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NAVIGATING THE IDENTITY THICKET:
TRADEMARK'S LOST THEORY OF PERSONALITY,
THE RIGHT OF PUBLICITY, AND PREEMPTION

Jennifer E. Rothman

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NAVIGATING THE IDENTITY THICKET: TRADEMARK'S LOST THEORY OF PERSONALITY, THE RIGHT OF PUBLICITY, AND PREEMPTION

*Jennifer E. Rothman**

Both trademark and unfair competition laws and state right of publicity laws protect against unauthorized uses of a person's identity. Increasingly, however, these rights are working at odds with one another and can point in different directions with regard to who controls a person's name, likeness, and broader indicia of identity. This creates what I call an "identity thicket" of overlapping and conflicting rights over a person's identity. Current jurisprudence provides little to no guidance on the most basic questions surrounding this thicket, such as what right to use a person's identity, if any, flows from the transfer of marks that incorporate indicia of a person's identity, and whether such transfers can empower a successor company to bar a person from using their own identity, and, if so, when.

Part of the challenge for mediating these disputes is that both right of publicity and trademark laws are commonly thought of as concerned solely with market-based interests. But this is not the case. As I have documented elsewhere, the right of publicity has long been directed at protecting both the economic and the noneconomic interests of identity-holders. And, as I demonstrate here, it turns out that the same is true for trademark and unfair competition laws, which have long protected a person's autonomy and dignity interests as well as their market-based ones.

After documenting and developing this overlooked aspect of trademark law, I suggest a number of broader insights of this more robust account of trademark law both for addressing the identity thicket and for trademark law more generally. First, I suggest that recognizing a personality-based facet of trademark law suggests a basis to limit the alienation of personal marks in some contexts. Second, this understanding shores up trademark's negative spaces, especially when truthful information is at issue. Third, recognizing trademark's personality-based interests provides a partial explanation (and limiting principle) for some of its expansionist impulses.

Finally, I contend that recognizing this broader vision of trademark law provides significant guidance as to how to navigate the identity thicket. I employ trademark preemption analysis to mediate disputes between trademark and right of publicity laws. Trademark preemption provides an avenue out of the thicket, but only if trademark law's robust theory of personality is recognized. A failure to do so risks leaving us with one of two bad options: a right of publicity that acts as a "mutant" trademark law, swallowing

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up and obstructing legitimate rights to use trademarks, or, alternatively, with a shallow husk of trademark law (rooted solely in commercial interests) that swallows up publicity claims at the expense of personal autonomy and dignity. Trademark law already provides us with the tools to avoid both of these unsavory paths — if only we reclaim its lost personality.

INTRODUCTION

Both trademark and unfair competition laws and state right of publicity laws protect against unauthorized uses of a person's identity. These distinct rights are thought to work in harmony to protect a person's commercial and personal interests. Increasingly, however, these rights are working at odds with one another and can point in different directions with regard to who controls a person's name, likeness, and broader indicia of identity. This creates an *identity thicket* of overlapping and conflicting rights over a person's identity. Because these rights are rooted in a person, rather than in something external, the conflicts pose even more profound concerns than do the identified patent thickets that have obstructed innovation and commercialization.¹ Here the intersecting and fragmentary property rights do more than just obstruct market exploitation. They implicate fundamental rights, such as whether and how a person's right to their own identity can be limited or owned by another, and whether and how businesses whose names and brand identities are rooted in individuals can separate from those individuals.

Current jurisprudence provides little to no guidance on the most basic questions surrounding this thicket. It is unclear what right to use a person's identity, if any, flows from the transfer of marks that incorporate indicia of that person's identity. Nor is it clear whether such transfers can empower a successor company to bar a person from using their own identity, and, if so, when. Not only do an individual's freedom to work, to speak, and even to appear in public hang in the balance, but so does the operation of many businesses. The resolution of such disputes also implicates consumers' access to information about products and services, as well as trademark holders' freedom of speech.

Disputes involving these identity thickets are percolating and flaring up around the country with inconsistent and contradictory results. *Publicity-holders* and *identity-holders* are suing *markholders*, and *markholders* and *publicity-holders* are suing *identity-holders*.² The

¹ See Carl Shapiro, *Navigating the Patent Thicket: Cross Licenses, Patent Pools, and Standard Setting*, 1 INNOVATION POL'Y & ECON. 119, 120 (2000); see also Dan L. Burk & Mark A. Lemley, *Policy Levers in Patent Law*, 89 VA. L. REV. 1575, 1614–15, 1628–29, 1693–95 (2003).

² I developed the use of the terms *identity-holder* and *publicity-holder* in earlier work. See Jennifer E. Rothman, *The Inalienable Right of Publicity*, 101 GEO. L.J. 185, 186–87 (2012). I use the term *identity-holder* to designate the underlying natural person upon whom the right of publicity and sometimes trademarks are based. The *publicity-holder* is the person or entity that owns

challenge is far more complex and serious than one solely of contract interpretation or better prospective contract drafting (though that would certainly help matters); it raises questions about the underlying objectives and scope of trademark law and right of publicity laws, as well as about the extent to which we are willing to tolerate significant restraints on individual liberty to further the freedom of contract, particularly in contexts in which transferred property rights are tightly rooted in an individual's identity.³

To the extent that conflicts between trademark law and the right of publicity have been recognized, it has largely been in the context of claims brought by the same plaintiff and concerns that the right of publicity can be used as an end-run around more limited trademark and unfair competition rights to expand the scope of liability and limit the reach of speech-related defenses.⁴ It is in this context that Professors Stacey Dogan and Mark Lemley have referred to the right of publicity as “a mutant version of trademark policy.”⁵ But the right of publicity is also becoming a mutant form of trademark law by being wielded against rightful markholders to limit how they can use their own marks.

Part of the challenge for mediating these disputes is that both right of publicity and trademark laws are commonly thought of as concerned solely with market-based interests. But this is not the case. As I have documented at length elsewhere, the right of publicity has long been directed at protecting both the economic and the noneconomic interests of identity-holders.⁶ As I will demonstrate in this Article, it turns out that the same is true for trademark and unfair competition law. Even though trademark law is usually thought of as having only two goals — one of protecting markholders' commercial interests and another of protecting consumers from being deceived or confused in the marketplace⁷ — trademark and unfair competition laws have also long sought to protect the personality of individuals. They have done so not only to

a person's right of publicity. If the right of publicity is transferable, then the publicity-holder could be someone other than the identity-holder. The *markholder* is the person or entity that owns the relevant trademarks and trade names. I will discuss this taxonomy in more detail in Part I.

³ See Margaret Jane Radin, *Property and Personhood*, 34 STAN. L. REV. 957, 959–61 (1982); Rothman, *supra* note 2, at 208–20, 225–32; see also MARGARET JANE RADIN, *CONTESTED COMMODITIES passim* (1996) (questioning the treatment of “contested commodities” that are rooted in “persons and the nature of human life” as marketable forms of property, *id.* at xi).

⁴ See, e.g., JENNIFER E. ROTHMAN, *THE RIGHT OF PUBLICITY* 158–59 (2018); Robert C. Post & Jennifer E. Rothman, *The First Amendment and the Right(s) of Publicity*, 130 YALE L.J. 86, 151–54 (2020); Rebecca Tushnet, *Raising Walls Against Overlapping Rights: Preemption and the Right of Publicity*, 92 NOTRE DAME L. REV. 1539, 1539–40, 1558–59 (2017).

⁵ Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1166 (2006).

⁶ See ROTHMAN, *supra* note 4, at 30–44; Post & Rothman, *supra* note 4, at 93–125.

⁷ See, e.g., 1 J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 2.1 (5th ed. 2020); see also *infra* Part II, pp. 1289–92.

protect the market value of the underlying identity-holders and marks, but also to protect a person's autonomy and dignity.

Scholars have largely overlooked this aspect of trademark law. In contrast, in other areas of intellectual property (IP) law, such as copyright and patent laws, many have recognized and developed such personality-oriented objectives.⁸ This Article addresses this gap by identifying and beginning to develop such a personality theory of trademark law. Recognizing and understanding this aspect of trademark law is essential to mediating its increasing conflicts with the right of publicity. Given the primacy of the federal rights afforded under the Lanham Act,⁹ the trademark regime should take precedence over conflicting state-based publicity rights; however, it is only when trademark's protections for personality are incorporated into the regime that such conflicts can be appropriately resolved, giving due respect to both the market-based and the personality-based injuries that flow from the unauthorized use of a person's identity. This overlooked strand of trademark law also suggests there should be greater scrutiny of the alienability of personal marks and provides one potential explanation (as well as some limiting principles) for the much-criticized and seemingly unending expansion of the scope of trademark liability.

The Article proceeds in five Parts. In Part I, I consider how federal and state trademark and unfair competition laws are increasingly conflicting with state right of publicity laws to create today's identity thicket. In Part II, I briefly set forth the widely recognized objectives of trademark law. Courts and scholars who rely solely on these conventional trademark objectives, rooted primarily in the economic interests of markholders and to a lesser extent in protecting consumers, overlook the personality-based objectives of trademark law.

I therefore turn in Part III to identifying this lost thread of trademark law. To the extent personality interests have been considered by scholars in the context of trademark law, it has primarily been in the context of justifying defendants' uses of others' marks, not as part of an

⁸ See, e.g., Shyamkrishna Balganesh, *Privative Copyright*, 73 VAND. L. REV. 1 *passim* (2020); Jeanne C. Fromer, *Expressive Incentives in Intellectual Property*, 98 VA. L. REV. 1745, 1759–64 (2012); Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 CARDOZO ARTS & ENT. L.J. 81, 82–85, 168–74, 179–81 (1998) (considering personality interests primarily in copyright and patent laws, and briefly in the context of human cell lines and the right of publicity); Christopher S. Yoo, *Rethinking Copyright and Personhood*, 2019 U. ILL. L. REV. 1039 *passim*; cf. Seana Valentine Shiffrin, *Intellectual Property*, in 1 A COMPANION TO CONTEMPORARY POLITICAL PHILOSOPHY 653, 660 (Robert E. Goodin, Philip Pettit & Thomas Pogge eds., 2d ed. 2007) (describing personality-based theories of IP more generally, and their particular applicability to “moral rights’ legislation” in the copyright context and to “rights of publicity,” without considering their relevance to trademark law).

⁹ Ch. 540, 60 Stat. 427 (1946) (codified as amended in scattered sections of 15 U.S.C.).

affirmative theory of trademark rights.¹⁰ There are very few accounts of trademark law that suggest that this body of law serves as anything other than a tool of economic efficiency.¹¹ Accordingly, in this Part, I document trademark and unfair competition law's longstanding protection of personality rights. These personality-based objectives were present from the beginning, and, despite claims to the contrary, are reflected in the continued differential treatment afforded to *personal marks* today.¹² Personal marks are those that include (or are entirely composed of) the portrait, name, or other indicia of identity of a natural person. The anomalous treatment of such marks has long been rooted in the autonomy and dignity interests of the individuals whose personalities are intertwined with such marks.

The few who have acknowledged this aspect of trademark law have largely consigned this "sacred rights" theory to the dustbin of history. Yet, as I demonstrate, the law involving personal marks has remained largely consistent from the 1800s to the present. One reason that some have missed this continuity of treatment is that they have not considered the longstanding limits on the doctrine. The right to use one's own name in trade was never "absolute" or unfettered.¹³ In addition, some have mistaken a shift in the market for a shift in doctrine. With the Industrial Revolution's technological advancements, particularly the rise of mass production and the ability to distribute goods far from where they were produced, marks shifted from primarily indicating particular

¹⁰ See, e.g., Rosemary J. Coombe, *Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue*, 69 TEX. L. REV. 1853, 1868–80 (1991) (discussing the importance of being able to use marks for "the cultural construction of self and world," *id.* at 1880); cf. Sonia K. Katyal, *Trademark Intersectionality*, 57 UCLA L. REV. 1601, 1609–38 (2010) (considering the expressive role, both personally and culturally, of trademarks).

¹¹ Two notable exceptions are Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621 (2004), which suggests that the economic account of trademark law is incomplete and provides a semiotic account, *id.* at 623–26, and Jeremy N. Sheff, *Marks, Morals, and Markets*, 65 STAN. L. REV. 761 (2013), which proposes using a "deontological moral theory" derived from social contract theory, *id.* at 763.

For an account of the dominant law and economics model of trademark law, see William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265 (1987). See generally Stephen L. Carter, Comment, *The Trouble with Trademark*, 99 YALE L.J. 759, 761–75 (1990) (explaining the economic model for trademark law); Nicholas S. Economides, *The Economics of Trademarks*, 78 TRADEMARK REP. 523 (1988); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687 (1999) (describing the current economic rationale for trademark law and critiquing expansions of trademark law that deviate from it).

¹² See WILLIAM HENRY BROWNE, A TREATISE ON THE LAW OF TRADE-MARKS AND ANALOGOUS SUBJECTS § 366 (Boston, Little, Brown & Co. 1873) (describing a "[p]ersonal trademark" as one that "is so clearly personal as to import that the goods bearing it are manufactured by a particular person"); see also ARTHUR P. GREELEY, FOREIGN PATENT AND TRADEMARK LAWS § 163 (Washington, D.C., John Byrne & Co. 1899) (distinguishing the treatment of personal marks from that of others in a variety of countries).

¹³ See *infra* section III.A, pp. 1295–317; see also sources cited *infra* notes 96–97 and accompanying text.

individuals and known sources to more commonly indicating “single, though anonymous, source[s].”¹⁴ The reduced salience of personal marks, however, did not upend their unique treatment.

In Part IV, I provide a number of reasons we should continue to consider personality-based objectives in trademark and unfair competition law, and suggest some implications of doing so. Embracing trademark’s personality-oriented objectives does not suggest a massive rethinking of trademark law writ large. Instead, trademark and unfair competition law’s concerns about individual autonomy and dignity should apply *only* in the context of uses of personal marks or a person’s identity. A personality-based understanding of trademark law provides renewed support for limits on the transferability not only of publicity rights but also of some personal marks when they are inseparable from the underlying person — what I designate as *de jure* personal marks. Recognizing trademark law’s personality-based doctrines also shores up trademark’s *negative spaces*. It provides yet another example of a well-developed carve-out from trademark enforcement to provide latitude for competition and the provision of truthful information. A theory of trademark law that includes consideration of personality rights also provides an explanation for Professor Barton Beebe’s recent and insightful claim that trademark law has “mutat[ed] . . . into corporate right of publicity law.”¹⁵ While Beebe identifies the current expansionist impulse in trademark law as drawing from state right of publicity laws, I demonstrate here that this aspect of trademark law appears to be (at least in part) internally (rather than externally) based. To the extent that these expansions emerge from a personality-based vision of trademark law, they should be cabined to instances in which the claims are rooted in (and asserted by) a natural person.

In Part V, I use the more robust understanding of trademark law’s objectives, including its personality-based aspects, to provide an analytical framework for addressing the identity thicket, particularly conflicts between trademark law and publicity rights. I propose employing *trademark preemption* analysis to determine when state publicity laws

¹⁴ Cal. Apparel Creators v. Wieder of Cal., Inc., 162 F.2d 893, 897 (2d Cir. 1947) (noting that consumers need not know “the personal identity of the manufacturer”); see also 2 MCCARTHY, *supra* note 7, § 15:8 (describing the “anonymous source rule” and its codification into federal law in 1984).

¹⁵ Barton Beebe, *What Trademark Law Is Learning from the Right of Publicity*, 42 COLUM. J.L. & ARTS 389, 393 (2019) (capitalization omitted); cf. Robert C. Denicola, *Institutional Publicity Rights: An Analysis of the Merchandising of Famous Trade Symbols*, 62 N.C. L. REV. 603, 620–21, 623–27 (1984) (supporting extending merchandising rights to well-known trademarks in part by analogizing to state publicity rights); Rochelle Cooper Dreyfuss, *We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity*, 20 COLUM.-VLA J.L. & ARTS 123, 124–25, 130–34, 136 (1996) (considering the expansions in trademark law and how they track similar interests to those of broad rights of publicity).

should yield to federal trademark and unfair competition laws. Properly understood, trademark law and the right of publicity can work in tandem to protect a person's commercial and personality-based interests without unduly restricting fair competition and free speech.

Revealing this largely lost theory of personality that lurks at the margins of today's trademark law is particularly important at this juncture not only because of the increasing litigation involving the nexus of right of publicity and trademark laws, but also because of the rise of social media influencers and personal brands. People are increasingly seeking trademark protection for themselves, unmoored from particular products or services — what Professor William McGeeveran has dubbed “self-marks.”¹⁶ Whatever one thinks of this trend, it indicates the need to better develop this underexplored facet of trademark law. A failure to do so risks leaving us with one of two bad options: a right of publicity that acts as a “mutant” trademark law,¹⁷ swallowing up and obstructing legitimate rights to use trademarks, or, alternatively, with a shallow husk of trademark law (rooted solely in commercial interests) that swallows up publicity claims at the expense of personal autonomy and dignity. Trademark law provides us with the tools to avoid both of these unsavory paths — if only we reclaim its lost personality.

I. THE IDENTITY THICKET

Both state right of publicity laws and federal (and state) trademark and unfair competition laws extend protection against unauthorized uses of a person's identity, most often unauthorized uses of a person's name or likeness. Trademark law primarily protects words, symbols, and designs that indicate the source of products or services.¹⁸ Trademark and broader unfair competition claims protect individuals by restricting the unauthorized use of a person's identity as a mark (or otherwise) to falsely indicate source, endorsement, or sponsorship. In contrast, the right of publicity does not focus on source (or affiliation) identification. Instead, it protects individuals more broadly against unauthorized uses of their identities often without regard to whether

¹⁶ See William McGeeveran, *Selfmarks*, 56 HOUS. L. REV. 333, 334–36, 338 (2018); see also Oliver Bajracharya & Drew Wilson, *Protecting Influence*, L.A. LAW., Feb. 2020, at 22, 22 (encouraging social media influencers to seek trademark registrations).

¹⁷ Cf. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) (rejecting a Lanham Act claim that would restrict the copying of a public domain work because to rule otherwise “would create a species of mutant copyright law”); Dogan & Lemley, *supra* note 5, at 1166 (criticizing the right of publicity for operating as “a mutant version of trademark policy” that lacks trademark law's “limitations”).

¹⁸ As is customary, I use the term “trademark” broadly to encompass marks for products, services, and company names, although the latter two can also be designated more specifically as “service marks” and “trade names.” When relevant, I will indicate the differences among these terms.

they sell particular products or services and usually without regard to any likely confusion or dilution related to the uses.

More specifically, the Lanham Act — the governing federal trademark and unfair competition statute — protects a person's identity in a variety of ways. The statute expressly bars the registration of marks that employ another person's name or signature without that person's permission, and does so without requiring a demonstration of likely confusion as to source or sponsorship.¹⁹ Sections 32 and 43(a) of the Lanham Act extend protection against trademark infringement of a person's name, likeness, or other indicia of identity if such indicia qualify as a mark.²⁰ Section 43(a) provides additional claims without regard to whether a person can claim a trademark in aspects of their identity. Such claims include those for false endorsement and false advertising.²¹ To the extent that a person can claim that some aspect of their identity rises to the level of a mark and a famous one at that, section 43(c) allows such a person to sue for dilution. Such claims arise when a defendant's use is likely to blur public associations with the person's mark or tarnish the mark's image, without regard to whether confusion is likely.²² State trademark and unfair competition laws generally track these provisions and provide similar protections.

State right of publicity laws also protect against unauthorized uses of a person's identity — but in contrast to trademark and unfair competition laws, this is their sole basis for existence. State publicity laws provide far broader protection over a person's identity than trademark and unfair competition laws do, extending coverage unmoored from status as a mark, any connection with particular goods or services, and without using confusion as the primary fulcrum of liability. State publicity laws vary widely, with states making wildly disparate decisions about who can bring publicity claims and under what circumstances.²³ This uncertainty makes navigating potential conflicts between rights over a person's identity difficult to manage, as it may be unclear which state law will apply and, in the context of nationally (or internationally) distributed products, multiple states' right of publicity laws could potentially apply. This is a problem more generally, but is especially challenging when trying to mediate conflicts with rights to a person's identity that also implicate trademarks and potential Lanham Act claims.

¹⁹ See 15 U.S.C. § 1052(a), (c).

²⁰ *Id.* §§ 1114, 1125(a).

²¹ *Id.* § 1125(a).

²² *Id.* § 1125(c).

²³ ROTHMAN, *supra* note 4, at 96–98; see also ROTHMAN'S ROADMAP TO THE RIGHT OF PUBLICITY, <https://rightofpublicityroadmap.com> [<https://perma.cc/2S4F-UX8Y>] (providing an online guide to state right of publicity laws).

Few have considered this problem because trademark and right of publicity claims are often brought by (or on behalf of) a single person, who brings a variety of claims in the same complaint, including Lanham Act claims for trademark infringement, false endorsement, and/or false advertising; state-based trademark and unfair competition claims; and state right of publicity (and/or right of privacy) claims.²⁴ Examples of such wide-ranging (but harmonious) claims by identity-holders abound. When Rosa Parks sued Outkast's record label over the group's naming a song "Rosa Parks," she brought a false advertising claim under the Lanham Act, as well as a common law right of publicity claim under Michigan law.²⁵ When Ginger Rogers objected to Federico Fellini's naming his movie "Ginger and Fred," she brought a lawsuit with claims under the Lanham Act for false endorsement and under Oregon law for a violation of her right of publicity.²⁶ When Michael Jordan sued over the use of his name and jersey number in print promotions for two supermarket chains, he asserted Lanham Act claims for trademark infringement, dilution, false designation of origin, and false endorsement, as well as state unfair competition and right of publicity claims.²⁷ When Tiger Woods objected to Rick Rush including his likeness and name in an art print and accompanying material, Woods's company, the ETW Corporation (ETW), asserted claims under the Lanham Act for trademark infringement, trademark dilution, unfair competition, and false advertising, as well as state trademark and unfair competition claims, and a state right of publicity claim under Ohio law.²⁸

Whatever the merits of these various claims in these particular contexts, in each instance the trademark, unfair competition, and publicity claims worked in harmony on behalf of the identity-holder or publicity-holder even if the elements of the claims (and analyses of defenses) differed. But this need not be so. And it will often not be the case when

²⁴ Even those who have observed a potential clash of rights have largely overlooked this type of conflict. See, e.g., Sheldon W. Halpern, *Trafficking in Trademarks: Setting Boundaries for the Uneasy Relationship Between "Property Rights" and Trademark and Publicity Rights*, 58 DEPAUL L. REV. 1013, 1044-45 (2009) (concluding that trademark law and the right of publicity will not usually conflict if neither covers merchandising rights and the right of publicity is defined narrowly); Tushnet, *supra* note 4, at 1540-42, 1558 (observing and criticizing the differential treatment of First Amendment defenses in right of publicity and Lanham Act false endorsement cases); cf. Dogan & Lemley, *supra* note 5, *passim* (considering the ways in which the right of publicity is more expansive than trademark law and less protective of free speech).

²⁵ Parks v. LaFace Recs., 329 F.3d 437, 442-43 (6th Cir. 2003). Parks also brought defamation and tortious interference with a business relationship claims. *Id.* at 443.

²⁶ Rogers v. Grimaldi, 875 F.2d 994, 997 (2d Cir. 1989). Rogers also brought defamation and false light claims. *Id.*

²⁷ See Amended Complaint at 2, Jordan v. Dominick's Finer Foods, 115 F. Supp. 3d 950 (N.D. Ill. 2015) (No. 10-cv-00407); see also Jordan v. Jewel Food Stores, Inc., 743 F.3d 509, 513 (7th Cir. 2014).

²⁸ ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 918-19 (6th Cir. 2003).

the rights of an identity-holder are not all held by the same person or entity. To the extent that trademarks are transferable — which they usually are — and the right of publicity is also transferable — something which I have strongly argued against, but that is often claimed to be the case²⁹ — then we could have many players in the mix, each claiming rights to use a person's identity in the context of trade.

Let's consider in more depth the example of Woods. Woods's vast portfolio of claimed marks in his name and likeness is not held by Woods personally but instead by a separate corporation, ETW.³⁰ The company claims to also hold Woods's right of publicity.³¹ Woods appears to actively control this company, but this need not be the case. Let's suppose that ETW is fully independent of Woods — perhaps after a lucrative sale by Woods or potentially even as a result of a transfer through bankruptcy or a divorce settlement. This would make Woods what I call the *identity-holder*, the underlying natural person upon whom the right of publicity and some trademarks are based. In this scenario, ETW is the *publicity-holder* of Woods's right of publicity (rooted in his identity), rather than Woods himself. ETW is also the *markholder* of service and trademarks that use Woods's name and likeness, even though those marks are composed of aspects of Woods's identity. Trademark rights originating with Wood's identity are capable of further division; for example, one entity might control the marks in the context of services for golf course design, another for endorsements, another for soft drinks, another for golf clubs, and so on. To the extent that the right of publicity is also transferable, it too is capable of such subdivision. And different licensing deals can be layered on top of this already complex landscape.

This tangled mess of rights all rooted in an identity-holder, who may be separated from their publicity and trademark rights, can create an *identity thicket*. Such a thicket of overlapping property rights over the same person's identity creates difficult questions for business transactions and development and poses a significant threat to a person's control over their own identity and future opportunities (both personal and professional). And this thicket appears to be growing ever more dense.

The increasing discord between right of publicity and trademark claimants and among identity-holders, publicity-holders, and mark-

²⁹ See Rothman, *supra* note 2, at 208–41; see also ROTHMAN, *supra* note 4, at 115–37.

³⁰ *ETW*, 332 F.2d at 918. The ownership of the IP rights arising out of Woods's identity is somewhat more complicated than even this because he has a number of other corporations involved in his brand and IP. Tiger Woods Enterprises S.A., based in Switzerland, holds at least some additional marks, encompassing both foreign registrations and U.S. ones based on underlying Swiss registrations. See, e.g., TIGER WOODS, Registration No. 5,521,859. There are also a host of other companies in which Woods and his identity are involved, including TGR Design, TGR Live, and The TGR Foundation. See *Biography*, TIGER WOODS, <https://tigerwoods.com/biography> [<https://perma.cc/VYF7-GS37>].

³¹ *ETW*, 332 F.2d at 918.

holders is a result of a variety of factors, including the exponential rise in right of publicity claims, combined with an expansion in the right's scope since the 1980s (including the possibility of its transferability and descendibility) and an ever-increasing awareness of the availability of such claims.³² Trademark law has also greatly expanded since the early twentieth century, adding liability on the basis of dilution without regard to confusion, and allowing liability for confusion as to sponsorship and affiliation (rather than solely on the basis of source confusion), a highly relevant expansion when it comes to protecting rights rooted in a person's identity.³³ The value and importance of rights over one's identity have grown with the rise of social media influencers and the ability to harness even an ordinary person's identity to market to their circle of online friends.³⁴ There is also an increasing awareness that individuals can register their own names and images as marks for their personal services, including endorsement services.³⁵

Conflicts between trademark and right of publicity laws are also a result of the fact that many (and until recently most) asset transfer agreements involving businesses named after their founders did not explicitly consider the right of publicity or name and likeness rights separately from broader intellectual property, goodwill, and intangible assets. Many such agreements were drafted before the right of publicity was

³² See ROTHMAN, *supra* note 4, at 67–96, 115 (documenting the right's expansion to include persona-based and postmortem claims, as well as its problematic shift to being considered transferable); Post & Rothman, *supra* note 4, at 90 n.6 (noting the dramatic rise in right of publicity cases, observing that a rough estimate based solely on published decisions indicates that there were fewer than twenty published right of publicity decisions during the 1970s and about fifty in the 1980s, but well over 100 published decisions in the 2010s).

³³ See, e.g., Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730 (codified as amended in scattered sections of 15 U.S.C.); Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (1996) (codified as amended at 15 U.S.C. §§ 1125, 1127); Trademark Law Revision Act of 1988, Pub. L. No. 100-667, § 132, 102 Stat. 3935, 3946 (codified as amended at 15 U.S.C. § 1125(a)); Act of Oct. 9, 1962, Pub. L. No. 87-772, 76 Stat. 769 (codified as amended in scattered sections of 15 U.S.C.); *Control Components, Inc. v. Valtek, Inc.*, 609 F.2d 763, 770 (5th Cir. 1980); see also Jennifer E. Rothman, *Valuing the Freedom of Speech and the Freedom to Compete in Defenses to Trademark and Related Claims in the United States*, in *THE CAMBRIDGE HANDBOOK OF INTERNATIONAL AND COMPARATIVE TRADEMARK LAW* 539, 540 (Irene Calboli & Jane C. Ginsburg eds., 2020) (describing these and other expansions in trademark law's scope).

³⁴ See *Fraley v. Facebook, Inc.*, 830 F. Supp. 2d 785, 799–800, 809 (N.D. Cal. 2011); McGeveran, *supra* note 16, at 333–35, 344–47; see also Susie Khamis, Lawrence Ang & Raymond Welling, *Self-Branding, "Micro-Celebrity" and the Rise of Social Media Influencers*, 8 *CELEBRITY STUD.* 191, 196–97 (2017) (discussing ease with which social media fosters development of "ordinary people," *id.* at 197, into "micro-celebrities" and incentivizes self-branding, *id.* at 196); cf. SARAH BANET-WEISER, *AUTHENTIC™* 70–89 (2012) (observing and critiquing trend of self-branding).

³⁵ McGeveran, *supra* note 16, at 333–35, 344–47; see also sources cited *infra* notes 236–39 and accompanying text.

thought to be capable of transfer or of surviving death.³⁶ Even today, when drafting such agreements it is not clear what rights are capable of transfer, nor what rights flow from transfers of marks comprised in part of a person's identity or from a transfer of the publicity rights of another person.

