

PUBLIC CITIZEN LITIGATION GROUP

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BY EMAIL TO bberliner@omm.com

October 5, 2021

Brian D. Berliner, Esquire
O'Melveny & Myers LLP
18th floor
400 South Hope Street
Los Angeles, California 90071-2899

Re: Your September 21 Demand Letter to LibertyManiacs

Dear Mr. Berliner:

I write on behalf of Dan McCall, who owns the web site at libertymaniacs.com, in response to your September 21, 2021, demand letter. You contend that the T-shirts and other paraphernalia on which McCall imprints the following image infringe your client's trademarks and copyrights, and you demand that McCall stop selling them. You also invoke the DMCA in demanding that McCall follow the takedown requirements that would apply if McCall were hosting a web site that allow third parties to post content.



However, your contentions are baseless. McCall has used a parody of your client's name and trademark to criticize the President of the United States. There is no trademark infringement. No reasonable person is going to think that your client had any involvement in the creation of this image,

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or that it approves of this image in any way. Indeed, your demand letter admits that the parody is a negative one, which “impugn[s]” your client’s products and services. That very negative character is a further signal to consumers that the parody is not one sponsored by your client. Moreover, Trader Joe’s appeals to a relatively upscale and sophisticated segment of the grocery market; members of that target audience would be especially likely to understand that this image is a joke, and especially **unlikely** to think that Trader Joe’s has any connection to this image other than as a target of parody. Hence, there is no likelihood of confusion and no possible claim for infringement. Moreover, because the phrase “Traitor Joe” is plainly parody, it comes within the defense of nominative fair use.

Trademark law aside, McCall’s use of the image to comment on the President of the United States, while playing on the name of a leading grocery store chain, is speech squarely protected by the First Amendment. Consequently, any application of trademark law to quash such uses would be highly suspect. Although McCall’s products are sold, their contents are noncommercial speech, which qualifies for full First Amendment protection. *Ayres v. Chicago*, 125 F.3d 1010, 1014 (7th Cir. 1997); *see also Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 812 (9th Cir. 2003); *Smith v. Wal-Mart Stores*, 537 F. Supp.2d 1302, 1340-1341 (N.D. Ga. 2008). The First Amendment protection for non-commercial speech extends to bar trademark claims. *E.S.S. Entertainment 2000 v. Rock Star Videos*, 547 F.3d 1095, 1099-1101 (9th Cir. 2008); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 968-976 (10th Cir. 2003); *CPC Intern. v. Skippy Inc.*, 214 F.3d 456, 462-463 (4th Cir. 2000); *L.L. Bean v. Drake Publishers*, 811 F.2d 26, 33 (1st Cir. 1987).

To be sure, some early decisions in the Eighth Circuit did not recognize these First Amendment objections to the application of trademark law, but trademark law has come a long way since the “Mutant of Omaha” and “Michelob Oily” cases were decided. *See Lemley & Volokh, Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 Duke L.J. 147, 224, 242 (1998). Moreover, the Supreme Court has recognized that the First Amendment imposes limits on trademark law. *E.g., Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019). Accordingly, we are prepared to defend McCall’s free speech rights if your client files suit.

Finally, your letter asserts a copyright claim. Although you cite the registration of your client’s trademark, and you provide a trademark registration number, you do not say that your client’s copyright in the “artwork” of its logo has been registered. Can you produce your client’s copyright registration, along with the copyright deposit showing precisely what was registered? We question whether the aspects of the logo that McCall has used would qualify for registration. McCall’s image uses the same typeface as the Trader Joe’s logo, but typefaces cannot be copyrighted. *Eltra Corp. v. Ringer*, 579 F.2d 294, 297-298 (4th Cir. 1978); *Adobe Systems v. Southern Software*, 1998 WL 104303, at *3 (N.D. Cal. Feb. 2, 1998); 37 C.F.R. § 202.1(e). The only other thing that the parody has in common with the logo are the concentric red circles around the edge, which are not likely sufficiently original to warrant copyright protection. Unless you produce the registration, we will assume that your copyright claim just enabled you to write a longer demand

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letter. Moreover, because, Liberty Maniacs is not an interactive web site that hosts third-party content, the Digital Millennium Copyright Act has no application, and your invocation of that statute adds nothing to your claims.

In sum, McCall does not agree that his sale of the parody T-shirts about which you complain violates any of your client's rights, and he is neither going to remove the images from his web site nor stop the sales as you demand. Trader Joe's should not have allowed you to send this bullying demand letter on its behalf. We request a prompt retraction.

Sincerely yours,


Paul Alan Levy