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What's Wrong with CHEWY VUITON?

Anthony L. Fletcher

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THE PRODUCT WITH THE PARODY TRADEMARK: WHAT'S WRONG WITH CHEWY VUITON?

*By Anthony L. Fletcher**

I. INTRODUCTION: A TALE OF TWO CASES

In the halcyon year of 1960,¹ Anheuser-Bush's BUDWEISER beer was riding the crest of five years of marketing under the slogan "Where there's life . . . there's Bud," and more than a quarter of a century of "Where there's life . . . there's Budweiser." More than forty million dollars' advertising supported the result of surveys showing that "a substantial portion of the public was not only acquainted and familiar with the slogans but also associated the slogans with Budweiser beer."² Chemical Corporation of America (CCA) made and sold "a floor wax which contains an insecticide"³ under the brand name FREEWAX, and advertised it using the catchy slogan "Life on Floors . . . Death on Bugs." When CCA decided to switch to the even catchier slogan "Where there's life . . . there's bugs," it knew of Anheuser's "Where there's life . . . there's Bud." This was a strategically sound admission, because nobody was likely to believe the similarity was coincidence. Shortly after commencing suit, Anheuser obtained a supplemental registration of "Where's there's life . . . there's Bud."⁴

* Senior principal, Fish & Richardson P.C., New York, NY; associate member of the International Trademark Association; member of the Saul Lefkowitz Moot Court Competition Committee; *The Trademark Reporter* Editorial Advisory Board; recipient of the International Trademark Association President's Award, 2003.

1. Singer Elvis Presley returned from two years' Army duty in Germany, the Canton of Geneva in Switzerland gave women the right to vote, *Ben Hur* won the Academy Award for best motion picture, a Soviet missile shot down a U.S. U-2 spy plane over Russia, *To Kill A Mockingbird* was first published, a young American boxer named Cassius Clay won the Olympic Gold Medal and subsequently began his professional career, Dr. Martin Luther King was (briefly) jailed in Atlanta, Georgia, for a traffic infraction, *Lady Chatterley's Lover* was found not obscene by a court (the Old Bailey in London), John F. Kennedy was elected President over close runner-up Vice-President Richard M. Nixon, and the last car was manufactured bearing the DeSOTO automobile brand, *inter alia*.

2. Chem. Corp. of Am. v. Anheuser-Busch, Inc., 306 F.2d 433, 434 (5th Cir. 1962).

3. *Id.* at 435.

4. So says the opinion at 434. The author's attempt to verify the fact on the PTO TESS database discloses only a Principal Register registration of the phrase.

The court endorsed the lower court's enjoining CCA's use of its new slogan. In so doing, it said: "defendant's use of the slogan was confusingly similar to plaintiff's. . . . [T]he rhythm, meter and pictures which appeared at the time that the slogan was used, when taken as a whole, created the impression that defendant's advertising had some connection with the plaintiff or plaintiff's product."⁵ That may be a modest stretch, but it seems plain that the CCA advertising appeared to have some ancestral connection to the BUD advertising, which certainly lent support to the court's "impression [of] some connection."

The court's opinion is a well-written synthesis of vitriol and scant authority.

. . . The gist of this action is that the plaintiff has a property interest in the slogan, built up at great expense, and that it and its products are favorably known as a result of its use of this property right and that the defendant, with full knowledge of the right and with the purpose of appropriating some of the value engendered in the minds of the public by its use has used, and proposes further to make use of, a deceptively similar slogan in a manner that will bring direct financial loss to the plaintiff, both by reason of confusing the source of the defendant's product, and by reason of the peculiarly unwholesome association of ideas when the word "bugs" was substituted for the word "Bud," referring to a food product.⁶

In affirming the trial court's injunction based on Florida unfair competition law (federal jurisdiction rested on diversity of citizenship), the court ruled that under Florida case law⁷ "[a] cause of action may exist where simulation of another's name or slogan causes damage on grounds entirely separate from actual confusion between competitors as to source of the product." It also relied on

5. *Id.* at 435.

6. *Id.* at 437. Similarly, *see*: "We are aware of the fact that the Court should not be swayed by its instinctive reaction upon reading the record that this is a brazen and cheap effort by the defendant below to capitalize on the good will created by the tremendous expenditure in advertising by the plaintiff. This, of course, is not enough to warrant the grant of relief, but any conduct that is of such nature as to fairly reek with unfairness and a callous indifference to the damage that might occur to others from the action taken by it will naturally be examined most carefully by . . . an appellate court whose duty it is to determine whether such conduct falls afoul of any established legal principles. . . . [W]e are not reluctant to conclude that what is here morally reprehensible is also legally impermissible." *Id.* at 438.

7. *Sun Coast, Inc. v. Shupe*, 52 So. 2d 805 (Fla. Sup. Ct., 1951); *Sentco v. McCulloh*, 68 So. 2d 577 (Fla. Sup. Ct. 1953).

III Restatement of the Law of Torts, §§ 730-31: “One’s interest in a trade-mark or trade name came to be protected against simulation, . . . not only on competing goods, but on goods so related in the market to those on which the trade-mark or trade name is used that the good or ill repute of the one type of goods is likely to be visited upon the other.”⁸ The general consensus of the trademark bar by the mid-seventies seemed to be that the case was perhaps a bit thin on legal authority but sound in reasoning and, certainly, in result.⁹

Forty-five years later, LOUIS VUITTON was by one measure ranked the seventeenth most prestigious trademark in the world, and much of the company’s luggage, handbags, and accessories are adorned by distinctive trade dress (some of it copyrighted). A merchant of canine play toys marketed doggy chew toys that were crude plush replicas of the then most-in-demand line of VUITTON bags and accessories. The dog toy bore the brand name CHEWY VUITTON. Dogs seemed to like them; the LOUIS VUITTON brand owners didn’t. Perhaps it was the image of a cheap plush replica encrusted with dried dog drool that offended their proprietary sensibilities. That image seems to be a reasonable analog for the impression of “Where there’s life . . . there’s bugs.” The dog toys survived, after cross motions for summary judgment and an appeal, however.¹⁰

Haute Diggity Dog was in the business of selling products at least some of which mocked prestigious trademarks for others’ products. Others of its “brands” were CHEWNEL NO. 5, FURCEDES, JIMMY CHEW, DOG PERIGNONN, SNIFFANY & CO., and DOGIOR,¹¹ and it aggressively contended that no “reasonable factfinder [could] conclude that there is likelihood of confusion, because it successfully markets its products as parodies of famous marks. . . .”¹² Haute Diggity Dog asserted that it is “precisely because of the [“famous” imitated] mark’s fame and

8. *Chem. Corp. of Am.*, 306 F.2d at 438, citing Restatement (Third) of Torts §§ 730-31 (1998).

9. Author’s recollection.

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

11. These evidently were intended to correlate, respectively, with CHANEL NO. 5 fragrance, MERCEDES automobiles, JIMMY CHOO shoes, DOM PERIGNON champagne, TIFFANY & CO. jewelers, and DIOR fashions and accessories.

12. *Louis Vuitton*, 507 F.3d at 259.

popularity . . . confusion is avoided, and it is on this lack of confusion that a parodist depends upon to achieve the parody.”¹³

The court pretty much accepted this analysis, although it did so in somewhat different terms. First, it introduced the concept of “successful parodies” and parodies that are not “successful.” Whether there is likelihood of confusion under the traditional multi-factor analysis “depend[s] to a great extent on whether Haute Diggity Dog’s products and marks are successful parodies” of the LOUIS VUITTON marks and trade dress.¹⁴ The concept of “success” with respect to parodies was not explained outside the context of whether or not a parody is successful determining whether there is likelihood of confusion under the Fourth Circuit test.

Second, the court defined *parody*, for trademark purposes, as a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner,¹⁵ and amplified that “A parody must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is *not* the original and is instead a parody.”¹⁶ (The notion that parody must convey two contradictory messages *simultaneously* is a frequent shibboleth in the legal literature on the subject. “Simultaneous” means “existing or occurring at the same time: exactly coincident.”¹⁷ Common experience teaches that it is, at the very least, rare to believe two diametrically opposed things at exactly the same time; more often, if not always, the messages are sequential, perhaps very quickly, perhaps not so quickly; either recognition can come first for the parody to work; and the parody can work if the target never believes it to be the original—(s)he need only recognize the reference.) Third, the court explained that:

This second [simultaneous] message [“that it is *not* the original”] must not only differentiate the alleged parody from the original but must also communicate some articulable element of satire, ridicule, joking or amusement. Thus, “[a] parody relies upon a difference from the original mark,

13. *Id.* Haute Diggity Dog continues: “It is necessary for the pet products to conjure up the original designer mark for there to be a parody at all. However, a parody also relies on ‘equally obvious dissimilarit[ies] between the marks’ to produce its desired effect.”

14. *Id.* at 260.

15. *Id.*, citing *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001).

16. *Id.*, citing the same case.

17. Merriam-Webster online, <http://www.merriam-webster.com/dictionary/simultaneous>.

presumably a humorous difference, in order to produce its desired effect.”¹⁸

The court then turned to the following analysis of the case before it: (1) “the pet chew toy is obviously an irreverent, and indeed intentional, representation of the LVM handbag. . . .” (2) “No one can doubt that LVM handbags are the target of the imitation by HDD’s ‘Chewy Vuiton’ dog toys.” (3) “At the same time, no one can doubt also that the ‘Chewy Vuiton’ dog toy is not the ‘idealized image’ of the mark created by LVM. . . .” (4) “Finally, the juxtaposition of the similar and dissimilar—the irreverent representation and the idealized image of an LVM handbag—immediately conveys a joking and amusing parody. The furry little ‘Chewy Vuiton’ imitation, as something to be *chewed by a dog*, pokes fun at the elegance and expensiveness of a LOUIS VUITTON handbag, which must *not* be chewed by a dog.” (5) “The dog toy irreverently presents haute couture as an object for casual canine destruction. The satire is unmistakable. The dog toy is a comment on the rich and famous, on the LOUIS VUITTON name and related marks, and on conspicuous consumption in general.”¹⁹

Having concluded that no one could doubt that the “Chewy Vuiton” image was not the idealized image of LOUIS VUITTON, the court then ran through its circuit’s likelihood of confusion factors, finding confusion not likely.²⁰ It then turned to dilution under the Trademark Dilution Revision Act of 2006.²¹ The Court’s consideration of dilution by blurring is interwoven throughout a discussion of the six statutory factors for determining if there is dilution by blurring.²²

The gist of its reasoning that there was no blurring by dilution was:

. . . Under the statute’s plain language, parodying a famous mark is protected by the fair use defense only if the parody is *not* “a designation of source for the person’s own goods or services.”

18. *Louis Vuitton*, 507 F.3d at 260, quoting *Jordache Enterprises, Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1487 (10th Cir. 1987), discussed *infra*.

19. *Id.* at 260-61.

20. *Id.* at 261-263.

21. 15 U.S.C. § 1125(c).

22. *Louis Vuitton*, 507 F.3d at 266-68; the factors are: (i) degree of similarity, (ii) degree of inherent or acquired distinctiveness of the famous mark; (iii) extent of mark owner’s exclusivity of the mark; (iv) degree of recognition of the famous mark; (v) whether there is an intent to create an association with the famous mark; and (vi) actual association between the famous mark and the parody mark or trade name. See 15 U.S.C. § 1125(c)(2)(B).

* * *

... While a parody intentionally creates an association with the famous mark in order to be a parody, it also intentionally communicates, if it is successful, that it is *not* the famous mark, but rather a satire of the famous mark. . . .

* * *

... If Haute Diggity Dog used the actual marks of LVM (as a parody or otherwise), it could dilute LVM's marks by blurring, regardless of whether Haute Diggity Dog's use was confusingly similar, whether it was in competition with LVM, or whether LVM sustained additional injury. . . .

But in this case, Haute Diggity Dog mimicked the famous marks; it did not come so close to them as to destroy the success of the parody and, more importantly, to diminish the LVM marks' capacity to identify a single source. Haute Diggity Dog designed a pet chew toy to imitate and suggest, but not *use*, the marks of a high-fashion LOUIS VUITTON handbag. It used "Chewy Vuiton" to mimic "LOUIS VUITTON"; it used "CV" to mimic "LV"; and it adopted *imperfectly* the items of LVM's designs. We conclude that these uses by Haute Diggity Dog were not so similar as to be likely to impair the distinctiveness of LVM's famous marks.²³

Dilution by tarnishment was dismissed on the ground that all that had been argued was that a dog might choke on the toy and die, and there was no evidence one ever had.²⁴ Back when CCA lost to Bud, the court recognized "the particularly unwholesome association of ideas when the word 'bugs' was substituted for the word 'Bud,' referring to a food product."²⁵ A watered-down analog of that argument might have better served the tarnishment claim than the one made, although a reader of the opinion must doubt whether any argument could have swayed that court at this point in time.

What is interesting about the two decisions is that several of the factors one court condemned in 1962 were, more than arguably, present in the 2007 decision. There can be no doubt, for example, that Vuitton "has a property interest in [its name and mark], built up at great expense, and that its products are favorably known as a result of its use of this property right, and

23. 507 F.3d at 266-68.

24. *Id.* at 269.

25. *Chem. Corp. of Am. v. Anheuser-Busch, Inc.*, 306 F.2d 433, 437-38 (5th Cir. 1962).

that the defendant, with full knowledge of the right and with the purpose of appropriating some of the value engendered in the minds of the public by [Vuitton's] use," sold the CHEWY VUITON chew toys.²⁶ Not unfairly, Haute Diggity Dog's conduct also may be characterized as "a brazen and cheap effort . . . to capitalize on the good will created by the tremendous expenditure in advertising by the plaintiff"; it is perhaps a mild overstatement to say that Haute Diggity Dog's conduct was "of such nature as to fairly reek with unfairness," but "a callous indifference to the damage that might occur to others from the action" is no more than one inflammatory adjective off the mark; "morally reprehensible" might be pushing it in this era.²⁷

Of course, a modernist could point out, correctly, that the CCA case evidenced no recognition of the possibility of parody, or a joke, or even free speech. The decisions reflect different sensibilities and different times. The intent of this article is to explore how the law got from there to here, to identify and point out some possible missteps, and forgotten right steps, along the way, and, ultimately, to propose a paradigm for analysis of parody trademarks.

