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Even More Parodic than the Real Thing: Parody Lawsuits Revisited

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EVEN MORE PARODIC THAN THE REAL THING: PARODY LAWSUITS REVISITED

By Bruce P. Keller* and Rebecca Tushnet**

I. INTRODUCTION

An article focusing on a copyright decision initially may appear out of place in the pages of The Trademark Reporter®. Yet Campbell v. Acuff-Rose Music, Inc.,¹ in which the U.S. Supreme Court held that a parodic, transformative use of a copyrighted work, even if commercial, could qualify as a fair use, is quite significant for trademark lawyers. As a practical matter, parody cases increasingly involve copyright as well as trademark claims, so practitioners often encounter both within the same case. As a doctrinal matter, Campbell also has proved legally significant in trademark cases because the free-speech concerns underlying protection for parodies apply no matter what law is invoked against them. Campbell is thus a good illustration of the unexpected effects that Supreme Court decisions often have when the generalist Court tries its hand at the occasional intellectual property case.

One of Campbell’s most significant—and unsatisfying—effects has been to elevate parody as a favored form of literary or artistic comment and devalue satire. Several courts have since explicitly relied on the distinction between these two forms of humor to impose liability on those who have created the latter, even though the actual language from the Court’s opinion counsels a more sensitive approach.

This is a troubling trend, for at least two reasons. First, the distinction between parody and satire is too fine for courts (not generally recognized as great connoisseurs of humor) to make. Second, the parody/satire distinction simply is not responsive to the considerations that underline copyright law’s fair use doctrine, including First Amendment values served by satires as well as parodies.

¹. 510 U.S. 569 (1994).


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This article sets forth the context in which the parody/satire distinction arose in *Campbell*, then examines how it has been applied in subsequent copyright, trademark, and right of publicity cases. Briefly stated, our review shows that factually similar copyright cases have reached wildly divergent results, which illustrates *Campbell*’s analytical limits. Insofar as trademark law is concerned, the bias created in favor of parodies may well have made things worse by making secondary the only proper question in a trademark infringement case: whether a particular use is likely to cause consumer confusion. In recent right of publicity cases, by contrast, courts have steered away from the parody/satire distinction, but have not uniformly replaced it with a coherent analysis.

II. *CAMPBELL* AND ITS ANTECEDENTS

In *Campbell*, the Supreme Court unanimously reversed a grant of summary judgment in favor of the owner of the copyright in Roy Orbison’s “Oh, Pretty Woman.” The defendants, the rap group 2 Live Crew, had recorded a song called “Pretty Woman” that used some of Orbison’s music and a twisted version of his words. The Sixth Circuit had held that 2 Live Crew’s commercial use—the song was on an album being sold to the public—made its appropriation presumptively unfair. The Supreme Court, however, declared that copying for profit did not give rise to a presumption, much less a conclusion, against fair use where that use was “transformative.” In Justice Souter’s words,

2 Live Crew juxtaposes the romantic musings of a man whose fantasy comes true, with degrading taunts, a bawdy demand for sex, and a sigh of relief from paternal responsibility. The later words can be taken as a comment on the naiveté of the original of an earlier day, as a rejection of its sentiment that ignores the ugliness of street life and the debasement that it signifies. ²

The Sixth Circuit could be forgiven for presuming that a commercial use was an unfair use; after all, the Supreme Court said exactly that in 1984. ³ Under *Campbell*, however, commercial use is less important than the extent to which the accused work adds something new to the original. ⁴ Not every change is “transformative” for fair use purposes: The alleged fair use must

2. Id. at 583.
not be merely a derivative work. The Court distinguished between simply adding new material and adding new material that reflects on the original work. A parody, which makes the original work its target, is particularly favored, while a satire, which uses the same work to criticize something else, is not. According to the Court, this is out of a concern that the satire may be using a preexisting work simply to "avoid the drudgery in working up something fresh."

In the Supreme Court's analysis, a finding of transformation necessarily pervades the analysis of the other statutory fair use factors: the nature of the copyrighted work, the amount and substantiality of the portion of the copyrighted work used, and the effect of the defendant's use on the market for the copyrighted work. The nature of the copyrighted work is not particularly important in a parody case because parodies almost invariably play off of highly expressive, creative works, or they risk failing in their purpose. The amount and substantiality of the portion of the copyrighted work used also have to be judged differently than in cases of nontransformative use. A parody needs to evoke at least enough of the original to identify its target. Often this will mean use of the "heart" of the work—the expressive elements that are most closely associated with that work. Parodies of Hemingway's style, Tolkien's imagined worlds, Star Trek characters' signature phrases, and the like all may use substantial portions of the original and still imbue those portions with transformative value.

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5. The Copyright Act of 1976 grants copyright owners the exclusive rights to authorize "derivative works," defined as any form in which a work may be transformed, recast or adapted; film versions of movies are classic examples of derivative works. See 17 U.S.C. § 106(2). Parodies, if they take enough of an original work, qualify as derivative works, as do satires and other kinds of reuse that add new material to the underlying copyrighted work.


7. The four factors set forth in the Copyright Act are: (1) the purpose and character of the use (a factor taking into account both whether the use is commercial and whether it is transformative); (2) the nature of the copyrighted work; (3) the amount and substantiality of the use in relation to the copyrighted work as a whole; and (4) the effect of the use on the market for the copyrighted work. 17 U.S.C. § 107.

8. See Campbell, 510 U.S. at 586.

9. Hemispheres magazine, for instance, runs an International Imitation Hemingway contest as well as a Faux Faulkner contest. The authors' styles are easy to recognize and thus attract more parodists than other famous authors' more workmanlike prose. Cf. SunTrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1277 n.1 (11th Cir. 2001) (Marcus, J., concurring) (quoting Ernest Hemingway's complaint that "Parodies are what you write when you are associate editor of the Harvard Lampoon. The greater the work of literature, the easier the parody.").


12. See Campbell, 510 U.S. at 588 ("When parody takes aim at a particular original work, the parody must be able to 'conjure up' at least enough of that original to make the object of its critical wit recognizable. What makes for this recognition is quotation of the
Once the parody has used enough of the original work to ensure recognition, how much more copying will be allowed will depend on the other fair use factors, particularly whether the overall purpose is to parody the original.\textsuperscript{13} How parodic the parody really is—that is, the extent to which it transforms and criticizes the original—affects the extent to which it is likely to serve as a substitute for the original, usurping the copyright owner's legitimate market.\textsuperscript{14}

\textit{Campbell} took its vision of transformative fair use from an article by Judge Pierre Leval, in which he proposed that fair use be redefined as requiring that the use be "productive" and "employ the quoted matter in a different manner or for a different purpose from the original."\textsuperscript{15} The concept of "productive" use, which serves the purpose of copyright law by increasing the store of knowledge, already had some currency before \textit{Campbell}.\textsuperscript{16} To take a core example, it was accepted that traditional critical scholarship and reviews—nonfiction uses that shed new light on the works they discuss—were protected by fair use.\textsuperscript{17}

Of \textit{Campbell}'s contributions, therefore, two were the most significant. First, the Court's opinion appeared to embrace the supremacy of the transformative use inquiry over all other factors, as Judge Leval advocated.\textsuperscript{18} Another way to describe \textit{Campbell}'s version of fair use is to say that, once the transformative use determination is made, all the other factors fall into place behind it.\textsuperscript{19}

Second, and relatedly, \textit{Campbell} drew a line between parody and satire, identifying the former as a favored type of transformative use and the latter as likely to be an unnecessary original's most distinctive or memorable features, which the parodist can be sure the audience will know.\textsuperscript{) (citations omitted).}

\textsuperscript{13} See \textit{id}.

\textsuperscript{14} \textit{id.} at 591 ("[W]hen . . . the second use is transformative, market substitution is at least less certain, and market harm may not be so readily inferred. Indeed, as to parody pure and simple, it is more likely that the new work will not affect the market for the original in a way cognizable under this factor, that is, by acting as a substitute for it . . .") (citations omitted).


\textsuperscript{18} See Leval, supra note 15, at 1111 (arguing that transformation should be the primary determinant of whether a use is fair); \textit{id.} at 1124 (arguing that a use that does not harm the copyright owner's market should still be deemed unfair unless the use is justified under the first statutory factor).

\textsuperscript{19} See, e.g., \textit{Abilene Music, Inc. v. Sony Music Entm't, Inc.}, 320 F. Supp. 2d 84, 89 (S.D.N.Y. 2003) ("[O]nce a work is determined to be a parody, the second, third, and fourth factors are unlikely to militate against a finding of fair use.").
use of another's copyrighted work. Before *Campbell*, courts used the terms interchangeably to refer to categories (or a category) of work likely to constitute fair use.²⁰ Indeed, our research has not found any pre-*Campbell* case using parody and satire to draw presumptive lines between fair and unfair uses,²¹ though courts did consider, under other rubrics, the extent to which a burlesqued work was used simply to get the audience's attention with a familiar text.

In fact, Justice Souter's *Campbell* opinion is careful to avoid any bright-line rule, including one condemning all satire. Although the text of the opinion suggests that satire can stand on its own two feet and thus has less of a claim to fair use than parody,²² a footnote points out that the more important question is whether

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The same phenomenon occurred in trademark law. *See, e.g.*, *Universal City Studios, Inc. v. Nintendo Co.*, 746 F.2d 112, 116 (2d Cir. 1984); *Dallas Cowboys Cheerleaders, Inc. v. Pussy Cat Cinema*, 467 F. Supp. 366, 376 (S.D.N.Y.) (defining "parody" and "satire" separately, as in *Campbell*, and treating both as fair use), aff'd, 604 F.2d 200 (2d Cir. 1979); *Groucho Marx Productions, Inc. v. Day & Night Co.*, 523 F. Supp. 485 (S.D.N.Y. 1981), rev'd on other grounds, 689 F.2d 317 (2d Cir. 1982), lumped the two together in discussing exceptions to the right of publicity. *See id.* at 492-93.

²¹. To the contrary, *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541 (2d Cir.), cert. denied, 379 U.S. 822 (1964), found *Mad Magazine* lyrics, to be sung to Irving Berlin tunes, to be fair use even though the object of the humor was not Berlin's songs but the "idiotic world we live in today." *Id.* at 542.

the accused work risks substituting for the original or licensed derivative works. According to that footnote, when there is "little or no risk of market substitution," both "looser forms of parody" and "satire" may be fair use.

Unfortunately, Justice Souter's nuanced reasoning has been overlooked in most post-Campbell cases; instead, some courts have relied on the easier wholesale parody/satire distinction, placing on it an importance far out of proportion to its origins and benefits. As the next three sections discuss, copyright and trademark cases have suffered most as a result, while right of publicity cases have more clearly recognized the disutility of the distinction (though right of publicity jurisprudence has troubles of its own with transformative use).

III. CAMPBELL'S EFFECTS ON COPYRIGHT CASES

We begin with an analysis of the impact of Campbell on copyright cases. As noted, humorous unauthorized uses of preexisting works often can involve copyright, trademark, the right of publicity or privacy and false advertising claims in the same case. Moreover, the problems of Campbell in copyright litigation provide important lessons counseling against its reflexive extension to trademark and right of publicity law. The central lesson to be drawn from the copyright cases is that, although the parody/satire line has become quite significant, the demarcation between parody and satire is not always clear. First, as a practical matter, the distinction is far too malleable in the hands of a capable practitioner or judge to be of much use. Second,

23. Id. at 580 n.14.

24. Id. Though Justice Souter is here speaking of copyright, one could imagine similar reasoning applied to trademark cases, in which factors supporting a minimal likelihood of confusion (such as audience sophistication and purchaser care) could justify greater similarity between a mark and its humorous imitation.

and perhaps more important, the distinction between the two is not responsive to the considerations that justify fair use and the free speech concerns underlying fair use.

