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7
 8 UNITED STATES DISTRICT COURT
 9 CENTRAL DISTRICT OF CALIFORNIA

10 WESTERN DIVISION
 11

12 JACKSON BROWNE., an individual
 13

CASE # CV08-05334 RGK (Ex)

14 Plaintiff,

**REPLY IN SUPPORT OF
 DEFENDANT JOHN MCCAIN'S
 MOTION TO DISMISS UNDER
 FRCP 12(b)(6)**

15 vs.

16 JOHN MCCAIN, an individual; THE
 REPUBLICAN NATIONAL
 17 COMMITTEE, a non-profit political
 organization; THE OHIO REPUBLICAN
 18 PARTY, a non-profit political
 organization,

Hearing:

19 Defendants.
 20

Date: February 2, 2009
 Time: 9:00 a.m.
 Place: Courtroom 850

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1 **MEMORANDUM OF POINTS AND AUTHORITIES**

2 **I. INTRODUCTION**

3 Browne’s Opposition (“Opp.”) concedes that the operative facts necessary to
4 grant the Motion – the contents of the Political Video and the Song – are properly
5 before the Court. Moreover, Browne concedes that his claims stem from the use of a
6 snippet of the Song “as part of a political message” that “criticize[d] President-elect
7 Obama’s energy policy.” Opp. at 1-2. Finally, Browne concedes that there was no lost
8 licensing fee because Browne emphatically states that he would never have granted a
9 license to defendants for this use. Opp. at 20. These concessions mandate the dismissal
10 of all of Browne’s claims.¹

11 As to the Copyright claims, Browne concedes that the use of a brief portion of
12 the Song furthered important political speech, but relies on *Harper & Row v. Nation*
13 *Enters.*, 471 U.S. 539 (1985) for the contention that not every use in the political
14 speech context is fair. The holding in *Harper & Row*, however, was dictated almost
15 exclusively by the fact that defendants stole an unpublished work, thereby depriving
16 plaintiff of first publication rights and a lucrative “first excerpts” deal. Here, Browne
17 admits the Song was published thirty years ago and has sold over *seven million* copies.
18 Opp. at 3. Moreover, Browne’s contention that the use was not fair because it did not
19 comment on the Song is wrong on both the facts and the law. Not only is such a
20 commentary made, but it is not required under the fair use analysis “purpose of the
21 use” factor. Finally, Browne’s assertion that defendants must address the relevant
22 licensing market for the work is rendered irrelevant by Browne’s own concession that
23 he would *never* have granted a license to use his work to “convey a message that [he]
24 disagrees with” such as the message conveyed here. *See* Opposition to Motion To
25 Strike at 18. Thus, the fair use defense bars the copyright claims.

26
27 _____
28 ¹ These concessions also mandate dismissal of Browne’s right of publicity claim. *See*
McCain’s Reply In Support of anti-SLAPP Motion (incorporated herein by reference).

1 Regarding his Lanham Act “false endorsement” claim, Browne’s argument that
2 defendants cannot challenge this claim because defendants themselves have federal
3 trademarks can be summarily disregarded. Rather, the relevant portion from the
4 Opposition is Browne’s concession that the “mark” (*i.e.*, the sound of Browne’s voice
5 singing his Song) was “artistically relevant” to the Political Video because it served to
6 “criticize President-elect Obama’s energy policy.” Opp. at 2. That concession defeats a
7 Lanham Act claim as a matter of law. Accordingly, the Motion should be granted and
8 the Complaint dismissed with prejudice.

9 **II. THE OPPOSITION DOES NOT SAVE THE COPYRIGHT CLAIMS**
10 **FROM THE BAR OF THE FAIR USE DOCTRINE**

11 Browne does not dispute that the Court can conduct a fair use analysis on a
12 motion to dismiss. *See Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d
13 962, 966 (C.D. Cal. 2007) (reviewing works and holding, on Motion to Dismiss, that
14 claim was barred by the fair use doctrine). Nor does Browne dispute that the Court
15 properly has before it the Political Video and the Song to conduct this analysis. Thus,
16 the Court can easily determine that the use of brief portions of the Song is a protected
17 fair use, and nothing in the Opposition fends off such a determination.

