

## OPPORTUNISTIC TRADEMARKING OF SLOGANS: IT'S NO CLOWN ISSUE, BRO<sup>♦</sup>

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### *Abstract*

In June 2012, Bryce Harper, the Rookie of the Year ballplayer for the Washington Nationals, responded to a reporter's inquiry with the statement, "That's a clown question, bro." The humorous retort was aired widely in the media, and gained such popularity that even Senate Majority Leader Harry Reid used it at a press conference. The day after Harper made the statement, he filed an intent-to-use trademark application for the slogan on t-shirts, hats and other types of products typically used by owners to express their personalities (herein called "billboard products"), and the United States Patent and Trademark Office ("PTO") quickly gave its approval for registration. The incident raised questions about the propriety of using trademarks to gain exclusive rights to display clever or influential slogans, such as "Three-Peat" and "Let's Roll," on billboard products. This article explains why the PTO, under most circumstances, should not be so quick to register such phrases, but instead should wait until the applicant can demonstrate secondary meaning.

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## INTRODUCTION

On June 12, 2012, a Canadian reporter asked Bryce Harper, the young Washington National's outfielder who was later named Rookie of the Year, whether he planned to open "a celebratory Canadian beer" after the Nationals defeated the Toronto Blue Jays.<sup>1</sup> The question was somewhat naïve, since Harper is a devout Mormon, a faith that opposes alcohol consumption.<sup>2</sup> Also, although the legal drinking age in Toronto, Canada is eighteen, Harper remains underage in his home country. In response, Harper quickly, and seemingly off-the-cuff, quipped, "That's a clown question, bro," a comeback considered so humorous that it immediately garnered widespread attention.<sup>3</sup> In fact, the phrase gained such immediate popularity that Senate Majority Leader Harry Reid used it days later at a press conference to answer whether he planned to bring the Dream Act to the Senate floor.<sup>4</sup> In addition, within a week, the Denver Beer Co. prepared a Canadian Lager brew adorned with the logo, "Clown Question Bro."<sup>5</sup>

On June 13, 2012, the day after he first uttered the remark, Bryce Harper applied to register the phrase "That's a Clown Question, Bro" as

<sup>1</sup> See Roxanne Roberts & Amy Argetsinger, *Bryce Harper and Friends, Still Clowning Around*, WASH. POST, June 25, 2012, at C2.

<sup>2</sup> *Id.*

<sup>3</sup> *Id.*

<sup>4</sup> Melanie Mason, *Politics Now*, CHICAGO TRIB., June 25, 2012, at 12.

<sup>5</sup> Neil Augenstein, *WTOP Taste-tests 'Clown Question Bro' Beer*, WTOP (June 25, 2012, 11:04 AM), <http://www.wtop.com/41/2916467/WTOP-taste-tests-Clown-Question-Bro-beer> (last visited Jan. 17, 2013).

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a trademark for wearing apparel, including, but not limited to, t-shirts, sweatshirts, jackets, pants, hats, and visors.<sup>6</sup> The United States Patent and Trademark Office (“PTO”) rapidly approved the application and issued a notice of allowance on January 8, 2013.<sup>7</sup> In the interim, the registration rekindled questions about the legitimacy of obtaining trademark rights in phrases that are likely to become popular marketing slogans.<sup>8</sup>

The debate is not a new one. For instance, Pat Riley, the coach of the Los Angeles Lakers, obtained a trademark registration in 1989 for the phrase “Three-Peat,” which was first coined by the player Byron Scott and became popular among Lakers fans to celebrate the possibility of winning three championships in a row.<sup>9</sup> Although the Lakers did not clinch that third victory, the Chicago Bulls accomplished the feat in 1993, but could not use the slogan on bumper stickers or other items without negotiating with Riley.<sup>10</sup> What would happen now, assuming that Riley maintained the registration, if fans of Michael Phelps or the U.S. women’s beach volleyball team wanted to celebrate their successive Olympic gold medals by displaying “Three-Peat” on t-shirts or hats? As another example, consider that on September 22, 2001, just eleven days after the 9/11 Al Qaida attacks, Iman Abdallah filed a trademark application for “Let’s Roll,” words spoken on Flight 93 by Todd Beamer that soon came to symbolize the nation’s resolve against terrorism.<sup>11</sup> Naturally, this raises the question of whether Abdallah, or anyone for that matter, should have exclusive rights to use the phrase as a trademark, especially on products, such as t-shirts, that are intended to display one’s thoughts and feelings.

The primary question in these and similar situations is whether individuals or companies should be able to use trademark laws to opportunistically gain marketing advantages over rivals by being the

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<sup>6</sup> U.S. Trademark Application Serial No. 85651210 (filed June 13, 2012).

<sup>7</sup> *Id.*

<sup>8</sup> See, e.g., Ryan S. Hilbert, *Competing Before the PTO: Four Things a Professional Athlete Should Consider When Seeking a Federal Trademark Registration*, SPORTS LITIG. ALERT (Hackney Publ’ns, Austin, Tex.), Aug. 24, 2012.

<sup>9</sup> U.S. Trademark Reg. No. 1552980 (Aug. 22, 1989). This registration for “Three-Peat” for shirts, jackets, and hats was cancelled on May 3, 2012, according to Section 8. Pat Riley, via Riles & Company, Inc., has active registrations for “Three Peat”, Reg. No. 1886081 (Mar. 28, 1995); ThreePeat, Reg. No. 4051757 (Nov. 8, 2011); and 3 Peat, Reg. No. 4139135 (May 8, 2012). Riley also maintains a registration for “Three-Peat” as to collector plates, mugs, and tankards, Reg. No. 1878690 (Feb. 14, 1995). For an article that explains the creation of Three Peat, see Darren Rovell, *What the Trojans Won’t Do: Three-Pete*, ESPN.com, Dec. 23, 2005, <http://sports.espn.go.com/nfl/news/story?id=2270041> (last visited Dec. 28, 2012) [hereinafter Rovell].

<sup>10</sup> See Rovell.

<sup>11</sup> U.S. Trademark Application Serial No. 76316210 (filed Sept. 22, 2001). For a thorough discussion of applications for “Let’s Roll,” see Noah Bleicher, *Trademarking Tragedy: The Fight For Exclusive Rights to ‘Let’s Roll’*, 52 EMORY L.J. 1847 (2003).

first to either use or to register a popular phrase. For instance, during games three and four of the 2011 National League division series between the Cardinals and the Phillies, a squirrel ran out onto the field in St. Louis and was soon adopted by Cardinals fans as the Rally Squirrel. Soon there were competing applications to obtain trademark rights to “Rally Squirrel” and shortly thereafter the phrase became a common sight on t-shirts and other clothing.<sup>12</sup> Likewise, Anthony Davis, the National Basketball Association’s (“NBA”) number one draft pick in 2012, was not only known for being a great basketball player at the University of Kentucky, but also for sporting his prominent unibrow. While Davis was in college, the owner of a University of Kentucky apparel store began selling shirts stating “Fear the Brow,” and filed a trademark application for the phrase.<sup>13</sup> Soon thereafter, Davis filed an application claiming the same slogan for clothing and many other items.<sup>14</sup> Should Davis be able to keep others from using the phrase because it indirectly refers to him? What about a tennis apparel company registering the phrase “Are You Sure?” for shirts, hats, and jackets?<sup>15</sup> Tennis players commonly use this phrase to question their opponents about line calls; is it fair for one company to control its use simply by being the first to register it as a trademark? What if I anticipate that the Baltimore Orioles will be playing in the American League Championship series in 2013, and thereafter I register a set of phrases, such as “Pitchfork New York” and “Set the Jays Ablaze,” for t-shirts and beer mugs? If I guess correctly, should I be the only one who can sell merchandise cleverly expressing what fans want to say? These questions illuminate how trademark policies governing rights to slogans sometimes raise special concerns.

This article evaluates the propriety of registering slogans as standard character trademarks for “billboard products”: objects that are significantly used by owners to display information about their personalities, emotions, and tastes, including t-shirts, hats, mugs, and key chains, among many other items. As we shall see, the PTO has been somewhat permissive in this area, often allowing the first person that files a trademark application to register the phrase unless the slogan

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<sup>12</sup> See Kavita Kumar, *Who Owns the Rally Squirrel? Vendors Race to Claim Trademarks*, STLTODAY.COM (Nov. 5, 2011, 12:15 AM), [http://www.stltoday.com/business/local/who-owns-the-rally-squirrel-vendors-race-to-claim-trademarks/article\\_ed33ed96-0e2e-51e4-80cd-c400390cd990.html](http://www.stltoday.com/business/local/who-owns-the-rally-squirrel-vendors-race-to-claim-trademarks/article_ed33ed96-0e2e-51e4-80cd-c400390cd990.html).

<sup>13</sup> U.S. Trademark Application Serial No. 85477805 (Nov. 21, 2011). See Paul Borovay, *Who Owns a Trademark? Jeremy Lin Wins Linsanity, as Anthony Davis Fights For His Unibrow*, PATTISHALL IP BLOG (July 25, 2012, 10:38 AM), <http://blog.pattishall.com/2012/07/25/who-owns-a-trademark-jeremy-lin-wins-linsanity-as-anthony-davis-fights-for-his-unibrow/> (last visited Dec. 28, 2012).

<sup>14</sup> U.S. Trademark Application Serial No. 85643417 (June 5, 2012).

<sup>15</sup> U.S. Trademark Reg. No. 4056684 (Nov. 15, 2011).

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identifies a specific individual.<sup>16</sup> This article argues that the PTO should typically refuse to register slogans as trademarks for billboard products until the applicant can demonstrate that the phrase actually designates source. In other words, in most cases, the PTO should not permit trademark applicants to register slogans on the primary register as standard character marks for billboard products until the applicants submit adequate proof that the slogans have attained secondary meaning. However, this proposal will not prevent a company from immediately protecting a popular slogan in conjunction with other design elements when consumers legitimately use the combination to identify the source of a billboard product. Thus, I could certainly receive immediate protection for my phrase “Pitchfork New York” as written in a distinctively stylized font and including a particular design in the background, but I would not hold exclusive rights to the phrase itself.<sup>17</sup> Only later, if I could prove that consumers had come to understand the phrase, by itself, as primarily an indicator of source rather than a humorous way to disparage an opponent, could I receive protection for the slogan as a standard character mark.<sup>18</sup> The only exceptions to this general proposal requiring proof of secondary meaning for standard character marks arise when a slogan clearly identifies a particular individual under right of publicity standards, or when it has already become famous as a standard character trademark for other kinds of products.<sup>19</sup> Under those exceptions, the slogan can be registered as a trademark for billboard products immediately without initial proof that the phrase actually designates source.

## I. THE BASICS OF TRADEMARK PROTECTION

### A. *Purpose of Trademarks*

Trademarks are one of the three primary elements of protection within the intellectual property system. At the very core, the U.S. economic system is based on the notion that free markets and unfettered competition promote public welfare.<sup>20</sup> When market participants are given free rein to duplicate and build on the creations of others, they then are able to use their personal expertise to lower costs, reduce

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<sup>16</sup> See *infra* notes 71–77, 86–90 and accompanying text.

<sup>17</sup> See *infra* notes 67–70 and accompanying text.

<sup>18</sup> See *infra* notes 67–70 and accompanying text.

