TRADEMARK PARODIES: WHEN IS IT OK TO LAUGH?

EMILY ADELMAN

ABSTRACT

In trademark parodies, there is a fine line between what is considered a First Amendment right to freedom of speech and what constitutes an unlawful appropriation, or trademark infringement. Current judicial decisions have been inconsistent across the different jurisdictions, thus making it unclear to parodists as to what may be lawfully appropriated when creating their parodies. This comment proposes that a new balancing test be used that is specific to trademark parodies. This new test will help to create more concrete guidelines that will reduce the amount of subjectivity that is currently used in trademark parody analysis.
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INTRODUCTION

A United States Circuit Court once stated that to deny “parodists the opportunity to poke fun at symbols and names which have become woven into the fabric of our daily life, would constitute a serious curtailment of a protected form of expression.” The United States Constitution gives full protection to people who wish to express their opinions, criticisms, beliefs, or philosophies. However, for people who wish to express themselves by parodying someone else’s trademark, protection is not so easily obtained. The line between a First Amendment right and trademark infringement is unclear in today’s legal system. This comment will analyze current inconsistencies of trademark parody cases and will suggest a more liberal approach in applying the First Amendment.

Part I of this comment will provide a background of trademark parodies. First, it will explain the law of trademark infringement and discuss what constitutes a likelihood of confusion amongst consumers. Second, this section will provide background in the law of trademark dilution and discuss the distinction between the

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2 See U.S. CONST. amend. I (“Congress shall make no law... abridging the freedom of speech ...”).
3 15 U.S.C. § 1127 (2000) (defining trademark as any “word, name, symbol, or device ... (1) used by a person, or (2) which a person has a bona fide intention to use in commerce ... to identify and distinguishes his or her goods, ... from those manufactured or sold by others and to indicate the source of the goods ...”).

Some parodies will constitute an infringement, some will not. But the cry of “parody!” does not magically fend off otherwise legitimate claims of trademark infringement or dilution. There are confusing parodies and non-confusing parodies. All they have in common is an attempt at humor through the use of someone else’s trademark. A non-infringing parody is merely amusing, not

Id.

two possible types of dilution. Finally, this section will discuss the inconsistencies in cases that apply the First Amendment to trademark parody cases.

Part II will analyze current trademark parody law and discuss possibilities for improvement. Additionally, Part II will discuss the problems that arise when a court applies its subjective sense of humor to make a decision. Finally, this section will provide an analysis of cases where greater deference to the First Amendment would have avoided the current problem of inconsistent trademark parody decisions.

Part III will propose a new approach for judges to follow in analyzing trademark parody cases. This comment proposes that judges give more weight to the First Amendment when balancing the interests of the parties in litigation. If this approach is not used, future decisions will seriously dampen the First Amendment right to freedom of expression.

I. BACKGROUND

A. What is a Parody?

Trademarks are often targets for comedic or critical expressions via a parody. Black’s Law Dictionary defines parody as a “transformative use of a well-known work for purposes of satirizing, ridiculing, critiquing, or commenting on the original work, as opposed to merely alluding to the original to draw attention to the later work.” In order to criticize or ridicule an original work, the parodist must copy a large number of characteristics from the original work. The U.S. Court of Appeals for the Second Circuit found that an effective 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.”

6 15 U.S.C. § 1127 (defining dilution as “the lessening of the capacity of a famous mark to identify and distinguish goods or services ...”).


8 BLACK’S LAW DICTIONARY, 1149 (8th ed. 2004).

9 Shaughnessy, supra note 7, at 1093. In order for a parody to work, it needs to be so similar to the original work that consumers associate the original in their minds. Id. However, there must also be equally obvious dissimilarities between the marks to produce the desired effect. Id. Some courts have used the “conjure up” test, which permits fair use of a mark if the mark takes no more similar characteristics than is necessary to “conjure up” the object of the parody. See Dr. Seuss Enterps., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1400 (9th Cir. 1997); Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub’g Group, Inc., 886 F.2d 490, 495 (2d Cir. 1989); World Wrestling Fedn. Entm’t, Inc. v. Big Dog Holdings, Inc., 280 F. Supp. 2d 413, 429 (W.D. Penn. 2003); Tommy Hilfiger Licensing, Inc. v. Nature Labs, L.L.C., 221 F. Supp. 2d 410, 417 (S.D.N.Y. 2002).

10 Cliffs Notes, 886 F.2d at 494.
Use of a trademark as a parody necessarily brings about a conflict of laws. On
the one hand, parodies are protected under the First Amendment as a freedom of
expression. On the other hand, trademarks are protected under the Lanham Act. As such, cases involving a parody of a trademark are torn between the Lanham Act’s protection of the trademark owner and the First Amendment’s protection of the parodist.

B. Current Trademark Law

Trademark owners can sue other people who use their trademark based on two
theories: trademark infringement and trademark dilution. Trademark infringement occurs when there is a likelihood of consumer confusion as to a product’s origin or affiliation. Trademark dilution, on the other hand, concerns the blurring or tarnishing of the original trademark. Dilution occurs when the defendant’s mark makes the trademark owner’s mark less distinctive or associated with a lower quality.

1. Trademark Infringement

The Lanham Act protects a trademark owner from using a mark by another in a
way that would lead to confusion amongst consumers. To prove trademark infringement, the trademark owner must prove there is a likelihood of confusion as to the source of the goods or services. In parody cases, courts weigh the public’s interest in protecting speech against the public’s interest in avoiding consumer confusion.

In order to show a likelihood of confusion between the two marks, the Second Circuit, for example, uses the “Polaroid factor” test. The test balances eight factors: (1) strength of the plaintiff’s mark, (2) degree of similarity between the two marks, (3) similarity of the defendant’s mark to the plaintiff’s mark, (4) marketer’s good reputation, (5) likelihood of consumer confusion, (6) marketing channels, (7) use of identical marks on different products, and (8) likelihood of buyer convenience.