18 **A. The Purpose And Character Of The Use Factor Favors McCain**

19 Browne concedes that the snippet from the Song was used in political speech
20 that related to a matter of public concern. In response, Browne relies on *Harper & Row*
21 for the contention that uses for political speech are not protected by the fair use
22 doctrine. But *Harper & Row* is easily distinguishable.

23 In *Harper & Row*, President Ford had contracted with Harper & Row to publish
24 his memoirs and to license prepublication excerpts, which Harper & Row licensed to
25 *Time* magazine. Before the release of the memoir and excerpts by *Time*, however, an
26 unauthorized source provided Ford’s manuscript to *The Nation* magazine, whose editor
27 “knew that his possession of the manuscript was not authorized” and had to be
28 “returned quickly to his ‘source’ to avoid discovery.” *Harper & Row*, 471 U.S. at 543.

1 *The Nation* then ran 300 to 400 words of verbatim quotes from the manuscript,
2 including the key portions dealing with Ford’s pardon of Nixon, so that *The Nation*
3 could “scoop” *Time*, causing *Time* to cancel its piece and a payment that was due to
4 Ford for *Time*’s serial rights. *Id.*

5 The Supreme Court rejected *The Nation*’s fair use defense. In so doing,
6 however, the Supreme Court focused almost exclusively on the fact that defendants
7 had usurped the first publication rights in the yet unpublished work. Thus, *Harper &*
8 *Row* was about the “piracy of verbatim quotations for the purpose of ‘scooping’ the
9 authorized first serialization” of an unpublished work – a circumstance vastly different
10 from that here. *Id.* at 556.²

11 Like a virus, the “unpublished” nature of the work infected the Court’s analysis
12 of all of the fair use factors. Regarding the “purpose and character of the use,” the
13 Court found against defendant on this factor because defendant had “actively sought to
14 exploit the headline value of its infringement, making a ‘news event’ out of its
15 unauthorized first publication of a noted figure’s copyrighted expression” and thus the
16 Court could not “ignore *The Nation*’s stated purpose of scooping the forthcoming
17 hardcover and *Time* abstracts.” *Id.* at 561-62. Regarding the “nature of the work”
18 factor, the Court held that “[t]he fact that a work is unpublished is a critical element of
19 its ‘nature’” and thus “the author’s right to control the first public appearance of his
20 expression weighs against” a finding of fair use on this factor. *Id.* at 564. Finally,
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23 ² Indeed, there are about a dozen references to that fact in the Court’s opinion. *See, e.g.,*
24 *id.* at 549 (“The Nation effectively arrogated to itself the right of first publication, an
25 important marketable subsidiary right”); 550-51 (“fair use traditionally was not
26 recognized as a defense to charges of copying from an author’s as yet unpublished
27 works”); 557 (“Where an author and publisher have invested extensive resources in
28 creating an original work and are poised to release it to the public, no legitimate aim is
served by pre-empting the right of first publication” and thus “[u]nder ordinary
circumstances, the author’s right to control the first public appearance of his
undisseminated expression will outweigh a claim of fair use”).

1 regarding the “effect on the market” factor, the Court held that this factor favored
2 plaintiff because “extensive prepublication quotations from an unreleased manuscript
3 without the copyright owner’s consent poses substantial potential for damage to the
4 marketability of first serialization rights in general” and the evidence demonstrated
5 that “*The Nation*’s article, which contained verbatim quotes from the unpublished
6 manuscript, [was the] reason” for *Time*’s cancellation of its projected serialization and
7 its refusal to pay \$12,500 due on its contract with Ford. *Id.* at 569, 567. Thus, in
8 summing up its conclusion on the fair use factors, the Supreme Court held that fair use
9 did not require the “unfettered access to the **unpublished** copyrighted expression of
10 public figures.” *Id.* at 569 (emphasis added).