A. Line- Drawing Problems

A fundamental flaw of the parody/satire divide is that there is no true division.\textsuperscript{26} \textit{Mad Magazine},\textsuperscript{27} which routinely lampoons both society and particular cultural phenomena with caricatures of movies and celebrities, is a good example.\textsuperscript{28} “Weird Al” Yankovic’s creative output provides further examples. “(This Song’s Just) Six Words Long”\textsuperscript{29} is a parody of “I Got My Mind Set on You” by George Harrison because it mocks the mind-numbingly repetitive lyrics of the original. Is his song “King of Suede,”\textsuperscript{30} about a clothing salesman, a parody of “King of Pain” by The Police? Arguably, the song pokes fun at the self-important angst represented by “King of Pain” and its singer, a contention no less plausible than the idea that 2 Live Crew’s rap song attacked the naïveté of Roy Orbison’s “Oh Pretty Woman” with lyrics identifying the targeted woman as an ugly prostitute.\textsuperscript{31}

To take another example, the musical \textit{Avenue Q} is, as everyone involved acknowledges, a takeoff on \textit{Sesame Street} using very similar puppets and even former \textit{Sesame Street} puppeteers. As \textit{Time} described the premise,

\begin{itemize}
\item[26.] See, e.g., Tyler T. Ochoa, \textit{Dr. Seuss, the Juice and Fair Use: How the Grinch Silenced a Parody}, 45 J. Copyright Soc’y 546, 557 (1998) (noting that “many literary scholars argue” that it is “both foolish to attempt and impossible to achieve” a true dichotomy between satire and parody).
\item[27.] See \textit{Mad Magazine}, http://www2.warnerbros.com/web/madmagazine/home.jsp (visited Mar. 6, 2004) (containing images from recent issues and various past movie parodies/satires). \textit{Is Our World Really All That Different from the Matrix?} http://www2.warnerbros.com/madmagazine/files/onthestands/ots_436/matrix.html, for example, uses \textit{The Matrix} to mock rapper 50 Cent, Geraldo Rivera and Viagra.
\item[28.] Rochelle Dreyfuss has informed one of the authors that her late colleague, Alan Latman, who wrote a major report on fair use to Congress before the enactment of the 1976 Copyright Act, spoke of the “\textit{Mad Magazine} exception,” and based many of his conclusions on the proposition that what \textit{Mad Magazine} did was, by definition, not copyright infringement.
\item[29.] “Weird Al” Yankovic, \textit{Even Worse} (Scotti Bros. 1988) (containing, along with many repetitions of the title, lyrics such as “Couldn’t think of any lyrics/No I never wrote the lyrics/So I’ll just sing any old lyrics/That come to mind, child”).
\item[30.] “Weird Al” Yankovic, \textit{In 3-D} (Scotti Bros. 1991) (“There’s a sale on our gabardine suits today/They’re all thirty percent off from yesterday/...Well, I never made it past the second grade/It took all of my life for me to learn this trade/But my friends are all thinking that I’ve got it made/Cause I’m known the world over as the King of Suede. . . .”).
\item[31.] In his \textit{Campbell} concurrence, Justice Kennedy points out that “Just the thought of a rap version of Beethoven’s Fifth Symphony or ‘Achy, Breaky Heart’ is bound to make people smile.” \textit{Campbell v. Acuff-Rose Music, Inc.}, 510 U.S. 569, 599 (1994) (Kennedy, J., concurring). He cautions, however, against allowing such “weak transformation” to count as fair use. \textit{Id.}.
\end{itemize}
What if the denizens of Sesame Street grew up into profane, broke, self-doubting college grads who kept some of their innocence but developed potty mouths? ... There's Cookie Monster's alter ego, Trekkie Monster, who is addicted to Internet porn, and a pair of sexualized Ernie and Bert characters, Nicky and Rod, who room together but don't sleep together. ... 32

Parody or satire? Like pre-Campbell courts, theater reviews eschew the distinction, noting that Avenue Q addresses recent college graduates' fears about adult life (satire) through obvious references to Sesame Street characters (parody).33 Indeed, one of the creators has stated that his motivation for basing the musical on Sesame Street—like puppets was to get younger audiences' attention,34 which could also be called "avoiding the drudgery of working in something fresh."35 The producers are fortunate that Sesame Street has decided not to use that admission against them in litigation.

For those who have not taken the time to sample these forms of humor, four post-Campbell reported opinions illustrate the limits of line-drawing in this area, showing how subjective and fuzzy the line between parody and satire can be. Two movie advertisements and two books stood accused of copyright infringement; one of each fended off the claim with a successful parody/fair use defense.

In Columbia Pictures Industries, Inc. v. Miramax Films Corp.,36 the owners of the copyright in the movie Men in Black and the poster used to promote it sued Miramax, distributor of The Big One, a Michael Moore documentary about the human casualties of

32. Kate Betts, Puppet Regime: Toys Really Are Us in the New Musical Avenue Q, Time, Aug. 11, 2003, at 62; see also Jesse McKinley, To Producers of "Avenue Q" Puppets Now Mean Profits, N.Y. Times, May 1, 2004, at B15 (similar description).

33. See, e.g., Elysa Gardner, "Q" Takes a Witty Ride Down "Sesame Street," USA Today, Aug. 4, 2003, at 4D (using both terms); Jake Tapper, Is This Town Big Enough for Two Puppet Boulevards? N.Y. Times, July 27, 2003, sec. 2, at 5 (same); Charles Isherwood, "Avenue Q" Re-Routed to Broadway, Variety, Aug. 4, 2003, at 29 (stating that show "co-opts the style of a tyke TV show to animate the aimless lives of underemployed twentysomethings looking for love and fulfillment," which would sound like satire after Campbell).

34. Blake Green, "Avenue Q"s Creators Grew Up on 'Sesame Street' and the Muppets, But Their Creations Are Decidedly Not Aimed at Children, L.A. Times, Aug. 3, 2003, Part 5, at 34 ("We needed a way in [to appeal to young people]," says Lopez, who repeats a friend's observation about 'Avenue Q': 'It's how you're sneaking in under the radar.'").

35. Campbell, 510 U.S. at 580. Cf. Alex Kozinski & Christopher Newman, What's So Fair About Fair Use? 46 J. Copyright Soc'y 513, 517 (1999) (pointing out that satire may not be a way of avoiding hard work; "[i]t's easy enough to spew a few lines of impromptu [Sleussian doggerel, but it takes some creativity and work to write a sustained satirical pastiche that people will enjoy enough to pay money for and recommend to their friends").

corporate America's focus on profits. Miramax's posters and movie trailer drew on *Men in Black* by imitating its advertising slogan ("Protecting the Earth from the scum of the universe" became "Protecting the Earth from the scum of corporate America"), the visual arrangement of its advertising poster and several notable elements from the poster.

The court rejected Miramax's argument that the trailer for *The Big One* poked fun at *Men in Black* by suggesting that an average, out-of-shape documentarian could assume a heroic role. The court found that the poster and trailer could not reasonably be perceived as commenting on or criticizing the ads for *Men in Black* that they imitated. The other fair use factors were no more help to Miramax, and the court found infringement.

In *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, the plaintiff brought suit alleging both copyright and trademark infringement against the publishers of a book written and illustrated in the style of Theodor S. Geisel, or "Dr. Seuss" as he was more commonly known. The book, *The Cat NOT in the Hat! A Parody by Dr. Juice*, commented on the murder trial of O.J. Simpson, making fun of the proceedings in rhyming doggerel, illustrated by numerous pictures of a cat and his distinctive striped stovepipe hat.

In its copyright analysis, the court concluded that *The Cat NOT in the Hat!* was best described as satire. Although the book mimicked Dr. Seuss's distinctive style, it did not hold that style up to ridicule. The defendants argued that they had cast O.J. Simpson as the mischievous Cat in that he and his defense team committed "tricks" and other acts contrary to moral and legal authority, creating a horrible mess. (The original Cat in the Hat was a classic trickster figure, who created chaos to the delight of young children but left them with quite a mess to explain to adults.) The court rejected this defense as "'pure shtick' and "completely unconvincing".

The reasoning—or really, the announcement of a conclusion—in those two cases elides some troubling questions. Copyright law generally instructs courts not to pass judgment on the aesthetics of a work. Yet distinguishing parody from satire requires aesthetic

37. Id. at 1187. See also *Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co.*, 900 F. Supp. 1287, 1300 (C.D. Cal. 1995) (rejecting the parody defense when a car commercial took numerous elements from James Bond character and films; copying unnecessary to parody action film genre).

38. 109 F.3d 1394 (9th Cir.), cert. dismissed, 521 U.S. 1146 (1997).

39. See *id.* at 1401.

40. *Id.* at 1403 (quoting district court opinion).

41. See, e.g., *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 300 (1903) ("It would be a dangerous undertaking for persons trained only to the law to constitute
and literary judgment that the copied work is not in any way a target of criticism, and, in particular, it is far from clear that the Dr. Seuss court's view was correct. Perhaps Dr. Seuss's charming Cat is a bad guy, contrary to Dr. Seuss's sympathetic portrayal, by analogy to another charming rogue who may have gotten away with murder owing in part to his lawyers' Seussian flourishes. Perhaps it is not desirable to laud people (or cats) whose charm substitutes for good behavior. In any event, the court did not, and probably could not, explain why it was any less reasonable to perceive a criticism of Dr. Seuss's blithe paean to trouble making in The Cat NOT in the Hat! than to perceive a criticism of Roy Orbison's naïve portrait of street life in 2 Live Crew's "Pretty Woman." Given that fair use is an important outlet designed to reduce the tension between copyright and First Amendment interests, the "chilling effects" of such a fuzzy distinction should be of concern, and we should distrust the courts' ability to draw the right line.

Now contrast these results with those reached in two other significant fair use cases that found parody, rather than satire, in two arguably similar texts. The first case involved a well-known cover of Vanity Fair showing actress Demi Moore in a profile that emphasized the beauty of her pregnant body; the pose recalled classical portrayals of the goddess Venus. Paramount Pictures, promoting its upcoming film Naked Gun 33 1/3: The Final Insult, starring Leslie Nielsen, copied Annie Leibovitz's Vanity Fair photograph for the film poster, with the small difference that a diamond ring on Moore's hand was replaced with a tacky, obviously fake ring and the large difference that Paramount's version used Nielsen's head on top of a pregnant woman's body. Nielsen's jaw and eyes were positioned at roughly the same angle as Moore's, but whereas her gaze was serious, his was smirking.

themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. . . . At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge." (Holmes, J.).

42. E.g., "If it doesn't fit, you must acquit." See Ochoa, supra note 26, at 591-92 ("By placing O.J. Simpson in the Cat's hat, the authors not only comment on Simpson's evasion of responsibility for his actions, but they also subtly suggest that the Cat in the Hat may be seen as a sinister and dangerous figure, instead of the merely mischievous character depicted in the original work.").


