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Amicus Brief of the Electronic Frontier Foundation and the  
ACLU of Virginia in *Radiance Foundation, Inc. v. NAACP*  
*Eugene Volokh & Mairead Dolan*





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AMICUS BRIEF OF THE ELECTRONIC FRONTIER  
FOUNDATION AND THE ACLU OF VIRGINIA IN  
*RADIANCE FOUNDATION, INC. V. NAACP*

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### SUMMARY OF ARGUMENT<sup>1</sup>

People often use the names of organizations, celebrities, and trademarked products, to comment on them, critique them, parody them, review their work, and more. A director might make a movie about fictional dancers who imitate Fred Astaire and Ginger Rogers, and call it “Ginger and Fred.”<sup>2</sup> A musical group might write a song mocking Barbie and call it “Barbie Girl.”<sup>3</sup>

Some might condemn the NRA by saying that it stands for “Next Rifle Assault” or “National Republican Association.”<sup>4</sup> Others might criticize NBC by saying that it stands for “Nothing But Caucasians,”<sup>5</sup> or the ACLU by saying that it stands for “Anti-Christian Lawyers Union.”<sup>6</sup> Still others might do what Radiance did here: criticize the NAACP by saying that it stands for “National Association for the Abortion of Colored People,”<sup>7</sup> on the theory that the NAACP “has publicly supported Planned Parenthood numerous times,” has “fought to prevent the abortion chain from being defunded while simultaneously fighting to ensure a massive influx of funding for its beloved ally (and annual convention sponsor),” and has otherwise allied itself with Planned Parenthood.<sup>8</sup>

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<sup>1</sup> To retain consistency with the filed brief citations have been verified, but not re-formatted to conform with blue book standards. Additionally, sections have been moved or deleted to better suit the journal format. For an unedited version of the brief see [https://www.eff.org/files/2014/10/11/eff\\_alcu\\_amicus\\_brief\\_-\\_radiance\\_v\\_naacp.pdf](https://www.eff.org/files/2014/10/11/eff_alcu_amicus_brief_-_radiance_v_naacp.pdf).

<sup>2</sup> *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

<sup>3</sup> *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002).

<sup>4</sup> Chris Williams, *The NRA Stands for Next Rifle Assault*, The Huffington Post, Jan. 17, 2013, [http://www.huffingtonpost.com/chris-williams/the-nra-stands-for-next-r\\_b\\_2490767.html](http://www.huffingtonpost.com/chris-williams/the-nra-stands-for-next-r_b_2490767.html); Michael J. McCoy, *NRA: The National Republican Association*, TIMES-HERALD, Mar. 27, 2013.

<sup>5</sup> Ruben Navarrette Jr., *Biggest Story Never Told Is Latinos Missing from the Media*, CONTRA COSTA TIMES, Aug. 24, 2011.

<sup>6</sup> Neo-Con\* Tastic, *Anti-Christian Lawyers Union*, Nov. 16, 2005, <http://neo-contastic.blogspot.com/2005/11/anti-christian-lawyers-union.html>; Ed Brayton, *The Anti-Christian Lawyers Union*, Dispatches from the Creation Wars, May 30, 2008, <http://scienceblogs.com/dispatches/2008/05/30/the-antichristian-lawyers-unio/> (sarcastically referring to this decoding in a post that stresses that the ACLU actually protects the rights of Christians).

<sup>7</sup> *Radiance Found., Inc. v. Nat’l Ass’n for the Advancement of Colored People*, 2014 WL 2601747 (E.D. Va. June 10, 2014).

<sup>8</sup> Ryan Bomberger, *NAACP: National Association for the Abortion of Colored People*, Jan. 16, 2013, <http://www.lifenews.com/2013/01/16/naacp-national-association-for-the-abortion-of-colored-peopl/>.

