

WHAT'S THE USE? WHY A COMMERCIAL USE REQUIREMENT IS NOT NECESSARY FOR INFRINGEMENT CLAIMS UNDER THE LANHAM ACT*

I. INTRODUCTION

Trademark law originates from the common law principle that protection of trademarks protects the public against confusion as to the source of goods and services.¹ In 1946, Congress codified this common law principle when it enacted the Lanham Act—the source of federal trademark law.² Among other things, the Lanham Act prohibits use of another's trademark in a manner likely to cause consumer confusion.³

In determining whether trademark infringement occurs under the Lanham Act, courts look to see whether the alleged infringer's use will cause a likelihood of confusion.⁴ If a court finds a likelihood of confusion, the alleged infringer can assert a fair use affirmative defense.⁵ The fair use defense was adopted to protect expressive use of a trademark, which is protected by the First Amendment.⁶

Traditionally, one could be held liable for trademark infringement even if the infringer was not selling goods or services.⁷ A nonprofit organization that co-opted a valid trademark could be held liable for infringement under the Lanham

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1. See Glynn S. Lunney, Jr., *Trademarks and the Internet: The United States' Experience*, 97 TRADEMARK REP. 931, 931 (2007) (noting that the common law of trademarks was “narrowly-tailored” and “consumer-centric”).

2. Michael Grynberg, *Things Are Worse than We Think: Trademark Defenses in a “Formalist” Age*, 24 BERKELEY TECH. L.J. 897, 925 (2009); Lunney, *supra* note 1, at 931.

3. See 15 U.S.C. § 1114(1)(a) (2012) (prohibiting the use of a registered trademark “in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive”); *id.* § 1125(a)(1)(A) (prohibiting the use of an unregistered trademark in connection with goods or services in a manner that is “likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person”).

4. Most circuits employ a likelihood of confusion test that involves weighing a nonexhaustive list of factors. See, e.g., *George & Co. LLC v. Imagination Entm't Ltd.*, 575 F.3d 383, 393 (4th Cir. 2009) (listing nine factors including (1) the strength of the plaintiff's mark, (2) the similarity of the two marks, (3) the similarity of the goods or services; (4) the similarity of the facilities used by the mark holders, (5) the similarity of advertising used by the mark holders, (6) the defendant's intent, (7) actual confusion, (8) the quality of the defendant's product, and (9) the sophistication of the consumers).

5. Grynberg, *supra* note 2, at 918.

6. *Id.* at 914. The Lanham Act protects a party's use of a trademark if it is used “otherwise than as a mark” in good faith “only to describe the goods or services of” the trademark owner. § 1115(b)(4).

7. See, e.g., *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 92 (2d Cir. 1997) (holding that a noncommercial political entity was liable for trademark infringement under the Lanham Act).

Act.⁸ For instance, a noncommercial political entity trading in ideas could not brand itself the “Democratic Party” simply because it was not selling goods or services.⁹

That has changed. In the early twenty-first century, several circuits have held that trademark infringement claims require a commercial use.¹⁰ That is, the alleged infringer must have used the trademark in connection with goods or commercial services. These courts reason that the Lanham Act is only constitutional because it regulates commercial speech—a form of speech that gets less First Amendment protection than other forms of speech.¹¹ Under this interpretation of the Lanham Act, noncommercial uses of a trademark—no matter how confusing—do not amount to infringement.¹² This is because a noncommercial use “refers to a use that consists entirely of noncommercial, or fully constitutionally protected, speech.”¹³

This Comment argues that the narrow focus of these courts on commercial uses of a trademark is misguided. In taking such a view of trademark use sufficient to trigger liability, these courts allow uses that harm the consumers and producers of goods and services. The better approach is to allow noncommercial use to constitute infringement, while simultaneously protecting First Amendment concerns through a modified likelihood of confusion analysis. Section II of this Comment is split into three parts. Parts II.A and II.B discuss the commercial speech doctrine and the history of the Lanham Act, respectively. Part II.C explores case law that grapples with the tension between First Amendment freedoms and the intellectual property rights of trademark owners. Finally, Section III advocates for a rule that abandons the commercial use threshold and instead relies on the traditional likelihood of confusion analysis.

II. OVERVIEW

The Lanham Act was enacted in 1946 and is the source of federal trademark law.¹⁴ In enacting and enforcing the Lanham Act, Congress and the courts have

8. See *id.* at 90 (listing multiple cases in which the Lanham Act was applied to defendants furnishing noncommercial services).

9. *Id.*

10. See *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1051–52 (10th Cir. 2008) (holding that Lanham Act infringement claims are subject to a commercial use requirement); *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 676 (9th Cir. 2005) (holding that Lanham Act infringement claims are subject to a commercial use requirement); *Taubman Co. v. Webfeats*, 319 F.3d 770, 774–75 (6th Cir. 2003) (“If [defendant’s] use is commercial, then, and only then, do we analyze his use for a likelihood of confusion.”).

11. *Fla. Bar v. Went For It, Inc.*, 515 U.S. 618, 623 (1995) (“Commercial speech enjoys a limited measure of [First Amendment] protection . . .” (alterations omitted) (quoting *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 477 (1989))).

12. See *Choose Energy, Inc. v. Am. Petroleum Inst.*, No. 5:14-CV-04557-PSG, 2014 WL 5474639, at *2–3 (N.D. Cal. Oct. 28, 2014) (holding a noncommercial political entity was not liable for trademark infringement while acknowledging a substantial likelihood of confusion).

13. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905 (9th Cir. 2002).

14. Andrew Brabender, Note, *Internet Trademark Disputes: A Modified Approach to the*

had to balance trademark holders' rights with the First Amendment rights of other parties.¹⁵ Congress has incorporated into the Lanham Act a number of defenses to trademark infringement,¹⁶ while the courts have, in large part, balanced the Lanham Act and the First Amendment with the commercial speech doctrine. This doctrine grants speech proposing a commercial transaction less First Amendment protection than noncommercial speech. This Section examines in more detail how Congress and the courts have done so.

A. *The Commercial Speech Doctrine*

"Commercial speech enjoys a limited measure of protection, commensurate with its subordinate position in the scale of First Amendment values, and is subject to modes of regulation that might be impermissible in the realm of noncommercial expression."¹⁷ In *Bolger v. Youngs Drug Products Corp.*,¹⁸ the Supreme Court considered three factors for determining whether speech is commercial or noncommercial.¹⁹ The factors are whether (1) the speech is an advertisement, (2) the speech refers to a specific product or service, and (3) the speaker has an economic motivation.²⁰ Answering yes to all three factors strongly supports the conclusion that the speech is commercial.²¹ This "commercial speech doctrine" involves making a common sense distinction between speech proposing a commercial transaction and other forms of speech.²² This distinction is significant.

B. *The Lanham Act*

The Lanham Act was passed "to protect the ability of consumers to distinguish among competing producers."²³ Section 1114 of the Lanham Act prohibits infringement of a registered trademark.²⁴ It specifically prohibits any person, without consent of the registrant, from using in commerce²⁵ "any

Applicability of the "Goods or Services" Requirement in the Lanham Act, 41 NEW ENG. L. REV. 115, 115 n.1 (2006).

15. The First Amendment of the United States Constitution provides that "Congress shall make no law . . . abridging the freedom of speech." U.S. CONST. amend. I.

16. See 15 U.S.C. § 1115(b) (2012) (providing a list of nine affirmative defenses to trademark infringement).

17. *Fla. Bar v. Went For It, Inc.*, 515 U.S. 618, 623 (1995) (alterations omitted) (quoting *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 477 (1989)).

18. 463 U.S. 60 (1983).

19. *Bolger*, 463 U.S. at 66–67.

20. *U.S. Healthcare, Inc. v. Blue Cross of Greater Phila.*, 898 F.2d 914, 933 (3d Cir. 1990) (citing *Bolger*, 463 U.S. at 66–67).

21. *Id.* (citing *Bolger*, 463 U.S. at 67).

22. *Id.* (citing *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626, 637 (1985)).

23. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992).

24. 15 U.S.C. § 1114 (2012).

25. Note that § 1114 and § 1125 both utilize "use in commerce" language merely to denote Congress's authority to pass the Lanham Act under the Commerce Clause and not to indicate a commercial use requirement. See *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 677 (9th Cir. 2005)

reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services” that is likely to cause confusion.²⁶

Section 1125(a)(1) of the Lanham Act creates two distinct bases of liability for unregistered marks: unfair competition²⁷ and false advertising.²⁸ Section 1125(a)(1), the source of protection for unregistered marks, specifically prohibits any person who, “in connection with any goods or services . . . uses in commerce any word, term, name, symbol, or device,” that is likely to cause confusion or mistake as to the origin of goods and services.²⁹ Courts analyze claims for unfair competition under § 1125(a)(1)(A) the same as trademark infringement claims under § 1114.³⁰ Because of the “connection with any goods or services” requirement, many circuits have concluded that liability for unfair competition and false advertising under the Lanham Act is limited to commercial uses.³¹

The Lanham Act also protects trademark owners from trademark dilution.³² In 1995, Congress amended the Lanham Act to include the Federal Trademark Dilution Act.³³ The Federal Trademark Dilution Act was updated by the Trademark Dilution Revision Act of 2006.³⁴ The Lanham Act thus entitles a party to injunctive relief against dilution, that is, when another uses the party’s trademark in commerce in a way that is “likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”³⁵

A dilution cause of action aims at preventing uses of marks that whittle away at the selling power of a mark. As such, unlike trademark infringement,

(noting that the lower court erred by focusing on “use in commerce” language to find that a usage of a mark was noncommercial, as such language is simply a “jurisdictional predicate to any law passed by Congress under the Commerce Clause”). The commercial use requirement is derived from the “connection with a sale of goods or services” language. *Id.*

26. § 1114(1)(a). See *supra* note 4 for an example of the factors courts may use in determining a likelihood of confusion.

