

When The Joke Is On A Trademark

Law360, New York (January 09, 2012, 12:28 PM ET) -- Almost anything can be the butt of attempted humor: People, places, things, current events, beliefs and popular culture are high on the list. Not so high, but of considerable concern to their custodians, are trademarks. Without wading through scores of trademark and copyright cases to determine “infringement or parody,” consider the following three somewhat simple, highly subjective, analytical tools to determine if you’ve crossed the line from parody to infringement.

They are not definitive; indeed, precedent usually can be found to support almost any result in these cases, but they are directional, in that if all three favor one result, that result is highly likely to prevail; a two-to-one result should more often than not be predictive.

1) Funny parodies are more likely to survive scrutiny than are those that are just stupid or incoherent.

When trademarks represent truth, loyalty, purity and patriotism, all of which are virtues promoted by Girl Scouts of America, their custodians tend to be sensitive. The custodians of the Girl Scout marks sprang to their defense when the counterculture of the late 1960s created and sold a poster depicting a very pregnant young woman in profile. She was clothed what appears to be the official uniform of the Girl Scouts, and the text of the message is the official motto of the Girl Scouts organization: “Be Prepared.”

The Girl Scouts sued under the law of unfair competition in lower Manhattan, and lost, essentially because the court could not believe that the public would be likely to attribute the poster or its message (whatever that might have been) to the Girl scouts. *Girl Scouts v. Personality Posters*, 304 F. Supp. 1228 (SDNY 1969).

On the other hand, when, three years later, another poster substituted “ocaine” for “ola” in an “Enjoy Coca-Cola” poster, the bottler of America’s favorite liquid indulgence suppressed the poster by finding a few consumers who would testify that they actually believed there was some ratification of the message by the bottler. *Coca-Cola v. Gemini Rising*, 346 F. Supp 1183 (EDNY 1972). That the court enjoining the poster sat in downtown Brooklyn suggests that the famous bridge might span a larger cultural gap than is apparent.

In the decades since, the principal development in the law has been that these cases turn on a balancing of the prevention of misappropriation of another's reputation or expression (trademark or copyright infringement) against the free speech interest in promoting parody.

The U.S. Supreme Court, in a case pitting the copyright owner of the song "Oh, Pretty Woman" against the perpetrators of the purported parody "Pretty Woman," said, in effect, that the justification for appropriating some protected material is to comment on that material or its author, and that any such comment must be new, yet have "some critical bearing on the substance or style of the original." The court takes a dim view, however, of borrowing that "has no critical bearing on the substance or style of the original ... which the alleged infringer merely uses to get attention or to avoid the drudgery of working up something fresh."

In the case at hand, the original, a ballad about a man's romanticized yearning for a particular "lady of the night," is transmogrified into the argot of the street — or, perhaps, gutter — and transposed into a strikingly dissimilar, ugly theme, though the melody and some of the word structure of the original lingers on. The Supreme Court says unequivocally that this bastardization of the sappy original might meet the test. Or maybe not. Having framed the test, the court remanded to lesser minds to apply it. *Campbell v. Acuff-Rose*, 510 U.S. 569 (1994).

A study of both pre- and post-"Pretty Woman" cases suggests that there might be some other factors that get unspoken consideration. When two not-so-svelte New Mexico women decided to make and sell designer jeans in which they could be comfortable, they considered adopting both the Calvin Swine and Vidal Sowsoon brands, but instead opted for the subtlety of Lardashe. Jeans-maker Jordache (pronounced "jord-ash") sued, and lost on appeal, the court of appeals deciding that their intent to parody did not demonstrate intent to confuse. *Jordache Enters. v. Hogg Wylde*, 842 F.2d 1482 (10th Cir. 1987).

On the other hand, when an antinuclear holocaust activist started selling "Mutant of Omaha" paraphernalia, decorated with emaciated Native American heads in feather bonnets, within the immediate vicinity of the Mutual of Omaha insurance company headquarters (its logo was a Native American in a feathered war bonnet), the court enjoined his activity post haste, reasoning that there other adequate means of communication for the activist to express his views. *Mutual of Omaha Ins. v. Novak*, 836 F.2d 397 (8th Cir. 1987).

Subjectively, one way to categorize the above results is that "Be Prepared" and "Lardashe" are clever and funny (authority: audience reaction when the cases are discussed); "Enjoy Cocaine" isn't, and "Mutant of Omaha," even coupled with "nuclear holocaust insurance," which it sometimes was, is unfunny except to the extent it is so stupid (authority: *Id.*). No insurance company is ever likely to abide, much less endorse, nuclear annihilation.

