



The Pillsbury Company v. Milky Way Productions, Inc. et al.

No. C78-679A

United States District Court for the Northern District of Georgia, Atlanta Division.

1981 U.S. Dist. LEXIS 17722; 215 U.S.P.Q. (BNA) 124; 8 Media L. Rep. 1016

December 24, 1981

CASE SUMMARY:

PROCEDURAL POSTURE: Plaintiff baking company sued defendant magazine for copyright infringement. Plaintiff alleged several counts of copyright infringement, federal statutory and common law trademark infringement, violations of the Georgia Uniform Deceptive Trade Practices Act and of the Georgia "anti-dilution" statute, and several counts of tortious tarnishment of its marks, trade characters, and jingle.

OVERVIEW: Plaintiff sued defendants for copyright infringement. The court found that defendants' unauthorized use of plaintiff's copyrights was protected by the fair use doctrine codified in 17 U.S.C.S. § 107. Plaintiff failed to produce evidence showing defendants' use of the copyrighted works affected the potential market for the copyrighted works. The court found further that plaintiff failed to sustain its burden of proof on its claim of trademark infringement. Plaintiff failed to show a likelihood of confusion, and defendants did not intentionally deceive the public in order to derive monetary benefit at plaintiff's expense. The court, however, found that plaintiff sustained its burden of proof on its claim that defendants violated the Georgia "anti-dilution" statute, 1955 Ga. Laws p. 453, § 1, O.C.G.A. § 10-1-451. The court found that there was a likelihood that defendants' presentation could injure the business reputation of plaintiff or dilute the distinctive quality of its trademarks.

OUTCOME: The court found defendants' unauthorized

use of plaintiff's copyrights was protected by the fair use doctrine. The court found plaintiff failed to sustain its burden of proof on the trademark infringement claim, but did sustain its burden of proof on the claim that defendants' presentation could injure the business reputation of plaintiff or dilute the distinctive quality of its trademarks.

COUNSEL: [*1] A. Felton Jenkins, Jr., King & Spalding, Julius R. Lunsford, Jr., and J. Rodgers Lunsford, III, all of Atlanta, Ga., and James L. Dooley, Robert W. Adams, and Cushman, Darby & Cushman, all of Washington, D.C., for plaintiff.

Warren C. Fortson, Andrew Eugene Smith, and Smith, Cohen, Ringel, Kohler & Martin, all of Atlanta, Ga., for defendants.

Reber Boulton, Atlanta, Ga., and Kenneth P. Norwick, New York, N.Y. for defendant Milky Way Productions, Inc.

Robert Eugene Smith, Atlanta, Ga., for defendants MGT Corp. and Gateway Books, Inc.

Glen Zell, Atlanta, Ga., for defendant Gateway Books, Inc.

OPINION BY: O'KELLEY

OPINION

O'Kelley, District Judge.

In its December 19, 1977 issue of Screw magazine, the defendant Milky Way Productions, Inc. published a picture of figures resembling the plaintiff's trade characters "Poppin" Fresh" and "Poppie Fresh" engaged in sexual intercourse and fellatio. This picture also featured the plaintiff's barrelhead trademark and its jingle, the refrain of a two stanza song entitled "The Pillsbury Baking Song." The same picture was published in the February 20, 1978 issue of Al Goldstein's Screw.

Contending that the manner in which Milky Way presented [*2] this picture suggested that the plaintiff placed or sponsored it as an advertisement in Screw magazine, the Pillsbury Company instituted this action. In its original complaint, the plaintiff alleged several counts of copyright infringement, federal statutory and common law trademark infringement, violations of the Georgia Uniform Deceptive Trade Practices Act and of the Georgia "anti-dilution" statute, and several counts of tortious tarnishment of its marks, trade characters, and jingle. The plaintiff later amended its complaint to name as defendants MGT Corp. and Gateway Books, Inc., local bookstores charged with distributing these issues of Screw, and to allege a claim of libel per se. The plaintiff also requests that the court find Milky Way in contempt for violating this court's temporary restraining order of April 21, 1978.

In its defense, Milky Way contends that its use of the plaintiff's marks and copyrighted works is protected by the *first amendment*¹ and/or the fair use doctrine and that there is no likelihood that an ordinary purchaser would confuse the source or sponsorship of this picture. Milky Way also takes issue with the plaintiff's claim that it violated the [*3] court's temporary restraining order. The defendant bookstores oppose the plaintiff's claims on the sole ground that they had no knowledge of the specific contents of the Screw magazines they sold and that, therefore, these sales are protected by the *first amendment*.²

1 On page 48 of its post-trial brief, Milky Way states that, in light of recent Fifth Circuit decisions, it decided to place primary emphasis on its fair use defense and chose not to press the *first amendment* aspects of the case further at that time. Pillsbury construes this statement as an abandonment of Milky Way's *first amendment* defense. While the court disagrees with Pillsbury's conclusion that Milky Way has

dropped its *first amendment* defense, it need not reach this issue in light of its ruling that Milky Way's unauthorized use of the plaintiff's copyrights is protected by the fair use doctrine.

2 In their post-trial brief, defendants MGT Corp. and Gateway Books, Inc. adopted the arguments contained in the brief filed by Milky Way. For ease of reference, the court will hereinafter refer to the defendants collectively as "Milky Way."

On August 14, 1980, the court conducted a bench trial of this [*4] case. At the close of the trial the court directed the parties to file post-trial briefs. The case was then submitted to the court for a decision on the merits on December 5, 1980.

I. Preliminary Issues

A. Personal Jurisdiction and Venue

Before addressing the issues raised by the plaintiffs' various claims, the court first must dispose of several preliminary matters discussed in the parties' post-trial briefs. While Pillsbury contends that Milky Way no longer contests the court's subject matter that personal jurisdiction Milky Way vigorously reaffirms its objections to this court's order of November 30, 1978, denying its motion to dismiss for lack of personal jurisdiction or, in the alternative, for a change of venue to the Southern District of New York. To underscore their opposition, the defendants reargue many of the points the court discussed in that order. The court declines the invitation to reconsider these rulings. For the reasons stated in its previous orders, the court concludes that it has personal jurisdiction over Milky Way and that venue is properly laid in this district.

B. Subject Matter Jurisdiction Over Claim Alleging Infringement of Cinnamon Roll [*5] Label Copyright

The only challenge to the court's subject matter jurisdiction pertains to the plaintiff's allegation of infringement of its cinnamon roll label copyright. In its complaint, Pillsbury alleged only infringements of the copyrights it holds in its jingle and its plastic dolls, "Poppin" Fresh" and "Poppie Fresh." Discovery in the case, however, revealed that Milky Way did not actually copy the dolls. It commissioned an artist to sculpt three-dimensional plaster-of-paris replicas of the plaintiff's trade characters. As her model, the artist used the two dimensional rendition of the doughboy found on

the label of a can of the plaintiff's cinnamon rolls. These labels eventually were registered in the Copyright Office, but not until after the Milky Way artist used one for this purpose. In briefing this issue, the plaintiff acknowledges the significance of this discovery; however, it never sought leave to amend its complaint to allege this infringement of its cinnamon roll label copyright. Nor did the plaintiff include this claim in its proposed findings of fact and conclusions of law. In its post-trial reply brief the plaintiff contends nonetheless that this claim is [*6] properly before the court. The defendants argue that the court lacks subject matter jurisdiction over this claim of copyright infringement because the plaintiff failed to register its copyright before commencing this suit.