11 The facts in *Harper & Row* are, of course, utterly different from the facts here.
12 The Song was published to the world over thirty years ago and has sold over seven
13 million copies. *See id.* at 551 (“Publication of an author’s expression before he has
14 authorized its dissemination seriously infringes the author’s rights to decide when and
15 whether it will be made public, **a factor not present in fair use of published works**”)
16 (emphasis added). Moreover, the ORP did not promote the Political Video as “the one
17 with the Jackson Browne song in it” or release the Political Video to “scoop” a
18 pending use of the Song. Rather, the Song was only one small part of a multi-image,
19 multi-sound informational political message aimed at discussing the policies of the
20 presidential candidates. Thus, *Harper & Row* has no bearing here.

21 Rather, the most analogous case to the present facts is *Keep Thompson*
22 *Governor Committee v. Citizens for Gallen Committee*, 457 F. Supp. 957, 961 (D.N.H.
23 1978) where the court held that use of brief portions of plaintiff’s song in a political
24 campaign message was a fair use. Browne buries his passing reference to *Keep*
25 *Thompson Governor* in a footnote in which he contends that the case is off-point
26 because it involved a commentary on the song itself. Opp. at 9 n.4. That
27 characterization of the case is false. No specific reference or commentary on the song
28

1 itself was made in the use; rather, the use (like that made of the Song here) was part of
2 the campaign spots overall political message.

3 Indeed, this raises another of Browne’s faulty assertions in the Opposition: that
4 a use must parody, comment on or target the underlying work to be a protected fair
5 use. That assertion is wrong on the facts and the law. First, as set forth in the Reply in
6 support of McCain’s anti-SLAPP Motion, the use here *does* comment on Browne by
7 recognizing how his Song has made the phrase “running on empty” a ubiquitous cliché
8 in our society. Second, the “purpose and character” of the use factor focuses on
9 whether a use is “transformative.” *Perfect 10 v. Amazon.com*, 508 F.3d 1146, 1164
10 (9th Cir. 2007) (“The central purpose of [the first fair use factor] inquiry is to
11 determine whether and to what extent the new work is ‘transformative’”). A work is
12 transformative when the use does not “merely supersede the objects of the original
13 creation” but rather “adds something new, with a further purpose or different
14 character, altering the first with new expression, meaning, or message.” *Campbell v.*
15 *Acuff Rose Music, Inc.*, 510 U.S. 569, 579 (1994). A use is considered transformative
16 where the defendant “changes a plaintiff’s copyrighted work or uses the plaintiff’s
17 copyrighted work in a different context such that the plaintiff’s work is transformed
18 into a new creation.” *Perfect 10*, 508 F.3d at 1165 (citation omitted); *Blanch v. Koons*,
19 467 F.3d 244, 252 (2d Cir. 2006) (use was a transformative fair use because defendant
20 used plaintiff’s work “for ‘sharply different’ purposes than [plaintiff], in that
21 [defendant] used it ‘as fodder for his commentary on the social and aesthetic
22 consequences of mass media’”); *Wall Data Inc. v. L.A. County Sheriff’s Dep’t.*, 447
23 F.3d 769, 778 (9th Cir. 2006) (a use is considered transformative where defendant
24 “uses the plaintiff’s copyright work in a different context such that plaintiff’s work is
25 transformed into a new creation”). It is *not* necessary that the use comment on the
26 work and numerous cases have held uses to be fair when no such commentary is

1 made.³ For example, in *Keep Thompson Governor*, there was no commentary on the
2 work. Likewise, in *Nat’ Rifle Ass’n of Am. v. Handgun Control Fed. of Ohio*, 15 F.3d
3 559, 561 (6th Cir. 1994), which again involved the use of a work in a political
4 message, the use was held to be a fair use even though the use did not comment in any
5 way on the work. In *Perfect 10*, the Ninth Circuit held that making exact copies of a
6 work “may be transformative so long as the copy serves a different function than the
7 original work.” *Perfect 10*, 508 F.3d at 1165. Accordingly, because the Political Video
8 added something new, with a further purpose or different character, giving the Song a
9 new meaning or message that commented on matters of the utmost public interest, the
10 purpose and character of the use factor overwhelmingly favors McCain.

