

William & Mary Bill of Rights Journal

Volume 8 (1999-2000)
Issue 1

Article 7

December 1999

Commercial Slogans: The First Amendment Should Shield Their Use in Campaign Speech

Raena L. Smith

Follow this and additional works at: <https://scholarship.law.wm.edu/wmborj>



Part of the [Constitutional Law Commons](#), and the [First Amendment Commons](#)

Repository Citation

Raena L. Smith, *Commercial Slogans: The First Amendment Should Shield Their Use in Campaign Speech*, 8 Wm. & Mary Bill Rts. J. 241 (1999), <https://scholarship.law.wm.edu/wmborj/vol8/iss1/7>

Copyright c 1999 by the authors. This article is brought to you by the William & Mary Law School Scholarship Repository.

<https://scholarship.law.wm.edu/wmborj>

COMMERCIAL SLOGANS: THE FIRST AMENDMENT SHOULD SHIELD THEIR USE IN CAMPAIGN SPEECH

Commercial slogans and trademarks are increasingly finding their way into every aspect of the American vernacular, including speech by political officials and candidates. A previous published Note in the Journal of Law and Politics has argued that such speech should be restricted as it infringes upon the copyright or trademark holder's rights established both under federal and state law. This Note takes the opposing view, arguing that, even if campaign speech falls under the purview of federal or state statutes, the First Amendment prevents the application of laws to restrict campaign speech.

* * *

INTRODUCTION

A trademark is defined as “a word, name, symbol, device, or other designation, or a combination of such designations, that is distinctive of a person’s goods or services and that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others.”¹ Although words are the most common type of trademark, such as KODAK used in connection with cameras or FORD in connection with automobiles, numbers, letters, and slogans are also eligible for protection as trademarks.²

Trademarks have come to do more than merely identify the source and quality of goods; they “have passed into popular culture.”³ One scholar observed:

[I]deograms that once functioned solely as signals denoting the source, origin, and quality of goods, have become products in their own right, valued as indicators of the status, preferences, and aspirations of those who use them. Some trademarks have worked their way into the English language; others provide bases for vibrant, evocative metaphors.⁴

As rhetorical and literary allusion comes to be based less on classic literature and more on popular culture references,⁵ “it is not surprising that speakers and writers are

¹ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (1995); *see also* JANE C. GINSBURG, TRADEMARK AND UNFAIR COMPETITION LAW 81 (2d ed. 1996).

² *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt. g (1995).

³ Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 397 (1990).

⁴ *Id.*

⁵ *See id.* at 424.

drawn to those devices that are, by dint of heavy advertising, doubtlessly universally familiar."⁶

Politicians are no exception. The slogan has increasingly come to be used by politicians in political campaigns. United States Senator Christopher "Kit" Bond was asked by the Sierra Club to withdraw campaign commercials supporting his reelection bid that contained the slogan "For Our Families, For Our Futures."⁷ Connecticut Secretary of State Miles Rapoport, who was running for Representative Barbara Kennelly's open seat in the 1998 congressional elections, promised to cease using the phrase "When you care enough to send the very best to Congress" in promotional campaign materials after receiving a reprimand from Hallmark's attorneys.⁸ In 1986, the Campbell Soup Company filed suit against Florida state legislative candidate Jack Campbell for copying the Campbell's label on signs and other campaign materials.⁹ Walter Mondale called for substance over style in his presidential bid against Ronald Reagan when he used the famous Wendy's catch phrase "Where's the Beef?"¹⁰ Bob Dole used a version of Nike's slogan, "Just [Don't] Do It," to convince the public of his anti-drug message.¹¹ This trend is likely to continue as slogans increasingly become part of the vernacular.

It is natural to criticize politicians who usurp the creative work of others to promote their candidacies; companies frequently cite trademark law as their basis for doing so. Trademark law traditionally protects the unauthorized use of words, symbols, and slogans when such use is likely to deceive consumers into purchasing a product they had no intention of purchasing.¹² Because consumer deceit is not likely to be a factor when politicians use commercial slogans (nobody believed that Bob Dole thought up the "Just Don't Do It" slogan himself), owners may cite "likelihood of dilution" as the reason the politician must stop using the slogan. Under this theory, it is not the "likelihood of confusion" that makes the use undesirable, but rather the likelihood that the unauthorized use will diminish the selling power of the slogan.¹³ This decrease in commercial value would occur by creating multiple associations in the minds of consumers in connection with the slogan. Alternatively, the mark may risk "tarnishment" if it is used by a politician with a less than wholesome reputation, under the theory that such use produces a negative association

⁶ *Id.*

⁷ See *Sierra Club Claims Bond Stealing Tag Line*, THE HOTLINE, July 15, 1998, at *1.

⁸ See Amy Keller, *Not in the Cards*, ROLL CALL, July 16, 1998, at *1.

⁹ See Barbara Moran, *Duped by Soup*, SAN DIEGO UNION-TRIB., Aug. 30, 1986, at D1, available in 1986 WL 2910433.

¹⁰ See David I. Kertzer, *The Rite Stuff: Politics and Symbolism*, WASH. POST, July 24, 1988, at C3; Howell Raines, *Wedding Mondale to a Poor Strategy*, N.Y. TIMES, Sept. 11, 1984, at A27.

¹¹ See *Fanfare*, WASH. POST, Sept. 20, 1996, at C2.

¹² See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt. b (1995).

¹³ See *id.* § 25 cmt. c.

in the minds of consumers.¹⁴ These theories are legitimate when the mark is used to sell goods and services, because the dilution section of the Lanham Act¹⁵ specifically applies to commercial use.¹⁶ These theories are questionable, however, when applied to political speech. Because courts have extended the application of the Lanham Act to political organizations engaged in the “purveying of ideas to the public,”¹⁷ it comes close to being a weapon with which to curtail all speech that makes use of a mark, whether or not the use is commercial in the traditional sense.

Politicians have one important defense when confronted by a trademark owner who insists that their mark not be used—the First Amendment. John Shakow, then a University of Virginia law student, argued in his Note, *Just Steal It: Political Sloganeering and the Rights of Trademark Holders*,¹⁸ that trademark infringement is a harm that should trump First Amendment protection, even in the highly protected arena of political speech.¹⁹ This Note takes the opposite view. It acknowledges that, at a minimum, the First Amendment protects political speech. Specifically, it protects speech by politicians made during the course of their campaigns for public office. This Note argues that the First Amendment should shield politicians’ use of commercial slogans in speech that promotes their candidacies or conveys their positions on issues of public importance, so long as that use does not confuse consumers into believing that the owner approves of such use.

Part I of this Note discusses the two theories of recovery under federal trademark law—likelihood of confusion and likelihood of dilution—in addition to the requirement of “commercial,” as opposed to “expressive,” use. Part I will then explain how courts have stretched this requirement to the extent that trademark law risks seriously encroaching upon freedom of speech. Part II explores First Amendment doctrine in general, in relation to political speech, and specifically when it may be used successfully to defend trademark infringement and dilution claims. Part III outlines John Shakow’s view that the First Amendment should not protect politicians who infringe upon or dilute trademarks by using them in their campaigns. Part IV refutes Shakow’s view, arguing that the First Amendment should always provide a successful defense to trademark dilution suits against politicians who use commercial slogans in their campaign speech.

¹⁴ See *id.*

¹⁵ Lanham Act § 43(c), 15 U.S.C. § 1125(c) (1994 & Supp. II 1996).

¹⁶ See *id.*

¹⁷ See, e.g., *Brach Van Houten Holding, Inc. v. Save Brach’s Coalition for Chicago*, 856 F. Supp. 472 (N.D. Ill. 1994) (applying Lanham Act to coalition’s use of company logo in connection with activities aimed at convincing company not to close a factory).

¹⁸ John D. Shakow, Note, *Just Steal It: Political Sloganeering and the Rights of Trademark Holders*, 14 J.L. & POL. 199 (1998).

¹⁹ See *id.* at 200.

I. TRADEMARK LAW

A. *Theories of Recovery*

Trademark law “has its roots in the common law action of deceit.”²⁰ A defendant who marketed goods under another merchant’s trademark would be accused of misrepresenting the source of his goods and deceiving confused customers into purchasing from an impostor.²¹ Although trademark rights have been described as

property rights in nature,²² the notion of consumer confusion remains “the touchstone of traditional trademark theory”²³ under both state and federal law.²⁴

The Lanham Act,²⁵ the federal trademark statute, reflects the confusion doctrine by giving trademark owners the right under federal law to enjoin the unauthorized use of their marks by a person who

use[s] in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.²⁶

²⁰ Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 160; see also Robert J. Shaughnessy, Note, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA. L. REV. 1079, 1082-85 (1986).

²¹ See Denicola, *supra* note 20, at 160.

²² See *id.* at 164-65 n.29 (discussing *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403 (1916)). The Court in *Hanover Star* made the following point:

Common-law trade-marks, and the right to their exclusive use, are of course to be classed among property rights; but only in the sense that a man’s right to the continued employment of his trade reputation and the good-will that flows from it, free from unwarranted interference by others, is a property right, for the protection of which a trade-mark is an instrumentality.

Hanover Star, 240 U.S. at 413.

²³ Denicola, *supra* note 20, at 160 & n.8 (“The essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another.”) (quoting *Hanover Star*, 240 U.S. at 412-13).

²⁴ See Denicola, *supra* note 20, at 161 & nn.10-11 (citing 15 U.S.C. §§ 1051-1127 (1976); MODEL STATE TRADEMARK BILL § 11 (1964)).

²⁵ 15 U.S.C. §§ 1051 *et seq.* (1994 & Supp. II 1996).

²⁶ Lanham Act § 32, 15 U.S.C. § 1114(1)(a) (1994).