<sup>19</sup> See *infra* notes 82–90 and accompanying text.

<sup>20</sup> See, e.g., *Eastern Wine Corp. v. Winslow-Warren, Ltd.*, 137 F.2d 955, 958 (2d Cir. 1943) (“[T]here is a basic public policy, deep-rooted in our economy and respected by the courts, resting on the assumption that social welfare is best advanced by free competition . . .”). See also *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) (stating that imitation and refinement through imitation are the very lifeblood of a competitive economy).

prices, and make beneficial improvements.<sup>21</sup> The problem though, is that artists and inventors may forego creative activities if others are free to take their ideas, at no cost, as soon as the creators disclose them to the public.<sup>22</sup>

Patents and copyrights are intended to address the economic disincentives that competition imposes on innovators by giving inventors and artists a limited period of exclusivity so that they have an opportunity to profit from their creativity.<sup>23</sup> For our purposes, the most critical concept is that each system is characterized by a delicate balance that provides just the right amount and length of protection to the appropriate kinds of innovations so that creative individuals have sufficient incentives to develop and share new works.<sup>24</sup> This means that lawmakers have to be particularly wary whenever they devise legislation that might interfere with the carefully crafted and balanced structures of the patent or copyright systems. Indeed, state laws that do so are typically preempted.<sup>25</sup> Also, the courts interpret federal laws in such a way as to prevent undue interference except where Congress makes it clear that other objectives take priority.<sup>26</sup>

While patents and copyrights provide exclusive rights so that creative individuals may profit from disclosing their innovations, trademarks have a different function altogether.<sup>27</sup> In an unrestrained marketplace, competitors are free to duplicate all product attributes that are not legally protected, usually by a patent or copyright. This means that when consumers enjoy a company's product, they may have a hard time relocating it because when they return to purchase it, many

<sup>21</sup> See, e.g., Lee Burgunder, *Trademark Registration of Product Colors: Issues and Answers*, 26 SANTA CLARA L. REV. 581, 583 (1986).

<sup>22</sup> See Paul Goldstein, *The Competitive Mandate: From Sears to Lear*, 59 CALIF. L. REV. 873, 878 (1971) (stating that "although short range competitive interests would benefit from immediate and free public access to technological and artistic innovation, to permit such access would destroy incentive to innovate . . .").

<sup>23</sup> U.S. CONST. art. I, § 8, cl. 8 (allowing exclusive rights for limited times to authors and inventors). See, e.g., *Bonito Boats*, 489 U.S. at 146 ("From their inception, the federal patent laws have embodied a careful balance between the need to promote innovation and the recognition that imitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy.").

<sup>24</sup> See, e.g., *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33–34 (2003) ("The rights of a patentee or copyright holder are part of a 'carefully crafted bargain,' under which, once the patent or copyright monopoly has expired, the public may use the invention or work at will and without attribution.") (internal citations omitted).

<sup>25</sup> E.g., *Bonito Boats*, 489 U.S. at 151–52; *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231–32 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237–38 (1964).

<sup>26</sup> Cf. *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 164–65 (1995) (noting that federal trademark law must be interpreted to prevent interference with the patent law's objectives of encouraging innovation, as "[i]t is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time . . .").

<sup>27</sup> E.g., *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34 (2001) (stating that the Lanham Act does not exist to reward manufacturers for innovation).

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products on the shelves might look exactly the same, although some are made by imitating competitors.<sup>28</sup> The trademark system is designed to address this problem by giving companies exclusive rights to identification symbols so that consumers can distinguish their products from those offered by competitors. In effect, trademarks make it easier for consumers to locate the products that they desire.<sup>29</sup>

According to the Lanham Act, the federal trademark statute, a trademark is “any word, name, symbol or device” that serves to identify the source of a product or service, and that can be used to distinguish it from those offered by others.<sup>30</sup> Protecting trademarks usually is not controversial because trademarks provide several beneficial market effects, often without raising any potential social or economic harm, and without impeding the function of the patent and copyright systems.<sup>31</sup> Perhaps most importantly, trademarks prevent unscrupulous competitors from fooling consumers so that they mistakenly buy their products rather than those of the manufacturer that they really seek.<sup>32</sup> Thus, trademarks are very much about maintaining commercial ethics. Additionally, trademarks provide a simple and efficient way for consumers to find exactly what they want,<sup>33</sup> without which they would have to employ more expensive measures to search out items from their preferred sources.<sup>34</sup> Moreover, trademarks may encourage companies to produce higher quality goods because pleased customers are more likely to make repeat purchases rather than be tricked by competitors.<sup>35</sup>

<sup>28</sup> See, e.g., Lee B. Burgunder, *Product Design Protection After Bonito Boats: Where it Belongs and How It Should Get There*, 28 AM. BUS. L.J. 1, 8 (1990).

<sup>29</sup> See 15 U.S.C. §§ 1114(1), 1125(a)(1) (2006) (indicating that one engages in trademark infringement by using a trademark in a way that is likely to cause confusion, mistake, or deception); see, e.g., Lee B. Burgunder, *The Scoop on Betty Boop: A Proposal to Limit Overreaching Trademarks*, 32 LOY. L.A. ENT. L. REV. 257, 269 (2012); see generally William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 270 (1987) (noting that in an unrestrained market, competitors would typically copy identifying marks because the cost of duplicating those elements would normally be less than the value of the goodwill that could be obtained as a result of consumer confusion).

<sup>30</sup> 15 U.S.C. § 1127 (2006).

<sup>31</sup> Burgunder, *supra* note 29, at 270.

<sup>32</sup> See, e.g., Burgunder, *supra* note 21, at 587; Gary Spratling, *The Protectability of Package, Container and Product Configurations (Part I)*, 5 U.S.F. L. REV. 451, 465-66 (1971); *Brown Chem. Co. v. Myer*, 139 U.S. 540, 544 (1891).

<sup>33</sup> E.g., *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003); *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 163-65 (1995).

<sup>34</sup> E.g., *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985). See, e.g., Ralph Folsom & Larry Tepley, *Trademarked Generic Words*, 89 YALE L.J. 1323, 1336 (1980).

<sup>35</sup> E.g., *Qualitex*, 514 U.S. at 164. *Scandia*, 772 F.2d at 1429-30. See S. REP. NO. 1333, 79<sup>th</sup> Cong., 2d Sess. 1, *reprinted in* 1946 U.S.C.C.A.N. 1274, 1275 (“Trade-marks encourage the maintenance of quality by securing to the producer the benefit of the good reputation which excellence creates. To protect trade-marks, therefore, is . . . to secure to the business community the advantages of reputation and good will by preventing their diversion from those who have created them to those who have not.”).

### B. *Competitive Concerns with Trademarks*

There are times, though, when trademarks may raise potential concerns, and in these circumstances, they have to be handled more cautiously.<sup>36</sup> One issue relates to the very purpose of trademarks as identification symbols that consumers use to distinguish source.<sup>37</sup> Although it may seem obvious, this means that consumers must be able to recognize the trademark—the identification symbol—as something that is separate from the product that it identifies.<sup>38</sup> When a word, such as Nike, is placed on a shoe, this is somewhat easy to do.<sup>39</sup> However, in other instances, the lines are less clear. For instance, if a chair manufacturer were to claim that its design served a trademark function to indicate source, it may be more difficult to differentiate the trademark from the good.<sup>40</sup> Still, consumers must at least be able to conceptually separate the two,<sup>41</sup> or else the trademark will infringe on the roles of patent and copyright by preventing competition in the product itself.<sup>42</sup>

In ideal situations, trademarks only provide benefits to a smoothly functioning competitive market without creating potential negative consequences.<sup>43</sup> However, this is not always the case. For instance, if a manufacturer of footballs were to gain the exclusive right to use the word “football,” then other manufacturers would be significantly disadvantaged since they could not use the only term that the public understands to represent their product.<sup>44</sup> Coupled with this, customers

<sup>36</sup> See, e.g., *Dastar*, 539 U.S. at 34 (stating that “in construing the Lanham Act, we have been ‘careful to caution against misuse or over-extension’ of trademark and related protections into areas traditionally occupied by patent or copyright.”) (quoting *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001)).

<sup>37</sup> See *id.* (stating that the purpose of federal trademark law is to prevent competitors from copying a source-identifying mark).

<sup>38</sup> See *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 1449–50 (3d Cir. 1990) (stating that the identifying element “must not appear to the consumer as a mere component, or the essence, of the product gestalt, but rather must appear as something attached (in a conceptual sense) to function in actuality as a source designator—it must appear to the consumer to act as an independent *signifier* of origin rather than as a component of the good.”).

<sup>39</sup> See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212 (2000).

<sup>40</sup> *Id.* at 213; *Duraco*, 40 F.3d at 1440–41.

<sup>41</sup> See *Duraco*, at 1449 (“As with trademarks, an inherently protectable product configuration must, at least conceptually, be something other than, and separate from, the merchandise.”) (internal quotation marks and citation omitted).

<sup>42</sup> Compare *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34 (2001) (“The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.”), with *Dastar*, 539 U.S. at 34–35 (noting that allowing the federal trademark laws to limit the public’s federal right to copy and use expired copyrights would create a species of mutant copyright law).

<sup>43</sup> See, e.g., Lee B. Burgunder, *Trademark Protection of Live Animals: The Bleat Goes On*, 10 J. MARSHALL REV. OF INTELL. PROP. L. 715, 720 (2011).

<sup>44</sup> E.g., *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976) (stating that protection of generic terms “must be denied since this in effect would confer a monopoly not only of the mark but of the product by rendering a competitor unable effectively to name what it was endeavoring to sell.”); *W. T. Rogers Co., Inc. v. Keene*, 778 F.2d 334, 339 (7th Cir. 1985) (claiming that trademark protection for a generic word would impair competition by allowing the

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typically use the generic term “football” to refer to the product class, rather than to identify the source of the product.<sup>45</sup> Thus, the term does not act properly as a trademark. For both of these reasons—the competitive concerns and the inability to identify source—companies are never allowed to protect generic terms as trademarks.

Problems also may arise when companies attempt to protect words that describe their products, such as the name “HoneyBaked” for ham. Although this is not a generic term for a ham cooked in honey, it may be one of only a few equally effective ways to easily inform customers about the nature of the product.<sup>46</sup> If several competitors adopted all of those descriptive words, then new entrants would be foreclosed from using equally informative terms, thus becoming disadvantaged. Thus, descriptive terms can pose competitive problems, although they are not as immediate or absolute as with generic terms.<sup>47</sup> On the consumer end, people who see the term HoneyBaked on a ham would probably at first only perceive the word as a description of the product rather than as a designation of source. Therefore, the term would not serve a trademark function when it is first seen on hams. Along with the potential market access issues, the fact that the term lacks essential identifying characteristics means that the trademark laws do not prevent others from using it.<sup>48</sup>

However, if one company were to consistently and exclusively use the term for a significant period of time, especially if coupled with appropriate forms of advertising, then consumers might start to recognize the term as a trademark that identifies the particular source of this honey-tasting ham.<sup>49</sup> Thus, although the term at first might simply be a description of the product, over time it might gain a new—or secondary—meaning, which serves primarily as a designation of source.<sup>50</sup> Once this secondary meaning arises, other companies’ use of the word for their products is likely to confuse the public, and although the competitive concerns over the availability of equivalent descriptions remain, they are viewed as relatively insignificant compared to the

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trademark holder to monopolize a scarce input); *see, e.g.*, Lee B. Burgunder, *Trademark and Copyright: How Intimate Should the Close Relationship Become?*, 29 SANTA CLARA L. REV. 89, 97 (1989); Landes & Posner, *supra* note 29, at 291–96.

