

Trademark Law

Prof. Madison

Today: Trademarks and (free, or expensive?) expression

Key concepts from Class 22:

“Nominative” use.

Trademarks and comparative advertising.

Judicial innovation.

Overlap with free expression concerns.

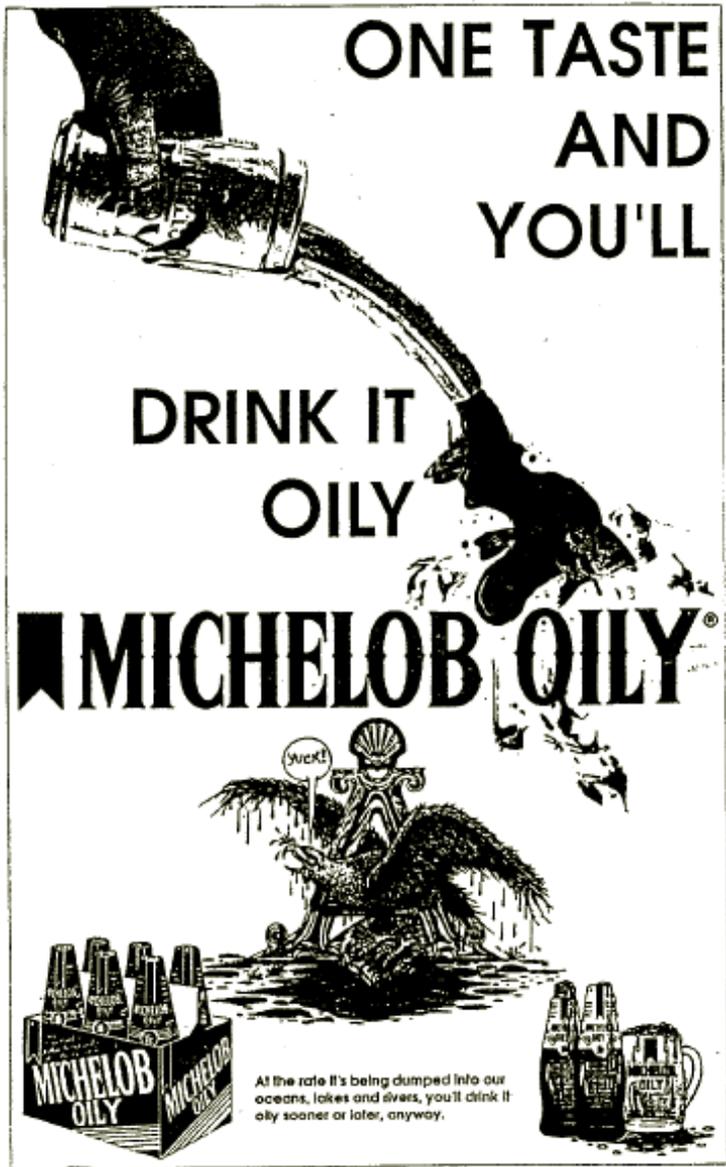
Freedom of expression in tension with TM law

Version 1 of 2: defending the unauthorized use of others' trademarks

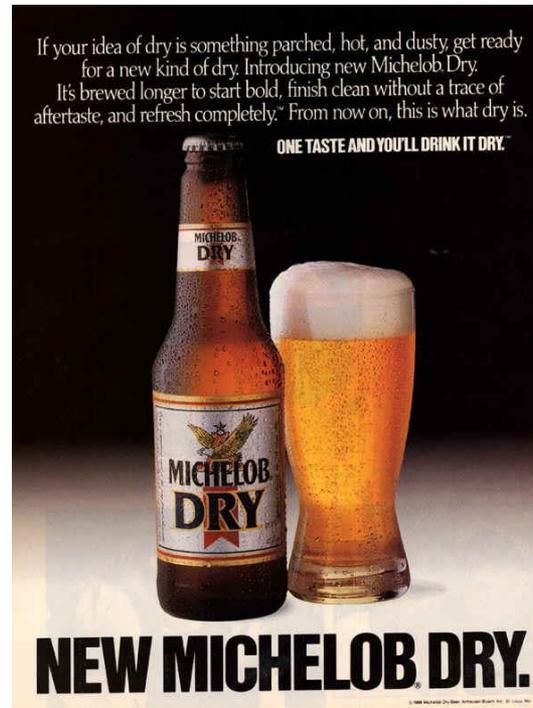
- Parody/satire/commentary and other forms of free expression (art!) are (often) protected under the First Amendment from government interference/regulation, such as © or TM.
- So: what to do when a TM owner argues: this is LoC (or dilution), and a deft argues: this is expression (including “fair use” as a statutory defense to dilution claims)
- Pause to consider how to define parody – satire – comedy – criticism – expression – “noncommercial” use. *Do not adopt the (false) parody/satire distinction from © in Campbell v Acuff-Rose Music (S. Ct. 1994), which doesn't exist – even in Campbell.*]
- Generally (but not always): courts steer away from the 1A as a tool and instead innovate within LoC and dilution doctrine.