27. This form of unfair competition is sometimes referred to as “false association” or “false designation.” See, e.g., *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 134 S. Ct. 1377, 1384 (2014); *Am. Tel. & Tel. Co. v. Winback & Conserve Program, Inc.*, 42 F.3d 1421, 1443–44 (3d Cir. 1994).

28. *Lexmark Int’l*, 134 S. Ct. at 1384.

29. § 1125(a)(1).

30. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

31. See, e.g., *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1051–52 (10th Cir. 2008) (discussing that, because of the requirement for a connection with goods or services, claims under § 1125(a)(1) are subject to what is “commonly described as the commercial use requirement”). A commercial use of a trademark is one that consists of commercial speech. Cf. *Mattel, Inc. v. MCA Records, Inc.*, 269 F.3d 894, 905 (9th Cir. 2002) (a noncommercial use “refers to a use that consists entirely of noncommercial, or fully constitutionally protected, speech”).

32. § 1125(c).

33. Matthew J. Slowik, *Ahead of the Curve? The Effect of the Trademark Dilution Revision Act of 2006 on the Federal Circuit*, 18 FED. CIR. B.J. 349, 349 (2009).

34. *Id.*

35. § 1125(c)(1).

dilution actions include uses that are not likely to cause consumers confusion, as long as consumers nevertheless associate the two marks.³⁶ However, in light of First Amendment concerns, the Trademark Dilution Revision Act specifically shields any “noncommercial use of a mark” from liability for dilution by tarnishment or blurring.³⁷ Congress specifically incorporated the concept of commercial speech from the commercial speech doctrine.³⁸

Congress again amended the Lanham Act by passing the Anticybersquatting Consumer Protection Act of 1999.³⁹ Under the Anticybersquatting Consumer Protection Act, a person can be liable for cybersquatting⁴⁰ when using a protected trademark as a domain name if he has made a bad faith attempt to profit from the trademark.⁴¹ This is true regardless of the “goods or services of the parties”⁴² Just as a trademark dilution claim does not require a likelihood of confusion,⁴³ a cybersquatting claim does not require a connection to goods or services. However, the statute provides a list of nine nonexhaustive factors in determining whether a person has a bad faith intent to profit from the mark.⁴⁴ Among these factors is “the person’s bona fide noncommercial or fair use of the mark.”⁴⁵ Congress included this provision to

36. *Id.* (“[T]he owner of a famous mark . . . shall be entitled to an injunction against another person who . . . commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, *regardless of the presence or absence of actual or likely confusion . . .*”) (emphasis added). See *supra* note 4 for an example of factors may courts use in determining a likelihood of confusion.

37. § 1125(c)(3)(C); H.R. REP. NO. 104-374, at 4 (1995), *reprinted in* 1996 U.S.C.C.A.N. 1029, 1031.

38. H.R. REP. NO. 104-374, at 8, *reprinted in* 1996 U.S.C.C.A.N. 1029, 1035.

39. § 1125(d).

40. “Cybersquatting is the practice of registering ‘well-known brand names as Internet domain names’ in order to force the rightful owners of the marks ‘to pay for the right to engage in electronic commerce under their own brand name.’” *Virtual Works, Inc. v. Volkswagen of Am. Inc.*, 238 F.3d 264, 267 (4th Cir. 2001) (quoting S. REP. NO. 106-140, at 4 (1999), 1999 WL 594571, at *5). In *Volkswagen*, the Fourth Circuit held that the registrant of the domain name “VW.net,” which included Volkswagen’s “VW” trademark, violated the Anticybersquatting Consumer Protection Act. *Id.* at 271. The registrant told Volkswagen it would sell the domain name to the highest bidder if Volkswagen did not offer to buy it within twenty-four hours. *Id.* at 270.

41. § 1125(d)(1)(A).

42. *Id.*

43. See *supra* note 4 for an example of factors courts may use in determining a likelihood of confusion.

44. § 1125(d)(1)(B)(i).

45. § 1125(d)(1)(B)(i)(IV). The other factors include: (1) the trademark rights of the person in the domain name, (2) the extent to which the domain name consists of the legal name of the person or a name that is commonly used to identify that person, (3) the person’s prior use of the domain name in connection with the bona fide offering of any goods or services, (4) the person’s intent to divert consumers from the trademark owner’s website to a website that could harm the goodwill represented by the trademark, (5) the person’s offer to sell the domain name to the trademark owner of a third party for financial gain without having used the domain name to offer goods or services, (6) the person’s provision of misleading false contact information in applying for the domain name, (7) the person’s registration of multiple domain names which the person knows are identical or similar to the trademarks of others, and (8) the extent to which the trademark in the person’s domain name is not

protect “the rights of Internet users and the interests of all Americans in free speech and protected uses of trademarked names for such things as parody, comment, criticism, comparative advertising, news reporting, etc.”⁴⁶

C. Case Law Interpreting the Lanham Act

Circuits have been split as to whether the Lanham Act only applies to commercial speech. For example, the First, Sixth, and Ninth Circuits have found such a requirement.

1. Circuit Courts that Restrict the Lanham Act to Commercial Speech:
Taubman, Bosley, and Utah Lighthouse Ministry

In *Taubman Co. v. Webfeats*,⁴⁷ a Texas-based web designer learned that Taubman Company was opening a nearby shopping mall called “The Shops at Willow Bend.”⁴⁸ He then registered the domain name “shopsatwillowbend.com” and created a website at that address.⁴⁹ The website included information regarding the mall, a map, and links to the official mall website and individual websites of the mall’s stores.⁵⁰ The website, however, also included links to the websites of the web designer’s business and his girlfriend’s custom-made t-shirt business.⁵¹ Once Taubman Company learned of the website, it demanded the defendant remove it.⁵² Taubman Company alleged that the domain name “shopsatwillowbend.com” infringed on its registered trademark “The Shops at Willow Bend.”⁵³ In response, the defendant registered five more domain names, including “taubmansucks.com,” “shopsatwillowbendsucks.com,” and “willowbendsmallucks.com.”⁵⁴ All five domain names linked to the same “gripe site,”⁵⁵ which presented the defendant’s narrative of the events and legal proceedings⁵⁶ between him and Taubman.⁵⁷

The district court granted Taubman’s motion for a preliminary injunction.⁵⁸ It enjoined the defendant from using the domain name

distinctive and famous. § 1125(d)(1)(B)(i).

46. S. REP. NO. 106-140, at 8 (1999), 1999 WL 594571, at *8.

47. 319 F.3d 770 (6th Cir. 2003).

48. *Taubman*, 319 F.3d at 772.

49. *Id.*

50. *Id.*

51. *Id.*

52. *Id.*

53. *Id.*

54. *Id.*

55. “Cybergripping” occurs when a consumer or former employee operates a website for the purpose of criticizing a company or organization. Martha Kelley, *Is Liability a Link Away? Trademark Dilution by Tarnishment Under the Federal Trademark Dilution Act of 1995 and Hyperlinks on the World Wide Web*, 9 J. INTELL. PROP. L. 361, 375 (2002).

56. The case involved, among other claims, an infringement of a registered trademark claim, and was thus governed by § 1114. *Taubman*, 319 F.3d at 774.

57. *Id.* at 772.

58. *Id.* at 773.

“shopsatwillowbend.com” and the five domain names the defendant later registered.⁵⁹ The United States Court of Appeals for the Sixth Circuit overturned the preliminary injunction.⁶⁰ Although it acknowledged that the links to the defendant’s and girlfriend’s business websites were “extremely minimal,” the Sixth Circuit concluded they were advertisements.⁶¹ Thus, they constituted a commercial use of Taubman’s mark.⁶²

However, because preliminary injunctions are only for prospective relief and the defendant had taken down the advertisements prior to the lawsuit, the court focused on the defendant’s nonadvertising websites.⁶³ Analyzing the “shopsatwillowbend.com” website, the court ultimately concluded that it was not used in connection with the sale of goods or services, and rejected Taubman’s argument that the defendant was economically motivated to register the domain name.⁶⁴

The court held that an economic motivation to hurt a business was not a sufficient connection to goods or services for the purpose of the Lanham Act.⁶⁵ While acknowledging that economic damage may have been an intended effect of the defendant’s websites, the court invoked the First Amendment.⁶⁶ The court reasoned that “the First Amendment protects critical commentary when there is no confusion as to source, even when it involves the criticism of a business. Such use is not subject to scrutiny under the Lanham Act.”⁶⁷ The court analogized the defendant’s conduct to shouting from a rooftop “Taubman Sucks!” and explained “[t]he rooftops of our past have evolved into the internet domain names of our present.”⁶⁸

The *Taubman* court explained that “[t]he Lanham Act is constitutional because it only regulates commercial speech, which is entitled to reduced protections under the First Amendment.”⁶⁹ Because the court believed the Lanham Act only applied to commercial speech, it reasoned that determining whether the speech was commercial was a threshold requirement.⁷⁰ Only if this threshold was met would further analysis be required.⁷¹

59. *Id.*

60. *Id.* at 775.

