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United States District Court,
S.D. New York.

GTFM, LLC, FUBU Records, LLC, and GTFM, Inc., Plaintiffs,
v.
UNIVERSAL STUDIOS, INC., and Universal Music Group, Inc., Defendants.
No. 02 CV. 0506(RO).
May 16, 2006.

Ira N. Glauber-Jaffe & Asher LLP, for Plaintiffs.
Floyd A. Mandell, Kristin J. Achterhof-Katten Muchin Zavis Rosenman, for Defendants.
Elisabeth C. Yap-In-House Counsel, NBC Universal, for the Defendants.

MEMORANDUM & ORDER

OWEN,

J.

*1 Plaintiff companies GTFM and FUBU offer clothing and apparel under the popular “FUBU” mark-which stands for “For Us By Us”-targeted at the “multicultural youth generation,” and strive to promote the empowerment of multicultural youth through creativity and entrepreneurship. Defendant movie enterprise made brief usage of the acronym “BUFU” in a motion picture comedy. Plaintiffs FUBU assert that their company continues to take affirmative steps to ensure that its name and marks are not associated with anything that could taint the positive image it has fought to establish over the past 15 years, as well as to correct negative stereotypes attributed to multicultural youth in today's popular media. In December 2001, defendant Universal Studios released the film “How High”-a satirical “stoner comedy” about the ridiculous, fictional antics and adventures of two African-American youths (played by popular rappers Method Man and Redman), who, following a course of “supernatural” events involving a marijuana plant, find themselves (along with a full cast of characters who personify wide-ranging and exaggerated stereotypes) attending college at Harvard University. The movie also takes a few light-hearted shots at plaintiffs' FUBU marks and the image that it is marketed to represent. The brief references to “BUFU” in the middle of the film-three instances, in total-are made in the context of comedic dialogue between the film's outlandish characters.FN1 The characters poke fun at the FUBU name that plaintiffs use in their advertising-as an acronym for the motto, “For Us, By Us”-by using the made-up name “BUFU”-as an acronym for the phrase, “By Us, Fuck You”-in reference to one of the main characters' fictional “fashion line” of clothing. In addition to being a satirical play on words, “BUFU”-a transparent transportation of the letters in FUBU-is intended to be a parody of the persona that FUBU symbolizes in plaintiffs' advertising. Plaintiffs market their brand as embodying the spirit of the “multicultural youth generation” and “African-American empowerment,” and along with myriad other images, themes and persona parodied and satirized throughout “How High,” the film takes this somewhat lofty image that plaintiffs intend to convey vis-à-vis their use of the term FUBU, and turns it on its head by using BUFU in a few scenes.

FN1. In the movie How High, “BUFU” is referenced in the following instances: (1) when one of the main characters is complimented on his clothing, he responds: “I designed it myself. I call it ‘BUFU.’ ”; (2) when another character comes under the sway of the main characters, he is asked why he changed his behavior and clothing, and responds: “It's phat. It's dope. It's cool. It's BUFU, man.”; and (3) in a dialogue between the main characters, one asks, “What the hell are you wearing?” to which the other responds, “BUFU ... By Us Fuck You.”

On January 22, 2002, plaintiffs filed a complaint against both Universal Studios and Universal

Records,FN2 asserting various causes of action under the Lanham Act and New York common law for trademark infringement and dilution, false advertising, false designation of origin, unfair competition, defamation, breach of contract, and breach of fiduciary duty. They allege that FUBU's valuable name and reputation has been injured by crudely profane ridicule and by its association with the repugnant stereotype that multicultural youths require illegal drugs to empower themselves-a stereotype that FUBU has vigorously fought to correct. Defendants have moved for summary judgment and to dismiss the complaint in its entirety, and plaintiffs have cross-moved for a continuance and for further discovery pursuant to Fed.R.Civ.P. 56(f).

FN2. The latter defendant played no role in the creation, production, distribution or release of the film, and had no input as to the script or advertising. However, certain of plaintiffs' claims relate to a December 2000 joint venture agreement between Universal Records and FUBU Records, under which FUBU Records agreed to provide the recording services of various artists under contract with FUBU in exchange for the production, distribution, and marketing of albums featuring these artists by Universal Music. Pursuant to this agreement, Universal Music covenanted not to harm FUBU's property interests or do anything to impair or diminish the value of such interests, and to notify FUBU promptly upon learning of any infringement of said interests.

*2 Summary judgment is appropriate when there are no genuine issues of material fact and the moving party is entitled to judgment as a matter of law. Fed.R.Civ.P. 56(c); accord *Ann Howard Designs, L.P. v. Southern Frills, Inc.*, 992 F.Supp. 688, 689 (S.D.N.Y.1998) (Owen, J.) (granting summary judgment on Lanham Act claims for failure to prove likelihood of confusion). Once the moving party meets its burden, the non-movant must then present “specific facts”, not vague assertions, showing the existence of a genuine issue to be resolved-“rest[ing] upon the mere allegations or denials of the adverse party's pleading” is insufficient. Fed.R.Civ .P. 56(e); see also *Celotex Corp. v. Catrett*, 477 U.S. 317, 324 (1986); *Sado v. Ellis*, 882 F.Supp. 1401, 1402 (S.D.N.Y.1995) (Owen, J.) (citation omitted).

