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CARDOZO LAW REVIEW
de•novo

MUSIC VIDEOS: THE GRAY AREA IN FIRST
AMENDMENT PROTECTED SPEECH AND THE
RESULTING TRADEMARK CONSEQUENCES

Lindsey Gold[†]

TABLE OF CONTENTS

INTRODUCTION.....	14
I. BACKGROUND: FIRST AMENDMENT SPEECH.....	20
A. <i>Commercial Versus Noncommercial Speech</i>	20
1. Implications of Noncommercial Versus Commercial Speech.....	22
II. THE LANHAM ACT AND ITS INTERACTION WITH THE FIRST AMENDMENT.....	24
A. <i>History of the Lanham Act</i>	24
B. <i>The “Fair Use” Exclusion</i>	25
C. <i>The “Noncommercial Use” Exclusion</i>	26
D. <i>Interplay Between the First Amendment and the Lanham Act</i>	27
1. Dilution Claims Under the FTDA of the Lanham	

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Act.....	28
2. Infringement Claims Under the Lanham Act	29
III. FORMS OF ARTISTIC SPEECH	31
A. <i>Parodies As Protected Expression</i>	31
B. <i>Films and Motion Pictures As Protected Expressions</i>	32
C. <i>Programs Broadcast by Radio and Television As Protected Expression</i>	33
D. <i>Music As Protected Expression</i>	33
IV. ANALYSIS: MUSIC VIDEOS SHOULD BE FEDERALLY CLASSIFIED AS NONCOMMERCIAL SPEECH UNDER THE FIRST AMENDMENT	34
A. <i>Music Videos Are Forms of Artistic Expression</i>	34
B. <i>Music Videos Play an Important Social Role in Society</i>	35
C. <i>Music Videos are Mini-Movies, Deserving of First Amendment Protection</i>	38
V. PROPOSAL: THE NEED FOR CERTAINTY AND FREEDOM OF EXPRESSION DICTATES WHY MUSIC VIDEOS MUST BE FEDERALLY DEEMED AS NONCOMMERCIAL SPEECH.....	42
CONCLUSION.....	44

INTRODUCTION

In one scene of *The Hangover: Part II*, a porter is shown pushing a dolly with hard luggage and what seems to be Louis Vuitton Malletier (LVM)¹ trunks and travel bags.² Alan, one of the movie’s main characters, is also shown holding what appears to be a LVM travel bag.³ However, the trunks and travel bags are actually infringing Diophy⁴ bags.⁵ After Warner Brothers (Warner Bros.) released the film on Blu-Ray and DVD, LVM instituted a lawsuit against Warner Bros. claiming—among general trademark infringement claims—that Warner Bros.’s use of the infringing bag in the film blurs and tarnishes⁶ LVM

¹ *Louis Vuitton Malletier S.A. v. Warner Bros. Entm’t Inc.*, 868 F. Supp. 2d 172, 174 (S.D.N.Y. 2012) (“Louis Vuitton is one of the premier luxury fashion houses in the world, renowned for, among other things, its high-quality luggage, trunks, and handbags. Louis Vuitton’s principle trademark is the highly-distinctive and famous Toile Monogram.”).

² *Id.*

³ *Id.*

⁴ *Id.* (“Diophy is a company that creates products which use a monogram design that is a knock-off of the famous Toile Monogram (the “Knock-Off Monogram Design”). The Diophy products bearing the Knock-Off Monogram Design have been extensively distributed throughout the United States, causing enormous harm to Louis Vuitton.”).

⁵ *Id.* at 174–175.

⁶ Dilution by blurring and dilution by tarnishment are two kinds of trademark dilution. *See*

marks in violation of 15 U.S.C. §§ 1051–1141, or alternatively, The Lanham Act.⁷ The Lanham Act is a federal statute that provides the standards for trademark protection.⁸ A trademark is a word, symbol, or phrase used to identify a seller’s product.⁹ In order to qualify as a trademark, a mark must be distinctive—meaning it “must be capable of identifying the source of a particular good.”¹⁰ Once the mark qualifies as distinctive, one can acquire rights in a trademark by either registering with the United States Patent and Trademark Office (USPTO),¹¹ or by being the first to use the mark in commerce.¹² Owning a mark confers on the owner the right to sue others for infringement.¹³ Infringement occurs if a party uses another’s mark—without authorization—in connection with the sale of goods or services that is likely to cause confusion as to the ownership or sponsorship of those goods or services.¹⁴ Owning a mark also confers on an owner the right to sue another party for trademark dilution.¹⁵ Dilution occurs when a third-party’s use of a mark whittles away the mark’s distinctiveness.¹⁶ The Lanham Act provides for two types of dilution: dilution by blurring and dilution by tarnishment.¹⁷ Dilution by blurring occurs when a third-

15 U.S.C. § 1125(c) (2012). A cause of action for trademark dilution arises under the Lanham Act when a third-party’s use of another’s mark whittles away the distinctiveness of the famous mark. See Tyler M. Hampy, *Trademark Dilution: Blurring v. Tarnishment*, WILDERMAN MALEK (Dec. 20, 2012, 6:00 AM), <http://legalteamusa.net/tacticalip/2012/12/20/trademark-dilution-blurring-v-tarnishment>. Dilution by blurring occurs when a third-party’s use of a famous mark decreases the association between the mark and the famous goods or services. *Id.* Dilution by tarnishment occurs when a third party uses a famous mark in an unwholesome or unpleasant context. *Id.*

⁷ Louis Vuitton Malletier S.A., 868 F. Supp. 2d at 175–76 (“The complaint further alleges that ‘Warner Bros.’ use and misrepresentation of the Diophy [b]ag bearing the Knock-Off Monogram Design as an authentic Louis Vuitton bag is likely to blur the distinctiveness of the LVM Marks’ and ‘tarnish the LVM Marks by associating Louis Vuitton with the poor quality and shoddy reputation of the cheap products bearing the Knock-Off Monogram Design.’”).

⁸ *Overview of Trademark Law*, HARVARD, <https://cyber.harvard.edu/metaschool/fisher/domain/tm.htm> (last visited Sep. 19, 2017).

⁹ 15 U.S.C. § 1127; see also *Overview of Trademark Law*, *supra* note 8.

¹⁰ *Overview of Trademark Law*, *supra* note 8.

¹¹ See 15 U.S.C. § 1051(a); see also *Overview of Trademark Law*, *supra* note 8.

¹² *Overview of Trademark Law*, *supra* note 8.

¹³ See 15 U.S.C. §§ 1114(1), 1125(a); see also *Overview of Trademark Law*, *supra* note 8.

¹⁴ See 15 U.S.C. § 1125(a); see also Hampy, *supra* note 6 (explaining that infringement occurs “when someone other than the trademark owner uses the mark in a way that is likely to cause consumer confusion”).

¹⁵ See 15 U.S.C. § 1125(c)(1).

¹⁶ Hampy, *supra* note 6 (“Dilution occurs when someone other than the trademark owner uses the mark, usually in connection with noncompeting goods, and thereby causes the association between the mark and the good/service to decrease.”).

¹⁷ 15 U.S.C. § 1125(c)(2).

(c) Dilution by blurring; dilution by tarnishment.

(2) Definitions.

(B) For purposes of paragraph (1), “dilution by blurring” is association arising from the similarity between a mark or trade name and a famous mark that impairs the

party's use of a mark whittles away the distinctiveness of the mark, decreasing the ability to identify the owner's unique good or service as her own.¹⁸ Dilution by tarnishment occurs when a third-party uses an owner's mark without permission and portrays the mark in an unwholesome light by associating it with goods of poor quality or by casting the mark in an unpleasant context.¹⁹

In the suit referenced above, LVM claimed that the use of the infringing Diophy bag was in violation of dilution by blurring because the similarity between the marks, and the use of the infringing mark in the film, allegedly impaired the distinctiveness of LVM's famous mark.²⁰ LVM also claimed that the infringing bag in the film tarnishes LVM's mark by associating the poor quality of the infringing bags with the high quality bags of the renowned luxury fashion company.²¹ It is important to note, however, that LVM objected to Warner Bros.'s use of the allegedly infringing bag, and not to Warner Bros.'s unauthorized use of the LVM mark itself.²² LVM aptly acknowledged that Warner Bros.'s use of its mark is noncommercial, and thus is considered artistic speech under *Rogers v. Grimaldi*.²³ Thus, the Lanham Act would not be applicable to LVM's claim as such.²⁴ Therefore, although a distinctive

distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

- (i) The degree of similarity between the mark or trade name and the famous mark.
 - (ii) The degree of inherent or acquired distinctiveness of the famous mark.
 - (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
 - (iv) The degree of recognition of the famous mark.
 - (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
 - (vi) Any actual association between the mark or trade name and the famous mark.
- (C) For purposes of paragraph (1), "dilution by tarnishment" is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

¹⁸ Humpy, *supra* note 6 (explaining that a third-party's use of a mark causes the association between a mark and its associated goods or services to decrease).

¹⁹ *Id.* ("Enjoy Cocaine" would be an example of dilution by tarnishment).

²⁰ *Louis Vuitton Malletier S.A. v. Warner Bros. Entm't Inc.*, 868 F. Supp. 2d 172, 175 (S.D.N.Y. 2012).

²¹ *Id.* at 175–76.

²² *Id.*

²³ *Id.* at 177. In *Rogers v. Grimaldi*, the Second Circuit pronounced a test for assessing trademark infringement claims. 875 F.2d 994 (2d Cir. 1989). Under *Rogers*, courts must weigh the public interest in free expression against the public interest in avoiding consumer confusion. *Id.* at 999. Artistic—i.e. noncommercial—speech is granted protection under the First Amendment. *Id.* at 998 (noting that the Lanham Act must be construed narrowly to avoid a conflict with the First Amendment).

²⁴ *Louis Vuitton Malletier S.A.*, 868 F. Supp. 2d at 177 ("In *Rogers v. Grimaldi*, the Second

mark is granted First Amendment protection in artistic works, LVM objects that First Amendment protection extends to infringing products.²⁵ The U.S. District Court for the Southern District of New York, however, disregarded LVM's objection and found its claim to be meritless.²⁶ The court took great heed of the potential threat to freedom of expression if the court were to hold that Warner Bros. diluted LVM's marks by their use of even a remarkably similar infringing product in noncommercial speech.²⁷ By extending First Amendment protection to infringing products, the court recognized the importance of trademarks in furthering freedom of expression.²⁸

Much like the defendants in *Louis Vuitton Malletier*, defendants in trademark infringement suits frequently invoke the First Amendment as an affirmative defense.²⁹ The First Amendment safeguards freedom of expression by categorizing speech into two categories: noncommercial speech and commercial speech.³⁰ Noncommercial speech³¹ is afforded greater protection from infringement and dilution claims than commercial speech.³² The distinction became crucial to the realm of trademarks when Congress passed the Federal Trademark Dilution Act (FTDA) in 1995.³³ The FTDA included two new exclusions from dilution liability: fair use³⁴ and noncommercial use.³⁵ Since *The*

Circuit held that the Lanham Act is inapplicable to 'artistic works' as long as the defendant's use of the mark is (1) 'artistically relevant' to the work and (2) not 'explicitly misleading' as to the source or content of the work.") (internal citations omitted).

²⁵ *Id.* (explaining that LVM acknowledges Warner Bros.'s use of the mark is noncommercial, and thus objects to extending First Amendment protection to an infringing product).

²⁶ *See id.* at 184 n.20 (stating that First Amendment protection extended to infringing products in artistic works).

²⁷ *Id.* at 183 ("The public's interest in avoiding consumer confusion . . . is not so great as to overcome the significant threats to free expression from holding Warner Bros. liable for its noncommercial speech in this case.").

²⁸ *See id.* at 182 (recognizing that if the court were to hold Warner Bros. liable, freedom of expression would suffer).

²⁹ *See id.* at 176 (noting that Warner Bros. moved to dismiss the complaint entirely because the use of the Diophy bag is protected by the First Amendment under the test advanced in *Rogers*).

