

PUBLIC CITIZEN LITIGATION GROUP

1600 20TH STREET, N.W.
WASHINGTON, D.C. 20009-1001

—
(202) 588-1000

BY EMAIL TO suzann.wilcox@nelsonmullins.com

June 4, 2021

Suzann M. Wilcox, Esquire
Nelson Mullins Riley & Scarborough LLP
Suite 1700
2011 17th Street NW
Atlanta, Georgia 30363

Dear Ms. Wilcox:

I write to you in response to your June 1, 2021 demand letter to Richard Pellegrino, threatening that the Cobb County School District will sue him for trademark infringement unless he stops displaying on social media the image of a leaflet he had seen on Facebook that contains the District's logo, and indeed, never uses any logo or symbol of the District ever again no matter what context. The leaflet, a copy of which is attached, calls on members of the public to come to the next School District board meeting to demonstrate, in honor of Juneteenth, their support for minority members of the school board and their efforts to achieve greater diversity in public education. Your contention is that members of the public cannot use the District's logo adjacent to the words "Board Meeting" to denominate which board meeting they are urging the public to attend. So far as we know, Pellegrino, who as the Field Director for the Cobb Southern Christian Leadership Conference ("CSCLC") has been one of your client's leading critics on issues of diversity and racism, is the only person who has received such a threat of litigation over this leaflet, even though, as Pellegrino has already explained to you in his own letter, he did not prepare the leaflet—he just saw it and re-used it. Pellegrino is going to continue to exercise his rights under the First Amendment to display the leaflet. My purpose in writing is to explain to you why you cannot hope to succeed on your trademark claims.

In displaying the leaflet in social media, Pellegrino is not engaged in the sale or advertising of goods and services; he is, rather, engaged in noncommercial speech on political issues, which is at the core of the protections provided by the First Amendment. Many courts have held outright that the trademark laws, and the Lanham Act in particular, do not apply to noncommercial speech that is directed to discussion of a trademark owner, in part to avoid unnecessary conflict with the First Amendment. *Farah v. Esquire Magazine*, 736 F.3d 528, 541 (D.C.Cir. 2013); *Utah Lighthouse Ministry v. Foundation for Apologetic Information and Research*, 527 F.3d 1045 (10th Cir. 2008); *Bosley Medical v. Kremer*, 403 F.3d 672 (9th Cir. 2005); *TMI v. Maxwell*, 368 F.3d 433, 436-438 (5th Cir. 2004); Cir 2004); *Taubman v. WebFeats*, 319 F.3d 770 (6th Cir. 2003). The Eleventh and Fourth Circuits, although not reaching that question, have held that trademark law must be construed narrowly to avoid conflict with the First Amendment when plaintiffs attempt to apply it to



Suzann M. Wilcox, Esquire

June 4, 2021

page 2

noncommercial expression. *Radiance Foundation v. N.A.A.C.P.*, 786 F.3d 316, 322 (4th Cir. 2015); *University of Alabama Bd. of Trustees v. New Life Art*, 683 F.3d 1266, 1278 (11th Cir. 2012). See also *Smith v. Wal-Mart Stores*, 537 F. Supp. 2d 1302, 1339 (N.D. Ga. 2008). Other courts have held that attempted application of state trademark law could run afoul of the First Amendment. *L.L. Bean v. Drake Publishers*, 811 F.2d 26, 33 (1st Cir. 1987). Consequently, in the event you follow through on your threat to sue Pellegrino, we will be prepared to defend him both on First Amendment grounds, and on the ground that his noncommercial speech is not subject to regulation by the trademark laws.

