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### Of Autonomy, Sacred Rights, and Personal Marks

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OF AUTONOMY, SACRED RIGHTS,  
AND PERSONAL MARKS

*Shyamkrishna Balganes\**

INTRODUCTION

At the height of the Indian freedom movement, Mahatma Gandhi was contacted by a manufacturer of clay tiles with a rather unusual request: permission to use his image as a trademark for its roofing tiles.<sup>1</sup> Gandhi's response to the request was characteristically direct and pointed, yet equally unusual: "I have no copyright in my portraits but *I am unable to give the consent you require.*"<sup>2</sup> While no expert in copyright or trademark law, Gandhi was of course an ardent champion of personal freedom and individual autonomy.<sup>3</sup> His inability (a euphemism for unwillingness, of course) to consent to the use was hardly because of an overriding intellectual property right that he recognized. Nor was it obviously because he had plans to use or license his own image for a competing commercial purpose. What then was the basis of Gandhi's refusal?

Gandhi's response rather vividly captures the puzzle underlying the "sacred rights" theory of identity-based trademarks, the subject of

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\* Sol Goldman Professor of Law, Columbia Law School. Many thanks to Ashraf Ahmed, Barton Beebe, Mala Chatterjee, Courtney Cox, Jennifer Rothman, and Jeremy Sheff for helpful comments and suggestions.

<sup>1</sup> Letter from Mahatma Gandhi to M. Rebello & Sons (May 31, 1931), in 52 THE COLLECTED WORKS OF MAHATMA GANDHI 218, 218 & n.1 (1999).

<sup>2</sup> *Id.* at 218 (emphasis added). Gandhi's response was invoked more recently when the German penmaker Montblanc sought to market a series of luxury pens bearing the image of Gandhi on their nibs under the name "Mahatma Gandhi Limited Edition." See, e.g., Amy Kazmin, *Fountains of Dismay Greet "Gandhi Pen,"* FIN. TIMES (Sept. 30, 2009), <https://www.ft.com/content/c97b5bco-add9-11de-87e7-00144feabdco> [<https://perma.cc/WDQ7-8T4B>]; "Mahatma" Pens from Mont Blanc, THE HINDU (Dec. 4, 2021, 10:47 PM), <https://www.thehindu.com/news/national/article60633467.ece> [<https://perma.cc/9EGQ-SK5G>]. Under Indian law, any use of Gandhi's name or pictorial representation requires prior permission from the government, which Montblanc did not obtain. See The Emblems and Names (Prevention of Improper Use) Act, 1950, § 3, sched. 1, at 9-A. Montblanc's use of the name was eventually challenged in court, *Montblanc Not to Sell Gandhi Series Pen*, THE HINDU (Dec. 16, 2016, 2:49 PM), <https://www.thehindu.com/news/national/Montblanc-not-to-sell-Gandhi-series-pen/article16816593.ece> [<https://perma.cc/D5BA-ENWX>], and the company soon withdrew the pens from the market, Dean Nelson, *Mont Blanc Apologises for Gandhi Pen*, THE TELEGRAPH (Feb. 25, 2010, 2:13 PM), <https://www.telegraph.co.uk/news/worldnews/asia/india/7316148/Mont-Blanc-apologises-for-Gandhi-pen.html> [<https://perma.cc/ZR4U-M35L>].

<sup>3</sup> See generally CHARLES R. DISALVO, M.K. GANDHI, ATTORNEY AT LAW (2013); LOUIS FISCHER, THE LIFE OF MAHATMA GANDHI (1950); RAMACHANDRA GUHA, GANDHI BEFORE INDIA (2013); STANLEY WOLPERT, GANDHI'S PASSION (2001). For an account of Gandhi's engagement with copyright, see Shyamkrishna Balganes, Essay, *Gandhi and Copyright Pragmatism*, 101 CALIF. L. REV. 1705 (2013).

Professor Jennifer Rothman's engaging new article, *Navigating the Identity Thicket*.<sup>4</sup> In Rothman's account, trademark law has long embodied special rules for such identity-based "personal marks," which include "the portrait, name, or other indicia of identity of a natural person."<sup>5</sup> These rules, she argues, are rooted in the normative ideals of "autonomy and dignity" as they relate to the individual whose identity is at issue.<sup>6</sup> She then attempts to explicate the theory underlying trademark law's treatment of such personal marks, to draw out its broader implications for courts to navigate the cluster of overlapping state rights that regulate the ownership of identity.<sup>7</sup>

In this Response, I will focus on Rothman's attempted extraction of a coherent theory from the pockets of trademark law doctrines pertaining to personal marks, focusing on the article's identification of autonomy as one of the key strands of that theory.<sup>8</sup> While the doctrines that she identifies do indeed exhibit critical commonalities, they at the same time operate in analytically disparate ways, which calls into question the identification of a unified normative coherence around them. And while the article associates the law's special rules for personal marks with the values of autonomy and dignity, it does not specify what such autonomy (and dignity) means within the private law framework of trademark law. In so doing, I argue, it leaves open the likelihood that allusions to autonomy (and dignity) are little more than courts' attempted rationalizations of their positions, which risks undermining the role of autonomy and other nonconsequentialist goals in trademark and intellectual property law more generally. While the complexities of autonomy are certainly not the focus of Rothman's already exhaustive article, they nevertheless raise a host of intriguing questions about the theory that she derives from the area.

