

ESSAY

TRADEMARKS UNPLUGGED

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In this Essay, Judge Kozinski urges us to reconsider the legal status of trademarks because their role has changed—that is, like Eric Clapton’s guitar, they’ve been “unplugged”: no longer do trademarks merely identify sources; frequently today they become part of the product itself. Judge Kozinski offers three examples to illustrate the implications of this phenomenon for trademark law: fake Rolex watches, New York Mets clothing, and a pirated adaptation of Sega’s Cool Spot video game. He then suggests that courts consider four factors in assessing the proper degree of legal protection to afford such trademarks: moral claims, utilitarian considerations, the potential for negative goodwill flowing from unlicensed uses, and society’s interest in free and open communication. And—oh, yeah—it’s kind of fun.

INTRODUCTION

I am pleased to be here to deliver the Sixth Annual Boal Memorial Lecture—pleased and a bit surprised. Unlike my distinguished predecessors—like Chief Judge Helen Nies, who unquestionably is an authority on trademark law, and Judge Richard Posner, who is an authority on everything—my knowledge of trademark law is rather limited and impressionistic. I’ve had my share of intellectual property cases, but I’m confident most of you here can “out-trademark” me any day of the week.

I figure the actual reason I was invited is that I know a whole lot more about video games than most of you. You can hear someone yak about trademarks any time, but how often do you get to hear the Nintendo reviewer for the *Wall Street Journal*?¹ So I thought I would talk to you about this neat new video game I bought for . . . my kids. It’s called Cool Spot and is available for the Sega Genesis system. The main character is a fat red dot with arms, legs, and a pair of shades. He (or she—it’s not clear) hops and floats across the screen, occasionally hitching rides on balloons and fighting bad guys who try to take little pieces out of him. Every so often a tiny bottle of 7-UP shows up on the screen;

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¹ See, e.g., Alex Kozinski, Guide to Nintendo Shopping, *Wall St. J.*, Jan. 31, 1990, at A16; Alex Kozinski, Judging Between Archrivals, *Wall St. J.*, Dec. 24, 1991, at A5; Alex Kozinski, Puzznic and Other Video Enigmas, *Wall St. J.*, Mar. 20, 1991, at A20; Alex Kozinski, Trouble in Super Marioland, *Wall St. J.*, July 27, 1990, at A9.

if Cool Spot drinks it, he regains his vigor. Cool Spot can gather certain letters of the alphabet—you guessed it, the letters U-N-C-O-L-A—to gain extra lives. Occasionally a giant 7-UP bottle shows up and Cool Spot has to hitch a ride on the tiny bubbles inside it to reach the top. There's really neat music, too, and lots of digitized sound effects. If you're eight-years old, you'll have no trouble hippity-hopping your way through the game, but most of you here would find it a real challenge.

What really caught my eye about the game, though, was the theme. Here a portion of a trademark—the big red dot that's part of the 7-UP logo—had been turned into a separate commodity, totally distinct from its original and traditional function. That's an interesting transmutation, though not really an unusual one. There's a growing tendency to use trademarks not just to identify products but also to enhance or adorn them, even to create new commodities altogether.² There was a time when the name of a shirt's manufacturer was discreetly sewn inside the collar. Izod and Pierre Cardin changed all that, making the manufacturer's logo an integral part of the product itself. Do you like a particular brand of beer? Chances are you can buy a T-shirt that telegraphs your brand loyalty. Some people put stickers on their cars announcing their allegiance to the Grateful Dead.³ Go figure.

It's a pretty good deal all around. The consumer gets a kick out of it, and the manufacturer gets free advertising,⁴ solidifying its name recognition and reinforcing brand loyalty.⁵ What's more, it's lucrative—not

² Lest you think this an isolated trend (destined to fizzle out, as it were), I suggest that on your next trip to Japan you stop at McDonald's, not for a burger and fries, but to try McDonald's Treasure Adventure, a videogame that Sega and McDonald's recently introduced in Japan. Wander along as Ronald McDonald searches for hidden treasures. There's nothing secret, though, about the treasure Sega and Mickie D's hope to find. Sega expects to sell 500,000 games at 6800 yen (\$64.00) each. Not bad for a clown. See Yumiko Ono, *Focus on Japan: McDonald's Serves Up Video Game*, *Clothing*, *Wall St. J.*, Sept. 17, 1993, at B1.

Other merchandisers have jumped into this market as well. New and upcoming video game releases include *Caesar's Palace*, *Aladdin*, *Jungle Book*, *Robocop versus Terminator*, and *Demolition Man*, see Nora L. Toohar, *Hasbro Teams with Video Game Firm*, *Providence Journal-Bulletin*, Aug. 27, 1993, at E1, as well as a game based on the *Cabbage Patch* dolls, see Nicholas Bannister, *Hasbro Computerizes Cabbage Patch*, *Guardian*, Aug. 27, 1993, at 14.

³ In fact, sales of Grateful Dead merchandise just keep truckin' along, as they say. See Scott Leon, *Showbiz Today: Grateful Dead Merchandise Allows Band to Prosper* (CNN television broadcast, Oct. 23, 1992) (transcript available in LEXIS, Nexis Library, Script File) (“[T]he band is still making a lot of money by marketing band merchandise.”). No wonder they're grateful.

⁴ Sometimes, a whole lot of free advertising. For example, McDonald's will spend \$20 million advertising its *Jurassic Park* tie-ins, and Kenner, a toy-maker, will spend \$8 million on the campaign. See Paula Span, *A Fit of Pre-Hysteria; Breeding the Commercial Clones of the Flick*, *Wash. Post*, June 11, 1993, at G1.

⁵ In the case of our friend Cool Spot, for example, one reviewer said it was “tempting . . . to condemn Cool Spot as a callous marketing exercise,” but ultimately concluded it was “an infuriatingly enjoyable platform game.” John Minson, *Games Reviews*, *Guardian*, July 8,

merely in enhancing sales of the product, but also as a separate profit center.⁶ Think, for example, how much money is made in products associated with sports teams⁷ and blockbuster movies.⁸

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.⁹ Where trademarks once served only to tell the consumer who made the product,¹⁰ they now often enhance it or become a functional part of it.¹¹ This trend raises

1993, at 17. He's right, too.

⁶ See, e.g., Ronald Blum, *Firm Had Something Up Its Sleeves*, L.A. Times, May 17, 1992, at D10 (noting \$4.5 million in Chicago White Sox apparel sold in 1991); Jennifer Heil, *Carmakers Win at Merchandise Name Game*, Automotive News, Sept. 6, 1993, at 20 (noting 1992 retail sales of licensed merchandise based on auto brands topped \$1.2 billion).

