

Against Fair Use: The Case for a Genericness Defense in Expressive Trademark Uses

Xiyin Tang*

ABSTRACT: The ever-expanding reach of trademark law and the narrowing strictures of trademark law's fair use doctrine demand new ways of thinking about defenses in artistic use cases. Trademark law currently acknowledges two types of expressive use as "fair": works that target or comment upon a trademarked work itself, and works that somehow "transform" the original. Defending a claim of infringement on these grounds is lengthy, fact-intensive, and, above all, expensive—thereby chilling protected expression. These defenses also do not adequately capture numerous modes of modern-day artistic expression, many of which do not even recognize a unique "original" to comment upon. This Article argues for increasing the use of genericide or genericness defenses in expressive use cases.

Genericide is a doctrine in which a formerly-protectable mark is held to be unprotectable because it no longer signifies the source or producer of the product (e.g., Aspirin as a product made by Bayer) but instead a category or genus of product (aspirin as pain reliever that a generic manufacturer can call their product). Defendants in expressive use cases should argue that the formerly-protectable mark has become generic in a specific market or industry as signifying not the producer but a category or genus of product—for example, that Cristal has become, in the rap industry, generic for champagne. Rather than claiming transformativeness or critical commentary in the hopes of winning a fair use defense, artists should emphasize that they did not, for example, reference Louis Vuitton to target or comment on either the mark itself or its producer—but rather that Louis Vuitton has become generic in the art industry as a general way of signaling a luxury product.

This defense would have the advantage of invalidating a trademark once and for all within a specific industry. The law's present focus on forcing every

* Lecturer, Yale University; Visiting Fellow, Yale Law School Information Society Project; J.D, Yale Law School; B.A., Columbia University. Many thanks to Barton Beebe, Ian Ayres, Jack Balkin, and the editors of the *Iowa Law Review*, especially Robert Fitzgerald, for their helpful comments and insight. For full-color versions of the graphs featured on pages 2060 and 2061, please e-mail me at xiyin.tang@yale.edu.

expressive use into the fair use defense does art a disservice by recognizing only one type of expressive use—parody—as “fair.”

I.	INTRODUCTION.....	2022
II.	DEFINING “GENERICIDE” AND “GENERICNESS”	2026
A.	THE ECONOMIC RATIONALE OF GENERICIDE.....	2026
B.	THE EXPRESSIVE MODEL OF GENERICIDE	2028
C.	A SEMIOTIC MODEL OF GENERICIDE.....	2031
III.	AGAINST FAIR USE	2032
A.	THE MANY FACES OF FAIR USE.....	2032
1.	The Initial Hurdle: “Non-Mark” Uses.....	2033
2.	“Nominative” and “Classic” Fair Uses	2034
3.	Parodic Fair Uses.....	2037
4.	The Trademark Dilution Revision Act	2037
B.	THE PROBLEM WITH PARODIES AND THE “COMMENTING UPON THE ORIGINAL” REQUIREMENT.....	2039
1.	What is a Parody?.....	2039
2.	Gutting the First Amendment.....	2040
3.	Parody as Commentary: Is That All There Is?.....	2042
4.	The Failure of the Parody Defense: A Case Study	2044
IV.	GENERICITY IN THE 21ST CENTURY.....	2046
A.	WHAT DOES IT ALL MEAN?.....	2046
B.	A LOOK AT MATTEL, INC. V. MCA RECORDS, INC. FROM THE GENERICIDE PERSPECTIVE.....	2048
V.	A GENERICNESS APPROACH TO ARTISTIC USE	2050
A.	POTENTIAL CRITIQUES OF THE GENERICIDE DEFENSE	2050
B.	GENERIC BY MARKET.....	2053
C.	GENERIC BY CASE	2055
D.	GENERICISM AS A FAIR USE FACTOR.....	2058
E.	A LAST OBJECTION: IS EVERYTHING FAMOUS . . . GENERIC?.....	2059
VI.	CONCLUSION	2062

I. INTRODUCTION

In recent years, even those outside the legal community have come to know the two-word phrase “fair use.”¹ It’s become the darling child of

1. E.g., Randy Kennedy, *Apropos Appropriation*, N.Y. TIMES (Dec. 28, 2011), <http://www.nytimes.com/2012/01/01/arts/design/richard-prince-lawsuit-focuses-on-limits-of-appropriation.html> (asking whether Richard Prince’s works are “[t]heft or fair use”); see also 15

transformativeness and critical commentary meant to save the intellectual property laws from overreach, oft-cited by courts as an engine of free speech and First Amendment protection.² Yet fair use is riddled with problems, as we all know: it's a defense, not an affirmative right; there are no bright-line rules; it's case-by-case; it's notoriously unpredictable.³ Nonetheless, everything from rap songs to chewy dog toys have been saved by fair use, in both the copyright and trademark infringement contexts.⁴ In recent years, what I like to call the "postmodern problem" has highlighted yet another glaring inadequacy of the fair use doctrine: its insistence that the new work somehow comment on or transform the original work.⁵ And yet the postmodern condition suggests that it is precisely the inability of a work to be unique enough to parody (in which the copyrighted or trademarked work, with its "original and separate

U.S.C. § 1115(b)(4) (2012) (alleging fair use as a defense to a claim by the holder of a registered mark); 17 U.S.C. § 107 (2012) (discussing limitations on fair use). Because genericide is strictly a trademark defense, this Article focuses on fair use case studies in the trademark context. Nonetheless, fair use case law in the copyright context informs and is quite analogous to that in the trademark context, including its emphasis on commentary on the original work/mark (i.e., parody). *See, e.g.,* *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999) ("[W]hatever protection is to be afforded a trademark parody must be informed by the Supreme Court's recent elucidation in the copyright context of parodies allegedly protected by the defense of fair use."); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 774 (8th Cir. 1994) (comparing the fair use doctrine's analysis of parodies in the copyright context to the present trademark parody defense). Therefore, throughout this Article, I sometimes refer to copyright fair use cases by way of elucidating concepts and critical court decisions on, for example, parody and satire.

2. In *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003), the Court specifically cites fair use as a "built-in First Amendment accommodation[]." As a result, fair use provides "considerable latitude for scholarship and comment." *Id.* at 190 (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985)).

3. *See, e.g.,* *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1171 (9th Cir. 2012); *Dellar v. Samuel Goldwyn, Inc.*, 104 F.2d 661, 662 (2d Cir. 1939) (*per curiam*); Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. PA. L. REV. 549, 552 (2008); Jessica Litman, *Billowing White Goo*, 31 COLUM. J.L. & ARTS 587, 596 (2008); David Nimmer, "Fairness of Them All" and Other Fairy Tales of Fair Use, 66 LAW & CONTEMP. PROBS. 263, 287 (2003).

4. These cases span the range of copyright and trademark, but note the focus on parody as transformative of the original in both. *See* *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 591 (1994); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007). However, with the recent Second Circuit decision in *Cariou v. Prince*, 714 F.3d 694, 706 (2d Cir. 2013), in which the court held that commentary on the original was not needed for a fair use defense, the tide may be starting to turn at least in the copyright context where the emphasis on commentary on the original (but not necessarily transformativeness) distinction is concerned. *Cariou's* implications for fair use in the trademark context (or indeed, even on copyright fair use doctrine in other circuits) are unclear, however.

5. *See, e.g.,* *Anheuser-Busch*, 28 F.3d at 774; *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g. Grp., Inc.*, 886 F.2d 490, 494 (2d Cir. 1989); *Henley v. DeVore*, 733 F. Supp. 2d 1144, 1155 (C.D. Cal. 2010); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1567 (S.D. Cal. 1996), *aff'd*, 109 F.3d 1394 (9th Cir. 1997).

expression, attributable to a different artist”⁶ is the object of the new work’s ridicule) that makes art forms like appropriation so urgent today.⁷

There is a lesser-mentioned safeguard against intellectual property overreach, which taps precisely into those ideas of the banal and the universal. It is genericide, and it is the bastard child of all defenses, relegated to the backseat of trademark law—and general scholarly interest.⁸ Genericide happens when a formerly protectable trademark is held to be no longer protectable because the mark ceases to signify a unique source or particular product but rather a genus or type of product. Genericide does everything fair use does not do. It recognizes anti-uniqueness in an age rife with appropriation art (in which images and objects are taken straight—and often wholesale—from our collective pop culture)⁹ and satire (in which the copyrighted work is used as a vehicle for general commentary on the state of society, a genre of work, and so on, rather than targeting the work itself)¹⁰ and the eradication of the author. It accommodates the use of marks not for purposes of commenting upon but for purposes of signification; it recognizes the right of the public, not the trademark owner, to decide a mark’s fate. It is audience-friendly and First Amendment-approved.¹¹ And, once a mark is held to be generic, it is free for all to use, comment on, and appropriate—which both decreases the enormous litigation costs associated with a fair use defense and serves as a potential deterrent to overzealous mark owners.¹²

So why don’t we talk about it enough? This Article makes a plea for increasing the use of genericide or genericness defenses in trademark infringement cases. Rather than focusing on arguments of transformativeness in the hopes of winning a fair use defense, artists should emphasize that they did not use the mark as a means of targeting, commenting on, or parodying the work itself, but rather, that they used the mark as a stand-in for a general category or genus. In doing so, the dialogue around what types of artistic use are defensible can begin to shift away from the narrow strictures of parodic fair use and toward a vastly greater number of expressive uses, such as satire,

6. *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992).

7. See Xiyin Tang, *That Old Thing, Copyright . . . : Reconciling the Postmodern Paradox in the New Digital Age*, 39 AIPLA Q.J. 71, 88–92 (2011) (discussing satire and pastiche’s lack of uniqueness and unmistakability as a postmodern art form); see also *infra* Part IV.

8. A recent search on Westlaw revealed over 3200 cases and 4800 articles discussing “fair use,” as compared to a paltry 31 cases and 265 articles discussing “genericide.”

9. See *Blanch v. Koons*, 467 F.3d 244, 246 (2d Cir. 2006) (referring to the defendant’s artistic works as “appropriation art”).

10. See *id.* at 254–55 (distinguishing between parodies and satire).

11. See Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 406–07 (1990) (discussing First Amendment precedent’s influence on the acceptance of genericide).

12. See William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 52 (2008) (discussing overlooked procedural and administrative costs resulting from overly-litigious markholders).

pastiche (deadpan parody that purely mimics, and does not mock, the appropriated work), and appropriation.

Importantly, this Article does not envision that courts will readily accept genericness defenses. This Article does not even argue that a genericness defense would be more likely to prevail than a fair use defense—indeed, I believe in fact the opposite is true. But this Article merely makes the point that we do art—and here I would like to sweep in the broader category of cultural engagement that ranges from painting to music to literature to even commercial advertising itself—a disservice by focusing solely on fair use. We do fair use doctrine a disservice by accumulating holdings that acknowledge just one type of expressive use—parody—as “fair.”

Moreover, the genericide defense is a muscle, and it needs to be exercised. That is, the more we talk about the genericity of a mark, the more likely it is that the mark will be deemed generic, because courts often look to the expressive contexts in which marks are used (e.g., newspapers or dictionaries) to determine whether a mark has become generic.¹³ Conversely, the more we focus on a mark’s uniqueness in crafting a parody defense, the weaker the argument for genericide of the mark, and the less defensible uses like satire, pastiche, and appropriation (the hallmarks of contemporary art-making or meaning-making) become.

While the doctrine of genericide is not applicable to copyright infringement cases, making genericide arguments in artistic-use trademark infringement cases could legitimize non-parodic uses so that courts, in copyright infringement cases, may become more open to such arguments. And as the recent Second Circuit decision in *Cariou v. Prince*—which is novel (and alone) in holding that a work need not comment on the original in order to be deemed fair use¹⁴—may suggest that revolution is already underway.

The idea for this Article came from a place that would, in modern trademark jurisprudence, seem decidedly unfair. I had attended a fashion and art law panel in which artists and trademark owners converged. The artists, it turned out, were making striking works with the owners’ marks: Louis Vuitton marks that were splashed across bold canvases with the melting and dripping “LV”; collages of found objects and advertising symbols that included everything from Lucky Strike cigarettes to Chanel signs. The mark owners, of course, were not pleased. One of the artists, in defense, had replied to a lawyer representing Louis Vuitton: But we’re not using your marks as any specific commentary on Louis Vuitton, really—it’s just more about the idea of luxury

13. See Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789, 1791 (2007) (explaining how a mark may become generic in informative contexts, such as newspapers and dictionaries).

14. *Cariou v. Prince*, 714 F.3d 694, 706 (2d Cir. 2013).

and the prominent role it plays in modern-day society. The artist's lawyer jumped in; "Look," he had said, "I think we can all agree that this is fair use."

But is it? The artist's statement that he was not using the marks as commentary on the mark should set off alarm bells. But this idea of using a mark to represent an idea—now *this* made me think. Isn't genericide, after all, about what happens when a mark ceases to signify the source, but rather a category of good? Louis Vuitton not for Louis Vuitton, but Louis Vuitton as merely a stand-in for this vast category of luxury goods? And what about that Jeff Koons sculpture that lost in *Rogers v. Koons*, the one where Koons' defense lay in "an artistic tradition of commenting upon the commonplace" and lost, under (albeit copyright's) fair use's parody exception?¹⁵ The common, the generic . . . Koons' definitive postmodern art show, titled, appropriately, the "Banality" show, the genericity of marks . . . now we are onto something!¹⁶

This Article will proceed in four Parts. First, it introduces the concept of genericide: what it is, the rationale behind it, and instances in which the defense has been accepted or rejected. Then, I will delve into the problem with the fair use doctrine in contemporary trademark case law. The third Part will focus on why genericide has become even more relevant today. The Final Part, outlines what a genericide approach to artistic use would look like, proposing a number of possible approaches: generic by case, generic by market, and genericism as a fair use factor. I believe, and argue here, that art, in a world where more genericide defenses are considered, may be headed toward brave new places.

I. DEFINING "GENERICIDE" AND "GENERICNESS"

A. THE ECONOMIC RATIONALE OF GENERICIDE

It is an oft-repeated mantra of trademark law that it has two goals: to reduce search costs for consumer goods, and to protect the hard-earned goodwill of a mark, as well.¹⁷ The latter, "reap what you sow" justification has been invoked in instances where a once-generic word was deemed to have acquired secondary meaning and therefore, trademark protection. For example, in *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*, the

15. *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992).

