

The Trademark Reporter®



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Brands as Speech, Speech as Brands: Mapping the Two-Way Street
Between Trademark Law and Freedom of Expression

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The Trademark Reporter®

BRANDS AS SPEECH, SPEECH AS BRANDS: MAPPING THE TWO-WAY STREET BETWEEN TRADEMARK LAW AND FREEDOM OF EXPRESSION*

*By Alvaro Fernandez-Mora**1*

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ABSTRACT

Trademarks today serve as more than source identifiers and quality signalers. They are important expressive artifacts through which individuals pursue their identity and self-expression. This development has given rise to a greater focus on free speech considerations in trademark law in both the United States and Europe. Yet judicial decisions and academic writings addressing the intersection of trademarks and free speech are numerous and inconsistent, producing confusion and uncertainty.

This article contends that the prevailing approach to the interaction between trademarks and speech is hindered by an incomplete conceptualization of their relationship, for two reasons. First, courts typically treat freedom of expression as a limiting constraint on trademark rights and fail to recognize its dual role in validating and not only limiting them. Acknowledging this duality allows reconceptualizing the interaction between trademarks and freedom of expression as competing forms of speech. Second, the prevailing approach fails to account for the diversity of expressive users of trademarks in the contemporary marketplace, with the result that adjudication tends to consider only one category of expressive users at a time and overlooks other expressive interests deserving of constitutional protection.

To bridge these gaps, this article: (a) proposes a typology of expressive users of trademarks and (b) shows how accounting for this diversity in trademark litigation can produce better balanced, more consistent outcomes. This is a worthwhile endeavor that will result in greater doctrinal clarity and more faithful enforcement of human rights guarantees in trademark disputes.

INTRODUCTION

Trademarks have evolved in recent decades from devices that identify a commercial source into vehicles that convey quality, reputation, and complex meanings that individuals can rely upon for expressive purposes.² The expansion of trademarks' expressive

² Trademarks' ability to perform functions beyond source-signaling has been widely acknowledged by courts and commentators on both sides of the Atlantic. *See*, in the United States: *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. Rev. 960, 977-78 (1993); Jerre B. Swann Sr., David A. Aaker & Matt Reback, *Trademarks and Marketing*, 91 Trademark Rep. 787, 799 (2001); Rochelle Cooper Dreyfuss, *Expressive Generativity: Trademarks as Language In the Pepsi Generation*, 65 Notre Dame L. Rev. 397, 397-98 (1990). In Europe, the recognition that marks can perform additional functions to that of origin is often framed within the broader debate on the "functions theory" as developed by the Court of Justice of the European Union ("CJEU") in, inter alia, Case C-487/07, *L'Oréal SA v. Bellure NV*, ECLI:EU:C:2009:378 (June 18, 2009). *See also*, Annette Kur, *Trade Marks Function, Don't They? CJEU Jurisprudence and Unfair Competition Principles*, 45 Int'l Rev. Intell. Prop. & Competition L. 434 (2014); Lisa P. Ramsey & Jens Schovsbo, *Mechanisms for Limiting Trade Mark Rights to Further Competition and Free Speech*,

capabilities has brought new opportunities and challenges to trademark law, and courts in the United States and Europe have been grappling with how trademarks and freedom of expression should be balanced.³ The resulting body of case law and scholarship, particularly voluminous in the United States, has produced a cacophony of competing voices, approaches, and conceptual frameworks, and a corresponding inconsistency in outcomes that has left the field riddled with uncertainty.⁴ This comes at a time when expressive uses of marks are on the rise.

I suggest that much of this confusion stems from an incomplete conceptualization of the relationship between trademarks and free speech. There are two ways in which our prevailing understanding of this interaction is incomplete.

First, courts hearing *interaction cases* (i.e., cases in which one of the parties invokes freedom of speech either to limit or to validate trademark rights) on both sides of the Atlantic tend to treat such disputes as unidirectional. In so doing, they advance the speech interests of one subset of *expressive users* (i.e., individuals who make use of a trademark to communicate a message beyond, or in addition to, commercial source) at a time, depending on the type of litigation.

44 Int'l Rev. Intell. Prop. & Competition L. 671 (2013); Dev S. Gangjee, *Property in Brands*, in *Property Concepts in Intellectual Property Law* 29 (Helena Howe & Jonathan Griffiths eds., 2013); Tobias Cohen Jehoram, *The Function Theory in European Trade Mark Law and the Holistic Approach of the CJEU*, 102 Trademark Rep. 1243 (2012); Alvaro Fernandez-Mora, *Trade Mark Functions in Business Practice: Mapping the Law Through the Search for Economic Content*, 52 Int'l Rev. Intell. Prop. & Competition L. 1370 (2021).

³ The volume of case law and literature addressing this topic is overwhelming, especially in the United States. Relevant sources will be cited systematically to facilitate the readers' task of locating sources.

⁴ *In Re Tam*, 808 F.3d 1321, 1341-42 (Fed. Cir. 2015); Stacey L. Dogan & Mark A. Lemley, *Parody as Brand*, 105 Trademark Rep. 1177, 1178 (2015); Andreas Rahmatian, *Trade Marks and Human Rights*, in *Intellectual Property & Human Rights*, 352-53 (Paul Torremans ed., 2008); Dima Basma, *Trade Mark Protection Versus Freedom of Expression: Towards an Expressive Use Defence in European Trade Mark Law*, 3 Intell. Prop. Q. 206, 226 (2021); Sabine Jacques, *The EU Trade Mark System's Lost Sense of Humour*, 1 Intell. Prop. Q. 1, 26 (2024); Sonia K. Katyal, *Brands Behaving Badly*, 109 Trademark Rep. 819, 822 (2019); Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 Trademark Rep. 1476, 1515, 1528 (2011) (reprinted with permission from Matthew Bender & Company, Inc., a member of the LexisNexis Group); Jennifer S. Davis & Lukasz Zelechowski, *Bad Faith, Public Policy and Morality: How Open Concepts Shape Trade Mark Protection*, 54 Int'l Rev. Intell. Prop. & Competition L. 859, 881 (2023); Martin Senftleben, *Robustness Check: Evaluating and Strengthening Artistic Use Defences in EU Trademark Law*, 53 Int'l Rev. Intell. Prop. & Competition L. 567, 580 (2022); Alvaro Fernandez-Mora, *Inconsistencies in European Trade Mark Law: The Public Policy and Morality Exclusions*, 4 Intell. Prop. Q. 271 (2020).

U.S. and European case law reflect three recurring forms of interaction:⁵

- i. In *infringement* cases, defendants can invoke free speech to shield their unauthorized use of the plaintiff's *recoded* mark (i.e., a modified version of the mark—by removing, replacing, and/or adding material—to imbue it with new meaning) for expressive purposes.⁶
- ii. In *registration* cases, unsuccessful applicants rely on free speech to challenge refusals. In the United States, this has led to the provisions relating to immoral, disparaging, and scandalous marks being struck down from the Lanham Act, while in the EU signs that are contrary to public policy or morality continue to be refused.⁷
- iii. In *brand restriction* cases, trademark owners invoke free speech to strike down measures that restrict trademark use in relation to goods posing a risk to public health, such as plain packaging rules or mandatory health warnings for tobacco products.⁸

A review of U.S. and European case law reveals that, in infringement litigation, courts have considered solely the expressive interests of defendants when assessing whether unauthorized recoded uses of trademarks are compatible with plaintiffs' exclusive rights. By contrast, in cases where applicants or owners invoke freedom of expression to obtain or maintain trademark rights, the analysis has been limited to their respective expressive interests. The recognition of applicants' or owners' free speech has not permeated to the infringement context, nor are defendants' expressive interests factored into registration or brand restriction cases. In previous work, I relied on this finding to suggest that courts should move away from this unidirectional approach and instead understand the interaction as a two-way street, where speech can simultaneously limit and validate trademark rights.⁹

⁵ Alvaro Fernandez-Mora, *A Counterintuitive Approach to the Interaction Between Trademarks and Freedom of Expression in the US and Europe: A Two-Way Relationship*, 39.2 Berkeley J. Int'l L. 293, 327-344 (2021).

⁶ See case law cited in note 31 *infra*. The term "recoding" as used in intellectual property literature is drawn from the cultural-studies scholarship of Rosemary Coombe, who used it to describe the practices by which individuals and communities appropriate and rework the meanings of commercial signs—including trademarks—to express identities, values and political commitments that diverge from those intended by the rightsholder. Rosemary J. Coombe, *Objects of Property and Subjects to Politics: Intellectual Property Laws and Democratic Dialogue*, 69 Texas L. Rev. 1853 (1991). See also Justin Hughes, "Recoding" Intellectual Property and Overlooked Audience Interests' [1999] 77 Texas L. Rev. 923.

⁷ See case law cited in note 37 *infra*.

⁸ See case law cited in note 41 *infra*.

⁹ Fernandez-Mora, *supra* note 5.

Applying this view, trademark disputes are better reconceptualized as *competing forms of speech*.

Second, courts fail to account for the diversity of expressive users of trademarks in today's marketplace. Decision makers in interaction cases have not simply overlooked the expressive interests of defendants, applicants, and rightsholders, but also those of additional expressive users of trademarks. This is surprising given the widespread recognition that trademarks are routinely used expressively by a wider range of users to communicate who they are and what they stand for.¹⁰

This article bridges that gap by proposing a typology of expressive users of marks comprising five categories: (a) *trademark owners*, who express themselves through use of their marks in relation to goods and services; (b) *consumers of branded goods*, who communicate their values through everyday acts of consumption; (c) *recoders*, who use recoded versions of marks for expressive purposes; (d) *consumers of goods bearing recoded marks*, who, in turn, use those marks to communicate their worldview; and (e) the *public*, who employ marks that have permeated language, art, and culture more broadly in their everyday conversations and creative endeavors.

The article then draws on this typology to explore how recognizing the full range of expressive interests at stake can enrich our analysis of interaction cases. In infringement litigation, the rebalancing draws in the expressive interests of all users implicated in recoding disputes (not merely the defendant's), and from this proposes a theory of (expressive) harm that can assist courts in defining the scope of protection afforded to trademarks with greater precision. In registration and brand restriction cases, the rebalancing exercise requires decision-makers to reckon with the expressive interests of users beyond applicants and rightsholders—including, notably, the reinforced protection owed to political and artistic speech where applicants seek to reclaim offensive signs through registration, or where brand restriction measures erode meanings on which a wide range of individuals rely for self-expression. The payoff is twofold: clearer, more consistent adjudication, and stronger protection of human rights guarantees in trademark disputes.

This article is structured in three parts. Part I examines the expressive function of trademarks and offers an overview of the three forms of interaction between marks and speech, drawing out

¹⁰ This is particularly the case in relation to the categories of expressive users of marks that I term consumers of branded goods and the public in Part II *infra*. Evidence of courts and scholars' engagement with these types of expressive users of marks can be found in, inter alia, notes 25–30 *infra*, as well as in Part III *infra* (upon discussion of the monolithic approach to the concept of the expressive user in existing literature and case law, see notes 72–73 and accompanying text *infra*).

the lessons that may be extracted from this diversity. Part II proposes the typology of expressive users of marks, going beyond those identified to date in the case law and literature. Part III considers how taking account of this diversity can enhance our understanding of interaction cases and support improved adjudication in this area of law. Concluding remarks follow.

PART I. THE INTERACTION BETWEEN TRADEMARKS AND SPEECH

A. Trademarks as Expressive Artifacts

Trademarks are signs. Signs, in turn, convey information and, through their use, enable communication between two or more people. The words that I am typing right now are signs that allow me to communicate with you, the reader. The same is true of trademarks: they convey information and, through their use, enable communication in the marketplace and in society at large.

The fundamental information conveyed by a trademark is, naturally, the commercial origin of goods or services.¹¹ For instance, the LOUIS VUITTON mark denotes a particular commercial origin: Louis Vuitton Malletier S.A. Used in the course of trade, it allows its owner to distinguish its high-end trunks, leather goods, and ready-to-wear clothing from those of its competitors. Yet contemporary trademarks can also convey a wide range of meanings beyond indicating origin, ranging from signals about quality or reputation—what trademark law has long captured under goodwill—to lifestyle preferences or values on which individuals can rely for expressive purposes.¹² The LOUIS VUITTON mark and its iconic interlocking “LV” monogram are rich with these additional meanings: they are associated with heritage, craftsmanship, luxury, and a long tradition of travel and adventure dating back to the founding of the house as a Parisian trunk-maker in 1854.¹³ Over time, the brand has come to symbolize a set of values centered on

¹¹ *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 2 *Wis. L. Rev.* 158, 158-59 (1982); Keith Aoki, *How the World Dreams Itself to Be American: Reflections on the Relationship between the Expanding Scope of Trademark Protection and Free Speech Norms*, 17 *Loy. L.A. Ent. L. Rev.* 523, 531 (1997).

¹² For further exploration of the range of functions performed by trademarks in the contemporary marketplace, see note 2 *supra*.

¹³ An overview of Louis Vuitton’s history can be found on its website, <https://uk.louisvuitton.com/eng-gb/magazine/articles/a-legendary-history> (last visited Apr. 29, 2026). See also, discussing the brand’s strong connection to travel and adventure, Jean-Noël Kapferer & Vincent Bastien, *The Luxury Strategy: Break the Rules of Marketing to Build Luxury Brands* 269 (2d ed. 2012).

exclusivity, refinement, and the signaling of affluence.¹⁴ Because these added meanings provide consumers with a wealth of useful information about the goods to which marks are affixed, they are extremely valuable to rightsholders.¹⁵ Indeed, firms are often willing to devote vast resources to develop and maintain them, typically through costly promotional activities and carefully curated distribution channels.¹⁶

How can signs, including trademarks, develop such complex meanings? The meaning of a sign emerges from social consensus: individuals collectively agree that sign “x” will carry meaning “y.”¹⁷ The word “sea,” for instance, symbolizes the “expanse of salt water that covers most of the earth’s surface and surrounds its land masses” only insofar as English speakers have agreed as much.¹⁸ There is no necessary correlation between the word and that meaning—their relationship is one of social convention, and therefore arbitrary. Because social consensus is not static, the meanings of signs are subject to constant transformation.¹⁹ Until the late nineteenth century, for instance, “queer” functioned solely as an adjective meaning “strange” or “odd.”²⁰ It subsequently acquired an additional, offensive meaning as a noun referring to a gay man. By the late 1980s, however, efforts within the gay community to reclaim the term led to the gradual loss of its negative connotations and an expansion of its meaning to encompass broader notions of sexuality and gender identity beyond cisgender,

¹⁴ The ability of the LOUIS VUITTON marks to convey this diverse range of meanings is explored in further detail in Part II *infra*.

¹⁵ Swann et al. have described in very persuasive terms the diverse ways in which the additional meanings conveyed by contemporary brands serve rightsholders’ interests. In their own words: “For their owners, therefore, strong brands are far more than a simple ‘investment.’ Rather, as a consequence of their bond with consumers, they: (i) allow access to consumers’ minds; (ii) make advertising less expensive or more impactful (or both); (iii) enable a manufacturer to communicate more directly with a consumer, cushioning any vagaries of distribution; (iv) assist in attaining channel power; (v) provide a more efficient and credible means of extending into related goods, and give rise to licensing opportunities; (vi) serve as certificates of ‘authenticity’; (vii) afford resilience; and (viii) constitute an asset-brand equity that is frequently a company’s most valuable single property.” Swann, *supra* note 2, at 807.

¹⁶ Reza Motameni & Manuchehr Shahrokhi, *Brand equity valuation: a global perspective*, 7 J. of Prod. & Brand Mgmt. 275, 275 (1998); Jerre B. Swann, *An Interdisciplinary Approach to Brand Strength*, 96 Trademark Rep. 943, 957, 969 (2006). This has also been acknowledged by the U.S. Supreme Court in *Matal v. Tam*, 582 U.S. 218, 239 (2017).

¹⁷ See, discussing Saussure’s view on the arbitrariness of meaning in symbols, Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 U.C.L.A. L. Rev. 621, 634 (2004) (quoting Ferdinand De Saussure, *Course in General Linguistics*, 74 (Charles Bally & Albert Sechehaye eds., Roy Harris trans. 1990) (1916)).

¹⁸ *Oxford English Dictionary*, www.oxforddictionaries.com (last visited Apr. 9, 2026).

¹⁹ Douglas Raber & John M. Budd, *Information as sign: semiotics and information science*, 59,5 J. of Documentation 507, 512 (2003); Megan Richardson, *Trade Marks and Language*, 26 Syd. L. Rev. 193, 200 (2004).

²⁰ *Oxford English Dictionary*, *supra* note 18.

heterosexual norms.²¹ Today, the meaning conveyed by “queer” shifts depending on context.

