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# The Art of Parody

Assessments range from the strength of the mark to the strength of the humor.

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A NUMBER of recent cases have produced seemingly inconsistent results where trademark parody is alleged. For example, the court in *Anheuser-Busch v. VIP Products* enjoined defendant's "Buttwiper" dog toys, which closely resembled Budweiser beer bottles, while defendants who produced pet products "Timmy Holedigger" canine perfume and "Chew Vuitton" purse-shaped chew toys successfully defeated both designers' infringement claims using a parody defense.<sup>1</sup>

Trademark parody entails appropriating another's mark as a known element of popular culture and then building on it to contribute something new for humorous effect or commentary.<sup>2</sup> Parody cases can seem inconsistent, even within a particular circuit or type of use. However, viewed in terms of the three main areas of inquiry in parody cases, the "Buttwiper" case is not as anomalous as some perceived it to be.

While plaintiffs Hilfiger and Vuitton established neither dilution nor infringement, Anheuser-Busch relied on survey evidence and presented evidence that the two products competed in the same market. Though defendant's product featured an image of a dog dragging its rear end across a rug to embody the "Buttwiper" name, it did not reach the threshold of dilution, but its low-brow humor may have implicitly influenced the court to enjoin it. The gag Hilfiger perfume and Vuitton purse also constituted "purer," more paradigmatic parodies than the "Buttwiper"



**The results all depend: Anheuser-Busch was successful in having 'Buttwiper' dog toys, resembling Budweiser beer bottles, enjoined, while the infringement claims of designers Tommy Hilfiger and Louis Vuitton were defeated by the producers of 'Timmy Holedigger' canine perfume and 'Chew Vuitton' purse-shaped chew toys, using a parody defense.**

beer bottles, since they satirized not only the products themselves, but the luxury-brand consumers who willingly pay \$60 for a bottle of cologne and \$1,000 for a handbag.

Courts consider a variety of issues when an infringement or dilution defendant asserts a

parody defense, from the strength of a mark to a parody's humor. These issues can be grouped into three general themes or lines of inquiry in parody cases:

- the extent to which the use is likely to confuse consumers;

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- how “pure” the parody is; and
- whether the use threatens to tarnish plaintiff’s mark or goodwill.

Counsel on either side of a parody case, as well as those advising clients whether to make or object to potentially parodic use of a mark, should assess a parody from all three angles.

### The Three Lines of Inquiry

**Confusion.** A significant portion of parody cases focus only on whether defendant’s use is likely to confuse consumers as to source or sponsorship, applying a traditional multi-step analysis that balances factors including the products’ similarity, proximity and quality, as well as consumer sophistication. Courts emphasize the existence of actual confusion or the lack thereof, as demonstrated by survey evidence or incidents of confusion, such as misplaced orders or disgruntled customers.

Courts that end their assessment at a traditional infringement analysis usually reason that if confusion exists or is likely, the parody is presumed unsuccessful and the defense fails: Good parody must make abundantly clear that it is not that which it parodies.

For example, when activists protesting nuclear arms based their “Mutant of Omaha” T-shirts and mugs on Mutual of Omaha’s well-known marks and logo, survey evidence and instances of actual confusion in the form of mis-delivered mail enabled plaintiffs to obtain an injunction prohibiting defendants’ activities despite the legitimate message defendants sought to convey.<sup>3</sup>

More recently, the Southern District of New York enjoined a popcorn maker that bottled its wares as “Dom Poppingnon,” ostensibly to mock snobby oenophiles. The champagne giant established that 47 percent of survey respondents believed an association of some kind existed between the two products.

A survey need not show such a high rate of confusion to persuade a court of infringement, however. For example, a mere 10 percent of the surveyed population assumed a sponsorship relationship in Mutant of Omaha, which sufficed to enjoin defendants’ use. In a dispute over fast food commercials, the court deemed each side’s survey unreliable, but held that taken together, they indicated at least a small percentage of the public was confused as to the true sponsor of the advertisements.<sup>4</sup>

Courts did not require survey evidence to enjoin “Gucchi-Goo” diaper bags, “A.2” sauce, and “Jaws” trash compactors on the basis of likely confusion with Gucci handbags, A.1 steak sauce, and the film “Jaws,” assigning little weight to the humor intended.<sup>5</sup> However, more recent cases have relied on survey evidence or made negative inferences based on its absence, reflecting a trend toward according surveys more weight than in the past.

On the other hand, courts are quick to discount surveys that do not adhere to prescribed techniques. The Tenth Circuit gave little credence to a survey showing confusion between “Lardashe” and “Jordache” jeans because its side-by-side comparison methodology did not represent market conditions.

