

IP *Litigator*

DEVOTED TO
INTELLECTUAL
PROPERTY
LITIGATION &
ENFORCEMENT

*Edited by the Law Firm of
Grimes & Battersby*

But It's a Joke! Balancing the Interests of Parodists Against Copyright and Trademark Owners Without Clear Guidelines

David Halberstadter

*David Halberstadter is a partner at Katten
Muchin Zavis Rosenman in Los Angeles, CA. An
earlier version of this article appeared in the
December 28, 2001, edition of the Los Angeles
Daily Journal.*

In his 1928 novel *Point Counter Point*, Aldous Huxley observed that "parodies and caricatures are the most penetrating of criticisms." The essence of a parody is that it imitates the characteristic style of an author or a work for comic effect or ridicule. Its effectiveness depends on its ability to make the object of its criticism recognizable to the audience. Most parodies therefore quote or distort the original work's memorable features.

Most contemporary works enjoy protections against unauthorized copying. Even the copyright law recognizes, however, that certain unauthorized uses of copyrighted works may be considered "fair." Section 107 of the Copyright Act provides that "the fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research, is not an infringement of copyright." The

statute enumerates four nonexclusive factors to be considered in determining fair use: "(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 on the potential market for or value of the copyrighted work." Parody is generally considered a fair use, provided it meets the statutory test.

Similarly, most companies' distinctive trademarks and logos enjoy protections against unauthorized uses by others, particularly competitors. The Lanham Act prevents one company from using the trademark or logo of another company if that use will create a likelihood of consumer confusion as to the source, sponsorship, or endorsement of its goods or services.¹

Unlike copyright law, there is no "parody" defense to trademark infringement or dilution. Rather, the manner and extent to which a trademark allegedly is parodied and the context in which the parody appears will be factors considered in assessing whether there is a likelihood of consumer confusion.

Under both copyright and trademark law, the determination of whether the use of another's intellectual property constitutes an infringement or a permissible parody is extremely fact specific. So, how can an author of humorous commentary be sure that his work will, in fact, be treated as a parody rather than an infringement of another's copyright or trademark? How does a legitimate parodist know whether she has copied a permissible amount of her target's work, or too much?

It appears that the parodist cannot know for certain until a court provides the answer. Whether the work will be considered a permissible parody or unlawful infringement may well depend on which court is asked the question to begin with. As a result, a parodist has no meaningful way to predict whether his work will result in costly litigation or even potential liability.

"Tomorrow Is Another Day"

A case in point is the recent litigation over the novel *The Wind Done Gone*, written by Alice Randall and published by Houghton Mifflin Company. In essence, *The Wind Done Gone* chronicles the diary of a woman who is portrayed as the illegitimate half-sister of Scarlett O'Hara, the fictional protagonist of the Margaret Mitchell classic *Gone With the Wind*. In order to critique *Gone With the Wind*'s depictions of slavery and the Civil War-era American South, *The Wind Done Gone* made liberal use of the core characters, relationships, and pivotal scenes from *Gone With the Wind*. The author considered these uses necessary to parody the original work; the copyright owners of *Gone With the Wind* considered the new work an unauthorized sequel and a blatant infringement.

In granting the plaintiffs' requests for a temporary restraining order and preliminary injunction, the district court rejected the defendant's claim of parody.² It found that *The Wind Done Gone* took "the characters, character traits, scenes, settings, physical descriptions, and plot" directly from *Gone With the Wind*. The court characterized the use of these elements from *Gone With the Wind* as "unabated piracy" and the quantity of the taking "overwhelming."

But, as Scarlett O'Hara said, "tomorrow is another day." On appeal, the Eleventh Circuit disagreed completely.³ It dissolved the preliminary injunction, finding that the parodic character of *The Wind Done Gone* was clear. In its view, the novel was "principally and purposefully a critical statement that seeks to rebut and destroy the perspective, judgments, and mythology of [*Gone With the Wind*]." The fact that the novel was published for profit was outweighed by its "highly transformative" use of *Gone With the Wind*'s protected elements, and the court was not prepared to conclude that *The Wind Done Gone* copied more than was reasonable.⁴ So Alice Randall's novel was

transformed from an "unabated piracy" into a legitimate parody.

