

Comment

BORN TO BE USED IN THE USA¹: AN ALTERNATIVE AVENUE FOR EVALUATING POLITICIANS' UNAUTHORIZED USE OF ORIGINAL MUSICAL PERFORMANCES ON THE CAMPAIGN TRAIL

I. INTRODUCTION

Music is one of the most effective ways to convey a political message.² During the 1992 presidential campaign, Democratic candidate and future President Bill Clinton played Fleetwood Mac's tune *Don't Stop* to emphasize his theme of forward-looking optimism.³ Almost 170 years earlier, supporters of Andrew Jackson used *The Hunters of Kentucky* to highlight Jackson's leadership during the Battle of New Orleans.⁴ In the heat of the historic 2008 presidential election, Democrat Barack Obama and Republican John McCain even incorporated music by the same country duo, Brooks and Dunn, into their respective campaigns.⁵ Like Clinton, Obama, and McCain, most contemporary politicians play original musical performances (i.e. "already existing" songs) on the cam-

1. BRUCE SPRINGSTEEN, *BORN IN THE USA* (Columbia Records 1984).

2. See Adam Nagourney, *On the Trail; The Edwards Playlist*, N.Y. TIMES (Dec. 20, 2007), <http://query.nytimes.com/gst/fullpage.html?res=9C03E1D61639F933A15751C1A9619C8B63> (describing campaign music as having two purposes: energize crowds and convey political messages); see also *Songs Along the Campaign Trail*, NATIONAL PUBLIC RADIO (Oct. 5, 2008), <http://www.npr.org/templates/story/story.php?storyId=95408459> [hereinafter *NPR Interview*] (explaining how music has been used to convey political messages throughout American political history).

3. See Nagourney, *supra* note 2 (mentioning Bill Clinton's use of *Don't Stop* "with its 'Thinking About Tomorrow' chorus").

4. See LYNNE HUDSON PARSONS, *THE BIRTH OF MODERN POLITICS: ANDREW JACKSON, JOHN QUINCY ADAMS AND THE ELECTION OF 1828* 160 Oxford University Press (2009) (describing methods of campaigning during 1828 presidential election). Thomas Jefferson and Martin Van Buren are other examples of 19th century politicians who used music to convey a campaign message. See *NPR Interview*, *supra* note 2 (discussing use of campaign songs in American political history).

5. See Chris Willman, *'Only in America' Could Obama Borrow the GOP's Favorite Brooks and Dunn Song*, ENTERTAINMENT WEEKLY (Aug. 29, 2008, 10:26 PM), <http://popwatch.ew.com/2008/08/29/only-in-america/> (reporting use of country-duo Brooks and Dunn's songs by Democratic candidate Barack Obama and Republican candidate John McCain during 2008 presidential campaign).

paign trail rather than having their staffs create songs with a degree of “personalization.”⁶

At times, politicians use or reference musical works of artists who do not support their candidacy.⁷ A well-known dispute occurred during the 1984 presidential election. At a September campaign stop in musician Bruce Springsteen’s native state of New Jersey, President Ronald Reagan praised Springsteen for the “message of hope” in his music.⁸ Following Reagan’s comments, Springsteen strongly disassociated himself from Reagan in a December 1984 cover-story interview for the music-magazine *Rolling Stone*.⁹

During the 1996 presidential campaign, the threat of litigation forced Republican candidate Bob Dole to stop using the hit Motown song *Soul Man* at his campaign rallies.¹⁰ More recently,

6. See *NPR Interview*, *supra* note 2 (explaining most contemporary politicians play “already existing music” on campaign trail); see also Cat Koo, *Ten Songs Stolen by Politicians*, BBC NEWS, Sept. 24, 2010, <http://www.bbc.co.uk/news/entertainment-arts-11406906> (reporting examples of politicians using original musical performances both internationally and in U.S.).

7. See Koo, *supra* note 6 (reporting recent disputes between international political candidates and musicians that arose from candidates’ unauthorized use of musicians in their campaigns).

8. See Sarah Wheaton, *Accompaniments; Theme Songs and Others*, N.Y. TIMES (Feb. 16, 2008), <http://query.nytimes.com/gst/fullpage.html?res=9D03EFD8153CF935A25751C0A96E9C8B63> (“Ronald Reagan praised Bruce Springsteen’s ‘message of hope’ not long after his dark and critical *Born in the U.S.A.* came out.”). Reagan said the following:

America’s future rests in a thousand dreams . . . It rests in the message of hope in the songs of a man so many young Americans admire- New Jersey’s own Bruce Springsteen. And helping you make those dreams come true is what this job of mine is all about.

Elizabeth Bird, “*Is that Me Baby?*” *Image, Authenticity, and the Career of Bruce Springsteen*, 35(2) AM. STUDIES, 39, 44 (1994), available at <https://journals.ku.edu/index.php/amerstud/article/viewFile/2821/2780>.

9. See Kurt Loder, *The Rolling Stone Interview: Bruce Springsteen*, ROLLING STONE, Dec. 6, 1984, at 21 (expressing Springsteen’s opinion that Reagan was “manipulat[ing] and exploit[ing]” people’s “need to feel good about the country” by referencing his music). See also Wheaton, *supra* note 8, (“Mr. Springsteen later implied in an interview with *Rolling Stone* that Reagan had exploited people’s need to feel good about the country.”).

10. See *Dole Campaign Agrees to Change Its Tune*, N.Y. TIMES, Sept. 14, 1996, at 9, available at <http://www.nytimes.com/1996/09/14/us/dole-campaign-agrees-to-change-its-tune.html> (discussing Dole campaign’s decision to cease playing *Soul Man*). Rondor Music International, Inc. owned the intellectual property rights to *Soul Man* and threatened to sue the Dole campaign for copyright infringement. See *id.* (discussing potential copyright infringement suit). At Dole’s rallies, his campaign played *Soul Man*, and the song’s chorus, “I’m a soul man,” often “morphed into ‘I’m a Dole man.’” *Id.* When Rondor Music initially protested Dole’s use of its song, the Dole campaign ceased using the line “I’m a Dole man” and only played the original song. *Id.* Shortly thereafter, however, the campaign ceased using *Soul Man* altogether. See *id.* (ceasing use of *Soul Man*). The line “I’m a Dole man” was sometimes performed by a member of the Motown duo that originally

singer John Mellencamp, who supported Democratic candidate John Edwards, asked McCain to stop using his songs *Our Country* and *Pink Houses* at his rallies during the 2008 presidential election.¹¹ In response to a letter from Mellencamp's publicist, the McCain campaign removed Mellencamp's music from its playlist.¹² During that same election, singer Jackson Browne sued McCain after the McCain campaign used Browne's song *Running on Empty* in a campaign advertisement without Browne's permission.¹³ Shortly after the 2010 congressional midterm election season got underway, former Eagles frontman Don Henley filed suit action against California assemblyman Charles DeVore for using two of Henley's songs in his campaign for the 2010 Republican primary for the U.S. Senate race in California.¹⁴

Because most contemporary politicians prefer to play original musical performances on the campaign trail, this Comment explores the legal issues presented when candidates incorporate original musical performances into their campaigns without

released *Soul Man*, Sam Moore of Sam and Dave. See Wheaton, *supra* note 8 (discussing Dole's use of *Soul Man*).

11. See Wheaton, *supra* note 8 (requesting McCain stop using his songs). Mellencamp also requested that Republican candidate and future President George Bush stop using his song *R.O.C.K. in the U.S.A.* during the 2000 presidential campaign. See *id.* (asserting demand for Bush to stop using *R.O.C.K. in the U.S.A.* in campaign). During that same campaign, Sting and Tom Petty also requested that Bush cease using their songs *Brand New Day* and *Won't Back Down*, respectively. See *id.* (noting request by Sting and Petty to President Bush to stop using their songs). Petty, however, did not protest when Democratic candidate Hillary Clinton, whom he supported, used his song *American Girl* during her 2008 presidential campaign. See *id.* (noting Petty's refraining from protesting when candidate he supported used his song in political campaign).

12. See Amanda Lee Myers, *Mellencamp Songs off McCain's Playlist*, Fox News (Feb. 07, 2008), <http://www.foxnews.com/wires/2008Feb07/0,4670,PeopleMcCainMellencamp,00.html> (reporting McCain campaign's decision to no longer play Mellencamp's songs). The letter read in part, "Are you sure you want to use [Mellencamp's] music to promote Senator McCain's efforts? Logic says that the facts might prove to be an embarrassment, were they to be circulated widely." *Id.*

13. See Complaint ¶¶ 19-38, *Browne v. McCain*, 611 F. Supp. 2d 1073, (C.D. Cal. 2008) (No. 08-05334), 2008 WL 3849451 [hereinafter *Browne Complaint*] (outlining copyright and trademark infringement claims brought by singer Jackson Browne against presidential candidate John McCain, Republican National Committee, and Ohio Republican Party for unauthorized use of Browne's song *Running on Empty* during 2008 presidential campaign).

14. See Complaint ¶¶ 43-76, *Henley v. DeVore*, 2010 U.S. Dist. LEXIS 67987 (C.D. Cal. 2009) (No. 09-0481) [hereinafter *Henley Complaint*] (outlining copyright and trademark infringement claims brought by singer Don Henley against senatorial candidate Charles DeVore and one of DeVore's campaign directors for their unauthorized use of Henley's songs during 2010 Republican primary for California's U.S. Senate seat).

authorization.¹⁵ Section II of this Comment discusses the basic principles of copyright and trademark law, First Amendment doctrines applicable to political campaigns and intellectual property law, and recent cases involving the unauthorized use of intellectual property in political campaigns.¹⁶ Section III begins by evaluating the impact that the cases discussed in Section II will have on future litigations involving the unauthorized use of an original musical performance in a political campaign.¹⁷ Because of that impact, Section III then proposes that courts apply a modified alternative avenues test to make preliminary determinations of copyright fair use in cases involving the unauthorized use of an original musical performance in a political campaign.¹⁸ The Comment concludes in Section IV that politicians will likely litigate challenges to their use of original musical performances well past the conclusion of their campaigns, and accordingly, it is in the interest of justice for courts to apply the modified alternative avenues test proposed herein.¹⁹

15. See *NPR Interview*, *supra* note 2 (explaining that most modern politicians use original musical performances as campaign songs).

16. In particular, this Comment focuses on Ninth and Second Circuit precedent because most entertainment-related intellectual property cases are filed in those circuits, including *Browne v. McCain* and *Henley v. DeVore*. See William K. Ford, *Judging Expertise in Copyright Law*, 14 J. INTELL. PROP. L. 1, 41 (2006) (“Only two circuits, the Second and the Ninth, plausibly possess sufficient experience with copyright litigation to acquire substantially greater expertise relative to the other circuits.”); *Browne Complaint*, *supra* note 13 (filed within Ninth Circuit); *Henley Complaint*, *supra* note 14 (filed within Ninth Circuit); see also, e.g., *Abdul-Jabbar v. GMC*, 85 F.3d 407 (9th Cir. 1996); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992); *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302 (9th Cir. 1992); *Motschenbacher v. R. J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974); *MasterCard Int’l Inc. v. Nader*, No. 00-6068, 2004 U.S. Dist. LEXIS 3644 (S.D.N.Y. Mar. 8, 2004); *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985). Other circuits have also handled celebrity intellectual property disputes. See, e.g., *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003); *Falwell v. Flynt*, 797 F.2d 1270 (4th Cir. 1986); *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983).

17. For a further discussion of the impact of recent cases that is discussed in Section III, see *infra* notes 258-97 and accompanying text.

18. For a further discussion of the modified alternative avenues test proposed in this Comment, see *infra* notes 298-345 and accompanying text.

19. For a further discussion of this Comment’s conclusion, see *infra* notes 346-51 and accompanying text.

II. BACKGROUND

A. Copyright Law

1. *Copyright Ownership Rights*

A copyright is a form of property ownership.²⁰ Copyrights grant individuals the exclusive right to use and disseminate their creative works for a fixed number of years.²¹ The principle of copyright protection originated in Britain's 1710 Statute of Anne as a response to the invention of the printing press.²² In the United States, the Constitution's Copyright clause grants Congress the enumerated power is to protect copyrights.²³ The current law governing copyright protections is the Copyright Act of 1976 (the "Copyright Act").²⁴

To be eligible for copyright protection, a work must be (1) original and (2) "fixed in any tangible medium of expression, now known or later developed, from which [it] can be perceived, reproduced, or otherwise communicated."²⁵ The Copyright Act limits copyright ownership to "those aspects of the work—termed 'expression'—that display the stamp of the author's originality."²⁶ Accord-

20. See *Davis v. Blige*, 505 F.3d 90, 98 (2d Cir. 2007) ("Like other forms of property ownership, copyright ownership is a 'bundle of discrete rights' regarding the owner's ability to use his property.").

21. *Copyright Basics*, UNITED STATES COPYRIGHT OFFICE, 1-2 (2008), <http://www.copyright.gov/circs/circ1.pdf> (explaining basic concepts and importance of copyrights).

22. See Statute of Anne, 8 Ann., c. 19 (1710), available at <http://www.case.edu/affil/sce-/authorship/statueofanne.pdf> (enacting first copyright code). The Statute of Anne was enacted because the invention of the printing press resulted in the widespread unauthorized reprinting of books and other writings in England. See *Id.* (discussing purpose of enactment); see also *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 431 n.12 (1984) ("Copyright protection became necessary with the invention of the printing press and had its early beginnings in the British censorship laws."). Historically, copyright law "served to protect copyright interests when the publisher lost the physical control over the copies," and "[m]ass distribution of works required a substitute for contractual or physical restraints over the use." Niva Elkin-Koren, *Cyberlaw and Social Change: A Democratic Approach to Copyright Law in Cyberspace*, 14 CARDOZO ARTS & ENT. L.J. 215, 275 (1996) (comparing historical purposes of copyright law to modern applications in cyberspace).

23. See U.S. CONST. art. I, § 8, cl. 8 ("[The Congress shall have power] [t]o 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.").

24. See 17 U.S.C.S. § 106 (LexisNexis 2010) (setting forth exclusive rights held by copyright holders).

25. 17 U.S.C.S. § 102(a). "Copyright protection subsists from the time the work is created in fixed form." *Copyright Basics*, *supra* note 21, at 2.

26. *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 547 (1985) (explaining scope of copyright ownership).

ingly, ideas, facts, principles, and concepts cannot be copyrighted.²⁷ Items that can be copyrighted include literary works, musical works, and sound recordings.²⁸ In general, the duration of copyrights for works created after 1978 is the life of the author or artist plus seventy years.²⁹ After its copyright protection expires, a work becomes part of the “public domain,” and the public may use the previously-copyrighted work without restriction.³⁰

Under the Copyright Act, copyright holders have the exclusive right to reproduce, publicly perform, publicly display, and create derivatives of their copyrighted works.³¹ To succeed in a copyright infringement action, a plaintiff must prove “(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.”³² The standard for determining copying is “‘substantial similarity’ between the copyrighted work and the allegedly infringing work.”³³

27. See 17 U.S.C.S. § 102(b) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”); see also *Harper & Row*, 471 U.S. at 547 (“In addition, no author may copyright facts or ideas.”).

28. See 17 U.S.C.S. § 102(a)(1)-(8) (listing examples of works of authorship protected by Copyright Act).

29. See 17 U.S.C.S. § 302 (codifying duration of copyright ownership); see also *Copyright Basics*, *supra* note 21, at 5-6 (explaining duration of copyright rules).

30. See *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1262 (11th Cir. 2001) (“The second goal of the Copyright Clause is to ensure that works enter the public domain after an author’s rights, exclusive, but limited, have expired.”); *Eldred v. Reno*, 239 F.3d 372, 377 (D.C. Cir. 2001), *aff’d sub nom. Eldred v. Ashcroft*, 537 U.S. 186 (2003) (“A work in the public domain is, by definition, without a copyright.”); see also BLACK’S LAW DICTIONARY 1349 (9th ed. 2009) (defining public domain as “[t]he universe of inventions and creative works that are not protected by intellectual-property rights and are therefore available for anyone to use without charge”).

31. See 17 U.S.C.S. § 106 (setting forth exclusive rights held by copyright holders).

32. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991); see also *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1398 (9th Cir. 1997) (“To prove a case of copyright infringement, [the plaintiff] must prove both ownership of a valid copyright and infringement of that copyright by invasion of one of the five exclusive rights.”). The owner of a copyright is not required to register the copyright for the work to be protected. See 17 U.S.C.S. § 408(a) (“[Copyright] registration is not a condition of copyright protection.”). However, in order to bring an infringement suit for works of U.S. origin, the author must first register the copyright with the United States Copyright Office. See 17 U.S.C.S. § 411(a) (“[N]o action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.”).

33. *Dr. Seuss Enters.*, 109 F.3d at 1398 (explaining standard for copyright infringement). “‘Substantial similarity’ refers to similarity of expression, not merely similarity of ideas or concepts.” *Id.*

2. *Fair Use Defense*

Fair use is an affirmative defense available when, without authorization, a party appropriates a copyrighted work for limited purposes such as “comment,” “news reporting,” and “teaching.”³⁴ It is an “exception to a copyright holder’s right to exclusive use of the original work and its derivatives.”³⁵ Accordingly, fair use is a “privilege” that allows others to use copyrighted material without the copyright holder’s permission.³⁶ As with any affirmative defense, the burden is on the defendant to demonstrate fair use.³⁷

The fair use defense balances artists’ interests in protecting their creative works against the public’s interests in protecting free speech and the free dissemination of ideas.³⁸ It also enables creativ-

34. See 17 U.S.C.S. § 107 (codifying fair use defense); Soc’y of Holy Transfiguration Monastery v. Gregory, 685 F. Supp. 2d 217, 226 (D. Mass. 2010) (explaining fair use is affirmative defense). Prior to its codification in the 1976 Copyright Act, the fair use defense evolved at common law. See William Henslee, *You Can’t Always Get What You Want, But If You Try Sometimes You Can Steal It and Call it Fair Use: A Proposal to Abolish The Fair Use Defense For Music*, 58 CATH. U.L. REV. 663, 666-76 (2009) (explaining origin of fair use defense); see also *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 576 (1994) (tracing common law development of fair use defense). The codification of the fair use defense in the 1976 Copyright Act was intended to “restate” the common law doctrine that developed, “not to change, narrow, or enlarge it in any way.” *Campbell*, 510 U.S. at 577 (citing H. R. Rep. No. 94-1476, at 66 (1976); S. Rep. No. 94-473, at 62 (1975)).

35. *Henley v. DeVore*, No. 09-0481, 2010 U.S. Dist. LEXIS 67987, at *9 (C.D. Cal. June 10, 2010) (explaining standards for fair use).

36. *Id.* (“[Fair use] has been described as ‘a privilege in others than the owner of the copyright to use the copyrighted material in a reasonable manner without his consent.’” (citing *Harper & Row Publishers, Inc., v. Nation Enters.*, 471 U.S. 539, 549 (1985))).

37. See *id.* at *11 (explaining allocation of burden of proof when fair use defense is asserted); *Gregory*, 685 F. Supp. 2d at 226 (Same); *MasterCard Int’l Inc. v. Nader*, No. 00-6068, 2004 U.S. Dist. LEXIS 3644, at*35 (S.D.N.Y. Mar. 8, 2004) (Same).