To be clear, I am not suggesting that nonutilitarian goals are not normatively legitimate within intellectual property. To the contrary, I believe that they do indeed remain crucial to the system's overall normative pluralism.<sup>9</sup> All the same, my concern is that underspecifying the

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<sup>4</sup> Jennifer Rothman, *Navigating the Identity Thicket: Trademark's Lost Theory of Personality, The Right of Publicity, and Preemption*, 135 HARV. L. REV. 1271 (2022). The phrase originates in courts' observation that "[t]he right to do business under one's own name is one of the sacred rights known to the law." *Tomsky v. Clark*, 238 P. 950, 952 (Cal. Dist. Ct. App. 1925); *Ida May Co. v. Ensign*, 66 P.2d 727, 729 (Cal. Dist. Ct. App. 1937); see also 2 RUDOLF CALLMANN, *THE LAW OF UNFAIR COMPETITION AND TRADE-MARKS* § 85.2 (1945) (quoting case law).

<sup>5</sup> Rothman, *supra* note 4, at 1276.

<sup>6</sup> *Id.*

<sup>7</sup> *Id.* at 1336–49 (Part V).

<sup>8</sup> Rothman identifies "autonomy and dignity" as the twin strands of this theory. *Id.* at 1276. Given that the two are analytically distinct, my focus herein is on autonomy rather than dignity, though some of my arguments may be fruitfully extended to the latter.

<sup>9</sup> See WILLIAM TWINING & DAVID MIERS, *HOW TO DO THINGS WITH RULES* 6 (2010) ("Normative pluralism is said to occur when two or more normative orders coexist in the same time-

form and content of autonomy and dignity at play in the rules relating to personal marks gives consequentialist<sup>10</sup> arguments within the system strategic cover in undesirable ways, some of which Rothman's own argument hints at.

My argument begins by examining three different senses in which the idea of autonomy might operate within trademark law's rules relating to personal marks and shows that each of them is critically incomplete or too weak to independently sustain the justificatory burden for the domain. It then examines the worrisome possibility that courts' allusions to autonomy here are little more than a trope for other considerations. It finally looks at how a genuine commitment to autonomy might be integrated into the principally market-driven framework of trademark law.

## I. SACRED RIGHTS AND THE PUZZLE OF AUTONOMY

In what sense does trademark law's treatment of personal marks further the normative ideal of individual autonomy? While Rothman's account associates a justification based on autonomy and dignity with each of trademark law's rules for personal marks, the area as a whole embodies three plausible conceptions of autonomy. Each suffers from serious limitations as a standalone justification for the law's treatment of personal marks.

### A. *Autonomy in Identity Ownership?*

The first plausible conception of autonomy underlying personal marks derives from their status as property. This conception takes root in the treatment of the "identity" embodied in personal marks as an *owned* object. The connection between ownership and autonomy has of course been the subject of extensive scholarship and debate.<sup>11</sup>

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space context." For my own efforts to defend such pluralism in the face of an increasing emphasis on utilitarianism in intellectual property, see Shyamkrishna Balganes, *Intellectual Property Law and Redressive Autonomy*, in 1 OXFORD STUDIES IN PRIVATE LAW THEORY 161, 161 (Paul B. Miller & John Oberdiek eds., 2020) [hereinafter Balganes, *Redressive Autonomy*]; Shyamkrishna Balganes, *Privative Copyright*, 73 VAND. L. REV. 1, 5 (2020); Shyamkrishna Balganes, *The Normativity of Copying in Copyright Law*, 62 DUKE L.J. 203, 233 (2012); and Shyamkrishna Balganes, *The Pragmatic Incrementalism of Common Law Intellectual Property*, 63 VAND. L. REV. 1543, 1574 (2010).

<sup>10</sup> Consequentialism argues that "normative properties depend only on consequences." Walter Sinnott-Armstrong, *Consequentialism*, in STANFORD ENCYCLOPEDIA OF PHILOSOPHY (Edward N. Zalta ed., 2021), <https://plato.stanford.edu/archives/fall2021/entries/consequentialism> [<https://perma.cc/BH42-NHDT>]. Paradigmatic of consequentialism is utilitarianism. *Id.*

<sup>11</sup> See, e.g., HANOCH DAGAN, A LIBERAL THEORY OF PROPERTY 3–5 (2021); JEREMY WALDRON, THE RIGHT TO PRIVATE PROPERTY 23–24 (1990); Stephen Kershnar, *Private Property Rights and Autonomy*, 16 PUB. AFFS. Q. 231 (2002); Dudley Knowles, *Hegel on Property and Personality*, 33 PHIL. Q. 45 (1983); Alan Patten, *Hegel's Justification of Private Property*, 16

Ownership in this conception functions as a vehicle for individual self-determination. Property rights facilitate and contribute to human autonomy by enabling individuals to exercise forms of control over objects that are the subject of such rights.<sup>12</sup> This ownership-driven autonomy is therefore analogous to the notion of positive liberty and is decidedly dependent on other additional conditions (for example, primary goods) for its full realization.<sup>13</sup>

Yet central to the autonomy underlying ownership is the existence of an *external* object that functions either as the end of such autonomy or as the means through which such autonomy is realized.<sup>14</sup> To Hegel, for instance, property represents the actualization of the human will (“personality”) in the natural world, and it is through such property that the will realizes itself.<sup>15</sup> In other words, the object mediates the relationship between the individual and the outside world, and it is such mediation that helps realize the individual’s autonomy.<sup>16</sup> To speak of an individual’s identity as the subject of an ownership interest is largely metaphorical, since it is hardly external in the same sense and resonates only ever tangentially with ownership-driven autonomy.