It's a Rap

This was hardly the first time that federal courts had flip-flopped on a finding of parody. In the seminal decision of the last decade, the courts were asked to determine whether the rap song *Pretty Woman* by the group 2 Live Crew constituted a parody or an infringement of Roy Orbison's rock ballad *Oh, Pretty Woman*.⁵ The district court granted summary judgment in 2 Live Crew's favor.⁶ It reasoned that the commercial purpose of 2 Live Crew's song was no bar to fair use, and that 2 Live Crew's version was a parody that "quickly degenerates into a play on words, substituting predictable lyrics with shocking ones" to show "how bland and banal the Orbison song" is. The district court also concluded that 2 Live Crew had taken no more than was necessary to "conjure up" the original in order to parody it, and that it was "extremely unlikely that 2 Live Crew's song could adversely affect the market for the original."⁷

The Sixth Circuit reversed.⁸ Although it assumed for the purpose of its opinion that 2 Live Crew's song was a parody of the Orbison original, the Court of Appeals thought the district court had put too little emphasis on "the admittedly commercial nature" of the parody. In the appellate court's view, the commercial nature of the parody required the conclusion that the first of the four statutory "fair use" factors (*i.e.*, the purpose and character of the use) weighed against a finding of fair use.⁹ The Court of Appeals also held that, by "taking the heart of the original and making it the heart of a new work," 2 Live Crew had qualitatively taken too much.¹⁰ Finally, the Sixth Circuit concluded that "harm for purposes of the fair use analysis has been established by the presumption attaching to commercial uses." Ultimately, the court concluded that the "blatantly commercial purpose" of 2 Live Crew's song "prevents this parody from being a fair use."¹¹

The Supreme Court then reversed the Sixth Circuit's decision, concluding that the commercial nature of a parody did not create a presumption against fair use and that the Sixth Circuit had not given sufficient consideration to all of the relevant fair use factors.¹² The court observed that "the heart of any parodist's claim to quote from existing material 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." If, however, "the commentary 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 claim to fairness in borrowing . . . diminishes accordingly (if it does not vanish)." The Supreme Court distinguished between legitimate parody, which "needs to mimic an original

to make its point, and so has some claim to use the creation of its victim's (or collective victims') imagination," and pure satire, which "can stand on its own two feet and so requires justification for the very act of borrowing."¹³

Highlighting the problem confronted by every parodist, the Supreme Court observed that "the fair use enquiry often requires close questions of judgment as to the extent of permissible borrowing in cases involving parodies." The task of determining what uses of a copyrighted work are fair uses "is not to be simplified with bright-line rules, for the statute, like the doctrine it recognizes, calls for case-by-case analysis."¹⁴ And, "the fact that parody can claim legitimacy for some appropriation does not, of course, tell either parodist or judge much about where to draw the line."¹⁵

Not surprisingly, lower court rulings following *Campbell* have been almost completely unpredictable, with one court rejecting a parody/fair use defense on facts from which another court might well have drawn the opposite conclusion. Four cases involving parodic advertisements illustrate this point.

Beer, Bond, Botticelli, and (Men In) Black

In *Anheuser-Busch, Inc. v. Balducci Publications*,¹⁶ the beer distributor sued the publisher of the humor magazine *Snicker* because of a fictitious advertisement for "Michelob Oily" that appeared on the back cover of one issue. The mock ad stated in bold type, "ONE TASTE AND YOU'LL DRINK IT OILY"—a take-off on Anheuser-Busch's trademarked phrase "ONE TASTE AND YOU'LL DRINK IT DRY." The accompanying graphics included a partially-obscured can of Michelob Dry pouring oil onto a fish, an oil-soaked rendition of Anheuser-Busch's trademarked "A & Eagle" design (with the eagle exclaiming "Yuck!") below a Shell Oil symbol, and various "Michelob Oily" products bearing a distinct resemblance to actual Michelob products. In smaller text the ad opined, "At the rate it's being dumped into our oceans, lakes and rivers, you'll drink it oily sooner or later, anyway." And a disclaimer in extremely small text ran vertically along the side of the page and stated: "Snicker Magazine Editorial by Rich Balducci. . . . Thank goodness someone still cares about quality (of life)."¹⁷

