



February 1, 2007

VIA EMAIL

Dennis M. O'Keefe
Attorney for Chicago Auto Show
c/o Lori Barca [lbarca@okeefepc.com]

RE: Legal Threats to Autoshowshutdown.org

Dear Mr. O'Keefe:

I am writing to you on behalf of my clients, Dan Korn and Todd Gee, in response to your email of January 29, 2007, threatening to sue them for trademark infringement in conjunction with their publication of the parody website AutoShowShutdown.org (the "Shutdown site"). This threat must be withdrawn immediately.

Simply put, your email attempts to stifle my clients' political speech by unsuccessfully recasting it as trademark infringement. As you are aware, the Shutdown site is a political parody and education site intended to help inform, energize and organize the citizens of Chicago to take part in the 8th Annual Auto Show SHUTDOWN Festival on February 10, 2007. The SHUTDOWN Festival, often attended by over 3,000 people, provides a forum for activists and citizens to express their concerns over the policies and practices of the oil and automotive industries, especially those companies and organizations that sponsor the Chicago Auto Show event. Thus, as a vehicle for the expression of free speech and a tool for political organizing, the Shutdown site is firmly protected by the First Amendment.

Moreover, your trademark infringement allegations are specious. The site does not infringe any trademark in "Chicago Auto Show." First, the site is non-commercial and thus cannot give rise to any cause of action under the Lanham Act. *See* 15 U.S.C. § 1125(a)(1) (limiting lawsuits under the Lanham Act to uses of a trademark "on or in connection with any goods or services"); *Bosley Med. Inst. v. Kremer*, 403 F.3d 672, 677 (9th Cir. 2005) (noncommercial use of mark on website for purposes of criticism cannot violate the Lanham Act).

Second, even if the Shutdown site were commercial, it is not clear that your client has a valid trademark in the phrase "Chicago Auto Show". A review of the United States Patent and Trademark Office ("USPTO") website reveals that you attempted to register the words "Chicago Auto Show" on behalf of your client as a trademark in 2004. *See* Exhibit A. However, the records also indicate that you abandoned the application in July

2006, after the application was twice rejected by the USPTO. *See* Exhibit B. Thus, you can imagine our surprise to see you now attempting to claims rights in mark you abandoned over six months ago. *See Mil-Mar Shoe Co, Inc. v. Shonac Corp.*, 75 F.3d 1153 (7th Cir. 1996) (“When the mark claimed as a trademark is not federally registered, the burden is on the claimant to establish that it is not an unprotectable generic mark.”).

Moreover, while we have not yet obtained the file, we suspect that the USPTO rejected the application because the phrase “Chicago Auto Show” is simply unprotectable as a trademark under these circumstances. At best, the phrase appears to be a mere description of events that involve automobiles and occur in the city of Chicago. *See Platinum Home Mortgage Corp v. Platinum Fin. Group, Inc.*, 149 F.3d 722, 727 (7th Cir. 1998) (finding generic terms to be unprotectable as trademarks as well as those that merely describe the characteristics or attributes of a good or service unless they have acquired secondary meaning). Thus, it would appear that you have no trademark rights in the phrase or any legal authority to restrict its use by others.

Even if “Chicago Auto Show” were a valid trademark, my clients would have every right to use those words on their website. Courts have consistently held that use of a trademark in order to parody or critique the trademark owner is a legal use of that trademark and fully protected by the First Amendment. *See Lamparello v. Falwell*, 420 F.3d 309, 315 (4th Cir. 2005) (use of trademark in domain name for website critical of trademark owner was not infringing); *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 792, 807 (9th Cir. 2003) (holding that commercial artist’s use of the trademark “Barbie” in works critical of markholder’s doll did not infringe the trademark because “the public interest in free and artistic expression greatly outweighs [the] interest in potential consumer confusion.”); *Nike, Inc. v. Just Did It Enterprises*, 6 F.3d 1225, 1227 (7th Cir. 1993) (“Manufacturers and merchants ... hope the public at large identifies their trademarks. When businesses seek the national spotlight, part of the territory includes accepting a certain amount of ridicule. The First Amendment, which protects individuals from laws infringing free expression, allows such ridicule in the form of parody.”).

Finally, such use is also protected by the doctrine of Nominative Fair Use, which allows speakers to use a trademark when referring to the product or service of the trademark owner such as comparative advertising or critique. *See New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308-09 (9th Cir. 1992).

Dennis M. O'Keefe
February 1, 2007
Page 3

In summary, we see your email as nothing more than a thinly veiled attempt to misuse the law to censor the free speech and political protest rights of my clients. We strongly recommend that you withdraw your threat and issue an immediate apology, as we are prepared to defend these rights vigorously and seek all appropriate relief available from the courts if necessary.

Sincerely,



Jason Schultz
Staff Attorney
Electronic Frontier Foundation
Jason@eff.org
(415) 436-9333 x 112

cc: Dan Korn
Todd Gee

enclosures