

Fair Use and Freedom of Expression of Trademarks in Instruction, Research, and Publishing

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Abstract:

Copyright isn't the only intellectual property that potentially permits a Fair Use defense for the use of another's intellectual property without permission. Additional Fair Use-related doctrines, including Freedom of Speech, protect lawful use of the trademarks of others in certain instances, as described in this article. Educators, librarians, and their research constituents are often unaware of their Fair Use boundaries related to trademarks; in some instances these educators, librarians, and their constituents rely on expressive use of others' trademarks for projects related to research, commentary, criticism, and other free speech applications. This article reviews what Fair Use-related defenses exist to support educators, librarians, and their constituents (especially students and non-profit professionals) in reducing risks of infringement for expressive uses of trademarks. Trademark topics mentioned include avoiding infringement, dilution, cybersquatting, and unfair competition. The universally acknowledged Fair Use-related defenses for trademarks encompass Classic (Descriptive) Fair Use (codified in the Lanham Act); Nominative (Collateral) Fair Use; Fair Use based upon Copyright Law (Section 107); and First Amendment (Rights of Expression). Although guidelines and safe harbors may be restrictive, Codes of Best Practices for Fair Use related to copyright have been successful for educators, librarians, and other research professionals, such as noncommercial documentary filmmakers. This article suggests that such a Code or guideline for educators and librarians supporting freedom of expression in instruction, research, and publishing related to Fair Use of trademarks is also needed.

Author note: This article is provided for informational purposes only and should not be considered legal advice. Readers should consult with a licensed attorney who specializes in

trademark law for details on their specific trademark-related needs.

Article Introduction:

The Other Fair Use Doctrines (Besides Copyright) For Trademarks

What do Sherlock Holmes, Taylor Swift, and Barbie by Mattel Inc. all have in common? Each of these entities holds federally registered trademarks which have triggered intense discussions about freedom of expression issues related to the rights of both the owners and consumers of each mark (including Fair Use and the First Amendment).

Educators, librarians, students, researchers, and other non-profit professionals are often unaware of their Fair Use boundaries related to the unlicensed use of others' copyrights or trademarks. Fair Use of copyrighted works has been well published and presented for educator and non-commercial application audiences, as a flexible doctrine from Section 107ⁱ of the U.S. Copyright Law in Title 17 of the USC (U.S. Code). Such Fair Use allows limited and legal use of copyrighted works without permission especially for educational and noncommercial scenarios, including free speech and criticism. The Fair Use Statute of the U.S. Copyright Law allows librarians, educators, and their constituents to copy and display limited amounts of the copyrighted works of others, especially for educational or personal uses. Although not impossible, Fair Use applies less often for commercial applications. When considering whether one's use of a copyrighted work is a Fair Use (Section 107), one should ask themselves the following questions:

- a. What is your **PURPOSE** for the copyrighted work? Is it educational or personal? Or is it commercial and for-profit? If it is educational or personal, more than likely it is a Fair Use. This is especially true for educational or personal mash-ups, where the user of a copyrighted work adds value to the use of a work for a purpose different from what the work was originally intended. The courts call this "transformative use," and it often favors Fair Use.
- b. What **AMOUNT** of the copyrighted work is used? The more you copy, the less likely it is permitted as Fair Use. For example, if you copied an entire three-minute popular song to insert into a multimedia slide show, that may not qualify as Fair Use. Using a much smaller portion is more likely Fair Use. However, music that is public domain or licensed for your educational or personal use could be used in full.

c. What is the **NATURE** of the copyrighted work? Is it a factual book, or is it a creative film or music? The more factual the material, the more likely your use is Fair Use. However, the more creative the material is, you may need to use as little as possible to qualify as Fair Use. The use of documentary films is more likely Fair Use than creative blockbuster entertainment movies.

d. What is the **EFFECT** on the market? Does your use of a copyrighted work substitute for what could have been purchased? In other words, does your use discourage others from purchasing an original copy? If you would copy part of someone else's song and then try to make money from your new mash-up on YouTube, this may not be Fair Use.

When making a Fair Use assessment, all four factors listed above must be weighed and balanced. When at least three of the four factors favor Fair Use, it is more likely a justified Fair Use (except when the fourth factor disfavors Fair Use exceedingly, e.g. effect of the use on the commercial marketplace). If only one factor favors Fair Use, permission should be obtained from the copyright holder. When the factors are evenly split, one needs to make a judgment call. Obviously when none of the factors assessed favor one's use, it is not Fair Use.ⁱⁱ