II. DURING THE INTERVAL BETWEEN THE DECISIONS

A. *To the End of the Seventies: Setting the Scene*

1. Copyright Cases in the Sixties and Seventies

Prior to the "Where there's life . . . there's bugs," and immediately thereafter, parody and similar phenomena were first dealt with in copyright cases, and the critical question was whether there was "fair use" or not. The history of "fair use" has been stated succinctly:

In determining whether given conduct constitutes copyright infringement, the courts have long recognized that certain acts of copying are defensible as "fair use." It has been said that the affirmative defense of fair use "permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster." The Copyright Act of 1976 for the first time accorded express statutory recognition of this judge-made rule of reason. However, this codification was "intended to restate the

26. See 306 F.2d at 437.

27. All quotations from *Chem. Corp. of Am.*, 306 F.2d at 437-38.

present [*i.e.*, pre-1978] judicial doctrine of fair use, not to change, narrow, or enlarge it in any way. . . .”²⁸

The statutory codification of the “fair use” doctrine is Section 107 of the Copyright Act, entitled “Limitations of exclusive rights: Fair use.”²⁹ It says in its preamble that certain reproductions of copyrighted works are “not an infringement of copyright.” It also itemizes six “purposes” for copying that “fair use” is intended to further. Because these purposes are listed after the word “including,” the list presumably is not definitive, only illustrative. The six sanctioned purposes are: “criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, [and] research.”

After the preamble four “factors” are listed for consideration “[i]n determining whether the use made of a work in any particular case is a fair use.” Again, the enumeration of factors is expressly said to be inclusive, so, implicitly, they are not exhaustive. The factors are: “(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.”

This, then, is the framework within which “fair use” has been determined since the 1976 Copyright Act took effect in 1978. It also presumably is the best articulation of the existing common law doctrine upon which the drafters of that Act could agree. Parody and parody-like conduct began to be considered seriously by the judiciary in 1956.

For one of his weekly television programs, comedian Jack Benny presented a “burlesque”³⁰ of the then classic, copyrighted movie *Gaslight*. When sued, he raised the defense of fair use, which was rejected because

. . . [i]f the material taken by appellants from “GasLight” [sic] is eliminated, there are left only a few gags, and some disconnected, and incoherent dialogue. If the television play were presented without appellant’s contribution, there would

28. 4 David Nimmer, *Nimmer on Copyright* § 13.05 (Rel. 73-8/2007), footnotes omitted.

29. 17 U.S.C. § 107.

30. “Burlesque” is defined as “a . . . dramatic work that seeks to ridicule by means of grotesque exaggeration or comic imitation.” Merriam-Webster online, <http://www.merriam-webster.com/dictionary/burlesque>.

be left the plot, story, principal incidents and same sequence of events as in the photoplay.³¹

In other words, too much was borrowed and not enough contributed for the use to be "fair." It might also be noted that there is probably less public interest in allowing imitation for the sole purpose of unbridled ridicule than for criticism or comment. Complicating application of that principle, of course, is that comment and criticism can take the form of ridicule, especially exaggeration to the point of *reductio ad absurdum*.

Eight years later, someone sued *MAD* magazine, which had to happen sooner or later. *MAD* itself proclaimed that it featured "satire" (depicted by an illustration of a satyr). The "someone" who brought suit was the very successful songwriter and composer Irving Berlin.³² The target of his ire was a piece from a feature that printed unusual "song lyrics" to be "sung to the tune of" various familiar and popular songs of the day. One such song chosen for the occasion was to be "sung to the tune of" Mr. Berlin's classic "A Pretty Girl is Like a Melody," the first line of which became "Louella Schwartz Describes her Malady." The court admitted that "as a general proposition, we believe that parody and satire are deserving of substantial freedom, both as entertainment and as a form of social and literary criticism. . . ." However,

We believe in any event that the parody lyrics involved in this appeal would be permissible under the most rigorous application of the "substantiality" requirement.^[33] The disparities in theme, content and style between the original lyrics and the alleged infringements could hardly be greater. . . . While brief phrases of the original lyrics were occasionally injected into the parodies, this practice would seem necessary if the defendants' efforts were to "recall or conjure up" the originals; the humorous effect achieved when a familiar line is interposed in a totally incongruous setting, traditionally a tool of parodists, scarcely amounts to a "substantial" taking if that standard is not to be woodenly applied.³⁴

31. *Benny v. Loew's, Inc.*, 239 F.2d 532, 536 (9th Cir. 1956).

32. *Berlin v. E.C. Publ'ns, Inc.*, 329 F.2d 541, 546 (2d Cir. 1964).

33. This refers to what Restatement (Third) of Torts § 107 now refers to as "substantiality of the portion used in relation to the copyrighted work as a whole."

34. *Berlin*, 329 F.2d at 545.

The Second Circuit's tolerance for drivel that mocks cultural icons may have been ahead of its time.

The following year, The Ninth Circuit had occasion to consider *Air Comics Funnies*, an underground comic title featuring “a rather bawdy depiction of the [Walt] Disney characters as active members of a free thinking, promiscuous, drug ingesting counterculture.”³⁵ Explaining that “the constraints of the existing precedent” balance the desire of the parodist to make the “best” parody against the copyright owner's rights “in his original expressions,” the court concluded “that balance has been struck at giving the parodist what is necessary to conjure up the original, and . . . that standard was exceeded here.”³⁶ Some contemporary critics thought the decision reflected instant revulsion at seeing icons of innocence taking a walk on the vile side.

That, however, cannot explain the following year's determination that the dinner theatre musical production *Scarlett Fever* infringed the book and movie *Gone With the Wind*.³⁷ There, the production

. . . opens, just as the movie does, with the scene at Tara on the day before the Wilkes' barbecue, with Scarlett talking to the Tarleton twins. It moves in sequence through the major episodes of “Gone With The Wind”, though in condensed form and omitting certain scenes, and ends as Rhett leaves Scarlett. Interspersed throughout the various scenes are original songs and dance routines.³⁸

The court found that this “is not the sort of original critical comment meant to be protected by the fair use defense, but rather is predominantly a derivative or adaptive use of the copyrighted film and novel. . . .” To the extent there was any parodic or satirical critical comment, the play producers had drawn on the originals “far more extensively” than was permissible to “conjure up” the original characters or subjects.³⁹

To this point, then, purported parody appeared to be a quantitative, “how-much-is-too-much?” test.

During the same period, trademark law was beginning to cope with analogous situations involving charges of infringement.

35. *Walt Disney Prods. v. The Air Pirates*, 581 F.2d 751, 753 (9th Cir. 1978).

36. *Id.* at 758.

37. *Metro-Goldwyn Mayer, Inc. v. Showcase Atlanta Coop. Prods., Inc.*, 479 F. Supp. 351 (N.D. Ga. 1979).

38. *Id.* at 354.

39. *Id.*

2. Trademark Cases in the Sixties and Seventies: Mostly Confusion, Likelihood of

Trademark law began to focus on light-hearted liberty with others' trademarks in 1969, when, in the spirit of the sixties, Personality Posters pricked the perceived pomposity of a "nonprofit, nonpolitical, nonsectarian character-building organization . . . [whose] purpose is to promote the virtues of truth, loyalty, purity and patriotism. . . ." ⁴⁰ Poster's vehicle of choice, naturally enough, was a poster—one depicting a very pregnant young woman in profile and in the Girl Scout uniform, along with the Girl Scout motto: "BE PREPARED." Unquestionably, many found the message hilarious. The Girl Scouts didn't, and sought a preliminary injunction. They failed the likelihood of success on the merits test:

. . . Plaintiff's affidavit goes no further than to state that "Plaintiff has received telephone calls from members of the public expressing their indignation concerning defendant's said poster"; but indignation is not confusion. To the contrary, the indignation of those who have called would appear to make it clear that they feel that the Girl Scouts are being unfairly put upon, not that the Girl Scouts are the manufacturers or distributors of the object of indignation. ⁴¹

Three years later, in the midst of an "ENJOY COCA-COLA" advertising barrage, a new poster appeared, closely imitating the format of the message, but altering it to "ENJOY COCAINE." There was the same widespread indignation, and one supposes, the same pregnant Girl Scout argument, but this time it failed:

Defendant nonetheless scoffs at the suggestion that the poster "would confuse any person of average intelligence, or even below average intelligence [sic]" and that its "very nature . . . precludes anyone from believing that it originates with the plaintiff." That is simply defendant's self-serving *ipse dixit*. The appearance of defendant's name—in relatively small lettering—on the poster does not meet plaintiff's factual proof that some persons of apparently average intelligence did attribute *sponsorship* to plaintiff and discontinued their use of Coca-Cola as an expression of resentment. Not only does visual comparison of defendant's poster with specimen advertising of plaintiff indicate the likelihood of such a

40. *Girl Scouts of U.S. v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228, 1230 (S.D.N.Y. 1969).

41. *Id.* at 1231.

mistaken attribution but recent so-called “pop art” novelty advertising utilized by plaintiff may have served to further the impression that defendant’s poster was just another effort of that kind by plaintiff to publicize its product.⁴²

At the time, there was considerable speculation whether the pregnant Girl Scout and Enjoy Cocaine cases could be reconciled.⁴³ But either way, there was, at least overtly, no favoring of attempted parody. On a purely subjective level, however, “BE PREPARED” seems a lot more clever and funny than ENJOY COCAINE.

Four years later, comedian Morey Amsterdam wrote, or at least lent his name to, an allegedly humorous publication, the *Betty Cooker Crock Book for Drunks*.⁴⁴ His publisher soon met the owner of BETTY CROCKER, a registered trademark for cookbooks. The court denied a preliminary injunction, noting that there was “not a likelihood that the public will be confused or misled in any way that the books are related.” It also accepted that defendant was “attempting a parody of” the original book and mark, but saw “no evidence . . . that defendant is intentionally attempting to confuse the public. . . .”⁴⁵

The same year, some entrepreneurs attempted to release an X-rated movie called *Tarz & Jane & Boy & Cheeta* about a jungle family. At the time, TARZAN was the hero of more than two dozen novels, numerous comic books, and more than forty movies (some of which included his wife, Jane, his son, Boy, and their pet chimp, Cheetah), which had taken in millions of dollars annually. There were many copyrights, and TARZAN was a trademark. There was no reported defense of parody, and advertising and distribution of the film was summarily (preliminarily) enjoined.⁴⁶

The next case introduced (and ignored) a factor not encountered since the CCA “bugs” case. The dictionary definition of *parody* is “a literary or musical work in which the style of an

42. *The Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1189-90 (E.D.N.Y. 1972), footnotes omitted.

43. Author’s recollection. The lesson the author gleaned was that in these cases, one must look very hard for actual confusion, and that it is okay to be funny (pregnant Girl Scout was; “Enjoy Cocaine” wasn’t). The latter obviously was subjective, and perhaps a bit naive.

44. At the time, “CROCK-POT” was a trademark for a slow-cooking, electric pot that cooked stews and the like at relatively low cooking temperatures for hours. It was fashionable, and there was considerable generic use of “crock pot.”

45. *General Mills, Inc. v. Henry Regnery Co.*, 421 F. Supp. 359, 361 (N.D. Ill. 1976).

46. *Edgar Rice Burroughs, Inc. v. Manns Theatres*, 195 U.S.P.Q. 159 (C.D. Cal. 1976).

author or work is closely imitated for comic effect or in ridicule.”⁴⁷ The justification for including parody in fair use for copyright purposes is that it is a form or comment upon, or criticism of, an original work. This case expanded this somewhat, but the media of parody (or possible parody) theretofore had been a radio broadcast (Jack Benny), MAD magazine (Irving Berlin), a comic book (Walt Disney), a musical comedy (M-G-M), posters (Girl Scouts and Coca-Cola), cookbooks (General Mills), and movies (Edgar Rice Burroughs). All are, to one degree or another, conventional communicators of ideas. What ideas, if any, that might have been communicated by the works challenged as infringements were rather vague in some cases, and in some cases the ideas could be understood to be too thin, but the medium in each case was among those that readily accommodate themselves to discourse and to the expression of ideas. Insecticide–floor wax was not, and neither was the object of the next case to be discussed, diaper bags.⁴⁸

GUCCI used its name and green-bordered red-stripe trade dress on various bags, cases and other items for more than two decades before Fashioncraft Products introduced its GUCCHI GOO vinyl diaper bags with green-red-green striping, marketing and sales of which were expeditiously enjoined. The opinion seemed more reactive than analytical, but its crux was:

Even if, as defendant Fashioncraft argues, no one could possibly confuse the diaper bag with the Gucci tote or travel bag, the use of the mark “GUCCHI” with the mark “GOO” on an item similar to a tote bag indicates an intent to “poke fun at” or ridicule plaintiff. The fact that the offending product was intended only as a joke is of no consequence. A well-known registered trademark such as “GUCCI” may still be protected from such ridicule by a preliminary injunction.⁴⁹

The court did, however, find it “not unreasonable to assume” that employment of the GUCCI-like marks “would mislead members of the public into believing that plaintiff is somehow connected with the ‘diaper bag.’”⁵⁰ On a less analytical, more visceral, level, is not the association of GUCCI with malodorous, “goo”ey diaper bags at least as revolting and demeaning, if not unwholesome, as the association of insects with beer? That is a thought to keep in mind when considering the next case, as well.

47. Merriam-Webster online, <http://www.merriam-webster.com/dictionary/parody>.

48. *Gucci Shops, Inc. v. R.H. Macy & Co., Inc.*, 446 F. Supp. 838 (S.D.N.Y. 1977).

49. *Id.* at 840, citing *Coca-Cola Co.*, 346 F. Supp. at 1189-90; *see also supra*, notes 42-43.

50. *Id.*

Two years later, the *Dallas Cowboys Cheerleaders* case came along. It was a trade dress case in the most literal sense, and the reason for its outcome is perhaps best expressed by the Appellate Court's explication of the salient facts of the case. The plaintiffs were the famous cheerleaders for the Dallas Cowboys football team. The defendant produced

a gross and revolting sex film whose plot, to the extent that there is one, involves a cheerleader at a fictional high school, Debbie, who has been selected to become a "Texas Cowgirl." In order to raise enough money to send Debbie . . . to Dallas, the cheerleaders perform sexual services for a fee. The movie consists largely of a series of scenes graphically depicting the sexual escapades. . . . In the movie's final scene, Debbie dons a uniform strikingly similar to that worn by the Dallas Cowboys Cheerleaders and for approximately twelve minutes of film footage engages in various sex acts while clad or partially clad in the uniform.⁵¹

As if the movie was not disgusting enough to the court's sensibilities, the defendant's advertising made express representations as to the putative star's prior membership in the plaintiff's squad. An injunction was a foregone conclusion, and likelihood of confusion was the convenient hook. None of this is very important to parody, but the case has been cited so often for so many things that it looms large on the landscape of trademark law in general, and should not be overlooked.

Its only specific reference of concern in considering parody arose because the defendant raised a First Amendment defense, which the court brushed off. "[T]hat [the] movie may convey a barely discernible message does not entitle them to appropriate plaintiff's trademark in the process of conveying the message," because there are many ways to "comment on 'sexuality in athletics' without infringing" people's trademarks.⁵² That was as constitutionally suspect as was the argument it addressed hypocritical. If an idea or comment is to be free to be made, its proponent necessarily needs to be free to make it his own way, subject only to limits of public safety and order.

If there is any discernible pattern to this point, it is that mocking respectable trademarks with references to narcotics, movie character names or titles, diaper bags, and "gross and

51. *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202-03 (2d Cir. 1979).

