SANDLER, REIFF, YOUNG & LAMB, P.C.

March 10, 2014

Via Facsimile and First Class Mail

Julia George Moore, Esq.
General Counsel
Office of the Lieutenant Governor
PO Box 44243
Baton Rouge, LA 70804-4243

Re: Use of "Pick Your Passion" Mark by MoveOn.org Civic Action

Dear Ms. Moore:

This will respond to your letter of March 5, 2014, demanding that our client, MoveOn.org Civic Action, a nonprofit advocacy organization ("MoveOn"), cease and desist from using the registered trademark "Pick Your Passion" on a billboard advertisement criticizing the Executive Branch of the State Government of Louisiana for its position on a controversial issue of great public interest and importance – the expansion of Medicaid.

We have carefully reviewed the contentions in your letter. For the following reasons, MoveOn believes its use of the trademark is non-infringing and declines to cease its billboard advertising campaign using that trademark (the "Mark").

First, the determinative issue is whether the use of the Mark creates a likelihood of confusion among relevant consumers. Clearly, MoveOn is not using the Mark for the advertisement of any goods or services of its own whatsoever. Your letter contends, however, that there is a "strong likelihood that a reasonable consumer will believe the Lieutenant Governor is the source...of the billboards" and is " likely to be confused into believing this office is involved in a dispute with the Governor over Medicaid expansion."

To the contrary, MoveOn's sponsorship of the billboard is clearly denoted. The advertisement is manifestly a criticism by our client of the position of the Governor on Medicaid expansion. The Lieutenant Governor is not mentioned or referenced in any way in the advertisement. No reasonable Louisiana citizen or visitor could conceivably look at this billboard and conclude that it is about a dispute between two state officials, as opposed to a criticism of the Governor's policy by an advocacy group. You allege that the billboard has "already caused confusion regarding the source of the message" but cite no facts or evidence supporting that allegation.

Further, although you contend that the Mark is "closely affiliated with the Office of the Lieutenant Governor," the Mark is in fact registered to the Louisiana Department of Culture, Recreation and Tourism, a "STATE AGENCY [of the State of] LOUISIANA" (USPTO

Registration No. 4022761)(capitals in original). While the Lieutenant Governor serves *ex officio* as Secretary of this Department, the head of the Department is not identical with the Department itself. The Lieutenant Governor is not the owner or holder of this Mark.

Second, as your letter implicitly acknowledges, MoveOn's use of the tourism slogan is clearly a parody or satire, and a use in that way of the State's own slogan to criticize the State, thus precluding any finding of likelihood of confusion. "In general a reference to a . . . trademark may be permissible if the use is purely for parodic purposes. To the extent the original work must be referenced in order to accomplish the parody, that reference is acceptable." *Lyons Partnership v. Giannoulas*, 179 F.3d 384, 388 (5th Cir. 1999). "A successful parody of the original mark weighs against a likelihood of confusion because, even though it portrays the original, it also send the message that is not the original and is a parody, thereby lessening any potential confusion." *Elvis Presley Enterprises, Inc. v. Capece,* 141 F.3d 188, 199 (5th Cir. 1998).

The First Amendment protection afforded to parodic or satirical uses of a mark, of course, is especially strong where the use is expressive and for non-commercial speech. "[T]rademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view.'" *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002)(quoting *L.L. Bean, Inc. v. Drake Publishers, Inc.* 811 F.2d 26, 29 (1st Cir. 1987)). For precisely that reason, use of a mark to criticize the markholder is protected by the First Amendment and does not constitute infringement. *See, e.g., Lamparello v. Falwell*, 420 F.3d 309, 317-18 (4th Cir. 2005)(a "markholder cannot 'shield itself from criticism by forbidding the use of its name in commentaries critical of its conduct'"(interal citations omitted).

Your letter contends that MoveOn is not commenting on the "owner or his mark," because the billboard criticizes the Governor while the owner is the Office of Lieutenant Governor, which you characterize as a "third party." We reject the suggestions that the Mark belongs personally to the Lieutenant Governor or that he is not part of the State Government. As noted, this Mark is not registered to the Lieutenant Governor personally, nor to the Office of the Lieutenant Governor. It is registered to a Louisiana state agency, the Department of Culture, Recreation and Tourism.

That this Department is headed by the Lieutenant Governor manifestly does not make him a "third party" with respect to the State Government, or with respect to the head of that State Government, the Governor of Louisiana. The Department is not the personal estate or property or some private enterprise of the Lieutenant Governor. To the contrary, Louisiana Revised Statutes §36:204(A)(1) provides that the Secretary of the Department of Culture, Recreation and Tourism shall "[r]epresent the public interest in the administration of this Chapter and shall be responsible to the governor, the legislature and the public therefor." The Mark by definition belongs to, and must be used for, the benefit of the State of Louisiana. For purposes of any infringement analysis, the State Government of Louisiana is the holder of the mark and the State Government's current policy is what the billboard criticizes.

Finally, because of the expressive nature of the use of the Mark, the "likelihood of confusion must be 'particularly compelling' to outweigh the first Amendment interests at stake." *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665 (5th Cir. 2000). In this case, there is no likelihood of confusion at all, let alone a "compelling" one.

For these reasons, MoveOn must respectfully decline your request that it cease and desist from use of the Mark on the billboard. If you have any questions or need any further information, please contact the undersigned.

Sincerely yours,

Joseph E. Sandler