7. 17 Id. at 441, 442.
9. 15 Id. at 441, 442.
10. “Likelihood of confusion” is the basic test of both common law trademark infringement and federal statutory trademark infringement. Id.
11. See Anheuser-Busch, Inc. v. Balducci Pubns, 28 F.3d 769, 773 (8th Cir. 1994).
13. Id. Under the Lanham Act, stronger marks will usually receive greater protection. Versa Prods. Co. v. Bifold Co., 50 F.3d 189, 293 (3d Cir. 1995). This happens because strong marks carry greater recognition, so a similar mark is more apt to cause confusion amongst consumers. Id.
14. Polaroid, 287 F.2d at 495. The more similar the two marks are, the more likely there will be confusion as to the source or affiliation. World Wrestling Fed’n, Entm’t, Inc. v. Big Dog Holdings, Inc., 280 F. Supp. 2d 413, 422 (W.D. Penn. 2003). In an obvious parody, however, there are significant differences that give the parody its satiric effect. Id.
(3) proximity of the products or services,

(4) likelihood that the prior owner will expand its work into the newcomer's product or service line,

(5) evidence of actual confusion between the marks,

(6) whether the defendant adopted the mark in good faith,

(7) quality of defendant's products or services, and

(8) sophistication of the consumers. However, courts are not limited to the above factors, and no one factor is dispositive.

A similar test was used in Anheuser-Busch, Inc. v. Balducci Publications. In that case, the defendant made a parody of the plaintiff's registered design trademark, MICHELOB, in the form of an advertisement on the back cover of their magazine. The advertisement depicted a Michelob Dry beer can under the headline MICHELOB OILY with the phrase ONE TASTE AND YOU'LL DRINK IT OILY. The plaintiff contended that the advertisement infringed its trademark and the trademarked phrase ONE TASTE AND YOU'LL DRINK IT DRY. The defendant argued that it used the plaintiff's trademarks to comment on pollution; specifically an oil spill that had recently occurred in a river. This river was one of the plaintiff's sources of water. The court determined that there was a likelihood of confusion because, according to survey evidence, a majority of those asked thought the defendant needed the plaintiff's permission to use the mark or that plaintiff's company was affiliated with the advertisement. The court decided that the evidence of actual confusion, factor...
five of the Polaroid test, was sufficient to prove a likelihood of confusion. The court then weighed the likelihood of confusion against the defendant’s First Amendment rights and found for the plaintiff.

In trademark infringement cases, the factor of good faith, factor six of the Polaroid test, is analyzed by looking at the intent of the defendant in specifically choosing the plaintiff’s trademark. Courts focus on whether the defendant intended to derive a benefit from the reputation or goodwill of the plaintiff. However, when the defendant chooses to parody the plaintiff’s mark, the intent is not usually to confuse the public, but rather to amuse the public. The benefit to a parodist in using another’s trademark is the humorous association that arises from the parody, not consumer confusion.

If a parody is obvious, an in-depth likelihood of confusion analysis is unnecessary because consumers realize that the parody is not affiliated or endorsed by the trademark owner. In these circumstances, the court can proceed to the next portion of the analysis: to determine if the parody dilutes the original trademark.

2. Trademark Dilution

Another cause of action for trademark owners is dilution. Dilution occurs when the defendant’s use of its mark diminishes the strong identification associated with the plaintiff’s trademark. A trademark owner can claim damages under the Federal Trademark Dilution Act of 1995 as well as state enacted anti-dilution laws. The U.S. Court of Appeals for the First Circuit stated, “Anti-dilution statutes have developed to fill a void left by the failure of trademark infringement law to curb the unauthorized use of marks where there is no likelihood of confusion between the original use and the infringing use.”
In a dilution analysis, the plaintiff must prove: (1) it is the owner of a famous mark,\(^5\) (2) the defendant is making commercial use in interstate commerce of the mark,\(^5\) (3) the defendant's use began after the plaintiff's mark became famous,\(^5\) and (4) the defendant's use causes dilution by lessening the capacity of the plaintiff's mark to identify and distinguish the goods or services.\(^5\) However, the analysis of these factors may differ depending on the type of dilution alleged.

\(\text{a. Dilution by Blurring}\)

Dilution by blurring occurs when the defendant's copying of the plaintiff's mark makes the mark lose some of its uniqueness, thus causing consumers to no longer associate the mark with the plaintiff's goods or services.\(^5\) This is rarely an issue for parodies because parodies tend to increase public identification of the plaintiff's mark with the plaintiff's goods or services.\(^5\) For the public to understand a parody, they must first identify it with a famous mark and then associate the famous mark with its use on dissimilar products.\(^5\)

\(^{50}\) Times Mirror Mags. v. Las Vegas Sports News, 212 F.3d 157, 163 (3d Cir. 2000). Before the Federal Dilution Act was enacted, about half of the states did not have anti-dilution statutes. Skoch, supra note 7, at 358.

\(^{51}\) Times Mirror Mags., 212 F.3d at 163. The Lanham Act defines use in commerce as:

[U]se of a mark in the ordinary course of trade . . . [f]or purposes of this act, a mark shall be deemed to be in use in commerce — (1) on goods when — (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce, and (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

\(^{52}\) "Times Mirror Mags., 212 F.3d at 163.

\(^{53}\) Id.


