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Selfmarks

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ESSAY

SELFMARKS

*William McGeeveran**

ABSTRACT

“Selfmarks” are branded personal identifiers that can be protected as trademarks. From Kim Kardashian West to Beyoncé’s daughter, attempts to propertize persona through trademark protection are on the rise. But should they be? The holder of a selfmark may use it to send a signal about products, just like the routine types of brand extension, cross-branding, and merchandising arrangements fully embraced under modern trademark law. Yet traditional trademark doctrine has adjusted to selfmarks slowly and unevenly. Instead, the law has evolved to protect selfmarks through mechanisms other than trademarks. In an age where brands have personalities and people nurture their individual brands, it is time to ask what principled reasons we have to *not* protect the individual persona as a trademark.

* Associate Dean for Academic Affairs and Professor of Law, University of Minnesota Law School. I am indebted to all the participants in the University of Houston IPIL National Conference for an engaging discussion of this Essay. I also benefited from presenting an earlier version of this project at the Works in Progress in Intellectual Property Conference hosted by Case Western Reserve University School of Law. I have received especially helpful comments from Stacey Dogan, Andrew Gilden, Laura Heymann, Shontavia Johnson, Sapna Kumar, Glynn Lunney, Mark McKenna, Connie Powell Nichols, Xuan-Thao Nguyen, Lisa Ramsey, and Alexandra Roberts. I am also grateful for student research assistance on this Essay from Richard Canada and to the editors of the *Houston Law Review*.

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I. INTRODUCTION

Kim Kardashian West, the world-famous reality television star, holds numerous registered trademarks in different forms of her name. Some of these are connected to conventional products such as jewelry or fragrances. Others relate more directly to the core of Kardashian West's *raison d'etre*. Under Registration Number 4,978,865, she provides "advertising services, namely, promoting the brands, goods and services of others; [and] endorsement services, namely, promoting the goods and services of others."¹ Registration Number 4,989,420 covers her "entertainment services, namely, personal appearances by a celebrity, actress and model."²

Can those really be trademarks? And should they be? Those turn out to be surprisingly difficult questions, especially considering the ubiquity of celebrity branding and endorsement in our fame-saturated culture. I call these branded personal identities "selfmarks."³ This Essay begins considering the disconnect between personal identity and trademark identity. In an age where

1. KIM KARDASHIAN WEST, Registration No. 4,978,865.

2. KIM KARDASHIAN WEST, Registration No. 4,989,420.

3. I will use the term "selfmark" to refer to personal identifiers like Kardashian

brands have personalities and people nurture their individual brands, it is time to ask what principled reasons we have to *not* protect the individual persona as a trademark.

The business of paying famous people to “like” your brand continues to grow. Kardashian West and her sisters—by far the wealthiest of the “famous for being famous” influencers—charge six figures for a single sponsored Instagram post.⁴ But they are only the most visible (and wealthiest) of the new celebrities whose cachet bestows a benefit on the products they endorse and earns a profit for themselves.⁵ Professional athletes and performers have long provided commercial endorsements for financial remuneration. Today, they are joined by a legion of reality television contestants, social media influencers, and self-produced podcasters or YouTubers. Even relatively ordinary individuals self-consciously cultivate their personal brand in a particular profession or a small topical niche—an opportunity now available to everyone through digital distribution and networked online amplification.⁶ In all these cases, the person’s reputation itself is the thing being sold.

In many ways, selfmarks function like trademarks do under modern doctrine. They represent a particular source in the mind of the public, albeit one associated with a well-known persona instead of with more traditional goods or services. The holder of a selfmark may use it to send a signal about products, just like the routine types of brand extension, cross-branding, and merchandising arrangements fully embraced under modern trademark law. Yet traditional trademark doctrine has adjusted to selfmarks slowly and unevenly. Instead, the law has evolved to protect selfmarks primarily through the common law appropriation tort, state publicity rights law, and false endorsement theories under federal and state unfair competition law. State legislatures continue to consider sweeping proposals for further expansions of publicity

West’s, leaving open the question of whether they do and should qualify for legal trademark protection—which is, after all, the question at the center of this Essay.

4. See Talia Ergas, *Kim, Khloe and Kourtney Kardashian Make Hundreds of Thousands of Dollars for Instagram Ads*, US WEEKLY (Mar. 16, 2017), <https://www.usmagazine.com/celebrity-news/news/kardashian-sisters-make-how-much-for-instagram-ads-w472080/> [<http://perma.cc/97D5-X8KZ>]; Natalie Robehmed, *Inside the Business of Kardashian-Jenner Instagram Endorsements*, FORBES (Nov. 16, 2016, 8:55 AM), <https://www.forbes.com/sites/nalierobehmed/2016/11/16/inside-the-business-of-celebrity-instagram-endorsements/#64c3352e5724> [<http://perma.cc/6P9Q-55TZ>].

5. See Robehmed, *supra* note 4 (discussing the business models by which social media influencers structure endorsement deals).

6. See Forbes Coaches Council, *14 Personal Branding Tips to Help You Grow Your Influence*, FORBES (Mar. 20, 2018, 7:00 AM), <https://www.forbes.com/sites/forbescoachescouncil/2018/03/20/14-personal-branding-tips-to-help-you-grow-your-influence/> [<http://perma.cc/HAY2-3RD7>].

rights.⁷ Plaintiffs routinely invoke all these theories, and trademark infringement as well, in kitchen-sink pleadings. Most courts accept that the selfmark is some sort of a trademark, but seldom devote much analysis to its validity or doctrinal contours.⁸

Others have already observed aspects of the overlap between brand persona and individual persona. Laura Heymann has frequently noted the ways in which brands are conceptualized as personalities by both marketers and customers.⁹ Jessica Silbey interviewed markholders and demonstrated how they consciously view trademarks anthropomorphically—comparing their brand to their “baby.”¹⁰ Not only are trademarks often seen as people, but people are often viewed as trademarks. Roberta Kwall has suggested that “celebrity endorsements function in much the same way as trademarks do—to communicate information about the product.”¹¹ Heymann and the late Greg Lastowka discussed the way writers’ pen names and other “authornyms” function as branding choices.¹² Stacey Dogan and Mark Lemley have argued at length that publicity rights for individual persona ought to emulate trademark law and should largely be limited to core trademark scenarios involving consumer confusion in the marketplace or dilution of the commercial signal sent by a celebrity’s identity.¹³ False endorsement cases decided under Section 43(a) often treat the endorser’s identity sort of like a mark, and may even use the multifactor test for likelihood of confusion to analyze consumer reactions.¹⁴

7. See Mark Bartholomew, *Another Voice: We Don’t Need More VIP Rights for Celebrities*, BUFFALO NEWS (June 15, 2018), <https://buffalonews.com/2018/06/15/another-voice-we-dont-need-more-vip-rights-for-celebrities/> [<http://perma.cc/7FP6-6ZD3>] (criticizing proposed New York bill to significantly expand publicity rights); William McGeeveran, *Hasty Action on a PRINCE Act Would be Pure Folly*, STAR TRIB. (May 11, 2016, 6:22 PM), <http://www.startribune.com/hasty-action-on-a-prince-act-would-be-pure-folly/379061161/> [<http://perma.cc/Q5VQ-BWV4>] (criticizing Minnesota bill to create statutory publicity rights called the “Personal Rights in Names Can Endure Act”—the PRINCE Act—proposed shortly after the death of musician and Minnesota icon Prince).

8. See, e.g., *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 926 (6th Cir. 2003) (quoting *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000)).

9. See, e.g., Laura A. Heymann, *Naming, Identity, and Trademark Law*, 86 IND. L.J. 381, 384 (2011) [hereinafter Heymann, *Naming*]; Laura A. Heymann, *The Scope of Trademark Law in the Age of the Brand Persona*, 98 VA. L. REV. BRIEF 61, 68 (2012) [hereinafter Heymann, *Brand Persona*].

10. JESSICA SILBEY, *THE EUREKA MYTH: CREATORS, INNOVATORS, AND EVERYDAY INTELLECTUAL PROPERTY* 156–60 (2015).

11. Roberta Rosenthal Kwall, *Fame*, 73 IND. L.J. 1, 25 (1997).

12. Laura A. Heymann, *The Birth of the Authornym: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377 (2005); Greg Lastowka, *The Trademark Function of Authorship*, 85 B.U. L. REV. 1171 (2005).

13. See Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1191–93 (2006).

14. See *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626–27 (6th Cir. 2000)

My particular aim here is to look at selfmarks within the context of traditional trademark doctrine. Trademark law has grown to encompass so many types of sponsorship or endorsement relationships between a trademark and an underlying product. These expanded boundaries protect trademarks identifying artificial corporatized entities such as COKE or the NEW YORK YANKEES against uses that confusingly conflate them with the products of others. In what ways does and should trademark law extend similar protection to the selfmark identifying KIM KARDASHIAN WEST?

Part II of this Essay considers what counts as a selfmark. Part III shows how crucial elements of trademark validity fit awkwardly with some aspects of the selfmark. Finally, Part IV discusses two overarching issues with the handling of personal identity through trademark law: the difficulty of ascertaining what counts as an infringing use and concerns about preserving free speech. I will not pretend to reach any definitive conclusions about selfmarks in such a brief Essay, but I hope it contributes to a different way of asking questions about the intersection of personal identity and trademark law.

II. WHAT ARE SELFMARKS?

A. *Subject Matter Covered by Selfmarks*

In recent decades, personal identities of the sort covered by selfmarks have benefited from rapidly increasing legal protection through state publicity rights laws, the privacy-based tort of appropriation, and common law claims of false endorsement.¹⁵ Most of these doctrines have grown up quite separately from core trademark law. Plaintiffs often plead overlapping violations of trademarks, unfair competition law, publicity rights, and privacy rights without much distinction between them. Frequently the core rules and rationales behind these theories do not align.

Many publicity rights statutes explicitly delineate the attributes of persona they cover. New York's law, for example, is limited

(applying traditional multifactor test because “the ‘mark’ at issue is the plaintiff’s identity”).

15. See generally SAMANTHA BARBAS, *LAW OF IMAGE: PRIVACY AND PUBLICITY IN AMERICA* 52, 102–21 (2015); JENNIFER E. ROTHMAN, *THE RIGHT OF PUBLICITY: PRIVACY REIMAGINED FOR A PUBLIC WORLD* 17–22 (2018). Other countries offer a similarly wide array of legal theories for persona protection. See SIMON SMITH, *IMAGE, PERSONA, AND THE LAW* 71, 111–13 (2d ed. 2008) (canvassing the law of England and Wales, including theories based in privacy and data protection, trademark and tortious passing off, defamation, copyright, and contract).

to an individual's "name, portrait, picture, or voice."¹⁶ On the other hand, courts generally interpret tort claims grounded in theories of publicity or appropriation more broadly.¹⁷ These cases often consider attributes such as an individual's unusual singing style¹⁸ or recognizable accouterments¹⁹ to be capable of trademark protection.