44. See Leibovitz v. Paramount Pictures Corp., 137 F.3d 109 (2d Cir. 1998).

45. See id. at 111-12. Leslie Nielsen was also involved in the other successful defense of a humorous advertisement against copyright infringement claims: He played the bunny in a beer commercial mocking the form of Eveready's "Energizer Bunny" commercials. See Eveready Battery Co. v. Adolph Coors Co., 765 F. Supp. 440, 443 (N.D. Ill. 1991). As the Eveready court noted, Nielsen is known for his comic acting in movies that often contain substantial parodic elements. Id. at 443 n.7. These cases suggest that an advertiser
The court determined that the poster was clearly transformative, in that it added something new to the copyrighted work. Whether it commented on the original, as parody must, was a closer question. Ultimately, the court believed that, "because the smirking face of Nielsen contrasts so strikingly with the serious expression on the face of Moore, the ad may reasonably be perceived as commenting on the seriousness, even the pretentiousness, of the original."\(^{46}\) As a result, the fair use factors weighed in Paramount’s favor.\(^{47}\) Nonetheless, out of the obvious concern that every copier could claim to "comment" on an original, the court emphasized that the very seriousness of the original photograph invited humorous deflation.\(^{48}\)

The most significant copyright parody/fair use decision since *Campbell* is *SunTrust Bank v. Houghton Mifflin Co.*,\(^{49}\) which provoked national attention and discussion about the role of the First Amendment in copyright cases. Briefly, *SunTrust* concerned a book, *The Wind Done Gone*, that took characters and settings from Margaret Mitchell’s *Gone With the Wind* and retold the story from the perspective of a new character, Scarlett O'Hara’s illegitimate, mulatto half-sister. Overall, the notable feature of the retelling is that the white characters appear as ineffectual, stupid, or otherwise flawed, whereas the black characters are intelligent and active, in vivid contrast to their respective portrayals in *Gone With the Wind*.

Although the district court granted a preliminary injunction against publishing the book, the Eleventh Circuit granted expedited review and, at the conclusion of oral argument, lifted the injunction from the bench. The district court had found that there was no need to use *Gone With the Wind* to criticize slavery and the romanticized view of the antebellum South, which was (part of) *The Wind Done Gone*’s goal. Randall’s book simply used well-known characters to draw attention to her version of the story. As a result, the work was a satire and a sequel, not a parody, and had no legitimate claim to build on Margaret Mitchell’s copyrighted work.

The court of appeals, by contrast, held that the proper focus of the "parody" inquiry was whether the aim of the accused work was "to comment upon or criticize a prior work by appropriating

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\(^{46}\) *Leibowitz*, 137 F.3d at 114.

\(^{47}\) *See id.* at 115-16.

\(^{48}\) *Id.* at 114-15; *see also Campbell*, 510 U.S. at 599 (Kennedy, J., concurring) (expressing similar concern and arguing that burden on defendant to show parodic character should be significant).

\(^{49}\) 268 F.3d 1257 (11th Cir. 2001).
elements of the original in creating a new artistic, as opposed to scholarly or journalistic, work." The court found that The Wind Done Gone plainly acted as a "specific criticism of and rejoinder to the depiction of slavery and the relationships between blacks and whites" in Gone With the Wind. From the conclusion that The Wind Done Gone was a true parody, the lifting of the preliminary injunction inexorably followed.

The lesson to be learned from these four cases is that the distinction between parody and satire is in the eye of the presiding judge. It may be that the subjectivity involved in judging the type of transformation at issue leads some courts to keep their analysis brief, or nonexistent, perhaps implicitly recognizing that distinguishing parody from satire as a legal matter is a custom honored more in the breach than in the observance. For example, at least two artists who altered the BARBIE character's image by placing her in sexually explicit contexts have survived infringement allegations. In their opinions, the courts wasted little ink concluding that sexualizing BARBIE is a comment on BARBIE. This task may have seemed easy because, as one artist who works through the BARBIE image suggests, "Barbie is quite a loaded symbol. Put a Barbie next to just about anything and meaning will rear its ugly head. This little pink lady is just too well known..." Thus, potentially any unauthorized use of the BARBIE character could be interpreted as critical and transformative.

In another case, a man in a chicken costume whose act incorporated taunting and assaulting BARNEY (the large purple dinosaur) prevailed on summary judgment because the court found that his act commented both on the BARNEY character's pervasive

50. Id. at 1268-69.
51. Id. at 1269. The court, and Judge Marcus in concurrence, also noted that The Wind Done Gone contained homosexuality and miscegenation, two things the Mitchell estate would never allow in any authorized derivative work. This also favored a finding of fair use. See id. at 1270 n.26; id. at 1282 (Birch, J., concurring).
52. Professor Goldstein has argued that some courts have a similar propensity to declare nontransformative uses to be transformative in order to justify a finding of fair use. See Paul Goldstein, Fair Use in a Changing World, 50 J. Copyright Soc'y 133, 139 (2003).
53. See Mattel, Inc. v. Pitt, 229 F. Supp. 2d 315, 322 (S.D.N.Y. 2002) (denying plaintiff's motion for summary judgment against pro se defendant; finding that BARBIE head on doll body dressed in "bavarian bondage dress" was transformative; "[t]o the Court's knowledge, there is no Mattel line of 'S&M Barbie'; Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792 (9th Cir. 2003) (affirming summary judgment in favor of defendant who displayed photos, some sexually suggestive, of BARBIE dolls posed with kitchen appliances).
54. See, e.g., Walking Mountain, 353 F.3d at 802 (displaying the BARBIE image in ridiculous and/or sexual situations critiques her); Pitt, 229 F. Supp. 2d at 322.
commercial presence and on his lovable, "sissy" image.\textsuperscript{56} The district court held that the BARNEY character's presence at a sporting event was a comment on its pervasiveness: "Even the Chicken cannot get away from Barney."\textsuperscript{57} Then, the court stated, "[t]he parody . . . moves to another level as the lovable, sissy Barney character transforms into an egotistical urban rapper. . . ."\textsuperscript{58} The court did not explain what is parodic here or what lessons one ought to learn about the original from viewing the burlesque, implying that any role reversal would be parodic. The animated pornographic film \textit{Starballz} also avoided a preliminary injunction as a parody of the \textit{Star Wars} style.\textsuperscript{59} In this case, the full discussion was as follows: "\textit{Starballz} is a parody of \textit{Star Wars}, in that it is a 'literary or artistic work that broadly mimics an author's characteristic style and holds it up to ridicule.' . . . Lucasfilm is not likely to succeed in its copyright claim because the parodic nature of \textit{Starballz} may constitute fair use."\textsuperscript{60}

Interestingly, the one court to address the issue of whether consumer reaction can determine the parodic or satirical nature of a work rejected consumer survey evidence purporting to show that an infringing work's parodic character could not reasonably be perceived by its audience.\textsuperscript{61} Instead, the court held that whether a work is a parody is a question of law, because parody is "an objectively defined rhetorical device"\textsuperscript{62} that should not be subject to a majority's potentially censorious views but should be entrusted to a court. Curiously, and apparently seeing no contradiction, the court immediately followed this conclusion by quoting Justice Holmes's caution, reiterated in \textit{Campbell}, that "it would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of [a work]."\textsuperscript{63} Apparently, the court saw no contradiction in making itself the

\textsuperscript{56} Lyons P'ship, L.P. \textit{v.} Giannoulas, 14 F. Supp. 2d 947 (N.D. Tex. 1998), aff'd, 179 F.3d 384 (5th Cir. 1999).
\textsuperscript{57} Id. at 955.
\textsuperscript{58} Id.
\textsuperscript{60} Id. at 901 (citation omitted).
\textsuperscript{61} See \textit{Walking Mountain}, 353 F.3d at 801. But see Mattel, Inc. \textit{v.} Robarb's, Inc., 2001 WL 913894 (S.D.N.Y. Aug. 14, 2001) (holding that survey evidence showing a high level of consumer confusion as to source weighed against fair use because the confusion showed that there was no transformation "into a substantially new product that merits protection").
\textsuperscript{62} \textit{Walking Mountain}, 353 F.3d at 801.
\textsuperscript{63} Id. (quoting \textit{Campbell}, 510 U.S. at 582-83, itself quoting \textit{Bleistein v. Donaldson Lithographing Co.}, 188 U.S. 239, 251 (1903)) (alteration in original).
judge of the subtle shades of meaning in a work whose merit it was not qualified to judge.

**B. Practical Slipperiness**

The subtle literary divide between parody and satire becomes even more obscure when lawyers enter the picture. It should not be especially difficult, in most cases in which a copyrighted work is somewhat altered, to adduce testimony that the changes are, at least in part, a parody, attacking elements of the original. When “a fertile imagination or a literature degree” can define a work as parody instead of satire, we should be unsurprised that lawyers possessed of one (or both) can manipulate the distinction.

The controversy over *The Wind Done Gone* is illustrative. It was marked by self-serving testimony on both sides, identifying Alice Randall’s work as parody in a distinct African-American tradition or failing to find any humor in the book. Randall’s publisher revised the book jacket in order to label it a parody, a step that more likely reflected legal tactics than a marketing pitch to readers interested in parodies. In fact, before *Campbell*, humorous works often called themselves “satires”; now the preferred word is “parody.”

The Eleventh Circuit reacted to the battle of the experts in *SunTrust* by apparently dismissing both positions and articulating its own view of the extent to which *The Wind Done Gone* was a valid critique of themes in *Gone With the Wind*: “[T]he parodic character of *[The Wind Done Gone]* is clear. [It] is not a general commentary upon the Civil-War-era American South, but a

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65. See *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1269 n.23 (11th Cir. 2001); *SunTrust Bank v. Houghton Mifflin Co.*, 136 F. Supp. 2d 1357, 1373-74 & nn.8-11 (discussing competing expert opinions on presence or absence of parody in Randall’s work) (N.D. Ga.), rev’d, 268 F.3d 1257 (11th Cir. 2001). On SunTrust’s side, experts included Joel Conarroe, president of the John Simon Guggenheim Memorial Fund and himself a former Guggenheim fellow; Alan Leibchuk, a novelist; Gabriel Motola, emeritus professor of English at CUNY; and Louis Rubin, Jr., emeritus professor of English at UNC-Chapel Hill. On Houghton Mifflin’s side, the roster included Pat Conroy; Henry Louis Gates, Jr., chair of Afro-American studies at Harvard; Harper Lee; Barbara McCaskill, professor of English at the University of Georgia; Toni Morrison; and Anton Mueller, senior editor at Houghton Mifflin. Their affidavits and declarations, and many more, can be found at [http://www.houghtonmifflinbooks.com/features/randall_url](http://www.houghtonmifflinbooks.com/features/randall_url) (visited June 16, 2003).

66. See *SunTrust*, 136 F. Supp. 2d at 1376.

specific criticism of and rejoinder to the depiction of slavery and the relationships between blacks and whites in [Gone With the Wind]."\textsuperscript{68} The district court in the same case, however, had accepted the Mitchell Estate’s characterization of the work as a mere sequel and satire on antebellum Southern society:

Ms. Randall does not seek to simply criticize the treatment of black Americans in Gone With the Wind’s fictional time but also to comment upon the treatment of black Americans in the South in the 1930’s, 1940’s and 1950’s as well as today. A parody, however, does not gain protection of the fair use doctrine if it merely uses the protected work as a means to ridicule another object.... [T]he book’s overall purpose is to create a sequel to the older work and provide Ms. Randall’s social commentary on the antebellum South.\textsuperscript{69}

As the two opinions show, it will rarely be difficult to make arguments that any particular fictional or artistic transformative use is a satire or a parody, depending on one’s side.

