Scenario Four

Your e-mail lights up with a new message from the Internet Freedom Foundation, an organization that recruits attorneys for ***pro bono*** representation of individuals and not-for-profit businesses in cases arising out of their activities on the internet. Today's case involves Zach, a 20-something Los Angeles blogger, musician by night, ***barista*** in a local coffee house by day, and self-styled media critic online. Zach posted an entry complaining about the incessant sniping between two of the judges on the popular television program American Idol, Simon Cowell and Paula Abdul. He thought perhaps they needed to "take it outside" to resolve their issues, so that the show would be less annoying. Apparently this entry touched a nerve, as there were dozens of responses. He posted a follow-up entry in which he announced the following:

> Since Ms. Abdul and Mr. Cowell seem intent on fighting, and since American Idol is all about taking sides, I have retrofitted my old Rock'em Sock'em Robots set (in Photoshop, of course) so that we can choose sides and settle this once and for all. Who will knock out who?

The response of site readers was enthusiastic, and Zach decided that it would be fun to sell an inexpensive conversion kit so that others could have one, too.

> Okay people, you asked for it, you're getting it. I have found a company that will make little rubber "faces" custom-fitted to slip over the robot heads, but I need to know how many to order because it would not be fun to have a lot of excess inventory. You will be able to place orders (yes, including paying for them) at www.PaulaHatesSimon.com, just as soon as I get around to putting up some pages there. And naturally each kit will include the "American Imbecile" logo sticker.

Word quickly got around the internet and FOX raised objections in a demand letter. Of course, Zach blogged about this, adding:

> Once upon a time there was a First Amendment in this country. I've posted a copy of it at www.AmericanImbecile.com so that those who seem to have forgotten can refresh their memories.

In fact, the First Amendment was the entire content of that site. FOX sued, seeking relief on several grounds, including trademark infringement and dilution (based on the name/logo American Imbecile and the domain name AmericanImbecile.com), and cybersquatting. FOX asked for an order barring Zach from selling any product associated with the program or its characters, and for transfer of the AmericanImbecile.com domain name. Paula Abdul and Simon Cowell joined the suit, alleging that the proposed "rubber faces" and the domain name PaulaHatesSimon.com misappropriated their identities. The stars sought an order barring Zach from selling any product evoking their personas, or using the PaulaHatesSimon.com domain name for anything related to either of them.

You check in with Joan, one of your more experienced colleagues. She finds it extremely silly, but agrees to outline her thoughts for your consideration.

Q10. Joan's take on FOX's infringement claim is that Zach's use of "American Imbecile" in connection with his "conversion kit" does not create a likelihood of confusion. She noted that the marks look and sound different, and the meanings are just about the complete opposites. Furthermore, in Zach's logo, the word Imbecile is in neon pink. Although FOX sell a variety of merchandise with the American Idol name on it, such as t-shirts, hats, bags, and an iPod slipcover, there is nothing like this at all. While both sides sell through the web and target the show's viewers, such loyal fans would have no difficulty recognizing that Zach's product is unofficial. Finally, she says that Zach's product clearly is a kind of commentary or parody, so any minor amount of confusion that might arise will be outweighed by the First Amendment interest. Do you agree?

A. No, because Joan did not consider the strength of the American Idol mark, which is very well known and for a mark this strong, a court will strain to find a likelihood of confusion despite all the other differences.

B. Yes, for the name, but No for Zach's logo because in the Ninth Circuit, a nominative fair use can take only as much as is necessary to call to mind the original (here, "American" is enough).

C. No, because based on other FOX shows such as The Simpsons, character-based toys are within the foreseeable scope of expansion for genuine American Idol merchandise, at which point the balance of factors would swing sharply in favor of FOX.

D. Yes, because even though the American Idol mark is strong, the right to engage in minimally confusing media criticism — in diverse forms — is stronger, particularly where there is no risk of product substitution.

E. No, even though it is funny and not intended to harm FOX, the court will always act to protect the public from possible confusion, and thereby the trademark owner's reputation, no matter how minimal that risk might be.

Optional Explanation for Q10 (if commenting in a blue book/ExamSoft, refer to Q10) (comments are strongly recommended for this question)***:***

Q11. On the dilution claim, Joan concedes that "American Idol" is a famous mark, and therefore is protected against tarnishment. Anyone called an "imbecile" should be highly insulted, as the word refers to someone who is stupid or has a mental age of 7 or under. Zach's readers and customers might understand the term to refer to the show's host and judges, its contestants, or its audience. Any of these interpretations might lower the program's esteem in the eyes of the public, and therefore be considered to tarnish it. It's a harsh result, but, she says, parody must have some limits. Do you agree?

A. No, because the Ninth Circuit has held that using the very famous mark "Barbie" does not cause dilution, so any ***less*** famous marks like American Idol must available for third party use.

B. Yes, because the analogy to the ***Deere*** case (altered deer logo) is better than the analogy to the ***Hormel*** case (altered SPAM mark).

C. No, because under the emerging multiple-factor test, the dissimilarity of the words "idol" and "imbecile" would lead to the conclusion that there would be no blurring of the American Idol mark in the public mind.

D. Yes, because Congress has not yet passed H.R. 683, so courts do not yet recognize parody as a defense to Federal trademark dilution.