Trademark law definitely does not rely on a closed list of attributes that can be protected. Rather, according to the Supreme Court, "almost anything at all that is capable of carrying meaning" can serve as a trademark.²⁰ Over the last sixty or so years, the subject matter of trademark law has steadily expanded to more types of indicators.²¹ These now may include color, design, packaging, sound, scent, and even a Mexican restaurant's "festive eating atmosphere."²² Like many others, I have criticized these expansions.²³ But, today they are the law.

Assuming they fulfill the requirements of trademark validity,²⁴ it seems logical that selfmarks should also include "anything capable of conveying meaning" about a source, including the indication of a particular individual as a source.²⁵

16. N.Y. CIV. RIGHTS LAW § 51 (McKinney 2009); *see* *Burck v. Mars, Inc.*, 571 F. Supp. 2d 446, 451 (S.D.N.Y. 2008); *see also* CAL. CIV. CODE § 3344(a), (e) (West 2016) (protecting "name, voice, signature, photograph, or likeness").

17. *See, e.g.*, *Midler v. Ford Motor Co.*, 849 F.2d 460, 463–64 (9th Cir. 1988); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983); ROTHMAN, *supra* note 15, at 88–93.

18. *See Midler*, 849 F.2d at 463; *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100–01 (9th Cir. 1992); *see also Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 61–62 (2d Cir. 2001) (stating that a song could be capable of serving as a trademark representing an individual's goods and services under the Lanham Act, but rejecting the claim in the case at hand).

19. *See Carson*, 698 F.2d at 836; *Motschenbacher v. R. J. Reynolds Tobacco Co.*, 498 F.2d 821, 827 (9th Cir. 1974) (finding unique features of a professional race car driver's vehicle within the ambit of his state-law publicity rights).

20. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

21. *See* Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 384–87 (1999); William McGeeveran & Mark P. McKenna, *Confusion Isn't Everything*, 89 NOTRE DAME L. REV. 253, 267–70 (2013).

22. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 (1992) (citing *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1117 (5th Cir. 1991) (internal quotation marks omitted)).

23. McGeeveran & McKenna, *supra* note 21 *passim*; *see, e.g.*, Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1688, 1695 (1999); Mark P. McKenna, *Testing Modern Trademark Law's Theory of Harm*, 95 IOWA L. REV. 63, 66–67 (2009); Rebecca Tushnet, *Running the Gamut from A to B: Federal Trademark and False Advertising Law*, 159 U. PA. L. REV. 1305, 1308–09, 1365 (2011).

24. There are, of course, formal requirements for recognition of a selfmark as a valid trademark. A mark must be in commercial use, it must be distinctive, and it must not be barred by any disqualifying doctrines, including several applicable to names. I will consider these requirements in Part III, *infra*.

25. I am not considering fictional characters used in many brands, such as BETTY CROCKER for cakes, to be selfmarks. *See* BETTY CROCKER, Registration No. 4,230,192.

As we shall see, there are special rules concerning personal names,²⁶ but these are not the only indicators we might consider selfmarks. Many familiar personal identifiers other than names already receive protection under trademark law, such as Walt Disney's signature for the entertainment conglomerate and its products;²⁷ the stylized portrait of Colonel Sanders for KFC;²⁸ or Paris Hilton's catchphrase "That's Hot" for clothing.²⁹ Just as logos, product design, catchphrases, and "look and feel"³⁰ can be perceived as source indicators and protected as trademarks, so too selfmarks might encompass names, photos, signatures, catch phrases, nicknames, and so forth—whatever causes the public to unmistakably think of the single individual.

B. *Selfmark Scenarios*

Selfmarks appear in a range of scenarios. Trademark doctrine works more smoothly with the scenarios where an indicator that happens to be a selfmark is also a label for tangible goods or traditional services. The fit is more awkward when the selfmark draws directly on an individual's renown to convey information and achieve marketing objectives.

1. *The Creator Scenario*

First, plenty of trademarks are simply the selfmark of someone involved—either in the past or the present—with providing the goods that now bear the mark. There were people behind many brand names that now live in memory almost entirely as trademarks such as KELLOGG's for cereal or JACUZZI for hot tubs.³¹ Even in their day, when the colorful entrepreneurs behind both names had some modest renown, that association with the individual was tied to a product signified by the corporate-controlled trademark.³² Thus, in the beginning the mark was a selfmark but also, simultaneously, still a conventional trademark. It identified

26. In particular, see *infra* Part III.C.

27. See, e.g., WALT DISNEY RECORDS, Registration No. 2,310,987.

28. See U.S. Trademark Application Serial No. 87/027,592 (filed May 6, 2016).

29. See THAT'S HOT, Registration No. 3,209,488 (for clothing); *Hilton v. Hallmark Cards*, 599 F.3d 894, 899 (9th Cir. 2010).

30. *Coach Leatherware Co. v. AnnTaylor, Inc.*, 933 F.2d 162, 170 (2d Cir. 1991) (citation omitted).

31. Wikipedia has an impressively long list of companies named for people. See *List of Companies Named After People*, WIKIPEDIA, https://en.wikipedia.org/wiki/List_of_companies_named_after_people [http://perma.cc/6HG8-H9VV] (last visited Nov. 2, 2018); KELLOGG'S, Registration No. 4,446,100; JACUZZI, Registration No. 1,101,174.

32. See *Will Keith Kellogg*, LEMELSON-MIT, <http://lemelson.mit.edu/resources/will-keith-kellogg> [http://perma.cc/VD5M-PD2X] (last visited Nov. 2, 2018); Glenn Fowler, *Candido Jacuzzi, 83, Is Dead: Inventor of Whirlpool Bath*, N.Y. TIMES, Oct. 10, 1986, at D18.

both a person and a product (or service) with which that person had a connection.

Today, most people would no longer recognize KELLOGG'S or JACUZZI as selfmarks at all, only as trademarks for products. A 2010 survey commissioned by KFC found that fifty percent of Americans ages 18 to 25 did not know Colonel Sanders was a real person at all, mistaking him for a fictional corporate mascot like Ronald McDonald or Mrs. Butterworth.³³ All of these are now selfmarks that have transformed into ordinary trademarks, bearing secondary meaning associated with the products. Indeed, I would argue that a mark like JACUZZI has become arbitrary or fanciful, not descriptive; today, anyone with that surname sounds like they have the name of a hot tub, rather than the other way around.

Newer eponymous products, or those involving individuals with more enduring fame, may still retain their dual nature as selfmarks and conventional trademarks. Think here of FORD for cars,³⁴ DONNA KARAN for apparel,³⁵ or ORVILLE REDENBACHER'S for popcorn.³⁶ As brands, all three have outlasted the people they denote. Henry Ford died in 1947, although his heirs retain effective control of the corporation he founded.³⁷ Karan left her eponymous fashion label in 2015.³⁸ And Redenbacher sold his popcorn company to the food conglomerate Hunt-Wesson in 1976 but continued to appear as the commercial spokesman for the brand.³⁹ Present-day consumers may be familiar with the human signified by these marks (although that is an empirical assumption). If so, these trademarks may continue to function—secondarily—as selfmarks today.

33. Raphael Brion, *KFC's Colonel Sanders Is a Stranger to American Teens*, EATER (Sept. 9, 2010, 11:40 AM), <https://www.eater.com/2010/9/9/6719933/kfcs-colonel-sanders-is-a-stranger-to-american-teens> [<http://perma.cc/UX3Y-G3V3>]; see Bruce Horovitz, *KFC Tries to Revive the Colonel's Prestige*, USA TODAY, Sept. 9, 2010, at 3B; see generally JOSH OZERSKY, *COLONEL SANDERS AND THE AMERICAN DREAM 1* (2012) (a biography of Sanders focusing on the symbolism he embodied).

34. See FORD, Registration No. 74,530.

35. See DONNA KARAN, Registration No. 1,692,152.

36. See ORVILLE REDENBACHER'S, Registration No. 3,928,255.

37. See Christina Rogers, *Ford Founding Family Keeps Backing of Shareholders*, WALL ST. J., May 13, 2016, at B3; see also *Auto Pioneer Henry Ford Dies*, HISTORY (Nov. 13, 2009), <https://www.history.com/this-day-in-history/auto-pioneer-henry-ford-dies> [<http://perma.cc/YRH5-WL6D>].

38. See Lisa Lockwood, *Donna Karan to Step Down at DK1*, WWD (June 30, 2015), <http://wwd.com/fashion-news/designer-luxury/donna-karan-steps-down-dki-10173733/> [<http://perma.cc/42NT-WPH8>]. Karan co-founded the company and took it public; it was eventually acquired by the luxury brands giant LVMH Moët Hennessey Louis Vuitton. *Id.*

39. See Gail Collins, *Orville Redenbacher: Our Inner Nerd*, N.Y. TIMES MAG., Dec. 31, 1995, at 23.

Finally, there are some outsized executives whose fame becomes associated with the brand informally, without ever being officially adopted as a corporate trademark. The selfmarks of Richard Branson at Virgin (including his facial hair) or Steve Jobs at Apple (including his black turtleneck) became part of consumer understanding about the source of those companies' products.⁴⁰

When people are only known, if at all, because of the brands they helped create, the commercial use of their identity fits fairly well into traditional trademark doctrine. The law largely handles these situations like a (descriptive⁴¹) trademark. It does not matter much whether the selfmark's reputation has expired or whether the creator was ever widely known. That reputation gets subsumed in the more conventional trademark identifying the source of goods and services. The selfmark is surplusage.

2. *The Licensor Scenario*

An intermediate scenario occurs when famous celebrities loan their cachet to a business venture by allowing the use of their identities as trademarks for products. Essentially, they license their pre-existing selfmark for the branding of something else. The selfmark's reputation does not derive from the product; the use of its fame helps boost the recognition of the product. This is how the TRUMP selfmark ended up on things with which its namesake had very little involvement other than a licensing contract, including steaks, vodka, real estate developments around the world, and a so-called "university."⁴²

The same thing happens when celebrities start a product line under the umbrella of a more established house brand. Martha Stewart has had complex contractual relationships (and resulting disputes) with multiple retailers who use her selfmark on home décor items.⁴³ Drew Barrymore sells a DEAR DREW clothing line

40. See Kif Leswing, *A New Version of Steve Jobs' Iconic Black Turtleneck Costs \$270*, BUS. INSIDER (June 28, 2017, 2:56 PM), <https://www.businessinsider.com/steve-jobs-iconic-black-turtleneck-by-issey-miyake-costs-270-2017-6> [<http://perma.cc/PZQ9-BT6K>]; see also *The Golden Goatee: Usain Bolt Sports a Branson Beard for the Tycoon's Latest Ad Campaign*, DAILY MAIL (Jan. 13, 2012), <https://www.dailymail.co.uk/news/article-2086326/Usain-Bolt-sports-Branson-beard-tycoons-latest-ad-campaign.html> [<http://perma.cc/KHH3-2WWG>].