\(^{55}\) Jordache Enters. v. Hogg Wyld, Ltd., 828 F.2d 1482, 1490 (10th Cir. 1987).
its owner's goods or services. For example, to understand a parody of Nike's swoosh trademark, the audience must not only recognize the swoosh symbol, but also associate the symbol with Nike and the Nike line of goods. Once this association is established, the audience can understand the humor or criticism that the parody expresses. By calling attention to the original trademark and its owner's goods or services, the parody does not dilute the trademark, but instead makes it more identifiable.

b. Dilution by Tarnishment

Dilution by tarnishment occurs when the defendant's use of the trademark degrades the positive associations of the mark. In one tarnishment case, the defendant sold trading cards with pictures of the plaintiff's trademarked dolls, CABBAGE PATCH KIDS, looking grotesque or doing grotesque things (see figures 1 and 2 in Appendix). The court found for the plaintiff because the defendant's unwholesome portrayal tarnished the plaintiff's trademarked dolls.

In another tarnishment case, the defendant used a Dallas Cowboys Cheerleader's uniform as a costume for the leading role in a pornographic film (see figures 3 and 4 in Appendix). The court determined that consumers would associate the Dallas Cowboys Cheerleaders with the pornography industry, thus tarnishing one of the Dallas Cowboys Cheerleaders' trademarks. However, the subjectivity in deciding whether a trademark is tarnished, has led to inconsistencies among court decisions.

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57 See Jordache, 828 F.2d at 1490.


60 Id. at 1040. A trademark, used in a certain context, which does not necessarily create an unwholesome association in the mind of the consumer, may still tarnish the plaintiff's high quality image. Jordache, 828 F.2d at 1490.


62 Id. at 205. In Jordache, the defendants manufactured and produced jeans for larger women called “Lardashe” which parodied Jordache, a company that manufactured high quality jeans. Jordache, 828 F.2d at 1483. The court held that the defendant's name for their product did not cause consumer confusion and did not tarnish plaintiff's mark. Id. The district court stated, “while ‘Lardashe’ might be considered to be in poor taste by some consumers . . . it is not likely to create in the mind of consumers a particularly unwholesome, unsavory, or degrading association with plaintiff's name and marks.” Jordache, 625 F. Supp. at 57.
C. Inconsistency of Trademark Parody Decisions

1. Non-Commercial Parodies

One of the purposes of enacting the Lanham Act was to prevent people from profiting off of others’ good will or reputation. Accordingly, courts generally reject dilution claims in parody cases where the defendant’s parody is not primarily commercial. In Mastercard International, Inc. v. Nader 2000 Primary Committee, Inc., Ralph Nader used the MASTERCARD trademark in an advertisement during his campaign for presidency (see figures 5 and 6 in Appendix). Mastercard sued, claiming trademark infringement and dilution. The court decided that there was no likelihood of confusion and, because the advertisement was not aimed to sell goods or services, the court allowed Nader’s use of the trademark.

The Nader holding contradicts the Anheiser-Busch decision. The advertisement in Anheiser-Busch was not designed to sell goods or services; its sole purpose was to express opinions about pollution and oil spills. Even though the defendant argued that the parody was non-commercial, the court held that the parody infringed and diluted the plaintiff’s trademark. Conversely, many cases involving commercial parodies have found the defendant’s mark not to infringe or dilute the plaintiff’s trademark.

2. Vulgar and Offensive Parodies

Further inconsistencies arise from differences in judges’ sense of humor or sensitivity to certain topics. In L.L. Bean, Inc. v. Drake Publishers, Inc., the Court of Appeals for the First Circuit found for the defendant even though his parody used...
the plaintiff’s trademarks in a non-commercial advertisement with nude models in sexually explicit positions. The court stated, “[w]hile [defendant’s] article is coarse and vulgar, ‘sexually explicit but non-obscene materials, however distasteful, are entitled to no less protection than other forms of expression.’”

In contrast, however, a district court found for the plaintiff where the defendant’s commercial poster mocked the plaintiff’s trademark with an explicit drug reference. Perhaps the differences in outcomes are due solely to the distinction between commercial and non-commercial activity. It seems that there are few objective guidelines the courts follow when analyzing a trademark parody case. This often results in judges using their subjective view of the parody. This subjective view includes factors such as the judge’s sense of humor and his sensitivity to offensiveness or vulgarity. The analysis below demonstrates how these factors play into trademark parody decisions.

II. ANALYSIS

The Supreme Court once stated, “it would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [a work], outside of the narrowest and most obvious limits.” With this in mind, it is difficult for judges to make any kind of objective ruling on trademark parodies. It is inevitable that a judge’s decision whether to allow a trademark parody will be influenced by his personal opinions on the matter. This section will explain how this phenomenon has occurred in past trademark parody cases. Section A will discuss how a likelihood of confusion should not be found in obvious parodies. Then, section B will analyze the subjectivity and judges’ senses of humor in tarnishment cases. Section B will also provide a case-by-case comparison and analysis of inconsistent decisions regarding tarnishment.

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73 Id. (quoting Fantasy Book Shop, Inc. v. City of Boston, 652 F.2d 1115, 1126 (1st Cir. 1981)).
74 Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183, 1193 (E.D.N.Y. 1972). The plaintiff contended that “[t]o associate such a noxious substance as cocaine with plaintiff's wholesome beverage as symbolized by its 'Coca-Cola' trademark and format would clearly have a tendency to impugn that product and injure plaintiff's business reputation.” Id. at 1189.
76 David Pannick, When is a Joke a Constitutional Issue? When it's a Brand of Parody, TIMES (London), Oct. 11, 2005, at 4. Justice Albie Sachs was the keynote speaker at the Constitutional Court of South Africa. Id. He asked if the law has a sense of humor, and concluded that it does. Id. This justice decided for the defendant in a case where the defendant sold T-shirts that parodied the Carling Black Label Beer trademark. Id. Justice Sachs stated that a joke can have a constitutional value whether or not it pleases the court. Id. “It is . . . a difficult feat of advocacy to explain and defend a joke that is being subjected to rigorous analysis in court before a judge with no sense of humor.” Id.
A. Little Likelihood of Confusion in Obvious Parodies

If an artist has made a successful satiric effect in a trademark parody, it will be clear that the original trademark owner had no affiliation in the creation of the parody.\(^7\) Most people would recognize that it is a parody because there are such obvious or substantial differences between parodies and the original trademarks.\(^7\) With so many differences, there is little likelihood of confusion.

