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WRITING SAMPLE

I drafted this response to a cease and desist request as an exercise for Professor Jennifer Jenkins. Per her request, any identifying information has been redacted.

Washington, DC

Re: Use of Mark and Design

Dear Mr. ,

Thank you for your letter of September 10, 2010 regarding the , the world's premier Team Relay Quadrathlon. This annual fundraising event combines athletic events similar to those found in a traditional triathlon with a unique competitive eating twist: individual members of a four-person team must each complete an eating-and-athletic leg of the race (relay-style) before the team completes the final eating-and-athletic leg together.

The relay event and annual banquet serves to raise funds for charities in Durham, North Carolina that support youth-focused initiatives while simultaneously showcasing local eateries. In 2010, the raised approximately \$20,000 to benefit two organizations: DIG (Durham Inner-City Gardeners) and SeeSaw Studio. DIG is a youth-driven, urban farming leadership development program and SeeSaw Studio is a free after-school studio that helps teens transform their printing, crafting, textile, and industrial design skills into micro-enterprises.

The organizers have immense respect for , and recognize 's interest in protecting the distinctiveness of their marks, but 's request for written assurance that the will "immediately cease use of the mark in any form or fashion for any purpose" is meritless and outlandish. The concerns described in your letter suggest the possibility of further action under 15 U.S.C. § 1125, but these claims would likely fail in court.

As a threshold matter, to bring a civil action under § 1125(a), would have to prove the mark was "use[d] in commerce". While the Supreme Court has broadly interpreted "commercial activity" in past cases, the non-profit nature of the materials used for this charitable fundraising event would likely weigh against a finding of commerciality.

Even if the claim survives this threshold inquiry, § 1125(a)(1)(A) requires that the use "is likely to cause confusion, or to cause mistake," and there is no likelihood that the would cause confusion or mistake regarding . Both the marks and the associated events are distinct; it is highly unlikely that an individual would mistake a local competitive eating and fundraising event with a formal triathlon. In 1961, the Second Circuit set forth eight factors to evaluate the likelihood of confusion:

1. The strength of the mark;
2. The degree of similarity between the two marks;

3. The proximity of the products;
4. The likelihood the senior owner will bridge the gap;
5. Actual confusion;
6. The junior user's good faith in adopting the mark;
7. Quality of the respective goods;
8. And sophistication of relevant buyers.

(See *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (1961)). While the inquiry is highly fact-specific, and these eight factors are not dispositive, analyzed under the *Polaroid* test there is no likelihood of confusion. First, the [REDACTED] Design is a suggestive mark; a letter with the addition of a circle would not be considered a strong or highly unique mark. Second, incorporating a design similar to the [REDACTED] Design is just enough to call to mind the intense athleticism of [REDACTED], which is particularly ironic in the context of the [REDACTED], clearly a play on words poking fun at the event's emphasis on eating as well as sport. This parodic nature also weighs against the likelihood of consumer confusion for the third, fourth, fifth, and sixth factors. The seventh factor is extremely subjective, but the eighth factor also weighs in favor of the [REDACTED]: participants in our competitive eating event are sophisticated enough to understand they are not participants in an [REDACTED] triathlon.

Alternatively, a claim under § 1125(c) would also fail, even assuming the [REDACTED] mark is considered famous according to § 1125(c)(2)(A) (although your letter provided that "[REDACTED]'s family of [REDACTED] marks are widely known among the consuming public worldwide," the statute requires a court to consider all relevant factors before making that determination). The exclusions provided in § 1125(c)(3) protect [REDACTED], either as a noncommercial use or as a fair use under § 1125(c)(3)(A)(ii), which protects parody.

Even if a court were to find the exclusions did not apply, a claim of dilution by blurring is still absurd. The [REDACTED] mark is not similar enough to "impair the distinctiveness" of the [REDACTED] Design, and the only association the [REDACTED] intended to create with [REDACTED] was parodic.

The [REDACTED] is also certainly not likely to cause dilution by tarnishment: this community-driven charity event exists to support disadvantaged youth of Durham and local eateries. Any association arising from the similarity between the [REDACTED] and [REDACTED]'s marks would not harm the reputation of the [REDACTED] marks.

Even though the mark in Exhibit A is non-infringing, the [REDACTED] has already changed their logo; this should definitively resolve the matter. The [REDACTED] is appreciative of [REDACTED]'s recognition of our "light-hearted event," but attacking a local charitable organization on the grounds of a bogus claim is only an impediment to achieving our goal: helping children.

Sincerely,

Abby Liebeskind