41. See *infra* Section II.B.

42. See Aaron Williams & Anu Narayanswamy, *How Trump Has Made Millions by Selling His Name*, WASH. POST (Jan. 25, 2017), <https://www.washingtonpost.com/graphics/world/trump-worldwide-licensing/> [<http://perma.cc/G4CA-PYQ6>]; David A. Graham, *The Many Scandals of Donald Trump: A Cheat Sheet*, ATLANTIC (Jan. 23, 2017), <https://www.theatlantic.com/politics/archive/2017/01/donald-trump-scandals/474726/> [<http://perma.cc/8FVG-HLS6>].

43. See *Macy's Inc. v. Martha Stewart Living Omnimedia, Inc.*, 6 N.Y.S.3d 7, 9–10 (N.Y. App. Div. 2015) (involving disputes between Macy's and J.C. Penney concerning

through Amazon Fashion, an initiative of the giant online retailer.⁴⁴ It seems most female celebrities (and a few men) have launched their own fragrance, often with the selfmark of their name and image as branding elements and another trademark applied to the perfume itself (as in CURIOUS BY BRITNEY SPEARS).⁴⁵

Inevitably, celebrities engage in promotion of the products bearing their selfmarks. Sometimes they are portrayed as having significant involvement in the development of the licensed product too.⁴⁶ Stars such as Sarah Jessica Parker have served as the “artistic director” for a selfmark-branded perfume, approving its scent as well as the associated marketing.⁴⁷ Promotional copy from the website for actress Eva Longoria’s clothing line is representative of the genre; she says, “[c]reating this collection has always been a dream of mine. I’ve been sewing since the age of 7 so this

exclusive rights to sell “bedding, bathware, housewares and cookware” under the MARTHA STEWART selfmark). Television and radio host Ryan Seacrest also sells a clothing line, “Ryan Seacrest Distinction,” exclusively through Macy’s. *See About, RYAN SEACREST DISTINCTION*, <https://www.ryanseacrestdistinction.com/about/> [<http://perma.cc/HQZ8-ZRHC>] (last visited Nov. 2, 2018).

44. *See Dear Drew by Drew Barrymore*, AMAZON, <https://www.amazon.com/stores/node/16284341011> [<http://perma.cc/MSV6-CBH9>] (last visited Nov. 2, 2018) (featuring video and photos of Drew Barrymore promoting a clothing line under her name, available from Amazon); Marcy Medina, *Drew Barrymore Launches Lifestyle Brand on Amazon Fashion*, WWD (Oct. 23, 2017) <https://wwd.com/fashion-news/fashion-scoops/drew-barrymore-launches-lifestyle-brand-amazon-fashion-11032817/> [<http://perma.cc/BE92-7GXP>].

45. *See* Steven McIntosh, *Is This the End of Celebrity Fragrances?*, BBC (Feb. 28, 2017), <http://www.bbc.com/news/entertainment-arts-38756997> [<http://perma.cc/6JRG-A52E>] (reporting on a decline in sales for celebrity fragrances but not, by any means, their end); Jenna Rosenstein, *The 14 Best Celebrity Perfumes of All Time*, HARPER’S BAZAAR (Aug. 30, 2017), <https://www.harpersbazaar.com/beauty/makeup/g12135032/best-celebrity-perfumes/> [<http://perma.cc/7PUJ-X8SJJ>] (including perfumes “by” Britney Spears, Sarah Jessica Parker, Paris Hilton, and Elizabeth Taylor). Wikipedia comes through for us again here. *See List of Celebrity-Branded Perfumes*, WIKIPEDIA, https://en.wikipedia.org/wiki/List_of_celebrity-branded_perfumes [<http://perma.cc/DJ3N-C4AS>] (last visited Nov. 2, 2018); ELIZABETH ARDEN, INC., Annual Report (Form 10-K) (June 30, 2010) (showing Curious by Britney Spears as a trademark license under Elizabeth Arden, Inc.).

46. *See* Dessert Beauty, Inc. v. Fox, 568 F. Supp. 2d 416, 420 (S.D.N.Y. 2008), *aff’d*, 329 Fed. Appx. 333 (2d Cir. 2009) (describing promotion of a line of perfumes by Jessica Simpson for the fragrance company Dessert Beauty Inc., including a public relations backstory involving her then-husband kissing her).

47. *See* CHANDLER BURR, *THE PERFECT SCENT: A YEAR INSIDE THE PERFUME INDUSTRY IN PARIS AND NEW YORK* xii–xiv, 164–76 (2009). Burr’s book follows the development of Parker’s perfume from concept to execution. *Id.* at 24. He explains the fairly typical involvement of three parties in the business deal. *See id.* at 165. Coty, Inc., an international perfume licensing company, was the lead investor and handled development, marketing, and overhead. *Id.* Coty enlisted International Flavors and Fragrances, a world-famous perfumers’ firm, to develop the actual scent. *Id.* Finally, “Parker is the concept, the commercial idea around which this particular Coty venture is built.” *Id.* at 165.

entire journey has just been an amazing experience for me.”⁴⁸ The Longoria clothes (and the website) are actually produced by Seven Licensing Company, LLC, a subsidiary of Sunrise brands, a private label clothing manufacturer that also owns the Seven7 jeans brand.⁴⁹

Like the selfmarks in the Creator Scenario, licensed selfmarks can evolve into more conventional trademarks. The trademark ROY ROGERS for fast food came about when the Marriott Corporation struck a licensing deal with Rogers, the then-legendary cowboy actor, to rebrand its ROBEE’S chain with his name.⁵⁰ Perhaps in a sign that fame is fleeting, I suspect today few customers eating roast beef sandwiches in the remaining Roy Rogers restaurants know he was a star.

The selfmark serves a different purpose in this Licensor Scenario than in the previous Creator Scenario. Here, because the celebrity’s fame comes first, the public recognizes *the selfmark* as an indicator of the source of *the product*. As perfume industry expert Chandler Burr explains, customers for celebrity perfumes value the opportunity to connect themselves with a star: “It is, in a small way, meeting them.”⁵¹ The selfmark tells consumers that an identifiable person is the “source” of goods or services to which it is attached. Britney Spears is not the source of her perfume in the same way Donna Karan was the source of her famous bodysuits. But the public understanding of their source roles will usually be stronger in the Licensor Scenario than in the Creator Scenario because the selfmark is likely to be stronger.

3. *The Endorser Scenario*

A final scenario is an endorsement of a brand that remains distinct from the endorser’s personal identity. We are familiar with countless examples such as Jennifer Aniston promoting Aveeno products or appearances by Alec Baldwin and Jennifer Garner in advertisements for Capital One credit cards.⁵² Tennis

48. *Brand Overview*, SUNRISE BRANDS, <http://sunrisebrands.com/brands/eva-longoria/> [<http://perma.cc/MV6S-SPN7>] (last visited Nov. 2, 2018).

49. *See Our Business*, SUNRISE BRANDS, <http://sunrisebrands.com/company/> [<http://perma.cc/GVQ2-UHA3>].

50. *See* Thomas Heath, *Their ‘Holy Trio’ of Burgers, Chicken, Roast Beef*, WASH. POST, Apr. 18, 2016, at A16. Something quite similar happened when professional hockey player Tim Horton participated in the opening of a coffee shop; if you are Canadian, or you have ever met a Canadian, you might be familiar with TIM HORTONS for breakfast-oriented restaurant services. *See Our Story*, TIM HORTONS, <https://www.timhortons.com/us/en/corporate/our-story.php> [<http://perma.cc/D2HH-GPN7>] (last visited Nov. 2, 2018).

51. McIntosh, *supra* note 45 (quoting author and perfume expert Chandler Burr).

52. Fortunately for my research, there are people who collect these examples and post them on the internet as a hobby. *See About Celebrity Fashionation*, CELEBRITY

star Roger Federer has endorsement deals not only for the Wilson tennis racquets and Nike sports apparel topically related to his persona, but also for Mercedes-Benz, Rolex, Credit Suisse, Lindt chocolates, Jura coffee and Barilla pasta.⁵³

These types of high-visibility celebrity endorsements are the ones that Judge Jerome Frank had in mind when writing the 1953 opinion in an early important case in the history of the free-standing right of publicity. Judge Frank commented that “many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways.”⁵⁴

The Endorser Scenario also includes the use of social media, particularly by popular “influencers” with a large and engaged online audience, to promote products sold under a separate trademark.⁵⁵ The Kardashians’ lucrative Instagram posts fall here.⁵⁶ But endorsers need not be world-famous television celebrities. Commercial promotion of perfectly ordinary people’s selfmarks through “social marketing” techniques seeks to cultivate and spread online “word of mouth” endorsements; Facebook founder Mark Zuckerberg has called such trusted referrals from friends or family the “Holy Grail” of marketing.⁵⁷ In one high-profile case, a

FASHIONATION, [http://www.celebrityendorsementads.com/celebrity-endorsements/about/\[http://perma.cc/7D69-45G2\]](http://www.celebrityendorsementads.com/celebrity-endorsements/about/[http://perma.cc/7D69-45G2]) (last visited Nov. 2, 2018) (“The concept behind the Celebrity Fashion & Perfume (CFP) network is to provide a resource guide for historical documentation of all celebrity endorsed products.”); *Jennifer Aniston—Celebrity Endorsements*, CELEBRITY FASHIONATION, [http://www.celebrityendorsementads.com/celebrity-endorsements/celebrities/jennifer-aniston/\[http://perma.cc/G7XG-2RXY\]](http://www.celebrityendorsementads.com/celebrity-endorsements/celebrities/jennifer-aniston/[http://perma.cc/G7XG-2RXY]) (last visited Nov. 2, 2018); see also Darren Heitner, *Capital One’s March Madness Campaign Banks on Baldwin, Barkley and Hashtags*, FORBES (Mar. 15, 2013, 8:01 AM), <https://www.forbes.com/sites/darrenheitner/2013/03/15/capital-ones-march-madness-campaign-banks-on-baldwin-barkley-and-hashtags/#4fab3f11217> [http://perma.cc/P6PD-D4PE]; *Jennifer Garner-Celebrity Endorsements*, CELEBRITY FASHIONATION, [http://www.celebrityendorsementads.com/celebrity-endorsements/celebrities/jennifer-garner/\[http://perma.cc/L4VK-WWDS\]](http://www.celebrityendorsementads.com/celebrity-endorsements/celebrities/jennifer-garner/[http://perma.cc/L4VK-WWDS]) (last visited Nov. 2, 2018).