The Act also prevents unregistered words or symbols from being used to misidentify sources or misrepresent affiliation or sponsorship.²⁷ In determining whether an unauthorized use should be prohibited under this rationale, all federal circuits apply some version of what the Second Circuit has labeled the "*Polaroid Factors*."²⁸ The factors applied are

the strength of [the] mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers.²⁹

One commentator lists three societal interests that the consumer confusion doctrine serves: (1) it shields consumers from misleading information in the marketplace; (2) it prevents the unjust enrichment of the infringer; and (3) it protects the trademark owner's reputation from the harm that occurs when an infringer passes off inferior products as those of the owner.³⁰

In addition to the confusion rationale, a second reason for protecting trademarks emerged with the publication in 1927 of a *Harvard Law Review* article by Frank Schechter.³¹ Schechter's article argued that even if consumer confusion were unlikely, trademark owners should be able to protect the unauthorized use of their marks against "dilution," defined as the "loss of distinctiveness caused by the adoption of the mark by another."³² According to Schechter, a trademark's chief value—its selling power—depends upon the ability of the mark to invoke a favorable

²⁷ See Lanham Act § 43, 15 U.S.C. § 1125(a) (1994). The Lanham Act provides: (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Id.

²⁸ See GINSBURG, *supra* note 1, at 427-29.

²⁹ *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961).

³⁰ See Denicola, *supra* note 20, at 162-63; see also *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412-14 (1916) (explaining that trademark protection exists to protect an owner's goodwill and profits).

³¹ See Frank Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927) (discussed in Denicola, *supra* note 20, at 181-82).

³² Denicola, *supra* note 20, at 181.

impression about a specific product or service in the minds of consumers.³³ Each time another user appropriates the mark, the ability of the public to associate the mark with the owner alone diminishes its distinctiveness, even if the use is on a totally dissimilar non-competing product. The law, argued Schechter, should protect against this "dilution" in order to protect its selling power.³⁴ Because the dilution theory does not depend upon injury to the consuming public, the doctrine has been said to have its basis in trespass rather than deceit.³⁵ Beginning with Massachusetts in 1947,³⁶ twenty-five states have passed anti-dilution statutes.³⁷ The Model State Trademark Bill, which has influenced the development of state anti-dilution statutes,³⁸ provides that the "[l]ikelihood of injury to business reputation or of dilution of the distinctive quality of a mark . . . shall be a ground for injunctive relief."³⁹ Thus, state anti-dilution statutes make both the "blurring" of a mark's distinctiveness and the "tarnishment" of the affirmative associations grounds for injunctive relief.⁴⁰ For example, the Seventh Circuit upheld an injunction against an Illinois car dealership that used the slogan, "The Greatest Used Car Show on Earth," in violation of the Illinois Anti-Dilution Act.⁴¹ Ringling Brothers-Barnum & Bailey claimed the car dealership's use diluted the distinctiveness of its slogan, "The Greatest Show on Earth," and the court agreed.⁴² The court explained that in light of the length of time the circus company's slogan had been used, the scope of advertising and promotions, the nature and extent of the business, and the nationwide scope of the Ringling Brothers' reputation, the slogan was sufficiently distinctive to merit an injunction against a third party's use of a deceptively similar slogan on a non-confusing, non-competing product.⁴³

Furthermore, a trademark's goodwill can be tarnished "through its association with unsavory unrelated goods or services."⁴⁴ Many cases involve a mark's

³³ See *id.*

³⁴ See *id.*

³⁵ See Beverly W. Pattishall, *Dawning Acceptance of the Dilution Rationale for Trademark-Trade Identity Protection*, 74 TRADEMARK REP. 289, 309 (1984) ("The tort of . . . dilution sounds not in deceit but in trespass and is a wrong damaging to an incorporeal property right in the sanctity of whatever distinguishing quality may be associated with one's mark or name.").

³⁶ See Denicola, *supra* note 20, at 182.

³⁷ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25 (1995).

³⁸ See Denicola, *supra* note 20, at 182.

³⁹ MODEL STATE TRADEMARK BILL § 12 (1964).

⁴⁰ See GINSBURG, *supra* note 1, at 760-61.

⁴¹ See *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Celozzi-Ettelson Chevrolet, Inc.*, 855 F.2d 480, 481 (7th Cir. 1988); see also 765 ILL. COMP. STAT. 1035/P5 (West 1999); GINSBURG, *supra* note 1, at 760-61.

⁴² See *Ringling Bros.*, 855 F.2d at 481-83.

⁴³ See *id.*

⁴⁴ GINSBURG, *supra* note 1, at 760-61.

association with sexual activity, obscenity, or illegal activity,⁴⁵ although other types of unwholesome associations have been found to tarnish a mark.⁴⁶ If there is no risk that the use will create a negative association in the minds of consumers, a court will not enjoin a use on tarnishment grounds. For example, in a recent Second Circuit decision, the court upheld the denial of an injunction against Jim Henson Productions by relying, *inter alia*, upon the district court's finding that Spa-am, a wild boar character appearing in a Muppet movie and on related merchandising items, was a "likeable, positive character . . . [that] will not generate any negative associations" of the plaintiff's luncheon meat, SPAM.⁴⁷

The federal anti-dilution statute became effective in January 1996.⁴⁸ It provides that "the owner of a famous mark shall be entitled . . . to an injunction against another person's commercial use in commerce" of the mark if the use "causes dilution of the distinctive quality of the mark."⁴⁹ It lists seven factors a court may consider in determining whether the mark is distinctive or famous⁵⁰ and specifically states that fair use in comparative commercial advertising to identify a competitor's product or service, noncommercial use, and use in news reporting and news commentary is not actionable.⁵¹ Although the plain language of the federal statute does not define

⁴⁵ See, e.g., *American Express Co. v. Vibra Approved Lab. Corp.*, 10 U.S.P.Q.2d 2006 (S.D.N.Y. 1989) (holding use of American Express' slogan, "Don't Leave Home Without It," on condom boxes sold in sex shops violated state anti-dilution statute through tarnishment); *Coca-Cola Co. v. Gemini Rising*, 346 F. Supp. 725 (N.D. Ill. 1989) (holding "Enjoy Cocaine" poster in Coca-Cola script and colors tarnished Coca-Cola Company's trademark); see also GINSBURG, *supra* note 1, at 761.

⁴⁶ See, e.g., *Chemical Corp. of Am. v. Anheuser-Busch, Inc.*, 306 F.2d 433 (5th Cir. 1962) (enjoining household pesticide manufacturer from using, "Where there's life . . . there's bugs," in a television advertisement because it diluted Budweiser's beer slogan, "Where there's life . . . there's Bud"); see also GINSBURG, *supra* note 1, at 761.

⁴⁷ *Hormel Foods Corp. v. Jim Henson Prod., Inc.*, 73 F.3d 497, 507 (2d Cir. 1996).

⁴⁸ See Federal Trademark Dilution Act of 1995 § 3(a), 15 U.S.C. §§ 1125(c) & 1127 (1994 & Supp. II 1996) (amending Trademark (Lanham) Act of 1946 § 43, 15 U.S.C. § 1125 (1994 & Supp. II 1996), 15 U.S.C. § 1127 (1994)).

⁴⁹ Lanham Act § 43(c), 15 U.S.C. § 1125(c)(1) (1994 & Supp. II 1996).

⁵⁰ The factors include, but are not limited to: (1) the degree of distinctiveness of the mark; (2) the duration and extent of the owner's use in connection with the mark; (3) the geographical extent of the owner's use; (4) the channels of trade of the products upon which the owner's mark is used; (5) the degree of recognition the trading areas and channels of trade of the owner and the third party user; (6) the nature and extent of the third party's use; and (7) whether the owner's mark is registered. See *id.*

⁵¹ See Lanham Act § 43(c), 15 U.S.C. § 1125(c)(4) (1994 & Supp. II 1996).

dilution to include tarnishment claims,⁵² some courts have interpreted the statute to encompass such claims.⁵³

B. *The “Commercial Use” Requirement*

The Supreme Court explained in *Hanover Star Milling Co. v. Metcalf*⁵⁴ that “the essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another.”⁵⁵ Thus, trademark law traditionally protects consumers against confusion or dilution in the marketplace of *goods and services*—that is, there must be *commercial use* of the mark to succeed in a trademark action.⁵⁶ The commercial use requirement is clear under the traditional confusion doctrine⁵⁷ as well as under the

⁵² See Lanham Act § 45, 15 U.S.C. § 1127 (1994) (defining dilution as “the lessening of the capacity of a famous mark to identify and distinguish goods or services regardless of the presence or absence of—(1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception”).

⁵³ See, e.g., *America Online, Inc. v. IMS*, 24 F. Supp. 2d 548 (E.D. Va. 1998) (granting summary judgment to internet service provider AOL for claim, *inter alia*, that the defendant sent unauthorized bulk e-mail to AOL subscribers with the AOL header such that its goodwill among its customers was tarnished in violation of the Lanham Act); *Hasbro, Inc. v. Internet Entertainment Group*, 40 U.S.P.Q.2d 1479, 1480 (W.D. Wash. 1996) (holding that the adult entertainment group diluted Hasbro’s CANDY LAND mark “by using the name ‘CANDYLAND’ to identify a sexually explicit Internet site and by using the name string ‘candyland.com’ as an Internet domain name”).

⁵⁴ 240 U.S. 403 (1916).

⁵⁵ *Id.* at 412-13.

⁵⁶ See, e.g., *Panavision Int’l, L.P. v. Toeppen*, 141 F.3d 1316, 1324 (9th Cir. 1998) (discussing commercial use as an element of a claim under the Federal Trademark Dilution Act).

⁵⁷ Federal law imposes liability upon persons who “use in commerce . . . a registered mark *in connection with the sale, offering for sale, distribution, or advertising of any goods or services* on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.” Lanham Act § 32, 15 U.S.C. § 1114(1)(a) (1994) (emphasis added).