The Second Circuit in *JA Apparel Corp. v. Abboud*³⁷ is one of the only appellate courts to squarely face a conflict between trademark and publicity rights asserted by opposing parties, all rooted in the same identity-holder. The lawsuit arose when well-known fashion designer Joseph Abboud (the identity-holder) announced plans to launch a new fashion line, JAZ, after having sold his eponymous fashion company to the plaintiff JA Apparel (the markholder) for \$65.5 million.³⁸ The sale agreement transferred the right to use Abboud's registered mark JOSEPH ABBOD, as well as other marks, including variations on his name, such as "Joe," "designed by Joseph Abboud," and "by Joseph Abboud."³⁹ While the parties agreed that JA Apparel owned the relevant marks, they disputed who was the publicity-holder of the rights rooted in Abboud's identity.⁴⁰ JA Apparel sued Abboud for using his name, likeness, and identity to promote and advertise his new venture, asserting claims for trademark infringement, dilution, and unfair competition.⁴¹ Although JA Apparel did not assert an explicit right of publicity claim against Abboud, it contended that Abboud's right of publicity had transferred to it as part of the sale agreement.⁴² Abboud asserted a right of publicity counterclaim against JA Apparel for the company's use of his identity in marketing its fashion line, denying the transfer of his right of publicity.⁴³ Abboud also asserted Lanham Act claims of his own, including claims of false endorsement and false advertising, which his attorneys concluded he could assert even if JA

³⁶ Notably, only about half of states today explicitly recognize a postmortem right of publicity and no states clearly recognized such a right prior to the 1980s. See ROTHMAN, *supra* note 4, at 81–86, 97–98. The transferability of the right of publicity even today is unclear and is something I have challenged particularly for the living on both doctrinal and normative grounds. See *id.* at 115–37; Rothman, *supra* note 2, *passim*.

³⁷ 568 F.3d 390 (2d Cir. 2009).

³⁸ *Id.* at 393–94.

³⁹ *Id.* at 393 (quoting the parties' sale agreement).

⁴⁰ *Id.* at 394.

⁴¹ *Id.*; see Complaint ¶¶ 62–94, *JA Apparel Corp. v. Abboud*, 591 F. Supp. 2d 306 (S.D.N.Y. 2008) (No. 07 Civ. 7787).

⁴² See, e.g., Plaintiff and Counterclaim-Defendants' Post-trial Proposed Findings of Fact and Conclusions of Law ¶ II.114, *JA Apparel*, 591 F. Supp. 2d 306 (No. 07 Civ. 7787) (alleging that Abboud had no "right of publicity separate and apart from the rights that he transferred to JA Apparel in the Purchase and Sale Agreement," and also suggesting that at the very least he had consented to all uses of his identity by JA Apparel going forward).

⁴³ See *JA Apparel*, 591 F. Supp. 2d at 394–95; *JA Apparel Corp. v. Abboud*, 682 F. Supp. 2d 294, 319–20 (S.D.N.Y. 2010); Answer and Counterclaims of Defendants and Counterclaim Plaintiffs, *JA Apparel*, 591 F. Supp. 2d 306 (No. 07 Civ. 7787).

Apparel held the rights to the marks comprised of his name and other indicia of his identity.⁴⁴

The Second Circuit and the district court on remand resolved the case before them, but on grounds that left most of the really thorny questions unanswered. The appellate court held that the contract at issue was ambiguous as to whether the right of publicity was transferred to JA Apparel,⁴⁵ and the court on remand concluded that it did not transfer.⁴⁶ Both courts avoided determining whether a transfer of Abboud's right of publicity could have taken place, and if it did what it would have meant for Abboud's ability to work and even to appear in public. Both courts also avoided addressing the question of whether Abboud could still bring false endorsement and false advertising claims after having transferred marks rooted in his identity, and whether his publicity rights limited JA Apparel's ability to exploit the marks and business it purchased. The district court simply (and somewhat unconvincingly) decided that when JA Apparel referred to Abboud and to Joe and Joseph, no one would think it was pointing to Abboud, the person.⁴⁷ The district court gave a little more guidance on the question of whether Abboud — in the absence of a transfer of his publicity rights — could continue to use his name in the fashion industry in light of his transferred marks, concluding that so long as he did not use aspects of his identity as a mark itself he had some (albeit limited) latitude to continue to use his own name in a competing fashion line.⁴⁸

The continued lack of guidance on these questions has unsurprisingly led to a number of conflicting recent decisions filled with contradictory and incoherent analyses. Two recent lawsuits arising out of the very same sales contract are illustrative of this chaos. The Traeger family sold their self-named company, known for its groundbreaking wood-pellet grills, to Traeger Pellet Grills (TPG). Some of the Traegers later started working for a competitor, Dansons, and appeared in advertisements for its competing grills.⁴⁹ In response, TPG filed two lawsuits, one against Dansons and another against individual members of the Traeger family.⁵⁰ TPG filed suit in Florida — against the members of the family individually — and in Arizona — against Dansons. Both lawsuits asserted claims for trademark infringement and dilution, and notably also for violations of the Traegers' rights of publicity that TPG

⁴⁴ *JA Apparel*, 568 F.3d at 394–95.

⁴⁵ *Id.* at 399.

⁴⁶ *JA Apparel*, 682 F. Supp. 2d at 322.

⁴⁷ *Id.* at 319–20.

⁴⁸ *Id.* at 315–18, 322.

⁴⁹ *Traeger Pellet Grills, LLC v. Dansons US, LLC*, 421 F. Supp. 3d 876, 881 (D. Ariz. 2019).

⁵⁰ *Id.*; *Traeger Pellet Grills LLC v. Traeger*, No. 19-cv-1714, 2019 WL 4305502, at *1 (M.D. Fla. Sept. 11, 2019).

claimed it owned. A district court in Florida held that the Traegers' rights of publicity were not unambiguously transferred to TPG, and therefore TPG could not limit the Traegers' ability to use their own names, likenesses, and identities in conjunction with a different grill company regardless of the transfers of their business and its marks to TPG.⁵¹ A district court in Arizona decided the exact opposite — concluding that the sales contract transferred both their rights of publicity and trademark rights connected to their identities. Accordingly, it held that the defendant company Dansons was liable for its and the Traegers' violation of the Traegers' *own* rights of publicity by participating in the new venture and promoting it (as well as a host of Lanham Act violations).⁵²

Lawsuits like those involving the Traeger family and Abboud increasingly raise questions about what sellers (and other identity-holders) who have transferred their marks can do thereafter, and if the right of publicity can transfer as part of these deals. One recent, chilling example involves a young fashion designer who joined a bridal wear company.⁵³ Her employment contract included a provision transferring to the company exclusive rights to any registered trademarks arising out of her name in perpetuity.⁵⁴ After her separation from the company, she was sued by the company for various social media posts that referred to a new venture of her own.⁵⁵ A federal court sided with the company and enjoined her from using her name in trade, posting videos of herself sketching dresses, and requiring her to turn over social media accounts to her former employer even though the accounts had handles composed of her name and that followers associated with her.⁵⁶

It is not only sellers and identity-holders who are left at sea, but also buyers of eponymous businesses and marks, who are uncertain of how

⁵¹ See *Traeger Pellet Grills*, 2019 WL 4305502, at *6–7.

⁵² *Traeger Pellet Grills*, 421 F. Supp. 3d at 888–90. Both cases settled while appeals were pending.

⁵³ *JLM Couture, Inc. v. Gutman*, No. 20-CV-10575, 2021 WL 827749 (S.D.N.Y. Mar. 4, 2021), *aff'd in part, vacated in part*, No. 21-870, 2022 WL 211017 (2d Cir. Jan. 25, 2022).

⁵⁴ *Id.* at *2–3.

⁵⁵ *Id.* at *6; Complaint and Demand for Jury Trial at 15–18, *JLM Couture*, 2021 WL 827749 (No. 20-CV-10575).

⁵⁶ *JLM Couture*, 2021 WL 827749, at *23–24; see *JLM Couture, Inc. v. Gutman*, No. 20-CV-10575, 2021 WL 4084573, at *8–9 (S.D.N.Y. Sept. 8, 2021). Both decisions were appealed, and as this Article was going to print, the Second Circuit issued an opinion in the first of these appeals. The other is still pending as of the time of publication. See Notice of Appeal, *JLM Couture, Inc. v. Gutman*, No. 21-2535 (2d Cir. Oct. 8, 2021). In its January 25, 2022 opinion, a divided panel affirmed the district court's preliminary injunction in part and remanded the case for reconsideration of whether the injunction ordering the defendant Gutman to turn over social media accounts was adequately supported. See *JLM Couture*, 2022 WL 211017, at *1. Notably, Judge Newman dissented from the part of the decision that affirmed the broad scope of the preliminary injunction limiting Gutman's ability to use her own name. See *id.* at *12 (Newman, J., concurring in part and dissenting in part).

they can use a person's identity if they do not also hold the person's right of publicity. This issue arose, though was not resolved, in the *JA Apparel* litigation.⁵⁷ This lack of guidance explains the recent litigation brought by the Hubert Hansen Intellectual Property Trust against The Coca-Cola Company, which initially resulted in a massive \$10 million judgment in favor of the plaintiff, the alleged publicity-holder, against the markholder.⁵⁸ This verdict was recently vacated and a new trial has been ordered,⁵⁹ but the crucial legal questions remain unanswered. The case was first brought to my attention when I was sought out (and then hired) as an expert for the defense. The views expressed in this Article, however, are my own and produced without any compensation or consultation with counsel.

The lawsuit was brought by relatives of Hubert Hansen, a deceased juice-maker who started selling juice in 1935 and died in 1951.⁶⁰ Some of Hansen's relatives formed the Trust, which claims to hold Hansen's postmortem right of publicity. What began as Hansen's company, including importantly its IP, is today largely held by Coca-Cola.⁶¹ The trial court concluded that this IP does *not* include Hansen's right of publicity in part because at the time of Hansen's death such a right did not survive death (and accordingly could not have been part of the company's intangible assets).⁶²

⁵⁷ The fashion industry is one of the most common locations for these disputes. In addition to *JA Apparel* and *JLM Couture, Inc. v. Gutman*, No. 20-CV-10575, 2021 WL 827749, the bridal dress designer case, see, for example, *Paul Frank Industries, Inc. v. Sunich*, 502 F. Supp. 2d 1094 (C.D. Cal. 2007). See also Stanton "Larry" Stein & Jonathan E. Stern, *The Name of the Brand: Emerging Issues in the Application of Trademark Law to Personal Names*, INTELL. PROP. & TECH. L.J., May 2008, at 17 (highlighting a series of fashion cases involving designers' separation from eponymous companies followed by lawsuits arising out of the designers' efforts to continue to work using their own names and identities in the fashion business); *Thinking About Naming Your Brand After Yourself? Think Again*, THE FASHION LAW (Feb. 24, 2021), <https://www.thefashionlaw.com/want-to-name-your-brand-after-yourself-think-again> [<https://perma.cc/MH6F-C8UW>] [hereinafter *Thinking About Naming Your Brand*] (describing numerous examples of problems created when designers separate from their eponymous businesses).

⁵⁸ Judgment, *Hubert Hansen Intell. Prop. Tr. v. Coca-Cola Co.*, No. 37-2016-00021046-CU-MC-CTL (Cal. Super. Ct. Feb. 19, 2020), 2020 WL 10964913.

⁵⁹ *Hansen v. Coca-Cola Co.*, No. D077588, 2021 WL 2461175, at *25 (Cal. Ct. App. June 17, 2021).

⁶⁰ *Id.* at *1.

⁶¹ *Id.* This is a somewhat simplified version of the ownership of rights but it captures the essence of the dispute. Monster Beverage Company also owns some of the relevant IP and is a named defendant in the case. *Id.*

⁶² See *Hansen*, 2021 WL 2461175, at *5, *11-13; *Hubert Hansen Intell. Prop. Tr. v. Coca-Cola Co.*, No. 37-2016-00021046-CU-MC-CTL, 2019 WL 8064040, at *14 (Cal. Super. Ct. Feb. 15, 2019). California first recognized a postmortem right of publicity in 1984. See CAL. CIV. CODE § 3344.1 (West 2021) (originally enacted as CAL. CIV. CODE § 990 (1984)); ROTHMAN, *supra* note 4, at 81-86 (describing the emergence of postmortem rights of publicity in the aftermath of Elvis's death in 1977).

Even if we suppose, as the trial court did, that Hansen's right of publicity survived his death and was not transferred to Coca-Cola (nor held by the prior corporate entities that succeeded to the Hansen companies' IP rights, nor waived through longtime use and consent), it is unclear what follows from this split of rights related to Hansen's identity. (Neither the trial court nor the appellate court evaluated this issue.⁶³) The Trust contended that Coca-Cola's uses of Hansen's name on the HANSEN'S soda and juice products, and of his name, photograph, and the story of the founding of the company on products, in advertising, and on the product website violated Hansen's postmortem right of publicity.⁶⁴ The Trust also objected to an expansion product line for lemonade named HUBERT'S.⁶⁵ If looking at trademark law alone, the defendants had the right to use these marks, related IP (including copyrighted works), and facts on their products. Yet the right of publicity (asserted from beyond the grave) potentially clawed back rights that were thought to have transferred (unencumbered) years earlier through both voluntary sales and bankruptcy proceedings.

This scenario also raises the issue of what the publicity-holder of Hansen's identity (the Trust) could do to commercially exercise its rights to Hansen's identity without running afoul of Coca-Cola's other IP rights, particularly its trademark rights. Could Coca-Cola stop members of the Trust, for example, from starting their own juice or soda business using Hansen's identity?

The cases described here are the tip of the coming iceberg.⁶⁶ Trademark law expressly gives markholders the right to use their marks in

⁶³ See generally *Hansen*, 2021 WL 2461175; *Hubert Hansen Intell. Prop. Tr.*, 2019 WL 8064040; Judgment, *supra* note 58.

⁶⁴ Complaint for Damages and Injunctive Relief ¶¶ 27–31, *Hubert Hansen Intell. Prop. Tr.*, 2019 WL 8064040 (No. 37-2016-00021046-CU-MC-CTL), 2016 WL 11664978.

⁶⁵ *Hansen*, 2021 WL 2461175, at *4; Complaint for Damages and Injunctive Relief, *supra* note 64, ¶¶ 23–24.

⁶⁶ See, e.g., *Phyllis Schlafly Revocable Tr. v. Cori*, 512 F. Supp. 3d 916, 921–23 (E.D. Mo. 2021) (involving dispute among Phyllis Schlafly's children and others over who owns rights to her personal marks and right of publicity after her death); *RSR Art, LLC v. Bob Ross, Inc.*, 380 F. Supp. 3d 510, 511–14 (E.D. Va. 2019) (involving dispute over who held the IP rights of deceased paint-by-numbers art teacher Bob Ross between an entity formed by some of his surviving family members and the entity that he formed before his death to hold his IP rights); *Coscarelli v. ESquared Hosp. LLC*, 364 F. Supp. 3d 207, 212–14 (S.D.N.Y. 2019) (involving dispute between a chef and the entity to which she licensed rights to use her identity and the personal mark BY CHLOE for a chain of vegan restaurants after she parted ways with the defendant); Defendant Counterclaim-Plaintiff Hayley Paige Gutman's Answer ¶¶ 180–96, *JLM Couture, Inc. v. Gutman*, 2021 WL 827749 (S.D.N.Y. Mar. 4, 2021) (No. 20-CV-10575) (bringing counterclaims by identity-holder for violation of her right of publicity, false endorsement, and false advertising against the plaintiff, which held marks using her name); Complaint for Declaratory Judgment ¶¶ 37–45, *Shaya Rest. v. Shaya*, No. 17-cv-10935 (E.D. La. Oct. 20, 2017) (seeking declaration that identity-holder, chef Alon Shaya, would infringe the trademark in SHAYA for restaurant services by starting his own restaurant and that the plaintiff restaurant had not violated any trademark rights of his by using a mark that originated with his name); Answer to Complaint for Declaratory Judgment ¶¶ 84–150, *Shaya*, No.

commerce, yet the governing Lanham Act appears to extend false endorsement and false advertising claims to identity-holders without regard to these rights over related marks, and state right of publicity laws also prohibit unauthorized uses of a person's identity.

The most straightforward way of thinking through how to tease apart this thicket of rights is to begin with the objectives of trademark and unfair competition laws, especially when they protect aspects of a person's identity. Because the most commonly asserted of these laws are federal, as codified in the Lanham Act, preemption analysis routinely employed in other areas of IP law could direct the resolution of these conflicts.⁶⁷ Under such an approach, the Lanham Act should preempt right of publicity claims that "stand[] as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress."⁶⁸ In Part V, I will consider such a preemption approach in more depth, but as a starting point to make the determination of "whether a state law conflicts with Congress'[s] purposes and objectives," the first step is to identify "the federal interest[s]" at stake.⁶⁹ Looking to the federal regime for guidance also furthers the goal of providing greater predictability and uniformity, something sorely lacking given the wide variations in state right of publicity laws.⁷⁰

Even short of adopting preemption as the framework to resolve these conflicts, trademark law, when properly understood to incorporate personality-based interests as well as market-based ones, provides a robust

17-cv-10935 (E.D. La. Dec. 20, 2017) (bringing counterclaims of identity-holder chef for, inter alia, trademark infringement, false advertising, false endorsement, dilution, and publicity and privacy violations against owners of his namesake restaurant that fired him and continued to operate using his name for the restaurant); Wendell Brock, *The Chef Who Lost His Name*, THE BITTER SOUTHERNER, <https://bittersoutherner.com/the-cook-who-lost-his-name-alon-shaya-new-orleans> [<https://perma.cc/A3SY-TVUC>] (describing the litigation between Shaya and the owners of the restaurant named for him and where he used to work); cf. *Cousteau Soc'y, Inc. v. Cousteau*, 498 F. Supp. 3d 287, 298–99 (D. Conn. 2020) (involving lawsuit brought by entity holding famous ocean explorer's IP rights, including trademarks consisting of his name and likeness, and his publicity rights against "an estranged granddaughter," *id.* at 198, who shares his last name and made a documentary in which his name and likeness are used both within the film and to promote it).

⁶⁷ See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 152–68 (1989) (applying conflict preemption to preempt state law that interfered with federal patent law); *Jackson v. Roberts (In re Jackson)*, 972 F.3d 25, 33–42 (2d Cir. 2020) (applying *Bonito Boats* analysis and obstacle preemption to hold that copyright law preempted a right of publicity claim); *Int'l Franchise Ass'n v. City of Seattle*, 803 F.3d 389, 409–11 (9th Cir. 2015) (applying conflict preemption analysis in context of Lanham Act); see also Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 236–38 (2002) (suggesting the use of conflict preemption analysis when evaluating conflicts between the right of publicity and copyright law given the opacity and confusion surrounding the explicit preemption provision contained within the Copyright Act).

⁶⁸ *Cap. Cities Cable, Inc. v. Crisp*, 467 U.S. 691, 699 (1984) (quoting *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941)).

⁶⁹ *Hillman v. Maretta*, 569 U.S. 483, 491 (2013).

⁷⁰ See *infra* notes 328–31 and accompanying text.

and normatively appealing approach to mediating these conflicts — one that protects both markholders *and* identity-holders. As both a doctrinal and a normative matter, trademark law’s objectives are central to finding our way through the identity thicket. Accordingly, I will next turn to considering the objectives of trademark law. I will then return in Part V to revisit some of the conflicts raised in this Part with these new insights in hand.

II. TRADEMARK’S CONVENTIONAL OBJECTIVES

Today’s dominant account of trademark law is market based and focuses on the interests of both markholders and consumers.⁷¹ By protecting producers from confusingly similar uses of marks and uses that dilute the value of marks, trademark and unfair competition laws seek to incentivize the production of high-quality and consistent goods and services for the public’s benefit.⁷² “Trade-marks encourage the maintenance of quality by securing to the producer the benefit of the good reputation which excellence creates.”⁷³

The protection of markholders is also supported by a labor-reward justification. Businesses (and the people behind those businesses) have worked hard to build value in their marks, brand, and company, and should earn the fruits of their labor rather than “pirates and cheats” who use deception to divert sales away from the rightful markholders.⁷⁴ Even this producer-centric vision of the Lanham Act encompasses concern for the public, but as a second-order benefit.⁷⁵

Trademark law also independently protects consumers. The Lanham Act itself expressly highlights this as an independent objective,⁷⁶ and the underlying reports and history of trademark and unfair competition law support a central place for consumers in this body of

⁷¹ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 1 cmt. e, 9 cmt. c (AM. L. INST. 1995); WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 168 (2003); Landes & Posner, *supra* note 11, at 270; Lemley, *supra* note 11, at 1688.

⁷² Some contend the trademark system causes overinvestment in strong marks and advertising rather than in high-quality products. See Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 *YALE L.J.* 1717, 1724–31 (1999); Jeremy N. Sheff, *Veblen Brands*, 96 *MINN. L. REV.* 769, 803 (2012).

⁷³ S. REP. NO. 79-1333, at 4 (1946); see also Landes & Posner, *supra* note 11, at 270 (arguing that trademarks “are valuable because they denote consistent quality, and a firm has an incentive to develop a trademark only if it is able to maintain consistent quality”).

⁷⁴ S. REP. NO. 79-1333, at 3; see also *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–64 (1995) (applying this rationale to include color within the scope of trademark protection).

⁷⁵ See Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 *NOTRE DAME L. REV.* 1839, 1840–41 (2007) (contending that trademark law was never directed at consumer interests).

⁷⁶ See 15 U.S.C. § 1127.

law.⁷⁷ The Senate Report accompanying the Lanham Act highlights the goal of “protect[ing] the public from deceit” and deception in the marketplace.⁷⁸ Subsequent amendments to the Lanham Act have continued to recognize this objective.⁷⁹

The consumer focus of trademark law is also evident from its partial origins in the torts of deceit and fraud.⁸⁰ These claims were distinct from those that competitors could bring, and could be brought by consumers directly when they were deceived by a defendant’s efforts to pass off its goods as those of another. Although most courts have concluded that consumers cannot bring claims under the Lanham Act, their interests remain central.⁸¹ Even in the absence of consumer suits, the Lanham Act protects people from being duped in the marketplace by prohibiting trademark infringement, false and misleading advertising, false designations of origin, and false endorsements.⁸² And consumer perceptions are fundamental to claims under the Lanham Act. Liability turns primarily on likely consumer confusion, and even dilution determinations turn on what consumers are likely to think.⁸³

The search-cost model for trademark law also puts consumers at its center. Under this theory, trademarks provide communicative messages to consumers that help them more easily and more quickly locate the

⁷⁷ See S. REP. NO. 79-1333, at 3-4; *POM Wonderful LLC v. Coca-Cola Co.*, 573 U.S. 102, 107 (2014); RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 2 cmt. a, 9 cmt. c (AM. L. INST. 1995); MCCARTHY, *supra* note 7, § 5:2 (“In the author’s opinion, to select as paramount either protection of the trademark property or protection of consumers would be to oversimplify the dual goals of trademark law . . .”); Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 555-56, 560-61, 593, 620-21 (2006) (highlighting the longstanding role of consumer protection in trademark and unfair competition laws); Lemley, *supra* note 11, at 1688; see also LANDES & POSNER, *supra* note 71, at 167 (discussing benefits for consumers of trademark law, including higher-quality products and reduced search costs); Landes & Posner, *supra* note 11, at 269 (same).

⁷⁸ S. REP. NO. 79-1333, at 4; cf. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989) (noting this history of unfair competition law and the focus on “protecting consumers”).

⁷⁹ See, e.g., 152 CONG. REC. 19,238 (2006) (statement of Rep. Lamar Smith).

⁸⁰ See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 778 n.5 (1992) (Stevens, J., concurring in the judgment); RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 2 cmt. a, 9 cmt. d; FRANK I. SCHECHTER, *THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADE-MARKS* 4-18, 143 (1925).

⁸¹ The plain language of the statute suggests that consumers can bring such claims and at least some legislative history suggests this as well. See 15 U.S.C. § 1125; H.R. REP. NO. 100-1028, at 13-15 (1988) (noting with regard to adding explicit authorization for consumer suits that this right already exists but that because of mistaken judicial decisions it should be clarified); 134 CONG. REC. 31,850 (1988) (statement of Rep. Robert Kastenmeier on Trademark Law Revision Act of 1988) (contending that consumers have standing to sue under the Trademark Act of 1946). Recent decisions on standing under the Lanham Act, however, indicate that such claims are not possible. See, e.g., *POM Wonderful*, 573 U.S. at 107 (noting in dicta that “[t]hrough in the end consumers also benefit from the Act’s proper enforcement, the cause of action is for competitors, not consumers”).

⁸² 15 U.S.C. §§ 1114, 1125.

⁸³ *Id.* §§ 1114(1), 1125(a), (c).

products and services that they wish to purchase.⁸⁴ The consumer-focused search-cost model fits well in the context of a law that penalizes deceptive uses, but is less convincing when asserted to justify dilution law, which does not require any demonstration of likely consumer confusion.⁸⁵

These two primary objectives of the Lanham Act — protecting businesses from unfair competition and protecting consumers from being deceived — usually work in harmony. Sometimes, however, they come into conflict. Such conflicts can arise when consumer confusion occurs after a markholder has lost rights to its mark (through, for example, abandonment, bankruptcy, or seizure of goods by an insurer or creditor).⁸⁶ In such instances, consumers may be deceived as to who is behind the products and services even if the seller can claim the right to employ the relevant marks. Conflicts between producers' interests and those of consumers also arise when consumers are not likely to be confused at all, and the sole basis of the markholder's claim is an assertion that it should reap all potential value stemming from its marks. Such a conflict arises, for example, in the context of unofficial merchandise in which sports teams and celebrities claim that they alone should have the rights to sell merchandise using their marks even though consumers are never (or rarely) confused about source or sponsorship.⁸⁷ Mediating such conflicts remains a challenge even beyond the personal mark cases that I focus on here.

Although often not demarcated expressly as a third objective of trademark law, it is recognized that trademark and unfair competition laws also have as a goal the broader objective “to foster fair competition.”⁸⁸ The Senate Report that accompanied the passage of the

⁸⁴ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995)); see Landes & Posner, *supra* note 11, at 269–70; Lemley, *supra* note 11, at 1690, 1695.

⁸⁵ Many scholars have criticized this rationale for dilution law. See, e.g., Barton Beebe, Roy Germano, Christopher Jon Sprigman & Joel H. Steckel, *Testing for Trademark Dilution in Court and the Lab*, 86 U. CHI. L. REV. 611, 616–17 (2019); Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507 *passim* (2008).

⁸⁶ See, e.g., *Alfred Dunhill Ltd. v. Interstate Cigar Co.*, 499 F.2d 232, 234 (2d Cir. 1974); *Stahly, Inc. v. M.H. Jacobs Co.*, 183 F.2d 914, 915 (7th Cir. 1950).

⁸⁷ See Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 463–65, 471–78 (2005); Justin Hughes, *Cognitive and Aesthetic Functionality in Trademark Law*, 36 CARDOZO L. REV. 1227, 1256 (2015); Lemley, *supra* note 11, at 1708; Madhavi Sunder, *Intellectual Property in Experience*, 117 MICH. L. REV. 197, 207–22, 249 (2018). But see Irene Calboli, *The Case for a Limited Protection of Trademark Merchandising*, 2011 U. ILL. L. REV. 865, 870, 887–92, 900–05, 910–13 (observing the potential conflict, but advocating for extending merchandising rights to markholders and suggesting that this may ultimately benefit consumers).

⁸⁸ S. REP. NO. 79-1333, at 4 (1946); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 2 cmt. a, 9 cmt. d (AM. L. INST. 1995) (suggesting that there are three main goals

Lanham Act suggests that this objective is on equal footing with the other two goals of the Lanham Act.⁸⁹ Trademark law expressly denies exclusive ownership of terms and symbols unmoored from a particular business, and limits the ability to stake out ownership of particular product or service categories.⁹⁰ This third objective of trademark law preserves these *negative spaces* for the public benefit. Trademark and unfair competition laws do so by protecting the ability of competitors to sell similar products and services, to compare those products and services with those of others, and to accurately describe their own wares and offerings.⁹¹ These negative spaces facilitate the expressly articulated objective of fair competition and protect the freedom of speech.⁹²

This is where even the most capacious understanding of trademark's objectives typically ends. As I will demonstrate in the next Part, however, trademark and unfair competition laws also seek to protect the personality of individuals, often (but not always) the founders of businesses. This lost facet and objective of trademark and unfair competition law — far from being consigned to the dustbin of history — is still alive, and is particularly vital to illuminate (and shore up) as individuals increasingly seek trademark protection for their own names and likenesses in the context of their own personal services. This inquiry is also essential given the increasing clash between state right of publicity laws directed at protecting a person's identity and federal trademark law. Because this personality-furthering objective of trademark law has been almost entirely overlooked, I will next turn to identifying and developing its contours.

III. RECLAIMING TRADEMARK'S PERSONALITY

From trademark's primordial days, trademark and unfair competition laws have considered the personality of markholders and others who use their own identities in trade. Nevertheless, to the extent scholars have recognized a personality theory of trademarks, it has been primarily in the context of the public's interest in using and referring to marks as part of self-expression, rather than from the perspective of

of modern trademark law, one of which is "the right of other sellers to compete vigorously with the trademark owner in the marketplace," *id.* § 9 cmt. d); Rothman, *supra* note 33, *passim*.

⁸⁹ See S. REP. NO. 79-1333, at 4.

⁹⁰ See *id.* at 3 ("Trade-marks are not monopolistic grants like patents and copyrights." (citing *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924); *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97-98 (1918))).

