The Trademark Fair Use Reform Act

William McGeveran
University of Minnesota Law School

ABSTRACT (as of July 16, 2009)

In previous work, I identified appropriate free speech goals for trademark law and criticized the deficiencies of current doctrinal protection for expressive uses of trademarks. These papers also suggested that simpler rules, fashioned to allow fast resolution, would improve protection for speech in trademark law. But they did not take on the messy job of formulating such rules. This new Article will turn to that task. It will consider some of the design choices necessary to craft an effective alternative. It then will propose a set of reforms that would avoid the major flaws of existing trademark fair use doctrine and reduce—though of course not eliminate—trademark law's inhibition of free communication.

After summarizing the problem, I plan to explain four key choices about the design of the reform. First, the proposal emphasizes the reduction of administrative costs in adjudicating disputes at the core of speech protection, even if error costs from false negatives may increase somewhat as a result. Second, the proposal favors clearly stated rules over more general standards. Third, much of the reform is embedded in defenses and exemptions rather than in elements of the plaintiff's prima facie case. Finally, it is designed (initially, at least) as statutory language that might be passed by Congress rather than as judge-made common law.

The final part of the Article will present the proposal, which incorporates both categorical safe harbors for certain types of expressive uses with low risk of causing harmful consumer confusion, and also speech-friendly presumptions outside of these categories. It also contemplates certain procedural reforms to address the structural problems with existing fair use doctrine.