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Mark Batholomew

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TRADEMARK MORALITY

MARK BARTHOLOMEW*

ABSTRACT

This Article challenges the modern rationale for trademark rights. According to both judges and legal scholars, what matters in adjudicating trademark cases are the economic consequences, particularly for consumers, of a defendant's use of a mark, not the use's morality. Nevertheless, under this utilitarian facade, judicial assessments of highly charged questions of right and wrong are also at work. Recent findings in the field of moral psychology demonstrate the influence of particular moral triggers in all areas of human decision making, often without conscious awareness. These triggers influence judges deciding trademark disputes. A desire to punish bad actors, particularly those deemed to insufficiently invest of themselves in the marketplace, results in an overbroad consideration of the defendant's intent. Judicial conceptions of sexual propriety guide trademark dilution law. Loyalty to certain views and markers of nationhood explain judge-made rules that privilege particular meanings for national symbols over consumer welfare. These three examples show that moral intuition can produce very bad trademark doctrine. The Article concludes that moral concerns will inevitably influence

* Professor of Law, SUNY Buffalo Law School. I would like to thank Alena Allen, Shyam Balganesh, Ann Bartow, Barton Beebe, Irene Calboli, Michael Carroll, Stacey Dogan, Dave Fagundes, Christine Haight Farley, Brett Frischmann, William Gallagher, Leah Chan Grinvald, Rob Heverly, Justin Hughes, Sonia Katyal, Greg Lastowka, Peter Lee, David Levine, Glynn Lunney, Irina Manta, Jessica Mantel, Bill McGeveran, Mark McKenna, Lisa Ramsey, Jeremy Sheff, Jessica Silbey, John Tehranian, Rebecca Tushnet, Mary Wong, and Peter Yu for their insightful comments and feedback. This Article benefited substantially from presentations at the 2012 Law & Society Annual Meeting, the New York University School of Law, the Sandra Day O'Connor College of Law at Arizona State University, the Washington College of Law at American University, the 2013 International Trademark Association Annual Meeting, the Erie County Bar Association Federal Practice Committee, and SUNY Buffalo Law School. Frances Stephenson and Jay Organek provided helpful research assistance.

judges, but they will do less harm if, instead of being hidden behind economic rhetoric, they are brought to the surface and interrogated just like any other technique of legal argument.

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"The law is full of phraseology drawn from morals, and by the mere force of language continually invites us to pass from one domain to the other without perceiving it, as we are sure to do unless we have the boundary constantly before our minds."[1]

INTRODUCTION

Looking at modern trademark jurisprudence, it appears that, at least in one area of the law, Holmes's cautionary statement has been taken to heart. The legal community today typically frames trademark law through the lens of efficiency. Judging from published decisions and law review articles, trademark law's prime directive is to remove obstacles from the consumer experience.[2] As noted by one trademark scholar, "Current thinking about trademark law is dominated by economic analysis, which views the law as a system of rules designed to promote informational efficiencies."[3] According to this line of thinking, by preserving the signaling power of particular words and symbols, trademark protection reduces consumer search costs and prevents wasteful confusion. This protection must yield only when consumers derive an even greater informational benefit from a defendant's use of another's trademark.[4]

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1. Oliver Wendell Holmes, *The Path of the Law*, 10 HARV. L. REV. 457, 459-60 (1897).

2. *See, e.g.*, Beltronics USA, Inc. v. Midwest Inventory Distribution, LLC, 562 F.3d 1067, 1072 & n.3 (10th Cir. 2009); Scandia Down Corp. v. Euroquilt, Inc., 772 F.2d 1423, 1429 (7th Cir. 1985); Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 549 (2006); Chad J. Doellinger, *A New Theory of Trademarks*, 111 PENN. ST. L. REV. 823, 834 (2007).

3. Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 621 (2004); *see also* Linda R. Cohen & Roger G. Noll, *Intellectual Property, Antitrust and the New Economy*, 62 U. PITT. L. REV. 453, 461 (2001) ("[T]he conceptual model underlying American intellectual property law is utilitarian: rights are granted for social objectives (advancing knowledge and producing useful products)."); Brett Frischmann & Mark P. McKenna, *Intergenerational Progress*, 2011 WIS. L. REV. 123, 129-30 ("[I]t is fair to say that the utilitarian view of IP dominates and that alternative theories have had relatively little effect on policy in recent years."); Mark P. McKenna, *A Consumer Decision-Making Theory of Trademark Law*, 98 VA. L. REV. 67, 75 (2012) ("[I]t would be nearly impossible to overstate the extent to which the search costs theory now dominates as *the* theoretical justification of trademark law.").

4. *See* WILLIAM M. LANDES & RICHARD A. POSNER, THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW 189 (2003). For example, non-mark holders may use a mark not as a source identifier but to describe their product or to engage in comparative advertising.

The focus on efficiency suggests a cold, dispassionate, and rational approach to questions of trademark protection, one that disclaims ethical considerations. What matters are the consequences, particularly for consumers, of a particular use of a mark, not the use's morality. As one court recently explained: "[T]rademark law [is] not [a] matter[ ] of strong moral principle. Intellectual property regimes are economic legislation based on policy decisions that assign rights based on assessments of what legal rules will produce the greatest economic good for society as a whole."[5] Given this predominant thinking, judges are criticized when they stray from the focus on economic consequences and appear to apply their own moral intuitions to a trademark dispute.[6]

Nevertheless, under the surface, a very different rationale than the economic justification described above guides many trademark decisions. Consider the following:

- Embedded within trademark doctrine are evaluations of the "good faith" of the defendant, particularly in the multiple factor tests for determining likelihood of confusion and likelihood of dilution.[7]
- Empirical study suggests that evidence regarding intent, rather than being an afterthought or only a small portion of the analysis, is of "decisive importance" and a finding a bad intent "creates ... a nearly un-rebuttable presumption" in favor of the plaintiff.[8]
- Courts take particular care to police unauthorized use of marks in sexual contexts, even going so far as to create a full-fledged

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See, e.g., Smith v. Chanel, Inc., 402 F.2d 562, 567-68 (9th Cir. 1968).

5. Sarl Louis Feraud Int'l v. Viewfinder Inc., 406 F. Supp. 2d 274, 281 (S.D.N.Y. 2005), *vacated*, 489 F.3d 474 (2d Cir. 2007).

6. *See* Ritchie v. Simpson, 170 F.3d 1092, 1102 (Fed. Cir. 1999) (Newman, J., dissenting) ("Neither [plaintiff] nor this court has legal right, moral authority, social responsibility, or judgmental power, to intrude into commercial trademark rights based on moral disapproval of the trademark owner."); Bone, *supra* note 2, at 553 (describing critics who blame recent expansions in trademark protection on judges "applying their own moral intuitions").

7. *E.g.*, Kos Pharm., Inc. v. Andrx Corp., 369 F.3d 700, 708 (3d Cir. 2004) (listing "the intent of the defendant in adopting the mark" as one of ten factors to be analyzed in determining likelihood of confusion); EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopulos Inc., 228 F.3d 56, 66-68 (2d Cir. 2000) (discussing role of defendant's good faith in fair use defense).

8. Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1622, 1628 (2006); *see infra* Part II.B.

presumption of trademark dilution when a defendant uses a mark to sell sex-related products.[9]

- Even if United States consumers are aware of a foreign mark and unaware of a domestic business using the same mark, courts will award priority rights in the mark to the domestic business.[10]
- A finding that a trademark contains "immoral ... or scandalous matter," may bring "national symbols ... into contempt, or disrepute," or consists of "the flag or coat of arms or other insignia of the United States" renders the mark ineligible for federal registration.[11]

In short, despite the dispassionate, economically-focused language typical of modern trademark jurisprudence, judicial assessments of highly charged questions of right and wrong are also at work.[12]

Uncovering the specific moral intuitions behind trademark jurisprudence is not easy. Judges make efforts to keep the emotional architecture of trademark law hidden as it is considered inappropriate for a judge to allow her moral sentiments to determine legal winners and losers. Trademark's decision makers take pains to explain that moral considerations are irrelevant when assessing the validity of a proposed mark or the likelihood of consumer confusion.[13] Even in the rare circumstance in which they hint at application of a moral standard, judges take care to frame such standards in an ambiguous and generalized manner that provides little traction for a reader trying to map the contours of a judge's ethical reasoning.[14]

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9. *E.g.*, V Secret Catalogue, Inc. v. Moseley, 605 F.3d 382, 389 (6th Cir. 2010); *see infra* Part III.B.

10. *See infra* Part IV.A.

11. Lanham Act, 15 U.S.C. § 1052(a)-(b) (2006); *see infra* Part IV.B.

12. One might also note that courts have deemed trademark counterfeiting a crime of moral turpitude meriting deportation. *See, e.g.*, Magasouba v. Mukasey, 543 F.3d 13, 14-15 (1st Cir. 2008); Tall v. Mukasey, 517 F.3d 1115, 1119-20 (9th Cir. 2008).

13. *See, e.g.*, Selfway, Inc. v. Travelers Petroleum, Inc., 579 F.2d 75, 79 (C.C.P.A. 1978) ("The law pertaining to registration of trademarks does not regulate all aspects of business morality.").

14. For example, courts have defined unfair competition regarding trademarks as performing acts contrary to "good conscience," Pennwalt Corp. v. Becton, Dickinson & Co., 434 F. Supp. 758, 765 (D.N.J. 1977), selling goods "by means that shock the judicial senses," Leon Finker, Inc. v. Schlussel, 469 F. Supp. 674, 680 (S.D.N.Y.), *aff'd*, 614 F.2d 1288 (2d Cir. 1979),

Notwithstanding this lack of transparency, it is possible to identify the moral reasoning employed by judges in trademark disputes, for a couple of reasons. First, the boundary between law and morality in trademark is not watertight. Recent research in the field of moral psychology identifies a particular cognitive structure at play when people render moral judgment.[15] Psychologists have also pinpointed five foundations of moral concern, subject areas that are likely to trigger intuitive moral judgment in place of reasoned deliberation.[16] Despite judicial protestations to the contrary, analyses of legal decision making suggest that moral heuristics often guide doctrinal decisions.[17]

Second, there is a continuity to the moral concerns surrounding trademark law that makes their presence and significance easier to identify. This Article concentrates on trademark jurisprudence at

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engaging in "activity which ... so ... violates standards of commercial morality that it cannot be tolerated," Wilson v. Electro Marine Sys., Inc., 915 F.2d 1110, 1118 (7th Cir. 1990) (quoting People *ex rel.* Mosk v. Nat'l Research Co. of Cal., 20 Cal. Rptr. 516 (Dist. Ct. App. 1962)) (internal quotation marks omitted), and "a level of rascality that would raise an eyebrow," Levings v. Forbes & Wallace, Inc., 396 N.E.2d 149, 153 (Mass. App. Ct. 1979).

15. *See infra* notes 50-58 and accompanying text.

16. *See infra* note 54 and accompanying text.

17. *See* Cass R. Sunstein, *Moral Heuristics and Moral Framing*, 88 MINN. L. REV. 1556, 1558 (2004). There has been little discussion of the moral concerns underpinning modern trademark law, but scholars have been devoting increasing attention to the moral analysis behind property rights. *See, e.g.*, James Grimmelmann, *The Ethical Visions of Copyright Law*, 77 FORDHAM L. REV. 2005, 2006 (2009); Thomas W. Merrill & Henry E. Smith, *The Morality of Property*, 48 WM. & MARY L. REV. 1849, 1850 (2007); Carol M. Rose, *The Moral Subject of Property*, 48 WM. & MARY L. REV. 1897, 1902-03 (2007); *see also* Vincent Chiappetta, *Living with Patents: Insights from Patent Misuse*, 15 MARQ. INTELL. PROP. L. REV. 1, 47 n.206 (2011) (discussing nonefficiency concerns animating patent law). A recent article by Jeremy Sheff applies the Kantian "contractarian" tradition in philosophy to trademark law. Jeremy N. Sheff, *Marks, Morals, and Markets*, 65 STAN. L. REV. 761, 763 & n.2 (2013). Sheff's article is prescriptive, suggesting a new philosophical framework to replace the utilitarian search costs model that currently dominates trademark law. *Id.* at 761, 763. Sheff's model is quite valuable in that it offers a different normative frame for those interested in trademark theory and concerned about the shortcomings of the status quo's reliance on law and economics. This Article is different, however, in that it provides a descriptive account of the current state of judicial decision making in trademark law, rather than an aspirational theory. I am also somewhat skeptical of the ability of judges and juries to apply Sheff's Kantian model when adjudicating trademark disputes. *See infra* Part I.C.2; *see also* Jonathan Haidt & Craig Joseph, *The Moral Mind: How Five Sets of Innate Intuitions Guide the Development of Many Culture-Specific Virtues, and Perhaps Even Modules*, *in* 3 THE INNATE MIND: FOUNDATIONS AND THE FUTURE 367, 369-71 (Peter Carruthers et al. eds., 2007) (maintaining that Kantian theory does not resemble the emotional way human beings actually render moral judgments).

two particular time periods: the beginning of the twentieth and twenty-first centuries. The beginning of the twentieth century represented a watershed moment in American trademark law, which morphed from a primitive, rarely consulted area of the law into a major economic guidepost for a new mass commercial society.[18] Courts in this formative period were less squeamish than their successors about using moral principles in decision making.[19] This was a time when technological and demographic change disrupted antebellum commercial ethics.[20] The general public was aware of and concerned with the moral implications of business behavior.[21] Into this uncertain environment, business leaders, religious authorities, and lawmakers announced new commercial values.[22] By showing that the same ethical approaches that shaped trademark law at its beginnings also determine decisions a century later, I hope to prove that these approaches form an unbroken, yet largely unstated, bedrock of the law.

To that end, Part I of the Article examines the properties of moral judgment and how they might be applied to legal decision making. A raft of experimental research investigating moral intuition is just beginning to come into focus, and it offers new insights into how all humans, including judges, make decisions. Part II looks to one particular moral construct identified by this research, the belief in rewarding personal investment, and how it has shaped trademark doctrine. Part III examines how courts, perhaps quite unknowingly, use notions of sexual purity and propriety to pick winners and losers in trademark disputes. Part IV studies the nationalist sentiments that led to the creation of a territorial principle in trademark law as well as prohibitions on particular marks deemed damaging to national symbols. Early twentieth-century jurisprudence is the starting point for all of these arguments. The doctrines it spawned remain a part of American trademark law, even though they do

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18. *See* Mark Bartholomew, *Advertising and the Transformation of Trademark Law*, 38 N.M. L. REV. 1, 3 (2008).

19. *See infra* notes 68-72 and accompanying text.

20. *See infra* notes 126-38 and accompanying text.

21. SAUL ENGELBOURG, POWER AND MORALITY: AMERICAN BUSINESS ETHICS, 1840-1914, at 46-49 (1980); Edward J. Balleisen, *Private Cops on the Fraud Beat: The Limits of American Business Self-Regulation, 1895-1932*, 83 BUS. HIST. REV. 113, 115 (2009).

22. *See* ENGELBOURG, *supra* note 21, at 4-5; *infra* note 135 and accompanying text.

little to promote consumer welfare. The Article's final Part maintains that moral intuition negatively influences trademark law and this influence is, to some degree, inevitable. Nevertheless, the quality of trademark decisions will be improved if judges articulate their moral concerns instead of hiding them behind the language of economic efficiency.

I. THE ROLE OF MORAL JUDGMENT IN LEGAL DECISION MAKING

A few things need to be mentioned about moral judgment before turning to its particular use in trademark jurisprudence. As explained in this Part, today's judges disfavor explicit appeals to morality.[23] Nevertheless, moral sentiments likely play a significant role in trademark jurisprudence. Moral foundations theory—a new and influential model of human decision making based on psychological experiment—identifies five categories of innate, moral concern central to our judgment.[24] At times, these categories of concern may form a moral intuition that guides legal decision making without explicit mention or even conscious awareness. These intuitions influence judicial behavior yet do not track the consumer efficiency justification for modern trademark law. Parts II, III, and IV offer three examples of trademark doctrine shaped by these moral triggers.

A. What Is Morality?

In this Article, I am investigating a particular sort of legal decision making that relies on moral intuition. Before detailing the nature of trademark's moral argument, I need to explain what I mean by morality.[25] You would surely get different definitions of morality depending on whom you ask. One approach would be to ask

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23. *See infra* Part I.B.

24. *See* Haidt & Joseph, *supra* note 17, at 373-74.

25. I have tried to mostly use the term "moral" instead of the term "ethical." "Ethical" is Greek in origin and historically tended to refer to character and education. "Moral" comes from Latin and referred more to law and customary practices. In common parlance, "ethical" and "moral" conduct have come to describe the same thing, although one author suggests that the media uses "ethics" to describe business practices and "morality" to refer to controversial sexual behavior. DEIRDRE N. MCCLOSKEY, THE BOURGEOIS VIRTUES 63 (2006).

a philosopher. One can divide moral philosophers into two categories: consequentialists and deontologists.[26] The consequentialists evaluate an action's morality by studying its consequences.[27] A consequentialist philosopher like Jeremy Bentham might describe morality as a system of rules of behavior designed to lead to optimal social welfare.[28]

By contrast, deontologists ignore results, focusing instead on the act itself.[29] This school of thought is most closely associated with the philosopher Emanuel Kant.[30] Kant believed that humans should be guided in their actions by universally shared moral duties, not self-interest.[31] Actions that transgress these shared duties are wrong, regardless of their consequences.[32] Under the Kantian view of morality, "the right" is prior to "the good."[33] The focus is on acts and the mental state behind those acts, not on results.[34] Moreover, Kant maintained that moral conduct was not equivalent to emotional conduct.[35] To be "moral," an act must be performed in the right frame of mind.[36] For Kant, truly moral action is not instinctual but rather is performed out of a thoughtful consideration of duty.[37]

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26. BUSINESS ETHICS: READINGS AND CASES IN CORPORATE MORALITY 5 (W. Michael Hoffman & Jennifer Mills Moore eds., 1984); Eric R. Claeys, *Virtue and Rights in American Property Law*, 94 CORNELL L. REV. 889, 894-95 (2009). A potential third category is virtue ethics, which looks to the character of the moral actor rather than rights or consequences in interrogating behavior. *See* Rosalind Hursthouse, *Virtue Ethics*, STANFORD ENCYCLOPEDIA OF PHILOSOPHY (Mar. 8, 2012), http://plato.stanford.edu/entries/ethics-virtue/.

27. Claeys, *supra* note 26, at 895.

28. *See* Bernard Gert, *The Definition of Morality*, STANFORD ENCYCLOPEDIA OF PHILOSOPHY (Mar. 14, 2011), http://plato.stanford.edu/entries/morality-definition/.

29. Claeys, *supra* note 26, at 894-95.

30. *Id.* at 895.

31. Bailey Kuklin, *The Morality of Evolutionarily Self-Interested Rescues*, 40 ARIZ. ST. L.J. 453, 497-98 (2008).

32. *See id.*

33. Frank I. Michelman, *Reasonable Umbrage: Race and Constitutional Antidiscrimination Law in the United States and South Africa*, 117 HARV. L. REV. 1378, 1384 (2004); *see also* Dan M. Kahan & Martha C. Nussbaum, *Two Conceptions of Emotion in Criminal Law,* 96 COLUM. L. REV. 269, 299 & n.121 (1996) (contrasting the Kantian and Aristotelian view of morality).

34. *See* Kuklin, *supra* note 31, at 497-98.

35. *See* Gregory Trianosky, *Natural Affection and Responsibility for Character: A Critique of Kantian Views of the Virtues*, *in* IDENTITY, CHARACTER, AND MORALITY: ESSAYS IN MORAL PSYCHOLOGY 93, 94 (Owen Flanagan & Amélie Oksenberg Rorty eds., 1990).

36. *See id.*

37. *Id.*

Another common definition of morality relies on religion.[38] A religious leader might equate morality with the particular tenets of her religion, and people commonly describe religious teachings as the foundation of morality.[39] Yet this definition of morality seems overly narrow. Even atheists hold certain values dear, and studies reveal that both atheists and religious adherents arrive at the same judgments when presented with various moral dilemmas.[40]

The larger problem with both the philosophical and the religious definitions of moral conduct is that they represent the ideal rather than the actual. Though we might want to evaluate every situation with the perspicacity of a Kant or Bentham, this is impossible. Even if we possess adequate philosophical tools to evaluate something in the abstract, our decision-making powers differ in the context of the real world.[41] Kantian and utilitarian theories cannot fully explain the behavior of judges who often act emotionally and may, like the rest of us, lack the analytical tools to predict the full consequences of their decisions. Similarly, religious teachings of what it means to be a moral being are prescriptive, not descriptive. Anyone witness to the downfalls of various television evangelists knows that religion's moral tenets are not always observed, even by their chief proponents.[42]

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38. MARC D. HAUSER, MORAL MINDS 410 (2006); Jonathan Haidt & Selin Kesebir, *Morality*, *in* 2 HANDBOOK OF SOCIAL PSYCHOLOGY 797, 820 (Susan T. Fiske et al. eds., 2010).

39. John Hare, *Religion and Morality*, STANFORD ENCYCLOPEDIA OF PHILOSOPHY (Oct. 1, 2010), http://plato.stanford.edu/entries/religion-morality (explaining that "religion and morality have been closely intertwined" since "the beginning of Western thought").

40. John Mikhail, *Universal Moral Grammar: Theory, Evidence and the Future*, 11 TRENDS IN COGNITIVE SCI. 143, 144 (2007). For example, whether you ask a Christian, a Muslim, or a nonbeliever, they all tend to agree that certain things should not be subject to market-pricing mechanisms, even if such mechanisms could be proven to lead to greater aggregate welfare. *See* A. Peter McGraw et al., *From the Commercial to the Communal: Reframing Taboo Trade-offs in Religious and Pharmaceutical Marketing*, 39 J. CONSUMER RES. 157, 169 (2012).

41. *See* DANIEL KAHNEMAN, THINKING, FAST AND SLOW 23 (2011) (explaining that humans have a limited cognitive "budget" for making multiple decisions); Baba Shiv & Alexander Fedorikhin, *Heart and Mind in Conflict: The Interplay of Affect and Cognition in Consumer Decision Making*, 26 J. CONSUMER RES. 278, 281 (1999) (suggesting that humans rely on affective responses rather than cognitive decisions when "processing resources are constrained").

42. *See, e.g.*, Robert E. Rains, *Marriage in the Time of Internet Ministers: I Now Pronounce You Married, but Who Am I to Do So?*, 64 U. MIAMI L. REV. 809, 839-40 & n.284 (2010) (rejecting "the notion that there is some sort of assurance that ministers or other clergy are

Because this Article is focused on uncovering the process by which judges decide morally tinged disputes, I want to use a different definition of morality than the one employed by the philosophers and religious scholars. Instead, my definition comes from psychology. Rather than articulating what morality ought to be, moral psychology asks what our shared morality really is.[43] The moral psychologist examines what actually triggers our moral sensibilities and how we then go about making moral judgments.[44] In other words, the moral psychologist strives for a definition of morality that tracks real-world behavior.