11 **B. The Long Ago Published And Cliché Nature Of The Portion Of The**
12 **Work That Was Used Supports A Finding Of Fair Use**

13 Browne concedes that the Song was published three decades ago and does not
14 dispute that only the cliché line “running on empty” is readily discernable in the
15 Political Video. Browne’s sole contention (Opp. at 11) that the use of a portion of the
16 Song in the Political Video was a “first use” because it was the first to use it in a
17

18
19 ³ Browne’s reliance on *Zomba Enters., Inc. v. Panorama Records, Inc.*, 491 F.3d 574
20 (6th Cir. 2007) (Opp. at 10) is unavailing: that case dealt with the use of karaoke
21 machines, which copied **entire** musical compositions as well as the **entire** lyrics to
22 hundreds of songs without adding any independent creative content and defendant was
23 manufacturing and selling karaoke packages as a profit-making enterprise. Likewise,
24 *Worldwide Church of God v. Philadelphia Church of God, Inc.*, 227 F.3d 1110, 1112,
25 1117 (9th Cir. 2000) (Opp. at 6 n.3) is inapplicable because defendant took plaintiff’s
26 380-page book and “cop[ied] it in its entirety and distributed large numbers of copies
27 to [defendant’s] members and the public” and the copies of the work were used “for
28 the same intrinsic purpose for which the copyright owner intended it to be used.” Here,
the ORP did not copy the entire Song, the ORP did add its own highly-protected
political content, defendants did not sell the Political Video nor operate profit-making
enterprises, and the Song was not used for the “same intrinsic purpose” for which
Brown intended it to be used (as a snappy song about life on the road), but instead for
a message about the policies of a candidate for President.

1 “commercial” is factually and legally incorrect. The Political Video, as even Browne
2 concedes, was not a “commercial.” Moreover, a work is only “published” once; each
3 appearance in a new medium is *not* a new “publication.” See *MasterCard Intern., Inc.*
4 *v. Nader 2000*, 70 U.S.P.Q.2d 1046 (S.D.N.Y. 2004) (“A previously published work
5 available to the general public will receive less protection under the fair use doctrine
6 than an unpublished work which has not yet been released to the general public by its
7 author”). Browne of course concedes that “*Running on Empty* was first published long
8 ago.” Opp. at 11. Thus, this factor favors McCain.

9 **C. The “Amount and Substantiality” Factor Favors McCain**

10 Browne concedes that the Political Video used only a small portion of the Song:
11 less than thirty seconds (and only nine seconds of lyrics) from a song almost five
12 minutes long. Browne incorrectly contends that defendants have “gloss[ed] over” the
13 fact that this was the “heart of the work.” Defendants have not glossed over this fact;
14 they have embraced it. Of course the words “running on empty” were used in the
15 Political Video because it was those precise words that were key to criticizing
16 Obama’s campaign and energy policy. The focus on the politically relevant portion of
17 the Song weighs strongly in **McCain’s favor**. See *Lennon v. Premise Media*, 556 F.
18 Supp. 2d 310, 325-26 (S.D.N.Y. 2008) (factor favored defendants because defendants
19 used portion of song that expresses idea they specifically wished to critique “without
20 copying other portions of the song that do not express that idea”).⁴