Your letter asserts that use of the logo “has created confusion as to the source or sponsorship of the event and is misleading to the public.” Your client’s own web site acknowledges, <https://www.cobbk12.org/page/59/calendar>, that your client is conducting a Board meeting on the evening of June 10. Thus, it is indisputably true that your client is both the source and the sponsor of the event at which the leaflet is directed, that is, the school board meeting, so it is difficult to understand your contention that the public is confused or has been misled. Moreover, the leaflet begins with reference to the need to support “minority school board members,” and goes on to condemn “exclusion” and “systemic racism” on your client’s part. These parts of the leaflet make clear that it is not the School District itself that is urging attendance. Unless members of the public think that your client would likely accuse itself of exclusion and systemic racism, the public about which you claim to be concerned could not possibly be confused about whether your client has put out this leaflet. However, to the extent that your letter implies that you have admissible evidence of actual confusion on the part of members of the public, I invite you to provide me with that evidence.

Even if you otherwise had a tenable claim for trademark infringement, the leaflet makes fair use of your client’s logo to identify your client as the entity that is having the meeting. Thus, Pellegrino’s display of the leaflet is protected by the doctrine of nominative fair use. *Pergo (Europe) v. Stanley Black & Decker*, 2017 WL 3525435, at *6 (N.D. Ga. Jan. 6, 2017); *Brookwood Funding v. Avant Credit Corp.*, 2015 WL 11504556, at *6 (N.D. Ga. July 28, 2015).

Moreover, there is an additional flaw in your legal claim. Section 1052(b) of the Lanham Act specifically provides that “the insignia of the United States, or of any State or municipality” cannot be registered, and several courts have held that, as a result, no trademark protection can be extended to any marks that come within that prohibition. *Bangkok Bangkok Import & Export v. Jamtan African Am. Mkt. Corp.*, 2016 WL 4939081, at *2 (S.D.N.Y. Aug. 29, 2016); *Renna v. County of Union, New Jersey*, 88 F. Supp.3d 310, 320-321 (D.N.J. 2014). Under federal law, school districts qualify as municipalities, *Hill v. Cundiff*, 797 F.3d 948, 977 (11th Cir. 2015); *S.W. v. Clayton County Pub. Schools*, 185 F. Supp. 3d 1366, 1379 (N.D. Ga. 2016), and the logo you are trying to enforce is plainly an insignia. Consequently, in the event you decide to sue Pellegrino, we will put in issue the enforceability of your client’s logo under the Lanham Act.

Finally, your letter suggests that your lawsuit might seek relief for trademark dilution.

Suzann M. Wilcox, Esquire
June 4, 2021
page 3

However, a dilution claim under the Lanham Act can only be brought to enforce a mark that is “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner.” 15 U.S.C. § 1125(c)(2)(A). Your client's logo certainly does not meet that standard. The Lanham Act also excludes noncommercial as well as nominative fair uses from dilution liability. 15 U.S.C. § 1125(c)(3)(A) and (C). And because a state-law dilution claim would allow enforcement of your client's mark against political speech without any showing of falsehood, such a claim would plainly be unconstitutional in violation of the First Amendment, as held in such cases as *L.L.Bean v Drake Publishers*.

In sum, you do not have any valid trademark claims, and Pellegrino is not going to stop displaying the leaflet on social media pages. I recommend that you eliminate any case or controversy between the parties by retracting your demand that he cease and desist.

Sincerely yours,


Paul Alan Levy



Show Up. Sign Up. SpeakUp!

Show support for our minority school board members and their efforts to bring diversity to a district full of diverse people. Equity and inclusion create a system where everyone wins!

Sign up starts at 6pm and your voice is needed! Let's show them the support they deserve as we celebrate Juneteenth! Freedom comes in different forms and fights. The community must show up to be heard. Your story matters. Use your voice to make sure it's heard.



Board Meeting

June 10, 2021 at 7:00 pm

Sign Up at 6:00 pm

Diversity in education unites our worlds.
Exclusion leaves us misinformed & is a part of systemic racism.

**JUNE
TEENTH
FREEDOM DAY**



**Cobb County Board of Education
514 Glover Street
Marietta, Ga. 30060**