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**IF YOU GIVE A MOUSE A TRADEMARK: DISNEY'S
MONOPOLY ON TRADEMARKS IN THE ENTERTAINMENT
INDUSTRY**

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I. INTRODUCTION..... 599

II. BACKGROUND..... 600

 A. TRADEMARK INTRODUCTION 600

 B. DEADMAU5 AND DISNEY DISPUTE BACKGROUND ... 602

 C. DISNEY'S TACTICS TO PROTECT MICKEY 606

III. ANALYSIS..... 610

 A. LANHAM ACT REMEDY REFORM 610

 1. *Injunctions* 611

 2. *Compensatory Damages* 612

 3. *Defendant's Lost Profits* 613

 B. CONSUMER CONFUSION SURVEYS..... 615

IV. CONCLUSION 618

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I. INTRODUCTION

If you give a mouse a trademark, the mouse will target other users of similar marks and claim infringement. If the marks of innocent and creative users are opposed, they will be forced to waste countless dollars defending their claims in court. If users are forced into court, many will be unable to afford the litigation costs and will forfeit their trademarks. If users forfeit their trademarks, the public domain will suffer a lack of creativity. If the public domain lacks creative efforts from other artists, the mouse will achieve a monopoly.

Joel Zimmerman, the world-renowned DJ deadmau5, learned this slippery slope through his efforts to trademark his own logo.¹ On August 18, 2014, Zimmerman filed a trademark for his mau5head logo, a mouse-shaped helmet that covers his face during his concerts.² However, Disney opposed Zimmerman's filing, claiming the mark resembles its pivotal figure, Mickey Mouse.³ Following, Zimmerman used social media to attack Disney's opposition.⁴ Disney then retracted two offers to work with Zimmerman in the near future on its *Star Wars Rebels* and *Fantasia* projects, and even had a hand in cancelling an appearance Zimmerman was supposed to make on Jimmy Kimmel.⁵ At this time, the United States Patent and Trademark Office ("USPTO") has not resolved this case and it refuses to comment on the timing of resolution.⁶ Some speculate that it could take years until the USPTO reviews this case, especially from an instance between two "warring parents" like Zimmerman and Disney.⁷

¹ Ed Brackett, *Disney Takes on DJ Deadmau5 over Mouse-ears Garb*, USA TODAY (Sept. 14, 2014, 11:54 PM), <http://www.usatoday.com/story/money/business/2014/09/04/disney-deadmau5-deadmouse-mickey-mouse/15106939/>; Adam Sherwin, *Deadmau5 Fights Disney in Mouse Ear Logo Dispute*, THE INDEPENDENT (Sept. 4, 2014), <http://www.independent.co.uk/arts-entertainment/music/news/deadmau5-fights-disney-in-mouse-ear-logo-legal-dispute-9712131.html>.

² U.S. Trademark Application Serial No. 86,370,081 (filed Aug. 18, 2014); Brackett, *supra* note 1 ("The costume stops there, typically with a T-shirt and a pair of frequently waving, tattooed arms plainly visible under the helmet.").

³ Brackett, *supra* note 1.

⁴ Eriq Gardner, *Deadmau5 Says Disney Approached Him About Re-Imagining Fantasia (Exclusive)*, THE HOLLYWOOD REPORTER (Oct. 14, 2014, 9:30 AM), <http://www.hollywoodreporter.com/thr-esq/deadmau5-says-disney-approached-him-740615>.

⁵ *Id.*

⁶ Stan Alcorn, *Trademark Law: Why Disney is Fighting a Canadian DJ*, MARKETPLACE (Nov. 5, 2014), <http://www.marketplace.org/topics/business/trademark-law-why-disney-fighting-canadian-dj>.

⁷ *Id.*

This article begins with an overview of trademark law, followed by a brief history of the dispute between Zimmerman and Disney. The article will then look at the transition of Disney's intellectual property tactics over the past forty years. The article concludes with solutions to reform trademark law in order to prevent Disney from transforming its single Mickey Mouse trademark into a monopoly over all artists who want to use trademarks involving a mouse. The article suggests this can be done through altering the remedies for trademark law, allowing artists seeking trademarks to use scientific surveys, and reforming dilution laws.

II. BACKGROUND

A. Trademark Introduction

In 1946, Congress passed the Lanham Act to protect the trademark rights of individuals and corporations.⁸ The Lanham Act defined a trademark as any word, name, symbol or device intended for use in interstate commerce that distinguishes a good or service and identifies its source.⁹ Corporations and individuals utilize trademarks so that consumers can identify their products or services and to ensure quality and consistency for consumers when they use the corporation's products or services.¹⁰ This association between the trademark and the corporation makes some trademarks very valuable.¹¹ Trademark law has two main purposes. First, it provides a system that eliminates customer confusion by identifying the source of the goods or services.¹² Second, it gives corporations and individuals the exclusive right to the mark, which encourages others in the market to compete to have their own distinct mark.¹³

Corporations and individuals can apply for a trademark through filing a use-based application under 15 U.S.C. § 1051(a), or an intent-to-use application under § 1051(b).¹⁴ A use-based application is filed for a trademark that is already in the market whereas an intent-to-use

⁸ Joseph E. Edwards, Annotation, *What Constitutes "in Commerce" Within Meaning of § 32(1)(a) of Lanham Trade-Mark Act (15 U.S.C.A. § 1114(1)) Giving Right of Action for Infringement of Trademark "in Commerce"*, 15 A.L.R. FED. 368 (1973).

⁹ Trademark (Lanham) Act of 1946, 15 U.S.C. § 1127 (2012).

¹⁰ J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION §§ 3:2, 3:10 (4th ed. 2014).

¹¹ *Id.* at § 2:15.

¹² *Id.* at § 2:1.