More recently, a court rejected Wal-Mart’s survey evidence challenging a blogger’s use of “Walocaust” and “Wal-Qaeda” online and on products. The court found the survey asked leading questions, failed to approximate real-world conditions, and relied on an over-inclusive universe, thus offering only dubious proof of consumer confusion.

Similarly, Anheuser-Busch lost credibility when a court thought its survey evidence, intended to show that a florist’s use of the slogan “This Bud’s For You” would confuse consumers, elicited “anticipated, and essentially irrelevant, responses.”<sup>6</sup>

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Trademark parody entails taking another’s mark as a known element of popular culture and then building on it to contribute something new for humorous effect or commentary. Courts consider a variety of issues, from the strength of the mark to the parody’s humor.

In a traditional trademark infringement case, plaintiffs benefit from evidence about their advertising expenditures, solid reputation, wide recognition among consumers and years of trademark use. While a strong mark points toward likelihood of confusion in the usual trademark case, “[w]here the plaintiff’s mark is being used as part of a jest...the opposite can be true.”<sup>7</sup> Parodists may fare better against well-known targets, as did those defendants who satirized Spam luncheon meat, the Farmer’s Almanac, and the New York Stock Exchange.<sup>8</sup> Courts assume famous marks make more viable targets for satire, since the renown of the parodied mark increases the likelihood that consumers will “get the joke.”

As the Second Circuit held in *Cliffs Notes*, a parody must simultaneously convey two contradictory messages: that it is the original, but also that it is not the original, and is rather a parody. If it does only the former and not the latter, it is both a poor parody and vulnerable under trademark law as an infringement.<sup>9</sup>

**Purity.** Courts that focus on the “purity” of the parody itself may ultimately hold that the First Amendment outweighs any Lanham Act interest for a particular non-trademark use of a mark. Where the parody use is editorial or artistic

rather than commercial, courts often demand a stronger showing of likely confusion before finding that a use is not protected speech. The *Cliffs Notes* court acknowledged that “somewhat more risk of confusion is to be tolerated when a trademark holder seeks to enjoin artistic expression such as parody.”

In the archetypal parody, the message is primary and commercial gain subordinate. Visual art, literary works and protest slogans are most likely to garner protection as speech, while items like shirts and bumper stickers present a middle ground; purely commercial products rarely garner protection under the First Amendment, even when they rely on humor or satire.

For example, the Ninth Circuit dismissed Mattel’s suit against photographer Tom Forsythe for his images depicting Barbie with various kitchen appliances, because his work constituted both art and social commentary and his use of the mark was noncommercial. In the 1970s, an activist group successfully defended its unflattering use of electric company mascot “Reddy Kilowatt,” which the group caricatured to convey dissatisfaction with that and other utility companies.<sup>10</sup>

In an exception to the tendency to find commercial uses of a mark not to be parodies, cases involving novelty items have been called the best examples of parody and presumed to preclude consumer confusion.<sup>11</sup> A “novelty item” usually refers to a small toy or gag gift with no inherent use besides amusement. Novelty items can provide ideal vehicles to comment on well-known marks, even though they are designed to generate profit as well as amusement, as with the “Timmy Holedigger” pet perfume; “Miami Mice” T-shirts; and “Petley fleabag” stickers.<sup>12</sup>

If defendant’s product is purely commercial, a court may find it to be a free-rider trying to pass off mere pun as parody, just as the makers of “A.2” sauce sought to capitalize on consumer following for the “A.1” brand. The Southern District of New York similarly enjoined the “Dom Poppingnon” popcorn described above, packaged in a bottle that mimicked that of Dom Perignon champagne. While the court acknowledged the wordplay, it gave little weight to defendant’s professed attempt to mock the pretensions of Dom Perignon purchasers in the face of survey evidence showing confusion.<sup>13</sup>

A parody may also fail because it uses plaintiff’s mark not to parody plaintiff, but to satirize an unrelated product or concept. Several circuits have dubbed such attempts “fool’s gold” parodies because they appear successful until analyzed more closely.

For example, the Ninth Circuit enjoined a parodist who relied on Dr. Seuss’s signature style to ridicule O.J. Simpson. Likewise, the Eighth Circuit found that evidence of confusion outweighed First Amendment rights when it enjoined a mock advertisement for “Michelob Oily,” which made a relevant environmental

statement, but relied on the mark of an innocent bystander to do so.<sup>14</sup>

Lastly, parody may simply convey “that business and product images need not always be taken too seriously; a trademark parody reminds us that we are free to laugh at the images and associations linked with the mark.”<sup>15</sup> Such a broad understanding of trademark parody may explain how elite designer brands Hilfiger and Vuitton lost out to their parodists, while plebian Budweiser prevailed.