A variant that has on occasion been put forth as a mechanism of getting around the externalization concern with ownership-driven autonomy is the notion of “self-ownership,” which Rothman identifies as one justificatory strand in the personal-marks jurisprudence.<sup>17</sup> With the idea of self-ownership, the argument is that ownership of one’s self — that is, of one’s body — is necessary for human autonomy, since without it humans are subject to being treated as means to ends and not ends in

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HIST. POL. THOUGHT 576 (1995); Howard Williams, *Kant’s Concept of Property*, 27 PHIL. Q. 32 (1977).

<sup>12</sup> DAGAN, *supra* note 11, at 2 (noting how property provides individuals with “some temporally extended control over tangible and intangible resources, which they need in order to carry out their projects and advance their plans”). For a similar account that relies on Hegel’s theory of ownership, see Margaret Jane Radin, *Property and Personhood*, 34 STAN. L. REV. 957, 957 (1982) (“[T]o be a *person* — an individual needs some control over resources in the external environment.”).

<sup>13</sup> See DAGAN, *supra* note 11, at 2, 3 (acknowledging this reality and describing it as the requirement of robust background conditions).

<sup>14</sup> See *id.* at 50; Radin, *supra* note 12, at 957.

<sup>15</sup> ALAN PATTEN, *HEGEL’S IDEA OF FREEDOM* 144 (2002).

<sup>16</sup> *Id.*

<sup>17</sup> Rothman, *supra* note 4, at 1297. See generally G.A. COHEN, *SELF-OWNERSHIP, FREEDOM, AND EQUALITY* (1995); George G. Brenkert, *Self-Ownership, Freedom, and Autonomy*, 2 J. ETHICS 27 (1998); Kasper Lippert-Rasmussen, *Against Self-Ownership: There Are No Fact-Insensitive Ownership Rights over One’s Body*, 36 PHIL. & PUB. AFFS. 86 (2008); Alan Ryan, *Self-Ownership, Autonomy, and Property Rights*, 11 SOC. PHIL. & POL’Y 241 (1994); Robert S. Taylor, *A Kantian Defense of Self-Ownership*, 12 J. POL. PHIL. 65 (2004). For a slightly different version of self-ownership, focused on individual identity, see Edward Feser, *Personal Identity and Self-Ownership*, 22 SOC. PHIL. & POL’Y 100 (2005).

themselves.<sup>18</sup> While facially attractive, this argument breaks down on closer scrutiny, since it is predicated on contingent truths about the ways in which humans relate to their bodies, around which the underlying conditions of necessity revolve.<sup>19</sup> As philosophers have argued, autonomy — in the thick sense of being able to plan one’s life — is hardly contingent on such self-ownership, even if in practice such ownership furthers such plans.<sup>20</sup> Extended to an intangible disconnected from the actual physical body — that is, one’s identity — the link between self-ownership and autonomy breaks down even further, since the *res* being controlled (identity) is to a large extent notional and hardly the unilateral creation of the putative owner (as opposed to a social construct).

Rothman’s discussion of “personal goodwill” rather vividly captures the concern with the need for an external object in discussions of ownership-autonomy.<sup>21</sup> Insofar as a hallmark of such goodwill is its inseparability from an individual, it is treated by the law as inalienable.<sup>22</sup> Yet ironically it is such inalienability — deriving from the inseparability — that calls into question the very claim that there is an ownership interest in identity that in turn furthers individual autonomy. Instead, it highlights the absence of an external object that is the basis of such autonomy. While ownership can thus contribute to individual autonomy, control over one’s identity (even as ownership) through a personal mark hardly does the same and risks producing an indelible circularity: control by law being justified as furthering autonomy when the autonomy inheres in that very control.

### B. *Autonomy Preservation in Identity Use?*

Another conception of autonomy that could justify the law’s treatment of personal marks eliminates the mediating role of ownership and focuses instead directly on the role of identity in furthering the individual’s agency. An individual’s use of their identity is autonomy-enhancing insofar as such identity allows the individual to determine their relationship to others in the world. A core aspect of the law of personal marks was its refusal to impede an individual’s ability to use their identity in trade by granting another a monopoly over a mark, a right that was described in the jurisprudence as a “natural right” to use one’s own name.<sup>23</sup> By restricting the trademark monopoly from extending to personal names, the law might therefore be seen as protecting a sphere of

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<sup>18</sup> See COHEN, *supra* note 17, at 116–17. Ironically, Kant himself rejected the idea of self-ownership since persons were not things in his classification. IMMANUEL KANT, LECTURES ON ETHICS 165–66 (Louis Infield trans., Harper & Row 1963) (1930).

<sup>19</sup> See Lippert-Rasmussen, *supra* note 17, at 117.

<sup>20</sup> See COHEN, *supra* note 17, at 230, 240; Lippert-Rasmussen, *supra* note 17, at 117–18.

<sup>21</sup> See Rothman, *supra* note 4, at 1311–14.

<sup>22</sup> *Id.* at 1313.

<sup>23</sup> See *id.* at 1299; HARRY D. NIMS, THE LAW OF UNFAIR COMPETITION AND TRADEMARKS § 69, at 174–77 (3d ed. 1929) (quoting case law).

autonomy from incursion. While on its face this argument may seem intuitive, on deeper scrutiny it hides more than it reveals.

To begin with, it is important to appreciate the analytical structure of the autonomy-based argument that is at play. The domain of individual autonomy involved in this conception is logically antecedent to trademark law. In other words, all that the rules relating to personal marks do here is to minimize the reach of trademark law's grant of exclusivity by preventing it from interfering with an individual's trademark-independent use of their identity (in or outside of commerce). These rules do little to protect an individual's affirmative use of identity, even in commerce, except to characterize such use as "natural."<sup>24</sup> Trademark law's rules on personal marks thus at best *preserve* an individual's autonomy in the use of their name (or other aspect of identity), and it is in this preservation that these rules could be seen as motivated by autonomy. Yet two cumulative aspects of this claim weaken its import further.