52. *Id.* at 206.

revolting” sex is inappropriate, while mocking (presumably unintended) pregnancy and drunkenness is acceptable. It is difficult to discern any consensus as to the demarcation between likelihood and unlikelihood of confusion in these cases, although one can, and should, appreciate Coca-Cola’s ability to find some actual confusion.

3. Political Free Speech Trumps Trademarks

When the 1980 Olympic Games were held at Lake Placid, New York, the resort community constructed an “Olympic Village” to house the participants and officials. Because the games were to be short-lived, the planners, to rationalize the construction cost, intended to turn the village into a jail. Some locals who thought this was a bad idea organized Stop the Olympic Prison (STOP) to protest the idea. In their arsenal of tactics was the design and sale of a poster.

The top half of the poster consists of the words “STOP THE OLYMPIC PRISON” in large, striking letters. Immediately below is a drawing of five vertical steel grey bars upon which are superimposed five interlocking rings in an arrangement universally recognized as a symbol of the Olympic Games. Thrusting through the bars and the rings is a silhouetted forearm clutching a flaming torch. . . .⁵³

STOP sought a declaratory judgment against the Olympic Committee, and won after trial. The court found it “extremely unlikely that anyone would presume [the poster] to have been produced, sponsored or in any way authorized by the [Olympic Committee].⁵⁴ While the court found it unnecessary to consider STOP’s First Amendment rights, it found it “worth recalling . . . a case that involved our most revered federally protected symbol” in which “the Supreme Court held that a college student’s public display of an upside-down American flag, to which he had affixed a peace symbol, was a form of expression protected by the First Amendment.”⁵⁵

This is the first of a short line of cases we will consider here, because they have an accumulative impact easily lost if scattered through the rest of this article. Roughly five years later, the Reagan Administration proposed a strategic defense initiative

53. *Stop the Olympic Prison v. U.S. Olympic Committee*, 489 F. Supp. 1112, 1114 (S.D.N.Y. 1980).

54. *Id.* at 1123.

55. *Id.* at 1126. The case recalled was *Spence v. Washington*, 418 U.S. 405 (1974).

involving space orbiting weapons to counter possible nuclear attacks. Those opposed quickly dubbed the idea “Star Wars,” and the name attached quickly. The reference—intended to be ridiculing—was to a trilogy of very popular outer space science fiction movies, which had by then expanded into a video game, toy, and literary franchise. The owners of the Star Wars properties sued two public interest groups to restrain their continued use of “Star Wars.”

The court ruled that trademark law, unfair competition, and the other business torts invoked by the plaintiff “do not reach into the realm of public discourse to regulate the use of terms used outside the context of trade.”⁵⁶ The court struck a sensible balance when it ruled it would be “wholly unrealistic and unfair to allow the owner of a mark to interfere in the give-and-take of normal political discourse,” yet recognized “it would be equally unrealistic and unfair to take from the lawful owner of a strong trademark his continued right to its *commercial use* because others, beyond his control and contemplating no harm to him, used the words . . . as part of an on-going international political debate.”⁵⁷

SMOKEY BEAR is an imaginary mascot of the United States Forest Service, relentlessly campaigning against forest fires. He is, by statute, “the property of the United States.”⁵⁸ When an environmental group, Lighthawk, the Environmental Air Force, wished to express its displeasure with the Forest Service’s decision to allow timbering of public lands, it created an advertising campaign, the centerpiece of which was a depiction of Smokey, holding a chainsaw behind him, and the plea: “Say it ain’t so, Smokey.” The Forest Service threatened to invoke the government’s property right against Lighthawk, which sued. Initially, the court described the protest advertisement as “a form of criticism of government policies [which] is on the ‘highest rung of the hierarchy of First Amendment values.’”⁵⁹ The statute and regulations, the plain meaning of which favored the Forest Service, were read by the court as “a restriction on speech,” the application of which was “thus presumptively invalid, and cannot be tolerated unless the government can demonstrate a compelling interest, that is directly advanced by the statute and is narrowly drawn.”⁶⁰

56. *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931, 934 (D.D.C. 1985).

57. *Id.* at 935, emphasis added.

58. 16 U.S.C. § 580p-2.

59. *Lighthawk, the Envtl. Air Force v. Robertson*, 812 F. Supp. 1095, 1099 (W.D. Wash. 1993).

60. *Id.* at 1101.

Next, the courts turned to candidate campaign behavior. In Ohio, someone named Hagan found himself seeking the gubernatorial nomination against the incumbent, a man named Taft (long a good name in Ohio politics). At the time, one of the more popular advertising campaigns was that of the American Family Life Insurance Company, which often ended with a real (or digitally animated) white duck flapping its wings and quacking the company acronym, “AFLAC!” Hagan created an attack campaign of “ads beginning with a clip of his adversary saying something, then cut to a clumsily animated duck with Taft’s face that quacked “TaftQuack!” The court acknowledged that the case had many of the trappings of a classic copyright or trademark infringement case. But it had something else too:

It appears incontestable that Hagan *intended* that the TaftQuack character would imitate the AFLAC duck, so that Hagan could go “coattail riding” . . . that is, “get attention” and perhaps “avoid the drudgery in working up something fresh. . . .” But AFLAC “does not own in gross the penumbral customer awareness of its name, nor the fallout from its advertising.” . . . That the consuming public may associate the AFLAC duck and TaftQuack character—a proposition the Court accepts—is an insufficient predicate to support injunctive relief of political speech. The First Amendment protects Hagan from AFLAC’s dilution claim under the Lanham Act.⁶¹

The next political speech opinion ignored the defendant’s invitation to rely on political free speech,⁶² and decided strictly on the basis of non-political parody law, so it will be considered later in this article.⁶³ It is safe to say, however, that thus far, no copyrights or trademarks have been held infringed by political speech, and that seems unlikely to change soon.

B. Development of New Ideas and Reinforcement of Old Ones in the Eighties and Early Nineties

Trademark and copyright jurisprudence continued on separate, but not dissimilar, paths.

61. American Family Life Ins. Co. v. Hagan, 266 F. Supp. 2d 682, 700-01 (N.D. Ohio 2002), citations omitted.

62. The author was one of the counsel for Nader, and extended the invitation.

63. MasterCard Int’l Inc. v. Nader 2000 Primary Committee, Inc., 70 U.S.P.Q.2d 1046 (S.D.N.Y. 2004).

1. Trademark Cases

Shortly after the movie *JAWS II* was released, *JAWS* was a very lucrative movie service mark (the original *JAWS* was, at the time, the second most successful and popular movie in history, and *JAWS II* was among the top twenty). Retail store and catalog merchant Montgomery Ward began marketing *JAWS ONE*, *JAWS TWO*, and *JAWS POWER* for food waste disposal units. A preliminary injunction followed in due course. While most of the evidence failed to “sway the Court one way or another on the issue of likelihood of confusion,” its finding that Montgomery Ward adopted its *JAWS* terms “with an intent to capitalize on the plaintiffs’ mark permit[ted] the Court to draw the strong inference of likelihood of confusion.”⁶⁴

Selling an inexpensive, “clip-on beverage can handle” under the designation *STEIN-WAY* must have seemed like a funny idea, until the grand piano manufacturer sued. A preliminary injunction issued under theories of infringement and dilution under California law. Perhaps the primary “pressing danger warranting injunctive relief [was] that the public [would] begin to identify *STEINWAY* with a product incompatible with the quality and prestige attached by the public to plaintiff’s mark. . . .”⁶⁵

Before Jay Leno, Conan O’Brien, and Jay Leno redux, NBC’s *Tonight Show* was hosted for thirty years by comedian Johnny Carson, who was invariably introduced by the words “Here’s Johnny!,” a phrase that identified him to a substantial portion of the television viewing public. Here’s Johnny Portable Toilets thought “Here’s Johnny” would be “a good play on the phrase.” To drive the point home, it described its portable outhouse as “the world’s foremost portable commodian.” The trial court dismissed the resulting action of grounds of no likelihood of confusion, but the appeals court found a violation of the Michigan right of publicity, because the defendant’s president “admitted that it adopted the name ‘Here’s Johnny’ because it identified . . . Carson. [The defendant] does not even contend that [it] did not successfully accomplish its intended purpose of appropriating [Carson’s] identity.”⁶⁶

64. *Universal City Studios, Inc. v. Montgomery Ward & Co., Inc.*, 207 U.S.P.Q. 852, 857 (N.D. Ill. 1980).

65. *Steinway & Sons v. Robert Demars & Friends*, 210 U.S.P.Q. 954, 964 (C.D. Cal. 1981). Oddly enough, another ground was that because Steinway distributed small, metal give-away articles, it would be a natural conclusion that the beverage can handles were just another promotional item distributed by Steinway.

66. *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 836 (6th Cir. 1983).

A common element in each of these cases finding a violation of law is that the infringement, dilution or invasion (of the right of publicity) resulted from “branding” a product with a well-known name, the obvious purpose being to gain benefit from the well-known name. The vast majority of product names are not jokes, so, at least in the abstract, one may posit that the public would not anticipate these products’ names to be jokes either, whether in good taste or bad. The same cannot be said for the next two cases.

When Topps created “Wacky Paks” of stickers that bore some resemblance to various product packages that they purported to parody (PUPSI-COLA, the soft drink for dogs, HEAD AND BOULDERS SHAMPOO for people with rocks in their heads), the PETLEY flea bags package rendering drew the ire of Tetley Tea, but not of the court.

... In sum, the distinctions between plaintiff’s products and defendants stickers all indicate that this case resembles those parody cases which have not resulted in the issuance of an injunction because the plaintiff could not demonstrate a likelihood of prevailing on the merits by showing a likelihood of confusion as to source, sponsorship or endorsement.⁶⁷

One distinction may be that the brand for the new product was WACKY PAKS, not a mark of plaintiff; another point of distinction is that stickers are a media of communication of speech.

On the other hand, when a new fast food chain created a television commercial that boasted facsimiles of Ronald McDonald, Little Wendy, and Colonel Sanders,⁶⁸ the “parody” characters were found to infringe the mascots they resembled. The conclusion was “buttressed by the fact that Wendy’s and Big Bite are direct competitors in an industry with high volume sales and relatively low cost goods.” If Big Bite were parodying the Little Wendy character in an effort to sell used cars, it might have passed muster, because “used cars are not substitutes for hamburgers,” and cost enough for people to presumably pay more attention.⁶⁹ TV commercials also are communications, but here, the opposing parties were competitors.

67. Tetley, Inc. v. Topps Chewing Gum, Inc., 556 F. Supp. 785, 793 (E.D.N.Y. 1983).

68. At the time, these were the respective spokespersons for McDONALDS, WENDY’S, and KENTUCKY FRIED CHICKEN.

69. Wendy’s Int’l, Inc. v. Big Bite, Inc., 576 F. Supp. 816, 824 (S.D. Ohio 1983).

2. Copyright Cases

Song lyric parodies returned to the courts. When TV's *Saturday Night Live* chose to poke fun at New York City's public relations/tourism promotion theme song "I Love New York," it created "as sung to the tune of" lyrics that began "I love Sodom." The District Court's ruling of parody and fair use was appealed and affirmed, in part because "in today's world of often unrelieved solemnity, copyright law should be hospitable to the humor of parody. . . ." ⁷⁰

The following year, an *avant-garde* theatrical "review" (*Let My People Come*) incorporated in its numbers a spoof of the World War II hit song "Boogie Woogie Bugle Boy [of Company B]," which it called "Cunnilingus Champion of Company C."

At trial, defendant Wilson testified that at the time he wrote Cunnilingus Champion, he did not intend it to be either burlesque or satire. . . . It is quite obvious, of course, that the words "Cunnilingus Champion of Company C" as used in the title and throughout the lyrics of Wilson's song, were not a take off on the music of the '40s but on plaintiff's song alone.^[71] . . . We are not prepared to hold that a commercial composer can plagiarize a competitor's copyrighted song, substitute dirty lyrics of its own, perform it for commercial gain, and then escape liability by calling the end result parody or satire on the mores of society. Such a holding would be an open-ended invitation to musical plagiarism.⁷²

At least two themes seen previously are reflected in these cases. Innocent or nonsensical substitutions of lyrics are permissible (*Berlin*), but derivative, original, and "gross, revolting, sex" works are not (*Dallas Cowboys Cheerleaders*).⁷³

SUPERMAN is the subject of a vast array of copyrights, as well as a number of trademarks. When a consumer electronics chain, CRAZY EDDIE, produced a television advertisement representing a "detailed copying" of two television "trailers" for SUPERMAN television shows, and defended on the ground of

70. *Elsmere Music, Inc. v. Nat'l Broad. Co.*, 623 F.2d 252, 253 (2d Cir. 1980).

71. *MCA Inc. v. Wilson*, 677 F.2d 180, 184 (2d Cir. 1981).

72. *Id.* at 185.

73. *Pillsbury Co. v. Milky Way Productions*, 215 U.S.P.Q. 124 (N.D. Ga. 1981) managed to have it both ways when it ruled that a pornographic "magazine"'s depictions of the popular Pillsbury Doughboy character and a "doughgirl" engaged in sexual intercourse and fellatio were fair use for copyright purposes, not trademark infringement (lack of likelihood of confusion), but were dilution under Georgia state law.

parody, the court found there was “not a case of fair use, but one of unjustifiable appropriation . . . for personal profit.”⁷⁴ However, when ABC television created “The Greatest American Hero,” about a very average person with powers of flying and strength he could not control and innate clumsiness, viewers took to it, and Warner Bros. sued ABC, unsuccessfully. On appeal, the court opined that it is “decidedly in the interests of creativity, not piracy, to permit authors to take well-known phrases and fragments from copyrighted works and add their own contributions of commentary and humor.”⁷⁵

On still another hand, when a singing telegram service created crude, sometimes risqué, imitations of comic book icons they called “Super Stud” and “Wonder Wench,” to deliver their messages, use of the characters was quickly enjoined pursuant to state dilution law and federal trademark rights in costumes. The decision recognized “two types of effect upon the potential market for plaintiff’s works” resulting from the “alleged parodies.” One was “the potential for commercial substitution”; even if plaintiff had yet to enter the singing telegram delivery business, it had licensed enough costumed appearances of its characters to shield their marks in the defendant’s business, and there was “a clear potential market for genuine SUPERMAN singing telegrams, as shown by the use by defendants. . . .” The other “effect on the potential market for or value of plaintiff’s copyrighted works results from the implicit disparagement and bawdy associations indisputably [sic] created by some of defendants’ adaptations.” It was also noted that “Defendants do not engage in critical comment that constitutes part of the ‘free flow of ideas’ underlying the doctrine of fair use . . . [but] instead . . . seek to augment the commercial value of their own property by creating new, and detrimental, associations with plaintiff’s property.”⁷⁶

Again in these cases, we find the theme that it is wrong to cash in on the fame, celebrity, and reputation of others, particularly by the name of another’s product, as opposed to use in an expressive medium.