³⁰ *See* Tara E. Langvardt, *Reinforcing the Commercial-Noncommercial Distinction: A Framework for Accommodating First Amendment Interests in the Right of Publicity*, 13 VA. SPORTS & ENT. L.J. 167, 174 (2014).

³¹ Noncommercial speech is speech that does more than propose a commercial transaction. *Id.* at 176. Noncommercial speech is analyzed under the most stringent and protective form of review, strict scrutiny review, which means that a regulation must be narrowly tailored to serve a compelling governmental interest. *Id.* at 174; *see also infra* Part I.A.

³² Commercial speech is analyzed under the moderate standard of intermediate scrutiny, which means that a restriction on speech is only upheld if it directly advances a substantial government interest and it is no more extensive than necessary to do so. *Id.* at 175–76; *see also infra* Part I.A.

³³ Lee Ann W. Lockridge, *When Is a Use In Commerce a Noncommercial Use?*, 37 FLA. ST. U. L. REV. 337, 345–46 (2010).

³⁴ 15 U.S.C. § 1125(c)(3)(A) (2012).

³⁵ 15 U.S.C. § 1125(c)(3)(C).

Hangover: Part II was released after Congress passed the FTDA in 1995,³⁶ and films are considered protected noncommercial speech,³⁷ LVM knew their claim would fail if they objected to Warner Bros.’s unauthorized use of their mark—and its dilution—because the movie is protected speech.³⁸ Thus, LVM had to argue that First Amendment protection should not extend to an infringing product in noncommercial speech.³⁹ However, the court extended First Amendment protection to infringing products,⁴⁰ and it set a precedent in New York that grants movie producers and distributors some insulation from liability when incorporating trademarks into noncommercial speech.⁴¹

However, other artistic producers and distributors cannot be so certain. Films are among a diverse category of artistic works that federal courts deemed as protected noncommercial speech.⁴² Other protected categories include parodies,⁴³ films and motion pictures,⁴⁴ programs broadcast by radio and television,⁴⁵ music,⁴⁶ and other modes of entertainment.⁴⁷ Federal courts, however, have yet to deem music videos as protected noncommercial speech.⁴⁸ If music videos are federally deemed as noncommercial speech, artists⁴⁹ can be more certain *ex ante* about the inclusion of trademarks in music videos.⁵⁰ As the law currently stands, artists should obtain a license from a trademark owner for the right to use their mark in a music video to avoid absolute

³⁶ *The Hangover Part II Blu-Ray*, BLU-RAY.COM, <http://www.blu-ray.com/movies/The-Hangover-Part-II-Blu-ray/21427> (last visited Sept. 15, 2017).

³⁷ *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952) (holding that films and motion pictures are protected, noncommercial speech under the First Amendment).

³⁸ *Id.* at 501–02.

³⁹ *Louis Vuitton Malletier S.A. v. Warner Bros. Entm’t Inc.*, 868 F. Supp. 2d 172, 181–84 (S.D.N.Y. 2012).

⁴⁰ *Id.* at 183–84 (holding that the public’s interest in free expression outweighed the public’s interest in avoiding consumer confusion).

⁴¹ *See generally id.*

⁴² *See infra* Part III.

⁴³ *See, e.g., Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120 (C.D. Cal. 1998) (holding that there was no trademark infringement of the song “Barbie Girl” as it was a parody, and thus it received full First Amendment protection).

⁴⁴ *See, e.g., Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495 (1952).

⁴⁵ *See, e.g., Montgomery v. Montgomery*, 60 S.W.3d 524 (Ky. 2001) (citing *Schad v. Borough of Mount Ephraim*, 452 U.S. 61 (1981)).

⁴⁶ *See, e.g., Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989); *see also ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 924 (6th Cir. 2003).

⁴⁷ *See, e.g., Schad*, 452 U.S. at 64 (holding that nude dancing was a form of entertainment protected under the First Amendment).

⁴⁸ The Supreme Court of Kentucky is the only court that has deemed music videos as protected speech. *See, e.g., Montgomery*, 60 S.W.3d at 529.

⁴⁹ “Artists” is used for brevity, as there are many categories of people and companies involved in the production of a music video.

⁵⁰ If music videos are deemed as noncommercial speech, they would qualify under the noncommercial use exemption of the FTDA and would not be subject to the same dilution liabilities without such a classification. *See generally* 15 U.S.C. § 1125(c)(3)(C) (2012).

liability.⁵¹ In general, third parties must obtain a license from the mark owner to use the mark because the owner maintains the right to control how the mark is used for commercial purposes.⁵² However, the need to obtain licenses can become inefficient when incorporating various trademarks in a work.⁵³ Additionally, owners can object to the use of the mark in a work.⁵⁴ Lack of response or objection from a mark's owner potentially impedes freedom of expression by forcing exclusion of such marks from a work to avoid potential litigation—or risking litigation by including the mark.⁵⁵ By excluding such marks, artists' expression can be significantly hindered.⁵⁶ If music videos are federally deemed as noncommercial, however, artists' freedom of expression would be furthered and the inefficiencies associated with licensing may cease to exist.⁵⁷

This Note argues for a federal classification of music videos as

⁵¹ Christopher Schiller, *Legally Speaking, It Depends: Trademarks in Film*, SCRIPT MAGAZINE (Mar. 29, 2016), <http://www.scriptmag.com/features/legally-speaking-depends-trademarks-film> (explaining that the use of trademarks in artistic expressions is not as clear cut as it seems because their use may or may not be protected under the First Amendment). If a mark is used in an artistic work, its use may be protected as a fair use. See Tamera H. Bennett, *Is That Fair (Use)? Third Party Trademarks in Film, Print, Video Games, and Other Media*, BENNETT L. OFF. (Jan. 12, 2015), <http://www.tbennettlaw.com/createprotect/2015/1/5/is-that-fair-use-third-party-trademarks-in-film-print-video-games-and-other-media> (“Both statutory law and common law allow for fair use of trademarks in commercial works and expressive works.”). If a mark is used in an artistic work, its use may also be protected under the First Amendment. *Id.* (discussing the application of the *Rogers* test—whether the use of the third-party trademark is artistically relevant to the underlying work, and if so, if it is deliberately misleading as to the source or content of the work—to expressive works). The artistic relevance prong of the *Rogers* test is intentionally applicable law. See *Louis Vuitton Malletier S.A. v. Warner Bros. Entm’t Inc.*, 868 F. Supp. 2d 172, 178 (S.D.N.Y. 2012) (discussing that “[t]he threshold for ‘artistic relevance’ is purposely low . . . [as] [t]he artistic relevance prong ensures that the defendant intended an artistic—i.e., noncommercial—association with the plaintiff’s mark.”).

⁵² Irene Calboli, *The Sunset of “Quality Control” In Modern Trademark Licensing*, 57 AM. U. L. REV. 341, 348 (2007) (“[T]he core of trademark rights resides in the ability of trademark owners to exclude unauthorized parties from using similar marks on identical or confusingly similar products. A corollary of this ‘right to exclude’ is the ability of trademark owners to authorize third parties to use their marks on a variety of products under specific conditions.”).

⁵³ See Stuart Whitwell, *The Power of Brands – Understanding Royalty Rate*, 43 WORLD TRADEMARK REV. 52 (June/July 2013) (discussing that brands may be selective over which companies and products they want to associate their brand with).

⁵⁴ See *id.* (discussing that as the Chief Executive of her brand, Beyoncé maintains control over who she associates her brand with); see also Calboli, *supra* note 52 (noting that trademark owners have the right to exclude parties from using their mark).

⁵⁵ See generally Schiller, *supra* note 51 (noting that the necessity of obtaining licenses for a third-party’s use of a mark is not clear cut because the mark’s use may be protected).

⁵⁶ See, e.g., *Girl Scouts of the U.S. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 808 F. Supp. 1112, 1118 (S.D.N.Y. 1992) (“To prevent filmmakers, novelists, painters, and political satirists from including trademarks in their works is to cordon off an important part of modern culture from public discourse.”).

⁵⁷ The First Amendment may provide protection for the use of trademarks in noncommercial artistic expressions, making the need for licenses less crucial. See Schiller, *supra* note 51. Further, trademark dilution claims would be shielded from liability under the FTDA. See 15 U.S.C. § 1125(c)(3)(C) (2012).

noncommercial, artistic speech under the First Amendment. As an artistic expression of a singer, music videos are no longer the promotional mini-movies they once were; they are now utilized widely by artists to express their artistic preferences—including the communication of social, political, and cultural doctrine.⁵⁸ Part I of this Note explains the prevailing understanding of artistic speech and commercial speech under the First Amendment. This Part also explains the implications of such classifications under the First Amendment. Part II of this Note outlines the history behind the FTDA and shows how the Lanham Act and First Amendment protections interact. Part III of this Note lists what the Supreme Court deems as noncommercial speech in order to show the relative similarity between music videos and speech federally deemed as noncommercial. Part IV advocates for categorizing music videos as artistic, noncommercial speech under the First Amendment. This Part argues that music videos contain the same levels of artistic expression as that of movies, books, and music—categories that are granted full First Amendment protection.⁵⁹ One category of speech federally deemed as noncommercial—films and motion pictures—are granted full First Amendment protection, but the other category—music videos—with the same underlying rationale and artistic input has yet to be federally granted full First Amendment protection.⁶⁰ Although at least one state court has deemed music videos to be protected artistic expression under the First Amendment,⁶¹ Part V proposes that to ensure consistency, avoid confusion, and enhance certainty, music videos must be federally deemed as protected speech under the First Amendment.

I. BACKGROUND: FIRST AMENDMENT SPEECH

A. *Commercial Versus Noncommercial Speech*

The First Amendment provides that Congress may not abridge the freedom of speech.⁶² The United States Supreme Court articulates

⁵⁸ See *infra* Part IV.

⁵⁹ *Schad v. Borough of Mt. Ephraim*, 452 U.S. 61, 65 (1981).

⁶⁰ The Supreme Court of Kentucky is the only court that has explicitly pronounced music videos as protected expressions under the First Amendment. See *Montgomery v. Montgomery*, 60 S.W.3d 524, 529 (Ky. 2001).

⁶¹ *Id.* (“‘Music, as a form of expression and communication, is protected under the First Amendment.’ Likewise, ‘[e]ntertainment . . . is protected; motion pictures, programs broadcast by radio and television, and live entertainment, such as musical and dramatic works, fall within the First Amendment guarantee.’ Therefore, we have little difficulty in concluding that the music video in question is protected free expression under the U.S. and Kentucky Constitutions.”) (internal citations omitted).

⁶² U.S. CONST. AMEND. I (“Congress shall make no law respecting an establishment of

distinctions among types of speech.⁶³ There is, generally, noncommercial speech and commercial speech.⁶⁴ Noncommercial speech encompasses speech utilized in entertainment, art, satire, and politics that does more than solely propose a commercial transaction.⁶⁵ Noncommercial speech may also involve a matter of public concern.⁶⁶ First Amendment protection for noncommercial speech is not solely limited to written or spoken speech.⁶⁷ Protection is extended to all artistic entertainment forms, including that of motion pictures, radio and television broadcasts, musical and dramatic live performances, films, paintings, pictures drawings, sketchings, engravings, and sculptures.⁶⁸

On the other hand, the Supreme Court has held that commercial speech solely proposes a commercial transaction and has economic ties to the speaker and its audience.⁶⁹ While noncommercial speech typically involves political or religious aspects, commercial speech typically includes advertisements for products and services.⁷⁰ Protection afforded commercial speech⁷¹ is justified by the value to consumers that the information in the speech provides.⁷² However, full First Amendment protection to commercial speech would dilute the guarantee of constitutional protection afforded noncommercial speech.⁷³ However,

religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.”).

⁶³ See *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of New York*, 447 U.S. 557, 562 (citing *Ohralik v. Ohio State Bar Ass’n*, 436 U.S. 447, 455–56 (1978)).

⁶⁴ Langvardt, *supra* note 30, at 174.

