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What Is Trademark Parody, Really? Louis Vuitton Puts UPENN in the Fashion Spotlight for a Perfect Case Study

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Fashion brands are again making news in trademark jurisprudence. If the holding in the Louboutin case left you wanting more, we bring you Louis Vuitton v. U.Penn and the irreverent world of trademark parodies.

The University of Pennsylvania Law School recently held its Annual Symposium on Fashion Law on March 20, 2012, hosted by the Penn Intellectual Property Group (PIPG). PIPG is a student run organization at the law school, focused on enhancing interest in intellectual property within the law school, Penn, and Philadelphia communities. They hold events including career panels, academic symposiums, and social events. Each year, PIPG holds a symposium on fashion law, inviting professors and attorneys in the fashion industry to discuss various topics at issue, in the fashion world. The 2012 symposium was focused on three topics, with separate panels and a keynote speaker entitled: (1) "Trademark and the Fast Fashion Phenomenon; (2) "Copyright for the Fashion Design: Evaluating the IDPPPA"; and (3) the Keynote, "Copyright and the Fall Line."

In the weeks leading up to the symposium, PIPG posted flyers throughout the law school, advertising the event. The flyers featured the signature Louis Vuitton print, but altered the famous logo. Instead of the famous "LV," the new logo featured a "TM." Underneath this altered print, the flyers contained the information regarding the date, times, feature speakers, and topics for the symposium.

Fashion Gets Ugly Where There is Parody

On February 29, 2012, Michael Pantalony, Director of North American Civil Enforcement for Louis Vuitton Malletier sent a cease and desist letter to the Dean of Penn's Law School, Michael Fitts, regarding the Fashion Law symposium flyer. Mr. Pantalony wrote, "This egregious action is not only a serious willful infringement and knowingly dilutes the LV Trademark, but also may mislead others into thinking that this type of unlawful activity is somehow 'legal' or constitutes 'fair use' because the Penn Intellectual Property Group is sponsoring a seminar on fashion law and 'must be experts.'"

On March 2, 2012, Robert Firestone, Associate General Counsel for University of Pennsylvania responded to Mr. Pantalony's letter, on behalf of the School and Dean Michael Fitts. The response denies the accusations of infringement and dilution, and supports PIPG's play on the LV mark in their flyer.

Mr. Firestone denies the claims for infringement by explaining that the flyers are not advertising goods being sold in interstate commerce, there is no likelihood of confusion, and Louis Vuitton's trademarks are likely not registered in the same class that covers educational symposia on intellectual property issues. He continues to deny the dilution claims by noting that the flyer is a noncommercial use of the trademark, and is a fair use parody.

The Operative Law

Section 43 of the Lanham Act (15 U.S.C. 1125) provides that:

"Any person who, on or in connection with any goods or services…uses in commerce any word, term, name, symbol, device, or any combination thereof… which…is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person…shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act" (See p. 221-222 of U.S. Trademark Law, Rules of Practice & Statutes).

This section protects the owners of trademarks, and provides remedies for any damage or likely damage caused by another's use of an owner's mark. The section does, however, carve out exceptions and exclusions for when an owner's mark is used, but is allowable. Section 43provides that:

"The following shall not be actionable as dilution by blurring or dilution by tarnishment… Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as designation of source for the person's own goods or services, including in connection with…identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner" (See p. 223 of U.S. Trademark Law, Rules of Practice & Statutes).

Where Trademark Meets the First Amendment a Caselaw Analysis

The fair use and parody exclusion from the Lanham Act demonstrates where trademark law meets the First Amendment. Parody is a form of artistic expression, which is protected by the First Amendment, with an ultimate objective of amusement, not confusion. Parody entitles the party using the owner's mark to argue that there is no trademark infringement, because there is no likelihood of confusion. McCarthy on Trademarks and Unfair Competition § 31:153 (4th ed. 2001).

Confusion exists when there is a "likelihood that an appreciable number of ordinary prudent purchasers will be misled or confused as to the source of the goods in question Mushroom Makers, Inc. v. R.G. Barry Corp., 580 F.2d 44, 47 (2d Cir. 1978), or where consumers are likely to believe that the mark's owner sponsored, endorsed, or

otherwise approved of the defendant's use of the mark" Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 204-205 (2d Cir. 1979); Tommy Hilfiger Licensing, Inc. v. Nature Labs LLC, 221 F.Supp.2d 410, S.D.N.Y., 2002.The Second Circuit has placed its focus on balancing the public interest in avoiding consumer confusion against the public interest in free expression. Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g, 886 F.2d 490, 494 (2d Cir. 1989).

In Tommy Hilfiger Licensing, defendant Nature Labs was selling a line of parodic pet fragrances, cheekily named after several designer fragrances, such as Miss Claybone (Liz Claiborne), White Dalmations (Elizabeth Taylor's White Diamonds) and Timmy/TommyHoledigger (Tommy Hilfiger). Plaintiff, Tommy Hilfiger Licensing brought several claims against defendant, including trademark infringement, trademark dilution, false designation of origin, false advertisements, and other claims. The court noted that "[t]he central issue in an action for trademark infringement or false designation of origin under the Lanham Act is whether the unauthorized use of the mark is 'likely to cause confusion'" 15 U.S.C. § 1114(1); 15 U.S.C. § 1125(a)(1)(A).

When a trademark is being used to comment and ridicule the trademark owner and not being used to indicate the source or origin of consumer products, and a parodist is not trading on the good will of the trademark owner to market its own goods, then the risk for consumer confusion is at its lowest. While defendant was not making any comment about plaintiff, he was intending to create a parody of plaintiff, by using a play on words. The court further explained that trademark parodies convey a message. "The message also may be a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark's owner" Tommy Hilfiger Licensing, Inc. v. Nature Labs, 221 F.Supp.2d 410 at 415, S.D.N.Y., 2002. Citing McCarthy, the court commented that "[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 the trademarked word or image" McCarthy on Trademarks and Unfair Competition § 31:153 (4th ed. 2001); Tommy Hilfiger Licensing, Inc. v. Nature Labs, 221 F.Supp.2d 410 at 415, S.D.N.Y., 2002. They further clarified that because of the mark's fame and popularity, confusion is avoided, and the parodist is able to achieve the parody. Id. As a result, the court held for the defendant, granting its motion for summary judgment. Id. at 425.

As demonstrated in the Tommy Hilfiger case, when a parodist is using a famous mark, for the purpose of humor, and it is conveying a message, courts will balance the public's interest in free speech against the public interest in avoiding consumer confusion. What is key about this balance, is that the confusion of the *consumer* is the main consideration. In the disagreement

between PIPG and Louis Vuitton, there is no consumer to be confused. No products are being commercially sold or consumed. No individuals are going to reasonably mistake a law school as a seller of designer goods. PIPG was using the Louis Vuitton mark in a non-commercial, educational context, to garner interest in an educational symposium. Similar to Nature Lab's use of the Tommy Hilfiger mark, making a play on words, PIPG was making a play on the Louis Vuitton mark. PIPG was seeking to educate individuals on laws in the fashion industry, many of which are trademark-related.

Conclusion

Playing with the LV mark, and replacing it with a TM, while maintaining the recognizability of the original mark, the poster was merely a parody, poking fun at the fashion industry and trademark laws. Although no case was filed in this instance, it certainly would make for interesting reading if it were.