2) Cultural icons are likely to be shielded from criticism or mockery in a manner that strikes a court as obscene or repugnant.

Comic book "parodies" of Disney characters that are rodents, aquatic fowl, mutts and other personified animals into active members of the profane, unkempt, promiscuous, drug-ingesting counterculture of the 1960s and '70s failed to qualify as protected free speech. *Walt Disney Prods. V. The Air Pirates*, 581 F.2d 751 (9th Cir. 1978).

Using a likeness of a Dallas Cowboys Cheerleaders uniform in the climactic scene of “a gross and revolting [hardcore] sex film” also failed to qualify as free speech because there are many ways to comment on sexuality in athletics without infringing trademarks. (The suggestion that one is free to convey an idea but not to express it in an offensive manner seems to be highly questionable.) *Dallas Cowboys Cheerleaders v. Pussycat Cinema* (2d Cir. 1979).

During the heyday of late-night comedian Johnny Carson on TV, “Here’s Johnny” portable toilets (“commodians”) were enjoined. And, when Cabbage Patch dolls were all the rage with young girls, a very rude, crude series of “Garbage Pail Kids” stickers sold like trading cards was prohibited. *Original Appalachian Artworks v. Topps Chewing Gum*, 642 F. Supp. 1031 (N.D. Ga. 1986).

3) In political speech, almost anything goes.

To house athletes for the 1980 Winter Olympic games in Lake Placid, N.Y., an Olympic Village was constructed. Its intended post-Olympic use was as a low-security prison. This outraged the locals so much that they organized a “Stop the Olympic Prison” movement, replete with posters featuring the five-ringed Olympic symbol. The court granted declaratory judgment that the local committee had a First Amendment right to use the Olympic rings. *Stop the Olympic Prison v. U.S. Olympic Committee*, 489 F.Supp. 1112 (SDNY 1980).

When a government-sponsored strategic defense initiative became popularly nicknamed “Star Wars,” the movie producer sought redress. The court held that business torts “do not reach into the realm of public discourse to regulate the use of terms used outside the context of trade.” The plaintiff’s right to control “commercial use” of the phrase was recognized. *Lucasfilm v. High Frontier*, 622 F. Supp. 931 (D.D.C. 1985).

Smokey Bear, the imaginary, but nevertheless federally protected, mascot of the U.S. Forest Service became public property of a sort when an environmental group displeased with the Forest Service’s timbering policies started using depictions of Smokey holding a chain saw behind his back, imploring, “Say it ain’t so, Smokey.” That, the court ruled, was simply free speech. *Lighthawk, the Environmental Air Force v. Robertson*, 812 F.Supp. 1095 (W.D.Wash).

A gubernatorial candidate in Ohio found himself running behind a man named Taft (a revered name in Ohio Republican politics) in a primary to the 2000 election, so he mounted an Internet campaign that began with pictures of Taft giving a speech, then cut to a crudely animated duck that proclaimed: “Taft Quack!” When the insurer and owner of the AFLAC duck sued to enjoin this dilution of its mark, the court held the advertisement was an exercise of free speech. *American Family Life Ins. Co. v. Hagan*, 266 F. Supp 2d 682 (N.D. Ohio 2002).

In the same election primaries, minor party candidate Ralph Nader mounted a close imitation of MasterCard’s then prevalent “priceless” campaign — “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.” MasterCard sued. Its suit was dismissed on summary judgment on pure parody grounds. The court refused to consider a “free speech defense.” *MasterCard Int’l v. Nader 2000 Primary Committee*, 70 USPQ 2d 1046 (SDNY 1004).

Whether use of a clear reference to a valid trademark or copyright is infringement or an exercise of the right of free speech is often a difficult analysis. There is considerable case law, and it isn't very congruent. There are, however, three shortcuts that, if applicable, can be indicative (but not necessarily determinative) of the outcome: (1) the funnier it is, the more likely it is parody; (2) the more offensive it is, the less likely it is to be protected parody; (3) if it is made in a political context, it is almost certain to be free speech, unless it is libel or slander (and untrue).

--By Anthony L. Fletcher, Fish & Richardson PC

Anthony Fletcher is a senior principal in Fish & Richardson's New York office, where he specializes in trademark litigation, counseling and prosecution.

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