

A PLEA FOR GENERICIDE DEFENSES IN ARTISTIC WORKS

Xiyin Tang

INTRODUCTION

In recent years, even those outside the legal community have come to know the two-word phrase "fair use."¹ It's become a nouvelle vogue topic of sorts, the darling child of transformativeness and critical commentary meant to save the draconian and nonetheless-still-expanding intellectual property laws from overreach.² Yet fair use is riddled with problems, as we all know: it's a defense, not an affirmative right; there are no bright-line rules; it's case-by-case; it's notoriously unpredictable.³ Nonetheless, everything from rap songs to chewy dog toys have been saved by fair use, which is an affirmative defense for both copyright and trademark infringement charges.⁴ In recent years, what I like to call the

¹ See 17 U.S.C. § 107; 15 U.S.C.A. § 1115(b)(4). Because genericide is strictly a trademark defense, this Article will focus on fair use case studies in the trademark context. Nonetheless, fair use case law in the copyright context informs and is quite analogous to that in the trademark context, not least of which is its emphasis on commentary on the original work/mark (i.e. parody). See, e.g., *Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999) (“[W]hatever protection is to be afforded a trademark parody must be informed by the Supreme Court’s recent elucidation in the copyright context of parodies allegedly protected by the defense of fair use.”); *Anheuser-Busch, Inc. v. Balducci Publications*, 28 F.3d 769, 774 (8th Cir. 1994) (comparing the fair use doctrine’s analysis of parodies in the copyright context to the present trademark parody defense). Therefore, throughout this Article, I will sometimes refer to copyright fair use cases, by way of elucidating concepts and critical court decisions on, for example, parody and satire.

² In *Eldred v. Ashcroft*, 537 U.S. 186, 219-20 (2003), the Court specifically cites fair use as a “built-in First Amendment accommodation...”, thus affording “considerable latitude for scholarship and comment.” *Id.* (citing *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 560 (1984)).

³ See, e.g., *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1171 (9th Cir. 2012); *Dellar v. Samuel Goldwyn, Inc.*, 104 F.2d 661, 662 (2d Cir. 1939) (per curiam); Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978-2005*, 156 U. PA. L. REV. 549, 552 (2008); Jessica Litman, *Billowing White Goo*, 31 COLUM. J.L. & ARTS 587, 596 (2008); David Nimmer, “*Fairest of Them All*” and *Other Fairy Tales of Fair Use*, 66 LAW & CONTEMP. PROBS. 263, 287 (2003).

⁴ These cases span the range of copyright and trademark, but note the focus on parody as transformative of the original in both. Cf. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 114 S. Ct. 1164, 127 L. Ed.

“postmodern problem” has highlighted yet another glaring inadequacy of the fair use doctrine: its insistence that the new work somehow comment on or transform the original work.⁵ And yet the postmodern condition suggests that it is precisely the inability of a work to be unique enough *to* parody (in which the copyrighted or trademarked work, with its “original and separate expression, attributable to a different artist”⁶ is the object of the new work’s ridicule) that makes art forms like appropriation so urgent today.⁷

There is a lesser-mentioned safeguard against intellectual property overreach that *does* acknowledge that not all works qualify as significant, unique, or transformative. It is genericide, and it is the bastard child of all defenses, relegated to the backseat of trademark law—and general scholarly interest—in a world in which fair use reigns.⁸ But genericide does everything fair use does not do: it recognizes anti-uniqueness in an age rife with appropriation art (in which images and objects are taken straight—and often wholesale—from our collective pop culture⁹), satire (in which the copyrighted work is used as a vehicle for general commentary on the state of society, a genre of work, and so on, rather than targeting the work itself¹⁰), and the eradication of the author; it recognizes the right of the

2d 500 (1994). However, with the recent Second Circuit decision in *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013), in which the court held that commentary on the original was not needed for a fair use defense, the tide may be starting to turn at least where the emphasis on commentary on the original (but not necessarily transformativeness) distinction is concerned, and at least in the copyright context. *Cariou’s* implications for fair use in the trademark context are unclear, however.

⁵ See, e.g., *Henley v. DeVore*, 733 F. Supp. 2d 1144, 1155 (C.D. Cal. 2010); *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1567 (S.D. Cal. 1996) *aff’d*, 109 F.3d 1394 (9th Cir. 1997); *Anheuser-Busch, Inc. v. Balducci Publications*, 28 F.3d 769, 774 (8th Cir. 1994); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Grp., Inc.*, 886 F.2d 490, 494 (2d Cir. 1989).

⁶ *Blanch v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992).

⁷ See *infra* Part III; Xiyin Tang, *That Old Thing, Copyright ...: Reconciling the Postmodern Paradox in the New Digital Age*, 39 AIPLA Q.J. 71, 88-92 (2011).

⁸ A recent search on Westlaw revealed over 10,000 cases and 3,000 articles discussing fair use, as compared to a paltry 238 articles discussing genericide and a mere 54 cases.

⁹ *Blanch v. Koons*, 467 F.3d 244, 246 (2d Cir. 2006).

¹⁰ *Id.* at 254-255.

public, *not* the trademark owner, to decide a mark's fate. It is audience-friendly and First Amendment-approved.¹¹ So why don't we talk about it enough? This Article makes a plea for genericide in trademark infringement cases where many would jump to argue fair use instead. It argues that, rather than focusing on arguments of transformativeness in the hopes of winning a fair use defense, artists should emphasize that they did *not* use the work as a means of targeting the work itself—that is—anti-transformativeness. In doing so, the dialogue around defenses to trademark infringement can appropriately begin to shift away from the narrow strictures of fair use and toward arguments that build on satire, pastiche (deadpan parody that purely mimics, and does not mock, the appropriated work), and appropriation. Further, the more we talk about the genericity of a mark, the more likely it is that the mark will be deemed generic.¹² Conversely, the more we focus on a mark's uniqueness in crafting a parody defense, the weaker the argument for genericide of the mark, and the less defensible uses like satire, pastiche, and appropriation (the hallmarks of contemporary art-making or meaning-making) become. Lastly, while the doctrine of genericide is not applicable to copyright infringement cases, making genericide arguments—with its attendant focus on satire, pastiche, and appropriation—in artistic-use trademark infringement cases will legitimize non-parodic uses so that courts, in copyright infringement cases, will become more open to them. And as the recent Second Circuit

¹¹ See, e.g., Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks As Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 406 (1990).

¹² This is so because courts often look to the expressive contexts in which marks are used—for example, newspapers or dictionaries—to determine whether a mark has become generic. See Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789, 1791 (2007).

decision in *Cariou v. Prince*—which is novel (and alone) in holding that a work need not comment on the original¹³—may suggest, that revolution is already underway.

The idea for this Article came from a place that would, in modern-day trademark jurisprudence, seem decidedly unfair. I had attended a fashion and art law panel in which artists and trademark owners converged. The artists, it turned out, were making striking works with the owners' marks: Louis Vuitton marks that were splashed across bold canvases with the "LV"s melting and dripping; collages of found objects and advertising symbols that included everything from Lucky Strike cigarettes to Chanel signs. The mark owners, of course, were not pleased. One of the artists, in defense, had replied to a lawyer representing Louis Vuitton: But we're not using your marks as any specific commentary on Louis Vuitton, really—it's just more about the idea of luxury and the prominent role it plays in modern-day society. The artist's lawyer jumped in; "Look," he had said, "I think we can all agree that this is fair use."

But *is it*? The artist's statement that he was not using the marks as commentary on the mark should set off alarm bells. But this idea of using a mark to represent an *idea*—now *this* made me think. Isn't genericide, after all, about what happens when a mark ceases to signify the source, but rather a category of good? Louis Vuitton not for Louis Vuitton, but Louis Vuitton as merely a stand-in for this vast category of luxury goods? And what *about* that Jeff Koons sculpture that lost in *Rogers v. Koons*, the one where Koons' defense lay in "an artistic tradition of commenting upon the commonplace" and lost, under (albeit copyright's) fair use's parody exception?¹⁴ The common, the generic...Koons' definitive

¹³ *Cariou v. Prince*, 714 F.3d 694, 698 (2d Cir. 2013).

¹⁴ *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992).

postmodern art show, titled, appropriately, the “Banality” show, the genericity of marks...now we are onto something!¹⁵

This Article will proceed in four Parts. First, it introduces the concept of genericide: what it is, the rationale behind it, and instances in which the defense has been accepted or rejected. Then, I will delve into the problem with the fair use doctrine in contemporary trademark case law. The third Part will focus on why genericide has become even more relevant today, in that it allows for reference to a mark as shorthand for a *categorical*, rather than the ability of a mark to signify, and to be unique in its signification. And, lastly, I outline what a genericide approach to artistic use would look like. I believe, and argue here, that art, in a world where more genericide defenses are considered, may be headed toward brave new places.

I. WHAT IS GENERICIDE?

A. Rationalizing Genericide

It is an oft-repeated mantra of trademark law that it has two goals: to reduce search costs for consumer goods, hence benefitting the public, and to protect the hard-earned goodwill of a mark, hence benefitting owners, as well.¹⁶ Genericide, on the other hand, refers to the process by which a once-protectable mark loses its trademark status. Generic

¹⁵ I acknowledge that the *Koons* cases were copyright fair use, not trademark fair use, cases. But the two doctrines, especially in their analysis of parodies, owe much to each other. *See supra* note 1 for an explanation of this Article’s use of both copyright and trademark decisions in its discussion of fair use.

