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Articles and Reports

*867 THE INTERSECTION OF FIRST AMENDMENT COMMERCIAL SPEECH ANALYSIS AND THE FEDERAL TRADEMARK DILUTION ACT: A JURISPRUDENTIAL ROADMAP

Richard B. Biagi [FN1]

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I. INTRODUCTION

The First Amendment to the United States Constitution states that "Congress shall make no law ... abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances." Although the absolute nature of this language remains the subject of a vigorous debate, the United States Supreme Court has steadfastly held that restrictions on the freedom of speech may be "permitted for appropriate reasons." [FN1]

Throughout the last century, the Court placed limits on the absolute nature of the protection afforded by the First Amendment. The Court has provided less protection to speech that incites violations of the law, [FN2] is obscene [FN3] or profane, [FN4] amounts to *868 "fighting words" [FN5] and speech that can be characterized as commercial. [FN6] It is this final category of speech, commercial speech, which will be the focus of this article, in light of the Federal Trademark Dilution Act ("FTDA"). [FN7]

With the advent of the Internet came a new and unique vehicle to transmit one's thoughts and ideas to the entire world immediately with the click of a button. In recent years, the Internet has proven to be a successful market place for ideas as well as goods and services. One example of the Internet's power as a free market place of ideas is the rise of the "cybergriper," [FN8] one who dedicates web sites to criticizing a person, product, or business. Cybergrippers often refer to the target of their criticism by registering a domain name that uses the federally protected trademarks of the entity being criticized, such as "ballysucks.com" [FN9] (referring to Bally Total Fitness).

Trademark owners seeking to protect their trademark rights against the actions of the cybergriper increasingly have turned to the federal trademark laws to preclude such use of their intellectual property. [FN10] This article will address the tension between the broad protection afforded by the First Amendment and the federal trademark dilution laws as applied to cybergriper web sites.

II. FEDERAL TRADEMARK DILUTION LAW

In 1946, Congress enacted the Lanham Act. [FN10a] The Lanham Act not only affords protection to federally registered trademarks [FN11] but also to trademarks that have been used in commerce though not federally registered. [FN12] In the legislative history of the statute, Congress expressed its intention to protect both the consumer and the trademark owner. [FN13] In protecting the consumer, Congress stated that it enacted this legislation "so [[the *869 public] may be confident that, in purchasing a product bearing a particular trademark which it favorably knows, it will get the product which it asks for and wants to get." [FN14] In addition, Congress stated that the trademark owner's expenditure of "energy, time, and money in presenting to the public the product" should be protected from "misappropriation by pirates and cheats." [FN15]

To achieve this dual goal, the Lanham Act provides for a claim of infringement, intended to reduce confusion among products in the market place. [FN16] Almost fifty years later, Congress amended the Lanham Act to add a dilution claim to protect the trademark holder's investment in its trademark. [FN17] The term "dilution" has been defined as the "lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of -- (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception."

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[FN18]

Prior to the enactment of the FTDA in 1995, a trademark owner had difficulty prohibiting the use of the same or similar mark on dissimilar goods or services which was not likely to result in consumer confusion. [FN19] "The fear that motivates trademark dilution protection is 'death by a thousand cuts,' or a fear that 'unauthorized use [of a trademark] by others on dissimilar products [[causes a slow] whittling away of an established trademark's selling power.'" [FN20] To that end, one court stated that "[t]he gravamen of a dilution complaint is that the continuous use of a mark similar to plaintiff's works an inexorably adverse effect upon the distinctiveness of the plaintiff's mark, and that, if he is powerless to prevent such use, his mark will lose its distinctiveness entirely ... dilution is an infection which, if allowed to spread, will inevitably destroy the advertising value of the mark." [FN21]

The FTDA of 1995 provides that:

***870** The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. [FN22]

The FTDA exempts certain trademark uses from a claim of dilution:

The following shall not be actionable under this section:

(A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.

(B) **Noncommercial use of a mark.**

(C) All forms of news reporting and news commentary. [FN23]

Therefore, to succeed on a claim for trademark dilution under the FTDA, "[a]ll that needs to be proven is that the mark is famous and the use by the offending party of the mark is commercial and in commerce. The mark [sought to be protected] may be either a common law mark or a federally registered one." [FN24]

Congress included the noncommercial use exemption in the FTDA in light of First Amendment concerns that the statute would otherwise prohibit protected forms of expression. [FN25] In the legislative history accompanying the FTDA, Senator Orrin Hatch defined the noncommercial use exemption under Section 1125(c)(4)(B) of the FTDA as encompassing "parody, satire, editorial and other forms of expression that are not part of a commercial transaction" [FN26] (referred to in this article as the "Hatch Definition").

Cybergrippers, as mentioned earlier, often use famous trademarks when publishing online content containing criticism of an organization's goods or services. Although it would initially appear that a "cybergriper" is exempt under the Hatch Definition of noncommercial use because the cybergriper's web site is not ***871** typically associated with the sale of goods or services, but rather is merely a forum by which the cybergriper airs his criticism, the federal courts have failed to agree on a standard for applying the exemption. This article will examine the issue of what standard should apply to noncommercial speech as it relates to the "cybergriper."

III. THE FIRST AMENDMENT COMMERCIAL SPEECH DOCTRINE

To better understand the reasoning behind the noncommercial use exemption in the FTDA, it is necessary to examine the Supreme Court's holdings relating to the protection of commercial speech under the First Amendment.

Prior to 1975, the Supreme Court included commercial speech in the list of unprotected forms of expression. [FN27] Indeed, in a 1942 decision, *Valentine v. Chrestensen*, [FN28] the Court ruled that commercial speech enjoyed no protection under the First Amendment. This began to change in 1975 in *Bigelow v. Virginia*. [FN29] The Court in *Bigelow* reversed a conviction for violation of Virginia law arising from the publication of an advertisement in a newspaper regarding the availability of abortion services in New York. The Court distinguished its prior holdings by stating that the advertisement at issue in *Bigelow* "did more than simply propose a commercial transaction" and therefore enjoyed limited protection under the First Amendment. [FN30]

In 1976, the Court in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council* [FN31] extended *Bigelow* to

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provide First Amendment protection to certain forms of commercial speech:

If there is a kind of commercial speech that lacks all First Amendment protection, therefore, it must be distinguished by its content. Yet the speech whose content deprives it of protection cannot simply be speech on a commercial subject Nor can it be dispositive that a commercial advertisement is noneditorial, and merely reports a fact. Purely factual matter of public interest may claim protection Our question is whether speech which does "no more than propose a commercial transaction" is so removed from any "exposition of ideas," and from "truth, science, morality, and arts in *872 general, in its diffusion of liberal sentiments on the administration of Government," that it lacks all protection. Our answer is that it is not. [FN32]

In reference to this distinction between various types of commercial speech, one court recently held that "[a]n expressive use does not become a commercial use solely because the use increases sales for a user." [FN33] Illustrating the spectrum of protected and unprotected speech, the district court held that "[b]etween advertisement and art, there exists various forms of speech that combine commercial and noncommercial elements. Whether a communication combining those elements is to be treated as commercial speech depends on factors such as whether the communication is an advertisement, whether the communication makes reference to a specific product, and whether the speaker has an economic motivation for the communication." [FN34]

The Third Circuit also adopted the aforementioned factors, initially outlined by the Supreme Court in *Bolger v. Youngs Drug Products, Corp.*, [FN35] in formulating its definition of commercial speech:

Commercial speech may be broadly defined as expression related to the economic interests of the speaker and its audience, generally in the form of a commercial advertisement for the sale of goods and services The Supreme Court has cited three factors to consider in deciding whether speech is commercial: (1) is the speech an advertisement; (2) does the speech refer to a specific product or service; and (3) does the speaker have an economic motivation for the speech. An affirmative answer to all three questions provides strong support for the conclusion that the speech is commercial. [FN36]