74. DC Comics Inc. v. Crazy Eddie, Inc., 205 U.S.P.Q. 1177, 1178 (S.D.N.Y. 1979).

75. Warner Bros. Inc. v. Am. Broadcast. Cos., Inc., 720 F.2d 231, 242 (2d Cir. 1983).

76. DC Comics, Inc. v. Unlimited Monkey Bus., 598 F. Supp. 110, 118 (N.D. Ga. 1984). Perhaps it is not the best idea, when executing a purported parody of an American icon, to do so under a name like “Unlimited Monkey Business.”

C. The Road to “Pretty Woman”

From 1986 to 1994, there was an unprecedented wave of parody cases, sixteen of which we discuss. Some new ideas arose, and several cases seem seriously flawed. It was the overture to the Supreme Court’s performance of “Oh, Pretty Woman.”

1. Copyright Cases

There were three.

1. In 1982, Original Appalachian Artworks licensed mass manufacture of what had been a growing business in the Southeast, and the “Cabbage Patch” soft-sculpture dolls became a “must have” for virtually every young girl. Each doll was unique (supposedly), kind of homely but, apparently, loveable to little girls, and came with adoption papers. Demand far outstripped supply, and they became a cultural phenomenon, then a craze, in the early eighties. Topps, a manufacturer of baseball cards and other, more parodic, merchandise aimed at children, came out with a series of cards, stickers, and folders unmistakably depicting Cabbage Patch lookalikes in noxious settings and giving them rude attitudes. The court was unimpressed:

Here the primary purpose behind defendant’s parody is not an effort to make a social comment but is an attempt to make money. . . . The Garbage Pail Kid stickers is [sic] one of the most profitable ventures in Topps’ business history. Neither are the Garbage Pail Kid stickers one of a series of spoofs of different products^[77] as defendant has produced in the past, nor a single cartoon or editorial product in a broader satirical product such as Mad Magazine.^[78] The basic concept behind the defendant’s stickers is aimed at capitalizing on the Cabbage Patch craze.⁷⁹

The case plainly attempted to distinguish between a business venture that parodies numerous targets and one that parodies one subject in various ways. In effect, the court ruled that if the motive is to ridicule society (or some elements of it), that is permissible, but if it is to exploit a singular commercial success, that is not. Making motivation a test of freedom to parody seems hard to justify. Making motivation a test of whether there is parody may

77. *Compare* Tetley, Inc. v. Topps Chewing Gum, Inc., 556 F. Supp. 785, 793 (E.D.N.Y. 1983).

78. *Compare* Berlin v. E.C. Publ’ns, Inc., 329 F.2d 541, 546 (2d Cir. 1964).

79. *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031, 1034 (N.D. Ga. 1986).

be what is at work here. If the court was saying this was a simple “rip off,” and “I’m not buying the parody excuse,” that appears to be defensible fact-finding.

2. By the mid-eighties, “When Sunny Gets Blue” had become an often-recorded, somewhat saccharine popular music standard, ripe for parody in at least one person’s view. The “parody” copied the first six of thirty-eight bars of the original, and tracked the first three lines of lyrics as follows: “When Sunny gets blue” became “When Sonny sniffs glue”; “Her eyes get gray and cloudy” became “Her eyes get red and bulgy”; and “Then the rain begins to fall . . .” becomes “Then her hair begins to fall. . . .” Characterizing the parody as “innocuous—silly perhaps, but surely not obscene or immoral,” the Court of Appeals affirmed a grant of summary judgment against the rights holder,⁸⁰ stating that “the economic effect of a parody with which we are concerned is . . . whether it *fulfills the demand* for the original. Biting criticism suppresses demand; copyright infringement usurps it.”⁸¹

3. Miller Brewing, after failing to obtain the services of the (then) popular singing group The Fat Boys for a TV beer commercial, hired look-alikes to perform in the commercial, imitating the distinctive style of the originals. This resulted in a lawsuit for copyright infringement of certain of the original group’s songs and recordings, false designation of origin and unfair competition under the Lanham Act⁸² and state statutory and common law claims under principles of pendent jurisdiction.⁸³ Miller moved to dismiss for failure to state a claim because the commercial was a parody. While the court recognized that parody “qualifies generally as fair use under the copyright law”⁸⁴ and “as a defense to a Lanham Act claim,”⁸⁵ it ruled, succinctly, that:

. . . [the d]efendants’ commercial does not qualify as parody. The commercial’s use is entirely for profit: to sell beer. Even if the concept of parody is impermissibly stretched to include this commercial, it does not even qualify as fair use, since . . .

80. Fisher v. Dees, 794 F.2d 432 (9th Cir. 1986).

81. *Id.* at 437-38. The Court went on to observe: “Like a speech, a song is difficult to parody effectively without exact or near-exact copying. If the would-be parodist varies the music or meter of the original substantially, it simply will not be recognizable to the general audience. This ‘special need for accuracy’ provides some license for ‘closer’ parody.” *Id.* at 439.

82. 15 U.S.C. §§ 1051-1127.

83. Tin Pan Apple, Inc. v. Miller Brewing Co., Inc., 737 F. Supp. 826 (S.D.N.Y. 1990).

84. *Id.* at 829.

85. *Id.* at 833.

the commercial in no manner “builds upon the original,” nor does it contain elements “contributing something new for humorous effect or commentary.”⁸⁶

It is interesting that the court viewed the fair use copyright defense as applicable to the claims of trademark infringement, and at least touches on certain of the definitional prerequisites for parody.

2. Trademark Cases

Most of the parody action during the period arose in trademark cases, of which fourteen are discussed.

1. A famous maker of outdoor gear and clothing sued the publisher of *High Society* magazine over a self-described “prurient parody,” two-page section labeled “L.L. Bean’s Back-to-School Sex Catalog,” which depicted “nude models in sexually explicit positions using ‘products’ that were described in a crudely humorous fashion.” The trial court’s summary judgment of (Maine) dilution by tarnishment was reversed.⁸⁷ The court correctly observed that the “ridicule conveyed by parody inevitably conflicts with one of the underlying purposes of the Maine anti-dilution statute [—] to protect against the tarnishment of the goodwill and reputation associated with a particular trademark.”⁸⁸ It also correctly observed that the parody used the [Beam] mark “solely to identify Bean as the object of its parody.”⁸⁹ It admitted that its reluctance to apply the statute “stem[med] from a recognition of the vital importance of parody [which, while] often offensive, is nevertheless ‘deserving of substantial freedom—both as entertainment and as a form of social and literary criticism. . . .’”⁹⁰ The court went on to explain:

The central role which trademarks occupy in public discourse (a role eagerly encouraged by trademark owners), makes them a natural target of parodists. Trademark parodies, even when offensive, do convey a message. The message may be simply that business and product images need not always be taken too seriously; a trademark parody reminds us that we are free to laugh at the images and associations linked with the mark. The message also may be a simple form of entertainment

86. *Id.* at 832.

87. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987).

88. *Id.* at 28.

89. *Id.* at 33.

90. *Id.* at 33, quoting *Berlin v. E.C. Publ’ns, Inc.*, 329 F.2d 541, 546 (2d Cir. 1964).

conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark's owner. . . . While such a message lacks explicit political content, that is no reason to afford it less protection under the first amendment.⁹¹

This is a well-thought-through libertarian view of the subject, but it nonetheless begs some questions. Is the message that self-important business and product images need not be taken "too" seriously really in such danger of suppression that its iteration requires First Amendment protection? Do "nude models in sexually explicit positions using '[faux] products' . . . described in a crudely humorous fashion" truly reflect (or comment on) "the images and associations linked with" L.L. BEAN? Do they even constitute "juxtaposing the irreverent representation of the trademark with the idealized image created by the mark's owner"? And, finally, is there any desecration of a mark that can flunk this test of free speech?

2. When two not-so-svelte women in New Mexico decided to make and sell jeans in which they and those like them could be comfortable in the fashionable eighties, they considered adopting the brand names CALVIN SWINE and VIDAL SOWSOON, but instead opted for the subtlety of LARDASHE, with a smiling pig design on the rear pocket. The makers of JORDACHE (pronounced "jord-ash"), the nation's fourth best-selling brand of jeans, were not amused. They sued, lost on likelihood of confusion, and appealed.⁹² On appeal, they found themselves espousing the argument that copying their brand name, which undeniably had happened, demonstrated "intent," which is a factor in the likelihood of confusion analysis. That argument was dismissed for an interesting reason:

In one sense, a parody is an attempt "to derive benefit from the reputation" of the owner of the mark, . . . if only because no parody could be made without the initial mark. *** Of course, a parody of an existing trademark can cause likelihood of confusion. . . . Our single concern here, however, is whether an intent to parody an existing trademark supports an inference of likelihood of confusion under the reasoning that one who chooses a mark similar to an existing trademark intends to confuse the public. . . . We hold that it does not.⁹³

91. *Id.* at 34.

92. *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987).

93. *Id.* at 1486.

Here, the “parody” was the brand of a product that competed with the original JORDACHE-branded product. The benefit LARDASHE derived from its resemblance to JORDACHE did not end with its attempt to parody; the very use of the parody mark was so reminiscent of the original, that, arguably, it gave the parody brand a credibility and cachet in competing against other brands it otherwise would lack. It may not have been confusion, but it was an appropriation resulting in the distinct competitive advantage of association with an established brand, as well as some diminution of distinctiveness of the source brand (the court also dismissed a state law dilution claim).

3. When a local protester against nuclear holocaust began selling T-shirts and mugs decorated with a feather-bonneted, emaciated human head and the words “Mutant of Omaha” (and, sometimes, “Nuclear Holocaust Insurance), the Mutual of Omaha Insurance Company, whose logo depicts a Native American garbed in a chief’s headdress, sued rapidly, and enjoined the protester’s trademark infringement.⁹⁴ The court concluded that Mutual of Omaha’s property rights in its trademark “need not ‘yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.’”⁹⁵ Pointing out that defendant was enjoined only from using Mutual of Omaha’s rights to market or identify his services or products, the court explained: “Other avenues for Novak to express his views exist. . . . [I]t in no way” would infringe “were Novak to present an editorial parody in a book, magazine, or film. . . .”⁹⁶ If one can get past the sheer lunacy of the “parody”—who could be more opposed to nuclear holocaust than an insurance company?—there is logic to the notion one may ridicule another’s name and reputation as a matter of free speech, but the license does not extend to the sale of merchandise under that name or reputation, even in ridicule.

4. The next case comprised pages of heavy thinking in the Second Circuit. It arose upon the release of an Italian movie entitled “Ginger and Fred” about the televised reunion of two cabaret dancers, Pippo and Amelia, whose imitations of Fred Astaire and Ginger Rogers motion picture dance numbers had earned them the sobriquet which became the movie’s title. The plaintiff was Ginger Rogers, claiming false representation and violation of her right of publicity. The problem confronting the court was a balancing of interests:

94. *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987).

95. *Id.* at 402, quoting *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972).

96. *Id.*

Movies, plays, books, and songs are all indisputably works of artistic expression and deserve protection. Nonetheless, they are also sold in the commercial marketplace like other more utilitarian products, making the danger of consumer deception a legitimate concern that warrants some government regulation.⁹⁷

The lower court had granted summary judgment on First Amendment grounds, holding the Lanham Act inapplicable to titles. That went too far:

We believe in general that the [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression. In the context of allegedly misleading titles using a celebrity's name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.⁹⁸

Apparently determining that the title (or at least the "Ginger" part of it) had some artistic relevance "whatsoever" to the underlying work, and that at worst it implicitly misled as to the source or content of the work, the court approved the title and furnished a few ponderous pages of loosely connected, but eminently quotable, judicial observations for future generations to ponder.

Rogers was not a parody case, but it nevertheless colored considerable thought in subsequent parody cases, and has been a primer for attempts to balance free speech in non-parodic art against the likelihood of confusion prohibitions of trademark law.

5. The publisher of *Cliff's Notes* study guides took umbrage when the humor magazine *Spy* published what it intended to be a double parody of *Cliff's Notes* and three then-modern urban-angst novels. The cover of the *Spy Notes* aped the *Cliff's Notes* trade dress except for several conspicuous notices that the book was

97. *Rogers v. Grimaldi*, 875 F.2d 994, 997 (2d Cir. 1989).

98. *Id.* at 999. In a contemporaneous article, the author wrote: "Upon analysis, the construct seems to result in condemnation of titles that invite confusion with other movies, books or plays, and those that lead the public to perceive a connection with a person (or property?) where one otherwise does not exist, but resolves ambiguity in favor of artistic freedom. That appears to be a likely result if the First Amendment is ignored, and the virtually certain result if free speech is given the limited role of dictating the resolution of substantial doubt against likelihood of confusion." *The Forty-Second Year of Administration of the Lanham Trademark Act of 1946*, 79 TMR 757, 822 (1989).

“satire.” A preliminary injunction was reversed.⁹⁹ The court announced that “[a] parody must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is *not* the original and is instead a parody.”¹⁰⁰ In the author’s experience, the messages are almost always sequential, rather than simultaneous. The court continued that “[t]o the extent that [the parody] does only the former [the original] but not the latter [*not* the original] it is not only a poor parody but also vulnerable under trademark law, since the consumer will be confused.”¹⁰¹ The court concluded that

... the parody cover of *Spy Notes*, although it surely conjures up the original and goes to great lengths to use some of the same colors and aspects of the cover design of *Cliff’s Notes*, raises only a slight risk of consumer confusion that is outweighed by the public interest in free expression, especially in a form of expression that must to some extent resemble the original.¹⁰²

6. When the makers of DOM PERIGNON champagne encountered “champop,” which was popcorn in a champagne bottle-like container labeled DOM POPIGNON, they sued. The defendant moved to dismiss for failure to state a claim for relief. The motion was (predictably) denied because the champop was “not a sufficiently strong parody to destroy the potential for consumer confusion. Defendant’s product has a functional use and is not so outlandish as to distinguish itself from plaintiff’s champagne. . . . [P]laintiff has stated a valid cause of action, and a jury should be allowed to weigh the facts. . . .”¹⁰³

7. One might suppose that a television advertising campaign has come of age when another campaign pokes fun at it. The EVEREADY Battery Co. did not appreciate that irony when its drum-beating pink toy bunny (who keeps going and going and going) was imitated by COORS LIGHT beer (“the official beer of the nineties, is the fastest growing light beer in America. It keeps growing and growing and growing. . .”).¹⁰⁴ The visual was of comedic actor Leslie Nielsen, dressed in a conservative dark

99. *Cliff’s Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc.*, 886 F.2d 490 (2d Cir. 1989).

100. *Id.* at 494.

101. *Id.*

102. *Id.* at 497.

103. *Schieffelin & Co. v. Jack Co. of Boca, Inc.*, 725 F. Supp. 1314, 1324 (S.D.N.Y. 1989).

