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. In 1946, Congress codified this common law principle when it enacted the Lanham Act—the source of federal trademark law. Among other things, the Lanham Act prohibits use of another’s trademark in a manner likely to cause consumer confusion.

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. If a court finds a likelihood of confusion, the alleged infringer can assert a fair use affirmative defense. The fair use defense was adopted to protect expressive use of a trademark, which is protected by the First Amendment.

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

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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 decease 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. 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.

That has changed. In the early twenty-first century, several circuits have held that trademark infringement claims require a commercial use. 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. Under this interpretation of the Lanham Act, noncommercial uses of a trademark—no matter how confusing—do not amount to infringement. This is because a noncommercial use “refers to a use that consists entirely of noncommercial, or fully constitutionally protected, speech.”

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. In enacting and enforcing the Lanham Act, Congress and the courts have...
had to balance trademark holders’ rights with the First Amendment rights of
other parties.\footnote{15} Congress has incorporated into the Lanham Act a number
of defenses to trademark infringement,\footnote{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.”\footnote{17} In \textit{Bolger v. Youngs Drug Products Corp.},\footnote{18}
the Supreme Court considered three factors for determining whether speech is
commercial or noncommercial.\footnote{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.\footnote{20} Answering yes to all three factors
strongly supports the conclusion that the speech is commercial.\footnote{21} This
“commercial speech doctrine” involves making a common sense distinction
between speech proposing a commercial transaction and other forms of speech.\footnote{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.” \footnote{23} Section 1114 of the Lanham Act
prohibits infringement of a registered trademark. \footnote{24} It specifically prohibits any
person, without consent of the registrant, from using in commerce \footnote{25} “any
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\footnote{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.
\footnote{16} See 15 U.S.C. § 1115(b) (2012) (providing a list of nine affirmative defenses to trademark
infringement).
\footnote{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)).
\footnote{18} 463 U.S. 60 (1983).
\footnote{19} Bulger, 463 U.S. at 66–67.
\footnote{20} U.S. Healthcare, Inc. v. Blue Cross of Greater Phila., 898 F.2d 914, 933 (3d Cir. 1990) (citing
\textit{Bolger}, 463 U.S. at 66–67).
\footnote{21} Id. (citing \textit{Bolger}, 463 U.S. at 67).
\footnote{22} Id. (citing Zauderer v. Office of Disciplinary Counsel, 471 U.S. 626, 637 (1985)).
\footnote{24} 15 U.S.C § 1114 (2012).
\footnote{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,
dilution actions include uses that are not likely to cause consumers confusion, as long as consumers nevertheless associate the two marks. 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. Congress specifically incorporated the concept of commercial speech from the commercial speech doctrine.

Congress again amended the Lanham Act by passing the Anticybersquatting Consumer Protection Act of 1999. Under the Anticybersquatting Consumer Protection Act, a person can be liable for cybersquatting when using a protected trademark as a domain name if he has made a bad faith attempt to profit from the trademark. This is true regardless of the “goods or services of the parties . . . .” Just as a trademark dilution claim does not require a likelihood of confusion, 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. Among these factors is “the person’s bona fide noncommercial or fair use of the mark.” 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 courts may use in determining a likelihood of confusion.


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.”

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, a Texas-based web designer learned that Taubman Company was opening a nearby shopping mall called “The Shops at Willow Bend.” He then registered the domain name “shopsatwillowbend.com” and created a website at that address. The website included information regarding the mall, a map, and links to the official mall website and individual websites of the mall’s stores. The website, however, also included links to the websites of the web designer’s business and his girlfriend’s custom-made t-shirt business. Once Taubman Company learned of the website, it demanded the defendant remove it. Taubman Company alleged that the domain name “shopsatwillowbend.com” infringed on its registered trademark “The Shops at Willow Bend.” In response, the defendant registered five more domain names, including “taubmansucks.com,” “shopsatwillowbendsucks.com,” and “willowbendsmallsucks.com.” All five domain names linked to the same “gripe site,” which presented the defendant’s narrative of the events and legal proceedings between him and Taubman. The district court granted Taubman’s motion for a preliminary injunction. It enjoined the defendant from using the domain name

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57. Id. at 772.