One commentator suggested yet another definition for commercial speech, stating that commercial speech should be defined as: "(1) speech that refers to a specific brand name product or service, (2) made by a speaker with a financial interest in the sale of the advertised product or service, in the sale of a competing product or service, or in the distribution of the speech, (3) that does *873 not advertise an activity itself protected by the First Amendment." [FN37]

A determination that a particular expression falls within the definition of commercial speech does not necessarily remove that expression from the protection of the First Amendment. If a court determines that a particular expression falls within the commercial speech definition, the restriction on that expression is still subject to a form of intermediate scrutiny in order to balance the state's interest in prohibiting the speech against the protections afforded such speech by the First Amendment. In 1980, the Supreme Court set forth a four-part analysis for commercial speech cases:

[First], we must determine whether the expression is protected by the First Amendment. For commercial speech to come within that provision, it at least must concern lawful activity and not be misleading. [Second], we ask whether the asserted governmental interest is substantial. [Third, if] both inquiries yield positive answers, we must determine whether the regulation directly advances the governmental interest. [And fourth], if the governmental interest could be served as well by a more limited restriction on commercial speech, the excessive restrictions cannot survive. [FN38]

IV. THE COMMERCIAL SPEECH DOCTRINE AND TRADEMARK LAW

One court explained the relationship between First Amendment protection of speech and trademark law and the circumstances under which trademark law takes precedence over First Amendment rights:

The grant to one person of the exclusive right to use a set of words or symbols in trade can collide with the free speech rights of others. When another's trademark (or a confusingly similar mark) is used without permission for the purpose of source identification, the trademark law generally prevails over the First Amendment. Free speech rights do not extend to labeling or advertising products in a manner that conflicts with the trademark rights of others. In these circumstances, the exclusive right guaranteed by the trademark law is *874 generally superior to the general free speech rights of others. See *Rogers v. Grimaldi*, 875 F2d 994, 999 (CA 2 1989). [FN39]

In contrast, a federal district court in New York held that a "[d]efendant's use of another entity's mark is entitled to First Amendment protection when his use of that mark is part of a communicative message, not when it is used to identify the source of a product." [FN40]

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In the context of the FTDA, the legislative history sheds a great deal of light on Congress' intended definition of the term "communicative message." Senator Leahy, in his comments on the bill, stated that, "parody, satire, editorial and other forms of expression will remain unaffected by this legislation." [FN41] As mentioned previously, the Hatch Definition in the introduction to the FTDA states that, "the bill will not prohibit or threaten noncommercial expression, such as parody, satire, editorial and other forms of expression that are not part of a commercial transaction." [FN42] Finally, Representative Moorehead stated that: "The bill would not prohibit or threaten noncommercial expression, such as parody, satire, editorial, and other forms of expression that are not part of a commercial transaction." [FN43]

In light of the preceding case law and legislative history of the FTDA, it is clear that when a defendant uses a confusingly similar mark in an expression that is not a communicative message but rather a commercial message, the protections afforded by the First Amendment are not applicable. The more difficult question is whether the First Amendment protects expression that includes the use of another's trademark when the expression can be characterized as neither purely commercial nor purely communicative. For example, does the First Amendment protect a web site titled IBM SUCKS, whose purpose is to publish criticism of IBM's latest computer, when the web site also contains an advertisement for handmade wood furniture? Does this constitute commercial speech, and if so, is this expression protected by the First Amendment?

Additionally, there remains the question of how noncommercial speech is defined, in the context of the cybergriper, under the noncommercial use exemption to the FTDA. Both questions may *875 be answered only by following a journey through the limited yet conflicting patchwork of case law illustrating the tension between constitutionally protected expressions of criticism and the policies underlying the FTDA. These cases illustrate the courts' difficulty in struggling with the tension between protecting communicative expression under the First Amendment and protecting trademark owners from dilution of a famous mark.

V. CONFLICTING TRADEMARK DILUTION CASE LAW

Cases involving the noncommercial use exemption to the FTDA may be separated into two disparate types. The first category of cases are those in which the court attempts to characterize the defendant's actions as commercial or noncommercial based upon the nature of the expression (i.e., parody, satire, criticism, etc.) and whether the expression contains a commercial component. [FN44] In the second category, the court uses a multifactor test, focusing on the defendant's intent, to determine whether a particular expression should be classified as commercial and therefore exempt from the FTDA.

A. The "Commercial Component" Cases

In *Dr. Seuss Enterprises, L.P. v. Penguin Book USA, Inc.*, [FN45] the defendant authored a book entitled "The Cat Not in the Hat! A Parody by Dr. Juice," intended to provide a "fresh new look" at the O.J. Simpson double murder trial through a parody of the famous Dr. Seuss works for children. In the complaint, plaintiff alleged that the defendant copied protected elements of its copyrighted works, infringed upon multiple trademarks owned by plaintiff and diluted the distinctive quality of plaintiff's trademarks. Defendant argued that its use of plaintiff's marks fell outside the reach of the dilution statute because the use was noncommercial. The plaintiff argued that defendant's use was commercial because the marks were used "to make their book more entertaining and to consequently, sell more copies." [FN46]

Addressing the trademark dilution claim, the court cited the legislative history, including the Hatch Definition of "noncommercial use" within the meaning of Section 1125(c)(4)(B) of the *876 FTDA. [FN47] The court rejected plaintiff's argument that increased sales renders the expression commercial, holding that "an expressive use is not rendered commercial by the impact of the use on sales." [FN48] The court held that defendant's use of plaintiff's marks was an "expressive use ... that [was] exempt from the reach of the Federal Trademark Dilution Act." [FN49]

Two years later, another federal district court in California, in *Mattel, Inc. v. MCA Records, Inc.*, [FN50] applied the *Dr. Seuss* holding concerning the noncommercial use exemption of the FTDA to sound recordings. This case involved the release of a song entitled "Barbie Girl" by the Danish musical group "Aqua." The defendants argued that the song was merely a parody of the famous toy manufactured by plaintiff. [FN51] Plaintiff brought suit alleging trademark and trade dress dilution, trademark infringement and unfair competition.

In its analysis of the trademark dilution claim and the noncommercial exemption under Section 1125(c)(4)(B), the *Mattel* court first characterized the Supreme Court's holding in *Virginia State Board of Pharmacy* as defining commercial speech as that "which does no more than propose a commercial transaction." [FN52] The court then cited various portions of the legislative history regarding the FTDA that stated that "the bill will not prohibit or threaten 'noncommercial' expression as the

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term has been defined by courts" [FN53] and that "nothing in this bill is intended to alter existing case law on the subject of what constitutes 'commercial speech.'" [FN54] In addition, the court cited the comments of Senators Hatch and Leahy and Representative Moorehead regarding the intention of Congress to exclude "parody, satire, editorial and other forms of satire that are not part of a commercial transaction" from the reach of the FTDA. [FN55]

Based on the legislative history of the FTDA and established Supreme Court precedent involving the commercial speech doctrine, the court rejected plaintiff's argument that the purpose of the song was to profit financially and, therefore, that defendant's *877 use of plaintiff's mark was commercial. The court, citing Virginia State Board of Pharmacy, held that "the fact that defendants' product makes a profit or is successful ... does not affect the protections afforded to it by the First Amendment. By plaintiff's reasoning, any book, movie, or song that incorporates a product name in its title would receive less protection the more money that it makes." [FN56] The court held that defendant's use of plaintiff's mark was exempt from the reach of the FTDA because the use was noncommercial in nature.