Courts have recognized that such speech is constitutionally protected, even when there is a risk that some people might be briefly confused about the source of the speech. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), and *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002), for instance, held that using a trademark in an artistic or political work’s title does not violate the Lanham Act unless the use “has no . . . relevance to the underlying work whatsoever.” *Rogers*, 875 F.2d at 999; *Mattel*, 296 F.3d at 902. The risk of some consumer confusion, the courts concluded, cannot outweigh the speaker’s First Amendment right to freedom of expression. Likewise, Radiance’s criticism of the NAACP contained in post titles is constitutionally protected.

Such uses of trademarks also do not constitute trademark dilution. Title 15 U.S.C. § 1125(c)(3) expressly excludes “noncommercial use[s] of a mark” from the dilution cause of action; as *Mattel* noted, this exclusion protects all uses other than “commercial speech” (*i.e.*, commercial advertising). *Mattel*, 296 F.3d at 905-06. That the *Barbie Girl* song involved in *Mattel* was aimed at making money did not make it a “commercial use” for dilution law purposes. Similarly, that Radiance’s Web site is aimed partly at making money—a property the site shares with nearly all newspapers, magazines, books, movies, and other fully protected materials—does not make Radiance’s political commentary “[c]ommercial use of a mark” under § 1125(c)(3).

The district court therefore erred in accepting the NAACP’s trademark infringement and trademark dilution theories. *Amici* ask this Court to reverse and to hold that Radiance should have been granted a declaratory judgment that its posts were not infringing.

## ARGUMENT

### I

#### RADIANCE’S USE OF THE TERM “NAACP” IN AN ARTICLE TITLE WAS NOT INFRINGING ON A CONFUSION THEORY

In talking about people, organizations, and products—including talking about them using speech that makes the speaker money—critics and commentators often use trademarks, sometimes in ways that mock or condemn the target. Such speech might also include statements that are facetious, but that help convey the desired message. NRA, the initials of the pro-gun-rights group, actually stand for National Rifle Association, but the mocking label “the National Republican

Association” helps the critic express what he views as the organization’s true nature.<sup>9</sup>

Such uses of a name might sometimes briefly confuse a handful of listeners. A reader unfamiliar with the organization may mistakenly believe that NRA indeed stands for “National Republican Association,” that the ACLU indeed stands for the “Anti-Christian Lawyers Union,” or that the NAACP is indeed endorsing the abortion of African Americans. But the law cannot undermine the freedom of speech simply because a few people make a mistake.

*Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), and *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002), make clear that such uses of trademarks in titles are not actionable even when some viewers are likely to be confused. In *Rogers*, a filmmaker was sued by Ginger Rogers for his use of the film title “Ginger and Fred.” The film was not about Rogers and her film partner, Fred Astaire, but about two other dancers who imitated the duo onstage. *Id.* at 996-97.

Rogers argued that potential viewers might well be confused by the reference, and might mistakenly believe that Rogers or Astaire had endorsed the film. *Id.* And indeed it is possible that some viewers might have bought tickets to the film because they believed it to be so endorsed, or at least more directly connected to Rogers’ and Astaire’s lives.

Yet despite survey evidence showing likely confusion and evidence of actual confusion, *Rogers*, 875 F.2d at 1001, the court found that the defendant had not violated the Lanham Act. *Id.* at 997. The court held that, “in the context of allegedly misleading titles using a celebrity’s name,” there is no Lanham Act violation “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some relevance, unless the title explicitly misleads as to the source or content of the work.” *Id.* at 999. And the court concluded that, as to *Ginger and Fred*, “the consumer interest in avoiding deception is too slight to warrant application of the Lanham Act.” *Id.* at 1000.

The *Rogers* approach was adopted by *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002), which dealt with a Lanham Act claim based on a musical group’s song called “Barbie Girl.” Mattel, the owner of the “Barbie” trademark, sued the record company for trademark dilution and infringement. The court disagreed, concluding that, “when a trademark owner asserts a right to control how

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<sup>9</sup> Michael J. McCoy, *NRA: The National Republican Association*, TIMES-HERALD, Mar. 27, 2013.

we express ourselves,” “applying the traditional test fails to account for the full weight of the public’s interest in free expression.” *Id.* at 900.