⁹¹ See 15 U.S.C. § 1115(b)(4); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 118-20, 122 (2004); *Sazerac Brands, LLC v. Peristyle, LLC*, 892 F.3d 853, 857-60 (6th Cir. 2018); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308-09 (9th Cir. 1992).

⁹² See Rothman, *supra* note 33, *passim*.

markholders.⁹³ A few scholars, notably Professor Laura Heymann and Professor William McGeeveran, have observed in passing that personality interests of identity-holders play a role in people's choices of names and the use of selfmarks.⁹⁴ But even they are skeptical that trademark law is a vehicle to protect these interests.⁹⁵ Of the contemporary legal scholars and commentators who have acknowledged the line of trademark cases stemming from the "sacred," "absolute," or "natural right" to one's own name and personality,⁹⁶ most have dismissed its import, concluding that it is obsolete, "archaic," "antiquated," "abandoned," "uniformly rejected," or "repudiated," and that trademark interests by definition are not personal in nature, and instead are driven solely by market-based concerns.⁹⁷ In this Part, I demonstrate the abundant evidence that personality-based interests have long been part of trademark

⁹³ See, e.g., Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 405–07 (1990); Katyal, *supra* note 10, *passim*.

⁹⁴ See, e.g., Laura A. Heymann, *A Name I Call Myself*, 2 U.C. IRVINE L. REV. 585, 623 (2012) [hereinafter Heymann, *A Name I Call Myself*] (noting that people choose their children's names, change their own names, and select their online usernames motivated by "identity, reputation, and personality"); McGeeveran, *supra* note 16, at 360–61 (observing in the context of selfmarks that there is "a greater independent basis for protecting . . . humans who have feelings and personal interests," than there is for protecting "corporate-controlled brands," *id.* at 360); cf. Laura A. Heymann, *The Law of Reputation and the Interest of the Audience*, 52 B.C. L. REV. 1341, 1359–60, 1366–67, 1374, 1385–400 (2011) [hereinafter Heymann, *The Law of Reputation and the Interest of the Audience*] (considering overlap between reputational protection for people and businesses).

⁹⁵ See Heymann, *A Name I Call Myself*, *supra* note 94, at 591–92, 623 (suggesting that the identity-based concerns she highlights in the context of naming are largely absent in trademark law, and instead are more similar to moral rights sometimes recognized in copyright law); William McGeeveran, *Disclosure, Endorsement, and Identity in Social Marketing*, 2009 U. ILL. L. REV. 1105, 1144–46 (noting that trademark and unfair competition laws focus on economic rather than "personal" concerns, even when evaluating false endorsement claims).

⁹⁶ See, e.g., *Tomsky v. Clark*, 238 P. 950, 952 (Cal. Dist. Ct. App. 1925) ("The right to do business under one's own name is one of the sacred rights known to the law . . ."); GREELEY, *supra* note 12, § 138 ("The right of any one to place his own name on goods sold by him is recognized as a natural right and cannot be interfered with."); HARRY D. NIMS, *THE LAW OF UNFAIR COMPETITION AND TRADE-MARKS* § 67 (2d ed. 1917) (describing the "right" to one's own name as on even stronger footing than the right to one's own home); Francis W. Treadway, *Personal Trade-Names*, 6 YALE L.J. 141, 143 (1897) (citing *Chas. S. Higgins Co. v. Higgins Soap Co.*, 39 N.E. 490 (N.Y. 1895)); see also *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 187 (1896) (noting "the well settled doctrine" that "every one has the absolute right to use his own name honestly in his own business" (quoting *Russ. Cement Co. v. Le Page*, 17 N.E. 304, 305 (Mass. 1888))); *Meneely v. Meneely*, 62 N.Y. 427, 431 (1875).

⁹⁷ See, e.g., 2 MCCARTHY, *supra* note 7, §§ 13:7–13:8 (contending that the "'sacred right' rule" is "archaic," *id.* § 13:7, has been "abandon[ed]," and is now "uniformly rejected," *id.* § 13:8 (capitalization omitted)); Mark Bartholomew, *Trademark Morality*, 55 WM. & MARY L. REV. 85, 122–28, 155–57 (2013) (noting that the absolute-right doctrine is "antiquated," *id.* at 155, and "weakened" today, *id.* at 126, and contending that it should be further dismantled as it "is hard to square with the efficiency rationale for trademark protection typically voiced by modern judges," *id.* at 128); McGeeveran, *supra* note 95, at 1146 (concluding that "[m]odern trademark law largely repudiates the nineteenth century rule" allowing "second-comers . . . to use their own name in business"); see also Christopher P. Bussert, *Family Feud: The Tension Between Family Names and Trademarks*, 99 TRADEMARK REP. 1388, 1390–91 (2009) (suggesting that most "modern cases" do not follow "the

law, and that they remain relevant today (even if often unrecognized), particularly in the pockets of trademark and unfair competition laws that are most likely to intersect with the right of publicity. Recognizing this facet of trademark law is about more than its doctrinal staying power — it is about recognizing the deeply rooted respect given in trademark and unfair competition laws to protecting individual autonomy and dignity.

Dating back to antiquity, trademarks literally marked the artisans who made the wares being sold.⁹⁸ Some of the first recorded “trademark” disputes revolved around the passing off of goods as those made by a famous craftsman or artist when they were fakes. In ancient Roman times, terracotta lamps thought to have originated with the then-famous potter Lucius Aemilius Fortis (or his workshops) were notoriously pirated by other sellers who used the same FORTIS mark on their counterfeit goods.⁹⁹ Early justifications for extending exclusionary rights to trademarks and trade names focused on protecting a *person’s* good name and their reputation in a particular industry, rather than the reputation of a separate business entity. Marks protected a person’s livelihood in a particular business, as well as their professional reputation. During this pre-Industrial Revolution period the person and their business often merged. One’s trade and profession were so much a part of one’s identity that many surnames originated from a person’s

historical, more deferential standard in assessing the right to use one’s family name,” but instead “treat[] these cases as ordinary infringement actions,” *id.* at 1390); Charles E. Colman, *An Overview of Intellectual Property Issues Relevant to the Fashion Industry*, in NAVIGATING FASHION LAW 113, 165 (2012) (“[J]udges have strayed quite far from the once widely accepted principle that each person possessed a ‘natural right’ to use her given name”); Dogan & Lemley, *supra* note 5, at 1209 n.223 (acknowledging “some extra solicitude toward personal names,” but largely consigning this approach to “older decisions”); Greg Lastowka, *The Trademark Function of Authorship*, 85 B.U. L. REV. 1171, 1196 (2005) (noting that while “some breathing room” exists to use one’s own name in business, there is “no *absolute* right to use your personal name in relation with your business”); Stein & Stern, *supra* note 57, at 18 (suggesting that “there is no absolute right to use one’s own personal name” in today’s trademark law (quoting *Paul Frank Indus., Inc. v. Sunich*, 502 F. Supp. 2d 1094, 1095 (C.D. Cal. 2007))).

⁹⁸ JAMES LOVE HOPKINS, *THE LAW OF TRADEMARKS, TRADENAMES AND UNFAIR COMPETITION* § 1 (4th ed. 1924); Sidney A. Diamond, *The Historical Development of Trademarks*, 73 TRADEMARK REP. 222, 225–29 (1983); Edward S. Rogers, *Some Historical Matter Concerning Trade-Marks*, 62 TRADEMARK REP. 239, 240–41, 245 (1972). Early marks also sometimes indicated monarchs who ruled over various jurisdictions and authorized the production of particular goods. See SCHECHTER, *supra* note 80, at 57–59. Other marks indicated membership in an organization authorized to produce specific classes of goods, and sometimes ownership. See *id.* at 15–16, 19–27, 48–57, 94–96, 101–05, 108–09; Diamond, *supra*, at 225.

⁹⁹ SALVATORE DI PALMA, *THE HISTORY OF MARKS FROM ANTIQUITY TO THE MIDDLE AGES* 341 (David Westgate trans., 2015); cf. Eric C. De Sena & Paola Chini, *Oil Lamps*, in *THE COLLECTION OF ANTIQUITIES OF THE AMERICAN ACADEMY IN ROME* 319, 324 (Larissa Bonfante & Helen Nagy eds., 2015).

profession, such as Baker, Milner, Shepherd, Smith, and Potter.¹⁰⁰ Well into the nineteenth century and up until the rise of the mass production of fungible goods, many goods were marked, stamped, or accompanied by the names, initials, or unique symbols of the craftsmen who made the products.¹⁰¹

The rise in prominence of the corporate structure in the mid-to-late nineteenth century altered this dominant merging of a person and their business by disentangling the natural person from the business entity to which they might be associated.¹⁰² However, these changes did not alter the differential treatment of marks and claims rooted in a particular individual; instead, they altered only the frequency with which such personality-based concerns arose in the context of trademark and unfair competition cases.

In this Part, I trace this longstanding, though largely unacknowledged, aspect of trademark law and highlight the ways in which it remains today. Such an effort is essential because of the entrenched skepticism among many jurists and scholars that personality interests have any role to play in trademark law. I begin by considering the role of personality in Anglo-American trademark and unfair competition laws from the eighteenth century up until shortly after the passage of the Lanham Act, which is generally demarcated as the dividing line between historical and modern trademark law. Section B then considers the continued relevance of personality in today's trademark and unfair competition laws, and the surprising continuity between the early treatment of personal marks and that of today.

A. *Unfair Competition and Trademark's Early Theory of Personality*

In 1873, William Henry Browne in his influential *Treatise on the Law of Trade-Marks* described a trademark as “carr[ying] the idea of a

¹⁰⁰ See P.H. REANEY, A DICTIONARY OF ENGLISH SURNAMES, at xli, xliii, 24, 310, 359, 404–05, 415 (R.M. Wilson, ed., 3d ed. 1991); see also DEBBY APPLGATE, MADAM: THE BIOGRAPHY OF POLLY ADLER 31 (2021) (describing “Kravets,” originating with the Polish word for “tailor,” as being used as the last name of a family of tailors). For a broader discussion of naming practices, see Laura A. Heymann, *Naming, Identity, and Trademark Law*, 86 IND. L.J. 381, 389–91 (2011).

¹⁰¹ See, e.g., *Sykes v. Sykes* (1824) 107 Eng. Rep. 834, 834; 3 B. & C. 541, 541 (describing maker of “shot-belts” and “powder-flasks” with “great reputation” who marked his wares with the words “Sykes Patent” to indicate they were made by him).

¹⁰² Prior to this time, companies and their property were usually held only by individuals, rather than by a separate corporation. The ability to form a corporate structure as a separate fictional entity distinct from any natural person associated with the business became commonly available only in the late 1800s. See Margaret M. Blair, *Locking in Capital: What Corporate Law Achieved for Business Organizers in the Nineteenth Century*, 51 UCLA L. REV. 387, 423–25 (2003). Without that option, most businesses were run either as individual proprietorships or partnerships. *Id.* at 405, 409. Property of the business, including its intangible property, such as trademarks and goodwill, was therefore personally owned. *Id.* at 404. The law did not clearly establish partnerships as separate legal entities capable of holding property until the late 1900s. See *id.* at 410 n.71.

man's personality, like his ordinary autograph."¹⁰³ Browne therefore concluded that trademarks "preserve[] [their] essential characteristics wherever [they] may go," much like a person.¹⁰⁴ The personality-based understanding of trademark law extended beyond instances in which people used their own names or likenesses as marks. Infringement of a mark or trade name — even one that was not personal in the sense of being derived from a person's name or image — was understood as an intrusion on an individual's personality, as well as a threat to that person's commercial success.¹⁰⁵ The personality-based aspects of trademark law predominated when marks and trade names were derived from a particular person's identity. It is in these contexts that the continuous thread of a personality-based understanding of trademark law remains present today.

Trademark and unfair competition laws were never solely about market-based interests. Unauthorized uses of another's name in trade were also understood as an affront to a person's autonomy interests, their dignity, and their natural right to the fruits of their own labor. Defendants who "dress[ed] [themselves] in another . . . man's name" were thought to "deprive that man of his own individuality, and thus despoil him of the gains to which by his industry and skill he is fairly entitled."¹⁰⁶ Trademarks were understood as a form of "celebrity" based

¹⁰³ BROWNE, *supra* note 12, § 90; *see also id.* § 130 ("A trade-mark is nothing more nor less than one's commercial signature to his goods . . .").

The definition of what constituted a trademark was far narrower in this era. So the name of a business was not technically a "trademark," but was still protected against unfair business practices epitomized by the passing off of one's goods as those of another's. The Supreme Court described the difference between a trademark and a trade name in 1926 as follows: A trademark was "applicable to the vendible commodity to which it is affixed," while a trade name attached to the "business and its good will." *Am. Steel Foundries v. Robertson*, 296 U.S. 372, 380 (1926). Though as the Court noted, even at that time, "the precise difference is not often material, since the law affords protection against its appropriation in either view upon the same fundamental principles." *Id.*; *see also* Milton Handler & Charles Pickett, *Trade-Marks and Trade Names — An Analysis and Synthesis: I*, 30 COLUM. L. REV. 168, 200 (1930) (noting that trademark and trade name cases were usually (and appropriately) analyzed in the same way).

¹⁰⁴ BROWNE, *supra* note 12, § 90.

¹⁰⁵ Some scholars and jurists have suggested that even business goodwill not intertwined with a particular person has elements of personality. *See, e.g.*, JOHN R. COMMONS, INDUSTRIAL GOODWILL 19–20 (1919) (referring to goodwill not as "science but personality" and as the "soul" of a corporation that "dies when dissected. . . [I]t is not even the personality of a single individual, it is that still more evasive personality to which the responsive French give the name, *l'esprit de corps*, the spirit of brotherhood, the solidarity of free personalities," *id.* at 20). Notably, Professor John Commons so concluded in part because of his understanding that the goodwill of a company was built by the contributions of individual laborers. *Id.* at 151 ("Goodwill is the soul; and goodwill is a multiple of all the different personalities that keep the business going.").

¹⁰⁶ BROWNE, *supra* note 12, § 95 (quoting *Howard v. Henriques*, 3 Sand. 725, 727 (N.Y. Super. Ct. 1851)).

on the person behind the goods, rather than solely as indicative of the goods themselves or some anonymous manufacturer or seller of them.¹⁰⁷

The personality-based aspects of trademark law derived in part from an understanding of self-ownership that flowered in the late nineteenth and early twentieth centuries.¹⁰⁸ The concept of having a property right in one's self led to a convergence during this time of unfair competition, trademark, and right of privacy/publicity laws that all protected the same interests. Personal name and image marks, trade names of eponymous businesses, and a person's portrait were protected against unauthorized uses under each of these theories on the basis that everyone has a property right in their own name and likeness. This concept famously led to the adoption of the right of privacy at the end of the nineteenth century (which developed into today's right of publicity),¹⁰⁹ but it also was a recognized part of trademark and unfair competition laws of this era and beyond.¹¹⁰

¹⁰⁷ See, e.g., *Perry v. Truefitt* (1842) 49 Eng. Rep. 749, 751; 6 Beav. 66, 70; see also LEWIS BOYD SEBASTIAN, *THE LAW OF TRADE MARKS* 2 (London, Stevens & Sons 1878).

This view contrasts with today's more anonymous vision of trademarks. See 15 U.S.C. § 1127 (defining "trademark" as "identify[ing] and distinguish[ing]" goods even if their "source is unknown"); see also *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 300 (3d Cir. 1986) (noting that the Trademark Clarification Act of 1984 codified this "long-recognized anonymous source rule").

¹⁰⁸ See, e.g., *Corliss v. E.W. Walker Co.*, 64 F. 280, 282 (C.C.D. Mass. 1894) (recognizing that every person has a property right in their portrait); *Pavesich v. New Eng. Life Ins. Co.*, 50 S.E. 68, 79 (Ga. 1905) ("The form and features of the plaintiff are his own."); *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442, 449–50 (N.Y. 1902) (Gray, J., dissenting) (suggesting that every person has a "property right" in their own "person" and image, *id.* at 450); *The Right to Privacy*, 6 GREEN BAG 498, 499 (1894) (suggesting that there is "a right of property in one's personal appearance").

¹⁰⁹ See ROTHMAN, *supra* note 4, at 11–44; see also Post & Rothman, *supra* note 4, at 93–95.

¹¹⁰ See, e.g., *Mackenzie v. Soden Mineral Springs Co.*, 27 Abb. N. Cas. 402, 410–11 (N.Y. Sup. Ct. 1891) (enjoining defendant from using the name and signature of well-known physician Sir Morell Mackenzie to sell its pastilles); *NIMS*, *supra* note 96, § 67 (comparing "trade rights in [a] family or personal name" to the unique status of one's home in property and privacy law, and noting that one's "name is dearer to him than his house"); see also *Edison v. Edison Polyform Mfg. Co.*, 67 A. 392, 394–95 (N.J. Ch. 1907) (citing both privacy-based cases and trademark and unfair competition ones to support a finding that the defendant could not use the famous inventor's name, signature, and image on its property because "a man's name" and "the peculiar cast of one's features" were both "property" with "pecuniary value" that "belong[ed] to its owner, rather than to the person seeking to make an unauthorized use of it" (citing, for example, *Brown Chem. Co. v. Meyer*, 139 U.S. 540 (1891); *Pavesich*, 50 S.E. 68)).

Although some courts limited unfair competition claims to instances in which a plaintiff was in direct competition with the defendant, others took a broader view, and as trademark and unfair competition laws expanded beyond direct competition and beyond source confusion so did the allowance of such claims within (rather than independently of) the unfair competition rubric. Compare *Mackenzie*, 27 Abb. N. Cas. at 403–04 (allowing claim by well-known doctor for quack medicine using his own identity), with *Dockrell v. Dougall* (1899) 80 LT 556 (AC) at 557 (denying relief under similar circumstances because the plaintiff could not claim a trademark in his name, was not a competitor, and had not proven a reputational injury from the use).

From the early days of Anglo-American trademark and unfair competition law, a number of unique rules for *personal marks* existed.¹¹¹ These rules were rooted in two distinct personality-based interests — the protection of a person’s autonomy and right to control uses of one’s own identity, and the protection of a person’s dignity, in particular one’s reputation in the community.¹¹² In the nineteenth century, the reputation of a person and their business were often merged.¹¹³ A person’s reputation as a craftsman or in their trade undoubtedly had market-based implications, and using another’s identity in trade encompassed the same market-based harms of uses of anyone’s mark (no matter the kind) to pass off one’s goods as those of another. But in the context of personal marks, these additional personality-based justifications for trademark law played a more robust role.

Because of the importance of a person’s name and likeness to both their business prospects and their individual identity and reputation, personal marks have long been treated differently from other marks. Marks rooted in something distinct from oneself are quite different from those in which the signifying mark and the signified object merge, as is the case when what is signified is a particular person, rather than some external and distinct object or company. In such instances of merger, the property right at issue in trademark and unfair competition cases is (and was recognized as) often rooted at least in part in the concept of *self-ownership*, rather than ownership of an external business or associated symbol of that business. When a company, product name, or design mark consists of the name, likeness, or autograph of a particular person, it can signal the underlying individual rather than (or in addition to) a separate and distinct corporate entity.

I illuminate trademark’s theory of personality through its expression in four longstanding doctrinal principles that are uniquely expressed in the context of marks and trade names that encompass an underlying individual’s identity: (1) the “natural right” to use one’s own name in trade;¹¹⁴ (2) the prohibition on using another’s identity as a mark or to suggest endorsement of products or services without their permission; (3) limits on the transferability of one’s own name or other self-identifying marks; and (4) the inability to abandon a personal mark.

¹¹¹ See BROWNE, *supra* note 12, § 366; see also GREELEY, *supra* note 12, § 138; cf. *id.* § 163 (observing the presumptive exclusion of such marks from a number of trademark registries around the world). Recall that personal marks are those that include the portrait, name, or other indicia of a natural person.

¹¹² Cf. Post & Rothman, *supra* note 4, at 116–25 (describing and elaborating on these distinct interests in the context of the right of publicity).

¹¹³ See LEWIS BOYD SEBASTIAN, *THE LAW OF TRADE MARKS* 4 (5th ed. 1911) (noting that in addition to a mark indicating the manufacturer of goods, it could also “indicate that the goods have been examined and selected by a person of known ability, so that they have attributed to them such value as his approval can give, and his *reputation* depends upon their corresponding to their alleged quality” (emphasis added)).

¹¹⁴ GREELEY, *supra* note 12, § 138.

Each of these doctrines is justified in significant part by an interest in protecting both a person's autonomy and their dignity. I first focus on them as they were understood before our modern Lanham Act era, because only by doing so is their underlying focus on personality evident.

My identification of these personality-based objectives does not mean that they operate in isolation from trademark and unfair competition law's other objectives developed in Part II; often these goals will overlap and align. But these personality interests are distinct and will sometimes conflict with markholders' and/or consumers' interests, and in the areas I identify, courts will sometimes act in preference for these personality-based interests when conflicts arise.

I. The "Natural Right" to One's Own Name. — In the nineteenth and early twentieth centuries, it was an unchallenged proposition that everyone had a "sacred" or "natural right" to use their own name.¹¹⁵ In 1918, a New Jersey court powerfully proclaimed: "The right of a man to use his own name in his own business is part of the natural and inalienable rights guaranteed by the very first clause of our [state] Constitution, without which the right to acquire, possess, and protect property would be of little worth."¹¹⁶ Courts continued to view a person's name as essential to their identity formation.¹¹⁷ In 1944, the Second Circuit declared: "To prevent all use of [a person's surname] is to take away his identity; without it he cannot make known who he is to those who may wish to deal with him; and that is so grievous an injury that courts will avoid imposing it, if they possibly can."¹¹⁸

Accordingly, a person's name alone could not serve as a mark because this would by definition require excluding others from the use of their own names.¹¹⁹ Perhaps the most famous pronouncement of this principle was in *Meneely v. Meneely*,¹²⁰ a case decided by the highest court of New York in 1875. The dispute involved brothers who ran competing bell foundries in Troy, New York.¹²¹ The court concluded

¹¹⁵ See sources cited *supra* note 96.

¹¹⁶ *Hilton v. Hilton*, 104 A. 375, 376 (N.J. 1918).

¹¹⁷ Some courts distinguished between names given at birth and those chosen thereafter. See, e.g., *Societe Vinicole de Champagne v. Mumm*, 143 F.2d 240, 241 (2d Cir. 1944) (per curiam) (extending sacred-rights theory only to given, not adopted names). In *Societe Vinicole de Champagne v. Mumm*, 143 F.2d 240, the Second Circuit rooted this distinction in the policy of preventing the "pirat[ing]" of trade names by "chang[ing] one's own name to that of one's intended victim, or to one near enough . . . to be no more than a deceptive variant." *Id.*; see also *Brennan's, Inc. v. Brennan's Rest., L.L.C.*, 360 F.3d 125, 128 (2d Cir. 2004) (pointing to "show-business people, some newly married women, and recent immigrants [who] shed their birth names like old coats and happily don new ones they prefer," as less attached to their names while others "think their names are treasures to be safeguarded jealously").

¹¹⁸ *Societe Vinicole de Champagne*, 143 F.2d at 241.

¹¹⁹ *Ex parte Dalsimer & Sons*, 1898 Dec. Comm'r Pat. 640, 641.

¹²⁰ 62 N.Y. 427 (1875).

¹²¹ *Id.* at 427–28.

that: "A person cannot make a trade mark of his own name and thus debar others, having the same name, from using it in their business."¹²²

Personal names (whether given names or surnames) were "merely" names.¹²³ They did not identify particular goods for consumers. As Browne noted in the second edition of his treatise in 1898: "[A] man's name cannot be transmuted into a technical trade-mark for himself."¹²⁴ Many people shared the same or similar names, so names often did not indicate a particular individual, but potentially many different people without additional information. Was it the William Smith of Surrey or the William Smith of Aberdeen? Was it William Smith the tailor or William Smith the cobbler? Accordingly, the English treatise author Lewis Boyd Sebastian explained in 1878 "that a name is in its very nature generic, and is properly applied to designate, not one individual in the world, but, it may be, many thousands, to all of whom it is equally appropriate."¹²⁵

It was therefore an "impossibility" for anyone "to arrogate to himself the exclusive use of a name which he shares in common with many other persons."¹²⁶ As the U.S. Supreme Court in *Brown Chemical Co. v. Meyer*¹²⁷ observed in 1891: "It is hardly necessary to say that an ordinary surname cannot be appropriated as a trade mark by any one person as against others of the same name, who are using it for a legitimate

¹²² *Id.* at 427; cf. *Amoskeag Mfg. Co. v. Spear*, 2 Sand. 599, 606–07 (N.Y. Super. Ct. 1849) (observing that there is "no right to appropriate a sign or symbol which, from the nature of the fact which it is used to signify, others may employ with equal truth, and therefore have an equal right to employ, for the same purpose").

¹²³ BROWNE, *supra* note 12, § 195 (quoting Act of July 8, 1870, ch. 230, § 79, 16 Stat. 198, 211); see also Trade-Mark Act of 1905, ch. 592, § 5, 33 Stat. 724, 726 (barring registration if mark "consists merely in the name of an individual . . . not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual"); Trademark Act of 1881, ch. 138, § 3, 21 Stat. 502, 503 (prohibiting registration of marks that are "merely the name of the applicant"); *McLean v. Fleming*, 96 U.S. 245, 252 (1878) ("[I]t is doubtless correct to say that a person may have a right in his own name as a trade-mark as against a trader or dealer of a different name; but the better opinion is, that such a party is not, in general, entitled to the exclusive use of a name, merely as such, without more." (citing *Meneely*, 62 N.Y. at 427; *Dent v. Turpin* (1861) 70 Eng. Rep. 1003; 2 J. & H. 139; *Millington v. Fox* (1838) 40 Eng. Rep. 956; 3 My. & Cr. 338)).

¹²⁴ WILLIAM HENRY BROWNE, A TREATISE ON THE LAW OF TRADE-MARKS AND ANALOGOUS SUBJECTS § 433 (2d ed. & Supp. 1898); see also BROWNE, *supra* note 12, § 433 (omitting "for himself" from the same quote). I note that at the time Browne wrote only "technical" marks were capable of registration and protection as marks; however, nontechnical identifiers, including names, could be protected by unfair competition laws. See BROWNE, *supra*, § 433; *HOPKINS*, *supra* note 98, §§ 3–4; see also *Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1375 & n.6 (Fed. Cir. 1983).

¹²⁵ SEBASTIAN, *supra* note 113, at 18–19; see also *Drake Med. Co. v. Glessner*, 67 N.E. 722, 727 (Ohio 1903) (noting that "the name of a person" cannot be a "technical" trademark "because all such names are generic, and because, speaking in a general sense, every person has the right to use his own name for the purposes of trade," but nevertheless concluding that a trademark could arise in a personal name if it was that of an "inventor or original maker of an article of traffic").

¹²⁶ SEBASTIAN, *supra* note 113, at 19.

¹²⁷ 139 U.S. 540 (1891).

purpose”¹²⁸ Only if a personal name was combined with other distinctive and unique features could it function in combination as a mark.¹²⁹ A person’s portrait and autograph were deemed unique, as were some other symbols that were illustrative or evocative of that person’s name, such as an image of a swan for a business that sold goods made by Swann.¹³⁰ But even when a name in combination with other features functioned as a mark, such exclusive rights could not bar someone else from using their own name and identity in trade. This was true even when the protection sought was not against an unauthorized use of a mark, but instead a broader unfair competition claim for an unauthorized use of a person’s name (a claim that did not require status as a mark).

The attachment to one’s name, particularly one’s family name and often a family trade, sprung from a deep well. As Lord Justice Knight Bruce explained in the 1853 decision of *Burgess v. Burgess*¹³¹:

All the Queen’s subjects have a right to sell these articles in their own names, and not the less so that they bear the same name as their fathers [The defendant] follows the same trade as that his father follows and has long followed, namely, that of a manufacturer and seller of pickles, preserves, and sauces; among them, one called ‘essence of anchovies.’ . . . The whole ground of complaint is the great celebrity which, during many years, has been possessed by the elder Mr. Burgess’s essence of anchovies. That does not give him such exclusive right, such a monopoly, such a privilege, as to prevent any man from making essence of anchovies, and selling it under his own [n]ame.¹³²

As was the case in *Burgess*, much of the early litigation over the use of family names was unsurprisingly within families.¹³³ These were likely heart-wrenching lawsuits between parents and their children, and among siblings, aunts and uncles and their nieces and nephews, and cousins.¹³⁴ The fraught nature of these intrafamily and intergenerational disputes likely weighed on judges and led to the greater allowance

¹²⁸ *Id.* at 542.

¹²⁹ See *McLean v. Fleming*, 96 U.S. 245, 252–53 (1878).

¹³⁰ See BROWNE, *supra* note 12, §§ 15, 204 (“One’s autograph is his emblem or symbol of himself. It is not merely his name.” *Id.* § 204).

¹³¹ (1853) 43 Eng. Rep. 351; 3 De G. M. & G. 896.

¹³² *Id.* at 354; 3 De G. M. & G. at 903–04.

¹³³ Until into the twentieth century, “the family remained the basic business unit.” ALFRED D. CHANDLER, JR., *THE VISIBLE HAND* 17 (1977); see Blair, *supra* note 102, at 404 n.44; see also *id.* at 449–50 (suggesting reasons that prior to the widespread availability of the corporate structure family businesses were preferred). Families remain central in many businesses today. See Blair, *supra* note 102, at 441 & n.214.

