Fair Comment:
Restoring the Rightful Scope of Fair Use and Free Speech after *Elster* and *Warhol*

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Abstract

Social criticism and self-expression are being suppressed under overbroad intellectual property regimes. The United States Supreme Court has had multiple opportunities to apply its precedents on common-law torts, statutory crimes, and administrative regulations to copyright, trademark, and the right of publicity, but it has failed to do so. Indeed, the Court has tripled down on a definitional or internal approach that virtually prohibits First Amendment scrutiny of injunctions or damages against infringing speech in copyright disputes.

This Article explores how the Supreme Court has not carefully considered a constitutional right to engage in commentary in its intellectual property jurisprudence. Cases like *Harper & Row, Campbell, Warhol, Jack Daniels*, and potentially *Elster* introduced a necessity test, which helps determine whether imitation of a protected work or personal name should be a free-speech right. Despite different fact patterns and legal theories, cutting across the copyright trademark divide, two of these cases involved First Amendment rights. *Harper & Row* addressed whether reproduction of excerpts of a United States president's memoirs or given name was truly necessary to a speaker's message, and *Elster* alluded to whether alternative means of expression existed to the use of a former president's name as the trademark of a t-shirt company. In cases involving commentary on works or brands not connected to public officials, a similar dynamic arose in *Campbell, Warhol,* and *Jack Daniels*. While *Warhol* did not reference free speech, it should have. A right of fair comment could have improved the rulings in each of these cases by focusing on speakers' and listeners' interests; the First Amendment's drafting and intent; and doctrines of viewpoint and content discrimination, overbreadth, vagueness, and chilling effects.

Fair comment is a familiar principle from libel and slander law and it has been expanded to right of privacy cases in the Supreme Court and to right of publicity cases in the state supreme courts and lower federal courts. One issue is how far designers, artists, sculptors, and brand managers—like those in *Warhol, Elster,* and *Jack Daniels*—may go in making fun of images, names, or designs that are iconic, heavily commodified, or even rare or banal. In a more complex statement, freedom of opinion needs to be preserved from strategic

deployments of copyright or trademark rights against quite dissimilar art or designs that criticize, comment upon, or parody famous images, trademarks, or trade dress, in a manner that would not be very confusing. Just as fair comment in tort and state statutory cases permits taking some liberties with the reputations, created facts, and messages of other persons, fair comment in federal statutory cases could involve two connected inquiries: whether an alleged infringer knowingly or recklessly violated another's rights, and whether the reasonably prudent consumer would be confused in trademark disputes or perceive the same "meaning" or "aesthetics" between two or more "works" in copyright ones. The function of these inquiries is to implement the First Amendment's overbreadth protections against chilling effects, thereby ensuring a wide breathing space for cultural and social comment.

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I. Introduction

Social criticism and self-expression are being suppressed under overbroad intellectual property regimes.[1] The United States Supreme Court has had multiple opportunities to extend its free-speech case law on torts, statutory crimes, and administrative regulations to copyright, trademark, and the right of publicity, but it has failed to do so. Indeed, the Court has tripled down on a definitional or internal approach that virtually prohibits First Amendment scrutiny of injunctions or damages against infringing speech in copyright disputes.[2]

This Article explores how the Supreme Court has not carefully considered a constitutional right to engage in commentary in its intellectual property jurisprudence. Cases like *Harper & Row, Campbell, Warhol, Jack Daniels*, and potentially *Elster* introduced a necessity test, which helps determine whether imitation of a protected work or name should be a right.[3] Despite different fact patterns and legal theories, cutting across the copyright trademark divide, two of these cases involved First Amendment rights. *Harper & Row* addressed whether reproduction of excerpts of a United States president's memoirs or given name was truly necessary to a speaker's message, and *Elster* alluded to whether alternative means of expression existed to the use of a former president's name as one trademark in use by a t-shirt company.[4] In cases involving commentary on works or brands not connected to public officials, a similar dynamic arose in *Campbell, Warhol,* and *Jack Daniels*.[5] A right of fair comment could have improved the rulings in each of these cases by focusing on speakers' and listeners' interests; the First Amendment's drafting and intent; and doctrines of viewpoint and content discrimination, overbreadth, vagueness, and chilling effects.

Fair comment is a familiar principle from libel and slander law and it has been expanded to right of privacy cases in the Supreme Court and right of publicity cases in the state supreme courts and lower federal courts.[6] One issue is how far designers, artists, sculptors, and brand managers—like those in *Warhol, Elster,* and *Jack Daniels*—may go in making fun of images, names, or designs that are iconic, heavily commodified, or even rare or banal. In a more complex statement, freedom of opinion needs to be preserved from strategic deployments of copyright or trademark rights against quite dissimilar art or designs that criticize, comment upon, or parody famous images, trademarks, or

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1. *See generally* Mark A. Lemley & Rebecca Tushnet, *First Amendment Neglect in Supreme Court Intellectual Property Cases*, 2023 Sup. Ct. Rev. 85 (2024); Rebecca Tushnet, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 Yale L.J. 535, 582–90 (2004).
2. *See* Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 556 (1985).
3. *See, e.g., id.* at 557–58.
4. *See infra* notes 50–74, 171–204 and accompanying text.
5. *See infra* notes 75–170 and accompanying text.
6. *See infra* notes 17–22 and accompanying text.

trade dress, especially deployments against creators who are not be very confusing or exploitative. Just as fair comment in tort and state statutory cases permits taking some liberties with the reputations, created facts, and messages of other persons, fair comment as a First Amendment principle could involve two connected inquiries: whether an alleged infringer knowingly or recklessly violated another's rights, and whether the reasonably prudent consumer would be confused in trademark disputes or perceive the same "meaning" or "aesthetics" between two or more "works" in copyright ones. The function of these inquiries is to implement the First Amendment's overbreadth protections against chilling effects, thereby ensuring a wide breathing space for cultural and social comment.[7]

Part II of this Article analyzes the judicial and theoretical sources of a fair comment principle under the First Amendment. Part III explores the evolution of the Supreme Court's assessment of free speech and fair use across nearly five decades of jurisprudence, from the right of publicity decision in the late 1970s to the copyright and trademark decisions of 2023-2024. Part IV generates a fair comment framework that might cut across the doctrinal divisions of intellectual property law into copyright, trademark, and the right of publicity. It articulates a free-speech principle that might shape tests geared to the completeness, directness, duplicativeness, and maliciousness of the use of an intellectual property asset. Such a test, transcending the divisions into parody, satire, comment, criticism, research, scholarship, "news" reporting, nominative use, and transformative use under the First Amendment and/or fair use would move the judicial treatment of commentary, persuasion, illustration, analysis, and satire closer to the treatment of parody.

II. Fair Comment as a Principle

A. *Constitutional Sources*

In tort law cases, the Supreme Court has clarified that First Amendment protection extends to all "information concerning interesting phases of human activity and embraces all issues about which information is needed or appropriate so that that individual may cope with the exigencies of their period."[8] The principle of fair comment operates in libel and slander cases as a defense covering both "honest misstatements of fact" as well as "honest expression of opinion based upon privileged, as well as true, statements of fact," unless "actual malice" was shown by the plaintiff.[9] The Fourteenth Amendment requires states to recognize the doctrine, even if their own common law restricted fair

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7. *See infra* notes 23, 205 and accompanying text.
8. Campbell v. Seabury Press, 614 F.2d 395, 397 (5th Cir. 1980) (citing Time, Inc. v. Hill, 385 U.S. 374, 388 (1967) and Thornhill v. Alabama, 310 U.S. 88, 102 (1940)).
9. N.Y. Times Co. v. Sullivan, 376 U.S. 254, 292 n.30 (1964).

comment to true but reputation-damaging statements.[10] The "comment" in "fair comment" is relevant to guaranteeing an "'opportunity for free political discussion.'"[11] It is also significant that one foundation of fair comment is the public interest, namely the overriding interest in being free to signify agreement or disagreement with political and cultural leaders; i.e., the precept that "'public men are, as it were, public property . . . .'"[12]

The *Restatement of Torts*, its second edition, and its line extensions have taken on fair comment. The *Restatement of Torts* adopted William Prosser's taxonomy of the right of privacy as including, among other categories, the placing of persons in a false light and the commercial use of name or likeness so as to exploit the value thereof.[13] These two categories also have a foundation in Samuel Warren and Justice Brandeis's 1890 article on the right of privacy.[14] One example of fair comment's recognition in the *Restatement (Second) of Torts* is the tort of placing a person in a false light by misrepresentation of the record of a "public figure," which is subjected to the defense that the misrepresentation was not "major" so as to provoke a high degree of offense in a reasonable person.[15] The rule is deemed necessary to ensure a thorough vetting of published "insights," and that protagonists in public debates go into battle armed with the "weaponry" of their choice.[16] A second example is the tort of public disclosure of private facts, in which privacy rights are limited or lost when information is communicated in the "public interest" or involves "matters of the kind customarily regarded as 'news.'"[17] A third example involves the

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10. *See id.*; *see also id.* at 267 (citing Parsons v. Age-Herald Publ'g Co., 181 Ala. 439, 450 (1913)).
11. *Id.* at 301 (quoting De Jonge v. Oregon, 299 U.S. 353, 365 (1937)).
12. *Id.* at 268 (citing Beauharnais v. Illinois, 343 U.S. 250, 263–64, 263 n.18 (1952)). The *Beauharnais* Court upheld a criminal libel statute targeting speech that brought groups into contempt or disrepute. It acknowledged the defense of fair comment but declined to apply it because the issue had not been preserved procedurally. *Beauharnais*, 343 U.S. at 263–65 & n.18. The Court stressed that fair comment on political parties—even if expressed through "contempt" or "hatred"—is "indispensable to the democratic political process." *Id.* In addition, at common law, public figures invited public "disapproval," and became a species of "public property" thereby. Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 Calif. L. Rev. 127, 153–54, 154 n.127 (1993) (quoting Tolley v. J.S. Fry & Sons, Ltd., 1 K.B. 467 (1930), *aff'd*, (1931) App. Cas. 333, and citing Dockrell v. Dougall, 80 L.T.R. 556 (Eng. C.A. 1899), and Lyngstad v. Anabas Prods. Ltd. [1977] Fleet St. Pat. L.R. 62 (Ch.)).
13. *See, e.g.*, Restatement of Torts § 652 (Am. L. Inst. 1938); William L. Prosser, Law of Torts § 117 (4th ed. 1971).
14. *See* Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 Harv. L. Rev. 193 (1890).
15. *See, e.g.*, Lane v. Random House, Inc., 985 F. Supp. 141, 149 (D.D.C. 1995) (citing, *inter alia*, Restatement (Second) of Torts § 652E, cmt. c (Am. L. Inst. 1977)).
16. *Id.*
17. Restatement (Second) of Torts § 652D cmt. g (Am. L. Inst. 1977); *see*, *e.g.,* City of San Diego v. Roe, 543 U.S. 77, 83–84 (2004); Taylor-Travis v. Jackson State Univ., 984 F.3d

first *Restatement*'s recognition of fair comment in libel actions as a prelude to the rule of *New York Times Co. v. Sullivan*, and of *absolute* immunity for statements by public officials doing their jobs.[18]

Sullivan held that criticism or commentary of a public official on a matter of public concern is insufficiently protected for First Amendment purposes by an affirmative defense of truth. The Court announced an additional defense of actual malice or reckless disregard of the truth or falsity of a provable factual assertion or implication.[19] In a follow-up case, *Milkovich v. Lorain Journal*, the Court had the opportunity to reign in the *Sullivan* defense for low-level public officials like sports coaches at high schools, but did not do so; instead, it clarified that statements of pure opinion about such officials are absolutely protected, while false statements or implications of fact on matters of public concern could only attract liability based on showings of actual malice.[20] The line of cases from *Sullivan* through *Milkovich v. Lorain Journal* may have erected an absolute First Amendment defense for statements of opinion that do not imply provably false facts.[21] This is true even in cases not involving public officials, which may lie closer to the core of the *Sullivan* defense.[22] The *Sullivan* thread in the law establishes a "command" and a "duty as a matter of

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1107, 1117 (5th Cir. 2021); Pearson v. Dodd, 410 F.2d 701, 703 (D.C. Cir. 1969); Lewis v. Time Inc., 710 F.2d 549, 554 (9th Cir. 1983); Dresbach v. Doubleday & Co., 518 F. Supp. 2d 1285, 1290–91 (D.D.C. 1981); Bernstein v. Nat'l Broad. Co., 129 F. Supp. 817, 829–31 (D.D.C. 1955), *aff'd*, 232 F.2d 369 (D.C. Cir. 1956); *cf.* Peay v. Curtis Publ'g Co., 78 F. Supp. 305, 309 (D.D.C. 1948) ("The publication of a photograph of a private person without his sanction is a violation of [a privacy] right. An exception necessarily exists in respect to individuals who by reason of their position or achievements have become public characters."); Harrison v. Wash. Post Co., 391 A.2d 781, 784 (D.C. 1978) (holding, as to invasion of privacy claim, that "there is no cause of action for an accurate report of a matter of legitimate public interest or concern"); Barber v. Time, Inc., 159 S.W.2d 291, 295 (Mo. 1942) (recognizing a "public interest" exception to tort of invasion of privacy, via a balancing test that assesses "scope of proper public interest" and looks for "serious, unreasonable, unwarranted and offensive interference with" privacy interest).

18. *See* N.Y. Times Co. v. Sullivan, 376 U.S. 254, 292 n.30 (1964) (citing RESTATEMENT OF TORTS § 607 (AM. LAW INST. 1938)); *see also id.* at 282 n.22 (citing RESTATEMENT OF TORTS § 591 (AM. L. INST. 1938)).
19. *See Sullivan*, 376 U.S. at 279–80.
20. *See* Milkovich v. Lorain J. Co., 497 U.S. 1, 10 n.5, 20 (1990).
21. *See, e.g.*, Milkovich v. Lorain J. Co., 497 U.S. 1, 18–19 (1990); Old Dominion Branch No. 496, Nat'l Ass'n of Letter Carriers v. Austin, 418 U.S. 264, 284–86 (1974); Gertz v. Robert Welch, Inc., 418 U.S. 323, 339–40 (1974); Greenbelt Coop. Publ'g Ass'n v. Bresler, 398 U.S. 6, 14 (1970); *Sullivan*, 376 U.S. at 265–66, 282, 285; Phantom Touring, Inc. v. Affiliated Publ'ns, 953 F.2d 724, 731 & n.13 (1st Cir. 1992); Ollman v. Evans, 750 F.2d 970, 975 (D.C. Cir. 1984); Yates v. Iowa W. Racing Ass'n, 721 N.W.2d 762, 769–72 (Iowa 2006); Immuno AG. v. Moor-Jankowski, 74 N.Y.2d 548, 555 (1989); Rinaldi v. Holt, Rinehart & Winston, Inc., 42 N.Y.2d 369, 380 (1977); James v. San Jose Mercury News, Inc., 20 Cal. Rptr. 2d 890, 900–01 (Cal. Ct. App. 6th Dist. 1993); Gregory v. McDonnell Douglas Corp., 17 Cal. 3d 596, 601 (1976).
22. *See supra* notes 12, 15, 19–21 and accompanying text.

constitutional adjudication to distinguish facts from opinions in order to provide opinions with the requisite, absolute First Amendment protection."[23] The principle arguably extends beyond the traditional journalistic or political statement of fact to a ranking, display, or coding of the plaintiff in a negative way.[24]

B. *Statutory Protections*

The legislative history of section 107, the fair use statute, clarifies that comment should be a favored reproduction, derivative work, or other copyright infringement. Comment is repeatedly referenced as an appropriate sort of fair use, while other reproductions may be more suspect:

> The examples enumerated at page 24 of the Register's 1961 Report, while by no means exhaustive, give some idea of the sort of activities the courts might regard as fair use under the circumstances: "quotation of excerpts in a review or criticism for purposes of illustration or comment; quotation of short passages in a scholarly or technical work, for illustration or *clarification of the author's observations*;
>
> The availability of the fair use doctrine to educational broadcasters would be narrowly circumscribed in the case of motion pictures and other audiovisual works, but under appropriate circumstances it could apply to the nonsequential showing of an individual still or slide, or to the performance of a short excerpt from a motion picture for criticism *or comment* . . . .
>
> When a copyrighted work contains unfair, inaccurate, or derogatory information concerning an individual or institution, the individual or institution may copy and reproduce such parts of the work as are necessary to permit *understandable comment on the statements made* in the work.[25]

Four inferences should be drawn from this legislative discussion. First, clarification of one's own thoughts, even if not a direct attack on another's ideas, is appropriately regarded by the courts as fair use. Second, a summary of another's thoughts, for purposes such as news reporting or teaching, and again without any apparent necessity of disagreement, mockery, or new meaning,

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23. *Ollman*, 750 F.2d at 975.
24. *See, e.g.*, Lowe v. Sec. & Exch. Comm'n. , 472 U.S. 181, 210 & n.58 (1985) (stock market trend identification) (citing Bose Corp. v. Consumers Union of U.S., Inc., 466 U.S. 485, 513 (1984); Levitt v. Yelp! Inc., 765 F.3d 1123, 1126 (9th Cir. 2014) (stars on Yelp); Compuware Corp. v. Moody's Inv.'s Servs., Inc., 499 F.3d 520, 529 (6th Cir. 2007) (debt issuer ratings on ten-point scale); Jefferson Cnty. Sch. Dist. No. R-1 v. Moody's Inv.'s Servs., Inc., 175 F.3d 848, 856 (10th Cir. 1999) (opinion as to whether municipal debt had positive or negative prospects); First Equity Corp. v. Standard & Poor's Corp., 690 F. Supp. 256, 256–57, 260 (S.D.N.Y. 1988) (description of corporate debt as to its level of interest adjustments); Search King, Inc. v. Google Tech., Inc., No. CIV-02-1457-M, 2003 WL 21464658, at *1 (W.D. Okla. May 27, 2003) (visual rank on Google's pages of results for terms); Albert v. Yelp, Inc., No. G051607, 2016 WL 3910830, at *6 (Cal. Ct. App. 4th Dist. July 15, 2016) (discussing *Levitt*).
25. H.R. Rep. No. 94-1476, at 65, 72–73 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5675ff.

could qualify as fair use. Third, showing clips from films, or photos or film stills could be appropriate for the application of the fair use principle, even if comment and not criticism is at stake.[26] To paraphrase the legislative history, an educator or political speaker might simply be conveying wisdom, making arguments specific and compelling, or reflecting on trends in a society's mood or an individual's thinking or artistic expressions.[27] Likewise, comments made by copying and then responding to another person's critique, caricature, or other derogatory communication could naturally be fair.[28]

There is a parallel to this in trademark law. The legislative history of the Federal Trademark Dilution Act of 1995 reveals that comment enjoyed recognition in Congress as a type of expression protected under the First Amendment, even when it threatens to blur the distinctiveness or tarnish the reputation of famous brands used in commerce.[29] As its sponsor stated, the dilution cause of

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26. *See id.* (an "individual or institution may copy and reproduce such parts of the work as are necessary to permit understandable comment on the statements made in the work"); *id*. (fair use to engage in "quotation of excerpts in a review or criticism … [or], for illustration or clarification of the author's observations").
27. *See id.* (referring to enhancing "understanda[bility of a] comment" and to the "illustration or clarification" of the author's observations). *Cf.* Hustler Magazine, Inc. v. Moral Majority, Inc., 796 F.2d 1148, 1153 (9th Cir. 1986) ("[A]n individual in rebutting a copyrighted work containing derogatory information about himself may copy such parts of the work as are necessary to permit understandable comment."); Matthew Sag, *Predicting Fair Use,* 73 Ohio St. L.J. 47, 56–57 (2012) ("Copying without modification was regarded as transformative in *Savage v. Council on American-Islamic Relations, Inc*., where the Islamic organization copied and distributed anti-Islamic statements made by Michael Savage as part of a fundraising exercise.") (citing No. C 07-6076 SI, 2008 WL 2951281, at *9 (N.D. Cal. July 25, 2008)); *id*. ("Recontextualization without modification from one expressive context to another was seen as transformative in *Bill Graham Archives v. Dorling Kindersley Ltd.*") (citing 448 F.3d 605 at 609–10). *See generally* Tushnet, *supra* note 1, at 574–581.
28. *See* Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1270–73 (11th Cir. 2001) (fair use to rewrite a story that expresses its protagonist's "disgust with and condescension towards blacks" and "ideali[zation]" of Confederate-era South as "idyllic" place "upset" or "ruin[ed]" by emancipation of enslaved persons and invasion of the North and its Constitution, so that it becomes a new story—with same character names—of black characters' wisdom, "courage," and attractiveness in spite of Southerners' alleged "stupid[ity] or feckless[ness]"); Sag, *supra* note 27, at 56 (citing *Suntrust*).
29. *See* 15 U.S.C. § 1125(c)(2)(C) (defining blurring or tarnishment to exclude, *inter alia*, uses of trademark in commerce that constitute nominative use, news, parody, comment or criticism on mark owner or their goods or services, and all other noncommercial use); 141 Cong. Rec. S19306–10 (daily ed. Dec. 29, 1995) (statement of Sen. Orrin Hatch); Bally Total Fitness Holding Corp. v. Faber, 29 F. Supp. 2d 1161, 1165–66 (C.D. Cal. 1998). Prior to the Federal Trademark Dilution Act, the Lanham Act arguably did not need such a defense, because no reasonable consumer would be likely to be confused, mistaken, or deceived by artistic or editorial comment. *See, e.g.*, Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, 886 F.2d 490 (2d Cir. 1989), and MasterCard Int'l. Inc. v. Nader 2000 Primary Comm., Inc., 2004 WL 434404 (S.D.N.Y. Mar. 8, 2004); *see also* Daniel Gervais & Julie M. Latsko, *Who Cares About the 85 Percent?*

action added to section 43 of the Lanham Act should "not prohibit or threaten noncommercial expression, such as parody, satire, *editorial* and other forms of expression that are not a part of a commercial transaction."[30] Courts have construed dilution law to apply neither to consumer product reviews nor to other expressions of a "point of view."[31] The framing of section 43 of the Lanham Act parallels that of the fair use statute in negating any intention, or indeed any legislative power, to restrain comments.

Whether a particular use is part of a commercial transaction certainly complicates the lawfulness of fair comment in trademark law. On the side of limiting comment, trademark developers or proprietors might try to condemn satirical, humorous, or editorial uses as "commercial." On the side of protecting freedoms of speech and the press, the response is that comment, criticism, satire, and parody differ from commercial speech in that the latter has no meaning or message other than proposing a commercial transaction. While many parodies, satires, reviews, critiques, analyses, classroom lessons, and scholarship are offered for sale or in exchange for some consideration, they are not designed solely to promote a commercial transaction.

