

ABA SECTION OF LITIGATION
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The Satire/Parody Distinction in Copyright and Trademark Law— Can Satire Ever Be a Fair Use?

*Juli Wilson Marshall
Nicholas J. Siciliano
Latham & Watkins LLP
233 South Wacker Drive
Sears Tower, Suite 5800
Chicago, Illinois 60606
juli.marshall@lw.com*

I. PARODY VERSUS SATIRE IN COPYRIGHT LAW: JUST ARGUE PARODY

A. Fair Use Defense for a Copyright Claim

The fair use of copyrighted works for purposes such as criticism or comment is not an infringement of copyright. *See* 17 U.S.C. § 107. The idea of fair use reflects copyright law’s careful consideration of First Amendment principles, as fair use permits later authors “to use a previous author’s copyright to introduce new ideas or concepts to the public.” *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1265 (11th Cir. 2001). Section 107 of the Copyright Act delineates a nonexclusive list of four factors to assist courts in determining whether a given use of a copyrighted work is fair. The factors include:

1. The purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
2. The nature of the copyrighted work;
3. The amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
4. The effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 107.

Each factor should be explored and weighed on a case-by-case basis, and depending on the facts of the case, some factors may weigh more heavily than others. *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577–78 (1994). Moreover, the factors should not be analyzed in a vacuum; indeed, the factors are interrelated. *See id.* at 579; *see also Abilene Music, Inc. v. Sony Music Entm't*, 320 F. Supp. 2d 84, 89 (S.D.N.Y. 2003) (“Once a work is determined to be a parody, the second, third, and fourth factors are unlikely to militate against a finding of fair use.”).

B. Supreme Court Weighs in on Parodic and Satiric Fair Use in *Campbell v. Acuff-Rose Music, Inc.*

The Supreme Court has unequivocally held that a parody may qualify as fair use under § 107. According to the Court, a parody is the “use of some elements of a prior author’s composition to create a new one that, at least in part, comments on that author’s works.” *Id.* at 580. Like other forms of comment or criticism, parody can provide social benefit, “by shedding light on an earlier work, and, in the process, creating a new one.” *Id.* In other words, parodies can be considered “transformative” works, as opposed to merely “superseding” works. Since transformative works “lie at the heart of the fair use doctrine’s guarantee of breathing space within the confines of copyright,” the more transformative the parody, the less will be the importance of other § 107 factors that may weigh against a finding of fair use. *Id.* at 579.

1. The Court creates a fair use dichotomy between parody and satire

After concluding that parody could be considered fair use, the Court quickly qualified its holding: if the new work “has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh,” the work is less transformative, and other fair use factors, such as whether the new work was sold commercially, loom larger. *Id.* at 580. The Court explained further that while a parody targets and mimics the original work to make its point, a satire uses the work to criticize something else, and therefore requires justification for the very act of borrowing. *See id.* at 581. As a result, the Court appears to favor parody under the fair use doctrine, while devaluing satire.

2. But a footnote arguably weakens the dichotomy

Although the above language from *Campbell* strongly suggests that a new work must target and comment upon the original work in order to be considered a fair use, the Court tempered its position in a footnote:

A parody that more loosely targets an original than the parody presented here may still be sufficiently aimed at an original work to come within our analysis of parody. If a

parody whose wide dissemination in the market runs the risk of serving as a substitute for the original or licensed derivatives . . . , it is more incumbent on one claiming fair use to establish the extent of transformation and the parody's critical relationship to the original. By contrast, when there is little or no risk of market substitution, whether because of the large extent of transformation of the original work, the new work's minimal distribution in the market, the small extent to which it borrows from the original, or other factors, taking parodic aim at an original is a less critical factor in the analysis, and looser forms of parody may be found to be fair use, as may satire with lesser justification for the borrowing than would otherwise be required.

Id. at 581 n.14.

Footnote 14 clarifies the Court's position regarding parody versus satire, and reemphasizes the fact that a proper fair use analysis considers and weighs all of the § 107 factors (and potentially others). The Court underscored this point, noting that "parody, like any other use, has to work its way through the relevant [fair use] factors, and be judged case by case, in light of the ends of copyright law." *Id.* at 581. Therefore, even satire that does not target the original work can be considered fair use if, for instance, there is little possibility that consumers would view the satire as a commercial substitute (§ 107(4)), or if only a small amount of the copyrighted work was used (§ 107(3)).

