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# HOW THE WORLD DREAMS ITSELF TO BE AMERICAN: REFLECTIONS ON THE RELATIONSHIP BETWEEN THE EXPANDING SCOPE OF TRADEMARK PROTECTION AND FREE SPEECH NORMS

Keith Aoki\*

*[O]ur modern media images, if they fascinate us so much it is not because they are sites of the production of meaning and representation—this would not be new—it is on the contrary because they are sites of the disappearance of meaning and representation . . . .<sup>1</sup>*

*But Hollywood moguls don't just make movies anymore; they control TV and cable networks, newspaper chains, magazine- and book-publishing empires—the information flow of the nation.*

*In that sense, they can create havoc in our culture as surely as a Michael Milken can rock the market.<sup>2</sup>*

## I. INTRODUCTION

Newspaper headlines ring out the news of yet another merger or acquisition between or by information-based corporations.<sup>3</sup> These

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1. Jean Baudrillard, *The Evil Demon of Images and the Precession of Simulacra*, in POSTMODERNISM: A READER (Thomas Docherty ed., 1993).

2. Frank Rich, *Mickey Mouse Clubbed*, N.Y. TIMES, Dec. 14, 1996, at A6.

3. Robert W. McChesney, *The Global Struggle for Democratic Communication*, 48 MONTHLY REV. 1, 2 (July-Aug. 1996):

newspaper headlines and stories, happy to proclaim the marriage of one multi-million dollar company with another, fail to address the public consequences of these mergers and employ language that keeps the public from closely scrutinizing the affects of these mergers. Absent from the reports on such mergers is any discussion of the information industries as the site of cultural production, or of the political role of the information industry. These news bytes ignore corporate colonization of nations resulting from the proliferation of commodified media images, distributed and controlled by a few mega corporations. It may be noted that the "globalization of media imagery is surely the most effective means ever for cloning cultures to make them compatible with the Western corporate vision."<sup>4</sup>

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[T]here are five global vertically integrated media companies: New Corp., Disney, Time Warner, Viacom, and TCI. There are several other media firms with global ambitions including General Electric (owner of NBC), Westinghouse (owner of CBS), Sony, Seagram (owner of MCA), and a few European giants led by Philips (owners of PolyGram), Havas and Bertelsmann AG.

*Id.*; *Mergers Were Biggest Offshoot of Telecom Overhaul*, ASSOCIATED PRESS, Feb. 4, 1997 (Local phone company Bell Atlantic Corp. agrees to combine with Nynex Corp. in a deal valued at \$22.7 billion; United Kingdom's British Telecom proposes to take over Washington-based MCI Communications Corp., the nation's second-largest long-distance company, for \$20 billion. Announced November 1996; The Walt Disney Co. buys Capital Cities/ABC Inc. for \$19 billion. Completed Feb. 9, 1996, one day after law enacted; Local phone company, SBC Communications Inc., agrees to buy Pacific Telesis Group for \$16.7 billion. Announced April 1996; WorldCom Inc. agrees to acquire MFS Communications Co. for \$12 billion. Completed December 1996; Bell company US West Corp. proposed to buy third largest-cable company, Continental Cablevision Inc., for \$10.8 billion. Announced February 1996; Time Warner Inc. takes over Turner Broadcasting System Inc. in deal valued at \$7.57 billion, creating the world's largest entertainment company. Completed October 1996; Largest radio station owner, Westinghouse Electric Corp. (parent of CBS Inc.) buys number two radio company, Infinity Broadcasting Corp., for \$3.9 billion, creating nation's largest radio owner. Completed December 1996); *see also* BEN H. BAGDIKIAN, *THE MEDIA MONOPOLY* 5 (1990):

In 1981 twenty corporations controlled most of the business of the country's 11,000 magazines, but only seven years later that number had shrunk to three corporations. . . . Today, despite more than 25,000 outlets in the United States, twenty-three corporations control most of the business in daily newspapers, magazines, televisions, books and motion pictures. . . . [B]y the year 2000 all United States media may be in the hands of six conglomerates.

*Id.*; HERBERT I. SCHILLER, *CULTURE, INC.: THE CORPORATE TAKEOVER OF PUBLIC EXPRESSION* 35 (1989) ("A prediction made in the mid-1980s that by 1995 almost 90 percent of all communication facilities (including newspapers, broadcast outlets, cable systems, telephone lines, relays and satellites) would be in the hands of fifteen companies is close to realization well before that date.").

4. Jerry Mander, *The Dark Side of Globalization: What the Media Are Missing*, NATION, July 15, 1996, at 13; *see also* DAVID MORLEY & KEVIN ROBBINS, *SPACES & IDENTITY: GLOBAL MEDIA, ELECTRONIC LANDSCAPES & CULTURAL BOUNDARIES* (1995); JOHN TOMLINSON, *CULTURAL IMPERIALISM: A CRITICAL INTRODUCTION* (1991); Rosemary J. Coombe, *Publicity Rights and Political Aspiration: Mass Culture, Gender Identity and Democracy*, 26 *New. Eng. L. Rev.* 1221 (1992).

The colonization of the Nation-state by the private corporate sovereigns is at hand.<sup>5</sup>

Almost every where you go in today's "global village," you'll find multilane highways, concrete cities and a cultural landscape featuring gray business suits, fast food chains, Hollywood films and cellular phones. In the remotest corner of the planet, Barbie and Madonna are familiar icons, and the Marlboro Man and Rambo define the male ideal. From Cleveland to Cairo to Caracas, *Baywatch* is entertainment and CNN is news.<sup>6</sup>

Western media images are transforming the world and constructing a hegemonic world culture modeled on the rampant consumerism of the United States. "[A]dvertising and media images exert powerful psychological pressures to seek a better, more 'civilized' life, based on the urban, Western consumerist model. Individual and cultural self-esteem are eroded by the advertising stereotypes of happy, blond, blue-eyed, clean Western consumers."<sup>7</sup>

In examining the effect of the distillation of information producers into a handful of mega corporations on global culture, it is helpful to look at how this same distillation has affected the national culture. This Article focuses on the flattening of democratic debate within the United States as a result of the concentration of information production in the hands of a few whose primary interest has little to do with promoting the public good, but rather in making money.

Throughout the history of the United States, the demonized image of government has been the primary aggressor on the battlefield of self-expression. The Constitution explicitly protects the individual from governmental interference with free speech. As we approach the twenty-first century, the attack on free speech has increasingly been an attack by private parties. The attack is often invisible and unconstrained by constitutional protections because the parties are private. Thus, under the surface of the cheerful headlines announcing the marriage of Disney and ABC Network lies the unreported and malignant illness that has afflicted

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5. See generally PETER DICKEN, *GLOBAL SHIFT: THE INTERNATIONALIZATION OF ECONOMIC ACTIVITY* (1982); WILLIAM GREIDER, *ONE WORLD, READY OR NOT* (1997); SASKIA SASSEN, *THE GLOBAL CITY: NEW YORK, LONDON, TOKYO* (1991); Rosemary J. Coombe, *The Cultural Life of Things: Anthropological Approaches to Law and Society in the Conditions of Globalization*, 10 AM. U. L.J. INT'L L. & POL'Y 791 (1995).

6. Helena Norberg-Hodge, *Break Up the Monoculture*, NATION, July 15, 1996, at 20; see also GUY DEBORD, *THE SOCIETY OF THE SPECTACLE* 29 (Donald Nicholson-Smith trans. 1994).