Claiming both that the advertisement was likely to create consumer confusion and that it tarnished the Michelob brand and related marks, Anheuser-Busch asserted claims of trademark infringement and dilution, among others. Balducci claimed that the fake advertisement was a parody that commented on the effects of environmental pollution, including a specific reference to the then-recent Shell oil spill in the Gasconade River, which was a source of Anheuser-Busch's water supply.¹⁸ The district court granted

summary judgment in favor of the publisher, finding that the advertisement was clearly a parody, and that Balducci's "use of [the] marks did not create a likelihood of confusion in the marketplace."¹⁹

But the Eighth Circuit reversed this decision, finding that Balducci had "if not an intent to confuse, at least an indifference to the possibility that some consumers might be misled by the parody." In its view, "no significant steps were taken to remind readers that they were viewing a parody and not an advertisement sponsored or approved by Anheuser-Busch," and Balducci had "carefully designed the fictitious ad to appear as authentic as possible."²⁰

Combined with the fact that several of Anheuser-Busch's marks were used with little or no alteration and that the disclaimer, in the Court of Appeals' view, was "virtually undetectable," the Eighth Circuit concluded that the ad parody was likely to confuse consumers as to its origin, sponsorship or approval. It found that this confusion was:

wholly unnecessary to Balducci's stated purpose. By using an obvious disclaimer, positioning the parody in a less-confusing location, altering the protected marks in a meaningful way, or doing some collection of the above, Balducci could have conveyed its message with substantially less risk of consumer confusion.²¹

In *Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co., Inc.*,²² the district court assessed whether a Honda commercial that was evocative of various James Bond films constituted permissible parody or copyright infringement. The commercial featured a young, well-dressed couple in a Honda del Sol being chased by a high-tech helicopter. A grotesque villain with metal-encased arms jumps out of the helicopter onto the car's roof, threatening harm. With a flirtatious turn to his companion, the male driver deftly releases the Honda's detachable roof, sending the villain into space and effecting the couple's speedy getaway.²³

The district court rejected Honda's defense that the commercial was a parody on the action film genre, noting that the Supreme Court in *Campbell* had specifically opined that "[t]he use . . . of a copyrighted work to advertise a product, even in parody, will be entitled to less indulgence . . . than the sale of the parody for its own sake." It ruled that all of the "fair use" factors—the purpose and character of the use, the nature of the allegedly infringed works, the amount and substantiality of the portion used, and the effect of the use on the value of the copyrighted work—all weighed against a finding of fair use.²⁴

By contrast, in *Paramount Pictures v. Leibovitz*,²⁵ the Second Circuit treated as permissible parody a commercial poster for the film *Naked Gun 33 1/3*, in which Leslie Nielsen posed like pregnant Demi Moore on a notorious cover of *Vanity Fair* magazine. In the cover photograph, which was taken by noted

photographer Anne Leibovitz, Moore was depicted nude, in profile, with her right hand and arm covering her breasts and her left hand supporting her distended stomach—a well known pose evocative of Botticelli's *Birth of Venus*. A ring adorns the middle finger of Moore's right hand. Her facial expression is serious, without a trace of a smile.

In creating the poster for *Naked Gun 33 1/3*, great effort was made to ensure that the photograph resembled in meticulous detail the one taken by Leibovitz. But the final step was to superimpose on the model's body a photograph of Nielsen's face, with his jaw and eyes positioned roughly at the same angle as Moore's, but with her serious look replaced by Nielsen's mischievous smirk.²⁶

The appellate court found that the advertisement qualified as a "transformative" work that at least arguably commented on the seriousness, even the pretentiousness, of the original photograph. The Second Circuit acknowledged that simply:

[b]eing different from an original does not inevitably "comment" on the original. Nevertheless, the ad is not merely different; it differs in a way that may reasonably be perceived as commenting, through ridicule, on what a viewer might reasonably think is the undue self-importance conveyed by the subject of the Leibovitz photograph. A photographer posing a well known actress in a manner that calls to mind a well known painting must expect, or at least tolerate, a parodist's deflating ridicule.