C. *Theoretical Approaches*

Scholars exploring First Amendment limitations on copyright, trademark, and the right of publicity make several theoretical observations. Lisa Ramsey, for example, explores tiers of First Amendment scrutiny.[32] She observes that to the extent the Lanham Act does not limit itself to misleading commercial speech, the federal government would need to articulate a substantial government interest and explain how the statute is narrowly tailored in order to satisfy strict First Amendment scrutiny.[33] Similarly, C. Edwin Baker argued that taking strict scrutiny seriously in copyright cases meant confining the statute to the least restrictive means of advancing the constitutional objective of promoting Science and the useful Arts.[34]

Reconsidering Survey Evidence of Online Confusion in Trademark Cases. 96 J. Pat. & Trademark Off. Soc'y 265, 268–69, 277–78 (2014).

30. Bally Total Fitness Holding Corp. v. Faber, 29 F. Supp. 2d 1161, 1166–67 (C.D. Cal. 1998) (quoting 141 Cong. Rec. S19306–10 (daily ed. Dec. 29, 1995) (statement of Sen. Orrin Hatch) (emphasis added)).
31. *Id.* at 1167 (citing Panavision Int'l, L.P. v. Toeppen, 945 F. Supp. 1296, 1303 (C.D. Cal. 1996)).
32. *See generally* Lisa P. Ramsey, *Free Speech Challenges to Trademark Law after* Matal v. Tam, 56 Houston L. Rev. 401 (2018).
33. *See id.* at 433; *see also* Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. Rev. 381 (2008).
34. C. Edwin Baker, *First Amendment Limits on Copyright*, 55 Vand. L. Rev. 891, 906 (2002); *see also* Tushnet, *supra* note 1, at 588 ("Transformative fair use … [could be] protecting the free speech functions of self-expression, persuasion, and affirmation. Instead of one prototypical fair use—*The Wind Done Gone*—we could have several, including the scholar at the photocopier and the fan in the chat room."); Tyler T. Ochoa, *Dr. Suess,*

III. Continuity and Change in Critiques of the Court's Case Law on Commentary

A. *Examining The Faulty Premise that Unauthorized Commentary Diminishes Incentive to Create*

In *Zacchini v. Scripps-Howard Broadcasting*, a performer objected to the filming of his human cannonball act at a county fair by a freelancer, to whom he conveyed his objection to being filmed. The news crew videotaped the act anyway and showed it on television. The performer sued for violation of the right of publicity under Ohio law, and the Ohio Supreme Court ruled that absent an intent to harm the performer or to exploit his act commercially, the First Amendment protected the freelancer and news station's activities with respect to the performer's act.[35] The state court emphasized the right to "report in [one's] newscasts matters of legitimate public interest."[36]

The majority opinion on appeal to the Supreme Court was mostly devoid of exploration of the history, values, or potential applications of the First Amendment. It mainly equated the right of publicity with copyright or trademark protection, and dismissed any potential First Amendment issues affecting these two primarily federal regimes.[37] In looking principally to precedents on the exclusive right to dramatize a book, or on contracts and torts in film and television disputes, it invoked precedents that did not consider the First Amendment at all.[38] Most troublingly, it endorsed Melville Nimmer's view that copyright does not trigger the free speech or free press clauses because it places no restraint on "the communication of ideas or concepts."[39]

The Juice and Fair Use: How The Grinch Silenced a Parody, 45 J. Copyright Soc'y U.S.A. 546, 615–16 (1997) ("The First Amendment interest in" copyright cases is more readily perceived by comparing copyright plaintiffs to hypothetical libel or slander plaintiffs challenging the same book, film, song, or other work. If such hypothetical plaintiffs sued for libel or intentional infliction of emotional distress, they "would have to prove both that the [work] was false, and that the defendant's acted either with knowledge that it was false or in reckless disregard as to whether or not it was false." This makes more apparent that copyright law "has given the fictional characters of Dr. Seuss [or other authors] greater protection from comment or criticism than an actual person would enjoy."); *see also infra* note 163 (citing cases such as *Chaker v. Crogan*, which state, like Ochoa, that a natural person is not protected from great deal of comment or criticism, even if knowingly false).

35. *See* Zacchini v. Scripps-Howard Broad. Co., 351 N.E.2d 454, 455 (Ohio 1976).
36. *Id.* (syllabus of opinion).
37. Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 575 (1977).
38. *See id.* at 575 (citing, *inter alia*, Kalem Co. v. Harper Bros., 222 U.S. 55 (1911); Manners v. Morosco, 252 U.S. 317 (1920); Ettore v. Philco Tel. Broad. Corp., 229 F.2d 481 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956)).
39. *Id.* at 577 n.13. This conclusion was already made in *Goldstein v. California*, 412 U.S. 546, 571 (1973). *See id.* The court also cited *Walt Disney Productions v. Air Pirates*, 345 F. Supp. 108, 115–16 (N.D. Cal. 1972) (citing Melville Nimmer, *Does Copyright Abridge*

This is incorrect because even as the Court was writing, copyright sometimes expressly regulated concepts as well as expressions or "feelings" of works, and because in other cases courts express doubt that idea and expression can fully be distinguished from one another.[40] It is also objectionable because freedom of speech recognizes the importance of a particular form of words or pattern of imagery or sound to the speaker, editor, publisher, or reader/listener.[41] The Court's "definitional balancing" of copyright and the First Amendment is therefore weak and ill-suited to remedying statutory overbreadth.[42]

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the First Amendment Guarantees of Free Speech and Press?, 17 UCLA L. Rev. 1180 (1970)).

40. *See, e.g.*, Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 755 (9th Cir. 1978) (extending copyright protection to "conceptual qualities" of cartoon characters like Mickey Mouse and Donald Duck); Sid & Marty Krofft Tel. v. McDonald's Corp., 562 F.2d 1157, 1167 (9th Cir. 1977) (copyright infringement involves "total concept and feel" of characters and setting in the case of television shows) (citing Roth Greeting Cards v. United Card Co., 429 F.2d 1106, 1110 (9th Cir. 1970)); *see also* Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 582–83 (1985) (noting that "the distinction between literary form and information or ideas is often elusive in practice."); Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930) (noting that a "playwright could [not] prevent the use of his 'ideas,' to which, apart from their expression, his property is never extended" but adding that: "Nobody has ever been able to fix that boundary, and nobody ever can. In some cases the question [of nonliteral or conceptual copyright infringement] has been treated as though it were analogous to lifting a portion out of the copyrighted work . . . .").
41. *See* Cohen v. California, 403 U.S. 15, 23 (1971); ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 926–27 (6th Cir. 2003) (citing Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989)); L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 29 (1st Cir. 1987); Bally Total Fitness Holding Corp. v. Faber, 29 F. Supp. 2d 1161, 1166 (C.D. Cal. 1998); Jennifer Rothman and Robert C. Post, *The First Amendment and the Right(s) of Publicity*, 130 Yale L.J. 86, 166 (2020); *cf*. Iancu v. Brunetti, 588 U.S. 388, 397–99 (2019). *But see* Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 206 (2d Cir. 1979) (trademark is a property entitlement that does "not 'yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.' . . . [b]ecause there are numerous ways in which defendants may comment" on their topic, enjoining them from trademark infringement presents no First Amendment issue) (quoting Lloyd Corp. v. Tanner, 407 U.S. 551, 567 (1972)), *limited by Rogers*, 875 F.2d at 999 n.4; *Walt Disney Prods.*, 581 F.2d at 756–57, 759 (suggesting that unnecessarily close copying may not be fair use and ability to express same idea without copying disposes of First Amendment issue raised).
42. Ramsey, *supra* note 32, at 406–07 & n.20, 433–34 & n.150 (collecting sources). *See generally* S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm., 483 U.S. 522, 568 (1987) (Brennan, J., joined by Marshall, J., dissenting) (contending that trademark-like rights may be facially overbroad and unconstitutional by conferring upon rightsholders a "broad discretion [which] creates the potential for significant suppression of protected speech. '[A] law subjecting the exercise of First Amendment freedoms to the prior restraint of a license, without narrow, objective, and definite standards to guide the licensing authority, is unconstitutional.'") (quoting Shuttlesworth v. Birmingham, 394 U. S. 147, 150–51 (1969)).

The dissent argued persuasively that the Court's analysis was wrong or at least overgeneralized.[43] It was wrong because the performance was open to the public, and television news crews had a free speech right to videotape public events and create speeches explaining them to viewers. The dissent contended that the majority should have created a framework to protect against "self-censorship," for example by barring liability for press reports with political or cultural value.[44]

The majority opinion in *Zacchini* was overly general because it painted broadcasts of the performers' entire act with a broad brush, rather than exempting commercial or unenlightening broadcasts from First Amendment protection.[45] As mentioned, dissenting Justice Powell alluded to a "good faith" standard that is critical to libel, slander, and false light claims against media defendants by public figures, and such as may remain relevant—perhaps highly so—to fair use arguments in copyright in light of *Harper & Row Publishers*.[46] Permitting "good faith" use of an "entire act" in a rebroadcast of it might facilitate tasteful, limited, or meritorious segments (or publications in non-broadcast media) as being shielded by the First Amendment, as with the "cultural" or "political" value test in obscenity law, a branch of the criminal law.[47]

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43. *Zacchini*, 433 U.S. at 580–81 (Powell, J., joined by Brennen, J., and Marshall, J., dissenting) (citing Smith v. California, 361 U.S. 147, 150–54 (1959)).
44. *Id.*
45. *Zacchini*, 433 U.S. at 562 (syllabus of opinion).
46. *See id.* at 580–81 & n.4 (citing, *inter alia*, N.Y. Times Co. v. Sullivan, 376 U.S. 254, 266 (1964)); *see also* St. Amant v. Thompson, 390 U.S. 727, 731 (1968) ("In *New York Times, supra*, the plaintiff did not satisfy his burden because the record failed to show that the publisher was aware of the likelihood that he was circulating false information."); *id.* (absent a speaker's "'serious doubts as to the truth' of the statement," or his or her "'subjective awareness of probable falsity,'" First Amendment does not permit damages to be imposed on media defendant for false statements about public figure on a matter of public concern); McCafferty v. Newsweek Media Grp., Ltd., 955 F.3d 352, 360 (3d Cir. 2020) (similar standards in analyzing false light claim); Schiavone Constr. Co. v. Time, Inc., 847 F.2d 1069, 1090 (3d Cir. 1988) ("[O]bjective circumstantial evidence can suffice to demonstrate actual malice . . . [and] can override defendants' protestations of good faith and honest belief that the report was true."). *But see* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 585 n.18 (good faith is not necessarily helpful in a fair use analysis). *See generally* Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 562 (1985) ("'Fair use presupposes "good faith" and "fair dealing."'") (quoting Time Inc. v. Bernard Geis Assocs., 293 F. Supp. 130, 146 (S.D.N.Y. 1968) (quoting Schulman, *Fair Use and the Revision of the Copyright Act*, 53 Iowa L. Rev. 832 (1968))).
47. *See* Reno v. Am. C.L. Union, 521 U.S. 844, 872–74 (1997) (citing Miller v. California, 413 U.S. 15, 24–25 (1973)); Free Speech Coalition, Inc. v. Paxton
95 F.4th 263, 290–91, 301–02 (5th Cir. 2024) (Higginbotham, J., concurring in part), *cert. granted* 144 S. Ct. 2714 (2024); NetChoice v. Bonta, 761 F. Supp. 3d 1202, 1214–17, 1224–26 (N.D. Cal. 2024), *injunction aff'd in part, rev'd in part*, 152 F.4th 1002, 1017–25 (9th Cir. 2025).

Zacchini appears to have been a pre-originalist opinion. Interest balancing is its frame of reference, such as Justice Breyer and others would later advance in opposition to original intent (or old originalism).[48] Pre- or non-originalist decision-making on issues relating to the Bill of Rights is questionable primarily because it relies on "a judge-empowering 'interest-balancing inquiry'" that weighs individuals' constitutional rights on an invisible, unlabeled measuring scale against beneficial governmental aims.[49] *Harper & Row* takes up its theme and imputes the *Zacchini* rule to the Constitution's Framers. The next section illustrates the difficulties with this approach, and how the dissent would defend the First Amendment right of news reporting and commentary with a rule of fair comment.

In *Harper & Row*, the former president, Gerald Ford, had published his memoirs with a for-profit publishing house and TV Guide and Time had arranged to publish excerpts.[50] *The Nation* magazine had obtained a leaked copy and published a summary, as part of its continuing coverage of the Eisenhower, Kennedy, Nixon, and Ford administrations, but with little new commentary or criticism of the Ford or Nixon administrations. Ford's publishers filed a copyright infringement suit against The Nation Enterprises, which argued fair use and a First Amendment right to publish newsworthy material as "fair comment", consistent with past journalistic and literary practice.[51]

The Supreme Court has used outdated marketplace assumptions and conceptual shortcuts to eviscerate the fair use and First Amendment right of commentary. The Court has advanced several reasons not to recognize a First Amendment right to comment on the news by publishing newsworthy copyrighted material. First, the Copyright Act may increase the aggregate publication of news and ideas by enhancing the economic returns from doing so.[52]

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48. *See* District of Columbia v. Heller, 554 U.S. 570, 689 (2008) (Breyer, J., joined by Stevens, Souter & Ginsburg, JJ., dissenting) (asking whether government's "concerns [are] sufficiently forceful to justify restrictions on individual liberties"); *see also id.* at 625, 634 (opinion for the Court) (noting that this is the dissent's argument, and calling it constitutional scrutiny by "a judge-empowering 'interest-balancing inquiry' that 'asks whether the statute burdens a protected interest in a way or to an extent that is out of proportion to the statute's salutary effects upon other important governmental interests,'" as opposed to the majority's "historical understanding of the scope of the right").
49. *Id*. at 634.
50. *Harper & Row*, 471 U.S. at 542–43, 563–69.
51. The Nation Enterprises also argued as well that its use of the memoir found support in the "Fair Comment doctrine" assertion of *The Washington Post* relating to publishing excerpts of John Haldeman's memoirs, a book which was licensed to The New York Times Co.'s subsidiary for first publication. *Harper & Row*, 471 U.S. at 578–79; *A Second-Rate What?*, Wash. Post (Feb. 21, 1978), https://www.washingtonpost.com/archive/politics/1978/02/22/a-second-rate-what/8bcfcd48-191e-4ea3-8f51-6936e16c4e52 [archive.is/lA4z0].
52. *Harper & Row*, 471 U.S. at 558–69.

Second, the "'social value'" of (re)publication is irrelevant to fair use under a Chicago School economic analysis focused on whether fair use is truly necessary to avert a "market failure."[53] Third, there is a right not to speak, which the law protects by creating an exclusive right to publish previously unreleased works.[54] The fair use statute may allude to this right by regulating commercial use, referring to the nature of the work, and weighing the impact on potential markets, according to its legislative history.[55]

Harper & Row reached a nearly identical conclusion as *Zacchini*, but in a copyright case with an arguably weightier matter of public concern at stake. Just as *Zacchini* spent little time on the original meaning or context of the First Amendment, but put its thumb on the scales for performers' control interests, the *Harper & Row* majority gave short shrift to the freedom of speech or the press while singing the rhetorical praises of publisher control.[56] Two dissenters

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53. *See, e.g.*, *id*.; Wendy Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1573, 1582–91, 1593, 1599–1604, 1606 (1993) (suggesting that courts should eliminate the First Amendment in intellectual property cases because it would not be efficient to allow citizens to engage in satire while referencing other citizens' prior commentaries, and that fair use must be an absolutely necessary use to comply with Lockean theory, while necessity does not exist where a person could reference a different, perhaps licensed, work in their own work) (citing, *inter alia*, William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL STUD. 325 (1989)); *see also* Richard Posner, *When Is Parody Fair Use?*, 21 J. LEGAL STUD. 67, 67–68 (1992).

54. *See Harper & Row*, 471 U.S. at 559–61. In this passage, the Court stated that news reporting could be benefited by enhanced copyright protection, contrary to The Nation's claims. The premises of copyright legislation that works most in the public interest needed the most incentivizing by exclusive rights had to override the First Amendment premise that public debate must be liberated from government control, free-wheeling, and immune from legal attack. Finally, the liberty to withhold speech and press publications existed alongside the liberty to write and publish them. It concluded:

> In view of the First Amendment protections already embodied in the Copyright Act's distinction between copyrightable expression and uncopyrightable facts and ideas, and the latitude for scholarship and comment traditionally afforded by fair use, we see no warrant for expanding the doctrine of fair use to create what amounts to a public figure exception to copyright. Whether verbatim copying from a public figure's manuscript in a given case is or is not fair must be judged according to the traditional equities of fair use.

Id. at 560.

55. *See Harper & Row*, 471 U.S. at 559–60; 17 U.S.C. § 107; H.R. REP. NO. 94-1476, at 72–73 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5675ff.

56. *See Harper & Row*, 471 U.S. at 556 ("The Second Circuit noted, correctly, that copyright's idea/ expression dichotomy 'strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression.'") (quoting Harper & Row Publishers, Inc. v. Nation Enters., 723 F.2d 195, 203 (2d Cir. 1983)); *id*. at 559 ("'If every volume that was in the public interest could be pirated away by a competing publisher, . . . the public [soon] would have nothing worth reading.'") (quoting Lionel S. Sobel, *Copyright and the First Amendment: A Gathering Storm?*, 19 ASCAP COPYRIGHT L. SYMP. 43, 78 (1971)).

in *Zacchini*, dissenting again in *Harper & Row*, observed that (1) a tiny portion of the book had been quoted, (2) the quotes were taken from distant passages in the book, (3) the book was summarizing other public officials' statements in several quoted passages, (4) the passages were hardly poetic or thickly evocative, and (5) restricting this kind of quotation inhibits public debates that must remain free and "'robust.'"[57]

One might object that the Court had protected the publishers' expression, not their ideas, except that this central distinction is, as the dissent noted, "elusive in practice."[58] The majority opinion in *Harper & Row* did not draw the line that defines "expression," and it indeed characterized as expression what a layperson would term an idea, such as "analysis, structuring of material and marshaling of facts."[59] In recent years, courts have extended copyright to a variety of analytical and organizational systems that many people would think of as ideas.[60] Other courts have found both historical analysis and a work's basic structure to be unprotected ideas.[61]

Doctrinal confusion and repression of analytical commentary were predictable outcomes of *Harper & Row* and from aspects of *Zacchini*. Preceding the Supreme Court's ruling in *Harper & Row*, the Second Circuit opinion criticized the publishers' position that memoirs could not be paraphrased to capture a former president's "state of mind," as being a rule governing "the copyrightability of facts and of paraphrase" that will "clash with the First Amendment [whenever] an author chose to put in his own words facts which

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57. *Id.* at 582, 599–600 (Brennan, J., joined by Marshall & White, JJ., dissenting) (quoting N.Y. Times Co. v. Sullivan, 376 U.S. 254, 270 (1964)).
58. *Id.* at 582–83 (Brennan, J., joined by Marshall & White, JJ., dissenting) (noting that "the distinction between literary form and information or ideas is often elusive in practice."). I refer to publishers in the plural to include TV Guide along with Harper & Row Publishers in the identification of the expressions protected, President Ford not being a publisher.
59. *Id.* at 548 (O'Connor, J., opinion for the Court).
60. *See* CDN Inc. v. Kapes, 197 F.3d 1256, 1260 (9th Cir. 1999) (price estimates); Practice Mgmt. Info. Corp. v. Am. Med. Ass'n, 121 F.3d 516, 517–18 (9th Cir. 1997), *amended by* 133 F.3d 1140 (9th Cir. 1998) (medical billing codes); CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61, 63 (2d Cir. 1994) (car valuations); Peter S. Menell et al., Intellectual Property in the New Technological Age 538 (2023).
61. *See, e.g.*, Vallejo v. Narcos Prods., LLC, 833 F. App'x 250, 257–58 (11th Cir. 2020); Corbello v. Valli, 974 F.3d 966, 971 (9th Cir. 2020); Rosemont Enters., Inc. v. Random House, Inc., 366 F.2d 303, 309–10 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967); Alexander v. Haley, 460 F. Supp. 40, 45 (S.D.N.Y. 1978); Broadway Music Corp. v. F-R Publ'g Corp., 31 F. Supp. 817, 818 (S.D.N.Y. 1940); *cf.* Folsom v. Marsh, 9 F. Cas. 342, 344–45, 347–49 (C.C.D. Mass. 1841) (No. 4,901) (noting that governments may have "right" or even "duty" to publish writings of public officials, "against the[ir] will," for "historical, military, or diplomatic information" dissemination).

had already been described by another writer."[62] Similarly, the *Zacchini* dissent had warned of broadcasters withholding information and "coverage."[63]

The economic analysis of fair use is overly simplistic and oblivious to non-economic values and possibilities. It assumes a great interest in controlling the ability not to speak, or to control the timing of one's speech, even when it is not one's own speech but another person or organization's comment on or summary or analysis of one's speech that is at issue. The *Harper & Row* dissent mocked the majority's rudimentary Chicago School approach to unauthorized publication of excerpts from copyrighted works, which assumes that a fair use or fair comment right will be an end to writing for profit by "drain[ing] all value from a copyright owner's right of first publication."[64] Under a more sophisticated economic approach, a court might ask whether sharing attention or revenue with a competitor might still have some "value," and indeed whether reviews, publicity, and controversy might expand one's market.[65]

Empirical work has demonstrated that fragmentary use of copyrighted material does not destroy any copyright's return or eliminate the incentive to create, as the majority in *Harper & Row* suggested. Music sampling, for example, is highly likely to increase sales of sampled songs.[66] Paraphrasing themes

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62. Harper & Row Publishers, Inc. v. Nation Enters., 723 F.2d 195, 204 (2d Cir. 1983), *rev'd*, 471 U.S. 539 (1985).
63. Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 580–81 (1977).
64. *Harper & Row*, 471 U.S. at 596–97 n.21 (Brennan, J., joined by Marshall & White, JJ., dissenting). As Mark Lemley explains, a rudimentary Chicago School law-and-economics approach to intellectual property would grant exclusive rights as often as possible, even at the expense of the public domain, in order to avoid the disastrous lack of investment which the approach's model of human activity posits in the absence of exclusive rights. Meanwhile, by downplaying the costs of licensing copyrighted or trademarked assets or foregoing partial and public-benefiting uses of them, the approach paints a distorted picture. *See* Mark Lemley, *Romantic Authorship and the Rhetoric of Property*, 75 Tex. L. Rev. 873, 895–905 (1997).
65. *Cf.* Elsmere Music, Inc. v. Nat'l Broad. Co., Inc., 482 F. Supp. 741, 747 (S.D.N.Y. 1980) ("Just as imitation may be the sincerest form of flattery, parody is an acknowledgment of the importance of the thing parodied."), *aff'd*, 623 F.2d at 253 n.1 ("A parody is entitled at least to 'conjure up' the original. Even more extensive use would still be fair use, provided the parody builds upon the original, using the original as a known element of modern culture and contributing something new for humorous effect or commentary."); *see also* Glynn Lunney, *Reexamining Copyright's Incentives-Access Paradigm*, 49 Vand. L. Rev. 483, 572 (1996) ("Without denying the hard work and creativity that an author may have invested in a work, we should also recognize . . . other individuals whose efforts, as much as those of the author, are factual predicates of the market value of any given work of authorship: [including] those whose efforts made possible the physical creation and mass-market dissemination of the work…."); Glynn Lunney, *Trademark Monopolies*, 48 Emory L.J. 367, 464 (1998) (observing that "famous marks did, in fact, develop during the nineteenth and early twentieth centuries when such property-based protection [against dilution, merchandise, etc.] remained unavailable").
66. *See*, *e.g.*, W. Michael Schuster, *Fair Use, Girl Talk, and Digital Sampling: An Empirical Study of Music Sampling's Effect on the Market for Copyrighted Works*, 67 Okla. L.

and stories from prior books, such as those of Socrates, Plato, Ovid, or Plutarch, hardly destroys them, or Aristotle and Shakespeare would already have eliminated their predecessors centuries or millennia ago.[67] Massive leaks of the juiciest revelations in memoirs like Prince Harry's *Spare* fail to prevent massive sales.[68] Authors who countenanced piracy of their own books or articles in their entirety, and producers or rightsholders who embraced similar treatment, have sometimes had similar experiences.[69]

The fate of Sherlock Holmes, Winnie the Pooh, and Mickey Mouse since the early versions of these characters entered the public domain also reveals little evidence of total market destruction. Many of the popular Sherlock Holmes movies and television shows we have today came out after the stories began to enter copyright's public domain, and four more television series were planned after the last Arthur Conan Doyle story did so.[70] *Mickey Mouse*

Rev. 443, 444 (2015); *cf. Harper & Row,* 471 U.S. at 596–97 n.21 (Brennan, J., joined by Marshall & White, JJ., dissenting); *id*. at 559–60 (opinion for the Court).