16. I acknowledge that the *Koons* cases were copyright fair use cases, and not about trademark fair use. But the two doctrines, especially in their analysis of parodies, owe much to each other. See *supra* note 1 for an explanation of this Article's use of both copyright and trademark decisions in its discussion of fair use.

17. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt. c (AM. LAW INST. 1995) ("If the trademark owner succeeds in creating a favorable image for its trademark in the marketplace, the mark itself can become a significant factor in stimulating sales. This ability of a mark to generate good will through advertising has also gained recognition under the law of trademarks."); William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 269 (1987) (describing trademarks as "a shorthand way of telling [the consumer] that the attributes are the same as that of the brand [he] enjoyed earlier").

Supreme Court addressed petitioner's argument that "Congress simply plucked a generic word [Olympics] out of the English vocabulary and granted its exclusive use to [respondent]." ¹⁸ In rejecting this argument, the Court stated: "Because Congress reasonably could conclude that [petitioner] has distinguished the word 'Olympic' through its own efforts, Congress' decision to grant [petitioner] a limited property right in the word 'Olympic' falls within the scope of trademark law protections" ¹⁹

This Article does not discuss these instances of taking generic words from the public domain and enclosing them to become private property via expenditure of time, money, and effort. Rather, what this Article is specifically concerned with the doctrine of genericide, which refers to the process by which a once-protectable mark *becomes* generic, hence losing its trademark status. That is, a court could find that the word, no longer referring to the unique source of a product, is now used by consumers to refer instead to the *category*, or genus, of product. ²⁰ In this instance, the economic rationale behind trademarks—reducing search costs—is eradicated. After all, if the public does not understand "aspirin" ²¹ to refer to the producer of the product, but rather only a type of product, allowing one producer to monopolize the term "aspirin" would inhibit competition while creating no gains for consumers.

The story of aspirin's death by genericide elucidates the rationale behind genericide itself, under a doctrine known as "death by patent" or the "primary significance test." Aspirin, a once trademarkable name, was also a patented product in the early 1900's. ²² When the product's period of patent protection expired, the question naturally became: what will competitors call their versions of aspirin? The makers of aspirin had not endowed it with an alternate name—unsurprisingly, Judge Hand, in *Bayer Co. v. United Drug Co.*, found that the term "acetyl salicylic acid" was unrecognizable by consumers. ²³ Thus, the term "aspirin" fell out of trademark's favor and into the hands of the public domain.

Or consider the Supreme Court's reasoning in *Kellogg Co. v. National Biscuit Co.*, in which the name "Shredded Wheat" was deemed generic—also, as it turns out, under the "death by patent" scheme:

It equally follows from the cessation of the monopoly and the falling of the patented device into the domain of things public that along with the public ownership of the device there must also necessarily

18. *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 534 (1987).

19. *Id.* at 534–35.

20. *See King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 580 (2d Cir. 1963).

21. I use this example because aspirin was deemed generic in 1921. *See Bayer Co. v. United Drug Co.*, 272 F. 505, 511 (S.D.N.Y. 1921).

22. *Id.* at 509.

23. *Id.* at 511.

pass to the public the generic designation of the thing which has arisen during the monopoly.²⁴

Key to the Court's reasoning is the idea that to foster competition, the word must be given over to genericness,²⁵ and that to benefit the public, one owner should not be entitled to monopolize a word that has now passed into the common vernacular as describing a mere type of good. The "shredded wheat" decision ushered in what is known as the "primary significance" test, in which a court requires the trademark holder to "show that the primary significance of the term in the minds of the consuming public is not the product but the producer."²⁶ In the case of shredded wheat, the Court determined that "shredded wheat" was merely "the term by which the biscuit in pillow-shaped form is generally known by the public."²⁷ Hence, the term was generic.

Genericide has also been justified under a model of economy of language.²⁸ That is, the idea that a certain "lexical poverty" would ensue if new products that later become well known (Landes and Posner use examples such as "thermos" and "dry ice") were locked in a series of property rights.²⁹ Genericide, under this rationale, reduces communication costs by enabling competitors to easily describe their product to others and reduces rent seeking by obviating the need for licensing agreements to use common words.³⁰

B. THE EXPRESSIVE MODEL OF GENERICIDE

Trademarks have an expressive function as well, distinct and apart from the "lexical poverty" theory discussed above, a function that can be justified under a First Amendment rubric better than it can under an economic rubric. This model, which Rochelle Dreyfuss elucidated with her phrase "expressive genericity," recognizes that trademarks are language—indeed, over two decades ago, Dreyfuss observed, "trademarks are the emerging lingua franca."³¹ Dreyfuss divides our use of trademarks into a competitive and an

24. *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938) (quoting *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896)).

25. Note that I use the words "genericity," "genericness," "genericide," and "genericism" in this Article. I use "genericity" and "genericness" to refer to the status of a mark trending toward or being generic; "genericide" to refer to the process by which a formerly-protectable mark *becomes* generic; and "genericism" to mean the larger doctrine, which encompasses genericide, which courts apply to determine whether a mark should be deemed generic and thus unprotectable as a trademark.

26. *Kellogg Co.*, 305 U.S. at 118.

27. *Id.* at 116.

28. For a discussion of genericness and the economy of language, see Landes & Posner, *supra* note 17, at 268–96.

29. *Id.* at 293.

30. *Id.* at 293–95.

31. Dreyfuss, *supra* note 11, at 397.

expressive set: in the former, trademarks perform a signaling function, in which a mark is used to identify goods and distinguish them from others, while in the latter, marks are used as language, as metaphor, but with a set of meanings entirely different from what the producer intended.³²

Courts rationalizing the genericism of a formerly protectable mark that has fallen into the public domain recognize expressive use. Consider the fact that courts often consider non-competitive uses of a trademarked term to determine whether it has undergone genericide. Rather than focusing purely on the use of the word in the consumer context, courts will turn to uses of the term in expressive contexts, such as dictionary definitions and newspaper usage, to determine whether a mark is generic.³³ In this sense, an analysis of genericism necessarily must go beyond the economic model of search costs and into the realm of the vernacular, focusing on the way a word is used culturally, not just competitively.

Consider, for example, the curious case of the Murphy bed. A Murphy bed today describes any bed that folds down from the wall and folds back up when not in use, but before the Second Circuit deemed it generic in 1989, only one company (the Murphy Door Bed Co.) could refer to the specific style of bed as a Murphy bed.³⁴ Other companies described this type of bed as “‘wall beds,’ ‘concealed beds,’ ‘disappearing beds,’ [or] ‘authentic adjustable hydraulic beds,’”³⁵ proving the point that a mark need not be deemed generic solely on the basis that there remains no other appropriate word with which a competitor could describe it by.³⁶ Rather, in *Murphy Door Bed Co. v. Interior Sleep Systems, Inc.*, the Second Circuit deemed the mark generic based on what it referred to as “expropriation by [the] public.”³⁷

The case came shortly on the heels of a refusal by the Trademark Trial and Appeal Board to register plaintiff Murphy Door Bed Co.’s mark “Murphy bed,” finding instead that the “Murphy bed has for a long period of time been used by a substantial segment of the public as a generic term for a bed which

32. *Id.* at 400.

33. *See* *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 101 (2d Cir. 1989).

34. *Id.* at 98.

35. *Id.*

36. This pro-competition, economic model of trademarks has been expounded by courts as one of the key principles underlying genericide. *See* A.J. Canfield Co. v. Honickman, 808 F.2d 291, 304 (3d Cir. 1986) (“Underlying the genericness doctrine is the principle that some terms so directly signify the nature of the product that interests of competition demand that other producers be able to use them even if terms have or might become identified with a source and so acquire ‘de facto’ secondary meaning.”); *Am. Cyanamid Corp. v. Connaught Labs., Inc.*, 800 F.2d 306, 308 (2d Cir. 1986) (“Consumers will not benefit . . . if trademark law prevents competitors from using generic or descriptive terms to inform the public of the nature of their product.”).

37. *Murphy Door Bed Co.*, 874 F.2d at 101 (citing *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 81 (2d Cir. 1936)).

folds into a wall or a closet.”³⁸ Upon learning of this finding, the defendant formed the “Murphy Bed Co. of America” and promptly began sending out his own manufactured beds to buyers as “Murphy beds,” despite protestations from plaintiff.³⁹ The trial court found for plaintiff on the basis that a “secondary meaning”—an acquired distinctiveness or association in the minds of the public between the mark and its source—had been attributed to the name Murphy by the general public.⁴⁰ The Second Circuit, on the other hand, found that a generic mark is only entitled to trademark protection on the basis of secondary meaning in situations in which “a generic term already in public use later acquires secondary meaning by virtue of a product developer’s unique use, thus warranting trademark protection.”⁴¹ In this instance, however, the Second Circuit deemed secondary meaning, well, meaningless in cases where “the trademark was initially an invented term and lost its protection because of later public expropriation.”⁴²

In finding that the public had expropriated the mark, the court noted, “[w]hile dictionary definitions are not conclusive proof of a mark’s generic nature, they are influential because they reflect the general public’s perception of a mark’s meaning and implication.”⁴³ The court also found persuasive “evidence [of] numerous examples of newspaper and magazine use of the phrase Murphy bed to describe generally a type of bed.”⁴⁴ While noting again that “such evidence is not proof positive,” the court found that “it is a strong indication of the general public’s perception that Murphy bed connotes something other than a bed manufactured by the Murphy Co.”⁴⁵

Pitting evidence of secondary meaning against dictionary and newspaper usage pits economic and expressive models of trademarks against each other. The economic justifications of either rewarding the producer/fostering competition or decreasing search costs are not served by the primary significance test in instances where much of the public continues to associate the mark with its source. An economic model of determining when a product name has become generic does not look to expressive uses to determine when a mark has become generic; rather, it asks whether:

the costs of continued protection (deadweight losses resulting from higher prices, higher costs to rivals in using alternative words, and the costs of licensing and defending trademarks) exceed its benefits (less consumer confusion, lower search costs, and the gains

38. *Murphy Door Bed Co.*, 874 F.2d at 98 (quoting *In re Murphy Door Bed Co.*, 223 U.S.P.Q. 1030, 1033 (T.T.A.B. 1984)).

39. *Murphy Door Bed Co.*, 874 F.2d at 98–99.

40. *Id.* at 99.

41. *Id.* at 102.

42. *Id.*

43. *Id.* at 101.

44. *Id.*

45. *Id.*

associated with the incentive of firms to develop high quality goods).⁴⁶

Thus, evidence of whether the consuming public continues to associate a mark with its source (i.e., evidence of secondary meaning) is critical to a determination of a mark's genericness from an economic, and traditional, trademark perspective. Deeming such evidence irrelevant, however, once a word has been "expropriated" to the public, suggests an emphasis not on the public's right not to be confused when shopping in the grocery store, but rather places value on how words are used in popular culture—an emphasis that comports more with First Amendment principles of participatory citizenship than those of reducing search costs.⁴⁷

C. A SEMIOTIC MODEL OF GENERICIDE

Semiotics is the study of sign systems, or, the interrelation between symbols and their signified. Semiotics' relevance to a full understanding of trademark law is indispensable. In Barton Beebe's semiotic analysis of trademarks, marks are traditionally understood as a triadic structure: (1) a sign (i.e., the mark itself); (2) the referent (i.e., the product or service the mark denotes); and (3) the signified (i.e., the source (producer/origin) of the product as well as the attendant goodwill).⁴⁸ In instances where a mark is found to be generic, the sign refers primarily to its referent, and the significance of the signified is lessened (i.e., "aspirin" is primarily associated with the product Bayer produces, and consumers are not so much motivated by the fact that it is Bayer that produces the product, nor its goodwill).

Of course, contemporary understandings of trademarks have seen what is arguably a collapse of the triadic model, for example a merging of signified and referent, in which the "trademark's goodwill is commodified and sold as its own product," an example being the sale of logos (the mark) as patches, unfixed to any specific good or service.⁴⁹ And, whether or not one may choose to believe it, Beebe further sees a complete implosion between all three—sign, signified, and referent—into the "hypermark," or free-floating signifiers (think the inundation of signs emptied of meaning and product in Times Square) that refer to nothing but its own internal logic but which have no tether in reality.⁵⁰ Appropriately, the author Don DeLillo exemplified the phenomenon of the hypermark in his novel *White Noise*, where brands are listed indiscriminately in laundry lists of excess and clutter, enacting their role

46. Landes & Posner, *supra* note 17, at 294–95.

47. See Jack M. Balkin, Commentary, *Digital Speech and Democratic Culture: A Theory of Freedom of Expression for the Information Society*, 79 N.Y.U. L. REV. 1, 33–38 (2004).

48. Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 645–46 (2004).

49. *Id.* at 658.

50. *Id.* at 667, 683.

as free-floating signifiers devoid of meaning: “Waffelos and Kabooms, fruit chews and toffee popcorn; the Dum-Dum pops, the Mystic mints.”⁵¹

Genericide doctrine has not yet had occasion to address either the new dyadic or monadic model—and frankly, I am not sure that the doctrine can in fact accommodate either model. But my purpose is not to consider whether the genericness defense comports with modern trademark theory (including, for example, the workability of the primary significance test⁵²), but rather how the semiotic model can shed light on how the genericness defense as it is currently formulated might be applied. For example, in the dyadic model where the referent is in fact the goodwill, one could easily see instances in which a mark’s genericness is determined based not on the fact that a mark has come to signify a genus of *product*, but rather that a mark has come to signify a genus of *goodwill*. That is, “Louis Vuitton”, rather than signifying a luxury brand, signifies luxury (the goodwill Louis Vuitton has shored up through brand and image marketing) itself. In that way, the genericness defense could in theory accommodate more than just marks-as-products—it should also apply to marks-as-ideas, marks-as-aspiration.

Just as the dyadic structure is especially helpful for thinking of contemporary trademark practice and how such marks may be used in expressive works, the idea of the *hypermark*, the free-floating signifier, creates the backdrop for an examination of fair use doctrine and its insistence on creating meaning in places where meaning may simply not exist. In Part II, I discuss the fiction of targeting or commenting upon the uniqueness of a mark in the modern ad-age and how fair use doctrine continues to perpetuate the modernist myth.