61. *Id.*

62. *Id.*

63. *Id.*

64. *Id.* at 776.

65. *Id.* at 777.

66. *Id.* at 778.

67. *Id.*

68. *Id.*

69. *Id.* at 774.

70. *Id.* The Sixth Circuit equated commercial speech with a connection to the sale or advertising of goods or services. *See id.* at 776 (“Even if [defendant’s] use is commercial speech, i.e., ‘in connection with the sale . . . or advertising of any goods or services,’ and within the jurisdiction of the Lanham Act, there is a violation only if his use also creates a likelihood of confusion among customers.” (quoting 15 U.S.C. § 1114(1))).

71. *See id.* at 774–75 (“If [defendant’s] use is commercial, then, and only then, do we analyze his

The United States Court of Appeals for the Ninth Circuit reached a similar conclusion in *Bosley Medical Institute, Inc. v. Kremer*.⁷² The *Bosley* court found that a disgruntled medical patient who erected a gripe site that criticized the plaintiff's medical services, and used the plaintiff's trademark as his domain name, was not liable under the Lanham Act.⁷³ The Ninth Circuit reasoned that the plaintiff "cannot use the Lanham Act either as a shield from [the defendant's] criticism, or as a sword to shut [the defendant] up."⁷⁴ The Ninth Circuit further noted that absent an actual sale of goods or services, the appropriate inquiry is whether the defendant offers competing services.⁷⁵ In *Utah Lighthouse Ministry v. Foundation for Apologetic Information & Research*,⁷⁶ a case with facts similar to *Bosley*, the United States Court of Appeals for the Tenth Circuit held that the Lanham Act does not encompass noncommercial speech.⁷⁷

In *L.L. Bean, Inc. v. Drake Publishers, Inc.*,⁷⁸ the United States Court of Appeals for the First Circuit reached a similar conclusion in a case involving an antidilution statute in Maine.⁷⁹ The court noted that "[t]rademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view."⁸⁰ The case involved an erotic magazine's use of L.L. Bean's trademark in a humorous article that featured pictures of "nude models in sexually explicit positions using 'products' that were described in a crudely humorous fashion."⁸¹ The court found the use to be noncommercial because "parody constitutes an editorial or artistic, rather than a commercial, use of [a] plaintiff's mark."⁸²

United States district courts that have addressed this issue have similarly found a commercial speech requirement. For example, in *Farah v. Esquire*

use for a likelihood of confusion. If [defendant's] use is also confusing, then it is misleading commercial speech, and outside the First Amendment.").

72. 403 F.3d 672 (9th Cir. 2005).

73. *Bosley*, 403 F.3d at 674–80.

74. *Id.* at 680.

75. *Id.* at 679 (citing *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 90 (2d Cir.1997)).

76. 527 F.3d 1045 (10th Cir. 2008).

77. *Utah Lighthouse Ministry*, 527 F.3d at 1054. Utah Lighthouse Ministry operated a bookstore and a website that served to critique the Church of Jesus Christ of Latter-day Saints (LDS Church). *Id.* at 1048. The Foundation for Apologetic Information and Research (FAIR) served as a volunteer organization that responded to criticisms of the LDS Church. *Id.* FAIR's vice president and webmaster erected a website parodying that of Utah Lighthouse Ministry. *Id.* at 1048–49. Among other claims, Utah Lighthouse Ministry sued for trademark infringement and unfair competition under the Lanham Act (specifically, under 15 U.S.C. § 1125(a)(1)). *Id.* at 1049–50.

78. 811 F.2d 26 (1st Cir. 1987).

79. See *L.L. Bean*, 811 F.2d at 32 (explaining that it "offends the Constitution, however, to invoke the anti-dilution statute as a basis for enjoining the noncommercial use of a trademark by a defendant engaged in a protected form of expression").

80. *Id.* at 29 (citing *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931, 933–35 (D.D.C. 1985)).

81. *Id.* at 27.

82. *Id.* at 32.

Magazine, Inc.,⁸³ the District Court for the District of Columbia, citing both *Bosley* and *Utah Lighthouse Ministry*, among other cases, stated “[e]very circuit that has addressed the issue has found that the Lanham Act restricts only commercial speech, as commercial speech is entitled to reduced protection under the First Amendment.”⁸⁴

Two district court cases that relied on the precedent set by *Bosley* exemplify how courts have interpreted the commercial speech requirement set forth by the circuits. In *Hancock Park Homeowners Ass’n Est. 1948 v. Hancock Park Home Owners Ass’n*,⁸⁵ the United States District Court for the Central District of California held that a nonprofit homeowners association’s claim against a competitor was beyond the jurisdictional scope of the Lanham Act because neither the plaintiff nor the defendant was a commercial entity.⁸⁶ A homeowners association, which had been operating for nearly sixty years, had its corporate status suspended by the California Secretary of State and the Franchise Tax Board due to a clerical error.⁸⁷ As a result of the error, the name “Hancock Park Home Owners Association” became available to the public, and the defendant formed a corporation under the same name.⁸⁸ The defendant began using the plaintiff’s trade name and registered the domain name “hancockparkhomeownersassociation.com.”⁸⁹ In response, the plaintiff brought an unfair competition claim against the defendant under § 1125(a) of the Lanham Act.⁹⁰

The plaintiff alleged that it had provided various services to the community, including participating in land use planning, assisting in the development of community safety standards, developing traffic management, and successfully opposing the construction of the Beverly Hills Freeway.⁹¹ The district court found that neither the plaintiff nor the defendant engaged in commercial use of the trademark at issue because neither entity performed commercial services—that is, with a motive for profit or an expectation of remuneration.⁹² Relying on *Bosley*,⁹³ the district court noted that the commercial use requirement applies to all Lanham Act claims.⁹⁴ Therefore, the plaintiff’s claim was dismissed.⁹⁵

83. 863 F. Supp. 2d 29 (D.D.C. 2012), *aff’d sub nom.*, *Farah v. Esquire Magazine*, 736 F.3d 528 (D.C. Cir. 2013).

84. *Farah*, 863 F. Supp. 2d at 40.

85. No. CV 06-4584 SVW, 2006 WL 4532986 (C.D. Cal. Sept. 20, 2006).

86. *Hancock Park*, 2006 WL 4532986, at *5.

87. *Id.* at *1.

88. *Id.*

89. *Id.*

90. *Id.*

91. *Id.*

92. *Id.* at *5. Although the defendant’s activities were not expressly enumerated, the court noted that, by purportedly attempting to imitate the plaintiff, the defendant had similar objectives to that organization. *Id.*

93. See *supra* notes 72–75 and accompanying text for the facts and holding of *Bosley*.

94. *Hancock Park*, 2006 WL 4532986, at *4. *But see* *Browne v. McCain*, 612 F. Supp. 2d 1125, 1131 (C.D. Cal. 2009) (rejecting defendant’s argument that false association or endorsement claims

In *Choose Energy, Inc. v. American Petroleum Institute*,⁹⁶ the United States District Court for the Northern District of California denied the plaintiff injunctive relief from the defendant's use of variations of the plaintiff's trademark because the two were not in competition.⁹⁷ The plaintiff, Choose Energy, Inc., operated an online energy marketplace at "chooseenergy.com."⁹⁸ The defendant, the American Petroleum Institute (API), launched a website with the domain name "chooseenergy.org" for the purpose of electing candidates that support the fossil fuel industry.⁹⁹ The defendant branded its website with Choose Energy's "CHOOSEENERGY" and "CHOOSE ENERGY" trademarks.¹⁰⁰

Choose Energy brought a trademark infringement claim against API under § 1114 of the Lanham Act.¹⁰¹ The plaintiff alleged that the defendant purposely misappropriated its trademarks to engage in a biased political campaign.¹⁰² The district court did not find trademark infringement in part because API's political activities did not constitute commercial services under the Lanham Act.¹⁰³ Further, the district court, relying on *Bosley*, recognized that noncommercial speech may trigger liability under the Lanham Act, but only if the alleged infringer is in competition with the plaintiff.¹⁰⁴ Because API's activities were "wholly and completely distinct" from the commercial services offered by the plaintiff, no such competition existed.¹⁰⁵

In summary, the Sixth, Ninth, and Tenth Circuits have held that liability under the Lanham Act for infringement claims only attaches if there is a commercial use of a trademark. These courts reason that commercial use of a trademark constitutes commercial speech, which is afforded less First Amendment protection than noncommercial speech. Thus, a noncommercial use of a trademark is noncommercial speech. Because noncommercial speech is constitutionally protected by the First Amendment, these courts first determine if the use of a trademark is commercial.

made under § 1125(a) of the Lanham Act only apply to commercial speech and not to political speech).

95. *Hancock Park*, 2006 WL 4532986, at *5.

96. No. 5:14-CV-04557-PSG, 2014 WL 5474639 (N.D. Cal. Oct. 28, 2014).

97. *Choose Energy*, 2014 WL 5474639, at *4.

98. *Id.* at *1.

99. *Id.*

100. *Id.*

101. *Id.*

102. *Id.* at *2.