53. See Ahzia Garcia, *Older Athletes Are Killing It on the Field and with Endorsements*, CNN MONEY (Jan. 31, 2018, 5:03 PM), <http://money.cnn.com/2018/01/31/news/companies/tom-brady-roger-federer-endorsement/index.html> [http://perma.cc/6PW3-ANLA].

54. *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

55. See Evan Varsamis, *Are Social Media Influencers the Next-Generation Brand Ambassadors?*, FORBES (June 13, 2018, 9:00 AM), <https://www.forbes.com/sites/theyec/2018/06/13/are-social-media-influencers-the-next-generation-brand-ambassadors/> [http://perma.cc/YS84-N8AY].

56. See *supra* notes 4–5 and accompanying text.

57. See William McGeveran, *Disclosure, Endorsement, and Identity in Social Marketing*, 2009 U. ILL. L. REV. 1105, 1109–13 (citation omitted). For a biting parody of such “viral” endorsement promotions, see generally JENNIFER EGAN, *A VISIT FROM THE GOON SQUAD* 139 (2010) (portraying a dystopian future dominated by inauthentic influencer marketing,

court refused to dismiss a publicity rights class action litigation against Facebook for the endorsements implied by an earlier version of its “Sponsored Stories” feature.⁵⁸

Or successful endorsers can be famous, but only within niches. “Lifestyle vlogger” Lauren Riihimaki, whose primary self-mark is her online handle “LaurDIY,” has amassed millions of followers for her videos about craft projects for home and fashion. She now has marketing deals with Fanta soda, Mudd jeans, and Pop-Sockets mobile phone accessories.⁵⁹ Riihimaki has not registered her given name as a trademark, but she did register a trademark for LAURDIY in the middle of 2017.⁶⁰ This first registration emulates Kim Kardashian West’s trademark strategy; it covers endorsement and spokesperson services to “promote the products and services of others” and entertainment services encompassing not only the production of her online programming but also “personal appearances by a celebrity.”⁶¹

The Federal Trade Commission has tightened its regulations mandating disclosure of paid “influencer” endorsements⁶² and recently sent inquiry letters to stars including Naomi Campbell and Lindsay Lohan seeking information about potential breaches of those rules in their Instagram posts.⁶³ But they are a fast-growing part of the marketing landscape—and that growth adds urgency to a serious analysis of selfmarks.

In theory, a selfmark used for endorsement could become such a part of a brand’s identity that it collapses into more of a traditional trademark as happened with KELLOGG’S or ROY ROGERS. But in reality it is very difficult to find examples. Hypo-

but also it’s funny).

58. See *Fraley v. Facebook, Inc.*, 830 F. Supp. 2d 785, 799 (N.D. Cal. 2011).

59. See Tom Ward, *LaurDIY: The Millennial Martha Stewart*, FORBES (Feb. 25, 2018, 12:39 PM), <https://www.forbes.com/sites/tomward/2018/02/25/laurdiy-the-millennial-martha-stewart/> [http://perma.cc/Q37H-5TPE] (last visited Nov. 2, 2018); LaurDIY, YOUTUBE, <https://www.youtube.com/user/LaurDIY/> [http://perma.cc/6PZN-FETU] (last visited Nov. 2, 2018) (showing a subscriber count of over 8.5 million); Lauren Riihimaki (@laurdiy), INSTAGRAM, <https://www.instagram.com/laurdiy/> [http://perma.cc/7YP4-9Q8F] (last visited Nov. 2, 2018) (showing a subscriber count of over 4.7 million).

60. LAURDIY, Registration No. 5,196,209.

61. *Id.*

62. See 16 C.F.R. § 255.5 (2017). For commentary on FTC oversight, see generally Leah W. Feinman, *Celebrity Endorsements in Non-Traditional Advertising: How the FTC Regulations Fail to Keep up with the Kardashians*, 22 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 97, 122 (2012).

63. See David Ingram & Diane Bartz, *FTC Demands Endorsement Info from Instagram ‘Influencers’*, REUTERS (Sept. 13, 2017, 5:01 PM), <https://www.reuters.com/article/us-usa-ftc-celebrities/ftc-demands-endorsement-info-from-instagram-influencers-idUSKCN1BO2TE> [http://perma.cc/GLS4-XH97].

thetically, the famous fedora-clad movie actor Karl Malden, uttering the slogan “Don’t Leave Home Without It” as a spokesperson for American Express Traveler’s Cheques from 1973 to 1994, may have become so inextricably linked to their brand identity as to become, effectively, a trademark for it.⁶⁴ If a competitor had begun using a similarly attired deadpan spokesperson, American Express might have had a strong trademark confusion claim, at least under the doctrine of 2018. But in the Endorser Scenario, the selfmark retains much more of its meaning as a designation of the source of the endorsement rather than of the product. It is more like KARL MALDEN for Malden’s endorsement, less KARL MALDEN for American Express.

There are many parallels between all the selfmark scenarios described above and common marketing scenarios that arise in ordinary trademark law. L.L. BEAN branding has appeared on select Subaru vehicles and COACH trademarks on Lexus automobiles.⁶⁵ Recently, I stood waiting for my teenager to select jeans at a trendy PacSun store and was confronted with a shelf of t-shirts bearing trademarks from PLAYBOY, NASA, POLAROID, NINTENDO, and NICKELODEON. These cross-branding relationships work very similarly to the Licensor Scenario: a company borrows the fame of an existing identity to promote its own offerings. Similarly, we see the Endorser Scenario with corporate trademarks, not just with selfmarks. When the electronics company Panasonic proudly announces that its electric razors are the “[o]fficial [s]havers and [t]rimmers of the New York Yankees,”⁶⁶ it is leveraging an endorsement just like Jennifer Aniston’s endorsement of Aveeno. Despite these similarities, it turns out traditional

64. See Beth Snyder Bulik, *Karl Malden Never Left Home Without It*, AD AGE (July 1, 2009), <http://adage.com/article/adages/karl-malden-obituary-delivered-famous-amex-ad-tagline/137713/> [<http://perma.cc/E35X-997W>]. At our IPIL conference, several participants pointed to the possible counterexample of Paul Marcarelli, the actor who became famous for asking, in countless television commercials for Verizon, “Can you hear me now?” Verizon’s competitor Sprint made a splash by later hiring him to appear in its ads, in which he mocked the earlier ones by saying he had switched to Sprint. See Jeff Beer, *How Sprint Got Verizon’s “Can You Hear Me Now” Guy to Change Teams*, FAST CO. (June 6, 2016), <https://www.fastcompany.com/3060648/how-sprint-got-verizons-can-you-hear-me-now-guy-to-change-teams> [<http://perma.cc/WL9E-L6KV>]. This isn’t quite right, however, because Marcarelli had no particular reputation before the Verizon ads. He did not bring a selfmark to Verizon with an endorsement; rather, Verizon created a branded character and hired him to portray it.

65. Laura Clark Geist, *Licensing Links Brands, People with Goods*, AUTOMOTIVE NEWS (Sept. 16, 2002, 12:01 AM), <http://www.autonews.com/article/20020916/ANA/209160709/licensing-links-brands-people-with-goods> [<http://perma.cc/UQB2-P3YK>].

66. See PANASONIC CONSUMER ELECS. CO., *Panasonic Announces Multi-Year Sponsorship with the New York Yankees*, PR NEWswire (July 24, 2017, 8:00 ET), <https://www.prnewswire.com/news-releases/panasonic-announces-multi-year-sponsorship-with-the-new-york-yankees-300492501.html> [<http://perma.cc/X36G-2C3W>].

trademark doctrine does not fit selfmarks in these latter categories so easily. The next Part explores some of these disconnects.

III. PROTECTING SELFMARKS

There are three sets of fundamental requirements for anything to be recognized as a trademark.⁶⁷ These principles should apply to selfmarks as they apply to all other marks. First, the use requirement means an identity asserted as a selfmark would need to have been exploited commercially in specific ways. Second, the purported selfmark must be distinctive—that is, it must be perceived by consumers as an indication of the source of a product or service. Finally, in contrast to these two validity requirements that fit awkwardly with selfmarks, several provisions in Section 2 of the Lanham Act are specially tailored to protect the rightful holders of selfmarks in the trademark registration process, and thus import privacy and autonomy considerations into trademark law. This Part considers each of the three in turn.

A. Use

A trademark can be protected only if a markholder demonstrates commercial use of the mark. In the early days of trademark law, this meant affixing a mark to goods, but this is no longer the rule.⁶⁸ Today, federal registration requires proof of use in commerce.⁶⁹ Courts have uniformly extended this same use requirement to unregistered marks as well, both because use gives the public the opportunity to form an association between the mark and its source, and because a demand of use prevents competitors or opportunists from claiming bad-faith blocking marks that are not actually found in the market.⁷⁰

In trademark law, a putative mark can pass the bar for bona fide commercial use as soon as it is employed to promote goods or services.⁷¹ The courts also agree that commerciality is required not

67. See Alexandra J. Roberts, *Tagmarks*, 105 CAL. L. REV. 599, 624 (2017) (describing the three requirements for a trademark: use, distinctiveness, and conformance with the Lanham Act).

68. See 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 16:22 (5th ed. 2018).

69. See 15 U.S.C. § 1051(a)(3)(C) (2012).

70. See *Zazú Designs v. L'Oreal, S.A.*, 979 F.2d 499, 503 (7th Cir. 1992).

71. See MCCARTHY, *supra* note 68, at § 16:18. Some preparatory activity may possibly suffice to establish rights, but courts are hesitant to recognize any rights without actual use. See *id.* §§ 16:12–16:13. The Lanham Act's "intent-to-use" provisions create some provisional rights for applicants who anticipate future use of an asserted trademark, but the rights are not perfected, and thus not enforceable against others, until the applicant verifies that use in commerce has occurred. See 15 U.S.C. § 1051(b), (d)(1).

only for trademark validity but also for standing in trademark cases.⁷² But what does it mean for a person to use a selfmark in commerce? We use our name and voice every day. Many of those uses certainly could be conceived of as commercial, especially if they are associated with our personal professional activities. And often these fit the more traditional scenarios described above. If I make jewelry and sell it on a website like Etsy using a selfmark such as my name or a consistent online handle, I have commercially used those identifiers in just the same way as a trademark. In a service economy in the age of personal branding, however, when should we pinpoint the moment of first commercial use of a selfmark?

