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BRANDED: Trademark Tattoos, Slave Owner Brands, And The Right To Have "Free" Skin

Shontavia Johnson

Drake University Law School

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BRANDED: TRADEMARK TATTOOS, SLAVE OWNER BRANDS, AND THE RIGHT TO HAVE “FREE” SKIN

*Shontavia Johnson**

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ABSTRACT

Though existing for several millennia in various cultures, body modification through tattooing is becoming more popular in the United States. Twenty percent of Americans have at least one tattoo, and among Millennials this number grows to almost forty percent. As the popularity of tattoos has increased in recent years, so too have questions revolving around concepts of intellectual property and the plausi-

* Assistant Professor and Director of Diversity Initiatives, Drake University Law School.

ble limitations of any rights stemming therefrom. This Article addresses the implications, for both the tattooist and the tattooed, of using trademarked designations as tattoos. Neither the courts nor Congress have definitively answered the question of how traditional trademark law norms apply when a trademark is permanently inked onto the body of a human being. This Article contends that traditional enforcement norms related to trademark law are ill equipped to address the myriad questions that arise with respect to tattoos. In addition, the Article builds on earlier suggestions that the Thirteenth Amendment necessitates the creation of exceptions to traditional intellectual property law enforcement mechanisms when permanent tattoos are at issue.

INTRODUCTION

In 2009, Sam Penix, a coffee enthusiast living in New York, opened a coffee shop named Everyman Espresso.¹ The company's logo featured an illustration of Penix's tattooed fist grabbing a portafilter filled with coffee between the stylized words *Everyman Espresso*.² Penix's fist, both in real life and in the illustration, features a tattoo reading "I [coffee cup] NY" across his knuckles.³ A few years after opening the coffee shop, Everyman Espresso received a cease and desist letter alleging trademark infringement from the New York State Department of Economic Development, which owns the "I ♥ NY" trademark on behalf of the State of New York.⁴ Despite his belief that the Everyman Espresso logo was not infringing, Penix and his business partners complied with letter's request to remove Penix's fist from the logo and to remove the original logo from marketing and other materials. In addition, Penix agreed to several restrictive limitations on how his fist could and could not be photographed.⁵

Around the same time that Everyman Espresso received its cease and desist letter from the State of New York, another New York company was garnering viral media exposure for its unique, tattoo-based compensation incentive. Rapid Realty, a New York City-based real estate company, offers

1. See Andy Newman, *A Cup is at the Heart of a Trademark Dispute*, N.Y. TIMES (May 29, 2013), http://www.nytimes.com/2013/05/30/nyregion/new-york-challenges-a-coffee-shop-logo.html?_r=0.

2. *Id.*

3. *Id.* Appendix A features photos of both the logo and Penix's actual fist.

4. Appendix B features a photo of the "I ♥ NY" trademark at issue. The New York State Department of Economic Development owns a number of federal trademark registrations featuring the "I ♥ NY" logo on behalf of the State of New York. See e.g., I NY Registration No. 4,409,927; I NY Registration No. 4,556,267; I NY Registration No. 1,555,836. Allegedly, the trademark is the subject of countless unauthorized uses, much to the chagrin of the state of New York. See Anthony Ramirez, *To Promote New York, Handlers Take Steps to Reclaim 'I ♥ NY'*, N.Y. TIMES (May 12, 2008), <http://www.nytimes.com/2008/05/12/nyregion/12loveny.html> (noting that "almost all" of "I ♥ NY" merchandise in Midtown Manhattan is infringing).

5. Newman, *supra* note 1 (stating that Penix has "to keep [his fist] separate from the promotion of the business and put it away for photos").

raises to employees who participated in its Tattoo Brand Ambassadors program.⁶ Through the program, employees who get a tattoo of the company's logo, of any shape and in any location, "are permanently raised to the company's highest commission split for showing apartments."⁷ By May 2013, forty employees had taken advantage of this program, representing roughly five percent of Rapid Realty's workforce.⁸

Indeed, employers are not the only groups encouraging brand loyalists to engage in what has been referred to as skinvertising,⁹ the practice of compensating people for tattooing a company's brand or logo on their body.¹⁰ Other private companies have begun to market their brands in ways that encourage such activities. Ecko Unlimited, an urban clothing company, offers a lifetime twenty percent discount to customers who have permanent tattoos of one of two of the company's trademarked logos.¹¹ Harley-Davidson's customers famously get the Bar & Shield logo tattooed on their bodies after purchasing one of the company's motorcycles.¹² Athletes who complete the World Triathlon Corporation's Ironman Triathlon consider it a rite of passage to get the iconic "M-Dot" trademark tattooed on their bodies after completing the grueling race.¹³

6. *Rapid Tattoos*, RAPIDREALTYNYC, <http://www.rapidnyc.com/rapidtattoos> (last visited Apr. 26, 2016).

7. *Id.* The incentive is based on an employee's ability to sell and rent apartments. An employee with a Rapid Realty tattoo can receive up to a fifteen percent increase in commission compensation over employees who do not have such tattoos.

8. See Amy Langfield, *Company ink: Agents get 15% Raise for Corporate Tattoos*, TODAYMONEY (May 1, 2013, 11:42 AM), <http://www.today.com/money/company-ink-agents-get-15-raise-corporate-tattoos-6C9714898>. Interestingly, the CEO of Rapid Realty did not get a tattoo of the company's logo. *Id.* While all forty of the tattooed employees were still with Rapid Realty as of 2013, it is unclear whether they are still employed with the company as of the time of this Article.

9. Drew Guarini, *Tattoo Ad Craze Created Human Billboards For Now Defunct Companies*, HUFFINGTON POST (Sept. 18, 2012, 5:06 PM), http://www.huffingtonpost.com/2012/09/18/tattoo-ads-human-billboards_n_1894235.html.

10. CORMAC McKEOWN & ELSPEETH SUMMERS, COLLINS I SMIRT, YOU STOOZE, THEY KRUMP: CAN YOU STILL SPEAK ENGLISH? 148-49 (2006).

11. *Ecko Offers 20 Percent Off For Life For Anyone Who Gets Tattoo Of Its Logo*, HUFFINGTON POST (Apr. 4, 2011, 8:26 AM), http://www.huffingtonpost.com/2011/04/04/ecko-tattoo-logo_n_844306.html.

12. Jonathan Salem Baskin, *Harley-Davidson Will Be A Case History In Social Branding*, FORBES (July 12, 2013, 3:06 PM), <http://www.forbes.com/sites/jonathansalembaskin/2013/07/12/harley-davidson-will-be-a-case-history-in-social-branding>.

13. Indeed, a large percentage of athletes who complete the World Triathlon Corporation's Ironman races tattoo themselves with the M-Dot trademark. The M-Dot tattoo can symbolize, among other things, personal accomplishment or athletic prowess. See Nick Pauley, *Getting the M dot Ironman Tattoo*, IRONMARKETER (Aug. 23, 2013), <http://ironmarketer.net/2013/08/23/the-m-dot-ironman-tattoo>. While some people choose the original red M-Dot as a tattoo, others prefer more customized versions of the M-Dot. See, e.g., *Photo Gallery [sic]: the art of the Ironman tattoo or when a boring M-DOT just won't do*, EVERYMANTRI (May 16, 2010), http://www.everymantri.com/everyman_triathlon/2010/05/photo-gallery-the-art-of-the-ironman-tattoo-or-when-a-boring-mdot-just-wont-do.html.

Tattoos based on corporate and organizational trademarks raise legal concerns that will become more pervasive as tattoos continue to grow in popularity in the United States.¹⁴ Tattoos have, of course, existed for millennia, but they are becoming increasingly more common.¹⁵ The number of tattoo shops in the United States has grown from about 300 in the 1970s¹⁶ to more than 21,000 today.¹⁷ Roughly twenty percent of all American adults have at least one tattoo.¹⁸ That number increases to nearly forty percent for Millennials—Americans born from 1981 to 1991.¹⁹ Academic inquiry into the legal and sociopolitical implications of tattoos has grown significantly among groups of scholars; courts, too, will ultimately have to address the myriad issues raised by trademark tattoos.²⁰

The intersection between intellectual property law and tattoos became the critical issue in a recent lawsuit involving Mike Tyson's tribal face tattoo.²¹ There, S. Victor Whitmill, the tattoo artist who designed and inked Tyson's tattoo, sued Warner Bros. Entertainment, Inc. ("Warner Bros.") for copyright infringement because it planned to release a film where one of the actors bore a tattoo nearly identical to Tyson's facial tattoo.²² One of the pressing pre-trial issues stemmed from whether the tattoo could actually be subject to a copyright claim. Serving as an expert witness, Professor David Nimmer compared copyright ownership of tattoos on human skin to the badges of slavery prohibited under the Thirteenth Amendment.²³ The

14. See generally Aaron Perzanowski, *Tattoos & IP Norms*, 98 MINN. L. REV. 511 (2013) (analyzing the intersection of the tattoo industry and intellectual property law).

15. By way of comparison, 6% of Americans aged 65 and above have at least one tattoo, 15% of Americans aged 46-64 have at least one tattoo, and 32% of Americans aged 30-45 have at least one tattoo. See PEW RESEARCH CTR., *Millennials, A Portrait of Generation Next* 57 (Feb. 2010), <http://www.pewsocialtrends.org/files/2010/10/millennials-confident-connected-open-to-change.pdf>.

16. Matthew P. Blanchard, 'Grandfather' of tattooing in Philadelphia puts down the pen at convention, enthusiasts say goodbye to an era., PHILA. INQUIRER (Feb. 9, 2004), http://articles.philly.com/2004-02-09/news/25374750_1_national-tattoo-association-tattooing-equipment-tattoo-artist.

17. Jason Gale, *No Pain No Gain as Tattoo Regret Fueling Laser Removals*, BLOOMBERG (June 1, 2014, 7:21 PM), <http://www.bloomberg.com/news/articles/2014-06-01/no-pain-no-gain-as-tattoo-regret-fueling-laser-removals>.

18. See Samantha Braverman, *One in Five U.S. Adults Now Has a Tattoo*, THE HARRIS POLL (Feb. 23, 2012, 12:00 AM), http://www.theharrispoll.com/health-and-life/One_in_Five_U_S_Adults_Now_Has_a_Tattoo.html.

19. PEW RESEARCH CTR., *supra* note 15, at 57.

20. See Thomas F. Cotter & Angela M. Mirabole, *Written on the Body: Intellectual Property Rights in Tattoos, Makeup, and Other Body Art*, 10 UCLA ENT. L. REV. 97 (2003).

21. See Complaint at 1, *Whitmill v. Warner Bros. Entm't, Inc.*, (No. 4:11-CV-752 CDP), 2011 WL 2038147 (E.D. Mo. Apr. 28, 2011), *dismissed* (E.D. Mo. June 22, 2011) [hereinafter "Whitmill Complaint"].

22. *Id.* ¶¶ 4-7.

23. Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction, Declaration of David Nimmer, *Whitmill v. Warner Bros. Entm't, Inc.*, (No. 4:11-CV-752), 2011 WL 10744102 ¶ 45 (E.D. Mo. May 20, 2011) [hereinafter "Nimmer Declara-"]

Amendment, which declares that “[n]either slavery nor involuntary servitude . . . shall exist within the United States, or any place subject to their jurisdiction,”²⁴ had never been raised in this context before. Scholars have spilled much ink over the copyright questions raised by Professor Nimmer, but none have yet addressed the connection between trademark law, the Thirteenth Amendment, and slavery.²⁵

The purpose of this Article is to analyze trademark law and Thirteenth Amendment issues that arise when private individuals get tattoos that embody trademarks owned by others. This Article explores the trend toward broadening trademark protection for words, symbols, and other designations. It then examines the ways in which this broadening of trademark enforcement, coupled with current trademark enforcement mechanisms, may significantly diminish the autonomy of a person tattooed with a trademark owned by an unrelated person or entity. Finally, the Article explains why the Thirteenth Amendment cannot provide a basis for limiting trademark law’s current enforcement mechanisms when used against individuals tattooed with the trademarks of others.

Part I of this Article analyzes the practices of slave branding and current trademark-based tattoo practices, including skinvertising and tattoos based on uncompensated brand loyalty. It next summarizes current trademark law, with a particular focus on trademark enforcement and permissible remedies against putative infringers. It then outlines the contemporary use of trademarks as tattoos in modern society.

Part II of this Article analyzes the rights granted to trademark owners and the ways such owners may enforce those rights against tattooed parties. In particular, it discusses the impracticality of applying traditional trademark infringement principles to alleged or actual infringers.

tion”] (“As applied to tattoos, the only legally cognizable result is to apply the strict requirement of physical separability. Such a construction is necessary to avoid the constitutional infirmity that would arise if the Copyright Act attempted to set at naught the Thirteenth Amendment’s prohibition of badges of slavery.”).

24. U.S. CONST. amend. XIII, § 1.

25. See, e.g., Matthew Beasley, *Who Owns Your Skin: Intellectual Property Law and Norms Among Tattoo Artists*, 85 S. CAL. L. REV. 1137 (2012); Craig P. Bloom, *Hangover Effect: May I See Your Tattoo, Please*, 31 CARDOZO ARTS & ENT. L.J. 435, 439 (2013); David M. Cummings, *Creative Expression and the Human Canvas: An Examination of Tattoos As A Copyrightable Art Form*, 2013 U. ILL. L. REV. 279 (2013); Christopher A. Harkins, *Tattoos and Copyright Infringement: Celebrities, Marketers, and Businesses Beware of the Ink*, 10 LEWIS & CLARK L. REV. 313 (2006); Meredith Hatic, *Who Owns Your Body Art?: The Copyright and Constitutional Implications of Tattoos*, 23 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 396, 397 (2012); Yolanda M. King, *The Challenges “Facing” Copyright Protection for Tattoos*, 92 OR. L. REV. 129 (2013); Christine Lesicko, *Tattoos As Visual Art: How Body Art Fits into the Visual Artists Rights Act*, 53 IDEA 39 (2013); see also Cotter & Mirabole, *supra* note 20. Most have determined that the Thirteenth Amendment either does not apply at all, or is only relevant with respect to copyright enforcement measures.

Part III of this Article contends that the Thirteenth Amendment is not the appropriate vehicle to insulate tattooed infringers from trademark infringement liability. Though Congress is empowered under the Amendment to abolish all badges and incidents of slavery, even the broadest interpretation does not support Professor Nimmer's view that the Thirteenth Amendment precludes intellectual property enforcement against tattoos.

This Article concludes that, while it is impossible to wholly prohibit people from permanently inking trademarks on their bodies, current trademark law is ill equipped to resolve trademark infringement problems involving tattoos. The expansion of trademark rights and enforcement measures pose threats to the growing number of American citizens with tattoos that may subject them to civil liability under trademark infringement and/or trademark dilution principles. Similarly, the blurred lines between private control and personal autonomy raise serious concerns that cannot be addressed using the Thirteenth Amendment.