C. Recent Cases Expose the Problems of the Parody/Satire Dichotomy

Although the Court in *Campbell* employed a flexible test that weighed the work's parodic character (i.e., the extent to which it commented on the original work) along with the other factors in determining fair use, many subsequent courts have been transfixed by the apparent dichotomy in *Campbell* between parody and satire. The dichotomy approach is certainly easier to apply: if the new work arguably criticized or commented on the original, a parodic character reasonably can be perceived (the *Campbell* Court noted that this was the threshold inquiry in any parody fair use case), the other factors concurrently become less important, and a fair use finding is quick to follow. On the other hand, if the new work used the original work as a mere vehicle to criticize something else (such as society in general), it is satire, not parody, and therefore not fair use. However, while the parody/satire distinction has become the central issue in many cases, the proper dividing line between quintessential parody and satire is blurry at best. Creative lawyers and judges have taken advantage of this blurriness in arguing for (or against) the parodic character of works.

1. The dichotomy is artificial

- a. Some parodies have satiric components, some satires have parodic components

As several commentators have observed, often works resist simple classification. *See, e.g.,* Annemarie Bridy, *Sheep in Goats' Clothing: Satire and Fair Use After Campbell v. Acuff-Rose Music, Inc.*, 51 J. COPYRIGHT SOC'Y U.S.A. 257, 274–78 (2004); Bruce P. Keller & Rebecca Tushnet, *Even More Parodic Than the Real Thing: Parody Lawsuits Revisited*, 94 TRADEMARK REP. 979, 985 (2004); Tyler T. Ochoa, *Dr. Seuss, the Juice and Fair Use: How the Grinch Silenced a Parody*, 45 J. COPYRIGHT SOC'Y U.S.A. 546, 557 (1998). Many works employ previous works to both criticize the work itself and myriad external matters.

The Court in *Campbell* recognized the hybrid nature of many works, which led it to conclude that the fair use factors vary in importance depending upon the level of commentary on the original work. *See Campbell*, 510 U.S. at 581. However, several courts have instead created the bright line that *Campbell* carefully avoided: a work is either parody or satire, and this conclusion determines its fair use fate.

For recent cases illustrating the blurred line between parody and satire, see, for example:

- ◆ *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1265, 1269 (11th Cir. 2001) (upholding the parody defense for a book entitled *The Wind Done Gone* against a copyright infringement claim brought by the owner of *Gone With the Wind*, finding that the new work was a specific criticism of the depiction of slavery and relationships between blacks and whites in *Gone With the Wind*);
- ◆ *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997) (discounting the defendants' argument that its book about the O.J. Simpson case parodied the original Dr. Seuss works, and holding that the work broadly mimicked Dr. Seuss's characteristic style to simply retell the Simpson tale);
- ◆ *MasterCard Int'l Inc. v. Nader 2000 Primary Comm.*, No. 00 Civ. 6068, 2004 WL 434404, at *13 (S.D.N.Y. Mar. 8, 2004) (citing footnote 14 in *Campbell* and concluding that a parodic character could "reasonably be perceived" when Ralph Nader's presidential campaign created an advertisement using MasterCard's famous "there are some

things money can buy, for everything else there's MasterCard" and "priceless" slogans).

- b. Copyright owners are not necessarily averse to licensing parodies, while quick to license a satiric social commentary

One explanation rooted in the First Amendment for the disparate treatment of parody versus satire is that while a copyright owner might be understandably wary of licensing a criticism or ridicule of his own work (a parody), he might be willing to license his work as a vehicle for broader social comment. *See Campbell*, 510 U.S. at 592 (“[T]here is no protectible derivative market for criticism. The market for potential derivative uses includes only those that creators of original works would in general develop or license others to develop.”). Put another way (and more closely referencing factor four in the fair use analysis), while a scathing parody may destroy the market for the original work, its destruction stems from criticism, not usurpation by acting as a substitute. In addition, even if a copyright owner refuses to license a satirical use of the work, it is arguable that a pure satire still should not be considered a fair use, considering a satire benefits from the popularity of the original work and is more likely to act as a market substitute.