¹³ *Id.*

¹⁴ Lanham Act § 1051.

application is filed for those who intend to begin using a trademark.¹⁵ If the application is approved, the mark is placed on the USPTO's Principal Register, and the mark holder has an exclusive right to use the mark in connection with its particular good or service.¹⁶

The USPTO is not responsible for monitoring the use of the protected mark.¹⁷ Instead, the USPTO focuses its efforts to make sure no other party is granted approval for a similar or identical mark.¹⁸ Thus, "the owner of a registration is responsible for bringing any legal action to stop a party from using an infringing mark."¹⁹

Trademark infringement occurs when a party uses in commerce "any word, term, name, symbol, or device . . . which is likely to cause confusion or to cause mistake."²⁰ To determine whether there is a likelihood of confusion, a court will look at: (1) "the strength or distinctiveness of the mark," (2) "the similarity of the two marks," (3) "the similarity of the goods/services the marks identify," (4) "the similarity of the advertising used by the two parties," (5) "the similarity of the advertising used by the two parties," (6) "the defendant's intent," and (7) "actual confusion."²¹ In order for a court to find a likelihood of confusion, a court does not need to find all of these factors.²² Additionally, a court does not have to value the factors equally and has

¹⁵ *Id.*

¹⁶ *Id.*

¹⁷ *Trademark Basics*, U.S. PATENT & TRADEMARK OFFICE, <http://www.uspto.gov/trademarks/basics/> (last visited May 22, 2015) ("You are responsible for enforcing your rights if you receive a registration because the USPTO does not 'police' the use of marks.").

¹⁸ *Id.*

¹⁹ *Id.* ("While the USPTO attempts to ensure that no other party receives a federal registration for an identical or similar mark for or as applied to related goods/services, the owner of a registration is responsible for bringing any legal action to stop a party from using an infringing mark.").

²⁰ Lanham Act § 1125.

²¹ *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984) ("To determine whether there is a likelihood of confusion under the trademark statute, courts generally consider a number of factors, which the district court, relying on *Sun-Fun Prods. v. Suntan Research & Dev.*, 656 F.2d 186, 189 (5th Cir. 1981) [did]."). Although the Supreme Court has not ruled on the factors in *Sun-Fun*, they are followed by the Fourth, Fifth, Eleventh Circuits and the Eastern District of New York. *See, e.g.*, *Pizzeria Uno Corp.*, 747 F.2d at 1527; *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 227–28 (5th Cir. 2009); *Sovereign Military Hospitaller Order of St. John of Jerusalem of Rhodes & of Malta v. Fla. Priory of the Knights Hospitallers of the Sovereign Order of St. John of Jerusalem, Knights of Malta, the Ecumenical Order*, 702 F.3d 1279, 1294 (11th Cir. 2012); *In re Joint E. & S. Dist. Asbestos Litig.*, 124 F.R.D. 538, 540 (E.D.N.Y. 1989).

²² *See Modular Cinemas of Am. Inc., v. Mini Cinemas Corp.*, 348 F. Supp. 578, 582 (S.D.N.Y. 1972) ("Not all of these are always relevant or equally emphasized in each case.").

the discretion to weigh some more than others.²³

When a party files for a trademark, any party who is damaged by the proposed registration listed on the USPTO's Principal Register must file an opposition in writing within thirty days.²⁴ When an opposition is filed, the USPTO sets a proceeding before the Trademark Trial and Appeal Board to resolve the dispute.²⁵ The Trademark Trial and Appeal Board may: (1) "refuse to register the opposed mark," (2) "cancel the registration of a mark or place restrictions on its use," (3) "refuse to register any mark," (4) "register the opposed mark . . . of persons who are found to be entitled to ownership," or (5) "order concurrent registration of marks along with conditions or restrictions on their use designed to prevent consumer confusion in the marketplace."²⁶

B. Deadmau5 and Disney Dispute Background

Joel Zimmerman, the thirty-three-year-old Canadian DJ sensation deamau5 (pronounced "dead mouse"), is famous worldwide for wearing his mau5head, a mouse-shaped helmet that covers his face during his concerts.²⁷ On August 18, 2014, Zimmerman filed a trademark for his mau5head logo, which is a registered trademark in thirty countries worldwide, including the United Kingdom, Japan, Germany, and Italy.²⁸ Zimmerman has used the mark in both the United States and worldwide for over a decade.²⁹ The mark is a caricature of a mouse head with big ears and white eyes with black X's over them like a dead mouse (see below).³⁰ Zimmerman does not claim color as part of the mark.³¹

²³ *Id.*

²⁴ *Opposing and Canceling a Trademark Registration*, NOLO LAW FOR ALL, <http://www.nolo.com/legal-encyclopedia/opposing-canceling-trademark-registration.html> (last visited May 21, 2015).

²⁵ *Id.*

²⁶ *Id.*

²⁷ Brackett, *supra* note 1; *Deadmau5 Takes on Disney in a Trademark Dispute*, BBC NEWSBEAT (Sept. 5, 2014), <http://www.bbc.co.uk/newsbeat/article/29078605/deadmau5-takes-on-disney-in-a-trademark-dispute>.

²⁸ BBC NEWSBEAT, *supra* note 27; U.S. Trademark Application Serial No. 86,370,081 (filed Aug. 18, 2014).

²⁹ Brackett, *supra* note 1.

³⁰ U.S. Trademark Application, *supra* note 28.

³¹ *Id.*



On September 2, 2014, Disney opposed the filing with a 171-page objection claiming that the mau5head is too similar to its own Mickey Mouse character.³² Disney alleges that the trademarks are so similar that the new trademark would violate the Lanham Act because it causes confusion or mistake.³³ Disney's opposition stated that the mau5head is "nearly identical in appearance, connotation, and overall commercial impression to Disney's Mouse Ears Marks . . . [both marks] are comprised of a round head with prominent round mouse ears in silhouette."³⁴ Disney defended its opposition, explaining that Mickey Mouse resembled the mau5head (see below).³⁵ Disney further argued that it had been using its mouse silhouette since 1928 and the mark is now "famous," "iconic," and "classic."³⁶

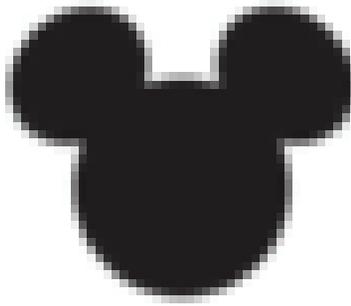
³² Brackett, *supra* note 1.