38. See *Campbell*, 510 U.S. at 584 (noting fair use requires “sensitive balancing of interests”); see also *Hustler Magazine, Inc. v. Moral Majority, Inc.*, 796 F.2d 1148, 1151-52 (9th Cir. 1986) (“Courts balance these factors to determine whether the public interest in the free flow of information outweighs the copyright holder’s interest in exclusive control over the work.” (citing *DC Comics, Inc. v. Reel Fantasy, Inc.*, 696 F.2d 24, 27 (2d Cir. 1982))); *Keep Thompson Governor Comm. v. Citizens for Gallen Comm.*, 457 F. Supp. 957, 960 (D.N.H. 1978) (stating fair use involves weighing “the exclusive right of a copyright holder” against “the public’s interest in dissemination of information affecting areas of universal concern,” and “[c]onflicts between interests protected by the First Amendment and the copyright laws can be resolved by application of the fair use doctrine” (citing *Wainwright Sec., Inc. v. Wall St. Transcript Corp.*, 558 F.2d 91 (2d Cir. 1977))). The fair use doctrine can also be considered to be a “free speech catch-all” for copyright law. See Eileen Hintz Rumpfelt, Comment, *Political Speech: Priceless- MasterCard v. Nader and the Intersection of Intellectual Property and Free Speech*, 55 EMORY L.J. 389, 397-98 (2006) (“[T]he fair use doctrine often functions as a free speech ‘catch all.’”). For a further discussion of the First Amendment’s impact on copyright law, see *infra* notes 159-75 and accompanying text.

ity by allowing artists and authors to borrow from others when necessary and appropriate.³⁹ The Copyright Act sets forth the following factors for courts to weigh when analyzing fair use:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for non-profit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.⁴⁰

Courts must evaluate fair use on a case-by-case basis.⁴¹ The fair use doctrine is an “equitable rule of reason,” and there is no “generally applicable definition” of fair use that allows for a rigid standard of evaluation.⁴² Courts must ensure that the fair use defense does not stifle creativity, which Congress intended it to encourage, while simultaneously protecting copyright holders’ intellectual property rights.⁴³ The “ultimate test” of fair use is to determine

39. See *Campbell*, 510 U.S. at 575 (“[I]n truth, in literature, in science and in art, there are, and can be, few, if any, things, which in an abstract sense, are strictly new and original throughout. Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before.” (quoting *Emerson v. Davies*, 8 F. Cas. 615, 619 (No. 4,436) (C.C.D. Mass. 1845))).

40. See 17 U.S.C.S. § 107(1)-(4) (setting forth factors to consider when analyzing fair use).

41. See *Campbell*, 510 U.S. at 577 (“The task [of determining fair use] is not to be simplified with bright-line rules, for the statute, like the doctrine it recognizes, calls for case-by-case analysis.”); see also *Blanch v. Koons*, 467 F.3d 244, 251 (2d Cir. 2006) (“As the words of [the Copyright Act] indicate, the determination of fair use is an open-ended and context-sensitive inquiry.”); *Henley*, 2010 U.S. Dist. LEXIS 67987, at *10-11 (“The factors are not winner-take-all categories to be tallied at the end to determine the prevailing party; they are intended to be carefully weighed case by case with an eye towards the policies underlying copyright protection.”). But see William F. Patry and Richard A. Posner, *Fair Use and Statutory Reform in the Wake of Eldred*, 92 CAL. L. REV. 1639, 1659 (2004) (“[W]hereas the fair use defense is interpreted and applied on a case-by-case basis, though some rules have emerged, as we have seen, such as the right of a book reviewer to quote brief passages from the book under review, or of scholarly critics to quote from the work they are criticizing.”).

42. *Hustler Magazine*, 796 F.2d at 1151 n.4 (reviewing legislative history of fair use factors set forth in Copyright Act (quoting H.R. Rep. No. 94-1476, 94th Cong., 2nd Sess. 65-66)).

43. See *Campbell*, 510 U.S. at 577 (“The fair use doctrine thus permits and requires courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.” (quoting *Stewart v. Abend*, 495 U.S. 207, 236 (1990) (internal quotations omitted))).

whether allowing the disputed use would serve copyright law's goal of "promoting the Progress of Science and useful Arts" better than prohibiting the use would.⁴⁴ The scope of the fair use defense is also "wider when the use relates to issues of public concern."⁴⁵ Therefore, the four fair use factors set forth in the Copyright Act are not exclusive; courts may also consider other factors when determining fair use.⁴⁶

The issue of fair use presents a mixed question of law and fact, which allows courts to make fair use determinations on summary judgment.⁴⁷ The "most important question under the first [fair use] factor, and in fair use analysis generally," is whether the secondary work is "transformative."⁴⁸ However, it is "not absolutely necessary" that a secondary work be transformative for a finding of fair

The Court explained that a fair use analysis must be conducted by weighing all four statutory factors together "in light of the purposes of copyright." *See id.* (explaining proper way to analyze fair use questions).

44. *See* MasterCard Int'l Inc. v. Nader, No. 00-6068, 2004 U.S. Dist. LEXIS 3644, at*35 (S.D.N.Y. Mar. 8, 2004) ("The ultimate test of fair use, therefore, is whether the copyright law's goal of 'promoting the Progress of Science and useful Arts' . . . would be better served by allowing the use than by preventing it." (citing U.S. CONST., art. I, § 8, cl. 8; Arica Inst., Inc. v. Palmer, 970 F.2d 1067, 1077 (2d Cir. 1992))).

45. Nat'l Rifle Ass'n of Am. v. Handgun Control Fed'n, 15 F.3d 559, 562 (6th Cir. 1994) (explaining fair use protected defendant's right to use document at issue "to comment on public issues and to petition the government regarding legislation" (citing Consumers Union of U.S., Inc. v. Gen. Signal Corp., 724 F.2d 1044, 1050 (2d Cir. 1983), *cert. denied*, 469 U.S. 823 (1984))). *But see* Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 555-56 (1985) (refusing to create copyright infringement exception based on "substantial public import" of copyrighted material).

46. *See* 17 U.S.C.S. § 107 (stating "factors to be considered shall include"); *see also* Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 547, 560-61 (1985) (explaining four statutory fair use factors are "are not meant to be exclusive" but are "especially relevant in determining whether the use was fair"). Likewise, the examples of fair use in the section's preamble are not all-inclusive. *See Campbell*, 510 U.S. at 577-78 ("The text employs the terms 'including' and 'such as' in the preamble paragraph to indicate the 'illustrative and not limitative' function of the examples given" (quoting *Harper & Row*, 471 U.S. at 561)).

47. *See* Blanch v. Koons, 467 F.3d 244, 250 (2d Cir. 2006) (explaining fair use is mixed question of fact and law appropriate for summary judgment); *see also* Henley v. DeVore, No. 09-0481, 2010 U.S. Dist. LEXIS 67987, at *11 (C.D. Cal. June 10, 2010) (explaining "summary judgment on the fair use question is proper" when there are no material facts in dispute).

48. *Nader*, 2004 U.S. Dist. LEXIS 3644 at *37-38 (explaining importance of determining transformative nature of secondary work in fair use analysis (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994))); *see also* Perfect 10, Inc. v. Amazon.com, Inc., 508 F.3d 1146, 1164 (9th Cir. 2007) (opining first fair use factor's "central purpose" is to "determine whether and to what extent the new work is 'transformative.'").

use.⁴⁹ A transformative work “adds something new, with a further purpose or different character, altering the first with new expression, meaning or message.”⁵⁰ It is possible, however, for a secondary work that uses an exact copy of the original work to be transformative.⁵¹

If a secondary work is a parody of an original work, the secondary work is viewed as transformative.⁵² “Parody is the use of some portion of a work in order to ‘hold it up to ridicule,’ or otherwise comment or shed light on it.”⁵³ The threshold question for determining fair-use parody is whether parody can “reasonably be perceived” in the secondary work.⁵⁴ For a court to find fair-use parody in a secondary work, commentary on the original work should have been intended when the secondary work was created; it should not be a “*post hoc* rationalization[]” used to defend against a copyright infringement suit.⁵⁵ Furthermore, parody differs from satire- par-

49. *Campbell*, 510 U.S. at 579 (explaining importance of transformative use when analyzing first fair use factor).

50. *Nader*, 2004 U.S. Dist. LEXIS 3644, at *38 (discussing requirements for secondary work to be transformative (quoting *Campbell*, 510 U.S. at 579)). If a secondary work “‘merely supersedes’ the original,” it is not transformative. *See id.* (defining transformative).

51. *See, e.g., Perfect 10*, 508 F.3d at 1165 (holding internet search engine Google added “new context to serve a different purpose” by enabling internet users to access third party websites posting infringing images of Perfect 10’s nude models (citing *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 818-19 (9th Cir. 2003))); *Blanch v. Koons*, 467 F.3d 244, 252-253 (2d Cir. 2006) (holding incorporating exact copy of original work into collage was transformative because of “sharply different objectives” of original work and collage); *Nunez v. Caribbean Int’l News Corp.*, 235 F.3d 18, 22-23 (1st Cir. 2000) (holding newspapers’ republication of copyrighted modeling portfolio photos to be transformative because photos were published “in conjunction with editorial commentary”); *Lennon v. Premise Media*, 556 F. Supp. 2d 310, 322-23 (S.D.N.Y. 2008) (holding movie’s use of unaltered clip of Beatle’s song *Imagine* was transformative because it criticized and commented by “contribut[ing] to the broader public interest by stimulating debate on an issue of current political concern”).

52. *See Campbell*, 510 U.S. at 579 (explaining “parody has an obvious claim to transformative value”).

53. *Henley*, 2010 U.S. Dist. LEXIS 67987, at *13 (defining parody (quoting *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1400-01 (9th Cir. 1997))); *see also Campbell*, 510 U.S. at 580 (defining parody as “the use of some elements of a prior author’s composition to create a new one that, at least in part, comments on that author’s works.”).

54. *See Campbell*, 510 U.S. at 582 (“The threshold question when fair use is raised in defense of parody is whether a parodic character may reasonably be perceived.”).

55. *Henley*, 2010 U.S. Dist. LEXIS 67987, at *26 (holding that “the parodist’s subjective contemporaneous intent in making the work is relevant to the parody inquiry” (citing *Campbell*, 510 U.S. at 600 (Kennedy, A., concurring); *Salinger v. Colting*, 607 F.3d 68 (2d Cir. 2010); *MCA, Inc. v. Wilson*, 677 F.2d 180, 183-84 (2d Cir. 1981); *Fisher v. Dees*, 794 F.2d 432, 436-37 (9th Cir. 1986); *Bourne Co. v. Twentieth Century Fox Film Corp.*, 602 F. Supp. 2d 499, 507-08 (S.D.N.Y. 2009))).

ody “target[s]” the copyrighted work whereas satire uses the copyrighted work as “a vehicle to poke fun at another target.”⁵⁶ Accordingly, parody presents a strong case for fair use, but satire does not.⁵⁷ Additionally, courts are split as to whether the use of copyrighted material to criticize the creator, rather than the work itself, constitutes fair-use parody.⁵⁸

A finding of fair-use parody under the first fair use factor affects how a court evaluates the subsequent factors. Courts give very little weight to the second and third factors when the secondary work is parody.⁵⁹ Courts, however, require more weight to be given to the second and third factors when there is a “loose” fit between the parody and the original work; such as when the secondary work doesn’t directly target the original work.⁶⁰ The relevant inquiry for the fourth fair use factor is “whether the new work tends to supplant or substitute for the potential market for the original or its derivatives.”⁶¹ However, market harm to an original work solely

56. *Henley*, 2010 U.S. Dist. LEXIS 67987, at *14 (distinguishing between satire and parody (citing *Dr. Seuss Enters., L.P.*, 109 F.3d at 1400)).

57. *See Campbell*, 510 U.S. at 580-81 (“Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim’s (or collective victims’) imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing.”); *see also Henley*, 2010 U.S. Dist. LEXIS 67987, at *34 (“However, as noted in *Campbell*, satire faces a higher bar for fair use because it requires greater justification for appropriating the original work.”).

58. *See, e.g., Henley*, 2010 U.S. Dist. LEXIS 67987, at *22 (“Under *Campbell*’s reasoning, rather than its precise phrasing, criticism of the author via the author’s works may fit within the structure of protectable parody.”); *Salinger v. Colting*, 641 F. Supp. 2d 250, 257 (S.D.N.Y. 2009), *rev’d on other grounds*, 607 F.3d 68 (2d Cir. 2010) (“*Campbell* and its progeny define the limits of parody to include only those elements which criticize or comment upon the source author’s works, rather than the author himself.”). Secondary works that parody the creator “must target the author directly” rather than targeting the “author’s views generally for the works to qualify as fair use. *See Henley*, 2010 U.S. Dist. LEXIS 67987, at *31 (explaining standard for “parody-of-the-author” fair use).

59. *See Nader*, 2004 U.S. Dist. LEXIS 3644, at *44-48 (explaining second and third factors are not as significant in fair use analysis when disputed work is determined parody (citing *Campbell*, 510 U.S. at 586; *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp.*, 150 F.3d 132, 144 (2d Cir. 1998); *Liebowitz v. Paramount Pictures Corp.*, 137 F.3d 109, 116 (2d Cir. 1998))). To be an effective parody, a secondary work must use enough of the original work “to make the object of its critical wit recognizable,” which thereby makes the third factor less important after the court determines that the secondary work is a parody. *Id.* at *47-48 (quoting *Campbell*, 510 U.S. at 588).

60. *See Henley*, 2010 U.S. Dist. LEXIS 67987, at *15 (“The ‘loose’ parodist has a greater burden of proving the necessity of the use and that the parody does not risk superseding potential markets for the original.” (citing *Campbell*, 510 U.S. at 580 n.14, 582 n.16.)).

61. *Id.* at *12 (explaining standards for fair use factors).

due to the parodic nature of a secondary work does not weigh in favor of the copyright holder.⁶²

In *MasterCard Int'l, Inc. v. Nader 2000 Primary Committee, Inc.*,⁶³ the District Court for the Southern District of New York (S.D.N.Y.) addressed the fair use defense in the context of a political campaign.⁶⁴ In the heat of the 2000 presidential campaign, MasterCard filed suit against the campaign of independent presidential candidate Ralph Nader, which modeled one of its political advertisements after MasterCard's famous "Priceless" advertisements (the "MasterCard Advertisements").⁶⁵ The Nader campaign's advertisement mimicked the well-known MasterCard Advertisements by listing items synonymous with dirty politics, the "prices" for each item, and then stating at the conclusion: "Finding out the truth: priceless. There are some things money can't buy" (the "Nader Advertisement").⁶⁶ One of MasterCard's causes of action was copyright infringement.⁶⁷ On summary judgment, the court held that the Nader Advertisement was a fair-use parody of the MasterCard Advertisements.⁶⁸

62. See *Nader*, 2004 U.S. Dist. LEXIS 3644, at *48 ("[I]f the secondary work harms the market for the original through criticism or parody, rather than by offering a market substitute for the original that supersedes it, it does not produce a harm cognizable under the Copyright Act." (quoting *Campbell*, 510 U.S. at 592); see also *Henley*, 2010 U.S. Dist. LEXIS 67987, at *12-13 ("Harm caused by effective criticism or disparagement is not cognizable under the Copyright Act"). When analyzing the fourth fair use factor, courts must also consider "whether unrestricted and widespread conduct" similar to that of the defendant would harm the market for the plaintiff's original work. See *Campbell*, 510 U.S. at 590 (explaining standard for evaluating fourth fair use factor). Furthermore, courts must also consider whether the defendant's conduct will harm the market for derivative works of the original. See *id.* (analyzing defendant's conduct).

63. No. 00-6068, 2004 U.S. Dist. LEXIS 3644 (S.D.N.Y. Mar. 8, 2004).

64. See *id.* at *1-2 (describing nature of dispute).

65. See *Nader*, 2004 U.S. Dist. LEXIS 3644, at *2 (reviewing origin of dispute). The MasterCard Advertisements "feature[d] the name and images of several goods and services purchased by individuals which, with voice-overs and visual displays, convey to the viewer the price of each item." *Id.* at *2 (describing MasterCard Advertisement). At the conclusion of the MasterCard Advertisements, a "priceless intangible" is mentioned followed by the voice-over saying "Priceless. There are some things that money can't buy, for everything else, there is MasterCard." *Id.*

66. *Id.* at *2-3 (describing Nader campaign's alteration of MasterCard Advertisements). The Nader Advertisement aired on television for a total of eleven days and was posted on Nader's website throughout the campaign. See *id.* at *3 (describing airing of Nader Advertisement).

67. See *id.* at *3 (stating MasterCard's copyright infringement claims). MasterCard also brought three claims for trademark infringement under the Lanham Act, which will be discussed later in this Section.

68. See *id.* at *49 (dismissing MasterCard's copyright infringement claim).

The court held that the first and fourth fair use factors heavily favored the Nader campaign.⁶⁹ The court reasoned that the Nader Advertisement was a parody and, thus, transformative; the Nader Advertisement conveyed a different message, one that commented on the “materialistic message” that was “sugar coated” in the MasterCard Advertisements.⁷⁰ Because parody in a secondary work need only “reasonably be perceived,” the court held that the Nader Advertisement was “sufficiently a parody for the purposes of a fair use analysis.”⁷¹ In its analysis of the fourth fair use factor, the court acknowledged that the two advertisements served the “general overlapping market” of the “viewing public.”⁷² However, the court held that the fourth factor strongly favored fair use because the Nader Advertisement served a political purpose that was entirely different than the commercial purpose of the MasterCard Advertisements.⁷³

Because the court viewed the Nader Advertisement as parody, it afforded the second and third factors little significance in its fair use analysis.⁷⁴ Accordingly, weighing all four fair use factors, the court held that the Nader Advertisement constituted fair use of MasterCard’s copyright.⁷⁵

B. Trademark Law

1. *Trademark Ownership*

A trademark is a “word, name, symbol, or device, or any combination thereof” that is used to identify and distinguish one’s product or goods from those of another.⁷⁶ In general, trademarks

69. *See id.* at *42-43, 48-49 (holding first and fourth fair use factors favored Nader campaign).

70. *See Nader*, 2004 U.S. Dist. LEXIS 3644, at *42-43. The message of the Nader Advertisement was that presidential candidates can be bought in many ways, but the he stood for the truth. *See id.* (analyzing Nader’s advertisement). The message of the MasterCard Advertisements was that consumers could use their MasterCard to purchase everything but intangible “priceless” items. *See id.* at *42. (noting MasterCard statements). The court agreed with the Nader campaign’s assertion that the Nader Advertisement “wittingly comment[ed] on the craft of the original, ‘which cloak[ed] its materialistic message in warm, sugar-coated imagery that purport[ed] to elevate intangible values over the monetary values it in fact hawk[ed].’” *Id.* at *43.

71. *Id.* at *43 (“The message [of a parody] need not be popular nor agreed with. It may be subtle rather than obvious. It need only be reasonably perceived.”).

72. *Id.* at *49. .

73. *See id.* (comparing political and commercial purposes).

74. *See id.* at *44-48 (evaluating second and third fair use factors).

75. *Id.* at *49 (granting Nader campaign summary judgment on MasterCard’s copyright claim).

76. 15 U.S.C.S. § 1127 (LexisNexis 2010).

perform four functions.⁷⁷ First, trademarks identify and distinguish the trademark holder's goods.⁷⁸ Second, trademarks indicate that "all the goods bearing the mark derive from the same source."⁷⁹ Third, trademarks signify to consumers that "all goods bearing the mark are of the same quality."⁸⁰ Finally, trademarks serve as a primary instrument "in the advertisement and sale of the seller's goods."⁸¹ The Supreme Court has recognized the need to protect trademark ownership rights "because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation."⁸² Therefore, trademark ownership rights protect producers against lost sales due to consumer confusion regarding the origin of products in the market.⁸³

Federal trademark rights are governed by the Lanham Act.⁸⁴ The purpose of the Lanham Act is to "foster fair competition," prevent the deceit of consumers, and protect the mark holder's goodwill in the marketplace.⁸⁵ For a mark to be protected under the Lanham Act, the public must be able to (1) recognize the mark as identifying the goods or services with which the mark is associated and (2) distinguish those goods and services through the mark.⁸⁶ To qualify as serving those functions, a mark must be "inherently distinctive" or acquire "secondary meaning."⁸⁷ Secondary meaning

77. See *State Auto Prop. & Cas. Ins. Co. v. Travelers Indem. Co. of Am.*, 343 F.3d 249, 257 (4th Cir. 2003) (providing functions of trademark protections); see also *Indianapolis Colts v. Metropolitan Baltimore Football Club*, No. IP. 94-727-C, 1994 U.S. Dist. LEXIS 19277, at *8-9 (S.D. Ind. June 27, 1994) (Same).

78. See *State Auto Prop.*, 343 F.3d at 257 (noting trademarks identify and distinguish goods).

79. *Id.*

80. *Id.*

81. See *id.* (looking at use of trademarks in advertisements).

82. *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 531 (1987) (quoting *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 198 (1985)).

