

A Fistful of Lawsuits: The Press, the First Amendment, and Section 43(a) of the Lanham Act

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Stymied by constitutional hurdles designed to advance public discourse, plaintiffs suing media defendants based on editorial content have attempted various maneuvers to sidestep these obstacles. One approach is to avoid the more defendant-friendly defamation claim and opt for a claim under section 43(a) of the Lanham Act. This Comment argues that such an approach disregards both the First Amendment's goal of promoting the free exchange of ideas and section 43(a)'s goal of reducing consumer confusion rather than protecting plaintiffs' reputations. The author suggests that courts should interpret section 43(a) narrowly and allow Lanham Act claims for false advertising or false endorsement only when the speech is commercial. Editorial content neither amounts to advertising nor risks consumer confusion over endorsement of the publication. It should not give rise to a Lanham Act claim.

INTRODUCTION

Standing in a grocery store checkout line in late December 1993, you may have glanced over to the racks of tabloid newspapers and noticed, beyond the stories of pop stars battling drug abuse or the end to some Hollywood phenomenon's rocky relationship, the *National Enquirer's* "Exclusive Interview" with Clint Eastwood, complete with an "Exclusive Photo." Or you may not have noticed it at all.

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Clint Eastwood's lawyers did. They hit the *Enquirer* with a lawsuit claiming harm to Eastwood's reputation.¹ Eastwood could not prevail on traditional libel grounds because he could not prove by clear and convincing evidence that the *Enquirer* had published the interview knowing that the interview was false.² Fortunately for the actor, the Federal Lanham Act made his day; the Ninth Circuit found that the misdesignation of the non-exclusive interview as "exclusive" was willful and therefore satisfied the actual malice standard, allowing him to prevail on his claim.³

Section 43(a) of the Lanham Act aims to reduce consumer confusion by prohibiting false endorsement and false advertising.⁴ Allowing Eastwood and other plaintiffs to use the statute to pursue claims against media defendants arising out of news coverage and editorial content circumvents the First Amendment and its goal of promoting the free exchange of ideas and information. To stave off this attack on constitutional protections, courts should narrowly interpret section 43(a) of the Lanham Act to allow claims for infringement only when the speech is commercial. Courts should scrutinize Lanham Act claims brought against the media to see whether they involve commercial speech or noncommercial speech. If they involve commercial speech, the suit should continue. If they involve noncommercial speech, the suit should be barred. Since news is neither advertising nor endorsement, and thus constitutes noncommercial speech, claims based on news content would clearly fall outside the scope of section 43(a).

Part I of this Comment delves into section 43(a) of the Lanham Act. It introduces the interests at stake in trademark law, and addresses section 43(a)'s goal of protecting consumers and business competitors from deception and misrepresentation involving the sale of goods and services. To achieve this goal, the statute creates causes of action for false endorsement and false advertising. Part I also introduces the conflict between the First Amendment and trademark law. It then runs through the elements of a section 43(a) claim, reviews the congressional rift over the constitutionally permissible scope of the section, and examines some of the instances in which section 43(a) has been applied to the mass media and has raised First Amendment concerns. After introducing the interests and elements in trademark law, Part I reviews the force behind First Amendment

1. See *Eastwood v. National Enquirer, Inc.*, 123 F.3d 1249 (9th Cir. 1997). Eastwood had, in fact, never granted the *Enquirer* an interview. See *infra* Part III.B.

2. See *id.* at 1255. Under *New York Times v. Sullivan*, 376 U.S. 254 (1964), and its progeny, a public official or public figure may only recover in a libel suit by proving the defendant made the defamatory statement with actual malice, that is, "with knowledge that it was false or with reckless disregard of whether it was false or not." *Id.* at 280.

3. See *Eastwood*, 123 F.3d at 1256.

4. See *Allen v. National Video, Inc.*, 610 F. Supp. 612, 625-26 (S.D.N.Y. 1985).

jurisprudence—assuring the free exchange of ideas in a vibrant public discourse—and discusses how the Court has treated the press in its decisions.

Part II focuses on how First Amendment considerations that pervade defamation rulings carry over into copyright and trademark law. It first uses the Court's approach to defamation, where the constitutional balance has already been struck between the public's interest in a free exchange of ideas and the private interest in reputation, as a window on the application of First Amendment arguments involving the press and public discourse. Part II also details what plaintiffs gain—a less demanding burden of persuasion, a more flexible statute of limitations, and a broader array of remedies, including injunctions and treble damages—by relying on section 43(a) of the Lanham Act rather than on alternatives, such as defamation law, that provide stronger constitutional protections for defendants.

Part II also provides another baseline from which to compare trademark law's interaction with the First Amendment. It considers the perpetization of information in another intellectual property context, copyright law. This Part focuses on the property interests at stake in copyright law, compares them to the interests at stake in the Lanham Act, and reviews how copyright has tried to accommodate First Amendment considerations.

Part III provides two reasons—(1) the noncommercial nature of the editorial content of newspapers and other media communications, and (2) the negligible risk of readers equating publication of an article about a plaintiff with endorsement by that plaintiff—why section 43(a) should not apply to claims based on nonadvertising news content in the mass media.

Part IV then offers suggestions on how courts can give greater weight to First Amendment protections for news accounts and prevent section 43(a) of the Lanham Act from being used to undercut the safeguards for free speech and a free press that have developed elsewhere. It concludes that courts should bar section 43(a) claims against media defendants for everything but strictly commercial speech. News content should not give rise to a section 43(a) claim.

I

THE COMPETING INTERESTS BEHIND THE LANHAM ACT AND THE FIRST AMENDMENT

Wielding the Lanham Act as a club against news media defendants without regard to First Amendment values puts those values at risk. To illustrate how this risk arises, this Part introduces the interests protected by the Lanham Act and the elements of a claim under section 43(a) alongside the rationales behind First Amendment protection for the press.

A. Section 43(a) of the Lanham Act⁵

1. Purpose of the Lanham Act and the Interests at Stake in Trademark Law

The Lanham Act, a post-*Erie*⁶ effort to codify the federal law of trademarks and unfair competition, is designed to protect consumers and business competitors from deception and misrepresentation of products and services in commerce.⁷ Rooted in the tort of fraud, trademark claims hinge on a false representation in the sale of goods and services.⁸

Trademark law aims to protect the buying public from confusion.⁹ The protection in trademark law is for the customer, not the trademark holder. For this reason, trademark law grants only a narrowly defined property right to trademark holders.¹⁰ As Professor J. Thomas McCarthy described in his trademark law treatise, "[A]ny 'property' in trademarks is created and defined by the mental state of customers."¹¹ Thus, if there is no

5. The section reads:

(a)(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Lanham Act § 43(a), 15 U.S.C. § 1125(a) (1994).

6. *Erie R.R. v. Tompkins*, 304 U.S. 64 (1938).

7. See *Wojnarowicz v. American Family Ass'n*, 745 F. Supp. 130, 141 (S.D.N.Y. 1990); 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 27:7, :25 (4th ed. 1999). Since the media are not often business competitors of trademark plaintiffs, the consumer protection aspect of trademark law is more relevant to this Comment. Subjects of media reports are unlikely to sue as business competitors. Clint Eastwood does not publish a tabloid that competes with the *National Enquirer*. Cher is involved in a lot of businesses, but the magazine business is not one of them. Contrast this with the New Kids on the Block, whose lawsuit against *USA Today* and *The Star* accused the publications of competing with the group's own 1-900 phone line. The Ninth Circuit found no implied endorsement and rejected all of the claims. See *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302 (9th Cir. 1992).

8. See 1 MCCARTHY, *supra* note 7, § 5:2 (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989) ("The law of unfair competition has its roots in the common-law tort of deceit: its general concern is with protecting consumers from confusion as to source.")).

9. See, e.g., *National Fed'n of the Blind, Inc. v. Loompanics Enters., Inc.*, 936 F. Supp. 1232, 1245 (D. Md. 1996); 1 MCCARTHY, *supra* note 7, § 2:1.

10. See *New Kids*, 971 F.2d at 306 ("A trademark is a limited property right in a particular word, phrase or symbol."); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) ("Plaintiff's trademark is in the nature of a property right."); 1 MCCARTHY, *supra* note 7, § 2:14 ("In the sense of an 'exclusive right' trademarks can be categorized as a form of 'property.'").

11. 1 MCCARTHY, *supra* note 7, § 2:14. Professors Mark Lemley and Eugene Volokh have reiterated trademark's tenuous claim as a property right, noting that "trademarks do not bear many of

confusion among the public, the trademark owner's property right provides no basis for an infringement claim. A trademark, Justice Oliver Wendell Holmes wrote,

does not confer a right to prohibit the use of the word or words. It is not a copyright. . . . A trademark only gives the right to prohibit the use of it so far as to protect the owner's good will against the sale of another's product as his. . . . When the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth. It is not taboo.¹²

Trademark plaintiffs thus defend the public's right to be free from deception in the marketplace. They may recover only when it is likely the public has been confused by the defendant's message.

In addition to misleading the public, trademark infringement also implicates the trademark holder's right to control its reputation.¹³ The District Court for the Southern District of New York recognized this interest in a section 43(a) lawsuit filed by Woody Allen. In a case involving an Allen look-alike in an advertisement, the court stated, "The celebrity's investment [in the 'drawing power' of his or her name and face] depends upon the good will of the public, and infringement of the celebrity's rights also implicates the public's interest in being free from deception when it relies on a public figure's endorsement in an advertisement."¹⁴ *Eastwood*¹⁵ demonstrated a similar focus on reputation in a case that did not involve advertising. There the jury awarded \$75,000 specifically to compensate Eastwood for damage to his reputation.¹⁶

the indicia of real property, or even other forms of intellectual property. Rather, they have traditionally been thought of as a means of preventing consumers from being deceived." Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 217 n.303 (1998) (citations omitted).

12. *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924); see also *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987) ("[T]rademark is not property in the ordinary sense but only a word or symbol indicating the origin of a commercial product. The owner of the mark acquires the right to prevent the goods to which the mark is applied from being confused with those of others and to prevent his own trade from being diverted to competitors through their use of misleading marks." (quoting *Power Test Petroleum Distribs. v. Calcu Gas*, 754 F.2d 91, 97 (2d Cir. 1985))); *Girl Scouts of the United States v. Bantam Doubleday Dell Publ'g Group, Inc.*, 808 F. Supp. 1112, 1119 (S.D.N.Y. 1992) ("[A] trademark owner cannot circumscribe the mark's use beyond a relatively narrowly defined area where consumer confusion is substantial.").

13. See 1 MCCARTHY, *supra* note 7, § 2:14 (quoting *James Burrough, Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266 (7th Cir. 1976)).

14. *Allen v. National Video, Inc.*, 610 F. Supp. 612, 625-26 (S.D.N.Y. 1985). The case arose after a person who closely resembled Allen appeared in a video rental store's advertisement. Despite the resemblance between Allen and the look-alike—and videotapes of Allen's films *Annie Hall* and *Bananas* displayed in the advertisement—the defendants argued that the ad had not appropriated Allen's likeness and was not likely to confuse consumers. See *id.* at 617.

15. *Eastwood v. National Enquirer, Inc.*, 123 F.3d 1249 (9th Cir. 1997).

16. See *id.* at 1250 n.2.

On one hand, this collateral interest in reputation orients trademark law toward defamation law, where the plaintiff's interest is purely reputational, but where First Amendment concerns for the free exchange of ideas limit the recovery for harm to that interest.¹⁷ On the other hand, the interest in reputation is not the primary interest underlying the limited property right in trademark law. This is true whether or not reputation is seen as property.¹⁸ The primary interest remains protecting the public from confusion.

2. *Direct Conflict Between Free Speech and Trademark Law*

By putting a priority on preventing consumer confusion and allowing that priority to restrict a message based on its content, trademark law can be at odds with another public interest—free speech. Trademarks are valuable because they communicate the identity of a commercial source. They offer consumers a shortcut.¹⁹ A trademark's ability to represent to consumers the qualities and history of the product's source means that famous marks "become an important, perhaps at times indispensable, part of the public vocabulary. Rules restricting the use of well-known trademarks may therefore restrict the communication of ideas. When this occurs the confrontation between trademark protection and free speech can no longer be ignored."²⁰

Courts have taken conflicting approaches to this confrontation between trademark protection and free speech. The better approach gives greater weight to First Amendment interests, refusing to elevate the trademark holder's limited property right to such an extent that it dictates the content of the speaker's message. In a much-criticized 1979 decision, the Second Circuit imported the rationales traditionally applied in balancing the First Amendment and real property interests into a trademark case, thus

17. See *Gertz v. Robert Welch, Inc.*, 418 U.S. 323 (1974); *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964).

18. Professor Robert C. Post has found that while "the common law of defamation bears the influence of both the concept of reputation as property and the concept of reputation as dignity," the perspective of reputation as property was not sufficient to explain defamation law. Robert C. Post, *The Social Foundations of Defamation Law: Reputation and the Constitution*, 74 CALIF. L. REV. 691, 699, 717 (1986). Professor Post notes that Justice Harlan's dissent in *Rosenbloom v. Metromedia, Inc.*, 403 U.S. 29 (1971), presents a view of reputation as property, with the purpose of defamation law to compensate for loss of an objectively measured private good. See Post, *supra* at 727. But the majority's holding in *Gertz*, while influenced by Harlan's earlier dissent, rests on the view of reputation not as property but as dignity. See *id.* at 728-30.

19. See, e.g., *Allen*, 610 F. Supp. at 625.

20. Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 195-96 (1982); see also *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 30-31 (1st Cir. 1987) (citing Denicola's argument).

failing to give adequate protection to free speech.²¹ In *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*,²² the Second Circuit upheld the grant of a preliminary injunction preventing the defendant movie theater owner from distributing or exhibiting *Debbie Does Dallas*. The sex film centered around a "Texas Cowgirl" whose outfit closely resembled the uniform of the Dallas Cowboys Cheerleaders. On the Lanham Act claims, the court found that the similarities between the uniforms would cause consumers to link the Dallas cheerleaders to the film, resulting in confusion. To the defendant's First Amendment argument, the court held that the cheerleaders' trademark amounted to a property right that would prevail as long as there were "adequate alternative avenues of communication."²³ Here the court found that the defendants could comment on "sexuality in athletics" without using the plaintiffs' trademark.²⁴

The First Circuit rejected the Second Circuit's approach. It noted that the Supreme Court had applied the "adequate alternative avenues of communication" rationale to a case involving real property—a shopping center—and not the limited property rights in trademarks.²⁵ In the First Circuit case, *L.L. Bean* sued over a sexually explicit parody of its catalogue. The court held, "The first amendment issues involved in this case cannot be disposed of by equating the rights of a trademark owner with the rights of an owner of real property."²⁶ As Professor Robert C. Denicola wrote in critiquing the "alternative avenues" argument, "When the restriction on speech relates merely to time or place, the existence of alternatives may weigh heavily in the balance, but it is one thing to require the speaker to move across the street, and another to demand she dilute the impact of her message."²⁷ A court within the Second Circuit later approved of the *L.L. Bean*²⁸ approach and went on to hold, "The owner of a

21. See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979). Courts and commentators have rejected the Second Circuit's First Amendment analysis in the case. See *infra* notes 23-27 and accompanying text.

22. *Dallas Cowboys Cheerleaders*, 604 F.2d at 202.

23. *Id.* at 206 (citing *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972)).

24. *Id.* In an earlier case, the District Court for the District of Columbia had also relied on the "adequate alternative avenues of communication" rationale to reject a defendant's First Amendment argument. See *Reddy Communications, Inc. v. Environmental Action Found.*, 199 U.S.P.Q. 630, 634 (D.D.C. 1977).

25. See *L.L. Bean*, 811 F.2d at 29.

26. *Id.* McCarthy noted that "[a]nalogies to other forms of 'property,' from real estate to patents and copyrights, falter on the basic definition of scope of trademark 'property.'" which he describes as defined by customer perception. 1 MCCARTHY, *supra* note 7, § 2:14.

27. Denicola, *supra* note 20, at 197; see also Lemley & Volokh *supra* note 11, at 183-84 (noting that content-based laws cast as property rules "may be substantively valid speech restrictions, but calling them property rules doesn't justify exempting them from the normal First Amendment procedural principles, especially when they ban people from saying a particular thing anywhere, at any time, and not just on others' land").

28. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987).

trademark does not possess a property right that is superior to the First Amendment right accorded to artistic expression."²⁹

The First Circuit's view recognizes the limits of trademark holders' property rights. The more limited property right should not be allowed to trump First Amendment rights and restrict public discourse. Nonetheless, plaintiffs have used the false endorsement and false advertising prongs of section 43(a) of the Lanham Act to restrict speech.

3. *Elements of a Claim Under Section 43(a) of the Lanham Act*

Section 43(a) of the Lanham Act applies to both registered and unregistered marks. Section 43(a) also covers celebrity persona, which the Ninth Circuit has held is a form of unregistered "trademark."³⁰ Capitalizing on this characterization, Tom Waits prevailed in a Lanham Act claim against Frito-Lay after the company ran a Doritos ad mimicking Waits's distinctive, gruff voice.³¹ Elsewhere, Cher's trademark persona gave her a claim against *Forum* after the magazine published advertisements that implied Cher had endorsed the magazine.³²

Section 43(a) claims may proceed under either of two prongs. The first prong, section 43(a)(1)(A), provides a claim for false endorsement. Plaintiffs use this provision to sue for infringement of unregistered trademarks; many celebrities have used it to sue when ads falsely suggest they endorse the advertised product or service.³³ Look-alikes—both human³⁴ and nonhuman³⁵—and sound-alikes³⁶ have also prompted celebrities to file section 43(a) claims. The second prong, section 43(a)(1)(B), provides a claim for false advertising. Both parts of the section, though, may come into play in false endorsement cases.³⁷

29. *Girl Scouts of the United States v. Bantam Doubleday Dell Publ'g Group, Inc.*, 808 F. Supp. 1112, 1118 (S.D.N.Y. 1992).

