

**PUBLIC CITIZEN LITIGATION GROUP**

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July 10, 2013

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Dear Mr. Anderson:

I write on behalf of Mark Dimondstein and other members of the APWU Members First slate running in the upcoming APWU election, in response to the cease and desist letter that you have sent, contending that the use of the letters “APWU” in the name of their slate and in the domain name of their campaign web site violates the union’s property rights, Title IV of the Labor-Management Reporting and Disclosure Act (“LMRDA”), and a union election rule. Simply put, we reject your claim that opposing candidates cannot use the union’s name as part of their campaign, not only because none of the legal authorities that you invoked bars their action, but also because the First Amendment, as well as Title I of the LMRDA, protects the right of intra-union candidates to identify themselves as APWU members, and to appeal to other members of the union using those initials, so long as the use does not suggest that the union itself sponsors their candidacy.

Although a union’s name and acronym are trademarked, and although a trademark is a form of property, that property right does not exclude all other uses as, for example, ownership of a building or vehicle would do. The property right in a trademark excludes only other uses that would cause a likelihood of confusion about whether the trademark owner sponsors the junior use. *Basile, S.p.A. v. Basile*, 899 F.2d 35, 37-38 (D.C. Cir. 1990). *See also Anti-Monopoly, Inc. v. General Mills Fun Group*, 611 F.2d 296, 301 (9th Cir. 1979) (“It is the source-denoting function which trademark laws protect, and nothing more.”) Moreover, even if there is some chance of confusion, trademark rights are subject to the defense of fair use. *KP Permanent Make-Up v. Lasting Impression I*, 543 U.S. 111, 121-122 (2004). The right of fair use includes the right to identify the trademark holder as being the subject of discussion, that is, it includes nominative use. *Playboy Enters. v. Welles*, 279 F.3d 796, 801 (9th Cir. 2002). A property law regime that fails to recognize these limitations on trademark rights would run afoul of a speaker’s free speech rights. *L.L. Bean, Inc. v. Drake Publishers*, 811 F.2d 26, 31-32 (1st Cir. 1987). *See also Knight v. ILA*, 457 F.3d 331, 338-340 (3d Cir. 2006). Indeed, an attempt to extend trademark infringement claims to non-commercial uses, such as the ones that the APWU Members First slate have made, could also run afoul of the First Amendment. *Id.*; *Taubman v. WebFeats*, 330 F.3d 770, 774 (6th Cir. 2003).

Dimondstein and his slate-mates have every right to call themselves APWU members, *Playboy Enters. v. Welles, supra*, and they have every right to use a slate name that succinctly describes their principal campaign platform—putting APWU members first. And, when they are out leafletting at the workplace, given the fact that members of different postal unions use the same

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entrances, they need to be able to place the union's acronym prominently on their literature so that workers receiving the literature can see, in one quick glance, that the piece of paper is aimed at them, not at letter carriers or mail handlers or NAPS members, not to speak of the many non-members. And there is no likelihood that any union member seeing the slate name "APWU Members First" would imagine that the union entity sponsored the slate. Indeed, it is quite common in the labor movement for reform groups and reform publications to include the union's name. Teamsters for a Democratic Union is the best known example, but other such names include BLET Members for Democracy; Cingular CWA Members; Concerned ILA Members; NYSNA Nurses for Unity; AAM Local 424; UAW Crisis; IATSE.org; IBEW Friend and Family Networks; IBEW Tramp Guide; IBEW Minuteman; IBEW Alternative; ICEUFTblog.blogspot.com; ILA Rank and File; The AFM Observer; IUOE Watch; MEBA United; SAG Watchdog; SEIU Local 888 Members Democracy Campaign; SEIU Members Active for Reform Today; Steelworkers Fight Back; Teamster Retiree Coalition of NY State; Teamster.net; UBC Members Discussion List; TWULocal100.com, and the UTU Bus Caucus. Similarly, although to my knowledge no union reform group has ever been sued for using a union's name in its domain name, a number of cases have held that placement of a trademark in the domain name for a web site that comments on the trademark holder does not contravene the trademark laws. Given that Dimondstein is in the Fourth Circuit, *Lamparello v. Falwell*, 420 F.3d 309 (4th Cir. 2005) might be the most relevant, but other cases include *Utah Lighthouse Ministry v. Foundation for Apologetic Information and Research*, 527 F.3d 1045 (10th Cir. 2008); *Bosley Medical v. Kremer*, 403 F.3d 672 (9th Cir. 2005); *TMI v. Maxwell*, 368 F.3d 433, 436-438 (5th Cir. 2004); and *Taubman v. WebFeats*, 319 F.3d 770 (6th Cir. 2003).