In contrast to the commercial use requirement, the “use in commerce” requirement is a “jurisdictional predicate” rather than a requirement of profit-seeking uses of a mark. See *Planned Parenthood Fed’n v. Bucci*, No. 97 Civ. 0629, 1997 WL 133313, at *3 (S.D.N.Y. Mar. 24, 1997). Because *The Trademark Cases*, 100 U.S. 82 (1879), invalidated a federal trademark statute as not explicitly within the limits of Congress’ constitutional powers, see *id.* at 98, Congress specifically provided in the Lanham Act that the intent of the law was to “regulate commerce within the control of Congress.” Lanham Act § 45, 15 U.S.C. § 1127 (1994 & Supp. II 1996); see also *Steele v. Bulova Watch Co.*, 344 U.S. 280, 283 (1952) (discussing “broad jurisdictional powers” given to courts by the Lanham Act); *United We Stand Am., Inc. v. United We Stand, Am. New York, 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 [sic] 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.”).

dilution doctrine,⁵⁸ although not all state anti-dilution laws specifically require commercial use.⁵⁹

Although some courts have refused to apply the Lanham Act on the basis that the unauthorized use was not commercial in nature,⁶⁰ courts generally have interpreted the commercial use requirement broadly. Political and other non-profit organizations may provide "services" for their members even if they are not undertaken for profit.⁶¹ Any organization that raises funds and provides education and information to their members is usually deemed to be providing "services" within the context of the Lanham Act.⁶² Even those that do not raise funds are sometimes deemed to provide "services" to its members or the public.⁶³ In *United We Stand America v. United We*

⁵⁸ Federal anti-dilution law entitles owners of famous marks to an injunction against another person's "commercial use in commerce" of a mark or trade name that causes dilution. Lanham Act § 43(c), 15 U.S.C. § 1125(c)(1) (1994 & Supp. II 1996) (emphasis added). This law specifically excludes "[n]oncommercial use." Lanham Act § 43(c), 15 U.S.C. § 1125(c)(4)(B) (1994 & Supp. II 1996).

⁵⁹ See, e.g., WASH. REV. CODE § 19.77.160 (1999).

⁶⁰ See, e.g., *Tax Cap Comm. v. Save Our Everglades, Inc.*, 933 F. Supp. 1077, 1081 (S.D. Fla. 1996) (finding that the environmental advocacy corporation did not use the political action committee's trade dress in commerce because the activity which gave rise to the claim—the circulation of petitions among voters, absent the solicitation of funds or supporters—is not a service within the meaning of the Lanham Act, but rather the "quintessential political activity"); *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931, 934-35 (D.D.C. 1985) (holding that public interest group's use of "star wars" to persuade the public of views about the Reagan Administration's strategic defense initiative did not infringe upon filmmaker's STAR WARS trademark because "[p]urveying points of view is not a service" and because it was a "descriptive, non-trade use").

⁶¹ See *American Diabetes Ass'n v. National Diabetes Ass'n*, 533 F. Supp. 16 (E.D. Pa. 1981), *aff'd*, 681 F.2d 804 (3d Cir. 1982) (using trade name in connection with the provision of charitable services puts organization within the purview of the Lanham Act).

⁶² See, e.g., *Planned Parenthood Fed'n*, 1997 WL 133313 at *1 (holding that pro-life Catholic radio host's use of pro-choice group's mark in domain name of web site is in connection with the provision of fund-raising and informational services); *Committee for Idaho's High Desert v. Yost*, 881 F. Supp. 1457 (D. Idaho 1995) (applying the Lanham Act to activities by competing environmental advocacy groups engaged in soliciting members and funds, providing informational and educational services, seeking government grants, and commenting to agencies and public officials), *aff'd in part and rev'd in part*, 92 F.3d 814 (9th Cir. 1996); *Brach Van Houten Holding, Inc. v. Save Brach's Coalition*, 856 F. Supp. 472 (N.D. Ill. 1994) (applying the Lanham Act to coalition's use of company logo in connection with fund-raising and organizational activities aimed at increasing job security for workers).

⁶³ See, e.g., *International Ass'n of Machinists & Aero. Workers v. Winship Green Nursing Ctr.*, 103 F.3d 196, 202 (1st Cir. 1996) (applying the Lanham Act to employer's use of union service mark on propaganda distributed during union organizing campaign on basis that employer was "selling" a lack of need for union "services"); *MGM-Pathe Communications v. Pink Panther Patrol*, 774 F. Supp. 869 (S.D.N.Y. 1991) (applying the Lanham Act to a group that provides free service of protecting gay individuals from

Stand, America New York, Inc.,⁶⁴ the Second Circuit reaffirmed the extension of the Lanham Act to organizations that promote political candidates when it declared that “a political organization that adopts a platform and endorses candidates under a trade name performs the valuable service of communicating to voters that it has determined that the election of those candidates would be beneficial to the objectives of the organization.”⁶⁵

Thus, courts have broadly interpreted and applied the Lanham Act to organizations engaged in political speech, so long as the use of the mark is in connection with the group’s fund-raising, organizational, or informational activities such that it can be deemed to be providing “services” to its members or the public. However, to date, no court has extended the Act to *candidate* speech, which is the issue raised in this Note. It would seem to be a small step to do so under the Second Circuit’s reasoning, for there is little, if any, difference between an organization that advocates the election of a candidate and the candidate herself. Both are providing the “service” of communicating to voters the benefits of electing that candidate. If the purveying of ideas can be a service, as the Second Circuit explained in *United We Stand America*,⁶⁶ then the question becomes whether the First Amendment should shield the use. The issue therefore is whether a politician’s use of a commercial slogan in a campaign should be shielded by the First Amendment, if conveying her political views will fall within the purview of the Lanham Act.

II. THE FIRST AMENDMENT

A. *Doctrine*

The First Amendment provides that “Congress shall make no law . . . abridging the freedom of speech, or of the press.”⁶⁷ This apparently simple statement has fostered a complex body of law concerning the exact protections the First Amendment extends to varying forms and manners of speech. Nevertheless, the Supreme Court

assault).

⁶⁴ 128 F.3d 86 (2d Cir. 1997) (applying the Lanham Act to a use of plaintiff’s “United We Stand America” mark by political campaign committee that also engages in solicitation of funds, political organization, and endorsement of candidates).

⁶⁵ *Id.* at 90; *see also* *Tomei v. Finley*, 512 F. Supp. 695, 698 (N.D. Ill. 1981) (enjoining a political party from using an acronym that is confusingly similar to another political party).

⁶⁶ *See United We Stand Am.*, 128 F.3d at 91 (disagreeing with the District of Columbia District Court’s statement in *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931, 934 (D.D.C. 1985), that “[p]urveying points of view is not a service”).

⁶⁷ U.S. CONST. amend. I.

consistently applies certain principles across various topic areas.⁶⁸ First, laws that regulate the content of speech normally trigger a higher level of judicial scrutiny than do content-neutral regulations.⁶⁹ A prominent case that demonstrates the Court's aversion to content-based regulation is the *Texas v. Johnson*,⁷⁰ flag-burning case. In *Johnson*, a statute prohibited actions that "deface, damage, or otherwise physically mistreat [the flag] in a way that the actor knows will seriously offend one or more persons likely to observe or discover his action."⁷¹ Because the statute prohibited flag-burning as a means of protest but not as a means of conveying patriotic messages, it was an impermissible content-based regulation that infringed upon freedom of speech.⁷² In general, content-based regulation will not be upheld unless the government can prove it has a compelling interest in the restriction and that such restriction is tailored in a sufficiently narrow way to further that interest.⁷³ However, the application of the strict scrutiny test to content-based speech rarely leads to a result favorable in the eyes of the government; as Professor Farber noted, "Although the Court has recognized other government interests as compelling, it has never found speech restrictions to be sufficiently narrowly tailored except in connection with political campaigns."⁷⁴ Professor Farber was referring to the Court's decision in *Buckley v. Valeo*,⁷⁵ which upheld some limits on campaign contributions to federal candidates in order to prevent the appearance or reality of corruption.⁷⁶

In contrast, the Court takes a less rigorous approach to content-neutral regulations.⁷⁷ Regulations that restrict not the speech itself but only its "time, place, or manner" are "[t]he purest example of content-neutral laws."⁷⁸ For example, in *Clark v. Community for Creative Non-Violence*,⁷⁹ a National Park Service regulation permitted camping in National Parks only in specifically-designated campgrounds.⁸⁰ The Park Service granted permits to groups who wished to demonstrate the plight of the homeless in Lafayette Park and the National Mall, both National Parks, but refused to grant them permits to sleep in either one.⁸¹ The Court upheld the

⁶⁸ See RODNEY A. SMOLLA, SMOLLA & NIMMER ON FREEDOM OF SPEECH § 2:65 (3d ed. 1998).

⁶⁹ See *id.* at § 2:66.

⁷⁰ 491 U.S. 397 (1989). For a discussion of *Johnson*, see DANIEL A. FARBER, THE FIRST AMENDMENT 23-24 (1998).

⁷¹ *Johnson*, 491 U.S. at 400 n.1 (quoting TEX. PENAL CODE ANN. § 42.09 (West 1989)).

⁷² See FARBER, *supra* note 70, at 24.

⁷³ See *id.* at 24-25.

⁷⁴ *Id.* at 33.

⁷⁵ 424 U.S. 1 (1976).

⁷⁶ See *id.* at 236.

⁷⁷ See SMOLLA, *supra* note 68, at § 2:66; see also FARBER, *supra* note 70, at 25.

⁷⁸ SMOLLA, *supra* note 68, at § 2:66.

⁷⁹ 468 U.S. 288 (1984).

⁸⁰ See *id.* at 289-94.

⁸¹ See *id.* at 290-91.

regulation because it was content-neutral; it did not prevent the groups from delivering their message, and to permit camping in the National Parks would frustrate the Park Service's interest in maintaining parks in an attractive and intact condition.⁸² In short, "[w]e have often noted that restrictions of this kind are valid provided that they are justified without reference to the content of the regulated speech, that they are narrowly tailored to serve a significant governmental interest, and that they leave open ample alternative channels of communication of the information."⁸³ Similar laws passed for purposes unrelated to the restriction of the content of speech but that nevertheless have an "incidental impact" upon it are considered by the Court to be content-neutral.⁸⁴ In the leading case, *United States v. O'Brien*,⁸⁵ the defendant burned his draft card as a means of protesting the Vietnam War.⁸⁶ The Court upheld the regulation as a means of ensuring that the government could check a person's draft status via the draft card.⁸⁷

The difficulty often lies in determining whether the speech is content-based or content-neutral, because that distinction will determine the level of scrutiny applied.⁸⁸ In *United States v. Eichman*,⁸⁹ the Court again considered a federal flag-burning statute that prohibited the burning of a flag except when disposing of worn or soiled ones.⁹⁰ This time, however, the drafters included no mention of potential offense taken by onlookers.⁹¹ Nevertheless, the Court determined the statute was content-based: "The Government asserts an interest in 'protect[ing] the physical integrity of the flag under all circumstances' in order to safeguard the flag . . . 'only when a person's treatment of the flag communicates [a] message' to others that is inconsistent with those ideals."⁹²

Although content-based regulation has nearly always received a heightened level of scrutiny, the Court will sometimes apply a lower level of scrutiny as determined by the subject matter of the speech or its setting,⁹³ and sometimes to regulations with a "long historical pedigree."⁹⁴

At one time, the Supreme Court applied the First Amendment mechanically, by dividing speech into categories that did or did not receive First Amendment

⁸² See *id.* at 295-96.

