

The First Amendment Trumps Trademark Rights in *Radiance Found, Inc. v. NAACP*



Article By

[Meng Zhong](#)

[Lewis Roca Rothgerber LLP](#)

[Most Valuable Property Blog](#)

- [Constitutional Law](#)
- [Intellectual Property](#)
- [Litigation / Trial Practice](#)
- [4th Circuit \(incl. bankruptcy\)](#)

Tuesday, May 26, 2015

When a pro-life columnist publicized a biting article criticizing the NAACP's stance on abortion rights, the **NAACP** retaliated with a cease and desist letter accusing the columnist of trademark infringement. When the dust settled, the Fourth Circuit Court of Appeals ruled in favor of the columnist, issuing a strongly-worded opinion that criticized the NAACP's attempt to silence free speech. The decision can be found at ***Radiance Found., Inc. v. NAACP***, No. 141568, — F.3d — (4th Cir. May 19, 2015).^[1]

In many ways, the facts of this case are pretty typical in politics. The Radiance Foundation is conservative pro-life, non-profit that operated several websites, including TooManyAborted.com and TheRadianceFoundation.org

In January 2013, Radiance's founder, Ryan Bomberger, posted an article criticizing the NAACP, its alleged ties to Planned Parenthood and its pro-abortion policies.

The article was titled "NAACP: National Association for the *Abortion* of Colored People" (italicize added). The article referred to the NAACP as an "out-of-touch

liberal organization” and accuses its Image Awards (an annual awards show celebrating people of color within the entertainment industry) of honoring “black imagery churned out by often racist, anti-Christian, perpetually sexist, violent and pornographic Hollywood.”

As a result of the article, the NAACP received angry phone calls from those who took issue with the NAACP’s support of abortion. Apparently, the play-on-words in the article’s title also caused confusion among the populace as to actual name of the NAACP. A survey conducted during the subsequent litigation showed that 10% of those surveyed thought the NAACP actually did stand for the “National Association for the Abortion of Colored People.”

The NAACP threatened Radiance with trademark infringement for using the NAACP name in its article. A lawsuit ensued, pitting the trademark right of the NAACP against the First Amendment rights of Radiance.

The NAACP won the first round. After a bench trial, the judge ruled in favor of the NAACP on its claims for trademark infringement and dilution of its trademark. But that victory was short lived. The Fourth Circuit unanimously reversed, not only vacating the judgment for the NAACP on First Amendment grounds, but also directing the trial court to rule in favor of Radiance.

“Trademark protection...comes at a potential cost to free expression,” it held.^[2]

“It is for this reason that an actionable trademark claim does not simply require that the alleged infringer used in commerce the mark that the trademark holder possesses. It also requires that the infringer’s use be “in connection with” goods or services in a manner that is “likely to cause confusion” among consumers as to the goods’ or services’ source or sponsorship.” *Id.*

Based on these fundamental principles, the *Radiance* Court found the trial court made “several errors.” There are many gems in this opinion but at its core, the *Radiance* Court focused on three flaws.

One, trademark infringement requires that Radiance use the NAACP name “in connection” with goods or services. It did not do that in this article. Simply because Radiance used the NAACP mark as part of an article to comment on the NAACP does not constitute using the mark in connection with the sale, distribution or advertising of goods and services. Holding otherwise would, as the *Radiance* Court explains, “neuter[.]” the First Amendment. In other words, the First Amendment protects speech, and criticism is speech.

Second, the *Radiance* Court found that there could not possibly be trademark infringement because there is no likelihood of confusion between Radiance and the NAACP’s good and services. On this point, the *Radiance* Court acknowledged that evidence did show that the article caused people to become confused as to the NAACP’s political stance as well as the NAACP’s name. However, that did not matter because “trademark infringement is not designed to protect mark holders from consumer confusion about their positions on political or social issues” and “confusion about what a particular trademark says or looks like is not relevant for infringement claims.”^[3]

Ironically, the NAACP's prominence backfired. The *Radiance* Court noted that the NAACP is a "renowned civil rights organization" and its "size and stature possesses megaphones all their own." Put it another way, if the NAACP wants to rebut *Radiance's* article, it could easily do so. "[B]ut that does not transform the Lanham Act into an instrument for chilling or silencing the speech of those who disagree with or misunderstand a mark holder's positions or views."^[4]

Finally, with respect to the trademark dilution claim, the *Radiance* Court reiterated that fair use is an absolute defense. Fair use protects criticism. And in the case of the *Radiance* article, it is "difficult to imagine what the article is if not criticism."^[5]

The *Radiance* decision is not just a strongly-worded opinion in favor of the First Amendment. Rather, it emphasizes that the freedom of speech is strongest when applied to the most scathing and disputable commentary. After all, situations like this may draw the most ire of trademark holders but "[i]t is [also] for this reason that law does not leave such speech without protection."^[6]

[1] Available at <http://www.ca4.uscourts.gov/opinions>.

[2] *Radiance Found., Inc. v. NAACP*, slip op. at *8-9 (4th Cir. May 19, 2015).

[3] *Radiance*, slip op. at *23.

[4] *Radiance*, slip op. at *24.

[5] *Radiance*, slip op. at *33.

[6] *Radiance*, slip op. at *36.

©2019 All Rights Reserved. Lewis Roca Rothgerber LLP

Source URL: <https://www.natlawreview.com/article/first-amendment-trumps-trademark-rights-radiance-found-inc-v-naacp>