7. Norberg-Hodge, *supra* note 6, at 22.

the First Amendment.<sup>8</sup> While the distillation of information has direct and profound consequences on the dissemination of information,<sup>9</sup> enhanced protection for the products of information producers has added to the impending crisis.<sup>10</sup>

The focal point of this Article is the increased protections afforded the owners of intellectual property within the United States, specifically through anti-dilution laws, and the effects of increased ownership in social and cultural signifiers on personal expression and cultural formation. This exploration begins with a discussion of symbols as sites of cultural contestation whose meanings change over time through both individual and cultural recodification. Part II briefly explores the role of symbols as consumption objects within the context of postmodernity, specifically detailing the role of consumption objects in the construction of self. Part III discusses anti-dilution laws and gives examples of how the courts have applied anti-dilution. Finally, this Article argues that by allowing increased ownership control over the meanings embedded in cultural texts, specifically trademarks, courts and the law ignore the important role that commodified cultural symbols play in identity formation.

## II. SYMBOLS AS LITERATURE

Symbols have been used throughout human history to express in a concise, visual format what would take a "thousand words" to express verbally. Symbols are the embodiment of multiple levels of textual information; a hierarchy of meaning. However, the texts embodied by symbols do not remain stagnant over time. The meanings and texts of symbols change over time because they become part of the dialogic process of recodification and rescripting of meaning.<sup>11</sup>

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8. HERBERT I. SCHILLER, *INFORMATION INEQUALITY: THE DEEPENING SOCIAL CRISIS IN AMERICA* 43-45 (1996).

9. *See generally id.*

10. *See generally* Ruth L. Gana, *Has Creativity Dies in the Third World? Some Implications of the Internationalization of Intellectual Property*, 24 *DENV. J. INT'L. & POL'Y* 109 (1995). Allan Hutchinson, *Talking the Good Life: From Free Speech to Democratic Dialogue*, 1 *YALE J. L. & LIB.* 28 (1989)

From McDonald's to General Motors and Sear to CBS, corporations are the primary loci for socio-economic decisions and policymaking: how we put food on the table, what food we put on the table, what we pay to put food on the table, what food we think we should put on the table are all questions. That one shaped by corporations . . . [L]arge sections of the ruling elite . . . remain beyond the reach of popular control and the grasp of electoral accountants.

*Id.*

11. On dialogism see MICHEAL HOLQUIST, *DIALOGISM; BAKHTION AND HIS WORLD* 48 (1990) ("Existence is . . . a vast web of interconnection each and all of which are linked as

The swastika serves to illustrate both the point that the visual messages sent by symbols are multiple and that the embodied meanings change as a result of time and human interaction. The swastika is the world's oldest known, and most widely dispersed symbol; the swastika spans the history of human existence, originating with prehistoric man and existing in postmodernity. It spans the globe, existing simultaneously in the Americas, Europe and the Orient. Until recently, the swastika was universally recognized as an amulet or charm, a sign of benediction, the visual embodiment of a blessing for long life, good fortune and good luck. This use of the swastika as an amulet represents the universal texts embodied by the swastika; the first rank in the hierarchy of meaning. Additional levels of meaning are also embodied by the swastika. As the swastika was adopted by different cultures, it took on multiple texts, and different visual forms of the swastika came to act not only as symbols of good luck, but as symbols of religious or cultural affiliation.

The benign texts embodied by the swastika survived well into the twentieth century, when it suddenly became the most vilified symbol of human history.<sup>12</sup> The swastika no longer signified benign texts, but came to be recognized as the embodiment of the Nazi party, and later as the embodiment of all the horror of Nazi Germany. The power of the swastika, with its newly acquired texts of horror, led to its being outlawed in Germany in 1946 under German constitutional law.<sup>13</sup> Today, the swastika remains a symbol of Nazi Germany, and is used by "racists and hate groups . . . [who] use evocative emblems both to distinguish themselves and to signify their goals."<sup>14</sup> In addition, it recalls instantaneously the violations of human rights that are the hallmark of Nazi Germany.

The textual role of symbols and their relationship to both cultural and personal identity, may be illustrated by examining the well-known Harley-Davidson trademark. Harley-Davidson's spread-winged eagle is generally constitutive of flight and American political freedom. This symbol, incorporated into corporate products and goods, also brands people through

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participants in an event whose totality that no single one of us can ever know it. That event manifests itself in the form of constant, ceaseless creation and exchange of meaning."); see also, Rosemary J. Coombe, *Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue*, 69 TEX. L. REV. 1853, 1877 (1990).

12. THOMAS WILSON, THE SWASTIKA: THE EARLIEST KNOWN SYMBOL, AND ITS MIGRATIONS; WITH OBSERVATIONS ON THE MIGRATIONS OF CERTAIN INDUSTRIES IN PREHISTORIC TIMES 770-92 (1996).

13. STEVEN HELLER, NEO-FASCIST FASHION: EMBLEMS OF THE NEW NATIONALISM, Print XLVIII:1, 42, 46 (1994).

14. STEVEN HELLER, WORLD CLASS ICONS: BLOOD AND IRON 42, 46 (1994).

the individual production of body art.<sup>15</sup> While Harley-Davidson can generally be understood to represent personal freedom, within the Harley-Davidson subculture discrete groups interpret the core set of values associated with Harley-Davidson so as to render them consistent with their “prevailing life structures.”<sup>16</sup>

### III. TRADEMARKS IN THE CONDITION OF POSTMODERNITY: WE ARE WHAT WE CONSUME<sup>17</sup>

The significance of trademarks, as the embodiment of textual meaning, dramatically increases within the context of postmodernity due to proliferation of commodified symbols as objects of consumption resulting from the uncoupling of the real and the symbolic. “[O]ur vision of the world and of ourselves is shaped by the words we use and by the images that fill our fantasies. The words and images of trade are an important part of this panorama”<sup>18</sup> because

[i]n our consumer culture people do not define themselves according to sociological constructs. They do so in terms of the activities, objects, and relationships that give their lives meaning. It is the objects, and consumer goods above all, that substantiate their place in the social world. It is through objects that they relate to other[s].<sup>19</sup>

In today’s societies, symbols that once functioned simply to indicate the source, origin, and quality of goods, have become products valued as indicators of the “status, preferences, and aspirations of those who use them. Some trademarks have worked their way into the English language; others provide bases for vibrant, evocative metaphors.”<sup>20</sup>

We live in the midst of codes, messages, and images which produce and reproduce our lives. These may have had their origins in commodity production, but have since won their independence and usurped its role in the maintenance of social relations. All that remains is the pleasure of playing in the fragments, the disruption and resistance of the codes in which

15. John Schouten & James H. McAlexander, *Subcultures of Consumption: An Ethnography of the New Bikers*, 22 J. CONSUMER RES. 43 (1995).

16. *Id.*

17. DAVID HARVEY, *THE CONDITION OF POSTMODERNISM: AN ENQUIRY INTO THE ORIGINS OF CULTURAL CHANGE* (1990).

18. Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 974 (1993).

19. Schouten & McAlexander, *supra* note 15.

20. Kozinski, *supra* note 18, at 965.

we live, the *jouissance* of realizing that the search for meaning is endlessly deferred and has no point of arrival and in the absence of new movements, styles or genres, the continual reiteration of those of the past.<sup>21</sup>

Increasingly, trademarks are a self-contained commodity that may be marketed and sold to the general public.<sup>22</sup>

[Capitalism by the] 1950s had expanded far beyond the mere production of obvious necessities and luxuries; having satisfied the needs of the body, capitalism as spectacle turned to the desires of the soul. It turned upon individual men and women, seized their subjective emotions and experiences, changed those once evanescent phenomena into objective, replicable commodities, placed them on the market, set their prices, and sold them back to those who had, once, brought emotions and experiences out of themselves—to people who as prisoners of the spectacle could now find such things only on the market.<sup>23</sup>

An extreme example is the sale of trademarks as cloth patches. In a quick visit to a cloth or craft store one can pick up patches such as a favorite sports emblem, Mickey or Minnie Mouse, and Winnie-the-Pooh.