30. *See White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992); 4 MCCARTHY, *supra* note 7, § 27:10.

31. *See Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992).

32. *See Cher v. Forum Int'l, Ltd.*, 692 F.2d 634, 639 (9th Cir. 1982).

33. *See Bruce P. Keller, "It Keeps Going and Going and Going": The Expansion of False Advertising Litigation Under the Lanham Act*, 59 LAW & CONTEMP. PROBS. 131, 135 (1996).

34. *See Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360 (S.D.N.Y. 1988) (Woody Allen look-alike); *Allen v. National Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985) (another Woody Allen look-alike).

35. *See White*, 971 F.2d 1395 (robot dressed like Wheel of Fortune letter-turner Vanna White).

36. *See Waits*, 978 F.2d 1093 (Tom Waits sound-alike).

37. *See* 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 5.4[D] (1999). Lawsuits involving both false endorsement and false advertising claims have not been limited to lawsuits based on advertisements. The New Kids on the Block included claims of false endorsement and false advertising in its lawsuit against News America Publishing and Gannett Satellite Information Network; both claims arose not out of advertisements but out of polls published in *Star Magazine* and *USA Today*. *See New Kids on the Block v. News Am. Publ'g, Inc.*, 745 F. Supp. 1540, 1542 n.2 (C.D. Cal. 1990).

To prevail under either prong, a plaintiff must prove that the defendant used a word, term, name, symbol, or device, or a false designation of origin, or a false or misleading representation of fact in interstate commerce—that is, according to 15 U.S.C. § 1127, all commerce that Congress may lawfully regulate—in connection with goods or services. The plaintiff must also show that the defendant's acts damaged or are likely to damage the plaintiff.³⁸ The plaintiff need not show actual injury.

To prevail in an infringement action under section 43(a)(1)(A), the plaintiff must also prove that the designation is likely to cause confusion, mistake, or deception as to the affiliation, connection, or association of the defendant with another person or as to the origin, sponsorship, or approval of the defendant's goods, services, or commercial activities by another person.³⁹

In addition to the elements that are common to both prongs of section 43(a), to prevail in an action for false advertising under section 43(a)(1)(B), the plaintiff must prove that the false or misleading description misrepresents the nature, characteristics, qualities, or geographic origin of the defendant's or another person's goods, services, or commercial activities; and that the statement was made in the context of commercial advertising or promotion. This differs from section 43(a)(1)(A), which has no explicit requirement that the acts occur in ads or promotions.

Unlike in the defamation context, where even a private figure has the burden of showing that a media defendant published a false statement,⁴⁰ the plaintiff need not show knowing falsehood under section 43(a). All that matters is consumer confusion.⁴¹ In trademark infringement cases, the confusion arises over the source of or connection to the goods or services; in false advertising cases, the confusion is over the quality or performance of the goods or services.⁴² If the ad is shown to be false, then the plaintiff need not delve into whether it was misleading or not.⁴³ Unlike false speech in the defamation context, which is protected to varying degrees depending on the class of plaintiff and the negligence or actual malice of the defendant, false advertisements receive no protection under section 43(a).⁴⁴

The key to both prongs is the *likelihood* of consumer confusion, not *actual* consumer confusion. Accordingly, some courts have held that section 43(a) does not apply to "puffing, advertising 'that is not deceptive for

38. See 15 U.S.C. §§ 1125(a), 1127 (1994); 4 MCCARTHY, *supra* note 7, §§ 27:13, :24.

39. See 15 U.S.C. § 1125(a)(1)(A) (1994).

40. See *Philadelphia Newspapers, Inc. v. Hepps*, 475 U.S. 767, 768-69 (1986) (holding that "at least where a newspaper publishes speech of public concern, a private-figure plaintiff cannot recover damages without also showing that the statements at issue are false").

41. See *Gordon and Breach Science Publishers S.A. v. American Inst. of Physics*, 859 F. Supp. 1521, 1529 (S.D.N.Y. 1994).

42. See *Keller*, *supra* note 33, at 150 n.140.

43. See *id.* at 141.

44. See *infra* notes 61-74 and accompanying text.

no one would rely on its exaggerated claims.”⁴⁵ The defendant’s statement must be material, that is, it must be likely to influence consumers’ decisions.⁴⁶ The test for likelihood of confusion—and thus the test for whether the plaintiff may prevail—considers various factors. The Second Circuit and the Ninth Circuit, for example, consider the strength of the plaintiff’s mark; the similarity between the plaintiff’s and the defendant’s marks; the relatedness of the goods in terms of type, quality, and market; evidence of actual confusion; sophistication of the buyers; and the defendant’s good faith.⁴⁷ Significantly, the Second Circuit also “weigh[s] the public interest in free expression against the public interest in avoiding consumer confusion.”⁴⁸ The approaches of the Second and Ninth Circuits carry substantial weight because those circuits set precedent in the two main media and entertainment centers in the United States: New York and Los Angeles.

4. *Congressional Rift over the Reach of Section 43(a)*

The legislative history of section 43(a) shows a split in House and Senate views over the scope of the law. Thus, courts’ interpretation of the legislative history can affect the extent of the threat that at least part of section 43(a) poses to the press. The amended section 43(a), which took effect in 1989, created a federal commercial defamation cause of action under section 43(a)(1)(B). The statute previously had allowed a lawsuit only when a defendant made false or misleading representations about the defendant’s own goods or services. Under the amended section, a plaintiff could also sue when a defendant made false or misleading statements about the *plaintiff’s* goods or services.⁴⁹ This change created a federal commercial defamation action, under which a defendant could be held liable for making defamatory statements about another’s product.⁵⁰

45. *U.S. Healthcare, Inc. v. Blue Cross*, 898 F.2d 914, 922 (3d Cir. 1990) (quoting *Toro Co. v. Textron, Inc.*, 499 F. Supp. 241, 253 n.23 (D. Del. 1980)).

46. See Keller, *supra* note 33, at 148.

47. See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992) (citing the standard announced in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979)); *Girl Scouts of the United States v. Bantam Doubleday Dell Publ’g Group, Inc.*, 808 F. Supp. 1112, 1119 (S.D.N.Y. 1992) (citing the standard established in *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961)).

48. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc.*, 886 F.2d 490, 494 (2d Cir. 1989). See *infra* Part IV for a discussion of this aspect of the test.

49. The 1982 version of section 43(a) targeted “false designation[s] of origin” and “any false description or representation, including words or other symbols tending falsely to describe or represent the same.” Arlen W. Langvardt, *Section 43(a), Commercial Falsehood, and the First Amendment: A Proposed Framework*, 78 MINN. L. REV. 309, 312 n.10 (1993) (quoting 15 U.S.C. § 1125(a) (1982)). “Courts consistently interpreted this language as contemplating liability only when the defendant’s designations, descriptions, or representations pertained to the defendant’s own product or service.” *Id.* (citing *Bernard Food Indus. v. Dietene Co.*, 415 F.2d 1279, 1283-84 (7th Cir. 1969)). The amended section took effect with the passage of the Trademark Law Revision Act.

50. See 134 CONG. REC. 31,851 (1988) (remarks of Rep. Kastenmeier).

Driven by constitutional concerns, the House held the view that these changes "should not be read in any way to limit political speech, consumer or editorial comment, parodies, satires, or other constitutionally protected material."⁵¹ Representative Robert W. Kastenmeier, the bill's sponsor in the House, specifically noted, "To avoid legitimate constitutional challenge, it was necessary to carefully limit the reach of the subsection."⁵² Thus, the House intended the amended Act to create a cause of action only for false, misleading commercial speech. It did not intend to subject non-commercial speech to section 43(a)(1)(B) claims.⁵³

The Senate took a different view. It intended the subsection's "commercial" focus to exclude only political speech from its coverage, not consumer reporting or editorial commentary. Under the Senate's interpretation of the statute, as stated by Arizona Democrat Dennis DeConcini, the term "commercial" should apply "any time there is a misrepresentation relating to goods or services."⁵⁴ This interpretation is broader than the House's view because it would include any misrepresentation regarding goods or services, not just misrepresentations targeting a business competitor during an advertising campaign, for example.

Courts have rejected the Senate's broad view of the scope of section 43(a). In a 1991 case, the U.S. District Court for the Southern District of New York ruled that the Senate's reading of the statute "raises constitutional concerns because it fails to consider speech that relates to both goods and services, as well as political issues."⁵⁵ To avoid holding liable, for example, a group that made disparaging remarks about a business that failed to divest its holdings in apartheid-era South Africa, the court limited "'commercial' to describe advertising or promotion for business purposes."⁵⁶ Other courts have followed suit.⁵⁷

51. *Id.* at 31,852. As Rep. Kastenmeier's remarks dominate the legislative record in the House, courts have equated his comments with the view of the House. *See, e.g.,* Gordon and Breach Science Publishers S.A. v. American Inst. of Physics, 859 F. Supp. 1521, 1533-34 (S.D.N.Y. 1994); National Artists Management Co. v. Weaving, 769 F. Supp. 1224, 1231-32 (S.D.N.Y. 1991). The same is true for Sen. DeConcini's remarks, which courts have seen as representing the view of the Senate. *See, e.g.,* National Artists, 769 F. Supp. at 1232.

52. 134 CONG. REC. 31,851 (1988) (remarks of Rep. Kastenmeier).

53. While members of Congress repeatedly referred to "43(a)," the "commercial advertising or promotion" language is only in section 43(a)(1)(B).

54. 134 CONG. REC. 32,053 (1988) (remarks of Sen. DeConcini).

55. National Artists, 769 F. Supp. at 1232.

56. *Id.*

57. *See, e.g.,* Gordon and Breach Science Publishers S.A. v. American Inst. of Physics, 859 F. Supp. 1521, 1533-34 (S.D.N.Y. 1994); Wojnarowicz v. American Family Ass'n, 745 F. Supp. 130, 142 (S.D.N.Y. 1990) (relying on S. 1883, 101st Cong., 135 CONG. REC. 1207, 1217 (1989) to show section 43(a) was narrowly drafted to cover only clearly false and misleading commercial speech). *But see* Semco, Inc. v. Amcast, Inc., 52 F.3d 108, 112 (6th Cir. 1995) (opting to "shrink from attempting to divine the true meaning of 'commercial advertising and promotion' because of the contradictory legislative history concerning that language" but finding that publication of an article in a trade journal in which a competitor allegedly misrepresented the plaintiff's products constituted commercial speech).

By expressly considering the constitutional implications of section 43(a) of the Lanham Act, the House and several courts rightly have recognized the potential threat the trademark statute presents to speech protected by the First Amendment. By limiting section 43(a)(1)(B)'s reach only to misleading advertising or promotion, "all other misrepresentations" are excluded "from section 43(a) coverage. These others are the type which raise free speech concerns, such as a Consumer Report which reviews and may disparage the quality of . . . products All of these would be judged by first amendment law . . . and not section 43(a) law."⁵⁸

If the Senate saw the section as being so limited and if courts and plaintiffs were more precise as to which 43(a) prong they were invoking, no further discussion of section 43(a)(1)(B) or commercial speech would be required. Any claim would have to be rooted in a commercial context or it would not survive. As noncommercial speech, editorial content would not give rise to a claim under section 43(a)(1)(B). But because the Senate did view the section as protecting only political speech and because court opinions do not always clearly distinguish between section 43(a)(1)(A) and section 43(a)(1)(B),⁵⁹ it is necessary to demonstrate that section 43(a)(1)(B) cannot be applied to claims arising from editorial content.

The narrower House view of section 43(a)(1)(B) comes into play only in cases that implicate the Supreme Court's commercial speech doctrine.⁶⁰ That doctrine provides that while commercial speech does receive some First Amendment protection, it gets less protection than noncommercial speech and is not protected at all if it is deceptive.⁶¹ While "[t]he First Amendment requires that we protect some falsehood in order to protect speech that matters,"⁶² in the area of commercial speech, if the speech is deceptive, it falls outside the First Amendment.⁶³ If the speech is found to be noncommercial, then it—and any falsehood within it—gets First Amendment protection against defamation claims under the *New York*

58. 134 CONG. REC. 31,852 (1988) (remarks of Rep. Kastenmeier) (quoting Jerome Gilson). For an application of this, see *Bose Corp. v. Consumers Union of United States, Inc.*, 466 U.S. 485 (1984). In that case the Court applied a *New York Times v. Sullivan* standard to a lawsuit based on a *Consumer Reports* article critiquing Bose loudspeakers.

59. See, e.g., *Eastwood v. National Enquirer, Inc.*, 123 F.3d 1249 (9th Cir. 1997) (referring merely to section 43(a) of the Lanham Act); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992) (referring to section 43(a) of the Lanham Act); *Cher v. Forum Int'l, Ltd.*, 692 F.2d 634 (9th Cir. 1982) (referring merely to the Lanham Act).

60. See 134 CONG. REC. 31,851 (1988) (remarks of Rep. Kastenmeier).

61. See *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557, 563 (1980).

62. *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 341 (1974); see also *New York Times Co. v. Sullivan*, 376 U.S. 254, 271 (1964) ("The constitutional protection does not turn upon 'the truth . . . of the ideas and beliefs which are offered.'" (quoting *NAACP v. Button*, 371 U.S. 415, 445 (1963))).

63. See *Central Hudson*, 447 U.S. at 563 (finding "no constitutional objection to the suppression of commercial messages that do not accurately inform the public about lawful activity"); 2 MCCARTHY, *supra* note 37, § 8.3[A].

Times v. Sullivan line of cases.⁶⁴ The *New York Times* protections for the press apply as long as the plaintiff is a public figure or official and the defendant did not act with actual malice.⁶⁵ Given the increased protection for noncommercial speech, determining whether the speech is commercial or not goes a long way toward determining whether the plaintiff will prevail.

The Court has defined commercial speech as speech that does “no more than propose a commercial transaction”⁶⁶ and is “related solely to the economic interests of the speaker and its audience.”⁶⁷ The primary message is “Buy me.”⁶⁸ Courts also look to several factors in deciding whether speech is commercial. These include whether the speech is an advertisement, whether it refers to a specific product or service, and whether the speaker has an economic motivation for the speech.⁶⁹ If the answer is yes to these three questions, then there is “strong support” for finding the speech to be commercial.⁷⁰

Even if commercial, the speech merits some level of constitutional protection because, like noncommercial speech, advertising performs an informational function in society.⁷¹ Nevertheless, commercial speech occupies a lower position in the First Amendment hierarchy, so restrictions are accepted that would be anathema in other areas of constitutionally guaranteed speech.⁷² The rationale for providing some, but not full, First Amendment protection for commercial speech lies in the view that the speech is more durable and less likely to be chilled by government

64. *Gertz*, 418 U.S. at 341 (“The First Amendment requires that we protect some falsehood in order to protect speech that matters.”); *New York Times*, 376 U.S. at 271-72 (noting that “erroneous statement is inevitable in free debate, and that it must be protected if the freedoms of expression” are to get needed “breathing space”).

65. *See Curtis Publ’g Co. v. Butts*, 388 U.S. 130, 162 (1967); *New York Times*, 376 U.S. at 279-80.

66. *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976) (quoting *Pittsburgh Press Co. v. Pittsburgh Comm’n on Human Relations*, 413 U.S. 376, 385 (1973)).

67. *Central Hudson*, 447 U.S. at 561. Justice Stevens advocates a more narrow definition of commercial speech “lest speech deserving of greater constitutional protection be inadvertently suppressed.” He suggests a definition that does not cover every economically motivated expression; otherwise, labor leaders’ push to strike or economists’ dissertations on the money supply, both of which relate to the economic interests of their audiences, would qualify as commercial speech and, wrongfully, receive less First Amendment protection. *See id.* at 579-80 (Stevens, J., concurring).

68. *See* 2 *McCARTHY*, *supra* note 37, § 8.2[D].

69. *See U.S. Healthcare, Inc. v. Blue Cross*, 898 F.2d 914, 933 (3d Cir. 1990) (citing *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66-67 (1983)).

70. *U.S. Healthcare*, 898 F.2d at 933.

71. *See Central Hudson*, 447 U.S. at 563; *see also Virginia Board*, 425 U.S. at 765 (noting that in a free enterprise system, the “free flow of commercial information is indispensable” to enlightened public decision making about the allocation of resources and regulation of the economy).

72. *See City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 422 (1993).

regulation than other forms of speech.⁷³ Motivated by money, commercial speech is seen as more resilient in the face of government regulation than noncommercial speech that contributes to the public discourse and democratic participation.⁷⁴

Admittedly, newspapers do have a profit motive, as accounts of media companies' quarterly reports and periodic newsroom layoffs that follow reports of lower profits attest. But that does not toss the papers' editorial content either outside the realm of the First Amendment or into the zone of less protected commercial speech. As the Court has held, "That books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment."⁷⁵

5. *How Section 43(a) of the Lanham Act Has Been Applied to the Mass Media*

The conflict between the First Amendment and the Lanham Act arises when a plaintiff sues a media defendant on the basis of the editorial content of the defendant's publication. In such a case, the plaintiff uses trademark law to chill the dissemination of news. Several cases have applied section 43(a) to the mass media, some successfully for the plaintiff, some unsuccessfully.

Three Ninth Circuit cases highlight the interaction between the press, celebrity coverage, and the Lanham Act. In *Eastwood v. National Enquirer, Inc.*,⁷⁶ the court held that the weekly tabloid newspaper's false, front-page classification of an interview as "exclusive" implied that Clint Eastwood had endorsed the tabloid, thus allowing the actor to prevail on a

73. See *Central Hudson*, 447 U.S. at 564 n.6 (finding support for the content regulation of commercial speech in light of its being "the offspring of economic self-interest" and "a hardy breed of expression." The Court also noted that since commercial speakers know their markets and their products, "they are well situated to evaluate the accuracy of their messages"). The *Central Hudson* Court established a four-part test in determining whether the speech falls under the First Amendment and whether regulation of it is constitutionally permissible: (1) Does the speech concern lawful activity and is it accurate? (2) Is the governmental interest in regulating the speech substantial? (3) If the first two questions can be answered "yes," then does the regulation directly advance the governmental interest asserted? (4) And is the regulation only as extensive as necessary to serve that interest? If the answers to (3) and (4) are "yes," then the regulation is constitutional. See *id.* at 566.