One of these differences is when a parody’s message is so different from, or even opposed to, the message given in the original trademark.\(^7\) For example, in Anheuser-Busch, Inc. v. L & L Wings, Inc., the defendant made and sold T-shirts with the BUDWEISER trademark on it with the writing, “Myrtle Beach” instead of “Budweiser.”\(^8\) The message of the parody was that Myrtle Beach is a nice place to go vacationing.\(^8\) This is very different from the message of Anheuser-Busch, which might be that Budweiser is a superior beer and that people should buy it.\(^8\) For this reason, the court found that no likelihood of confusion existed.\(^8\) Even if a parody is found obvious, it will still need to be found non-tarnishing for the court to find in the parody owner’s favor.

B. Tarnishment Analysis Very Subjective in Parody Cases

1. “Enjoy Cocaine” Poster Infringes Coca-Cola

In Coca-Cola Co. v. Gemini Rising, Inc., the defendant sold posters that had “Enjoy Cocaine” written on it and appeared similar to the Coca-Cola Company’s trademark, ENJOY COCA-COLA.\(^8\) The court held that there was a likelihood of confusion because the court believed that consumers were likely to assume that the Coca-Cola Company endorsed the poster and/or cocaine.\(^8\) It is hard to be sure what

\(^7\) Jordache Enters. v. Hogg Wyld, Ltd., 828 F.2d 1482, 1486 (10th Cir. 1987). Obvious differences between the defendant’s mark and the original trademark do not necessarily mean that the defendant has created a successful parody. Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394 (9th Cir. 1997). Judges need to assess what is being mocked and what kind of comment is being made. Id. There are no rules or guidelines to help judges decide what a parody is as opposed to a meaningless trademark imitation. Campbell, 510 U.S. at 581. In a copyright parody case, Justice Kennedy stated that a “parody must target the original, and not just its general style, the genre of art to which it belongs, or society as a whole (although if it targets the original, it may target those features as well).” Id. at 597.


\(^1\) See, e.g., id.

\(^2\) Id. at 318.

\(^3\) Id. at 319.

\(^4\) Id. The Budweiser trademark and logos express the message that Budweiser’s “aging [process] produces a taste, a smoothness, and a drinkability [not found in any] other beer at any price.” Id.

\(^5\) Id. at 321.


\(^7\) Id. at 1190. The plaintiff was able to show that some members of the public of average intelligence attributed the poster as affiliated with plaintiff and that they stopped buying the soft drink out of resentment. Id.
exact message the artist was trying to convey, but there are many possibilities.\footnote{For example, a “message . . . may be a simple form of entertainment 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.” L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 34 (1st Cir. 1987).} One may simply have been to make fun of the popularity of the Coca-Cola beverage and that so many people drink it as part of their daily routine. Because so many people rely on caffeine in their diets, the artist’s parody might be that Coca-Cola is addictive and the need for it is similar to a cocaine addict’s need for cocaine.

Regardless of the message that the artist was trying to convey, the court could have used a different approach in analyzing whether there was a likelihood of confusion and tarnishment. The court only used one of the Polaroid factors in assessing whether there was a likelihood of confusion.\footnote{Coca-Cola, 346 F. Supp. at 1190. The court only relied on the plaintiff’s evidence that an un-quantifiable amount of people were confused and stopped buying the beverage because of the confusion. \textit{Id.}} The court concluded that a likelihood of confusion existed based solely on little evidence of actual confusion, which is only one factor from the Polaroid test.\footnote{\textit{Id.} at 1193. The court decided that the defendant would suffer lesser hardship than the plaintiff because they would have to stop selling only one of their many posters. \textit{Id.} It was determined that this would hardly put the defendants out of business where, on the other hand, the plaintiff’s name is at stake and continued injury to its reputation would be far more serious than the decrease in defendant’s profits from their “Enjoy Cocaine” poster sales. \textit{Id.} The court made this decision in spite of an affidavit submitted by the defendants showing that Coca-Cola sales had increased since the sale of the posters. \textit{Id.} at 1190.} The court found for the plaintiff because there was evidence of actual confusion and because they believed that the plaintiff would suffer more of a hardship than the defendant if the injunction were not granted.\footnote{\textit{Id.} at 1193.} The court decided that a likelihood of confusion existed based solely on evidence of actual confusion, which is only one factor from the Polaroid test.\footnote{Ann Bartow, Likelihood of Confusion, 41 SAN DIEGO L. REV. 721, 802 (2004).} One law review article stated, “some consumer confusion is inevitable when a few people fail to realize that one product is parodying another. This fact should not be used to censor criticism of or social comments on icons in our popular culture.”\footnote{Girl Scouts of the U.S. v. Personality Posters Mfg. Co., 304 F. Supp. 1228, 1231, 1233–34 (S.D.N.Y. 1969).}

The court did not go into a tarnishment analysis at all. It seems that the judge decided which side should prevail morally, and then tried to find a legal basis to back it up. The Coca-Cola analysis and decision directly contradict the following case involving another “offensive” parody displayed on a poster.

2. “Be Prepared” Poster Tarnishes the Girl Scouts

In Girl Scouts of the United States of America v. Personality Posters Manufacturing Co., Inc., the plaintiff claimed that the defendant’s poster caused confusion as to its source and tarnished the GIRL SCOUTS trademark.\footnote{\textit{Id.} at 1230.} The poster showed a pregnant girl in a girl scout’s uniform with the words “Be Prepared” written at the bottom of the poster.\footnote{\textit{Id.} at 1230.} The plaintiff contended that the defendant’s poster intended to “impute unchastity and moral turpitude to members of plaintiff, to
hold plaintiff up to ridicule and contempt, and to suggest that plaintiff's motto ‘Be Prepared’ encourages the practice of contraception.’ The plaintiff believed that this message would stop members from joining its organization and would create a negative association with it. Similarly, the plaintiff in Coca-Cola believed that a negative association would prevent people from buying its products. The Coca-Cola plaintiff thought that the association of its wholesome beverage with an illegal substance would “have a tendency to impugn that product and injure plaintiff's business reputation.”