⁷ When the Minnesota Twins won the World Series in 1987, retail sales of postseason merchandise hit \$40 million. See Susan Feyder, *Twins Fever: Some Businesses Have It; Others Sweat it Out*, Star Trib., Oct. 1, 1991, at 1A; see also Tony Munroe, *Burgundy and Gold Sales Super—So Long as the Redskins Win*, Wash. Times, Jan. 11, 1992, at C6 (“Souvenir hawkers are racking up sales as the Redskins enjoy their best season ever.”).

⁸ For example, sales of Batman merchandise—at around \$500 million wholesale—were double the movie's box-office take. See Span, *supra* note 4, at G1. More recently, MCA/Universal licensed 100 manufacturers of official Jurassic Park products. See *id.*; see also Deborah Yu, *Sales of Spinoff Products Often Reflect a Film's Success*, Dallas Morning News, Sept. 9, 1993, at 1W (discussing marketing of film-related products).

⁹ As Judge Posner has noted:

In an age when fashion-conscious consumers wear T-shirts emblazoned with the trademarks of consumer products and owners of Volkswagens buy conversion kits to enable them to put a Rolls Royce grille on their car, it is apparent that trade names, symbols, and design features often serve a dual purpose, one part of which is functional in the sense of making the product more attractive, and is distinct from identifying the manufacturer or his brand to the consumer.

W.T. Rogers Co. v. Keene, 778 F.2d 334, 340 (7th Cir. 1985).

I made a similar point in *Plasticolor Molded Prods., Inc. v. Ford Motor Co.*, 713 F. Supp. 1329, 1332 (C.D. Cal. 1989) (“Only relatively recently have trademarks begun to leap out of their role as source-identifiers and, in certain instances, have effectively become goods in their own right.”). Unfortunately, these words of wisdom were vacated (along with the rest of the opinion), see 767 F. Supp. 1036 (C.D. Cal. 1991), *so never mind*.

¹⁰ Mankind has used marks to identify a product's owner or manufacturer since the dawn of civilization. For example, ancient Egyptian wall paintings depicted field workers branding cattle, see 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 5.01, at 5-1 to 5-2 (3d ed. 1992), and Greek vases from the fifth and sixth centuries B.C. sometimes bore the potter's insignia, see Paul Goldstein, *Copyright, Patent, Trademark and Related State Doctrines* 276 (2d ed. 1981).

In their modern incarnation, trademarks were probably first used by the medieval guilds of Europe, who relied on them “to facilitate the tracing of ‘false’ or defective wares and the punishment of the offending craftsman.” Frank I. Schechter, *The Historical Foundations of the Law Relating to Trade-marks* 47 (1925).

¹¹ See, e.g., *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 920 (9th Cir. 1980) (holding that jewelry manufacturer did not infringe fraternal organization's trademark by using fraternal insignia as functional element of jewelry), cert. denied, 452 U.S. 941 (1981); *Plasticolor*, 713 F. Supp. at 1334 (holding that trademark of auto manufacturer is not only source-identifier, but also functional element of floor mat made by different firm); *University of Pittsburgh v. Champion Prods., Inc.*, 566 F. Supp. 711, 720-21 (W.D. Pa. 1983)

questions about whether—and to what extent—the law should protect trademarks when they are pressed into service as separate products. I want to pose three hypotheticals which hopefully will shed light on various aspects of this issue.

First, take the case of prestige wristwatches. As everyone here knows, you don't have to walk very far in Manhattan before you run into somebody who'll sell you a Rolex or Piaget watch for twenty or thirty dollars, less if you drive a hard bargain.¹² Do these watches infringe rights legitimately claimed by Rolex or Piaget? Take a second example: you drive down to Shea Stadium for a Mets game. As you're crawling slowly into the parking lot, an enterprising peddler knocks on your windshield and offers you a sweatshirt bearing the Mets logo for ten bucks; a similar sweatshirt at the concession stand runs twenty-nine dollars. You'd like to show your team loyalty, but not twenty-nine dollars' worth; ten is just about right. If you buy the sweatshirt, are you infringing the Mets's legitimate rights? Finally, suppose the Cool Spot video game had not been licensed by 7-UP or Sega¹³ (as I assume it was) and, in fact, was called "Cool Spot Does Dallas."¹⁴ Does this game infringe any of 7-UP's rights? Or Sega's, for that matter?

Now, before anyone gets too excited, I acknowledge that some or all of these hypotheticals have come up under existing law. I don't mean to question the validity of the caselaw, except to note that applying trade-

(holding that university's insignia is functional element of shirts); *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188, 1195 (S.D.N.Y. 1983) (holding that likenesses, logos, trademarks, and names of recording artists are functional elements of buttons because consumers desire mark for its intrinsic value and not as its designation of origin).

¹² See David Kocieniewski, *Two Lives: Chinatown & Melville: Reputed Asian Gang Leader a Low-Profile Figure on L.I.*, *Newsday*, Aug. 15, 1991, at 4 (describing availability of black market for fake Rolex watches). In fact, the sale of counterfeit watches is a worldwide phenomenon. See Richard Cohen, *The Rolex Factor*, *Wash. Post*, Nov. 24, 1991, at W7 (noting sales of \$15 fake Rolex watches in Indonesia); *Pacific Watch: South Korea*, *L.A. Times*, Feb. 8, 1993, at D3 (noting that Seoul, Korea's Itaewon district is notorious for \$20 fake Rolex watches); Walter Skol, *Bangkok by Night is Steamy but Alluring*, *Toronto Star*, Sept. 26, 1992, at G9 (noting price of fake Rolex watches ranges from \$20 to \$100).

¹³ At the risk of shocking the innocent among you, I'll tell you that such things do happen. For example, Philip Morris U.S.A. sued Sega for allegedly using the Marlboro cigarette brand logo in a video game without authorization. In an unusual twist, Philip Morris claimed damage to its image, not because Sega's game made its cigarettes seem unappealing, but because it didn't want people to think it was marketing cigarettes to children. See *Philip Morris Files Lawsuit*, *N.Y. Times*, Feb. 22, 1991, at D5; *Philip Morris U.S.A. Files Lawsuit to Stop Trademark Violation by Video Game Company*, *Bus. Wire*, Feb. 21, 1991, available in LEXIS, Nexis Library, Wires File.