74. See *id.* at 564 n.6.

75. *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501-02 (1952). As New York University Professor Diane Leenheer Zimmerman wrote:

The press, which the First Amendment expressly protects, is clearly as interested in garnering profits from the information it publishes as any other merchant. But to treat the press' commercial uses of information as potential infringements of another's property rights would impose such severe burdens on speech activities as to render the protection available under the First Amendment almost nugatory.

Diane Leenheer Zimmerman, *Information as Speech, Information as Goods: Some Thoughts on Marketplaces and the Bill of Rights*, 33 WM. & MARY L. REV. 665, 722-23 (1992).

76. *Eastwood v. National Enquirer, Inc.*, 123 F.3d 1249 (9th Cir. 1997).

section 43(a) claim. Eastwood had alleged that the article, "Clint Eastwood at 63: being a new dad has made my day," misrepresented its origin, association and/or endorsement in violation of the Lanham Act.⁷⁷ As Eastwood's lawyer said later, "Our first line of argument was that it was an invasion of privacy, a hijacking of his persona for their commercial gain."⁷⁸

The interview, which appeared first in the British tabloid *Today*, ran with an *Enquirer* byline and a photo of Eastwood and Frances Fisher's baby girl.⁷⁹ The Ninth Circuit found no clear and convincing evidence that the publishers acted with actual malice, that is, that the *Enquirer* published the interview knowing that it was false or recklessly disregarding whether it was false or not. Eastwood thus failed to satisfy the burden imposed by *New York Times* on public figures to establish defamation.⁸⁰ The court did find, however, that the publishers acted with actual malice in labeling the interview and its accompanying snapshot as "exclusive."⁸¹ The court held that suggesting that Eastwood agreed to an interview with the *Enquirer* could be found to damage the actor's reputation since a jury could have found that Eastwood's fans would consider him either a washed-up star or a hypocrite for baring his private life to the tabloid⁸² that reaches 2.7 million readers weekly.⁸³ To the Ninth Circuit, an exclusive interview in a newspaper amounted to an endorsement of that publication.

Eastwood contrasts with an earlier Ninth Circuit case addressing friction between celebrities, the press, and trademarks. In *New Kids on the Block v. News America Publishing, Inc.*,⁸⁴ the press prevailed. The case arose after *The Star* and *USA Today* conducted polls to get a public vote—via 1-900 numbers at fifty cents or ninety-five cents a minute—on favorite members of the successful but short-lived teen music group. *The Star* published articles and photographs of the group and asked, "Now which kid is the sexiest?" *USA Today's* survey, timed to coincide with a review of the group's televised concert and an article about the New Kids doll collection, asked, "Who's the best on the block?"⁸⁵

In finding for the press defendants, the district court for the Central District of California applied a First Amendment analysis. The court held that "the First Amendment provides immunity to defendants in this case

77. *Id.* at 1250.

78. Gail Diane Cox, *9th Makes Movie Star's Day: Appellate Panel Upholds Clint Eastwood's Verdict*, NAT'L L.J., Sept. 8, 1997, at A12.

79. *See Eastwood*, 123 F.3d at 1250, 1253, 1256.

80. *See id.* at 1255.

81. *See id.* at 1256.

82. *See id.*

83. *See James Bates, Backlash, Competition Are Hurting Sales of Scandal Sheets*, L.A. TIMES, Sept. 6, 1997, at D1.

84. *New Kids*, 971 F.2d 302 (9th Cir. 1992).

85. *See id.* at 304.

unless their use of the plaintiffs' trademark was wholly unrelated to news gathering and dissemination, misleading as to content, or falsely and explicitly denoted authorship, sponsorship, or endorsement by the New Kids on the Block."⁸⁶ Since the polls related to news gathering and dissemination, were not misleading, and did not explicitly say the group endorsed the polls, the publishers were not liable for a section 43(a) violation. The court struck a balance firmly in favor of First Amendment interests: "The risk that some people might think that the New Kids implicitly endorsed or sponsored the Star Magazine's and USA Today's 900 number services is outweighed by the danger of restricting news gathering and dissemination."⁸⁷

The Ninth Circuit chose not to decide the case on constitutional grounds when it upheld the ruling in favor of the media defendants. Viewing the newspapers' use of the band's identity as a form of journalistic entertainment and news rather than as an exploitative, commercial use, the court held that the unauthorized use of the New Kids' trademark was neither false nor misleading and did not imply that the group endorsed the polls.⁸⁸

The group did not have a lock on all uses of its name, the Ninth Circuit held. Where the trademark is the only way to describe something, a defendant's reference to that thing does not necessarily amount to infringement.⁸⁹ Assuming you wanted to, how else would you describe the group of Donnie Wahlberg, Danny Wood, Jonathan Knight, Jordan Knight and Joe McIntyre? You have to use the group's name, its trademark (that would be New Kids on the Block). For the court, Judge Kozinski wrote, "Such *nominative use* of a mark . . . lies outside the strictures of trademark law: Because it does not implicate the source-identification function that is the purpose of trademark, it does not constitute unfair competition; such use is fair because it does not imply sponsorship or endorsement by the trademark holder."⁹⁰ The court also held, "While plaintiffs' trademark certainly deserves protection against copycats and those who falsely claim that the New Kids have endorsed or sponsored them, such protection does not extend to rendering newspaper articles, conversations, polls and comparative advertising impossible."⁹¹

86. *New Kids on the Block v. News Am. Publ'g, Inc.*, 745 F. Supp. 1540, 1541-42 (C.D. Cal. 1990).

87. *Id.* at 1545.

88. *See New Kids*, 971 F.2d at 308-09.

89. *See id.* at 308.

90. *Id.*

91. *Id.* A recent decision from the U.S. District Court for the Central District of California held a media defendant liable in a celebrity plaintiff's Lanham Act case. *See Hoffman v. Capital Cities/ABC Inc.*, 33 F. Supp. 2d 867 (1999). Dustin Hoffman sued *Los Angeles* magazine after the magazine published a fashion spread in which a photograph of the actor in his *Tootsie* role had been altered to dress Hoffman in a designer gown. *See id.* at 870. Hoffman prevailed on several accounts, including

In an earlier celebrity lawsuit charging a Lanham Act violation, *Cher v. Forum International, Ltd.*,⁹² the Ninth Circuit—"the Court of Appeals for the Hollywood Circuit"⁹³—limited First Amendment protections for the publishers to the "truthful use of a public figure's name and likeness in advertising which is merely an adjunct of the protected publication and promotes only the protected publication."⁹⁴ The advertisement is protected if it uses a celebrity's identity as an example of the publication's content without falsely claiming that the celebrity endorses the publication. But when the advertising copy promoting the news medium is false, the plaintiff has a claim for false endorsement.⁹⁵

While Judge Goodwin's ruling in *Cher* avoided a decision on Lanham Act grounds, the case does distinguish between using Cher's identity in news content and in advertising. The opinion thus offers an approach that courts can take when a Lanham Act claim rests not on advertising content but on editorial content. Both *Forum*'s publication of a free-lancer's interview, "Exclusive: Cher Talks Straight" and the tabloid *Star*'s publication of parts of the same interview, "Exclusive Series—Cher: My life, my husbands and my many, many men," were not actionable because they were not published with actual malice.⁹⁶ Unlike the *Eastwood* panel, here the Ninth Circuit gave no weight to the argument that the plaintiff's celebrity image was damaged by the suggestion that she would give an exclusive interview to the tabloid; the "exclusive" tag did not amount to a false endorsement of the publication.⁹⁷ The court stated, "Even if some of the material in *Star* had already appeared in *Forum*, Cher did not suffer any

section 43 of the Lanham Act and common-law and statutory rights of publicity. The judge found that the photo was likely to confuse consumers into thinking Hoffman endorsed, approved, or was somehow associated with the article. *See id.* at 874. The judge, declaring Hoffman to be "one of our country's living treasures," *id.* at 869, rejected any news or public affairs defense, *see id.* at 875.

This rejection of the magazine's fashion article as news runs counter to other opinions. A New York court has recognized newsworthiness as applying "not only to reports of political happenings and social trends . . . but also to news stories and articles of consumer interest including developments in the fashion world." *Stephano v. News Group Publications, Inc.*, 474 N.E.2d 580, 585 (N.Y. 1984). The public interest that the *Stephano* court recognized wasn't the fashion trend but rather "the availability of the clothing item displayed." *Id.*

The *Hoffman* decision also failed to expressly weigh the public interest in avoiding consumer confusion against the public interest in free expression. *See Hoffman*, 33 F. Supp. 2d 867. For a discussion on the Second Circuit's balancing of those interests, *see infra* Part IV.B.

92. *Cher*, 692 F.2d 634 (9th Cir. 1982).

93. *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1521 (9th Cir. 1993) (Kozinski, J., dissenting).

94. *Cher*, 692 F.2d 634, 639.

95. *See id.*

96. *See id.* at 637 n.1 (finding false endorsement, but under a right to publicity theory and not under the Lanham Act).

97. *See id.* at 637-38.

damage from *Star*'s exaggerated claims of exclusivity."⁹⁸ In *Eastwood*, the court overlooked that statement—and, apparently, the fact that liability in *Cher* attached only to the advertisement, not to the headlines.⁹⁹ But while First Amendment protections cover "headlines and cover display so long as the headlines and promotional devices were true or were not published with knowledge that they were false or in reckless disregard for their truth," the same protections did not cover *Forum*'s misleading tear-out subscription advertisements that proclaimed, "There are certain things that Cher won't tell People and would never tell Us. She tells Forum. . . . So join Cher and FORUM's hundreds of thousands of other adventurous readers today."¹⁰⁰ With that the court held that *Forum* had published a false, implied endorsement of the magazine and stepped into the domain of misleading commercial speech, which the First Amendment does not protect.¹⁰¹

The *Cher* court distinguished the use of Cher's identity in headlines, even those with "exaggerated claims of exclusivity," from the use of her identity in an ad campaign. Given the lesser protection for commercial speech, that distinction matters under the First Amendment.¹⁰²

98. *Id.* at 637. The parties stipulated that the "exclusive" *Star* article had not appeared elsewhere. *See id.* In *Eastwood* the "exclusive" *Enquirer* interview had appeared in the British tabloid *Today*. *See Eastwood v. National Enquirer, Inc.*, 123 F.3d 1249, 1253 (9th Cir. 1997).

99. *See Eastwood*, 123 F.3d at 1255 n.16. The *Eastwood* court stressed that *Cher* applies only to previously unpublished quotations. *See id.*

100. *Cher*, 692 F.2d at 638-39. The court contrasted pure advertising against the use of promotional devices on the front page that the publisher was entitled to use to inform its readers of the content of the publication. *See id.* at 638.

101. Since the interview was originally to appear in *Us* magazine, before its editors acceded to Cher's request to kill the interview, the court found the ad to be "patently false." *See id.* at 639. Similar advertisements appeared in both *Forum* and *Penthouse*, whose owner holds a controlling stake in *Forum*'s parent corporation. *See id.* at 640.

102. Courts have recognized a First Amendment hierarchy of protection, with news, or speech on public issues, at the top. *See Dun & Bradstreet, Inc. v. Greenmoss Builders, Inc.*, 472 U.S. 749, 758-59 (1985) ("We have long recognized that not all speech is of equal First Amendment importance. It is speech on 'matters of public concern' that is 'at the heart of the First Amendment's protection.'" (quoting *First Nat'l Bank v. Bellotti*, 435 U.S. 765, 776 (1978))).

Studying this hierarchy reiterates the importance the Court has placed on the dissemination of news. One approach to classifying the levels of the hierarchy puts news, or "information about the real world," first, followed by fiction for entertainment purposes, and then by advertising, or commercial speech. *See Peter L. Felcher & Edward L. Rubin, Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1597-99 (1979). Felcher and Rubin point out that there is no sharp delineation between the protection given the news and entertainment categories; entertainment just faces a greater likelihood of less protection. This is because entertainment will be seen as serving a cultural function instead of the more central First Amendment function of furthering self-governance. *Id.* at 1598.

Commercial speech, while deserving of constitutional protection because it disseminates information via advertising, rests lower on the First Amendment hierarchy. The Court has "recognized 'the "common-sense" distinction between speech proposing a commercial transaction, which occurs in an area traditionally subject to government regulation, and other varieties of speech.' . . . The Constitution therefore accords a lesser protection to commercial speech than to other constitutionally

B. First Amendment Considerations

1. Raising a First Amendment Barrier Based on the Content of the Report

The First Amendment seeks to assure the “unfettered interchange of ideas for the bringing about of political and social changes desired by the people.”¹⁰³ This interchange is essential to a democracy where people govern themselves; to govern well, people must have access to information. Put another way, for public debate to have value, it must be informed.¹⁰⁴ The press is inextricably linked to this democratic view, for, as the Court has written, “[a] broadly defined freedom of the press assures the maintenance of our political system and an open society.”¹⁰⁵

The free exchange of ideas also helps define a community out of a diverse society.¹⁰⁶ American society is built on *People*, *Hustler*, and the *National Enquirer* as well as *Newsweek*, *The Nation*, and *The New York Times*. While celebrity gossip may not have the same direct impact on self-governance as reports on foreign aid or tax reform, such information adds to a reservoir of shared experiences and history and helps define the community and provide a common language in the United States.¹⁰⁷ People from Los Angeles to Little Rock could tell you how many times Elizabeth Taylor has been married (eight)¹⁰⁸ or that James Dean died in a car crash. Neither point is likely to come up in a town hall meeting, but both contribute to a shared American culture.

In the course of defending the “profound national commitment to the principle that debate on public issues should be uninhibited, robust, and

guaranteed expression.” *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557, 562-63 (1980) (quoting *Ohralik v. Ohio State Bar Ass’n*, 436 U.S. 447, 455-56 (1978)).

103. *New York Times Co. v. Sullivan*, 376 U.S. 254, 269 (1964) (quoting *Roth v. United States*, 354 U.S. 476, 484 (1957)).

104. *See Richmond Newspapers, Inc. v. Virginia*, 448 U.S. 555, 587 (1980) (Brennan, J., concurring); *see also Whitney v. California*, 274 U.S. 357, 375 (1927) (Brandeis, J., concurring) (“[F]reedom to think as you will and to speak as you think are means indispensable to the discovery and spread of political truth. . .”).

105. *Time, Inc. v. Hill*, 385 U.S. 374, 389 (1967).

106. *See* Robert C. Post, *The Constitutional Concept of Public Discourse: Outrageous Opinion, Democratic Deliberation and Hustler Magazine v. Falwell*, 103 HARV. L. REV. 601, 671 (1990).

107. *See id.* at 674 (suggesting that “[l]earning of a prominent athlete or entertainer’s struggles with drugs or alcohol may well lead the public to a different and perhaps more (or less) sympathetic understanding of the social problem of substance abuse. Discussion of the World Series may lead to an altered perception of the national character”); *see also* James Carey, *The Decline of Democratic Institutions*, COLUM. JOURNALISM REV., Mar./Apr. 1998, at 6 (observing that “[t]he ultimate justification for journalism and the First Amendment is that together they constitute us as a civil society and set us in conversation with one another. Journalism is our public diary, our day book, and as such it forms our collective memory.”).

108. For Taylor, that would be to hotel heir Conrad “Nicky” Hilton, actor Michael Wilding, Broadway producer Michael Todd, singer Eddie Fisher, actor Richard Burton, actor Richard Burton (again), U.S. Sen. John Warner of Virginia, and construction worker Larry Fortensky. *See Celebrity Court* (visited Oct. 13, 1999) <http://www.lawstreet.com/celebrity/taylor_liz>.

wide-open,"¹⁰⁹ the courts have developed substantial First Amendment protections that benefit the press and other news media outlets that provide fodder for public discourse locally and nationally. Once the speech is considered part of public discourse, its value increases to the degree that community norms of civility cannot be allowed to restrain it.¹¹⁰ To maintain a commitment to wide-open public debate, the Supreme Court has taken an expansive view of what constitutes a "public issue." As Justice Brennan noted in *Time, Inc. v. Hill*,¹¹¹ "The guarantees for speech and press are not the preserve of political expression or comment upon public affairs, essential as those are to healthy government. . . . 'Freedom of discussion, if it would fulfill its historic function in this nation, must embrace all issues about which information is needed or appropriate to enable the members of society to cope with the exigencies of their period.'"¹¹²

The Court's broad definition of "public issue" dictates that more of what a person sees in the newspaper or weekly magazine—whether it is coverage of election night or Oscar night—will be protected as part of public discourse. In the interest of not restraining that discourse, the Court has taken a broad view of what is news. News, the Court has said, includes all media presentation of information on public issues, including political and social phenomena and all matters of public concern.¹¹³ As Justice Douglas noted in his dissent in *Gertz v. Robert Welch, Inc.*,¹¹⁴ "[P]ublic affairs' includes a great deal more than merely political affairs. Matters of science, economics, business, art, literature, etc., are all matters of interest to the general public. Indeed, any matter of sufficient general interest to

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

110. *See Post*, *supra* note 106, at 667.

111. 385 U.S. 374 (1967).