103. *Id.* at *3.

104. See *id.* (citing *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 679 (9th Cir. 2005)); see also *Stanislaus Custodial Deputy Sheriffs' Ass'n v. Deputy Sheriff's Ass'n of Stanislaus Cnty.*, No. CV F 09-1988 LJO SMS, 2010 WL 843131, at *6 (E.D. Cal. Mar. 10, 2010) ("[I]f an actual sale of goods is not involved, the infringer must be engaged in some form of commercial *competition*.").

105. *Choose Energy*, 2014 WL 5474639, at *3-4.

2. Circuit Courts that Applied the Lanham Act to Noncommercial Speech: *Lamparello* and *United We Stand America*

Not all courts have found a commercial speech requirement. For instance, in *Lamparello v. Falwell*,¹⁰⁶ the United States Court of Appeals for the Fourth Circuit faced facts similar to those in *Bosley*,¹⁰⁷ but declined to address whether the Lanham Act applied only to commercial speech.¹⁰⁸ Lamparello had erected a gripe site under the domain name “fallwell.com” criticizing Reverend Jerry Falwell for, among other things, his antihomosexual views.¹⁰⁹ After Falwell sent Lamparello cease and desist letters demanding that Lamparello stop using the domain name or any variation of Falwell’s last name as a domain name, Lamparello sought a declaratory judgment of noninfringement.¹¹⁰ Falwell counterclaimed, alleging, among other claims, trademark infringement, unfair competition, and cybersquatting under §§ 1114, 1125(a), and 1125(d), respectively.¹¹¹ The district court granted summary judgment in favor of Falwell and enjoined Lamparello.¹¹² Lamparello appealed to the Fourth Circuit.¹¹³

On appeal, Lamparello argued that the Lanham Act was limited to commercial speech so as to avoid unconstitutional censorship.¹¹⁴ While acknowledging the Sixth and Ninth Circuits’ decisions in *Taubman*¹¹⁵ and *Bosley*,¹¹⁶ respectively, the Fourth Circuit declined to adopt their holdings.¹¹⁷ Rather, the court distinguished Lanham Act causes of action for trademark infringement and unfair competition from those for dilution and cybersquatting.¹¹⁸ The court noted that the statutory language for dilution and cybersquatting claims explicitly used the term “noncommercial.”¹¹⁹ As mentioned above, the dilution statute provides an exception for noncommercial use of a mark.¹²⁰ Similarly, the Anticybersquatting Consumer Protection Act

106. 420 F.3d 309 (4th Cir. 2005).

107. *Bosley* involved a disgruntled medical patient who erected a gripe site that criticized his medical services provider. See *supra* notes 72–75 and accompanying text for the facts and holding of *Bosley*.

108. *Lamparello*, 420 F.3d at 314.

109. *Id.* at 311.

110. *Id.* at 312.

111. *Id.* The court used the term “false designation,” which in context of the Lanham Act is synonymous with “unfair competition.” See *New W. Corp. v. NYM Co. of Cal., Inc.*, 595 F.2d 1194, 1201 (9th Cir. 1979) (“Whether we call the violation infringement, unfair competition or false designation of origin, the test is identical . . .”).

112. *Lamparello*, 420 F.3d 309 at 312.

113. *Id.*

114. *Id.* at 313.

115. 319 F.3d 770, 774 (6th Cir. 2003).

116. 403 F.3d 672, 674 (9th Cir. 2005).

117. *Lamparello*, 420 F.3d 309 at 314.

118. *Id.* at 313–14. See *supra* notes 32–46 and accompanying text for a discussion on dilution and cybersquatting claims under the Lanham Act.

119. *Lamparello*, 420 F.3d 309 at 313–14.

120. *Id.* at 313.

allows courts to consider whether one's use of another's mark is a bona fide noncommercial or fair use.¹²¹

In contrast, neither a cause of action for trademark infringement nor for unfair competition uses the term "noncommercial."¹²² The court acknowledged that the statutory language required a connection to goods or services, but it was reluctant to follow the Sixth and Ninth Circuits in interpreting this as applying to only commercial speech.¹²³ The court noted that, as the Second Circuit explained, "[t]he term 'services' has been interpreted broadly" and so "[t]he Lanham Act has . . . been applied to defendants furnishing a wide variety of non-commercial public and civic benefits."¹²⁴ However, the court ultimately reversed the trademark infringement and unfair competition claims because Falwell failed to show the website caused a likelihood of confusion.¹²⁵

Scholars and other case law suggest that claims by and against noncommercial entities for trademark infringement and unfair competition are viable.¹²⁶ In *United We Stand America, Inc. v. United We Stand, America New York, Inc.*,¹²⁷ the United States Court of Appeals for the Second Circuit held that a nonprofit's political activities were considered services within the Lanham Act's jurisdiction for trademark infringement claims.¹²⁸ In support of this proposition, the court cited multiple district court cases where the Lanham Act protected the trademarks of noncommercial entities, including civil rights organizations, charitable organizations, college fraternities, and political organizations.¹²⁹ The court held that engaging in political organizing, establishing and equipping an office, soliciting politicians, issuing press releases, endorsing candidates, and distributing literature are services under the Lanham Act, despite not being undertaken for profit.¹³⁰ The court concluded there was "no doubt that they satisfy § 1114(1)(a)'s requirement that the mark be used in connection with goods or services."¹³¹

121. *Id.* at 314.

122. *Id.*

123. *Id.*

124. *Id.* (alterations and omission in original) (quoting *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 89–90 (2d Cir. 1997)).

125. *See id.* at 314–15 ("[T]he fact that people contacted Reverend Falwell's ministry to report that they found the content at www.falwell.com antithetical to Reverend Falwell's views does not illustrate, as Reverend Falwell claims, that the website engendered actual confusion. To the contrary, the anecdotal evidence Reverend Falwell submitted shows that those searching for Reverend Falwell's site and arriving instead at Lamparello's site quickly realized that Reverend Falwell was *not* the source of the content therein."). *See supra* note 4 for an example of factors courts may use to determine if there is a likelihood of confusion.

126. *See, e.g.*, 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 9:5 (4th ed. 2004) ("The fact that an organization is non-profit and sells no goods does not take it out of the protection of the law of unfair competition.").

127. 128 F.3d 86 (2d Cir. 1997).

128. *United We Stand Am.*, 128 F.3d at 89.

129. *Id.* at 89–90.

130. *Id.* at 90.

131. *Id.*

In so holding, the Second Circuit disagreed with the reasoning of an unrelated district court case on which the defendants relied.¹³² In *Lucasfilm Ltd. v. High Frontier*,¹³³ Lucasfilm sued public interest groups for trademark infringement and unfair competition for using the mark “Star Wars” in television advertisements to characterize the Reagan administration’s Strategic Defense Initiative.¹³⁴ The district court did not find that the advertisements were services under §§ 1114 and 1125(a) of the Lanham Act.¹³⁵ The *Lucasfilm* court noted that the “[d]efendants’ only activity is trying to communicate their ideas” and that “[p]urveying points of view is not a service.”¹³⁶ In rejecting this view, the Second Circuit in *United We Stand America* stated that if “communicating ideas and purveying points of view is not a service subject to the controls established by trademark law, then one who established a learning center would be free to call it Harvard or Yale University.”¹³⁷

The *United We Stand America* court then considered the First Circuit’s decision in *L.L. Bean, Inc. v. Drake Publishers, Inc.*¹³⁸ In *L.L. Bean*, the First Circuit adopted the district court’s reasoning in *Lucasfilm*.¹³⁹ The *United We Stand America* court determined that the First Circuit could not have meant that the categories of “editorial or artistic” and “commercial” are mutually exclusive.¹⁴⁰ The Second Circuit further remarked that “[m]ost editorial, artistic, and humorous works are sold in commerce.”¹⁴¹

Instead of *Lucasfilm* and *L.L. Bean*, the *United We Stand America* court cited to *Brach Van Houten Holding, Inc. v. Save Brach’s Coalition for Chicago*¹⁴² and *Committee for Idaho’s High Desert v. Yost*¹⁴³ to support its contention that political activities—that is, noncommercial speech—constitute services under the Lanham Act.¹⁴⁴ In *Save Brach’s*, the defendant operated as a coalition with the purpose of preventing the plaintiff from closing its candy factory located on the West Side of Chicago.¹⁴⁵ As part of its campaign, the defendant incorporated the plaintiff’s federally registered trademark into its

132. *Id.* at 91.

133. 622 F. Supp. 931 (D.D.C. 1985).

134. *Lucasfilm*, 622 F. Supp. at 932.

135. *Id.* at 934.

136. *Id.*

137. *United We Stand Am.*, 128 F.3d at 91.

138. *Id.* at 91.

139. *L.L. Bean v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987). See *supra* notes 78–82 and accompanying text for the First Circuit’s complete reasoning in *L.L. Bean*.

140. *United We Stand Am.*, 128 F.3d at 91.

141. *Id.* at 91–92.

142. 856 F. Supp. 472 (N.D. Ill. 1994).

143. 881 F. Supp. 1457 (D. Idaho 1995), *aff’d in part, rev’d in part*, 92 F.3d 814 (9th Cir. 1996).

144. See *United We Stand Am.*, 128 F.3d at 90 (supporting the proposition by citing *Save Brach’s*, 856 F. Supp. at 475–76, and *Yost*, 881 F. Supp. at 1470–71).

