March 1994

Dilution, An Idea Whose Time Has Gone; Brand Equity As Protectable Property, the New/Old Paradigm

Jerre B. Swann  
Kilpatrick & Cody

Theodore H. Davis Jr.  
Kilpatrick & Cody

Follow this and additional works at: https://digitalcommons.law.uga.edu/jipl

Part of the Intellectual Property Law Commons, and the Law and Economics Commons

Recommended Citation
Available at: https://digitalcommons.law.uga.edu/jipl/vol1/iss2/2

This Article is brought to you for free and open access by Digital Commons @ Georgia Law. It has been accepted for inclusion in Journal of Intellectual Property Law by an authorized editor of Digital Commons @ Georgia Law. Please share how you have benefited from this access. For more information, please contact tstriepe@uga.edu.
ARTICLES

DILUTION, AN IDEA WHOSE TIME HAS GONE; BRAND EQUITY AS PROTECTABLE PROPERTY, THE NEW/OLD PARADIGM*

* This article will also appear in The Trademark Reporter.

Jerre B. Swann** and Theodore H. Davis, Jr.***

I. INTRODUCTION

The touchstone for trademark protection under the Lanham Act is likelihood of confusion as to source or sponsorship.1 Dilution statutes in twenty-five states have extended protection to likelihood of injury to business reputation or dilution of the distinctive quality

1 "[T]he test for liability is likelihood of confusion: 'Under the Lanham Act, the ultimate test is whether the public is likely to be deceived or confused by the similarity of the marks. . . . Whether we call the violation infringement, unfair competition or false designation of origin, the test is identical—is there a 'likelihood of confusion?'" Two Pesos, Inc. v. Taco Cabana, Inc., 112 S. Ct. 2753, 2763 (1992) (Stevens, J., concurring) (quoting New West Corp. v. NYM Co., 595 F.2d 1194, 1201 (9th Cir. 1979) (footnote omitted)).
of a mark. It is the thesis of this Article that the positive associations that comprise a brand—a brand’s equity—can rise to the level of a property right entitled separately to protection irrespective of confusion or the existence of a dilution statute. Without more, exploitation of such associations as the principal catalyst for the sale of goods, particularly in a manner that may damage brand equity, should invoke injunctive and monetary sanctions; uses even for the expression of ideas should be carefully delineated. The likelihood of “free ride” or “negative” associations with a mark should equal the likelihood of confusion as a basis for judicial scrutiny.

In a commercial context, a solid core of decisions has clearly predicated relief on evidence of negative association:

[T]he uniform depicted in “Debbie Does Dallas” unquestionably brings to mind the Dallas Cowboys Cheerleaders. Indeed, it is hard to believe that anyone who had seen defendants’ sexually depraved film could ever thereafter disassociate it from plaintiff’s cheerleaders. This association results in confusion which has “a tendency to impugn [plaintiff’s services] and injure plaintiff’s business reputation


[T]he plaintiff has a property interest in the slogan ["Where there's life, there's Bud"], ... and ... the defendant, ... with the purpose of appropriating some of the value engendered in the minds of the public by its use has used ... a deceptively similar slogan ["Where there's life, there's bugs"] in a manner that will bring direct financial loss to the plaintiff ... by reason of the peculiarly unwholesome association of ideas when the word "bugs" was substituted in the slogan for the word "Bud," referring to a food product. 4

The evidence indicates that defendant's marks are being associated with the plaintiff's and this association adversely affects plaintiff's mark. 5

In each negative association precedent, the court paid lip-service to likelihood of confusion, and the facts bore many characteristics of a strong likelihood of confusion case, e.g., the infringing mark would not have existed but for the genuine article. 6 Likelihood of confusion itself, however, was attenuated, 7 and in the principal

---


6 For example, "Wonder Wench" would not have existed but for "Wonder Woman." See DC Comics v. Unlimited Monkey Business, 598 F. Supp. at 110.

7 For example, notwithstanding record sales volumes of both items, evidence of actual confusion in Original Appalachian Artworks v. Topps was de minimis, see Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 263 (5th Cir.) (isolated instances of confusion
free ride association case, the court so conceded. In both free ride and negative association actions, the common denominator has been the use of the infringed mark as the “triggering mechanism” for the sale of defendant’s goods, and in each, the court was offended by “a brazen [often detrimental] ... effort by the defendant ... to capitalize on the good will created by the ... plaintiff.” Given the current economic function and acceptance of trademarks, and recognition of their value and performance in the marketplace, it is submitted that such facts alone should mandate relief whether or not confusion is present. Equally, the right of a trademark owner to protect its brand equity as property must be constitutionally balanced against the right of free speech.

8 Boston Professional Hockey Ass’n v. Dallas Cap & Emblem Mfg., Inc., 510 F.2d 1004, 1012 (5th Cir.), cert. denied, 423 U.S. 868 (1975). Because the panel in Boston Professional Hockey failed to articulate a reasoned basis for its departure from the likelihood of confusion standard, the Fifth Circuit later retreated to familiar ground, see Kentucky Fried Chicken Corp. v. Diversified Packaging Corp., 549 F.2d 368, 389 (5th Cir. 1977), and abandoned the “free ride” rationale. See Supreme Assembly, Order of Rainbow for Girls v. J.H. Ray Jewelry Co., 676 F.2d 1079 (5th Cir. 1982). Other Circuits, however, have adopted Boston Professional Hockey’s “triggering mechanism” test, see, e.g., Boston Athletic Ass’n v. Sullivan, 867 F.2d 22, 35 (1st Cir. 1989) (“defendants intentionally referred to the Boston Marathon on their shirt in order to create an identification with the event and, thus, to sell their shirts”), albeit disclaiming inconsistency with a confusion standard; University of Ga. Athletic Ass’n v. Laite, 756 F.2d 1535, 1546 (11th Cir. 1985).

9 See Boston Professional Hockey, 510 F.2d at 1012. For example, an “Enjoy Cocaine” poster would have had limited success without an “Enjoy Coca-Cola” antecedent. See Coca-Cola v. Gemini Rising, 346 F. Supp. at 1187 (“[D]efendant’s assertion that ‘the poster was intended to be a spoof, satirical, funny, and to have a meaning exactly the opposite of the word content’ would be meaningless except in the context of an immediately recognizable association with the ‘Coca-Cola’ trademark.” (footnote omitted)); see also Rolls-Royce v. A & A Fiberglass, 428 F. Supp. at 695 (“It is enough that a motivating reason behind the purchase of the infringing article is its association with the trademark owner.” (citations omitted)).

II. THE ECONOMIC FUNCTION AND ACCEPTANCE OF TRADEMARKS

Trademarks were developed in the Middle Ages by the guilds to serve as indications of source and to protect against the diversion of trade. In modern economies, however, brands play a different and far more expanded role:

With respect to relatively inexpensive, frequently purchased (experience) goods with unobservable differences in quality or variety or both, trademarks enable consumers to choose the product with the particular combination of features that has previously afforded satisfaction (or to avoid a product which has not met expectations). Having decided from experimentation that one brand of detergent affords a desired level of cleaning power and fabric softening characteristics at an acceptable price, a consumer may efficiently identify that brand in subsequent purchasing transactions.

Trademark owners, in turn, are encouraged to maintain quality and variety standards to warrant continued patronage. Moreover, in seeking to differentiate their goods, trademark owners will often seek to imbue their separate brands with particular combinations of features, affording consumers a broader quality and variety spectrum.

As a consequence, trademarks for experience goods primarily transmit quality and variety signals rather than source signals and may become so identified with a combination of features embodied in a particular product that it is virtually necessary to use the trademark in discussing the product. The specific

---

11 An excellent history of the early development of trademarks is found in Thomas D. Drescher, The Transformation and Evolution of Trademarks—from Signals to Symbols to Myth, 82 TRADEMARK REP. 301, 309-20 (1992). The function of a brand in the Middle Ages was quite different: it was a "liability" mark enabling a buyer to identify a faulty artisan, and it protected not against confusion, but against invasion of the monopoly of the guild.
identity of the producer of an experience good is typically inconsequential to the consumer as is suggested by the fact that many firms market a wide array of such goods without any real effort to advertise their common source.\(^\text{12}\)

This altered economic role of trademarks is not of recent vintage. In a seminal article written almost seventy years ago, Frank Schechter postulated that brands identify products, not producers,\(^\text{13}\) and Justice Frankfurter appreciated fifty years ago the "psychological" impact and "commercial magnetism" that a trademark owner can generate by "impregnat[ing] the atmosphere of the market with the drawing power of a congenial symbol."\(^\text{14}\) Avoiding injury to the "drawing power" of trademarks was, indeed, the catalyst for development of the dilution doctrine.\(^\text{15}\)

Broader protection for trademarks consonant with their economic function was temporarily derailed in the 1930's, however, by economists led by Edward Chamberlain,\(^\text{16}\) who were concerned with "monopoly." According to this school of thought, "[b]y successfully differentiating a standardized product ... and achieving consumer brand loyalty through advertising, a producer could insulate his market share from price competition [and] create high barriers to entry ... ."\(^\text{17}\) Although partially undercut by the premise of the Lanham Act that trademarks "are the essence of competition [making] possible a choice between competing articles,"\(^\text{18}\) Chamberlin's "Harvard" school of economic thought


\(^{16}\) *See* EDWARD H. CHAMBERLIN, *The Theory of Monopolistic Competition: A Re-Orientiation of the Theory of Value* (1933); *see also* JOE S. BAIN, *Barriers to New Competition* (1956).