I. THE TRADEMARK'S JOURNEY FROM ENSLAVED SKIN TO AUTONOMOUS SKIN

This Part outlines the basic historical, legal and policy issues associated with the practice of placing identifying indicia on human bodies. This practice predates modern American trademark law and can be traced to the days of African and African-American enslavement in the United States. The permanent, forced body modification of slaves was an early precursor to contemporary American use of trademarks as tattoos. As more Americans voluntarily tattoo their bodies today, a growing segment of this tattooed population encompasses brand enthusiasts who choose to permanently ink their bodies with the trademarks of their favorite companies and brands and copyright-protected images. Coupled with this trend, disputes based on tattoos encompassing the intellectual property of third parties have also grown in recent years.²⁶ In perhaps one of the most famous lawsuits based on tattoos and intellectual property, *Whitmill v. Warner Bros.*, Professor David Nimmer posited that the rights of intellectual property owners should not extend to human flesh, because to do so would create "almost literally, a badge of involuntary servitude."²⁷ Otherwise, he argued, the law would "set at naught the Thirteenth Amendment's prohibition of badges of slavery."²⁸ Though

26. See, e.g., Complaint, *Escobedo v. THQ*, (2:12-CV-02470-JAT), (D. Ariz. Nov. 16, 2012); Complaint, *Reed v. Nike, Inc.*, (3:05-CV-00198), 2005 WL 1182840 (D. Or. Feb. 10, 2005), *dismissed* (D. Or. Oct. 19, 2005); *Dennis Rodman v. Fanatix Apparel, Inc.*, Case No. 96-2103 (D.N.J. May 28, 1996).

27. See Nimmer Declaration, *supra* note 23, at 20. *Whitmill* was based on a tattoo [allegedly] protected under copyright law, though many of the undesirable consequences imagined by Professor Nimmer would also extend to tattoos embodying the trademarks of third parties.

28. *Id.* at 45.

tenuous, it is understandable why Professor Nimmer would draw connections between contemporary trademark-based tattoos and the Thirteenth Amendment's prohibition of slavery. His suggestion, however, provides scant historical or factual foundation. This Part will lay the groundwork implicit in such claims before ultimately explaining why the connection is inappropriate in the modern context of trademark-based tattoos.

A. *The History of Branding African and African-American Slaves with Primitive Trademarks*

Though tattooing words and symbols on human bodies has become increasingly popular in recent decades, it is not a new practice. African and African-American slaves routinely had the initials or other identifying indicia of their slave masters permanently branded on their skin.²⁹ These involuntary "trademarks" were placed on slaves both for purposes of punishment and identification.³⁰

Prior to the passage of state and federal trademark law, slave owners used trademarks as a way to distinguish their human property from the property of other slave masters. Branding as a mechanism for distinguishing human property began in 2000-1800 B.C. with Babylonian slaves.³¹ Within the Transatlantic slave trade, the practice dates back to at least as early as the 1440s, when the Portuguese branded African slaves' upper bodies to indicate that the slaves belonged to the king of Portugal or another slave owner.³² During the time period of African slave trafficking, each European nation had its own trademark used to mark African slaves.³³ Discussing the early history of slave branding, one scholar outlined the many ways in which slave branding took place:

[S]laves landed at São Tome were branded with a cross on the right arm in the early sixteenth century; but, later, this design was changed to a 'G,' the marca de Guiné. Slaves exported from Luanda were often branded not once but twice, for they had to receive the mark of the Luso-Brazilian merchants who owned them as well as the royal arms—on the right breast—to signify their relation to the Crown. Sometimes, baptism led to the further branding of a cross

29. See CHARLES M. CHRISTIAN ET AL., *BLACK SAGA: THE AFRICAN AMERICAN EXPERIENCE: A CHRONOLOGY* 102-03 (1998); see also *Branding Iron*, UNDERSTANDING SLAVERY INITIATIVE, http://www.understandingslavery.com/index.php?option=com_content&view=article&id=622:branding-iron&Itemid=256 (last visited Apr. 26, 2016).

30. See Leonard Hoenig, *The Branding of African American Slaves*, 148 *JAMA DERMATOLOGY* 271 (2012).

31. See SIMON J. BRONNER, *ENCYCLOPEDIA OF AMERICAN FOLKLIFE* 124 (2006) (stating that the "earliest known branding iron designed for use on humans bear the words 'I am his slave' in cuneiform and dates from 2000-1800 B.C.E. in Babylonia").

32. See HUGH THOMAS, *THE SLAVE TRADE* 396 (1999).

33. See *id.*

over the royal design. Slaves of the Royal Africa Company were marked, with a burning iron upon the right breast, ‘DY,’ duke of York, after the chairman of the company. In the late eighteenth century, a ‘G’ would indicate that the slave concerned had been marked by the Compañía Gaditana, the Cádiz company concerned to import slaves into Havana in the late 1760s.³⁴

The use of branding significantly decreased after the United States and England made the importation of African slaves illegal in 1807 and 1808, but it was revived after the illegal slave trade in the American South, Brazil, and Cuba became commonplace.³⁵ Frederick Douglass described the process of American slave branding in 1846 in England: “[a] person was tied to a post, and his back, or such other part as was to be branded, laid bare; the iron was then delivered red hot (sensation), and applied to the quivering flesh, imprinting upon it the name of the monster who claimed the slave.”³⁶

Of course, modern trademark law did not exist during this era, but Anglo-American law recognized the use of trademarks to identify and distinguish goods in the marketplace as early as the sixteenth century.³⁷ It is clear that slave owners used trademark-like branding to identify certain slaves as their property and ensure that others could not claim ownership over those slaves.³⁸ In one 1838 advertisement for a runaway slave, the slave’s owner, Micajah Ricks of North Carolina, stated that “the woman is tall and black, and a few days before she went off, I burnt her with a hot iron on the left side of her face; I tried to make the letter M”³⁹ This “M” presumably represented the slave owner’s first name, “Micajah.” Similarly, a slave

34. *Id.*

35. KYM S. RICE & MARTHA B. KATZ-HYMAN, *WORLD OF A SLAVE* 78 (2010). Indeed, there are many recorded instances of runaway slaves being found and identified by the brands appearing on their bodies. *See, e.g.*, PEDRO FUNARI & CHARLES ORSER, *CURRENT PERSPECTIVES ON THE ARCHAEOLOGY OF AFRICAN SLAVERY IN LATIN AMERICA* 53 (2015) (recounting Cuban slave records from 1805 and 1806 where a captured slave was described as “38 years old, tall and thin, deep black colored, scanty beard, friendly eyes, filed teeth, with a *D* on his right breast, confessing he belonged to Don Pedro Diago”).

36. FREDERICK DOUGLASS & JOHN W. BLASSINGAME, *THE FREDERICK DOUGLASS PAPERS* 377-78 (Yale University Press 1985).

37. *See, e.g.*, Sanforth’s Case, Cory’s Entries, BL MS. Hargrave 123, fo. 168 (1584), (providing a portion of the complaint), *reprinted in* J.H. BAKER & S.F.C. MILSOM, *SOURCES OF ENGLISH LEGAL HISTORY - PRIVATE LAW TO 1750* 615-18 (1986); Keith M. Stolte, *How Early Did Anglo-American Trademark Law Begin? An Answer to Schechter’s Conundrum*, 8 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 505 (1998).

38. *See* Hoenig *supra* note 30; BETTY WOOD, *SLAVERY IN COLONIAL AMERICA 1619-1776* 29 (2005); MARCUS WOOD, *BLIND MEMORY: VISUAL REPRESENTATIONS OF SLAVERY IN ENGLAND AND AMERICA 1780-1865*, 249-50 (2000).

39. THEODORE WELD, *AMERICAN SLAVERY AS IT IS: TESTIMONY OF A THOUSAND WITNESSES* 152 (1968). The actual advertisement can be viewed online through the North Carolina Runaway Slave Advertisements project website. *\$20 reward in Nash County*, NORTH CAROLINA RUNAWAY SLAVE ADVERTISEMENTS, <http://libcdm1.uncg.edu/cdm/singleitem/collection/RAS/id/199/rec/1> (last visited Apr. 24, 2016).

owner from Kentucky was documented as stating that his slave, Jane, bore his “brand mark on the breast something like L blotched.”⁴⁰

In this way, slave owners used their own identifying indicia and trademarks to distinguish their slaves from others and indicate to whom those slaves belonged. The Thirteenth Amendment, of course, abolished slavery and its related practices in 1865.⁴¹ Roughly five years later, in 1870, Congress enacted the first federal trademark statute.⁴²

B. Contemporary Trademark Law Landscape

Prior to the enactment of a federal trademark statute, American trademark law’s fundamental purpose was to prevent unapproved parties from using trademarks in connection with goods or services that the trademark owner neither created nor sanctioned.⁴³ Early case law supported the view that a trademark’s critical purpose was to protect the goodwill and reputation that it signified.⁴⁴ Scholars of the mid-nineteenth century agreed, noting that, “to the end that [trademarks] may be known in the market . . . [they] enable [a trademark owner] to secure such profits as result from a reputation for superior skill, industry or enterprise.”⁴⁵ Because there was no federal law unifying these principles nationwide, however, trademark protection lacked uniformity and was wholly dependent on intrastate commerce.⁴⁶ Early American trademark law was based primarily on judicial decisions, but to the extent that statutes existed, they were based on state law.⁴⁷

In 1870, Congress enacted the first federal trademark statute to provide a nationwide registration system for trademarks used in intrastate or interstate commerce.⁴⁸ The Supreme Court struck down the statute because it found that the Copyright Clause of the Constitution did not provide Con-

40. Scott W. Howe, *Slavery As Punishment: Original Public Meaning, Cruel and Unusual Punishment, and the Neglected Clause in the Thirteenth Amendment*, 51 ARIZ. L. REV. 983, 998 (2009).

41. See U.S. CONST. amend. XIII.

42. Act of July 8, 1870, 16 Stat. 198, §§ 77-84, entitled “An Act to Revise, Consolidate and Amend the Statutes Relating to Patents and Copyrights,” *invalidated* by Trade-Mark Cases, 100 U.S. 82, 99 (1879). Prior to this time, American trademark law stemmed predominantly from the common law and judicial decisions. See Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1859 & n.82 (2007).

43. See McKenna, *supra* note 42, at 1858-59; R. Darryl Burke, *Intellectual Property*, 29 TEX. TECH L. REV. 711, 715 (1998).

44. See, e.g., *Partridge v. Menck*, 2 Barb. Ch. 101, 103 (N.Y. Ch. 1847) (noting that the complainant was “entitled to protection against any other person who attempts to pirate upon the goodwill of the complainant’s friends or customers, or of the patrons of his trade or business, by sailing under his flag without his authority or consent”).

45. FRANCIS H. UPTON, A TREATISE ON THE LAW OF TRADE MARKS 2 (1860).

46. See McKenna, *supra* note 42, at 1859 & n.82.

47. *Id.*

48. *In re Trade-Mark Cases*, 100 U.S. 82, 88-89 (1879).

gress with the power to regulate trademarks.⁴⁹ In 1881, Congress made a second attempt to create a federal trademark statute based on its Commerce Clause powers, though it did not purport to create a nationwide trademark registry.⁵⁰ Congress did not create the first modern federal registration statute regulating interstate commerce until 1905.⁵¹ The statute was heavily revised over the years to remedy perceived inadequacies, ultimately culminating with the enactment of the Lanham Trademark Act, which took effect on July 5, 1947 and still applies today.⁵²

The Lanham Act, over time, expanded the goals of modern trademark law to protect (1) the trademark owner's property and the goodwill and reputation developed in the trademark, *and* (2) the consuming public from confusion over trademarks being used in the marketplace.⁵³ The Lanham Act also expanded the definition of what is protectable, and thus registerable, as a trademark under federal law. The 1905 commerce Act limited registration to "technical common-law trademarks" that were fanciful or arbitrary.⁵⁴ Under today's Lanham Act, the definition of the term trademark includes "any word, name, symbol, or device, or any combination thereof [used] to identify and distinguish [the trademark owner's] goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."⁵⁵ Something may be classified as a trademark if it is inherently distinctive, as in the case of arbitrary, fanciful or suggestive trademarks, or if it has acquired distinctiveness through secondary meaning, as in the case of descriptive trademarks.⁵⁶

Courts have broadly interpreted this definition—nearly any thing can serve as a trademark.⁵⁷ In addition to traditional identifying indicia of trademarks like letters, words, symbols and logos, the United States Patent and

49. *See id.* at 93-94.

50. *See* Zvi S. Rosen, *In Search of the Trade-Mark Cases: The Nascent Treaty Power and the Turbulent Origins of Federal Trademark Law*, 83 ST. JOHN'S L. REV. 827, 829 (2009) (stating that "the 1881 legislation was enacted to call into effect the treaty obligations of the United States regarding trademarks, not to create a domestic trademark system").

51. This Act was entitled "An Act to authorize the registration of trademarks used in commerce with foreign nations or among the several States or with Indian Tribes, and to protect the same." Act of Feb. 20, 1905, 33 Stat. 724, 15 U.S.C. §§ 81-134.

52. *See* 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:4 (4th ed. 2004).

53. MCCARTHY, *supra* note 52, § 2.2.

54. MCCARTHY, *supra* note 52, § 5.3. Fanciful trademarks include words that are made up or chosen solely for trademark purposes, and arbitrary trademarks are real words that have no meaning as connected to the offered products or services. *See* MCCARTHY, *supra* note 52, at §§ 11:5-14. In addition, personal names, names of corporations, and primarily geographical terms were not protectable under the 1905 Act. *Id.*

55. 15 U.S.C. § 1127 (2012).

56. MCCARTHY, *supra* note 52, § 4:12.

57. *See* *Qualitex v. Jacobsen*, 514 U.S. 159, 162 (1998) (noting that, "[s]ince human beings might use as a 'symbol' or 'device,' almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive").

Trademark Office (“USPTO”) has found permissible trademarks to include certain spoken words (“WOO HOO!” for lottery services);⁵⁸ certain distinctive sounds (“the sound of methamphetamine which starts with the flick of a lighter, followed by the fizzing sound of a small flame ignition, and high pitched metallic crackling sounds”);⁵⁹ and even live animals (“goats on a roof of grass” for the rooftop of a restaurant).⁶⁰ As such, the potential universe of protectable trademarks is limited only by human ingenuity and technology. Once a party establishes ownership in a protectable trademark, it can enforce its trademark rights using a variety of vehicles.

1. Enforcing Trademark Rights Against Putative Infringers

State and federal law offer several causes of action based on the unauthorized use of trademarks. The two primary causes of action are trademark infringement and trademark dilution.⁶¹ Though infringement and dilution protect against different types of trademarks and activities, the remedies for both include injunctive and monetary relief.