Summary judgment is appropriate here because Universal Studios used “BUFU” as a parody,FN3 which is entitled to full protection under the First Amendment and pursuant to the substantial body of case law establishing “safe harbors” for this form of comical expression.FN4 Parodies of trademarks necessarily incorporate the original mark's likeness in order for consumers to get the joke. Indeed, “[a] parody must convey two simultaneous-and contradictory-messages: that it is the original, but also that it is not the original and is instead a parody.” *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490, 494 (2d Cir.1989).FN5 In trademark infringement cases, parodies are protected where the mark is being used to lampoon or comment upon the trademark owner or the mark itself, “in which expression, and not commercial exploitation of another's trademark, is the primary intent, and in which there is a need to evoke the original work being parodied.” *Id.* at 495.“In such cases, the parodist is not trading on the good will of the trademark owner to market its own goods; rather, the parodist's sole purpose for using the mark is the parody itself, and precisely for that reason, the risk of consumer confusion is at its lowest.” *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F.Supp.2d 410, 414 (S.D.N . Y.2002).

FN3. In contemporary usage, parody is a form of satire that imitates another work, exploiting the peculiarities of that work's expression, in order to ridicule or to affectionately poke fun at the original work. Courts have noted various alternate definitions of the term, see, e.g., *Yankee Publishing Inc. v. News America Publishing Inc.*, 809 F.Supp. 267, 279 n. 11 (S.D.N.Y.1992) (“An imitation of a work more or less closely modeled on the original, but turned so as to produce a ridiculous effect.”); *Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F.Supp.2d 330, 337-38 (S.D.N.Y.2000) (“literary or artistic work that imitates the characteristic style of an author or a work for comic effect or ridicule.”).

FN4. See, e.g., *Yankee Publishing Inc. v. News America Publishing Inc.*, 809 F.Supp. 267, 279 (S.D.N.Y.1992) (“parody is merely an example of the types of expressive content that are favored in fair use analysis under the copyright law and [given] First Amendment deference under the trademark law … The message of [the leading Second Circuit trademark] cases is not merely that parody is accorded First Amendment deference, but rather that the use of a trademark in the communication of an expressive message is accorded such deference.”); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir.1987) (“Denying parodists the opportunity to poke fun at symbols and names which have become woven into the fabric of our daily life, would constitute a serious curtailment of a protected form of expression.”); *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F.Supp.2d 410, 414 (S.D.N.Y.2002) (“the Second Circuit has recognized that where the unauthorized use of a trademark is part of an expressive work, such as a parody, the Lanham Act must be construed narrowly … [T]he public interest in avoiding consumer confusion must be balanced against the public interest in free speech.”).

FN5. See also, *Hormel Foods Corp. v. Jim Henson Productions, Inc.*, 73 F.3d 497 (2d Cir.1996) (granting summary judgment for defendants because the Muppet puppet-character “Spa’am” was a parody of the luncheon meat SPAM, and thus, unlikely to cause confusion); *Universal City Studios, Inc. v. Nintendo Co., Ltd.*, 746 F.2d 112 (2d Cir.1984) (affirming summary judgment for defendant, finding that defendant’s “Donkey Kong” video game was a parody of “King Kong”).

Universal Studios was, indisputably, not acting as a competitor of plaintiffs’ by attempting to sell products or services under the name “BUFU.” FN6 Furthermore, plaintiffs’ FUBU marks appear nowhere in the film, and thus, plaintiffs have no claim that FUBU was used in a manner injurious to the mark and to its reputation and good will. To whatever extent, if any, one regards the parody as lewd or offensive, or whether one actually appreciates its comedic value, is entirely irrelevant to the issue of whether this expression of ideas should be afforded First Amendment protection, and judicial evaluations of the former sort will not be made. See *Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F.Supp .2d 330, 338 (S.D.N.Y.2000); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir.1987).

FN6. Obviously from the record, defendants did not use the term “BUFU” in the film to sell competing products. Indeed, defendants are not selling any “BUFU”-branded products-no such products exist; this is a fictional clothing line in a fictional movie. Plaintiffs attempt to draw a connection between Universal Studios and the clothing manufacturer Rocawear, based on: (1) the film’s wardrobe department allegedly having some “relationship” with Rocawear, (2) Rocawear’s promotion of an advanced screening of the film, and (3) the film’s two stars having some association with brands competitive to FUBU. This connection, to the extent it exists, is attenuated at best, and certainly does not rise to the level of establishing competitive or improper business motives on the part of defendants.

*3 While the Court must examine whether the use of “BUFU” within the context of the film is likely to cause confusion on the part of consumers “as to the source or sponsorship” of plaintiffs’ FUBU-branded products, see *Playtex Products, Inc. v. Georgia-Pacific Corp.*, 390 F.3d 158, 161 (2d Cir.2004), to determine this, under the authorities, the following eight non-exhaustive factors must be balanced: (i) the strength of plaintiff’s mark; (ii) the degree of similarity between the two parties’ marks; (iii) the proximity of the parties’ products in the marketplace; (iv) the likelihood that the prior user will “bridge the gap” between the products; (v) actual consumer confusion; (vi) the defendant’s good or bad faith in adopting plaintiff’s mark; (vii) the quality of defendant’s product; and (viii) the sophistication of the relevant consumer group. *Polaroid Corp. v. Polarad Electronics*

Corp., 287 F.2d 492, 495 (2d Cir.1961). An explicit consideration of each of the eight Polaroid factors tips the scales entirely in favor of the defendants, and need not be discussed here. There being no likelihood of confusion, and no tarnishing or dilution of the FUBU mark, there is no genuine issue of material fact with respect to any of plaintiffs' claims. This action, in the judgment of the Court, is "UFUB." FN7 Defendants' motion for summary judgment is, accordingly, granted as to all counts of the Complaint. Plaintiffs' cross-motion is denied. Over the several years this case has been pending, plaintiffs have failed to demonstrate how additional discovery could be reasonably expected to raise a genuine issue of material fact, and is denied. See *Miller v. Wolpoff & Abramson, L.L.P.*, 321 F.3d 292, 303-04 (2d Cir.2003).

FN7. "Utterly Frivolous Under Biopsy."

So Ordered.

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