Yet legitimate expressive Fair Uses of trademarks are not so clear as copyright, as there are multiple Fair Use and Freedom Expression exemptions found within the Lanham Act (15 U.S.C. §1051 et seq.) as well as varying and disparate court decisions in recent years. As the *Digital Media Law Project* website affirms, "Neither Congress nor the courts have developed a simple and clear rule that protects your rights to use the trademarks of others for free speech purposes; instead they've developed a complex array of defenses to trademark claims that even lawyers find difficult to untangle."ⁱⁱⁱ In some instances, individuals rely on expressive use of others' trademarks for projects related to research, commentary, criticism, and other free speech applications such as Web blogging. When freedom of expression and trademarks meet, legal conflict often looms. A threat of legal action could become a potential form of censorship. This article reviews what Fair Use and First Amendment defenses exist in the United States to support educators, librarians, students, and other non-profit professionals in reducing risks of infringement for their expressive uses of trademarks. Although guidelines and safe harbors may be restrictive, Codes of Best Practices for Fair Use related to copyright have been supportive of educators and other professionals, such as noncommercial documentary filmmakers and other noncommercial parties. This article will illustrate a few examples of where such a hypothetical Code for educators and

other nonprofit constituents would facilitate freedom of expression in instruction, research, and writing related to Fair Use of trademarks.

A trademark is often a brand name. A trademark or service mark includes any word, name, symbol, device, or any combination (used or intended to be used) to identify and distinguish the goods/services of one seller or provider from those of others, and to indicate the source of the goods/services. The main purpose of a trademark law, such as the Lanham Act in the United States, is to help prevent consumer confusion about the source of the goods or services. Trademark infringement results when a secondary user's use of the trademark creates a likelihood of confusion. On the other hand, one could be sued for trademark dilution for use of another's trademark, in which a lack of consumer confusion would not help. Then an obvious defense could be that there is no likelihood of dilution. A trademark owner may claim dilution by asserting that another's use of its famous mark diminishes the strength or value of the mark by "blurring" the mark's distinctiveness or "tarnishing" the mark's image by associating it to something distasteful or objectionable, even if there is no likelihood of confusion.^{iv} Noncommercial expressive uses are often easier to defend than commercial ones in dilution cases.

Trademarks registered with the U.S. Patent & Trademark Office (USPTO) are marked with an encircled letter "®" while those registered by a state government or common law are marked with a "TM" after the trademarked name or symbol, e.g. Northern Kentucky University's Norse logo (see artwork). The USPTO describes that common law rights may also exist from actual use of a mark.^v Common law allows posting a "TM" symbol without registration, but it is not as secure as registration with a government agency, e.g. federal or state. From an economic standpoint, "a trademark is just a symbol that allows a purchaser to identify goods or services that have been acceptable in the past and reject goods or services that have failed to live up to the desired standards, which will vary from consumer to consumer."^{vi} One may also hear the expression "service mark," or see the tag "SM," which is basically the same. Whereas trademarks apply to products or brands, service marks apply to services by indicating the source. Other types of marks include collective and certification. This article will concentrate more on traditional trademarks registered with federal or state agencies in the United States.



Image source: Northern Kentucky University

Finally, only marks that are distinctive or strong (those that distinguish between competing products or services) function more effectively than marks that are merely descriptive or common. A trademark must be distinctive to be eligible for registration from the USPTO. A descriptive mark will only be protected under trademark law if it attains secondary meaning. It becomes distinctive when consumers link it with specific goods or services.^{vii}

Trademark trolls are looming as they hijack public creative cultural words and images associated with commercial branding. There are cases where trademark trolls abuse their rights. Some Freedom of Speech advocates believe that trademark law has recently evolved in protecting brands rather than preventing consumer confusion.^{viii} Sometimes marks may even be deceptive, which further detracts from possible registration with a government agency.^{ix} Intentional marketplace deception and confusion of products and services is both legally and ethically wrong. This article will focus on the legal creative and expressive uses by educators and other noncommercial users of trademarks and similar publicity-related intellectual properties. Associated federal case laws, law review and trade press literature, and associated web blogs related to the cultural Fair Use aspect of trademarks are referenced.

In the digital information age, there is a tension-of-rights continuum between Freedom of Expression by consumers (customers, educators, critics, etc.) and Intellectual Property owners (businesses, brands, services, etc.). On one side, the First Amendment right to information for freedom of expression is an inherent Constitutional right in the United States, while on the other side information protected by intellectual property has been guarded by monopolies, which some argue, stifle any new creative culture. Law and history scholar Susan Scafidi points out in her book, *Who Owns Culture?*, that if cultural products were, “outside the scope of intellectual property protection,” these works would, “neither