Conversely, assertions that copyright holders generally abhor parodies and authorize satires may be more aptly characterized as assumptions. Indeed, commentators have noted that “[t]he fundamental premise that copyright owners will not create or license parodies of their works is belied by market evidence.” Keller & Tushnet, *supra*, at 995–96. The authors detailed several examples of copyright owners licensing parodies of their works, including numerous artists granting “Weird Al” Yankovic a license to parody original songs, and Dimension Films creating the parody film *Scary Movie* based upon another Dimension Films movie, *Scream*. *See id.* at 996–97.

Likewise, if a copyright holder is able to short circuit all satirical opinions he disagrees with, the fair use focus on stimulating creativity may be frustrated. Additionally, because broad social criticism is arguably more valuable than parodic criticism of an individual work, satire may have a strong claim to fulfilling the role fair use was intended to play. *See Ochoa*, *supra*, at 611–12.

Since some copyright holders license parodies and reject satires, pegging the fourth fair use factor to whether a work is a parody or satire seems incomplete.

2. Courts should not pass judgment on the literary meaning and aesthetics of a work

Justice Holmes famously noted in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903): “It would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of [a work], outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke.” While the Court in *Campbell* cited Holmes to illustrate the difference between courts’ permissible analysis of the parodic character of a work versus an impermissible evaluation of the quality of a work, it is arguable that courts inevitably assess the creative underpinnings of a work in determining whether a work criticizes or comments on the original work. *See Campbell*, 510 U.S. at 582. The chilling effects of judges as final arbiters of the literary meaning of a work might be lessened if they carefully follow the guidance in *Campbell* to determine only whether a parodic character may be *reasonably* perceived. *See id.* Under this framework, a “reasonably perceived” parody that predominantly criticizes matters external to the original work itself will be scrutinized more carefully under the other fair use factors. However, if courts insist on characterizing a work as “parody” or “satire,” Justice Holmes’s fear of judges as literary and artistic critics may come to pass.

For a relatively recent case regarding this issue, see:

- ◆ *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403 (9th Cir. 1997) (rejecting the defendants’ argument that its book was both a satire and a parody, and agreeing with the district court that the parody arguments were “pure shtick” and “completely unconvincing”).

3. Dichotomy leads to post-hoc rationalization by attorneys and judges

The most notable effect of the *Campbell* Court’s apparent preference for parody over satire is the corresponding tendency for both lawyers and judges to couch any work it deems a fair use as a parody. Justice Kennedy’s concurrence in *Campbell* predicted this new wave of post-hoc rationalization:

We should not make it easy for musicians to exploit existing works and then later claim that their rendition was a valuable commentary on the original. Almost any revamped version of a familiar composition can be construed as a ‘comment on the naivete of the original,’ . . . because of the difference in style and because it will be

amusing to hear how the old tune sounds in the new genre. Just the thought of a rap version of Beethoven's Fifth Symphony or "Achy Breaky Heart" is bound to make people smile. If we allow any weak transformation to qualify as parody, however, we weaken the protection of copyright. And underprotection of copyright disserves the goals of copyright just as much as overprotection, by reducing the financial incentive to create. . . . As future courts apply our fair use analysis, they must take care to ensure that not just any commercial takeoff is rationalized *post hoc* as a parody.

Campbell, 510 U.S. at 599–600 (Kennedy, J., concurring).

But if the primary focus in a fair use analysis is a plain and rigid determination whether the work is a parody or satire, attorneys would be remiss if they failed to conceive of as many parodic purposes as possible. To be sure, creative attorneys could probably find some commentary between any two works picked at random. *See* MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05[C][2] (2005).