⁸³ *Id.* at 293.

⁸⁴ See SMOLLA, *supra* note 68, at § 2:66.

⁸⁵ 391 U.S. 367 (1968).

⁸⁶ See *id.* at 369.

⁸⁷ See *id.* at 385-86. For a discussion of *O'Brien*, see FARBER, *supra* note 70, at 25.

⁸⁸ See FARBER, *supra* note 70, at 21.

⁸⁹ 496 U.S. 310 (1990).

⁹⁰ See *id.* at 312.

⁹¹ See *id.* at 314.

⁹² *Id.* at 315-16 (quoting Brief of the United States at 28 and *Texas v. Johnson*, 491 U.S. 397, 410 (1989)). For a discussion of *Eichmann*, see FARBER, *supra* note 70, at 27.

⁹³ See SMOLLA, *supra* note 68, at § 2:68.

⁹⁴ See FARBER, *supra* note 70, at 33.

protection.⁹⁵ The Court in *Chaplinsky v. New Hampshire*⁹⁶ explained that lewd, obscene, profane, libelous, and insulting (“fighting words”) speech are unprotected forms of expression.⁹⁷ The Court has retreated from this approach; today, only a few classes of speech continue to be treated as outside the scope of First Amendment protection.⁹⁸ Obscene speech, for example, falls outside the scope of First Amendment protection.⁹⁹ Commercial speech falls within the scope of the First Amendment, but receives less than strict scrutiny analysis.¹⁰⁰ Professor Smolla has noted, “With these very few exceptions, however, the Court has not used *subject matter alone* to disqualify even the most offensive forms of speech.”¹⁰¹

In addition to a subject-matter based departure, the Court has departed from applying strict scrutiny to content-based regulations of speech where the setting

⁹⁵ See SMOLLA, *supra* note 68, at § 2:70.

⁹⁶ 315 U.S. 568 (1942).

⁹⁷ See *id.* at 571-72.

⁹⁸ See SMOLLA, *supra* note 68, at § 2:70. According to Professor Smolla, many of the categories listed in *Chaplinsky* now receive some form of protection. See *id.* For example, the Court’s decision in *Cohen v. California*, 403 U.S. 15 (1971), resulted in the protection of “lewd” speech from regulation; “libelous” speech first received protection in *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964).

In *New York Times v. Sullivan*, the Court considered a libel action brought by a public official against critics of his official conduct. It was undisputed that some of the statements made in the newspaper advertisement were inaccurate. See *id.* at 258. The Court stated, “If neither factual error nor defamatory content suffices to remove the constitutional shield from criticism of official conduct, the combination of the two elements is no less adequate.” *Id.* at 273. The Court then set forth the requirement of “actual malice” that applies to libel actions brought against public officials, and that was later extended to public figures:

The constitutional guarantees require, we think, a federal rule that prohibits a public official from recovering damages for a defamatory falsehood relating to his official conduct unless he proves that the statement was made with ‘actual malice’ that is, with knowledge that it was false or with reckless disregard of whether it was false or not.

Id. at 279-80.

⁹⁹ See *Miller v. California*, 413 U.S. 15, 27 (1973) (holding that the evaluation of pornographic materials in determining obscenity must be with reference to the standards of the state rather than to some uniform national standard). In *Miller*, the Court stated, “This much has been categorically settled by the Court, that obscene material is unprotected by the First Amendment.” *Id.* at 23.

¹⁰⁰ See *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557, 566 (1980) (applying a balancing test to commercial speech that requires consideration of four factors: (1) whether the commercial speech concerns a lawful activity and is not misleading; (2) whether the government interest asserted to justify the regulation is substantial; (3) whether the regulation directly advances that government interest; and (4) whether the regulation is no more extensive than necessary to serve that interest).

¹⁰¹ SMOLLA, *supra* note 68, at § 2:71.

justifies it.¹⁰² Such cases usually involve speech with some relationship to government operations.¹⁰³ One such example is the right of school officials to control the conduct of its students.¹⁰⁴ In 1969, the Court in *Tinker v. Des Moines Independent Community School District*,¹⁰⁵ reassured students that they do not “shed their constitutional rights to freedom of speech or expression at the schoolhouse gate.”¹⁰⁶ Nevertheless, the First Amendment will not protect conduct by a student that “materially disrupts classwork or involves substantial disorder or invasion of the rights of others.”¹⁰⁷ Later decisions gave more deference to school officials in relation to quasi-curricular activities.¹⁰⁸ For example, school officials may regulate speeches made at student assemblies and articles written by students that are published in the school newspaper. In *Bethel School District No. 43 v. Fraser*,¹⁰⁹ the Court upheld a student’s suspension for giving a sexually explicit speech at a school assembly.¹¹⁰ The Court expressed concern that such a speech could “undermine the school’s basic educational mission.”¹¹¹ The Court averred:

A high school assembly or classroom is no place for a sexually explicit monologue directed towards an unsuspecting audience of teenage students. Accordingly, it was perfectly appropriate for the school to disassociate itself to make the point to the pupils that vulgar speech and lewd conduct is wholly inconsistent with the “fundamental values” of public school education.¹¹²

In *Hazelwood School District v. Kuhlmeier*,¹¹³ the Court upheld the right of school officials to censor a school newspaper.¹¹⁴ The Court drew a distinction between tolerating speech and affirmatively promoting it. According to the Court, *Tinker* involved the former and *Hazelwood* the latter.¹¹⁵ The *Hazelwood* Court held that “educators do not offend the First Amendment by exercising editorial control over the

¹⁰² See *id.* at § 2:72.

¹⁰³ See FARBER, *supra* note 70, at 33; see also DOUGLAS M. FRALEIGH & JOSEPH S. TUMAN, FREEDOM OF SPEECH IN THE MARKETPLACE OF IDEAS 273-74 (1997).

¹⁰⁴ See FARBER, *supra* note 70, at 33, 187-90.

¹⁰⁵ 393 U.S. 503 (1969) (upholding the right of students to wear black armbands in protest of the Vietnam War).

¹⁰⁶ *Id.* at 506.

¹⁰⁷ *Id.* at 513.

¹⁰⁸ See FARBER, *supra* note 70, at 188.

¹⁰⁹ 478 U.S. 675 (1986).

¹¹⁰ See *id.* at 685.

¹¹¹ *Id.* at 685.

¹¹² *Id.* at 685-86.

¹¹³ 484 U.S. 260 (1988).

¹¹⁴ See *id.* at 274.

¹¹⁵ See *id.* at 270-71.

style and content of student speech in school-sponsored expressive activities so long as their actions are reasonably related to legitimate pedagogical concerns."¹¹⁶

Another example of a setting-based exception is the ability of the government to regulate the speech of public sector employees.¹¹⁷ In general, the government may regulate speech affecting the operations of the workplace; however, it is not as free to regulate speech relating to matters of public concern.¹¹⁸ In *Rankin v. McPherson*,¹¹⁹ a clerical employee was fired for remarking on the attempted assassination of the President of the United States, "If they go for him again, I hope they get him."¹²⁰ The Court cited *Pickering v. Board of Education*¹²¹ for the test applicable in government employment settings. It found that determining whether a public employee has been properly discharged requires "a balance between the interests of the [employee], as a citizen, in commenting upon matters of public concern and the interest of the State, as an employer, in promoting the efficiency of the public services it performs through its employees."¹²²

After concluding that the threshold question of whether the employee's speech was about a matter of public concern had been met in the affirmative, the Court placed the burden on the state to prove that its interest in providing efficient public services through its employees outweighed the employee's interest in freedom of expression.¹²³ The Court explained that certain considerations are part of the balancing test, such as "whether the statement impairs discipline by superiors or harmony among co-workers, has a detrimental impact on close working relationships for which personal loyalty and confidence are necessary, or impedes the performance of the speaker's duties or interferes with the regular operation of the enterprise."¹²⁴ The Court concluded, "While McPherson's statement was made at the workplace, there is no evidence that it interfered with the efficient functioning of the office."¹²⁵ Although the Court found her discharge improper, the case illustrates the process used by the Court to determine when public employers may or may not regulate employee speech.¹²⁶

¹¹⁶ *Id.* at 273.

¹¹⁷ See FARBER, *supra* note 70, at 193-200.

¹¹⁸ See *id.* at 194.

¹¹⁹ 483 U.S. 378 (1987).

¹²⁰ *Id.* at 380.

¹²¹ 391 U.S. 563 (1968).

¹²² *Rankin*, 483 U.S. at 384 (quoting *Pickering*, 391 U.S. at 568).

¹²³ See *id.* at 388.

¹²⁴ *Id.* (citing *Pickering*, 391 U.S. at 570-73).

¹²⁵ *Id.* at 388-89.

