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“I’m Litigatin’ It”: Infringement, Dilution, and Parody Under the Lanham Act

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**“I’m Litigatin’ It”: Infringement, Dilution, and
Parody Under the Lanham Act**

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“I’m Litigatin’ It”: Infringement, Dilution, and Parody Under the Lanham Act

By Patrick Emerson*

I. INTRODUCTION

¶1 Outside of the trademark registration process, the federal Lanham Act provides two causes of action, infringement and dilution, to holders of protectable trademarks to exclude others from using their marks.¹ Both of these actions can be defeated by the defense of parody, which is a subset of the defense of “fair use.” For actions against dilution of protectable marks, Congress formally codified the parody defense for the first time in the Trademark Dilution Revision Act (“TDRA,” 2006) amendments to the Lanham Act.²

¶2 This Comment argues that codification has done little to strengthen protection of trademark parody in the courts. Parody should be a strong bar to recovery, particularly in dilution actions in which the plaintiff is not required to prove confusion. I argue that the existing body of law in this area suggests courts tend to be moralistic and unpredictable in their interpretation of the parody defense. Finally, I suggest that the protection of parodies should be decided based on the question of whether a parody meets a stringent definition, not on whether the parody is more or less “commercial.” Focusing on the commercial dimension has negative consequences for freedom of consumption. Focusing instead on the definition of the parody protects consumer freedom, while effectively preventing free riding.

¶3 This Comment has a broad reach and seeks primarily to make a policy argument. I proceed by critically analyzing case law and the reasoning behind groups of decisions. I do not argue that any individual case should have been decided differently, but rather that courts’ approach to the parody defense should be reconsidered, as if necessary should the law. In Section II, I address the basic policy rationales behind infringement and dilution. In Section III, I address the portions of the Lanham Act defining infringement and dilution. In Section IV, I address the parody defense as it has been applied in the context of the Lanham Act and in similar state statutes.³ In Section V, I discuss the public policy arguments for refocusing judicial inquiry regarding the parody defense more towards the definition of a parody and away from the degree of commercialization, particularly when a defendant raises the parody defense against a dilution action.

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¹ Lanham Act, 15 U.S.C. §§ 1051–1141n (2009). (Subsequent statutory citations are all to this Act, and are divided by the Act’s internal section numbers.)

² § 43(c)(3)(A)(ii).

³ Although this Comment focuses on the Lanham Act, I also discuss case law applying dilution and infringement actions at state law, where the cases serve to illustrate trends in the law and judicial behavior.

II. PUBLIC POLICY RATIONALES, INFRINGEMENT, AND DILUTION

¶4 A central distinction between dilution and infringement actions, both in federal trademark law and also in state equivalents, concerns the public policy underlying the actions. Dilution and infringement have been designed to protect two different groups. Primarily, the infringement action serves to protect consumers.⁴ Infringement is an action brought by a holder of a trademark; success in court provides immediate and obvious advantages for a producer of goods. However, consumers as a group are the stakeholders of greatest public policy concern.

¶5 For example, when I buy a “Big Mac” I (a consumer) expect to receive a product made by McDonald’s (a producer), with all of the associated ingredients and standards of quality in production. The public utility of the infringement cause of action inheres principally in the fact that I will not be bewildered into purchasing some interloping fast food item also called a “Big Mac,” or “Big Ma C”. Likewise, public utility derives from, for example, the protection of trade dress from infringement. Consumers are protected in the trade dress context from the confusion of entering a restaurant that looks exactly like a McDonald’s, but which is in fact a vegan diner. In short, producers are permitted by law to seek a remedy for infringement at least in part because of the goodwill, or even mere consumer recognition, attached to their product.

¶6 By contrast, the dilution action works principally for producers’ advantage.⁵ The dilution action does not directly pay dividends to consumers. Rather, the dilution action protects trademarks from other producers. It does so even where there is no appreciable risk that a consumer would mistake the origin of the product associated with the trademark.⁶ In fact dilution, which as with infringement is historically established in state law as well as federal, protects producers even where the defendant is not in direct competition with a plaintiff producer. For example, through this action, one court found that the Georgia anti-dilution statute prohibited the production of sexualized images featuring Milky Way’s trademarks “Poppin’ Fresh” and “Poppie Fresh.”⁷ This was not because of concern that consumers could be confused into thinking that the images were a product of Milky Way or because of Milky Way’s opportunity cost in not producing the images itself. Rather, the court ruled that indirect association with the images “tarnished” Milky Way’s marks.

¶7 Tarnishment is one of two subsets of dilution now codified under the TDRA, along with “blurring.” The full scope of the dilution action is discussed below. The salient point for the purposes of public policy, however, is that marks such as Milky Way’s are protected as if the exclusivity of the marks’ financial worth to one producer has inherent value—as if public policy demanded that no one else should benefit financially from the mark, even in a manner that the producer itself would never have considered. From a public policy point of view, protection did not attach to Milky Way’s marks, as with infringement, because of the public utility of avoiding consumer confusion. It attached out of private convenience to Milky Way. Granted, Milky Way might not have filed suit

⁴ Corina I. Cacovean, *Is Free Riding Aided by Parody to Sneak Between the Cracks of the Trademark Dilution Revision Act?*, 31 HASTINGS COMM. & ENT. L.J. 441, 444 (2009).

⁵ *Id.*

⁶ § 43(c)(1).

⁷ *Pillsbury Co. v. Milky Way Prods.*, No. C78-679A, 1981 U.S. Dist. LEXIS 17722 (N.D. Ga. Dec. 24, 1981).

under a dilution theory (or won), against a more quotidian use of its trademark—for example, “Milky Way Airlines.” However, this is only to say that there may be a corpus of uses of “Milky Way” that is immune to dilution suits because it is less offensive and thus less tarnishing. Whether under a tarnishment or a blurring theory of dilution, unconfused consumers are still deprived of the universe of uses that is not immune from dilution. As far as cartoon pornography is concerned, that is perhaps not much of a loss to consumers. However, as I will discuss, the reach of dilution is broader than the extreme example of *Milky Way* illustrates.