For recent cases arguably involving post-hoc rationalizations of parodies, see:

- ◆ *MasterCard Int'l Inc. v. Nader 2000 Primary Comm.*, No. 00 Civ. 6068, 2004 WL 434404, at *13 (S.D.N.Y. Mar. 8, 2004) (finding that a parodic character could "reasonably be perceived" when Ralph Nader's presidential campaign created an advertisement using MasterCard's famous "there are some things money can buy, for everything else there's MasterCard" and "priceless" slogans);
- ◆ *Abilene Music, Inc. v. Sony Music Entm't, Inc.*, 320 F. Supp. 2d 84, 89–92 (S.D.N.Y. 2003) (commenting first that the relevant inquiry was not whether rapper Ghostface Killah intended his song as a parody of *Wonderful World* but whether the song differs from the original in a way that may reasonably be perceived as commenting on what a viewer might reasonably think is the unrealistically uplifting message of *Wonderful World*, and consequently holding that Ghostface Killah's song could be perceived as commenting on the innocence reflected in the lyrics of the original, in order to drive home its hard-knock life message more effectively);
- ◆ *World Wrestling Fed'n Entm't, Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413, 426–28 (W.D. Pa. 2003) (concluding that defendant's graphics and shirts depicting dogs with similar names to famous WWE wrestlers and clad in wrestling garb were parodies, since there was evidence of humor, ridicule, and

comment on the over-hyped and pseudo-ferocious world of professional wrestling);

- ◆ *Mattel, Inc. v. Pitt*, 229 F. Supp. 2d 315, 322–23 (S.D.N.Y. 2002) (denying Mattel’s motion for summary judgment and concluding that defendant’s “Dungeon Doll” adaptations of Barbie dolls may be considered parodies where the defended asserted that she was attempting at least in part to comment on “what she perceives as the sexual nature of Barbie through her use of customized Barbie figurines in sadomasochistic costume and/or storylines”);
- ◆ *Lucasfilm Ltd. v. Media Mkt. Group, Ltd.*, 182 F. Supp. 2d 897, 901 (N.D. Cal. 2002) (quoting *Dr. Seuss* and conclusorily noting that *Starballz*, a pornographic animated film based on *Star Wars*, was parody in that it was a “literary or artistic work that broadly mimics an author’s characteristic style and holds it up to ridicule”).

One case that merits additional discussion is the *MasterCard* case. Citing footnote 14 in *Campbell*, the court stressed an interrelationship between the fair use factors when examining an alleged parody. If there is little threat that the parody would divert sales from the original work (factor four and arguably others), demonstrating the parody’s critical relationship to the original is less important in the fair use analysis. *See MasterCard Int’l Inc. v. Nader 2000 Primary Comm.*, No. 00 Civ. 6068, 2004 WL 434404, at *13 (S.D.N.Y. Mar. 8, 2004). Ralph Nader and his presidential committee created an advertisement that mirrored MasterCard’s “there are some things money can buy, for everything else there’s MasterCard” advertisements. Nader’s ads displayed various ways in which presidential candidates can be bought by private interests. However, the defendants claimed that their ad also commented on the original MasterCard ads by laying “bare the artifice of the original, which cloaks its materialistic message in warm, sugar-coated imagery that purports to elevate intangible values over the monetary values it in fact hawks’ through parody.” *Id.* at *12.

Despite these parodic contentions, the ads more likely were created to criticize the other presidential candidates rather than the MasterCard ads themselves. That is, Nader’s ads more closely resemble traditional satire than parody. However, the court noted that the threshold inquiry was not whether the work was a parody *or* a satire, but whether a parodic character may reasonably be perceived. *Id.* at *13. Under that analysis, Nader’s ad was sufficiently a parody for fair use analysis, and was consequently transformative under the first fair use factor. *See id.* It must be remembered, though, that fair use did not necessarily follow based on a finding that the ad was a parody. In fact, the court subtly acknowledged that the parodic character of the ad was weak. Nonetheless, the court relied on *Campbell*’s statement that less parodic content is required when

other factors, such as a lack of a commercial purpose and low risk of market substitution, weigh in favor of fair use. Because Nader’s ads were political as opposed to commercial, and because there was little threat of market substitution, using MasterCard’s copyright slogans was deemed a fair use.