And the court concluded that letting trademark claims trump free speech rights was especially inappropriate when the use was a title. “A title is designed to catch the eye and to promote the value of the underlying work. Consumers expect a title to communicate a message about the book or movie, but they do not expect it to identify the publisher or producer.” *Id.* at 902. Therefore, the court held, “literary titles do not violate the Lanham Act ‘unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.’” *Id.* (quoting *Rogers*, 875 F.2d at 999). The court concluded that the use of “Barbie” in the title was not enough to satisfy the “explicitly misleads as to the source or the content” test; “if this were enough to satisfy this prong of the *Rogers* test, it would render *Rogers* a nullity.” *Id.* at 902.

As in *Mattel*, Radiance used a trademarked term in the course of criticizing it. The trademark was used in the title of a work and was directly related to the article itself. Just as “[t]he song [*Barbie Girl*] does not rely on the Barbie mark to poke fun at another subject but targets Barbie herself,” *Mattel*, 296 F.3d at 901, so the Radiance articles did not rely on the NAACP mark to criticize another subject, but targeted the NAACP itself. As in *Mattel*, there is the possibility that some people might be confused by the title’s reference. But, as *Mattel* and *Rogers* show, that possibility cannot suffice to trump Radiance’s First Amendment rights, given the importance of the right to refer to, comment on, or criticize famous organizations, people, and products.

*E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir 2008), likewise followed the *Rogers* test. In *E.S.S. Entertainment*, a video game set in East Los Angeles portrayed a strip club that was clearly representative of the plaintiff’s club; the club owner sued the video game creator for trademark infringement.

As in *Mattel* and *Rogers*, the court concluded that artistic or political use of a trademark will not violate the Lanham Act so long as “the level of relevance [to the underlying work is] merely . . . above zero.” *Id.* at 1100. And though “the Game is not ‘about’ the [club] the way that Barbie Girl was about Barbie,” the court held, “given the low threshold the Game must surmount, that fact is hardly dispositive.” *Id.* Because the neighborhood that the game was trying to recreate was “relevant to Rockstar’s artistic goal,” Rockstar had the right to “recreate a critical mass of the

businesses and buildings that constitute it” by “includ[ing] a strip club that [was] similar in look and feel” to the plaintiff’s club. *Id.*

As with the defendants’ speech in *Rogers*, *Mattel*, and *E.S.S. Entertainment*, Radiance’s use of NAACP’s trademark in the title of an article was directly relevant to the article’s political goal and did not explicitly mislead as to the source or content of the article. At most it led some people to briefly misunderstand what “NAACP” stood for—but the risk of misunderstanding the title was present in *Rogers* and *Mattel* as well, and the Second and Ninth Circuits held that this risk was not enough to justify restricting defendants’ speech.

*Rogers*, *Mattel*, and *E.S.S. Entertainment* show that the First Amendment broadly protects cultural reference, commentary, criticism, and parody, including when such speech uses another’s trademark. The district court thus erred in viewing the possibility of some consumer confusion as trumping Radiance’s free speech rights. The district court likewise erred in admitting the expert report presented by NAACP, given that, under these precedents, the report’s assertions are irrelevant.

And the Second and Ninth Circuit’s analyses in *Rogers*, *Mattel*, and *E.S.S. Entertainment* are sound. To be sure, in any group of potential viewers or listeners, some people might not think hard about what is being said and might thus reach the wrong conclusion. But in most situations, a brief further review will clear things up. “[M]ost consumers are well aware that they cannot judge a book solely by its title any more than by its cover.” *Rogers*, 875 F.2d at 1000. And even if there is some risk of consumer confusion, that cannot justify interfering with the First Amendment rights of artists, social commentators, and political commentators.

