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Mouthwash maker tackles a parody

IP NEWS CHALLENGE

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Welcome to today's Intellectual Property Challenge, where we pose a question and you guess the answer.

Question: Does a parody of a famous trademark create a likelihood of confusion?

Discussion: Pissterine LLC filed an intent to use application for the trademark Pissterine. The company described its products as: "Mouthwashes, not for medical purposes; Non-medicated mouthwash and gargle; Non-medicated mouthwashes" in International Class 003. Although it had not yet alleged use of the mark in commerce, its Facebook page posted a picture of a bottle of yellow liquid with a label using the name.

Johnson & Johnson, which makes mouthwash and oral care goods under the name Listerine, holds nine registered trademarks for the name, the first registered in 1903.

J&J filed an opposition to the allowance of the Pissterine intent to use application before the Trademark Trial and Appeal Board, alleging the name creates a likelihood of confusion.

The trademark board used relevant factors of confusion enumerated in *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) to determine whether confusion was likely.

It found that Listerine was an arbitrary name for the goods, and so had both inherent and conceptual strength as a trademark. It agreed with J&J that the mark was famous. And it found that the marks contained similar strings of letters and sounded similar and that the goods and channels of trade were similar. All of these factors weighed in favor of a likelihood of confusion.

The board also discussed relevant factors that it deemed to be neutral on confusion. A consumer's care in choosing between the products didn't seem to matter.

But the most interesting neutral factor was Pissterine's intent in adopting the name. J&J argued, and the board acknowledged, that the name was obviously intended to parody Listerine. The board stated: "... by its very nature [parody] is an attempt to create an association in the form an outlandish imitation."

Parody is not a defense if the marks would otherwise be considered confusingly similar. However, J&J did not submit sufficient evidence that Pissterine intended to cause confusion.

Answer: The opposition was sustained.

Case Cite: *Johnson & Johnson v. Pissterine, LLC,* Opposition No. 91254670 (TTAB, Jan.18, 2022).

Sur-Reply: Parody trademarks can avoid a likelihood of confusion. The best examples are in the realm of dog toys.

In *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC,* 507 F.3d 252 (4th Cir. 2007), the defendant manufactured dog toys that mimicked plaintiff's handbags under the name Chewy Vuiton. The Fourth Circuit upheld summary judgment in the defendant's favor because the likelihood of confusion factors substantially favored the defendant.

In VIP Prods. Ltd. Liab. Co. v. Jack Daniel's Props., 953 F.3d 1170 (9th Cir. 2020), the court held that dog toys that looked like a Jack Daniel's No. 7 Black Label bottle did not create a likelihood of confusion. The toy conveyed a humorous message protected by the First Amendment.