⁶⁵ *Id.* at 174 (Noncommercial speech is speech “which is political, informational, artistic, for entertainment, or which involves some other manner of public concern.”). Throughout this Note, noncommercial speech and artistic speech are used interchangeably. Noncommercial speech encompasses artistic speech, which is speech that communicates artistic expression and is thus protected under the First Amendment. *Id.*

⁶⁶ *Id.*; see also *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952) (recognizing that motion pictures fall within the ambit of First Amendment protection because they have the capacity to affect public attitudes or characterize thought which encompasses all artistic expression.).

⁶⁷ *Hurley v. Irish-American Gay, Lesbian, and Bisexual Grp.*, 515 U.S. 557, 569 (1995) (“[T]he Constitution looks beyond written or spoken words as mediums of expression.”).

⁶⁸ *Id.*

⁶⁹ Langvardt, *supra* note 30, at 175 (“[T]he Supreme Court has described commercial speech as that which ‘does no more than propose a commercial transaction’ and as ‘expression related solely to the economic interests of the speaker and its audience.’”).

⁷⁰ Jennifer L. Pomeranz, *No Need to Break New Ground: A Response to the Supreme Court’s Threat to Overhaul the Commercial Speech Doctrine*, 45 *LOY. L.A. L. REV.* 389, 395 (2012).

⁷¹ See *infra* Part I.A.1. Commercial speech is reviewed under intermediate scrutiny, but not under strict scrutiny that is used to review noncommercial speech.

⁷² Pomeranz, *supra* note 70, at 401 (noting that protection of commercial speech affords the free flow of commercial information, informing consumers about and assisting consumers in good decision-making).

⁷³ *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 481 (1989) (“To require a parity of constitutional protection for commercial and noncommercial speech alike could invite dilution, simply by a leveling process, of the force of U.S. Const. amend. I’s guarantee with respect to the

distinguishing between the different types of speech is crucial in evaluating First Amendment protection.

1. Implications of Noncommercial Versus Commercial Speech

Since noncommercial and commercial speech are evaluated under different constitutional standards, there are large implications in making such distinctions. Noncommercial speech is entitled to full protection under the First Amendment, as it is evaluated under strict scrutiny.⁷⁴ Strict scrutiny means that a government restriction on speech will be upheld only if it is narrowly tailored to achieve a compelling state interest.⁷⁵ The Supreme Court reversed its position regarding First Amendment protection for commercial speech.⁷⁶ Formerly, the Supreme Court denied First Amendment protection to commercial speech altogether.⁷⁷ However, in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.* in 1976, the Supreme Court agreed to grant some First Amendment protection to commercial speech, meaning that commercial speech is evaluated under intermediate scrutiny.⁷⁸ Intermediate scrutiny means that a restriction on speech is only upheld if it directly advances a substantial governmental interest and is no more extensive than necessary to achieve that interest.⁷⁹

In *Jordan v. Jewel Food Stores, Inc.*, the Supreme Court declared an advertisement that a grocery store placed in its commemorative magazine issue, congratulating National Basketball Association player Michael Jordan for making it into the basketball hall of fame, as commercial speech.⁸⁰ Although the advertisement did not propose a commercial transaction, the grocery store placed its logo on the advertisement, creating image advertising for the grocery store while profiting off public affection for Michael Jordan.⁸¹ As commercial

latter kind of speech.”) (quoting *Ohralik v. Ohio State Bar Ass’n*, 436 U.S. 447, 456 (1978)).

⁷⁴ Langvardt, *supra* note 30, at 174.

⁷⁵ *Id.*

⁷⁶ *Va. State Bd. of Pharmacy v. Va. Citizens Council, Inc.*, 425 U.S. 748, 762 (1976).

⁷⁷ Langvardt, *supra* note 30, at 175; *see also* *Va. State Bd. of Pharmacy*, 425 U.S. at 762.

⁷⁸ *Va. State Bd. of Pharmacy*, 425 U.S. 748; *see also* *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 69 (1983) (The Defendant’s “[p]roposed commercial speech is therefore clearly protected by the First Amendment. Indeed, where—as in this case—a speaker desires to convey truthful information relevant to important social issues such as family planning and the prevention of venereal disease, we have previously found the First Amendment interest served by such speech paramount.”); *accord* *Zauderer v. Office of Disciplinary Counsel of Supreme Court of Ohio*, 471 U.S. 626, 637 (1985) (“There is no longer room to doubt what has come to be known as ‘commercial speech’ is entitled to the protection of the First Amendment, albeit to protection somewhat less extensive than that afforded ‘non-commercial speech.’”).

⁷⁹ *See* Langvardt, *supra* note 30, at 176.

⁸⁰ *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 517 (7th Cir. 2014).

⁸¹ *Id.* at 519.

speech, the advertisement still received First Amendment protection—intermediate scrutiny⁸²—but not the utmost protection of strict scrutiny afforded noncommercial speech.⁸³

Although commercial speech is now entitled to protection of the First Amendment, it still receives less than that afforded noncommercial speech.⁸⁴ Thus, noncommercial speech is subject to strict scrutiny and a regulation will be upheld only if the content-based regulation is narrowly tailored to serve a compelling state interest.⁸⁵ However, a regulation of commercial speech will only be upheld if it directly advances a substantial governmental interest and is no more extensive than is necessary to serve that interest.⁸⁶ The Supreme Court justifies evaluating commercial speech under less protective scrutiny because commercial speech is more likely to be regulated, yet less likely to be chilled, by the government.⁸⁷ Further, artistic expression—such as that expressed in titles—may complement the content of the work and aid the consumer of the work in identifying with that expression.⁸⁸

Noncommercial speech, as fully protected under the First Amendment, has more flexibility to utilize trademarks without first obtaining a license from the trademark owner.⁸⁹ As noncommercial

⁸² *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of New York*, 447 U.S. 557, 566 (1980).

⁸³ *Id.* at 566 (developing a four-part test to determine whether commercial speech can withstand intermediate scrutiny granted by the First Amendment); *see also supra* note 64, at 174.

⁸⁴ *Jordan*, 743 F.3d at 515 (citing *Zauderer v. Office of Disciplinary Counsel of Supreme Court*, 471 U.S. 626 (1985)).

⁸⁵ Langvardt, *supra* note 30, at 174.

⁸⁶ *Id.* at 176; *see also Cent. Hudson Gas & Elec. Corp.*, 447 U.S. at 566. “In commercial speech cases, then, a four-part analysis has developed. At the outset, we must determine whether the expression is protected by the First Amendment. For commercial speech to come within that provision, it at least must concern lawful activity and not be misleading. Next, we ask whether the asserted governmental interest is substantial. If both inquiries yield positive answers, we must determine whether the regulation directly advances the governmental interest asserted, and whether it is not more extensive than is necessary to serve that interest.” *Id.*

⁸⁷ *Cent. Hudson Gas & Elec. Corp.*, 447 U.S. at 566.

⁸⁸ *See Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989).

“Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker’s expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined. Film-makers and authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works. Furthermore, their interest in freedom of artistic expression is shared by their audience. The subtleties of a title can enrich a reader’s or a viewer’s understanding of a work. Consumers of artistic works thus have a dual interest: They have an interest in not being misled and they also have an interest in enjoying the results of the author’s freedom of expression. For all these reasons, the expressive element of titles requires more protection than the labeling of ordinary commercial products.” *Id.*

⁸⁹ *Using the Trademark of Others*, DIGITAL MEDIA LAW PROJECT (Oct. 19, 2016), <http://www.dmlp.org/legal-guide/using-trademarks-others>; *see also infra* Part IV.

speech, any trademark infringement claims may be defeated as the speech could satisfy the demands of the Roger’s Test⁹⁰—the public interest in free expression outweighs the public interest in avoiding consumer confusion.⁹¹ Under the Roger’s Test, a mark used in an expressive work will be prohibited only if the mark has no artistic relevance to the underlying work; and, if there is artistic relevance, the use of the mark in the work is only prohibited if it explicitly misleads as to the source or content of the work.⁹² Thus, even if there is consumer confusion regarding the use of a mark in an artistic work, artistic relevance to the alleged use of the mark will likely defeat the infringement claim so long as its use does not greatly mislead consumers as to the maker of the work.⁹³ After all, avoiding consumer confusion is what trademark laws are intended to protect against.⁹⁴ Since expressive works receive First Amendment protection, courts must weigh the trademark owner’s rights under the Lanham Act with the protections of the First Amendment when a mark is used in an expressive work.⁹⁵

II. THE LANHAM ACT AND ITS INTERACTION WITH THE FIRST AMENDMENT

A. *History of the Lanham Act*

The Lanham Act proscribes the standards for trademark liability.⁹⁶ The Act has been refined several times to reflect then-current case law and emerging dilution interests.⁹⁷ The Act currently distinguishes between two types of dilution: dilution by blurring⁹⁸ and dilution by tarnishment.⁹⁹ Though trademark infringement occurs when the defendant uses the plaintiff’s trademark in a way that is likely to cause

⁹⁰ See *infra* Part III.

⁹¹ *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989); see also *infra* Part II.D.2.

⁹² 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:144.50 (4th ed. 2017).

⁹³ *Id.*

⁹⁴ Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 722 (2004).

⁹⁵ See Bennett, *supra* note 51.

⁹⁶ 15 U.S.C. § 1125 (2012).

⁹⁷ See generally Lockridge, *supra* note 33.

⁹⁸ § 1125(c)(2)(B) (defining “dilution by blurring” as an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.”).

⁹⁹ 15 U.S.C. § 1125(c)(2)(C) (defining “dilution by tarnishment” as an “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”).

confusion, dilution claims occur when the defendant uses the plaintiff's trademark in connection with the defendant's own goods or services that causes the association between the plaintiff's mark and its goods or services to decrease.¹⁰⁰ Dilution by tarnishment, in particular, is an unauthorized use of the plaintiff's trademark in connection with other goods or services that are depicted in a somewhat negative or distasteful light, which in turn may adversely affect the reputation of the trademark owner's mark.¹⁰¹

A brief history of the defenses for dilution claims in the FTDA provides evidence that First Amendment concerns motivated their inclusion.¹⁰² The first dilution statutes contained no defenses for a dilution claim.¹⁰³ Forty years later, in 1987, the first federal dilution law arose due to concerns of inconsistency among state dilution statutes.¹⁰⁴ However, the first federal dilution bill similarly lacked statutory defenses.¹⁰⁵ It was not until 1995 that Congress included statutory exclusions in the FTDA.¹⁰⁶ Congress then made exclusions for fair and noncommercial uses of a mark.¹⁰⁷ The House's section-by-section report of the bill included First Amendment concerns as a justification for the newly added exclusions.¹⁰⁸ The report explained that the defenses were carved out to prevent courts from impinging on constitutionally protected speech.¹⁰⁹ Thus, Congress was wary of the potential for conflict between the FTDA and the First Amendment. Fair use is one of the statutory exclusions provided in the FTDA.¹¹⁰

B. *The "Fair Use" Exclusion*

Fair use includes descriptive fair use and a nominative fair use.¹¹¹

¹⁰⁰ Hampy, *supra* note 6.

¹⁰¹ *Id.*

¹⁰² Lockridge, *supra* note 33, at 347.

¹⁰³ *Id.* at 342.

¹⁰⁴ *Id.* at 343.

¹⁰⁵ *Id.*

¹⁰⁶ *Id.* at 346.

¹⁰⁷ *Id.* ("Excluded from dilution liability were two types of uses of another's trademark: 'Fair use of a registrant's mark by another person in comparative commercial advertising or promotion to identify the registrant's competing goods or services,' and 'Noncommercial use of a mark.'").

¹⁰⁸ *Id.* at 347 ("The proposal adequately addresses legitimate First Amendment concerns espoused by the broadcasting industry and the media. The bill will not prohibit or threaten 'noncommercial' expression . . .").

¹⁰⁹ *Id.* ("[T]he exceptions were designed to preclude the courts from enjoining speech that courts have recognized to be constitutionally protected.").

¹¹⁰ See 15 U.S.C. § 1125(c)(3) (2012).

¹¹¹ *Fair Use of Trademarks (Intended for a Non-Legal Audience)*, INT'L TRADEMARK ASSOC.