The threshold issue, however, is whether the plaintiff has even alleged an infringement of its copyright in the cinnamon roll label. No such claim appears in the plaintiff's amended complaint or in the pre-trial order. The plaintiff contends that an amendment to its complaint was unnecessary because the defendants stipulated that "[t]he labels presenting Pillsbury's 'POPPIN FRESH' trade character have all borne a proper copyright notice * * *." and that the copyright on the cinnamon roll label "has been duly registered in the Copyright Office by Certificate of Registration VA 46-937 dated March 11, 1980." The plaintiff argues that pursuant to *rule 15(b) of the Federal Rules of Civil Procedure*, this stipulation serves as an amendment to the complaint. As authority for this proposition, the plaintiff refers the court to *Proctor v. Gissendaner*, 579 F.2d 876 (5th Cir. 1978). In *Proctor*, the Fifth Circuit noted that a stipulation could operate as an express or [*7] implied amendment of the pleadings under *rule 15(b)* when neither party entered into the record any reservations or restrictions on the use or significance of the stipulation. *Id.* at 885 n.20; accord, *Sun-Fun Products, Inc. v. Suntan Research & Development Inc.*, 656 F.2d 186, 192 n. 7, 213 U.S.P.Q. (BNA) 91, 95 n. 7 (5th Cir. 1981); *Gibbs v. Randolph*, 250 F.2d 41, 42-43 (5th Cir. 1957); see *Streeter v. Hopper*, 618 F.2d 1178, 1180 (5th Cir. 1980). The defendants have not responded to this argument.³

3 In discussing the post-trial briefing schedule for this case, the court informed the parties that the plaintiff, through its reply brief, would have the last opportunity to address the issues raised in this case, unless the plaintiff included new matters in the reply. Although, in the court's opinion, this

issue was raised for the first time in the plaintiff's reply brief, the defendants chose not to respond, and, therefore, the court does not have the benefit of the defendants' perspective on this question. The court assumes, however, that the defendants would strenuously oppose the belated assertion of this claim.

While the court is not eager to overlook the plaintiff's failure either [*8] to request leave to amend its complaint or to obtain the express consent of the defendants to assert this claim, it nevertheless concludes that, by agreeing to the aforementioned stipulation, the defendants impliedly consented to amendment of the pleadings to include the plaintiff's claim of infringement of its cinnamon roll label copyright. In the stipulations approved by this court in the pretrial order, the defendants stipulated that the labels presenting Pillsbury's "Poppin" Fresh" trade character have all borne a proper copyright notice, that the copyright on the cinnamon roll label was duly registered in the Copyright Office by a certificate of registration dated March 11, 1980, that the plaster-of-paris characters were replicas of the plaintiff's trade character "Poppin" Fresh" as it appeared on a cinnamon bun roll label, and that the female was modeled after the male. The defendants did not restrict the use or significance of these stipulations, and the plaintiff's statement of the issues to be tried contained in attachment "C" to the pretrial order was broad enough to include a claim of infringement of the cinnamon roll label copyright. The court therefore concludes that [*9] the plaintiff adequately alleged a violation of the copyright in the cinnamon roll label.

The defendants now contend, however, that the court lacks subject matter jurisdiction over this claim because, at the time this suit was commenced, the copyright in the cinnamon roll label had not been registered. That an infringement suit may not be instituted until the plaintiff registers its copyright is axiomatic. 17 U.S.C.A. § 13 (Copyright Act of 1909); 17 U.S.C.A. § 411(a) (current Copyright Act, effective January 1, 1978); e.g., *Burns v. Rockwood Distributing Co.*, 481 F. Supp. 841, 845-47, 209 U.S.P.Q. (BNA) 713 (N.D. Ill. 1979); *Frederick Fell Publishers, Inc. v. Lorayne*, 422 F. Supp. 808, 810-11, 199 U.S.P.Q. (BNA) 188, 189-191 (S.D.N.Y. 1976). See also *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30, 40 U.S.P.Q. (BNA) 190, 83 L. Ed. 470, 59 S. Ct. 397 (1939); 2 *Nimmer on Copyright* § 7.16[B] [1] (1980).⁴ Having stated this legal principle, however, the court

does not believe that the argument for its application in this case is so apparent. When this suit was commenced, the only claims of copyright infringement pertained to the plaintiff's jingle and its two dolls. The claim that the defendants also infringed the plaintiff's copyright [*10] in the cinnamon roll label was not alleged in the complaint but was included in the pretrial order approved by the court on August 14, 1980. At the time this claim was first asserted, then, the plaintiff had registered this copyright, thus fulfilling the jurisdictional prerequisites of the Copyright Act. Moreover, once these preconditions had been satisfied, the defect in the complaint could be cured by an amendment relating back to the time the plaintiff commenced this action. See *Frankel v. Stein and Day, Inc.*, 470 F. Supp. 209, 212 n.2, 205 U.S.P.Q. (BNA) 51 (S.D.N.Y. 1979), aff'd w/out op., 646 F.2d 560 (1980); *Frederick Fell Publishers, Inc.*, 422 F. Supp. at 810-11, 199 U.S.P.Q. (BNA) 189-191. The court concludes that it has subject matter jurisdiction over the plaintiff's claim that the defendants infringed the plaintiff's federally registered copyright in the cinnamon roll label.

4 Although registering a copyright is a necessary precedent to filing suit, it does not create the cause of action for copyright infringement. The cause of action exists at common law, but, under the Copyright Act, one cannot enforce his rights in the courts until he registers a copyright with the Copyright Office. Thus, one can bring an action for copyright infringement of a work which was not copyrighted at the time the alleged infringement took place.

[*11] II. The Substance of the Plaintiff's Claims

A. Copyright Infringement

To establish an infringement of its copyright, the plaintiff must show by a preponderance of the evidence that it owned the copyright in question and that the protected work was "copied" by the defendant. 3 *Nimmer on Copyright* § 13.01 (1980) (cited with approval in *Ferguson v. Nat'l Broadcasting Co.*, 584 F.2d 111, 113, 200 U.S.P.Q. (BNA) 65 (5th Cir. 1978)). In order to prevail on the latter issue, the plaintiff need not introduce direct evidence of copying. It may prevail by showing that the defendant had an opportunity to view the copyrighted work and that the defendant's work is substantially similar to the protected work or that the two works are so similar as to preclude the likelihood of

independent creation. 3 *Nimmer on Copyright* §§ 13.01[B], 13.02, 13.03 (1980). See *Ferguson v. Nat'l Broadcasting Co.*, 584 F.2d 111, 113, 200 U.S.P.Q. (BNA) 65 (5th Cir. 1978); see also *Donald v. Zack Meyer's T.V. Sales and Service*, 426 F.2d 1027, 1029, 165 U.S.P.Q. (BNA) 751, 752 (5th Cir. 1970), cert. denied, 400 U.S. 992, 168 U.S.P.Q. (BNA) 257, 27 L. Ed. 2d 441, 91 S. Ct. 459 (1971); *Metro-Goldwyn-Mayer, Inc. v. Showcase Atlanta Cooperative Productions, Inc.*, 479 F. Supp. 351, 356, [*12] 203 U.S.P.Q. (BNA) 822, 825 (N.D. Ga. 1979), appeal docketed, No. 81-7817 (11th Cir. Oct. 13, 1981). Because direct evidence of copying is rarely available, the courts prefer not to handicap plaintiffs in infringement suits in this regard. Consequently, once the plaintiff proves substantial similarity, courts typically shift the burden to the defendant to rebut the inference of copying that arises from the plaintiff's showing. See 3 *Nimmer on Copyright*, § 13.01[B], at 13-5 (1980).