¹²⁶ Preceding *Rankin* was *Connick v. Myers*, 461 U.S. 138 (1983), in which the Court found in favor of the employer. In that case, the public employee circulated a questionnaire to fellow employees regarding office policy, office morale, and other issues relating to the workplace. Because only one of the items on the questionnaire related to a matter of public concern—a question relating to pressure on employees to work on a political

Finally, the Court has upheld content-based regulation of speech with a long historical pedigree.¹²⁷ For example, state laws prohibiting vote solicitation within a certain distance of a polling place may be justified by the long history of such restrictions.¹²⁸ In *Marsh v. Chambers*,¹²⁹ the Court rejected an Establishment Clause¹³⁰ challenge to the practice of opening legislative sessions with prayers by a state-employed chaplain.¹³¹ The Court relied upon the tradition and history of the practice in this country:

From colonial times through the founding of the Republic and ever since, the practice of legislative prayer has coexisted with the principles of disestablishment and religious freedom . . . It can hardly be thought that in the same week Members of the First Congress voted to appoint and to pay a chaplain for each House and also voted to approve the draft of the First Amendment for submission to the states, they intended the Establishment Clause of the Amendment to forbid what they had just declared acceptable.¹³²

A free speech claim would presumably have been met with the same objections despite the fact that only religious messages were allowed.¹³³

B. *First Amendment and Political Speech*

1. Campaign Speech

Although there are many justifications in support of free speech,¹³⁴ some of which

campaign—the Court found that the speech primarily expressed a grievance about office policy. *See id.* at 154. It was thus subject to a balancing test that ultimately weighed in favor of the employer’s right to snuff out “action which he reasonably believed would disrupt the office, undermine his authority, and destroy close working relationships.” *Id.* at 154.

¹²⁷ *See* FARBER, *supra* note 70, at 33-34.

¹²⁸ *See* *Burson v. Freeman*, 504 U.S. 191, 199 (1992) (holding that a Tennessee statute prohibiting vote solicitation and display or distribution of campaign materials within 100 feet of a polling place was narrowly tailored to serve the compelling state interest in preventing voter intimidation and election fraud).

¹²⁹ 463 U.S. 783 (1983).

¹³⁰ “Congress shall make no law respecting an establishment of religion.” U.S. CONST. amend. I.

¹³¹ *See* *Marsh*, 463 U.S. at 791.

¹³² *Id.* at 786, 790.

¹³³ *See* FARBER, *supra* note 70, at 33.

¹³⁴ *See* FRALEIGH & TUMAN, *supra* note 103, at 6-10. Professors Fraleigh and Tuman explain the four primary rationales for protecting speech: (1) it is vital to self-government; (2) it facilitates the discovery of truth; (3) it promotes individual autonomy; (4) regulation

the Supreme Court has emphasized over others,¹³⁵ there is no doubt that “the First Amendment ‘has its fullest and most urgent application’ to speech uttered during a campaign for political office.”¹³⁶ According to the Court, “Whatever differences may exist about interpretations of the First Amendment, there is practically universal agreement that a major purpose of that Amendment was to protect the free discussion of governmental affairs. This, of course, includes discussions of candidates”¹³⁷

Thus, when Congress passed campaign reforms in 1974 in response to the Watergate Scandal,¹³⁸ the Supreme Court viewed them skeptically. For example, in *Buckley v. Valeo*,¹³⁹ the Court performed a strict scrutiny analysis to strike down limits on campaign expenditures and uphold limits on campaign contributions.¹⁴⁰ The Court reasoned that the government had a sufficiently compelling interest in preventing corruption or the appearance of corruption in the political process.¹⁴¹ The Court stated, “To the extent that large contributions are given to secure a political *quid pro quo* from current and potential office holders, the integrity of our system of representative democracy is undermined.”¹⁴² In response to contentions that such limits were not the least restrictive means of preventing corruption, the Court reasoned:

The Act’s \$1,000 contribution limitation focuses precisely on the problem of large campaign contributions . . . while leaving persons free to engage

of “harmful” speech will inevitably be abused to constrain worthwhile speech. *See id.* at 6; *see also* ALEXANDER MEIKLEJOHN, *FREE SPEECH AND ITS RELATION TO SELF-GOVERNMENT* 27 (1948) (discussing how free speech ensures that citizens have access to all ideas about government policy from which to make rational decisions about it).

¹³⁵ *See* FRALEIGH & TUMAN, *supra* note 103, at 6.

¹³⁶ *Eu v. San Francisco County Democratic Cent. Comm.*, 489 U.S. 214, 223 (1989) (quoting *Monitor Patriot Co. v. Roy*, 401 U.S. 265, 272 (1971)). For a discussion of *Eu*, see SMOLLA, *supra* note 68, at § 16:3 n.14.

¹³⁷ *Mills v. Alabama*, 384 U.S. 214, 218 (1966), *cited in* *Buckley v. Valeo*, 424 U.S. 1, 14 (1976) (per curiam) (holding legislative prohibition of election-day editorials invalid on First Amendment grounds).

¹³⁸ *See* *Buckley*, 424 U.S. at 13.

The major contribution and expenditure limitations in the Act prohibit individuals from contributing more than \$25,000 in a single year or more than \$1,000 to any single candidate for an election campaign and [prohibited an individual] from spending more than \$1,000 a year ‘relative to a clearly identified candidate.’ Other provisions restrict a candidate’s use of personal and family resources in his campaign and limit the overall amount that can be spent by a candidate in campaigning for federal office.

Id. (citing 18 U.S.C. § 608 (1970 & Supp. IV 1974)).

¹³⁹ 424 U.S. 1 (1976) (per curiam).

¹⁴⁰ *See id.* at 143.

¹⁴¹ *See id.* at 67.

¹⁴² *Id.* at 26-27.

in independent political expression. . . . [T]he Act's contribution limitations in themselves do not undermine to any material degree the potential for robust and effective discussion of candidates and campaign issues by individual citizens, associations, the institutional press, candidates, and political parties.¹⁴³

On the other hand, the Court found that the limits on independent expenditures placed heavy burdens on core First Amendment expression while failing to serve any substantial interest in stemming actual or perceived corruption.¹⁴⁴ The Court reasoned that independent expenditures on behalf of a candidate were by definition not coordinated with a campaign, and thus of little value to a candidate and could even prove counterproductive.¹⁴⁵ These factors "alleviate[] the danger that expenditures will be given as a *quid pro quo* for improper commitments from the candidate."¹⁴⁶ At the same time, the limitations "severely restrict[] all independent advocacy despite [their] substantially diminished potential for abuse."¹⁴⁷

Restrictions on expenditures by candidates of their own personal funds received disapproval as well.¹⁴⁸ The Court noted that the governmental interest in preventing actual or perceived corruption is not served by limiting candidates' expenditures of personal funds because it reduces their dependence on outside contributions and the potential coercive effect they may have.¹⁴⁹ At the same time, such a restriction

poses a substantial restraint on the ability of persons to engage in protected First Amendment expression. The candidate, no less than any other person, has a First Amendment right to engage in the discussion of public issues and vigorously and tirelessly to advocate his own election. . . . Indeed, it is of particular importance that candidates have the unfettered opportunity to make their views known so that the electorate may intelligently evaluate the candidates' personal qualities and their positions on vital public issues before choosing among them on election day.¹⁵⁰

The overall limits on campaign expenditures were also rejected. According to the Court, "The major evil associated with rapidly increasing campaign expenditures is the danger of candidate dependence on large contributions. The interest in alleviating

¹⁴³ *Id.* at 28-29.

¹⁴⁴ *See id.* at 47-48.

¹⁴⁵ *See id.* at 47.

¹⁴⁶ *Id.*

¹⁴⁷ *Id.*

¹⁴⁸ *See id.* at 47-48.

¹⁴⁹ *See id.* at 53.

¹⁵⁰ *Id.* at 52-53.

the corrupting influence of large contributions is served by the Act's contribution limitations and disclosure provisions rather than by § 608(c)'s campaign expenditure ceilings."¹⁵¹

The Court's disapproval of limits on campaign expenditures is premised upon its equation of expenditures with speech,¹⁵² and therefore signals the Court's willingness to protect candidate speech. Subsequent decisions have tracked the expenditure/contribution approach.¹⁵³

2. Politicians' Access to the Media

There are two legal models under which politicians' access to the media has been analyzed: the print model and the broadcast model.¹⁵⁴ Professor Farber has explained:

In the print model, private publishers are completely autonomous, protected from almost all forms of government interference with the content of their publications. In the broadcasting model, stations are considered to be trustees acting in the public interest, and are subject to FCC regulation to ensure that they live up to their duties.¹⁵⁵

Broadcasting has been regulated since Congress passed the Communications Act of 1934.¹⁵⁶ Pursuant to that Act, the Federal Communications Commission (FCC) issued regulations aimed at encouraging diversity, of which the "fairness doctrine"

¹⁵¹ *Id.* at 55.

¹⁵² *See id.* at 14-17. The Court rejects the Court of Appeal's view that the contribution and expenditure limits are comparable to restrictions on conduct upheld in *United States v. O'Brien*, 391 U.S. 367, 372 (1968); *see also supra* notes 85- 87 and accompanying text. "[T]his Court has never suggested that the dependence of a communication on the expenditure of money operates itself to introduce a nonspeech element or to reduce the exacting scrutiny required by the First Amendment." *Buckley*, 424 U.S. at 16.

¹⁵³ *See* FARBER, *supra* note 70, at 237-39. The Court has since upheld limits on contributions to multi-candidate political committees, *see* *California Med. Ass'n v. FEC*, 453 U.S. 182 (1981), and struck down limits on expenditures by such groups, *see* *FEC v. National Conservative PAC*, 470 U.S. 480 (1985). The Court has taken a different approach with respect to corporations. It upheld a state prohibition on corporate expenditures except through special political action funds despite any burden on the corporation's First Amendment rights, because "it ensures that expenditures reflect actual public support for the political ideas espoused by corporations." *Austin v. Michigan Chamber of Commerce*, 494 U.S. 652, 660 (1990).

¹⁵⁴ *See* FARBER, *supra* note 70, at 220-21.