83. *Venture Tape Corp. v. McGills Glass Warehouse*, 540 F.3d 56, 62 (1st Cir. 2008) (stating lost sales can be harm suffered because of trademark infringement).

84. See generally 15 U.S.C.S. §§ 1051-1141 (LexisNexis 2010) (codifying trademark protections).

85. See Stephanie Dotson Zimdahl, Comment, *A Celebrity Balancing Act: An Analysis of Trademark Protection under the Lanham Act and the First Amendment Artistic Expression Defense*, 99 Nw. U. L. REV 1817, 1823 n.38 (2005) (explaining Supreme Court interpretation and congressional intent of Lanham Act); see also Rumpfelt, *supra* note 38, at 392 (discussing purposes of trademark law).

86. See *Comedy III Prods. Inc. v. New Line Cinema*, 200 F.3d 593, 595 (9th Cir. 2000) (explaining requirements for trademark recognition).

87. See *id.* (describing attributes of mark needed to qualify for protection); see also *Arrow Fastener Co. v. The Stanley Works*, 59 F.3d 384, 390 (2d Cir. 1995) ("Whether the mark is entitled to protection depends on whether it is inherently distinctive or, if merely descriptive, has acquired 'secondary meaning.'" (citing

attaches when the mark and the product or business the mark symbolizes “become synonymous in the mind of the public, submerging the primary meaning of the [mark] in favor of its meaning as a word identifying that [product or] business.”⁸⁸ The Act also establishes trademark law’s “functionality doctrine,” which precludes trademark ownership for a “useful product feature.”⁸⁹ Furthermore, trademark law specifies that a trademark right only attaches if the owner was the first to use that mark in commerce.⁹⁰

Marks are generally grouped into four categories: fanciful or arbitrary, suggestive, descriptive, or generic.⁹¹ Fanciful, arbitrary, and suggestive marks function as trademarks “almost automatically.”⁹² A descriptive mark can only function as a trademark if the mark has acquired secondary meaning.⁹³ A “generic term can never be a valid trademark.”⁹⁴ The Lanham Act’s definition of

Merriam-Webster, Inc. v. Random House, Inc., 35 F.3d 65, 70 (2d Cir. 1994), *cert. denied*, 513 U.S. 1190 (1995)).

88. *Arrow*, 59 F.3d at 390.

89. *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 164 (1995) (explaining “[i]t is the province of patent law, not trademark law,” to grant “a monopoly over new product designs or functions for a limited time”).

90. *See Dep’t of Parks & Rec. v. Bazaar Del Mundo, Inc.*, 448 F.3d 1118, 1125 (9th Cir. 2006) (explaining that common law “requires a mark to have been used in commerce before a protectable ownership interest in the mark arises”). “To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services.” *Id.* (citation omitted).

91. *See Time, Inc. v. Petersen Publ. Co.*, 173 F.3d 113, 118 (2d Cir. N.Y. 1999) (“There are four categories along the spectrum of possible trademarks: generic, descriptive, suggestive, and arbitrary or fanciful.”). These categories are also used to determine the strength of a trademark in a likelihood of confusion analysis. *See id.* (analyzing strength of trademark). For a further discussion of the likelihood of confusion analysis for trademark infringement cases, see *infra* notes 104-09 and accompanying text.

92. *See Qualitex*, 514 U.S. at 162 (“‘[F]anciful,’ ‘arbitrary,’ or ‘suggestive’ words or designs . . . almost *automatically* tell a customer that they refer to a brand (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-10 (2d Cir. 1976); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992))); *see also Arrow*, 59 F.3d at 391 (“Suggestive, arbitrary or fanciful marks may be protected without a showing of secondary meaning.”). “A fanciful mark is a made-up term.” *Arrow*, 59 F.3d at 391. “An arbitrary mark has an actual dictionary meaning, but that meaning does not describe the product.” *Id.* “A suggestive mark offers suggestions of, but does not actually describe, the features of a product.” *Id.*

93. *See Arrow*, 59 F.3d at 391 (explaining general characteristics of protected trademarks).

94. *Id.*; *see also Abercrombie & Fitch*, 537 F.2d at 9.

[N]o matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.

Id.

trademark, however, when “read literally, is not restrictive.”⁹⁵ Accordingly, the Supreme Court has held that a color can function as a trademark.⁹⁶

Trademark ownership lasts as long as the trademark is in continuous use.⁹⁷ A Trademark will lose legal protection if it no longer “relate[s] exclusively to the trademark owner’s product.”⁹⁸ Likewise, a mark no longer used by its owner is considered “abandoned” and, therefore, loses legal protection and becomes available for public use.⁹⁹

2. *Liability under the Lanham Act*

To succeed on a claim for trademark infringement under the Lanham Act, a plaintiff must prove (1) trademark ownership and (2) that the defendant’s unauthorized use of the trademark is likely to cause consumer confusion.¹⁰⁰ The Lanham Act protects both registered and unregistered trademark holders against misappropriation of their protected marks.¹⁰¹ Though not required for

95. *Qualitex*, 514 U.S. at 162. “Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive.”

96. *See id.* at 163, 174 (holding color that acquired secondary meaning meets legal requirements for trademark protection). The Court also listed shapes, sounds and scents as examples of seemingly generic marks that may function as protected trademarks. *See id.* at 162. (setting forth qualifying marks).

97. *See Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164 (Fed. Cir. 2002) (“[W]hile trademarks endure as long as the mark is used, copyrights eventually expire.”). This indefinite ownership should not be confused with the Lanham Act’s registration requirements, which allow registration for ten-year renewable increments with certain interim requirements. *See* 15 U.S.C.S. § 1058 (LexisNexis 2010) (setting forth registration requirements).

98. *Abdul-Jabbar v. GMC*, 85 F.3d 407, 411 (9th Cir. 1996). Trademarks lose protection because “the primary cost of recognizing property rights in trademarks is the removal of words from (or perhaps non-entrance into) our language.” *Id.*

99. *See Abdul-Jabbar*, 85 F.3d at 411 (“[T]he law ceases to protect the owner of an abandoned mark”); *see also* 15 U.S.C.S § 1127 (LexisNexis 2010) (setting forth standard that mark that becomes generic is considered to be “abandoned”). Under the Lanham Act, a mark is abandoned when the owner intends to discontinue its use; three consecutive years of non-use is “prime facie evidence of abandonment.” *See* 15 U.S.C.S § 1127 (2009) (defining “abandoned”).

100. *See* 15 U.S.C.S. § 1114 (LexisNexis 2010) (setting forth cause of action and remedies for trademark infringement of registered trademarks); *see also Comedy III Prods. Inc. v. New Line Cinema*, 200 F.3d 593, 594 (9th Cir. 2000) (“In order to prevail on a Lanham Act claim, a plaintiff must prove the existence of a trademark and the subsequent use of that mark by another in a manner likely to create consumer confusion.”); *Arrow*, 59 F.3d at 390 (explaining elements of Lanham Act claim). Those two elements of a Lanham Act claim are known as the “validity” and “infringement” prongs. *See Comedy III*, 200 F.3d at 594 (noting two prongs of Lanham Act).

101. *See Time, Inc. v. Petersen Publ. Co.*, 173 F.3d 113, 117 (2d Cir. 1999) (explaining 15 U.S.C. § 1114(1) - Section 32(1) - prohibits misappropriation of

trademark ownership rights, registration of a mark serves as prime facie evidence of trademark ownership.¹⁰² A defendant, however, may rebut that “presumption of ownership with evidence establishing its own prior use in commerce of the registered mark.”¹⁰³

The second element of a Lanham Act claim requires courts to undertake a “likelihood of confusion” analysis.¹⁰⁴ Courts must determine whether “numerous ordinary prudent purchasers are likely to be misled or confused as to the source of the product in question because of the entrance in the marketplace of defendant’s mark.”¹⁰⁵ To evaluate likelihood of confusion, the Circuit Courts have developed various tests. The Second Circuit applies the following eight factors, which are known as the *Polaroid* factors:

- (1) strength of the mark;
- (2) degree of similarity between the two marks;
- (3) proximity of the products;
- (4) likelihood that the trademark holder will “bridge the gap” (*i.e.* likelihood that trademark holder will enter into the market of the alleged infringer);
- (5) actual confusion;
- (6) defendant’s good faith in adopting the mark;
- (7) quality of the defendants’ product; and

registered trademarks and § 1125(a)(1) - Section 43(a) - prohibits misappropriation of unregistered trademarks). Trademarks are registered with the United States Patent and Trademark Office. *See* 15 U.S.C.S. § 1051(a)(1) (“The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office . . .”).

102. *See* 15 U.S.C.S. § 1057(b) (LexisNexis 2010).

A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

Id.; 15 U.S.C.S. § 1115(a) (establishing evidentiary standard that registration is prime facie evidence of trademark validity and ownership); *see also* Dep’t of Parks & Rec. v. Bazaar Del Mundo, Inc., 448 F.3d 1118, 1124 (9th Cir. 2006) (explaining registration of trademark is prime facie evidence of trademark ownership).

103. *See Bazaar Del Mundo*, 448 F.3d at 1124.

104. *See Arrow*, 59 F.3d at 390-91 (explaining likelihood of confusion analysis).

105. *Id.*

(8) sophistication of the buyers.¹⁰⁶

The Ninth Circuit's applies a similar set of factors to determine likelihood of confusion, known as the *Sleekcraft* factors.¹⁰⁷ Other circuits have also adopted similar multi-prong evaluations to analyze likelihood of confusion.¹⁰⁸ These factors, however, are not exclusive, and "[o]ther variables may come into play depending on the particular facts presented."¹⁰⁹

Liability under the Lanham Act is not limited to the misappropriation of a trademark in commercial activities. Though the statutory language of the Lanham Act only imposes liability for the unauthorized use of a trademark "in commerce," that phrase is simply a description of federal courts' jurisdiction over acts that Congress may regulate pursuant to the Constitution's Commerce Clause.¹¹⁰ Furthermore, the Lanham Act also may apply to unau-

106. *Id.* at 391 ("Under the law of this Circuit, courts deciding whether a plaintiff has established likelihood of confusion must consider the eight factors elaborated by Judge Friendly in *Polaroid Corp. v. Polaroid Elecs. Corp.* . . ."); see also *Polaroid Corp. v. Polaroid Elecs., Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), *cert. denied*, 368 U.S. 820 (1961) (establishing Second Circuit likelihood of confusion factors).

107. See *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979) (listing likelihood of confusion factors). The *Sleekcraft* factors are as follows:

- (1) strength of the mark;
- (2) proximity of the goods;
- (3) similarity of the marks;
- (4) evidence of actual confusion;
- (5) marketing channels used;
- (6) type of goods and the degree of care likely to be exercised by the purchaser;
- (7) defendant's intent in selecting the mark;
- (8) likelihood of expansion of the product lines.

Id.; see also *Dr. Seuss Enters., L.P.*, 109 F.3d at 1404 ("The eight-factor *Sleekcraft* test is used in the Ninth Circuit to analyze the likelihood of confusion question in all trademark infringement cases, both competitive and non-competitive.").

108. The First Circuit's likelihood of confusion factors are known as the *Pignons* factors. See *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981) (setting forth *Pignons* factors). The Sixth Circuit adopted the *Sleekcraft* Factors. See *Frisch's Rests., Inc. v. Elby's Big Boy of Steubenville, Inc.*, 670 F.2d 642, 648 (6th Cir.1982) (adopting *Sleekcraft* Factors). The Eight Circuit's likelihood of confusion factors are known as the *SquirtCo* factors. See *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 399 (8th Cir. 1987) (applying the Eight Circuit's *SquirtCo* factors (citing *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980))).

109. *Sleekcraft*, 599 F.2d at 348 n.11.

110. See *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.* 128 F.3d 86, 92 (2d Cir. 1997) ("The history and text of the Lanham Act show that 'use in commerce' reflects Congress's intent to legislate to the limits of its authority under the Commerce Clause, rather than to limit the Lanham Act to profit-seeking uses of a trademark."); *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 694 (N.D. Ohio 2002) ("Put simply, the 'commercial and in commerce' provision contained in 15 U.S.C. § 1125(c)(1) 'denotes Congress's authority under the Com-

thorized uses of trademarks in political speech.¹¹¹ Courts view the intentional confusion of the electorate regarding the source of political material to be very dangerous to the political process.¹¹²

merce Clause, rather than an intent to limit the Lanham Act's application to profitmaking activity.'" (quoting *United We Stand Am.*, 128 F.3d at 92-93)); see also *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, No. 97-0629, 1997 U.S. Dist. LEXIS 3338, at *10 (S.D.N.Y. Mar. 19, 1997) ("The 'use in commerce' requirement of the Lanham Act is a jurisdictional predicate to any law passed by Congress"). The Supreme Court has also held that "the Lanham Act defines 'commerce' as 'all commerce which may lawfully be regulated by Congress,' thereby 'conferring broad jurisdictional powers upon the courts of the United States.'" *Hagan*, 266 F. Supp. 2d at 695 (quoting *Steele v. Bulova Watch Co.*, 344 U.S. 280, 283-84 (1952)).

111. See, e.g., *United We Stand*, 128 F.3d at 92 (holding Lanham Act applied to defendant's unauthorized use of plaintiff's mark for political purposes); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 28 (1st Cir. 1987) ("Commercial advertising slogans, which can be registered as trademarks, have become part of national political campaigns."); *Hagan*, 266 F. Supp. 2d at 700 ("[I]n the marketplace of ideas — use of another's trademark to identify the source of your own political views is simple trademark infringement."); *Brach Van Houten Holding, Inc. v. Save Brach's Coal. For Chi.*, 856 F. Supp. 472, 475-76 (N.D. Ill. 1994) (holding "soliciting donations, preparing press releases, holding public meetings and press conferences, propounding proposals for the reorganization of [the plaintiff's] ownership and/or management, and other activities designed to bring about change in the [plaintiff's] organization and enhance the stability of workers' jobs" are "services" to which Lanham Act applies); *MGM-Pathe Commc'ns Co. v. Pink Panther Patrol*, 774 F. Supp. 869, 877 (S.D.N.Y. 1991) ("The seriousness and virtue of a cause do not confer any right to the use of the trademark of another."); *Planned Parenthood*, 1997 U.S. Dist. LEXIS 3338, at *14 (holding Lanham Act applied to defendant even though defendant had "a political motive" for using plaintiff's mark); *Order Denying Defendants' Motion to Dismiss* at 5, *Henley v. DeVore*, 210 U.S. Dist. LEXIS 67987 (C.D. Cal. 2009) (No. 09-0481) [hereinafter *Henley Motion to Dismiss Decision*] (explaining "political activities may constitute services" under Lanham Act). But see *Tax Cap Comm. v. Save Our Everglades, Inc.*, 933 F. Supp. 1077, 1081 (S.D. Fla. 1996) (denying motion for emergency preliminary injunction and dismissing Lanham Act claim for lack of subject matter jurisdiction because court held solicitation of signatures as part of campaign to amend state constitution did not constitute services "being rendered in commerce" for purpose of Lanham Act jurisdiction).

112. See, e.g., *United We Stand*, at 128 F.3d at 90 ("The resulting confusion [due to different organizations employing the same trade name to endorse candidates] would be catastrophic; voters would have no way of understanding the significance of an endorsement or position taken by parties of recognized major names."); *Browne v. McCain*, 611 F. Supp. 2d 1073, 1079 (C.D. Cal. 2009) ("Indeed, the [Lanham] Act's purpose of reducing consumer confusion supports application of the Act to political speech, where the consequences of widespread confusion as to the source of such speech could be dire"); *Tomei v. Finley*, 512 F. Supp. 695, 696-97 (N.D. Ill. 1981) (granting preliminary injunction precluding organization affiliated with Democratic Party from running candidates under party name "Representation for Every Person Party" and using slogan "Vote REP April 7" in "Republican stronghold"). Strongly voicing its disapproval, the court in *Tomei v. Finley* said that the defendant's deceptive political tactic was "a page from the Watergate book of 'dirty tricks,'" an "impermissible distortion" of the First Amendment's protections, and the kind of "lie" the Supreme Court held to be unprotected by the First Amendment. *Tomei*, 512 F. Supp. at 698 (citing *Garrison v. La.*, 379 U.S. 64, 75 (1964)).

3. *False Association or Endorsement Liability under the Lanham Act*

Section 43(a) of the Lanham Act extends liability for trademark misappropriation beyond consumer confusion as to source identification.¹¹³ Under Section 43(a), trademark owners are protected against the misappropriation of their trademarks if the misappropriation (1) is likely to cause consumer confusion by creating a false association with or endorsement by the trademark holder or (2) constitutes false advertising.¹¹⁴ Accordingly, trademark rights protect against consumer confusion regarding a “plaintiff’s sponsorship or approval of defendant or defendant’s products.”¹¹⁵ Courts consider the same likelihood of confusion factors when determining liability for false association, endorsement, or advertising as they do when determining liability for consumer confusion regarding the source of trademarked goods.¹¹⁶ In 1995, the Federal Trademark Dilution Act created liability for trademark misappropriation that causes “dilution by blurring or dilution by tarnish-

113. See William McGeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV 49, 57 (2008) (explaining significance of Section 43(a)’s expansion of trademark rights).

114. See 15 U.S.C.S. 1125(a)(1) (LexisNexis 2010) (codifying liability for false affiliation and false advertising by unauthorized use of trademarks). Though the text of Section 43(a) only lists false “affiliation, connection, or association” as grounds for liability, courts have interpreted Section 43(a) as extending liability to false endorsement. See, e.g., *Parks v. LaFace Records*, 329 F.3d 437, 445 (6th Cir. 2003) (explaining liability under Section 43(a) includes unauthorized use of trademarks resulting in consumer confusion as to “sponsorship or approval”); *EMI Catalogue P’ship v Hill, Holliday, Connors, Cosmopolulos Inc.*, No. 99-7022, 2000 U.S. App. LEXIS 30761, at *10 (2d Cir. Jan. 24, 2000) (“If consumers believe that the trademark owner sponsors or endorses the use of the challenged mark, the confusion requirement is satisfied [under Section 43(a)].”); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1107 (9th Cir. 1992) (interpreting Section 43(a) as encompassing false endorsements created by unauthorized appropriation of protected trademarks); *Brach Van Houten Holding, Inc. v. Save Brach’s Coal. for Chi.*, 856 F. Supp. 472, 475 (N.D. Ill. 1994) (“[T]he Lanham Act is concerned not only with confusion over the source of goods but also with deceptive appearances of approval.”).

115. McGeveran, *supra* note 113, at 57 (explaining significance of Section 43(a)’s expansion of trademark rights) (internal quotations omitted).

116. See *Time, Inc. v. Petersen Publ. Co.*, 173 F.3d 113, 117 (2d Cir. N.Y. 1999) (explaining likelihood of confusion standards for claims brought under Section 43(a)); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992) 1400 (applying *Sleekcraft* Factors to decide false endorsement claim brought under Section 43(a)); *MasterCard Int’l, Inc. v. Nader 2000 Primary Comm., Inc.*, No. 00-6068, 2004 U.S. Dist. LEXIS 3644, at *6-7 (S.D.N.Y. Mar. 8, 2004) (applying *Polaroid* Factors to decide false endorsement claim brought under Section 43(a)); *Parks v. LaFace Records*, 329 F.3d 437, 446-48 (6th Cir. 2003) (discussing application of *Sleekcraft* Factors when determining liability under Section 43(a)).

ment.”¹¹⁷ The Federal Trademark Dilution Act of 1995, however, exempted noncommercial uses of trademarks from liability.¹¹⁸

Lanham Act protections under Section 43(a) are not only invoked by marketplace competitors.¹¹⁹ A celebrity can own trademark rights for his or her identity or persona, for which he or she has “an economic interest . . . akin to that of” a commercial trademark holder.¹²⁰ Likewise, the Lanham Act also protects distinctive attributes, such as a singer’s voice or a celebrity’s physical appearance.¹²¹ Accordingly, celebrities and well-known individuals have filed Lanham Act claims for false association, endorsement, or advertising against companies that used their identities or personas for commercial purposes.¹²² When analyzing the likelihood of confusion factors in Lanham Act cases involving celebrities, courts examine the “level of recognition that the celebrity enjoys among members of society” to determine the “strength of the plaintiff’s mark.”¹²³ Likewise, the “relatedness or proximity of the products” refers to “the reasons for or source of the plaintiff’s fame.”¹²⁴

In *Nader*, MasterCard brought the following Lanham Act claims: (1) false endorsement pursuant to Section 43(a); (2) the unauthorized use of its federally registered trademark pursuant to Section 32(1); and (3) trademark dilution pursuant to the Section

117. 15 U.S.C.S. § 1125(c) (codifying trademark protections for trademark dilution); see also McGeveran, *supra* note 113, at 57 (discussing expansion of trademark rights). Dilution occurs when the unauthorized use of a trademark “bring[s] to mind two products, not one.” *Hagan*, 266 F. Supp. 2d at 692.