In a 1999 decision, a federal district court in Connecticut in World Championship Wrestling v. Titan Sports, Inc. [FN57] held that a speech that increases sales cannot categorically be defined as commercial in the context of a television broadcast. Plaintiff, World Championship Wrestling, was involved in televising, merchandising and licensing professional wrestling. Defendant Titan Sports, operating under the trade name World Wrestling Federation, offered live, cable and pay-per-view broadcasts of professional wrestling matches. Plaintiff filed suit claiming trademark infringement, unfair competition and trademark dilution, alleging that defendant "engaged in a continuing scheme to disparage the WCW and NITRO trademarks, and to exploit and exacerbate consumer confusion with respect to the affiliation of professional wrestlers under contract to WCW and as to the source, origin and sponsorship of certain professional wrestling programming." [FN58]

Defendant argued that its use of plaintiff's marks was noncommercial and expressive and therefore exempt from the dilution statute pursuant to Section 1125(c)(4)(B) of the FTDA. In its analysis of the noncommercial use exemption under the FTDA, the court cited the Supreme Court's holding in Bolger v. Youngs Drug Products for the proposition that the "classic example of commercial speech is an advertisement that 'does no more than propose a commercial transaction.'" [FN59] In addition, the court held that "an expressive use does not become a commercial use solely because the use increases sales for a user." [FN60] Finally, the court cited the test first enunciated by the Second Circuit in Rogers v. Grimaldi, that "[i]f the unauthorized use of a mark is for expressive purposes implicating the First Amendment ... the rights of *878 the trademark owner must be weighed against the interests of free speech." [FN61]

Denying defendant's motion to dismiss the claim, the court concluded:

The world of professional wrestling seems to be a hybrid of expressive performance and advertisement, with wrestlers trading insults, performing attention-getting stunts and challenging each other to fights in the hopes of attracting viewers. The balancing test called for in the case law involves factual and legal issues which cannot be disposed of at this stage in the case. [FN62]

More recently, a federal district court in New York afforded First Amendment protection to what it characterized as merely a parody of the plaintiff's trademark in Charles Atlas, Ltd. v. DC Comics, Inc. [FN63] Plaintiff, a well-established provider of bodybuilding courses, brought suit against DC Comics, a widely-read creator and publisher of comic books and magazines alleging that DC Comics' comic strip character, FLEX MENTALLO, was a vulgar parody of and tarnished plaintiff's HERO OF THE BEACH trademark. In response to plaintiff's trademark dilution claim, defendant argued that its use of plaintiff's trademark was noncommercial and therefore not subject to the Lanham Act and that, as a parody, the expression warranted protection under the First Amendment.

The Charles Atlas court cited specific instances in which other courts found expression to be subject to the Lanham Act because of its commercial nature although the expression was embodied as parody. [FN64] The court then focused on whether the challenged use was likely to cause consumer confusion. The court explained:

Only if defendant's use of plaintiff's mark was "not in a manner that could create confusion as to source, but rather as a part of a message whose meaning depended on reference to plaintiff's product" is defendant free and clear of liability. *879 Accordingly, we must evaluate both the defendant's use of plaintiff's trademark material and the likelihood of confusion in order to determine whether liability may attach under the Lanham Act. [FN65]

In outlining the standard for the defendant's parody defense, the court cited earlier case law that held:

Satirists, selling no product other than the publication that contains their expression, may wish to parody a trademark to make a point of social commentary ... to entertain ... or perhaps both to comment and entertain. Such uses risk some dilution of the

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identifying or selling powers of the mark, but that risk is generally tolerated in the interest of maintaining broad opportunities for expression. *Deere & Co.*, 41 F3d at 44 (citing, inter alia, *Girl Scouts of USA v. Personality Posters Manufacturing Co.*, 304 F Supp 1228 (SDNY 1969)). [FN66]

The court reviewed the parody defense under the well-settled Supreme Court case law regarding protected parodies, concluding that the analysis for either of defendant's pleaded defenses was the same, namely, "whether defendant used the mark for an expressive purpose, or to create an incorrect association in order to confuse the public." [FN67] The court held that defendant's expression was in fact protected by the First Amendment.

B. The "Intent of Defendant" Cases

In *Planned Parenthood Federation of America v. Bucci*, [FN68] the plaintiff was a well-established, non-profit, reproductive healthcare organization, which sued a pro-life advocate for trademark infringement, unfair competition and trademark dilution. The defendant Bucci operated a web site at the address "www.plannedparenthood.com." When users accessed the web site, they were greeted by the words "Welcome to the PLANNED PARENTHOOD HOME PAGE!" and a scanned image of the (pro-life) book "The Cost of Abortion" by Lawrence Roberge. The web page also contained hyperlinks to a full text version of the book as well as various book reviews and contact information for the author.

Addressing the trademark dilution claim, the court held that: "defendant's use of plaintiff's mark is 'commercial' [and thus not covered by the noncommercial use exemption of the FTDA] for *880 three reasons: (1) defendant is engaged in the promotion of a book, (2) defendant is, in essence, a non-profit political activist who solicits funds for his activities, and (3) defendant's actions are designed to, and do, harm plaintiff commercially." [FN69] The court cited various authorities to bolster its argument that defendant's use was commercial within the meaning of the statute as a result of defendant's intent to profit from, and harm the good will and fame associated with, the plaintiff's mark. First, the court held that "[a]lthough defendant does not seek a profit from his actions, Section 1125(c) carries no 'for-profit' requirement." [FN70] Next, the court held that the "mere fact that defendant seeks to criticize plaintiff cannot automatically immunize a use that is otherwise prohibited by the Lanham Act." [FN71] Finally, the court held that "defendant's use of plaintiff's mark is sufficiently tied to defendant's fund-raising efforts for the use to be deemed 'commercial' within the meaning of Section 1125(c)." [FN72] The court then explained the relationship between the noncommercial use exemption in Section 1125(c)(4)(B) and the First Amendment by holding that "whether defendant's use of the mark is commercial within the meaning of the Lanham Act is a distinct question from whether defendant's use of the mark is protected by the First Amendment." [FN73]

In the court's First Amendment analysis, it cited the holding in *Yankee Publishing, Inc. v. News America Publishing, Inc.*, stating "defendant's use of another entity's mark is entitled to First Amendment protection when his use of that mark is part of a communicative message, not when it is used to identify the source of the product." [FN74] The court held that defendant's use of the domain name "plannedparenthood.com" and the reference to "plannedparenthood.com" in the homepage were source-identifiers that confused viewers into believing that defendant's web site originated from plaintiff. This type of use, the court held, was not part of a communicative message and therefore was not protected by the First Amendment.

In *Jews For Jesus v. Brodsky*, [FN75] a federal district court in New Jersey considered a case with facts similar to those in *881 *Planned Parenthood*. Defendant Brodsky, a professional Internet web site developer, registered the domain name "jewsforjesus.org" and developed a web site criticizing the plaintiff and containing a hyperlink to the Outreach Judaism Organization web site. The plaintiff, a non-profit international outreach ministry that teaches "Jesus is the Messiah of Israel and the Savior of the World," filed a complaint against Brodsky alleging trademark infringement, unfair competition and trademark dilution.

The court addressed the noncommercial use exemption under the FTDA, holding that defendant's use of plaintiff's famous mark was in fact commercial. The court used the three-part analysis set forth in *Planned Parenthood*, and found that defendant's site solicited funds indirectly through a hyperlink to the Outreach Judaism Organization web site, and that defendant's use of plaintiff's mark was designed to "harm the Plaintiff Organization commercially by disparaging it and preventing the Plaintiff Organization from exploiting the Mark [sic] and the Name [sic] of the Plaintiff Organization." [FN76] Ultimately, the court appeared to weigh heavily the defendant's intention to "trick" users into believing that his web site originated with plaintiff.