In descriptive fair use, the accused infringer uses the plaintiff's mark in order to describe her own product.¹¹² The infringed trademark in descriptive fair use is that which is not used as trademark; it is solely used for descriptive purposes.¹¹³ For example, a library pointing to one of its sections and entitling it Hot Picks, a registered trademark, is a descriptive fair use of Hot Picks because it is being used only to describe the library's own products.¹¹⁴

A nominative fair use is when the alleged infringer uses the plaintiff's mark to describe the plaintiff's products in the alleged infringer's advertising, website, or other materials.¹¹⁵ The Ninth Circuit advanced a three-part test to determine whether a use is a nominative fair use.¹¹⁶ To qualify, the product or service at issue must not be identifiable without the mark, only as much of the mark or marks as is reasonably necessary is shown to identify the product, and the user must not do anything with the mark that would suggest that the trademark owner sponsored or endorsed the use.¹¹⁷ An example of a nominative fair use is the defendant's use of New Kids on The Block, a registered mark, in a toll telephone poll listed in defendant's newspaper in order to ascertain the popularity of the group.¹¹⁸ The Ninth Circuit held that such use was entitled to the nominative fair use defense because there was nothing false or misleading about the defendant's use of the mark, defendant used only as much of the mark as needed to identify the group, and there was no suggestion that the New Kids on the Block sponsored or endorsed the poll.¹¹⁹ One question in the poll asked if New Kids is a "turn off"—strengthening defendant's stance because The New Kids would not refer to themselves or endorse themselves in that manner, lessening any possible confusion of sponsorship.¹²⁰ Another statutory exclusion in the FTDA is for noncommercial use.¹²¹

C. *The "Noncommercial Use" Exclusion*

The noncommercial use exception in the FTDA is still somewhat

(Jan. 2016), <http://www.inta.org/TrademarkBasics/FactSheets/Pages/Fair-Use-of-TrademarksNL.aspx>.

¹¹² Jacqueline Levasseur Patt, *Not All Is Fair (Use) in Trademarks and Copyrights*, INT'L TRADEMARK ASSOC. (Sep. 15, 2012), [http://www.inta.org/INTABulletin/Pages/NotAllIsFair\(Use\)inTrademarksandCopyrights.aspx](http://www.inta.org/INTABulletin/Pages/NotAllIsFair(Use)inTrademarksandCopyrights.aspx).

¹¹³ *Id.*

¹¹⁴ MARY MINOW & TOMAS A. LIPINSKI, *THE LIBRARY'S LEGAL ANSWER BOOK* 98 (2003).

¹¹⁵ Patt, *supra* note 112.

¹¹⁶ *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

¹¹⁷ *Id.* at 302.

¹¹⁸ *Id.* at 304.

¹¹⁹ *Id.* at 308.

¹²⁰ *Id.* at 309.

¹²¹ 15 U.S.C. § 1125(c)(3)(C) (2012).

controversial, however.¹²² There is confusion as to why the legislature even included an exclusion for noncommercial use in the 1995 FTDA because the Act only applied if the dilution occurred as a commercial use in commerce.¹²³ The legislature included the noncommercial exclusion to protect First Amendment speech that was not explicitly protected under other categories.¹²⁴ An interesting interpretation of the noncommercial use defense applied to a website that incorporated plaintiff's mark in its domain name "fuckgeneralmotors.com"—a website aimed at criticizing the holder of the mark.¹²⁵ The court elaborated that if the commercial use requirement of the FTDA is to have meaning, it cannot be interpreted broadly to encompass any claim that may commercially harm the mark's owner.¹²⁶ The noncommercial use exception also applies to a literary parody,¹²⁷ political commercials—both on television¹²⁸ and the Internet¹²⁹— and songs.¹³⁰ In this context, noncommercial speech also refers to that which does more than propose a commercial transaction.¹³¹

D. *Interplay Between the First Amendment and the Lanham Act*

Frequently, dilution and infringement claims under the broader Lanham Act interact with the protections of the First Amendment.¹³² It is important to note, however, that although the Lanham Act encompasses both infringement claims and dilution claims, courts apply different analyses and exemptions to each claim.¹³³ The noncommercial

¹²² MARY LAFRANCE, UNDERSTANDING TRADEMARK LAW 231 (2d ed. 2009).

¹²³ *Id.* at 231–33.

¹²⁴ *Id.* (“[The noncommercial use exclusion was included as a] catch-all for speech that was protected by the First Amendment but that fell outside of the FTDA’s exceptions for comparative advertising and news reporting.”).

¹²⁵ *Ford Motor Co. v. 2600 Enters.*, 177 F. Supp. 2d 661 (E.D. Mich. 2001).

¹²⁶ *Id.*

¹²⁷ LAFRANCE, *supra* note 122, at 232 (citing *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1573–74 (S.D. Cal 1996)).

¹²⁸ *Id.* (citing *Mastercard Int’l Inc. v. Nader 2000 Primary Comm., Inc.*, No. 00 Civ. 6068 (GBD), 2004 U.S. Dist. LEXIS 3644 (S.D.N.Y. 2004)).

¹²⁹ *American Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 686, 698–701 (N.D. Ohio 2002).

¹³⁰ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 906–907 (9th Cir. 2002).

¹³¹ *Id.*; Patrick D. Curran, *Diluting the Commercial Speech Doctrine: “Noncommercial Use” and The Federal Trademark Dilution Act*, 71 U. CHI. L. REV. 1077, 1089 (2004) (citing *Mattel*, 296 F.3d 894).

¹³² *See Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) (explaining that when First Amendment concerns bump up against The Lanham Act, the Act is construed to not infringe constitutional rights); *see also* Bennett, *supra* note 95 (noting that when expressive works incorporate trademarks, courts must weigh the rights of a trademark owner against First Amendment concerns).

¹³³ *See infra* Part II.D.1; *see also supra* Section II.D.2.

use exception applies to dilution claims.¹³⁴ The nominative fair use exception could apply to both infringement and dilution claims.¹³⁵

1. Dilution Claims Under the FTDA of the Lanham Act

To succeed on a dilution by tarnishment claim, the plaintiff must prove its trademark is famous, defendant is making a commercial use of the mark, defendant's use began after the mark became famous, and defendant's use of the mark dilutes the quality of the mark by hindering the identity of the mark to distinguish goods and services.¹³⁶ Under the FTDA, however, dilution claims are defrayed if a mark is used in noncommercial speech.¹³⁷

In *Lucasfilm Limited v. Media Market Group*, defendant produced a pornographic film using plaintiff's *Star Wars* film and other properties.¹³⁸ The U.S. District Court for the Northern District of California found that plaintiff succeeded on its dilution by tarnishment claim as per every element except for defendant's use as a commercial use of the mark.¹³⁹ Thus, the district court found that the defendant's use of the mark in a pornographic film tarnished the plaintiff's mark because its inclusion in an obscene film was inconsistent with the image the plaintiff created of its mark.¹⁴⁰ However, the defendant's use of the plaintiff's mark fell within the noncommercial use exception of the FTDA—disqualifying, in its totality, plaintiff's claim to dilution by tarnishment.¹⁴¹ The film was a parody—artistic speech subject to the protections of the First Amendment—and thus exempted from a dilution claim.¹⁴² The court recognized that trademark dilution does not apply to noncommercial use of the mark, despite how distasteful or unwholesome defendant's use may be.¹⁴³ Although mark owners can bring a case for trademark dilution against a third-party for an unauthorized use of their mark, mark owners can also bring a general trademark infringement claim against a third-party under the Lanham

¹³⁴ 15 U.S.C. § 1125(c)(3)(C) (2012); LAFRANCE, *supra* note 122, 231–32.

¹³⁵ Patt, *supra* note 112. Nominative fair use typically applies to noncommercial uses of a mark. As such, a nominative fair use could potentially be used to defeat general claims of trademark infringement as well as dilution by tarnishment claims. *Id.*

¹³⁶ *Lucasfilm Ltd. v. Media Mkt. Grp., Ltd.*, 182 F. Supp. 2d 897 (N.D. Cal. 2002).

¹³⁷ 15 U.S.C. § 1125(c)(3)(C) (2012).

¹³⁸ *Lucasfilm Ltd.*, 182 F. Supp. 2d at 900.

¹³⁹ *Id.*

¹⁴⁰ *Id.*

¹⁴¹ *Id.*

¹⁴² *Id.*

¹⁴³ *Id.*; *see also* *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002) (holding that a parodic song that tarnishes a mark with crude lyrics and sexual references is still subject to the noncommercial exclusion of the Act).

Act.¹⁴⁴

2. Infringement Claims Under the Lanham Act

The Roger's test is the test for balancing the protections of the Lanham Act against the protection of artistic speech under the First Amendment for trademark infringement claims.¹⁴⁵ Under the Roger's test, when an expressive work is alleged to infringe a trademark, courts weigh the public interest in free expression against the public interest in avoiding consumer confusion.¹⁴⁶ In *Rogers v. Grimaldi*, the plaintiff was a celebrity whose name was included in the title of defendants' motion picture.¹⁴⁷ The plaintiff sued alleging, among other things, false advertising under § 1125(a) of the Lanham Act and a violation of plaintiff's common-law right of publicity.¹⁴⁸ The Second Circuit Court of Appeals held that defendants' interest in the free expression of their title outweighed the public interest in avoiding consumer confusion.¹⁴⁹ Defendants' title did not substantially mislead the public and the title was artistically relevant to the motion picture, as the film's characters were named after the celebrities and they were sufficiently relevant to the film's content, to fall within the confines of artistic expression under the First Amendment.¹⁵⁰ Even if the title was somewhat ambiguous, that risk was outweighed by the risk of curbing First Amendment artistic expression.¹⁵¹ Thus, the *Roger's* court gave much deference to freedom of expression.¹⁵²

However, some courts do not give freedom of expression the same deference that the Second Circuit did in *Rogers*.¹⁵³ For example, in *San Francisco Arts and Athletics, Inc. v. United States Olympic Committee*, the Supreme Court granted a trademark holder rights irrespective of

¹⁴⁴ 15 U.S.C. § 1125(a)(1) (2012).

¹⁴⁵ *Girl Scouts of the U.S. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 808 F. Supp. 1112, 1121 (S.D.N.Y. 1992); *see also* *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

¹⁴⁶ *Rogers*, 875 F.2d at 999.

¹⁴⁷ 875 F.2d 994 (2d Cir. 1989).

¹⁴⁸ *Id.*

¹⁴⁹ *Id.* at 999.

¹⁵⁰ *Id.* at 1001–02.

¹⁵¹ *Id.* at 1001.

¹⁵² *Id.* (“To the extent that there is a risk that the title will mislead some consumers as to what the work is about, that risk is outweighed by the danger that suppressing an artistically relevant though ambiguous title will unduly restrict expression.”); *see also* *Louis Vuitton Malletier S.A. v. Warner Bros. Entertainment Inc.*, 868 F.Supp.2d 172, 178 (S.D.N.Y. 2012) (discussing that the artistic relevance prong of the *Rogers* test is purposely low and will be satisfied unless there is a complete lack of artistic relevance to the underlying work).

¹⁵³ Robert N. Kravitz, *Trademarks, Speech, and The Gay Olympics Case*, 69 B.U. L. REV. 131 (1989).

defendant's First Amendment concerns.¹⁵⁴ There, the defendant was enjoined from using the mark "Olympic" when coining its own athletic games "Gay Olympic Games."¹⁵⁵ In Justice Brennan's dissent, he explicitly recognizes the impediment to First Amendment rights and the failure of the Court to apply the defenses for trademark infringement in the Lanham Act.¹⁵⁶ When trademark infringement suits bump up against First Amendment guarantees, the trademark owner's rights are construed narrowly because she does not have a property right in her trademark that outweighs First Amendment rights of artistic expression.¹⁵⁷ Thus, when portions of the Lanham Act are allegedly infringed in an expressive work, courts give deference to the First Amendment for fear of curtailing important constitutional rights.¹⁵⁸

Additionally, *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.* is another case that held trademark rights prevailed over First Amendment concerns.¹⁵⁹ In *Dallas Cowboys Cheerleaders*, Dallas Cowboys Cheerleaders, Inc. sued the makers of a sexual film for trademark infringement and dilution¹⁶⁰ as the actors in the film engaged in sexually explicit acts while wearing a remarkably similar uniform to that of the Dallas Cowboys cheerleaders.¹⁶¹ After confirming that the Dallas Cowboys cheerleaders held a valid trademark in their distinctive and famous uniform, the Second Circuit held that even though the film might convey a message, the First Amendment does grant defendants the right to freely use plaintiff's trademark in the film.¹⁶² The Second Circuit employed a no alternative avenues test, which dispels the notion that if there are multiple ways of commenting on a particular topic—here, sexuality in athletics—without infringing plaintiff's trademark,

¹⁵⁴ 483 U.S. 522, 535–42 (1987).