118. See 15 U.S.C.S. § 1125(c)(3)(C) (exempting any “noncommercial use of a mark” from liability for trademark dilution); see also *Nader*, 2004 U.S. Dist. LEXIS 3644, at *22 (“The Federal Trademark Dilution Act specifically exempts noncommercial uses of a mark from its coverage.”).

119. See *Zimdahl*, *supra* note 85, at 1824 (“However, the scope of section 43(a) is broad enough that it extends beyond disputes between commercial competitors.”).

120. See *Parks*, 329 F.3d at 445 (discussing celebrities’ trademark rights and economic interests in their identities (citing *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992))); see also *Abdul-Jabbar v. GMC*, 85 F.3d 407, 410 (9th Cir. 1996) (explaining Lanham Act claims for false endorsement “based on the unauthorized use of a celebrity’s identity” is actionable as trademark infringement); *White*, 971 F.2d at 1400 (“In cases involving confusion over endorsement by a celebrity plaintiff, ‘mark’ means the celebrity’s persona.”).

121. See *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1107 (9th Cir. 1992) (holding Section 43(a) recognizes false endorsements claims “premised on the unauthorized imitation of an entertainer’s distinctive voice” or physical appearance).

122. See, e.g., *Parks*, 329 F.3d at 441 (involving Civil Rights Movement hero Rosa Parks); *Abdul-Jabbar*, 85 F.3d at 409 (involving basketball legend Kareem Abdul-Jabbar); *White*, 971 F.2d at 1396 (involving television celebrity Vanna White).

123. See *Zimdahl*, *supra* note 85, at 1829 (analyzing likelihood of confusion factors in celebrity cases).

124. *Id.*

43(c).¹²⁵ There were two MasterCard trademarks at issue in *Nader*: (1) “There are some things money can’t buy. For everything else there’s MasterCard.”; and (2) “Priceless.”¹²⁶ After balancing the *Polaroid* factors, the court held that there was no likelihood of confusion between the two advertisements.¹²⁷ Thus, the Nader campaign was not liable for trademark dilution because the Nader Advertisement was political rather than commercial, placing the Advertisement outside the scope of the Federal Trademark Dilution Act’s.¹²⁸

C. First Amendment Doctrines Applicable to Political Campaigns and Intellectual Property Law

1. *First Amendment’s Protection of Political and Commercial Speech*

The two types of speech that are relevant to disputes involving the unauthorized use of intellectual property by political candidates are core political speech and commercial speech.¹²⁹ Core political speech relates to public issues, the conduct of government, and elections.¹³⁰ Commercial speech is speech that is “related solely to the economic interests of the speaker and its audience.”¹³¹

125. See *MasterCard Int’l, Inc. v. Nader 2000 Primary Comm., Inc.*, No. 00-6068, 2004 U.S. Dist. LEXIS 3644, at *3-4 (S.D.N.Y. Mar. 8, 2004) (listing trademark claims).

126. *Id.* at *5.

127. See *id.* at *14 (holding Nader campaign did not violate Lanham Act).

128. See *id.* at *28 (holding Nader Advertisement to be exempt from liability under Federal Trademark Dilution Act). In the alternative, the court held that MasterCard failed to meet its burden of proving that the Nader Advertisements diluted the distinctiveness of its trademarks. See *id.* at *29 (asserting court’s finding). For a further discussion of the noncommercial nature of the Nader Advertisement, see *infra* notes 147-58 and accompanying text.

129. See Rumpfelt, *supra* note 38, at 398-99 (discussing First Amendment inquiries in context of intellectual property disputes). Rumpfelt argues that “where core political speech is at issue, the First Amendment provides a more appropriate governing analysis than any intellectual property test.” *Id.* at 416.

130. See *McIntyre v. Ohio Elections Comm’n*, 514 U.S. 334, 346-47 (1995) (describing core political speech as “[d]iscussion of public issues,” “debate on the qualifications of candidates,” “discussion of governmental affairs,” and “conduct of campaigns for political office” (citing *Buckley v. Valeo*, 424 U.S. 1, 14-15 (1976) (per curiam))); see also BLACK’S LAW DICTIONARY, *supra* note 30, at 1276-77 (defining “political” and “politics”). Though political speech is commonly thought of as relating to political campaigns and petitions, election referendums also fall under the category of “core political speech.” See *McIntyre*, 514 U.S. at 347 (explaining scope of First Amendment’s protection of core political speech).

131. *Cent. Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557, 561 (1980) (defining commercial speech); see also *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council*, 425 U.S. 748, 762 (1976) (defining commercial speech as that which “does no more than propose a commercial transaction” (internal quotations omitted)).

Governmental and judicial restrictions on political speech and campaigns operate in “an area of the most fundamental First Amendment activities”¹³² because the “role that elected officials play in our society makes it all the more imperative that they be allowed freely to express themselves on matters of current public importance.”¹³³ As the Supreme Court noted in the landmark election-law case *Buckley v. Valeo*,¹³⁴ the First Amendment “has its fullest and most urgent application precisely to the conduct of campaigns for political office.”¹³⁵ Accordingly, courts review infringements on core political speech under the highest constitutional standard—exact scrutiny.¹³⁶ When applying exacting scrutiny, courts will only uphold regulations that are “narrowly tailored to serve an overriding state interest.”¹³⁷ For commercial speech, the Constitution “accords a lesser protection . . . than [it does for] other constitutionally guaranteed expression.”¹³⁸

In *American Family Life Insurance Co. (AFLAC) v. Hagan*,¹³⁹ the District Court for the Northern District of Ohio addressed the distinction between commercial and core political speech in the con-

132. *Keep Thompson Governor Comm. v. Citizens for Gallen Comm.*, 457 F. Supp. 957, 959-60 (D.N.H. 1978) (cautioning courts must proceed very carefully when limiting speech in political campaigns (citing *Buckley v. Valeo*, 424 U.S. 1, 14-15 (1976) (per curiam))).

133. *Republican Party of Minn. v. White*, 536 U.S. 765, 781-82 (2002) (involving dispute over Minnesota Supreme Court’s canon of judicial conduct prohibiting candidates for judicial office from announcing their “views on disputed legal or political issues”).

134. 424 U.S. 1 (1976).

135. *Id.* at 15 (discussing general First Amendment principles). In *Buckley v. Valeo*, the Supreme Court upheld the individual campaign contribution limits, disclosure requirements, and public financing system for presidential elections under the Federal Election Campaign Act of 1971, but held that the Act’s limits on campaign expenditures, independent expenditures by individuals and groups, as well as, personal campaign expenditures by candidates were unconstitutional. *See id.* at 143 (setting forth holding).

136. *See McIntyre v. Ohio Elections Comm’n*, 514 U.S. 334, 347 (1995) (“When a law burdens core political speech, we apply ‘exacting scrutiny,’ and we uphold the restriction only if it is narrowly tailored to serve an overriding state interest.”).

137. *Id.* In cases involving core political speech, the burden is on the government to show the existence of an overriding state interest. *See First Nat’l Bank v. Bellotti*, 435 U.S. 765, 786 (U.S. 1978) (“[T]he burden is on the government to show the existence of such an interest.” (quoting *Elrod v. Burns*, 427 U.S. 347, 362 (1976))).

138. *Cent. Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557, 563 (1980) (analyzing constitutional standard for protection of commercial speech).

139. 266 F. Supp. 2d 682 (N.D. Ohio 2002).

text of a political campaign.¹⁴⁰ In *Hagan*, the campaign of Ohio gubernatorial candidate Tim Hagan posted an internet advertisement featuring a “crudely animated character made up of [his opponent] Governor Taft’s head sitting on the body of a white cartoon duck,” which quacks “TaftQuack several times during each commercial” (the “Hagan Advertisement”).¹⁴¹ The figure in the Hagan Advertisement resembled the well-known quacking duck in AFLAC’s insurance commercials.¹⁴² The Hagan Advertisement also solicited campaign donations through an internet link.¹⁴³ The court held that, for the purposes of the Federal Trademark Dilution Act’s exemption on noncommercial uses of trademarks, the solicitation of contributions by the Hagan Advertisement was “completely noncommercial political speech.”¹⁴⁴ The court opined that it was “arguable whether Hagan’s speech propose[d] a commercial transaction at all.”¹⁴⁵ Rather, the Hagan Advertisement discussed “public issues and challenge[d] the qualifications of a political candidate.”¹⁴⁶

In *Nader*, the S.D.N.Y. found the *Hagan* court’s reasoning to be “persuasive,” holding the *Nader* Advertisement exempt from liability under the Federal Trademark Dilution Act because its use of MasterCard’s trademarks was political in nature.¹⁴⁷ Additionally, the court applied the reasoning in its trademark dilution analysis to hold that the *Nader* Advertisement was noncommercial for the purpose of fair use.¹⁴⁸

140. *See id.* at 695-97 (analyzing whether speech at issue was commercial or noncommercial).

141. *Id.* at 685.

142. *See id.* at 686 (describing similarities between sound of duck in Hagan Advertisement and trademarked duck sound in AFLAC’s advertisements).

143. *See id.* at 697 (describing internet link for viewers to donate to Hagan campaign).

144. *Id.*; *see also* Federal Election Com’n v. Colorado Republican Fed. Campaign Comm., 533 U.S. 431, 440 (2001) (“Spending for political ends and contributing to political candidates both fall within the First Amendment’s protection of speech and political association.”).

145. *Hagan*, 266 F. Supp. 2d at 697.

146. *Id.*

147. *See* MasterCard Int’l, Inc. v. Nader 2000 Primary Comm., Inc., No. 00-6068, 2004 U.S. Dist. LEXIS 3644, at *23-28 (S.D.N.Y. Mar. 8, 2004) (holding *Nader* Advertisement was political in nature).

148. *See id.* at *37 (“As this Court has already discussed, the [*Nader* Advertisement’s] use is not commercial.”); *see also* Keep Thompson Governor Comm. v. Citizens for Gallen Comm., 457 F. Supp. 957, 961 (D.N.H. 1978) (holding defendant’s campaign advertisement that incorporated plaintiff’s copyrighted was “clearly part of a political campaign message, noncommercial in nature, and First Amendment issues of freedom of expression in a political campaign are clearly implicated”).

MasterCard argued that the Nader Advertisement was commercial in nature because contributions to the Nader campaign increased after the internet version of the Nader Advertisement, which contained a “Donate On-line” link, was released.¹⁴⁹ The court rejected that argument on two grounds.¹⁵⁰ First, MasterCard provided “no evidence of a causal connection between the [Nader Advertisement] and the contributions.”¹⁵¹ Alternatively, even if the Nader Advertisement did spur an increase in donations to the Nader campaign, the court would have still held that the Nader Advertisement was political in nature.¹⁵² The court opined that the Nader Advertisement conveyed a “strong political message”- Nader’s opinion that “other presidential candidates can be bought, but that the ‘truth,’ represented by himself, cannot.”¹⁵³

The court warned that if it held the Nader Advertisement to be commercial in nature solely because the advertisement increased campaign contributions, “all political campaign speech would also be ‘commercial speech’ since all political candidates collect contributions.”¹⁵⁴ Such a holding would be inconsistent with the Lanham Act’s legislative history, which “clearly indicates that Congress did not intend for the Act to chill political speech.”¹⁵⁵ The court also quoted the following from the legislative history of the Act: “Political advertising and promotion is political speech, and therefore not encompassed by the [Lanham Act’s] term ‘commercial.’”¹⁵⁶ Accordingly, viewing this case as analogous to *Hagan*, the court held that the Nader Advertisement use of MasterCard’s trademarks was political in nature.¹⁵⁷ The court further supported its finding that the Nader Advertisement was political in nature in its fair use analy-

149. *See Nader*, 2004 U.S. Dist. LEXIS 3644, at *23 (explaining MasterCard’s argument that Nader’s Advertisement was commercial in nature). Donations to the Nader campaign rose from \$5,125 before the Nader Advertisement aired to \$818,000 in the month that it aired. *See id.* (noting effect of advertisement on donations).

150. *See id.* at *23-28 (rejecting MasterCard’s assertion that Nader’s Advertisement was commercial in nature).

151. *Id.* at *23 (“There is nothing in the record other than the inference to be drawn from the proximity in time that advances the notion that the contributions Ralph Nader and his political committee received were a direct result of the Ad.”).

152. *See id.* at *23-24 (explaining why Nader Advertisement was political in nature).

153. *Id.* at *24 (stating Nader Advertisement’s political message).

154. *Id.* at *23-24.

155. *Id.* at *24.

156. *Id.* (quoting 134 CONG. REC. H. 1297 (daily ed. Apr. 13, 1989) (statement of Wisc. Rep. Kastenmeier)).

157. *See id.* at *26-28 (holding Nader campaign’s use of MasterCard’s trademarks was political in nature and analogizing case to *Hagan*).

sis, opining that the Nader Advertisement's stated purpose was to "raise public awareness of Ralph Nader's desire to be included in the upcoming televised Presidential candidate debates."¹⁵⁸

2. *First Amendment's Impact on the Copyright Act*

The Copyright Clause and the First Amendment are "intuitively in conflict" because of the contrary interests that they protect.¹⁵⁹ In *Eldred v. Ashcroft*,¹⁶⁰ however, the Supreme Court explained that free speech protections are embodied in copyright law.¹⁶¹ Because the First Amendment and Copyright Clause were adopted within a few years of each other, the Court reasoned that the Framers viewed "copyright's limited monopolies" to be "compatible with free speech principles."¹⁶² The Court further explained that copyrights promote free expression and dissemination of ideas by "establishing a marketable right to the use of one's expression."¹⁶³

Additionally, the Court identified the Copyright Act's "built-in First Amendment accommodations."¹⁶⁴ The Copyright Act precludes copyright ownership of ideas, facts and concepts while protecting the expression of such ideas, facts and concepts, which is known as the "idea/expression dichotomy."¹⁶⁵ The idea/expression dichotomy "strikes a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression"; it allows the ideas, theories and facts behind copyrighted works to be "instantly available for public exploitation at the moment of publication."¹⁶⁶ Furthermore, the Court reasoned that the fair use defense

158. *Id.* at 37.

159. *See* *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1263 (11th Cir. 2001) (explaining inherent conflict between Copyright Clause and First Amendment).

160. 537 U.S. 186 (2003).

161. *See id.* at 218-21 (evaluating relationship between copyright law and free speech).

162. *Id.* at 219 (discussing original intent behind Copyright Clause).

163. *Id.* (discussing free speech protections inherent in copyright law).

164. *Id.* (explaining First Amendment protections contained in Copyright Act).

165. *See* 17 U.S.C.S. § 102(b) (LexisNexis 2010) ("In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work."); *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985) (referring to copyright law's protection of expression and lack of protection of facts and ideas as "copyright's idea/expression dichotomy").

166. *Eldred*, 537 U.S. at 219 (citing *Harper & Row*, 471 U.S. at 556).

protects the First Amendment rights of copyright users, “allow[ing] the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances.”¹⁶⁷

Because First Amendment protections are such an integral part of copyright law, most courts do not conduct a separate First Amendment analysis when adjudicating copyright infringement claims.¹⁶⁸ In *Eldred*, the Court held that heightened judicial scrutiny under the First Amendment was not warranted to determine the constitutionality of the Copyright Term Extension Act, which extended the duration of copyright ownership by twenty years.¹⁶⁹ The Court did acknowledge that copyrights are not “categorically im-

167. *Id.* at 219-20.

168. Rumfelt, *supra* note 38, at 408 (“The majority of [copyright] cases, especially those decided in recent years, have taken the view that an independent First Amendment analysis is unnecessary.”); *see also* Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1264-65 (11th Cir. 2001) (“Because of the First Amendment principles built into copyright law through the idea/expression dichotomy and the doctrine of fair use, courts often need not entertain related First Amendment arguments in a copyright case.”); *Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F.3d 65, 74 (2d Cir. 1999) (“We have repeatedly rejected First Amendment challenges to injunctions from copyright infringement on the ground that First Amendment concerns are protected by and coextensive with the fair use doctrine.”); *Keep Thompson Governor Comm. v. Citizens for Gallen Comm.*, 457 F. Supp. 957, 960 (D.N.H. 1978) (“Conflicts between interests protected by the First Amendment and the copyright laws can be resolved by application of the fair use doctrine.”). *But see* Los Angeles News Serv. v. Tullo, 973 F.2d 791, 796 (9th Cir. 1992) (leaving open possibility that First Amendment could preclude liability for copyright infringement in limited circumstances when expression, not idea, is only aspect of work that is meaningful to “democratic dialogue” (citing 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 1.10[C][2] (1992 ed.))); *Pac. & S. Co. v. Duncan*, 744 F.2d 1490, 1498-1500 (11th Cir. 1984) (engaging in separate, albeit brief, First Amendment analyses to determine copyright infringement liability of defendant and whether injunction was proper remedy). In *Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc.*, 626 F.2d 1171 (5th Cir. 1980), the Fifth Circuit declined to review whether the First Amendment provided a defense to a copyright infringement claim. *See id.* at 1172. (asserting 5th Circuit holding). The district court had held that the unauthorized copyright appropriation at issue was protected by the First Amendment even though it was not fair use under the Copyright Act. *See id.* at 1173 (noting district court holding); *see also* Triangle Publ’ns, Inc. v. Knight-Ridder Newspapers, Inc., 445 F. Supp. 875, 881, 883-85 (S.D. Fla. 1978), *aff’d* on other grounds, 626 F.2d 1171 (5th Cir. 1980) (“Hence, there is a conflict between the First Amendment and the Copyright Act, if as the plaintiff contends, the Act should be applied in the case *sub judice* to strike down defendant’s activity.”). The Fifth Circuit affirmed the district court’s decision on different grounds, holding that the defendant’s use of the plaintiff’s copyright was fair use. *Triangle Publ’ns*, 626 F.2d at 1178. Accordingly, the court held that it was not necessary to evaluate whether the First Amendment provided a constitutional defense to the plaintiff’s copyright infringement claim. *Id.* (“The majority concludes that we need not, and should not, reach the First Amendment issue.”).

169. *See Eldred*, 537 U.S. at 221 (holding Copyright Term Extension Act to be constitutional under First Amendment).

mune from challenges under the First Amendment.”¹⁷⁰ The Court explained that copyright law’s “built-in free speech safeguards are generally adequate to address” infringements on free speech resulting from copyright ownership.¹⁷¹ Accordingly, the Court held that when, as in *Eldred*, “Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.”¹⁷² Likewise, in *Harper & Row Publishers, Inc. v. Nation Enterprises*,¹⁷³ the Court rejected the respondents’ argument that, under the First Amendment, the “substantial public import” of certain copyrighted material excuses “a use that would ordinarily not pass muster as a fair use.”¹⁷⁴ The Court held that the “First Amendment protections already embodied” in the Copyright Act did not justify “expanding the doctrine of fair use to create what amounts to a public figure exception to copyright.”¹⁷⁵

3. *First Amendment’s Impact on the Lanham Act*

The First Amendment’s can provide a defense to a Lanham Act claim in a case involving the unauthorized use of a trademark for a communicative purpose.¹⁷⁶ Though the unauthorized use of a trademark in political speech does not preclude Lanham Act liability per se,¹⁷⁷ the Lanham Act should not be used to “chill political

170. *Id.* (“We recognize that the D.C. Circuit spoke too broadly when it declared copyrights ‘categorically immune from challenges under the First Amendment.’” (citing *Eldred v. Reno*, 239 F.3d 372, 375 (D.C. Cir. 2001), *aff’d sub nom. Eldred v. Ashcroft*, 537 U.S. 186 (2003))).