145. *Save Brach’s*, 856 F. Supp. at 474. The coalition’s members included Teamsters Local 738, the Midwest Center for Labor, and the Garfield-Austin Interfaith Network. *Id.*

promotional materials.¹⁴⁶ The plaintiff thereafter sought to enjoin the defendant from doing so.¹⁴⁷

The defendant, a noncommercial entity, argued that the Lanham Act did not apply to its activities because it did not sell, distribute, or advertise goods or services.¹⁴⁸ In rejecting this “narrow interpretation of [the] Lanham Act provisions,” the district court found that soliciting donations and engaging in other activities designed to change the plaintiff’s organization all constituted services within the meaning of the Lanham Act.¹⁴⁹ The *Save Brach’s* court acknowledged that another court—the District Court for the District of Columbia in *Lucasfilm*—had found that the purveying of ideas is not a service.¹⁵⁰ However, the court distinguished *Lucasfilm* on the facts because the defendant in that case used a trademark as part of a communicative message, not to create confusion as to sponsorship.¹⁵¹ The court found that while the defendant may not have intended to create confusion by using the plaintiff’s trademark, confusion was nevertheless likely.¹⁵²

Similarly, in *Yost*, the district court found that a noncommercial entity could still be entitled to the protections provided by the Lanham Act.¹⁵³ In *Yost*, a nonprofit environmental group brought claims of trademark infringement and unfair competition under the Lanham Act.¹⁵⁴ The defendants, part of a rival organization, discovered that the plaintiff had forfeited its corporate status years earlier.¹⁵⁵ The defendants shortly thereafter incorporated their organization using the plaintiff’s name.¹⁵⁶ The district court rejected the argument that nonprofit organizations are not entitled to Lanham Act protection from unfair competition.¹⁵⁷ The court concluded that trademark principles applied to the plaintiff though “no goods or services were exchanged in commerce.”¹⁵⁸

A number of district court cases have relied on the Second Circuit’s decision in *United We Stand America* that a noncommercial entity’s activities can constitute services under the Lanham Act. In *Hershey Co. v. Friends of*

146. *Id.* The plaintiff rejected a proposal from the defendant that called for “significant changes in management.” *Id.*

147. *Id.* The plaintiff brought trademark infringement and unfair competition claims against the coalition. *Id.*

148. *Id.* at 475 (citing 15 U.S.C. §§ 1114, 1125 (2012)).

149. *Id.* at 475–76.

150. *Id.* at 476. See *supra* notes 133–36 and accompanying text for the facts and holding of *Lucasfilm*.

151. *Save Brach’s*, 856 F. Supp. at 476. (citing *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp 931, 934 (D.D.C. 1985)).

152. *Id.*

153. *Comm. for Idaho’s High Desert v. Yost*, 881 F. Supp. 1457, 1470–71 (D. Idaho 1995), *aff’d in part, rev’d in part*, 92 F.3d 814 (9th Cir. 1996).

154. *Id.* at 1463.

155. *Id.* at 1464.

156. *Id.*

157. *Id.* at 1470–71.

158. *Id.* at 1471.

Steve Hershey,¹⁵⁹ the district court granted the Hershey Company, a manufacturer of chocolate and candy products under the trademark “Hershey’s,” a preliminary injunction against Maryland state senator Steve Hershey.¹⁶⁰ As part of the 2014 midterm election campaign, Senator Hershey used a campaign logo with the word “Hershey” in white letters against a dual tone brown Maryland flag background.¹⁶¹ Senator Hershey’s campaign logo was substantially similar to the Hershey Company’s trademark.¹⁶² The Hershey Company sued the senator for trademark infringement, false designation of origin, and false endorsement under §§ 1114(1)(a) and 1125(a)(1) of the Lanham Act.¹⁶³

Relying on *Lamparello*¹⁶⁴ and *United We Stand America*,¹⁶⁵ the district court determined that Senator Hershey’s noncommercial political activities were services under the Lanham Act.¹⁶⁶ The district court analyzed the trademark infringement claim based on a likelihood of confusion standard.¹⁶⁷ Recognizing that the public was unlikely to confuse Senator Hershey with a chocolate bar, the district court nevertheless found a likelihood of confusion, finding that the public could mistakenly believe that Hershey Company was affiliated with or sponsored the campaign.¹⁶⁸

In *American Family Life Insurance Co. v. Hagan*,¹⁶⁹ insurance provider American Family Life Insurance (AFLAC) brought claims of trademark infringement, unfair competition, and dilution against Ohio gubernatorial candidate Tim Hagan and his campaign organization.¹⁷⁰ AFLAC sponsored the “AFLAC Duck” commercials, which involved a white duck quacking the name AFLAC “in a distinctive, nasal tone.”¹⁷¹ Hagan created Internet commercials aimed at his opponent Governor Robert Taft that borrowed from AFLAC’s commercials.¹⁷² The Internet commercials featured Governor Taft’s head sitting

159. 33 F. Supp. 3d 588 (D. Md. 2014).

160. *Hershey*, 33 F. Supp. 3d. at 590–91.

161. *Id.* at 591.

162. *Id.* at 593–94.

163. *Id.* at 590 n.1. The trademark infringement claim was brought under § 1114(1)(a). *Id.* The false designation of origin and false endorsement claims were brought under § 1125(a)(1). *Id.*

164. See *supra* notes 106–25 and accompanying text for a discussion of *Lamparello*.

165. See *supra* notes 127–44 and accompanying text for a discussion of *United We Stand America*.

166. *Hershey*, 33 F. Supp. 3d. at 594. The court contrasted a trademark infringement claim with a dilution claim, stating that unlike the latter, the former does not have a commercial activity requirement. *Id.*

167. *Id.* at 593–94.

168. See *id.* at 594 (“On the basis of the substantially similar campaign design, a member of the public could easily—and mistakenly—believe that Senator Hershey is in some way affiliated with Hershey.”).

169. 266 F. Supp. 2d 682 (N.D. Ohio 2002).

170. *Hagan*, 266 F. Supp. 2d at 685.

171. *Id.*

172. *Id.*

on the body of a white cartoon duck.¹⁷³ The cartoon duck would quack “TaftQuack” several times during each commercial.¹⁷⁴

In addressing AFLAC’s trademark infringement and unfair competition claims, the district court applied a likelihood of confusion analysis.¹⁷⁵ The district court noted that trademark infringement causes consumer confusion, which is not protected by the First Amendment.¹⁷⁶ The court found there was no likelihood of confusion.¹⁷⁷ In analyzing AFLAC’s dilution claim, the district court noted the distinction between source identification and communicative political speech in a number of trademark infringement cases, including *United We Stand America*.¹⁷⁸ In deciding AFLAC’s trademark dilution claim, the district court found that Hagan’s use of a slogan similar to AFLAC’s trademark was noncommercial and thus statutorily exempted from a dilution claim.¹⁷⁹

In summary, the Second and Fourth Circuits do not impose a commercial use requirement for infringement claims under the Lanham Act. In particular, the Second Circuit has held that a trademark used in connection with noncommercial services can constitute infringement. These courts acknowledge that noncommercial speech is protected by the First Amendment, whereas speech that confuses consumers is not. Therefore, these courts determine Lanham Act liability by asking whether the use of a trademark is likely to cause consumer confusion, not if a use is commercial.

III. DISCUSSION

This Section will first explore the impact that *Bosley Medical Institute, Inc. v. Kremer*¹⁸⁰ and *Taubman Co. v. Webfeats*¹⁸¹ have had on lower courts’ interpretations of the Lanham Act. Specifically, it will analyze how district court cases have dealt with Lanham Act claims against noncommercial entities. The consequences of these decisions may undermine legitimate trademark property rights for mark holders.

This Section will then explore the effects of *United We Stand America, Inc. v. United We Stand, America New York, Inc.*¹⁸² and *Lamparello v. Falwell*¹⁸³ on Lanham Act claims against noncommercial organizations. In these instances,

173. *Id.*

174. *Id.*

175. *Id.* at 689–92. Courts employ a likelihood of confusion test to determine trademark infringement and unfair competition. See *supra* note 4 for an example of factors courts may use to determine if there is a likelihood of confusion.

176. *Hagan*, 266 F. Supp. 2d at 696–97.

177. *Id.* at 690.

178. *Id.* at 698–700. See *supra* notes 127–44 and accompanying text for a discussion of *United We Stand America* and its holding that activities need not be commercial to maintain claims of trademark infringement and unfair competition under the Lanham Act.

179. *Hagan*, 266 F. Supp. 2d at 696–98.

180. 403 F.3d 672 (9th Cir. 2005).

181. 319 F.3d 770 (6th Cir. 2003).

182. 128 F.3d 86 (2d Cir. 1997).

183. 420 F.3d 309 (4th Cir. 2005).

courts have interpreted the Lanham Act broadly to encompass a wide range of services. The courts then apply a likelihood of confusion standard to determine liability under the Lanham Act.¹⁸⁴ This approach leads to greater protection for trademark owners than the *Bosley* and *Taubman* approach. However, it also protects legitimate First Amendment concerns by asking if the trademark use is likely to confuse consumers—a use that is not protected by the First Amendment.

