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Westchester Media Co. L.P., et al. v. PRL USA Holdings, Inc.: The Fight over the Name, POLO

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I. INTRODUCTION

"It is impossible to own the name Polo just as it is impossible to own the name soccer or tennis." Many shared this sentiment when "[a] onetime horseman’s magazine, now full of ads from the likes of Gucci and Lexus, was told by a federal court to start running disclaimers saying it has nothing to do with fashion design house Polo Ralph Lauren Corp." Westchester Media Company v. PRL USA Holdings underscores the high stakes involved in protecting a brand name when PRL USA Holdings ("PRL") sought to prevent Westchester Media Corporation ("Westchester") from using "POLO" as its magazine title. In so doing, PRL’s claim against Westchester implicated the latter’s First Amendment right to choose an appropriate title for its literary works. Consequently, the Fifth Circuit had to decide whether a fashion design house or an official sports publication had a greater right to the name "POLO."

This note focuses on the Fifth Circuit’s trademark infringement and dilution analysis that led to “Polo Magazine get[ting]
whipped by Lauren." Section II describes the facts that gave rise to this case. Section III discusses the applicable areas of law considered, including the Lanham Act, the Federal Trademark Dilution Act ("FTDA") and several state law claims. The Fifth Circuit's analysis and disposition of the issues are covered in detail in Section IV. Section V analyzes the Fifth Circuit's decision, which adopted a new standard for establishing dilution under the FTDA. In conclusion, Section VI explores the impact of Westchester Media on similar suits in the future.

II. FACTS

Fashion design house, Polo Ralph Lauren Corp. ("PRL"), sued magazine publisher, Westchester Media Company ("Westchester"), alleging both trademark infringement of its "Polo" mark under the Lanham Trademark Act and dilution of that mark under the Federal Trademark Dilution Act. Since 1967, Ralph Lauren has been involved in the fashion and design business, building PRL into a successful multi-billion dollar company that sells fashion apparel, accessories, home furnishings and men's and women's designer fragrances. In conducting this business, PRL has registered a number of trademarks with the Patent and Trademark Office, including the word "POLO." PRL asserts that after thirty years of continuously using its registered trademarks, those marks have become fa-

8. For a discussion of the facts of Westchester Media Co., see infra notes 13-36 and accompanying text.
9. For a discussion of the background of the Lanham Act, the FTDA, and other applicable law, see infra notes 37-109 and accompanying text.
10. For a discussion of the court's analysis and holding in Westchester Media Co., see infra notes 110-99 and accompanying text.
11. For an analysis of the court's reasoning, see infra notes 200-14 and accompanying text.
12. For a discussion of the impact of Westchester Media Co., see infra notes 219-23 and accompanying text.
14. See Westchester Media Co., 103 F. Supp. 2d at 940. In the last four years alone, PRL sold approximately four billion dollars wholesale value of products bearing various "Polo" trademarks. See id. PRL advertises extensively in newspapers, trade publications and magazines. See id. In fact, articles have been written about PRL's products and Ralph Lauren himself in such magazines as Time, Financial World and Town and Country. See id.
15. See id. These "Polo" trademarks, while all remain in effect and several have become incontestable under the Lanham Act, do not include a POLO trademark for use on a publication of any kind. See id.
mous, and the word “POLO” has come to be closely identified with both Ralph Lauren and PRL.\(^{16}\)

Westchester, on the other hand, is a magazine publisher who, prior to the summer of 1997, focused solely on topical specialty magazines like “Cowboys and Indians.”\(^{17}\) In May 1997, however, Westchester and its general partner, Novasota Holding Company (“Novasota”), purchased all of the assets of POLO magazine from Fleet Street Publishing and its owner, Ami Shinitzky.\(^{18}\) Those assets included its trademark rights to the name “POLO.”\(^{19}\)

Ami Shinitzky founded POLO magazine (“Old POLO Magazine”) in 1975 as a polo enthusiast and as a member of the United States Polo Association (“USPA”).\(^{20}\) Until the sale to Westchester in 1997, the Old POLO Magazine was a special interest magazine, and the magazine’s devotion to the sport earned its endorsement as the “Official Publication” of the USPA.\(^{21}\) Under Shinitzky’s direction,

\(^{16}\) See Westchester Media Co. v. PRL USA Holdings, Inc., 214 F.3d 658, 661 (5th Cir. 2000) (noting since 1967, PRL has built image known to national and international consumers).

\(^{17}\) See id. at 661.

\(^{18}\) See id. John B. Goodman, sole shareholder of Novasota, is an avid polo player with strong ties to the United States Polo Association (USPA). See id. He is captain of the top-ranked polo team that has represented the United States in the international Westchester Cup tournament. See id. Additionally, he has been a member of the USPA since 1989 and serves on the boards of two USPA committees. See id. He is also on the board of directors of the Houston Polo Club, where he was president in 1994 and 1995. See id.

\(^{19}\) See id. Shinitzky and Fleet Street acquired trademark registrations in 1992. They read:

1. Registration No. 1,691,432 for “POLO”, a “magazine on the subject of equestrian sports and lifestyles”;
2. Registration No. 1,677,088 for a “horse and rider design” for “magazine publication services”, and the design which appears on the masthead of POLO magazine; and
3. Registration No. 1,710,894 for “POLO Life”, a “magazine dealing with equestrian sports and lifestyles.”

\(^{20}\) See Westchester Media, 214 F.3d at 661 (emphasizing POLO Magazine’s history is critical to dispute at hand).

\(^{21}\) See id. Old POLO Magazine was “an insider’s view of the sport of polo and the international society and . . . traditions that surround it.” Id. In an article on the history of the Old POLO Magazine from August 1997, Shinitzky wrote that the magazine “hit its stride with a formulaic mixture of game coverage, personality and
Old POLO Magazine and PRL enjoyed a "peaceful coexistence," even though Shinitzky began publishing Old POLO Magazine with an expanded "lifestyle" section in 1989, called "POLO Life." In 1992, Shinitzky obtained federal registration for POLO as a "magazine on the subject of equestrian sports and lifestyles."

In 1997, Westchester purchased all assets of the Old POLO Magazine and re-launched the magazine with the same name ("New POLO Magazine"). Westchester described the New POLO Magazine as "not about the sport, but rather [about] an adventurous approach to living life." Westchester's re-launching efforts included purchasing Neiman Marcus' customer list to send promotional materials and a free copy of the magazine to over a million of those customers. Additionally, Westchester chose fashion model, Claudia Schiffer, to appear on the inaugural issue's cover. Finally, Westchester published a separate magazine called "Polo Player's Edition" that focused primarily on the sport, mirroring that of Old POLO Magazine.

In addition, Old POLO's advertising base dealt primarily with horses, riding and polo equipment. See id. See also 5th Circuit Affirms Infringement Finding, Remands on Remedy, 8 No. 19 MEALEY's LITIG. REP.: INTELL. PROP. 10 (July 3, 2000) (describing the history and outcome of this case).

22. See Westchester Media, 214 F.3d at 661-62 (explaining that Shinitzky interviewed Ralph Lauren shortly after magazine's founding, PRL frequently advertised in magazine and PRL never complained about magazine's use of "Polo" mark).

23. See id. at 662. A trade journal, Ad Week, described one of these issues in 1989 as bearing "a striking resemblance to one of Lauren's ads. It's loaded with pictures of upscale people having a good time at country clubs." Id. (quoting one of several entities finding similarities between old POLO and PRL). Although PRL was aware of the Ad Week article, it continued to advertise in Old POLO Magazine without any objection. See id. (noting Ad Week was not only entity finding similarities between old POLO and PRL).


25. See id. Unlike Shinitzky's magazine, the re-launched magazine carried the tagline "Adventure. Elegance. Sport." See id. New POLO Magazine also changed the target audience and distribution methods. See id.

26. Id. at 945.

27. See Westchester Media, 214 F.3d at 662. Neiman Marcus is one of PRL's largest retailers. See id.

28. See Westchester Media Co., 103 F. Supp. 2d at 945 (noting this was only one year after Schiffer was PRL's featured model in one of their exclusive advertising campaigns).

29. See id. at 943 (explaining that Old POLO Magazine was forerunner of Polo Player's Edition and is perfectly consistent with the theme of sport-centered periodical including profiles of celebrity players, supporters of polo and features concerning sport venues).
Initially, Westchester attempted and succeeded in maintaining the magazine’s relationship with PRL. In September 1997, however, everything changed when the designer formally objected to New POLO Magazine’s use of the name “POLO” as the title of the new magazine. In response, Westchester filed a declaratory judgment action against PRL, seeking a determination of its right to use “POLO” as the title for the magazine. PRL answered by filing counterclaims alleging trademark infringement and dilution. PRL further sought injunctive relief under state law claims of unfair competition and injury to business reputation. In response, Westchester raised the defenses of laches, acquiescence, trademark incontestability and a First Amendment right to appropriately name its literary work. The District Court held in favor of PRL and issued a permanent injunction against Westchester’s use of “POLO” for its fashion magazine’s title.

30. See Westchester Media Co. v. PRL USA Holdings, Inc., 214 F.3d 658, 662-63 (5th Cir. 2000). Westchester contacted PRL, secured a meeting with Elizabeth Morris and made an advertising sales pitch. See id. at 663. The pitch included two “mock-up” covers of the New POLO Magazine, neither of which was ever used for the New POLO Magazine. See id. One cover depicted a horse, but Westchester did not put a horse on the cover until over a year after its re-launch. See id. Slaughter testified that Morris reacted positively to his presentation. See id. PRL asserted that Morris made a clear objection to the magazine’s title. See id.

31. See id. at 663. In September 1997, PRL’s advertising agency invited Westchester to an event, allowing them to solicit advertising agreements with PRL, but rescinded the invitation. See id. Later, on September 23, 1997, PRL formally objected to the title of the New POLO Magazine. See id. (asserting PRL made clear objection to magazine’s title).

32. See id. (claiming its magazine on “equestrian sports and lifestyles” does not infringe on PRL’s “Polo” mark).


34. See Westchester Media Co. v. PRL USA Holdings, Inc., 103 F. Supp. 2d 935, 1010 (S.D. Tex. 1999) (requiring Westchester to disseminate “disclaimer which states clearly that POLO Magazine has no affiliation, sponsorship, or association with Ralph Lauren, or any Ralph Lauren entities”).

35. See id. For a discussion of the Fifth Circuit’s treatment of Westchester’s defenses, see infra notes 182-99 and accompanying text.