In Leibovitz v. Paramount Pictures,\textsuperscript{70} similar wordplay occurred. Paramount’s executive Vice President for Creative Advertising stated that she believed that the Naked Gun 33 1/3 ad “lampooned the controversial and “serious” Moore Photo, [and] was perfectly in keeping with the Naked Gun brand of irreverent parodic humor.”\textsuperscript{71} Other defense testimony claimed that “[f]rom the outset, [the ad] was intended to make a mockery of an image that had become a ‘cultural icon.”\textsuperscript{72} Although the court of appeals noted that there was no evidence that the person who created the ad was aware that Naked Gun 33 1/3 in fact dealt with themes of pregnancy and childbirth,\textsuperscript{73} the claim of parody proved fatal to Leibovitz’s case. Nonetheless, she could plausibly have claimed that, like Justice Kennedy’s example of a rap version of “Achy Breaky Heart,” the ad was merely a grotesque version of the photograph that added no critical insights.\textsuperscript{74}

Abilene Music, Inc. v. Sony Music Entertainment, Inc.,\textsuperscript{75} provides an equally subjective evaluation. The opinion discusses

\textsuperscript{68} SunTrust, 268 F.3d at 1269; see also id. at 1269 n.23 (rejecting reliance on “assistance from experts”).

\textsuperscript{69} SunTrust, 136 F. Supp. 2d at 1374-78 (footnote and citation omitted).

\textsuperscript{70} 948 F. Supp. 1214 (S.D.N.Y. 1996), aff’d, 137 F.3d 109 (2d Cir. 1998).

\textsuperscript{71} Id. at 1216.

\textsuperscript{72} Id. at 1221.

\textsuperscript{73} See Leibovitz, 137 F.3d at 111.

\textsuperscript{74} See Campbell, 510 U.S. at 599 (“Almost any revamped modern version of a familiar composition can be construed as a ‘comment on the naiveté of the original.’... Just the thought of a rap version of Beethoven’s Fifth Symphony or ‘Achy Breaky Heart’ is bound to make people smile.”) (Kennedy, J., concurring) (citation omitted).

\textsuperscript{75} 320 F. Supp. 2d 84 (S.D.N.Y. 2003).
the use of modified lines from the famous song "What a Wonderful World," and takes pains to emphasize that alteration of the tone, lyrics and musical features makes the use a parody of the original, a commentary "on the innocence reflected in the lyrics of the original, in order to drive home its own message [that the world is corrupted with crime and drugs] more effectively." 76 By contrast, the court asserts, uses of the same song over images of a corrupt and dystopian world constitute commentary on the world, not on the song. 77 This distinction is, to put it mildly, not self-evident; shifting the depiction of corruption from sound to vision still leaves us with a naive song in a cynical world.

C. Conceptual Flaws in the Parody/Satire Distinction

Assume for argument's sake that observers generally will be able to agree that an accused work is a parody or a satire. That still does not make the distinction particularly useful for determining whether the work is a fair use. A literary label is less important than consideration of the four fair use factors taken together.

A rare example of the proper analysis is Kane v. Comedy Partners, which did not rely on literary terms to make legal judgments. 78 In Kane, The Daily Show, a Comedy Central staple, mocked cable television's public access channels with a segment called "Public Excess." To illustrate its view of the "merits" of public access television, it used a brief clip from The Sandy Kane T.V. Show, a public access program hosted by a former stripper and comedienne whose signature song is "I Love Dick." That clip was used to introduce the "Public Excess" segment and also incorporated into a commercial promoting The Daily Show. Kane sued for infringement.

In its fair use analysis, the court acknowledged that, "unlike a parody," Comedy Central's use did not alter a "famous work" for the purpose of commenting on it. It found that the only similarity between parody and Comedy Central's use was "the element of ridicule." The court seems to mean that quoting, as opposed to rewriting with the addition of new material as in Campbell and SunTrust, cannot properly be described as either parody or satire. Nevertheless, it was the ridicule that counted; the "derisive commentary" made the use transformative. 79

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76. Id. at 90.
77. See id. at 92.
79. Williams v. Columbia Broad. Sys., Inc., 57 F. Supp. 2d 961 (C.D. Cal.), vacated by consent, 1999 WL 1260143 (C.D. Cal. Dec. 21, 1999), also followed Campbell's more nuanced approach. Williams involved a "spirit message" from an Army unit that was broadcast
The other notable feature of *Kane* was the court's marketplace effect analysis: The plaintiff was apparently willing to license parodies and other critical uses; she just wanted to be paid.80 Finding that her desire for compensation could not be taken into account because it risked a troubling circularity in the analysis, the court instead held that Comedy Central's critical use did not run a risk of supplanting the original, and thus would not harm the plaintiff's market.81

*Kane* points to a serious weakness in current legal treatment of parody. Historically, courts have given parodies more leeway than satire, based in part on the notion that copyright owners are unlikely to develop a market for authorized parodies that, unlike satire, poke fun directly at the copyright owner's work.82 Because the market effect prong of the fair use analysis finds harm only when the defendant's use affects markets that copyright owners are reasonably likely to develop,83 parodies fare better than satire under this factor.

The fatal flaw in this logic is that "parody" is not a good proxy for "markets that copyright owners are unlikely to develop," especially when it is juxtaposed with "satire."84 The fundamental

during the 1997 Army-Navy football game. The message showed an animated clay “Sailor Bill” experiencing trauma at the hands of the Army. The court rejected a parody defense, finding that “Sailor Bill” did not comment on the misfortunes of the copyrighted clay character “Mr. Bill,” but merely showed a clay figure suffering similar harms. Nonetheless, the court accepted a fair use defense, because the other factors, particularly the effect on the market, did not favor the plaintiff. See id. at 970; see also MasterCard Int'l Inc. v. Nader 2000 Primary Comm. Inc., 70 U.S.P.Q.2d 1046, 1059 (S.D.N.Y. 2004) (relying on Campbell's statement that less parodic content is required where the likelihood of market substitution is low).

80. See *Kane*, 68 U.S.P.Q.2d at 1752.
81. See id. at 1753.
82. *Campbell*, 510 U.S. at 592 ("[T]he unlikelihood that creators of imaginative works will license critical reviews or lampoons of their own productions removes such uses from the very notion of a potential licensing market. ‘People ask ... for criticism, but they only want praise.’") (quoting Somerset Maugham, *Of Human Bondage* 241 (Penguin ed. 1992)); *SunTrust*, 268 F.3d at 1270 n.26 (holding that parody's references to homosexuality and miscegenation took on “special relevance” to the market-harm analysis, favoring fair use, because evidence showed that copyright owner would not license any works making such references).
83. See *American Geophysical Union* v. *Texaco*, Inc., 60 F.3d 913, 930 (2d Cir. 1994) ("only traditional, reasonable, or likely to be developed markets" are relevant to market-effect analysis) (citing *Campbell*); *Twin Peaks Prods., Inc. v. Publications Int'l, Ltd.*, 996 F.2d 1366, 1377 ("In the cases where we have found the fourth factor to favor a defendant, the defendant's work filled a market niche that the plaintiff simply had no interest in occupying."); cf. *Campbell*, 510 U.S. at 592 ("The market for potential derivative uses includes only those that creators of original works would in general develop or license others to develop.").
84. Moreover, satire is just as unlikely to substitute for the original as is parody: no child would demand (or accept) *The Cat NOT in the Hat!* instead of *The Cat in the Hat*. Yet, after determining that the defendants' use was not "transformative" because it was satirical rather than parodic, the *Dr. Seuss* court went on mechanically, and preposterously, to
premise that copyright owners will not create or license parodies of their works is belied by marketplace evidence. Sandy Kane is not alone in licensing her work for parodies. DC Comics' "Elseworlds" consist of numerous alternate versions of Batman, Superman and other superheroes, including several storylines in which the superheroes become supervillains and others played for laughs. DC also publishes Bizarro Comics, self-described parodies of Superman, Wonder Woman and the rest drawn by cartoonists such as Matt Groening, creator of The Simpsons. Its rival Marvel, meanwhile, teamed up with Archie Comics to bring the brutal crime-fighter The Punisher to the idyllic world of Archie, Betty, Veronica and Jughead. Copyright doctrine tells us that a comic book that makes Lex Luthor a brave hero fighting a dangerous Superman is a good candidate for a fair use-protected parody. DC, however, is ready, willing and able to make money off of it. Similarly, "Weird Al" Yankovic, known for humorous reworkings of popular songs such as "Eat It" (from Michael Jackson's "Beat It") and "Like a Surgeon" (from Madonna's "Like a Virgin"), has a practice of asking for, and a history of receiving, permission from

85. See SunTrust, 268 F. 3d at 1279 n.3 (Marcus, J., concurring) ("The irony and self-awareness common in contemporary literature, in particular, may one day pose difficulties for the fair use doctrine. It is not hard to imagine a copyrighted story that parodies itself, by design, or an author who makes a career out of parodying his own work in each subsequent one.").

86. See, e.g., Batman: Crimson Mist (2001) (Batman is a vampire); Batman: I, Joker (1998) (Batman is the bad guy, the Joker is the hero); Superman Inc. (1999) (Superman is an athletic superstar and media hound); Superman/Wonder Woman: Whom Gods Destroy (1997) (Superman is turned into a teenage girl—not, incidentally, for the first time in his long and tangled history); Legend of the Dark Mite, in Batman: Collected Legends of the Dark Knight 84 (1993) (Batman is a dwarf with magical powers).


88. See The Punisher Meets Archie (1994) (the subtitle reads The Crossover You've Been Dreading!).

89. See Man of Steel: Lex Luthor (forthcoming 2004); Matt Brady, Brian Azzarello Talks Lex Luthor (available at http://198.65.99.89/forums/showthread.php?s=&threadid=5044) (visited Apr. 22, 2004) (quoting DC Comics writer who states that "I'm trying to change people's minds about Superman. . . . Luthor might have a point, and maybe he's right."); see also John M. Ford, How Much for Just the Planet? (1987) (official Star Trek novel that parodies conventional Star Trek plots); Electronic OtherRealms, Winter 1987, available at http://www.plaidworks.com/ehuq Olsen/Downloads/OtherRealms/19-08.txt (visited Sept. 20, 2003) ("The last people you would expect to publish a parody of Star Trek would be Pocket. Pocket, however, has . . . [The result is] one of the most bizarre plots you'll ever see.").


91. "Weird Al" Yankovic, Dare to Be Stupid (Way Moby/Volcano 1985).
copyright owners, even though he has strong parody/fair use arguments for at least some of his songs.\textsuperscript{92}

In fact, as an economic matter, authorized parody makes even more sense for a multimedia conglomerate that owns many kinds of intellectual property. \textit{Scary Movie}, produced by Dimension Films, is in large part a parody of \textit{Scream}, produced by Dimension Films.\textsuperscript{93} AOL-Time Warner, which owns the Hanna-Barbera cartoon \textit{Space Ghost}, also produces a parody, \textit{Space Ghost Coast to Coast}, that puts the former hero in the role of a talk show host. Fox News Corporation nearly sued itself over a \textit{Simpsons} parody of Fox News, but reason prevailed at the last minute and the parody went unchallenged.\textsuperscript{94} Taking these developments to their natural conclusion, some lawyers now advise copyright owners affirmatively to develop and license parody markets, so that they will be able to show market harm should their works be parodied \textit{without} authorization.\textsuperscript{95}

Authorized parody is an instance of the ever-present risk of circularity in market harm analysis: Without an external limiting principle, all uses harm copyright owners' markets, in the sense that the copyright owner could always be paid for every use.\textsuperscript{96} The

\textsuperscript{92} See Frequently Asked Questions—and the Answers! http://www.weirdal.com/faq.htm ("Al does get permission from the original writers of the songs that he parodies. While the law supports his ability to parody without permission, he feels it's important for him to maintain the relationships that he's built with artists and writers over the years.") (visited Mar. 13, 2002); Chuck Miller, "Weird Al" Yankovic: Polkas, Parodies and the Power of Satire, at 4, http://members.aol.com/boardwalk7/Yankovic.pdf (visited Oct. 30, 2003) (noting that one writer of "I Love Rock and Roll" not only approved the parody "I Love Rocky Road," but helped Yankovic find a producer); see also Dan Strack, Gaijinity, Ltd. Presents the Music of Dan Strack (available at http://www.gaijinity.com/parodylyrics.html) (noting that the Rolling Stones granted permission for parody in return for royalties, resulting in the Japanese-influenced "I Can't Get Noh Satisfaction"); Kurt Cobain: The Lost Interview Part 2, http://www.guitarworld.com/artistindex/9611.cobain.html (visited Mar. 13, 2002) (discussing Nirvana-approved parody of "Smells Like Teen Spirit," "Smells Like Queer Spirit").