¹³⁴ See, e.g., *Burgess*, 43 Eng. Rep. at 351–52; 3 De G. M. & G. at 896, 899 (lawsuit between father and son); *Holloway v. Holloway* (1850) 51 Eng. Rep. 81, 81; 13 Beav. 209, 209 (lawsuit between brothers); *Croft v. Day* (1843) 49 Eng. Rep. 994, 995; 7 Beav. 84, 84 (lawsuit involving uncle and nephew); see also *LFP IP, LLC v. Hustler Cincinnati, Inc.*, 810 F.3d 424, 424, 427 (6th Cir. 2016) (noting in the context of a lawsuit between the Flynt brothers that “[s]ibling and other family

of uses of a shared family name.¹³⁵ This concern was especially present when relatives continued on in family traditions of a particular profession (and were often not parties to a sales agreement that transferred a family business and its associated marks).

Consider the Eighth Circuit's explanation in 1913 for why the Knabe brothers could continue their piano business under that moniker even though they had transferred to the plaintiff, the American Piano Company, the "trade-marks, trade-name, and good will"¹³⁶ of the William Knabe & Company Manufacturing Company, originally founded by their grandfather:

Ernest J. Knabe, Jr., and William Knabe III have a peculiar right to use the name "Knabe" in their trade. They are not pirates. They have not come into the piano business from some other field for the purpose of stealing a good name. They were bred and trained to the business and have known no other calling throughout their lives.¹³⁷

The natural right to use one's own name in trade was also grounded in a theory of self-ownership and the right to use one's own property as one wishes. As the Supreme Court in *Brown Chemical* explained: "A man's name is his own property, and he has the same right to its use and enjoyment as he has to that of any other species of property."¹³⁸ Defendants were accordingly allowed to use their own names, even in competing businesses, as long as they acted in good faith.¹³⁹ And they were permitted to do so even in the face of consumer confusion.¹⁴⁰ Such

rivalries have generated all manner of trademark disputes over the use of a shared last name," *id.* at 427); *Charles J. Donnelly, Inc. v. Donnelly Bros., Inc.*, 191 A.2d 143, 144-45 (R.I. 1963) (describing history of long-running dispute between brothers who worked in competing tailoring businesses after having initially worked together in their father's business). I note that although I made my description gender neutral the vast majority of disputes were among men because of their dominance in trade during this era.

¹³⁵ See, e.g., *Meneely v. Meneely*, 62 N.Y. 427, 431-32 (1875); see also *L.E. Waterman Co. v. Mod. Pen Co.*, 235 U.S. 88, 94 (1914) (agreeing that, when "reasonable precautions" were taken to avoid public confusion, "courts [would] not interfere with the use of a party's own name 'where the only confusion, if any, results from a similarity of the names and not from the manner of the use'" (quoting *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U.S. 118, 140 (1905))).

¹³⁶ *Stix, Baer & Fuller Dry Goods Co. v. Am. Piano Co.*, 211 F. 271, 272 (8th Cir. 1913).

¹³⁷ *Id.* at 274.

¹³⁸ *Brown Chem. Co. v. Meyer*, 139 U.S. 540, 544 (1891).

¹³⁹ See *id.*

¹⁴⁰ See, e.g., *Brown Sheet Iron & Steel Co. v. Brown Steel Tank Co.*, 269 N.W. 633, 635 (Minn. 1936) (allowing two steel companies to continue to operate using the same surname as part of their trade names because "[t]he confusion comes from the legitimate use of words which both have a right to use and not from an improper or deceitful combination made of them" (quoting *Jordan Sulphur Springs & Mud Bath Sanitarium Co. v. Mudbaden Sulphur Springs Co.*, 160 N.W. 252, 253 (Minn. 1916))); *Seligman v. Fenton*, 133 A. 561, 561-62 (Pa. 1926) (allowing continued use of defendant's name in business in spite of evidence of confusion).

potential diversion of business was recognized as an injury without remedy.¹⁴¹

The foundation of these conclusions was the view that restrictions on a person using their own name in business were “intolerable,”¹⁴² a “grievous . . . injury,”¹⁴³ and simply “monstrous.”¹⁴⁴ Such phrases are indicative of uses that violate community norms and are understood as an affront to dignity.¹⁴⁵ Accordingly, even when confusion was likely to result from multiple individuals using their own names in the same field and market, courts considered such confusion tolerable because of the superior right of an individual to use their own name.

This natural right, however, had limits. Acting in bad faith would defeat the right to use one’s own name.¹⁴⁶ When confusingly similar packaging and names were used on similar products, courts would often presume ill intent.¹⁴⁷ This significant and longstanding limit on the

¹⁴¹ *Brown Chem.*, 139 U.S. at 544 (“If such use be a reasonable, honest and fair exercise of such right, he is no more liable for the incidental damage he may do a rival in trade than he would be for injury to his neighbor’s property by the smoke issuing from his chimney These and similar instances are cases of *damnum absque injuria*.”); BROWNE, *supra* note 12, §§ 420–421, 423 (“A Manufacturer has a Right to affix his own Name to an article of his product; and any injury which another manufacturer of the same surname may suffer thereby is *damnum absque injuria*.” *Id.* § 420.); *see also* Rogers v. Rogers, 1 A. 807, 814 (Conn. 1885) (“[T]here has been, from the first to the present time, a general consensus of judicial opinion that the use of a personal name in a fair, honest, and ordinary business manner, could not be prevented, even if damage resulted therefrom.”).

¹⁴² NIMS, *supra* note 96, § 72 (quoting *Jamieson & Co. v. Jamieson* (1898) 15 RPC 169 (AC) at 181).

¹⁴³ *Societe Vinicole de Champagne v. Mumm*, 143 F.2d 240, 241 (2d Cir. 1944) (per curiam); *see also* Stix, Baer & Fuller Dry Goods Co. v. Am. Piano Co., 211 F. 271, 275 (8th Cir. 1913) (suggesting that “[i]t would be a *grievous perversion* of the law of unfair trade” to allow a person or entity to have exclusive rights to use a family name in trade (emphasis added)).

¹⁴⁴ *Turton v. Turton* (1889) 42 Ch D 128 at 136.

¹⁴⁵ Cf. Robert C. Post, *The Social Foundations of Privacy: Community and Self in the Common Law Tort*, 77 CALIF. L. REV. 957, 1006–07 (1989); Post & Rothman, *supra* note 4, at 121–22.

¹⁴⁶ *See, e.g., Brown Chem.*, 139 U.S. at 542; *McLean v. Fleming*, 96 U.S. 245, 250–58 (1878); *John B. Stetson Co. v. Stephen L. Stetson Co.*, 85 F.2d 586, 588 (2d Cir. 1936); *see also* *Holloway v. Holloway* (1850) 51 Eng. Rep. 81, 82; 13 Beav. 209, 213 (“The Defendant’s name being Holloway has a right to constitute himself a vendor of Holloway’s pills and ointment But he has no right to do so with such additions to his own name as to deceive the public and make them believe that he is selling the Plaintiff’s pills and ointment.”); *Croft v. Day* (1843) 49 Eng. Rep. 994, 997; 7 Beav. 84, 90 (“[The defendant] has a right to carry on the business of a blacking manufacturer honestly and fairly; he has a right to the use of his own name . . . but I must prevent him from using it in such a way as to deceive and defraud the public, and obtain for himself, at the expense of the Plaintiffs, an undue and improper advantage.”); *Sykes v. Sykes* (1824) 107 Eng. Rep. 834, 835; 3 B. & C. 541, 542–43 (affirming jury verdict for plaintiff even though one of defendants used his own name on goods because the use was intended to facilitate the passing off of the defendants’ wares as those of the plaintiff); *Treadway*, *supra* note 96, at 145; John H. Wigmore, *Justice, Commercial Morality, and the Federal Supreme Court; The Waterman Pen Case*, 10 ILL. L. REV. 178, 182–83 (1915) (contending that the right to use one’s own name in trade should be limited to instances in which it is used honestly rather than to trade off another’s trade name or value).

¹⁴⁷ *See, e.g., McLean*, 96 U.S. at 253–56. I note that the defendant in *McLean v. Fleming*, 96 U.S. 245, may also have been looked upon unfavorably because he was deceiving the public into thinking that he was a physician. *See id.* at 249–50.

so-called “absolute right” to use one’s own name in trade was perhaps best explained by the Sixth Circuit in 1896 in *Garrett v. T.H. Garrett & Co.*¹⁴⁸:

While it is true that every man has a right to use his own name in his own business, it is also true that he has no right to use it for the purpose of stealing the good will of his neighbor’s business, nor to commit a fraud upon his neighbor, nor a trespass upon his neighbor’s rights or property¹⁴⁹

The mere use of one’s own name without substantially more, however, would not support a finding of bad faith — this usually required evidence of intentional efforts to deceive the public. Evidence of bad faith was unsurprisingly found when a company enlisted a person who shared a similar name with a successful individual in an effort to hide behind the sacred-rights theory to sell competing goods.¹⁵⁰ Bad faith was also found when a person had no connection to a particular field or trade before adopting the use of their surname in a market that was already occupied by a well-known person or company that shared their name.¹⁵¹ Such shenanigans fooled no one.¹⁵²

However, even when a defendant failed to take “reasonable precautions,” acted in bad faith to trade off a plaintiff’s reputation, or took steps to intentionally deceive consumers, injunctions still provided latitude for these bad-actor defendants to continue to use their names, even in the same markets, and even in the face of consumer confusion.¹⁵³ This latitude demonstrates respect for a defendant’s personality rights sometimes over that for the property rights of markholders or the protection of consumers.

When trademark law and unfair competition laws expanded to permit personal names to function as marks (if they acquired secondary meaning),¹⁵⁴ the same limits on exclusivity remained as when they had been protected solely under broader unfair competition laws.¹⁵⁵ Today,

¹⁴⁸ 78 F. 472 (6th Cir. 1896).

¹⁴⁹ *Id.* at 478 (citing *Holloway*, 51 Eng. Rep. 81; 13 Beav. 209).

¹⁵⁰ See *Churton v. Douglas* (1859) 70 Eng. Rep. 385, 394; Johns. 174, 197 (citing *Rodgers v. Nowill* (1853) 43 Eng. Rep. 241; 3 De G. M. & G. 614).

¹⁵¹ See, e.g., *Stetson*, 85 F.2d at 587.

¹⁵² See BROWNE, *supra* note 124, § 728.

¹⁵³ See, e.g., *L.E. Waterman Co. v. Mod. Pen Co.*, 235 U.S. 88, 94–98 (1914); *Donnell v. Herring-Hall-Marvin Safe Co.*, 208 U.S. 267, 274 (1908); *S.M. Spencer Mfg. Co. v. Spencer*, 66 N.E.2d 19, 21–23 (Mass. 1946).

¹⁵⁴ By 1920, if not earlier, trademark law had expanded to encompass descriptive terms that acquired secondary meaning (that is, consumers associated the particular term with a particular source of a product or service). Personal names became capable of achieving status as marks on the same basis. See Act of March 19, 1920, ch. 104, § 1(b), 41 Stat. 533, 533–34; *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315, 329–30 (1938). The use of names as marks was likely recognized even as early as the Trade-Mark Act of 1905, ch. 592, 33 Stat. 724. See *Thaddeus Davids Co. v. Davids Mfg. Co.*, 233 U.S. 461, 468 (1914).

¹⁵⁵ See, e.g., *Ida May Co. v. Ensign*, 66 P.2d 727, 729 (Cal. Dist. Ct. App. 1937).

the initial bar on using personal names as marks is typically understood as an issue of the failure to establish source identification in the minds of consumers. However, limits on the use of personal marks initially were also rooted in significant part on the personality interests of the individuals who shared the same name as the person who sought to use the name as a mark or trade name.¹⁵⁶ Thus, the initial bar on acquiring a trademark in one's own name was in part a corollary of the right of everyone to use their own name in trade. No one's adoption of a name or mark could obstruct "others bearing the same name" from using their own name in good faith.¹⁵⁷

As the corporate form rose in availability and prominence toward the turn of the twentieth century, courts more frequently distinguished between uses of a person's name in trade generally and the use of a person's name as the trade name of a business. Courts began to recognize that greater limits on uses of a person's name might be appropriate in the context of chosen trade names, even if those names originated with a person's name. As the California Supreme Court in 1904 in *Dodge Stationery Co. v. Dodge*¹⁵⁸ explained:

[A] person comes naturally by his name from his parents, and it is a thing personal to himself, which in truth and in justice he has the right to use, provided he does not resort to artifices calculated to produce deception or confusion in the public mind between him and some other person, to the injury of the latter; while the name given to a corporation is an artificial and impersonal thing, selected arbitrarily by the incorporators themselves, and which can be selected from an entire vocabulary of names.¹⁵⁹

Despite this shifting view, even when a defendant chose to name their company using their own name (rather than something distinct), courts continued to extend latitude to use one's own name and identity in business (even after sales) because of the personality-based right to use one's own name and identity in trade.¹⁶⁰

¹⁵⁶ GREELEY, *supra* note 12, § 138.

¹⁵⁷ *Id.*; see also *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U.S. 118, 134 (1905) (allowing sale of defendant's typewriters using the "Remington" name because "a personal name cannot be exclusively appropriated by any one as against others having a right to use it").

¹⁵⁸ 78 P. 879 (Cal. 1904).

¹⁵⁹ *Id.* at 882; see also *Treadway*, *supra* note 96, at 146–47 (noting in 1897 that the same interests in allowing a person to use their own name did not extend to a "corporate name," *id.* at 146, which was "chosen," *id.* at 147). Similarly, although Professor John Wigmore agreed that "personality attaches" to a person's name and "personal liberty" is bound up with the choice and use of a name generally, he thought that the use of the same name in trade was "no longer a question of preserving our personality, in itself." Wigmore, *supra* note 146, at 182. Instead, in such instances the personality rights were more limited and "merely a tool" subject to limits, including the honest use of one's identity in trade. *Id.*

¹⁶⁰ See *Brown Chem. Co. v. Meyer*, 139 U.S. 540, 541, 547–48 (1891) (allowing defendant, successor to E.L. Brown, to continue to sell "Brown's Iron Tonic" because of connection to inventor and founder's name in spite of plaintiff's mark in "Brown's Iron Bitters"); *Fleming v. McLean* (C.C.E.D. Mo. June 4, 1874), reprinted in *Transcript of Record* at 162–63, *McLean v. Fleming*, 96

2. *Limits on Unauthorized Uses of Another's Identity.* — A corollary of the right to use one's own name and identity in trade is the right to stop others from doing so — at least those who don't share the same name. Trademark and unfair competition laws have long limited such unauthorized uses of another's identity. These longstanding prohibitions are partially rooted in market-based concerns of identity-holders, as well as a concern for protecting consumers from fraud, but they are also rooted in protecting a person's dignity and autonomy. Because a person's name and image were understood to be that person's own property, each person had a right to control how others used their identity in trade. Unauthorized uses of another's name (or other indicia of a person's identity) as part of a trade name or trademark, or in conjunction with a business enterprise were also an affront to a person's dignity, "subject[ing] [them] to humiliation and embarrassment."¹⁶¹ Cases raising the unauthorized use of a person's identity in trade therefore were often indistinguishable from privacy-based appropriation claims (which were often brought alongside trademark and unfair competition claims).¹⁶²

In 1878, the U.S. Supreme Court understood enforcement of trademark and unfair competition laws in the context of personal names as an important part of protecting the "celebrity" of the craftsperson whose goods could otherwise be pirated by another. This craftsperson was "entitled to all the advantages of that celebrity, whether resulting from the greater demand for his goods or from the higher price the public are willing to give for the article, rather than for the goods of the other manufacturer, whose reputation is not so high."¹⁶³

U.S. 245 (1878) (No. 259) (issuing an injunction that left latitude for the defendant to continue to use his name in business, and in the context of the same field of patent medicines), *aff'd in part, rev'd in part sub nom. McLean*, 96 U.S. 245; *Ida May*, 66 P.2d at 727-28 (allowing businesses both competing in women's apparel to continue operating under similar names in the city of Los Angeles); *Fitzgerald's Atl. Bar & Grill v. Fitzgerald*, 40 N.Y.S.2d 341, 342-43 (Sup. Ct. 1942) (allowing defendant to operate a restaurant using the same surname in its sign and trade name as the senior user despite being on the same block because of the "natural right" to use one's own name in business, *id.* at 343); *Seligman v. Fenton*, 133 A. 561, 561-62 (Pa. 1926) (allowing competitors in the moving and storage business to continue operating under the same surname "in a like business in the same neighborhood," *id.* at 562).

¹⁶¹ *Tomsky v. Clark*, 238 P. 950, 952 (Cal. Dist. Ct. App. 1925).

¹⁶² *See, e.g., Edison v. Edison Polyform Mfg. Co.*, 67 A. 392, 395 (N.J. Ch. 1907) (enjoining use of inventor's name and identity in compounded preparation); *World's Dispensary Med. Ass'n v. Pierce*, 96 N.E. 738, 739-41 (N.Y. 1911) (limiting defendant's use of his own name where would cause confusion as to sponsorship by Dr. Ray Pierce); *State ex rel. La Follette v. Hinkle*, 229 P. 317, 319-20 (Wash. 1924) (enjoining a political party from using the name of a particular individual without his permission); *cf. Fairfield v. Am. Photocopy Equip. Co.*, 291 P.2d 194, 200 (Cal. Dist. Ct. App. 1955) (allowing recovery of damages for unauthorized use of attorney's name in advertising for a product that allegedly caused him to be "ridiculed" by colleagues).

¹⁶³ *McLean*, 96 U.S. at 251.

The concern for protecting a particular person's reputation and dignity supported not only infringement and unfair competition actions, but also the denial of status as a trademark when a person's identity was used without permission as part of someone else's claimed mark. This common law doctrine was codified into both state and federal trademark statutes, as well as state business codes. For example, in 1853, Massachusetts passed a law requiring the written consent of a person or their legal representatives before one could "assume or continue to use in his business the name . . . of any other person."¹⁶⁴ By the late nineteenth century, marks that "include[d] the portrait or name of a person other than the user of the mark" were banned in many countries around the world unless there was written consent by the underlying identity-holder.¹⁶⁵ In addition to the United States, for example, Brazil, Denmark, Finland, Norway, and Sweden prohibited such practices.¹⁶⁶

Trademark registries long barred the registration of any mark that consisted of "the portrait or name of a person other than the user of the mark" without written consent.¹⁶⁷ This bar on registration is codified in today's section 2 of the Lanham Act, which prohibits the registration of marks that may "falsely suggest a connection with persons, living or dead" or that "consist[] of or comprise[] a name, portrait, or signature identifying a particular living individual except by his written consent."¹⁶⁸ This bar on registration was justified both to avoid the potential consumer deception that such an unauthorized use would cause and

¹⁶⁴ An Act to Prevent the Transaction of Business Under Unauthorized Names, ch. 156, 1853 Mass. Acts 450 (codified at MASS. GEN. STAT. ch. 56, §§ 3–4 (1861)); *see also* *Bowman v. Floyd*, 85 Mass. (3 Allen) 76, 77, 79–80 (1861) (discussing the statute).

¹⁶⁵ GREELEY, *supra* note 12, § 163.

¹⁶⁶ *Id.*

¹⁶⁷ *Id.*; *see, e.g.*, Trade-Mark Act of 1905, ch. 592, § 5(b), 33 Stat. 724, 726 ("[N]o portrait of a living individual may be registered as a trade-mark, except by the consent of such individual, evidenced by an instrument in writing . . ."); Act of April 4, 1941, ch. 58, § 14242(g), 1941 Cal. Stat. 703, 705 (precluding registration of a mark that consists of "[t]he portrait of a living person except by consent of the person evidenced by an instrument in writing").

¹⁶⁸ 15 U.S.C. § 1052(a), (c). The term "particular living individual" appears to have been added to address a concern expressed during hearings that this bar to registration might otherwise obstruct legitimate applications. *See Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Pats.*, 76th Cong. 185 (1939) (statement of Chauncey P. Carter) ("A large percentage of trade-marks may consist of or comprise a word or words that constitute the Christian, middle, or surname [of] some individual somewhere and it is absurd to require that every such mark be registered only with the written consent of any such individual."). There is also a provision that precludes the use of "the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by . . . written consent." 15 U.S.C. § 1052(c).

Many states have similar prohibitions that largely track the Lanham Act language. *See, e.g.*, CAL. BUS. & PROF. CODE § 14205(b), (d) (West 2021); N.Y. GEN. BUS. LAW § 360-a(b), (d) (McKinney 2021); TEX. BUS. & COM. CODE ANN. § 16.051(a)(2), (4) (West 2021); WASH. REV. CODE § 19.77.020(1)(b), (d) (2021).

to protect interests akin to publicity and privacy rights.¹⁶⁹ The fact that the bar both at common law and as codified extends beyond instances of likely confusion demonstrates the focus on the personality interests of the identity-holder, in addition to concerns for market-based harms.

The provision was adopted to preserve the dignity of those depicted without consent, including the dignity of the deceased and their surviving family. Conway Coe, the Commissioner of the Patent Office in the 1930s, highlighted this dignitary concern in his 1938 remarks in favor of prohibiting the registration of marks using others' identities without their (or their heirs') permission regardless of confusion as to source. He described the "shock to [his] sense of propriety to see liberty taken not only with the names of our Presidents, but with the names of celebrities of private life."¹⁷⁰ Commissioner Coe pointed to several examples of the commercial exploitation of individuals, including several recently deceased individuals, and the affront to their (and their families') dignity. He pointed to one applicant that tried to register the name of Knute Rockne (a famous coach of the University of Notre Dame football team) immediately upon his death for use on whiskey and alcoholic beverages.¹⁷¹ He also found particularly offensive an "attempt to register the name of the Duchess of Windsor for brassieres and ladies' underwear."¹⁷² He thought such usages violated community norms and were "outrages of the sensibilities of the American people."¹⁷³

Even long before the codification of this bar to registration, the U.S. Patent Office (the predecessor to today's Patent and Trademark Office) rejected applications to register marks that referred to individuals without their permission. In 1898, then-Patent Commissioner Charles H. Duell approved the refusal to register "Dewey's Chewies" for confections on the grounds that Admiral George Dewey was a "living celebrity" who was "entitled to protection from the ordinary trader."¹⁷⁴ No one but

¹⁶⁹ *Hornby v. TJX Cos.*, 87 U.S.P.Q.2d 1411, 1424 (T.T.A.B. 2008); see also *In re ADCO Indus.-Techs., L.P.*, 2020 WL 730361, at *13 (T.T.A.B. Feb. 11, 2020) (recognizing that section 2(a) of the Lanham Act protects "the right of privacy and publicity that a living person has in his/her identity and protects the public by targeting marks that may mislead the public into thinking that the source of the marks is connected with a particular person").

¹⁷⁰ *Trade-Marks: Hearing on H.R. 9041 Before the Subcomm. on Trade-Marks of the H. Comm. on Pats.*, 75th Cong. 79 (1938) (statement of Conway Coe, Comm'r of Patents).

¹⁷¹ *Id.*

¹⁷² *Id.*

¹⁷³ *Id.* at 80; see also *id.* at 81 (statement of Edward S. Rogers, American Bar Association) (criticizing "attempt[s] to give vicarious credit to goods by putting a great man's name on them"); *Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Pats.*, supra note 168, at 19 (statement of Thomas E. Robertson, former Comm'r of Patents) (expressing concern about the unauthorized commercial use of dead Presidents' names and likenesses on products and in advertising).

¹⁷⁴ *Ex parte McInnerney*, 85 Off. Gaz. Pat. Office 148, 149 (1898).

Dewey himself could appropriate “Dewey” as a mark for goods or services without Dewey’s consent.¹⁷⁵ The Dewey in question was a renowned admiral with the U.S. Navy who had surprised the Spanish Pacific fleet in 1898, and as a result had become famous.¹⁷⁶ Because of his popularity, Dewey was subject to widespread and unauthorized commercialization of his name and image, including a particularly irksome laxative named in his honor.¹⁷⁷ Trademark and related laws long stood in the way of such unauthorized uses even when such uses were not likely to cause consumer confusion or jeopardize market-based interests.

3. *Limits on Transferability.* — Although assignments of marks and trade names are generally allowed in conjunction with the sale of a business, one of the longstanding exceptions to free assignability of trademarks has been in the context of marks or business names that consist of a person’s name, autograph, or portrait. Such marks have long been allowed to transfer, but on a far more limited basis than transfers of other types of marks. Such differential treatment is based on a variety of theories, including that the continued use of a person’s identity by a successor company could work a fraud on the public, who might believe that the person identified by the marks continues to work there or continues to approve of its goods or services. But these limits on transferability were also justified by protecting the underlying person whose identity was intertwined with the mark or trade name.¹⁷⁸ The interest in protecting the rights of the identity-holder provides yet another example of a pocket of trademark and unfair competition law that sometimes allows autonomy and dignity interests to prevail when they conflict with other trademark objectives. I will consider these limits on transferability in three contexts: determinations of when a transfer is an assignment in gross, when goodwill is capable of transfer, and, finally, when limits are placed on the scope of transfers.

(a) *Assignments in Gross.* — In contrast to copyrights and patents, “[t]here is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed.”¹⁷⁹ When a transfer of a business or mark

¹⁷⁵ *Id.*

¹⁷⁶ William P. Leeman, *America’s Admiral: George Dewey and American Culture in the Gilded Age*, 65 *THE HISTORIAN* 587, 587 (2003).

¹⁷⁷ *Id.* at 596.

¹⁷⁸ See, e.g., *Skinner v. Oakes*, 10 Mo. App. 45, 60–61 (1881) (“[W]e cannot go to the wild length of holding that the name of a man may be segregated from the man himself, and from the business in connection with which the man has used it, erected into an ideal and abstract species of property, [and] be made a subject of traffic and sale in the market”); BROWNE, *supra* note 124, § 57 (noting that the general transferability of marks could be limited when a mark is rooted in a person, on the basis that allowing such a transfer would deprive a person of the use of their name and deceive the public).

¹⁷⁹ *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918).

does not come along with the underlying goodwill of the business and the new entity does not produce similar goods or provide similar services, the transfer will be deemed an assignment in gross, and any rights to the mark will be forfeited.¹⁸⁰ So, for example, failure to transfer a secret formula for a soda will invalidate the transfer of a mark to that soda.¹⁸¹

Transfers of marks comprised in part of a person's identity are particularly prone to invalidation as assignments in gross. In the context of services, the essential nature of the provider of those services will often make those services inseparable from the identity-holder from whom the mark originated. This can also be true even in the context of products. A different person's involvement in a company or with the craftsmanship or manufacturing of products may make the goods fundamentally different.¹⁸² This is especially true if the goods and their reputation are tied to the special skill or reputation of a particular person: "[W]here the reputation of the goods and of the name has grown out of excellence of manufacture depending on the honesty and skill of the maker, it is more difficult to hold that [the mark] can be sold to a stranger, or that it is generally assignable."¹⁸³ Accordingly, when a

¹⁸⁰ See MCCARTHY, *supra* note 7, § 2:16. A mark can be created anew by a successor company, but will not be considered a continuation of the marks thought to be transferred.

¹⁸¹ See, e.g., PepsiCo, Inc. v. Grapette Co., 416 F.2d 285, 290 (8th Cir. 1969); see also Mister Donut of Am., Inc. v. Mr. Donut, Inc., 418 F.2d 838, 842 (9th Cir. 1969) (holding that an assignment was in gross because there was no transfer of "customer lists, merchandise, equipment, recipes, decals or other goods"); Clark & Freeman Corp. v. Heartland Co., 811 F. Supp. 137, 141 (S.D.N.Y. 1993) (holding that transfer of mark in HEARTLAND for boots was assignment in gross because the successor use was on men's work boots, and the original use was on women's pixie-style boots).

Some have suggested that courts today are less rigorously enforcing limits on assignments in gross. See, e.g., Irene Calboli, *Trademark Assignment "With Goodwill": A Concept Whose Time Has Gone*, 57 FLA. L. REV. 771, 788–99 (2005); Lemley, *supra* note 11, at 1709–10. But courts continue to rely on the doctrine even if its scope has narrowed or it can be navigated around by sophisticated parties. See, e.g., Sugar Busters LLC v. Brennan, 177 F.3d 258, 265–67 (5th Cir. 1999) (invalidating transfer of mark to plaintiff as an assignment in gross because plaintiff sold diet books, rather than operated retail stores as the assignor had done); Vital Pharms., Inc. v. Monster Energy Co., 472 F. Supp. 3d 1237, 1262–63 (S.D. Fla. 2020) (observing that the "anti-assignment-in-gross" rule is deeply rooted in trademark law," *id.* at 1262, and concluding that the plaintiff did not have priority over the relevant mark because the transfer was "an invalid assignment in gross," *id.* at 1263).

¹⁸² See Oakes v. Tonsmierre, 49 F. 447, 449, 451 (C.C.S.D. Ala. 1883) (considering when and how the absence of the namesake candymaker would affect the ability to continue to use that mark in a successor business); Filkins v. Blackman, 9 F. Cas. 50, 51–52 (C.C.D. Conn. 1876) (No. 4,786) (observing that successor to business and mark for DR. J. BLACKMAN'S GENUINE HEALING BALSAM could use Dr. Blackman's name in its mark because he had given permission to do so, the formula made was indeed his creation, and the public was not deceived into thinking he had an ongoing relationship with the company); BROWNE, *supra* note 124, § 57 (noting that if a mark "consist[s] of a man's name" and "leads the public to believe the particular goods are in fact made by the person whose name is thus stamped upon them, whereas they are in fact made by another person, then such a use of the name will not be protected by the courts, for to do so would be to protect the perpetration of a fraud on the people" (quoting *Skinner*, 10 Mo. App. at 56–57)).