Until recently, the psychologists studying moral judgment defined it fairly narrowly. One group identified morality strictly as care for others.[45] Another view limited the moral domain to questions of "unfair" treatment.[46] Under either approach, morality addressed only interpersonal relations. Psychologists combined both views into a single definition: "prescriptive judgments of justice, rights, and welfare pertaining to how people ought to relate to each other."[47] Other reported concerns, such as patriotism or sexual purity, that do not directly relate to interactions with others, were viewed as merely matters of social convention or personal choice, not morality.[48] Hence, under the psychologists' definition, only considerations

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necessarily persons of integrity and responsibility" and noting sex abuse cases within the Catholic Church).

43. Haidt & Kesebir, *supra* note 38, at 797.

44. Gert, *supra* note 28.

45. *See* CAROL GILLIGAN, IN A DIFFERENT VOICE: PSYCHOLOGICAL THEORY AND WOMEN'S DEVELOPMENT 19 (1982).

46. This view stems mostly from Lawrence Kohlberg's seminal work on moral reasoning. *See* Jesse Graham et al., *Ideology and Intuition in Moral Education* 2 EUROPEAN J. DEVELOPMENTAL SCI. 269, 273-74 (2008) (discussing Kohlberg's importance to the field of moral psychology and listing "fairness, equality, and justice" as his exclusive principles of moral development). For examples of Kohlberg's influential work, see Lawrence Kohlberg, *From Is to Ought: How to Commit the Naturalistic Fallacy and Get Away with It in the Study of Moral Development*, *in* COGNITIVE DEVELOPMENT AND EPISTEMOLOGY 151, 154 (Theodore Mischel ed., 1971); Lawrence Kohlberg, *Stage and Sequence: The Cognitive-Developmental Approach to Socialization*, *in* HANDBOOK OF SOCIALIZATION THEORY AND RESEARCH 347, 347 (David A. Goslin ed., 1969).

47. ELLIOT TURIEL, THE DEVELOPMENT OF SOCIAL KNOWLEDGE: MORALITY AND CONVENTION 3 (1983); *see also* Jesse Graham et al., *Mapping the Moral Domain*, 101 J. PERSONALITY & SOC. PSYCHOL. 366, 366-67 (2011) (noting that this definition has been "widely cited" among psychologists).

48. Graham et al., *supra* note 47, at 367. Of course, sexuality usually implies interaction

of harm or justice to others could be considered part of one's moral makeup.[49]

A flurry of recent experiments, however, has broadened our understanding of morality. New research demonstrates that people view other considerations besides failure to care for others as worthy criteria for condemnation. Moral judgment and the emotion of disgust are tightly linked.[50] We often feel disgust at particular behaviors, even when those behaviors can in no way be described as harmful or unfair to any individual. Think of a scene in which someone eats dinner off of a plate, one portion of which houses a group of completely sterilized cockroaches.[51] Our minds tell us that such activity is simply wrong even if it poses no risk to the individual.[52] Such findings have caused psychologists to adjust their definition of morality in an attempt to include all concepts that people believe are moral and trigger a particular mode of mental analysis.

A more inclusive definition of morality comes from moral foundations theory, an influential new development in evolutionary and cultural psychology.[53] Moral foundations theory identifies five

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with others, but not always. Our moral judgment of others' sexual behavior applies even to strictly individualized conduct. *See, e.g.*, Jonathan Haidt et al., *Affect, Culture, and Morality, or Is It Wrong to Eat Your Dog?*, 65 J. PERSONALITY & SOC. PSYCHOL. 613, 617-20, 625 (1993) (describing subjects who identify the story of an individual purchasing a dead chicken and having sexual relations with it as morally wrong).

49. Graham et al., *supra* note 47, at 367.

50. Paul Rozin et al., *Disgust*, *in* HANDBOOK OF EMOTIONS 757, 762-63 (Michael Lewis et al. eds., 3d ed. 2008); Simone Schnall et al., *Disgust as Embodied Moral Judgment*, 34 PERSONALITY SOC. PSYCHOL. BULL. 1096, 1096-97 (2008); *see also* James Gorman, *Survival's Ick Factor*, N.Y. TIMES, Jan. 24, 2012, at D1 (discussing the effects of the disgust emotion on behavior).

51. Paul Rozin et al., *Operation of the Laws of Sympathetic Magic in Disgust and Other Domains*, 50 J. PERSONALITY & SOC. PSYCHOL. 703, 704-05 (1986).

52. *See id.* at 706-10.

53. Greg Miller, *The Roots of Morality*, 320 SCI. 734, 734 (2008) (chronicling "intense interest" in moral foundations theory and related work); Christopher L. Suhler & Patricia Churchland, *Can Innate, Modular "Foundations" Explain Morality? Challenges for Haidt's Moral Foundations Theory*, 23 J. COGNITIVE NEUROSCIENCE 2103, 2103 (2011) (describing the theory as "an influential scientific account of morality"). In addition to shaping the psychological literature, the theory has begun to influence scholarship in law, political science, and public health. Jess Alderman et al., *Understanding the Origins of Anger, Contempt, and Disgust in Public Health Policy Disputes: Applying Moral Psychology to Harm Reduction Debates*, 31 J. PUB. HEALTH POL'Y 1, 3-4 (2010); Courtney Megan Cahill, *Abortion and Disgust*, 48 HARV. C.R.-C.L. L. REV. 409 (2013); Karl S. Coplan, *Legal Realism, Innate Morality, and*

areas of moral concern, common across cultures. According to the theory, when conduct being evaluated falls under one of these five categories, our moral sense is likely to be triggered and we will evaluate the conduct in the particular cognitive style described below. The five categories are described as (1) Harm/Care, (2) Fairness/Reciprocity, (3) Purity/Sanctity, (4) Ingroup/Loyalty, and (5) Authority/Respect.[54] These same areas of moral intuition are found in cultures across the world.[55] They may not always be equally valued, but they all influence the human judgment process.

The Harm/Care category matches well with the modern justification for trademark protection. Although not spoken of in moral terms, modern trademark law's stated reason for being is protecting consumers from harmful, misleading signals in the marketplace.[56] This justification fits the Harm/Care category, which praises caring for others and condemns inflicting harm.[57] If this were the only category that triggered our moral sense, there would be little disconnect between the consumer welfare justification that supposedly guides modern trademark law and the moral sentiments undergirding much of trademark doctrine. In many situations,

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the Structural Role of the Supreme Court in U.S. Constitutional Democracy, 86 TUL. L. REV. 181, 201-03 (2011); Brad Jones, The Morality of Representation: Constituent Moral Foundations and Position-Taking in Congress (Feb. 27, 2012) (unpublished manuscript), http://ssrn.com/ abstract=2018491. A recent book describing the theory and its application to political conflict, Jonathan Haidt's *The Righteous Mind*, was a best seller of 2012 and touted as "the most important book of the year." Holman W. Jenkins, Jr., *Jonathan Haidt: He Knows Why We Fight*, WALL ST. J. (June 29, 2012), http://online.wsj.com/article/SB10001424052702303830204577446512522582648.html.

54. *See* Haidt & Kesebir, *supra* note 38, at 822; Haidt & Joseph, *supra* note 17, at 381-85. A sixth category of universal moral concern, Liberty/Oppression, has recently been proposed and is being evaluated by scholars in the field. *See* Jesse Graham et al., *Moral Foundations Theory: The Pragmatic Validity of Moral Pluralism*, 47 ADVANCES EXPERIMENTAL SOC. PSYCHOL. 55, 85-87, 104 (2013).

55. Haidt & Joseph, *supra* note 17, at 367.

56. *See supra* note 3 and accompanying text. Hence, one might describe a judge's self-stated concern with "efficiency" or "search costs" in a trademark case as a type of "moral" argument. There are two potential problems with this, however. First, judges do not recognize arguments based on economic theory as the product of moral decision making; instead they present such arguments as the result of conscious, logical deliberation. As described *infra*, moral decision making involves a much less deliberative and self-aware process. Second, efficiency analysis tends to obscure other, largely unstated, moral concerns that are relevant not only to trademark law, but to legal decision making as a whole. *See* Joseph William Singer, *Normative Methods for Lawyers*, 56 UCLA L. REV. 899, 904-06 (2009).

57. *See* Haidt & Kesebir, *supra* note 38, at 822.

however, the other areas of moral concern will trump the Harm/Care category. The other four categories will be discussed in detail later in the Article. For now, two things are worth noting: (1) we routinely judge conduct based on these other moral foundations; and (2) these moral judgments can extend to purely personal behaviors. For example, someone may do something considered impure, thereby committing a violation of the Purity/Sanctity category, in the privacy of her own home without any deleterious consequences to anyone else. Nevertheless, others will condemn that action as immoral.[58]

B. Morality's Current Disfavor in the Law

A candidate for a federal judgeship today is unlikely to mention a strenuous reliance on these other moral foundations during the confirmation process. This is because certain styles of legal argument are deemed more legitimate than others. Appeals to precedent, statutory language, historical understandings at the time of enactment, and the appropriate balance of relevant legal and political institutions are all perceived as approved decision-making techniques and relied on regularly to justify judicial outcomes.[59] Rather than obscuring these techniques, their craftspersons make their use open and notorious. This holds true across all types of legal disputes, including decisions involving intellectual property law.

Hence, the preferred emphasis in judging is on the mechanical application of rules with little mention of judicial discretion.[60] Legal reasoning is typically described by those in the field as a special skill of lawyers and judges involving the discernment and applica-

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58. Haidt & Joseph, *supra* note 17, at 384.

59. *See* PHILIP BOBBITT, CONSTITUTIONAL FATE: THEORY OF THE CONSTITUTION 93-94 (1982); Gerald Torres, *Social Movements and the Ethical Construction of Law*, 37 CAP. U. L. REV. 535, 540 (2009).

60. *See, e.g.*, *Confirmation Hearing on the Nomination of John G. Roberts, Jr. to Be Chief Justice of the United States: Hearing Before the S. Comm. on the Judiciary*, 109th Cong. 56 (2005) (statement of John G. Roberts, Jr.) ("[A]nd I will remember that it's my job to call balls and strikes, and not to pitch or bat."); *see also* Richard A. Posner, *The Role of the Judge in the Twenty-First Century*, 86 B.U. L. REV. 1049, 1051 (2006) (describing formalism as the "conventional" and possibly "official" description of the modern judge's role).

tion of legal principles.[61] These principles come from the law, not outside sources. Most judicial opinions follow a set formula: the judge canvasses applicable precedents, extracts the principle that explains them, and then applies that principle to determine the legal winner.[62] To further support the winning principle, the judge may note its policy advantages.[63] This is where the search costs justification for trademark law often enters written opinions.[64]

By sharp contrast, modern opinions rarely appeal to a shared morality.[65] Even those who realistically acknowledge that there is great discretion in evaluating precedent and that the judicial role inevitably involves more than simply calling balls and strikes still hesitate to openly acknowledge that moral principles have shaped a legal outcome.[66]

As I will illustrate throughout the rest of this Article, this has not always been true, at least in the area of trademark law. Earlier courts were much more willing to tolerate some confusion and inefficient behavior to uphold trademark values separate from consumer protection.[67] In its foundational period in the late nineteenth and early twentieth centuries, the moral sentiments animating trademark doctrine became somewhat transparent.[68]

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61. LARRY ALEXANDER & EMILY SHERWIN, DEMYSTIFYING LEGAL REASONING 64-65 (2008).

62. *Id.* at 88.

63. *See* Daniel A. Farber & Philip P. Frickey, *Legislative Intent and Public Choice*, 74 VA. L. REV. 423, 456 & n.122 (1988) (maintaining that statutory interpretation requires inquiries into both legislative intent and the consequences from particular interpretations); Brian Z. Tamanaha, *How an Instrumental View of Law Corrodes the Rule of Law*, 56 DEPAUL L. REV. 469, 490 (2007) ("[J]udicial decisions today routinely cite policy considerations, consider the purposes behind the law, and pay attention to law's social consequences.").

64. *See* Daniel M. McClure, *Trademarks and Competition: The Recent History*, 59 LAW & CONTEMP. PROBS. 13, 32-33 (1996).

65. *See* BOBBITT, *supra* note 59, at 95 (discussing the absence of discussion of ethical arguments in the teaching of constitutional law); Samuel Enoch Stumpf, *The Moral Element in Supreme Court Decisions*, 6 VAND. L. REV. 41, 41 (1953) (describing a "manful resistance" by judges to allowing "moral and ethical judgments into their decisions"); *see also infra* notes 298-300 and accompanying text (explaining how modern trademark law favors certain groups).

66. *See* BOBBITT, *supra* note 59, at 128. A place where moral argument may enjoy more open support is in decisions involving constitutional recognition of unenumerated rights. *See* Akhil Reed Amar, *America's Lived Constitution*, 120 YALE L.J. 1734, 1744 (2011); *see also infra* notes 371-80 and accompanying text (explaining Philip Bobbitt's framework for employing moral arguments in constitutional law).

67. *See* Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1848 (2007).

68. *See* Sicilia Di R. Biebow & Co. v. Cox, 732 F.2d 417, 431 (5th Cir. 1984) ("Early cases

Treatise writers explicitly emphasized the salutary role of trademark law in encouraging a higher standard of commercial morality among businessmen.[69] Rather than justifying the law as strictly facilitating consumer efficiency, authorities explained that trademark protections were justified by the need to promote honesty and fair dealing.[70] As one court of the time described it, the legal standard for what can and cannot serve as a trademark derived exclusively from "broad principles of morality and public law."[71] These comments in the legal literature were not simply geared towards the instrumental goal of making businessmen more honest. They also reflected a particular view of commercial morality that drew its persuasive force from its supposedly nearly universal acceptance.[72]

Modern trademark law has turned its back, however, on openly invoking moral arguments. Judges frequently attempt to show morality's lack of influence by noting their own distaste for the defendant yet simultaneously stating that the law in the area requires ruling in the defendant's favor.[73] For example, in one case involving a distiller that copied the distinctive packaging of a famous whiskey producer, the court explained that "regardless of how disapproving the courts may be of such practices, they cannot

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dealing with the tort of palming off or passing off, which developed from the common law tort of fraud and deceit, 'imported a great deal of moral judgment into situations of trademark infringement.'"); *see also* 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25:1 (4th ed. 2009).

69. *See* JAMES LOVE HOPKINS, THE LAW OF TRADEMARKS, TRADENAMES AND UNFAIR COMPETITION, at vii (4th ed. 1924); HARRY D. NIMS, THE LAW OF UNFAIR BUSINESS COMPETITION, at iii-v (1909); PAUL STRUVEN, A TREATISE ON REGISTRATION OF TRADE MARKS IN THE INDIVIDUAL STATES OF THE UNITED STATES 24-25 (1934).

70. *E.g.*, Piso Co. v. Voight, 4 Ohio N.P. 347, 348 (Super. Ct. 1897) ("The ground upon which equity restrains the counterfeiting of trademarks is the promotion of honesty and fair dealing."); AMASA C. PAUL, THE LAW OF TRADE-MARKS INCLUDING TRADE-NAMES AND UNFAIR COMPETITION § 13 (1903).

71. Arbutnot, Latham & Co. v. Cage Drew Co., 6 Teiss. 374, 376 (La. Ct. App. 1909).

72. The early twentieth-century business community resented attempts by judges to force compliance with general moral precepts, however. A familiar refrain of the time was "business is business," meaning that the business world had its own structural concerns and norms that required moral specialization. ENGELBOURG, *supra* note 21, at 48.

73. 1 MCCARTHY, *supra* note 68, § 1:18; *see, e.g.*, Person's Co. v. Christman, 900 F.2d 1565, 1570 (Fed. Cir. 1990); Fashion Two Twenty, Inc. v. Steinberg, 339 F. Supp. 836, 848 (E.D.N.Y. 1971); Phila. Dairy Prods., Inc. v. Quaker City Ice Cream Co., 159 A. 3, 6 (Pa. 1932).

legislate the morals of the market place."[74] Another typical move is to maintain that any ethical concerns must be ignored in favor of decisions that further trademark law's primary goal—the reduction of consumer search costs. As one court explained in holding that a plaintiff could not reduce its burden of proof by citing the intentional nature of the defendant's acts, "A defendant's conduct, whether legitimate or reprehensible, has only a tenuous connection to the perceptions of consumers."[75] Despite evidence that moral concerns routinely influence decision making, today's courts portray themselves as immune to such concerns when evaluating trademark disputes.

C. Morality and Legal Decision Making

This section explains how, despite judicial protests to the contrary, moral intuition influences legal decision making. First, I describe the general psychology behind moral judgment. In many circumstances, we do not rationally deliberate the pros and cons of a particular action. This is often the case when we confront questions of morality. When our moral sense is triggered, other methods for rendering a decision tend to go out the window. Second, I suggest that judges often rely on this particular mode of decision making. Sometimes judges simply do not have the time or desire to expend the mental resources to engage in a lengthy deliberative process and, therefore, turn to emotion and readily available heuristics. This is particularly likely when a situation to be judged implicates one of the five areas of moral concern mentioned above.

1. Moral Judgment

Psychologists have uncovered a few hallmarks of moral decision making. First, when our moral sense is triggered, it operates implicitly and is used unreflectively.[76] According to psychologist

74. Jack Daniel Distillery, Inc. v. Hoffman Distilling Co., 190 F. Supp. 841, 844 (W.D. Ky. 1960), *aff'd*, 298 F.2d 606 (6th Cir. 1962).

75. Cont'l Lab. Prods. Inc. v. Medax Int'l Inc., 114 F. Supp. 2d 992, 1012-13 (S.D. Cal. 2000).

76. Haidt & Kesebir, *supra* note 38, at 802. Some would posit a greater role for deliberative reasoning, *see, e.g.*, Steven A. Sloman, *Two Systems of Reasoning*, *in* HEURISTICS

Daniel Kahneman's influential work, two basic strategies are available to us when making a decision.[77] One is a systematic mode that is effortful and analytic. This is a relatively slow process that requires time and concentration.[78] The other is a heuristic mode that is relatively effortless as it prioritizes instinct over reasoned deliberation.[79]

The heuristic mode typifies moral judgment. Certain questions are more likely to activate the heuristic mode than others. It appears that for most individuals, moral dilemmas—scenarios implicating one of the five moral categories—trigger this quick-response system. Past research suggested that when we are confronted with moral questions, systematic reasoning guides our thought process. But this research made the mistake of accepting its subjects' descriptions of their decision-making process at face value.[80] When our moral sense is engaged, we have little chance, after the fact, of accurately explaining why we judged a particular event the way we did.[81] As described by one cognitive scientist, "[t]he mind adjudicates when it comes to moral dilemmas, but guards its operative principles, leaving individuals to express

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AND BIASES: THE PSYCHOLOGY OF INTUITIVE JUDGMENT 379, 380-84 (Thomas Gilovich et al. eds., 2002), but the weight of the evidence suggests that intuition holds the upper hand in this process. Haidt & Kesebir, *supra* note 38, at 802.

77. KAHNEMAN, *supra* note 41, at 20-21. Psychologist Jonathan Haidt describes a similar cognitive dyad, which he refers to as "seeing-that" and "reasoning-why." JONATHAN HAIDT, THE RIGHTEOUS MIND: WHY GOOD PEOPLE ARE DIVIDED BY POLITICS AND RELIGION 41-48 (2012).

78. KAHNEMAN, *supra* note 41, at 22-23; Chris Guthrie et al., *Blinking on the Bench: How Judges Decide Cases*, 93 CORNELL L. REV. 1, 7-8 (2007); Pauline T. Kim, *Deliberation and Strategy on the United States Courts of Appeals: An Empirical Exploration of Panel Effects*, 157 U. PA. L. REV. 1319, 1373 (2009).

79. KAHNEMAN, *supra* note 41, at 20-22.

80. JOHN MIKHAIL, ELEMENTS OF MORAL COGNITION 20-21 (2011); Jonathan Haidt & Craig Joseph, *Intuitive Ethics: How Innately Prepared Intuitions Generate Culturally Variable Virtues*, 133 DAEDALUS 55, 57 (2004). When confronted with certain hypothetical moral dilemmas, people largely agree on the proper judgment, even if their professed reasons for that judgment are logically incoherent. *See, e.g.*, HAUSER, *supra* note 38, at 128-29 (noting that one experiment suggests this, though more research is needed to verify this among other groups).

81. Haidt & Kesebir, *supra* note 38, at 805; *see also* HAUSER, *supra* note 38, at 156; DANIEL KELLY, YUCK!: THE NATURE AND MORAL SIGNIFICANCE OF DISGUST 24 (2011) (describing how, when the feeling of "moral disgust" is triggered, people will continue to maintain the initial negative judgment even after admitting that they are unable to articulate a compelling reason supporting that judgment).

principles that provide either weak or incoherent support for their judgment."[82] Without our awareness, a moral norm acquired through cultural transmission becomes a part of us, and we are intrinsically motivated to punish those who would break that norm.[83] A decision based on moral intuition often comes first and preconsciously, and then is rationalized at a conscious level.[84] Our brains decide for us without being able to tell us why.

Second, moral judgment is infused with emotion.[85] Most decisions that we label as "moral" do not involve Kantian or utilitarian reasoning.[86] As one psychologist notes, "Our moral sense hands us emotional responses that motivate action, enabling judgments of right or wrong, permissible or forbidden."[87] Strong emotions can shift what would normally be a deliberative effort to determine whether someone has violated a social convention into the more intuitive moral decision-making process.[88]

Third, moral judgment does have criteria, even if those criteria are not always accessible to our conscious mind. Although instinctual, our moral instincts are guided by facts. Our moral faculty has developed over thousands of years to become skilled at identifying particular aspects of situations so as to punish cheaters and other moral transgressors.[89] The causal aspects of any scenario will be

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82. HAUSER, *supra* note 38, at 126-27; *see also* Haidt & Kesebir, *supra* note 38, at 805.

83. *See generally* Chandra Sekhar Sripada & Stephen Stich, *A Framework for the Psychology of Norms*, *in* 2 THE INNATE MIND: CULTURE AND COGNITION 280 (Peter Carruthers et al. eds., 2006) (explaining what norms are, how they originate, and how they affect individuals).

84. Jonathan Haidt, *The Emotional Dog and Its Rational Tail: A Social Intuitionist Approach to Moral Judgment*, 108 PSYCHOL. REV. 814, 817-18 (2001); *see also* HAUSER, *supra* note 38, at 25 ("Conscious moral reasoning often plays no role in our moral judgments, and in many cases reflects a post-hoc justification or rationalization of previously held biases or beliefs.").

85. JESSE J. PRINZ, THE EMOTIONAL CONSTRUCTION OF MORALS 22 (2007); Haidt & Kesebir, *supra* note 38, at 803; Nancy Sherman, *The Place of Emotions in Kantian Morality*, *in* IDENTITY, CHARACTER, AND MORALITY: ESSAYS IN MORAL PSYCHOLOGY, *supra* note 35, at 149, 150-54; *see also* WILLIAM PATRY, MORAL PANICS AND THE COPYRIGHT WARS 52 (2009) ("The emotional power of our beliefs is often the main determinant in our decision making.").

86. PRINZ, *supra* note 85, at 33; *see also* Haidt & Kesebir, *supra* note 38, at 802.

87. HAUSER, *supra* note 38, at 24.

88. *See id.* at 240.