First, as a purely analytical matter, the harm — or autonomy interference — that the law is protecting against in this conception is one that is entirely a creation of trademark law's own grant of an exclusive right to a markholder. Recall that the autonomy incursion in question is meant to arise when a markholder attempts to enjoin an individual from using their own name in trade, something that is only made possible because of the right that trademark law grants holders. Absent such a right, the individual's use autonomy would not be implicated, *qua* this conception. And to the extent that the attempt to enjoin such use comes from other domains, the limited protection afforded by trademark law is meaningless, since it has little spillover value outside of that domain. In a sense, therefore, what is described as autonomy-preservation might be well recast as a definitional aspect of the right at issue. Yet what this reveals is the artificiality of the connection to autonomy, which is fairly contrived. If it is in this sense that the rules relating to personal marks relate to the autonomy of individuals, it is at best a weak connection.

Second, and despite the rhetoric about the right (to the use of one's own name in trade) being "natural" and "absolute,"<sup>25</sup> courts have long remained willing to prevent such use when it was seen as an act of unfair competition — a category within which they have included a whole host of presumptively problematic behavior, including deception and passing off.<sup>26</sup> Rothman recognizes that these limits undermined the absolute

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<sup>24</sup> See, e.g., *Chas. S. Higgins Co. v. Higgins Soap Co.*, 39 N.E. 490, 491 (N.Y. 1895) ("The right of a person to use his family name in his business is regarded as a natural right, of which he cannot be deprived, by reason simply of priority of use by another of the same name.")

<sup>25</sup> See, e.g., *Meneely v. Meneely*, 62 N.Y. 427, 431 (1875) ("[E]very man has the absolute right to use his own name in his own business.")

<sup>26</sup> See *id.* at 431–33 (collecting cases).

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nature of the right and acknowledges that the right was never truly absolute,<sup>27</sup> yet she notes that courts nevertheless accorded dishonest defendants “latitude” to continue to use their names for honest commercial purposes when constructing their injunctions.<sup>28</sup> True as that may well be, the very presence of a basis on which courts policed the exercise of these rights suggests an even narrower concern with autonomy than what the preservation claim implies. Put another way, the law merely sought to preserve a domain of use for honest commercial uses by individuals of their own names when trademark law was likely to interfere with such use. Such *honest commercial* use is hard to see as based on an *absolute* right of autonomy.

The autonomy-preservation claim may well reflect “respect” for a defendant’s “personality rights” over the rights of the trademark holder, as Rothman points out.<sup>29</sup> Yet such respect does not on its own offer the domain a sufficiently robust standalone justification that is rooted in a concern with individual autonomy.

### C. *Autonomy by Preventing Identity Misuse?*

The most plausible conception of autonomy that justifies this domain of trademark law originates in the flip side of the identity use just described — that is, in situations where the law does not just preserve an individual’s use of their own name, but also empowers that individual to prevent the unauthorized use of their name by others in commerce. Trademark law also seeks to prevent the misuse of personal marks by individuals and entities having no connection to the identity embodied in the mark, by requiring for such use the consent of the individual whose identity is to be used.<sup>30</sup> The Gandhi episode discussed earlier is illustrative.<sup>31</sup> All the same, the requirement applies only when the use is commercial.

Consequently, the rules relating to personal marks may be seen as protecting an individual’s autonomy by guarding against inauthentic market-based uses of the individual’s identity. Insofar as such (mis)use in commerce interferes with the individual’s ability to use their identity to interact with the outside world — even independent of the market — trademark law offers the individual a modicum of protection. In other words, a defendant’s use in commerce becomes unlawful quite independently of the plaintiff’s own use, protection that may be seen as moderately autonomy-enhancing.

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<sup>27</sup> Rothman, *supra* note 4, at 1276, 1303–05.

<sup>28</sup> *Id.* at 1304.

<sup>29</sup> *Id.*

<sup>30</sup> *See id.* at 1307–09.

<sup>31</sup> *See supra* p. 343.

Much like the prior version of autonomy just discussed, this version too is obviously a negative one in the sense of eliminating obstacles to an individual's realization of their own goals.<sup>32</sup> All the same, it is fundamentally different from the autonomy-preservation variant, insofar as the infraction that it offers protection against is not an artificial by-product of trademark's monopoly, but instead a form of harm that might arise from trademark-independent behavior (that is, impersonation). And it is also affirmative in the limited sense of affording the individual a mechanism of redress at private law.<sup>33</sup> Yet, being principally negative in analytical structure, it requires a clearer understanding of how it seeks to eliminate — albeit through private redress — an interference with autonomy. As we shall see, that autonomy is principally a market-based commercial one — that is, in the use of one's identity in commerce — which needs to be acknowledged.