¹⁵⁵ *Id.*

¹⁵⁶ Lois Nitti, *The Gay Olympics: San Francisco Arts & Athletics v. United States Olympic Committee*, 8 PACE L. REV. 373, 384 (1988) ("Justice Brennan stressed that these defenses were essential safeguards which prevented trademark power from infringing upon constitutionally protected speech.").

¹⁵⁷ *Girl Scouts of the U.S. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 808 F. Supp. 1112, 1119 (S.D.N.Y. 1992) ("To prevent filmmakers, novelists, painters, and political satirists from including trademarks in their works is to cordon off an important part of modern culture from public discourse.") (quoting Kravitz, *supra* note 153, at 152).

¹⁵⁸ *Id.* at 1118–19.

¹⁵⁹ 604 F.2d 200, 206 (2d Cir. 1979).

¹⁶⁰ The plaintiffs sued the defendants for trademark dilution in violation of Section 368-d of The New York General Business Law. The suit was brought in 1979 before the first federal dilution act, the FTDA of 1995, which took effect in 1996. Presumably, that is why the plaintiffs sued under a state, rather than federal, dilution statute.

¹⁶¹ *See generally Dallas Cowboys Cheerleaders, Inc.*, 604 F.2d 200.

¹⁶² *See id.* at 206 ("Nor does any other first amendment doctrine protect defendants' infringement of plaintiff's trademark. That defendants' movie may convey a barely discernible message does not entitle them to appropriate plaintiff's trademark in the process of conveying that message.").

then First Amendment values are not infringed.¹⁶³ However, numerous courts—including the same Circuit that espoused the test¹⁶⁴—expressly decline to follow the approach laid out in *Dallas Cowboys Cheerleaders, Inc.*¹⁶⁵ The no alternative avenues test laid out in *Dallas* improperly analogizes trademark rights with those of real property.¹⁶⁶ By comparing the two, First Amendment rights are improperly suppressed.¹⁶⁷ In denouncing the test and ultimate result in *Dallas*, courts are concerned with impinging on First Amendment values by giving a superior property right in trademarks.¹⁶⁸

III. FORMS OF ARTISTIC SPEECH

Artistic speech encompasses a wide variety of categories.¹⁶⁹ Among those are parodies,¹⁷⁰ films and motion pictures,¹⁷¹ programs broadcast by radio and television,¹⁷² music,¹⁷³ and other modes of entertainment.¹⁷⁴

A. *Parodies As Protected Expression*

In *Mattel v. MCA Records*, the plaintiff filed a trademark infringement suit against music publishers for titling their song “Barbie

¹⁶³ *Id.* (“Plaintiff’s trademark is in the nature of a property right, and as such it need not ‘yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.’”).

¹⁶⁴ *Rogers v. Grimaldi*, 875 F.2d 994, 999 n.4 (2d Cir. 1989) (“We do not read *Dallas Cowboys Cheerleaders* as generally precluding all consideration of First Amendment concerns whenever an allegedly infringing author has ‘alternative avenues of communication.’”).

¹⁶⁵ See *Louis Vuitton Malletier S.A. v. Warner Bros. Entertainment Inc.*, 868 F. Supp. 2d 172, 180 (S.D.N.Y. 2012).

¹⁶⁶ *Parks v. LaFace Records*, 329 F.3d 437, 449–50 (6th Cir. 2003).

¹⁶⁷ *Id.* at 450 (“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.”) (quoting *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987)).

¹⁶⁸ See generally *id.* (explaining that First Amendment concerns should not be precluded whenever there are alternative avenues of communication).

¹⁶⁹ Langvardt, *supra* note 30, at 175. Artistic speech includes forms of artistic expression such as music, films and motion pictures, and other entertainment, which are typically protected as noncommercial speech due to their ability to encourage self-expression. *Id.*

¹⁷⁰ See, e.g., *Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120 (C.D. Cal. 1998) (holding that there was no trademark infringement of the song “Barbie Girl” as it was a parody, and thus it received full First Amendment protection).

¹⁷¹ See, e.g., *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495 (1952).

¹⁷² See, e.g., *Montgomery v. Montgomery*, 60 S.W.3d 524, 529 (Ky. 2001) (citing *Schad v. Borough of Mount Ephraim*, 452 U.S. 61 (1981)).

¹⁷³ See, e.g., *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989); see also *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 924 (6th Cir. 2003).

¹⁷⁴ See, e.g., *Schad v. Borough of Mount Ephraim*, 452 U.S. 61, 66 (1981) (holding that nude dancing was a form of entertainment protected under the First Amendment).

Girl,” using the name of the toy manufacturer’s product.¹⁷⁵ The U.S. District Court for the Central District of California held that the defendant music publishers did not infringe on the plaintiff’s trademark because defendant’s song “Barbie Girl” was a parody of the plaintiff’s product and thus the song was entitled to the protection of the First Amendment.¹⁷⁶ The court utilized the test advanced in *Rogers v. Grimaldi* to reach its holding.¹⁷⁷ When an expressive work is alleged to infringe a trademark, the public interest in free expression is weighed against the public interest in avoiding consumer confusion.¹⁷⁸ Thus, the court recognized the defendant’s significant First Amendment interests at stake and held that the inclusion of the mark “Barbie Girl” in the title of defendant’s parodic song outweighed the possibility that some consumers would be confused as to plaintiff’s association with, or possible endorsement of, the song.¹⁷⁹ The court also recognized that although the First Amendment does not completely insulate trademark infringement claims, courts must be cognizant not to impede free speech rights in order to protect trademarks.¹⁸⁰

B. *Films and Motion Pictures As Protected Expressions*

Films and motion pictures also fall under the umbrella of First Amendment protection because of their ability to impact societal attitudes by communicating a political or social doctrine or by using such doctrine to change consumer’s attitudes.¹⁸¹ It is that very impactful change that underlies artistic expression.¹⁸² The fact that motion pictures are sold for a profit does not remove their free speech guaranty under the First Amendment.¹⁸³ The same is equally true for books and other periodicals.¹⁸⁴

¹⁷⁵ *Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120 (C.D. Cal. 1998).

¹⁷⁶ *Id.* at 1140.

¹⁷⁷ *Id.* at 1152.

¹⁷⁸ *Id.* at 1144; *see* *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

¹⁷⁹ *Mattel*, 28 F. Supp. 2d at 1152 (recognizing that “parody has an obvious transformative value . . . Like less ostensibly humorous forms of criticism, it can provide social benefit, by shedding light on an earlier work, and, in the process, creating a new one. . . .”) (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994)).

¹⁸⁰ *Id.* at 1144–45 (“The owner of a trademark does not possess a property right that is superior to the First Amendment right accorded to artistic expression.”) (citing *Girl Scouts of the U.S. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 808 F. Supp. 1112 (S.D.N.Y. 1992)).

¹⁸¹ *See* *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501–02 (1952).

¹⁸² *See generally id.* (noting that freedom of expression encompasses art forms which espouse political or social doctrine and impact public attitudes).

¹⁸³ *Smith v. Cal.*, 361 U.S. 147, 150 (1959) (“It is of course no matter that the dissemination takes place under commercial auspices.”).

¹⁸⁴ *Id.* at 150.

C. *Programs Broadcast by Radio and Television As Protected Expression*

Similarly, programs broadcast by radio and television are protected as artistic expressions under the First Amendment.¹⁸⁵ Displaying trademarks in television shows is completely legal.¹⁸⁶ Television producers opt to displace popular trademarks by covering them up for a myriad of reasons including to deter trademark owners from requesting a licensing fee to show their mark, to avoid free advertising of the mark when companies pay to insert their marks, and to avoid disdain from a trademark owner who objects to her mark's inclusion if it is being displayed in a negative way.¹⁸⁷

D. *Music As Protected Expression*

Music is also a category protected under the First Amendment.¹⁸⁸ The Supreme Court of Kentucky case *Montgomery v. Montgomery* is significant because the Supreme Court of Kentucky is the only court to consider and explicitly hold that music videos are protected artistic expressions protected under the First Amendment.¹⁸⁹ In *Montgomery v. Montgomery*, John Michael Montgomery, the son of musician Harold E. Montgomery, produced a music video for his song as a tribute to his late father.¹⁹⁰ The song contains, in total, up to thirty seconds exploiting the name and likeness of Harold, and the music video includes a tape of Harold singing, pictures of Harold, and photographs of both Harold with John and Harold alone.¹⁹¹ Before producing and publishing the music video, John did not receive permission from Harold's estate to use Harold's name or likeness.¹⁹² Harold's estate then initiated suit, alleging that John exploited Harold's right of publicity.¹⁹³ In finding for John, the Supreme Court of Kentucky elaborated that the right of publicity is constrained by the constitutional guaranty of freedom of

¹⁸⁵ *Schad v. Borough of Mt. Ephraim*, 452 U.S. 61, 65 (1981).

¹⁸⁶ Matt Klein, *Why Do TV Shows and Movies Cover Up Logos?*, HOW TO GEEK (Aug. 24, 2016), <http://www.howtogeek.com/243047/why-do-tv-shows-and-movies-cover-up-logos>.

¹⁸⁷ *Id.*; Gladys Santiago, *Product Displacement Explained: Part 1*, WORD PRESS (Apr. 16, 2009), <https://gladyssantiago.wordpress.com/2009/04/16/product-displacements-explained-part-1>.

¹⁸⁸ *Schad v. Borough of Mount Ephraim*, 452 U.S. 61, 65 (1981).

¹⁸⁹ 60 S.W.3d 524, 529 (Ky. 2001).

¹⁹⁰ *Id.* at 526.

¹⁹¹ *Id.*

¹⁹² *Id.*

¹⁹³ *Id.*; The right of publicity is an individual's right to control the commercial use of her name, image, or likeness. See *Right of Publicity: An Overview*, LEGAL INFORMATION INSTITUTE, <https://www.law.cornell.edu/wex/publicity>.

expression.¹⁹⁴

IV. ANALYSIS: MUSIC VIDEOS SHOULD BE FEDERALLY CLASSIFIED AS NONCOMMERCIAL SPEECH UNDER THE FIRST AMENDMENT

A. *Music Videos Are Forms of Artistic Expression*

Artists are increasingly using music videos as a means of artistic expression.¹⁹⁵ Many music videos have underlying messages that artists convey by depicting certain elements in the video in conjunction with their song.¹⁹⁶ For instance, Beyoncé’s music video for her song “Formation” includes expressive elements about black empowerment, police violence, and feminism.¹⁹⁷ In her music video, Beyoncé includes the image of a police car with corresponding lyrics about African-American stereotypes.¹⁹⁸ Beyoncé utilized her music video to express cultural values in an aesthetic way.¹⁹⁹ Other artists have similarly utilized music videos as an art form to convey messages.²⁰⁰ Kanye West’s music video for “Famous” included a scene with him and wife Kim Kardashian lying nude in bed surrounded by other nude celebrity look-alikes.²⁰¹ Kanye artistically modeled that scene after a painting by Vincent Desiderio.²⁰² Although he received much criticism around the provocativeness of the nudity and the eclectic mix of celebrity look-alikes, Kanye defended his artistic expression saying that his music video was a comment on fame.²⁰³

Although Beyoncé and Kanye decided to use music videos as a means of explicitly conveying a message, other artists—such as Justin

¹⁹⁴ See *Montgomery*, 60 S.W.3d at 528–29.