¹⁶ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (1995) (“If the trademark owner succeeds in creating a favorable image for its trademark in the marketplace, the mark itself can become a significant factor in stimulating sales. This ability of a mark to generate good will through advertising has also gained recognition under the law of trademarks.”); William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 268-270 (1987) (describing trademarks as a “shorthand way of telling [the consumer] that the attributes are the same as that of the brand [he] enjoyed earlier”).

marks, rather than referring to the unique source of a product, refer instead to the *category* of product.¹⁷ In this instance, the economic rationale behind trademarks—reducing search costs—is depleted. After all, if the public does not understand “aspirin”¹⁸ to refer to the producer of the product, but rather only a *type* of product, allowing one producer to monopolize the term “aspirin” would inhibit competition while creating no gains for consumers, who understand all “aspirin” to be merely a type of medicine meant to relieve general pain. Compare this outcome with that of trademarked pain relievers that have *not* undergone genericide—for example, Midol, Excedrin, or Tylenol. Consumers would understand Midol to be particularly useful for symptom relief associated with menstrual cramps, Excedrin to be used especially for migraines or strong headaches, and Tylenol as effective for relieving cold symptoms. These are specific attributes of a product that consumers associate with a brand, the goodwill for which its producers have spent countless amounts of money shoring up. The name “aspirin,” on the other hand, retains no special goodwill in and of itself—when asked for aspirin, one might very well point you to Midol, or Excedrin or Tylenol.

The story of aspirin’s death by genericide elucidates the rationale behind genericide itself, under a doctrine known as “death by patent” or the “primary significance test.” Aspirin, a once trademarkable name, was also a patented product in the early 1900’s.¹⁹ When the product’s period of patent protection expired, the question naturally became: what will competitors call their versions of aspirin? The makers of aspirin had not endowed it with an alternate name—unsurprisingly, Judge Hand, in *Bayer Co. v. United*

¹⁷ King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 580 (2d Cir. 1963).

¹⁸ I use this example because aspirin was deemed generic in the 1921 case *Bayer Co., Inc. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921).

¹⁹ *Id.* at 509.

Drug Co., found that the term “monoaceticacidester of salicylic acid” or “acetyl salicylic acid” was unrecognizable by consumers.²⁰ Thus, the term “aspirin” fell out of trademark’s favor and into the hands of the public domain.

Or consider the Supreme Court’s reasoning in *Kellogg Co. v. National Biscuit Co.*, in which the name “Shredded Wheat” was deemed generic—also, as it turns out, under the “death by patent” scheme:

It equally follows from the cessation of the monopoly and the falling of the patented device into the domain of things public that along with the public ownership of the device there must also necessarily pass to the public the generic designation of the thing which has arisen during the monopoly.²¹

Key to the Court’s reasoning is the idea that to foster competition, the word must be given over to genericism,²² and that to benefit the public, one owner should not be entitled to monopolize a word which has now passed into the common vernacular as describing a mere type of good. The “shredded wheat” decision ushered in what is known as the “primary significance” test, in which a court requires the trademark holder to “show that the primary significance of the term in the minds of the consuming public is not the product but the producer.”²³ In the case of shredded wheat, the Court determined that “shredded wheat” was merely “the term by which the biscuit in pillow-shaped form is generally known by the public.”²⁴ Hence, the term was generic.

²⁰ *Id.* at 511.

²¹ *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118, 59 S. Ct. 109, 113, 83 L. Ed. 73 (1938).

²² Note that I use the words “genericity,” “genericide,” and “genericism” in this Article. I use “genericity” to refer to the status of a mark tending toward the generic, “genericide” to refer to the process by which a mark *becomes* generic, and “genericism” to mean the decidedly generic state of a mark.

²³ *Kellogg Co.* at 118.

²⁴ *Id.* at 113.

What emerges from these decisions is a keen emphasis on public perception, and, surprisingly, on the public's use of language, both in the purchasing and expressive contexts. In other words: should the trademark owner be entitled to control the way the public refers to a good, when, in reality, no other appropriate designation of the thing exists? In following with what I call the "audience-friendly" (rather than simply buyer-friendly) nature of genericism, consider the fact that courts often consider non-competitive uses of a trademarked term to determine whether it has undergone genericide. Rather than focusing purely on the use of the word in the consumer context, courts will turn to uses of the term in expressive contexts, such as dictionary definitions and newspaper usage, to determine whether a mark is generic.²⁵ This is remarkable, as genericism takes trademark law outside of the law and economics focus on consumer protection and into the realm of the vernacular, focusing on the way a word is used culturally, not just competitively.²⁶ In this way, as I argue in Parts II and III, *infra*, genericism is more concerned with semiotics and linguistics, with culture and pop, than any of trademark's other doctrines, *including* fair use.

Of course, there are arguments to be made that genericide in fact encourages mark-owners to engage in anti-linguistic, anti-culture, anti-vernacular behavior.²⁷ These arguments inevitably focus on the fact that the threat of genericide leads mark owners to engage in excessive "policing" of their marks or else to create advertising campaigns that

²⁵ See *supra* note 12.

²⁶ This line of thought—of trademarks as language rather than source identifiers—has gained much ground in the past decade. See, e.g., Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621 (2004).

²⁷ Laura Heymann, for example, has argued that trademark law too often encourages courts and trademark owners to dictate how consumers use certain words. Laura A. Heymann, *The Grammar of Trademarks*, 14 LEWIS & CLARK L. REV. 1313 (2010).

attempt to dictate how we use words themselves.²⁸ I take up this argument in Part IV, where I contend that the threat is, in fact, less real than some would make it out to seem. Before we begin down that knotty path, a brief look at the doctrine of genericide in practice will begin to reveal the self-reinforcing nature of the doctrine as an equitable balancing of rights between the mark-owner and the public.

B. Instances and Examples

1. *The Murphy Bed Case: Power to the Public*

A Murphy bed today describes any bed that folds down from the wall and folds back up when not in use, but before the Second Circuit deemed it generic in 1989, only one company (the Murphy Door Bed Co.) could refer to the specific style of bed as a Murphy bed.²⁹ Other companies described this type of bed as “wall beds,” “concealed beds,” “disappearing beds,” or “authentic adjustable hydraulic beds,”³⁰ proving the point that a mark need not be deemed generic solely on the basis that there remains no other appropriate word with which a competitor could describe it by.³¹ Rather, in *Murphy Door*

²⁸ *See id.*; Desai & Rierson, *supra* note 12, at 1834.

²⁹ *Murphy Door Bed Co., Inc. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 98 (2d Cir. 1989).

³⁰ *Id.*

³¹ This pro-competition, law and economics-type reasoning has been expounded by courts as one of the key principles underlying genericide. *See A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 304 (3d Cir. 1986) (“Underlying the genericness doctrine is the principle that some terms so directly signify the nature of the product that interests of competition demand that other producers be able to use them even if terms have or might become identified with a source and so acquire ‘de facto’ secondary meaning.”); *Am. Cyanamid Corp. v. Connaught Labs., Inc.* 800 F.2d 306, 308 (2d Cir. 1986) (“Consumers will not benefit...if trademark law prevents competitors from using generic or descriptive terms to inform the public of the nature of their product.”).

Bed Co., Inc. v. Interior Sleep Systems, Inc., the Second Circuit deemed the mark generic based on a thrilling concept of “expropriation by [the] public.”³²

The case came shortly on the heels of a refusal by the Trademark Trial and Appeal Board to register plaintiff Murphy Door Bed Co.’s mark “Murphy bed,” finding instead that the “Murphy bed has for a long period of time been used by a substantial segment of the public as a generic term for a bed which folds into a wall or a closet.”³³ Upon learning of this finding, the defendant formed the “Murphy Bed Co. of America” and promptly began sending out his own manufactured beds to buyers as “Murphy beds,” despite protestations from plaintiff. The trial court found for plaintiff on the basis that a “secondary meaning”—an acquired distinctiveness or association in the minds of the public between the mark and its source—had been attributed to the name Murphy by the general public.³⁴ The Second Circuit, on the other hand, found that a generic mark is only entitled to trademark protection on the basis of secondary meaning in situations in which “a generic term already in public use later acquires secondary meaning by virtue of a product developer’s unique use, thus warranting trademark protection.”³⁵ This, as it turns out, was precisely the Supreme Court’s reasoning underlying the next case. In *this* instance, however, the Second Circuit deemed secondary meaning, well, meaningless in cases where “the trademark was initially an invented term and lost its protection because of later *public expropriation*.”³⁶

The Court’s reasoning is sound, because in instances where a once-protectable mark undergoes genericide, an argument can always be made that the mark is rife with

³² *Murphy Door Bed Co.*, at 101 (citing *DuPont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75, 81 (2d Cir.)).

³³ *Id.* at 98.

³⁴ *Id.* at 99.

³⁵ *Id.* at 102.

³⁶ *Id.* (emphasis added).

secondary meaning. In fact, in many ways, genericide is a testament to *too much* secondary meaning, to the *fame* of a mark—so famous and so self-explanatory, in fact, that the name becomes shorthand for an entire host of attributes or as a means of referring to a general category of goods.³⁷ To allow for a secondary meaning defense in cases of public expropriation would effectively kill the ability of the public to appropriate a mark into the public vernacular. On the other hand, the Second Circuit and subsequent courts’ acknowledgment that secondary meaning matters in cases where once-generic terms gained uniqueness through the hard work of a product developer speaks to trademark law’s encouragement of shoring up goodwill by building up quality.³⁸

This focus on public expropriation in the case of once-unique marks that have undergone genericide places the emphasis on how words are actually *used*, not on how mark owners *intend* for them to be used. Likewise, the Second Circuit cautions that where a “mark has entered the public domain beyond recall, policing is of no consequence to a resolution of whether a mark is generic.”³⁹ A mark owner, despite his best efforts, is therefore not the ultimate arbiter of whether a word may enter the public domain.