II. AGAINST FAIR USE

A. THE MANY FACES OF FAIR USE

The two-word phrase “fair use” has been both much celebrated and much reviled in contemporary copyright law. It has been tested empirically,⁵³ it has been cited as a built-in First Amendment safeguard,⁵⁴ hauled into law review articles for reform (shaving down the four factor test into just two),⁵⁵ and questioned as merely an end-result based process.⁵⁶ Copyright fair use is still codified as four neat factors which courts then apply in analyzing any fair use defense:

51. DON DELILLO, *WHITE NOISE* 1 (1985).

52. See generally John F. Coverdale, Comment, *Trademarks and Generic Words: An Effect-on-Competition Test*, 51 U. CHI. L. REV. 868 (1984).

53. See Beebe, *supra* note 3, at 552.

54. *Eldred v. Ashcroft*, 537 U.S. 186, 219–20 (2003).

55. See generally Joseph P. Liu, *Two-Factor Fair Use?*, 31 COLUM. J.L. & ARTS 571 (2008).

56. Nimmer, *supra* note 3, at 281–82.

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.⁵⁷

The scholarship and body of law surrounding trademark “fair use,” on the other hand, is, simply put, a mess. There is no four-factor test and no consensus on why or how it should differ (if it differs at all) from other applications of fair use in the copyright and right of publicity contexts. Its interaction with the First Amendment is nebulous. Before discussing why this is so, I provide a brief primer on the various ways the fair use doctrine has been formulated and applied in the trademark context.⁵⁸

1. The Initial Hurdle: “Non-Mark” Uses

To some, this entire exercise in analyzing the fair use defense as applied to artistic uses of trademarks may seem beside the point. After all, only uses of a mark *as a mark* are infringing,⁵⁹ and so, the argument goes, most expressive uses of marks—*especially* in the artistic context—should be categorically exempt from infringement claims. This argument, or the so-called “trademark use” theory, has been cited by some scholars as serving a “gatekeeper function” that so “limit[s] the reach of trademark law without regard to a factual inquiry into consumer confusion.”⁶⁰

But, of course, the argument is easier made than applied. For in trademark law, the classic question is whether a *consumer* would view the use as a trademark use—or, in other words, if consumers view the use of the mark as indicating sponsorship or origin. As one scholar has pointed out, this “approach to defining trademark use grounded in consumer understanding collapses completely into a slightly different way of asking the crucial likelihood of confusion question.”⁶¹

57. 17 U.S.C. § 107 (2012).

58. I spend relatively little time on diagnosing the various ailments that have plagued trademark fair use for the simple reason that other scholars have already done deep analyses of the issue. See, e.g., McGeeveran, *supra* note 12.

59. See 15 U.S.C. § 1125(a)(1) (2012) (stating that trademark infringement is limited to “[a]ny person who, on or in connection with any goods or services . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof” that “(A) is likely to cause confusion . . . as to the origin, [or] sponsorship” of the mark).

60. See Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 805 (2004).

61. McGeeveran, *supra* note 12, at 79–80.

Whether a mark is used in the trademark sense from a consumer perspective is not just expensive to prove or disprove (via the use of consumer surveys, for example)—it may, in increasing instances of artistic use, be less than clear-cut. Consider, for example, a famous, modern-day example in the art world: Prada Marfa. Consumers of pop culture may instantly recall a canvas print emblazoned with the well-known Prada logo, with the word “Marfa” and “1837 MI →” appearing underneath it. The print is a popular fixture in home décor, popularized by the television show about wealthy Upper East Siders, *Gossip Girl*, and manifesting the undeniable appeal of the posh Prada logo (under semiotic theory, the monetization of sign-value, itself).

But Prada Marfa in fact is a sculptural work by the experimental artists Elmgreen and Dragset, who built a faux Prada store (a “permanent sculpture masquerading as a shop, a store that will never open”⁶²) in what they called “pop architectural land art.”⁶³ The artists obtained Prada’s permission to use the corporate logo, and, even more curiously, Prada picked out the shoes to be used within the sculpture’s “window display.”⁶⁴ One commentator notes that, though “ostensibly a critique of capitalism and consumerism,” it “unintentionally reinforced the capitalist values it criticised [sic],” attracting a number of tourists to the area and “intensifying the processes of gentrification and powerfully reinforcing the appeal of the commodity.”⁶⁵

While undeniably an expressive use, Prada Marfa is just but one example of the continuing erosion of the line between art and commodity, between artwork and merchandising, between uses of a trademark as a “mark” and not. We live in a world of readymades—consumer objects as art, and art as commerce.⁶⁶ I will explore this further below, but for now, it is sufficient to say that the appeal of the “trademark use” theory falls apart upon closer examination.

2. “Nominative” and “Classic” Fair Uses

Classic fair use applies in instances where the defendant uses the plaintiff’s mark to describe the defendant’s own product.⁶⁷ Consider, for example, *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, where the maker of the candy Sweetarts brought suit against Ocean Spray Cranberries for describing

62. NICKY RYAN, FROM NEW YORK TO THE CONGO VIA MARFA: BRANDED OCCUPATION 3 (2009), http://arts.brighton.ac.uk/_data/assets/pdf_file/0010/44848/39-Nicky-Ryan_From-New-York-to-the-Congo-via-Marfa.pdf.

63. PHILIP JODIDIO, 5 ARCHITECTURE NOW! 202 (2007).

64. Eric Wilson, *Little Prada in the Desert*, N.Y. TIMES (Sept. 29, 2005), <http://www.nytimes.com/2005/09/29/fashion/thursdaystyles/little-prada-in-the-desert.html>.

65. RYAN, *supra* note 62, at 6.

66. See generally Xiyin Tang, Note, *The Artist as Brand: Toward a Trademark Conception of Moral Rights*, 122 YALE L.J. 218 (2012) (discussing “factory-made” art objects, art fairs, and the artist-as-businessman as examples of the commodity culture of the art world today).

67. 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:11, at 23-87 (4th ed. 2012).

its cranberries as sweet-tart.⁶⁸ The court held this to be a descriptive fair use by defendant to accurately describe its own product as sweet and tart.⁶⁹ This form of fair use will likely seldom arise in the artistic use context, as most often artists are invoking brand names not to describe their own work but to comment on the brand name itself. This commentary-on-the-original is known, in some circuits, as nominative fair use, where the defendant uses the plaintiff's mark to describe the *plaintiff's* product.⁷⁰ This would be the doctrine invoked in an artistic use context, and this is precisely the doctrine the Ninth Circuit turned to in a couple of cases involving Barbie, in finding that the use of the mark "Barbie" was an allowable parody under the nominative fair use doctrine.⁷¹

The nominative fair use test, as developed by the Ninth Circuit, requires the defendant to prove that:

First, the product or service in question [is] one not readily identifiable without use of the trademark; second, only so much of the mark or marks [is] used as is reasonably necessary to identify the product or service; and third, the user [did] nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.⁷²

The Ninth Circuit did not create so much a "gatekeeper" mechanism in which clearly-expressive uses would be exempt from trademark infringement's intensive fact-finding mission; rather, it just replaced the traditional likelihood of confusion factors with a new set of factors that look to consumer confusion.⁷³ Thus, perhaps appropriately seeing the "defense" for what it is, many circuits do not follow the Ninth Circuit three-factor test—in fact, many circuits do not recognize the nominative versus classic fair use distinction at all. Rather, most circuits use a traditional likelihood of confusion analysis in determining so-called "nominative" uses.⁷⁴

Thus, unlike in copyright, where fair use is a true defense (i.e., a defendant's use is allowable despite being found infringing), fair use in the

68. See generally *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, 64 F.3d 1055 (7th Cir. 1995).

69. *Id.* at 1060–61.

70. 4 MCCARTHY, *supra* note 67, § 23:11, at 23–87.

71. *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 810 (9th Cir. 2003) (artistic photographs portraying Barbie doll found to be parody and therefore nominative fair use). See generally *Mattel, Inc. v. MCA Records, Inc.*, No. CV 97-6791 WMB, 1998 WL 422641 (C.D. Cal. Feb. 18, 1998) (song invoking Barbie is parody for purposes of nominative fair use test).

72. *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

73. McGeeveran, *supra* note 12, at 91.

74. See, e.g., *Health Grades, Inc. v. Robert Wood Johnson Univ. Hosp., Inc.*, 634 F. Supp. 2d 1226, 1241 (D. Colo. 2009) (noting that "[t]he Ninth Circuit's 'nominative fair use' analysis has not been widely adopted;" rather, most courts still use the traditional multi-factor analysis of a likelihood of confusion claim even in so-called "fair use" cases).

trademark context is almost never an affirmative defense. As respects so-called “classic” fair use, in the 2004 Supreme Court decision *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, the Court held that a defendant need not negate evidence of likelihood of confusion if it has used a mark “descriptively, not as a mark, fairly, and in good faith.”⁷⁵ However, even there, the Court noted that “the degree of likely consumer confusion bears not only on the fairness of using a term, but even on the further question whether an originally descriptive term has become so identified as a mark that a defendant’s use of it cannot realistically be called descriptive.”⁷⁶ And, following *KP Permanent Make-Up, Inc.*, Ninth Circuit courts have continued to view classic fair use as a complement to the traditional likelihood of confusion factors—meaning that if enough consumer confusion is found, the use presumptively cannot be fair.⁷⁷

Nominative fair use—the type of fair use that implicates artistic expression—is even more problematic. The Ninth Circuit has used the doctrine not as a defense, but as another way for determining whether likelihood of confusion—and hence, trademark infringement—exists. As Professor McCarthy puts it, “the ‘nominative fair use’ analysis is a ‘defense’ only in the sense that an accused infringer in certain cases can use the analysis to argue that there will be no infringement because there will be no likelihood of confusion.”⁷⁸ Because a determination of whether a use is a “nominative fair use” still uses an alternative to the traditional infringement factors, it is not really a defense at all.⁷⁹ In short, even a clearly “artistic” use still has to go through the rigmarole of showing non-confusion—a problem as a practical matter because a likelihood of confusion analysis is fact-intensive and cannot be made on a motion to dismiss, and made only sometimes on summary judgment, leading to costly and protracted litigation that would discourage would-be fair users from doing so in the first place.⁸⁰

75. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 124 (2004).

76. *Id.* at 123.

77. *See, e.g.*, *Visual Changes Skin Care Int’l, Inc. v. Neways, Inc.*, No. CV F 08-0959 LJO DLB, 2008 WL 4723603, at *7 (E.D. Cal. Oct. 24, 2008) (stating that “[t]he classic fair use analysis . . . only complements the likelihood of customer confusion analysis . . .” [and] ‘some degree of confusion does not foreclose the relevance of the extent of any likely consumer confusion in assessing whether a defendant’s use is objectively fair’” (quoting *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1151 (9th Cir. 2002) and *KP Permanent Make-Up, Inc.*, 543 U.S. at 123)); *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp. 2d 1012, 1028 (C.D. Cal. 2006) (“In the Ninth Circuit, ‘the classic fair use defense is not available if there is a likelihood of customer confusion as to the origin of the product.’” (quoting *Cairns*, 292 F.3d at 1151)).

78. 4 MCCARTHY, *supra* note 67, § 23:11, at 23–89. Note, however, that the Third Circuit has departed from other circuits in holding that nominative fair use is “an affirmative defense to be proven by defendant after likelihood of confusion has been demonstrated by the plaintiff.” *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 228 (3d Cir. 2005).

79. 4 MCCARTHY, *supra* note 67, § 23:11, at 23–89.

80. *See, e.g.*, *Just Enters., Inc. v. Nurenberg Paris Heller & McCarthy Co., LPA*, No. 1:07CV1544, 2008 WL 2048167, at *3–4 (N.D. Ohio May 12, 2008) (finding that given the fact-

3. Parodic Fair Uses

Of all these defenses, perhaps only one creates a neat “bright-line” test, and it is also my least favorite. That is, some courts have carved out a special space for parodic uses, finding that because such a use is humorous, often ridiculing the mark or portraying the mark in a distasteful light, it necessarily cannot create confusion.⁸¹ Without likelihood of confusion, no infringement exists.⁸² Aside from the fact that this (arguably categorical) exemption necessarily relies on the absence of consumer confusion for its validity (that is, one can imagine a parody that does cause confusion would either be deemed, circularly, not a parody and thus not a fair use), the undue emphasis in trademark law on parodic uses is deeply pernicious to other uses like pastiche or appropriation, which may often be deadpan or humorless in their portrayal of the mark at issue. Of this I will have much to say in the following Section. But first: a brief primer on the Trademark Dilution Revision Act.

4. The Trademark Dilution Revision Act

Parody’s importance and reigning role in protecting expressive uses from a charge of trademark infringement does not just exist in judge-made common law. In 2006, Congress officially cemented its importance by codifying it as a defense to a charge of trademark dilution in the Trademark Dilution Revision Act, which is incorporated into the federal trademark statute, 15 U.S.C. § 1125 (known as the Lanham Act).⁸³ Dilution, a cause of action available only to owners of famous marks,⁸⁴ does not require a showing of likelihood of confusion. Rather, the mark owner must merely prove that his mark is either likely to be tarnished—that is, the use is likely to create

intensive nature of inquiry, likelihood of confusion analysis cannot be resolved on a motion to dismiss); *Health Net v. U.S.A. Healthnet, Inc.*, No. CV 92-3925 KN, 1993 WL 209558, at *1 (C.D. Cal. May 12, 1993) (noting courts’ “‘dislike’ or ‘disfavor’” resolving trademark cases through summary judgment).

81. See, e.g., *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1057 (10th Cir. 2008) (“The fact that the [defendant’s] website is a successful parody weighs heavily against a finding of likelihood of confusion.”); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007) (“[A]n effective parody will actually diminish the likelihood of confusion, while an ineffective parody does not.”); *Protectmarriage.com v. Courage Campaign*, 680 F. Supp. 2d 1225, 1228 (E.D. Cal. 2010) (“One way to negate the element of confusion is to show that the allegedly infringing mark is a parody of the original mark, and that this parody is unlikely to show confusion.”).

82. See, e.g., *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1142 (9th Cir. 2011) (“[T]he *sine qua non* of trademark infringement is consumer confusion . . .”). To prevail on a trademark infringement claim, “a plaintiff must show that it has a valid mark that is entitled to protection and that the defendant’s actions are likely to cause confusion with the plaintiff’s mark.” *Brockmeyer v. Hearst Corp.*, 248 F. Supp. 2d 281, 292 (S.D.N.Y. 2003).

83. Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730 (codified as amended at 15 U.S.C. § 1125 (2012)).