67. *See, e.g.*, Andy Warhol Found. for the Visual Arts v. Goldsmith, 598 U.S. 508, 583 (2023) (Kagan, J., joined by Roberts, C.J., dissenting) (noting that Shakespeare took material from Ovid for *Romeo and Juliet* and from many other authors for reuse in other plays or sonnets—Plutarch was one, although he is not mentioned); *see also id.* at 582 (observing that "'[A]ppropriation, mimicry, quotation, allusion and sublimated collaboration,' [as] novelist Jonathan Lethem has explained, are '… cutting across all forms and genres in the realm of cultural production.'") (quoting Jonathan Lethem, *The Ecstasy of Influence*, *in* Harper's Magazine 61 (Feb. 2007)); Julia Griffin, *Plutarch and Shakespeare*, *in* The Cambridge Companion to Plutarch 364 (Frances B. Titchener & Alexei V. Zadorojnyi eds., 2023) (discussing Shakespeare's use of Plutarch's texts in *Antony and Cleopatra* and *Julius Caesar*); Nicholas D. Smith, *Aristotle on Socrates*, *in* Socrates and the Socratic Dialogue 601–622 (Alessandro Stavru & Christopher Moore eds., 2017) (noting that Aristotle attempts to summarize thought of Socrates, but in doing so is seen by some as too "dependent upon Plato").

68. *See, e.g.*, Alexandra Alter & Elizabeth Harris, *The Rollout of Prince Harry's Book 'Spare' is Chaotic. Sales are Still Surging*, N.Y. Times (Jan. 10, 2023), https://www.nytimes.com/2023/01/07/books/prince-harry-spare-memoir-leaks.html [https://perma.cc/28ZE-2WBE]; Max Foster, Lauren Said-Moorhouse & Lianne Kolirin, *Prince Harry's Memoir 'Spare' Breaks Sales Record*, CNN (Jan. 13, 2023), https://www.cnn.com/style/article/harry-spare-publication-record-scli-intl/index.html [https://perma.cc/QQ8C-XBDE].

69. *See, e.g.*, Violeta Solonova Foreman, *Problems with BitTorrent Litigation in the United States: Personal Jurisdiction, Joinder, Evidentiary Issues, and Why the Dutch Have a Better System*, 13 Wash. U. Glob. Stud. L. Rev. 127, 134 n.40 (2014) (citing "best-selling author Paulo Coelho, who made his novels available on The Pirate Bay and as a result sold tens of thousands of extra books."); Jordan Valinsky, *HBO Thinks Illegally Downloading 'Game of Thrones' Is a Huge Compliment*, Observer (Apr. 2, 2013), https://observer.com/2013/04/hbo-thinks-illegally-downloading-game-of-thrones-is-a-huge-compliment-to-the-network/ [https://perma.cc/T4C9-DQF7] (quoting HBO President of Programming, Michael Lombardo, calling online torrents in the manner of The Pirate Bay a "compliment" that "certainly didn't negatively impact the DVD sales" and "something that comes along with having a wildly successful show on a subscription network.").

70. *See* Abigail Stevens, *Every Sherlock Holmes Movie & TV Show in Development*,

and *Winnie the Pooh* movies and shows still appeared on Disney's streaming service and linear cable networks like Disney Junior in 2023 or 2024.[71] These two revenue sources brought in $400 million more in Q2 2024 than Q2 2023, realizing a nearly 10% jump, and the streaming service was then on the verge of becoming profitable.[72] If fully entering the public domain does not destroy the market for a character, it is difficult to imagine how commenting on newsworthy aspects of an author or a work could destroy markets. For this reason, *Harper & Row* and its progeny rest on a faulty premise, and should be revisited.

Another underpinning of *Harper & Row* has been greatly undermined recently. The relevant dictum, drawn from a law review article, states that: "It is fundamentally at odds with the scheme of copyright to accord lesser rights in those works that are of greatest importance to the public."[73] In finding that privately prepared annotations to public laws could not be copyrighted under the government edits doctrine, the Supreme Court observed that recognizing such copyrights would reduce citizens' ability to "learn[] [their] legal rights and duties."[74] Therefore, importance to the public could be considered as a factor in adjusting the scheme of copyright to extend less expansive rights where the public's interest might be harmed.

B. Campbell, Warhol, *and the Discrimination Against Comment in Favor of Parody*

As others have observed, the contemporary fair use doctrine tramples on the right of fair comment by treating parody more favorably than other

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Screenrant (Feb. 26, 2024), https://screenrant.com/sherlock-holmes-upcoming-movies-shows/ [https://perma.cc/ZN9D-BXLG]. Entry of the stories into the public domain was complicated by "definitional balancing" under the First Amendment, alongside noncompliance with the rule of the shorter term, compliance with the Uruguay Round Agreements relating to the World Trade Organization and with the Term Directive in the European Union, and passage of the Copyright Term Extension Act of 1998. *See, e.g.*, Golan v. Holder, 565 U.S. 302 (2012); Klinger v. Conan Doyle Est., Ltd., 755 F.3d 496 (7th Cir. 2014).

71. *See Playdate with Winnie the Pooh*, Disney Wiki, https://disney.fandom.com/wiki/Playdate_with_Winnie_the_Pooh [https://perma.cc/2J7V-EYKL]; Jaden Thompson, *'Mickey Mouse Clubhouse' to Be Revived, As Disney Junior Reveals New Slate Including Shows with Taye Diggs, Cynthia Erivo, More*, Variety (Aug. 18, 2023), https://variety.com/2023/tv/news/disney-junior-mickey-mouse-clubhouse-taye-diggs-cynthia-erivo-amber-riley-ariel-robogobo-1235699805/ [https://perma.cc/NZ7Y-CPKU]

72. *See Q2 '24 Earnings Presentation 6*, Walt Disney Co. (May 7, 2024), https://thewaltdisneycompany.com/app/uploads/2024/05/Q2_FY24_Earnings_Presentation.pdf [https://perma.cc/9Q7Q-324F]. Disney's streaming or direct-to-consumer business was $600 million more profitable in Q2 2024 than in Q2 2023, and new episodes of Playdate with Winnie the Pooh and The Mickey Mouse Club are debuting or being produced in 2024. *Id.*; *see also Playdate with Winnie the Pooh*, *supra* note 71.

73. Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 559 (1985).

74. Georgia v. Pub. Res. Org, Inc., 590 U.S. 255, 268–70, 273–75 (2020).

journalistic or artistic comment, including satire.[75] In *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, the Supreme Court endorsed a version of a necessity test for fair use that presents a contrast not only with the statute's legislative history, but also with First Amendment case law.[76] In holding that the Sixth Circuit "correctly suggested that 'no more was taken than necessary'" from the copyrighted song, and that the copying was not "excessive in relation to its parodic purpose," the Court parted ways with the legislative history's placing of "illustration" and parody on the same plane of fair use, and with its refusal to articulate any such necessity test in cases of illustration or parody.[77] The Court suggested that a parodic purpose involves a greater "claim" on fair use of protected expression than satire. But there is no requirement under First Amendment fair comment principles that a comment be parodic rather than serious or satirical, or that the person whose private life or reputation is misused in some way is the only possible vehicle for discussing a public issue or concern.[78] It is enough that the person is implicated in some public concern or legitimate public interest.[79]

There is no basis for limiting textual or video copying to only what is "no more than necessary," whether under the text, history, or First Amendment context of the fair use statute.[80] First, there is no reason stated why the

75. *See generally* Stacey L. Dogan & Mark A. Lemley, *Parody as Brand*, 105 Trademark Rep. 1177 (2015); Andrew Gilden & Timothy Greene, *Fair Use for the Rich and Fabulous?*, 80 U. Chi. L. Rev. Online 88 (2017), https://chicagounbound.uchicago.edu/cgi/viewcontent.cgi?referer=&httpsredir=1&article=1012&context=uclrev_online; Bruce P. Keller & Rebecca Tushnet, *Even More Parodic Than the Real Thing: Parody Lawsuits Revisited*, 94 Trademark Rep. 979 (2004); Mark A. Lemley & Rebecca Tushnet, *First Amendment Neglect in Supreme Court Intellectual Property Cases*, 2023 Sup. Ct. Rev. 85, 93 (2024); Ochoa, *supra* note 34 at 590; Geri Yanover, *The Dissing of Da Vinci: The Imaginary Case of* Leonardo v. Duchamp: *Moral Rights, Parody, and Fair Use*, 29 Val. U.L. Rev. 935 (1994).
76. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994).
77. *Id.* at 580–81, 589.
78. *See, e.g., supra* notes 25–28, 76–77 and accompanying text.
79. *See supra* notes 25–28, 76–77 and accompanying text.
80. *Compare Campbell*, 510 U.S. at 589 (despite finding the song in question to be a parody of another existing song, with real critical bearing on the original, the Court remanded the case for determination of whether taking from song was "excessive" or "'more … than necessary'") (internal citation omitted), *with* Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1273 (11th Cir. 2001) (rejecting copyright owner's attempt to confine fair use claimant to use only of that quantum of copyrightable material that is "necessary," because: "'[E]ven more extensive use [than necessary to conjure up the original] would still be fair use, provided the parody builds upon the original, using the original as a known element of modern culture and contributing something new for humorous effect or commentary.'") (brackets added in original) (quoting Elsmere Music, Inc. v. *Nat'l* Broad. Co., 623 F.2d 252, 253 n.1 (2d Cir. 1980)). For prior discussions of the necessity test, *see infra* notes 92 & 233. *But see* Shyamkrishna Balganesh & Peter S. Menell, *Going "Beyond" Mere Transformation:* Warhol *and Reconciliation of the Derivative Work Right and Fair Use*, Colum. J.L. & Arts 413, 424 (2024) (early legislative history

minimal amount factor must be predominant over the factor of purpose/character as comment. The fair use statute subjects comment to a multi-factor test, and lists comment as a prominent example of fair use along with others, like research, that Congress has identified as having the character of fairness, like comment.[81] Second, the statute places non-parodic comment and illustration on the same plane of fair use as parody, rather than listing parody separately, which might then means that parody has more "justification" than comment.[82] Third, the First Amendment would counsel in favor of granting, if anything, a greater leeway to those making serious social or political commentaries using copyrighted material than to those engaging in mockery or ridicule.[83] The critique of public officials may be closer to the heart of speech and press freedoms, and merely entertaining speech or expression may not be of the same "magnitude" of social interest.[84]

In *Andy Warhol Foundation for the Visual Arts v. Goldsmith (Warhol)*, the Court widened the gap between comment and parody when it comes to fair use.[85] The majority opinion in *Warhol* carries forward certain recent trends

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of fair use statute, in any event superseded by amendments in ensuing years [more than a decade, in fact] referred to fair uses as being *either* necessary or "incidental" to user's "legitimate purpose"). It should be noted that the early legislative history of fair use did not demand that the portion used be necessary for something that the user could not otherwise get across (an alternative means of expression test), but that exceptions to copyright in general should be necessary to advance a "public interest." *See id.*, at 422 ("For these reasons, *we believe* that the author's rights should be stated in broad terms and that the specific *limitations on them* should not go any further than is shown to be necessary in the public interest.") (emphasis added) (quoting *Copyright Law Revision: Hearings on H.R. 4347, H.R. 5680, H.R. 6831 and H.R. 6835 Before Subcomm. No. 3 of the H. Comm. on the Judiciary*, 89th Cong., 1st Sess. 13–14 (1966)).

81. *See, e.g.,* 17 U.S.C. § 107; *supra* note 25–28 and accompanying text.
82. 17 U.S.C. § 107. *See Campbell,* 510 U.S. at 580–81.
83. *Cf. supra* notes 12, 15, 19–21 and accompanying text.
84. Young v. Am. Mini Theatres, Inc., 427 U.S. 50, 61, 70–71 (1976); *but see id.* at 87 (Stewart, J., dissenting) ("The fact that the 'offensive' speech here may not address 'important' topics 'ideas of social and political significance,' in the Court's terminology, Ante, at 2447 does not mean that it is less worthy of constitutional protection. 'Wholly neutral futilities . . . come under the protection of free speech as fully as do Keats' poems or Donne's sermons.'") (quoting Winters v. New York, 333 U.S. 507, 528 (1948) (Frankfurter, J., dissenting)); *see also* Monitor Patriot Co. v. Roy, 401 U.S. 265, 272 (1971) (suggesting "fullest" application of First Amendment to political speech). *But see* Hurley v. Irish-Am. Gay, Lesbian and Bisexual Grp. of Bos., 515 U.S. 557, 569 (1995) (holiday parade could be protected speech); Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 970 (10th Cir. 1996) (entertaining merchandise in form of playing cards could be protected speech); Folsom v. Marsh, 9 F. Cas. 342, 347 (C.C.D. Mass. 1841) (No. 4,901) (diplomatic information quote); Comedy III Prods., Inc. v. Gary Saderup, Inc., 25 Cal. 4th 387 (2001) (entertaining merchandise containing celebrity likenesses could be protected speech).
85. Andy Warhol Found. for the Visual Arts v. Goldsmith, 598 U.S. 508 (2023); *see also* Lemley & Tushnet, *supra* note 75.

in decision-making at the Supreme Court. As others have noted, there is a "David and Goliath" quality to the ruling—photographer Lynn Goldsmith, breaking barriers as a woman in the male-dominated rock 'n' roll photography field and earning a modest living from selling photographs to magazines for around $400, was entitled to compensation from the celebrated New York-based pop artist Andy Warhol making an unauthorized tracing and silkscreen of her photograph of the rock star Prince and this being licensed by a foundation to Vanity Fair for $10,000.[86] The Court attempts to return fair use doctrine to what it sees as first principles, contrary to certain lower court rulings that supposedly overemphasized one aspect of one fair use factor.[87] This continues a trend of swatting away overly formalistic or innovative circuit court tests, some of the more notorious being "newsworthiness" in fair use, "likelihood of dilution," and "humorous" noninfringement in First Amendment trademark law (there are many other examples in the patent law area).[88]

One of the critical points in *Warhol* is the relationship between the fair use defense and the exclusive right of Goldsmith and other copyright holders to prepare "derivative works." As the Court explains, the Copyright Act contains a right to prepare derivative works, and defines derivatives to include transformations and adaptations.[89] Finding a fair use purpose or character of a work due to transformation "would narrow the copyright owner's exclusive right to create derivative works."[90] Therefore, to be favored under the defense of fair use, a new work must be extra transformative, not merely transformative

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86. Sarah Cascone, *In a Landmark Ruling Against the Andy Warhol Foundation, the Supreme Court Has Sided With Photographer Lynn Goldsmith*, Artnet (May 18, 2023), https://news.artnet.com/art-world/the-supreme-court-ruling-lynn-goldsmith-andy-warhol-foundation-2304684 [https://perma.cc/MBU2-2NYA].
87. *Warhol*, 598 U.S. at 541 (citing *Campbell*, 510 U.S. at 579 and Pierre Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1111 (1990)).
88. *See* Harper & Row Publishers, Inc. v. Nation Enters., 723 F.2d 195, 204–05 (2d Cir. 1983), *rev'd*, 471 U.S. 539; V Secret Catalogue, Inc. v. Moseley, 259 F.3d 464, 473 (6th Cir. 2001), *rev'd*, 537 U.S. 418 (2003); VIP Prods. LLC v. Jack Daniel's Props., 953 F.3d 1170, 1175 (9th Cir. 2020), *rev'd*, 143 S. Ct. 1578 (2023). For decisions overturning formalistic circuit tests in patent law, see Bilski v. Kappos, 561 U.S. 593 (2010) (overturning "machine-or-transformation" test for patentability); KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007) (overturning "teaching, suggestion, or motivation" test for non-obviousness); Graham v. John Deere Co., 383 U.S. 1 (1966) (overturning suggested combination test for obviousness, and reversing result in Calmar, Inc., v. Cook Chem. Co., 336 F.2d 110 (8th Cir. 1964)).
89. *Warhol*, 598 U.S. at 529–31 (citing 17 U.S.C. § 106(2); Authors Guild v. Google, Inc., 804 F.3d 202, 214 (2d Cir. 2015)); *see also Warhol*, 598 U.S. at 553–56 (Gorsuch, J., concurring) (suggesting that transforming a prior work into a new "aesthetic" would "risk making a nonsense of the statutory scheme—suggesting that transformative uses of originals belong to the copyright holder (under § 106) but that others may simultaneously claim those transformative uses for themselves (under § 107)") (citing 17 U.S.C. §§ 101, 106(2)).
90. *Id.* at 529.

(even though neither the word "transformative" nor the concept of parodic necessity appears in the text or the history of the fair use statute).[91]

The analysis should be turned on its head. Beginning with the premise that the derivative work right is subject to fair use, the first point would be that an overbroad conception of the derivative work right would wrongfully narrow fair use. By its nature, fair use overrides an exclusive right and should not be itself overridden.[92] Second, the more derivative a use is, the more fair that use may be—a use that engages with, builds upon, recasts, or transforms the original is likely to have a different purpose or character than the original, and to use only a portion of the original; moreover, a use that fails to manifest engagement or elaboration with the expression of the original, as opposed to its ideas, may simply be noninfringing.[93] Third, statute refers to the purpose and character of the use, without modifying said purpose and character with parodic, transformative, or non-derivative. Some of the purposes and characters listed in the preamble, like "research," could be said to be transformative in the way that parodies might be; but others are exploitative or consumptive,

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91. *See id.*

92. *See* Kirtsaeng v. John Wiley & Sons, Inc., 568 U.S. 519, 523 (2013) (exclusive rights set forth in section 106 of Copyright Act are "qualified, however, by the application of various limitations set forth in the next several sections of the Act, §§ 107 through 122. Those sections, typically entitled 'Limitations on exclusive rights….'"); *see also* Balganesh & Menell, *supra* note 80, at 413, 435 ("In its initial opinion [in *Warhol*], the Second Circuit mistakenly observed that 'there exists an entire class of secondary works that add 'new expression, meaning, or message' to their source material but are nonetheless specifically excluded from the scope of fair use: derivative works." This statement is obviously incorrect, since the fair use doctrine is made expressly applicable to all of the statute's exclusive rights, including the derivative work right.") (footnote omitted) (quoting Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 992 F.3d 99, 111 (2d Cir. 2021), *amended*, 11 F.4th 26, 39 (2d Cir. 2021)); Tushnet, *supra* note 1, at 551 ("[T]he derivative works right … is in obvious tension with transformative fair use because it prevents other people from adding creative content and meaning to copyrighted works without the owner's permission. As a result, many of copyright's critics propose a cutback in the right in order to ameliorate copyright's conflict with free speech and eliminate the possibility that the next [fair user] will lack the resources to litigate against the next [copyright proprietor].").

