

PUBLIC CITIZEN LITIGATION GROUP

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May 23, 2016

Kenneth C. Booth, Esquire
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Dear Mr. Booth:

I write in response to your May 16, 2016, demand letter to Jeremy Whittaker, who is running for the Mesa City Council against a longtime city employee who enjoys endorsements from several incumbent elected officials. Your letter threatens legal action over the political campaign literature, lawn signs and Internet sites that Whittaker has been using in his campaign for the Mesa City Council. You claim the placement on these campaign materials of the “three-tier” symbol that the City of Mesa has adopted as its insignia infringes the city’s trademark. Whittaker has received similar complaints by email from Deputy City Attorney Alfred Smith and City Clerk DeeAnn Mickelsen about his use of that logo, as well as about his display of the shield of the Mesa police force on a web page of his campaign web site that discusses his opinions about the issue of public safety in Mesa.

As I explain in this letter, not every use of a trademark constitutes infringement, and the First Amendment protects Whittaker’s use of these logos for purposes of noncommercial political expression. Moreover, your claims of trademark infringement run counter to controlling law in the Ninth Circuit. Consequently, Whittaker is not going to give in to your demand on behalf of the incumbent city officials, who apparently hope to use trademark bullying to run up the costs of an independent candidate challenging a longtime city employee whom the incumbents prefer. Whittaker will not stop using the insignia and, in fact, he is going to restore the police shield to his web site. I also strongly suggest that your client retract its claims of infringement because the alternative could be litigation that will cost the City of Mesa dearly, but lead to its inevitable defeat.

The First Amendment Bars Your Claims.

To begin with, wholly apart from the construction of the Lanham Act, Whittaker has used these two symbols in connection with his campaign for public office, political speech that is at the core of the protections protected by the First Amendment. Moreover, his use of the logos is entirely truthful—it identifies the city for whose office he is running. The First Amendment bars the



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government from taking action to forbid truthful political speech. Your client is a government body, which is directly barred by the First Amendment from taking action against truthful political speech. A lawsuit seeking to enjoin Whittaker's political speech would be barred even if your client were a private party, because injunctions or damage awards by courts are the actions of government agencies that are subject to First Amendment scrutiny. *New York Times v. Sullivan*, 376 U.S. 254 (1964); *Organization for a Better Austin v. Keefe*, 402 U.S. 415 (1971).

The Lanham Act Does Not Support Your Infringement Claims.

Even apart from the First Amendment, the assertion by Mesa officials that others must get their permission for any use of the city's trademarks is flatly wrong. For example, Mikkelsen wrote as follows: "All City logos are owned by the City of Mesa and cannot be used in any form without the prior authorization from the City of Mesa Public Information Office." But that is not correct, and I rather expect that your client's officials are fully cognizant of those limits, because a quick glance around the Internet reveals dozens of web sites where Mesa's logo is displayed to identify the city as a subject of discussion, but those uses are not by insurgent candidates whom the city officials oppose. I assume that the city has not undertaken a campaign to suppress the use of its logo, for example, on a blog about things to do in Mesa, <https://jillbadair.wordpress.com/about/>, or by such commercial enterprises as a local dentist, <http://www.drrobison.com/category/mesa-dentist/>, a consulting firm, <http://www.fmgrou.net/due-diligence-experience-2/>, a software company, <http://www.zabbix.com/users.php>, a for-profit training company, <http://www.relationshipbuildingacademy.com/mesa-location/>, and a landscape management company, <http://www.dlresources.com/#!/partners/c8hd>. It would be interesting to learn whether they have gone after **anybody** besides a candidate whom they oppose.

As you know, trademark rights are not absolute. Mesa is only entitled to prevent the use of its logo in connection with the sale or advertising of goods and services in a way that would confuse reasonable consumers about whether the use is sponsored by the city, and then its rights are limited by affirmative defenses such as fair use. Each of these limitations precludes your trademark infringement claims.

First, your effort to invoke the trademark laws to limit noncommercial political expression is barred by the Ninth Circuit's decision in *Bosley Medical Institute v. Kremer*, 403 F.3d 672 (9th Cir. 2005). That case involved the use of the plaintiff's trademark as the domain name for an Internet "gripe site" in which Michael Kremer was criticizing the plaintiff company. The district court dismissed Bosley's claims for trademark infringement and dilution, and the court of appeals affirmed because "trademark infringement law prevents only unauthorized uses of a trademark in connection with a **commercial** transaction in which the trademark is being used to confuse **potential consumers**." *Id.* at 676 (emphasis added). Like Kremer, Whittaker is not using the City's various logos to sell any goods or services, but only to identify the government body whose policies and operation he hopes to improve by being elected to public office. Consequently, "[Mesa] cannot use

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the Lanham Act either as a shield from [Whittaker]’s criticism, or as a sword to shut [Whittaker] up.” *Id.* at 680. *See also Radiance Found. v. NAACP*, 786 F.3d 316, 325-326 (4th Cir. 2015); *Utah Lighthouse Ministry v. Found. for Apologetic Info. and Research*, 527 F.3d 1045, 1051-1052 (10th Cir. 2008); *Taubman Co. v Webfeats*, 319 F.3d 770, 774 (6th Cir. 2003).

Second, even if your client could show a commercial use of its marks, Whittaker has employed the marks to identify the subjects of his commentary, and is thus protected by the doctrine of nominative fair use, which has been recognized by the Ninth Circuit since *New Kids on the Block v. News America Publishing*, 971 F.2d 302 (9th Cir. 1992). Whittaker cannot meaningfully identify his candidacy without making clear that it is for the **Mesa** City Council that he is running, just as the artist whom Mattel sued for his parody of the Barbie doll had to use her likeness to make the point of his parody clear. *See Mattel v. Walking Mountain*, 353 F.3d 792 (9th Cir. 2003). The city’s success in letting its logo stand in as a shorthand for the city provides as well the necessity to use the logo so that members of the public driving by his lawn signs or seeing his campaign literature understand at a glance that he is a candidate for office in **their** city.