<sup>45</sup> *Abercrombie*, 537 F.2d at 9.

<sup>46</sup> *See Scandia*, 772 F.2d at 1430; *id.* at 10; Landes & Posner, *supra* note 29, at 290; Burgunder, *supra* note 43, at 721.

<sup>47</sup> *See, e.g., Scandia*, 772 F.2d at 1430 (“If descriptive words and pictures could be appropriated without evidence of a secondary meaning, sellers could snatch for themselves the riches of the language and make it more difficult for new entrants to identify their own products; consumers would be worse off.”).

<sup>48</sup> 15 U.S.C. § 1052(e).

<sup>49</sup> *E.g., G. & C. Merriam Co. v. Saalfield*, 198 F. 369, 373 (6th Cir. 1912), *cert. denied*, 243 U.S. 651 (1917).

<sup>50</sup> *See Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000).

possible harms that might result from consumer confusion.<sup>51</sup> Thus, trademark policies do not protect descriptive terms when companies first adopt them on their products, but the law will provide cover after the terms attain secondary meaning.<sup>52</sup>

Besides these concerns, one also needs to make sure that trademark enforcement does not unduly interfere with other federal rights or policies.<sup>53</sup> For example, as already noted, the patent and copyright laws are carefully structured to provide the necessary incentives to stimulate new inventions and creative expressions. Since trademarks can protect words, drawings, and product designs, one must be mindful that overlapping patent and copyright protection might lead to conflicts in policy objectives.<sup>54</sup> For this reason, it is important to ensure that trademarks stay true to their purpose: to provide rights to control identification symbols while simultaneously allowing free competition in the underlying products. To this end, courts have determined that trademark protection is inappropriate when it yields competitive advantages unrelated to the goodwill of its owner.<sup>55</sup>

### C. First Amendment Considerations

When trademarks include words or phrases, one must take care to ensure that the trademark owner's exclusive rights do not prevent others from engaging in free speech.<sup>56</sup> Also, since trademarks represent companies and can be powerful symbols in society, citizens may need to use them to engage in public discourse.<sup>57</sup> For these reasons, trademark privileges are often restrained to ensure that protection does not impinge on First Amendment rights. Sometimes, statutory language explicitly limits the breadth of trademark rights to preserve freedom of speech. For instance, the Lanham Act allows companies to use descriptive marks to fairly describe their own products.<sup>58</sup> It also prevents owners of famous trademarks from making dilution claims,

<sup>51</sup> See, e.g., *Abercrombie*, 537 F.2d at 13–14.

<sup>52</sup> 15 U.S.C. § 1052(f).

<sup>53</sup> E.g., *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003).

<sup>54</sup> See Burgunder, *supra* note 29, at 272–74.

<sup>55</sup> See, e.g., *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 165 (1995); see also *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001).

<sup>56</sup> See, e.g., *New York Times v. Sullivan*, 376 U.S. 254, 270 (1964) (stating that the First Amendment supports “a profound national commitment to the principle that debate on public issues should be uninhibited, robust, and wide-open.”).

<sup>57</sup> See, e.g., Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 973 (1993) (“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.”); Margreth Barrett, *Domain Names, Trademarks and the First Amendment: Searching for Meaningful Boundaries*, 39 CONN. L. REV. 973, 979–81 (2007).

<sup>58</sup> 15 U.S.C. § 1115(b)(4).

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under certain conditions, against those engaged in commentary or criticism.<sup>59</sup> In other circumstances, the courts apply various judicially created rules to ensure the public's rights to speak freely about issues.<sup>60</sup> For example, depending on the situation, courts will appraise free speech rights in light of likelihood of confusion principles, nominative fair use standards, or artistic relevance, among many other tests.<sup>61</sup> In light of these statutory and judicially created trademark limitations, if a trademark owner tries to prevent a billboard product company from displaying "Let's Roll," "Three-Peat," or "That's a Clown Question, Bro," serious First Amendment issues may arise.

## II. PROTECTING SLOGANS AS TRADEMARKS FOR BILLBOARD PRODUCTS: THE MODERN APPROACH

The Lanham Act protects just about any type of identifier that can be used to distinguish products in the marketplace, including sounds, smells, and for the purpose of this article, slogans.<sup>62</sup> Except in the notable case of product designs, each trademark form is subject to a spectrum analysis similar to words, ranging from generic or common conceptions, which can never be protected, to fanciful or inherently distinctive notions, which can achieve immediate trademark status.<sup>63</sup> In the middle are descriptive types of designations that can become trademarks only after secondary meaning has been established.

According to this spectrum, slogans can be immediately registered as trademarks as long as they do not merely describe the nature or qualities of the product and function as a trademark.<sup>64</sup> Thus, a slogan such as "The Extra-Strength Pain Reliever" should not qualify as a

<sup>59</sup> 15 U.S.C. § 1125(c)(3)(A)(ii). The statutory exception is important because dilution principles otherwise might allow owners of famous trademarks to make credible claims against uses of their marks on unrelated merchandise, including billboard products, based on concepts of blurring and tarnishment. For a thorough explanation of dilution principles, see, for example, *Ty Inc. v. Perryman*, 306 F.3d 509 (7th Cir. 2002).

<sup>60</sup> See, e.g., Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 WASH. L. REV. 887, 899–922 (2005).

<sup>61</sup> See *infra* notes 169–176 and accompanying text. Companies make a nominative fair use when they need to use another's trademark to describe their own products or services. E.g., *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1151 (9th Cir. 2002). An illustrative example is a sign on an auto repair shop that says "Modern Volkswagen Porsche Service." *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350, 351 (9th Cir. 1969). The notion of artistic relevance is often raised when famous names or marks are used with book, song or movie titles. See, e.g., *Ginger Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

<sup>62</sup> See, e.g., *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209 (2000); *Two Pesos Inc. v. Taco Cabana*, 505 U.S. 763, 764–65 (1992); in re Gen. Elec. Broad. Co., Inc., 199 U.S.P.Q. 560 (T.T.A.B. 1978) (sounds); in re Clarke, 17 U.S.P.Q. 2d 1238 (T.T.A.B. 1990) (smells); *Roux Laboratories, Inc. v. Clairol, Inc.*, 427 F.2d 823 (C.C.P.A. 1970) (slogans).

<sup>63</sup> *Two Pesos*, 505 U.S. at 774; *Samara*, 529 U.S. at 212.

<sup>64</sup> See, e.g., Evynne Grover, *The Trademark Protection of Advertising Slogans: A Modern Perspective*, 1 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 213, 224–29 (1991).

trademark for a headache medication without proof of secondary meaning, due to a lack of initial trademark significance and the potential unfair competitive advantages previously noted. However, arbitrary or even suggestive slogans, such as “Stay Thirsty My Friends” or “That’s a Clown Question, Bro” are sufficiently distinctive for beer that protection will benefit market efficiency without conceivable harms.<sup>65</sup> Additionally, terms and slogans may be generic or descriptive in one context, but totally arbitrary in another. For this reason, a fishing reel company might be able to immediately register the phrase “The Extra Strength Pain Reliever” because it is a somewhat fanciful comment about the qualities of fishing equipment.<sup>66</sup>

Of course, even a slogan that is generic or descriptive of the product upon which it appears may be distinctive when written in an unusual typeface or combined with a unique design. For instance, a manufacturer of tables might call itself “The Modern Art Tables Company” and designate its products with that phrase in distinctive lettering having a particular color and superimposed on a design of a modern piece of furniture. Although the phrase, by itself, may not at first be distinctive, the combined elements certainly could be. Thus, a competitor should have the right to use the phrase “Modern Art Tables Company” as long as the phrase remains descriptive without secondary meaning. However, customers would be confused if that rival also incorporated a confusingly similar typeface and design, since the overall appearance of the logo uniquely identifies another source. Therefore, the original “Modern Art Tables Company” should be entitled to trademark protection for the phrase when it is presented with these other distinctive elements.

The PTO provides trademark registrants the flexibility to achieve this result. Trademark users, for instance, may register identifying words in a “standard character format,” which provides protection to the words, themselves, regardless of how they appear.<sup>67</sup> Trademark applicants may also register their logos as stylized or design marks, enabling them to make claims to not only the words, but also to other artistic elements, such as drawings or stylized characters, among other things.<sup>68</sup> Thus “The Modern Art Tables Company” could register its

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<sup>65</sup> The slogan, *Stay Thirsty, My Friends*, was registered for beer in 2008. STAY THIRSTY, MY FRIENDS, Registration No. 3410073.

<sup>66</sup> In this instance, registration might be denied, depending on the potential for confusion or dilution with previous uses of the phrase used with marketing Excedrin.

<sup>67</sup> The PTO discusses options for representing the mark on its website at <http://www.uspto.gov/trademarks/basics/mark.jsp>. As the PTO website provides, “standard character format” marks “should be used to register word(s), letter(s), number(s) or any combination thereof, without claim to any particular font style, size, or color, and absent any design element.” The United States Patent and Trademark Office, Representation of the Mark, *available at* <http://www.uspto.gov/trademarks/basics/mark.jsp>.

<sup>68</sup> *See* The United States Patent and Trademark Office, Representation of the Mark, *available at*

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mark with a stylized or design designation, but disclaim exclusive rights to the descriptive phrase by itself.<sup>69</sup> This achieves the company's purpose of protecting rights in the entire gestalt, while allowing other companies to use the descriptive phrase that has been disclaimed. Over time, due to exclusive use and other factors, consumers may not only perceive the entire logo as a trademark, but they also may start to believe that all furniture stamped with "The Modern Art Tables Company" actually comes from one source. In that event, the company could then register the complete design as a stylized mark without a disclaimer, and could also register the slogan as a standard character mark.<sup>70</sup>

These same principles conceptually should apply when a company wants to protect a slogan for a billboard product, such as a baseball cap, that does *not* prominently display the slogan. As an example, the slogan may be written on a removable tag or under the cap, but it does not also appear on the front of the cap, above the bill. In this event, the company would not be able to register a generic phrase such as "Baseball Caps," and would have to demonstrate secondary meaning before registering a descriptive slogan such as "The Cool Cap for Cool Ballplayers." However, the slogans noted in the introduction, such as "Are You Sure?" and "That's a Clown Question, Bro" have absolutely nothing to do with the quality or features of the hat, and thus should merit trademark protection immediately as long as those slogans are not confusingly similar to any previously registered for the same kinds of merchandise. In fact, the company could file an application to claim the slogan as a trademark before even using it, based on a bona fide intent to use it.<sup>71</sup> As long as it shows the PTO a specimen demonstrating use of the slogan as a trademark within three years, the company will have rights over any others who might have applied for registration after it did, even if those other companies actually used the slogan on wearing apparel first.<sup>72</sup>

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<http://www.uspto.gov/trademarks/basics/mark.jsp>.