Milky Way argues that the plaintiff cannot prevail on its claim for infringement of its copyrights in the two dolls because the only evidence of copying contained in the record pertains to the plaintiff's cinnamon roll label. Conversely, the plaintiff argues that Milky Way's presentation infringed its copyright in the dolls, as well as in the cinnamon roll label, because both Mr. Goldstein, the originator of this idea and the editor of the magazine, and Ms. Moore, the artist who sculpted the plaster-of-paris replicas, acknowledged at their depositions that they were familiar with the two dimensional animated versions of these characters shown during the plaintiff's television advertisements.

In the pre-trial [*13] order, the parties stipulated that Ms. Moore used the "Poppin" Fresh" character from the Pillsbury cinnamon roll label as her model. At trial, there was no evidence presented and the plaintiff did not argue that Mr. Goldstein or Ms. Moore actually copied the dolls. To the contrary, the uncontradicted evidence in the record establishes that neither Mr. Goldstein or Ms. Moore had even seen the copyrighted dolls.⁵

5 At their depositions, both denied ever having seen the dolls before creating Milky Way's figures.

While normally the court could infer copying from the defendant's access to the protected work and substantial similarity between the protected work and the alleged infringing work,⁶ it cannot do so here where

Pillsbury stipulated that the sculptor used the cinnamon roll label as her model. Pillsbury apparently overlooks that it must prove by a preponderance of the evidence that Milky Way copied the dolls. Pillsbury's argument that the defendants violated its copyright in the dolls because Mr. Goldstein and Ms. Moore acknowledged that they were familiar with the two dimensional animated versions of the Pillsbury trade characters as seen in the plaintiff's television [*14] commercials misses the mark. Pillsbury has not alleged copyright infringement of the individual commercials in which "Poppin" Fresh" appears,⁷ and its copyright on the dolls does not purport to cover the "Poppin" Fresh" and "Poppie Fresh" trade characters in whatever form they appear. In light of the uncontradicted evidence in the record and Pillsbury's stipulation that the sculptor used the cinnamon roll label for her model, the court finds that Pillsbury has failed to establish that Milky Way copied the dolls; the defendants' general familiarity with the plaintiff's trade characters in other forms is not an adequate substitute for this requirement. Accordingly, because the court finds that Milky Way did not in fact copy the dolls, it concludes that the defendants have successfully rebutted the inference of copying that arises from the plaintiff's showing of substantial similarity.

6 Because the plaintiff's dolls are three-dimensional replicas of the original two dimensional trade characters displayed on many of the plaintiff's products, Milky Way's three-dimensional caricature of the "Poppin" Fresh" figure as it appeared on the cinnamon roll label is substantially similar to the plaintiff's dolls. 7 In its post-trial brief, Pillsbury acknowledges that it could have registered, as unpublished works, the television commercials that Mr. Goldstein and Ms. Moore had seen and then charged that Milky Way's presentation also infringed those copyrights. Pillsbury stated that it chose not to do so because of the impracticality of proving which of the hundreds of such commercials Mr. Goldstein and Ms. Moore viewed and because proving infringement of a dozen copyrights "would not get Pillsbury anything more than proving infringement of two of its copyrights."

[*15] As the court noted earlier, the plaintiff alleges that Milky Way's unauthorized use of its trade characters "Poppin" Fresh" on the cinnamon roll label. Because the

defendants stipulated as to the validity of this copyright, the plaintiff has satisfied the first element of its burden, proof of ownership of the copyrights. The plaintiff has also sustained its burden of showing that Milky Way copied its protected work, for the defendants also stipulated that Milky Way intentionally copied the plaintiff's trade character "Poppin" Fresh" as it appeared on the cinnamon roll label. The fact that Milky Way borrowed only a portion of the copyrighted label, namely the trade character, does not preclude the court from finding that it infringed the plaintiff's copyright in the label. *Miller Brewing Co. v. Carling O'Keefe Breweries, Ltd.*, 452 F. Supp. 429, 439-40, 199 U.S.P.Q. (BNA) 470, 479, 480 (W.D.N.Y. 1978). E.g., *Amana Refrigeration Inc. v. Consumers Union of U.S., Inc.*, 431 F. Supp. 324, 195 U.S.P.Q. (BNA) 56 (N.D. Iowa 1977) (quote from copyrighted work). See *Tennessee Fabricating Co. v. Moultrie Manufacturing Co.*, 421 F.2d 279, 284, 164 U.S.P.Q. (BNA) 481, 484 (5th Cir.), cert. denied, 398 U.S. 928, 165 U.S.P.Q. (BNA) 609, 26 L. Ed. 2d 91, 90 S. Ct. 1819 [*16] (1970). The only remaining question is whether the plaster-of-paris replica of "Poppie Fresh" also infringed the plaintiff's copyright in the cinnamon roll label. "Poppie Fresh" does not appear on the cinnamon roll label that Milky Way admits to copying. The court could conclude that Milky Way's female plaster-of-paris figure is substantially similar to the "Poppin" Fresh" trade character and thus constitutes an additional infringement of the cinnamon roll label. Because finding an additional infringement of "Poppin" Fresh" will not increase the damages that the plaintiff may be entitled to recover, 17 U.S.C.A. § 412,⁸ the court declines to reach this issue.

8 Under this section, plaintiffs cannot receive statutory damages or attorney's fees for infringements which occur after the work has been published but over three months before the copyright is registered. Because Pillsbury did not register the cinnamon roll label copyright until over three months after the alleged infringement, it can only be awarded actual damages for any breach thereof. Pillsbury's actual damages would be the same whether the court found one violation of the cinnamon roll or two violations.

[*17] The plaintiff's final allegation of copyright infringement concerns its jingle. The defendants stipulated that they used without authorization the plaintiff's entire jingle, which is the refrain of a two

stanza song entitled "The Pillsbury Baking Song." In any event, the probability that Milky Way could have coined this jingle independently is too remote to rebut the inference arising naturally from the verbatim replication of the jingle in Milky Way's presentation. Because the defendants also stipulated as to the validity of the copyright, the court concludes that the plaintiff has sustained its burden of proof on this claim.