112. *Id.* at 388 (quoting *Thornhill v. Alabama*, 310 U.S. 88, 102 (1940)); *see also* *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1519 (9th Cir. 1993) (Kozinski, J., dissenting) ("The First Amendment isn't just about religion or politics—it's also about protecting the free development of our national culture."); *Guglielmi v. Spelling-Goldberg Productions*, 603 P.2d 454, 458 (Cal. 1979) (Bird, C.J., concurring) ("Participation in the process of self-government requires knowledge of more than current events and political candidates. The information required to establish basic values and to order political priorities is essential."); Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983, 989 (1970) ("Wise and independent political choices are not the outgrowth of exposure to political ideas alone. Essential, too, is exposure to the varieties of cultural experience—philosophy, science, the written, visual, and musical arts—which conduce to individual growth and freedom."). Neil Weinstock Netanel of the University of Texas describes public discourse in the United States as "a rambunctious, effervescent brew of spectacle, prurient appeal, social commentary, and political punditry. It is part entertainment, but as it entertains, it often reveals contested issues and deep fissures within our society, just as it may reinforce widely held beliefs and values." Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L.J. 283, 350 (1996).

113. *See* 2 MCCARTHY, *supra* note 37, § 8.1[A][1][a]; *Abood v. Detroit Bd. of Educ.*, 431 U.S. 209, 231 (1977) (stating that "our cases have never suggested that expression about philosophical, social, artistic, economic, literary, or ethical matters—to take a nonexhaustive list of labels—is not entitled to full First Amendment protection").

114. 418 U.S. 323 (1974).

prompt media coverage may be said to be a public affair.”¹¹⁵ While some have criticized this deference to the news media’s definition of news as “bootstrapping,”¹¹⁶ judges have refrained from substituting their views of what constitutes news for the judgment of the information suppliers in the press.¹¹⁷

Others have followed Justice Douglas’s broad view of what is news. In 1986 the court for the Southern District of New York stressed that

the initial inquiry is whether the article in question “is arguably within the sphere of legitimate public concern.” Matters of general interest such as entertainment and health, as well as so-called ‘hard news,’ are within this sphere. Diets and dieting, subjects of great interest to many Americans, are also of interest to the public. Because a particular diet strikes some as strange, novel, or even humorous does not remove it from the realm of public concern. Nor does its inclusion in a publication that some would term a sensational tabloid entitle it to any less protection.¹¹⁸

The Supreme Court has noted that “entertainment itself can be important news.”¹¹⁹ Celebrity news serves to help people “cope with the exigencies of their period”¹²⁰ by giving ordinary readers and listeners insight into the lives of the rich and famous, insight that may help people decide what they want to try to emulate and what they want to avoid. As Richard Posner wrote, “Gossip columns open people’s eyes to opportunities and dangers; they are genuinely informational.”¹²¹

2. *Raising a First Amendment Barrier Based on the Identity of the Speaker*

“Congress shall make no law . . . abridging the freedom . . . of the press”¹²² Despite the language of the Press Clause of the First Amendment, the justices generally have avoided limiting special protections specifically to the press. This avoidance recurs throughout the

115. *Id.* at 357 n.6 (Douglas, J., dissenting). *But see* Post, *supra* note 106, at 677-78 (observing that while media speech has a prima facie claim to be defined as public discourse, that claim rests on the speech’s broad dissemination, not its content).

116. *See, e.g.,* Anthony Lewis, *New York Times v. Sullivan Reconsidered: Time to Return to “The Central Meaning of the First Amendment,”* 83 COLUM. L. REV. 603, 624 (1983) (arguing that a test that looks to the subject matter’s relevance to public affairs or government is preferable to one based on “public or general interest”—really a bootstrap expression, since anything publicized by a newspaper may be said to be of general interest”).

117. *See* 2 MCCARTHY, *supra* note 37, § 8.8[B][2][a] & nn.18 & 19 (citing Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539 (1985); Ann-Margret v. High Society Magazine, Inc., 498 F. Supp. 401, 405 (S.D.N.Y. 1980)).

118. *Nelson v. Globe Int’l, Inc.*, 626 F. Supp. 969, 976 (S.D.N.Y. 1986) (citations omitted).

119. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 578 (1977).

120. *Thornhill v. Alabama*, 310 U.S. 88, 102 (1990).

121. Richard A. Posner, *The Right of Privacy*, 12 GA. L. REV. 393, 396 (1978).

122. U.S. CONST. amend. I.

justices' opinions, especially in defamation cases. For example, in his concurring opinion in *Dun & Bradstreet, Inc. v. Greenmoss Builders, Inc.*,¹²³ Justice White agreed with four dissenting justices "that the First Amendment gives no more protection to the press in defamation suits than it does to others exercising their freedom of speech. None of our cases affords such a distinction; to the contrary, the Court has rejected it at every turn."¹²⁴

In *Dun & Bradstreet*, the majority avoided making a distinction among defendants. The Vermont Supreme Court had held that the protections for media defendants described in *Gertz*—requiring private-figure plaintiffs to prove at least negligence to recover compensatory damages in a defamation suit¹²⁵—did not apply to nonmedia defendants.¹²⁶ The Supreme Court's affirmance hinged not on the identity of the defendant but on whether or not the speech involved matters of public concern.¹²⁷ This ambivalence about the treatment of media defendants persists; a year after *Dun & Bradstreet*, Justice Sandra Day O'Connor noted that the Court need not "consider what standards would apply if the plaintiff sues a nonmedia defendant."¹²⁸

While the Court has avoided making a distinction between media and nonmedia defendants, it has not closed the door on such a distinction.¹²⁹ Throughout its decisions the Court repeats the protections available specifically to media defendants. In *Gertz* its focus was on shielding "the press and broadcast media from the rigors of strict liability for defamation."¹³⁰ In *Philadelphia Newspapers, Inc. v. Hepps*,¹³¹ the term "media defendant" saturated the opinion. The standard the Court

123. *Dun & Bradstreet, Inc. v. Greenmoss Builders, Inc.*, 472 U.S. 749 (1985).

124. *Id.* at 773 (White, J., concurring). Five justices—Justices White, Brennan, Marshall, Blackmun, and Stevens—would not limit *Gertz* to media defendants. "Such a distinction is irreconcilable with the fundamental First Amendment principle that '[t]he inherent worth of . . . speech in terms of its capacity for informing the public does not depend upon the identity of its source, whether corporation, association, union, or individual.'" *Id.* at 781 (Brennan, J., dissenting) (quoting *First Nat'l Bank v. Bellotti*, 435 U.S. 765, 777 (1978)). In *Bellotti*, Chief Justice Burger, while finding no special privilege for the press, noted in his concurrence that the "Court has not yet squarely resolved whether the Press Clause confers upon the 'institutional press' any freedom from government restraint not enjoyed by all others." *Bellotti*, 435 U.S. at 798.

125. See *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 347 (1974).

126. See *Dun & Bradstreet*, 472 U.S. at 753 (citing *Greenmoss Builders, Inc. v. Dun & Bradstreet, Inc.*, 461 A.2d 414, 418 (Vt. 1983)).

127. See *id.* at 763.

128. *Philadelphia Newspapers, Inc. v. Hepps*, 475 U.S. 767, 779 n.4 (1986).

129. See 2 RODNEY A. SMOLLA, SMOLLA AND NIMMER ON FREEDOM OF SPEECH § 22:12 (1998).

130. *Gertz*, 418 U.S. at 348.

131. See *Hepps*, 475 U.S. at 777 ("[T]he common-law presumption that defamatory speech is false cannot stand when a plaintiff seeks damages against a media defendant for speech of public concern"; "placement by state law of the burden of proving truth upon media defendants who publish speech of public concern deters such speech because of the fear that liability will unjustifiably result"; and "a private-figure plaintiff must bear the burden of showing that the speech at issue is false before recovering damages for defamation from a media defendant.").

established—that private-figure plaintiffs must show that speech involving a matter of public concern was false before they can recover damages—was defined so as to apply specifically to media defendants.¹³²

The repeated emphasis on media defendants is partly attributable to the fact that the press has more at stake than private citizens—professionally and financially—in defending First Amendment freedoms.¹³³ But beyond its institutional interest, the promotion of vibrant public discourse and the press's role as both agent for the public¹³⁴ and watchdog of the government¹³⁵ support the recognition of the Press Clause as providing guarantees beyond those provided in the Speech Clause. As Justice Potter Stewart noted in a 1974 address at Yale Law School, "If the Free Press guarantee meant no more than freedom of expression, it would be a constitutional redundancy."¹³⁶ Justice Stewart reiterated this view in his 1978 concurring opinion in *Houchins v. KQED*:¹³⁷ "That the First Amendment speaks separately of freedom of speech and freedom of the press is no constitutional accident, but an acknowledgment of the critical role played by the press in American society."¹³⁸ Justice Stewart saw the clause as a structural provision, establishing a Fourth Estate that scrutinizes the workings of government.¹³⁹

All courts should recognize the First Amendment implications of decisions involving the press even when the case does not involve such classic First Amendment issues as defamation or invasion of privacy. Courts hearing Lanham Act cases should follow the same path that the Supreme Court has taken in the field of defamation. Without making explicit distinctions between media and nonmedia defendants, the Court should establish a standard that serves speech interests and that applies at least to members of the media. Thus, when a media defendant is faced with a Lanham Act claim, the court would consider the special role the press plays in fostering public discourse. This would apply whether the defendant is *The New York Times* or the *National Enquirer*, whether the publication is a broadsheet or a tabloid. As the Ninth Circuit noted in *Eastwood*,

132. *See id.*

133. *See* 2 SMOLLA, *supra* note 129, § 22:9.

134. *See* *Richmond Newspapers, Inc. v. Virginia*, 448 U.S. 555, 586 n.2 (1980) (Brennan, J., concurring) (arguing, in a case involving access to a criminal trial, that the "institutional press is the likely, and fitting, chief beneficiary of a right of access because it serves as the 'agent' of interested citizens, and funnels information about trials to a large number of individuals").

135. *See, e.g.*, Vincent Blasi, *The Checking Value in First Amendment Theory*, 1977 AM. B. FOUND. RES. J. 521 (1977).

136. Potter Stewart, *Or of the Press*, 26 HASTINGS L.J. 631, 633 (1975).

137. 438 U.S. 1 (1978).

138. *Id.* at 17.

139. *See* Stewart, *supra* note 136, at 634.

"[T]he size of the page does not diminish the constitutional protection afforded the content."¹⁴⁰

II

APPLYING FIRST AMENDMENT CONSIDERATIONS WIDELY—FROM DEFAMATION TO COPYRIGHT TO SECTION 43(A) OF THE LANHAM ACT

The Supreme Court should guard against claims that chill speech, whatever their guise. In cases such as *New York Times*,¹⁴¹ the Court has recognized conflicting interests between bolstering public discourse and protecting individual reputations but has consistently recognized the overarching need for the constitutional protection of public discourse. In copyright law, free speech interests have won less consideration. This Part addresses both copyright and defamation law and argues that the Court must give greater weight to First Amendment interests in Lanham Act cases. Given the relatively low trial burdens on trademark plaintiffs, and the higher price that defendants may pay by way of injunctions, treble damages, and attorney fees, the societal interest in the free flow of information suffers when courts are fooled by speech-chilling claims dressed in trademark-protection clothing.

A. *The Court's First Amendment Jurisprudence in the Defamation Context Justifies Broader Press Protections Under the Lanham Act*

The Court's approach to defamation in *New York Times v. Sullivan* and beyond offers a window on the application of many of the previously discussed First Amendment arguments involving the press and public discourse. In defamation cases, the balance has already been struck. While the interests in free speech may weigh out differently when confronted with other interests, such as the property interest in copyright law or the property/reputation/consumer interest in trademark law instead of the purely reputational interest at stake in defamation, the fundamental arguments against restraints on the press as the supplier of material for the public discourse are the same. This is especially true when a plaintiff uses a property claim as a vehicle for protecting its reputation.

Defamation law—covering libel and slander—provides a means for plaintiffs to protect their reputations.¹⁴² To succeed against defendants, who, in the strict liability regime of the common law, published at their

140. *Eastwood v. National Enquirer, Inc.*, 123 F.3d 1249, 1252 (9th Cir. 1997); *see also* *Desnick v. American Broad. Cos.*, 44 F.3d 1345, 1355 (7th Cir. 1995) ("Today's 'tabloid' style investigative television reportage . . . constitutes—although it is often shrill, one-sided, and offensive, and sometimes defamatory—an important part of that market [in ideas and opinions]. It is entitled to all the safeguards with which the Supreme Court has surrounded liability for defamation.").

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

142. *See Rosenblatt v. Baer*, 383 U.S. 75, 86 (1966).

peril,¹⁴³ plaintiffs need only show that the defendants published defamatory material that was of and concerning the plaintiffs and that was understood as such by a reader or listener.¹⁴⁴ By bringing suit, plaintiffs seek to vindicate their reputations, to receive compensation for the harm they have suffered, and to deter defendants from further defamation.¹⁴⁵ The Supreme Court has stressed, "The right of a man to the protection of his own reputation from unjustified invasion and wrongful hurt reflects no more than our basic concept of the essential dignity and worth of every human being—a concept at the root of any decent system of ordered liberty."¹⁴⁶ This reputational interest is what half of the *Eastwood*¹⁴⁷ jury's damage award sought to protect in the actor's Lanham Act suit against the *National Enquirer*.

Historically, courts have balanced this protection of reputation with the public interest in free expression and access to information that underlies the First Amendment.¹⁴⁸ In its defamation rulings, the Supreme Court has attempted to accommodate these conflicting values, balancing the need to avoid media self-censorship against the need to compensate people injured by defamation.¹⁴⁹

Rejecting the strict liability regime of common-law defamation, the Court has found the Constitution provides the strongest support for defamation defendants.¹⁵⁰ The Constitution requires a plaintiff who alleges that a defendant published a defamatory statement to prove fault—at a minimum, negligence—on the defendant's part. Private figures face the lower negligence hurdle in order to recover compensatory damages.¹⁵¹ The Court holds public figures and private figures seeking punitive damages to a higher standard. It requires these plaintiffs to prove that the defamatory statement was made with actual malice—that the speaker or publisher

143. See LAURENCE H. ELDREDGE, *THE LAW OF DEFAMATION* § 5 n.47 (1978) (quoting *Rey v. Woodfall*, 98 Eng. Rep. 914, 916 (1774)).

144. See RESTATEMENT (FIRST) OF TORTS §§ 558, 613(1) (1938).

145. See ELDREDGE, *supra* note 143, § 2.

146. *Rosenblatt*, 383 U.S. at 92 (Stewart, J. concurring).

147. *Eastwood v. National Enquirer, Inc.*, 123 F.3d 1249, 1250 n.2 (9th Cir. 1997) (explaining that the jury allocated half of its \$150,000 award for damage to the actor's reputation and half to profits that the *Enquirer* unjustly obtained).

148. See REX S. HEINKE, *MEDIA LAW* § 2.4 (1994 & Supp. 1997).

149. See *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 341 (1974).

150. See *id.* at 348 (noting that the Court's approach "shields the press and the broadcast media from the rigors of strict liability for defamation"); *id.* at 340 (finding that "a rule of strict liability that compels a publisher or broadcaster to guarantee the accuracy of his factual assertions may lead to intolerable self-censorship"); RESTATEMENT (SECOND) OF TORTS § 580B cmt. c (1977).

151. See *Gertz*, 418 U.S. at 347, 350. In dissent, Justice White criticized the opinion for requiring plaintiffs to "prove some further degree of culpable conduct on the part of the publisher, such as intentional or reckless falsehood or negligence." *Id.* at 375-76 (White, J., dissenting).

knew the statement was false or recklessly disregarded whether it was false or true.¹⁵²

The Court has recognized that the purpose of this protection is to provide "breathing space" for freedom of expression. As Justice Brennan held in *New York Times v. Sullivan*, "[C]onstitutional protection does not turn upon 'the truth . . . of the ideas and beliefs which are offered. . . . [E]rroneous statement is inevitable in free debate, and . . . it must be protected if the freedoms of expression are to have the 'breathing space' that they 'need . . . to survive.'"¹⁵³ To let plaintiffs recover against defendants without showing the defamatory statements were false would "only result in a deterrence of speech which the Constitution makes free."¹⁵⁴ The absence of such protection for the press raises the specter of onerous legal defense costs and crushing judgments, both of which would foster an overly cautious press constricted by self-censorship. As the Court noted in *New York Times*, "the pall of fear and timidity imposed upon those who would give voice to public criticism is an atmosphere in which the First Amendment freedoms cannot survive."¹⁵⁵

Given the First Amendment barrier that the Court has erected in defamation cases, plaintiffs try to squeeze their claims against the press into other legal boxes.¹⁵⁶ One of these boxes is section 43(a) of the Lanham Act. While the interests that plaintiffs seek to vindicate may vary—involving such areas as trademark, contract, and tort—courts should pay careful attention to preserving "the free flow of ideas and opinions on matters of public interest and concern."¹⁵⁷ This approach appears in *Hustler Magazine v. Falwell*, in which the Court imported the actual malice standard from the *New York Times* defamation case into an intentional infliction of emotional distress claim.¹⁵⁸ The Court could have been led astray by

152. See *New York Times Co. v. Sullivan*, 376 U.S. 254, 280 (1964). The Court failed to follow the absolutist path laid out by Justices Hugo L. Black and William O. Douglas. They saw the Constitution as "granting the press an absolute immunity for criticism of the way public officials do their public duty." *Id.* at 295 (Black, J., concurring); see also *Gertz*, 418 U.S. at 349.

153. *New York Times*, 376 U.S. at 271-72 (quoting *NAACP v. Button*, 371 U.S. 415, 433 (1963)).

154. *Speiser v. Randall*, 357 U.S. 513, 526 (1958).

155. *New York Times*, 376 U.S. at 278.