171. *Id.*

172. *Id.*

173. 471 U.S. 539 (1985).

174. *Id.* at 555-56, 560 (rejecting exception to copyright ownership rights if unauthorized appropriation does not qualify as fair use). In *Harper & Row*, the copyrighted material of “substantial public import” was excerpts from the memoirs of former President Gerald Ford, which contained President Ford’s reflections on the, *inter alia*, the Watergate crisis, his pardon of former President Nixon, and his reflections on “this period of history, and the morality and personalities involved.” *Id.* at 542-43.

175. *Id.* at 560.

176. *See* McGeveran, *supra* note 113, at 98 (noting that courts sometimes “entertain[] a ‘First Amendment defense’ for expressive uses” of trademarks); *see, e.g.*, *Parks v. LaFace Records*, 329 F.3d 437, 447-52 (6th Cir. 2003) (analyzing applicability of First Amendment to Lanham Act claims involving artistic expression “even if [the] evidence demonstrates some likelihood of confusion”); *Rogers v. Grimaldi*, 875 F.2d 994, 997-1000 (2d Cir. 1989) (analyzing First Amendment’s application to Lanham Act disputes when unauthorized use of trademark contains artistic expression); *Brach Van Houten Holding, Inc. v. Save Brach’s Coal. for Chi.*, 856 F. Supp. 472, 476 (N.D. Ill. 1994) (explaining First Amendment’s relevance to Lanham Act disputes when unauthorized use of trademark contains communicative messages).

177. *See* *Browne v. McCain*, 611 F. Supp. 2d 1073, 1080 (C.D. Cal. 2009) (“In fact, courts that have applied the Lanham Act to noncommercial and political

speech.”¹⁷⁸ For trademark dilution claims in particular, political speech is fully protected because the Federal Trademark Dilution Act specifically excludes noncommercial uses of trademarks from liability.¹⁷⁹

As a threshold matter, the First Amendment only provides a defense to a Lanham Act claim if the alleged infringer used the trademark to convey a communicative message, not if the alleged infringer used the trademark for source identification.¹⁸⁰ To determine if enforcing the Lanham Act violates the First Amendment

speech have implicitly rejected the theory that claims based on such speech are barred, as a matter of law, based on the First Amendment”); *see, e.g.*, *United We Stand Am., Inc. v. United We Stand, Am., N.Y., Inc.* 128 F.3d 86, 93 (2d Cir. 1997) (holding defendant’s unauthorized use of plaintiff’s trademarked name was not protected by First Amendment even though trademarked name was used for political purpose); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) (explaining “protection afforded by the First Amendment does not give [the defendant] license to infringe” plaintiff’s trademark rights even though defendant used plaintiff’s logo in political speech regarding nuclear weapons); *MGM-Pathé Comm’ns Co. v. Pink Panther Patrol*, 774 F. Supp. 869, 877 (S.D.N.Y. 1991) (rejecting defendant’s argument that unauthorized use of trademark in political speech reduces Lanham Act protections for trademark owner).

178. *See* *MasterCard Int’l, Inc. v. Nader 2000 Primary Comm., Inc.*, No. 00-6068, 2004 U.S. Dist. LEXIS 3644, at *24 (S.D.N.Y. Mar. 8, 2004) (“The legislative history of the Lanham Act clearly indicates that Congress did not intend for the Act to chill political speech.”); *see also* *Rogers*, 875 F.2d at 998 (“Because overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict.”).

179. *See* 15 U.S.C.S. § 1125(c)(3)(C) (LexisNexis 2010) (exempting “[a]ny noncommercial use of a mark” from liability for trademark dilution); *see also* *Nader*, 2004 U.S. Dist. LEXIS 3644, at *22 (explaining liability under Federal Trademark Dilution Act).

180. *See, e.g., United We Stand*, 128 F.3d at 93 (holding First Amendment did not protect defendant’s unauthorized use of plaintiff’s mark for political purposes because it was used for source identification rather than for commentary on mark’s owner); *Morrison & Foerster LLP v. Wick*, 94 F. Supp. 2d 1125, 1135 (D. Colo. 2000) (holding defendant’s use of plaintiff’s trademark in his domain name was not protected by First Amendment because use lacked any communicative message and was “analogous to source identification”); *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, No. 97-0629, 1997 U.S. Dist. LEXIS 3338, at *35 (S.D.N.Y. Mar. 19, 1997) (“Defendant’s use of another entity’s mark is entitled to First Amendment protection when his use of that mark is part of a communicative message, not when it is used to identify the source of a product.”); *Brach Van Houten Holding*, 856 F. Supp. at 476 (“[T]he trademark law generally prevails over the First Amendment where the trademark functions to connote the source of the product or message, rather than being used in a communicative message.”); *Yankee Publ’g, Inc. v. News Am. Publ’g, Inc.*, 809 F. Supp. 267, 276 (S.D.N.Y. 1992).

When another’s trademark (or a confusingly similar mark) is used without permission *for the purpose of source identification*, the trademark law generally prevails over the First Amendment. . . .

However, when unauthorized use of another’s mark is part of a communicative message and not a source identifier, the First Amendment is implicated in opposition to the trademark right.

Id.

rights of the alleged infringer, courts generally apply one of three tests: (1) the “likelihood of confusion” test; (2) the “alternative avenues” test; or (3) the *Rogers v. Grimaldi*¹⁸¹ test, which is commonly known as the *Rogers* or “artistic relevance” test.¹⁸² The federal circuit courts are split as to which test is the proper method for balancing First Amendment and trademark interests, and the Second Circuit has even applied more than one test.¹⁸³

Under the likelihood of confusion test, courts apply a standard likelihood of confusion analysis, such as evaluating the *Polaroid* or *Sleekcraft* factors, without a separate First Amendment analysis.¹⁸⁴ Proponents of this approach argue that “intellectual property law, including trademark law, has built-in mechanisms that operate to avoid First Amendment concerns.”¹⁸⁵ The likelihood of confusion test has been inferred from the Ninth Circuit’s Lanham Act analysis in *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*¹⁸⁶ and “obliquely endorsed” by the Tenth Circuit.¹⁸⁷ Critics, however, fault this approach for giving “no weight to First Amendment concerns” because it treats items with artistic expression the same as noncommunicative commercial products.¹⁸⁸

181. 875 F.2d 994 (2d Cir. 1989).

182. See *Parks v. LaFace Records*, 329 F.3d 437, 447 (6th Cir. 2003) (discussing standards courts apply to balance First Amendment and trademark interests); *Browne*, 611 F. Supp. 2d at 1080 (referring to *Rogers* Test as “artistic relevance” test).

183. See Zimdahl, *supra* note 85, at 1820 n.23 (noting circuit split); see also *Rogers*, 875 F.2d at 999 n.4 (establishing artistic relevance test in Second Circuit and distinguishing, but not overruling, previous application of alternative avenues test in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (applying alternative avenues test).

184. See Zimdahl, *supra* note 85, at 1828-29 (describing likelihood of confusion approach).

185. *Id.* at 1829; see also *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003) (differentiating First Amendment protections inherent in traditional infringement determinations from those of trademark dilution determinations by noting trademark infringement’s likelihood of confusion analysis has “built-in First Amendment compass”). The *Mattel* court, however, applied and, thus, implicitly adopted the *Rogers* test. See *id.* at 902 (applying *Rogers* test).

186. 109 F.3d 1394, 1403 (9th Cir. 1997) (“The issue in trademark infringement actions is not the alleged appropriation of [the plaintiff’s] creative expression, but rather, the likelihood of confusion in the market place as to the source of [the alleged infringer’s product]”).

187. See *Parks*, 329 F.3d at 448 (outlining origin of likelihood of confusion test (citing *Films of Distinction, Inc., v. Allegro Film Prods., Inc.*, 12 F. Supp. 2d 1068, 1078 (C.D. Cal. 1998); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996))).

188. See *id.* at 449 (rejecting likelihood of confusion approach); see also Zimdahl, *supra* note 85, at 1830 (explaining arguments against likelihood of confusion approach).

Under the alternative avenues test, enforcing the trademark holder's Lanham Act rights does not violate the First Amendment when there are "sufficient alternative means" of communication available.¹⁸⁹ Courts that apply the alternative avenues test view trademarks as property rights that need not "yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist."¹⁹⁰ Those courts reason that, if alternative means of communication are available, neither the speaker nor the public are deprived the benefit of the speaker's ideas.¹⁹¹ Accordingly, the alternative avenues test is very deferential to the property rights of the trademark holder.¹⁹²

The seminal case for the alternative avenues test is *Lloyd Corp. v. Tanner*.¹⁹³ In *Lloyd Corp.*, anti-war protesters were ejected from a privately-owned shopping mall after they tried to distribute anti-war handbills.¹⁹⁴ Holding that there was no constitutional violation, the Court introduced the fundamental principle of the alternative avenues test.¹⁹⁵ The Court explained that infringing on the mall owner's property rights while the protesters had sufficient alternative means to exercise their First Amendment rights "would diminish property rights without significantly enhancing the asserted right of free speech."¹⁹⁶ The Eighth Circuit is the only circuit to

189. *See Parks*, 329 F.3d at 448 (explaining standard for alternative avenues test).

190. *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) *cert. denied*, 488 U.S. 933 (1988); *see also Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (Same); *Brach Van Houten Holding, Inc. v. Save Brach's Coal. for Chi.*, 856 F. Supp. 472, 476 (N.D. Ill. 1994) (Same).

191. *See Mutual of Omaha Ins. Co.*, 836 F.2d 397 at 402 ("Because the injunction leaves open many such avenues of expression, it deprives neither [the defendant] nor the public of the benefits of his ideas."); *see also Dallas Cowboys Cheerleaders, Inc.*, 604 F.2d at 206 (explaining district court did not infringe on defendants' First Amendment rights by enjoining use of plaintiff's trademark because "numerous" other means of communication were available).

192. *See Rumpfelt, supra* note 38, at 405 (opining alternative avenues test "pays strong deference to a trademark owner's property right").

193. 407 U.S. 551 (1972).

194. *See id.* at 556 (describing dispute).

195. *See id.* at 567 ("It would be an unwarranted infringement of property rights to require [the property owner] to yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist."). The Court's main reason for finding no constitutional violation was that the mall was private property. *See id.* at 570 (holding there was no dedication of "privately owned and operated shopping center to public use as to entitle respondents to exercise therein the asserted First Amendment rights").

196. *Id.* at 567.

have adopted the alternative avenues test as its standard for evaluating First Amendment rights in Lanham Act disputes.¹⁹⁷

The First, Second, Sixth and Tenth Circuits have either rejected or significantly limited the alternative avenues test because, *inter alia*, (1) the test does not sufficiently protect the right to free expression, (2) trademark and real property rights should not be analogized for the purpose of balancing property rights with First Amendment rights and (3) the test could require a court to critically evaluate creative necessity.¹⁹⁸ In *Parks v. LaFace Records*,¹⁹⁹ the Sixth Circuit rejected the alternative avenues test.²⁰⁰ The court noted the “awkwardness of analogizing property rights in land to

197. See *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) *cert. denied*, 488 U.S. 933 (1988) (applying alternative avenues test to Lanham Act dispute); see also *Brach Van Houten Holding, Inc. v. Save Brach’s Coal. for Chi.*, 856 F. Supp. 472, 476 (N.D. Ill. 1994) (applying alternative avenues test to hold First Amendment did not preclude preliminary injunction in Lanham Act dispute). Following *Mutual of Omaha*, the Eighth Circuit applied a balancing test that weighed “the public interest in free expression against the public interest in avoiding consumer confusion,” but the alternative avenues test and balancing approach have been found to be consistent. See *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 734 (D. Minn. 1998) (“The Eighth Circuit has framed the applicable standard in two different, yet consistent, ways.”).

198. See Zimdahl, *supra* note 85, at 1831-32 (outlining courts’ rationale for rejecting alternative avenues test); see, e.g., *Parks v. LaFace Records*, 329 F.3d 437, 450 (6th Cir. 2003) (“To suggest that other words can be used as well to express an author’s or composer’s message is not a proper test for weighing First Amendment rights.”); *Cardtoons, L.C. v. Major League Baseball Ass’n*, 95 F.3d 959, 971 (10th Cir. 1996) (“[I]n the context of intellectual property, *Lloyd’s* ‘no adequate alternative avenues’ test does not sufficiently accommodate the public’s interest in free expression.”); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (“We cannot indulge the facile assumption that one can forbid particular words without running a substantial risk of suppressing ideas in the process.” (quoting *Cohen v. California*, 403 U.S. 15, 26 (1971))); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987) (“The first amendment [*sic*] issues involved in this [Lanham Act] case cannot be disposed of by equating the rights of a trademark owner with the rights of an owner of real property.”). The Second Circuit, however, had previously employed the alternative avenues test in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.* See 604 F.2d 200, 206 (2d Cir. 1979) (applying alternative avenues test to rule that upholding plaintiff’s trademark rights does not violate defendant’s First Amendment rights). The *Rogers* court subsequently held that *Dallas Cowboys Cheerleaders* did not require the courts in the Second Circuit to apply the alternative avenues test to all intellectual property disputes- it was unique and distinguishable in that it involved “blatantly false advertising.” See *Rogers*, 875 F.2d at 999 n.4 (limiting application of *Dallas Cowboy Cheerleaders* in Lanham Act disputes).

199. 329 F.3d 437 (6th Cir. 2003).

200. See *id.* at 449-50 (discussing inappropriateness of applying alternative avenues test to Lanham Act disputes). In *Parks*, the rap duo OutKast titled one of its hit songs *Rosa Parks*. *Id.* at 442. In the opening lyrics, the song’s subjects were moved to the back of a bus, resistance to which made Rosa Parks a hero of the Civil Rights Movement. See *id.* at 442 (describing facts of dispute). The song’s opening lyrics were: “Ah huh, hush that fuss. Everybody move to the back of the bus.” *Id.*

property rights in words or ideas.”²⁰¹ For a communicative message, a change in wording is usually much more significant to the overall message’s effectiveness than a difference in the location from which the message is communicated.²⁰² Furthermore, applying the alternative avenues test to a Lanham Act dispute would require a court to evaluate whether the unauthorized use of a trademark is “necessary” to communicate an idea, which according to the *Parks* court, is an inappropriate evaluation for the judiciary to make.²⁰³

Finally, the Second, Fifth, Sixth, and Ninth Circuits and the Eastern District of Pennsylvania have adopted the *Rogers* test to determine if the Lanham Act’s restrictions apply to an artistic work.²⁰⁴ The *Rogers* test only permits the Lanham Act to preclude the use of a trademark in a work that contains artistic expression when “the public interest in avoiding consumer confusion outweighs the public interest in free expression.”²⁰⁵ Accordingly, the Lanham Act will only apply when (1) the use of the trademark has “no artistic relevance to the underlying work” or (2) if the use of the trademark has artistic relevance, that use “explicitly misleads as to the source or the content of the work.”²⁰⁶ The *Rogers* court limited the test to cases arising in the “context of allegedly misleading titles using a celebrity’s name,”²⁰⁷ but courts have since expanded its scope to

201. *Id.* at 450.

202. *See id.* (“The difference between the almost-right word and the right word is really a large matter – it’s the difference between the ‘lightning-bug’ and the ‘lightning.’”).

203. *See Parks*, 329 F.3d at 450 (rejecting alternative avenues test).

204. *See id.* at 448, 451-52 (adopting *Rogers* test and discussing how it has been adopted by Second, Fifth, and Ninth Circuits and Eastern District of Pennsylvania); *see also* *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (adopting *Rogers* test); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665 (5th Cir. 2000) (stating Fifth Circuit has adopted *Rogers* test); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (establishing artistic relevance test); *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 339-40 (E.D. Pa. 1996) (applying *Rogers* test).

205. *Rogers*, 875 F.2d. at 999 (setting forth standards for First Amendment analysis involving Lanham Act disputes).

206. *Id.* (establishing artistic relevance test). Under the second prong of the *Rogers* test, the standard likelihood of confusion factors, such as the *Polaroid* factors, are applied to determine whether the use is “explicitly misleading.” *See Westchester Media*, 214 F.3d at 664-65 (explaining standard for *Rogers* test (citing *Twin Peaks Prods. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. N.Y. 1993))). “However, the likelihood of confusion must be ‘particularly compelling’ to outweigh the First Amendment interests at stake.” *Id.*

207. *Rogers*, 875 F.2d. at 999 (applying artistic relevance test in case involving fictional movie titled “Ginger and Fred,” which calls to mind Ginger Roger and Fred Astaire).

cover any work of artistic expression.²⁰⁸ After rejecting the likelihood of confusion and alternative avenues tests, the *Parks* court applied the *Rogers* test, opining that it is the “most appropriate method to balance the public interest in avoiding consumer confusion with the public interest in free expression.”²⁰⁹

D. Recent Cases Involving the Unauthorized Use of Music in Political Campaigns

Since the 2008 presidential campaign, there have been two high-profile cases involving the unauthorized use of music in political a campaign. In August 2008, Jackson Browne filed suit against Republican presidential candidate John McCain, the Republican National Committee (the “RNC”), and the Ohio Republican Party (the “ORP” and, collectively, the “Browne Defendants”) after the Browne Defendants used Browne’s hit song *Running on Empty* in a television advertisement without Browne’s permission.²¹⁰ The following April, Don Henley filed suit against Republican senatorial candidate Charles DeVore and the DeVore campaign’s Director of Internet Strategies and New Media (collectively, the “Henley Defendants”) for incorporating two of Henley’s songs into consecutive internet advertisements in support of DeVore’s candidates for the 2010 Republican nomination for California’s U.S. Senate seat.²¹¹

1. *Browne v. McCain*²¹²

During the 2009 presidential campaign, the ORP released a campaign commercial that mocked a comment made by Democratic presidential candidate and future President Barack Obama (the “McCain Advertisement”).²¹³ The conclusion of the McCain

208. See *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989) (“Thus, we hold that the *Rogers* balancing approach is generally applicable to Lanham Act claims against works of artistic expression, a category that includes parody.”); *Seale*, 949 F. Supp. at 339-40 (applying *Rogers* test to dispute involving unauthorized use of well-known political figure Bobby Seale’s name and likeness to promote and advertise film).

209. *Parks*, F.3d at 448-50 (explaining rationale for adopting *Rogers* test).

210. See *Browne Complaint*, *supra* note 13, ¶ 2 (describing dispute).

211. See *Henley Complaint*, *supra* note 14, ¶¶ 19, 24-25 (describing dispute).

212. 611 F. Supp. 2d 1073 (C.D. Cal 2009); 612 F. Supp. 2d 1125 (C.D. Cal. 2009); 612 F. Supp. 2d 1118 (C.D. Cal. 2009). The only decision issued in *Browne v. McCain* was a ruling on the Browne Defendants’ respective motions to dismiss, for which the court issued a separate decision for each defendant.

213. See *Browne Complaint*, *supra* note 13, ¶ 2 (describing McCain Advertisement); *Browne*, 611 F. Supp. 2d at 1076-77 (Same). The McCain Advertisement was aired on television and posted on the internet. See *id.* at 1077. (discussing airing and posting of Advertisement).

Advertisement showed a clip of Obama suggesting that people can reduce the United States' energy consumption by ensuring that the tires on their cars are properly inflated.²¹⁴ While that clip of Obama was playing, *Running on Empty* was also playing in the background.²¹⁵ Because the Browne Defendants neither sought nor received a license for the use of *Running on Empty*, Browne filed suit for, *inter alia*, copyright infringement and false endorsement under the Lanham Act.²¹⁶ In his complaint, Browne claimed that McCain's politics directly conflicted with "the political and social values that Browne has espoused and supported throughout his career."²¹⁷ On November 17, 2008, the Browne Defendants filed separate motions to dismiss.²¹⁸ The complaint against the ORP was dismissed for lack of personal jurisdiction,²¹⁹ but the court upheld Browne's claims against both McCain and the RNC.²²⁰

The court declined to evaluate McCain's or the RNC's fair use arguments because the facts alleged in the complaint were insufficient to conduct a fair use analysis.²²¹ The court explained, "[I]n order to undertake the fair use analysis, a court usually must make factual findings, or rely on undisputed or admitted material

214. See *Browne Complaint*, *supra* note 13, ¶ 2 (describing McCain Advertisement); *Browne*, 611 F. Supp. 2d at 1076-77 (Same).