Apart from ridiculing the photograph's pretentiousness, the court also found that "the ad might also be reasonably perceived as interpreting the Leibovitz photograph to extol the beauty of the pregnant female body and, rather unchivalrously, to express disagreement with this message."²⁷

Yet in another case involving a movie advertisements, *Columbia Pictures Industries, Inc. v. Miramax Films Corp.*,²⁸ a district court rejected a claim by the producers of the documentary film *The Big One* that its poster was a parody of the poster for the film *Men In Black*. *The Big One* sought to expose the consequences of corporate America's focus on profits. Its advertisements mimicked in content and style the posters for *Men In Black* by incorporating certain distinctive elements, such as figures with a particular stance carrying large weapons, standing in front of the New York skyline at night, with a similar layout.²⁹

The court observed that *The Big One's* ads did not constitute "transformative works" because they could not "reasonably be perceived as commenting on or criticizing the ads for *Men In Black*." To the contrary, the advertisements appeared "to be little more than an effort to 'get attention' for *The Big One* and 'avoid the drudgery in working up something fresh.'"³⁰

"The Juice" and "The King"

Disputes involving humorous depictions of celebrities have likewise produced different results. *Cardtoons, L.C. v. Major League Players Association*³¹ involved the sale of mock baseball trading cards featuring caricatures of major league baseball players on the front and humorous commentary about their careers on the back. A person reasonably familiar with baseball could readily identify the players lampooned on the parody trading cards, which ridiculed those players using a variety of themes. Certain of the cards, including one featuring a player named "Treasury Bonds" (an obvious reference to Barry Bonds), humorously criticized players for their substantial salaries. Others mocked the players' narcissism, like the card featuring "Egotisticky Henderson" of the "Pathetics" (a parody of Ricky Henderson, then of the Oakland Athletics). The remainder of the cards simply poked fun at things such as the players' names (e.g., "Chili Dog Davis," who "plays the game with relish," a parody of designated hitter Chili Davis), physical characteristics (e.g., "Cloud Johnson," a parody of six-foot-ten-inch pitcher Randy Johnson) and on-field behavior (e.g., a backflipping "Ozzie Myth," a parody of shortstop Ozzie Smith).³²

The district court initially referred the case to a magistrate, who found in favor of the Players Association, ruling that the parody cards infringed on the Players Association's members' rights of publicity and that, under either a trademark balancing test or a copyright fair use test, Cardtoons did not have the right to market its cards without a license. The district court initially adopted the magistrate's recommendations,³³ but then reversed itself.³⁴ In its second opinion, the district court rejected application of a trademark balancing test and instead applied a copyright fair use analysis. Unlike the magistrate, however, the court held that a fair use analysis requires recognition of a parody exception to the Oklahoma publicity rights statute, and issued a declaratory judgment in favor of Cardtoons.

On appeal, the Tenth Circuit accorded the card producers full First Amendment protection. It found that the cards:

provide social commentary on public figures, major league baseball players, who are involved in a significant commercial enterprise, major league baseball. While not core political speech (the cards do not, for example, adopt a position on the Ken Griffey, Jr., for President campaign), this type of commentary on an important social institution constitutes protected expression. . . . The cards are no less protected because they provide humorous rather than serious commentary.³⁵

But in *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*,³⁶ the Ninth Circuit rejected a claim of par-

ody for a poetic account of the O.J. Simpson double murder trial entitled *The Cat NOT in the Hat! A Parody by Dr. Juice*. This commentary on the highly-publicized trial was told in the distinctive style of Dr. Seuss' *The Cat in the Hat*. The new poem mimicked Dr. Seuss' style but did not "hold his style up to ridicule."³⁷ In essence, O.J. Simpson, not Dr. Seuss or his works, was the "butt of the joke."

The Ninth Circuit noted that to qualify as a protected parody, a satire "need not be only of the copied work and may . . . also be a parody of modern society." But "the copied work must be, at least in part, an object of the parody, otherwise there would be no need to conjure up the original work." Because the poem had "no critical bearing on the substance or style" of *The Cat in the Hat*, the author's use of the Cat's distinctive stove-pipe hat, the narrator ("Dr. Juice") and the title constituted an unprotected infringement, not a legitimate parody.³⁸