The first way to enforce trademark rights is through a cause of action for trademark infringement. Trademark infringement exists where there is an unsanctioned use of a trademark that “is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association” of the putative infringer with the trademark’s owner.⁶² This “likelihood of confusion” standard for trademark infringement applies to registered and unregistered trademarks.⁶³ Regarding trademarks that have been federally registered, the Lanham Act requires a determination of whether the putative infringer’s conduct is “likely to cause confusion, or to cause mistake, or to deceive.”⁶⁴ For unregistered marks, the Lanham Act similarly asks whether the putative infringer’s conduct “is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association” of the putative infringer with the trademark owner.⁶⁵ State law is generally consistent with federal law in regards to standards for trademark infringement. In fact, most courts faced with both federal and state law trademark infringement claims use a single likelihood of confusion analysis in assessing a putative infringer’s conduct.⁶⁶

58. U.S. Trademark Application Serial No. 3,461,451 (filed Nov. 6, 2007).

59. U.S. Trademark Application Serial No. 3,582,216 (filed Aug. 30, 2007).

60. U.S. Trademark Application Serial No. 2,007,624 (filed Feb. 27, 1995).

61. Other common causes of action include unfair competition, false advertising, and counterfeiting. *See, e.g.,* Katja Weckström, *Secondary Liability for Trademark Infringement in the United States*, 49 U. LOUISVILLE L. REV. 555, 579 (2011).

62. McCARTHY, *supra* note 52, § 23.1 (citing 15 U.S.C. § 1125(a) (2012)).

63. *See id.*

64. *Id.* (citing 15 U.S.C. § 1114(1) (2005)).

65. *Id.* (citing 15 U.S.C. § 1125(a) (2012)).

66. *See* McCARTHY, *supra* note 52, § 23:1.50.

The legal principle of confusion can take many forms, including point of sale confusion, initial interest confusion, post-sale confusion, or confusion as to affiliation, connection, or sponsorship.⁶⁷ The confused party may be an actual consumer, a potential consumer, or general member of the public who has never purchased the relevant goods or services.⁶⁸

The most common type of trademark confusion is point of sale confusion, which occurs when a consumer is confused about the source of the goods or services at the time that she makes the purchase.⁶⁹ Initial interest confusion, on the other hand, may afflict potential purchasers; this confusion occurs when a putative infringer uses the “trademark in a manner calculated to capture initial consumer attention, even though no actual sale is finally completed as a result of the confusion.”⁷⁰ Even non-purchasing members of the general public can experience actionable trademark confusion through post-sale confusion. In the seminal “post-sale confusion” case, *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-LeCoultre Watches, Inc.*, the defendant copied the trademark-protected appearance of a high-end Atmos clock and sold it at a much cheaper price.⁷¹ In finding the defendant liable for trademark infringement, the court noted that:

[S]ome customers would buy the . . . cheaper clock for the purpose of acquiring the prestige gained by displaying what many visitors at the customers’ homes would regard as a prestigious article. [The] wrong thus consisted of the fact that such a visitor would be likely to assume that the clock was an Atmos clock.⁷²

Lastly, confusion as to affiliation, connection, or sponsorship illustrates the broad reach of trademark enforcement. Oftentimes this type of confusion is demonstrated by inquiring whether consumers believe permission is required to use the trademark in question.⁷³ Confusion as to affiliation, connection, or

67. See generally McCARTHY, *supra* note 52, §§ 23:5-8.

68. McCARTHY, *supra* note 52, § 23:5.

69. See *id.*; see also Connie Davis Powell, *We All Know It’s A Knock-Off! Re-Evaluating the Need for the Post-Sale Confusion Doctrine in Trademark Law*, 14 N.C.J.L. & TECH. 1 (2012).

70. *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1144 (9th Cir. 2011) (quoting *Nissan Motor Co. v. Nissan Comput. Corp.*, 378 F.3d 1002, 1018 (9th Cir. 2004)).

71. 221 F.2d 464, 467 (2d Cir. 1955).

72. *Id.* at 466.

73. Scholars have noted the “chicken and egg conundrum” of such a scenario where, “[i]f consumers think that most uses of a trademark require authorization, then in fact they will require authorization because the owner can enjoin consumer confusion caused by unpermitted uses or charge for licenses. And if owners can sue to stop unauthorized uses, then only authorized uses will be seen by consumers, creating or reinforcing their perception that authorization is necessary.” McCARTHY, *supra* note 52, § 24:9.

sponsorship may even apply in a situation where the trademark owner's product is no longer being manufactured.⁷⁴

Once the type of confusion has been determined, jurisdictions apply multi-factor tests designed to predict whether a likelihood of confusion exists.⁷⁵ While each jurisdictional test has its own idiosyncrasies, the foundational factors include:

- (1) The degree of resemblance between the conflicting designations,
- (2) The similarity of the marketing methods and channels of distribution,
- (3) The characteristics of the prospective purchasers and the degree of care they exercise,
- (4) The degree of distinctiveness of the senior user's mark,
- (5) Where the goods or services are not competitive, the likelihood that prospective buyers would expect the senior user to expand into the field of the junior user,
- (6) Where the goods or services are sold in different territories, the extent to which the senior user's designation is known in the junior user's territory,
- (7) The intent of the junior user, and
- (8) Evidence of actual confusion.⁷⁶

These factors, however, are not to be applied in rigid mathematical fashion. They are guidelines with highly factually specific application.⁷⁷

Trademark infringement predicated on the theory of confusion also requires that the putative infringer's conduct be connected to the commercial nature of goods or services. With respect to registered trademarks, the use must cause a likelihood of confusion "in connection with the sale, offering

If consumers think that most uses of a trademark require authorization, then in fact they will require authorization because the owner can enjoin consumer confusion caused by unpermitted uses or charge for licenses. And if owners can sue to stop unauthorized uses, then only authorized uses will be seen by consumers, creating or reinforcing their perception that authorization is necessary.

McCARTHY, *supra* note 52, § 24:9.

74. See McCARTHY, *supra* note 52, § 23:8. In one popular case, the Sixth Circuit held that the defendant's unauthorized replicas of Ferrari's Testarossa constituted trademark infringement, even though Ferrari stopped producing the Testarossa after the 5000th car was manufactured in 1984. *Ferrari S.P.A. v. Roberts*, 944 F.2d 1235, 1238 (6th Cir. 1991).

75. See McCARTHY, *supra* note 52, § 24:28 (noting that most "tests have about eight factors to consider and the number of factors varies slightly among the 13 federal circuits").

76. McCARTHY, *supra* note 52, § 24:29 (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 20-23 (1995)).

77. McCARTHY, *supra* note 52, § 24:28.

for sale, distribution or advertising of any goods or services.”⁷⁸ For unregistered trademarks, the use must be likely to cause confusion, mistake, or deceive “as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.”⁷⁹

The second way to enforce trademark rights is through a cause of action for trademark dilution. The concept of dilution is a separate basis of trademark enforcement that is relatively new.⁸⁰ The first federal law related to trademark dilution was not enacted until 1996, and it was significantly modified in 2006.⁸¹ Trademark dilution is not based on consumer confusion, but is instead designed to combat the weakening of a famous trademark’s ability to identify and distinguish goods and services in the marketplace.

Dilution allows the owner of a famous trademark to enjoin unauthorized commercial uses of that trademark, whether or not a likelihood of confusion exists.⁸² Under federal law, the 2006 Trademark Dilution Revision Act (“TDRA”) only extends dilution to so-called “famous” trademarks.⁸³ A mark is considered famous “if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.”⁸⁴

Once it has been determined that a trademark is famous, the trademark owner has two avenues to present a trademark dilution cause of action: dilution by blurring and dilution by tarnishment. Dilution by blurring destroys a trademark owner’s rights in a trademark by obscuring “its product identification or by damaging positive associations that have attached to it.”⁸⁵ Dilution by blurring claims are more common than dilution by tarnishment claims.⁸⁶

78. 15 U.S.C. § 1114(1) (2012).

79. 15 U.S.C. § 1125(a)(1)(A) (2012).

80. Frank Schechter first proposed the concept of dilution in 1927. *See* McCARTHY, *supra* note 52, § 24:67.

81. McCARTHY, *supra* note 52, § 24:67. Before 1996, antidilution statutes were creatures of state statutory law. *Id.*

82. *Tecip Holding Co. v. Haar Commc’ns Inc.*, 244 F.3d 88, 95 (2d Cir. 2001).

83. 15 U.S.C. § 1125(c) (2012). Because of the myriad state-law standards related to dilution, this Article will focus only on federal dilution law.

84. 15 U.S.C. § 1125(c)(2)(A) (2012).

85. *Ameritech, Inc. v. Am. Info. Techs. Corp.*, 811 F.2d 960, 965 (6th Cir. 1987).

86. *See, e.g., Pfizer Inc. v. Sachs*, 652 F. Supp. 2d 512 (S.D.N.Y. 2009) (VIAGRA trademark tarnished where defendant’s use consisted of creating a twenty-foot missile featuring the VIAGRA trademark and parking it in Manhattan while women rode the missile and distributed condoms); *Coca-Cola Co. v. Alma-Leo U.S.A., Inc.*, 719 F. Supp. 725 (N.D. Ill. 1989) (dilution by tarnishment existed where a white candy powder that looked like cocaine was sold in a bottle resembling the Coca-Cola bottle, which is protected by trademark law); *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972) (dilution by tarnishment found where defendant created and sold posters featuring the words ENJOY COCAINE in Coca-Cola’s trademarked Spenserian script in red and white).

Dilution by tarnishment occurs where a trademark is used without permission in a way that degrades and causes reputational harm to the trademark.⁸⁷

The Lanham Act provides some guidance for determining whether dilution by blurring exists, but it does not provide the same guidance for a determination of dilution by tarnishment. Regarding dilution by blurring, courts may assess all relevant factors, including the following:

- (i) The degree of similarity between the mark or trade name and the famous mark,
- (ii) The degree of inherent or acquired distinctiveness of the famous mark,
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark,
- (iv) The degree of recognition of the famous mark,
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark,
- (vi) Any actual association between the mark or trade name and the famous mark.⁸⁸

Though there are no statutory guidelines with respect to tarnishment, courts have noted that “[a] trademark may be tarnished when it is linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context, with the result that the public will associate the lack of quality or lack of prestige in the defendant’s goods with the plaintiff’s unrelated goods.”⁸⁹ In addition, a trademark may also be tarnished “if the mark loses its ability to serve as a ‘wholesome identifier’” of the trademark owner’s goods or services.⁹⁰ Finally, certain forms of trademark utilization, including fair use, news reporting and commentary, and noncommercial uses, are not actionable under either theory of dilution.⁹¹

2. Remedies Available Against Proven Infringers

The structure of trademark remedies allows for injunctive relief and monetary recovery, depending on the facts and circumstances of each case. Successful trademark owners are typically awarded injunctive relief to eliminate infringement and/or dilutive conduct.⁹² Monetary relief for trademark

87. *See id.*

88. 15 U.S.C. § 1125(c)(2)(B) (2012).

89. *Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497, 507 (2d Cir. 1996) (quoting *Deere & Co. v. MTD Prods.*, 41 F.3d 39, 43 (2d Cir. 1994)).

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

91. 15 U.S.C. § 1125(c)(3) (2012).

92. *Overview of Trademark Law*, BERKMAN CENTER FOR INTERNET AND SOCIETY AT HARVARD UNIVERSITY, <https://cyber.law.harvard.edu/metaschool/fisher/domain/tm.htm#11> (last visited Apr. 15, 2016).

infringement under the Lanham Act is cumulative and includes profits, damages, reasonable attorney fees in “exceptional cases,” and costs.⁹³ Historically, however, monetary remedies have been rare.⁹⁴ In trademark dilution suits, damages are permissible only in cases where the infringer “willfully intended” to trade on the recognition of the famous mark (in the instance of dilution by blurring) or to harm the reputation of the famous mark (in the instance of dilution by tarnishment).⁹⁵

Permanent injunctive relief is the most common remedy in trademark infringement and dilution suits. Monetary relief is generally considered inadequate, primarily because reputational and good will-related harm is not compensable.⁹⁶ The scope of injunctive relief must be tailored to fit the facts and circumstances of the case.⁹⁷ Courts consider, at minimum, “the manner in which the [trademark owner] is harmed, the possible means by which the harm can be avoided, the justification advanced for the [infringer’s] conduct, the potential burden that would be imposed on the legitimate interests of the [trademark owner], and the potential effect upon lawful competition between the parties.”⁹⁸ The First Amendment may also be relevant under certain circumstances, as speech-based restrictions may infringe upon the right of free expression.⁹⁹

C. Contemporary Use of Trademarks as Tattoos in the United States

In contrast to the pre-American Civil War period, parties who permanently place trademarks on their bodies now generally do so based on their own free will and not because a slave owner has forced them to.¹⁰⁰ Some

93. 15 U.S.C. § 1117 (2012). Under certain extenuating circumstances, treble damages may also be awarded. *Id.*

94. See Andrew W. Carter & Gregory M. Remec, *Monetary Awards for Trademark Infringement under the Lanham Act*, 86 TRADEMARK REP. 464 (1996). For example, from the period between 1946 and 1995, monetary relief was only granted in 125 cases. *Id.* at 465. One scholar has even gone as far to note that “[t]he Lanham Act’s monetary relief rules are an abject failure.” Mark A. Thurmon, *Federal Trademark Remedies: A Proposal for Reform*, 5 AKRON INTELL. PROP. J. 137, 138 (2011).

95. 15 U.S.C. § 1125 (2012). State statutes rarely provide for the collection of monetary damages in dilution actions. *Trademark Dilution*, BITLAW, <http://www.bitlaw.com/trademark/dilution.html> (last visited April 25, 2016).

96. See McCARTHY, *supra* note 52, § 30:1 (comparing damages for reputational harm to trying to “un-ring a bell”).

97. McCARTHY, *supra* note 52, § 30:3.

98. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 35 cmt. c (1995).

99. *Id.* (“Although market participants do not have a constitutional right to engage in deceptive or confusing commercial speech, restrictions on speech that extend beyond those reasonably necessary to prevent the wrongful conduct may infringe on protected rights.”).

100. But see Mia De Graff, *The return of slave-branding*, DAILY MAIL (Sept. 6, 2015, 10:09 PM), <http://www.dailymail.co.uk/news/article-3224738/Modern-day-sex-traffickers-bringing-branding-used-slaves-having-names-insignia-tattooed-victims-mark-property.html> (noting that “[m]odern-day sex traffickers are . . . [forcing girls] to get a tattoo of their pimp’s name or insignia to mark them out as his ‘property’”).

people get trademark tattoos because they are paid for skinvertising, while others are merely unpaid brand enthusiasts.