215. See *Browne Complaint*, *supra* note 13, ¶ 2; *Browne*, 611 F. Supp. 2d at 1076-77 (Same).

216. See *Browne Complaint*, *supra* note 13, ¶ 2, 19-38 (setting forth claims); *Browne*, 611 F. Supp. 2d at 1077 (listing Browne's claims).

217. *Browne Complaint*, *supra* note 13, ¶ 1. Browne claimed that he initiated legal action to "vindicate an egregious, intentional false association created by agents of the presumptive Republican candidate for President of the United States." *Id.*

218. See generally Memorandum of Points and Authorities in Support of Defendant John McCain's Motion to Dismiss under FRCP 12(b)(6), *Browne v. McCain*, 611 F. Supp. 2d 1073 (C.D. Cal. 2008) (No. 08-05334), 2008 WL 4994419; Memorandum of Points and Authorities in Support of Defendant the Republican National Committee's Motion to Dismiss under FRCP 12(b)(6), *Browne v. McCain*, 612 F. Supp. 2d 1125 (C.D. Cal. 2008) (No. 08-05334), 2008 WL 4994423; Defendant Ohio Republican Party's Memorandum of Points and Authorities in Support of Motion to Dismiss Complaint Pursuant to FRCP 12(b)(2), (3), &(6) Or Transfer Pursuant to 28 U.S.C. §§ 1404(a) & 1406(a), *Browne v. McCain*, 612 F. Supp. 2d 1118 (C.D. Cal. 2008) (No. 08-05334), 2008 WL 4994420.

219. *Browne v. McCain*, 612 F. Supp. 2d 1118, 1122-23 (C.D. Cal. 2009) (dismissing complaint against ORP for lack of sufficient minimum contacts with California).

220. See *Browne*, 611 F. Supp. 2d at 1081 (denying McCain's motion to dismiss copyright and trademark infringement claims); *Browne v. McCain*, 612 F. Supp. 2d 1125, 1133 (C.D. Cal. 2009) (denying RNC's motion to dismiss copyright and trademark infringement claims).

221. See *Browne*, 611 F. Supp. 2d at 1078 (denying McCain's motion to dismiss copyright infringement claim); *Browne*, 612 F. Supp. 2d at 1130 (denying RNC's motion to dismiss copyright infringement claim).

facts.”²²² The court also held that neither McCain nor the RNC established that Browne’s claim was barred as a matter of law solely because the McCain Advertisement was political speech.²²³

Additionally, the court rejected McCain’s and the RNC’s argument that Browne’s Lanham Act claim failed as a matter of law.²²⁴ First, the court explained that the Lanham Act applies to noncommercial speech.²²⁵ Next, the court held that neither McCain nor the RNC had established the following to justify the court dismissing Browne’s claim under the *Rogers* test: (1) the McCain Advertisement was an “artistic” work; and (2) the First Amendment precluded Browne’s trademark infringement claim as a matter of law solely because the McCain Advertisement was noncommercial, political speech.²²⁶ Using the same logic as used in its fair use analysis, the court reasoned that prior jurisprudence did not support the position that Lanham Act claims involving political speech should be dismissed as a matter of law on First Amendment grounds.²²⁷ Finally, the court held that both McCain and the RNC

222. See *Browne*, 611 F. Supp. 2d at 1078 (explaining courts’ standard for fair use evaluations (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985)); *Browne*, 612 F. Supp. 2d at 1130 (Same). The court emphasized the importance of discovery when ruling on the fair use defense. See *Browne*, 611 F. Supp. 2d at 1078 (“As a result [of the parties not having had a full opportunity to conduct discovery], Plaintiff is not yet aware of all relevant and material facts supporting his claim and potentially refuting Senator McCain’s fair use defense.”); *Browne*, 612 F. Supp. 2d at 1130 (“As a result [of the parties not having had a full opportunity to conduct discovery], Plaintiff is not yet aware of all relevant and material facts supporting his claim and potentially refuting RNC’s fair use defense.”).

223. See *Browne*, 611 F. Supp. 2d at 1078 (“The mere fact that Plaintiff’s claim is based on Defendants’ use of his copyrighted work in a political campaign does not bar Plaintiff’s claim as a matter of law.”); *Browne*, 612 F. Supp. 2d at 1130 (Same).

224. See *Browne*, 611 F. Supp. 2d at 1079 (upholding Browne’s Lanham Act claims); *Browne*, 612 F. Supp. 2d at 1131 (Same).

225. See *Browne*, 611 F. Supp. 2d at 1079 (explaining liability under Lanham Act for unauthorized uses of mark in political speech); *Browne*, 612 F. Supp. 2d at 1131 (Same). The court also reinforced prior holdings of other courts by explaining that the phrase “in commerce” contained in Section 43(a) of the Lanham Act is a jurisdictional precondition rather than a requirement that a mark be used commercially for a defendant to incur liability under the Lanham Act. See *Browne*, 611 F. Supp. 2d at 1079 (discussing phrase “in commerce”); *Browne*, 612 F. Supp. 2d at 1131-32 (Same). For a further discussion of other circuits’ interpretation of the phrase “in commerce,” see *supra* note 110 and accompanying text.

226. See *Browne*, 611 F. Supp. 2d at 1080 (holding that McCain failed to meet burden to dismiss under *Rogers* test); *Browne*, 612 F. Supp. 2d at 1132 (holding that RNC failed to meet burden to dismiss under *Rogers* test).

227. See *Browne*, 611 F. Supp. 2d at 1080 (“In fact, courts that have applied the Lanham Act to noncommercial and political speech have implicitly rejected the theory that claims based on such speech are barred, as a matter of law, based on

failed to meet their burden of demonstrating Browne's inability to show likelihood of confusion as a matter of law.²²⁸

Browne, however, was never adjudicated at trial. In August 2009, the court approved an out-of-court settlement, which included a public apology issued by McCain.²²⁹

2. *Henley v. DeVore*²³⁰

As *Browne* was being settled, Don Henley filed a copyright and trademark infringement suit against the Henley Defendants in April 2009.²³¹ To promote DeVore's campaign for the Republican nomination for California's U.S. Senate seat, the Henley Defendants altered the lyrics of Henley's song *Boys of Summer* in an internet article and online video that criticized President Obama and his supporters (the "Summer Secondary Work").²³² Two weeks after the initial video, the Henley Defendants released a second online

the First Amendment and artistic relevance test."); *Browne*, 612 F. Supp. 2d at 1132 (Same).

228. See *Browne*, 611 F. Supp. 2d at 1080-81 (holding McCain had not met burden to dismiss Lanham Act claim as a matter of law); *Browne*, 612 F. Supp. 2d at 1133 (holding that RNC had not met burden to dismiss Lanham Act claim as a matter of law). The court's holding was influenced by the Defendants' failure to address every *Sleekcraft* factor in their respective motions. See *Browne*, 611 F. Supp. 2d at 1081 (noting McCain's failure to address *Sleekcraft* factor); *Browne*, 612 F. Supp. 2d at 1133 (noting RNC's failure to address *Sleekcraft* factor). Also, the court held that the defendants' contention that the McCain Advertisement "clearly identify[d] its source as ORP, alone, [did] not show that a consumer could not possibly be confused as to whether Browne endorsed RNC, Senator McCain, or ORP." *Browne*, 611 F. Supp. 2d at 1080; *Browne*, 612 F. Supp. 2d at 1133.

229. See Order on Joint Stipulation Re Dismissal of Entire Action at 2, *Browne v. McCain*, 2009 WL 2912982 (C.D. Cal. 2009) (No. 08-05334) [hereinafter *Browne Settlement Order*] (dismissing action without prejudice); Alex Dobuzinskis, *Jackson Browne Wins Republican Apology Over Song*, REUTERS, (July 21, 2009, 7:26 PM), <http://www.reuters.com/article/musicNews/id-USTRE56K5O420090721> (describing publicly known details of settlement).

230. No. 09-0481, 210 U.S. Dist. LEXIS 67987 (C.D. Cal. June 19, 2010).

231. See *Henley Complaint*, *supra* note 14, ¶¶ 43-76 (stating Henley's intellectual property claims).

232. See *id.* ¶¶ 24-25 (setting forth factual allegations). The song *Boys of Summer* is about a man reminiscing about a summer romance. See *id.* ¶ 19 (describing basis of song). In the Summer Secondary Work, Obama is the singer's love interest and the singer is "dreaming wistfully of the time before President Obama's election." See Defendants' Notice of Motion and Motion to Dismiss under Rule 12(b)(6) of the Federal Rules of Civil Procedure at 2, *Henley v. DeVore*, 210 U.S. Dist. LEXIS 67987 (C.D. Cal. 2009) (No. 09-0481) [hereinafter *Henley Defendants' Motion to Dismiss*] (describing Summer Secondary Work). The Summer Secondary Work then "asks whether the parties' naïve love affair can survive" what the Henley Defendants call "President Obama's broken promises and failure to deliver on the promised 'hope.'" *Id.* The Henley Defendants titled the Summer Secondary Work *The Hope of November*. See *Henley*, 210 U.S. Dist. LEXIS 67987, at *3 (C.D. Cal. June 19, 2010) (stating title of Summer Secondary Work).

video that incorporated a different Henley song, *All She Wants to Do is Dance*, to critique Democratic Senator Barbara Boxer (the “Dance Secondary Work” and, collectively with the Summer Secondary Work, the “DeVore Secondary Works”), who was the incumbent holding the office for which DeVore was running.²³³ The Henley Defendants moved to dismiss Henley’s Lanham Act claim for false endorsement, but the court denied the motion because, *inter alia*, Henley’s complaint sufficiently plead misappropriation of a distinctive attribute.²³⁴ Additionally, citing to its decision in *Browne*, the court rejected the Henley Defendant’s argument that Henley’s Lanham Act claim must fail as a matter of law because the defendants used Henley’s songs in noncommercial, political speech.²³⁵ The court subsequently granted Henley summary judgment on his copyright claim and granted the defendants summary judgment on Henley’s Lanham Act claim.²³⁶

In its summary judgment opinion, the court held that the Henley Defendants did not meet their burden of establishing fair use.²³⁷ In its analysis of the first fair use factor, the court held that the DeVore Secondary Works were satire because they merely “evoked the same themes of the original in order to attack an entirely separate subject.”²³⁸ Though the court found slight parody of Henley in the Summer Secondary Work, parody was a very minor element of that work because the work’s main target was Obama and his sup-

233. See *Henley Complaint*, *supra* note 14, ¶ 37 (describing Dance Secondary Work). The Dance Secondary Work “asserts that the American government, through Barbara Boxer and her comrades in Washington - and with the support of Hollywood’s liberal elite (of which Henley is proudly a member) - are inserting themselves into the American economy and enriching the government and certain special interests through immoral tax policies.” *Henley Defendants’ Motion to Dismiss*, *supra* note 232, at 3. The Henley Defendants titled the Dance Secondary Work *All She Wants to Do is Tax*. See *Henley*, 2010 U.S. Dist. LEXIS 67987, at *5 (describing Dance Secondary Work).

234. See *Henley Motion to Dismiss Decision*, *supra* note 111, at 14 (denying Henley Defendants’ motion to dismiss Henley’s Lanham Act claim).

235. See *Henley Motion to Dismiss Decision*, *supra* note 111, at 3-8 (explaining Lanham Act liability extends to political activities); see also *Henley Defendants’ Motion to Dismiss*, *supra* note 232, at 11-13 (arguing Lanham Act did not apply to DeVore Secondary Works because they were “pure political speech”).

236. See *Henley*, 2010 U.S. Dist. LEXIS 67987, at *66 (summarizing holding).

237. See *id.* at *51 (granting Henley summary judgment on copyright infringement claim).

238. *Id.* at *33. The court found that the Summer Secondary Work did not comment on any of the original song’s content, such as nostalgia or summer romances, but rather, it used “those themes and devices to mock a separate subject entirely, namely Obama and his supporters.” *Id.* at *29. Likewise, the Dance Secondary Work used the same themes as *All She Wants to Do is Dance* “to comment on entirely different subjects, namely Barbara Boxer, taxation, global warming, and the proposed cap-and-trade program.” *Id.* at *32.

porters.²³⁹ Furthermore, the court found that neither the Summer Secondary Work offered commentary on the liberal political undertones in *Boys of Summer* nor the Dance Secondary Work commented on the “explicit social commentary” contained in *All She Wants to Do is Dance*.²⁴⁰ Applying Ninth Circuit precedent, the court also held that the DeVore Secondary Works were commercial in nature because the Henley Defendants “benefitted or gained an advantage without having to pay customary licensing fees.”²⁴¹

The fourth fair use factor also weighed against the Henley Defendants.²⁴² The court reasoned that it could not hold, as a matter of law, that the “widespread dissemination of similar satirical spins” on Henley’s songs would not harm the market for the original works, even though it was not clear that the DeVore Secondary Works actually threatened the markets of Henley’s songs.²⁴³ Regarding the potential effects that the DeVore Secondary Works might have on the market for derivatives of Henley’s songs, the court held that the Henley Defendants submitted “no evidence demonstrating that [the DeVore Secondary Works] would not usurp the potential licensing market” for the original songs.²⁴⁴

The court granted summary judgment to the Henley Defendants for Henley’s Lanham Act claim.²⁴⁵ The court began its analysis by distinguishing between the unauthorized use of a singer’s dis-

239. *See id.* at *31 (finding parody of Henley could be reasonably perceived in Summer Secondary Work because it targeted Obama’s supporters, which includes Henley). The court qualified this finding with “assuming that criticism of the author can qualify as parody.” *Id.*

240. *See id.* at *27-33 (rejecting Henley Defendants’ argument that DeVore Secondary Works were parody). In the final verse of *Boys of Summer*, the song’s narrator describes seeing a “Deadhead sticker on a Cadillac.” *Id.* at *27. Citing an interview that Henley gave to Rolling Stone magazine in which he explained the meaning of that verse, the Henley Defendants argued that the song’s narrator is “bemoaning the failure of 1960’s liberal politics (symbolized by the Deadhead sticker) to change the status quo (symbolized by the Cadillac).” *Id.* at *28. The court also accepted the Henley Defendants’ assertion that *All She Wants to Do is Dance* should be interpreted as criticizing the United States’ foreign policy in Latin America during the 1980s and the corresponding indifference of the American public. *See id.* at *32 (interpreting meaning of *All She Wants to Do is Dance*).

241. *Id.* at *38 (citing *Worldwide Church of God v. Phila. Church of God, Inc.*, 227 F.3d 1110, 1118 (9th Cir. 2000)).

242. *See id.* at *44-49 (analyzing fourth fair use factor).

243. *See id.* at *45-46. When analyzing market effects under the fourth fair use factor, courts must consider “whether unrestricted and widespread conduct of the sort engaged in by the defendant would result in a substantially adverse impact on the potential market for the original.” *Id.* at 45 (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994)) (internal quotations omitted).

244. *Id.* at *47-48.

245. *See id.* at *66 (awarding Henley Defendants summary judgment on Lanham Act claim).

tinctive attribute and the unauthorized use of a musician's prior performance of a song.²⁴⁶ A celebrity's distinctive attribute is part of that celebrity's persona, which the Lanham Act protects against misappropriation.²⁴⁷ However, adopting Second Circuit precedent, the court held that an original musical performance cannot function as a trademark for either the performer or the song itself.²⁴⁸ Therefore, the court held that Henley could not maintain a Lanham Act claim based solely on the Henley Defendants' use of his songs.²⁴⁹ Regarding likelihood of confusion based on the alleged misappropriation of a distinct attribute of Henley, the court held that "no reasonable jury could find a likelihood that Henley actually performed" the DeVore Secondary Works and, accordingly, awarded the Henley Defendants summary judgment on the Lanham Act claim.²⁵⁰

The only issue unresolved on summary judgment was Henley's claim for willful copyright infringement.²⁵¹ The parties, however, settled this issue following the court's summary judgment decision.²⁵² Though DeVore could claim a partial victory in the court's summary judgment decision, he lost the California Republican senatorial primary to Carly Fiorina two days before the decision was issued.²⁵³

246. *See id.* at *58-62 (detailing distinction between trademark rights for celebrities' distinctive attributes and original musical performances); *see also* *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 62 (2d Cir. 2000) (Same).

247. *See Henley*, 2010 U.S. Dist. LEXIS 67987, at *60 (explaining celebrity distinctive attributes may function as trademarks); *see also* *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1107 (9th Cir. 1992) (holding "entertainer's distinctive voice" is protected by Lanham Act).

248. *See Henley*, 2010 U.S. Dist. LEXIS 67987, at *62 (holding Lanham Act does not protect against unauthorized use of musical performances (citing *Oliveira*, 251 F.3d at 62-63)).

249. *See id.* at *64 (denying Lanham Act relief based on Henley Defendants' unauthorized use of Henley's songs).

250. *Id.* at *64-66.

251. *See id.* at *57 (holding summary judgment for willful infringement was not appropriate for either party).

252. *See* Order of Dismissal Upon Settlement of Case, *Henley v. DeVore*, 2010 U.S. Dist. LEXIS 67987 (C.D. Cal. 2009) (No. 09-0481) (dismissing case due to settlement between parties).

253. *See* Associated Press, *Fiorina Wins GOP Senate Primary in California*, CBSNEWS POLITICS, (June 9, 2010), <http://www.cbsnews.com/stories/2010/06/09/politics/main6563065.shtml> (reporting Fiorina's victory in California Republican primary held on June 8, 2010).

III. ANALYSIS

Part A of this Section analyzes the impact that *Nader*, *Hagan*, *Browne*, and *Henley* will have on future cases involving the unauthorized use of an original musical performance in a political campaign.²⁵⁴ Part A first discusses the impact that those cases will have on copyright law, concluding that all four cases support the notion that future litigations will outlast the campaigns that give rise to the musicians' intellectual property claims.²⁵⁵ Part A then explains why courts will likely prohibit musicians from bringing Lanham Act claims against politicians who use their original musical performances without authorization.²⁵⁶ Based on the impact discussed in Part A, Part B of this Section proposes that courts apply a modified alternative avenues test to make preliminary copyright fair use determinations in cases involving the unauthorized use of an original musical performance in a political campaign.²⁵⁷

A. Impact of *Nader*, *Hagan*, *Browne* and *Henley* on Future Cases Involving the Unauthorized Use of an Original Musical Performance in a Political Campaign

Like MasterCard, AFLAC, and Don Henley in their respective litigations, Jackson Browne claimed copyright and trademark infringement for the unauthorized use of his intellectual property in a political campaign.²⁵⁸ The nature of Browne's dispute, however, was significantly different than those of the three other aforementioned plaintiffs. In *Nader* and *Hagan*, the plaintiffs' original works

254. For a further discussion of *Nader's*, *Hagan's*, *Browne's*, and *Henley's* impact on future cases involving the unauthorized use of an original musical performance in a political campaign, see *infra* notes 258-97 and accompanying text.

255. For a further discussion of *Nader's*, *Hagan's*, *Browne's*, and *Henley's* impact on copyright law, see *infra* notes 261-89 and accompanying text.

256. For a further discussion of why it is unlikely that musicians will be able to bring Lanham Act claims in future disputes involving the unauthorized use of an original musical performance in a political campaign, see *infra* notes 290-97 and accompanying text.

257. For a further discussion of this Comment's proposal that courts adopt a modified alternative avenues test to make preliminary fair use determinations in cases involving the unauthorized use of an original musical performance in a political campaign, see *infra* notes 298-345 and accompanying text.

258. Compare *Browne v. McCain*, 611 F. Supp. 1073, 1077 (C.D. Cal. 2009) (listing Browne's claims), with *MasterCard Int'l, Inc. v. Nader 2000 Primary Comm., Inc.*, No. 00-6068, 2004 U.S. Dist. LEXIS 3644, at *3-4 (S.D.N.Y. Mar. 8, 2004) (listing MasterCard's claims); *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 685 (N.D. Ohio 2002) (listing AFLAC's claims); *Henley*, 2010 U.S. Dist. LEXIS 67987, at *6 (stating Henley's intellectual property claims).

were commercial advertisements.²⁵⁹ In *Henley*, the defendants altered the plaintiffs' original musical works.²⁶⁰ Despite these differences, all four cases will impact future litigations involving the unauthorized use of an original musical performance in a political campaign.