The same is true of trademarks. Their meanings may evolve over time depending on how they are used.²² Returning to the previous example, the LOUIS VUITTON mark performs a source-identifying function when it is used to differentiate goods originating from the French house Louis Vuitton Malletier S.A. from those of its Italian competitor Prada S.p.A., marketed under the PRADA mark. Trademarks also perform an advertising function when they are used to “convey[] a particular image to the . . . consumer of the goods or services in question.”²³ For instance, Louis Vuitton may use its “LV” monogram in campaigns shot by leading photographers and featuring high-profile public figures in evocative travel settings, conveying an image of timeless elegance, refinement, and international sophistication.²⁴ And marks perform an expressive function when they are used to express allegiance to a certain idea, value, or lifestyle.²⁵ Thus, the LOUIS VUITTON mark performs an expressive function when consumers who identify with values of luxury, status, and refined taste wear LOUIS VUITTON-branded goods in order to express their adherence to such values—and, in many cases, their membership in a community defined by access to objects whose acquisition is itself a marker of cultural and social capital. The capacity of trademark meaning to evolve is not new. The same social-convention basis that allows marks to acquire

²¹ *Id.*

²² Jason Bosland, *The Culture of Trade Marks: An Alternative Cultural Theory Perspective*, 10 Media & Arts L. Rev. 99, 108 (2005); Deven R. Desai, *From Trademarks to Brands*, 64 Fla. L. Rev. 981, 986, 1041-42; Gangjee, *supra* note 2, at 58.

²³ Datacard Corp. v. Eagle Technologies Ltd., [2011] EWHC 244 Pat [272] (emphasis omitted). At EU level, the CJEU has defined the advertising function of marks as “that of using a mark for advertising purposes designed to inform and persuade consumers.” Case C-129/17, *Mitsubishi Shoji Kaisha Ltd. v. Duma Forklifts NV*, ECLI:EU:C:2018:594, ¶ 37 (July 25, 2018). *See also* Joined Cases C-236/08 to C-238/08, *Google France SARL v. Louis Vuitton Malletier SA*, ECLI:EU:C:2010:159, ¶¶ 91-92 (Mar. 23, 2010). According to Fhima, “contemporary trade marks . . . have a wider range of functions. In particular, their use in advertising allows their owners to build a reputation and image around the mark.” Ilanah Simon Fhima, *Trade Marks and Free Speech*, 44 Int’l Rev. Intell. Prop. & Competition L. 293, 293 (2013).

²⁴ Examples of such campaigns include: Rafael Nadal and Roger Federer’s mountain expedition captured by Anne Leibovitz, <https://uk.louisvuitton.com/eng-gb/stories/core-values-campaign> (last visited Apr. 29, 2026); or the evocative campaign “Towards a Dream,” captured by Viviane Sassen across different countries and landscapes, <https://uk.louisvuitton.com/eng-gb/magazine/articles/towards-a-dream> (last visited Apr. 29, 2026).

²⁵ Michael Spence, *The Mark as Expression/The Mark as Property*, 58 Current Legal Problems 491, 504 (2005) (“[There is] a recognition that a mark is a form of speech. Trade mark owners work hard to ensure that their mark communicates, not only the trade origin of goods, but also a whole range of associated values.”); Marco Ricolfi, *Trademarks and Human Rights*, in *Intellectual Property & Human Rights*, at 470 (Paul Torremans ed., 3d ed. 2015).

expressive associations also underpins genericide, whereby a mark loses its source-identifying capacity through common use and comes to denote the product category itself. Both phenomena reflect the capacity of marks to acquire—and shed—meanings through patterns of social use.

That trademarks can perform an expressive function has been widely acknowledged by courts and commentators.²⁶ Dreyfuss, for example, famously argued as early as 1990 that “ideograms that once functioned solely as signals denoting the source, origin, and quality of goods, have become . . . indicators of the status, preferences, and aspirations of those who use them. Some trademarks have worked their way into the English language; others provide bases for vibrant, evocative metaphors.”²⁷ McGeeveran similarly observes that “[m]any uses of trademarks in today’s culture go far beyond the boundaries of . . . commerc[e] . . . They can involve political expression, artistic works, parodies, or criticism.”²⁸ Richardson has advanced that “[n]ow trade marks do more than ‘sell’ goods and services, let alone distinguish their ‘origin’ . . . Like them or not, trade marks tell stories. Their expressiveness is the basis of commercial activity.”²⁹ In its landmark decision in *Tam*, the United States Supreme Court held that “trademarks often have an expressive content. Companies spend huge amounts to create and publicize trademarks that convey a message. It is true that the necessary brevity of trademarks limits what they can say. But powerful messages can sometimes be conveyed in just a few words. Trademarks are . . . speech.”³⁰

B. Rethinking the Interaction Between Trademarks and Speech: Two Counterintuitive Suggestions

The above examples illustrate just how widespread the consensus is that trademarks can convey expressive meaning. Their expressive capabilities give rise to unprecedented challenges for trademark law, as a growing range of expressive users seek to invoke the protection afforded by the fundamental right to freedom of expression in trademark litigation. As briefly explained in the Introduction, three different scenarios in which trademark rights and speech rights interact can be identified.

²⁶ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (“[T]rademarks [can] transcend their identifying purpose. Some trademarks enter our public discourse and become an integral part of our vocabulary.”); Kozinski, *supra* note 2, at 966; Jacques, *supra* note 4, at 3; Dogan & Lemley, *supra* note 4, at 1196.

²⁷ Dreyfuss, *supra* note 2, at 397 (citations omitted).

²⁸ William McGeeveran, *Four Free Speech Goals for Trademark Law*, 18 Fordham Intell. Prop. Media & Ent. L.J. 1205, 1211 (2008) (citations omitted).

²⁹ Richardson, *supra* note 19, at 196.

³⁰ *Matal v. Tam*, 582 U.S. 218, 239 (2017).

First, in infringement litigation involving the unauthorized use of recoded marks for expressive purposes (typically parody or commentary),³¹ a defendant's appeal to freedom of expression often leads courts to balance the owner's proprietary interests against the defendant's speech interests.³² In such cases, freedom of speech operates as a defense to the exclusive rights granted to trademark owners,³³ shielding many unauthorized expressive uses from

³¹ A comprehensive list of infringement cases would be overwhelmingly long. Relevant examples include, in the United States: *Punchbowl, Inc. v. AJ Press, Inc.*, 90 F.4th 1022 (9th Cir. 2024); *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023); *Ebony Media Operations LLC v. Univision Commc'ns Inc.*, No. 18-cv-11434-AKH, 2019 WL 8405265 (S.D.N.Y. June 3, 2019); *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425 (S.D.N.Y. 2016); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266 (11th Cir. 2012); *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007); *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410 (S.D.N.Y. 2002); *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430 (S.D.N.Y. 1997); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997); *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497 (2d Cir. 1996); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769 (8th Cir. 1994); *Hard Rock Cafe Licensing Corp. v. Pac. Graphics, Inc.*, 776 F. Supp. 1454 (W.D. Wash. 1991); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490 (2d Cir. 1989); *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987); *L.L. Bean Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979); *Gucci Shops, Inc. v. R. H. Macy & Co.*, 446 F. Supp. 838 (S.D.N.Y. 1977); *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1193 (E.D.N.Y. 1972). In Europe: *Cour d'Appel [CA] Paris*, 4 ch., Nov. 16, 2005, 04/12417 (Fr.) (for an English translation, see *Esso Plc v. Greenpeace France*, [2006] E.T.M.R. 53); *Cour d'Appel [CA] Paris*, 14 ch., Feb. 26, 2003, 02/16307 (Fr.) (for an English translation, see *Association Greenpeace France v. SA Société ESSO*, [2003] E.T.M.R. 66); *Tribunal de grande instance [TGI] Paris*, May 14, 2001, 01/55088 (Fr.) (for an English translation, see *Société Gervais Danone v. Société Le Réseau Voltaire*, [2003] E.T.M.R. 26); *Ate My Heart Inc. v. Mind Candy Ltd.* [2011] EWHC 2741 (Ch); *Miss World Ltd. v. Channel 4 Television Corp.* [2007] EWHC 982 (Pat); *Rb.'s-Gravenhage* 4 mei 2011, NJF 2011, 264 (Nadia Plesner Joensen/Louis Vuitton Malletier SA) (Neth.); *Bundesgerichtshof [BGH] [Federal Court of Justice]* Apr. 7, 2005, NJW 2856 (2005) (Ger.) (for an English translation, see *Violet Postcard*, 38 Int'l Rev. of Intell. Prop. & Competition L. 119 (2007)).

³² Jonathan Moskin, *Frankenlaw: The Supreme Court's Fair and Balanced Look at Fair Use*, 95 Trademark Rep. 848, 871 (2005) ("[C]ourts have employed a balancing approach, weighing fair use concerns and First Amendment rights of expression, on the one hand, against the trademark owner's claimed proprietary interests—at least for some parodic fair use cases.") (citations omitted). See also case law cited in note 33 *infra*.

³³ The ability of freedom of speech to insulate defendants' unauthorized use of marks for expressive purposes has been explicitly recognized by U.S. and European courts on numerous occasions. See, e.g., in the United States: *Yankee Publ'g Inc. v. News Am. Publ'g Inc.*, 809 F. Supp. 267, 275-76 (S.D.N.Y. 1992); *Mut. of Omaha Ins. Co. v. Novak*, 648 F. Supp. 905, 911 (D. Neb. 1986); *Reddy Commc'ns, Inc. v. Env't Action Found., Inc.*, 199 U.S.P.Q. (BNA) 630, 634 (D.D.C. 1977); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 494 (2d Cir. 1989); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989); *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1440 (S.D.N.Y. 1997); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 776 (8th Cir. 1994); *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 906 (9th Cir. 2002). In Europe: *Bundesgerichtshof [BGH]* Apr. 7, 2005, NJW 2856 (2005) (Ger.) (in English: *Violet Postcard*, *supra* note 29, at 121 (2007)); *Rb.'s-Gravenhage* 4 mei 2011, NJF 2011, 264 (Nadia Plesner Joensen/Louis Vuitton Malletier SA) (Neth.), para. 4.6; *Cour d'Appel*

liability.³⁴ Challenging the conventional wisdom that defendants rarely succeed in U.S. courts, McGeveran observed in 2015 that “plausible claims of parody almost always prevail over trademark rights in judicial rulings.”³⁵ Whether this remains the case is now an open question following the Supreme Court’s recent decision in *Jack Daniel’s*, which has narrowed the protective reach of the First Amendment where defendants use recoded marks for source-identifying purposes, even if the use is also expressive in nature.³⁶

Second, in recent years, refusals to register signs on the statutory ground that they are immoral, disparaging, or scandalous (in the United States), or contrary to public policy or morality (in Europe), have increasingly been challenged on the basis that they violate the applicants’ speech rights, with varying success.³⁷ In the United States, this line of argument has been remarkably successful. In *Matal* and *Brunetti*, the Supreme Court struck down the Lanham Act’s bars on the registration of disparaging, immoral, and scandalous marks as impermissibly viewpoint-based restrictions on speech, significantly expanding the range of signs eligible for federal registration.³⁸ The position in Europe is markedly different. In *Constantin Film Produktion*, the Court of

[CA] Paris, 4 ch., Nov. 16, 2005, 04/12417 (Fr.) (for an English translation, see *Esso Plc v. Greenpeace France*, [2006] E.T.M.R. 53).

³⁴ William McGeveran, *The Imaginary Trademark Parody Crisis (and the Real One)*, 90 Wash. L. Rev. 713 (2015); Sonia K. Katyal, *Trademark Cosmopolitanism*, 47 U.C. Davis L. Rev. 875, 927 (2013). See, in slightly less positive terms, Dogan & Lemley, *supra* note 4, at 1194.

³⁵ McGeveran, *supra* note 34, at 713.

³⁶ *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023).

³⁷ In the United States: *Iancu v. Brunetti*, 588 U.S. 388 (2019); *Matal v. Tam*, 582 U.S. 218 (2017); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015); *In Re Fox*, 702 F.3d 633 (Fed. Cir. 2012); *In re Boulevard Entertainment, Inc.*, 334 F.3d 1336 (Fed. Cir. 2003); *Pro-Football, Inc. v. Harjo*, 57 U.S.P.Q.2d 1140 (D.D.C. 2000); *Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999); *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d 1828 (T.T.A.B. 1994); *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367 (Fed. Cir. 1994); *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981). In Europe: R 260/2021-G, Application of Matthias Zirnsack (COVIDIOT) (May 16, 2024); R 1364/2022-5, Application of Escobar Inc. (PABLO ESCOBAR) (Feb. 21, 2023); CSIBI v. Romania, App. No. 16632/12 (ECtHR, June 4, 2019); Case C-240/18, *Constantin Film Produktion GmbH (FACK JU GÖHTE)* v. EUIPO, ECLI:EU:C:2020:118 (Feb. 27, 2020); R 2244/2016-2, Application of Brexit Drinks Ltd. (BREXIT) (June 28, 2017); *Dor v. Romania*, App. No. 55153/12 (ECtHR, Aug. 25, 2015); R 519/2015-4, Application of Josef Reich (JEWISH MONKEYS) (Sept. 2, 2015); R-793/2014-2, Application of Ung Cancer (FUCK CANCER) (Feb. 23, 2015); R 2804/2014-5, Application of Square Enix Ltd. (MECHANICAL APARTHEID) (Feb. 6, 2015); R 2889/2014-4, Case T-417/10, *Federico Cortés del Valle López (¡Que bueno ye! HIJOPUTA)* v. OHIM, ECLI:EU:T:2012:120 (Mar. 9, 2012); Case T-232/10, *Couture Tech Ltd. v. OHIM*, ECLI:EU:T:2011:498 (Sep. 20, 2011); R 495/2005-G, Application of Jebaraj Kenneth (SCREW YOU) (July 6, 2006); *French Connection Ltd.’s Trademark Application (FCUK)* [2007] E.T.M.R. 8; *Basic Trademark SA’s Trademark Application (JESUS)* [2006] E.T.M.R. 24; *Ghazilian’s Trademark Application (TINY PENIS)* [2002] E.T.M.R. 57.

³⁸ *Matal v. Tam*, 582 U.S. 218 (2017); *Iancu v. Brunetti*, 588 U.S. 388 (2019).

Justice of the European Union (“CJEU”) acknowledged freedom of expression as a relevant consideration in the assessment of morality-based refusals to registration, but without allowing speech to override the morality bar.³⁹ Signs contrary to public policy or morality therefore continue to be refused in the EU in a way that their U.S. counterparts no longer are.

Third, restrictions on trademark use that impact marks’ expressive function arise not only from trademark statutes, but also, at times, from public measures regulating the consumption of certain goods. This is most apparent in legislation designed to prevent the use of marks that may mislead consumers about the characteristics of the goods or that—through the positive images marks convey—encourage the purchase of goods posing health risks. Examples include restrictions on the use of marks for tobacco products, such as mandatory health warnings, advertising bans, and, more recently, standardized packaging.⁴⁰ Rightsholders have challenged these measures, arguing, *inter alia*, that they constitute an unjustified interference with their right to freedom of expression.⁴¹ Once again, an Atlantic divide emerges. European courts tend to apply a deferential proportionality test under which the pursuit of public health is largely sufficient to validate such measures, whereas U.S. courts apply more demanding scrutiny to restrictions on commercial speech under the First Amendment—an

³⁹ Case C-240/18, *Constantin Film Produktion GmbH (FACK JU GÖHTE) v. EUIPO*, ECLI:EU:C:2020:118 (Feb. 27, 2020).

⁴⁰ Regulations requiring that tobacco products bear health warnings have been in effect since 1965 in the United States (The Cigarette Labelling and Advertising Act of 1965, Pub. L. No. 89-92), 1976 in France (Loi 76-616 du 9 Juillet 1976 Relative à la Lutte Contre le Tabagisme), and 2001 in the EU (Directive 2001/37, of the European Parliament and of the Council of 5 June 2001 on the Approximation of the Laws, Regulations and Administrative Provisions of the Member States Concerning the Manufacture, Presentation and Sale of Tobacco Products, 2001 O.J. (L194) 26). Advertising bans have been regulated in the EU by means of several instruments, including Directive 98/43, of the European Parliament and of the Council of 6 July 1998 on the Approximation of the Laws, Regulations and Administrative Provisions of the Member States Relating to the Advertising and Sponsorship of Tobacco Products, 1998 O.J. (L213) 9. Some European countries have recently adopted plain packaging legislation, such as France (Loi 2016-41 du 26 janvier 2016 de modernisation de notre système de santé), Ireland (Public Health (Standardised Packaging of Tobacco) Act 2015), and the UK (Standardised Packaging of Tobacco Products Regulations 2015).

⁴¹ That government-imposed restrictions on trademark use can impinge on rightsholders’ freedom of expression has been recognized by both U.S. and European courts. *See*, in the United States: *Cigar Assoc. of Am. v. FDA*, 315 F. Supp. 3d 143 (D.D.C. 2018); *R.J. Reynolds Tobacco Co. v. FDA*, 696 F.3d 1205 (D.C. Cir. 2012); *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525 (2001). In Europe: Case C-547/14, *Philip Morris Brands SARL v. Secretary of State for Health*, ECLI:EU:C:2016:325 (2016); Opinion of Advocate General Kokott in Case C-547/14, *Philip Morris Brands SARL v. Secretary of State for Health*, ECLI:EU:C:2015:853 (2015); *R. (on the application of British American Tobacco UK Ltd.) v. Secretary of State for Health* [2004] EWHC 2493 (Admin.); Opinion of Advocate General Fennelly in Case C-376/98, *Germany v. European Parliament*, ECLI:EU:C:2000:324 (2000).

approach that has, in several instances, led to such measures being struck down.