93. *See* H.R. Rep. No. 94-1476, at 62 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5675ff; Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994) (fair use protects those who use but alter an original work with "new expression, meaning or message"). Cases involving the use of art and photography make this point clear; for if the idea of the original was used, without recasting the expression in some way, fair use would be irrelevant. *Cf.* Seltzer v. Green Day, Inc., 725 F.3d 1170, 1177 (9th Cir. 2013) ("[A]n allegedly infringing work is typically viewed as transformative (and therefore "at the heart of … fair use") as long as new expressive content or message is apparent.") (parenthetical added); Cariou v. Prince, 714 F.3d 694, 711 (2d Cir. 2013); Bill Graham Archives v. Dorling Kindersley Ltd., 448 F.3d 605, 609 (2d Cir. 2006); Leibovitz v. Paramount Pictures Corp., 137 F.3d 109, 114–15 (2d Cir. 1998); Graham v. Prince, 265 F. Supp. 3d 366, 379–382 (S.D.N.Y. 2017). *See generally* Authors Guild v. Google, Inc., 804 F.3d 202 (2d Cir. 2015).

at times, such as news reporting and education.[94] All of them might invade a plausible licensing market, such as denying all requests for permission to reference the work in the news, in schools and universities, or in subsequent research or scholarship, absent payment of a high licensing fee. A news item on a popular new movie or song could present a plausible licensing opportunity, based on the model of celebrities licensing their wedding or baby photos to tabloids, generating payments to persons involved in newsworthy events for their interviews, and for serialization or life story rights.[95] Yet news reporting is given pride of place as a potential example of fair use and there is no requirement of analysis or critique.[96]

The dissenting opinion in *Warhol* effectively argues that denying new authors the ability to adapt, recast, or transform a prior work without written permission will chill the very creativity that copyright is intended to promote.[97] For dissenting Justice Elena Kagan and Chief Justice John Roberts, there is no tension between finding a work to be an infringing derivative yet favored under fair use as having a "purpose or character" that is akin to comment,

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94. *See* H.R. Rep. No. 94-1476, at 65–66 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5675ff. On consumptive news reporting on copyrighted works, see, for example, one might analogize consumptive journalistic or educational copying to the consumptive research and scholarly copying that was alleged in *Williams & Wilkins Co. v. United States*, 172 U.S.P.Q. (BNA) 670 (Ct. Cl. 1972), *rev'd*, 487 F.2d 1345 (Ct. Cl. 1973), *aff'd by an equally divided court*, 420 U.S. 376 (1975) (per curiam). The Supreme Court, by an equally divided number of justices, did not disturb the Court of Claims' ruling (as the predecessor to the Federal Circuit U.S. Court of Appeals) that widespread copying of medical and biophysical research articles was not necessarily an unfair use even though the journal publishers for the respective articles claimed that photocopying infringed upon a plausible derivative market relating to photocopied excerpts, such as copies of abstracts, conclusions, charts, and tables. *See id.*; *see also* Sag, *supra* note 27, at 58–59.

95. *See* Contreras and Fagundes, *infra* note 151; Thomas Kadri, *Drawing Trump Naked: Curbing the Right of Publicity to Protect Public Discourse*, 78 Md. L. Rev. 899, 901, 951–53 (2019).

96. *See* 17 U.S.C. § 107 (citing "use by reproduction in copies . . . , for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research," as potential fair use). Certain forms of news writing and education can certainly be transformative, but the legislative history indicates that newsworthy fair use may be performed in the manner of a summary, which *Harper & Row* branded exploitative (as articulating a similar message), 471 U.S. 539, 561-62, and that educational fair use may be in the form of trying to "illustrate a lesson," which seems more decorative or consumptive than critical or scholarly. H.R. Rep. No. 94-1476, at 65, 72–73 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5675ff.

97. *See* Andy Warhol Found. for the Visual Arts v. Goldsmith, 598 U.S. 508, 558–61 (2023) (Kagan, J., dissenting) (noting that "it is not just that the majority does not realize how much Warhol added; it is that the majority does not care" for it is willing to destroy the "'breathing space' for artists to use existing materials to make fundamentally new works, for the public's enjoyment and benefit" so that its opinion "hampers creative progress and undermines creative freedom").

criticism, research, or scholarship.[98] The derivative work right is not eliminated despite this approach because the amount and importance of material taken and any economic harm to the original author can outweigh the purpose factor.[99] Even more importantly, the derivative work right is "[s]ubject to" the fair use statute and other defenses/limitations.[100]

Thus, finding a fair use by Warhol and his successors would not conflict with the derivative work language. In other words, the courts might have balanced the amount used against Andy Warhol's purpose and the character of his art, and analyzed the impact on Goldsmith's foreseeable markets at the time that Warhol created the disputed artworks, before ruling for Goldsmith on the question presented (whether the unauthorized Prince art based on a Goldsmith photo was "transformative" under the fair use doctrine and whether the purpose and character of the use factor favored the Warhol Foundation). Balancing the third and fourth factors would prevent the recognition of some adaptive or transformative derivatives from ruining the derivative work right.

The legislative history of the Copyright Act further illustrates why allowing fair uses of some derivative works would be consistent with the statute.[101] Both the definition of a derivative work, and that of fair use, refer to a "portion of [the] . . . work" being used.[102] Unlike the majority opinion in *Warhol*, which defines fair use as necessarily excluding "plausible derivatives," the legislative history states that "no real definition" of fair use even exists.[103] Therefore, there was no suggestion in the legislative history that using a portion of a work should be disfavored because that might be a plausible derivative. Several of the examples of fair uses in the legislative history amount to a "recast[ing]" of the original work, and are therefore "plausible derivatives," including: "illustration or clarification of the author's observations" and "summary of an address or article, with brief quotations, in a news report."[104] Both of these examples are captured in a part of the fair use statute under "comment," "research," or "scholarship," so that criticism must not exhaust the world of fair uses.[105]

Nevertheless, the majority opinion in *Warhol* starkly contrasts comment and criticism, greatly disadvantaging commentary and research in comparison to "target[ing] an original work."[106] The *Warhol* dissent rightly castigates this major error, which could infect fair use doctrine to its core and diminish

98. *See id.* at 591.
99. *See id.* at 569 & n.5.
100. 17 U.S.C. § 107.
101. *See* H.R. Rep. No. 94-1476, at 65–66 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5675ff.
102. 17 U.S.C. §§ 101, 107.
103. H.R. Rep. No. 94-1476, at 72–73 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5675ff.
104. *Id.*
105. 17 U.S.C. § 107.
106. Andy Warhol Found. for the Visual Arts v. Goldsmith, 598 U.S. 508, 579–82 (2023) (Kagan, J., dissenting).

its vitality.[107] Parody rap songs and open-source software reimplementation of software interfaces are currently protected under fair use, depending on market impact and other considerations, despite their being offered for sale, in part because they can be considered "creative" and enlightening.[108] Nothing in the text of the fair use statute requires going beyond creative commentary to "target' the original" work for some kind of attack.[109]

The *Warhol* majority, like the *Campbell* case it applies, adopts a transformation-harm paradigm from a *Harvard Law Review* article by Judge Pierre Leval.[110] Judge Leval argued that the further removed the purposes of the user are from those of the original author, the more that excusing an unauthorized use will advance the aims of copyright law.[111] On the other hand, subsequent authors who share purposes or characteristics of their work with the original author's work threaten to divert income from him or her and to harm the mechanism with which copyright adds to knowledge via incentives.[112]

The central question under this approach is whether an interference with a "plausible derivative" is made by the subsequent author.[113] As Leval put it, any "reasonably substantial" loss of revenue due to the substitutionary effect of a use may negate its fairness.[114] Leval expanded on the proposal with a "significantly competing substitute" test.[115] Yet the word "significant," as pliable and overbroad as it is, is not in the statute as a measure of harm to the market for or value of a work.[116] It threatens to dictate decisions denying fair use whenever a merely trivial effect on the market for a work or on its value is likely.[117] Judge Leval's discussion of derivative substitution dealt with the fourth

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107. *Id*.
108. *Id.* (citing Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 581 (1994)); cf. *Warhol*, 598 U.S. at 550–51.
109. *Id.* at 580–81 (quoting *Warhol*, 598 U.S. at 547). *See also id*. at 530-32 & n. 7, 539-41 & nn. 15-16, 546 & n. 20, 548 (Opinion of the Court).
110. *See id.*; Pierre Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1111 (1990); *see also Campbell*, 510 U.S. at 580–82.
111. *See* Leval, *supra* note 110.
112. *See id*.
113. *Warhol*, 598 U.S. at 531 (quoting Authors Guild v. Google, Inc., 804 F.3d 202, 214 (2nd Cir. 2015) (Leval, J.))
114. *See* Leval, *supra* note 110, at 1125.
115. *Authors Guild*, 804 F.3d at 222.
116. *Cf.* U.S. v. Lopez, 514 U.S. 549, 616 (1995) (Breyer, J., joined by Stevens, Souter & Ginsburg JJ., dissenting) (observing that word "significant" is closer to "trivial," in context of a legal test designed to measure how much of an effect is required to pass the test, than is the "word 'substantial,'" as a "question of degree").
117. *See id.* A better approach, as Christina Bohannan explains, would be to clarify that "harm to the copyright owner (and liability) should be found where there is a substantial difference between the probability that a copyright owner would create the copyrighted work if the alleged infringer's use of the copyrighted work is permitted minus the probability that a copyright owner would create the work if the alleged infringer's use of the work is not permitted (i.e., is deemed an infringing use that requires payment)."

fair use factor. The *Warhol* dissent argues that the majority's use of impact on derivative markets to inform the first factor will lead to confusion between the first factor and the fourth factor, or respectively, confusion between the purpose and character of a work and the market effect. The most clarifying statement by the majority is that a significant effect on derivative markets may be associated with a purpose and character that is unfair (for being too close to that of the original work).[118]

The analysis by Judge Leval, mediated by its reception in *Campbell*, is about the sum total of the influence of legal scholarship on the majority opinion. As ignoring the First Amendment issue, this cramped view of legal scholarship negatively affected the Court's analysis,[119] as legal scholarship is rife with theories about the history and optimal development of fair use.[120]

Christina Bohannan, *Copyright Harm, Foreseeability, and Fair Use*, 85 WASH. U. L. REV. 969, 991 n.76 (2007). This harm of foreseeable exploitation is the legally relevant harm when framing a test for which sorts of creations should be outlawed for having an impermissible effect on the copyright purpose of incentivizing expressive labor.

118. Andy Warhol Found. for the Visual Arts v. Goldsmith, 598 U.S. 508, 529–32, 559–60 (2023) (opinion of the Court).

119. *See, e.g.*, Baker, *supra* note 34, at 905 & n.47 (arguing Court used a natural rights approach to copyright incentives in *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 545 (1985), to avoid an analysis of whether "the First Amendment restricts the government's power to recognize one party's (e.g., the libeled person or the copyright holder) private property in someone else's (e.g., the libeler or the purported copyright infringer) speech content."); Christina Bohannon, *Taming the Derivative Works Right: A Modest Proposal for Reducing Overbreadth and Vagueness in Copyright*, 12 VAND. J. ENT. & TECH. L. 669, 682 (2009) (observing, with respect to the fair use doctrine, that: "It is particularly problematic to rely on an affirmative defense to protect speech when the scope of the defense is vague."); *id.* at 685 (citing courts that declare that "the multi-factor test is vague and leads to unpredictability in fair use cases."); Lawrence Lessig, *Re-crafting a Public Domain*, 18 YALE J.L. & HUMANS. 56, 58, 61 (2006) (observing that "it takes a willed obliviousness not to see the First Amendment values implicated when we consider [copyright's chilling effects on] documentary films, or any film commenting upon matters of public import").

120. *See, e.g.*, Baker, *supra* note 34, at 893–94 (arguing that the First Amendment limits and supersedes the scope of constitutional powers of Congress and the executive branch, without abolishing those powers, reasoning: " . . . Congress cannot use the commerce power to forbid interstate commerce in books. Likewise, the First Amendment can reasonably be seen as limiting (although not eliminating) congressional power to grant exclusive rights to author's expressions."); Christina Bohannon, *Taming the Derivative Works Right: A Modest Proposal for Reducing Overbreadth and Vagueness in Copyright,* 12 VAND. J. ENT. & TECH. L. 669, 687 (2009) (arguing that the derivative work right language of the Copyright Act chills and deters building on the ideas or portions of existing works, and suggesting that the language is therefore unconstitutionally overbroad under the First Amendment); Jane C. Ginsburg, *Fair Use in the United States: Transformed, Deformed, Reformed?*, 2020 SING. J. LEGAL STUD. 265, 273 (suggesting that the Second Circuit was correct in *Cariou* to refuse to require an artist to prove that his art did not derive from its source material, explaining: "the Court's refusal to require artists to explain themselves is certainly compatible with the free speech

One theme from existing legal scholarship and postmodern art briefs is that fair use is vital to free speech.[121] This crucial theme, however, was not acknowledged by the majority opinion.

By excluding illustrative or summative *commentary* and other plausible derivatives from the scope of the first factor of the fair use doctrine, the majority opinion may confine fair use to a very minor domain, because it did not want to "narrow" the derivative or adaptation right.[122] A first fair use factor with a wide scope ensures a "'breathing space' for artists to use existing materials to make fundamentally new works, for the public's enjoyment and benefit."[123] Courts formerly utilized the first factor to outweigh aspects of the new work that might otherwise negate finding fair use, such as use of the entire work or use of the "heart" of the work such as a song's guitar riffs or melodies.[124] The majority's near-categorical exclusion of possible "derivatives" may basically negate the purpose/character factor's impact in cases of comment without criticism, or decisive consideration of amount added versus used from the original work.[125]

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goals that fair use furthers. Artists are not art critics—no more than judges are—and the copyright law should let their works speak for themselves.") (footnotes omitted); Lawrence Lessig, *Re-crafting a Public Domain*, 18 YALE J.L. & HUMANS. 56, 58, 61 (2006) (observing that because the cost of licensing quoted materials may be prohibitive, "a domain of 'fair use' is important; that one be able to identify that domain without risking extraordinarily punitive damages, or spending significant resources on legal advice, is essential"); Rebecca Tushnet, *Mix and Match, in* THE ROUTLEDGE COMPANION TO MEDIA EDUCATION, COPYRIGHT, AND FAIR USE 22 (2018), (suggesting that a strict requirement of transformation of "purpose" might stifle creative or instructive speech by others, but arguing that transformation of "content" is a factor considered by courts in finding fair use even where a purpose may be shared with the original author); *see also* Leval, *supra* note 110, at 1109, 1132 (arguing that free speech in nonfiction writing, literary criticism, scholarship, and journalism require leeway to use copyrighted works because "all intellectual creative activity is in part derivative.").

121. *See* Baker, *supra* note 34, at 893–94; Ochoa, *supra* note 34, at 568, 590, 616–19.

122. *See Warhol,* 598 U.S. at 578 (Kagan, J., joined by Roberts, C.J., dissenting); *id.* at 528–30 (opinion for the Court).

123. *Id.* at 560 (Kagan, J., joined by Roberts, C.J., dissenting).

124. *Cf.* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 589 (1994) (remanding for assessment of whether copying of bass riff was excessive even in a parody); Abilene Music, Inc. v. Sony Music Entm't., Inc., 320 F. Supp. 2d 84, 91–92 (S.D.N.Y. 2003) (making similar suggestion as to overuse of melody even in parody); Elsmere Music, Inc. v. Nat'l Broad. Co., Inc., 482 F. Supp. 741, 747 (S.D.N.Y. 1980) (where use of melody in parody alleged to be excessive, court emphasized that "repetition furthered the overall satirical effect" and was sung for only 18 seconds, which was just about what was necessary to conjure up song for parody), *aff'd*, 623 F.2d 252 (2d Cir. 1980) (affirming on district court opinion).

125. *See Warhol*, 598 U.S. at 578, 591 ("[T]he preamble . . . gives examples of uses often thought fair: 'criticism, comment, news reporting, teaching[,] . . . scholarship, or research.' § 107. As we have explained, an emphasis on commercialism would 'swallow' those uses—that is, would mostly deprive them of fair-use protection. . . . [¶] [According to] the

The dissent in *Warhol* recalls an earlier discussion of research and scholarship, which unlike the deficient analysis in Warhol, situated research and scholarship within the tradition of First Amendment protections, exemplified by *Sullivan*.[126] Building on *Harper & Row*, courts ruled that even liberally quoting unpublished letters could result in a copyright ban on a biography.[127] In an effective concurring opinion to one of these cases, a circuit court judge explained why scholarly or public-interested works may be valuable news reporting, First Amendment expression, and commentary on the events involving public figures.[128] The dissent in *Harper & Row* had predicted this problem; the dissenting justices had long extensive experience in First Amendment adjudication, unlike some members of the majority, and pointed to the ease with which copyrights could be abused.[129]

The *Warhol* dissent takes a minimalistic approach, phrasing the issue unduly narrowly. It avoids exploring the historical and doctrinal interconnections between the freedom of speech and fair use, including the right to include published content in one's own expression of a new message or comment. The First Amendment right to make art of a postmodern or even simply a "pop art" variety is not discussed in the dissenting opinion.[130] Even the legislative

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majority's view, an artist had best not attempt to market even a transformative follow-on work—one that adds significant new expression, meaning, or message. That added value (unless it comes from critiquing the original) will no longer receive credit under factor 1. And so it can never hope to outweigh factor 4's assessment of the copyright holder's [economic] interests.").

126. *See also* Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 582 (1985) (Brennan, J., dissenting) ("Were an author able to prevent subsequent authors from using concepts, ideas, or facts contained in his or her work, the creative process would wither …."). *Compare Warhol*, 598 U.S. at 579–83 (Kagan, J., dissenting), *with* New Era Publ'ns Int'l, ApS v. Carol Publ'g Grp., 904 F.2d 152 (2d Cir. 1990).

127. *See, e.g.*, *New Era Publ'ns Int'l, ApS*, 904 F.2d, *superseded in part by statute,* 17 U.S.C. § 107; New Era Publ'ns Int'l, ApS v. Henry Holt & Co., 873 F.2d 576 (2d Cir. 1989), *superseded in part by statute*, 17 U.S.C. § 107; Salinger v. Random House, Inc., 811 F.2d 90 (2d Cir. 1987), *cert. denied*, 484 U.S. 890 (1987), *superseded in part by statute*, 17 U.S.C. § 107.

128. *Henry Holt*, 873 F.2d at 585, 590 (Oakes, J., concurring) (citing Meeropol v. Nizer, 417 F. Supp. 1201, 1206 (S.D.N.Y. 1976)).

129. *See Harper & Row*, 471 U.S. at 541 (opinion of O'Connor, J.). Justice Sandra Day O'Connor had only been appointed to the Court a few years before, after serving two years on Arizona Court of Appeals and four years on an Arizona trial court. Appointment of Justice O'Connor, 453 U.S. xi, xii (1981); *Biography of Associate Justice Sandra Day O'Connor*, Supreme Court of the United States, https://www.supremecourt.gov/about/biographyOConnor.aspx [https://perma.cc/Z44E-9JTG]. Justice Brennan had been on the Court since the 1950s, and Marshall and White since the 1960s, when the First Amendment was reborn.

130. *See generally* Amy Adler, *Fair Use and the Future of Art*, 91 N.Y.U. L. Rev. 559, 614–16 (2016). *See also* Neil Weinstock Netanel. *Making Sense of Fair Use,* 15 Lewis & Clark L. Rev. 715, 771 (2011) (suggesting that collages, mashups, and other works that share a general expressive purpose but "build a very different expressive product should be

history, which contains important discussions on the scope of fair use and the derivative right, makes no appearance in the dissent. The dissent invites readers to review the precedents and read the text differently from the majority, but fails to open a destabilizing inquiry into these precedents' contemporary implications.[131]

Justices Gorsuch and Jackson wrote a concurrence in *Warhol* to point out that the first fair use factor might favor a similar use to that made by Warhol's successors in an appropriate case involving less commerce and more public benefit, such as an exhibition in an art museum that is run otherwise than for profit.[132] The majority seemed unwilling even to state that a nonprofit museum exhibition or a critical book review necessarily benefits from the first factor, seemingly because certain nonprofit exhibitions or quotation of book passages might satisfy consumer demand for part of a photograph or book and therefore lose the benefit of the first factor.[133]

The *Warhol* majority falls short in offering guidance on a number of important topics. It concedes that when a creator uses only a tiny portion of what came before or hides whatever is created in the classroom or private quarters, the "plausible derivatives" test may support a fair use under the first factor.[134] It approvingly cites cases stating that reproducing a photograph that is "the story" unaltered alongside a news article could be a fair purpose, as could altering a photograph for parodic effect.[135] It reaffirms a decision from 2021 that it could be a fair purpose to make use of "primarily functional" computer software elements to create a new programming "environment" with "shared interfaces" and the ability to attract programmers from earlier coding environments.[136] It even analyzes Warhol's *Campbell Soup Cans* from 1962 (part of a series continuing through at least 1969) as having a purpose and character consistent with a fair use because advertisements have a different purpose and the series "target[ed]" the ads, presumably for being "ordinary."[137] Finally, the majority declares—with no precedential or theoretical support—that film adaptations are unfair uses.[138] (The Court ruled in 1911 that a film could be

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able to qualify as fair use").