104. *Eveready Battery Co., Inc. v. Adolph Coors Co.*, 765 F. Supp. 440 (N.D. Ill. 1991).

business suit, white rabbit ears, a fuzzy white tail and big pink rabbit-foot slippers beating a drum and spinning a few times in a manner reminiscent of the ENERGIZER bunny. The court denied a preliminary injunction after defining the trademark issue as “does the Coors commercial cause its viewers to correlate Coors and its products or symbols with Eveready and its products and symbols in terms of origin, sponsorship or approval?”¹⁰⁵ That analysis missed the point, which was that the COORS commercial was mocking the EVEREADY campaign to call attention to itself and, at most, to comment that the EVEREADY commercial, in the words of the court in *L.L. Bean*,¹⁰⁶ “need not be taken too seriously”—as if that were a significant risk.

8. When an entrepreneur in Seattle marketed a HARD RAIN T-shirt, the message of which was in the instantly recognizable HARD ROCK CAFE typeface, the court instantly found likelihood of confusion, observing that “[a] defendant’s claim of parody will be disregarded where the purpose of the similarity is to capitalize on a famous mark’s popularity for the defendant’s commercial use. . . . [T]his case is different from those cases in which courts have found . . . true parody.”¹⁰⁷

9. The following year on the other coast, a T-shirt designer had better luck when he decorated T-shirts with a big BUDWEISER beer label—with a few inane changes: BUDWEISER became MYRTLE BEACH, S.C.; “Anheuser-Busch, Inc., St. Louis, Mo.” became “Myrtle Beach, S.C.”; “King of Beers” became “King of Beaches”; and “This Bud’s for You” became “This Beach is for You.” The jury ruled for the local merchant. The trial court granted judgment notwithstanding the verdict. On appeal, the court thought “that a reasonable jury could find that the T-shirt was readily recognizable as a parody [especially unlikely to create confusion in the minds of ordinary consumers], and that such a

105. *Id.* at 449. There were also copyright claims, as to which the court ruled that the effect of a parody with which it was concerned is not its potential to destroy or diminish the market for the original—any bad review can have that effect—but rather whether it fulfilled the demand for the original. Biting criticism suppresses demand; copyright infringement usurps it. Thus, infringement occurs when a parody supplants the original in markets the original is aimed at, or in which the original is or has reasonable potential to become, commercially valuable. *Id.* at 448, quoting *Fisher v. Dees*, 794 F.2d 432 (9th Cir. 1986). That analysis does not make a lot of sense when one considers that both works are television commercials, as to which consumer “demand” is difficult, at best, to measure.

106. *L.L. Bean, Inc. v. Drake Publishers*, 811 F.2d 26 (1st Cir. 1987).

107. *Hard Rock Café Licensing Corp. v. Pacific Graphics, Inc.*, 776 F. Supp. 1454, 1462 (W.D. Wash. 1991).

finding provides additional support for the jury's verdict."¹⁰⁸ This decision apparently lowered the bar for parody to new depths.

10. For its annual holiday gifts issue, *New York* magazine decided to reflect the slowing economy and mark the passing of a decade of free-spending and self-indulgence by adopting a theme of "thrift," which it chose to reflect on its cover with a "whimsical" pastiche of the perennial cover of *The Old Farmer's Almanac*. The conclusion that confusion was unlikely and First Amendment protection applied was not very difficult, but the court took pains to explain that First Amendment protection extends beyond just parody:

... Because unauthorized uses that provoke litigation, both in the copyright and in the trademark field [sic], often involve parody, the decisions often discuss the special latitudes that are afforded to parody. But parody is merely an example of the types of expressive content that are favored in fair use analysis under the copyright law and First Amendment deference under the trademark law. Indeed, of the two leading trademark cases that have explained that deference in the Second Circuit, while *Cliff's Notes* dealt with parody, [Ginger] *Rogers v. Grimaldi* did not. The message of these cases is not merely that parody is accorded First Amendment deference, but rather that the use of a trademark in the communication of an expressive message is accorded such deference.¹⁰⁹

The message here is that it is "expressive content" that is afforded First Amendment deference, not just anything in general.

11. The BLACK DOG restaurant and bakery on Martha's Vineyard, a Summer resort island, has enough notoriety to support a BLACK DOG T-shirt business with a black dog design on the front and "The Black Dog, Martha's Vineyard [year of purchase]" on the back. One year, an iconoclast sold screen-printed T shirts with a black dog lying on its back, legs aloft, and the back legend: "The Dead Dog, Martha's Vineyard [year of purchase]." The following year, the defendant, as he would come to be, changed the dog design to one of a dog skeleton, and introduced a "Black Hog" shirt.¹¹⁰ "Absent contrary guidance from" a superior court, the court saw no reason to abandon the "likelihood of confusion analysis, 'provided that it is applied with special sensitivity to the

108. *Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.2d 316, 321 (4th Cir. 1992).

109. *Yankee Publ'g Inc. v. New America Publ'g, Inc.*, 809 F. Supp. 267, 279 (S.D.N.Y. 1992).

110. *Black Dog Tavern Co., Inc. v. Hall*, 823 F. Supp. 48 (D. Mass. 1993).

purposes of trademark law and the First Amendment.” Noting that when one chooses “a mark as a parody of an existing mark, the intent is not necessarily to confuse the public but rather to amuse,” the court concluded that “ordinarily prudent customers are [not] likely to believe that plaintiff produced or otherwise endorsed defendant’s goods. . . .”¹¹¹

12. Selling used clothing on consignment under the name SACKS THRIFT AVENUE caught the eye of upscale department store chain SAKS FIFTH AVENUE, which sued. After a two-day trial, SAKS obtained a judgment of trademark infringement and (state law) dilution. The defendant admitted to believing SACKS THRIFT AVENUE to be a “clever play on words.”¹¹² Although the court recognized that an intent to parody is not an intent to deceive the public, it ruled in favor of an injunction. The best legal defense defendant could muster was fair descriptive use, which the court ruled, “cannot be a defense in this action unless ‘Sacks’ is defendant’s name, or ‘Thrift Avenue’ is the geographic origin of the goods or services. 15 U.S.C. § 1115(b)(4). Neither is true.”¹¹³

13. When the back cover of *Snicker*, a minor humor magazine published a faux advertisement for “Michelob Oily,” Anheuser-Busch (brewers of the BUDWEISER, BUSCH, and MICHELOB families of beers) found it about as amusing as one would expect. The appellate opinion describes the advertisement very well:

The advertisement states in bold type, “ONE TASTE AND YOU’LL DRINK IT OILY” immediately above “MICHELOB OILY®.” The accompanying graphics include a partially-obscured can of Michelob Dry [sic] pouring oil onto a fish, an oil-soaked rendition of the A & Eagle design (with the eagle exclaiming “Yuck!”) below a Shell Oil symbol, and various “Michelob Oily” products bearing a striking resemblance to appellants’ Michelob family. This resemblance was quite intentional, as evidenced by the admitted use of actual Anheuser-Busch “clip-art” in replicating several of the protected trademarks. In smaller text the ad opines, “At the rate it’s being dumped into our oceans, lakes and rivers, you’ll drink it oily sooner or later, anyway.” Finally, the following disclaimer is found in extremely small text running vertically along the right side of the page: “Snicker Magazine Editorial

111. *Id.* at 57-58, quoting *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 814 F. Supp. 791 (E.D. Mo. 1993), *rev’d*, 28 F.3d 769 (8th Cir. 1994).

112. *Saks & Co. v. Hill*, 843 F. Supp. 620, 624 (S.D. Cal. 1993).

113. *Id.* at 625.

by Rich Balducci. Art by Eugene Ruble. Thank goodness someone still cares about quality (of life).”¹¹⁴

At trial, the publisher/author explained that the intent of the “ad” was to comment upon: “(1) the effects of environmental pollution, including a specific reference to the then-recent Shell oil spill in the Gasconade River—a source of Anheuser-Busch’s water supply; (2) Anheuser-Busch’s subsequent decision to temporarily close its St. Louis brewery; and (3) the proliferation of Anheuser-Busch beer brands and advertisements. The defendants concede they possessed no knowledge that any Anheuser-Busch product actually contained oil.”¹¹⁵ It is fair to say that this was probably not the most sharply focused parody in history, but it does seem to make more sense than “Mutant of Omaha.”¹¹⁶ It is also fair to posit that free speech is a right accorded all of us, not just those whose wit is finely honed (assuming there is a rational basis for distinguishing sharp wit from dull).

The trial court dismissed the case. The appellate panel saw the case on appeal as follows:

This case involves the tension between the protection afforded by the Lanham Act to trademark owners and the competing First Amendment rights of the parodist. Our analysis of the district court’s decision encompasses two related, but distinct steps. We begin by considering whether the district court erred in finding no likelihood of confusion. Since a trademark infringement action requires a likelihood of confusion, this finding, if upheld, decides this case. If we conclude the court erred in finding no likelihood of confusion, we must consider Balducci’s additional argument that the First Amendment protects it from liability.¹¹⁷

Relying in part on a survey,¹¹⁸ and the comment by the trial court

114. *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 772 (8th Cir. 1994).

115. *Id.*

116. *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987).

117. *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d at 773.

118. The survey showed that 6% of the respondents believed the plaintiff was the source of the advertisement, but that roughly 50% thought the “advertisement” had to be approved or permitted by the plaintiff. Six per cent confusion of source or association is not enough to establish likelihood of confusion; indeed, it approximates the “noise level of most surveys—noise being that segment of the respondents who consistently get everything wrong, no matter how clear or obvious. Asking if the mark owner had to authorize such a use, aside from being leading, tests the survey universe’s knowledge of the law, but not likelihood of consumer confusion. It has, however, been accepted previously in at least one non-parody case. What this result suggests is that half the public believes you need permission to poke fun at someone else’s trademark, which plainly means that half the public is wrong. Indeed,

that, at first blush, the parody ad looked like a MICHELOB advertisement, the court found likelihood of confusion.¹¹⁹

... Thus, we must weigh the public interest in protecting Balducci's expression against the public interest in avoiding consumer confusion.

Applying this standard, we are convinced that the First Amendment places no bar to the application of the Lanham Act in this case. As we have discussed, Balducci's ad parody was likely to confuse consumers as to its origin, sponsorship or approval. This confusion might have to be tolerated if even plausibly necessary to achieve the desired commentary—a question we need not decide. In this case, the confusion is wholly unnecessary to Balducci's stated purpose. By using an obvious disclaimer, positioning the parody in a less-confusing location, altering the protected marks in a meaningful way, or doing some collection of the above, Balducci could have conveyed its message with substantially less risk of consumer confusion.

* * *

Balducci's ad, developed through the nearly unaltered appropriation of Anheuser-Busch's marks, conveys that it is the original, but the ad flounders on its failure to convey that it is not the original. Thus, it is vulnerable under trademark law since the customer is likely to be confused. . . .¹²⁰

So here, a humor magazine, attempting to parody plaintiff's brand proliferation (and a few other things as well) is branded an infringer, because he took too much from the original. One suspects that almost nobody paying much attention to the advertisement believed it to be a real MICHELOB advertisement; it is simply too outlandish (and the 6% confused survey result supports that conclusion).

This can be considered the last significant parody case before the Supreme Court weighed in.

the result is equally consistent with the notion that the entire surveyed universe is ignorant on the subject, because 50–50 is about what one will get if one asks a question to which nobody knows the answer, assuming there is nothing in the question that biases the response.

119. Normally, in the Eighth Circuit, “[t]he determination of whether ‘likelihood of confusion’ exists is a factual determination which we review under the clearly erroneous standard. . . . However, our review is not so limited when, as here, the district court’s ‘conclusions are inextricably bound up in its view of the law.’” *Id.*

120. *Id.* at 776-77.

D. The Supreme Court Speaks

*Campbell v. Acuff-Rose Music, Inc.*¹²¹ was decided almost four months before *Anheuser-Busch*, but the latter was submitted and was decided on a record closed before the *Campbell* decision was issued. *Campbell*, most assuredly, was a copyright case, decided under the “fair use” provision of the Copyright Act. However, it came to be recognized in at least one circuit that:

... [W]hatever protection is to be afforded a trademark parody must be informed by the Supreme Court’s recent elucidation in the copyright context of parodies allegedly protected by the defense of fair use. “[T]he heart of any parodist’s claim to quote from existing material[] is the use of some elements of a prior author’s composition to create a new one that, at least in part, *comments on that author’s works.*” The comment must have some “critical bearing on the substance or style of the original composition.”... The Supreme Court’s parody explication as to copyrights, set forth in the context of an expressive work, is relevant to trademarks, especially a trademark parody that endeavors to promote primarily non-expressive products such as a competing motorcycle repair service...¹²²

The common thread, of course, is parody, and certainly the Supreme Court’s “elucidation” of parody is what defines parody for any purpose. *Harley Davidson* identified one lesson—that parody uses elements of the original to create something new that comments on the original—but failed to add that “[t]he threshold question when fair use is raised in defense of parody is whether a parodic character may reasonably be perceived.”¹²³ Another observation in *Campbell* that has ready applicability to trademark law is:

... If, on the contrary, the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to

121. 510 U.S. 569 (1994).

122. *Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999), internal citations omitted. Motorcycle maker Harley-Davidson sued the owner of a motorcycle repair shop he called “The Hog Farm”; the owner used a “bar and shield” logo similar to one used by Harley. “Hog farm” was not actionable because “hog” is a generic name for the kind of motorcycle Harley builds. The logo, however, was actionable, because it in no way commented on Harley and was used to promote a competing service.

123. *Campbell*, 510 U.S. at 582.

fairness in borrowing from another's work diminishes accordingly (if it does not vanish), and other factors, like the extent of its commerciality, loom larger.¹²⁴

Also of interest is one element of the Supreme Court's discussion of the first "fair use" factor, the purpose and character of the use:

The central purpose of this investigation is to see . . . whether the new work merely "supersede[s] the objects" of the original creation, . . . or instead adds something new, with a further purpose of different character, altering the first with new expression, meaning or message; it asks, in other words, whether and to what extent the new work is "transformative."¹²⁵

"Transformative," however, can be a slippery word, because it is the adjectival form of the transitive verb "transform," which can mean any of the following: "1 a: to change in composition or structure[;] b: to change the outward form or appearance of[;] c: to change in character or condition: convert[;] 2: to subject to mathematical transformation[;] 3: to cause (a cell) to undergo genetic transformation."¹²⁶ It should narrow areas of dispute to recognize "transformative" as copyright shorthand for "adds something new, with a further purpose of different character, altering the first with new expression, meaning or message."

It is helpful to see exactly what the Supreme Court ruled at least might be parody (the actual decision remanded for further consideration of the question). At issue were the lyrics of the song "Oh, Pretty Woman" and a purported parody, "Pretty Woman," by the rap music group 2 Live Crew. The complete lyrics are compared in an Appendix to the opinion,¹²⁷ but a fair idea of the discrepancies can be gleaned from the last few lines of the original¹²⁸ and the

124. *Id.* at 580.

125. *Id.* at 579, citing *Folsom v. Marsh*, 9 F. Cas. 342, 348 (No. 4,901)(C.C.D. Mass. 1841) and Pierre Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1111 (1990). This *is* the copyright test of parody, once the threshold of reasonable perception is passed. It seems trademark parody should have the same, or an analogous, effect to be protected as parody.

