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[Scandalous Trademarks: Wanted Dead or Alive?](#)

July 14, 2011 by [Brent Lorentz](#)



On June 15, 2011, the United States District Court for the Southern District of Indiana [put a bullet in](#) Dillinger, LLC's efforts to hold Electronic Arts liable for trademark infringement and unfair competition based on EA's use of the word "Dillinger" in one of its video games. EA is the developer and publisher of [Godfather video games](#) based on the movies and novel by the same name. The games allow players to use weapons identified as the "Dillinger Tommy Gun" (first Godfather game) and the "Modern Dillinger Tommy Gun" (second Godfather game). Dillinger, LLC, the owner of the "Dillinger" mark, alleged that such use constituted trademark infringement. The court held that despite Dillinger, LLC's interest in the Dillinger mark, EA was entitled to use the mark in the manner it had because video games are considered "literary works" in the Second Circuit, and the use of trademarks in literary works can be, under proper circumstances, protected by the First Amendment. Specifically, the use of the mark must: (1) have "artistic relevance" to the work; and (2) not explicitly mislead the public as to the source or content of the work. The Court held that this test was met here.



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The First Amendment ruling, while interesting, was not the most interesting part of the case from my perspective. Instead, I thought of the Lanham Act's prohibition of trademarks which comprise "immoral, deceptive, or scandalous matter." (See [15 U.S.C. §1025\(a\)](#).) The FBI website [succinctly catalogued](#) Dillinger's atrocities:

Dillinger, whose name once dominated the headlines, was a notorious and vicious thief. From September 1933 until July 1934, he and his violent gang terrorized the Midwest, killing 10 men, wounding 7 others, robbing banks and police arsenals, and staging 3 jail breaks—killing a sheriff during one and wounding 2 guards in another.

Sounds pretty immoral and scandalous to me.

A number of articles have been written documenting the fuzzy line for immoral and scandalous matter. (See [here](#) and [here](#).) Consider [Cocaine](#) for soft drinks or Baby Al-Qaeda for infant T-shirts. Some people try to draw the line, but I think it's a hopeless effort. Do you think the "immoral" and "scandalous" line should continue to be drawn?