challenge the First Amendment nor limit the availability of their own expressive use.”^x Communications Studies Professor Kembrew McLeod, in his book *Freedom of Expression*, further discusses related situations where corporate culture has pursued silencing artists in fear of financial losses. This act of stifling artists or imposing censorship presents a very pertinent point that social commentary (a vital First Amendment right) is often silenced by intellectual property owners.^{xi} Parody artist Tom Forsythe learned this lesson well when he was sued by the toy manufacturer Mattel® for his photographic depiction of Barbie®™ dolls “jammed” in a kitchen appliance.^{xii} His photographic critique of a branded icon, entitled *Food Chain Barbie*, was a comment on the unrealistic beauty myth of a cultural icon. Forsythe was quoted in McLeod’s book stating, “Intellectual-property lawsuits limit the scope of artistic expression in such a way these days because everything’s branded...If you want to comment on society today, you’re using somebody’s brand if you’re at all in touch with reality.”^{xiii} The artist merely expressed his view on a well-known cultural icon, while the toy manufacturer saw this as an infringement of their copyrights and trademarks. After winning this case, the artist Forsythe affirmed, “We may be free to express ourselves, but if that expression involves offending a rapacious corporation, they’re equally free to sue; and unless we have the wherewithal to fight off high-powered attorneys, that’s where our free speech ends.”^{xiv} Imagine if a similar situation occurred with a student art exhibit at a university and trademark infringements were imposed based on a branded name or logos of a cultural icon. Fair Use may be costly or difficult for a college student or professor to defend.

Another topic for scholars to consider deals with advocating for more academic freedom in terms of their shared Intellectual Properties within their institutions of higher education, e.g. university-industry partnerships such as business “incubators” where intellectual property ownership and rights are questioned by researching faculty. Academics are advocating for more academic freedom in terms of intellectual property. Corynne McSherry, author of *Who Owns Academic Work?* and Intellectual Property Director of the *Electronic Frontier Foundation (EFF)*, reminds us that symbolic information associated with trademarks of university-industry partnerships will become more common, especially in academic scientific works.^{xv} Again, this article is based upon the First Amendment eminence (eminent domain) over a commercial asset viewpoint where there are many legitimate and legal Fair Uses of a trademark, especially in a noncommercial academic setting.

B. Use in Commerce as Threshold to Trademark Rights of Trademark Holder

The Federal Trademark Registration Act of 1946, known as the Lanham Act (or Trademark Act), provides

the contemporary statutory framework for federal examination and registration of trademarks. Section 1127 of the Act currently defines “use in commerce” as: “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”^{xvi} In particular, “ a mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce, and (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.”^{xvii}

The “use in commerce” requirement stems from the fact that the federal government has no constitutional authority to regulate marks that are utilized within a single state border. **The federal government may only regulate goods or services that travel across state or international borders or that involve commerce across these boundaries.** This is rooted in the Trade-Mark Supreme Court Cases 100 U.S. 82 (1879), which were a set of three cases consolidated into a single appeal which ruled that the Copyright Clause^{xviii} of the U.S. Constitution gave Congress no power to regulate trademark. This resulted in the Trade Mark Act of 1881,^{xix} based on the Commerce Clause,^{xx} that was determined to be constitutional.

The U.S. constitution asserted that: “The Congress shall have power...To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries...” from *Article One, Section 8(8) of the U.S. Constitution*, Federal Convention of 1787. Notice that the Constitution does not include anything about branding or trade markings. However, patents and federal trademarks are granted by the USPTO under the U.S. Department of Commerce (an executive branch of the federal government), while copyrights are registered by the Copyright Office at the Library of Congress (a legislative branch of the federal government).

How does “use in commerce” apply to our Fair Use and Freedom of Speech scenarios for research, instruction, and publishing, especially non-commercial speech? Without “use in commerce” tied to the

use of federal trademarked goods and services, there is no trademark infringement per the Lanham Act. The Act further excludes all noncommercial speech and applies to commercial use only. This Lanham Act codified concept, Section 1125, exempting noncommercial speech of trademark infringement, is further supported by the spirit of the First Amendment, otherwise scholarly or consumer criticism, opinion, or parody (excluding defamation) would be ineffectual. More about these topics later.

“Offering services via the Internet has been held to constitute use in commerce, since the services are available to a national and international audience who must use interstate telephone lines to access a website.”— From *TMEP 901.03 Commerce That May Be Lawfully Regulated By Congress*.

C. Identity Rights: Trademark versus Right of Publicity (or Personality Rights)

David L. Lange and H. Jefferson Powell comment on trademark exclusivity versus appropriation where, “the law professes to be concerned chiefly with confusion, but in reality often treats trade identity as though it too is property entitled to exclusivity.”^{xxi} This newer view of trademark protection has created confusion between trademark and rights of publicity. The right of publicity has developed into private censorship of culture where, without permission, it could be an infringement to evoke a cultural image associated with a celebrity.^{xxii}

Jonathan Faber, Law professor and founder of Luminary Group LLL, a licensing agency specializing in personality branding, defines the right of publicity as, “the right to control the commercial use of one’s identity,” or celebrity licensing. Faber believes that freedom of speech liberties related to celebrity licensing have not been suppressed as the “judiciary is very good about safeguarding the First Amendment.”^{xxiii}

On the other hand, Michael Madow, Mass Media Law scholar, suggests that personality as property law in the United States is an uneasy case for publicity rights provide:

...famous persons considerable protection against the unauthorized use of their identities for commercial purposes. Unfair competition laws are an important source of protection, as are the invasion of privacy and defamation torts. However, in many states, an additional instrument of control is the so-called “right of publicity,” which gives a celebrity a legal entitlement to the commercial value of her identity, and thereby enables her to determine the extent, manner, and timing of its commercial exploitation.^{xxiv}

Have rights of publicity gone too far? Madow and other scholars believe that freedom of expression could be challenged when censorship is alleged.