Taken together, these three scenarios reveal an important pattern. In infringement cases, freedom of expression is invoked by defendants to *limit* trademark rights; in registration and brand restriction cases, it is invoked by applicants or rightsholders to *validate* them. Yet neither decision-makers nor scholars have previously engaged with the interaction between trademarks and speech in a holistic manner.⁴² Their analyses have, instead, been systematically focused on one form of interaction at a time, producing a common misconception in the field: that the interaction between trademarks and speech is unidirectional, advancing the speech interests of only one subset of expressive users at a time, depending on the type of litigation involved.⁴³ This is, I argue, one of two ways in which the prevailing conceptualization of the interaction between marks and speech is incomplete. A joint analysis of the three main contexts in which trademarks and speech interact reveals that the relationship, in fact, operates as a two-way street, in which free speech can simultaneously validate and limit trademark rights. Recognizing this two-way dynamic provides a more solid foundation for reconceptualizing the interaction between trademarks and free speech as competing forms of speech.

A possible explanation for the misconception that the interaction is unidirectional may be historical: until the more recent wave of litigation mobilizing freedom of expression to challenge refusals of registration, free speech arguments were, for the most part, confined to infringement litigation.⁴⁴ Another may be that free speech operates as a reactive tool to safeguard the status quo, keeping in check the unintended consequences of (a) ever-expanding trademark rights (as a result of the progressive broadening of the likelihood of confusion cause of action,⁴⁵ as well as the adoption of

⁴² I have explored this further elsewhere: Fernandez-Mora, *supra* note 5.

⁴³ *Id.* at note 18.

⁴⁴ Compare the vast volume of infringement cases (especially in the United States, which date all the way back to the early 1970s) cited in note 31 *supra* with the more reduced number of registration and brand restriction cases in notes 37 and 41 *supra*, respectively.

⁴⁵ Likelihood of confusion has expanded particularly through the recognition of protection against initial interest confusion, post-sale confusion, and sponsorship confusion. Beebe's contributions are particularly noteworthy in this regard. As he explains, the expansion of the confusion cause of action is doing much of the heavy lifting to protect trademarks against dilutive harms. He goes as far as to argue that "the antidilution cause of action is itself a failure," adding that "courts have adapted other areas of trademark law [notably protection against confusion] to do the regulatory work that antidilution law was originally intended to do." Barton Beebe, *Intellectual Property and the Sumptuary Code*, 123 Harv. L. Rev. 809, 851 (2010). See also: Barton Beebe, *The Continuing Debacle of U.S. Antidilution Law: Evidence from the First Year of Trademark Dilution Revision Act Case Law*, 24 Santa Clara High Tech. L.J. 449 (2007); Mark Lemley and Mark McKenna, *Owning Mark(et)s*, 109 Mich. L. Rev. 137 (2010); Mark McKenna, *Testing Modern Trademark Law's Theory of Harm*, 95 Iowa L. Rev. 63 (2010).

anti-dilution provisions),⁴⁶ and (b) increasingly restrictive public law measures targeting trademark use and registration.⁴⁷ As the case law shows, different parties invoke freedom of expression to pursue very different agendas: defendants seek to shield their unauthorized uses of recoded marks from infringement liability, while rightsholders and applicants seek to continue unobstructed use of their marks in trade or to secure access to the register. Put differently, the opportunistic nature of free speech claims in trademark law may also help explain the apparent lack of communication between courts deciding corresponding cases.

This lack of communication is the second reason, I argue, that decision-makers are adjudicating interaction disputes in suboptimal conditions: they fail to recognize the diversity of expressive users of trademarks. Awareness of the full range of scenarios in which trademarks and speech interact highlights the spillover effect that judicial findings in one setting can have in the others. Recognition of the expressive interests of rightsholders and applicants in registration and brand restriction litigation ought to permeate the infringement context, and vice versa. This is not to say that trademarks and free speech interact identically across all three contexts, but rather that certain core principles apply across interaction disputes, as mandated by human rights instruments. Honoring those principles requires courts to resolve interaction disputes with a view to protecting the full diversity of expressive rights at stake—not just those of the subset of expressive users that happens to be before the court. It also requires courts to identify the full range of expressive users impacted by interaction disputes, moving beyond those traditionally identified in the case law and scholarship (i.e., defendants, rightsholders, and applicants). The result would be improved enforcement of constitutional guarantees in trademark disputes.

We now turn to the diversity of ways in which individuals can use trademarks for expressive purposes.

⁴⁶ Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat 985 (1996) (U.S.); First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (EU).

⁴⁷ This is particularly noticeable in the context of trademark-restrictive measures, which have expanded both in terms of the intensity of the restrictions imposed on trademark use (from advertising bans dating back to the 1960s to ever-larger health warnings and even plain packaging requirements in a wide range of jurisdictions in the last decade) and the industries targeted (from tobacco products to alcoholic drinks and even foods high in fat, sugar, and salt in recent years). I have explored this topic further elsewhere: Alvaro Fernandez-Mora, *Trade Marks and the Right to Health: A Growing Tension*, in *Justice in Global Health: New Perspectives and Current Issues* (Himani Bhakuni & Lucas Miotto eds., 2023).

PART II. SPEAKING IN BRANDS: A TYPOLOGY OF EXPRESSIVE USERS OF TRADEMARKS

Much has been written on the interaction between trademarks and speech, whether in the context of infringement,⁴⁸ registration,⁴⁹ or brand restriction cases.⁵⁰ Yet case law and scholarship have made

⁴⁸ Among others: Martin Senftleben, *The Unproductive “Overconstitutionalization” of EU Copyright and Trademark Law—Fundamental Rights Rhetoric and Reality in CJEU Jurisprudence*, 55 Int’l Rev. Intell. Prop. & Competition L. 1471 (2024); Martin Senftleben, *supra* note 4; Basma, *supra* note 4, at 226; Michal Bohaczewski, *Conflicts Between Trade Mark Rights and Freedom of Expression Under EU Trade Mark Law: Reality or Illusion?*, 51 Int’l Rev. Intell. Prop. & Competition L. 856 (2020); Kathleen E. McCarthy, *Free Ride or Free Speech: Predicting Results and Providing Advice for Trademark Disputes Involving Parody*, 109 Trademark Rep. 691 (2019); Sabine Jacques, *supra* note 4; Katyal, *supra* note 4; Stacey L. Dogan & Mark A. Lemley, *supra* note 4; McGeveran, *supra* note 34; Christine Haight Farley & Kavita DeVaney, *Considering Trademark and Speech Rights through the Lens of Regulating Tobacco*, 43 AIPLA Q.J. 289 (2015); Rebecca Tushnet, *More than a Feeling: Emotion and the First Amendment*, 127 Harv. L. Rev. 2392 (2014); Rt. Hon. Sir Robin Jacob, *Parody and IP Claims: A Defence?—A Right to Parody?*, in *Intellectual Property at the Edge—The Contested Contours of IP*, 427 (Rochelle Cooper Dreyfuss & Jane C. Ginsburg eds., 2014); David A. Simon, *The Confusion Trap: Rethinking Parody in Trademark Law*, 88 Wash. L. Rev. 1021 (2013).

⁴⁹ Among others: Margaret Chon & Robert S. Chang, *The Indians Who Were Not Heard and the Band That Must Not Be Named: Racial Formation and Social Justice in Intellectual Property Law*, in *The Cambridge Handbook of Intellectual Property & Social Justice* (Steven D. Jamar & Lateef Mtima eds., 2024); Mariana Bernal Fandiño, *Controversial Trademarks: A Comparative Analysis*, in *The Cambridge Handbook of Intellectual Property & Social Justice* (Steven D. Jamar & Lateef Mtima eds., 2024); Davis & Żelechowski, *supra* note 4; Elena Izyumenko, *A Freedom of Expression Right to Register “Immoral” Trademarks and Trademarks Contrary to Public Order*, 52 Int’l Rev. Intell. Prop. & Competition L. 893 (2021); Ned Snow, *Immoral Trademarks after Brunetti*, 58 Hous. L. Rev. 401 (2020); Gary Myers, *It’s Scandalous!—Limiting Profane Trademark Registrations after “Tam” and “Brunetti,”* 27 J. Intell. Prop. L. 1 (2020); Katyal, *supra* note 4; Vicenc Feliu, *The F Word—An Early Empirical Study of Trademark Registration of Scandalous and Immoral Marks in the Aftermath of the In Re Brunetti Decision*, 18 J. Marshall Rev. Intell. Prop. L. 404 (2019); Barton Beebe & Jeanne C. Fromer, *Immoral or Scandalous Marks: An Empirical Analysis*, 8 N.Y.U. J. Intell. Prop. & Ent. L. 169 (2019); Susan Snedden, *Immoral Trade Marks in the UK and at OHIM: How Would the Redskins Dispute Be Decided There?*, 11 J. Intell. Prop. L. & Prac. 270 (2016); Enrico Bonadio, *Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Trademarks*, 19 Marq. Intell. Prop. L. Rev. 39 (2015); Fhima, *supra* note 23.

⁵⁰ Fernandez-Mora, *supra* note 47; Sunil S. Gu, *Plain Tobacco Packaging’s Impact on International Trade and the Family Smoking Prevention and Tobacco Control Act in the U.S. and Drafting Suggestions*, 16 Wash. U. Global Stud. L. Rev. 197 (2017); Matthew J. Elmsore, *Trademarks, Tobacco, Health: Brokerage by Fundamental Rights?*, in *The New Intellectual Property of Health* (Alberto Alemanno & Enrico Bonadio eds., 2016); Sergio Puig, *Tobacco Litigation in International Courts*, 57 Harv. Int’l L.J. 383 (2016); Jonathan Griffiths, *“On the Back of a Cigarette Packet”—Standardised Packaging Legislation and the Tobacco Industry’s Fundamental Right to (Intellectual) Property*, Intell. Prop. Q. 343 (2015); Richard J. Bonnie, *The Impending Collision Between First Amendment Protection for Commercial Speech and the Public Health: The Case of Tobacco Control*, 29 J. L. & Pol. 599 (2014); Nathan Cortez, *Do Graphic Tobacco Warnings Violate the First Amendment?*, 64 Hastings L.J. 1467 (2013).

few attempts to classify the full range of expressive users of marks.⁵¹ This section addresses that gap by proposing a typology that can help courts and scholars better account for the expressive richness of trademark use. I suggest five categories: (a) trademark owners; (b) consumers of branded goods; (c) recoders; (d) consumers of goods bearing recoded marks; and (e) the public. Each is explored, with examples, below.

The first category of expressive user that I have identified is *trademark owners*, who express themselves through use of their marks in relation to the offer of goods or services, including in advertising.⁵² For instance, in the luxury goods sector, the LOUIS VUITTON mark has come to communicate a wealth of information beyond signaling the commercial origin of its owner, Louis Vuitton Malletier S.A. It now also conveys an image of heritage, craftsmanship, and aspirational luxury. This is the result of a conscious effort by its rightsholder, whose brand strategy seeks to transcend more conventional meanings such as commercial origin and product quality. Louis Vuitton is well known for its commitment to artisanal production in its dedicated ateliers, for the long history of its monogram canvas (introduced in 1896 by Georges Vuitton in part as an anti-counterfeiting measure),⁵³ and for a series of high-profile collaborations with artists ranging from Yayoi Kusama to Jeff Koons.⁵⁴ The concepts of heritage, craftsmanship, and exclusivity are, therefore, firmly rooted in the house's ethos. They tap into broader social values, such as refinement, sophistication, and the cultural capital that comes with discerning consumption—all of which the LOUIS VUITTON mark is able to convey. How? First, by maintaining production processes that emphasize traditional leather-working techniques.⁵⁵ Second, by informing consumers, through elaborate advertising and editorial coverage, that its high-end products are the heirs of a long-standing tradition

⁵¹ Although she did not attempt to define or classify the different categories of expressive users of marks, Katyal noted the diversity of expressive interests involved in trademark use in Katyal, *supra* note 34, at 878 ("Each of these audiences—whether consumers of luxury goods, political actors, or artist/activists . . .—oppositional or otherwise, all integrate and respond to particular brands as part of their process of self-expression.").

⁵² See Spence, *supra* note 25.

⁵³ A timeline of Louis Vuitton's history is available on its website, <https://uk.louisvuitton.com/eng-gb/magazine/articles/heritage> (last visited Apr. 29, 2026).

⁵⁴ Erin-Atlanta Argun, *Creating Infinity: Yayoi Kusama & Louis Vuitton*, My Art Broker (Aug. 5, 2025), <https://www.myartbroker.com/artist-yayoi-kusama/articles/creating-infinity-yayoi-kusama-louis-vuitton> (last visited Apr. 29, 2026); Katie Berrington, *Louis Vuitton Launches Collaboration With Jeff Koons*, British Vogue (Apr. 11, 2017), <https://www.vogue.co.uk/gallery/louis-vuitton-collaboration-with-jeff-koons> (last visited Apr. 29, 2026).

⁵⁵ Matilde Stadager, *The art and precision of Louis Vuitton's craftsmanship*, Collector's Cage (Jan. 5, 2024), <https://collectorscage.com/blogs/guides/louis-vuitton-craftmanship> (last visited Apr. 29, 2026).

of luxury travel and refinement.⁵⁶ This information allows Louis Vuitton to attract consumers who value heritage and brand prestige above other features. And third, by building a brand image that revolves around aspirational luxury and global sophistication. As a result, the LOUIS VUITTON mark allows the house to: (a) distinguish its goods from those of other luxury houses; (b) inform—and persuade—consumers that its products combine superior quality with a sense of heritage, craftsmanship, and exclusivity; and (c) express its allegiance to values of luxury, lasting quality, and refined taste. The ability of contemporary trademarks to convey such complex meanings is extremely valuable for firms wishing to attract consumers who identify with the values and lifestyle preferences conveyed by expressive marks.

This brings us to the second category of expressive users of marks: *consumers of branded goods*. Purchasing and using branded goods allows consumers not only to meet their material needs but also to project an identity, the goods serving as vehicles for self-expression. As Belk observes, “we regard our possessions as parts of ourselves.”⁵⁷ Such expressive uses are commonplace in our brand-oriented, image-driven society. Returning to the luxury goods example, a consumer who identifies with the heritage and luxury values conveyed by the LOUIS VUITTON marks will use them expressively through the acts of acquiring and carrying a monogram-canvas handbag, wallet, or piece of luggage with the aim of communicating his or her adherence to such values. In this scenario, it is easy to imagine the “LV” monogram communicating the consumer’s identity project as a person of established taste and means when he or she carries a LOUIS VUITTON-branded handbag at a fashion event, business meeting, or while travelling internationally—signaling membership in a community that values the public display of luxury consumption. There is evidence of this type of expressive use in the considerable cultural commentary that the brand attracts: lifestyle journalism and academic writing on luxury consumption have long treated Louis Vuitton as a paradigmatic example of how individuals deploy branded goods to communicate social position.⁵⁸ Interestingly, in presenting himself or herself as someone who carries a LOUIS VUITTON-branded good, the consumer may also be communicating that he or she is not, say, someone who carries an HERMÈS-branded handbag (i.e., someone who might be read as preferring more discreet, quiet

⁵⁶ See marketing campaigns cited in note 24 *supra*.

⁵⁷ Russell W. Belk, *Possessions and the Extended Self*, 15 J. Consumer Rsch. 139, 139 (1988).

⁵⁸ Kapferer & Bastien, *supra* note 13; Elizabeth Currid-Halkett, *The Sum of Small Things: A Theory of the Aspirational Class* (Princeton University Press, 2017); Dana Thomas, *Deluxe: How Luxury Lost Its Lustre* (Penguin Press, 2007).

luxury signals).⁵⁹ The two consumption choices express different aesthetic and social commitments, even though both brands operate at the very top of the luxury market.

The third category of expressive user of trademarks is *recoders*, who use modified versions of marks—by removing, replacing, and/or adding material—to imbue them with new meaning. Often, the point of recoding is to comment on the meanings that the mark already carries, whether by criticizing or parodying them. At other times, the recoded mark is less about the brand or its owner than about deploying the mark as a vehicle for a broader sociopolitical message. Importantly, while defendants in infringement actions involving expressive uses of marks will commonly qualify as recoders, the opposite is not true: recoders will be deemed defendants only where their unauthorized use of a recoded mark has given rise to an infringement suit. Indeed, many expressive uses of recoded marks fall outside the scope of trademark law altogether, notably where the recoder does not use the mark as a designation of source for goods or services—a threshold requirement for trademark liability in most jurisdictions.

The LOUIS VUITTON mark and its associated monogram pattern have been recoded on numerous occasions to critique the values of exclusivity and conspicuous consumption on which the house's image rests, and Louis Vuitton Malletier S.A. has been among the most zealous defenders of its marks against such uses on both sides of the Atlantic.⁶⁰ A particularly powerful example is the Danish artist Nadia Plesner's *Simple Living* and *Darfurnica* artworks, in which an emaciated child is depicted carrying a handbag bearing the unmistakable pattern of Louis Vuitton's multicolored monogram.⁶¹ The artist's aim was to draw attention to the disproportionate share of public attention devoted to celebrity consumption—in particular to luxury accessories of the kind in question—while a humanitarian catastrophe unfolded in Darfur. Louis Vuitton sued Plesner for infringement of its EU design rights in the multicolored monogram pattern, but the District Court of The Hague ultimately ruled that Plesner's freedom of artistic expression prevailed over the claimant's exclusive rights (design rather than trademark rights, though the constitutional balancing principles

⁵⁹ Priya Bhamra, *Quiet Luxury and Timeless Desire: How Hermès Mastered Luxury*, Vogue College of Fashion (Jan. 13, 2026), <https://www.voguecollege.com/articles/london/quiet-luxury-and-timeless-desire-how-hermes-mastered-luxury/> (last visited Apr. 29, 2026).