Finally, this Section will endorse the *United We Stand America* court's reading of the Lanham Act. This Section argues that Lanham Act claims for unfair competition and trademark infringement should not be limited to commercial speech—this doctrine is too narrow. Instead, First Amendment concerns should be balanced by exempting trademark liability for communicative use and attaching liability for source identification use.¹⁸⁵

A. *Bosley and its Progeny Read the Lanham Act Too Narrowly*

Allowing organizations to capitalize on a company's trademark to purposely confuse consumers undermines the purpose of the Lanham Act.¹⁸⁶ Since *Bosley*,¹⁸⁷ district courts in the Ninth Circuit have dismissed Lanham Act claims that would otherwise have been actionable under a model that did not limit claims to commercial use. For instance, in *Hancock Park Homeowners Ass'n Est. 1948 v. Hancock Park Home Owners Ass'n*,¹⁸⁸ the district court relied on *Bosley* in its narrow reading of the Lanham Act.¹⁸⁹ The *Hancock Park* court applied the *Bosley* commercial use requirement not only to the defendant's use of the mark, but also to the plaintiff's.¹⁹⁰ In support of its holding, the court repeatedly pointed out that the plaintiff was not a commercial entity.¹⁹¹

184. See *supra* note 4 for an example of factors courts may use in a likelihood of confusion analysis.

185. The Lanham Act was passed to prevent consumer confusion as to the source of goods and services. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992) (“[T]he Act’s purpose [is] to ‘secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.’” (quoting *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985))). Confusing consumers is not protected by the First Amendment. *Hagan*, 266 F. Supp. 2d at 696–97. See *supra* notes 169–79 and accompanying text for the *Hagan* court’s analysis of the distinction between a communicative use of a trademark and a use intended to confuse consumers.

186. See *supra* Part II.B for a discussion of the Lanham Act.

187. See *supra* notes 72–75 and accompanying text for the facts and holding of *Bosley*.

188. No. CV 06-4584 SVW, 2006 WL 4532986 (C.D. Cal. Sept. 20, 2006). See *supra* notes 85–95 and accompanying text for the facts and holding of *Hancock Park*.

189. *Hancock Park*, 2006 WL 4532986, at *3–5.

190. *Id.* The court in *Hancock Park* held it lacked subject matter jurisdiction to hear the plaintiff’s Lanham Act claims because the plaintiff and defendant were both nonprofit organizations and did not meet the commercial use requirement of *Bosley*. *Id.*

191. See *id.* at *3 (“This Court holds that Plaintiff’s and Defendant’s use of the unregistered trademark in question fails [the commercial use] threshold for establishing subject matter jurisdiction.”). The *Hancock Park* court noted that it would lack jurisdiction over the action unless either party had used the trademark “in a manner that impacts some type of purchasing decisions,” and that neither party had done so. *Id.* at *5 (“Neither Plaintiff’s nor Defendant’s actions involve

Requiring a commercial use for the plaintiff's mark is nowhere to be found in the Lanham Act.¹⁹² The text on which the *Hancock Park* court relied applies to infringers, not trademark holders bringing infringement claims.¹⁹³ The result completely undercuts traditional notions of trademark and unfair competition law.¹⁹⁴

Under this narrow reading, a nonprofit organization that acted without a profit motive would not have the benefit of Lanham Act protection against trademark infringement. It is easy to see, for instance, a nonprofit organization having its trademark co-opted and left with little recourse. Imagine that a prominent nonprofit organization such as the World Wildlife Fund¹⁹⁵ had its trademark "WWF" co-opted by another nonprofit organization to promote its own services.¹⁹⁶ Under the *Hancock Park* court's reading of *Bosley*, the World Wildlife Fund would not have a Lanham Act claim.

The absurdity of this result is clear. The purpose of the Lanham Act—avoiding consumer confusion as to the source of goods and services¹⁹⁷—is completely undercut. What is stopping a trustworthy, loyal, helpful, friendly, courteous, kind, obedient, cheerful, thrifty, brave, clean, and reverent firearms enthusiast from starting the Boy Scouts of America Gun Club?¹⁹⁸ What is to stop a charitable retirement community from labeling itself the Salvation Army Condominium Association?¹⁹⁹ Uses of known trademarks in this manner would not only be confusing to consumers, but would also be unfair to the trademark owners.

Realizing this problem, district courts in the Ninth Circuit have since

commercial transactions in any sense, nor are they acting with a motive for profit. Plaintiff's services cannot be considered 'commercial' merely because they are funded by freely given donations.").

192. See 15 U.S.C. § 1114 (2012) (stating a person is *liable* for trademark infringement if she uses in commerce a registered trademark in connection with goods or services); *id.* § 1125(a)(1)(A) (stating a person is liable for unfair competition if she uses any "false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion . . . as to the origin, sponsorship, or approval of . . . her goods, services, or commercial activities by another person").

193. See *Hancock Park*, 2006 WL 4532986, at *4-5 (quoting § 1125(a)(1)(A)).

194. See, e.g., 1 MCCARTHY, *supra* note 126, at § 9:5 ("The fact that an organization is nonprofit and sells no goods does not take it out of the protection of the law of unfair competition.").

195. See *Careers*, WORLD WILDLIFE FUND, <http://www.worldwildlife.org/about/careers> (last visited Mar. 31, 2016) ("World Wildlife Fund is a nonprofit organization dedicated to environmental conservation through science.").

196. See WORLD WILDLIFE FUND, <http://www.worldwildlife.org> (last visited Mar. 10, 2016) (displaying throughout the website its logo, which includes the abbreviation "WWF").

197. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992).

198. See *generally Boy Scouts*, BOY SCOUTS OF AMERICA, <http://www.scouting.org/Home/BoyScouts.aspx> (last visited Mar. 31, 2016) (describing a Boy Scout as "trustworthy, loyal, helpful, friendly, courteous, kind, obedient, cheerful, thrifty, brave, clean, and reverent"); *The 50 Largest U.S. Charities*, FORBES, <http://www.forbes.com/top-charities/list/#tab:rank> (last visited Nov. 8, 2016) (listing the Boy Scouts of America as the twenty-ninth largest charity in the United States).

199. As of 2015, the Salvation Army is the second largest charity in the United States. *The 50 Largest U.S. Charities*, *supra* note 198.

recognized that noncommercial speech may trigger liability under the Lanham Act, but the alleged infringer must at least be in *competition* with the plaintiff.²⁰⁰ In *Choose Energy, Inc. v. American Petroleum Institute*,²⁰¹ the district court held that the American Petroleum Institute (API) was not liable for trademark infringement when it used Choose Energy's trademark because the two were not in competition.²⁰² API did not use its website to attack or criticize Choose Energy.²⁰³ API did not co-opt Choose Energy's trademark for the purpose of parody.²⁰⁴ It instead embarked on a political campaign that advocated for natural gas and petroleum friendly political candidates—a purpose at odds with Choose Energy's.²⁰⁵ Indeed, it seems as if API was playing off of Choose Energy's good will to confuse voters as to the source of the information it was providing.²⁰⁶ In this respect, API's use of Choose Energy's trademark differs greatly from cases where gripe site operators used the plaintiff's trademark to *criticize the plaintiff*.

While the Lanham Act may not protect against confusion generally,²⁰⁷ it does protect consumers from confusion over the source of goods or services.²⁰⁸ Choose Energy asserted *actual* consumer confusion, while the Lanham Act only requires a showing of a *likelihood* of confusion.²⁰⁹ Indeed, the district court

200. See, e.g., *Stanislaus Custodial Deputy Sheriffs' Ass'n v. Deputy Sheriff's Ass'n of Stanislaus Cnty.*, No. CV F 09-1988 LJO SMS, 2010 WL 843131, at *6 (E.D. Cal. Mar. 10, 2010) (“[I]f an actual sale of goods is not involved, the infringer must be engaged in some form of commercial competition”).

201. No. 5:14-CV-04557-PSG, 2014 WL 5474639 (N.D. Cal. Oct. 28, 2014).

202. *Choose Energy*, 2014 WL 5474639, at *3–4 (holding that political activities can trigger Lanham Act liability, but there must be competition (citing *Bosley Med. Inst. Inc. v. Kremer*, 403 F.3d 672, 679 (9th Cir. 2005))).

203. See *id.* at *1–3 (commenting that API's purpose in using Choose Energy's trademarks was to promote candidates that were friendly to the natural gas and oil industry).

204. See *id.*

205. See *id.* at *1 (“Choose Energy use[s] its domain name and trademarks to emphasize the fact that its services, as opposed to its offerings, are energy unbiased.”).

206. See *id.* at *2 (“Choose Energy may well be right that it faces a substantial likelihood of confusion . . . perhaps API should have known better.”); Leon Kaye, *American Petroleum Institute Accused of Sabotage, Trademark Infringement*, TRIPLEPUNDIT (Oct. 20, 2014), <http://www.triplepundit.com/2014/10/American-petroleum-institute-accused-sabotage-trademark-infringement/> (describing API's unethical use of Choose Energy's trademarks as a “public relations embarrassment”).

207. See *Lang v. Ret. Living Publ'g Co., Inc.*, 949 F.2d 576, 583 (2d Cir. 1991) (“[T]rademark infringement protects only against mistaken purchasing decisions and not against confusion generally.” (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 20 reporters' note to cmt. b (AM. LAW INST., Tentative Draft No. 2, 1990))).