¹⁵⁵ *Id.*

¹⁵⁶ 47 U.S.C. § 151 (1994).

is the most notable.¹⁵⁷ Under this doctrine, broadcasters were required “to devote a reasonable amount of time to discussion of public issues and to give fair coverage of each side.”¹⁵⁸ The Supreme Court, in *Red Lion Broadcasting Co. v. FCC*,¹⁵⁹ upheld the fairness doctrine.¹⁶⁰ According to the Court, the scarcity of broadcast frequencies justified greater regulation of speech as a means of preserving “an uninhibited marketplace of ideas,”¹⁶¹ that might otherwise be restricted by station owners and networks who wished to make time available only for the issues and candidates with which and whom they agree.¹⁶² Although the FCC abolished the fairness doctrine in the late 1980s, thanks to a decision affirmed by the Court of Appeals for the District of Columbia Circuit,¹⁶³ analogous provisions still exist with respect to candidates for political office.¹⁶⁴

Four major statutory provisions govern broadcasters’ obligations to political candidates.¹⁶⁵ First, the “equal time” rule requires stations to provide political candidates equal opportunities to their facilities. Specifically, the rule embodied in Section 315(a) of the Communications Act requires that a broadcaster who permits the “use” of broadcast station facilities by any “legally qualified candidate for any public office [whether federal, state, or local] . . . shall afford equal opportunities to all other such candidates for that office.”¹⁶⁶ An exception is provided for an appearance by a candidate in a “bona fide newscast.”¹⁶⁷ Section 315 provides a “contingent right of access,” meaning that a candidate’s right arises only after a broadcaster has provided his opponent with a forum.¹⁶⁸ The Supreme Court has never explicitly considered whether the “equal opportunities” rule is constitutional, “although *Red Lion* presumably removed any question on this score.”¹⁶⁹

¹⁵⁷ See FARBER, *supra* note 70, at 216-17.

¹⁵⁸ *Id.* at 216.

¹⁵⁹ 395 U.S. 367 (1969).

¹⁶⁰ See *id.* at 375-79.

¹⁶¹ *Id.* at 390.

¹⁶² See *id.* at 392.

¹⁶³ See *Syracuse Peace Council v. FCC*, 867 F.2d 654, 669 (D.C. Cir. 1989); see also Glen O. Robinson, *The Electronic First Amendment: An Essay for the New Age*, 47 DUKE L.J. 899, 926 (1998) (reporting that the fairness doctrine was officially abandoned in 1989).

¹⁶⁴ See *infra* note 185 and accompanying text.

¹⁶⁵ See Reed Hundt, *The Public's Airwaves: What Does the Public Interest Require of Television Broadcasters*, 45 DUKE L.J. 1089, 1103 (1996); Douglas C. Melcher, *Delineating the Scope of a Licensee's Obligation to Broadcast Political Advertisements*, 66 GEO. WASH. L. REV. 842, 842-47 (1998); Ralph Nader & Claire Riley, *Oh, Say Can You See: A Broadcast Network for the Audience*, 5 J.L. & POL. 1, 31-32 (1988); Evan Richman, Note, *Deception in Political Advertising: The Clash Between the First Amendment and Defamation Law*, 16 CARDOZO ARTS & ENT. L.J. 667, 686-88 (1998).

¹⁶⁶ 47 U.S.C. § 315(a) (1994).

¹⁶⁷ 47 U.S.C. § 315(a)(1) (1994).

¹⁶⁸ Nader & Riley, *supra* note 165, at 31.

¹⁶⁹ See Robinson, *supra* note 163, at 926.

Broadcasters' second duty to candidates is not a contingent but rather an affirmative one. Section 312(a)(7) of the Communications Act, added in 1972, gives federal candidates an affirmative right of "reasonable access" to broadcast time for them to use on behalf of their candidacies.¹⁷⁰ The statute does not define the phrase "reasonable access," although the FCC policy guidelines indicate that "it is unreasonable . . . for a licensee to adopt a rigid policy of refusing to sell or give prime-time programming to legally qualified candidates for Federal elective office."¹⁷¹ The Supreme Court upheld this statute and the FCC's interpretation of it in *CBS, Inc. v. FCC*.¹⁷² In *CBS*, the Court stressed the importance of ensuring a vigorous debate on issues of public concern.¹⁷³ A subsequent decision by the Court of Appeals for the District of Columbia held that the FCC's *Declaratory Ruling*, allowing broadcasters to refuse air time for non-decent political advertisements deemed to be harmful to children, violated the "reasonable access" provision.¹⁷⁴

A third statutory provision, the "lowest unit charge" rule, requires broadcasters who sell time to candidates during specified periods preceding primary and general elections to charge them the "lowest unit charge of the station for the same class and amount of time for the same period."¹⁷⁵ This rule "is intended to make available to the candidate who buys only one or a few spots the same rate paid by the broadcaster's best commercial customer, who buys in bulk."¹⁷⁶

The last major rule applying to broadcasting of political advertisements is the "no censorship" rule.¹⁷⁷ Section 315(a) forbids a broadcaster from censoring the contents of any candidate's political advertisement.¹⁷⁸ Indeed, it "affords the candidate absolute freedom to broadcast any accusations he wants on national television

¹⁷⁰ 47 U.S.C. § 312(a)(7) (1994).

¹⁷¹ Melcher, *supra* note 165, at 844 (quoting Licensee Responsibility under Amendments to the Communications Act made by the Federal Election Campaign Act of 1971, Public Notice, 47 F.C.C.2d 516-17 (1974)).

¹⁷² 453 U.S. 367(1981).

¹⁷³ *See id.* at 396.

¹⁷⁴ *See Becker v. FCC*, 95 F.3d 75, 84-85 (D.C. Cir. 1996); *see also* Melcher, *supra* note 165, at 846-47. The D.C. Circuit also held that the *Declaratory Ruling* violated the "no censorship" and "equal opportunities" provisions of § 315(a). *See Becker*, 95 F.3d at 85.

¹⁷⁵ 47 U.S.C. § 315(b)(1) (1994).

¹⁷⁶ Hundt, *supra* note 165, at 1103 n.53.

¹⁷⁷ The "no censorship" rule provides that:

If any licensee shall permit any person who is a legally qualified candidate for any public office to use a broadcasting station, he shall afford equal opportunities to all other such candidates for that office . . . *Provided*, That such licensee shall have no power of censorship over the material broadcast under the provisions of this section.

47 U.S.C. § 315(a) (1994) (emphasis added).

¹⁷⁸ *See id.*

without any type of restriction whatsoever.”¹⁷⁹ In *Farmers Educational & Cooperative Union of America v. WDAY, Inc.*,¹⁸⁰ the Supreme Court held that Section 315 forbids licensees from editing candidates’ broadcasts.¹⁸¹ Accordingly, the FCC has refused to censor misleading and deceptive ads, and affirmed that libelous remarks must likewise be broadcast.¹⁸²

In contrast to federally licensed broadcasters, the Court has treated print media as exempt from access mandates.¹⁸³ The rationale is that newspapers forced to bear the cost of a “right to reply” statute may decline to criticize candidates, resulting in less vigorous debate.¹⁸⁴ In addition, the Court distinguished a newspaper editorial board’s exercise of control and judgment over what it prints from the more “passive” receptacle for news, commentary, and advertising that broadcasters provide.¹⁸⁵

C. *First Amendment in the Trademark Law Context*

The First Amendment will not be implicated, or capable of being used as a shield, in cases where the mark is used for the purpose of source identification.¹⁸⁶ Thus, in cases where the use is likely to cause consumer confusion as to the source, the First Amendment will not shield the use.¹⁸⁷ The purpose of trademark law is to protect consumers from deception in the marketplace; if consumers are likely to be confused in the marketplace of ideas in connection with the commercial use of a mark, trademark law should prevail over the First Amendment.

However, “the First Amendment confers a measure of protection for the unauthorized use of trademarks when that use is part of the expression of a

¹⁷⁹ Richman, *supra* note 165, at 686-87.

¹⁸⁰ 360 U.S. 525 (1959).

¹⁸¹ *See id.* at 530.

¹⁸² *See* Richman, *supra* note 165, at 687-88 (discussing FCC decisions issued pursuant to the “no censorship” rule).

¹⁸³ *See* *Miami Herald Publ’g Co. v. Tornillo*, 418 U.S. 241, 257-58 (1974) (striking down a Florida “right to reply” statute that guaranteed a candidate equal space to respond to newspaper content that attacked his character).

¹⁸⁴ *See id.* at 257.

¹⁸⁵ *See id.* at 258; *see also* FARBER, *supra* note 70, at 218.

¹⁸⁶ *See* *Yankee Publ’g Inc. v. News Am. Publ’g, Inc.*, 809 F. Supp. 267, 276 (S.D.N.Y. 1992) (holding that magazine’s right of free speech in parody outweighed any injury that may have occurred to trademark owner) (citing *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989)); *MGM-Pathe Communications Co. v. Pink Panther Patrol*, 774 F. Supp. 869, 877 (S.D.N.Y. 1991) (holding that the First Amendment will not shield an infringer if the use is likely to cause consumer confusion because “[t]he seriousness and virtue of a cause do not confer any right to use the trademark of another”). *MGM-Pathe* turned on the likelihood of consumer confusion. *See* *MGM-Pathe*, 774 F. Supp. at 877.

¹⁸⁷ *See* *Yankee Publ’g*, 809 F. Supp. at 275.

communicative message.”¹⁸⁸ Thus, the First Amendment may shield the use when a trademark is used not to indicate source but rather as part of a communicative message. In cases where the use is in connection with a work of comedy, parody, allusion, criticism, news reporting, and commentary, the Second Circuit has engaged in a balancing of interests analysis.¹⁸⁹

In the case of political speech, First Amendment protection is less clear. This is because courts have either characterized the speech as noncommercial¹⁹⁰ or halted the analysis after finding a likelihood of confusion.¹⁹¹ Yet, what should courts do when political candidates assert a First Amendment defense to their use of commercial slogans in their campaigns? John Shakow, the author of the Note that this Note rebuts, has concluded, “Trademark protection is a harm that should trump First Amendment protection, even in the context of highly protected political speech.”¹⁹²

III. JOHN SHAKOW’S VIEW

After balancing the interests of trademark owners against those of politicians, Shakow argued that the First Amendment should not shield politicians’ use of commercial slogans for three reasons: (1) the First Amendment does not protect all political speech; (2) the theft of or trespass onto the mark constitutes a harm that should trump First Amendment protection even of political speakers; and (3) a strong public interest in protecting trademarks exists.¹⁹³ This Note disagrees with Shakow’s conclusions and explains why trademark rights should not be so extended.