1. *Impact of Nader, Hagan, Browne, and Henley on Copyright Law*

The respective fair use analyses undertaken by the *Nader* and *Henley* courts provide persuasive precedent for cases involving the unauthorized use of an original musical performance in a political campaign. The *Henley* and *Nader* decisions represent opposite extremes for analyzing fair-use parody.²⁶¹ Likewise, the *Nader* and *Henley* courts came out differently on the question of whether the political advertisements at issue were commercial in nature under the first fair use factor.²⁶² Accordingly, future plaintiff-musicians and defendant-politicians have two persuasive, yet opposite, precedents to cite when resolving questions of fair use in cases involving the unauthorized use of an original musical performance in a political campaign.

Arguably, the *Nader* Advertisement and the DeVore Secondary Works were very similar- their creators utilized the style and underlying substance of the well-known original works in order to criticize political opponents.²⁶³ The *Nader* and *Henley* courts, however, viewed the "reasonably be perceived" threshold for fair-use parody very differently.²⁶⁴

259. See *Nader*, 2004 U.S. Dist. LEXIS 3644, at *2-3 (describing *Nader* campaign using MasterCard Advertisements); *Hagan*, 266 F. Supp. 2d at 686 (describing *Hagan* campaign using AFLAC's well-known duck character).

260. See *Henley*, 2010 U.S. Dist. LEXIS 67987, at *2-5 (describing *Henley* Defendants' alterations of Don Henley's music in political advertisements).

261. Compare *Nader*, 2004 U.S. Dist. LEXIS 3644, at *42-43 (holding *Nader* Advertisement commented on original works), with *Henley*, 2010 U.S. Dist. LEXIS 67987, at *29-34 (holding DeVore Secondary Works did not comment on original works).

262. Compare *Nader*, 2004 U.S. Dist. LEXIS 3644, at *37 (holding *Nader* Advertisement was noncommercial for purpose of first fair use factor), with *Henley*, 2010 U.S. Dist. LEXIS 67987, at *35-38 (holding DeVore Secondary Works were commercial for purpose of first fair use factor).

263. Compare *Nader*, 2004 U.S. Dist. LEXIS 3644, at *2-3 (describing *Nader* Advertisement), with *Henley*, 2010 U.S. Dist. LEXIS 67987, at *2-5 (describing DeVore Secondary Works).

264. Compare *Nader*, 2004 U.S. Dist. LEXIS 3644, at *42-43 (applying more lenient "reasonably be perceived" standard to hold *Nader* Advertisement was parody), with *Henley*, 2010 U.S. Dist. LEXIS 67987, at *29-35 (applying stricter "reasonably be perceived" standards to hold DeVore Secondary Works were not parody).

The court in *Nader* applied a more lenient standard when evaluating fair-use parody. Though both the purpose and message of the MasterCard Advertisements were nonpolitical, the court “reasonably perceived” commentary in the purely political Nader Advertisement.²⁶⁵ It seems apparent that the only purpose of the Nader Advertisement was to convey the message that Nader was a truthful politician.²⁶⁶ It is unlikely that the Nader campaign intended for its advertisement to function as a commentary on the MasterCard Advertisements.²⁶⁷ Despite Justice Kennedy’s warning that courts should be cautious about “*post hoc*” parody assertions when evaluating fair use,²⁶⁸ the court did not inquire into the Nader campaign’s original intent.²⁶⁹ Rather, the court’s ability to “reasonably perceive[]” commentary on the MasterCard Advertisements was sufficient to hold that the Nader Advertisement was parody.²⁷⁰

To the contrary, the *Henley* court viewed the DeVore Secondary Works as satire—using Henley’s songs to comment on third parties—rather than parody.²⁷¹ The court held that the DeVore Secondary Works did not directly comment on the original works, even though Henley’s songs contained political messages that contrasted significantly with the views of DeVore.²⁷² The *Henley* court even accepted the “parody-of-the-author” theory *arguendo*, but in the Summer Secondary Work, the court viewed parody of Henley to be a

265. See *Nader*, 2004 U.S. Dist. LEXIS 3644, at *43 (accepting Nader campaign’s argument that Nader Advertisement “wittingly” commented on “materialistic message” of MasterCard Advertisements).

266. See *id.* at *42-43 (“Ralph Nader’s Political Ad attempts to show various ways different Presidential candidates can be bought in the ‘big-money arena of Presidential politics’ . . . and contrasts the ‘priceless’ truth represented by Ralph Nader as the remedy for the bought and paid for positions of others.”).

267. See Rumpfelt, *supra* note 38, at 415 (opining “use of the parody category” in *Nader* was “contrived” and arguing that Nader Advertisement was “more appropriately defined as satire”).

268. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 600 (1994) (Kennedy, A., concurring) (“As future courts apply our fair use analysis, they must take care to ensure that not just any commercial takeoff is rationalized *post hoc* as a parody.”). Because the court held that the Nader Advertisement was noncommercial, political speech, it may have viewed Kennedy’s advice, which addressed “commercial takeoff[s],” as irrelevant. See *id.*; *Nader*, 2004 U.S. Dist. LEXIS 3644, at *37 (holding Nader Advertisement was noncommercial).

269. See *Nader*, 2004 U.S. Dist. LEXIS 3644, at *42-43 (analyzing commentary in Nader Advertisement and not discussing Nader campaign’s subjective intent).

270. See *id.* at *43 (holding Nader Advertisement was parody).

271. See *Henley v. DeVore*, No. 09-0481, 2010 U.S. Dist. LEXIS 67987, at *33 (C.D. Cal. June 10, 2010) (holding DeVore Secondary Works were satire).

272. For a further discussion of the political messages contained in the original Henley songs, see *supra* note 240 and accompanying text.

“relatively minor element.”²⁷³ Furthermore, the *Henley* court directly addressed the question of whether the subjective intent of the alleged infringer is relevant to determining fair-use parody, ultimately holding that to be the standard.²⁷⁴ Accordingly, the *Henley* court incorporated Justice Kennedy’s warning about “*post hoc*” parody assertions into the “framework” of its analysis and, overall, applied a relatively strict standard for evaluating fair-use parody.²⁷⁵

Incorporating an exact copy of an original work into a secondary work can be transformative.²⁷⁶ Accordingly, a defendant-politician in a future case involving the unauthorized use of an original musical performance in a political campaign may be able to argue that the use of the original work constitutes parody. Therefore, the standards for parody applied in *Nader* and *Henley* may be relevant in such litigations.²⁷⁷

Likewise, future litigants can look to *Nader* and *Henley* for persuasive, yet opposite, precedent addressing whether a political advertisement is commercial in nature.²⁷⁸ The *Nader* court viewed political advertisements, even those soliciting donations, as non-commercial, political speech.²⁷⁹ Furthermore, the *Nader* court opined that the *Nader* Advertisement’s stated purpose was to “raise public awareness of Ralph Nader’s desire to be included in the upcoming, televised Presidential candidate debates,” which according to the court, was a noncommercial purpose.²⁸⁰ Additionally, in its Lanham Act analysis, the *Hagan* court questioned whether political

273. See *Henley*, 2010 U.S. Dist. LEXIS 67987, at *31 (evaluating parody of *Henley* contained in Summer Secondary Work).

274. See *id.* at *26 (“The answer [to whether the parodist’s subjective contemporaneous intent in making the work is relevant to the parody inquiry] is clearly yes, at least as evidence of whether the work actually contains parodic character.”).

275. See *id.* (discussing Justice Kenney’s concurrence in *Campbell* (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 600 (1994) (Kennedy, A., concurring))).

276. For a further discussion of the use of exact copies of original works being transformative, see *supra* note 51 and accompanying text.

277. For a further discussion of the *Nader* and *Henley* courts’ parody analyses, see *supra* note 263-75 and accompanying text.

278. Compare *MasterCard Int’l, Inc. v. Nader 2000 Primary Comm., Inc.*, No. 00-6068, 2004 U.S. Dist. LEXIS 3644, at *37 (S.D.N.Y. Mar. 8, 2004) (holding *Nader* Advertisement was noncommercial in nature for purpose of first fair use factor), with *Henley*, 2010 U.S. Dist. LEXIS 67987, at *35-38 (holding *DeVore* Secondary Works were commercial for purpose of first fair use factor).

279. See *Nader*, 2004 U.S. Dist. LEXIS 3644 at *23-24 (holding *Nader* Advertisement was political in nature). This analysis of the noncommercial nature of the *Nader* Advertisement was conducted in the court’s Lanham Act evaluation and was incorporated into its fair use analysis. See *id.* at *37 (incorporating noncommercial nature analysis in Lanham Act).

280. *Id.* at *37.

advertisements even propose commercial transactions because they discuss political issues and often challenge the qualifications of the advertisers' political opponents.²⁸¹ The *Henley* court, however, held that the DeVore Secondary Works were commercial in nature because the Henley Defendants "benefitted or gained an advantage without having to pay customary licensing fees."²⁸² As they did when evaluating fair-use parody, the *Nader* and *Henley* courts established persuasive, yet opposite, precedent for future litigants in disputes involving the unauthorized use of an original musical work in a political campaign.²⁸³

Despite the differences in their substantive holdings regarding fair use, *Nader* and *Henley* share a common attribute- a decision on the merits for the question of fair use was not issued until after the conclusion of the defendants' campaigns.²⁸⁴ The summary judgment decision in *Nader* was handed down on March 4, 2004, while the *Nader* Advertisement was used during the 2000 presidential campaign.²⁸⁵ The summary judgment decision in *Henley* was handed down on June 10, 2010, while DeVore lost his bid for the Republican nomination for California's U.S. Senate seat two days prior.²⁸⁶ Additionally, *Browne* did not settle until eight months after the 2008 presidential election.²⁸⁷ Furthermore, the courts in *Nader* and *Hagan* denied the plaintiff's motions for preliminary injunctions during the defendants' respective campaigns.²⁸⁸ Likewise, in *Browne*, McCain's and the RNC's motions to dismiss were rejected because fair use should not be adjudicated prior to discovery.²⁸⁹

281. See *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2D 682, 697 (N.D. Ohio 2002) (explaining noncommercial nature of *Hagan* Advertisement).

282. *Henley*, 2010 U.S. Dist. LEXIS 67987, at *38 ((citing *Worldwide Church of God v. Phila. Church of God, Inc.*, 227 F.3d 1110, 1118 (9th Cir. 2000)).

283. For a further discussion of how future litigants may be able to use *Nader* and *Henley* to resolve questions regarding the parodic character of a secondary work, see *supra* notes 263-77 and accompanying text.

284. For a further discussion of the timing of the summary judgment decisions in *Nader* and *Henley*, see *infra* notes 285-86 and accompanying text.

285. See *Nader*, 2004 U.S. Dist. LEXIS 3644, at *1-3 (discussing facts of case).

286. See *Henley*, 2010 U.S. Dist. LEXIS 67987, at *1 (stating date of decision); Associated Press, *supra* note 253 (reporting Carly Fiorina's victory in California Republican primary held on June 8, 2010).

287. See *Browne Settlement Order*, *supra* note 229, at 2 (ordering case dismissed because of settlement).

288. See *Nader*, 2004 U.S. Dist. LEXIS 3644, at *4 (stating court denied MasterCard's motion for preliminary injunction during 2000 presidential campaign); *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2D 685 (N.D. Ohio 2002) (denying plaintiff's motion for preliminary injunction).

289. For a further discussion of the *Browne* court's analysis of McCain's and the RNC's motions to dismiss, see *supra* notes 221-23 and accompanying text. *But see* *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962, 971-72 (C.D.

Therefore, based on the duration of *Nader*, *Henley*, *Hagan* and *Browne*, future litigants in cases involving the unauthorized use of an original musical performance in a political campaign can safely conclude that the case will outlast the campaign.

2. *Impact of Henley on Trademark Law*

In future disputes involving the unauthorized use of an original musical performance in a political campaign, courts will likely prohibit musicians from asserting a Lanham Act claim against politicians who use their original musical performances without authorization. Adopting unambiguous Second Circuit precedent, the *Henley* court held that an original musical performance cannot function as a trademark for the performer.²⁹⁰ According to the Second Circuit, an original musical performance cannot function as a trademark for either the performer or the song itself.²⁹¹ The Second Circuit has given several justifications for this rule. First, “[c]opyright law, not trademark law, is the primary vehicle for protecting the rights of a song’s composer or her successor in interest” in a musical work.²⁹² To hold otherwise would grant musicians indefinite control over a song by affording them Lanham Act protection even after the song’s copyright expires.²⁹³ Second, even

2007) (dismissing complaint for copyright infringement without leave to amend after conducting full fair use analysis); *Keep Thompson Governor Comm. v. Citizens for Gallen Comm.*, 457 F. Supp. 957, 961 (D.N.H. 1978) (making fair use determination when ruling on motion for preliminary injunction).

290. See *Henley*, 2010 U.S. Dist. LEXIS 67987, at *59-64 (holding *Henley* could not “maintain a Lanham Act claim based purely on the use of *Henley*’s songs” (citing *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 60-63 (2d Cir. 2000); *EMI Catalogue P’ship v. Hill, Holliday, Connors, Cosmopolos Inc.*, 228 F.3d 56, 64 (2d Cir. 2000); *Butler v. Target Corp.*, 323 F. Supp. 2d 1052, 1059 (C. D. Cal. 2004))).

291. See *Oliveira*, 251 F.3d at 62 (holding “the law does not accord [the plaintiff] trademark rights in the recording of her signature performance”); *EMI Catalogue P’ship v. Hill, Holliday, Connors, Cosmopolos Inc.*, No. 99-7922, 2000 U.S. App. LEXIS 30761, at *18 (2d Cir. Sept. 15, 2000) (“We hold therefore that a musical composition cannot be protected as its own trademark under the Lanham Act.”). This rule does not preclude the title of a song or a song itself from functioning as a trademark when either is used as a source identifier for a particular product. See *Oliveira*, 251 F.3d at 61-62 (explaining songs can function as trademarks and, thus, be protected by Lanham Act if they function as marks for goods or services); *EMI Catalogue*, 2000 U.S. App. LEXIS 30761, at *15 (“The title of a song certainly may fulfill the source- or product-identifying function of a mark.”).

292. *EMI Catalogue*, 2000 U.S. App. LEXIS 30761, at *16; see also *Oliveira*, 251 F.3d at 62 (applying reasoning used in *EMI Catalogue* to hold original musical performance cannot function as trademark for performer).

293. See *EMI Catalogue*, 2000 U.S. App. LEXIS 30761, at *18 (“A contrary conclusion would allow any copyright claim for infringement of rights in a musical composition to be converted automatically into a Lanham Act cause of action.”); *Oliveira*, 251 F.3d at 62 (explaining court in *EMI Catalogue* “reasoned that granting to a song the status of trademark *for itself* would stretch the definition of trademark

though many well-known musicians have recorded performances that are famously associated with them, “in no instance was such a performer held to own a protected mark in that recording.”²⁹⁴ Third, the Second Circuit distinguishes the Lanham Act’s protection of celebrities’ personas and distinctive attributes from original musical performances.²⁹⁵ The *Henley* court further explained that, while the misappropriation of a celebrity’s distinctive attribute can create consumer confusion as to whether that celebrity is endorsing a product, “the mere use of the celebrity’s prior performance does not present the same sort of confusion.”²⁹⁶ Finally, invoking constitutional separation of powers, the Second Circuit opined that, while it would not be “unthinkable for the trademark law to accord to a performing artist a trademark or service mark in her signature performance,” such an extension of trademark law must be made by Congress, not the courts.²⁹⁷ Considering that very persuasive precedent, courts will unlikely afford musicians Lanham Act rights for their original musical performances. Accordingly, in future disputes involving the unauthorized use of an original musical performance in a political campaign, it is doubtful that musicians will be able to maintain a valid Lanham Act claim.

too far and would cause disruptions as to reasonable commercial understandings” and adopting *EMI Catalogue* court’s reasoning to hold performer did not have trademark rights for performance of song).

294. *Oliveira*, 251 F.3d at 62.

295. *See id.* at 62 (“The use of [the plaintiff’s] recorded song has not taken her persona . . .”).

296. *Henley*, 2010 U.S. Dist. LEXIS 67987, at *61. . However, in *Browne*, which preceded *Henley*, the same court rejected the motions to dismiss Browne’s Lanham Act claim, holding that neither McCain nor the RNC established that Browne could not demonstrate likelihood of confusion. *See Browne v. McCain*, 611 F. Supp. 2d 1073, 1080-81 (C.D. Cal. 2009) (rejecting McCain’s motion to dismiss Browne’s Lanham Act claim); *Browne v. McCain*, 612 F. Supp. 2d 1125, 1133 (C.D. Cal. 2009) (rejecting RNC’s motion to dismiss Browne’s Lanham Act claim). Thus, because the McCain campaign used an original performance of *Running on Empty* in the McCain Advertisement, which thereby did not raise the possibility of a misappropriated distinctive attribute, the *Browne* court appears to have implicitly supported the notion that an original musical performance can function as a trademark for the performer. *See Browne*, 611 F. Supp. 2d at 1075-77 (describing McCain Advertisement as incorporating original performance of *Running on Empty*, with which Browne is “famously associated”).

297. *Oliveira*, 251 F.3d at 62-3 (reasoning it “would be profoundly disruptive to commerce” for courts to suddenly “‘recognize’ the previously unknown existence” of trademark rights in original musical performances).

B. Applying a Modified Alternative Avenues Test to Make Preliminary Fair Use Determinations in Cases Involving the Unauthorized Use of an Original Musical Performance in a Political Campaign

A case involving the unauthorized use of an original musical performance in a political campaign warrants a preliminary determination of fair use.²⁹⁸ Courts are unlikely to permit an original musical performance to function as a trademark for the performer or the song itself.²⁹⁹ Accordingly, copyright infringement will be the only federal cause of action available to musicians when politicians use their original musical performances in campaigns without their authorization.³⁰⁰ Furthermore, unless the validity of a musician's copyright for a song is at issue, the only trademark infringement defense available to defendant-politicians will be fair use.³⁰¹

Musicians such as Jackson Browne and Don Henley do not want their songs assisting the campaigns of politicians whose views they find repugnant.³⁰² However, the current pace of adjudicating fair use in the context of political campaigns allows politicians to use copyrighted material for the duration of their campaigns before

298. Cf. McGeeveran, *supra* note 113, at 122 (referencing benefit of defendants' ability to raise copyright fair use defense on motions to dismiss and summary judgment to support argument that, once record contains sufficient evidence, question of trademark fair use should be heard earlier than question of likelihood of confusion in Lanham Act disputes).

299. For a further discussion of courts' refusal to recognize an original musical performance as a trademark for the performer or the song itself, see *supra* notes 290-97 and accompanying text.

300. See *EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopolos Inc.*, No. 99-7922, 2000 U.S. App. LEXIS 30761, at *16 (2d Cir. Sept. 15, 2000) ("Copyright law, not trademark law, is the primary vehicle for protecting the rights of a song's composer or her successor in interest in the musical composition."); see also *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 62 (2d Cir. 2000) (applying reasoning used in *EMI Catalogue* to hold original musical performance cannot function as trademark for performer).

301. Often, a musician has no legal remedy when a politician plays his or her copyrighted music at a campaign rally because the politician has already obtained a blanket license from the performing rights organization to which the musician belongs. See Lauren M. Bilasz, Note, *Copyrights, Campaigns, and the Collective Administration of Performance Rights: A Call to End Blanket Licensing of Political Events*, 32 *Cardozo L. Rev.* 305, 308-09 (2010) (explaining rights under blanket licenses in context of political campaigns). A politician who obtains a blanket license for a copyrighted song may play that song publicly "for profit in a nondramatic manner" without the authorization of the musician who owns the song's copyright. See *id.* at 309 (playing music for profit with a blanket license).