It seems that the messages from the defendants' posters in both of these cases had negative images from what the plaintiffs' companies tried to portray. However, in Girl Scouts, the court found there was neither a likelihood of confusion, nor tarnishment because the plaintiff failed to provide concrete evidence that the plaintiff's organization was harmed. On the other hand, in Coca-Cola, the court found a likelihood of confusion existed because a few angry consumers called in and complained about the poster. Consumers calling in to complain do not necessarily indicate that they think Coca-Cola is endorsing cocaine use or that the company was harmed. In fact, it is difficult to believe that Coca-Cola, a family beverage, would sell paraphernalia endorsing an illegal drug. The court relied on a few consumer phone calls to the plaintiff's company to determine a likelihood of confusion, instead of relying on more concrete evidence of harm.

The court in Girl Scouts found that the reputation of the plaintiff was so “secure against the wry assault of the defendant that no such damage had been demonstrated.” It is difficult to imagine that the Girl Scouts have such a strong, wholesome reputation that cannot be tainted, but that Coca-Cola does not. Many people would probably say that Coca-Cola has one of the most recognizable and

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93 Id. at 1234.
94 Id. at 1231. The plaintiff showed an affidavit that stated that the plaintiff had received phone calls from the public expressing their concern and indignation for the defendant's posters. Id.
96 Id. at 1189.
97 Id.; Girl Scouts, 304 F. Supp. at 1231.
98 Girl Scouts, 304 F. Supp. at 1235. No facts were presented to show that contributions to the Girl Scouts organization had decreased, that any members had dropped out of the organization, or that members had failed to join due to defendant's posters. Id.
99 Coca-Cola, 346 F. Supp. at 1190.
100 The name Coca-Cola is derived from the Andean coca leaf plant and the African cola nut. Id. at 1189. Extracts of these plants give the beverage its flavor. Id. The coca leaf is also the source of cocaine. Id. Although Coca-Cola was originally an elixir of cocaine and caffeine in 1886, cocaine became illegal in 1914. Cocaine Abuse, eMedicineHealth, Sept. 21, 2006, http://emedicinehealth.com/cocaine_abuse/article_em.html. It has since become a serious offense to possess, use, or sell the drug. However, as the Supreme Court noted in 1920, there is no longer cocaine in Coca-Cola. Coca-Cola Co. v. Koke Co., 254 U.S. 143, 145-46 (1920).
101 Girl Scouts, 304 F. Supp. at 1235-36. The court found that although there were telephone calls from indignant people, they would continue to respect the reputation of the Girl Scouts of America. Id.
102 Plaintiff spends large sums of money on advertising to induce people to buy Coca-Cola products. Coca-Cola, 346 F. Supp. at 1187. The court reasoned that plaintiff's business depends upon millions of purchase decisions made daily and that the soft drink industry is highly competitive. Id. at 1190. The court determined that because there are substitutes available, “even the slightest negative connotation concerning a particular beverage may well affect a consumer's decision.” Id.
secure images in the world. These cases are so similar from a tarnishment perspective that the Coca-Cola court could have analyzed the facts with more leniency as the Girl Scouts court did for more consistency. For example, the Coca-Cola court could have proved tarnishment by requiring a clear showing that Coca-Cola product sales had decreased in profits because of the poster. Even though these cases were in different jurisdictions, the Coca-Cola court could have followed an analysis similar to that relied on by the court in Girl Scouts.

3. Song Insulting Barbie Found Not Tarnishing

In Mattel, Inc. v. MCA Records, Inc., the defendants wrote and marketed a song about Mattel’s Barbie doll entitled “Barbie Girl” (see figures 7 and 8 in Appendix). The defendant’s song referred to Barbie as a “blond bimbo girl” who loves to party and whose life is plastic (see figure 9 in Appendix). The plaintiff claimed that the song’s message would negatively affect its doll sales. Mattel claimed that the unauthorized use of its mark would lead to confusion among consumers and harm to the Barbie product because the defendant’s song associated its doll with anti-social themes such as “promiscuity, lewdness, and the stereotyping and denigration of young women.” Although there was evidence of actual confusion, the defendant successfully argued that the BARBIE trademark is a powerful one and that their unauthorized use of it was protected by First Amendment rights.

Mattel is similar to Girl Scouts in that the courts found that the First Amendment allowed the defendants to poke fun at the wholesome image of the plaintiff. In contrast, the Coca-Cola court found that the First Amendment does not allow the defendant to make fun of Coca-Cola. The COCA-COLA trademark is as strong a trademark as, if not stronger than, BARBIE and the GIRL SCOUTS. Why did the court find that COCA-COLA should receive more protection than BARBIE when there was actual evidence of confusion in both cases and no evidence of commercial loss in either case? Had the court in Coca-Cola been less conservative and more open about the parody, the outcome may have been much more consistent with the outcome in Mattel and Girl Scouts. Furthermore, future courts would have had clearer guidelines to follow in evaluating similar cases.