\(^{17}\) Daniel M. McClure, *Trademarks and Unfair Competition: A Critical History of Legal Thought*, 69 TRADEMARK REP. 305, 330 (1979). The McClure article is an excellent review of the various theories of trademark protection that have evolved and fluctuated over time.

remained a force into the 1980's, vying for acceptance with the "Chicago" school that brand advertising reduces search costs, fosters quality control and promotes entry,\textsuperscript{19} and only recently has "the hostile view of brand advertising . . . been largely . . . rejected by economics."\textsuperscript{20}

A trademark, quite simply, is not a monopoly in the underlying good, and no product market has ever been defined as narrowly as a single brand.\textsuperscript{21} The brand premium has been hypothesized as

\textsuperscript{19} McClure, \textit{supra} note 17, at 345-47.

\textsuperscript{20} William M. Landes & Richard A. Posner, \textit{The Economics of Trademark Law}, 78 \textit{TRADEMARK REP.} 267, 277 (1988). As late as 1982, this Article's senior author, citing "Harvard" school authority, wrote as to the "Domino" brand for sugar that:

Sugar is . . . a fungible commodity without significant quality variances between producers. Indeed, branded manufacturers often engage in private label packing with the result that the sugar in the "Domino" bag and the sugar sold under the grocery store's house mark may emanate from the same source. To the extent the "Domino" name creates in the consumer's mind a sense that Amstar's sugar is a "differentiated" or superior product, it does not inform; it misinforms. To the extent that "Domino" sugar commands a price premium, it does so for products which are "alike in every respect but image."

Jerre B. Swann, \textit{Bald Protectionism or a Balanced Review: A Reply to Lunsford and Cohrs}, 33 \textit{MERCER L. REV.} 1205, 1216 (1982) (footnotes omitted). This Article's junior author, then a law student, cited approvingly to "Harvard" school authority as late as 1989. See Theodore H. Davis, Jr., Comment, \textit{Applying Grecian Formula to International Trade: K Mart Corp. v. Cartier, Inc. and the Legality of Gray Market Imports}, 75 \textit{VA. L. REV.} 1397, 1418 (1989). Recognition of error dawned when, after the senior author had characterized the branding of poultry (a "commodity") as economically wasteful, a number of exposes appeared as to the unsanitary conditions in many poultry processing facilities. As Landes and Posner correctly note:

The fact that two goods [are processed commodities or, like bleach,] have the same chemical formula does not make them of equal quality to even the most coolly rational consumer. That consumer will be interested not in the formula but in the manufactured product and may therefore be willing to pay a premium for greater assurance that the [product] will actually be manufactured to the specifications of the formula. Trademarks enable the consumer to economize on a real cost because he spends less time searching to get the quality he wants.

Landes & Posner, \textit{supra}, at 277. A reduction in search costs to assure even minimum quality represents a value independent of that quality.

a return on an investment in reputation,\textsuperscript{22} and the consumer is separately benefitted both by the quality and by the information resulting from that investment. Although lacking in empirical support, the authors suggest that no society has experienced as broad a proliferation of trademarks as the United States, and no society has enjoyed as vast an array of goods at competitive prices. In our economy, even generics engage in brand competition.\textsuperscript{23}

Combined with their current economic acceptance, the sovereignty of trademarks has accelerated to the point that a host of famous brands—\textit{e.g.}, MARLBORO, MUSTANG, PEPSI, BUDWEISER, HARVARD, and CARTIER—evoke a range of images that extend beyond the quality and variety characteristics of the products themselves.\textsuperscript{24} Many brands have their own "personalities"\textsuperscript{25} and serve the function of court jesters of yore: they make consumers feel good and regal.\textsuperscript{26} Brand leveraging—using a mark on unrelated

\textsuperscript{22} Carl Shapiro, \textit{Premiums for High Quality Products as Returns to Reputations}, 98 Q. J. ECON. 659, 660 (1983):

When consumers rely on sellers' reputations, a seller who chooses to enter the high quality segment of the market must initially invest in his reputation via the production of quality merchandise. During this investment period such a seller must sell his product at less than cost: he cannot command prices associated with high quality items until his reputation is established. The necessity of investment in reputation implies that, in equilibrium, high quality items must sell for a premium above their costs of production. This premium represents the return on the initial investment in reputation.

\textsuperscript{23} See, \textit{e.g.}, Milt Freudenheim, \textit{All About Generic Pharmaceuticals: How the Big Drug Makers are Imitating Their Imitators}, N.Y. TIMES, Sept. 29, 1992, § 3, at 5.

\textsuperscript{24} See Ellen P. Winner, \textit{Right of Identity: Right of Publicity and Protection for a Trademark's 'Persona,'} 71 TRADEMARK REP. 193 (1981), for an excellent treatment of the phenomenon.


\textsuperscript{26} As one commentator has observed:

Consider the gift of a Tiffany bracelet. For most, opening a Tiffany package will feel different from opening a Macy's package—the feeling will be more intense, more special. Further, the wearing of a Tiffany bracelet may even make the wearer feel more attractive and confident than if that same bracelet had been purchased at a department store. The associations of prestige and quality are hypothesized to actually change the use experience, to add value to the brand.

DAVID A. AAKER, \textit{MANAGING BRAND EQUITY: CAPITALIZING THE VALUE OF A BRAND NAME} 161 (1991). It is not wasteful, it is submitted, for a consumer to pay a premium for a personal benefit apart from product quality, and brands additionally can have psychological
items such as T-shirts—to capitalize on a consumer’s desire to identify with a brand apart from any goods thus has come into vogue as a complement to brand extensions—expanding the good will of a mark to related goods—as a method of enhancing revenue and the fame of the brand. The “trademark has a value independent of the good it identifies [and] itself is a good.”

Even as a product in itself, the transfer of brand imagery should not occur at monopoly prices as some have feared. Rather:

Since the number of prestigious names is vast . . ., it is hard to see how any of their owners could obtain substantial license fees. Competition would drive the fees to zero, since if a name is being used in an unrelated market, virtually every prestigious name is a substitute for every other.

The charisma of a brand may be appropriated, however, without...
causing confusion, and the message it communicates can be distorted by a negative association with a use conveying a different message.

The owner of the Cabbage Patch Kids property, for example, was not seriously concerned that purchasers of Garbage Pail Kids bubble gum trading cards would be deceived as to source; rather, as Original Appalachian Artworks' President testified, she feared that the gross Garbage Pail images would make it no longer "cool" to own a Cabbage Patch Kids doll. The creation of static as to the signals transmitted by the brand, and as to its "loving" persona, was far more troublesome than was anxiety about a perceived affiliation between OAA and Topps Chewing Gum Company.

Indeed, a negative association use of a mark that has developed a persona is arguably more damaging over time than is a likelihood of confusion use. When a consumer mistakenly buys an infringing product expecting certain characteristics, the trademark owner loses an immediate sale, but is harmed for the long term only if the consumer is disappointed and does not discover the error. The set of expectations generated by a mark may or may not be distorted. A negative association, however, attacks the attributes of the brand itself and overtly distorts its image both among purchasers and potential purchasers. Although concerned with both, it is submitted that the Coca-Cola Company would rather have an occasional request for "Coke" filled with another brand than have consumers associate "Coca-Cola" with cocaine.

---

III. The Market Value and Performance of Trademarks

As is evident from the merger mania of the 1980's, brands are often more valuable than the physical assets of a business. A 1988 article, for example, reflected the recognition by corporate raiders that the true value of their targets lay in brand equity:

* RJR Nabisco was the centre of a $25 billion fight between its own management and various predators to buy the company. Nabisco biscuits and Winston cigarettes now belong to Kohlberg Kravis Roberts.

* In October another American food and tobacco giant, Philip Morris, bought Kraft, the maker of cheese of the same name, Miracle Whip toppings and Breyers ice cream. The price was $12.9 billion, four times Kraft's "tangible" assets.

* Grand Metropolitan, a British food and drinks company, looks set to take over Pillsbury for $5.5 billion—a 50% premium on the American firm's pre-bid value. Grand-Met hopes to squeeze more profits out of Green Giant vegetables and Burger King.

* Nestle paid £2.5 billion ($4.5 billion), more than five times Rowntree's book value, to gobble up the York confectionery firm that makes Kit Kat . . . and Polo.35

In Europe, companies have attempted to eliminate the discrepancy between book value and market value by including brand equity on their balance sheets.36 In 1984, Rupert Murdoch's news conglomerate increased its net worth by $600 million (143%), representing its appraisal of several acquired titles.37 In 1988, a simi-

---

35 *The Year of the Brand*, ECONOMIST, Dec. 24, 1988, at 95. See also Drescher, supra note 11, at 302-03.
36 *See John Murphy, Brand Strategy* 149-50 (1990).
lar revaluation by Guinness added £1.695 billion to its assets.\textsuperscript{38}

Brands are routinely pledged as collateral for loans,\textsuperscript{39} and trademarks are "property of the estate" within the meaning of section 504 of the Bankruptcy Code,\textsuperscript{40} as well as assets entitled to capital gains treatment under the Internal Revenue Code.\textsuperscript{41} In many companies, brand managers are more important than plant managers,\textsuperscript{42} and the company would be far more damaged by the loss of a brand than by the loss of the plant and equipment used to produce the product sold under the brand.\textsuperscript{43} Brand positioning has been raised to an art form.\textsuperscript{44}

Brands are so valuable, in part, because they instantaneously convey a wealth of information about product attributes,\textsuperscript{45} consumer benefits,\textsuperscript{46} and price.\textsuperscript{47} The true worth of brands, howev-

\textsuperscript{38} Nikki Tait, Guinness Puts Value on Brands, FIN. TIMES, Feb. 24, 1989, at 1.
\textsuperscript{40} Richard Lieb, The Interface of Trademark and Bankruptcy Law, 78 TRADEMARK REP. 307, 316 (1988).
\textsuperscript{42} As the first two of ten rules of good brand management, Murphy advises:
1. Cherish your brands. Ensure that your brands are cared for. Treat them as valuable and important assets. Ensure that they have a central role in the organisation.
2. Take brand management seriously. Treat it as a senior function and give it authority and responsibility.
\textsuperscript{43} As Julius R. Lunsford, Jr., then a member of The Coca-Cola Company's legal department, stated in 1955:

The production plants and inventories of The Coca-Cola Company could go up in flames overnight. Yet, on the following morning there is not a bank in Atlanta, New York, or anywhere else, that would not lend this Company the funds necessary for rebuilding, accepting as security only the inherent good will in its trademarks "Coca-Cola" and "Coke."

