

THE RUTHERFORD INSTITUTE

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INTERNATIONAL OFFICE
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April 5, 2011

Via Telefax and Certified Mail

Robert E. Barry, Esq.
County Counsel
County of Union
10 Elizabethtown Plaza
Elizabeth, New Jersey 07207

**Re: Use of the Seal of the County of Union / Union County Citizen's
Forum**

Dear Mr. Barry:

The Rutherford Institute has been contacted by Tina Renna, a resident of the County of Union who is the producer of the local access television show "Union County Citizen's Forum," which airs on the Township of Cranford's public access Channel 35. In a letter under your signature dated September 17, 2010, the County of Union demanded that the Township of Cranford cease and desist display of the Seal of the County of Union in any way, including all television shows, because the Seal is a pending trademark and the display constitutes trademark infringement. Ms. Renna's television show included a display of the Seal of the County of Union with a light shining on it, which was a symbolic expression of the show's purpose to shed light on the workings of the County government. The County's cease and desist demand has thereby inhibited her speech and expression. Indeed, it is Ms. Renna's belief that the County's demand was specifically targeted at her reporting of news and public information concerning the activities of the Union County government.

On behalf of Ms. Renna, we hereby demand that the County withdraw its demand that Channel 35 and programming producers, such as Ms. Renna, cease and desist display of the Seal of the County of Union as the County has no right to prevent use of the Seal under trademark laws, and the use of the Seal in connection with news and public information reporting is affirmatively protected by federal and state guarantees to freedom of speech.

The County's claim to trademark protection in the Seal is unwarranted because both federal and state trademark statutes preclude trademark registration for symbols and

insignias of governmental entities. Thus, the state trademark statute provides that a mark “shall not be registered” if it consists of “the flag or coat of arms or other insignia of the United States, or of any state or municipality[.]” N.J. Stat. Ann. § 56:3-13.2(c). *Accord* 15 U.S.C. § 1052(b). Counties are subdivisions of the state, *Shapiro v. Essex County Bd. of Chosen Freeholders*, 177 N.J. Super. 87, 98-99 (Law Div. 1980), and so the prohibition on registering state government insignias applies to Union County’s Seal.

Additionally, a trademark serves to identify and distinguish the source of a tangible product. *Dial-a-Mattress Operating Corp. v. Mattress Madness, Inc.*, 841 F. Supp. 1339, 1345 (E.D.N.Y. 1994). There is no indication that the County of Union is engaged in the production of tangible goods to which it attaches the Seal of the county such that trademark protection would arise.

Even more fundamentally, the display of the seal by Ms. Renna in connection with her news and public information programming is not commercial in nature and so would not violate any trademark rights of the County even if they existed. For a trademark to be infringed upon, it must be used “in connection with the sale, offering for sale, distribution, or advertising of any goods or services.” 15 U.S.C. § 1114(1)(a). Thus, the U.S. District Court for New Jersey recently held as follows:

Case law also supports the proposition that infringing use is only illegal if it is done in connection with the defendant’s offer or provision of goods or services. In cases in multiple circuits, courts have held that individuals who use protected marks in the course of merely criticizing the trademark holders’ goods or services do not violate the Lanham Act. . . . Courts have identified multiple reasons for holding that the Act does not apply in this situation, the most important of which for the case at bar is that such speech does not fall within the purview of the act because it bears no connection to the provision of goods or services.

Howard Johnson Intern., Inc. v. Vraj Brig, LLC, 2010 WL 215381, *6 (D.N.J. Jan. 14, 2010) (citing *Bosley Medical Institute, Inc. v. Kremer*, 403 F.3d 672, 677-680 (9th Cir.2005)).

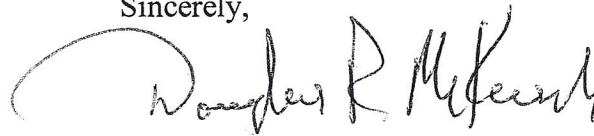
The limitation of trademark protection to commercial contexts is to allow persons to exercise the very First Amendment rights Ms. Renna is exercising when displaying the Seal of the county during her news and public information show. While the First Amendment may not protect a competitor who labels commercial goods in a confusing way, “trademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view.” *Bosley*, 403 F.3d at 677 (quoting *Mattel, Inc. v. M.C.A. Records, Inc.*, 296 F.3d 894, 903 (9th Cir. 2002)). The requirement that a use be “commercial” in order to be improper under the trademark laws is designed to protect both the trademark holder and the First Amendment rights of

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any citizen to comment and critique on the mark holder. *Utah Lighthouse Ministry, Inc. v. Discovery Computing, Inc.*, 506 F. Supp. 2d 889, 896 (D. Utah 2007).

The unwarranted cease and desist demand has chilled Ms. Renna's exercise of her First Amendment rights, particularly because the Channel 35 management may refuse Ms. Renna access to the public airways if she displays the Seal as is her right. Therefore, the demand contained in your September 17 letter must be withdrawn and the implied threat to sue if a display does occur disavowed. Because fundamental First Amendment rights are at issue here, I must have a response to this letter on or before the close of business April 14, 2011.

Sincerely,

A handwritten signature in black ink, appearing to read "Douglas R. McKusick". The signature is written in a cursive style with a large, sweeping initial "D".

Douglas R. McKusick
Staff Attorney

Cc: Walter Luers, Esq.
Ms. Tina Renna