<sup>69</sup> See U.S. PATENT & TRADEMARK OFFICE, U.S. DEP'T OF COMMERCE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1213 (on Disclaimer of Elements in Marks) [hereinafter T.M.E.P.]. According to the PTO, a disclaimer of a component of a composite mark amounts merely to a statement that, in so far as that particular registration is concerned, no rights are being asserted in the disclaimed component standing alone, but rights are asserted in the composite; and the particular registration represents only such rights as flow from the use of the composite mark. See *Sprague Electric Co. v. Erie Resistor Corp.*, 101 U.S.P.Q. 486, 486–87 (Dec. Comm'r Pat. 1954). A disclaimer may not be necessary if it is obvious from the unitary nature of the mark that registration does not extend to the descriptive slogan. See T.M.E.P. § 1213.01(a).

<sup>70</sup> T.M.E.P. § 1213.11 (Acquiring Rights in Disclaimed Matter). See *Quaker Oil Corp. v. Quaker State Oil Ref. Corp.*, 161 U.S.P.Q. 547, 549–50 (T.T.A.B. 1969), *aff'd*, 453 F.2d 1296 (C.C.P.A. 1972); *Victor Tool & Mach. Corp. v. Sun Control Awnings, Inc.*, 299 F. Supp. 868, 875–76 (E.D. Mich. 1968), *aff'd*, 411 F.2d 792 (6th. Cir. 1969).

<sup>71</sup> 15 U.S.C. § 1051(b).

<sup>72</sup> 15 U.S.C. § 1051(d)(1)–(d)(2).

The PTO follows these principles when it reviews applications for slogans; however, it fails to adequately consider that trademark holders ultimately might try to prevent others from prominently displaying the registered phrases. Accordingly, if I were to apply to register the phrase “Pitchfork New York” as a trademark for t-shirts, the PTO would initially assess whether consumers would recognize that the slogan is meant to be a trademark.<sup>73</sup> In this regard, the PTO examines the specimen to determine how the public is likely to perceive the use. If the specimen simply shows a t-shirt emblazoned in large lettering with the slogan, then the PTO will likely conclude that the slogan serves merely as ornamentation on the shirt rather than as a trademark that designates source.<sup>74</sup> In this event, the PTO will not register the slogan until the applicant can demonstrate secondary meaning.<sup>75</sup> However, if the slogan is smaller and positioned, perhaps near the breast, or if it appears on tags or under the collar, then the PTO will typically assume it serves as a trademark.<sup>76</sup> Therefore, as long as I submit a specimen showing a removable tag or a shirt with appropriate trademark usage, then the PTO will likely register the mark without requiring any proof of secondary meaning.<sup>77</sup>

The problem with this approach is that my overriding intent is to sell shirts that permit their respective wearers to clearly indicate that they want their team to beat the Yankees. Thus, so long as I add a hangtag or a small under-collar label that shows the phrase, I can obtain a trademark registration and, in turn, make it very difficult for anyone else to display the slogan on billboard products, no matter how popular and inspiring the slogan becomes.<sup>78</sup> The result is one that potentially violates trademark policies, interferes with copyright doctrines, and infringes on the First Amendment.<sup>79</sup> Thus, the PTO needs to carefully consider the full reach of its decisions when granting trademark rights to slogans for billboard products.

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<sup>73</sup> T.M.E.P. § 1202.03 (Refusal on Basis of Ornamentation).

<sup>74</sup> T.M.E.P. § 1202.03(a) (stating that a large rendition of a word or design emblazoned across the front of a garment may likely be perceived merely as a decorative or ornamental feature of the goods); T.M.E.P. § 1202.03(f)(i) (stating that slogans inscribed in large letters on items such as t-shirts have been refused registration because purchasers will perceive them as conveying a message rather than indicating source).

<sup>75</sup> T.M.E.P. § 1202.03(1) (stating ornamental matter that is not inherently distinctive may be registered on the Principal Register under §2(f) if the applicant proves that the subject matter has acquired distinctiveness).

<sup>76</sup> T.M.E.P. § 1202.03(a) (stating that “[a] small, neat and discrete word or design feature . . . may be likely to create the commercial impression of a trademark”).

<sup>77</sup> T.M.E.P. § 904.04 (Material Appropriate as Specimens for Trademarks). *Cf.*, *Damn I’m Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 1359 (S.D.N.Y. 1981) (PTO refused registration of prominently displayed slogan until it was sold with tags using the slogan, since before which the phrase could not serve a source identifying function).

<sup>78</sup> *See infra* Section VI.

<sup>79</sup> *See infra* Section VI.

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Indeed, the PTO should assume that a company seeking trademark rights in a slogan for billboard products will prominently display that slogan, and perhaps others expressing similar sentiments, on their wares. For this reason, it would be improper to evaluate the meaning of the slogan “Pitchfork New York” simply in terms of basic t-shirts; that is, to conclude that “Pitchfork New York” is not descriptive because it has nothing to do with the quality of wearing apparel. Rather, the notion of the product class must be refined to better reflect reality.<sup>80</sup> In the example “Pitchfork New York,” the product is not just a t-shirt, but a t-shirt that expresses hatred for New York. With that understanding, the slogan is no longer arbitrary, but rather is one of several ways to describe the nature of a shirt that demonizes the Yankees. In this event, I should have to demonstrate secondary meaning before obtaining registration. One could take this even farther, and argue that consumers will at first perceive the slogan “Pitchfork New York” to be an attribute of the product, thereby making the phrase generic until the public conceptually separates the slogan from the product. Under legal rules governing product designs, the required separation only materializes when the phrase attains secondary meaning.<sup>81</sup> Thus, again, by defining the product class in more realistic terms, the PTO would recognize that it should wait until there is proof of secondary meaning before registering slogans for billboard products.

Having said this, it is important to reiterate at this juncture that we are talking about the registration of slogans as standard character marks for billboard products. A company—indeed, more than one—should be able to immediately register the slogan in a stylized format (with design elements), assuming it disclaims rights to the slogan, and the remaining logo does not cause a likelihood of confusion. Again, this result will prove to be totally consistent with trademark, copyright, and First Amendment policies.

When considering trademark rights for slogans on billboard products, one must address a few other basic trademark principles. One issue involves “sponsorship rights,” which are provided in the Lanham Act with the following language:

Any person who, on or in connection with any goods or services . . .  
uses in commerce any word, term, name, symbol, or device . . .  
which is likely to cause confusion, or to cause mistake, or to  
deceive . . . as to the origin, sponsorship, or approval of his or her  
goods, services, or commercial activities by another person . . . shall

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<sup>80</sup> For a discussion of the importance of defining the product class, see Burgunder, *supra* note 43, at 729–30.

<sup>81</sup> See *infra* notes 143–153 and accompanying text.

be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.<sup>82</sup>

Although controversial, the prevalent interpretation of this provision allows companies with powerful trademarks to control the use of their marks on billboard products, not because consumers would believe that the trademark owners made the shirts, but rather because the public would think that they endorsed or sponsored the use of their marks on the products.<sup>83</sup> This means that a t-shirt designer would have to be very careful if it wanted to use the word, Nike, or a Swoosh, on its product since doing so might cause confusion as to Nike's sponsorship. However, it must exercise the same caution if it wants to use "Just Do It" because that slogan likewise serves as a trademark for Nike's products.

Perhaps more pertinent to the topic here, the notion of sponsorship also provides a federal cause of action for violations of publicity rights, which are otherwise governed by state law.<sup>84</sup> Typically, publicity rights give well-known individuals the ability to prevent others from using their names or images to falsely suggest that they endorse someone else's products.<sup>85</sup> The important question here is whether an individual can have publicity rights in a slogan, for if so, then that person could prevent others from using the phrase on all types of products, including billboard products, barring a defense such as fair use or freedom of speech.

Companies and individuals that enjoy sponsorship or publicity rights over slogans logically should have priority to register those slogans when they intend to license them for use on designated products, including billboard products. The Lanham Act makes this very clear regarding individuals because it bars registration of "matter which may disparage or falsely suggest a connection with persons, living or dead."<sup>86</sup> Even beyond sponsorship rights, the Lanham Act now grants owners of famous marks more extensive rights than those enjoyed by typical registrants. Specifically, trademarks ordinarily prevent uses only on similar products under circumstances that cause a likelihood of confusion.<sup>87</sup> However, owners of famous marks can use

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<sup>82</sup> 15 U.S.C. § 1125(a)(1)(A).

<sup>83</sup> See, e.g., Irene Calboli, *The Case for a Limited Protection of Trademark Merchandising*, 11 U. ILL. L. REV. 865, 880–86 (2011); Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82:5 NOTRE DAME L. REV. 1839, 1911–12 (2007).

<sup>84</sup> See, e.g., *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 928 (6th Cir. 2003).

<sup>85</sup> See, e.g., *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 802 (Cal. 2001) (stating that the right of publicity is invoked when the appropriation of a celebrity's likeness creates a misleading impression that the celebrity is endorsing a product).

<sup>86</sup> 15 U.S.C. § 1052(a).

<sup>87</sup> E.g., *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979) ("If the goods are totally unrelated, there can be no infringement because confusion is unlikely.").

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dilution principles to extend their exclusive rights to almost any application of their marks, including displays on billboard products.<sup>88</sup> In addition, the Lanham Act gives these owners the ability to oppose the registration of their marks in different product classes based on dilution principles.<sup>89</sup> Thus, at the end of the day, individuals and companies that are widely recognized by their famous names and trademarks have exclusive rights to identify themselves on billboard products through trademark registration.<sup>90</sup> This makes sense from a procedural perspective because it would be senseless to allow others to register such notable identification symbols for their products when their actual use would not be lawful; in other words, a t-shirt company should not be able to register the slogan “Just Do It” when the shoe company that owns rights to the slogan could stop use of the phrase based on sponsorship rights or dilution. More importantly, however, this slogan, unlike “Pitchfork New York,” has developed a form of secondary meaning prior to the application, given that the phrase brings the shoe company to mind no matter where it appears. Similarly, references to famous individuals may have the same effect. Thus, under these special circumstances where slogans are already widely recognized as source identifiers, the PTO should grant the identified sources priority in registering the slogans for billboard products, and should allow them to do so without having to prove secondary meaning.

### III. APPLICATION OF PUBLICITY AND SPONSORSHIP RIGHTS TO SLOGANS

When a phrase becomes sufficiently popular that it has acquired marketing value, one naturally has to ask whether a particular person, or anyone for that matter, might have the right to control it as a trademark. Should the person who first made the statement have the rights, or should it be the first person to use it on a product, or the first to file an intent-to-use trademark application? Pat Riley was granted rights to “Three-Peat” because he was the first person to file a trademark application for the slogan, although Byron Scott allegedly made it up to refer to the Los Angeles Laker’s historic opportunity to win three consecutive NBA titles.<sup>91</sup> After the media focused considerable attention on Bryce Harper’s “That’s a Clown Question, Bro” comment, a beer company understood that it might violate Harper’s rights when it

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<sup>88</sup> 15 U.S.C. § 1125(c). *See, e.g.*, Calboli, *supra* note 83, at 885–86.

<sup>89</sup> 15 U.S.C. §§ 1052(f), 1063–64

<sup>90</sup> *See* Calboli, *supra* note 83, at 895 (stating that PTO examiners and the Trademark Trial and Appeal Board have routinely allowed registrations for use on merchandised products and upheld oppositions based on the use of marks on collateral goods).