There are some extreme possible answers. When reality television star (and sometime presidential advisor) Omarosa Manigault Newman sought to register her first name, OMAROSA, as a trademark for a range of “entertainment services,” her application indicated that “[t]he mark was first used at least as early as 02/05/1974 and first used in commerce at least as early as 00/00/1992.”⁷³ February 5, 1974, is her date of birth; she began her college degree in broadcast journalism at Central State University in Ohio in 1992.⁷⁴ In a sense, Omarosa had been “using” her own unusual first name almost from the day she learned to speak. But when did the *commercial* use of her identity really start? Was it when she began, as a student, promoting her services as a broadcaster? When she first began working? Or in 2004, the date she actually applied to register, when she appeared in the first season of *The Apprentice* on NBC?⁷⁵

72. See *Condit v. Star Editorial, Inc.*, 259 F. Supp. 2d 1046, 1052 (E.D. Cal. 2003) (reviewing case law and determining “[a] majority of circuits require a commercial interest in a mark, that is, at minimum, a present intent to commercialize a mark”); see also *Colligan v. Activities Club of N. Y., Ltd.*, 442 F.2d 686, 692 (2d Cir. 1971) (a leading case on standing).

73. See U.S. Trademark Application Serial No. 78/428,292 (filed June 1, 2004). I am grateful to Mark McKenna for pointing out this example.

74. *Omarosa Manigault-Stallworth*, ENCYCLOPEDIA.COM, <https://www.encyclopedia.com/education/news-wires-white-papers-and-books/manigault-stallworth-omarosa> [<http://perma.cc/D6T3-UV2F>] (last visited Nov. 2, 2018).

75. In addition to entertainment services, the application also sought protection for a range of apparel, but it dated first commercial use in those classes to the application year, 2004. Frances Romero, *The Apprentice: Omarosa Gets Fired and Hired*, TIME (Apr. 07, 2011), <http://entertainment.time.com/2011/04/08/32-epic-moments-in-reality-tv-history/slide/the-apprentice-omarosa-gets-fired-and-hired-and-fired/> [<http://perma.cc/64QT-FXDT>]. The entire application was eventually abandoned after an office action found OMAROSA failed to function as a trademark. Manigault again applied for a selfmark in the same categories of goods and services a few years later, but at that time the examiner determined that her name was likely to be confused with the preexisting registered mark AMOROSO for clothing, and she again abandoned it. See U.S. Trademark Application Se-

Surely there was no commercial activity connected to Omara's selfmark on the day she was born. Similar issues arose when Beyoncé and Jay-Z filed an intent-to-use application for a trademark in the unusual name of their infant daughter, BLUE IVY CARTER, purportedly for use in a planned line of baby clothes and products.⁷⁶ A wedding planner who had already used the name BLUE IVY for her company opposed registration and cited a story in a glossy magazine cover story reporting that Jay-Z said they had registered the trademark merely to prevent others from using it.⁷⁷

Selfmarks for babies cannot qualify for protection until they are used commercially. But it can honestly be difficult to tell when legally relevant use did start. Trademark law does not require a presence on national network television before a trademark is considered to be used in connection with a commercial service. The same issues are present in the case of non-celebrities too. In a modern "gig" economy, with widespread self-employment, every freelance carpenter found on Angie's List engages in branding with a selfmark. Whether calling herself "Sally Smith the carpenter" or "Ace Carpentry," she has established the same sort of commercial exploitation that trademark doctrine requires for use. Lawyers in private practice should appreciate this conundrum. Rainmaking strives to connect the attorney's selfmark with the provision of legal services, and it involves a conscious effort of branding.⁷⁸ So, when a new associate at a law firm begins blogging about legal issues, or promoting her professional expertise on LinkedIn, is she

rial No. 78/955,495 (filed Aug. 18, 2006). Manigault recently filed another selfmark application, this time for motivational speaking and workshops in the fields of "religion, politics, entertainment, and business"; it remains pending. See U.S. Trademark Application Serial No. 87/955,215 (filed June 8, 2018).

76. U.S. Trademark Application Serial No. 85/526,099 (filed January 26, 2012). The application was abandoned for failure to show commercial use, and the applicants filed another intent-to-use application. U.S. Trademark Application Serial No. 86/883,293 (filed January 22, 2016).

77. See *Blue Ivy v. BGK Trademark Holdings, LLC*, Opposition No. 91234467 (TTAB), Notice of Opposition (May 10, 2017) (citing and quoting Lisa Robinson, *Jay Z Has the Room*, VANITY FAIR (Nov. 2003), <https://www.vanityfair.com/hollywood/2013/11/jay-z-beyonce-blue-ivy-cover-story> [<http://perma.cc/PXM3-YPZR>]). At this writing the opposition proceeding remains pending. The opposition filing is available at <http://www.ipwatchdog.com/wp-content/uploads/2017/06/2017.05.10-Blue-Ivy-Opposition-to-BLUE-IVY-CARTER-mark.pdf> [<http://perma.cc/6X4F-3NR4>] (last visited Nov. 2, 2018).

78. See, e.g., DAVID KING KELLER, *THE ASSOCIATE AS RAINMAKER: BUILDING YOUR BUSINESS BRAIN* 102 (2011) ("You [the attorney] are a brand. You have to manage your brand name just as any Fortune 500 corporation manages its brand name."); Katy Goshtasbi, *Making it Rain: Practical Tips from Those Who Do*, ABA L. PRAC. TODAY (June 15, 2015), <http://www.lawpracticetoday.org/article/women-rainmakers> [<http://perma.cc/CW62-YNW2>] ("Branding is a way to differentiate yourself in a crowded market.").

fulfilling the use requirement for her selfmark? We are less accustomed to thinking of the selfmark here as a trademark, but if we are to be consistent, the use requirement would seem to be satisfied by the promotion of services that are already available to potential purchasers.

The difficulties multiply in the Endorsement Scenario when the service being identified by a selfmark is not as distinct a product or service as handmade jewelry, carpentry, or even legal representation. At what point did Kim Kardashian West's lucrative endorsement services, for which she holds a registered trademark, come into commercial use? If a niche blogger has established a noncommercial identity and endorses products within that market segment, is that a protectable selfmark as well?

Perhaps trademark law should only protect the symbol of a mark when it is first connected to goods or services *other than* endorsement or promotion. Only then would trademark law give the markholder exclusive control over cross-branding uses, like L.L. BEAN cars or YANKEES caps. For those who establish their pre-existing reputations in traditional commercial pursuits, this may not be a difficult bar to clear. Musicians who perform live and sell merchandise often provide the type of commercial services (concerts) and goods (t-shirts and posters) that trademark law expects. But social media stars and podcasters' initial uses of their selfmarks may not satisfy the conventional requirements of commerciality, even if they become quite well known. If endorsement services like Kardashian West's can themselves be covered by a trademark, why predicate the status of that mark on the existence of other goods or services?

Or, perhaps the use requirement is a reason to rely on a narrower theory of harm in endorsement cases. A number of scholars have suggested keeping the focus of persona rights anchored in concepts of privacy and autonomy rather than in consumer perception or information.⁷⁹ At least in the Endorsement Scenario, it seems, the tail may be wagging the dog. That is, courts analogize personal identity to a trademark, as one court in a famous case assumed the singer Tom Waits held a trademark in his "raspy, gravelly singing voice."⁸⁰ But the *reason* for protecting a selfmark in his singing voice in that case had almost no relationship to the

79. See, e.g., ROTHMAN, *supra* note 15, at 181–85; Edward J. Bloustein, *Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser*, 39 N.Y.U. L. REV. 962, 982–83, 997–1000 (1964); Mark P. McKenna, *The Right of Publicity and Autonomous Self-Definition*, 67 U. PITT. L. REV. 225, 251–52, 268 n.189 (2005).

80. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1097 (9th Cir. 1992); see also *ETW Corp. v. Jireh Publ'g., Inc.*, 332 F.3d 915, 925–26 (6th Cir. 2003); *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000).

commercialized use through which that selfmark would have first become a valid trademark.⁸¹ Indeed, Waits never endorses products.⁸² The harm in the case was to Waits' personal dignity and autonomy, not the consumer confusion rationale supposedly anchoring a trademark claim. Maybe that awkward fit is telling us something.

B. *Distinctiveness*

"Distinctiveness" is a term of art in trademark law to describe a fundamental requirement for protection: that an asserted mark is "used by a substantial number of people as a symbol to identify and distinguish one source" of goods or services.⁸³ Under the canonical "*Abercrombie* spectrum," some marks are considered presumptively distinctive; for example, wordmarks that are invented terms like XEROX (fanciful) or terms that lack any direct connection to the underlying product, such as APPLE for computers (arbitrary).⁸⁴

Trademark law categorically withholds this presumption of inherent distinctiveness from a range of purported marks, including colors and product configurations.⁸⁵ These features may be understood by consumers as serving other purposes besides source identification, such as ornamentation or a description of the product's attributes. Instead of relying upon a presumption in these situations, trademark law places the burden on the trademark claimant to demonstrate that a symbol has "acquired distinctiveness," also called "secondary meaning."⁸⁶ This is an empirical factual question, in principle based on actual consumer understanding.

Traditional doctrine imposes the same burden on those seeking to protect selfmarks in personal names (either first or last) to

81. *Landham*, 227 F.3d at 623.

82. *Waits*, 978 F.2d at 1097 ("Tom Waits does not, however, do commercials. He has maintained this policy consistently during the past ten years, rejecting numerous lucrative offers to endorse major products.").

83. 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 4:13 (5th ed. 2018).

84. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976); Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2127–34 (2004) (explaining presumption of secondary meaning as a way to reduce enforcement costs).

85. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 174 (1995) (withholding the presumption of inherent distinctiveness from the color green); *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 215 (2000) (withholding the presumption of inherent distinctiveness from product configuration).

86. *Wal-Mart*, 529 U.S. at 211.

show secondary meaning.⁸⁷ The Lanham Act further requires a showing of secondary meaning before registering any mark that is “primarily merely a surname.”⁸⁸ Extremely famous celebrities such as Kim Kardashian West should be able to show secondary meaning and protect selfmarks in their names. Less ubiquitous personalities may have more difficulty. Thus, a South Florida sinus doctor named Paul Tartell could not proceed under Section 43(a) against a former partner’s allegedly infringing use of his name, because a court considered his evidence of secondary meaning inadequate.⁸⁹ Among the factors the court considered, it faulted Dr. Tartell for failing to show that his use of his name went beyond the way doctors typically use their name in their professional activities.⁹⁰ In other words, not only is the selfmark denied access to a presumption of distinctiveness that many other marks enjoy, but a claimant may need to show *unusual* use of the selfmark to make that showing. Our rainmaking lawyer or crafty Etsy seller might encounter a similar obstacle to selfmark protection.

