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Mark V.B. Partridge

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ARTICLES

TRADEMARK PARODY AND THE FIRST AMENDMENT: HUMOR IN THE EYE OF THE BEHOLDER

MARK V.B. PARTRIDGE*

INTRODUCTION

Trademark parody has become increasingly common in the United States. The use of another's trademark in a humorous or disparaging manner can appear in many forms, from gag products,¹ to slogans and advertising for an unrelated product,² to satiric commentary.³ While "[i]n one sense a parody is an attempt to derive benefit from the reputation of the owner of the mark . . . a parody relies upon a difference from the original mark, presumably a humorous difference, in order to produce its desired effect."⁴ A parody must convey two simultaneous and contradictory

* Mr. Partridge is a partner with the Chicago based law firm, Pattishall, McAuliff, Newbury, Hilliard & Geraldson, and an adjunct professor at The John Marshall Law School. This article is an adaptation of a speech given at the annual International Trademark Association conference held in Orlando, Florida, on May 3, 1995. The author gratefully acknowledges the assistance of Charles R. Wulf in the preparation of this article.

1. *See, e.g.*, *Hard Rock Cafe Licensing Corp. v. Pacific Graphics, Inc.*, 776 F. Supp. 1454, 1462 (W.D. Wash. 1991) (rejecting the defendant's argument that its use of HARD RAIN CAFE on T-shirts was a permissible parody of the Hard Rock Cafe); *Schieffelin & Co. v. Jack Company of Boca, Inc.*, 725 F. Supp. 1314, 1324 (S.D.N.Y. 1989) (rejecting defendant's argument that their product was a harmless parody, noting that the parody was not sufficiently effective to eliminate the likelihood of confusion among the consumers); *Gucci Shops, Inc. v. R.H. Macy & Co.*, 446 F. Supp. 838, 840 (S.D.N.Y. 1977) (enjoining the defendant from marketing diaper bags under the trademark 'Gucchi Goo' because of similarity with the 'Gucci' trademark).

2. *See, e.g.*, *Tin Pan Apple Inc. v. Miller Brewing Co.*, 737 F. Supp. 826, 834 (S.D.N.Y. 1990) (rejecting defendant's parody defense). *Cf. Everyready Battery Co. v. Adolph Coors Co.*, 765 F. Supp. 440, 450 (N.D. Ill. 1991) (denying relief to the plaintiff and noting that it was clear that the parody was not the original trademark).

3. *See, e.g.*, *Anheuser-Busch, Inc. v. Balducci Publications*, 28 F.3d 769, 775 (8th Cir. 1994), *cert. denied*, 115 S. Ct. 903 (1995) (expressing concern that the public may be misled by the parody); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490, 495 (2d Cir. 1989) (holding that the public interest in parody outweighed the risk of confusion between *Spy Notes* and *Cliff Notes*).

4. *Hormel Foods Corp. v. Jim Henson Prod., Inc.*, No. 95 Civ. 5473, 1995 U.S. Dist. LEXIS 13886, at *21 (S.D.N.Y. Sept. 22, 1995), *aff'd*, 73 F.3d 497 (2d Cir.

messages. It must express that it is the original, while at the same time, that it is not the original but instead is a parody.⁵ As one court stated, "[t]o the extent it does only the former [that it is the original] but not the latter [that it is not the original], it is not only a poor parody but also vulnerable under the trademark law."⁶

The First Amendment to the United States Constitution guarantees free speech and artistic expression.⁷ Since parodies involve a form of expression, they are entitled to protection against undue government interference.⁸ Traditionally, the First Amendment interests have been adequately protected by the standard likelihood of confusion analysis. The defendant's First Amendment interests end when the parody creates a likelihood of confusion.⁹ However, more recently there has been a trend to view the First Amendment issue separately, particularly when the parody involves a commentary, as opposed to a mere gag or a play on words. The First Amendment analysis attempts to balance the public interest in free speech, against the public interest in avoiding confusion in the marketplace.¹⁰ This Article will illustrate a framework for the analysis of First Amendment protection in the context of trademark parody.

I. BACKGROUND

Many courts deciding trademark parody cases up until the late 1980s either dismissed the free speech issue or decided the case without reference to the free speech argument. Those courts that rejected the First Amendment argument applied the reason-

1996).