When trademarks are used in this way, they acquire certain functional characteristics that are different from—and sometimes inconsistent with—their traditional role as identifiers of source. This trend raises questions about whether—and to what extent—the law should protect trademarks when they are pressed into service as separate products.<sup>24</sup>

The repositing of trademarks as consumption objects requires rethinking the legal protection afforded trademarks from use by nonowners because the self is created and defined through the integration of these objects with personal identity. Consumers may also use such objects to classify themselves and build an identity of both association with and

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21. SADIE PLANT, *THE MOST RADICAL GESTURE: THE SITUATIONIST INTERNATIONAL IN A POSTMODERN AGE 6–7* (1989).

22. Kozinski, *supra* note 18, at 961.

23. GREIL MARCUS, *LIPSTICK TRACES: A SECRET HISTORY OF THE TWENTIETH CENTURY* 101 (1989); *see also* GUY DEBORD, *supra* note 6, at 29:

The spectacle corresponds to the historical moment at which the commodity completes its colonization of social life. It is not just that the relationship to commodities is now plain to see—commodities are now all that there is to see; the world we see is the world of the commodity.

*Id.*

24. Kozinski, *supra* note 18, at 962.



differentiation from others.<sup>25</sup> The process of classification revolves around the leveraging of personal interaction with the consumption object in order to “communicate with others (where the “other” can also be oneself viewed in the third person)”<sup>26</sup> something about themselves.

Spectator sports illustrate how trademarks are used to build affiliation through the use of totemic symbols. Sports fans classify themselves through objects by using the shared meanings associated with consumption objects. Clothing that incorporates the team’s insignia or trademark is a primary tool in creating an identity, because spectators have a limited ability to engage in the production of the game itself. Thus, spectators focus on personalizing the part of the game over which they have control, themselves.<sup>27</sup>

The process of integrating consumption objects into self-identity may take one of two forms. Integration may occur through self-extension processes that draw external objects into one’s self-concept.<sup>28</sup> Secondly, integration may be achieved by re-orienting the individual self-concept so that it aligns with an institutionally defined identity.<sup>29</sup> Integration is virtually automatic when consumers significantly participate in the creation of the consumption object, acting simultaneously as producer and consumer. However, this ability to integrate decreases with the proliferation and consumption of mass-produced consumption objects because the reified quality of the object prevents consumers from participating in the production of the object.<sup>30</sup>

25. Douglas B. Holt, *How Consumers Consume: A Typology of Consumption Practices*, 22 J. CONSUMER RES. 1 (1995).

26. *Id.*

27. Igor Kopytoff, *The Cultural Biography of Things: Commoditization as Process*, in THE SOCIAL LIFE OF THINGS: COMMODITIES IN CULTURAL PERSPECTIVE 77 (Arjun Appadurai ed., Cambridge Univ. Press 1986) (“[I]n any society, the individual is often caught between the cultural structure of commoditization and his own personal attempts to bring a value order to the universe of things.”).

28. See, e.g., Russell W. Belk, *Materialism: Trait Aspects of Living in the Material World*, 12 J. CONSUMER RES. 265 (1985); Russell W. Belk, *Possessions and the Extended Self*, 15 J. CONSUMER RES. 139 (1988); Melanie Wallendorf & John F. Sherry, Jr., *The Sacred and Profane in Consumer Behavior: Theodicy on the Odyssey*, 16 J. CONSUMER RES. 1 (1989).

29. See, e.g., *Homeyness: A Cultural Account of One Constellation of Consumer Goods and Meanings*, in INTERPRETIVE CONSUMER RESEARCH 168 (Elizabeth Hirschman ed., Ass’n for Consumer Research 1989); Grant McCracken, *Culture and Consumption: A Theoretical Account of the Structure and Movement of the Cultural Meaning of Consumer Goods*, 13 J. CONSUMER RES. 71 (1986).

30. See generally Holt, *supra* note 25.

Thus, symbols or trademarks are luxury goods,<sup>31</sup> defined by Arjun Appadurai as “goods whose principal use is rhetorical and social, goods that are simply incarnated signs.”<sup>32</sup> Increasingly, these goods or symbols are construed as the property of others through active policing of the exclusive right of use gained through federal trademark registration.<sup>33</sup>

#### IV. INTELLECTUAL PROPERTY LAW AND THE CONSTRUCTION OF IDENTITY

##### *A. The Traditional Legally Recognized Text of Trademarks*

Trademarks are traditionally viewed as a source identifier. They are words and designs whose purpose is to distinguish the goods or services of one company from the goods or services of another company.<sup>34</sup> The underlying premise in the treatment of trademarks as a source identifier rests on the assumption that consumers read these identifiers as representing consistency between goods bearing the same identifier—that different goods bearing the same trademark emanate from the same source, and that trademarks represent the promise of consistent quality. Justice Frankfurter noted:

The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. . . . The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. . . . [T]he aim is . . . to

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31. Arjun Appadurai, *Commodities and the Politics of Value*, in *THE SOCIAL LIFE OF THINGS: COMMODITIES IN CULTURAL PERSPECTIVE* 38 (Arjun Appadurai, ed., Cambridge Univ. Press 1986) (Luxury goods are marked by some or all of the following attributes: (1) restriction, either by price or by law, to elites; (2) complexity of acquisition, which may or may not be a function of real “scarcity”; (3) semiotic virtuosity, that is, the capacity to signal fairly complex social messages . . . ; (4) specialized knowledge as a prerequisite for the ‘appropriate’ consumption, that is, regulation by fashion; and (5) a high degree of linkage of their consumption to body, person and personality.).

32. *Id.* at 38.

33. Rosemary J. Coombe, *Objects of Property and Subjects of Politics: Intellectual Property Law and Democratic Dialogue*, 69 *TEX. L. REV.* 1853, 1866 (1991).

34. “[T]rademark’ includes any word, name, symbol or device, or any combination thereof . . . used . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. § 1127 (1994).

convey through the mark . . . the desirability of the commodity upon which it appears.<sup>35</sup>

This traditional view of a trademark as simply a symbol of origin, quality and consistency ignores the role that trademarks play in identity formation because it ignores the repositing of trademarks as consumption goods. This is especially true under current formulations of the concept of consumer confusion. Under the guise of protecting the consumer, courts increasingly objectify and reify cultural forms, thereby "freezing the connotations of signs and symbols and fencing off with 'No Trespassing' signs" the very texts that embody cultural and personal meaning.<sup>36</sup>

*B. The Expanding Doctrine of Anti-Dilution: The Uneasy Relationship Between the First and Fifth Amendments*

Overprotecting intellectual property is as harmful as underprotecting it. Creativity is impossible without a rich public domain. Nothing today, likely nothing since we tamed fire, is genuinely new: Culture, like science and technology, grows by accretion, each new creator building on the works of those who came before. Overprotection stifles the very creative forces it's supposed to nurture.<sup>37</sup>

In 1927, the proposition that trademarks should be protected from the "gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name" was introduced to U.S. law.<sup>38</sup> Initially, courts were hesitant to embrace this proposition, but over the course of the 1970s and 1980s, with the increasing proliferation of state anti-dilution statutes<sup>39</sup> culminating in the adoption of federal anti-dilution provisions,<sup>40</sup>

35. *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942).