³³ *See id.*; Lanham Act § 1125.

³⁴ Ben Rayner, *Deadmau5 Accuses Disney of Copyright Infringement*, TORONTO STAR (Sept. 6, 2014), http://www.thestar.com/entertainment/music/2014/09/06/deadmau5_accuses_disney_of_copyright_infringement.html.

³⁵ Alcorn, *supra* note 6.

³⁶ Emily Thomas, *Disney Launches Trademark War with Deadmau5 Over Those Infamous Mouse Ears*, THE HUFFINGTON POST (Sept. 4, 2014, 1:59 PM), http://www.huffingtonpost.com/2014/09/04/disney-deadmau5-trademark-logo-lawsuit-mouse-head_n_5766050.html.



Upon receiving news of Disney's opposition, Zimmerman turned to a common form of social media, Twitter.³⁷ Zimmerman tweeted, "[I]anded home to some interesting news: looks like Disney officially filed in opposition of my trademark . . . lawyer up Mickey."³⁸ Later on, Zimmerman tweeted, "Disney thinks you might confuse an established electronic musician/performer with a cartoon mouse. That's how stupid they think you are."³⁹ Interestingly, in a previous interview with *Rolling Stone*, Zimmerman was asked about the similarity of his brand to Disney.⁴⁰ Zimmerman merely said, "[s]omeone at the Disney patent office fell asleep on that one."⁴¹ Perhaps Zimmerman was intending to be funny in his *Rolling Stone* interview, but upon later legal advice, he realized that paralleling his mau5head to Disney may have jeopardized his chances of registering his trademark.

On September 4, 2014, deadmau5 filed a cease and desist letter against Disney for allegedly using one of his songs in one of its cartoons.⁴² Zimmerman believes that Disney used its song "Ghosts 'n' Stuff Re-Micks" on Disney.com without a license.⁴³ Next to the video, Disney included the caption "Enjoy a spooky cartoon Re-Micks to the tune of Deadmau5's 'Ghosts 'n' Stuff.'"⁴⁴ Zimmerman's cease and desist letter says that Disney's caption insinuates "a non-existent endorsement by Zimmerman."⁴⁵ Zimmerman and his legal counsel

³⁷ *Id.*

³⁸ *Id.*

³⁹ *Id.*

⁴⁰ Josh Eels, *The Rise of Deadmau5*, ROLLING STONE (July 5, 2012), <http://www.rollingstone.com/music/news/the-rise-of-deadmau5-20120705?page=3>.

⁴¹ *Id.*

⁴² Kory Grow, *Deadmau5 Sends Cease and Desist to Disney Over 'Infringing Video'*, ROLLING STONE (Sept. 5, 2014), <http://www.rollingstone.com/music/news/deadmau5-cease-desist-disney-20140905>.

⁴³ *Id.*

⁴⁴ Rayner, *supra* note 34.

⁴⁵ *Id.*

requested that the video be removed within two business days.⁴⁶ Disney removed the video on September 5, 2014.⁴⁷

In October 2014, Zimmerman filed an answer to Disney's opposition, claiming that the two have co-existed with goodwill for the past decade without Disney filing for protection of its trademark.⁴⁸ Zimmerman explains that, not only had the two co-existed, but Disney had asked to work with him on two separate occasions.⁴⁹ Just a few months prior, Disney offered Zimmerman the chance to remix the *Star Wars* theme for its animated series *Star Wars Rebels*.⁵⁰ The offer included daily promotional spots on the Disney XD channel that services 260 million households in 141 countries.⁵¹ Following Disney and Zimmerman's dispute, Disney pulled the offer.⁵² Zimmerman attributes Disney's actions as attempts to "cash in" on the Electronic Dance Music ("EDM") market.⁵³ Disney recently released a compilation album of Disney song remixes from other famous EDM artists, including Armin Van Buuren, Avicii, and Kaskadee.⁵⁴

Furthermore, Zimmerman also alleges that Disney approached him in October of 2013 about "re-imagining" *Fantasia* for the movie's 75th Anniversary.⁵⁵ Zimmerman's answer says that Disney pitched deadmau5 to write and perform new songs at the live *Fantasia* concerts worldwide, including the Hollywood Bowl.⁵⁶ Zimmerman said that Disney chose him for the project because "deadmau5 is the most innovative musician of our time, and Disney, the most successful entertainment brand to ever exist. Bringing these two visionaries together, with this particular franchise, provides an incredible opportunity that could touch millions of people around the world."⁵⁷

Zimmerman was supposed to appear on Jimmy Kimmel's

⁴⁶*Id.*

⁴⁷Eriq Gardner, *Why Deadmau5' Trademark Battle With Disney Has Cost Him Dearly*, BILLBOARD, (Sept. 12, 2014, 1:00 PM), <http://www.billboard.com/articles/news/6251375/why-deadmau5-trademark-battle-with-disney-has-cost-him-dearly>.

⁴⁸ Gardner, *supra* note 4.

⁴⁹ *Id.*

⁵⁰ *Battle With Disney Has Cost Him Dearly*, *supra* note 47 ("In July, Disney's music division extended an offer for the DJ to remix the *Star Wars* theme for the animated series *Star Wars Rebels*, according to several sources close to the situation.").

⁵¹ *Id.*

⁵² *Id.*

⁵³ Grow, *supra* note 42.

⁵⁴ *Id.*

⁵⁵ Gardner, *supra* note 4.