Courts also have relied on the intent of the defendant in finding a commercial use in cases involving cybersquatters -- i.e., defendants who register famous trademarks as domain names in the hope that the trademark owner will pay a substantial

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ransom for the domain name.

The plaintiff in *Intermatic, Inc. v. Toeppen* [FN77] was a large "manufacturer and distributor of a wide variety of electrical and electronic products, including computerized and programmable timers ... sold under the name and trademark INTERMATIC," [FN78] which had been doing business for more than fifty years. Defendant Toeppen was a small Internet service provider who acquired various Internet domain names that included famous business names with the intention of selling the domain names back to the various business name owners. [FN79] Defendant registered the domain name "intermatic.com," intending to market a software program under the name Intermatic. He operated a web site under the "intermatic.com" domain name, but removed the site after only one week in response to the plaintiff's cease and desist request and never sold any goods or services on the "intermatic.com" web site. *882 The plaintiff filed suit against Toeppen for trademark infringement, unfair competition and trademark dilution.

Defendant argued that his use of plaintiff's mark was not commercial and therefore was exempt from the reach of the dilution statute. Plaintiff claimed that defendant's use was commercial, because ".com," in fact, is an abbreviation for "commercial" and because the domain name was used "in connection with the proposed sale of computer software." [FN80] Although the court neglected to specifically invoke the First Amendment in its analysis, it instead focused its analysis on Toeppen's intention to sell the subject domain name for commercial gain.

Addressing Intermatic's first argument, the court held that a ".com designation alone does not establish commercial use" [FN81] within the meaning of Section 1125(c)(4)(B) because at the time, the .com suffix (or top level) was the only available designation for commercial and private use. The court also rejected the argument that defendant's use of the domain name to sell computer software constituted commercial use because the sale terminated prior to the enactment of the FTDA. However, the court held instead that defendant's intent to sell the domain name back to the plaintiff did, in fact, constitute commercial use:

Toeppen's intention to arbitrage the "intermatic.com" domain name constitutes a commercial use. At oral argument Toeppen's counsel candidly conceded that one of Toeppen's intended uses for registering the Intermatic mark was to eventually sell it back to Intermatic or to some other party. Toeppen's desire to resell the domain name is sufficient to meet the "commercial use" requirement of the Lanham Act. [FN82]

Another case involving defendant Toeppen, *Panavision International, L.P. v. Toeppen*, [FN83] involved the registration of the domain names "panavision.com" and "panaflex.com," which incorporated the registered trademarks of plaintiff Panavision, a "theatrical motion picture and television camera and photographic equipment business." [FN84] Plaintiff alleged trademark infringement, trademark dilution and unfair competition claims.

Analyzing whether defendant's use of plaintiff's marks was commercial under the FTDA, the court first held that "[r]egistration *883 of a trade [name] [[sic] as a domain name, without more, is not a commercial use of the trademark and therefore is not within the prohibitions of the Act." [FN85] The court next noted that: "The Dilution Act requires that the 'commercial use' be 'in commerce.' Commerce is defined as 'all commerce which may lawfully be regulated by Congress.' 15 U.S.C. Sec. 1127. Toeppen's conduct was clearly commerce within this definition." [FN86]

Toeppen's "business" is to register trademarks as domain names and then to sell the domain names to the trademarks' owners. Toeppen's business is evident from his conduct with regard to Panavision and his conduct in registering the domain names of many other companies. His "business" is premised on the desire of the companies to use their trademarks as domain names and the calculation that it will be cheaper to pay him than to sue him. Panavision, however, chose to litigate rather than accede to Toeppen's \$13,000 "fee." [FN87]

The court explained that the purpose of the noncommercial exemption in the FTDA is to avoid the preclusion of constitutionally protected forms of speech under the First Amendment, including "parodies and consumer product reviews." [FN88] The court also cited the Hatch Definition of "noncommercial use" under the FTDA. [FN89]

As in *Intermatic*, the court focused on Toeppen's intent to profit from the value associated with the subject trademark, concluding that Toeppen's use did not fall under the noncommercial exemption. As the court held, "permissible, non-trademark uses stand in sharp contrast to Toeppen's use of the Panavision marks. Toeppen traded on the value of the marks as marks by attempting to sell the domain names to Panavision." [FN90]

Another, more recent case, *OBH, Inc. v. Spotlight Magazine, Inc.*, [FN91] illustrates the continuing reliance placed upon the multifactor test set forth in *Planned Parenthood* and the emphasis placed on the defendant's intent to confuse the public as to

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the source of his goods or services in order to commercially harm the plaintiff or, in the case of defendant Toeppen, to profit from the *884 value associated with the plaintiff's mark. The plaintiff in OBH was the holding company of The Buffalo News, a daily newspaper in Buffalo, New York, and it owned a federal registration for the mark THE BUFFALO NEWS. Defendant published a free apartment rental guide entitled Apartment Spotlight Magazine in western and central New York. Defendant registered the domain name "thebuffalonews.com" and operated a web site that contained "disparaging comments about The Buffalo News and hyperlinks to other web pages containing negative opinions and stories about The Buffalo News." [FN92] In addition, the web site contained hyperlinks to other news-related web sites, some of which competed with The Buffalo News. Plaintiff filed an action in federal court for trademark infringement, trademark dilution and unfair competition.

Responding to the dilution claim, defendant argued that its use of plaintiff's trademark constituted a parody and therefore was exempt from the reach of the FTDA pursuant to the noncommercial use provision in Section 1125(c)(4)(B). The court rejected defendant's argument, citing the holding in Planned Parenthood that "defendant's use of plaintiff's trademark constitutes a commercial use because defendant's actions are designed to, and do, harm plaintiff commercially." [FN93] In this case, as evidence of the defendant's intent, the court pointed to the hyperlinks that transported users to other news-related web sites that were in direct competition with The Buffalo News. In addition, the court found that defendant's use of plaintiff's trademark constituted a commercial use in light of the presence of the hyperlink to defendant's own publication and the fact that defendant's publication was operated for commercial purposes.

As in the Planned Parenthood decision, the court in OBH, Inc. appeared to sever the relationship between the noncommercial use exemption to the FTDA and the First Amendment protection afforded to communicative expressions. Citing Yankee Publishing, the court held that:

[W]hen another's trademark ... is used without permission for the purpose of source identification, the trademark law generally prevails over the First Amendment. Free speech rights do not extend to labeling or advertising products in a manner that conflicts with the trademark rights of others. [FN94]

*885 Finally, in the recent case of Northland Insurance Companies v. Blaylock, [FN95] a federal district court in Minnesota refused to infer from the record that defendant intended to harm plaintiff's business. Accordingly, it held that the speech in question was noncommercial and exempt from the reach of the FTDA. The plaintiff in Northland, an insurance provider, had refused to indemnify defendant Blaylock for damage to a yacht covered under a policy it had issued. Following Northland's refusal to indemnify, Blaylock created two web sites under the registered domain names northlandinsurance.com and sailinglegacy.com. The web sites were utilized by Blaylock to offer commercial commentary and criticism of Northland's business practices. Northland subsequently filed suit against Blaylock under the Lanham Act and the Anticyber-squatting Consumer Protection Act ("ACPA"). [FN96]

Analyzing Blaylock's noncommercial use defense to Northland's claim under the FTDA, the court held:

[A]ny inference of defendant's commercial motives or intentions to commercially impact plaintiff's business is speculative absent further proof. Thus, even if the court concludes that the plaintiff's mark is famous and distinctive for purposes of this statute, there is no indication of commercial use. On the basis of the present record, defendant's use is for noncommercial commentary purposes. Defendant correctly contends that his use is exempt because it constitutes noncommercial speech. Therefore, the court finds that plaintiff is unlikely to prevail on the merits of the FTDA claim. [FN97]

It is evident from the aforementioned cases that there are two distinct theories concerning the noncommercial use exemption of the FTDA. The first theory, following the Hatch Definition, affords First Amendment protection to any "noncommercial expression, such as parody, satire, editorial and other forms of expression that are not part of a commercial transaction." Additional legislative history beyond the Hatch Definition strengthens the argument that Congress intended to exempt from the reach of the FTDA all communicative expression, even if the expression includes famous trademarks, unless that expression involves a commercial transaction.