Summarizing, the court concludes that the plaintiff has failed to sustain its burden of proof on its claim that Milky Way infringed its copyright in the "Poppin" Fresh" and "Poppie Fresh" dolls. The plaintiff, however, has demonstrated that Milky Way infringed its copyrights in the cinnamon roll label and in the jingle.

B. Fair Use Defense

Milky Way contends that its use of the plaintiff's copyrighted jingle and label is protected by the "fair use" doctrine. In this regard, the defendants invite the court to decide whether their portrayal of these [*18] copyrighted works qualifies as a satire or a parody, but, on this record, the court is not inclined to tackle this issue. The court does not question the relevance of this dispute to the defendants' fair use defense: a parodist or satirist would be entitled to broader license in copying original works. But establishing that this infringement of the plaintiff's copyrights is protected by the fair use doctrine falls upon Milky Way. While requesting the court to characterize its portrayal as a satire or parody, Milky Way has not furnished the court with any basis for making this determination. As evidence taken in *Metro-Goldwyn-Mayer, Inc.*, vividly illustrates, these two words of art do not have a fixed definition even among accomplished literary critics. Although it is often called upon to judge the merits of written works, this court is not conversant with these literary concepts. Therefore, without some guidance other than an English handbook and some prior judicial decisions, the court refuses the defendant's invitation.

This determination, however, does not dispose of the defendants' claim that the unauthorized use of the plaintiff's copyrights is protected by the fair use [*19] doctrine. The fair use defense, codified in 17 U.S.C.A. § 107, turns upon the following four factors:

(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;

(2) the nature of the copyrighted work;

(3) The amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

(4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C.A. § 107; see *Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc.*, 626 F.2d 1171, 1174-75, 207 U.S.P.Q. (BNA) 977, 980-981 (5th Cir. 1980).

In delineating these factors, Congress did not specify how much weight the court should accord to each, but the House and Senate reports indicate that the statute merely restates the common law doctrine of fair use. S. Rep. No. 473, 94th Cong., 1st Sess. 62 (1975); H.R. Rep. No. 1476, 94th Cong., 2d Sess. 66 (1976). Courts traditionally have placed the heaviest emphasis on what is the fourth statutory factor: whether the defendant's unauthorized use affects the potential market for the plaintiff's copyrighted work. E.G., *Triangle Publications, Inc.*, 626 [*20] F.2d 1171, 1174-1175, 1177, 207 U.S.P.Q. (BNA) at 980-981, 983. Because this factor is often determinative, the court will consider it first.

1. Effect on Market Value

Milky Way contends that the record is devoid of any evidence that the plaintiff has suffered any economic injury as a result of its unauthorized use of the copyrighted works. The court disagrees, but what evidence there is demonstrates that the actual or potential economic harm to the plaintiff is at most de minimus. See *Triangle Publications, Inc.*, 626 F.2d at 1177, 207 U.S.P.Q. (BNA) at 983.

To support the argument that it has sustained economic injury, the plaintiff refers the court to the parties' stipulations. The defendants conceded that the trade character "Poppin" Fresh" stands for "a quantum of goodwill of inestimable value" and that the jingle "has become well known to many millions of Americans who immediately associate it with the plaintiff." Upon this showing, Pillsbury insists that its copyrighted works have substantial commercial value.

Milky Way does not contest this assertion, having essentially stipulated to the truth of this fact in the pretrial order. Evidence that the copyrighted works are valuable,

however, supplies only part of [*21] the critical showing. Pillsbury must also show that the defendants' unauthorized use of the copyrighted works has affected or may affect their market value. See *Meeropol v. Nizer*, 560 F.2d 1061, 1070, 195 U.S.P.Q. (BNA) 273, 279 (2d Cir. 1977), cert. denied, 434 U.S. 1013, 54 L. Ed. 2d 756, 98 S. Ct. 727 (1978); *Encyclopaedia Britannica Educational Corp. v. Crooks*, 447 F. Supp. 243, 251, 197 U.S.P.Q. (BNA) 280, 286 (W.D.N.Y. 1978). In discussing this issue in its briefs, Pillsbury does not refer to what is probably the only evidence of potential economic harm in the record. The plaintiff received a letter from Mr. Charles L. Sipp, who, having seen Milky Way's portrayal of the plaintiff's characters and jingle, indicated that if the plaintiff condoned this use of its "brand name," he would "stop buying Pillsbury products * * *" and would do his best "to bring these practices before the public eye." Arguably, if enough consumers saw the presentation and shared Mr. Sipp's indignation, the plaintiff's business could suffer, and the value of its copyrighted works would depreciate. might now draw from this letter, however, were rebutted to a significant extent by the testimony of two of the plaintiff's executives, Thomas R. McBurney and [*22] Mr. Raymond T. Good. Mr. McBurney testified at trial and, during the defendant's cross-examination, stated that to his knowledge the plaintiff did not suffer any economic injury as a result of similar comical or parodical, but unauthorized, uses of or references to its trade characters by third parties. These unauthorized presentations appeared in magazines including the National Lampoon and Hustler, which both have a circulation larger than Screw. Mr. Good stated in a deposition which was admitted at trial that to his knowledge the plaintiff did not suffer any economic injury as a result of Milky Way's presentation. Moreover, the unauthorized use challenged here occurred over two years ago. Other than the Sipp letter, the plaintiff has introduced no evidence of any depreciation in the value of its copyrighted works. As did the courts in *Triangle Publications, Inc.*, 626 F.2d at 1177-78, 207 U.S.P.Q. (BNA) at 983-984, and *Williams & Wilkins Co. v. United States*, 203 Ct. Cl. 74, 487 F.2d 1345, 1359, 180 U.S.P.Q. (BNA) 49, 59 (Ct. Cl. 1973), aff'd by an equally divided court, 420 U.S. 376, 184 U.S.P.Q. (BNA) 705, 43 L. Ed. 2d 264, 95 S. Ct. 1344 (1975), the court finds it significant that the plaintiff has failed to introduce more than a sliver of evidence supporting [*23] its claim of economic harm. The court is not inclined to fill this void by presuming economic injury from the acknowledged commercial value of these works.

2. The Purpose and Character of the Use

In *Triangle Publications, Inc.*, the Fifth Circuit noted that "any commercial use tends to cut against a fair use defense." 626 F.2d at 1175. The plaintiff contends that Milky Way used its copyrighted works for a commercial use. It also maintains that Milky Way borrowed the copyrighted works with the intent of "besmirching the POPPIN" FRESH trade character." Milky Way, on the other hand, argues that its presentation is a spoof of the plaintiff's advertising campaign and its corporate image in general, a conclusion that the plaintiff strenuously opposes. While the defendants' usage of the "Poppin" Fresh" trade character and Pillsbury's jingle by no means had a nonprofit educational purpose, the court is not persuaded that Milky Way's use of the plaintiff's copyrighted works is commercial in the sense suggested by the Fifth Circuit in *Triangle Publications, Inc.*, 626 F.2d at 1175-76, 207 U.S.P.Q. (BNA) at 981-982. After reviewing Milky Way's presentation, the court concludes that is more in the nature [*24] of an editorial or social commentary than it is an attempt to capitalize financially on the plaintiff's original work.⁹ Although the portrayal is offensive to the court, the court has no doubt that Milky Way intended to make an editorial comment on the values epitomized by these trade characters. The fact that Screw magazine is offered for sale does not compel a contrary conclusion. Social commentary placed in a newspaper or magazine is not put to a commercial use simply because the publication is sold rather than given to the public. The presentation was located on the inside of the magazine, not on the cover where it might be taken more reasonably as an attempt to capitalize on the plaintiff's original work.