5. *Id.* at *14.

6. *Id.*

7. U.S. CONST. amend. I. "Congress shall make no law . . . abridging the freedom of speech, or of the press. . . ." *Id.*

8. However, some courts have chosen to ignore the first amendment issue altogether when deciding a trademark parody case. *See, e.g., Jordache Enters., v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1490 n.7 (1987) (first amendment issue noted in the footnote but not dealt with in the text).

9. The likelihood of confusion test is found in § 32(1) of the Lanham Act. 15 U.S.C. § 1114(1)(1988).

Any person who shall, without the consent of the registrant-(a) use in commerce any reproduction, counterfeit, copy or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with such is likely to cause confusion, or to cause mistake or to deceive; . . . shall be liable in a civil action by the registrant for the remedies hereinafter provided. . . .

Id.

10. *Hormel Foods Corp. v. Jim Henson Prod., Inc.*, No. 95 Civ. 5473, 1995 U.S. Dist. LEXIS 13886, at *13-14 (S.D.N.Y. Sept. 22, 1995), *aff'd*, 73 F.3d 497 (2d Cir. 1996).

ing handed down by the United States Supreme Court in *Lloyd's Corp. v. Tanner*.¹¹ One such case was *Dallas Cowboys Cheerleaders v. Pussycat Cinema*.¹² In *Dallas Cowboys*, the Second Circuit addressed the question of whether the defendant filmmaker's use of the plaintiff's trademark was protected under the First Amendment.¹³ After finding that the defendant's film, which depicted women wearing uniforms similar to the plaintiff's, created a "likelihood of confusion,"¹⁴ the court rejected the defendant's First Amendment defense.¹⁵ In making this determination, the court reasoned that simply because "defendant's movie may convey a barely discernible message does not entitle them to appropriate plaintiff's trademark in the process of conveying that message, and as such it need not 'yield to the exercise of First Amendment rights under circumstances where adequate alternatives of communication exists."¹⁶ As a result, the Second Circuit Court of Appeals ruled that the district court did not encroach upon the defendant's First Amendment rights when it granted the plaintiff's preliminary injunction.¹⁷

Another case that had a similar result is *Mutual Of Omaha Insurance v. Novak*.¹⁸ The *Mutual Of Omaha* case involved a t-shirt that said "Mutant of Omaha," with an emaciated Indian Head on the t-shirt.¹⁹ The defendant claimed he was selling the

11. 407 U.S. 551 (1972). One commentator has argued that *Tanner* should not have been controlling in trademark parody cases because it involved a different form of property, namely real estate. Arlen V. Langvardt, *Protected marks and Protected Speech: The First Amendment Boundaries in Trademark Parody Cases*, 36 VILL. L. REV. 1, 61 (1991). The issue in *Tanner* was whether a privately owned shopping center could prohibit the distribution of handbills on its property when the handbilling was unrelated to the shopping center's operations. *Tanner*, 407 U.S. at 552. The Court held that the petitioner's privately owned shopping center was not dedicated to public use, and as such, there was no First Amendment right to distribute handbills on the property. *Id.* at 570. The focus of the Court's reasoning centered on the existence of "adequate alternative avenues of communication." *Id.* at 567. Where such 'avenues' existed, property owners did not have to yield to others exercise of their First Amendment rights. *Id.* at 567.

12. 604 F.2d 200 (2d Cir. 1979). In *Dallas Cowboys Cheerleaders*, the plaintiffs alleged that when the defendants advertised and exhibited the film "Debbie Does Dallas," they infringed and diluted the plaintiffs' trademark in the Dallas Cowboy cheerleader uniform. *Id.* at 202.

13. *Id.* at 206.

14. *Id.* at 205. Specifically, the court stated that there was a sufficient likelihood that people who would watch the defendant's sexually explicit film would thereafter associate it with the Dallas Cowboy Cheerleaders. *Id.* This association, the court reasoned, would result in confusion that might injure the plaintiff's business reputation. *Id.*

15. *Id.* at 206.

16. *Id.*

17. *Id.*

18. 836 F.2d 397 (8th Cir. 1985), *cert. denied*, 488 U.S. 933 (1988).