III. THE LANHAM ACT

A. *Infringement*

¶8 The Lanham Act prohibits anyone, without prior consent from the trademark registrant, from using in commerce any “reproduction, counterfeit, copy or colorable imitation of a registered mark in connection with the sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion . . . mistake, or to deceive.”⁸ It further prohibits reproduction, counterfeiting, copying, or imitating marks for reproduction in labels, signs, prints, packages, and so on, provided they are intended to be used in commerce in connection with sales, distribution, or advertising, and provided there is a likelihood of confusion.⁹

¶9 In order to prove infringement against a third party under the Lanham Act a plaintiff needs to show that: (i) it owns a valid and protectable mark; (ii) the defendant has used a reproduction, counterfeit, copy or imitation of the mark in some kind of commerce without the plaintiff’s consent; and (iii) the defendant’s action is likely to cause confusion.

¶10 In keeping with the value ascribed to protecting potentially confused consumers, the courts have afforded wide latitude to what could constitute confusion. Confusion, broadly speaking, includes cases where consumers may not be confused as to the origin of the goods, but may be confused as to whether the non-mark-holding producer is in some way connected to the primary mark-holder.¹⁰

¶11 The breadth of interpretation afforded to confusion has implications for the parody defense. For example, in *Anheuser-Busch, Inc. v. Balducci Publications*, the Eighth Circuit ruled that a magazine’s parody advertisement for Michelob beer, declaring “Michelob Oily,” could confuse consumers.¹¹ Specifically, consumers could think that the satire was in some way “connected” or affiliated to the producer of the beer (even while not being confused into thinking that Michelob itself produced the parody).¹² The court endorsed a broad interpretation of confusion:

Many courts have applied, we believe correctly, an expansive interpretation of likelihood of confusion, extending “protection against use of [plaintiff’s] mark on any product or service which would reasonably be thought by the buying public

⁸ § 32(1)(a).

⁹ § 32(1)(b).

¹⁰ See *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 774 (8th Cir. 1994).

¹¹ *Id.*

¹² *Id.* at 769.

to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner.”¹³

B. Dilution

¶12 Notwithstanding the broad interpretation of confusion that courts have been willing to apply, as illustrated by *Anheuser-Busch*, the fact that confusion is required to sustain an infringement action at all is a distinction between infringement and dilution actions. This distinction is key in the context of the parody defense. As confusion is not required in dilution actions, trademark holders can sustain actions against parody: (i) even where consumers *get the joke*, and (ii) where consumers are neither confused as to the origin of the parody, nor confused into thinking that the parody producer is affiliated with the mark holder. As such, dilution implicitly prioritizes the value of the mark over the value of the joke, social commentary, satire, and so on that is contained in the parody. Moreover, it prioritizes the “good name” of the mark over the comprehension of consumers that what they are viewing is not in fact a product of the mark holder, but is instead a joke.

¶13 Although dilution is a recently codified addition to the Lanham Act, it is not a particularly recent doctrine. Dilution has roots in European law, dating back to at least the nineteenth century.¹⁴ In 1927, Frank Schechter made the notion prominent on this side of the Atlantic when he wrote the seminal *The Rational Basis of Trademark Protection* for Harvard Law Review.¹⁵ Schechter’s central thesis was that trademarks, by 1927, no longer represented merely the source of origin for goods, with their value being drawn from the consumer’s identification of the producer. Rather, he argued that trademarks had become independent drivers of custom, detached from consumer recognition of the producer.¹⁶ Schechter argued that consumers had come to identify goods by the trademarks themselves, without regard for or knowledge of, the producer. His idea foreshadows modern mass production and byzantine corporate structures, which are clearly beyond the understanding of most consumers.¹⁷ Thus, Schechter’s article introduced the idea that trademarks have inherent value—that they are beacons for consumers in a foggy consumerist world.

¶14 Further, Schechter concluded that “[t]rademark pirates are growing more subtle and refined. They proceed circumspectly, by suggestion and approximation, rather than by direct and exact duplication of their victims’ wares and marks.”¹⁸ So the “pirates” threatened the inherent value of marks; the time had come to take some buccaneers to the gallows (or at least to federal court).

¶15 Reviewing possible solutions to the guile of the modern trademark pirate, Schechter advocated something akin to the dilution doctrine, although without using the exact term. Schechter discussed contemporary European cases involving well-known brands, such as Rolls-Royce, Kodak, and Vogue, where non-competing producers

¹³ *Id.* at 774.

¹⁴ See DAVID S. WELKOWITZ, TRADEMARK DILUTION: FEDERAL, STATE AND INTERNATIONAL LAW 336 (2002).

¹⁵ Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927).

¹⁶ *Id.* at 814–19.

¹⁷ *Id.* at 814–16.

¹⁸ *Id.* at 825.

appropriated their trademarks (for example producing Kodak bathtubs).¹⁹ Outlining a rationale for finding in favor of the primary user in these cases, Schechter defined what we now call dilution as “the *whittling away* or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competing goods.”²⁰ Schechter supported providing greater protection for such brands, provided that the trademarks were arbitrary or fanciful. He argued:

[T]here is not a single one of these fanciful marks which will not, if used on different classes of goods, or to advertise different services, gradually but surely lose its effectiveness and unique distinctiveness If “Kodak” may be used for bath tubs and cakes, “Mazda” for cameras and shoes, or “Ritz-Carlton” for coffee, these marks must inevitably be lost in the commonplace words of the language, despite the originality and ingenuity in their contrivance, and the vast expenditures in advertising them.²¹

Schechter’s whittling away definition remains relevant today. The Lanham Act provides that, subject to the principles of equity:

[T]he owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment . . . regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.²²

This is a codified response to Schechter’s whittling away problem. No confusion is required, likewise no “actual economic injury.” Just as Kodak could not have proved that it lost out on bathtub profits—or probably even that it lost goodwill when people slipped and fell while bathing in a “Kodak” tub—so modern producers need not prove measurable injury to their bottom lines. Holders are entitled to protect the “unique distinctiveness” of their marks without a greater showing of injury or, as in an infringement action, consumer confusion.

1. Blurring

¶16 Although the examples discussed so far pertain to the idea of dilution by tarnishment, blurring is also a version of dilution under the Lanham Act. The language of the Act explains that blurring “impairs the distinctiveness” of the mark (whereas tarnishment “harms the reputation” of the mark).²³ Blurring thus remains close to Schechter’s idea of whittling away identity.