In *Elvis Presley Enterprises v. Capece*,³⁹ a restaurant owner was prevented from operating a restaurant/bar called "The Velvet Elvis," in which references to Elvis Presley permeated the establishment's decor and menu. Its decor included velvet paintings of celebrities, including ones of Elvis. Other "eclectic" decorations included lava lamps, cheap ceramic sculptures, beaded curtains, and vinyl furniture. In addition to the velvet paintings of Elvis, the bar's menu included "Love Me Blenders," a type of frozen drink; peanut butter and banana sandwiches, a favorite of Elvis; and "Your Football Hound Dog," a hotdog.⁴⁰

Elvis Presley Enterprises claimed that these references constituted unfair competition, trademark infringement, trademark dilution, and a violation of its state law right of publicity in Elvis' name and likeness. The restaurant owner claimed it was his intention to parody "the Las Vegas lounge scene, the velvet painting craze and perhaps indirectly, the country's fascination with Elvis."

The district court agreed, finding in favor of the restaurant owner on all claims except for those relating to the establishment's advertising practices.⁴¹ But the Fifth Circuit reversed the trial court, ruling that Elvis was not a true target of the restaurant's arguable parody, which therefore was not a fair use of the Elvis Presley Enterprises' protected images and marks.⁴²

Barney, Barbie, and Mr. Bill

Challenges to the comedic use of fictional characters have also produced varying results. In *Lyons Partnership v. Giannoulas*,⁴³ the owner of television's "Barney" character challenged the use of a similar-looking dinosaur in a routine performed at sporting events, in which the putative Barney is slapped, stood upon, and otherwise subjected to aggressive physical conduct by the "San Diego Chicken." The creator of the "Barney" character sued for copyright and trade-

mark infringement. But Giannoulas, the creator of the "San Diego Chicken," asserted that his performance was a parody. He considered Barney to be a symbol of "all the inane, banal platitudes that we readily accept and thrust unthinkingly upon our children." His performance was intended to be a "critique of society's acceptance of this ubiquitous and insipid creature." Giannoulas argued that he used the minimum necessary to evoke Barney—a character dressed like Barney and that danced like Barney—but did not incorporate any of Barney's other "friends" into his act, imitate Barney's voice, or perform any of Barney's songs.⁴⁴

The Fifth Circuit concluded that there was no likelihood of consumer confusion over the sponsorship or endorsement of Giannoulas' performance by the owners of the Barney character. The appellate court acknowledged that although "parody is not an affirmative defense to trademark infringement, a parody should be treated differently from other uses that infringe on a trademark." And it found that:

[w]hen, as here, a parody makes a specific, ubiquitous trademark the brunt of its joke, the use of the trademark for satirical purposes affects our analysis of the factors to consider when determining whether the use is likely to result in consumer confusion.⁴⁵

In *Mattel, Inc. v. MCA Record, Inc.*,⁴⁶ the manufacturer of the Barbie doll challenged the release of a song entitled "Barbie Girl" by a Danish band called Aqua, in which a woman and man assume the identities of Barbie and Ken and sing about their "plastic" life. In the song, the female singer (who calls herself Barbie) is "a Barbie girl, in [her] Barbie world." She tells her male counterpart (named Ken), "Life in plastic, it's fantastic. You can brush my hair; undress me everywhere. Imagination, life is your creation." And off they go to "party."⁴⁷

Both the district court and the Ninth Circuit considered the song a legitimate parody. In the Court of Appeals' view, Mattel's Barbie "has been labeled both the ideal American woman and a bimbo. She has survived attacks both psychic (from feminists critical of her fictitious figure) and physical (more than 500 professional makeovers). She remains a symbol of American girlhood, a public figure who graces the aisles of toy stores throughout the country and beyond. With Barbie, Mattel created not just a toy but a cultural icon." But, the court added, "with fame often comes unwanted attention."⁴⁸ In this instance, "the song does not rely on the Barbie mark to poke fun at another subject but targets Barbie herself." It "lampoons the Barbie image and comments humorously on the cultural values Aqua claims she represents."⁴⁹

But in *Williams v. Columbia Broadcasting Systems, Inc.*,⁵⁰ a court rejected a challenge by the owners of a clay figure known as "Mr. Bill" to CBS' broadcast of an animated segment, during an Army-Navy football

game, that spoofed what would happen to a sailor forced to undergo Army basic training. Years ago, Mr. Bill appeared frequently on the television show *Saturday Night Live*, on which it would be subjected to a variety of physical abuses (such as being stepped on, run over, etc.). The segment used a clay figure called "Sailor Bill," who is obliterated in a number of ways intended to be comical. CBS claimed the segment was a parody, but the exploits of Sailor Bill did not poke fun at Mr. Bill; they merely copied his antics to make fun of the claimed inadequacy of Navy training.⁵¹