Skinvertisements became popular during the dotcom era of the early 2000s.¹⁰¹ The first such instance of “skinvertising” involved a man named Jim Nelson selling space on the back of his head to CI Host, a now-defunct web hosting company.¹⁰² A few years later, a single mother in Utah sold the space on her forehead to GoldenPalace.com in exchange for \$10,000.¹⁰³ Other individuals, like Billy Gibby¹⁰⁴ and Joe Tamargo,¹⁰⁵ have allegedly made hundreds of thousands of dollars auctioning off their skin to potential skinvertisers. The dotcom skinvertisement boom eventually died in the late 2000s (along with many of the dotcom companies who paid for such skinvertisements) and has all but fallen into obscurity.¹⁰⁶

There may, however, be a burgeoning renaissance among trademark tattoos through professional sports and athletes. Beyond the realm of dotcom skinvertisements, sports-related skinvertising has been likened to ambush marketing, where “companies attempt to make the consumer think their product or service is somehow affiliated with a popular sporting event or league.”¹⁰⁷ The purpose of such marketing is to take advantage of large-scale viewership without going through the bureaucracy of obtaining permission from the sports league or other organizers.¹⁰⁸ Ambush marketing also diminishes a company’s willingness to spend large sums of money on advertisement and sponsor fees when it can obtain similar results through skinvertising at a lower cost.¹⁰⁹

Professional sports leagues have taken a wide variety of approaches to such athlete endorsements. In 2001, the boxing industry was faced with the question of whether to allow boxers to wear temporary tattoos during matches.¹¹⁰ The first instance came when Bernard Hopkins was paid roughly

101. Guarini, *supra* note 9.

102. *Past their sell by dates: Meet the people branded for life with tattoos advertising websites that no longer exist*, DAILY MAIL (Sept. 27, 2012, 12:19 AM), <http://www.dailymail.co.uk/news/article-2209233/The-body-billboard-The-people-dotcom-tattoos-advertising-websites-longer-exist.html>.

103. Guarini, *supra* note 9.

104. *Id.* (noting that Gibby’s website offered prices for advertising on his body through permanent tattoos).

105. See *Past their sell by dates*, *supra* note 102.

106. Some enterprising entrepreneurs still auction off skin space for advertisement purposes. See, e.g., Joe Lawler, *Professional wrestler inks deal with Lucky Gal Tattoo*, DES MOINES REGISTER (Nov. 1, 2013), <http://archive.desmoinesregister.com/article/20131101/NEWS/311010056/Professional-wrestler-inks-deal-Lucky-Gal-Tattoo>.

107. John Vukelj, *Post No Bills: Can the NBA Prohibit Its Players from Wearing Tattoo Advertisements?*, 15 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 507, 518 (2005).

108. *Id.*

109. Patrick Donohue Sheridan, *An Olympic Solution to Ambush Marketing: How the London Olympics Show the Way to More Effective Trademark Law*, 17 SPORTS LAW J. 27, 28 (2010).

110. See Vukelj, *supra* note 107, at 509.

\$100,000 by GoldenPalace.com to wear a temporary tattoo across his back during a boxing match.¹¹¹ This display was, from a business perspective, a wildly successful marketing effort—many news outlets devoted a large amount of screen time to the appropriateness of skinvertising.¹¹² The Nevada Athletic Commission (“NAC”), however, disagreed and banned skinvertisements on boxers.¹¹³ The following year, the NAC was sued by Clarence Adams, who wanted to wear a similar GoldenPalace.com tattoo.¹¹⁴ Adams was ultimately granted a preliminary injunction by the Clark County District Court, which apparently noted that “the ban was a violation of the boxers’ First Amendment rights and therefore could not be enforced.”¹¹⁵ Thereafter, Todd Bridges, Danny Bonaduce, and Tonya Harding wore GoldenPalace.com tattoos during *Celebrity Boxing*, a television show on the Fox network.¹¹⁶ Both ESPN and Fox Sports were displeased by GoldenPalace.com’s circumventing the payment of advertisement and sponsorship fees, and both eventually banned skinvertising.¹¹⁷

Most notably, the National Basketball Association (“NBA”) has taken affirmative steps to prohibit skinvertising, even though no player to date has affirmatively obtained a tattoo for the express purpose of skinvertising.¹¹⁸ The NBA Collective Bargaining Agreement states that “a player may not, during any NBA game, display any commercial, promotional, or charitable name, mark, logo or other identification, including but not limited to on his body, in his hair, or otherwise.”¹¹⁹ NBA players, therefore, are expressly prohibited from wearing skinvertisements during games.

NBA players have already experienced the commercial implications of bearing trademark tattoos.¹²⁰ In 2009, Marcin Gortat, a NBA player for the

111. Hilary Cassidy, *Roll (Dice) with the Punches: When an Online Casino Sends a Fighter into the Ring with its Ad Tattooed on His Back, He Upsets His Opponents, the Boxing Community and ESPN*, BRANDWEEK, Dec. 9, 2002, at 22.

112. Zachary Crockett, *How An Illegal Gambling Website Became The King Of Marketing*, PRICEONOMICS (Nov. 18, 2014), <http://priceonomics.com/the-rogue-marketing-of-golden-palacecom/>.

113. *Id.*

114. Vukelj, *supra* note 107, at 511-12. The NAC gave three reasons for the decision to ban skinvertisements: “(1) that the tattoos could distract judges; (2) that the ink might get into the opponent’s eyes; and (3) that tattoo advertisements are demeaning to the sport of boxing.” *Id.*

115. *Id.* at 512.

116. *Id.* at 513 (noting that more than “fifteen million viewers in the United States saw the program on Fox, and visitors to the GoldenPalace.com web site reportedly rose 200% in the twenty-four hour period following the show”).

117. *Id.*

118. Players have, of course, obtained tattoos for purposes of brand loyalty. *See infra*, notes 121-125 and accompanying text.

119. National Basketball Association Collective Bargaining Agreement, art. XXXVII, § 3(b) (Dec. 2011) (emphasis added), <http://nbpa.com/cba/>.

120. More than half of all NBA players have visible tattoos. *See* Mike Wilson, *What Ethan Swan Learned From Tracking Every Tattoo in the NBA*, FIVETHIRTYEIGHT (June 6,

Orlando Magic, famously made headlines because of the Nike Jumpman tattoo that appears on his lower right leg.¹²¹ According to some reports, Reebok International Ltd., a sportswear company, signed Gortat to an endorsement deal presumably without knowing that he had the Jumpman tattoo.¹²² Shortly thereafter, Gortat's photo appeared in a Polish newspaper with the tattoo prominently displayed.¹²³ Reebok asked Gortat to cover the tattoo during basketball games, but he refused to do so and was dropped by Reebok.¹²⁴ Amidst these reports, Reebok claimed no official contract was ever signed, and that Reebok would stop providing Gortat with free shoes and no longer pursue an endorsement deal.¹²⁵

On the other hand, tattoos featuring corporate logos are also obtained by people with no commercial interest in acquiring them.¹²⁶ Scholars have suggested that such tattoos extend beyond the realm of a few brand enthusiasts at the fringes of society and into sociocultural indications of group membership.¹²⁷ In the United States, popular trademark tattoos seem to depend upon geographical boundaries.¹²⁸ Specifically related to the West Coast, the seem-

2014), <http://fivethirtyeight.com/features/what-ethan-swain-learned-from-tracking-every-tattoo-in-the-nba/>.

121. J.E. Skeets, *Reebok asks Magic center Gortat to cover Jordan tattoo*, YAHOO! SPORTS: BALL DON'T LIE (June 9, 2009), http://sports.yahoo.com/nba/blog/ball_dont_lie/post/Reebok-asks-Magic-center-Gortat-to-cover-Jordan-?urn=nba,169109. The Jumpman logo is owned by Nike and features Michael Jordan's silhouette dunking a basketball. See Darren Rovell, *Nike sued over Michael Jordan logo*, ESPN (Jan. 23, 2015), http://espn.go.com/nba/story/_/id/12218091/photographer-sues-nike-michael-jordan-photo-

122. See Skeets, *supra* note 121.

123. See *id.*

124. *Id.*

125. See, e.g., Tania Ganguli, *Marcin Gortat's ink puts black mark on Reebok deal*, ORLANDO SENTINEL (July 29, 2009), http://articles.orlandosentinel.com/2009-07-29/sports/gortat_1_reebok-gortat-air-jordan.

126. See Jamie Shelden & Mary DeLongis, *Tattoo You—With A Trademark*, INTABULLETIN (July 1, 2001), <http://www.inta.org/INTABulletin/Pages/TattooYou%E2%80%93WithATrademark.aspx>. Interestingly, however, tattoo artists seem to exist in a bifurcated universe where copying pre-designed tattoo designs (called “flash”) is acceptable, while the copying of custom designs is considered taboo. See Perzanowski, *supra* note 14, at 541-57. Trademark tattoos would seem to fall into the former category, absent directions from a client to create a more creative rendering of the trademark.

127. See Shelden & DeLongis, *supra* note 126 (“It seems that the trademarks that are most frequently seen as tattoos tend to be those that have achieved a certain cultural impact; ones that have become, for their admirers, a way of life.”).

128. See *id.* Obtaining a trademark tattoo also depends upon the willingness of a tattoo artist to complete such a tattoo. The question of whether providing trademark tattoos is legal is in the forefront of the minds of some tattoo artists. See *id.* (noting that “one tattoo artist indicated that he refuses to reproduce trademarks as tattoos because of concerns about infringement.”). In an interview about the intellectual property ramifications of providing trademark tattoos, another tattoo artist stated that he had considered the consequences, noting,

[I]t is impossible to regulate . . . [s]o many people have tattoos of protected art, he said, that there is simply nothing . . . trademark owners can do about it. Specifically, he mentioned Hello Kitty's popular Japanese bobtail cat, explaining that it is a very

ingly most popular trademark tattoos in the United States are those related to the Harley-Davidson brand, including the famous eagle with outstretched wings.¹²⁹ This has been attributed to Harley-Davidson's marketing strategy of social branding.¹³⁰ The second-most popular trademark tattoos belong to followers of the band The Grateful Dead.¹³¹ "Deadheads," as they are affectionately christened, commonly obtain "the [trademark] THE GRATEFUL DEAD, [and] other marks associated with the band, such as the Dancing Bears logo and Skull design mark, and countless variations of these designs."¹³² Tattoo artists have stated that other popular trademark tattoos include logos from National Football League teams, the NASCAR logo, and collegiate sports designs and logos.¹³³ On the East Coast, the most popular trademark tattoo is the New York Yankees baseball team YANKEES logo.¹³⁴ In Northeastern states, other popular trademark tattoos include Harley-Davidson-related logos, the CHEVY CAMARO logo, and the NIKE swoosh.¹³⁵ In New York specifically, celebrity portraits, Budweiser cans, and Corona beer bottles are also popular tattoo selections.¹³⁶

Tattoos obtained for noncommercial purposes may develop trademark qualities and/or commercial value with a rise in popularity or visibility of the tattooed individual. For example, the tattoos of one of the NBA's early tattoo enthusiasts, Dennis Rodman, formed the basis of a 1996 lawsuit.¹³⁷ Rodman obtained his roughly 100 tattoos based upon his personal preferences

common tattoo among young women. Presumably, none of those young women asked for (or asked their tattoo artist to request) permission from Hello Kitty's parent company, Sanrio. For his part, [the tattoo artist] explained that he averages about three to five tattoos a day and estimates that he tattoos a sports logo about once every three months. He related that there are tattoo fads that ebb and flow, like particular sports logos or movie or television characters that are popular for a short time. For example, when the Los Angeles Lakers won their second consecutive NBA championship in June 2010, [the tattoo artist] said he noticed an increase in requests for Lakers logos.

Beasley, *supra* note 25, at 1160-61.

129. See Sheldon & DeLongis, *supra* note 126.

130. See Baskin, *supra* note 12 (noting that "H-D was a social brand long before we ever had a name for it, selling emotive themes and a lifestyle to a generation of Americans who yearned for safe rebellion and the promise of the open road.").

131. Sheldon & DeLongis, *supra* note 126.

132. *Id.*

133. *Id.*

134. *Id.*

135. See *id.* In addition, following Dale Earnhardt's untimely death, tattoos encompassing the number "3" and Earnhardt's signature skyrocketed in popularity. *Id.*

136. *Id.*

137. See *Dennis Rodman v. Fanatix Apparel, Inc.*, Case No. 96-2103 (D.N.J., May 28, 1996). Though tattoos are commonplace in the NBA today, Dennis Rodman was one of the first NBA players to don large numbers of tattoos. See Harry Cheadle, *A Brief History of Tattoos in the NBA*, VICE, May 17, 2011, <http://www.vice.com/read/a-brief-history-of-tattoos-in-the-nba> (calling Rodman a "tattoo pioneer in the [NBA]").

and life experiences, and was as well known for his tattoos as he was for his prowess on the basketball court.¹³⁸ At the height of Rodman's fame as an NBA player, Fanatix Apparel began making unauthorized t-shirts with reproductions of Rodman's tattoos positioned in the same physical locations as found on Rodman's body.¹³⁹ These shirts were sold as Fanatix's "Dennis Rodman Tattoo Shirt."¹⁴⁰ In seeking a preliminary injunction from the district court, Rodman alleged, among other things, that his tattoos were protectable as unregistered trademarks and that the defendant's activities would cause a likelihood of confusion as to source and sponsorship.¹⁴¹ The court granted the preliminary injunction and enjoined Fanatix from further making, selling or advertising the shirts.¹⁴²

Once considered the wares of "sailors, convicts, and circus performers,"¹⁴³ tattoos have become commonplace in the United States. The increasing ubiquity of tattoos in American culture, and the rise of trademark tattoos, has given rise to unique legal questions that will be addressed in the remainder of this Article.

II. ENFORCING TRADEMARK RIGHTS AGAINST PARTIES WITH TRADEMARK TATTOOS

A person with a trademark tattoo may, like Sam Penix of Everyman Espresso, eventually find him or herself at odds with the owner of the trademark or others. State and federal trademark law allow trademark owners to preclude others from using their trademarks in commerce under certain circumstances. Such enforcement claims may be subject to several viable defenses. If, however, those claims are successful, the primary remedy for infringement is to enjoin the infringing conduct, which could have far-reaching implications for tattooed parties. The discussion below analyzes trademark enforcement mechanisms and the remedies available to trademark owners when dealing with allegedly infringing trademark tattoos.

A. Enforcing Trademark Rights

Once a trademark owner learns that a putative infringer has obtained a permanent tattoo embodying the trademark owner's valid, protectable trademark, nothing in current trademark law precludes the trademark owner from enforcing her trademark rights against the tattooed party. This enforcement

138. DENNIS RODMAN & JACK ISENHOUR, *I SHOULD BE DEAD BY NOW 18* (2006) (noting that his roughly 100 tattoos tell his life story).