36. Coombe, *supra* note 33, at 1866.

37. *White v. Samsung Elec. Am. Inc.*, 989 F.2d 1512, 1513 (9th Cir. 1993) (Kozinski, J., dissenting in the denial of a petition for a *en banc* rehearing).

38. Frank Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 825 (1927).

39. See, e.g., ALA. CODE § 8-12-17 (Supp. 1984); ARK. CODE ANN. § 4-71-113 (Michie 1987); CAL. BUS. & PROF. CODE § 14330 (West Supp. 1989); CONN. GEN. STAT. ANN. § 35-11i(c) (West 1987); DEL. CODE. ANN. tit. 6, § 3313 (Supp. 1990); FLA. STAT. ANN. § 495.151 (West 1988).

40. See 15 U.S.C. § 1125 (c) (Remedies for dilution of famous marks):

(1) The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection.

it was accepted. Anti-dilution statutes protect trademarks from the "likelihood of injury to business reputation or of dilution of the distinctive quality of a mark" even absent competition between the parties, or confusion as to the source of goods or services. Dilution has gradually been extended to include protection against the "blurring" of trademark's positive connotations by dissonant or unfavorable usage.<sup>41</sup> Dilution of a trademark occurs when the affirmative associations of the mark are tarnished through unwholesome or unsavory mental associations.<sup>42</sup> The

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In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to—

- (A) the degree of inherent or acquired distinctiveness of the mark;
  - (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
  - (C) the duration and extent of advertising and publicity of the mark;
  - (D) the geographical extent of the trading area in which the mark is used;
  - (E) the channels of trade for the goods or services with which the mark is used;
  - (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;
  - (G) the nature and extent of use of the same or similar marks by third parties; and
  - (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.
- (2) In an action brought under this subsection, the owner of the famous mark shall be entitled only to injunctive relief unless the person against whom the injunction is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If such willful intent is proven, the owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity.
- (3) The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register shall be a complete bar to an action against that person, with respect to that mark, that is brought by another person under the common law or a statute of a State and that seeks to prevent dilution of the distinctiveness of a mark, label, or form of advertisement.
- (4) The following shall not be actionable under this section:
- (A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.
  - (B) Noncommercial use of a mark.
  - (C) All forms of news reporting and news commentary.

*Id.*

41. See, e.g., *Exxon Corp. v. Exxene Corp.*, 696 F.2d 544, 550 (7th Cir. 1983); *Jordache Enters. v. Hogg Wyld, Ltd.*, 625 F. Supp. 48, 52 (D.N.M. 1985) (noting that there is a risk of "erosion of the public's identification" of a trademark, diminishing its distinctiveness, uniqueness, effectiveness and prestige (quoting *Tiffany & Co. v. Boston Club, Inc.*, 231 F. Supp. 836, 844 (D. Mass. 1964))).

42. *Mead Data Cent. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1031 (2d Cir. 1989); *Mutual of Omaha Ins. Co. v. Novak*, 648 F. Supp. 905, 912 (D. Neb. 1986)

underlying premise of anti-dilution law is that the primary value of a trademark lies in its ability to convey positive meaning to the public.<sup>43</sup>

Anti-dilution law protects trademarks from negative associations that might harm the value of the mark, even when these associations are actually true, as evidenced by the injunction granted to Coca-Cola against the creators of a poster reading "Enjoy Cocaine" printed in the same typeface used in the "Enjoy Coca-Cola" advertisements.<sup>44</sup> The judge who granted the injunction noted that people might be unwilling to consume goods sold by a company who treated such a "dangerous drug in such a jocular fashion."<sup>45</sup> The judge overlooked, or perhaps simply didn't care about, Coca-Cola's very real historical usage of cocaine.<sup>46</sup>

A similar attitude was adopted in 1987, by the Eighth Circuit when they granted Mutual of Omaha an injunction against the use of a logo using the words "Mutant of Omaha" coupled with a side view of an emaciated human head wearing a feather headdress.<sup>47</sup> This logo was originally marketed on T-shirts with the additional text of "Nuclear Holocaust Insurance" imprinted on them.<sup>48</sup> The design was also applied to sweatshirts, caps, buttons, and coffee mugs that were offered for sale at retail shops, exhibitions, and fairs.<sup>49</sup> The merchandise was advertised on television and in newspapers and magazines.<sup>50</sup> The court found this to be an infringement of the Mutual of Omaha trademark in that the design bearing words "Mutant of Omaha" and depicting a side view of a feather-bonneted, emaciated human head created likelihood of confusion as to the insurance company's sponsorship of or affiliation with designer's merchandise.<sup>51</sup> The court found that confusion rather than competition should be used to determine trademark infringement.<sup>52</sup> The court refused to acknowledge a First Amendment defense so long as alternative means, not restricted by the injunction, existed by which the designer could express his views.<sup>53</sup>

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43. Schechter, *supra* note 38, at 825.

44. *See Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1193 (E.D.N.Y. 1972).

45. *Id.* at 1191.

46. *See E. KAHN, THE BIG DRINK: AN UNOFFICIAL HISTORY OF COCA-COLA* 54-55, 101-03 (1960) (Coca-Cola contained cola nuts, caffeine, and a derivative of coca leaves that included, prior to 1906, trace amounts of cocaine).

47. *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 398 (8th Cir. 1987).

48. *Id.* at 398.

49. *Id.*

50. *Id.*

51. *Id.* at 400.

52. *Id.* at 399.

53. *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d at 402.

The Eighth Circuit has reiterated its commitment to preserving the exclusive right of use given to a trademark owner in *Anheuser-Busch, Inc. v. Balducci Publications*.<sup>54</sup> Rich and Kathleen Balducci published, from their apartment, a low-budget, usually free tabloid approximately four times a year called "Snicker" with circulation of about 13,000 copies.<sup>55</sup> The back cover of Snicker's Spring 1989 issue featured a full page fake advertisement for a beer dubbed "Michelob Oily."<sup>56</sup> The parody ran after Anheuser-Busch temporarily stopped manufacturing beer because a Shell Oil pipeline rupture had contaminated its water supply.<sup>57</sup> The advertisement was an illustration depicting a hand holding a beer can with an oil spout with oil pouring from the can onto a fish, coupled with the slogan, "One taste and you'll drink it oily," intended to mock the Michelob slogan "One drink and you'll drink it dry."<sup>58</sup> At the bottom of the page was a Shell Oil logo, and an illustration resembling the Anheuser-Busch "A & Eagle" design depicting the eagle covered in oil and exclaiming "Yuck."<sup>59</sup> Text on the very bottom of the page read, "At the rate it's being dumped into our oceans, lakes and rivers, you'll drink it oily sooner or later, anyway."<sup>60</sup> A disclaimer stating this was a "Snicker Magazine Editorial by Rich Balducci, Art by Eugene Ruble" was positioned running up the right hand side of the page.<sup>61</sup>

The Eighth Circuit, in granting the injunction, applied a two step test.<sup>62</sup> First, the court determined the likelihood of confusion, and then determined if the resulting likelihood of confusion was outweighed by First Amendment concerns. The court concluded that the similarity between Balducci's editorial and a real Michelob ad were similar enough to create a likelihood of confusion and so any social commentary he sought to make was outweighed by trademark law's objective of avoiding consumer confusion.<sup>63</sup>

These decisions, and others like them,<sup>64</sup> protect the property rights of the trademark owner over individual rights of free expression by failing to

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54. *Anheuser-Busch, Inc. v. Balducci Publications*, 28 F.3d 769 (8th Cir. 1994).

55. *Id.* at 772.