Yet the court in *Murphy Door Bed* was also careful to hold that “where the public is said to have expropriated a term established by a product developer, the burden is on the defendant to prove genericness.”⁴⁰ This burden-shifting is a recognition that the “presumption of nongenericness of a product name in the case of apparent public expropriation is justified by the commercial protection a developer of innovations

³⁷ For example, in Part III, I consider the case of Cristal and the evocation of the mark by the hip-hop community to signify a certain (self-described) “bling lifestyle.”

³⁸ See Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 466 (2005).

³⁹ *Murphy Door Bed Co.*, at 101.

⁴⁰ *Id.*

deserves.”⁴¹ Thus the doctrine draws an appropriate balance between rewarding a mark owner for his efforts and disallowing a monopoly on the use of a word that has been incontestably adopted into our collective vocabulary.

2. *A Nascent Use of Genericide in the Expressive Context: San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*

If this Article attempts to advance an argument for the viability of genericide defenses in expressive contexts, it acknowledges that there have already been nascent attempts to invoke the defense in such contexts. *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*⁴² is unique in that it is one of the few cases focusing on genericide in an expressive, rather than competitive, context. Petitioners San Francisco Arts & Athletics, Inc. (“SFAA”) was a nonprofit California corporation that sought to use the phrase “Gay Olympic Games” to describe its 9-day athletic event.⁴³ As appropriately recognized in Justice Brennan’s dissent, SFAA’s use of the word “Olympic” “promote[s] a realistic image of homosexual men and women that...help[s] them move into the mainstream of their communities.”⁴⁴ The use of the word “Olympic” is hence expressive, meant to evoke a deep-seeded history of the Olympic games and the values of camaraderie and heroism inherent in its associations with the ancient Greek games.

⁴¹ *Id.*

⁴² *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 107 S. Ct. 2971, 97 L. Ed. 2d 427 (1987).

⁴³ *Id.* at 525.

⁴⁴ *Id.* at 569 (Brennan, J., dissenting).

The Court, however, focused its inquiry only on whether a once-generic term could become protectable (essentially, reverse-genericide), deciding that “the SFAA’s contention that Congress simply plucked a generic word out of the English vocabulary and granted its exclusive use to [respondent]” was meritless.⁴⁵ Unfortunately, it would appear that the SFAA, in turn, chose not to focus on the public expropriation aspect of the word, thus foreclosing the question of whether a once-generic term could gain protectable trademark status *and then* undergo genericide again. Yet this would, it seems to me, be the core point of the genericide defense: in other words, not whether the mark was ever protectable, but whether whatever protections the mark once had must be *shed* in favor of First Amendment considerations, in favor of our expressive needs, in favor of the public’s understanding of a word, its history, its context, and its connotations.⁴⁶ In choosing instead to focus on the fact that a generic word may, through private expenditure of time, effort, and money, become protectable, the Court and the SFAA tipped the balance between public rights and private protection too far toward the latter end of the spectrum, foregoing a

⁴⁵ *Id.* at 534.

⁴⁶ The body of case law and attendant scholarship analyzing trademarks in a First Amendment framework is (perhaps understandably) narrower than that for copyright and First Amendment, but many acknowledge that there are indeed very real First Amendment issues in mark owner’s deployment of trademark law to restrict speech. For example, Sonia Katyal’s work focuses extensively on the intersection of First Amendment and trademark law issues. *See, e.g.,* Sonia Katyal, *Trademark Intersectionality*, 57 UCLA LAW. REV. 1601 (2010). Note that in the Gay Olympics case, the Court deemed SFAA’s use “commercial” and hence of limited First Amendment protection. The Court placed much emphasis on SFAA’s intent to sell T-shirts, buttons, bumper stickers, and other items emblazoned with the mark. *San Francisco Arts & Athletics, Inc.*, 483 U.S. at 539-540. Perhaps the real crux of the issue lies in the fact that the “Gay Olympics” and the Olympics were set to compete in similar markets—that is, the athletic competition arena. As I argue in Part IV, *infra*, a genericide approach to artistic use would appropriately look at whether a mark has become generic in one market (for example, the market for music, in the case of Cristal) while remaining distinctive or unique in another (for example, the market for champagne).

pivotal moment for the power of genericide defenses in the expressive context.⁴⁷ In the following Parts, I examine how genericide can prove to be an even better defense for artistic works than the classic fair use defense.

II. THE PROBLEM WITH FAIR USE

A. Distinguishing Copyright and Trademark Fair Use

The two-letter word “fair use” has been both much celebrated and much-reviled in contemporary copyright law. There have been empirical tests done on it,⁴⁸ it has been cited as a built-in First Amendment safeguard,⁴⁹ hauled into law review articles for reform (shaving down the four factor test into just two),⁵⁰ and questioned as merely an end-result based process.⁵¹ However, no matter how messy the four-factor test may be in practice, the fact remains that copyright fair use is codified as four neat factors which courts then apply in analyzing any fair use defense: the purpose and character of the use (including whether such use is of a commercial nature or is for nonprofit educational purposes); the nature of the copyrighted work; the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and the effect of the use upon the potential market for or value of the copyrighted work.⁵²

⁴⁷ Rochelle Dreyfuss sees the Gay Olympics case and the Court’s ultimate solution of replacing “Olympic” with “games” as an evaluation of the word solely in its competitive, rather than expressive, context. Dreyfuss, *supra* note 11, at 417. In this sense Dreyfuss divides trademarks into a consuming and a linguistic component, and the outcome of the case as hinging on too much of the former rather than the latter. I instead argue that the outcome was a result of an incorrect balancing of private property rights versus public appropriation (or expropriation, rather), and argue that used correctly, as in the Murphy Bed case, genericide can protect both.

⁴⁸ Beebe, *supra* note 3.

⁴⁹ Eldred v. Ashcroft, 537 U.S. 186, 219-220 (2003).

⁵⁰ Joseph P. Liu, *Two-Factor Fair Use?*, 31 COLUM. J.L. & ARTS 571 (2008).

⁵¹ Nimmer, *supra* note 3.

⁵² 17 U.S.C. § 107.

The scholarship and body of law surrounding trademark “fair use,” on the other hand, is, simply put, a mess. There is no four-factor test, no statute codifying the doctrine (with the exception of the 2006 Trademark Dilution Revision Act, which I will get to)). There are, instead, broadly speaking, two categories of trademark fair use: classic and nominative. The former is when the defendant uses the plaintiff’s mark to describe the defendant’s own product.⁵³ Consider, for example, *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*,⁵⁴ where the maker of the candy Sweetarts brought suit against Ocean Spray Cranberries for describing its cranberries as sweet-tart. The court held this to be a descriptive fair use by defendant to accurately describe its own product as sweet and tart.⁵⁵ This form of fair use will likely seldom arise in the artistic use context, as most often artists are invoking brand names not to describe their own work but to comment on the brand name itself. This is what is known as nominative fair use, where the defendant uses the plaintiff’s mark to describe the *plaintiff’s* product.⁵⁶ This would be the doctrine invoked in an artistic use context, and this is precisely the doctrine the Ninth Circuit turned to in a couple of cases involving Barbie, in finding that the use of the mark “Barbie” was an allowable parody under the nominative fair use doctrine.⁵⁷ The nominative fair use test, as developed by the Ninth Circuit, requires the defendant to prove: (1) that the product or service in question is not one readily identifiable without use of the trademark; (2) that only so much of the mark or marks is used as is reasonably necessary to identify the

⁵³ 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:11 (4th ed.).

⁵⁴ 64 F.3d 1055, 1061 (7th Cir. 1995).

⁵⁵ *Id.*

⁵⁶ McCarthy, *supra* note 53.

⁵⁷ *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 810 (9th Cir. 2003) (artistic photographs portraying Barbie doll found to be parody and therefore nominative fair use); *Mattel, Inc. v. MCA Records, Inc.*, No. 97-cv-6791, 1998 WL 422641 (C.D. Cal. Feb. 18, 1998) (song invoking Barbie is parody for purposes of nominative fair use test).

product or service; and (3) that the user did nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.⁵⁸

But there's more. Unlike in copyright, where fair use is a true defense (i.e. a defendant's use is allowable despite being found infringing), only "classic" fair use in trademark law can be considered a true defense. That is, the Supreme Court held in 2004, in *KP Permanent Make-Up, Inc. v. Lasting Impression*, that a defendant need not negate evidence of likelihood of confusion if it has used a mark descriptively, not as a mark, and fairly and in good faith.⁵⁹ Thus, as infringement would normally exist were there evidence of likelihood of confusion, classic fair use is like copyright's fair use in that it "saves" a defendant from liability even in instances where infringement has been found.

Nominative fair use, on the other hand, is trickier. The Ninth Circuit had used the doctrine not as a defense but as another way for determining whether likelihood of confusion—and hence trademark infringement—exists. As Professor McCarthy puts it, "the 'nominative fair use' analysis is a 'defense' only in the sense that an accused infringer in certain cases can use the analysis to argue that there will be no infringement because there will be no likelihood of confusion."⁶⁰ Further, the Third Circuit has departed from other circuits in holding that nominative fair use *is* an affirmative defense "to be proven by defendant after likelihood of confusion has been demonstrated by the plaintiff."⁶¹

Yet further still, other courts do not rely on the nominative fair use analysis at all in determining whether an expressive/artistic use is infringing: rather, such courts have

⁵⁸ *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

⁵⁹ *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 125 S. Ct. 542, 160 L. Ed. 2d 440 (2004).