Julius R. Lunsford, Jr., Good Will in Trademarks: Coca-Cola and Coke, COCA-COLA BOTTLER (Coca-Cola Co., Atlanta, Ga.), at 27 (1955), quoted in Drescher, supra note 11, at 301-02.
\textsuperscript{44} See generally AAKER, supra note 26; MURPHY, supra note 36.
\textsuperscript{45} A VOLVO is durable; a BMW is "the ultimate driving machine"; a JAGUAR is elegant; a MERCEDES-BENZ is well-engineered.
\textsuperscript{46} CREST fights cavities; GLEEM whitens teeth; CLOSE-UP freshens breath.
\textsuperscript{47} The RITZ-CARLTON, MARRIOTT, HOLIDAY INN, DAYS INN, and MOTEL 6 marks each generate separate price expectations.
er, is their capacity, like an "old friend," to generate a distinct set of warm and welcome associations: consumers "like" BETTY CROCKER, "REACH OUT AND TOUCH SOMEONE," WEIGHT WATCHERS, LEVI'S, BAYER, KODAK, HERSHEY, MAXWELL HOUSE, CAMPBELL'S, and a myriad of other "trusted" names. Such brands not only transmit price/quality/variety signals, but they "reach over the retailer's shoulder" to communicate directly with the consumer and they engender brand loyalty, provide a "reason-to-buy," facilitate extensions to other products and afford other competitive advantages.

As should be obvious, "the management of [brand] associations . . . is both important and complex," and altering such associations can be a prelude to disaster. In the early 1970s, for example, Schlitz was the No. 2 brand of "premium" beer with a famous slogan: "You only go around once in life—so grab all the gusto you can." In 1974, its producer (a) switched to "accelerated batch fermentation" reducing fermentation time from twelve days to four; (b) replaced barley malt with corn syrup, which produced a lighter taste; and (c) used the savings to engage in aggressive discounting. Its premium, macho image evaporated and, hammered by a series of additional blunders, its brand equity fell from $1 billion in 1974 to $75 million six years later.

General Motors flirted with the same fate. In the 1920s, Alfred Sloan segmented the automobile market into five categories: CHEVROLET meant lower priced quality cars; PONTIAC signified performance oriented cars; OLDSMOBILE cars excelled in technology; BUICK vehicles focused on highway comfort; and CADILLAC

48 See, e.g., Shirley Young, Brand Equity, EXECUTIVE SPEAKER, Dec. 1989, at 10 ("When you become familiar with a brand, like a person, it becomes an old friend. It is special. We know what a friend is like. We know what to expect of him or her. We have shared experiences that build our friendship.").

49 Schechter, supra note 13, at 818.

50 The origins of substantial portions of this discussion lie in AAKER, supra note 26, the interleaf of which contains a "Brand Equity" flowchart that distills on a single page a profusion of information upon which the ensuing 275 pages astutely expound.

51 AAKER, supra note 26, at xi.

52 Id. at 78-85.

53 See David A. Aaker, Guarding the Power of a Brand Name, N.Y. TIMES, Dec 1, 1991, § 3, at 13; Caroline E. Mayer, New Coke Joins Marketing Hall of Flops; Ranks With Edsel as a Major Blunder, WASH. POST, July 12, 1985, at B1.

54 AAKER, supra note 26, at 78-85.
was the standard of luxury. In the 1980's, however, upscale vehicles appeared under the CHEVROLET mark and the Cadillac division offered the downscaled CIMMARON model; all GM cars "looked alike" and GM lost market share. In the 1990's, GM has "return[ed] to its roots": Chevrolet is again the HEARTBEAT OF AMERICA and Cadillac is "consistently upscale." Unlike Schlitz, GM appears to be recapturing its associations.

The critical fact for the purposes of this Article is that consumer associations with a brand may be damaged not only by owner miscalculation, but by third party calculation to trade on misassociations. As noted above, for example, Original Appalachian Artworks positioned the Cabbage Patch Kids as lovable, adoptable and one-of-a-kind. A bond was created between child and "Kid," and children "adopted" Kids in multiples, giving each a separate personality. As a purported parody on the "cute doll" syndrome, Garbage Pail Kids represented the antithesis of Cabbage Patch values: Garbage Pail Kids characters were ugly, hateful, and often disgusting. Twelve year old boys used Garbage Pail Kids to mock the affection nine year old girls displayed for their dolls.

In this framework, OAA was not concerned with "confusion"; rather, as its licensing agent testified, Garbage Pail Kids had an:

undeniable . . . negative effect on our whole [Cabbage Patch] program . . . . They have put an onus and a stigma on the purchase of a "Cabbage Patch Kid." . . . Instead of being a source of pride in having a "Cabbage Patch Kid," . . . not of just having one but having many, there is unquestionably . . . a stigma attached and a potential for a child to be embarrassed by virtue of the "Garbage Pail Kids," and that

---

56 AAKER, supra note 26, at 117.
58 At OAA, "doll" was a four letter word.
60 See, e.g., id. at 1036.
BRAND EQUITY

association will make them not want to have [a "Cabbage Patch Kid"] . . . .

As OAA's principal expert witness testified:

[T]he relationship built between a child and the Cabbage Patch doll [is] a very elusive and sensitive relationship, very private to that child, and to the doll which that child had adopted as its own child. . . . [A]nything that held that relationship up to ridicule, particularly among the older children, whom these children . . . considered as peers, would in net effect deter from that relationship and make them very self-conscious of it and the net end result would be a total negative effect on the Cabbage Patch program.

The testimony of both proved prescient. From 1983 through 1985, 52-53% of Cabbage Patch Kids sales were to children eight and older, the group most sensitive to peer pressure; in 1986, principally by reason of the negative publicity generated by the Garbage Pail Kids program, the percentage dropped to 42%. If in 1986 alone, the eight and older group had continued to represent 52% of Cabbage Patch Kids purchasers, sales would have approximated $275 million, as opposed to the $225 million actually generated.

Children, moreover, were not the only troubled segment. Parents wanted to know why OAA did not "do something," and 32% of

64 Consumers typically express "indignation" in such cases, see, e.g., Girl Scouts of United States v. Personality Posters Mfg. Co., 304 F. Supp. 1228, 1231 (S.D.N.Y. 1969), and expect the brand owner to react. See, e.g., University of Ga. Athletic Ass'n v. Laite, 756 F.2d 1535, 1546 (11th Cir. 1985) ("Most of those who made the inquiries [about Battlin' Bulldog Beer] were concerned that [it] was not the sort of product that should be licensed by or in any way related to the University of Georgia . . . .").
adults in a survey conducted by Topps responded they would be less likely to purchase Cabbage Patch products. As one court has thus observed, "by altering the denotation and connotation of ... marks, defendants are likely to damage plaintiff[s]." In the wake of Topps' conduct, OAA lost more than $100 million in brand equity.

IV. THE PROTECTION OF ANALOGOUS RIGHTS

Under the concept of a right of publicity, an individual's persona increasingly has been recognized as entitled to protection from commercial exploitation. Because of equity's distaste for allowing merchants to free ride on the efforts of others, a defendant may not appropriate a celebrity's name or likeness to advertise even benign goods or services, much less reproduce either in unfavorable fora. Rather, the publicity right "grants a person an exclusive right to control the commercial value of his name and likeness and to prevent others from exploiting that value without permission."

The analogy between the right of publicity and the right to protect the persona of a brand has been the subject of excellent commentary and need not be redeveloped here. Professor McCarthy, because "[a] partnership or corporation ... has no

---

67 With nurturing, the brand has regained much of its "warmth" and now enjoys a $100 million per year niche in the toy industry.
68 As one commentator has summarized the right of publicity, "[e]very man has the right to prevent the commercial exploitation of his personality, not because of its commercial worth, but because it would be demeaning to human dignity to fail to enforce such a right." Edward J. Bloustein, Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser, 39 N.Y.U. L. REV. 962, 989 (1964).
69 See, e.g., Boston Athletic Ass'n v. Sullivan, 867 F.2d 22, 23 (1st Cir. 1989).
73 See, e.g., Robert C. Denicola, Institutional Publicity Rights: An Analysis of the Merchandising of Famous Trade Symbols, 75 TRADEMARK REP. 41, 61-68 (1985); see also Winner, supra note 24.
feelings to hurt," has argued that stretching the right of publicity to cover brands "would constitute a major change and dislocation of the law," but as Judge Frank observed in the first express judicial acknowledgement of the right per se, it is not grounded in an individual's hurt feelings:

We think that in addition to and independent of that right of privacy . . . a man has a right in the publicity value of his [name and image] . . . . This right might be called a "right of publicity." For it is common knowledge that many prominent persons (especially actors and ball-players), far from having feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing . . . their countenances, displayed in newspapers, magazines, busses, trains and subways.