These recent developments have placed right of publicity in the shadows of trademark. Both areas provide rights-holders some measure of control over the meaning of their identities by permitting control of the use of associated symbols. In addition to identity, merchandising of the persona is another challenge for courts.^{xxv} Faber also points out that trademark attributes to prevent unfair competition and its doctrine of misappropriation also promote similarities.^{xxvi} Ironically, a mistaken identity issue related to these two types of rights has developed.

Perhaps these rights of publicity by way of celebrity licensing have evolved into the concept of celebrities as brands. For example, Gene Simmons of the 1970s rock group KISS has affirmed that “KISS is a brand, not a band.” At business lectures, he supports that individuals potentially are their own brand.^{xxvii} Other celebrities follow this idea as they request trademark registration of their own identity name, e.g. Paul McCartney and Taylor Swift. However applying for a trademark solely to guard others from using your trademark is not enough. A trademark registration must be supported by the “actual use in commerce.” In some instances, estates of dead celebrities are able to obtain a trademark of the deceased name because of their right of publicity.

A right of publicity guards the market value of one’s persona or identity and allows an entity to keep others from unfairly appropriating this worth for their commercial gain. Protection includes:

(1) Section 43(a) of the Lanham Act, which holds that unauthorized use of an aspect of one’s persona, or use of a persona feature confusingly similar to a feature of one’s persona, on or in connection with any goods or services can constitute a false designation of origin, false or misleading description of fact, or false or misleading representation of fact;(2) State laws, extending protection to living and deceased persons; and (3) Common law, which differs state by state but generally holds that use of a person’s identity for the “purposes of trade” without that person’s consent constitutes unfair competition.^{xxviii}

Yet parody in some cases may be exempt from the Lanham Act as covered later in this article.

Characters from copyrighted literary works that have fallen into the public domain, such as Tarzan and Sherlock Holmes, may be protected by trademark. Even photographs of authors of such recent public

domain works might have right of publicity issues unless the subject died more than 100 years ago.¹

Right of publicity prohibits unauthorized commercial use of a person's name, image, likeness, signature, and voice, particularly with commercial products, and as used in advertising goods or services.

Noncommercial entertainment, informational, or editorial uses are not protected by right of publicity and could be utilized for newer copyrighted works and associated subjects and their right of publicity.

For more about right of publicity related to celebrities, see the following websites:

http://www.mediainstitute.org/ONLINE/FAM2002/Media_H.html

AND <http://rightofpublicity.com/brief-history-of-rop>.

D. Infringement Types Defendable as Fair Use or Freedom of Expression

To understand which expressive uses by educators or nonprofit professionals are lawful, we must be familiar with most types of infringement defenses with trademarks.

1. Fair Use (Defense)

According to trademark-education.com: "Fair use or nominative use can only be used when the use of the trademark does not imply affiliation or sponsorship with the owner's product or services, and will not confuse the reader into thinking the owner of the mark has something to do with the use."^{xxix} For example, a computer repair shop advertises that they specialize in repair of Apple[®] computers displaying the Apple[®] brand logo although they are not an authorized Apple[®] retailer.

- a. A defendant asserting the Classic (or Descriptive) Fair Use affirmative defense under the Lanham Act need only prove their use of the plaintiff's mark not as a mark, but rather as a Fair Use and good faith description of the characteristics of a good or service."^{xxx} This type of Fair Use often occurs when the user utilizes a competitor's weaker descriptive trademark that employs a common, everyday word or phrase. For example, company A brand named *Makeup Express* sells makeup and describes its cosmetic colors in marketing materials as a "beautiful rainbow of colors," while company B is named *Beautiful Rainbow* cosmetics which is also its trademark registered name. Company B sues company A for infringement of its registered trademark *Beautiful Rainbow*. Company A defends itself by claiming classic Fair Use whereby it is only using a common term as a good faith description of the color characteristics of its goods. Now does it make sense why a common descriptive mark is not as strong as a distinctive one?

¹ There is no single federal right of publicity law, so it varies from state to state. Indiana's publicity statute is the strongest--up to 100 years, while as of 2012 over a dozen states have no right of publicity law. So it is safe to assume that anyone who died over 100 years ago is not covered by any right of publicity.