89. *See* Leda Cosmides & John Tooby, *Cognitive Adaptations for Social Exchange*, *in* THE ADAPTED MIND 163, 163 (Jerome H. Barkow et al. eds., 1992).

important in rendering an instant moral judgment.[90] Likewise, the actor's perceived intent will inevitably shape our moral reaction, perhaps even in situations in which intent should be largely irrelevant because more formalized consequentialist thinking is supposed to apply.[91] This is manifest in trademark law, where the perceived intent of the defendant remains a determinative factor in infringement decisions despite its tenuous relationship to consumer welfare.[92]

Fourth, moral decisions can be contingent on local tradition. Instead of reasoning from first principles, people assess moral sanction on the basis of cultural norms: "Cultural patterns become internalized scripts and habits that are rarely consciously noted; if noted, rarely questioned; and if questioned, rarely energetically refuted."[93] Although the five categories of moral concern operate in every society, their specific content and relative salience can vary depending on culture.[94] For example, within the United States, due to historical circumstance, Northerners and Southerners have developed different moral judgments for when aggressive acts of self-defense are warranted. These judgments have even been translated into particular local laws.[95]

Finally, although many of us would like to envision ourselves as steadfastly obeying a consistent moral code, our moral decisions are highly dependent on context. People judge certain acts more or less harshly depending on surrounding cues.[96] Just to take one example,

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90. KAHNEMAN, *supra* note 41, at 110 (describing certain causal judgments as part of our heuristic mode of thinking); *see also* Mark Bartholomew & Patrick F. McArdle, *Causing Infringement*, 64 VAND. L. REV. 675, 704-18 (2011) (urging courts to formalize their intuitive reliance on causal reasoning in contributory infringement jurisprudence).

91. HAUSER, *supra* note 38, at 264; Miller, *supra* note 53, at 736.

92. *See infra* Part II.B.

93. Joseph A. Vandello & Dov Cohen, *When Believing Is Seeing: Sustaining Norms of Violence in Cultures of Honor*, *in* THE PSYCHOLOGICAL FOUNDATIONS OF CULTURE 281, 299 (Mark Schaller & Christian S. Crandall eds., 2004).

94. HAUSER, *supra* note 38, at 298-99, 422; KELLY, *supra* note 81, at 93.

95. RICHARD E. NISBETT & DOV COHEN, CULTURE OF HONOR: THE PSYCHOLOGY OF VIOLENCE IN THE SOUTH 60-65 (1996). There are also gender differences in moral constructs, with some evidence that men tend to have their moral sense triggered more by the Fairness/Reciprocity moral cluster, whereas women focus more on the Care/Harm cluster. *See* Owen Flanagan & Amélie Oksenberg Rorty, *Introduction* to IDENTITY, CHARACTER, AND MORALITY: ESSAYS IN MORAL PSYCHOLOGY, *supra* note 35, at 1, 8.

96. DAVID BROOKS, THE SOCIAL ANIMAL 282 (2011); KAHNEMAN, *supra* note 41, at 370. For

people render harsher moral judgments in dirty or smelly rooms than they do in environments that are clean or odor free.[97] Hence, the way in which acts are presented for judgment can determine whether our moral sense is activated.

2. Effect on Judges

Even if the description of the mechanics behind moral judgment offered above is accepted, one might argue that judges avoid such an approach. Their education, their specialized legal training, and their recognition of the importance of the issues before them may allow them to take a different cognitive path in rendering judgment. Judging is often described as a "craft," requiring the specialized ability to reason through analogy and uncover governing principles through close examination of past cases.[98] Under this view, respect for precedent will compel a judge to render decisions that clash with her own preferred outcomes and personal moral sentiments.[99]

In some situations, the systematic mode will prevail. Judges will naturally want to be accurate and to arrive at the "correct" decision. Some cases may be particularly important because of the pathbreaking nature of the case, the amount of money at stake, or the severity of the potential punishment. In such situations, we can expect judges to engage in reasoned deliberation, making difficult

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example, in one study, subjects were taught under hypnosis to feel disgust when they came across emotionally neutral words like "take" or "often." Then, when primed with these words, they punished particular moral infractions more severely than a control group for which "take" and "often" retained their normal valence. KWAME ANTHONY APPIAH, EXPERIMENTS IN ETHICS 86-87 (2008); Thalia Wheatly & Jonathan Haidt, *Hypnotic Disgust Makes Moral Judgments More Severe*, 16 PSYCHOL. SCI. 780 (2005).

97. KELLY, *supra* note 81, at 25-26; Schnall et al., *supra* note 50, at 1096; *see also* Shai Danziger et al., *Extraneous Factors in Judicial Decisions*, 108 PROC. NAT'L ACAD. SCI. U.S. 6889 (2011) (documenting different decisions of an Israeli parole board based on whether board members ate before making a decision); Robert Kurzban et al., *Audience Effects on Moralistic Punishment*, 28 EVOLUTION & HUM. BEHAV. 75, 81 (2007) (finding that the presence of an audience causes an increase in moralistic punishment).

98. ALEXANDER & SHERWIN, *supra* note 61, at 2-3; Brett G. Scharffs, *Law as Craft*, 54 VAND. L. REV. 2245, 2271-77 (2001).

99. *See* Lawrence Baum, *Motivation and Judicial Behavior: Expanding the Scope of Inquiry*, *in* THE PSYCHOLOGY OF JUDICIAL DECISION MAKING 3, 7 (David Klein & Gregory Mitchell eds., 2010); LEE EPSTEIN & JACK KNIGHT, THE CHOICES JUSTICES MAKE 163-77 (1998).

comparisons with other cases and concepts, synthesizing information, and, to the best of their ability, predicting the larger consequences of their decision.[100]

In other situations, however, judges employ the heuristic mode. Everyone, including judges, has cognitive limits, and this can influence when they adopt a particular decision-making strategy.[101] Sometimes it is not clear what judicial outcome best furthers a particular policy interest.[102] One response to such cognitive limits is to rely on heuristics that limit the complex cognitive work necessary to reach a decision. There is no reason to think that judges never engage in these affective strategies, particularly when confronted with crowded dockets and a limited number of resources to deal with them.[103]

Judges can also be influenced by what psychologists describe as the defense motivation—"an orientation toward reinforcing important self-related beliefs."[104] Emily Sherwin makes a compelling case that judges routinely engage in motivated reasoning, with a moral heuristic representing the first part of their analysis. As she

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100. It should be noted that, even when the systematic mode of decision making is engaged, a number of cognitive biases are likely to distort this process. Judges, like other decision makers, are apt to focus too intently on the facts at hand and, thereby, give insufficient attention to the future implications of a legal decision in different contexts. *See* Frederick Schauer, *Do Cases Make Bad Law?*, 73 U. CHI. L. REV. 883, 885-86 (2006); Amos Tversky & Daniel Kahneman, *Availability: A Heuristic for Judging Frequency and Probability*, *in* JUDGMENT UNDER UNCERTAINTY: HEURISTICS AND BIASES 163, 177-78 (Daniel Kahneman et al. eds., 1982).

101. *See* C.K. Rowland et al., *Every Jury Trial Is a Bench Trial: Judicial Engineering of Jury Disputes*, *in* THE PSYCHOLOGY OF JUDICIAL DECISION MAKING, *supra* note 99, at 183, 192; Shiv & Fedorikhin, *supra* note 41, at 286, 288.

102. This may especially be the case with intellectual property regulation, including trademark law, whose costs and benefits are notoriously hard to quantify. *See, e.g.*, Jeremy N. Sheff, *Biasing Brands*, 32 CARDOZO L. REV. 1245, 1311-13 (2011) (maintaining that it is impossible to empirically assess the balance between consumer welfare losses from psychological manipulation by trademark owners versus the administrative and error costs of attempting to regulate such manipulation).

103. *See, e.g.*, Baum, *supra* note 99, at 8-9; Jeffrey J. Rachlinski et al., *Does Unconscious Racial Bias Affect Trial Judges?*, 84 NOTRE DAME L. REV. 1195, 1196 (2009).

104. Shelly Chaiken et al., *Beyond Accuracy: Defense and Impression Motives in Heuristic and Systematic Information Processing*, *in* THE PSYCHOLOGY OF ACTION: LINKING COGNITION AND MOTIVATION TO BEHAVIOR 553, 554 (Peter M. Gollwitzer & John A. Bargh eds., 1996); Ziva Kunda, *The Case for Motivated Reasoning*, 108 PSYCHOL. BULL. 480 (1990); *see* Hugo Mercier & Dan Sperber, *Why Do Humans Reason?: Arguments for an Argumentative Theory*, 34 BEHAV. & BRAIN SCI. 57, 72-73 (2011).

explains, "[T]he reasoner constructs a tentative moral principle applicable to the problem at hand, then tests the principle against moral intuitions about particular instances within the principle's scope and against background theories about the world at large."[105] Judges make adjustments to resolve conflicts until the conflicts are satisfactorily addressed and a principle emerges that resolves the case.[106] Importantly, the process Sherwin describes begins with a moral principle.[107] Thus, judicial outcomes may be greatly dependent on a particular cognitive starting point: moral intuition.

Moreover, the decision maker's initial moral stance may not be as tentative as Sherwin and others suggest. If a legal dispute activates the judge's sense of self, a defense motivation is likely to kick in.[108] Given that moral beliefs often form the core of our identities, judges will be more likely to engage in directed reasoning in cases implicating one of the five moral foundations.[109] Legal decision makers may believe they are merely responding to accuracy concerns because:

> [They] do not realize that the process is biased by their goals, that they are accessing only a subset of their relevant knowledge, that they would probably access different beliefs and rules in the presence of different directional goals, and that they might even be capable of justifying opposite conclusions on different occasions.[110]

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105. Emily Sherwin, *Features of Judicial Reasoning, in* THE PSYCHOLOGY OF JUDICIAL DECISION MAKING, *supra* note 99, at 121-22.

106. *Id.* at 122.

107. *Id.*

108. *See* Baum, *supra* note 99, at 17.

109. For example, when the emotion of "disgust," which has ties to the Purity/Sanctity moral category, is triggered, the effects are powerful enough that "people will maintain their negative judgment of the object of evaluation even when they admit that, by their own lights, they are unable to articulate any good reasons supporting that negative evaluation." KELLY, *supra* note 81, at 24.

110. Rowland, *supra* note 101, at 194; *see also* Tom Pyszczynski & Jeff Greenberg, *Toward an Integration of Cognitive and Motivational Perspectives on Social Inference: A Biased Hypothesis-Testing Model*, 20 ADVANCES EXPERIMENTAL SOC. PSYCHOL. 297, 297-98 (1987) ("Rather than viewing cognitive bias as a result of the affective consequences of various cognitive configurations [some theorists] view it as a consequence of the dispassionate workings of the cognitive system.").

One might continue to argue that judges, on the alert for the influence of moral intuition, can do a better job than the rest of us in rerouting their decision making to a more systematic, deliberate process. Admittedly, few studies have examined judges' compliance with moral norms. But evidence suggests that judges do not always have conscious awareness of the motives guiding their behavior.[111]

A good example of the proven influence of moral intuition in the legal decision-making process comes from a study involving purported harms from vaccines and birth control pills.[112] Subjects read different versions of a hypothetical case in which an individual consumer was harmed by the item of manufacture, and then asked whether the manufacturer should be fined.[113] In some versions, the subjects were informed that issuing a penalty against the manufacturer would make the manufacturer likely to stop making the product altogether, thereby resulting in less safe products on the market.[114] In other versions, subjects were told that the result of a penalty would be that the manufacturer would work harder in the future to make a safer product.[115] Most of the subjects surveyed, including a number of judges, called for the same penalty for both versions of the case.[116] This suggests that the judges did not notice or did not pay attention to the issue of incentives or even of aggregate welfare. Cass Sunstein argues that instead the study's participants applied what he calls an "outrage heuristic."[117] Instead of evaluating the future effects of a particular legal outcome, the decision maker mandates a punishment proportional to her own sense of outrage.[118] In other words, the punishment is based on moral intuition. We can see this as an example of moral judgment short-circuiting the more deliberative process, which might be used to decide other, less emotionally charged questions.

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111. *See* Baum, *supra* note 99, at 13; *see also* David G. Winter, *Personality and Political Behavior*, *in* OXFORD HANDBOOK OF POLITICAL PSYCHOLOGY 110, 121 (David O. Sears et al. eds., 2003) ("[M]otives often operate at an implicit or even unconscious level–partly because people may not attend to or verbalize the long-term trends of their actions.").

112. Jonathan Baron & Ilana Ritov, *Intuitions About Penalties and Compensation in the Context of Tort Law*, 7 J. RISK & UNCERTAINTY 17, 17 (1993).

113. *Id.* at 21-23.

114. *Id.* at 23.

115. *Id.*

116. *Id.* at 23-24.

117. Cass R. Sunstein, *Moral Heuristics*, 28 BEHAV. & BRAIN SCI. 531, 538 (2009).

118. *Id.*

Of course, the scaffolding judges erect to justify their decisions does not describe their use of the heuristic mode. In their opinions, judges are usually careful to offer the appearance of lengthy, reasoned deliberation. The public expectation is for the traditional techniques of legal reasoning to bear the greatest weight in the decision-making process, and any judicial announcement of judgment will reflect the same.[119] Hence, a surface view of judicial texts shows legal issues decided strictly according to statutory language, the closest applicable precedent, and information on the historical intent of legislative actors. The weight of the evidence suggests, however, that this is often an after-the-fact process in which the morally motivated judge selectively picks nonmoral evidence to justify an instinctual decision.[120] Judges, particularly in the intellectual property context, are uncomfortable making morality an explicit part of their opinions. But it is there.

II. DETECTING UNFAIRNESS

Having sketched out the basic contours of moral judgment and its potential influence on legal decision making, I now turn to identifying some important areas where these phenomena have influenced trademark doctrine. These areas of doctrinal development, despite their basis in moral intuition, have withstood time and the switch to the consumer efficiency rationale. One moral norm critical to shaping trademark law is the belief that fairness requires a respect for personal investment. Courts privilege competitors that can demonstrate their own investment in the marketplace, even though this investment is largely irrelevant to the question of consumer

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119. *See* ALEXANDER & SHERWIN, *supra* note 61, at 2-3; *see also* Brian Leiter, *Heidegger and the Theory of Adjudication*, 106 YALE L.J. 253, 257 (1996) (describing general public satisfaction with the perceived methods of judicial decision making).

120. Of course, other considerations besides moral intuition and traditional methods of legal reasoning may influence judicial decision making. No doubt strategic behavior is part of the judicial process. Judges may factor in the reactions of various audiences—their colleagues, other political branches, the general public—in deciding cases as well. *See* Baum, *supra* note 99, at 6; EPSTEIN & KNIGHT, *supra* note 99, at 164-65; *see also* Benjamin Weiser, *Judge in Madoff Case Recalls Rationale Behind a 150-Year Sentence*, N.Y. TIMES, June 29, 2011, at A1, *available at* http://www.nytimes.com/2011/06/29/nyregion/judge-denny-chin-recounts-his-thoughts-in-bernard-madoff-sentencing.html (recounting the sentencing judge's efforts to sentence Bernard Madoff to a symbolically appropriate sentence).

welfare. On the other hand, when the evidence suggests an intent to piggyback on the work of others, courts punish economic actors.

A. Personal Investment and Moral Nature

As explained in Part I, psychologists have identified four additional categories of moral concern apart from the Harm/Care category.[121] The Fairness/Reciprocity moral foundation implicates those situations in which an inequity is perceived. Over the centuries, humans have developed a rapid-fire capacity for detecting cheaters—those who have somehow entered into and violated a social contract.[122] Research shows that humans are not only good at detecting inequity, but they respond to it with great emotion.[123] An offer perceived to be "unfair" activates the same portions of the brain that respond to feelings of disgust.[124] In other words, we are hardwired to find cheaters revolting. But who is a cheater? The Fairness/Reciprocity intuition can be triggered when actors enjoy rewards disproportionate to their actual contributions, as well as by scenarios denying similarly situated individuals equal opportunities.[125] American history and culture have further shaped the Fairness/Reciprocity intuition in this country, leading to activation of our moral sense in particular circumstances. In the late nineteenth century, when American trademark law entered its formative period, the competitive marketplace, with its potential for both economic success and financial trickery, became the site of a character formation process.[126] In navigating this process, "the young American was told he must assume complete command of his own moral destiny by forming his own character from within."[127] Not

121. *See supra* note 54 and accompanying text.

122. HAUSER, *supra* note 38, at 276.

123. Haidt & Joseph, *supra* note 17, at 382-83.

124. HAUSER, *supra* note 38, at 287.

125. HAIDT, *supra* note 77, at 136-38.

126. *See* KAREN HALTTUNEN, CONFIDENCE MEN AND PAINTED WOMEN: A STUDY OF MIDDLE-CLASS CULTURE IN AMERICA, 1830-1870, at 25-31 (1982). For example, early antipathy to life insurance was due, in part, to the belief that it was incompatible with the character formation process offered by the marketplace. VIVIANA A. ROTMAN ZELIZER, MORALS AND MARKETS: THE DEVELOPMENT OF LIFE INSURANCE IN THE UNITED STATES 32 (1979).

127. HALTTUNEN, *supra* note 126, at 25 (1982); *see also* BROOKS, *supra* note 96, at 125 (describing how "Victorian moralists" focused on the ability of "upstanding people" to repress and control their temptations); RICHARD WHITE, RAILROADED 395 (2011) (linking business

just captains of industry, but even members of the nascent consumer movement assumed that the marketplace served an important role in the moral development of its participants.[128] Some economic moralists emphasized the marketplace's role in teaching the virtue of self-denial.[129] Teddy Roosevelt was representative of many in that he believed in an economic world that produced people with the vigorous virtues of self-reliance and initiative.[130] Discussions of competitive freedom at the time linked economic liberty with personal liberty; they were considered equally essential to individual growth.[131] Because participation in the marketplace conferred personal and spiritual benefits,[132] any denial of the ability to participate raised serious fairness concerns.[133]

In this period, people typically viewed material success as an accurate gauge of a man's hard work and self-restraint.[134] Religious authorities linked commercial accomplishment with moral triumph.[135] But, if further scrutiny revealed that this success was

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behavior with "manhood" and "character" in the late nineteenth-century view).

128. *See* LAWRENCE B. GLICKMAN, BUYING POWER: A HISTORY OF CONSUMER ACTIVISM IN AMERICA 5, 23 (2009). There were some anticapitalist critics to be sure, but, in general, people saw business as a neutral field for personal striving and heroic endeavor, and not overly influenced by its corporate interests. *See* ALAN TRACHTENBERG, THE INCORPORATION OF AMERICA: CULTURE & SOCIETY IN THE GILDED AGE 5 (1982); *see also* ENGELBOURG, *supra* note 21, at 28 ("The belief in the morality of businessmen coming together for their mutual benefit endured as the dominant value and was implicitly sanctioned by society despite the strictures of common law."); JAMES W. KUHN & IVAR BERG, VALUES IN A BUSINESS SOCIETY: ISSUES & ANALYSES 106-07 (1968) ("The public accepted without much question the businessman's theory of a self-regulating economy, paying little attention to the inconsistency between this theory and the business community's opportunistic practices.").

129. DONALD E. FREY, AMERICA'S ECONOMIC MORALISTS: A HISTORY OF RIVAL ETHICS AND ECONOMICS 91 (2009); WHITE, *supra* note 127, at 250 (describing the "Victorian attitude of manhood defined by control and self-restraint that [some] thought should inform commercial life").

130. BROOKS, *supra* note 96, at 333.

131. *See* ROBERT GREEN MCCLOSKEY, AMERICAN CONSERVATISM IN THE AGE OF ENTERPRISE 2-3 (1951).

132. *See supra* note 128 and accompanying text.

133. MAX RADIN, MANNERS AND MORALS OF BUSINESS 143-44 (1939) ("To prevent a man from competing was at the beginning of the modern era a wrongful act because it violated his fundamental and rational right.").

134. *See* DONALD MCCONNELL, ECONOMIC VIRTUES IN THE UNITED STATES: A HISTORY AND AN INTERPRETATION 147-48 (1973).

135. *See id.* at 148; RADIN, *supra* note 133, at 175. In some sermons, God was described as a businessman and as the investing partner of other businessmen. ZELIZER, *supra* note 126, at 150; *see* REINHARD BENDIX, WORK AND AUTHORITY IN INDUSTRY 257 (1956); SIGMUND

simply the product of inheritance or good fortune, then the individual had no claim to the moral high ground.[136] Even titans of industry could find themselves under attack when it appeared that their success owed more to a family bequest or unscrupulous behavior than to the virtues that were taught by economic competition.[137] The "contract" between individuals and the rest of society was that the individual had to personally invest in the economic sphere before he could enjoy the material and spiritual benefits of the marketplace. An actor that profited from the marketplace but invested nothing of himself was a cheater and could not claim the moral blessings of economic competition.[138] Trademark law reflects this perceived link between personal investment and moral character. Two examples follow. First, by fixating on and broadly defining a trademark defendant's culpable intent, judges reveal their desire to punish freeriders—those who do not personally participate in the character-building function of the marketplace. Second, by privileging the use of personal names by trademark

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DIAMOND, THE REPUTATION OF THE AMERICAN BUSINESSMAN 77 (1955). Bruce Barton's 1925 best seller, *The Man Nobody Knows*, depicted Jesus as "the founder of modern business." BRUCE BARTON, THE MAN NOBODY KNOWS 159 (1925). The point of such sermons was to wed material and spiritual advancement. Failures to achieve wealth were often described as moral shortcomings. *See* THOMAS K. MCCRAW, PROPHETS OF REGULATION 17 (1984); DAVID J. ROTHMAN, THE DISCOVERY OF THE ASYLUM: SOCIAL ORDER AND DISORDER IN THE NEW REPUBLIC 162 (2002).

136. *See* MCCONNELL, *supra* note 134, at 76; *see also* Rudolf Callmann, *What Is Unfair Competition?*, 28 GEO. L.J. 585, 599-601 (1940) (distinguishing, for purposes of unfair competition law, between illegal "non-constructive effort" and legal "constructive effort" in the struggles of the post-industrial business world).

137. *See* MCCONNELL, *supra* note 134, at 76; *see also* WHITE, *supra* note 127, at 253 (describing "Robber Baron literature" that criticized those who amassed fortune due to political corruption rather than individual virtue).

138. Evidence of this attitude can be found in the regulation of gambling in the late 1800s. American courts of the late nineteenth century were particularly concerned with the harmful social and economic effects of gambling. Almost every state had a law outlawing wagering. As one state supreme court remarked: "[B]y legislation and judicial decision, the hostility to wagers of every nature has been marked.... Wagers are inconsistent with the established interests of society, and in conflict with the morals of the age; and, as such, they are void, as against public policy." Bernhard v. Taylor, 31 P. 968, 968 (Or. 1893). The problem with gambling was that it involved no productive activity of its own and discouraged the sober Puritan virtues of industriousness and prudence. Someone might put up only a small amount of money and achieve a large payday. This upset the typical assumption that a man's wealth was proportional to his industry. *See* ZELIZER, *supra* note 126, at 81; Edward J. Balleisen, *Vulture Capitalism in Antebellum America: The 1841 Federal Bankruptcy Act and the Exploitation of Financial Distress*, 70 BUS. HIST. REV. 473, 511-12 (1996).

defendants, courts rank autonomy and reciprocity concerns over the protection of consumers.