Moreover, whether or not there is a right of publicity of businesses, courts have afforded relief to musical groups that may

---

75 Id. at 4-44.1.
76 Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953), cert. denied, 345 U.S. 816 (1953). See also Harold R. Gordon, Right of Property in Name, Likeness, Personality, and History, 55 Nw. U. L. REV. 553, 613 (1960) ("The growing recognition by courts and litigants of the distinction between causes of action involving injured feelings and those involving appropriation, is leading to a fuller understanding of the type of harm involved and an increasing application of the proper remedy to suit the myriad factual situations which arise.").
survive changes in membership, even to the point that rights may vest in individuals other than the originators. In such cases, "[t]he rationale for [protecting the right of publicity] is [generally that] of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay." 

Equally, many businesses are closely linked to the identity of their founders—e.g., Ralph Lauren—and even where an individual name is not reflected in the company's brand, the two may be intermeshed: it is difficult to hypothesize conduct that would injure Colonel Sanders without negatively impacting KFC. In this framework, Professor McCarthy has identified the "basic elements" necessary to a prima facie case of right of publicity infringement under existing law:

1. **Validity.** Plaintiff owns an enforceable right in the identity or persona of a human being.

2. **Infringement.**
   A. Defendant, without permission, has used some aspect of the identity or persona in such a way that plaintiff is identifiable from defendant's use.
   B. Defendant's use is likely to cause damage to the commercial value of that persona.

---


80 See Rick v. Buchansky, 609 F. Supp. 1522 (S.D.N.Y.) (group's manager, as owner of name, enjoined performances by original members), aff'd, 770 F.2d 157 (2d Cir. 1985).


82 McCARTHY, supra note 74, § 3.1[C], at 3-3 (footnotes omitted; emphasis added).
Because Colonel Sanders and KFC have the same "finger lickin' good" persona, McCarthy's "of a human being" qualifier appears unnecessarily confining in this and any other context in which a brand has a distinct personality. Defining as identity misappropriation the taking for one's "own use or benefit the reputation, prestige, social or commercial standing, public interest or other values of the plaintiff's name or likeness," the Restatement (Second) of Torts does not impose the "of a human being" limitation, but instead provides that a corporation may have the "same rights . . . as those to which a private individual is entitled."

The fundamental point, however, is the fact that the common law often grows by "analogy" and "[t]he right of publicity protects interests very closely analogous to the owner's property rights in trademark 'personas'": both sets of rights are "[o]ften . . . built up at the expense of large amounts of money, time, and creative effort; and both types of rights are equally deserving of protection." Whether the right of publicity can be fully imported into trademark law is immaterial. Rather, the right of publicity and related unjust enrichment and misappropriation doctrines, together with the economic role of marks and the need of owners to manage their destinies, add up to "a surprisingly strong case for the trademark owner." As was true with news gathering in 1918, it should be true with brand equity today that:

[I]n a court of equity, where the question is one of unfair competition, if that which complainant has acquired fairly at substantial cost may be sold fairly at substantial profit, a competitor who is misappropriating it for the purpose of disposing of it to his own profit and to the disadvantage of complainant

---

83 Restatement (Second) of Torts § 652C, cmt. c, at 382 (1979).
84 Id. § 6521, cmt. c, at 403.
85 Denicola, supra note 73, at 56.
86 Winner, supra note 24, at 214.
87 For a thorough analysis that concludes with a proposed amendment to the Lanham Act proscribing any unjust appropriation of trademark goodwill, see Marlene B. Hanson & W. Casey Walls, Protecting Trademark Good Will: The Case for a Federal Standard of Misappropriation, 81 Trademark Rep. 480 (1991).
88 Denicola, supra note 73, at 85.
cannot be heard to say that it is too . . . evanescent to be regarded as property. It has all the attributes of property necessary to determine that a misappropriation of it by a competitor is unfair competition because contrary to good conscience. 89

V. TRADEMARKS AS PROPERTY

The basic fact is that many trademarks are no longer mere words indicating source but are symbols with independent value and are entitled to be protected like any other corporate asset. In this context, there is ample historical precedent for viewing infringement as a form of trespass on property, and, indeed, it is under such a theory that equity operated to protect trademarks. For example, the Second Circuit in Aunt Jemima Mills Co. v. Rigney & Co. 90 upheld entry of injunctive relief against a noncompetitive use of a mark identical to that of the plaintiff, observing:

This is a wrong which equity will enjoin without reference to the character of the article, or to the question of competition or of prior occupation of the market in any particular territory. No one has a right to apply another’s name to his own goods. If, for instance, one were to publish a book on banking under the name of a firm of bankers, it would be no answer to say that there was no competition between banking and publishing, or that the bankers had sustained no pecuniary damage, or that the book was a good book. The act would still be a trespass, for which the bankers would be entitled to at least nominal damages at law, and, that remedy being inadequate and the trespass being a continuing one, they would be entitled to relief in equity. 91

89 International News Serv. v. Associated Press, 248 U.S. 215, 239-40 (1918) (a defendant may not “reap where it has not sown”).
90 247 F. 407 (2d Cir. 1917), cert. denied, 245 U.S. 673 (1918).
91 Id. at 410.
In the 1920 Trademark Act, however, the trademark bar sought to extend the protection afforded to marks in actions *at law*, and at law, plaintiffs had traditionally been required to allege affirmative deceit. Section 3 of the 1920 Act thus provided:

That any person who shall willfully and with intent to deceive, affix, apply, or annex, or use in connection with any article or articles of merchandise, or any container or containers of the same, a false designation of origin, . . . shall be liable to an action for damages and to an action in equity for an injunction.

As the first federal statutory cause of action against the infringement of an unregistered mark, Section 3 of the 1920 Act must have represented a dramatic new weapon for brand owners, but by adopting the legal standard of deceit for both law and equity, the Act may have actually narrowed the scope of protection potentially available. In any event, by the late 1920's "the law, even in its most liberal interpretation . . ., [would] prevent the misuse of [a] mark only where there [was] an actual confusion created by . . . misuse, resulting in either diversion of trade or other concrete

---

92 As Schechter described the distinction:

The repression of trademark infringement came into the common law through an action of deceit . . . although it is the public rather than the owner of the trademark who is actually deceived . . . Equity, on the other hand, acting "in aid of" and "ancillary to" what it deemed to be a "legal right" to have a particular trademark, at first assumed jurisdiction in such cases to protect the plaintiff's "title" to trademarks, regardless of the question of deceit. Thus, in the great case of *Millington v. Fox*, Lord Chancellor Cottenham stated: "Having previously come to the conclusion that there was sufficient [evidence] in the case to show that the plaintiffs had a title to the marks in question; . . . they undoubtedly had a right to the assistance of a court of equity to enforce that title."

*Schechter, supra* note 13, at 819 (footnote and emphasis omitted).


94 Under Section 4 of the 1920 Act, a defendant could not "reproduce . . . or colorably imitate" a registered trademark "on merchandise of substantially the same descriptive properties." *See id.* at 534.
financial liability or injury to trade repute.®

In his landmark article, as noted above, Schechter characterized as “obsolete” this unified approach “that a trademark [only] designates [and can only be protected against confusion as to] either origin or ownership—in other words, source.® Perhaps, however, because trademarks had not then assumed fuller characteristics of property—they still served to “sell goods”®, they were not goods in and of themselves salable apart from the products on which they appeared—Schechter did not promote a full return to the trespass-upon-property equity paradigm.® Rather, he put forward the analogous, but more limited, proposition that owners are to be protected against “the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name.”® Among the “confusion factors” currently applied in varying formats by all federal courts,® Schechter's focus was on the strength of the brand.®

® Schechter, supra note 13, at 825. In 1927, another commentator observed that “[w]here there are no circumstances that would cause the public to think the products bearing the same name were made by the same party, no wrong is done.” Edward C. Lukens, The Application of the Principles of Unfair Competition to Cases of Dissimilar Products, 75 U. PA. L. REV. 197, 198 (1927).

® Schechter, supra note 13, at 825.

® Id. at 819.

® He referred to cases such as Aunt Jemima as “exceptions.” See id. at 821.

® Id. at 825. As one court has noted of the New York statute, in language echoing that of Schechter, dilution “is analogous to the situation where the plaintiff's building is demolished because it is carried away stone by stone.” Eastman Kodak Co. v. Rakow, 739 F. Supp. 116, 119 (W.D.N.Y. 1989) (citation omitted).

® For the tests used by the circuits, see Boston Athletic Ass'n v. Sullivan, 867 F.2d 22, 29 (1st Cir. 1989); Beer Nuts, Inc. v. Clover Club Foods Co., 805 F.2d 920, 925 (10th Cir. 1986); Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397, 399 (8th Cir. 1985); Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha, 754 F.2d 591, 595 (5th Cir. 1985); Pizzeria Uno Corp. v. Temple, 747 F.2d 1522, 1527 (4th Cir. 1984); Interface Corp. v. Lapp, Inc., 721 F.2d 460, 463 (3d Cir. 1983); Frisch's Restaurants, Inc. v. Elby's Big Boy, Inc., 670 F.2d 642, 649 (6th Cir.), cert. denied, 459 U.S. 916 (1982); AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348 (9th Cir. 1979); Helene Curtis Indus., Inc. v. Church & Dwight Co., 560 F.2d 1325, 1331 (7th Cir. 1977), cert. denied, 434 U.S. 1070 (1978); In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973); Carl Zeiss Stiftung v. VEB Carl Zeiss Jena, 433 F.2d 686, 704 (2d Cir. 1970), cert. denied, 403 U.S. 905 (1971).