¹⁸³ BROWNE, *supra* note 124, § 57 (citing *Carmichel v. Latimer*, 11 R.I. 395 (1876)).

person's connection to a business is significant enough (whether in the context of services or goods), any attempt to transfer marks comprised at least in part of that person's identity could lead to the forfeiture of any rights to such marks.

(b) *Personal Goodwill and Limits on Alienability.* — Determinations of whether something is an assignment in gross often turn on whether the underlying goodwill of the business also transferred (or at least the goodwill associated with the product or services at issue). Generally speaking, goodwill represents the positive associations that consumers who frequent a business have with that business.¹⁸⁴ Goodwill is something of great value and is deemed a form of intangible or intellectual property. Trademarks can be indicative of this goodwill but are not its measure. Goodwill is typically the property of a business and can usually transfer along with that business if it is sold (whether voluntarily or through bankruptcy). However, if a business's goodwill is inseparable from a person (or identifiable group of people), then neither the marks, nor the trade names, nor the goodwill of the business can transfer.

There are at least three distinct forms of goodwill that have historically been treated differently when it comes to the possibility of alienability. I will designate these as *business goodwill*, *professional goodwill*, and *personal goodwill*. Originally, business goodwill had a degree of physicality to it. In 1810, Lord Eldon defined goodwill as “nothing more than the probability that the old customers will resort to the old place.”¹⁸⁵ The idea was that when a customer returned to the same physical location or store, they would find there the same entity providing the same goods or services.¹⁸⁶ Goodwill can also attach to objects or goods that are sold from a particular place or business.¹⁸⁷

In contrast, professional goodwill and personal goodwill “attach[] more directly to a person, and [are] not associated, in the minds of the public or business world, with any particular spot.”¹⁸⁸ They are rooted in a particular person, wherever that person might go. Professional goodwill focuses on the goodwill associated with a person's professional

¹⁸⁴ *Metro. Bank v. St. Louis Dispatch Co.*, 149 U.S. 436, 446 (1893) (quoting JOSEPH STORY, COMMENTARIES ON THE LAW OF PARTNERSHIP § 99 (Boston, Little, Brown & Co., 5th ed. 1859)).

¹⁸⁵ *Cruttwell v. Lye* (1810) 34 Eng. Rep. 129, 134; 17 Ves. Jun. 335, 346 (punctuation omitted).

¹⁸⁶ See NIMS, *supra* note 96, § 13.

¹⁸⁷ *Id.*

¹⁸⁸ *Id.* Prior to the common availability of the corporate form, most businesses' goodwill merged with the underlying people. See Blair, *supra* note 102, at 407 (“[A business's] credibility . . . depend[ed] almost entirely on the proprietor's skill, personal relationships, and reputation as a business person . . .”).

services. Such goodwill “attaches to *persons*, not to place[s] usually.”¹⁸⁹ It most often arises in the context of professions involving skilled individuals who are not fungible, such as attorneys, physicians, musicians, and artists. In such instances, consumers seek out the services of particular individuals who are often irreplaceable. As a result, professional goodwill usually cannot transfer.¹⁹⁰

Although this limit on transferability was significantly based on concerns for protecting consumers, it also was animated by the view that an individual’s personality and the business’s goodwill merged in the context of professional goodwill, making separation impossible. The Supreme Court of Pennsylvania highlighted such a merger when it held that the name of the famous American composer and conductor John Philip Sousa, best known for his military marches, could not transfer to his manager.¹⁹¹ The court held that Sousa’s professional goodwill in connection with the use of his name for musical services could not be assigned to anyone as it was personal to him.¹⁹² “The value of the names of such persons depends entirely upon their personal reputation, skill, and experience, and is indissolubly connected or associated with the owner.”¹⁹³

Personal goodwill encompasses both a person’s standing in the community as well as their professional reputation, regardless of whether they work in a field considered “professional.” Personal goodwill is associated with the production of goods as well as with personal services. It encompasses what treatise author Browne termed “[p]ersonal trademark[s],” those that are “so clearly personal as to import that the goods

¹⁸⁹ NIMS, *supra* note 96, § 13 (emphasis added). Even though treatise author Harry Nims was more critical of the sacred-rights theory than Browne, *see id.* § 68, he agreed that assignability should be limited in these contexts:

On grounds of public policy the right to use the name of an artist or musician is not capable of being assigned so as to be used, for example, in designating or advertising a band, or a series of concerts, with which the musician in question has no connection. The same is probably true of all professional names, whenever the repute of the name depends on the personality or personal characteristics of the individual in such a way that if used, except in connection with that individual, the public will not be getting what it has a right to expect from the use of the name.

Id. § 17 (citation omitted); *see* BROWNE, *supra* note 124, § 726.

¹⁹⁰ The concepts of professional and personal goodwill overlap with the concept in contract law that personal services contracts are not transferable and may be enforceable through injunctive relief in contexts in which a breach of a contract would otherwise be remedied only through damages. *Cf.* Lea S. VanderVelde, *The Gendered Origins of the Lumley Doctrine: Binding Men’s Consciences and Women’s Fidelity*, 101 YALE L.J. 775, 796–97 (1992) (developing concerns about enforcing “a mitigated form of slavery” by granting injunctive relief for breach of personal services contracts, *id.* at 797 (quoting *Ford v. Jermon*, 6 Phila. 6, 7 (Pa. Dist. Ct. 1865))).

¹⁹¹ *See* *Blakely v. Sousa*, 47 A. 286, 287–88 (Pa. 1900).

¹⁹² *Id.* at 288.

¹⁹³ *Id.*

bearing it are manufactured by a particular person.”¹⁹⁴ Such personal marks and personal goodwill were not thought of as capable of transfer because they were understood as inseparable from the underlying person.¹⁹⁵ It was only when a person’s identity became separated and recognized as distinct and nonpersonal in nature that assignability became possible. Thus, even in the context of the sale of goods, rather than services, marks were sometimes deemed “unassignable” when the products sold involved “the personal skill of an artist or artisan” such that a product bearing the person’s name as part of a trademark would “imply that [the individual’s] personal work or supervision was employed in the manufacture” of the item.¹⁹⁶

In contrast, when a company name — even if originating with an individual’s identity — was understood to have gained a meaning separate and apart from the founding individual, it could be transferred along with the goodwill of a business without requiring continued involvement of that individual.¹⁹⁷ The status of marks is dynamic. Over time the meaning of marks can change; a person’s name, even if used as the trade name for a business or product, can become disentangled with their personality, “practically becom[ing] an artificial one, designating nothing but the establishment.”¹⁹⁸

Judge Cardozo emphasized this “distinction between names purely personal or individual, and names that had acquired, through the incrustations of time, a veneer of associations artificial and impersonal.”¹⁹⁹ In this instance a mark can have a “double significance”;²⁰⁰ the name can point both to a person and to a separate and identifiable company or product. The possibility of such separability (and awareness of it)

¹⁹⁴ BROWNE, *supra* note 12, § 366; *see also* *Bury v. Bedford* (1864) 46 Eng. Rep. 954, 961; 4 De G. J. & S. 352, 369; *Bone, supra* note 77, at 575 (observing that “the clearest and least problematic kind of goodwill” is “goodwill as personal reputation” moored in a particular merchant or craftsman).

¹⁹⁵ *See* *Warren v. Warren Thread Co.*, 134 Mass. 247, 247 (1883); BROWNE, *supra* note 124, § 437.

¹⁹⁶ *Blakely*, 47 A. at 288 (quoting *Hoxie v. Chaney*, 10 N.E. 713, 714 (Mass. 1887)); *see also* *Warren*, 134 Mass. at 247 (noting that when “peculiar personal skill” is involved in the manufacture of a good, limits exist on the transfer of trademarks); *Mayer v. Flanagan*, 34 S.W. 785, 786 (Tex. Civ. App. 1896) (invalidating a contract transferring the trademark MAGALE’S MONARCH WHISKEY and other related marks because the trademark “derived its value from the known skill, integrity, and honesty of [Magale] in selecting good whiskey”).

¹⁹⁷ *See, e.g.,* *McLean v. Fleming*, 96 U.S. 245, 248–50 (1878) (recognizing the transfer of the trademark for Dr. C. McLane’s Liver-Pills from the inventor Dr. McLane to subsequent purchasers of his patent medicine business); *Hoxie*, 10 N.E. at 715 (recognizing legitimacy of transfer of marks that included the “Hoxie” name for soap when transferred by Albur Hoxie to successors to his company).

¹⁹⁸ *In re Brown*, 150 N.E. 581, 583 (N.Y. 1926) (quoting *Rowell v. Rowell*, 99 N.W. 473, 479 (Wis. 1904)).

¹⁹⁹ *Id.* (citing *Slater v. Slater*, 67 N.E. 224, 225 (N.Y. 1903)).

²⁰⁰ *Thaddeus Davids Co. v. Davids Mfg. Co.*, 233 U.S. 461, 470 (1914).

grew with the rise in popularity of the corporate structure, such that by 1940 Judge Learned Hand explained: “[E]veryone knows that the name of a corporation assures no continuity of personnel — at least when . . . the only name of an individual which it contains has long since ceased to mean that he has any share in its management.”²⁰¹

(c) *Limited Scope of Transfers*. — When a separation between the underlying person and the business or marks sold was possible, transfers could take place. In these instances, the seller’s ability to use their own name and identity in commerce could be limited.²⁰² Confusion was no longer tolerated to the same degree as it was when a defendant independently and in good faith used their own name. “[T]he rule, often held applicable to accidental similarity of personal names in business . . . , that every man in the absence of proved fraud or misleading artifices has the absolute right to use his own name, even though he may interfere with and injure the business of another . . . cannot be applicable” when the name-holder voluntarily sells the use of his name in the context of a particular business or trade.²⁰³

From at least the beginning of the twentieth century, courts expressed the view that a seller cannot “keep for himself the essential thing he sold, and also keep the price he got for it.”²⁰⁴ This language comes from the famous and oft-cited (even today) 1915 case of *Guth v. Guth Chocolate Co.*²⁰⁵ The litigation arose after Charles G. Guth sold his candy company along with “the good will and use of the name Guth for the purpose of manufacturing and selling candies under the Guth label,” and decided to open up a competing chocolate company using his own name on the products.²⁰⁶ The Fourth Circuit enjoined him from labeling his new candy with trademarks that used his name, even his full name, because of his voluntary transfer of the marks to the Guth Chocolate Company.²⁰⁷

Even earlier, in 1876, in a case with striking similarities to *Guth*, a Missouri appellate court restricted the ability of the well-known candymaker Peter Oakes to use his name as a mark in a competing business after he sold his eponymously named business.²⁰⁸ Nevertheless, the

²⁰¹ *Mut. Life Ins. Co. v. Menin*, 115 F.2d 975, 978 (2d Cir. 1940).

²⁰² *Cf., e.g., Richmond Nervine Co. v. Richmond*, 159 U.S. 293, 300 (1895); *Kidd v. Johnson*, 100 U.S. 617, 620 (1880).

²⁰³ *Karsh v. Haiden*, 260 P.2d 633, 637 (Cal. Dist. Ct. App. 1953); *see also Hoxie v. Chaney*, 10 N.E. 713, 716–17 (Mass. 1887) (holding that while the seller Hoxie could continue to sell soap and use his name in trade, he could not “represent[] himself as the successor to the business, the goodwill of which he had sold” or use the trademarks that he had transferred even if they included his name, *id.* at 717); *Treadway*, *supra* note 96, at 145–47.

²⁰⁴ *Guth v. Guth Chocolate Co.*, 224 F. 932, 934 (4th Cir. 1915).

²⁰⁵ 224 F. 932.

²⁰⁶ *Id.* at 934.

²⁰⁷ *Id.*

²⁰⁸ *Probasco v. Bouyon*, 1 Mo. App. 241, 242–44 (1876).

defendant Oakes was given latitude to use his name to inform customers of his association with a new competing venture, even though he could no longer use a mark for it composed solely of the personal mark that he had voluntarily transferred:

Oakes may still make and sell candy, but not under the name the use of which he has for this purpose sold. He may make and sell the very same candies, and is not obliged to conceal the fact that they are made by him; but he may not, in St. Louis, advertise them either by sign over his shop door, or by label on the boxes in which they are packed, or in any other general and public way, as “Oakes’ Candies.”²⁰⁹

The allowance for identity-holders to start competing ventures and to inform consumers of their association with them exceeds the latitude to refer to marks that are not personal in nature, and demonstrates trademark and unfair competition law’s consideration of autonomy and dignity interests.²¹⁰ It also furthers and supports the more commonly recognized objective of providing consumers with useful and accurate information about the providers of goods and services.

Notably, *involuntary* transfers of personal marks were treated quite differently from voluntary ones and from involuntary transfers involving impersonal marks. Outside of the context of personal marks, trademark law provided latitude to transfer marks in bankruptcy as long as the underlying business also transferred. But transfers of marks comprised of some aspect of a person’s identity were sometimes prohibited entirely. As Browne observed in 1898: “The right of one to use his name as a trade-mark . . . is a *personal right*, and does not pass to his assignee in bankruptcy.”²¹¹ Judge Cardozo expressed a similar concern over involuntary transfers of personal marks: “A name, which in popular thought is solely or predominantly the name of a living man, may not be sold against his protest as it might if it were the impersonal symbol

²⁰⁹ *Id.* at 246–47. In some states this view has been codified. In California, for example, the Business and Professions Code states that the right to use a person’s name does not generally transfer as a part of the goodwill of a business, but expressly allows the transfer of such a name if it is the one “under which the business is conducted.” CAL. BUS. & PROF. CODE § 14103 (West 2021); *see id.* § 14101.

²¹⁰ *See, e.g.,* Goldwyn Pictures Corp. v. Goldwyn, 296 F. 391, 397, 403 (2d. Cir. 1924) (recognizing the ability of famous film producer Samuel Goldwyn (a pseudonym) to transfer by contract the right to use his name to his eponymous film studio, Goldwyn Pictures Corporation, but suggesting that the absolute-right theory provided latitude for him to continue to use his name as a producer in future films without liability for trademark infringement).

²¹¹ BROWNE, *supra* note 124, § 743 (emphasis added); *see* Child.’s Bootery v. Sutker, 107 So. 345, 348 (Fla. 1926) (noting that if a trade name “is one which is in law a personal name, and the transfer thereof is by operation of law or through judicial proceedings, a limitation exists upon the future use thereof by the purchaser” at least when enforced against the identity-holder); Buffalo Oyster Co. v. Nenko, 229 N.Y.S. 210, 213 (Sup. Ct. 1928) (distinguishing voluntary and involuntary transfers and concluding that “[u]ndoubtedly it is the law that no man, unless he has voluntarily parted with that right, may be deprived of the use by him of his name in business”).

of an organization or a product.”²¹² Such a rule is required to protect the person’s “standing” and “good name” in the community (as well as future business prospects) if the successor company engages in “dishonorable business conduct” or produces inferior goods.²¹³

Even when involuntary transfers were allowed, latitude was provided to continue to use one’s own name.²¹⁴ Recognizing the “handicap” and dangers of such transfers, Judge Hand warned that such an occurrence “would often give . . . creditors the practical power of preventing [a person’s] resumption of the only activity by which he could earn a living.”²¹⁵ Judge Hand distinguished the situation of a bankrupt corporation from that of a bankrupt individual. Even though a corporation could adopt another name, a person could not do so without a fundamental injury to their identity.²¹⁶ Accordingly, courts have long allowed bankrupt individuals to continue to use their names and identities in future endeavors, including in competing businesses.²¹⁷

In fact, limits were placed on how a purchaser (markholder) could use or refer to past owners or founders of a company.²¹⁸ For example, in 1883 in *Manhattan Medicine Co. v. Wood*,²¹⁹ the U.S. Supreme Court refused to enforce the plaintiff’s mark in ATWOOD’S VEGETABLE PHYSICAL JAUNDICE BITTERS because the label misleadingly suggested that Moses Atwood — the creator of said bitters — was still manufacturing the product, when he had parted ways with the company.²²⁰ Similarly, in France during this time assignees of personal marks could not continue to use the autograph of the seller because such “[c]redit is altogether *personal*.”²²¹ Accordingly, purchasers had some relief against

²¹² *In re Brown*, 150 N.E. 581, 583 (N.Y. 1926).

²¹³ *Id.* (quoting *Rowell v. Rowell*, 99 N.W. 473, 479 (Wis. 1904)).

²¹⁴ *See, e.g.*, *Mut. Life Ins. Co. v. Menin*, 115 F.2d 975, 978 (2d Cir. 1940) (“[I]t has never been suggested that an individual bankrupt — or other owner involuntarily dispossessed — may not so compete in his own name, but must adopt another.”).

²¹⁵ *Id.*

²¹⁶ *Id.*

²¹⁷ *See, e.g.*, *Sawilowsky v. Brown*, 288 F. 533, 536 (5th Cir. 1923); *Ralph Bros. Furniture Co. v. Ralph*, 12 A.2d 573, 575 (Pa. 1940); *Cruttwell v. Lye* (1810) 34 Eng. Rep. 129, 134; 17 Ves. Jun. 335, 347.

²¹⁸ *See, e.g.*, *Leather Cloth Co. v. Am. Leather Cloth Co.* (1863) 46 Eng. Rep 868, 873; 4 De G. J. & S. 136, 148–49 (holding that a plaintiff could not enjoin defendant’s use of its marks because the plaintiff had unclean hands as a result of claiming, among other falsehoods, that its goods were still manufactured by the founders of the company).

²¹⁹ 108 U.S. 218 (1883).

²²⁰ *Id.* at 222–23 (describing this as a “fraud upon the public,” *id.* at 223); *see also* *Samuel v. Buger*, 13 How. Pr. 342, 343 (N.Y. Sup. Ct. 1856) (concluding that plaintiffs had no enforceable right over “Brindle” as stamped on a watch even though the use of Iberson Brindle’s name was assigned to them because Brindle, a watchmaker, was not in fact making those watches).

²²¹ BROWNE, *supra* note 124, § 210 (emphasis added); *see id.* §§ 209–210 (discussing French law and *Compère v. Bajou*, a French case reprinted in FRANCIS H. UPTON, A TREATISE ON THE LAW OF TRADE MARKS 72–79 (Albany, Weare C. Little 1860)). French law required “successor of” to be added if the founder of an eponymous business was no longer affiliated with it. *Id.* § 211.

sellers who continued to use their own identities after a sale, but it was limited by concerns about the competing personality interests of the sellers.

4. *Limits on Abandonment.* — Usually, abandonment of a mark occurs when a markholder ceases to use the claimed mark in commerce to sell products or services, either with an intent not to resume use or over several years (now three), leading to a presumption of an intent to abandon.²²² When a mark is deemed abandoned, all trademark rights are extinguished. But when a mark is “personal in its nature” such abandonment was considered impossible, at least while a person was alive.²²³ At any time, a person could resume providing services or goods, or start a new venture. Therefore, one cannot presume an intent not to resume use in the same way that one can in the context of an impersonal mark in which sales and operations cease. Accordingly, trademark law has long limited the ability to abandon one’s own name as a mark in ways substantially different from how abandonment of other marks is treated. Browne described abandonment in metaphysical terms as occurring when “the union of soul and body” is separated.²²⁴ Such a separation is possible only if a product or business named after a person becomes distinct from that person. Otherwise the mark continues to function as a source identifier for the person, at least during their lifetime.

*B. The Continued Existence of Personality-Based Concerns
in Trademark and Unfair Competition Law*

Despite pronouncements that the sacred-rights doctrine has been “abandon[ed],”²²⁵ trademark’s personality-oriented doctrines have remained surprisingly similar from the nineteenth century to today.

At least some Anglo-American treatise authors recognized and endorsed this line of French cases as being consistent with U.S. law at the time. *See id.* § 525.

²²² *See* 15 U.S.C. § 1127; RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 30 (AM. L. INST. 1995); 3 MCCARTHY, *supra* note 7, §§ 17:1, 17:9; Silverman v. CBS Inc., 870 F.2d 40, 45–48 (2d Cir. 1989); Corkran, Hill & Co. v. A.H. Kuhlemann Co., 111 A. 471, 474 (Md. 1920); Rockowitz Corset & Brassiere Corp. v. Madam X Co., 162 N.E. 76, 78 (N.Y. 1928); *see also* 3 MCCARTHY, *supra* note 7, § 17:6 (discussing that marks can also be abandoned through assignments in gross and naked licensing).

²²³ BROWNE, *supra* note 124, § 690; *see id.* §§ 676–677.

²²⁴ *Id.* § 676.

²²⁵ 2 MCCARTHY, *supra* note 7, § 13:8 (capitalization omitted); *see also* Basile, S.p.A. v. Basile, 899 F.2d 35, 39 (D.C. Cir. 1990) (claiming that “the truly personal element [of trademark law] has been so largely squeezed out of business, [that] there is naturally less legitimate pecuniary value in a family name,” and a “businessman loses nothing by losing [his] name” (first quoting Hat Corp. of Am. v. D.L. Davis Corp., 4 F. Supp. 613, 623 (D. Conn. 1933)); John R. Thompson Co. v. Holloway, 366 F.2d 108, 113 (5th Cir. 1966) (concluding that there is “no absolute right to use [one’s] own name, even honestly” and suggesting that there is no difference in the analysis even in personal name cases); Robin Woods, Inc. v. Woods, 815 F. Supp. 856, 870 (W.D. Pa. 1992) (dismissing continued

Prominent trademark treatise author J. Thomas McCarthy might be correct that “[c]ustomers who are faced with two or more businesses in related fields with the same surname mark are not particularly concerned with the ‘inalienable’ right of anyone to use his own name as a mark,”²²⁶ but nevertheless courts continue to recognize a person’s right to their own name and identity.²²⁷ This is not to say that there has not been some increasing dismissiveness of such concerns, or examples of increased tolerance of burdens on identity-holders that may not have been acceptable in prior years, but the doctrines of the last section largely remain in place and in forms quite similar to those of the past two centuries.²²⁸

We continue to see traces of the earlier era’s more explicit concern for a person’s autonomy and dignity. The Second Circuit in 2004, for example, favorably quoted a 1944 decision describing the injury to a person denied the right to use their name in business as “grievous.”²²⁹ The longstanding bars to registering a mark consisting of another’s name or signature without their permission remain codified in the Lanham Act’s subsections 2(a) and 2(c).²³⁰ Section 43(a) is routinely used to enforce false endorsement claims.²³¹ Collectively, these Lanham Act provisions are sometimes described as a federal form of a right of publicity.²³² Personal marks retain distinct treatment compared to other

existence of sacred-rights theory and concluding that “[t]oday, courts treat disputes involving personal name trademarks in much the same way as any other trademark dispute”), *rev’d in part on other grounds*, 28 F.3d 396 (3d Cir. 1994).

²²⁶ 2 MCCARTHY, *supra* note 7, § 13:12.

²²⁷ See, e.g., *Brennan’s, Inc. v. Brennan’s Rest., L.L.C.*, 360 F.3d 125, 131–34 (2d Cir. 2004); *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1288–89, 1298 (9th Cir. 1992) (observing the continued favoring and differential treatment afforded to defendants who use their own names); see also *Peaceable Planet, Inc. v. Ty, Inc.*, 362 F.3d 986, 989 (7th Cir. 2004) (noting the “valid” and ongoing “reluctance to forbid a person” from using their identity in commerce).

²²⁸ I identify the passage of the current operative trademark statute, the Lanham Act, in 1946 as the dividing line that separates modern trademark law from the earlier era of trademark law that I focused on in the prior section, but I could mark the dividing line as the year 2000 and reach the same conclusions.

²²⁹ *Brennan’s*, 360 F.3d at 131–32 (allowing the defendant to use his last name for his restaurant because “prevent[ing] all use of [a man’s personal name] is to take away his identity . . . and that is so grievous an injury that courts will avoid imposing it, if they possibly can” (second alteration in original) (quoting *Societe Vinicole de Champagne v. Mumm*, 143 F.2d 240, 241 (2d Cir. 1944) (per curiam))).

²³⁰ 15 U.S.C. § 1052(a), (c).

²³¹ *Id.* § 1125(a).

²³² See *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003) (noting the similarities between right of publicity and Lanham Act false endorsement claims, and the assessment by at least “one legal scholar . . . that a Lanham Act false endorsement claim is the federal equivalent of the right of publicity” (citing Bruce P. Keller, *The Right of Publicity: Past, Present, and Future*, in *ADVERTISING LAW IN THE NEW MEDIA AGE* 159, 170 (PLI Corp. L. & Prac., Course Handbook Ser. No. B-1207, 2000)); *In re Elster*, No. 87749230, at 10 (T.T.A.B. 2020) (recognizing that both section 2(a) and section 2(c) protect “the right of privacy and publicity” (quoting *In re ADCO Indus.-Techs., L.P.*, 2020 WL 730361, at *13 (T.T.A.B. Feb. 11, 2020)); see also Oral Argument, *In re Elster*,

types of marks when it comes to acquiring status as marks. In 2004, Judge Posner of the Seventh Circuit noted the ongoing validity of the differential treatment of personal name marks in this context, rooted in part on “a reluctance to forbid a person to use his own name in his own business.”²³³

The prohibition against assignments in gross continues to limit (but not bar) the transfer of marks to services or goods that are intimately tied to a particular individual. As McCarthy has noted, “a trademark cannot be sold or assigned to another unless the associated goodwill is also sold.”²³⁴ This poses a problem when the underlying products or services are rooted in a particular individual, and are inextricably intertwined with that person. McCarthy describes these as “unusual situations” in which “good will [is] linked to a single person.”²³⁵ Although these circumstances are purportedly “unusual,” there are reasons to be skeptical of this claim. Individuals are increasingly registering their names and likenesses as servicemarks or trademarks for merchandise centered on marketing their own brands;²³⁶ social media influencers, who can make a large amount of money simply by posting about various products, are also seeking to register their names and user handles;²³⁷ actors, singers, athletes, and models are registering their own names and likenesses for their services and brands;²³⁸ and individual

No. 20-2205 (Fed. Cir. Nov. 3, 2021), https://fedcircuitblog.com/wp-content/uploads/2021/10/20-2205_11032021.mp3 [<https://perma.cc/W34A-B6AX>]; Dreyfuss, *supra* note 15, at 125–26 (observing that section 43(a) of the Lanham Act essentially “federalize[s]” the protection of “personal images” in ways that track the right of publicity, *id.* at 126); McGeveran, *supra* note 16, at 347 (“Section 2 of the Lanham Act . . . import[s] privacy and autonomy considerations into trademark law.”); *cf.* U.S. COPYRIGHT OFF., AUTHORS, ATTRIBUTION, AND INTEGRITY 38–59 (2019), <https://www.copyright.gov/policy/moralrights/full-report.pdf> [<https://perma.cc/P2XN-QGDH>] (discussing both false endorsement and false designation claims as protective of moral rights).

²³³ *Peaceable Planet, Inc. v. Ty, Inc.*, 362 F.3d 986, 989 (7th Cir. 2004); *see id.* at 989–92 (concluding that the differential treatment for personal names did not apply to a toy camel’s name). Notably, Judge Posner, one of the main proponents of the law and economics model for trademark law, recognized the personality-related aspects of the law at work in such cases. Judge Posner also suggested other reasons that personal name marks were treated differently, including the recognition that consumers will not assume that the use of the same name, especially a common name, is indicative of the same source: “If there are two bars in a city that are named ‘Steve’s,’ people will not infer that they are owned by the same Steve.” *Id.* at 989. Judge Posner further pointed to the importance to consumers of knowing “useful information” about the source of goods or services, including any person associated with those goods or services. *Id.*

²³⁴ MCCARTHY, *supra* note 7, § 2:16.

²³⁵ *Id.* (capitalization omitted).

²³⁶ *See, e.g.*, KIM KARDASHIAN WEST, Registration No. 4,978,865 (for “endorsement services”); CARA DELEVINGNE, Registration No. 5,178,943 (for “entertainment services”); *see also* McGeveran, *supra* note 16, at 334–35, 344–47.

²³⁷ *See generally* Bajracharya & Wilson, *supra* note 16; Khamis et al., *supra* note 34.

²³⁸ *See, e.g.*, JUSTIN BIEBER, Registration No. 4,516,933; MICHAEL PHELPS, Registration No. 3,828,950; MERYL STREEP, Registration No. 5,559,993; Design mark consisting of a photograph of model Doutzen Kroes registered for modeling services and clothing, Registration No.

proprietorships and partnerships continue to outnumber corporations.²³⁹ Such personal marks with limited assignability will more frequently arise in the context of the very identity thicket I identified in Part I.

Limits on the transfer of professional and personal goodwill also remain, particularly in the context of personal services.²⁴⁰ Broad assignments and transfers remain more restricted in the context of personal marks than otherwise. When a business's reputation depends on the "qualifications and skills uniquely linked to one person or a group of persons," it is not possible for the goodwill of the business to transfer.²⁴¹ The justifications for such a doctrine remain the same as always — one cannot separate the person from the business in such instances, and doing so would work a personality-based harm on the underlying person, as well as a fraud on the public.²⁴² The professional goodwill of lawyers, accountants, musicians, physicians, and similarly situated individuals continues to be recognized as personal and therefore has more limited transferability.²⁴³

Even today, when a person transfers an eponymously named company or marks comprised of their name or other indicia of their identity, courts often allow those individuals to use their own names in new ventures so long as they are not employing a similar mark to the one they sold.²⁴⁴ Contracts can explicitly limit what a seller can do after the

5,854,065; Design mark consisting of a photograph of model Maartje Verhoef registered for entertainment services, Registration No. 5,097,855; *see also* KL KATIE LEDECKY, U.S. Trademark Application Serial No. 88,616,036 (filed Sept. 13, 2019) (intent-to-use application for design and word mark for athletic apparel filed on behalf of Olympic swimmer Katie Ledecky); David Fagundes, *Talk Derby to Me: Intellectual Property Norms Governing Roller Derby Pseudonyms*, 90 TEX. L. REV. 1093, 1114 (2012).