II. PARODY VERSUS SATIRE IN TRADEMARK LAW: WHAT IS THE PROPER TEST?

A. Trademark Infringement Cases

Trademark law seeks to prevent confusion among consumers as to the origin, sponsorship, or approval of goods or services. As a result, the central issue in every trademark infringement case is the likelihood of consumer confusion. *See* 15 U.S.C. §§ 1114, 1125. Similar to the fair use doctrine in copyright, the likelihood of confusion test in trademark infringement cases requires a flexible inquiry that analyzes a variety of factors, including freedom of expression concerns in the context of parodies and satires. However, some courts have shifted their focus from the likelihood that a trademark parody or satire will confuse consumers to the familiar parody/dichotomy that has complicated copyright cases. Still other courts have applied different tests to determine whether a parody infringes a trademark.

1. Some recent cases have applied the traditional “likelihood of confusion” test

Many courts have applied the traditional likelihood of confusion test to parodies. Even though parody is not a defense to a claim of trademark infringement, courts have noted in the context of the likelihood of confusion test (either as a separate factor or in relation to the other factors) that a successful parody will rarely be considered infringing, since the ultimate object of a parody is to amuse, not confuse. *See, e.g., Cardtoons, L.C. v. Major League Baseball Players’ Ass’n*, 95 F.3d 959, 967 (10th Cir. 1996). While likelihood of confusion tests differ among jurisdictions, many tests include the following factors:

- a. Strength of the mark;
- b. Similarity of the marks;
- c. Proximity of the goods;
- d. Quality of defendant’s product;
- e. Likelihood that plaintiff will enter the product market of the alleged infringer under the same mark;

- f. Evidence of actual confusion;
- g. Marketing channels used;
- h. Defendant's intent;
- i. Sophistication of buyers.

The parodic or satiric use of trademark should likely inform and influence a court's analysis of the factors when determining whether the use is likely to result in consumer confusion. *See Lyons P'ship v. Giannoulas*, 179 F.3d 384, 390 (5th Cir. 1999). As one example, consider the first factor, the strength of the mark. Generally, a strong mark weighs in favor of a likelihood of confusion. However, in a parody case, "[t]he strength and recognizability of the mark may make it easier for the audience to realize that the use is a parody and a joke on the qualities embodied in [a] trademarked word or image." *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 416 (S.D.N.Y. 2002) (quoting MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:153 (4th ed. 2001)). Because the mark is easily recognizable, consumers will understand the distinction between the parody and the original.

Some courts (especially in the Second Circuit) have taken the further step of balancing the public interest in avoiding consumer confusion against the public interest in free expression. *See, e.g., Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g*, 886 F.2d 490, 494 (2d Cir. 1989); *Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F. Supp. 2d 330 (S.D.N.Y. 2000).

For recent cases applying the likelihood of confusion factors to parodies (or satires), see:

- ◆ *MasterCard Int'l Inc. v. Nader 2000 Primary Comm.*, No. 00 Civ. 6068, 2004 WL 434404, at *4 (S.D.N.Y. Mar. 8, 2004) (balancing the likelihood of confusion factors and concluding that Ralph Nader's political ads did not infringe MasterCard's trademarks);
- ◆ *World Wrestling Fed'n Entm't, Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413, 441 (W.D. Pa. 2003) (evaluating the likelihood of confusion factors and applying First Amendment principles in holding that Big Dog's parodies of WWE were not likely to confuse consumers);
- ◆ *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 415–16, 421 (S.D.N.Y. 2002) (despite first holding that the First Amendment interests balanced in favor of

the plaintiff because the use of Tommy Hilfiger's mark on pet cologne was somewhat non-expressive and commercial, finding no infringement because there was no likelihood of confusion);

2. Some courts have employed a parody/satire distinction similar to copyright cases

Other courts have borrowed *Campbell*'s apparent parody/satire distinction and concluded that parodies are less likely to infringe a trademark than satires. In response, some commentators have argued that reliance on *Campbell* in a likelihood of confusion analysis "tends to obscure the ultimate issue in any [trademark] infringement case: the likelihood of confusion." Keller & Tushnet, *supra*, at 999–1000. In their view, "[i]f a joke is recognizable as a joke, consumers are unlikely to be confused, and whether the butt of the joke is society at large, or the trademark owner in particular, ought not to matter at all." *See id.* at 1000.

