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*presents*

## **IP Cannabis Law Conference**

Pot “Parodies”

Wednesday, April 19, 2023  
11:00 a.m.– 12:15 p.m.

MCLE: 1.25

Speakers:

Russ Jacobs

David Branfman

### ***Conference Reference Materials***

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The Intellectual Property Law Section presents

# THE CANNABIS IP LAW CONFERENCE

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## Pot “Parodies”

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director, managing corporate counsel, Starbucks Corp.

April 19, 2023



# Welcome

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The content of this presentation does not necessarily reflect the views of the speakers' employers or their clients.

# Trademark Parodies Introduction

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“Novak argues that his use of the design in question is an exercise of his right of free speech and is protected by the First Amendment. We believe, however, that the protection afforded by the First Amendment does not give Novak license to infringe the rights of Mutual. Mutual's trademarks are a form of property. . .”

*Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8<sup>th</sup> Cir. 1987)



# Trademark Parodies Introduction

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“... parody is unavailing to applicant as an outright defense and, further, does not serve to distinguish the marks”

*Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741 (TTAB 2006)

STARBUCKS COFFEE

LESSBUCKS COFFEE

# Trademark Parodies Introduction

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“The dog toy irreverently presents haute couture as an object for casual canine destruction. The satire is unmistakable. The dog toy is a comment on the rich and famous, on the LOUIS VUITTON name and related marks, and on conspicuous consumption in general. . . . We conclude that . . . the ‘Chewy Vuiton’ dog toys convey ‘just enough of the original design to allow the consumer to appreciate the point of parody,’ but stop well short of appropriating the entire marks that LVM claims.”

*Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.2d 252, 261 (4<sup>th</sup> Cir. 2007)



# Trademark Parodies Introduction

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The mark is “expressive” because “Bad Spaniels comments humorously on precisely those elements that Jack Daniels seeks to enforce here.”

*VIP Products LLC v. Jack Daniel’s Props.*, 953 F.3d 1170, 1175-76 (9<sup>th</sup> Cir. 2020)

- Expressive works can infringe only if the underlying works are artistically relevant or the defendant explicitly misleads the consumer
- Expressive works are non-commercial and cannot dilute by tarnishment







# Trademark Parodies Edibles

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Court enjoined sale of marijuana edibles on <[www.2020ediblez.com](http://www.2020ediblez.com)> website under marks SKITTLES, CANNABURST STARBURST, STARBUDDS, LIFESAVERS, and others. *Wm. Wrigley Jr. Co. v. Conde*, No. 5:21-cv-00777 JWH (SHKx) (C.D. Cal. Jan. 17, 2023). Parties resolved the dispute in a confidential settlement.



# Trademark Parodies Merchandise

Suit by City of New York alleges counterfeiting, false designation of origin and unfair competition, trademark dilution, and trademark cancellation.

*City of New York v. Lopez*, Civ. No. 21 CIV. 7862, Complaint (S.D.N.Y. Sept. 21, 2021)

35. On December 3, 2020, Defendant Lopez posted the following image on Facebook and the Instagram Webpage, stating, in relevant part, “funny story is I haven’t even been building this brand for a full 30 days and we already above the radar - - got contacted yesterday by New York City’s Law Department Senior Counsel of the Affirmative Litigation Department Gerald Singleton, Esq.” regarding my use of the City of New York’s “NYC” logo...in short form I told him to eat [redacted] with salt...pepper...and ketchup...quickly let him know that I come from a 20 plus year background in Intellectual Property and that I managed the #Trademark and #Copyright department of a NYC IP Firm for 13 years in which I resigned from in 2013...to(sic) long to elaborate on in a single post but I am very familiar with the “fair use” laws as well as the laws and rules regarding “parody” uses of certain designs and/or logos that are permissible...NYC

The City’s Registered Marks	Dft.’s NYC New York Cannabis Marks
	
 City of New York Parks & Recreation	 NYC New York Cannabis
	
	
	

# Trademark Parodies Merchandise



Court found defendant James Landgraf liable for trademark dilution, copyright infringement, trademark infringement, and false designation of origin, and ordered \$410K in damages. *Starbucks Corp. v. Hitman Glass*, Case No. 2:16-CV-03937-ODW(PJW) (C.D. Cal. Oct. 21, 2016)

# Trademark Parodies Storefront

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Suit by toy store against dispensary alleges trademark dilution, trademark infringement, false designation of origin.

*Tru Kids Inc. v. Zaza R Us*, Civ. No. 1:23-cv-2260, Complaint (E.D.N.Y. March 23, 2023)

Plaintiff's logo:



Defendants' logo:



# Trademark Parodies Storefront

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Court entered injunction to prohibit use of BUDWAY trademark, ordered “delivery up or destruction” of goods, imposed CAD25,000 damages, and CAD25,000 costs against Vancouver dispensary.

*Subway IP LLC v Budway, Cannabis & Wellness Store*, 2021 FC 583, (Federal Court June 10, 2021)



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