<sup>91</sup> Eric Zorn, *Marketing Coup is No Bull-oney*, CHICAGO TRIB., June 15, 1993, at C1.

used “Clown Question, Bro” on one of its brews.<sup>92</sup> Did it have reason to worry simply because Bryce Harper made the statement first? What about Iman Abdallah, who filed the first trademark application for “Let’s Roll” on billboard products?<sup>93</sup> Should the estate of Todd Beamer, the man who made the heroic statement on Flight 93, have been able to successfully oppose Abdallah’s registration?

To address these questions, one must first determine if the particular slogan actually represents a person who can claim publicity or sponsorship rights over it. If it does, that person has priority to register the slogan and can prevent others from using it for commercial purposes, unless those purposes are otherwise protected by the First Amendment.<sup>94</sup> For this reason, this section reviews what publicity rights are supposed to do, whether one might attain them in a slogan, and if so, how. Following this discussion, this Article more fully evaluates how the PTO should address the registration of slogans that are not covered by publicity rights.

According to the Restatement (Third) of Unfair Competition, the right of publicity prevents members of the public from appropriating “the commercial value of a person’s identity by using without consent the person’s name, likeness or other indicia of identity for purposes of trade.”<sup>95</sup> Under common law, the basic purpose underlying the right of publicity is to protect the economic interests of celebrities who have become famous due to their personal achievements.<sup>96</sup> Thus, the right is intended to protect the investments that recognizable individuals make in developing their personal goodwill, whether it derives from athletics, the creative arts, politics, or business.<sup>97</sup> Following this logic, when others use the names or faces of famous individuals to further their own commercial objectives, they have, in a sense, unjustly enriched themselves at the expense of the celebrity.<sup>98</sup>

One important question with the right of publicity is how broadly to frame the notion of identifying characteristics.<sup>99</sup> A person’s name is

<sup>92</sup> See Augenstein, *supra* note 5.

<sup>93</sup> See Bleicher, *supra* note 11, at 1848–49, 1859.

<sup>94</sup> See, e.g., *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 802–05 (Cal. 2001).

<sup>95</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION ch. 4, topic 3, § 46 (1995).

<sup>96</sup> See, e.g., *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575–76 (1977); *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956, 957 (6th Cir.) *cert denied*, 449 U.S. 953 (1980).

<sup>97</sup> See *Zacchini*, 433 U.S. 562. For a thorough discussion and a list of relevant cases about the right of publicity and its application in sports and other contexts, see Anastasios Kaburakis et al., *NCAA Student-Athletes’ Rights of Publicity, EA Sports, and the Video Game Industry: The Keller Forecast*, 27 ENT. & SPORTS L. 1 (2009). For a discussion on the right of publicity as applied to political figures, see Sean T. Masson, *The Presidential Right of Publicity*, 2010 B.C. INTELL. PROP. & TECH. F. 12001 (2010).

<sup>98</sup> *Id.* at 581 n.2 (“[T]he reason for recognizing a cause of action asserting a “right of publicity” is to prevent unjust enrichment.”).

<sup>99</sup> For example, a California statute extends the right of publicity to a “name, voice, signature, photograph, or likeness.” CAL. CIV. CODE § 3344(a).

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not controversial because a name is so repeatedly used to refer to a person that the public clearly understands that it represents the particular individual. Similarly, a celebrity's physical appearance is often familiar as a result of news and other media coverage, so the public will naturally make the necessary association. However, what else should count as an "indicia of identity"? Some would argue that it could be anything that the public associates with a particular individual. To illustrate, one author argued Todd Beamer had publicity rights in the phrase "Let's Roll" because it became widely known after the media reported that he said those words before attempting to take down the hijackers.<sup>100</sup> In the same way, one could argue that Bryce Harper has publicity rights in the slogan, "That's a Clown Question, Bro," due to the attention the interview has received in the press. However, precedent and policy suggest that this is not the proper way to approach the trademarking of slogans.

When publicity rights have been extended beyond a person's name or image, it has been to elements that individuals have repeated with sufficient regularity that the public recognizes them as part of their personal personas. For instance, the Ninth Circuit ruled that Ford Motor Co. might have violated Bette Midler's right of publicity by imitating her voice for a commercial because she was a professional singer with a distinctive voice that was widely known.<sup>101</sup> Likewise, Tom Waits successfully sued Frito-Lay for imitating his distinctively raspy vocal style in a song created for a Dorito's commercial.<sup>102</sup> An individual also can gain publicity rights in a nickname or stage name when that name is used to identify the individual so often that the public comes to recognize the person by it. For instance, football player Elroy Hirsch, who became well known as "Crazylegs" due to his running style, successfully argued that a company selling shaving gel under the name "Crazylegs" might have violated his right of publicity.<sup>103</sup> Likewise, Jimmy Buffett convinced the Trademark Trial & Appeal Board that he may have attained rights to "Margaritaville," almost as if it had served as a nickname, because Buffet had gone to great lengths, and succeeded in, associating the title of his song with his public persona.<sup>104</sup> The right of publicity has even protected the distinctive look of racing cars driven by the internationally famous Lothar Motschenbacher, on the theory that he consistently applied the same design to his cars so that he could be easily identified on the track.<sup>105</sup>

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<sup>100</sup> Bleicher, *supra* note 11, at 1873–74.

<sup>101</sup> Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988).

<sup>102</sup> Waits v. Frito-Lay, Inc., 978 F.2d 1093, (9th Cir. 1992).

<sup>103</sup> Hirsch v. S.C. Johnson & Son, Inc., 280 N.W.2d 129 (Wis. 1979).

<sup>104</sup> Buffett v. Chi-Chi's, Inc., 226 U.S.P.Q. 428, (T.T.A.B. 1985).

<sup>105</sup> Motschenbacher v. R.J. Reynolds Co., 498 F.2d 821 (9th Cir. 1974).

The key to all of these situations is that the identifying characteristic is something that is so repeatedly, consistently, and purposely used by, or to describe, the individual that it becomes part of the individual's distinctive persona. In a sense, these attributes help comprise the signature that serves to define the person. So, with this understanding, it is not remarkable that a court determined that Johnny Carson had publicity rights in the slogan, "Here's Johnny."<sup>106</sup> After all, the phrase by that time had been consistently used every night for twenty years to introduce Carson on *The Tonight Show*, and by its repetition the slogan was intended to be a distinctively identifying feature of Johnny Carson and his show.<sup>107</sup> By the same token, many other celebrities very well may have publicity rights in short phrases due to their consistent efforts to pair the words with their personal identities. Some credible examples, therefore, would be "Git-R-Done" (Daniel Lawrence Whitney, also known as Larry the Cable Guy),<sup>108</sup> "Take My Wife—Please" (Henny Youngman),<sup>109</sup> and "That's Hot" (Paris Hilton).<sup>110</sup>

These examples are quite different than the circumstances connecting Bryce Harper to "That's a Clown Question, Bro," or Todd Beamer to "Let's Roll." In these instances, the individuals made humorous or inspirational statements once, and received substantial media attention as a result. Although the distinction may seem subtle, just because members of the public can identify that someone said a phrase does not mean that they identify that person by the phrase. If that were the case, then public figures might reasonably claim rights to every clever line that gets significant public attention. For instance, one of the most memorable lines in political debate history was delivered by Lloyd Bensten in his vice-presidential contest with Dan Quayle when he stated, "Senator, you're no Jack Kennedy."<sup>111</sup> Now, every time that line is used, one typically thinks back to that debate. Nevertheless, few

<sup>106</sup> *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983).

<sup>107</sup> *Id.* at 832–33.

<sup>108</sup> Brian Warner, *Larry the Cable Guy Net Worth*, CELEBRITY NET WORTH, <http://www.celebritynetworth.com/richest-celebrities/richest-comedians/larry-the-cable-guy-net-worth/> (last visited May 9, 2013).

<sup>109</sup> "Take My Wife—Please" was a line used so often by Henny Youngman in his stand-up comedy routines that it was entered in Bartlett's Familiar Quotations in 1988. See Mervyn Rothstein, *Henny Youngman, King of the One-Liners, is Dead at 91 After 6 Decades of Laughter*, N.Y. TIMES, Feb. 25, 1998, available at <http://www.nytimes.com/1998/02/25/arts/henny-youngman-king-of-the-one-liners-is-dead-at-91-after-6-decades-of-laughter.html>.

<sup>110</sup> "That's Hot" is a phrase closely associated with Paris Hilton stemming from her character on the television show "The Simple Life," who says the line when she finds something interesting or amusing. See *Hilton v. Hallmark Cards*, 599 F.3d 894, 899 (9th Cir. 2009).

<sup>111</sup> Lloyd Bentsen delivered the line in the 1988 debate after Senator Dan Quayle said that he had as much experience in Congress as John F. Kennedy did when seeking the presidency. Patrick Sloyer & Gaylord Shaw, *Pulling No Punches Bensten and Quayle Clash over Qualifications*, NEWSDAY (Nov. 6, 1988) at 5.

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people would believe that Lloyd Bensten is associated with, or has somehow sponsored, the subsequent uses.<sup>112</sup> For the same reason, Byron Scott clearly had no superior claim under the right to publicity to the slogan, “Three-Peat,” just because he may have made it up and said it first.

In these instances when individuals do not have publicity rights in slogans, others can use them with their products and even protect them as trademarks under appropriate circumstances. For this reason, the beer company should have breathed a little easier when it sold its “Clown Question, Bro” beer, and perhaps could have even registered the name as its own trademark for alcoholic beverages if it had wanted. In contrast, when individuals have publicity rights in words or slogans, then others have to be significantly more careful. For instance, many athletes have followed in the footsteps of “Crazylegs” and created nicknames, such as baseball pitcher Randy Johnson, who is known as “The Big Unit.” Therefore, Johnson likely had superior rights to register the slogan as a trademark for billboard products, among other kinds of items, and in fact did just that.<sup>113</sup> This does not mean that others necessarily cannot use the phrase on their billboard products, but to do so, they have to establish First Amendment interests, such as criticism, parody or social commentary. In contrast, with phrases that are not governed by publicity rights, such as “That’s a Clown Question, Bro,” the first to file the trademark application has priority for registration. Nevertheless, as previously argued, the PTO should register the slogan as a standard character mark for billboard products only after the applicant demonstrates secondary meaning.

#### IV. TRADEMARK PROTECTION OF PROMINENT SLOGANS ON BILLBOARD PRODUCTS

Although trademarks often function as inconspicuous product identifiers that help consumers to distinguish sources, problems sometimes arise when they are given more prominent roles so that they also serve as significant selling points of the products.<sup>114</sup> For instance,

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<sup>112</sup> A more recent, but similar, example arose when Vice-President Joe Biden used the phrase “That’s a bunch of stuff” during the October 2012 vice-presidential debate with Paul Ryan. Paul West, *The Vice Presidential Debate*, L.A. TIMES, Oct. 12, 2012, at A1.