¹⁴ In case you haven't caught the reference, the movie *Debbie Does Dallas* prompted an interesting lawsuit in the Second Circuit. See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979). The Dallas Cowboys cheerleaders brought a successful suit for trademark infringement because the film—which few would call wholesome—used Dallas Cowboys cheerleader uniforms to provide context for its pornographic storyline.

mark and unfair competition law to these situations can be a bit awkward. Take the case of the Rolex. The great evil the Lanham Act¹⁵ seeks to prevent is that of consumers being duped into buying a watch they later discover was made by someone other than Rolex.¹⁶ I suppose there may be one or two people who buy fake Rolex watches for twenty dollars on the streets of New York and think they're getting a genuine \$3000 Rolex. But they probably also assume the watch was stolen so, as far as I'm concerned, they've got it coming. Usually, though, no one's fooled. The people buying the fake Rolex know they're getting a fake from the price and the venue of sale. They're buying the fakes precisely *because* they're fake; these folks want to pretend to own a Rolex without paying the price—which also means Rolex is not losing any sales because the people buying twenty dollar fakes wouldn't have bought the real thing.

There *is*, however, the problem of confusing third-parties—the recipient of a gift of the twenty dollar Rolex, for example.¹⁷ A number of courts have held this sufficient to establish a Lanham Act claim,¹⁸ as well as criminal prosecution under the Trademark Counterfeiting Act.¹⁹ But third-party confusion gets at the problem only indirectly and imperfectly. One might defend against a third-party confusion claim by showing that few people notice—or are confused by—the brand of a wristwatch. Furthermore, in circuits like my own, which have accepted the doctrines of utilitarian and aesthetic functionality,²⁰ third-party confusion might mat-

¹⁵ 15 U.S.C. §§ 1051-1072 (1988).

¹⁶ See, e.g., Edward S. Rogers, *The Lanham Act and the Social Function of Trade-marks*, 14 *Law & Contemp. Probs.* 173, 182 (1949) (explaining that Lanham Act protection enables consumers to find merchandise of known quality and gives suppliers incentive to produce better merchandise); see also William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 *Trademark Rep.* 267, 270-75 (1988) (adapted from Judge Posner's 1988 Boal Memorial Lecture).

¹⁷ For a discussion of how the Lanham Act treats third-party or post-sale confusion, see 2 J.T. McCarthy, *supra* note 10, § 23.01[4][c].

¹⁸ See *United States v. Hon*, 904 F.2d 803, 808 (2d Cir. 1990) (holding that Lanham Act's "likely to confuse" standard covers not only purchasers or even potential purchasers, but also persons who have no intention of purchasing a watch, such as recipient of a gift or someone who simply views the watch), cert. denied, 498 U.S. 1069 (1991); *United States v. Torkington*, 812 F.2d 1347, 1352 (11th Cir. 1987) (holding that likelihood of post-sale confusion by observers of those wearing counterfeit Rolex watches is sufficient to state claim under Lanham Act); *Rolex Watch U.S.A., Inc. v. Canner*, 645 F. Supp. 484, 492 (S.D. Fla. 1986) (holding that Lanham Act "endeavors not just to protect a purchaser, but instead aims to prevent mistake, deception, and confusion in the marketplace at large").

¹⁹ *Hon*, 904 F.2d at 805 (finding "likely to confuse" standard of criminal counterfeit act incorporates Lanham Act's test for likelihood of confusion).

²⁰ Trademarks cannot protect product features that are functional. Though some elements are obviously functional—such as a handle shaped to make the product easier to carry—others are functional in subtler ways. The doctrines of aesthetic and utilitarian functionality, which some courts view as distinct, see, e.g., *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378,

ter little or not at all.

Other areas of intellectual property law have some relevance to these cases but likewise do not provide a perfect fit. Copyright law may protect some logos, but not most trademarks.²¹ Moreover, copyright protection is limited in time²² and is subject to defenses not available in trademark cases.²³ Unfair competition and antidilution statutes have provided some answers. These laws vary from state to state, however, and are preempted to the extent they are inconsistent with or duplicative of federal law.²⁴

I realize that a number of courts, including my own, have solved these problems under existing law. But the solutions have been inconsistent and not always satisfactory. The fact of the matter—and the problem—is that trademarks have invaded our popular culture in ways never anticipated. Professor Rochelle Dreyfuss of this law school described the phenomenon as follows:

[I]deograms that once functioned solely as signals denoting the source, origin, and quality of goods, have become products in their own right, 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.

1382 n.3 (9th Cir. 1987), are designed to cover such situations.

As these terms suggest, an element of a product is aesthetically functional if consumers want it for its appearance—a problem very attractive people often encounter, but that's a discussion for another day. Cf. Alex Kozinski, *Confessions of a Bad Apple*, 100 Yale L.J. 1707 (1991). Meanwhile, something is functional in the utilitarian sense if consumers like it because they can use it.

This distinction comes into play only where one firm allegedly infringes on another's trade dress or packaging. See *Plasticolor Molded Prods. v. Ford Motor Co.*, 713 F. Supp. 1329, 1336 n.11 (C.D. Cal. 1989), vacated on other grounds, 767 F. Supp. 1036 (C.D. Cal. 1991). While we can offer trademark protection to aesthetically functional packaging, there is no such protection for utilitarian functionality. See *Fabrica Inc. v. El Dorado Corp.*, 697 F.2d 890, 895 (9th Cir. 1983).

²¹ See Earl W. Kinter & Jack L. Lahr, *An Intellectual Property Law Primer* 340 (2d ed. 1982).

²² See 17 U.S.C. § 302 (1988) (limiting duration of copyright to life of author plus 50 years, subject to certain exceptions).

²³ See generally 2 Paul Goldstein, *Copyright* §§ 9.1-10.3, at 147-243 (1989) (discussing legal and equitable copyright defenses and fair use exception to copyright protection).

²⁴ Thus, the dilution doctrine, for example, is limited to protecting only the most distinctive marks. See 2 J.T. McCarthy, *supra* note 10, § 24.13[1][b] (explaining difference between dilution and likelihood of confusion); see also, e.g., *Accuride Int'l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1539 (9th Cir. 1989) (holding that "ACCURIDE" is not distinctive enough to merit protection under California's antidilution statute); *Grey v. Campbell Soup Co.*, 650 F. Supp. 1166, 1175 (C.D. Cal. 1986) (holding that GODIVA's mark for chocolate is sufficiently distinctive to be protected), *aff'd*, 830 F.2d 197 (9th Cir. 1987); *Builders Square, Inc. v. Wickes Cos.*, 227 U.S.P.Q. (BNA) 644, 649 (C.D. Cal. 1985) (holding that "BUILDERS EMPORIUM" is insufficiently distinctive to merit protection); Milton W. Handler, *Are the State Antidilution Laws Compatible with the National Protection of Trademarks?*, 75 *Trademark Rep.* 269 (1985).