58. Id. at 773.
“shopsatwillowbend.com” and the five domain names the defendant later registered. The United States Court of Appeals for the Sixth Circuit overturned the preliminary injunction. 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. Thus, they constituted a commercial use of Taubman’s mark.

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. 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.

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. While acknowledging that economic damage may have been an intended effect of the defendant’s websites, the court invoked the First Amendment. 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.” 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.”

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.” 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.

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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.* 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. 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.” The Ninth Circuit further noted that absent an actual sale of goods or services, the appropriate inquiry is whether the defendant offers competing services. In *Utah Lighthouse Ministry v. Foundation for Apologetic Information & Research,* 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.

In *L.L. Bean, Inc. v. Drake Publishers, Inc.,* the United States Court of Appeals for the First Circuit reached a similar conclusion in a case involving an antidilution statute in Maine. 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.” 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.” 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.”

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.”)

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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., 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.”

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 Homeowners Ass’n, 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. 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. 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. The defendant began using the plaintiff’s trade name and registered the domain name “hancockparkhomeownersassociation.com.” In response, the plaintiff brought an unfair competition claim against the defendant under § 1125(a) of the Lanham Act.

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. 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. Relying on Bosley, the district court noted that the commercial use requirement applies to all Lanham Act claims. Therefore, the plaintiff’s claim was dismissed.

84. Farah, 863 F. Supp. 2d at 40.
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.
In Choose Energy, Inc. v. American Petroleum Institute, 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. The plaintiff, Choose Energy, Inc., operated an online energy marketplace at “chooseenergy.com.” 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. The defendant branded its website with Choose Energy’s “CHOOSEENERGY” and “CHOOSE ENERGY” trademarks.

Choose Energy brought a trademark infringement claim against API under § 1114 of the Lanham Act. The plaintiff alleged that the defendant purposely misappropriated its trademarks to engage in a biased political campaign. The district court did not find trademark infringement in part because API’s political activities did not constitute commercial services under the Lanham Act. 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. Because API’s activities were “wholly and completely distinct” from the commercial services offered by the plaintiff, no such competition existed.

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).

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.").
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, the United States Court of Appeals for the Fourth Circuit faced facts similar to those in Bosley, but declined to address whether the Lanham Act applied only to commercial speech. Lamparello had erected a gripe site under the domain name “fallwell.com” criticizing Reverend Jerry Falwell for, among other things, his antihomosexual views. 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. Falwell counterclaimed, alleging, among other claims, trademark infringement, unfair competition, and cybersquatting under §§ 1114, 1125(a), and 1125(d), respectively. The district court granted summary judgment in favor of Falwell and enjoined Lamparello. Lamparello appealed to the Fourth Circuit.

On appeal, Lamparello argued that the Lanham Act was limited to commercial speech so as to avoid unconstitutional censorship. While acknowledging the Sixth and Ninth Circuits’ decisions in Taubman and Bosley, respectively, the Fourth Circuit declined to adopt their holdings. Rather, the court distinguished Lanham Act causes of action for trademark infringement and unfair competition from those for dilution and cybersquatting. The court noted that the statutory language for dilution and cybersquatting claims explicitly used the term “noncommercial.” As mentioned above, the dilution statute provides an exception for noncommercial use of a mark. 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.
120. Id. at 313.
allows courts to consider whether one’s use of another’s mark is a bona fide noncommercial or fair use.\textsuperscript{121}

In contrast, neither a cause of action for trademark infringement nor for unfair competition uses the term “noncommercial.”\textsuperscript{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.\textsuperscript{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.”\textsuperscript{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.\textsuperscript{125}

