Free Speech, Competition, and the Structure of Trademark Law

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I have finished a draft of my paper for the 2014 Intellectual Property Scholars Conference, but I prefer not to publish it on the Internet for wide distribution at this stage. Please email me at lramsey@sandiego.edu and I will send you the draft of the paper. Thanks!

Abstract

In this book project, I explore how legislators, judges, and trademark offices can better protect free expression and fair competition in trademark law. This portion of the book argues that governments will best serve the public interest if they reform trademark law in several ways. First, decision-makers must continue to exclude certain subject matter from trademark protection and enact more limits on the scope of trademark rights, and not just rely on distinctiveness and non-functionality requirements, or on defenses, to safeguard the public domain. We need to be more selective about what can qualify as a trademark, and ensure that the burden of proof is generally placed on the party attempting to use trademark law to restrict the language and designs available for use in the marketplace and beyond. Second, for marks and trade dress that require proof of acquired distinctiveness for protection—such as cartoon characters, descriptive terms, colors, product configurations, scents, sounds, tastes, and textures—the scope of trademark rights should be narrow if governments decide to protect these types of trademarks. Protection of exclusive rights in such marks is more likely to conflict with the legitimate interests of third parties, especially if trademark rights extend to non-identical marks, to dissimilar goods or services, or to harms unrelated to source-confusion. Third, legislatures and courts should implement more categorical rules and rebuttable presumptions in trademark laws to increase clarity, predictability, and efficiency, and allow early resolution of trademark disputes where a particular third party use of a mark is clearly harmful or legitimate. While it may be difficult in some disputes to draw the line between commercial and noncommercial uses of marks, or determine if the defendant is engaged in comparative advertising, news reporting, or other nontrademark uses of the plaintiff's mark, in many cases it is easy to classify this type of unauthorized use of the mark as falling within or outside of a category. Finally, government decision-makers must articulate a justification for each specific trademark doctrine that potentially conflicts with free speech or competition, and explain how that trademark law furthers compelling or important government interests. The starting point should be freedom of expression and the ability to use all words, symbols, and designs to compete in the marketplace. Trademark rights should be an exception to this baseline of free expression and fair competition, not the other way around.