84. 15 U.S.C. § 1125(c)(1).

unsavory associations in the minds of the public⁸⁵—or blurred, where an association arises from the similarity between a mark and a famous mark that impairs its distinctiveness (think Kodak pianos or Bulova gowns⁸⁶). The necessity of the dilution statute has often been vividly invoked by analogizing the dilution of a famous mark to “death by a thousand cuts, where significant injury is caused by the cumulative effect of many small acts of dilution.”⁸⁷ Therefore, confusion is irrelevant: so long as a Tiffany’s dry cleaners (which would qualify as dilution by blurring) or a Tiffany’s strip club (qualifying as dilution by tarnishment) is allowed to exist, so does the danger to the distinctiveness of the Tiffany’s mark.

The dilution statute’s very strength explains the codification of specific forms of exempted uses (such uses are “parodying, criticizing, or commenting upon the famous mark”⁸⁸), even if, under the 1996 dilution statute, such uses fell under the general “noncommercial use” safe harbor.⁸⁹ Understandably, if nominative fair use and the common law carve-out for parodies grounds its analysis in a lack of likelihood of confusion, then the desirability of clarifying that parodic uses are still protected under a statute that does not require likelihood of confusion becomes clear.

Then again, perhaps the entirety of trademark fair use comes down to First Amendment expression versus the desire to profit, as summed up by Judge Kozinski’s statement in the famous “Barbie Girl” case: “[T]he trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function.”⁹⁰ This clear, seemingly obvious delineation between expressive speech and commercial intent would seem to put all quibbles about infringement to bed. Yet even Judge Kozinski’s analysis of whether the song “Barbie Girl” was an infringing use of plaintiff’s “Barbie” mark salvaged the First Amendment issue from the fire based on the lodestar of trademark and copyright fair use defenses: yes, parody.

85. *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 110 (2d Cir. 2009).

86. *Id.* at 105.

87. *Trademark Dilution Revision Act of 2005: Hearing on H.R. 683 Before the Subcomm. on Courts, the Internet, & Intellectual Prop. of the H. Comm. on the Judiciary*, 109th Cong. 13 (2005) (statement of Rep. Howard L. Berman, Ranking Member, Subcomm. on Courts, the Internet, and Intellectual Prop.).

88. 15 U.S.C. § 1125 (c) (3) (A) (ii).

89. *See* 4 MCCARTHY, *supra* note 67, § 24:128.

90. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

B. THE PROBLEM WITH PARODIES AND THE “COMMENTING UPON THE ORIGINAL” REQUIREMENT

1. What is a Parody?

Parody, unlike other uses such as satire, sets its sights on the original work as the object of its ridicule.⁹¹ In the copyright context, the limited scope of its applicability revealed itself in a series of cases centered around what is known as “appropriation art,” in which the artist takes another’s work and presents it anew, often without any stated intent to comment on or critique the original.⁹² Notably, in the 1992 Second Circuit case surrounding a Jeff Koons sculpture, the court found that “the copied work must be, at least in part, an object of the parody, otherwise there would be no need to conjure up the original work.”⁹³ The court, therefore, found that Koons’s sculpture was not fair use, citing policy-driven reasons behind the rule that the copied work must in part be an object of the artist’s ridicule, “as were it otherwise there would be no real limitation on the copier’s use of another’s copyrighted work to make a statement on some aspect of society at large.”⁹⁴ While the recent Second Circuit decision in the copyright infringement case *Cariou v. Prince* seemed to turn the tide on this requirement, at least within that Circuit,⁹⁵ the Supreme Court’s distinction between parodic commentary as privileged above other forms of artistic commentary in the, so far, only high court ruling on artistic fair use still stands: “Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim’s (or collective victims’) imagination, whereas satire can stand on its own two feet and *so* requires justification for the very act of borrowing.”⁹⁶

Parodies in trademark infringement cases play an even more important role than in copyright cases. As discussed above, courts have found that parodies negate the likelihood of confusion standard crucial to a finding of trademark infringement, holding both that “an intent to parody is not an intent to confuse the public”⁹⁷ and that “an effective parody will actually

91. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 495–96 (2d Cir. 1989) (“[A] literary work is a parody if, taken as a whole, it pokes fun at its subject.”).

92. *See* *Blanch v. Koons*, 467 F.3d 244, 254–55 (2d Cir. 2006); *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992); *Campbell v. Koons*, No. 91 Civ. 6055(RO), 1993 WL 97381, at *2 (S.D.N.Y. Apr. 1, 1993). The court in *Rogers* highlighted this tension between appropriation art’s objectives and fair use’s commentary-on-the-original requirement when it stated: “The problem in the instant case is that even given that [the work] is a satirical critique of our materialistic society, it is difficult to discern any parody of the photograph ‘Puppies’ itself.” *Rogers*, 960 F.2d at 310.

93. *Rogers*, 960 F.2d at 310.

94. *Id.*

95. *Cariou v. Prince*, 714 F.3d 694, 698 (2d Cir. 2013).

96. *Campbell v. Acuff–Rose Music, Inc.*, 510 U.S. 569, 580–81 (1994) (emphasis added).

97. *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1486 (10th Cir. 1987).

diminish the likelihood of confusion, while an ineffective parody does not.”⁹⁸ Further, courts are clear that parodies “‘must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is *not* the original and is instead a parody’ Thus, ‘[a] parody relies upon a difference from the original mark, presumably a humorous difference, in order to produce its desired effect.’”⁹⁹ In instances of a dilution claim, not only are parodies specifically named as one of the instances of “fair use,” but so is the (as outlined in the case study below) commenting upon the “famous mark” requirement.¹⁰⁰

Further still, other courts have made the parody versus other forms of commentary requirement explicit: “where an artistic work targets the original and does not merely borrow another’s property to get attention, First Amendment interests weigh more heavily in the balance.”¹⁰¹ The Second Circuit, at least in the trademark context, has thus far not strayed from its holding in *Harley–Davidson, Inc. v. Grottanelli* (an interesting case for genericide, as well)¹⁰² that a parodic use of a mark must “have some ‘critical bearing on the substance or style of the original composition’ [or else] is not a permitted trademark parody use.”¹⁰³

2. Gutting the First Amendment

Indeed, the First Amendment defense to trademark use, while perhaps originally envisioned as a unique and separate defense (*à la Rogers v. Grimaldi*¹⁰⁴), has been overshadowed and rolled into the fair use doctrine’s emphasis on parodic and/or transformative use, such that it is no longer clear which is driving which. In other words—since when did fair use’s emphasis on commentary which has “critical bearing on the substance or style of the

98. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007).

99. *Id.* at 260 (quoting *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001) and *Jordache Enters., Inc.*, 828 F.2d at 1486).

100. 15 U.S.C. § 1125(c)(3)(A)(ii) (2012).

101. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901 (9th Cir. 2002).

102. *Harley–Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812 (2d Cir. 1999) (finding that the word “Hog” was generic and hence not trademarkable despite the fact that “a substantial segment of the relevant consumers began to use the term specifically to refer to Harley–Davidson motorcycles”). Hence, *Harley–Davidson* was a reverse-genericide case in which the question centered on whether a formerly generic term can gain trademark status via use and subsequently-acquired secondary meaning. The outcome here was the opposite of that in *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522 (1987), which suggested that it could, at least as to Congress’ decision to grant the mark owner a limited property right in the mark.

103. *Harley–Davidson*, 164 F.3d at 813 (quoting *Campbell v. Acuff–Rose Music, Inc.*, 510 U.S. 569, 580 (1994)).

104. *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. 1989) (holding that movie titled “Ginger and Fred,” which combined both artistic expression and commercial promotion, was not violation of Lanham Act, after balancing the interest against consumer confusion with the interest in freedom of expression).

original” also determine whether an expressive work deserves First Amendment protection?¹⁰⁵ Courts have determined that the use of trademarked works in ways that do not so comment on the substance or style of the original “could not claim First Amendment protection.”¹⁰⁶ Since when are only “transformative” works entitled to First Amendment protection? Yet courts have determined that expressive works impinging on another’s right of publicity is only entitled to First Amendment protection where “added creative elements significantly transform the celebrity depiction,” thus making “transformative” synonymous with “expressive.”¹⁰⁷ Such is often not the case in contemporary art practice.

Thus, any hope that *Rogers* would create some bright line for artistic expression has been long gutted. The Second Circuit’s application of the *Rogers* standard for artistic titles to artistic works as a whole reveals the all-encompassing predominance of parodies. This is evident in *Cliffs Notes, Inc.*, where the Second Circuit restated the *Rogers* balancing test of weighing the public interest in avoiding consumer confusion over “the well-established public interest in parody.”¹⁰⁸ Of course, the emphasis on parody in the context of the *Rogers* balancing test is defensible, since *Rogers* pits artistic expression against consumer confusion: if, in fact, courts are correct in finding that a parody diminishes likelihood of confusion,¹⁰⁹ then other types of uses that may create consumer confusion—for example, pastiche, or deadpan mimicry of the original—cannot be justified under *Rogers*.

To further complicate the matter is the continued erosion of the expressive/commercial divide. In *Rogers*, the Second Circuit recognized that even what would indisputably be considered expressive works (to say nothing of commercial works that may have expressive components, which I will get to later) are bought and sold in the marketplace like any other consumer good.¹¹⁰ The Second Circuit assumed a clear definition of just what “expressive” works are—“[m]ovies, plays, books, and songs.”¹¹¹ Yet a world in which the line between “art” and consumer goods no longer exists—in which artists “may find their medium in consumer products, making T-shirts and sneakers instead of paintings and sculptures” is not some postmodern scholar’s post-apocalyptic vision of the future: it is here.¹¹² As Amy Adler pointed out in the late ‘aughts, “Richard Prince, fresh from his Guggenheim

105. Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1400 (9th Cir. 1997).

106. *Mattel, Inc.*, 296 F.3d at 901.

107. Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 808 n.10 (Cal. 2001).

108. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989).

109. See *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007).

110. *Rogers v. Grimaldi*, 875 F.2d 994, 997 (2d Cir. 1989).

111. *Id.*

112. Amy M. Adler, *Against Moral Rights*, 97 CALIF. L. REV. 263, 297 (2009).

one-man show, is busily collaborating on a handbag line with Marc Jacobs, while Takashi Murakami's latest exhibition featured a Murakami-Louis Vuitton boutique in the middle of the Brooklyn Museum."¹¹³ While traditional "high art" artists are busy selling their wares in storefronts,¹¹⁴ luxury brands are busy endowing their wares with the auspices of high art.

3. Parody as Commentary: Is That All There Is?

Focus on parodies, on commentary upon the original, to the exclusion of all else, can be deeply pernicious. In many ways, this exclusive focus on parodies that comment on the unique original—which assumes that there is some unique original—seems outmoded in a contemporary age of art-making that problematizes the very notion of "an original and separate expression, attributable to a different artist."¹¹⁵ In 1935, Walter Benjamin had predicted that technological advances would drastically change the way art was both received and perceived.¹¹⁶ Because of this loss of a work's aura, "[t]he fiction of the creating subject gives way to the frank confiscation, quotation, excerptation, accumulation and repetition of already existing images. Notions of originality, authenticity and presence . . . are undermined."¹¹⁷ Benjamin proved to be a prescient prophet of the way art-making would evolve over the next century. In the late 1970s, writing after decades of pop art—in which advertising slogans were taken straight from billboards and transplanted to museum walls¹¹⁸—Roland Barthes compared the author to a scriptor, to one who "can only imitate a gesture that is always anterior, never original."¹¹⁹ A decade later, Frederic Jameson noted a marked break in the belief that there remains a unique artistic style worthy of imitation and a shift toward

113. *Id.*

114. See 2 ART SINCE 1900: MODERNISM, ANTIMODERNISM, POSTMODERNISM 455 (Hal Foster et al. eds., 2004) (noting Claes Oldenburg's "*The Store*", an art "environment" meant to replicate the dime shops it was surrounded with, which sold Oldenburg's iconic reproductions of food items for prices "a far cry from those commanded by art works in even the least prestigious gallery").

115. *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992).

116. See generally Walter Benjamin, *The Work of Art in the Age of Its Technological Reproducibility: Second Version*, in THE WORK OF ART IN THE AGE OF ITS TECHNOLOGICAL REPRODUCIBILITY AND OTHER WRITINGS ON MEDIA 19 (Michael W. Jennings et al. eds., 2008). Benjamin describes the Dadaists as predecessors to film, with their "word-salad" poems and bricolage paintings. *Id.* at 39 ("What they achieved by such means was a ruthless annihilation of the aura in every object they produced, which they branded as a reproduction through the very means of its production.").

117. Douglas Crimp, *On the Museum's Ruins*, in THE ANTI-AESTHETIC: ESSAYS ON POSTMODERN CULTURE 43, 53 (Hal Foster ed., 1998).

118. The aim of pop art was to "look into the conscience of America's commercial culture, find the glint of shiny metal no more than an inch thick, and *mirror it brilliantly*." Steven Henry Madoff, *Wham! Blam! How Pop Art Stormed the High-Art Citadel and What the Critics Said*, *Introduction to POP ART: A CRITICAL HISTORY*, at xiii, xiv (Steven Henry Madoff ed., 1997) (emphasis added).

119. ROLAND BARTHES, *The Death of the Author*, in IMAGE–MUSIC–TEXT 142, 146 (Stephen Heath trans., 1977).

pastiche—“blank parody, parody that has lost its sense of humor.”¹²⁰ In this new mode of art-making, we do not merely copy to mock—we simply repeat, as if in some ritualistic repetition of past trauma. Pastiche is deadpan parody, and in that sense it is not a parody that any court would recognize.

Just as with Elmgreen and Dragset’s Prada Marfa store-that-is-not-a-store, contemporary art’s mode of subversion is to serve up the artifacts of consumer products exactly as they would be found in the grocery store: just think of Andy Warhol’s “readymade” Campbell’s soup cans and Brillo Boxes. While perhaps formerly radical in its ordinariness, perhaps there really is no line between art and commerce anymore. Recently, Campbell’s issued special, “Warhol-themed” editions of its iconic soup cans, with labels mimicking the artist’s brightly-colored pop style that were licensed from the Warhol foundation.¹²¹ Warhol’s soup cans were an appropriation of Campbell’s soup cans, but now Campbell’s soup cans are an appropriation of Warhol’s appropriation of Campbell’s soup cans.

