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Yankee Publishing Inc. v. News America Publishing Inc., 809 F. Supp. 267, 273 (S.D.N.Y. 1992)

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tection)). The Supreme Court relied on Sears Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964) and Compco Corp. v. Day-Brite Lighting, 376 U.S. 234 (1964) in deciding *Bonito Boats*.

6. The defendants argued that *Midler* was wrongly decided because unlike other federal copyright preemption involving entertainers' performances, the decision in *Midler* ignored *Sears* and *Compco*. *Id.* at 1099-1100.

7. Waits v. Frito-Lay, Inc., 978 F.2d at 1100 (*citing* Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. at 165).

8. *Id.*

9. *Id.* (*citing* Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977)).

10. *Id.* at 1100 (*citing* 17 U.S.C. at 301(b)(1)).

11. *Id.* (*citing* Midler v. Ford Motor Co., 849 F.2d at 462).

12. *Id.*

13. *Id.*

14. In a footnote, the appellate court stated that such an instruction would have added another element to the *Midler* tort: actual confusion. However, no opinion was given as to the inclusion of this element since its validity was not an issue on appeal. *Id.* at 1101 n.3.

15. *Id.* at 1101.

16. The district court instruction read, "A professional singer's voice is widely known if it is known to a large number of people throughout a relatively large geographic area." *Id.* at 1102.

17. *Id.* at 1103 (*citing* Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 824 and n.11 (9th Cir. 1974)).

18. CAL. CIV. CODE § 3333 (West 1970).

19. Under California law, punitive damages are available if clear and convincing evidence shows a defendant is guilty of "oppression, fraud or malice." CAL. CIV. CODE § 3294(a) (West Supp. 1992). "Malice" is defined in the statute to be "despicable conduct which is carried on by the defendant with a wilful and conscious disregard of the rights or safety of others." *Id.* at §3294(c)(1).

20. Section 43(a) now expressly prohibits "the use of any symbol or device which is likely to deceive consumers as to the association, sponsorship, or approval of goods or services by another person." 15 U.S.C. at § 1125(a) (1988).

21. To interpret the version of § 43(a) of the Lanham Act that existed at the time of the broadcast, the appellate court looked to the 1988 amendments to the Act since they codified prior case law which authorized claims for false endorsement. Waits v. Frito-Lay, Inc., 978 F.2d at 1107.

22. *Id* (*citing* S. REP. NO. 515 101st Cong., 1st. Sess. 44 (1981); 1988 U.S.C.C.A.N. at 5607).

23. *Id.* at 1108. (*citing* Smith v. Montoro, 648 F.2d 602, 608 (9th Cir. 1981)).

24. *Id.* (*citing* Halicki v. United Artists Communications, Inc., 812 F.2d 1213 (9th Cir. 1987)).

25. 15 U.S.C. at § 1127.

26. Waits v. Frito-Lay, 978 F.2d at 1109.

27. *Id.* at 1106.

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INTRODUCTION

Yankee Publishing Inc. ("Yankee"), publisher of THE OLD FARMER'S ALMANAC (the "ALMANAC") sued the publisher of NEW YORK magazine, News America Publishing Inc., alleging that the defendant's takeoff of the ALMANAC'S cover design violated section 43(a) of the Lanham Act. Yankee claimed that the cover of NEW YORK magazine was likely to cause confusion among consumers and dilute Yankee's trademark. The District Court for the Southern District of New York held that there was not a substantial likelihood of consumer confusion since it was clear that the defendant's takeoff on the ALMANAC cover design was intended as a joke. Moreover, even if there was consumer confusion, it was outweighed by the First Amendment's protection of the right of commentary and artistic impression.

FACTS

The ALMANAC has been published with the same cover design since 1852. The ALMANAC's cover design, a distinctive mark registered with the United States Patent and Trademark Office, is strongly associated with the ALMANAC. International Licensing Management Incorporated ("ILM"), the exclusive merchandise licensing agent for the ALMANAC's trademark cover design, was a co-plaintiff in the suit. ILM licenses variations of the ALMANAC cover design to companies who incorporate the cover design into their products.

The defendant publishes NEW YORK magazine. NEW YORK magazine is a stylish weekly magazine which covers New York City's cultural, fashion, entertainment, and restaurant scene. In its 1990 annual Christmas gift issue, NEW YORK magazine incorporated the ALMANAC's cover design to highlight a thrift theme. The thrift theme was intended to be satirical. For example, in the magazine, sample gifts were shown which were not inexpensive, although they were described as being thrifty.

After learning of the NEW YORK magazine cover, Yankee filed suit against the defendant contending that the defendant's takeoff on the ALMANAC'S cover design violated Yankee's trademark by causing likely confusion among consumers and diluting the value of Yankee's trademark.

LEGAL ANALYSIS

The first issue the district court faced was whether the defendant's use of the ALMANAC'S cover design caused a substantial likelihood of consumer confusion in violation of section 43(a) of the Lanham Act. Mere unauthorized use of a trademark does not violate the Lanham Act.[1] There must be a likelihood of consumer confusion.[2] If the way in which the trademark is employed does not imply that the trademark is being used to indicate source or origin of publication, there can be no consumer confusion.[3]

Although the court stated it was clear that the defendant imitated the ALMANAC'S trade dress in its cover design, the court held that there was no likelihood of confusion among consumers since it was obvious to consumers that the imitation was a joke and not a trademark source identifier. The court identified several factors which prevented confusion. First,

on the cover, the defendant used its regular logo and type on the title "New York", and the magazine's spine stated "New York" without reference to the ALMANAC. Second, the defendant did not print the ALMANAC's title on its magazine. Third, the court noted that it was easily recognizable that the artwork on NEW YORK's cover was a "joking deviation from the themes of the ALMANAC's Finally, NEW YORK MAGAZINE is much larger than the ALMANAC. Thus, the court held that the defendant's use of the ALMANAC's cover design did not cause likely consumer confusion since the use of the cover design was clearly a joke.