¶17 The underlying reasoning for disallowing blurring is that: (i) the mark is valuable because it has a particular association in the public mind (i.e. “distinctiveness” in the

¹⁹ *Id.* at 825, 831.

²⁰ *Id.* at 825 (emphasis added).

²¹ *Id.* at 830.

²² § 43(c)(1).

²³ § 43(c)(2)(B)–(C).

language of the Lanham Act or “unique distinctiveness” in Schechter’s terms), and (ii) that anything reducing the popular association in turn damages the mark.

2. Tarnishment

¶18 Although now actionable under the Lanham Act, tarnishment was not always available as a federal cause of action and is a relatively recent development in trademark law. In the landmark case, *Moseley v. Victoria's Secret Catalogue, Inc.*, the Supreme Court suggested, in dicta, that dilution by tarnishment would not be enforceable under the then-Federal Trademark Dilution Act (“FTDA,” 1999), unless actual economic harm could be shown.²⁴ The case concerned a store selling adult products, which was initially called “Victor’s Secret,” and then, after threat of legal action, “Victor’s Little Secret.” (The change proved insufficient to forestall legal action by Victoria’s Secret.) Justice Stevens, writing for the majority, cited Schechter’s article extensively and tried to be faithful to Schechter’s understanding of dilution.²⁵

¶19 However, the Supreme Court handed down *Moseley* in 2003. In 2006, the TDRA marked a significant and deliberate shift away from *Moseley*.²⁶ Incorporated into the Lanham Act, the TDRA expressly provides that both blurring and tarnishment are actionable at federal law.²⁷ The TDRA also removed the requirement of actual economic injury under either theory.

¶20 Unlike blurring, tarnishment clearly goes beyond Schechter’s definition. Rather than relying on a preexisting association between the mark and popular consciousness, which could be subject to blurring, tarnishment expands the ambit of dilution to include the creation of alternative, new associations. Specifically, it addresses new associations that are negative and could harm the reputation of the mark if left unchecked. *Milky Way*, discussed above, serves as a paradigm example of tarnishment—a family-friendly product acquired new, unwanted associations with sex.²⁸

C. Standards Applied in Dilution Actions

¶21 Courts assessing tarnishment and blurring are directed by the Lanham Act to apply different standards. However, both actions require that the mark at issue is “famous.”²⁹ A mark is famous for the purposes of the Lanham Act if “it is widely recognized by the general consuming public as a designation of source of the goods or services of the mark’s owner.”³⁰ The Act provides four factors to assess famousness: (i) the duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised

²⁴ *Moseley v. Victoria’s Secret Catalogue, Inc.*, 537 U.S. 418, 432 (2003).

²⁵ *Id.* at 429.

²⁶ § 43(c).

²⁷ § 43(c)(1).

²⁸ An alternative way of expressing this would be that *Milky Way*’s preexisting reputation for “wholesome fun” (or whatever the opposite of sex is) was damaged by association with sexualized images. This would make the rationale for tarnishment the same as for blurring—i.e., the damaging of a *preexisting* association. However, it is clear that at least some courts have been willing to find for the plaintiff in tarnishment cases on the basis of a wholly new association, without consideration of existing associations. The action leaves open this option.

²⁹ § 43(c)(1).

³⁰ § 43(c)(2)(A).

or publicized by the owner or third parties; (ii) the amount, volume, and geographic extent of sales of goods or services offered under the mark; (iii) the extent of actual recognition of the mark; and (iv) whether the mark was registered.³¹ Both actions also require, in another development under the TDRA, a finding of only likely rather than actual dilution (the latter had been the standard under the FTDA).³² Thus, dilution demands neither a showing of actual economic injury nor actual dilution.

¶22 The Lanham Act provides six factors that courts may consider in blurring suits, subject to relevance: (i) the degree of similarity between the mark or trade name and the famous mark; (ii) the degree of inherent or acquired distinctiveness of the famous mark; (iii) the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark; (iv) the degree of recognition of the famous mark; (v) whether the user of the mark or trade name intended to create an association with the famous mark; and (vi) any actual association between the mark or trade name and the famous mark.³³

¶23 The full definition of dilution by tarnishment is “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”³⁴ Lynda Oswald has noted that this definition is typically met in one of three possible scenarios, which also serve to illustrate some of the wide range of factors applied by courts in tarnishment cases. The first scenario arises when “a plaintiff’s trademark is linked to products of a shoddy quality, or is portrayed in an unwholesome or unsavory context likely to evoke unflattering thoughts about the owner’s product.”³⁵ The second arises when the reproduction and the original are almost identical. The third arises when “alterations of a mark are made by a competitor with both an incentive to diminish the favorable attributes of the mark and ample opportunity to promote its products in ways that make no significant alteration.”³⁶

¶24 Additionally, some commentators have posited the possibility that “free riding” should be regarded as a de facto third version of the dilution action, in addition to blurring and tarnishment.³⁷ Without considering whether free riding is a freestanding theory of dilution (or whether it should be), as I discuss below, it is a significant public policy concern underlying dilution.

IV. THE PARODY DEFENSE, WHOLESOMENESS, TORTIOUSNESS, AND INTENT

¶25 To understand what parody means in the context of trademark law, it is informative to begin with a general definition of the term “parody.” A widely cited and serviceable definition is that, in order to be successful, a parody must: (i) “convey two simultaneous—and contradictory—messages: that it is the original, but also that it is not

³¹ § 43(c)(2)(A)(i)–(iv).

³² § 43(c)(2)(B).

³³ § 43(c)(2)(B)(i)–(vi).

³⁴ § 43(c)(2)(C).

³⁵ Lynda J. Oswald, “*Tarnishment*” and “*Blurring*” Under the Federal Trademark Dilution Act of 1995, 36 AM. BUS. L.J. 255, 277 (1999).

³⁶ *Id.*

³⁷ See Cacovean, *supra* note 4, at 453–54.

the original and is instead a parody;” and (ii) “communicate some articulable element of satire, ridicule, joking, or amusement.”³⁸

¶26 One commentator has noted that, for the first requirement of this definition, “the line between mimicry and deviation” is tough to traverse.³⁹ If a parody doesn’t go *far enough* in distinguishing itself from the original product, then it risks being a source of confusion rather than parody, and would thus be vulnerable under an infringement action. On the other hand, if the parody goes *too far* then it risks becoming just a joke, without parodic content.