¹⁹⁵ Jon Caramanica, *Good News for MTV’s V.M.A.s: Music Videos Matter Again*, N.Y. TIMES (Aug. 25, 2016), http://www.nytimes.com/2016/08/26/arts/music/mtv-vm-as-beyonce-drake-kanye-west.html?_r=0.

¹⁹⁶ *Id.*

¹⁹⁷ *Id.*; Mehera Bonner, *The True Story Behind Beyonce’s “Formation” Song Lyrics*, MARIE CLAIRE (July 6, 2016), <http://www.marieclaire.com/celebrity/news/a21391/beyonce-formation-explained>.

¹⁹⁸ Caramanica, *supra* note 195; *Beyonce Knowles Lyrics*, AZ LYRICS, <http://www.azlyrics.com/lyrics/beyonceknowles/formation.html>.

¹⁹⁹ Bonner, *supra* note 197.

²⁰⁰ DOUGLAS KELLNER, *MEDIA CULTURE: CULTURAL STUDIES, IDENTITY, AND POLITICS BETWEEN THE MODERN AND THE POSTMODERN* 281 (1995) (“[Madonna’s] videos . . . attempted to expand the boundaries of the permissible in terms of male and female gender roles, overt sexuality, parody of religion, and modernist ambiguity.”).

²⁰¹ Ashley Lasimone, *Kanye West Explains ‘Famous’ Video Concept*, BILLBOARD (June 25, 2016), <http://www.billboard.com/articles/columns/hip-hop/7416571/kanye-west-famous-video-concept>.

²⁰² *Id.*

²⁰³ *Id.*

Bieber and Drake—decided to use their music videos in a way in which the audience could interpret and draw their own conclusions.²⁰⁴ Drake’s “Hotline Bling” video and Justin Bieber’s “Sorry” video include less explicit, if any, expressive messages and were meant to serve as blank canvases for the audience to interpret.²⁰⁵ Although such artists did not explicitly convey an expressive message, their music videos are nonetheless an art form, as artists frequently leave their works unfinished with the hopes that the audience will fill in the blanks—applying multiple conclusions to one aesthetic piece.²⁰⁶ Being that music videos are forms of artistic expression, and are the visual extensions of the lyrical component of music²⁰⁷—a category granted noncommercial protection under the First Amendment—music videos deserve the same protection.

B. *Music Videos Play an Important Social Role in Society*

As visual depictions of music, music videos also convey important messages about societal roles and interactions.²⁰⁸ Music has been an essential part of human existence since prehistoric times.²⁰⁹ Some researchers even coin music as a human need²¹⁰ due its ability to foster social cohesiveness and a sense of belonging.²¹¹ Collaborative efforts in music rituals in prehistoric times encouraged social cohesiveness, which enabled the preservation of society by forming groups that collectively fought predators and hunted for food.²¹² Music videos, serving as pictorial illustrations of music, serve the same role—they foster social cohesiveness and teach about social roles and interactions.²¹³ Beyoncé’s

²⁰⁴ Caramanica, *supra* note 195.

²⁰⁵ *Id.*

²⁰⁶ JOHN CAREY, WHAT GOOD ARE THE ARTS? 84 (2006) (“The advantage of an unfinished work of art . . . is that it does not tie the visual system down to a single definite form.”).

²⁰⁷ MATHIAS BONDE KORSGAARD, MUSIC VIDEO AFTER MTV: AUDIOVISUAL STUDIES, NEW MEDIA, AND POPULAR MUSIC 63 (2017) (“The obvious function of [a] music video is that it ‘visualizes music,’ as, in a music video, an already existing piece of popular music is given a visual supplement.”).

²⁰⁸ MEDIA ENTERTAINMENT: THE PSYCHOLOGY OF ITS APPEAL 176 (DOLF ZILLMANN & PETER VORDERER eds., 2000) (“Music videos, which provide additional social information in the visual imagery, can be an especially potent source of information about social roles, consumerism, and culture.” (citing Sun & Lull, 1986)).

²⁰⁹ Flora Rostami, *Free Is Hard to Beat: A Closer Look at the Digital Music Download Dilemma*, 15 UCLA J.L. & TECH. 1,16 (2011).

²¹⁰ *Id.* at 15.

²¹¹ Andrew R. Salminen, *Music and the Human Need for Social Identity and Emotional Impulse*, BELMONT UNIVERSITY, <http://www.belmont.edu/burs/pdf/Music%20-%20Salminen.pdf>.

²¹² Rostami, *supra* note 209, at 16 (noting that music helped people form collective identities, and foster the social cohesiveness necessary for survival).

²¹³ *Id.*; Basil G. Englis, *Music Television and Its Influences on Consumer Culture, and the Transmission of Consumption Messages*, 18 ADVANCES IN CONSUMER RESEARCH 111 (1991)

music video for “Formation” did more than just convey a cultural message. It encouraged social cohesiveness among those in the video, and it enabled them to bond over cultural similarities and differences.²¹⁴

In addition to serving a social function, music videos also serve to convey social messages.²¹⁵ Music videos became such a prominent means of advancing social messages that in 2011, MTV added a new category—Best Video With a Message—to award artists at the Video Music Awards.²¹⁶ Lady Gaga was the first recipient of the Best Video With a Message award for her song “Born This Way.”²¹⁷ “Born This Way” is meant to encourage a world free from discrimination and thus to deter consequential self-insecurity.²¹⁸ Other nominees included Katy Perry’s “Firework,” which is intended to promote individual uniqueness, and Taylor Swift’s “Mean,” which is intended to convey that being mean does not achieve anything.²¹⁹

Lady Gaga did not stop conveying social messages through her music with “Born This Way,” however. On February 5, 2017, Lady Gaga took the stage at the Super Bowl LI halftime show.²²⁰ Gaga sang a variety of songs—including some that are not her own—that aggregately culminated into an overt message about inclusion and equality.²²¹ Gaga opened the show singing “God Bless America” and continued with “This Land Is Your Land”—both conveying a political and social message about inclusion.²²² Gaga also sang “Born This Way”—a less-than-subtle ode to the Lesbian, Gay, Bisexual, Transgender, and Queer (LGBTQ) community, “Poker Face”—which addresses Gaga’s own bisexuality, and “Telephone”—which hints at the idea that the upper class has some disdain toward those in the general population.²²³

(explaining that music television has the potential to foster socialization among consumers).

²¹⁴ See generally Bonner, *supra* note 197 (noting that the overall idea behind “Formation” is black empowerment and feminism—enabling the dancers to bond over the song’s activism).

²¹⁵ Lucas Kavner, *VMAs 2011: ‘Best Video With A Message’ Category Premieres Tonight*, HUFF. POST (Aug. 28, 2011), http://www.huffingtonpost.com/2011/08/28/mtv-premieres-best-video-_n_939877.html.

²¹⁶ *Id.*

²¹⁷ Nicole James, *2011 MTV VMA Winners List*, MTV (Aug. 29, 2011), <http://www.mtv.com/news/2298947/2011-vma-winners-list>.

²¹⁸ Kavner, *supra* note 215.

²¹⁹ *Id.*

²²⁰ Chloe Melas, *Lady Gaga Brings Message of Inclusion to Super Bowl Halftime—Oh, and Drones*, CNN (Feb. 6, 2017, 3:06 PM), <http://www.cnn.com/2017/02/05/entertainment/lady-gaga-super-bowl-halftime-show-2017>. Although Lady Gaga conveyed her message during a live performance, she utilized music to convey those messages, and music videos have a similar role in facilitating that communication as well.

²²¹ *Id.*

²²² *Id.*

²²³ *Id.*; see also Christopher Luu, *The Hidden Meaning Behind Lady Gaga’s Super Bowl Songs*, REFINERY29 (Feb. 5, 2017, 9:00 PM), <http://www.refinery29.com/2017/02/139427/lady-gaga-super-bowl-songs-hidden-meaning-lgbtq-diversity>.

Similarly, at twenty-five years old, artist Hayley Kiyoko uses her music video to convey social messages about contemporary issues in society.²²⁴ Kiyoko's music video for her song "One Bad Night" portrays a transgender woman getting beat up and harassed by people on the street.²²⁵ An African-American boy watches the violence and comes to her rescue.²²⁶ The two then sit down and enjoy a meal together, laughing and talking throughout the meal.²²⁷ Kiyoko's song is lyrically not about the events in the music video.²²⁸ The song is actually about a fantasy of sexual activity in a car.²²⁹ However, Kiyoko thought it was important to make the video as a reminder of human compassion.²³⁰ Kiyoko wanted to portray that even the most unexpected people can be someone's hero and a simple kind gesture can go a long way.²³¹ Further, Kiyoko directed her own video to ensure her creative vision came to life,²³² supporting the proposition that artists are increasingly using music videos as an art form.²³³

Music videos are no longer the promotional videos they once were.²³⁴ Music videos are being used ubiquitously to both express important cultural and social messages in an artistic manner, and also to play a critical role in developing social behavior.²³⁵ An indicator of noncommercial speech is defined as speech that addresses a matter of public concern.²³⁶ Although being a matter of public concern does not exclusively indicate noncommercial speech, speech that does not involve commercial transactions, but addresses a matter of public concern, is granted protection.²³⁷ Artists are utilizing their music videos and respective songs as an art form to capitalize on issues of public concern.²³⁸ By relaying messages through their music videos about

²²⁴ Kim Taylor Bennett, *Hayley Kiyoko's Video for "One Bad Night" Packs a Serious Punch*, VICE: NOISEY (Oct. 11, 2016, 10:08 AM), https://noisey.vice.com/en_us/article/hayley-kiyokos-video-for-one-bad-night-packs-a-serious-punch.

²²⁵ *Id.*

²²⁶ *Id.*

²²⁷ *Id.*

²²⁸ *Id.*

²²⁹ *Id.*

²³⁰ *Id.*

²³¹ *Id.*

²³² *Id.*

²³³ See *supra* Section IV.A.

²³⁴ See Caramanica, *supra* note 195 (noting that music videos can be a stand-alone art form that convey political and other societal messages).

²³⁵ Englis, *supra* note 213 ("Although music videos originated as promotional tools for record albums, the videos themselves present the viewer with far more than music: they provide information about fashion and cosmetics, lifestyles, and social roles and behavior.")

²³⁶ Langvardt, *supra* note 30, at 174.

²³⁷ *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 68 (1983) (citing *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of New York*, 447 U.S. 557, 563 (1980)).

²³⁸ See *generally* Bonner, *supra* note 197 (discussing how Beyoncé used her music video of "Formation" to make a statement about black empowerment and feminism).

discrimination, police violence, feminism, black empowerment, equality, and promotion of individual originality, among others, artists are screaming—or rather, harmoniously chanting—matters of public concern through their music.²³⁹ As the visual extension of their music, music videos help address those matters of public concern and further aesthetically depict them.²⁴⁰

If artists' music videos are not deemed noncommercial speech under the First Amendment, the expressive element of their underlying message is obstructed and their free speech is consequentially hindered.²⁴¹ If their auditory counterpart—music—is granted full First Amendment protection, but the video extension of them—music videos—are not, there will be the deleterious effect of curtailing societal and cultural messages, and artists will not be able to fully express themselves and their respective issues of public concern.²⁴² Music and other protected categories are deemed noncommercial because they contain the ability to advocate a political or social doctrine and affect public attitudes that is the very essence of artistic expression.²⁴³ Music videos are achieving that same result, but yet are not granted the same respect and have not federally been granted the same classification.²⁴⁴

C. *Music Videos are Mini-Movies, Deserving of First Amendment Protection*

Films and motion pictures are among the categories that receive full First Amendment protection.²⁴⁵ Movies are granted full First Amendment protection because they are a communicative means of

²³⁹ *See id.*

²⁴⁰ *Id.*

²⁴¹ *See* *Girl Scouts of the U.S. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 808 F. Supp. 1112, 1119 (S.D.N.Y. 1992) (noting that the First Amendment should defend the inclusion of trademarks in artistic works where trademarks help to convey a message (citing Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 202 (1982))).