131. *See* Andy Warhol Found. for the Visual Arts v. Goldsmith, 598 U.S. 508, 559 (2023) (Kagan, J., joined by Roberts, C.J., dissenting).
132. *See Warhol*, 598 U.S. at 557 (Gorsuch, J., joined by Brown Jackson, J., concurring).
133. *See id.* at 528 n.4 (opinion for the Court).
134. *Id.* at 531.
135. *Id.* at 529 n.5 (citing Nunez v. Caribbean Int'l News Corp., 235 F.3d 18, 21–23 (1st Cir. 2000)).
136. *Id.* at 533 n.8 (citing Google LLC v. Oracle Am., Inc., 593 U.S. 1, 29 (2021)).
137. *Id.* at 539; *see also* Blake Gopnik, *How Andy Warhol Came to Paint Campbell's Soup Cans*, Smithsonian Mag., (May 2020), https://www.smithsonianmag.com/arts-culture/andy-warhol-campbell-soup-cans-180974600/ [https://perma.cc/GL7Q-QKT4].
138. *See Warhol*, 598 U.S. at 543.

an infringing dramatization of a book under the copyright act of 1891, but fair use did not come up, and had not even been codified yet in its present form.[139])

Taking the *Warhol* majority opinion at face value, there can be little clarity as to whether any given work is a fair use or even has a fair "purpose and character."[140] As noted above, even book reviews are now at risk even though they were one of the first types of fair uses recognized, alongside abridgments.[141] Thus, there is scant assurance as an author that a meager book advance or expectation of royalties will not disappear into a sink of potential damages liability after an unexpectedly harsh fair use ruling. One might say that this problem exists with all affirmative defenses, but fair use is textually defined as a limitation on exclusive rights, rather than as a disfavored or problematic defense.[142]

The *Warhol* dissent argues that despite the guidance provided, the majority's emphasis on an authors' commercial aims will leave subsequent authors and musicians in a very uncertain position as to quoting others' original work.[143] Were Warhol's series of Marilyn Monroe paintings and screenprints all infringements? The *Warhol* dissent is unsure, although the majority notes that Warhol paid to license the photographic source material of some of his works, so the scope and term of said licenses might be important.[144] How could future artists or musicians possibly rely on fair use if even an "avatar" of a bracing and revolutionary form of recontextualizing art worthy of museum exhibition and inclusion in art history's pantheon, had no legal justification for (at least some of) his works?[145] No matter, say the *Warhol* majority and the concurrence: a narrow question was asked, and answered.[146]

C. Jack Daniels, Elster, *and Why Denigrating Comment Leads to Unconstitutional Viewpoint Suppression*

In *Jack Daniel's Properties v. VIP Products, Inc.*, the Supreme Court rejected First Amendment defenses for humorous, parodic, or message-bearing trademarks that identify the source or sponsorship of goods or services (see Figure 1).[147] The Court concluded that there is a substantial government interest in protecting trademarks and trade names, and the likelihood-of-confusion

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139. *See* Kalem Co. v. Harper Bros., 222 U.S. 55 (1911).
140. See *Warhol*, 598 U.S. at 509–10.
141. *See* Story v. Holcombe, 23 F. Cas. 171, 176–78 (C.C.D. Ohio 1847) (No. 13,497).
142. *See* Lydia Pallas Loran, *Fair Use: An Affirmative Defense*, 90 Wash. L. Rev. 685, 698 (2015); Ned Snow, *Who Decides Fair Use—Judge or Jury?*, 94 Wash. L. Rev. 275, 292–93, n. 128 (2019); Hannibal Travis, *Google Book Search and Fair Use: iTunes for Authors, or Napster for Books?*, 61 U. Miami L. Rev. 87, 145–151 (2006).
143. *See Warhol*, 598 U.S. at 560 (Kagan, J., joined by Roberts, C.J., dissenting).
144. *See id.* at 534 (opinion for the Court).
145. *Id.* at 561 (Kagan, J., joined by Roberts, C.J., dissenting).
146. *Id.* at 534 (opinion for the Court).
147. Jack Daniel's Props., Inc. v. VIP Prods. LLC, 599 U.S. 140, 157–61 (2023).

text under the Lanham Act adequately tailors that protection to the interest served.[148] No further tailoring would be necessary to ensure that trademark rights do not trample others' First Amendment interests.[149] To expand the First Amendment beyond that would be "special" pleading, the Court suggested.[150] The Court distinguished that the *Rogers* test protects artistically or culturally relevant references to trademarks, even if inadvertently or ambiguously misleading, as in the content of paintings, films, and video games, but the Court rejected its application to a misleading product name.[151]

Figure 1. Humorous Comment in *Jack Daniel's*

The opinion involves very little analysis of the First Amendment issues, other than some reference to an effective parody being unlikely to be found to be a trademark infringement due to the common social presumption that

148. *See id.*
149. *See id.*
150. *Id.* at 145–46.
151. *See id.* at 148–63. The Ninth Circuit would have remanded for more findings under the *Rogers* test for aesthetic relevance and clearly misleading use. *See id.* at 150–52. *See generally* ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915 (6th Cir. 2003); Univ. of Ala. Bd. Of Trs. v. New Life Art Inc., 677 F. Supp. 2d 1238 (N.D. Ala. 2009) (cases discussing paintings of persons or entities whose names or logos, color schemes, or trade dress may be trademarked, on canvas or in video games); Jorge L. Contreras & Dave Fagundes, *The Life Story Rights Puzzle*, 14 HARV. J. SPORTS & ENT. L. 153 (2023) (discussing First Amendment doctrine of *Rogers* in connection with biopic films); Kristin Kuraishi, *From the Golden Gate to London: Bridging the Gap Between Data Privacy and the Right of Publicity*, 46 BROOK. J. INT'L L. 733, 743–45 (2020) (explaining that New York right of publicity cannot control use of personalities, fashion styles, satirical references, jokes about persons, etc., in television commercials or video games).

self-mockery is rare.[152] The presumption, as embodied into a classic quote from Somerset Maugham and the "need to 'conjure up'" test for parody fair use in the Ninth Circuit, made its way into *Campbell* as an explanation of why parody might have a greater claim to fair use than praise, satire, or mere commentary.[153] To the extent that the opinion attempts to distinguish cases upholding First Amendment defenses in trademark cases, it does not do so particularly effectively. One issue is whether the widely followed precedent in the *Ginger & Fred* case (*Rogers*) involved an identification of the source of the motion picture, or only a message or point of view contained within the motion picture.[154] The Court seems to suggest that, unlike VIP Products' use, *Rogers* did not involve a source-identifying use, but such titles are how motion pictures are commonly marketed and branded, with director or studio names likely being an afterthought to many theater goers or videotape renters.[155] Similarly, the Court cites an appellate decision on a painting of the uniformed University of Alabama football team, but fails to mention that the lower court reaffirmed that the use of registered marks in the titles of paintings is protected by the First Amendment.[156]

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152. *See* Andy Warhol Found. for the Visual Arts v. Goldsmith, 598 U.S. 508, 546–61 (2023).
153. *See id.* at 542; Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 592 (1994) (citing Fisher v. Dees, 794 F.2d 432, 437–38 (9th Cir. 1986); W. Somerset Maugham, Of Human Bondage 241 (Penguin ed. 1982)); *see also* Berlin v. E.C. Pubs., Inc., 329 F.2d 541, 544–45 (2d Cir. 1964) (in a decision "roundly criticized by many commentators," a district court held, and the Ninth Circuit affirmed, that: while a "parodist must be permitted sufficient latitude to cause his reader or viewer to 'recall or conjure up' the original work if the parody is to be successful," in the case at bar, "this license [or latitude] had been grossly exceeded") (citing Loew's, Inc. v. Columbia Broad. Sys., 131 F. Supp. 165 (S.D. Cal. 1955), *aff'd sub nom.* Benny v. Loew's, Inc., 239 F.2d 532 (9th Cir. 1956), *aff'd by an equally divided court*, 356 U.S. 43 (1958); Columbia Pictures Corp. v. Nat'l Broad. Co., 137 F. Supp. 348 (S.D. Cal. 1955)); *cf.* MCA, Inc. v. Wilson, 677 F.2d 180, 185 (2d Cir. 1981) ("[I] f the copyrighted song is not at least in part an object of the parody, there is no need to conjure it up.") (citing Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 758 n.15 (9th Cir. 1978)); Ochoa, *supra* note 34.
154. *See Jack Daniel's*, 599 U.S. at 140–42, 150–63.
155. *Compare id.*, *with* Finola Kerrigan, Film Marketing (2d ed. 2017) 48–49, 94, 131–33, 187 and Robert Marich, Marketing to Moviegoers 55 (S. Ill. Univ. Press 2013) (citing, for example, *Hellboy* (2004), *Pokemon: The First Movie* (1999), *Watchmen* (2009), and analyzing film posters and marketing studies to emphasize title usage). Consider, for example, the importance of including the name of a series in the title of a film such as *Star Trek: Into Darkness* or *Avengers: Age of Ultron*.
156. *See* Univ. of Ala. Bd. of Trs. v. New Life Art Inc., 677 F. Supp. 2d 1238, 1253 (N.D. Ala. 2009) (summarizing how in *N.Y. Racing Ass'n v. Perlmutter Publ'g, Inc.,* No. 95-CV-994, 1996 WL 465298 at *4 (N.D.N.Y. July 19, 1996), the court referred to "the use of a registered mark on the title of a painting [as] protected by the First Amendment"), *aff'd in part, rev'd in part*, 683 F.3d 1266, 1276–79 (11th Cir. 2012) (holding that depiction of plaintiff's trademarks in defendant's artistic paintings, where the artist's name was disclosed, and paintings were not suggested to have been sponsored or endorsed by plaintiff, were protected by First Amendment) (citing ESS Ent. 2000, Inc. v. Rock Star

As the Electronic Frontier Foundation described in its amicus brief, the position of plaintiff Jack Daniel's Properties, which the Supreme Court essentially adopted, overlooks several important First Amendment considerations. [157] First, free speech principles should apply with at least some force to advertising and other commercial speech.[158] Second, the Electronic Frontier Foundation urges that, in the wake of the Court's two recent encounters with the Lanham Act, the anti-parody, anti-humor impact of the federal law should have been assessed, because Jack Daniel's was not the first plaintiff to threaten a parody product, magazine spread, or motion picture reference.[159] In these two cases, the Court intervened on the question of whether viewpoint discrimination was taking place that could be made less restrictive on speech and the press.[160] *Matal v. Tam* and *Iancu v. Brunetti* characterize the denial of a trademark as suppression of one's speech, because it abridges one's ability to claim a brand name and own a trademark; yet that is precisely what the ruling of *Jack Daniel's* does to those who might desire to parody a brand without operating completely non-commercially, and becoming a charity of some kind.[161]

Videos, Inc., 547 F.3d 1095, 1096–1101 (9th Cir. 2008); *ETW Corp*., 332 F.3d at 918–19; Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, 886 F.2d 490 (2d Cir. 1989); Rogers v. Grimaldi, 875 F.2d 994, 999–1000 (2d Cir. 1989)); *see also* N.Y Racing Ass'n v. Perlmutter Publ'g, Inc., 959 F. Supp. 578 (N.D.N.Y. 1997) (holding that use in title of paintings, reproduced on t-shirts, of trademarks such as SARATOGA or SARATOGA RACE COURSE was protected under First Amendment as matter of artistic freedom).

157. *See generally* Brief for Elec. Frontier Found. as Amicus Curiae Supporting Respondent, *Jack Daniel's*, 599 U.S. 140 (2023) (No. 22-148).

158. *See id.* at 4, 17–18 (citing Hustler Magazine v. Falwell, 485 U.S. 46, 56 (1988); N.Y. Times v. Sullivan, 376 U.S. 254, 280–81 (1964)); Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, 425 U.S. 748 (1976); *see also* Brief for Found. for Individual Rts. And Expression as Amicus Curiae Supporting Respondent, *Jack Daniel's*, 599 U.S. 140 (2023) (No. 22-148) (arguing that outcome successfully proposed by Jack Daniel's Properties as petitioner for certiorari would be adverse to freedom of expression, including in cases in which public universities might censor faculty and student speech containing university trademarks for identification or affiliation purposes).

159. Warner Bros. v. American Broad. Cos., 654 F.2d 204, 211 (2d Cir. 1981); L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 29 (1st Cir. 1987); Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 967 (10th Cir. 1996); Louis Vuitton Malletier, S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 256 (4th Cir. 2007).

160. *See* Brief for Elec. Frontier Found. as Amicus Curiae Supporting Respondent at 3, *Jack Daniel's*, 599 U.S. 140 (2023) (No. 22-148), https://www.supremecourt.gov/DocketPDF/22/22-148/255380/20230227140513430_Amicus%20Brief.pdf [https://perma.cc/2ERA-5623] (citing Matal v. Tam, 582 U.S. 218, 233–34 (2017)).

161. *See, e.g.*, Iancu v. Brunetti, 588 U.S. 388, 393 (2019) (denying trademark registration to an offensive or disparaging brand name would violate the "bedrock First Amendment principle" that the government cannot discriminate against ideas that offend) (cleaned up); *Tam*, 582 U.S. at 247 ("If affixing the commercial label permits the suppression of any speech that may lead to political or social 'volatility,' free speech would be endangered."); *cf.* Cariou v. Prince, 714 F.3d 694, 707–09 (2d Cir. 2013), *cert. denied*, 571 U.S. 1018 (2013).

The cost of defending the nearly inevitable lawsuit from a target of a commercial-speech parody of a trademark might well bankrupt many entities.[162] Third, the Electronic Frontier Foundation explains that other commercial speech obtains a significantly greater degree of protection than the *Rogers* test (aesthetic relevance/explicit misleadingness) guarantees, due to the occasional application of strict scrutiny analysis to commercial speech that does not use a trademark.[163]

The Court in *Jack Daniels* unjustly ignored the principle that "speech does not lose its First Amendment protection because money is spent to project it, as in a paid advertisement of one form or another."[164] While the name of a commodity is not the same as an advertisement, this distinction is elusive in practice. For example, most advertisements focus on the commodity's name or a trade name, and some contain little material other than such a name. By the same token, is there a large difference between the physical tag on a stuffed animal, such as those displayed on racks of Ty, Inc., toys in Walgreens, and advertisements on Amazon or Shopify? For the consumer, there is a degree of interchangeability between online advertising and point-of-sale advertising attached to the product.[165]

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162. *See* Brief for Elec. Frontier Found. as Amicus Curiae Supporting Respondent at 18–23, *Jack Daniel's*, 599 U.S. 140 (2023) (No. 22-148), https://www.supremecourt.gov/DocketPDF/22/22-148/255380/20230227140513430_Amicus%20Brief.pdf [https://perma.cc/2ERA-5623]; *Tam*, 582 U.S. 218.

163. *See* Brief for Elec. Frontier Found. as Amicus Curiae Supporting Respondent at 17, *Jack Daniel's*, 599 U.S. 140 (2023) (No. 22-148), https://www.supremecourt.gov/DocketPDF/22/22-148/255380/20230227140513430_Amicus%20Brief.pdf [https://perma.cc/2ERA-5623] (citing Reed v. Town of Gilbert, 576 U.S. 155, 169 (2015)); Sorrell v. IMS Health, Inc., 564 U.S. 552, 563–65 (2011); Members of the City Council of L.A. v. Taxpayers for Vincent, 466 U.S. 789, 804 (1984); Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd., 502 U.S. 105, 115 (1991)); *see also* Camp Hill Borough Republican Ass'n v. Borough of Camp Hill, 101 F.4th 266, 269 (3d Cir. 2024); Interpipe Contracting, Inc. v. Becerra, 898 F.3d 879, 899 (9th Cir. 2018); Norton v. City of Springfield, 806 F.3d 411, 412 (7th Cir. 2015). For example, laws banning both commercial and political messages on physical signs other than those identifying the business done on the property hosting the sign often fail strict scrutiny as being content-based. *See Reed*, 576 U.S. at 155–57; Snyder v. Phelps, 562 U.S. 443, 456 (2011); Adam Winkler, *Fatal in Theory and Strict in Fact: An Empirical Analysis of Strict Scrutiny in the Federal Courts*, 59 Vand. L. Rev 793, 851–52 (2006) (collecting cases). Another example relevant to the Electronic Frontier Foundation's point involves laws against intentionally making false accusations against government officials, which have been struck down using strict scrutiny. *See id.* (citing Eakins v. Nevada, 219 F. Supp. 2d 1113, 1121 (D. Nev. 2002); Hamilton v. City of San Bernardino, 107 F. Supp. 2d 1239, 1248 (C.D. Cal. 2000)); *see also Snyder*, 562 U.S. at 448, 453–55; *id*. at 468 (Alito, J., dissenting) (concerning an arguable false statement about military officer); Chaker v. Crogan, 428 F.3d 1215 (9th Cir. 2005), *cert. denied. sub nom*. Crogan v. Chaker, 547 U.S. 1128 (2006).

164. City of Cincinnati v. Discovery Network, Inc., 507 U.S. 410, 420 (1993); *see also* N.Y. Times v. Sullivan, 376 U.S. 254, 266 (1964).

165. *Cf. Point-of-sale, Point-of-purchase Display, in* Encyclopedia of Sports Management

Some might object that the Lanham Act is not directed to suppressing a specific kind of speech. The nostrum that a law of general applicability (one that addresses a broad problem such as injury or breach of promise, and not caused by a particular viewpoint's expression or speaker's content) does not violate the First Amendment has a long pedigree.[166] A lingering question is why that rule applies differently to inventing an association between oneself and a trademark, blurring a trademark's distinctive quality, or negatively portraying a trademark. The protection in reducing search costs with trademarks should not be considered a categorically weaker interest in comparison to other First Amendment considerations.

It remains possible that both *Warhol* and *Jack Daniel's* will be resolved in further proceedings in ways that preserve the right of fair comment, but leeway for comment may be based on noninfringement rather than fair use or First Amendment doctrine. In *Warhol*, the concurring opinion of Justices Gorsuch and Jackson suggests that the idea-expression distinction, which helps conform copyright law to the First Amendment according to *Harper & Row*, might render the typical Warhol-style work noninfringing as primarily a taking of the unprotectable physical features of a celebrity, as opposed to the lighting and lens choice reflecting photographic expression.[167] In *Jack Daniel's*, there is

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and Marketing 4, at 1140 (Linda E. Swayne & Mark Dodds eds., 2011) (noting that although many consumers make purchases due to research at home or prior to entering stores, point-of-sale displays of products encourage and increase sales that may not have been planned).

166. Associated Press v. Nat'l Lab. Rels. Bd., 301 U.S. 103, 132–33 (1937); *see, e.g.*, Giboney v. Empire Storage & Ice Co., 336 U.S. 490, 497 (1949).

167. *See* Andy Warhol Found. for the Visual Arts v. Goldsmith, 598 U.S. 508, 557 (2023) (Gorsuch, J., joined by Jackson, J., concurring) ("The Court today does not even decide whether the Foundation's image of Prince infringes on Ms. Goldsmith's copyright. . . . [A] court must find the defendant copied elements of the plaintiff's work that are themselves original"); *id.* ("[E]ven when two works are substantially similar, if both the plaintiff's and the defendant's works copy from a third source (reworking, say, a traditional artistic or literary theme), a claim for infringement generally will not succeed. In this case, we address none of these questions or other elements of the infringement standard designed to ensure room for later artists to build on the work of their predecessors.") (citation omitted). For precedents suggesting that elements of an image taken from the features of the underlying subject, which may be either human or nonhuman, were such a "third source" rendering similarities resulting from them insufficiently original, there is, for example, the television docudrama and digital model case law. *See* Harney v. Sony Pictures Television, Inc., 704 F.3d 173, 181, 189 n.8 (1st Cir. 2013) (noting that the positioning of a young girl on a man's shoulders in a father-daughter scene; the posture, age, and hair color of the young girl; the age of the man; and, although the court does not mention it, the fact he was dressed in a suit intended to be juxtaposed with father's being wanted for abduction or homicide, and accordingly were unprotected elements under copyright law as being facts and elements "ineluctably and inextricably intertwined with the idea of producing a realistic depiction" of subject matter) (quoting Coquico, Inc. v. Rodríguez-Miranda, 562 F.3d 62, 68 (1st Cir. 2009)); Mattel, Inc. v. MGA Ent., Inc., 616 F.3d 904, 914–16 (9th Cir. 2010) (finding that not only features of sketches that bore

a prominent citation to a similar case finding chewable dog toys making fun of fashion brands to be noninfringing under the internal principles of trademark law that help protect speech, such as the reasonable consumer standard for infringement, the parody and news exclusions from dilution, and the fair and nominative use doctrines in infringement and dilution.[168] A fair comment principle might operate in part by recognizing a reduced likelihood of confusion, often reduced to the point of a defense victory, where a commentary (such as a parody) distinguishes itself from the original source.[169] In other words, no reasonably prudent consumer would be confused by a comment.[170] Artists

"resemblance or similarity to human form and human physiology" were unprotectable, but also unprotectable were those features that displayed a "synergistic[ally] . . . unique style" or "attitude" with respect to the characters or dolls portrayed); Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc., 528 F.3d 1258, 1268 (10th Cir. 2008) (noting that features from a digitally created model that accurately portrays real world things are not protectable elements for copyright purposes).

168. *Cf.* Jack Daniel's Props., Inc. v. VIP Prods. LLC, 599 U.S. 140, 159–62 (2023) (apparently referring to likelihood of confusion factors such as consumer sophistication, mark usage differences, and good or bad faith to indicate that parodies may not infringe the marks they target); Louis Vuitton Malletier, S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252 (4th Cir. 2007); *see also* 15 U.S.C. § 1115(b)(4) (fair use); 15 U.S.C. § 1125(c)(4)(B) (news, comparative advertising, noncommercial use); 141 Cong. Rec. 38554–59 (1995) (parody, satire, and editorializing are noncommercial for purposes of 5 U.S.C. § 1125(c)(4)(B)); Lockheed Martin Corp. v. Network Solutions, Inc., 985 F. Supp. 949, 957 (C.D. Cal. 1997) (nominative use defense) (collecting cases); Volkswagenwerk Aktiengesellschaft v. Church, 411 F.2d 350, 352 (9th Cir. 1969); ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 920 (6th Cir. 2003); *cf.* Mark Bartholomew & John Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*, 81 Geo. Wash. L. Rev. 1, 81–82 (2013) (referring to nominative fair use, a judge-made defense applicable to those who describe themselves or their speech, product, or service using the trademark of another as a noun or adjective, as being drawn from trademark harm analysis rather than First Amendment principles).

169. *See, e.g.*, *Jack Daniel's*, 599 U.S. at 161 (under *Haute Diggity Dog* standard, an "expressive message—particularly a parodic one, as VIP asserts—may properly figure in assessing the likelihood of confusion"); *Haute Diggity Dog*, 507 F.3d at 259–63 (citing a non-parody case, Lamparello v. Falwell, 420 F.3d 309, 316 (4th Cir. 2005), for the proposition that markets may differ between defendant who "sufficiently distinguished its own product" and the plaintiff's trademarked product referenced by the defendant); *see also, e.g.*, Univ. of Ala. Bd. of Trs. v. New Life Art Inc., 677 F. Supp. 2d 1238, 1253 (N.D. Ala. 2009); Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, 414, 418 (S.D.N.Y. 2002) (noting, as in many other parody cases, "products in fact do not compete, and they occupy distinct, non-over-lapping markets," and that "[c]ases finding that First Amendment interests prevail involve nontrademark uses of mark—that is, where the trademark is not being used to indicate the source or origin of consumer products, but rather is being used only to comment upon and, in the case of parody, to ridicule, the trademark owner") (citing Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g, 886 F.2d 490, 494 (2d Cir. 1989); Charles Atlas, Ltd., v. DC Comics, Inc., 112 F. Supp. 2d 330 (S.D.N.Y. 2000); Yankee Publ'g Inc. v. News Am. Publ'g Inc., 809 F. Supp. 267 (S.D.N.Y. 1992)).

170. *Cf.* Bally Total Fitness Holding Corp. v. Faber, 29 F. Supp. 2d 1161 (C.D. Cal. 1998)

and their advocates might find a split decision or noninfringement finding on remand to be reassuring, but a risk of protracted litigation for all artists and parody product makers would remain.

A recent oral argument addressing the First Amendment right to comment is *Vidal v. Elster*.[171] In that case, a disappointed trademark applicant for the mark TRUMP TOO SMALL for t-shirt marketing (a satirical reference to a challenged the Lanham Act's "names clause" as a form of viewpoint-discrimination under the First Amendment.[172] Addressing the argument that the denial suppressed Elster's negative commentary on Trump's policies (and his "features"), the Federal Circuit concluded, as it had little choice but to do after conforming to the ruling of *Iancu v. Brunetti*, that the viewpoint-based denial of federal trademarks to applicants who make unauthorized use of the personal name of another person violated the First Amendment.[173] For the purposes of this Article, one of the more poignant observations of the Federal Circuit's opinion is that advertising billboards, fundraising handbills, and merchandise can be protected speech.[174] There is no textual or other requirement that

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(holding that no reasonably prudent consumer confused by commentary site using a trademark in part of its Internet address, or domain names). *But cf.* Gervais and Latsko, *infra* note 218, at 274–75, 287 (suggesting that some courts construe the reasonably prudent consumer that trademark law seeks to protect as being part of "small minority" of unsophisticated, easily distracted, less savvy shoppers). *See generally* Toyota Motor Sales, U.S.A., Inc. v. Tabari, 610 F.3d 1171, 1176 (9th Cir. 2010) ("Unreasonable, imprudent and inexperienced web-shoppers are not relevant"); Nissan Motor Co. v. Nissan Computer Corp., 378 F.3d 1002, 1019 (9th Cir. 2004) ("An internet user interested in purchasing, or gaining information about Nissan automobiles would be likely to enter nissan.com. When the item on that website was computers, the auto-seeking consumer 'would realize in one hot second that she was in the wrong place and either guess again or resort to a search engine to locate' Nissan Motor's site.").