® Schechter restricted his comments to arbitrary or fanciful marks and his concern was that stated in Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 259 (5th Cir.), cert. denied, 449 U.S. 899 (1980) (quoting Julius R. Lunsford, Jr., Trademark Basics, 59 TRADEMARK REP. 873, 878-79 (1969):

“If the owner of KODAK should permit its use by others on washing
Schechter's article since has become a talisman to members of the trademark bar who seek to expand the protection available to their clients.\(^\text{102}\) Ironically, however, the widespread acceptance of Schechter's theories has proven in part to be as restrictive a paradigm as the diversion of trade theories he attacked. Having (unnecessarily) dismissed the equitable concept of marks as property defensible against trespass, Schechter left only two apparent options open to reformers sympathetic to the substance of his theories. First, by tacitly acquiescing in Section 3's equation of legal and equitable standards,\(^\text{103}\) Schechter led generations of would-be reformers to target the wording of the likelihood of confusion language in that provision and its successors.\(^\text{104}\) Second, Schechter's theories led directly to the anti-dilution movement, on both the state and federal levels.\(^\text{105}\)

Even the most expansive definition of confusion, however, cannot protect the full range of property rights in brand equity, and dilution statutes: (a) have not been universally adopted;\(^\text{106}\) (b) have

powders, shoes, candy bars, or cosmetics, or if The Coca-Cola Company should permit COCA-COLA or COKE to be used for rain coats, cigarette lighters, golf balls, or jewelry not of its manufacture, it would not take long for even these giants in the trademark world to be reduced to pigmy size."

The tarnishment prong of the dilution doctrine, as expressed in cases such as Tiffany & Co. v. Boston Club, Inc., 231 F. Supp. 836, 844 (D. Mass. 1964), was a later development generally attributed to Rudolf Callmann. See 3 LOUIS ALTMAN, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 84.2 (1993 ed.).

\(^{102}\) See Kevin Parks, "Naked" is not a Four-Letter Word: Debunking the Myth of the "Quality Control Requirement" in Trademark Licensing, 82 TRADEMARK REP. 531, 531 (1992) ("Schechter's work is viewed as a cornerstone of modern trademark theory, having originated or contributed to such now-established concepts as the idea that unique and arbitrary marks are 'stronger' than their descriptive counterparts and therefore deserving of a broader scope of protection against junior uses; the concept of anonymous source; and the theory of trademark dilution.").

\(^{103}\) Schechter, supra note 13, at 820-21.

\(^{104}\) Reformers have long since discarded the requirements of the 1920 Act of an "intent to deceive" (section 3) and "merchandise of substantially the same descriptive properties" (section 4), and the Lanham Act was amended in 1962 to eliminate the requirement that the confusion had to be suffered by "purchasers as to the source of origin of such goods or services." See generally T & T Mfg. Co. v. A.T. Cross Co., 449 F. Supp. 813, 820-22 (D.R.I.), aff'd, 587 F.2d 533 (1st Cir. 1978), cert. denied, 441 U.S. 908 (1979).

\(^{105}\) See, e.g., The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors, 77 TRADEMARK REP. 375, 454 n.132 (1987).

\(^{106}\) For a list of the states that have adopted such statutes, see supra note 2.
not been uniformly applied;\(^{107}\) (c) typically do not provide for damages;\(^{108}\) and (d) by failing to accord trademarks the full accoutrements of property, may be disregarded when balanced against "higher" rights.\(^{109}\) By contrast, property rights in the physical assets of a business are constitutionally protected, and injury to such property or its unauthorized use irrespective of injury, have always been recognized nationally and uniformly as wrongs for which damages are available.\(^{110}\) In the evolved context of the autonomous brand, the same basic principles should apply, and the exclusive management of brand equity should normally be as much the province of a business as the management of a plant.\(^{111}\)

Recognition that brand equity can be "property" will avoid the uncomfortable compulsion of some courts virtually to fabricate rather than to find a likelihood of confusion in free ride and


\(^{108}\) There are exceptions: see, e.g., TENN. CODE ANN. § 47-25-512 (1988) and WASH. REV. CODE ANN. § 19.77.010.160 (West Supp. 1994).


\(^{111}\) The principal debility of the dilution doctrine lies, perhaps, in Schechter's own genius. Recognizing the evolution of brand equity at its incipiency, Schechter created the wholly new concept of brand blurring for which there were no measurements or doctrinal moorings. As one consequence, it took courts in commercially sophisticated venues more than half a century to articulate the force of Schechter's ideas, see, e.g., Allied Maintenance Corp. v. Allied Mechanical Trades, Inc., 369 N.E.2d 1162 (N.Y. 1977), and into the 1980's, dilution statutes continued "producing a checkerboard jurisprudence, thus frustrating a major goal of the federal law." Milton W. Handler, Are the State Antidilution Laws Compatible with the National Protection of Trademarks?, 75 TRADEMARK REP. 269, 285-86 (1985). The progress of trademark law might thus have been better served had Schechter been slightly less gifted, forcing him to turn to well established and understood property concepts, the analogies to which have become increasingly appropriate over time. In effect, in the period it has taken the judicial system to assimilate Schechter's views, his subject matter has moved to a higher, more traditional plane.
negative association cases, and will prevent other mischief as well. For example, in the Restatement (Third) of Unfair Competition, the reporters observe ex cathedra that:

The protection accorded by the law of trademarks is limited to the exploitation of a designation as an identifying symbol. Although the antidilution statutes extend protection to certain nonconfusing uses, they remain part of the general law of trademarks and should be applicable only to disputes involving the concurrent use of similar designations to identify goods, services, or businesses.\(^\text{112}\)

In similar fashion, the reporters conclude:

The commercial value of a highly distinctive trade symbol results from the strong association of the symbol with the goods, services, or business of a particular user. When that symbol is used by others to identify a different source, the power of the mark to evoke its original association is diluted. Nontrademark uses, which do not involve a use to identify another's goods, services, or business, however, are unlikely to have this diluting effect. In most instances such uses are intended to refer back to the original trademark owner and serve to confirm rather than undermine the associational significance of the mark.\(^\text{113}\)

In so doing, the reporters suppress one "property" concern and wholly ignore another.

First, because the use by an insecticide company of the slogan, "Where there's life, there's bugs," is a trademark use, the Restatement would apparently recognize it as dilutive of the famous

\(^{112}\) RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25 cmt. c, at 238 (Tent. Draft No. 2, 1990) (emphasis supplied). This one disagreement with Restatement views should not be read to detract from what the authors regard as an outstanding contribution to trademark law.

\(^{113}\) Id. § 25 cmt. i, at 244 (emphasis supplied).
Anheuser-Busch slogan. The display, however, by a purveyor of posters of the phrase “Enjoy Cocaine” in a familiar red logo on its product would not be a trademark use and, under the Restatement, would have to be shown to be a “defamation, or invasion of privacy, or injurious falsehood” to merit relief. From a property perspective, however, and in logic, there is no damage distinction.

It is true, of course, that “Enjoy Cocaine” refers back not to the poster purveyor, but to The Coca-Cola Company, and if source identification was the latter’s principal concern, the “joke [would reinforce] the public’s association of the mark with the plaintiff.” With celebrity brands, however, source is typically the least important and valuable of the associations transmitted by the mark, and the allusion to cocaine is no “joke” in the context of Coca-Cola’s “real thing” positioning in the marketplace.

Second, even if the merchandising use of a brand on a T-shirt mundanely “refers back to the . . . trademark owner,” it is the proprietor of a trademark property who should be entitled solely to determine how best to reinforce its “associational significance.” An owner of a famous mark may be concerned, as just one example, about overexposure among consumers—“oversaturation of the market”—and, absent confusion or defamation, such an owner should not have to endure commercial exploitation of the brand by others on promotional goods. Likewise, if Anheuser-Busch

114 Id. § 25(1).
115 Id. § 25(2). See also id. § 25(2) cmt. g, at 255.
117 To facilitate their own competing brands, companies such as Procter & Gamble avoid even anonymous source association.
118 The concern is not simply that by calling both Coke and cocaine to mind, the power of the Coca-Cola brand would be diluted. See, e.g., Robert J. Shaughnessy, Note, Trademark Parody: A Fair Use and First Amendment Analysis, 72 VA. L. REV. 1079, 1113 (1986). Rather, the concern is that the consumer, unable mentally to “disassociate” Coke from cocaine, will join the “Pepsi generation.”
119 Winner, supra note 24, at 207.
120 California prohibits such activity by statute. CAL. BUS. & PROF. CODE § 14335 (West Supp. 1994). “[T]he sheer volume of ornamental use may affect the value of the symbol as the market becomes saturated with merchandise bearing the mark.” Denicola, supra note 73, at 81. By placing its brand on 14,000 products, “Gucci” lost its glitz, AAKER, supra note 26, at 224, and to avoid the limited lives of properties such as those marketed under the CARE BEAR and MY LITTLE PONY marks, Original Appalachian Artworks rejected
desires to continue its corporate policy of discouraging the over-consumption of alcohol, it should be able to preclude others from using its brands in the associational milieu of a fraternity beer blast.121 In many businesses, again, brand managers are as important as plant managers.

To justify their broader tolerance for "nontrademark" uses, the Restatement reporters raise the specter of "serious free speech concerns" and note that "the line between a tarnishing trademark use and protected parody is difficult to draw."122 Such rationales, of course, do not justify illogical results, nor should hard questions make bad law. Of greater concern, not even the most avid free speech proponent would have sanctioned in 1967 the welding of "Hell No" onto the White House gate as a lawful expression of opposition to the Vietnam war or would condone today the spray-painting of "MURDERER" on the walls of an abortion clinic by a pro-life advocate. Clearly, the most effective expression of Klan "ideas" is the burning of a cross on an "offender's" lawn, but the First Amendment does not contemplate the invasion or destruction of private property as an acceptable form of communication.123 Accordingly, the rejection on property grounds of a free speech defense to the use of a caricature of the Reddy Kilowatt symbol on materials critical of electrical utilities124 may not be as "[un]sophisticated" as one author has asserted.125 Every famous brand

Saturday morning TV as a medium for Cabbage Patch Kids.