⁶⁰ Noteworthy examples include: *Rb.'s-Gravenhage 4 mei 2011*, NJF 2011, 264 (Nadia Plesner Joensen/Louis Vuitton Malletier SA) (Neth.); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007); *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425 (S.D.N.Y. 2016).

⁶¹ *Rb.'s-Gravenhage 4 mei 2011*, NJF 2011, 264 (Nadia Plesner Joensen/Louis Vuitton Malletier SA) (Neth.).

apply with equal force). Recoding allowed Plesner to harness the communicative potential of the “LV” monogram as a conveyor of conspicuous luxury and to steer it toward expressing her preferred message—one that interrogates the moral disproportion between media saturation around such goods and indifference to mass atrocity.

We find other examples of recoding the LOUIS VUITTON marks. The American company Haute Diggity Dog, LLC markets plush chew toys for dogs bearing the name “Chewy Vuiton” and a “CV” monogram in colors and configuration evocative of Louis Vuitton’s “LV” monogram.⁶² The U.S. Court of Appeals for the Fourth Circuit found this to be a successful parody, observing that “[t]he dog toy irreverently presents haute couture as an object for casual canine destruction. The satire is unmistakable. The dog toy is a comment on the rich and famous, on the LOUIS VUITTON name and related marks, and on conspicuous consumption in general.”⁶³ Similarly, My Other Bag, Inc. markets inexpensive canvas tote bags featuring cartoonish drawings of luxury handbags—including one of Louis Vuitton’s signature handbags in simplified form, with “MOB” (i.e., “My Other Bag”) replacing the claimant’s “LV” monogram—alongside “My Other Bag . . .,” riffing on the bumper-sticker convention “my other car . . .” to lampoon the very status hierarchy that the original mark embodies.⁶⁴ The Second Circuit found this to be a successful parody too and, thus, shielded from liability.⁶⁵

Recoding allows the defendants in these examples to harness the communicative power of the LOUIS VUITTON marks and redirect it toward a critique of the consumerist and status-driven values the mark is taken to embody. This kind of expressive use sits far from Louis Vuitton’s own use of its mark. So far that, as we have seen, recoders have found themselves on the receiving end of infringement actions brought by the rightsholder—“by its own description, an ‘active[] and aggressive[]’ enforcer of its trademark rights.”⁶⁶ But recoders sometimes go on to affix their recoded marks to goods that are later offered for sale in the marketplace, as Plesner did when offering for sale T-shirts bearing her *Simple Living* artwork (the proceeds of which were donated to humanitarian relief in Darfur), and as Haute Diggity Dog, LLC and My Other Bag, Inc. continue to do. Their aim in doing so is

⁶² Available on Haute Diggity Dog, LLC’s online store, <https://www.hautediggitydog.com/collections/chewy-vuiton> (last visited Apr. 29, 2026).

⁶³ *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007).

⁶⁴ Available on My Other Bag, Inc.’s online store: <https://www.myotherbags.com/shop> (last visited Apr. 29, 2026).

⁶⁵ *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425 (S.D.N.Y. 2016).

⁶⁶ *Id.* at 445.

twofold. First, to express themselves through use of the recoded marks. And second, to enable those individuals who identify with the critical or parodic message conveyed by the recoded marks to use them expressively too, by purchasing and using goods bearing recoded marks.⁶⁷ While this form of use by recoders may resemble the form in which trademark owners make expressive use of their (non-recoded) marks, the content of the respective messages conveyed is very different.

This leads us to the fourth category of expressive user of marks: *consumers of goods bearing recoded marks*. To illustrate this type of expressive use, one can think of consumers who purchase and wear Plesner's *Simple Living* T-shirts to express their solidarity with the victims of the Darfur conflict and their unease at the disproportion between popular attention to celebrity consumption and indifference to human suffering. Or of consumers who buy "Chewy Vuiton" toys for their pets as a knowing nod to the absurdities of conspicuous consumption, or who carry "My Other Bag" canvas totes both to mock the luxury status hierarchy and, perhaps, to signal a more egalitarian set of consumption values. Similarly to what we saw with recoders and rightsholders, although consumers of goods bearing recoded marks express their worldview in much the same manner as consumers of branded goods, the ideas conveyed by both types of consumers are very different.

In the final category of expressive user of marks, we find individuals who employ expressive marks that have permeated language, art, and culture more broadly in their everyday conversations and creative endeavors—what I have dubbed the *public*. This is, of course, only possible of trademarks that have made their way into the language, in the sense that they can convey meaning irrespective of any underlying goods or services. Perhaps the most popular example of this type of mark is BARBIE, which has entered the English language to describe "a young woman who is glossily attractive but apparently characterless or unintelligent."⁶⁸ Dreyfuss was the first scholar to draw attention to this type of expressive use of trademarks as early as 1990, when she relied precisely on the famous doll's trademark to explain Joan Kennedy's use of the word "Barbie" in conversation as a way "to indicate that she was treated like a beautiful but empty-headed accessory, . . . exploit[ing] a set of meanings that are quite different from the ones invoked by [the trademark owner] Mattel."⁶⁹

⁶⁷ Dogan & Lemley, *supra* note 4, at 1186.

⁶⁸ *Oxford English Dictionary*, *supra* note 22.

⁶⁹ Dreyfuss, *supra* note 2, at 400. The quote from Joan Kennedy that Dreyfuss was commenting on, as recounted by Marcia Chellis, was as follows: "When I campaign alone I'm approachable. Women talk to me, complain, but when I'm with Ted I'm a Barbie doll." Marcia Chellis, *The Joan Kennedy Story: Living with the Kennedys*, 191 (Jove ed., 1986).

The luxury sector offers further illustrations of this phenomenon. The words “Louis Vuitton” have long since outgrown their function as a mere product identifier and now circulate in everyday language as shorthand for a particular form of aspirational luxury—and, indeed, for the kind of social positioning that owning such goods is taken to signify. References to “Louis Vuitton” abound across literature,⁷⁰ film, and music, with the last offering especially rich examples of luxury marks permeating into the language. In hip-hop in particular, “Louis Vuitton” and “LV” recur as cultural shorthand for achievement and success—a tradition that arguably reached a peak with Kanye West’s self-styling as “the Louis Vuitton Don” on his debut album *The College Dropout* (2004).⁷¹

As we have seen, the expressive dimension of marks allows a wide range of individuals to express themselves through their use, and the same mark may serve very different expressive interests in different hands. This should come as no surprise, given the fundamental role expression plays in allowing individuals to convey their ideas and values to others—and, in so doing, to develop their autonomy. Adopting the typology of expressive users proposed here refines our understanding of the interaction between trademarks and free speech. The following section explores how it does so, and what implications this shift carries for the discipline.

PART III. BRINGING SPEECH TO CHAOS: A WAY FORWARD FOR THE INTERACTION BETWEEN TRADEMARKS AND SPEECH

A note is in order at this stage regarding the kinds of trademarks typically implicated in interaction cases. As the examples discussed throughout this article illustrate, recoding efforts overwhelmingly target marks that enjoy a significant degree of public recognition. This is no accident. The communicative force of a recoded mark depends on the audience’s ability to recognize the original sign and to perceive the gap between its conventional meaning and the modified message the recoder seeks to convey. Where the underlying mark is unknown, the recoded version cannot perform

⁷⁰ In relation to the use of trademarks in literature, Monroe Friedman conducted an empirical study back in 1985 that showed a remarkable increase in the number and variety of marks used in mainstream novels published in the United States in the period from 1946 to 1972. Monroe Friedman, *The Changing Language of a Consumer Society: Brand Name Usage in Popular American Novels in the Postwar Era*, 11 J. Consumer Rsch. 927, 931–34 (1985).

⁷¹ Kanye West, *The College Dropout* (Roc-A-Fella Records/Def Jam Recordings 2004). See also, discussing West’s fashion style evolution, including his Louis Vuitton Don phase, Nate Erickson, Ren McKnight and Stelios Phili, *Style Evolution: Kanye West*, GQ (June 18, 2013), <https://www.gq.com/gallery/kanye-west-celebrity-style-evolution> (last visited Apr. 29, 2026).

this expressive function: the reference is lost on the viewer. In such cases, the dispute is more naturally resolved through ordinary trademark doctrines than through the more complex free speech considerations explored here. The same logic extends to consumers of goods bearing recoded marks, whose ability to communicate their worldview through the consumption of such goods presupposes that the wider public can decode the reference to the original mark.

That said, the relevant threshold is not strictly one of fame or reputation in the technical trademark law sense. What matters is that the mark carries sufficient expressive content for its recoding to be legible to a relevant audience—and expressive content does not invariably track consumer following. Marks with strong environmental credentials, subcultural cachet, or other forms of social or political resonance may convey complex meanings to a discrete community of readers despite commanding only a modest market share. Recoding such marks can be just as expressively rich for that community as recoding a household name is for the general public. The examples deployed throughout this article are drawn predominantly from reputed marks because they most readily communicate the analysis to a broad readership, and because the bulk of interaction litigation does indeed concern such marks. But the framework proposed here is not confined to them: the relevant question in any given interaction case is not whether the mark is famous, but whether it has acquired the kind of expressive content that supports the speech interests of the diverse users identified in the typology above.

This typology illustrates the variety of ways in which individuals communicate their values and ideas through expressive marks. But it also exposes a core assumption underpinning this area of law: the perceived uniformity of the expressive user. Rarely does the case law or scholarship distinguish between different types of expressive user, let alone offer a typology such as the one advanced here. The likely explanation is a tendency to treat the (expressive) user as monolithic. Scholars across both jurisdictions have written extensively about the self-expressive acts of purchasing and using branded goods, typically by reference to a “consumer” who is rarely, if ever, defined with precision.⁷² These accounts capture an important feature of contemporary trademark use, but they do not distinguish between the two categories of expressive consumer identified in the typology above: consumers of branded goods and consumers of goods bearing recoded marks. The same indeterminacy persists even where authors gesture toward a wider

⁷² Desai, *supra* note 22, at 986; Elsmore, *supra* note 50, at 101; Gangjee, *supra* note 2, at 35; Sabine Jacques, *A Parody Exception: Why Trade Mark Owners Should Get the Joke*, 38 Eur. Intell. Prop. Rev. 471, 473 (2016); Wolfgang Sakulin, *Trademark Protection and Freedom of Expression: An Inquiry into the Conflict Between Trademark Rights and Freedom of Expression under European, German, and Dutch Law*, at 9 (2010).

range of expressive users (referring, for instance, to “market participants” beyond the rightsholder, or to “members of the public” who use marks to communicate with one another), but without specifying who these users are or how their expressive engagement differs from that of consumers.⁷³

This is not a matter of mere academic rigor; it has fundamental implications for how trademark law is interpreted and applied.⁷⁴ Where the “consumer,” “market participant,” or “member of the public” is left undefined, courts may privilege one subset of expressive users—those whose interests happen to be recognized—at the expense of others, whose speech interests go overlooked. The typology proposed here addresses this by enabling decision-makers to identify, with greater precision, the full range of expressive interests at stake in any given interaction, and to assess which of them merit protection under the right to freedom of expression.

This is precisely what Grynberg had in mind when he criticized the prevailing monolithic approach to the consumer in likelihood of confusion cases, where courts and scholars tend to give disproportionate weight to the interests of confused consumers.⁷⁵ In his view, this comes at the expense of non-confused consumers, whose interest in accessing the defendant’s goods is insufficiently considered,⁷⁶ and the result is a balancing exercise that tilts too readily toward the plaintiff. The plaintiff effectively fights “two-against-one”: the interests of both the plaintiff and confused consumers in preventing the unauthorized use are weighed against only the defendant’s interest in using a similar sign for its (similar) goods or services.⁷⁷ This imbalance, Grynberg argues, “skews analysis of trademark claims and abets the heavily criticized

⁷³ Chon & Chang, *supra* note 49, at 59; Dogan & Lemley, *supra* note 4, at 1196.

⁷⁴ Marlan has explored the consequences of overreliance on the term “consumer” in trademark law for purposes of sustaining unconscious biases, arguing that “the biasing effects of *consumer* may be contributing to trademark law defining the public in a manner that is patronizing, biased, insulting, and indulgent of likelihood-of-confusion claims.” Dustin Marlan, *Is the Word “Consumer” Biasing Trademark Law?*, 8 Tex. A&M L. Rev. 367, 373 (2021) (emphasis in original). Heymann has also argued in favor of a more expansive understanding of the consumer in trademark law that can adequately factor in the interests of “[d]isadvantaged consumers—such as those not literate in the English language, those with lower socioeconomic status, and those who face both constraints.” Laura A. Heymann, *Trademark Law and Consumer Constraints*, 64 Arizona L. Rev. 339, 339 (2022).

⁷⁵ Michael Grynberg, *Trademark Litigation as Consumer Conflict*, 83 N.Y.U. L. Rev. 60 (2008).

⁷⁶ Grynberg acknowledges that the interests of non-confused consumers are sometimes taken into consideration, for instance, when courts seek to promote competition. However, in his view, this is rarely the case, and even when they are factored in, the privileged consideration given to the interests of confused consumers tends to prevail. *Id.*

⁷⁷ *Id.* at 62.

expansion of trademark's scope beyond its traditional boundaries."⁷⁸ Abandoning the monolithic understanding of the consumer would, therefore, not only improve adjudication in likelihood of confusion cases but also help rein in the expanding scope of protection afforded to trademark owners.

Grynberg's proposition opens the door to more nuanced adjudication by attuning trademark enforcement to the diversity of users and interests involved in trademark use, and so to better balanced and fairer outcomes. His contribution is arguably more relevant still in disputes involving expressive uses of marks, where, as we have seen, the interests of a wide range of users are at stake.⁷⁹ There is support for this in the case law. In its recent decision in *COVIDIOT*, the EUIPO Grand Board of Appeal relied on the Advocate General's opinion in *Constantin Film Produktion* to recognize the "different multi[faceted rights and] interests' at stake in the protection of freedom of expression."⁸⁰ Yet its application of that recognition remained conventional in two respects. First, it diminished the applicant's expressive interest on grounds that registration is not a precondition of use, overlooking the genuine expressive value of registration itself.⁸¹ Second, the third-party interests it weighed against the applicant's speech were moral rather than expressive: the public's interest in not seeing a sign that trivializes a public health tragedy endorsed through registration, rather than the expressive interests of the other users identified in Part II.⁸² For all these shortcomings, *COVIDIOT* takes a useful first step toward recognizing the multiplicity of interests at stake in interaction cases, opening the door to the typology proposed here—which goes further, recognizing that those third-party interests include not only the moral concerns of the wider public but also the expressive interests of the additional categories of users identified in Part II.

Improved adjudication in interaction cases will therefore require expanding the range of expressive interests considered. The recognition of those interests on the part of applicants and rightsholders in registration and brand restriction cases ought to permeate the recoding context, and vice versa. But this is only the

⁷⁸ *Id.* at 62.

⁷⁹ See Part II *supra*.

⁸⁰ R 260/2021-G, Application of Matthias Zirnsack (*COVIDIOT*), ¶ 143 (May 16, 2024), quoting Opinion of AG Bobek in Case C-240/18, *Constantin Film Produktion GmbH (FACK JU GÖHTE) v. EUIPO*, ECLI:EU:C:2019:553, ¶ 53 (July 2, 2019) (the AG's quote has been amended to reflect the actual language employed by the AG in the English version of its Opinion in *Constantin Film Produktion*, which does not match the one employed by the EUIPO Grand Board of Appeal in the English version of its decision in *COVIDIOT*).

⁸¹ *Id.* at ¶ 143 and 148.

⁸² *Id.* at ¶ 146-49.

first step. Proper enforcement of the human rights guarantees safeguarding freedom of expression requires decision-makers to consider the interests of all the expressive users of marks identified in Part II.

Admittedly, this is a counterintuitive approach to resolving interaction disputes, and critics may dismiss it as overcomplicated or far-fetched. Yet trademark law is, in fact, particularly adept at factoring in a wide range of interests through the efforts of an individual party with standing to litigate. Core trademark doctrines are designed precisely to protect the interests of third parties who have no legal standing in the dispute. In infringement proceedings, for instance, actions are brought by trademark owners not simply to protect their proprietary and commercial interests, but, more fundamentally, the interest of (confused, following Grynberg's proposition) consumers in avoiding confusion as to the source of the goods or services bearing the allegedly infringing sign.⁸³ Or, in the registration context, the absolute ground for refusal of descriptive marks safeguards the interests of competitors in retaining access to signs that ought to remain available for all traders to use—which, in turn, protects consumers through the welfare gains generated by a competitive marketplace. Trademark law even safeguards third-party interests vicariously in interaction cases themselves: the absolute ground for refusal of marks contrary to public policy or morality (and, in the United States until the Supreme Court's decisions in *Tam* and *Brunetti*, of immoral, disparaging, or scandalous marks) requires trademark offices and courts to routinely protect the wider public's interest in a marketplace free of offensive signs registered as trademarks.⁸⁴

⁸³ *Curtin v. United Trademark Holdings, Inc.*, 137 F.4th 1359, 1369-70 (emphasis in the original) (“[. . .] The Supreme Court has explained that th[e] goal [of protecting consumers’ ability to distinguish among products of competitors] may be served by conferring rights that only commercial actors have statutory standing to exercise.”). See *POM Wonderful LLC v. Coca-Cola Co.*, 573 U.S. 102, 107 (2014) (“Though in the end consumers also benefit from the [Lanham] Act’s proper enforcement, the cause of action [for false advertising] is for competitors, not consumers.”). It is interesting to note that this has not always been the case. In the early days of the discipline, English courts very clearly rejected the consumer protection rationale underpinning trademark infringement. In the late nineteenth century, for instance, the court in *Levy v. Walker* held that: “The Court interferes solely for the purpose of protecting the owner of a trade or business from a fraudulent invasion of that business by somebody else. It does not interfere to prevent the world outside from being misled into anything.” (1878) 10 Ch. D. 436, 438. See, discussing this early line of cases, Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 Notre Dame L. Rev. 1839, 1854-55 (2007).