**Tarnishment.** Tarnishment arises when a defendant borrows or approximates another’s mark in a way that creates an undesirable, unwholesome, or unsavory association with that mark.<sup>16</sup>

Prior to the passage of the Federal Trademark Dilution Act (“FTDA”) in 1996, some courts applied state anti-dilution statutes to regulate dilutive uses, while others deemed uses infringing that they might more accurately have labeled dilutive. Trademark owners consistently have prevailed on infringement claims against uses that associate their mark with sex or illegal drugs: Coca-Cola successfully challenged “Enjoy Cocaine” posters, and General Electric obtained an injunction to prohibit the sale of “Genital Electric” T-shirts.<sup>17</sup>

Owners of famous marks consistently fare better when challenging their marks’ use in a pornographic or illicit context than they do when seeking to enjoin a novelty use or a cogent political message, whether because the court explicitly finds dilution or simply because a pure parody will more likely garner First Amendment protection.

For example, courts found both the magazine spread featuring the Pillsbury doughboy engaged in lewd acts and the pornographic film featuring Dallas Cowboy cheerleaders to dilute the marks they incorporated. Likewise, a mock American Express card that came with a condom and adopted the “Never Leave Home Without It” slogan was found likely to tarnish the famous credit card.<sup>18</sup>

Toilet humor or “dirty” jokes can also fall under the rubric of tarnishment, as dilution doctrine increasingly encompasses a wider span of noninfringing uses. Based on the federal dilution statute, Anheuser-Busch successfully enjoined “Buttwiser” on T-shirts and the makers of Cabbage Patch Kids dolls prevailed against Topps over the latter’s “Garbage Pail Kids” cards on their state antidilution claim.<sup>19</sup>

In the recent “Buttwiper” case, Anheuser-Busch argued that defendant’s crass product name and image of a dog wiping its rear end across a floor tarnished its “Budweiser” mark. While Anheuser-Busch ultimately lost its dilution claim and won on infringement, that coarse image may have predisposed the court to issue

an injunction. Anheuser-Busch had previously obtained an injunction prohibiting the use of “Where There’s Life, There’s Bugs” as a slogan for floor wax: that decision rested on a likelihood of confusion, but the court acknowledged plaintiff’s complaint that associating bugs with beer could damage Budweiser’s image.<sup>20</sup>

Since the passage of the FTDA and the more comprehensive Trademark Dilution Revision Act, several unsuccessful infringement plaintiffs have prevailed on dilution claims. In 2008, one district court issued a temporary restraining order enjoining Art Van Furniture’s use of an image of a partially-unwrapped brown couch that resembles Hershey’s trade dress based on dilution, while rejecting Hershey’s infringement claim. Another district court permanently enjoined the owners of “tawdry” adult retail store “Victor’s Secret” as likely to tarnish the marks and reputation of nationwide chain Victoria’s Secret.<sup>21</sup>

While dilution doctrine often proves impotent against a use comprising strictly speech, it can otherwise be a great boon to owners of famous marks when their marks are put to unwholesome, unsavory or merely benign blurring uses that do not reach the level of infringement.

## Conclusion

Although likelihood of confusion remains the crux of an infringement analysis, a successful parody defense precludes confusion and can inject the First Amendment into the analysis. Where the offending use tarnishes an existing mark, plaintiffs may find protection in the TDRA.

Counsel for both plaintiffs and defendants in parody cases should not fail to consider the three dominant lines of inquiry: confusion, purity and tarnishment.



1. *Anheuser-Busch Inc. v. VIP Prods. LLC*, No. 08-cv-0358, 2008 U.S. Dist. LEXIS 82258 (E.D. Mo. Oct. 16, 2008); *Tommy Hilfiger Licensing Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410 (S.D.N.Y. 2002); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 263 (4th Cir. 2007).

2. *Elsmere Music Inc. v. Nat’l Broad. Co.*, 623 F.2d 252, 253 n.1 (2d Cir. 1980).

3. *Mutual of Omaha Ins. Co. v. Novak*, 648 F. Supp. 905 (D. Neb. 1986), aff’d, 836 F.2d 397 (8th Cir. 1987).

