

PUBLIC CITIZEN LITIGATION GROUP

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October 23, 2006

Via Email

Deborah Lively
Thompson & Knight LLP
1700 Pacific Ave. Suite 3300
Dallas, Texas 75201-4693

Re: BNSF's Cease-and-Desist Letter to Jay Youngdahl

Dear Ms. Lively:

Jay Youngdahl has asked for our assistance in responding to your letter of October 6, 2006, in which you demand that he immediately remove images of paintings from his website at <http://www.youngdahl.com/>. You claim that, because the paintings contain representations of BNSF trains, they infringe and dilute BNSF's trademark and trade dress. We strongly disagree with your interpretation of trademark law, which would create a far-reaching chill on a wide range of artistic expression protected by the First Amendment. Not only are your claims without merit, we believe they would potentially subject BNSF to attorneys' fees were you to pursue them in court. We therefore ask that you withdraw your demands against Mr. Youngdahl.

As you know, the Youngdahl Law Firm brings claims on behalf of injured railroad workers under the Federal Employers' Liability Act (FELA). Part of the firm's website includes a gallery of images created by New Mexico artist Douglas Johnson. Johnson's paintings show railroad workers either working or on strike. They also show several trains, some of which may represent trains owned by BNSF. Youngdahl commissioned the paintings from Johnson to show the challenges faced by railroad workers, a subject that he feels has historically been ignored in the art world.

To the extent BNSF's trade dress and trademarks are represented in the paintings, they are used only to aid communication of the message of the art, not to indicate the source of any goods or services. The trademark laws—both infringement and dilution—do “not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view.” *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987). “[W]hen unauthorized use of another's mark is part of a communicative message and not a source identifier, the First Amendment is implicated in opposition to the trademark right.” *Yankee Publ'g, Inc. v. News Am. Publ'g, Inc.*, 809 F. Supp. 267, 276 (S.D.N.Y. 1992).

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In *Mattel, Inc. v. Walking Mountain Productions*, for example, the defendant took photographs of Barbie dolls in various absurd and sexualized poses for the purpose of critiquing the objectification of women. 353 F.3d 792 (9th Cir. 2003). The court rejected Mattel's claims of trademark infringement and dilution, holding that the art was protected First Amendment expression that outweighed Mattel's interest in protecting its Barbie trademark. *Id.*; see also *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003) (holding that an artist's painting of Tiger Woods was protected by the First Amendment); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996) (holding that the First Amendment protected parody baseball cards designed to comment on public figures).

Because of the importance of artistic expression in our society, artistic works can be suppressed by trademark law only in rare cases "where the public interest in avoiding consumer confusion outweighs the public interest in free expression." *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989). This balancing test can only be satisfied when the trademark used "has no artistic relevance to the underlying work *whatsoever*" or "*explicitly* misleads as to the *source or the content* of the work." *Id.* (emphasis added); see also *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664-65 (5th Cir. 2000) (adopting the *Rogers* test). In this case, the trains depicted in the paintings are relevant to the subject of the underlying work—the struggles of railroad workers—and are in no way misleading. The paintings are therefore subject to full First Amendment protection as expressive works.

Your assertion that the paintings are misleading because they "suggest[] that all FELA claims are claims made against BNSF" is not credible. To begin with, a variety of trains from other companies are represented in the gallery—including trains belonging to Union Pacific and Amtrak. BNSF therefore cannot claim that it was singled out for special treatment. Even if only BNSF trains were shown, however, BNSF would have no right to demand that Youngdahl remove the images. BNSF has in fact faced FELA claims in the past, including some brought by the Youngdahl Law Firm, and no reasonable viewer of these paintings would reach the conclusion that no other railroad companies had ever faced similar claims. If there were any remaining doubt, it would be dispelled by Youngdahl's addition of a disclaimer to his website, in which he explicitly states that "FELA claims are filed against all railroads." See <http://www.youngdahl.com/disclaimer.htm>.