139. *Rodman*, Case No. 96-2103, at *4.

140. *Id.*

141. *Id.*

142. 3 AARON WISE & BRUCE MEYER, *INTERNATIONAL SPORTS LAW AND BUSINESS* (1997).

143. See Perzanowski, *supra* note 14, at 512.

would likely take the form of a claim for trademark infringement or trademark dilution.

1. Proving Trademark Infringement Against a Party With a Trademark Tattoo

Assuming that the trademark owner has a valid, protectable trademark, the remaining steps in proving an infringement claim are showing that the tattooed party is using a “reproduction, . . . copy, or colorable imitation” of the trademark (the first requirement) in commerce without permission (the second requirement) and that such use is likely to cause confusion (the third requirement).¹⁴⁴

The first requirement, which requires a reproduction, copy, or colorable imitation, will arguably be met in most instances. In cases of skinvertising, the tattooed party will almost necessarily get a tattoo recognizable as the relevant trademark. With regard to brand enthusiasts, if the goal is to convey support or loyalty to a particular brand, the trademark tattoo will likely encompass a copy or imitation.¹⁴⁵

With respect to the second requirement, unauthorized use in commerce, athletes, entertainers, and other public figures are most at risk of falling within the ambit of the requisite use in commerce. By virtue of their careers, these figures are regularly in the public eye, using their physical appearance, skills, and bodies to market themselves and the goods and services connected to their livelihoods. Athletes in particular may be the most susceptible because athlete endorsement has become a lucrative marketing strategy for many companies.¹⁴⁶ Indeed, marketing companies have approached athletes in recent years regarding temporary skinvertisements, only to be shut down by sports leagues.¹⁴⁷

Private individuals may also find themselves using trademark tattoos in commerce through photos and marketing materials related to their own companies, similar to Mr. Penix of Everyday Espresso.¹⁴⁸ On the other hand, some people may escape liability if they merely adorn their trademark tattoos and never appear in commercial photos or videos, engage in paid public

144. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 259 (4th Cir. 2007) (citing 15 U.S.C. § 1114(1)(a) (2012); *CareFirst of Md., Inc. v. First Care, P.C.*, 434 F.3d 263, 267 (2006)).

145. The statutory language does not require that the allegedly infringing trademark be identical. Thus, trademark tattoos using artistic derivations from the original trademark may still be infringing. Indeed, Mr. Penix’s “I [coffee cup] NY” tattoo was not identical to the I ♥ NY trademark owned by the State of New York, and the state still accused him of trademark infringement. *See Newman, supra* note 1.

146. *See Julie Stevens et al., “Who is Your Hero?” Implications for Athlete Endorsement Strategies*, 12 *SPORT MARKETING Q.* 103 (2003).

147. *See Vukelj, supra* note 107, at 513-14.

148. *But see Cotter & Mirabole, supra* note 20, at 123-24 (suggesting that merely having a trademark tattoo does not infringe).

performances, or attempt to pursue any career where their appearance and tattoo(s) are relevant or visible. Increasingly, however, the Internet and social media have made nearly ever multimedia opportunity a potentially commercial endeavor. For example, Instagram, a social networking site, has become a place for its users, especially Millennials, to make large amounts of money sharing photos and videos featuring seemingly mundane tasks.¹⁴⁹ Companies spend more than \$1 billion per year on sponsored Instagram posts commissioned from Instagram “influencers” with large followings.¹⁵⁰ Social media allows otherwise unknown individuals to become “micro-celebrities” among large numbers of followers.¹⁵¹ As such, it is easy to imagine scenarios where private individuals will use their trademark tattoos in commerce within the ambit of trademark law.

The third and final requirement for finding trademark infringement, whether there exists a likelihood of confusion, poses significant challenges for individuals with trademark tattoos because of the many forms confusion can take.¹⁵² A likelihood of confusion analysis in the trademark tattoo universe would likely be based on initial interest confusion, post-sale confusion, or confusion as to affiliation, connection, or sponsorship.

Initial interest confusion is based on “initial customer interest,” even if the customer ultimately does not purchase the object of her confusion.¹⁵³ One line of cases suggests that people with trademark tattoos could be found liable under such a theory.

In *Mobil Oil Corp. v. Pegasus Petroleum Corp.*,¹⁵⁴ the Second Circuit Court of Appeals upheld a finding of trademark infringement even where a likelihood of confusion only existed briefly at the outset of a transaction. Mobil had used a trademark symbol encompassing a winged horse since 1931, which represented the Greek mythological creature named Pegasus, in its gasoline and petroleum business.¹⁵⁵ At the time of the litigation, the court recognized that Mobil’s winged horse trademark was one of the strongest trademarks in American commerce.¹⁵⁶ In 1981, the defendant entered the

149. See Kayleen Schaefer, *How Bloggers Make Money on Instagram*, HARPER’S BAZAAR (May 20, 2015), <http://www.harpersbazaar.com/fashion/trends/a10949/how-bloggers-make-money-on-instagram/> (interviewing a 22-year-old blogger with 992,000 Instagram followers who charges between \$5,000 and \$15,000 for one sponsored photo or video post on Instagram).

150. See *id.*

151. See generally Alice Marwick, *Status update: Celebrity, Publicity and Self-branding in Web 2.0* (2010) (unpublished Ph.D. dissertation, New York University) (on file with author).

152. See *supra* notes 67-74 and accompanying text.

153. MCCARTHY, *supra* note 52, § 23.6.

154. 818 F.2d 254 (2d Cir. 1987).

155. *Id.* at 255. As part of their business activities, Mobil participated in the oil trading market. *Id.* at 256. “The oil trading market is tight-knit and sophisticated . . . [O]il traders do not consummate deals with strangers except after a thorough credit check.” *Id.*

156. *Id.* at 255-56.

private oil trading market under the name Pegasus Petroleum.¹⁵⁷ The company's founder, Gregory Callimanopoulos, had chosen the name "because he wanted a name with both mythical connotations and alliterative qualities."¹⁵⁸ The Second Circuit agreed with the district court judge's assertion that a likelihood of confusion was based on "the likelihood that that Pegasus Petroleum would gain crucial credibility during the initial phases of a deal."¹⁵⁹ It further noted that this initial interest confusion could form the basis of a trademark infringement lawsuit.¹⁶⁰ In the trademark tattoo context, this type of analysis leaves open the potential for liability if consumers initially believe that a party with the tattoo is providing any services of the trademark owner.¹⁶¹

Consider an application of this legal framework to the case of Sam Penix and his coffee shop, Everyman Espresso. The State of New York's trademark infringement claim against Sam Penix may have been based on initial interest confusion. A consumer seeing the Everyman Espresso logo on signage may initially be interested in the coffee shop based on the belief that it is owned by the trademark owner (the State of New York) and thus more authentic or special. Even if that consumer did not ultimately purchase coffee from the coffee shop, confusion has happened.

Even more likely than initial interest confusion is an infringement claim based on confusion as to affiliation, connection, or sponsorship. If consumers are confused into believing that the trademark owner approved of the trademark tattoo in some way, this could expose the tattooed party to infringement liability.¹⁶² In such cases, the appropriate legal question "is whether the average purchaser would be likely to believe that the infringer's product has 'some connection' with the trademark owner."¹⁶³ Given the era of dotcom skinvertisements, tattoo-based ambush marketing in boxing and the NBA, and other types of body billboard opportunities, it is clear that some companies do, indeed, approve of trademark tattoos for such pur-

157. *Id.*

158. *Id.* He also said that, though he was aware of Mobil's trademark, he was unaware that the term Pegasus was represented by a flying horse.

159. *Id.* at 259 ("[A]n oil trader might listen to a cold phone call from Pegasus Petroleum—an admittedly oft used procedure in the oil trading business—when otherwise he might not, because of the possibility that Pegasus Petroleum is related to Mobil.").

160. *Id.* at 260.

161. This would be more relevant with regard to services, not goods. Absent the return of slavery, the party bearing the tattoo would not be the "good" of the trademark owner.

162. See *Homeowners Grp., Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991) (noting that the ultimate question is whether consumers are likely to believe that the parties' offerings are affiliated in some way).

163. See *Ferrari S.p.A. Esercizio Fabbriche Automobili e Corse v. McBurnie*, No. 86-1812-B(IEG), 1989 WL 298658, at *5 (S.D. Cal. June 1, 1989) (quoting *Grey v. Campbell Soup Co.*, 650 F.Supp. 1166, 1173 (C.D. Cal. 1989) (noting that a customer purchasing unauthorized manufacturing kits or completed cars looking like a Ferrari "might not know if Ferrari has sponsored, approved, or licensed" those items)).

poses.¹⁶⁴ It is not beyond the realm of possibilities, therefore, that consumers would believe that a trademark tattoo has been authorized in some way.

Some cases also suggest that the tattoo artist may be liable for trademark infringement under a theory of confusion based on affiliation, connection, or sponsorship. In *Boston Professional Hockey Ass'n, Inc. v. Dallas Cap & Emblem Manufacturing, Inc.*, the National Hockey League and thirteen NHL teams (collectively “NHL”) sued Dallas Cap & Emblem Manufacturing, Inc. (“Dallas Cap”) for trademark infringement stemming from Dallas Cap’s manufacture and sale of embroidered NHL patches.¹⁶⁵ The NHL owned trademark rights in the logos embodied by the patches.¹⁶⁶ The court struggled with the fact that the “reproduction of the trademark [was] being sold unattached to any other goods or services, [because] [t]he statutory and case law of trademarks is oriented toward the use of such marks to sell something other than the mark itself.”¹⁶⁷ The court ultimately found this activity infringing in part because the trademark owners had worked hard to build goodwill in the trademarks, and the commercial value of Dallas Cap’s patches stemmed from those efforts.¹⁶⁸ Using such a rationale, a tattoo artist selling and inking trademark tattoos unconnected to other products could be subject to trademark infringement liability.¹⁶⁹

Post-sale confusion could also exist with regard to trademark tattoos. Post-sale confusion would occur where observers view a trademark tattoo and become confused regarding whether the party with the tattoo provides services offered by the trademark owner.¹⁷⁰ In *Acad. of Motion Picture Arts & Sciences v. Creative House Promotions, Inc.*, the Ninth Circuit considered the issue and found infringement in another context—replicas of the golden “Oscar” statuette—and noted that, while purchasers of the infringing statu-

164. See, e.g., *GoldenPalace.com featured on MSNBC's Countdown*, GOLDENPALACE EVENTS.COM, <http://www.goldenpalaceevents.com/auctions/msnbc01.php> (“[P]ermanent and semi-permanent tattoos of [GoldenPalace.com] have appeared] in such places as foreheads, legs, the bellies of pregnant women and the chest of [a] former swimsuit model.”).

165. *Boston Prof'l Hockey Ass'n v. Dallas Cap & Emblem Mfg. Inc.*, 510 F.2d 1004, 1008 (5th Cir. 1975).

166. *Id.*

167. *Id.* at 1010.

168. *Id.* at 1011. The court was hesitant, however, to encourage a broad reading of its holding, noting that it was not addressing “whether every artistic reproduction of the symbol would infringe. . . .” The court restricted itself “to the emblems sold principally through sporting goods stores for informal use by the public in connection with sports activities and to show public allegiance to or identification with the teams themselves.” *Id.* In fact, in a later case, the same court distinguished its holding as applied to fraternal jewelry. See *Supreme Assembly, Order of Rainbow for Girls v. J. H. Ray Jewelry Co.*, 676 F.2d 1079, 1085 (5th Cir. 1982) (“It is not unreasonable to conclude . . . that a consumer seeing the emblem or name of a team on or associated with a good or service would assume some sort of sponsorship or association between the product’s seller and the team.”).

169. *Cotter & Mirabole*, *supra* note 20, at 127.

170. See *Acad. of Motion Picture Arts & Sciences v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1455 (9th Cir. 1991).

ette would know that it was not an Oscar given by the Academy of Motion Picture Arts & Sciences, a secondary audience could see the replica and believe that it was associated with the real Oscar.¹⁷¹ Other courts have noted that trademark law is designed to protect post-sale observers of products featuring infringing trademarks, not just those who purchase goods and services.¹⁷²

Considering the many types of confusion, a tattooed party could find themselves liable under several theories, including initial interest confusion, confusion as to affiliation, connection, or sponsorship, or post-sale confusion.

Once the type of confusion has been identified, the next step will be to apply the likelihood of confusion factors to the specific circumstances.¹⁷³ Though no court has yet considered whether a trademark tattoo is infringing, a hypothetical analysis can be based on Everyman Espresso's former logo featuring Sam Penix's "I [coffee cup] NY" tattoo.

In the Second Circuit, the likelihood of confusion factors are:

- (1) The strength of the plaintiff's mark,
- (2) The similarity of plaintiff's and defendant's marks,
- (3) The competitive proximity of the products,
- (4) The likelihood that plaintiff will "bridge the gap" and offer a product like defendant's,
- (5) Actual confusion between products,
- (6) Good faith on the defendant's part,
- (7) The quality of defendant's product, and
- (8) The sophistication of buyers.¹⁷⁴

171. *Id.*

172. *See* Ferrari S.P.A. v. Roberts, 944 F.2d 1235, 1245 (6th Cir. 1991) (The court ruled that protection of automobile manufacturer from confusion of source resulting from defendant's manufacture of replicas was not limited to confusion at point of sale)

173. Each Circuit has its own approach to the likelihood of confusion analysis. *See, e.g.*, S. Co. v. Dauben Inc., 324 F. App'x 309 (5th Cir. 2009); Borinquen Biscuit Corp. v. M.V. Trading Corp., 443 F.3d 112 (1st Cir. 2006); Sally Beauty Co. v. Beautyco, Inc., 304 F.3d 964 (10th Cir. 2002); Barbecue Max, Inc. v. 551 Ogden, Inc., 235 F.3d 1041 (7th Cir. 2000); Champagne Louis Roederer, S.A. v. Delicato Vineyards, 148 F.3d 1373 (Fed. Cir. 1998); Tally-Ho, Inc. v. Coast Community College District, 889 F.2d 1018 (11th Cir. 1989); Wynn Oil Co. v. Thomas, 839 F.2d 1183 (6th Cir. 1988); Pizzeria Uno Corp. v. Temple, 747 F.2d 1522 (4th Cir. 1984); Interpace Corp. v. Lapp, Inc., 721 F.2d 460 (3d Cir. 1983); SquirtCo. v. Seven-Up Co., 628 F.2d 1086 (8th Cir. 1980); AMF Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979); Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d 492 (2d Cir. 1961).

174. Fed. Exp. Corp. v. Fed. Espresso, Inc., 201 F.3d 168, 171 (2d Cir. 2000) (citing Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d 492, 495 (2d Cir.), *cert. denied*, 368 U.S. 820, 82 S.Ct. 36, 7 L.Ed.2d 25 (1961)).