⁶⁰ McCarthy, *supra* note 53.

⁶¹ *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 228 (3d Cir. 2005).

carved out a special place for parodic uses, finding that because such a use is humorous, often ridiculing the mark or portraying the mark in a distasteful light, it necessarily cannot create confusion.⁶² And, without likelihood of confusion, no infringement exists.⁶³ As we will see in the following section, the undue emphasis in trademark law on parodic uses is deeply pernicious to other uses like pastiche or appropriation, which may often be deadpan or humorless in its portrayal of the mark at issue.

Parody's importance and reigning role in protecting expressive uses from a charge of trademark infringement does not just exist in judge-made common law. In 2006, Congress officially cemented its importance by codifying it as a defense to a charge of trademark dilution in the Trademark Dilution Revision Act, which is incorporated into the federal trademark statute, 15 U.S.C. § 1125 (known as the Lanham Act).⁶⁴ Dilution, a cause of action available only to owners of famous marks, does not require a showing of likelihood of confusion. Rather, the mark owner must merely prove that his mark is either likely to be tarnished—that is, the use is likely to create unsavory associations in the minds of the public⁶⁵ — or blurred, where an association arises from the similarity between a

⁶² See, e.g., *Utah Lighthouse Ministry v. Foundation for Apologetic Information and Research*, 527 F.3d 1045, 1057, 86 U.S.P.Q.2d 1865 (10th Cir. 2008) (“The fact that the [defendant’s] website is a successful parody weighs heavily against a finding of likelihood of confusion.”); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007) (“[A]n effective parody will actually diminish the likelihood of confusion, while an ineffective parody does not.”); *Protectmarriage.com v. Courage Campaign*, 680 F.Supp.2d 1225, 93 U.S.P.Q.2d 1477 (E.D. Cal. 2010) (“One way to negate the element of confusion is to show that the allegedly infringing mark is a parody of the original mark and that this parody is unlikely to show confusion.”).

⁶³ See, e.g., *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1142 (9th Cir. 2011) (“[T]he *sine qua non* of trademark infringement is consumer confusion.”). To prevail on a trademark infringement claim, a plaintiff must show: (1) that it has a valid mark that is entitled to protection; and (2) that the defendant’s actions are likely to cause confusion with the plaintiff’s mark. See *Brockmeyer v. Hearst Corp.*, 248 F. Supp. 2d 281, 292 (S.D.N.Y. 2003).

⁶⁴ Trademark Dilution Revision Act of 2006, PL 109–312, October 6, 2006, 120 Stat 1730; 15 U.S.C. § 1125.

⁶⁵ *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 110 (2d Cir. 2009).

mark and a famous mark that impairs its distinctiveness (think Kodak pianos or Bulova gowns⁶⁶).⁶⁷ The necessity of the dilution statute has often been vividly invoked by analogizing the dilution of a famous mark to “death by a thousand cuts, where significant injury is caused by the cumulative effect of many small acts of dilution.”⁶⁸ Therefore, confusion is irrelevant: so long as a Tiffany’s dry cleaners (which would qualify as dilution by blurring) or a Tiffany’s strip club (qualifying as dilution by tarnishment) is allowed to exist, so does the danger to the distinctiveness of the Tiffany’s mark.

The dilution statute’s very strength explains the codification of specific forms of exempted uses (such uses are “parodying, criticizing, or commenting upon the famous mark”⁶⁹), even if, under the 1996 dilution statute, such uses fell under the general “noncommercial use” safe harbor.⁷⁰ Understandably, if nominative fair use and the common law carve-out for parodies grounds its analysis in a lack of likelihood of confusion, then the desirability of clarifying that parodic uses are still protected under a statute that does not require likelihood of confusion becomes clear.

Then again, perhaps the entirety of trademark fair use comes down to First Amendment expression versus the desire to profit, as summed up by Judge Kozinski’s statement in the famous “Barbie Girl” case:⁷¹ “[T]he trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning

⁶⁶ *Id.* at 105.

⁶⁷ 15 U.S.C. 1125(c)(1).

⁶⁸ Trademark Dilution Revision Act of 2005: Hearing on H.R. 683 Before the Subcomm. On Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary, 109th Cong. 8, at 3 (2005).

⁶⁹ 15 U.S.C. § 1125.

⁷⁰ McCarthy McCarthy, *supra* note 53, at § 24:.

⁷¹ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002).

beyond its source-identifying function.”⁷² This clear, seemingly obvious delineation between expressive speech and commercial intent would seem to put all First Amendment quibbles to bed. Yet even Judge Kozinski’s analysis of whether the song “Barbie Girl” was an infringing use of plaintiff’s “Barbie” mark salvaged the First Amendment issue from the fire based on the lodestar of trademark and copyright fair use defenses: yes, parody.

B. Parody As Targeting the Uniqueness of the Original

Parody, unlike other uses such as satire, sets its sights on the original work as the object of its ridicule.⁷³ In the copyright context, the limited scope of its applicability revealed itself in a series of cases centered around what is known as “appropriation art,” in which the artist takes another’s work and presents it anew, often without any stated intent to comment on or critique the original.⁷⁴ Notably, in the 1992 Second Circuit case surrounding a Jeff Koons sculpture, the court found that “the copied work must be, at least in part, an object of the parody, otherwise there would be no need to conjure up the original work.”⁷⁵ The court, therefore, found that Koons’ sculpture was not fair use, citing policy-driven reasons behind the rule that the copied work must in part be an object of the artist’s ridicule, “as were it otherwise there would be no real limitation on the copier’s use

⁷² *Id.* at 900.

⁷³ *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Grp., Inc.*, 886 F.2d 490, 496-97 (2d Cir. 1989) (“A literary work is a parody if, taken as a whole, it pokes fun at its subject.”).

⁷⁴ *See Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006); *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992); *Campbell v. Koons*, 91 CIV. 6055 (RO), 1993 WL 97381 (S.D.N.Y. Apr. 1, 1993). The court in *Rogers* highlighted this tension between appropriation art’s objectives and fair use’s commentary-on-the-original requirement when it stated: “The problem in the instant case is that even given that [the work] is a satirical critique of our materialistic society, it is difficult to discern any parody of the photograph ‘Puppies’ itself.” *Rogers*, 960 F.2d at 310.

⁷⁵ *Id.* at 310.

of another’s copyrighted work to make a statement on some aspect of society at large.”⁷⁶ While the recent Second Circuit’s decision in the copyright infringement case *Cariou v. Prince* seemed to turn the tide on this requirement, at least within that Circuit,⁷⁷ the Supreme Court’s distinction between parodic commentary as privileged above other forms of artistic commentary in the, so far, only high court ruling on artistic fair use still stands: “Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim’s (or collective victim’s) imagination, whereas satire can stand on its own two feet and *so requires justification for the very act of borrowing.*”⁷⁸

Parodies in trademark infringement cases play an even more important role than in copyright cases. As discussed above, courts have found that parodies negate the likelihood of confusion standard crucial to a finding of trademark infringement, holding both that “[a]n intent to parody is not an intent to confuse the public”⁷⁹ and that “an effective parody will actually diminish the likelihood of confusion, while an ineffective parody does not.”⁸⁰ Further, courts are clear that parodies “must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is *not* the original and is instead a parody. . . . Thus, a parody relies upon a difference from the original mark, presumably a humorous difference, in order to produce its desired effect.”⁸¹ Other courts have made the parody versus other forms of commentary requirement explicit: “where an artistic work targets the original and does not merely borrow another’s property to get

⁷⁶ *Id.*

⁷⁷ *Cariou v. Prince*, 714 F.3d 694, 698 (2d Cir. 2013).

⁷⁸ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 581, 114 S. Ct. 1164, 1172, 127 L. Ed. 2d 500 (1994) (emphasis added).

⁷⁹ *Jordache Enterprises, Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1486 (10th Cir. 1987).

⁸⁰ *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007).

⁸¹ *Id.* at 260.

attention”—i.e. freeriding off the fame of the copyrighted work—“First Amendment interests weigh more heavily in the balance.”⁸² The Second Circuit, at least in the trademark context, has thus far not strayed from its holding in *Harley Davidson, Inc. v. Grottanelli* (an interesting case for genericide, as well⁸³) that a parodic use of a mark must “have some critical bearing on the substance or style of the original composition” or else is “not a permitted trademark parody use.”⁸⁴

C. Parody as Commentary: Is *That All There Is*?

Yet the focus on parodies, on commentary upon the original, to the exclusion of all else, can be deeply pernicious. In many ways, this exclusive focus on parodies seems outmoded in a contemporary age of art-making that problematizes the very notion of “an original and separate expression, attributable to a different artist.”⁸⁵ In 1935, Walter Benjamin, in his infamous article *The Work of Art in the Age of Its Technological Reproducibility*, had predicted that technological advances (such as film and photography) would drastically change the way art was both received and perceived through the driving back of a work’s aura in favor of a simulacrum without originals.⁸⁶ *Because* of this loss of a

⁸² *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901 (9th Cir. 2002).

⁸³ *Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812 (2d Cir. 1999) (finding that the word “Hog” was generic and hence not trademarkable despite the fact that “a substantial segment of the relevant consumers began to use the term specifically to refer to Harley-Davidson motorcycles”). Hence, *Harley Davidson* was a reverse-genericide case in which the question centered on whether a formerly generic term can gain trademark status via use and subsequently-acquired secondary meaning. The outcome here was the opposite of that in *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 107 S. Ct. 2971, 97 L. Ed. 2d 427 (1987), which suggested that it could, at least as to Congress’ decision to grant the mark owner a limited property right in the mark.