36. See id. The magistrate judge held that:

(1) supplier showed likelihood of confusion leading to conclusion that supplier published or sponsored magazine;
(2) alternatively, supplier showed likelihood of dilution of trademark;
(3) incontestable nature of publisher’s trademark for “Polo,” as used with equestrian magazine, did not carry over into new format;
(4) First Amendment did not bar issuance of injunction;
(5) Supplier was not barred from seeking injunction under doctrines of laches or acquiescence;
(6) Supplier satisfied irreparable injury, balance of harms and public interest requirements for injunction;
(7) Removal of name was required; and
III. BACKGROUND

A. The Lanham Act

The Federal Trademark Act of 1946, the "Lanham Act," is the codification of trademark law in the United States.\(^{37}\) The purpose of the Lanham Act is to consolidate, amend and codify all pre-existing trademark law to prevent the reasonably prudent consumer from being confused as to the source or sponsorship of products and services in a given marketplace.\(^{38}\)

The Lanham Act defines a trademark as "any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others."\(^{39}\) This definition demonstrates that the primary function of a trademark is to be distinctive.\(^{40}\) Specifically, trademarks are "commercial substitutes

\(^{37}\) Attorney fees would not be assessed.

See id.


\(^{38}\) See S. Res. 1333, 79th Cong. 5 (1946), reprinted in 1946 U.S.C.C.A.N. 1274. The Senate Committee on Patents said that:

The purpose of this bill is to place all matters relating to trade-marks in one statute and to eliminate judicial obscurity, to simplify registration and to make it stronger and more liberal, to dispense with mere technical prohibitions and arbitrary provisions, to make procedure simple, and relief against infringement prompt and effective . . . . There can be no doubt . . . that the protection of trademarks is merely protection of goodwill, to prevent diversion of trade through misrepresentation and the protection of the public against deception [and] a sound public policy requires that trademarks should receive nationally the greatest protection that can be given them.


\(^{39}\) JANE C. Ginsburg et al., TRADEMARK AND UNFAIR COMPETITION LAW 27-44 (The Michie Company 1991). There are four general functions of trademarks: 1) to establish its distinctive identity by distinguishing itself from the competition; 2) to establish that all products and services bearing the same name are of equal quality; 3) to signify that goods bearing the same trademark come from the same source; and 4) to aid in the sale of goods and services. See id. These functions enable sellers/manufacturers to establish goodwill and create "buyer momentum" and "the lure to return." J. THOMAS McCarthy, The Rights of Publicity and Privacy 104, 104-05 (Clark, Boardman, and Callaghan, 1993).

\(^{40}\) In discussing the purpose and significance of trademarks in the market setting, Justice Frankfurter stated the following:

The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trade-mark is a merchandising short-cut that induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human
for one's own autographic signature, certifying to the genuineness of the goods to which they are affixed.\textsuperscript{41}

A trademark "does not [, however,] confer a right to prohibit the use of the word or words. . . . A trade-mark [sic] only gives the right to prohibit the use of [the word] so far as to protect the owner's good will against the sale of another's product as his."\textsuperscript{42} The Senate Committee on Patents, which is the reviewing body of the trademark bill, found trademarks to be the essence of competition.\textsuperscript{43} The Senate Committee valued the Lanham Act as a tool to ensure fair competition by making possible a choice between distinguishable competing articles, protecting the public from deceit, fostering fair competition and securing to the business community the advantages of reputation and goodwill.\textsuperscript{44}

Under the Lanham Act, a plaintiff who owns a federally registered trademark, may take federal action based upon, \textit{inter alia}, un-

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propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress. Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co., 316 U.S. 203, 205 (1941).
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\textsuperscript{42} S. REP. No. 79-1333, at 3 (1946), \textit{reprinted in} 1946 U.S.C.C.A.N. 1274, 1275 (quoting Prestonettes v. Coty, 264 U.S. 359, 368 (1924)). "[The Trademark Bill] has as its object the protection of trademarks, securing to the owner the good will of his business and protecting the public against spurious and falsely marked goods." Smith, \textit{supra} note 38, at 1529-30 (providing general overview of requirements and protections of Lanham Act).

\textsuperscript{43} \textit{See} id. \textit{See also} S. REP. No. 79-1333, at 3 (1946) (noting importance of trademarks in distinguishing competing goods and services in any given marketplace).

\textsuperscript{44} \textit{See id. See also} 1 J. McCarthy, \textit{Trademarks and Unfair Competition} § 2:1, at 44-49 (2d ed. 1984). Four categories of trademark strength with corresponding levels of protection include: 1) arbitrary and fanciful marks; 2) suggestive marks; 3) descriptive marks; and 4) generic marks. \textit{See} McCarthy, \textit{supra} note 39, at 74. Arbitrary and fanciful marks receive the highest protection because they are inherently distinctive. \textit{See id. They unquestionably identify a specific product or entity and create a greater likelihood of confusion if third parties use such names. \textit{See id. Alternatively, if the mark simply carries a descriptive name, it will not be given the same level of protection because the likelihood of confusion is less. \textit{See id. To determine whether a mark is descriptive, three factors are considered: 1) if the mark describes the product or service it identifies, or 2) describes the geographic location from which the goods or services originate, or 3) constitutes a person's last name. \textit{See id. Generic names receive no protection. \textit{See id.}
fair competition, trademark infringement or dilution. Plaintiffs may also pursue federal remedies in the absence of federal registration for unfair competition under theories of, inter alia, fraud, false advertising or infringement. If a plaintiff owns a mark registered with a state, she may sue under infringement or unfair competition. Plaintiffs may also proceed under common law rights of, inter alia, infringement, unfair competition, dilution or invasion of right to publicity. Typical defenses to trademark infringement and unfair competition include, inter alia, incontestability, abandonment, acquiescence, laches, unclean hands, fraud, fair use and the denial of a likelihood of confusion.

B. Trademark Infringement

The owner of a registered trademark may bring an action for infringement under the Lanham Act when another uses: 1) any reproduction, counterfeit, copy or color imitation of a mark; 2) without the registrant’s consent; 3) in commerce; 4) in connection with a sale, offering for sale, distribution or advertising of goods; 5) where such use is likely to cause confusion, mistake or deception.

In the Fifth Circuit, a trademark infringement action requires a two-step analysis: determining whether the claimant has a protectable right in its mark; and, if so, whether there is infringement as determined by the likelihood of confusion. The Fifth Circuit's

45. See S. Rep. No. 79-1333, at 3 (1946), reprinted in 1946 U.S.C.C.A.N. supra note 38, at 1976. The Committee stated that in regard to the protection afforded to trademark holders: "There is no essential difference between trademark infringement and what is loosely called unfair competition. Unfair competition is the genus of which trademark infringement is one of the species; the law of trademark is but a part of the broader law of unfair competition." Id. at 4, reprinted in U.S.C.C.A.N. supra note 38, at 1975 (quoting United Drug Co. v. Rectanus, 248 U.S. 90, 97 (1918)). For an authoritative review of federal legal theories upon which plaintiffs might sue, see McCarthy, supra note 44, at ¶ 33:1; see also Balarum Gupta, Names and Logos: Protection under Intellectual Property Laws and Consequences, 2 Sports Law. J. 245, 253 (1995).


47. See Kuester & Nieves, supra note 46, at 249-61 (discussing state legal theories upon which plaintiffs might sue); see also McCarthy, supra note 44, at ¶ 33:2.

48. See McCarthy, supra note 44, at ¶ 33:4 (discussing common law rights upon which plaintiffs might sue).

49. See id. at ¶ 33:4 (discussing typical defenses to trademark infringement and unfair competition).


51. See Sec. Ltd. v. First Nat’l. Sec. Centers, 750 F.2d 1295, 1298 (5th Cir. 1985); see also Boston Beer Co. v. Slesar Bros. Brewing Co., 9 F.3d 175, 180 (1st Cir.
decision in *Elvis Presley Enterprises, Inc. v. Capece* requires that defendant's use of the trademark create a likelihood of confusion in the minds of potential consumers as to the "source, affiliation, or sponsorship" of the defendant's mark. A likelihood of confusion is "synonymous with probability of confusion, which is more than a mere possibility of confusion." The non-exhaustive list of factors considered in determining whether such a likelihood of confusion exists includes: (1) the type of mark allegedly infringed; (2) the similarity between the two marks; (3) the similarity of the two products or services; (4) the identity of the retail outlets and purchasers; (5) the identity of the advertising media used; (6) the defendant's intent; and (7) any evidence of actual confusion. In considering these "digits of confusion," "no single factor is dispositive; a finding of a likelihood of confusion does not require a positive finding on a majority of these factors;" and courts may consider additional relevant factors.
C. Dilution

Dilution refers to the diminishing of a trademark's marketing value. Anti-dilution laws arose to provide legal protection against another's use of one's trademark on non-competing, unrelated goods. The purpose of anti-dilution laws is not to prevent consumer confusion, but rather to protect a mark owner against the gradual diluting, or whittling away, of the mark's identity. Just as a trademark must be "distinctive" in order to receive infringement protection, anti-dilution laws protect that same distinctiveness while maintaining the trademark's ability to identify the source of goods.

1. The Federal Trademark Dilution Act

PRL claimed dilution of its mark under 15 U.S.C. § 1125(c)(3), the Federal Trademark Dilution Act ("FTDA"). The FTDA's purpose is to address those situations in which a junior user's mark may cause harm to a senior user's mark, even though the junior mark may not compete directly with the senior user. Specifically, the FTDA amends the Lanham Act to codify the protection available to "famous marks." The FTDA prevents unauthorized users from attempting to trade upon the mark holder's goodwill and established renown in commerce, thereby diminishing the mark's distinctive quality.

57. For an authoritative review of trademark dilution, see generally David S. Welkowitz, Reexamining Trademark Dilution, 44 Vand. L. Rev. 531 (1991).


59. See Frank I. Schecter, The Rational Basis of Trademark Protection, 40 Harv. L. Rev. 813, 825 (1927) (explaining dilution theory envisions another's use of one's mark as "whittling away or dispersion of the identity . . . of the mark").


62. See H.R. Rep. No. 104-374, at 3 (1995), reprinted in 1995 U.S.C.C.A.N. 1029, 1030 (stating Congress' intent in passing FTDA was to provide uniformity in law by permitting dilution claims regardless of whether relief was available in state where suit is brought and provide claimants with nationwide injunctive relief).

63. See 15 U.S.C. § 1125(c)(1) (1996) (noting under FTDA, owner of famous mark is protected "against another person's commercial use . . . of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark").