At times, *Navigating the Identity Thicket* appears to suggest that the autonomy at stake is more than just a market-based one. Rothman, for instance, concedes that while the negative protection is “*partially* rooted in market-based concerns of identity-holders,” it is “*also* rooted in protecting a person's dignity and autonomy.”<sup>34</sup> What Rothman appears to be suggesting is that an unauthorized use of another's identity in the marketplace not just impedes that individual's own use of their identity in the marketplace, but also influences that individual's perceived relationship to the outside world. What this still does not fully answer is just how the unauthorized “use in commerce”<sup>35</sup> interferes with the individual's own identity outside of that commercial context — that is, its spillover effects — so as to raise it beyond “market-based concerns.”<sup>36</sup> To take an example from the article, how exactly did the sale of

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<sup>32</sup> The idea of negative autonomy tracks Isaiah Berlin's famous idea of negative liberty. See ISAIAH BERLIN, *TWO CONCEPTS OF LIBERTY* 15–16 (1958); see also A.S. Kaufman, Discussion, *Professor Berlin on “Negative Freedom,”* 71 MIND 241 (1962). For extensions of the negative framing into the realm of autonomy, see Michael J. Meyer, *Stoics, Rights, and Autonomy*, 24 AM. PHIL. Q. 267, 267 (1987) (describing negative autonomy in terms of not being “directed by another”). For a critique, see ROBERT YOUNG, *PERSONAL AUTONOMY: BEYOND NEGATIVE AND POSITIVE LIBERTY* 4 (Routledge 2017) (1986).

<sup>33</sup> See Balganes, *Redressive Autonomy*, *supra* note 9, at 161. This is in contrast to the entitlement structure of the putative autonomy claim in the prior variant, which focuses on the overbreadth of trademark protection. Autonomy in that variant is more in the nature of a Hohfeldian immunity, whereas here it partakes of a power. See Wesley Newcomb Hohfeld, *Fundamental Legal Conceptions as Applied in Judicial Reasoning*, 26 YALE L.J. 710, 710 (1917).

<sup>34</sup> Rothman, *supra* note 4, at 1306 (emphases added).

<sup>35</sup> For a general account of trademark law's “use in commerce” requirement and its connection to commerciality, see Graeme B. Dinwoodie & Mark D. Janis, *Confusion over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597, 1609–15 (2007). The requirement of “use in commerce” is codified in the Lanham Act, Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified as amended in scattered sections of 15 U.S.C.), as a limitation on both protectability, see 15 U.S.C. § 1127, and infringement, see 15 U.S.C. § 1114.

<sup>36</sup> Rothman, *supra* note 4, at 1306.

“Dewey’s Chewies” affect Admiral George Dewey’s ability to use his good name outside of the market?<sup>37</sup>

Now, if the answer is that it interfered with the Admiral’s ability to sell his own brand of chewies, or license the use of his market, the concern is obviously less about autonomy and instead is a “market-based” one.<sup>38</sup> The unauthorized use certainly would not have impeded the Admiral’s use of his name in the noncommercial context unless the unauthorized use of the chewies was so extensive as to make the Admiral’s name unrecognizable in any other context, including noncommercial ones, which is very unlikely. If that were true — or even likely to occur — a clear case might indeed be made for the harm to autonomy that the Admiral might suffer. But the only sense in which it is likely to have interfered with the Admiral’s use of his name is in shaping his commercial interactions, by denying him the choice of whether to be represented as associated with or endorsing the chewies being sold under his name. Yet these are primarily “market-based concerns,”<sup>39</sup> rendering it unclear how the law goes beyond them to considerations of autonomy — other than by invoking the idea of individual identity.<sup>40</sup>

To be clear, a market-based autonomy rooted in the commercial representation of one’s identity is no doubt a form of autonomy. All the same, it is again an extremely narrow form of protection for individual autonomy against impersonation, one that is restricted to the market and the realm of commerce. Further, it is analytically unclear how and why this protection — *qua* autonomy — is any different from the protection against misuse accorded to a made-up name (such as a corporate name), except that the law identifies the connection as being natural in one and not in the other.

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<sup>37</sup> *Id.* at 1308–09.

<sup>38</sup> *Id.* at 1306.

<sup>39</sup> *Id.*

<sup>40</sup> One way of recognizing the nonmarket harm that Dewey might suffer would be to focus on the harm to his reputation (rather than his use of his identity) that might have come about through the unauthorized use of his name. Harm to reputation is undoubtedly a dignitary harm, and as such derives from the normative ideal of dignity. Yet dignity is distinct from autonomy. Whereas autonomy is about control and self-determination, dignity focuses on self-respect and value, and is a decidedly relational ideal. In prior work, Rothman does an excellent job of distinguishing the two. See Robert C. Post & Jennifer E. Rothman, *The First Amendment and the Right(s) of Publicity*, 130 YALE L.J. 86, 121 (2020) (“If the value of autonomy strives to promote the *independence* of persons, the value of dignity presupposes and protects their *interdependence*.”). To be sure, Rothman invokes both autonomy and dignity in her narrative, though it is not clear if she sees the two as interconnected within the domain of the personal market. See Rothman, *supra* note 4, at 1294–318. My focus herein is limited to autonomy.

Each of these conceptions of autonomy remains unsatisfactory as a *stand-alone* justification for trademark law's treatment of personal marks. Each is hampered by serious limitations internal to the doctrines involved, which significantly curtail the law's potential focus on autonomy and call into question the extent to which such autonomy is indeed at the heart of the law's treatment of personal marks.

## II. AUTONOMY AS RATIONALIZATION

Despite embracing the idea that trademark law's treatment of personal marks emanates primarily from considerations of autonomy and dignity, *Navigating the Identity Thicket* nevertheless concedes in multiple places that these considerations routinely overlap with other market-based ones.<sup>41</sup> This overlap raises two concerns. The first is that the rhetoric and language of autonomy and personality are little more than mechanisms for courts to rationalize their consequentialist intuitions in the language of morality so as to render them more palatable to audiences. And the second is that autonomy as a normative value is notoriously difficult to integrate with other consequentialist or utilitarian values without undermining its very nature. This Part focuses on the first, while the next addresses the second.