¶27 Within the context of dilution, the parody defense is codified in the Lanham Act under the fair use exception, which states that “identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner” is excluded from coverage by dilution.⁴⁰ Initially this reads like an all-encompassing protection for parodies. However, the defense is not available for parodies that are primarily commercial, which is defined as “a designation of source for the person’s own goods.”⁴¹

¶28 In practice, a further consideration as to whether a parody defense will be upheld is the distinction between a “wholesome” and “unwholesome” parody. One illustration of this distinction is *Jordache Enterprises, Inc. v. Hogg Wyld, Ltd.*⁴² Addressing an action under New Mexico’s trademark act, the case overtly employs the notion of wholesomeness. The court found that Jordache Jeans, using a horse’s head logo, were not diluted by defendant’s “Lardashe” jeans for large size women (the defendant’s jeans featured a pig logo). Addressing the plaintiff’s tarnishment argument, the court reasoned that an “undesirable, unwholesome, or unsavory mental association” had not been sufficiently created by the parody because it was not “particularly unwholesome,” although potentially “in poor taste” to some consumers.⁴³

¶29 Similarly, in *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. B.E. Windows Corp.*, the court addressed a motion for a preliminary injunction based on the theory that the defendant’s slogan “The Best Bar on Earth” tarnished, by association with alcohol, “The Best Show on Earth”—Ringling’s circus slogan.⁴⁴ The court denied the injunction on the grounds of the plaintiff’s failure to prove likelihood of success on the merits.⁴⁵ The court noted that the circus already played in some venues serving alcohol, and thus that an association with alcohol was neither new nor tarnishing.⁴⁶

¶30 By contrast, in *Milky Way* the court found injunctive relief appropriate where the defendant depicted plaintiff’s “Poppin’ Fresh” and “Poppie Fresh” characters in sexualized images.⁴⁷ Similarly, in *American Express Co. v. Vibra Approved*

³⁸ See, e.g., *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260 (4th Cir. 2007).

³⁹ See Laura E. Little, *Regulating Funny: Humor and the Law*, 94 CORNELL L. REV. 1235, 1265 (2009).

⁴⁰ § 43(c)(3)(A)–(A)(ii).

⁴¹ § 43(c)(3)(A).

⁴² *Jordache Enters. v. Hogg Wyld, Ltd.*, 625 F. Supp. 48 (D. N.M. 1985).

⁴³ *Id.* at 57.

⁴⁴ *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. B.E. Windows Corp.*, 937 F. Supp. 204 (S.D.N.Y. 1996).

⁴⁵ *Id.* at 211.

⁴⁶ *Id.*

⁴⁷ See *supra* Part II.

Laboratories, the court found for the plaintiff under New York anti-dilution law, in a motion for preliminary injunction against the defendant's condom carrying-case. The carrying-case was emblazoned with a bust of a gladiator and the words "America Express" and "Don't Leave Home Without It."⁴⁸

¶31 All of these tarnishment cases support the observation that courts are influenced by the perceived wholesomeness of the parody at issue, although—as discussed further below, and already illustrated by *Ringling Bros.*—the plaintiff's prior reputation for wholesomeness is sometimes relevant too. The relevance of the distinction between wholesome and unwholesome parodies is particularly evident for actions in which tarnishment is alleged. As we have seen, tarnishment exists to prevent lessening the "commercial magnetism" or "magic" of the mark by the creation of new associations.⁴⁹ As common sense suggests, an action brought under this theory will be more credible where the new and supposedly negative association is not with puppies and sunshine, but rather with something "distasteful or off-putting" (unless perhaps the distinctive quality of the original product is that it is distasteful or off-putting).⁵⁰

¶32 Courts applying tarnishment theories are thus more likely to attach liability where the parody alludes to something risqué, offensive, or crude. However, the outcome may also be influenced by the mode of humor employed. Laura Little observes that, although not expressly recognizing this reasoning, courts are sometimes more likely to permit an ostensibly unwholesome parody where it involves "release humor"⁵¹ because release humor serves a social function. Release humor involves making light of something in such a way as to induce catharsis. "Incongruity humor," by contrast, is more akin to being just a joke—and is less likely to find sympathy in court. As implied by the name, incongruity humor simply means placing something where it would not normally be found (for example, in the non-parody realm, a frog drinking Budweiser).

¶33 The wholesomeness of the parody seems as if it ought not to be relevant in the context of *infringement* actions. The inquiry in this context, after all, is whether consumers are likely to be confused. There is no obvious reason why confusion would turn on whether or not the parody is obscene. Nevertheless, some infringement cases also evidence the willingness of courts to favor plaintiffs whose marks are linked by the defendant to prurient material. In *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, for example (cited in *Jordache Enterprises* as an example of a case illustrating a "particularly unwholesome" parody), the court held that a pornographic film featuring actresses in Dallas Cowboys cheerleader outfits was "sexually depraved," and factored this consideration into its finding that the Cowboys's marks had been infringed.⁵² Similarly, Coke was successful in obtaining a preliminary injunction against a supposed parody, "Enjoy Cocaine."⁵³ The court in this case held that this attempted parody failed, because it did not go far enough in distinguishing itself from the original to

⁴⁸ *Am. Express Co. v. Vibra Approved Labs. Co.*, No. 87 Civ. 8840 (CSH), 1989 U.S. Dist. LEXIS 4377 (S.D.N.Y. Apr. 19, 1989).

⁴⁹ ROGER E. SCHECHTER & JOHN R. THOMAS, *INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS*, § 30.6, at 719 (2003).

⁵⁰ *Id.*

⁵¹ See Little, *supra* note 39, at 1267–68.

⁵² *Jordache Enters. v. Hogg Wyld, Ltd.*, 625 F. Supp. 48, 57 (D. N.M. 1985); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205 (2d Cir. 1979).