Like state anti-dilution statutes, the FTDA defines dilution as the "lessening of the capacity of a famous mark to identify and distinguish goods or services." Consequently, "[t]o show dilution, under the federal law, a plaintiff must prove (1) sufficient similarity between the junior and senior marks to evoke an instinctive mental association of the two by a relevant universe of consumers which (2) has caused (3) actual economic harm to the famous mark's value by reducing its previous selling power as an advertising agent for its goods or services." "Mere proof that customers would make a mental association between the marks however, is insufficient to allow a plaintiff to prevail." Finally, under the FTDA, plaintiff must show that its mark is "famous" and defendant's use "causes dilution."
Currently debate exists as to the requirements of a dilution claim. The Fourth Circuit requires “actual consummated harm.”\(^{69}\) The Second Circuit, on the other hand, requires only proof that confusion is likely.\(^{70}\)

2. **Dilution Under Texas State Law**

According to Texas law, to succeed in a state dilution claim, the plaintiff must demonstrate that its mark is distinctive and there is a likelihood that dilution will follow defendant’s use of those marks.\(^{71}\) Nonetheless, “[w]hile the legislative history of the Dilution Act clearly states that the Act does not preempt existing state dilution statutes,’ one exception to the general rule of non-preemption, is set out at 43(c)(3) of the Act.”\(^{72}\) This section provides that federal registration of a trademark is a complete defense to state and common law dilution claims, and the section was included to encourage federal registration.\(^{73}\)

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69. See Ringling Bros. Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 170 F.3d 449, 452 n.6 (4th Cir. 1999) (noting that FTDA’s legislative history indicates congressional understanding that dilution results from actual blurring or tarnishment, i.e. dilution has been proven). See also Robert N. Klieger, *Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection*, 58 U. Pitt. L. Rev. 789, 840 (1997) (noting key difference between requirements of federal dilution act and requirements of its state counterparts). Klieger states that “[I]n place of the ‘likelihood of dilution’ language of the state anti-dilution statutes, the [federal act] . . . creates an actual dilution requirement.” Id.

70. See Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208, 218 (2d Cir. 1999) (holding that company established likelihood of success on dilution claim through showing that famous mark was susceptible to blurring). See also Eli Lilly and Co. v. Natural Answers, Inc., 86 F. Supp. 2d 834, 852 (S.D. Ind. 2000) (finding likelihood of confusion).


The ownership by a person of a valid registration . . . on the principal register shall be a complete bar to an action against that person, with respect to that mark, that is brought by another person under the common law or a statute of a State and that seeks to prevent dilution of the distinctiveness of a mark, label, or form of advertisement.

In defense of PRL's infringement, dilution and unfair competition claims, Westchester raises defenses based upon First Amendment rights, as well as laches, acquiescence and incontestability. 74

1. First Amendment

The First Amendment to the Constitution of the United States precludes laws restricting freedom of expression. 75 Despite said Constitutional limitation, "[i]ncidental government restrictions on expression . . . do not violate the First Amendment." 76 Courts, therefore, must balance the competing interests of the speaker's First Amendment rights and the government's need to regulate the affected expression when deciding whether government action unduly restricts freedom of speech. 77 Differing types of speech carry different degrees of constitutional protection. 78 The Supreme Court for example has established that obscene expression and expression inciting lawless activity receive no protection; while political expression on the other hand receives great protection. 79

Section 1125(c)(3) encourages the federal registration of trademarks and furthers the purpose of the Lanham Act by protecting registered marks from state law interference. See Jerome Gilson, 2 Trademark Protection and Practice § 5.12[1][c][v], at 5-267 (1974) (current through May 1999); see also 3 McCarthy, supra note 44, § 24-90, at 24-144 and n.26 (citing House Report 104-374 (Nov. 30, 1995)). While section 1125(c)(3) provides an absolute defense to dilution claims based on state law, it has no impact on dilution claims that are based on federal law. See Gilson, supra, § 1.12[1][c][v], at 5-267; see also 3 McCarthy, supra note 44, § 24-90, at 24-144. See also Viacom Inc. v. Ingram Enters., Inc., 141 F.3d 886, 891 n.8 (8th Cir. 1998).


75. See U.S. CONST. amend. I. The First Amendment states: "Congress shall make no law . . . abridging the freedom of speech, or of the press." Id. However, the Supreme Court has consistently held that the First Amendment prohibits only government action that unduly restricts freedom of expression. See, e.g., Gitlow v. New York, 268 U.S. 652, 666 (1925).


78. See Langvardt, supra note 76, at 48 (citing Dun and Bradstreet, Inc. v. Greenmoss Builders, Inc., 472 U.S. 749, 758-60 (1985) (suggesting that not all speech is valued equally for First Amendment purposes).

79. See Miller v. Cal., 413 U.S. 15, 25 (1972) (holding that mailing of unsolicited sexually explicit material not protected by First Amendment). Indecent expression, unlike obscene expression, is generally protected. See, e.g., Sable Com-
Supreme Court however has also noted that “[o]ur cases have never suggested that expression about philosophical, social, artistic, economic, literary, or ethical matters . . . is not entitled to full First Amendment Protection.”

a. Commercial Speech v. Non-Commercial Speech

In 1976, the U.S. Supreme Court declared that “commercial speech” is protected by the Constitution’s First Amendment “free speech” clause. The Supreme Court consistently has held that false or misleading commercial speech is not constitutionally insulated from appropriate regulation. With regard to such false or misleading commercial speech, the Supreme Court found that

80. Abbood v. Detroit Bd. of Educ., 431 U.S. 209, 231 (1977) (holding First Amendment principles prohibited union and Board of Education from conditioning employment as public school teacher upon teacher’s contribution to and support of ideological cause that she might oppose).


82. See id. The Constitution does not prohibit courts from “insuring that the stream of commercial information flows cleanly as well as freely.” Id. Further, the Supreme Court has noted, “the government may ban forms of communication more likely to deceive the public than to inform it.” Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n, 447 U.S. 557, 563 (1980). At times, the Supreme Court has been remarkably indulgent in permitting regulation in cases where advertising has been only arguably misleading. See Friedman v. Rogers, 440 U.S. 1, 18 (1978) (holding possibility of deception through use or trade names suffices for state to forbid their use). The Court however has rejected adopting the “potentially misleading” standard as the basis for banning certain types of advertising. See Ibanez v. Fla. Dept’ of Bus. & Prof’l. Regulation, 512 U.S. 136, 146-47 (1994) (holding state did not show that “CPA” and “CFP” designations in attorney advertising would actually or potentially mislead public). Specifically, the Court has stated that “[w]e cannot allow rote invocation of the words ‘potentially misleading’ to supplant the Board’s burden to ‘demonstrate that the harms it recites are real and that its restriction will in fact alleviate them to a material degree.’” Id. See also Peel v. Attorney Registration & Disciplinary Comm’n, 496 U.S. 91, 106 (1990) (explaining that attorney’s use of designation “Certified Trial Specialist by The National Board of Trial Advocacy” was neither actually nor potentially misleading, hence,
"[t]he government may ban forms of communication more likely to deceive the public than to inform it."83 As Justice Blackmun stated, "[a] listener has little interest in receiving false, misleading, or deceptive commercial information."84 False or misleading commercial speech therefore, is not protected by the First Amendment and may be abridged or prohibited completely.85

In an action for trademark infringement, where confusion is likely, the First Amendment does not affect enforcement of trademark rights.86 As such, freedom of speech is not absolute because First Amendment freedom is balanced against competing governmental interests and policies.87 With respect to certain types of speech, the freedom of speech yields to other interests.88 PRL's efforts to prevent Westchester from using "POLO" as the title of its literary work creates a clash between trademark protection and First Amendment rights.89
b. First Amendment and Trademark Protection

Typically, in support of a trademark infringement claim, a plaintiff only needs to establish a likelihood of confusion to establish the case. When a plaintiff attempts to control or affect the use of a word however, this action implicates the First Amendment right to choose an appropriate title for literary works. In Rogers v. Grimaldi, the Second Circuit ruled that the tension between the protection afforded by the Lanham Act to trademark owners and the protection afforded by the First Amendment to expressive activity could not be resolved by allowing the First Amendment to insulate titles of artistic works from Lanham Act claims. Courts other than the Second Circuit, however, could not ignore First Amendment concerns when enforcing the Lanham Act.

Finding that “overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values,” courts construe the Lanham Act narrowly to avoid that conflict. For example, because titles combine both artistic expression and commercial promotion, the Rogers court held that titles require more First Amendment protection than the labeling of ordinary commercial products—commercial speech. The Second Circuit decided that “literary titles do not violate the Lanham Act unless the title has no

90. For a discussion of trademark infringement and the “likelihood of confusion” requirement, see supra notes 50-56 and accompanying text.

91. See Westchester Media, 214 F.3d at 664 (citing Sugar Busters LLC v. Brennan, 177 F.3d 258, 269 n.7 (5th Cir. 1999), which noted First Amendment interest in choosing appropriate book title); see also Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd., 996 F.2d 1366, 1379 (2d Cir. 1993).

92. 875 F.2d 994 (2d Cir. 1989).

93. See id. at 998. In Rogers, the Second Circuit found that because “overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values . . . [it] . . . must construe the Lanham Act narrowly to avoid such conflict.” Id. (citing Silverman v. CBS, 870 F.2d 40, 48 (2d Cir. 1989)). See also Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub’g Group, Inc., 886 F.2d 490, 494 (2d Cir. 1989) (recognizing that if parody conveys that it is original work instead of obviously being parody, it would not only be poor parody but also vulnerable under trademark law due to customer confusion).

94. See Rogers, 875 F.2d at 994; see also Silverman v. CBS, 870 F.2d 40, 47-48 (2d Cir. 1989) (recognizing that in area of artistic speech, enforcement of trademark rights carries risk of inhibiting free expression); Cliffs Notes, 886 F.2d at 494 (2d Cir. 1989) (noting, “[Lanham] Act should be construed to apply to artistic works only where public interest in avoiding consumer confusion outweighs public interest in free expression”) (citing Rogers, 875 F.2d at 999).

95. Westchester Media, 214 F.3d at 664 (citing Rogers, 875 F.2d at 994); see also Silverman, 870 F.2d at 48; Cliffs Notes, 886 F.2d at 494.