121 "The trademark laws are designed not only to prevent consumer confusion but also to protect 'the synonymous right of a trademark owner to control his product's reputation.' " Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd. 604 F.2d 200, 205 (2d Cir. 1979).

122 RESTATEMENT (THIRD) OF UNFAIR COMPETITION, supra note 112, § 25 cmt. i, at 255.

123 As the Supreme Court has observed in the picketing context, "'[i]n hold that store owners are compelled by law to supply picketing areas for pickets to drive store customers away is to create a court-made law wholly disregarding the constitutional basis on which private ownership of property rests in this country . . . .' " Hudgens v. NLRB, 424 U.S. 507, 517 (1976) (quoting Amalgamated Food Employees Union v. Logan Valley Plaza, 391 U.S. 308, 332-33 (1968) (Black, J., dissenting)).


125 Denicola, supra note 116, at 158. The authors would agree, however, that the "Reddy Kilowatt" example reflects a legitimate free speech use of a trademark. As a caricature, its impact on brand equity was principally predicated on the underlying force of the defendant's message, and that message was subject to the traditional free speech antidote: more speech. On the other hand, as the sound truck cases illustrate, see, e.g., Kovacs v. Cooper, 336 U.S. 77 (1949), there may be limitations on where speech can occur, and it is submitted that
owner could make every argument, save perhaps one, proffered by the Supreme Court in support of the “limited property right” conferred by Congress on the “Olympics” name, which prevailed against both commercial and political free speech attacks.

It is, of course, likely that a brand persona will no more be shielded from “emotional distress” than would be a public figure. It would, indeed, be difficult to justify a total insulation of trademarks from free speech parodies given: (i) the express statutory exposure of constitutionally based copyrights to such invasions; and (ii) the elimination by the 100th Congress of a federal dilution cause of action from the TLRA in part because of First Amendment concerns. Courts are simply unlikely to

commercial, messageless intrusions, particularly those that may damage brand equity, should not be permitted onto the property of the mark. See infra note 160.

126 San Francisco Arts & Athletics v. United States Olympic Comm., 483 U.S. 522 (1987). The arguable exception would be the “Olympic” goal “to educate young people through sport in a spirit of better understanding between each other and of friendship, thereby helping to build a better and more peaceful world.” Id. at 537.

127 The “Gay Olympics” case has been broadly criticized. See Robert N. Kravitz, Trademarks, Speech, and the Gay Olympics Case, 69 B.U. L. REV. 131 (1989). Whether or not the decision is correct, however, it does reflect the view of seven Justices that when correctly viewed as quasi-property, the rights in trademarks cannot be reflexively dismissed even in a noncommercial free speech context. The balancing process might also have been affected had it been developed in discovery that the political speech reasons given by defendant for using the “Olympics” name were largely afterthoughts, and that the name was in fact adopted when the promoters realized that it was necessary to draw on its fame in order to attract a desired level of financial and participatory support.


129 Section 107 of the Copyright Act of 1976 provides that:

the fair use of a copyrighted work . . . for purposes such as criticism, comment, [or] news reporting . . . is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;

(2) the nature of the copyrighted work;

(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

(4) the effect of the use on the potential market for or value of the copyrighted work.


130 See, e.g., H. REP. NO. 1028, 100th Cong., 2d Sess. 5-7 (1988).
entertain claims of "[trademark] misuse against legitimate news, information, and entertainment programming." 131

At a minimum, however, to paraphrase the copyright "fair use" criteria, a trademark should not be subjected under a parody banner to (i) commercial exploitation; (ii) of its brand equity; (iii) in wholesale fashion; (iv) that is directly competitive. 132 Broader protection for copyrights against parodists cannot be justified, for example, on a copyright "need-to-promote-creativity" rationale 133

---

131 Id. at 6 (quoting Letter from Douglas J. Bennet, President, National Public Radio, to the Hon. Robert W. Kastenmeier, Chairman, Subcomm. on Courts, Civil Liberties, and the Administration of Justice of the House Comm. on the Judiciary, Sept 20, 1988).

132 Nonetheless, precisely such conduct was sanctioned in Anheuser-Busch, Inc. v. L & L Wings, 962 F.2d 316 (4th Cir.), cert. denied, 113 S. Ct. 206 (1992), in which the defendant (i) sold T-shirts, (ii) using as the catalyst for sales the separately registered Budweiser label design, (iii) which defendant had replicated almost to the last detail, (iv) in competition with T-shirts sold in the same trade channels by plaintiff's licensees. See id. at 326 (Powell, J., dissenting). In setting aside a jury verdict of noninfringement, the District Court had noted that plaintiff's mark was "one of the strongest marks in this country, indeed, in the world" and that "there [could] be no question what the defendant's intent in this case was . . . . He copied the mark, he copied it to confuse the public . . . ." Transcript of Post-Trial Motions Hearing, at 52-53, Anheuser-Busch, Inc. v. L & L Wings, Inc., Civil Action No. 4:89-2247-02 (filed Sept. 11, 1989 D.S.C.). In reinstating the jury's verdict, the panel majority dismissed such "extrinsic" factors because, based on a side-by-side, abstract comparison, there were "intrinsic" differences in words defendants added to plaintiff's design mark and there was no evidence of actual confusion during the limited period in which defendants' product had been marketed. Anheuser-Busch v. L & L Wings, 962 F.2d at 320. Apart from the principle that extrinsic, marketplace factors are generally controlling in trademark actions, see Kenner Parker Toys, Inc. v. Rose Art Indus., Inc., 963 F.2d 350, 352 (Fed. Cir.) ("The test for likelihood of confusion does not focus on similarity of competing marks in the abstract."). cert. denied, 113 S. Ct. 181 (1992); see also Sun-Fun Prods., Inc. v. Suntan Research & Dev., Inc., 656 F.2d 186, 189 (5th Cir. 1981) ("[I]t is difficult to assess degree of similarity in a vacuum.")., the case should have turned on the proposition that a manufacturer should not be permitted "intentionally [to] use[] another's mark as a means of establishing a link in consumers' minds, and directly profit[] from that link." Boston Athletic Ass'n v. Sullivan, 867 F.2d 22, 35 (1st Cir. 1989). See J. Steven Gardner, Trademark Infringement, Likelihood of Confusion, and Trademark Parody: Anheuser-Busch, Inc. v. L & L Wings, Inc., 28 WAKE FOREST L. REV. 705 (1993).

133 Indeed, given the significant differences between copyright and unfair competition law, the contrary argument can be made. The underlying purpose of copyright law is the promotion of creative works. Therefore, parody is not only compatible with the rights of copyright owners, it is invited: "[P]arody and satire are valued forms of criticism, encouraged because this sort of criticism itself fosters the creativity protected by the copyright law." Rogers v. Koons, 960 F.2d 301, 310 (2d Cir.), cert. denied, 113 S. Ct. 365 (1992). Although copyright policy may thus dictate that "[i]t is decidedly in the interests of creativity, not piracy, to permit authors to take well-known phrases and fragments from copyrighted works and add their own contributions of commentary or humor," Warner Bros. v. American Broad-
because the brands that draw attention from parodists are, by definition, the end products of a very successful creative process. Consumers are richer (and can proceed with greater efficiency and confidence) in the presence of "Ivory, Camay, Dreft, Tide, Cheer, Joy, Pampers, Crest, Secret, Sure, Folgers [and] Pringles" than if confronted by "P&G bar soap [I and II], P&G laundry detergent [A, B and C], P&G dishwashing detergent, P&G diapers, P&G toothpaste, P&G deodorant [for women and for men], P&G coffee, and P&G potato snacks." While it is true that trademark owners have independent incentives to build brands, copyright owners also have separate inducements, and it is submitted that in a regime of protection for neither, there would still be many casting Cos., 720 F.2d 231, 242 (2d Cir. 1983), these interests are not similarly reflected in trademark law. Indeed, in the latter framework, such conduct is discouraged. See, e.g., Bellbrook Dairies, Inc. v. Hawthorn-Mellody Farms Dairy, Inc., 253 F.2d 431, 432 (C.C.P.A. 1958); see also Keds Corp. v. Renee Int'l Trading Corp., 886 F.2d 215, 222 (1st Cir. 1989); International Kennel Club, Inc. v. Mighty Star, Inc., 846 F.2d 1079, 1088 (7th Cir. 1988); Levi Strauss & Co. v. Blue Bell, Inc., 632 F.2d 817, 822 (9th Cir. 1980).

134 AAKER, supra note 26, at 226-27. Company or trade names are typically used in connection with consumer search goods:

With respect to more expensive, infrequently purchased (search) goods, as to which a consumer may attempt to gather information prior to making a buying decision, trade names or house marks may signal a quality standard extending to multiple products within a category. While a typical consumer will not purchase in a lifetime a sufficient number of refrigerators upon which to predicate a future decision as to such a purchase, the same consumer may well purchase a sufficient number of refrigerators, toasters, blenders, can openers and similar products to make generalized quality assessments of firms in the appliance category. If the category is sufficiently broad, and if meaningful information is difficult to acquire, search goods assume certain characteristics of experience goods and, as with experience goods, efficiency may thus be enhanced by the use of trademarks. Unlike the case with experience goods, however, the identity of the producer (or sponsor) of search goods is of obvious significance to the consumer.