- b. Nominative (or Collateral) Fair Use (where descriptive use of a trademarked term is virtually unavoidable). For example, when a drug manufacturer compares its product brand X to competitor brand Z, it must use the competitor's name to demonstrate the point of its advertisement. A test for nominative use basically states that one party may use or refer to the trademark of another if:
 - (1) the product or service cannot be readily identified without using the trademark (i.e. trademark is descriptive of a person, place, or attribute); (2) only so much of the mark is used as necessary for the identification (i.e. the words but not the specific font or logo); and (3) the user does nothing to suggest sponsorship or endorsement by the trademark holder—which applies even if the nominative use is commercial.^{xxxii}
- c. Fair Use based on Copyright Law (Section 107) and the four factors test as covered earlier in the beginning of this article.
- d. Noncommercial Use (defenses include trademark infringement or trademark dilution)

One of the best illustrations of noncommercial use was with the Strategic Defense Initiative by President Reagan in the 1980s, borrowing the name *Star Wars* from the trademarked name of the popular commercial movie. Lucasfilm Ltd. (trademark owner) was denied an injunction against the use of the name as an expression for the Strategic Defense Initiative. The classic (descriptive) fair use doctrine in trademark law applied as the owner of the trademark could not prevent its use to describe such a noncommercial government program.^{xxxiii}

2. First Amendment (Rights of Expression)

- a. Parody – In 2008 a trademark infringement suit by plaintiff *E.S.S. Entertainment 2000*, doing business as the *Play Pen*, (a “gentlemen’s club” in Los Angeles), was filed against the video game *Grand Theft Auto*. It was judged as a First Amendment victory for the defendant, video game producer Rock Star Videos. Gamers navigating the “East Los Santos” virtual vicinity could visit a strip club called the “Pig Pen,” which was similar to the plaintiff’s establishment. The court acknowledged that the game used attributes of the *Play Pen* to support its parody image of urban Los Angeles. The court accepted the defendant’s First Amendment argument. However the plaintiff claimed that the video game infringed its trademark associated with their real club. They presented evidence and testimony which questioned with validity the likelihood of confusion. Although parody triumphed here, likelihood of

confusion in future product placement in movies, video games, and other media should be carefully reviewed, especially in commercial scenarios.^{xxxiii}

As demonstrated in the case example above, parodies of trademarks are becoming more common than parody of copyrighted materials. The three types of parody associated with trademark are differentiated below.

- i. Comparative advertising – As discussed earlier, a business could legally use a competitor’s mark or brand as necessary to fairly and accurately describe its products or services or to compare to those of its competitor. This is often used in commercial applications such as advertising for comparing an over-the-counter pharmaceutical product A to product B, whereby visual images of the brands are put side by side. However, another comparative advertising example was judged as an infringement despite its parody humor in *Deere & Co. v. MTD Products*. Both companies marketed riding lawn mowers. MTD Products distributed an advertisement where the John Deere trademarked deer symbol runs in fear from MTD’s “Yard-Man” riding mower and a dog barking. Although clever, the court ruled it was not parody since it was being utilized to sell a product rather than to offer social commentary or entertainment. Further, the court held that the parody infringed Deere’s right to prevent the dilution of its mark.^{xxxiv} What do you believe? Many experts continue to debate this judgment. Can you think of examples where a nonprofit library, college, or social service might use the trademark of either a commercial or another nonprofit organization in comparative advertising or publicity?
- ii. Confusion of services – In 2005, the U.S. Supreme Court ruled Fair Use defense could be made in certain instances when the use resulted in consumer confusion.^{xxxv} This is more likely when a weak, non-distinctive ordinary mark is utilized, e.g. descriptive. McDaniel College, a private, nonprofit college in Maryland, has a unique brand image McLive! on its website as of 2012. Imagine if McDonald’s restaurant lawyers approach McDaniel College with a cease and desist order. Does McDonald’s have a valid case here? Often a surname for a business is considered a weak descriptive trademark and rarely granted federal registration.

iii. Trademark Dilution (blurring or tarnishment) – Parody or Satire are often exempt of dilution because they are considered noncommercial. First Amendment as well as the Trademark Dilution Revision Act of 2006 protects parodies that are noncommercial or not used to market goods or services commercially. However, when parody is used in commercial applications with federally registered marks, then such a parody must abide by federal dilution law. Our example of the John Deere case above further demonstrates this point.^{xxxvi}