56. *Id.*

57. *Id.*

58. *Id.*

59. *Id.*

60. *Anheuser-Busch*, 28 F.3d at 772.

61. *Id.*

62. *Id.* at 776.

63. *Id.* at 777.

64. See also *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979) (rejecting a First Amendment argument on grounds that property rights, such as

balance the constitutionally protected rights in property with the constitutionally protected right of freedom to individual expression.<sup>65</sup> They instead, give property rights precedence over First Amendment rights. As noted by Rosemary Coombe, anti-dilution laws are “the perfect tool for corporate overreaching” when they are used to “preclude the use of a trademark in noncompeting contexts in ways that have no potential to confuse consumers.”<sup>66</sup> A better approach to balancing First Amendment with Fifth Amendment concerns involves a simultaneous analysis of the constitutionally protected rights at stake.<sup>67</sup> Courts using this approach have refused to grant injunctions against the unauthorized use of trademarks when the trademarks are an important part of the expression.<sup>68</sup>

trademark rights, can supersede the exercise of free speech when alternative means of communicating the message are available); *Chemical Corp. of Am. v. Anheuser-Busch, Inc.*, 306 F.2d 433 (5th Cir. 1962) (holding that floor wax and insecticide maker’s slogan, “Where there’s life, there’s bugs,” harmed strength of defendant’s slogan, “Where there’s life, there’s Bud.”); *American Express Co. v. Vibra Approved Lab. Corp.* 10 U.S.P.Q.2d. (BNA) 2006, 2013 (S.D.N.Y. 1989) (stating that defendant’s “condom card” using the name “America Express” and the slogan “Never Leave Home Without It” was seen to threaten the distinctiveness of the American Express card as a symbol of quality and prestige); *Original Appalachian Artworks, Inc. v. Topps Chewing Gum*, 642 F. Supp. 1031 (N.D. Ga. 1986) (merchandise of “Garbage Pail Kids” stickers and products injured owner of Cabbage Patch Kids mark); *D.C. Comics, Inc. v. Unlimited Monkey Bus.*, 598 F. Supp. 110 (N.D. Ga. 1984) (holder of Superman and Wonder Woman trademarks damaged by unauthorized use of marks by singing telegram franchiser); *Pillsbury Co. v. Milky Way Prod., Inc.* 215 U.S.P.Q. (BNA) 124 (N.D. Ga. 1981).

65. Madhavi Sunder, *Authorship and Autonomy as Rites of Exclusion: The Intellectual Propertyization of Free Speech in Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston*, 49 STAN. L. REV. 141, 144–45 (1996) (“Although historically the concept of free speech arguably has been used as a bulwark against the absolute entitlements of property” the increasing propertyization of free speech has led courts to imbue the First Amendment with the “same entitlements as private property: the rights of unconstrained use, exclusivity, and selective transfer.”).

66. Rosemary J. Coombe, *Authorial Cartographies: Mapping Proprietary Borders in a Less-Than-Brave New World*, 48 STAN. L. REV. 1357, 1366 (1996).

67. The few cases decided under the 1995 Federal Trademark Dilution Act have favored the property rights of the trademark owners. See generally *Panavision Int’l, L.P. v. Teoppen*, 1996 WL 653726 (S.D. Cal. 1996); *Clinique Lab., Inc. v. Dep Corp.*, 1996 WL 583395 (S.D.N.Y. 1996); *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. B.E. Windows Corp.*, 937 F. Supp. 204 (S.D.N.Y. 1996); *Wawa, Inc. v. D. Haaf, II*, 1996 WL 460083 (E.D. Pa.). But see *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559 (S.D. Cal. 1996) (holding that expressive use is not rendered commercial merely through sales). In *Dr. Seuss Enterprises*, the court found that the defendant’s book was a parody of Dr. Seuss’ trademark and thus protected expression under the First Amendment.

68. See also *Nike v. “Just Did It” Enters.*, 6 F.3d 1225 (7th Cir. 1993) (reversed summary judgment finding that “MIKE,” “JUST DID IT,” and swoosh symbol on T-shirts and sweatshirts infringed “NIKE,” “JUST DO IT” and swoosh symbol, and remanded to ascertain likelihood of confusion at trial); *Anheuser-Busch, Inc. v. L & L Wings Inc.*, 962 F.2d 316 (4th Cir. 1992) (upholding jury finding that the phrase “This Beach is For You,” on beach towels was not actionable parody.); *Jordache Enters. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987) (LARDASHE jeans for large-size women held not violative of famous JORDACHE jeans).

The balancing of free speech concerns along with property concerns is exemplified by the First Circuit's 1987 decision in *L.L. Bean, Inc. v. Drake Publishers, Inc.*<sup>69</sup> In October 1984, *High Society*, a monthly periodical featuring adult erotic entertainment, contained a two-page article entitled "L.L. Bean's Back-To-School-Sex-Catalog."<sup>70</sup> The article was labeled on the magazine's contents page as "humor" and "parody."<sup>71</sup> The article displayed a facsimile of Bean's trademark and featured pictures of nude models in sexually explicit positions using "products" that were described in a crude and humorous fashion.<sup>72</sup> L.L. Bean sought a temporary restraining order to remove the issue from circulation.<sup>73</sup> The First Circuit held that the limits of the property interest in a trademark were such that the First Amendment issue could not be summarily dismissed by merely asserting that the property owner's interest supersedes the individual's interest in the exercise of First Amendment rights.<sup>74</sup> The court stated that "[t]rademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view."<sup>75</sup> Thus, the court found that the application of Maine's anti-dilution statute to *High Society's* noncommercial parody of L.L. Bean's trademark would violate the First Amendment because the magazine had not used the mark to identify or market goods or services, but solely to identify the owner of the trademark as the object of parody.

Like the First Circuit, the United States District Court for the District of Columbia recognizes the serious First Amendment concerns implicit in enjoining the unauthorized use of trademarks when the trademark is used in the expression of ideas. In *Lucasfilm Ltd. v. High Frontier*,<sup>76</sup> the court refused to apply the confusion, misappropriation, or dilution rationales to bar the defendants' use of plaintiff's trademark in the term "Star Wars." The term "Star Wars" was being used by the defendants, comprised of various public interest groups, in television advertisements to express a variety of views surrounding the Reagan Administration's Strategic Defense Initiative.<sup>77</sup> The court refused to enjoin this use of the trademark,

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69. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987).

70. *Id.* at 27.

71. *Id.*

72. *Id.*

73. *Id.*

74. *Id.* at 29.

75. 811 F.2d at 29 (citing *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931, 933-35 (D.D.C. 1985)).

76. *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931 (D.D.C. 1985).

77. *Id.* at 932.



finding that the limited property rights conferred by a trademark did not include the right to exclude the use of certain words in all contexts.<sup>78</sup> The court found that, despite the fact that the descriptive meaning of "Star Wars" was originally derived from Lucasfilm's trademark, the defendants' use of the term was protected expression because the only activity, in using the term "Star Wars," was the communication of their ideas; courts "cannot regulate the type of descriptive, non-trade use involved here without becoming the monitors of the spoken or written English language."<sup>79</sup> The court further stated that even if Lucasfilm could prove the potential for injurious confusion or a weakening of the strength of the mark, an injunction would be inappropriate because, "[I]t would be wholly unrealistic and unfair to allow the owner of a mark to interfere in the give-and-take of normal political discourse."<sup>80</sup>

*C. The First Amendment Does Not Guarantee the Most Effective Form of Speech; or Are Prohibitions Against Nonowners' Use of Trademarks Simply the Regulation of the Time, Place, and Manner of Expression?*

Courts, in giving preferential treatment to the rights of trademark owners, rely on the Supreme Court's holding in *Lloyd Corp. v. Tanner*.<sup>81</sup> In *Lloyd*, the Supreme Court gave the owner of real property the right to exclude picketers from that property. Reliance on *Lloyd* has led courts to conclude, by analogy, that the unauthorized use of a trademark must yield to an assertion of trademark ownership. While the real property analogue may at times be useful, when applied to trademarks it has become distorted. This distortion leads to limitations, not only the place of expression, but also on the content of that expression. This analogy, when applied to trademarks, repositis the regulation of the content of expressive material as simply the regulation of the place, time and manner in which it may be said.<sup>82</sup> The First Circuit noted that restricting the use of trademarks may

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78. *Id.* at 933.