Almost 25 years after Jameson wrote the treatise on postmodernism, this drama between contemporary art’s internalization of anti-originality and anti-transformativeness continued to play out in *Cariou v. Prince*.¹²² In that case one of the key questions was whether the artist Richard Prince, in taking plaintiff Cariou’s photographs and altering them, had any intention to comment on Cariou’s original works. The district court found it significant that Prince stated that he did not, thus rejecting his fair use defense.¹²³ If the Second Circuit’s reversal and holding that “the law does not require that a secondary use comment on the original artist or work”¹²⁴ seems to be an encouraging sign for artists working in popular mediums such as appropriation art, found art, and pastiche, the road toward trademark fair use reform seems less clear.

There are, after all, many forms of speech that do not hinge on parodic commentary. Rebecca Tushnet recognized as much when she espoused the value of copying and the harm that (copyright) fair use’s emphasis on transformation can wreak on First Amendment values.¹²⁵ Our focus on

120. Frederic Jameson, *Postmodernism and Consumer Society*, in *THE ANTI-AESTHETIC: ESSAYS ON POSTMODERN CULTURE*, *supra* note 117, at 111, 114.

121. T.S. Fox, *Campbell’s Celebrates Andy Warhol with 50th Anniversary Soup Cans*, HYPEBEAST (Aug. 30, 2012), <http://hypebeast.com/2012/8/campbells-celebrates-andy-warhol-with-50th-anniversary-soup-cans>.

122. *Cariou v. Prince*, 784 F. Supp. 2d 337 (S.D.N.Y. 2011), *rev’d in part, vacated in part*, 714 F.3d 694 (2d Cir. 2013).

123. *Id.* at 348–50. Prince himself had stated in his deposition that he did not intend to comment on Cariou’s works, and that his intent in creating the allegedly infringing works “was to pay homage or tribute to other painters, including Picasso, Cezanne, Warhol, and de Kooning, and to create beautiful artworks which related to musical themes and to a post-apocalyptic screenplay he was writing.” *Id.* at 349 (citation omitted).

124. *Cariou v. Prince*, 714 F.3d 694, 698 (2d Cir. 2013).

125. Rebecca Tushnet, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L.J. 535, 552 (2004) (“But the logical chain linking criticism, the First Amendment, and transformative fair use can make those concepts seem coterminous with one

parodies is a self-reinforcing mechanism: the more a work comments on the original mark, the more fair it looks; to the extent that it seems to use the mark as a means to an end (i.e., as commentary on something else), it cannot be a defensible use.

4. The Failure of the Parody Defense: A Case Study

In 2010, during the Super Bowl post-game show, auto manufacturer Hyundai aired a commercial picturing a scene of an inner-city basketball game that included a one-second shot of a basketball decorated with a pattern resembling Louis Vuitton's trademark.¹²⁶ The commercial, titled "Luxury", aimed to convey the "style, quality, and amenities" of the 2011 Sonata, "a mid-sized Sedan."¹²⁷ Defendant Hyundai explained that, "The symbols of 'old' luxury, including the [Louis Vuitton] Marks, were used as part of the Commercial's humorous social commentary on the need to redefine luxury during a recession"¹²⁸

Louis Vuitton brought suit for trademark infringement, dilution, and unfair competition. Hyundai, who had altered the trademark logo slightly, stated that its intention was to create a "quick reference to luxury [so that] people would get the luxury reference quickly," and claimed that such a use was fair use.¹²⁹ The court disagreed. Specifically, it noted: "Through deposition testimony and in submissions by counsel, Hyundai has disclaimed any intention to parody, criticize or comment upon Louis Vuitton. Rather, it contends that the basketball design in the 'Luxury' ad reflects a broader social comment"¹³⁰ Citing the TDRA's fair use exception, including the "parodying, criticizing, or commenting upon" language, and *Harley-Davidson v. Grottanelli*, which had held that the parody exception to the TDRA does not apply if the "purported parody 'makes no comment' on the original mark," the court held that Hyundai's use was not a fair use.¹³¹

The use of a mark like Louis Vuitton's to create, in Hyundai's words, a "quick reference" to luxury has been argued before, as in 2008, when an art student, Nadia Plesner, created a drawing of a Darfurian child holding a purse with a (modified) Louis Vuitton logo. When asked her reason for choosing the Louis Vuitton bag, she simply replied that it was "meant to be a designer bag in general," and that the Louis Vuitton brand, in particular, "resonates in

another as far as copyright defendants are concerned. The values of public access and dissemination that were also traditionally part of fair use, and part of many theories of free speech, get left behind.").

126. *Louis Vuitton Malletier, S.A. v. Hyundai Motor Am., No. 10 Civ. 1611 (PKC)*, 2012 WL 1022247, at *1 (S.D.N.Y. Mar. 22, 2012).

127. *Id.* at *2.

128. *Id.*

129. *Id.*

130. *Id.* at *17.

131. *Id.* at *19–20.

a way that people understand it when they see it.”¹³² Plesner’s drawing, meant to raise money for Darfur, in fact did use the Louis Vuitton logo to “get attention” (a type of use that the Supreme Court questioned in *Campbell* and a criticism of non-parodies that has been cited in other leading trademark fair use cases¹³³). Plesner specifically dressed a Darfurian child in the auspices of high luxury to see if the media, who (in her view) overwhelmingly focused on meaningless luxuries rather than important issues, would take notice.¹³⁴ Though not intended to specifically comment on the fashion house of LVMH, Plesner’s use of the mark was meant to criticize our consumer-obsessed culture. Like Hyundai, Plesner’s defense (if she had been sued in U.S. court, which she was not¹³⁵) was one of broad social commentary.

Yet *Hyundai* was not the only case that rejected a “broader social commentary” fair use defense. As the *Hyundai* court notes, the same argument was made—and rejected—in *Rogers v. Koons*, which involved a sculpture copied detail-by-detail from a postcard.¹³⁶ In putting forth a (failed) justification of such blatant copying, Koons argued that the sculpture was a form of social critique, meant to exemplify “the mass production of commodities and media images,” and that, by appropriating these forms of seemingly ubiquitous imagery in his artwork, Koons was “comment[ing] critically both on the incorporated object and the political and economic system that created it.”¹³⁷

It has been over two decades since *Koons* was decided. The recent Second Circuit opinion expressly disavowing any commentary-upon-the-original requirement for fair use purposes in copyright law suggests that courts may be more open to novel arguments in artistic and expressive use cases than

132. *Art Student Nadia Plesner’s Giant Louis Vuitton Copyright Suit*, NYMAG.COM (May 6, 2008, 6:00 PM), http://nymag.com/thecut/2008/05/art_student_nadia_plesners_gia.html.

133. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580 (1994) (“If, on the contrary, the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another’s work diminishes accordingly (if it does not vanish)”); see also *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999).

134. *Art Student Nadia Plesner’s Giant Louis Vuitton Copyright Suit*, *supra* note 132.

135. An Unofficial translation of the decision by Court of The Hague in preliminary relief proceedings filed by Louis Vuitton against Plesner is available at <http://www.nadiaplesner.com/upl/website/simple-living-darfurnica1/VerdictEnglish.pdf>.

136. *Louis Vuitton Malletier, S.A.*, 2012 WL 1022247, at *19; see also *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992) (noting that a “copied work must be, at least in part, an object of the parody”). Curiously, *Rogers* was not cited by the Second Circuit in *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013). Of course, in *Cariou*, the high-art artist Richard Prince, in discussing his use of plaintiff-photographer’s works of Rastafarians, expressly disavowed any “new meaning or a new message” in these appropriations. *Cariou*, 714 F.3d at 707. That the Second Circuit held that a new work need not comment on the original in order to be transformative may suggest a broadening of the scope of uses considered “fair” in copyright doctrine; *Harley-Davidson* is still good law when it comes to trademark fair use, which bears no definite “transformativeness” requirement.

137. *Rogers*, 960 F.2d at 309.

ever before.¹³⁸ In the next Part, I examine why the doctrine of genericide is more relevant today, and more applicable to a greater variety of artistic expression, than fair use's narrow parody exception.

III. GENERICITY IN THE 21ST CENTURY

A. WHAT DOES IT ALL MEAN?

We are what we buy. If taking the emblems and signs straight from the bastions of consumer culture (billboards, magazine advertisements, and supermarket shelves) was a novelty in the post-World War II period where Pop Art and its predecessors reigned, the inundation of the ad-world into the real world has become rather banal today. Signs—whether literally in the form of billboards or semiotically as signifiers—are not so much unique as endless, ceaseless white noise, floating signifiers unmoored to any real-world referent or meaning.

Perhaps the ubiquity and banality of brand names in the modern age has found its best exemplification in an unlikely place: hip-hop culture. Premised on depictions of excess, hip-hop culture, as embodied in music videos, song lyrics, and fashion paraphernalia, has become almost a parody of itself. There are expected tropes to be found in a hip-hop video: women, cars, and “bling,” or flashy jewelry.¹³⁹ More significantly, rap lyrics themselves often call out a roster of trademarked names, used not as commentary on the marks themselves but as evocations of a lifestyle. Consider, for example, rappers' penchant for evoking Cristal in the '90s¹⁴⁰—so constant, in fact, that (as if in an almost-eerie call to genericide) commentators have noted: “Mentions of the vintage bubbly have become so common in hip-hop circles that the brand name Cristal has often come to stand in for the very word champagne itself. At this point, to call Cristal ubiquitous in hip-hop would be an understatement.”¹⁴¹

The use of marks in hip-hop to signal associations with a certain lifestyle, and the evocation of marks as a means of conveying that idea of luxury, present an interesting antithesis to fair use's call for commentary on the mark itself. Marks used in this way do little if anything to target the uniqueness of the mark—rather, using Cristal to denote champagne or the constant litany of upscale car brands that litter the songs (Bentleys, Porsches, Maybachs)

138. See *Campbell*, 510 U.S. at 580.

139. *Bubbles and Bling*, ECONOMIST (May 8, 2006), <http://www.economist.com/node/6905921> (describing the “bling-bling” lifestyle as one including “ten-carat diamond studs, chunky gold jewellery, pimped up Caddies and sensuous women”).

140. A controversy surrounding such usage came to a head in 2006, in which a Cristal executive suggested the hip-hop community's affection for its product was unwelcome. A boycott followed. Douglas Century, *Jay-Z Puts a Cap on Cristal*, N.Y. TIMES (July 2, 2006), http://www.nytimes.com/2006/07/02/fashion/02cris.html?pagewanted=all&_r=0.

141. *Cristal and the Buying Power of Hip-Hop*, NPR (July 31, 2006, 9:00 AM), <http://www.npr.org/templates/story/story.php?storyId=5594229>.

seems to create a genericity not only of the marks themselves, but of the rap song formula as a whole. In the same way that the songs used marks to evoke a lifestyle, so the insertion of certain mark-tropes (Hennessey, Bentley, Gucci) definitively denote a song as a rap song, part of an entire canon of artists singing about women, money, and bling.

Hip-hop's way of using marks simply cannot be explained by resorting to the old "parody as critique" defense. Rather, it is more apt to say that hip-hop appropriated something that once did not belong to them and made it theirs. To some, this may not seem like anything other than trademark infringement. In the early '90s, for example, a Harlem clothes-maker who called himself Dapper Dan took to creating jackets, coats, and suits embossed with logos from the likes of Louis Vuitton, Fendi, and Gucci.¹⁴² The odd thing was that he often made coats that used one mark as the lining, another for the outside, a third for the lapel, and a fourth as pocket squares.¹⁴³ The fashion houses were not pleased and enacted a raid on Dapper Dan's shop.¹⁴⁴ Dapper Dan's creations could not be saved by anything like a parody defense (as dog toys labeled with "Chewy Vuitton" and bearing the Louis Vuitton trade dress were¹⁴⁵), nor would he have argued for one: in his view, "he wasn't parodying these brands; he was paying tribute to them, and so were his customers."¹⁴⁶ In his words, "I Africanized it . . . Took it away from that, like, Madison Avenue look."¹⁴⁷

Dapper Dan's own intent behind creating his works of mark mash-ups, and his customers' (they included numerous rappers and the boxer Mike Tyson¹⁴⁸) enthusiasm for wearing them, also cannot be explained by the traditional rationales underlying infringement. In other words: not only did Dapper Dan have no intention of "passing off" his goods as a *real* Louis Vuitton, or Fendi, or Gucci (hence creating consumer confusion), but his customers could not have caused what is known as post-sale confusion, either.¹⁴⁹ Just as no purchaser would be deceived into thinking that Gucci is affiliated with a coat that also has Louis Vuitton lapels and Fendi lining, so no

142. Kelefa Sanneh, *Harlem Chic: How a Hip-Hop Legend Remixed Name-Brand Fashion*, NEW YORKER, Mar. 25, 2013, at 52.

143. *Id.* at 57.

144. *Id.*

145. Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 269–70 (4th Cir. 2007).

146. Sanneh, *supra* note 142, at 57.

147. *Id.* at 55.

148. *Id.* at 56.

149. Post-sale confusion focuses not on the purchaser's confusion as to the product's source but on that of observers. As one court has explained, "[t]his type of confusion harms the owner of a trademark in that a potential purchaser, knowing that the public is likely to be confused or deceived by the allegedly infringing product, will choose to purchase that product instead of a genuine one in order to gain the same prestige at a lower price." Gucci Am., Inc. v. Guess?, Inc., 843 F. Supp. 2d 412, 418 (S.D.N.Y. 2012).

passerby on the street would mistake a Dapper Dan creation for the “real” thing (whatever that may be, since no fashion house would dare mash up its label with others and then sell it).¹⁵⁰ And the oddity of his customers paying thousands of dollars for one of his coats, then, lies in this: why pay so much for a luxury good that is not a luxury good?¹⁵¹ If the rationale behind trademark law is that the value of a Louis Vuitton lies in the attributes a consumer can reliably expect from the house of Louis Vuitton (craftsmanship and quality), then paying thousands for a coat you definitively know to be *not* from the house of Louis Vuitton makes no sense. The same goes for trademark’s signaling function.¹⁵² The appeal of a counterfeit good is that it is both cheap and can “pass,” to unwitting observers, at least, as the real thing, hence marking you as someone of a certain class.¹⁵³ But for someone wearing Dapper Dan, that rationale breaks down. No coat with four brand labels affixed to it will pass for the real thing. And as for the parody defense, no coat with four brand labels affixed to it in an indiscriminate mash-up can claim to be targeting the uniqueness of one.