Even though the court rejected the parody claim because the Navy, not Mr. Bill, was the intended target, it found the use to be fair nonetheless. Evaluating all four of the statutory fair use factors, the court found that the use of Mr. Bill in the Sailor Bill segment was a mix of commercial and non-commercial uses. It was commercial in that CBS stood to reap rewards by higher ratings for the Army/Navy game. But it was also non-commercial in that the segment was produced by an Army infantry division "for fun and with no eye toward financial gain."

While Mr. Bill is a fictional work and therefore deserving of the highest protection against infringing uses, the amount of the use was slight and unlikely to affect the market for the original. As the district court put it, "the twenty-three second spirit message, produced by an army infantry unit, which aired once, poses little danger of competing with or supplanting in the market the widely known and slickly produced Mr. Bill."⁵²

From Spam to Skywalker

Finally, a collection of trademark cases corroborate the difficulties in distinguishing between humorous uses of a registered mark that constitute permissible parody and those which constitute infringement. In *Hormel Foods Corp. v. Jim Henson Productions, Inc.*,⁵³ the maker of Spam luncheon meat sued the well known producer of the Muppets, alleging trademark infringement and dilution caused by Henson's merchandising of a puppet character named "Spa'am." In Henson's film, Spa'am is the high priest of a tribe of wild boars that worships Miss Piggy. Henson obviously was poking a little fun at Hormel's famous luncheon meat by associating it with a humorously wild beast.⁵⁴

Arguably lacking a sense of humor, Hormel characterized Henson's Spa'am character as "evil in porcine form," and expressed concern that even a comic association with "an unclean grotesque boar" might call into question the purity and high quality of its meat product (as though the quality of Spam had never been questioned or joked about before).

Suffice it to say that the Second Circuit rejected Hormel's claims. It found that Henson's use of the

name Spa'am "is simply another in a long line of Muppet lampoons. Moreover, this Muppet brand of humor is widely recognized and enjoyed. Thus, consumers of Henson's merchandise, all of which will display the words 'Muppet Treasure Island,' are likely to see the name 'Spa'am' as the joke it was intended to be." The court concluded that:

the clarity of Henson's parodic intent, the widespread familiarity with Henson's Muppet parodies, and the strength of Hormel's mark, all weigh strongly against the likelihood of confusion as to source or sponsorship between Hormel's mark and the name 'Spa'am.'

Similarly, in *Charles Atlas, Ltd. v. DC Comics, Inc.*,⁵⁵ the seller of the famous body building course sued a comic book publisher for unfair competition and trademark dilution based upon the publisher's parody of the famous Charles Atlas advertisement in which a bully at the beach kicks sand in a skinny man's face, the man takes Atlas' body building course and returns to the beach, earning respect by punching the bully. In a DC Comics issue of *Doom Patrol*, a character has the same experiences as the skinny man in the Atlas ad. But the comic book takes the ad to what the district court characterized as "an absurd conclusion." He becomes a brute and a bully himself, and beats up the woman he was with at the beach, proclaiming "I don't need a tramp like you anymore!"⁵⁶

The district court rejected Atlas' claims, holding that "[t]he Lanham Act is construed narrowly when the unauthorized use of a trademark is made not for identification of product origin but rather for the expressive purposes of comedy, parody, allusion, criticism, news reporting and commentary." The debated comic book unquestionably was an expressive work that offered "a farcical commentary on [Atlas'] implied promises of physical and sexual prowess through use of the Atlas method."⁵⁷

But in *People for the Ethical Treatment of Animals v. Doughney*,⁵⁸ the owner of the service mark "PETA" objected to the registration of the domain name www.peta.org and the creation of a Web site by an organization that called itself "People Eating Tasty Animals." A viewer accessing the Web site would see the title "People Eating Tasty Animals" in large, bold type. Under the title, the viewer would see a statement that the Web site was a "resource for those who enjoy eating meat, wearing fur and leather; hunting, and the fruits of scientific research." The Web site contained links to various meat, fur, leather, hunting, animal research, and other organizations, all of which held views generally antithetical to those of the group People for the Ethical Treatment of Animals.⁵⁹