²³⁹ *See* Blair, *supra* note 102, at 441.

²⁴⁰ There remains a difference of opinion under different states' laws about whether successor firms can "continue to use a retired or deceased partner's name." *Gracey v. Maddin*, 769 S.W.2d 497, 500 (Tenn. Ct. App. 1989). *Compare id.* at 500–01, *with id.* at 501, 503–05 (Koch, J., dissenting) (noting majority's conflict with other states on treatment of law partnerships).

²⁴¹ MCCARTHY, *supra* note 7, § 2:16.

²⁴² *See id.*; 3 *id.* § 18:35; *cf.* *Peaceable Planet, Inc. v. Ty, Inc.*, 362 F.3d 986, 989 (7th Cir. 2004).

²⁴³ *See Gracey*, 769 S.W.2d at 499; *Jackson v. Caldwell*, 415 P.2d 667, 670 (Utah 1966); *see also* MCCARTHY, *supra* note 7, § 2:16; 3 *id.* § 18:35; 74 AM. JUR. 2D *Trademarks and Tradenames* § 17 (2021).

²⁴⁴ *See, e.g., Madrigal Audio Laboratories, Inc. v. Cello, Ltd.*, 799 F.2d 814, 816, 822–23 (2d Cir. 1986) (allowing audio-equipment designer Mark Levinson to use his name in a competing company even after the sale of his business and its marks that used his name, including LEVINSON and MARK LEVINSON AUDIO SYSTEMS); *JA Apparel Corp. v. Abboud*, 682 F. Supp. 2d 294, 313–16 (S.D.N.Y. 2010) (allowing fashion designer, who sold his eponymous company and its associated marks, to continue to use his name and likeness to market his new venture as long as he did not use his name as a mark or in ways that were "overly intrusive" or "utterly confusing," *id.* at 315 (first quoting *Madrigal Audio Laboratories*, 799 F.2d at 823)); *Dutcher v. Harker*, 377 S.W.2d 140, 144–45 (Mo. Ct. App. 1964) (allowing some continued use of seller's name as part of a mark in a competing paint business even though he sold his business and marks composed in part of his surname).

fact — in terms of using their name and competing in the same industry (subject to a variety of limits under contract, employment, and labor law) — but the mere transfer of a business and its marks does not usually upend the longstanding presumption that a seller can continue to use their name in commerce even after the sale of an eponymous business.²⁴⁵ Thus, latitude remains pursuant to trademark and unfair competition laws for sellers of businesses to continue to use their names and identities in new businesses, even ones that directly compete with the company that was sold.

Successor companies continue to be limited in how they can use the seller's name and identity in marketing the company. The Second Circuit has suggested that a successor company cannot “represent[] itself as possessing [the seller's] personal skill,” even if it now owns that person's company and the marks comprised of the person's name.²⁴⁶ Purchasers have the right to use a person's name in the context of a particular business as a source identifier, but cannot use a “personal name as a symbol of [the seller's] individual reputation.”²⁴⁷

The right to use one's own name in commerce also continues to put a thumb on the scale of allowing potentially confusing uses when a person has acted in good faith and used their own name and identity.²⁴⁸ This remains true even in the context of uses in the aftermath of a sale.²⁴⁹ These cases demonstrate not only the continued limit on

²⁴⁵ See, e.g., *JA Apparel*, 682 F. Supp. 2d at 312–16; see also 2 MCCARTHY, *supra* note 7, § 13:10 (observing latitude to use one's own name after a sale of a business and related marks absent contractual limits on such uses).

²⁴⁶ *Madriral Audio Laboratories*, 799 F.2d at 825 n.5.

²⁴⁷ *Id.* at 825; see also *JA Apparel*, 682 F. Supp. 2d at 305–08 (highlighting the distinction between the “Joseph Abboud trademarks” and the personal name “Joseph Abboud” to support the conclusion that Abboud's rights over his own name and likeness did not transfer to the purchaser).

²⁴⁸ See, e.g., *Keaton & Keaton v. Keaton*, 842 N.E.2d 816, 818–19, 821 (Ind. 2006) (allowing two law firms to operate under the name Keaton & Keaton, noting that even though “[m]odern authority” limited the common law view that “every person had an absolute right to use his own name,” the “burden” to establish an infringement claim was “higher” in such instances, *id.* at 821); *Charles F. Ryan & Son, Inc. v. Lancaster Homes, Inc.*, 205 N.E.2d 859, 859 (N.Y. 1965) (refusing to enjoin defendant's use of own name in spite of evidence of some consumer confusion), *aff'g* 254 N.Y.S.2d 473 (App. Div. 1964).

²⁴⁹ See, e.g., *Haltom v. Haltom's Jewelers, Inc.*, 691 S.W.2d 823, 826 (Tex. Ct. App. 1985) (suggesting that any risk of confusion should be borne by the purchaser who chose to buy a company named after a person). The court in *Haltom v. Haltom's Jewelers, Inc.*, 691 S.W.2d 823, explained:

Likelihood of consumer confusion may be the touchstone of the law of trademarks and unfair competition generally, but not where personal names are involved. If a person enters into business using his personal name, or if he buys a business founded on a personal name, he accepts the risk that others with the same name may follow suit, and the “likelihood of confusion” argument will not protect him. For this reason, the law encourages entrep[re]neurs to select unique nonpersonal tradenames in which no person is likely to have natural rights.

Id. at 826.

retaining “the essential thing . . . sold,”²⁵⁰ but also the continued latitude of sellers to nevertheless use their own names and identities in new ventures.

Not only do courts continue to tolerate more confusion in cases involving the use of a defendant’s own identity, but they are also less likely to find such confusion, presuming instead that the use of a defendant’s own name is evidence of acting in good faith.²⁵¹ Such a determination is a major factor in evaluating the likelihood of confusion.²⁵² Additionally, the same limited injunctive relief that was afforded in personal name cases in the nineteenth and early twentieth centuries remains common today in such contexts.²⁵³

In light of the continued differential treatment of personal marks and names, it is hard to see why some think these doctrines are dead. Perhaps some overlook the nuance that the so-called “sacred right” was never “absolute,” and point to cases decided against defendants for using their own names as evidence that the doctrine is moribund.²⁵⁴ But the cases that suggest that personality-based concerns are dead or obsolete

²⁵⁰ *Guth v. Guth Chocolate Co.*, 224 F. 932, 934 (4th Cir. 1915). *Guth* is routinely cited today for this same proposition. See, e.g., *Dovenmuehle v. Gilldorn Mortg. Midwest Corp.*, 871 F.2d 697, 700–01 (7th Cir. 1989); *Madrigal Audio Laboratories*, 799 F.2d at 824; *JL Powell Clothing LLC v. Powell*, No. 13-CV-00160, 2014 WL 347249, at *13 (D. Me. Jan. 30, 2014); *JBCHoldings NY, LLC v. Parker*, 931 F. Supp. 2d 514, 528 n.11 (S.D.N.Y. 2013); *Williams v. Spelic*, 844 S.W.2d 305, 309 (Ark. 1992).

²⁵¹ See, e.g., *Brennan’s, Inc. v. Brennan’s Rest., L.L.C.*, 360 F.3d 125, 131–35 (2d Cir. 2004) (allowing the defendant to use his last name for his restaurant because he acted in good faith and the use of a common surname was not likely to generate confusion); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 U.S.P.Q.2d 1321, 1327–28, 1334 (T.T.A.B. 1992) (concluding that confusion was unlikely given the use of the defendant’s name and her good faith efforts to indicate herself rather than the plaintiff’s company).

²⁵² See Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1582, 1628 (2006).

²⁵³ See, e.g., *LFP IP, LLC v. Hustler Cincinnati, Inc.*, 810 F.3d 424, 425, 428 (6th Cir. 2016) (affirming modified injunction that allowed the defendant to continue to use his full name “Jimmy Flynt” in the adult entertainment market even though he could not use his last name alone because of his brother’s senior and famous mark in that category); *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1288–89, 1298 (9th Cir. 1992) (affirming injunction against brother using the famous winery’s GALLO mark in his cheese business when he was held to have intentionally tried to confuse consumers, *id.* at 1293, but allowing him to continue to use JOSEPH GALLO as a mark for wholesale packages of cheese and to use “Gallo Cattle Co.” and “Joseph Gallo Farms” as trade names, as well as to use these names and his own signature and identity in advertising, because of “the judicial reluctance to enjoin use of a personal name,” *id.* at 1289); see also *Taylor Wine Co. v. Bully Hill Vineyards, Inc.*, 569 F.2d 731, 734–36 (2d Cir. 1978) (remanding for narrowing of injunction so that defendant could use his own name on competing wine).

²⁵⁴ See, e.g., *JA Apparel Corp. v. Abboud*, 682 F. Supp. 2d 294, 311–12 (S.D.N.Y. 2010) (suggesting that the “historical[]” view of an “‘absolute right’ to use [one’s] own name in his own business” has given way to “[t]he more modern view” that this “sacred right” is not “unlimited,” *id.* at 311–12 (quoting *Meneely v. Meneely*, 62 N.Y. 427, 427 (1875); *David B. Findlay, Inc. v. Findlay*, 218 N.E.2d 531, 534 (N.Y. 1966))).

are primarily ones in which a defendant acted in bad faith.²⁵⁵ These cases would have come out the same way in the nineteenth century or early twentieth century.²⁵⁶ Another possible explanation for this dismissive view is a claim that personality-based interests became obsolete when the economy and dominant business structure shifted.²⁵⁷ However, these changes (mass production and the dominance of the corporate structure) were already well on their way during the time at which the sacred-rights theory was widely recognized,²⁵⁸ and did not alter the use (or treatment) of marks rooted in particular individuals. These developments affected the frequency of personality-based claims, but did not engender a substantive shift in the law.

In sum, a personality theory of trademarks remains relevant — and is of increasing importance as we see a rise in the use of personal marks and selfmarks, and their conflict with other rights held by identity-holders, including the right of publicity.

IV. WHAT TRADEMARK'S PERSONALITY MEANS FOR TRADEMARK LAW

One could observe the influence of personality objectives in trademark law, and nevertheless conclude that they should be jettisoned. I think this would be a mistake. Rather than chipping away at or dismantling the personality-oriented doctrines and objectives described in the last Part, there are good reasons to embrace and even shore up the protection of personality interests when marks originate with a person's identity or when violations stem from unauthorized uses of a person's identity. Marks rooted in a person's identity constitute what Professor Margaret Jane Radin has termed "property for personhood."²⁵⁹ Such marks are "bound up with personhood" and should not be treated the

²⁵⁵ See, e.g., *John Allan Co. v. Craig Allen Co.*, 540 F.3d 1133, 1140 (10th Cir. 2008); *E. & J. Gallo Winery*, 967 F.2d at 1288; *Mayo Clinic v. Mayo's Drug & Cosm., Inc.*, 113 N.W.2d 852, 856 (Minn. 1962); *Madison v. La Sene*, 268 P.2d 1006, 1011 (Wash. 1954); *Foglesong v. Foglesong Funeral Home, Inc.*, 141 S.E.2d 390, 392–93 (W. Va. 1965).

²⁵⁶ See *Taylor Wine*, 569 F.2d at 734–35 (providing a survey of the case law and noting that the differential treatment of the nineteenth century has largely persisted to today); see also *supra* notes 146–152, 203–209 and accompanying text.

²⁵⁷ See *Basile, S.p.A. v. Basile*, 890 F.2d 35, 39–40 (D.C. Cir. 1990) (suggesting that personality-based considerations are no longer relevant given the shift from "a world of primarily local trade" to one in which "goodwill" no longer rests on an "individual[s] reputation within the community," *id.* at 39); 1 HARRY D. NIMS, *THE LAW OF UNFAIR COMPETITION AND TRADE-MARKS* § 68 (4th ed. 1947) (suggesting that the changing nature of commerce supports moving away from the differential treatment of personal names (quoting *Hat Corp. of Am. v. D.L. Davis Corp.*, 4 F. Supp. 613, 623 (D. Conn. 1933))).

²⁵⁸ See generally Blair, *supra* note 102; David McBride, *General Corporation Laws: History and Economics*, 74 *LAW & CONTEMP. PROBS.* 1, 2–5 (2011).

²⁵⁹ Radin, *supra* note 3, at 957, 959–60; see *id.* at 957.

same as other types of property.²⁶⁰ Allowing a third party to own marks in another person's name or other aspect of their identity can obstruct a person's ability to work, speak, and appear in public, and markholders can use personal marks to compel (even if only virtually) an identity-holder's speech and associations.²⁶¹ Such realities cause market-based *and* personality-based injuries that deserve legal attention.

Even those who are skeptical of both publicity and personality rights have at least a pragmatic reason to support trademark's personality-based objectives. In the absence of trademark law affirmatively addressing these concerns, the right of publicity will fill in this vacuum, and likely in a way that is unduly disruptive of trademark rights and wildly varying and unpredictable across different states and courts. Not only is this outcome bad for those who care about personality rights — as I do — but it also is bad for businesses and consumers, and disruptive even under a purely market-centered vision of trademark law.

Recognizing trademark's personality-oriented objectives informs how we should navigate through the identity thicket described in Part I, a topic to which I will return in Part V. Before doing so, however, it is necessary to understand what it means for trademark law if we take its personality-oriented objectives more seriously. Such a theory of trademark law does not provide a global theory. It should be limited to instances in which personal marks or a person's identity are at issue. It also will not operate in isolation from trademark's other objectives; instead, it is an additional consideration in disputes that involve a person's identity.

If we take seriously trademark and unfair competition law's concerns for personal autonomy and dignity, then a number of implications follow: First, there should be limits on the alienability of personal marks; second, people should be able to use their own identity despite some potential for consumer confusion; and third, such an understanding of trademark law provides a potential avenue for limiting some of trademark law's expansionary impulses by cabining this broader vision of trademark entitlements to instances in which a natural person's autonomy and dignity are actually at stake. This means that corporations will not usually be able to assert personality-based interests, unless those corporations are truly stand-ins for an actual person whose personality and identity are at issue.²⁶²

²⁶⁰ *Id.* at 959.

²⁶¹ *Cf.* Rothman, *supra* note 2, at 210–12.

²⁶² See generally Margaret M. Blair, *Corporations and Expressive Rights: How the Lines Should Be Drawn*, 65 DEPAUL L. REV. 253 (2016) (developing a taxonomy of different types of corporations and when they should or should not be granted expressive rights pursuant to the First Amendment).

A. *Limits on Alienability: De Jure Versus De Facto Personal Marks*

As discussed in sections III.A.3 and III.B, while trademarks are generally understood to be capable of transferring along with the underlying goodwill of a business (or product line), trademark law limits some transfers of personal marks, especially marks rooted in professional or personal goodwill. Such limits further the autonomy and dignity interests of identity-holders, as well as support other trademark objectives, particularly protecting consumers from being duped about who stands behind various products and services.

In prior work, I have challenged the claimed alienability of the right of publicity, concluding that even if understood as a property right, it should not be transferable away from the identity-holder upon whom the rights are based.²⁶³ Many of the reasons to limit the transfer of a person's right of publicity also apply in the context of personal marks that are closely tied to a living identity-holder. In order for property to transfer, it must be separable from the underlying person upon whom the rights are based. I have previously denominated this criteria for alienability *separability*.²⁶⁴ In the context of the right of publicity, a person's identity is an inseparable "attribute" of that person rather than an external "object" that conceivably could be transferred.²⁶⁵ Although some personal marks may be separable from the underlying person — in contrast to a person's broader right over their entire identity — others will not be.²⁶⁶

²⁶³ Rothman, *supra* note 2, *passim*. This view also shares some similarities with the basis for limits on alienability of some authors' rights, particularly those found in continental European copyright law. See Russell J. DaSilva, *Droit Moral and the Amoral Copyright: A Comparison of Artists' Rights in France and the United States*, 28 BULL. COPYRIGHT SOC'Y U.S.A. 1, 12–14 (1980); Dominique Giocanti, *Moral Rights: Authors' Protection and Business Needs*, 10 J. INT'L L. & ECON. 627, 628–31 (1975); Neil Netanel, *Alienability Restrictions and the Enhancement of Author Autonomy in United States and Continental Copyright Law*, 12 CARDOZO ARTS & ENT. L.J. 1, 2 (1994).

²⁶⁴ Rothman, *supra* note 2, at 225.

²⁶⁵ *Id.* at 225–26 (agreeing with Radin's view in *Reinterpreting Property* that "substantive constitutive elements of personality' are not alienable but instead are 'attribute-properties (permanently inside the person),'" *id.* at 226 n.191 (quoting MARGARET JANE RADIN, REINTERPRETING PROPERTY 191–96 (1993))); see Margaret Jane Radin, *Market-Inalienability*, 100 HARV. L. REV. 1849, 1852, 1880–81, 1891–98 (1987) (suggesting that alienability should be limited when objects are tightly bound with our personality); see also Radin, *supra* note 3, at 957, 974 n.59, 986 n.101, 988 n.108 (contending that alienability should be limited when property is intimately tied with personhood).

²⁶⁶ Cf. Seana Valentine Shiffrin, *Lockean Arguments for Private Intellectual Property*, in NEW ESSAYS IN THE LEGAL AND POLITICAL THEORY OF PROPERTY 138, 165–66 (Stephen R. Munzer ed., 2001) (observing that "the Lockean right of self-ownership" weakens when "a person has deliberately separated from his or her products," *id.* at 165).

Marks should not be transferable when they “carr[y] the idea of a man’s personality”²⁶⁷ and are inseparable from that person.²⁶⁸ When a personal mark indicates to the public that services or goods are provided by or made by a particular person, then no separation is possible. In such instances, the person and the mark merge. I designate such marks *de jure* personal marks; such marks should be incapable of separation from the underlying identity-holder, and hence should not be transferred away from them. In contrast, if the public merely associates a mark with a founder or person who used to be connected with a business, such marks are separable and transferable. I designate these as *de facto* personal marks. Even though such marks may originate with a natural person’s name or other indicia of identity, they should not be personal as a matter of law. The distinction turns on whether the personal mark continues to serve as an identifier of the person in conjunction with the business, particularly services, or if instead it has taken on what the Supreme Court has called a “double significance,” where a mark indicates both a person and a separate product or business that is distinct from that person.²⁶⁹ Using separability as the fulcrum upon which transferability turns fits with the longstanding view that personal and professional goodwill cannot transfer when they are inseparable from the person upon whom the goodwill is based.

Not all marks designated *de jure* personal will remain in that category forever; some are capable of shifting over time into the *de facto* category.²⁷⁰ For example, even if the Ford Motor Company, founded by the inventor, Henry Ford, might initially have been *de jure* personal in nature, inextricably linked to Ford’s services as an inventor and his oversight and management, over time the company came to be understood as a separate entity from him. Accordingly, even if it continued to have some associations with him and his persona, it became a mark and business that could transfer away from him (and his heirs).

A number of other considerations, both distinct from separability and also intertwined with it, suggest there should be limits on transferring personal marks.²⁷¹ Losing control over personal marks,

²⁶⁷ BROWNE, *supra* note 12, § 90.

²⁶⁸ Cf. Rothman, *supra* note 2, at 225–28.

²⁶⁹ Thaddeus Davids Co. v. Davids Mfg. Co., 233 U.S. 461, 470 (1914); *see id.* at 470–71.

²⁷⁰ *See In re Brown*, 150 N.E. 581, 583 (N.Y. 1926); *Hall v. Barrows* (1863) 46 Eng. Rep. 873, 875; 4 De G. J. & S. 150, 155 (“[I]t must be borne in mind that a name, though originally the name of the first maker, may in time become a mere trade mark or sign of quality, and cease to denote or to be current as indicating that any particular person is the maker. In many cases a name once affixed to a manufactured article continues to be used for generations after the death of the individual who first affixed it. In such cases the name is accepted in the market either as a brand of quality, or it becomes the denomination of the commodity itself, and is no longer a representation that the article is the manufacture of any particular person.”).

²⁷¹ The concerns over commodification and forced commercialization that arise in the context of transferring a person’s right of publicity have little to no salience in the context of personal marks,

particularly ones that are inseparable from the underlying identity-holder, can work fundamental injuries to a person's autonomy and dignity. This danger justifies the longstanding limits on the transferability of personal marks. Allowing for the alienation of personal marks in some instances "deprive[s]" a person of their own "individuality."²⁷² It can also subject them to public "humiliation and embarrassment."²⁷³ In such contexts, transferability works at cross purposes with the autonomy and dignity interests that in part justify extending protection to personal marks in the first place.²⁷⁴ Allowing someone other than the identity-holder to own de jure personal marks jeopardizes fundamental rights of identity-holders, particularly their rights to free speech and liberty. Third-party markholders could restrict the identity-holder's activities and communications, as well as compel appearances and speech. Such burdens weigh against the alienability of personal marks.²⁷⁵

It is worth returning in a bit more detail to the recent lawsuit mentioned in Part I involving a designer of bridal dresses. The defendant, Hayley Paige Gutman, allegedly without legal representation and while only twenty-five years old, signed an employment contract that gave JLM Couture (JLM) "the exclusive world-wide right and license to use her name" and "any derivative thereof . . . in connection with the design, manufacture, marketing and/or sale of bridal clothing, bridal accessories

which arise when a person has actively chosen to commercialize an aspect of their identity for use as a mark in commerce. Cf. Rothman, *supra* note 2, at 217–20 (discussing commodification and forced commercialization concerns in the context of the potential alienability of the right of publicity).

²⁷² BROWNE, *supra* note 12, § 95 (quoting *Howard v. Henriques*, 3 Sand. 725, 727 (N.Y. Super. Ct. 1851)); see also JESSICA SILBEY, *THE EUREKA MYTH* 163–64 (2015) (describing creators' personal investment and "reputational" concerns tied up with their names (and marks) and the "[p]erceived harm to identity" when they are used without permission, *id.* at 163); cf. Post & Rothman, *supra* note 4, at 116–25; Rothman, *supra* note 2, at 209–17.

²⁷³ *Tomsky v. Clark*, 238 P. 950, 952 (Cal. Dist. Ct. App. 1925).

²⁷⁴ Cf. Richard A. Epstein, *Why Restrain Alienation?*, 85 COLUM. L. REV. 970, 971 (1985); Rothman, *supra* note 2, at 228–32 (explaining how alienability undermines the basis for affording publicity rights in the first place).

²⁷⁵ Cf. JOHN STUART MILL, *ON LIBERTY* 101 (Elizabeth Rapaport ed., 1978) (1859) (warning that "[i]t is not freedom to be allowed to alienate [one's] freedom"); Guido Calabresi & A. Douglas Melamed, *Property Rules, Liability Rules, and Inalienability: One View of the Cathedral*, 85 HARV. L. REV. 1089, 1112–13 (1972) (advocating that fundamental rights not be alienable to protect ourselves from making bad decisions, like selling ourselves into slavery or abandoning our First Amendment rights); Radin, *supra* note 265, at 1899–903 (contending that limits on alienability can be "freedom-enhancing," and in some instances are essential to promote "self-development," *id.* at 1899, and "foster personhood," *id.* at 1903); Susan Rose-Ackerman, *Inalienability and the Theory of Property Rights*, 85 COLUM. L. REV. 931, 961–68 (1985) (considering circumstances in which alienability is restricted to promote citizenship); Laurence H. Tribe, *Commentary, The Abortion Funding Conundrum: Inalienable Rights, Affirmative Duties, and the Dilemma of Dependence*, 99 HARV. L. REV. 330, 333 (1985) ("[A]t the most general level, rights that are relational and systemic are necessarily inalienable: individuals cannot waive them because individuals are not their sole focus."); cf. also Rothman, *supra* note 2, at 209–17 (discussing these sources and the burden on fundamental rights as a basis for limiting the transferability of publicity rights).

and related bridal and wedding items.”²⁷⁶ While this assignment was to terminate two years after her employment, the contract provided in another clause that if any uses of her name or its derivatives were registered as trademarks, then they would be “the exclusive property” of JLM and owned “in perpetuity.”²⁷⁷ JLM did register a variety of marks that incorporated Gutman’s name, including HAYLEY PAIGE.²⁷⁸ JLM used its status as markholder (as well as a noncompete provision²⁷⁹) to obtain an injunction against Gutman that bars her from using her name in the fashion industry even when not used as a trademark (unless she obtains permission from JLM), and requires her to turn over several of her social media accounts to JLM, including her Instagram account (@misshayleypaige).²⁸⁰ The court even enjoined Gutman from showing herself sketching dresses on her social media feeds.²⁸¹ These restrictions raise significant First Amendment concerns, even though the district court rejected such a defense.²⁸² The broad injunction issued against Gutman demonstrates the severe restrictions on an identity-holder that could flow from allowing a third party to hold personal marks of a living identity-holder. JLM is able to compel Gutman’s speech and appearances by using her name, likeness, and social media feeds as if she is “speaking.” Putting aside possible constitutional restrictions on such injunctions, trademark law itself should limit such burdens on identity-holders. Trademark’s consumer-protection goals align here with Gutman’s interests as the public is likely to be deceived by JLM’s continuing to run the line of bridal dresses under the moniker of Hayley Paige, as if she were still designing them. Also likely to deceive the public is JLM’s posting on social media accounts as if the posts were from the real “Hayley Paige.”

The burdens on a person’s liberty will be particularly severe if the claimed mark consists of a person’s likeness.²⁸³ One can change one’s

²⁷⁶ *JLM Couture, Inc. v. Gutman*, No. 20-CV-10575, 2021 WL 827749, at *2 (S.D.N.Y. Mar. 4, 2021) (quoting the employment contract), *aff’d in part, vacated in part*, No. 21-870, 2022 WL 211017 (2d Cir. Jan. 25, 2022); see Defendant Counterclaim-Plaintiff Hayley Paige Gutman’s Answer, *supra* note 66, ¶ 18.

²⁷⁷ *JLM Couture*, 2021 WL 827749, at *3.

²⁷⁸ *Id.* at *2.

²⁷⁹ *Id.* at *14–15.

²⁸⁰ *Id.* at *23–24.

²⁸¹ *JLM Couture, Inc. v. Gutman*, No. 20-CV-10575, 2021 WL 4084573, at *5, *9 (S.D.N.Y. Sept. 8, 2021) (holding Gutman in contempt for violating the preliminary injunction by posting a video of herself on Instagram announcing that she will be able to work again in 2022, posting a video of herself sketching designs of new gowns, and telling *Business Insider* in an interview that she planned to re-enter the fashion industry with her own brand once her noncompete expired). This aspect of the case still has an appeal pending. See Notice of Appeal, *supra* note 56; see also *JLM Couture*, 2022 WL 211017, at *1 (affirming injunction limiting Gutman’s use of her name).

²⁸² See *JLM Couture*, 2021 WL 4084573, at *6.

²⁸³ See David Lefranc, *Commercial Exploitation of the Human Persona in European and French Law: Who Needs Trademarks when You Have Personality Rights?*, in *THE CAMBRIDGE*

name, operate under a nickname, or choose a different term as one's mark for one's business or products, but absent significant plastic surgery, changing one's likeness is usually not an option nor easily achieved. In addition, once transferred, marks rooted in a person's identity could be transferred many times over, including in the aftermath of a bankruptcy, to parties far removed from the original buyer or assignee. These conveyances could make the holder of a personal mark an entity or person that the identity-holder has no relationship with or even knowledge of.²⁸⁴

Limiting the alienability of some personal marks not only protects fundamental rights, but also can promote efficiency in the marketplace.²⁸⁵ When personal marks merge with the underlying person, mark-holders and identity-holders could act in conflicting ways that undermine the commercial value of the marks, any related businesses, and the identity-holder.²⁸⁶ Allowing separability in such instances undermines the information function of trademarks.²⁸⁷ Consumers' information

HANDBOOK OF INTERNATIONAL AND COMPARATIVE TRADEMARK LAW, *supra* note 33, at 365, 375–80.

²⁸⁴ See PAUL FRANK, Registration No. 3,726,765 (recording a series of assignments and credit obligations, including to Sunwest Bank); see also *Paul Frank Indus., Inc. v. Sunich*, 502 F. Supp. 2d 1094, 1096–97 (C.D. Cal. 2007).

²⁸⁵ Cf. Rothman, *supra* note 2, at 220–24 (noting that limits on the alienability of publicity rights might improve market efficiency by incentivizing identity-holders to maintain the value of their identities, facilitating coordination, and preventing significant valuation problems). Several scholars have contended that restraints on alienability are appropriate when they promote market efficiency. See Epstein, *supra* note 274, at 973–88; Lee Anne Fennell, *Adjusting Alienability*, 122 HARV. L. REV. 1403 *passim* (2009) (arguing that limits on alienability could address “resource dilemmas” and “sidestep” holdout problems, *id.* at 1404); Clifford G. Holderness, *Joint Ownership and Alienability*, 23 INT’L REV. L. & ECON. 75, 93–97 (2003) (considering the role of “separation of ownership from management” as one of the relevant considerations for alienating jointly owned property and highlighting the coordination problems that obstruct alienability in the absence of such separability); Rose-Ackerman, *supra* note 275, at 932–33, 937–40.