9 In this respect, this case is easily distinguishable from *MCA, Inc. v. Wilson*, 677 F.2d 180, 211 U.S.P.Q. (BNA) 577 (2d Cir. 1981) wherein the court affirmed the district court's determination that the defendants' performance of the song "Cunnilingus Champion of Company C" infringed the plaintiffs' copyright in the song "Boogie Woogie Bugle Boy." In that case, the court noted that the plaintiffs and defendants were competitors in the entertainment field and that both songs were performed on stage, sold as recordings, and sold in printed copies. On the basis of these facts, the court agreed with the district court's conclusion that the purpose and character of the defendants' use was for

commercial gain. The court distinguished *Elsmere Music, Inc. v. National Broadcasting Co.*, 623 F.2d 252 (2d Cir. 1980), by stating that in *Elsmere* the trial court found that the defendant's song did not interfere with the marketability of the plaintiff's and that it did not have the effect of fulfilling the demand for the original. The court apparently felt that the converse was true in *MCA, Inc. v. Wilson*. In the present case, there is no evidence that the defendants' presentation interfered with the marketability of the plaintiff's advertisements or food products, and the defendants' presentation (which did not attempt to sell anything) could not have the effect of fulfilling the demand for the original.

[*25] The plaintiff suggests that, in addressing this factor, the court should consider the generally salacious content of *Screw* magazine. The plaintiff seems to believe that a pornographic adaptation of copyrighted works should be accorded less protection under the fair use doctrine than what might otherwise be granted a more continent presentation. The Copyright Act, however, does not expressly exclude pornographic materials from the parameters of the fair use defense, and the plaintiff offers no authority for this protection. The character of the unauthorized use is relevant, but, in the court's judgment, the fact that this use is pornographic in nature does not militate against a finding of fair use.¹⁰

10 In *Mitchell Brothers Film Group v. Cinema Adult Theater*, 604 F.2d 852, 203 U.S.P.Q. (BNA) 1041 (5th Cir. 1979), cert. denied, 445 U.S. 917, 63 L. Ed. 2d 601, 100 S. Ct. 1277 (1980), the Fifth Circuit addressed the question of whether an obscene work is entitled to protection under the Copyright Act. Concluding that the statute contained no explicit or implicit bar to copyrighting obscene materials, the court construed the statute as providing for the copyright of all creative works, obscene or non-obscene. After holding that the Copyright Act, so construed, did not violate the Constitution, the court declined to create an obscenity defense to infringement actions involving immoral or obscene works, stating that it is "inappropriate for a court, in the absence of some guidance or authorization from the legislature, to interpose its moral views between an author and his willing

audience." *Id.* at 861. If one assumes that Milky Way's portrayal containing Pillsbury's copyrights was immoral and/or obscene, this case presents the flip-side of the question presented in *Mitchell*: whether there is an "obscenity" exception to the fair use defense contained in the Copyright Act. For the reasons stated in *Mitchell*, the court concludes that there is not. Because the definition of obscenity varies from community to community and the applicability of the Copyright Act (including the fair use defense) does not, an obscenity exception to the fair use defense could fragment the uniform national standards of the Copyright Act. See *id.* at 858. Some commentators have argued that this would be unconstitutional. See *id.* n. 10. If not unconstitutional, it would certainly be difficult to apply. See *id.* at n.11.

[*26] 3. The Nature of the Copyrighted Work

The copyrighted works involved in this case were devoted to strictly commercial uses. There is no dispute that these works consist of original, imaginative elements created by or for the plaintiff, that the plaintiff has invested a considerable amount of money in establishing an enviable reputation for quality food products, and that these copyrighted works are responsible in no small measure for the instant recognition that the plaintiff enjoys among consumers.

4. The Amount and Substantiality of the Use

Citing cases such as *Walt Disney Productions v. Air Pirates*, 581 F.2d 751, 199 U.S.P.Q. (BNA) 769 (9th Cir. 1978), cert. denied, 439 U.S. 1132, 59 L. Ed. 2d 94, 99 S. Ct. 1054 (1979), and *MCA, Inc. v. Wilson*, 425 F. Supp. 443, 199 U.S.P.Q. (BNA) 166 (S.D.N.Y. 1976), the plaintiff contends that the defendant has copied more than was necessary to achieve the desired effect and that, therefore, the defendants' conduct is not protected under the fair use doctrine. In these cases the courts surmised that any greater use of the protected works than was necessary to conjure up the original could not be justified under the fair use doctrine. E.g., *Air Pirates*, 581 F.2d at 756, 199 U.S.P.Q. (BNA) at 773; [*27] *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541, 544-45, 141 U.S.P.Q. (BNA) 1, 3-4 (2d Cir.), cert. denied, 379 U.S. 822, 143 U.S.P.Q. (BNA) 464, 13 L. Ed. 2d 33, 85 S. Ct. 46 (1964); *MCA, Inc.*, 425 F. Supp. at 452, 454, 199 U.S.P.Q. (BNA) at 174, 175. Also, the fact that subsection (3) of *Section*

107 refers to the "portion" of the protected work borrowed lends sole support to the plaintiff's argument that taking an unduly large amount of the work can never be fair use. Cf. *Benny v. Loew's Inc.*, 239 F.2d 532, 536-37, 112 U.S.P.Q. (BNA) 11, 14-15 (9th Cir. 1956), aff'd by an equally divided court, 356 U.S. 43, 116 U.S.P.Q. (BNA) 479, 2 L. Ed. 2d 583, 78 S. Ct. 667 (1958). The court would agree with Milky Way that each element of the plaintiff's copyrighted works it borrowed contributed to the overall effect of its portrayal. The court agrees with the plaintiff, however, that Milky Way used more of the copyrighted works than was necessary to suggest the original to its readers. In our media-saturated society, it would be difficult to find anyone of television age that would not recognize the doughboy and the jingle. The extent that these works would have to be copied to remind viewers of the originals is difficult to estimate, but, given their widespread recognition, it would certainly be less [*28] than what Milky Way borrowed. See *Air Pirates*, 581 F.2d at 757-58, at 774-775.