19. *Id.* at 398.

t-shirts in part to express his concern over nuclear proliferation, thus he argued, the t-shirt should be considered protected speech under the First Amendment.²⁰ In rejecting the defendant's First Amendment claim, the court relied on the fact that the defendant sold t-shirts and started up a company called the Mutant of Omaha, Inc.²¹ The court held that the plaintiff's trademark was a form of property and the First Amendment did not give the defendant the right to infringe on those rights.²² According to the court, the property interest in a trademark "need not 'yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.'"²³ Accordingly, under the traditional approach, as illustrated by *Dallas Cowboys* and *Mutual Of Omaha*, courts refused to balance a plaintiff's property interest in a trademark against a defendant's First Amendment interest in free expression when there were alternative means available to the defendant to convey his or her message. Once a court determined that there was a likelihood of confusion, that was the end of the inquiry and no further First Amendment analysis was undertaken.

Both the *Dallas Cowboys* court and the *Mutual of Omaha* court relied on the reasoning of the United States Supreme Court in *Tanner*. However, the applicability of *Tanner* to trademark parody remains unsettled. The situation contemplated in the *Tanner* case was very different. *Tanner* did not affect the content of the speech. Rather, it only affected the time, place or manner of delivery of the speech. The *Dallas Cowboys* case and the *Mutual of Omaha* case, however, do affect the content of speech. Therefore, the *Tanner* case does not apply to the trademark parody context. Commentators noted this and the courts started to recognize this fact in the late 1980s. The following Section details the course of this recognition.

II. THE EVOLVING FIRST AMENDMENT ANALYSIS

The evolving standard in trademark parody cases distinguishes the nature of the communication based upon whether it is commercial or non-commercial speech. The first line of distinction in a trademark parody analysis is whether a particular advertisement or product involves artistic expression or commercial speech. If a court finds that a parody constitutes artistic expression, the First Amendment interests are balanced against the interests of

20. *Id.* at 402.

21. *Id.*

22. *Id.*

23. *Id.* The court held that other avenues open to the defendant included editorial parody in a book, magazine or film. *Id.*

the Lanham Act.²⁴ For commercial speech to come within the protection afforded by the First Amendment, it must involve lawful activity and not be misleading.²⁵ Thus, if a court finds that a trademark parody involves commercial speech, no free speech guarantees are implicated if the parody is likely to cause confusion, violates dilution laws, or violates the publicity laws. If the court finds that the parody involves commercial speech, it does not perform a balancing test.²⁶ In such cases, the parody defense becomes just one factor to consider in the confusion analysis.²⁷ However, distinguishing between what is commercial and what is non-commercial in the context of trademark parody can be a troublesome task. In *Virginia Pharmacy Board v. Virginia Citizens Consumer Counsel*,²⁸ the United States Supreme Court characterized commercial speech as that which "does no more than propose a commercial transaction."²⁹ That can be a difficult standard to apply in the trademark context.³⁰ Often, a parody may mix commercial and non-commercial elements.³¹

24. In the context of artistic expressions, the court allows a higher degree of confusion than in the context of commercial speech.

25. *Rubin v. Coors Brewing Co.*, 115 S. Ct. 1585, 1589 (1995).

26. Dilution laws and publicity laws are state-created statutes that protect the distinctive qualities of businesses, their reputations, their goodwill, and their respective trademarks. The "overriding purpose of anti-dilution statutes is to prohibit a merchant of noncompetitive goods from selling its products by trading on the goodwill and reputation of another's mark." *L.L. Bean v. Drake Publishers, Inc.*, 811 F.2d 26, 30 (1st Cir.), *cert. denied*, 483 U.S. 1013 (1987). The "right of publicity" commonly refers to the "appropriation of one's name or likeness for the defendant's advantage." *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 834 (6th Cir. 1983) (citations omitted). A further discussion of the various forms of dilution and publicity laws, however, is beyond the scope of this Article.

27. The intent to parody, however, is not necessarily the intent to confuse. Thus, unintentional copying of a trademark may not raise the presumption of confusion sometimes found in cases where there is intentional copying.

28. 425 U.S. 748 (1980).

29. *Id.* at 772 n.24.

30. *See, e.g.*, *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490, 495 (2d Cir. 1989) (finding that a satirical parody of a study guide that was sold for profit contained sufficient expressive elements to warrant First Amendment protection); *L.L. Bean*, 811 F.2d at 32 (concluding that the defendant's parody of the plaintiff's catalogue in the humor section of an adult magazine constituted artistic, rather than commercial, use of the plaintiff's mark).