In a sense, trademarks are the emerging lingua franca: with a sufficient command of these terms, one can make oneself understood the world over, and in the process, enjoy the comforts of home.²⁵

It seems to me that we should confront this new reality head on, probably by amending the Lanham Act. But I'm not concerned here with the mechanics of change; instead, I want to discuss some considerations that might define the proper scope of protection for trademarks serving not just as source identifiers, but also as part of the language and as profitable commodities in their own right.

I

MORAL CLAIMS

I'll start with something not often considered in legal discussion nowadays—morality. The link between law and morality has ancient roots; indeed, the Old Testament treats these concepts as one and the same. While law and morality have diverged as our world has become more secular and complex, our shared conceptions of right and wrong still form an important consideration in creating legal rules (or at least they should). We live in a capitalist society, one whose moral code derives from Judeo-Christian ethics, as filtered through seventeenth- and eighteenth-century Enlightenment ideas. John Locke is credited with the observation that he who takes something out of a state of nature to create something useful thereby makes it his property.²⁶ Given that our system of values embraces this view, the claim "I've made it; it's mine," has strong appeal. Often the right-based moral claim is confused with, or subsumed under, the utilitarian claim, which I discuss next. But they're really quite different. Utilitarian arguments look to incentives; they ask: How can we best manipulate people's behavior by adjusting the rewards associated with various types of conduct? Moral claims are harder to quantify, but nevertheless have a force of their own. They tend to be

²⁵ Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 *Notre Dame L. Rev.* 397, 397-98 (1990) (footnotes omitted).

²⁶ As Locke put it, "The *Labour* of [one's] Body, and the *Work* of his Hands, we may say, are properly his." John Locke, *Two Treatises of Government* 287-88 (Peter Laslett ed., 2d ed. 1967) (3d ed. 1698).

For an insightful discussion of Locke's influence on intellectual property law—and also a suggestion about how Locke's legacy should be understood—see generally Wendy Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 *Yale L.J.* 1533 (1993).

As Justice Kennedy has pointed out, John Locke was not the only Enlightenment scholar to influence our understanding of property rights. See Anthony M. Kennedy, *Property and Our Constitutional Tradition: Some Hobbesian Sticks in the Lockian Bundles*, Hefner Memorial Lecture at McGeorge Law School (Oct. 24, 1991) (copy on file with the New York University Law Review).

based on the notion that people are entitled to something not as an incentive to work harder, but because it's right.²⁷

The case of the phony Rolex watches seems to carry the strongest moral charge. Rolex has spent considerable energy and money creating an image for its product;²⁸ the Rolex trademark has become a substantial part of the product itself—some might say the *most* important part.²⁹ At the same time, the counterfeiters have only weak moral claims. They are free riding on the Rolex trademark, while doing very little, if anything, creative and nothing at all to advance Rolex's interests. To the contrary: Rolex's swank image is based on exclusivity, not popularity, and the proliferation of Rolex look-alikes cuts away at that valuable commodity. To be sure, the counterfeiters have expended a little energy in copying the product, and to that extent their moral claim might be superior to that of a thief. But when it comes to selling the watches, their moral claim is negligible because the *only* reason they can do so is that they are cashing in on someone else's effort. Phooey on them!

The New York Mets's moral claim is less clear-cut. Lots of sports fans wear clothes bearing the team logo to express allegiance. Accordingly, one purpose sports merchandise serves is to develop and promote loyalty. Team merchandise also serves as free advertising, reminding people to go see or tune into a ballgame. The trademark holder's efforts in developing its market are thus only partially directed at promoting sweatshirts, banners, and the like. A large measure of the effort is intended to promote the team itself; the reward for that effort is increased attendance and TV ratings for ballgames.

Thus, in considering the relative moral claims of the parties, it is significant that the counterfeiter's efforts do not run entirely at cross-purposes with those of team owners; counterfeit Metswear also helps increase team loyalty, perhaps by making these items available to fans who can't or won't pay top dollar for the genuine article. The team owners have an unimpaired moral claim to exclusive sales of such items only to the extent they have promoted Mets merchandise separately from the

²⁷ See Ayn Rand, Patents and Copyrights, in *Capitalism: The Unknown Ideal* 130 (1967) (arguing that patents and copyrights are government protection for already existing property right).

Moral claims resonate with particular force in some cultures. For an insightful comparison of American and French notions of copyright and artistic creation, see Jane C. Ginsburg, *A Tale of Two Copyrights: Literary Property in Revolutionary France and America*, 64 *Tul. L. Rev.* 991 (1990).

²⁸ As the Supreme Court has described this moral claim, "the infringer deprives the owner of the goodwill which he spent energy, time, and money to obtain." *Inwood Lab. v. Ives Lab., Inc.*, 456 U.S. 844, 854 n.14 (1982).

²⁹ See, e.g., Patricia McLaughlin, *Bargain-Basement Special: The Status Symbol Today*, *St. Petersburg Times*, Mar. 6, 1989, at 1D.

team itself.

The weakest moral claim is that of 7-UP when it protests my hypothetically bootlegged Cool Spot game. Let's face it: 7-UP is not about to go into the video game business; the game is mainly a publicity device for promoting the soft drink. Just how successful such advertising gimmicks can be is illustrated by a 1989 movie called *The Wizard*,³⁰ which is basically a two-hour infomercial for Nintendo. The movie involves some youngsters who participate in a Nintendo championship where the finalists get to compete by playing a brand new, never released game. This turns out to be Super Mario Brothers 3. The movie gave millions of children an advance glimpse of their mustachioed hero sporting a raccoon tail, flying and doing all sorts of new and amazing tricks. By the time the game actually appeared in the stores, kids were in a frenzy of anticipation, driving their parents to distraction and pushing sales of Super Mario Brothers 3 over the \$500 million mark³¹—the biggest take ever in the entertainment industry, topping the work even of veteran money-makers Steven Spielberg and Michael Jackson.³²

Any moral claim Nintendo might make against *The Wizard*'s producers, like 7-UP's claim against our hypothetical Cool Spot, seems pretty thin. As vehicles for promoting the company's principal product, a movie or video game would serve exactly the same purpose whether or not the trademark holder licensed or sponsored it. To be sure, the trademark holder has an interest in avoiding negative associations with the product, which I will discuss below.³³ But let's say *The Wizard* had been produced entirely without Nintendo's consent—indeed, over its objection. We would have relatively little sympathy for Nintendo's claim that it was wronged. For better or worse, its bruised feelings would have been salved by all the money rolling in when Super Mario Brothers 3 became a huge success. That is, even if something had been taken from Nintendo, it received compensation for its loss. The same goes for 7-UP's complaints that its soft drink is being used in video games. The answer to the moral gripe is: What's the beef?³⁴

Sega's moral claim against the manufacturers of Cool Spot is stronger. It has developed the technology and created the market for

³⁰ *The Wizard* (Universal 1989).