⁵⁶ *Id.*

⁵⁷ *Id.*

Halloween episode of his television show, which is featured on Disney's ABC division.⁵⁸ Following this dispute, Kimmel rescinded the offer, when someone from ABC stated, "[w]e have to stay away from [deadmau5] until the matter is resolved."⁵⁹ Disney has refused to comment.⁶⁰

The dispute has not been resolved by the USPTO at this time.⁶¹ Intellectual property onlookers speculate that Disney will pay Zimmerman for infringing his song.⁶² However, neither side appears to be backing down from their claims to the mark.⁶³ The USPTO has refused to comment on when it will review the case, but some speculate resolving this claim could take years.⁶⁴

C. Disney's Tactics to Protect Mickey

Unfortunately, deadmau5 was not the first of Disney's targets in its intellectual property disputes. "Disney is notoriously protective of its intellectual property, especially when it comes to Mickey Mouse."⁶⁵ In the past forty years, Disney has transitioned from a strategy of suing users of images resembling Mickey Mouse for copyright infringement to suing users of such images for trademark infringement because trademarks do not expire like copyrights.⁶⁶ This strategy of using copyright and trademark protection is referred to as character protection, where a corporation challenges those who infringe on its fictional character's name, physical or visual appearance, or personality.⁶⁷

In the 1980s, Disney received negative publicity for twice threatening to sue organizations for infringing on its copyrights. In 1987, Disney threatened to sue three day-care centers in Hallandale, Florida that had drawings of Disney characters on its walls.⁶⁸ The

⁵⁸ *Id.*

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ Murray Rosenbaum, *Deadmau5 v. Disney*, HUFFINGTON POST (Sept. 15, 2014), http://www.huffingtonpost.com/murray-rosenbaum/deadmau5-vs-disney_b_5813936.html (last updated Feb. 12, 2015) ("My guess is that Disney will pay deadmau5 for the infringement on his intellectual property, but then begin a huge battle over the deadmau5 logo and the similarity between it and Mickey Mouse.").

⁶² *Id.*

⁶³ *Id.*

⁶⁴ Alcorn, *supra* note 6.

⁶⁵ *Id.*

⁶⁶ Gerald S. Jagorda, *The Mouse That Roars: Character Protection Strategies of Disney and Others*, 21 T. JEFFERSON L. REV. 235, 242 (1999).

⁶⁷ *Id.* at 235, 237.

⁶⁸ Paul Richter, *Disney's Tough Tactics: Entertainment: Critics View the*

dispute was resolved when Universal painted pictures of the Flintstones over the Disney characters.⁶⁹ This story received coverage from the *Los Angeles Times*, which described Disney's tactics to protect its intellectual property as "bare-knuckle."⁷⁰ Following the dispute, Hallandale's mayor threatened "to ban Mickey Mouse from the city limits."⁷¹ In 1989, Disney seemed likely to sue the Academy of Motion Picture Arts and Sciences for using a parody of Snow White during the opening of the Oscars.⁷² Although neither lawsuit went to court, Disney perpetuated a reputation that it will fight to protect its intellectual property, especially when it comes to protecting the precious face of Mickey Mouse.

In 1990, Disney sued a business of street vendors for copyright infringement after the vendor sold shirts with the faces of Mickey and Minnie Mouse.⁷³ The United States Court of Appeals for the District of Columbia Circuit ("DC Circuit") awarded Disney a permanent injunction, which required the vendors to cease using Mickey's face as well as pay an award of attorneys' fees.⁷⁴ Although the DC Circuit vacated a previous judgment requiring the vendor to pay Disney \$15,000, critics of the decision believe that "the court was influenced to take this extraordinary step to safeguard the characters of the Disney menagerie because they have become such American icons."⁷⁵ This decision, coupled with a Ninth Circuit decision from 1978 that prohibited a comic book artist from depicting a Disney character in a vulgar way,⁷⁶ "added another weapon to Disney's arsenal for character protection."⁷⁷

In 1998, when Disney's copyright over Mickey Mouse would soon expire, Disney worked to extend its copyright beyond the statutory limits.⁷⁸ Disney brought a bill to the Senate for the Copyright Term Extension Act of 1998 ("CTEA"), which proposed a twenty-year

Company As the Fiercest of Hollywood's Bare-Knuckle Fighters. Disney Maintains It is Held to a Higher Standard than Others, L.A. TIMES, (July 8, 1990), http://articles.latimes.com/1990-07-08/business/fi-486_1_walt-disney.

⁶⁹ *Id.*

⁷⁰ *Id.*

⁷¹ *Id.*

⁷² Jessica Litman, *Mickey Mouse Emeritus: Character Protection and the Public Domain*, 11 U. MIAMI ENT. & SPORTS L. REV. 429, 432 (1994).

⁷³ *Walt Disney Co. v. Powell*, 897 F.2d 565, 567 (D.C. Cir. 1990).

⁷⁴ *Id.* at 570.

⁷⁵ *Id.*; Jagorda, *supra* note 66, at 242.

⁷⁶ *See Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 756 (9th Cir. 1978).

⁷⁷ Jagorda, *supra* note 66, at 243.

⁷⁸ *Id.* ("In an effort to counter the temporal restriction of copyright, owners of characters have turned to the concepts of trademark and unfair competition for protection.").

extension to American copyright limits for works like Mickey Mouse that would enter the public domain in 2003.⁷⁹ Prior to the passage of the CTEA—referred to as the Mickey Mouse Protection Act—copyrights lasted the life of the author plus 50 years, or 75 years for corporations.⁸⁰ The CTEA extended corporate works to 120 years after creation or 95 years after publication, whichever is earlier.⁸¹

In 2003, Justice Ruth Bader Ginsburg wrote for a seven-member majority that Congress had the authority to extend existing copyright terms for individuals and corporations as long as the terms are not infinite and satisfy the Supreme Court's "limited times" requirement.⁸² Ginsburg believed doing so was among Congress's powers and such extensions were "historical practice."⁸³ In his dissent, Justice Breyer disagreed with the logic that copyrights should be extended merely because individuals today lived longer than at the passing of the Copyright Act.⁸⁴ Justice Breyer also warned that the copyright extension would only help create corporate monopolies.⁸⁵ These extensions will expire in October 2018 unless Congress intervenes.⁸⁶

Although Congress and the Courts provided Disney with major power to protect Mickey Mouse, the CTEA demonstrated that copyright protection for Mickey may eventually expire and that it must equally protect Mickey as a trademark to achieve full character protection.⁸⁷ Disney began to focus on protecting its trademarks under the Lanham Act where it was not limited to the "temporal limits" of copyright law.⁸⁸ In 1981, Disney challenged a Colonie, New York bar called "Mickey's Mousetrap," claiming that it had infringed on Mickey Mouse's trademark to the point that it would cause customer confusion.⁸⁹ The two owners, Mickey Colarusso and Mickey Visk, had a sign outside their bar with a mouse wearing a top hat and jacket.⁹⁰ The owners

⁷⁹ Rosenbaum, *supra* note 61.