31. *Compare Schieffelin & Co. v. Jack Company of Boca, Inc.*, 725 F. Supp. 1314, 1322-24 (S.D.N.Y. 1989) (concluding that the defendant's use of aspects of the plaintiff's distinctive bottle was not based upon any artistic expression), *with Black Dog Tavern Co. v. Hall*, 823 F. Supp. 48, 57 (D. Mass. 1993) (finding that the defendant's t-Shirts, which mimicked the plaintiff's popular tavern, contained enough expressive elements so as not to create a risk of confusion).

A. *The Development of the Distinction Between Commercial and Non-Commercial Speech*

One of the first major decisions to recognize the distinction between commercial and non-commercial speech in the trademark parody context was *L.L. Bean v. Drake Publishers, Inc.*³² The parody at issue involved a two page article entitled "L.L. Bean's Back-To-School-Sex-Catalog" placed in a monthly periodical featuring erotic entertainment.³³ The court noted that the pervasive influence of trademarks in our society today have made recognizable trademarks a natural target for satirists.³⁴

On appeal, the court found that the parody constituted an editorial or artistic, rather than commercial, use of the plaintiff's trademark.³⁵ Thus, the court considered the parody non-commercial speech. Accordingly, the court reasoned that it was unconstitutional to prevent the use of another's trademark based on dilution law when the parody was purely non-commercial, although in the context of commercial speech, anti-dilution statutes may constitute legitimate regulations of speech.³⁶

In contrast to the purely non-commercial speech found in *L.L. Bean*, in *Schieffelin & Co. v. Jack Company of Boca, Inc.*,³⁷ the New York District Court faced a parody involving purely commercial speech.³⁸ In *Schieffelin*, the defendants filed a motion to dismiss, claiming that their ten-dollar bottle of popcorn would not likely be confused with Dom Perignon Champagne and that this was simply a "classic parody" protected under the First Amendment.³⁹ Three factors influenced the court's ruling that the speech was purely commercial. First, the defendant was selling a product; second, the defendant did not base the parody upon artistic or political expression; and finally, the underlying purpose of the parody was economic gain. Thus, the court did not balance the First Amendment rights to freedom of speech against established trademark rights.⁴⁰ The court found that the parody was

32. 811 F.2d at 26.

33. *Id.* at 27. The article displayed L.L. Bean's trademark but was labelled as "humor" and "parody". *Id.* The district court found, however, that the article had tarnished L.L. Bean's trademark by "undermining the good will and reputation associated with the mark." *Id.*

34. *Id.* at 28 (citations omitted).

35. *Id.* at 32.

36. *Id.*

37. 725 F. Supp. 1314 (S.D.N.Y. 1989).

38. The popcorn product sold by the defendants, called Champop, was packaged in a champagne bottle similar to the Dom Perignon bottle produced by the plaintiffs. *Id.* at 1316. In addition, the label affixed was of identical shape and color as the Dom Perignon label. *Id.*

39. *Id.* at 1322.

40. The Northern District of Illinois reached a similar decision when the Coca-

not sufficiently strong to destroy the potential for consumer confusion between the two products.⁴¹

In another purely commercial setting, *Carson v. Here's Johnny Portable Toilets*,⁴² the Sixth Circuit held that the defendant violated Carson's right of publicity because the defendant "intentionally appropriated his identity for commercial exploitation" by using the now-famous "Here's Johnny" phrase to promote their product.⁴³ The defendant claimed that because neither the celebrity's name nor likeness was used, there can be no finding of infringement.⁴⁴ The court, however, concluded that protecting the "Here's Johnny" phrase did not implicate the commands of the First Amendment.⁴⁵

The expressive elements of parody and artistic expression require greater First Amendment protection than pure commercial speech. In *Cliffs Notes v. Bantam Double-Day Dell Publishing Group*,⁴⁶ the publisher of a study guide claimed that the cover of a parody publication would give consumers the false impression as to which company published the book.⁴⁷ There, the court used a balancing test in the context of artistic speech, rather than classifying the publication as commercial speech.⁴⁸ In balancing the interest, the court noted that:

in deciding the reach of the Lanham Act in any case where an expressive work is alleged to infringe a trademark, it is appropriate to weigh the public interest in free expression against the public interest in avoiding consumer confusion . . . the expressive element of parodies requires more protection than the labeling of ordinary commercial products.⁴⁹