103 Id. at 1187. COCA-COLA has been described as “one of the three most recognizable trademarks in the world.” Id. (citing THE BUSINESS LAWYER, Nov. 1971, at 309).
105 Id.
106 Id. at 1136. Although the plaintiff showed that there was a likelihood of confusion through survey analysis, the judge determined that “[t]he fact that a plaintiff can point to some evidence of confusion in the abstract does not automatically mean that such confusion affects actual purchasing decisions.” Id. at 1148.
107 Id. at 1155.
108 Id. at 1156. The court concluded that the defendant’s song was not meant to capitalize on Mattel’s good will and reputation, but instead to make a social commentary about the negative body and lifestyle images that the doll sends to children. Id.
4. Garbage Pail Kids Tarnishes Dolls

In Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc., the defendant produced and sold trading cards under the name “Garbage Pail Kids.”\textsuperscript{111} The cards illustrated images of cartoon characters, similar to the Cabbage Patch Kids dolls, in unflattering but not explicit situations.\textsuperscript{112} For example, one card had the name “Graffiti Petey” written on it and had a drawing of a doll spray painting graffiti on a wall (see figure 2 in Appendix).\textsuperscript{113} The court found that these cards were likely to tarnish the CABBAGE PATCH KIDS trademark and noted that the cards negatively altered the trademark’s wholesome image.\textsuperscript{114} The court went through no further dilution analysis.\textsuperscript{115}

In Mattel, the defendant’s song disparaged the plaintiff’s wholesome trademark image.\textsuperscript{116} However, the court analyzed the case more thoroughly, declining to jump to the conclusion that the trademark had been tarnished.\textsuperscript{117} Unfortunately, the Cabbage Patch court did not follow this approach. In both cases, the products were children’s dolls and, in both cases, the respective defendants portrayed the particular doll in a poor light.\textsuperscript{118} And yet, somehow, the courts implied that the First Amendment included the right to bash Barbie, but Cabbage Patch Kids dolls deserved much more public respect.

5. The Spa’am Muppet Does Not Tarnish Spam

Another case that reinforces the decision in Mattel is Hormel Foods Corp. v. Henson Productions, Inc.\textsuperscript{119} In Hormel, Jim Henson created a movie titled “Muppet Treasure Island” and named one of the characters Spa’am.\textsuperscript{120} This character was intended to parody Hormel’s canned luncheon meat, Spam.\textsuperscript{121} Hormel claimed that Henson’s character tarnished the meat product because Spa’am was portrayed as a

\textsuperscript{112} Original Appalachian Artworks, Inc. v. S. Diamond Assocs., Inc., 911 F.2d 1548, 1549 (11th Cir. 1990) (deciding whether S. Diamond Associates, which owned an exclusive license of the Cabbage Patch Kids trademark and copyright, should receive settlement proceeds that arose out of the Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc. litigation).
\textsuperscript{113} Id.
\textsuperscript{114} Id. at 1040.
\textsuperscript{115} Id. The court granted a preliminary injunction to the plaintiff based on this short analysis of dilution. Id. The parties settled out of court in which the defendants agreed to pay the plaintiffs seven million dollars in exchange for the plaintiff’s agreement not to sue them. S. Diamond Assocs., 911 F.2d at 1549.
\textsuperscript{116} Id. at 1154–56.
\textsuperscript{117} Id. at 1155; Original Appalachian Artworks, 642 F. Supp. at 1032.
\textsuperscript{118} See Hormel Foods Corp. v. Henson Prods., Inc., 73 F.3d 497, 508 (2d Cir. 1996).
\textsuperscript{119} Id. at 500–01.
\textsuperscript{120} Id. at 501. Jim Henson poked fun at Hormel’s lunch meat by associating its “processed, gelatinous block with a humorous wild beast.” Id. The court had a good sense of humor about the parody, noting that Hormel was the least amused. Id.
big, hairy, unattractive, monstrous boar. Hormel claimed that the unattractive portrayal of this character would tarnish Spam, thereby affecting its sales.

Much like the Mattel court, the Hormel court had a sense of humor about the parody. The court even noted, “[i]n view of the more or less humorous takeoffs such as these, one might think Hormel would welcome the association with a genuine source of pork.” As one court stated, “imitation may be the highest form of flattery.”

The courts in Mattel, Hormel, and Girl Scouts had a stronger sense of humor about trademark parody than did the Coca-Cola and Cabbage Patch courts. Trademark owners do have the right to protect their trademarks, but this right does not include the right to be taken seriously. If courts fail to follow these more lenient decisions, encroachment of First Amendment rights is inevitable.

III. PROPOSAL

This section proposes that courts take a new approach when analyzing trademark parody cases. As the previous section discussed, the current balancing approach that courts use is too vague and results in inconsistencies. Section A will discuss how the likelihood of confusion test should be more specific to parodies and how the Lanham Act should include a parody defense. Section B will discuss how stricter guidelines for a dilution analysis will decrease subjectivity and increase consistency.

A. More Specific Infringement Guidelines for Trademark Parodies

Currently, parody is not listed as one of the defenses to trademark infringement in the Lanham Act. Parody should be listed as one of the defenses in the Act, where an obvious parody will give the parody owner immunity from legal

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122 Id. The character actually turned out to be a heroic character and helped the Muppets from escaping the film’s villain, Long John Silver. Id. The court found this information important because Sp'am turned out to be a likeable character, such that Henson put the character on cereal boxes. Id. If this character were so hideous, children would have been turned off from eating out of a box that had the character on the cover. Id. But see Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc., 642 F. Supp. 1031, 1040 (N.D. Ga. 1986) (finding tarnishment in part because, regardless of the humorous effect of the defendant’s trading cards, the offensiveness of them would make children not want to buy the plaintiff’s dolls).

123 Hormel, 73 F.3d at 501.

124 Id. One criticism about Spam is that “[i]n one can, Spam contains the five major food groups: Snouts. Ears. Feet. Tails. Brains.” Id. (quoting Mike Thomas, Ready? Set? No!, ORLANDO SENTINEL, June 25, 1995).

125 Id.


127 MCCARTHY, supra note 4, at § 31:155 (“No one likes to be the butt of a joke, not even a trademark. But the requirement of trademark law is that a likely confusion of source, sponsorship, or affiliation must be proven, which is not the same thing as a ‘right’ not to be made fun of.”).