⁸⁴ In Europe, for instance, and according to the EUIPO Grand Board of Appeal:

The purpose of Article 7(1)(f) EUTMR is . . . [to ensure] that the privileges of trade mark registration should not be granted in favour of signs that are contrary to public policy or to accepted principles of morality. The organs of government and public administration should not positively assist people who wish to further their business aims by means of trade marks that offend against certain basic values of civilised society.

The U.S. Court of Appeals for the Federal Circuit's recent decision in *Curtin* illustrates this vicarious protection of third-party interests.⁸⁵ The court affirmed the dismissal of a consumer's opposition to the registration of RAPUNZEL for dolls and toy figures. Because the grounds on which she relied—genericness, descriptiveness, and failure to function—concern commercial interests, the court held that only commercial actors are entitled to oppose registration on those grounds.⁸⁶ Consumer interests in such oppositions must, on this view, be protected through competitors' litigation efforts rather than by consumers themselves. The decision does not deny that consumer interests matter to the trademark system; it simply channels their protection through commercial parties with standing on those particular grounds. *Curtin* also leaves intact an important earlier line of authority: in *Ritchie*, the same court recognized consumer standing to oppose registration on disparagement grounds (now struck down from the Lanham Act).⁸⁷ The *Curtin* court distinguished *Ritchie* on the basis that the grounds at issue there—disparagement and reputational harm—were unrelated to the protection of any commercial interest, whereas *Curtin*'s were rooted in commercial interests.⁸⁸ What determines standing, in other words, is whether the ground for opposition is commercial or non-commercial: where the basis is commercial, standing is reserved to commercial parties; where it is not, consumers retain standing in their own right. The implication for the present argument is significant: U.S. trademark law already accepts that consumers' non-commercial interests—including, arguably, their expressive interests on the *Ritchie* logic—can warrant direct judicial protection. The typology proposed in this article identifies, and gives content to, the expressive interests that this opening implicitly accommodates.

With these considerations in mind, it is worth exploring what expressive interests courts should consider when hearing interaction cases, and how this will reshape the judicial inquiry. The analysis is best undertaken in relation to each of the three instances where marks and speech interact: infringement, registration, and brand restriction cases.

A. Infringement

In infringement litigation, the approach proposed here would require courts to look beyond the defendant's speech rights and

R 260/2021-G, Application of Matthias Zirnsack (COVIDIOT), ¶ 30 (May 16, 2024).

⁸⁵ *Curtin v. United Trademark Holdings, Inc.*, 137 F.4th 1359, 1369-70.

⁸⁶ *Id.* at 1370.

⁸⁷ *Id.* discussing *Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999).

⁸⁸ *Id.* at 1366-67.

consider the expressive interests of the plaintiff and consumers of branded goods alongside those of the defendant and consumers of goods bearing recoded marks. The aim is not to advocate a quantitative assessment whereby infringement decisions would turn on a numerical comparison of expressive users on either side. Such an approach would almost invariably favor plaintiffs on the strength of their larger customer base—a result at odds with the protection freedom of expression affords all expressive users, regardless of their numbers. The proposed (re)balancing instead makes three principal contributions.

1. Extending Speech Protection to Commercial Uses of Recoded Marks

Recognizing that the commercial use of recoded marks can serve the expressive interests of users beyond the defendant—in particular, consumers of goods bearing recoded marks—calls into question the prevailing treatment of such uses. On both sides of the Atlantic, courts have approached defendants’ speech claims by distinguishing between recoded uses that can trigger protection under freedom of expression and uses that do not.

In the United States, this distinction turns on whether the defendant has used the plaintiff’s recoded mark “as a trademark”—that is, to designate the source of its own goods or services. The Supreme Court recently reaffirmed this distinction in *Jack Daniel’s* across both likelihood of confusion and dilution analyses,⁸⁹ but the distinction itself has run through the case law since the early 1970s.⁹⁰ In doing so, the decision brought welcome clarity to this area of law, albeit at the expense of robust speech protection in infringement litigation: as decades of case law suggest, a finding that the First Amendment is not triggered in a recoding case usually leads to a finding of infringement, more often than not on dilution grounds.⁹¹ Lower courts are, indeed, already narrowing the

⁸⁹ *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 145 (2023).

⁹⁰ *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 414 (S.D.N.Y. 2002); *Charles Atlas, Ltd., v. DC Comics, Inc.*, 112 F. Supp. 2d 330, 336 (S.D.N.Y. 2000); *Planned Parenthood Fed’n of Am. Inc. v. Bucci*, 42 U.S.P.Q. 2d (BNA) 1430, 1440-41 (S.D.N.Y. 1997); *Yankee Publ’g Inc. v. News Am. Publ’g Inc.*, 809 F. Supp. 267, 276 (S.D.N.Y. 1992); *Punchbowl, Inc. v. AJ Press, Inc.*, 90 F.4th 1022, 1028-29 (9th Cir. 2024); *Hard Rock Cafe Licensing Corp. v. Pac. Graphics, Inc.*, 776 F. Supp. 1454, 1462 (W.D. Wash. 1991); *Schieffelin & Co. v. Jack Co. of Boca, Inc.*, 725 F. Supp. 1314, 1323-24 (S.D.N.Y. 1989); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402-03 (8th Cir. 1987); *Tetley, Inc. v. Topps Chewing Gum, Inc.*, 556 F. Supp. 785, 793 (E.D.N.Y. 1983); *Gucci Shops, Inc. v. R. H. Macy & Co., Inc.*, 446 F. Supp. 838, 839-40 (S.D.N.Y. 1977); *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1192-93 (E.D.N.Y. 1972).

⁹¹ *Schieffelin & Co. v. Jack Co. of Boca, Inc.*, 725 F. Supp. 1314, 1323-24 (S.D.N.Y. 1989); *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1192-93 (E.D.N.Y. 1972); *Hard Rock Cafe Licensing Corp. v. Pac. Graphics, Inc.*, 776 F. Supp. 1454, 1462-63 (W.D. Wash. 1991); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402-03 (8th Cir. 1987); *Gucci*

protection afforded to recoders whose uses are source-identifying in the wake of *Jack Daniel's*.⁹² The District Court of Arizona's recent decision on remand is illustrative: the court found that the defendant's parodic "Bad Spaniels" pet toy tarnished Jack Daniel's marks (the parody no longer shielded on First Amendment grounds), yet held that the very success of that parody made consumer confusion unlikely.⁹³

The European picture is more complex and considerably more uncertain. Two distinct problems can be identified, pulling in opposite directions. The first is a conceptual confusion surrounding the role of speech in infringement litigation. Some domestic courts have invoked freedom of expression as a shield in cases where there is no use in the course of trade, no use as a trademark, or no use in relation to goods or services.⁹⁴ In these cases, speech has no work to do, because trademark law is not triggered in the first place: the threshold requirements for infringement are simply not met.⁹⁵ Reliance on freedom of expression in this context therefore rests on a misconception, and it generates conceptual confusion about what speech is doing in the analysis. This problem is compounded by additional factors. The commercial character of a use is not always easy to determine. Some activities, such as those of artists, broadcasters, and political parties, can occupy a grey zone in which

Shops, Inc. v. R. H. Macy & Co., Inc., 446 F. Supp. 838, 840 (S.D.N.Y. 1977); *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812-13 (2d Cir. 1999); *Wendy's Int'l, Inc. v. Big Bite, Inc.*, 576 F. Supp. 816, 818-19 (S.D. Ohio 1983); *Parks v. LaFace Recs.*, 329 F.3d 437, 448-452 (6th Cir. 2003); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 733-35 (D. Minn. 1998); *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1440-41 (S.D.N.Y. 1997); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1400-01 (9th Cir. 1997); *Gen. Foods Corp. v. Mellis*, 203 U.S.P.Q. 261, 262 (S.D.N.Y. 1979); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205-06 (2d Cir. 1979).

⁹² See, notably, the recent decision of the Court of Appeals for the Ninth Circuit in *Punchbowl*, where the court withdrew and reversed its previous decision shielding defendant from infringement on free speech grounds. *Punchbowl, Inc. v. AJ Press, Inc.*, 90 F.4th 1022, 1031 (9th Cir. 2024). See also *VIP Prods. LLC v. Jack Daniel's Props., Inc.*, 2025 WL 275909 (D. Ariz. Jan. 23, 2025).

⁹³ *VIP Prods. LLC v. Jack Daniel's Props., Inc.*, 2025 WL 275909 (D. Ariz. Jan. 23, 2025).

⁹⁴ *Cour d'Appel [CA] [regional court of appeal] Paris*, 4 ch., Nov. 16, 2005, 04/12417 (Fr.) (for an English translation, see *Esso Plc v. Greenpeace France*, [2006] 53 E.T.M.R. 665, 670) (shielding defendant's unauthorized recoded use on grounds that the defendant "has [. . .] kept its activities within the limits of freedom of expression, in such a way that the trade mark infringement suit brought against it [. . .] must be rejected [as it did] not manifestly seek to promote the marketing of products or services . . . for the profit of [defendant], but rather fall within purely controversial use which is alien to business life and competition between commercial enterprises"); *Cour d'Appel [CA] Paris*, 14 ch., Feb. 26, 2003, 02/16307 (Fr.) (for an English translation, see *Association Greenpeace France v. SA Société ESSO*, [2003] E.T.M.R. 66).

⁹⁵ We do find precedents of courts correctly applying these threshold requirements to infringement claims: *Kammergericht Hamburg [KG] [Berlin Court of Appeal]* Aug. 20, 1996 5 U 4311/96 (1996) (Ger.) (for an English translation, see *Alles wird teurer*, [1999] E.T.M.R. 49).

the commercial character of the use is genuinely contestable.⁹⁶ The threshold has also been eroded by the CJEU's decision in *L'Oréal v. Bellure*, which extended the protection of reputed marks beyond the origin function to their quality, investment, advertising, and communication functions,⁹⁷ opening the door to infringement even absent use as a trademark or in relation to goods or services.⁹⁸ And in some jurisdictions—most notably the Benelux—trademark statutes expressly provide that, for dilution claims, the use of the possibly infringing sign need not be for the purpose of distinguishing goods or services.⁹⁹ This explains the two Belgian decisions in which the use of a mark by a political party has given rise to a dilution action, both of which should be understood as departures from the rule rather than as instances of it.¹⁰⁰ This includes notably the pending reference for a preliminary ruling before the CJEU in *IKEA*, where the Flemish nationalist party *Vlaams Belang* used *IKEA*'s marks in a political campaign branded “*IKEA-PLAN—Immigratie Kan Echt Anders*” (“*IKEA plan—Immigration really can be different*”) to advance an unrelated message on immigration policy.¹⁰¹ The use was plainly non-commercial and, on the orthodox approach, would fall outside the reach of trademark law altogether.

The second problem runs in the opposite direction: in many cases involving genuinely commercial uses, freedom of expression is not taken into account at all or,¹⁰² where it is, its protective reach is very

⁹⁶ *Les Guignols de l'Info*, CA Reims, Feb. 9, 1999, D., 1999, p. 449, Obs B. Edelman (Fr.); *International-Compagnia Generale Distribuzione s.p.a. v. Zorro Prods. Inc.* (No. 38165/2022) (It.); *Unilever Plc v. Griffin* [2010] EWHC 899 (Ch) (Eng.).

⁹⁷ Case C-487/07, *L'Oréal SA v. Bellure NV*, ECLI:EU:C:2009:378 (June 18, 2009).

⁹⁸ *International-Compagnia Generale Distribuzione s.p.a. v. Zorro Prods. Inc.* (No. 38165/2022) ¶ 5.6 (It.) (“In the matter of trade marks, [. . .] the exploitation of another's trade mark, if notorious, is to be considered prohibited when the use of the sign without due cause, carried out in economic activity, allows undue advantage to be gained from the distinctive character or renown of the trade mark or causes harm to them, regardless of whether the trade mark is used to distinguish the products or services of the author of the use, as can occur in the case of the parodic representation of the trade mark in question.”).

⁹⁹ Art. 2.20(1)(d) of the Benelux Convention on Intellectual Property (Trade Marks and Designs).

¹⁰⁰ Case C-298/23, *Inter IKEA Systems BV v. Algemeen Vlaams Belang VZW*, EU:C:2025:886, Opinion of AG Szpunar; *Bpost NV v. Algemeen Vlaams Belang VZW et feitelijke vereniging Vlaams Belang*, Judgment of the President of the Dutch-speaking Business Court of Brussels, June 22, 2020 (Bel.).

¹⁰¹ C-298/23, *Inter IKEA Systems BV v. Vlaams Belang*. For an in-depth discussion of the case, see Elena Izyumenko, *Trademark “Law and Political Expression: The Case of Inter IKEA Systems BV v. Vlaams Belang and Beyond*, Int'l Rev. Intell. Prop. & Competition L. (2026), <https://doi.org/10.1007/s40319-026-01719-4> (last visited: May 22, 2026).

¹⁰² Cour d'Appel [CA] [regional court of appeal] Paris, 5 ch., Dec. 11, 2015, 14/32109 (Fr.) (“as regards the right to parody and freedom of expression invoked by the appellants, . . . trademark law . . . do[es] not recognize [an] exception to . . . [plaintiffs'] monopoly [—unlike copyright law]. Furthermore, it cannot be disputed that the litigious signs are used [by appellant] in business life and serve, not for commentary purposes . . . , but to

limited.¹⁰³ This sometimes follows from a court's conclusion that the defendant's expressive use is unsuccessful and therefore undeserving of speech protection—a determination that has itself bred inconsistency, as courts adopt differing thresholds for what counts as expressive.¹⁰⁴ As Jacques' empirical study demonstrates, courts become markedly more cautious about prioritizing freedom of expression as soon as the use has a commercial dimension, even where the defendant does not compete with the rightsholder.¹⁰⁵ This is the inverse of the first problem, and it is the more troubling of the two. It is in the commercial context—where trademark law is triggered—that the constitutionally mandated protection of freedom of expression ought to permeate the infringement analysis and inform a genuine balancing of the interests at stake. Where speech is not engaged in these cases, courts find themselves in a position analogous to that of the U.S. courts after *Jack Daniel's*, in which the expressive intent underlying the defendant's recoded use is reduced to one factor among many.¹⁰⁶ This is an outcome to be avoided. As we have seen, marks are increasingly deployed expressively by a wide range of users, and an approach that withholds meaningful speech protection from commercial recoded uses risks chilling valuable forms of expression. Tellingly, clear examples of European courts protecting a genuinely commercial recoded use on free speech grounds are difficult to find.¹⁰⁷ Germany is the notable exception. In *Lila Postkarte*, the defendant produced and sold satirical postcards reproducing the distinctive lilac color and visual idiom of Milka's chocolate packaging alongside a satirical verse playing on the

promote products marketed by the appellant companies, so that the alleged facts fall within the scope of the exclusive right conferred by the trademarks owned by the appellee." (author's translation)).

¹⁰³ Rechtbank van Koophandel Brussel (Brussels Commercial Court), *Moët Hennessy Champagne Services v. BVBA CEDRIC.ART*, No. A/17/02627, Apr. 12, 2018 (Belgium) (the court easily found the sale of T-shirts bearing the recoded mark to infringe the plaintiff's DOM PÉRIGNON marks, even if their use on paintings called for a balancing exercise under due cause that ought to factor in the defendant's freedom of expression, as mandated by the Benelux Court of Justice in the same case; see *Moët Hennessy Champagne Service (MHCS) v. Cedric Art*, No. A 2018/1/8, Oct. 14, 2019); *Der Oberste Gerichtshof [OGH] [Supreme Court of Justice of the Republic of Austria]*, Sept. 22, 2009, 17Ob15/09v (Austria).

¹⁰⁴ *Oberlandesgericht Hamburg [OLG] [Hamburg Higher Regional Court]* Aug. 9, 2010 [GRUR-RR] 382 (2010) (Ger); *Ate My Heart, Inc. v. Mind Candy Ltd.* [2011] EWHC 2741 (Ch) (Eng.); *Miss World Ltd. v. Channel 4 Television Corp.* [2007] EWHC 982 (Pat) (Eng.)

¹⁰⁵ Jacques, *supra* note 4, at 16.

¹⁰⁶ *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 145 (2023).