<sup>113</sup> U.S. Trademark Registration No. 2159750 (May 19, 1998); U.S. Trademark Registration No. 2914855 (Dec. 28, 2004). Similarly, Anthony Davis probably has superior rights to the slogan, “Fear the Brow,” since he nurtured public attention to his prominent unibrow, and jokingly accepted the many references to him in the press as “The Brow.” In the context of basketball, the public clearly believes that the phrase *Fear the Brow* is about Davis. For this reason, the PTO refused an application by a Kentucky apparel store to register the name for billboard products in an office action on September 8, 2012. U.S. Trademark Application Serial No. 85477805 (filed Nov. 21, 2011).

<sup>114</sup> As will soon be discussed, questions about the size and placement of the slogan lead to difficult line-drawing problems. See *infra* notes 156–158 and accompanying text. Since the

most people who see bold displays of the words “Nike” or “Just Do It” on the front of t-shirts believe that they indicate source or sponsorship. However, this may not be so clear with other phrases, such as “Are you Sure?” The question, then, is whether there are standards and restrictions used in this context to ensure that the law appropriately serves the objectives of trademark and its underlying policies. In this regard, the most important issues involve functionality, distinctiveness, and freedom of speech.

#### A. *Prominent Slogans and Functionality*

As previously noted, it is important to ensure that trademark policies do not unnecessarily interfere with the carefully balanced protection schemes of patents and copyrights. Focusing for a moment only on patents, trademarks might be disruptive if used to protect unpatented product designs or features because such items, by virtue of not being patented, are supposed to be free for all to use.<sup>115</sup> Additionally, the overarching goal of patents is to stimulate creativity by giving inventors the prospect of profiting through control of what they hope are superior product attributes.<sup>116</sup> For this reason, trademark protection potentially raises problems when exclusivity might result in competitive advantages.<sup>117</sup> The courts and Congress address both of these issues by preventing trademark protection for product features that are deemed functional.<sup>118</sup>

According to the Supreme Court, a product attribute is functional and cannot serve as a trademark “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”<sup>119</sup> Based on this definition, two branches of functionality have developed: one based on features that perform useful functions (“utilitarian functionality”) and the other addressing aesthetic attributes (“aesthetic

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article advocates treating the registration of slogans for billboard products with the same standard, no matter how they are displayed on the specimen, these line drawing problems would be eliminated.

<sup>115</sup> *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001) (“In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying.”).

<sup>116</sup> *Burgunder*, *supra* note 43, at 725; *See Traffix*, 532 U.S. at 34 (“The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.”); *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 164–65 (1995) (stating that it is the province of patents to encourage innovation by granting a monopoly over product designs, but color may be protected by trademark as long as it is not more desirable than other colors could be).

<sup>117</sup> *See, e.g., Qualitex*, 513 U.S. at 165; *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 339–40 (7th Cir. 1985).

<sup>118</sup> The Lanham Act prevents registration if a feature is functional, 15 U.S.C. § 1052(e)(5), and requires a person suing for infringement of trade dress to prove that the material is not functional, 15 U.S.C. § 1125(a)(3).

<sup>119</sup> *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982).

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functionality”). With utilitarian functionality, there was once a debate whether a useful feature was “essential” to its operation if competitors could design their products in other ways and achieve the same function.<sup>120</sup> The Supreme Court put the issue to rest in *Traffix Devices, Inc. v. Marketing Displays, Inc.*,<sup>121</sup> holding that a feature is essential, even in the face of potential alternatives, if it contributes to the operation of the article in more than an incidental fashion.<sup>122</sup> However, when considering aesthetic functionality, the Supreme Court has taken a less absolute approach, stating that the focus is whether trademark protection would cause competitors to suffer “a significant non-reputation related disadvantage.”<sup>123</sup> Thus, the inquiry here very much depends on competitive realities and consequences.<sup>124</sup>

When slogans appear on billboard products, they can only be feasibly functional in an aesthetic sense; clearly they do not affect utilitarian objectives, such as the fit or quality of the physical article. Thus, functionality only applies if trademark protection would foster an unfair advantage in the market.<sup>125</sup> In this regard, courts consider two tests to appraise potential inappropriate effects: (1) whether the aesthetic feature is an important reason to purchase the product [the “important-reason-to-purchase” test],<sup>126</sup> and (2) whether the attribute is more attractive or desirable than other potential options that competitors might use with their products [the “competitive-alternatives” test].<sup>127</sup>

The “important-reason-to-purchase” test has a somewhat checkered history,<sup>128</sup> and has only been used in a few circumstances to

<sup>120</sup> See, e.g., *Mktg. Displays, Inc. v. Traffix, Inc.*, 200 F.3d 929, 940 (6th Cir. 1999), *rev'd Traffix*, 532 U.S. 23 (2001).

<sup>121</sup> 532 U.S. 23 (2001).

<sup>122</sup> *Id.* at 32–33.

<sup>123</sup> *Id.* at 33 (“It is proper to inquire into a ‘significant non-reputation-related disadvantage’ in cases of esthetic functionality. . . .”) (quoting *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 165 (1995)).

<sup>124</sup> *Qualitex*, 514 U.S. at 170 (“[I]f a design’s ‘aesthetic value’ lies in its ability to ‘confe[r] a significant benefit that cannot practically be duplicated by the use of alternative designs,’ then the design is ‘functional.’”) (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 cmt c (1993)).

<sup>125</sup> *Id.* (“The ‘ultimate test of aesthetic functionality[] . . . is whether the recognition of trademark rights would significantly hinder competition.’”) (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 cmt c (1993)).

<sup>126</sup> See *id.* at 165 (citation omitted); *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343 (9th Cir. 1952) (finding floral design of china pattern to be aesthetically functional because it was an important reason in its commercial success); *Industria Arredamenti Fratelli Saporti v. Charles Craig, Ltd.*, 725 F.2d 18, 20 (2d Cir. 1984) (finding the design of an Italian sofa aesthetically functional because it was a principal characteristic of the sofa and enhanced its salability).

<sup>127</sup> See, e.g., *Qualitex*, 514 U.S. at 169–70 (evaluating the aesthetic functionality of product color in terms of competitive need); *W.T. Rogers Co., Inc. v. Keene*, 778 F.2d 334, 343 (stating that the hexagonal end panel of stacking tray is not aesthetically functional if effective competition is possible without it, such as by using other shapes that are equally appealing).

<sup>128</sup> For a history of aesthetic functionality and problems related to the “important factor test,” see *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 696 F.3d 206, 219–22 (2d Cir. 2012);

limit trademark protection, such as with a china pattern<sup>129</sup> and the design of an Italian sofa.<sup>130</sup> However, the approach, if held to be applicable, could have widespread implications for protecting slogans on billboard products, since consumers usually are significantly motivated to buy the merchandise so that they can display the slogan adorning it. For instance, athletes buy t-shirts that say “Just Do It” because they want to express the attitude that Nike has built around its brand image. Likewise, tennis players might want to buy a hat that says “Are you Sure?” to express moral superiority in a humorous way. These scenarios differ in one crucial way, however. Consumers want merchandise bearing “Just Do It” because of the reputation created by Nike. In effect, the slogan reflects the goodwill generated by Nike; thus, doing just what a trademark is supposed to do. This is why the Supreme Court defined functionality in terms of non-reputation related advantages. Hence, consider the plight of an automobile accessories company that wanted to sell products, such as key chains and license plate holders, to owners of Audi automobiles.<sup>131</sup> It argued that application of the word “Audi” is functional because the trademark is an important reason for purchase, but it lost because the advantage was not based on the inherent desirability of the word “Audi,” but rather the goodwill of the automaker’s trademark.<sup>132</sup> Thus, although critics may challenge the notion of sponsorship rights for a variety of reasons, functionality is not an appropriate basis to do so.<sup>133</sup> For this reason, companies that have well-known slogans that serve as trademarks in other contexts have rights to control those phrases on billboard products, barring typical trademark defenses.

When the phrase is not a famous moniker governed by sponsorship or dilution rights, then the application of aesthetic functionality becomes more credible. Having said this, some courts have rejected the “important-reason-to-purchase” test altogether,<sup>134</sup> while others usually find alternative grounds to deny trademark rights.<sup>135</sup> For instance, just as a slogan may be an important reason to purchase a billboard product,

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Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc., 457 F.3d 1062, 1067–72 (9th Cir. 2006).

<sup>129</sup> *Pagliero*, 198 F.2d 339.

<sup>130</sup> *Industria Arredamenti*, 725 F.2d 18.

<sup>131</sup> *Au-Tomotive Gold*, 457 F.3d 1062 (the defendant also sold merchandise bearing the trademark, Volkswagen).

<sup>132</sup> *Id.* at 1064, 1074.

<sup>133</sup> See Calboli, *supra* note 83, at 888–91, and sources cited therein. One case that questioned sponsorship rights based on the important-reason-to-purchase test is *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912, 917–18 (9th Cir. 1980). The Ninth Circuit, though, subsequently discounted the rationale of that decision. See *Au-tomotive Gold*, 457 F.3d at 1069 (Job’s Daughters “was a somewhat unique case and its broad language was soon clarified and narrowed.”).

<sup>134</sup> See, e.g., *Keene Corp. v. Paraflex Indus., Inc.*, 653 F.2d 822, 825 (3d Cir. 1981).

<sup>135</sup> See, e.g., *Louboutin*, 696 F.3d at 221.

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so too might one allege that color is an important factor with fashion design. In fact, Yves Saint Laurent made this claim when Christian Louboutin sued it for violating Louboutin's registered trademark in red-soled shoes.<sup>136</sup> The district court judge agreed, finding that in the fashion industry, color serves aesthetic functions vital to robust competition.<sup>137</sup> The Second Circuit Court of Appeals, though, was not so sure, and expressed doubts that a monochromatic color must always be functional with fashion.<sup>138</sup> Nonetheless, it ultimately did not have to appraise functionality because it determined that Louboutin's trademark only extended to shoes with contrasting uppers, and not to shoes with red uppers, such as those sold by Yves Saint Laurent.<sup>139</sup>

In sum, slogans that prominently appear on billboard products arguably may be functional based on the "important-reason-to-purchase" test, thereby foreclosing any possibility of protecting them as trademarks.<sup>140</sup> Nevertheless, given the background in the courts, this article does not adopt this approach, but instead recognizes that there are times when prominent slogans may serve as trademarks, even when they are not famous in other contexts. If nothing else, the uncertainty and confusion raised by the "important-reason-to-purchase" test for aesthetic functionality should send a warning that greater caution must be exercised before granting trademark rights to slogans. This article heeds this warning by calling for moderate additional restraints before registering them as trademarks for billboard products.

The "competitive-alternatives" test is the most widely accepted method for evaluating aesthetic functionality.<sup>141</sup> The primary difficulty with framing this test is defining the breadth of the competitive market.<sup>142</sup> So for instance, with "Three-Peat," the competitive market could be framed as billboard products that express: (1) any sentiment, (2) a positive sentiment in sports, (3) a desire to win three consecutive titles in a clever way, or (4) a desire to win three titles in a row using the word, peat. Unless the market is defined very narrowly, as with level four, the "competitive-alternatives" test should not serve as a bar to

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<sup>136</sup> *Louboutin*, 696 F.3d 206.

<sup>137</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 452–53 (S.D.N.Y. 2011), *aff'd in part, rev'd in part*, 696 F.3d 206.

<sup>138</sup> *Louboutin*, 696 F.3d at 223–24.