126. Merriam-Webster online, <http://www.merriam-webster.com/dictionary/transformative>.

127. *Campbell*, 510 U.S. at 594-96.

128. "Pretty Woman, don't walk away,
Hey, O.K.
If that's the way it must be, O.K.
I guess I'll go on home, it's late
There'll be tomorrow night, but wait!
What do I see?"

purported parody,¹²⁹ which arrive at the same denouement. As the Supreme Court explained:

While we might not assign a high rank to the parodic element here, we think it fair to say that 2 Live Crew's song reasonably could be perceived as commenting on the original or criticizing it, to some degree. 2 Live Crew juxtaposes the romantic musings of a man whose fantasy comes true, with degrading taunts, a bawdy demand for sex, and a sigh of relief from paternal responsibility. The latter words can be taken as a comment on the naiveté of the original of an earlier day as a rejection of its sentiment that ignores the ugliness of street life and the debasement that it signifies. It is this joinder of reference and ridicule that marks off the author's choice of parody from other types of comment and criticism that traditionally have had a claim to fair use protection as transformative works.¹³⁰

The Court did not say whether also it reasonably could be perceived that the lyrics at issue simply debase the original to no apparent purpose, parodic or otherwise.

Finally, just as economic harm to the originator is a factor to consider in copyright fair use, it is one trademark plaintiffs are prone to argue against parodies. But as the Supreme Court pointed out,

[W]hen a commercial use amounts to near duplication of the entirety of an original, it clearly "supersedes the objects" . . . of the original and serves as a market replacement for it, making it likely that cognizable market harm to the original will occur. . . .

We do not, of course, suggest that a parody may not harm the market at all, but when a lethal parody, like a scathing theater review, kills demand for the original, it does not produce a harm under the Copyright Act. Because "parody may quite legitimately aim at garroting the original, destroying it commercially as well as artistically," . . . , the role of the courts is to distinguish between "[b]iting criticism

Is she walkin' back to me?
Yeah, she's walking back to me!
Oh, Pretty Woman."

129. "Two timin' woman girl you know you ain't right/Two timin' woman you's out with my boy last night/Two timin' woman that takes a load off my mind/Two timin' woman now I know the baby ain't mine/Oh, two timin' woman/Oh, pretty woman."

130. *Campbell*, 510 U.S. at 583, footnote omitted.

[that merely] suppresses demand [and] copyright infringement [, which] usurps it.”¹³¹

E. The Aftermath of “Pretty Woman”

In the decade after *Campbell v. Acuff-Rose*, there were at least twelve significant copyright or trademark parody cases other than *Vuitton v. Haute Diggity Dog*¹³² and *Harley-Davidson*.¹³³

1. When the movie *Muppet Treasure Island* included a pig-like “Muppet” character named “Spa’am,” the canned lunch meat manufacturer quickly sued. The court reasoned that this was “simply another in a long line of Muppet lampoons,” that “this Muppet brand of humor is widely recognized and enjoyed,” so that consumers “are likely to see the name ‘Spa’am’ as the joke it was intended to be.”¹³⁴

2. Among the many analyses of the notorious O.J. Simpson criminal murder trial is a work entitled “The Cat Not in the Hat,” which was written and illustrated in a style that imitated that of famous children’s book author “Dr. Seuss,” and was attributed to “Dr. Juice.” It was clever, but copyright-infringing because, while there was imitation, there was no comment or criticism of the original. It was also trademark-infringing, because:

... In a traditional trademark infringement suit founded on the likelihood of confusion rationale, the claim of “parody” is not really a separate “defense” as such, but merely a way of phrasing the traditional response that customers are not likely to be confused as to source, sponsorship or approval.¹³⁵

The first two cases are congruent in that they basically ignored *Campbell v. Acuff-Rose*, and decided on a straight likelihood of confusion analysis weighed by the recognition of “parody,” albeit different results were reached, presumably because of the pervasiveness of the “parody” in *Seuss*. *Seuss* did discuss copyright fair use under the *Acuff-Rose* doctrine, but concluded that the imitation was not “fair” because it said nothing about the original and was used solely to attract attention.

131. *Id.* at 591-92, some citations omitted. The “garroting” quote is from Benjamin Kaplan, *An Unhurried View of Copyright* 69 (Columbia University Press) (1967); the “biting criticism” quote is attributed to *Fischer v. Dees*, 794 F.2d 432 (9th Cir. 1986).

132. See cases cited *supra* notes 10-27.

133. *Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999); see also *supra* text accompanying note 121.

134. *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 503 (2d Cir. 1996).

135. *Dr. Seuss Enters., L.P. v. Penguin Books, USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997).

3. Among the better-known photographs by Annie Liebovitz is a copyrighted one of celebrity Demi Moore, quite pregnant and “depicted nude, in profile, with her right hand and arm covering her breasts and her left hand supporting her distended stomach—a well known pose evocative of Botticelli’s *Birth of Venus*.”¹³⁶ To advertise its upcoming movie *Naked Gun 33 1/3: The Final Insult*, the defendant hired another pregnant model and photographer to reproduce the Liebovitz/Moore pose and portrait as closely as they could, superimposed in the photograph the face of actor Leslie Nielsen (who had earlier imitated the “Energizer bunny” in the *Eveready Battery* case¹³⁷), and added the movie’s title and the words “due this March.” Ms. Liebovitz lost when the parties cross-moved for summary judgment, and again on appeal:

... Plainly, the ad adds something new and qualifies as a “transformative” work. Whether it “comments” on the original is a somewhat closer question. Because the smirking face of Nielsen contrasts so strikingly with the serious expression on the face of Moore the ad may reasonably be perceived as commenting on the seriousness, even pretentiousness, of the original. The contrast achieves the effect of ridicule that . . . serve[s] as a sufficient “comment.” . . . Being different from an original does not inevitably “comment” on the original. Nevertheless, the ad is not merely different; it differs in a way that may reasonably be perceived as commenting, through ridicule, on what a viewer might reasonably think is the undue self-importance conveyed by the subject of the Liebovitz photograph. A photographer posing a well known actress in a manner that calls to mind a well known painting must expect, or at least tolerate, a parodist’s deflating ridicule.”¹³⁸

What is most interesting is that the analysis is spot on with the parody requirement of comment upon the original set forth in *Acuff-Rose*. The result was not necessarily compelled by the facts, since the analysis was subjective, but it seems to be a reasonable one, which is all *Acuff-Rose* required. It may not have been the only reasonable analysis of the specific facts, but that is the nature of subjective analysis.

4. Another would-be parodist, the owner of the VELVET ELVIS restaurant and bar, parodied “the faddish, eclectic bars of

136. *Liebovitz v. Paramount Pictures Corp.*, 137 F.3d 109, 111 (2d Cir. 1998).

137. *Eveready Battery Co., Inc. v. Adolph Coors Co.*, 765 F. Supp. 440 (N.D. Ill. 1991). See note 4 and accompanying text.

138. *Liebovitz*, 137 F.3d at 114-15.

the sixties,” and executed the theme with such décor as lava lamps, beaded curtains, and numerous Elvis Presley paintings and portraits, including one large velvet painting. The trial court’s denial of relief on grounds of parody was reversed on appeal,¹³⁹ primarily because Elvis Presley was not the target of the attempted parody.¹⁴⁰ This case viewed parody not as a defense, but as a factor to consider in assessing likelihood of [trademark] confusion. It implied that “successful” parodies weigh against infringement, while unsuccessful ones do not.

5. BARNEY, a very sweet, purple dinosaur, has endeared himself to many very young children who watch TV; more than a few parents find him exceedingly annoying. One of his fans was, apparently with a parent, watching a baseball game, when a “mascot,” the “Famous Chicken,” appeared to entertain the crowd. The routine involved the chicken outsmarting, and then beating the whey out of, a Barney-like, purple (but otherwise anonymous) dinosaur character. The child was extremely upset, and possibly traumatized. The parents complained to the BARNEY TV show, which, instead of telling them to monitor their child’s television viewing, sued the creator of the “Famous Chicken” for trade dress infringement. The court granted summary judgment on grounds of parody. The dismissal was affirmed on appeal.

... [A]though ... parody is not an affirmative defense to trademark infringement, a parody should be treated differently from other uses that infringe on a trademark. . . . When, as here, a parody makes a specific, ubiquitous trademark the brunt of its joke, the use of the trademark for satirical purposes affects our analysis of the factors to consider when determining whether the use is likely to result in consumer confusion.¹⁴¹

The closest the court came to identifying any comment on the original was that “[c]learly, in the context in which Giannoulas intended to insert a reference to the Barney character, the humor

139. *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188 (5th Cir. 1998).

140. “In the case of the standard likelihood-of-confusion analysis, a successful parody of the original mark weighs against a likelihood of confusion, because, even though it portrays the original, it also sends the message that it is not the original and is a parody, thereby lessening any potential confusion. . . . Therefore, a parody of a mark needs to mimic the original mark and from this necessity arises the justification for the mimicry, *but this necessity wanes when the original mark is not the target of the parody. . . .*” *Id.* at 199-200 (5th Cir. 1999), emphasis added.

141. *Lions Partnership v. Giannoulas*, 179 F.3d 384, 389-90.

came from the incongruous nature of such an appearance, not from an attempt to benefit from Barney's goodwill."¹⁴²

6. People for Ethical Treatment of Animals, an animal rights advocacy organization of some renown, registered the acronym PETA. A would-be parodist registered the domain name www.peta.org, which resolved to a home page for a supposed organization called "People Eating Tasty Animals." As a surprise, and as a presumed joke, it may not have been bad. But the domain name was enjoined because

... [l]ooking at [the] domain name alone, there is no suggestion of a parody. The domain name *peta.org* simply copies PETA's mark, conveying the message that it is related to PETA. The domain name does not convey the second, contradictory, message needed to establish a parody—a message that the domain name is not related to PETA, but that it is a parody of PETA.¹⁴³

It should be noted that the decision addressed only the defendant's Internet address.

7. The first parts of journalist Alice Randall's first book, *The Wind Done Gone* (billed on its dust jacket as "The Unauthorized Parody") was a retelling of parts of the classic Southern novel *Gone With the Wind*, only thinly disguised. Rhett Butler, for example, became "R."; the narrator was the half-sister of "Other" (Scarlett)—same father ("Planter"), different mother (a slave). The guardians of the *Gone with the Wind* legend, perhaps understandably, took offense and sued for copyright infringement, which was preliminarily enjoined until reversed on appeal.¹⁴⁴

While the case was a pure copyright case, it shed light on what, in a literary context, is a "transformative" fair use parody, giving new meaning and purpose to those parts of the original it borrows:

[The parody] is principally and purposefully a critical statement that seeks to rebut and destroy the perspective, judgments and mythology of *GWTW*. Randall's literary goal is to explode the romantic, idealized portrait of the antebellum South during and after the Civil War. . . . Randall's work flips

142. *Id.* at 388. The Court went on to state that "[t]his point is clearly established by the fact that the Chicken's actions toward Barney seem to have always been antagonistic." That a borrowed character's persona might be "incongruous" in the new setting seems, at best, to be a very modest comment upon the original.

143. *People for Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001).

144. *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257 (11th Cir. 2001).

GTWT's traditional race roles, portrays powerful whites as stupid or feckless, and generally sets out to demystify *GWTW* and strip the romance from Mitchell's specific account of this period in our history. . . . It is hard to imagine how Randall could have specifically criticized *GWTW* without depending heavily upon the copyrighted elements of that book.¹⁴⁵

The court explained that “[o]nce enough [of the original] has been taken to assure identification [of the original], how much more is reasonable will depend” on various factors.¹⁴⁶ Identified as considerations were the extent to which the new work’s “overriding purpose and character is to parody the original,” or, alternatively, “the extent to which the parody may serve as a “market substitute” for the original.

8. One of the more successfully merchandised trademarks over several decades is *BARBIE*, originally for action figure dolls and their clothing, more recently for various lifestyles of the dolls. When Aqua, a Danish singing group, recorded its own composition, “Barbie Girl,” which incorporated singing about “a Barbie girl in [her] Barbie world” (“life is plastic, it’s fantastic/You can brush my hair, undress me everywhere . . .”), Mattel sued to stop the music. Both trial and appellate court agreed that the song was a parody, and the title was therefore permissible, because the song “targets Barbie herself.” “[T]he song is about Barbie and the values Aqua claims she represents.”¹⁴⁷

9. The same year, designer brand *TOMMY HILFIGER*, which included fragrance within its stable of products, sued a manufacturer of pet fragrances, some of which purported to parody elegant human fragrances. The occasion for the suit—brought for infringement, dilution, false advertising (“If you like *TOMMY HILFIGER*, you’ll love *TIMMY HOLEDIGGER*”) and unfair competition—was a *TIMMY HOLEDIGGER* pet product. The putative infringer won a motion for summary judgment on the ground that though “unamused,” Hilfiger had not offered evidence of confusion justifying a denial of summary judgment.¹⁴⁸

10. *BARBIE* fell victim to another cultural critic, this time a photographer who created a series of photos (“Food Chain Barbie”) depicting the doll

145. *Id.* at 1270-71.

146. *Id.* at 1273, quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

147. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901-02 (9th Cir. 2002), relying on *Rogers v. Grimaldi*, 875 F.2d 994, 997 (2d Cir. 1989).

148. *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410 (S.D.N.Y. 2002).

... in various absurd and often sexualized positions. ... [He] generally depicts one or more nude Barbie dolls juxtaposed with vintage kitchen appliances. For example, “Malted Barbie” features a nude Barbie placed on a vintage Hamilton-Beach malt machine. “Fondue a la Barbie” depicts Barbie heads in a fondue pot. “Barbie Enchiladas” depicts four Barbie dolls wrapped in tortillas and covered with salsa in a casserole dish in a lit oven.¹⁴⁹

The artist described the series as an attempt to “critique ... the objectification of women associated with [Barbie], and ... [to] ... lambast ... the conventional beauty myth and the societal acceptance of women as objects because this is what Barbie embodies.” He chose Barbie because he believed she was “the most enduring of those products that feed on the insecurities of our beauty and perfection-obsessed consumer culture.”¹⁵⁰

Against this, Mattel advanced expert testimony and a consumer survey that purported to show that the public did not perceive “Food Chain Barbie” as either parody or comment upon the original. To this, the Court responded: “The issue of whether a work is a parody is a question of law, not a matter of public majority opinion.^[151] Parody is an objectively defined rhetorical device”¹⁵² “because parody is ‘a form of social and literary criticism,’ it has ‘socially significant value as free speech under the First Amendment.”¹⁵³ “First Amendment protections do not apply only to those who speak clearly, whose jokes are funny, and whose parodies succeed”¹⁵⁴ and “[a]llowing majorities to determine whether a work is a parody would be greatly at odds with the purpose of the fair use exception and the Copyright Act.”¹⁵⁵

There are at least two ideas embedded in this rationale that beg for further thought.