96. See Rogers, 875 F.2d at 998 (holding although books are indisputably works of artistic expression and deserve protection, they are sold in commercial marketplaces making danger of consumer deception legitimate concern, warranting governmental regulation).
artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work." 97

When determining whether an artistically relevant title is misleading (as to the source or content of a work), the Second Circuit applies the likelihood of confusion test. 98 The likelihood of confusion must be "particularly compelling" when First Amendment interests are at stake. 99 In 1999, the Fifth Circuit adopted the Second Circuit's "particularly compelling" standard used in *Sugar Busters L.L.C. v. Brennan*. 100

2. Laches and Acquiescence

In addition to its First Amendment challenge, Westchester asserted the affirmative defenses of laches and acquiescence. 101 To succeed on a laches defense, a defendant must demonstrate prejudice by showing: "(1) [an] unreasonable delay by one [asserting legal or equitable rights . . . ; and (2) a good faith change of position by another to his detriment because of the delay." 102 Simply stated, "prejudice ensues when a defendant has changed his position in a way that would not have occurred if the plaintiff had not delayed." 103

97. *Westchester Media*, 214 F.3d 658, 664 (quoting *Twin Peaks Prods. v. Publ'ns Int'l*, Ltd., 996 F.2d 1366, 1379 (2d Cir. 1993)). See also *Rogers*, 875 F.2d at 999 ("Even where title surpassed appropriately low threshold of minimal artistic relevance but was explicitly misleading as to source or content, violation could be found.").

98. See *Twin Peaks Prods.*, 996 F.2d at 1379 (applying similar test used in evaluating standard trademark infringement claims).

99. See id. (requiring that "particularly compelling" circumstances exist before injunction can be issued in view of First Amendment objection).

100. 177 F.3d 258, 269 n.7 (5th Cir. 1999) (applying "particularly compelling" standard to Fifth Circuit cases where trademark and First Amendment rights conflict).

101. See *Westchester Media*, 214 F.3d at 668.

102. *Exxon Corp. v. Oxford Clothes, Inc.*, 109 F.3d 1070, 1082 (5th Cir. 1997) (citing *Rogers v. Ricane Enters.*, Inc., 772 S.W.2d 76, 80 (Tex. 1989)). See also *Conan Properties, Inc. v. Conan's Pizza, Inc.*, 752 F.2d 145, 153 (5th Cir. 1985) ("Laches is commonly defined as an inexcusable delay that results in prejudice to the defendant."); *Armco, Inc. v. Armco Burglar Alarm Co.*, 693 F.2d 1155, 1161 (5th Cir. 1982) (explaining differing standards for determining unreasonable delay); *Env'tl Defense Fund, Inc. v. Alexander*, 614 F.2d 474, 478 (5th Cir. 1980) ("Equitable remedies are not available if granting the remedy would be inequitable to the defendant because of the plaintiff's long delay.").

103. *Conopco, Inc. v. Campbell Soup Co.*, 95 F.3d 187, 192 (2d Cir. 1996) (internal quotations omitted) (quoting *Goodman v. McDonnell Douglas Corp.*, 606 F.2d 800, 808 n.17 (8th Cir. 1979)).
In addition to laches, the defendant can assert the affirmative defense, acquiescence. To succeed on this affirmative defense, the defendant must show that the plaintiff implicitly or explicitly assured the defendant so as to justifiably induce the defendant’s reliance.\(^{104}\) The difference between laches and acquiescence is slight; “Laches is commonly defined as an inexcusable delay that results in prejudice to the defendant, . . . [while] acquiescence involves the plaintiff’s implicit or explicit assurances to the defendant which induces reliance by the defendant.”\(^{105}\) Consequently, to prevail under the affirmative defense of acquiescence, Westchester must demonstrate that it had been prejudiced by an assurance, implicit or explicit, on PRL’s part.

3. \textit{Incontestability}

Westchester also asserted its right to publish the New POLO Magazine on the basis that the mark had become incontestable.\(^{106}\) Generally, a mark becomes incontestable after five years of continuous use, federal registration and compliance with statutory formalities.\(^{107}\) Once a mark has achieved incontestable status, “it is conclusively presumed either that the mark is non-descriptive, or if descriptive, has acquired a secondary meaning.”\(^{108}\) Consequently, an incontestable mark is rarely subject to challenge.\(^{109}\)

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\(^{105}\) Conan, 752 F.2d at 153 (citing In Re Bohart, 743 F.2d 313, 315 (5th Cir. 1984)).

\(^{106}\) See Westchester Media Co. v. PRL USA Holdings, Inc., 103 F. Supp. 2d 935, 982 (S.D. Tex. 1999) (noting incontestable defense is Westchester’s most convincing defense). Section 33(b) of the Lanham Act provides that an incontestable registration is conclusive evidence of the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 15. See 15 U.S.C. § 1115(b) (1996).


\(^{109}\) See 15 U.S.C. § 1115(b), which facially permits an incontestable mark to be challenged in the following circumstances:

- (1) That the registration . . . was obtained fraudulently; or
- (2) That the mark has been abandoned by the registrant; or
- (3) That the registered mark is being used . . . to misrepresent the source of the goods . . . in connection with which the mark is used; or
- (4) That the use of a name . . . charged to be an infringement is a use, otherwise than as a mark, of the [alleged infringer’s] individual name in his own business, . . . or of a term . . . which is descriptive of and used fairly and in good faith to describe the [alleged infringer’s] goods . . . or their geographic origin; or
- (5) That the [allegedly infringing mark] was adopted without knowledge of the registrant’s prior use and has been continuously used [for a certain period of time]; or
- (6) That the [allegedly infringing] mark was registered and used prior to the [infringed mark’s] registration; or
- (7) That the mark is being used to violate the anti-trust laws; or
- (8) That the mark is functional;
IV. NARRATIVE ANALYSIS

In *Westchester Media Company L.P. v. PRL USA Holdings, Inc.*, the Fifth Circuit considered five issues against a clearly erroneous standard of review. First, the court considered whether Westchester infringed upon PRL's "POLO" mark. Second, the court considered whether there was substantial proof to support PRL's trademark dilution claim. The third issue required the court's consideration of each party's rights, as determined by the protections of the Lanham Act and the First Amendment. The fourth issue was whether PRL was guilty of laches or acquiescence. The fifth issue was whether Westchester could claim the incontestability of its predecessor's (Fleet Street's) mark.

or (9) That equitable principles, including laches, estoppel, and acquiescence, are applicable.

*Id.*

110. 214 F.3d 658 (5th Cir. 2000).

111. See *id.*; see also *Fed. R. Civ. P. 52(a)* ("Findings of fact, whether based on oral or documentary evidence, shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."). A factual finding is clearly erroneous when the appellate court, after reviewing the complete record, is left with the definite and firm conviction that a mistake has been committed. See 6 *JAMES WM. MOORE ET AL., MOORE's FEDERAL PRACTICE* ¶ 206.03 (3d ed. 1999) (citing United States v. United States Gypsum Co., 333 U.S. 364, 395 (1948), which cited *Fed. R. Civ. P. 52(b)*; see also *Anderson v. City of Bessemer City, N.C.*, 470 U.S. 564, 574 (1985) (citing also *Fed. R. Civ. P. 52(b))*; *Carr v. Allison Gas Turbine Div. Gen. Motors Corp.*, 32 F.3d 1007, 1011 (7th Cir. 1994) (finding that sole woman surrounded by male factory workers invited sexual harassment was incredible in discrimination action); *Mar Oil, S.A. v. Morrissey*, 982 F.2d 830, 842 (2d Cir. 1993) (finding in attorney-fee dispute that plaintiff's attorney logged more time after complex litigation was resolved than during litigation was too improbable to believe); United States v. Fid. Capital Corp., 920 F.2d 827, 840 (11th Cir. 1991) (finding alter ego argument inconceivable in action by company to recover on debt, since company refused to release debt over many transactions with purported alter egos); *Todd v. Corp. Life Ins. Co.*, 945 F.2d 204, 208 (7th Cir. 1991) (ruling in breach of employment contract case, that letter could not unilaterally modify contract regarding term, but inconsistently finding that letter unilaterally modified contract regarding payment of expenses) (quotations omitted)). A mistake has been committed if the factual finding seems so improbable as to the belief, is incredible on the admitted facts, is inconceivable or is internally inconsistent. See *id.*

112. For a discussion of PRL's trademark infringement claim, see *infra* notes 119-43 and accompanying text.

113. For a discussion of the issue of dilution, see *infra* notes 144-53 and accompanying text.

114. For a discussion of the issue of suitable remedies, see *infra* notes 154-79 and accompanying text.

115. For a discussion of Westchester's defenses of laches and acquiescence, see *infra* notes 182-93 and accompanying text.

116. For a discussion of the incontestability of Westchester's mark, see *infra* notes 194-99 and accompanying text.
The Fifth Circuit concluded that Westchester’s magazine, “POLO,” infringed upon PRL’s “Polo” mark.\(^1\) The court also held that for PRL to establish a case of dilution, PRL would have to present proof of (1) actual dilution of its “Polo” mark caused by Westchester’s “POLO” mark; (2) the district court erred in failing to adequately consider a remedy that would have accommodated Westchester’s First Amendment concerns; (3) PRL was not guilty of laches or acquiescence; and (4) Westchester could not claim the incontestability of its predecessor’s “POLO” mark.\(^2\)

A. Westchester Infringed Upon PRL’s Mark

The Fifth Circuit first considered whether Westchester’s use of the “POLO” mark constituted infringement under the Lanham Act.\(^3\) On appeal, Westchester first argued that the court improperly applied the “particularly compelling” standard as mandated by the Fifth Circuit’s precedent in *Sugar Busters L.L.C. v. Brennan*\(^4\). Second, Westchester challenged the magistrate’s findings on several “digits of confusion.”\(^5\) Third, Westchester claimed that it had no intent to infringe upon PRL’s mark.\(^6\) Fourth, Westchester found fault in the court’s holding of a similarity between products because magazines are within PRL’s “natural zone of expansion.”\(^7\) Finally, Westchester argued that the 1997 re-launch of the New POLO Magazine did not result in increased actual confusion.\(^8\)

1. Consideration of the Sugar Busters Standard

The Fifth Circuit began the infringement analysis by considering Westchester’s complaint that the trial court improperly applied the *Sugar Busters*, “particularly compelling,” standard.\(^9\) Specifically, the Fifth Circuit considered whether the trial court erroneously applied the “particularlly compelling” standard as mandated by the Fifth Circuit’s precedent in *Sugar Busters L.L.C. v. Brennan*.\(^10\) In particular, Westchester challenged the district court’s findings on the issues of intent, similarity of products and services and actual confusion.\(^11\)