Regardless of whether “[w]e are all [L]egal [R]ealists now,”<sup>42</sup> one of the enduring lessons of Legal Realism is its revelation that the formal reasoning seen in judicial opinions routinely fails to capture the full extent of judges' influences and motivations in deciding cases.<sup>43</sup> This lack of candor and transparency came to be explained either as driven by bad faith, wherein judges actively conceal the real basis of their decisionmaking for fear that it will betray their biases,<sup>44</sup> or instead as the simple result of a mismatch between the “hunch” or intuition at the heart of the decision and the available criteria for the judge to employ in the opinion.<sup>45</sup> In either case, Legal Realists believed judges' real bases for their decisions to be covered up in their formal reasoning, a process known as “rationalization.”<sup>46</sup>

<sup>41</sup> E.g., Rothman, *supra* note 4, at 1298, 1306, 1324, 1330.

<sup>42</sup> Joseph William Singer, Review Essay, *Legal Realism Now*, 76 CALIF. L. REV. 465, 467 (1988).

<sup>43</sup> See Brian Leiter, *Legal Realism and Legal Doctrine*, 163 U. PA. L. REV. 1975, 1975 (2015) (“What the Legal Realists taught us is that too often the doctrine that courts invoke is not really the normative standard upon which they *really* rely.”).

<sup>44</sup> For an extreme version of this argument, see generally JEROME FRANK, *LAW AND THE MODERN MIND* (1930). See also Brian Leiter, *Rethinking Legal Realism: Toward a Naturalized Jurisprudence*, 76 TEX. L. REV. 267, 268 (1997) (collecting similar accounts).

<sup>45</sup> See Joseph C. Hutcheson, Jr., *The Judgment Intuitive: The Function of the “Hunch” in Judicial Decision*, 14 CORNELL L.Q. 274, 285 (1929).

<sup>46</sup> Leiter, *supra* note 44, at 267; see also Max Radin, *The Theory of Judicial Decision: Or How Judges Think*, 11 A.B.A. J. 357, 361 (1925). The notion of rationalization is traced back to Freud's

Rothman is undoubtedly correct to observe that the language of cases dealing with rights in personal marks hints at considerations of autonomy, dignity, and personality. The references to “sacred” rights, “natural and inalienable rights,” and the like suggest the existence of a deontic rationale for these rules.<sup>47</sup> It is, however, possible that this deontic terminology is little more than a formalization of other nondeontic considerations. These considerations need not encompass the formal idea of efficiency; however, the looming presence of the market and commerce in relation to all of the cases that address personal marks cannot be ignored, because it hints at the possibility of consequentialist considerations driving the outcomes.

One explanation for this mismatch is of course the possibility of bad faith reasoning among judges, something that the Realists emphasized. In this version, the real — consequentialist and utilitarian — considerations are consciously hidden from the public reasoning of a judicial opinion and replaced instead with more acceptable arguments from deontic morality. One need not, however, accept this extreme version (of bad faith reasoning) for the same logic of mismatch to be explanatorily significant. A more benign explanation for the mismatch might be found in a phenomenon best described as “radical semantic evaluation,” developed by Professor Jody Kraus as a philosophical defense of explanatory economic analysis in the common law.<sup>48</sup>

On this account, common law terms and concepts that originate with a distinctively deontic meaning, such as “right” and “duty,” over time assume nondeontic, or consequentialist meaning by virtue of their being embedded in a system that is motivated by such nondeontic considerations.<sup>49</sup> This evolution is fueled by the facial indeterminacy of such terms, which allows for their infusion with such contextually determined meaning.<sup>50</sup> Such semantic evolution results in participants within the system coming to understand their deployment of such concepts as having a distinctive meaning within the system of practice that they are in, often one that is removed from their original semantic meaning taken in the abstract.

Radical semantic evolution might well explain the role of terms found in the personal-marks jurisprudence, which semantically imply an autonomy-driven emphasis in the doctrine, one that is nevertheless

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work, which Legal Realism deployed. See LAURA KALMAN, *LEGAL REALISM AT YALE, 1927–1960*, at 20 (1986).

<sup>47</sup> Rothman, *supra* note 4, at 1299 (quoting, *inter alia*, *Tomsky v. Clark*, 238 P. 950, 952 (Cal. Dist. Ct. App. 1925); *Hilton v. Hilton*, 104 A. 375, 376 (N.J. 1918)).

<sup>48</sup> Jody S. Kraus, *Transparency and Determinacy in Common Law Adjudication: A Philosophical Defense of Explanatory Economic Analysis*, 93 VA. L. REV. 287, 303 (2007); see also RICHARD A. POSNER, *HOW JUDGES THINK* 238 (2008).

<sup>49</sup> See Kraus, *supra* note 48, at 328–29.

<sup>50</sup> *Id.* at 332.

hard to square with its working. Terms such as “natural,” “sacred,” and “inalienable”<sup>51</sup> used to describe the “so-called ‘absolute right’”<sup>52</sup> that an individual presumptively has in their own name certainly suggest the presence of deontic considerations, semantically. All the same, even insofar as these terms are used to invoke considerations of identity use (and misuse), the context of their deployment within a market setting — that is, in the regulation of uses in commerce — arguably gives them a contextual meaning that is consequentialist in orientation. In other words, the *right* to use one’s name for a commercial purpose, or to prevent the unauthorized use of one’s name by another in commerce, may relate to the individual’s identity, but the commercial use of a name imbues it with a different meaning: as a preferential entitlement to trade using one’s own name, a preference that is predicated on a balancing of competing consequentialist considerations.