Swann, supra note 12, at 67. Another pertinent difference between trademarks and trade names is that the signals transmitted by the latter can be "noisy" in that the quality level across an array of products will rarely be uniform. Economides, supra note 12, at 531. If Procter & Gamble thus used "P&G [generic name]" on all its products, it is unlikely that consumers would be as well informed as they are by Procter & Gamble's multi-brand strategy.

135 Denicola, supra note 116, at 178-79.

136 As Samuel Johnson observed, "no man but a blockhead ever wrote, except for money." 3 BOSWELL'S LIFE OF JOHNSON 19 (G. Hill ed., 1934).
literary and artistic works, but few, if any, trademarks.  

In an equal status regime, commercial use of a copyright does not meet the fair use threshold unless it is "transformative":

If ... commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another's work diminishes accordingly (if it does not vanish) ... .  

The same guidelines should apply to brands, and "courts should not accord fair use protection to profiteers who do no more than add a few silly words to someone else's or place the characters from a familiar work in novel or eccentric poses."  

Likewise, the copyright "fair use" defense seldom prevails in the face of evidence, under the fourth factor, of an adverse effect on

137 "The[] manifold purposes and benefits of the Lanham Act only operate ... if investments to secure a strong, recognizable mark bring the reward of certain legal protection." Kenner Parker Toys, Inc. v. Rose Art Indus., Inc., 963 F.2d 350, 354 (Fed. Cir.), cert. denied, 113 S. Ct. 181 (1992). In the absence of brands: consumers could only learn about the quality distribution of an industry as a whole [and] a manufacturer would gain little or nothing from improving his product's quality. Consumers would be unable to recognize high- or low-quality brands, so sales would tend to go to manufacturers who reduce their price by cutting corners on quality. The result would be a race to produce inferior products rather than competition to produce better ones.  


139 Id. at 1181 (Kennedy, J., concurring) (citing Walt Disney Prods. v. Air Pirates, 581 F.2d 751 (9th Cir. 1978), cert. denied, 439 U.S. 1132 (1979) and DC Comics Inc. v. Unlimited Monkey Business, Inc., 598 F. Supp. 110 (N.D. Ga. 1984)).
"the potential market for or value of the copyright," and it has been recognized that such an adverse effect can exist apart from a showing of direct competition between the parties. In *OAA v. Topps*, for example, the court relied on testimony of OAA's expert quoted above to find that Garbage Pail Kids would "have a serious negative impact on the Cabbage Patch Kids program," and concluded that "Garbage Pail Kids are likely to harm the potential market for or the value of the Cabbage Patch Kids products."

It is true, of course, that "critical commentary" can lawfully destroy the value of a copyrighted work, but it was not the force of Topps' message that harmed OAA; rather, Garbage Pail Kids commercially capitalized on the original by placing it "in incongruous settings . . . engaged in activities antithetical to [its] values." Under a copyright fair use banner, defendants ought not "augment the commercial value of their own property by creating new, and detrimental, associations with plaintiff's property."

Equally concerning for trademark purposes, therefore, should be asserted free speech parodies that play on a brand's positive associations, not principally to send a message or criticize, but commercially to capitalize, by utilizing negative associations, on prurient interests. The real property or equity in brands is their potential derived from their associational value to generate revenue, and the "L.L. Bean" persona should not be smeared with pornography if, in addition to offending sensitivities, it was

---

140 As the Supreme Court has noted, "[effect on the market] is undoubtedly the single most important element of fair use. 'Fair use, when properly applied, is limited to copying by others which does not materially impair the marketability of the work which is copied.'" *See, e.g., Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 566-67 (1985) (citation omitted).


142 *Campbell v. Acuff-Rose*, 114 S. Ct. at 1178.


established that the calumny detracted from the selling power of the mark. And no free speech advocate would condone false suggestions about a brand that would be likely to turn consumers away.

How courts ultimately will resolve the free speech/parody issue is beyond the scope of this Article. The distinction between a legitimate lampoon and a "commercial take-off... rationalized post hoc as a parody" may never be clearly drawn. At a minimum, however, there must be a balancing of: "(1) the nature and extent of the owner's injury if the speaker is permitted to use the property; (2) the speaker's interest in using the property to express himself; and (3) the public interest in allowing the speaker to use the property." As to the first of these competing interests, it is naive to suggest that there is "potential harm to the trademark owner" only "if a parody creates a genuine likelihood that consumers will believe

and the evidence relied on by plaintiff to show harm to the commercial magnetism of its brand—two conclusory affidavits that the quality and integrity of the mark would be impaired, without any specific explication, as was provided in OAA v. Topps, as to how the selling power of the brand might be harmed—would appear insufficient for the purpose. The problem, however, with the L.L. Bean decision is that even if plaintiff had shown damage to brand equity, it is unlikely that the First Circuit would have balanced such proof against First Amendment considerations.

In Hustler, Falwell did not allege that the parody had impaired his ability to generate funds for his church. Indeed, he used the "outrageous" portrayal that his "first time" had been in a "drunken incestuous rendezvous with his mother in an outhouse," Hustler Magazine, Inc. v. Falwell, 485 U.S. 46, 48 (1988), to attract contributions. See Hustler Magazine, Inc. v. Moral Majority, Inc., 796 F.2d 1148 (9th Cir. 1986).

"False statements of fact are particularly valueless." Hustler Magazine v. Falwell, 485 U.S. at 52. If, therefore, an appreciable percentage of consumers were to understand from a use of "Michelob Oily" not only that the author was commenting on an environmental issue, but that MICHELOB beer, in fact, contained contaminated water, the First Amendment would not be implicated. "The First Amendment... does not prohibit the State from insuring that the streams of commercial information flow cleanly as well as freely." Denicola, supra note 116, at 165. Such principles, however, were overlooked in Anheuser-Busch, Inc. v. Balducci Publications, 814 F. Supp. 791 (E.D. Mo. 1993), in which a parody defense was sustained notwithstanding a survey showing that many respondents believed from reviewing defendant's mock ad that MICHELOB beer was impure. See id. at 797 n.5.


Shaughnessy, supra note 118, at 1112 (interpreting Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977)).
that the trademark owner sponsored it."\textsuperscript{150} Likewise, the statement that a "trademark parody dilutes its target only by adding a humorous picture of the mark to the collection of images the owner has created for it"\textsuperscript{151} fundamentally ignores marketplace realities, particularly if the "humorous picture" is, in fact, not humorous to the plaintiff's existing or potential customers.\textsuperscript{152}

As for the second competing interest, use on a T-shirt of "The King of Beaches" within the borders of the famous, separately registered Budweiser label design for, \textit{inter alia}, T-shirts, is at best a commercial take-off—the adding of "a few silly words" in a feeble effort to justify appropriation of Anheuser-Busch's property.\textsuperscript{153} It may be that trademarks will never be protected from nondestructively creative "spoofs" where the "trigger" for sales is far more the "infringer's" ingenuity than any free ride on the magnetism of the brand.\textsuperscript{154} Likewise, in cases involving genuine commentary on a

\textsuperscript{150} Id. The very existence of the antidilution movement testifies to the infirmity of such a proposition. Although a successful parody immediately conveys the message that it is not the original, see Cliff's Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc., 886 F.2d 490, 494 (2d Cir. 1989), the likelihood of confusion question should initiate, not end, the analysis. Trademark parody cases should not be, any more than other trademark association cases, reflective only of a narrow focus on the likelihood of confusion.

\textsuperscript{151} Shaughnessy, \textit{supra} note 118, at 1113.

\textsuperscript{152} As the court noted in Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183, 1191 (E.D.N.Y. 1972):

[T]he real thrust of plaintiff's claim is that unless defendant's unauthorized use of the "Coca-Cola" trademark and format is enjoined, plaintiff's good will and business reputation are likely to suffer in the eyes of those who, believing it responsible for [or acquiescent to] defendant's poster, will refuse to deal with a company which would seek commercial advantage by treating a dangerous drug in such a jocular fashion [or would permit others to do so].

\textsuperscript{153} In Anheuser-Busch, Inc. v. L & L Wings, Inc., 962 F.2d 316 (4th Cir.), \textit{cert. denied}, 113 S. Ct. 206 (1992), there was minimal creativity and no "message" from a parodist whose admitted principal purpose was to sell T-shirts by trading on the value of the Budweiser label. That case, and Anheuser-Busch, Inc. v. Florists Ass'n, 603 F. Supp. 35 (N.D. Ohio 1984) should have been otherwise resolved on the basis that, to repeat, "[n]o social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay." Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 576 (1977) (quoting Harry Kalven, \textit{Privacy in Tort Law—Were Warren and Brandeis Wrong?}, 31 LAW & CONTEMP. PROBS. 326, 331 (1966)). See \textit{supra} note 81.

\textsuperscript{154} See Jordache Enters., Inc. v. Hogg Wyld, Ltd., 828 F.2d 1482, 1483 (10th Cir. 1987) (upholding finding of noninfringement where word "Lardashe" appeared immediately beneath a pink pig peeking from rear pocket of jeans for plump women).
plaintiff's mark, First Amendment concerns may protect the defendant.\textsuperscript{155} Where, however, a free ride is the principal explanation for the parody, and particularly where there is damage apart from consumer confusion,\textsuperscript{156} the property right in the brand should be accorded the greater weight.

Likewise, a speaker should not be able to appropriate a trademark to comment generally on public issues unrelated to the mark,\textsuperscript{157} particularly when that commentary may harm the equity in the brand.\textsuperscript{158} And ultimate resolution of the scope of the parody/free speech defense should also require an examination of alternative channels of communication not resulting in damage to a mark that are available to speakers who legitimately seek to criticize the brand or its owner.\textsuperscript{159}

As for the third competing interest, there is no private right in any property that is absolute: the owner of a plant may not pollute the atmosphere because of the countervailing public interest in the environment. Likewise, even though comparative advertising, by definition, may afford a free ride on brand equity, and a \textit{Consumer Reports} article may damage that equity, both uses reflect the public's countervailing interest in full and fair information.