In the court's judgment, however, the fact that the defendants used more than was necessary to accomplish the desired effect does not foreclose a finding of fair use. Accord, *Williams & Wilkins Co. v. U.S.*, 487 F.2d at 1353 and n. 22, 180 U.S.P.Q. (BNA) at 54 and 58 n. 22. In this circuit all four factors must be considered together. *Triangle Publications, Inc.*, 626 F.2d at 1174-7, 207 U.S.P.Q. (BNA) at 980-981; accord, *Meeropol*, 560 F.2d at 1069-70, 195 U.S.P.Q. (BNA) at 278-279. Special emphasis, however, is placed on the fourth factor. The plaintiff's failure to show any appreciable harm to the potential market for or the value of its copyrighted works bears significantly upon the relative fairness of Milky Way's unauthorized use of these copyrighted works. There is no showing that Milky Way intended to fill the demand for the original or that its presentation had this effect. One of the principal purposes of the Copyright Act is to preserve the profit motive for creating original works. Under this Act, the author's or creator's investment in a work and the ability to capitalize on this investment are entitled to protection. The [*29] same Act, however, creates a safe harbor for infringing uses which in Congress' collective judgment serve too important a purpose to permit suppression. The court does not condone the manner in which Milky Way chose to assault the corporate citadel, but value judgments have no place in this analysis. The court concludes that Milky Way's use of the plaintiff's copyrighted works was protected under the fair use doctrine.

C. Trademark Infringement

In its complaint the plaintiff also alleges that Milky Way's presentation falsely suggests sponsorship by the plaintiff, thereby causing confusion and violating the Lanham Act, 15 U.S.C.A. § 1125(1). It contends that the defendants' presentation infringed its statutory and common law trademarks in the Pillsbury "barrelhead," in the trade characters "Poppin' Fresh" and "Poppie Fresh," in the jingle, and in the phrase "Poppin Fresh." The plaintiff's theory of liability runs as follows: by appropriating the plaintiff's marks almost in their entirety, the defendants have or may deceive consumers into believing that the plaintiff placed this "advertisement" in *Screw* magazine; assuming that these individuals find Milky Way's publication as [*30] repulsive as the plaintiff apparently does, they may think less of the plaintiff; because the plaintiff's marks and its commercial reputation are associated closely with its products, its business will suffer accordingly.

In opposing the plaintiff's allegations, the defendants do not challenge the validity of the plaintiff's trademarks. Milky Way stipulated that the plaintiff has used these marks to identify its goods for a long time and that the public associates these marks with the plaintiff's products. It argues, however, that as a matter of fact its isolated use of these marks in its publication is not likely to confuse consumers.

Whether the plaintiff seeks protection of a common law or federally registered trademark, the central question of fact is whether the defendants' use of a mark similar to the plaintiff's to identify its service or product is apt to cause confusion among ordinary consumers. *Armstrong Cork Co. v. World Carpets, Inc.*, 597 F.2d 496, 500, 203 U.S.P.Q. (BNA) 19, 23 (5th Cir.), cert. denied, 444 U.S. 932, 204 U.S.P.Q. (BNA) 608, 62 L. Ed. 2d 190, 100 S. Ct. 277 (1979); SEE 15 U.S.C.A. § 1114(1). The burden of demonstrating by a preponderance of the evidence that confusion is likely rests with the plaintiff. [*31] In *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 205 U.S.P.Q. (BNA) 969 (5th Cir.), cert. denied, 449 U.S. 899, 208 U.S.P.Q. (BNA) 464, 66 L. Ed. 2d 129, 101 S. Ct. 268 (1980), the Fifth Circuit listed seven factors to be considered in evaluating the plaintiff's claim of actual or likely confusion:

- (1) type of trademark
- (2) similarity of design

- (3) similarity of product
- (4) identity of retail outlets and purchasers
- (5) identity of advertising media utilized
- (6) defendant's intent
- (7) actual confusion

Id. at 259. Accord, *Sun-Fun Products, Inc. v. Sontan Research & Development, Inc.*, 656 F.2d 186, 189, 213 U.S.P.Q. (BNA) 91, 94 (5th Cir. 1981); *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 212 U.S.P.Q. (BNA) 345 (5th Cir. 1981). The court will address each of these factors in turn.

1. Type of Trademark

The defendants do not challenge the validity of the plaintiff's registered trademarks. Indeed, they acknowledge that the plaintiff's marks are strong. The defendants stipulated that the plaintiff has used the word "Pillsbury" to identify its products at least since 1922, that the "Pillsbury barrelhead" is "one of the most famous, and most widely recognized, 'house marks' in the United States," and that these marks are federally [*32] registered. The defendants also stipulated that the "Poppin" Fresh" trade character is a "valuable trademark" for the plaintiff's goods and that this mark is also federally registered. On the basis of the evidence, the court concludes that through their use in connection with the sale of the plaintiff's products over a number of years the plaintiff's marks have become a distinctive, well-known designation for Pillsbury's goods.¹¹

¹¹ Even had these marks not been federally registered -- and therefore not entitled to a presumption of validity, see *The Vision Center v. Opticks, Inc.*, 596 F.2d 111, 119, 202 U.S.P.Q. (BNA) 333, 341 (5th Cir. 1979); Lanham Act §§ 7(b), 22, 33(a), 15 U.S.C.A. §§ 1057(b), 1072, 1115(a) -- these marks would still be protected because, through the plaintiff's efforts, they have acquired secondary meaning as the source and identity of the plaintiff's products. See *Aloe Creme Laboratories, Inc. v. Milsan, Inc.*, 423 F.2d 845, 849, 165 U.S.P.Q. (BNA) 37, 40 (5th Cir.), cert. denied, 398 U.S. 928, 165 U.S.P.Q. (BNA) 609, 26 L. Ed. 2d 90, 90 S. Ct. 1818 (1970).

The defendants, however, maintain that the strength of the plaintiff's marks nonetheless has been diluted by uncontested third-party uses similar to the [*33] one challenged by the plaintiff here. The parties stipulated that unauthorized renditions of the plaintiff's "Poppin" Fresh" trade character have appeared in *National Lampoon* and *Hustler*, both of which have circulations greater than *Milky Way's* publication, and on a television broadcast seen by approximately 317,000 people. The plaintiff has not voiced its objections, if any, to any of these uses. The defendants argue that, because of its failure to police its mark in the past, the plaintiff should be estopped from doing so now.

The court, however, does not believe that the defendants have satisfied all the elements necessary to invoke the estoppel doctrine. See *Metro-Goldwyn-Mayer, Inc.*, 479 F. Supp. at 362, 203 U.S.P.Q. (BNA) at 830. And as the plaintiff points out, the failure to contest all infringing uses does not preclude the plaintiff from challenging the defendant's unauthorized use. See *McNeil Laboratories, Inc. v. American Home Products Corp.*, 416 F. Supp. 804, 808, 193 U.S.P.Q. (BNA) 486, 490 (D.N.J. 1976). Uncontested third-party uses, however, may dilute the strength of the plaintiff's mark and limit the scope of the protection to which these marks are entitled. *Amstar Corp.*, 615 [*34] F.2d at 259-60, 205 U.S.P.Q. (BNA) at 975. These same uses also weigh against the plaintiff's claim that the defendants' allegedly infringing use is likely to injure the plaintiff's commercial reputation.

