

PUBLIC CITIZEN LITIGATION GROUP

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September 22, 2008

Melanie Sherk, Esquire  
Zazzle.com  
1900 Seaport Boulevard  
Redwood City, California 94063

Dear Ms. Sherk:

I write in response to the claims of trademark infringement advanced by Lea Hall Speed on behalf of the City of Memphis and Police Director Larry Godwin, which claims to own a trademark in the term "Blue Crush" and further claims that designs sold through Zazzle by an anonymous citizen known as "nico3974" that include the photograph or name of Larry Godwin violate his right of publicity or privacy. These claims are entirely spurious. (I note that because Nico3974 is anonymous, I am using the female pronoun generically, without any intent to identify actual gender).

Although the parody and likelihood of confusion objections raised below are the most significant objection the City's takedown letter, we must note at the outset that we have grave doubts that the City can even establish that it has a valid trademark. The City sent you a printout of a registration form that can be viewed on the web site of the Tennessee Secretary of State, but what it neglected to tell you is that in Tennessee the only review conducted before the state issues a registration for a given name is to see whether anybody has already filed for the same name in Tennessee. There is no review to determine whether the trademark is otherwise valid, and no law gives the existence of a registration any presumption of validity when the mark is challenged on grounds that were never presented for review under the state's minimal process.

The registration form shows that the city's "Blue Crush" slogan has been used on "banners and backdrops for community meetings, media releases and press conferences" as well as on "bumper stickers" placed on city vehicles. But there city has never sold any materials using the slogan – it is just a political slogan. As such, the City's use does not qualify as "use in the ordinary course of trade" as required for registration or acquisition of trademark status under 15 U.S.C. § 1127. Specifically, when a mark is used for services, as here, the qualifying use must be "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce." It is highly questionable whether police services constitute a "course of trade" or are rendered in commerce. Indeed, given the case law suggesting that the term "in commerce" was intended to be used in parallel to the power conferred by the Commerce Clause, we assume that the City of Memphis would agree that Congress cannot regulate municipal police services under the Commerce Power. Moreover, Tennessee recently amended its trademark statutes to provide that they should be construed in pari materia with federal trademark law. Consequently, Memphis simply does not have **any** trademark rights in the term "blue crush."

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Moreover, to the extent the City objects to Nico's sale of T-shirts, not only has the police department not registered the term "Blue Crush" for use on apparel, but there is a Hawaiian man, William Ballard a/k/a Billy Goat Productions, who **has** registered the term Blue Crush for use on apparel, Registration No. 2633780. But Ballard has made no objection. Blue Crush is also the name of a surfer movie.

As for the right of publicity claim, Larry Godwin is an important public figure, and as such has only limited rights in his image. Citizens are entitled to use the picture of a public official of whom they disapprove as part of political expression about why they disapprove of this official.

Moreover, the uses here are plainly parody. Nico uses the term Blue Crush derisively, as in the phrase "Blue Crush, fighting crime two tickets at a time" – as if writing traffic tickets were the sort of crime fighting that will clean up rough neighborhoods. Or, her products say "Blue Crush, fighting crime one block at a time" a reference to the fact that when the "blue crush" program is brought to bear on a particularly bad block in the city, the crooks just move to a different block. See Nico's discussion of this issue on her blog at <http://mpdenforcer20.blogspot.com/2008/03/fearless-leader.html>. The citizens of Memphis (and the Memphis police officers dissatisfied with current leadership) know this, and nobody is likely to think that the City of Memphis is making fun of its own program. In this regard, you might note that the Tennessee registration shows the term in black and simple block letters, while Nico shows them in blue and in distinctive fonts of her own. Similarly, with respect to the designs that incorporated Godwin's name and photograph all did so for the purpose of denouncing Godwin.

Finally, Nico's use is parody, and hence is fair use for the purpose of commenting on the trademark holder. I might add that critical speech directed at a government body is squarely protected by the First Amendment, hence any application of trademark law to quash such uses is highly suspect. Although Nico's T-shirts and bumperstickers are sold, full First Amendment protections for noncommercial speech would be extended in this context even though the medium on which they are carried are sold commercially. *Ayres v. Chicago*, 125 F.3d 1010, 1014 (7th Cir. 1997). Similarly, state "right of publicity" claims such as the ones advanced in support of Police Chief Godwin's objections to the use of his photograph normally give way to the First Amendment rights even when the defendant is selling a product. See *C.B.C. Distribution and Marketing v. Major League Baseball Advanced Media*, 505 F.3d 818, 823-824 (8th Cir. 2007).

After sending you the takedown letter, City of Memphis and Godwin initiated a legal proceeding against Nico based on her use of the Blue Crush and Godwin images. They claimed that they needed to obtain Nico's identity in order to sue her for trademark infringement. Although the City originally proceeded without giving any notice, and misrepresented the facts to a Tennessee state judge in order to obtain an order allowing discovery, Nico learned of the action from America Online, her Internet Service Provider, and retained my services. I told plaintiffs that we were going to file a motion to quash the subpoena; plaintiffs immediately put the subpoena on hold. I repeatedly

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asked the City to provide evidence that the marks had been used in commerce, thus supporting the trademark claim, and to identify any images that were not negative commentary (which would, obviously, not be confusing, and would also be fully protected by the First Amendment). Rather than provide such evidence, the City has dismissed the proceeding, albeit without prejudice, in a clear acknowledgment that its trademark and right of publicity claims could not be sustained.

Finally, I have reviewed these images with trademark counsel at CafePress, which, for Ms. Speed's benefit, is another California company which, like Zazzle, provides a print-on-demand service for people who have expressive images that they would like to make available to the public. She has indicated that CafePress will have no problem allowing Nico to sell items bearing these images. Nico could take her sales there, but we would prefer to give Zazzle the opportunity to restore all of the challenged images to Nico's account. I hope you will do so.

Sincerely yours,



Paul Alan Levy

cc: Lea Hall Speed, Esquire