B. Intent

In trademark claims involving infringement, dilution, and secondary liability, judges make the defendant's intent central to their overall assessment of liability. Moreover, courts define culpable intent more broadly than necessary to fulfill the professed informational efficiency goal of trademark law.

It was not always so. A number of late nineteenth-century courts initially maintained that a judge must consider only what a trademark defendant did, not what he intended.[139] As time went on, however, the courts with the winning argument were those that found bad faith not essential, but extremely important in determinations of trademark infringement. Supreme Court rulings on trademark law cemented the importance of intent to infringement analysis.[140]

Early twentieth-century judges not only committed trademark law to an inquiry into the defendant's intent, but also broadly defined what sort of mental state should be relevant to determining liability. Trademark judges define probative intent in two different

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139. *See, e.g.*, Kann v. Diamond Steel Co., 89 F. 706, 712-13 (8th Cir. 1898); Wirtz v. Eagle Bottling Co., 24 A. 658, 659 (N.J. 1892) ("The legal quality of an act, resulting in injury, must be decided, not by the motive with which it was done, but by the consequences which have necessarily resulted from it."); *see also* NIMS, *supra* note 69, at 45-51 (collecting cases holding that proof of intent was immaterial to determining infringement); Thomas L. Casagrande, *A Verdict for Your Thoughts?: Why an Accused Trademark Infringer's Intent Has No Place in Likelihood of Confusion Analysis*, 101 TRADEMARK REP. 1447, 1451 (2011) (describing how mid-twentieth-century courts "generally focused more on the defendant's actions and their effects on consumers than the defendant's intention itself"). In the late nineteenth century, courts often distinguished between "technical trademarks," which applied arbitrary or fanciful terms to products, and "trade names," which employed surnames, geographic terms, or descriptive terms to identify products. For the most part, courts would require proof of intent in trade name cases but not in cases involving technical trademarks. McKenna, *supra* note 67, at 1862. Courts abandoned the distinction between technical trademarks and trade names in the early twentieth century. Bartholomew, *supra* note 18, at 9-10.

140. *See, e.g.*, Elgin Nat'l Watch Co. v. Ill. Watch Co., 179 U.S. 665, 674 (1901) (holding that suits for certain infringement actions require that "such circumstances must be made out as will show wrongful intent"); Lawrence Mfg. Co. v. Tenn. Mfg. Co., 138 U.S. 537, 549 (1891) (requiring proof of "intent, on the part of the defendant, to avail itself of the reputation of the plaintiff").

ways. Under one view, intent means that the defendant must intend to deceive consumers.[141] This definition arguably tracks the search costs justification for trademark protection by targeting only those situations in which the defendant meant to disrupt consumer expectations. The theory is that if the defendant meant to confuse consumers, then this indicates that the defendant was successful in confusing consumers.[142]

But another definition of intent suggests that courts are applying a moral standard in the likelihood of confusion analysis, rather than attempting to predict consumer reaction. This view of intent asks not whether the defendant meant to deceive consumers but merely whether the defendant intended to benefit from the trademark holder's goodwill.[143] This is a broader conception of bad faith than the one described above. It includes situations in which the defendant's goal was not necessarily misaligned with consumer interests.[144] A business may intend to utilize the goodwill in another's trademark without intending to deceive consumers. It may even intend to employ the goodwill of another brand in a way that aids consumers. For example, a private label seller may position its less expensive product on the shelf next to a product bearing a brand name (think of the Walgreens brand of ibuprofen parked next to Advil) in an intentional effort to utilize a consumer's recognition of the more established brand. Such conduct demonstrates an intent to profit from the plaintiff's mark, but not an intent to fool shoppers into making a mistaken purchase. Hence, the

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141. *E.g.*, A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc., 237 F.3d 198, 226 (3d Cir. 2000) (describing the applicable standard as "intent to confuse"); Streetwise Maps, Inc. v. VanDam, Inc., 159 F.3d 739, 745 (2d Cir. 1998) ("The intent to compete by imitating the successful features of another's product is vastly different from the intent to deceive purchasers as to the source of the product.").

142. *See* 4 MCCARTHY, *supra* note 68, § 23:124 ("[I]t is not often that a business person intentionally sets out to divert sales from a competitor by confusing customers, yet is so inept that it fails to achieve its goal.").

143. Courts also consider an intent to profit off the goodwill of a trademark owner in determining whether there has been an actionable "use" of a trademark, a determination separate from the likelihood of confusion analysis. *E.g.*, DaimlerChrysler AG v. Bloom, 315 F.3d 932, 938-39 (8th Cir. 2003); Holiday Inns, Inc. v. 800 Reservation, Inc., 86 F.3d 619, 623-24 (6th Cir. 1996); *see also* Margreth Barrett, *Trademarks and Digital Technologies: "Use" on the Net*, 13 J. INTERNET L. 1, 10-11 (2010) (criticizing same).

144. *See* Michael Grynberg, *The Judicial Role in Trademark Law*, 52 B.C. L. REV. 1283, 1319-20 (2011).

second way of defining intent potentially implicates business behaviors that help rather than harm or confuse consumers.

Repeatedly, in assessing trademark infringement disputes, early twentieth-century courts applied the second definition of intent, citing defendants' lack of industry and attempts to trade off of the goodwill of another as reason for sanctioning their conduct. The phrase "reaping where one has not sown" was used to justify many decisions in favor of trademark plaintiffs in the early 1900s,[145] including those of the Supreme Court.[146] A good example comes from the 1928 case of *Lambert Pharmacal Co. v. Listerated Co.*[147] In that case, the defendant, a hair tonic producer, was enjoined from advertising its product under the name "Listerated," this being judged an infringement of the plaintiff's "Listerine" trademark. The court seized on evidence that the defendant had "largely copied" the defendant's advertisements.[148] To make matters worse, the defendant's product contained Listerine, albeit in small amounts. The court opined that "only a blind man can fail to see that defendant has deliberately set out to pirate plaintiff's reputation, to reap where it had not sown, and, like the cuckoo, to lay its eggs in the nest of another bird."[149] Seemingly unconcerned that the two parties operated in two very different markets—antiseptic mouthwash versus hair tonic—the court condemned the defendant in biblical terms. It stated that the defendant's chosen name "conceived as it was in business sin, and brought forth in business iniquity, cannot

145. *See, e.g.*, Van Camp Sea Food Co. v. Alexander B. Stewart Orgs., 50 F.2d 976, 980 (C.C.P.A. 1931); F.P. Kirkendall & Co. v. Mayer Boot & Shoe Co., 47 App. D.C. 245, 246 (D.C. Cir. 1918); Flora v. Flora Shirt Co., 283 P. 1013, 1014 (Okla. 1930); M.M. Newcomer Co. v. Newcomer's New Store, 217 S.W. 822, 825 (Tenn. 1919); Robinson v. Robinson's, Inc., 9 Tenn. App. 103, 111 (1928); J.I. Case Plow Works v. J.I. Case Threshing Mach. Co., 155 N.W. 128, 134 (Wis. 1915); *see also* Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2113 & n.43 (2004) (cataloging use of "unjust enrichment rhetoric" in trademark cases); Rudolf Callmann, *He Who Reaps Where He Has Not Sown: Unjust Enrichment in the Law of Unfair Competition*, 55 HARV. L. REV. 595, 612 (1942) ("[O]ne who has used his intellectual, physical, or financial powers to create a commercial product should be afforded judicial relief from a competitor who seeks to reap where he has not sown.") (internal quotation marks omitted).

146. *See, e.g.*, Coca-Cola Co. v. Koke Co., 254 U.S. 143, 145 (1920); Hanover Star Milling Co. v. Metcalf, 240 U.S. 403, 426 (1916) (Holmes, J., concurring).

147. 24 F.2d 122 (S.D. Tex. 1928).

148. *Id.* at 123.

149. *Id.*

be cleansed of its original sin ... but that what is needed here is a true regeneration, with a new christening, under a new name."[150]

This sort of judicial reasoning frustrates most intellectual property scholars.[151] After all, the presence or absence of personal investment has little to do with reducing search costs for consumers.[152] Perhaps potential purchasers of hair tonic might see a link between "Listerated" and "Listerine," but the defendant's lack of industry does not really shed light on that issue. It takes a logical leap to infer consumer confusion merely from a defendant's intent to benefit in some fashion from the plaintiff's mark.[153] In some cases, including *Lambert*, the "reap/sow" language was used to find against defendants not even in competition with the plaintiff.[154] Under the search costs model of trademark law, what should be important is consumer perception of a particular mark, not the hard work, or lack thereof, of a business in developing that mark. If a defendant is employing someone else's trademark in a nonconfusing manner, then it should not matter if she means to free ride off of the trademark holder's previous efforts.

If you look to modern trademark opinions, you might conclude that today's courts agree with the scholars and that decisions like *Lambert* are outdated relics. Today, in evaluating claims of trade-

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150. *Id.* In *Lambert* and other cases employing the "reap/sow" language, defendants were held accountable for trying to use the goodwill built up in another's mark instead of making their own effort to create a brand from the ground up. This focus on personal investment tracks the property rights theory of philosopher John Locke. Locke made a moral argument that labor makes one "deserving" of property rights. Trading off of that labor without performing labor yourself seems unjust. Labor should be rewarded with legal rights, whereas a lack of labor should not. When the labor at issue is the plaintiff's efforts to build up goodwill in a brand, the defendant's free riding off of that goodwill can appear inappropriate under Locke's theory and, hence, warrant a finding of infringement. 4 MCCARTHY, *supra* note 68, § 24:21. As others have noted, this Lockean argument continues to animate modern trademark law. *See, e.g.*, David J. Franklyn, *Debunking Dilution Doctrine: Toward a Coherent Theory of the Anti-Free-Rider Principle in American Trademark Law*, 56 HASTINGS L.J. 117, 147-48 (2004); Sheff, *supra* note 17, at 768-74.

151. *See, e.g.*, William P. Kratzke, *Normative Economic Analysis of Trademark Law*, 21 MEMPHIS ST. U. L. REV. 199, 223 (1991); Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1032-33 (2005); McKenna, *supra* note 3, at 124-27.

152. *See* Bone, *supra* note 2, at 583-92, 616-21; Felix S. Cohen, *Transcendental Nonsense and the Functional Approach*, 35 COLUM. L. REV. 809, 814-17 (1935).

153. *See* Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 98 TRADEMARK REP. 1345, 1370-71 (2008); Mark P. McKenna, *Testing Modern Trademark Law's Theory of Harm*, 95 IOWA L. REV. 63, 116 (2009).

154. *See, e.g.*, Checker Cab Mfg. Corp. v. Sweeney, 197 N.Y.S. 284, 286 (1922).

mark infringement, courts apply a variety of judge-made factors in determining whether a defendant's use of a trademark is likely to cause confusion. Almost all of these factors are directly related to pinpointing what kinds of uses will cause a consumer to mistake the defendant's product for the plaintiff's—the essential question in any infringement action. For example, every federal circuit examines the similarity between the plaintiff's and the defendant's marks, the relatedness of the plaintiff's and defendant's goods, and the sophistication of the relevant consumer base.[155] These factors all focus on the likely consequences of the defendant's actions for consumers.

Another factor, universally applied, stands out, however. The defendant's intent is considered relevant to the question of consumer confusion, even though it arguably has little bearing on how a consumer perceives the defendant's use of the plaintiff's mark.[156] Some judges profess to care little for questions of intent, noting that it is only one factor among many to be considered.[157] Nevertheless, no federal circuit has chosen to discard considerations of intent in its confusion analysis.[158] Moreover, empirical study of recent decisions demonstrates the critical importance of intent to an ultimate finding of infringement, even in those circuits that disclaim its importance.[159] Despite their public statements, courts continue to construe intent in a broad manner that is unrelated to consumer

155. *See, e.g.*, Streetwise Maps, Inc. v. Vandam, Inc., 159 F.3d 739, 743-46 (2d Cir. 1998); Bos. Athletic Ass'n v. Sullivan, 867 F.2d 22, 29-31 (1st Cir. 1989); Helene Curtis Indus., Inc. v. Church & Dwight Co., 560 F.2d 1325, 1330 (7th Cir. 1977).

156. *See, e.g.*, Casagrande, *supra* note 139, at 1447.

157. *See, e.g.*, Virgin Enters. Ltd. v. Nawab, 335 F.3d 141, 151 (2d Cir. 2003); Chrysler Corp. v. Silva, 118 F.3d 56, 59 n.3 (1st Cir. 1997); T.A.B. Sys. v. PacTel Teletrac, 77 F.3d 1372, 1376 (Fed. Cir. 1996); Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co., 799 F.2d 867, 875 (2d Cir. 1986).

158. Kitsuron Sangsuvan, *Trademark Infringement Rules in Google Keyword Advertising*, 89 U. DET. MERCY L. REV. 137, 161 (2012); *see also* 4 MCCARTHY, *supra* note 68, § 23:19 (describing intent as a "foundational factor" that helps form "the basis for the various lists of factors now required to be used by the various federal circuits"). One circuit treats evidence of bad intent as triggering a rebuttable presumption in favor of the trademark holder. *See* Bauer Lamp Co. v. Shaffer, 941 F.2d 1165, 1172 (11th Cir. 1991).

159. *See* Beebe, *supra* note 8, at 1626-31; *see also* Casagrande, *supra* note 139, at 1453-54 ("[E]xperienced practitioners are well aware that intent remains one of the most—if not the single most—critical of the confusion factors.").

protection or really any sort of utilitarian assessment of consumer welfare.[160]

A good illustration of this phenomenon comes from cases involving unauthorized use of university color schemes. In those cases, courts have equated "intent to *capitalize* on the university's popularity" with an "intent to *confuse* consumers."[161] As one judge explained, the defendants' admission that they meant to "rely upon the drawing power [of the university colors] in enticing fans of the particular universities to purchase their shirts" was evidence of bad faith.[162] The judge also noted that the defendants had attempted to take a "free ride" on the universities' reputation.[163] As it did a century ago, this language may reflect a moral judgment of the defendant's "fairness" rather than a desire to eliminate inefficiencies for consumers. As others have pointed out, consumers typically do not care whether merchandise featuring their favorite university sports team is officially licensed by the university itself.[164] Nevertheless, when a court perceives that the merchandiser intended to profit from the university's brand goodwill, the university will typically succeed in its infringement claim.

Broad definitions of intent translate into judicial victories for trademark holders. When the Academy of Motion Picture Arts and Sciences sued the maker of a golden "Star Award" for infringing the trademark in its "Oscar" statuette, the Ninth Circuit reversed the court below and found a likelihood of confusion.[165] It seems unlikely

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160. In many modern cases, judges mention "free-riding" or its equivalent when discussing the sort of culpable mental state relevant under the intent factor of the multi-factor likelihood of confusion test. *E.g.*, Comerica Inc. v. Fifth Third Bankcorp, 282 F. Supp. 2d 557, 573 (E.D. Mich. 2003); Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, 419 (S.D.N.Y. 2002); Estate of Jenkins v. Paramount Pictures Corp., 90 F. Supp. 2d 706, 714 (E.D. Va. 2000), *aff'd*, 7 F. App'x 270 (4th Cir. 2001); *see also* Caliber Auto. Liquidators, Inc. v. Premier Chrysler, Jeep, Dodge, LLC, 605 F.3d 931, 940 (11th Cir. 2010) ("[W]e must determine whether the defendant adopted a plaintiff's mark with the intention of deriving a benefit from the plaintiff's business reputation." (internal quotation marks omitted) (quoting Frehling Enters. v. Int'l Select Group, Inc., 192 F.3d 1330, 1340 (11th Cir. 1999))).

161. *See* Stephanie Frank, Note, *Showing Your School Spirit: Why University Color Schemes and Indicia Do Not Deserve Trademark Protection*, 92 B.U. L. REV. 329, 354 (2012).

162. Bd. of Supervisors v. Smack Apparel Co., 438 F. Supp. 2d 653, 661-63 (E.D. La. 2006) (internal quotation marks omitted), *aff'd*, 550 F.3d 465 (5th Cir. 2008).

163. *Id.* at 660.

164. *See* Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 440-41 (2010).

165. Acad. of Motion Picture Arts & Sci. v. Creative House Promotions, Inc., 944 F.2d 1446,

that anyone receiving a "Star Award" would think she had joined the ranks of actual "Oscar" winners like Joan Fontaine and Spencer Tracy, or that the makers of the "Star Award" meant to fool purchasers into thinking that they were buying actual "Oscar" statuettes. The "Star Award" was shorter than the "Oscar," held a star instead of a sword, and was primarily purchased by corporate buyers as a reward for high performing salespersons.[166] The Ninth Circuit generously defined intent, however, faulting the court below for making a false distinction between an intent to "*associate* the Star Award with the Oscar" and an intent to "*confuse* purchasers."[167] Both types of intent, the Ninth Circuit explained, were probative of a finding of trademark infringement.[168]

This broad conception of probative intent is not limited to infringement actions. It is also evident in the relatively new cause of action for federal trademark dilution as well as claims of secondary infringement. Just as the Ninth Circuit adopted a generous view of intent for the likelihood of confusion analysis, the Second Circuit has been similarly generous when it comes to dilution. In *Starbucks v. Wolfe's Borough Coffee*, the Second Circuit assessed whether the court below had been too stingy in evaluating the type of intent that could justify a dilution verdict.[169] The trial court had concluded that the defendant, by labeling one variety of its coffee "Mr. Charbucks," was trying to communicate to customers only that this variety was a particularly dark roast; the indirect "Starbucks" reference was merely an efficient shorthand given Starbucks's reputation for selling abnormally dark roasted coffee. As a result, there could be no inference of bad intent.[170] In the trial court's view, this was a nonactionable attempt to use the Starbucks name to communicate something about a product's characteristics, not an attempt to hijack Starbucks's customers. The Second Circuit disagreed, holding that a mere "intent to associate" with Starbucks was enough to infer bad faith.[171]

1449, 1457 (9th Cir. 1991).

166. *Id.* at 1449-50.

167. *Id.* at 1456.

168. *Id.*

169. 588 F.3d 97, 105 (2d Cir. 2009).

170. *See* Starbucks Corp. v. Wolfe's Borough Coffee, 559 F. Supp. 2d 472, 478 (S.D.N.Y. 2008), *aff'd in part*, *vacated in part*, 588 F.3d 97 (2d Cir. 2009).

171. *Starbucks*, 588 F.3d at 109. Fixation on the intent factor can blind a court to the

Intent, broadly defined, has also taken center stage in trademark's secondary infringement doctrine. Secondary infringement allows for liability against intermediaries that do not directly infringe trademarks themselves.[172] Although secondary infringement cases often speak in the language of consequentialism and consumer welfare, their outcomes can rely on judicial assessments of the defendant's character.[173] For example, in an important case evaluating secondary trademark liability against eBay for the posting of infringing items on its auction website by third parties, the Second Circuit spent a great deal of time discussing evidence of eBay's good faith.[174] As Stacey Dogan has noted, even though it is clear that eBay provides a potent forum for infringing activity, the court's concerns were sufficiently assuaged by evidence of eBay's "status as a legitimate business concern acting in good faith."[175] Evidence of eBay's own anticounterfeiting measures went a long way to convincing the court that eBay did not mean for infringement to occur.[176] Even though these measures were clearly inadequate—the court admitted that a large percentage of goods offered under the TIFFANY mark on eBay were fakes—more important were eBay's own outlays and attitudes towards the marketplace. The court emphasized the amount of money eBay had devoted to rooting out fraud, thereby demonstrating the sort of investment that

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parodic nature of the defendant's use. Federal law explicitly exempts parodies from dilution claims. 15 U.S.C. § 1125(c)(3)(A)(ii) (2006). Nevertheless, when Hyundai aired a humorous television commercial featuring, among other examples of misplaced luxury, an image of a basketball emblazoned with a gaudy Louis Vuitton logo, a court granted summary judgment for Louis Vuitton, holding that Hyundai was guilty of diluting Louis Vuitton's mark. Louis Vuitton Malletier, S.A. v. Hyundai Motor Am., No. 10 Civ. 1611 (PKC), 2012 WL 1022247, at *1 (S.D.N.Y. Mar. 22, 2012). To justify its ruling, the court highlighted testimony from Hyundai that it was "borrowing equity" from Louis Vuitton. *Id.* at *2. In other words, the court set out to punish what it viewed as an unfair attempt to profit from the goodwill of another brand, ignoring a statutory defense because of Hyundai's perceived intent to free ride off of the Louis Vuitton brand.

172. Tiffany (NJ) Inc. v. eBay, Inc., 600 F.3d 93, 103-05 (2d Cir. 2010) (discussing the development of the doctrine of secondary liability for trademark infringement).

173. Stacey L. Dogan, *"We Know It When We See It": Intermediary Trademark Liability and the Internet*, 2011 STAN. TECH. L. REV. 7, ¶ 3 ("In the end, what matters most in these cases is whether the court believes in the defendant's essential legitimacy and good faith.").

174. *Tiffany*, 600 F.3d at 98-100.

175. Dogan, *supra* note 173, at ¶ 27.

176. *See Tiffany*, 600 F.3d at 98-100.

can help clear a defendant of liability for facilitating another's infringement.[177]

What all these analyses of intent—whether in infringement, dilution, or secondary liability—demonstrate is the continued importance of a now largely unspoken moral concern in trademark law: the belief in rewarding personal investment and punishing those who try to reap rewards from the efforts of others. The judicial focus on intent does nothing to promote consumer efficiency. Instead, the intent factor is a way for judges to justify a result when their moral intuition tells them that the defendant has violated the Fairness/Reciprocity foundation. When culpable intent is defined broadly, as an intent to profit from the brand goodwill of another, it serves as a proxy for the need for personal investment in the marketplace.[178]

C. Privileging Use of Personal Names

A trademark treatise writer in 1885 analogized participants in the American economy to knights in a medieval tournament. "Each man stands upon his own merits," he wrote, "just as a knight at a tourney has his own color to identify him with valor and high emprise."[179] In this tournament, it was important for each participant to identify himself to all other competitors. Only then would he be able to fully measure himself against others. Moreover, although

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177. *Id.* at 97-98.

178. Intent is relevant in several other areas of trademark doctrine. The "good faith" of a junior user is scrutinized to determine if the user should be allowed to continue to use its mark in areas once remote from the senior user's trade. *See, e.g.*, C.P. Interests, Inc. v. Cal. Pools, Inc., 238 F.3d 690, 692, 700 (5th Cir. 2001). In evaluating the descriptive fair use defense to infringement, courts investigate whether the defendant intended to trade on the goodwill of the mark owner. *See, e.g.*, Int'l Stamp Art, Inc. v. U.S. Postal Serv., 456 F.3d 1270, 1274-75 (11th Cir. 2006). The Lanham Act also contains a provision against cybersquat-ting, which specifically requires a court to investigate whether the domain name holder acted with a "bad faith intent to profit" from the plaintiff's mark. 15 U.S.C. § 1125(d)(1)(A)(I) (2006). Courts also investigate intent when evaluating a trademark defendant's First Amendment defense. *See, e.g.*, Anheuser-Busch, Inc. v. Balducci Publ'ns, 28 F.3d 769, 773-74 (8th Cir. 1994). Intent is perhaps more relevant in the determination of remedies than in any other area of trademark law. A finding of willful intent is required for any claim for profits in the Second Circuit and is necessary for an award of profits under the unjust enrichment theory in the Ninth Circuit. Adray v. Adry-Mart, Inc., 76 F.3d 984, 988 (9th Cir. 1996); Banff, Ltd. v. Colberts, Inc., 996 F.2d 33, 35 (2d Cir. 1993).