b. Freedom of Speech

i. Trademark cybersquatting (also known as domain squatting) is where an unaffiliated party registers, sells, or uses an Internet domain name with the intent (in most situations) of profiting from the good will of another's trademark.^{xxxvii} The Lanham Act provides civil remedies for such bad faith actions.^{xxxviii} For one such scenario, Freedom of Speech was the motive rather than an economic, commercial intention. The case was *Lamparello v. Falwell* 420 F.3d 309 (4th Cir., 2005). The dispute focused on the domain name fallwell.com. Christopher Lamparello produced a website to counter and criticize the anti-homosexual statements of popular yet controversial Christian televangelist Reverend Jerry Falwell. Lamparello's website domain spelling varied with an additional letter "L" as fallwell.com. Falwell felt that confusion was created by the similarity between Lamparello's Web domain name and Falwell's name, domain name, and other trademarks. Falwell tried to legally stop Lamparello from using the trademark "fallwell" and transfer the misspelled domain name to Falwell. The original decisions decided in favor of Falwell, conceding Falwell's claims of federal trademark infringement, false designation of origin, unfair competition, and cybersquatting. On appeal in 2005, the court overturned the earlier decisions, determining that there was not a "likelihood of confusion," and that there was no trademark infringement based on "initial interest confusion." Lamparello's site was non-commercial, and the Court ruled there was no "bad faith intent to profit." Further, it was not considered cybersquatting.^{xxxix}



Image source: <http://www.flickr.com/photos/consumerist/2086657436/>

Another example of freedom of speech applied to the use of a trademark is illustrated by the following case. A customer sued Best Buy for losing her laptop and displayed an original mash up (shown above) on a grievance blog using the Best Buy logo. She struck out “best” and inserted the word “worst.” The customer was disgruntled, as she claimed identity theft had occurred due to the negligence of Best Buy. The lawsuit was ultimately dismissed in 2008.^{xi}

- ii. Can you think of any academic or school examples where Freedom of Speech might be violated for expressive uses in teaching or learning? Ponder this thought, as we propose a Best Practice guideline for noncommercial use by constituents of educators and librarians to follow to avoid infringement.
3. In all cases where a secondary user of trademark relies on either Fair Use or Freedom of Speech, the user of the trademark should include a prominent disclaimer on their published medium to make clear their work is not “official” or associated with the trademark. However, this is not a guaranteed protection, as one’s use must be defended as either Fair Use or Freedom of Speech. As noted earlier, one should consult with a licensed attorney who specializes in trademark law for details on their specific trademark-related needs.

E. Code of Best Practices for Fair Use of Trademarks (e.g. Safe Harbors)

Should there be a Code of Best Practices for Fair Use of Trademarks? Codes for Fair Use of copyrighted works have been published by the Center for Media and Social Impact^{xii} and utilized for some time with great success. Yet there is a lack of awareness related to this topic for trademarks, as confusion exists between various types of intellectual properties with educators and professionals at non-profit organizations. The Code of Best Practices in Fair Use for OpenCourseWare spotlights a common

confusion between copyright and trademark. In this instance, OpenCourseWare creators reflect their concerns about displaying corporate brand names and logos in their work. The Code clarifies that in most cases, “re-use of commercial identifiers is not regulated by copyright law. Instead, trademark law applies—and it teaches that educational uses of trademarks and trade names simply are not actionable where such uses do not mislead or confuse consumers about the source of a good or service, and do not constitute libel or product disparagement. So there is no need to ‘blur’ out brand names images or substitute generic designations (ibuprofen for Motrin) in text.”^{xlii}

Here is an example of why such a Code could be helpful for educators and library constituents:

A student wants to lampoon a popular television series on printed t-shirts to sell as a fundraising activity for her campus choral group. The parody is related to a popular television series about a hip, cool glee club. How do they spoof the iconic series and yet remain within a Fair Use safe harbor for both copyright and trademark? Should they consult with the school’s legal counsel? Most likely they must apply an established court “conjuring up” test and ask themselves if the parody expression conjures up as little as possible to achieve its comedic effect without being superfluous. See David Bollier’s *Brand Name Bullies: The Quest to Own and Control Culture*, (Hoboken, New Jersey, 2005), pages 98-99, for more related to parody and commercial art in such scenarios.^{xliii}

Other real world Trademark Fair Use scenarios for educational applications could include:

- A. College electronic-media class mini-documentary for a commercial & cultural signs museum consisting of trademark branded images included in film posted on public view website of a museum.
- B. University grant science project where commercial trademark name or image of chemical or commodity must be listed in scientific report and project website.
- C. Library archive and special collection scenarios related to a patron’s research and publishing of content with trademark names or images. The patron intends to post content on a noncommercial website and/or in a nonprofit organization’s published book.
- D. Student class assignment blog or thesis about hip-hop music and when permission might be needed for use of trademark related names and logos of music artists.

E. Trademark parody of names or characters in education and non-profit organizations: A history instructor parodies popular trademarked name of *Discovery Channel* history series for an online course title. A public library parodies popular trademarked name of network television game show for its patron program related to educating musicians about the music business. To go a step further, how about avatars of famous celebrity or trademarked characters in online learning scenario activities?