¹⁸⁸ *Id.*

¹⁸⁹ *See id.* at 276 (citing *Rogers*, 875 F.2d at 998).

¹⁹⁰ *See, e.g.*, *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 32 (1st Cir. 1987) (“It offends the Constitution . . . to invoke the anti-dilution statute as a basis for enjoining the noncommercial use of a trademark by a defendant engaged in a protected form of expression . . .”); *Tax Cap Comm. v. Save Our Everglades, Inc.*, 933 F. Supp. 1077, 1080-81 (S.D. Fla. 1996) (declining to apply the Lanham Act to nonprofit organization engaged in a petition drive to place constitutional amendments on a state ballot); *Lucasfilm v. High Frontier*, 622 F. Supp. 931, 934-35. (D.D.C. 1985) (declining to apply the Lanham Act to group’s use of the phrase “star wars” in television advertisement to persuade public of views on Reagan Administration’s Strategic Defense Initiative). However, categorizing speech as noncommercial is not really an option for courts anymore, as they have come to broadly define “service” for purposes of the Lanham Act, so as to subject all sorts of speech to it. *See supra* notes 61-65 and accompanying text.

¹⁹¹ *See United We Stand Am., Inc. v. United We Stand Am. New York, Inc.*, 128 F.3d 86, 93 (2d Cir. 1997) (making no analysis of dilution claim after finding that the First Amendment does not protect group’s use of mark as source identifier likely to cause confusion), *cert. denied*, 118 S. Ct. 1521 (1998).

¹⁹² Shakow, *supra* note 18, at 219-20.

¹⁹³ *See id.* at 214-21.

First, Shakow argued that although political speech is highly protected, it is not invulnerable to government regulation and should not be immune to claims by trademark holders.¹⁹⁴ He began by outlining the four speech-type categories: (1) obscenity, indecency, and speech least deserving of protection; (2) commercial speech; (3) artistic or creative speech; and (4) political speech.¹⁹⁵ He next explained that political speech represents “the core of the First Amendment”¹⁹⁶ and that, accordingly, “the Court requires a compelling state interest to uphold government regulation of [it].”¹⁹⁷ Nevertheless, Shakow pointed out that political speech is not invulnerable to government regulation. Obscene political speech, libelous and slanderous political speech, and subversive or inciting political speech are examples of types of political speech that are subject to government regulation.¹⁹⁸ Indeed, he explained, because “[a]lmost all speech could be considered political, . . . protecting political speech absolutely could open the door to an outright ban on all laws that somehow limit any kind of speech, dangerously disabling both government and society.”¹⁹⁹ Using O. Lee Reed’s “harms” analysis to determine whether certain speech is worthy of protection, an analysis that disregarded the category of speech and focused on whether the speech was likely to produce a substantial public or private harm, in which case the harm would “trump” the First Amendment’s free speech protection, Shakow concluded that trademark owners’ rights should “trump” the rights of politicians to incorporate commercial slogans in their campaigns.²⁰⁰ This is because trademarks are “extremely valuable property . . . the theft of or trespass onto [which] constitutes a substantial harm” to the owner and to the public, which benefits from being able to “distinguish between producers, identify those products and services with which they have had positive relationships in the past, and maintain associations with products whose trademarks reflect those positive relationships.”²⁰¹ On the other hand, the public’s interest in protecting politicians who transform commercial trademarks into slogans, according to Shakow, is minimal. First, trademark infringement is a “bright line rule” that would prohibit only the manner of

¹⁹⁴ See *id.* at 214-18.

¹⁹⁵ See *id.* at 212-14 (citing O. Lee Reed, *Is Commercial Speech Really Less Valuable than Political Speech? On Replacing Values and Categories in First Amendment Jurisprudence*, 34 AM. BUS. L.J. 1, 12-14 (1996)).

¹⁹⁶ *Id.* at 214 (quoting *Shapero v. Kentucky Bar Ass’n*, 486 U.S. 466, 483 (1988) (O’Connor, J., dissenting)).

¹⁹⁷ *Id.* at 214 (quoting Reed, *supra* note 195, at 12-13); see also *New York Times Co. v. Sullivan*, 376 U.S. 254, 269-72 (1964) (discussing the importance of broadly protecting free speech).

¹⁹⁸ See *id.* at 216.

¹⁹⁹ *Id.* at 215 (citing MELVILLE B. NIMMER, *NIMMER ON FREEDOM OF SPEECH: A TREATISE ON THE THEORY OF THE FIRST AMENDMENT* § 3.01 (1984) (“[I]n a very real sense all speech relates to governmental ‘policy,’ and is therefore political.”)).

²⁰⁰ See *id.* at 216-17.

²⁰¹ *Id.* at 220.

expression, not the content of a politician's speech.²⁰² Second, the value of slogans is minimal as they are "not political discourse, they are political nicknames."²⁰³ Third, trademark protection "would impose only an incidental and indirect restriction on political speech."²⁰⁴ Finally, the remedy, "injunction, rarely fines, and never incarceration . . . is not too stringent a penalty on politicians who disrespect the creative property of others."²⁰⁵

IV. SHAKOW REBUTTED: THE FIRST AMENDMENT SHOULD CONTINUE TO PROTECT POLITICAL SPEECH

Almost any type of speech *could* be considered political; certainly, there must be a method to limit the types of speech that merit the highest level of First Amendment protection. However, politicians who use commercial slogans in their campaigns deserve a high level of protection because they are using them *in their campaigns for public office* either in express advocacy of their own election²⁰⁶ or in commentary on an issue of importance to the voters who ultimately will elect the politician of their choice.²⁰⁷ This type of speech unambiguously falls within the category of "pure political speech" that deserves the highest level of protection against government regulation absent a compelling state interest. In *Buckley v. Valeo*,²⁰⁸ the landmark case that defines the limits of Congress' ability to regulate political campaigns,²⁰⁹ the Supreme Court stated, "Discussion of public issues and debate on the qualifications of candidates are integral to the operation of the system of government established by our Constitution."²¹⁰ Such debate should be "uninhibited, robust, and wide-open."²¹¹ Moreover, "it can hardly be doubted that the constitutional guarantee has its fullest and most urgent application precisely to the conduct of campaigns for political office."²¹² One scholar explained that the First Amendment's minimum coverage is

²⁰² See *id.*

²⁰³ *Id.* at 221.

²⁰⁴ *Id.*

²⁰⁵ *Id.*

²⁰⁶ See Keller, *supra* note 8, at *1 (reporting a candidate's use of the slogan, "When You Care Enough to Send the Very Best to Congress" as express advocacy of the candidate).

²⁰⁷ See *Fanfare*, *supra* note 11 (reporting Bob Dole's use of the slogan, "Just [Don't] Do It" as commentary on the pitfalls of teen drug use, an issue of importance to voters).

²⁰⁸ 424 U.S. 1 (1976) (per curiam) (sustaining the constitutionality of political contribution limits and reporting and disclosure requirements but voiding limitations on expenditures).

²⁰⁹ See *supra* notes 138-53 and accompanying text.

²¹⁰ *Buckley*, 424 U.S. at 14.

²¹¹ *Id.* (citing *New York Times Co. v. Sullivan*, 376 U.S. 254, 270 (1964)).

²¹² *Id.* at 15 (citing *Monitor Patriot Co. v. Roy*, 401 U.S. 265, 272 (1971)).

for “the process of forming and expressing the will of the majority according to which our representatives must govern.”²¹³

Contrary to Shakow’s assertion, the Supreme Court did not weaken protection for candidate speech when it decided what has become known as the “Gay Olympics” case.²¹⁴ That case involved a special statute passed by Congress that granted the United States Olympic Committee (USOC) the right to enjoin certain commercial and promotional uses of the word “Olympic” and certain Olympic symbols.²¹⁵ The USOC challenged San Francisco Arts & Athletic’s (SFAA’s) use of the phrase “Gay Olympic Games” on its “T-shirts, buttons, bumper stickers, and other items” for sale to the public and for promotion of its athletic event.²¹⁶ SFAA claimed, *inter alia*, that the use “was intended to convey a political statement about the status of homosexuals in society,” and thus, the special statute barring its use suppressed SFAA’s political speech.²¹⁷ The Court decided in USOC’s favor, explaining, “The mere fact that the SFAA claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to “appropriat[e] to itself the harvest of those who have sown.”²¹⁸ Although the Court was willing to permit the incidental restriction of a political message when expressed pursuant to commercial speech, the rule does not extend to candidate speech, which is primarily political. SFAA’s use of the word “Olympic” was primarily commercial—to promote an athletic event and sell goods to the public, both specifically covered by the Act²¹⁹—and only incidentally political, thus less deserving of First Amendment protection.²²⁰ The Court stated that “[s]ection 110 primarily applies to all uses of the word ‘Olympic’ to induce the sale of goods or services Under [section] 110, the USOC may prohibit purely promotional uses of the word only when the promotion relates to an athletic or

²¹³ Lillian R. BeVier, *The First Amendment and Political Speech: An Inquiry Into the Substance and Limits of Principle*, 30 STAN. L. REV. 299, 309 (1978).

²¹⁴ See *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987) (upholding ability of United States Olympic Committee (USOC) to enjoin San Francisco Arts & Athletics’ (SFAA’s) use of the name “Gay Olympics” under a federal statute that entitles the USOC to bar use of “Olympic” even without demonstration of likelihood of confusion). Shakow asserted, “The decision in *Gay Olympics* is clearly indicative of the Supreme Court’s willingness to protect the rights of trademark holders against infringement . . . even when the infringer is attempting to convey a political message.” Shakow, *supra* note 18, at 219.

²¹⁵ See *Gay Olympics*, 483 U.S. at 526; see also 36 U.S.C. § 380 (1994).

²¹⁶ *Gay Olympics*, 483 U.S. at 539.

²¹⁷ *Id.* at 535.

²¹⁸ *Id.* at 541 (quoting *International News Serv. v. Associated Press*, 248 U.S. 215, 239-40 (1918)).

²¹⁹ See 36 U.S.C. § 380 (1994).