Rather, a coat with four brand labels affixed to it seems to stand for another proposition: that Fendi, Gucci, and Louis Vuitton are interchangeable to Dapper Dan and his customers. To them, the labels are a stand-in for the general idea of luxury, for the rarefied world of Madison Avenue, for the vulgarities (often comically so) of newly-minted wealth. In many ways, this appropriation of Madison Avenue culture is no different from the practices of female artists like those in the Pictures generation, who used appropriation practices of reproducing images by other artists to challenge the authorial power of their male predecessors.¹⁵⁴ A genericness defense like the one I outline in this Part could accommodate these types of uses where a fair use doctrine could not. Further, as I explain below, a genericness defense in a less blatantly-commercial, expressive use context is more apt than a fair use defense.

B. A LOOK AT MATTEL, INC. V. MCA RECORDS, INC. FROM THE GENERICIDE PERSPECTIVE

What would a world in which more genericide-type defenses were allowed look like? To take a different look at the same problem, let’s consider Judge

150. This would seem to present the ideal case for a fair use under 15 U.S.C.A. § 1115(b)(4) (2012), yet it is unlikely a court will find that the marks are being used in a descriptive sense, rather than as marks. No matter how strange the mark mash-up may be, it is the *marks themselves* as marks, which are on display in a Dapper Dan creation.

151. Sanneh, *supra* note 142, at 55 (noting that for some of Dapper Dan’s clients, his high prices were part of the appeal—“[y]ou had to pay on the same level as if it was from Gucci”).

152. Beebe, *supra* note 48, at 624.

153. This is much of the reasoning underlying the post-sale confusion doctrine. See *supra* note 149 and accompanying text.

154. 2 ART SINCE 1900: MODERNISM, ANTIMODERNISM, POSTMODERNISM, *supra* note 114, at 598.

Kozinski's analysis of the song "Barbie Girl" in *Mattel, Inc. v. MCA Records, Inc.*, a song by the band Aqua that quickly rose to the top of the charts, causing Mattel, the creator of "Barbie dolls," some consternation.¹⁵⁵ Kozinski insists that, "The song does not rely on the Barbie mark to poke fun at another subject but targets Barbie herself."¹⁵⁶ To shore up this reasoning, Kozinski relies on a few representative lyrics: "[I'm] a Barbie girl, in [her] Barbie world. . . . Life in plastic, it's fantastic. You can brush my hair, undress me everywhere/Imagination, life is your creation. . . . I'm a blond bimbo girl, in a fantasy world/Dress me up, make it tight, I'm your dolly."¹⁵⁷ In some ways, one could claim that the song does, as Kozinski claims, "poke[] fun at Barbie and the values that Aqua contends she represents"—plastic, fake, a fictional play world where Barbie is a blank slate for which one's own desires can be projected.¹⁵⁸

But just what about the trademark is the alleged parody "poking fun" at, anyhow? To return to the traditional triadic structure of the trademark: is it: (1) the actual mark itself ("Barbie"); (2) the referent (a plastic doll made for young girls); and/or (3) the goodwill of its producer, Mattel, as a trusted manufacturer of children's toys (of all three, the third is the least likely)? In most expressive uses such as the present one, it is likely that the answer will be none of the above, and certainly not all three components of the trademark together. If anything, the parody is targeted towards the values that Barbie instills in young girls—but that is not a component of the "Barbie" mark, either in its full triadic structure or any one of the three components.

Rather, the mark "Barbie" is here used as a simple stand-in for that entire category of product: plastic dolls of unrealistic proportions made for young girls. "Barbie" in this sense does not depend on the fact that Mattel manufactures it, but could be any kind of plastic doll that symbolizes to young girls what a female is supposed to be (docile, blonde, beautiful). It is satire, not parody, that is more appropriate here (remember that, in *Dr. Seuss*, the Ninth Circuit had rejected a defense of satire as protected under the First Amendment¹⁵⁹)—"Barbie" is used as a means to an end, as a mere vehicle to tell a story about a certain kind of woman. That is, by using the word "Barbie" in their song, the band Aqua did not intend to comment on Barbie itself as they simply used the mark as shorthand, as metaphor (conjuring up a cultural icon with ready associations in the collective consciousness—as they say about effective writing, show, don't tell) in a song about a relationship between a woman and a man in which the woman ingratiate herself into the idealized

155. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 898–99 (9th Cir. 2002).

156. *Id.* at 901.

157. *Id.*

158. *Id.*

159. *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1400–01 (9th Cir. 1997).

role of girlfriend, willing and ready to be bent every-which-way he pleases. Barbie is, in fact, anti-unique: she is the every woman of a man's dream.

Genericness is a better fit for many modes of contemporary story-telling or art-making today. As a practical matter, justifications of "targeting" or "commenting" upon the original is *ex-post-facto*, a fact the court in *Cariou* recognized when it stated, "when transformative use is at issue, the alleged infringer would go to great lengths to explain and defend his use as transformative."¹⁶⁰ As a political statement, genericness speaks louder: Barbie is *not* unique. She has come to be the universal symbol for docility, a certain category of fake. To argue parodic intent in targeting the original's uniqueness by invoking its blandness is ironic, at best. As a defense, genericness does more: once a mark has been deemed generic (in one "market," at least, as I argue should be the standard, in the following Part¹⁶¹), a mark owner loses its rights all together (whereas fair use is a case-by-case determination).¹⁶²

IV. A GENERICNESS APPROACH TO ARTISTIC USE

A. *POTENTIAL CRITIQUES OF THE GENERICIDE DEFENSE*

To many readers my proposal might seem a ludicrous one. The first, less troublesome general critique that comes to mind is that, setting aside any critiques of the common law development of the fair use defense, uses are only infringing (thus invoking the need for the fair use defense) if a likelihood of confusion exists.¹⁶³ In that sense, there is very little possibility that consumers would think, for example, that Mattel created the "Barbie Girl" song, or even, as I admitted above, in a more problematic usage, that Fendi, would be affiliated with a Dapper Dan coat on which its mark appears alongside those of its competitors. However, as discussed above, the Lanham Act's expanding reach in the form of protection for "famous" marks does *not* require a likelihood of confusion, rather, the owner of a famous mark must merely prove that its mark is being diluted. And, though the Lanham Act's dilution statute has a "built-in" defense of fair use for the purposes of parody or commentary, the standards for such parody nonetheless fall prey to the same problems that traditional trademark fair use suffers from: an emphasis on the uniqueness of the original.¹⁶⁴ The dilution statute is especially

160. *Cariou v. Prince*, 714 F.3d 694, 707 (2d Cir. 2013).

161. *See infra* Part V.B.

162. A party who believes a mark owner's trademark is generic may file a petition to cancel that mark. *See* 15 U.S.C. § 1064 (2012) ("A petition to cancel a registration of a mark . . . may . . . be filed . . . (3) [a]t any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered . . .").

163. *See* *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 118 (2004).

164. *See, e.g., Lucasfilm Ltd. v. Media Mkt. Grp., Ltd.*, 182 F. Supp. 2d 897, 900-01 (N.D. Cal. 2002) (finding that parody is protected under the Federal Trademark Dilution Act, and that

troubling, for marks that have the most expressive potential are often famous marks. After all, the power of a song titled “Barbie Girl” would be lost on much of its audience if only a small segment of the public was aware of Barbie. In fact, all the marks I have discussed throughout this Article, luxury marks like Fendi and Louis Vuitton, for example, are famous marks (and thus more susceptible to dilution claims).

Related to the above critique, then, might be the sheer viability of any likelihood of confusion or dilution claim—and indeed, whether those claims can even triumph in the face of a First Amendment or fair use defense. That is, regardless of the courts’ emphasis on parody or commentary, as the recent *Prince* case may illustrate, if a use is “fair” (i.e., of some artistic or expressive value), it will be accordingly recognized as such, regardless of which *ex post facto* framework (fair use, First Amendment) a court may choose to drill the use into. This reasoning is pernicious because it continues to create awkward case law that removes any semblance of logic or actual application of the case law to the facts at hand in an artistic-use case. That a court may also reach the “right” result eventually does not change the chilling effect of fair use’s high costs of getting to that end result.¹⁶⁵ As just one example of an infringement claim which could not possibly be legitimate: the automobile manufacturer Rolls Royce recently brought infringement and dilution claims against the Georgia rapper Royce Rizzy, demanding that the rapper cease selling all apparel and memorabilia bearing the Rolls Royce trademark, and further demanding that the rapper change his name, destroy all products that include his name, and turn over all profits he made under the stage name.¹⁶⁶ As of the date of this writing, the rapper’s lawyers are working on cooperating with Rolls-Royce to resolve the matter¹⁶⁷—rather than going to court and litigating what would almost undoubtedly eventually prevail to be a protected use of the mark.

But, one may well ask, if in fact it is overzealous trademark owners who are responsible for the chilling of what will be ultimately deemed protected speech, then wouldn’t the doctrine of genericide create perverse incentives for mark owners to police their marks, thus further chilling speech rather than encouraging it?¹⁶⁸ That is, if the threat of genericide is more real—by encouraging more defendants to invoke the genericide defense—such policing will inevitably get worse. Yet this fear flies in the face of well-settled case law. The majority of courts have found that a mark owner’s active policing

“parody is meant to comment on or criticize an original work”); Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, 417 (S.D.N.Y. 2002) (finding perfume for dogs to be “a joking variation on the original”).

165. McGeeveran, *supra* note 12, at 70–71.

166. See Aeberle, *Rolls-Royce Targets Rapper Royce Rizzy in Trademark Suit*, LAW 360 (Jan. 23, 2015, 1:38 PM), <http://www.law360.com/articles/614447/rolls-royce-targets-rapper>.

167. *Id.*

168. See Desai & Rierison, *supra* note 13, at 1834–42.

of its mark is of no consequence to whether a mark will be found generic.¹⁶⁹ This is not to say that mark owners won't attempt to police expressive uses regardless, but that such policing cannot be necessarily attributed to any elements within the doctrine of genericide itself. Yet other doctrines, such as laches, acquiescence, and the "crowded field"¹⁷⁰ doctrine, require the trademark owner to actively police (and, in the case of acquiescence, threaten an infringement suit and follow through with that threat) its rights against potential infringers.¹⁷¹ More troubling still is the doctrine of abandonment which, like laches, requires mark owners to vigorously police its marks if they hope to enforce their rights in court, and for which a failure to police may result in abandonment by allowing the mark to become generic.¹⁷² These doctrines, which focus on the actions of the mark owner, are far more prohibitive and create greater chilling effects to free speech than genericide, which appropriately disregards the actions of the mark owner in favor of

169. See, e.g., *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 101 (2d Cir. 1989); *Hickory Farms, Inc. v. Snackmasters, Inc.*, 509 F. Supp. 2d 716, 723 (N.D. Ill. 2007). Desai and Rierson quote Judge Posner in arguing that courts in fact find policing to be of consequence in determining whether a mark is generic: "A serious trademark holder is assiduous in endeavoring to convince dictionary editors, magazine and newspaper editors, journalists and columnists, judges, and other lexicographically influential persons to avoid using his trademark to denote anything other than the trademarked good or service." Desai & Rierson, *supra* note 13, at 1835 (quoting *Ill. High Sch. Ass'n v. GTE Vantage Inc.*, 99 F.3d 244, 246 (7th Cir. 1996)). But Judge Posner then goes on to say that "that is a detail," and, "in fact irrelevant, for no defense of laches has been pleaded," which suggests that this dicta is more for the purposes of proving laches than anything else. *Ill. High Sch. Ass'n*, 99 F.3d at 246. As further proof of this fact, Judge Posner then goes on to state in the same case:

When a trademark becomes generic . . . because the public, perhaps egged on by the omnipresent media, decides to use the trademark to designate not the particular manufacturer's brand but the entire product comprising all the competing brands, the trademark is dead no matter how vigorously the holder has tried to prevent this usage. *Id.* at 247.

This reasoning is in line with what other courts have found: that policing is of no consequence in finding genericity.

170. A crowded trademark field is one that is "hemmed in on all sides by similar marks on similar goods," and thus prevents any one party from the "crowded field" from preventing uses by others. *PostX Corp. v. docSpace Co.*, 80 F. Supp. 2d 1056, 1061 (N.D. Cal. 1999). Active policing by a mark owner against such third-party uses is considered to mitigate this effect. See *Lexington Mgmt. Corp. v. Lexington Capital Partners*, 10 F. Supp. 2d 271, 282–83 (S.D.N.Y. 1998) (rejecting defendant's "crowded field" defense where "plaintiff has successfully policed against third-party use of its mark, sending cease and desist letters to unauthorized users of the 'Lexington' mark for financial services, and successfully halting all such uses").

171. See, e.g., *Grupo Gigante SA de CV v. Dallo & Co.*, 391 F.3d 1088, 1102 (9th Cir. 2004) ("Companies expecting judicial enforcement of their marks must conduct an *effective* policing effort." (quoting *Am. Int'l Grp., Inc. v. Am. Int'l Bank*, 926 F.2d 829, 834 (9th Cir. 1991) (Kozinski, J., dissenting))); *Saul Zaentz Co. v. Wozniak Travel, Inc.*, 627 F. Supp. 2d 1096, 1110 (N.D. Cal. 2008) (stating that a laches defense is based on either actual or constructive knowledge, and that the latter "imposes on a trademark owner the duty to police its rights against potential infringers").

172. *Hermès Int'l v. Lederer de Paris Fifth Ave., Inc.*, 219 F.3d 104, 110 (2d Cir. 2000).

public opinion. In that way, genericide is far more audience-friendly and First Amendment-approved than other trademark infringement defenses.

The last critique is simply a practical one and also the most compelling: how likely is it, really, that courts will determine “Louis Vuitton” to be generic? While it might be easier to imagine a court holding the mark “Barbie” generic as signifying a class of blonde plastic dolls, there are nonetheless real concerns (not to mention incredulities) to be had in envisioning that some of our most famous marks—Cristal, BMW, McDonald’s—may undergo death by genericide and lose its status as a protectable mark. For these reasons, my proposed version of a genericide defense in artistic works does not go so far. Rather, it is simply a slight reimagining of an existing element of the doctrine: that a mark may be generic in one market, and not the other. This will be the focus of the following Section.