Regarding the strength of the plaintiff's mark, "I ♥ NY" is a strong and well-known trademark. Products featuring the slogan are visible all over New York City.¹⁷⁵ It is one of the most widely distributed images in the world and is even featured in the Museum of Modern Art.¹⁷⁶ As such, the strength of the plaintiff's "I ♥ NY" trademark weighs in favor of infringement.

The similarity of "I ♥ NY" to Everyman Espresso's logo is a more difficult analysis. Conflicting trademarks utilizing both words and designs must be considered in their entirety.¹⁷⁷ Here, it is critical to determine whether words or design elements dominate the trademark.¹⁷⁸ Most courts have held that the word portion dominates.¹⁷⁹ When comparing trademarks, one must "consider not only the similarity of the accused word marks, but also the similarity of the lettering style, color and format and any accompanying background matter."¹⁸⁰ In addition, both the Supreme Court and the USPTO have noted that adding matter to protectable trademarks is generally insufficient to avoid infringement liability.¹⁸¹ Penix's trademark tattoo uses stylized lettering for "I" and "NY" identical to the State of New York's mark. The primary difference is the replacement of the red heart symbol with a red coffee cup, but the words likely dominate the design. Also, the additional matter, including the coffee portafilter and the words EVERYMAN ESPRESSO, do not eliminate liability. This leans in favor of infringement in regards to the similarity factor.¹⁸²

Regarding the competitive proximity of the products, the State of New York owns nearly twenty federal trademark registrations for derivations of "I ♥ NY," from key chains, clothing, and magnets to plush toys and perfume.¹⁸³ It also owns a registration for enhancing the state's economic development and promoting tourism.¹⁸⁴ Everyman Espresso, on the other hand,

175. See Ramirez, *supra* note 4.

176. Gabe Pressman, "I Love NY": The Doodle That Became an Icon, NBCNEWYORK.COM (May 31, 2012), <http://www.nbcnewyork.com/news/local/The-Doodle-That-Became-an-Icon-156019055.html>.

177. See *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084, 1090-91 (10th Cir. 1999).

178. See, e.g., *The Board of Trustees of the University of Alabama v. Pitts*, 107 U.S.P.Q.2d 2001, 2023 (T.T.A.B. 2013) ("When a composite mark contains both words and a design, the word portion is more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and services.").

179. *Id.*

180. MCCARTHY, *supra* note 52, § 23:52.

181. *Id.* § 23:50 (noting that, as a general rule, additions to protected trademarks do not eliminate infringement liability).

182. See *Banff, Ltd. v. Federated Dept. Stores, Inc.*, 841 F.2d 486 (2d Cir. 1988) (affirming a finding of infringement where "the similarity of typefaces—each using a Roman letter design for the label—exacerbates the like impression created by the two labels").

183. See, e.g., I NY, Registration No. 4,267,307; I NY, Registration No. 4,254,793; I NY, Registration No. 4,106,575.

184. See, e.g., I NY, Registration No. 4,224,966.

was ostensibly only using its logo to provide restaurant services, more specifically coffee shop services.¹⁸⁵ While offering coffee-related services may promote economic development and promote tourism, the competitive proximity of the products seemingly weighs against a finding of trademark infringement.¹⁸⁶

With respect to Everyman Espresso's good faith, "actual or constructive knowledge" of the trademark owner's mark can be used to show bad faith.¹⁸⁷ While the Lanham Act does provide a defense based on innocent infringement, it is limited to printers and publishers.¹⁸⁸ Of course, Penix knew about the "I ♥ NY" trademark but it is not clear whether he intended to capitalize on the reputation and goodwill built in the trademark. He is most likely a brand enthusiast who did not set out to infringe when he obtained the tattoo.¹⁸⁹ However, placing a stylized representation of Penix's tattoo in the company's logo adds a level of complexity to the analysis. What is more, the State of New York has admitted that there is widespread infringement of the "I ♥ NY" trademark on the city streets by individuals and companies who may not know that the designation is trademarked.¹⁹⁰ The resulting impact of Penix's good faith is difficult to predict.

Regarding the sophistication of the relevant consumers, the likelihood of confusion is reduced when the consumers are sophisticated parties.¹⁹¹ Low consumer sophistication means that such parties are less discriminating and more likely to be confused when encountering allegedly infringing trademarks. The relevant inquiry "considers the general impression of the ordinary purchaser, buying under the normally prevalent conditions of the market and giving the attention such purchasers usually give in buying that class of goods."¹⁹² Anyone passing by Everyman Espresso could be a consumer, and courts have noted that buyer sophistication is generally low when

185. It is unclear, however, if Everyman Espresso was also selling merchandise featuring the logo in its shop.

186. If, however, the State of New York has rights in an unregistered "I ♥ NY" trademark related to restaurant or coffee shop services, this factor may indeed also weigh in favor of a finding of infringement.

187. *Info. Superhighway, Inc. v. Talk Am., Inc.*, 395 F. Supp. 2d 44, 53 (S.D.N.Y. 2005) (citing *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 259 (2d Cir. 1987)).

188. See 15 U.S.C. § 1114(2) (2012). Innocent infringement remains a confusing principle for courts. Legislative history suggests a publisher or broadcaster is "innocent" only if it "knew that [an] advertisement was false or infringing or proceeded to publish the advertisement with 'reckless disregard' as to whether it was false or infringing or not." MCCARTHY, *supra* note 52, § 25:29. Other jurisdictions, like the Fifth Circuit, have found that the term "innocent" is measured by the standard of objective reasonableness. *Id.* (citing *Dial One of the Mid-South, Inc. v. BellSouth Telecommunications, Inc.*, 269 F.3d 523 (5th Cir. 2001)).

189. Indeed, Penix commented that he wanted Everyman Espresso to display "an in-your-face passion for New York City." See Newman, *supra* note 1.

190. See Ramirez, *supra* note 4.

191. *Morningside Grp. Ltd. v. Morningside Capital Grp., L.L.C.*, 182 F.3d 133, 142 (2d Cir. 1999).

192. *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1137 (2d Cir. 1979).

related to basic food and beverage purchases.¹⁹³ Because buyer sophistication is relatively low, this weighs in favor of a finding of trademark infringement.

There are not enough available facts to determine whether the State of New York will “bridge the gap” and enter the restaurant and/or coffee shop space, but it is plausible that the state, which owns trademarks directed to tourism and economic development, could enter into commercial transactions dealing with food and beverages. Nevertheless, courts can find a likelihood of confusion even where there is no evidence that a trademark owner plans to bridge the gap.¹⁹⁴ There are also not enough facts to determine the quality of Everyman Espresso’s products,¹⁹⁵ or whether there has been actual confusion.¹⁹⁶

In sum, applying traditional trademark law to an allegedly infringing trademark tattoo could result in liability for the tattooed person. Given that the most common remedy in trademark infringement lawsuits is an injunction, there are serious questions about fashioning appropriate relief under such circumstances. A court would have to determine how to craft an appropriate injunction, which could come at the cost of serious autonomy limitations for the person with a trademark tattoo.

In addition to trademark infringement, the party could also find herself exposed to trademark dilution claims, which are addressed below.

2. Proving Trademark Dilution Against a Party With a Trademark Tattoo

A party with a trademark tattoo may also be found liable for dilution if the trademark in question is famous within the meaning of the statute. This is the possible even in the “absence of actual or likely confusion, of competition, or of actual economic injury.”¹⁹⁷ A trademark dilution claim under the TDRA requires proof that:

- (1) That the plaintiff owns a famous mark that is distinctive,

193. See *Patsy’s Brand, Inc. v. I.O.B. Realty, Inc.*, 317 F.3d 209, 219 (2d Cir. 2003) (rejecting expert testimony that “New Yorkers ‘tend to be savvy and knowledgeable about restaurants and food’”).

194. See *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1136 (2d Cir. 1979). To address the “bridging the gap” factor, a trademark owner would typically set forth evidence showing a present intention or plan for expansion. *Id.* at 1135-36.

195. Everyman Espresso had only been in business for four years before it received the State of New York’s cease and desist letter. See Newman, *supra* note 1. Penix has stated that Everyman Espresso was created in part to represent “fine coffee.” *Id.*

196. Proof of actual confusion is not required; in fact, it is difficult to prove such confusion in most cases. See *Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112 (1st Cir. 2006).

197. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 263 (4th Cir. 2007) (stating that “no actual confusion is required to prove a case of trademark infringement, although the presence of actual confusion can be persuasive evidence relating to a likelihood of confusion”).

- (2) That the defendant has commenced using a mark in commerce that allegedly is diluting the famous mark,
- (3) That a similarity between the defendant's mark and the famous mark gives rise to an association between the marks, and
- (4) That the association is likely to impair the distinctiveness of the famous mark or likely to harm the reputation of the famous mark.¹⁹⁸

The TDRA provides defenses to dilution, including fair use, news reporting and commentary, and noncommercial use.¹⁹⁹

Regarding the fame requirement, it will be likely that the class of plaintiffs at issue have very popular, well-known marks. Most of the documented trademark tattoos are those that have large followings of brand enthusiasts, like the NIKE swoosh and Harley-Davidson eagle.²⁰⁰ Whether or not these trademarks also meet the requisite level of famousness under the TDRA is a separate question. The fame standard is a challenging, arduous requirement reserved for a rare class of trademarks.²⁰¹ The TDRA provides several factors that can be used to determine a trademark's relative degree of fame, including:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties,
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark,
- (iii) The extent of actual recognition of the mark,
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.²⁰²

198. *Id.* at 264-65.

199. *Id.* at 265; 15 U.S.C. § 1125(c)(3) (2012).

200. *See supra* notes 126-136 and accompanying text.

201. "Dilution is meant to be a special remedy for only a narrow class of famous marks, and against only a narrow class of uses that are likely to impair the distinctiveness or harm the reputation of the famous mark, thereby decreasing the power of the brand." *Trademark Dilution: Hearing on H.R. 683 Before the Subcomm. on Courts, the Internet and Intellectual Property*, 109th Cong. (2005) (statement of Anne Gundelfinger, President, International Trademark Association). Courts are discriminating in applying this federal standard to trademarks due to its anti-competitive nature. McCARTHY, *supra* note 52, § 24:104.

202. 15 U.S.C. § 1125(c)(2) (2012). Lawyers and courts have found it incredibly difficult to determine which trademarks meet the fame standards outlined in the TDRA. *See generally* Xuan-Thao Nguyen, *Fame Law: Requiring Proof of National Fame in Trademark Law*, 33 CARDOZO L. REV. 89 (2011) ("Judicial struggle with the 'fame' requirement is due to . . . the wording of the statute and judicial failure to grasp legislative history and intent in interpreting the statute with respect to 'fame.'").

Each of these factors should be weighed in determining the famousness of a trademark.²⁰³

In the context of the earlier Everyman Espresso hypothetical, only the Trademark Trial and Appeal Board (“TTAB”) has considered whether or not the trademark “I ♥ NY” is famous.²⁰⁴ It did so under the Federal Circuit’s likelihood of confusion standard, which is less rigorous and a lower standard than that of trademark dilution.²⁰⁵ The analysis, however, is still instructive because it provides the facts necessary to begin to analyze the Everyman Espresso hypothetical. In finding that “I ♥ NY” is famous, the TTAB noted that between FY 2003-2004 through FY 2007-2008, the State of New York had spent more than \$40 million on marketing materials featuring the trademark.²⁰⁶ In addition, the logo was “identified as one of the best known logos in the United States, if not the world,” “probably the world’s most recognized place-brand;” and “ranked as the world’s 24th top logo based on whether the logo had a positive effect on perceptions of the company among employees and the public.”²⁰⁷ These facts, taken together, seem to support a finding of famousness based on the first three dilution requirements. The fourth factor relates to whether the trademark is registered on the Principal Register with the USPTO.²⁰⁸ Here, the State of New York owns several trademark registrations for “I ♥ NY” on the Principal Register.²⁰⁹

Regarding the use in commerce requirement, this analysis would rely on information similar to the earlier likelihood of confusion assessment.²¹⁰ As mentioned earlier, there could be any number of scenarios where individuals will use their trademark tattoos in commerce within the ambit of trademark law. Commercial endeavors abound both in the real world and in the digital universe given the ubiquity of social media and Internet interconnectivity, particularly with respect to personal photographs. In the Everyman Espresso

203. See Report of the Trademark Rev. Commission, 77 Trademark Rep. 375, 460 (1987) (“The enumerated factors are designed to guide the court. No one factor is controlling and a court may consider factors which are not listed.”). Some federal circuits, however, have held that the TDRA “does not require that courts strictly apply every factor in the statute.” *Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.*, 212 F.3d 157, 166 (3d Cir. 2000).

204. See *New York State Dep’t of Econ. Dev. v. Ramapo Valley Brewery*, 2010 WL 985321 (T.T.A.B. 2010).

205. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1375 (Fed. Cir. 2005) (“While dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame varies along a spectrum from very strong to very weak.”). As applied to a likelihood of confusion analysis, the question of fame depends on the nature of the putative infringer’s use. McCARTHY, *supra* note 52, § 24:104. In the dilution context, a mark either is or is not famous, and the designation only applies to a select “category of truly elite marks.” *Id.*

206. *Ramapo*, 2010 WL 985321, at *3.

207. *Id.*

208. McCARTHY, *supra* note 52, § 24:106.

209. See *supra* note 183.

210. See *supra* notes 148-151 and accompanying text.

hypothetical, there is no question that Penix was using his tattoo and the Everyman Espresso logo in marketing materials to promote his coffee shop. As such, this would be considered a use in commerce that is alleged to dilute the “I ♥ NY” trademark.

Determining the degree of similarity between Penix’s tattoo and the “I ♥ NY” trademark, and whether such similarities give rise to an association between the two marks, is quite a subjective analysis.²¹¹ Though identical similarity is not required, courts have not provided much guidance regarding the threshold degree of similarity that must be crossed to support a likelihood of confusion finding.²¹² Several jurisdictions compare conflicting trademarks on the basis of sight, sound, and meaning.²¹³ If the total impression of the trademarks is the same, this will support a likelihood of confusion finding.²¹⁴ Regarding sight and meaning, the letters “I” and “NY” in Penix’s tattoo appear in identical font, color and typeface as the same letters in the “I ♥ NY” trademark and were also pronounced the same way.²¹⁵ The heart in the “I ♥ NY” trademark and the coffee cup in Penix’s tattoo both appeared in red, though the heart is shaded in and the coffee cup is not.²¹⁶ These give the same overall impression – a phrase expressing fondness for things related to New York City. Even Penix stated that he wanted the coffee shop’s brand to stand for “an in-your-face passion for New York City.”²¹⁷ As such, the similarities give rise to an association between the two trademarks.