179. WILLIAM HENRY BROWNE, A TREATISE ON THE LAW OF TRADE-MARKS 66 (2d ed. 1898).

a medieval knight was meant to live by a self-imposed code of chivalry, the commercial cavaliers of the late nineteenth century could not be trusted to police themselves. "Piracy must be restrained by the iron grasp of justice, that laudable industry may flourish," proclaimed the treatise writer. It was for the courts to help set the ethical boundaries of this tournament and "uphold a high mercantile morality."[180]

In keeping with the idea that the marketplace was a place for self-definition and that courts had a role in encouraging this process, late nineteenth-century trademark law chose to recognize an absolute right, even in the face of consumer confusion or competitive injury, for citizens to use their own name for the purposes of trade. Names are an obvious badge of identity, the personal marker we most commonly use for self-presentation.[181] The doctrinal privileges afforded competitive use of personal names can be explained by the moral argument that it was unfair to prevent certain citizens from having the opportunity to shape themselves in economic competitive struggle.

In 1875, the New York Court of Appeals instructed that "every man has the absolute right to use his own name in his own business, even though he may thereby interfere with or injure the business of another person bearing the same name."[182] In that case, the plaintiffs' mark, "Meneely," had been in use since 1826 and had "become a designation or trade mark of great celebrity and value to the plaintiffs."[183] Use of the same name in the same type of business in the same town by another person named Meneely, however, was

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180. *Id.*; *see also* TRACHTENBERG, *supra* note 128, at 5 (maintaining that in the late 1800s, "business was still thought of as a field of personal competition, of heroic endeavor, and not of corporate manipulation").

181. Laura A. Heymann, *Naming, Identity, and Trademark Law*, 86 IND. L.J. 381, 381 (2011) ("[W]e think about names in a very personal way, as a core part of our identity."); Neal Rendleman, *False Names*, 169 W. J. MED. 318, 320 (1998) ("The name is the identifier, the badge of allegiance to family and group, and even a surrogate for identity itself.").

182. Meneely v. Meneely, 62 N.Y. 427, 431 (1875); *see also* England v. N.Y. Publ'g Co., 8 Daly 375, 377 (N.Y. Ct. Com. Pl. 1878) ("It is well settled, as a general proposition, that a person has the legal right to use his own name to designate an article produced and sold by him, although another person of the same name has previously manufactured and sold the like article with the same designation."). As one prominent treatise noted, "[I]t is the opinion of the ablest jurists that a person's name cannot be an essential element of his trade-mark; and such is the settled doctrine of the Patent Office." BROWNE, *supra* note 179, at 213.

183. *Meneely*, 62 N.Y. at 427-28.

not actionable under trademark law despite the consumer confusion produced by such use.[184]

Such a rule was not justified by prudential concerns. After all, some consumers would inevitably fail to realize that the junior user of the surname was unaffiliated with the senior user. In such circumstances, the senior user was likely to lose some potential sales and some purchasers were likely to buy from the defendant while under the impression that they were trading with the plaintiff. Rather, the privilege granted to use of personal names stemmed from an ethical argument about the accoutrements of personhood. Someone pursuing "the avocation of a lifetime in a corporation" under her own name should not be blocked by an infringement action.[185] As one leading treatise of the time explained, there was a shared belief in this country that the identity concerns bound up in the right to use one's own name in business should trump other concerns:

> The general impression is prevalent that a man's name, like his house, is particularly his own; and an Englishman or American is quick to resent any interference with such rights by the courts. The common law has taught them that every man's house is called his castle.... And his name is more dear to him than his house.[186]

The Supreme Court agreed, describing the right to use one's name in a business in the strongest of terms:

> A man's name is his own property, and he has the same right to its use and enjoyment as he has to that of any other species of property. If such use be a reasonable, honest and fair exercise of such right, he is no more liable for the incidental damage he may do a rival in trade than he would be for injury to his neighbor's property by the smoke issuing from his chimney, or for the fall of his neighbor's house by reason of necessary excavations upon

184. *Id.* at 432.

185. W.F. & John Barnes Co. v. Vandyck-Churchill Co., 207 F. 855, 859 (S.D.N.Y. 1913), *aff'd*, 213 F. 637 (2d Cir. 1914).

186. NIMS, *supra* note 69, at 125 (internal quotation marks omitted).

> his own land. These and similar instances are cases of *damnum absque injuria*.[187]

Reviewing Supreme Court precedent on this issue, the Second Circuit noted in 1905 that the Court "has reasserted and reaffirmed in clear and unequivocal language the right of every man to use his own name in all legitimate ways."[188] Thus, from the outset, trademark doctrine was structured in a way to bolster attempts to assert one's identity in the marketplace. One must have the right to use one's given name in business, even at the risk of collateral consumer damage.[189]

The absolute privilege to use one's own name in the marketplace, even if that name confused others, waned over time. As the twentieth century progressed, judges began to mention the competing concern of consumer protection when evaluating whether a defen-

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187. Brown Chem. Co. v. Meyer, 139 U.S. 540, 544 (1891).

188. Von Faber-Castell v. Faber, 139 F. 257, 258 (2d Cir. 1905).

189. Strangely enough, even though the original rationale for the personal names privilege was based on spiritual benefits for the individual, judges believed that competition's moral chastening could also apply to corporations. It was in this era that the legal system came to identify the corporation as a person, with many of the same constitutional protections as persons under U.S. law. *See* Santa Clara Cnty. v. S. Pac. R.R., 118 U.S. 394, 396 (1886). In the same period, courts evaluating trademark disputes blurred the line between corporate and personal reputation. Judges vindicated corporations seeking injunctive relief for trademark infringement not only on grounds of consumer confusion, but also in terms of a corporate right to self-definition. For example, in considering a case brought by a corporation that manufactured batteries, Judge Learned Hand described the mark YALE as "a reputation, like a face" and "the symbol of its possessor and creator." Yale Elec. Corp. v. Robertson, 26 F.2d 972, 974 (2d Cir. 1928). He went on to describe another entity's appropriation of that mark as donning "a mask," implying not only that consumers might be confused by this disguise but that the defendant was somehow disfiguring itself instead of forming a genuine identity in the marketplace. *Id.* Hand maintained that this was an injury to the corporation that the law must stop even if the defendant's use did not divert any sales or tarnish the YALE mark in any way. *Id.* Similarly, courts often described corporate trademarks as "one's commercial signature," implying the same personal attributes manifested in an individual's handwriting. *See, e.g.*, Leidersdorf v. Flint, 15 F. Cas. 260, 261 (C.C.E.D. Wis. 1878) (No. 8219); PAUL, *supra* note 70, at 5. In one case, the Supreme Court described a trademark as a corporation's "autograph," implying a personal role for the moniker selected by a business to attract customers and house its corporate goodwill. Beech-Nut Packing Co. v. P. Lorillard Co., 273 U.S. 629, 630 (1927). Treating corporations like people helped preserve the idea of an economic system that rewarded individual virtues. If a corporation was a person, then one could envision corporations as mere individuals competing on the same basic playing field as individual entrepreneurs. KUHN & BERG, *supra* note 128, at 221. And if they were equal competitors, they also needed to be able to take advantage of not just the financial rewards but the beneficial moral cleansing of the marketplace.

dant accused of infringement should be permitted to use his own name in business. Although still stressing the importance of being able to use one's own name, courts began to require defendants to take precautions to prevent confusion.[190] Many decisions required the second user of a trademarked personal name to attach disclaimers to its packaging or discontinue the use of confusing trade dress.[191] Courts continue to resolve personal name cases in the same manner today.[192]

Nevertheless, even though the courts' protection of eponymous business owners weakened after its early twentieth-century high-water mark, the privilege for personal name use still remains an important component of modern trademark law. Well into the twentieth century, courts described the ability to use one's own name in business, despite the confusing presence of an identical established trademark, as a "sacred right."[193] Through common law decision making, a "personal names rule" emerged that raises barriers on the trademarking of personal names. Under the rule, personal names cannot be inherently distinctive. In other words, the proponent of a mark based on someone's name has to prove secondary meaning in the minds of consumers before the mark can be legally recognized.[194] In effect, this results in businesses having to wait years before they can trademark a personal name and even then having to go through the costly process of documenting "an association formed in the minds of consumers between the mark and the source or origin of the product."[195] By contrast, other words or

190. *E.g.*, L.E. Waterman Co. v. Modern Pen Co., 235 U.S. 88, 94 (1914) (requiring junior user to use the disclaimer "not connected with the L.E. Waterman Co." on its packaging); *see also* Walter Baker & Co. v. Sanders, 80 F. 889, 895 (2d Cir. 1897) (granting an injunction requiring defendant to place upon its packages the words "W.H. Baker is distinct from and has no connection with the old chocolate manufactory of Walter Baker & Company").

191. *See, e.g.*, Nat'l Distillers Prods. Corp. v. K. Taylor Distilling Co., 31 F. Supp. 611, 616 (E.D. Ky. 1940).

192. *See, e.g.*, Taylor Wine Co. v. Bully Hill Vineyards, 569 F.2d 731, 735-36 (2d Cir. 1978); Gucci v. Gucci Shops, Inc., 688 F. Supp. 916, 928 (S.D.N.Y. 1988).

193. *See, e.g.*, Ida May Co. v. Ensign, 66 P.2d 727, 729 (Cal. Dist. Ct. App. 1937); Tomsky v. Clark, 238 P. 950, 952 (Cal. Dist. Ct. App. 1925); Carson v. Harris, 242 S.W.2d 777, 780 (Tex. Civ. App. 1951).

194. *See* Peaceable Planet, Inc. v. Ty, Inc., 362 F.3d 986, 989-90 (7th Cir. 2004); Brown v. Quiniou, 744 F. Supp. 463, 469 (S.D.N.Y. 1990).

195. *See* Frosty Treats, Inc. v. Sony Computer Entm't Am., Inc., 426 F.3d 1001, 1005 (8th Cir. 2005).

symbols not involving personal names are eligible for trademark protection immediately, before any evidence has developed that consumers associate the proposed mark with its proponent.[196]

Even when a company does manage to prove secondary meaning and receive trademark protection for a personal name, judges will reduce the value of any verdict of infringement against a competitor blessed with the same name, balancing the need to protect the senior user and consumers from injury with the goal of facilitating the use of personal names in business.[197] When the plaintiff wins a trademark infringement suit involving the defendant's confusing use of a personal name, only a limited injunction is granted. This limited injunction permits continued use of the name in some form along with a disclaimer.[198] By sharp contrast, a successful infringement case not involving the defendant's use of a personal name usually results in an injunction completely preventing use of the confusing term.[199] More tailored relief in the form of continuing use with a disclaimer is frowned on. In fact, in cases not involving personal names, courts express great skepticism that disclaimers can ever successfully prevent consumer confusion.[200] Hence, courts offer a half-remedy in personal names cases, one that permits more residual confusion than in the typical successful infringement action.

What is most striking is that the privilege afforded use of personal names continues at all. Any privilege for use of personal names comes at a cost for consumers. Consumers are likely to be

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196. Under modern trademark doctrine, marks that are deemed "fanciful," "arbitrary," or "suggestive" are "inherently distinctive," and can enjoy full trademark rights without a demonstration of secondary meaning. *See* Tana v. Dantanna's, 611 F.3d 767, 774 (11th Cir. 2010).

197. *See* cases cited *supra* note 194; *see also, e.g.*, Paul Frank Indus., Inc. v. Sunich, 502 F. Supp. 2d 1094, 1102 (C.D. Cal. 2007) ("Because this case involves use of Mr. Sunich's personal name, the Court must tailor an appropriate injunction so as to limit use of the Paul Frank name only to the extent necessary to avoid public confusion.") (internal quotation marks omitted).

198. 2 MCCARTHY, *supra* note 68, § 13:9.

199. *See, e.g.*, Microsoft Corp. v. McGee, 490 F. Supp. 2d 874, 883-84 (S.D. Ohio 2001).

200. *See, e.g.*, Weight Watchers Int'l, Inc. v. Luigino's, 423 F.3d 137, 143-44 (2d Cir. 2005); Home Box Office, Inc. v. Showtime/The Movie Channel, Inc., 832 F.2d 1311, 1315 (2d Cir. 1987); Ohio State Univ. v. Thomas, 738 F. Supp. 2d 743, 755 (S.D. Ohio 2010); s*ee also* Mark P. McKenna, *Back to the Future: Rediscovering Equitable Discretion in Trademark Cases*, 14 LEWIS & CLARK L. REV. 537, 544-49 (2010) (describing prevailing judicial reluctance to tailor injunctive relief in trademark suits).

confused by simultaneous use of two personal names and senior users are likely to suffer lost sales. Like the focus on intent, the personal names privilege is hard to square with the efficiency rationale for trademark protection typically voiced by modern judges. If the privilege for competitive personal name use cannot be defended in terms of consumer welfare, the real justification may lie in a belief that it would be unfair to deprive individuals of the spiritual and dignitary value of such uses.

III. MAINTAINING SEXUAL PURITY

Judges deciding trademark disputes are motivated by more than fairness concerns. Sexual usage of a trademark triggers moral judgment and leads to particular doctrinal rules. In the early twentieth century, the introduction of sexuality into new commercial environments provoked a legal backlash. Judges adjusted the law of obscenity and slander to police and promote a particular vision of womanhood. Trademark law was invoked to prevent mark uses that clashed with this chaste vision, particularly uses suggesting sex outside of marriage. Concern with sexuality in the marketplace still influences trademark decisions today. The best evidence of this is trademark dilution law's willingness to presume tarnishment from sexual uses, but not from other uses equally likely to harm mark reputation.[201]

A. Biology, History, and Sexuality

Sexually related activity is a surefire way to trigger our moral judgment.[202] In fact, when asked to describe immoral behavior, the first thoughts of many turn to intimate physical activity.[203] Our instinctive judgment of sexual activity stems from the Purity/Sanctity moral foundation. This category derives from intuitive concerns with physical and spiritual contagion. Humans developed a variety of cognitive reactions to potential illness. These

201. *See infra* Part III.B.

202. Sunstein, *supra* note 117, at 540 ("Issues at the intersection of morality and sex provide an obvious place for the use of moral heuristics.").

203. Paul Rozin et al., *Operation of the Sympathetic Magical Law of Contagion in Interpersonal Attitudes Among Americans*, 27 BULL. PSYCHONOMIC SOC. 367, 367-70 (1989).

reactions were adaptive responses designed to keep individuals safe from such threats as tainted meat and transmittable diseases. By developing feelings of disgust when viewing such threats, humans helped themselves live longer.[204] Sexual activity, because of its ability to transmit disease from one infected host to another, became an especially likely prompt for feelings of disgust—at least when signs of illness in a potential sexual partner were apparent. Because of the importance of avoiding such threats, humans developed a hair trigger response to perceived sexual impurities.[205]

In time, various cultures further emphasized the need to avoid contagion by separating the sacred from the profane and exhorting followers to live in a more ascetic, less carnal manner.[206] The result is that sexual purity, which was originally rooted in simply evading physical ailments, has become deeply moralized, causing many of us to have real feelings of moral disgust towards conduct that cannot possibly impact us or others.[207]

Historical context creates particularized sexual moral intuitions.[208] In the early 1900s, concern over sexuality weighed heavily on the minds of Americans, both elites and the middle-class. Historians describe this period as a watershed moment in the history of sexual ideology and practice in the United States.[209] Urbanization made family and local community constraints on

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204. Haidt & Joseph, *supra* note 17, at 384; Rozin et al., *supra* note 50, at 758.

205. KELLY, *supra* note 81, at 51. For example, when an object deemed unclean comes into perceived contact with another clean object, the second object is deemed unclean as well. Andrea C. Morales & Gavan J. Fitzsimons, *Product Contagion: Changing Consumer Evaluations Through Physical Contact with "Disgusting" Products*, 44 J. MKTG. RES. 272, 272 (2007). This holds true even when the two objects never actually touch and the "disgusting" object is completely sealed in packaging. *Id.* at 281. Our feelings of disgust easily transfer not just between objects, but to people coming into contact with those objects. *See* KELLY, *supra* note 81, at 19.

206. Haidt & Joseph, *supra* note 17, at 384.

207. *See* JOHN D'EMILIO & ESTELLE B. FREEDMAN, INTIMATE MATTERS: A HISTORY OF SEXUALITY IN AMERICA, at xvii-iii (3d ed. 2012) ("Sex is easily attached to other social concerns, especially those related to impurity and disorder, and it often evokes highly irrational responses."); Haidt & Joseph, *supra* note 17, at 384.

208. *See* John A. Terrizzi, Jr. et al., *Disgust: A Predictor of Social Conservatism and Prejudicial Attitudes Toward Homosexuals*, 49 PERSONALITY & INDIVIDUAL DIFFERENCES 587, 591 (2010).

209. Catherine Cocks, *Rethinking Sexuality in the Progressive Era*, 5 J. GILDED AGE & PROGRESSIVE ERA 93, 93 (2006).

sexual activity less effective.[210] Meanwhile, technological advances in advertising, manufacturing, and transportation presented new opportunities for sexual expression and activity outside of the home.[211] The result was a deep anxiety over the changing nature of sexuality, and a desire to develop new regulatory mechanisms to prevent such change.[212] In the Victorian era, the dominant view of the female role emphasized the inherent moral purity of women who were described as naturally modest and passive.[213] More frequent portrayals of female sexuality in the public sphere as well as an increased willingness to equate sex with pleasure among the working classes threatened to upend the Victorian view.[214]

These concerns translated into legal action in several ways.[215] A legally and politically sophisticated social purity movement pushed for reform of what it deemed a sexually toxic environment.[216] The movement rooted out red light districts that had been willfully ignored by authorities in the past.[217] It called for advertisements to no longer make overt appeals based on female sexuality, instead asking advertisers to focus on women's strength and moral charac-

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210. *Id.* at 116; Donna I. Dennis, *Obscenity Law and the Conditions of Freedom in the Nineteenth-Century United States*, 27 LAW & SOC. INQUIRY 369, 370-72 (2002); Melissa Murray, *Marriage as Punishment*, 112 COLUM. L. REV. 1, 18 (2012).

211. D'EMILIO & FREEDMAN, *supra* note 207, at 166, 173 (describing how the "market economy drew sexuality out of the home, including ... advertisements for conception and abortion" and migration of working class women to work in urban manufacturing zones away from their families); Murray, *supra* note 210, at 12 ("The changes wrought by industrialization expanded the opportunities for out-of-wedlock sexuality.").

212. *See* Estelle B. Freedman, *Sexuality in Nineteenth-Century America: Behavior, Ideology, and Politics*, 10 REVS. AM. HIST. 196, 203 (1982); Murray, *supra* note 210, at 27-29.

213. Brian Donovan, *Gender Inequality and Criminal Seduction: Prosecuting Sexual Coercion in the Early 20th Century*, 30 LAW & SOC. INQUIRY 61, 65 (2005).

214. *See id.* at 68-69, 83.

215. The medical profession reacted as well. Psychiatrists identified new disorders meant to link more modern sexual attitudes and behaviors with mental dysfunction. The "hypersexual female, the willfully passionate" woman, incapable of controlling her desire, required institutionalization and medical treatment. Elizabeth Lunbeck, *"A New Generation of Women": Progressive Psychiatrists and the Hypersexual Female*, 13 FEMINIST STUD. 513, 513 (1987).

216. Dennis, *supra* note 210, at 377; *see also* J. Shoshanna Ehrlich, *You Can Steal Her Virginity but Not Her Doll: The Nineteenth Century Campaign to Raise the Legal Age of Sexual Consent*, 15 CARDOZO J.L. & GENDER 229, 230-31 (2009) (describing the purity movement as being based on sexual restraint and stigmatizing all non-marital sexuality).

217. John C. Burnham, *The Progressive Era Revolution in American Attitudes Toward Sex*, 59 J. AM. HIST. 885, 901, 907-08 (1973).

ter.[218] Reformers pushed through laws in a majority of states to raise the age of sexual consent.[219] Obscenity law was invoked to attack a broad array of communications thought to degrade women, including birth control information.[220] Judges were receptive to such arguments, ignoring the free speech implications of using obscenity law to eliminate alternative visions of American womanhood.[221]

Two particular legal innovations of the time deserve mention. Concern over visible prostitution in the cities and male entreaties that could lead women to out-of-wedlock sex led to the criminalization of "seduction."[222] Women who agreed to sexual activity due to a false promise of marriage could find redress in court. Judges would pose a Hobson's choice to male defendants found to have made such a promise: either marry the plaintiff or serve time in prison.[223] The result was judicial affirmation that marriage was the only appropriate site of sexual activity and a disciplining of those, both female and male, that attempted to engage in such activity outside of the marital bed.[224]

Meanwhile, defamation law was invoked to affirm the rigid sex roles of the Victorian era. According to judges, statements that implied a lack of female chastity had ruinous consequences and could not be tolerated.[225] Affirming the view of women as naturally sexually pure while acknowledging the treacherous sexual environment women now had to navigate, the Kansas Supreme Court explained: "The world is censorious, and a woman's or a maiden's reputation for modesty and chastity is an asset of inestimable value. Its loss renders her poor indeed."[226] Dramatically restructuring

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218. Dennis, *supra* note 210, at 378.

219. Ehrlich, *supra* note 216, at 235.

220. Dennis, *supra* note 210, at 385. To the extent birth control advertising continued in this period, it had to alter its message to fit the conservative view of sexuality, touting "reliability for married women" rather than a generalized promise of sex without conception. ANDREA TONE, DEVICES AND DESIRES: A HISTORY OF CONTRACEPTIVES IN AMERICA 31 (2001).

221. Dennis, *supra* note 210, at 380. Judges did not begin applying a First Amendment analysis to obscenity decisions until almost the mid-twentieth century. *Id.*

222. Murray, *supra* note 210, at 17.

223. *Id.* at 23.

224. *Id.* at 24.

225. *See, e.g.*, Hardin v. Harshfield, 12 S.W. 779, 779 (Ky. 1890) (calling for the law of slander to be used to protect "defenseless and helpless women against false and malicious imputations, that tend to humiliate and degrade them in society").