171. Vidal v. Elster, 143 S. Ct. 2579 (2023) (granting writ of certiorari).

172. *See In re* Elster, 26 F.4th 1328, 1330 (Fed. Cir. 2022) (discussing a names clause, and how a proposed mark evoked a "memorable exchange between President Trump and Senator Marco Rubio from a 2016 presidential primary debate, and aims to 'convey[] that some features of President Trump and his policies are diminutive'") (citing 15 U.S.C. § 1052(c)).

173. *See also* S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm., 483 U.S. 522, 569 (1987) (Brennan, J., joined by Marshall, J., dissenting) (declaring that overbroad trademark-like rights violate free speech because "governments might soon seize upon the censorship of particular words as a convenient guise for banning the expression of unpopular views.") (quoting Cohen v. California, 403 U.S. 15, 26 (1971)). *Compare* 15 U.S.C. § 1052(c) (a trademark is not federally registrable if it contains "a name . . . identifying a particular living individual except by his written consent"), *with Elster*, 26 F.4th at 1331 (noting that the Supreme Court had held that "to deny registration of marks that 'disparage . . . or bring . . . into contempt[] or disrepute' any 'persons, living or dead,'" would "violate[] the First Amendment" as an attempt to "discriminate against speech based on the ideas or opinions it conveys") (quoting 15 U.S.C. § 1052(a); Iancu v. Brunetti, 588 U.S. 338 (2019); Matal v. Tam, 582 U.S. 218 (2017)).

174. *See In re Elster*, 26 F.4th at 1333–34 (citing Heffron v. Int'l Soc. for Krishna Consciousness,

speech (or press materials) be donated to others or lent without payment.[175] The other major premise of the ruling is that public persons like Donald Trump must submit to criticism of their conduct or character, whether or not it harms their reputations or subjects them to ridicule.[176] There is nothing exempting public persons from this rule because they seek and win publicity for their commercial rather than for their political achievements, like Jack Daniels, Louis Vuitton, Tiger Woods, or other endorsers or brands.[177]

The court turned to the misappropriation justification for the Lanham Act's section 2(c) bar. Does registering a work containing the name or portrait of a particular living person without his or her consent "steal" an "identity"? In concluding that the restriction is suppressive of the right to criticize members of the government and candidates for office, the circuit decision drew on the rights of fair comment:

> The *Restatement* specifically notes that the right of publicity would be unavailable to "a candidate for public office" who sought to "prohibit the distribution of posters or buttons bearing the candidate's name or likeness, whether used to signify support or opposition." *Restatement (Third) of Unfair Competition* § 47 cmt. b. Similarly, in *Paulsen v. Personality Posters, Inc*., 59 Misc.2d 444, 299 N.Y.S.2d 501, 508–09 (Sup. Ct. 1968), a comedian who had initiated a presidential campaign could not enjoin the distribution of mocking campaign posters bearing his likeness because the poster communicated "constitutionally protected" political speech that "must supersede any private pecuniary considerations."
>
> The government has no valid publicity interest that could overcome the First Amendment protections afforded to the political criticism embodied in Elster's mark.[178]

Inc., 452 U.S. 640, 647 (1981); Village of Schaumburg v. Citizens for a Better Env't, 444 U.S. 620, 632 (1980); Murdock v. Pennsylvania, 319 U.S. 105, 111 (1943); Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 970 (10th Cir. 1996)). The court also mentions printed jackets and shirts as obviously containing speech. *See id.* (citing Cohen v. California, 403 U.S. 15, 19 (1971)); Comedy III Prods., Inc. v. Gary Saderup, Inc., 25 Cal. 4th 387, 398 (2001)); *see also* Ramsey, *supra* note 33, at 383, 400–02, 434–37 (concerning t-shirts as speech).

175. *See In re Elster*, 26 F.4th at 1333; *cf.* Hustler Magazine v. Falwell, 485 U.S. 46, 50 (1988); N.Y. Times Co. v. Sullivan, 376 U.S. 254, 266 (1964); *supra* notes 151, 156, 168–69 and accompanying text.

176. *See In re Elster*, 26 F.4th at 1334. (citing *Sullivan*, 376 U.S. at 273; Baumgartner v. United States, 322 U.S. 665, 673–74 (1944)).

177. *See, e.g.*, Bose Corp. v. Consumers Union of U.S., Inc., 692 F.2d 189 (1st Cir. 1982), *aff'd*, 466 U.S. 485 (1984) (finding that a private corporation could be public figure for First Amendment purposes in product disparagement dispute); Global Telemedia Int'l v. Doe 1, 132 F. Supp. 2d 1261 (C.D. Cal. 2001) (holding that a corporation with many private investors could be public figure, necessitating application of First Amendment standards in tort dispute). *Cf. supra* notes 151, 156, 168–69.

178. *See In re Elster*, 26 F. 4th at 1338.

Perhaps surprisingly, at oral argument, members of the Supreme Court seemed inclined to reverse, based on the actual practice of the courts, hereby referred to as "practice originalism," which apparently was to extend protections against the unauthorized use of one's name or likeness on merchandise or in commerce as a form of endorsement.[179] This is symptomatic of actual practice originalism's deleterious impact on the Court's doctrine. Rather than inquiring into the purposes of the First Amendment and limiting government power as a protective judicial bulwark, as the Bill of Rights presumes, the Court becomes a bulwark of earlier judicial practice at the expense of basic freedoms, freedoms which are essential to the legitimacy of this very practice.[180] Such "practice originalism" wrongfully elevates a historical trend that matured after the 1950s over an intention to promote a wide-ranging freedom of speech that was first articulated in 1791.[181]

Actual practice originalism of the sort used in *Harper & Row* and the *Elster* oral argument has the same relevancy problems as post-enactment legislative history. Justice Stephen Breyer once articulated why. First, comments about a statute or constitutional provision subsequent to its framing, debate, and passage are not part of its drafting history.[182] Second, such comments do not represent an articulation and coming to a consensus about what text is being

179. *See* Transcript of Oral Argument, Vidal v. Elster, 602 U.S. 286 (2024) (No. 22–704); Grace Wickstrom, *Part II: Elster Oral Arguments and Beyond*, Chicago-Kent J. of Intell. Prop. Blog (Apr. 4, 2024), https://studentorgs.kentlaw.iit.edu/ckjip/7660-2/ [https://perma.cc/DL8F-6NPG].

180. On the intention to make the Court a bulwark of individual freedoms in Bill of Rights cases, especially those involving the First Amendment and Congress, see Barenblatt v. United States, 360 U.S. 109, 142-44 (1959) (Black, J., dissenting).

181. *See* N.Y. State Pistol & Rifle Ass'n v. Bruen, 597 U.S. 1, 46 (2022) (holding that "we cannot conclude from this historical record that, by *the time of the founding*, English law would have justified restricting the right to publicly bear arms suited for self-defense only to those who demonstrate some special need for self-protection.") (emphasis added); Espinoza v. Mont. Dep't of Revenue, 591 U.S. 464, 482–84 (2020) (reasoning that where "early American tradition" did not support a limitation on the Free Exercise Clause of the First Amendment, a historical practice that "arose in the second half of the 19th century" could not by itself support the limitation, and also could not support subjecting protections of the Clause to "a 'judgment-by-judgment analysis . . . .'); *cf.* District of Columbia v. Heller, 554 U.S. 570, 614 (2008) ("Since [certain discussions of keeping and bearing arms] took place 75 years after the ratification of the Second Amendment, they do not provide as much insight into its original meaning as earlier sources."); *id.* at 635 ("The First Amendment contains the freedom-of-speech guarantee that the people ratified, which included exceptions for obscenity, libel, and disclosure of state secrets, but not for the expression of extremely unpopular and wrong headed views.").

182. *See Heller*, 554 U.S. at 662 n.28 (Breyer, J., dissenting).

voted on by legislators or constitutional framers.[183] They are potentially speculative, like a judge's opinion on a statute that is merely under consideration.[184]

The post-enactment history of the First Amendment – —or of the copyright and trademark statutes ––– is therefore considerably less meaningful than the drafting and ratification history of the First Amendment. In *Elster*, there could not have been any legislative history of the First Amendment suggesting that content-based denials of trademark registration are good for the freedom of speech. In fact, no history of the First Amendment was offered to support that view, only cases in which people were granted trademark or trademark-like rights in their own given name or surname, a statute limiting the registration of marks containing the name of another living person without their permission, and cases under this statute.[185] Likewise, there is no legislative history of the Copyright Act from the period of its consideration and enactment suggesting that fair use is an important qualifier of the freedom of speech or that excessive quotation from a text is not protected by the First Amendment— – in part because the case law in 1790 did not support this, and the relevant discussion of fair use in the United States did not arise until four decades after the passage of the Bill of Rights' passage.[186] In both *Elster* and *Harper & Row*, there really is nothing more than what the litigants opposed to the First Amendment theory had in *Sullivan* or *Reno* – a tradition of regulating a type of speech.[187]

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183. *See id.*

184. *See id.* (citing Sullivan v. Finkelstein, 496 U.S. 617, 631–32 (1990) (Scalia, J., concurring in part)).

185. *See* Vidal v. Elster, 602 U.S. 286, 295–300 (2024).

186. *Compare, e.g.*, Newbery's Case (1773) 98 Eng. Rep. 913, 913 (Ch.) (reproductions of portions of prior books may be "a new and a meritorious work" and not an infringement), Dodsley v. Kinnersley (1761) 27 Eng. Rep. 270, 271 (Ch.) (reproduction of book excerpt in magazine "was a fair abridgment, and, as such, not a piracy"), Gyles v. Wilcox (1740) 26 Eng. Rep. 489, (Ch.) (reproductions of portions of legal treatise reflecting "invention, learning, and judgment" in the choice of excerpts is not an infringement of copyright), Story v. Holcombe, 23 F. Cas. 171, 173 (C.C.D. Ohio 1847) (No. 13,497) (under the English cases, "[a] fair abridgment of any book is considered a new work, as to write it requires labor and exercise of judgment"), *and* Stowe v. Thomas, 23 F. Cas. 201, 203 (C.C.E.D. Pa. 1853) (use of characters from prior book in new work would not infringe copyright), *with* Folsom v. Marsh, 9 F. Cas. 342, 344–45, 348–49 (C.C.D. Mass. 1841) (articulating test that became known as fair use).

187. *Harper & Row*, 471 U.S. 539, 558 (1985). *Compare Elster*, 602 U.S. at 296 (civil regulation as fraud or trademark infringement), *with* N.Y. Times Co. v. Sullivan, 376 U.S. 254 265–69, 280–82, 285, 292 n.30 (1964) (despite its seeming viewpoint neutrality and historical pedigree, libel law requires an actual malice defense for a verdict against a media defendant to withstand First Amendment examination of verdict's potential impact on public discourse via chilling effects); Reno v. ACLU, 521 U.S. 844, 862–63, 865–66, 872–75, 877–78 (1977) (obscenity and indecency laws require definition with precision to exclude books, websites, or art with cultural or political value in order to withstand First Amendment scrutiny regarding impact on public discourse).

When the Supreme Court released its opinion in *Elster*, most justices agreed that the First Amendment permitted Congress to carry forth a "common-law tradition" of guaranteeing a person some control over his or her own name in a registration bar, or restriction of others' mode of speech.[188] Left explained is any reason to prioritize tradition in this way over the text and intention of the First Amendment to promote communicative freedom. This variety of actual practice originalism imports the "content-based" doctrines of English law, and doctrines particularly of the English courts of chancery, as the maximal scope of the freedoms of speech and of the press.[189] The chancery courts, of course, were well known to the Framers of the Constitution as being at the heart of a system of prepublication censorship, or prior restraints on speech, which were among the main targets of the First Amendment in preventing abridgements of speech and press freedoms.[190] Besides presenting a

188. *See Elster*, at 307–08. The Court's unanimous decision might have been surprising to some observers. There was no dissent; five justices joined every part of the majority opinion of the Court other than Part III, and three justices joined most of Justice Barrett's concurrence, which is largely repetitive to the main opinion and to such an extent as to prompt one to wonder what purpose it serves. The divisive part of the majority opinion of the Court seemed to be Part III, which stated that the trademark registration system was not a limited public forum, restrictions on access to which would be analyzed with reference to whether there is a vague consistency between "trademark registration restrictions" and their "purpose." *Id*. at 314 (Barrett, J., concurring in part). The opinions for the Court and those of the three concurring opinions indicate that the dispute as to Part III of Justice Thomas's opinion (on behalf of himself and Justices Alito and Gorsuch) pertains to whether an even looser reasonableness standard than Justice Thomas employs should be adopted. It would be drawn from limited public forum cases or from cases relating to monetary subsidies and participation in government programs. *See id*. at 309; *id*. at 317–18 (Barrett, J., concurring); *id*. at 332 (Sotomayor, J., concurring); *see also, e.g.*, Nat'l Endowment for the Arts v. Finley, 524 U.S. 569 (1998); Ark. Educ. Tel. Comm'n v. Forbes, 523 U.S. 666 (1998). Insofar as this dispute might not matter in practice in *Elster*, it seems to look towards the use of history in religious exercise, right to privacy, or gun regulation cases, or perhaps reflects an attempt to relitigate *Tam* and *Brunetti*. *Cf.* District of Columbia v. Heller, 554 U.S. 570, 595 (2008); Matal v. Tam, 582 U.S. 218 (2017).

189. *Elster*, 602 U.S. at 295 ("Trademark rights 'ha[ve] been long recognized by the common law and the chancery courts of England and of this country, and by the statutes of some of the States,' and that protection continues today.") (quoting *In re* Trade-Mark Cases, 100 U.S. 82, 92 (1879)); *see also* Bartholomew & Tehranian, *infra* note 233, at 68 (collecting scholarly citations for proposition that weight of authority called intellectual property content-based).

190. *See* An Act for the Regulating the Privy Council and for taking away the Court commonly called the Star Chamber 1641, 17 Car. I. cap. 10, Statutes of the Realm, v. 110 (Gr. Brit.); Sterling Edwin Edmunds, Struggle for Freedom: The History of Anglo-American Liberty 75 (1946); Louis E. Ingelhart, Press and Speech Freedoms in the World, from Antiquity until 1998, at 98, 109 (1998); Charles Ogilvie. The King's Government and the Common Law 1471–1641, at 58 (1978). The Chancellors Wolsey or Woolsey and Thomas More threatened to persecute the English translators of the Bible and those persons influenced by them to proclaim Protestantism, religious dissent,

serious tension with the purpose of the First Amendment to free Americans from the censorship of the Chancellor and the Star Chamber, the supposed consensus of the common law is not even recognized in American case law or in the legislative history of the Lanham Act.[191] The analysis thereby promotes neither freedom nor consistency.

In the majority opinion of *Vidal v. Elster*, the long tradition of allowing a person to protect their own name as a trade name or registered trademark served to dispel the First Amendment problem.[192] Trademark law and free speech "play well" together, in the Court's view, because the former deals with commercial signage and the latter with the message conveyance.[193] Under *Jack Daniel's*, where there is conduct or a publication that does both things, the tests for infringement, dilution, and fair use will resolve any lingering tension between public discourse and source-identification.[194] Infringement analy-

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or heresies. *See* Michael Farris, From Tyndale to Madison: How the Death of an English Martyr Led to the American Bill of Rights 8–33, 320–21 (2007); James Anthony Froude, History of England from the Fall of Wolsey to the Defeat of the Spanish Armada 294-95 (1870). The infamous Court of Star Chamber, which oversaw executions on the pillory for writing false statements against private persons, was likely to have been involved with the chancery in censorship efforts. *See* James Paterson, The Liberty of the Press, Speech, and Public Worship: Being Commentaries on the Liberty of the Subject and the Laws of England 225 (1880) (pillory and speech/libels); Marvin Lomax, *The Court of Star Chamber—A Tudor Creation?,* 45 Proc. Okla. Acad. Sci. 167, 167, 169 (1965) (Court of Star Chamber associated by English parliament with the King's Council meeting in a star chamber, which included the Chancellor). Also, when Sir Thomas More was Chancellor in England, he sentenced the publishers of an unauthorized—more literal—translation of the Bible to be ridden about town with their faces affixed to the behinds of horses. *See* Paterson, *supra* note 191, at 224; *cf.* Joseph Story, Commentaries on the Constitution of the United States 704–5 (1833).

191. *See Elster*, 602 U.S. at 319–21 (Barrett, J., concurring in part) (in U.S. law, there was [and is] no automatic trademark interest in one's own name, third parties have trademarked the names of famous and/or dead persons, a personal name in an unadorned text was not trademark-worthy under *McLean v. Fleming*, 96 U.S. 245, 252–53 (1878), and federal law as of 1916 was likely that "'[t]he law permits the adoption as a trade-mark of the name of a person who has achieved fame and distinction, provided the name is not descriptive of the quality or the character of the article or a geographical name.'") (quoting Stephano Bros., Inc. v. Stamatopoulos, 238 F. 89, 93 (2d Cir. 1916)); *see also* Trademark Manual of Examining Procedure § 1211.01(b)(vi) (U.S. Pat. and Trademark Off. Nov. 2024) (noting that an applicant may not register a combination of their own surname with a class of goods or services offered in many cases, for "one could evade § 2(e)(4) [the bar on registering marks that are primarily merely a surname] by the easy expedient of adding merely descriptive matter or the generic name of the goods or services to a word that is primarily merely a surname").

192. *Elster*, 602 U.S. at 286.

193. *Id.* at 300 (quoting Jack Daniel's Props., Inc. v. VIP Prods. LLC, 599 U.S. 140, 159 (2023).

194. *Cf. Jack Daniel's*, 599 U.S. at 150–63. Although dilution is not mentioned in the *Elster* opinion, perhaps to avoid dealing with the contention of the applicant and some amici that a First Amendment analysis should consider as a less restrictive means the likelihood of confusion or likelihood of deception (misleadingness) bars on registration

sis might absolve many parodies and satires of trademark liability, while the defense of fair use would come to the rescue of others.[195]

Inattention to the free speech principle embodied in fair comment rules led the Supreme Court's justices to overlook the most important issues raised in *Elster*. First, by failing to uncouple the "names clause" from creating a likelihood of confusion or deception, the decision withholds a government benefit on content-based grounds, for a purpose related to the prevention of offense being taken by the person named, rather than clear labeling.[196] Second, the

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as less restrictive alternatives to the names clause, *Jack Daniel's* is cited in the *Elster* opinion, and that case refers to dilution. *Cf.* TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1207.01(b)(x) (U.S. PAT. AND TRADEMARK OFF. Nov. 2024) (suggesting that a party could register a parody of another's trademark, although parody is not sufficient "in itself" for this purpose).

195. *See* Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252 (4th Cir. 2007); *see also* KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111 (2004); Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97, 116–19 (2d Cir. 2009); White v. Samsung, 971 F.2d 1395, 1406–07 (9th Cir. 1992) (Kozinski, J., concurring in part) (citing Toho Co., Ltd. v. Sears, Roebuck & Co., 645 F.2d 788, (9th Cir. 1981); Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 759 (9th Cir. 1978), *cert. denied sub nom* O'Neill v. Walt Disney Prods, 439 U.S. 1132 (1979); Navajo Nation v. Urban Outfitters, Inc., 212 F. Supp. 3d 1098 (2016); MasterCard Int'l. Inc. v. Nader 2000 Primary Comm., Inc., 2004 WL 434404 (S.D.N.Y. Mar. 8, 2004).

196. *See* Transcript of Oral Argument at 43–44, Vidal v. Elster, 602 U.S. 286 (2024) (No. 22-704); Brief for the Am. Intell. Prop. Law Ass'n as Amicus in Support of Neither Party at 14–19, Vidal v. Elster, 602 U.S. 286 (2024) (No. 22–704). Indeed, the various opinions in *Elster*, occupying around 17,000 words or the equivalent of 68 pages of Microsoft Word text, do not even mention the false-suggestion-of-a-connection, likelihood-of-confusion, likelihood-of-dilution, or misdescriptive-mark standards, which are obviously less restrictive and narrower protections of the consumer interest in buying licensed goods and of individual endorsement and likeness value than a broad names clause. *See In re* Elster, 26 F.4th 1328, 1336–37 (Fed. Cir. 2022) ("trademarks inaccurately suggesting endorsement in a manner that infringes the 'right of privacy, or the related right of publicity' are already barred by section 2(a) of the Lanham Act, a provision not invoked on appeal") (footnote omitted); TRADEMARK MANUAL OF EXAMINING PROCEDURE §§ 1202.17(d)(ii), 1203.03, 1207.01, 1207.01(b)(x) (U.S. PAT. AND TRADEMARK OFF. Nov. 2024), https://www.bitlaw.com/source/tmep/1200.html [https://perma.cc/5K7X-MU2M] (citing Lanham Act, § 2(e), 15 U.S.C. § 1052(e); Lanham Act, § 2(d), 15 U.S.C. § 1052(d); Lanham Act, § 2(a), 15 U.S.C. § 1052(a); *In re* E. I. du Pont de Nemours & Co., 476 F.2d 1357 (C.C.P.A. 1973). Justice Sotomayor's concurrence (also on behalf of Justices Kagan and Jackson) does state in general terms that famous baseball players "would not want manufacturers to dilute the commercial value of their name and reputation. Nor would [they] want a Boston Red Sox fan to manufacture cheaper goods and use their names to promote second-rate products." Vidal v. Elster, 602 U.S. at 338 (Sotomayor, J., concurring). But these cases might be covered by the section 1052(d) bar, which prohibited registration of CRACKBERRY (BlackBerry) or CLOTHES ENCOUNTERS (*Close Encounters of the Third Kind*). *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1211.01(b)(vi) (citing, *inter alia*, Rsch. in Motion Ltd. v. Defining Presence Mktg. Grp., Inc., 102 U.S.P.Q.2d 1187, 1192 (T.T.A.B. 2012); Columbia Pictures Indus., Inc. v. Miller, 211 U.S.P.Q. 816, 820 (T.T.A.B. 1981)).

rational-basis test the Court and some concurring justices apply to the names clause on account of its alleged viewpoint neutrality is inconsistent with its treatment of viewpoint-neutral libel, Internet indecency, and other laws.[197] Third, the names clause is obviously not viewpoint neutral; it targets persons whose message involves mimicking or lampooning other persons for denial of a benefit, while allowing the benefit to those whose opinion and speech differ. This is even more clear in practice: the Court simply ignored contrary evidence in the briefs and public record that critics are the ones who suffer the main difficulty and bias in registering marks. Negative commentary on public figures has been treated differently, and worse, in a manner that suppresses certain viewpoints:

> A few examples: BIDEN PRESIDENT was accepted for federal registration. But "Impeach 46" was denied under the names clause. Likewise, "JOE 2020" is registered, but not "No Joe in 2024." HILLARY FOR AMERICA, too, was approved. But "Hillary for Prison 2016"? Denied. And while celebrity fanbases can register their celebrity adoring names as trademarks (e.g., SWIFTIES, ARNIE'S ARMY, and BEYHIVE), groups opposing presidential candidates have had their requests denied under the clause (e.g., "Never Trumper"). That is the opposite of the First Amendment's command.[198]

Creators are in a bind after the elevation of commercialism over the communication of ideas in cases such as *Warhol* and *Elster*.[199] *Elster* is therefore another blow by the Roberts Court against commentary in the form of parody or satire. The difficulty obtaining any form of intellectual property protection for a work of parody or satire under the combined impact of *Warhol* and *Elster* may frustrate efforts to procure financing for parody or satire plays or shows that allude to existing works, such as *3Co*. (*Three's Company* parody), *Who's Holiday* (*How the Grinch Stole Christmas!* parody), or *Point Break*

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197. *See supra* notes 9 and 175 and accompanying text (First Amendment defense needed in libel cases to protect public discourse); *see also supra* note 47 and accompanying text (indecency or obscenity laws need a definitional component of lack of cultural or artistic value for First Amendment purposes).