Starbucks v. Dwyer (2000)
(settled; the artist withdrew)



Anheuser Busch, Inc. v. Balducci Publications
(8th Cir. 1994)



Approach 1:
Analyze LoC confusion factors first, then consider possible parody.
Does the existence of a credible claim of parody change the LoC outcome?

A broad view of parody/satire: Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC (4th Cir. 2007)



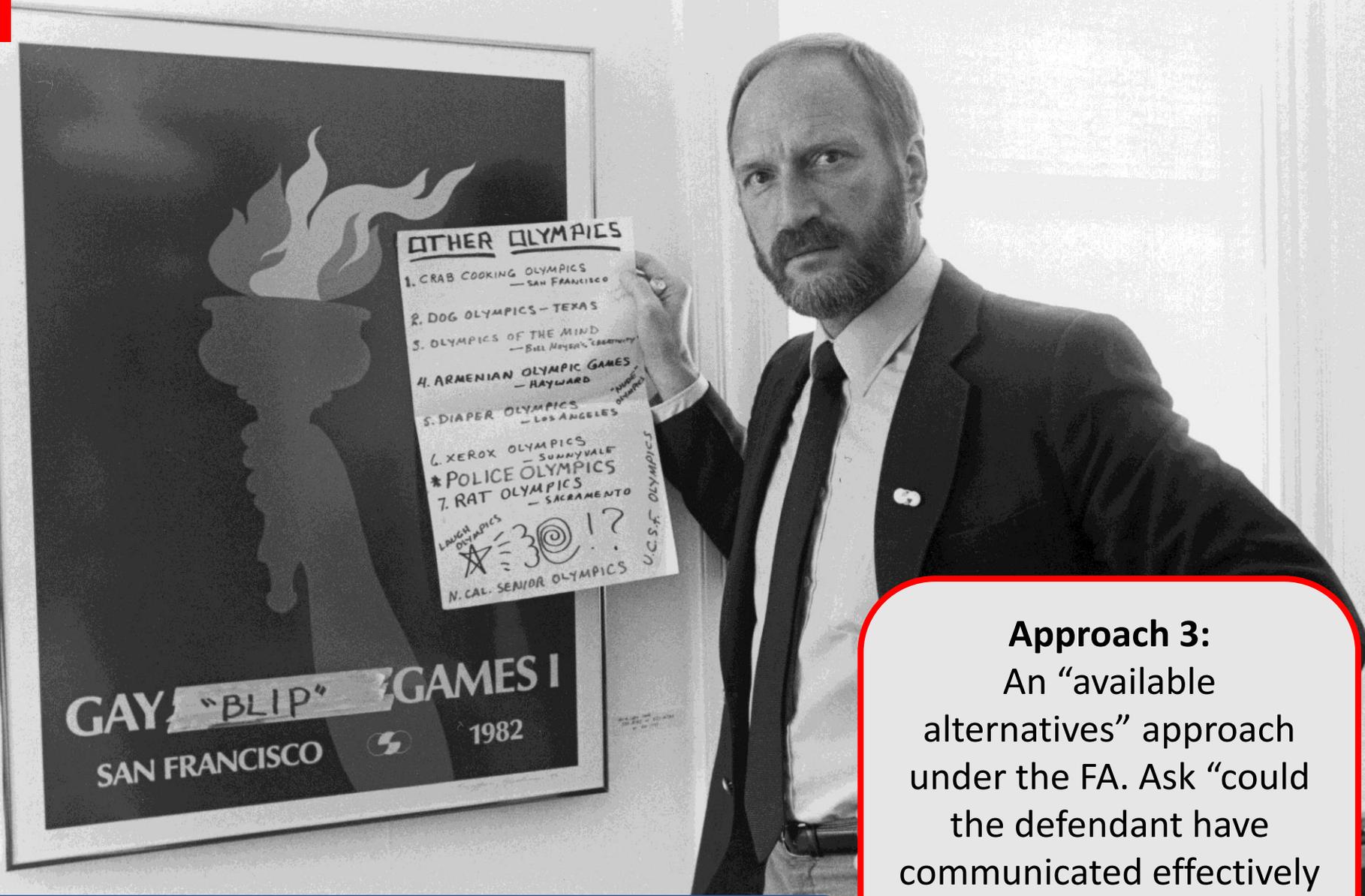
(a narrow view of parody/satire: Louis Vuitton Malletier S.A. v. Hyundai Motor Am. (S.D.N.Y. 2012))



Approach 2:

Ask “is it a parody or satire?” first.