⁸⁴ *Harley Davidson*, 164 F.3d at 813.

⁸⁵ *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992).

⁸⁶ Benjamin describes the Dadaists as predecessors to film, with their “word-salad” poems and brickolage paintings. “What they achieved by such means was a ruthless annihilation of the aura in every object they produced, which they branded as a reproduction through the very means of its production.” Walter Benjamin, *The Work of Art in the Age of Its Technological Reproducibility*

work's aura, "[t]he fiction of the creating subject gives way to the frank confiscation, quotation, excerptation, accumulation and repetition of already existing images. Notions of originality, authenticity and presence...are undermined."⁸⁷ Benjamin proved to be a prescient prophet of the way art-making would evolve over the next century. In the late 1970s, writing after a couple decades of the pop art movement, in which advertising slogans and signs were taken straight from their homes on billboards and transplanted to museum walls,⁸⁸ Roland Barthes, in his famous work *The Death of the Author*, compared the author to a scriptor, to one who merely imitates gestures that are "anterior, never original."⁸⁹ A decade later, the postmodern theorist Frederic Jameson noted a marked break in the belief that there remains a unique artistic style worthy of imitation and a shift toward pastiche—"blank parody, parody that has lost its sense of humor."⁹⁰ In this new mode of art-making, we do not merely copy to mock—we simply repeat, as if in some ritualistic repetition of past trauma. Pastiche is deadpan parody, and in that sense it is not a parody that any court would recognize.

Almost twenty five years after Jameson wrote the treatise on postmodernism, this drama between contemporary art's internalization of anti-originality and anti-transformativeness, of the artist as merely a scriptor rather than a creator, of confiscation-

(*Second Version*), in *THE WORK OF ART IN THE AGE OF TECHNOLOGICAL REPRODUCIBILITY AND OTHER WRITINGS ON MEDIA* 19, 39 (Michael W. Jennings et al. eds., 2008).

⁸⁷ Douglas Crimp, *On the Museum's Ruins*, in *THE ANTI-AESTHETIC: ESSAYS ON POSTMODERN CULTURE* at 43, 53 (Hal Foster ed., 7th ed. 1991) (1983).

⁸⁸ The aim of Pop art was to "look into the conscience of America's commercial culture, find the glint of shiny metal no more than an inch thick, and *mirror it brilliantly*." Steven Henry Madoff, *Wham! Blam! How Pop Stormed the High Art Citadel and What the Critics Said*, in *POP ART, A CRITICAL HISTORY*, *supra* note 25, at xiii, xiv (emphasis added).

⁸⁹ Roland Barthes, *The Death of the Author*, in *IMAGE-MUSIC-TEXT* 142, 146 (Stephen Heath trans., 1977).

⁹⁰ Frederic Jameson, *Postmodernism and Consumer Society*, in *THE ANTI-AESTHETIC: ESSAYS ON POSTMODERN CULTURE* at 111, 114 (Hal Foster ed., 7th ed. 1991) (1983).

quotation-excerptation-accumulation-repetition (anything, anything but the belief that there exists an original to be transformed or transformative potential itself) continued to play out in *Cariou v. Prince*, in which one of the key questions was whether the artist Richard Prince, in taking plaintiff Cariou's photographs and altering them, had any intention to comment on Cariou's original works. The district court found it significant that Prince stated that he did not, thus rejecting his fair use defense.⁹¹ If the Second Circuit's reversal and holding that "the law does not require that a secondary use comment on the original artist or work"⁹² seems to be an encouraging sign for artists working in popular mediums such as appropriation art, found art, and pastiche, the road toward trademark fair use reform seems less clear.

There are, after all, many forms of speech that do not hinge on parodic commentary. Rebecca Tushnet recognized as much when she espoused the value of copying and the harm that (copyright) fair use's emphasis on transformation can wreak on First Amendment values.⁹³ Our focus on parodies is a self-reinforcing mechanism: the more a work comments on the original mark, the more fair it looks; to the extent that it seems to use the mark as a means to an end (i.e. as commentary on something else), it cannot be a defensible use. In the next Part, I examine why the doctrine of genericide is more relevant

⁹¹ *Cariou v. Prince*, 784 F. Supp. 2d 337, 348-350 (S.D.N.Y. 2011) *judgment rev'd in part, vacated in part*, 714 F.3d 694 (2d Cir. 2013). Prince himself had stated in his deposition that he did not intend to comment on Cariou's works, and that his intent in creating the allegedly infringing works was to "pay homage or tribute to other painters, including Picasso, Cezanna, Warhol, and de Kooning, and to create beautiful artworks which related to musical themes and to a post-apocalyptic screenplay he was writing....").

⁹² *Cariou v. Prince*, 714 F.3d 694, 698 (2d Cir. 2013).

⁹³ Rebecca Tushnet, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L.J. 535, 552 (2004) ("But the logical chain linking criticism, the First Amendment, and transformative fair use can make those concepts seem coterminous with one another as far as copyright defendants are concerned. The values of public access and dissemination that were also traditionally part of fair use, and part of many theories of free speech, get left behind.")

today, and more applicable to a greater variety of artistic expression, than fair use's narrow parody exception.

III. GENERICIDE IN THE 21ST CENTURY

A. What Does it All Mean?

We are what we buy. If taking the emblems and signs straight from the bastions of consumer culture (billboards, magazine advertisements, supermarket shelves) was a novelty in the post-World War II period where Pop Art (Warhol, Lichtenstein, Johns, and Rosenquist) and its predecessors (Richard Hamilton, who, in what is commonly acknowledged to be the forefather of Pop Art, created *Just what is it that makes today's homes so different, so appealing?* with its bits of consumer culture and ad-slogans⁹⁴) reigned, the inundation of the ad-world into the real world has become rather, well, as Koons would put it, banal today. Signs—whether literally in the form of billboards or semiotically as signifiers—are not so much unique as endless, ceaseless white noise. Appropriately, the author Don DeLillo exemplified the new age of ad-fatigue in his novel *White Noise*, where brands are listed indiscriminately in laundry lists of excess and clutter: “Waffelos and Kabooms, fruit chews and toffee popcorn; the Dum-Dum pops, the Mystic mints.”⁹⁵

Perhaps the ubiquity and banality of brand names in the modern age has found its best exemplification in an unlikely place: hip-hop culture. Premised on depictions of excess, hip-hop culture, as embodied in music videos, song lyrics, and fashion paraphernalia, has

⁹⁴ See 2 ART SINCE 1900: MODERNISM, ANTIMODERNISM, POSTMODERNISM 389 (Hal Foster et al. eds., 2004).

⁹⁵ DON DELILLO, WHITE NOISE 3 (1986).

become almost a parody of itself. There are expected tropes to be found in a hip-hop video: women, cars, and “bling,” or flashy jewelry.⁹⁶ More significantly, rap lyrics themselves often call out a roster of trademarked names, used not as commentary on the marks themselves but as evocations of a lifestyle. Consider, for example, rappers’ penchant for evoking Cristal in the ’90s⁹⁷—so constant, in fact, that (as if in an almost-eerie call to genericide) commentators have noted: “Mentions of the vintage bubbly have become so common in hip-hop circles that the brand name Cristal has often to stand in for the very word champagne itself. At this point, to call Cristal ubiquitous in hip-hop would be an understatement.”⁹⁸

The use of marks in hip-hop to signal associations with a certain lifestyle, and the evocation of marks as a means of conveying that idea of luxury, of bling, of excess, or of money present an interesting antithesis to fair use’s call for commentary on the mark itself. Marks used in *this* way do little if anything to target the uniqueness of the mark—rather, Cristal to denote champagne or the constant litany of upscale car brands that litter the songs (Bentleys, Porsches, Maybachs) seem to create a genericity not only of the marks themselves, but of the rap song formula as a whole. In the same way that the songs used marks to evoke a lifestyle, so the insertion of certain mark-tropes (Hennessy, Bentley,

⁹⁶ *Bubbles and Bling*, THE ECONOMIST, May 8, 2006, <http://www.economist.com/node/6905921> (describing the “bling-bling” lifestyle as one including “ten-carat diamond studs, chunky gold jewellery, pimped up Caddies and sensuous women”).

⁹⁷ A controversy surrounding such usage came to a head in 2006, in which a Cristal executive suggested the hip-hop community’s affection for its product was unwelcome. A boycott followed. Douglas Century, *Jay-Z Puts a Cap on Cristal*, N.Y. Times, July 2, 2006, <http://www.nytimes.com/2006/07/02/fashion/02cris.html?pagewanted=all&r=0>.

⁹⁸ *Cristal and the Buying Power of Hip-Hop*, NPR, July 31, 2006, <http://www.npr.org/templates/story/story.php?storyId=5594229>.

Gucci) definitively denoted a song as a rap song, part of an entire canon of artists singing about women, money, and bling.