⁵³ *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1187 (E.D.N.Y. 1972).

avoid a high likelihood of confusion.⁵⁴ For no apparent reason, given the nature of the action, the court also noted in support of its holding:

Judicial notice may be taken that cocaine is a narcotic drug possession of which for nonmedical purposes is a felonious criminal offense against the laws of the United States punishable by substantial prison terms and fines. . . . The stringency of those laws reflects the national concern that cocaine—far from being “enjoyable”—is part of the tragic drug problem currently afflicting this nation, and particularly its youth. To associate such a noxious substance as cocaine with plaintiff’s wholesome beverage as symbolized by its “Coca-Cola” trademark and format would clearly have a tendency to impugn that product and injure plaintiff’s business reputation.⁵⁵

On the other hand, there are more recent infringement cases that evidence a reversal of the trend in *Pussycat Cinema* and *Coca-Cola*. In *Burnett v. Twentieth Century Fox Film Co.* the court made the obvious point that “the more distasteful and bizarre the parody, the less likely the public is to mistakenly think that the trademark owner has sponsored or approved it.”⁵⁶ The court thus drew on the basic notion of confusion in infringement suits, avoiding the somewhat moralistic detour of the *Pussycat Cinema* and *Coca-Cola* decisions.

¶34 Some have argued that an emphasis on perceived wholesomeness causes tarnishment to operate like an intentional tort.⁵⁷ Just as defamation of a person requires injury to reputation, so tarnishment requires injury to the reputation of a mark. One way of viewing these cases is that the defendant cannot tarnish a reputation that is already tarnished in the same manner. A further way of looking at these cases, not previously considered, would be to say that the wholesomeness of the parody operates in a way analogous to the defense of “truth” in defamation. It is true to say that “The Best Bar on Earth” is no less wholesome than an alcohol-serving circus—a true statement is thus implied in the parody of the circus. Therefore, no new injurious association could be created. By contrast, it is not true to say that American Express is already tarnished with sexual innuendo; therefore, the parody fails for want of an element of truth, and an injurious association could be created. This accords with common sense. A sketch depicting, for example, Mother Teresa as uncharitable and mean would not be a “parody”—there is no grain of truth to the depiction. It would merely be a slur or, in the legal vernacular, a tarnishment. Parody requires a kernel of truth, or at least believability, to avoid dilution.

¶35 A final consideration regarding whether courts are likely to find that a parody defense is successful is the issue of intent. Joseph Dreitler argues that courts consider intent when deciding whether a parody is valid, both for infringement and dilution actions.⁵⁸ Specifically, Dreitler argues that courts ask whether the defendant intended to parody or to profit. However, Dreitler’s account is inaccurate. *All* infringement claims

⁵⁴ *Id.* at 1190.

⁵⁵ *Id.* at 1189.

⁵⁶ *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962, 972 (C.D. Cal. 2007).

⁵⁷ See Oswald, *supra* note 35, at 274.

⁵⁸ Joseph R. Dreitler, *Comment: The Tiger Woods Case—Has the Sixth Circuit Abandoned Trademark Law?* ETW Corp. v. Jireh Publishing, Inc., 38 AKRON L. REV. 337, 341 (2005).

require use in commerce, and all infringement claims require some kind of reproduction of a protected mark. Assuming that these things do not happen by accident, intent to profit would *always* be satisfied. The issue, as framed in the Lanham Act, is not whether the defendant intended to profit, but whether the defendant intended primarily to profit. Citing *Wendy's International, Inc. v. Big Bite, Inc.*, Dreitler claims the court found that the defendant's use of Wendy's trademarks in "Little Wendy" in its own advertising campaigns could not constitute a valid parody because the use of the marks was plainly an intentional ploy to free ride off the mark.⁵⁹ However, Dreitler overstates the conclusiveness of the holding. The court held that "where it is shown that the alleged infringer used the movant's mark knowingly and with the intention of deriving some benefit from it, a *strong inference* of probable confusion arises"⁶⁰ A strong inference is not a categorical intent rule. Nevertheless, the strong inference may still form part of a range of tools used by a court in assessing a parody-defense case. It is simply that framing the issue solely as one of "intent to profit" is misleading. As the next section discusses, the "commercial" dimension of speech is relevant to the parody defense, but it is not always dispositive—nor should it be.

V. PARODY AND PUBLIC POLICY

¶36 In this section, I argue that parody ought to be a stronger bar to relief. Particularly, I argue that that parody should be a strong bar to recovery in dilution actions, even those where the alleged parody is commercially motivated.

A. *Parody, the First Amendment, and Commercial Use*

A defendant generally asserts a parody defense to establish that consumers would not likely confuse the protected product with the challenged product or communication. This argument may have force beyond simply negating an element of the plaintiff's claim, however, because of the solicitude accorded to parody under First Amendment case law.⁶¹

There is a sliding scale of protection for parodies, predicated not merely on an assessment of wholesomeness, tortiousness, or intent, but also on the perceived political or apolitical content of the parody.⁶² The scale derives from First Amendment jurisprudence. Courts afford political and cultural parodies a higher level of protection than commercial parodies. For example, in *Smith v. Wal-Mart Stores, Inc.* a district court in Georgia held that Smith's products (T-shirts and other novelty products) accusing Wal-Mart of, inter alia, "Walocaust," and of being "Wal-Qaeda," were analogous to sandwich-boards historically worn by protestors, and were noncommercial, political speech subject to First Amendment protection (even though Mr. Smith sold his creations).⁶³ The court addressed the protection the First Amendment affords to parody and concluded that

⁵⁹ *Id.* at 342 (citing *Wendy's Int'l, Inc. v. Big Bite, Inc.* 576 F. Supp. 816 (S.D. Ohio 1983)).

⁶⁰ *Wendy's*, 576 F. Supp. at 822 (emphasis added).

⁶¹ Little, *supra* note 39, at 1263–64.

⁶² David H. Bernstein & Thomas H. Prochnow, *Defense to Infringement—When the First Amendment Protects Trademark Parodies*, 4 INTELL. PROP. STRATEGIST 1 (1998).

⁶³ *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1340 (N.D. Ga. 2008).