\textsuperscript{155} To reiterate, the "Reddy Kilowatt" case, Reddy Communications, Inc. v. Environmental Action Found., 199 U.S.P.Q. (BNA) 630 (D.D.C. 1977), should have been resolved on the basis that the defendant's use did represent a legitimate lampoon involving genuine commentary.

\textsuperscript{156} The Fourth Circuit having condoned in Anheuser-Busch, Inc. v. L & L Wings, Inc., 962 F.2d 316 (4th Cir.), cert. denied, 113 S. Ct. 206 (1992), the words "King of Beaches" within red scroll-work duplicative of the Budweiser label, Anheuser-Busch was next confronted with shirts bearing the legends "King of Butts" and "King of Rears" within such scrollwork accompanied by "thonged" female derrieres, a presentation that many women rightfully would regard exploitative and about which they would expect Anheuser-Busch to "do something." See Anheuser-Busch, Inc. v. Pacific Beachwear, Anheuser-Busch, Inc. v. Bargain Beachwear, and Anheuser-Busch, Inc. v. USA Beachwear, Nos. 4:91-1744-2, 4:91-1743-2, and 4:91-1742-2 (D.S.C. filed June 17, 1991).

\textsuperscript{157} Cf. Rogers v. Koons, 960 F.2d 301, 310 (2d Cir.) ("[T]hough the satire . . . may . . . also be a parody of modern society, the copied work must be, at least in part, an object of the parody.")., cert. denied, 113 S. Ct. 365 (1992); Fisher v. Dees, 794 F.2d 432, 436 (9th Cir. 1986) ("[A] humorous or satiric work deserves protection under the [copyright] fair-use doctrine only if the copied work is at least partly the target of the work in question.").


\textsuperscript{159} See Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 206 (2d Cir. 1979) (holding that "[b]ecause there are numerous ways in which defendants may comment on 'sexuality in athletics' without infringing plaintiff's trademark, the district court did not encroach upon their first amendment rights in granting a preliminary injunction").
It is submitted, however, that it approaches the bizarre to suggest that virtually all "satirical" uses of trademarks, irrespective of damage to their associations or equity, should be sanctioned as free speech because they convey the "important message" that "business and product images should not be taken too seriously." Rather, a balanced assessment of trademark property and the First Amendment must recognize that usages such as GENITAL ELECTRIC are far more exploitative than expressive, having only "marginal [if any] implications for free speech rights."

No doubt in this context the purveyor of "Roadkill Helper" believed its "spoof" was harmless and reinforced the fame of HAMBURGER HELPER, but it may have misjudged the reaction of at least some consumers, both with its original offering and its follow-on, "Spotted Owl Helper," and it would be of little comfort to General Mills if, hypothetically, while 80% of consumers were amused, the remaining 20% purchased at the margin and, confused or not, were "put off" by the "distasteful" association. The principal point, however, is that Roadkill Helper conveys no free speech "message" and it is General Mills, not a third party, who should decide what is best for its brand. In this framework, General Mills has positioned its HAMBURGER HELPER products, inter alia, as "quality" goods to allay any concern, which some consumers have as to any "dry mix," that they produce a less wholesome meal, and if General Mills believes that "Roadkill

---

160 Shaughnessy, supra note 118, at 1109. As Denicola far more perceptively recognizes, in the context of TARZAN photographs in an adult magazine:

It would be an exaggeration for the defendant to maintain that any tarnishment of the plaintiff's trademark is the result of the persuasiveness of the ideas being communicated. The injury stems not from the force of the defendant's speech, but rather from the mere appearance of the mark in an unwholesome environment. The trademark owner is unable to minimize the harm by countering the defendant's speech with speech of his own. There are here no ideas to dispute, no claims to rebut. The affixing of undesirable associations to the trademark, once done, cannot be undone by further speech. Recalling the Supreme Court's analysis of another first amendment case, such uses "by their very utterance inflict injury."

Denicola, supra note 116, at 202-03 (quoting Chaplinsky v. New Hampshire, 315 U.S. 568, 572 (1942)).

161 Id. at 202.

"Helper" contradicts the "image" or positioning of its brand, it should not be frustrated in managing its property by the law's singular focus on confusion.

Likewise, because HAMBURGER HELPER mixes are impulse items, General Mills may legitimately fear that buyers, having seen the Roadkill product, will not "thereafter disassociate it from" HAMBURGER HELPER in their minds and that their impulse to reach for HAMBURGER HELPER products will be dampened. Clearly, if General Mills' "real" property was being used as a public dump, it could respond to neighbors' demands that it "do something" about the resulting eyesore. It should likewise be able to prevent the trashing of its brand. Continuing in such cases to analyze protection only in likelihood of confusion terms is counterproductive.

While, therefore, it is unlikely that the property interests in brands will ever be treated as rights in gross, marks simply cannot be viewed as mere abstract indications of source, subject to damage only when consumers are misled. A brand's property value can be as fragile as a Steuben vase and is entitled to constitutional recognition. In no event can the complex of issues simply be ignored as presenting questions difficult to resolve.

This is not to say that likelihood of confusion will be displaced as an analytic tool. To the contrary, the existence of actual confusion and evidence of likelihood of confusion will continue to be the best,

---


164 On even the most basic level, the requirement that a mark actually be in or on the threshold of use as a mark before qualifying for protection dramatically distinguishes trademark rights from the true property rights in gross granted by patents and copyrights. See, e.g., Tally-Ho, Inc. v. Coast Community College Dist., 889 F.2d 1018, 1022 (11th Cir. 1989) ("Under the common law, trademark rights are appropriated only through actual prior use in commerce. Trademark ownership is always appurtenant to commercial activity. Thus, actual and continuous use is required to acquire and retain a protectible interest in a mark." (citations omitted)).

165 Tort law generally has not shrunk from addressing difficult questions simply because they are difficult. For example, early twentieth century cases did not permit recovery for emotional distress resulting from "mere words, however violent," in substantial part because of the apparently ephemeral nature of the injury. See W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS § 12, at 56-57 (5th ed. 1984). Ultimately, however, the general rule became that one is liable for "conduct exceeding all bounds usually tolerated by decent society, of a nature which is especially calculated to cause, and does cause, mental distress of a very serious kind." Id. at 60 (citation omitted).
and often most readily available, proof that a trespass is occurring. Nor is this to say that the mere adoption of a mark "similar" to one already in use will mandate judicial intervention. There must still be a trespass—some form of impermissible "association"—and in recognition of the truism that "there are, and can be, few, if any, things, which, in an abstract sense, are strictly new and original throughout," even some forms of nondestructively creative association will pass scrutiny. If, however, the economic and marketplace realities of brands are to be acknowledged, likelihood of confusion must be only one form of association with which the courts are concerned.

Courts must involve themselves not only with weighing confusion factors, but with identifying the associations that constitute brand equity and asking whether those associations have been appropriated or damaged. Will, for example, any negative associations attached by the defendant linger over time, deflecting the owner's positioning of the brand and sapping both its immediate and long term potential to produce sales? Equally, is the principal sales trigger the defendant's transformative ingenuity or a play on the reputation of the brand? Given, moreover, the clear informational and other benefits derived from brand equity, both by owners and consumers, courts must ask whether misassociational static generated by a defendant's conduct offers countervailing benefits sufficient to warrant its condonation. If a free speech defense is proffered, courts should ask whether defendant's use may be rebutted by more speech or whether it is so amorphous or destructive as to preclude an effective response. At each level of the inquiry, viewing brands as hard, constitutionally protected assets, not as mere abstractions, will lend appropriate balance to the analysis.

166 Emerson v. Davies, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845).

167 See Toho Co. v. Sears, Roebuck & Co., 645 F.2d 788 (9th Cir. 1981) (BAGZILLA for "monstrously strong" garbage bags did not infringe GODZILLA for a giant green lizard); Universal City Studios, Inc. v. Nintendo Co., 746 F.2d 112 (2d Cir. 1984) (DONKEY KONG did not infringe KING KONG, both involving gorillas, tall buildings and blond women).
VI. CONCLUSION

As Schechter observed in 1927:

"There is no part of the law which is more plastic than unfair competition, and what was not reckoned an actionable wrong 25 years ago may have become such today." . . . "Many earlier dicta, probably some earlier decisions, are not now safe guides." These vigorous judicial expressions of impatience with the old theories of trademark protection are indicative of a desire to keep abreast of and to serve the needs of modern business. 168

When trademarks only indicated source, likelihood of confusion was a fully adequate measure of infringement. It prevented deception of consumers and diversion of trade alike. As, however, trademarks have fully evolved into business assets, likelihood of confusion often bears no relationship to the appropriation of their values.

In a related framework, trademark practitioners twenty-five years ago referred to themselves as such; today they refer to themselves as "intellectual property" counsel, and the law has been moving in the same direction. 169 A brand, quite simply, stakes out an image, defined by associational markers in the consumer's mind, and to the extent that another "poaches" 170 on the metes and bounds of the image, the brand owner is entitled to seek protection both unconstrained by the limiting concept of confusion and with the appreciation that the Fifth Amendment stands in parity with the First. We have come full cycle, and it is now time to restore the equity paradigm of a century ago.

168 Schechter, supra note 13, at 813 (footnotes omitted).
169 See, e.g., Denicola, supra note 116, at 159 ("To say that the law appears increasingly willing to accord trademarks the status of property may not be a particularly helpful characterization of modern trademark law, but it does emphasize that today's doctrine somehow differs from yesterday's.").