In a well-known opinion, Judge Posner identified three overlapping rationales for this presumption against distinctiveness of names: (1) “a reluctance to forbid a person to use his own name in his own business” if someone else already has trademark rights in that name; (2) a belief that consumers will not assume that two different products bearing the same common name come from the same source; and (3) a concern that consumers may lose valuable information if names are monopolized.⁹¹ He then argued that the “rule” requiring proof of secondary meaning should only apply if

87. See *Scott Paper Co. v. Scott’s Liquid Gold, Inc.*, 589 F.2d 1225, 1258 (3d Cir. 1978) (“[A] non-distinctive trademark, such as a common-name mark, only achieves protection if the mark is shown to have secondary meaning.”); Quentin R. Wittrock, *Use of Personal Names in Noncompeting Businesses—Doctrines of Unfair Competition, Trademark Infringement, and Dilution*, 70 IOWA L. REV. 995, 1006–07 (1985) (summarizing cases as considering personal names relatively “weak” trademarks, likely to lack distinctiveness and require proof of secondary meaning).

88. 15 U.S.C. § 1052(e) (2012); see U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1211 (Oct. 2018) [Hereinafter TMEP] (explicating at length the rules for assessing whether a proposed mark qualifies as a surname and what evidence of secondary meaning can overcome the presumption against registering such a mark).

89. See *Tartell v. S. Fla. Sinus & Allergy Ctr., Inc.*, 790 F.3d 1253, 1255–58 (11th Cir. 2015). The analysis in this particular case may have been influenced by the relatively trivial harm caused by the alleged infringement there, see *id.* at 1257, but its rule of law concerning secondary meaning for selfmarks applies more generally.

90. *Id.* at 1259 (holding that “in ‘professions where the use of personal names as identifiers is traditional,’ such as the medical profession, it is more difficult to establish secondary meaning” (quoting J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 13.2 (4th ed. 2009))).

91. See *Peaceable Planet, Inc. v. Ty, Inc.*, 362 F.3d 986, 989 (7th Cir. 2004).

one of these three rationales is implicated.⁹²

Unpacking each of these justifications reveals complexity. Older cases viewed the first concern, a right to use one's own name in business, as nearly sacrosanct.⁹³ But modern courts have limited it considerably and are now more concerned with preventing consumer confusion that may arise if a newcomer began infringing on a name selfmark that had acquired distinctiveness.⁹⁴ This regard for consumer understanding also addresses Judge Posner's third concern. A junior user is often accommodated in the use of a personal name through a defense such as descriptive fair use⁹⁵ or the careful shaping of an equitable remedy.⁹⁶

The second of Judge Posner's three justifications relies on the assumption that a selfmark of a common name does not tell consumers the *particular* source that provides the goods. As Professor McCarthy explains it:

Seeing a sign announcing "AL'S Cafe," the buyer knows only that someone named Al, out of all the Als in the world, is in business. If someone says "Let's go to Al's," the reaction may be "Who is Al? What's at Al's?"⁹⁷

I have never understood this argument. It is in tension with the anonymous source doctrine, under which trademark law declares itself agnostic about whether consumers understand the ac-

92. See *id.* at 990. Judge Posner's approach create a presumption of the availability of another presumption.

93. See *Brown Chem. Co. v. Meyer*, 139 U.S. 540, 544 (1891) ("A man's name is his own property, and he has the same right to its use and enjoyment as he has to any other species of property.").

94. See *Basile, S.p.A. v. Basile*, 899 F.2d 35, 39 (D.C. Cir. 1990).

95. See 15 U.S.C. § 1115(b)(4) (2012) (allowing a junior user to employ a trademark descriptively to her own goods or services).

96. See *LFP IP, LLC v. Hustler Cincinnati, Inc.*, 810 F.3d 424, 427 (6th Cir. 2016) (affirming injunction against infringer of last-name selfmark that required he also use his distinguishing first name and other disclaimers); *L.E. Waterman Co. v. Modern Pen Co.*, 235 U.S. 88 (1914) (an early Supreme Court case affirming an equitable remedy). As summarized by the *LFP* court:

The case law in this area . . . reflects two imperatives: (1) that the court finds that the traditional requirements for unfair competition through the use of another's trademark have been established (typically including the requirement that the name acquired a "secondary meaning" as a result of its association with the relevant products), and (2) that the scope of the injunction accounts for the reality that the mark relates to the offending party's own last name.

LFP IP, LLC, 810 F.3d at 427 (citations omitted).

97. MCCARTHY, *supra* note 68, at § 13:4. He makes the same point about last names: "The name SMITH will merely describe to the public that someone named SMITH has something to do with the product. Which Smith, the public does not know. There is a potential of many 'Smiths' selling related goods or services." *Id.*

tual corporate identity that stands behind any particular trademark.⁹⁸ You need not know who Al is, or who Procter & Gamble is, to understand that such a clear branding label, including a selfmark, functions as a source designation. And in the Licensor or Endorser Scenarios, the consumer already knows precisely who the selfmark indicates, yet the presumption against secondary meaning remains in effect.

Similarly, when considering distinctiveness in connection with registration, trademark examiners assume a neat separability of the naming function from the source-identifying function. They are instructed that a selfmark may be registered as a service mark only “if the record shows that it is used in a manner that would be perceived by purchasers as identifying the services in addition to the character or person.”

In accordance with these rules, the Trademark Trial and Appeal Board (TTAB) has required that specimens submitted with registration applications for selfmarks refer explicitly to the services performed by an individual. When the legendary late-night television host Johnny Carson sought to register his first and last name as a mark, the examiner rejected the application for failure to function.⁹⁹ The TTAB reversed, but only because the submitted specimens happened to include advertisements for live performances labeled “Johnny Carson in Concert.”¹⁰⁰ The Board concluded that “we believe that these specimens are sufficient to establish that the designation ‘JOHNNY CARSON’ is used by applicant not only as a name to identify himself but also as a service mark to identify services rendered by him in commerce.”¹⁰¹ Presumably, the outcome might have differed if the ads simply promoted “Johnny Carson,” based on the (quite reasonable) assumption that all Americans in 1977 knew who Johnny Carson was and what he did. And indeed, in a later case, the TTAB upheld the examiner’s rejection of professional boxer Ray “Boom Boom” Mancini’s application to register BOOM BOOM as a service mark for providing “entertainment services, namely, conducting boxing exhibitions and matches.”¹⁰² The Board concluded “those who

98. *Id.* § 15:8 (“The buyer who associates a designation with a single source need not know the corporate or personal name of that source. When the buyer sees any related product with that mark, she is entitled to assume that it comes from the same anonymous source as every other related product so marked.”).

99. *See In re Carson*, 197 U.S.P.Q. (BNA) 554, 554 (T.T.A.B. Nov. 29, 1977).

100. *Id.*

101. *Id.* at 555 (“To hold otherwise would be to discriminate against applicant simply because he is an individual.”).

102. *See In re Mancino*, 219 U.S.P.Q. (BNA) 1047, 1047 (T.T.A.B. July 27, 1983) (citation omitted).

would encounter the words ‘BOOM BOOM’ in connection with applicant would view those words solely as applicant’s professional boxing nickname. There has been, in short, a failure of proof that “BOOM BOOM” functions as a service mark.”¹⁰³

The conflicting outcomes here may be attributable in part to the particular specimens each applicant submitted. But they also result from hair-splitting about the relationship between names and either people or goods. Some commentators suggest that it is easier to separate names from products than from persons, but this seems to be a call back to the old notion of marks being “affixed” to goods.¹⁰⁴ Taking the Carson and Mancini cases seriously would require us to differentiate the person telling jokes or hitting his opponent from his service of entertaining the audience with comedy or boxing. The TTAB somehow concluded that consumers saw a “boxing nickname” but did not think of it as referring to a boxer, whose service was boxing.¹⁰⁵

Heightened skepticism that selfmarks distinguish source may underestimate the ability of identifiers to carry multiple meanings. The FORD trademark for automobiles is a brand for cars, but also the name of the company that produces them and of its famous founder. All three of these operate as identifiers because each denotes its subject.¹⁰⁶ In fact, the real-world inseparability of the name from its subject is the basic rationale for allowing nominative use, precisely because “it is often virtually impossible to refer to a particular product for purposes of comparison, criticism, point of reference or any other such purpose without using the mark.”¹⁰⁷ That doctrine is equally applicable whether the name belongs to a person (like PRINCESS DIANA), a group of people (like THE BEACH BOYS), or a corporate brand (like LEXUS).¹⁰⁸ In all

103. *Id.* at 1047. The TTAB also perceived a distinction between “the identified services of conducting boxing exhibitions and matches” and “participating as a fighter in such matches.” *Id.* at 1048.

104. *See* Kwall, *supra* note 11, at 45 n.258 (“Trademarks differ from publicity rights in that a trademark is affixed to goods that are physically separate from the trademark and therefore identify the source of something other than the trademark itself. In contrast, a celebrity’s image is attached to the individual in a way that is not capable of physical separation.”).

105. *In re Mancino*, 219 U.S.P.Q. at 1048.

106. *See* Heymann, *supra* note 9, at 437–38.

107. *New Kids on the Block v. News Am. Publ’g., Inc.*, 971 F.2d 302, 306 (9th Cir. 1992).

108. The cases concerning these selfmarks are, respectively, *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1144 (9th Cir. 2002) (concerning a selfmark for the “use of the name and likeness of the late Princess Diana on commercially sold jewelry, plates, and dolls”); *Bro. Records, Inc. v. Jardine*, 318 F.3d 900, 902 (9th Cir. 2003) (concerning a selfmark for the use of a musical group’s trademark by one of its former members); *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1175 (9th Cir. 2010) (concerning a selfmark for the

three cases, the name is attached to its referent.¹⁰⁹ Yet the law of trademark distinctiveness isn't so sure, and the results can be odd. If tomorrow I start selling an energy drink called BOOM BOOM without any reference to the boxer, I will almost certainly have an easier time getting trademark rights in the name than Mr. Mancini did—and it's *his* name.