F. Business entrepreneur student scenarios where another's trademark is associated with their research and/or new business development. For example, an informatics student designs a new app for smart phones. Beyond copyrights and patents, what trademark considerations should the student be aware of, e.g. app icons or images utilized in the program? What about mobile device apps and computer desktop icons related to trademark versus copyright of thumbnail images for non-profits vs. small businesses?

G. Literature professor writes annotated scholarly study about trademarked characters from both public domain and contemporary works, e.g. Sherlock Holmes. Even some of the public domain works contain characters that are currently registered as trademarks. Some characters are from graphic novels which hold multiple trademarks. How will the professor determine how much discussion of the trademarked characters is Fair Use to cover without permission?

H. Non-profit Library Friends or Museum Gift Shop dealing with trademark and/or publicity rights of fundraising merchandise based on special exhibit collections. For example, a trademarked image in their collection printed on coffee mugs for a fundraising sale at the Library. What about the same trademark/publicity rights related to similar works utilized within virtual web exhibit?

A Code of Best Practices listing safe harbor guidelines would strengthen and support the expressive uses by educators, librarians, and other nonprofit professionals of others' trademarks within legal boundaries that support Fair Use and First Amendment rights to communicate ideas and information for both the pedagogical needs of students, information or free speech rights, and the greater good of our society at large.

The Future of Fair Use and Freedom of Speech with Trademarks

What can be done to strengthen the awareness of expressive Fair Use and Free Speech of trademarks? Patent & Trademark Resource Centers (PTRCs) and other libraries and information-related organizations could offer outreach and support to researcher and creative communities by offering instruction on how to remain legal with Fair Use of copyrights and trademarks. This complements the patent and trademark searching-instruction of PTRCs. Such libraries could also offer awareness of public domain and open source shared resources, such as the Creative Commons and Project Gutenberg. Licensing and contracts related to publishing by constituents of educators and librarians are common instruction activities by Scholarly Communication Specialists and Librarians. Libraries are also well suited to provide factual information and programs featuring guest speakers like local intellectual property lawyers or scholars. Some academic libraries could even call on their law school instructors or students specializing in intellectual property. Customers trust libraries to offer reliable information for both sides of a debate (such as the Fair Use of trademarks) by including information and programs that also support businesses and artists as intellectual property creators and owners.

ⁱ U.S. Copyright Office, Fair Use, <http://www.copyright.gov/fls/fl102.html> (accessed March 6, 2015).

ⁱⁱ Cornell University, Copyright Information Center, Checklist for Conducting a Fair Use Analysis Before Using Copyrighted Materials, http://copyright.cornell.edu/policies/docs/Fair_Use_Checklist.pdf; and Kenneth Crews, Columbia University Libraries, Copyright Advisory Office, Fair Use Checklist, <http://copyright.columbia.edu/copyright/fair-use/fair-use-checklist/> (both accessed March 6, 2015).

ⁱⁱⁱ Digital Media Law Project, Using the Trademarks of Others, <http://www.dmlp.org/print/1542> (accessed March 3, 2015).

^{iv} U.S. Patent & Trademark Office, About Trademark Infringement, <http://www.uspto.gov/page/about-trademark-infringement> (accessed March 5, 2015).

^v U.S. Patent & Trademark Office, Trademark FAQs, <http://www.uspto.gov/learning-and-resources/trademark-faqs> (accessed March 5, 2015).

^{vi} New York State Science & Technology Law Center at Syracuse University College of Law, Law Resources, Law Library, Trademarks, Basics, http://nysstlc.syr.edu/Law_Resources/Law_Library/Trademark/TrademarkLawFunds/TrademarkLawFunds.aspx (accessed March 25, 2012).

^{vii} Stim, Richard, Patent, *Copyright & Trademark: An Intellectual Property Desk Reference*, (Berkeley, CA: Nolo, 2009), pages 396; 401.

^{viii} Middle Tennessee State University, Taylor Swift Archives – John Seigenthaler, Catching in on Catch Phrases: The Cost of Free Speech by Ken Paulson, <http://mtpress.mtsu.edu/seigenthaler/tag/taylor-swift/> (accessed March 3, 2015).

^{ix} For more on Deceptive Matter -- See 15 USC § 1052 (e) (1) & TMEP 1203.02(b).

^x Scafidi, Susan, *Who Owns Culture?: Appropriation and Authenticity in American Law*, (New Brunswick, New Jersey: Rutgers, 2005), page 138.

^{xi} McLeod, Kembrew, *Freedom of Expression®: Overzealous Copyright Bozos and Other Enemies of Creativity*, (New York: Doubleday, 2005).

^{xii} *Mattel v. Walking Mountain Productions*, 353 F.3d 792 (2003)

^{xiii} *Ibid*, 144

^{xiv} Bollier, David, *Brand Name Bullies: The Quest to Own and Control Culture*, (Hoboken, New Jersey: Wiley, 2005), page 93.