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1. See Westchester Media Co. v. PRL USA Holdings, Inc., 214 F.3d 658, 658-60 (5th Cir. 2000).
2. Id.
3. See id. at 663-66. Although the First Amendment is a consideration in the infringement claim, Section A specifically deals with infringement, while Section C considers the First Amendment considerations in determining a remedy for the resolution of this conflict. See id.
4. See id. at 665-68 (citing Sugar Busters LLC v. Brennan, 177 F.3d 258 (5th Cir. 1999)).
5. See id. In particular, Westchester challenged the district court’s findings on the issues of intent, similarity of products and services and actual confusion. See id.
7. See id.
8. See id. at 667.
9. See id.
10. See id.
ously found infringement despite Westchester's First Amendment interests by finding liability on a simple likelihood of confusion.\footnote{126}{See id. at 665.} In reviewing the injunction ordered against Westchester, the Fifth Circuit noted the magistrate's recognition that \textit{Sugar Busters} "raised the bar," requiring that "particularly compelling" circumstances exist before an injunction can be issued despite a First Amendment objection.\footnote{127}{See \textit{Westchester Media}, 214 F.3d at 665 (citing \textit{Westchester Media Co., v. PRL USA Holdings, Inc.}, 103 F. Supp. 2d 935, 991 (S.D. Tex. 1999)).} Because Westchester's position was to simply attack the evidence considered in the magistrate's "digits of confusion" analysis, the Fifth Circuit emphasized that only the likelihood of confusion, and not the evidence, must be "particularly compelling."\footnote{128}{See id. at 665-66 (citing depiction of standard in \textit{Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.}, 996 F.2d 1366, 1379 (2d Cir. 1993), as "the finding of likelihood of confusion must be particularly compelling"); \textit{see also} \textit{Sugar Busters LLC v. Brennan}, 177 F.3d 258, 269 n.7 (5th Cir. 1999) (requiring "particularly compelling" likelihood to cause confusion before First Amendment interests will be overcome); \textit{Twin Peaks Prods.}, 996 F.2d at 1379 (holding "the finding of likelihood of confusion must be particularly compelling to outweigh the First Amendment interest").}

2. Application of the Digits of Confusion

a. Westchester's Intent

In considering the digits of confusion, the Fifth Circuit began with Westchester's intent in adopting its "POLO" mark. In particular, the Fifth Circuit began by recognizing that "[a]n innocent intent in adopting a mark does not immunize an intent to confuse in the actual use of the mark."\footnote{129}{\textit{Westchester Media}, 214 F.3d at 666 (citing \textit{Elvis Presley Enters., Inc. v. Capece}, 141 F.3d 188, 203 (5th Cir. 1998)); \textit{see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 22 cmt. c (1995)).}} The court further recognized the history that Westchester's ownership has with the sport of polo and therefore, agreed with the magistrate judge that Goodman did not purchase the "Polo" mark with intent to trade on PRL's reputation and goodwill.\footnote{130}{See \textit{Westchester Media}, 214 F.3d at 666.} Nonetheless, the court found Westchester's actual use of the "Polo" mark, in light of its publication of two magazines, \textit{New POLO} and Polo Player's Edition, without a convincing explanation for the split, as evidence of an intent to trade on PRL's reputation.\footnote{131}{The Fifth Circuit noted the magistrate judge's review of evidence, including magazine covers, editorial and advertising content and customer surveys. \textit{See id.} This evidence demonstrated that \textit{New POLO} Magazine's primary focus is affluent lifestyles, fashion and travel rather than the sport of polo. \textit{See id.} The fact...}
b. Similarity of Products and Services

Even though Ralph Lauren publishes no magazines or periodicals, the Fifth Circuit supported the magistrate's decision on the issue of similarity of products and services, finding that magazines are within PRL's "natural zone of expansion."\(^{132}\) In the absence of direct competition, the Fifth Circuit agreed with the magistrate judge that "consumer perception is the issue."\(^{133}\) In comparing PRL's strong presence in the fashion and merchandise industry with New POLO Magazine's emphasis on fashion, elegance and affluent lifestyles, the court found no clear error in finding that consumers would perceive an inherent connection between PRL and New POLO Magazine.\(^{134}\) The court also found Westchester's marketing strategies, including the focus on consumers in the same context, to be persuasive.\(^{135}\) The Fifth Circuit, therefore, held that the record indicated no clear error in the district court's finding that the likelihood of confusion was "particularly compelling."\(^{136}\)

that Westchester published both New POLO Magazine and Polo Player's Edition demonstrates the split of the lifestyle content from the technical polo content. See id. The magistrate judge also found this split to demonstrate intent to profit from the lifestyle image already established by PRL's "Polo" mark. See id. Westchester's alternative explanations for this split were found unconvincing to the magistrate judge. See id.

132. See Westchester Media Co., 103 F. Supp. 2d at 953 (clarifying that competition is not necessary for confusion); Restatement (Third) of Unfair Competition § 21(e), cmt. j (1995) (establishing danger of affiliation or sponsorship confusion increases when junior user's marker is one into which senior user would naturally expand); see also Exxon Corp. v. Tex. Motor Exch., Inc., 628 F.2d 500, 505 (5th Cir. 1980) (stating that "the greater the similarity between products and services, the greater the likelihood of confusion"). But see Elvis Presley Enters., 141 F.3d at 202 (explaining that direct competition between parties' products is not required in order to find likelihood of confusion, but when products or services are non-competing, confusion at issue is one of sponsorship, affiliation or connection).

133. See Westchester Media, 214 F.3d at 667; see also Elvis Presley Enters., 141 F.3d at 202 (explaining "[i]f consumers believe, even though falsely, that the natural tendency of producers of the type for goods marketed by the prior user is to expand into the market of the type of goods marketed by the subsequent user, confusion may be likely." ) (quoting Restatement (Third) of Unfair Competition § 21 cmt. j (1995)).

134. See Westchester Media, 214 F.3d at 666-67. The clear error standard permits the reversal of the district court's holding only if it has a "definite and firm conviction that a mistake has been committed." Id. at 665 (quoting B.H. Bunn Co. v. AAA Replacement Parts Co., 451 F.2d 1254, 1260 (5th Cir. 1971)).

135. See id. at 667-68 (supporting magistrate judge's findings that, inter alia, New POLO Magazine and PRL's products target same consumers and occasionally use same retail outlets). Furthermore, New POLO Magazine's emphasis on fashion, affluent lifestyle and travel can plausibly lead consumers to believe that PRL is associated with the New POLO Magazine. See id.

136. See id. (finding no "definite and firm conviction that a mistake ha[d] been committed," which accords with requirements of B.H. Bunn Co. v. AAA Re-
c. Actual Confusion

Westchester challenged the results of PRL’s survey and argued clear error in the district court’s finding that the 1997 re-launch of New POLO resulted in an increase in incremental confusion.\(^{137}\) Westchester claimed that PRL’s survey was faulty because the survey did not distinguish between actionable confusion produced by the New POLO Magazine and permissible confusion attributable to the Old POLO Magazine.\(^{138}\) Although the Fifth Circuit found that Old POLO Magazine may have been a more effective control than using Polo Player’s Edition, the court also found that Polo Player’s Edition to be “not so different from the Old POLO Magazine as to make it clearly erroneous to rely on PRL’s survey.”\(^{139}\) The court’s concern was the level of actual confusion in the current marketplace as “today’s consumers are exposed to Polo Player’s Edition, not the Old POLO Magazine.”\(^{140}\) Therefore, the Fifth Circuit found that the two magazines define the difference between permissive and actionable confusion.\(^{141}\) Finding no clear error in analyzing the challenged digits of confusion, the Fifth Circuit upheld the magistrate’s finding of a likelihood of confusion between New POLO Magazine and the PRL marks.\(^{142}\)

\(^{137.}\) See id. at 667. Westchester attacks PRL’s survey on the grounds that its control factor was faulty. See Westchester Media Co., 103 F. Supp. 2d at 965-66.

\(^{138.}\) See Westchester Media, 214 F.3d at 667. Westchester argues that the survey should have used the Old POLO Magazine as a control rather than POLO Player’s Edition to effectively isolate the variable at issue, the change in the look of the re-launched magazine, as opposed to the name. See id. In using Polo Player’s Edition as a control however, the name of the magazine was admitted into the survey as another variable, meaning that the one variable at issue, the look of the magazine, could not be isolated. See id. The incremental confusion solely attributable to the magazine’s new look could not therefore be determined, and some of the incremental confusion could have been attributed to the different names, Polo Player’s Edition and POLO. See id.

\(^{139.}\) Id. (explaining that although Old POLO Magazine would have provided for better study control group than Polo Player’s Edition, this did not constitute clear error).

\(^{140.}\) Westchester Media, 214 F.3d at 667.

\(^{141.}\) See id.

\(^{142.}\) See id. “Westchester left unchallenged: the type of mark infringed (strong), the similarity between the two marks, the identity of the retail outlets and purchasers, and the identity of the advertising media used.” Id. at 667 n.6. The district court and Fifth Circuit found the question of whether Westchester’s magazine title is artistically relevant to its content as moot. See id. Although the New POLO contains articles on fashion and travel, it remains the official publication of the USPA and contains articles specifically related to polo, including sections dedicated to tournaments, polo players and personalities. See id. The Fifth Circuit found that Westchester was appealing the district court’s decision because it was not a model
Because the court found support in the record of the magistrate judge’s holding as to the “particularly compelling likelihood of confusion,” Westchester’s only remaining hope would be through a successful defense.\(^\text{143}\)

B. The Federal Trademark Dilution Act

In addition to infringement, PRL declared dilution of its “Polo” mark.\(^\text{144}\) As the Fifth Circuit had not yet addressed the standards governing relief under the FTDA and PRL requested the same relief under both its dilution claims as that ordered in the infringement action, after finding infringement the district court declined to rule on the issue of dilution.\(^\text{145}\) Additionally, finding that PRL’s Texas state law dilution claim was pre-empted by Westchester’s federal registration of its “POLO” mark, the magistrate did not consider the state dilution claim’s merits either.\(^\text{146}\) Since the magistrate’s ruling on PRL’s state law dilution claim was unchallenged by both parties, the ruling was left undisturbed by the Fifth Circuit.\(^\text{147}\) In finding that PRL’s dilution claim under the FTDA could establish another basis for mark holders to seek equitable relief, the court chose to address the dilution issue.\(^\text{148}\)

The Fifth Circuit ruled that in order to prevail on the dilution claim, PRL had to prove that (1) its marks were famous and distinctive; (2) Westchester’s mark was adopted after PRL’s had become famous and distinctive; and (3) Westchester’s use of its “Polo” mark “caused dilution” of PRL’s “Polo” mark.\(^\text{149}\) As the parties did not contest the first two of these issues, their dispute focused upon whether proof of dilution requires a showing of actual or merely of clarity. See id. The district court did recognize, however, that Sugar Busters had “raised the bar” and that “particularly compelling” circumstances did exist. See id. Therefore, Westchester’s argument was based only upon the clarity of the decision, which followed the Sugar Busters standard in substance. See id. at 665.