¹⁰⁷ Agreeing with this claim, Jacques's empirical study of parody cases across Europe found that "when a trade mark parody is used on merchandise and gifts, such as T-shirts, stickers, tote bags, badges, mugs, and other message-bearing items [. . .] only cases where the trade mark parody took place in a context of a satirical show were given favourable outcome for parodists." Jacques, *supra* note 4, at 16 and note 75.

brand's mountain-pasture imagery.¹⁰⁸ The German Federal Court of Justice held that the use was protected by freedom of artistic expression and did not infringe Milka's trademark rights, notwithstanding the commercial sale of the postcards—and lower courts have since followed this precedent in comparable cases.¹⁰⁹ Beyond Germany, the examples are scattered and thin¹¹⁰ and tend to depend on additional features that take the use outside the ordinary commercial case, as with *Nadia Plesner* (which arose in the context of EU design rights) and *Miffy* (where the defendant's use was not as a trademark but was nonetheless captured by the Benelux Convention's robust protection against dilution), both in the Netherlands.¹¹¹ That such examples are so scarce, and that the clearest of them is now two decades old, is itself revealing. It suggests that European courts, when confronted with a recoded use that crosses the commercial threshold, have largely failed to give freedom of expression the weight it is due—precisely in the category of cases where the balancing of fundamental rights matters most.

Taken together, these factors give rise to a rather complex picture on both sides of the Atlantic. Yet for all the doctrinal disorder, the practical effect is much the same: a commercial recoded use will rarely attract robust speech protection, and decision-makers regularly side with plaintiffs once they find such a use confusing, dilutive, or both. The framework proposed here unsettles that result at its root. If commercial uses of recoded marks can themselves further the expressive interests of both defendants and consumers of goods bearing recoded marks, the categorical exclusion of such uses from the protection of free speech can no longer be sustained. The commercial character of a recoded use thus ceases to be a threshold that forecloses speech protection and becomes merely one feature of a richer inquiry into the expressive stakes on both sides.

¹⁰⁸ Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 7, 2005, NJW 2856 (2005) (Ger.) (for an English translation, see *Violet Postcard*, 38 Int'l Rev. of Intell. Prop. & Competition L. 119 (2007)).

¹⁰⁹ Oberlandesgericht Hamburg [OLG] [Hamburg Higher Regional Court], Jan. 5, 2006, GRUR-RR 231 (2006) (Ger.).

¹¹⁰ *Les Guignols de l'Info*, CA Reims, Feb. 9, 1999, D., 1999, p. 449, Obs B. Edelman (Fr.); Rb.'s-Gravenhage, May 4, 2011, NJF 2011, 264 (Nadia Plesner Joensen/Louis Vuitton Malletier SA) (Neth.); Gerechtshof Amsterdam, Sept. 13, 2011, IES 2012, 15 m.nt. Herman MH Speyart (Mercis BV/Punt.nl BV) (Neth.).

¹¹¹ Respectively: Rb.'s-Gravenhage, May 4, 2011, NJF 2011, 264 (Nadia Plesner Joensen/Louis Vuitton Malletier SA) (Neth.); Gerechtshof Amsterdam, Sept. 13, 2011, IES 2012, 15 m.nt. Herman MH Speyart (Mercis BV/Punt.nl BV) (Neth.).

2. Speech vs. Speech: A Commensurable (Re)Balancing Exercise

Pitting the expressive interests of rightsholders and consumers of branded goods against those of defendants and consumers of goods bearing recoded marks renders the (re)balancing exercise commensurable. This goes to the core of the contribution advanced here. A common objection to free speech analysis in trademark cases is that it requires courts to weigh apples against oranges: the economic and proprietary interests protected by trademark law on one side, and the speech interests asserted by defendants on the other. The resulting analysis is doctrinally awkward because it imports constitutional reasoning into what is, at its core, a private law dispute. It also tends toward reductionist outcomes, in which defendants' expressive interests are either too easily dismissed once their use is deemed commercial (at odds, as we have seen, with the protection that free speech affords defendants and consumers of goods bearing recoded marks), or automatically privileged once their use is deemed expressive (which fails to safeguard the expressive interests of the rightsholder and consumers of branded goods).¹¹² The latter approach has been particularly prevalent in the United States, both in the application of the *Rogers* test to likelihood of confusion inquiries and in the noncommercial-use defense to dilution claims—though both have been considerably narrowed in the wake of *Jack Daniel's*.¹¹³

Recognizing the expressive function of trademarks—and the fact that both parties in an infringement dispute can claim expressive stakes in the mark, both directly and vicariously through the other expressive users they represent—corrects this asymmetry. The economic content of trademark rights, on this view, is itself a form of speech: it secures the rightsholder's ability to communicate the meanings the mark has come to embody. Spence has argued, in a related vein, that the mark is best understood as both expression and property—the property right protecting the rightsholder's expressive stake in the mark.¹¹⁴ The framework proposed here builds on that insight, extending it from the rightsholder to the wider range of expressive users identified. The exercise then

¹¹² *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989); *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 906 (9th Cir. 2002); *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1440 (S.D.N.Y. 1997); *Yankee Publ'g Inc. v. News Am. Publ'g Inc.*, 809 F. Supp. 267, 275-76 (S.D.N.Y. 1992); Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 7, 2005, NJW 2856 (2005) (Ger.) (for an English translation, see *Violet Postcard*, 38 Int'l Rev. Intell. Prop. & Competition L. 119 (2007)); Oberlandesgericht Hamburg [OLG] [Hamburg Higher Regional Court] Jan. 5, 2006, GRUR-RR 231 (2006) (Ger.).

¹¹³ *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023).

¹¹⁴ Spence, *supra* note 25.

becomes one of speech against speech, conducted within trademark law itself.

3. Proposing a Theory of (Expressive) Harm

The commensurability of the (re)balancing exercise proposed here is what allows the articulation of a doctrinal theory of harm. Once the inquiry is reframed as speech against speech, the question in any given case becomes whether the defendant's unauthorized use is liable to cause *expressive harm* to the mark—that is, to fragment its expressive function so severely as to impair its capacity to convey the complex meanings the rightsholder has cultivated and that consumers of branded goods rely on for self-expression.¹¹⁵ This imposes a high evidentiary burden on plaintiffs and will rarely be satisfied where the defendant's recoded use is genuinely expressive in nature. At the same time, it gives courts a doctrinal test that can be applied consistently across recoding disputes, without invoking constitutional balancing in every case.

One caveat is in order. Beyond harm to the expressive function of marks, harm to the source-identifying function remains relevant to the likelihood of confusion analysis. The reconceptualization proposed here assists rather than displaces that analysis: where there is no harm to the expressive function, the protection afforded by the source-identifying function should be narrowly construed. Even then, the expressive content of the defendant's use bears on the confusion inquiry. As the U.S. Supreme Court made clear in *Jack Daniel's*, “a trademark's expressive message—particularly a parodic one [. . .]—may properly figure in assessing the likelihood of confusion.”¹¹⁶ Courts should accordingly find infringement only where the defendant's unauthorized use is evidently likely to confuse consumers—a finding rarely made, the Supreme Court observed, where the parody is successful, since “a parody is not often likely to create confusion.”¹¹⁷

The operation of this theory of harm is best illustrated through a worked example. The dispute in *Jack Daniel's* concerns the defendant's unauthorized use of the “Bad Spaniels” dog toy, which mimics the shape, label, and trade dress of a JACK DANIEL'S whiskey bottle while substituting scatological references (“The Old

¹¹⁵ In the European context, the expressive function of trademarks as defined here would allow giving content to the communication function provided for by the CJEU since its landmark decision in Case C-487/07, *L'Oréal SA v. Bellure NV*, ECLI:EU:C:2009:378 (June 18, 2009), which remains the least explored function to date—the court has yet to define it and provide a theory of harm. I have explored the potential for the communication function to be conceived of as a mark's ability to convey expressive meaning in further detail elsewhere, including an exploration of the advantages that would derive from such an interpretation. Fernandez-Mora, *supra* note 2, at 1400-01.

¹¹⁶ *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 161 (2023).

¹¹⁷ *Id.* at 161 (emphasis in the original).

No. 2 On Your Tennessee Carpet” replaces “Old No. 7 Tennessee Sour Mash Whiskey”; “43% poo by vol.” and “100% smelly” replace “40% alc. by vol. (80 proof”).¹¹⁸ The dispute remains live as the appeal continues to work its way through the federal courts, making this hypothetical all the more relevant.

The expressive harm test proposed would require the court to undertake a two-stage inquiry. The first stage involves identifying the expressive content of the JACK DANIEL’S mark, which carries a rich set of meanings beyond source-identification: Tennessee whiskey heritage, masculinity, rugged authenticity, and a particular kind of Americana. Its owner has cultivated these meanings over more than a century and a half, and consumers of JACK DANIEL’S-branded whiskey draw on them to express their adherence to the values and lifestyle the mark embodies. The second stage asks whether the defendant’s recoded use causes a substantial loss of the mark’s communicative capacity through the severe fragmentation of those meanings. On the facts of *Jack Daniel’s*, the answer is almost certainly no. The defendant’s toy is a single product in a niche market—squeaky dog toys—sold at limited volumes relative to the global scale of JACK DANIEL’S whiskey sales. The recoded use is unlikely to displace or fragment the mark’s expressive content in any meaningful or durable way: consumers encountering the parody remain perfectly able to identify the mark with the meanings its rightsholder has long cultivated. No finding of expressive harm could be sustained on these facts, and the case would not be resolved in the plaintiff’s favor on that basis.

As we have seen, harm to the source-identifying function of the mark remains relevant to the likelihood of confusion analysis. The heavy comedic framing of the “Bad Spaniels” toy makes a finding of confusion unlikely—which is, as noted above, precisely the conclusion the District Court of Arizona reached on remand.¹¹⁹

The framework advanced in this article would also resolve cases like *IKEA* differently from the approach proposed by Advocate General Szpunar in his recent opinion.¹²⁰ The AG accepted that freedom of expression is relevant to the “due cause” analysis under Article 9(2)(c) EUTMR, but only where the expressive use targets the trademark proprietor or its goods and services—a restriction that would exclude many of the most expressively rich recoded uses, including those at issue in *Plesner* and *Lila Postkarte*.¹²¹ The

¹¹⁸ *Id.*

¹¹⁹ *VIP Prods. LLC v. Jack Daniel’s Props., Inc.*, 2025 WL 275909 (D. Ariz. Jan. 23, 2025).

¹²⁰ Case C-298/23, *Inter IKEA Systems BV v. Algemeen Vlaams Belang VZW*, EU:C:2025:886, Opinion of AG Szpunar. For an in-depth discussion of this decision, see Izyumenko, *supra* note 101.

¹²¹ *Rb.’s-Gravenhage*, May 4, 2011, NJF 2011, 264 (Nadia Plesner Joensen/Louis Vuitton Malletier SA) (Neth.); *Bundesgerichtshof [BGH]* [Federal Court of Justice] Apr. 7, 2005,

expressive harm test asks a different question: not whether the expression targets the rightsholder, but whether the recoded use is liable to cause expressive harm to the mark. Methodologically, however, the AG's opinion is broadly aligned with the doctrinal emphasis advocated here: it treats freedom of expression as an internal component of the trademark analysis (as part of the "due cause" inquiry in *IKEA*), rather than as an external constitutional override.

B. Registration

In the registration context, the expressive interests of the unsuccessful applicant would be best assessed alongside those of the other categories of expressive users identified above—especially those of potential consumers of branded goods and the broader public. After all, the potential for signs to journey from source-signaling devices to expressive artifacts that a wide range of individuals can draw on for self-expressive purposes depends to a large extent on their ability to access the register in the first place (i.e., to be used by one trader on an exclusive basis). This is particularly true in Europe, where protection for non-registered marks is limited.¹²² The proposed approach would, thus, require a rebalancing exercise when assessing refusals of registration whereby the interests of the wider population in a marketplace free of offensive signs must be pitted against the expressive interests of a wide range of individuals—not merely those of the unsuccessful applicant, as has been the case to date.

Admittedly, the impact of this shift will be limited in most instances. In the United States, and in the wake of the Supreme Court decisions in *Tam* and *Brunetti*,¹²³ it is highly unlikely that the suggested line of reasoning will be relevant in the future.¹²⁴ This is regrettable, however. The Supreme Court's categorical approach to the First Amendment in these cases prevents the government from differentiating between socially beneficial and socially harmful rationales for seeking registration of immoral, disparaging, or scandalous marks. *Tam* is a good example of a socially beneficial trademark application insofar as the dance-rock band's justification

NJW, 2856 (2005) (Ger.) (for an English translation, see *Violet Postcard*, 38 Int'l Rev. Intell. Prop. & Competition L. 119 (2007)).

¹²² I explore the link between exclusive trademark use and the development of expressive meanings in signs in further detail below; see text to footnotes 137-141 *infra*.

¹²³ *Matal v. Tam*, 582 U.S. 218 (2017); *Iancu v. Brunetti*, 588 U.S. 388 (2019).

¹²⁴ Some authors have argued that, after *Tam* and *Brunetti*, the last frontier in challenges to the validity of refusals of registration on First Amendment grounds lies in the systematic rejection by the U.S. Patent and Trademark Office ("USPTO") of applied-for marks in relation to goods the sale of which is forbidden at federal level (but allowed in certain states, notably cannabis products). See Robert L. Greenberg, *Cannabis Trademarks and the First Amendment*, 51 Tex. Tech. L. Rev. 525, 556 (2020).

for seeking registration of the racial slur THE SLANTS was “to ‘reclaim’ and ‘take ownership’ of stereotypes about people of Asian ethnicity.”¹²⁵ In sharp contrast, the unsuccessful request, by members of the affected racial minority, to cancel the disparaging “REDSKINS” trademarks owned by the Washington-based football team in *Pro-Football* is illustrative of a socially harmful registration.¹²⁶ The decision not to remove these disparaging marks from the register was the direct—and regrettable—consequence of the Supreme Court’s unconstitutionality finding in *Tam*. Several authors working at the intersection of intellectual property rights and social justice have also voiced their criticisms of the Supreme Court’s categorical approach to Section 2(a) of the Lanham Act, arguing that “[a]ppplied in such a formally symmetrical fashion, the First Amendment not only protects minorities eager to engage in controversial expression (*Tam*), but protects market-dominant actors as well from the consequences of their socially harmful expression (*Pro-Football*).”¹²⁷ The Court’s blanket approach to the interaction between trademarks and speech in the registration context thus fails to acknowledge that minority interests will, in some instances, be best protected through the grant of registration (e.g., *Tam*) while, in others, they will be best protected precisely through the refusal to register a mark (e.g., *Pro-Football*). The reconceptualization advanced here is particularly well suited to addressing the asymmetries that beset the U.S. register, since it ensures that decision-makers take account of the diversity of expressive interests involved in trademark use. As the following discussion explores, it makes it possible to infuse proportionality

¹²⁵ *Matal v. Tam*, 582 U.S. 218, 228 (2017).

¹²⁶ *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d (BNA) 1080 (T.T.A.B. 2014); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015), vacated in light of *Tam* in *Pro-Football, Inc. v. Blackhorse*, 709 F. App’x 182 (4th Cir. 2018).

¹²⁷ Chon and Chang, *supra* note 49, at 66. It is worth quoting another excerpt from their work, where they explore the implications of this asymmetry in further detail:

Compare Blackhorse’s premise that Section 2(a) of the Lanham Act was a legitimate regulation of speech providing an important legal basis to recognize the harmfulness of Pro-Football’s marks to her and the communities she represented with Tam’s ardent perspective that the government’s decision to deny federal registration of his mark violated his speech rights. Both Blackhorse and Tam were plausibly fighting for the rights of minority groups to exert some form of representational sovereignty, that is, to control the use of racially derogatory symbols directed at their communities and to place power back in the hands of those people who have traditionally been harmed by the racist language in question. These competing narratives of freedom from harm raise complex questions of how antiracist activists and scholars engage in coalitional strategies that speak back against dominant frameworks. They also bring into question the role of IP legal doctrines in framing these challenges, especially when the affected stakeholders may disagree on strategies.

Id. at 58 (citations omitted). See also Fandiño, *supra* note 49.

into the registrability analysis—in line with Justice Breyer’s separate opinion in *Brunetti*.¹²⁸

In Europe, equivalent provisions preventing the registration of signs that are immoral or contrary to public policy remain in force. They have survived where their U.S. analogues did not because the European Convention on Human Rights (“ECHR”) and the EU Charter afford public authorities a broader margin of appreciation to restrict freedom of expression than the First Amendment allows. In its landmark decision in *Constantin Film Produktion*, however, the CJEU admitted the sign FACK JU GÖHTE into the register, holding that “freedom of expression . . . must . . . be taken into account” when applying the public policy and morality exclusions.¹²⁹ This led the Court away from an abstract assessment of morality and toward an evidence-based inquiry into whether the applied-for sign is genuinely liable to outrage the relevant public.¹³⁰ The EUIPO’s Boards of Appeal, however, appear to be failing to apply that mandate with the required rigor.¹³¹

The proposed reconceptualization can, however, be particularly significant where applicants seek to register an offensive sign as a trademark to reclaim its meaning through ownership and sustained exclusive use in the course of trade.¹³² Consumers of branded goods

¹²⁸ *Iancu v. Brunetti*, 588 U.S. 388, 401-405 (2019) (Breyer, J., concurring and dissenting) (“In short, the trademark statute does not clearly fit within any of the existing outcome-determinative categories. Why, then, should we rigidly adhere to these categories? Rather than puzzling over categorization, I believe we should focus on the interests the First Amendment protects and ask a more basic proportionality question: Does ‘the regulation at issue wor[k] harm to First Amendment interests that is disproportionate in light of the relevant regulatory objectives?’”) (quoting *Reed v. Town of Gilbert*, 576 U.S. 155, 179 (2015) (Opinion of Breyer, J.)).