Traditional trademark doctrine does not have as many specialized distinctiveness rules for other types of selfmarks besides names. That is so even though these other identifiers may be less likely to identify the particular individual in the consumer's mind compared to the person's actual name. Johnny Carson's name confronts special obstacles to trademark protection, but not the "Here's Johnny" with which he was introduced on his show.¹¹⁰ The same is true of Hilton and "That's Hot."¹¹¹

In the apparent simplicity of the *Abercrombie* spectrum of distinctiveness,¹¹² trademark law embraces the notion that personal identifiers are mere descriptors of the person and unlikely to signify source to consumers. But it turns out consumers do not really understand distinctiveness in the stylized and regimented way the *Abercrombie* spectrum assumes.¹¹³ Besides, the target audience for product endorsement by KIM KARDASHIAN WEST cannot even comprehend it without understanding both the specific unique individual to whom the selfmark refers and the recommendation service she is providing. And while consumers who hear of DR. TARTELL presumably understand the name to be identifying a person, they also understand the selfmark to identify a provider of medical services and therefore the source of those services.

C. *Special Bars to Protection*

The third (and somewhat circular) requirement for trademark validity is that there isn't a rule invalidating the mark. Here we find a grab bag of policy-driven caveats to trademark protection such as functionality, misdescriptiveness, and geographic marks. Some of these are just different ways to frame distinctiveness inquiries, including the rule discussed above concerning marks that

use of an automobile trademark by auto broker).

109. See Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 657–59 (2004); Heymann, *supra* note 9, at 444.

110. Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 835 (6th Cir. 1983).

111. See Hilton v. Hallmark Cards, 599 F.3d 894, 899 (9th Cir. 2010); THAT'S HOT, Registration No. 3,209,488.

112. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 13–14 (2d Cir. 1976).

113. See Thomas R. Lee et al., *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033, 1105–06 (2009).

are “primarily merely a surname.”¹¹⁴

I will just mention two other provisions that apply to trademark registration of selfmarks. Rather than constraining individuals’ ability to protect their selfmarks, however, these rules assist them. Both are absolute bars to registration, irrespective of whether secondary meaning has been shown. Under the traditional view, disqualification from registration does not foreclose potential common law trademark rights.¹¹⁵

Under Section 2(c) of the Lanham Act, a trademark that “[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual” is ineligible for federal registration unless that individual provides written consent to the registration.¹¹⁶ The provision includes nicknames, stage names, titles, and the like if they are shown to identify a particular living person who is connected to the business area in which the mark operates or so well known by the general public “that such a connection would be assumed.”¹¹⁷ Using this provision, individuals can oppose registration by someone else of a trademark that conflicts with their selfmark in their own name.

Another provision, Section 2(a), prohibits registration of any mark—not just a name—if it would “falsely suggest a connection with persons, living or dead.”¹¹⁸ The Federal Circuit has concluded that the drafters of the Lanham Act intended with this section for the trademark registration process to mirror still nascent privacy rights against appropriation.¹¹⁹ Examiners rely on a four-part test to determine whether this provision applies.¹²⁰ (This section of the

114. See *supra* note 88 and accompanying text.

115. See, MCCARTHY *supra* note 68, at § 13:37.

116. 15 U.S.C. § 1052(c) (2012).

117. TMEP, *supra* note 88, at § 1206.01; see *In re Krause*, 76 U.S.P.Q. (BNA) 2d 1904, 1906, 1914 (T.T.A.B. Nov. 18, 2005) (noting opposition by person who was prominent in coin collecting and antique auto collecting prevails against use of his name for a collector’s magazine); *In re Sauer*, 27 U.S.P.Q.2d (BNA) 1073, 1073–75 (T.T.A.B. Apr. 23, 1993), *aff’d*, 26 F.3d 140 (Fed. Cir. 1993) (finding the proposed registration BO BALL for a combination football and baseball identified Bo Jackson, an athlete well known for playing both those sports professionally).

118. 15 U.S.C. § 1052(a) (2012).

119. See *Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1376 (Fed. Cir. 1983).

120. TMEP, *supra* note 88, at § 1203.03(c)(i). The four-part test requires that:

- 1 the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution;
- 2 the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;
- 3 the person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and
- 4 the fame or reputation of the person or institution is such that, when the

statute also covers disparagement of individuals, but its continued authority is in doubt after the Supreme Court's decision in *Matal v. Tam*.¹²¹) This would be a way for Blue Ivy Carter's parents to prevent unscrupulous uses of the baby's selfmark if they were intended to deceive consumers about a relationship to her.

IV. SOME IMPLICATIONS OF SELFMARKS

A. *Endorsement Confusion*

In an important article 15 years ago, Stacey Dogan reviewed publicity rights cases and concluded that “the courts appeared to be converging on a simple rule: if a commercial actor ran an advertisement that obtained value by referencing a celebrity, that commercial actor should pay.”¹²² Trademark law does not adopt such a sweeping view of the scope of rights related to individual identity captured by selfmarks. Trademark liability at least requires that consumers be confused about something—even though the nature of that “something” has become less clear over time.

The problem is, trademark and unfair competition law do not clearly explain how to determine when the use of a selfmark creates confusion about “affiliation, connection, . . . association . . . ,” “sponsorship,” or “approval” of a product or service.¹²³ These prohibitions in Section 43(a) of the Lanham Act protect both registered and unregistered marks from such confusion.¹²⁴

As Jim Gibson has documented, overreliance on consumer understanding as the basis for the legal determination leads to a cyclical increase in markholder rights: as consumers perceive broader legal rights, the law then absorbs their assumptions. Thus, the public's belief that individuals need to approve the use of their selfmarks in a wide variety of contexts where it is not required can gradually become the law.¹²⁵ Attorneys for golfer Tiger

mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

Id.; see also *In re Peter S. Herrick, P.A.*, 91 U.S.P.Q.2d (BNA) 1505, 1507 (T.T.A.B. June 10, 2009); *Buffett v. Chi-Chi's, Inc.*, 226 U.S.P.Q. (BNA) 428, 429 (T.T.A.B. June 13, 1985).

121. 137 S. Ct. 1744 (2017); see *In re Brunetti*, 877 F.3d 1330, 1335–36 (Fed. Cir. 2017) (interpreting *Tam* to require striking down the § 2(a) bar against registering “immoral or scandalous marks” on free speech grounds).

122. Stacey L. Dogan, *An Exclusive Right to Evoke*, 44 B.C. L. REV. 291, 305 (2003); see also Dogan & Lemley, *supra* note 13, at 1178–80 (echoing this argument).

123. 15 U.S.C. § 1125(a)(1)(A) (2012).

124. See *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 146 (2d Cir. 2003).

125. James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 YALE L.J. 882, 911–12 (2007); see Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 414 (2010); McGeveran & McKenna, *supra* note 21, at 267–69.

Woods and football player Jim Brown both introduced surveys in selfmark-related litigation documenting this misunderstanding by consumers.¹²⁶ A consumer-defined scope of endorsement might sweep very broadly.

Certainly, there is a spectrum of potential confusion. On one end are direct personal testimonials about a product, where the selfmark conveys endorsement explicitly. The Kardashians' social media posts work this way. In an older medium, so do many radio ads featuring deejays or local baseball players ("C'mon down to Joe's Tavern after the game, it's my favorite local watering hole!"). If such a testimonial were fabricated it would almost surely mislead consumers, harming both audience and alleged endorser.¹²⁷ It would also intrude on the personal interests of the person whose identity was misused.¹²⁸ But the underlying implication that the selfmark is being used to express an individual's endorsement of the product is unmistakable.

Consumers have also been habituated to understand the full-page ads for Aveeno featuring Jennifer Aniston or the television spots for Capital One featuring Alec Baldwin and Jennifer Garner to convey endorsement. But at what point on this spectrum might more allusive or evocative uses of selfmarks fall outside the boundaries of trademark protection?

The law does not really provide a yardstick, or even clarity, about the rationale with which to develop such a measure. Scholars doubt that many uses of trademarks on others' products and services cause meaningful consumer confusion.¹²⁹ A recent empirical study suggests many consumers assume markholders are involved with any sponsored goods bearing their trademarks.¹³⁰ How do consumers understand those relationships between selfmarks and the products where they are used?

The famous case of the Vanna White robot serves as an example. In the case, Samsung ran humorous magazine advertisements touting the durability of its products. The idea was that, even though everything else will have changed in the then-far-distant future of 2012, you would still be using your Samsung products.

126. See *Brown v. Elec. Arts*, 724 F.3d 1235, 1245–46 (9th Cir. 2013); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 937 (6th Cir. 2003). In those cases, the courts rejected the surveys, but primarily because they were applying the *Rogers v. Grimaldi* test for expressive works. See *infra* Part IV.B. Had the cases involved purely commercial uses, it is not clear whether the surveys might have been probative.

127. See McGeveran, *supra* note 57, at 1127–30.

128. See *Pavesich v. New Eng. Life Ins.*, 50 S.E. 68, 69, 79 (Ga. 1905).

129. See sources cited *supra* note 23.

130. See Matthew B. Kugler, *The Materiality of Sponsorship Confusion*, 50 U.C. DAVIS L. REV. 1911, 1943 (2017).

One of the ads featured a blond-wigged humanoid robot turning letters on a television program that looked just like *Wheel of Fortune*—because famed *Wheel* hostess Vanna White would be replaced by a robot¹³¹ but the same Samsung VCR would still tape the show. White did not find it funny and sued under a publicity rights theory.¹³²

Dogan and Lemley wrote that it was “inconceivable” that consumers actually could be confused about the association of Vanna White with the Samsung advertisement.¹³³ But why should that necessarily be so? Surely an equally prominent photo of Vanna White turning letters might cause consumers to understand the ad as touting her endorsement of Samsung, just as a photo of Jennifer Aniston might in an Aveeno ad. Why, then, would we be certain that consumers would not see a cartoon or other representation of White that way? Even a robot-based caricature? At a minimum, it is not “inconceivable.”¹³⁴ I do not say this to argue that the court was correct to rule for White, only to suggest that the lack of any meaningful guidepost about the nature or amount of confusion as to endorsement makes the determination a crapshoot.

Similarly, Dogan and Lemley express astonishment at theories of persona rights tied to the use of a name or likeness in commercial merchandise, critically citing cases involving Arnold Schwarzenegger bobblehead dolls and the Three Stooges t-shirt.¹³⁵ This merchandizing right certainly exists in trademark law, although these scholars are well known critics of it.¹³⁶ But there may be a greater independent basis for protecting this right for individuals than for corporate-controlled brands. They are humans who have feelings and personal interests.¹³⁷ Appropriation is one of the oldest forms of privacy tort and it is not predicated on either the

131. In fact, White just renewed her contract to host the show through 2022. See Paige Albinak, *Pat Sajak, Vanna White, Alex Trebek Renew Contracts Through 2022*, BROAD. & CABLE (Oct. 31, 2018), <https://www.broadcastingcable.com/news/pat-sajak-vanna-white-alek-trebek-renew-contracts-through-2022> [<http://perma.cc/CR49-N2EZ>].