²⁴² *See* *Winters v. New York*, 333 U.S. 507, 510 (1948) (“The line between the informing and the entertaining is too elusive for the protection of that basic right [a free press]. Everyone is familiar with instances of propaganda through fiction. What is one man’s amusement, teaches another’s doctrine.”).

²⁴³ *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952).

²⁴⁴ *See* *Montgomery v. Montgomery*, 60 S.W.3d 524 (Ky. 2001) (acknowledging that the Supreme Court of Kentucky holds music videos as noncommercial speech); *see also* *Caramanica*, *supra* note 195. *See generally* *Bonner*, *supra* note 197.

²⁴⁵ *Montgomery*, 60 S.W.3d at 529 (citing *Schad v. Borough of Mount Ephraim*, 452 U.S. 61 (1981)).

political or social doctrine that affect public attitudes.²⁴⁶ Although movies are made for a profit,²⁴⁷ they are not stripped of their First Amendment protection—as books, newspapers, and magazines are similarly sold for a profit, yet still enjoy the protections of the First Amendment.²⁴⁸ In contrast, music videos, as an extension of music, receive full protection in at least one jurisdiction,²⁴⁹ but have yet to be federally deemed noncommercial speech worthy of full First Amendment protection.²⁵⁰

The same artistry and skill set is needed for the making of a movie as it is for the making of a music video.²⁵¹ Both involve artistic input and creative expression.²⁵² A music video is indeed a mini-movie in which production, direction, and talent are retained, but for a shorter time period.²⁵³ Yet, the same creative input—story line, characters, lighting, camera angles, and composition—is involved.²⁵⁴ Further, music videos similarly affect public values and communicate political or social doctrines.²⁵⁵ The disparity in treatment of works artistically and pedagogically similar will have the disastrous effect of impinging on artists' free speech.²⁵⁶

Although music videos are mini-movies worthy of First Amendment protection,²⁵⁷ some courts have refused to extend that protection to short video programs.²⁵⁸ In *Facenda v. N.F.L. Films, Inc.*, the estate of National Football League broadcasting icon John Facenda sued National Football League Films (NFL) and its affiliates for—among other things—the incorporation of Facenda's voice in a cable-television broadcast about an upcoming video game “Madden NFL 06” as false endorsement under the Lanham Act and in violation of

²⁴⁶ *Joseph Burstyn*, 343 U.S. at 501.

²⁴⁷ *Id.* at 501–02.

²⁴⁸ *Id.*

²⁴⁹ *Montgomery*, 60 S.W.3d at 529.

²⁵⁰ See Alexia Bedat, *Kanye West's Video "Famous": A Celebrity (Legal) Hotbed?*, INFORM'S BLOG, <https://inform.org/2016/07/02/kanye-wests-video-famous-a-celebrity-legal-hotbed-alexia-bedat> (“Presumably, Kanye West would not be sued in Kentucky. Whether other states would adopt the same analysis and deem his video to be constitutionally protected speech is unclear. As the cases below show, courts have approached expressive works differently.”).

²⁵¹ *Montgomery*, 60 S.W.3d at 529 (“Music videos are in essence mini-movies that often require the same level of artistic and creative input from the performers, actors, and directors as is required in the making of motion pictures.”).

²⁵² *Id.*

²⁵³ See *id.*

²⁵⁴ Shaun Letang, *How To Make a Music Video for Beginners*, MUSIC INDUSTRY HOW TO (Jan. 1, 2017), <http://www.musicindustryhowto.com/how-to-make-a-music-video-for-beginners>.

²⁵⁵ See *supra* Section IV.B.

²⁵⁶ See, e.g., *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 458 (Cal. 1979) (“To limit how one speaks not only impedes self-expression but diminishes the public dialogue so essential to a free people.”).

²⁵⁷ See *supra* Section IV.C.

²⁵⁸ *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1015 (3d Cir. 2008).

Facenda's right to publicity.²⁵⁹ NFL Films raised a First Amendment defense—arguing that the cable-television program was protected speech as artistic expression under the First Amendment.²⁶⁰ If the court deemed the cable-television broadcast program as protected, NFL had a complete defense to Facenda's estate's false endorsement claim as the statute only refers to a use in commerce,²⁶¹ and the estate's right to publicity claim would likely fall to the protections of the First Amendment.²⁶²

However, the Third Circuit deemed the cable-television broadcast about Madden NFL 06 as commercial speech under the three-factor test advanced by *Bolger v. Young Drugs Product Corp.*²⁶³ To determine whether speech is commercial, the court must determine whether the speech is an advertisement, whether the speech refers to a specific product or service, and whether the speaker has an economic motivation for the speech.²⁶⁴ The Third Circuit determined that the cable-television production at issue affirmatively met all three factors.²⁶⁵ The cable-television production was like an infomercial which positively focused on one product—Madden NFL 06—that only played eight times in a three-day period before the release of the video game; the speech solely referred to Madden NFL 06; and the NFL contracted with a company that gave the NFL financial motivations for the speech, on top of that which the company indirectly retained through promotion of NFL products.²⁶⁶ The Third Circuit agreed that courts generally fully protect speech when there is speech near the commercial/noncommercial boundary line.²⁶⁷ Here, however, the Third Circuit refused to apply that deference because the cable-television production promoted another expressive work—Madden NFL 06.²⁶⁸

Although the Third Circuit refused to deem the cable-television

²⁵⁹ *Id.*

²⁶⁰ *Id.* at 1015.

²⁶¹ Lanham Act § 43(a), 15 U.S.C. § 1125(a)(1) (2012).

²⁶² *Rogers v. Grimaldi*, 695 F. Supp. 112, 121–22 (S.D.N.Y. 1988), *aff'd*, 875 F.2d 994 (2d Cir. 1989) (“[C]ourts have been consistently unwilling to recognize the right of publicity cause of action where the plaintiff’s [likeness] was used in connection with a matter of public interest, be it news or entertainment.”); *see also* *Simeonov v. Tiegs*, 602 N.Y.S.2d 1014, 1018 (N.Y. Civ. Ct. 1993) (“Although a person’s right of privacy as protected by Civil Rights Law sections 50 and 51 is also a very significant right, it must fall to the constitutionally protected right of freedom of speech.”).

²⁶³ *Bolger v. Young Drugs Prod. Corp.*, 463 U.S. 60, 66–67 (1983); *see also* *Facenda*, 542 F.3d at 1017–18.

²⁶⁴ *Facenda*, 542 F.3d at 1017–18.

²⁶⁵ *Id.*

²⁶⁶ *Id.* at 1017.

²⁶⁷ *Id.* at 1018 (“Although we err on the side of fully protecting speech when confronted with works near the line dividing commercial and noncommercial speech, we do not view ‘The Making of Madden NFL 06’ as close to that boundary.”).

²⁶⁸ *Id.*

production—or, mini-movie—as noncommercial speech,²⁶⁹ there are major distinctions between the speech at issue there and music videos. First, music videos are not advertisements.²⁷⁰ Music videos, while potentially promote a song indirectly, primarily serve to visually aid the expression of artistic preferences and espouse matters of public concern or social and political doctrines.²⁷¹ Further, unlike the cable-television production in *Facenda*, music videos do not solely air for a short period before the release of a new song and then drop off into the deep end, but continue to air throughout the duration of the song and are accessible in perpetuity on websites such as YouTube.²⁷² Second, a music video does not solely refer to a specific product or service—a song—but rather embraces a song in its totality to express it artistically and creatively.²⁷³ Although an outdated theory views music videos as the promotional counterparts of songs,²⁷⁴ music videos now serve a much more didactic function of communicating and expressing cultural, political, and social ideas.²⁷⁵ Third, an artist does not always have a purely economic motivation for a music video, but instead may be motivated by the desire to convey a message while simultaneously expressing her own artistic take on the matter.²⁷⁶ Although music videos may indirectly obtain a profit for an artist by promoting her song, this should not preclude music videos from receiving full First Amendment protection.²⁷⁷ Thus, music videos fail to meet the three-factor test

²⁶⁹ *Id.*

²⁷⁰ *Montgomery v. Montgomery*, 60 S.W.3d 524, 529 (Ky. 2001) (“[M]usic videos are aired on television not as advertisements but as the main attraction . . .”).

²⁷¹ See *supra* Section IV.B.

²⁷² YouTube is an online platform that enables users to view, share, and upload original videos. See *Celebrating 10 Years of YouTube*, GOOGLE BLOG: YOUTUBE (May 1, 2015), <https://youtube.googleblog.com/2015/05/celebrating-10-years-of-youtube.html>; see also Ari Herstand, *Everyone Calm Down. YouTube is NOT Going to Remove Music Videos*, DIGITAL MUSIC NEWS (June 17, 2014), <https://www.digitalmusicnews.com/2014/06/17/youtube-not-going-remove-music-videos>.

²⁷³ See *Montgomery*, 60 S.W.3d at 529 (noting that music videos are not aired as advertisements, but instead, as the main attraction).

²⁷⁴ Englis, *supra* note 213 (“Although music videos originated as promotional tools for record albums, the videos themselves present the viewer with far more than music: they provide information about fashion and cosmetics, lifestyles, and social roles and behavior.”).

²⁷⁵ See *supra* Section IV.B; see also Englis, *supra* note 213.

²⁷⁶ See Christopher Luu, *The Hidden Meaning Behind Lady Gaga’s Super Bowl Songs*, REFINERY29 (Feb. 5, 2017, 2:00 AM), <http://www.refinery29.com/2017/02/139427/lady-gaga-super-bowl-songs-hidden-meaning-lgbtq-diversity> (explaining that when Lady Gaga released “Born This Way,” she said in an interview that she does not want to make money with her music—she wants to make a difference); see also Caramanica, *supra* note 195 (“Each of these videos, in its own way, shows an artist deploying the form as a novel means of garnering attention in an increasingly scattered marketplace, using either provocation or participation. That all these approaches are arriving at once suggests a new era of maturity for music video, one in which the biggest stars are also among the biggest innovators.”).

²⁷⁷ *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501–02 (1952) (“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. We fail to see why operation

advanced in *Bolger* to be classified as commercial speech.²⁷⁸ As a sister work to films and motion pictures, music videos deserve to obtain the same noncommercial classification and thus protection under the First Amendment as films and motion pictures do.

V. PROPOSAL: THE NEED FOR CERTAINTY AND FREEDOM OF
EXPRESSION DICTATES WHY MUSIC VIDEOS MUST BE FEDERALLY
DEEMED AS NONCOMMERCIAL SPEECH

Although one state court classified music videos as fully protected under the First Amendment,²⁷⁹ a federal classification would eliminate uncertainty and foster efficiency in the music industry.²⁸⁰ As the law currently stands, some record labels prefer to blur still, visible trademarks in music videos in order to insulate the label from any claims of infringement or dilution.²⁸¹ If the Supreme Court declared music videos as noncommercial speech, record labels would no longer have to expend the time and money analyzing every minute detail of music videos to ensure unlicensed trademarks are not readily visible.²⁸²

Further, record labels would not have to alter the artist's artistic expression out of fear of litigation.²⁸³ For example, an undisclosed record label dealt with a situation in which one of their artists wanted to use a common trademarked expression in their music video.²⁸⁴ However, the requested expression did not refer to the trademark as such, but instead would have been used to refer to drugs as implicated in the song.²⁸⁵ The record label personnel had lengthy discussions about the inclusion of the mark, and whether or not it was worth the risk knowing that the company that owns the mark is particularly litigious.²⁸⁶ Although the label explicitly talked about never wanting to

for profit should have any different effect in the case of motion pictures.”).

²⁷⁸ See *supra* Section IV.C (noting that music videos are not advertisements and artists may not have an economic motivation for their speech).

²⁷⁹ *Montgomery v. Montgomery*, 60 S.W.3d 524, 529 (Ky. 2001) (holding music videos as artistic, noncommercial speech under the First Amendment).

²⁸⁰ See Interview with Record Label (Dec. 5, 2016). I interviewed a record label to ascertain what the implications of a federal classification of music videos as noncommercial speech would be for them. *Id.* I asked them how the label currently handles the use of trademarks in their music videos. *Id.* I asked them how such a classification might affect artistic expression. *Id.* The record label asked to remain anonymous. This Note does not disclose the name of the record label in order to protect its anonymity.