“tarnishment caused merely by an editorial or artistic parody which satirizes [the complainant’s] product or its image is not actionable under an anti-dilution statute because of the free speech protections of the First Amendment.”⁶⁴

¶37

Similarly, in *Mattel, Inc. v. MCA Records, Inc.*, the Ninth Circuit held that cultural content is afforded protection in parodies, although the defendant had been selling its parody. Specifically, the court concluded that the “Barbie” doll is a cultural as well as a commercial symbol, and that Barbie could be a necessary component of artistic expression not merely a commercial symbol.⁶⁵ The case addressed a song called “Barbie Girl,” by the band Aqua, which the manufacturer of Barbie (Mattel) claimed diluted its Barbie marks because of lyrics such as: “Life in plastic, it’s fantastic. You can brush my hair, undress me everywhere.”⁶⁶ Mattel filed suit against the band’s record company, MCA Records. Addressing the dilution claim, the court held for the defendant, noting:

[T]he song also lampoons the Barbie image and comments humorously on the cultural values Aqua claims she represents. Use of the Barbie mark in the song Barbie Girl therefore falls within the noncommercial use exemption to the FTDA. For precisely the same reasons, use of the mark in the song’s title is also exempted.⁶⁷

By contrast, a district court in Massachusetts held in *General Electric Co. v. Alumpa Coal Co.* that “Genital Electric” products, although seemingly similar to the equally doubtful “Walocaust” pun, were without protection because there was a “great probability of confusion among the general public.”⁶⁸ In this case, unlike *Mattel* and *Wal-Mart*, the court did not consider a First Amendment issue relevant, because the message was intended for a primarily commercial purpose—i.e., to *sell* the joke, rather than to *make* the joke.

¶38

The First Amendment should, however, always be relevant in parody-defense cases, and courts should not be quick to deny protection to parodies on the grounds that a parody is “primarily commercial”—if that requirement should remain in the Lanham Act at all. The history of the First Amendment evidences a longstanding concern to protect parody, even where there is a commercial *component* to propagating the parody. As the court in *Wal-Mart* in fact recognized, the correct question is not whether speech is commercial or not, but whether it is commercial to such an extent as to overwhelm the underlying parody.⁶⁹ As I discuss below, it is virtually unimaginable, particularly in dilution actions, that commercial purpose ever overwhelms the parody, *provided the parody is genuine*. Courts should begin by looking at whether the defendant has a genuine parody, not whether the parody is primarily commercial.

⁶⁴ *Id.* at 1339 (quoting *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 812 (9th Cir. 2003)).

⁶⁵ *Mattel, Inc. v. MCA Records, Inc.* 296 F.3d 894, 906–07 (9th Cir. 2002).

⁶⁶ *Id.* at 901 (quoting AQUA, BARBIE GIRL (MCA Records 1997)).

⁶⁷ *Id.* at 907.

⁶⁸ *Gen. Elec. Co. v. Alumpa Coal Co.*, No. 79-1815, 1979 U.S. Dist. LEXIS 9197, at *4 (D. Mass. Oct. 12, 1979).

⁶⁹ *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1340 (N.D. Ga. 2008).

B. Commercial Use and Free Riding

¶39 Contrary to the prevailing trend in First Amendment jurisprudence, some commentators argue that the reluctance of courts to find First Amendment protection for parodies that are primarily commercial *does not go far enough* in preventing the use of the parody defense, and that parodies effectively provide a shield for free-riding.

¶40 Corina Cacovean argues that, as a matter of policy, the law should diligently prevent free riding under the guise of parody.⁷⁰ Cacovean notes that one possible approach to the commercial parody question is a subjective test looking at whether the defendant intended to exploit the existing mark commercially. However, Cacovean concludes that, without an objective test, courts lack guidance.⁷¹

¶41 According to Cacovean, an objective test would have changed the outcome in an often cited case, *Louis Vuitton Malletier v. Haute Diggity Dog*. In this case, the Fourth Circuit ruled for the defendant, holding that “Chewy Vuiton” dog toys were valid parodies, despite the strong commercial impetus behind the parody.⁷²

¶42 Cacovean suggests a *commercial gains* test as an objective alternative to what she sees as the more subjective approach of the Fourth Circuit and other courts. Cacovean’s test would reject the parody defense under either type of trademark action, either where the parody led directly to the sale of goods or where *any* commercial gain ensued to the defendant. Cacovean argues such a test would be in keeping with the general public interest in preventing free riding. Cacovean notes two possible models for such a test.

¶43 First, Cacovean notes, “in South America, famous marks benefit from higher protection than that allowed to Louis Vuitton in United States.”⁷³ She goes on to note that the Brazilian Patents and Trademarks Office recognizes a set of “highly renowned” trademarks which are, because of their “economic attractiveness,” afforded a higher level of protection.⁷⁴ This group includes marks such as McDonald’s, Visa, and Hollywood. Cacovean goes on to note, “[i]n a large majority of cases the Special Commission [afforded] . . . special protection in all classes of goods and service.”⁷⁵

¶44 Second, under European law, “protection for famous marks in the European Union is more flexible.”⁷⁶ Cacovean cites two cases from the European Court of Justice (“ECJ”), *Davidoff & Cie S.A. v. Gofkid Ltd.* and *Adidas-Salomon AG v. Fitnessworld Trading Ltd.*, where the court held that “the anti-dilution law is an overarching legal remedy applicable to any and all situations, whether the goods and services are competitive, similar, or non-similar.”⁷⁷ Cacovean concludes that “[t]he ECJ interpretation reflects a tendency for a [sic] more flexible protection.”⁷⁸

⁷⁰ Cacovean, *supra* note 4, at 443.

⁷¹ *Id.* at 457.

⁷² *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007).

⁷³ Cacovean, *supra* note 4, at 456.

⁷⁴ *Id.*

⁷⁵ *Id.* at 456 (quoting Ana Lucia de Sousa Borda, *Highly Renowned Marks—Criteria Adopted by the BPTO for Their Recognition*, 11 DANNEMANN SIEMSEN NEWS, Dec. 2005, available at http://www.dannemann.com.br/files/dsnews_200512_en.pdf).

⁷⁶ *Id.* at 455.

⁷⁷ *Id.*

⁷⁸ *Id.*

¶45 However, as we have seen, Cacovean’s strict “any commercial gains” test would not comport with the First Amendment. Cases such as *Wal-Mart* and *Mattel* show that the First Amendment affords at least some protection to parodies, even where the parodies lead to commercial gain.