⁸⁰ *Id.*; Josh Young, *Ask TPU: Is Disney Picking on Deadmau5?*, THEME PARK UNIV., (Dec. 16, 2014), <http://themeparkuniversity.com/disney/ask-tpu-disney-picking-deadmau5/>.

⁸¹ Young, *supra* note 80.

⁸² *Eldred v. Ashcroft*, 537 U.S. 186, 204 (2003).

⁸³ *Id.*

⁸⁴ *Id.* at 263.

⁸⁵ *Id.* at 246.

⁸⁶ Timothy B. Lee, *15 Years Ago, Congress Kept Mickey Mouse out of the Public Domain. Will They Do It Again?*, WASH. POST (October 25, 2013), <http://www.washingtonpost.com/blogs/the-switch/wp/2013/10/25/15-years-ago-congress-kept-mickey-mouse-out-of-the-public-domain-will-they-do-it-again/>.

⁸⁷ Jagorda, *supra* note 66, at 245–46.

⁸⁸ *Id.* at 243–44.

⁸⁹ Young, *supra* note 80.

⁹⁰ Albin Krebs & Robert McG. Thomas Jr., *Notes on People: The Mouse that*

attempted to appease Disney by adding a mustache and sunglasses on the mouse, but Disney was unsatisfied.⁹¹ Ultimately, the bar was unable to afford the cost of defending their claim against the corporate entity, so they dropped the word “Mickey’s” from the bar’s name and painted over the mouse face on the sign.⁹²

Disney challenged Filmation Associates in the United States District Court for the Central District of California for a series of animated movies including *The New Adventures of Pinocchio*, *Alice Returns to Wonderland*, and *The Continuing Adventures of the Jungle Book*.⁹³ Disney claimed that these movies would be confused as Disney movies like the Disney Classics: *Pinocchio*, *Alice in Wonderland*, and *The Jungle Book*.⁹⁴ The court concluded that consumers would confuse Filmation’s movies as Disney Classics, utilizing the confusion factors previously mentioned in Section II A.⁹⁵

The court’s ruling is rather surprising, given Disney borrowed fictional characters in the creation of these movies.⁹⁶ Some trademark scholars argue that even Mickey Mouse was not completely original as it used preexisting elements of other cartoon mice and that this combination of elements should be returned to the public domain in order to avoid a monopoly on mouse characters.⁹⁷ Another simply says, “Disney and its brethren must permit future creators to build on what has already been produced, as they were allowed to do.”⁹⁸ I am sure Joel Zimmerman agrees.

Roared Trademark, N.Y. TIMES (Oct. 24, 1981), <http://www.nytimes.com/1981/10/24/nyregion/notes-on-people-the-mouse-that-roared-trademark.html>.

⁹¹ *Id.*

⁹² *Id.*

⁹³ *Walt Disney Prods. v. Filmation Assoc.*, 628 F. Supp. 871, 874 (C.D. Cal. 1986).

⁹⁴ *Id.*

⁹⁵ *Id.* at 880.

⁹⁶ Jagorda, *supra* note 66, at 241 (“Disney has a unique perspective in this area because it is both an owner, as well as a user, of fictional characters.”).

⁹⁷ Litman, *supra* note 72, at 433 (“Walt Disney created Mickey Mouse using preexisting elements. Mickey was not the first cartoon mouse, nor the first cute cartoon mouse.”); *id.* at 434–35 (“[W]hile we want to give Mickey Mouse enough protection that the Disney Company can comfortably release the first Mickey Mouse movie without worrying that Filmation will enter the market with an identical squeaky-voiced mouse character, we don’t want to give the Disney Company a 75, or 95, year monopoly on all films involving mice, or all characters with squeaky voices.”); Young, *supra* note 80 (“It’s also worth noting that by now, Mickey Mouse should be in the public domain and the Disney Company shouldn’t have ownership of him anymore.”); Rosenbaum, *supra* note 61 (“To add a whole new level to this issue, in all technicality Mickey Mouse SHOULD be in the public domain. Mickey Mouse, along with a whole slew of original Disney characters, should have entered the public domain back in 2003.”).

⁹⁸ Jagorda, *supra* note 66, at 251.

III. ANALYSIS

Reform of the Lanham Act is necessary to prevent Disney from bullying artists like Zimmerman from using trademarks similar to Mickey Mouse. First, Congress should ameliorate the Lanham Act's remedies to discourage corporations like Disney from bringing cases only to scare away others from filing marks. Secondly, the USPTO should expand its use of scientific surveys so mark holders can more easily demonstrate a lack of customer confusion. Third, Congress should reform dilution laws so that Disney cannot hide behind them when they are unable to claim customer confusion. These changes will prevent Disney from scaring away all other artists who want to use mouse images in a creative fashion.

A. Lanham Act Remedy Reform

Even though Disney is unlikely to prove that Zimmerman infringed on its Mickey Mouse trademark, Disney is now able to use Zimmerman to intimidate other creative minds from claiming marks remotely similar to Disney's. Even worse, Disney is attempting to scare away other artists from using anything mouse related in creating their marks. "Many companies believe that by challenging your trademark every once in a while, it ensures you get to protect it from other people coming in and using it, or something similar to it, and potentially making money off of your brand."⁹⁹ Yet these corporations often invoke their trademark rights as "symbolic actions" to merely scare off potential mark holders, not because they truly feel that their trademark has been infringed.¹⁰⁰

Disney in particular has been characterized as part of "an active campaign to protect the copyrights and trademarks."¹⁰¹ Disney estimates that one-quarter of Disney's 800 lawsuits and regulatory cases each year involve copyright and trademark disputes.¹⁰² Does Disney really fear that the picture of a mouse on the sign of "Mickey's Mousetrap" in Colonie, New York, would be confused for Disney's iconic Mickey Mouse? Or is it more likely that Disney used this instance to disincentivize people from using marks similar to Mickey

⁹⁹ Young, *supra* note 80.