21
22 ⁴ Rather than address the cases set forth in the Motion regarding this factor, Browne
23 relies on the inapposite *Elvis Presley Enters., Inc. v. Passport Video*, 349 F.3d 622 (9th
24 Cir. 2003) and *Los Angeles News Serv. v. KCAL-TV*, 108 F.3d 1119 (9th Cir. 1997)
25 cases. In *Elvis*, defendant used numerous excerpts from a variety of works which
26 “comprise[d] a substantial portion of Elvis’ total appearances on many of these shows”
27 including “[t]hirty-five percent of his appearances on *The Ed Sullivan Show*” and three
28 minutes from a comeback special. *Elvis*, 349 F.3d at 625. Moreover, defendant had
sought to “profit directly from the copyrights it uses without a license” by using as
“[o]ne of the most salient selling points on the box” for defendant’s work that it
included the infringing works. *Id.* at 628. Finally, the infringed works were used

1 **D. Browne Concedes The Use Had No Effect On Value Of The Song**

2 The fourth factor focuses on the copyright law’s condemnation of the “copier
3 who attempts to usurp the demand for the original work.” *Consumer Union of United*
4 *States, Inc. v. Gen. Signal Corp.*, 724 F.2d 1044, 1050 (2d Cir. 1983). Browne
5 concedes that having a blip of his Song in a political video does not “usurp the
6 demand” or supplant the market for his Song.⁵

7 Rather, Browne appears to rely on a “lost licensing fee” theory of damages and
8 contends that defendants were required to produce evidence on that issue. Browne,
9 however, has *conceded* that there was no such lost licensing fee because Browne
10 repeatedly states that he never would have licensed the work to defendants to make the
11 use that was made in the Political Video. Opp. at 20.⁶ Accordingly, Browne concedes
12 there was no harm to the market for the work and thus this factor favors McCain.

14 “without much interruption” and “serve[d] the same intrinsic entertainment value that
15 is protected by Plaintiff’s copyrights.” *Id.* at 629. That is nothing like the situation
16 here, where the use was only a brief snippet of one of Browne’s works, defendants did
17 not seek to profit from (or even highlight) the fact that the Political Video included an
18 excerpt from the Song, the Song was not played “without interruption” (Obama
19 speaking and Hillary Clinton saying “shame on you, Barack Obama” plays over the
20 music from the Song) and use of the Song did not serve the same entertainment value,
21 but served to make a political commentary. In *Los Angeles News Service*, defendant
22 simply copied plaintiff’s entire tape of the Reginald Denny beating and did not add
23 “anything new or transformative to what made [plaintiff’s] work valuable – a clear,
24 visual recording of the beating itself.” *Los Angeles News Service*, 108 F.3d at 1122.
25 Again, no such wholesale copying or failure to add anything new is present here.

26 ⁵ Indeed, the court in *Elvis* made this exact point, holding that use of portions of Elvis
27 songs was a fair because it “seems unlikely that someone in the market” for these
28 songs would purchase defendants’ work instead of the songs. *Elvis*, 349 F.3d at 631.

29 ⁶ Moreover, even if he would have entertained a license, the bare assertion that
30 plaintiff may have been deprived of a licensing fee does not stave off a finding of fair
31 use: “a copyright holder cannot prevent others from entering fair use markets merely
32 by developing or licensing a market for ... transformative uses of its own creative
33 work ... Copyright owners may not preempt exploitation of transformative markets.”
34 *Bill Graham Archives v. Dorling Kindersley*, 448 F.3d 605, 614-615 (2d Cir. 2006).

1 Thus, a transformative use of a limited, non-creative and cliché portion of the
2 Song to make an important political commentary about issues of public interest and
3 which admittedly caused no harm to Browne is a fair use. Accordingly, Browne’s
4 copyright claims fail as a matter of law.