¹²⁹ Case C-240/18, *Constantin Film Produktion GmbH (FACK JU GÖHTE) v. EUIPO*, ECLI:EU:C:2020:118, ¶ 56 (Feb. 27, 2020).

¹³⁰ *Id.* at ¶ 43.

¹³¹ R 260/2021-G, Application of Matthias Zirnsack (COVIDIOT), ¶ 91 (May 16, 2024) (the Grand Board rejected the applicant’s free-speech challenge on grounds that the sign “trivialises the serious harm done by [the COVID] disease to the fundamental values of the European Union [and is] therefore *likely* to shock or offend . . . any person who . . . encounters that mark and has average sensitivity and tolerance thresholds.” (emphasis added)). See also R 1364/2022-5, Application of Escobar Inc. (PABLO ESCOBAR) (Feb. 21, 2023). Compare R0006/2026-5, Application of Katjes Fassin GmbH + Co. KG (TOUCH YOUR BOOBS) (May 7, 2026).

¹³² I explored this argument briefly in Fernandez-Mora, *supra* note 4, at 290. The role that the protection afforded under freedom of expression ought to play in meaning-reclaiming processes in trademark registration has also been discussed by Ilanah Fhima, *Trade Mark Law and Diversity*, in Research Agendas in Trade Mark Law (Anke Moerland & Ilanah Fhima eds., forthcoming), <https://ssrn.com/abstract=5306942> (last visited Apr. 29, 2026); Ilanah Fhima, *Reappropriation of Slurs and the Implications for Trade Mark Registration: A Policy Proposal*, <https://www.ucl.ac.uk/laws/ibil/research/trade-marks-and-social-justice-series/reappropriation-slurs-and-implications-trade-mark-registration> (last visited Apr. 20, 2026); Izyumenko, *supra* note 49, at 898-900. See also, for empirical studies exploring the rates of meaning-reclaiming driven registrations of disparaging trademarks before the USPTO both before and after the decision of the

who wish to contribute to the rightsholder's reclaiming efforts would be able to do so through their expressive uses of the mark. Furthermore, the public could also contribute to, and benefit from, the shift in meaning to which registration (and subsequent exclusive use) of an offensive trademark can lead, notably through the progressive proliferation of non-offensive, inclusive signs.

The reappropriation of meaning in offensive signs is, however, an aspect of registration (and use) that trademark law has thus far not been very receptive to.¹³³ This was recently acknowledged by the EUIPO Grand Board of Appeal in its decision in *Application of Turner Broadcasting System Europe Ltd.*, concerning the unsuccessful attempt to register the mark MARICON PERDIDO ("hopeless faggot" in Spanish), where it:

[N]ote[d] that reappropriation, in the sense that a term which once was offensive could be cured of its offensiveness by the target group filing the word in question as a trade mark, is a notion that is, at present, untested in EU trade mark law. Reappropriation through trade mark registration by the target group disparaged by the particular word or words at issue, is a concept that has come from the US. . . . Both trade marks ["DYKES ON BIKES" and "THE SLANTS"] ultimately obtained registration based on the overriding principle of freedom of speech, enshrined in the US Constitution¹³⁴

Unfortunately, the Grand Board failed to explore the role that trademark registration can (and should) play in reappropriation to any meaningful extent. Instead, it went on to circumscribe its assessment of registrability to whether, on the evidence available, the offensive meaning of the applied-for sign had *already been reappropriated* within Spanish society.¹³⁵ In so doing, the Grand Board missed an opportunity to explore whether the *potential for reappropriation through* trademark registration should be factored in when assessing registrability.

Supreme Court in *Matal v. Tam*, Vicki Huang, *Trademarks, Race and Slur-Appropriation: An Inter-Disciplinary and Empirical Study*, 2021 U. Ill. L. Rev. 1605 (2021); Michael P. Goodyear, *Queer Trademarks*, 2024 U. Ill. L. Rev. 163 (2024).

¹³³ This is true on both sides of the Atlantic, even if more prominently so in European trademark law. See, agreeing with this observation: Katyal, *supra* note 4, at 821 ("[W]hen it comes to reappropriated symbols or terms, trademark law has often provided a far less protective response for such semiotic disobedience than one might imagine."); Fhima, *Trade Mark Law and Diversity*, *supra* note 132, at 19 ("the [EUIPO] Grand Board [of Appeal] appears to doubt reappropriation as a concept at all").

¹³⁴ R 2307/2020-G, Application of Turner Broadcasting System Europe Ltd. (MARICON PERDIDO), ¶ 54-55 (Nov. 25, 2024).

¹³⁵ *Id.* at ¶ 69-70.

This should not come as a surprise. Arguments advancing the expressive interests of trademark applicants on speech grounds are often dismissed on the basis that the applied-for sign remains available to the unsuccessful applicant (including as a badge of origin to identify its goods) and, by extension, to consumers of those goods.¹³⁶ On this view, the applicant remains free to pursue even uses that seek to reclaim the meaning of an offensive sign, through its own marketing efforts and through the consumption choices of consumers of the (non-registered) sign. This argument is, however, too simplistic. It overlooks the fundamental role that registration and ownership can play in furthering the expressive interests of rightsholders, and in turn of consumers—in three respects.

First, a refusal of registration encumbers the applicant's ability to use the sign exclusively in relation to its goods (as we saw earlier, unregistered marks enjoy very limited protection in Europe, so a refusal effectively denies the applicant exclusive use of the sign).¹³⁷ Exclusivity is, in turn, fundamental to the communicative work a mark performs—most importantly, its capacity to signal commercial origin clearly.¹³⁸ Were several traders to brand competing goods with the same sign, consumers would likely be confused as to their source. Second, the applicant's advertising strategy would be severely impaired by the loss of exclusivity. Promoting a mark across advertising campaigns and other marketing channels is often so costly that applicants may have little incentive to invest in a refused sign if competitors remain free to use it. As the EUIPO Grand Board of Appeal observed in *Jebaraj Kenneth*:

While it is true to say that a refusal to register does not amount to a gross intrusion on the right of freedom of expression, since traders can still use trade marks without registering them, it does represent a restriction on freedom of expression in the sense that businesses may be unwilling to invest in large-scale promotional campaigns for trade marks which do not enjoy protection through registration

¹³⁶ This has been noted by, inter alia, the EUIPO Grand Board of Appeal in R 2307/2020-G, Application of Turner Broadcasting System Europe Ltd. (MARICON PERDIDO), ¶ 84 (Nov. 25, 2024) ("it is not necessary to register a sign for it to be used for commercial purposes") and in R 495/2005-G, Application of Jebaraj Kenneth (SCREW YOU), ¶ 13 (July 6, 2006).

¹³⁷ The expressive constraints imposed on applicants by refusals of registration are more stringent in Europe than in the United States, where common law marks (i.e., unregistered) are deserving of a substantial degree of protection as a result of use.

¹³⁸ There is wide support for this proposition in the literature. See, e.g., Dreyfuss, *supra* note 2, at 400 ("[E]xclusivity is essential to an efficient marketplace. Without an unambiguous signal for goods, consumers would have no way to apply their past experience to future purchasing decisions."); Gangjee, *supra* note 2, at 29 ("Granting exclusive rights to control the use of a mark preserves its ability to reliably signal origin. This ability reduces consumer search costs and protects producer goodwill.").

because the Office regards them as immoral or offensive in the eyes of the public.¹³⁹

Third, without exclusive use, the applicant cannot build a brand image around the sign.¹⁴⁰ The sign will not evolve over time in the way that would allow it to acquire and convey the further meanings, expressive and otherwise, that the applicant wishes to communicate in the marketplace, including those that seek to reclaim its original offensive sense.¹⁴¹

To sum up, so long as traders cannot use a sign exclusively, they are unlikely to make the investments required to shift its social perception. Processes of reclaiming the meaning of morally objectionable signs should therefore be incentivized through registration.¹⁴² Where applicants (and consumers of branded goods) can reasonably be expected to use morally objectionable signs in socially valuable ways, it is difficult to see how refusals to grant trademark registration could comply with free speech principles. Society would benefit if free speech guarantees were implemented with a view to enlarging the stock of signs that conform to democratic principles—signs on which the public can then draw in their reclaimed form. MARICON PERDIDO is a good example of a slur ripe for reappropriation by the Spanish-speaking LGBTQ+ community in the EU, and one where, had the application succeeded, exclusive use through registration could have

¹³⁹ R 495/2005-G, Application of Jebaraj Kenneth (SCREW YOU), ¶ 15 (July 6, 2006). *See*, in similar terms, Bonadio, *supra* note 49, at 56; Teresa Scassa, *Antisocial Trademarks*, 103 Trademark Rep. 1172, 1190-92 (2013). By contrast, Kapff, Griffiths, and Ricolfi have argued that free speech can hardly be said to be curtailed as a result of refusals of registration, since applicants are still able to market their goods using the contentious sign. Philipp von Kapff, *Fundamental Rights in the Practice of the European Trade Mark and Designs Office (OHIM)*, in Research Handbook on Human Rights & Intellectual Property, 303 (Christophe Geiger ed., 2015); Jonathan Griffiths, *Is there a right to an immoral mark?*, in *Intellectual Property & Human Rights*, 448-49 (Paul Torremans ed., 3d ed. 2015); Ricolfi, *supra* note 25, at 471.

¹⁴⁰ According to Dreyfuss: “Th[e] absence [of exclusivity in the use of a mark] would reduce suppliers’ incentives to invest in quality-producing and brand-differentiating activities as the benefits of the investment could not be captured through repeat sales to loyal customers.” Dreyfuss, *supra* note 2, at 400-01.

¹⁴¹ I have explored in further detail the rationale for invoking speech protection in refusals of registration elsewhere: Alvaro Fernandez-Mora, *supra* note 4, at 284-85.

¹⁴² As the following discussion acknowledges, this proposition faces substantial hurdles in Europe, where offices have not been receptive to meaning-reclaiming arguments via trademark registration. An early example includes the decision of the EUIPO BoA in *FICKEN*: “[w]ords or acts which are contrary to the accepted principles of morality today can also be morally acceptable tomorrow. But such changes should not be promoted by trade mark law.” R 493/2012-1, Application of EFAG Trade Mark Company GmbH & Co. KG (FICKEN), ¶ 28 (Oct. 18, 2012) (EUIPO Board of Appeal). Authors have also been critical of the views advanced here. *See, e.g.*, Fady J.G. Aoun, *The Belated Awakening of the Public Sphere to Racist Branding and Racist Stereotypes in Trademarks*, 61 IDEA 545, at 561 (2021) (“I remain unconvinced that reclamation require[s] registration.”).

contributed significantly to the reclamation of its meaning. This argument echoes the one advanced by the appellant in *Square Enix*, whose speech-based challenge rested, inter alia, on the contention that the EUIPO's refusal to register the sign MECHANICAL APARTHEID would prevent it "from commenting on (the abhorrent policy of) racial segregation in the context of its work"—a fundamental form of reclaiming a sign's meaning.¹⁴³ The Board of Appeal, unfortunately, failed to address this claim.

In any event, and judging from the many cases in which decision-makers have given little weight to the way the applicant intends to use the sign, it is difficult to see how the meaning-reclaiming argument proposed here could ever be successful. For instance, the General Court has held that the assessment of the absolute grounds for refusal contained in Article 7(1) EUTMR (including the public policy and morality bars) must be undertaken on the basis of "the intrinsic qualities of the mark applied for and not [of] circumstances relating to the conduct of the person applying for the trade mark."¹⁴⁴ The EUIPO has consistently followed this finding.¹⁴⁵ In concluding that MARICON PERDIDO had not been successfully reclaimed by the disparaged group in Spain at the time of application, the Grand Board of Appeal made it clear that:

The intentions of the applicant have no bearing on the outcome of the case. It is not relevant in the assessment of the facts whether the applicant is part of the group that is potentially offended or disparaged by the registered term or whether the applicant, as a legal entity, has dedicated itself to the fight against homophobia. The test is whether the term is offensive to persons of normal levels of tolerance and sensitivity who come into contact with the sign. Consequently, the characteristics or personal circumstances of the trade mark applicant have no impact on the applicability of Article 7 absolute grounds objections to the

¹⁴³ R 2804/2014-5, Application of Square Enix Ltd. (MECHANICAL APARTHEID) (Feb. 6, 2015), ¶ 3.

¹⁴⁴ Case T-1/17 La Mafia Franchises, SL (LA MAFIA SE SIENTA A LA MESA) v. EUIPO, ECLI:EU:T:2018:146, ¶ 40 (2018); Case T-140/02 Sportwetten GmbH Gera v. OHIM, ECLI:EU:T:2005:312, ¶ 28 (2005). In another example, Arnold QC, sitting as the Appointed Person, held that:

A mark is only objectionable under [the exclusion] if its use would contravene a generally accepted moral principle by reason of its intrinsic qualities. The reason for this is that, even if the applicant intends to use it in a particular way, his intention may change. Furthermore, the application or registration may be assigned to someone else. Thus the manner in which the mark is subsequently used can neither infect the mark with, nor immunise it from, objectionability.

French Connection Ltd.'s Trade Mark Application (FCUK), [2006] 5 WLUK 432, ¶ 88.

¹⁴⁵ R 2307/2020-G, Application of Turner Broadcasting System Europe Ltd. (MARICON PERDIDO), ¶ 65-66 (Nov. 25, 2024); R 2244/2016-2, Application of Brexit Drinks Ltd. (BREXIT), ¶ 13 (June 28, 2017).

sign at issue. It is the sign itself that must be assessed, not the applicant.¹⁴⁶

There is, however, at least one precedent where the EUIPO Boards of Appeal have been willing to factor in the personal characteristics of the applicant and the type of use to which it allegedly intends to subject the mark when assessing the morality of an applied-for sign.¹⁴⁷ In *Application of Josef Reich*, a case involving registration of the sign JEWISH MONKEYS by a member of an eponymous klezmer music band who is of Jewish faith and uses the sign for satirical purposes, the Board of Appeal granted registration to the applied-for sign after finding that:

The *identity* of the *applicant* must certainly be taken into account in the context of Article 7(1)(f) [EUTMR] According to the overall content of the case file, it can be ruled out that in the *manner* in which the sign applied for is *likely* to be *used* (i.e. not in the context of anti-Israeli political propaganda), the recipients of the goods and services will feel personally targeted and therefore insulted by the designation ‘Jewish Monkeys’.¹⁴⁸

Accounting for the expressive interests of potential consumers of branded goods (and even the wider public) would lend further weight to the meaning-reclaiming argument advanced here. The suggested approach would, thus, open the door to fairer outcomes in the registration context by protecting the rights and interests of minorities who mobilize trademark law to reclaim oppressive language—an endeavor that highlights trademarks’ potential as tools of political and cultural change in our brand-driven society. The reasoning of Judge Dyk from the U.S. Court of Appeals in his partially dissenting/partially concurring opinion in *Tam* (later appealed before the Supreme Court) lends support to this characterization of contemporary trademarks.¹⁴⁹ Although he disagreed that the disparagement clause of the Lanham Act should be struck down on First Amendment grounds, he sided with the majority on the need to allow registration of THE SLANTS to respect the applicant’s speech rights, stating:

Here there can be no doubt that [appellant’s] speech is both *political* and commercial. . . . [Appellant’s] choice of mark reflects a clear desire to *editorialize* on cultural and political subjects. Mr. Tam chose THE SLANTS at least in part to *reclaim* the negative racial stereotype it embodies

¹⁴⁶ *Id.* at ¶ 65-66 (citations omitted).

¹⁴⁷ R 519/2015-4, *Application of Josef Reich (JEWISH MONKEYS)* (Sept. 2, 2015).

¹⁴⁸ *Id.* at ¶ 17 (emphasis added).

¹⁴⁹ *In re Tam*, 808 F.3d 1321, 1363-74 (Fed. Cir. 2015).

Given the indisputably *expressive* character of Mr. Tam's trademark in this case, the government's recognized interests in protecting citizens from targeted, demeaning advertising and proscribing intrusive formats of commercial expression [. . .] are insufficient to justify [the refusal to register the mark].¹⁵⁰

Judge Dyk's reasoning is particularly valuable because it acknowledges that trademarks can carry expressive content that goes beyond the commercial sphere and conveys political messages—which deserve heightened protection under free speech guarantees on both sides of the Atlantic.¹⁵¹ Unfortunately, the Supreme Court chose to remain silent on this point.¹⁵² Judge Dyk's reasoning is also consistent with this article's recognition of the diversity of expressive interests involved in trademark use. As previously noted, the analysis cannot be siloed: the treatment of expressive interests in registration and brand restriction cases ought to inform the infringement analysis, and vice versa. None of this is to deny that speech interests may legitimately be weighed differently across the two contexts: refusing registration of a trademark is not the same act as enjoining a defendant's use, and the doctrines through which the two arise serve distinct purposes. What cannot be sustained, however, is an inconsistency at a more basic level: in the *characterization* of the expressive content itself. If a recoder's use of a mark in infringement litigation can be recognized as artistic or political speech deserving of reinforced protection under freedom of expression, it is difficult to see how the same sign, in the hands of an applicant, can be dismissed as purely commercial in a refusal of registration. The expressive potential of

¹⁵⁰ *Id.* at 1373 (emphasis added).