These precedents also show that the First Amendment protects the expressive use of others’ trademarks for cultural or historical reference, commentary, criticism, or parody. The use of “National Association for the Abortion of Colored People” as a mocking decoding of “NAACP” was indeed “parody,” “defined as ‘a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.’” *People for Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001). “[E]ntertainment” need not arouse laughter or light-hearted pleasure; some political criticism can entertain precisely by being caustic. *See, e.g.*, ROSEMARIE OSTLER, SLINGING MUD: RUDE NICKNAMES, SCURRILOUS SLOGANS, AND INSULTING SLANG FROM TWO CENTURIES OF AMERICAN POLITICS (2011).

But even if the article title was not parody but was commentary or criticism, it should be protected. “Ginger and Fred,” for instance, was a constitutionally protected reference to Rogers and Astaire but not a parody of them. And more broadly, political criticism must be at least as protected as humor and entertainment; indeed, when the Lanham Act expressly discusses “parodying,” in 15 U.S.C. § 1125(c)(3)(A)(ii) (in the dilution section), it treats parodying on par with “criticizing[] or commenting upon” the mark.

## II

### **RADIANCE’S USE OF THE TERM “NAACP” IN AN ARTICLE TITLE WAS NOT TRADEMARK DILUTION**

#### *A. Radiance’s Speech Was a “Noncommercial Use” and Thus Expressly Exempted from Trademark Dilution Actions*

Beyond its mistaken finding of confusion, the court below also mistakenly found trademark dilution by failing to apply the exceptions laid out in 15 U.S.C. § 1125(c)(3).

To begin with, § 1125(c)(3) expressly exempts “any noncommercial use” of a trademark from Lanham Act action. As the Ninth Circuit held in *Mattel*, “[n]oncommercial use’ refers to a use that consists entirely of noncommercial, or fully constitutionally protected, speech,” 296 F.3d at 905—which is to say, speech that “does more than propose a commercial transaction,” *id.* at 906. As a result, the Ninth Circuit held that the *Barbie Girl* song, though distributed for profit, constituted a “noncommercial use” of the Barbie trademark.

Likewise, this Court has stated that Congress “did not intend for trademark laws to impinge the First Amendment rights of critics and commentators”; one First Amendment protection within “[t]he dilution statute” is that Congress “incorporate[d] the concept of ‘commercial’ speech from the ‘commercial speech’ doctrine,” *i.e.*, “speech proposing a commercial transaction,” into the “noncommercial use” exception. *Lamparello v. Falwell*, 420 F.3d 309, 313-14 (4th Cir. 2005) (citations omitted). The “noncommercial use” exception thus limits the dilution cause of action to commercial advertising (which does propose a commercial transaction), and excludes fully protected speech, even when that speech—like most speech in newspapers, magazines, films, songs, and similar media—is distributed with an eye towards raising money.

*Mattel* offered a detailed explanation for why this interpretation of “noncommercial use” is correct. Reading the “noncommercial use” exception as limited to non-money-making media, the court held, “would . . . create a

constitutional problem, because it would leave the FTDA [the Federal Trademark Dilution Act] with no First Amendment protection for dilutive speech other than comparative advertising and news reporting.” 296 F.3d at 904. But this First Amendment difficulty can be avoided because the FTDA’s legislative history suggests that “[n]oncommercial use” refers to a use that consists entirely of noncommercial . . . speech” in the sense that “noncommercial speech” is used in First Amendment doctrine, *id.* at 905:

The FTDA’s section-by-section analysis presented in the House and Senate suggests that the bill’s sponsors relied on the “noncommercial use” exemption to allay First Amendment concerns. H.R. Rep. No. 104-374, at 8, *reprinted in* 1995 U.S.C.C.A.N. 1029, 1035 (the exemption “expressly incorporates the concept of ‘commercial’ speech from the ‘commercial speech’ doctrine, and proscribes dilution actions that seek to enjoin use of famous marks in ‘non-commercial’ uses (such as consumer product reviews)”; 141 Cong. Rec. S19306-10, S19311 (daily ed. Dec. 29, 1995) (the exemption “is consistent with existing case law[, which] recognize[s] that the use of marks in certain forms of artistic and expressive speech is protected by the First Amendment”). At the request of one of the bill’s sponsors, the section-by-section analysis was printed in the Congressional Record. Thus, we know that this interpretation of the exemption was before the Senate when the FTDA was passed, and that no senator rose to dispute it.