²⁸⁶ See Lefranc, *supra* note 283, at 375–76 (noting the problems that arise when a real person whose identity is used in a corporate trademark separates from the underlying business and then works at cross purposes with that business); see also *Ky. Fried Chicken of Bowling Green, Inc. v. Sanders*, 563 S.W.2d 8, 8–9 (Ky. 1978) (involving a defamation lawsuit brought against the former owner of a business whose likeness and identity were parts of marks promoted and owned by successor company when he began publicly criticizing the company and its decline in quality since the sale — including its new gravy formula, which he likened to “wallpaper paste,” *id.* at 8); Dan L. Burk & Brett H. McDonnell, *Trademarks and the Boundaries of the Firm*, 51 WM. & MARY L. REV. 345, 365–75 (2009) (describing the challenges when personal and business reputation are intertwined in the context of companies that use personal name marks, and suggesting the legitimacy of some limits on alienability of such marks in light of this); cf. Christopher R. Knittel & Victor Stango, *Celebrity Endorsements, Firm Value, and Reputation Risk: Evidence from the Tiger Woods Scandal* 60 MGMT. SCI. 21, 34 (2014) (“[T]he market value of Tiger Woods’ sponsors fell substantively after [his] scandal broke, relative to the market values of firms without such endorsement deals.”).

²⁸⁷ See Landes & Posner, *supra* note 11, at 285 (noting that allowing assignments of trademarks in gross violates the “information” function of trademarks that supports their protection in the first place).

costs will rise as they sort through conflicting (and potentially confusing) signifiers rooted in the same person. The separation of a personal mark from the identity-holder may mislead consumers about the source of services and goods, as well as their nature and characteristics. Allowing others to use another's personal mark can also significantly interfere with that person's future ability to work, earn a living, and meaningfully contribute to society.²⁸⁸ The identity-holder's professional (and personal) reputation can be impaired by successors, who might produce low-quality products or services or shift the brand's narrative in ways that reflect negatively on the identity-holder. In some instances, the disconnect between the personal mark and the identity-holder may be so great that the transfer should be invalidated as an assignment in gross.

Even if a person and their brand are separable, there may be strong market-based reasons to keep personal marks integrated with identity-holders. The experience of Martha Stewart's eponymous company, Martha Stewart Living, is instructive. After Stewart's insider-trading scandal and prison sentence, the company sought to distance itself from her.²⁸⁹ But the company soon discovered that her continued involvement and connection with the brand was essential to its value and success, and accordingly returned to rooting itself in her as an individual rather than trying to distinguish itself as an independent entity.²⁹⁰ The enhanced value of uniting the person with the business might have been true for Abboud and his fashion company as well since he ultimately was reunited with JA Apparel, the very company to which he had sold his eponymous business and with which he had been involved in litigation over the use of his name and identity.²⁹¹ Personal marks have significant consumer appeal, and may be most valuable when they are merged, rather than divorced, from the identity-holder.

²⁸⁸ Cf. Orly Lobel, *Noncompetes, Human Capital Policy & Regional Competition*, 45 J. CORP. L. 931, 935–42 (2020) (surveying an array of reasons to disfavor noncompetes ranging from concerns over equality, to depressed wages, to reduced productivity and motivation); MARK LEMLEY & ORLY LOBEL, DAY ONE PROJECT, SUPPORTING TALENT MOBILITY AND ENHANCING HUMAN CAPITAL 2–4 (2021), <https://law.stanford.edu/wp-content/uploads/2021/01/Supporting-Talent-Mobility-and-Enhancing-Human-Capital-Banning-Noncompete-Agreements-to-Create-Competitive-Job-Markets-Jan2021.pdf> [<https://perma.cc/C8A7-7R59>] (discussing the inefficiency of covenants not to compete).

²⁸⁹ Susan Fournier & Giana M. Eckhardt, *Putting the Person Back in Person-Brands: Understanding and Managing the Two-Bodied Brand*, 56 J. MKTG. RSCH. 602, 606–07, 610 (2019).

²⁹⁰ *Id.* at 609; *see id.* at 604–11 (describing Martha Stewart's inextricable connection with Martha Stewart Living).

²⁹¹ *See* Karlee Weinmann, *Willkie Farr Pilots Men's Wearhouse's \$98M Designer Line Buy*, LAW360 (July 18, 2013, 2:14 PM), <https://www.law360.com/articles/458228/willkie-farr-pilots-mens-wearhouse-s-98m-designer-line-buy> [<https://perma.cc/T3J7-NZRQ>] (reporting the announcement that Men's Wearhouse was "thrilled to reunite Joseph with his iconic brand"); cases cited *supra* notes 37–48 and accompanying text (discussing litigation history); *see also* *Thinking About Naming Your Brand*, *supra* note 57 (noting the example of Roland Mouret, who lost the use of his name as a mark for a period of time, struggled with alternatives, and ultimately was able to reacquire it).

Personality-based limits on alienability should usually cease at the time of death. Some personal marks may not function as marks after a person dies if they are closely tied to that person. Such a death may lead to the abandonment of a mark if the underlying services (or, less frequently, unique goods) can no longer be provided. But, in other instances, personal marks might transform postmortem into distinct corporate brands.

B. Personality-Driven Negative Spaces

A theory of trademark law that includes consideration of personality interests not only justifies the right to exclude others from using one's identity, but also provides a basis to *limit* trademark rights when they intersect with personality rights. If a person cannot use their own identity, a "grievous . . . injury" to a person's autonomy and dignity follows, which should continue to be "intolerable," even if it is perceived today as less "pervers[e]" and "monstrous" than it once was.²⁹² Such a violation of personality interests supports a carve-out from trademark enforcement when a defendant's violation stems from the defendant's good faith use of their own identity.

Even when consumers are potentially (or even likely to be) confused by a person's use of their own name or other indicia of identity, the right to do so should predominate over concerns that some consumers will be confused. Trademark law tolerates such confusion elsewhere when a defendant's use is considered fair and provides useful and accurate information.²⁹³ Truthful, accurate information about a person's own business when not intentionally designed and calculated to deceive should be insulated from liability in service of trademark's personality-based objectives, as well as its goals of providing room for fair competition and free speech. It may be appropriate, however, to require identity-holders to take "reasonable precautions" to mitigate confusion, particularly with a well-known counterpart.²⁹⁴ Although the provision of

²⁹² *Societe Vinicole de Champagne v. Mumm*, 143 F.2d 240, 241 (2d Cir. 1944) (per curiam); *NIMS*, *supra* note 96, § 72 (quoting *Jamieson & Co. v. Jamieson* (1898) 15 RPC 169 (AC) at 181); *Stix, Baer & Fuller Dry Goods Co. v. Am. Piano Co.*, 211 F. 271, 275 (8th Cir. 1913); *Turton v. Turton* (1889) 42 Ch D 128 at 136.

²⁹³ See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 123 (2004); *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 122 (1938); *Rothman*, *supra* note 33, at 542, 547–50.

One could also understand this latitude as based on the presumption that truthful information will serve consumers' interests; systemically, this is a better rule than allowing piecemeal litigation that could discourage the provision of useful, accurate information on the basis that occasionally consumers will get confused by it.

²⁹⁴ *L.E. Waterman Co. v. Mod. Pen Co.*, 235 U.S. 88, 94 (1914); see also *Kellogg*, 305 U.S. at 121 (suggesting that defendant need not eliminate all likely confusion, but instead only had to take "reasonable means to prevent confusion"). Although the reasonable-precautions standard is no longer regularly employed, it is a particularly appropriate analytical tool in the context of evaluating

truthful information about identity-holders will often coincide with consumer interests, it is more likely to part ways with a markholder's interests if that information is about a competitor or a person formerly involved with the company.²⁹⁵

The right to use one's own identity should continue even after a voluntary transfer of a company and its marks that incorporate that person's name or other indicia of identity.²⁹⁶ Identity-holders should have latitude to embark on new, even competing ventures, and to use their own names and identities in the process unless they either use such indicia as marks or misrepresent a continued association or connection with the plaintiff's business.²⁹⁷ The ongoing preference for allowing uses of a person's own identity supports a vision of trademark and unfair competition law that affirmatively protects negative spaces, particularly the provision of truthful information and the allowance of fair competition even at the expense of other trademark objectives.

C. Trademark's Expansionary Impulse and Its Limits

A theory of trademark law that includes consideration of personality rights also provides an alternative way to understand what Beebe has described as "the mutation of trademark law into corporate right of publicity law."²⁹⁸ The personality-oriented thread of trademark law developed here suggests that this broader conception of entitlements may stem from within, rather than outside of, trademark law. The existence of personality-based concerns in trademark law provides one potential explanation (though not a justification) for trademark's expansion in scope over the last 100 years. Such expansions include allowing liability beyond confusion over source, beyond competing goods and services, and beyond even confusion, in the context of dilution (and some initial interest) claims.²⁹⁹ Many scholars have suggested that trademark's

liability for defendants who are using their own names or identities in trade and are acting in good faith.

²⁹⁵ For an early example of this divergence, consider *Samuel v. Buger*, 13 How. Pr. 342 (N.Y. Sup. Ct. 1856), in which the court rejected the assertion of the alleged assignees' rights over the use of the watchmaker Brindle's name on watches against the defendants who were selling authentic watches made by the watchmaker. *Id.* at 343. The plaintiffs in the case could not "call on this court to aid them in passing off the watches made by them as those manufactured by Brindle" nor could they obstruct the defendants selling "watches made by Brindle, and stamped by him with his name" as this was in fact the "truth." *Id.*

²⁹⁶ See *Madrigal Audio Laboratories, Inc. v. Cello, Ltd.*, 799 F.2d 814, 822–23 (2d Cir. 1986) ("[E]ven when a personal name has become a trade name it continues to serve the important function to its bearer of acting as a symbol of that individual's personality, reputation and accomplishments" *Id.* at 822.).

²⁹⁷ See, e.g., *id.*; *JA Apparel Corp. v. Abboud*, 682 F. Supp. 2d 294, 313–16 (S.D.N.Y. 2010); see also sources cited *supra* notes 208–217, 244–247 and accompanying text.

²⁹⁸ Beebe, *supra* note 15, at 393 (capitalization omitted).

²⁹⁹ See Rothman, *supra* note 33, at 540 & n.4 (describing these expansions).

traditional market-based and consumer-protection rationales do not support these expansions.³⁰⁰ One alternative way of understanding these expansions is that they stem at least in part from trademark's personality-based objectives (perhaps without an awareness that they do). We can see this possibility expressed in two ways. First, we observe language that sounds in concerns over autonomy and dignity used to support some of these expansions. Second, some of these doctrines make more logical (and perhaps normative) sense when applied to protect natural persons, rather than artificial ones.

Consider the expansion of trademark liability to uses in noncompeting goods. In his famous opinion in *Yale Electric Corp. v. Robertson*,³⁰¹ Judge Learned Hand explained the basis for this expansion in trademark law not on market-based grounds, but instead on the affront to individual dignity and autonomy that stems from picking up a person's identity without authorization and using it as a source identifier:

[A merchant's] mark is his authentic seal; by it he vouches for the goods which bear it; it carries his name for good or ill. If another uses it, he borrows the owner's reputation, whose quality no longer lies within his own control. This is an injury, even though the borrower does not tarnish it, or divert any sales by its use; for a reputation, like a face, is the symbol of its possessor and creator, and another can use it only as a mask.³⁰²

McCarthy quotes this language from Judge Hand in his contemporary trademark treatise to explain why trademark infringement expanded to include liability in the context of noncompeting goods and services, without acknowledging the language's personality-based roots.³⁰³ There may be good market-based reasons to allow infringement claims beyond competing goods and services, especially when there is confusion about sponsorship or affiliation, or when the use is in a likely zone of expansion. But it is notable that Judge Hand relied not on these market-based concerns but instead on personality-based ones.

Similarly, the increasing severance of one of trademark's traditional and fundamental aspects — that it is not a property right in gross but instead is appurtenant to particular products and services — makes more sense when the mark is rooted in a person than it does otherwise. This severing can be seen, for example, in some initial interest cases, broad sponsorship or affiliation claims, antidilution law, and the protection of merchandise even when a plaintiff's primary business does not encompass the type of goods at issue. Such a broad vision of

³⁰⁰ See, e.g., Beebe, *supra* note 15, at 390, 393–95, 398; Lemley, *supra* note 11, at 1697–713; Litman, *supra* note 72, at 1721–25, 1728–35; Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 CARDOZO L. REV. 105, 124–39 (2005).

³⁰¹ 26 F.2d 972 (2d Cir. 1928).

³⁰² *Id.* at 973; see *id.* at 973–74.

³⁰³ See 4 MCCARTHY, *supra* note 7, § 24:5.

trademark rights, unmoored from particular goods or services, fits best in the context of a natural person for whom the mark functions as an identifier of that person, rather than of entirely distinct goods or services. If we understand the protection of personal marks as rooted in a concept of self-ownership,³⁰⁴ then any particular connection to products or services is less important. And, as McGeeveran suggests, extending merchandising rights without regard to likely confusion over source or sponsorship might be appropriate in the context of individuals with self-marks because “humans . . . have feelings and personal interests” but would not be appropriate for “corporate-controlled brands” that cannot suffer the same personal injuries.³⁰⁵

Perhaps the most contentious expansion of trademark law is the adoption of antidilution laws, which broadly extend liability regardless of likely confusion. A defendant can be liable for using a plaintiff’s mark (or something similar) as its own — even if there is no confusion as to source, sponsorship, or affiliation — when such a use is likely to water down the mark’s value by blurring or tarnishing it.³⁰⁶ The market-based rationales for antidilution laws have been subject to withering critiques.³⁰⁷ In addition, the original concerns that led to calls for antidilution laws have largely been addressed by trademark law’s expansion to protect against confusion both as to sponsorship or affiliation and in noncompeting markets.³⁰⁸ With these concerns addressed, what remains is a doctrine that seems more concerned with personality-based injuries than market-based ones. The conclusion, for example, that associating a business’s mark with sex is presumptively tarnishing shares more in common with concerns over personal dignity than it does with concerns over business harms.³⁰⁹ Similarly, the concerns of Frank

³⁰⁴ See *Brown Chem. Co. v. Meyer*, 139 U.S. 540, 544 (1891) (“A man’s name is his own property, and he has the same right to its use and enjoyment as he has to that of any other species of property.”); *Edison v. Edison Polyform Mfg. Co.*, 67 A. 392, 395 (N.J. Ch. 1907) (concluding that a person’s name and likeness were “property” owned by the underlying person); cf. Post & Rothman, *supra* note 4, at 116–21.

³⁰⁵ McGeeveran, *supra* note 16, at 360; see *id.* at 360–61 (making this argument in the context of suggesting one possible critique of scholarship broadly objecting to merchandising rights).

³⁰⁶ See, e.g., 15 U.S.C. § 1125(c) (providing the federal antidilution law).

³⁰⁷ See Beebe et al., *supra* note 85, *passim*; Tushnet, *supra* note 85, *passim*.

³⁰⁸ The original justification for these laws emphasized the unique harm to well-known marks that arose when they were used on unrelated products. See Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 830–33 (1927); see also *Eastman Photographic Materials Co. v. John Griffiths Cycle Corp.* (1898) 15 RPC 105 (Ch) at 112 (pointing, in what is often credited as the first dilution case in England, to the likelihood of confusion as to a connection between the plaintiff’s famous KODAK mark and the defendant’s use of the same mark for bicycles).

³⁰⁹ See *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 388 (6th Cir. 2010) (concluding in the context of dilution law that selling “sex-related products” using a mark that resembles a famous mark “create[s] a kind of rebuttable presumption, or at least a very strong inference” of likely tarnishment); *Ty Inc. v. Perryman*, 306 F.3d 509, 511 (7th Cir. 2002) (providing the use of the mark TIFFANY on a “striptease joint” as a paradigmatic example of dilution by tarnishment);

Schechter, the recognized parent of American dilution law, that a mark's "identity" will be "whittl[ed] away" and its "uniqueness" obliterated, sound more like concerns over self-definition and individual autonomy than ones exclusively about business profits.³¹⁰ Schechter rooted what became antidilution protection in the "celebrity" of marks, evoking the same constellation of rights often extended to individuals under state publicity laws.³¹¹ Another proponent of antidilution laws, the well-known treatise author Rudolf Callmann, similarly referred to personal injury when he likened dilution to an "infection" that posed a mortal threat to a mark's life.³¹² To be fair, dilution law, including Schechter's vision of it, was not (and has never been) expressly about protecting personality interests; it was initially posited as a way to protect the "selling power" of marks, and particularly the business interests of markholders in a world that did not yet recognize infringement in the context of confusion over sponsorship or noncompeting goods.³¹³ Nevertheless, it is revealing that efforts to justify antidilution laws often tap into the language of personality rights.

Within the boundaries of this Article focused on addressing today's identity thicket, my primary point by raising this possibility is that it highlights that the personality-based objectives I have identified and developed here are not without limits. They should apply only to natural persons and only in circumstances in which there are meaningful threats posed to a person's autonomy and dignity. Thinking for a moment beyond the identity thicket, if the best (only?) explanation for some

3 RESTATEMENT (SECOND) OF TORTS § 574 (AM. L. INST. 1977) (providing that "imputations of sexual misconduct" constitute defamation per se (capitalization omitted)); cf. Heymann, *The Law of Reputation and the Interest of the Audience*, *supra* note 94, at 1390–93, 1409–11 (observing that trademark dilution laws overlap with concerns about personal "reputation" and "autonomy" that also arise in right of publicity cases, *id.* at 1390). For a critique of the sex-negative approach in the context of dilution law, see Jennifer E. Rothman, *Sex Exceptionalism in Intellectual Property*, 23 STAN. L. & POL'Y REV. 119, 134–39 (2012).

³¹⁰ Schechter, *supra* note 308, at 825–26 (quoting Note, *Appropriation of Trade Symbols by Noncompetitors*, 25 COLUM. L. REV. 199, 204 (1925)); see also Beebe, *supra* note 15, at 394–95 (suggesting that antidilution law is the "best expression of the mutation of trademark law into a right of publicity law for persons both natural and corporate," *id.* at 394); Beverly W. Pattishall, *The Dilution Rationale for Trademark — Trade Identity Protection, Its Progress and Prospects*, 71 NW. U. L. REV. 618, 618–20 (1976).

The Supreme Court adopted Schechter's rationale as its own, observing that "the only rational basis" for dilution law is "the preservation of the uniqueness of a trademark." *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 429 (2003) (quoting Schechter, *supra* note 308, at 831).

³¹¹ SCHECHTER, *supra* note 80, at 166.

³¹² 3 RUDOLF CALLMANN, *THE LAW OF UNFAIR COMPETITION AND TRADE-MARKS* 1643 (2d ed. 1950).

³¹³ Schechter, *supra* note 308, at 832 (pointing to the harm of dilution as a loss of the mark's "selling power"); cf. Barton Beebe, *The Suppressed Misappropriation Origins of Trademark Antidilution Law: The Landgericht Elberfeld's Odol Opinion and Frank Schechter's "The Rational Basis of Trademark Protection,"* in *INTELLECTUAL PROPERTY AT THE EDGE* 59, 61–71 (Rochelle Cooper Dreyfuss & Jane C. Ginsburg eds., 2014).

of these expansions in trademark law is that they further personality-based interests, then these expansions should be limited to instances in which they actually further those interests. Accordingly, they should be limited to claims by natural persons (or at least their agents). Corporations are not subject to “humiliation and embarrassment”³¹⁴ when their corporate name or identity is used without permission and should not have the same autonomy-based rights of self-definition. Other limits on liability might also be appropriate if we understand these expansions as rooted in personality. In the context of dignity-based right of publicity claims, Professor Robert Post and I have suggested that it would be appropriate to limit such claims to instances in which the use of a person’s identity would be highly offensive to a reasonable person.³¹⁵ Adding such a requirement to a dilution by tarnishment claim, for example, might similarly be appropriate.

* * *

Incorporating autonomy and dignity concerns into trademark law does *not* mean that these interests should overcome competing interests. Like other objectives of trademark law, they must be limited to provide room for fair competition and free speech. In fact, an awareness of trademark’s personality-based objectives shores up trademark’s negative spaces by providing protection for identity-holders to fairly compete in their own names and to accurately convey information to the public. Considering trademark’s personality-oriented objectives more explicitly also suggests limiting principles for some of trademark’s expansionary impulses. Thus, a broader conception of trademark entitlements in the context of personal marks is accompanied by a broader vision of limitations on liability. In addition, shoring up the personality-based interests of trademark law poses fewer speech concerns than right of publicity claims do. Trademark law has clearer boundaries than the right of publicity, as well as far more robust and widely accepted speech-protective doctrines and defenses (including descriptive and nominative fair use, genericism, and an independent First Amendment analysis³¹⁶).

V. WHAT TRADEMARK’S PERSONALITY MEANS FOR THE RIGHT OF PUBLICITY AND TRADEMARK PREEMPTION

With this more robust understanding of trademark law and some of its implications in hand, we can now return to the identity thicket created by fragmentary, overlapping rights to a person’s identity. In this

³¹⁴ *Tomsky v. Clark*, 238 P. 950, 952 (Cal. Dist. Ct. App. 1925).

³¹⁵ See Post & Rothman, *supra* note 4, at 124–25; see also Heymann, *The Law of Reputation and the Interest of the Audience*, *supra* note 94, at 1397–400 (suggesting that dilution claims based on reputational harm should require demonstration of precise reputational injury rather than mere “association,” *id.* at 1399).

³¹⁶ See generally Rothman, *supra* note 33.

Part, I will consider how a preemption framework that employs a personality theory of trademark law, alongside its more widely recognized objectives of protecting markholders and consumers, can help to navigate conflicts in the rights surrounding a person's identity. I cannot fully operationalize such a framework here, but I can provide some significant guidance on how these questions should be analyzed.

As discussed in Part I, because right of publicity claims are often brought in tandem with Lanham Act claims, few have thought much about what role, if any, *trademark preemption* should play in limiting or barring state right of publicity laws.³¹⁷ In fact, there are very few uses of the term "trademark preemption" in court decisions, filings, or legal scholarship.³¹⁸ This contrasts with the robust consideration of copyright preemption by both scholars and courts.³¹⁹ Despite the lack of attention

³¹⁷ See *supra* notes 24–28 and accompanying text.

³¹⁸ One of the only cases to consider such an analysis is the recent district court decision in *Moran v. Edie Parker, LLC*, No. 20-CV-12717, 2021 WL 4427246 (E.D. Mich. Sept. 27, 2021), which controversially held that a right of publicity claim brought by the estate of the beat generation figure Edie Parker against the defendant, which had registered a variety of trademarks that included the name "Edie Parker," was preempted by the Lanham Act simply because the defendant held registered trademarks in that name. See *id.* at *4–5. Prior to the decision in *Moran*, a search on Westlaw turned up only one unpublished decision from 2010 and one brief in its database that used the term "trademark preemption." See *Luck v. OTX Acquisition Corp.*, No. CV 10-1671, 2010 WL 11595817, at *7 (C.D. Cal. Aug. 3, 2010); Brief and Appendix of Defendants-Appellants at 11, *Novell, Inc. v. Dep't of Pro. Regul.*, 738 N.E.2d 229 tbl. (Ill. App. Ct. 1998) (No. 1-97-3065), 1997 WL 33761452, at *11. As of the writing of this Article, approximately five law review, law journal, or magazine articles (indexed in Westlaw) even mention the term. Of these even fewer consider the concept in any depth. See, e.g., John T. Cross, *The Role of the States in United States Trademark Law*, 49 U. LOUISVILLE L. REV. 485, 487–88 (2011) (calling for the passage of an express preemption provision that would displace most state trademark laws); Daniel Gervais, Martin L. Holmes, Paul W. Kruse, Glenn Perdue & Caprice Roberts, *Is Profiting from the Online Use of Another's Property Unjust? The Use of Brand Names as Paid Search Keywords*, 53 IDEA 131, 151 (2013) (concluding that state unfair competition laws based on unjust enrichment arising out of keyword advertising "survive trademark preemption analysis"); Mark A. Lemley, *Intellectual Property and Shrinkwrap Licenses*, 68 S. CAL. L. REV. 1239, 1271 n.143 (1995) (observing in a footnote that "surprisingly, there is no Supreme Court guidance on trademark preemption").

Professor Anupam Chander uses the term "trademark preemption" a number of times in his article *The New, New Property*, but uses it for an entirely different concept related to trademark holders having priority rights over domain names that incorporate their marks. Anupam Chander, *The New, New Property*, 81 TEX. L. REV. 715, 747–48 (2003). Few casebooks raise the issue, a notable exception being Professors Lemley, Peter Menell, Robert Merges, and Shyamkrishna Balganesh's *Intellectual Property in the New Technological Age*. 2 PETER S. MENELL, MARK A. LEMLEY, ROBERT P. MERGES & SHYAMKRISHNA BALGANESH, *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 1201–03 (2020 ed.) (observing that "[t]here has been surprisingly little litigation over the preemptive effect of the Lanham Act," *id.* at 1201). Several other articles and courts have considered whether preemption occurs in the context of federal trademark and unfair competition laws, particularly under the Lanham Act, but do not use that exact term. See, e.g., *Int'l Franchise Ass'n v. City of Seattle*, 803 F.3d 389, 409–10 (9th Cir. 2015); David S. Welkowitz, *Preemption, Extraterritoriality, and the Problem of State Antidilution Laws*, 67 TUL. L. REV. 1, 8–12 (1992).

³¹⁹ Westlaw has over 400 published cases that address or refer to the doctrine of "copyright preemption," and its law journal index has nearly 900 listings for articles that mention copyright

paid thus far to trademark preemption in right of publicity cases (or elsewhere), it is a promising method to address the increasing conflicts between federal trademark and unfair competition law and the right of publicity. Preemption provides a doctrinal framework for the analysis that follows, and also a launchpad for the larger normative consideration of how best to resolve the conflicting set of laws that address unauthorized uses of a person's identity in the context of trade, even if one does not adopt a full-blown preemption-based approach.³²⁰

Unlike the Copyright Act,³²¹ the Lanham Act does not have an explicit, broad preemption provision addressing its interaction with state law.³²² And, in contrast to federal patent and copyright laws, the Lanham Act works in conjunction with state trademark and unfair competition laws, rather than preempting them.³²³ Nevertheless, conflict preemption analysis can still be employed to address instances in which state publicity laws significantly interfere with federal trademark and unfair competition laws.³²⁴ While conflict preemption, particularly

preemption, many of which use it in the title and many more of which robustly address the issue even if the term does not appear in the title. And a significant number of these sources consider preemption in the specific context of the clash between copyright law and the right of publicity. *See, e.g.*, Jackson v. Roberts (*In re Jackson*), 972 F.3d 25, 33–42 (2d Cir. 2020); ROTHMAN, *supra* note 4, at 160–79 (describing the right of publicity's "collision course with copyright" and the potential of preemption to address it); Thomas F. Cotter & Irina Y. Dmitrieva, *Integrating the Right of Publicity with First Amendment and Copyright Preemption Analysis*, 33 COLUM. J.L. & ARTS 165, 169, 179–89, 208–18 (2010); Rothman, *supra* note 67, *passim*; *see also* Tushnet, *supra* note 4, at 1542–48 (considering the potential of copyright preemption to limit the reach of the right of publicity).

³²⁰ A reconciliation of these conflicting rights could potentially be achieved through a variety of mechanisms, but preemption is the most promising starting point for teasing out the issues (and potential solutions) raised in this Article. *Cf.* Mark A. Lemley, *Beyond Preemption: The Law and Policy of Intellectual Property Licensing*, 87 CALIF. L. REV. 111, 151–71 (1999) (considering alternative frameworks to preemption for addressing concerns about overreaching IP licenses).

³²¹ *See* 17 U.S.C. § 301 (explicitly preempting state laws that are "equivalent" to rights provided by the Copyright Act and that "come within the subject matter of copyright").

³²² I note that the Lanham Act does have at least two targeted preemption provisions geared toward protecting registered marks. *See* 15 U.S.C. § 1121(b) (preventing states from requiring alteration of federally registered marks); *id.* § 1125(c)(6) (barring the assertion of state dilution claims against federally registered marks).

³²³ *See* H.R. REP. NO. 104-374, at 8 (1995) (noting that "the proposed federal dilution statute would not preempt state dilution laws" and that the existing "federal trademark law coexist[s] with state trademark law"); *see also* Yankee Candle Co. v. Bridgewater Candle Co., 259 F.3d 25, 46 (1st Cir. 2001); 3 MCCARTHY, *supra* note 7, § 22:2 ("[T]he federal Lanham Act does not occupy the whole field of trademark and unfair competition law in such a way that it would preempt parallel state law.").

³²⁴ *Cf.* U.S. CONST. art. VI, cl. 2. Conflict preemption is the most applicable form of preemption here given the absence of an explicit preemption provision and an intention to leave state law generally intact. Conflict preemption is sometimes further divided into "impossibility" preemption and "obstacle" preemption. *Mut. Pharm. Co. v. Bartlett*, 570 U.S. 472, 502–03 (2013) (Sotomayor, J., dissenting). Impossibility preemption allows for the preemption of state laws when it is impossible for a party to comply with both federal and state law, while obstacle preemption allows for the preemption of state laws when they more broadly conflict with the "purposes and objectives" of

when stemming from obstacle preemption rather than impossibility preemption, has been increasingly controversial in other areas of law,³²⁵ it remains widely accepted in the context of mediating state law conflicts with federal IP regimes.³²⁶ In line with this body of law, the Lanham Act should also preempt state right of publicity claims when they “stand[] as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress” as expressed through federal trademark and unfair competition laws.³²⁷

To the extent there are close calls in determining whether trademark law should preempt right of publicity claims, the Lanham Act’s goal of achieving national uniformity puts a thumb on the scale in favor of preemption.³²⁸ National uniformity itself stands as one of the objectives of the Supremacy Clause and preemption analysis in general.³²⁹ In the context of patent law, the Supreme Court has recognized the dangers of piecemeal, conflicting state laws that set up a clash with federal patent entitlements, not only directly, but also by virtue of being unpredictable and variable from state to state.³³⁰ Given the right of publicity’s wide variations from state to state, the Lanham Act’s national scope weighs in favor of adopting its rules over those of state publicity laws. The

federal law. *Id.* at 502; *Cap. Cities Cable, Inc. v. Crisp*, 467 U.S. 691, 699 (1984) (quoting *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941)).