<sup>139</sup> *Id.* at 227–28.

<sup>140</sup> See *Damn I'm Good, Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357 (1981) (finding the use of the phrase "Damn I'm Good" on bracelets did not identify source and was functional because it was an important ingredient in the products commercial success).

<sup>141</sup> See, e.g., *Louboutin*, 696 F.3d at 221–22.

<sup>142</sup> See Anna F. Kingsbury, *Market Definition in Intellectual Property Law: Should Intellectual Property Courts Use an Antitrust Approach to Market Definition?*, 8 MARQ. INTELL. PROP. L. REV. 63, 68 (2004) (stating that an assessment of functionality requires that a court "identify competitors, which in turn requires identification of the market in which they compete."); Lee B. Burgunder, *Trademark Protection of Product Characteristics: A Predictive Model*, 16 J. PUB. POL'Y & MKTG. 277, 285 (1997).

trademark registration. Using level three, which intuitively feels most appropriate, companies that want to sell billboard products to compete with “Three-Peat” could use slogans such as “We are Three,” “Victor-Three,” “Have no Sympa-Three,” and “Tic Tac Toe, Here We Go,” to name just a few. Similarly, in most other circumstances, there typically will be several suitable alternative ways to convey the same message. For this reason, functionality will normally be a clearable hurdle for those wanting to protect slogans on billboard products.

### B. *Prominent Slogans and Distinctiveness*

In the classic formulation of trademark function, companies place names or symbols on their products so that consumers can easily find what they want. The system works because consumers recognize that the mark is something that is separate from the basic product, and they use it to distinguish source.<sup>143</sup> With traditional marks, the notion of separation is assumed, so the only real issue concerns the distinctiveness of the mark; that is, whether the mark is so inherently distinctive that it can be registered immediately, or whether it must acquire distinctiveness through secondary meaning in order to receive the protection of the trademark system.<sup>144</sup>

Over time, courts have expanded the range of devices that can serve as trademarks so that forms of trade dress, such as packaging and product designs can be protected.<sup>145</sup> The evaluation of these new breeds of trademarks, though, does not always fit neatly into the schemes used for words and symbols. Packaging, for instance, is somewhat like the use of names and symbols, in that consumers may easily perceive it as separate from the essential product.<sup>146</sup> However, packaging often is defined by colors and designs, requiring courts to rely on other considerations besides the meaning of words to evaluate inherent distinctiveness.<sup>147</sup> For example, elements that are unique or unusual in the field may be protected immediately, while others require proof of secondary meaning.<sup>148</sup>

The analysis becomes most troublesome with product designs because the allegedly identifying features cannot be clearly separated from the products they are supposed to represent.<sup>149</sup> For this reason, the

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<sup>143</sup> See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212 (2000).

<sup>144</sup> *Id.* at 212–13.

<sup>145</sup> *Id.* at 209–10.

<sup>146</sup> *Id.* at 212.

<sup>147</sup> See *id.* at 214; *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977).

<sup>148</sup> See *Seabrook*, 568 F.2d at 1345 (finding that Seabrook’s package design was not unique in the field, and therefore it needed to demonstrate proof that it had acquired secondary meaning.).

<sup>149</sup> See *Samara*, 529 U.S. at 213 (“[W]here product design is concerned we have little confidence that a reasonably clear test can be devised.”).

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Supreme Court determined that consumers would almost never, at first, perceive elements of product designs to be trademarks, but rather would view them as aspects of the products themselves.<sup>150</sup> Thus, product designs are never treated as inherently distinctive.<sup>151</sup> However, over time, consumers may begin to conceptually separate the features of the product design from the overall product and recognize that they identify source.<sup>152</sup> As a result, product designs may ultimately serve as trademarks, but only after there is proof of secondary meaning.<sup>153</sup>

Because a billboard product is intended to display a message, that message, by definition, is part of the core function of the product. For this reason, there should be little doubt that prominent slogans on billboard products must be treated in the same way as product designs.<sup>154</sup> A bumper sticker that says “Three-Peat” is no different than a chair with a uniquely designed seat: at first, the attributes don’t serve a trademark function because consumers don’t recognize or use them to identify source. At that point, they are simply perceived as part of the product, meaning that other companies are free to appropriate them unless the attributes are protected by a patent or copyright. This means that the initial seller of “Three-Peat” bumper stickers has no right to prevent others from prominently displaying the slogan on their products. However, if other businesses do not take the opportunity to enter the fray, then consumers, over time, might start to believe that the slogan always originates from the same source, especially if the seller takes steps to enhance the slogan’s brand significance.<sup>155</sup> Should that occur, the slogan will have attained secondary meaning, thereby opening the door for trademark protection.

The preceding discussion raises a number of related questions. Could the size or location of the message affect its trademark status?<sup>156</sup> For instance, if the slogan “Three-Peat” only appeared in small letters on the back of a hat, would consumers recognize it as a trademark?<sup>157</sup> Assuming that the slogan is the only statement on the hat, consumers would still probably just believe that it is a cool way to display what the

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<sup>150</sup> *Id.*

<sup>151</sup> *Id.* at 212, 216.

<sup>152</sup> *Id.* at 212.

<sup>153</sup> *Id.* at 212, 216.

<sup>154</sup> See T.M.E.P. § 1202.03(f)(i); *cf. Samara*, 529 U.S. 205 (treating children’s clothing, decorated with appliques of hearts, flowers, and fruits as product design).

<sup>155</sup> Exclusivity of use is one of several factors that are relevant in demonstrating secondary meaning. See *Ford Motor Co. v. Summit Motor Prod., Inc.*, 930 F.2d 277, 292 (3d Cir. 1991). The Lanham Act also provides that five years of continuous and exclusive use may be treated as prima facie evidence of secondary meaning. 15 U.S.C. § 1052(f).

<sup>156</sup> The Trademark Manual of Examining Procedure states that the “examining attorney must also consider the size, location, and dominance of the proposed mark, as applied to the goods, to determine whether ornamental matter serves a trademark function.” T.M.E.P. § 1202.03(a).

<sup>157</sup> See *id.* (stating that a “small, neat, and discrete word or design feature . . . may be likely to create the commercial impression of a trademark . . .”).

wearer wants to express. If several hats from that seller, on the other hand, prominently displayed other unrelated messages, then it is possible that the small slogan on the back could immediately attain brand significance. Given the nature and purpose of billboard products, however, this scenario seems highly unlikely. So is it worth devising systems to accurately pinpoint the relatively few situations when slogans actually have immediate source significance? In addressing the same question in the context of product design, the Supreme Court declared, “the game of allowing suit based upon alleged inherent distinctiveness seems to us not worth the candle.”<sup>158</sup> The same conclusion should be reached with slogans on billboard products, and similarly, the standard should be a blanket rule requiring proof of secondary meaning prior to trademark protection.

As noted, since a billboard product is intended to display a message, the slogan has to be considered a part of the product. However, if the slogan is written with a unique flair and/or is combined with a distinctive design, then these attributes may be considered separate from the product. In effect, these stylistic notes should be treated like packaging that accompanies the product, and allowed to immediately serve as a trademark if inherently distinctive. This makes sense because although the design elements are connected to the product, they are not directly related to the core product function. The Supreme Court actually provided precedent for treating design elements as such in *Two Pesos v. Taco Cabana, Inc.*, when it considered the décor of a restaurant to be akin to packaging.<sup>159</sup> This result thus supports the analogous conclusion posited here—that slogans with distinctive design elements can be immediately registered, but with a statement disclaiming rights to the words.

Thus far, all of the discussion regarding distinctiveness has concerned slogans that had not previously gained notoriety as trademarks in other contexts. However, if consumers immediately recognize that a phrase appearing on a billboard product serves as a trademark, then it already functions to identify source, albeit for something other than the product displaying it.<sup>160</sup> Thus, in a sense, these slogans already have a form of secondary meaning that justifies

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<sup>158</sup> *Samara*, 529 U.S. at 214.

<sup>159</sup> *Two Pesos v. Taco Cabana, Inc.*, 505 U.S. 763 (1992). In *Two Pesos*, the Supreme Court ruled that inherently distinctive restaurant décor is protected as trademark under the Lanham Act without proof of secondary meaning. *Id.* at 776. Moreover, in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, the Supreme Court distinguished *Two Pesos* by concluding that the restaurant décor in that case was more like packaging than product design. *Samara*, 529 U.S. at 214–15.

<sup>160</sup> The PTO accepts this position. The Trademark Manual of Examining Procedure states, “Ornamental matter that serves as an identifier of a ‘secondary source’ is registrable on the Principal Register. For example, ornamental matter on a t-shirt (e.g., the designation ‘NEW YORK UNIVERSITY’) can convey to the purchasing public the ‘secondary source’ of the t-shirt (rather than the manufacturing source).” T.M.E.P. § 1202.03.

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granting them immediate protection, even as trademarks for the billboard products. This conclusion supports the rationales behind sponsorship rights, and it is entirely consistent with the general rule requiring proof of secondary meaning prior to protecting slogans as trademarks.<sup>161</sup>

*C. Slogans, Copyright Policy, and the First Amendment*

Copyright policy protects expressions from copying to provide incentives for artists and authors to invest their creative energies into developing original works. Since copyright law prevents others from stating their ideas with substantially similar expressions, the system is naturally in tension with the First Amendment. In addressing First Amendment conflicts, courts must attempt to balance the competing interests, weighing the importance of the state interest, here motivating creativity, against the degree of intrusion on free speech rights.<sup>162</sup> With copyright, this balance usually is accomplished through the concept of fair use, which provides a defense to infringement.<sup>163</sup>

Copyright does not protect brief phrases and slogans.<sup>164</sup> For one, slogans are so short that they add little, if any, creativity beyond the idea itself.<sup>165</sup> Copyrights, of course, do not protect ideas, which must remain in the public domain.<sup>166</sup> Also, any effort that might be involved with creating slogans is so slight that copyright is not needed to motivate people to share them.<sup>167</sup> For this reason, they must remain free for the public to copy, unless other policies clearly warrant limitations to advance distinct objectives. Trademark policies, of course, have the very different goal of preventing consumer confusion. But since expressing a slogan treads so close to the line of simply stating an idea, the government should be very sure that trademark protection is

<sup>161</sup> See T.M.E.P. § 1202.03(c) (discussing registration based on sponsorship identification); T.M.E.P. § 1202.03(d) (indicating that ornamentation which has acquired distinctiveness may be registered); T.M.E.P. § 1212 (discussing acquired distinctiveness through proof of secondary meaning).

<sup>162</sup> See, e.g., Alan E. Garfield, *The First Amendment as a Check on Copyright Rights*, 23 HASTINGS COMM. & ENT. L.J. 587, 591–92 (2001).

<sup>163</sup> See, e.g., *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985); *Religious Tech. Center v. Henson*, 182 F.3d 927, 927 (9th Cir. 1999), *cert denied*, 528 U.S. 1105 (2000).

<sup>164</sup> See U.S. Copyright Office, Circular 34, *Copyright Protection Not Available for Names, Titles or Short Phrases* (stating that the Copyright Office cannot register claims to exclusive rights in brief combinations of words such as slogans or short advertising expressions).