\textsuperscript{93} See also William M. Landes & Richard A. Posner, The Economic Structure of Intellectual Property Law 151 n.12 (2003) ("Universal Pictures, which produced \textit{Abbott and Costello Meet Frankenstein}, was the owner of the three earlier horror films that it spoofed.") (citing Don Harries, \textit{Film Parody} 19 (2000)). The owners of the James Bond copyrights and trademarks also dropped their objection to the title \textit{Austin Powers in Goldmember}, as part of a deal to get trailers for Bond movies shown before the Austin Powers movie. \textit{See The Gold Standard: Member v. Finger}, N.Y. Post, July 23, 2002 (available at 2002 WL 22355859).

\textsuperscript{94} See Fresh Air, Oct. 23, 2003 (available at 2003 WL 56730786) (interview with \textit{The Simpsons} creator, Matt Groening).

\textsuperscript{95} See Jay Flemma, \textit{The Wind Done Got Away With It}, http://www.alanbergman.com/parody.pdf, at 11 (n.d., visited Aug. 12, 2003) ("[T]he client should explore the benefits of entering into favorable parody licensing arrangements and other derivative markets.... This 'use it or lose it' analysis of derivative markets could grow to encompass parody licenses.").

\textsuperscript{96} This circularity has been repeatedly noted. \textit{See, e.g., Princeton Univ. Press v. Michigan Document Servs.}, 99 F.3d 1381, 1387 (6th Cir. 1996) (en banc), cert. denied, 520
limiting principle generally offered to support parodies is that, because society is better off when people can freely parody other works, the market for parody should not be monopolized by the copyright owner.

If this is so, then the parody/satire distinction becomes even more mysterious. Just as society is better off when people can parody existing works, it is better off when people can freely satirize them. It is said that no satirist needs to start with a copyrighted work in order to achieve that goal, but that argument is extremely weak. A parodist could also in theory always parody something else. Moreover, courts generally are unwilling to suppress speech because it might have been said another way: If a speaker believes that certain words or images are the most effective way to communicate, a court has little business disagreeing with him or her. That is why the Supreme Court protected Paul Cohen's right to wear a jacket proclaiming "Fuck the Draft" in public: "[W]e cannot indulge in the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process." Thus, a satire may provide a uniquely effective social commentary whose effect could not have been achieved in a completely new work or a satire of a public domain work.

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97. The public's interest in having access to broad-sweeping satires might, if anything, be greater than that in having access to parodies of more limited cultural relevance. It is this, rather than the range of derivative works a copyright owner might authorize, that provides the proper baseline for determining the copyright owner's legitimate markets. See *Carol Publg*, 150 F.3d at 145 n.11 (assuming that most copyright owners would not license parodies, but noting danger of allowing copyright owners to define their own markets); see also *Leibowitz v. Paramount Pictures Corp.*, 137 F.3d 109, 115 n.3 (2d Cir. 1998) ("[T]he fair use doctrine is broad enough to protect even those commentaries that are not so damaging that the original author would refuse to license them for a fee. A parodist need not demonstrate that the copyright owner would prohibit the use in order to qualify the copy as fair use under *Campbell*."

98. *Cohen v. California*, 403 U.S. 15, 26 (1971); see also *Meyer v. Grant*, 486 U.S. 414, 424 (1988) (First Amendment protects individuals' right "not only to advocate their cause but also to select what they believe to be the most effective means to advocate their cause"); *Turner Broad. Sys. Inc. v. FCC*, 512 U.S. 622, 675 (1994) (O'Connor, J., concurring in part and dissenting in part) ([As we know from the example of publishing houses, movie theaters, bookstores and Reader's Digest, communication occurs in selecting which speech to copy and distribute no less than in creating the speech in the first place.]).

99. See Kozinski & Newman, supra note 35, at 517 ("Even if the original work is used only as a vehicle, not just any vehicle will get you where you want to go. ... When this kind of satire really works well, it's because there is something about the original that fits—or pointedly doesn't fit—the subject"); giving example of a character playing Paula Jones singing "Don't Cry for Me Judge Scalia," with its evocation of Evita Peron; Robert P. Merges, *Are You Making Fun of Me?: Notes on Market Failure and the Parody Defense in Copyright*, 21 AIPLA Q.J. 305, 311 (1993) ("a parodist's choice of a particular weapon ... is
In short, the “unlikely licensing” argument never made much sense as a way to explain why parody in particular, but not satire, can be fair use. No uptight copyright owner is going to authorize derivative works that satirize society at large while refusing to authorize parodies of the copyrighted work itself.100

D. Conclusion

The parody/satire distinction is difficult to make, may lead to the suppression of constitutionally protected speech and lacks a logical connection to the economic justification for copyright. It should be abandoned in favor of a fair use analysis that finds addition of critical insights—about the original work or society in general—to be favored uses, without judging the merits of those insights. There are no easy answers in fair use law; attempting a shortcut by way of the parody/satire distinction has led courts into error.

IV. CAMPBELL’S EFFECT ON TRADEMARK INFRINGEMENT CASES

Campbell’s application has not been limited to copyright. Courts increasingly have analyzed trademark parodies using a variant of the Campbell fair use test,101 although a judge’s subjective reaction to an alleged parody may still be as important as any enunciated principle of law. In fact, reliance on Campbell to aid trademark infringement analysis tends to obscure the ultimate issue in any infringement case: the likelihood of confusion. This section explains how Campbell has been partially imported into not accidental”); Ochoa, supra note 26, at 596-97 (arguing that works under copyright, which are more current than most public domain works, may be better targets for parody because they are better known, and that the choice of a particular work to parody is an artistic decision worthy of respect).

100. See Kozinski & Newman, supra note 35, at 518; Merges, supra note 99, at 311; Ochoa, supra note 26, at 610-11 (criticizing the idea that copyright owners might license satires more readily than parodies and relating instances of satirists denied permission to use copyrighted works because copyright owners fear association with the satirists’ views).

101. See, e.g., Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 901 (9th Cir. 2002) (applying Campbell’s requirement that parody must target the original); Harley-Davidson, Inc. v. Grottanelli, 164 F.3d 806, 813 (2d Cir. 1999) (“[W]hatever protection is to be afforded a trademark parody must be informed by the Supreme Court’s elucidation in the copyright context of parodies allegedly protected by the defense of fair use.”); Elvis Presley Enters., Inc. v. Capece, 141 F.3d 188, 199 (5th Cir. 1998) (“[R]ecently . . . the Supreme Court considered parody in the copyright context, which is relevant to the treatment of parody in the trademark context.”); Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1406 (9th Cir.) (finding that “The Cat NOT in the Hat!” was parody, not satire), cert. dismissed, 521 U.S. 1146 (1997); see also Gary Myers, Trademark Parody: Lessons from the Copyright Decision in Campbell v. Acuff-Rose Music, Inc., Law & Contemp. Probs., Spring 1996, at 181.
trademark infringement cases, with special attention to the doctrine of nominative fair use, which is based on related concerns for freedom of speech. It also briefly examines trademark dilution cases, which have, perhaps oddly, not been much affected by *Campbell*.

**A. Parody and Satire in Trademark Infringement Cases**

As in copyright, the parody/satire divide is unhelpful in addressing the central question in trademark infringement cases: whether the defendant's use is likely to cause confusion among a substantial number of consumers. If a joke is recognizable as a joke, consumers are unlikely to be confused, and whether the butt of the joke is society at large, or the trademark owner in particular, ought not to matter at all.\(^{102}\)

An additional wrinkle is that trademark owners, like copyright owners, are increasingly willing to authorize activities that could be understood as mocking the mark.\(^{103}\) One recent example is that of "rivalry figurines" that show one university team's mascot beating up on a caricature of another team's mascot; Georgia fans may buy a figurine showing a large Georgia bulldog mauling a tiny Florida 'Gator, while Florida fans may buy the opposite figurine.\(^{104}\) Both schools authorized the use of their mascots.

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102. See, e.g., *MasterCard Int'l Inc. v. Nader 2000 Primary Comm., Inc.*, 70 U.S.P.Q.2d 1046 (using standard likelihood of confusion test and holding that evidence that viewers got the joke could not support a finding of confusion); *Yankee Pub'g Inc. v. News America Publ'g Inc.*, 809 F. Supp. 267, 273 (S.D.N.Y. 1992) (holding that identifiable "jest or commentary" is unlikely to cause confusion); *Eveready Battery Co. v. Adolph Coors Co.*, 765 F. Supp. 440 (N.D. Ill. 1991) (same); 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:155, at 31-261 (4th ed. 2002) ("If the difference in wording or appearance of the designation together with the context and overall setting is such as to convey to the ordinary viewer that this is a joke, not the real thing, then confusion as to source, sponsorship, affiliation or connection is unlikely."). Courts have also been willing to find infringement when there does not seem to be any joke to get. See, e.g., *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 463 (7th Cir. 2000) (upholding preliminary injunction against an herbal antidepressant product, HERBROZAC, that capitalized on the fame of PROZAC), and when a motorcycle mechanic used an altered version of the HARLEY-DAVIDSON logo in his own logo. See *Harley-Davidson*, 164 F.3d at 812-13 (affirming judgment against defendant based on use of confusingly similar logo; applying *Campbell* to trademark context and finding that defendant's use made no comment on plaintiff's mark).

103. But see Michael K. Cantwell, *Confusion, Dilution, and Speech: First Amendment Limitations on the Trademark Estate*, 87 TMR 48, 62 (1997) ("Given the dearth of self-parody in this world, however, the danger of confusing the subject of a parody with its author seems remote at best. . . .").

This trend not only makes it more difficult for consumers to tell when "jokes" are unauthorized, it also further erodes the parody/satire distinction. These trademark owners clearly are parodying themselves rather than satirizing society, perhaps in order to attract the attention of irony-loving consumers. Even aside from cases of self-mockery, the labels of parody and satire can be particularly unhelpful and distracting when trade dress is at issue because those terms usually are applied to writings rather than, for example, a rubber version of an HERMES bag.

To take an example from a recent case, it is difficult to discern any conceptual or even practical advantage in characterizing T-shirts that caricature pro wrestlers as dogs as "parodies" of the World Wrestling Federation, rather than as satire. It is a fair question to ask how it would even be possible to parody pro wrestling. In the case of the wrestling dogs, the court felt compelled to opine that, with "dogified" T-shirts, "we are reminded that we are free to laugh at the images and associations linked

There's a growing demand for "rivalry merchandise" in which ... "two schools allow their trademarks to appear on the same item, even if one team is being throttled, humiliated or labeled as a loser." ... Why would schools agree to such a practice? Money. The two schools share the revenue that the merchandise makes and often argue that it simply highlights the traditions of their rivalries. According to Ron Bohler, licensing director of Memory Co., the market leader in nonapparel rivalry products, "sometimes their logic is elusive." This year, rivalry products account for 15 percent of its sales, up from 5 percent in 2002. ... 25 colleges have approved merchandise that depict their mascots being boiled alive in soup pots.

