

The logo for Astrachan Gunst Thomas features a stylized, swirling blue graphic to the left of the firm's name. The name "astrachan gunst thomas" is written in a lowercase, sans-serif font, with "astrachan" and "thomas" in a darker blue and "gunst" in a lighter blue.

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a professional corporation
attorneys at law
baltimore . washington, d.c.
www.agtlawyers.com

A Tail for Two Dogs

By: James B. Astrachan

My buddy wants to manufacture and sell a dog chew toy that will look like a rolled-up newspaper with the masthead, "THE BALTIMORE SON." "Pretty funny," I thought. "But will The Sun think so?"

Manufacturers parody well known products to take advantage of brand recognition among consumers. Their humorous brands are similar but not identical to the products they parody. Often challenged by the brand's owner, they sometimes prevail – and sometimes they do not. The cases of BUTTWIPER/BUDWEISER and CHEWY VUITON/LOUIS VUITTON are disparate cases in point.

VIP Products was sued by Anheuser-Busch for trademark infringement, unfair competition and dilution over its dog squeeze toy, "Buttwiper," shaped like a beer bottle with a Budweiser-like label. Haute Diggity Dog was sued by Louis Vuitton for copyright infringement and trademark infringement and dilution over its handbag shaped dog chew toy, "Chewy Vuiton."

A district court in the Eighth Circuit held Buttwiper infringed the Budweiser mark by creating a likelihood of confusion among consumers as to association; surprisingly it was held not to dilute the trade dress or trademark. The Fourth Circuit Court of Appeals affirmed a district court decision holding that Chewy Vuiton did not infringe Luis Vuitton's copyrights or trade dress and did not dilute its trademarks.

Louis Vuitton claimed that the use of almost an exact imitation of the house mark VUITTON, without the second "T," and the copied Vuitton monogram design mark would cause confusion and dilute the distinctive nature of its famous mark. No survey evidence or evidence of actual confusion was presented. Haute Diggity Dog countered there could be no confusion because it successfully marketed its products as parodies of famous marks and that because the parodied mark is so famous, confusion is avoided. In other words, people almost instantly get it that the Chewy is not a Louis.

A parody for trademark purposes is defined as a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark's owner. A parody must convey two simultaneous and contradicting messages: that it is the original, and that it is not the original – it is a parody. The second message must distinguish the copy from the real thing. The copy must also communicate some articulable element of satire, ridicule, joke or amusement. The parody must rely on the difference between it and the original to create this effect, but it must not substitute itself for the original in the eyes of consumers.

The *Vuitton* court found the toy to be an irreverent and intentional representation of a real Vuitton bag, although smaller and rougher. Nor was the chew toy the idealized image of the Vuitton mark; the differences were immediate, using only enough of the original Vuitton design to allow a consumer to appreciate the point of the parody but stopped short of appropriating the entire mark.

Even a successful parody may confuse, and courts should apply the traditional factors used to assess likelihood of confusion. In *Vuitton*, the court held that the likelihood of confusion factors favored Haute Diggity Dog and that Vuitton had failed to demonstrate any likelihood of confusion. Vuitton offered no survey.

Compared to *Vuitton* the holding in *Anheuser-Busch* is peculiar as the copy was even further removed from the original object. Like *Chewy Vuiton*, the *Anheuser-Busch* court applied the traditional factors to assess likelihood of confusion in order to measure whether plaintiff would be likely to succeed on the merits of its claim. Of these factors, defendant conceded that only the degree of care reasonably expected of potential customers and actual confusion were at issue. That these two factors favored plaintiff was established solely by Anheuser-Busch's survey of 327 persons in 9 shopping malls, each of whom was likely to buy a pet toy within 6 months. Incredibly, one in three people interviewed mistakenly believed that Buttweiler was manufactured or marketed by, or with the approval of, plaintiff, or that there is some affiliation between Buttweiler and plaintiff. There was no other evidence of confusion.

The Eighth Circuit had previously set its likelihood of confusion threshold low, at 11% of those surveyed, ironically, in another parody case. In *Buttweiler*, Anheuser-Busch presented survey evidence showing that 30% of those surveyed were confused as to an association between the products or companies. The court concluded that the survey was conducted in a technically proper manner using relevant and non-confusing questions, as the evidentiary value of a survey for showing actual confusion in trademark cases depends on the relevance of the questions asked and the technical adequacy of the survey.

Those surveyed were allowed to view Buttweiler and a control item for as long as they wanted before they were asked questions such as: "What company or companies do you think makes or puts out the product you just saw?"; "Do you think the company

that makes the product...puts out any other products or brands?"; "Do you think the company that makes or puts out the product you just saw does or does not have a business connection or affiliation with any other company or brand?"; "Do you think the product you just saw is or is not made or put out with the approval or sponsorship of any other company or brand?"

The court and defendant ignored the leading nature of some of these questions. The survey should have been rejected as a survey question that begs its answer by suggesting a link between plaintiff and defendant cannot serve as a real indication of consumer confusion. Had the court rejected plaintiff's survey, the evidentiary playing field would have been leveled as to likelihood of confusion.

On the issue of parody, the *Buttwiper* court properly concluded that a parody creating a likelihood of confusion may be trademark infringement, but it appears to have missed the mark when it applied the "intent of the junior user" factor to likelihood of confusion caused by parody, holding that evidence that the infringer chose a mark with intent to copy, rather than randomly or by accident, typically supports an inference of likelihood of confusion. "How does one parody a brand unless he chooses the mark with an intent to copy?" I asked myself. The short answer is he can not for he must conjure up association with the original item.

The Fourth Circuit properly determined that Chewy Vuiton was protectable parody and not trademark infringement or dilution. The *Buttwiper* court, however, missed the mark for a couple of reasons. First, the survey appears to have been defective due to the leading nature of the questions asked, and it should have been rejected or accorded very little weight. Without the survey there was not any evidence of actual confusion and an analysis of the two likelihood factors relied on by the court should have been supported a finding of no likelihood of confusion, just as did the Fourth Circuit's *Chewy Vuiton* analysis. Second, the court could have found a likelihood of dilution by tarnishment on the basis that Budweiser would suffer negative associations through defendant's use. After all, Budweiser is considered by some a food product. And due to the dog drool, Buttwiper is, at best, unsanitary. Or worse for other, obvious, reasons.

"Yes," I said to my friend. "I believe your product will be protectable parody. But how much money and time are you willing to spend to fight for your rights?"

James B. Astrachan is the author of The Law of Advertising and Mass Communications, published by Matthew Bender-Lexis/Nexis.