Upon deeper reflection, however, this theory appears somewhat flawed. The Hatch Definition seems to be founded on circular logic, namely, that noncommercial speech is that which does not *886 involve a commercial transaction. The Hatch Definition fails to explain how much of a "commercial transaction" is sufficient to remove communicative expression from First Amendment protection. According to Senator Hatch, any expression that includes even a de minimis commercial transaction should remove its First Amendment protection.

Judicial reliance on the Hatch Definition would effectively broaden the Supreme Court's definition of commercial speech by

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holding that commercial speech is not only speech which "does no more than propose a commercial transaction" [FN98] but also includes various communicative expressions that involve a commercial transaction element. Under this broader definition, speech that contains both a communicative and commercial aspect may lose its First Amendment protection, thus narrowing the protection afforded by the First Amendment to hybrid commercial and communicative forms of expression in accordance with the Supreme Court precedent in the area of commercial speech.

The second theory arising from the Planned Parenthood line of cases involves a multifactor test that considers the intent of the defendant to profit from the value associated with plaintiff's mark or confuse consumers as to the source of his goods or services; the harm caused to the plaintiff; and the economic benefit reaped by the defendant as a result of his use of plaintiff's trademark. Under this approach, the court is required to infer the purpose of the speech by analyzing the defendant's financial gains and the competitive nature of the parties' services or products. The court is put in the difficult position of determining the defendant's intent through indirect evidence because defendants rarely concede an intent to profit from the fame of the plaintiff's mark or to cause confusion or commercial harm. Thus, the decision to prohibit certain communicative expression often is based solely upon the court's "best guess" as to the defendant's intent. This approach also seems to leave First Amendment protection in a precarious position.

In this author's opinion, the approach used in Planned Parenthood appears to be loosely based on the Supreme Court's decision in *Bolger v. Youngs Drug Products Corp.*, although the Planned Parenthood court never expressly mentioned *Bolger*. [FN99] The Court in *Bolger* held that informational pamphlets on the topic of contraception that contained various references to Trojan brand condoms were commercial speech. The Court reviewed three factors in reaching this decision, although it expressly stated that *887 no one factor is dispositive of a finding that the expression in question constitutes commercial speech:

The mere fact that these pamphlets are conceded to be advertisements clearly does not compel the conclusion that they are commercial speech. See *New York Times Co. v. Sullivan*, 376 US 254, 265-266 (1964). Similarly, the reference to a specific product does not by itself render the pamphlets commercial speech. See *Associated Students for Univ. of Cal. at Riverside v. Attorney General*, 368 F Supp 11, 24 (CD Calif 1973). Finally, the fact that Youngs has an economic motivation for mailing the pamphlets would clearly be insufficient by itself to turn the materials into commercial speech. See *Bigelow v. Virginia*, 421 US, at 818; *Ginzburg v. United States*, 383 US 463, 474 (1966); *Thornhill v. Alabama*, 310 US 88 (1940) That a product is referred to generically does not, however, remove it from the realm of commercial speech. For example, a company with sufficient control of the market for a product may be able to promote the product without reference to its own brand names. Or a trade association may make statements about a product without reference to specific brand names. See, e.g., *National Comm'n on Egg Nutrition v. FTC*, 570 F2d 157 (CA 7 1977) (enforcing in part a Federal Trade Commission order prohibiting false and misleading advertising by an egg industry trade association concerning the relationship between cholesterol, eggs, and heart disease). In this case, Youngs describes itself as "the leader in the manufacture and sale" of contraceptives. Brief for Appellee 3. The combination of all these characteristics, however, provides strong support for the District Court's conclusion that the informational pamphlets are properly characterized as commercial speech. The mailings constitute commercial speech notwithstanding the fact that they contain discussions of important public issues such as venereal disease and family planning. We have made clear that advertising which "links a product to a current public debate" is not thereby entitled to the constitutional protection afforded noncommercial speech. *Central Hudson Gas & Electric Corp. v. Public Service Comm'n of New York*, 447 US, at 563. [FN100]

Based on the Supreme Court's holding in *Bolger*, the factors outlined by Planned Parenthood should be considered as a whole and no one factor should be dispositive of a finding that the expression in question constitutes commercial speech.

*888 VI. THE BALLYSUCKS.COM CASE

Andrew Faber, an Internet web site developer, operated numerous web sites covering a wide variety of topics. One of these sites, entitled *ballysucks.com*, was dedicated to providing a forum for complaints about Bally Total Fitness health clubs. Bally Total Fitness filed suit claiming trademark infringement, unfair competition and trademark dilution and sought a temporary restraining order that would force Faber to remove his web site from the Internet. [FN101] The court granted defendant's motion for summary judgment.

The court summarily disposed of the plaintiff's trademark infringement claim, holding that "Faber has established that there is no likelihood of confusion as a matter of law." [FN102] According to the court, no consumer would believe that an Internet web site entitled *ballysucks.com* originated from Bally Total Fitness. [FN103]

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Analyzing plaintiff's trademark dilution claim, the court was faced with interpreting the noncommercial use exemption in the FTDA. In reviewing the legislative history of the FTDA, the court found, based on the Hatch Definition, that "this exception encompasses both parodies and consumer product reviews": [FN104]

[T]he courts have held that trademark owners may not quash unauthorized use of the mark by a person expressing a point of view. This is so even if the opinion may come in the form of a commercial setting If the anti-dilution statute were construed as permitting a trademark owner to enjoin the use of his mark in a noncommercial context found to be negative or offensive, then a corporation could shield itself from criticism by forbidding the use of its name in commentaries critical of its conduct. The legitimate aim of the anti-dilution statute is to prohibit the unauthorized use of another's trademark in order to market incompatible products or services. The Constitution does not, however, permit the range of the anti-dilution statute to encompass the unauthorized use of a trademark in a noncommercial setting such as an editorial or artistic context. [FN105]

Holding that Faber's use was noncommercial, the court stated:

***889** Faber is not using the Bally mark to sell his services. Faber is not using Bally's mark to identify his goods in commerce. Faber merely listed the "Bally sucks" site as one of several web sites that he has designed so that those who are interested in his services may view his work. This is akin to an online resume Here, however, Faber is using Bally's mark in the context of a consumer commentary to say that Bally engages in business practices which Faber finds distasteful or unsatisfactory. This is speech protected by the First Amendment. [FN106]

More recently, Lucent Technologies, a major telecommunications equipment manufacturer, filed suit in two separate actions under the Lanham Act and the ACPA for violations connected with use of a web site under the domain name "lucentsucks.com." In *Lucent Technologies, Inc. v. lucentsucks.com*, [FN107] defendant argued that Lucent had failed to satisfy the in rem jurisdiction requirements of the ACPA, and that its use of the domain name was protected by the First Amendment. The court concluded that Lucent in fact failed to satisfy the requirements of the in rem provision of the ACPA. Thus, a ruling on the First Amendment argument was not necessary. In dicta, however, the court acknowledged that "a successful showing that lucentsucks.com is effective parody and/or a cite [sic] for critical commentary would seriously undermine the requisite elements for the causes of action at issue in this case." [FN108]

In a related action, *Lucent Technologies, Inc. v. Johnson*, [FN109] the defendant was alleged to have operated a web site under the domain name lucentsucks.com that offered pornographic photographs and services. The court acknowledged defendant's argument that any domain name ending in the word "sucks" should qualify under a "safe harbor" defense afforded by the First Amendment because it neither attempts to confuse the consumer nor dilute the distinctive nature of the subject mark, but the court refused to reach a decision on the issue at the motion to dismiss stage. [FN110]

***890 VII. THREE VARIATIONS ON BALLYSUCKS.COM**

In order to test the two approaches to defining noncommercial use in the context of the FTDA, it is helpful to pose three hypothetical variations on the facts of the ballysucks.com case. These hypotheticals involve a blend of commercial and communicative activity. [FN111]

A. Variation One--Unrelated Banner Advertising [FN112]

Assume that the ballysucks.com web site contains banner advertising for the Internet book retailer Amazon.com, [FN113] in addition to critical commentary on the Bally Total Fitness health clubs. When the user clicks on the banner advertisement, one is transported to the Amazon.com web site, by means of a hyperlink, [FN114] where one can purchase books, recordings, electronics and a variety of other items. For each purchase made by a user of Faber's web site on Amazon.com as a result of the banner advertisement, Faber receives one percent of the total sale.