Melissa Costa, Colleges Profit from 'Rivalry Merchandise,' U-Wire, Dec. 4, 2003. The Wall Street Journal offered further information about the trend. Perhaps unsurprisingly, the school depicted as dominating gets more of the licensing revenue, because its partisans buy more of the merchandise. Moreover, fans' tastes are leading sellers to push colleges to license more explicit and/or more violent images, in part in order to compete with cruder bootleg rivalry merchandise. See Jeffrey Zaslow, Colleges Get a Cut from Being Kicked When They're Down: Sports Fans Snap Up Souvenirs of Winners Beating Losers; Mascot Boiled or Grilled? Wall St. Journal, Nov. 12, 2003. Thus, trademark owners may be in the same situation as copyright owners, able to claim that there is direct market competition between authorized and unauthorized parodies. The Wall Street Journal recounts one situation in which a Florida State Heisman Trophy candidate pleaded guilty to petty theft, and an entrepreneur sold thousands of "Heistman Trophy" shirts to University of Florida fans. When threatened by the colleges' licensee, the entrepreneur claimed First Amendment protection for his parody, and no litigation ensued. See id.


See Ginia Bellafante, A "Satire" of a Classic Fails to Amuse the August House of Hermès, N.Y. Times, Aug. 12, 2003, at B8; see also Kate Betts, Cartoon Couture, Time, July 28, 2003, at 69 (labeling "Jelly Kellys" "tongue-in-chic"); Style Watch, People, Aug. 11, 2003, at 115 (calling bags "whimsical" and "the season's classiest beach bag").
with these icons.”

A different court took a more realistic approach when it discussed a comic character whose appearance and background resemble the character portrayed in Charles Atlas bodybuilding ads, but who used his newfound strength to be a misogynist bully. It stated, “This court fails to discern a substantive difference between ‘surrealism’ or ‘irony’ on one hand [as the plaintiff described the defendant’s character], and ‘parody’ on the other, much less do we find them to be mutually exclusive.”

The court went on to note that the character serves mainly as an implicit criticism of other superheroes—that is, its critical force was not directed mainly at Charles Atlas ads—and that such commentary was “precisely the type of expression of ideas that the First Amendment is designed to protect.” As many courts facing similar cases do, the court hedged its bets by running through the ordinary confusion factors and finding that they favored the defendant, while also suggesting that the plaintiff’s burden of showing confusion was somehow higher than in an ordinary case because of the First Amendment concerns involved.

When courts do use the parody/satire distinction, they can easily go astray. In *Dr. Seuss Enterprises*, the plaintiff convinced the court that the defendants’ infringement of copyright also justified an injunction based on potential consumer confusion. Analyzing the trademark claim, the Ninth Circuit noted that parody is not truly a separate defense to trademark infringement, but an explanation of why, in a particular case, a defendant’s use of a mark is unlikely to cause consumer confusion: If consumers get the joke, they will understand that a humorous use is not authorized by the trademark owner. That is correct. The Ninth Circuit, however, then went off track. Its earlier conclusion that *The Cat NOT in the Hat!* was satire led it to deny that reasonable consumers would get the (satiric) joke.

Another aspect of the problem with borrowing from *Campbell* to decide trademark cases is that “parody” is just as subject to manipulation by clever parties or courts in trademark as in

108. *Id.* at 446.


110. *Id.*

111. *See id.* at 339-40 (holding that the absence of actual competition or bridging the gap, the sophistication of comic buyers, and the long period of time without reported instances of confusion indicated that confusion was not likely).

112. *See id.* at 337 (holding that First Amendment concerns justified tolerating some risk of confusion).

copyright. In one case, the court was confronted with TIMMY HOLEDIGGER perfume for dogs modeled on TOMMY HILFIGER perfume. Although the defendant “had difficulty expressing the parodic content of his communicative message,” the court concluded that “trademark parodies ... do convey a message. The message may be simply that business and product images need not always be taken too seriously ...”114 If that is all that is required for a parody, almost anything could qualify, including what another court might call “satire.”

This indeterminacy proved significant in Elvis Presley Enterprises, Inc. v. Capece,115 in which the district court and the court of appeals disagreed on the significance of the defendant's expressed desire to mock (yet pay homage to) the type of kitsch evoked by the phrase “velvet Elvis.” The district court determined that “velvet Elvis” necessarily implied a certain type of tackiness, distinct from the message conveyed by “Elvis” alone, and that use of “Velvet Elvis” as a parodic restaurant name was therefore justified.116 The court of appeals, however, found this to be simply satire, because the defendant intended to make fun of pretentious restaurants and of the time during which velvet Elvises were popular, neither of which criticized Elvis directly.117 This seems a very fine (albeit pomaded) hair to split. The real issue, whether the name caused confusion, risked getting lost in the shuffle, though evidence of actual confusion helped the trademark owner considerably.

Because confusion is the touchstone, the obviousness of the joke, regardless of its true humor value or categorization, ought to be the dominant focus.118 Furthermore, because humor often is premised on the recognition that the joke is on the trademark owner, the standard likelihood of confusion factors, like the copyright fair use factors, have to be applied differently in parody


115. 141 F.3d 188 (5th Cir. 1998).

116. See id. at 195.

117. See id. at 200.

118. See, e.g., Kane v. Comedy Partners, 68 U.S.P.Q.2d 1748, 1753-54 (S.D.N.Y. 2003) (finding no infringement when television show played a clip from another show because it was “clear that someone else’s work is being displayed and ridiculed”); Charles Atlas, 112 F. Supp. 2d at 338-41 (finding that a comic showing a weakling turning into a bully after bodybuilding was critical and therefore noninfringing and nondiluting); New York Stock Exch., Inc. v. New York, New York Hotel, LLC, 69 F. Supp. 2d 479, 485 (S.D.N.Y. 1999) (replica of the façade of New York Stock Exchange, in casino with New York theme, and use of name “New York Slot Exchange” on replica and “New York Slot Exchange” for players’ club, was whimsical and an obvious pun on similarities between gambling and stock investing, and thus nonconfusing), aff’d in relevant part, 293 F.3d 550 (2d Cir. 2002).
cases. Just as parody may take the “heart” of a nonfactual, highly creative work and still be a fair use, a joke may target a strong mark without causing any confusion, even though copying a strong mark usually weighs against a defendant. When a humorist targets a strong mark, consumers can more easily discern whether the mark owner is likely to have authorized the parody because they know very well how the owner wishes its mark to be portrayed. For that reason, in the case in which “The Famous Chicken” battled a purple dinosaur who looked similar to the BARNEY character, but was not kind, gentle and loving like the “real” BARNEY, the court found that confusion was unlikely. 119

Similarly, when Jim Henson Productions decided to add a warlike, but ultimately friendly, puppet pig character named Sp'am to its film Muppet Treasure Island, Hormel, the producer of the processed meat product SPAM, sued for both infringement and dilution. The Second Circuit reiterated that a parody of a strong mark is less likely to be confusing than a parody of a weak mark. 120 The appellate court also noted that the Muppets were well known for parodies, which would increase the likelihood that viewers would expect and get the joke. 121

B. Parody and the Problem of Nominative Fair Use

In addition to Campbell’s parody/satire distinction, other copyright concepts have crept into trademark cases. (Perhaps this cross-fertilization is easier because parody often spawns both copyright and trademark claims.) In the Lyons case, for example, the court echoed the copyright fair use test when it noted with approval that the Chicken “used the minimum necessary to evoke Barney”—a purple dinosaur with the distinctive gait of BARNEY, but none of the friends or songs of BARNEY. 122 A straightforward trademark analysis would have focused solely on literal similarities and dissimilarities between the marks, not on the concept of minimal copying. That traditional focus, along with an

119. See Lyons P’ship, L.P. v. Giannoulas, 179 F.3d 384, 389 (6th Cir. 1999), affg 14 F. Supp. 2d 947, 952 (N.D. Tex. 1998). The plaintiff also argued that the BARNEY character was not a necessary target of the Chicken’s wrath, but the court disagreed because the parody targeted BARNEY himself. See Lyons, 14 F. Supp. 2d at 953.
120. Hormel Foods Corp. v. Jim Henson Prods., Inc., 73 F.3d 497, 503 (2d Cir. 1996). The presence of a variant of the defendant’s house mark was also a factor: Spa’am’s name would only be used along with his picture and the title of the movie, decreasing the similarity between SPAM and Spa’am. See id. at 503-04.
121. See id. at 503. In light of this observation, perhaps the best parody an advertiser could come up with would star Leslie Nielsen and the Muppets. See supra note 45.
122. Lyons, 179 F.3d at 388; see also Lyons, 14 F. Supp. 2d at 955 (defendant did not copy the full BARNEY costume, other characters, words, music, or songs from plaintiff’s works, which decreased the chance of confusion).
analysis of the obviousness of the joke, seems much more helpful in determining likely consumer confusion than an inquiry into whether less copying could still have made the parodic point. Still, as noted above, parody's deliberate copying does require somewhat different treatment than the activities that normally give rise to infringement litigation.

One particularly interesting way in which courts have dealt with trademark parody is by employing the concept of nominative fair use, which either supplements or supplants the traditional multifactor confusion analysis. Nominative fair use, a concept devised by the Ninth Circuit, allows people to speak about trademarked products without permission, as long as they satisfy three criteria:

First, the plaintiff's product or service in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the plaintiff's product or service; and third, the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.

For example, Mattel lost its infringement suit against the record company distributing the Swedish group Aqua's novelty song "Barbie Girl" (sample lyrics: "I'm a Barbie Girl/In a Barbie World/Life is plastic, it's fantastic/You can brush my hair, undress me everywhere...."). The district court found that mocking BARBIE and the plastic values she sometimes symbolizes was a

123. Some courts have suggested that nominative fair use is a replacement for confusion analysis, such that the court need not consider other factors, even evidence of actual confusion. Cairns v. Franklin Mint Co., 292 F.3d 1139 (9th Cir. 2002), explicitly states that nominative fair use "replaces" traditional confusion analysis, rather than "complement(Jing)" it, and contrasts nominative fair use to classic descriptive fair use, which is not available as a defense in the Ninth Circuit if there is a likelihood of consumer confusion. Id. at 1150-51. See also New Kids on the Block v. News America Publ'g, 971 F.2d 302, 307 (9th Cir. 1992) (holding that nominative fair uses are uses "to which the infringement laws simply do not apply"). The Second Circuit has used similar concepts to determine when a special test should replace standard confusion analysis. See Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989) (holding that the Lanham Act applies to titles only where the public interest in avoiding confusion outweighs the First Amendment, and that this occurs only when a title has no artistic relevance to a work or is explicitly misleading as to source or content). Yet courts have also refused to apply the nominative fair use test where common sense suggests that confusion is more likely. See Abdul-Jabbar v. General Motors Corp., 85 F.3d 407 (9th Cir. 1996).

124. See New Kids, 971 F.2d at 308 (citation omitted); see also, e.g., Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792, 808-11 (9th Cir. 2003) (using the nominative fair use test to determine that photographs of BARBIE that did not infringe Mattel's copyright also did not infringe the BARBIE doll trade dress); Mattel, Inc. v. MCA Records, Inc., 28 F. Supp. 2d 1120, 1142-43 (CD. Cal. 1998), aff'd, 296 F.3d 894 (9th Cir. 2002) (suggesting that disclaimers were a favored way of establishing nominative fair use).