¹⁰⁰ Alcorn, *supra* note 6 ("In part, this may be because you need to exercise trademark rights in order to retain them. 'Trademark owners often feel they need to take symbolic actions,' says Tushnet.").

¹⁰¹ See Richter, *supra* note 68.

¹⁰² *Id.* at 4 ("About one-quarter of the 800 lawsuits and regulatory cases Disney pursues each year are over copyright and trademark actions, Disney has estimated.").

Mouse?

If the latter is the case, the Lanham Act's remedies must be reformed to penalize corporations like Disney for using these scare tactics as they frustrate the purpose of protecting the creative efforts of all. The Lanham Act provides three forms of remedies: (1) injunctions, (2) compensatory damages, and (3) defendant's profits.¹⁰³ Although the Lanham Act has gone through numerous changes over the years, the remedies and provisions have not been changed since 1946.¹⁰⁴ By reforming the remedies, Disney will be more reluctant to oppose other trademarks.

1. *Injunctions*

In order for a mark holder to issue an injunction to stop a party from using an infringing mark, the mark holder must demonstrate:

- (1) that it has suffered an irreparable injury;
- (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury;
- (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted;
- and (4) that the public interest would not be disserved by a permanent injunction.¹⁰⁵

Prior to 2006, mark holders seeking equitable relief in the form of an injunction had a presumption of an irreparable injury.¹⁰⁶ In *eBay*, a Supreme Court case involving injunctive relief for patent cases, the Court explained that there may be instances where patent holders will need to demonstrate an irreparable injury.¹⁰⁷ Although *eBay* was a decision involving injunctive relief for patent cases, the Ninth Circuit has often applied it to trademarks.¹⁰⁸ The Ninth Circuit interpreted *eBay* as meaning that, mark holders must "proffer evidence sufficient to establish a likelihood of irreparable harm."¹⁰⁹ The decision insinuated that mark holders now must demonstrate concrete evidence that cannot be fixed by monetary damages, such as damage to the company's

¹⁰³ Lanham Act, 15 U.S.C. §§ 1116–1117 (2012).

¹⁰⁴ Mark A. Thurmon, *Federal Trademark Remedies: A Proposal for Reform*, 5 AKRON INTELL. PROP. J. 137, 139 (2010).

¹⁰⁵ *Id.*; *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006). The Court refers to this test as one of the "well established principles of equity."

¹⁰⁶ *eBay*, 547 U.S. at 391–93.

¹⁰⁷ *Id.*

¹⁰⁸ *See, e.g.*, *Herb Reed Enters., LLC v. Fla. Entm't Mgmt., Inc.*, 736 F.3d 1239, 1249 (9th Cir. 2013).

¹⁰⁹ *Id.* at 1251.

business reputation.¹¹⁰

J. Thomas McCarthy, a leading commentator on trademarks, believes that *eBay* should not be applied to trademark analysis.¹¹¹ McCarthy argues that “the reason for the trademark presumption of irreparable injury is that once a probability of proving likelihood of confusion at trial is shown, the trademark owner's business goodwill and reputation are at risk . . . the plaintiff's reputation is threatened: it is in the hands of the defendant.”¹¹² However, this is not always the case. Disney did not oppose Zimmerman’s trademark because of true risk to its reputation; Disney opposed the mark to scare him away. By allowing a presumption of an irreparable injury, Disney is one step closer to preventing Zimmerman from ever wearing his mau5head again. Disney did not suffer an irreparable harm because there was no injury to its reputation at all. Courts should follow the Ninth Circuit’s lead and force corporations to prove an injury first before they can burden others like Zimmerman with an injunction that prevents them from registering their trademarks.

2. *Compensatory Damages*

Moreover, mark holders are able to recover compensatory damages under the Lanham Act to compensate for the damage of consumer confusion.¹¹³ Congress determined mark holders could not seek punitive damages under the Lanham Act and courts have found that monetary damages should be for “compensation and not a penalty.”¹¹⁴ However, for those seeking a trademark, when another party opposes their trademark, they are forced into a prolonged battle with expensive attorney fees and a delay in claiming their mark. Congress passed the Lanham Act “for mark holders to bring claims only when they ‘undermine consumers’ ability to rely on protected marks.”¹¹⁵ Yet reform to compensatory damages is necessary to prevent corporations like Disney from bringing claims when consumer confusion is not present.

Even if the party’s opposition fails, the party seeking mark approval only gets their mark, and is ineligible for compensatory damages other

¹¹⁰ *Id.* at 1250 (“Evidence of loss of control over business reputation and damage to goodwill could constitute irreparable harm.”).

¹¹¹ Thurmon, *supra* note 104, at 154 n.69.

¹¹² J. Thomas McCarthy, TRADEMARKS AND UNFAIR COMPETITION, § 30:47 (4th ed. 2005).

¹¹³ Lanham Act, 15 U.S.C. § 1116 (2012).

¹¹⁴ *Id.* at § 1117(a).

¹¹⁵ Thurmon, *supra* note 104, at 159.

than attorney fees.¹¹⁶ The Lanham Act allows courts to award attorney fees only in “exceptional cases,” but does not define exceptional.¹¹⁷ This has made it rare that attorney fees are awarded in trademark cases.¹¹⁸ The Lanham Act should be reformed to eliminate the exceptional requirement so that courts have more discretion in awarding attorney fees.¹¹⁹ Such a requirement “creates an even playing field, and it imposes an additional risk upon both parties” because the Lanham Act states the prevailing party, whether plaintiff or defendant, can qualify for attorney fees.¹²⁰ This rule will make sure that those opposing marks will “carefully consider the legal merits of their positions before engaging in expensive and protracted trademark litigation.”¹²¹

Broader discretion for courts to award attorney fees will help parties like Zimmerman in two ways. First, Zimmerman will be able to be compensated for the expensive attorney fees to defend his mark. More importantly, this will encourage parties who are not in Zimmerman’s financial position, like Mickey’s Mousetrap, to seek protection of their marks against corporate giants. Although Disney may argue that it has a right to protect its valuable mark, it should not be able to target weaker parties. Such parties will no longer fear the expensive costs of litigation if they have a good case in demonstrating a lack of consumer confusion because they can qualify for attorney fees. Further, Mickey’s Mousetrap would be incentivized to challenge corporate giants who use their marks that they would not challenge because of the rare chance they would have qualified for attorney fees. Secondly, these corporate giants will be cautious in opposing the marks of others for fear they will have to pay their attorney fees. This will prevent Disney from making excessive trademark challenges merely as a symbolic action to scare off others. Therefore, reforming the Lanham Act to allow easier access to attorney fees will rectify some of the problems faced by Zimmerman and Mickey’s Mousetrap.