³²⁵ See, e.g., *Williamson v. Mazda Motor of Am., Inc.*, 562 U.S. 323, 340–43 (2011) (Thomas, J., concurring in the judgment); Caleb Nelson, *Preemption*, 86 VA. L. REV. 225, 265–90 (2000); see also Michael S. Greve, Jonathan Klick, Michael Petrino & J.P. Sevilla, *Preemption in the Rehnquist and Roberts Courts: An Empirical Analysis*, 23 SUP. CT. ECON. REV. 353, 362–63 (2015) (observing the increasing disagreement in preemption cases among members of the Roberts Court).

³²⁶ See, e.g., *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 144, 151–52 (1989) (holding that a Florida statute that limited the duplication of unpatented boat hulls was preempted by federal patent law); *Jackson v. Roberts (In re Jackson)*, 972 F.3d 25, 34–42 (2d Cir. 2020) (applying obstacle preemption to hold that copyright law preempted a right of publicity claim); *Int’l Franchise Ass’n v. City of Seattle*, 803 F.3d 389, 409–10 (9th Cir. 2015) (applying conflict preemption analysis in the context of the Lanham Act and a state minimum wage law); *Biotechnology Indus. Org. v. District of Columbia*, 496 F.3d 1362, 1371–74 (Fed. Cir. 2007) (applying conflict preemption analysis and holding that federal patent law preempted a D.C. drug-pricing statute); cf. *Wyeth v. Levine*, 555 U.S. 555, 576–77 (2009); Kerry Abrams, Essay, *Plenary Power Preemption*, 99 VA. L. REV. 601, 608 (2013) (observing that, in spite of criticism, “most of the [preemption] cases are obstacle preemption cases”).

³²⁷ *Cap. Cities Cable*, 467 U.S. at 699 (quoting *Hines*, 312 U.S. at 67).

³²⁸ The Lanham Act was part of an effort to modernize, clarify, and harmonize trademark and unfair competition laws across the country. S. REP. NO. 79-1333, at 5 (1946). This nationalizing and harmonizing impulse is also evident in the passage of the Federal Trademark Dilution Act of 1995 and its subsequent amendments. See H.R. REP. NO. 104-374, at 3; 141 CONG. REC. 38,559 (1995) (statement of Sen. Orrin Hatch); Mark P. McKenna, *Trademark Law’s Faux Federalism*, in INTELLECTUAL PROPERTY AND THE COMMON LAW 288 (Shyamkrishna Balganeshe ed., 2013) (describing such uniformity concerns, while highlighting that state and federal trademark and unfair competition laws have largely been harmonious).

³²⁹ See U.S. CONST. art. VI, cl. 2; see also Nelson, *supra* note 325, at 256–57.

³³⁰ See *Bonito Boats*, 489 U.S. at 152–57.

Lanham Act could (and likely should) preempt state laws if “disuniformity . . . arise[s] from the multitude of state laws” in a space that is generally regulated by the Lanham Act.³³¹ Such disarray is exactly what we confront in the context of disparate state right of publicity laws that markholders have to navigate to make basic business decisions about how to exercise their trademark rights in marks comprised in part by some aspect of a person’s identity.

To determine when the Lanham Act should preempt state publicity laws, courts must consider not only the “objectives” of the federal law but also those of the state laws.³³² Accordingly, to facilitate the conceptual untangling of trademark and publicity claims, we must identify (even if only briefly) the right of publicity’s objectives. Right of publicity laws seek to protect individuals from having their identities used without permission to protect against both market-based and personality-based harms. In recent work, Post and I identified four distinct branches of the right of publicity that each track different objectives of the tort: the *right of commercial value*, the *right of performance*, the *right of control*, and the *right of dignity*.³³³ I will briefly discuss here how each of these rights of publicity intersects with trademark law.

Of the market-oriented objectives, the *right of commercial value* intersects most often with trademark law. The right of commercial value is the branch of the right of publicity focused on protecting the market value of a person’s identity. The right of commercial value shares analogous objectives with those of trademark infringement, false endorsement, and dilution claims.³³⁴ When a person’s identity is used without permission, they may “suffer injuries that range from lost job opportunities and endorsement deals to reduced salaries, loss of revenue from licensing and merchandising contracts, and overall diminishment of goodwill.”³³⁵ This is particularly true for celebrities, and such individuals will also be the ones most likely to bring trademark infringement and false endorsement claims for unauthorized uses of their identities.³³⁶

³³¹ *POM Wonderful LLC v. Coca-Cola Co.*, 573 U.S. 102, 117 (2014); see also Paul Heald, Comment, *Unfair Competition and Federal Law: Constitutional Restraints on the Scope of State Law*, 54 U. CHI. L. REV. 1411, 1434 (1987) (contending that the Lanham Act should preempt state unfair competition laws to promote national uniformity in trademark and unfair competition laws); cf. *POM Wonderful*, 573 U.S. at 117 (suggesting that such disuniformity could support preemption of state laws under the Federal Food, Drug, and Cosmetic Act (FDCA)).

³³² *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480 (1974).

³³³ Post & Rothman, *supra* note 4, at 92–125.

³³⁴ *Id.* at 111–14; see also Dogan & Lemley, *supra* note 5, at 1164, 1190–200 (contending that the right of publicity is best analogized to trademark infringement, false endorsement, and dilution laws).

³³⁵ Post & Rothman, *supra* note 4, at 108.

³³⁶ Ordinary people and those who work in public-facing jobs who are less well known, like some models, may be able to bring right of publicity claims, but are less likely to succeed with trademark infringement or false endorsement actions.

Unsurprisingly then, right of publicity claims rooted in protecting a person's commercial value often work in harmony with companion false endorsement and trademark infringement claims — at least when a party (usually a plaintiff) is both a markholder and a publicity-holder. However, when the publicity-holder and the markholder are not the same person or entity, clashes will arise given that two different parties will both claim to have the right to the person's commercial value, at least in the context of particular products or services.

The other market-based branch of the right of publicity is the *right of performance*. This interest overlaps with the objectives of copyright law, rather than those of trademark law, and is primarily motivated by a desire to incentivize the creation of performances.³³⁷ Right of publicity claims rooted in the right of performance could cause a conflict with the Lanham Act if one party holds the rights to use copyrighted footage of a performer and also holds the trademark rights to exploit that work and the performer's name or likeness but does not hold the performer's publicity rights.³³⁸ Imagine that a company, say Taylor Swift's former label, Big Machine Label Group, holds the copyrights to Swift's musical compositions, sound recordings, music videos, and recorded concert performances, as well as the rights to various trademarks using her name and image for sound recordings, entertainment services, and merchandise.³³⁹ Big Machine would be entitled under copyright and trademark law to circulate those performances, advertise them, and sell related merchandise. But if Big Machine did not also hold Swift's publicity rights (or have a clear license or waiver to use them), Swift could bring a right of publicity claim against Big Machine for doing so. I will discuss later in this section how to analyze whether such a claim should prevail over the trademark rights asserted by the record label.

The right of publicity also seeks to further two purely personality-based objectives — one rooted in autonomy and the other rooted in dignity, which Post and I denominate, respectively, the *right of control* and the *right of dignity*. While these personality-focused aspects of the right of publicity have usually been understood as wholly distinct from trademark law, my analysis in Part III demonstrates that trademark law also

³³⁷ See Post & Rothman, *supra* note 4, at 99–102; see also *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573–75 (1977). The right of performance is not exclusively market based; it also furthers some personality-based interests of performers. See Post & Rothman, *supra* note 4, at 101 n.64.

³³⁸ Conflicts with copyright law are more likely in the context of right of performance cases, and the Copyright Act should frequently preempt performance-based claims. See Post & Rothman, *supra* note 4, at 105–06; see also ROTHMAN, *supra* note 4, at 160–79; Rothman, *supra* note 67, at 214–18, 252, 254, 259, 261–64.

³³⁹ Cf. Ben Sisario, Joe Coscarelli & Kate Kelly, *Taylor Swift Denounces Scooter Braun as Her Catalog Is Sold Again*, N.Y. TIMES (Nov. 16, 2020), <https://www.nytimes.com/2020/11/16/arts/music/taylor-swift-scooter-braun-masters.html> [<https://perma.cc/82D9-HNUZ>].

has personality-based interests that overlap in some instances with both of these right(s) of publicity.

The right of control is often “expressed through the metaphor of property. Persons are said to own their own identity and accordingly are authorized to control its use by others.”³⁴⁰ Such control is understood to be essential to furthering the development of each individual’s personhood.³⁴¹ This branch of the right of publicity overlaps with trademark and unfair competition law’s objectives of preventing unauthorized uses of a person’s identity as a mark or to falsely suggest a connection or endorsement. It also harmonizes with trademark law’s protection of the right to use one’s own name and identity even if such a use causes some likely confusion or market harm to others; this reflects both bodies of law’s shared respect for self-ownership and the interest in autonomy.

The right of dignity, in contrast to the right of control, recognizes our interconnectedness with others and advances the integrity of personality.³⁴² This branch of the right of publicity focuses on the humiliation and degradation that can stem from unauthorized uses of one’s identity.³⁴³ The right of dignity also echoes some of the personality-driven aspects of trademark law; in particular, those rooted in the preservation of a person’s reputation and standing in the community that were identified in Part III.

Recognizing the role personality plays in trademark and unfair competition law significantly shifts the preemption analysis, as does an understanding of when trademark law and the right of publicity come into conflict. For example, while Swift’s publicity claim above might be properly preempted on market-based grounds, her publicity claim might have more success when it comes to personality-based interests. In the face of confusion as to Swift’s endorsement or participation in performances, trademark law provides a basis for allowing the

³⁴⁰ Post & Rothman, *supra* note 4, at 116; *see also* Corliss v. E.W. Walker Co., 64 F. 280, 282 (C.C.D. Mass. 1894); Pavesich v. New Eng. Life Ins. Co., 50 S.E. 68, 79–80 (Ga. 1905); Edison v. Edison Polyform Mfg. Co., 67 A. 392, 394 (N.J. Ch. 1907); Roberson v. Rochester Folding Box Co., 64 N.E. 442, 449–50 (N.Y. 1902) (Gray, J., dissenting).

³⁴¹ Post & Rothman, *supra* note 4, at 116; *see also* ROTHMAN, *supra* note 4, at 111; Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383, 385, 411–30 (1999) (contending that the right of publicity is best understood “as a property right grounded in human autonomy,” *id.* at 385); Mark P. McKenna, *The Right of Publicity and Autonomous Self-Definition*, 67 U. PITT. L. REV. 225, 231, 282 (2005); Rothman, *supra* note 2, at 212–17. Such a right of control must be severely circumscribed to avoid violating the First Amendment and its protections for free speech. *See* Post & Rothman, *supra* note 4, at 121, 162–65.

³⁴² *See* Post & Rothman, *supra* note 4, at 120–22; *cf.* Robert C. Post, *Community and the First Amendment*, 29 ARIZ. ST. L.J. 473, 475–76 (1997).

³⁴³ To violate a person’s right of dignity, the uses should be highly offensive to a reasonable person. In the context of public discourse, the use should also be likely to cause confusion as to the identity-holder’s participation or endorsement. *See* Post & Rothman, *supra* note 4, at 123–24, 165–71.

publicity-based claim to proceed. Such confusion would work an injury under trademark law to the consumers who are duped and could also work a personality-based injury to the identity-holder Swift in contravention of trademark's own articulated personality-based objectives. In such an instance, the right of publicity claims could *further* rather than obstruct trademark law.

When the right of publicity “complement[s]” trademark law in this way, it should be given greater latitude,³⁴⁴ but when it significantly disrupts the federal trademark and unfair competition regime such claims should be preempted.³⁴⁵ Preemption should occur not only when state publicity rights significantly interfere with the rights of markholders, but also when they disrupt the other objectives of trademark law — including its protection of personality, consumers, and fair competition, and the latitude it provides for free speech. The Supreme Court has held in the context of patent law that “federal patent laws must determine not only what is protected, but also what is free for all to use.”³⁴⁶ The same holds true in the context of trademark preemption. Trademark law prevents markholders from locking up facts that accurately describe products or services; obstructing reasonable and appropriate references to marks for products or services, whether for purposes of comparison or creative expression; and blocking or greatly hampering entry by others in the same product or service category.³⁴⁷ And trademark law limits the ways that markholders can restrict identity-holders from using their own names and likenesses.

To focus the analysis here, I will consider claims brought by publicity-holders against markholders first, followed by those brought by markholders against publicity-holders. Often such cases will involve circumstances in which an identity-holder sold the rights to the trademarks at issue, but the analysis here extends beyond these situations. For purposes of this discussion, I will largely presume that the identity-holder and the publicity-holder are the same person except where I expressly note otherwise. Nevertheless, to the extent transfers of publicity rights are permissible, non-identity-holding publicity-holders should *not*

³⁴⁴ POM Wonderful LLC v. Coca-Cola Co., 573 U.S. 102, 121 (2014); *cf. id.* at 120–21 (holding that the FDCA did not preclude a Lanham Act false advertising claim because the two laws complemented one another); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480–85, 492–93 (1974) (holding that state trade secret laws were not preempted because they did not conflict with federal patent laws and were complementary to patent law's objectives).

³⁴⁵ See *Geier v. Am. Honda Motor Co.*, 529 U.S. 861, 872 (2000); *Cap. Cities Cable, Inc. v. Crisp*, 467 U.S. 691, 698–99 (1984); *Kewanee Oil*, 416 U.S. at 479–80.

³⁴⁶ *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151 (1989).

³⁴⁷ See 15 U.S.C. § 1115(b)(4); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004); *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 116 (1938); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992); *Rogers v. Grimaldi*, 875 F.2d 994, 998–1001 (2d Cir. 1989); *cf. supra* section IV.B, pp. 1331–32.

be able to assert personality-based interests stemming from either the right of publicity or trademark law's personality-protective features.

A. Publicity-Holders/Identity-Holders v. Markholders

When a publicity-holder/identity-holder sues a markholder who is allegedly making an unauthorized use of their identity, there are two initial overarching questions that should be asked. The first is whether the right of publicity claim is really a trademark claim in disguise, asserted by a party who lacks (or sold or lost) the relevant trademarks.³⁴⁸ When the mere exercise of trademark rights leads to liability, state right of publicity claims should usually be preempted.³⁴⁹

The second question is whether enforcement of the plaintiff's publicity rights would "substantially restrict" or interfere with the trademark regime.³⁵⁰ Such an interference would include substantially disrupting what a legitimate markholder can do, in contravention of the entitlements provided by trademark law, as well as substantial restrictions on trademark's negative spaces, including its provision for fair uses. Disruption of the personality-based objectives and doctrine incorporated into the Lanham Act would also work a substantial interference.

When a markholder properly holds the rights to use a person's name, likeness, or other indicia of identity in connection with a particular business, product, or service pursuant to lawfully acquired trademark rights, publicity-holders should not be able to assert right of publicity claims for those very same uses. Under such circumstances, right of publicity claims should usually be preempted in the absence of clear contractual language limiting the uses at issue, or substantial evidence of confusion as to the sponsorship and ongoing involvement of the publicity-holder/identity-holder in ways that would likely violate trademark law's own limits. The bar for such confusion must be high and must be distinct from simple confusion over a connection to a person as there is an unavoidable, ongoing, perpetual connection between the marks used and the person who, for example, likely founded the company and for whom it and/or some of its products are named.

Let's return to the example of the Hansen IP Trust's lawsuit against Coca-Cola.³⁵¹ This conflict that initially seemed unnavigable now seems fairly straightforward. Because the publicity-based claims were asserted

³⁴⁸ Cf. *Jackson v. Roberts (In re Jackson)*, 972 F.3d 25, 37–41 (2d Cir. 2020) (applying this approach in the context of federal copyright law to preempt a right of publicity claim).

³⁴⁹ Cf. *id.*; *Dryer v. Nat'l Football League*, 814 F.3d 938, 943 (8th Cir. 2016); *Laws v. Sony Music Ent., Inc.* 448 F.3d 1134, 1143–45 (9th Cir. 2006); *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 649–51 (Ct. App. 1996).

³⁵⁰ *In re Jackson*, 972 F.3d at 40; cf. *id.* (noting in the context of copyright preemption that a state law should be preempted if it would "substantially interfere with the utilization of a work in ways explicitly permitted by the Copyright Act"); Rothman, *supra* note 67, at 262–64.

³⁵¹ See *supra* notes 58–65 and accompanying text.

by the trust founded by the heirs of a long-dead relative, the right of publicity claim is rooted in market-based concerns.³⁵² (The heirs have their own personality interests, but they cannot assert those of the deceased Hansen, who was the only identity-holder at issue in the case.) And because we are not dealing with a performance claim, the right of publicity claim is solely one to the right of commercial value in Hansen's identity. But this right is limited by the trademark rights employing his identity that are already lawfully held by Coca-Cola.³⁵³ Here the marks at issue are separable from the deceased Hansen, and are accordingly *de facto* personal marks, rather than *de jure* ones. Therefore, they are capable of transfer to and ownership by Coca-Cola. To the extent that the Trust's claim is "an attempt to exercise control over" trademark rights held by Coca-Cola,³⁵⁴ and to benefit from profits derived from the company's marks, products, and promotion, the right of publicity claims should be preempted. Coca-Cola should therefore be free to use the marks it has acquired, and to accurately describe the history of the founding of Hansen's by Hansen and his involvement with the company and its products.

A somewhat closer call is whether Coca-Cola's trademarks and the other IP rights it holds give it the ability to name a lemonade HUBERT'S. But even here Hansen's personality is wrapped up in the story, marks, and other IP of the business that Coca-Cola acquired. Under such circumstances, Coca-Cola (the successor company) should have latitude to expand both products and product lines associated with the company and the marks.³⁵⁵ More generally, such determinations will require consideration of the types of marks acquired by purchasers, as well as any limitations placed on uses in the sales and asset transfer agreements.

To the extent that personality interests are raised by an identity-holder — which they are not in the Hansen IP Trust case — trademark law remains the guidepost for how to resolve these considerations. As discussed in Parts III and IV, when a person voluntarily sells their company, trademark law already has an established line of cases that takes into consideration both personality- and market-based concerns, and

³⁵² I presume for purposes of this analysis that Hansen's right of publicity survived his death and that the Trust is the owner of his postmortem rights. Both of these conclusions were challenged in the litigation and may be revisited as the litigation continues.

³⁵³ See *Hansen v. Coca-Cola Co.*, No. D077588, 2021 WL 2461175, at *1, *4 (Cal. Ct. App. June 17, 2021); *supra* note 61 and accompanying text.

³⁵⁴ *In re Jackson*, 927 F.3d at 38; *cf. id.* at 38, 54 (holding that such an effort to exercise control over a copyrighted work using a right of publicity claim was preempted).

³⁵⁵ *Cf. JA Apparel Corp. v. Abboud*, 682 F. Supp. 2d 294, 320 (S.D.N.Y. 2010) (suggesting that because JA Apparel had purchased the right to use the Abboud name as a trademark, it had the right to generate new marks related to that name, such as "Joe," "JA," "Joseph Abboud," and "Ask Joseph Abboud").

provides a framework for resolving such conflicts. Markholders who sell their businesses are not allowed to retain the very thing sold.³⁵⁶ State law (expressed through the right of publicity) cannot set this established principle at naught. Trademark law — properly understood with its personality-based aspects recognized — may limit or bar some sales of businesses, marks, and goodwill altogether if they are inextricably tied to a person. It may also set limits on the scope of rights transferred via bankruptcy, and set some constraints on how successor companies refer to individuals for whom a company was named or who used to be associated with that company. However, these protections do not entitle sellers to retain the exact rights that they bargained away.

These issues were raised in *JA Apparel Corp. v. Abboud*, and specifically in the defendant Abboud's counterclaim against JA Apparel, the company to which he sold his eponymously named apparel company.³⁵⁷ Abboud claimed that JA Apparel had violated his right of publicity by referring to him in advertisements for the company's products and on its website — for example, by referring to a "Joe," and suggesting that consumers could ask him questions like "Hey Joseph, What Should I Wear?"³⁵⁸ The district court rejected Abboud's publicity claim, concluding that consumers would not associate that particular Joe or Joseph with the real person, but instead with the corporation and its staff.³⁵⁹ There are reasons to be skeptical of that conclusion, but regardless it is easy to foresee circumstances in which such an ongoing association with Abboud would be made. The proposed preemption analysis provides a route to navigate such a conflict of rights.

Given the voluntary sale, one could view the uses as with authorization and so not as violations of the right of publicity in the first place; however, presuming that the specific uses were deemed unauthorized, a preemption analysis would be required. Preemption analysis suggests that because JA Apparel purchased the rights to use Abboud's name and personality in connection with the apparel business it purchased, Abboud could not turn around and obstruct the exercise of the trademark rights that he had willingly sold. His market-based interests in continuing to retain control over his identity in the context of that particular business would be preempted by the trademark rights held by the successor company. And the company would have latitude both in conjunction with its own rights and to further consumer-protection goals and free speech to accurately describe the historical association

³⁵⁶ See *supra* notes 204–209 and accompanying text.

³⁵⁷ See sources cited *supra* notes 37–48 and accompanying text.

³⁵⁸ *JA Apparel*, 682 F. Supp. 2d at 319. JA Apparel claimed that it acquired the right to Abboud's right of publicity through the sale agreement, but the district court considering the case on remand from the Second Circuit rejected this conclusion. *Id.* at 303, 307–08; Plaintiff and Counterclaim-Defendants' Post-trial Proposed Findings of Fact and Conclusions of Law, *supra* note 42, ¶ 11.114.

³⁵⁹ *JA Apparel*, 682 F. Supp. 2d at 320.

with Abboud, as long as it did not mislead consumers into thinking Abboud held an ongoing role in the company.

Abboud's personality interests too would be subsumed into the trademark analysis that encompasses such concerns. Trademark law provides guidance about these circumstances: When a person voluntarily transfers their self-named business, they cannot claim a personality-based injury for the bare continued use of their name and personality in conjunction with the business. However, as discussed, some trademark-based limits remain. For example, JA Apparel cannot suggest that Abboud has an active, continued involvement in the company. It is possible that suggestions that one could get direct advice or guidance from Abboud when he was no longer involved might exceed what is allowable. Here trademark and right of publicity claims would align, permitting Abboud to potentially succeed not only with a right of publicity claim, but also with false endorsement and false advertising claims under the Lanham Act. It is also possible that if Abboud's identity were inseparably intertwined with his business (such that the marks were de jure personal in nature), the entire transfer could be invalidated — or at least the transfer of the marks and goodwill. And if the business were allowed to transfer as part of a bankruptcy proceeding, instead of voluntarily, a successor (like JA Apparel) might have even more limited rights to use a seller's identity (like Abboud's), at least while the seller is alive.

B. Markholders v. Publicity-Holders/Identity-Holders

The *JA Apparel* litigation also raises the opposite vector conflict — in which a markholder sues a publicity-holder/identity-holder. JA Apparel sued Abboud when it heard that Abboud was about to launch a new clothing line under the brand name JAZ.³⁶⁰ Abboud planned to appear in advertisements and marketing campaigns for the new label and indicate his association with the new venture. JA Apparel asserted both Lanham Act and contract claims against Abboud and contended it held his publicity rights, at least in the context of the business.³⁶¹ Trademark law again gives guidance as to how to address these claims against Abboud. Trademark law and particularly its personality-oriented aspects expressly give latitude for a person to continue to use their own name in subsequent ventures after such a transfer if they act in good faith.³⁶² This is true even if confusion is likely to result.³⁶³ Accordingly,

³⁶⁰ *JA Apparel Corp. v. Abboud*, 568 F.3d 390, 394 (2d Cir. 2009).

³⁶¹ See *JA Apparel*, 682 F. Supp. 2d at 300, 303, 307–08.

³⁶² See *supra* notes 208–210, 244–250 and accompanying text.

³⁶³ See *supra* notes 251–253, 293–297 and accompanying text; cf. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 121–22 (2004) (holding that some degree of confusion

when Abboud fairly used his name to describe and promote his new venture, such uses should have been allowed as long as reasonable precautions were taken and Abboud acted in good faith, rather than trying to mislead consumers into thinking they were purchasing clothes from JA Apparel.³⁶⁴ Abboud had every right to inform consumers of his new venture and his involvement with it (after the completion of his contractual agreement not to compete with the company). This would be true even if JA Apparel had held Abboud's publicity rights — state law claims should not usurp what federal trademark and unfair competition laws expressly carve out as fair uses that provide for the accurate description of products and services.³⁶⁵

The same analysis as in the *Abboud* case would apply to the dispute in *Traeger Pellet Grills LLC v. Traeger*³⁶⁶ and *Traeger Pellet Grills, LLC v. Dansons US, LLC*.³⁶⁷ Here the plaintiff in both cases, TPG, sued when members of the Traeger family, who had sold TPG their wood-pellet grill business, started working for a competitor.³⁶⁸ Under the analysis here, trademark law protects the right of both the Traegers and the competitor, Dansons, to inform the public about this new business venture on personality-based, consumer-protection, fair competition, and free speech grounds. At the same time, the Traegers cannot retain the essential thing(s) sold. So they could not (nor could Dansons) use the trademarks and trade dress that had transferred to TPG. "Traeger" could not be used as a mark on a new product line nor could the recognizable (and transferred) trade dress (in the form of the family barn marked with the Traeger logo) appear in promotional materials.³⁶⁹

Let's return to a question posed earlier in the context of the Hubert Hansen IP Trust — whether the Trust itself or its members could use the Hansen name to sell its own juices and sodas. Coca-Cola's trademark rights would allow it to exclude others from using Hansen's name and identity in the soda and juice business, at least those other than

must be allowed in the context of descriptive fair use defenses otherwise the defense would be meaningless).

³⁶⁴ This is essentially what the district court (on remand) held; it allowed Abboud to use his name and likeness in advertising, but not in ways that were likely to confuse consumers as to the origin of the goods being advertised. See *JA Apparel*, 682 F. Supp. 2d at 313–16, 318; see also Heymann, *supra* note 100, at 438–39 (supporting appellate court's analysis that separated out the trademark functioning of Abboud's name from its function as a reference to himself because consumers would not be confused about the distinct references).

³⁶⁵ See *Madrigal Audio Laboratories, Inc. v. Cello, Ltd.*, 799 F.2d 814, 823, 825 (2d Cir. 1986) (allowing defendant to continue to use his name and "individual reputation" in competing business to accurately inform consumers of his new venture, *id.* at 825); *supra* notes 293–297 and accompanying text; cf. *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964) (preempting state unfair competition laws when the likely confusion arises from the good faith copying of a work in the public domain); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232–33 (1964) (same).

³⁶⁶ No. 19-cv-1714, 2019 WL 4305502 (M.D. Fla. Sept. 11, 2019).

³⁶⁷ 421 F. Supp. 3d 876 (D. Ariz. 2019).

³⁶⁸ See *id.* at 880–81; *Traeger Pellet Grills*, 2019 WL 4305502, at *1.

³⁶⁹ As Dansons apparently did. *Traeger Pellet Grills*, 421 F. Supp. 3d at 881, 885–86.

Hansen himself or other relatives who had Hansen as their surname. Trademark law, however, would allow members of the Trust to describe a family connection (if accurate) and to use their own name in business (even if it was Hansen) if done in good faith, rather than to trade off Coca-Cola's efforts to promote the brand and products by intentionally confusing consumers. The Hansen family members might be required, as part of taking reasonable precautions to mitigate confusion, to add significant disclaimers of any connection to products put out by Coca-Cola, and could not use "Hansen's" on its own as a mark for the same or similar products to those Coca-Cola sells. The latitude of the Hansen family to do so would not stem from market-based publicity rights, but instead from trademark law itself and particularly its concern for protecting individual personality and the sacred right to use one's own name and identity. Such an allowance would be cabined by trademark's own boundaries, rather than by state publicity laws.

CONCLUSION

Recognizing trademark law's personality-oriented objectives lends a number of important insights. It suggests a basis to limit the alienation of personal marks in some instances. It also shores up a theory of trademark's negative spaces that leaves room for individuals to use their own identities in trade, as well as room more broadly for competitors and the public to use others' marks for expressive purposes even in the face of some likely confusion. A personality-based understanding of trademark law also provides a partial explanation for its expansionist impulses, while illuminating a path to limit this trajectory. Properly understood, the personality-based aspects of trademark law developed in this Article are not boundless. To the extent that trademark's theory of personality furthers the goals of autonomy and dignity, corporations unmoored from underlying individuals should not be able to employ the same personality-based claims, and the theory will only apply when personal marks or a person's identity are at issue.

Understanding trademark's personality-motivated objectives also lends insight into how to navigate through the current identity thicket, and especially how to address the growing clash between this largely federal regime and state right of publicity laws. Much as trademark law cannot be employed as a "mutant copyright law,"³⁷⁰ the right of publicity cannot function as a mutant form of trademark law that restricts what trademark law permits. Trademark preemption provides an avenue out of this thicket, but only if trademark law's respect for personality is recognized. In the absence of this understanding, trademark preemption would unacceptably threaten individual autonomy and dignity. People should not have to change their names or abandon their own identity

³⁷⁰ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003).

and vocation simply because they have transferred their company and trademarks. And trademark law properly understood — taking into account its personality-based aspects — does not ask them to do so — in fact it specifically protects against such outcomes.