Cola Company sued a bubble gum company that used a container to market its product which closely resembled a Coca-Cola bottle. *Coca-Cola Co., v. Alma-Leo U.S.A., Inc.*, 719 F. Supp. 725 (N.D. Ill. 1989). There, the court examined the distinctive nature of the Coca-Cola container and applied, in reaching its determination, factors such as the commonness of the trademark, the length of time the mark has been used, the scope of advertising and promotion, the nature and extent of the business, and its reputation. *Id.* at 727.

41. *Schieffelin*, 725 F. Supp. at 1323-24.

42. 698 F.2d 831 (6th Cir. 1983).

43. *Id.* at 836.

44. *Id.* at 833-35.

45. The court held that the defendants could not use the "Here's Johnny" phrase based upon a right of publicity theory rather than a traditional likelihood of confusion test. According to the Court, the defendants did not violate the confusion test because it was unlikely that the public would believe that Johnny Carson endorsed or promoted the company's product. *Id.* at 833-34.

46. *Cliffs Notes, Inc., v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490, 495 (2d Cir. 1989).

47. *Id.* at 494-92.

48. *Id.* at 493.

49. *Id.* at 494-95.

Though the court noted that there is a strong public interest in avoiding confusion, in the context of artistic expression, somewhat more risk of confusion should be tolerated.⁵⁰ Thus, the court found that the parody embodied only a slight risk of confusion and that the public interest in free expression and parody outweighed that slight risk of confusion.⁵¹

In contrast with the *Cliffs Notes* decision and its finding of little likelihood of confusion, the Eighth Circuit recently held that a parody involving a mock advertisement on the back of a humor magazine did create such confusion. In *Anheuser-Busch, Inc. v. Balducci Publications*,⁵² the defendants claimed that the plaintiff's parody was intended to comment on three things: 1) the effects of environmental pollution, particularly in reference to an oil spill in a river that is the main water source for Anheuser-Busch; 2) Anheuser-Busch's decision to temporarily close its St. Louis facility as a result of that oil spill; and 3) the proliferation of Anheuser-Busch's brands and advertisements.⁵³ Conversely, the plaintiff argued that the defendant's mock advertisement created a significant likelihood of confusion, and therefore, violated the Lanham Act.⁵⁴ In support of this proposition, the plaintiff offered survey evidence to show that over half of those questioned thought that permission would be required to produce such advertisements and that six percent surveyed thought it was an actual Anheuser-Busch advertisement.⁵⁵ Nonetheless, the district court found that this was a permissible parody.⁵⁶ Specifically, the court gave "special sensitivity" to the First Amendment aspects of the case, while engaging in the confusion analysis.⁵⁷ Accordingly, the district court employed a heightened test for confusion and ruled that the editorial nature of the defendant's parody required a greater showing of confusion on the part of the plaintiff.⁵⁸

On appeal, the Eighth Circuit Court of Appeals reversed and held that the district court erred in applying a heightened like-

50. *Id.*

51. *Id.* at 497.

52. *Anheuser-Busch, Inc., v. Balducci Publications*, 28 F.3d 769 (8th Cir. 1994), *cert. denied*, 115 S. Ct. 903 (1995). The fictitious advertisement was promoting the brand "Michelob Oily." *Id.* at 771. It included the phrase "ONE TASTE AND YOU'LL DRINK IT OILY" and it included various graphics depicting the products of the plaintiffs. *Id.* at 771-72.

53. *Id.* at 772.

54. *Id.* at 772-73.

55. *Id.* at 772.

56. *Anheuser-Busch, Inc. v. Balducci Productions*, 814 F. Supp. 791, 797 (E.D. Mo. 1993), *rev'd*, 28 F.3d 769 (8th Cir. 1994), *cert. denied*, 115 S. Ct. 903 (1995).

57. *Id.* at 795-96.