226. Cooper v. Seaverns, 105 P. 509, 515 (Kan. 1909).

defamation law to fit this view of female sexuality, courts made statements impugning a woman's chastity per se slanderous.[227] Motivated by a desire to protect women and the family unit from the social and economic changes of the time,[228] this change to defamation law had significant cultural consequences. It reinforced the idea that without a reputation for sexual purity, a woman was nothing.[229] It also provided a legal tool for changing the discourse, driving open talk of overt female sexuality underground.[230]

In this environment, some early trademark law and related business torts decisions appear to be grounded on a particular view of sexual morality, rather than a desire to avoid consumer confusion or protect producer goodwill.[231] A military school successfully alleged "trade libel" when a group of clergymen falsely accused it of permitting intersex dancing on its grounds.[232] The Missouri Supreme Court maintained that the clergymen's accusations were "susceptible of no other fair construction than as containing an imputation upon plaintiff's morality."[233] Overt racism mixed with sexual moral concerns when another court explained that although it was not libelous to falsely contend that a corporation was unsanitary and paid its workers less than its rivals, it was per se libelous to charge that the corporation permitted a male African American to supervise white female workers.[234] The court explained that it was "the general feeling everywhere prevailing that the negro ... is not and cannot be a fit associate for white girls."[235]

A decision on unfair competition based on trade dress offers another window into the sexual anxieties of the early twentieth-

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227. *E.g.*, Gates v. N.Y. Recorder Co., 49 N.E. 769, 770 (N.Y. 1898); *see* Lisa R. Pruitt, *Her Own Good Name: Two Centuries of Talk About Chastity*, 63 MD. L. REV. 401, 406 (2004).

228. *See* Andrew J. King, *Constructing Gender: Sexual Slander in Nineteenth-Century America*, 13 LAW & HIST. REV. 63, 65-66 (1995).

229. *See* Lisa R. Pruitt, *"On the Chastity of Women All Property in the World Depends": Injury from Sexual Slander in the Nineteenth Century*, 78 IND. L.J. 965, 1016 (2003).

230. *See id.* at 1016-17.

231. *See* William E. Nelson, *Criminality and Sexual Morality in New York, 1920-1980*, 5 YALE J.L. & HUMAN. 265, 268 (1993) ("[C]ases from the 1920s and 1930s establish beyond doubt that the era was one of continuing, and perhaps even expanded, judicial enforcement of Victorian sexual norms.").

232. St. James Military Acad. v. Gaiser, 28 S.W. 851 (Mo. 1894).

233. *Id.* at 853.

234. Axton Fisher Tobacco Co. v. Evening Post Co., 183 S.W. 269, 275-77 (Ky. 1916).

235. *Id.* at 277.

century legal elite. A publisher sued its rival for unfair competition, contending that the rival had simulated its magazine in a manner likely to confuse purchasers.[236] Although the judge hearing the case acknowledged many confusing similarities—both publications used the word "stocking" in their titles, used the same size paper, had similar front covers and pictures, contained similarly themed stories and jokes, and even carried an identical advertisement[237]—he stated that "salacious stories and daring photographs ... designed to stir up jaded sex appetites ... warrant no aid from a court of equity."[238] The magazines not only concerned sex, he noted, but also suggested "sexual affairs between unmarried ... persons."[239] Most disturbing, in the court's view, was the potential effect of such publications on young women. The judge explained that "[a] prudent caution ... compelled me to place the exhibits under lock and key in order to prevent them from falling into the hands of my young daughter."[240] Despite compelling evidence of potential consumer confusion, the judge refused to hold for the plaintiff because of his desire to stifle the growth of such publications: "Only by such positive measures can we protect the minds of our growing boys and girls from this pestilence and noisome filth."[241]

B. Sexuality and Modern Trademark Law

Although trademark decisions no longer engage in the open criticism of particular sexual expressions and practices described above, trademark law still reflects moral opprobrium for sexualized depictions deemed outside of certain heterosexual norms. The most obvious modern example of judges using their moral circuitry to decide trademark disputes comes in the context of claims of mark dilution from a defendant's sexually related uses. Dilution refers to uses of a mark that, even if not confusing, would gradually whittle

236. Ultem Publ'ns v. Arrow Publ'ns Inc., 2 N.Y.S.2d 933, 933-34 (Sup. Ct. 1938).
237. *Id.* at 935, 938.
238. *Id.* at 937-38.
239. *Id.* at 934.
240. *Id.*
241. *Id.* at 937; *see also* Oren Bracha, *The Ideology of Authorship Revisited: Authors, Markets, and Liberal Values in Early American Copyright*, 118 YALE L.J. 186, 205-07 (2008) (discussing late 1800s cases denying copyright protection to sexually explicit stage shows on grounds that they lacked "substantive merit").

away or disperse the established public meaning of the mark.[242] Dilution comes in two varieties, blurring and tarnishment.[243] According to federal statute, both blurring and tarnishment occur when an association arises from the similarity between a mark and a famous mark.[244] If the association "impairs the distinctiveness of the famous mark," there is blurring;[245] if the association "harms the reputation of the famous mark," there is tarnishment.[246]

In investigating whether such a harm to reputation has occurred, courts take particular care to police unauthorized use of marks in sexual contexts. In fact, there is now a judge-made presumption of trademark dilution when a defendant uses a mark to sell sex-related products. In *V Secret Catalogue v. Moseley*, the Sixth Circuit articulated the view that tarnishment of a trademark through use in a sexual context was automatic. In the words of the court, "any new mark with a lewd or offensive-to-some sexual association raises a strong inference of tarnishment."[247]

The *Moseley* decision stands out for a few reasons. First, no presumption of tarnishment exists for any other type of use of a trademark. For other nonsexual uses, further proof of reputational harm, perhaps in the form of a consumer survey, is required.[248] For some reason, sexual uses of a famous mark cause courts to presume tarnishment when alternative uses can be just as destabilizing to an original brand's meaning. *Moseley* is the first case to make this

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242. Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 825 (1927).

243. 15 U.S.C. § 1125(c) (2006).

244. *Id.* § 1125(c)(2)(B)-(C).

245. *Id.* § 1125(c)(2)(B).

246. *Id.* § 1125(c)(2)(C).

247. V Secret Catalogue, Inc. v. Moseley, 605 F.3d 382, 389 (6th Cir. 2010).

248. *See, e.g.*, Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97, 110 (2d Cir. 2009) (faulting plaintiff for not providing survey evidence demonstrating that coffee purveyor's use of term "Charbucks Blend" harmed its reputation); N.Y. Stock Exch., Inc. v. N.Y., N.Y. Hotel, LLC, 69 F. Supp. 2d 479, 492 (S.D.N.Y. 1999) (refusing to presume that an association between the New York Stock Exchange and casino gambling would harm the Exchange's reputation), *aff'd in part*, *rev'd in part*, 293 F.3d 550 (2d Cir. 2002); Kellogg Co. v. Exxon Mobil Corp., 192 F. Supp. 2d 790, 809-10 (W.D. Tenn. 2001) (noting that courts "usually find tarnishment only in cases where a distinctive mark is depicted in an obviously degrading context, often involving a sexual activity, obscenity, or illegal activity" and concluding that the defendant's reputation for environmental pollution could not be a sound basis for a finding of tarnishment).

presumption explicit. Even before *Moseley*, however, other courts seemed to implicitly adopt this sexual double standard.

For example, in separate actions, famous toy retailer Toys "R" Us sued online sellers of lingerie and firearms for tarnishing its brand.[249] The lingerie seller identified itself as "Adults R Us";[250] the firearms seller as "Guns Are Us."[251] One court granted a preliminary injunction against the lingerie seller,[252] but the other awarded summary judgment to the gun retailer.[253] The second result is particularly puzzling. Toys "R" Us, in an effort to burnish its family-friendly image, was one of the first stores to refuse to carry toy guns, and it widely publicized this fact.[254] Given that the Toys "R" Us brand partially defined itself as antigun, it seems plausible to argue that reminding consumers of its brand while they purchase firearms would be detrimental to its brand reputation. Although one court was quick to find tarnishment from sexual use, the gun retailer escaped liability.[255]

In some ways, presuming dilution from sexual use of a trademark makes sense. If our moral sense is triggered more easily by sexual concepts, then consumers are less likely to engage in rational deliberation when evaluating a defendant's sexualized use of the plaintiff's mark. Such use could result in liability because "[t]arnishment covers cases where the defendant uses a similar mark in a way that severely clashes with the meanings that consumers associate with the plaintiff's mark."[256] Maybe, given our hardwiring when it comes to rendering judgments that touch upon sexual activity, consumers are more likely to perceive a severe clash

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249. Toys "R" Us, Inc. v. Feinberg, 26 F. Supp. 2d 639 (S.D.N.Y. 1998), *vacated on procedural grounds*, 201 F.3d 432 (2d Cir. 1999); Toys "R" Us Inc. v. Akkaoui, 40 U.S.P.Q.2d (BNA) 1836 (N.D. Cal. 1996).

250. *Akkaoui*, 40 U.S.P.Q.2d (BNA) at 1836.

251. *Feinberg*, 26 F. Supp. 2d at 641.

252. *Akkaoui*, 40 U.S.P.Q.2d (BNA) at 1836.

253. *Feinberg*, 26 F. Supp. 2d at 645.

254. *Id.* at 641.

255. *See also* Ty Inc. v. Perryman, 306 F.3d 509, 511 (7th Cir. 2002) (listing a striptease club calling itself "the Tiffany Club" as an example of dilution by tarnishment); DC Comics Inc. v. Unlimited Monkey Bus., Inc., 598 F. Supp. 110, 112-15 (N.D. Ga. 1984) (finding dilution of "Superman" and "Wonder Woman" marks by singing telegram company that used marks "Super Stud" and "Wonder Wench").

256. Robert G. Bone, *Schechter's Ideas in Historical Context and Dilution's Rocky Road*, 24 SANTA CLARA COMPUTER & HIGH TECH. L.J. 469, 473 (2008).

between the meaning of a plaintiff's mark and a sexually suggestive use of that mark by the defendant.[257]

Courts go beyond this proposition, however, and concede tarnishment on the basis of a sexually related use even when the plaintiff's mark already possesses a sexual connotation. The second thing to note about the *Moseley* decision is that Victoria's Secret, the plaintiff, already held a mark whose meaning was drenched in sex. It is one thing to argue that a defendant's sexualized use harms a brand with a nonsexual or child-friendly reputation. But it is quite another to argue a per se harm from any sexual use of a famous mark, even when that mark is already highly sexualized. The kind of harm cognized by a tarnishment claim is the clash between the meaning already held by the plaintiff's mark and the use employed by the defendant. When the plaintiff's mark is already suffused with sexual meaning, it is hard to see how a defendant's use in a sexual manner should be presumed to be tarnishing.

The *Moseley* decision resulted in a permanent injunction barring the defendant, a small retailer in the town of Elizabethtown, Kentucky, from naming its store "Victor's Secret."[258] In justifying its decision, the majority cited eight other federal cases finding tarnishment when the defendant's mark was used to sell sex-related products.[259] For some of these cases, it was readily apparent that use in a sexual context could detrimentally conflict with the popular meaning of the famous brand. Kraft, owner of the VELVEETA trademark, successfully argued tarnishment by the defendant's use of the name "VelVeeda" for a pornographic website.[260] Similarly, the owners of the POTTERY BARN mark, who, among other things, sell furnishings for children, were able to stop use of their mark on sexually oriented websites.[261] On the other hand, for some of the

257. It is by no means established, however, that sexual uses of a famous mark are more likely to be dilutive. It may be that our intuitive sensitivity to sexual matters makes us *more* capable of conceptually separating a sexualized use of a famous mark from a nonsexualized use. *See* Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 536-42 (2008) (offering reasons why dilutive uses may actually reinforce, rather than weaken, the strength of a famous mark).

258. V Secret Catalogue, Inc. v. Moseley, 605 F.3d 382, 390 (6th Cir. 2010).

259. *Id.* at 388.

260. Kraft Foods Holdings, Inc. v. Helm, 205 F. Supp. 2d 942, 949-50 (N.D. Ill. 2002).

261. Williams-Sonoma, Inc. v. Friendfinder, Inc., No. C 06-6572 JSW (MEJ), 2007 WL 4973848, at *7 (N.D. Cal. Dec. 6, 2007).

cited cases, the plaintiff alleging tarnishment through sexually related uses already held a mark with a sexual flavor. For example, it is not readily apparent to this author that a trade show exhibition featuring two models distributing condoms while perched on a VIAGRA-branded missile naturally defiles the Viagra brand.[262] Nevertheless, the judge in that matter held that such sexually themed activities automatically tarnished the Viagra name.[263]

One might argue that the dilution by tarnishment cause of action is a trademark law outlier in that it seems to openly invite moral judgment. Unlike the infringement cause of action, which necessitates an empirical examination of consumer confusion, dilution by tarnishment calls for an open-ended judicial inquiry into a mark's "reputation." In assessing whether that reputation has been harmed by the defendant's actions, judges may be naturally drawn to moral concerns.[264] Yet it is important to recognize that regardless of the moral intuition behind these decisions, to the extent they offer any justification beyond the mere language of the statute, judges choose to publicly justify themselves through the same search costs arguments employed for the rest of trademark law.

Dilution law began out of an attempt to preserve mark meaning so that established marks could continue to be relied on by consumers. The dilution concept was initiated by Professor Frank Schechter, who urged antidilution legislation to protect the valuable "uniqueness" of distinct marks.[265] Rather than appealing to moral sentiment, Schechter justified his proposal by the "rational" need to protect these unique marks so they could continue to send the same

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262. *See* Pfizer Inc. v. Sachs, 652 F. Supp. 2d 512, 525 (S.D.N.Y. 2009).

263. *Id.*; Victoria's Cyber Secret Ltd. v. V Secret Catalogue, Inc., 161 F. Supp. 2d 1339, 1354-55 (S.D. Fla. 2001) (presuming tarnishment of Victoria's Secret brand from mere registration of domain names that were to be used as adult entertainment websites)*; see also* Victoria's Secret Stores v. Artco Equip. Co., 194 F. Supp. 2d 704, 712, 729-32 (S.D. Ohio 2002) (finding dilution by tarnishment from defendant's sale of lingerie and sex toys under domain name "victoriassecrets.net").

264. *See, e.g.*, Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, 422 (S.D.N.Y. 2002) (describing tarnishment as when a famous mark "ceases to serve as a *wholesome* identifier of the owner's products" (emphasis added) (internal quotation marks omitted) (quoting Deere & Co. v. MTD Prods., Inc., 41 F.3d 39, 43 (2d Cir. 1994))). One scholar sees a parallel in protection of famous marks through the dilution by tarnishment doctrine and moral rights protections for copyrighted works. *See* Christina Bohannan, *Copyright Infringement and Harmless Speech*, 61 HASTINGS L.J. 1083, 1140 (2010).

265. Schechter, *supra* note 242, at 825.

informational signals to consumers.[266] As Rebecca Tushnet has argued, Schechter's contentions "have simply been formalized and translated into the language of law and economics" by modern courts and legal scholars.[267] Judge Posner describes tarnishment as a subset of blurring because "it reduces the distinctness of the trademark as a signifier of the trademarked product or service."[268] In other words, even if not confused by the defendant's tarnishing use of the famous mark to the point of making a mistaken purchase, consumers are no longer able to retrieve a famous mark from memory as quickly when they are also confronted with a tarnishing use. These "internal search costs" are the reason for prohibiting diluting mark uses.[269] Others have endorsed Posner's reasoning,[270] even though consumer studies cast doubt on whether dilutive, non-confusing uses of a mark actually delay the retrieval of a famous brand from memory.[271]

The important point for my analysis is that rather than admitting that they are engaging in moral judgment, some courts attempt to frame their tarnishment decisions in the predominant economic language of trademark law. For example, the *Moseley* court contended that its presumption of tarnishment was based on "an economic prediction about consumer taste."[272] Yet neither the *Moseley* court nor any of the decisions cited in the *Moseley* opinion provide evidence that an association with something sexual automatically harms the reputation of a product or service already associated with sex. Instead of being an example of systematic

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266. *See id.* Note, however, that Schechter never specifically mentioned a cause of action for "tarnishment." *See* Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 809, 857 (2010).

267. Tushnet, *supra* note 257, at 525.

268. Ty Inc. v. Perryman, 306 F.3d 509, 511 (7th Cir. 2002).

269. *Id.* at 510-12.

270. *E.g.*, MetroPCS Wireless, Inc. v. Virgin Mobile USA, L.P., No. 3:08-CV-1658-D, 2009 WL 3075205, at *14 (N.D. Tex. Sept. 25, 2009). For examples of scholarship justifying tarnishment protection in terms of consumer search costs, see Bone, *supra* note 2, at 605; Jacob Jacoby, *The Psychological Foundations of Trademark Law: Secondary Meaning, Genericism, Fame, Confusion, and Dilution*, 91 TRADEMARK REP. 1013, 1047-48 (2001); *see also* Tushnet, *supra* note 257, at 520 n.54 (collecting examples of legal scholars agreeing with Posner's search costs argument for general antidilution protection).

271. *See* Tushnet, *supra* note 257, at 527-44.

272. V Secret Catalogue, Inc. v. Moseley, 605 F.3d 382, 388 (6th Cir. 2010).

reasoning, dilution decisions reveal an instinctual desire to punish sexualized uses of another's trademark.

Even for cases not involving a dilution by tarnishment claim, judges react swiftly to sanction defendants for sexualized mark uses. Although officially deciding the case under a likelihood of confusion claim, the Second Circuit used the reasoning of dilution by tarnishment to enjoin use of the trademarked uniforms of the Dallas Cowboys Cheerleaders in a pornographic film. The court made plain just how convinced it was that the use of these uniforms would have a tarnishing effect: "[I]t is hard to believe that anyone who had seen defendants' sexually depraved film could ever thereafter disassociate it from plaintiff's cheerleaders."[273] It is unclear why the Second Circuit assumed this negative reaction towards the cheerleaders' brand from the film's viewers given that brand's meaning. Whatever the values are that consumers associate with the Cowboys Cheerleaders, chastity is not among them.[274] Moreover, in evaluating whether a defendant has infringed another's mark, a court is meant to assess whether consumers are likely to falsely infer a relationship between the defendant and the plaintiff. The language from the Second Circuit suggests an instinctive moral judgment of the defendant rather than a deliberative inquiry into consumers' likelihood to mistake one use of the cheerleader uniform for another.

Visceral reaction to sexual expression deemed transgressive can guide a trademark decision even when evidence of the expression's effects on consumers is thin at best. Consider a case involving a gay rights group's use of the name "The Pink Panther Patrol."[275] The court declined to consider a state dilution claim, instead finding for the trademark holder, MGM, on the basis of likelihood of

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273. Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 202, 205 (2d Cir. 1979).

274. *See* Pamela J. Bettis & Natalie Guice Adams, *Short Skirts and Breast Juts: Cheerleading, Eroticism and Schools*, 6 SEX EDUC. 121, 123 (2006) ("The Dallas Cowboys' Cheerleaders, with their patented hot pants and low-cut cowgirl vests and shirts, was the first such squad to make explicit the sexual element of cheerleading."); Jennifer E. Rothman, *Sex Exceptionalism in Intellectual Property*, 23 STAN. L. & POL'Y REV. 119, 131 (2012) ("[D]uring that era, if someone was going to have a sexual fantasy about cheerleaders, it likely would have centered around the Dallas Cowboys' cheerleaders.").

275. MGM-Pathe Commc'ns Co. v. Pink Panther Patrol, 774 F. Supp. 869 (S.D.N.Y. 1991).

confusion.[276] Yet the district judge's opinion, like the decision in the Dallas Cowboys Cheerleaders case, sounds in the language of dilution by tarnishment. He noted that whereas MGM's "Pink Panther" cartoon character has a "lighthearted, nonpolitical, asexual" image, the gay rights group associated the Pink Panther name "with political activism, violence, defiance, [and] homosexuality."[277] In other words, it was important that the famous mark was "asexual" whereas the defendant's use was "homosexual" and, therefore, threatened a "cheapening" of the famous mark.[278] As others have noted in discussing this case, it is by no means apparent that the gay rights group's use of "Pink Panther Patrol" would confuse consumers given the different consuming bases and marketing channels for the two marks—not to mention the sheer implausibility of MGM getting into the street patrol business in New York City.[279] Nevertheless, the court deemed the defendant's use a sexual one and, therefore, presumed damage to the MGM mark.[280]

These cases reveal a seemingly automatic willingness to presume harm from a defendant's use of sexual imagery—or, in the *MGM* case, from merely referencing sexual activity outside of dominant norms. This presumption cannot be justified on efficiency grounds. After all, even though other types of mark use may influence consumers and potentially disturb the established meaning behind a famous mark, courts are unwilling to presume harm from such nonsexual uses. Instead, this modern doctrinal trend mirrors the decisions of Progressive-era legal elites in cases involving sexual expression. Similar to the current willingness to presume tarnishment from sexual uses, early twentieth-century judges presumed slander whenever someone referenced a woman's sexual behavior. At the same time, judges mobilized the laws of seduction, obscenity, trade libel, and unfair competition to affirm a chaste vision of

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276. *Id.* at 871, 877.

277. *Id.* at 876.

278. *See id.* at 877.

279. *See* Regina Schaffer-Goldman, Note, *Cease-and-Desist: Tarnishment's Blunt Sword in Its Battle Against the Unseemly, the Unwholesome, and the Unsavory*, 20 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1241, 1267 (2010).

280. The court's willingness to presume damage from the gay rights group's "sexual" use is all the more striking given that the judge in the case, Pierre Leval, is known as a particularly thoughtful and influential intellectual property jurist. *See* Beebe, *supra* note 8, at 1627.

womanhood.[281] Although modern courts justify their dilution holdings through statutory language and reference to consumer search costs,[282] the parallel with the past suggests the influence of a similar vision of acceptable, heteronormative sexuality.

IV. PROTECTING THE NATION-STATE

Another moral intuition evident in trademark jurisprudence reflects a desire to protect and preserve certain ideas of the American nation-state. Though untethered to the goal of consumer protection, moral judgments rooted in nationalism shape trademark doctrine in important ways. First, trademark law's territoriality principle refuses to countenance those situations in which foreign uses must be acknowledged and legitimated with priority rights in the United States lest shoppers be confused. Second, when commercial actors appropriate symbols of American authority, consumer protection takes a backseat to judicial visions of the national polity. One can see the influence of two moral foundations, ingroup loyalty and respect for authority, in these areas of trademark doctrine.

A. Territoriality and National Loyalty

As mentioned in Part I, psychologists have identified moral intuitions relating to ingroup loyalty and respect for authority. Actions interpreted as disloyal to one's social group or disrespectful to a symbol of authority may be judged immoral.[283] As with the Purity/Sanctity foundation, situations activating these moral intuitions can produce strong emotional reactions. Psychologists testing subjects for such reactions note feelings of disgust when these intuitions are activated, just like those experienced when confronted with sexual behavior deemed immoral.[284] What is most striking about these areas of moral judgment is their potential

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281. *See supra* notes 215-41 and accompanying text.

282. *See supra* notes 265-74.

283. *See* Haidt & Joseph, *supra* note 17, at 372, 383-84; Haidt & Kesebir, *supra* note 38, at 822; Adrian M.S. Piper, *Higher-Order Discrimination*, *in* IDENTITY, CHARACTER, AND MORALITY: ESSAYS IN MORAL PSYCHOLOGY, *supra* note 35, at 285.