Doughney claimed that the Web site was a parody of PETA, but the district court disagreed, granting summary judgment in PETA's favor, and the Fourth Circuit affirmed. The Court of Appeals ruled that "a parody must 'convey two simultaneous—and contra-

dictory—messages: that it is the original, but also that it is *not* the original and is instead a parody.” It stated that “to the extent that an alleged parody conveys only the first message, ‘it is not only a poor parody but also vulnerable under trademark law, since the customer will be confused.’” The domain name *www.peta.org* conveyed only the first of these two messages, providing no suggestion of parody by itself. Although the content of the Web site itself made clear that it was not associated with PETA, “this second message was not conveyed simultaneously with the first message, as required to be considered a parody.”⁶⁰

Lastly, in *Lucasfilm Ltd. v. Media Market Group Ltd.*,⁶¹ the owner of the copyrights and trademarks to the *Star Wars* franchise sought to enjoin a distributor of pornographic films from the further distribution of an animated pornographic movie entitled *Starballz*. The district court rejected this request, finding that *Starballz* was a parody of *Star Wars* and, even though parody is not a defense to trademark infringement, its parodic character “is relevant to show that there is little likelihood of confusion between an original mark and a parody of that mark.” The court opined that “no reasonable consumer is likely to be confused between *Star Wars* and *Starballz*, which is labeled as an adult film, is animated, and is rarely sold in the same marketing channels as *Star Wars*. Further, the *Star Wars* films are so famous that it is extremely unlikely that consumers would believe that *Starballz* is associated with *Star Wars* or Lucasfilm. Moreover, because a parody is meant to comment on or criticize an original work, it is unlikely to be confused with the original work.”⁶²

What Is a Parodist to Do?

To recap, a pornographic send-off of *Star Wars*, a boar-like character bearing the name of a trade-

marked luncheon meat, and a comic book that spoofs a famous body building ad were permissible parodies; a bogus advertisement for “Michelob Oily” and a Web site domain name having the same acronym as the animal rights group whose beliefs were mocked on the Web site itself were infringements. The Army could use the Mr. Bill character to ridicule the Navy, but Penguin Books could not use Dr. Seuss’ story to criticize O.J. Simpson.

A musical group could use Mattel’s Barbie doll to mock the values she supposedly represents and the San Diego Chicken could do the same with the Barney character, but a restaurant could not use Elvis’ likeness to lampoon the Las Vegas lounge scene that “The King’s” image conjured up. Honda could not evoke the image of James Bond and the films in which he appeared to sell its automobiles, but a trading card company could use baseball players’ likenesses to sell mock trading cards.

One movie poster that used a humorous re-creation of a famous magazine cover was a parody; a different poster that was a humorous take on a different film’s poster was not. And depending upon which court did the analysis, a rap song and an alternative novel about the *ante bellum* South were either ripoffs or parodic criticisms of the works from which they liberally borrowed.

Given these disparate court decisions, a parodist has no clear guidelines for what will and will not constitute a parody. What will happen if the appropriated work or its author is only one of the intended targets of criticism? Or what if the parody comments generally on the social attitudes and beliefs that are depicted in the copied work? A parodist also cannot know until it is too late whether he made too much use of the targeted work. While the absence of a “bright-line” test ensures a degree of flexibility in determining fair use, it may also chill the very speech the fair use doctrine was intended to protect.

1. 15 U.S.C. § 1114; see also *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979).
2. *Suntrust Bank v. Houghton Mifflin Company*, 136 F. Supp. 2d 1357, 1367 (N.D. Ga. 2001).
3. *Suntrust Bank v. Houghton Mifflin Company*, 268 F.3d 1257, 1270 (11th Cir. 2001).
4. *Id.* at 1274.
5. The by-now famous lyrics of the Roy Orbison ballad include the following:

Pretty Woman, walking down the street, Pretty Woman, the kind I like to meet,
Pretty Woman, I don't believe you, you're not the truth, No one could look as good as you. Mercy.
Pretty Woman, won't you pardon me, Pretty Woman, I couldn't help but see,
Pretty Woman, that you look lovely as can be. Are you lonely just like me?