3. *Defendant’s Lost Profits*

Furthermore, the Lanham Act’s remedy awarding the plaintiff a defendant’s profits should be restructured to account for lost profits that a defendant may incur from the plaintiff’s opposition. Currently under the Lanham Act, a plaintiff who prevails on a charge of infringement

¹¹⁶ *Id.* at 174.

¹¹⁷ *Id.*

¹¹⁸ *Id.*

¹¹⁹ *Id.* at 174–75.

¹²⁰ *Id.* at 175.

¹²¹ *Id.*

can charge a defendant for the profits not received because of customer confusion.¹²² This remedy was intended to fulfill the Lanham Act's purpose of ensuring that parties do not profit from infringing.¹²³ However, "the Lanham Act's remedial scheme has never satisfactorily accomplished this objective" because "a trademark owner proves willful infringement or some other type of culpable misconduct by the infringer in order to obtain an award of profits."¹²⁴

If one of the purposes of the Lanham Act is to ensure that parties do not profit from conduct that prevents the other party from earning profits, a defendant should also have the opportunity to prove that a plaintiff's opposition to their trademark has prevented them from earning profits. For example, if Zimmerman could demonstrate that Disney's opposition to its trademark prevented him from earning profits, he should be able to claim those profits under the Lanham Act. In a sense, Disney's opposition has in part cost Zimmerman the profits he would have earned working with *Star Wars Rebels* and *Fantasia*, along with profits earned from appearing on Jimmy Kimmel.

A remedy of lost profits may even be more applicable for defendants like Mickey's Mousetrap. Mickey's Mousetrap may have been able to prevail in its trademark dispute over its sign, but because it could not afford the expensive cost of litigation, the bar was forced to drop the word "Mickey's" from the bar's name and paint over the mouse face on the sign.¹²⁵

If this change caused Mickey's to lose profits, the bar should be entitled to recoup those lost profits. Such a rule would dissuade Disney from targeting weaker parties if it fears it may have to pay part of their profits.

To prove infringement, a defendant should not have to prove that the plaintiff intended to tamper with the defendant's profits. Under the Lanham Act, in order for a plaintiff to receive a portion of the defendant's profits, they must demonstrate that the defendant engaged in willful or culpable infringement.¹²⁶ Many intellectual property commentators believe that plaintiffs should not have to prove willful or culpable infringement because the standard requires too much of a burden for plaintiffs.¹²⁷ However, this has not stopped courts from enforcing this standard.¹²⁸

¹²² *Id.* at 168.

¹²³ *Id.*

¹²⁴ *Id.*

¹²⁵ Krebs, *supra* note 90.

¹²⁶ Thurmon, *supra* note 104, at 168 ("Some commentators have argued against this practice, but the courts, for the most part, have continued to impose this requirement.").

¹²⁷ *Id.*

¹²⁸ *Id.*

If defendants are able to charge plaintiffs for lost profits, they should similarly not have to prove that the infringement was willful or culpable. Instead, defendants should be entitled to their lost profits if they can merely demonstrate that the plaintiff's opposition caused them to lose profits. Allowing defendants to seek profits would protect parties like Zimmerman and Mickey's Mousetrap from plaintiff oppositions that are intended to scare off defendants. Therefore, the Lanham Act should be reformed to add an opportunity for defendants to claim lost profits.

B. Consumer Confusion Surveys

In trademark disputes, it can be difficult for a plaintiff to truly demonstrate that the public confused the defendant's mark with that of the plaintiff's.¹²⁹ In order to prove confusion, attorneys utilize confusion surveys that ask individuals to identify the defendant's marks.¹³⁰ If the results demonstrate that many people identified the defendant's mark as the plaintiff's, then the plaintiff can use the results of the survey to prove that the defendant's mark caused confusion under the Lanham Act.¹³¹ These confusion surveys have been found reliable and as having scientific value, especially where attorneys and courts that deal with intellectual property issues are becoming more familiar.¹³² As the use of confusion surveys increase, they "are increasingly being relied upon as both a litigation and settlement tool."¹³³ Despite the importance of these surveys, courts view these surveys improperly, which leads to a frustration of the purposes of the Lanham Act.¹³⁴ The Lanham Act should be amended to use surveys that look at the marks in the context of the consumer. Such reform would ensure that plaintiffs do not use improper surveys to sway a judge to rule in their favor.

Trademark scholars disagree on how surveys are used in the practice of trademark disputes. For example, McCarthy believes that a "survey is accepted and relied upon when the judge already has his or her mind made up in favor of the survey results; and a survey is rejected and torn

¹²⁹ Jacob Jacoby, *Experimental Design and the Selection of Controls in Trademark and Deceptive Advertising Surveys*, 92 TRADEMARK REP. 890, 890-91 (2002).

¹³⁰ *Id.*

¹³¹ *Id.*

¹³² *Id.*

¹³³ *Id.*

¹³⁴ See Jacob Jacoby, Amy H. Handlin, & Alex Simonson, *Survey Evidence in Deceptive Advertising Cases Under the Lanham Act: A Historical Review of Comments from the Bench*, 84 TRADEMARK REP. 541 (1994).

apart when the judge subjectively disagrees with the survey results.”¹³⁵ Jacob Jacoby, whose knowledge of trademark converges with consumer surveys, conducted an empirical study in 1994 looking at how judges view empirical surveys.¹³⁶ Jacoby and his colleagues found “instances where courts have ‘torn apart’ surveys for scientifically indefensible reasons.”¹³⁷

They found that this was mostly due to the fact that the judges lack the social science background necessary to interpret if these surveys were properly conducted.¹³⁸ Jacoby’s research demonstrated that of the forty cases they researched involving surveys, 55% were given considerable weight, 22% were given moderate weight, and 23% were given little or no weight.¹³⁹ Therefore, it is startling that the Lanham Act does not provide sufficient guidance for judges on how to weigh survey evidence, yet these surveys can be a significant part of their decision-making process.