B. Variation Two--Competitive Banner Advertising Unrelated to Web Site Owner's Business

Assume that the Ballysucks.com web site contains banner advertising for Gold's Gym, a nationally known competitor of Bally Total Fitness. When the user clicks on the banner advertisement, ***891** one is transported to the Gold's Gym web site, where one can view the facilities and purchase a membership to the health club. For each membership purchased as a result of the banner advertisement on Faber's web site, Faber receives fifty dollars.

C. Variation Three--Competitive Banner Advertising: Related to Web Site Owner's

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Business

Assume that the Ballysucks.com web site contains banner advertising for Faber's Health Clubs, Inc., a competitor of Bally Total Fitness. When the user clicks on the banner advertisement, one is transported to the Faber's Health Clubs web site, where one can view the facilities and purchase a membership to the health club. As president and majority shareholder of Faber's Health Clubs, Faber receives a salary and bonus from Faber's Health Club as well as dividends on his shares of stock in the corporation. The amount that Faber receives in bonuses and dividends is directly dependent upon the profitability of the corporation.

VIII. A PROPOSED TEST FOR HYBRID COMMERCIAL AND COMMUNICATIVE SPEECH AS APPLIED TO THE NONCOMMERCIAL USE EXEMPTION OF THE FEDERAL TRADEMARK DILUTION ACT

Federal courts have inconsistently applied the noncommercial use exemption in the FTDA. In the author's opinion, in order to afford the greatest amount of protection to hybrid communicative and commercial expressions, the two approaches outlined previously, namely the Planned Parenthood multi-factor approach (taking into account the Court's holding in Bolger) and the Hatch Definition, should be combined.

As stated previously, the Hatch Definition appears to prohibit communicative messages that contain even a de minimis commercial component. This standard provides little direction to the federal courts in adjudicating dilution claims because Senator Hatch failed to explain exactly what constitutes a commercial component. [FN115] Similarly, the test outlined in Planned Parenthood gives courts a great deal of discretion to determine whether expression is exempt from the FTDA, thus leaving the judiciary with a vague test to apply to dilution claims.

***892** A better approach would consider all of the factors outlined in Planned Parenthood, as well as the test in Bolger and the legislative history of the FTDA in order to provide the greatest amount of protection to hybrid commercial and communicative speech. The multi-factor test from Planned Parenthood must be read in light of the Court's holding in Bolger, namely that no one factor is dispositive of a finding that certain expression constitutes commercial speech. In addition, the Planned Parenthood multi-factor test must be read in light of the legislative history of the FTDA. When applying the Planned Parenthood test, courts should be cognizant of Congressional intent to exclude various forms of communicative messages from the scope of the FTDA, including parody, satire, and editorial commentary. Finally, the courts should try to effectuate the policies underlying the trademark laws:

The basic policy is to prevent deception of the public. Trademark law also protects the interests of trademark owners in not having the value of their marks misappropriated. Finally, trademark law encourages competition and economic efficiency from which the public benefits. [FN116]

IX. THE PROPOSED COMBINED TEST APPLIED TO THE BALLYSUCKS.COM HYPOTHETICALS

A. Variation One--Unrelated Banner Advertising

Under the author's proposed test, the communicative expression in Variation One would not likely be found to constitute commercial speech and would therefore be exempt under the noncommercial use provision in the dilution statute. In this scenario, Faber is receiving a financial benefit as a result of the revenue generated from the unrelated banner advertisements on his web site which contains critical commentary of Bally's business practices. In addition, the harm caused to Bally's does not directly [FN117] result from the banner advertisements; rather, any alleged harm results from constitutionally protected speech that criticizes Bally's business practices. Amazon.com does not compete with Bally's, and therefore any harm from the banner advertisement itself is negligible. Finally, Faber's intent under this ***893** scenario is no different than his intent in the actual set of facts. Faber is not attempting to confuse the consumers as to the source of his web site. As the court stated, no one would believe that a web site entitled "Ballysucks.com" originates from Bally Total Fitness.

Under the author's proposed test, the policies underlying the federal trademark laws, namely to avoid consumer confusion, and the protections afforded by the First Amendment, outweigh the harm to Bally's in this scenario. Therefore, this type of hybrid commercial and communicative expression would be afforded strict First Amendment protection.

B. Variation Two--Competitive Banner Advertising Unrelated to Web Site Owner's Business

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Under the proposed test, the communicative expression in Variation Two would likely be found to constitute commercial speech and therefore would not be exempt under the noncommercial use provision in the dilution statute. In this instance, Faber is receiving a financial benefit as a result of the banner advertisement on the web site, and the financial benefit is received as a result of a banner advertisement for Gold's Gym that directly harms Bally Total Fitness because Gold's Gym is a direct competitor of Bally Total Fitness. It reasonably could be argued that both Faber and Gold's Gym intend that the critical commentary found on "Ballysucks.com" regarding Bally Total Fitness will entice visitors to become members of Gold's Gym. Therefore, it is clear that Faber intends to cause financial harm to Bally Total Fitness by the communicative expression on his web site.

Finally, the court must weigh the policies underlying the federal trademark laws in addition to the Planned Parenthood factors. While Faber apparently does not intend to confuse consumers into believing that his web site actually originates from Bally Total Fitness, he is using a forum of public commentary to reap financial gain for himself. In this situation, the balance between constitutionally protected speech and the policies underlying the trademark laws seems to favor the plaintiff. Consequently, this type of hybrid commercial and communicative expression should not be protected by the First Amendment.

***894 C. Variation Three--Competitive Banner Advertising Related to Web Site Owner's Business**

Under the proposed test, the communicative expression in Variation Three would be found to constitute commercial speech and therefore not be exempt under the noncommercial use provision in the dilution statute. As in Variation Two, Faber is receiving a financial benefit as a result of the banner advertisement on the web site. Because of his financial interest in Faber's Health Clubs, Faber is in direct competition with Bally Total Fitness, and any Faber's Health Clubs memberships procured as a result of the banner advertisement on the "Ballysucks.com" web site would directly harm Bally Total Fitness. Thus, Faber intends to harm Bally Total Fitness by directly soliciting health club memberships on a web site containing otherwise constitutionally protected public commentary.

As in the previous hypothetical, a persuasive argument can be made that Faber is enticing Internet users who are unhappy with Bally Total Fitness health clubs to visit his site. Once the user has been lured onto the site by the constitutionally protected criticism, Faber transforms the purpose of his site to a commercial endeavor by directly soliciting applications for membership to his competing health club.

In balancing the policies underlying the trademark laws with the protections afforded by the First Amendment, the courts should find that the competitive nature of the site is dispositive that the communicative message constitutes commercial speech and is therefore subject to the FTDA. Under this scenario, the policy of protecting trademark owners from unauthorized use of their trademarks for financial gain outweighs the protections afforded by the First Amendment.

