16-0241-cv

United States Court of Appeals
for the
Second Circuit

LOUIS VUITTON MALLETIER, S.A.,

Plaintiff-Appellant,

– v. –

MY OTHER BAG, INC.,

Defendant-Appellee.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

BRIEF OF AMICUS CURIAE LAW PROFESSORS IN SUPPORT OF DEFENDANT-APPELLEE

Christopher Jon Sprigman
Professor of Law
New York University School of Law
Co-Director, Engelberg Center on
Innovation Law and Policy
40 Washington Square South
New York, NY 10012
(212) 992-8162

Rebecca Tushnet Inn
Professor of Law
Georgetown University Law Center
600 New Jersey Avenue, NW
Washington, DC 20001
(703) 593-6759
Counsel for Amici Curiae

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INTEREST OF AMICI CURIAE

Amici, listed in Appendix A, are professors of law who research, write, and teach in the area of trademark, copyright, and related fields.[1] Amici's institutional affiliations are provided for identification purposes only, and imply no institutional endorsement of the views expressed herein. Amici have no personal stake in the outcome of this case. Counsel for all parties have consented to the filing of this brief.

SUMMARY OF ARGUMENT

Overextension of trademark and copyright poses grave risks for freedom of expression. The district court properly recognized that both trademark and copyright law give wide scope to criticism and parody, in order to avoid chilling protected expression. In addition, the district court understood that in trademark analysis, parody has the effect of making many of the usual *Polaroid* likelihood of confusion factors weigh in a defendant's favor. Furthermore, application of

[1] Pursuant to Fed. R. App. P. 29(c)(5) and Local Rule 29.1(b) of the United States Court of Appeals for the Second Circuit, amici hereby certify that no party's counsel authored this brief in whole or in part; no party or party's counsel contributed money intended to fund preparing or submitting the brief; and no person other than amici contributed money intended to fund preparing or submitting the brief.

dilution law to Appellee MOB's use would be an unconstitutional content-based regulation. Louis Vuitton (LV) also brought a makeweight copyright claim, and the district court properly rejected it for the same reasons as it rejected LV's trademark claims.

ARGUMENT

Louis Vuitton routinely threatens those who comment on its marks, both in the United States and elsewhere, contrary to basic principles of freedom of expression. *See, e.g.*, Nadia Plesner, Simple Living & Darfurnica, Plesner, http://www.nadiaplesner.com/simple-living--darfurnica1 (discussing LV's legal actions against artist's critical depictions of a Louis Vuitton handbag); Letter from Robert F. Firestone, Assoc. Gen. Counsel, University of Pennsylvania Law School, to Michael Pantalony, Dir. of Civil Enforcement, Louis Vuitton Malletier (Mar. 2, 2012), available at https://www.law.upenn.edu/fac/pwagner/DropBox/penn_ogc_letter.pdf (discussing legal threats against the University of Pennsylvania Law School based on poster advertising a conference about fashion law using an obvious parody of LV's mark). As the district court persuasively explained, neither trademark nor copyright should be extended to assist LV in this speech-suppressing mission.

I. The Value of MOB's Parody Outweighs Any Risk of Confusion

"Competition is deterred … not merely by successful suit but by the plausible threat of successful suit…." Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 214 (2000). The chilling effect of plausible threats of litigation exists for commentary as well. And in the case of commentary, the First Amendment interests of MOB and its consumers in expressing themselves are at their apogee, and are substantial enough to outweigh any slight risk of confusion that MOB's parody might create.

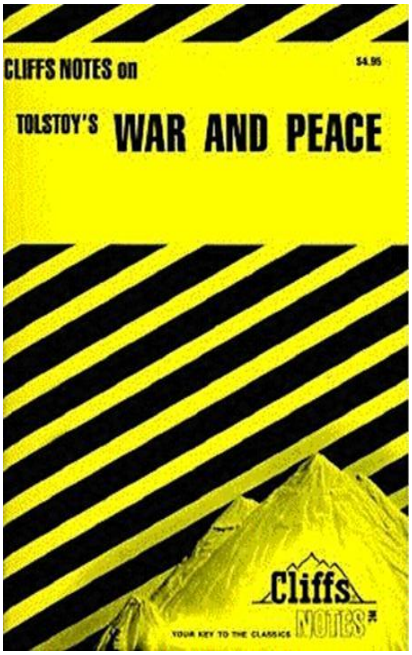
A. MOB's Commentary Is Readily Understood by Consumers to be Parody and Serves First Amendment Values

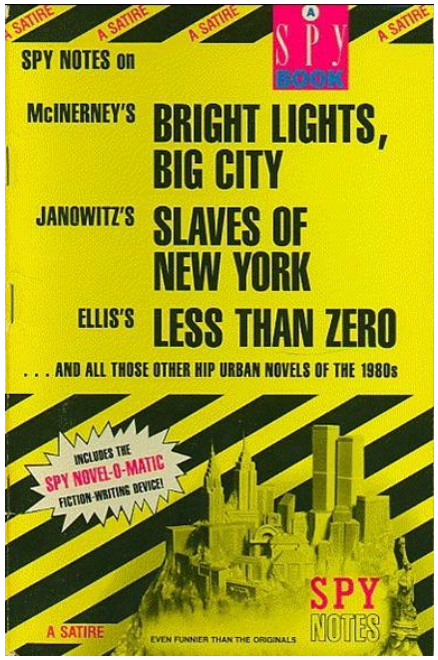
LV claims that, for trademark purposes, there is no difference between a designer handbag and a canvas tote bearing a cartoon of a designer handbag. LV asks the court to fall victim to what René Magritte famously labeled "The Treachery of Images":