58. *Id.* at 799.

likelihood of confusion test.⁵⁹ The correct standard, according to the court, is to analyze the likelihood of confusion issue first and then proceed to consider the scope of the First Amendment issues.⁶⁰ Applying this standard, the court of appeals found that the defendant's mock advertisement created a significant likelihood of confusion.⁶¹ In particular, the court noted that the advertisement appeared on the back of the magazine where the plaintiff's advertisements often appeared in other magazines and the advertisement used identical versions of the Anheuser-Busch marks.⁶² Furthermore, the plaintiff's survey evidence was particularly persuasive and strongly indicated actual consumer confusion.⁶³

In considering the implications upon the First Amendment, the *Anheuser-Busch* court noted, as did the *Cliffs Notes* court, that confusion might be tolerated if necessary to achieve the desired commentary.⁶⁴ However, the court found in this case that the confusion was completely unnecessary to achieve the defendant's stated purpose.⁶⁵ Unlike the commentary in *Cliffs Notes* which conjured up elements of the original, yet also sent a clear message that it was not the original, the court found that here the defendant's ad was an unaltered appropriation of the original.⁶⁶ The court stated that the defendant had failed to make it clear that its advertisement was a parody, and therefore, unnecessarily created confusion.⁶⁷ The court concluded that the balance between the public interest in avoiding consumer confusion and the public interest in free expression weighed against the defendant's First Amendment considerations.⁶⁸

In another case following the *Cliffs Notes* balancing approach to trademark parodies, the Southern District of New York found no likelihood of confusion between the defendant's movie character and the plaintiff's meat product. In *Hormel Foods Corp. v. Jim Henson Productions, Inc.*,⁶⁹ the plaintiff, owner of the trademark

59. *Anheuser-Busch*, 28 F.3d at 775. Specifically, the court concluded that the district court "essentially skewed its likelihood of confusion analysis in an attempt to give 'special sensitivity' to the First Amendment, holding Anheuser-Busch to a higher standard than required in a 'classic trademark infringement case.'" *Id.* at 773.

60. *Id.*

61. *Id.*

62. *Id.*

63. *Id.*

64. *Id.* at 776.

65. *Id.*

66. *Id.* at 775-76.

67. *Id.*

68. *Id.* In reaching this result, the court emphasized that there is no simple "mechanical rule by which courts can determine when a potentially confusing parody falls within the First Amendment's protective reach." *Id.* at 776.

69. *Hormel Foods v. Jim Henson Prod., Inc.*, No. 95 Civ. 5473, 1995 U.S. Dist.

"SPAM," a meat product, brought a trademark action against the defendant movie producer, who featured a character named Spa'am in its movie.⁷⁰ The plaintiff asserted that the use of the character Spa'am in the defendant's movie created a likelihood of confusion and tended to direct negative associations to the plaintiff's product.⁷¹

The Southern District Court of New York held that the defendant's use of a character named Spa'am did not create a likelihood of confusion with the plaintiff's meat product SPAM.⁷² In reaching this decision, the court recognized the standard set forth in *Cliffs Notes* as the appropriate test for addressing a First Amendment defense in a trademark parody context.⁷³ Following this standard, the court first applied each of the eight factors articulated in *Polaroid Corp. v. Polaroid Electric Corp.*⁷⁴ to determine whether there was a likelihood of confusion.⁷⁵ In particular the court noted that the defendant's character and the plaintiff's meat product were easily distinguishable and would not confuse consumers.⁷⁶ Consequently, the court concluded that there was no likelihood of confusion,⁷⁷ and therefore, did not have the occasion to engage in the subsequent First Amendment balancing analysis.

B. Recent Decisions

Recently, two district courts have confronted the First Amendment defense in trademark infringement actions and have employed two different standards in reaching their conclusions. In *No Fear, Inc. v. Imagine Films, Inc.*,⁷⁸ the plaintiff, a sportswear manufacturer, brought an infringement action against the defen-

LEXIS 13886, at *23 (S.D.N.Y. Sept. 22, 1995), *aff'd*, 73 F.3d 497 (2d Cir. 1996).

70. *Id.* at *1-2.

71. *Id.* at *5-7.

72. *Id.* at *23.

73. *Id.* at *13-14.

74. 287 F.2d 492 (2d Cir. 1961). The "Polaroid factors" which are used in determining whether there is a sufficient likelihood of confusion consist of:

1) strength of plaintiff's mark; 2) similarity of uses; 3) proximity of the products; 4) likelihood that the prior owner will bridge the gap (this refers to one of the manufacturers expanding into the domain of the other); 5) actual confusion; 6) defendant's good or bad faith; 7) quality of the junior user's product; 8) sophistication of consumers. The Polaroid factors are not exhaustive, and, in evaluating them "a court should focus on the ultimate question of whether consumers are likely to be confused."