X. CONCLUSION

Supreme Court jurisprudence in the area of the First Amendment protection of commercial speech, although fairly extensive, by no means creates a bright line rule for determining whether certain expression constitutes commercial speech that should be reviewed under the intermediate scrutiny standard. In addition, the various federal circuits have had difficulty deciding whether certain expression subject to claims under the FTDA rises to the level of commercial speech.

The test proposed in this article attempts to balance the protection afforded by the First Amendment against the policies underlying the federal trademark laws as they apply to various *895 forms of communicative expression. Although this proposed test also does not provide a bright line rule for determining whether hybrid commercial and communicative expression should be subject to FTDA liability, it certainly offers the court a full panoply of factors to consider when making such a decision.

[FN1]. Attorney in the firm of Neal & McDevitt, Evanston, Illinois, Associate Member of the International Trademark Association.

[FN1]. *Elrod v. Burns*, 427 US 347, 360 (1976).

[FN2]. See, eg, *Brandenburg v. Ohio*, 395 US 444 (1969) (In reversing a conviction under the Ohio Criminal Syndicalism statute, the Court held that the State may restrict this type of speech only if: (1) it involves an express advocacy of law

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violation; (2) the law violation is imminent; and (3) the imminent law violation is likely to occur. Schwartz, [Holmes versus Hand: Clear and Present Danger or Advocacy of Unlawful Action?](#), 1994 Supreme Court Review 209, 240-41.

[FN3]. See, eg, [Miller v. California](#), 413 US 15 (1973) (the Court adopts criteria for determining whether material is obscene: (a) whether the average person applying contemporary community standards would find that the work, taken as a whole, appeals to prurient interest; (b) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and (c) whether the work, taken as a whole, lacks serious literary, artistic, political or scientific value).

[FN4]. See, eg, [FCC v. Pacifica Foundation](#), 438 US 726, 747 (1978) (the Court held that the FCC may restrict a broadcast by a public radio station of comedian George Carlin's monologue entitled "Filthy Words" in light of the "vulgar, offensive and shocking" nature of the broadcast and the time of day in which it aired); but see [Cohen v. California](#), 403 US 15, 16 (1971) (the Court, citing First Amendment protections, reversed the conviction of defendant for violating a municipal law that prohibited "maliciously and willfully disturb[ing] the peace or quiet of any neighborhood or person ... by ... offensive conduct ...". Defendant was arrested for wearing a jacket bearing the words "Fuck the Draft" in the Los Angeles County Courthouse) and [Reno v. American Civil Liberties Union](#), 521 US 844, 885 (1997) (The Court found unconstitutional various statutory provisions that were intended to protect minors from "indecent" and "patently offensive" communications on the Internet. The Court held that "the interest in encouraging freedom of expression in a democratic society outweighs any theoretical but unproven benefit of censorship.").

[FN5]. See, eg, [Chaplinsky v. New Hampshire](#), 315 US 568, 572 (1942) (the Court defined fighting words as "those which by their very utterance inflict injury or tend to incite an immediate breach of the peace").

[FN6]. See, eg, [Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council](#), 425 US 748 (1976) (holding that some forms of commercial speech may be regulated).

[FN7]. 15 USC § 1125(c).

[FN8]. Thomas E. Anderson, [Aces -- Emerging Intellectual Property Issues in Cyberspace](#), 78 Michigan Bar Journal 1260 (November 1999).

[FN9]. *Ibid.*

[FN10]. See, eg, [Bally Total Fitness Holding Corp. v. Faber](#), 29 F Supp2d 1161, 50 USPQ2d 1840 (CD Calif 1998).

[FN10a]. 15 USC § 1051 et seq.

[FN11]. 15 USC § 1114.

[FN12]. 15 USC § 1125(a).

[FN13]. Senate Report No. 79-1333 at 3 (1946).

[FN14]. *Ibid.*

[FN15]. *Ibid.*

[FN16]. Christopher R. Perry, [Trademarks as Commodities: The "Famous" Roadblock to Applying Trademark Dilution Law in Cyberspace](#), 32 Connecticut Law Review 1127 (Spring 2000).

[FN17]. 141 Cong Rec S19310.

[FN18]. 15 USC § 1127.

[FN19]. 2 Jerome Gilson, [Trademark Protection and Practice](#), §5.12 (2001 Matthew Bender & Company).

[FN20]. Perry, *supra* note 16 (quoting [Mead Data Central Inc. v. Toyota Motor Sales](#), 875 F2d 1026, 1031, 10 USPQ2d 1961,

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1965 (CA 2 1989)).

[FN21]. *Intermatic Inc. v. Toeppen*, 947 F Supp 1227, 1240, 40 USPQ2d 1412, 1423 (ND Ill 1996) (citations omitted).

[FN22]. 15 USC § 1125(c)(1).

[FN23]. 15 USC § 1125(c)(4) (emphasis added).

[FN24]. *Jews for Jesus v. Brodsky*, 993 F Supp 282, 305, 46 USPQ2d 1652, 1670 (D NJ 1998) (citing *Intermatic*, supra note 21 at 1237-38, 40 USPQ2d at 1420-21).

[FN25]. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F2d 26, 1 USPQ2d 1753 (CA 1 1987) (reversing lower court's holding that noncommercial use of a trademark in a parody is subject to Maine's anti-dilution statute).

[FN26]. 141 Cong Rec S19310 (daily ed December 29, 1995) (Orrin Hatch, R- Utah).

[FN27]. See *Valentine v. Chrestensen*, 316 US 52 (1942).

[FN28]. *Ibid.*

[FN29]. 421 US 809 (1975).

[FN30]. *Id* at 822.

[FN31]. *Supra* note 6.

[FN32]. *Id* at 761-62 (citations omitted).

[FN33]. *World Championship Wrestling v. Titan Sports, Inc.*, 46 F Supp2d 118 (D Conn 1999) (citing *Dr. Seuss Enterprises v. Penguin Book USA, Inc.*, 924 F Supp 1559, 1574 (SD Calif 1996), *affd* 109 F3d 1394, 42 USPQ2d 1184 (CA 9 1997)).

[FN34]. *Id* at 123 (citing *Bad Frog Brewery, Inc. v. New York State Liquor Authority*, 134 F3d 87, 97 (CA 2 1998)).

[FN35]. 463 US 60 (1983).

[FN36]. *U.S. Healthcare, Inc., et al. v. Blue Cross of Greater Philadelphia, et al.*, 898 F2d 914 (CA 3 1990).

[FN37]. Geoffrey R. Stone, et al., *The First Amendment* p 170 (Aspen Law & Business, 1999) (citing *First Amendment Protection for Commercial Advertising: The New Constitutional Doctrine*, 44 *University Chicago Law Review* 205, 236 (1976)).

[FN38]. *Central Hudson Gas v. Public Service Commission of New York*, 447 US 557 (1980).

[FN39]. *Morrison & Foerster v. Wick*, 94 F Supp2d 1125, 1135 (D Colo 2000) (citing *Yankee Publishing, Inc. v. News America Publishing, Inc.*, 809 F Supp 267, 275-76, 25 USPQ2d 1752, 1758 (SDNY 1992)).

[FN40]. *Planned Parenthood Federation of America, Inc. v. Bucci*, 42 USPQ2d 1430 (SDNY 1997) (citing *Yankee Publishing, ibid.*).

[FN41]. 141 Cong Rec S19312 (1995) (Patrick Leahy, D-Vt.).

[FN42]. 141 Cong Rec S19306, S19310 (1995) (Carlos Moorehead, R-Calif.).

[FN43]. 141 Cong Rec H14317, 14318 (1995).