³¹ See Richard A. Shaffer, *Playing Games*, *Forbes*, Aug. 16, 1993, at 108; see also David Sheff, *Game Over: How Nintendo Zapped an American Industry, Captured Your Dollars, and Enslaved Your Children* 4, 190-91 (1993).

³² See Dwight Silverman, *How Nintendo Won the Game: Invention, Ruthlessness Helped Video-Game Maker Transform Entertainment*, *Houston Chron.*, Aug. 29, 1993, at 17.

³³ See text accompanying notes 38-40 *infra*.

³⁴ For a real life example of this, see Michael W. Miller, *Sandoz Gets PR Windfall From TV Movie*, *Wall St. J.*, Jan. 10, 1994, at B1 (describing advertising windfall drug company got from TV movie).

game cartridges that play on its system. Unlike 7-UP, Sega *is* in the video game business and is affected when counterfeiters tinker with the market. Sega has a pretty good moral claim to at least part of the profit someone else makes on Sega-compatible games. But this claim is not unclouded. To begin with, Sega has sold the game deck to the consumer, who may have a legitimate moral claim to use it as he sees fit. Also, the video game market is not Sega's invention alone. Nintendo can claim a large chunk of the credit, as can Atari, Mattel, and dozens of smaller companies that have helped condition the consumer to accept a product like Sega's.

On the other side of the ledger, the bootlegger also has some equities. While he copied a portion of the work, the bootlegger has invested considerable creative resources in developing the game, and even a non-licensed Sega game can serve some of Sega's own interests—much like bootlegged Mets T-shirts serve those of the Mets. An abundance of good, unlicensed games might induce consumers to buy a Sega game deck, and then some licensed games.

II

UTILITARIAN CLAIMS

Utilitarian considerations can be as important as moral claims.³⁵ A utilitarian asks what arrangement will provide the most goods to the most people at the lowest price. In other words, a utilitarian would argue for copyright laws with the best incentives for creative output and wealth maximization. Rolex again comes out pretty well. In saying this, I make no normative judgment about whether it's good or bad that people are concerned with their image; I take it as a given that image merchandising—which emphasizes the panache a product will confer on the consumer, rather than its intrinsic quality—is a booming business and therefore reflects the preferences of a lot of people.³⁶ Accepting image as

³⁵ For an insightful discussion of utilitarian rationales for protecting intellectual property, see generally William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 *J. Legal Stud.* 325 (1989). Landes and Posner focus on the idea that if we don't protect intellectual property, free-rider problems will lead to underproduction. See id.

For a contrary view, which focuses on the deadweight loss intellectual property monopolies create, see Wendy J. Gordon, *An Inquiry into the Merits of Copyright: The Challenges of Consistency, Consent, and Encouragement Theory*, 41 *Stan. L. Rev.* 1343, 1436-37 (1989); see also Lee B. Burgunder, *An Economic Approach to Trademark Genericism*, 23 *Am. Bus. L.J.* 391, 397-402 (1985) (arguing that though monopolizing a generic mark benefits manufacturer, it harms public). Professor Litman notes that giving existing works excessive protection interferes with the creation of new works which can't borrow from past ones, something Litman considers essential to the creative process. See generally Jessica Litman, *The Public Domain*, 39 *Emory L.J.* 965 (1990).

³⁶ Some commentators, however, are intensely critical of image merchandising. Professors Collins and Skover, for example, believe that such advertising substitutes "imagery for idea"

a good—one sold by Rolex—we ask what is likely to produce the most of that good at the lowest price.

When discussing image, however, “the most for the lowest price” is an odd notion. Image denotes exclusivity and, to a large extent, price. Whatever pleasure people get from wearing an image-enhancing product is diminished if everyone else can get the same thing at a discount store. First, the proliferation of users destroys the panache that comes from being the only one on your block to own a Kozinski Unplugged® designer T-shirt.³⁷ Second, if everyone knows you can pick up the same product or an exact replica dirt cheap, how can ownership of the product help telegraph the idea that you’re the kind of swell guy who has money to burn? Keeping the supply low and the price high is thus part and parcel of the good itself; therefore, it cuts no ice to argue that letting other producers manufacture the product will give consumers more for their money. In the Rolex context—where the key is not purchaser confusion but third-party confusion—allowing replication of goods bearing the mark can have no beneficial effect; it’s a pure loss. Allowing unrestricted copying of the Rolex trademark will make it less likely that Rolex, Guess, Pierre Cardin, and others will invest in image advertising, denying the image-conscious among us something we hold near and dear.

The Mets’s utilitarian claim is quite a bit weaker. The team’s owners have an independent interest in promoting the team, regardless of whether they sell T-shirts. It’s therefore unlikely that the supply of Met-swear will dry up if others free-ride on the team’s logo. Indeed, a strong argument can be made that the public will be better off with an increased supply of paraphernalia bearing the Mets logo, which would lower the price and probably enhance selection.

and encourages “fantasized decisions by the consumer.” Ronald K.L. Collins & David M. Skover, *Commerce & Communication*, 71 *Tex. L. Rev.* 697, 698 (1993) [hereinafter Collins & Skover, *Commerce*]. As a result, they would not only strip such expression of all first amendment protection, but would use the Constitution as a grant of authority for regulating such speech by creating “a legal guarantee against the commercial culture.” *Id.*; see also generally Ronald K.L. Collins & David M. Skover, *Paratexts*, 44 *Stan. L. Rev.* 509 (1992); Ronald K.L. Collins & David M. Skover, *The First Amendment in an Age of Paratroopers*, 68 *Tex. L. Rev.* 1087 (1990).

In case you are wondering, I don’t share this view. In fact, I’ve been described as being at “the other end of the ideological spectrum” from these gentlemen. W. John Moore, *Look Who’s Talking*, *Nat’l J.*, Aug. 21, 1993, at 2073. Along with Professor Banner, who is also a pretty unplugged dude, I’ve said that commercial speech should get more, not less, constitutional protection. See, e.g., Alex Kozinski & Stuart Banner, *The Anti-History and Pre-History of Commercial Speech*, 71 *Tex. L. Rev.* 747 (1993) (mildly criticizing Collins and Skover); Alex Kozinski & Stuart Banner, *Who’s Afraid of Commercial Speech?*, 76 *Va. L. Rev.* 627, 638-48 (1990) (urgently criticizing Supreme Court’s treatment of commercial speech).