Hip-hop's way of using marks simply cannot be explained by resorting to the old "parody as critique" defense. Rather, it is more apt to say that hip-hop appropriated something that once did not belong to them and made it theirs. To some, this may not seem like anything other than trademark infringement. In the early '90s, for example, a Harlem clothesmaker who called himself Dapper Dan took to creating jackets, coats, and suits embossed with logos from the likes of Louis Vuitton, Fendi, and Gucci.⁹⁹ The odd thing was that he often made coats that used one mark as the lining, another for the outside, a third for the lapel, and a fourth as pocket squares.¹⁰⁰ The fashion houses were not pleased and enacted a raid on Dapper Dan's shop.¹⁰¹ Dapper Dan's creations could not be saved by anything like a parody defense (as dog toys labeled with "Chewy Vuitton" and bearing the Louis Vuitton trade dress were¹⁰²), nor would he have argued for one: in his view, "he wasn't parodying these brands, he was paying tribute to them, and so were his customers."¹⁰³ In his words, "I Africanized it. Took it away from that, like, Madison Avenue look."¹⁰⁴

Dapper Dan's own intent behind creating his works of mark mash-ups, and his customers' (they included numerous rappers and the boxer Mike Tyson¹⁰⁵) enthusiasm for wearing them, also cannot be explained by the traditional rationales underlying

⁹⁹ Kelefa Sanneh, *Harlem Chic*, THE NEW YORKER, Mar. 25, 2013, at 52.

¹⁰⁰ *Id.* at 57.

¹⁰¹ *Id.*

¹⁰² *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007).

¹⁰³ Sanneh, *supra* note 99, at 57.

¹⁰⁴ *Id.* at 55.

¹⁰⁵ *Id.* at 56.

infringement. In other words: not only did Dapper Dan have no intention of “passing off” his goods as a *real* Louis Vuitton, or Fendi, or Gucci (hence creating consumer confusion), but his customers could not have caused what is known as post-sale confusion, either.¹⁰⁶ Just as no purchaser would be deceived into thinking that Gucci is affiliated with a coat that also has Louis Vuitton lapels and Fendi lining, so no passerby on the street would mistake a Dapper Dan creation for the “real” thing (whatever that may be, since no fashion house would dare mash up its label with others and then sell it).¹⁰⁷ And the oddity of his customers paying thousands of dollars for one of his coats, then, lies in this: why pay so much for a luxury good that is not a luxury good?¹⁰⁸ If the rationale behind trademark law is that the value of a Louis Vuitton lies in the attributes a consumer can reliably expect from the house of Louis Vuitton: craftsmanship and quality, then paying thousands for a coat you definitively know to be *not* from the house of Louis Vuitton makes no sense. The same goes for trademark’s signaling function:¹⁰⁹ after all, the appeal of a counterfeit good is that it is both cheap and can “pass,” to unwitting observers, at least, as the real thing, hence marking you as someone of a certain class.¹¹⁰ But for someone wearing Dapper Dan, that rationale

¹⁰⁶ Post-sale confusion focuses not on the purchaser’s confusion as to the product’s source but on that of observers. As one court has explained, “This type of confusion harms the owner of a trademark in that a potential purchaser, knowing that the public is likely to be confused or deceived by the allegedly infringing product, will choose to purchase that product instead of a genuine one in order to gain the same prestige at a lower price.” *Gucci Am., Inc. v. Guess?, Inc.*, 843 F. Supp. 2d 412, 418 (S.D.N.Y. 2012), opinion clarified (Feb. 21, 2012).

¹⁰⁷ This would seem to present the ideal case for a fair use under 15 U.S.C.A. § 1115(b)(4), yet it is unlikely a court will find that the marks are being used in a descriptive sense, rather than as marks. No matter how strange the mark mash-up may be, it is the *marks themselves*, as marks, that are on display in a Dapper Dan creation.

¹⁰⁸ Sanneh, *supra* note 99, at 55 (noting that for some of Dapper Dan’s clients, his high prices were part of the appeal—“You have to pay on the same level as if it was from Gucci”).

¹⁰⁹ Beebe, *supra* note 3, at 624.

¹¹⁰ This is much of the reasoning underlying the post-sale confusion doctrine. *See supra* note 81 (noting that some will choose to purchase a counterfeit good in order to gain the same *prestige* at a lower price).

breaks down. No coat with four brand labels affixed to it will pass for the real thing. And as for the parody defense, no coat with four brand labels affixed to it in an indiscriminate mash-up can claim to be targeting the uniqueness of one.

Rather, a coat with four brand labels affixed to it seem to stand for another proposition: that maybe, just maybe, Fendi, Gucci, and Louis Vuitton are interchangeable to Dapper Dan and his customers. To them, the labels are a stand-in for the general idea of luxury, for the rarefied world of Madison Avenue, for the vulgarities (often comically so) of newly-minted wealth. Put simply: these labels stand for a category of good, rather than the good itself.

B. A Look at *Mattel v. MCA Records* From the Genericide Perspective

What would a world in which more genericide-type defenses were allowed look like? To take a different look at the same problem, let's consider Judge Kozinski's analysis of the song "Barbie Girl" in *Mattel v. MCA Records*, a song by the band Aqua that quickly rose to the top of the charts, causing Mattel, the creator of Barbie dolls, some consternation.¹¹¹ Kozinski insists that "[t]he song does not rely on the Barbie mark to poke fun at another subject but targets Barbie herself."¹¹² Yet to shore up this reasoning, Kozinski relies on a few representative lyrics, which claim that the singer is a "Barbie girl, in [her] Barbie world....Life in plastic, it's fantastic. You can brush my hair, undress me everywhere/Imagination, life is your creation....I'm a blond bimbo girl, in a fantasy

¹¹¹ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 895 (9th Cir. 2002).

¹¹² *Id.* at 901.

world/Dress me up, make it tight, I'm your dolly."¹¹³ In some ways, one could claim that the song targets the values that Barbie represents—plastic, fake, a fictional play world where Barbie is a blank slate for which one's own desires can be projected.

But another argument could also be true—that the mark “Barbie” here is used as a simple stand-in for that certain kind of girl: a fake bimbo. “Barbie” in this sense does not depend on the fact that Mattel manufactures it, but could be any kind of plastic doll that symbolizes to young girls what a female is supposed to be (docile, beautiful, blonde). “Barbie” is a simple category of good: a doll of unrealistic proportions made for young girls. And by using the word “Barbie” in their song, the band Aqua did not intend to comment on Barbie itself as they simply used the mark as shorthand (denoting the litany of characteristics stated above) in a song about a relationship between a woman and a man in which the woman ingratiate herself into the idealized role of girlfriend, willing and ready to be bent every-which-way he pleases. Barbie is, in fact, anti-unique: she is the every woman of men's dreams.

To argue genericide here would make just as much sense if not more sense than putting forth a parody argument. As a political statement, genericide speaks louder: Barbie is *not* unique. She has come to be the universal symbol for docility, a certain category of fake. To argue parodic intent in targeting the original's uniqueness by invoking its blandness is ironic, at best. As a defense, genericide does more: once a mark has been deemed generic (in one “market,” at least, as I argue should be the standard below¹¹⁴), a mark owner loses its rights all together (whereas fair use is a case-by-case

¹¹³ *Id.*

¹¹⁴ *See infra* pp. 33-36.

determination).¹¹⁵ And lastly, in our modern-day ad-age, genericide makes more sense, covering a wider range of odd uses exemplifying how trademarks are so integrated into our daily lexicon that a mark no longer signifies the origin, but becomes shorthand for a category, an idea, a state of being.

IV. A GENERICIDE APPROACH TO ARTISTIC USE

A. Potential Critiques of the Genericide Defense

To many readers who've made it this far, my proposal might seem a ludicrous one. The first, less troublesome critique that comes to mind is that, setting aside any critiques of the common law development of the fair use defense, uses are only infringing (thus invoking the need for the fair use defense) if a likelihood of confusion exists.¹¹⁶ In that sense, there is very little possibility that consumers would think, for example, that Mattel created the "Barbie Girl" song, or even, as I admitted above, in a more problematic usage, that Fendi, one of the four or five marks appearing on a Dapper Dan creation, would be affiliated with a coat in which its mark appears alongside those of its competitors. However, as discussed *supra*, the Lanham Act's expanding reach in the form of protection for "famous" marks does *not* require a likelihood of confusion, rather, the owner of a famous mark must merely prove that its mark is being diluted. And, though the Lanham Act's dilution statute has a "built-in" defense of fair use for the purposes of parody or

¹¹⁵ A party who believes a mark owner's trademark is generic may file a petition to cancel that mark. See 15 U.S.C. § 1064 (2005) ("A petition to cancel a registration of a mark...may...be filed...(3) [a]t any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered....").

¹¹⁶ See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 118, 125 S. Ct. 542, 548, 160 L. Ed. 2d 440 (2004).

commentary, the standards for such parody—that it must refer to the original and only use as much of the original as is necessary—nonetheless fall prey to the same problems that traditional trademark fair use suffers from: an emphasis on the uniqueness of the original.¹¹⁷ The dilution statute is especially troubling, for marks that have the most expressive potential are often famous marks: after all, the power of a song titled “Barbie Girl” would be lost on much of its audience if only a small segment of the public was aware of Barbie. In fact, all the marks I have discussed throughout this paper, luxury marks like Fendi and Louis Vuitton, for example, are famous marks.

A second critique might be that the doctrine of genericide creates perverse incentives for mark owners to police their marks, thus further chilling speech rather than encouraging it.¹¹⁸ That is, if the threat of genericide is more real—by encouraging more defendants to invoke the genericide defense—such policing will inevitably get worse. Yet I believe this fear flies in the face of well-settled case law, for the majority of courts have found that a mark owner’s active policing of its mark is of no consequence to whether a mark will be found generic.¹¹⁹ This is not to say that mark owners won’t attempt to police

¹¹⁷ See, e.g., *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 417 (S.D.N.Y. 2002) (finding perfume for dogs to be a “joking variation on the original”); *Lucasfilm Ltd. v. Media Mkt. Grp., Ltd.*, 182 F. Supp. 2d 897, 900-01 (N.D. Cal. 2002) (finding that parody is protected under the Federal Trademark Dilution Act, and that “parody is meant to comment on or criticize an original work”).