\(^\text{143}\) See id. at 668. The district court’s finding of a likelihood of confusion was supplemented by evidence of actual confusion, both anecdotal and survey-based, as well as its finding of Westchester’s intent to trade on PRL’s goodwill and reputation. See id. at 666-68.


\(^\text{145}\) See Westchester Media Co., 103 F. Supp. 2d at 980 (noting that decisions in Fifth Circuit addressing claims of dilution avoided analysis of FTDA).

\(^\text{146}\) See Westchester Media, 214 F.3d at 669 n.10.

\(^\text{147}\) See id.

\(^\text{148}\) See id. at 669.

\(^\text{149}\) See id. at 670 (citing 15 U.S.C. § 1125(c)(1), 1127 and Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 170 F.3d 449, 452 (4th Cir. 1999)).
threatened economic harm. Finding that proof of actual harm harmonizes with the plain meaning of the statute, the Fifth Circuit endorsed and adopted that requirement as an issue of first impression. Because PRL made no showing of actual harm, the Fifth Circuit upheld the district court’s position, rejecting PRL’s dilution claim. In doing so, the Fifth Circuit adopted the requirement that plaintiffs prove actual harm in claims under the FTDA. Having discounted the dilution claim, the only remaining issue in this case surrounded the appropriate remedy for Westchester’s trademark infringement.

C. The First Amendment’s Effect on a Remedy

In addressing the inherent First Amendment conflict in this case, the Fifth Circuit pointed out that while “[i]n the usual Lanham Act case, the presence of a likelihood of confusion disposes of the issue of infringement . . . this case [therefore] is not so simple,” even with the “particularly compelling” standard. The Fifth Circuit recognized that in PRL’s attempt to enjoin Westchester’s commercial use of the “POLO” mark, the claim implicated the First Amendment right to choose an appropriate title for literary works. In doing so, the court addressed the clash between the protections afforded by the Lanham Act to trademark owners and the protection afforded by the First Amendment to expressive activity.

150. See id. For the Fifth Circuit, dilution under the FTDA is an issue of first impression. See id. Westchester relies on a Fourth Circuit opinion, Ringling Bros., 170 F.3d at 464, in asserting that the proof of dilution under the FTDA requires proof of “actual, consummated harm.” Id. at 670. Accord Kuester & Nieves, supra note 46, at 247-51 (examining federal trademark infringement cases). PRL contests this assertion with the support of a Second Circuit opinion holding that FTDA requires only proof of a likelihood of dilution. See Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208, 224-25 (2d Cir. 1999) (refusing to limit application of statute to dilution that has already occurred).

151. See Westchester Media, 214 F.3d at 670 (explaining that there is key difference between state anti-dilution statutes that formed backdrop for FTDA and FTDA itself because state statutes require likelihood of confusion and federal statute requires proof); see also Klieger, supra note 69 at 840 (explaining that FTDA replaces language requiring likelihood of confusion with actual dilution requirement).

152. See Westchester Media, 214 F.3d at 671.

153. See id.

154. Id. at 664.

155. See id.

156. See id. (noting Sugar Busters LLC v. Brennan, 177 F.3d 258, 269 n.7 (5th Cir. 1999) (explaining First Amendment interest in choosing appropriate book title)); Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd., 996 F.2d 1366, 1379 (2d Cir. 1993) (“the finding of likelihood of confusion must be particularly compelling”).
Agreeing that titles combine both artistic expression and commercial promotion, the Fifth Circuit found that titles require greater First Amendment protection than the labeling of ordinary commercial products.157 As such, courts must balance the need for injunctive relief with the need to protect free expressive speech.158 In determining a proper remedy in light of such First Amendment considerations, courts apply the ‘least restrictive alternative’ rule and order the narrowest appropriate remedy.159 When a First Amendment issue is at stake, courts construe the Lanham Act narrowly while also recognizing that the First Amendment does not give one license to “infringe on the rights” of others.160

In considering the district court’s broad injunction, ordering Westchester to cease publication of New POLO Magazine under the name “POLO,” the Fifth Circuit found that the lower court improperly disregarded Westchester’s First Amendment interests.161 Consequently, the Fifth Circuit rejected the district court’s finding that PRL’s rights need not yield to First Amendment concerns because Westchester had alternative avenues of communication available.162 The “other avenue” was for Westchester to publish its


158. *See McCarthy*, *supra* note 44 at 27:69 (explaining need to consider First Amendment in determining most appropriate remedy).

159. *See Westchester Media*, 214 F.3d at 664. *See also* In *Re R.M.J.*, 455 U.S. 191, 203 (1982) (“Misleading advertising may be prohibited entirely. But the States may not place an absolute prohibition on certain types of potentially misleading information . . . if the information also may be presented in a way that is not deceptive . . . restrictions upon such advertising may be no broader than reasonably necessary to prevent the deception.”); *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 566 (1980) (holding that in commercial speech context, First Amendment mandates that speech constraints remain as narrow as possible and not completely suppress information when narrower restrictions on expression would serve a legitimate interest as well).

160. *See Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) (holding trial court’s issuance of injunction prohibiting designer from using insurance company’s trademarks as logos or to market, advertise or identify his products did not violate designer’s First Amendment rights, where other avenues to express his views existed and were unrestricted by injunction).

161. *See Pebble Beach Co. v. Tour 18 I, Ltd.*, 155 F.3d 526, 550 (5th Cir. 1998). In reviewing injunctive relief in trademark cases, the Fifth Circuit applied the abuse of discretion standard. *See id.*

162. *See Westchester Media*, 214 F.3d at 664. The Fifth Circuit precedent holds that, just like injunction relief generally, an equitable remedy for trademark infringement should be no broader than necessary to prevent the deception. *See Peaches Entm’t Corp. v. Entm’t Repertoire Assocs., Inc.*, 62 F.3d 690, 693 (5th Cir. 1995) (holding that abuse of discretion automatically inheres in injunctive decree if trial court misinterpreted applicable law); *Soltex Polymer Corp. v. Fortex Indus., Inc.*, 832 F.2d 1274, 1329 (2d Cir. 1987) (holding that equitable remedy for trademark infringement should be no broader than necessary to prevent deception). The magistrate judge, therefore, too hastily followed the case of Reddy Communi-
magazine under another title.\textsuperscript{163} The Fifth Circuit found this avenue too harsh since the district court failed to exhaustively consider all other possible remedies.\textsuperscript{164} In failing to explore all possible remedies, the district court improperly labeled Westchester’s title as “commercial speech.”\textsuperscript{165} On the contrary, the Fifth Circuit recognized that a magazine title is a hybrid between commercial and artistic speech.\textsuperscript{166}

Because the Fifth Circuit found Westchester’s infringing speech to be at least partly literary or artistic, and not simply a commercial use of PRL’s mark, the court needed to eliminate the likelihood of confusion, while accommodating Westchester’s First Amendment interests.\textsuperscript{167} In doing so, the court noted that disclaimers have served to satisfy that purpose in similar situations.\textsuperscript{168} The court explained that “[l]ike fraudulent speech, speech that

cations, Inc. v. Env’t Action Found., Inc., 199 U.S.P.Q. 630, 634 (D.D.C. 1977), and dismissed Westchester’s First Amendment concerns in concluding that the rights of a trademark owner need not yield to First Amendment concerns “where a defendant has alternative avenues of communication available.” Westchester Media, 214 F.3d at 671 (quoting Westchester Media Co., v. PRL USA Holdings, Inc., 103 F. Supp. 2d 935, 990 (S.D. Tex. 1999)) (citing Reddy Communications, 199 U.S.P.Q. 630, 634 (D.D.C. 1977)). Here, Westchester’s alternative avenue is to publish the lifestyle magazine under any title other than POLO. See id. The Fifth Circuit rejected the Reddy Communications approach and held that even where trademark infringement has been found, First Amendment interests should influence the choice of remedy. See id. at 672 (citing L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26 (1st Cir. 1987) (recognizing importance of First Amendment in fashioning appropriate remedy for infringement)).

163. See Westchester Media, 214 F.3d at 671-72. (citing Westchester Media Co., 103 F. Supp. 2d at 990) (following, Reddy Communications, Inc., 199 U.S.P.Q. 630, 634 (holding that First Amendment rights do not give license to infringe upon others’ trademark rights); Mutual of Omaha Ins. Co., 836 F.2d at 402 (“the First Amendment does not give [one party] license to infringe the rights of [another party]”); and Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc., 600 F.2d 1184, 1188 (5th Cir. 1979) (“The first amendment is not a license to trammel on legally recognized rights in intellectual property.”)).


165. See id. at 672 (citing Westchester Media Co., 103 F. Supp. 2d at 989). By labeling the magazine title as commercial speech, the district court provided less First Amendment protection than afforded to artistic speech. See id.

166. See id. (citing Rogers v. Grimaldi, 875 F.2d 994, 998 (2d Cir. 1989), holding that speech contained in magazine is more expressive than ordinary commercial speech; therefore, requires more protection than labeling of typical commercial products).

167. See id.

168. See id. at 672 (noting that disclaimers had been used in Better Bus. Bureau, 681 F.2d at 405; Consumers Union, Inc. v. Gen. Signal Corp., 724 F.2d 1044, 1053 (2d Cir. 1983); Twin Peaks Prods., 996 F.2d at 1379 (2d Cir. 1993); and even in district court’s preliminary injunction).
misleads or creates confusion is not protected under the First Amendment.”169 Because the infringing speech was found to be at least partly literary or artistic, not solely a commercial appropriation of PRL’s mark, the Fifth Circuit decided to consider the use of a disclaimer as a possible trademark remedy.170 The Fifth Circuit concluded its analysis with a four-fold explanation for favoring a disclaimer over the broad injunction imposed by the district court.171

The first reason why a disclaimer might provide a more appropriate remedy stems from the “undisputed [fact] that Westchester has the right to publish some magazine under the title POLO.”172 Recognizing this, the Fifth Circuit found the district court’s remedial injunction, prohibiting the New POLO Magazine to focus on fashion and lifestyles, as being potentially effective.173 At the same time, imposing editorial constrictions upon the New POLO Magazine would pose a constant threat that one other than Westchester would regulate the “speech content of Westchester’s magazine.