Determine presence of critical use, then use that as a baseline for analysis of LoC factors or fair use/noncomm use defense to dilution.



San Francisco Arts & Athletics Ass'n v. U.S. Olympic Committee (U.S. 1987)

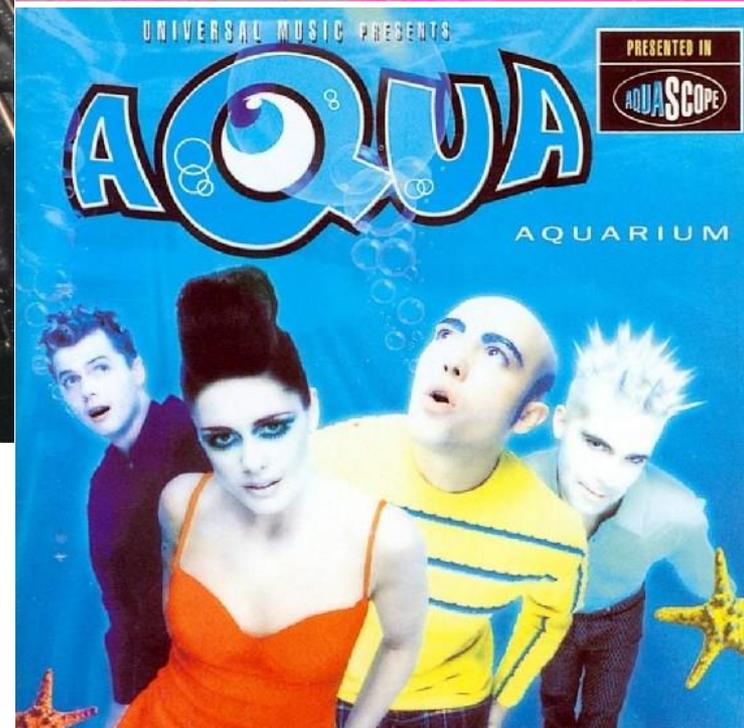
Approach 3:
An “available alternatives” approach under the FA. Ask “could the defendant have communicated effectively using different expression?”



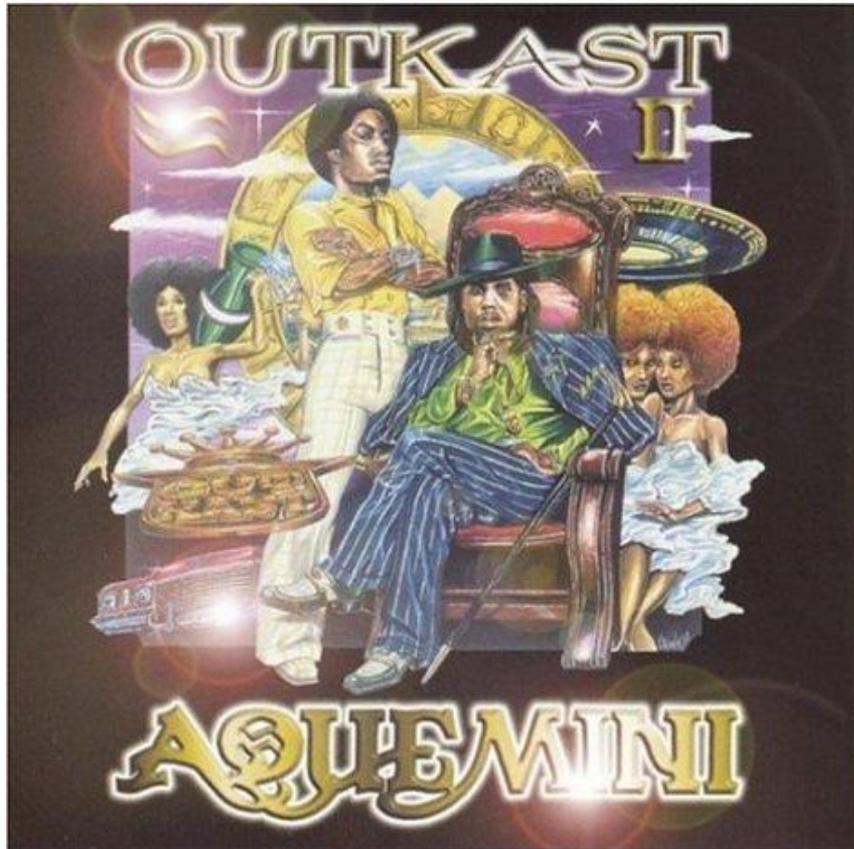
Approach 4 (the dominant (?) approach): Artistic relevance under *Rogers v. Grimaldi* (2d Cir. 1989). For LoC re: expressive works, does the title have some artistic relevance to the content? If not, then: LoC?