B. GENERIC BY MARKET

Several courts analyzing whether a mark has become generic have held that when a term is generic, “trademark protection will be denied save for those markets where the term still has not become generic and a secondary meaning has been shown to continue.”¹⁷³ Thus, a mark may be generic in one market, but nonetheless retain its rights in another. Courts frequently look to the context or the industry within which a mark is used—for example, in one trade dress infringement case, the district court looked to whether a certain spider web design used in the specific context of the Halloween industry was distinctive or generic.¹⁷⁴ And in the famous *Abercrombie* case, the Second Circuit analyzed whether the use of the word “safari” was generic in the apparel industry, and became even more detailed in its analysis by determining that “safari” was generic when used in connection with hats and jackets, but not when used in connection with boots.¹⁷⁵

There is no reason why courts should not use this analysis when determining whether a certain mark has become generic in the context of artistic uses—and here, I use “artistic” in the narrower sense of what courts have traditionally acknowledged to be “art”, such as “[m]ovies, plays, books, and songs,” as well as fine art.¹⁷⁶ For example, one might also readily see how a court may hold that the mark “Barbie” is generic in the publishing industry as referring to a category of docile, fake beauties, but not generic as used in the toy industry.

Declaring a mark generic in one market—Cristal as generic for champagne in the music industry but fanciful or arbitrary¹⁷⁷ and hence

173. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976).

174. *See generally* *Funrise Can. (HK) Ltd. v. Zauder Bros.*, No. 99-CV-1519 (ARR), 1999 WL 1021810 (E.D.N.Y. July 2, 1999).

175. *Abercrombie & Fitch Co.*, 537 F.2d at 12.

176. *Rogers v. Grimaldi*, 875 F.2d 994, 997 (2d Cir. 1989).

177. This Article, for the most part, does not get into the five categories into which

protectable in the liquor industry—has several advantages. For one, it allows for a wide range of expressive uses while nonetheless protecting the mark competitively in the industries where the mark has made its name. In this way, the generic-by-market analysis nonetheless remains friendly to mark-holders. However, it also offers enormous benefits to artists hoping to use the mark in their work. That is, marks that nonetheless retain secondary meaning within the industry in which they compete are especially effective in the artistic context: after all, the ready abundance of secondary meaning suggests that the public can immediately conjure up a wealth of associations merely by being presented with one mark. On the other hand, were a mark to truly become generic—such as aspirin or thermos—the wealth of associations conjured up by the name might be scant (merely a pain reliever, or an insulated cup).

Secondly, and more importantly, deeming a mark generic in one “market” or “context” frees up that mark for permanent use within that market, unlike the sticky, fact-intensive, expensive, litigious, case-by-case determination of a fair use defense.¹⁷⁸ Artists can therefore freely use the mark without fear of retaliation by cautious mark owners. Furthermore, once a mark is deemed generic in one market, owners of once-famous marks no longer have a dilution argument for uses in that market, saving a wide variety of non-confusing uses from unnecessary litigation by over-vigilant mark owners.¹⁷⁹ Of course, the traditional burden of proof in genericide defenses does not change—it is the defendant’s burden to prove that a mark has become generic, whether through newspaper articles, dictionary entries, survey evidence, or otherwise.¹⁸⁰

However, the generic-by-market defense may not necessarily save some potentially infringing uses. For example, in the Dapper Dan scenario and

potentially trademarkable terms may fall, but they are: arbitrary, fanciful, suggestive, and descriptive, and generic. Arbitrary and fanciful marks receive the highest degree of trademark protection, and the term “Cristal” would likely fall into the second category. The former refers to marks that have no logical association with the underlying product (e.g., “Apple” to describe computers), and the latter refers to words that are invented (e.g., “Google”). Suggestive marks receive less protection than the first two but nonetheless does not require secondary meaning to be protectable as it requires the consumer to use some imagination in calling to mind what the mark is associated with: for example, “Habitat” for home furnishings. Lastly, descriptive marks, as purely describing the product, are not eligible for trademark protection unless they acquire secondary meaning. An example would be “Fish Fri” to describe a batter for frying fish. *See Abercrombie & Fitch Co.*, 537 F.2d at 9. This Article, of course, has focused on the last category, generic terms. While it has mostly described the process through which a mark that once fell into either of the other four categories becomes generic, marks that start out being generic also cannot be trademarked: for example, “Chocolate Fudge Soda” to refer to a chocolate fudge soda. *See generally* A.J. Canfield Co. v. Honickman, 808 F.2d 291 (3d Cir. 1986).

178. McGeveran, *supra* note 12, at 66–71.

179. Of course, this is so because only trademarkable terms are subject to the provisions of the Lanham Act, and once a mark is deemed generic, no trademark protection applies.

180. *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 101 (2d Cir. 1989).

Hyundai infringement case discussed above, the infringing uses overlap with the markets in which the trademarked goods (Louis Vuitton, Fendi, Gucci) compete. Thus, at least on some level, such use is inherently more competitive than uses that are more traditionally thought of as expressive (such as a painting or book).¹⁸¹ And yet, as discussed above, such a use does have expressive power. For these uses, I describe an approach to the genericide defense much akin to that of aesthetic functionality, where a case-by-case analysis would be undertaken.

C. GENERIC BY CASE

The curious defense of “aesthetic functionality” has, as it turns out, much in common with genericide, and yet is in many ways much more susceptible to criticism. The rationale behind aesthetic functionality lies in the idea that because trademark law is concerned only with truthful source-identification, it “does not prevent a person from copying so-called ‘functional’ features of a product which constitute the actual benefit that the consumer wishes to purchase, as distinguished from an assurance that a particular entity made, sponsored, or endorsed a product.”¹⁸² Therefore, marks that are deemed aesthetically functional are not subject to trademark protection.¹⁸³

An obvious critique of the doctrine—one that genericide could also be prey to—is that it essentially “punishes” a trademark owner for success; for example, in one case, the court held that a federally trademarked stripe design on plaintiff’s luggage was functional and thus not a valid trademark because its appeal to consumers lay mainly in such design.¹⁸⁴ Yet aesthetic functionality, unlike genericide, does not import a new word into the public vernacular, hence benefitting the public or the consuming public by encouraging *expressive* uses of the mark in addition to purely competitive ones.¹⁸⁵ It does allow the hard efforts of one mark owner to be reaped by competitors, merely by the latter suggesting that the use of such mark or trade dress is functional precisely because the mark has become so desirable to the public. The inherent incoherence of the doctrine has led to much criticism,¹⁸⁶

181. As proof that such uses are more competitive, consider the fact that Dapper Dan’s customers will often buy real Gucci shoes to match their Gucci creation from Dapper Dan, to make it “super official.” Sanneh, *supra* note 142, at 57.

182. Int’l Order of Job’s Daughters v. Lindeburg & Co., 633 F.2d 912, 917 (9th Cir. 1980).

183. Forschner Grp., Inc. v. Arrow Trading Co., 124 F.3d 402, 409–10 (2d Cir. 1997).

184. Ventura Travelware, Inc. v. Balt. Luggage Co., 322 N.Y.S.2d 93, 99 (N.Y. Sup. Ct. 1971), *aff’d*, 328 N.Y.S.2d 811 (N.Y. App. Div. 1972).

185. Ty Inc. v. Perryman, 306 F.3d 509, 514 (7th Cir. 2002) (“Although there is a social cost when a mark becomes generic—the trademark owner has to invest in a new trademark to identify his brand—there is also a social benefit, namely an addition to ordinary language.”).

186. See, e.g., Anthony L. Fletcher, *The Defense of “Functional” Trademark Use: If What Is Functional Cannot Be a Trademark, How Can a Trademark Be Functional?*, 75 TRADEMARK REP. 249 (1985); Deborah J. Krieger, Note, *The Broad Sweep of Aesthetic Functionality: A Threat to Trademark Protection of Aesthetic Product Features*, 51 FORDHAM L. REV. 345 (1982); Jessica Litman, Note, *The*

helped along in no small part by the fact that what consumers are often purchasing¹⁸⁷ is, in fact, the trademark or the trade dress itself, hence conveying, at least to observers, that the product originated from the mark owner. This was acknowledged most recently in *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.*, which centered around the infamous “red sole” of Christian Louboutin shoes.¹⁸⁸ While the Second Circuit ultimately determined that because aesthetic functionality is an affirmative defense that will only be considered once an allegedly infringing use is found to likely cause consumer confusion, the court avoided the issue of whether a use of a contrasting red sole would be eligible for the aesthetic functionality defense.¹⁸⁹ Yet, of course, consumers desire red soles precisely because of their source-identifying function as a Louboutin, which in turn connotes prestige and status.

But that is, really, a topic for another day. What interests me most about aesthetic functionality for the purposes of this Article is the fact that it has been used by courts on a case-by-case basis to determine whether a certain mark was used purely for aesthetic purposes, rather than for source-identifying ones. Consider, for example, *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, a case originating out of the Ninth Circuit concerning defendant’s use of the “Betty Boop” mark on t-shirts bearing movie poster images, dolls, and packaging adapted from plaintiff’s “Betty Boop” vintage movie posters that had fallen into the public domain.¹⁹⁰ The court found that defendant’s use of the Betty Boop word mark on t-shirts bearing such images were not a trademark use, but in fact a decorative component “part and parcel of the aesthetic design of those goods.”¹⁹¹ Thus, the court found for defendant based on the aesthetic functionality doctrine *without* holding that the mark “Betty Boop” was itself ineligible for trademark protection.

The *Fleischer* holding is fascinating for the genericide defense, for it suggests that courts may potentially hold, as well, that for purposes of *this use* (that is, in *this case only*), the mark was being used in its generic sense, merely to denote the category of good it represents. This approach could easily apply to Dapper Dan’s creations—but note that *not all* of Dapper Dan’s creations, some of which use only one mark and one mark alone and thus could in a very real sense be used to connote origin or sponsorship.¹⁹² But as for the

Problem of Functional Features: Trade Dress Infringement Under Section 43(a) of the Lanham Act, 82 COLUM. L. REV. 77 (1982).

187. *Int’l Order of Job’s Daughters*, 633 F.2d at 917.

188. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 222 (2d Cir. 2012) (“Therefore, in determining whether a mark has an aesthetic function so as to preclude trademark protection, we take care to ensure that the mark’s very success in denoting (and promoting) its source does not itself defeat the markholder’s right to protect that mark.”).

189. *Id.* at 224–25.

190. *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 925 F. Supp. 2d 1067, 1070 (C.D. Cal. 2012).

191. *Id.* at 1074.

192. *See* Sanneh, *supra* note 142, at 56 (describing a Dapper Dan Gucci windbreaker).

Dapper Dan creations, which feature three or four trademarks mashed-up together into one creation: now *this*, one could argue, employs the marks in their generic sense, as simply identifying luxury goods, rather than referring to any one unique source (nor could it refer to any one unique source). Rather, such use of the marks employs them in a way reaching far beyond the confines of the Lanham Act. The marks are being repurposed to signify a certain idea of Madison Avenue luxury that was, for a long time, out of reach for many of Dapper Dan's newly-wealthy customers. To them, the marks may or may not blend together: they are signifiers of luxury, not of source.

Similarly, a genericness defense should have been asserted in the *Hyundai* case discussed above. Of course, in *Hyundai*, the failure of the fair use defense hinged almost exclusively on the fact that the court found a lack of intent to comment or parody.¹⁹³ Thus, *Hyundai* is a prime example of how a genericness defense creates a much more cohesive narrative and justification for a certain type of use than the blank assertion of fair use where intent to parody or comment was clearly absent. In arguing that the intent of the commercial "was to portray these over-the-top overwhelming luxury ideas," what Hyundai was *really* arguing was that it used the Louis Vuitton mark in a generic sense.¹⁹⁴

Determining genericness on a case-by-case basis is trickier, less obviously expressive but more blatantly competitive uses such as these does what fair use also aims to do: allow for a small number of uses without wiping out protection for the mark owner completely. On the other hand, genericide offers another perspective on, and viable defense for, the range of allowable uses: a use need not be merely parodic in order to be defensible in a trademark infringement proceeding. Uses can be pastiche, appropriative or dead-pan satiric—they can be, in short, postmodern. And, lastly, a determination of genericness on a case-by-case basis promotes expression beyond that of what is typically thought of as "pure" expressive speech, in the manner of movies, plays, and books.

The onus of litigating a genericness defense on a case by case basis in turn balances out its extraordinary nature, ensuring that potential infringers do not merely exploit the genericide defense in order to free-ride on the goodwill of the mark owner—which, I argue, should be the test employed by courts. That is, like the test the Ninth Circuit used in *Fleischer*,¹⁹⁵ a court could determine, from looking at the allegedly infringing use and any attendant merchandising or advertising, that the use was generic and hence defensible because the mark in this instance was used as referring to a *genus* or class of good, rather than a specific source (consider the evidence presented before

193. *Louis Vuitton Malletier, S.A. v. Hyundai Motor Am.*, No. 10 Civ. 1611 (PKC), 2012 WL 1022247, at *19 (S.D.N.Y. Mar. 22, 2012).

194. *Id.* at *17.

195. *Fleischer Studios, Inc.*, 925 F. Supp. 2d at 1074 (examining defendant's products and merchandising practices and finding that the use of the mark was not source-identifying).

the *Hyundai* court from depositions of the Hyundai executives¹⁹⁶).¹⁹⁷ This would then exclude those uses for which evidence shows that the junior user attempted to mislead as to source (i.e., free-riding uses suggesting sponsorship in the hopes of garnering more sales) but asserted genericness as a defense *ex-post*.

D. GENERICISM AS A FAIR USE FACTOR

Of course, this Article could be read not as being “against” fair use but merely arguing for its reform—i.e., allowing for more, different “fair uses” that would encompass those uses that do not comment upon or target the original. And, as I noted previously, that revolution, at least in copyright law, may already be under way. But familiarizing courts and judges with why genericness is important—why a refusal to comment or anti-transformativeness is important—likewise sheds light on what uses may appropriately be considered “fair”, even if such a defense may ultimately be rejected.