Scholars and other case law suggest that claims by and against noncommercial entities for trademark infringement and unfair competition are viable.\textsuperscript{126} In United We Stand America, Inc. v. United We Stand, America New York, Inc.,\textsuperscript{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.\textsuperscript{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.\textsuperscript{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.\textsuperscript{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.”\textsuperscript{131}

\begin{thebibliography}{126}
\bibitem{121} Id. at 314.
\bibitem{122} Id.
\bibitem{123} Id.
\bibitem{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)).
\bibitem{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.fallwell.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.
\bibitem{126} See, e.g., I 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.”).
\bibitem{127} 128 F.3d 86 (2d Cir. 1997).
\bibitem{128} United We Stand Am., 128 F.3d at 89.
\bibitem{129} Id. at 89–90.
\bibitem{130} Id. at 90.
\bibitem{131} Id.
\end{thebibliography}
In so holding, the Second Circuit disagreed with the reasoning of an unrelated district court case on which the defendants relied. In *Lucasfilm Ltd. v. High Frontier*, 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. The district court did not find that the advertisements were services under §§ 1114 and 1125(a) of the Lanham Act. 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.” 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.”

The *United We Stand America* court then considered the First Circuit’s decision in *L.L. Bean, Inc. v. Drake Publishers, Inc.* In *L.L. Bean*, the First Circuit adopted the district court’s reasoning in *Lucasfilm*. 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. The Second Circuit further remarked that “[m]ost editorial, artistic, and humorous works are sold in commerce.”

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* and *Committee for Idaho’s High Desert v. Yost* to support its contention that political activities—that is, noncommercial speech—constitute services under the Lanham Act. 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. As part of its campaign, the defendant incorporated the plaintiff’s federally registered trademark into its

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132. *Id.* at 91.
135. *Id.* at 934.
136. *Id.*
137. *United We Stand Am.*, 128 F.3d at 91.
138. *Id.* at 91.
140. *United We Stand Am.*, 128 F.3d at 91.
141. *Id.* at 91–92.
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–Austen Interfaith Network. *Id.*
promotional materials. The plaintiff thereafter sought to enjoin the defendant from doing so.

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. 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. 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. 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. The court found that while the defendant may not have intended to create confusion by using the plaintiff’s trademark, confusion was nevertheless likely.

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

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

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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.
154. Id. at 1463.
155. Id. at 1464.
156. Id.
157. Id. at 1470–71.
158. Id. at 1471.
Steve Hershey, 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. 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. Senator Hershey’s campaign logo was substantially similar to the Hershey Company’s trademark. 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.

Relying on Lamparello and United We Stand America, the district court determined that Senator Hershey’s noncommercial political activities were services under the Lanham Act. The district court analyzed the trademark infringement claim based on a likelihood of confusion standard. 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.

In American Family Life Insurance Co. v. Hagan, 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. AFLAC sponsored the “AFLAC Duck” commercials, which involved a white duck quacking the name AFLAC “in a distinctive, nasal tone.” Hagan created Internet commercials aimed at his opponent Governor Robert Taft that borrowed from AFLAC’s commercials. The Internet commercials featured Governor Taft’s head sitting

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.”).
171. Id.
172. Id.
on the body of a white cartoon duck. The cartoon duck would quack “TaftQuack” several times during each commercial.

In addressing AFLAC’s trademark infringement and unfair competition claims, the district court applied a likelihood of confusion analysis. The district court noted that trademark infringement causes consumer confusion, which is not protected by the First Amendment. The court found there was no likelihood of confusion. 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*. 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.

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* and *Taubman Co. v. Webfeats* 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.* and *Lamparello v. Falwell* on Lanham Act claims against noncommercial organizations. In these instances,
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.\(^ {191}\)

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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) (“The 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.
187. See *supra* notes 72–75 and accompanying text for the facts and holding of *Bosley*.
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.\footnote{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”).} The text on which the Hancock Park court relied applies to infringers, not trademark holders bringing infringement claims.\footnote{See Hancock Park, 2006 WL 4532986, at *4–5 (quoting § 1125(a)(1)(A)).} The result completely undercuts traditional notions of trademark and unfair competition law.\footnote{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.”).}