¹¹⁸ Desai & Rierson, *supra* note 12, at 1834-1842.

¹¹⁹ See, e.g., *Murphy Door Bed Co., Inc. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 101 (2d Cir. 1989); *Hickory Farms, Inc. v. Snackmasters, Inc.*, 509 F. Supp. 2d 716, 723 (N.D. Ill. 2007). Desai and Rierson quote Judge Posner in arguing that courts in fact find policing to be of consequence in determining whether a mark is generic by citing this line from *Illinois High Sch. Ass’n v. GTE Vantage Inc.*, 99 F.3d 244, 246 (7th Cir. 1996): “A serious trademark holder is assiduous in endeavoring to convince dictionary editors, magazine and newspaper editors, journalists and columnists, judges, and other lexicographically influential persons to avoid using his trademark to denote anything other than the trademarked good or service.” But Judge Posner then goes on to say that that is “a detail,” and, “in fact irrelevant, for no defense of laches has been pleaded,” which suggests that this dicta is more for the purposes of proving laches than anything else. As further proof of this fact,

expressive uses regardless, but just that such policing cannot be necessarily attributed to any elements within the doctrine of genericide itself—other than its mere existence, yet other doctrines, such as laches, affirmatively *require* the trademark owner to actively police its rights against potential infringers, lest it lose the right to challenge such infringing uses in court.¹²⁰ More troubling still is the doctrine of abandonment, which, like laches, requires mark owners to vigorously police its marks if they hope to enforce their rights in court, and for which a failure to police may result in abandonment by allowing the mark to become generic.¹²¹ These doctrines, which focus on the actions of the mark owner, are far more prohibitive to free speech than genericide, which appropriately disregards the actions of the mark owner in favor of public opinion. In that way, genericide is far more audience-friendly and First Amendment-approved than other trademark infringement defenses.

The last critique is simply a practical one and also the most compelling: how likely is it, really, that courts will determine “Louis Vuitton” to be generic? In this regard, luxury marks are especially problematic because they denote status goods with high sign values—sign value being used simply to refer to an

Judge Posner then goes on to state in the same case: “When a trademark becomes generic...because the public, perhaps egged on by the omnipresent media, decides to use the trademark to designate not the particular manufacturer’s brand but the entire product comprising all the competing brands, the trademark is dead no matter how vigorously the holder as tried to prevent this usage.” *Id.* at 247. This reasoning is in line with what other courts have found: that policing is of no consequence in finding genericity.

¹²⁰ *See, e.g.,* Grupo Gigante Sa De CV v. Dallo & Co. Inc., 391 F.3d 1088, 1102 (9th Cir. 2004) (“[c]ompanies expecting judicial enforcement of their marks must conduct an *effective* policing effort”); Saul Zaentz Co. v. Wozniak Travel, Inc., 627 F. Supp. 2d 1096, 1110 (N.D. Cal. 2008) (stating that a laches defense is based on either actual or constructive knowledge, and that the latter “imposes on a trademark owner the duty to police its rights against potential infringers”).

¹²¹ *Hermes Int’l v. Lederer de Paris Fifth Ave., Inc.*, 219 F.3d 104, 110 (2d Cir. 2000).

“expression and mark of style, prestige, luxury, power, and so on.”¹²² While it might be easier to imagine a court holding the mark “Barbie” generic as signifying a class of blonde plastic dolls, there are nonetheless real concerns (not to mention incredulities) to be had in envisioning that some of our most famous marks—Cristal, Hennessey, McDonald’s—may undergo death by genericide and lose its status as a protectable mark. For these reasons, my proposed version of a genericide defense in artistic works does not go so far. Rather, it is simply a slight reimagining of an existing element of the doctrine: that a mark may be generic in one market, and not the other. This will be the focus of the following Section.

B. Generic by Market, Generic by Case

1. Generic by Market

Several courts analyzing whether a mark has become generic have stated, in dicta, that when a term is generic, “trademark protection will be denied save for those markets where the term still has not become generic and a secondary meaning has been shown to continue.”¹²³ Thus, a mark may be generic and hence unprotectable in one market, but nonetheless retain its rights in another. Courts frequently look to the context within which a mark is used—for example, in one trade dress infringement case, the district court looked to whether a certain spider web design used in the specific context of

¹²² I do not use this in Barton Beebe’s more complex meaning of sign value as differential value—used in this way, even goods that are not symbols of high status still have high sign values. See Beebe, *supra* note 3, at 644.

¹²³ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976).

the Halloween industry was distinctive or generic.¹²⁴ In another case, the Second Circuit analyzed whether the use of the word “safari” was generic in the apparel industry, and became even more detailed in its analysis by determining that “Safari” was generic when used in connection with hats and jackets, but not when used in connection with boots.¹²⁵

There is no reason why courts should not use this analysis when determining whether a certain mark has become generic in the context of artistic uses. Like the Second Circuit, a court could become even more detailed, not merely limiting itself to the holding that a mark has become generic in the context of *all* artistic uses. For example, it could be determined, as in my analysis of the mark “Cristal” above, that “Cristal” is a generic name for champagne as used in rap songs, but not generic if used in a rock song. Or, a court could hold that the mark “Louis Vuitton” is used generically in paintings to refer to a luxury conglomerate, but that it nonetheless retains secondary meaning when used by tattoo artists (as tattoos are arguably of some artistic value,¹²⁶ a holding that “Louis Vuitton” is generic in all artistic contexts might be too broad) because tattoos, like a purse, might nonetheless act as signals of prestige—thus, the brand matters. One might also readily see how a court may hold that the mark “Barbie” is generic as referring to a category of docile, fake beauties in literature or music but not generic as used in the toy industry.

¹²⁴ *Funrise Canada (HK) Ltd. v. Zauder Bros., Inc.*, 99-CV-1519 (ARR), 1999 WL 1021810 (E.D.N.Y. July 2, 1999).

¹²⁵ *Abercrombie & Fitch Co.*, 537 F.2d at 12.

¹²⁶ *See Anderson v. City of Hermosa Beach*, 621 F.3d 1051, 1061 (9th Cir. 2010) (“We do not profess to understand the work of tattoo artists to the same degree as we know the finely wrought sketches of Leonardo da Vinci or Albrecht Durer, we can take judicial notice of the skill, artistry, and care that modern tattooists have demonstrated.”).

Declaring a mark generic in one market—Cristal as generic for champagne in the music industry but fanciful or arbitrary¹²⁷ and hence protectable in the liquor industry—has several advantages. For one, it allows for a wide range of expressive uses while nonetheless protecting the mark competitively in the industries where the mark has made its name. In this way, the generic-by-market analysis nonetheless remains friendly to mark-holders. However, it also offers enormous benefits to artists hoping to use the mark in their work. For one, marks that nonetheless retain secondary meaning within the industry in which they compete are especially effective in the artistic context: after all, the ready abundance of secondary meaning suggests that the public can immediately conjure up a wealth of associations merely by being presented with one mark. On the other hand, were a mark to truly become generic—such as aspirin or thermos—the wealth of associations conjured up by the name might be scant (merely a pain reliever, or an insulated cup).

Secondly, and more importantly, deeming a mark generic in one market frees up that mark for permanent use within that market, unlike the sticky, fact-intensive,

¹²⁷ This Article, for the most part, does not get into the five categories into which potentially trademarkable terms may fall, but they are: arbitrary, fanciful, suggestive, and descriptive, and generic. Arbitrary and fanciful marks receive the highest degree of trademark protection, and the term “Cristal” would likely fall into the second category. The former refers to marks that have no logical association with the underlying product (for example, “Apple” to describe computers), and the latter refers to words that are invented (for example, “Google”). Suggestive marks receive less protection than the first two but nonetheless does not require secondary meaning to be protectable as it requires the consumer to use some imagination in calling to mind what the mark is associated with: for example, “Habitat” for home furnishings. Lastly, descriptive marks, as purely describing the product, are not eligible for trademark protection unless they acquire secondary meaning. An example would be “Fish Fri” to describe a batter for frying fish. *See, e.g., Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). This Article, of course, has focused on the last category, generic terms. While it has mostly described the process through which a mark that once fell into either of the four above categories becomes generic, marks that start out being generic also cannot be trademarked: for example, “Chocolate Fudge Soda” to refer to a chocolate fudge soda. *A.J. Canfield Co. v. Honickman*, 808 F.2d 291 (3d Cir. 1986).

expensive, by-nature-litigious, case-by-case determination of a fair use defense.¹²⁸ Artists can therefore freely use the mark without fear of retaliation by cautious mark owners. Furthermore, once a mark is deemed generic in one market, owners of once-famous marks no longer have a dilution argument for uses in that market, either, saving a wide variety of non-confusing uses from unnecessary litigation by over-vigilant mark owners.¹²⁹

However, the generic-by-market defense may not necessarily save some potentially infringing uses. For example, in the Dapper Dan scenario above, the infringing use overlaps with the markets in which would-be plaintiffs' marks (Louis Vuitton, Fendi, Gucci, etc.) compete. Thus, at least on some level, such use is inherently more competitive than uses that are more readily thought of as expressive (such as artistic works).¹³⁰ And yet, as discussed above, such a use *does* have expressive power. For these uses, I describe an approach to the genericide defense much akin to that of aesthetic functionality, where a case-by-case analysis would be undertaken.