198. Brief for Respondent at 25, Vidal v. Elster, 602 U.S. 286 (2023) (No. 22–704) (citing Matal v. Tam 582 U.S. 218, 249 (2017) (Kennedy, J., concurring)). *See also id.* at 20 (CLINTON THE MUSICAL was denied registration, and Motion Picture Association of America expressed concern that titles like that of television and streaming video series *The People v. O.J. Simpson. An American Crime Story* would be denied registration for unwelcome name use); *Id.* at 2–15 (summarizing similar portions of legislative history and subsequent history); *In re Elster*, 26 F.4th at 1336 n.1 (Lanham Act supporters observed that names clause would help politicians avoid association with unsavory products, not so much association with admiring biographies, films, plays, or the like).

199. Indeed, Justice Sotomayor's appeal to the plight of baseball players fearing "second-rate" merchandise parallels her solicitude for the commercial interests of photographers like Goldsmith even when artistic and literary freedom must be sacrificed to maximize those interests. *See supra* note 197 and accompanying text.

Live![200] Even dramas like unauthorized biopics or true crime stories will be affected.[201] Due to the existence of federal unregistered mark and state law trademark protections, *Elster* will not prohibit artists or designers from suing infringers of their t-shirts, posters, and the like. However, it may render some lawsuits unpractical.[202] Moreover, for creators lacking a claim on a trade name or the brand name of a product or a work, the process of seeking financing may be impaired.[203]

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200. *See* 17 U.S.C. § 103(b) (copyright does not persist in portion of derivative work in which preexisting material used unlawfully); Keeling v. Hars, 809 F.3d 43 (2d Cir. 2015) (*Point Break Live!* was transformative under pre-*Warhol* law); Lombardo v. Dr. Seuss Enters., LP, 279 F. Supp. 3d 497, 505–10 (S.D.N.Y. 2017), *aff'd*, 729 F. App'x 131 (2d Cir. 2018) (*Who's Holiday* as transformative, citing Adjmi v. DLT Entmt. Ltd., 97 F. Supp. 3d 512 (S.D.N.Y. 2015) (*3Co* case)). Of course, *Warhol* did not say that parodies could not be a fair use, but denigrated satire in its discussion of comment, and generally emphasized commerciality over artistic freedom. *See* Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508, 560–62 (2023) (Kagan, J., joined by Roberts, C.J., dissenting); Menell et al., *supra* note 60, at 35 (citing dissent).
201. *See* Brief for Respondent at 20, Vidal v. Elster, 602 U.S. 286 (2024) (No. 22-704). Lenders to or producers of theatre or visual arts productions may be pressured by threats from copyright or trademark holders. *See, e.g.*, David Faux, *The Show Dr. Seuss Doesn't Want You to See*, Dramatists Guild (Jan. 1, 2018), https://www.scribd.com/document/385586821/JAN-FEB-2018-The-Show-Dr-Seuss-Doesn-t-Want-You-to-See [https://perma.cc/3AKN-Q7XW]; Brief for The Dramatists' Legal Def. Fund as Amicus Curiae Supporting Appellee and Affirmance at 7, Corbello v. Valli, 974 F.3d 965 (2020) (No. 17-16337); *cf*. Patricia Aufderheide & Peter Jaszi, *Untold Stories: Creative Consequences of the Rights Clearance Culture for Documentary Filmmakers*, Center for Media & Soc. Impact (Nov. 3, 2004), https://cmsimpact.org/resource/untold_stories/ [https://perma.cc/2V22-QHKS] (noting that uncertainty of fair use "sometimes threatens to derail [film] production"); Contreras and Fagundes, *supra* note 151 (suggesting, without benefit of *Elster*, that biopics are protected by First Amendment, and surveying legal threats to biopic directors, producers, or distributors).
202. Specifically, the cost of proving trademark rights (rather than enjoying a presumption of prima-facie validity) may be impractical to wager good money on, damages may be unavailable, or certain customs-related remedies may be unavailable. *See* 15 U.S.C. § 1111; 15 U.S.C. § 1115(a); 15 U.S.C. § 1117 (registration benefit in terms of remedies includes exemption from actual notice under 15 U.S.C. § 1111); *Elster*, 602 U.S. at 291 (describing benefits of federal registration as "important"); Coach, Inc. v. Asia Pac. Trading Co., Inc., 676 F. Supp. 2d 914, 921–25 (C.D. Cal. 2009) (actual notice of *registration*—not brand name—may be required to recover damages in some design infringement cases; so plaintiffs may be entitled to no damages despite defendants knowing relevant store sold fashion look-alikes). If a party only seeks damages but cannot recover them do to a lack of registration under 15 U.S.C. § 1111, it might owe the other side its attorney's fees as a prevailing party under 15 U.S.C. § 1117, and end up subsidizing the infringer. *See* 15 U.S.C. § 1117(a) (prevailing party attorney's fees in exceptional cases).
203. *See, e.g.*, Troy Mathew, *Hey, Founders—Before You Name Your Startup Something Stupid, Read This*, VentureBeat (June 27, 2014), https://venturebeat.com/entrepreneur/hey-founders-before-you-name-your-startup-something-stupid-read-this/ [https://perma.cc/TR2T-6BLM] ("For startups, the name of the business becomes the first word of every

IV. A Fair Comment Framework for the Rightful Scope of Fair Use and Free Speech in IP Cases

The mens rea requirement of libel and invasion of privacy law in trade name and trademark cases accelerates the accumulation of knowledge and the vigor of public debates, which would be chilled by the prospect of litigation without actual malice and absolute opinion immunity.[204] In order to expand the freedom of speech and harmonize the treatment of individual and trade name/trademark comments, parodies, and criticisms, courts should adopt similar standards in trade name and trademark cases, and in copyright cases as well. As one court described, comment and editorial matter (as well as parody) that transforms a personal or entity image should be entitled to more First Amendment protection than an unadorned attempt to fabricate a source or sponsorship:

> In many right of publicity cases, the question of actual malice does not arise, because the challenged use of the celebrity's identity occurs in an advertisement that "does no more than propose a commercial transaction" and is clearly commercial speech. In all these cases, the defendant used an aspect of the celebrity's identity *entirely and directly* for the purpose of selling a product. Such uses do not implicate the First Amendment's protection of expressions of editorial opinion . . . .[205]

If a use of a brand or a persona is not "entire and direct" but partial, and either additive or artistic, the presumption of little to no speech interest should vanish.[206] Moreover, due to the distinction between the creative commentary and the untransformed naive original work, any presumption of a high likelihood of deception should go away. In such cases, the mens rea of the secondary user must be tested for whether there was an intention or reckless attempt to purloin a source identifier or endorsement from the primary user of a mark. Otherwise, the breathing space for editorial and humorous commentary will be

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investor pitch and the first message that's spread to potential use."). A good startup name should be "short," "catchy," contained in a domain name, and convey a sense of action, like Snap, Uber, or Yelp. *See id.*

204. *See* Tushnet, *supra* note 1, at 582–88.

205. Hoffman v. Cap. Cities/ABC, Inc., 255 F.3d 1180, 1185–86 (9th Cir. 2001) (citing Newcombe v. Adolf Coors Co., 157 F.3d 686, 691 (9th Cir. 1998); Abdul-Jabbar v. Gen. Motors Corp., 85 F.3d 407, 409 (9th Cir. 1996); White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1396 (9th Cir. 1992) (as amended); Midler v. Ford Motor Co., 849 F.2d 460, 461 (9th Cir. 1988); Restatement (Third) of Unfair Competition § 25(2) (Am. L. Inst. 1995). The court in *Hoffman* further suggested that cultural or social expression "is entitled to the full First Amendment protection accorded noncommercial speech," including protection against tort liability pursued against a media organization unless actual malice exists. 255 F.3d at 1186 (citing Harte-Hanks Commc'ns, Inc. v. Connaughton, 491 U.S. 657, 667 (1989)).

206. *Id*.

invaded, contrary to the aims of the First Amendment as construed in *Sullivan*, *Falwell*, and *Hoffman*.[207]

Jennifer Rothman and Robert Post have also developed a First Amendment theory that is intended to be applicable to a subset of intellectual-property cases, and in which mens rea plays an important part. They suggest that *Zacchini* too hastily equated reproduction of unique performances with other uses of personal identities or talents, and alternatively, that later courts overextended the holding.[208] They advocate updating the First Amendment analysis to account for contemporary levels of First Amendment scrutiny, while drawing inspiration from the tests lower courts have used to distinguish creative uses of identities or personas from exploitative, unproductive, or random ones. For uses of and interferences with valuable likenesses, identities, or personas, Rothman and Post utilize a test of an intent to confuse or serious actual confusion.[209] The *Jack Daniels* decision, to its credit, does something slightly analogous by strongly suggesting that a parody in public discourse or "fair" advertising is unlikely to be confusing.[210]

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207. *See id*. at 1184 (citing N.Y. Times Co. v. Sullivan, 376 U.S. 254, 279–80 (1964)); Brief for Elec. Frontier Found. as Amicus Curiae Supporting Respondent at 4, 17–18, *Jack Daniel's*, 599 U.S. 140 (2023) (No. 22-148), https://www.supremecourt.gov/DocketPDF/22/22-148/255380/20230227140513430_Amicus%20Brief.pdf [https://perma.cc/2ERA-5623] (citing Hustler Magazine v. Falwell, 485 U.S. 46, 56 (1988), and *Sullivan*, 376 U.S. at 280–81 (1964)); *Sullivan*, 376 U.S. at 292 n.30.

208. *See* Rothman & Post, *supra* note 41, at 126. *Accord* Brief for Motion Picture Ass'n of Am. as Amicus Curiae Supporting Neither Party at 13–19, Vidal v. Elster, 602 U.S. 286 (2024) (No. 22-704).

209. *Id.* In trademark law, "serious confusion" helps separate actual confusion evidence entitled to some weight from anecdotal evidence of "inquiries," "searches," or attempts to clarify a producer's or endorser's relationship to a use. Heaven Hill Dist., Inc. v. Log Still Dist., LLC, 575 F. Supp. 3d 785, 833 (W.D. Ky. 2021) (citing Kibler v. Hall, 843 F.3d 1068, 1078–79 (6th Cir. 2016)); Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc., 528 F.3d 1258, 1268 (10th Cir. 2008); Toyota Motor Sales, U.S.A., Inc. v. Tabari, 610 F.3d 1171, 1176 (9th Cir. 2010); Nissan Motor Co. v. Nissan Computer Corp., 378 F.3d 1002, 1019 (9th Cir. 2004). Actual confusion is one of the more important factors in a trademark infringement assessment. An intent to confuse may separate more innocent parodies from knowing or deliberate attempts to pretend that an endorsement relationship exists. *White*, 971 F.2d at 1400–01. *But see id*. at 1406–7 (Kozinski, J., dissenting) (criticizing majority's application of intent to confuse factor because use of robot likeness of plaintiff meant that ad was parody, not endorsement).

210. *See Jack Daniel's*, 599 U.S. at 161 (holding that if a parody contrasts itself with the original using new "message" or "humor," then it "is not often likely to create confusion," and indicating that a "trademark's expressive message—particularly a parodic one…—may properly figure in assessing the likelihood of confusion); *see, e.g.*, Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 261 (4th Cir. 2007) ("Parody 'influences the way in which the [likelihood-of-confusion] factors are applied'."). *Accord Hoffman,* 255 F.3d at 1187 ("It is not enough to show that [a magazine] unknowingly misled readers into thinking [an actor] had actually posed for [a digitally] altered photograph. Mere negligence is not enough to demonstrate actual malice."); Toho Co., Ltd. v. Sears, Roebuck & Co., 645 F.2d 788, 791 (9th Cir. 1981) (where Sears sold "Bagzilla" garbage

The following table creates a matrix of potential First Amendment applications in right of publicity cases. The columns or left-right axis measure, in part, the degree of exploitation of a persona that is taking place. Public discourse is the least exploitative end of the spectrum, use on commodities the most exploitative. The rows distinguish between the type of interest being asserted, and the type of conduct being challenged by the plaintiff. This top-to-bottom axis tracks a definitional balance in cases involving the right of performance, the right of endorsement or image control, and the right of dignity or protection from negative associations. Despite attempting to fit and justify the case law since the 1970s, the matrix recognizes several paths to successfully challenge the right of publicity assertions using First Amendment protections of fair use, the public domain in ideas, and viewpoint neutrality.

Table 1: How the First Amendment (1A) Might Structure Defenses to Right of Publicity Claims

Speech Type → *Right of ↓*	*Public discourse*	*Commercial speech*	*Commodities*
Performance	No 1A defense unless RoP controls ideas or forbids "fair" use	No 1A defense to RoP claims (any exceptions?)	No 1A defense to RoP claims (any exceptions?)[211]
Commercial value	1A defense unless serious or explicit confusion is created/intended in violation of RoP	No 1A defense unless RoP controls ideas or forbids "fair" use	No 1A defense to RoP claims (any exceptions?)[212]
Control	1A defense unless serious or explicit confusion is created/intended in violation of RoP	No 1A defense unless RoP controls ideas or forbids "fair" use	No 1A defense to RoP claims
Dignity	No 1A defense to RoP claims	No 1A defense unless RoP is viewpoint-discriminatory(?)[213]	No 1A defense to RoP claims

bags, allegedly creating a likelihood of confusion with "Godzilla" trademark, court held that "[t]he contention that Sears intends to confuse consumers is implausible: Sears means only to make a pun"); *cf.* Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97, 116 (2d Cir. 2009) ("[W]e have held that a strong mark may nonetheless weigh against the likelihood of confusion in the limited circumstance where the defendants' mark is a clear parody and there is widespread familiarity with the parody.") (citing Hormel Foods Corp. v. Jim Henson Prods., Inc., 73 F.3d 497, 503 (2d Cir. 1996)).

211. Professors Rothman and Post call decisions like *American Heritage,* concerning use of a likeness on a commodity but in a semi-creative way, controversial but do not seem prepared to advocate that courts overrule them. *See* Martin Luther King, Jr., Center for Soc. Change, Inc. v. Am. Heritage Prods., Inc., 250 Ga. 135 (1982); *cf.* Alicia M. Hunt, *Everyone Wants to Be a Star: Extensive Publicity Rights for Noncelebrities Unduly Restrict Commercial Speech*, 95 Nw. U.L. Rev. 1605, 1615 (2000); Tara E. Langvardt, *Reinforcing the Commercial-Noncommercial Distinction: A Framework for Accommodating First Amendment Interests in the Right of Publicity*, 13 Va. Sports & Ent. L.J. 167, 182 (2013).
212. *See supra* note 211.
213. This is my gloss on Rothman and Post's discussion of commercial speech, the First

At critical points, however, Rothman and Post concede that introducing a matrix like Table 1 does not necessarily generate determinate results. In other words, simply qualifying a use for a specific type of First Amendment review does not dispose of all issues. For instance, a use of a name, identity, or likeness on or in connection with a commodity might be a fair use, despite diminishing the value of the persona that is taken and not being part of "public discourse."[214] A helpful second or third factor—after contribution to public discourse and impact on the value or integrity of a persona—might be intent to confuse, to tarnish a reputation, or to make a false association or claim of sponsorship. Each square within the matrix might therefore be divided in two based on a mens rea standard. That might help provide clear guidance and adequate breathing space for free speech, while accounting for the *Zacchini* interests of endorsers and performers from protection against exploitation.

Amendment, and the right of publicity as a right of dignity—which they define as implicating "highly offensive" deployments or uses of personas, but in practice seem to associate with sex tapes, or nude or risqué images, although a soundalike and a biopic are also referenced. See Rothman & Post, supra note 41, 89, 93–4, 122–23, 131–32, 135–39, and 167–68.

214. Imagine, for example, that instead of being playable in a video game or viewable on a t-shirt, an image of an athlete or actor was part of a montage of the "greats," the "greatest," or the "GOATs," which might be a transformative commodity on the model of copyright fair use. *Cf.* Hart v. Elec. Arts, Inc., 717 F.3d 141, 165 (3d Cir. 2013) (fair or transformative use of athletic likeness); ETW Corp. v. Jireh Pub., Inc., 332 F.3d 915, 925–27 (6th Cir. 2003) (aesthetically relevant use of athlete's trademarked name—and likeness—in montage or collage or great golfers, which athlete had joined by competing in the Masters at Augusta National Golf Club) (citing Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989)); Volkswagenwerk Aktiengesellschaft v. Church, 411 F.2d 350, 352 (9th Cir. 1969) (fair use of terms "Volkswagen" or "VW" by repair service, which is allowed "may advertise to the public that he repairs appellant's cars"). Like a nominative use, a First Amendment use under *Rogers* and its progeny might also be referred to informally as a "fair use." *See, e.g.*, Amy McFarland, *The Last Dance? The Future of the "Rogers Test" After the Jack Daniel's Decision*, Arent Fox Schiff (Mar. 28, 2024), https://www.afslaw.com/perspectives/alerts/the-last-dance-the-future-the-rogers-test-after-the-jack-daniels-decision [https://perma.cc/A67S-RLQ3] (although "[m]any titles [of films etc.] can still be cleared for use based on standard likelihood of confusion and nominative fair use analysis . . . , media and entertainment companies should be prepared to expend more in legal fees defending title dispute cases moving forward . . . ."); Jacob Schneider, *The Metaverse: Artistic Uses of Trademarks in Virtual Spaces*, Holland & Knight LLP (Oct. 17, 2022), https://www.hklaw.com/en/insights/publications/2022/10/the-metaverse-artistic-uses-of-trademarks-in-virtual-spaces [https://perma.cc/N5KN-EKPS] ("It is a fair expressive use to parody trademarks in creative works . . . . All of these fair uses apply to the metaverse.") (citing Mattel v. MCA Records, 296 F.3d 894, 901 (9th Cir. 2002)); *see also* Erica B.E. Rogers, *Trademark Infringement Is No Joke!: Jack Daniel's Properties, Inc. v. VIP Products LLC*, Ward and Smith, P.A. (June 8, 2023), https://www.wardandsmith.com/articles/trademark-infringement-is-no-joke-Jack-Daniels-Properties-Inc-v-VIP-Products-LLC [https://perma.cc/D9M4-9CNU] ("The Court in *Rogers* provides a parody fair use defense – if the trademark is not used in a trademark way, then it's not infringement.").

Some form of actual malice standard makes sense in copyright disputes involving such activities as blogging, online reaction videos, and other public discourse.[215] The reason is similar to that provided in libel cases like *Sullivan* and in false endorsement cases involving digital manipulation or multimedia, such as *Hoffman*—ensuring "breathing space" for fair comment.[216] In a non-*Sullivan* world, some people might be willing to discuss public officials' misdeeds or character defects in reliance on the affirmative defense of truth, indifference to or ignorance of legal consequences, or defenses such as absolute legislative or judicial immunity; still, such options are not sufficient to protect the speech of all those who might negligently misstate the record. Similarly, while many people would engage in commentary that references or imitates copyrighted or trademarked material in reliance on fair use, noninfringement, or other internal doctrines, the vagueness of these doctrines chills the speech of those uncertain as to what qualifies as a fair or noninfringing use.[217]

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215. *See* Hannibal Travis, *Free Speech Institutions and Fair Use: A New Agenda For Copyright Reform*, 33 Cardozo Arts & Ent. L.J. 673, 723–27, 732 (2015).

216. *See* N.Y. Times Co. v. Sullivan, 376 U.S. 254, 265–69, 280–82, 285, 292 n. 30 (1964); Hoffman v. Cap. Cities/ABC, Inc., 255 F.3d 1180, 1185–86, 1189–90 (9th Cir. 2001).