For cases in which the apparent *Campbell* parody/satire dichotomy has crept into trademark infringement analysis, see:

- ◆ *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999) (citing *Campbell* and holding that because defendant's mark makes no comment on the Harley-Davidson mark, and "simply uses it somewhat humorously to promote his own products and services," defendant infringed Harley-Davidson's trademark);
- ◆ *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 199–200 (5th Cir. 1998) (citing *Campbell* for that proposition that a trademark parody, like a copyright parody, needs to mimic the original, and concluding that the defendants' "parody" using Elvis Presley marks in its restaurants could not factor against the likelihood of confusion because the use of the marks ridiculed faddish bars of the sixties, not Elvis);
- ◆ *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 415 (S.D.N.Y. 2002) (illustrating an equal opportunity for post-hoc rationalization in the trademark context by noting that a parodic character can be found in the mere juxtaposition of "the irreverent representation of the trademark with the idealized image created by the mark's owner" (citing *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir. 1987)));
- ◆ *See also* 2 JEROME GILSON ET AL., TRADEMARK PROTECTION AND PRACTICE § 5.05[10][c] (2005) (noting that "[s]ome courts appear less likely to enjoin a humorist's use of a mark if it pokes fun at the mark or mark owner, rather than a different topic").

3. Other courts have applied a nominative fair use test

More recently, the Ninth Circuit scrapped the likelihood of confusion test altogether and instead employed the doctrine of nominative fair use in determining that a photographer's parodic use of Barbie's trade dress was non-infringing. *See Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003). Nominative fair use occurs when a defendant uses the plaintiff's trademarks or trade dress to describe or identify the plaintiff's product, even if the ultimate goal is to describe defendant's own product. *See id.* at 809–810.

Defendants must satisfy three criteria to qualify for nominative fair use:

First, the plaintiff's product or service in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the plaintiff's product or service; and third, the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.

Id. at 810 (quoting *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1151 (9th Cir. 2002)).

The third factor alludes, arguably, to a likelihood of confusion analysis. The court concluded that the defendant satisfied all three elements, and therefore his use of Barbie trademarks in his photographs depicting Barbie in “absurd and often sexualized positions” was a fair use. *See id.* at 812. It is unclear whether the nominative fair use defense will be applied in other jurisdictions, but it at least provides a narrow but potential “shortcut” for parody or satire defendants in addition to the traditional likelihood of confusion test. *See Keller & Tushnet, supra*, at 1008.

4. Still other courts have applied a special rule for titles of artistic works

Relying on line of cases providing special First Amendment protection for titles of artistic works, the Ninth Circuit concluded that the use of “Barbie” in a song title was not trademark infringement. Adopting the rule originally outlined in *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989), the court noted that literary titles do not violate trademark law “‘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.’” *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002). The second factor again alludes, at least in part, to a likelihood of confusion analysis, but the court in *Mattel* did not apply the relevant factors.

As applied to the song “Barbie Girl,” the court first concluded that the use of mark “Barbie” in the title clearly was relevant to the song, since the song comments on Barbie and the values she represents. *See id.* Moreover, without applying any likelihood of confusion factor, the court concluded that the song title did not suggest that it was produced by Mattel, and therefore did not explicitly mislead as to source.

Upon first glance, this approach seems to treat both parodies and satires quite favorably (at least their use of marks in titles, if not more): the standard does not consider whether use of the mark was *necessary* for the parody, but simply whether the title has *any* artistic relevance to the underlying work whatsoever. *See* 2 GILSON ET AL., *supra*, § 5.05[10][b][2]. Thus, while satires differ from parodies in that underlying work is not absolutely necessary for satiric commentary, clearly even most satires can claim some artistic relevance to the underlying work.

However, the court in *Mattel* suggested that it would be much more difficult for satires to claim “artistic relevance” to the underlying work by reasoning that “Barbie Girl” was much different than the *Dr. Seuss* case. While “Barbie Girl” used the Barbie mark to target Barbie herself, the use of the Dr. Seuss marks had no critical bearing on the substance or style of *The Cat in the Hat!*. *See Mattel*, 296 F.3d at 901. Put another way, “Barbie Girl” was a parody, while *The Cat NOT in the Hat!* was satire.