79. *Id.* at 935.

80. *Lucasfilm Ltd.*, 622 F. Supp. at 935.

81. 407 U.S. 551 (1972).

82. Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 165 ("The danger in utilizing a property conception of trademark . . . goes beyond its inadequacies as a descriptive theory. When adopted, it inevitably assumes a normative role, producing a mode of analysis incapable of transcending doctrine, thus precluding a rational consideration of competing social, economic, and occasionally, constitutional, interests."); Wendy J. Gordon, *Reality as Artifact: From Feist to Fair Use*, 55 L. & CONTEMP. PROBS. 93, 101 (1992) ("Too broad a set of intellectual property rights can give one set of persons control over how . . . reality is viewed, perceived, interpreted—control over what the world means.").

restrict the communication of ideas because “trademarks offer a particularly powerful means of conjuring up the image of their owners and thus become an important, perhaps at times indispensable, part of the public vocabulary.”<sup>83</sup>

The problems of allowing ownership in text may be more clearly depicted through an example of ownership in a word as opposed to a symbol.<sup>84</sup> Under the Amateur Sports Act,<sup>85</sup> the United States Olympic Committee has been granted the exclusive right to use the term “Olympic” in certain enumerated circumstances.<sup>86</sup> The Supreme Court upheld this

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83. *L.L. Bean*, 811 F.2d at 30–31 (criticizing the application of *Lloyd* to intellectual property, specifically trademarks).

84. *See, e.g., San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987).

85. 36 U.S.C. § 380 (1994).

86. Section 110 of the Act provides:

(a) Without the consent of the [USOC], any person who uses for the purpose of trade, to induce the sale of any goods or services, or to promote any theatrical exhibition, athletic performance, or competition—

(1) the symbol of the International Olympic Committee, consisting of 5 interlocking rings;

(2) the emblem of the [USOC], consisting of an escutcheon having a blue chief and vertically extending red and white bars on the base with 5 interlocking rings displayed on the chief;

(3) any trademark, trade name, sign, symbol, or insignia falsely representing association with, or authorization by, the International Olympic Committee or the [USOC]; or ...

(4) the words ‘Olympic,’ ‘Olympiad,’ ‘Citius Altius Fortius,’ or any combination or simulation thereof tending to cause confusion, to cause mistake, to deceive, or to falsely suggest a connection with the [USOC] or any Olympic activity; shall be subject to suit in a civil action by the [USOC] for the remedies provided in the Act of July 5, 1946 (60 Stat. 427; popularly known as the Trademark Act of 1946). However, any person who actually used the emblem in subsection (a)(2) of this section, or the words, or any combination thereof, in subsection (a)(4) of this section for any lawful purpose prior to September 21, 1950, shall not be prohibited by this section from continuing such lawful use for the same purpose and for the same goods or services. In addition, any person who actually used, or whose assignor actually used, any other trademark, trade name, sign, symbol, or insignia described in subsections (a)(3) and (4) of this section for any lawful purpose prior to September 21, 1950, shall not be prohibited by this section from continuing such lawful use for the same purpose and for the same goods or services.

(b) The [USOC] may authorize contributors and suppliers of goods or services to use the trade name of the [USOC] as well as any trademark, symbol, insignia, or emblem of the International Olympic Committee or of the [USOC] in advertising that the contributions, goods, or services were donated, supplied, or furnished to or for the use of, approved, selected, or used by the [USOC] or United States Olympic or Pan-American team or team members.

(c) The [USOC] shall have exclusive right to use the name ‘United States Olympic Committee’; the symbol described in subsection (a)(1) of this section; the emblem described in subsection (a)(2) of this section; and the words ‘Olympic,’

right when a San Francisco based gay advocacy group sponsored a gay Olympics. The Supreme Court found that barring the use of the word "Olympic" in the context of the "gay Olympic games" did not prohibit the conveyance of a political statement about the status of homosexuals in society because the statute restricted only the manner in which the message was delivered.<sup>87</sup>

Justice Brennan dissented, stating that the restrictive use of the word "Olympic" was not simply a restriction of the time, place, and manner by which a message could be conveyed, but a restriction on the content of the message.<sup>88</sup> Brennan argued that the San Francisco Arts and Athletics Association, in using the word "Olympic," intended to "promote a realistic image of homosexual men and women that would help them move into the mainstream of their communities."<sup>89</sup> Thus, the injunction against the San Francisco Arts and Athletics Association's use of the word "Olympic" violated the First Amendment because it prohibited the use of a word for which no adequate translation existed.<sup>90</sup> Brennan further asserted that, even if a translation could be found, the First Amendment protects more than the right to mere translation because a translation can never fully express the original.

When we look at particular words, it is not their translation into statements of equivalence that we should seek but an understanding of the possibilities they represent for making and changing the world. . . . Such words do not operate in ordinary speech as restatable concepts but as words with a life and force of their own. They cannot be replaced with definitions, as though they were parts of a closed system, for they constitute unique resources, of mixed fact and value, and their translation into other terms would destroy their nature. Their meaning resides not in their reducibility to other terms but in their irreducibility. . . . They operate indeed in part as gestures, with a meaning that cannot be restated.<sup>91</sup>

Indeed, the Supreme Court has acknowledged the danger of censoring expressive content by prohibiting the use of individual words. In *Cohen v.*

'Olympiad,' 'Citius Altius Fortius,' or any combination thereof subject to the preexisting rights described in subsection (a) of this section.

36 U.S.C. § 380 (1994).

87. *San Francisco Arts & Athletics, Inc.* 483 U.S. at 535-42.

88. *Id.* at 548.

89. *Id.* at 569.

90. *Id.*

91. *Id.* at 570 n.33 (Brennan, J., dissenting) (quoting J. WHITE, WHEN WORDS LOSE THEIR MEANING 11 (1984)).

*California*,<sup>92</sup> the Supreme Court recognized that words were not interchangeable with either their definition or other words. The *Cohen* Court stated:

[W]e cannot indulge the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process. Indeed, governments might soon seize upon the censorship of particular words as a convenient guise for banning the expression of unpopular views. We have been able . . . to discern little social benefit that might result from running the risk of opening the door to such grave results.<sup>93</sup>

The inability to fully express oneself through substitute words or translation was simply illustrated by Judge Kozinski when he observed that a jacket reading "I Strongly Resent the Draft" would not convey the same message as a jacket reading "Fuck the draft."<sup>94</sup>

While both *Cohen* and *San Francisco Arts & Athletics* involve the permissible or impermissible use of words, the restriction of nonowners' use of trademarks is likewise an impermissible censorship of content because "trademarks are the emerging *lingua franca*: with a sufficient command of these terms, one can make oneself understood the world over."<sup>95</sup> Trio, a graphic design group from Sarajevo, created a set of twenty-five postcards using familiar Western trademarks to convey their demand for the return of their most fundamental human right, the right to exist. The use of familiar Western images was adopted in an attempt to introduce, to the West, the unfamiliar with familiar imagery. One postcard, entitled "Andy Warhol's Campbell Soup Redesigned by Trio Sarajevo," depicts a Warhol Campbell's soup can, empty, and riddled with bullet holes. The image communicates multiple messages including those of hunger, destruction of life, and the destruction of cultural heritage. Another postcard uses the symbol of the United Nations coupled with the text "1993, Disunited Nations of Bosnia and Herzegovina" to represent the inability of the United Nations to prevent the "dismemberment of Bosnia and Herzegovina."<sup>96</sup>

These postcards are representative of the value of using trademarks as something other than a source indicator. Under current applications of *Lloyd* to trademarks, it is likely that Trio would have been required to use

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92. 403 U.S. 15 (1971).