217. *See, e.g.*, Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 545 (1985) (Second Circuit rejected copyright liability for "scoop" of presidential memoirs' contents, the court being "especially influenced by … its conviction that it is not 'the purpose of the Copyright Act to impede that harvest of knowledge so necessary to a democratic state' or 'chill the activities of the press by forbidding a circumscribed use of copyrighted words.'") (internal citation omitted); *id*. at 604 (Brennan, J., joined by Marshall and White, JJ., dissenting) (imposing copyright liability for commenting on memoirs and "information" will be "risking the robust debate of public issues that is the 'essence of self-government'") (internal citation omitted); Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 580 (1977) (Powell, J., joined by Brennan and Marshall, JJ., dissenting) ("The Court's holding that the station's ordinary news report may give rise to substantial liability has disturbing implications, for the decision could lead to a degree of media self-censorship."); Aufderheide & Jaszi, *supra* note 202 (noting widespread self-censorship of documentary film due to copyright "clearance culture"); Bohannon, *supra* note 119, at 682 (vague infringement tests chill speech in absence of robust First Amendment defenses); Glynn Lunney, *Trademark Monopolies*, 48 Emory L.J. 367, 392–94 (1998) (making similar point about trademark's likelihood-of-confusion standard); *see also* Barton A. Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement,* 94 Calif. L. Rev. 1581, 1582–84 (2006) (trademark infringement standards are subject to circuit splits and are infamously malleable); Mark A. Lemley, *Our Bizarre System for Proving Copyright Infringement,* 57 J. Copyright Soc'y U.S.A. 719, 719 (2010) (circuit splits and uncertainty about what constitutes copyright infringement, including bizarre standards focusing on "feel" of a work or series of works); Anthony Zangrillo, *The Split on the Rogers v. Grimaldi Gridiron: An Analysis of Unauthorized Trademark Use in Artistic Mediums,* 27 Fordham Intell. Prop. Media & Ent. L.J. 385, 403–14 (2017) (circuit split and related uncertainties regarding nominative fair use, historical use of trademarks or athletes' names or likenesses, and so on); *cf*. Daniel Gervais and Julie M. Latsko, *Who Cares About the 85 Percent? Reconsidering Survey Evidence of Online Confusion in Trademark Cases*. 96 J. Pat. & Trademark Off. Soc'y 265, 268–69, 277–78 (2014) (despite reasonable consumer standard, unclear how trademark infringement

A. *Comment, Criticism, and Aesthetic Identity in IP Disputes*

The essence of the argument in *Harper & Row* and *Warhol* as to why artistic and journalistic liberties are not shielded from copyright restrictions under the First Amendment boils down to congressional practice.[218] The Continental Congress decided to include an Authors and Inventors Clause in Article I, and the United States Congress restricted copying creative expression since 1790 and again in 1976. Uncritical deference to legislative practice means that the First Amendment is of little use in many cases of commentary on copyrighted or trademarked matter. While the fair use doctrine was supposed to ensure the breathing space for free speech that *Sullivan* guarantees as against libel claims, *Warhol* and *Campbell* undermine fair use and make it quite difficult to successfully leverage free speech.[219] In other words, the actual practice of Congress after ratifying the First Amendment must limit the exercise of free speech or free press rights, even when the speaker's or publisher's own speech or message is at issue rather than that of their client, or a customer for whom they act as a carrier or storage space.

A right to comment is a solution to the problem of copyright infringements involving new meanings, messages, and explanations. It goes some way towards protecting even commodities like t-shirts, mugs, or toys from overbearing copyright or trademark claims, reminiscent of *Comedy III Productions v. Gary Saderup, Inc*.[220] The *Comedy III* decision is itself Warhol-esque in recognizing that one need not create a parody, a dry review, or a classroom lecture in order to enjoy the freedom of speech. As the California Supreme Court explained in that case:

> It is admittedly not a simple matter to develop a test that will unerringly distinguish between forms of artistic expression protected by the First Amendment and those that must give way to the right of publicity. Certainly, any such test must incorporate the principle that the right of publicity cannot, consistent with the First Amendment, be a right to control the celebrity's image by censoring disagreeable portrayals. Once the celebrity thrusts himself or herself forward into the limelight, the First Amendment

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disputes involving confusion of a fringe minority of potential consumers will be resolved, in light of circuit splits and other splits in authority on reasonableness, surveys, etc.).

218. *See, e.g.*, *Harper & Row*, 471 U.S. at 558 (First Amendment inapplicable because Framers and Congress intended strong copyright incentives and narrow fair use doctrine, typically available when there is a market failure); *cf.* Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508, 529–30 (2023) (fair use ruled less likely in cases of "transformative" uses that overlap with derivative work right enacted by Congress, which had to take priority); *id.* at 560 (Kagan, J., joined by Roberts, C.J., dissenting) (majority curtailed expressive freedom with its decision).

219. *See supra* notes 142–43, 145 and accompanying text.

220. Comedy III Prods., Inc. v. Gary Saderup, Inc. 21 P.3d 797 (Cal. 2001). Warhol-esque in reference to this discussion refers to reminiscent of the freedom of pop art, not the restrictive approach of the *Warhol* decision.

> dictates that *the right to comment on*, parody, lampoon, and make other expressive uses of *the celebrity image must be given broad scope*.[221]

The *Comedy III* formula, by recognizing a right of free comment extending to "other expressive uses" of intellectual property, helps reassure the creative speaker, someone who is truly articulating a distinctive message of their own like an artist or novelist, of a freedom of speech. A speaker has a right to comment on brands and celebrity identities (without reproducing a brand/identity solely to propose a for-profit sale, in the words of *Hoffman*).[222] In copyright terms, the First Amendment test should inquire into whether a work has material differences from another work that it uses, such as new commentary, rather than waving away differences with the talisman "plagiarism."[223] Such a fair comment principle expands the First Amendment right of aesthetic and cultural expression to cases in which authors, brands, or people being depicted sue, rather than state prosecutors. It does not commit the error of *Warhol* or *Jack Daniel's*: using a statute to narrow a constitutional right, namely, the right to add meaning or message to existing expressions, whether the name and design of products or the features of creative works.

Early on in the scholarly and judicial debates on copyright and the First Amendment, Melville Nimmer observed that an absolute interpretation of the First Amendment could not be the correct one, for then we could have no copyright laws at all, which he found absurd.[224] My response is that while creating copyright liability for mere reproductions and distributions (as the Act of 1790 did) might not meaningfully abridge the freedoms of speech or of the press, the post-1909 or post-1976 acts did so in how they micromanage quotations, adaptations, and so forth.[225] A principle of fair comment would restore a freedom of speech that existed with respect to copyrighted works in the eighteenth and nineteenth centuries, and prevent its abridgment as the First Amendment commands.[226]

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221. *Id.* at 807 (emphasis added).
222. Hoffman v. Cap. Cities/ABC, Inc., 255 F.3d 1180, 1186 (9th Cir. 2001) (emphasis added).
223. *Compare, e.g.*, Warner Bros., Inc. v. American Broad. Cos., 654 F.2d 204, 211 (2d Cir. 1981) ("defendant may legitimately avoid infringement by intentionally making sufficient changes in a work which would otherwise be regarded as substantially similar to that of the plaintiff's"), *and id.* ("an examination of the differences between two works may reveal the absence of substantial similarity" as when there are "substantial differences") (internal quotation marks and citation omitted), *with* Rogers v. Koons, 960 F.2d 301, 308 (2d Cir. 1992) ("no copier may defend the act of plagiarism by pointing out how much of the copy he has not pirated") (citing cases), *and* Sid & Marty Krofft Television v. McDonald's Corp., 562 F. 2d 1157, 1169 (9th Cir. 1977) (similar).
224. *See, e.g.*, Melville B. Nimmer, *The Right to Speak from* Times *to* Time*: First Amendment Theory Applied to Libel and Misapplied to Privacy*, 56 Calif. L. Rev. 935, 937 (1968).
225. *See* Hannibal Travis, *Of Blogs, eBooks, and Broadband: Access to Digital Media as a First Amendment Right*, 35 Hofstra L. Rev. 1519, 1559–60 (2007).
226. Folsom v. Marsh, 9 F. Cas. 342, 345 (C.C.D. Mass. 1841) (Story, J.) (under nineteenth century law, copyright law permitted reviews, as well as scholarship and research in

B. *Extending Parodist Rights to Authors of Commentary*

The comment-parody distinction of *Campbell* and *Warhol* must be unraveled to bring copyright law's First Amendment into the twenty-first century.[227] This is consistent with the Rothman-Post framework for right of publicity cases implicating the First Amendment, in which viewpoint distinctions would be repealed, even when a use is commercial speech in terms of doing no more than promoting a paid transaction. The mandate of doing away with invidious viewpoint distinctions has particular force since *Matal v. Tam*.[228]

The line of cases from *Zacchini* to *Elster* went awry in adopting a First Amendment theory of speech/press "reasonableness." An article by Melville Nimmer prophesied as much. The Supreme Court's opinions, as Nimmer might have foretold, were destined to be unclear, influenced by popular passions, and deferential to recent legislative compromises (like the Copyright Act of 1976 and Federal Trademark Dilution Act of 1995).[229] The problem, Nimmer explained, was:

> If we may not cling to the anchor of an absolute, unqualified rule, is not the alternative no rule at all? If the judges are not required to protect all speech, doesn't this mean that the only speech which will be protected is that which, on an ad hoc basis, the judges may from time to time approve? That this fear is not fanciful is all too clearly illustrated by a line of cases in which the Court engaged in what has been called ad hoc balancing.[230]

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form of "real, substantial condensation of the materials" from existing books, letters, or articles in journals); Glynn Lunney, *Trademark Law's Judicial De-evolution*, 106 Calif. L. Rev. 1195, 1208, 1212, 1249 (2018) (in nineteenth century law, a use like that in *Jack Daniel's* or *Elster* would not be actionable as not being an infringing "nearly identical mark" as applied to merchandise of "same … properties"; thus, unauthorized sports team merchandise was the "norm" until the mid-1970s) (citing Act of Mar. 3, 1881, ch. 138, 21 Stat. 502, 503–04); Madow, *supra* note 12, at 130 (right of publicity did not receive judicial approval until 1950s) (citing Haelan Lab'ys, Inc. v. Topps Chewing Gum, 202 F.2d 866 (2d Cir. 1953)); Travis, *supra* note 226.

227. *See supra* note 47 and accompanying text (as of late twentieth century, a viewpoint-neutral prohibition such as on obscenity or indecency required exemptions for works having artistic, social, or political value in order to be consistent with First Amendment); *see also supra* notes 161-63 and accompanying text (First Amendment doctrine as of 2020s clarified that denial of a trademark can unlawfully suppress protected speech if it occurs under circumstances in which trademark relating to speech having a more positive or politically-correct content would have been granted); *supra* note 164 and accompanying text (as of late twentieth century, First Amendment rule was that unjustly ignored the principle that speech was not unprotected simply due to commercial motivation underlying it or connection to interstate or foreign commerce).

228. *See generally* Ramsey, *supra* note 32.

229. *See, e.g.*, Melville B. Nimmer, *The Right to Speak from* Times *to* Time*: First Amendment Theory Applied to Libel and Misapplied to Privacy*, 56 Calif. L. Rev. 935, 939–41 (1968).

230. *Id.* at 938. Nimmer discusses *Barenblatt v. United States*, 360 U.S. 109 (1959), as an example of balancing processes often ending up with speech restrictions. *See id.* at 950. In his dissent there, Justice Hugo Black, an anchor of the Warren Court's Bill

Responsiveness to public opinion may or may not have been an influential factor lurking behind the *Tam* and *Brunetti* decisions.[231] In any event, they tracked Nimmer's prediction that a hard-fought recent legislative compromise might be more resistant to judicial review.[232] The statutory bars struck down in *Tam* and *Brunetti* arguably addressed a long-ago articulated preference of Congress, which may have been an afterthought even at the time, rather than a recent effort to dramatically expand trademarks so as to threaten commentary or satire.[233] Many of the recent federal compromises that have been struck down have been quite poorly drafted and, with a few exceptions, relatively minor additions to the code books.[234] Other statutes that seem grounded in some prior standard taken from a respected jurist or treatise seem to garner great respect. Examples include the rather overextensive phrasing of sections 1114 and 1125 of the Lanham Act especially as amended by the dilution laws and cybersquatting act, and the exclusive rights and fair use statutes, which have their roots in prior case law (among other places).[235] Acts of Congress in

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of Rights revolution, wrote that his colleagues were wrong to permit "reasonable . . . encroachment[s] upon rights expressly stipulated for in the Constitution by the declaration of rights." *Barenblatt*, 360 U.S. at 142–44 (Black, J., dissenting) (citing 1 ANNALS OF CONGRESS 434–36, 439–43 (1789)).

231. *Cf.* Juliet Dee, *Sweet Baby Jesus, the Band Who Must Not Be Named, and Friends U Can't Trust: Disparaging, Immoral and Scandalous Trademarks in the United States and the European Union*, 53 FIRST AMEND. STUD. 91, 104–13 (2019) (discussing survey evidence and judicial trends suggesting that Patent and Trademark Office enforcement of "political correctness" may not have been overwhelmingly popular, and perception that "marketplace" should decide what is too offensive or disparaging to be used as a trademark or trade name).

232. *See also* Bartholomew & Tehranian, *supra* note 168, at 86–90 (arguing for a traditionalist account of the differences in how the courts have treated First Amendment defenses in right of publicity versus copyright cases, given the firm establishment of the copyright regime and the initially judicially-created hodgepodge that is the right of publicity).

233. *Cf.* Iancu v. Brunetti, 588 U.S. 338, 413 (2019), (Sotomayor, J., joined by Breyer, J., concurring in part and dissenting in part) ("The text of § 1052," at issue in *Tam* and *Brunetti*, "is a grab bag" of seemingly "unrelated concepts.").

234. *See, e.g.*, *Table of Laws Held Unconstitutional in Whole or in Part by the Supreme Court*, CONST. ANNOTATED, https://constitution.congress.gov/resources/unconstitutional-laws/ [https://web.archive.org/web/20210220094524/https://constitution.congress.gov/resources/unconstitutional-laws/] (citing, *inter alia*, 47 U.S.C. § 227(b)(1)(A)(iii) (the government debt collection exception to the federal prohibition on robocalls), 15 U.S.C. § 1052(a) (the immoral or scandalous exception to trademark registrability), 2 U.S.C. § 441b (the prohibition on certain "electioneering communication[s]"), and 28 U.S.C. § 2241(e), (the suspension of writ of habeas corpus on Guantanamo Bay naval station)).

235. *Cf.* Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 549 (1985) ("The statutory formulation of the defense of fair use in the Copyright Act reflects the intent of Congress to codify the common-law doctrine."); Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1261 (11th Cir. 2001) ("It was not until the 1909 Act, which codified the concept of a derivative work, that an author's right to protect his original work against imitation was established."); Chamberlain v. Columbia Pictures Corp., 186 F.2d 923,

general are highly resistant to strict scrutiny under the Constitution, compared to state laws.[236]

While an absolute rule of free speech or unrestrained press publication might seem to be highly unrealistic if not counterproductive in copyright, trademark, and publicity rights disputes, an equally extensive right for comment and criticism as for parody is a first step towards a viable First Amendment.[237] Comment and editorial matter are already recognized as central pillars of public discourse for purposes of First Amendment rights against generally applicable state libel or privacy laws.[238] Fair comment as an exploitation test could shield publications, art works, and even commodities that comment on a matter of public concern and are not a mere "subterfuge" for exploitation.[239] A parody of a trademark of the sort used in *Deere & Co. v. MTD Products*[240] or *Pillsbury Co. v. Milky Way Productions*,[241] or of a copyrighted work like that in *Campbell* or *Dr. Seuss Enterprises v. ComicMix*,[242] could also be covered by the right.[243] As a free speech and free press principle, fair comment would provide

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925 (9th Cir.1951) (suggesting that Lanham Act codified "fundamental requirements necessary to sustain a suit for unfair competition, one such requirement being a direct injury to the property rights of a complainant by passing off the particular goods or services misrepresented as those of complainant."), *disagreed with in* Procter & Gamble Co. v. Chesebrough-Pond's Inc., 747 F.2d 114, 118–19 (2d Cir. 1984).

236. *See generally* Winkler, *supra* note 163, at 818–23.

237. *But cf. id.* at 804 (strict scrutiny provides an opportunity to make "categorical rules" of First Amendment rights, and other rights in Bill of Rights or Fourteenth Amendment).

238. *See* N.Y. Times Co. v. Sullivan, 376 U.S. 254, 268–69 (1964); Hustler Magazine v. Falwell, 485 U.S. 46, 50, 53 (1988); Sorrell v. IMS Health, Inc., 564 U.S. 552, 578–79 (2011).

239. Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 581 (1977) (Powell, J., joined by Brennan and Marshall, JJ., dissenting) (urging a subterfuge/"cover" for "exploitation" standard to defeat First Amendment right in cases of right of publicity violation via the performance right); *see also* Hart v. Electronic Arts, Inc., 717 F.3d 141, 165 (3d Cir. 2013) (advocating this test for "additional transformative elements . . .—i.e., [whether] the work contains 'merely a copy or imitation' of the celebrity's identity," under the *Zacchini* decision and its dissent, as well as Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959 (10th Cir. 1996), Estate of Elvis Presley v. Russen, 513 F. Supp. 1339 (D. N.J. 1981), Comedy III Prods., Inc. v. Gary Saderup, Inc., 25 Cal. 4th 387 (2001), and Guglielmi v. Spelling-Goldberg Prods., 259 Cal. 3d 860, 875–76 (1979)); Hoffman v. Cap. Cities/ABC, Inc., 255 F.3d 1180, 1185–86 (9th Cir. 2001) (applying identity or performance "directly" and entirely as First Amendment standard, so that indirect or partial use—and perhaps montage use as in ETW Corp. —could be free speech).

240. Deere & Co. v. MTD Products, 41 F.3d 39 (2d Cir. 1994) (involving a parody of the John Deere green deer logo in a competitive ad).

241. Pillsbury Co. v. Milky Way Prods., No. C78-679A, 1981 WL 1402 (N.D. Ga. Dec. 24, 1981) (involving a parody of Pillsbury Doughboy).

242. Dr. Seuss Enters. v. ComicMix, 983 F.3d 443, 449 (9th Cir. 2020) (involving an arguable parody of *Oh, the Places You'll Go!* as a manifesto prescribing individualist achievement, using Star Trek's ethos of collective excellence and teamwork as a visual and narrative counterpoint).

243. *Cf.* Restatement (Third) of Unfair Competition § 25(2) (Am. L. Inst. 1995) ("One

a defense where the right of publicity, trademark dilution, or copyright is being asserted against something more expressive than a "direct" and "entire" reproduction of an identity/trademark/work.[244]

V. Conclusion

In *Harper & Row*, the Court ruled 6–3 that paraphrasing and selectively quoting choice passages from the memoirs of a former president and potential presidential primary candidate Gerald Ford were consumptive and exploitive uses of his manuscript. *The Nation*'s claim to fair news reporting with a beneficial purpose of conveying uncopyrightable facts was rejected. Yet Justices William Brennan, Byron White, and Thurgood Marshall issued one of the great First Amendment dissents in the case, warning that news reporting, which was a "prime example" of fair use according to the statutory text, had been disfavored by the majority, threatening open discussion and debate on public figures and official measures.[245] Since then, several other examples of speech and commentary that should have been protected by the First Amendment have been ruled otherwise: Andy Warhol's *Orange Prince*, VIP Products' Bad Spaniels chew toy parody, and Elster's TRUMP TOO SMALL trademark.

In the minimalistic approach of *Warhol* and *Jack Daniels*, the First Amendment is shunted to one side. The right of fair comment and its application to

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who uses a designation that resembles the trademark, trade name, collective mark, or certification mark of another, not in a manner that is likely to associate the other's mark with the goods, services, or business of the actor, but rather to comment on, criticize, ridicule, parody, or disparage the other or the other's goods, services, business, or mark, is subject to liability without proof of a likelihood of confusion only if the actor's conduct meets the requirements of a cause of action for defamation, invasion of privacy, or injurious falsehood."); Jendi B. Reiter, *Trademark Anti-Dilution Laws as Cultural Censorship*, Federalist Soc'y (July 1, 1997), https://fedsoc.org/commentary/publications/trademark-anti-dilution-laws-as-cultural-censorship [https://perma.cc/H7LC-73FE] ("If anti-dilution law is to survive, it must develop a more effective safeguard against the erosion of our freedom to re-evaluate and transfigure the cultural meaning of famous trademarks and the products they represent.").

244. *See, e.g.*, Hart v. Elec. Arts, Inc., 717 F.3d 141, 165 (3d Cir. 2013) ("'merely a copy or imitation'" test for First Amendment defense to Lanham Act claim under the *Zacchini* decision and its dissent, as well as Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959 (10th Cir. 1996), Estate of Elvis Presley v. Russen, 513 F. Supp. 1339 (D. N.J. 1981), Comedy III Prods., Inc. v. Gary Saderup, Inc., 25 Cal. 4th 387 (2001), and Guglielmi v. Spelling-Goldberg Prods., 259 Cal. 3d 860, 875–76 (1979)); Hoffman v. Cap. Cities/ABC, Inc., 255 F.3d 1180, 1185–86, 1189–90 (9th Cir. 2001) ("direct[]" and entire use of identity test for First Amendment defense to Lanham Act claim, which would not be satisfied by a plaintiff who sued over an "abundantly clear" parody) (citing Midler v. Ford Motor Co., 849 F.2d 460, 461 (9th Cir. 1988)); *cf.* White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1406–07 (9th Cir. 1992) (Kozinski, J., dissenting).

245. Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 591 (1985) (Brennan, J., joined by Marshall and White, JJ., dissenting).

postmodern or even simply "pop" culture is not discussed, despite effective briefs on the topic by art law professors and copyright law professors.[246]

This Article attempts to put criticism of public figures in tort law on the same First Amendment footing as comment on brands, personas, and works in IP law. It observes that the right of intervention into public debates is not limited to targeting or attacking others, but extends to speculation or theories of public events, non-parody discussion of private facts, or even misstatements of private facts. It draws upon briefs and other analyses of the viewpoint discrimination problems that afflict the Court's current case law. Finally, it proposes building on mens rea and exploitation tests from trademark and personality law to prevent IP censorship.

246. Brief for Art L. Professors as Amicus Curiae Supporting Petitioners, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508 (2023) (No. 21-869), https://www.supremecourt.gov/DocketPDF/21/21-869/228144/20220616190601481_42518%20pdf%20Dupree%20br.pdf [https://perma.cc/6S2W-3ZEK]; Brief for Inst. for Intell. Prop. & Soc. Just. & Intell.-Prop. L. Professors as Amici Curiae Supporting Respondents, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508 (2023) (No. 21-869), https://www.supremecourt.gov/DocketPDF/21/21-869/233495/20220815140948843_220807a%20Amicus%20Brief%20for%20efiling.pdf [https://perma.cc/TLM5-HUMN]; Brief for First Amend. L. Professors as Amici Curiae Supporting Respondent, Jack Daniel's Props., Inc. v. VIP Prods. LLC, 599 U.S. 140 (2023) (No. 22-148), https://www.supremecourt.gov/DocketPDF/22/22-148/255392/20230223130058120_43246%20pdf%20Tushnet%20br.pdf [https://perma.cc/WR96-KUEY].