*Id.* at 905-06 (emphasis added, some citations omitted). And this analysis is entirely consistent with this Court’s reasoning in *Lamparello*.

The articles about the NAACP that Radiance posted were not “commercial speech” aimed at “proposing a commercial transaction.” They were political advocacy aimed at communicating Radiance’s views about the NAACP. That they appeared on a site that aimed to raise money for Radiance is irrelevant for purposes of dilution law, just as *Barbie Girl* being a commercially distributed song—and most movies, newspapers, magazines, and books being aimed at making money—is irrelevant for purposes of dilution law.

*B. Radiance’s Speech Was Not Actionable Dilution Because It Was Exempted  
Commentary and Criticism*

Under § 1125(c)(3)(A)(ii) any use of a trademark is protected against a dilution claim if it is “identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.”

Radiance used the NAACP’s trademark to criticize the practices of the organization and to comment on how abortion affects the African-American community. Such uses are therefore exempted under § 1125(c)(3)(A)(ii).

Indeed, exceptions for commentary and criticism, such as those laid out for copyright infringement in 17 U.S.C. § 107, are a “First Amendment protection[.]” *See Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (2007) (discussing “the First Amendment protections already embodied in . . . the latitude for . . . comment traditionally afforded by fair use”). Likewise, the exception for “parodying, criticizing, or commenting” in § 1125(c)(3)(A)(ii)—a close analog to the exception “for purposes such as criticism[ or] comment” in 17 U.S.C. § 107—is also an important First Amendment protection. In this instance, and even independently of the “noncommercial use” exception, the § 1125(c)(3)(A)(ii) exception protects Radiance’s rights to use NAACP’s mark to criticize what Radiance sees as NAACP’s improper stance on abortion.

### CONCLUSION

*Amici* ask that this court follow *Rogers*, *Mattel*, and *E.S.S. Entertainment*—as well as the plain meaning of § 1125(c)(3)(A)(i)-(ii)—and conclude that Radiance’s uses of the NAACP marks constituted neither infringement by confusion nor infringement by dilution.

### INTEREST OF AMICI CURIAE

The Electronic Frontier Foundation (“EFF”) is a nonprofit public advocacy organization devoted to preserving civil liberties in the digital realm. Founded in the nascent days of the modern Internet, EFF uses the skills of lawyers, policy analysts, activists, and technologists to promote Internet freedom, primarily through impact litigation in the American legal system. EFF has no position on the controversy over abortion.

EFF views the protections provided by the First Amendment as vital to the promotion of a robustly democratic society. This case is of special interest to EFF because incautiously defined intellectual property rights improperly restrict speech that should receive full First Amendment protections. It is thus important that the Lanham Act not be interpreted in a way that erodes long-standing First Amendment freedoms.<sup>10</sup>

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<sup>10</sup> No party or party’s counsel has authored this brief in whole or in part, or contributed money that was intended to fund preparing or submitting the brief. No person has contributed money that was intended to fund preparing or submitting the brief, except that UCLA School of

The American Civil Liberties Union of Virginia, Inc. is the state affiliate of the American Civil Liberties Union (“ACLU”), a nationwide, non-profit, non-partisan organization with more than 500,000 members dedicated to defending the principles of liberty and equality embodied in the Constitution and the nation’s civil rights laws.

Among the top priorities of the ACLU is the defense of the freedom of speech guaranteed by the First Amendment. The ACLU generally strongly supports the NAACP, and its mission of racial justice. The ACLU also vigorously defends reproductive freedom, including a woman’s right to choose an abortion. But despite its disagreement with the speech of Radiance Foundation, the ACLU of Virginia joins this brief in support of Radiance because it believes that the right to parody prominent organizations like the NAACP (and the ACLU) is an essential element of the freedom of speech.