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 Fund\footnote{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.”).} had its trademark “WWF” co-opted by another nonprofit organization to promote its own services.\footnote{See WORLD WILDLIFE FUND, http://www.worldwildlife.org (last visited Mar. 10, 2016) (displaying throughout the website its logo, which includes the abbreviation “WWF”).} 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 services\footnote{Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 774 (1992).}—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?\footnote{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, 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).} What is to stop a charitable retirement community from labeling itself the Salvation Army Condominium Association?\footnote{As of 2015, the Salvation Army is the second largest charity in the United States. The 50 Largest U.S. Charities, supra note 198.} 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.”).}
recognized that noncommercial speech may trigger liability under the Lanham Act, but the alleged infringer must at least be in competition with the plaintiff. In *Choose Energy, Inc. v. American Petroleum Institute*, 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. API did not use its website to attack or criticize Choose Energy. API did not co-opt Choose Energy's trademark for the purpose of parody. 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. 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. 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, it does protect consumers from confusion over the source of goods or services. Choose Energy asserted actual consumer confusion, while the Lanham Act only requires a showing of a likelihood of confusion. 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 8453131, at *6 (E.D. Cal. Mar. 10, 2010) (“[T]f an actual sale of goods is not involved, the infringer must be engaged in some form of commercial competition”).


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. The district court recognized both Choose Energy’s and API’s “marks are nearly identical” and “their services are similar.” Nevertheless, under the constraints of Bosley, the district court’s hands were tied—it had no choice but to deny Choose Energy injunctive relief. API’s speech was noncommercial and thus outside of the realm of the Lanham Act.

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. One could imagine a politician implying that Facebook “likes” him by affiliating his campaign with the Facebook “Thumbs Up” trademark. Allowing organizations to capitalize on a company’s trademark to purposely confuse consumers undermines the purpose of the Lanham Act.

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. 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. Not constrained by the commercial speech or use threshold requirements other circuits impose, the district court


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.
217. See supra notes 23–38 and accompanying text for the origins and purpose of the Lanham Act.
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. Relying on Lamparello and United We Stand America, the district court determined that Senator Hershey’s political activities were services under the Lanham Act.

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. Recognizing that the public was unlikely to confuse Senator Hershey with a chocolate bar, the district court nevertheless found a likelihood of confusion. The district court found that the public could mistakenly believe that Hershey Company was affiliated with or sponsored the campaign. 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.

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. 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.

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. 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.

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. Fulwell, 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).


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.


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. In determining whether speech is commercial, three factors are considered: (1) the speech is an advertisement, (2) the speech refers to a specific product or service, and (3) the speaker has an economic motivation. The presence of all three factors strongly supports the conclusion that the speech is commercial. 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.

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 is unlikely to confuse consumers. 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. Senator Hershey was fundraising using the Hershey Company’s logo, so it may be said that he had an economic motivation. 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))).


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


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

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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))).


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.


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.\footnote{Am. Family Life Ins. Co. v. Hagan, 266 F. Supp. 2d 682, 696–97 (N.D. Ohio 2002).} In \textit{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.\footnote{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 \textit{Lamparello}.} 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.\footnote{See \textit{Lamparello}, 420 F.3d at 315 (“After even a quick glance at the content of the website at www.fallwell.com, no one seeking Reverend Falwell’s guidance would be misled by the domain name- www.fallwell.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.”).} Using the likelihood of confusion analysis in \textit{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.\footnote{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).}

Conversely, the test that has emerged from \textit{Bosley} has led to results that legitimately undermine trademark owners’ property rights. Both \textit{Hancock Park} and \textit{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.\footnote{\textit{Hancock Park} and \textit{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.} 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.\footnote{Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 905 (9th Cir. 2002).} Dilution claims, however, do not require a showing of consumer confusion, and thus “lack the built-in First Amendment compass of trademark” infringement claims.\footnote{Id.} For this reason, Congress specifically exempted noncommercial uses of a trademark from dilution liability.\footnote{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.").} No such exemption was made for trademark infringement claims.

The \textit{United We Stand America} approach is in line with Congress’s intentions in passing the Lanham Act.\footnote{United We Stand Am., 128 F.3d at 89–92.} In \textit{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.\footnote{See supra notes 32–38 and accompanying text for information on trademark dilution.} This is a more useful threshold determination than the
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.  

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 Lanham Act, 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.

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”).