169. Westchester Media, 214 F.3d at 672 (citing Better Bus. Bureau, 681 F.2d at 404). On this basis, the court explained that because the purpose of a remedy for trademark infringement is to eliminate the likelihood of confusion between the holder of the mark and the imposter, the remedy could, in some cases, require suppression of otherwise constitutionally protected speech. See id.; see also Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1399-1400 (9th Cir. 1997) (enjoining production of parody of Dr. Seuss’ “The Cat in the Hat”); Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 206 (2d Cir. 1979) (holding that First Amendment rights were not encroached upon because numerous ways to comment without infringing trademark existed).

170. See Westchester Media, 214 F.3d at 672. The court noted that it and others have frequently approved disclaimers when trademark and First Amendment interests overlap. See id. See, e.g., Better Bus. Bureau, 681 F.2d at 404 (noting that trademark infringement remedies cannot restrain dissemination of accurate, factual information); Consumers Union, Inc. v. Gen. Signal Corp., 724 F.2d 1044, 1053 (2d Cir. 1983) (preferring disclaimers over total prohibitions); Twin Peaks Prods., Inc., 996 F.2d at 1379 (remanding to determine if there is any possibility disclaimer will suffice). The court stressed that courts in trademark cases have a responsibility to tailor the relief to the violation and this responsibility includes the consideration of disclaimers. See Westchester Media, 214 F.3d at 672. Courts disallowing disclaimers have done so only after a fact specific conclusion that they would be ineffective. See id. at 672 n.19. See, e.g., Boston Prof’l Hockey Ass’n, Inc. v. Dallas Cap & Emblem Mfg., Inc., 510 F.2d 1004, 1013 (5th Cir. 1975) (“Only a prohibition of the unauthorized will sufficiently remedy the wrong.”). Courts have not defeated the use of disclaimers where they would be effective to accommodate conflicting legal principles. See, e.g., Playboy Enters., Inc. v. Chuckleberry Publ’g, Inc., 687 F.2d 563, 571 (2d Cir. 1982) (disallowing disclaimer only after exhaustive analysis of other remedies that would more sufficiently accommodate applicable First Amendment interests).

171. See Westchester Media, 214 F.3d at 673-74.

172. Id. at 673 (noting that Westchester bought Fleet Street’s rights to incontestable mark).

173. See id.
which is not permissible under the First Amendment.”

In other words, “[t]he content-based impact of [that] injunction could extend beyond the title of Westchester’s magazine, posing special First Amendment concerns.”

The second reason why the Fifth Circuit favored a disclaimer is that PRL was essentially claiming the right to dictate the use of the “Polo” mark by the publisher of the USPA’s official magazine.

The Fifth Circuit explained that PRL became famous through associating itself with the sport of polo and now asserts that it has rights to the name that extend beyond those of the sport. The court found that this result would be unjust.

Third, the Fifth Circuit favored disclaimer relief because after the district court’s preliminary injunction requiring a disclaimer, consumer confusion was no longer apparent. Finally, the court favored a disclaimer because both PRL’s products and Westchester’s magazine catered to relatively sophisticated consumers. Such consumers, as a class, are considered to be more likely to notice, read and understand the written disclaimer’s significance.

174. Westchester Media Co. v. PRL USA Holdings, Inc., 103 F. Supp. 2d 935, 989 (S.D. Tex. 1999) (citing Docket Entry # 188, at 4). But see Centaur Communications, Ltd. v. A/S/M Communications, Inc., 830 F.2d 1217, 1229-30 (2d Cir. 1987) (affirming injunctive relief for infringing trademark in title of publication); Am. Ass’n for Advancement of Sci. v. Hearst Corp., 498 F. Supp. 244, 264-65 (D.D.C. 1980) (demonstrating that while order to cease publication under particular name is rare circumstance, it has been held best course of action when there is no adequate remedy at law). For discussions of First Amendment concerns, see Sugar Busters L.L.C. v. Brennan, 177 F.3d 258, 269 n.7 (5th Cir. 1999) (noting First Amendment interest in choosing appropriate book title); Twin Peaks Prods., Inc., 996 F.2d at 1379 (2d Cir. 1993) (requiring “particularly compelling” likelihood of confusion before First Amendment interests will be overcome).

175. See id. at 673.

176. See id.

177. The Fifth Circuit found:

PRL products became famous by basking in the reflected glow of an elegant sport. PRL now asserts that it, not the sport, is the source of that glow. While PRL’s primary claim is the essence of the ordinary trademark case, we cannot be blind, when balancing the equities, to the fact that PRL is arrogating the very name of a sport from the players’ publication. In a sense, PRL is biting the hand that fed it.

178. See id. The magistrate judge speculated that the absence of confusion was due to publicity surrounding the present case rather than disclaimers. See id. However, PRL provided no evidence of actual confusion. See id. The Fifth Circuit found that on remand, both parties would have the opportunity to establish the presence or absence of confusion. See id.

179. See id. at 674 (citing Soltex Polymer Corp. v. Fortex Indus., Inc., 832 F.2d 1325, 1380 (2d Cir. 1987), which explained presence of sophisticated consumers weighs in favor of disclaimer relief).

180. See Westchester Media, 214 F.3d at 674 (citing Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C., 212 F.3d 157, 168-69 (3d Cir. 2000) reason-
The Fifth Circuit, therefore, affirmed the district court on the issue of liability but vacated and remanded the case for determination of whether a disclaimer would afford a more appropriate remedy.\(^{181}\)

### D. Westchester’s Defenses

Westchester based its defenses on theories of laches, acquiescence and the incontestability of its trademark.\(^{182}\)

1. **Laches**

   The defense of laches is defined as “an inexcusable delay that results in prejudice to the defendant.”\(^{183}\) Laches contains three elements: “(1) delay in asserting one’s trademark rights, (2) lack of excuse for the delay, and (3) undue prejudice to the alleged infringer caused by the delay.”\(^{184}\) Westchester challenged the trial court’s finding that none of these elements were established.\(^{185}\) The Fifth Circuit upheld the magistrate’s finding that no delay existed because Ralph Lauren had no complaints with the Old POLO Magazine.\(^{186}\) PRL claimed the New POLO Magazine was “an entirely new product and different from the Old POLO Magazine in most respects.”\(^{187}\) The Fifth Circuit also found that the four months, which elapsed between the June meeting and PRL’s registered objections in its cease and desist letter, were not an unreasonable amount of time in which to assert PRL’s rights.\(^{188}\) Finally, the

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\(^{181}\) See id.

\(^{182}\) For a complete discussion of Westchester’s defense of laches, see infra notes 183-89. For a complete discussion of Westchester’s defense of acquiescence, see infra notes 190-93. For a complete discussion of Westchester’s defense of trademark incontestability, see infra notes 194-99.

\(^{183}\) See Westchester Media, 214 F.3d at 668. See also Exxon Corp. v. Oxxford Clothes, Inc., 109 F.3d 1070, 1082 (5th Cir. 1997) (citing Rogers v. Ricane Enters., Inc., 772 S.W.2d 76, 80 (Tex. 1989)). See also Conan Props., Inc. v. Conan’s Pizza, Inc., 752 F.2d 145, 153 (5th Cir. 1985) (discussing application of laches and acquiescence in one locale to another locale); Armco, Inc. v. Armco Burglar Alarm Co., 693 F.2d 1155, 1161 (5th Cir. 1982) (describing analysis as factual calculation for trial court); Envt’l Def. Fund, Inc. v. Alexander, 614 F.2d 474, 478 (5th Cir. 1980) (outlining criteria for defense of laches).

\(^{184}\) See Westchester Media, 214 F.3d at 668 (citing Elvis Presley Enters., Inc. v. Capece, 141 F.3d 188, 205 (5th Cir. 1998)).


\(^{186}\) See Westchester Media, 214 F.3d at 668.

\(^{187}\) Id.

\(^{188}\) See id.
court did not find that this delay prejudiced Westchester in any way.189

2. Acquiescence

Westchester asserted acquiescence based on PRL’s failure to object to the re-launch efforts at the June 1997 meeting.190 Westchester claimed that PRL’s response constituted an implicit assurance and as such, justifiably induced reliance.191 The Fifth Circuit, however, found Westchester’s acquiescence contention unpersuasive because Westchester had not raised a challenge to the trial court’s finding that it misled PRL’s representative about the extent of the new venture.192 Having found that Westchester misled PRL, any assurance by PRL would not be legally actionable.193

3. Incontestability

The Fifth Circuit found Westchester’s assertion that § 33(b) of the Lanham Act makes its registration for the mark “POLO” on or in connection with its “magazine on the subject of equestrian sports and lifestyles” to be presumptuous.194 Specifically, the court found that Westchester assumed that the purchased registration would cover both the Old and New POLO Magazine.195 Although 15 U.S.C. § 1115(b) provides that a mark becomes incontestable through five years of continuous use following federal registration

189. See id. at 668 n.7. With regard to the magistrate’s finding of no undue prejudice in light of Westchester’s losses, amounting to $1.3 million, the Fifth Circuit found that PRL cannot be held responsible for Westchester’s investment prior to learning about the planned launch of the New POLO Magazine. See id. Furthermore, any such investment made following PRL’s objection was made at Westchester’s own risk. See id. Similarly, in Elvis Presley Enters. v. Capece, 141 F.3d 188 (5th Cir. 1998), the court remarked that “[a]ny acts after receiving a cease and desist letter are at the defendant’s own risk because it is on notice of the plaintiff’s objection to such acts.” Elvis Presley Enters., 141 F.3d at 198.

190. See Westchester Media Co., 103 F. Supp. 2d at 998-99, (referring to June 23, 1997 meeting between Westchester’s Reid Slaughter with PRL advertising executive, Elizabeth Morris).

191. See Westchester Media, 214 F.3d at 668 (citing Conan Properties, Inc. v. Conon’s Pizza, Inc., 752 F.2d 145, 153 (5th Cir. 1985).

192. See id.

193. See id. at 668. See also Westchester Media Co., 103 F. Supp. 2d at 998-99 (finding that Elizabeth Morris was misled as to extent of project).

194. See Westchester Media, 214 F.3d at 669 (explaining that Westchester’s incontestability argument presupposes that official PTO registration, purchased from Fleet Street, similarly covers both Old and New POLO Magazine).