156. See Thomas S. Leatherbury, *Media Law: Explosion of Lanham Act Cases*, COMM. LAW., Spring 1996, at 1. Leatherbury lists some causes of actions that plaintiffs have relied on. See *id.* at 17-18 nn.5-7, 9 & 11 (citing *Cohen v. Cowles Media Co.*, 501 U.S. 663 (1991) (breach of contract); *Desnick v. American Broad. Cos.*, 44 F.3d 1345 (7th Cir. 1995) (intrusion); *Scheetz v. Morning Call, Inc.*, 946 F.2d 202 (3d Cir. 1991) (conversion); *Ault v. Hustler Magazine, Inc.*, 860 F.2d 877 (9th Cir. 1988) (intrusion); *Galella v. Onassis*, 487 F.2d 986 (2d Cir. 1973) (intrusion); *Food Lion, Inc. v. Capital Cities/ABC, Inc.*, 887 F. Supp. 811 (M.D.N.C. 1995) (RICO); *Lal v. CBS, Inc.*, 551 F. Supp. 356 (E.D. Pa. 1982) (trespass); *Globe Int'l, Inc. v. Superior Court*, 12 Cal. Rptr. 2d 109 (Ct. App. 1992) (RICO)).

157. *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 50 (1988).

158. See Post, *supra* note 106, at 612 ("[The issue is not that the torts] have different functions and elements. The decisive issue is rather how these elements affect 'the world of debate about public affairs' protected by the Constitution." (quoting *Falwell*, 485 U.S. at 53)).

the manner in which Falwell stated his claim against *Hustler*; it could have disregarded the fact that a successful claim would block the dissemination of ideas. Instead, it recognized the First Amendment interests at stake and applied the actual malice standard. The same recognition should recur in other claims launched against the press. Whether the plaintiff claims harm to a property interest or to reputation, whenever the consequence of the claim would be to restrict public discourse, courts should give First Amendment values the same weight they have given those values in defamation cases.

B. What Plaintiffs Gain by Relying on Section 43(a)

Plaintiffs such as Clint Eastwood who believe the press has harmed their reputations by falsely implying that they endorsed a publication have sought to vindicate their reputations by suing under both defamation law and section 43(a) of the Lanham Act. Given the varying burdens on the plaintiff, statutes of limitations, and available remedies, the choice of causes of action has substantial implications for the type and likelihood of recovery. Artful pleading should not determine whether a plaintiff's claim is time-barred, whether a media defendant is enjoined, or whether the plaintiff's attorney can send the bill to the defendant.

1. Plaintiffs Have Less to Prove

A plaintiff in a defamation case must sustain a significantly higher burden than a plaintiff who pleads a Lanham Act violation. A plaintiff in a defamation action must prove that the communication is defamatory; the defendant published the statement; the statement was about the plaintiff; the listener or reader understood the statement to be defamatory and to be about the plaintiff; and the defendant published it with negligence or actual malice and without a constitutional privilege.¹⁵⁹ After *New York Times v. Sullivan*, public-official plaintiffs must prove actual malice instead of negligence, that is, that the defendant made the statement with knowledge of its falsity or with reckless disregard for the truth.¹⁶⁰ To show reckless disregard, the plaintiff must do more than show the defendant merely failed to investigate the report; the plaintiff must show the publisher acted with "a high degree of awareness of . . . probable falsity" of the statement or had serious doubts as to the truth of the publication.¹⁶¹ The Court soon added public figures to those required to show actual malice.¹⁶² This is a high

159. See RESTATEMENT (SECOND) OF TORTS § 613(1) (1977).

160. See *New York Times*, 376 U.S. at 279-80.

161. See *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 332 (1974) (quoting *St. Amant v. Thompson*, 390 U.S. 727, 731 (1968), and citing *Garrison v. Louisiana*, 379 U.S. 64, 75-76 (1964)).

162. See *Curtis Publ'g Co. v. Butts*, 388 U.S. 130, 164 (1967) (Warren, C.J., concurring). The Chief Justice's concurrence enunciated the standard for public figures that gained the support of a

standard. "[A] public plaintiff is destined to lose a defamation suit despite the falsity of the statement allegedly giving rise to reputational injury, unless the plaintiff proves clearly and convincingly that the defendant knew of the statement's falsity or entertained serious doubts as to its truth."¹⁶³ Private figures do not have to meet such a high standard. But the Supreme Court, in *Gertz v. Robert Welch, Inc.*,¹⁶⁴ held that plaintiffs who were not public figures or public officials must prove at least some degree of fault on the publisher's part.

While strict liability no longer survives in defamation law, it remains the standard under the Lanham Act. The predecessor to Lanham Act section 43(a) required proof of willfulness and intent to deceive, but the current Act requires no such intent.¹⁶⁵ As Professor J. Thomas McCarthy noted, "It was one of the purposes of the drafters of the Lanham Act that section 43(a) remove the requirement of willfulness and intent to deceive contained in the predecessor 1920 Act."¹⁶⁶ In addition, neither proof of actual injury nor proof of actual confusion is necessary for an infringement claim under the current Act.¹⁶⁷ Instead, the plaintiff must show the defendant's message is false or misleading; the misrepresentation is material, i.e., it would influence a purchasing decision; and the misrepresentation was used in commerce. Under the Act, there is no need for the plaintiff to show the defendant knew the message was false. Indeed, courts have even held for plaintiffs who alleged no false factual statement, just a false implication.¹⁶⁸

2. *Plaintiffs Have a Lower Burden of Persuasion*

Plaintiffs in Lanham Act cases also benefit by having to meet a lower burden of persuasion. In defamation actions, public-figure or public-official plaintiffs must prove by clear and convincing evidence that the defamatory statement was made with actual malice.¹⁶⁹ This burden is much greater than the preponderance of the evidence standard in most civil cases.

majority of the Court. See *id.* at 170, 172. That standard was cemented in later opinions. See, e.g., *Gertz*, 418 U.S. at 336 & n.7.

163. Langvardt, *supra* note 49, at 347-48.

164. *Gertz*, 418 U.S. at 347.

165. See, e.g., *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 203 (5th Cir. 1998) (requiring no proof of intent to confuse the public in order to find a likelihood of confusion).

166. 4 McCARTHY, *supra* note 7, § 27:51. Under the 1920 Act, "any person who shall willfully and with intent to deceive . . . use in connection with any article or articles of merchandise . . . a false designation of origin" was liable for damages or an injunction. 41 Stat. 533. The text of 15 U.S.C. § 1125(a) makes no reference to fault.

167. See 4 McCARTHY, *supra* note 7, § 27:18.

168. See *Leatherbury*, *supra* note 156, at 18 n.19 (giving as an example the Vanna White robot case, *White v. Samsung Elecs. America, Inc.*, 971 F.2d 1395 (9th Cir. 1992)). For more details on the elements of a prima facie case under section 43(a)(1)(A) or section 43(a)(1)(B), see Part I.A.3.

169. See *Gertz*, 418 U.S. at 342. In *New York Times*, the standard was the same although phrased differently: convincing clarity. See *New York Times Co. v. Sullivan*, 376 U.S. 254, 285-86 (1964).

The key First Amendment issues at stake, and the risk of chilling the press in cases where news organizations are defendants, justify such a burden.¹⁷⁰ The Court applies the higher burden so that any errors that creep into the judgment favor the defendant.¹⁷¹ In the defamation context, the Court "view[s] an erroneous verdict for the plaintiff as most serious. Not only does it mulct the defendant for an innocent misstatement . . . but the possibility of such error . . . would create a strong impetus toward self-censorship, which the First Amendment cannot tolerate."¹⁷² While *New York Times* makes clear that the Constitution limits when defendants can be held liable, states have opted for different burdens for private-figure plaintiffs in defamation suits. While many states require only the lower showing of preponderance of the evidence,¹⁷³ some states place a higher value on having a press free of self-censorship. Under this blending of the *New York Times* clear and convincing evidence standard with the *Gertz* negligence standard, private individuals suing the media in those states must "prove by clear and convincing evidence that the defendant failed to act reasonably in attempting to discover the truth or falsity or defamatory character of the publication."¹⁷⁴

As an additional safeguard on First Amendment freedoms, defamation claims undergo independent review at the appellate level, all in the interest of ensuring "that the judgment does not constitute a forbidden intrusion on the field of free expression."¹⁷⁵

While the Court specifically rejected the preponderance of the evidence burden for public plaintiffs in defamation actions, plaintiffs, even such public figures as Hollywood celebrities, suing under section 43(a) of the Lanham Act must only meet the lower preponderance of the evidence

170. See Lemley & Volokh *supra* note 11, at 215-16 (noting that requiring clear and convincing evidence of actual malice "reflects the principle that oversuppression of speech is considerably worse than underprotection of the government interest").

171. See, e.g., RONALD J. ALLEN ET AL., EVIDENCE: TEXT, CASES, AND PROBLEMS 830 (2d ed. 1997). "Clear and convincing evidence" has been described as a measure of proof beyond "a mere 'preponderance of the evidence,' but not to the extent of such certainty as is required 'beyond a reasonable doubt' in criminal cases, and which will produce in the mind of the trier of facts a firm belief or conviction as to the facts sought to be established." *Lansdowne v. Beacon Journal Publ'g Co.*, 512 N.E.2d 979, 984 (Ohio 1987) (quoting *Cross v. Ledford*, 120 N.E.2d 118 (Ohio 1954)).

172. *Gertz*, 418 U.S. at 366-67 (Brennan, J., dissenting) (quoting *Rosenbloom v. Metromedia, Inc.*, 403 U.S. 29, 50 (1971)).

173. See, e.g., *Weldy v. Piedmont Airlines, Inc.*, 985 F.2d 57, 65 (2d Cir. 1993) (concluding that New York courts would require private-figure plaintiffs to prove malice by a preponderance of the evidence); *Chang v. Michiana Telecasting Corp.*, 900 F.2d 1085, 1087 (7th Cir. 1990) (noting that an Alaska court has rejected that private figures must prove actual malice by clear and convincing evidence); *Lothschuetz v. Carpenter*, 898 F.2d 1200, 1205 n.4 (6th Cir. 1990) (noting that District of Columbia law requires private-figure defamation plaintiffs to prove negligence by a preponderance of the evidence).

174. *Brooks v. American Broad. Cos.*, 999 F.2d 167, 171 (6th Cir. 1993) (quoting *Lansdowne*, 512 N.E.2d at 984 (1987)) (applying Ohio law).

175. *New York Times Co. v. Sullivan*, 376 U.S. 254, 285 (1964).

standard.¹⁷⁶ Thus, in proving the likelihood of consumer confusion, plaintiff's evidence need only show there is more than a fifty percent chance that the likelihood of confusion claim is true.

Circuit courts differ regarding the standard of review for determinations of likelihood of confusion. The Second Circuit will reverse lower court determinations on the individual factors in a likelihood-of-confusion test only if the findings are clearly erroneous; the balancing of the factors, however, is reviewed *de novo*.¹⁷⁷ The Ninth Circuit, by contrast, applies only the clearly erroneous standard.¹⁷⁸

3. *Plaintiffs May Have a Longer Statute of Limitations*

Defamation law varies from state to state, as do the accompanying statutes of limitations. Most states, however, provide for short statutes of limitations on defamation claims. In California, for example, defamation claims must be brought within a year.¹⁷⁹ The longest statute of limitations for defamation is three years.¹⁸⁰

The Lanham Act specifies no particular statute of limitations. Courts applying the Act adopt the state-law statute that best serves the federal policy.¹⁸¹ In practice this has ranged up to six years. In New York, for example, where a defamation plaintiff would have to bring a claim within a year, if the plaintiff brought a Lanham Act claim, the time would be (and has been) three years if the court sees a state damage-to-property claim as most similar to the Federal Lanham Act claim; it would stretch (and has stretched) up to six years in cases in which the court sees state fraud statute of limitations as best serving the federal policy.¹⁸² Thus, if a plaintiff succeeds in cloaking a defamation claim as a Lanham Act claim, the one-year limit could grow sixfold.

4. *Plaintiffs Have a Broader Array of Remedies*

Once a claim lands in the property box, the court can apply remedies, such as injunctions, that are rarely allowed in the First Amendment context. Because "liberty of the press, historically considered and taken up by the Federal Constitution, has meant, principally although not exclusively, immunity from previous restraints or censorship," only exceptional

176. See 3 McCARTHY, *supra* note 7, § 23:62.

177. See *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.3d 1033, 1043 (2d Cir. 1992).

178. See *Pacific Telesis Group v. International Telesis Communications*, 994 F.2d 1364 (9th Cir. 1993).

179. See CAL. CIV. PROC. CODE § 340 (West 1982). Such other jurisdictions as New York, Washington, D.C., Illinois, and Arizona also have one-year limits. See, e.g., ARIZ. REV. STAT. ANN. § 12-541 (West Supp. 1998); D.C. CODE ANN. § 12-301(4) (1981); 735 ILL. COMP. STAT. ANN. 5/13-201 (West 1992); N.Y. C.P.L.R. § 215 (McKinney 1990).

180. See, e.g., N.H. REV. STAT. ANN. § 508.4 (1955).

181. See 4 McCARTHY, *supra* note 7, § 27:48.

182. See 4 *id.* § 27:48 n.2.

circumstances, such as reporting on troop location during wartime, will permit the state to prevent publication.¹⁸³ The First Amendment thus limits plaintiffs' remedies to post-publication punishment, not pre-publication restraint.

In defamation cases, financial remedies fall into four basic groups: nominal (where no substantial injury was proved), general (covering damages to reputation), special (covering actual out-of-pocket losses), and punitive.¹⁸⁴ In California, for example, general damages are damages that necessarily result from the defamation and that compensate the plaintiff for damages resulting from loss of reputation. Special damages, which are natural but not necessary consequences of the defamation, include business losses that the plaintiff alleges and proves.¹⁸⁵ In California, the plaintiff can recover punitive damages only by proving the defamatory statement was made with a "state of mind arising from hatred or ill will toward the plaintiff."¹⁸⁶

Remedies available to successful Lanham Act plaintiffs are much broader. While most cases involving the publication of news prohibit injunctions as impermissible prior restraints on the press, the Lanham Act allows for injunctions for any violation of section 43(a).¹⁸⁷ Plaintiffs in section 43(a) false advertising cases, for example, may get an injunction if they prove the defendants' false statements had a tendency to deceive the defendants' audience.¹⁸⁸ Proof of actual confusion is not necessary unless the plaintiff is seeking monetary damages,¹⁸⁹ so the plaintiff can succeed in

183. *Near v. Minnesota*, 283 U.S. 697, 716 (1931). See also *New York Times Co. v. United States*, 403 U.S. 713 (1971) (Pentagon Papers Case), where the justices' opinions range from never enjoining the publication of news (Justices Black and Douglas), to allowing restraining orders only in extraordinary circumstances, such as the troop movement example in *Near* (Justices Brennan, White, Stewart and Marshall), to allowing prior restraint in broader circumstances, such as was the case here, where the government sought to enjoin *The New York Times* and *The Washington Post* from publishing the contents of "History of U.S. Decision-Making Process on Viet Nam Policy" (Chief Justice Burger and Justices Harlan and Blackmun). Among the statements, Justice Douglas: "It should be noted at the outset that the First Amendment provides that 'Congress shall make no law . . . abridging the freedom of speech, or of the press.' That leaves, in my view, no room for governmental restraint on the press." *Id.* at 720 (Douglas, J., concurring). Justice Brennan: "[T]here is a single, extremely narrow class of cases in which the First Amendment's ban on prior judicial restraint may be overridden. Our cases have thus far indicated that such cases may arise only when the nation 'is at war.'" *Id.* at 726 (Brennan, J., concurring). Justice White: "Prior restraints require an unusually heavy justification under the First Amendment; but failure by the Government to justify prior restraints does not measure its constitutional entitlement to a conviction for criminal publication." *Id.* at 733 (White, J., concurring).

184. See ELDREDGE, *supra* note 143, § 95.

185. See CAL. CIV. CODE § 48a (West 1982).

186. See CAL. CIV. CODE § 48a(4)(d) (West 1982).

187. See 15 U.S.C. § 1116(a) (1994) (giving courts "power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent . . . a violation under section 1125(a) of this title"). Professors Lemley and Volokh have found injunctions to be "the most important remedy in trademark cases." Lemley & Volokh, *supra* note 11, at 216.

188. See Langvardt, *supra* note 49, at 321 n.52.

189. See *id.*

the equitable remedy of enjoining publication merely by showing the defendant's message has a tendency to deceive consumers. There are restrictions on the availability of injunctive relief for unauthorized copying of a registered trademark when the defendant is a publisher or distributor of a newspaper, magazine, or similar periodical, but those restrictions are limited. They apply only if the publisher is an innocent infringer—that is, the publisher or broadcaster ran an infringing advertisement without knowing the ad was intended to be deceptive or cause confusion or if the injunction would delay publication.¹⁹⁰

Critics in the copyright field have attacked as nonsensical “[h]aving a doctrine in free speech law that severely limits the use of prior restraints, only to throw it all out whenever even a small amount of someone else’s expression has been incorporated into the defendant’s speech.”¹⁹¹ This view should translate to section 43(a) of the Lanham Act. There, the use of another’s trademark—which should be protected only to the extent there is consumer confusion, the *raison d’être* of trademark law—tears down the First Amendment antagonism toward prior restraint and opens the way to enjoining publications. Nevertheless, courts below the Supreme Court have given little weight to the First Amendment concerns about prior restraint in the context of intellectual property rights, instead seeing the restraints as content-neutral.¹⁹² Indeed, injunctions are the standard remedy in trademark cases because the damages from infringement are considered irreparable.¹⁹³

Beyond injunctive relief, Lanham Act plaintiffs can go for a few dollars more and recover a broad array of damages under 15 U.S.C. § 1117.¹⁹⁴ These include treble damages, costs, and the defendant’s profits from the information. In *Eastwood*, \$75,000 of the \$150,000 damage award was for profits that the *Enquirer* was found to have unjustly obtained. The other \$75,000 was to compensate for damage done to Eastwood’s reputation.¹⁹⁵

190. See 15 U.S.C. §§ 1114(2)(B), 1114(2)(C) (1994).

191. Zimmerman, *supra* note 75, at 737. Professor Zimmerman makes the point that since economics justifies protecting intellectual property rights, the remedy should likewise be economic: compensatory damages. See *id.* at 738.