E. No, because Joan has overlooked the noncommercial use exception, which applies even to products sold for a profit.

Optional Explanation for Q11 (if commenting in a blue book/ExamSoft, refer to Q11):

Q12. Registering AmericanImbecile.com in response to FOX's demand letter was not the best move, Joan says. It suggests a type of inappropriate retaliation. On the other hand, the usage purely to display the First Amendment presents little risk of confusion, and it does not seem as though FOX would itself have a need to use this domain. Because Zach had labeled his "prototype" product with the "American Imbecile" name, he might be considered to have one of the first four "no bad faith" ACPA factors in his favor. He also doesn't appear to have a habit or practice of trademark-squatting. All things considered, it doesn't sound like cybersquatting to her. Do you agree?

A. Yes, because the ACPA was written to address a well defined set of piratical practices, and this simply is not listed in the statute.

B. No, because there is a serious risk of initial interest confusion among web users who guess that American Idol (FOX) might have a web site at www.AmericanImbecile.com and find themselves there with no exit link.

C. Yes, because Zach has done nothing to extract commercial value from the domain, and has not associated it in any way with FOX, other than to mention it in the course of a blog entry about FOX's demands.

D. No, because courts view with great suspicion any activity undertaken after a party is notified of an intellectual property dispute, so the appearance of retaliation would receive decisive weight.

E. Yes, because Zach's usage qualifies for the automatic "safe harbor" exception, even if he failed to first obtain legal advice after being informed of FOX's claims of alleged trademark infringement.

Optional Explanation for Q12 (if commenting in a blue book/ExamSoft, refer to Q12):

Q13. The celebrities' right of publicity claims with respect to likeness, "image" or identity are a bit vague, but presumably are based both on the applicable State privacy laws and the common law. Because Zach has not yet had the rubber faces manufactured, it is not clear how similar they will be, but undoubtedly they will be similar enough that customers will know who they are intended to be. Joan concludes that the only hope is a First Amendment defense, along the lines of the ***Cardtoons*** case. Having thought through the facts, she thinks that such a defense will work. Do you agree?

A. No, because the case is in the Ninth Circuit, and while ***Motschenbacher, Midler*** and ***Samsung*** dealt with advertising, the distinction between commercial speech and fully protected speech has lost its significance.

B. Yes, because Zach's commentary on the celebrities' behavior requires the use of their likenesses and, under the reasoning of the ***ETW*** case, the overall effect of placing the rubber heads and sticker on the robot game is sufficiently transformative to qualify for a First Amendment defense.

C. No, because Zach is able to sufficiently express his views on the two celebrities without using their likenesses at all — much less selling a kit enabling others to spread his message — even if a purely textual description is a somewhat less compact or powerful way to convey it.

D. Yes, because like the targets of the parody baseball cards, the plaintiffs here are overpaid celebrities who don't know how to behave in a civilized manner and therefore deserve to be lampooned.

E. No, because the parody in ***Cardtoons*** was primarily a literary one, involving cards full of commentary along with the players' caricatured names and images, so a court would not apply its principles to a toy.

Optional Explanation for Q13 (if commenting in a blue book/ExamSoft, refer to Q13) (comments are strongly recommended for this question)***:***

Q14. The celebrities' claims with respect to their names presumably are based on the Lanham Act and applicable State privacy laws and the common law. While Paula and Simon are common given names, Joan suspects the plaintiffs will be able to show that the combination "PaulaHatesSimon" would be understood by anyone familiar with American Idol to refer to Paula Abdul and Simon Cowell. Zach never posted a web site at the domain, and it merely displays "This page was recently registered by one of our customers." Do you agree with Joan's rough assessment of these causes of action, as set out below?

I. Lanham Act: usually no ***regular*** likelihood of confusion or ***initial interest*** confusion when there's no site; moreover, consumers would not believe the celebrities sponsored or approved a site named "Paula Hates Simon": the word "hates" negates any association.

II. State law / Common law: like the movie title "Ginger and Fred" the domain calls to mind two particular people, but unlike the movie title, there is no special exception for domain names that either are in use or which have been advertised for future use.

III. First Amendment defense: "Paula Hates Simon" is an exaggerated and humorous version of Zach's original comments, and a logical extension of the "fighting" metaphor illustrated by the modified robot game; if the game itself is permissible, then the usage in a domain is honestly descriptive and does no additional harm, but if the game is not permissible, then merely registering the domain name misappropriated the two celebrities' identities.

A. Agree with I only.

B. Agree with II only.

C. Agree with III only.

D. Agree with I and II.

E. Agree with II and III.

F. Agree with I and III.

Optional Explanation for Q14 (if commenting in a blue book/ExamSoft, refer to Q14):

Q15. BONUS QUESTION: ***Points awarded on this question are "above the curve."***

The company CafePress.com lets users upload any artwork to a personal storefront which other web users then can have printed on mugs, t-shirts, coasters, and other types of merchandise. A percentage of each sale goes to the owner of the storefront. Would Zach be in much worse trouble if he set up a storefront named "Parody Legal Defense Fund" to sell merchandise bearing the "American Imbecile" logo? If so, why: how would the additional conduct differ appreciably from his present conduct or, if applicable, change the way his present conduct is evaluated? (Limit your analysis to the trademark infringement and / or dilution claims.)

"American Imbecile" Coaster

Please answer in a blue book or in the exam software, referring to Q15.