125. See MCA, 28 F. Supp. 2d at 1137.
legitimate parody. The court then applied the nominative fair use test and found the test satisfied because the song did not use more of the BARBIE image than was necessary. In the music video for the song and the CD packaging, for example, the singers did not adopt the likeness of the dolls. The defendant did nothing else to suggest association and even included a disclaimer on some materials.

Although the result in the “Barbie Girl” case was correct, the use of “reasonably necessary” in the second part of the test is unsound, and has been discredited in copyright doctrine. As the Second Circuit pointed out in another Lanham Act case, a copyright parodist “is entitled ‘at least’ to conjure up the original and can do more.” Establishing a conceptual floor in the form of “no more than necessary” is too vague and manipulable and does not give sufficient leeway to free speech interests. The “reasonably necessary” standard needs refining and possibly rephrasing. Limiting the extent to which the mark is used (and the number of times it may be used) makes the most sense as applied to word marks. For example, use of the distinctive COCA-COLA font is much more likely to cause consumer confusion than use of “Coca-Cola” in Times New Roman. Nonverbal marks such as the famous COCA-COLA bottle, however, cannot be chopped up so easily, and the nominative fair use test should be sensitive to the differences between types of marks.

Instead of looking for “necessity,” the nominative fair use test should (and in practice often does) focus on whether the use is excessive in relation to the defendant’s purpose, as does the copyright fair use test. It should also give special leeway to nominative uses of images, as does the copyright fair use test.

126. See id. at 1136-40.
127. See id. at 1142 (setting forth elements of and rationale for nominative fair use defense).
129. See Cairns, 292 F.3d at 1154 (noting that “[w]hat is ‘reasonably necessary to identify the plaintiff’s product’ differs from case to case”).
130. See, e.g., New Kids, 971 F.2d at 308 n.7; Toho Co. v. William Morrow & Co., 33 F. Supp. 2d 1209, 1211 (C.D. Cal. 1998).
131: See, e.g., Cairns, 292 F.3d at 1153 (holding that the defendant could use photographs of Princess Diana, not just her name, in advertising its commemorative items depicting Princess Diana, because photographs were necessary to identify her to the broadest range of consumers); Playboy Enters., Inc. v. Welles, 279 F.3d 796 (9th Cir. 2002) (holding that multiple repetitions of plaintiff’s trademark in website wallpaper failed the nominative fair use test, but simple use to identify the defendant's status as former Playmate of the Year, even incorporated into defendant’s advertising, was nominative fair use).
132. See, e.g., Walking Mountain, 353 F.3d at 804 (suggesting in its copyright fair use analysis that, while songs, video, and written works “are naturally severable,” visual works...
When a defendant uses the minimum possible, such as an unadorned reference to a mark, this by definition should not be excessive because it is necessary for people to understand the reference. Yet more than the minimum can also be legitimate; in a later BARBIE case, the Ninth Circuit agreed that images of the entire doll could constitute nominative fair use, even though BARBIE would have been identifiable by more fragmentary images. Likewise, repeating “Barbie” in a song’s lyrics is acceptable, even if repeating a word mark in background images on a website advertising services is not. The former is part of a product, and a defendant’s judgment about what to include in an expressive product should be given more deference than its judgment about how to advertise its products or services. Defendants should not have to worry that courts will disagree with them about the minimum copying of a mark that is necessary to discuss or criticize it. Examining whether the copying is disproportionate would give more leeway in cases raising free speech issues.

133. This situation corresponds to the current formulation of the nominative fair use test, yet it was not followed in Abdul-Jabbar v. General Motors Corp., 85 F.3d 407 (9th Cir. 1996), in which the Ninth Circuit reversed a district court’s finding of nominative fair use when General Motors compared the plaintiff’s successful athletic career with the award-winning track record of its car. The plaintiff was not readily identifiable without use of his name; General Motors used only his name (actually, a name he himself no longer used), the absolute minimum possible; and it did nothing else to suggest endorsement. Literal application of the nominative fair use test would have exonerated General Motors. Cf. MCA, 296 F.3d at 902 (“The only indication that Mattei might be associated with the song is the use of Barbie in the title; if this were enough ... it would render Rogers a nullity.”). The court’s result may be defended on the ground that even the minimum may be too much when an advertiser invokes a celebrity’s accomplishments to tout its own product. The public may be likely to perceive any such mention as an endorsement. See Abdul-Jabbar, 85 F.3d at 413 (“[A] jury might find an implied endorsement in General Motors’ use of the celebrity’s name in a commercial, which would not inhere in a newspaper poll.”) (emphasis added). If that is the case, however, courts should admit that the nominative fair use defense is not available in classic advertising cases in which the reference to the mark is purely laudatory, although that would increase the uncertainty surrounding the defense. An even better response would be to make the presumption against confusion raised by a successful nominative fair use defense rebuttable in classic advertising contexts (“commercial speech” under the First Amendment) such as that involved in Abdul-Jabbar, while irrebuttable outside such contexts.

134. See Walking Mountain, 353 F.3d at 808-11.

135. The former was the situation in MCA, while the latter was the situation in Welles.

136. Cairns states that, where “the description of defendant’s product depends on the description of the plaintiff’s product, more use of the plaintiff’s trademark is ‘reasonably necessary to identify the plaintiff’s product.’” 292 F.3d at 1154, but that formulation does not explain the difference in outcome between MCA and Welles, both of which involved multiple repetitions of a word mark.
The Ninth Circuit affirmed the result in the "Barbie Girl" case, but did not rely on the nominative fair use defense. Instead, it invoked case law that states a special rule for titles, based on publishers’ First Amendment interest in identifying their literary products. Under this rule, titles are protected against Lanham Act challenges unless they are deceptive as to their contents (such as relabeling War and Peace as The Official Barbie Songbook) or confusingly similar to other titles. Unlike nominative fair use, this rule does not look to necessity, only to some minimal relationship between the title and the work’s content. In part because of this line of cases, Fox’s lawsuit against Al Franken for incorporating its trademarked slogan “Fair and Balanced” in the title of his recent book, Lies and the Lying Liars Who Tell Them: A Fair and Balanced Look at the Right, was just as unavailing in a court of law as it was counterproductive in the court of public opinion. The district and appellate court analyses in the “Barbie Girl” case differ from standard trademark parody analysis, which uses parody as a lens through which to view the likelihood of confusion factors. Essentially, the nominative fair use defense creates a shortcut for defendants who are using a mark to explain their own products or services, while the special rule for titles gives extra protection to books, movies and other products that consist of speech protected by the First Amendment. It remains somewhat unclear whether these tests are true substitutes for the standard confusion analysis or simply another way of stating that confusion is unlikely. This vagueness stems in part from the judicial tendency to rule for defendants on the dual grounds that the defendant made a nominative fair use and that there was no likelihood of confusion. Nonetheless, as a matter of doctrine, recognizing that these special-purpose tests are substitutes for confusion analysis makes more sense of them; if they are true supplements, there is no reason to go through such elaborate analysis in the first place.

137. See MCA, 296 F.3d at 901-02; see also Walking Mountain, 353 F.3d at 807 (applying rule on titles and finding that the use of the BARBIE mark to identify photographs of BARBIE was noninfringing).


139. See supra note 123.

140. See, e.g., Cairns, 292 F.3d at 1150, 1155 n.14.
C. Parodies as Dilution

Campbell's focus on the social value of criticism seems inherently to conflict with the idea of dilution through tarnishment. As a result, one would have thought that it would play a more prominent role in cases in which parodies were challenged on dilution grounds. In fact, courts generally have responded to parodies accused of dilution by ignoring the First Amendment value of parodic commentary141 or by defining dilution narrowly142 rather than by invoking Campbell-type First Amendment concerns as providing special solicitude for parodies. For example, the Ninth Circuit has adopted a rule that only narrowly "commercial" speech—in other words, advertisements—can be diluting.143 Many parodies will fall outside that category, as will many other uses of trademarks to which owners might object. Given the Supreme Court's apparent distaste for dilution,144 it appears that most courts will continue to feel little need to borrow from Campbell when analyzing dilution claims that are doomed on other, simpler grounds.145

V. PARODY AND THE RIGHT OF PUBLICITY

The expanding right of publicity often is joined with claims asserted under the Lanham Act.146 It is not surprising, then, that courts have incorporated trademark-like First Amendment and fair use defenses into their right of publicity analyses, even though confusion as to whether the plaintiff has endorsed the use of his or


145. See, e.g., MasterCard Int'l, 70 U.S.P.Q.2d at 1053-54 (holding that dilution claims against parody campaign ad failed because ad was not "commercial" speech but political and there was no evidence of actual or likely dilution); cf. Kane v. Comedy Partners, 68 U.S.P.Q.2d 1748, 1754 (S.D.N.Y. 2003) (dismissing state dilution claim because, oddly enough, there was no evidence of likely confusion).

146. See, e.g., ETW Corp. v. Jireh Pub'g, Inc., 332 F.3d 915, 924 (6th Cir. 2003).
her image is not an element of the right of publicity.\textsuperscript{147} This trend has also affected the right of privacy, a cause of action associated with the right of publicity. Thus, a model's right of privacy claim failed when a parodist spliced scenes from a sexually suggestive commercial in which she appeared with segments of other, sexually explicit footage. According to the court, the parody highlighted the exploitation of sexuality in the original commercial and constituted critical commentary deserving First Amendment protection.\textsuperscript{148}

If confusion is not required for a violation of the right of publicity, asking whether consumers get the joke will not help distinguish between legitimate and unlawful uses of celebrity images. Generally speaking, an individual's publicity right is violated simply when his or her image (or name or voice) is used without authorization for commercial gain. Right of publicity cases that challenge parodies thus often force a starker choice between free speech and intellectual property law than standard trademark and copyright cases.

This section focuses on two contrasting approaches to the problem taken by the Tenth Circuit and the California Supreme Court. The Tenth Circuit's analysis borrowed some concepts from \textit{Campbell} but ultimately was grounded in consumer protection law as limited by the First Amendment. The California Supreme Court, by contrast, freely adapted \textit{Campbell}'s endorsement of transformative use as a way of dividing simple celebrity merchandise from First Amendment-protected art: When the value of the artistic contribution to a product outweighs the value contributed by the celebrity image, there is no violation of the right of publicity.

The Tenth Circuit's approach is far more sound because it requires courts to do less of the art critic's job. In neither method of analysis is the parody/satire distinction helpful;\textsuperscript{149} rather, as the

\textsuperscript{147} See \textit{Geary v. Goldstein}, No. 91 Civ. 6222 (KMW), 1996 WL 447776, at *3 n.7, *4 (S.D.N.Y. Aug. 8, 1996) (holding that, though implied endorsement was not required to violate New York's statutory right of privacy, New York would exclude "satire" from scope of law, relying in part on First Amendment interests at stake); \textit{see also Kane}, 68 U.S.P.Q.2d at 1754 (finding that a mockery of plaintiff's public-access television show was newsworthy and thus outside the scope of New York's right to privacy, relying in part on free speech interests).

\textsuperscript{148} See \textit{Geary}, 1996 WL 447776. The court also rejected a defamation claim based on its conclusion that no reasonable viewer could infer that the model consented to the parody, a claim that strongly resembles a right of publicity claim. See \textit{id.} at *1-3.

\textsuperscript{149} See \textit{Winter v. DC Comics}, 69 P.3d 473, 479 (Cal. 2003) ("The distinction between parody and other forms of literary expression is irrelevant to the ... transformative test. It does not matter what precise literary category the work falls into. What matters is whether the work is transformative, not whether it is parody or satire or caricature or serious social commentary or any other specific form of expression."); \textit{Comedy III Prods., Inc. v. Gary Saderup, Inc.}, 21 P.3d 797, 809 (Cal. 2001) (holding that transformation "is not confined to

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California case in particular demonstrates, the trouble comes from the broader question of defining acceptable “transformation.” As with popular copyrighted works and trademarks, celebrity images may provide much of the inspiration for a new product, yet it may be unwise and even unconstitutional to let the celebrity have a monopoly over all such products.