Next, the court applied some of the factors set out in *Polaroid Corp. v. Polarad Elec. Corp.* in order to ascertain consumer confusion.[5] The first factor is strength of plaintiff's mark. Usually, if the plaintiff has a strong mark, there is a greater chance of consumer confusion.6 On the other hand, if plaintiff's mark is used for a commentary or joke, plaintiff's strong mark can have the opposite effect.[7] The court reasoned that since both plaintiff's and defendant's marks are associated with particular, distinct life values, there is no confusion. On seeing the cover of NEW YORK magazine, the consumer understands that the use of the ALMANAC's trade dress is intended as a joke and is not a source identifier.[8]

The second major issue the district court faced was whether, assuming there was consumer confusion, the First Amendment protected the defendant's use of the ALMANAC's cover design. The First Amendment protects the unauthorized use of trademarks utilized as part of the expression of a communicative message.[9]

The Second Circuit interprets the Lanham Act narrowly when a defendant uses a plaintiff's trademark to communicate a message, rather than identify product origin. When a trademark is employed for expressive purposes, such as parody, the court must balance the rights of the trademark owner with the interests of free speech.[10] The Lanham Act should be applied to artistic works only where the public interest in avoiding consumer confusion outweighs its interest in free expression.[11]

In *Rogers v. Grimaldi,* the Second Circuit adopted this balancing test for trademark infringement cases in which artistic expression is employed.[12] In *Rogers,* Ginger Rogers sued Federico Fellini, the director of a film entitled "Ginger and Fred", for violating the Lanham Act. The film was about two Italian cabaret performers who imitated Ginger Rogers and Fred Astaire and became known in Italy as "Ginger and Fred." In finding for the defendant, the Second Circuit reasoned that since titles combine artistic expression and commercial promotion, consumers not only have an interest in not being confused but also have an interest in enjoying freedom of expression.[13] Thus, the expressive element in titles requires more protection than the labeling of ordinary commercial products.

This reasoning was carried further in *Cliff Notes v. Bantam Doubleday Pub. Group.* In *Cliff Notes,* the Second Circuit balanced trademark and First Amendment interests where the trade dress of the plaintiff's publication was used on defendant's publication for parody.[14] The Second Circuit included parody in the category of artistic expression in applying the *Rogers* balancing approach. The court found that the slight risk of consumer confusion caused by the defendant's parody was outweighed by the public interest in free expression.[15]

Here, the court found that the defendant's use of the ALMANAC's cover design for the purpose of a joke was artistic editorial expression which at most caused slight consumer confusion. The court held that the public interest in free expression outweighed the public interest in avoiding confusion.

Yankee argued that the since the defendant's cover was not a parody, the First Amendment balancing approach should not be applied. Although the court agreed that the defendant's cover was not a parody, the court reasoned that not only the use of parody is given protection, but the use of an expressive message in general is accorded deference.[16] The defendant's joke is an expressive message that is entitled to First Amendment protection.

Next, Yankee argued that the defendant's joke was so complicated and incomprehensible that no expression was communicated. The court agreed that the joke was complicated and many readers may not have understood the intended joke. Nevertheless, the court stated that the vagueness of the joke did not strip the defendant of First Amendment protection. The defendant made a good faith attempt to express itself in the form of a joke. Although the joke may not have been understood by many consumers, the court reasoned that the First Amendment still protects it since the defendant made a "bona fide effort to communicate."[17]

CONCLUSION

The District Court for the Southern District of New York held that the defendant's takeoff use of the ALMANAC's cover design on the cover of NEW YORK magazine did not violate section 43(a) of the Lanham Act. Since the defendant's use of ALMANAC's cover design was a joke, it was not likely to cause confusion among consumers. Furthermore, even if there was some consumer confusion, the First Amendment interest in the artistic expression of the defendant's unauthorized use of Yankee's trademark outweigh the public's interest in being free from confusion.

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1. Lanham Act, 15 U.S.C. § 1114(1) (1988).
2. Yankee Publishing Inc. v. News Am. Publishing Inc., 809 F. Supp. 267, 273 (S.D.N.Y. 1992).
3. *Id.*

4. *Id.*

5. *Id.* (*citing* Polaroid Corp. v. Polarad Elec. Corp., 287 F.2d 492, 495 (2d Cir. 1961), *cert. denied,* 368 U.S. 820 (1961)(the eight *Polaroid* factors include: (1) strength of plaintiff's mark, (2) similarity of the uses, (3) proximity of the products, (4) the likelihood that the prior owner will bridge the gap, (5) actual confusion, (6) defendant's good or bad faith in using plaintiff's mark, (7) quality of the junior user's product, and (8) sophistication of consumers).

6. Yankee Pbulishing Inc. v. News Am. Publishing Inc., 809 F. Supp. at 273.

7. *Id.*

8. *Id.* at 274. The court then applied the remaining seven Polaroid factors to the facts of this case and concluded that the defendant's cover design did not cause a significant likelihood of confusion among consumers as to its source or origin.

9. *Id.* at 276.

10. *Id.*

11. *Id.* (*citing* Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989)).

12. *Id.* at 276-77.

13. *Id.* at 276 (*citing* Rogers, 875 F.2d at 998).

14. *Id.* at 277 (*citing* Cliff Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc., 886 F.2d 490, 495 (2d Cir. 1989)).

15. *Id.* at 277-78 (*citing* Cliff Notes, Inc., 886 F.2d at 496).

16. *Id.* at 279.

17. *Id.* at 280.