Mattel, Inc. v. Walking Mountain Productions
(9th Cir. 2003)

Mattel, Inc. v. MCA Records, Inc.
(9th Cir. 2002)



An "artistic relevance" (balancing) approach, based on *Rogers v. Grimaldi*.
Note: a judicial innovation, as with nominative (fair) use.



An “artistic relevance” approach,
based on *Rogers v. Grimaldi*.
*Is the pltf’s mark relevant to the
deft’s work?*
Who decides, and how?

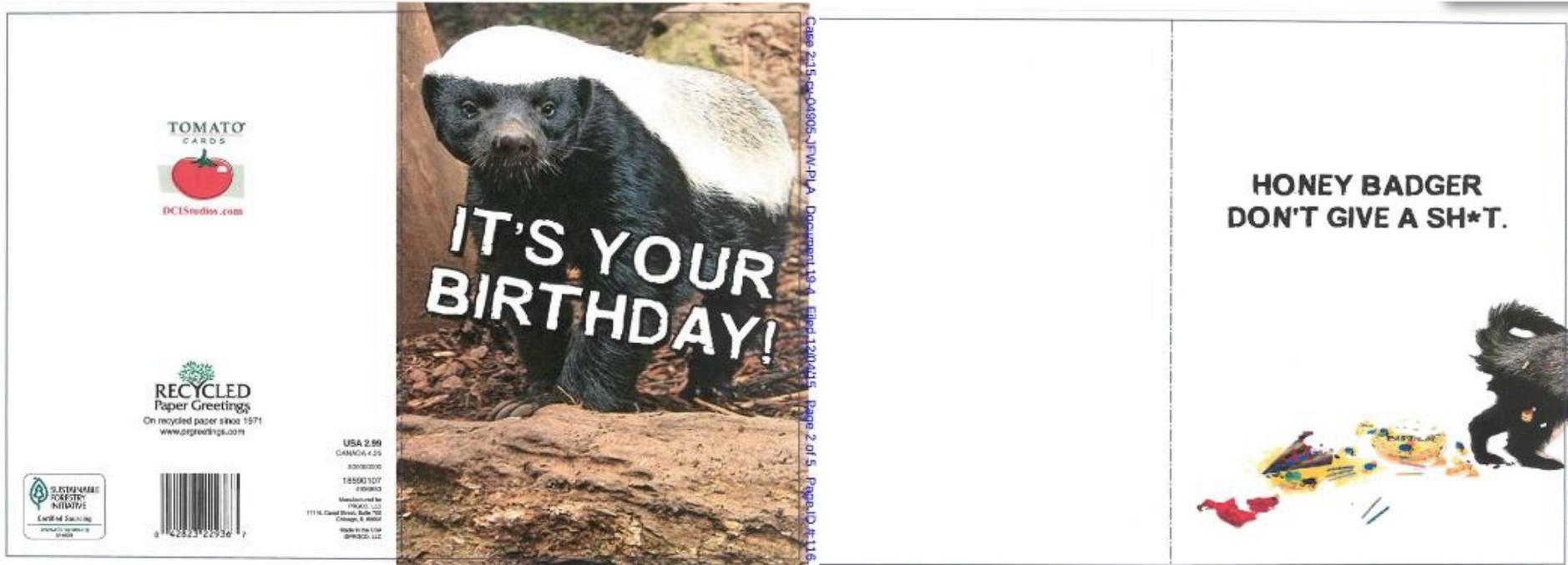


Rosa Parks v.
LaFace Records
(6th Cir. 2003)



An “artistic relevance” approach,
based on *Rogers v. Grimaldi*.
Expanded beyond titles, to use of
protected marks in the body of the
work.

E.S.S. Entertainment 2000,
Inc. v. Rock Star Videos, Inc.
(9th Cir. 2008)



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An “artistic relevance” approach,
based on *Rogers v. Grimaldi*.

*Even if the use of the mark has
“artistic relevance,” is the use of the
mark explicitly misleading as to the
source or content of the cards?*

The defendant,
in *Gordon v.
Drape Creative*
(9th Cir. 2018)

BUT Rogers does not apply where the defendant used the plaintiff's mark as a mark – as a designation of source. Instead: ordinary LoC applies.

Is a dog toy an expressive work, so that *Rogers v. Grimaldi* should have applied?

Dilution claims are subject to the defense that the deft's use is "noncommercial." Is use of the JD mark and trade dress by the deft "noncommercial"?

LoC? If the deft were to file a motion for SJ on "no likelihood of confusion" grounds and "no likelihood of dilution by tarnishment" grounds, should the motion be granted?

What if surveys show that some consumers were confused as to source?



Jack Daniel's Properties, Inc. v. VIP Products, LLC (U.S. 2023)

(Both products are still available for purchase.)

A

WALT DISNEY

MICKEY MOUSE

The End

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