2. Similarity of Design

In discussing the plaintiff's claims of copyright infringement, the court noted that *Milky Way* intentionally borrowed the plaintiff's marks almost in their entirety. *Milky Way* intended that its renditions of the plaintiff's marks be similar in their design to the originals.

3. Similarity of Product

The plaintiff is in the business of manufacturing, advertising, distributing, and selling a variety of food products. *Milky Way* is the publisher of a pornographic magazine. The bookstores are vendors of magazines and books. The parties' products are not even remotely similar.

4. Identity of Retail Outlets and Purchasers

The parties' respective retail outlets are also distinct. The purchasers of the two parties' products may overlap, but there is no evidence to establish this as a matter of fact.

5. Identity of Advertising Media

The plaintiff advertises extensively on television and in print. The record does not disclose how or to what extent Milky [*35] Way advertises its magazine.

6. Defendant's Intent

In discussing its claim of copyright infringement, the plaintiff accuses the defendants of intentionally besmirching the commercial reputation of its doughboy. The basis for this accusation is a statement made by Mr. Goldstein during his deposition that he intended to "have a good time and make fun of" the plaintiff's doughboy. Conceding that he intended to make light of the doughboy, however, is not tantamount to admitting that he used the plaintiff's marks for the purpose of intentionally deceiving the public or deriving some monetary benefit at the plaintiff's expense. Milky Way admits that the similarity between its portrayal and the plaintiff's marks is no mistake, but there is no evidence that in borrowing these marks the defendants intended "to confuse, mislead, or deceive the public." *Amstar Corp.*, 615 F.2d at 263, 205 U.S.P.Q. (BNA) at 978.

7. Actual Confusion

The best evidence of a likelihood of confusion is proof of actual confusion. *Roto-Rooter Corp. v. O'Neal*, 513 F.2d 44, 45-46, 186 U.S.P.Q. (BNA) 73 at 73-74 (5th Cir. 1975). The plaintiff contends that the letter written by Mr. Sipp is evidence that consumers were actually confused [*36] as to the source or sponsorship of Milky Way's portrayal of the plaintiff's marks. Upon review of this letter, however, the court is not convinced that Mr. Sipp thought that Pillsbury had sponsored this picture as an advertisement. On the contrary, the letter read as a whole indicates that Mr. Sipp did not believe that the plaintiff placed this ad; he rather wrote the plaintiff to find out if it intended to take any action against Screw magazine. Even assuming, however, that Mr. Sipp thought that the plaintiff sponsored this presentation, the court does not believe that this single instance of actual confusion is sufficient to support a finding of a likelihood of confusion. The plaintiff seems to believe that any evidence of actual confusion, no matter how slight, will

sustain its burden of showing a likelihood of confusion. The plaintiff is in error. Evidence of actual confusion, although the most probative on this issue, is but one of the factors the court considers in assessing the plaintiff's claim of infringement. More important, evidence of occasional, isolated instances of confusion is insufficient to sustain a finding of a likelihood of confusion when given the similarities [*37] between the plaintiff's mark and the alleged infringer's mark, the duration of their concurrent use, and the total volume of sales under both marks, it would be reasonable to expect that if the plaintiff's allegations were true, more instances of confusion would have been reported. *Amstar Corp.*, 615 F.2d at 263, 205 U.S.P.Q. (BNA) at 978. The court finds it significant that several years after Milky Way's presentation was published, the only evidence of any confusion whatsoever by consumers is the Sipp letter.

8. Summary

Weighing all seven factors, the court concludes that the plaintiff has failed to show a likelihood of confusion by a preponderance of the evidence. The plaintiff's trademarks are strong as a result of its concerted efforts to cultivate a respectable commercial reputation. The parties' products and retail outlets, however, are substantially dissimilar, and while the purchasers of the two products may overlap, there is scant evidence that ordinary consumers attributed sponsorship of Milky Way's pictorial presentation to the plaintiff.¹² This lack of actual confusion is significant in light of the striking similarity in design. Finally, the defendants did not intentionally [*38] deceive the public in order to derive monetary benefit at the plaintiff's expense. For all the foregoing reasons, the court concludes that the plaintiff has failed to sustain its burden of proof on its claims of trademark infringement.

¹² Indeed, the supposed "advertisement" does not promote any product whatsoever, while all the evidence presented by the plaintiff shows that these marks have been used only in conjunction with the advertisement for sale of its food products. Moreover, the defendants' presentation was placed inside the magazine, so it is unlikely that, given the limited circulation of Screw magazine, the majority of the plaintiff's customers would even be exposed to this photograph.

The plaintiff alleges that Milky Way's unauthorized use of the plaintiff's barrelhead trademark, the slogan "Poppin' Fresh," the trade characters, and the jingle violates subsections (2), (3), and (5) of Georgia's enactment of the Uniform Deceptive Trade Practices Act, Ga. Code Ann. § 106-702. The parties agree that under this Act, the plaintiff must prove a likelihood of confusion between the parties' products. See *Amstar Corp.*, 615 F.2d at 265, 205 U.S.P.Q. (BNA) at 980; *Baker Realty Co. v. Baker*, 228 Ga. 766, 770, 174 U.S.P.Q. (BNA) 36, 187 S.E.2d 850 (1972). In disposing of the plaintiff's claims of trademark infringement, the court has already determined that the plaintiff has failed to show a likelihood of confusion. For this reason, its claim under this state statute must also fail.

E. Georgia "anti-dilution" Statute

The plaintiff alleges that in violation of Ga. Code Ann. § 106-115, Milky Way's unauthorized use of its barrelhead trademark, the words "Poppin' Fresh," its trade characters, and its jingle creates a likelihood of injury to its commercial reputation and of dilution of the distinctive quality of its trademarks, trade symbols, or advertising. The plaintiff contends that Milky Way has tarnished the reputation, and thereby impaired the effectiveness, of its advertising agents by placing them in a "depraved context."

Milky Way rests its defense against this claim upon an erroneous conception of the anti-dilution statute, namely that the plaintiff must prove a likelihood of confusion to prevail on this count. The court previously has concluded that the plaintiff has failed to show a likelihood of confusion, but [*40] as the statute plainly states, actionable dilution occurs when by subsequent unauthorized use of the plaintiff's marks, the uniqueness of the plaintiff's marks as the designation for its products is diminished by the defendant's unauthorized use of these marks, "notwithstanding the absence of competition between the parties or of confusion as to the source of goods or services." Ga. Code Ann. § 106-115; see *Holiday Inns, Inc. v. Holiday Out in America*, 481 F.2d 445, 450, 178 U.S.P.Q. (BNA) 257, 260 (5th Cir. 1973); *Dolphin Homes Corp. v. Tocomc Development Corp.*, 223 Ga. 455, 458, 155 U.S.P.Q. (BNA) 543, 156 S.E.2d 45 (1967). The basis for this cause of action is the belief that the owner of these marks should not have to stand by and watch the diminution in their value as a result of unauthorized uses by others. All the plaintiff need show

to prevail is that the contested use is likely to injure its commercial reputation or dilute the distinctive quality of its marks. See *Robert B. Vance & Associates v. Baronet Corp.*, 487 F. Supp. 790, 798, 205 U.S.P.Q. (BNA) 24 (N.D. Ga. 1979). The court concludes that, despite the lack of actual damages, there is a likelihood that the defendants' presentation could injure the business reputation [*41] of the plaintiff or dilute the distinctive quality of its trademarks. Consequently, the court concludes that the plaintiff has prevailed on this claim and is entitled to injunctive relief provided in section 106-115 of the Georgia Code.