If parody truly is an objectively defined literary device, the “objective definition” is whether the putative parody “reasonably [can] be perceived as commenting on the original or criticizing it to

149. *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 796 (9th Cir. 2003).

150. *Id.*

151. *Id.* at 801, citing *Campbell*, 510 U.S. at 569.

152. *Id.* at 801.

153. *Id.*, citing *Dr. Seuss Enters., L.P. v. Penguin Books, USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997).

154. *Id.*, quoting *Yankee Publ'g Inc. v. New America Publ'g, Inc.*, 809 F. Supp. 267, 279 (S.D.N.Y. 1992).

155. *Id.*, citing *Campbell*, 510 U.S. at 582.

some degree.”¹⁵⁶ Reasonableness seems not necessarily a trait better (or more objectively?) determined by judges than by jurors, and, indeed, in many cases jurors are charged to determine the behavior of a reasonable person under particular circumstances.

The notion that “First Amendment protections do not apply only to those who speak clearly, whose jokes are funny, and whose parodies succeed” seems very democratic at first blush, and might greatly have benefited the creator of the “objectively” nutty slogan “Mutant of Omaha,” but the social value in articulations of commentary or criticism so bizarre nobody can understand them is highly questionable. Such expressions no doubt have therapeutic value, but that seems not to be a First Amendment concern.

11. When a purveyor of T-shirts (and other paraphernalia) launched a line of dog-themed merchandise that purported to parody three World Wrestling Entertainment (WWE) wrestlers (and even more “Star Wars” characters), the wrestling association acted aggressively, bringing a lawsuit for infringement, dilution and state law claims.¹⁵⁷ The court’s ultimate, multiple-bases conclusion is set forth below (points meriting discussion are numbered in brackets to facilitate subsequent discussion):

Based upon the foregoing, this Court finds that [1] the Big Dog WBDF merchandise parodies WWE’s widely popular characters and phrases, and therefore, [2] the property is entitled to the free expression protections of the First Amendment. Moreover, [3] Big Dog’s merchandise has the intention and effect to amuse rather than confuse the public, and [4] this Court is unable to find a likelihood of consumer confusion. [5] Big Dog’s parodies convey a simple message that business and product images need not always be taken too seriously, and we are reminded that we are free to laugh at the images and associations linked with these icons. [6] Denying Big Dog the opportunity to poke fun at WWE characters and symbols that have become such a major component in today’s entertainment media, would constitute a serious curtailment of a protected form of expression. As such, Big Dog’s motion for summary judgment shall be granted. . . .¹⁵⁸

156. *Campbell*, 510 U.S. at 582.

157. *World Wrestling Fed’n Entm’t, Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413 (W.D. Pa. 2003).

158. *Id.* at 446.

[1] At least at this point, parody is an unexplained conclusion. [2] Parody *per se* is not entitled to First Amendment protection; free speech considerations may be implicated, but it seems unlikely that truly confusing parody will be protected. [3] Lack of intention to confuse does not exculpate what is likely to confuse, and likelihood of confusion does not automatically follow from intent to confuse; demonstrated intent to confuse is sometimes taken as the defendant's "expert" opinion that there will be confusion, and is weighed against the accused infringer in close cases, but it does not establish likelihood of confusion by itself.¹⁵⁹ [4] Inability to find likelihood of confusion is, of course, fatal to infringement claims, but not necessarily to dilution claims. [5] If the "simple message that business and product images need not always be taken too seriously, and . . . that we are free to laugh at the images and associations" is sufficient to invoke First Amendment protection, then the threshold is ridiculously low. That may be one of the truisms underlying free speech, but its invocation is hardly a substitute for the more difficult Supreme Court test of whether critical comment upon the original may rationally be perceived. The protectable value of parody (and part of its dictionary definition) is its capacity to comment on what is being parodied. [6] Simply poking "fun" at something, which in certain situations can be intolerably cruel and even provoke violence, is protected only if it has some intellectual content that gives it free speech value—in the case of parody, it comments on the original. Personifying professional wrestlers as canines seems to fall short of that hurdle.

12. The decisive issue in *MasterCard v. Nader*¹⁶⁰ was whether the accused infringement was a parody by virtue of a reasonably perceptible comment on the original.¹⁶¹ The "original" was a series of MasterCard television commercials, which began by portraying everyday people doing something involving two or three purchases by credit (or debit) card as an announcer intoned the purchase and its price (for example) "fishing pole: thirty-three dollars . . . bait: forty dollars. . . ." This was followed by a warm picture of an old

159. See Restatement (Third) of Unfair Competition § 22 cmt. b ("Use of a designation that is likely to cause confusion . . . is an infringement regardless of whether the actor . . . intends to confuse prospective purchasers.") and cmt. c (while "[t]he actor's intent does not affect the perception of prospective purchasers, it may be appropriate to assume that an actor who intends to cause confusion will be successful in doing so.").

160. *MasterCard Int'l Inc. v. Nader* 2000 Primary Committee Inc., 70 U.S.P.Q.2d 1046 (S.D.N.Y. 2004).

161. Nader also argued that the parody was political free speech in the context of a presidential election, and therefore subject to First Amendment protection; the court made no mention of the issue. The author was counsel for Mr. Nader.

man and small child fishing on a river bank, and “A lazy afternoon with Grandpa: priceless.” The tag line was “There are some things money can’t buy. For everything else, there’s MasterCard.”¹⁶²

The Nader-Green Party campaign ran an advertisement that pictured President Bush, Challenger Gore, Bush again, then Ralph Nader amidst stacks of documents. The narration was: “Grilled tenderloin for fund-raiser: one thousand dollars a plate . . . campaign ads filled with half truths: ten million dollars . . . promises to special interest groups: over one hundred billion dollars . . . finding out the truth: priceless.” The stated object of the advertisement was to include Ralph Nader in upcoming Presidential candidate debates. It appeared on television only a handful of times but had a lively Internet run. It resulted, quite quickly, in suit for trademark (PRICELESS®) and copyright infringement, among other claims.

The court eventually granted summary judgment to Nader, ruling:

Ralph Nader’s Political Ad attempts to show various ways different Presidential candidates can be bought in the “big money arena of Presidential politics” . . . and contrasts the “priceless” truth represented by Ralph Nader as the remedy for the bought and paid for positions of others. Through this depiction, Ralph Nader argues that he not only sends across his own message, but that he wittingly comments on the craft of the original, “which cloaks its materialistic message in warm, sugar-coated imagery that purports to elevate intangible values over the monetary values it in fact hawks.” This commentary “may reasonably be perceived.” . . . The message need not be popular nor agreed with. It may be subtle rather than obvious. It need only be reasonably perceived.”¹⁶³

F. A Suitable Bookend: BUTTWIPER

In October, 2008, Anheuser-Busch struck again, this time on behalf of BUDWEISER.¹⁶⁴ The object of its attention was a dog chew toy that squeaked. It was in the shape of a beer bottle, decorated (intentionally) by a very BUDWEISER-like label (the “brand name” is BUTTWIPER, in front of which is a comic illustration of a dog apparently dragging its “butt” along a

162. This is an apocryphal example of the campaign *circa* 2000; the campaign has evolved since, arguably for the better.

163. *MasterCard*, 70 U.S.P.Q.2d at 1058.

164. *Anheuser-Busch, Inc. v. VIP Prods., LLC*, 666 F. Supp. 2d 974 (E.D. Mo. 2008).

horizontal line, as to which the parties argued whether it represented shadow or dog feces).¹⁶⁵

Post-*Louis Vuitton v. Haute Diggity Dog*, Anheuser mounted a very thorough case, showing BUDWEISER beer sales over an eight-year period of about \$3 billion (wholesale), BUDWEISER-licensed collateral product revenue of \$400 million dollars, and \$148,500 or receipts from “dog toys” over a twenty-eight year period. They also commissioned a survey in which interviewers were asked a series of questions about the BUTTWIPER product.¹⁶⁶ The court distinguished *Louis Vuitton* on the ground that no actual confusion had been demonstrated there, and that the difference in price between the parties’ products was far greater than the difference in price between beer and dog toys. The court waffled more on “Timmy Holedigger,” noting that the parties thereto did not compete; courts are more vigilant in guarding against likelihood of confusion between competitors; and besides, there was no survey there, either.

With respect to parody in general, *Anheuser-Busch, Inc. v. VIP Prods.* stated that parody is not a defense, just a factor to consider in the likelihood of confusion analysis.¹⁶⁷ It also defined *parody* as “a humorous or satirical imitation of a work of art that ‘creates a new artwork that makes ridiculous the style and expression of the

165. The label design was “inspired” by a STANLY STEEMER carpet cleaning service commercial—“Toby’s New Trick.” The commercial is easily found on the Internet by entering “Toby’s New Trick” in the Google search engine (as of the date of this writing.)

166. The questions included: “What company or companies do you think makes or puts out the product you just saw?” [Q1] “Do you think that the company that makes or puts out the product you just saw puts out any other products of brands?” [Q5] “What other products or brands do you think are put out by that company?” [Q6] “Whether or not you know the name of the company that makes or puts out the product you just saw, do you think that company puts out any other products of brands?” [Q 10] “Do you think that the company that makes or puts out the product that you just saw does or does not have a business connection or affiliation with any other company or brand?” [Q 15] “Do you think that the product that you just saw is or is not made or put out with the approval or sponsorship of any other company or brand?” [Q18] *Anheuser-Busch*, 666 F. Supp. 2d at 983. This barrage of questions purportedly demonstrated a 30% “net” confusion rate—which means it is 30% higher than the “confusion” rate between two products with dissimilar attributes. The problem with this survey, magnified several-fold, is that—“The question about whether the two items are put out by the same or a related source is likely to generate so-called ‘demand effects’ that bias the survey by suggesting to respondents, at least implicitly, that they should believe there is at least some sort of relationship between the different items when the possibility might not even have occurred to the vast majority of consumers who see the items.” *Simon Property Group L.P. v. mySimon, Inc.*, 104 F. Supp. 2d 1033, 1048 S.D. Ind. 2000); similarly, see the other cases cited there.

167. *Anheuser-Busch*, 666 F. Supp. 2d at 985, citing *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188 (5th Cir. 1998).

original.”¹⁶⁸ Ultimately, the court concluded that there was registered trademark infringement and a violation of Lanham Act Section 43(a),¹⁶⁹ but was unable to find dilution by blurring or tarnishment.

III. CONCLUSION: WHAT DOES IT ALL MEAN? LESSONS LEARNED, IGNORED AND FORGOTTEN— A PROPOSED PARADIGM FOR DEALING WITH PARODY TRADEMARKS

It may seem odd to begin the conclusion with still another case, but the case illustrates again the need for the conclusion. *Protectmarriage.com*¹⁷⁰ involved groups on opposite sides of the gay marriage issue. *Protectmarriage.com* had lobbied for California Proposition 8, which amended the state constitution to provide that “[o]nly marriage between a man and a woman is valid or recognized in California.” Its logo depicts stylized silhouettes of a man and woman with arms raised to support both ends of a sign. Between the two are similarly stylized figures of a boy and smaller girl. The difference between the male and female figures is that from the ribcage down, the female silhouettes flare out, then, at mid-leg, turn straight back in to represent a skirt. The message on the sign the adult figures are holding is anchored with a large 8 in the center, with “YES on” and “Protect Marriage” flanking the 8.

In due course, the constitutionality of Proposition 8 was contested in court. A gay marriage advocate group, Courage Campaign, started a website to follow developments in the lawsuit. It adorned the website with a logo that duplicated *Protectmarriage.com*’s logo, except: the words flanking the big 8 on the sign are “Prop” and “Trial Tracker,” and both adult silhouetted figures are wearing skirts. The suit was brought under Section 43(a), and a temporary restraining order was sought. After stating the tests of trademark infringement as (1) ownership, and (2) likelihood of confusion, the court dropped the subject and, instead, stated its understanding of *Rogers v. Grimaldi*.¹⁷¹ “Under a test borrowed from the Second Circuit, an artistic work’s use of a mark does not violate the Lanham Act unless the use ‘has no artistic

168. *Anheuser-Busch*, 666 F. Supp. 2d at 985, citing *Eli Lilly & Co. v. Nat’l Answers, Inc.*, 233 F.3d 456, 463 (7th Cir. 2000) and *Rogers v. Koons*, 960 F.2d 301, 309-10 (2d Cir. 1992), the latter of which is a copyright case.

169. 15 U.S.C. § 1125(e).

170. *Protectmarriage.com v. Courage Campaign*, 680 F. Supp. 2d 1225 (E.D. Cal. 2010).

171. 875 F.2d 994, 997 (2d Cir. 1989). See *also* *supra* note 97 and accompanying text.

relevance to the underlying work whatsoever' or the use 'explicitly misleads as to the source or the content of the work.'"¹⁷²

The court then explained that the logo was artistic; the broader website was “undeniably expressive of a political idea, and both political and artistic expression” were “protected by the First Amendment”; any potential for confusion was obviated by the messages and text of “homosexual couples” accompanying the challenged mark; the four parody cases relied upon by the plaintiff all involved the sale of goods; and “[w]hen use of a trademark is protected parody,” further analysis of infringement is unnecessary, but, alternatively, the text and images accompanying defendant’s use of the mark were “sufficient to dispel any possible consumer confusion,” so the plaintiff was unlikely to succeed on the merits.¹⁷³

While the analysis is not as finely honed as one might wish, it does illustrate that courts dealing with alleged parody cases have available to them numerous propositions in prior case law—usually enough to reach any result they might choose. Here, for example, the graphic similarity of the designs is confusingly similar by almost any test. The textual content of the websites as a whole is almost certainly enough to defuse such confusion among much of the attentive public, but that often is the case; when the graphic or verbal ensign of two similar articles (here, websites) are strikingly similar, that often is enough for infringement, and in appropriate cases, dilution by either blurring or tarnishment. In this case, one could as easily, and certainly more persuasively, have found the second logo not to be a parody at all, because it makes no comment on or criticism of the original (and that is arguable either way too). Certainly there were and are alternative ways to express whatever it is the second logo says about the first, without blurring or tarnishing Protectmarriage.com’s logo.¹⁷⁴ While the new logo may represent a political idea, it doesn’t in this context very clearly express that idea because it is so strikingly similar to the original, which represents the opposite political idea.

Precedent furnishes more potentially decisive factors to consider than appear to have been considered in any one case, and most of the more recent cases appear to pluck principles from previous cases either arbitrarily or to support a fore-ordained result, in either case with little or no regard to the principles that weigh against the result reached.

172. *Protectmarriage.com*, 680 F. Supp. 2d at 1229.

173. *Id.*

174. This is meant as a statement of a general proposition; in this particular case, the author does not intend to identify either party as a potential “tarnisher” or “tarnishee.”