Similarly, the decisions about union elections under Title IV of the LMRDA allow candidates to use the union's trademark on their literature so long as the use does not imply union sponsorship. Generally speaking, an insurgent candidate's use is unlikely to lead to a finding of improper use. *Solis v. TWU Local 234*, 855 F. Supp. 2d 329, 337 (E.D. Pa. 2011) (challenger whose campaign materials showed him standing in front of the union logo "did not reflect the appearance of union support"); *McLaughlin v. Musicians*, 700 F. Supp. 726, 736 (S.D.N.Y. 1988) (where local union officer used national and local union logos on letters to support a challenger for the office of national president, use of the national logo did not violate the LMRDA, given that the letter's content did not imply an endorsement by the national union and that the identity of the author and the dynamics of the race made it unlikely that anyone would infer such an endorsement; but use of logo of the entity where the sender was the incumbent leader was improper on the facts of that case).

Finally, the election rule that your demand letter cites does not, on its face, prohibit what the APWU Members First slate has done. By its terms, the rule applies only to the "logo or stationery,"<sup>1</sup> and the APWU Members First slate does not use the logo — the acronym in a stylized font, like so: **APWU** — but only the acronym itself. Several intra-union candidates have used leaflets employing

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<sup>1</sup>"No Union logo or stationery may be used in campaigning for or against a candidate. This includes using any Union logo for campaign related purposes, including press conferences."

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the union's marks, and, indeed, there is a non-official organization of local union officers, the American Postal Workers Union National Presidents' Conference, that includes the APWU name in its own acronym, as well as in its domain name, although it is scrupulous not to use the logo.

When you wrote to me on June 21, you told me that you had, in the past, "sent a number of demand letters to insurance marketers and the like demanding that they stop using the APWU trademark." I'd be willing to look at the demand letters to which you refer in judging your arguments, but that sort of enforcement is irrelevant to the issue before us, because, as you describe them, these were commercial uses by outsiders with no claim to the right to identify themselves truthfully as APWU members.

In your correspondence to me, it appeared that you understood that, applied to **any** use of the union's marks and not just the logo, the union's rule would be unlawfully overbroad; therefore, you told me, the union only objects to the use of the name in the slate name and domain name. However, nothing in the rule gives notice that it extends to the union's non-stylized name, and that it extends only to slate and domain names. Apart from when a rule thus limited would be valid, had the rule been so limited on its face, while clearly applying to the acronym and not just the stylized lettering, the slate might well have selected a different name, to avoid the possible need for litigation to protect their free speech rights. But you announced this specialized interpretation of the rule, apparently tailored precisely to disadvantage this slate, six weeks into the campaign after the slate had been announced, and after the slate had printed and widely disseminated its campaign literature. Moreover, although you told me that you originally sent the letter entirely on your own, and without any consultation with or authorization from the union's elected officials or its incumbent-selected election committee, we cannot help noticing that your demand letter favors one side in the election—the side that was aware of the secret interpretation that you assert is longstanding.

Consequently, Dimondstein and his slate will stand on their rights. They are not willing to surrender their right to identify themselves squarely with the APWU membership in both their slate name and their web site's domain name. We hope that the incumbent leadership will not choose to divert the members' money into litigating the members' right to correctly identify their slate and their web site using the letters "APWU." But if litigation is what it takes, we are prepared to go that route.

Sincerely yours,



Paul Alan Levy