At least part of the reason, one suspects, for trademark law’s reliance on the language of deontic morality for its doctrinal content in this area is the close connection between the law relating to personal marks and the domains of privacy law and publicity rights, both of which have significantly firmer nonconsequentialist roots principally as a result of their not being limited to commerce. This is a reality that Rothman acknowledges when she notes that claims relating to personal marks were usually brought in conjunction with claims from these other areas.<sup>53</sup> Consequently, it is not surprising that courts borrowed the same language to describe the nature of the interest involved in personal marks, even when the context was unquestionably utilitarian.

The possibility of such semantic evolution in the normative content of the concepts involved is supported by a cursory examination of the manner in which more modern courts deploy the language of the early jurisprudence in opinions that Rothman discusses. For instance, Rothman analyzes the 1875 case of *Meneely v. Meneely*,<sup>54</sup> which found an injunction restraining a defendant from making any use of his own name in trade to be overbroad, in the process implying deontic origins for the entitlement and describing the defendant’s claim as driven by an “absolute right.”<sup>55</sup> By 1966, we see this view shifting in the same court, the New York Court of Appeals.<sup>56</sup> Even though the court continued to refer to the entitlement in the use of one’s own name in trade as a “right,” it was equivocal about the deontic origins of the right, referring to it as originating in the “so-called ‘sacred right’ theory” and emphasizing that

<sup>51</sup> Rothman, *supra* note 4, at 1299 (quoting, inter alia, *Tomsky*, 238 P. at 952; *Hilton*, 104 A. at 376).

<sup>52</sup> *Id.* at 1304.

<sup>53</sup> *Id.* at 1297.

<sup>54</sup> 62 N.Y. 427 (1875).

<sup>55</sup> *Id.* at 431.

<sup>56</sup> *David B. Findlay, Inc. v. Findlay*, 218 N.E.2d 531 (N.Y. 1966).

this did not render it “unlimited,” despite what the term might imply.<sup>57</sup> The majority opinion in that case consciously sought to distance itself from the implicit reasoning of *Meneely*,<sup>58</sup> which a dissent readily called out.<sup>59</sup> The majority’s response was merely that “[t]he present trend of the law is to enjoin the use even of a family name” when there was a tendency of potential confusion in the marketplace,<sup>60</sup> more than suggesting (a) that the “right” was a relational entitlement that required balancing, and (b) that it was equally driven by commercial considerations.

Perhaps then, we should be more circumspect about taking courts’ use of deontic language to imply a commitment to autonomy, dignity, or other moral concerns in developing the law, and examine whether a combination of the language and its contextual application indeed merits being seen as a commitment to such concerns in practice.

### III. INTEGRATING AUTONOMY INTO THE THEORY OF PERSONAL MARKS

Assuming for a moment that *a* conception of autonomy is indeed behind some or all of trademark law’s rules relating to personal marks, the critical question that this then raises is whether such autonomy remains functionally compatible with the other consequentialist values that operate in the domain. As we have seen, courts acknowledge that even in relation to personal marks, commercial considerations (predominantly utilitarian) are important in their framing of the relevant rules.<sup>61</sup> How exactly then is autonomy to be integrated with these overtly consequentialist normative considerations?

Rendering autonomy compatible with other normative values is far from straightforward and is at the root of the concern with incommensurability that has been a staple of debates about the confluence of deontological and consequentialist values within legal doctrine.<sup>62</sup> For

<sup>57</sup> *Id.* at 534 (emphasis added). Indeed, the court began its opinion with the observation: “When should a man’s right to use his own name in his business be limited? This is the question before us.” *Id.* at 532.

<sup>58</sup> *See id.* at 534–35.

<sup>59</sup> *Id.* at 535–36 (Burke, J., dissenting).

<sup>60</sup> *Id.* at 534 (majority opinion).

<sup>61</sup> *See, e.g.,* *Meneely v. Meneely*, 62 N.Y. 427, 431–32 (1875); *Findlay*, 218 N.E.2d at 534.

<sup>62</sup> For leading work on incommensurability in philosophy, see ELIZABETH ANDERSON, *VALUE IN ETHICS AND ECONOMICS* (1993); and INCOMMENSURABILITY, INCOMPARABILITY, AND PRACTICAL REASON (Ruth Chang ed., 1997). For applications of the idea in law, see Matthew Adler, *Incommensurability and Cost-Benefit Analysis*, 146 U. PA. L. REV. 1371 (1998); Bruce Chapman, *Law, Incommensurability, and Conceptually Sequenced Argument*, 146 U. PA. L. REV. 1487 (1998); Richard Craswell, *Incommensurability, Welfare Economics, and the Law*, 146 U. PA. L. REV. 1419 (1998); Richard A. Epstein, *Are Values Incommensurable, Or Is Utility the Ruler of the World?*, 1995 UTAH L. REV. 683; Cass R. Sunstein, *Incommensurability and Valuation in Law*, 92 MICH. L. REV. 779 (1994); and Francisco J. Urbina, *Incommensurability and Balancing*, 35 OXFORD J. LEGAL STUD. 575 (2015).

the idea of autonomy to remain true to its deontological orientation and yet coexist side by side with instrumental considerations within an area, it is crucial for that area to develop a mechanism that integrates the two without requiring either to abandon its foundational tenets. In identifying an autonomy-focused justification for personal marks within the overall utilitarian framework of trademark law, *Navigating the Identity Thicket* introduces autonomy into the mix of normative values influencing the area. Critical to the success of this identification is the presence of a methodology of pluralism that allows autonomy to function within trademark law, without undermining the rest of the domain's core normative tenets.

