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Via Email M.Pantalony@us.vuitton.com and First Class Mail

Michael Pantalony, Esq.
Director, Civil Enforcement, North America
Louis Vuitton Malletier
1 East 57th Street
New York, NY 10022

Dear Mr. Pantalony:

I represent the University of Pennsylvania, its Law School, and a student group at the Law School, the Pennsylvania Intellectual Property Group (PIPG), and Dean Michael Fitts forwarded your February 29, 2012 letter to me.

PIPG does not agree that the artwork on its poster and invitation infringes any of Louis Vuitton's trademarks, nor does it dilute any of those trademarks. In fact, 15 U.S.C. 1125(c)(3) expressly protects a noncommercial use of a mark and a parody from any claim for dilution. There also is no violation of 15 U.S.C. 1125(a) because there is no likelihood of confusion that Louis Vuitton sponsored or is associated with PIPG's annual educational symposium.

You assert that the clever artwork parody that appears on the poster and invitation is a "serious willful infringement." However, to constitute trademark infringement under the Lanham Act, PIPG has to be using a trademark in interstate commerce, which is substantially similar to Louis Vuitton's mark(s), and which is likely to cause confusion between Louis Vuitton's luxury apparel goods and PIPG's educational conference among the relevant audience. First, I don't believe that PIPG's artwork parody was adopted as, or is being used as, a trademark to identify any goods and services. It is artwork on a poster to supplement text, designed to evoke some of the very issues to be discussed at the conference, including the importance of intellectual property rights to fashion companies, the controversy over the proposed Innovative Design Protection and Piracy Prevention Act, and the exceptions in the law to liability for dilution, including parody. Second, although you don't cite the actual federal trademark registrations that you assert protect your marks, I doubt any of them are registered in Class 41 to cover educational symposia in intellectual property law issues. There is no substantial similarity between the goods identified by Louis Vuitton's marks and the PIPG educational symposium. Third, there is no likelihood of confusion possible here. The lawyers, law students, and fashion industry executives who will attend the symposium certainly are unlikely to think that Louis Vuitton is organizing the conference; the poster clearly says that PIPG has organized the event, with support from Penn Law and a number of nationally-known law firms. The artwork on the poster and invitation does not constitute trademark infringement.

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You also state that PIPG's use of its artwork parody knowingly dilutes the Louis Vuitton trademarks. I disagree. First, PIPG has not commenced use of the artwork as a mark or trade name, which is a prerequisite for any liability under 15 U.S.C. 1125(c)(1). More importantly, however, even if PIPG has used the artwork as a mark, there is an explicit exception to any liability for dilution by blurring or dilution by tarnishment for "any noncommercial use of a mark." 15 U.S.C. 1125(c)(3)(C). A law student group at a non-profit university promoting its annual educational symposium is a noncommercial use. Lastly, the artwork clearly is a fair use under 15 U.S.C. 1125(c)(3)(A), and a parody protected under 15 U.S.C. 1125(c)(3)(A)(ii). See also Louis Vuitton Malletier vs. Haute Diggity Dog, LLC, 507 F.3d 252 (4th Cir. 2007).

The poster and invitation are clear that Louis Vuitton is not a sponsor of the symposium, and no reasonable person would be confused or deceived as to sponsorship, affiliation, connection or association regarding Louis Vuitton and PIPG's conference, merely because of the clever artwork parody illustrating the invitation and poster. I do not think there is any liability under 15 U.S.C. 1125(a)(1), either.

Therefore, I will be advising PIPG that it may continue to use posters and invitations to its annual symposium that contain the artwork to which Louis Vuitton objects, without violating any of Louis Vuitton's legitimate trademark rights. I realize that Steven Barnes, the Associate Dean for Communications at the Law School, previously sent you an email stating that PIPG would stop using the posters and invitations. However, Mr. Barnes sent that email before seeking legal advice from our office and without sharing that legal advice with PIPG. Now that we have had the time to consider your letter and investigate the facts and the law, I will be advising the students otherwise.

If there is any need to discuss this further, please contact me directly. In addition, I encourage you to attend the symposium on March 20, 2012. Educating our students about both the rights of, and the defenses against, intellectual property owners, is a key goal of the symposium. The students have invited some of the in-house counsel from some of your peer fashion companies to speak on the panels, and I am sure the students would welcome your attendance as well. If you are able to come, please let me know, so I can introduce myself in person, and try to introduce you to some of the Penn Law faculty and students working to make their annual educational symposium about the unique and challenging intellectual property issues in the fashion industry a success.

Sincerely,

A handwritten signature in cursive script that reads "Robert F. Firestone".

Robert F. Firestone

Cc: Dean Michael Fitts, University of Pennsylvania Law School