208. See, e.g., *Anheuser-Busch, Inc. v. L. & L. Wings, Inc.*, 962 F.2d 316, 318 (4th Cir. 1992) (describing infringement as an unauthorized use of a trademark if it is likely to confuse a consumer as to the source or sponsorship of the goods or services); *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 293 (3d Cir. 1991) (noting that confusion is likely if the marks create the same “overall impression”); 2 MCCARTHY, *supra* note 126, § 23:28 (“If two conflicting marks each have an aura of suggestion, but each suggests something different to the buyer, this tends to indicate a lack of a likelihood of confusion.”).

209. See Kaye, *supra* note 206 (stating that Choose Energy asserted the American Petroleum Institute's website confused its potential customers, particularly those that attempted to contact

acknowledged that Choose Energy faced a *substantial* likelihood of confusion in this case.²¹⁰ The district court recognized both Choose Energy's and API's "marks are nearly identical" and "their services are similar."²¹¹ Nevertheless, under the constraints of *Bosley*,²¹² the district court's hands were tied—it had no choice but to deny Choose Energy injunctive relief.²¹³ API's speech was noncommercial and thus outside of the realm of the Lanham Act.²¹⁴

The *Choose Energy* court's decision is an example of an absurd result under *Bosley*. Following the court's logic, noncommercial political groups could use well-established trademarks in a manner that suggests false affiliation. For instance, an anti-gay rights organization could distribute literature using The Coca-Cola Company's registered trademarks—falsely suggesting The Coca-Cola Company endorses the organization's views.²¹⁵ One could imagine a politician implying that Facebook "likes" him by affiliating his campaign with the Facebook "Thumbs Up" trademark.²¹⁶ Allowing organizations to capitalize on a company's trademark to purposely confuse consumers undermines the purpose of the Lanham Act.²¹⁷

B. *The Progeny of Lamparello and United We Stand America*

United We Stand America and *Lamparello* produce sound results that align with the policy goals of the Lanham Act as demonstrated by *Hershey Co. v. Friends of Steve Hershey*.²¹⁸ *Hershey*, a case similar to *Choose Energy* that involved the 2014 midterm election, produced starkly different results. In *Hershey*, Senator Hershey used a campaign logo that was substantially similar to the Hershey Company's trademark.²¹⁹ Not constrained by the commercial speech or use threshold requirements other circuits impose,²²⁰ the district court

Choose Energy online); see also 15 U.S.C. §§ 1114, 1125(a)(1)(A) (2012) (requiring a likelihood of confusion for infringement).

210. *Choose Energy, Inc.*, 2014 WL 5474639, at *2.

211. *Id.*

212. *Bosley* held that Lanham Act claims only apply to a commercial use of a trademark. See *supra* notes 72–75 and accompanying text for the facts and holding of *Bosley*.

213. See *Choose Energy, Inc.*, 2014 WL 5474639, at *3 ("Since the Ninth Circuit's ruling in *Bosley*, other district courts have followed suit, applying *United We Stand America* through the lens of *Bosley* and Washington State Grange. This court has no choice but to do the same." (footnote omitted)).

214. *Id.* at *3–4.

215. The Coca-Cola Company's registered trademarks include "Coca-Cola" and its signature contour bottle. See Ted Ryan, *The Story of the Coca-Cola Bottle*, THE COCA-COLA COMPANY (Feb. 26, 2015), <http://www.coca-colacompany.com/stories/the-story-of-the-coca-cola-bottle>.

216. See FACEBOOK BRAND, <https://www.facebookbrand.com/> (last visited Mar. 10, 2016) (displaying a white and blue "Thumbs Up" among the Facebook brands).

217. See *supra* notes 23–38 and accompanying text for the origins and purpose of the Lanham Act.

218. 33 F. Supp. 3d 588 (D. Md. 2014).

219. *Hershey Co.*, 33 F. Supp. 3d at 593–94.

220. See, e.g., *Taubman Co. v. Webfeats*, 319 F.3d 770, 774–75 (6th Cir. 2003) ("If [defendant's] use is commercial, then, and only then, do we analyze his use for a likelihood of confusion. If

was able to analyze the trademark infringement claim based on a likelihood of confusion standard.²²¹ Relying on *Lamparello* and *United We Stand America*, the district court determined that Senator Hershey's political activities were services under the Lanham Act.²²²

Senator Hershey argued that his campaign logo was not used in a way that would confuse his political activities with Hershey Company's products, but the district court rejected his argument.²²³ Recognizing that the public was unlikely to confuse Senator Hershey with a chocolate bar, the district court nevertheless found a likelihood of confusion.²²⁴ The district court found that the public could mistakenly believe that Hershey Company was affiliated with or sponsored the campaign.²²⁵ This result is sound—Senator Hershey was trying to capitalize off of the good will of a well-known brand, not exercising his right to freedom of speech.²²⁶ In *Hershey*, the district court addressed Senator Hershey's First Amendment concerns by distinguishing communicative use of a trademark from use of trademark by association.²²⁷ That is, the district court did not view Senator Hershey's use of Hershey Company's mark as part of a communicative message—rather Senator Hershey was trying to associate himself with a popular brand.²²⁸

Cases such as *Hershey* are examples of why the likelihood of confusion analysis is effective. Courts should not ask if the use of a trademark is commercial as a threshold matter. Instead, courts should determine if the trademark is being used to communicate ideas. If used for communicative purposes, the use is protected by the First Amendment.²²⁹ If the trademark is used to purposely confuse consumers as to the source of goods and services, it is not protected by the First Amendment.²³⁰

[defendant's] use is also confusing, then it is misleading commercial speech, and outside the First Amendment.”).

221. *Hershey Co.*, 33 F. Supp. 3d at 593. See *supra* note 4 for an example of factors courts may use in determining a likelihood of confusion.

222. *Hershey Co.*, 33 F. Supp. 3d at 594. In *Lamparello*, the United States Court of Appeals for the Fourth Circuit declined to limit Lanham Act infringement claims to commercial uses of a trademark. *Lamparello v. Falwell*, 420 F.3d 309, 314 (4th Cir. 2005). In *United We Stand America*, the United States Court of Appeals for the Second Circuit held that noncommercial services fell within the scope of the Lanham Act. *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 89 (2d Cir. 1997).

223. *Hershey Co.*, 33 F. Supp. 3d at 594.

224. *Id.*

225. *Id.* (“On the basis of the substantially similar campaign design, a member of the public could easily—and mistakenly—believe that Senator Hershey is in some way affiliated with Hershey.”).

226. See *id.* at 594–95 (finding no First Amendment defense for the defendant).

227. *Id.*

228. *Id.*

229. *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 699 (N.D. Ohio 2002).

230. *Id.* In *Hagan*, the court also made this distinction between source identification and communicative political speech in a number of trademark infringement cases, including *United We Stand America*. *Id.* at 698–700. In deciding AFLAC's trademark dilution claim, the district court found that Hagan's use of a slogan similar to AFLAC's trademark was noncommercial and thus statutorily exempted from a dilution claim. *Id.* at 696. In addressing AFLAC's trademark infringement and unfair

C. *Courts Should Follow Lamparello and United We Stand America to Strike the Right Balance between the First Amendment and the Lanham Act*

Protecting speech that is communicative or unlikely to cause confusion from liability under the Lanham Act is more sound than protecting speech or uses that are noncommercial; in other words, the courts' decisions in *United We Stand America* and *Lamparello* are superior to those of the courts in *Taubman* and *Bosley*. For instance, a political organization necessarily engages in political speech that is protected by the First Amendment. Conversely, commercial speech is not subject to full First Amendment protection.²³¹ In determining whether speech is commercial, three factors are considered.²³² The factors are whether (1) the speech is an advertisement, (2) the speech refers to a specific product or service, and (3) the speaker has an economic motivation.²³³ The presence of all three factors strongly supports the conclusion that the speech is commercial.²³⁴ Though the *Taubman* court did not apply a test to determine whether the defendant's speech was commercial, district courts since have cited *Taubman* to invoke the commercial speech test.²³⁵

The commercial speech test goes too far in narrowing what kind of speech or use is subject to liability under the Lanham Act. Simply because speech is noncommercial does not mean it that is unlikely to confuse consumers.²³⁶ In *Hershey*, it was not at all clear that Senator Hershey's use of Hershey Company's trademark in his campaign logo would be considered commercial speech.²³⁷ Senator Hershey was fundraising using the Hershey Company's logo, so it may be said that he had an economic motivation.²³⁸ But raising political

competition claims, however, the district court applied a likelihood of confusion analysis. *Id.* at 689–92. The district court rightly noted that uses of trademarks that cause consumer confusion are not protected by the First Amendment. *Id.* at 696–97.

231. Fla. Bar v. Went For It, Inc., 515 U.S. 618, 623 (1995) (“Commercial speech enjoys a limited measure of protection, commensurate with its subordinate position in the scale of First Amendment values, and is subject to modes of regulation that might be impermissible in the realm of noncommercial expression” (alterations omitted) (quoting Bd. of Trs. of State Univ. of N.Y. v. Fox, 492 U.S. 469, 477 (1989))).

232. Bolger v. Youngs Drug Prods. Corp., 463 U.S. 60, 66–67 (1983).

233. U.S. Healthcare, Inc. v. Blue Cross of Greater Phila., 898 F.2d 914, 933 (3d Cir. 1990) (citing *Bolger*, 463 U.S. at 66–67).