²²⁰ “[T]he application of the Act to this commercial speech is not broader than necessary to protect the legitimate congressional interest and therefore does not violate the First Amendment.” *Gay Olympics*, 483 U.S. at 540 (emphasis added).

theatrical event.”²²¹ A politician’s speech during the course of his campaign, on the other hand, is primarily political. For this reason, the case cannot be said to have extended the rights of trademark owners into the context of speech by candidates for public office.

Congress has affirmed, through its regulation of broadcasters, the principle that campaign speech by politicians deserves significant First Amendment protection.²²² The “equal opportunities,” “no censorship,” and “reasonable access” regulations,²²³ are prime examples of this. Most noteworthy is the “no censorship” rule; under it, candidates are given the right, under the equal time provisions, to say anything they want—even to make deliberately defamatory statements—about another candidate and the broadcaster cannot censor it.²²⁴ The broadcaster will be shielded from liability, and although the candidate may be sued for defamation (subject to meeting the “actual malice” standard elucidated in *New York Times v. Sullivan* which would undoubtedly apply), the message is nevertheless disseminated. This rule places a high value on candidate speech, permitting the delivery of what could be considered a defamatory statement rather than letting broadcasters chill free speech or inhibit the free debate on public issues.

The Court has limited permissible restrictions on candidate speech to those that are justified by a compelling government interest and narrowly tailored to further that interest. In *Buckley*, for example, the Court upheld limits on political contributions as justified by the government’s compelling interest in limiting actual or perceived corruption in the political process.²²⁵ Because corruption in the political process does not further the goal of self-government, it makes sense for the Court to approve the government’s attempt to monitor and prevent corruption. Restrictions on candidate speech that is defamatory and said with “actual malice” are likewise constitutional under the *New York Times v. Sullivan* doctrine.²²⁶ In *Sullivan*, the Court held that proof of “actual malice” was required for claims against public officials (and later public figures) to prevent public criticism of their conduct from being chilled.²²⁷ The Courts have articulated no such compelling interest for prohibiting the use of trademarks that dilute the distinctiveness of the owner’s mark.

The legislative history of the Lanham Act suggests that use of slogans by

²²¹ *Id.* at 539, 540.

²²² *See supra* notes 164-84 and accompanying text.

²²³ *See id.*

²²⁴ *See supra* notes 178-84 and accompanying text.

²²⁵ *See Buckley v. Valeo*, 424 U.S. 1, 26 (1976) (per curiam); *supra* notes 139-52 and accompanying text.

²²⁶ *See supra* note 98 and accompanying text.

²²⁷ *See New York Times Co. v. Sullivan*, 376 U.S. 254, 279 (1964) (“A rule compelling the critic of official conduct to guarantee the truth of all his factual assertions . . . leads to comparable ‘self-censorship.’ . . . The rule thus dampens the vigor and limits the variety of public debate. It is inconsistent with the First and Fourteenth Amendments.”).

politicians in their campaigns for public office does not fall within the purview of the Act. Representative Robert Kastenmeier (D-Wisconsin) clarified in the Congressional Record that although the 1988 amendments to section 43(a) expanded the realm of actionable deceptive advertisements,²²⁸ political advertising and promotion is political speech not encompassed by the term “commercial.” He wrote:

[Section] 1883 . . . uses the word “commercial” to describe advertising or promotion for business purposes, whether conducted by for-profit or non-profit organizations or individuals. Political advertising and promotion is political speech, and therefore not encompassed by the term “commercial.” This is true whether what is being promoted is an individual candidacy for public office, or a particular political issue or point of view. . . . However, if a political or other similar organization engaged in business conduct incidental to its political functions, then the business conduct would be considered “commercial” and would fall within the confines of this section. . . . The section is narrowly drafted to encompass only clearly false and misleading commercial speech.²²⁹

Although Representative Kastenmeier’s remarks pertained to the false designation of origin and false description amendments passed by Congress in 1988, the 1996 anti-dilution provision included similarly limiting language. It prohibits the application of the statute to “noncommercial use.”²³⁰ It is only logical to assume that the word “commercial” has the same meaning under the same statute, and that the definition of “commercial” should be uniformly applied and interpreted by courts absent specific evidence of Congress’ intent to the contrary.

The final question to be answered is whether slogans can fairly be categorized as speech that contributes to the process of forming and expressing the will of the majority; that is, whether political sloganeering is speech “relevant to the purposes of self-government.”²³¹ Politicians’ use of slogans at least does not hinder the ability to self-govern, and at best it increases this ability. Bob Dole’s use of the “Just [Don’t] Do It” slogan was made in commentary on teen drug use; it helped convey to voters his position on this important issue—that he would use the “bully pulpit” of the presidency to dissuade teens from using drugs.²³² In the case of the slogan

²²⁸ See GINSBURG, *supra* note 1, at 633-35 (discussing false designation of origin and false description under the Lanham Act).

²²⁹ 134 CONG. REC. 31852 (1988) (remarks of Rep. Kastenmeier commenting on Lanham Act § 43(a)(2), 15 U.S.C. § 1125(a)(2) (1996)).

²³⁰ Lanham Act § 43(c), 15 U.S.C. § 1125(c)(4)(B) (1994 & Supp. II 1996).

²³¹ Edward J. Bloustein, *The First Amendment and Privacy: The Supreme Court Justice and the Philosopher*, 28 RUTGERS L. REV. 41, 51 (1974); see also BeVier, *supra* note 213, at 308.

²³² See *supra* note 11 and accompanying text.

“When you Care Enough to Send the Very Best to Congress,” it is relevant to purposes of self-government because it advocates a candidate’s own election.²³³ It implies, “I am a quality candidate. Elect me.” This substitute phrase, however, does not create the same image in the minds of voters as does the Hallmark slogan.

Candidate speech does not, and should not, fall within the confines of trademark dilution theory. Shakow’s application of “harms analysis” to trademark law works somewhat in a tarnishment claim, but not in a dilution claim. A tarnishment claim is arguable by the owner, such as when a “dirty” or scandal-ridden politician uses a commercial slogan and thereby degrades the positive image of the slogan in consumers’ minds. A dilution claim, however, has no such negative effect on the mark unless the mark is used generically. Denicola noted that “non-trademark uses [such as decorative use, use in parody or commentary] do not undermine distinctiveness for the simple reason that they do not associate the symbol with another. The reference is solely to the trademark owner.”²³⁴ When the mark is used as a trademark, however, there is a greater threat to the loss of the mark’s distinctiveness.²³⁵

Yet, the actual effect . . . may vary. Some uses are not likely to erode the connection between trademark and trademark owner. The presence of a famous mark on certain products may have little diluting effect, particularly where it is obvious that the defendant intends the public to associate the use with the true owner. . . .²³⁶

When politicians use trademarks, there is usually no pretense of having thought up the slogan on their own; they are trying to benefit from the positive associations the mark has already come to convey in the minds of consumer and voters.

The nature of the property right itself cuts against extending the dilution doctrine to candidate speech. First, a trademark is not an absolute property right. Unlike a copyright, which promotes literary and artistic creativity by protecting such works for a limited amount of time against others’ use or copying of their work,²³⁷ a trademark is not recognized by law as protectable *per se*. Rather, a “trademark is treated as merely a protection for the good-will, and not the subject of property except in connection with an existing business.”²³⁸ Extending the dilution doctrine to political speech would, in effect, extend to trademark owners an almost absolute property right in their marks.

²³³ See *supra* note 8 and accompanying text.

²³⁴ Denicola, *supra* note 20, at 188.

²³⁵ See *id.*

²³⁶ *Id.*

²³⁷ See Willaim M. Borchard, *A Trademark is Not a Copyright or a Patent* (excerpts), reprinted in GINSBURG, *supra* note 1, at 48.

²³⁸ *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 414 (1916).

Finally, if slogans become part of our culture, owners should expect them to be used and should not be able to claim an absolute property right in them except as a source identifier. In an article about the communicative interests that policymakers should take into account when extending the scope of trademark protection, Judge Alex Kozinski suggested that owners who “burn [words and images] into our collective consciousness . . . necessarily—and justly—must give up some measure of control.”²³⁹ Kozinski discussed Professor Dreyfuss’ article²⁴⁰ on the doctrine of “expressive genericity;” stating that:

trademarks, slogans, and logos are particularly apt to fill in gaps in our language because they often describe products and services that are totally new, . . . and are also likely to be adopted into the vernacular because, again, they’re selected for their pleasing, roll-off-the-tongue quality.²⁴¹

He went on to state, “What starts out as a trademark or slogan quickly spills over into a political campaign, a Saturday Night Live skit, a metaphor, a cultural phenomenon, an everyday expression—and occasionally a fixed part of the language.”²⁴² Judge Kozinski believes that the originator may not simply monopolize the English language. Rather, he must

understand that the mark or symbol or image is no longer entirely his own, and that in some sense it also belongs to all those other minds who have received and integrated it. This does not imply a total loss of control, however, only that the public’s right to make use of the word or image must be considered in the balance as we decide what rights the owner is entitled to assert.²⁴³

CONCLUSION

The First Amendment should protect politicians who use commercial slogans during the course of their campaigns against trademark dilution claims. Candidate speech merits the highest First Amendment protection because it is critical to the process of self-government. Both the Supreme Court in *Buckley* and the Congress in its broadcast media regulations have affirmed the principle that campaign speech merits the highest protection. The legislative history of the Lanham Act suggests that it was not meant to extend to candidate speech, but rather that protection for marks

²³⁹ Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 975 (1993).

²⁴⁰ See Dreyfuss, *supra* note 3.

²⁴¹ Kozinski, *supra* note 243, at 974 (discussing Dreyfuss, *supra* note 3).

²⁴² *Id.*

²⁴³ *Id.* at 975.

was limited to “commercial use.” Politicians’ use poses little risk of dilution, since the worst that could happen is that consumers would be reminded of the original product. Because trademark owners should realize that slogans will come to be used in everyday language—that, indeed, is their goal—they should not be able to impose a monopoly on their use. As Judge Kozinski noted, owners who spend time and money burning slogans into our collective consciousness give up some measure of control over their subsequent use. Trademark rights are not absolute property rights, and the First Amendment should, at the very least, protect their use during the course of campaigns.

RAENA L. SMITH