192. See 2 MCCARTHY, *supra* note 37, § 8.3[A]. Professor Robert Post notes a metamorphosis in the courts’ aversion to prior restraints: Once speech is defined as property, “the routine injunction against communication that would ordinarily be regarded as a highly disfavored prior restraint is routinely tolerated.” Robert C. Post, *Rereading Warren and Brandeis: Privacy, Property, and Appropriation*, 41 CASE W. RES. L. REV. 647, 665 n.94 (1991). For a good discussion on why intellectual property laws may be viewpoint-neutral but are certainly not content-neutral, see Lemley & Volokh, *supra* note 11, at 183.

193. See 5 MCCARTHY, *supra* note 7, § 30:2. This is the standard in the Ninth Circuit. See *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1180 (9th Cir. 1988) (noting that “[i]njunctive relief is the remedy of choice for trademark and unfair competition cases, since there is no adequate remedy at law for the injury caused by a defendant’s continuing infringement”).

194. 15 U.S.C. § 1117 (1994).

195. See *Eastwood v. National Enquirer, Inc.*, 123 F.3d 1249, 1250 n.2 (9th Cir. 1997).

In "exceptional" cases the prevailing party may get attorney's fees.¹⁹⁶ This depends on bad faith on the part of the defendant in infringing or of the plaintiff in bringing the suit, the extent of the infringement, the degree to which the plaintiff was injured, and parties' conduct during litigation. The *Eastwood* case highlights the effect of the Lanham Act's allowance for attorney's fees: Of his \$803,156 award, \$653,156 was an award of attorney's fees. The lower court awarded the fees pursuant to the Lanham Act and the California misappropriation statute in *Eastwood*'s claim.¹⁹⁷

The opportunity for injunctive relief—an opportunity that is absent in defamation cases—plus the potential to receive attorney's fees and compensatory damages three times above actual damages rewards plaintiffs who can characterize their claims against the press as section 43(a) claims. They thus can short-circuit the system the Court has constructed in other areas to protect speech.

C. *The First Amendment, Copyright Law, and the Propertization of Information*

1. *The Dangers of Expression as Property*

The Lanham Act is not alone in limiting the supply of information available as a common resource by taking that information and defining it as private property. Nor should it be alone in being seen as a restriction on speech, despite its property-rights mantle. Copyright law also has been used to move information out of the public domain and into the private sphere, where it creates wealth for the property owner instead of enriching public discussion.¹⁹⁸ This places dollars over discourse. As New York University law professor Diane Leenheer Zimmerman wrote, "What Justice Holmes later referred to as a marketplace of ideas presumably was conceived of as a place of free exchange, not of economic or contractual transactions."¹⁹⁹

Whereas classifying a defamation plaintiff as a public figure almost guarantees that the plaintiff will lose, classifying information as property, and not as protected speech, goes far toward securing the plaintiff's

196. See 15 U.S.C. § 1117 (1994); see also *Bagdasarian Prods. v. Audiofidelity Enters., Inc.*, 225 U.S.P.Q. (BNA) 53 (1984) (finding infringement of the plaintiff's Chipmunks (as in Alvin, Simon, and Theodore) trademark).

197. See *Eastwood*, 123 F.3d at 1250-51. California's misappropriation statute provides that the prevailing party shall be entitled to attorney's fees. See CAL. CIV. CODE § 3344 (West 1982 & Supp. 1999).

198. See Zimmerman, *supra* note 75, at 665-67 (arguing that "an ever-expanding array of new or reconstructed property theories is cannibalizing speech values at the margin"). Zimmerman attributes this property theory expansion to the courts' failure to "think critically about the justifications for, functions of, and limitations on property rules in the sensitive arena of speech" and to the clearer benefits in property rights as opposed to the more abstract benefits of free speech. *Id.* at 667, 673.

199. *Id.* at 679.

victory.²⁰⁰ If the plaintiff can successfully plead a property theory, her future looks rosy; if the defendant can successfully present the same case as an effort to squash free speech, the picture changes dramatically.²⁰¹ It all depends on which box the case falls into.

A focus on property rights has allowed the holder of the property right to suppress political and personal criticism and block the media from exposing damaging information, thus chilling free speech.²⁰² Within the realm of the rights of publicity, critics of a broad reading for those rights note that rights of publicity give a celebrity the power to suppress divergent images of the celebrity and thus limit others' First Amendment right of expression.²⁰³ When property rights obstruct public discourse, they compromise the constitutionally protected debate about public affairs.²⁰⁴ Thus, courts should hesitate before supporting such claims—especially claims of infringement of a trademark, which “is not nearly so secure an entitlement as a property right”²⁰⁵—when First Amendment interests are at stake.

200. See *id.* at 668.

201. See *id.* at 669; see also Post, *supra* note 192, at 665 n.94 (citing *Florida Star v. B.J.F.*, 491 U.S. 524 (1989), *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985), *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 578 (1977), and *Cox Broad. Corp. v. Cohn*, 420 U.S. 469 (1975), to demonstrate that the Court is more hostile to restrictions on speech arising from privacy and defamation claims than it is to restrictions arising from property-based rationales for protecting personality).

202. See Netanel, *supra* note 112, at 294-95 (providing as an example a case, *Belmore v. City Pages Inc.*, 34 U.S.P.Q.2d (BNA) 1295 (D. Minn. 1995), in which a police officer filed a copyright infringement suit against a newspaper to block it from reporting on his racist fable that was published within the police department). Netanel argues for a copyright regime that limits the proprietization of publicly disseminated expression and furthers democratic self-rule by being “broad enough to assure the independence and vitality of civil society’s communicative sphere, but not so broad as to smother expressive diversity.” *Id.* at 363, 386.

203. See Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 125, 145-46 (1993).

204. See Post, *supra* note 192, at 669 n.119 (citing *Rogers v. Grimaldi*, 695 F. Supp. 112, 121 (S.D.N.Y. 1988), and *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978), among others, as examples of circumstances in which giving weight to property rights might “seriously interfere with the practical functioning of public discourse”).

205. *Illinois High Sch. Ass’n v. GTE Vantage Inc.*, 99 F.3d 244, 246 (7th Cir. 1996) (citing *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924); *Door Sys., Inc. v. Pro-Line Door Sys., Inc.* 83 F.3d 169, 173 (7th Cir. 1996)). The court characterized a trademark as less a property right than a designation of source. See *id.* The Supreme Court recently put the strength of property rights in the Lanham Act’s false-advertising provisions on tenuous ground. See *College Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 119 S. Ct. 2219 (June 23, 1999) (noting, in an Eleventh Amendment decision finding no deprivation of property in an unfair competition case against a Florida state entity, that while trademarks “are the ‘property’ of the owner because he can exclude others from using them. . . . The Lanham Act’s false-advertising provisions, however, bear no relationship to any right to exclude.”). The plaintiff in that case had argued that the state entity made false claims about its own product.

2. *Property Interests in Copyright*

Rooted in the constitutional grant of power to Congress “to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries,”²⁰⁶ copyright law in the United States seeks to balance the public benefit from authors’ creativity against the need to provide an economic incentive for such creation.²⁰⁷ While copyright law is “the most comprehensive scheme of property rights in forms of expression,”²⁰⁸ the “Framers intended copyright itself to be the engine of free expression.”²⁰⁹ The law attempts to foster creation by giving copyright owners exclusive rights to reproduce the work, prepare derivative works, distribute copies of the work, and publicly perform or display the work.²¹⁰ Copyright owners may transfer any of these rights²¹¹ and may enjoin, seek attorney’s fees, or seek actual or statutory damages from anyone who violates their bundle of rights.²¹² But while these exclusive rights extend to “original works of authorship fixed in any tangible medium of expression,” a fundamental limit on copyright owners is that they can receive no copyright protection for ideas.²¹³

Even with that limit, copyright owners are in a position to suppress expression. Professor Paul Goldstein has described two types of monopoly that flow from copyright law. The Copyright Act grants a statutory monopoly, which allows the copyright holder to regulate the timing and price for public access to the work.²¹⁴ Enterprise monopoly, “built on pyramids of individual copyrights,” goes beyond this to control the content of works to which the public has access.²¹⁵ A 1966 lawsuit against Random House is an example of an attempt at enterprise monopoly.²¹⁶ One of Howard Hughes’ holding companies bought up the rights to a series of

206. U.S. CONST. art I, § 8, cl. 8.

207. See Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180, 1186 (1970). Professor Netanel has described what is at stake if these interests become unbalanced:

If copyright is cast too narrowly, authors may have inadequate incentives to produce and disseminate creative works or may be unduly dependent on the support of state or elite patrons. If copyright extends too broadly, copyright owners will be able to exert censorial control over critical uses of existing works or may extract monopoly rents for access, thereby chilling discourse and cultural development.

Netanel, *supra* note 112, at 285. Netanel sees copyright’s purpose as “underwrit[ing] political competency, with allocative efficiency a secondary consideration.” *Id.* at 364.

208. Denicola, *supra* note 20, at 190 n.146.

209. Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 558 (1985).

210. See 17 U.S.C. § 106(1)-(5) (1994).

211. See *id.* § 201.

212. See *id.* §§ 501-505.

213. See *id.* § 102.

214. See Goldstein, *supra* note 112, at 985-86.

215. *Id.* at 986.

216. See *Rosemont Enters., Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966).

articles in two magazines on the life of the reclusive entrepreneur. With copyrights in hand, it tried to enjoin Random House from publishing a biography on Hughes, accusing the publisher of copying from the articles. The Second Circuit panel saw through this ploy and vacated a preliminary injunction against Random House.²¹⁷ The concurring opinion noted that Hughes' company was not using the copyright "to protect the value of the original writing but to suppress the Random House biography because Hughes wished to prevent its publication."²¹⁸ This intent to suppress, coupled with the aggregation of copyrights, exemplifies the "private hegemony" that marks copyright enterprise.²¹⁹

3. *Copyright Law's Attempt to Accommodate First Amendment Concerns*

Copyright law restricts speech via its statutory monopoly, but it makes some effort to account for First Amendment values. The trademark law regime should follow copyright's lead and build in protection for First Amendment interests. This section introduces copyright law's accommodation attempts and lays the groundwork for the next section, which considers the portability of copyright's approach into trademark law.

Against copyright's promotion of "the useful arts," which it attempts to achieve by giving authors proprietary rights in expression, lies the First Amendment's promotion of a vibrant public discourse, which it attempts to achieve by allowing "no law . . . abridging the freedom of speech, or of the press."²²⁰ Despite being "the uniquely legitimate offspring of censorship,"²²¹ copyright has attempted to accommodate First Amendment concerns by distinguishing between expression, over which authors may have exclusive rights, and ideas, which belong to no one. The Supreme Court has held that "First Amendment protections [are] already embodied in the Copyright Act's distinction between copyrightable expression and uncopyrightable facts and ideas."²²² Professor Melville Nimmer also found this "definitional balance under which ideas per se fall on the free speech side of the line, while the statement of an idea in specific form, as well as the selection and arrangement of ideas fall on the copyright side of the line" a sufficiently acceptable balance.²²³

This idea-expression distinction, however, does not always fully address First Amendment concerns. First, judges have discretion in

217. See *id.* at 311.

218. *Id.* at 313 (Lumbard, J., concurring).

219. Goldstein, *supra* note 112, at 987. More recent cases allow precisely such suppression, especially where unpublished works have been copied. See, e.g., *New Era Pubs. Int'l v. Henry Holt & Co.*, 873 F.2d 576 (2d Cir. 1989); *Salinger v. Random House, Inc.*, 811 F.2d 90 (2d Cir. 1987).

220. U.S. CONST. amend. I.

221. Goldstein, *supra* note 112, at 983.

222. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985).

223. Nimmer, *supra* note 207, at 1190.

deciding what falls onto the unprotected idea side and what falls onto the protected expression side. This discretion creates uncertainty, and such uncertainty over whether speech is protected tends to chill speech.²²⁴ Moreover, at times, free access to the idea alone will not be sufficient; it is the expression that will most contribute to the public discourse.²²⁵

The Copyright Act has attempted to compensate for such failings of the idea-expression distinction with the fair use defense. The statute spells out four factors to consider in determining whether the use of copyrighted material was fair: (1) the purpose and the character of the use, including commercial use; (2) the nature of the copyrighted work; (3) the amount used relative to the full copyrighted work; and (4) the effect on the market for the copyrighted work.²²⁶

Justice Brennan, dissenting in *Harper & Row*,²²⁷ lamented that the "progress of arts and sciences and the robust public debate essential to an enlightened citizenry are ill served by [the majority's] constricted reading of the fair use doctrine."²²⁸ But, read narrowly or broadly, the doctrine does not expressly weigh the First Amendment interests in public discourse. That lack of express allowance for First Amendment interests has sparked a recognition among some commentators of the need for a separate First Amendment defense to copyright infringement.²²⁹ This recognition has gained some support in the federal judiciary. For example, the court for the Southern District of Florida has expressly stated the preeminence of the First Amendment. In *Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc.*,²³⁰ the court found no fair use in the *Miami Herald's* use of a copy of *TV Guide* in its promotions for its own television guide. The court based its finding of no fair use on the *Herald's* commercial purpose.

224. See Zimmerman, *supra* note 75, at 709 (finding the uncertainty tolerable as a matter of copyright policy but less tolerable as a matter of free speech policy).

225. See Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 CALIF. L. REV. 283, 293 (1979); Nimmer, *supra* note 207, at 1198 (citing the Zapruder film of John F. Kennedy's assassination and photographs of the massacre at My Lai during the Vietnam War as examples of when "it was only the expression, not the idea alone, that could adequately serve the needs of an enlightened democratic dialogue").

226. See 17 U.S.C. § 107 (1994).

227. *Harper & Row*, 471 U.S. at 539.

228. *Id.* at 579 (Brennan, J., dissenting).

229. See, e.g., Denicola, *supra* note 225, at 316 ("The ultimate response to the confrontation between free speech and copyright should be the recognition of an independent first amendment privilege."); Jessica Litman, *Copyright and Information Policy*, 55 LAW & CONTEMP. PROBS. 185, 208 (1992) ("[P]erhaps we could stop clinging to the notion that copyright law needs no first amendment adjustment because its internal limitations ensure the broad dissemination of information and ideas, and introduce explicit first amendment limitations into copyright infringement suits."); Netanel, *supra* note 112, at 303 ("As copyright has evolved, its internal limitations on copyright owner prerogatives have themselves been vitiated by copyright expansionism. As a result, the copyright law safeguards that have made First Amendment defenses seem overly intrusive and unnecessary have in fact been only sporadically effective in protecting First Amendment values.").

230. 445 F. Supp. 875 (S.D. Fla. 1978).

It then went on to find that the *Herald's* comparative advertising campaign was protected commercial speech. The decision for the defendant was based on the view that when the First Amendment and the Copyright Act "operate at cross-purposes, the primacy of the First Amendment mandates that the Copyright Act be deprived of effectuation."²³¹ On appeal, the Fifth Circuit also found for the defendants but on the grounds that the ads amounted to a fair use of *TV Guide*; the majority expressly did not reach the issue of the First Amendment as a defense to copyright infringement.²³² In a separate dissent, the author of the appellate court's opinion wrote that "the First Amendment will rarely prevail over a copyright interest."²³³ Another judge on the panel concurred separately to stress that if fair use had not provided the *Herald* with a defense, then the First Amendment would have.²³⁴ Thus, the district court's recognition of a First Amendment defense was never overruled (even though it was also not embraced).

In attempting to give more weight to the First Amendment in copyright decisions, Professor Robert C. Denicola has proposed a test requiring a case-by-case determination of the defendant's need to use the copyrighted material. In his view, if the defendant cannot exercise the right to free speech and contribute to the public discourse without using the copyrighted expression and if there is no copyright defense to such use, then the First Amendment should provide a privilege to use the expression.²³⁵

4. *Importing Copyright's Accommodation of First Amendment Interests into Trademark Law*

The First Amendment considerations and the push for a separate First Amendment defense that appear in copyright law should weigh heavily in trademark law as well. Unlike the property rights in copyright, the property interests in trademark are limited by the consumer confusion at issue and include a collateral protection for the reputation of the trademark owner's product.²³⁶ Nevertheless, both areas raise similar First Amendment concerns. Only the competing interests—in copyright, property rights and in trademark, consumer confusion, for example—differ.

The Lanham Act contains a statutory fair use defense, which allows the use of a name or term, other than as a trademark, so long as it is "descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin."²³⁷ This defense

231. *Id.* at 882.

232. *See Triangle Publications, Inc., v. Knight-Ridder Newspapers, Inc.*, 626 F.2d 1171, 1178 (5th Cir. 1980).

233. *Id.* at 1182 (Brown, J., dissenting).

234. *See id.* at 1184 (Tate, J., concurring).

235. *See Denicola, supra* note 225, at 316.

236. *See supra* notes 9-14 and accompanying text.

237. 15 U.S.C. § 1115(b) (1994).

applies when the defendant uses another's trademark to describe the defendant's own product or service.²³⁸ Thus, a trademark holder cannot take a descriptive term, make it its trademark, and forbid everyone else from using that term to describe their own goods. Others may always use the term descriptively, though they may not use it as a trademark.²³⁹

The traditional fair use defense would have little application in the context of editorial content, since news stories do not need to describe themselves. The Ninth Circuit's twist on the fair use defense in *New Kids on the Block*²⁴⁰ has provided a defense to media use of trademarks. The nominative fair use defense involves a non-trademark use of the plaintiff's mark. It allows a defendant to use the plaintiff's mark to describe the plaintiff's product or service so long as the product or service is not readily identifiable without using the trademark, the mark is only used to the extent necessary to identify the product or service, and the defendant does not imply sponsorship or endorsement. This allows others to use trademarks freely to refer to the trademark holder.²⁴¹

The defenses of statutory fair use and non-trademark use help keep trademark holders from creating a monopoly on certain words and phrases. But, given that the Lanham Act continues to be used to limit speech, courts should routinely recognize First Amendment considerations.