132. See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1396–97 (9th Cir. 1992).

133. Dogan & Lemley, *supra* note 13, at 1195, 1196 n.158.

134. As Inigo Montoya warns Vizzini in *The Princess Bride*, “You keep using that word. I do not think it means what you think it means.” *THE PRINCESS BRIDE* (Act III Communications 1987).

135. Dogan & Lemley, *supra* note 13, at 1205–06.

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

137. See, e.g., ROTHMAN, *supra* note 15, at 181–85; Bloustein, *supra* note 79, at 967; McKenna, *supra* note 79, at 227–28.

fame of a celebrity or the commercial nature of the allegedly tortious “use or benefit.”¹³⁸ Indeed, the Ohio law that Dogan and Lemley identify as an outlier is in fact a word-for-word repetition of the Restatement tort for appropriation.¹³⁹

None of these represents any inherent problem with self-marks. Rather, they are examples of a broader deficiency in trademark doctrine, which relies so heavily on consumer perception about ill-defined relationships to set the boundaries of infringement. It is in many ways the same concern many have about merchandising rights writ large. And the problem is not going away.

B. *Speech Concerns*

Much of the concern about trademark-like protection for personal identity flows from its potentially significant restriction on speech. As Eugene Volokh has said, “Real people, dead or alive, are important subjects of discussion, in fiction as well as in news reporting.”¹⁴⁰ Many of the well-known cases involving false endorsement or publicity concern artistic works that could be distorted by an assertion of monopolistic rights in personal identifiers. These cases include unauthorized portraits of famous people,¹⁴¹ allusions to real persons in the titles of artistic works,¹⁴² inclusion of real people in video games,¹⁴³ and biographical portrayals whether historical or somewhat fictionalized.¹⁴⁴ Those same free speech concerns could arise in disputes about selfmarks under trademark law.

138. RESTATEMENT (SECOND) OF TORTS § 652C (AM. LAW INST. 1977); see ROTHMAN, *supra* note 15, at 11–29 (tracing history).

139. Dogan & Lemley, *supra* note 13, at 1206 n.211; RESTATEMENT (SECOND) OF TORTS, *supra* note 138, § 652C.

140. Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 903, 908 (2003); see also Rebecca Tushnet, *A Mask That Eats into the Face: Images and the Right of Publicity*, 38 COLUM. J.L. & ARTS 157, 205 (2015); Tyler T. Ochoa, *The Schwarzenegger Bobblehead Case*, 45 SANTA CLARA L. REV. 547, 554 (2005).

141. See *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 918–19 (6th Cir. 2003); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 800–01 (Cal. 2001); cf. *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1269 (11th Cir. 2012) (paintings of football players that included “realistic portrayals of the University’s uniforms, including helmets, jerseys, and crimson and white colors”).

142. See *Parks v. LaFace Records*, 329 F.3d 437, 441 (6th Cir. 2003); *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. 1989).

143. See *Brown v. Elec. Arts*, 724 F.3d 1235, 1238–39 (9th Cir. 2013); *NCAA Student-Athlete Name & Likeness Licensing Litig. v. Elec. Arts Inc.*, 724 F.3d 1268, 1271–72 (9th Cir. 2013); *Romantics v. Activision Publ'g, Inc.*, 574 F. Supp. 2d 758, 762 (E.D. Mich. 2008); *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 402 (Cal. Ct. App. 2011).

144. See *Sarver v. Chartier*, 813 F.3d 891, 896 (9th Cir. 2016); *De Havilland v. FX Networks, LLC*, 230 Cal. Rptr. 3d 625, 630 (Cal. Ct. App. 2018), *appeal denied* (July 11, 2018).

Trademark doctrine also has stronger defensive doctrines for speech than are found in most publicity rights statutes. I have strongly criticized free speech protections in trademark law as chaotic, unpredictable, and overly fact-intensive.¹⁴⁵ But everything is relative. Speech-protective defensive doctrines in publicity rights law are even worse. In her superb new book examining the right of publicity, Jennifer Rothman identified five different balancing tests courts deploy to sort out free speech claims in publicity rights cases.¹⁴⁶ These tests have long been a dumpster fire.¹⁴⁷ And, as in trademark law, even when complex doctrine reaches the correct result, the mere prospect of costly litigation muzzles speech all by itself.¹⁴⁸

In recent years, trademark doctrine has greatly improved its approach to speech protective reasoning.¹⁴⁹ One of the mainstays of this better protection is the doctrine for the use of trademarks within expressive works, derived from a proto-selfmark case, *Rogers v. Grimaldi*.¹⁵⁰ The original Second Circuit case involved a Federico Fellini film that told a fictional story about a reunion performance of a pair of once-famous Italian dancers. Fellini titled the film *Ginger and Fred*, evoking the legendary dancing duo of Rogers and Astaire, and Rogers sued.

Many courts have now adopted the *Rogers* approach, and it has been distilled to a simple test.¹⁵¹ First, the *Rogers* approach applies to uses in the title or, usually, the body of an expressive work, a category that has been found to include visual art¹⁵² and

145. See William McGeeveran, *The Trademark Fair Use Reform Act*, 90 B.U. L. REV. 2267, 2272–79 (2010) [hereinafter McGeeveran, *The Trademark Fair Use Reform Act*]; William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 51–52 (2008).

146. See ROTHMAN, *supra* note 15, at 145–48.

147. See Rochelle Cooper Dreyfuss, *We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity*, 20 COLUM.-VLA J.L. & ARTS 123, 146–48, 151–53, 156 (1996); Volokh, *supra* note 140, at 904–05, 926; see generally Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 130, 132–34, 178–79 (1993).

148. See McGeeveran, *The Trademark Fair Use Reform Act*, *supra* note 145, at 2275–76.

149. See William McGeeveran, *The Imaginary Trademark Parody Crisis (and the Real One)*, 90 WASH. L. REV. 713, 728–38 (2015) (tracing the significant improvement over time of trademark doctrine’s protection of parody).

150. 875 F.2d 994, 998–1001 (2d Cir. 1989).

151. See, e.g., *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1277–78 (11th Cir. 2012); *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008); *Parks v. LaFace Records*, 329 F.3d 437, 447–48 (6th Cir. 2003); see also *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 329 (4th Cir. 2015) (“[U]se of a mark in a title will generally not result in the type of consumer confusion necessary to support infringement claims.” (citing *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989))).

152. *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 956 (6th Cir. 2003).

video games,¹⁵³ among other forms. Then, the court only needs to find that the use of the selfmark has “artistic relevance to the underlying work and that it does not explicitly mislead as to the source of the work.”¹⁵⁴ The first prong recently has been interpreted by multiple courts as being satisfied as long as there is *any* artistic relevance of the selfmark to the expressive work—that is, anything “above zero.”¹⁵⁵ The second prong is also stacked in favor of speech; it requires that an expressive work include “an ‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement’” that misleads consumers about the connection between the expressive work and the selfmark.¹⁵⁶ Good-faith uses of a selfmark in an expressive work are exceedingly unlikely to fail the *Rogers* test.

Illustrating how much difference the *Rogers* test can make, the same panel of the Ninth Circuit recently reached opposite decisions on two factually similar cases involving the use of athletes’ selfmarks in football video games. One case was evaluated as a trademark claim under *Rogers* and the plaintiff lost, while the other was considered under California’s publicity rights statute and the court found *Rogers* inapplicable and ruled for the plaintiffs.¹⁵⁷

Not all relevant situations fall within the scope of *Rogers*, of course. Some speech objections involve commercial promotion, not expressive works, that humorously evoke a famous person,¹⁵⁸ or that refer to facts about them.¹⁵⁹ And some cases involve uses of a selfmark that fall on the line between expressive and nonexpressive uses: an unaltered portrait of a person on a t-shirt, or a depiction on a greeting card, for example.¹⁶⁰

All that being said, there isn’t really any indication that trademark coverage of selfmarks is worse for speech than publicity and

153. See *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241 (9th Cir. 2013) (“[T]he Supreme Court has answered with an emphatic ‘yes’ when faced with the question of whether video games deserve the same protection as more traditional forms of expression.”); *E.S.S. Entm’t*, 547 F.3d at 1099–1100 (accepting plaintiff’s concession that the video game was artistic so that *Rogers* applied).

154. *ETW Corp.*, 332 F.3d at 937; see also *Brown*, 724 F.3d at 1242.

155. See, e.g., *E.S.S. Entm’t*, 547 F.3d at 1100; see also *Brown*, 724 F.3d at 1242–43.

156. *Brown*, 724 F.3d at 1245 (quoting *Rogers*, 875 F.2d at 1001).

157. Compare *Brown*, 724 F.3d at 1238–39 (upholding the dismissal of *Brown*’s Lanham Act claim against a video game maker after applying the *Rogers* test), with *NCAA Student-Athlete Name & Likeness Licensing Litig. v. Elec. Arts Inc.*, 724 F.3d 1268, 1271 (9th Cir. 2013) (upholding a ruling in favor of athletes against the same video game maker after applying a state right-of-publicity test).

158. See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1396 (9th Cir. 1992); *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612, 617–18 (S.D.N.Y. 1985).

159. See *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 511–12 (7th Cir. 2014).

160. See *Hilton v. Hallmark Cards*, 599 F.3d 894, 899 (9th Cir. 2010); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 800–01 (Cal. 2001).

unfair competition approaches. And for most uses in expressive works, it is likely better.

V. CONCLUSION

People have used their names and other personal identifiers in trade since before unfair competition law crystallized in the nineteenth century. But the doctrine that has grown up around trademarks did not always match well with these selfmarks, and the disconnects are more noticeable in our celebrity culture and service economy. Much of the work of protecting the interest of individuals in their selfmarks and consumers in their nonconfusing use has been borne outside formal trademark doctrine, such as through the appropriation tort, publicity rights, and false endorsement theories of unfair competition law.

Particularly when licensors or endorsers bring their preexisting fame into promotional relationships, they may seek to rely increasingly on trademark law as well. This Essay has considered the scenarios in which people might seek trademark protection for their selfmarks, the ways in which trademark validity rules can make that awkward, and the implications for likelihood of confusion and for free speech under trademark doctrine. It has necessarily been preliminary, but one message comes through clearly: the need for continued rigorous analysis of the currently sloppy ways that trademark rules are being grafted onto individuals' persona rights.