³⁷ As the cognoscenti are aware, these T-shirts made their world premiere at New York University School of Law on the date of the Boal Memorial Lecture, modelled by none other than Professor Eleanor Fox.

How about our good friend Cool Spot? 7-UP's utilitarian argument for exclusive rights to its logo seems pretty weak to me. Its strongest claim would be that consumer interest in games involving its character is necessarily limited, and that 7-UP has an interest in keeping supply low so as to keep consumer interest high. There may be something to this, although, as a video game maven, I can tell you there is *no* known limit on the number of good games a particular character will support. Look at Mario of Nintendo fame, for example, who now appears in at least ten games.

Sega's utilitarian argument is stronger. Cool Spot enhances demand for Sega products, but it also competes with other Sega games. The increased competition from a counterfeiter would increase supply and lower price. But it might also ultimately harm development of video game technology by making it more difficult for those in Sega's position to recoup their investments and make a profit.

Contrary utilitarian arguments can be made, and I certainly do not mean to preclude them here. The point is that utilitarian arguments, like moral arguments, must be weighed carefully and, to some extent, individually. The Rolex, Mets, 7-UP, and Sega cases might come out very differently.

III

NEGATIVE GOODWILL

The next interest that should be considered is the reverse of the previous two. While it might have been included as part of the analysis there, I view it as significant enough to merit its own category. I am referring to the negative goodwill that unauthorized goods generate—the affirmative destruction of the market, not by dint of competition, but by undermining consumer confidence in the product. If unlicensed items are of poor quality, or portray the product in an unfavorable light, they take away not only from the goods in the secondary market, but in the primary market as well.

Somewhat surprisingly, Rolex here fares least well. Assuming the consumer at the point of sale is not fooled into thinking he's buying a real Rolex, who cares if the thing keeps time? If you pay for a Rolex shell with cruddy innards, you're unlikely to blame Rolex when your timepiece makes you late for an important meeting. Most third-party observers normally would not know or care whether your timepiece is accurate. It's possible, I suppose, that if you're consistently late to meetings and people observe you wearing a Rolex, they'll begin to doubt whether your timepiece is reliable. More likely, though, they'll assume you're the kind of inconsiderate clod who keeps others waiting at meetings. And this

would be a fair assumption if you're late for meetings more than once because you relied on your ersatz Rolex.

The Mets have a stronger negative-image argument. People seeing Metswear of poor quality might assume it's genuine and later refuse to buy the real thing because they think the color will fade and the fabric will shrink. If the shirts portray the team in an unflattering light, the team owner has a legitimate claim not to have his trademark used for that purpose. Rolex could make a similar claim to the extent that fake Rolex watches deteriorate in appearance, misleading third-party observers into believing that genuine Rolex watches don't hold up.

7-UP's interest here would be strongest. Whatever else one might say about "Cool Spot Does Dallas," it surely will not enhance the image of the soft drink in the minds of consumers. This interest in avoiding tarnishment of intellectual property has been recognized implicitly in cases such as *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*³⁸ and *Walt Disney Productions v. Air Pirates*.³⁹ *Air Pirates* was a copyright case about whether a vulgar depiction of Mickey and Minnie Mouse was a parody and therefore covered by the fair use doctrine. The Ninth Circuit held it was not, because more of the conceptual aspects of the characters were taken than required to accomplish the parody. But I have a hard time imagining how you could do that type of parody without using the actual characters. What I think actually motivated the court in that case, as in the case of the Dallas Cowboys cheerleaders, is that unsavory use of the characters was inconsistent with the images of the products and would have had an unfairly destructive effect on them.⁴⁰

Sega might have similar concerns. Parents are notoriously bad at playing video games, and they might be inhibited from buying games for their children if it turned out that, in world four, level four, Mario not only rescues the princess, but also gets the type of reward not appropriate for viewing by minors.

IV

TRADEMARKS IN PUBLIC DISCOURSE

This brings me to the last consideration in determining what rights to allow the holder of a trademark whose role transcends identifying the source. As noted earlier, trademarks play a significant role in our public

³⁸ 604 F.2d 200 (2d Cir. 1979).

³⁹ 581 F.2d 751 (9th Cir. 1978), cert. denied, 439 U.S. 1132 (1979).

⁴⁰ For a similar view, see David H. Bernstein, A Standard for Deviation, Recorder, Sept. 22, 1993, at 8 ("[M]any of the cases in which parodies have been enjoined (either on dilution or infringement grounds) involved trademarks used in noxious contexts.").

discourse.⁴¹ They often provide some of our most vivid metaphors, as well as the most compelling imagery in political campaigns. Some ideas—"it's the Rolls Royce of its class," for example—are difficult to express any other way. That's no accident. Trademarks are often selected for their effervescent qualities, and then injected into the stream of communication with the pressure of a firehose by means of mass media campaigns. Where trademarks come to carry so much communicative freight, allowing the trademark holder to restrict their use implicates our collective interest in free and open communication.

So long as trademark law limits itself to its traditional role of avoiding confusion in the marketplace, there's little likelihood that free expression will be hindered. Whatever first amendment rights you may have in calling the brew you make in your bathtub "Pepsi" are easily outweighed by the buyer's interest in not being fooled into buying it. But once you get past the confusion rationale—as I think we should—trademark law loses this built-in first amendment compass.

How far trademark law might be stretched without offending the first amendment is an important question,⁴² but one I do not wish to address here.⁴³ Instead, I want to talk about the more general communicative interests that should be taken into account—as a matter of *policy*,

⁴¹ See, e.g., Malla Pollack, *Your Image is My Image: When Advertising Dedicates Trademarks to the Public Domain—With an Example from the Trademark Counterfeiting Act of 1984*, 14 *Cardozo L. Rev.* 1391, 1393 (1993) ("Trademarks may become communicative symbols standing for something *besides* the source or sponsorship of the product in whose service they originated.").