III

WHY SECTION 43(A) OF THE LANHAM ACT SHOULD NOT APPLY TO CLAIMS BASED ON NEWS-BASED, NONADVERTISING CONTENT IN THE COMMUNICATIONS MEDIA

The news content of newspapers and magazines rests securely in the top level in the hierarchy of First Amendment protections.²⁴² Allowing plaintiffs to succeed in using section 43(a) of the Lanham Act to restrict the dissemination of that news encroaches on the First Amendment goal of promoting the free exchange of ideas and information. As trademark authority Professor J. Thomas McCarthy summarized:

The unauthorized use of a trademark on commercial products is clearly commercial speech which will usually receive little if any Constitutional immunity from the normal rules of liability. But the

238. See *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1185 (5th Cir. 1980) (finding fair use where defendant used the term "larvicide" as a descriptive term on its own product and plaintiff had trademark of "Larvacide"); *National Fed'n of the Blind, Inc. v. Loompanics Enters., Inc.*, 936 F. Supp. 1232 (D. Md. 1996) (finding no fair use where defendant used plaintiff's mark to refer to plaintiff's business and not to defendant publisher's goods).

239. See 2 MCCARTHY, *supra* note 7, §§ 11.45-47.

240. *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 308 (9th Cir. 1992).

241. The New Kids on the Block cannot prevent others from using that mark to describe the band. Volkswagen cannot block an auto repair shop from using the VW mark to describe the cars that it repairs. See *id.* at 306.

242. See *supra* note 102.

unauthorized use of a trademark in the course of communicating a message in a traditional communications medium such as a newspaper, magazine, radio or television is a different matter. In most such communicative uses, the policy of free speech is more potent and is to be weighed against the policies of preventing consumer confusion and deception.²⁴³

The need to give weight to First Amendment interests is great when plaintiffs use the Lanham Act to reach beyond the advertising context and target news outlets because of their editorial content. As shown in Part I.A above, plaintiffs suing media defendants have used the Lanham Act instead of the more plaintiff-hostile defamation law to seek remedies for alleged damage to their reputations from editorial, not advertising, copy. In the *Eastwood* case, the Ninth Circuit held that the scope of section 43(a) reached beyond commercial speech to cover a newspaper's false statement in a headline and "exclusive" story label.²⁴⁴ The court agreed that fans could see Eastwood as hypocritical and washed-up for talking to the tabloid and that Eastwood's reputation was harmed because of it. But the "exclusivity equals endorsement" argument has not always fared so well for celebrities. In *Cher v. Forum International, Ltd.*,²⁴⁵ the court rejected Cher's claim that the suggestion—in headlines and cover promotion of an "Exclusive Series" with Cher—that she would grant an exclusive interview to the tabloid *Star* had degraded her celebrity image. Nor did similar conduct on *Forum*'s part give rise to liability. Only *Forum*'s separate advertising campaign resulted in it being liable for falsely implying Cher endorsed *Forum*. This result stays true to First Amendment jurisprudence that provides less protection to commercial speech such as advertising while striving to keep noncommercial speech unhindered and free to contribute to public discussion.

A. *The Distinction Between Media Use and Commercial Use Serves to Bar Section 43(a)(1)(B) False Advertising Claims*

Because section 43(a)(1)(B) of the Lanham Act requires the misleading description or representation of fact to occur in commercial advertising or promotion, the editorial content of newspapers, magazines, and other media communications clearly falls outside the scope of the Act. If the media's use of a trademark or celebrity name can be tied to the dissemination of news, courts should protect that use and reject plaintiffs' Lanham Act claims. Media use, as opposed to commercial use, of a person's identity involves use that has a reasonable relationship with the normal content of the media—news, commentary, fiction, and entertainment. Commercial

243. 5 McCARTHY, *supra* note 7, § 31:147.

244. *See Eastwood v. National Enquirer, Inc.*, 123 F.3d 1249 (9th Cir. 1997).

245. 692 F.2d 634 (9th Cir. 1982).

use, on the other hand, involves identification of a person in an advertisement or promotion in connection with goods.²⁴⁶ These two uses overlap when newspapers or books advertise themselves. But courts have held that advertising for a media use that is protected under the First Amendment does not drop into the less-protected commercial speech category; instead it shares the constitutional protection of the media use itself.²⁴⁷

Media defendants should be aware of limits on this ancillary protection afforded to advertising. If the advertisement—the commercial speech—falsely implies that the person actually endorsed the publication, the publication could be liable under a section 43(a) false advertising claim. Another limit arises when the commercialization is removed from the news aspect. Pure advertising speech does not receive the level of protection afforded speech that is linked with the dissemination of news. For example, a New York court held in an invasion of privacy case that while a public figure may be the proper subject of news, the right to use the figure's identity in a news context does not extend to commercialization of public figures "through a form of treatment distinct from the dissemination of news or information."²⁴⁸

In order to give full benefit to First Amendment protections, courts should properly place the line dividing use for news value as opposed to use for commercial value. As the Ninth Circuit noted in *Midler v. Ford Motor Co.*,²⁴⁹ a non-Lanham Act case in which Ford hired a Bette Midler sound-alike to sing for a commercial, the importance of freedom of speech entitles the media to use a person's identity for informative or cultural purposes. But if the use "serves no such function but merely exploits the individual portrayed, immunity will not be granted."²⁵⁰ "Exploiting" a celebrity's image for news purposes is fully protected because news itself is free; it is neither copyrightable nor trademarkable. As First Amendment authority Rodney Smolla noted, "to give individuals property rights in their news value as personalities would make a free press impossible. A free press is dependent on 'free' news; those who make the news necessarily surrender part of themselves to the public domain."²⁵¹

246. See 2 MCCARTHY, *supra* note 37, § 7.1[A].

247. See 2 *id.* §§ 7.5[B][1], 8.8[F][2].

248. *Gautier v. Pro-Football, Inc.*, 107 N.E.2d 485, 488 (N.Y. 1952) (holding that plaintiff animal trainer's name or picture were not used for advertising purposes where his performance during a football game halftime show was broadcast between commercials).

249. 849 F.2d 460 (9th Cir. 1988)

250. *Id.* at 462 (quoting *Felcher & Rubin*, *supra* note 102, at 1596). The court allowed Midler's suit to go forward against Ford over the appropriation of her identity, her voice. See *Midler*, 849 F.2d at 463.

251. RODNEY A. SMOLLA, *SUING THE PRESS* 129 (1986).

Included in the acceptable "exploitation" for news value are promotions that illustrate the quality and content of the news publication.²⁵² Thus *Sports Illustrated* was allowed to reproduce a photograph of Joe Namath from its post-Super Bowl issue for an ad campaign.²⁵³ A New York state court held that the reproduction of Namath's picture was permissible as an illustration of the magazine's quality and content. California courts followed this view in another quarterback-wins-the-Super-Bowl case, *Montana v. San Jose Mercury News, Inc.*²⁵⁴ That case arose after the *Mercury News* sold a poster reproduction of its front page coverage of the 49ers' 1990 Super Bowl win. The court held that the poster was an advertisement of the newspaper's quality and content and thus exempt from California's right of publicity laws.²⁵⁵

Like the picture of Joe Namath and the poster of Joe Montana, headlines, magazine cover displays, and newspaper "skyboxes" (those blurbs at the top of the front page that alert readers to select stories throughout the paper and are designed to entice passers-by who glance into newsboxes) fall into the informative category. Such elements of a publication must be protected as part of the dissemination of news. If they were not, then succeeding waves of journalistic promotional developments that straddle the line between being stories in their own right and being teasers to other stories—such as the front-page "billboards," very short stories, often with art, that some newspapers use to pull readers into the full story inside—could be denied protection.

While celebrity plaintiffs may argue that using their images on magazine covers or front-page skyboxes betrays the publishers' commercial motives to pump up circulation, the Court repeatedly has held that the broad First Amendment protections that cover noncommercial news content are not withdrawn just because newspapers and other magazines operate for profit.²⁵⁶ What counts is the content of the article, not the publisher's circulation-boosting motives.²⁵⁷

252. See, e.g., *Cher v. Forum Int'l, Ltd.*, 692 F.2d 634, 638 (9th Cir. 1982) (holding that "*Star* was entitled to inform its readers that the issue contained an article about Cher, that the article was based on an interview with Cher herself, and that the article had not previously appeared elsewhere").

253. See *Namath v. Sports Illustrated*, 371 N.Y.S.2d 10 (App. Div. 1975); see also SMOLLA, *supra* note 251, at 130.

254. 40 Cal. Rptr. 2d 639 (Ct. App. 1995).

255. State right of publicity laws, while providing for intellectual property rights in personal identity, do not duplicate section 43(a) of the Lanham Act, which requires some level of falsity or misrepresentation. Lanham Act claims may accompany right of publicity claims, though, since in many cases "the unpermitted use of one's persona will in addition to infringing upon the Right of Publicity also infringe trademark or service mark rights in personal identity and/or involve elements of false endorsement." 1 MCCARTHY, *supra* note 37, § 6.16[B].

256. See *Harte-Hanks Communications, Inc. v. Connaughton*, 491 U.S. 657, 667 (1989) ("If a profit motive could somehow strip communications of the otherwise available constitutional protection, our cases from *New York Times to Hustler Magazine* would be little more than empty vessels."); *New York Times Co. v. Sullivan*, 376 U.S. 254, 266 (1964)); 2 MCCARTHY, *supra* note 37, § 8.8[F][1]

Importing these approaches into Lanham Act cases, courts should take a broad view of what material is tied to the dissemination of news and should thus receive the higher level of First Amendment protection; they should place less material into the category of commercial advertising and promotion. In other words, more material should fall well beyond the scope of section 43(a)(1)(B). In the interest of not constricting the information supply to the public discourse, when an item is attacked by plaintiffs as a bald effort to boost circulation but can be supported by media defendants as an effort to inform readers of news content, the interests of defendants and of news dissemination should triumph. The headline and exclusive tag at issue in *Eastwood* should be regarded as tied to the dissemination of news: the *Enquirer's* article on Eastwood. That they also serve to boost circulation should not bar categorizing them as furthering the dissemination of news.

B. Because News Coverage Creates Little Risk of Consumer Confusion over Endorsement of the Publication, Section 43(a)(1)(A) Should Not Apply to Editorial Content

Beyond the commercial-noncommercial distinction that dominates section 43(a)(1)(B), claims brought under both prongs of section 43(a) must involve at least a likelihood of consumer confusion. Just as 43(a)(1)(B) claims that try to portray the media's use of celebrity images in editorial content as commercial instead of news must fail, section 43(a)(1)(A) claims that such use falsely implies celebrity endorsement of the media outlet also must fail. Compared to the context of advertisements, where an audience could infer some level of endorsement by the celebrity or person involved,²⁵⁸ the risk of the audience inferring an endorsement of the defendant's news publication based on the plaintiff's appearance in that publication is much slimmer.

Publication does not equal endorsement. Readers would not consider a *Los Angeles Times* report about Kofi Annan's diplomatic efforts in Iraq

(citing *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952)); see also Zimmerman, *supra* note 75, at 722-23;

The press, which the First Amendment expressly protects, is clearly as interested in garnering profits from the information it publishes as any other merchant. But to treat the press' commercial uses of information as potential infringements of another's property rights would impose such severe burdens on speech activities as to render the protection available under the First Amendment almost nugatory.

257. See Harriette K. Dorsen, *Satiric Appropriation and the Law of Libel, Trademark, and Copyright: Remedies Without Wrongs*, 65 B.U. L. REV. 923, 950 (1985) (citing *Stephano v. News Group Publications, Inc.*, 474 N.E.2d 580, 585 (N.Y. 1984)).

258. Michael Madow argues that a celebrity's image in an advertisement is not likely to lead consumers to believe that the celebrity personally uses or favors the advertised product. See Madow, *supra* note 203, at 229. He cites a 1989 study showing that an increasing percentage—64%—of adult television viewers think celebrities who endorse products or services are just in it for the money. See *id.* at 229 n.478.

as the U.N. secretary-general's endorsement of the newspaper. There is no confusion: The report is news. Nor would readers be likely to regard an interview of Brad Pitt in *People* as a sign of Pitt's endorsement of the magazine. It is a different story if Annan's face and a quote saying, "For news of the world, I read the *Los Angeles Times*," show up on billboards across Southern California as part of the *L.A. Times*' efforts to boost circulation or if Pitt appears in a TV spot for *People*, saying, "To catch up on all the Hollywood singles news, I read *People*."

Cases support this view. In *New Kids on the Block v. News America Publishing, Inc.*,²⁵⁹ the Ninth Circuit found no implied endorsement, and therefore no consumer confusion, in *The Star* and *USA Today*'s announcements of pay-per-call telephone polls to choose "the best on the block" or the sexiest kid. Both papers packaged photos of the group, requests to call a 900 number and such teasers as "Which of the five is your fave?" and "Which of the New Kids on the Block would you most like to move next door?"²⁶⁰ There the use of the name was purely descriptive and implied no endorsement by the group.²⁶¹

Even a claim of exclusivity, while tying the plaintiff to the one publication relative to others, need not justify an impression of endorsement. As the Ninth Circuit found in *Cher*, an "Exclusive Series" tag and the headline "Cher: My life, my husbands and my many, many men" did not amount to a damaging, false claim that Cher endorsed *Star*.²⁶² The actor-singer did not grant an interview to either *Star* or *Forum*, which had obtained the piece from a free-lancer. Both publications touted the interviews as exclusive, but neither was found liable on those grounds. Only *Forum* was found liable, and that was based solely on its false implication in advertising copy that Cher endorsed the magazine.²⁶³

However, courts have not uniformly found no endorsement in "exclusive" cases, even when the content did not constitute advertising. In *Eastwood*, which involved a layout much like the one in *Cher*, the Ninth Circuit found a false implication of endorsement.²⁶⁴ The *National Enquirer* falsely labeled an interview with Clint Eastwood as exclusive, as *Forum*

259. 971 F.2d at 308-09.

260. *See id.* at 304.

261. *See id.* at 309.

262. *See Cher v. Forum Int'l, Ltd.*, 692 F.2d 634, 638 (9th Cir. 1982).

263. *See Cher*, 692 F.2d at 637-39. It was only *Forum*'s subscription cards saying, "There are certain things that Cher won't tell *People* and would never tell *Us*. She tells *Forum*," and an ad that ran in the *New York Daily News* saying, "Cher Never Told Anyone How She Played Kiss and Tell with Rock Star Gene Simmons . . . She Told *Forum Magazine*," that went beyond showing *Forum*'s quality and content and amounted to a false implication that Cher endorsed that magazine. *Id.* at 638-39. Cher did not sue the *Daily News*; under 15 U.S.C. § 1114, the newspaper would be an innocent infringer unless it ran the ad with actual malice.

264. *See Eastwood*, 123 F.3d 1249.

and Star did in *Cher*.²⁶⁵ But it also ran the article with an *Enquirer* byline and a falsely labeled "Exclusive Photo" and edited the article—Eastwood said things "with a chuckle"—to increase the impression that Eastwood and the writer actually talked. The court found that those items, combined, created a knowingly false impression that the *Enquirer* actually interviewed Eastwood.

Even if a court, such as the Ninth Circuit in *Eastwood*, finds evidence of a risk of consumers wrongly inferring a plaintiff's endorsement of a publication, that risk is not the only interest that must be considered when the dissemination of news is involved. In such cases, the court must give substantial consideration to the danger of restricting the dissemination of news and thus curbing public discourse. Balancing First Amendment interests against the interest in not misleading consumers, the district court in *New Kids* held that "the Lanham Act does not apply unless the defendants falsely and explicitly represented" that the plaintiffs endorsed the defendants' actions.²⁶⁶ This "false and explicit representation" test, which rightly recognizes the primacy of First Amendment rights to disseminate the news, requires more than what Eastwood proved against the *National Enquirer*. It correctly limits the reach of the Lanham Act to cases of explicit endorsement, such as in advertising, and blocks application of section 43(a) in cases involving editorial content, where endorsement would be implicit, if it existed at all.

IV

OPTIONS FOR APPLYING SECTION 43(A) OF THE LANHAM ACT TO THE COMMUNICATIONS MEDIA WITHOUT RUNNING AFOUL OF THE FIRST AMENDMENT

Several approaches would succeed in giving greater weight to First Amendment protections for news accounts in Lanham Act cases and avoid undercutting the safeguards for journalists that have developed elsewhere, including in the fields of defamation and copyright law. These approaches include applying the *New York Times*²⁶⁷ standard more stringently to Lanham Act section 43(a) claims that are based on the editorial content of media defendants' publications; systematically weighing First Amendment

265. In *Eastwood* Judge Kozinski distinguished *Cher* as involving previously unpublished quotations. See *id.* at 1255 n.16. *Cher*'s interviewer had sold the interview to publishers of the *Star*, which printed it in its March 17 and 24, 1981, issues, and to publishers of *Forum*, which printed it in its March 1981 issue. Eastwood's interview appeared in the *Enquirer*'s December 21, 1993, issue. The interview had previously appeared in the British tabloid *Today*; identical quotes had appeared in a *Star* article.

266. *New Kids on the Block v. News Am. Publ'g, Inc.*, 745 F. Supp. 1540, 1545 (C.D. Cal. 1990). Unfortunately, the Ninth Circuit *New Kids* decision did not address constitutional considerations. The "false and explicit representation" test is a test of the district court and one that the Ninth Circuit did not have to apply in *Eastwood*.

267. *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964).

interests in Lanham Act cases; increasing media exemptions to Lanham Act claims; or prohibiting section 43(a) claims against media defendants for everything but strictly commercial speech. All of the approaches move application of the Lanham Act in news dissemination cases more in line with established First Amendment protections. The best approach—the one that is clearest and most protective of the First Amendment interest in the free flow of information—is to prohibit 43(a) claims against media defendants for all but commercial speech.