4. *Schieffelin & Co. v. Jack Co. of Boca Inc.*, 850 F. Supp. 232, 240 (S.D.N.Y. 1994); *Mutual of Omaha*, 648 F. Supp. at 911; *Wendy’s Int’l Inc. v. Big Bite Inc.*, 576 F. Supp. 816 (S.D. Ohio 1983).

5. *Gucci Shops Inc. v. R.H. Macy & Co.*, 446 F. Supp. 838 (S.D.N.Y. 1977); *Nabisco Brands Inc. v. Kaye*, 760 F. Supp. 25 (D. Conn. 1991); *Universal City Studios Inc. v. Montgomery Ward & Co.*, 207 U.S.P.Q. 852 (N.D. Ill. 1980).

6. *Jordache Enters. Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987); *Smith v. Wal-Mart Stores Inc.*, 537 F. Supp. 2d 1302 (N.D. Ga. 2008); *Anheuser-Busch Inc. v. Florists Ass’n of Greater Cleveland Inc.*, 603 F. Supp. 35, 38 (N.D. Ohio 1984).

7. *Yankee Publ’g Inc. v. News Am. Publ’g Inc.*, 809 F. Supp. 267, 273 (S.D.N.Y. 1992), quoted in *Hilfiger*, 221 F. Supp. 2d at 416.

8. *Hormel Foods Corp. v. Jim Henson Prods. Inc.*, 73 F.3d 497 (2d Cir. 1996); *Yankee Publ’g*, 809 F. Supp. 267; *N.Y. Stock Exch. Inc. v. N.Y., N.Y. Hotel, LLC*, 69 F. Supp. 2d 479 (S.D.N.Y. 1999), aff’d in part and rev’d in part, 293 F.3d 550 (2d Cir. 2002)

(fact issue existed as to whether use tarnished logo of building facade).

9. *Cliffs Notes Inc. v. Bantam Doubleday Dell Publ’g Group Inc.*, 886 F.2d 490, 494, 495 (2d Cir. 1989).

10. *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003); *Reddy Comm’ns Inc. v. Envtl. Action Found. Inc.*, 199 U.S.P.Q. 630 (D.D.C. 1977).

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

12. *Hilfiger*, 221 F. Supp. 2d at 415 n.4; *Universal City Studios Inc. v. Casey & Casey Inc.*, 622 F. Supp. 201 (S.D. Fla. 1985), aff’d without op., 792 F.2d 1125 (11th Cir. 1986); *Tetley Inc. v. Topps Chewing Gum Inc.*, 556 F. Supp. 785 (E.D.N.Y. 1983).

13. *Nabisco*, 760 F. Supp. at 26-29; *Schieffelin*, 850 F. Supp. at 239-41.

14. *Dr. Seuss Enters., L.P. v. Penguin Books USA Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997); *Anheuser-Busch Inc. v. Balducci Publ’ns*, 28 F.3d 769 (8th Cir. 1994).

15. *Hilfiger*, 221 F. Supp. 2d at 415.

16. *Original Appalachian Artworks Inc. v. Topps Chewing Gum Inc.*, 642 F. Supp. 1031, 1039 (N.D. Ga. 1986). Dilution comprises two types of harm: blurring, when a famous mark’s ability to identify its product has been impaired due to an association in the minds of consumers arising from similarity between it and another mark, and tarnishment.

17. *Coca-Cola Co. v. Gemini Rising Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972); *Gen. Elec. Co. v. Alumpa Coal Co. Inc.*, 205 U.S.P.Q. 1036 (D. Mass. 1979).

18. *Pillsbury Co. v. Milky Way Prods. Inc.*, 215 U.S.P.Q. 124 (N.D. Ga. 1981); *Dallas Cowboys Cheerleaders Inc. v. Pussycat Cinema Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979); *Am. Express Co. v. Vibra Approved Labs. Corp.*, 10 U.S.P.Q.2d 2006 (S.D.N.Y. 1989).

19. *Anheuser-Busch Inc. v. Andy’s Sportswear Inc.*, 40 U.S.P.Q.2d 1542 (N.D. Cal. 1996); *Original Appalachian*, 642 F. Supp. at 1039-40.

20. *VIP Prods.*, 2008 U.S. Dist. LEXIS 82258, at \*30-32; *Chem. Corp. of Am. v. Anheuser-Busch Inc.*, 306 F.2d 433, 436 (5th Cir. 1962).

21. *Hershey Co. v. Art Van Furniture Inc.*, No. 08-cv-14463 (E.D. Mich. Oct. 24, 2008); *V Secret Catalogue Inc. v. Moseley*, No. 98-cv-395 (W.D. Ky. May 21, 2008).