284. HAUSER, *supra* note 38, at 199; KELLY, *supra* note 81, at 145; Rozin et al., *supra* note 50, at 770.

inconsistency with other areas of moral judgment, particularly concerns over fairness and reciprocity. Humans continually discriminate against others for reasons that appear to violate other moral foundations. Some actions may be deemed moral, even if causing harm or denying justice to others, if they reflect loyalty to one's own social cohort.[285] On the other hand, performing an unpatriotic act might not actually harm an individual or trample on her rights, yet many would view such an act as immoral.[286]

Nationalist impulses are one effect of these innate preferences for members of our own social group and familiar sources of authority. Nationalism has been described as a response to modern conditions.[287] In the early twentieth century, some argued that forming a national ingroup, based on political sovereignty, was necessary to find the social cohesion needed to compete in a new economic landscape.[288] Yet there are reasons for feeling loyal to one's national ingroup apart from economic self-interest. Historians place responsibility for the Spanish-American War, and other turn of the century imperialist moves, not on national security interests but on "subjective worries about self-definition and identity."[289] As U.S. citizens in the industrial age became detached from close-knit groupings based on kin and locality, they turned to other sources for a common culture and shared sense of identity. After being disempowered by modern industrial forces, elites sought to regain their identity through talk of nationhood.[290] The nationalist spirit also found its way into the trademark doctrines created by early twentieth-century judges.

Perhaps one example of the nationalist impulse surrounding American trademark law is the territoriality principle. Under the principle, only uses of a mark in the United States can ultimately

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285. HAUSER, *supra* note 38, at 122-23. For a work demonstrating the unstated importance of victim identity to criminal law, see Joshua Kleinfeld, *A Theory of Criminal Victimization*, 65 STAN. L. REV. 1087 (2013).

286. *See* Haidt & Joseph, *supra* note 17, at 383; Piper, *supra* note 283, at 285.

287. Robert McKim & Jeff McMahan, *Introduction* to THE MORALITY OF NATIONALISM 1, 5 (Robert McKim & Jeff McMahan eds., 1997).

288. *Id.*; *see also* Bartholomew, *supra* note 18, at 16-17 (noting arguments of the time for using advertising to homogenize the tastes of immigrants).

289. FRANK NINKOVITCH, THE UNITED STATES AND IMPERIALISM 16 (2001).

290. RICHARD H. IMMERMAN, EMPIRE FOR LIBERTY: A HISTORY OF AMERICAN IMPERIALISM FROM BENJAMIN FRANKLIN TO PAUL WOLFOWITZ 146 (2012).

give rise to U.S. trademark rights.[291] Achieving trademark recognition in a foreign nation does not necessarily translate into an award of trademark rights in the United States, even if U.S. consumers are familiar with the foreign mark.[292] Hence, sales of a trademarked product manufactured in the United States but sold exclusively to customers in Canada do not constitute "use" that can trigger trademark rights under U.S. law.[293]

One can envision a contrary approach in which once a mark was deemed legally protected in one country, whether it be Spain, Surinam, or the United States, merchandise carrying that mark would be deemed lawful and non-infringing no matter where merchandise bearing that mark traveled. In fact, this view did hold sway among some trademark courts in the late nineteenth and early twentieth centuries.[294] For those courts, a "universality" principle stipulated that a trademark must only truthfully identify its original manufacturer to enjoy protection.[295] Under this view, goods lawfully made under a trademark valid in one country could be imported to the United States without infringing the rights of a domestic manufacturer employing the same mark.[296] Such behavior

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291. *See* ITC Ltd. v. Punchgini, Inc., 482 F.3d 135, 164-65 (2d Cir. 2007). The relatively recent adoption of an intent to use regime allows for U.S. trademark registrations to be issued based on the registration of the same mark by an owner who intends to use the trademark in commerce. *See* 15 U.S.C. § 1051(b) (2006). However, the applicant must ultimately use the mark in commerce in the United States or the registration will be deemed abandoned. Shelby v. Ford Motor Co., 2 U.S.P.Q.2d (BNA) 1471, 1472 n.2 (C.D. Cal. 1993), *dismissed*, 43 U.S.P.Q.2d (BNA) 1692 (C.D. Cal 1997); Graeme B. Dinwoodie, *Trademarks and Territory: Detaching Trademark Law from the Nation-State*, 41 HOUS. L. REV. 885, 909 n.86 (2004).

292. *See* Person's Co. v. Christman, 900 F.2d 1565, 1568-69 (Fed. Cir. 1990); Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha, 754 F.2d 591, 599 (5th Cir. 1985); Osawa & Co. v. B & H Photo, 589 F. Supp. 1163, 1171-72 (S.D.N.Y. 1984); 5 MCCARTHY, *supra* note 68, § 29:1.

293. *See Shelby*, 28 U.S.P.Q.2d (BNA) at 1472 n.2. Relatedly, to defeat a claim of trademark abandonment, evidence of use in the United States, not foreign uses, is required. Imperial Tobacco v. Philip Morris, Inc., 899 F.2d 1575, 1578, 1583 (Fed. Cir. 1990).

294. *See, e.g.*, Apollinaris Co. v. Scherer, 27 F. 18, 21 (C.C.S.D.N.Y. 1886); *see also* Lee Ann W. Lockridge, *Honoring International Obligations in U.S. Trademark Law: How the Lanham Act Protects Well-Known Foreign Marks (and Why the Second Circuit Was Wrong)*, 84 ST. JOHN'S L. REV. 1347, 1392 (2010) ("Universality of rights, rather than strict territoriality of rights, held sway within trademark law until the 1930s.").

295. 5 MCCARTHY, *supra* note 68, § 29:1; *see also* BLACK'S LAW DICTIONARY 1054 (8th ed. 2004) (describing "national treatment" as "universality" or the "policy or practice of a country that accords the citizens of other countries the same intellectual-property protection as it gives its own citizens, with no formal treaty of reciprocity required").

296. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 24 cmt. f (1995).

was not deemed confusing because the imports truly identified the source of the goods.[297]

Yet this approach was thoroughly rejected in favor of the rule that trademark rights, within a particular sovereignty, arise only out of their use in that particular sovereignty.[298] In some circumstances, this rule matches trademark's professed goal of reducing consumer search costs. Consider a scenario in which two businesses, one foreign and one based in the United States, use the same mark. The foreign business was the first to use the mark anywhere in the world, except in the United States, whereas the U.S. business was the first to use the mark in this country. Awarding U.S. trademark rights to the foreign brand over the domestic brand could produce confusion. If foreign uses resulted in priority rights for the foreign user in this country, the foreign user would be able to claim trademark protection even when its mark was unknown to U.S. consumers. Even worse, U.S. consumers may have already developed an association between the mark and its U.S. producer. If a court awards the foreign company priority rights in the United States, consumers might obtain goods under the foreign company's mark while thinking that the goods were affiliated with the U.S. producer. In such a scenario, applying the territoriality principle and awarding rights only to the U.S.-based producer avoids confusion and makes perfect sense under the search costs justification for trademark law espoused by modern judges.

But the territoriality principle is also applied in ways likely to cause consumer confusion, demonstrating that there is more behind the principle than a desire to preserve the ability of consumers to make efficient choices. When U.S. consumers do have prior experience with a foreign brand, an award of trademark rights to a domestic latecomer can produce confusion. It is entirely possible for U.S. consumers to recognize a mark used exclusively in a foreign jurisdiction.[299] U.S. citizens may travel to the jurisdiction and

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297. *See* Margo A. Bagley, *Using Section 337 of the Tariff Act of 1930 to Block Materially Different Gray Market Goods in the Common Control Context: Are Reports of Its Death Greatly Exaggerated?*, 44 EMORY L.J. 1541, 1546 (1995).

298. *E.g.*, Topps Co. v. Cadbury Stani S.A.I.C., 526 F.3d 63, 70 (2d Cir. 2008).

299. *See* Sarah B. Chopnick, Comment, *Search Costs and Famous Foreign Marks: Should Congress Reduce the Search Costs of the Global Consumer and Protect Famous Foreign Marks?*, 5 SETON HALL CIRCUIT REV. 213, 235-36 (2008).

become aware of the goods or services offered under the mark. Or consumers may be exposed to advertising for a marked product available just across the United States border in Canada or Mexico.[300] Recent immigrants can bring their familiarity with brand names purchased in their home country to the United States. Under each of these circumstances, U.S. residents may believe that products offered under the same mark in the United States are coming from the foreign interest rather than an unaffiliated domestic producer. In all of these scenarios, however, under the territoriality principle, the domestic producer wins trademark protection, not the foreign interest. Without some softening of the territoriality principle, some consumers will mistakenly purchase trademarked goods produced by an unknown American manufacturer while thinking that they are coming from a famous foreign business.

Nevertheless, the majority of federal courts have refused to adjust the territoriality principle to better reflect consumer interests. The predominant rule under U.S. law remains that, regardless of consumer familiarity with a foreign mark, only uses of the mark in the United States can confer priority on a mark owner.[301] Of the federal courts of appeals, only the Ninth Circuit recognizes a famous-mark exception to the territoriality principle, justifying the exception on grounds of economic efficiency.[302] As one Ninth Circuit court explained, "[a]n absolute territoriality rule without a famous-mark exception would promote consumer confusion and fraud."[303] Despite this strong language, all other federal courts, including the Second Circuit, remain unmoved.[304] One case describes the territoriality principle as "a bedrock principle of federal trademark law" that does not allow for exceptions.[305] Legal arguments about

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300. *See* Shelby v. Ford Motor Co., 28 U.S.P.Q.2d (BNA) 1471, 1472 n.2 (C.D. Cal 1993), *dismissed*, 43 U.S.P.Q. 2d (BNA) 1692 (C.D. Cal. 1997).

301. *See supra* note 291.

302. Anne Gilson LaLonde, *Don't I Know You From Somewhere?: Protection in the United States of Foreign Trademarks That Are Well Known But Not Used There*, 98 TRADEMARK REP. 1379, 1382-83 (2008).

303. Grupo Gigante SA De CV v. Dallo & Co., 391 F.3d 1088, 1094 (9th Cir. 2004).

304. *See, e.g.*, ITC Ltd. v. Punchgini, Inc., 482 F.3d 135, 165 (2d Cir. 2007); Maruti.com v. Maruti Udyog Ltd., 447 F. Supp. 2d 494, 500 (D. Md. 2006).

305. Almacenes Exito S.A. v. El Gallo Meat Market, Inc., 381 F. Supp. 2d 324, 326-27 (S.D.N.Y. 2005).

the familiarity of U.S. consumers with a foreign mark before its actual use in this country typically fall on deaf ears.[306]

The refusal of the federal courts to embrace the famous-mark exception is even more striking given its repeated adoption by legal authorities in other countries, often to the benefit of U.S. corporations. For example, when someone registered STARBUCKS in Russia before the U.S. coffee purveyor had begun to sell its wares in that country, Russian authorities agreed to cancel the registration.[307] The same thing happened when an Iranian tried to register MICKEY MOUSE in Iran.[308] A South African court recognized McDonald's Corporation's priority in such marks as BIG MAC, MCMUFFIN, and the golden arches logo even though McDonald's had not been using the marks in South Africa—thanks to an international embargo.[309] Article 6bis of the Paris Convention of the Protection of Industrial Property, of which the United States is a signatory, mandates protection of "well-known" trademarks even if those marks have not been "use[d] in commerce" in the country in question.[310]

Why do American courts remain wedded to a rule that can reduce, rather than enhance, consumer welfare? There is no doubt that refusal to legally recognize the semiotic significance of famous

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306. *E.g.*, Buti v. Impressa Perosa, S.R.L., 139 F.3d 98, 103 (2d Cir. 1998) ("Impressa's registration and use of the Fashion Cafe name in Italy has not, given the territorial nature of trademark rights, secured it any rights in the name under the Lanham Act."); La Societe Anonyme des Parfums le Galion v. Jean Patou, Inc., 495 F.2d 1265, 1270 n.4 (2d Cir. 1974) ("It is well settled that foreign use is ineffectual to create trademark rights in the United States."); Fiat Group Autos. S.P.A. v. ISM Inc., 94 U.S.P.Q.2d (BNA) 1111, 1113 (T.T.A.B. 2010); Bayer Consumer Care AG v. Belmora LLC, 90 U.S.P.Q.2d (BNA) 1587, 1589-91 (T.T.A.B. 2009) (refusing to recognize an exception to the territoriality principle for "well-known" foreign marks).

307. *See* Andrew E. Kramer, *After Long Dispute, a Russian Starbucks*, N.Y. TIMES, Sept. 7, 2007, at C3, *available at* http://www.nytimes.com/2007/09/07/business/worldbusiness/07sbux.html.

308. 5 MCCARTHY, *supra* note 68, § 22:61.

309. *McDonald's Corp. v. Joburgers Drive-Inn Restaurant (Pty) Ltd.* 1996 (1) SA 1 (A) at 3-4 (S. Afr.); Jennifer Frankel, *The Legal and Regulating Climate for Investment in Post-Apartheid South Africa: An Historical Overview*, 6, CARDOZO J. INT'L & COMP. L. 183, 190 (1998).

310. Paris Convention for the Protection of Industrial Property, art. 6bis, Mar. 20, 1883, *last revised* July 14, 1979, 21 U.S.T. 1583, 828 U.N.T.S. 305. U.S. courts have held that, although the United States is a signatory, they are not bound in matters of trademark law by the Convention. *See* ITC Ltd. v. Punchgini, Inc., 482 F.3d 135, 162 (2d Cir. 2007); L'Aiglon Apparel, Inc. v. Lana Lobell, Inc., 214 F.2d 649, 654 (3d Cir. 1954).

foreign marks increases search costs for consumers.[311] Some suggest that historical inertia may be responsible.[312] The territoriality principle first arose in an earlier time when global trade was minimal and many businesses claimed only limited geographical rights within the United States. It may simply have been beyond the imagination of early twentieth-century judges to create an exception for internationally well-known marks in simpler economic times. Even when the economy and the experiences of consumers changed, these early precedents may have proved too difficult to dislodge. But there may be something else besides traditionalism motivating such unstinting devotion to the territoriality principle. The territoriality principle invokes American nationalist sympathies. It acts to privilege domestic companies, giving them, rather than foreign competitors, control over the meaning of particular commercial signifiers. Interpreting the law to help domestic businesses may be desirable from an instrumental view, even if it reduces consumer efficiency, but it may also reflect the influence of a particular moral trigger. Strict adherence to the territoriality principle, rather than reducing search costs, favors a national ingroup against foreign outgroups. Hence, the principle may be rooted in the Ingroup/Loyalty moral intuition, rather than concern for consumer welfare.[313]

B. Respect for Symbols of National Authority

Courts also subvert efficiency goals when the trademark in question invokes a national symbol. In early twentieth-century cases, judges restricted commercial speech involving such symbols by denying trademark protection to uses they deemed undignified.

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311. Chopnick, *supra* note 299, at 236-37.

312. Mark Bartholomew & John Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*, 81 GEO. WASH. L. REV. 1, 79-82 (2013) (arguing that trademark law's statutory provisions limit its ability to recognize expression-based defenses); Dinwoodie, *supra* note 291, at 891; *cf.* Michael Grynberg, *Things Are Worse than We Think: Trademark Defenses in a "Formalist" Age*, 24 BERKELEY TECH. L.J. 897, 900-02 (2009) (maintaining that trademark law's structure has prevented it from adopting defenses to infringement responsive to changing conditions).

313. *See also* Steven Wilf, *Copyright and Social Movements in Late Nineteenth-Century America*, 12 THEORETICAL INQUIRIES L. 123, 143-44 (2011) (locating a move to stronger copyright protection in the late 1800s to "a distinctly American xenophobic set of claims" promoting a particular Anglo-American literary culture).

Legislators crafted statutory language to aid them in this process. Today, the same policing of commercial speech for threats to national authority continues. Judges interpret statutes, both old and new, to promote patriotism and punish disloyalty.

One early example of a proposed mark considered disrespectful to national authority comes from a 1909 decision of the Patent and Trademark Office. The PTO refused to register former President Grover Cleveland's signature and picture as a trademark for cigars.[314] President Cleveland had authorized the use, but the PTO explained:

> To use the names of ex-Presidents of the United States as trademarks tends to detract from the dignity of the high office which they have held, and for that reason it is believed that it is against public policy for the Patent Office to encourage such use of their names by allowing them to be registered as trade-marks.[315]

In a subsequent decision, the PTO justified its earlier decision to deny the Cleveland mark by stating it was "offensive to good taste."[316]

Similarly, in the hearings held on the bill that would become the Lanham Act, representatives expressed concern that merely prohibiting confusing uses of marks did not go far enough:

> MR. ROBERTSON. Yes. Why should the Congress of the United States, for example, permit Benjamin Harrison's name, and I am picking out an ex-President so far back so that his widow is dead, why should the Congress of the United States permit Benjamin Harrison's name to be used as a trade-mark on any article, device, or merchandise, even though dead?
>
> MR. MARONEY. In other words, we would not want to have Abraham Lincoln gin.
>
> MR. ROBERTSON. No, sir; we would not.[317]

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314. *Ex parte* Banner Cigar Mfg. Co., 1908 Dec. Comm'r Pat. 9, 10.
315. *Id.* at 10.
316. *Ex parte* Jefferson Elec. Mfg. Co., 1917 Dec. Comm'r Pat. 71, 72.
317. *Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on*

Representatives suggested adding to the new trademark statute a prohibition on the registration of "disparaging marks." Representative Robertson went on to say, however, that limiting the reach of the Lanham Act to confusing and disparaging marks was insufficient in that one could use an ex-President's name in a nonconfusing, "respectful manner," yet that kind of use should still be disallowed.[318] The result was a new trademark statute that provided judges with a means to disallow not only confusing and disparaging mark uses, but those uses they believed could bring "national symbols ... into contempt, or disrepute."[319]

In another early example, an adjudicator used this statutory language to preserve the meaning of a symbol of the American military. A company sought to register the word "Dough-boy" for a prophylactic.[320] The applicant had successfully registered the same

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Patents, 76th Cong. 18 (1939), *reprinted in* Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 1379 (Fed. Cir. 1983).

318. *Id.* at 1381.

319. Lanham Act, 15 U.S.C. § 1052(a) (2006). In addition to the prohibitions on scandalous and disparaging marks and marks that falsely suggest a connection with national symbols, Section 2 of the Lanham Act contains additional provisions designed to preserve a particular view of national identity. One provision in Section 2(a) prevents businesses from using marks that suggest a connection with the federal government. *Id.* Suggesting a connection appears to be an easier standard to meet than demonstrating a likelihood of confusion. Proposed marks struck down for this reason include a toy mailbox bearing the insignia of the U.S. Postal Service, *In re* Brumberger Co., 200 U.S.P.Q. (BNA) 475, 476-77 (T.T.A.B. 1978), a seal with the words "U.S. Customs Service," *In re* Peter S. Herrick P.A., 91 U.S.P.Q.2d (BNA) 1505, 1506, 1511 (T.T.A.B. 2009), and the word mark NATIONAL COLLECTION & CREDIT CONTROL combined with a picture of the American Eagle superimposed on a map of the United States, *In re* Nat'l Collection & Credit Control, Inc., 152 U.S.P.Q. (BNA) 200 (T.T.A.B. 1966). In addition to the language of Section 2(a), Section 2(b) also prevents certain commercial uses of national symbols. Section 2(b) imposes an absolute bar on any mark "comprising the flag or coat of arms or other insignia of the United States," although the mark must be an exact simulation of the original. § 1052(b). A separate statutory provision, which seems to be largely ignored, prohibits any use of the United States flag "for advertising purposes in any manner whatsoever." 4 U.S.C. § 8(h)(i) (2006). As Professor McCarthy points out in his treatise, almost half of the states have enacted similar provisions banning the use of the U.S. flag in advertising. 3 MCCARTHY, *supra* note 68, § 19:79. Many of these provisions were enacted at the beginning of the twentieth century. *Id.* They were given further legitimacy by a 1907 decision of the United States Supreme Court upholding the conviction, under Nebraska law, of a defendant for selling beer with an image of the U.S. flag on the bottles. Halter v. Nebraska, 205 U.S. 34, 38, 45-46 (1907). Section 2(c), which addresses marks containing the names of living individuals, §1052(c), has been used to block "Eisenhower" greeting cards and "Obama" pajamas. *See In re* Richard M. Hoefflin, 97 U.S.P.Q.2d (BNA) 1174 (T.T.A.B. 2010); *In re* Masucci, 179 U.S.P.Q. (BNA) 829 (T.T.A.B. 1973).

320. Doughboy Indus., Inc. v. Reese Chem. Co., 88 U.S.P.Q. (BNA) 227, 227 (P.T.O. 1951).

mark for prophylactics over twenty-five years before but inadvertently allowed the registration to expire and had to reapply to the Patent Office.[321] A flour manufacturer that used the term "Doughboy" for wheat flour opposed the condom maker's attempt to re-register.[322] Although the examiner initially reviewing the application concluded that the application posed no risk of confusion to purchasers of wheat flour and allowed the registration, the examiner-in-chief held the application unregisterable.[323] The examiner-in-chief found that the mark "obviously consists of or comprises matter which may disparage or falsely suggest a connection with [a national symbol] or bring [it] into contempt or disrepute."[324] He offered little argument in support of his finding, simply explaining that the applicant's use had this effect because the term "doughboy" can refer to American soldiers that served in World War I, and the applicant invoked this meaning by placing soldiers on its packaging.[325]

Modern adjudications also use trademark law to prevent changes to the preferred meaning of a national symbol. In *San Francisco Arts & Athletics v. United States Olympic Committee*, the Supreme Court decided that Congress meant to provide the U.S.O.C. the ability to stop a gay rights organization from using the term "Olympic" to promote its own athletic contest.[326] The case involved interpretation of the Amateur Sports Act, which contains a provi-

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321. *Id.*

322. *Id.*

323. *Id.*

324. *Id.* at 228 (internal quotation marks omitted).

325. *Id.* In 1993, another condom manufacturer tried to register a mark consisting of a drawing of a condom decorated with stars and stripes along with the word mark OLD GLORY CONDOM CORP. *In re* Old Glory Condom Corp., 26 U.S.P.Q.2d (BNA) 1216, 1217 (T.T.A.B. 1993). Although initially rejected by the PTO, on appeal the registration application was approved. *Id.* at 1221. The condom manufacturer managed to convince the Trademark Trial and Appeal Board that, rather than showing contempt for a national symbol as in the "Doughboy" case, its mark denoted respect for that symbol. *See id.* at 1217, 1221. The Board highlighted a statement on the Old Glory packaging that condom usage prevented AIDS. The packaging also included the sentence: "We believe it is patriotic to protect and save lives." *Id.* at 1217. Ultimately, the Board concluded that fusing the image of the flag with a condom, in this particular instance, was not working harm on the flag. The packaging's references to patriotism and eliminating AIDS bespoke "a seriousness of purpose" that neutralized the charge that the mark would disparage or bring a national symbol into contempt. *Id.* at 1221 & n.4.