²⁸¹ *Id.*

²⁸² See *id.* (explaining that the Label now expends time policing music videos blurring exposed trademarks to avoid potential litigation).

²⁸³ See *id.* (recognizing that blurring—or otherwise dealing with exposed trademarks—could create a chilling effect on artists' expressions).

²⁸⁴ *Id.*

²⁸⁵ *Id.*

²⁸⁶ *Id.*

change someone's art, they knew they had to make the change and exclude the mark to shield them from liability.²⁸⁷ Unfortunately, the exclusion of the mark came at the expense of hindering the artist's expression.²⁸⁸ Freedom of expression is crucial to maintaining a democratic society because expression is a means of "assuring individual self-fulfillment, attaining the truth, encouraging societal participation in social and political decision-making, and maintaining the balance between stability and change in society."²⁸⁹ If music videos were federally deemed as noncommercial speech, labels and companies alike would no longer have to worry about limiting artistic expression out of fear of litigation.²⁹⁰

Additionally, if music videos were federally deemed as noncommercial speech, the resulting flexibility with the inclusion of trademarks would eliminate the inefficiencies of obtaining licensing for every use of a trademark.²⁹¹ Although licensing may be desirable on a small scale, it can become burdensome, inefficient, and costly if incorporating many trademarks in an artistic work.²⁹² Federally deeming music videos as noncommercial eliminates the inefficiency of obtaining multiple licenses by insulating artists from dilution liability.²⁹³

Thus, a noncommercial classification would foster expression by allowing for flexibility with trademarks in music videos, and artistic expression would not be hindered.²⁹⁴ Knowing that the use of a trademark in a music video is eligible under either a fair use or noncommercial use exclusion of the Lanham Act ex-ante would provide clarity and encourage artistic expression that the First Amendment exists to protect.²⁹⁵ Without having to constantly fear litigation, a

²⁸⁷ *Id.* ("I do not ever want to change someone's art. I never want to say no, but we have to make this change.").

²⁸⁸ *Id.*

²⁸⁹ Thomas I. Emerson, *Toward a General Theory of the First Amendment*, 72 *YALE L.J.* 877, 878–79 (1963).

²⁹⁰ See Interview with Record Label (Dec. 5, 2016) ("When you take away any potential risk of us doing something, we have less incentive to police it and stop it. If [music videos were deemed noncommercial speech], we would be happy. [Artistic expression] would without a doubt be furthered.").

²⁹¹ See generally Stuart Whitwell, *The Power of Brands—Understanding Royalty Rates*, 43 *WORLD TRADEMARK REV.* 52 (June/July 2013), <http://www.worldtrademarkreview.com/Magazine/Issue/43/Features/The-power-of-brands-understanding-royalty-rates>. If music videos are federally deemed as noncommercial speech, artists will likely have a First Amendment defense to the inclusion of trademark in their artistic expression. See 15 U.S.C. § 1125(c)(3)(C) (2012); *supra* Part IV (advocating for First Amendment protection of music videos via their classification as noncommercial speech).

²⁹² See Whitwell, *supra* note 291, at 55 (discussing that brands may withhold permission to license their brands in order to maintain control over who they decide to associate with).

²⁹³ See, e.g., 15 U.S.C. § 1125(c)(3)(C).

²⁹⁴ *Id.* (recognizing that if music videos were federally deemed as noncommercial speech, music videos would fall under the noncommercial use exclusion of the Lanham Act).

²⁹⁵ See *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952) ("It cannot be doubted that

noncommercial classification could expedite the production process of music videos and allow for total artistic expression.²⁹⁶

However, opponents of deeming music videos noncommercial speech may argue that music videos are purely commercial because they promote their respective songs.²⁹⁷ In *New Line Cinema Corporation v. Bertlesman Music Group, Inc.*, the plaintiff sued alleging copyright infringement for the music video the defendant allegedly produced from the plaintiff's movie. In assessing the fair use inquiry, the U.S. District Court for the Southern District of New York regarded the purpose of defendant's music video as commercial because the music video only existed to promote the underlying song.²⁹⁸ Although music videos may be produced to promote and sell the underlying song, that does not strip them of First Amendment protection.²⁹⁹ Many other creative works—including books, music, and films and motion pictures—are produced and sold for a profit, yet still receive full First Amendment protection.³⁰⁰ If music videos are not classified as protected noncommercial speech under the First Amendment because producers and others stand to profit off of music videos, members of the democratic society will not obtain all information and truth necessary to uphold their civic commitment and participate in political and societal decision-making.³⁰¹

CONCLUSION

The First Amendment protects artistic expression partly because of the social, political, or cultural value a protected work offers.³⁰² Music videos serve as a fundamental, revolutionary means of espousing social,

motion pictures are a significant medium for the communication of ideas. They may affect public attitudes and behavior in a variety of ways, ranging from direct espousal of a political or social doctrine to the subtle shaping of thought which characterizes all artistic expression.”). If music videos were similarly federally deemed as noncommercial speech, record labels and other production companies would not have to be as hesitant when incorporating trademarks in their works, as their use would fall under the noncommercial use exclusion of the Lanham Act. *See* 15 U.S.C. § 1125(c)(3)(C).

²⁹⁶ Interview with Record Label (Dec. 5, 2016). Although labels would still monitor music videos for other Intellectual Property and other legal issues, a noncommercial classification of music videos would streamline the process, as labels would no longer have to thoroughly police for trademarks. *Id.*

²⁹⁷ *New Line Cinema Corp. v. Bertlesman Music Grp., Inc.*, 693 F. Supp. 1517, 1526 (S.D.N.Y. 1988) (noting that the purpose of the music video in question is purely commercial to promote the underlying song).

²⁹⁸ *Id.*

²⁹⁹ *Montgomery v. Montgomery*, 60 S.W.3d 524, 529 (Ky. 2001).

³⁰⁰ *Id.*

³⁰¹ Emerson, *supra* note 289, at 881–84.

³⁰² *See* Langvardt, *supra* note 30, at 174.

political, or cultural doctrines.³⁰³ Such societal benefits and artistic expression are precisely what the First Amendment purports to protect.³⁰⁴ As an extension of freedom of speech, freedom of expression facilitates the complete distribution of ideas, truth, and beliefs essential to a system of self-governance.³⁰⁵ A federal classification of music videos as noncommercial would have huge implications for society—labels would benefit by not having to constantly police music videos,³⁰⁶ artists would benefit by fulfilling self-expression,³⁰⁷ and members of society would benefit by obtaining the truth and thus enabling discussions essential to participation in a democratic society.³⁰⁸ However, if there remains no federal classification of music videos as artistic speech under the First Amendment, confusion will persist among jurisdictions and artistic expression will be significantly hindered.³⁰⁹ If artists cannot freely incorporate trademarks in their music videos, society stands to lose.³¹⁰ Congress even recognized the possible impediment to society from preventing the use of marks in protected expressions by including the fair use and noncommercial use exclusions in the FTDA.³¹¹

In addition to the espousal of social, political, and cultural doctrine or communicating issues of contemporary public concern,³¹² music videos are extensions of categories protected under the First Amendment.³¹³ As the visual counterpart of music, music videos are an extension of their protected auditory component.³¹⁴ As such, they should be afforded the same constitutional protection.³¹⁵ Additionally, as mini-movies, music videos should be afforded the same protection granted to motion pictures and films.³¹⁶ The justifications of affecting public attitudes and espousing beneficial societal doctrine underlying

³⁰³ See Caramanica, *supra* note 195.

³⁰⁴ Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495, 501 (1952).

³⁰⁵ Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454, 458 (Cal. 1979).

³⁰⁶ Interview with Record Label (Dec. 5, 2016).

³⁰⁷ *Id.*; see also Emerson, *supra* note 289, at 878 (noting that freedom of expression is necessary to assure individual self-fulfillment).

³⁰⁸ Emerson, *supra* note 289, at 881–84.

³⁰⁹ See *Girl Scouts of the U.S. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 808 F. Supp. 1112, 1118 (S.D.N.Y. 1992) (noting that including trademarks in artistic works furthers expression because they have the potential to help convey a message).

³¹⁰ See *id.* (explaining that trademarks are an “important part of modern culture”).

³¹¹ Lockridge, *supra* note 33, at 347.

³¹² See *supra* Section IV.B.

³¹³ *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989). Music videos are an extension of music, a category granted First Amendment protection. *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952). As mini-movies, music videos are also an extension of motion pictures and film, which are granted First Amendment protection. See generally *id.*

³¹⁴ *Ward*, 491 U.S. at 790 (“Music, as a form of expression and communication, is protected under the First Amendment.”).

³¹⁵ *Montgomery v. Montgomery*, 60 S.W.3d 524, 529 (Ky. 2001).

³¹⁶ *Id.*; see also *supra* Section IV.C.

the protection granted music and motion pictures underlie the same interests at stake with music videos.³¹⁷ Failing to federally deem music videos as noncommercial speech would have the deleterious effect of cordoning off society from the immense value associated with incorporating trademarks in videos.³¹⁸

Without the classification of music videos as noncommercial speech, Congress's rationale for the fair and noncommercial use exclusions in the FTDA are not being properly served.³¹⁹ Inconsistency among state dilution statutes encouraged Congress to initially create a federal dilution statute.³²⁰ First Amendment concerns then motivated Congress to create exclusions in the FTDA for fair and noncommercial uses.³²¹ If confusion persists as to what constitutes noncommercial speech, however, the exemptions in the FTDA are useless, and First Amendment values are thus threatened by judicial impingement.³²² The very thing that Congress sought to protect—First Amendment values—is being counteracted by uncertainty.³²³ The remedy for the irreparable harm of speech impingement and hindrance of artistic expression to society—that Congress explicitly sought to prevent³²⁴—is the federal classification of music videos as noncommercial speech under the First Amendment.³²⁵

³¹⁷ See *supra* Part IV.

³¹⁸ *Girl Scouts of the U.S. v. Bantam Doubleday Dell Publ'g Grp.*, 808 F. Supp. 1112, 1119 (S.D.N.Y. 1992) (quoting Robert N. Kravitz, *Trademarks, Speech, and the Gay Olympics Case*, 69 B.U. L. REV. 131, 152 (1989) (“To prevent filmmakers, novelists, painters, and political satirists from including trademarks in their works is to cordon off an important part of modern culture from public discourse.”)).

³¹⁹ See *supra* Section II.A.

³²⁰ Lockridge, *supra* note 33, at 342–47.

³²¹ *Id.* at 347. (explaining that Congress included such exclusions to protect impingements of speech courts deemed constitutionally protected).

³²² *Id.* First Amendment concerns motivated the inclusion of fair and noncommercial use exemptions; however, without certainty as to what is a noncommercial use, First Amendment values may escape the protection the exemption is meant to protect. *Id.*

³²³ See *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007 (3d Cir. 2008) (holding that a cable-television production was commercial speech, not privy to the greater protections afforded noncommercial speech). *But see* *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 907 (9th Cir. 2002) (holding that a song that mentions a famous mark was noncommercial speech, and thus afforded the full protection of the First Amendment).

³²⁴ Lockridge, *supra* note 33, at 347 (noting that the statutory exclusions in the FTDA were added to preclude courts from enjoining constitutionally protected speech).

³²⁵ See *Montgomery v. Montgomery*, 60 S.W.3d 524, 529 (Ky. 2001) (“‘Music, as a form of expression and communication, is protected under the First Amendment.’ Likewise, ‘[e]ntertainment . . . is protected; motion pictures, programs broadcast by radio and television, and live entertainment, such as musical and dramatic works, fall within the First Amendment guarantee.’ Therefore, we have little difficulty [sic] in concluding that the music video in question is protected free expression under the U.S. and Kentucky Constitutions.”) (internal citations omitted). Federally classifying music videos as noncommercial speech under the First Amendment would help foster unity among the types of speech, and the extensions of those, that have been judicially deemed as protected. *Id.*