The final requirement necessitates an analysis of dilution by blurring (by impairing the famous trademark’s distinctiveness) and dilution by tarnishment (“by harming the reputation of the famous mark). In analyzing dilution by blurring, the relevant factors include:

- (i) The degree of similarity between the mark or trade name and the famous mark,
- (ii) The degree of inherent or acquired distinctiveness of the famous mark,
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark,

211. Some scholars have referred to this factor as “nothing more than a subjective ‘eye-ball’ test.” See McCARTHY, *supra* note 52, § 23:25 (citing Exxon Corp. v. Texas Motor Exchange, Inc., 628 F.2d 500 (5th Cir. 1980); General Foods Corp. v. Ito Yokado Co., 219 U.S.P.Q. 822 (T.T.A.B. 1983); Ocean Spray Cranberries, Inc. v. Ocean Garden Products, Inc., 223 U.S.P.Q. 1027 (T.T.A.B. 1984) (parentheticals omitted)).

212. *Id.*

213. See, e.g., Official Airline Guides, Inc. v. Goss, 6 F.3d 1385, 1392 (9th Cir. 1993); First Sav. Bank, F.S.B. v. First Bank Sys., Inc., 101 F.3d 645, 653 (10th Cir. 1996); Sensient Techs. Corp. v. SensoryEffects Flavor Co., 613 F.3d 754, 765 (8th Cir. 2010).

214. See *In re Triple R Mfg. Corp.*, 168 U.S.P.Q. 447 (T.T.A.B. 1970).

215. See *infra*, Appendix A and B.

216. *Id.*

217. See Newman, *supra* note 1.

- (iv) The degree of recognition of the famous mark,
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark,
- (vi) Any actual association between the mark or trade name and the famous mark.²¹⁸

Congress has provided no statutory guidelines for dilution by tarnishment.

In the dilution by blurring case, factors (i), (ii), (iii), and (iv) should weigh in favor of the trademark owner in most instances for many of the reasons stated earlier. Most parties who get trademark tattoos *want* those tattoos to be identical to symbols of their beloved brands. In addition, the types of trademarks that are most often replicated are the most popular, distinctive, and well-known.²¹⁹ Factors (v) and (vi) would necessarily invite an assessment of the party's intent in getting the tattoo, their actual use of the tattoo, and the impact that the use has on the famous mark.²²⁰

In the Everyman Espresso hypothetical, it is unclear whether Penix knew that "I ♥ NY" was trademarked at all.²²¹ It is also unclear whether any "actual associations" arose during that period. Both seem unlikely. Interestingly, however, factor (iii), which asks whether the famous trademark's owner has engaged in substantially exclusive use of the trademark, may also weigh in Everyman Espresso's favor, because the "I ♥ NY" trademark is notoriously infringed by third parties.²²² Therefore, Everyman Espresso may not be exposed to dilution by blurring.

Dilution by tarnishment, on the other hand, could pose issues for people with trademark tattoos. A trademark may be tarnished when it "is portrayed in an unwholesome or unsavory context, with the result that the public will associate the lack of quality or lack of prestige in the defendant's goods with the plaintiff's unrelated goods."²²³ In addition, while dilution by tarnishment is typically found in cases related to sexual activity, drug use, or obscenity, it is not limited to sordid activities.²²⁴ Though courts have not yet grappled

218. 15 U.S.C. § 1125(c)(2)(B) (2012).

219. See *supra* notes 129-136 and accompanying text.

220. See *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 267 (4th Cir. 2007).

221. Indeed, most people do not even realize that "I ♥ NY" is trademarked. See *Wagner v. City of New York*, No. 14-CV-2521 VEC, 2015 WL 5707326, at *4 (S.D.N.Y. Sept. 28, 2015).

222. Ramirez, *supra* note 4 (noting that almost all of the "I ♥ NY" products in Midtown Manhattan are unauthorized).

223. *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507 (2d Cir. 1996) (internal quotation marks omitted).

224. See *J&B Wholesale Distributing, Inc. v. Redux Beverages, LLC*, 85 U.S.P.Q.2d 1623 (D. Minn. 2007) (finding tarnishment in unauthorized use of NO NAME trademark in connection with beverage formerly called COCAINE); *America Online, Inc. v. IMS*, 24 F. Supp. 2d 548, 48 U.S.P.Q.2d 1857, 107 A.L.R.5th 781 (E.D. Va. 1998) (finding AOL trademark tarnished by unauthorized use in spam email messages); *Toys "R" Us, Inc. v. Akkaoui*,

with this question, any analysis must give consideration to the growing pervasiveness and acceptance of tattoos by mainstream society. It seems, however, that dilution by tarnishment could pose a liability risk to people with trademark tattoos. In Penix's case, he was using the trademark to sell coffee, which does not seem to portray the "I ♥ NY" trademark in an unwholesome or unsavory context. Regarding trademark tattoos, the mere act of tattooing the trademark on a human body may be considered "unwholesome or unsavory" to some.²²⁵ It is unlikely, however, that Penix would be found liable under a cause of action for tarnishment.

B. Trademark Remedies

Assuming a trademark owner's lawsuit for infringement or dilution is successful, the likely relief will be an injunction. When crafting an appropriate remedy for trademark infringement, a court may limit conduct that is otherwise legal and permissible.²²⁶ Courts, therefore, can broadly fashion injunctive relief to dissuade future infringement.²²⁷ Courts should balance the rights of the trademark owner with the interests and liberties of the parties with trademark tattoos.²²⁸

In trademark cases, injunctive relief is critically important because of the need to prevent consumer confusion.²²⁹ There will be practical difficulty in determining how to accomplish this goal when considering trademark tattoos. To date, the author has not seen any cases like this appear before a court. Parties engaged in conflict over trademark tattoos typically settle such matters long before litigation ensues. At best, this Article can only posit what remedies a court might craft. Shall a party be required to cover their tattoo with a band, adhesive covering, or makeup for appearances that may be considered "use in commerce"? Should the tattooed party position themselves in a manner that hides the offending tattoo? Or, in a worst-case scenario, could a court require that the tattoo be removed or covered with more permanent ink? Some scholars have noted that disclaimers may be used in unique circumstances to eliminate consumer confusion,²³⁰ but in the context of tattoos this would prove to be at minimum, impractical, and at best, incredibly invasive. The challenges of crafting the appropriate injunction

40 U.S.P.Q.2d 1836 (N.D. Cal. 1996) (finding that "'Adults R Us' tarnishes the 'R Us' family of marks by associating them with a line of sexual products").

225. See Perzanowski, *supra* note 14, at 518-21 (tracing the history of tattoos in the United States and noting that tattoos have not always been well-accepted in this country).

226. Kentucky Fried Chicken Corp. v. Diversified Packaging Corp., 549 F.2d 368, 390 (5th Cir. 1977).

227. Patsy's Brand, Inc. v. I.O.B. Realty, Inc., 317 F.3d 209, 220 (2d Cir. 2003) ("[A] court can frame an injunction which will keep a proven infringer safely away from the perimeter of future infringement.") (internal quotation marks omitted).

228. See Cotter & Mirabole, *supra* note 20, at 130.

229. See *id.* at 130.

230. *Id.*

under such circumstances may persuade some judges to apply an ill-fitting defense to the infringing party's conduct, thereby ignoring the question altogether.²³¹

Sidestepping the issue, however, does not address the practical implications of allowing trademark remedies to restrict or otherwise impose upon the liberties of the tattooed parties. As seen in earlier instances, trademark owners have already requested such restrictions through informal phone calls and cease and desist letters.²³²

These pragmatic challenges illustrate that trademark law is currently ill-equipped to deal with questions related to trademark tattoos.²³³ Though a legal solution is necessary to address the gaping legal hole created by the use of trademarks as tattoos, the next Part of this Article argues that the Thirteenth Amendment cannot be used to eliminate the enforcement of traditional trademark infringement and dilution remedies.

III. THE THIRTEENTH AMENDMENT - NO RIGHT TO "FREE" SKIN

The Thirteenth Amendment and contemporary trademark law doctrine are strange bedfellows, seemingly existing on different planets in the legal universe. Nevertheless, it has been argued that the Thirteenth Amendment is rooted in principles that are germane to a discussion of potential enforcement mechanisms and remedies for tattoo-based intellectual property infringement.²³⁴ Applying this argument to a practical example, imagine that the State of New York filed a trademark lawsuit against Sam Penix based on his "I [coffee cup] NY" tattoo and that Penix is found liable for trademark infringement or dilution. The next step, of course, would be for a court to provide relief to the State of New York, likely in the form of an injunction. The basic premise of a Thirteenth Amendment argument would be that, regardless of the State of New York's trademark rights, a court should not be allowed to force Penix to remove the tattoo, or preclude, any activity involving the tattoo because doing so would be sanctioning slavery or involuntary servitude. As argued below, it is unlikely that enforcement suits against trademark tattoos can be likened to slavery or involuntary servitude under the Thirteenth Amendment, or that a Thirteenth Amendment argument could form the basis for disallowing a court to provide injunctive relief to trademark owners.

Professor David Nimmer made the Thirteenth Amendment-intellectual property connection in a copyright lawsuit involving Mike Tyson's tribal

231. *See id.*

232. *See, e.g.,* Newman, *supra* note 1.

233. *See* Cotter & Mirabole, *supra* note 20, at 130 (noting that "the difficulty in crafting an appropriate remedy may influence some courts to find" unauthorized uses permissible under other areas of law).

234. *But c.f.* King, *supra* note 25, at 159 n.184.

face tattoo.²³⁵ There, S. Victor Whitmill, the original tattoo artist who claimed to own all copyrights in the tattoo's design, sued Warner Bros., who planned to release a film called *The Hangover 2* in which one of the actors bore a tattoo nearly identical to the design tattooed on Tyson's face.²³⁶ Professor Nimmer, who was retained by Warner Bros. as an expert witness, opined that tattoos could not be the subject of traditional copyright protection in part because of the Thirteenth Amendment's prohibition on slavery and involuntary servitude.²³⁷ Stating that, "the design inked onto a human being should never constitute the property of another individual," Professor Nimmer encouraged the court to deny copyright protection to tattoos.²³⁸ Otherwise, he argued, the consequences "include[d] the possibility that a court could order the bearer not to remove it . . . ; or to order the bearer to undergo laser removal . . . ; or to prevent magazine, television, and film coverage of the bearer with the tattoo" ²³⁹ In merely one line of his declaration, Professor Nimmer offered, seemingly as an afterthought, that his interpretation was "necessary to avoid the constitutional infirmity that would arise if the Copyright Act attempted to set at naught the Thirteenth Amendment's prohibition of badges of slavery."²⁴⁰

Prior to the lawsuit, Professor Nimmer had written in a footnote in his authoritative treatise, *Nimmer on Copyright*, that a tattoo affixed to human flesh could qualify for copyright protection.²⁴¹ He also authored one other article in 2001 that made a passing reference to bodily property and slavery. There, Professor Nimmer pondered whether a cosmetic surgeon who dramatically altered the physical appearance of a patient could claim copyright protection in the patient's augmented body.²⁴² He ultimately decided that the human body could not be subject to copyright claims after cogitating that "any court presented with such an obscene claim [should] dismiss it summarily, if on no other basis than the constitutional prohibition on involuntary servitude and other badges of slavery."²⁴³ There was no mention in the article of tattoos or a specific reference to the Thirteenth Amendment.

Scholars have roundly disagreed with Professor Nimmer's statements in the Whitmill declaration, noting that copyright protection should indeed ex-

235. Nimmer Declaration ¶ 45.

236. Nimmer Declaration ¶ 3.

237. Nimmer Declaration ¶ 45.

238. *Id.* at P. 48.

239. *Id.* at P. 47.

240. *Id.* at P. 45.

241. See 1 Melville B. Nimmer & David Nimmer, *NIMMER ON COPYRIGHT* § 1.01 [B][1][i] n.392.

242. See David Nimmer, *Copyright in the Dead Sea Scrolls: Authorship and Originality*, 38 HOUS. L. REV. 1, 29 (2001).

243. *Id.*

tend to tattoos based on fundamental concepts of copyright law.²⁴⁴ Neither Professor Nimmer nor the many dissenting voices have provided meaningful treatment to the trademark-related issues raised by such arguments, though some have noted the practical difficulty of dealing with tattoo-related trademark disputes.²⁴⁵ These arguments and analyses, however, are naturally applicable to a discussion of how to enforce trademark law against parties bearing trademark tattoos.²⁴⁶ In particular, the consequences are essentially the same. This Part of the Article will analyze the Thirteenth Amendment through the framework of trademark law and critique Professor Nimmer's suggestion that the amendment precludes the enforcement of intellectual property rights as applied to tattoos.

The Thirteenth Amendment, which abolished slavery in 1865, provides in Section 1 that “[n]either slavery nor involuntary servitude, except as a punishment for crime whereof the party shall have been duly convicted, shall exist within the United States, or any place subject to their jurisdiction.”²⁴⁷ Section 2 of the Thirteenth Amendment empowers Congress to enforce this ban “by appropriate legislation.”²⁴⁸

There is a general consensus among scholars that the Thirteenth Amendment applies to both state and private actors.²⁴⁹ In 1905, the Supreme Court noted that the amendment:

[D]enounces a status or condition, irrespective of the manner or authority by which it is created. The prohibitions of the [Fourteenth] and [Fifteenth] Amendments are largely upon the acts of the states; but the [Thirteenth] Amendment names no party or authority, but simply forbids slavery and involuntary servitude, [and] grants to

244. See, e.g., Lesicko, *supra* note 25; King, *supra* note 25; Cummings, *supra* note 25. Other scholars have suggested that Professor Nimmer reconfigured his opinion to benefit his then-client, Warner Brothers. See Ann Bartow, *When a treatise writer tries to reconfigure copyright law to benefit a client*, THE MADISONIAN (May 25, 2011), <http://madisonian.net/2011/05/25/when-a-treatise-writer-tries-to-reconfigure-copyright-law-to-benefit-a-client> (stating that “Nimmer holds himself out as the nation’s authority on copyright law, and he’s provided a pretty clear road map here about how instrumental and client driven his legal analysis is”).

245. Some have suggested that trademark law is not a “good ‘fit’” for cases involving tattoos, but this is as deep as any analysis to date has gone. See Cotter & Mirabole, *supra* note 20, at 131.

246. Indeed, other commentators have noted that tattoos raise issues in both the copyright and trademark realm. See, e.g., Beasley, *supra* note 25, at 1144 n.44 (stating that, “[e]xploring the issues implicated by the tattooing of trademarked symbols and art is an avenue for further investigation”); see also Cotter & Mirabole, *supra* note 20, at 123-31.