128 See supra Part II.

punishment. After parody is claimed as a defense, the burden of proof should lie with the plaintiff to show that the parody is not obvious and is likely to cause consumer confusion.

To help assess what is an obvious parody, the courts should change the likelihood of confusion test in order specifically to address trademark parodies. The test should change because some of the current factors have little or no meaning when applied to parodies. Applying a modified factor test specific to parodies will help to determine whether the parody is obvious. The next part of this section will discuss which Polaroid factors should be removed which should be kept, and which factors, specific to parody cases, should be added.

1. Factors Removed

Courts should not look into the sophistication of consumers. Too often, judges decide that consumers lack enough sophistication to know what they are buying when purchasing things like T-shirts and posters. If this were true, confusion would be found in most cases. Courts should also not look at the similarities between the parody and the trademark, but should look at the differences. A parody must take a substantial amount of characteristics of the trademark in order to convey the parody. Therefore, the differences will show whether the parody is obvious or will cause confusion. The strength of the plaintiff's mark should not be analyzed, because more often than not, the trademark is famous, otherwise, the parody is not effective. The defendant's intent should not be analyzed because a parodist always intends to imitate the trademark, and intends to make an expression, not to profit off of the trademark owner's goodwill. The quality of the products should be analyzed, but only in a tarnishment analysis because the quality of a good that contains a parody has little to do with whether the parody is obvious.

2. Factors Kept

Courts should still consider evidence of actual confusion, but only if it is concrete evidence. Some surveys are flawed because they do not represent a true market

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130 Anheuser-Busch, Inc. v. L & L Wings, Inc., 962 F.2d 316, 322 (4th Cir. 1992) (“The purpose of the Lanham Act is to eliminate consumer confusion, not to banish all attempts at poking fun or eliciting amusement.”).

131 Courts assume that the cheaper a product is, the less sophisticated the consumer will be. World Wrestling Fed'n Entm't, Inc. v. Big Dog Holdings, Inc., 280 F. Supp. 2d 413, 436 (W.D. Pa. 2003). This is because consumers will spend less time shopping for a cheaper item. Id. Less time spent shopping means less time for the consumer to look at the product and its labeling. See Id.

132 Bartow, supra note 90, at 816-17 (“Protecting consumers’ is even less supportable a justification for broadly enforceable trademark rights when consumers are incorrectly and illegitimately assumed to be idiots.”). It is inevitable that some consumers will fail to realize that the defendant’s work is in fact a parody. Id. at 802. This should not be used to censor social criticism on icons in our popular culture, for example, one as famous as Barbie. Id.
reality. Likewise, courts should continue analyzing the proximity of the products after the parody is established as commercial or not.

3. Factors Added

The factors that should be added to the Polaroid test should include: (1) the amount and extent of differences between the trademark and its parody, (2) whether there is a conspicuous disclaimer on the parody saying that it is a parody or that it is not affiliated with the owner of the trademark, and (3) the proximity between the message expressed and the nature of the trademark. These factors, however, should not be inclusive. Some of them have been used by courts to determine whether First Amendment rights should outweigh trademark protection. If the court has determined that most of the factors favor the defendant, then the parody is obvious. In that case, there will be no likelihood of confusion, and the parody should be protected if the court also decides that the parody does not tarnish.

B. Stricter Dilution Guidelines for Trademark Parodies

Since an obvious parody would be able to overcome the likelihood of confusion test according to the previous section (A) above, the parody would only be vulnerable to dilution claims. Parody should be a complete defense to dilution by blurring. As discussed in Part I, an obvious parody must first remind its audience of the original trademark before making its comedic or political expression. If more courts follow this anti-dilution by blurring guideline, then dilution by tarnishment will be the only dilution theory needed to be analyzed.

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133 See, e.g., Jordache Enters. v. Hogg Wyld, Ltd., 828 F.2d 1482, 1488 (10th Cir. 1987). The Jordache court found that plaintiff's side-by-side comparison in their survey was flawed. Id. As a result, little weight was given to this factor. Id.

134 "To eliminate the risk of confusion, a disclaimer will inform the casual reader or consumer that the parody is a creative conception that is not sponsored or authorized by the trademark owner." Keren Levy, Trademark Parody: A Conflict Between Constitutional and Intellectual Property Interests, 69 GEO. L. REV. 425, 450 (2001). Although a disclaimer may not guarantee the parodists' rights, it would certainly help in his argument against infringement. Id.


136 The overall test, including the added factors, should be: (1) the degree and amount of differences between the parody and the trademark, (2) whether there is a conspicuous disclaimer on the parody, (3) the proximity between the parody expression and the nature of the trademark, (4) concrete evidence of actual confusion between the parody and the trademark, and (5) if the parody is considered commercial, the proximity of the goods being sold.

137 The Restatement takes the view that the anti-dilution statute should not be available against unauthorized trademark uses that comment on, criticize, ridicule, parody, or disparage the goods or business of the trademark owner. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25(2) (1995).

138 See supra Part I(B)(2)(a).
Even if a parody is obvious and has defeated the likelihood of confusion test, it may still tarnish the original trademark. As discussed in Part II of this comment, what constitutes tarnishment is subjective, which has resulted in inconsistent court decisions. These inconsistencies allow the public to enjoy some parodies, while being denied others.

The public’s interest in First Amendment protection would be better served if there were stricter guidelines when it comes to deciding tarnishment. A parody should only be found to tarnish if the parody is so offensive and repulsive that the very thought of it makes most consumers not buy the associated product. It is doubtful that Coca-Cola would endorse a poster alluding to illegal drug use. However, to associate a trademark with an illegal drug may be offensive and tarnishing. The Coca-Cola court may have concluded this had they gone through a tarnishment analysis. It is likely that the humor that the Garbage Pail Kids trading cards produced for children would make those children want the Cabbage Patch Kids dolls even more than they did before seeing the card, due to the card’s popularity. A logical conclusion is that the outcomes in cases addressing trademark issues would increase in uniformity across the varying jurisdictions if the tarnishment test were much stricter as to what constitutes tarnishment.