⁴² See, e.g., Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 *Cal. L. Rev.* 283 (1979) (advocating recognition of independent first amendment privilege in resolving conflicts between free speech and copyright); Dreyfuss, *supra* note 25, at 398-99 (constructing doctrine of "expressive genericity" to protect access to marketplace of ideas); Paul Goldstein, *Copyright and the First Amendment*, 70 *Colum. L. Rev.* 983, 988-90 (1970) (analyzing copyright's potential for conflict with first amendment as deriving from its statutory and enterprise monopolies); Pierre N. Leval, *Toward a Fair Use Standard*, 103 *Harv. L. Rev.* 1105, 1130-35 (1990) (noting first amendment issue in arguing against automatic granting of injunctive relief); Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 *UCLA L. Rev.* 1180 (1970) (examining conflicting interests and policy questions in copyright and free speech); L. Ray Patteson, *Free Speech, Copyright, and Fair Use*, 40 *Vand. L. Rev.* 1, 13-36 (1987) (arguing that copyright clause embodies first amendment constraints, thereby limiting congressional power to grant copyright); Pamela Samuelson, *Reviving Zacchini: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases*, 57 *Tul. L. Rev.* 836 (1983) (proposing two-part analysis of first amendment claims in publicity cases); Alfred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work's "Total Concept and Feel"*, 38 *Emory L.J.* 393 (1989) (examining free speech problems caused by courts' reliance on idea/expression dichotomy in copyright law).

⁴³ See, e.g., *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1519-21 (9th Cir.) (Kozinski, J., dissenting from denial of rehearing en banc) (criticizing majority's decision to grant plaintiff property rights in her person in parody case as harmful to marketplace of ideas protected by first amendment), cert. denied, 113 S. Ct. 2443 (1993).

not constitutional law—when we give wider protection to trademarks. Professor Dreyfuss's article provides a thoughtful and interesting framework for analysis. She points out that trademarks, slogans, and logos are particularly apt to fill in gaps in our language because they often describe products and services that are totally new, such as Xerox, Sanka, Kleenex, Band-Aid, and Escalator. Those names were virtually the only way to describe the items in question when they first came into use.⁴⁴ Trademarks are also likely to be adopted into the vernacular because, again, they're selected for their pleasing, roll-off-the-tongue quality. Advertising not only helps us identify products that fill our needs, but often shapes our desires altogether, associating them with the name of the brand advertised.⁴⁵

Stated another way, our 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. What starts out as a trademark or slogan quickly spills over into a political campaign, a *Saturday Night Live* skit, a metaphor, a cultural phenomenon, an everyday expression—and occasionally a fixed part of the language. Looking back in recent history, for example, "Where's the Beef" and Joe Isuzu are perhaps the only memorable aspects of the 1984 and 1988 presidential campaigns. Think back further to a time when it seemed like everyone in the country would bring a thumb and two fingers to their lips, blow off a kiss, and, in their worst Italian accent, say, "Try it, you'll like it." Or a few years later, when everyone thought they were the soul of wit when they pointed to some large object like a car or a house and drawled out, "I can't believe I ate the whole thing." How many others can you think of? "This Bud's for you." "It takes two hands to handle a Whopper." "Just do it." Even as we speak, there's a federal judge who runs around the country telling anyone who is willing to listen that a lot of tort cases can be resolved by a rule of law he calls the Toyota Principle: "You asked for it—you got it."⁴⁶

This communicative phenomenon is hardly limited to verbal slogans, or even to trademarks. Celebrities⁴⁷—particularly people in show

⁴⁴ See Dreyfuss, *supra* note 25, at 417.

⁴⁵ Collins and Skover also make this observation, but with considerably less gusto. See Collins & Skover, *Commerce*, *supra* note 36, at 698.

⁴⁶ See Alex Kozinski, *The Toyota Principle*, Address at the Lawyer's Club of San Francisco (May 9, 1991); see also Philip Carrizosa, *Kozinski: Mixed S.F. Reviews: Remarks on Self Responsibility Turn Some Off*, *L.A. Daily J.*, May 10, 1991, at 1.

⁴⁷ In at least one recent case, the celebrity—or at least a stylized likeness of him—was himself the trademark. Through a company he founded called Redsand, Inc., Steve Timmons, a professional volleyball player, sells a line of clothes that features the REDSAND trademark, a caricature of Timmons with sunglasses and a distinctive red hair cut in a high flat-top style. Thereafter, another firm created a line of private label shirts called "Red Eraser," which fea-

business—become metaphors for particular traits.⁴⁸ If you want to refer to someone as a nebbish, you call him a Woody Allen⁴⁹ type; or if it's someone who throws his weight around, you might call him the Arnold Schwarzenegger of his profession. Or if you want to evoke the image of a blonde with a waxen smile, wearing a glitzy evening gown on a game show, who could easily be displaced by a robot, you'd refer to—never mind, don't even *think* of it. You might have to pay you-know-who a royalty for the privilege.⁵⁰

The point is that any doctrine that gives people property rights in words, symbols, and images that have worked their way into our popular culture must carefully consider the communicative functions those marks serve.⁵¹ The originator of a trademark or logo cannot simply assert, "It's mine, I own it, and you have to pay for it any time you use it." Words and images do not worm their way into our discourse by accident; they're generally thrust there by well-orchestrated campaigns intended to burn them into our collective consciousness. Having embarked on that endeavor, the originator of the symbol necessarily—and justly—must give up some measure of control. The originator must understand that the mark or symbol or image is no longer entirely its own, and that in some sense it also belongs to all those other minds who have received and integrated it. This does not imply a total loss of control, however, only that the public's right to make use of the word or image must be considered in the balance as we decide what rights the owner is entitled to assert.⁵²

ured a cartoon character with a rapper haircut. Timmons sued, claiming there was a likelihood that consumers would confuse Red Eraser with REDSAND. The district court agreed. See *M'otto Enters., Inc. v. Redsand, Inc.*, 831 F. Supp. 1491 (W.D. Wash. 1993).

⁴⁸ See generally Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 *Yale L.J.* 1577 (1979) (considering portrayals published without consent); see also Samuelson, *supra* note 42, at 838-54 (discussing publicity rights).

⁴⁹ See Alex Kozinski & Eugene Volokh, *Lawsuit, Shmawsuit*, 103 *Yale L.J.* 463, 464 n.9 (1993) (explaining that Allen is more of a nebbish than a schlemiel). So distinctive is Woody Allen's persona that he has brought a series of suits objecting to what he claims are unauthorized uses of his likeness and reputation. See, e.g., *Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360 (S.D.N.Y. 1988); *Allen v. National Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985). He won; some nebbish!

⁵⁰ For the far superior view on Vanna White's claim, see *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512 (9th Cir.) (Kozinski, J., dissenting from denial of rehearing en banc), cert. denied, 113 S. Ct. 2443 (1993).

⁵¹ For an insightful discussion of the tension between free expression and property rights in ideas, images, and words, see Diane Leenheer Zimmerman, *Information as Speech, Information as Goods: Some Thoughts on Marketplaces and the Bill of Rights*, 33 *Wm. & Mary L. Rev.* 665 (1992).