326. 483 U.S. 522, 525, 527-28 (1987).

sion prohibiting use of the word "Olympic" without the U.S.O.C.'s consent.[327] The Court credited the U.S.O.C.'s argument that Congress meant to block unauthorized uses of the term "Olympic" regardless of whether such uses would confuse consumers.[328] The Court also determined that the statute did not violate the First Amendment as it represented a reasonable effort to achieve Congress's policy goals.[329]

Although there were several components to the Court's decision, including statutory construction and evaluation of a Fifth Amendment claim,[330] respect for a symbol of nationhood also played a role. Rather than focusing on the statute's effect on consumers, the Court highlighted the U.S.O.C.'s role in articulating the symbolic values of the United States. The majority justified its decision by explaining that the U.S.O.C.'s monopoly on the word "Olympic" furthered the organization's stated objectives, including "establish[ing] national goals for amateur athletic activities," exercising exclusive jurisdiction over U.S. participation in the Olympic Games, and promoting U.S. involvement in athletic events with other nations.[331] As Justice Brennan pointed out in his dissent, these objectives demonstrate that the U.S.O.C.'s role is to serve as a national symbol. "Although the Olympic ideals are avowedly nonpolitical," he explained, "Olympic participation is inescapably nationalist."[332] Brennan maintained that the national symbolism inherent in the activities of the U.S.O.C. and the word "Olympic" meant that the U.S.O.C. was a state actor and that the statute was an unconstitutional prohibition of noncommercial speech.[333]

The majority conveniently deemed the Act a regulation of commercial speech and, therefore, less of a threat to free expression.[334] But the majority's real disagreement with the dissent was not on the distinction between commercial and noncommercial expression. The majority simply placed more importance on using the law to protect this particular version of national symbolism. It

327. *Id.* at 524; *see also* 36 U.S.C. § 220506(a)(4) (2006).
328. *S.F. Arts & Athletics*, 483 U.S. at 532-35.
329. *Id.* at 536-41.
330. *Id.* at 528-30, 542-47.
331. *Id.* at 534-39 n.17.
332. *Id.* at 550 (Brennan, J., dissenting).
333. *Id.* at 548-56.
334. *Id.* at 524, 535-37, 540.

explained that much of the value of the word "Olympic" came from its limited use.[335] In oral argument, one justice posited that it was acceptable to prevent other businesses from using "Olympic" as a point of comparison with the Olympic Games because of the dilutive potential of such activities.[336] For the majority, the importance of preserving the meaning of a particular national symbol won out over other concerns.[337]

San Francisco Arts & Athletics strongly influenced the Court as it recently grappled with legal protection for another kind of national symbol—military decorations.[338] The Court had to decide whether a federal statute making it a crime to falsely claim receipt of such medals, including the Congressional Medal of Honor, violated the First Amendment.[339] Although a majority held the statute invalid under the First Amendment,[340] five of the nine justices appeared convinced that false claims regarding the medals worked a serious harm by diminishing their symbolic value.[341] The language of trademark dilution featured heavily in their arguments. Multiple justices cited *San Francisco Arts & Athletics* as a valid example of using the law to prevent a lessening of the distinctive meaning of a cherished term.[342] Justice Alito compared the effects of knock-off goods on luxury brands to how "the proliferation of false

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335. *Id.* at 539.

336. Transcript of Oral Argument at 22, S.F. Arts & Athletics, Inc. v. United States Olympic Committtee, 483 U.S. 522 (1987) (No. 86-270), 1987 U.S. Trans. LEXIS 57, at *9.

337. *S.F. Arts & Athletics*, 483 U.S. at 534, 548. Fairness/Reciprocity concerns also appeared to influence the Court as it noted the U.S.O.C.'s efforts to create its own meaning for the word "Olympic." In oral argument, Justice Scalia emphasized that the U.S.O.C. was responsible for giving "Olympic" its current valence in national discourse and, accordingly, was entitled to exercise plenary control to preserve that valence. *See* Transcript of Oral Argument, *supra* note 336, at *11. Following this logic, the majority opinion explained that because the U.S.O.C. had built up the word "Olympic" through its own efforts, a Congressional award of complete rights over the word fell within traditional trademark law protections and "constitutional bounds." *SFAA*, 483 U.S. at 534-35. The Purity/Sanctity trigger may have also had a role given the homophobia evident in another of the Court's decisions in the same timeframe. *See* Bowers v. Hardwick, 478 U.S. 186 (1986).

338. United States v. Alvarez, 132 S. Ct. 2537 (2012).

339. *Id.* at 2542.

340. *Id.* at 2551.

341. *Id.* at 2555 (Breyer, J., concurring with Justice Kagan) ("To permit those who have not earned those honors to claim otherwise dilutes the value of the awards."); *id.* at 2559 (Alito, J., dissenting with Justices Scalia and Thomas) (describing the "diluting effect" of false claims).

342. *Id.* at 2554-56 (Breyer, J., concurring); *id.* at 2559 (Alito, J., dissenting).

claims about military awards blurs the signal given out by the actual awards by making them seem more common than they really are."[343] Justice Breyer described trademark laws as "the closest analogy" to the statute at issue.[344] It appears that Congress may pass another law prohibiting speech regarding military decorations, this time more narrowly defining the contexts in which it would apply.[345] If so, the Court signaled that it is likely that such a law would pass its review.[346]

Prohibitions on Abraham Lincoln gin, Doughboy condoms, and unauthorized use of the word "Olympic" do nothing to help consumers navigate the marketplace. In fact, truly offensive trademarks or trademarks invoking national symbols can stand out of the informational clutter and serve as an efficient shorthand for consumers.[347] Hence, one cannot justify these decisions under the economic analysis typically touted as trademark law's raison d'etre. Instead, courts sometimes invoke trademark law to maintain the dignity of particular symbols that, although not directly representing the federal government, may be viewed as important markers of American identity.[348]

V. FINDING A BETTER ROLE FOR MORAL ARGUMENTS IN TRADEMARK LAW

So far my approach has been descriptive, merely cataloging and characterizing some of the moral judgments that developed in early

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343. *Id.* at 2559 (Alito, J., dissenting).

344. *Id.* at 2554 (Breyer, J., concurring).

345. Chris Carroll, *Supreme Court Strikes Down Stolen Valor Act*, STARS AND STRIPES (Jun. 28, 2012), www.stripes.com/news/supreme-court-strikes-down-stolen-valor-act-1.181587 (discussing new legislation in Congress adding a "material gain" component to the criminal prohibition on false claims of military decoration).

346. *See Alvarez*, 132 S. Ct. at 2547 (faulting the original statute for its "sweeping, quite unprecedented reach" that "would apply with equal force to personal, whispered conversations within a home").

347. *See, e.g.*, Davide Dukcevich, *Hooters Is Grounded for Now*, FORBES (Sept. 27, 2002, 1:50 PM), http://forbes.com/2002/09/27/0927hooters.html (describing the success of the "Hooters" brand); Press Release, U.S. Patent & Trademark Office, In Remembrance of Our Nation's Heroes (Nov. 9, 2001), *available at* http://www.uspto.gov/news/pr/2001/01-51.jsp (noting the effectiveness of the Army's "Be All You Can Be" federally registered motto).

348. Of course, Congress may be engaging in its own moral decision making when it passes statutes relevant to national symbols, which courts are subsequently required to apply and interpret.

twentieth-century trademark jurisprudence and remain largely in place. In this final Part, I offer some thoughts on the problems with using such judgments to render legal decisions as well as some suggestions on how to make their inevitable use less problematic.

As I have indicated throughout this Article, the trademark doctrines shaped by moral intuition—the focus on intent,[349] the personal names privilege,[350] presumption of tarnishment from use of a mark to sell sex-related goods,[351] rigid application of the territoriality principle[352]—produce inefficiencies for consumers. Even though their proponents justify them in terms of the prevailing search costs model, there is little doubt that these rules make the commercial world harder, not easier, for consumers to navigate. But the negative effects of these rules are not limited to increased search costs. They are also problematic from other perspectives.

One problem with judicial use of moral intuition is that it can prevent the law from adapting to new technological or social circumstances.[353] By and large, our moral intuitions are conservative.[354] The foundations at the heart of moral judgment have been hardwired into our brains over centuries of evolutionary struggle.[355] This encourages us to act on our moral impulses in ways that may not be advantageous when modern realities are considered. We recoil in disgust at certain behaviors thanks more to the survival struggles of our progenitors than a real need to protect ourselves in the more sanitary and regulated environment of the twenty-first

349. *See supra* Part II.B.

350. *See supra* Part II.C.

351. *See supra* Part III.B.

352. *See supra* Part IV.A.

353. Moral arguments are not the only conservative technique of legal argument, however. Arguments in favor of doctrinal consistency can also retard legal change. Legal innovation and adaptation are largely impossible if a judge feels completely duty-bound to follow every prior holding. *See* Jeff A. King, *Institutional Approaches to Judicial Restraint*, 28 OXFORD J. LEGAL STUD. 409, 414 (2008) (explaining that stare decisis, along with a belief in rational objectivity, tends to create "conservative inertia in the law"). Similarly, historical arguments may neglect new social forces that argue for a revised conception of the law's practical effects. The same may be true of rigid adherence to the specific text of statutory provisions.

354. I use "conservative" here to imply a generalized sense of caution and resistance to change, not for its political meaning. Politically speaking, both liberals and conservatives routinely engage in moral decision making. *See generally* HAIDT, *supra* note 77.

355. Steven Pinker, *The Moral Instinct*, N.Y. TIMES (Jan. 13, 2008), http://www.nytimes.com/2008/01/13/magazine/13Psychology-t.html.

century.[356] Morals can and do change, but this can be a slow process.[357] Even when our moral foundations narrow into a particular cultural focus, they may still be rooted in historical anachronism.

For example, the refusal to recognize exceptions to the territoriality principle reflects a time in the economic past when consumer knowledge of particular goods and their manufacturers depended on a physical presence within national borders. Revolutions in transportation and communications technologies now allow us to be familiar with brands produced and sold halfway around the world. Political change has also rendered the territoriality principle less coherent. In a globalized world, which increasingly relies on both multi-national sources of authority and private ordering, the principle appears increasingly outdated.[358]

Similarly, the personal names privilege reflects a perspective on the marketplace that now seems antiquated. In the early twentieth century, a trademark often reflected an individual's personal participation in the marketplace. The marks of the Wright Company—named for aviation pioneers Orville and Wilbur Wright—and the Ford Motor Company told stories of individual initiative and perseverance as well as serving as signifiers of product origin. In a postmodern world, however, we no longer necessarily expect brands to identify the actual manufacturer of an item. Instead, the brand supplies a marker of consistency and quality, whereas the actual provider of the product remains anonymous. Modern trademarks are artificial, corporate choices. They do not organically arise from an individual's efforts in the marketplace. Rather, they are focus grouped and tested before they ever hit store shelves. Consumers do not know and do not care that HUGGIES diapers are made by the Kimberly-Clarke Corporation. To be sure, trademarks still have semiotic significance for consumers and some popular brand names are personal names. Generally

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356. *See, e.g.*, Gorman, *supra* note 50, at D4.

357. *See* K C Calman, *Evolutionary Ethics: Can Values Change*, 30 J. MED. ETHICS 366, 366-68 (2004) (describing the changing moral conceptions of various medical topics from "primitive societies to the present").

358. 5 MCCARTHY, *supra* note 68, § 29:1 (noting criticisms of the territoriality principle "in a world market where information products like computer programs cannot be located at a particular spot on the globe").

speaking, however, the branding culture has shifted, become more artificial, and consumers no longer expect these marketplace signposts to reflect a connection with a particular individual.[359] There may be less sense in privileging the use of personal names in this pseudonymous environment.[360]

Another problem with moral intuition, particularly when invoked by legal elites, is that it can operate as a proxy for locking in the preferences of favored groups.[361] Morality is a malleable concept and is, therefore, susceptible to manipulation. For example, early twentieth-century business law relied on ethical appeals to protect vested interests. Thanks in part to moral concerns, the law of fraud, privacy, and interference with contract were construed in a way to cement the current distribution of wealth in favor of white, Anglo-Saxon Protestants.[362]

Similar charges might be levied against particular provisions of modern trademark law.[363] Many of the doctrines discussed in this Article have been invoked to privilege elite commercial actors and to discourage the expressive activities of non-elites. The presumption of tarnishment for sex-related uses of a famous mark blocks sexual expression involving trademarks that are avant-garde or outside the mainstream. Cases finding tarnishment—even if described in the language of consumer confusion—disproportionately impact those outside of heterosexual and middle-class norms. It is no accident that gay rights organizations, small-town commercial actors, and low-budget filmmakers have been on the wrong end of the tarnishment presumption.

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359. Jessica Silbey, *The Mythical Beginnings of Intellectual Property*, 15 GEO. MASON L. REV. 319, 359-60 (2008).

360. *See* Laura A. Heymann, *The Birth of the Authornym: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377, 1379-80 (2005).

361. Although different, ethical arguments have been linked to the trend favoring "originalism," an interpretative theory that asks judges to look primarily to the original understandings of a legal provision's ratifying generation. *See* Jamal Greene, *The Case for Original Intent*, 80 GEO. WASH. L. REV. 1683, 1697-98 (2012).

362. *See* William E. Nelson, *From Morality to Equality: Judicial Regulation of Business Ethics in New York, 1920-1980*, 43 N.Y. L. SCH. L. REV. 223, 227-28 (1999).

363. *See, e.g.*, Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(A) Trademark Law After* Lawrence v. Texas, 9 MARQ. INTELL. PROP. L. REV. 187, 223 (2005) (critiquing use of trademark law to reject registration of "queer marks").

Relatedly, by expansively defining probative intent, judges protect established brands at the expense of young upstarts. By and large, the judicial focus on intent helps only trademark plaintiffs. Although a finding of bad intent dooms accused defendants, the absence of wrongful intent does not typically exonerate them.[364] As a result, even if they lack evidence of the defendant's intent before filing suit, trademark holders are incentivized to file and commit the defendant to expensive discovery proceedings in the hopes that such evidence will appear.[365] In many situations, defendants may capitulate rather than sink resources into an unpredictable process.[366] Hence, moral intuition can translate into doctrine that is self-serving for those already in power.

Given the above, it would probably be better if moral decision making had no influence on trademark law.[367] Not only are the doctrines spawned by moral concerns inefficient, but they appear ill-tailored to modern marketplace realities and highly biased in favor of commercial and cultural elites. Unfortunately, purging moral considerations from judicial decisions is no more likely than eliminating them from our own thought process. As described earlier, much of the cognitive background for our moral judgments is not accessible to us. Moral decision making can operate at an instinctual, even subconscious level.[368] Hence, urging judges to simply ignore their inner moral voices is unlikely to succeed.

This is not to say, however, that the quality of judicial decision making involving moral intuition cannot be improved. Not all of our moral reasoning goes on behind closed doors. As the analysis of early twentieth-century case law throughout this Article demonstrates, judges can and have marshaled explicit moral arguments in favor of their decisions. When judges transparently announce the influence of moral considerations in their decision making, they

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364. *See, e.g.*, GoTo.com, Inc. v. Walt Disney Co., 202 F.3d 1199, 1208 (9th Cir. 2000); Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Cntr., 109 F.3d 275, 287 (6th Cir. 1997).

365. Casagrande, *supra* note 139, at 1470.

366. *See id.* at 1470-71; William McGeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 61-66 (2008).

367. Moral reasoning does not inevitably lead to bad results, however. As Dave Fagundes pointed out to me, moral concerns likely had a role in the Supreme Court's unanimous decision in *Brown v. Board of Education*, 437 U.S. 483 (1984), to good, history-changing effect.

368. *See supra* Part I.

subject those considerations to potential criticism, whether from appellate bodies, lawyers appearing before them, or the general public. In this way, moral appeals can be tested and screened for flaws in a collective fashion. Moreover, just being aware of the potential influence of moral intuition can steer decision makers toward a different way of thinking. Research demonstrates that greater mindfulness can channel our decision-making process into a more systematic mode and thereby limit the influence of hidden biases.[369] In other contexts, increased attention to potential prejudices has brought latent moral reasoning to the surface and improved decisional outcomes.[370]

So the goal should not be to completely excise moral concerns from trademark law but to bring them to the surface and subject them to further interrogation, just like any other technique of legal argument. To some degree, this has already been done in the field of constitutional law. Constitutional law scholar Philip Bobbitt has made the case for increased use of moral arguments in constitutional decision making, but only when fashioned with two particular limits in mind. Encouraging the use of moral arguments with similar limitations also makes sense for trademark law.

First, according to Bobbitt, in justifying a particular legal outcome, only those moral arguments that explicitly rely on a collective sense of right and wrong should survive scrutiny.[371] He explains that moral arguments derive their legitimacy from consistency with the moral understandings of the larger American society.[372] As a result, moral appeals out of step with the larger society should be rejected by courts in review.[373] Only those moral arguments that attempt to articulate the collective moral sense of the polity, not the individualized morality of the judge, should be

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369. *See* KAHNEMAN, *supra* note 41, at 417-18; Evan R. Seamone, *Judicial Mindfulness*, 70 U. CIN. L. REV. 1023, 1102-03 (2002).

370. *See* William T. Bielby, *Minimizing Workplace Gender and Racial Bias*, 29 CONTEMP. SOC. 120, 124-25 (2000); *see also* Jerry Kang et al., *Implicit Bias in the Courtroom*, 59 UCLA L. REV. 1124, 1169-79 (2012) (listing strategies for decreasing implicit judicial bias).

371. *See* BOBBITT, *supra* note 59, at 94.

372. *See id.* at 211.

373. *See id.*; *see also* Richard S. Markovitz, *Legitimate Legal Argument and Internally-Right Answers to Legal-Rights Questions*, 74 CHI.-KENT L. REV. 415, 427 (1999) ("To be legitimate, the use of a particular type of legal argument must be consistent with the moral commitments of the culture in which it is made.").

legally credible.[374] For particular issues on which no national moral consensus has been reached, the moral argument will not be available and judges will have to rely on the other techniques of legal decision making in their arsenal.

For example, one potential reason for rejecting a moral argument in favor of the presumption of tarnishment from sexually related mark uses is that it is out of step with the sexual mores of large swaths of the population.[375] The judge in the Pink Panther case seemed willing to presume harm to the plaintiff's mark based on an instinctive reaction to homosexuality.[376] Yet a majority of Americans currently support same sex marriage.[377] If a large segment of the buying population would not view a sexual commercial representation as taboo, then judges should not be able to make a moral appeal for the banning of such a representation. Of course, it is difficult to accurately take the moral temperature of the general population on all matters. Different media sources might arrive at very different accounts of American ethics—think MSNBC versus Fox News. Moreover, not every moral argument is susceptible to polling or other types of evidence that one could use to document generalized attitudes. Moral arguments will always be difficult to prove and, like other techniques of legal argument, susceptible to judicial bias. But following Bobbitt's prescription will at least keep legal decision makers on the alert for the influence of their own individual prejudices.

Second, moral arguments are meant to complement other modes of legal argument, not crowd them out. Those opposed to any judicial use of moral arguments maintain that their gravitational pull is simply too powerful and will cause judges to ignore the analytical force of other, more neutral methods of legal reasoning.[378]

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374. Efforts to "press a particular vision of the national ethos" that is out of step with the larger populace may also lead to political reprisal. Robert Post, *Democracy, Popular Sovereignty, and Judicial Review*, 86 CALIF. L. REV. 429, 441-42 (1998).

375. *See* M. Christopher Bolen et al., *When Scandal Becomes Vogue: The Registrability of Sexual References in Trademarks and Protection of Trademarks from Tarnishment in Sexual Contexts*, 39 IDEA 435, 471 (1999) (noting that courts had not adjusted their standards for trademark tarnishment in keeping with more generally sexually liberated mores).

376. *See supra* notes 275-80 and accompanying text.

377. *See CNN Poll: Americans' Attitudes Toward Gay Community Changing*, CNN (June 6, 2012, 5:00 AM), http://politicalticker.blogs.cnn.com/2012/06/06/cnn-poll-americans-attitudes-toward-gay-community-changing/.

378. *See* Richard H. Fallon, Jr., *A Constructivist Coherence Theory of Constitutional*

But one check on the ability of such arguments to stampede decision making is that moral appeals must be backed up with appeals to text, history, and public policy. Moral argument is not meant to displace other argumentative techniques; it is meant only to supplement them. According to Bobbitt, "no sane judge or law professor can be committed solely to one approach."[379] An opinion nakedly based on moral sentiments and nothing else would be completely unpersuasive under our common law tradition. Hence, rather than employing a hidden moral heuristic that is papered over with other techniques of legal argument, judges committed to a particular outcome or rule should make their moral arguments transparently, alongside historical, textual, and doctrinal arguments. This is already done to some extent in constitutional law when judges combine arguments as to precedent, governmental structure, and public policy along with their sense of the national ethos.[380]

The same should be attempted in trademark law. In addition to perhaps improving the results of judicial decision making, a more transparent approach to moral argument could provide citizens with greater knowledge and understanding of the legal process. As Thomas Merrill and Henry Smith write with regard to property rights, "[r]ights to exclude others from a thing must be grounded in robust moral notions that are easy to communicate and shared by the relevant members of the population."[381] Merrill and Smith give the example of trespass to land, which eschews discussions of "efficient breach" or internalizing costs through liability rules in favor of strict prohibitions that are often phrased in deontological terms.[382] By issuing a sharp condemnation of this type of property right violation, the law of trespass works as a sort of judicial megaphone that encourages respect for real property even when actual legal prosecution may be unlikely or the costs to the land-

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Interpretation, 100 HARV. L. REV. 1189, 1246-48 (1987).

379. BOBBITT, *supra* note 59, at 124.

380. *See* Jack M. Balkin, *Nine Perspectives on* Living Originalism, 2012 U. ILL. L. REV. 815, 824; James E. Fleming, *Living Originalism and Living Constitutionalism as Moral Readings of the American Constitution*, 92 B.U. L. REV. 1171, 1185 (2012); Andrew Koppelman, *Bad News for Everybody: Lawson and Kopel on Health Care Reform and Originalism*, 121 YALE L.J. ONLINE 515, 524 (2012).

381. Merrill & Smith, *supra* note 17, at 1855.

382. *Id.* at 1873-74.

owner may be minimal or uncertain. Trademark jurisprudence appears to make some similar moves by creating distinct biases in favor of domestic users of a particular contested mark and defendants using their own names in business. As noted earlier, these doctrines are problematic. But perhaps by subjecting their antecedent moral reasoning to the full scrutiny of other judges as well as the general public, new, more defensible, and perhaps morally intuitive, rules for navigating the American marketplace will emerge.

CONCLUSION

The moral responses to a new consumer society, which were developed at the turn of the nineteenth century, continue to animate twenty-first century trademark doctrine. Although mostly obscured behind the consumer efficiency rationale that dominates current trademark jurisprudence, moral judgments form another critical, yet largely overlooked, component of judicial reasoning in this area. Today's trademark doctrine privileges personal investment in the marketplace through the personal names rule and emphasis on intent in infringement, dilution, and secondary liability analyses. Tarnishment cases appear inconsistent until one considers the influence of moral sentiment in determining the reputational effects of sexual use of a plaintiff's mark. The territoriality principle as well as judicial interpretation of the Lanham Act's statutory bars to registration reveal a nationalist impulse in trademark law. These rules and interpretations may make little sense when compared to the utilitarian rhetoric of modern trademark law, but that is somewhat beside the point. Instead, these doctrinal moves are animated by moral judgments that have been shaping trademark law for over one hundred years.