Thus, belying the plain language of the rule, the parody/satire dichotomy may arise in the context of this rule.

For another recent Ninth Circuit case applying this rule, see:

- ◆ *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806–07 (9th Cir. 2003) (applying the *Rogers* test and concluding that the public interest in free and artistic expression outweighed the public interest in potential consumer confusion about Mattel’s sponsorship of the defendant’s photographs with the Barbie mark included in the titles).

B. Trademark Dilution Cases

In the absence of a likelihood that consumers will be confused as to source or sponsorship, anti-dilution laws provide an additional avenue for trademark protection against parodies or satires. However, the dichotomy between parodies and satires is not as apparent in the dilution context. Dilution results from the “lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of—(1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception.” 15 U.S.C. § 1127. As the statutory definition suggests, unlike trademark infringement, trademark dilution occurs when consumers are not

confused about the source or sponsorship of a product. Traditionally, courts have recognized two types of dilution: blurring, which involves the “whittling away of an established trademark’s selling power and value through its unauthorized use by others upon dissimilar products,” 2 GILSON ET AL., *supra*, § 5A.01[5][a] (quoting *Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1031 (2d Cir. 1989)), and tarnishment, which occurs “when a famous trademark is linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context.” *Id.* § 5A.01[6]. (However, it must be noted that the Supreme Court’s decision in *Moseley v. V Secret Catalogue, Inc.* “cast serious doubt on the viability of tarnishment claims under the Federal Trademark Dilution Act.” See 537 U.S. 418 (2003); GILSON ET AL., *supra*, § 5A.01[6][b].)

Some courts have employed blurring and tarnishment tests in parody/satire dilution cases, while other courts, mainly in the Ninth Circuit, have concluded that the Federal Trademark Dilution Act does not even apply to parodies or satires.

1. Courts have examined parodies under both blurring and tarnishment theories

a. Dilution by blurring

Several recent cases have noted that parodies will usually not result in blurring (while at least one has found blurring):

- ◆ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 903–04 (9th Cir. 2002) (finding blurring where consumers hearing Barbie’s name may now think of the song “Barbie Girl” in addition to the doll, or potentially of the song only) (the court later concluded, however, that use of the Barbie mark in the song was noncommercial and therefore exempted from the Dilution Act);
- ◆ *World Wrestling Fed’n Entm’t, Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413, 441–42 (W.D. Pa. 2003) (citing both *Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497 (2d Cir. 1996), and *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987), and holding that Big Dog’s parody products were more apt to increase, rather than blur, public identification of WWE’s marks with WWE);
- ◆ *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 421–22 (S.D.N.Y. 2002) (concluding that defendant’s parody of Tommy Hilfiger cologne for its pet cologne was not likely to impair the identification of the Tommy Hilfiger marks with its products, reasoning that the

defendant's parody actually tends to increase public identification of the Hilfiger mark with Hilfiger).

b. Dilution by tarnishment

Recent cases have also assessed the possibility of tarnishment by parody or satire.

- ◆ *World Wrestling Fed'n Entm't, Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413, 442–43 (W.D. Pa. 2003) (citing *Hormel Foods* for the proposition that the “*sine qua non* of tarnishment is a finding that the plaintiff's mark will suffer negative associations through defendant's use,” and finding no tarnishment, since the Big Dog graphics were humorous and generally family-friendly, and consequently unlikely to create a negative association with WWE's marks);
- ◆ *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 422–23 (S.D.N.Y. 2002) (citing precedent and holding that no rational jury could find tarnishment when there is nothing to suggest that the Tommy Hilfiger label has anything to lose from mere association with pets, particularly where the association is a light-hearted parody);
- ◆ *Kraft Food Holdings, Inc. v. Helm*, 205 F. Supp. 2d 942, 949–50, 953 (N.D. Ill. 2002) (finding that defendant's use of the mark “VelVeeda” in connection with sexually explicit website likely tarnished the famous Velveeta mark, while also concluding that “VelVeeda” was not a parody of Kraft cheese products).