93. *Id.* at 26.

94. *Cohen v. California*, 789 F.2d 1319, 1321 (9th Cir. 1986).

95. Kozinski, *supra* note 18, at 966.

96. Cedomir Kostovic, *Postcards From Sarajevo*, *Print*, May/June 1994, at 92, 95.

an alternative format in expressing their ideas so as to avoid trademark infringement liability. What can be clearly understood from Trio's work is that symbols have the ability to convey meaning across the globe because they are not restricted by language barriers, and they often have a uniformity of meaning that is understood across cultures. Courts that restrict this ability to convey meaning in a universally recognizable way restrict freedom of expression. Trademarks, as language, properly belong to the people, and just as words are not interchangeable, one symbol is not interchangeable with another, or with a collection of words.<sup>97</sup>

Where the trademark is an inextricable part of the message, no alternative means of expression exist, and inquiry into alternatives rests on the perception that the content of the message can be conveyed absent the protected trademark. Alternative means of communication, such as words, often lack the communicative power of symbols, and unless the government has banned all alternatives, an alternative method of communication will exist. Asking courts to determine whether the "alternatives are 'adequate' opens an inquiry into the capacity of various media to convey emotion and other highly nuanced and elusive aspects of symbolic speech."<sup>98</sup> If the trademark is an integral part of the message being conveyed then courts should be hesitant to grant injunctions barring the trademark's use by nonowners.<sup>99</sup>

The recodification of cultural imagery by nonowners is central to the process of creating culture because meanings expressed through systems of signification are, by definition, perpetually unstable, they are always capable of being deployed against the grain. The ambiguities and traces of cultural forms may be seized upon by those who may well repeat, imitate, and appropriate elements of a dominant cultural order while

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97. One could also examine the Negativland of trademarks owned by fast food restaurants such as McDonald's to expose how economic imperialism contributes to continued human rights violations in the third world, as well as environmental destruction throughout the world available at <<http://www.envirolink.org/mcspotlight/home.html>>. See also ADBUSTERS: J. MENTAL ENV'T, Winter 1996 (deconstructing consumer capitalism and mass marketing through the Negativland of trademarks and advertising images). The front cover of the Winter 1996 issue features a traditional Quaker Oats package. The quaker is replaced with an image of presidential candidate Bob Dole, the product is named "Dole Oats" and is supported by the caption, "Good Old-Fashioned Blandness." *Id.*

98. William E. Lee, *The Futile Search for Alternative Media in Symbolic Speech Cases*, 8 CONST. COM. 451, 455 (1991).

99. See *Texas v. Johnson*, 491 U.S. 397, 416 n.11 (1989) (stating that the Texas anti-flag burning law was unconstitutional; the court's hostility content regulation "is not dependent upon the particular mode in which one chooses to express an idea;" and the availability of alternative means of communication was insufficient to justify the law).

critically marking differences in social experience. legal forums may legitimate or undermine such deployments.<sup>100</sup>

Recodification allows individuals to push and contest social boundaries and the unexamined privileges of normality (i.e., white, straight and male). This power is exemplified in the co-opting of Matt Groening's character Bart Simpson by Queer Nation. Bart, as produced on a T-shirt conceived of by Queer Nation, becomes a "New York gay clone: he wears an earring, his own Queer Nation T-shirt, and a pink triangle button"<sup>101</sup> and exclaims "'Get Used to it Dude!'"<sup>102</sup> Queer Nation's ability to capitalize on popular media images is further illustrated through the organization's series of pseudo-advertisements using popular Gap clothing advertisements featuring gay, bisexual and polymorphous celebrities. The "p" in Gap's logo is changed to a "y." These pseudo-advertisements were designed to accomplish two goals. First, they "out" the closeted gays and bisexual celebrities used in the ad, and secondly, they serve to "out" the use of gay style to sell clothes.<sup>103</sup> The use of popular media images by Queer Nation allow them to engage in the dialogic process of cultural formation by appropriating the power of popular media to contest, create, and disseminate cultural norms.<sup>104</sup>

100. Rosemary J. Coombe, *Contingent Articulations: A Critical Cultural Studies of Law, in LAW IN THE DOMAINS OF CULTURE* (Austin Sarat & Thomas R. Kearns, ed. forthcoming 1997).

101. LAUREN BERTLANT & ELIZABETH FREEMAN, QUEER NATIONALITY, FEAR OF A QUEER PLANET: QUEER POLITICS AND SOCIAL THEORY 209 (1985); see also HAL FOSTER, RECORDINGS: ARTS, SPECTACLE, CULTURAL POLITICS 170 (1985):

Subcultural practice differs from the countercultural (e.g., 60s student movements) in that it recodes cultural signs rather than poses a revolutionary program of its own. . . . [T]he subcultural must be grasped as a textual activity. Plural and symbolic, its resistance is performed through a 'spectacular transformation of the whole range of commodities, values, common-sense attitudes, etc.' through a parodic collage of the privileged signs of gender, class and race that are contested, confirmed, 'customized.' In this bricolage the false nature of these stereotypes is exposed as the arbitrary character of the social/sexual lines they define.

*Id.*; STUART HALL, ENCODING/DECODING IN CULTURE, MEDIA, LANGUAGE (Stuart Hall et al. eds., 1980); Keith Aoki, *Adrift in the Intertext: Authorship and Audience "Recoding" Rights*, 68 CHI.-KENT L. REV. 805, 810 (1993); Regina Austin, *Sapphire Bound!*, 1989 WIS. L. REV. 539 (considering how changes in consumption patterns in the African American community may constitute potent weapons of political and cultural resistance).

102. BERTLANT & FREEMAN, *supra* note 101, at 209.

103. *Id.* at 214.

104. The rock band Negativland attempted to employ similar tactics of Negativland. The band produced a single entitled U2 Negativland. The rock band named U2 promptly filed suit to have the albums enjoined and removed from stores. Additionally, Casey Kasem accused the band of theft and piracy because the album contained samples taken from a recording of a Casey Kasem show. The single was removed from stores and has yet to reappear. See generally NEGATIVLAND, FAIR USE: THE STORY OF THE LETTER U AND THE NUMERAL 2 (1995).