F. Tortious Tarnishment

The plaintiff alleges as a separate cause of action a heretofore unheard of common law tort, tarnishment of trade characters. According to the plaintiff, this tort is committed when "the defendant has so altered the image of plaintiff's trade character [sic] (one of which is Pillsbury's corporate spokesman) as to make them distasteful or even repulsive to a significant segment of Pillsbury's customer." The plaintiff adds that in christening this tort the court will only be giving an official name to a species of tort that other courts have recognized previously.

The court, however, is at a loss to discern any of this ready-made precedent. The cases cited by the plaintiff in its briefs do not contain any reference to such a tort, and, after an independent search, the court was unable to locate the supposedly pre-existing foundation for this cause of action. Nor is the court inclined to accept the plaintiff's invitation [*42] to plant this first seed. Aside from the many theoretical and practical problems inherent in this undertaking, ones which the plaintiff does not begin to address, in the court's judgment any wrong done to the plaintiff's commercial reputation can be redressed adequately by existing statutory and common law causes of action. Indeed, many of these already overlap. In short, the court is not persuaded that a separate common law cause of action is needed to protect the reputation of a trade character. The court concludes that the plaintiff has failed to state a claim for tortious tarnishment of its trade characters.

G. Libel Per Se

The plaintiff alleges that under Georgia law, Ga. Code Ann. §§ 105-701, -703, the statement appearing in Mr. Goldstein's editorial column in the May 1, 1978 issue

of Screw that Mr. Winston Wallin, the president of Pillsbury, is "syph-laden" is libelous per se as to the company. The court sees little reason to discuss this allegation in great detail. This court has previously held that a corporation cannot be defamed by a personal reference to a company officer. *Southard v. Forbes, Inc.*, No. C74-1984A, slip op. at 3-4 (N.D. Ga. Sept. 20, 1977), *aff'd* [*43] on other grounds, 588 F.2d 140 (5th Cir. 1978), cert. denied, 444 U.S. 832 (1979). The plaintiff entreats the court to reconsider this ruling in light of the authorities it cites in its brief. The court has reviewed these decisions, but it does not feel that its ruling in *Southard* is inconsistent with the conclusion reached by these other courts. The court concludes that the plaintiff cannot recover for the alleged libel of one of its officers.

H. Contempt

The plaintiff contends that Milky Way¹³ violated the temporary restraining order and thereby is in contempt of court. On April 21, 1978, after hearing oral arguments on the question whether the plaintiff was likely to prevail on the merits of this action, the court modified its temporary restraining order of April 17, 1978, "to more clearly define the scope of the court's restraint against the defendant." It temporarily restrained Milky Way from reproducing or republishing the "claimed advertisement" that appeared in the two issues of Screw magazine or "any similar reproduction thereof which purports to be an advertisement of the plaintiff."

13 This claim is against Milky Way only and does not include the defendant bookstores.

[*44] In the May 1, 1978 issue of Screw, Milky Way reprinted in miniature, this same original picture as it had been reproduced in an article in the Village Voice about the law suit brought by Pillsbury. Alongside this Village Voice clipping is a portion of the contested presentation showing the plaintiff's trade characters coupling but the head of Pillsbury's president Winston Wallin transposed onto the doughboy's body.

Milky Way insists that this order did not proscribe this reproduction of the picture. It emphasizes that the picture appears under an editorial about the lawsuit and was taken from an article appearing in the Village Voice and that this reproduction is considerably smaller than the original.

The court cannot agree. Milky Way seems to believe that this order prohibited only the publication or reproduction of a picture which purports to be an advertisement of the plaintiff. The court, however, does not believe that the scope of this restraining order is so narrow. In the first sentence of this order the court prohibited Milky Way from reproducing or republishing this presentation. The court feels that, read fairly, this language applies to any reproduction of this [*45] picture by Milky Way during the prescribed term of this order, irrespective of the size of the reproduction.

The court modified the more expansive language of its first restraining order so as not to interfere with Milky Way's *first amendment* right to comment on this lawsuit. Milky Way is well within its rights to reprint in Screw what other publications or individuals have to say about its dispute with Pillsbury, but the court does not feel that this reprint from the Village Voice falls within this preserve. As reproduced in the Screw editorial, the only legible portion of the Village Voice article is the picture; the nameplate covers the text of the article, so that no one would be able to read this comment. Under the circumstances, the court concludes that this reproduction of the picture is in violation of the terms of this temporary restraining order and that, therefore, the defendant is in contempt of court.

III. Conclusion

In sum, the court concludes that (1) the court has personal jurisdiction over the defendants, (2) that venue is properly laid in this district, (3) that the court has subject matter jurisdiction over Pillsbury's claim alleging infringement of [*46] the cinnamon roll label copyright, (4) that the plaintiff cannot prevail on its claim that the defendants infringed its copyrights in the "Poppin" Fresh and "Poppie Fresh" dolls, (5) that the plaintiff has sustained its burden on its claim that the defendants infringed its copyright on the cinnamon roll label, (6) that the plaintiff has sustained its burden on its claim that the defendants infringed its copyright on its jingle, the two stanza refrain of "The Pillsbury Baking Song", (7) that the defendants' unauthorized use of the plaintiff's copyrights is protected by the "fair use" doctrine codified in 17 U.S.C.A. § 107, (8) that the plaintiff failed to sustain its burden of proof on its claims of trademark infringement, (9) that the plaintiff failed to sustain its burden of proof on its claim that the defendants violated the Uniform Deceptive Trade Practices Act, (10) that the

plaintiff has sustained its burden of proof on its claim that the defendants violated the Georgia "anti-dilution" statute, (11) that the plaintiff has failed to state a claim for tortious tarnishment of its trade characters, (12) that the plaintiff cannot recover for the alleged libel of one of its officers, [*47] and (13) that the defendant Milky Way is in contempt of court for violating this court's temporary restraining order entered April 21, 1978.

In light of the above rulings, the court concludes that a hearing would be appropriate in order to allow the parties to present argument on any and all issues concerning the final relief to be entered in the action. In lieu of a hearing, the parties are invited to confer and

present the court with a proposed consent order concluding the matter. If the parties are unable to reach agreement on a proposed consent order, the court will hold a hearing at 10:00 a.m., January 21, 1982, in room 1906, United States Courthouse, 75 Spring Street, S.W., Atlanta, Georgia, 30303. The parties are hereby directed either to present a proposed consent order prior to January 21, 1982 or to appear before the court at 10:00 a.m. on that date for a hearing on the final relief to be entered in the action.

It Is So Ordered.