¶46 On other hand, parodies are not protected where they are primarily commercial. This leaves parodies in a gray area when they are associated with products for sale, but are arguably not primarily a commercial endeavor. Balancing a Cacovean-like position with the other pole—i.e. absolute permissiveness—we need to ask, not just what is best for trademark holders, but also what is best for consumers?

C. Parody and Consumer Freedom

¶47 A rigid prohibition on profiting from parodies of trademarks would not be a policy favorable to the majority of consumers. The general disadvantage for consumers can be illustrated by a “literary” reference.

¶48 In the comedy movie, *Coming to America*, Eddie Murphy plays an African Prince named Akeem, who “comes to America” seeking a wife who will accept him for his personality, rather than his nobility. He takes a position at “McDowell’s,” a restaurant with all of the hallmarks of a McDonald’s, including big golden arches, and a specialty burger, the “Big Mick.”⁷⁹

¶49 In the real world, the name of Prince Akeem’s employer would probably amount to infringement of McDonald’s trademarks. Indeed, the restaurant in the movie is “under investigation” by McDonald’s. Nevertheless, despite the many aspects of *Coming to America* that require suspension of disbelief, the fact that McDowell’s consumers do not appear to be “confused” by the McDonald’s-esque diner is *not* one of them. It is wholly credible that consumers would recognize the distinction between McDonald’s and this comically bad imitation.

¶50 This speaks to a broader point about the acute perceptions and distinguishing capabilities of actual consumers, who are often divorced from: (i) the rarified discussion of doctrine, and (ii) the focus on the parties to lawsuits (typically two commercial producers). One commentator argues that a problem with infringement actions is that, the confusion requirement notwithstanding, they actually fail to protect the vast majority of consumers who have the common sense not to be confused.⁸⁰ Michael Grynberg notes, in one case:

The specificity of the harm of confusion to a survey-defined group of buyers easily trumped the harms to the nonconfused who were never considered as a distinct class. The defendants stood alone; the court considered only their interest in the plaintiff’s marks, not the interests of the public for whom the defendants were a proxy.⁸¹

The public policy of protecting consumers from confusion is not well served by finding producers liable for parodies in situations where the parodies at issue simply would not

⁷⁹ *COMING TO AMERICA* (Paramount Pictures 1988).

⁸⁰ Michael Grynberg, *Trademark Litigation as Consumer Conflict*, 83 N.Y.U. L. REV. 60 (2008).

⁸¹ *Id.* at 99.

confuse the silent majority of consumers (even if the parody confused some consumers in a sample group used as trial evidence). Similarly, Little makes the point that “consumers understand that it would be incongruous for the profit-maximizing producer of a protected product to undercut the product.”⁸²

Grynberg’s position is persuasive. However, it is open to attack on the grounds that it relies on prioritizing one public benefit (free consumption) over another (not confusing less sophisticated consumers) without much justification.⁸³ Furthermore, while Grynberg might be right that existing law errs in privileging the prevention of confusion over free consumption, his seems like an argument for making confusion harder to prove. Grynberg thus misses the bigger point. The strongest case to be made for protecting consumers against the over-sensitive and litigious natures of producers is not in infringement actions, but in dilution actions. Dilution actions are in no way underpinned by an interest in directly protecting consumers. Dilution does not overlook unconfused consumers, instead it avoids consideration of consumer interests altogether. Dilution exists to prevent rival producers from making famous brands look bad or less distinctive, while at the same time profiting from the denigration of the famous brand. As such, dilution actions fit perfectly into the problematic mold of *Producer X v. Producer Y* litigation, because consumer benefits are at best an unintended consequence of the litigation.

¶51 There are at least two reasons why protecting famous trademarks from dilution, even dilution via a parody that is itself commercialized, is a dubious position. The first reason for thinking that famous trademarks do not require protection from dilution recalls the rationale in *Twentieth Century Fox*—namely, that “unwholesome” parodies can in fact be the least problematic of parodies. The court in that case stated, “the more distasteful and bizarre the parody, the less likely the public is to mistakenly think that the trademark owner has sponsored or approved it.”⁸⁴ Turning that logic on its head, we can say that the *less* distasteful and bizarre the *trademark*, the more likely it is that a *parody* will seem innocuous. In other words, famous brands (by definition not distasteful to many consumers) do not need protection to sustain their “magic.” Famous trademarks are those *least* in danger of being diluted, because they already command mass public recognition and approval. This follows, provided that consumers are not actually confused into thinking that what they are looking at—i.e. a parody—is genuinely a product of the original producer. This eventuality, however, would be actionable under infringement.

¶52 Again, a common sense check is sufficient to demonstrate the reasonableness of this position. For example, consider *Vibra Approved Laboratories*. Why would someone *actually* be less likely to open an American Express account because they had witnessed a condom case with a similar logo, when they *knew* the case had nothing to do with the real American Express?

¶53 The second reason for thinking that famous brands do not require protection from negative associations is purely functional. Conventional free-market economics theory

⁸² Little, *supra* note 39, at 1263.

⁸³ In addition, Grynberg it fails to account for the role of trademark protection in incentivizing innovation, albeit that this argument is weaker in a trademark context—where no creative content or ideas are involved—than in other areas of intellectual property.

⁸⁴ *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962, 972 (C.D. Cal. 2007).

dictates that famous marks are famous because of the quality of the underlying product. To be sure, marketing also plays a role in selling goods. However, it is to be expected that consumers will eventually shun shoddy products no matter how well they are marketed, in favor of a superior product. It follows that if famous brands represent genuinely superior products they will continue to succeed because of their quality, irrespective of dilution of their marks. If American Express genuinely has the best deals on credit cards, then being associated with condom carrying cases should not matter. On the other hand, if the benefits of being an American Express member were merely smoke-and-mirrors, easily shattered by a cheap joke, then the product deserves to fail.

¶154 As I have presented it, the second point is a little simplistic. It is true that a good parody could affect the sales even of a superior product, for example by making ownership of it simply embarrassing. However, the reality is that dilution *already fails to protect against this risk*. There is no obvious reason for thinking that purely commercialized parodies are more likely to be successful at creating embarrassment than, say, a sketch on “Saturday Night Live” or a viral video online, both of which would likely be protected as artistic content.