*D. Trademark Ownership:  
Legally Recognized Limitations on Identity Formation*

[T]he silence and silencing of people begins with the dominating enforcement of linguistic conventions, the resistance to relational dialogues, as well as the disablement of peoples by outlawing their forms of speech.<sup>105</sup>

Courts, in analyzing the relationship between the First Amendment and the property rights of trademark owners, focus on the need to protect political or social commentary and criticism versus the need to protect the property rights of trademark owners. This dichotomy obscures the way in which ownership in text displaces the ability of individuals to engage in the creation of self and cultural identity.<sup>106</sup> The employment of this dichotomy, and the way that it obscures the underlying issue of identity formation, is exemplified by *San Francisco Arts and Athletics* where the expressed need of the gay community was to counteract negative societal stereotypes of homosexuals through the development of the Gay Olympics. The Gay Olympics were designed to counteract the societal myth that gay men are unathletic and not fit for rigorous competition, as well as to provide a forum in which lesbians could compete athletically without being made to feel that their athletic ability made them less feminine.<sup>107</sup> Thus, the Gay Olympics was created both as a way to participate in the ongoing process of cultural formation by changing culturally held stereotypes about homosexuals, and to aid in the development of personal identity, as exemplified by the expressed need to provide lesbians an environment in

105. Norma Alarcon, *The theoretical subject(s) of THIS BRIDGE CALLED MY BACK AND ANGLO-AMERICAN FEMINISM, THE POSTMODERN TURN: NEW PERSPECTIVES ON SOCIAL THEORY* 149 (Cambridge Univ. Press 1994).

106. Coombe, *supra* note 33, at 1863 ("Uruguay Rounds, GATT systems, Dunkel Drafts, 'Special 301s,' and TRIPS Agreement enforcement provisions—these legal instruments and institutions that so effectively enforce borders ... do so by putting 'NO TRESPASSING' signs around the cultural forms and representations that provide the resources with which new identities and communities are ... forged."); Madhavi Sunder, *Authorship and Autonomy as Rites of Exclusion: The Intellectual Propertization of Free Speech in Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston*, 49 STAN. L. REV. 143, 156-57 (1996).

Property law ... is not an appropriate source for governing social learning and discourse. Although valid arguments exist for the creation of property rights in speech for minority and majority groups alike, these attempts reach an impasse when confronting the complexities of identity in today's society. Rather than a property right in speech, today's identity based politics need a revamped, culture-conscious First Amendment jurisprudence.

*Id.*

107. William A. Henry, III, *Pride and Prejudice*, TIME, June 27, 1994 at 54.

which their femininity was not questioned because of their athletic achievements and abilities.

By failing to acknowledge the important role of trademarks in identity formation, the courts fail to understand the full implications of denying nonowners trademark use. To understand this proposition, it is necessary to return to two of this Article's initial propositions. First, in postmodernity, self identity is constructed through the integration of consumption objects with self, and "the consumption of commodified representational forms is a productive activity in which people engage in meaning-making to adapt signs, texts, and images to their own agendas."<sup>108</sup> Second, the process of integration and adaptation can occur in one of two ways: either through self-extension processes that draw consumption objects into one's self-concept or through the reorientation of one's self-concept so that it aligns with an institutionally defined identity.

The process of integration is almost automatic for consumption objects in which the consumer acts as producer, but as consumers become less able to participate in the production of the consumption object, integration becomes increasingly difficult. The process of recodifying symbols or trademarks allows for individual participation in the production of trademarks because individuals are engaged in the production of meaning, and trademarks, as consumption objects, are simply the embodiment of meaning. Recodification enables individuals, through self-extension processes, to integrate trademarks by allowing for the simultaneous consumption and creation of meaning. When courts chill recodification by disallowing the use of trademarks by all but owners, they chill the ability of the individual to act as both consumer and producer. This in turn chills the individual's ability to engage in identity formation through self-extension processes. Thus, as the subtexts or meanings embodied by trademarks become increasingly fixed, individual identity formation must take the second form, that of reorienting self conception in a way that renders it consistent with institutionally defined and articulated identities.

## V. CONCLUSION

When the manner in which identity is formed is understood, the impact that the law has on identity formation is equally understood. Courts truly become places of cultural performance,<sup>109</sup> institutions in which the

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108. Coombe, *supra* note 33, at 1862.

109. Martha Minow, *Law and Social Change*, 62 *UMKC L. REV.* 171 (1993).



“events that produce transformations in socio-cultural practices and consciousness” occur.<sup>110</sup> The law, when it protects the exclusive right of trademark owners against all uses by nonowners, enables an increasingly smaller group of individuals, or corporations, to dictate how self is constructed. As individuals become increasingly disenfranchised from the production of meaning through the removal of texts from the dialogic process of recodification, they become disenfranchised from the production of cultural meaning because

Relationships between people shape identities which depend on negotiations and interactions between oneself and others. The relative power enjoyed by some people compared with others is partly manifested through the ability to name oneself and others, and to influence the process of negotiation over questions of identity.<sup>111</sup>

Increasingly, the only institute that is allowed to impregnate text with meaning is Corporate America. Hence, the self will increasingly be defined by Corporate America because the self will be forced to reconfigure personal identity so as to render it consistent with those identities articulated and approved by trademark owners. “[I]n a world where mass media tends to monopolize the dissemination of signifying forms, the cultural resources available to us (and within us) are increasingly the properties of others.”<sup>112</sup>

As individuals become disabled from the project of producing and defining personal identity, they become disabled from the project of producing and defining cultural identity. If the self is authored through the dialogic process of recodification of social signifiers,<sup>113</sup> then the ownership of these signs decreases the ability of individuals to impact cultural identity formulation because they are quite simply barred from the creation of meaning. “Those who do not have power over the story that dominates their lives, power to retell it, power to rethink it, deconstruct it, joke about it and change it as times change, truly are powerless, because they cannot

110. See JUNE STAR & JANE COLLIER, *HISTORY AND POWER IN THE STUDY OF LAW: NEW DIRECTIONS IN LEGAL ANTHROPOLOGY* (1989); Sally E. Merry, *Law and Colonialism*, 25 *L. & SOC'Y REV.* 889, 892 (1991); Gerald Torres, *Translating Yonondio: By Precedent and Evidence: The Mashpee Indian Case*, 1990 *DUKE L.J.* 625, 628 (“[T]here are specific places where most of the activities making up social life within that society simultaneously are represented, contested, and inverted. Courts are such places.”).

111. Martha Minow, *Identities*, 3 *YALE J.L. & HUMAN.* 97, 98–99 (1991).

112. Coombe, *supra* note 33, at 1866.

113. *Id.* at 1876.

think new thoughts.”<sup>114</sup> The First Amendment was designed to protect the public’s right to “think new thoughts” through the protection of democratic dialogue—a marketplace of ideas and information from which a collective understanding of our national culture can emerge.<sup>115</sup> It “isn’t just about religion or politics—it is about protecting the free development of our national culture.”<sup>116</sup>

While people in the United States have had a relatively strong right and privilege to freely express themselves, a right to engage in democratic discourse to counterbalance the property rights of corporations in imagery as intellectual property protection laws is not exported. Many cultures will be completely disabled from recodifying corporate messages because the First Amendment will not be there to free them from infringement.<sup>117</sup> The packaging and sale of intellectual property protections as the “tried and true” universally accepted minimum standards of protection is, at best, a slick marketing job replete with puffery.<sup>118</sup>

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114. Salman Rushdie, *Excerpts from Rushdie's Address: 1,000 Days "Trapped Inside a Metaphor,"* N.Y. TIMES, Dec. 12, 1991, at B8 (excerpts from a speech delivered at Columbia University).

115. *White v. Samsung Elecs. Am. Inc.*, 989 F.2d 1512, 1518 (9th Cir. 1993) (Kozinski, J., dissenting in the denial of a petition for a *en banc* rehearing).

116. *Id.*

117. The “export” of national norms is incomplete without the First Amendment or the idea of fair use. These arguably provided a “safety valve” or counterbalance when maximalist intellectual property claims threaten to eclipse speech interests.

118. Coombe, *supra* note 66, at 1366 (“Under the TRIPS Agreement, intellectual property protections which are constitutionally questionable within the United States are represented as universally-accepted minimal standards of protection.”).