IV. CONCLUSION

The vague guidelines that courts currently use in analyzing trademark parody cases have resulted in contradictory holdings. In trying to balance trademark protection against First Amendment rights, the decisions that judges have made have been based on subjective analyses. The Lanham Act provides protection to trademark owners against another’s use of the same or similar mark, which may cause confusion amongst consumers. However, there is no defense listed for a parody. Thus, courts have to use a likelihood of confusion test in parody cases. Courts should use a modified likelihood of confusion test that applies to specifically trademark parodies. Courts should also use a stricter test to determine what constitutes tarnishment. A stricter test will decrease some subjectivity and increase consistency among courts. These changes will also allow parodists to understand what may lawfully be used when creating a parody.

Parodists should be able to express themselves regardless of whether the parody is funny or unflattering. The First Circuit Court of Appeals put it simply by stating that "[t]rademark parodies, even when offensive, do convey a message. The message may be simply that business and product images need not always be taken too.

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140 See supra Part II.
141 Although the court found that the defendant’s poster tarnished the plaintiff’s image, this finding was based on a likelihood of confusion test. Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183, 1190 (E.D.N.Y. 1972). The two analyses were not separate as they should have been. Id.
142 See supra Part II.
seriously; a trademark parody reminds us that we are free to laugh at the images and associations linked with the mark.”

APPENDIX

Figure 1: Cabbage Patch Doll, trademark owned by Original Appalachian Artworks, Inc. http://www.cabbagepatchkids.com/
Figure 2: Garbage Pail Kids, products owned by Topps Chewing Gum, Inc. 
http://www.garbagepailkidsworld.com/
Figure 3: The Dallas Cowboys Cheerleaders' uniform.  
http://www.dallascowboys.com/cheerleaders/history.cfm
Figure 4: Debbie Does Dallas, a pornographic film produced by Pussycat Cinema.  
http://www.imdb.com/title/tt0077415/
Figure 5: Example Mastercard advertisement.

first base: 58 dollars.
second base: 630 pesos.
third base: 300,000 yen.
home: priceless.
there are some things money can't buy.
for everything else there's Mastercard.
fan of the game, wherever there's a game.

http://www.priceless.com/pricelesstv
Figure 6: Ralph Nader’s Priceless Advertisement that ran during his presidential campaign.

Grilled tenderloin for fundraiser: $1,000 a plate.
Campaign ads filled with half truths: 10 million dollars.
Promises to special interest groups: Over 10 billion dollars.
Finding out the truth: Priceless.
There are some things money can’t buy. Without Ralph Nader in the presidential debates, the truth will come in last. Find out how you can help. Go to voteNader.com.
Vote Ralph Nader for president.

http://www.gwu.edu/~action/ads2/nadead1.html
**Figure 7**: Mattel's trademarked Barbie dolls.

home.hetnet.nl/.../barbie-refresh-500295.jpg
Figure 8: Album cover for "Barbie Girl", sung by the group Aqua.
www.schwimmerlegal.com/images/barbiegiralaqua.jpg
Figure 9: Lyrics to “Barbie Girl.”

Hi Barbie
Hi Ken!
Do you wanna go for a ride?
Sure Ken!
Jump In...

I'm a barbie girl, in the barbie world
Life in plastic, it's fantastic!
You can brush my hair, undress me everywhere
Imagination, life is your creation
Come on Barbie, let's go party!

I'm a barbie girl, in the barbie world
Life in plastic, it's fantastic!
You can brush my hair, undress me everywhere
Imagination, life is your creation

I'm a blond bimbo girl, in the fantasy world
Dress me up, make it tight, I'm your dolly
You're my doll, rock'n'roll, feel the glamour in pink,
Kiss me here, touch me there, hanky panky...
You can touch, you can play, if you say: "I'm always yours"

(uu·oooh·u)

I'm a barbie girl, in the barbie world
Life in plastic, it's fantastic!
You can brush my hair, undress me everywhere
Imagination, life is your creation

Come on Barbie, let's go party!
(Ah·ah·ah·yeah)
Come on Barbie, let's go party!
(uu·oooh·u)
Come on Barbie, let's go party!
(Ah·ah·ah·yeah)
Come on Barbie, let's go party!
(uu·oooh·u)

Make me walk, make me talk, do whatever you please
I can act like a star, I can beg on my knees
Come jump in, bimbo friend, let us do it again,
hit the town, fool around, let's go party
You can touch, you can play, if you say: "I'm always yours"
You can touch, you can play, if you say: "I'm always yours"
Come on Barbie, let's go party!
(Ah·ah·ah·yeah)
Come on Barbie, let's go party!
(uu·oooh·u)
Come on Barbie, let's go party!
(Ah·ah·ah·yeah)
Come on Barbie, let's go party!
(uu·oooh·u)

I'm a barbie girl, in the barbie world
Life in plastic, it's fantastic!
You can brush my hair, undress me everywhere
Imagination, life is your creation

I'm a barbie girl, in the barbie world
Life in plastic, it's fantastic!
You can brush my hair, undress me everywhere
Imagination, life is your creation

Come on Barbie, let's go party!
(Ah·ah·ah·yeah)
Come on Barbie, let's go party!
(uu·oooh·u)
Come on Barbie, let's go party!
(Ah·ah·ah·yeah)
Come on Barbie, let's go party!
(uu·oooh·u)

Oh, I'm having so much fun!
Well Barbie, we're just getting started
Oh, I love you Ken!

http://www.azlyrics.com/lyrics/aqua/barbiegirl.html