Third, your letter asserts that the placement of the city’s logos on campaign material “falsely encourag[es] a public belief that [Whittaker is] endorsed by the City of Mesa.” We see no likelihood of confusion, and the fact (recited in your demand letter) that some “other candidates” have complained about the use of the logo does not show any likelihood of confusion about source or sponsorship. It is, indeed, regrettable that your letter shows so little confidence in the intelligence of your client’s constituents. The citizens of Mesa are surely used to the fact that there are periodic elections for city offices and that, even if some candidates are supported by the incumbent officials who employ you and support Whittaker’s electoral adversary (and who, indeed, are displayed on that candidate’s web site wearing lapel pins bearing the city logo), candidates are not sponsored or endorsed by the city government itself.

Your Claims Pose Serious Risks to the City’s Assets.

For all of these reasons, your assertion that Whittaker is infringing your client’s trademarks, and your threat of litigation, is taking your client down a very dangerous and costly road. In our view, your trademark claims are so plainly groundless that an infringement suit would be an “exceptional case” warranting an award of attorney fees. *See Mattel v. Walking Mountain*, 353 F.3d 792, 816 (9th Cir. 2003); *Baker v DeShong*, 2016 WL 2342963 (5th Cir. May 3, 2016). If your client brings a lawsuit, it could so easily cost the city tens of thousands of dollars in attorney fees once it has paid your fees, and then an award of attorney fees to Whittaker’s counsel.

But there is one more important reason why your client should withdraw its claims: litigating the claims could result in the cancellation of your client’s trademark. In my letter so far, I have indulged the assumption that your client has consistently made, and on which your letter rests: that the three-tier logo is effectively Mesa’s city insignia. But your demand letter performs a clever

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sleight of hand—you say that you are writing on behalf of the “City of Mesa Municipal Development Corporation,” which you say will be referenced as “City of Mesa”; then you go on to talk about how the logo belongs to the City of Mesa. But it does not, and it cannot. Section 2(b) of the Lanham Act, 15 U.S.C. § 1052(b), provides that no mark may be registered if it “consists of or comprises the flag or coat of arms or other insignia of . . . any State or municipality.” That is no doubt why, instead of seeking to register the three-tier logo on behalf of the City of Mesa as a city insignia, you secured Registration No. 4,073,776 as counsel for the City of Mesa Municipal Development Corporation, and only for such specialized services as construction planning, library services, utility services and the like. You made no claim that this would be a mark for political campaign purposes, and no claim that it would be a general city logo. Yet the repeated contentions by Mikkelsen and Smith, and indeed by your own letter, that this is the city’s logo, are flatly inconsistent with the limited purposes for which this logo was registered. If we have to litigate this case, the record will only draw public attention to how your client is trying to expand the rights conferred by the federal registration beyond what the Lanham Act allows, and, indeed, in a manner that runs afoul of the First Amendment. “Trademark law is not properly employed to stifle discussion.” *Renna v. Cty. of Union, N.J.*, 88 F. Supp. 3d 310, 322 (D.N.J. 2014)

Indeed, I suggest you pay careful attention to the *Renna* decision, which discusses the reasons why First Amendment limits on government’s right to suppress speech about itself make trademark rights inappropriate for municipal insignia, whether asserted as registered rights or unregistered rights. In that regard, there is an additional issue with which you and your client should be concerned. Notwithstanding the peremptory language of the statutory exception, the Trademark Office has been construing that exception narrowly to allow certain government agencies to register logos for narrow purposes, even if states and municipalities themselves cannot. *See, e.g., In re City of Houston*, 101 U.S.P.Q.2d 1534 (Trademark Tr. & App. Bd. Jan. 18, 2012), *aff’d*, 731 F.3d 1326 (Fed. Cir. 2013) (upholding Trademark Office’s refusal to register the seal of the City of Houston). In the course of preparing to litigate this case, we are considering whether this is a permissible interpretation of the statute. Regardless of that legal question, to the extent that the registrant represents that the mark is in fact the city’s logo, § 2(b) invalidates any registration of that mark, whether or not the registrant is the city or some other entity. *RE/MAX LLC v. M.L. Jones & Associates*, 2014 WL 7405461 (E.D.N.C. Dec. 30, 2014) (invalidating registration of mark identical to the flag of the Netherlands by unrelated entity based on plain language of § 2(b)). Given the claims made to Mr. Whittaker, moreover, your client is estopped from arguing that the mark is not identical to the municipality's insignia.

Whittaker Asks You to Retract Your Infringement Claim.

In conclusion, your client has no valid claims, and Whittaker is not going to comply with your demands. Indeed, Whittaker will be considering whether he is willing to allow you to dangle the threat of enforcement over his head while he continues to order campaign materials. Consequently, he reserves the possibility that, instead of waiting to be sued, he may choose to sue

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the City for a declaratory judgment of non-infringement. *See Renna v. Cty. of Union, N.J.*, 2015 WL 93800, at *9 (D.N.J. Jan. 7, 2015), *report and recommendation adopted*, 2015 WL 1815498 (D.N.J. Apr. 21, 2015) (awarding attorney fees against municipality whose trademark bullying forced expressive user of city insignia to seek declaratory judgment of non-infringement). Accordingly, we are giving your client ten business days from the date of this letter to retract your claims of trademark infringement.

We look forward to hearing from you.

Sincerely yours,



Paul Alan Levy