A. *Filtering Lanham Act Claims Through a New York Times Screen*

One approach would require plaintiffs in section 43(a) cases to prove, by clear and convincing evidence, that the media defendant acted with actual malice in infringing the plaintiff's trademark in the course of disseminating news. This would build on the Supreme Court's application of the *New York Times* actual malice standard in cases other than those based on defamation claims.²⁶⁸ The Ninth Circuit has already applied the actual malice standard to a Lanham Act claim. In *Eastwood*,²⁶⁹ the court held that the editors acted with actual malice by intentionally giving the "impression—known by them to be false—that Eastwood willfully submitted to an interview by the *Enquirer*."²⁷⁰ In contrast, the court found no clear and convincing evidence of actual malice in the *Enquirer*'s publication of the interview; Eastwood failed to prove that the *Enquirer* published the interview knowing it was false.²⁷¹ The actual malice attached not to the publication of the interview itself but to the labeling of the interview as an exclusive. The *Enquirer* could have published the interview itself without incurring section 43(a) liability, but once it misdesignated the interview as exclusive, the Lanham Act came into play and resulted in an award of more than \$800,000 for Eastwood.

While the court in *Eastwood* recognized the importance of requiring proof of actual malice when a public figure is suing a news organization for damage to reputation, it failed to emphasize in its analysis of the Lanham Act claim, which Eastwood used to vindicate his reputation, the *New York Times* requirement of proving actual malice by clear and convincing evidence. Concerns for "breathing space" for free expression require a higher burden on plaintiffs when First Amendment protections

268. The Court applied the actual malice standard to the Rev. Jerry Falwell's claim of intentional infliction of emotional distress against *Hustler Magazine*. See *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 52 (1988) (holding that "such a standard is necessary to give adequate 'breathing space' to the freedoms protected by the First Amendment"). The Court also accepted a lower court ruling, without expressing a view on it, that applied the *New York Times* standard to a product disparagement claim. See *Bose Corp. v. Consumers Union of United States, Inc.*, 466 U.S. 485, 513 (1984).

269. *Eastwood*, 123 F.3d at 1249.

270. *Id.* at 1256.

271. See *id.* at 1255.

are at stake. This approach, demanding clear and convincing proof that the false, defamatory statement was made with knowledge that it was false or with reckless disregard of its truth or falsity, satisfies that requirement by jettisoning the strict liability regime in section 43(a) of the Lanham Act in cases involving news content. Equalizing the burdens on the plaintiff would properly withhold rewards from plaintiffs merely because they pleaded artfully. The First Amendment interests are the same regardless of whether the injury to reputation is addressed through defamation or the Lanham Act. What differs is the burden on the plaintiff. A plaintiff should not be able to achieve with a Lanham Act claim what could not be achieved under the stricter burdens of a defamation suit. This argument gains strength since the true purpose of the Lanham Act is not protecting reputations but avoiding consumer confusion. Despite the higher burdens for the plaintiff, the approach continues to provide an outlet—albeit a more challenging one—for plaintiffs to resolve claims of false advertising and false endorsement in the mass media.

Beyond changing the burdens on the plaintiff, an approach to section 43(a) of the Lanham Act requiring proof of actual damages and prohibiting injunctive relief would be more in tune with First Amendment concerns. Most cases involving media defendants prohibit injunctions as impermissible prior restraints on the press. As for damages, in defamation law, a field full of First Amendment influence, even private-figure plaintiffs—whom the Court sees as deserving more protection than public officials and public figures like Clint Eastwood—merit compensation only for actual harm unless they prove actual malice.²⁷² As it is now, Lanham Act plaintiffs need not prove they suffered any actual harm—the likelihood of harm is sufficient—and they routinely receive injunctions as a standard remedy for trademark infringement.²⁷³ While issuing injunctions helps serve the Lanham Act's goal of preventing consumer confusion, it defeats the First Amendment's goal of encouraging—not chilling—speech. An approach that limits remedies to monetary damages thus limits plaintiffs who have section 43(a) claims based on news content to the same remedy that many other plaintiffs have in cases involving the press.

A downside to this approach is that it potentially expands the reach of *New York Times* into the realm of private-figure plaintiffs, an expansion the Court has rejected. Courts can avert this issue by repeating the Court's approach in *New York Times* and *Gertz*²⁷⁴ by applying the actual malice standard to public officials and public figures and reserving the lower standard of at least negligence for private figures. Additionally, in many of the Lanham Act cases in which a media defendant is sued for false

272. See *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 349-50 (1974).

273. See *supra* note 193.

274. *Gertz*, 418 U.S. at 323.

endorsement based on editorial content, the plaintiff is a celebrity, so the public-private concern will not arise.

B. Systematically Weighing First Amendment Concerns in All Cases Involving the Media and Section 43(a) of the Lanham Act

A second option would be to continue to work within the existing framework but to apply a balancing test in all Lanham Act cases involving the media. Courts would apply section 43(a) as it currently exists; they would just routinely and explicitly factor in First Amendment considerations. The district court in *New Kids*²⁷⁵ adopted this approach, as did the Second Circuit in *Rogers v. Grimaldi*.²⁷⁶ In the latter case the court balanced the artistic expression rights of the makers of *Ginger and Fred*, a Federico Fellini film about two fictional Italian performers who were known as Ginger and Fred because of their imitations of Ginger Rogers and Fred Astaire, against those of Ginger Rogers, who argued that the film title created the false impression that she endorsed or was the subject of the film. While the court recognized consumers' interest in not being misled, the touchstone of trademark law, it also recognized that consumers had an interest in enjoying artistic expression.²⁷⁷ Concerned that a broad take on the Lanham Act would trample First Amendment values, the court opted for a narrow interpretation, holding that "in general the Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression."²⁷⁸ The balance tilts against free expression only if the title had no artistic relevance or was *explicitly* misleading.²⁷⁹

In extending the *Rogers* approach to parodies, the Second Circuit in *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*,²⁸⁰ held that "in deciding the reach of the Lanham Act in any case where an expressive work is alleged to infringe a trademark, it is appropriate to weigh the public interest in free expression against the public interest in avoiding consumer confusion."²⁸¹ In vacating an injunction against publishers of *Spy Notes*, a parody of *Cliffs Notes*, the court recognized that "the expressive element of parodies requires more protection than the labeling of ordinary commercial products."²⁸² It thus applied, in a section

275. *New Kids on the Block v. News Am. Publ'g, Inc.*, 745 F. Supp. 1540, 1545 (C.D. Cal. 1990).

276. 875 F.2d 994 (2d Cir. 1989).

277. *See id.* at 998.

278. *Id.* at 998-99.

279. *See id.* at 999.

280. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 886 F.2d 490 (2d Cir. 1989).

281. *Id.* at 494.

282. *Id.* at 495.

43(a) context, the First Amendment view of putting greater protection on less hardy noncommercial speech.

Within the Second Circuit, the District Court for the Southern District of New York has relied on *Rogers* to articulate a likelihood of confusion test that gives weight to First Amendment considerations.²⁸³ In addition to such factors as the strength of the plaintiff's trademark, similarity of the marks, and the defendant's good faith, the court expressly considered First Amendment interests "so as to give due weight to the fact that the goods at issue are artistic expression."²⁸⁴ A small likelihood of confusion would not be sufficient to upset First Amendment concerns involved in cases involving artistic expression. Given that news—even a broad definition of news that extends beyond political reportage—sits higher in the First Amendment hierarchy, the same, or an even greater, likelihood of confusion would not allow a plaintiff to prevail over a media defendant.

The *New Kids* district court took the Second Circuit's balancing of interests and replaced the interest in artistic expression with the public interest in the gathering and dissemination of news.²⁸⁵ It, too, recognized the importance of protecting freedom of expression. The district court expounded a test in cases in which trademark law encroached on First Amendment rights. The court held that in such cases, "the First Amendment provides immunity to defendants . . . unless their use of plaintiffs' trademark was wholly unrelated to news gathering and dissemination, misleading as to content, or falsely and explicitly denoted authorship, sponsorship, or endorsement by [the plaintiffs]."²⁸⁶

The advantage of this balancing test is that it puts a priority on dissemination of news and requires any alleged endorsement to be both false and explicit, something that is unlikely in an editorial context. The disadvantage is that while it requires endorsements to be false and explicit to be actionable, the district court's *New Kids* test allows for liability if the media's use of the plaintiff's trademark was merely misleading as to content. It thus allows a public-figure plaintiff to recover against the press without a showing of actual malice. The Second Circuit's balancing test, while more vague, does allow for more leeway to inject free speech considerations in cases that implicate the First Amendment.

In affirming the district court decision in *New Kids*, the Ninth Circuit avoided a decision on constitutional grounds. Instead, it applied a fair use test inadequate to protect First Amendment interests. The court found the

283. See *Girl Scouts of the United States of Am. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 808 F. Supp. 1112, 1122 (S.D.N.Y. 1992) (finding no likelihood of confusion between the Girl Scouts and Boy Scouts organizations and a "Pee Wee Scouts" series of children's books).

284. *Id.*

285. See *New Kids on the Block v. News Am. Publ'g, Inc.*, 745 F. Supp. 1540, 1541-42 (C.D. Cal. 1990).

286. *Id.*

newspapers' use of the New Kids mark was nominative and not within trademark law's restrictions.²⁸⁷ In a result akin to copyright law's idea-expression distinction, the court established a nominative fair use defense where (1) the plaintiff's product or service is not readily identifiable without using the plaintiff's trademark, (2) the defendant only used the mark to the extent necessary to identify the plaintiff's product or service, and (3) the defendant did not imply sponsorship or endorsement.²⁸⁸ So long as courts recognize that editorial content is an unlikely vehicle for an implication of endorsement, the Ninth Circuit's nominative fair use defense should provide substantial protection to media defendants. But much as copyright-law commentators have suggested, despite the existence of a fair use defense, a separate First Amendment defense is necessary to ensure expression is protected.²⁸⁹ The *Rogers* court's and *New Kids* district court's balancing test provides the basis for such a defense.

C. Increasing Media Exemptions to Lanham Act Claims

A third option is to take the current statutory framework and increase media exemptions to Lanham Act claims. This approach would build on existing media exceptions in the Lanham Act. Amended in 1989, 15 U.S.C. § 1114 now provides that "innocent" publishers of infringing advertisements are not liable.²⁹⁰ Congressional intent was clear on this point: "For a defendant who is a member of the media to be found liable under section 43(a), the plaintiff must show that the defendant was not 'innocent' . . . and . . . that state of mind must encompass the *New York Times v. Sullivan* standard."²⁹¹ To build on this limitation on Lanham Act remedies so that it applies to more than just journalists as transmitters of a third party's infringing advertisements, the legislature could extend the broad media exemption found in section 43(c) of the Lanham Act to section 43(a). Section 43(c), which was enacted into law in 1996, establishes a federal claim to deter the dilution of the distinctiveness of famous marks.²⁹² Under section 43(c)(4)(C), "all forms of news reporting and news commentary" are exempt from injunction or damages due to commercial use of another person's trademark causing dilution of the mark.²⁹³

287. See *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

288. See *id.*

289. See *supra* Part II.C.3.

290. See 15 U.S.C. § 1114 (1994).

291. 134 CONG. REC. 31,851-52 (1988) (remarks of Rep. Kastenmeier) ("[T]he change protects newspapers, magazines, broadcasters, and other media from liability for the innocent dissemination of commercial false advertising, including promotional material.").

292. See J. Thomas McCarthy, *Lanham Act § 43(a): The Sleeping Giant is Now Wide Awake*, 59 LAW & CONTEMP. PROBS. 45, 54 (1996).

293. 15 U.S.C. § 1125(c)(4)(C) (Supp. III 1997).

The benefit of this approach is that it works within the current framework, building on legislative action by taking the press-friendly rationale under section 43(c)(4)(C) and applying it elsewhere in the section. The section would expand the section 43(c)(4)(C) exemption and hold that any false designation of origin, false or misleading description of fact, or false or misleading representation of fact made in the context of news reporting and news commentary shall not be actionable under the Lanham Act.

The hurdle such an approach faces is the need for legislative action. The legislature could respond to calls for an amendment by pointing out that it had the chance to extend the full immunity to news reporting and commentary in 1996 when it amended section 43(c). Congress rejected the opportunity to adjust 43(a) when it added 43(c). Furthermore, the dilution claim under 43(c) expands the intellectual property right, so the explicit news exception merely balances out that expansion.

D. Prohibiting Section 43(a) Claims Against Media Defendants for Everything but Strictly Commercial Speech

A fourth alternative—the one that is most protective of the First Amendment interest in the dissemination of news and the one that courts should adopt—would bar section 43(a) claims against media defendants for everything but strictly commercial speech, thus collapsing section 43(a)(1)(A) and section 43(a)(1)(B) in media cases. This builds on the result in *Cher*, in which the falsely labeled “exclusive” article was not actionable but the misleading advertising and subscription campaign was. Changing a crucial *or* to *and* in the test elaborated by the District Court for the Central District of California in *New Kids* would create this immunity for news gathering and dissemination. The test would thus be: “the First Amendment provides immunity to defendants . . . unless their use of the plaintiffs’ trademark was wholly unrelated to news gathering and dissemination, misleading as to content,” *and* “falsely and explicitly denoted authorship, sponsorship, or endorsement.”²⁹⁴ Replacing *or* with *and* creates a straightforward Lanham Act immunity for the dissemination of news while noting section 43(a)(1)(A)’s prohibition on false endorsement.

The application of this approach is clear: It would simply require courts to scrutinize the Lanham Act claim to see whether it involves commercial speech or noncommercial speech. Commercial speech can give rise to Lanham Act liability. Noncommercial speech cannot. News content would clearly fall beyond the scope of section 43(a) since it is neither advertising nor endorsement. Plaintiffs could still sue based on the non-commercial speech; the claims would just have to be filed under something

294. *New Kids on the Block v. News Am. Publ’g, Inc.*, 745 F. Supp. 1540, 1541 (C.D. Cal. 1990).

other than section 43(a) of the Lanham Act. Defamation in disguise would be uncovered and dismissed. Thus Cher could file a defamation claim against *Forum International* if she sought to repair alleged damage to her image as a celebrity from the publication of an "exclusive" interview, which would be classified as news dissemination. She would have to show by clear and convincing evidence that the editors acted with actual malice and that the contents of the interview and/or the "exclusive" tagline defamed her. In the actual case, Cher never alleged that the interview defamed her.

The advantage to this approach is that it forecloses application of section 43(a) of the Lanham Act to all but commercial speech. It would thus avoid pulling protected speech into the less protected commercial speech category, where falsity strips away any First Amendment protection for the statement. The Court has stressed the importance of maintaining a clear distinction, for "the failure to distinguish between commercial and noncommercial speech 'could invite dilution, simply by a leveling process, of the force of the [First] Amendment's guarantee with respect to the latter kind of speech.'"²⁹⁵ Another advantage is that it would focus section 43(a) on commercial speech, the area that is more likely to implicate the goal underlying the Lanham Act: preventing consumer confusion.

The disadvantage of this approach is that it would require amending section 43(a)(1)(A) to include language restricting the subsection to "commercial advertising or promotion." Another disadvantage is that if the approach is viewed as an absolute protection of the press, it would likely not survive. The absolutist approach has failed to get support from a Court majority before and would likely fail again.²⁹⁶

While this fourth approach may seem absolute in that it shuts out Lanham Act plaintiffs completely in cases involving editorial content, it does not give free rein to the press. Advertising content in newspapers and magazines, the area where the risk of any consumer confusion would be greater, would not be exempt from the Lanham Act. For example, Cher would still have a claim against *Forum* based on the ads that read, "So join Cher and FORUM's hundreds of thousands of other adventurous readers

295. *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557, 562 n.5 (1980) (quoting *Ohrlik v. Ohio State Bar Ass'n*, 436 U.S. 447, 456 (1978)).

296. In *New York Times*, the newspaper's counsel suggested three remedies to the Court: (1) provide absolute protection for publishing criticism of public officials; (2) require public officials to prove special damages before they may recover against the press; and (3) require public officials to prove actual malice. See Lewis, *supra* note 116, at 607. Only Justices Douglas, Black, and Goldberg supported the first option. See *New York Times Co. v. Sullivan*, 376 U.S. 254, 293 (Black, J., concurring) (supporting the view that "the Times and the individual defendants had an absolute, unconditional constitutional right to publish in the Times advertisement their criticisms" of public officials); *id.* at 298 (Goldberg, J., concurring) (finding that "the First and Fourteenth Amendments to the Constitution afford to the citizen and to the press an absolute, unconditional privilege to criticize official conduct despite the harm which may flow from excesses and abuses").

today.” But Clint Eastwood could not raise a successful Lanham Act claim based merely on a front-page, *National Enquirer* claim of exclusivity.

CONCLUSION

By adopting the fourth approach and shielding editorial content from section 43(a) suits, courts could balance the interests in having an unencumbered press against the interests of trademark owners in protecting their trademarks. The approach takes claims based on editorial content back to the fundamental protections elucidated in *New York Times v. Sullivan* and applied in such numerous contexts as defamation, intentional infliction of emotional distress, and product disparagement. Time and again the courts have worked to assure that the “unfettered interchange of ideas for the bringing about of political and social changes desired by the people”²⁹⁷ thrives in the face of novel pleadings. Courts could continue to protect that exchange of ideas by immunizing news content from section 43(a) claims that attempt to make an end run around the barrier that the First Amendment has created to protect public discourse and the dissemination of news. At the same time, courts would respect both the economic interests of trademark owners and celebrities and the interests of Congress in preventing consumer confusion by vigorously applying section 43(a) of the Lanham Act exclusively in the commercial context.

297. *Id.* at 269 (quoting *Roth v. United States*, 354 U.S. 476, 484 (1957)).