2. *Generic by Case*

The curious defense of "aesthetic functionality" has, as it turns out, much in common with genericide, and yet is in many ways much more susceptible to criticism. The rationale behind aesthetic functionality lies in the idea that because trademark law is concerned only with truthful source-identification, "it does not prevent a person from copying so-called 'functional' features of a product which constitute the actual benefit that the consumer wishes to purchase, as distinguished from an assurance that a particular

¹²⁸ McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 66-71 (2008).

¹²⁹ Of course, this is so because only trademarkable terms are subject to the provisions of the Lanham Act, and once a mark is deemed generic, no trademark protection applies.

¹³⁰ As proof that such uses are more competitive, consider the fact that Dapper Dan's customers will often buy real Gucci shoes to match their Gucci creation from Dapper Dan, to make it "super official." Sanneh, *supra* note 99, at 57.

entity made, sponsored, or endorsed a product.”¹³¹ Therefore, marks that are deemed aesthetically functional are not subject to trademark protection.¹³² An obvious critique of the doctrine—one that genericide could also be prey to—is that it essentially “punishes” a trademark owner for success; for example, in one case, the court held that a federally-trademarked stripe design on plaintiff’s luggage was functional and thus not a valid trademark because its appeal to consumers lay mainly in such design.¹³³ Yet aesthetic functionality, unlike genericide, does not import a new word into the public vernacular, hence benefitting the public or the consuming public by encouraging *expressive* uses of the mark in addition to purely competitive ones¹³⁴—rather, it allows the hard efforts of one mark owner to be reaped by competitors, merely by the latter suggesting that the use of such mark or trade dress is functional *precisely because* the mark has become so desirable to the public. The inherent incoherence of the doctrine has led to much criticism,¹³⁵ helped along in no small part by the fact that what consumers are “often purchasing”¹³⁶ *is*, in fact, the trademark or the trade dress itself, hence conveying, at least to observers, that the product originated from the mark owner. This was acknowledged most recently in *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, which centered around the

¹³¹ Int’l Order of Job’s Daughters v. Lindeburg & Co., 633 F.2d 912, 917 (9th Cir. 1980).

¹³² Forschner Grp., Inc. v. Arrow Trading Co., 124 F.3d 402, 409-10 (2d Cir. 1997).

¹³³ Ventura Travelware, Inc. v. Baltimore Luggage Co., 66 Misc. 2d 646, 650, 322 N.Y.S.2d 93, 99 (Sup. Ct. 1971) *aff’d*, 38 A.D.2d 794, 328 N.Y.S.2d 811 (1972).

¹³⁴ Ty Inc. v. Perryman, 306 F.3d 509, 514 (7th Cir. 2002) (“Although there is a social cost when a mark becomes generic—the trademark owner has to invest in a new trademark to identify his brand—there is also a social benefit, namely an addition to ordinary language.”).

¹³⁵ See, e.g., Jessica D. Litman, Note, *The Problem of Functional Features: Trade Dress Infringement Under Section 43(a) of the Lanham Act*, 82 COLUM. L. REV. 77 (January 1982); Deborah J. Krieger, Note, *The Broad Sweep of Aesthetic Functionality: A Threat to Trademark Protection of Aesthetic Product Features*, 51 Fordham L. Rev. 345 (November 1982); Anthony L. Fletcher, *The Defense of “Functional” Trademark Use: If What Is Functional Cannot Be a Trademark, How Can a Trademark Be Functional?*, 75 TMR 249 (1985).

¹³⁶ Int’l Order of Job’s Daughters v. Lindeburg & Co., 633 F.2d 912, 917 (9th Cir. 1980).

infamous “red sole” of Christian Louboutin shoes.¹³⁷ While the Second Circuit ultimately determined that because aesthetic functionality is an affirmative defense that will only be considered once an allegedly infringing use is found to likely cause consumer confusion—and the YSL shoe was a monochromatic shoe, not a shoe with a contrasting red sole—the court ultimately avoided the issue of whether a use of a contrasting red sole would be eligible for the aesthetic functionality defense.¹³⁸ Yet, of course, red soles are desired by consumers *precisely because* of its source-identifying function as a Louboutin, which in turn connotes prestige and status.

But that is, really, a topic for another day. What interests me most about aesthetic functionality for the purposes of this Article is the fact that it has been used by courts on a case-by-case basis to determine whether a certain mark was used purely for aesthetic purposes, rather than for source-identifying ones. Consider, for example, *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, a recent case originating out of the Ninth Circuit concerning defendant’s use of the “Betty Boop” mark on t-shirts bearing movie poster images, dolls, and packaging adapted from plaintiff’s “Betty Boop” vintage movie posters that had fallen into the public domain.¹³⁹ The court found that defendant’s use of the Betty Boop word mark on t-shirts bearing such images were not a trademark use, but in fact a decorative component “part and parcel of the aesthetic design of those goods.”¹⁴⁰ Thus, the court found for defendant based on the aesthetic functionality doctrine *without* holding that the

¹³⁷ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 222 (2d Cir. 2012) (“Therefore, in determining whether a mark has an esthetic function so as to preclude trademark protection, we take care to ensure that the mark’s very success in denoting (and promoting) its source does not itself defeat the markholder’s right to protect that mark.”).

¹³⁸ *Christian Louboutin*, 696 F.3d at 225.

¹³⁹ *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 925 F. Supp. 2d 1067, 1070 (C.D. Cal. 2012).

¹⁴⁰ *Id.* at 1074.

word mark “Betty Boop” was itself ineligible for trademark protection all together based on the aesthetic functionality doctrine.

The *Fleischer* holding is fascinating for the genericide defense, for it suggests that courts may potentially hold, as well, that for purposes of *this use* (that is, in *this case only*), the mark was being used in its generic sense, merely to denote the category of good it represents, rather than to identify the source of the product. This approach could easily apply to Dapper Dan’s creations—but note that *not all* of Dapper Dan’s creations, some of which use only one mark and one mark alone and thus could in a very real sense be used to connote origin or sponsorship.¹⁴¹ But as for the Dapper Dan creations which feature three or four trademarks, mashed-up together into one creation: now *this*, one could argue, employs the marks in their generic sense, as simply identifying luxury goods, rather than referring to any one unique source (nor could it refer to any one unique source). Rather, such use of the marks employs them in a way reaching far beyond the confines of the Lanham Act—the marks are being repurposed to signify a certain idea of Madison Avenue luxury that was, for a long time, out of reach for many of Dapper Dan’s newly-wealthy customers. To them, the marks may or may not blend together: they are signifiers of luxury, not of source.

Determining genericide on a case-by-case basis is trickier, less obviously expressive but more blatantly competitive uses such as these does what fair use also aims to do: allow for a small number of uses without wiping out protection for the mark owner completely. On the other hand, genericide offers another perspective on and viable defense for the range of allowable uses: a use need not be merely parodic in order to be defensible in a

¹⁴¹ Sanneh, *supra* note 99, at 56 (describing a Gucci windbreaker that Dapper Dan made as one of his creations).

trademark infringement proceeding. Uses can be pastiche, appropriative or dead-pan satiric—they can be, in short, postmodern. The onus of proving genericide on a case by case basis, on the other hand—which, like finding aesthetic functionality or fair use, is incredibly fact-intensive¹⁴²—in turn balances out its extraordinary nature, ensuring that potential infringers do not merely exploit the genericide defense in order to free-ride on the goodwill of the mark owner.

CONCLUSION

Our era's flood of brand names in our daily lives creates a seamless integration between how we think, speak, and process information and the free-floating signifiers of consumer culture that surround us. We do not search for information, we Google it. In the opening season of the infamously iconic HBO series *Sex and the City*, the character Carrie Bradshaw, herself a prophet of modern-day pop culture and media, declares: "Welcome to the age of un-innocence. No one has breakfast at Tiffany's and no one has affairs to remember." In that one line, two references: to both Tiffany's, the jewelry conglomerate meant to symbolize elegance and luxury, and the film *Breakfast at Tiffany's*, in which Audrey Hepburn's character stares bright-eyed and in awe into the window of a Tiffany's store, complete the antithesis to jaded, cynical modern-day New York. Trademarks have become language, able to concisely and often bitingly get at an idea that would otherwise be elusive or else just long-winded to say. In that sense, certain marks have become the poster children for their class of goods: Tiffany's for fine jewelry, Google for search engines,

¹⁴² See McGeeveran, *supra* note 128, at 66-71; *Christian Louboutin*, 696 F.3d at 220.

Hennessey for fine liquor, McDonald's for fast food. We refer to these marks by name, not by its category, because they are universals, as enduring in our collective consciousness as the Madonna and child had been for a past age.

Ours is the modern ad age, and if those who are responsible for the persistence of the signs and symbols that surround us via billboards and radio-speak are to have it both ways: that we both only think of Google when we think of search engine and yet that we not "Google" something but "search for it on Google"—well, what would be the justice in that? Genericide is, in my view, the only trademark defense that gives back to the very consumers the entirety of the system depends upon. And genericide is a muscle: the more we flex it, the stronger the argument for the genericity of a mark becomes.¹⁴³ Conversely, the more artists turn to the overwhelmingly popular defense of fair use and its focus on parody, the more we regress to the now-ridiculous idea that there is some unique original left. "Toyota Corolla, Toyota Celica, Toyota Cressida. Supranational names, computer-generated, more or less universally pronounceable. Part of every child's brain noise"¹⁴⁴—welcome to the new information age. The revolution, I believe, should be genericized.

¹⁴³ See *supra* note 8.

¹⁴⁴ DeLillo, *supra* note 95, at 155.