Moreover, the type of confusion you allege in your letter is not confusion regarding the "the source or the content of the work" that is the subject of trademark law. *Rogers*, 875 F.2d at 999. The limited purpose of trademark law is to "prevent[] others from duping consumers into buying a product they mistakenly believe is sponsored by the trademark owner." *Walking Mountain Prods.*, 353 F.3d at 806 (quotation omitted). Given that the image depicts striking railroad workers and the website is largely devoted to FELA claims against railroad companies, viewers of the images could not reasonably believe that either the paintings or the website on which they are hosted were created or sponsored by BNSF. See *id.* at 811 ("Critical works are

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much less likely to have a perceived affiliation with the original work.”). That railroad workers at BNSF have faced hardship may be a message that BNSF does not want communicated to the public, but it is not a message that BNSF has a right to control.

In addition to the First Amendment, the doctrine of nominal fair use also protects the images on Youngdahl’s website. Use of a trademark for purposes of commentary or criticism constitutes nominal fair use because it “does not implicate the source-identification function that is the purpose of trademark.” *New Kids on the Block v. News Am. Publ’g Inc.*, 971 F.2d 302, 308 (9th Cir. 1992). Nominative fair use protects against dilution as well as infringement claims. *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 806 (9th Cir. 2002) (“Uses that do not create an improper association between a mark and a new product but merely identify the trademark holder’s products should be excepted from the reach of the anti-dilution statute. Such uses cause no harm.”). The nominative fair use doctrine arises from the courts’ recognition that “it is often virtually impossible to refer to a particular product for purposes of comparison, criticism, point of reference, or any other such purpose without using the mark” and that “[m]uch useful social and commercial discourse would be all but impossible if speakers were under threat of an infringement lawsuit every time they made reference to a person, company or product by using its trademark.” *New Kids on the Block*, 971 F.2d at 306-07.

Thus, in *Caterpillar v. Walt Disney Co.*, the court rejected a trademark claim by Caterpillar over the depiction of Caterpillar bulldozers in the Disney movie *George of the Jungle 2*. 287 F. Supp. 2d 913 (C.D. Ill. 2003). The court noted that trademark names are commonly used in movies and television without permission, and that Disney’s use of Caterpillar’s trademark did not implicate the source-identifying function of trademark law. *Id.* at 919-20; *see also Wham-O, Inc. v. Paramount Pictures Corp.*, 286 F. Supp. 2d 1254 (N.D. Cal. 2003) (refusing to require moviemakers to refer to Wham-O’s Slip ‘n Slide generically as a “water slide” or a “lubricated plastic sheet”). For the same reason, Andy Warhol’s famous paintings of a Campbell’s soup can would not give rise to a trademark claim. As the court wrote in *Mattel, Inc. v. MCA Records* in holding that the song “Barbie Girl” does not infringe Mattel’s trademark: “If we see a painting titled ‘Campbell’s Chicken Noodle Soup,’ we’re unlikely to believe that Campbell’s has branched into the art business. Nor, upon hearing Janis Joplin croon ‘Oh Lord, won’t you buy me a Mercedes-Benz?,’ would we suspect that she and the carmaker had entered into a joint venture.” 296 F.3d 894, 902 (9th Cir. 2002).

For these reasons, we believe BNSF’s claims against Mr. Youngdahl are meritless. If you nevertheless decide to follow through on your threat to file suit against Mr. Youngdahl, we believe he may be entitled to attorneys’ fees under the Lanham Act. The Ninth Circuit in *Walking Mountain* suggested that attorneys’ fees may have been available in that case, where a trademark owner attempted to suppress artistic works that were “protected by policy interests in free expression,” and where Mattel’s claim against the artist “may have been groundless or unreasonable.” 353 F.3d at 816. Similarly, if BNSF is attempting to use the trademark laws to

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silence protected First Amendment speech merely because it does not like the content of that speech, we believe it would be liable for attorneys' fees here.

We therefore request that you immediately withdraw your demand against Mr. Youngdahl. Thank you for your attention to this matter.

Sincerely,

A handwritten signature in black ink, appearing to read "Gregory Beck". The signature is written in a cursive style with a large, looping initial "G".

Gregory A. Beck