302. See *Browne Complaint*, *supra* note 13, ¶ 1 (asserting McCain's politics "directly conflict[] with the political and social values that Browne has espoused and supported throughout his career"); see also *Henley Complaint*, *supra* note 14, ¶ 39 (asserting Henley did not want public to believe that he "might be associated with or endorse the social or political views of DeVore").

courts evaluate the rights of the copyright holders.³⁰³ Accordingly, while a campaign is still ongoing, a court should make a preliminary determination as to whether a politician's unauthorized use of an original musical performance constitutes fair use. A court could make such a determination by applying a modified alternative avenues test to decide a musician's motion for a preliminary injunction at the outset of a case.³⁰⁴

1. *Legal Justification for Incorporating a Modified Alternative Avenues Test Into the Fair Use Analysis for Cases Involving the Unauthorized Use of an Original Musical Performance in a Political Campaign*

A modified alternative avenues test is an appropriate addition to the fair use analysis for cases involving the unauthorized use of an original musical performance in a political campaign. Fair use is an "equitable rule of reason,"³⁰⁵ so the four statutory fair use factors are not exclusive.³⁰⁶ Furthermore, fair use determinations require a case-by-case approach, so courts may be required to consider factors outside of the four statutory factors in certain contexts.³⁰⁷ Therefore, adding an additional fair use consideration, when appropriate, is in accordance with the goals of the fair use doctrine.³⁰⁸ Though applying the alternative avenues test is not necessary for relatively straight forward questions of fair use, such as the use of a copyright in a news report or scholarly work, it is appropriate for cases involving the unauthorized use of an original musical performance in a political campaign.³⁰⁹

303. For a further discussion of the length of fair use determinations in cases involving the use of intellectual property in political campaigns relative to the length of the political campaigns that gave rise to the claims, see *supra* notes 284-89.

304. *Cf.* Patry and Posner, *supra* note 41, at 1650 (proposing fair use rule for specific situation in which party wishes to copy "old [copyrighted] works of limited value").

305. *Hustler Magazine, Inc. v. Moral Majority, Inc.*, 796 F.2d 1148, 1151 n.4 (9th Cir. 1986) (reviewing legislative history of codified fair use defense).

306. *See Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560-61 (1985) (explaining four statutory fair use factors are "are not meant to be exclusive" but are "especially relevant in determining whether the use was fair").

307. *See Campbell*, 510 U.S. at 577 ("The task [of determining fair use] is not to be simplified with bright-line rules, for the statute, like the doctrine it recognizes, calls for case-by-case analysis.").

308. For a further discussion of the flexible nature of the fair use doctrine, see *supra* notes 41-46 and accompanying text.

309. *See* 17 U.S.C.S. § 107 (LexisNexis 2010) (listing news reporting and scholarship as examples of fair use).

The alternative avenues test is an appropriate means for balancing copyright and First Amendment interests. The intuitive conflict between the First Amendment and the Copyright Clause manifests itself clearly when politicians use original musical performances in their political campaigns without authorization.³¹⁰ Campaigning for elected office is one of the most “fundamental First Amendment activities.”³¹¹ Likewise, preventing the federal government from unjustly infringing on private property rights is one of the most fundamental goals of the U.S. Constitution.³¹² Though not tangible, a copyrighted means of expression is a form of property that the Constitution empowers Congress to protect.³¹³ Copyright ownership, however, limits the ability of politicians to freely use the words, phrases and creativity that form the building blocks of a copyrighted means of expression.³¹⁴ Despite these conflicting interests, “copyright’s limited monopolies” are meant to be “compatible with free speech principles.”³¹⁵ By weighing a musician’s property rights in his or her creative expression against a politician’s need to use that form of expression to communicate with voters, adding the alternative avenues test to a fair use analysis would enable such compatibility.³¹⁶ Furthermore, the alternative avenues test is derived from a real property dispute, so it is not exclusive to trademark law in the context of intellectual property.³¹⁷ Therefore, the alternative avenues test is a proper means for balancing copyright ownership and First Amendment rights.

310. See *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1263 (11th Cir. 2001) (explaining Copyright Clause and First Amendment are “intuitively in conflict”).

311. *Buckley v. Valeo*, 424 U.S. 1, 14 (1976) (per curiam) (explaining political “contribution and expenditure limitations operate in an area of the most fundamental First Amendment activities”).

312. See U.S. CONST. amend. V (prohibiting deprivation of private property “without due process of law” and takings of private property for public use “without just compensation”).

313. See *Davis v. Blige*, 505 F.3d 90, 98 (2d Cir. 2007) (explaining copyright ownership is form of property ownership); U.S. CONST. art. I, § 8, cl. 8 (“[The Congress shall have power] [t]o 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.”).

314. For a further discussion of the idea/expression dichotomy, see *supra* notes 26-27 and accompanying text.

315. *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003) (discussing original intent behind Copyright Clause).

316. For a further discussion of the fundamental principles of the alternative avenues test, see *supra* notes 189-92 and accompanying text.

317. For a further discussion of the origin of the alternative avenues test, see *supra* notes 193-96 and accompanying text.

For it to be a proper means of evaluating fair use when an original musical performance is used in a political campaign without permission, the alternative avenues test must be modified to accord less deference to intellectual property rights.³¹⁸ The alternative avenues test must not resemble a bright line rule when used to make preliminary determinations of fair use; courts must not automatically defer to copyright holders if there are any alternative means of expression available.³¹⁹ Rather, courts must decide on a case-by-case basis whether an alternative means of communication is “sufficient.”³²⁰ Because determinations of fair use require a “sensitive” balancing of copyright and free speech interests,³²¹ the fact-sensitive inquiry to determine “sufficient alternative means” must take into account the heightened level of protection that the First Amendment affords political activities.³²² Furthermore, the scope of the fair use defense is “wider when the use relates to issues of public concern.”³²³ Accordingly, a court must carefully consider whether enjoining the use of a song will significantly reduce a candidate’s ability to reach the electorate when applying the alternative avenues test to make a preliminary fair use determination.³²⁴ A politician may feel that a particular song is the *most* effective way to convey his or her particular message to the electorate in that particular election, even though there are other adequate ways to convey the politician’s message. Additionally, courts should not place a significant burden of creating original expressive works on politicians when the politicians are trying to reach the electorate. Thus, the

318. For a further discussion of the alternative avenues test’s deference to the property rights of trademark holders in Lanham Act disputes, see *supra* notes 189-92 and accompanying text.

319. See *Campbell*, 510 U.S. at 577 (stating bright line rules are inappropriate for fair use determinations).

320. See *id.* (explaining fair use requires case-by-case analysis).

321. For a further discussion of the interests balanced in fair use determinations, see *supra* notes 38-39 and accompanying text.

322. See *Buckley v. Valeo*, 424 U.S. 1, 15 (1976) (per curiam) (“[I]t can hardly be doubted that the [First Amendment] has its fullest and most urgent application precisely to the conduct of campaigns for political office.”). For a further discussion of the heightened First Amendment protections of political speech, see *supra* notes 132-37 and accompanying text.

323. *Nat’l Rifle Ass’n of Am. v. Handgun Control Fed’n*, 15 F.3d 559, 562 (6th Cir. 1994) (explaining fair use protected defendant’s right to use document at issue “to comment on public issues and to petition the government regarding legislation” (citing *Consumers Union of U.S., Inc. v. Gen. Signal Corp.*, 724 F.2d 1044, 1050 (2d Cir. 1983), *cert. denied*, 469 U.S. 823 (1984))).

324. See *Republican Party of Minn. v. White*, 536 U.S. 765, 781-82 (2002) (“The role that elected officials play in our society makes it all the more imperative that they be allowed freely to express themselves on matters of current public importance.”).

alternative avenues test must be modified to be less deferential to copyright holders when it is incorporated into the fair use analysis for cases involving the unauthorized use of an original musical performance in a political campaign.

As modified, the alternative avenues test is a proper addition to the fair use analysis for cases involving the unauthorized use of an original musical performance in a political campaign. First, the fair use doctrine's purpose is to balance intellectual property and First Amendment interests, so the alternative avenues test's function of balancing property and First Amendment rights is a natural fit for a fair use evaluation.³²⁵ Second, a flexible and adoptable method of evaluation is required for fair use determinations.³²⁶ The modified alternative avenues test described above affords courts the necessary flexibility to determine what constitutes a "sufficient alternative means," while still according the property rights of musicians proper deference by requiring politicians to demonstrate that there are no "sufficient alternative means" of communication available. Finally, though the alternative avenues test is applied as an independent First Amendment defense in Lanham Act claims,³²⁷ the modified alternative avenues test proposed in this Comment would only function as an additional consideration in the fair use analysis for cases involving the unauthorized use of an original musical performance in a political campaign. Such an application of the alternative avenues test is consistent with the majority view that a separate First Amendment analysis is not necessary in copyright infringement suits.³²⁸

Furthermore, the concerns of courts that have rejected the alternative avenues test for Lanham Act disputes would not be applicable if the modified alternative avenues test proposed in this

325. See *Eldred*, 537 U.S. at 219-20 (opining fair use defense protects First Amendment rights by allowing "the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances."). For a further discussion of the interests balanced in a fair use analysis, see *supra* notes 38-39 and accompanying text.

326. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994) ("The fair use doctrine thus permits and requires courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster." (quoting *Stewart v. Abend*, 495 U.S. 207, 236 (1990) (internal quotations omitted))).

327. For a further discussion of the alternative avenues test's function as an independent First Amendment defense in Lanham Act claims, see *supra* notes 189-203 and accompanying text.

328. For a further discussion of the reasons why courts do not engage in a separate First Amendment analysis when adjudicating Copyright claims, see *supra* notes 164-75 and accompanying text.

Comment is applied to the fair use analysis for cases involving the unauthorized use of an original musical performance in a political campaign.³²⁹ First, many of those courts express concerns that the alternative avenues test does not adequately protect the right to free expression.³³⁰ Applying a modified alternative avenues test to the fair use analysis for a case involving the unauthorized use of an original musical performance in a political campaign would require a court to take into account the strong First Amendment protections of political speech when deciding if there are “sufficient alternative means” of communication available.³³¹ Second, the *Parks* court was very concerned that the alternative avenues test would require a judicial evaluation of creative necessity, which the court believed to be an inappropriate task for the judiciary.³³² The use of an original musical performance in a political campaign does not raise that concern because there is little artistic creativity involved in choosing a popular song to play in a campaign commercial or at a rally. Political advisors may put much thought into choosing songs that effectively convey a candidate’s message, but such strategic decision making is very different than choosing a title for an artistic work to convey the artist’s message.³³³

Finally, many courts feel that trademark and real property rights should not be equated or analogized for the purpose of balancing property rights with First Amendment rights and, thus, the alternative avenues test should not be applied to intellectual property disputes.³³⁴ In the context of evaluating the necessity of incor-

329. For a further discussion of the reasons why courts have rejected or significantly limited the use of the alternative avenues test to balance trademark and First Amendment rights, see *supra* note 198-203 and accompanying text.

330. See, e.g., *Cardtoons, L.C. v. Major League Baseball Ass’n*, 95 F.3d 959, 971 (10th Cir. 1996) (“[I]n the context of intellectual property, *Lloyd’s* ‘no adequate alternative avenues’ test does not sufficiently accommodate the public’s interest in free expression.”); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (“We cannot indulge the facile assumption that one can forbid particular words without running a substantial risk of suppressing ideas in the process.” (quoting *Cohen v. California*, 403 U.S. 15, 26 (1971))).

331. For a further discussion of how the modified alternative avenues test proposed in this Comment will take into account the heightened First Amendment protections of political speech, see *supra* notes 318-24 and accompanying text.

332. See *Parks v. LaFace Records*, 329 F.3d 437, 450 (6th Cir. 2003) (rejecting alternative avenues test because, *inter alia*, test would require courts to evaluate whether unauthorized use of trademark is “necessary” to communicate idea).

333. See *id.* (explaining importance of choosing proper words when titling expressing works). For a further discussion of the purposes of using music in political campaigns, see *supra* notes 2-6 and accompanying text.

334. See, e.g., *id.* (noting “awkwardness of analogizing property rights in land to property rights in words or ideas”); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987) (“The first amendment issues involved in this [Lanham

porating a trademark into a creative work's title, that is a valid concern.³³⁵ However, the unauthorized use of an original musical performance in a political campaign is very analogous to the dispute in *Lloyd* that gave rise to the alternative avenues doctrine.³³⁶ In *Lloyd*, the Court opined that allowing the war protesters to utilize the defendant's shopping mall rather than the adjacent public streets and sidewalks would "diminish property rights without significantly enhancing the asserted right of free speech."³³⁷ Furthermore, courts that apply the alternative avenues test to Lanham Act disputes reason that precluding a speaker from using one means of expression neither deprives the speaker of the right to free expression nor prevents the public from benefitting from the speaker's ideas.³³⁸ Had the *Browne* court prohibited the defendants from using *Running on Empty* to critique Obama in the McCain Advertisement, there would have been many other ways to supplement the clip of Obama speaking so that the McCain campaign's intended message was communicated to voters.³³⁹ Accordingly, there will be no "awkwardness" if courts apply the modified alternative avenues test proposed in this Comment to the fair use analysis for cases involving the unauthorized use of an original musical performance in a political campaign.³⁴⁰ Therefore, the modified alternative avenues test proposed in this Comment is an appropriate addition to the fair use analysis for such cases.

Act] case cannot be disposed of by equating the rights of a trademark owner with the rights of an owner of real property.").

335. See *Parks*, 329 F.3d at 450 ("To suggest that other words can be used as well to express an author's or composer's message is not a proper test for weighing First Amendment rights.").

336. See *Lloyd Corp. v. Tanner*, 407 U.S. 551, 556 (1972) (describing dispute).

337. *Id.* at 566-67 (reasoning sufficient alternative means were available for war protesters to distribute handbills).

338. See *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) (justifying injunction prohibiting use of plaintiff's trademark because "it deprives neither [the defendant] nor the public of the benefits of his ideas"); see also *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (explaining district court did not infringe on defendants' First Amendment rights by enjoining use of plaintiff's trademark because "numerous" other means of communication were available).

339. See *Browne v. McCain*, 611 F. Supp. 2d 1073, 1076-77 (C.D. Cal. 2009) (describing McCain Advertisement as playing *Running on Empty* in background while it showed clip of Obama recommending people conserve energy by keeping their tires fully inflated and displayed McCain campaign's slogans).

340. *Contra Parks*, 329 F.3d at 450 (noting "awkwardness of analogizing property rights in land to property rights in words or ideas").

2. *Practical Application of Using a Modified Alternative Avenues Test to Make Preliminary Fair Use Determinations in Cases Involving the Unauthorized Use of an Original Musical Performance in a Political Campaign*

The modified alternative avenues test proposed above will allow courts to make much needed preliminary fair use determinations in cases involving the unauthorized use of original musical performances in political campaigns. The alternative avenues test prohibits one from using another's intellectual property to engage in protected speech when there are "sufficient alternative means" of communication available.³⁴¹ Additionally, fair use is an affirmative defense, which places the burden of proof on the defendant.³⁴² Accordingly, a defendant-politician will be required to demonstrate a lack of "sufficient alternative means" of communication if the modified alternative avenues test proposed in this Comment is applied to the fair use analysis for a case involving the unauthorized use of an original musical performance in a political campaign.

A court will be able to evaluate a defendant-politician's arguments concerning the modified alternative avenues test on a plaintiff-musician's motion for a preliminary injunction.³⁴³ If the defendant-politician fails to persuade the court that there are no "sufficient alternative means" of communication available to express his or her campaign's message, the court would be justified in issuing a preliminary injunction and then allowing the defendant-politician to argue the more fact-intensive aspects of fair use—such as transformative use—at summary judgment or trial.³⁴⁴ Because the primary purpose of using an original musical performance in a political campaign is to express a political message, the necessity of that song's use will likely be more relevant to a fair use determination than questions about transformative use or the impact that the politician's unauthorized use will have on the market for that

341. *See id.* at 448 (explaining standard for alternative avenues test in Lanham Act disputes).

342. *See Soc'y of the Holy Transfiguration Monastery v. Gregory*, 685 F. Supp. 2d 217, 226 (D. Mass. 2010) (explaining fair use is affirmative defense).

343. *See* 17 U.S.C.S. § 502(a) (LexisNexis 2010) (authorizing temporary injunctions to "prevent or restrain infringement of a copyright"); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (upholding district court's preliminary injunction because there were "numerous ways" in which defendants could have conveyed message without misappropriating plaintiff's trademark); *Brach Van Houten Holding, Inc. v. Save Brach's Coal. For Chi.*, 856 F. Supp. 472, 476-77 (N.D. Ill. 1994) (evaluating alternative avenues test and issuing preliminary injunction in Lanham Act dispute).

344. *See Browne*, 611 F. Supp. 2d at 1078 (holding factual record was insufficient to evaluate four statutory fair use factors prior to discovery).

song.³⁴⁵ Therefore, incorporating the modified alternative avenues test proposed in this Comment into the fair use analysis for cases involving the unauthorized use of an original musical performance in a political campaign will allow musicians to assert their intellectual property rights while a political campaign is still ongoing and also allow politicians to argue all aspects of fair use.

IV. CONCLUSION

Music is a significant part of modern political campaigns, so it is likely that disputes between musicians and politicians will continue to arise, especially during high-profile elections.³⁴⁶ The recent *Browne* and *Henley* cases demonstrate an increased willingness on the part of both musicians and politicians to litigate disputes over the unauthorized use of music in political campaigns.³⁴⁷ Furthermore, *Browne* and *Nader* were not resolved until almost nine months and four years, respectively, after the defendants' campaigns concluded.³⁴⁸ These facts are other strong indicators that politicians are willing to seriously defend claims regarding their use of intellectual property during their campaigns. Because contemporary politicians generally play original musical performances on the campaign trail, it is likely that more disputes like *Browne* will reach the courts in the near future.³⁴⁹

Therefore, it is in the interest of justice to use the modified alternative avenues test proposed in this Comment to make preliminary fair use determinations in cases involving the unauthorized use of an original musical performance in a political campaign. The modified alternative avenues test proposed in this Comment is an appropriate addition to the fair use analysis for cases involving

345. See 17 U.S.C.S. § 107 (listing statutory fair use factors). For a further discussion of the purpose of using music in political campaigns, see *supra* notes 2-6 and accompanying text.

346. See, e.g., *Browne Complaint*, *supra* note 13, ¶¶ 1-2 (occurring during 2008 presidential election); *Henley Complaint*, *supra* note 14, ¶ 1 (occurring during 2010 Republican primary for nomination for U.S. Senate seat in California held by member of current majority party).

347. For a further discussion of *Browne* and *Henley*, see *supra* notes 210-53 and accompanying text.

348. See *Browne Settlement Order*, *supra* note 229, at 2 (issuing final settlement order in August 2009); *MasterCard Int'l Inc. v. Nader*, No. 00-6068, 2004 U.S. Dist. LEXIS 3644, at *1 (S.D.N.Y. Mar. 8, 2004) (decided on March 8, 2004) (same).

349. See *NPR Interview*, *supra* note 2 (explaining most contemporary politicians play "already existing music" on campaign trail); *Browne v. McCain*, 611 F. Supp. 2d 1073, 1076-77 (C.D. Cal. 2009) (describing McCain campaign's use of Browne's original musical performance). For a further discussion of examples of the use of original musical performances by contemporary politicians, see *supra* notes 6-13 and accompanying text.

the unauthorized use of an original musical performance in a political campaign.³⁵⁰ Applying it to the fair use determination in such a case will allow a musician to protect his or her copyright interests in a timely manner, while also allowing a politician to assert a comprehensive fair use defense.³⁵¹ Accordingly, courts should apply the modified alternative avenues test proposed in this Comment to make preliminary fair use determinations in cases involving the unauthorized use of an original musical performance in a political campaign.

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350. For a further discussion of the legal justifications for applying the modified alternative avenues test proposed in this Comment to the fair use analysis for cases involving the unauthorized use of an original musical performance in a political campaign, see *supra* notes 305-40 and accompanying text.

351. For a further discussion of how incorporating the modified alternative avenues test proposed in this Comment will allow for preliminary determinations of fair use in cases involving the unauthorized use of an original musical performance in a political campaign, see *supra* notes 341-45 and accompanying text.

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