234. *Id.* (citing *Bolger*, 463 U.S. at 67).

235. See Bd. of Dirs. of Sapphire Bay Condominiums W. v. Simpson, No. CV 04-62, 2014 WL 4067175, at *3 (D.V.I. Aug. 13, 2014) (citing *Taubman* for the proposition that the Lanham Act only regulates commercial speech before applying the commercial speech test); Valley Forge Military Acad. Found. v. Valley Forge Old Guard, Inc., 24 F. Supp. 3d 451, 455 (E.D. Pa. 2014) (same). See *supra* notes 47–71 and accompanying text for a discussion of *Taubman*.

236. See Choose Energy, Inc. v. Am. Petroleum Inst., No. 5:14-CV-04557-PSG, 2014 WL 5474639, at *2 (N.D. Cal. Oct. 28, 2014) (finding noncommercial speech that presented a substantial likelihood of consumer confusion).

237. See *supra* notes 159–68 and accompanying text for the facts and holding of *Hershey*.

238. See *Hershey Co. v. Friends of Steve Hershey*, 33 F. Supp. 3d 588, 594 (D. Md. 2014) (discussing that Senator Hershey used the logo in part to solicit donations).

donations is considered a form of protected political speech.²³⁹ Furthermore, it is hard to say that the speech was in any way proposing a commercial transaction.²⁴⁰ More to the point, it is a stretch to say *any* nonprofit or political organization that provides services proposes a commercial transaction.

Thus, under *Taubman* and *Bosley* only commercial uses of a trademark may be infringement—no matter how deceptive that noncommercial use is. The uses of trademarks in *Hershey* and *Choose Energy* did not include public commentary—the trademarks were used to deliberately confuse consumers as to the source of the defendant’s sponsorship.²⁴¹ *Bosley* and *Taubman* allow these uses. *United We Stand America* does not.²⁴²

Applying the *United We Stand America* approach to the facts of *Choose Energy* would yield a different result.²⁴³ Under *United We Stand America*, the proper threshold question of whether API could be liable for infringement would be whether it provides goods or services.²⁴⁴ In *United We Stand America*, the court construed the term “services” broadly as to include political activities and distributing information.²⁴⁵ API’s services would have fallen within this interpretation of services.²⁴⁶

The *United We Stand America* inquiry also involves a likelihood of confusion analysis.²⁴⁷ Since confusing consumers is not protected by the First Amendment, applying a likelihood of confusion analysis helps draw the line

239. See *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 697 (N.D. Ohio 2002) (casting doubt as to whether solicitation of political contributions proposes a commercial transaction); see also *FEC v. Colo. Republican Fed. Campaign Comm.*, 533 U.S. 431, 440 (2001) (“Spending for political ends and contributing to political candidates both fall within the First Amendment’s protection of speech and political association.”); *Buckley v. Valeo*, 424 U.S. 1, 14, (1976) (“[Political campaign] contribution and expenditure limitations operate in an area of the most fundamental First Amendment activities.”).

240. *U.S. Healthcare, Inc. v. Blue Cross of Greater Phila.*, 898 F.2d 914, 933 (3d Cir. 1990) (stating that the commercial speech doctrine makes the common sense distinction between speech proposing a commercial transaction and other forms of speech (citing *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626, 637 (1985))).

241. See *supra* notes 96–105 and accompanying text for the facts and holding of *Choose Energy*. See *supra* notes 159–68 and accompanying text for the facts and holding of *Hershey*.

242. See *supra* notes 127–44 and accompanying text for a discussion on *United We Stand America*.

243. See *supra* notes 96–105 and accompanying text for the facts and holding of *Choose Energy*.

244. See *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 89 (2d Cir. 1997) (beginning its analysis for trademark infringement under 15 U.S.C. § 1114 by determining whether the defendant provides goods or services).

245. *Id.* at 89–92.

246. According to the district court in *Choose Energy*, API’s services included educating voters, encouraging conversation regarding energy issues, and encouraging voters to elect officials that support energy initiatives. *Choose Energy, Inc. v. Am. Petroleum Inst.*, No. 5:14-CV-04557-PSG, 2014 WL 5474639, at *2 (N.D. Cal. Oct. 28, 2014).

247. See *United We Stand Am.*, 128 F.3d at 93 (“Even assuming that [the defendant] might communicate its political message more effectively by appropriating [the plaintiff’s trademark], such appropriation would cause significant consumer confusion.”).

between legitimate First Amendment concerns and trademark property rights.²⁴⁸ In *Lamparello*, for instance, the alleged infringer used a mark very similar to Jerry Falwell's as a domain name for a website devoted to criticizing Jerry Falwell.²⁴⁹ As the court rightly noted, nobody that visited the website would be confused as to whether Falwell was the source or sponsor of the website.²⁵⁰ Using the likelihood of confusion analysis in *United We Stand America*, the court also reached the correct conclusion—that the defendant was using the plaintiff's mark precisely to confuse voters regarding the origins of its services.²⁵¹

Conversely, the test that has emerged from *Bosley* has led to results that legitimately undermine trademark owners' property rights. Both *Hancock Park* and *Choose Energy* are examples of why a broad commercial speech restriction on Lanham Act claims for trademark infringement and unfair competition serves to undermine the statute's purpose. The Lanham Act not only protects a mark holder's rights to the trademark, but it also protects the public from confusion.

Contrast Lanham Act trademark infringement claims with dilution claims.²⁵² Trademark infringement claims are premised on the need to prevent consumer confusion, which is consistent with the First Amendment theory that the First Amendment does not protect fraudulent speech.²⁵³ Dilution claims, however, do not require a showing of consumer confusion, and thus “lack the built-in First Amendment compass of trademark” infringement claims.²⁵⁴ For this reason, Congress specifically exempted noncommercial uses of a trademark from dilution liability.²⁵⁵ No such exemption was made for trademark infringement claims.

The *United We Stand America* approach is in line with Congress's intentions in passing the Lanham Act.²⁵⁶ In *United We Stand America*, the court addressed whether the defendant has First Amendment protection by determining if its use of the trademark suggests the source of services or if the use is communicative.²⁵⁷ This is a more useful threshold determination than the

248. *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 696–97 (N.D. Ohio 2002).

249. *Lamparello v. Falwell*, 420 F.3d 309, 311 (4th Cir. 2005). See *supra* notes 106–25 and accompanying text for the facts and holding of *Lamparello*.

250. See *Lamparello*, 420 F.3d at 315 (“After even a quick glance at the content of the website at www.falwell.com, no one seeking Reverend Falwell's guidance would be misled by the domain name-www.falwell.com-into believing Reverend Falwell authorized the content of that website. No one would believe that Reverend Falwell sponsored a site criticizing himself, his positions, and his interpretations of the Bible.”).

251. *United We Stand Am.*, 128 F.3d at 89–92.

252. See *supra* notes 32–38 and accompanying text for information on trademark dilution.

253. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905 (9th Cir. 2002).

254. *Id.*

255. See 15 U.S.C. § 1125(c)(3) (2012) (“The following shall not be actionable as dilution by blurring or dilution by tarnishment . . . [a]ny noncommercial use of a mark.”).

256. See *supra* notes 127–44 and accompanying text for a discussion on *United We Stand America*.

257. *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 93 (2d Cir. 1997). Trademark infringement and unfair competition claims require showing a likelihood of confusion. See 15 U.S.C. §§ 1114, 1125(a)(1).

determination of whether the speech is commercial or noncommercial. Ultimately, the *United We Stand America* inquiry helps strike a balance between trademark owners' intellectual property rights and individuals' free speech rights.²⁵⁸

IV. CONCLUSION

The commercial use requirement for trademark infringement claims under the Lanham Act is unnecessary. It has led to absurd and unfair results. The requirement unnecessarily limits trademark infringement claims otherwise cognizable under the Lanham Act and ignores the legitimate concern of consumer confusion. It likewise discounts the intellectual property rights of trademark owners.

The *United We Stand America* approach not only protects First Amendment rights, but also protects against consumer confusion. By distinguishing between expressive and associative trademark uses, the approach carefully considers First Amendment protection. Only if the use is associative should the court then look to whether the use is likely to confuse consumers. The end result is that expressive speech continues to enjoy the protection it is warranted under the First Amendment and consumer confusion is avoided. This result not only fosters the aims of the Lanham Act, but also promotes the freedom of expression upon which our society prides itself. And that, America, is a cup of coffee that is good to the last drop.²⁵⁹

258. District courts in the Ninth Circuit have interpreted *Bosley* such that when there is no sale of goods or services, there must be competing services. *See, e.g.*, *Choose Energy, Inc. v. Am. Petroleum Inst.*, No. 5:14-CV-04557-PSG, 2014 WL 5474639, at *3 (N.D. Cal. Oct. 28, 2014). To the extent that this is relevant, it can be accounted for in a likelihood of confusion analysis. For instance, among the factors employed by the Ninth Circuit to determine a likelihood of confusion is the relatedness of the goods. *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1145–46 (9th Cir. 2011).

259. “Good to the Last Drop” is a trademark associated with Maxwell House Coffee, a brand owned by Kraft Foods Group, Inc. *See generally* MAXWELL HOUSE, <http://www.kraftrecipes.com/maxwell-house/> (last visited Nov. 10, 2016) (displaying the slogan “Good to the Last Drop”).