^{xv} McSherry, Corynne, *Who Owns Academic Work?: Battling for Control of Intellectual Property*, (Cambridge, Massachusetts: Harvard University Press, 2001), pages 2-3; 16.

^{xvi} 15 U.S.C. § 1127

^{xvii} *Ibid*

^{xviii} United States Constitution, Article I, Section 8 empowers the United States Congress: To promote the Progress of Science and useful Arts, be securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

^{xix} Act of Mar. 3, 1881, ch. 138, 21 Stat. 502

^{xx} United States Constitution, Article I, Section 8, Clause 3 states that the United States Congress shall have power: To regulate Commerce with foreign Nations, and among the several States...

^{xxi} Lange, David and H. Jefferson Powell, *No Law: Intellectual Property in the Image of an Absolute First Amendment*, (Stanford, California: Stanford Law Books, 2009), page 65.

^{xxii} Bollier, David, *Brand Name Bullies: The Quest to Own and Control Culture*, (Hoboken, New Jersey, 2005), pages 131-33.

^{xxiii} Faber, Jonathan, "Celebrity Licensing and the Right of Publicity: Navigating New Frontiers of Opportunity and Liability," *Licensing Journal*, September 2012.

^{xxiv} Madow, Michael, "Personality as Property: The Uneasy case for Publicity Rights," in *Intellectual Property and Information Wealth: Issues and Practices in the Digital Age*, Volume 3: Trademark and Unfair Competition, edited by Peter K. Yu, (Westport, Connecticut: Praeger, 2007), page 345.

^{xxv} Dogan, Stacey L. and Mark A. Lemley, "What the Right of Publicity Can Learn from Trademark Law," *Stanford Law Review*, Vol. 58, No. 4 (Feb., 2006), pp. 1161-1220.

^{xxvi} Faber, Jonathan, "Indiana: A Celebrity-Friendly Jurisdiction," *RES GESTAE (Journal of the Indiana State Bar Association)*, Vol. 43, No. 9 (March 2000).

^{xxvii} Faber, Jonathan, "Celebrity Licensing and the Right of Publicity: Navigating New Frontiers of Opportunity and Liability," *Licensing Journal*, September 2012.

^{xxviii} Robert D. Litowitz, “Trademark Basics. The Rights of Publicity,” *IP Strategist*, May/June 1995, obtain page range, volume, issue, etc.

^{xxix} Trademark Education & Information, What is Trademark Fair Use? – Fair Use & Nominative Use Lanham Act, <http://www.trademark-education.com/fairuse.html> (accessed 30 November 2012).

^{xxx} 15 U.S.C. §1115(b)(4).

^{xxxi} *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302 (9th Cir. 1992); *Playboy Enterprises, Inc. V. Welles*, 279 F.3d 796 (9th Cir. 2002).

^{xxxii} *Lucasfilm Ltd. V. High Frontier*, 227 USPQ 967 (D.D.C. 1985).

^{xxxiii} *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 2008 WL 4791705 (9th Cir. 2008).

^{xxxiv} *Deere & Co. v. MTD Products* 41 F.3d 39 (2d Cir. 1994)

^{xxxv} See *Coca-Cola Co. v. Gemini Rising, Inc.* 346 F. Supp. 1183, 1189 (E.D.N.Y. 1972); *Hormel Foods Corp. v. Jim Henson Productions, Inc.* 73 F. 3d 497 (2d Cir. 1996); and J. Thomas McCarthy, *McCarthy on Trademark and Unfair Competition* § 24: 104, 24:105 (4th ed. 2002).

^{xxxvi} See *Pink Panther* case regarding a gay group parody name association; *Jordache Enterprises, Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987); *L.L. Bean, Inc. v. Drake Publishers, Inc.* 811 F.2d 26, 30-31 (1st Cir. 1987).

^{xxxvii} Nolo, Cybersquatting: What It Is and What Can Be Done About It, <http://www.nolo.com/legal-encyclopedia/cybersquatting-what-what-can-be-29778.html> (accessed 1 March 2015).

^{xxxviii} U.S. Patent & Trademark Office, Report to Congress: The Anticybersquatting Consumer Protection Act of 1999, section 3006 concerning the abusive registration of domain names, <http://www.uspto.gov/web/offices/dcom/olia/tmcybpiracy/repcongress.pdf>, (accessed 1 March 2015).

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^{xlii} *Code of Best Practices in Fair Use for OpenCourseWare*, Committee of Practitioners of OpenCourseWare in the United States, Center for Social Media, 2009.

^{xliii} Bollier, David, *Brand Name Bullies: The Quest to Own and Control Culture*, (Hoboken, New Jersey, 2005), pages 98-99.