195. See id. at 669. Section 33(b) of the Lanham Act provides that an incontestable registration is conclusive evidence of the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 15. See id.
and statutory compliance, the court found the issue unnecessary to address. In relying on the factual finding that the Old POLO Magazine and New POLO Magazine are different products, the court rejected Westchester's incontestability argument. Consequently, the statutory minimum of five years required to establish incontestability had not been satisfied. The Fifth Circuit noted, therefore, that the incontestability of the mark as applied to Old POLO Magazine did not shield New POLO Magazine from attack as "[t]he incontestable 'Polo' mark was used to title a magazine about the sport of polo, and cannot be transferred to a fundamentally different magazine."

V. CRITICAL ANALYSIS

In Westchester Media v. PRL USA Holdings, Inc., the Fifth Circuit affirmed the district court's holding that Westchester Media infringed upon PRL's trademark rights. At the same time, the court recognized that Westchester, as the publisher of the USPA's official magazine, had a right to publish a magazine entitled "POLO." Consequently, the court affirmed the district court's finding that Westchester infringed upon PRL's trademark. At the same time however, the Fifth Circuit also found that issuing a broad injunction, requiring Westchester to focus the magazine on the sport as in Polo Player's Edition, was too great a penalty. The court therefore, remanded the case for a determination of whether a disclaimer, disavowing any affiliation between "POLO" Magazine

196. See id. Because the district court found that the Old "POLO" Magazine and the New "POLO" were essentially different, the incontestable registration did not apply to the New "POLO" Magazine. See id.

197. See id. (noting that while both magazines fit literal description of registered mark, applying § 1115 of Lanham Act would ignore district court's finding that two magazines are not same product). "A federal registration does not create the trademark; the trademark is acquired by use." Id. (citing 3 McCarthy, supra note 44, at § 19:3 and Volkswagenwerk Aktiengesellschaft v. Wheeler, 814 F.2d 812, 819 (1st Cir. 1987)).

198. See id. Westchester argued that New POLO, like its predecessor, satisfies the description of a "magazine on the subject of equestrian sports and lifestyles." Id. However, such an application of § 1115 ignores the magistrate's finding that the two magazines are different products. See id.

199. Westchester Media, 214 F.3d at 669.
200. Id. at 660.
201. See id. (recognizing Westchester's incontestable registration of "POLO" mark). For additional background concerning the ramifications of a mark's incontestability and its significance in this case, see supra notes 15, 106, 109, 169, 193 and accompanying text.
202. See Westchester Media, 214 F.3d at 660.
203. See id. (finding that such restriction was not narrowest restriction upon Westchester's First Amendment right).
and PRL, would serve as a more appropriate remedy. In so doing, the court recognized PRL’s right to the “POLO” mark in the fashion and lifestyles industry, while also recognizing Westchester’s right to appropriately title its literary works and control the magazine’s substance. The Fifth Circuit decided the case appropriately.

The court properly found that the likelihood of confusion between Westchester’s New POLO Magazine and PRL’s “POLO” mark was “particularly compelling.” Just as the district court found a likelihood of confusion, the Fifth Circuit determined that the findings similarly supported a “particularly compelling” likelihood of confusion. The “particularly compelling” standard, as derived from Rogers and adopted in Sugar Busters, recognizes that “[l]iterary titles do not violate the Lanham Act ‘unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.’”

In assessing whether the “particularly compelling” standard had been satisfied, the Fifth Circuit considered the district court’s application of the digits of confusion. The district court found a particularly compelling likelihood of confusion. Absent clear error, in light of the inapplicability of Westchester’s two affirmative defenses, the finding of infringement was proper.

In considering the issue of dilution under the FTDA, the Fifth Circuit held, as an issue of first impression, that a violation of the

204. See id.
205. See id.
206. See Sugar Busters L.L.C. v. Brennan, 177 F.3d 258, 269 n.7 (5th Cir. 1999) (holding that any finding that defendants’ book title is likely to cause confusion with plaintiff’s book title must be “particularly compelling” to outweigh defendants’ First Amendment interest in choosing appropriate book title for their work) (citing Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd., 996 F.2d 1366, 1379 (2d Cir. 1993)).
208. For a discussion of Rogers v. Grimaldi, see supra notes 92-97 and accompanying text.
209. For a discussion of Sugar Busters v. Brennan, see supra notes 100, 120, 125-28 and accompanying text.
210. Westchester Media, 214 F.3d at 664 (citing Twin Peaks Prods., 996 F.2d at 1379, which quoted Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989) (internal quotations omitted).
211. See Twin Peaks Prods., Inc., 996 F.2d at 1379 (explaining Second Circuit’s need for district court to apply Polaroid digits of confusion to determine whether likelihood of confusion was so great as to overcome presumption established in Rogers, 875 F.2d at 999).
212. See Westchester Media Co., 103 F. Supp. 2d at 991.
FTDA requires proof of actual harm, not merely a "likelihood of dilution." As the FTDA prohibits any commercial use of a famous mark that "causes dilution," rather than prohibiting a "likelihood of dilution," this standard best accords with the plain meaning of the statute. The Fifth Circuit therefore was correct in adopting the requirement that plaintiffs prove actual consummated harm to establish liability under the FTDA.

Finally, the Fifth Circuit properly intervened in vacating the district court's finding that the magazine's title was mere commercial speech and finding that the district court's issuance of a broad injunction as infringement upon Westchester's substantive editorial rights. The district court's injunction would have created a governmental editorialship that regulated the speech content of Westchester's magazine. Forcing the New POLO Magazine to limit its content to that of Polo Player's Edition, would require constant supervision of the amount of lifestyle content it provides. Such supervision is impermissible according to the First Amendment.

213. See Westchester Media, 214 F.3d at 669-71. In doing so, the court explicitly adopted the standard set forth in Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 170 F.3d 449, 458-59 (4th Cir. 1999), which required a finding of actual harm, and rejected the test announced in Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208 (2d Cir. 1999), which required only a likelihood of confusion. See Westchester Media, 214 F.3d at 670-71.


215. See Westchester Media, 214 F.3d at 669-71 (citing Ringling Bros., 170 F.3d at 452, which noted that FTDA's legislative history indicates congressional understanding that dilution results from actual dilution); see also Playboy Enters., Inc. v. Netscape Communications, Corp., 55 F. Supp. 2d 1070, 1088 n.22 (C.D. Cal. 1999) ("The Act requires dilution; there is no remedy for 'likelihood of dilution.'"); Am. Cyanamid Co. v. Nutraceutical Corp., 54 F. Supp. 2d 379, 390-92 (D.N.J. 1999) (requiring actual dilution).

216. See U.S. CONST. amend. I. The First Amendment states: "Congress shall make no law ... abridging the freedom of speech, or of the press." Id. In addition, the Supreme Court has consistently held that the First Amendment prohibits government action that unduly restricts freedom of expression. See supra note 75 and accompanying text. By restricting the expression contained in Westchester's magazine, its expression would have been unjustly suppressed. See Gitlow v. New York, 268 U.S. 652, 666 (1925) (describing when First Amendment rights may be suppressed by the government).

217. See Westchester Media, 214 F.3d at 662. This produces an unnecessary "gray area" as to how much lifestyle content is allowed, especially as the Old POLO Magazine included expanded lifestyle content since 1987. See id. If a disclaimer, adequately disavowing any affiliation with POLO Magazine, could prevent such a "gray area" and prevent an unnecessarily broad penalty, it could be a far more appropriate remedy. See id.
An injunction for trademark infringement may be no broader than necessary to prevent the deception of consumers.\textsuperscript{218} Because PRL’s and Westchester’s consumers are assumed to understand a disclaimer’s message, the Fifth Circuit was correct in holding that a disclaimer could be a more appropriate remedy and remanding the case for a factual finding in support. In so doing, the Fifth Circuit prevented PRL from policing the right to use the word “POLO” as against the USPA’s official magazine.

VI. IMPACT

\textit{Westchester Media v. PRL USA Holdings} dealt with an interesting conflict between the PRL’s rights to use the name “POLO,” as a designer who has successfully established the name in the fashion industry, and Westchester’s right to use the same name for “a magazine of equestrian sports and lifestyles.”\textsuperscript{219} Although it has done little to establish new law in the areas of Lanham Act trademark infringement and First Amendment jurisprudence, it has clearly demonstrated an incorporation of the legal frameworks of Rogers,\textsuperscript{220} and \textit{Sugar Busters}\textsuperscript{221} and demonstrated the merits of disclaimer relief when First Amendment rights and consumer confusion may clash.

\textit{Westchester Media} has developed new trademark law in the Fifth Circuit by clarifying the standard required to establish a case under the FTDA.\textsuperscript{222} Prior to this case, decisions in the Fifth Circuit had avoided deciding whether a likelihood of confusion or evidence of actual consummated harm is required under an FTDA claim.\textsuperscript{223}

\begin{footnotesize}
\begin{enumerate}
\item \textsuperscript{218} See Better Bus. Bureau of Metro. Houston, Inc. v. Med. Dirs., Inc., 681 F.2d 397, 405 (5th Cir. 1982) (holding preliminary injunction absolutely prohibiting medical center from making further references to Bureau in their ads was overbroad and would be narrowed to require only that references to Bureau contain prominent disclaimer of Bureau’s endorsement of program).
\item \textsuperscript{219} \textit{Westchester Media}, 214 F.3d at 661. For the details of Westchester’s “POLO” registration, see \textit{supra} notes 19, 24 and accompanying text.
\item \textsuperscript{220} For a discussion of \textit{Rogers v. Grimaldi}, see \textit{supra} notes 92-97 and accompanying text.
\item \textsuperscript{221} For a discussion of \textit{Sugar Busters L.L.C. v. Brennan}, see \textit{supra} notes 100, 120, 125-28 and accompanying text.
\item \textsuperscript{222} For a discussion of the Fifth Circuit’s decision on the requirements of the FTDA, see \textit{supra} notes 144-52 and accompanying text.
\item \textsuperscript{223} See Westchester Media Co. v. PRL USA Holdings, Inc., 103 F. Supp. 2d 935, 978-81 (S.D. Tex. 1999) (noting that it need not address FTDA requirement); see also Sunbeam Prods., Inc. v. West Bend Co., 123 F.3d 246, 261 n.28 (5th Cir. 1997) (declining to rule on FTDA claim); Elvis Presley Enters., Inc. v. Capece, 950 F. Supp. 783, 797 (S.D. Tex. 1996) (using New York’s anti-dilution statute as guide to interpreting FTDA).
\end{enumerate}
\end{footnotesize}
This case affirms the plain meaning of the statute by requiring plaintiffs to prove actual consummated harm.

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