⁵² Parodies, for example, present an interesting conflict between the interests of the creator of a symbol, image, or work and society's communicative interests. For example, can a beer manufacturer run a commercial in which the comedian hawking its product wears a rabbit suit and carries a bass drum? The court approved this parody of Eveready's Energizer Bunny

How do our three examples fare in this respect? Use of the term Rolex as a place holder for a “prestigious, well-crafted piece of equipment” is something that has more or less made it into the language, and we should therefore be pretty careful about restricting its use. It’s a different matter when the message communicated is: “I’m the kind of person who can afford to wear a Rolex watch.” Unless you are, in fact, willing to buy a Rolex, the message is false and should be given relatively little weight. Whatever communicative aspect may be served by wearing a fake Rolex watch—and I do think there is a communicative aspect to such conduct—is surely outweighed by the other interests I discussed earlier.

Metswear presents a far closer case. When you don a Mets shirt, your primary statement is not that you’re the type of person willing to pay \$30 for a sweatshirt; what you’re communicating is your team loyalty, and that loyalty is not something the team owns.⁵³ Having used the means and methods of advertising to inspire admiration for the home team, the Mets, I would argue, have given you a right to express that admiration in your own way, without having to pay a tribute every time you do so. This means you would have a strong claim to stencil your own Mets shirt or to make a banner praising the Mets—or burying

commercial—that is, the court said the commercial could “keep going, and going . . .,” as it were—since it created no likelihood of confusion. *Eveready Battery Co. v. Adolph Coors Co.*, 765 F. Supp. 440, 448-50 (N.D. Ill. 1991).

In contrast, a T-shirt bearing the phrase “Hard Rain Cafe: Seattle” was enjoined because the court thought consumers were likely to confuse it with that common eyesore, the “Hard Rock Cafe” T-shirt. *Hard Rock Cafe Licensing Corp. v. Pacific Graphics Inc.*, 776 F. Supp. 1454 (W.D. Wash. 1991). See generally Harriette K. Dorsen, *Satiric Appropriation and the Law of Libel, Trademark, and Copyright: Remedies Without Wrongs*, 65 B.U. L. Rev. 923 (1985) (arguing that development of tort of “satiric appropriation” impermissibly intrudes upon freedom of expression); Bernstein, *supra* note 40 (discussing legal protection of parodies).

The Supreme Court’s decision in *Campbell v. Acuff-Rose Music, Inc.*, 62 U.S.L.W. 4169 (U.S. Mar. 7, 1994), has given guidance on the copyright status of parodies. Even a parody made for a commercial purpose can constitute a fair use, as long as it has added to or “transformed” the original work. *Id.* at 4172-74. Hence, 2 Live Crew’s “Pretty Woman” (a.k.a. “Hairy Woman”), a parody of Roy Orbison’s “Oh, Pretty Woman,” may be a fair use within the meaning of § 107.

⁵³ The team’s claim becomes even weaker when we consider that sometimes the loyalty such clothing expresses is not even to the team. Some people—including one of my law clerks—wear a Mets hat to identify not only with the team, but (for reasons I don’t fully understand) also with New York City.

On a different note, members of inner-city gangs sometimes show their allegiances via sports clothing. For example, a blue Kansas City Royals hat with “KC” apparently stands for “Kitchen Crips,” while a Houston Astros hat identifies the “Hoover Street Crips.” See, e.g., Michael Wilbon & Dave Sheinin, *Gangs Suit Up in Sportswear, Leaving Games Behind*, *Wash. Post*, May 25, 1992, at C1. Tragically, in fact, innocent bystanders have been injured and even killed for unwittingly wearing the wrong clothing in the wrong place at the wrong time. See *id.*; see also Michael K. McIntyre, *Raiders Garb Sparks Youth Fight in Lakewood*, *Plain Dealer*, Dec. 3, 1992, at 1B.

them—to hang from your window on Central Park West. It's only a small step from there to say you ought to be able to pay someone to stencil the shirt or banner professionally. The other interests I've discussed would certainly also come into play, but the public's right to use the team's name, logo, and other images to express itself must be given a wide berth.

With loyalty and admiration, of course, come the reverse sentiments. Having thrust itself into the public eye, the baseball team loses not only full control of the means of communication but also its content. Thus, if the home team does something the public disapproves of, there's a very strong interest in allowing such protest to be expressed through those very images—perhaps a Mets logo exploded by a firecracker.⁵⁴ Unless a likelihood of confusion can somehow be shown, free public discourse should trump the trademark owner's control over its logo.

The final example, that of Cool Spot, raises the fewest communicative concerns. Video games generally are played in the privacy of one's home. They are notoriously introverted activities. The communicative aspects of trademarks play a relatively small role, if any at all.

CONCLUSION

We've considered four different kinds of interests implicated by giving trademark owners a more extensive property right in their marks: moral, utilitarian, goodwill, and free expression. How does a court or legislature go about balancing all of these? Well, as I tell my kids when they ask what I'll do if they run away and join the circus, I don't give advisory opinions. In truth, the hypotheticals I've sketched here indicate that results may be case-specific; many of these are close judgment calls, requiring one to balance interests that point in different directions. Applying these considerations to a particular set of facts requires a normative judgment about the relative importance of competing interests.

It is enough for today to recognize that in our culture, trademarks are doing all kinds of work they weren't originally meant to do. As their new functions become more important, so will the need for law to keep

⁵⁴ In case you've forgotten, during this past season (in which, my law clerk tells me, the Mets finished with an explosive 56 and 103 record), outfielder Vince Coleman tossed a lit firecracker from a parked car, injuring several fans. See Tom Friend, *A Tossed Firecracker, A Cloud on Coleman*, N.Y. Times, July 26, 1993, at C1. The Mets subsequently cut him from the team. See Diane Pucin, *Strange Mets Tell Coleman to be a Stranger—Forever*, Orlando Sentinel, Aug. 29, 1993, at C15. Coleman is now defending against several civil actions, see Tom Friend, *Parents of Injured Girl Plan a Lawsuit*, N.Y. Times, July 29, 1993, at B9, and has plead guilty to a misdemeanor, see *Around the Majors*, Wash. Post, Nov. 6, 1993, at 65. To those planning to go into business manufacturing Mets jackets and T-shirts with the firecracker design, please remember I thought of it first. To avoid a lawsuit, please send one dollar per shirt or jacket to the author c/o the New York University Law Review. Thank you.

up. It's critical that we consider all the interests at stake and weigh those interests by reference to current reality, not according to rules made up at another time to deal with another reality. Trademarks, trade names, logos, and the other symbols of commerce have evolved. The law must evolve with them.