¹⁵¹ In the United States: *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 64-65 (1983) (“[T]he Constitution accords less protection to commercial speech than to other constitutionally safeguarded forms of expression”). In Europe: *Mouvement Raëlien Suisse v. Switzerland*, App. No. 16354/06, ¶ 61 (July 13, 2012) (citations omitted) (“Whilst there is little scope under Article 10 § 2 of the Convention for restrictions on political speech . . . , States have a broad margin of appreciation in the regulation of speech in commercial matters or advertising.”).

¹⁵² In *Tam*, the Supreme Court was asked to rule on whether marks ought to be characterized as commercial speech in all instances, or whether some marks, if not all, have an expressive component allowing to convey meaning beyond source identification, in which case they would be deserving of reinforced protection under the First Amendment. In dodging a bullet, however, the Court saw no need to answer this question in the case at hand since the disparagement exclusion could not even withstand the lower level of scrutiny that applies to commercial speech. *Matal v. Tam*, 582 U.S. 218, 245-46 (2017). *See*, disagreeing with the views advanced here, Meaghan Annett, *When Trademark Law Met Constitutional Law: How a Commercial Speech Theory Can Save the Lanham Act*, 61 B.C. L. Rev. 253, at 253 (2020) (“[T]he law should treat trademarks as commercial speech. The *Central Hudson* test for intermediate scrutiny is appropriate for identifying a compelling government interest that is related to trademark restrictions at issue.”).

a sign does not depend on the procedural setting in which a court encounters it. An applied-for mark can be put to use by its would-be owner (and, in turn, by consumers of goods bearing the mark, and even by the public, should it permeate the language) for any and all purposes, including the conveyance of artistic or political messages.¹⁵³ Regrettably, however, the EUIPO Grand Board of Appeal rejected this proposition outright in its recent decision in *COVIDIOT*:

The fact that a trade mark applied for may contain political content does not entitle it to a greater protection in so far as freedom of expression is concerned, because a trade mark is not essential to the expression of that political opinion. The registration of an opinion as a trade mark does not bring any advantage to political debate.¹⁵⁴

The Grand Board of Appeal went even further in its rejection of the views advanced here. Upon discussion of different instances where trademarks and speech interact (more precisely, infringement litigation and refusals of registration), it held that:

¹⁵³ This can occur where the rightsholder uses its mark not only to distinguish or promote its goods or services, but also to express its view on a broader topic and engage in public debate. This was the case, for instance, in the *Benetton* advertisements saga decided by the Federal Constitutional Court of Germany. See Bundesverfassungsgericht [BverfGE] [Federal Constitutional Court] Dec. 12, 2000, 102 Entscheidungen des Bundesverfassungsgerichts [BVERFGE] 347; Bundesverfassungsgericht [BverfGE] [Federal Constitutional Court] Mar. 11, 2003, 107 Entscheidungen des Bundesverfassungsgerichts [BVERFGE] 275. The contentious ads showed different images dealing with issues of environmental, social, and health concern, for instance, a picture of a person's naked behind with the words "HIV Positive" stamped on the skin, or a dying AIDS patient surrounded by his grieving family. The apparel company's reputed mark consisting of the words "UNITED COLORS OF BENETTON" contained in a green square was featured in a corner of the ads. In overturning the decision of the Federal Court of Justice upholding a ban on the publication of these ads pursuant to the Unfair Competition Act, the Federal Constitutional Court gave much weight to the robust protection afforded to political expression under the German Constitution. According to the Court, this degree of protection is in no way affected by the fact that the socially relevant message is conveyed in an advertising context where the aim is not only to engage in public debate, but also to further the company's commercial interest in attracting consumers by building a particular brand image. In the words of the Court:

The advertisements draw the attention to socially and politically relevant issues and are also suitable for gaining public attention for these issues. The special protection that [the right to freedom of expression] provides particularly for this form of expression is not diminished by the fact that [the ads] . . . do not make any substantial contribution to the debate on the deplorable situations that they depict. The (mere) denouncement of an injustice can also be an important contribution to the free exchange of ideas. . . . The denouncing effect of the advertisements, which are critical of society, is not called into question by the advertising context.

Bundesverfassungsgericht [BverfGE] [Federal Constitutional Court] Dec. 12, 2000, 102 Entscheidungen des Bundesverfassungsgerichts [BVERFGE] 347, ¶ 62-63 (Ger.).

¹⁵⁴ R 260/2021-G, Application of Matthias Zirnsack (*COVIDIOT*), ¶ 138 (May 16, 2024).

The need to protect the freedom of expression is necessarily higher where the use of a certain expression in the context of actual commercial or even political activities is concerned, as opposed to the mere registration, in particular because failure to register a mark does not prohibit the applicant from using the sign.¹⁵⁵

This constitutes a missed opportunity for EU trademark law to recognize the broader role that registration can play in furthering the expressive interests of a wide range of individuals beyond trademark applicants. This finding is, however, consistent with previous EUIPO decisions and—more worryingly—the case law of the European Court of Human Rights, where speech restrictions resulting from refusals of registration have been consistently scrutinized under the narrower scope of protection afforded to commercial expression.¹⁵⁶ This is difficult to reconcile with the findings of several German courts, for instance, which (as we saw earlier) have permitted recoders' unauthorized uses of reputed marks under the broader scope of protection accorded to artistic expression.¹⁵⁷ If adopted, the approach to interaction cases suggested here would eliminate this inconsistency between infringement and registration disputes, while also ensuring better enforcement of the freedom of expression guarantee under human rights instruments.

C. Brand Restriction

There are precedents on both sides of the Atlantic in which courts have acknowledged that brand restriction measures, notably health warnings and plain packaging requirements, interfere with rightsholders' freedom of expression.¹⁵⁸ In the United States, these arguments have, for the most part, led courts to side with trademark owners after finding that the challenged measure is incompatible

¹⁵⁵ *Id.* at ¶ 143.

¹⁵⁶ In the words of the EUIPO Grand Board of Appeal in *COVIDIOT*:

The case-law of the ECtHR shows that there is categorisation of expression of an opinion according to the importance of its content in order to determine the extent of the protection granted. This hierarchical model of expression puts commercial expression at a lower level than others, especially when compared to political forms of expression. An expression containing a commercial message may be subject to different restrictions than a political speech.

R 260/2021-G, Application of Matthias Zirnsack (*COVIDIOT*), ¶ 136 (May 16, 2024). See also *CSIBI v. Romania*, App. No. 16632/12 (ECtHR, June 4, 2019); *Dor v. Romania*, App. No. 55153/12 (ECtHR, Aug. 25, 2015).

¹⁵⁷ Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 7, 2005, NJW 2856 (2005) (Ger.) (for an English translation, see *Violet Postcard*, 38 Int'l Rev. of Intell. Prop. & Competition L. 119 (2007)); Oberlandesgericht Hamburg [OLG] [Hamburg Higher Regional Court] Jan. 5, 2006, GRUR-RR 231 (2006) (Ger.).

¹⁵⁸ See case law cited in note 41 *supra*.

with the broad protection the First Amendment affords to speech.¹⁵⁹ This is in contrast with European courts, which have consistently ruled in favor of the legislature under the wider margin of appreciation afforded to domestic decision-makers under the ECHR and EU Charter.¹⁶⁰ Their approach to the balancing exercise has often been cursory, opting for a hierarchical resolution of the clash of rights in which the governmental interest in advancing the right to (public) health readily trumps rightsholders' freedom of commercial expression—which, as discussed, warrants less protection than political or artistic speech.¹⁶¹

Against this backdrop, the refined approach suggested here would require courts hearing challenges to brand restriction measures to factor the expressive interests of consumers of branded goods into their analysis, alongside those of the rightsholder. This reconceptualization has profound implications for how courts approach this form of interaction. Brand restriction mandates are often adopted in conjunction with other measures (notably combined health warnings using images and text to alert consumers to the risks of the goods concerned) that, over time, erode the expressive meanings conveyed by the targeted marks—meanings on which consumers may have come to rely for self-expression. Furthermore, where a mark has become a cultural symbol or permeated everyday language, courts should also factor in the expressive interests of the public (and even those of potential recoders who draw on the mark for parody or commentary) since the mark's role as an expressive artifact may be lost over time. The MARLBORO mark is an obvious example: the masculinity and rugged independence with which it was long associated—meanings vivid enough to lodge the “Marlboro Man” in our cultural vocabulary—are being steadily eroded by these measures.

The proposed rebalancing would widen the range of expressive interests recognized as affected by brand restriction measures, leading courts to weigh the legislature's interest in advancing the

¹⁵⁹ Rightsholders' challenges to trademark-restrictive measures have been successful in the following cases: *R.J. Reynolds Tobacco Co. v. FDA*, 696 F.3d 1205, 1212 (D.C. Cir. 2012); *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 569-71 (2001). *See, in contrast*, *Cigar Assoc. of Am. v. FDA*, 315 F. Supp. 3d 143, 164 (D.D.C. 2018).

¹⁶⁰ Case C-547/14, *Philip Morris Brands SARL v. Secretary of State for Health*, ECLI:EU:C:2016:325 (2016); Opinion of Advocate General Kokott in Case C-547/14, *Philip Morris Brands SARL v. Secretary of State for Health*, ECLI:EU:C:2015:853 (2015); *R. (on the application of British American Tobacco UK Ltd.) v. Secretary of State for Health* [2004] EWHC 2493 (Admin). The only precedent where trademark-restrictive measures have been found to constitute a disproportionate encroachment on tobacco manufacturers' freedom of expression is the Opinion of Advocate General Fennelly in Case C-376/98, *Germany v. European Parliament*, ECLI:EU:C:2000:324 (2000).

¹⁶¹ Case C-547/14, *Philip Morris Brands SARL v. Secretary of State for Health*, ECLI:EU:C:2016:325, ¶ 152 (2016); Opinion of Advocate General Kokott in Case C-547/14, *Philip Morris Brands SARL v. Secretary of State for Health*, ECLI:EU:C:2015:853, ¶ 233 (2015).

right to public health against the political and artistic expression of a broad range of individuals, rather than against the rightsholder's commercial speech alone.¹⁶² Support for this proposition can be found in the European Court of Human Rights' case law on mixed expression. The Court has consistently held that forms of expression usually characterized as commercial, such as advertising, must be reviewed under a stricter standard—that is, with a narrower margin of appreciation—where the aim and content of the message are fundamentally non-commercial.¹⁶³ So it held, for instance, in the case of an animal-welfare association's broadcast urging viewers to reduce their meat consumption, where the message did not seek to attract custom but to contribute to a broader public debate.¹⁶⁴ In the words of the Court:

[T]he applicant association's film fell outside the regular commercial context inciting the public to purchase a particular product. Rather, it reflected controversial opinions pertaining to modern society in general. . . .

As a result, in the present case the extent of the margin of appreciation is reduced, since what is at stake is not a given individual's purely "commercial" interests, but his participation in a debate affecting the general interest.¹⁶⁵

¹⁶² This approach is also in keeping with the consistent enforcement of the guarantees provided to speech under human rights instruments across different forms of interaction. As we saw upon study of infringement cases, trademark use by recoders has often been found deserving of protection under the broader scope of protection afforded to artistic speech—including in cases involving recoded use of renowned tobacco trademarks in anti-smoking campaigns, notably: Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 17, 1984, NJW 1956 (1984) (Ger.) (for an English translation of the decision, see *Re Parodying of Cigarette Advertising* (VI ZR 246/82) [1986] E.C.C. 1); Cour de cassation [Cass.] [supreme court for judicial matters] 2e civ., Oct. 19, 2006, Bull. civ. II, No. 282 (Fr.) (for an English translation of the decision, see *Comité National contre les Maladies Respiratoires et la Tuberculose v. Société JT International GmbH*, 38 Int'l Rev. Intell. Prop. & Competition L. 357 (2007)).

¹⁶³ Although they carry special weight, the aim and content of the expression are not the only factors that the ECtHR has taken into consideration when assessing the margin of appreciation that must be afforded in cases of mixed expression. This has been noted by Sakulin. As he points out, in *Barthold v. Germany*, for instance, the ECtHR's finding that the veterinarian's mixed speech was deserving of robust protection under Article 10 also took into consideration: (a) the degree of influence that the appellant had on the means of communication; (b) whether the appellant had paid for the advertisement; or (c) the effect that the expression was bound to have on the public. *Barthold v. Germany*, App. No. 8734/79 (ECtHR, March 25, 1985). Sakulin relies on this, and other cases, to make an interesting point: courts must detach the definition of commerciality that applies in the context of Article 10 from that which usually applies in other areas of law, notably trademark law or unfair competition law. Otherwise, courts risk adopting an overreaching definition of commerciality that can lead to most instances of mixed speech being categorized as commercial speech. Sakulin, *supra* note 72, at 169-74.

¹⁶⁴ *VgT Verein Gegen Tierfabriken v. Switzerland*, App. No. 24699/94 (ECtHR, June 28, 2001).

¹⁶⁵ *Id.* ¶ 70-71 (citations omitted).

The Court has reached similar conclusions in cases involving television advertisements by political and religious organizations.¹⁶⁶ Under the stricter tests applied to political and artistic expression, the proposed rebalancing would require courts adjudicating challenges to brand restriction measures to assess their compatibility with freedom of expression against a higher burden of proof than applies to commercial speech. The European Court of Human Rights has held that, on strict scrutiny, “the need for any restrictions must be established *convincingly*.”¹⁶⁷ This is a markedly higher threshold than the one applied to commercial expression, where the Court has held that a measure need only be “justifiable in principle and proportionate,”¹⁶⁸ or justified on “reasonable grounds.”¹⁶⁹

On this view, “convincing” evidence would require public authorities to show that the causal link between the restrictive measure and the intended effect (in the tobacco context, a reduction in smoking prevalence) rests on more than coherence or plausibility. Where the quantitative evidence remains inconclusive, there is room to argue that this higher threshold cannot be met by inference alone.

CONCLUSION

This paper has argued that courts on both sides of the Atlantic adjudicate interaction cases under an impoverished conception of who actually speaks through a trademark. Once the full range of expressive users (owners, consumers of branded goods, recoders, consumers of goods bearing recoded marks, and the public) is brought into view, the standard ways of resolving these disputes begin to look not merely incomplete but, in places, incoherent. The practical payoff of the typology lies in what it asks courts to do differently in each of the three interaction contexts.

In infringement litigation, the move is to stop treating the commercial character of a recoded use as a threshold that forecloses speech protection, and to ask instead whether the use causes expressive harm to the mark—a question that, by pitting speech against speech, makes the balancing not only commensurable, but also internal to trademark law rather than importing constitutional

¹⁶⁶ TV Vest As & Rogaland Pensjonistparti v. Norway, App. No. 21132/05, ¶ 64 (ECtHR, Dec. 11, 2008); Murphy v. Ireland, App. No. 44179/98, ¶ 70 (ECtHR, July 10, 2003).

¹⁶⁷ VgT Verein Gegen Tierfabriken v. Switzerland, App. No. 24699/94, ¶ 66 (ECtHR, June 28, 2001); Hertel v. Switzerland, App. No. 25181/94, ¶ 46 (ECtHR, Aug. 25, 1998); Handyside v. The United Kingdom, App. No. 5493/72, ¶ 49 (ECtHR, Dec. 7, 1976) (emphasis added).

¹⁶⁸ Markt Intern Verlag GmbH & Klaus Beermann v. Germany, App. No. 10572/83, ¶ 33 (ECtHR, Nov. 20, 1989).

¹⁶⁹ *Id.* at ¶ 37.

reasoning from outside it. In registration cases, the proposal is to abandon the assumption that an applicant's interest in a sign is purely commercial: the same sign that a court would recognize as carrying political or artistic meaning in a recoder's hands cannot coherently be dismissed as commercial in an applicant's. This narrows the proper scope of the morality exclusion—and, in particular, brings into view the role that registration can play in efforts to reappropriate an offensive sign. In challenges to brand restriction measures, the suggestion is to recognize that the interests on the speech side of the scale extend well beyond the rightsholder's commercial expression to the political and artistic interests of consumers of branded goods and the public. Such interests should weigh genuinely in the balancing, not be treated as readily outweighed by the legislature's objectives (especially in Europe).

None of this will eliminate inconsistency. The U.S. Supreme Court and the CJEU will continue to play an indispensable role in providing guidance. The balancing exercises proposed here are demanding ones that will not always yield clear answers, and the approach generates frictions of its own. The contribution of this paper is not to eliminate that complexity but to give courts a more accurate map of it. Recognizing the diversity of expressive users, and replacing categorical proxies with a substantive inquiry into the expressive interests genuinely at stake, is the most promising route to outcomes that are at once fairer, more consistent, and more faithful to the human rights guarantees that freedom of expression demands. That is a modest claim in one sense and an urgent one in another: modest, because it refines rather than replaces existing doctrine; urgent, because the cost of the present disorder is borne by the speech it quietly chills.