The Tenth Circuit invoked the First Amendment to bar state law and Lanham Act claims against Cardtoons, a producer of parody baseball trading cards that sought declaratory relief against claims by the Major League Baseball Players Association.\(^{150}\) The trading cards mocked players’ public personae, with a special focus on their substantial salaries. The Tenth Circuit found that the cards were clearly parodies and thus would not cause confusion as to sponsorship or association.\(^{151}\) As noted, however, the right of publicity confers protection against commercial uses that do not involve consumer confusion as to endorsement. Thus, the players still had a right of publicity action after their Lanham Act claims failed.

The court nonetheless found that Cardtoons’ social commentary was protected by the First Amendment.\(^{152}\) The Players Association argued that rights of publicity are property rights, and no one has a right to use another person’s property to engage in First Amendment-protected activity where adequate alternative means of communication exist. Cardtoons could, for example, poke fun at the institution of baseball with generic images of baseball players. The Tenth Circuit disagreed, because intellectual property, “unlike real estate, includes the words, images and sounds that we use to communicate, and ‘we cannot indulge in the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process.’”\(^{153}\) Changing the images would change the parody because Cardtoons was parodying particular players as well as the institution of baseball, and generic images could not do that.

Parodies of celebrities, the court continued, are especially valuable because of celebrities’ (overinflated) role in modern society, where they symbolize certain ideas and values.\(^{154}\) Allowing the right of publicity to prevent commentary would amount to censorship.

\(^{150}\) Cardtoons, L.C. v. Major League Baseball Players Ass’n, 95 F.3d 959 (10th Cir. 1996).

\(^{151}\) See id. at 967.

\(^{152}\) See id. at 970 (finding that the cards were not commercial speech under the First Amendment, even though they were sold for a profit).

\(^{153}\) Id. at 971 (quoting Cohen v. California, 403 U.S. 15, 26 (1971)).

\(^{154}\) See id. at 972.
The Tenth Circuit then examined whether this suppression of speech was justified by the social value of the right of publicity. The court considered several economic and noneconomic justifications for rights of publicity, and rejected them all as reasons to enjoin Cardtoons' nonconfusing cards. One part of the court's analysis is notable for its relationship to arguments in copyright: Celebrities, the court stated, are unlikely to authorize parodies, and therefore protecting celebrities against unauthorized parodies does not provide them additional economic incentives. In current popular culture, this argument rests on shaky empirical grounds, just as it does with copyright owners. Saturday Night Live, to take an easy example, often gets celebrities to engage in self-parody, willingly and sometimes even gleefully.

Although the California Supreme Court also professed concerns about First Amendment freedoms, it ultimately proved much more hospitable to right of publicity claims than the Tenth Circuit, failing to examine the justifications for such claims in sufficient detail. In Comedy III Productions, Inc. v. Gary Saderup, Inc., the owner of the Three Stooges' rights of publicity prevailed in a claim against Gary Saderup, who draws portraits of celebrities and reproduces them on lithographs and T-shirts. Recognizing that its decision had potentially significant consequences for artists who create representations of famous figures, the California Supreme Court adapted the transformative use test from Campbell to create a standard that would preserve the right of publicity without violating the First Amendment. The court rejected the parody/satire division in favor of an inquiry that asks whether an artwork "adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation."

Despite an extended discussion of the First Amendment value of social, artistic and political commentary that uses celebrity images, the court held that the California legislature had a "rational basis" for creating a right of publicity that extended beyond a right to control commercial endorsements to "exploiting the value to be obtained from merchandising the celebrity's

155. See id. at 973-76
156. See id. at 974.
159. See Saderup, 21 P.3d at 808.
160. Id. at 799.
161. See id. at 803-04.
In order to limit the effect of such an expansive right of publicity on free speech, however, the California Supreme Court held that a work that both used a celebrity image and contained "significant transformative elements" would be protected by the First Amendment; only works that "take the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond the trespass," would violate the celebrity's rights.

The court suggested that a subsidiary inquiry might be useful if the extent of transformation was unclear: "Do[] the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted?" Saderup's charcoal drawings, the court determined, did not have the necessary artistic extra element; his talent was "manifestly subordinated to the overall goal of creating literal, conventional depictions of the Three Stooges so as to exploit their fame." It commented that Andy Warhol's lithographs, by contrast, did have that extra element.

The California Supreme Court's attempt to save postmodern art is quite unpersuasive. Andy Warhol, whose fame is sustained largely by images such as Marilyn, Single Elvis, Blue Liz as Cleopatra, and, of course, Campbell's Soup Cans, has been considered a difficult case even before Saderup. Jane Gaines, indeed, predicted Saderup's outcome—and demonstrated its fundamental flaw—six years before the fact:

While it would be completely possible to argue that a larger percentage of the artistry in the (mostly derived) works [Warhol] produced was "taken" and a relatively small percentage "added" by the artist, working as Warhol did,
under the protection of the charmed art world, this issue was held at bay. This art world charm made it possible for Warhol to make the kinds of outrageous and offensive visual statements . . . that you or I would not be able to make if we set up a small factory to produce Marilyn Monroe's image in Day-Glo for discount merchandising chains such as Wal-Mart and Revco.168

Even accepting the idea that Warhol's cachet added value to his lithographs beyond the celebrity image portrayed,169 it is manifest that Saderup's cachet, though more limited, did so as well. His lithographs cost more than standard photographic prints or posters of stars; consumers evidently value the artistic quality of Saderup's work in addition to the star power of his subjects.170 Under Saderup, traditional portraitists, photographers and likely the unknown Warhols and Lichtensteins of the next generation will be barred from using images free to looser hands. Or, courts that want to find for artists, like courts that want to find for humorists in copyright cases, will manipulate the definition of "transformation" to suit their purposes.

In a case involving a portrait of Tiger Woods at the Masters Tournament, for example, the majority and the dissent disagreed on the application of the Saderup test.171 The majority considered that the painting had "significant transformative elements" because it "consists of a collage of images [of caddies, the Augusta clubhouse, and six other golf greats] in addition to Woods's image[,] which are combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods's achievement in that event."172 The majority's rationale suggests that all that is required for

168. Jane Gaines, Reincarnation as the Ring on Liz Taylor's Finger: Andy Warhol and the Right of Publicity, in Identities, Politics, and Rights 131, 143 (ed. Austin Sarat & Thomas R. Kearns, 1995). Gaines notes that Warhol "engaged his mother to sign his works and employed workers to render them," further distancing himself from the conventional attributes of the value-adding artist. Id.

169. Warhol's cachet was not always so well established; initially, the value of his work gained nothing from his reputation and was perhaps hurt by it. See, e.g., Ingrid Sischy, Andy Land, N.Y. Times, Aug. 17, 2003, Fashions of the Times, at 80, 84 (discussing the stigma initially surrounding Warhol).

170. As Justice Holmes said in Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903), "if [works] command the interest of any public, they have a commercial value,—it would be bold to say that they have not an aesthetic and educational value,—and the taste of any public is not to be treated with contempt." Id. at 252. Cf. Eugene Volokh, Freedom of Speech and the Right of Publicity, 40 Hous. L. Rev. 903, 923-24 (2003) ("[N]ot all nontransformative 'conventional celebrity images' are mutually interchangeable. I may not want to see a standard print of Elvis hanging on my wall; I may want to see a Gary Saderup charcoal drawing of Elvis, or someone's impressionist Elvis or pointillist Elvis.").

171. See ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915 (6th Cir. 2003).
172. Id. at 938.
transformation is a backdrop, or a collage of several celebrities together. The dissenting judge, on the other hand, could see no relevant difference between the portrait of Woods and the portrait of the Stooges, and pointed out that there appeared to be direct competition between the authorized and unauthorized images: "[T]he rendition done by Rush is nearly identical to that in [an authorized] poster distributed by Nike. . . ."\[^{174}\]

The flaw of Saderup was that, though the court recognized the irrelevance of the parody/satire distinction, it nonetheless fashioned a Campbell-like transformative use test that has the same problems of subjectivity, manipulability and unpredictability.\[^{175}\] Borrowing from copyright law rather than from trademark law, which is a much closer analog to the right of publicity, distracted the California Supreme Court from an analysis of the interests served by right of publicity law.

The distinctions between the two approaches should not be exaggerated. The Saderup and Cardtoons approaches are likely to produce similar results whenever significant creative additions are evident on the face of the accused artwork.\[^{176}\] As a practical matter, Saderup may just muddy the waters further. Ideally, any (nonconfusing) artistic rendering—with the possible exception of recordings of entire performances and candid photos—should be protected from celebrity control. If this result is unacceptable, courts need a better account of the state’s interest in protecting celebrities’ rights to control the presentation of their images in

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\[^{173}\] This concept is related to copyright’s recognition of the creativity involved in selecting, coordinating and arranging preexisting materials to create a compilation or collective work; the author of such a work is entitled to protect his or her creative contribution, which can be seen as a kind of transformation inasmuch as it puts existing elements into a new context. See 17 U.S.C. § 103.

\[^{174}\] ETW Corp., 332 F.3d at 959 (Clay, J., dissenting).

\[^{175}\] Consider Winter v. DC Comics, 69 P.3d 473 (Cal. 2003), in which the California Supreme Court reversed a court of appeals decision that, applying Saderup, had concluded that summary judgment was inappropriate when two musician brothers, Johnny and Edgar Winter, sued over a comic book series that portrayed Johnny and Edgar Autumn, "villainous half-worm, half-human offspring born from the rape of their mother by a supernatural worm." Id. at 476. This would seem obviously a protected lampoon, but the court of appeals got entangled in the question of how much of the series’ value depended on the presence of the Autumn (Winter) brothers. Even though the California Supreme Court reversed, DC Comics was forced into expensive litigation because of Saderup’s ill-defined test for artistic separability.

\[^{176}\] See, e.g., ETW Corp., 332 F.3d at 937-38 (endorsing both cases); World Wrestling Fed’n Entm’t, Inc. v. Big Dog Holdings, Inc., 280 F. Supp. 2d 413, 444-45 (W.D. Pa. 2003) (using both cases); Hoepker v. Kruger, 200 F. Supp. 2d 340, 349-50 (S.D.N.Y. 2002) (finding, under both Saderup and more expansive protection for art under New York law, that Barbara Kruger’s collage using an image of a plaintiff looking through a magnifying glass and the words "It’s a small world but not if you have to clean it" was protected from a right of publicity claim by the First Amendment); cf. Saderup, 21 P.3d at 809 (finding Cardtoons consistent with its result).
noncommercial speech, one that answers the Tenth Circuit's criticisms of broad publicity rights. At all events, *Campbell's* literary analysis is not much help in distinguishing between what should be within a celebrity's control and what should not.

**VI. CONCLUSION**

Parodies can be funny or offensive. What is certain is that they are frustrating, enough so that intellectual property owners may litigate out of a sense of wounded dignity even when there is a strong fair use defense. Because parody determinations are fact-intensive—and sometimes dependent on a judge's response to their humor or lack thereof—predictions remain extremely difficult. We have no ready answer to this problem; we can only suggest that the parody/satire divide has proved a frolic and detour ill suited to proper intellectual property policy. Courts should take a broader view of transformation when they address humorous (and nonhumorous) unauthorized uses of works, marks or images.