Confusion surveys are intended to “simulate reality as closely as possible” so a court can truly understand whether consumer confusion was present.¹⁴⁰ Yet judges only view confusion surveys that “look at the mark in isolation” by comparing the similarity of the marks.¹⁴¹ Jacoby says that by forcing individuals to view the mark in isolation, the results are inaccurate.¹⁴² He suggests that confusion surveys be viewed by individuals in the context where consumers actually view the marks.¹⁴³ This way, the surveys would more accurately illustrate that consumers are confused in the context where they would see the two marks. For example, there is a difference between determining consumer confusion using a survey that shows consumers viewing a t-shirt with the deadmau5 mark on it versus showing them the simple mouse silhouette pictured above.

In the case of Disney and Zimmerman, Jacoby says that judges should not compare the marks in isolation by comparing the mouse silhouettes to each other.¹⁴⁴ Jacoby says that “the confusion case boils down to what’s in the mind of the person who picks a mau5head t-shirt off the rack-and whether they’ll think the deadmau5 item was made by,

¹³⁵ *Id.* at 546.

¹³⁶ *See id.* at 544–46.

¹³⁷ *Id.* at 546.

¹³⁸ *Id.*

¹³⁹ *Id.* at 550.

¹⁴⁰ Alcorn, *supra* note 6.

¹⁴¹ *Id.*

¹⁴² *Id.*

¹⁴³ *Id.*

¹⁴⁴ *Id.*

affiliated with, or allowed by Disney.”¹⁴⁵ Stan Alcorn decided to conduct a confusion survey outside of a mall in Queens, New York.¹⁴⁶ Alcorn showed a group of electronic music fans a picture of a deadmau5 shirt and asked them to identify to whom the mark belonged.¹⁴⁷ He concluded that “[a]mong [Zimmerman’s] fans, everyone knew the symbol immediately, and had no confusion about Disney’s involvement.”¹⁴⁸

Based on the results of Alcorn’s survey, looking at the mau5head mark in isolation hurts Zimmerman’s argument. Electronic music fans who are more likely to encounter Zimmerman’s mark would not confuse it with Disney’s. When merely comparing the two mouse silhouettes, Zimmerman’s mark is more similar to Disney’s; however, consumers who encounter one of his products in a store are less likely to be confused. These consumers are more likely to associate Zimmerman’s mark with deadmau5 in a store than if they saw a silhouette in isolation. Thus, the Lanham Act should be amended to use surveys that consider the context of consumers to fully achieve the Lanham Act’s goal of punishing parties who have truly caused customer confusion.

Furthermore, reforming the Lanham Act to give guidance to judges who are reviewing consumer surveys would place defendants in a better position to defend against plaintiffs’ trademark infringement claims. Typically, only plaintiffs use confusion surveys to show confusion amongst consumers.¹⁴⁹ On the other hand, defendants generally do not provide contrary surveys that show a lack of consumer confusion.¹⁵⁰ Instead, defendants criticize the procedures in which the surveys were conducted to prove that consumers do not confuse the marks.¹⁵¹ If courts require surveys to be administered in the proper context, defendants would likely conduct their own surveys that would give them an opportunity to demonstrate a more accurate understanding of the two marks. This would make sure that trademark decisions are not about the judge’s understanding of social science but rather, on the results of accurate surveys. Moreover, precise surveys would allow a larger number of these cases to be settled outside of court, thus saving court resources. Therefore, amending the Lanham Act’s requirements of consumer surveys would incentivize defendants to administer their own survey, refocus the court’s decision, and increase settlement of

¹⁴⁵ *Id.*

¹⁴⁶ *Id.*

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

¹⁴⁹ Jacoby, *supra* note 134, at 548–49.

¹⁵⁰ *Id.* at 549.

¹⁵¹ *Id.*

trademark infringement disputes.

In summary, courts view confusion surveys in isolation and not in the context in which consumers view these marks. Consumers who view a picture of Zimmerman's mau5head in isolation view it differently than when consumers view it in the context of deadmau5's merchandise. Requiring courts to view marks in their proper context will increase the defendants' use of confusion surveys, which will ensure that judges utilize more accurate surveys in making their decisions and will not have to question the social science behind these surveys. Additionally, more of these cases can be settled outside of court because the parties can rely on the results of these surveys to prove whether there was a presence of consumer confusion. Thus, reform of confusion surveys is imperative.

IV. CONCLUSION

The goal of this article was to analyze the trademark dispute between Joel Zimmerman and Disney to find necessary reform under the Lanham Act. The article looked at an overview of trademark law followed by Disney's intellectual property tactics and how they compared to Disney's trademark opposition to Zimmerman's mark. The analysis of this article centered on reform to the Lanham Act. The article demonstrates that Congress should revise the Lanham Act's remedies for (1) injunctions, (2) compensatory damages, and (3) defendant's lost profits. First, Disney should not receive a presumption of an irreparable injury so that it does not burden parties like Zimmerman with an injunction that prevents them from registering their trademarks. Second, defendants should be able to claim attorney fees to incentivize parties to challenge corporations like Disney. This will also force Disney to be cautious in opposing the marks of others for fear they will have to pay their attorney fees and reduce Disney's excessive trademark challenges that are only performed to scare others. Third, if a defendant loses profits because of the plaintiff's opposition, the defendant should be able to charge the plaintiff for those lost profits. In addition to remedial reform, courts should view confusion surveys in isolation and not in the context in which consumers view these marks. Reforming consumer surveys will ensure that judges utilize more accurate surveys in making their decisions that will increase settlements outside of court.

If you give a mouse a trademark, the court can allow a company to achieve an intellectual property monopoly. If, instead, you don't give a mouse a trademark and you reform the remedy and survey mechanisms that impact the court's decision, trademark law will be one step closer to making sure that Disney does not inhibit the public domain of

creativity and discourage other artists from seeking protection for their marks.