247. U.S. CONST. amend. XIII, § 1.

248. U.S. CONST. amend. XIII, § 2.

249. See, e.g., Ryan D. Walters, *The Thirteenth Amendment “Exception” to the State Action Doctrine: An Originalist Reappraisal*, 23 GEO. MASON U. CIV. RTS. L.J. 283, 289 (2013); George Rutherglen, *State Action, Private Action, and the Thirteenth Amendment*, 94 VA. L. REV. 1367, 1391 (2008).

Congress power to enforce this prohibition by appropriate legislation. The differences between the [Thirteenth] and subsequent amendments have been so fully considered by this [C]ourt that it is enough to refer to the decisions.²⁵⁰

Though Section 1 can apply to private actors, its language will likely fall short of providing parties tattooed with a trademark the foundation for escaping either liability or Draconian remedies potentially sanctioned by trademark law.

Section 1 expressly abolishes American slavery, but it was written to further encompass “involuntary servitude,” which has been interpreted “to cover those forms of compulsory labor akin to African slavery which in practical operation would tend to produce like undesirable results.”²⁵¹ The outermost limits of this language, though difficult to delineate, do not embrace even the most extreme injunctions based on trademark infringement.²⁵²

In *United States v. Kozminski*, the seminal case interpreting the term “involuntary servitude,” two men with mental disabilities were “found laboring on [a] farm in poor health, in squalid conditions, and in relative isolation from the rest of society.”²⁵³ Their captors used psychological coercion, threats of institutionalization, and physical abuse to keep the men on the farm.²⁵⁴ The captors were charged with several crimes based on their violation of the two men’s Thirteenth Amendment right to be free from involuntary servitude.²⁵⁵ The Supreme Court held that involuntary servitude requires “a condition of servitude in which the victim is forced to work for the defendant by the use or threat of physical restraint or physical injury, or by the use or threat of coercion through law or the legal process,” except under exceptional circumstances.²⁵⁶ The Court rejected the Government’s arguments that involuntary servitude could also encompass other forms of coercion.²⁵⁷ In particular, the government urged the Court to adopt a broad definition of involuntary servitude, “which would prohibit the compulsion of services by

250. See Walters, *supra* note 249, at 289 (citing *Clyatt v. United States*, 197 U.S. 207, 216 (1905)).

251. *United States v. Kozminski*, 487 U.S. 931, 942 (1988).

252. See *id.*

253. *Id.* at 931.

254. *Id.*

255. *Id.*

256. *Kozminski*, 487 U.S. at 961 (Brennan, J., concurring) (recounting that the relevant definitions of “servitude” include, “[c]ondition[s] of a slave; slavery; serfdom; bondage; state of compulsory subjection to a master,” and “[t]he condition of a slave; a state of subjection to a master or to arbitrary power of any kind”); Justice Brennan stated in a concurring opinion that Section 1 should include any coercion that looks like pre-Civil War slavery (noting that relevant factors include “complete domination over all aspects of the victim’s life, oppressive working and living conditions, and lack of pay or personal freedom are the hallmarks of that slave-like condition of servitude”). *Id.* at 962-63.

257. *Id.* at 952.

any means that, from the victim's point of view, either leaves the victim with no tolerable alternative but to serve the defendant or deprives the victim of the power of choice."²⁵⁸ The Court was concerned that this would criminalize day-to-day activities and be wholly dependent on the victim's state of mind.²⁵⁹ Ultimately, the captors' convictions were reversed and the case was remanded for a new trial, because the District Court's instructional definition of involuntary servitude was too broad.

The permissible trademark remedies (injunctive relief and/or money damages) also pale in comparison to other cases where courts have had to determine the existence of involuntary servitudes. In *Clyatt v. United States*,²⁶⁰ for example, the Court held that peonage, a condition in which the person is forced by a master's threats to work off a debt, is compulsory service and thus involuntary servitude. In *Clyatt*, two parties were held in peonage against their will to "work out a debt" they owed to a group of men.²⁶¹ In finding that the victims had no choice but to either work or face legal penalties, the Court noted that the Thirteenth Amendment "denounces a status or condition, irrespective of the manner or authority by which it is created."²⁶² Relatedly, the Court has also invalidated state laws that allowed a person fined for a misdemeanor to agree to work for a surety who would, in exchange for such work, pay the convict's misdemeanor fine to the appropriate agency.²⁶³ Finally, the Court has also struck down state laws subjecting debtors to prosecution and criminal punishment for failing to work off a debt after receiving advance compensation.²⁶⁴

In the trademark tattoo context, infringing parties are not forced to work by use or threat of physical restraint or injury, or by the use or threat of coercion through the law or legal process. Indeed, they are not forced to work in any sense. Unlike the brands forcibly placed onto African and African-American slaves, the vast majority of tattoos in the United States are volitionally obtained. Even if a party with a trademark tattoo is found liable for trademark infringement or dilution, they will be subject to, at best, an injunction that requires behavior modification, and at worst (though unlikely), an injunction that requires body modification. Therefore, Section 1 would not apply.

While Section 1 of the Thirteenth Amendment only applies to slavery and involuntary servitude, Section 2 gives Congress broad authority to pass

258. *Id.* at 949.

259. *Id.* at 949-50.

260. 197 U.S. at 215-16.

261. *Id.* at 214.

262. *Id.* at 216.

263. *United States v. Reynolds*, 235 U.S. 133, 146-49 (1914).

264. *See, e.g., Pollock v. Williams*, 322 U.S. 4 (1944); *Bailey v. Alabama*, 219 U.S. 219 (1911).

legislation enforcing Section 1's ban on forced labor.²⁶⁵ Section 2 also has been interpreted broadly to allow Congress to craft other types of legislation.²⁶⁶ Congress is further empowered "to pass all laws necessary and proper for abolishing all badges and incidents of slavery in the United States."²⁶⁷ Using its Section 2 power, Congress has passed legislation prohibiting racial discrimination in contracts, property matters like conveyances and the sale of real estate, and punishing race-based crimes on public property.²⁶⁸ Even so, the type of activity that constitutes a badge or incident of slavery has not been well defined in the courts or in the literature.²⁶⁹

Many scholars have implored Congress to craft legislation under its Section 2 powers related to a vast array of legal issues tied to historically marginalized groups of people, including "hate crimes, hate speech, racial profiling, disproportionate capital sentencing of black defendants, violence against women, sexual harassment, reproductive rights, and gay marriage."²⁷⁰ Others have taken a much more expansive view of Section 2, claiming that the badges and incidents of slavery should include actions such as city street closings²⁷¹ and human cloning.²⁷² Whether tattoos necessitate legislation under Section 2 requires an analysis of current theoretical frameworks, as neither Congress nor the Courts provide much guidance in this arena.

If the interpretation of "badges and incidents of slavery" is considered on a spectrum, there are three prevailing approaches that exist on the most extreme points and one sitting squarely in the middle. The narrowest ap-

265. U.S. CONST. amend. XIII.

266. Jennifer Mason McAward, *Defining the Badges and Incidents of Slavery*, 14 U. PA. J. CONST. L. 561, 563 (2012). The first Supreme Court cases interpreted Section 2 quite narrowly. See *United States v. Harris*, 106 U.S. 629, 640-42 (1883) (finding that the Ku Klux Klan Act of 1871, designed to enforce criminal penalties for certain racist KKK activities, was an impermissible exercise of the power under Section 2 because it covered people who had never been enslaved). Less than one year later, the Supreme Court also held that the Civil Rights Act of 1875 was an impermissible exercise of Congress's Section 2 power because Section 2 did not allow Congress to prohibit race-based discrimination in public spaces. *The Civil Rights Cases*, 109 U.S. 3, 20-22 (1883).

267. *The Civil Rights Cases*, 109 U.S. at 20.

268. See McAward, *supra* note 266, at 563-64.

269. Professor McAward has noted that many questions remain unanswered, including: "[w]hat, however, qualifies as a badge or incident of slavery? Does this concept refer only to a public law that discriminates against African Americans or, more generally, on the basis of race? Alternatively, does it encompass any public or private practice that perpetuates racial inferiority? Or is its scope even broader, extending to any act motivated by arbitrary class prejudice?" See *id.* at 564 (internal quotation marks omitted).

270. *Id.* at 564 (internal citations omitted).

271. *City of Memphis v. Greene*, 451 U.S. 100, 124-26 (1981).

272. Sean Charles Vinck, Note, *Does the Thirteenth Amendment Provide a Jurisdictional Basis for a Federal Ban on Cloning?*, 30 J. LEGIS. 183, 185-86 (2003) (stating that "[t]he Thirteenth Amendment is a particularly promising source of . . . authority" for a federal cloning ban).

proach is based wholly on race-based discrimination. The broadest approach applies to any type of class-based subjugation. The middle ground approach focuses on race and previous histories of servitude. Contrary to Professor Nimmer's argument, none of these approaches provide tattooed parties with any protection under the Thirteenth Amendment.²⁷³

The narrow approach, articulated by both Judge A. Leon Higginbotham²⁷⁴ and Judge John Minor Wisdom,²⁷⁵ requires that conduct "(1) target African-Americans as a class, (2) in a way that labels them inferior, and (3) is historically linked to slavery and its aftermath."²⁷⁶ Clearly, under this approach, trademark infringing or diluting tattoos cannot seek solace in the Thirteenth Amendment. Trademark enforcement does not target African-Americans in a way that labels them inferior. While there may be an attenuated connection between slave branding and trademark tattoos,²⁷⁷ trademark tattoos are not linked to slavery or its aftermath. Thus, trademark enforcement over infringing tattoos would not be prohibited by the Thirteenth Amendment under this approach.

Nor does the middle ground approach, proposed by Professor Jennifer Mason McAward, prohibit trademark enforcement over infringing tattoos. Professor McAward's proposed approach to the badges and incidents of slavery allows Congress to act under Section 2 where there is

[P]ublic or widespread private conduct that targets a group on the basis of race or previous condition of servitude, that mimics the law of slavery, and that poses a substantial risk that the members of the targeted population will be returned to de facto slavery or otherwise denied the ability to participate in the basic transactions of civil society.²⁷⁸

Here, trademark enforcement does not target a group on the basis of race or previous condition of servitude—it targets people who have allegedly committed trademark infringement. Nor does being subject to an injunction mimic the law of slavery. Finally, there is no risk that trademark infringers with trademark tattoos will be returned to slavery. There could be an issue of participating in the "basic transactions of civil society," if a broad injunction

273. To the author's knowledge, Professor Nimmer has not publicly expounded on the statements made in his declaration and how he came to such conclusions. Other scholars, however, have called his statements both "rather shocking" and "shockingly unconvincing." See Bartow, *supra* note 244, at 496.

274. See *Pennsylvania v. Local Union No. 542, Int'l Union of Operating Eng'rs*, 347 F. Supp. 268 (E.D. Pa. 1972).

275. See *Williams v. City of New Orleans*, 729 F.2d 1554, 1570 (5th Cir. 1984) (en banc) (Wisdom, J., concurring in part and dissenting in part).

276. See McAward, *supra* note 266, at 600.

277. See *supra*, Part II.A, C (discussing history of slave branding and contemporary trademark tattoos).

278. See McAward, *supra* note 266, at 606.

is granted disallowing photos and other appearances. Regardless, this unlikely scenario still cannot meet the other factors proposed by Professor McAward.

The broadest approach to defining the badges and incidents of slavery has been proposed by Professor Sidney Buchanan.²⁷⁹ This approach suggests that a badge or incident of slavery is “any act motivated by arbitrary class prejudice which, in its cumulative manifestations, has assumed a pattern of regional significance.”²⁸⁰ This approach does not limit the framework to race at all; conduct can be based on any number of group commonalities.²⁸¹ The first logical key here is whether the acts are arbitrary. With respect to trademark infringement or dilution lawsuits, such actions are not arbitrary but based on the conduct of the alleged infringer. This would foreclose Thirteenth Amendment protection to infringers bearing trademark tattoos. In addition, trademark infringement is not generally regional, but merely tied to the location of the alleged infringer.²⁸²

Though Professor Nimmer’s claims raise novel questions, the Thirteenth Amendment is not the appropriate vehicle to insulate tattooed infringers from liability for trademark infringement. As a practical matter, courts historically interpret the Thirteenth Amendment to be inextricably linked to matters of race and racial discrimination. Though scholars have offered creative expansions of Section 2, it is unlikely that trademark tattoos will fall within the ambit of the badges and incidents of slavery.

CONCLUSION

Tattoos will likely continue to grow in popularity as social attitudes and technology progress.²⁸³ Millennials are tattooing their bodies at increasing rates, and with such realities will necessarily come more brand enthusiasts willing to permanently ink their favorite logos on their bodies. The digital age will also lead to more opportunities to capitalize on one’s personal brand through photos, videos, and other new media. As Sam Penix learned, this can also lead to liability exposure when trademark owners believe tattoos are likely to confuse or dilute the goodwill they have worked hard to obtain. As alarming as it might be to consider the parade of horrors that may emerge

279. G. Sidney Buchanan, *The Quest for Freedom: A Legal History of the Thirteenth Amendment*, 12 HOUS. L. REV. 1069, 1073 (1975).

280. McAward, *supra* note 266, at 602 (citing Buchanan, *supra* note 279, at 1072, 1077).

281. Buchanan, *supra* note 279, at 1084 (“There is nothing in the nature of the trait upon which a given act of discrimination is based that limits congressional power under § 2 of the thirteenth amendment.”).

282. However, the Everyman Espresso question raises a unique question in this regard. Presumably, the “I ♥ NY” trademark would be used and likely infringed in greater numbers in the State of New York, and more specifically in areas populated with many tourists.

283. Indeed, both Nokia Corporation and Motorola Mobility, Inc. have filed patent applications on tattoos that can be connected to cellular phones. *See* U.S. Patent No. US 2012/0062371 (filed Sept. 13, 2011); U.S. Patent No. US 2013/0297301 (filed May 3, 2012).

through injunctive relief, the Thirteenth Amendment is not an appropriate means of combating such fears. Trademark law, much like the tattoo universe, will have to innovate to come up with creative solutions to enforcement concerns.

APPENDIX A.

FIGURE 1. THE BELOW FIGURE DEPICTS THE EVERYMAN ESPRESSO LOGO FEATURING SAM PENIX'S FIST AND TATTOO.²⁸⁴



FIGURE 2. THE BELOW IMAGE DEPICTS SAM PENIX'S TATTOO.²⁸⁵



284. EVERYMAN ESPRESSO (Feb. 20, 2013), <http://web.archive.org/web/20130412143639/http://everymanespresso.com/>.

285. Newman, *supra* note 1.

APPENDIX B.

FIGURE 3. THE IMAGE BELOW DEPICTS THE MOST COMMON REPRESENTATION OF THE “I ♥ NY” TRADEMARK.²⁸⁶



286. U.S. Trademark Application Serial No. 3,097,782 (filed Apr. 22, 2005).