While I do not purport to have a comprehensive answer to this challenge, the overall orientation of the doctrine lends itself to a strategy of normative pluralism that some have described as “vertical,” insofar as it advances a “unified theory” with “logically distinct” components.<sup>63</sup> Versions of such integration can be seen in the theories of Kant, Rawls, and legal scholars attempting to reconcile autonomy and consequentialist goals (most commonly efficiency) in the working of legal doctrine, by ordering them lexically and then sequencing the manner in which they are considered as part of the analysis.<sup>64</sup>

Adopting this framing for trademark law's treatment of personal marks, one might therefore argue that the law begins with the recognition of a natural (or moral) right in individuals to control their representation in the world, and thereupon comes to qualify that right sequentially in recognition of the utilitarian framework that the right is being deployed into. The key to the success of this integration strategy is, however, the analytical separation of the autonomy-focused inquiry from the utilitarian one, even if they are both ultimately components of the same adjudicatory framework. In other words, the concern with autonomy ought to be given full and independent ventilation, and only thereafter should it come to be qualified by utilitarian considerations deriving from the overall orientation of the system. What then might this look like in practice?

As an illustration, consider cases that allow a plaintiff to enjoin a defendant's misuse of their identity when the defendant deploys the plaintiff's name in commerce without prior consent. The first step in the inquiry would begin with an examination of the extent to which a plaintiff's concern with individual autonomy is implicated by the

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<sup>63</sup> Jody S. Kraus, *Reconciling Autonomy and Efficiency in Contract Law: The Vertical Integration Strategy*, 11 PHIL. ISSUES 420, 421 (2001).

<sup>64</sup> See, e.g., Chapman, *supra* note 62, at 1507–12 (Epstein and Hart); Kraus, *supra* note 63, at 423–25 (Rawls); Ernest J. Weinrib, *Deterrence and Corrective Justice*, 50 UCLA L. REV. 621, 632–38 (2002) (Kant). For a definition of lexical ordering, see Adam M. Samaha, *If the Text Is Clear — Lexical Ordering in Statutory Interpretation*, 94 NOTRE DAME L. REV. 155, 162 (2018) (“Successful lexical ordering creates a particular kind of priority among considerations that might be used to make a single decision.”).

defendant's behavior. Instead of relying purely on the rhetoric of a "natural" or "sacred" right, the inquiry should instead scrutinize the defendant's behavior and the extent to which it is likely to interfere with a plaintiff's ability to represent themselves to the external world — both in commerce and potentially beyond (perhaps analogous to the inquiry in blurring). If that risk is nonexistent or negligible, that should be the end of the inquiry. Otherwise, the inquiry should move to the second step, looking to the practical and introducing various utilitarian considerations into the equation, most of which will be defendant- and public-focused. This framing would introduce a measure of sequenced lexical ordering into the inquiry,<sup>65</sup> which would separate autonomy and non-autonomy considerations during the analysis.

As with any form of lexical ordering or sequenced analysis, the separation is easier to achieve in theory than it is in practice. Courts will of course invariably blend the two in practice. Yet such sequencing will have the salutary effect of acknowledging — beyond plain rhetoric — the plausibility that autonomy, as a separate normative concern underlying personal marks, has a role to play in the construction of the cause of action at issue. And once this happens, it will be on courts to determine whether their deployment of the deontic logic of morality into this domain is more than just rhetorical, or instead a true embrace of normative pluralism.

#### CONCLUSION

*Navigating the Identity Thicket* does an excellent job of laying bare a puzzle that appears to have plagued trademark jurisprudence for over a century now. All the same, in embracing the plausibility of autonomy and other deontic concerns motivating the law of personal marks, it stops short of addressing the larger puzzle of integrating autonomy with the overall commercial (that is, consequentialist) orientation of modern trademark law, an orientation that is neither superficial nor recent but rather well entrenched in today's trademark law thinking.<sup>66</sup>

In so doing, Rothman accepts the idea that autonomy is doing serious normative work in this domain. My principal concerns with the article's argument are thus twofold: (1) that we ought to be doing more than just accepting courts' framing (and rhetoric) before believing that autonomy drives the decisionmaking in this domain, even if only partially; and (2)

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<sup>65</sup> See Kraus, *supra* note 63, at 423.

<sup>66</sup> See Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 623–24 (2004) (noting how law and economics "has long offered a . . . definitive theory of American trademark law," *id.* at 623, and that "[t]he influence of this analysis is now nearly total," *id.* at 624); Jeremy N. Sheff, *Marks, Morals, and Markets*, 65 STAN. L. REV. 761, 765 (2013) ("The dominant theoretical account of trademark law today comes from the law and economics movement of the Chicago School.").

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that even if we accept this as true, the modality of autonomy's functioning therein deserves further reflection.

None of this should take away from the serious contribution that the article makes to both trademark law and broader theorizing in intellectual property scholarship, which, for the most part, has assumed a utilitarian stance without additional scrutiny. Courts and scholars continue to puzzle over the anomalous nature of trademark's rules relating to personal marks, an anomaly that may well result in their eventual abandonment.<sup>67</sup> Rothman's article suggests to such skeptics that they would do well to pause and recalibrate their own normative lenses before scrutinizing this domain, and that utilitarianism and commerciality may in fact not exhaust the list of trademark law's foundational values.

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<sup>67</sup> For an account of a recent effort by a court to understand the origins of these rules, see Kyle Jahner, *Identifying Marks Ban Probed in "Trump Too Small" Case*, BLOOMBERG L. (Nov. 3, 2021, 5:17 PM), <https://news.bloomberglaw.com/ip-law/ban-on-person-identifying-marks-probed-in-trump-too-small-case> [<https://perma.cc/VDQ6-3K5A>].