Hormel foods, 1995 U.S. Dist. LEXIS 13886, at *12-13.

75. *Id.*

76. *Id.* at *23.

77. *Id.*

78. 930 F. Supp. 1381 (C.D. Cal. 1995).

dant who was making a movie called "No Fear."⁷⁹ The defendant filed a motion for summary judgment asserting a First Amendment defense and contending that the use of the title was artistic expression,⁸⁰ relying on *Rogers v. Grimaldi*.⁸¹ In particular, the defendant argued that the stringent balancing test applied in *Rogers* was applicable.⁸² The court noted, however, that the *Rogers* test, by its own admission, is limited to cases involving the use of celebrity names in the title of works.⁸³ Thus, the court chose to follow balancing tests articulated in *Cliffs Notes* and *Twin Peaks Productions v. Publications International, Inc.*⁸⁴ In particular, the court stated that the first part of the analysis is to determine whether there is a likelihood of confusion under the traditional framework and then weigh the risk of confusion against the First Amendment concerns.⁸⁵ Applying this standard, the court concluded that at the summary judgment phase, the parties failed to produce enough evidence to fully evaluate the likelihood and extent of confusion as to the film's source.⁸⁶ Accordingly, the court denied the defendant's motion due to the remaining questions of fact.⁸⁷

In another recent decision, the Southern District of California in *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*,⁸⁸ declined to adopt the balancing approach applied in *Cliffs Notes* and *Anheuser-Busch*, and instead, fashioned its own test for dealing

79. *Id.* at 1382.

80. *Id.*

81. 875 F.2d 994 (2d Cir. 1989).

82. *No Fear*, 930 F. Supp. at 1382. In *Rogers*, the Second Circuit held that minimal use of a celebrity's name in a title of an artistic work was permissible because it did not give the appearance of sponsorship and it was not misleading. In so ruling, the court applied a stringent balancing test that afforded great weight to First Amendment interests. *Id.* Specifically, the *No Fear* court stated:

[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.

Id. (citing *Rogers*, 875 F.2d at 999).

83. *Id.* Specifically, the court refused to apply the "explicitly misleading standard" utilized in *Rogers*. This standard, the court reasoned, gives preferential treatment to works involving competing artistic titles under the First Amendment. *Id.* at 1382-83.

84. 996 F.2d 1366 (2d Cir. 1993).

85. *No Fear*, 930 F. Supp. at 1383-84.

86. *Id.*

87. *Id.*

88. 924 F. Supp. 1559 (S.D. Cal. 1996).

with the First Amendment in the context of trademark parody.⁸⁹ In that case, the plaintiff, the owner of trademarks for children's books, brought a trademark infringement action, *inter alia*, against the defendant for its use of the plaintiff's marks in the defendant's double parody of the plaintiff's books and the O.J. Simpson double-murder trial.⁹⁰ The plaintiff asserted that the defendant misappropriated several of the plaintiff's marks and created a likelihood of confusion through its parody.⁹¹ Conversely, the defendant claimed that its use was non-infringing.⁹²

In granting the plaintiff's motion for a preliminary injunction, the court held that the defendant's use of the plaintiff's trademarks raised substantial questions for litigation and the balance of hardships favored the grant of the injunction.⁹³ The court first determined that the plaintiff had shown a possibility of confusion, but failed to establish a reasonable likelihood of success on the merits.⁹⁴ In reaching this result, the court analyzed the confusion issue under the traditional framework.⁹⁵ The court found that although the plaintiff's marks were strong, the plaintiff was unable to establish that the defendant's use was sufficiently similar and that the use would likely lead to confusion among consumers.⁹⁶ Specifically, the court took into account the significant steps that the defendant took in order to reduce the likelihood of confusion, such as the label "A Parody" prominently featured on the defendant's packaging and the disclaimer.⁹⁷ Thus, the court concluded that although the plaintiff has raised questions for litigation, the plaintiff had not established that the

89. *Id.* at 1572-73.