<sup>165</sup> *But see* STEPHEN M. MCJOHN, COPYRIGHT: EXAMPLES AND EXPLANATIONS 20 (2006) (“The rule [against copyrights for words and short phrases] is often justified by stating that words or short phrases are not sufficiently original . . . [b]ut certainly even a single word could . . . have more than the requisite minimal spark of creativity . . .”).

<sup>166</sup> 17 U.S.C. § 102(b).

<sup>167</sup> See *Feist Publ’n, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 359 (1991) (“There remains a narrow category of works in which the creative spark is utterly lacking or is so trivial as to be virtually nonexistent. Such works are incapable of sustaining valid copyright.”) (citation omitted).

necessary to reduce confusion before attaching trademark rights.<sup>168</sup> This concern is especially acute when trademarks prevent others from making statements on billboard products, which are largely designed to express ideas. Thus, it makes sense to require proof of secondary meaning before protecting slogans as trademarks to prevent both a clash with the copyright system as well as unconstitutional intrusions on free speech rights.

Even when laws grant trademark or publicity rights, the First Amendment limits application of these rights to ensure that they do not unduly interfere with rights to free speech.<sup>169</sup> When striking this balance, courts tend to appraise two things. First, they often frame their tests in terms of whether people will truly face some likelihood of confusion or dilution given the circumstances of the unpermitted use.<sup>170</sup> Often, the alternative application changes the words or combines them with other images for purposes such as criticism or parody, which makes it clear that the product neither comes from, nor is sponsored by, the trademark holder.<sup>171</sup> Thus, courts often account for First Amendment rights simply through traditional tests for confusion and dilution.<sup>172</sup> Of most relevance here, courts are far more likely to find a likelihood of confusion if the trademark is used on products that directly compete with or are similar to those sold by the trademark holder.<sup>173</sup>

On the other side of the ledger, courts will also assess how protection might infringe free speech rights. For this reason, courts often tolerate uses that serve to legitimately comment, criticize, or report on the trademark or publicity rights holder.<sup>174</sup> Furthermore, courts are more likely to approve uses that add transformative value since these involve the inclusion of new artistic expressions and

<sup>168</sup> See *Turner Broad. Sys., Inc. v. F.C.C.*, 512 U.S. 622, 662 (1994) (content neutral regulations are constitutional if, among other criteria, they do not “burden substantially more speech than necessary to further the government’s interest.”).

<sup>169</sup> See, e.g., *Rosa Parks v. LaFace Records*, 329 F.3d 437, 447–48 (6th Cir. 2003); *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1998); *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 21 P.3d 802, 802–10 (Cal. 2001).

<sup>170</sup> See, e.g., *Parks, id.* at 447–48 (citing numerous cases therein).

<sup>171</sup> See, e.g., *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161 (C.D. Cal. 1998).

<sup>172</sup> See, e.g., *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1007–10 (9th Cir. 2001); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, L.L.C.*, 464 F. Supp. 2d 495 (E.D. Va. 2006); *Bally Total Fitness*, 29 F. Supp. 2d. 1161.

<sup>173</sup> See, e.g., *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979) (explaining that with competing goods, likelihood of confusion is determined by comparing the similarity of the marks, while with related, but noncompeting goods, several other factors are relevant.)

<sup>174</sup> See, e.g., *W. Mack Webner & Leigh Ann Lindquist, Transformation: The Bright Line Between Commercial Publicity Rights and the First Amendment*, 37 AKRON L. REV. 171, 188–191 (2004); *Comedy III*, 21 P.3d at 807 (“[T]he right to comment on, parody, lampoon, and make other expressive uses of the celebrity image must be given broad scope.”); *Montana v. San Jose Mercury News*, 40 Cal. Rptr. 2d 639, 640–41 (Cal. Ct. App. 1995); *Dora v. Frontline Video*, 18 Cal. Rptr. 2d 790, 791 (Cal. Ct. App. 1993).

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ideas.<sup>175</sup> The application of these factors, of course, is very context and fact specific, but one thing is clear: the First Amendment probably is not going to rescue a use which does little else but display the otherwise legally protected element.<sup>176</sup>

#### V. PTO REGISTRATION PRACTICES FOR SLOGANS ARE TOO PERMISSIVE

It is time for the PTO to directly address what most people who file trademark applications for slogans on billboard products are trying to do: control the right to display clever statements on their gear to gain an advantage over rivals while the phrases remain popular. Under current policy, all that one typically has to do to achieve this goal is win the race to file an intent-to-use application at the PTO, and then use the name on a tag or label within a couple of years. The PTO should not be fooled by such attempts at opportunistic trademarking.

The PTO operates on the theory that everything changes as soon as the slogan is used in a typical source-designating fashion. However, this is merely a facade to obtain registration for something that should not be so quickly registered. People who see “Three-Peat” prominently displayed on shirts are going to think it is a prayer to win three titles in a row, regardless of whether the shirt was sold with a tag. Even purchasers who notice the tag probably only believe that the tag merely restates what the shirt provides. As previously noted, putting the slogan on a tag will not create trademark significance despite its size and location. Rather, at this juncture, the slogan will only serve as a generic statement of what the product is: a shirt requesting a three-peat. Only after those who see the slogan on the shirt believe that the phrase has source significance, will the tag take on an appropriate trademark function. For this reason, unless it has prior source significance, the PTO should refuse to register a slogan for a billboard product until there is adequate proof of secondary meaning.

One might argue that protecting a slogan, as a trademark, would not prevent others from prominently displaying the slogan because such displays are not trademark uses that would cause a likelihood of confusion. That is, in that context, consumers will perceive the slogan to be part of the product, and thus without source-designating properties, at least until the slogan attains secondary meaning. As such, one might legitimately claim that a registration for “Three-Peat” should not prevent another company from prominently putting the slogan on a shirt unless the trademark holder can prove that consumers attach source significance to the phrase in the prominent context. This means

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<sup>175</sup> See, e.g., *Comedy III*, 21 P.3d at 808.

<sup>176</sup> See *id.* at 811.

the company owning the registered mark might be able to prevent others from using the slogan on their labels or in some other source-designating fashion, but could not legitimately stop the non-trademark uses. In fact, numerous people at the time probably knew “Three-Peat” had something to do with the Lakers; however, most would not have thought it identified the team, and even fewer would have thought someone such as Pat Riley, was the source of the shirts or bumper stickers. So, think what this means in terms of copyright policy and the First Amendment, for if no legitimate trademark objectives are satisfied then the public must be free to duplicate the uncopyrighted material.

Herein lies the problem. Companies that have registrations for slogans, such as “Three-Peat,” may threaten to sue anyone who displays the slogan on their billboard products, alleging trademark infringement based on a likelihood of confusion.<sup>177</sup> Although the suit probably has little merit, the individual sued has reasons to worry. The trademark holder certainly will allege that the person is making a trademark use, and of course, a prominent display feasibly can be a trademark use, as for instance in situations involving sponsorship or publicity rights, or when the mark has attained secondary meaning. Therefore, the trademark holder can at least make a credible threat, especially since the PTO has registered the mark, and thus validated its source-identifying potential.<sup>178</sup> Given this, when a registered mark is used on competing products, courts typically only evaluate the similarity of the marks to appraise the likelihood of confusion.<sup>179</sup> That might make the case appear to be a slam-dunk loser unless the defendant can raise free speech defenses, such as parody or artistic transformation. But those arguments will just not work to help those companies that simply want to use the slogan for what it means—to win three titles in a row. This is probably why manufacturers felt a need to license “Three-Peat” in 1993 for Chicago Bulls merchandise after the team won three NBA titles in a row.<sup>180</sup> This happened, despite the fact that almost nobody would have believed that the merchandise was somehow connected to some singular source that sold “Three-Peat” items during the Lakers championship run. For this reason, the registration of “Three-Peat” served to chill legitimate speech that others had a constitutional right to express.<sup>181</sup>

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<sup>177</sup> This is true even when the purchaser of the billboard product knows that the trademark owner did not authorize the display of the trademark on the product, based on the doctrine of post-sale confusion. *E.g.*, *Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc.*, 457 F.3d 1062, 1077–78 (9th Cir. 2006).

<sup>178</sup> *Cf.*, *Samara*, 529 U.S. at 213 (finding that a blanket rule requiring secondary meaning for protection of product designs is justified because of plausible threats of a lawsuit).

<sup>179</sup> *See, e.g.*, *Sleekcraft*, 599 F.2d at 348.

<sup>180</sup> *See* Richard Sandomir, *The Economics of a Sports Cliché*, N.Y. TIMES, June 22, 1993, at D1.

<sup>181</sup> As an example, Pat Riley sent a cease and desist letter to a seller of t-shirts that displayed the phrase, “Three-Pete” in anticipation of head coach Pete Carroll leading the U.S.C. Trojans to a possible third straight Rose Bowl title. *See* Rovell, *supra* note 9.

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Due to this very real danger, slogans should not be registered for billboard products until the applicant can demonstrate that the slogan actually identifies source.

In light of these considerations, the PTO should consider the following principles when reviewing applications for slogans on billboard products. If the slogan is identified so closely with an individual that the person has publicity rights to it, then only this individual should be able to register it, and should be able to do so immediately without proof of secondary meaning. Likewise, a company that owns trademark rights to a slogan that has become famous for identifying that company should be able to register the phrase for billboard products instantly. In all other circumstances, the applicant should have to demonstrate secondary meaning prior to registering a slogan as a standard character mark. A company can prove secondary meaning based on a variety of factors, such as a long period of exclusive use, surveys of consumer understanding, the amount of money spent on advertising referring to the slogan as a brand, among other indicia of source significance.<sup>182</sup> The key to all of these factors is that the proof depends on actual use. This means the PTO should reject intent-to-use applications in these instances and insist on use-based applications after the applicants can demonstrate secondary meaning. In the meantime, those wishing to obtain trademark rights can register their use of the phrase on the Supplemental Register.<sup>183</sup> Finally, the PTO can immediately register distinctive marks consisting of slogans combined with stylistic elements and designs, as long as the application disclaims rights to the slogan itself. Any rights to the slogan as a standard character mark could only come later, with proof of secondary meaning.

### CONCLUSION

This article demonstrates that the PTO has been too liberal in allowing firms and individuals to register clever sayings opportunistically so that they can maintain exclusive rights to use them on billboard products. In conclusion, the PTO should refuse registration for slogans unless the applicant can demonstrate that the phrase has attained secondary meaning through use as a designation of source. This will end the practice of unfairly granting trademark rights to the

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<sup>182</sup> See, e.g., *Ford Motor Co. v. Summit Motor Prod., Inc.*, 930 F.2d 277, 292 (3d Cir. 1991) (“[A] non-exclusive list of factors which may be considered [in evaluating the existence of secondary meaning] includes the extent of sales and advertising leading to buyer association, length of use, exclusivity of use, the fact of copying, customer surveys, customer testimony, the use of the mark in trade journals, the size of the company, the number of sales, the number of customers, and actual confusion.”).

<sup>183</sup> An application for registration on the Supplemental Register must be based on actual use of a mark in interstate commerce, and not merely the intent to use a mark. See T.M.E.P. § 1102.03.

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first to win the race to the trademark office. It also will protect the integrity of the copyright system and prevent the unconstitutional chilling of First Amendment rights. So, is this issue important? That's a clown question, bro.