Therefore, perhaps an even less radical proposal than the preceding two tests (generic by market and generic by case) would be folding genericism into the fair use analysis. This would, of course, reintroduce consumer confusion into any given fair use test. Using the Ninth Circuit’s nominative fair use test by way of example, the genericness of a mark would be taken into consideration in evaluating the first factor: whether “the product or service in question [is] one not readily identifiable without use of the trademark.”¹⁹⁸ As Rochelle Dreyfuss has previously suggested in advocating for an expressive genericity defense, “[a]n absence of synonyms [for the prefix ‘Mc’] may have persuaded the court that ‘Mc’ was the crystallization of an otherwise nameless conceptualization, defined by terms like standardized, basic, consistent, and convenient.”¹⁹⁹ In her proposed analysis, even where uses are “close[r] to the signaling side of the spectrum (it implied sponsorship), where the claim for access would require establishing a high degree of necessity, the court might have been persuaded to [deem the use expressive and thus non-infringing].”²⁰⁰ Folding genericness into a fair use determination would accordingly balance necessity (the first factor in the Ninth Circuit’s test) and suggestion of sponsorship (the third factor).²⁰¹ Here, as in the generic-by-case analysis, intent matters: uses are fair where the junior user “does not attempt

196. *Louis Vuitton Malletier, S.A.*, 2012 WL 1022247, at *17.

197. In some ways, this is a reformulation of the “non-mark” defense or theory, see *supra* notes 59–60 and accompanying text, but with a specific focus on a very particular type of “non-mark” use.

198. *New Kids on the Block v. News Am. Publ’g., Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

199. Dreyfuss, *supra* note 11, at 421.

200. *Id.* at 422.

201. *New Kids on the Block*, 971 F.2d at 308.

to capitalize on consumer confusion or to appropriate the cachet of one product for a different one.”²⁰²

While both the generic-by-case and genericness-as-a-fair-use factor would seemingly reintroduce uncertainty and high litigation costs into any trademark infringement defense, in addition to the fact that the end determination is a better “fit” for more types of art-making than current fair use doctrine, such arguments are worth making if for no other reason than that it begins to build toward potential arguments for the genericide of a particular mark within a market. That is—if, over the course of a decade, a number of decisions have been handed down in which, say, Louis Vuitton was found to have been used generically by a number of “high art” artists, then perhaps the next court to approach the issue may find it easier to find that the mark “Louis Vuitton” has undergone genericide in the “high art” market, and thus is *de facto* unprotectable within that market.

E. A LAST OBJECTION: IS EVERYTHING FAMOUS . . . GENERIC?

If this Article has argued for the ad-world’s complete domination of modern day life, then wouldn’t my proposal by nature subject all famous marks to genericide and genericism, such that *no* famous mark is protectable? After all, if ad-speak has become both the *lingua franca*, then certainly *every* famous mark could be generic for something, and thus every famous mark is—generic?

This argument is both intuitive and, in my view, unsupported. Consider again the case of Nadia Plesner, who found herself embroiled in a trademark battle with Louis Vuitton over the use of the Louis Vuitton logo in her drawings of Darufrian children holding oversized purses as a critical commentary on our society’s obsession with luxury over substance. In an interview, Plesner was asked why she specifically chose the Louis Vuitton logo, and whether she thought, for example, that a Fendi bag would have the same cache.²⁰³ Her response was: “I’ve traveled all over the world in places like Asia and Thailand and these kinds of bags in these colors are what I’ve seen the most everywhere. Not only the real bags but the copies—everybody wants to buy them to display a specific image and that’s what I was trying to show.”²⁰⁴ This suggests that, for whatever reason, certain famous marks and symbols resonate more than others, ably capturing the public imagination and taking root in the cultural zeitgeist.

Nor is it simply a matter of “the more famous the mark, the more likely it resonates.” To illustrate this point, consider the use of brand names in rap lyrics. In a study published in 2015, the marketing and communications agency Millward Brown charted the most valuable luxury brands, which are,

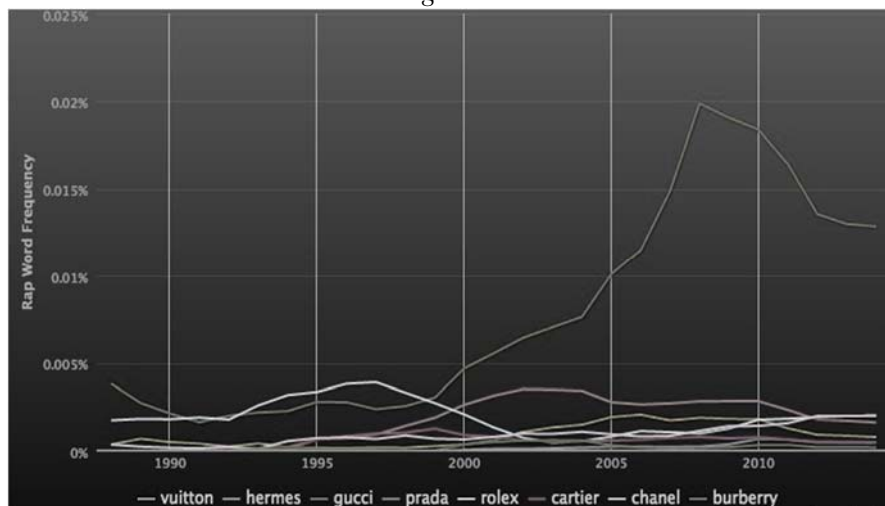
202. *Id.*

203. NYMAG.COM, *supra* note 132.

204. *Id.*

in order: (1) Louis Vuitton; (2) Hermes; (3) Gucci; (4) Chanel; (5) Rolex; (6) Cartier; (7) Prada; (8) Burberry; (9) Michael Kors; and (10) Tiffany.²⁰⁵ Of course, this Article has already documented rap music’s obsession with channeling luxury via the use of brand-names, which become stand-ins for a certain idea of the “bling” lifestyle. Thus, it would only seem intuitive that an analysis of rap lyrics would show the frequency of a certain brand name’s use to roughly correspond to its overall fame. However, an analysis of rap lyrics from 1990 to the present does not bear out this prediction.²⁰⁶

Figure 1.



Rather, the above graph shows the overall prevalence of just one mark: Gucci (its use only briefly eclipsed by Rolex, which rose in the mid-90s before quickly dropping off by the beginning of the ‘aughts). Despite Louis Vuitton’s (and Hermes’) undisputed dominance as luxury labels, the use of either mark pales in comparison to Gucci.²⁰⁷ Further, the use of “Chanel”, which is No. 4 on the list of most valuable global luxury brands, outpaces both Louis Vuitton and Hermes—the two most valuable global luxury brands. Prada, which is

205. Millward Brown, *Economic Weakness in Key Markets Dims Luxury Sales*, MILLWARDBROWN, <http://www.millwardbrown.com/brandz/top-global-brands/2015/brand-categories/luxury> (last visited Apr. 22, 2016).

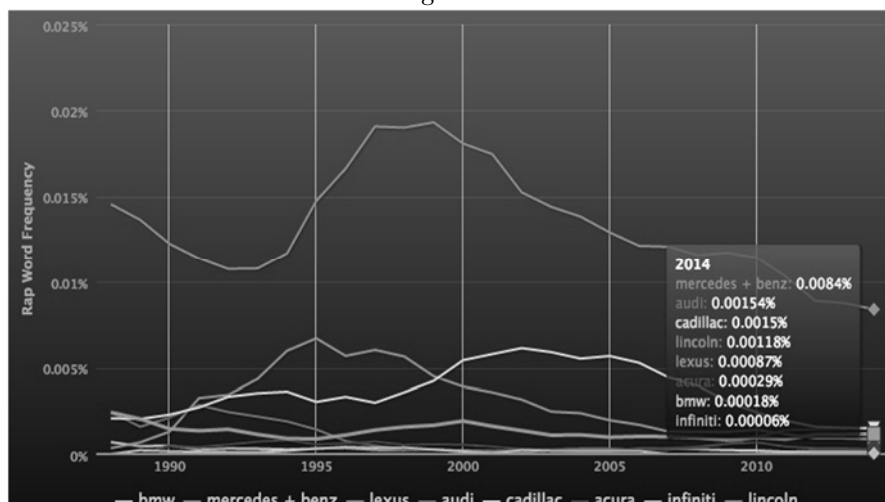
206. Statistical mapping done via Rap Stats, a tool on the rap-lyric-annotation website Rap.Genius.com, which, thanks to its enormous database of song lyrics, is able to plot the use of a specific word across all rap songs over time. See *Rap Stats*, RAP GENIUS, <http://rap.genius.com/rapstats> (last visited Apr. 22, 2016).

207. Note that the statistical mapping assumes that rappers using the term “Louis” are *not* referring to the brand name Louis Vuitton—an assumption that was made based off the definition of “Louis” on Urban Dictionary (i.e., “Louis” is *not* defined as a shorthand for the label)—and thus individually-occurring instances of the word “Louis” were *not* mapped.

only No. 7 on the list, also has outpaced uses of both Hermes and Louis Vuitton in the past five years.²⁰⁸

That the prevalence of a certain word does not correlate to its fame or power as a trademark also bears out in the following graph on the use of luxury car names in rap songs:

Figure 2.



The order in which the automobile brands appear on the bottom of the graph is the order in which they are ranked by sales.²⁰⁹ However, Mercedes Benz overwhelmingly dominates the graph in terms of rap-world frequency—despite BMW’s dominance in the auto industry—and, despite the fact that, by sales, Mercedes Benz only slightly outpaces Lexus in sales.²¹⁰

208. Some may argue that the preference for one word over another, i.e., Gucci over Louis Vuitton, may have less to do with its genus-over-species function and more to do with the fact that “Gucci” may just *sound* better than the clunkier “Louis Vuitton”. This of course is pure speculation and does not have data or even anecdotal evidence to back it up. However, if this does in fact turn out to be true, it is what could be called an aesthetic functionality argument—but for the *sound* of word marks, rather than the *appearance* of design marks (which is what traditional aesthetic functionality doctrine has been rooted in). There is currently no such recognized aesthetic functionality defense for word marks, but it is one that I will be discussing in another forthcoming work. See Xiyin Tang, A Phonaesthetics Theory of Trademark Functionality (2016) (unpublished manuscript) (on file with author).

209. *U.S. Auto Market and Luxury Sales—Graphic of the Day*, THOMSON REUTERS: KNOWLEDGE EFFECT, <http://blog.thomsonreuters.com/index.php/u-s-auto-market-and-luxury-sales-graphic-of-the-day> (last visited Apr. 22, 2016).

210. Some may argue that there are other ways of “referring” to a BMW—for example, by referring to an “M5.” Aside from the fact that an M5 is an entirely separate trademark from “BMW” and therefore cannot be “lumped” together into an analysis of whether the “BMW” trademark should be deemed generic, plotting “M5” into the same data point as “BMW” only shows an uptick of 0.00002% in frequency.

This exercise not only illustrates that, in any given niche (such as the rap industry), there may be only a predominance of one brand name, thus further militating for that brand name's genericity in that specific industry, but also that such dominance does not necessarily correspond to fame, thus questioning the intuition that the more famous the mark, the more likely it will be deemed generic.

Lastly, this exercise also suggests ways in which a court could determine genericness and how that analysis might turn out—by looking to expressive uses and evaluating the frequency in which a specific mark is used generically, within a particular industry. Frequency aside, it may further be helpful to look to Internet sources that frequently evaluate the colloquial uses of words such as Urban Dictionary. In the hip-hop example, Urban Dictionary may be especially insightful: for example, it sets forth an uncannily apt definition for Gucci that reads *almost* as if it were written by Gucci's in-house lawyers, noting the "proper" (to refer to Gucci by source, as "[a] fashion company started by Guccio Gucci in the late 1800s in Italy" and now with designer Tom Ford at the helm), and "improper" ways ("to make a term out of this prestigious name meaning cool or flashy") to refer to the name (proper way: "That gucci coat is blingin!!!" improper way: "Yo that caddy is strait up gucci!").²¹¹

V. CONCLUSION

Our era's flood of brand names in our daily lives creates a seamless integration between how we think, speak, and process information and the free-floating signifiers of consumer culture that surround us. We do not search for information, we Google it. In the opening season of the infamously iconic HBO series *Sex and the City*, the character Carrie Bradshaw, herself a prophet of modern-day pop culture and media, declares: "Welcome to the age of un-innocence. No one has breakfast at Tiffany's and no one has affairs to remember."²¹² In that one line, two references: to both Tiffany's, the jewelry conglomerate meant to symbolize elegance and luxury, and the film *Breakfast at Tiffany's*, in which Audrey Hepburn's character stares bright-eyed and in awe into the window of a Tiffany's store, complete the antithesis to jaded, cynical modern-day New York. In that sense, certain marks have become the poster children for their class of goods: Tiffany's for fine jewelry, Google for search engines, Hennessy for fine liquor, McDonald's for fast food. We refer to these marks by name, not by its category, because they are universals, as enduring in our collective consciousness as the Madonna and child had been for a past age.

211. *Gucci*, URBAN DICTIONARY, <http://www.urbandictionary.com/define.php?term=Gucci> (last visited Apr. 22, 2016) (see the second definition of "Gucci").

212. *Most Memorable Quotes from "Sex and the City"*, NY DAILY NEWS (May 16, 2008, 12:27 AM), <http://www.nydailynews.com/entertainment/memorable-quotes-sex-city-article-1.332554>.

Ours is the modern ad age, and if those who are responsible for the persistence of the signs and symbols that surround us via billboards and radio-speak are to have it both ways: that we both only think of Google when we think of search engine and yet that we not “Google” something but “search for it on Google”—well, what would be the justice in that? Genericide is, in my view, the only trademark defense that gives back to the very consumers the entire system depends upon. And genericide is a muscle: the more we flex it, the stronger the argument for the genericness of a mark becomes.²¹³ Conversely, the more artists turn to the overwhelmingly popular defense of fair use and its focus on parody, the more we regress to the now-ridiculous idea that there is some unique original left. The “generic” therefore is two-fold, able to simultaneously convey the banal and the universal. The “generic” in trademark law is a word that has become indispensable in delineating a certain set; the “generic” in popular vernacular is the everyday, the dull, the commonplace. Genericness as a defense is not just a legal statement—it is an ideological and political statement.

“Toyota Corolla, Toyota Celica, Toyota Cressida. Supranational names, computer-generated, more or less universally pronounceable. Part of every child’s brain noise”²¹⁴—welcome to the new ad-age. As corporations find ever-increasing means of protecting not just commercial goodwill but an all-encompassing brand identity and supranational corporate culture,²¹⁵ we the people will find new ways of rebelling against such totalitarian attempts at controlling speech and impairing expression. The revolution will be genericized.

213. See *supra* note 13 and accompanying text.

214. DELILLO, *supra* note 51, at 155.

215. See Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1916 (2007) (characterizing modern trademark law as “industrial policy intended to protect brand value”).