90. *Id.* at 1561. The defendant wrote the parody entitled "The Cat Not In The Hat! A Parody by Dr. Juice." *Id.* The work satirized the O.J. Simpson double-murder trial through mimicking the distinctive style of the popular Dr. Seuss books. *Id.*

91. *Id.* at 1570. Specifically, the plaintiff argued that the defendant misappropriated: 1) the words "Dr. Seuss"; 2) the words "Cat In The Hat"; 3) the character illustration of the famous "The Cat In The Hat"; 4) the design of the character's distinctive "stove pipe hat"; 5) the character illustration of "Maysie Bird"; 6) the character illustration of "Horton the Elephant"; and 7) the character illustration "Sam I Am." *Id.*

92. *Id.* at 1562.

93. *Id.* at 1575-76.

94. *Id.* at 1571.

95. *Id.* at 1570-71. Here, the court considered the following factors: "1) the strength of the mark, 2) [the] similarity between the mark and the infringing items, 3) [the] evidence of actual confusion, 4) [the] marketing channels used, 5) the type of goods and likely degree of consumer care, and 6) the defendant's intent in selecting its marks." *Id.* at 1570 (citing *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 616 (9th Cir. 1989)).

96. *Id.* at 1571.

97. *Id.*

defendant's use had created a likelihood of confusion.⁹⁸

Secondly, the court considered the merits of a possible First Amendment defense.⁹⁹ In addressing this issue, the court declined to following the balancing approach used in *Cliffs Notes* and *Anheuser-Busch*.¹⁰⁰ Rather, the court analyzed this issue under the traditional approach articulated by the *Dallas Cowboys* court.¹⁰¹ In applying this standard, the court rejected the defendant's First Amendment defense and concluded:

Just as in copyright, trademark infringement will be excused only where necessary to the purpose of the use. Where alternative avenues of achieving the satiric or parodic ends exist that would not entail consumer confusion, the First Amendment will not protect the parodist from being held to infringe. The court's reasoning as to the fair use defense therefore applies equally to this issue. Dr. Seuss would most likely prevail at trial against a First Amendment defense.¹⁰²

C. Testing the First Amendment Framework Against Future Challenges

Challenges remain and questions linger as to the proper analytical framework in trademark parody cases, as can be seen by the emergence and proliferation in the late 1980s of First Amendment concerns. The First Amendment analysis for trademark parody seems to be evolving into a two-part test. First, determine if the use of the trademark is unlawful, confusing, misleading or disparaging using the traditional tests for trademark infringement, dilution or right of publicity. Next, determine whether the speech is commercial or non-commercial. If the speech involved is commercial, no balancing test is required under the First Amendment. Those interests are analyzed in the traditional infringement context. If the speech is non-commercial, then the First Amendment interests should be balanced. In the context of non-commercial speech, courts will tolerate a higher level of confusion than would otherwise be the case.

Another issue to consider is whether the balancing would be the same in trademark infringement versus dilution or right of publicity. Some commentators have suggested that the trademark

98. *Id.*

99. *Id.* at 1571-72.

100. *Id.* at 1572. The court noted that the *Cliffs Notes* balancing test is inappropriate for addressing questions involving non-commercial speech, such as the parody at issue. *Id.* This standard, according to the court, evolved out of the commercial speech decisions, and rests on the principle that commercial speech is entitled to a lower degree of First Amendment protection. *Id.*

101. *Id.* at 1573.

102. *Id.*

owner's interest in avoiding dilution should be given much less weight than the trademark owner's interest in preventing confusion because confusion also involves the public's interest in not being misled. The *L.L. Bean* case suggests in the context of artistic speech, non-commercial speech that the private interest in preventing dilution should not be weighed against the First Amendment interest.

CONCLUSION

This Article has tried to identify the framework of analysis that accounts for the legitimate yet sometimes competing interests of artistic expression on the one hand and trademark protection on the other. The remaining challenge is to test that framework against future cases. The results in trademark parody cases are sometimes difficult to reconcile. The humor is often simply in the eye of the beholder.

The line between permissible artistic expression and impermissible disparagement and confusion can be difficult for courts to draw. In practice, it seems a plaintiff is most likely to succeed against a trademark parody when the parody is disparaging or offensive, the parody is identical or closely similar to the original trademark, and the interest of the public in avoiding confusion is strong.