5 **III. THE OPPOSITION DOES NOT SAVE THE LANHAM ACT CLAIM**

6 Browne’s attempt to salvage his “false endorsement” Lanham Act claim fails.
7 First, Browne makes the frivolous assertion that defendants cannot challenge this
8 claim because defendants themselves have sought to obtain federal trademarks and
9 thus rely on the protections afforded by the Lanham Act. That argument makes no
10 sense: it is the equivalent of arguing that the Walt Disney Company can never make a
11 fair use argument because it has itself registered copyrights and thus has sought to use
12 the protections of the Copyright Act.⁷

13 McCain recognizes that the Lanham Act may be used as a *shield* to protect
14 marks that relate to political expression. But as numerous courts have held, however,
15 the Lanham Act cannot be used as a *sword* to punish the use of purported “marks”
16

17 ⁷ In Browne’s limited discussion of trademarks in the political arena, Browne relies on
18 *MGM-Pathé Commns. Co. v. Pink Panther Patrol*, 774 F. Supp. 869 (S.D.N.Y. 1991)
19 and *United We Stand Am., Inc. v. United We Stand, Am. New York, Inc.*, 128 F.3d 86
20 (2d Cir. 1997) (Opp. at 15-16) which have no bearing on this case. Both of these cases
21 involved the use of marks as “source identifiers” and not as a component of an
22 expressive work. *See Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 698
23 (N.D. Ohio 2002) (noting that in *United We Stand*, court was “careful to point out”
24 that “the defendant was using the plaintiff’s mark as a source identifier, and not as a
25 means to communicate a message” and thus *United We Stand* has no bearing on a case
26 involving the use of a mark “*as part of his communicative message, in the context of*
27 *expressing political speech*”). Moreover, in *MGM*, the court dismissed First
28 Amendment concerns in a short paragraph, stating in a cursory fashion that the First
Amendment does not “confer any right to use the trademark of another.” *MGM*, 774 F.
Supp. at 877. That cursory conclusion, of course, has been contradicted by legions of
decisions, including those from the Ninth Circuit and the Second Circuit that controls
the Southern District of New York. *See Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d
894, 900 (9th Cir. 2002) and *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

1 when such uses are artistically relevant to protected expression. *See Mattel, Inc. v.*
2 *MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002); *Mattel, Inc. v. Walking*
3 *Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003); *E.S.S. Ent't 2000 v. Rock Star*
4 *Videos*, 547 F.3d 109 (9th Cir. 2008).⁸

5 Here, Browne *concedes* that the “mark” (*i.e.*, the sound of Browne’s voice
6 singing his Song) was “artistically relevant” to the Political Video because it
7 “criticize[d] President-elect Obama’s energy policy.” Opp. at 2. That concession
8 defeats Browne’s Lanham Act claim as a matter of law.

9 **IV. CONCLUSION**

10 The use of a brief portion of a long-ago published song to comment on issues of
11 profound national importance was a fair and artistically relevant use of the Song and
12 Browne’s voice. Accordingly, McCain’s Motion should be granted and the Complaint
13 dismissed with prejudice.

14
15 Dated: January 21, 2009

LATHROP & GAGE LLP

16
17 By: 

18 _____
Lincoln D. Bandlow

19 Attorneys for Defendant JOHN MCCAIN
20
21

22 _____
23 ⁸ Browne’s only response to the “artistic relevance” test is to assert that it does not
24 apply because the use does not target Browne for criticism. Opp. at 18. That is not a
25 requirement of the “artistic relevance” test. Indeed, the Ninth Circuit in *Mattel* adopted
26 the holding in *Rogers*, 875 F.2d at 999 (2d Cir. 1989), which involved a use that was in
27 no way critical or a “parody” of Ginger Rogers, yet was protected because it was
28 artistically relevant to the expressive work. *Mattel*, 296 F.3d at 901-902; *see also*
Romantics v. Activision Publ., 532 F.Supp.2d 884, 889 (E.D.Mich. 2008) (use in
expressive work protected because it “related to the content of the work” even though
use did not involve any criticism or parody of plaintiff).