¶155 In practice, it is apparent that what dilution serves to protect is an elite group of famous brands—the very group whose trademarks are least in need of protection. It should not be surprising that, as one commentator notes, “Federal dilution has become a luxury claim.”⁸⁵ As Schechter effectively showed, dilution laws are a product of the bygone and paternalistic protection of elite, luxury European brands. Under the Lanham Act, ironically, trademarks are not really protected against dilution, which is still possible under non-commercial guises. Instead, famous marks are protected against valid but commercial enterprises, which are doing little more than profiting from the public preference for mocking power. This runs contrary to free competition, and contrary to the interests of a public capable of being discerning—capable of getting the joke.

D. Parody First, Commercialization Second

¶156 The foregoing analysis notwithstanding, I do not mean to suggest that the dilution action should be completely removed, as it has some clear virtues. Indeed, even in the context of parody, there are obvious reasons why a multinational fast food company, for example Burger King, should be prevented from producing a product called, “McDonald’s Death Nuggets.” Very little public function is served by insults made by obviously self-interested parties—even if those insults might look like parodies to some observers.

¶157 However, the definition of a successful parody is already sufficiently narrow to avoid this risk. Courts should not be concerned, primarily, with whether the creator of a parody also profits and to what extent. The definition of a genuine parody should be the first consideration of any court addressing the parody defense. This approach—parody first, commercialization second—retains the benefits of the dilution action, while better protecting consumer interests.

⁸⁵ Deborah R. Gerhardt, *The 2006 Trademark Dilution Revision Act Rolls Out a Luxury Claim and a Parody Exemption*, 8 N. C. J. L. & TECH 205, 221 (2007). Gerhardt misguidedly approves of the fact that the number of producers famous enough to use the dilution action is small, as she believes it will limit the overall number of uses of the action. This perspective overlooks the relative power, over both competitors and producers of parodies, of those producers fortunate enough to be in this minority.

¶58 Recall that a parody must (i) “convey two simultaneous—and contradictory—messages: that it is the original, but also that it is not the original and is instead a parody;” and (ii) “communicate some articulable element of satire, ridicule, joking, or amusement.”⁸⁶ This means that mere insults and negative marketing, even if they meet the element of being satirical or amusing, fall short of the required standard. Such a product as McDonald’s Death Nuggets obviously would not convey “convey two simultaneous—and contradictory—messages: that it is the original, but also that it is not the original and is instead a parody.” As we have seen, “the line between mimicry and deviation”⁸⁷ is tough to traverse, and the mimicry in this hypothetical would be palpably weak. No-one could ever, even for a fleeting moment, think that McDonald’s actually produced this product (conceivably around Halloween, or the release of a movie called “Death,” etc.—but not otherwise).

¶59 Courts, therefore, could begin with inquiry into whether a parody is genuine because that approach is *workable*—it proposes two understandable elements already used. In addition, this approach is *desirable*, because it returns the focus of inquiry to the consumer. By looking, first, at whether a parody is genuine, rather than at whether it is primarily commercial, a court would protect any successful parody as a matter of law. Whether a producer could be losing out on perceived “brand magnetism,” by the whittling away of its good name, would be very much a secondary inquiry. This approach would accord with protecting freedom of consumption, and would avoid removing the interests of unconfused consumers from the judicial calculus. To be sure, it might lead to unpredictable results. Asking a court to determine what is funny and genuinely parodic is unlikely to be more predictable than asking it to determine what is commercial. However, the court would be forced to consider the *parody itself*—the item in the equation given First Amendment solicitude—and to do so from a *consumer’s* point of view. This, at least, begins the analysis in the right place.

¶60 Again, any confusion created by a parody product would still be actionable under a theory of infringement. The point of focusing on genuine parodies is not to allow chaos and confusion to rein on restaurant menus or supermarket shelves. However, in order to retain the advantages of a dilution action, while also protecting freedom of consumption, courts should ask not whether a supposed parody is primarily commercial, but whether it is a parody *at all*. A real-life “McDowell’s,” tucked away in a corner of the Bronx? Maybe. Burger King’s hypothetical “McDonald’s Death Nuggets?” Clearly actionable. The answer, in other words, is merely to enforce the definition of “parody,” not to scrutinize the degree of commercialization behind the speech.

¶61 The only time that commercialization would need to be assessed, under a *definition-first approach*, would be when the question of whether a parody was successful proved inconclusive. This follows because assessing the degree of commercialization is, in fact, an *indirect* way of assessing the genuineness of a parody. A genuine parody is by definition not “primarily commercial,” because a primarily commercial message ceases to be a parody, and becomes instead a marketing device or an advertisement. There are not two contradictory messages in an advertisement, *there is only one*: “buy me.”

⁸⁶ See *supra* Section V.

⁸⁷ See Little, *supra* note 39, at 1265.

¶62 A parody may not be primarily commercial. However, commercial speech may be a parody. By beginning the analysis with the question of whether the speech is commercial, courts begin the inquiry in the wrong place. In doing so, they cut consumer interests in consuming genuine parodies out of the equation, or at least relegate those interests to a secondary concern. Courts should begin by asking whether the defendant produced a genuine parody. If it did, that should end the inquiry. If the answer is inconclusive then, and only then, should the court should consider whether the parody is primarily commercial.

VI. CONCLUSION

¶63 “The protection of trademarks originated as a police measure to prevent ‘the grievous deceit of the people’ by the sale of defective goods, and to safeguard the collective good will and monopoly of the gild.”⁸⁸

¶64 Today, preventing the “grievous deceit of the people” remains a valid public-policy concern. However, I have argued that prohibiting parodies that cause no confusion, and that successfully meet the specific requirements of a genuine parody, serves no public benefit. Instead, it risks creating a modern-day guild, comprising the handful of famous marks that fall under the ambit of the federal dilution action, with unprecedented power to enjoin and seek damages for parody.

¶65 Parody should be interpreted as a strong bar against relief in dilution actions, defeated only in cases in which a supposed parody is not really a parody at all. This approach gives proper weight to the interests of consumers and to the protection of parodies.

⁸⁸ Schechter, *supra* note 15, at 819.