[FN44]. Following the Hatch Definition as previously mentioned in supra note 26.

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[FN45]. Supra note 33.

[FN46]. Id at 1574.

[FN47]. Ibid (citing 141 Cong Rec S19310 (noncommercial refers to "parody, satire, editorial and other forms of expression that are not part of a commercial transaction")).

[FN48]. Ibid (citing Virginia State Board, supra note 6 at 762).

[FN49]. Ibid.

[FN50]. 28 F Supp2d 1120 (CD Calif 1998).

[FN51]. Id at 1125 (the song refers to Barbie as a "blond bimbo girl" who loves to party and whose "life is plastic").

[FN52]. Id at 1154 (citing Virginia State Board, supra note 6 at 762).

[FN53]. Id at 1155 (citing HR Rep 104-374).

[FN54]. Ibid.

[FN55]. Id at 1155 fn 55.

[FN56]. Id at 1154 fn 54 (citing Virginia State Board, supra note 6 at 761).

[FN57]. Supra note 33.

[FN58]. Id at 121 (citing Complaint).

[FN59]. Id at 122 (citing Bolger, supra note 35 at 66).

[FN60]. Id at 123 (citing Dr. Seuss, supra note 33 at 1574).

[FN61]. Id at 123 (citing *Rogers v. Grimaldi*, 875 F2d 994, 999 (CA 2 1989)).

[FN62]. Ibid.

[FN63]. 112 F Supp2d 330, 56 USPQ2d 1176 (2000).

[FN64]. Id at 336, 56 USPQ2d at 1181-82. These situations include: expressions used to promote a competing product or service, see, eg, *Harley Davidson, Inc. v. Grottanelli*, 164 F3d 806, 812, 813, 49 USPQ2d 1458, 1463 (CA 2 1999) (noting that while courts "have accorded considerable leeway to parodists whose expressive works aim their parodic commentary at a trademark or a trademarked product, [they] have not hesitated to prevent a manufacturer from using an alleged parody of a competitor's mark to sell a competing product"); *Deere & Co. v. MTD Products*, 41 F3d 39, 45, 32 USPQ2d 1936 (CA 2 1994); and use of trademark material by a political group, see, eg, *United We Stand America, Inc. v. United We Stand America New York, Inc.*, 128 F3d 86, 92, 44 USPQ2d 1351 (CA 2 1997).

[FN65]. Id at 337, 56 USPQ2d at 1182.

[FN66]. Ibid.

[FN67]. Ibid (citing United We Stand, supra note 64 at 93).

[FN68]. Supra note 40.

[FN69]. Id at 1436.

[FN70]. Ibid.

[FN71]. Ibid.

[FN72]. Ibid (citing [Cancer Research Institute, Inc. v. Cancer Research Society, Inc.](#), 694 F Supp 1051, 8 USPQ2d 1243 (SDNY 1988) ("courts have found that fund-raising activities may bring a defendant's actions within the scope of the Lanham Act"))).

[FN73]. Id at 1437.

[FN74]. Ibid (citing [Yankee Publishing](#), supra note 39 at 275, 25 USPQ2d at 1758).

[FN75]. Supra note 24.

[FN76]. Id at 308, 46 USPQ2d at 1673 (citing [Panavision](#) 945 F Supp 1296, 1303, 40 USPQ2d 1908 (CD Calif 1996)).

[FN77]. Supra note 21.

[FN78]. Id at 1229, 1230, 40 USPQ2d at 1413.

[FN79]. See, eg, [deltaairlines.com](#), [eddiebauer.com](#), [ussteel.com](#).

[FN80]. [Intermatic](#), supra note 21 at 1239, 40 USPQ2d at 1422.

[FN81]. Ibid.

[FN82]. Ibid.

[FN83]. Supra note 76.

[FN84]. Id at 1298, 1299, 40 USPQ2d at 1909.

[FN85]. Id at 1303, 40 USPQ2d at 1913.

[FN86]. Id at 1303 fn 5, 40 USPQ2d at 1913.

[FN87]. Id at 1303, 40 USPQ2d at 1913.

[FN88]. Ibid.

[FN89]. Ibid (citing 141 Cong Rec S19310 (noncommercial refers to "parody, satire, editorial and other forms of expression that are not part of a commercial transaction"))).

[FN90]. Ibid.

[FN91]. 86 F Supp2d 176, 54 USPQ2d 1383 (WDNY 2000).

[FN92]. Id at 182, 183, 54 USPQ2d at 1388.

[FN93]. Id at 192, 54 USPQ2d at 1396 (citing [Planned Parenthood](#), supra note 40).

[FN94]. Id at 198, 54 USPQ2d at 1400 (citing [Yankee Publishing](#), supra note 39 at 275, 25 USPQ2d at 1758).

[FN95]. 115 F Supp2d 1108, 56 USPQ2d 1662 (D Minn 2000).

[FN96]. Pub L No 106-113 (1999), 113 Stat 1501 (1999), 15 USC § §1116, 1117, 1125(d) and 1129.

[FN97]. Id at 1123, 56 USPQ2d at 1671.

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[FN98]. See supra note 52 and accompanying text (emphasis added).

[FN99]. Bolger, supra note 35.

[FN100]. Id at 66-68.

[FN101]. Bally, supra note 10.

[FN102]. Id at 1166, 50 USPQ2d at 1844.

[FN103]. Id at 1163-64, 50 USPQ2d at 1842.

[FN104]. Id at 1167, 50 USPQ2d at 1845 (citing *Panavision*, supra note 76 at 1303, 40 USPQ2d at 1913).

[FN105]. Ibid (citations omitted).

[FN106]. Ibid (citations omitted).

[FN107]. 95 F Supp2d 528, 54 USPQ2d 1653 (ED Va 2000).

[FN108]. Id at 536, 54 USPQ2d at 1659.

[FN109]. 56 USPQ2d 1637 (CD Calif 2000).

[FN110]. Id at 1639-40.

[FN111]. The following hypotheticals are solely based on the author's creativity and do not reflect any inference gleaned from the facts of the case.

[FN112]. Banner advertisements are "advertisements that are often active links to Web-sites in which a product or service is advertised." *Digital Equipment Corp. v. Alta Vista Technology, Inc.*, 960 F Supp 456, 460 fn 9 (D Mass 1997).

[FN113]. "Amazon.com, Inc. is an online retailer that serves over 17 million customer accounts in over 150 countries. The Company directly offers for sale millions of distinct items in categories such as books, music, DVDs, videos, toys, electronics, software, video games and home improvement products. Through its marketplace services such as Amazon.com Auctions, zShops and sothebys.amazon.com, the Company has created Web-based marketplaces where buyers and sellers can enter into transactions with respect to a wide range of products. In addition to its US Web site, the Company currently has two internationally focused Web sites located at www.amazon.co.uk and www.amazon.de." Market Guide (2000 multex.com).

[FN114]. A hyperlink is "a link from one site on the Internet to a second site on the Internet. 'Clicking' on a designated space on the initial page which references the subsequent site by a picture, by some highlighted text or by some other indication will take a person viewing the initial web page to a second web page. In addition to their use in indexes, hyperlinks are commonly placed on existing web pages, thus allowing Internet users to move from web page to web page at the click of a button, without having to type in URLs." *Intermatic*, supra note 21 at 1232, 40 USPQ2d at 1415.

[FN115]. There is a serious question as to whether even a de minimis commercial transaction included in the expression removes the expression from First Amendment protection.

[FN116]. *Panavision*, supra note 76 at 1302, 40 USPQ2d at 1912 (citing 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §2.01 (4th ed 1996)).

[FN117]. It could be argued that the revenue from banner advertisements allows Faber to continue to operate his web site, thereby aiding in the harm caused to Bally's.

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