The 2 Live Crew version includes the following lyrics:

Pretty woman walkin' down the street, Pretty woman girl you look so sweet
Pretty woman you bring me down to that knee, Pretty woman you make me wanna beg please.

Oh, pretty woman.

Big hairy woman you need to shave that stuff, Big hairy woman you know I bet it's tough,
Big hairy woman all that hair it ain't legit, 'Cause you look like 'Cousin It.'
Big hairy woman.

6. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 594–595 (1994).
7. *Id.* at 1154–1155, 1157–1158.
8. *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429 (6th Cir. 1992).
9. *Id.* at 1435, 1437.
10. *Id.* at 1438.
11. *Id.* at 1439.
12. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).
13. *Id.* at 580–581.
14. *Id.* at 577.
15. *Id.* at 581.
16. *Anheuser-Busch, Inc., v. Balducci Publ'ns*, 28 F.3d 769 (8th Cir. 1994).
17. *Id.* at 772.
18. *Id.*
19. *Anheuser-Busch, Inc.*, 814 F. Supp. 791, 793.
20. *Anheuser-Busch, Inc.*, 28 F.3d 769, 774.
21. *Id.* at 776.

-
22. *Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co., Inc.*, 900 F. Supp. 1287 (C.D. Cal. 1995).
23. *Id.* at 1291.
24. *Id.* at 1300–1301.
25. *Paramount Pictures v. Leibovitz*, 137 F.3d 109 (2d Cir. 1998).
26. *Id.* at 111–112.
27. *Id.* at 114–115.
28. *Columbia Pictures Indus., Inc. v. Miramax Films Corp.*, 11 F. Supp. 2d 1179 (C.D. Cal. 1998).
29. *Id.* at 1186.
30. *Id.* at 1188.
31. *Cardtoons, L.C. v. Major League Players Ass'n*, 95 F.3d 959 (10th Cir. 1996).
32. *Id.* at 962963.
33. *Cardtoons, L.C. v. Major League Baseball Players Association*, 838 F.Supp. 1501 (N.D. Okla.1993).
34. *Cardtoons, L.C. v. Major League Baseball Players Association*, 868 F.Supp. 1266 (N.D. Okla.1994).
35. *Cardtoons, L.C. v. Major League Baseball Players Association*, 95 F.3d 959, 969 (10th Cir. 1996).
36. *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997).
37. *Id.* at 1401.
38. *Id.*
39. *Elvis Presley Enters. v. Capece*, 141 F.3d 188 (5th Cir. 1998).
40. *Id.* at 192.
41. *Elvis Presley Enters., Inc. v. Capece*, 950 F. Supp. 783, 792, 795 (S.D. Tex. 1996).
42. *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 200 (5th Cir. 1998).
43. *Lyons P'ship v. Giannoulas*, 179 F.3d 384 (5th Cir. 1999).
44. *Id.* at 386, 388.
45. *Id.* at 390.
46. *Mattel, Inc. v. MCA Record, Inc.*, 296 F.3d 894 (9th Cir. 2002).
47. *Id.* at 901.
48. *Id.* at 898–899.
49. *Id.* at 901.
50. *Williams v. Columbia Broad. Sys., Inc.*, 57 F. Supp. 2d 961 (C.D. Cal. 1999).
51. *Id.* at 968.
52. *Id.* at 970.
53. *Hormel Foods Corp. v. Jim Henson Prod., Inc.*, 73 F.3d 497 (2d Cir. 1996).
54. *Id.* at 501.
55. *Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F. Supp. 2d 330 (S.D.N.Y. 2000).
56. *Id.* at 332.
57. *Id.* at 338.
58. *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359 (4th Cir. 2001).
59. *Id.* at 363.
60. *Id.* at 366.
61. *Lucasfilm Ltd. v. Media Market Group Ltd.*, 182 F. Supp. 2d 897 (N.D. Cal. 2002).
62. *Id.* at 901.

KMZ Rosenman
KATTEN MUCHIN ZAVIS ROSENMAN

Reprinted from *IP Litigator*, Volume 9, Number 3, pages 26–32, with permission from Aspen Publishers, Inc., Gaithersburg, MD 1-800-638-8437 or www.aspenpublishers.com.