2. Other courts have concluded that parodies fall within the Federal Anti-Dilution Act's “noncommercial use” exception

The Federal Trademark Dilution Act provides an important exception for “[n]oncommercial use of a mark.” See 15 U.S.C. § 1125(c)(4)(B). The exception inhibits courts from enjoining constitutionally protected speech. Following First Amendment precedent, expressive works may be considered “noncommercial” even though they have a commercial purpose. “Thus, for example, the use of famous marks in non-commercial settings, such as parodies, consumer product reviews, and news and investigative reports, would not be actionable.” 2 GILSON ET AL., *supra*, § 5A.01[9][b]. Parodies, consumer product reviews, and news reports all arguably contain a commercial component, but can still be considered “noncommercial speech.” The legislative history to the Act's counterpart

bill includes a comment from then-chairman of the Senate Judiciary Committee Orrin Hatch, who remarked, “[t]he bill will not prohibit or threaten noncommercial expression, such as parody, satire, editorial and other forms of expression that are not a part of a commercial transaction.” *See id.* (quoting 141 CONG. REC. S19306, 19310 (daily ed. Dec. 29, 1995) (statement of Sen. Hatch)). Political speech may also fall within the Act’s noncommercial use exception. *See id.*

Recent cases (especially in the Ninth Circuit) have applied the noncommercial exception in striking down Dilution Act challenges to parodies (and satires):

- ◆ *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 812 (9th Cir. 2003) (holding that the defendant artist’s photographs containing Barbie were artistic and parodic works and therefore noncommercial speech not subject to a trademark dilution claim);
- ◆ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 904–07 (9th Cir. 2002) (describing noncommercial use as a statutory “exemption” and concluding that while the defendant used the Barbie mark to sell copies of the “Barbie Girl” song, the song also ridicules the Barbie image and comments on the cultural values that Barbie represents, and therefore use of the Barbie mark was “exempted” from the Dilution Act);
- ◆ *MasterCard Int’l Inc. v. Nader 2000 Primary Comm.*, No. 00 Civ. 6068, 2004 WL 434404, at *9 (S.D.N.Y. Mar. 8, 2004) (“Ralph Nader’s use of [MasterCard]’s trademarks is not commercial, but instead political in nature and . . . therefore, it is exempted from coverage by the Federal Trademark Dilution Act.”);
- ◆ *Lucasfilm Ltd. v. Media Mkt. Group, Ltd.*, 182 F. Supp. 2d 897, 901 (N.D. Cal. 2002) (commenting both that an expressive use of a mark is not rendered commercial by the impact of the use on sales, and that “[p]arody is a form of non-commercial, protected speech which is not affected by the Federal Trademark Dilution Act”);
- ◆ *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1574 (S.D. Cal. 1996), *aff’d*, 109 F.3d 1394 (9th Cir. 1997) (despite first concluding that the majority of the defendants’ book was not parody because it did not comment on Dr. Seuss’s original works, holding that defendants’ use of Dr. Seuss’s marks was exempt from the reach of the Federal Trademark Dilution Act by way of the noncommercial use exception).

III. DISCUSSION POINTS

- A. Which is the correct test to apply in trademark infringement cases? Should trademark infringement inquiries explicitly consider the parody/satire dichotomy?
- B. During the 2004 presidential campaign, the website JibJab created an animated video poking fun at George W. Bush and John Kerry, set to the familiar tune of Woody Guthrie's "This Land." Unlike most people who watched the short, the purported owners of Guthrie's copyright were not amused, claiming copyright infringement. JibJab countered that it merely parodied Guthrie's song by undermining the unifying message of the original. However, it is also easy to argue that JibJab used the song for satiric purposes, namely, to criticize the candidates, and "This Land" was chosen simply because it was familiar and catchy. Was this song a parody or a satire, or both? How should that influence a fair use determination? What effect does the fact that JibJab was commenting on politics have on the fair use determination?
- C. Does equal treatment of satire and parodies necessarily support the goals of copyright and trademark law? Put another way, should a parody/satire dichotomy exist, no matter what *Campbell* suggests is the proper inquiry?