Likelihood of confusion, secondary meaning, dilution, and a number of less common issues in trademark cases normally are determined by employing a structured analytical framework: lists of likelihood of confusion factors and secondary meaning factors; tests of what is generic, descriptive, suggestive, arbitrary or fanciful; criteria for determining what is descriptive, surnominal, or nominative fair use; and analogous tools for addressing other issues common to trademark cases. When confronted with any of these, courts have analytical tools to apply. When facing the parody argument or defense, courts have a grab bag of factors and often irreconcilable precedents from which to choose, but no generally accepted methodology for selecting or applying them. There is no accepted structured analysis for deciding what is required to establish trademark parody. There is no shortage of worthy ideas, both pro and anti-parody. But judicial attempts to reconcile and rationalize them have been few, if any. This article proposes a statement of the law of trademark parody.

A. Trademark Parody: A Discussion of Considerations

In trademark cases, parody may be asserted defensively two ways: one is that the fact it is parody makes likelihood of confusion less likely, which is basically a factual argument; the other is that parody is a free speech defense to which likelihood of confusion must yield, which is more of a legal argument, and a questionable one at that. The clearest examples of the latter are the political free speech cases discussed above. *L.L. Bean v. Drake Publishers, Inc.*¹⁷⁵ can be read to elevate parody over state trademark dilution. No case has been found that states consumer confusion is the price we must pay for free speech. But, at least since *Campbell v. Acuff-Rose*, there have been some definitional criteria, theoretically binding on all federal courts, for recognizing parody.

A reasonable starting point is a definition of *parody*. Webster's online dictionary currently defines *parody* as, foremost, "a literary or musical work in which the style of an author or work is closely imitated for comic effect or in ridicule." Secondly, it is "a feeble or ridiculous imitation."¹⁷⁶ The second definition best fits the idea of an inadequate imitation for any purpose, *viz.*—"in his declining years, [the world-renowned tenor's] voice became a parody of its former self." It is the first definition with which we are here concerned, and it has at least three aspects that inform. First,

175. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987).

176. Merriam-Webster online, <http://www.merriam-webster.com/dictionary/parody>.

parody is found in literary or musical works; in today's complex society, one may extrapolate a much wider variety of communicative (or expressive) media—the press, TV, the Internet, some T-shirts, posters, and even some advertising, just to name a few. Second, parody imitates the original closely. Third, it does so for comic effect or ridicule. Leeway to accommodate this historically literary/artistic form of expression to the commercial world of marketing seems necessary, and “comic imitation of known expression” is a good start for identifying parody.

Next, it seems suitable to ask why parody should be a favored or sheltered expression. The Supreme Court answered that in *Campbell v. Acuff-Rose*, and the Second Circuit Court adopted it into trademark law: “the heart of any parodist’s claim to quote from existing material is the use of some elements of a prior author’s composition to create a new one that, at least in part, comments on that author’s works.”¹⁷⁷ It’s a free speech thing. “[W]hether a parodic character may reasonably be perceived” is the threshold question when parody is raised as a defense to appropriation.¹⁷⁸ So, the reason for permitting parody is that expression should not be free from comment, but there needs to be some limit on that comment; one limit is when the comment “may [not] reasonably be perceived.” Another limit appears to be when the imitation exceeds currently sagging societal norms of good taste—Debbie’s “doing” of Dallas and “Cunnilinguis Champion” being two examples. Risqué (the unprepared, pregnant Girl Scout) is tolerated; “gross, revolting” (Debbie, again¹⁷⁹) goes too far.

One justification for the rationality limit on perception of criticism is that would-be parodists are not all articulate, or, one may suspect from some cases, even sane. “Mutant of Omaha” may be a stinging, justifiable indictment of the insurance company in its creator’s mind, but if nobody understands it—and it does seem to defy rational perception as comment—there is not much point to protecting anyone’s right to say it. “Cunnilinguis Champion” is comprehensible in and of itself, but what it says about the original “Boogie-Woogie Bugle Boy [of Company B]” is beyond mystery. “Michelob Oily” probably isn’t. It may be unfair, dopey, and even unappetizing, but what probably was rattling around in its creator’s head can be perceived rationally, and indeed readily, with sufficient factual background. If the value of parody is the

177. *Harley-Davidson v. Grontanelli*, 164 F.3d at 813 (2d Cir. 1999).

178. *Campbell v. Acuff Rose Music, Inc.*, 510 U.S. 569, 582 (1994).

179. A not unfair description, in the author’s opinion; the work is distressingly tawdry, and lacks anything resembling humor, to boot.

communication of comment on or criticism of the original, then the language of that communication needs to be understandable.

If this is so, it undermines one rationale sometimes advanced in support of parody: “[t]he message [of parody] may be simply that business and product images need not always be taken too seriously; a trademark parody reminds us that we are free to laugh at the images and associations linked with the mark.”¹⁸⁰ That is no test at all. In effect it says that even desecration—perhaps a harsh word for that particular case—conveys the idea that we are free to desecrate, without worrying about any possible redeeming critical value. If that is the law, anything goes, which is not much of a balance of competing interests.

One further aspect of *Campbell* merits notice:

... If, on the contrary, the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another’s work diminishes accordingly (if it does not vanish), and other factors, like the extent of its commerciality, loom larger.¹⁸¹

This is the copyright analog of the “free ride” in trademark law: the use of a known mark for the attention value it commands and, often, the favorable reaction it engenders. That is not a purpose of parody. Parody deflates the original; free-riding inflates the copy. One of the forgoing cases seems to have recognized that dichotomy expressly. *D.C. Comics v. Monkey Business Unlimited*¹⁸² involved both copyright and trademark infringement claims. The court noted there that the “[d]efendants do not engage in critical comment that constitutes part of the ‘free flow of ideas’ underlying the doctrine of fair use . . . [but,] instead, . . . seek to augment the commercial value of their own property by creating new, and detrimental, associations with plaintiff’s property.”¹⁸³ The court was supporting its ruling of infringement by reasoning that when the critical benefits of the so-called parody are nil, and the obvious purpose of the “parody” is the “free ride” on the original’s owner’s reputation (and, in this case, among others, diminish it by the association), the balance tips in favor of infringement and against “free speech.”

180. *L.L. Bean*, 811 F.2d at 34.

181. *Campbell*, 510 U.S. at 580.

182. 598 F. Supp. 110, 118 (N.D. Ga. 1984).

183. *Id.* at 118.

Both the Constitution and common sense indicate that there can be greater values than free speech, few though they may be. Shouting “Fire!” in a crowded theatre is a classic example (at least when there is no fire) of the sort of speech that merits condemnation. It is a call to action that may well prove injurious, or even fatal, to some. The greater good, it appears, is to suppress such speech, because there is no perceived benefit to allowing it.

One question that arises in identifying parody is whether the imitation is “comic,” or something resembling funny, presumably in at least a plurality of rational minds targeted by the purported parody. What is funny, of course, is highly subjective, but it can be ascertained with relative ease by survey, and perhaps that is the answer. Better to have the public decide than to have juries caught up in that question. To lawyers, at least, it would seem unwise to entrust the decision to judges, or even professional “experts.”

A difficult sub-issue arises when the “humor” is based on obscenity or scatology: is that funny or just disgusting? That problem is compounded by the fact that society today appears to be more tolerant of crudity and what used to be considered obscene, cruel and offensive is increasingly acceptable. Interestingly, racial and ethnic slurs, and terms demeaning the handicapped and disadvantaged, appear to be less acceptable today than in the past. The “moron” jokes of the author’s childhood, and the ethnic and sexual orientation jokes of his younger adulthood, seem far less prevalent today. Inevitably, current majority standards must be applied, and current community standards—or a judge or jury’s perception of them—will have to be applied, since almost any other standard is even harder to apply with any confidence.

Funny, by itself, is not enough. LARDASCHE, in the author’s speaking and listening experience, is widely regarded as funny. But what does it say about the original, JORDACHE? That JORDACHE jeans wearers have noticeably larger than average rumps? Even if that were the case, so what? Incongruity between image and reality may be funny in and of itself, especially when so cleverly expressed, but what articulable—or even inarticulable—comment or criticism of JORDACHE is LARDASCHE? “Lardass” might target designer jeans in general; LARDASCHE targets one designer jean brand in particular for no apparent reason, and thus is hard to understand as comment or criticism. A rational perception of comment or criticism of the original is the second test of parody.

What, for example, sort of criticism of or comment upon the LOUIS VUITTON brand or product is made by CHEWY VUITON for plush dog toys that “emulate” some of the original brand’s handbags? The closest the court came to answering that question was:

“Finally, the juxtaposition of the similar and dissimilar—the irreverent representation and the idealized image of an LVM handbag—immediately conveys a joking and amusing parody. The furry little ‘Chewy Vuiton’ imitation, as something to be *chewed by a dog*, pokes fun at the elegance and expensiveness of a LOUIS VUITTON handbag, which must *not* be chewed by a dog.”¹⁸⁴

Poking fun at something is not necessarily commenting on or criticizing it. Here the “fun” essentially lies in the trashing of a mark and image painstakingly developed, at great expense, over a long period of years. If this is an acceptable rationalization, then sticking one’s tongue out at dignitaries is comment or criticism. Nobody or thing should be above criticism, but trashing is not criticism. The court came a bit closer to the point when it stated that

[t]he dog toy irreverently presents haute couture as an object for casual canine destruction. The satire is unmistakable. The dog toy is a comment on the rich and famous, on the LOUIS VUITTON name and related marks, and on conspicuous consumption in general.¹⁸⁵

What was not explained was *how* the dog toy is “a comment on the rich and famous and . . . on conspicuous consumption in general.” It also stated that it was “satire,” which is different from parody, as is discussed anon. In short, the “satire” is very mistakable—and very easily “overlookable.”

The third requirement for protectable parody is less directly derived from *Campbell*. Classic parody is a literary or musical device, although by general consensus it appears to have expanded to include moving visual media (movies, TV, and stage) static art (cartoons and comics) and other venues (such as the Internet). But whatever parody is, its justification for preference lies in its role as comic criticism or comment. And it is reasonable that protectable parody should be limited to appearance in media accustomed to the communication of ideas. These would include books, magazines, newspapers, comics, plays, certain websites, motion pictures, television programs, songs and perhaps other music, posters, T-shirts, and, at the fringe, perhaps, trading cards.

It is not wrong to employ or sell parody as parody; but it becomes far less justifiable when actual products and brands of

184. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260-61 (4th Cir. 2007).

185. *Id.* at 261.

actual products purport to take parodic form. The creator of CHEWY VUITON plush dog toys was not peddling parody or espousing any recognizable comment or criticism of Vuitton; he was peddling dog chew toys, and, to all appearances, using the VUITTON reference to attract attention, in much the way the appearance of counterfeit watches is used to make them seem desirable. It is an appropriation of the goodwill and reputation of a more famous, well-received product to promote the sale of an otherwise unknown product by utilizing the famous product's indicia of prestige and acceptability. That is what is wrong with CHEWY VUITON, TIMMY HOLEDIGGER, and LARDASCHE, to take three well-known examples. They are not parodies because they are attached to commercial products to the intrinsic worth of which they contribute nothing.

As products displayed in a parody catalog, perhaps they should be permitted. Even there, the humor remains crude (at best) and the comment on or criticism of the original is all but impossible to discern, but that only makes for poor parody; it does not piggyback on the fame and recognition of another mark to enhance sales of a completely unrelated brand or product (and, not infrequently, tarnish the luster of the original).

When one buys a pack of trading cards, or a magazine or book intended to be humorous, the commercial world is fair game. But when one buys dog toys, jeans, or even animal fragrance, the commercial world should not be fair game for association of the targeted product with a brand or product that ill, or just gratuitously, becomes it.

The harm trademark law seeks to prevent is harm to public reputation as a result of confusion, tarnishment, or blurring of distinctiveness. To the extent this occurs from comment or criticism of the original, the foremost threat often will be a measure of tarnishment. That, or just confusion, will be tolerated, at least to a degree, in the interest of the free flow of ideas. Indeed, the relation may be viewed as symbiotic, with the parodist drawing on the recognition of the original for the enlightenment of the public (and, possibly, even the owner of the original). The doctrine of nominative fair use accommodates much the same balance, as does the very influential case of *Rogers v. Grimaldi*.¹⁸⁶ But to the extent harm to public reputation contributes little or nothing of critical value, the copy becomes a parasite on the original, draining

186. "We believe that in general, the [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression." 875 F.2d 994, 999 (2d Cir. 1989).

reputation from the original to no end other than its own aggrandizement.

In striking a balance, the medium of the purported parodic communication should play a very important role. Movie producer Samuel Goldwyn is supposed to have said: “[p]ictures are for entertainment, messages should be delivered by Western Union.”¹⁸⁷ Nowadays, messages have found more ways of being delivered (including motion pictures), but the field hasn’t yet expanded to brand names for chewable dog toys. One does not go into a pet store (or department, or catalog) expecting comment or criticism; and to see a recognizable LOUIS VUITTON lookalike on a chewable dog toy most likely will not be perceived as any sort of comment or criticism. The original will be recognized, by many, at least. Even if nobody confuses or takes it seriously, the association seems likely, if only subconsciously, to have a degrading effect on the reputation of, or regard for, the original brand in the viewer’s mind and memory. It is difficult to justify the gratuitous infliction of such reputational harm, without some offsetting benefit to society. Here, the benefit is to the thief of the original’s recognition.

B. Copyright Parody

Parodies of copyrighted material appear to be well protected by the fair use doctrine embodied in Section 107 of the Copyright Act.¹⁸⁸

IV. APPENDIX: A PROPOSED STATEMENT OF THE LAW OF TRADEMARK PARODY

1. Parody is a (i) comic imitation of (ii) a known expression, which comic imitation comments on or criticizes the known expression. In considering whether an imitation is parody, two inquiries should be undertaken:

- a. Whether the comic aspect of the imitation can be rationally perceived; and
- b. Whether comment on or criticism of the known expression can be rationally perceived.

187. BrainyQuote, http://www.brainyquote.com/quotes/authors/samuel_goldwyn_3.html (last visited Aug. 31, 2010).

188. 17 U.S.C. §107.

c. As used in this section, “comic imitation” encompasses “literary” works within the meaning of the term as defined in paragraph 3.

2. The rules in this section apply only to parody when the known expression is a trademark or personal name.

3. The rules of this section do not apply to satire or burlesque that does not meet all of the conditions of Rules 1 and 2.

a. “satire” means a literary work holding up human vices or follies to ridicule and scorn, or trenchant wit, irony, or sarcasm used to expose and discredit vice or folly.

b. “Burlesque” means a literary work that seeks to ridicule or mock by means of grotesque exaggeration or comic imitation.

c. As used in this rule, “literary” encompasses dramatic, musical, auditory, written and graphic works and media commonly utilized to convey opinion.

4. Parody that appears in media commonly utilized to convey opinion shall be immune to legal redress if made for political purposes.

5. Parody made for non-political purposes shall be immune to legal redress except when the interest in expressing such parody is outweighed by the risk of:

a. confusion of source, affiliation, approval, or endorsement by the source of the known expression;

b. tarnishment or blurring of the reputation of the known expression or its source; or

c. undermining the police powers of the State.