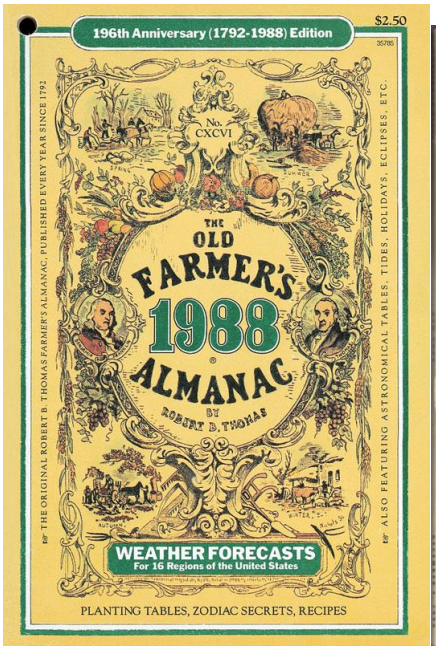
The words of the painting force us to reconsider the relation between image and reality. Analogously, the words on a MOB bag ("My Other Bag …") and the fact that the image on the surface of the MOB bag opposite the words is a cartoon, rather than a photorealistic image of the LV bag or a facsimile of the LV pattern directly applied to every surface of the tote, create palpable incongruities that lead any reasonably percipient consumer to see the joke. The MOB bags are commenting humorously on society's obsession with owning status symbols, and with showing them off. The commentary is even more intelligible at actual size, although it is apparent in these shrunken-down pictures as well:

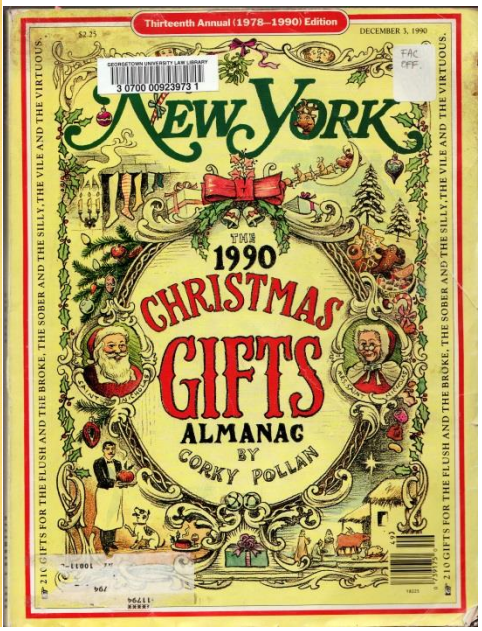

MQB
Choreography by ANDY BLANKENBUEHLER
Directed by THOMAS KAIL
RODGERS THEATRE • 226 WEST 46TH STREET

By way of comparison, here are contrasting images from previous cases in which defendants' commentary was held to vitiate any likelihood of confusion, also reduced in size:









If anything, the commentary in the MOB parody is easier to understand. As the district court had no trouble recognizing, MOB's parody is a simple play on "my other car is an X" – a comedic trope that many people have seen on a bumper sticker on an old car. This trope is so well known that it has its own entry on the

trope-tracking website TVTropes, http://tvtropes.org/pmwiki/pmwiki.php/Main/MyOtherCarIsAnX. A number of the examples involve more extended variants, like the one involved here, with the form "my other X is a Y."[2] This is a joke about the owner's cultural commitments, whether those involve aspirations to fancy or fuel-saving cars, to high fashion, or to geekery.[3] "My Other Bag …" is just another easily recognized variant.[4] As one fashion website noted in reference to a different product using the same idea, "What could possibly say 'fashion rebel' more succinctly than an oh-so-chic and on-trend white my other bag is Chanel? … [The bag] is not only fashionable and

[2] This expansion of a linguistic trope is known as a "snowclone." Tom Hawking, Why "The New Black" Is More Irritating Than the Average Cliché, Flavorwire, Aug. 8, 2013, http://flavorwire.com/408707/why-the-new-black-is-more-irritating-than-the-average-cliche ("[I]t's a special sort of cliché, one of sentence construction rather than just vocabulary. You tend to see a lot of these around in 2013: 'My other X is a Y,' 'have X will travel,' 'X Y is X.' There's even a word for these clichés — they're called snowclones, a neologism coined in 2004 by linguist Geoffrey Pullum.").

[3] To really kill the joke, an extended explanation is available at 80: My Other Car, ExplainXKCD.com, https://www.explainxkcd.com/wiki/index.php/80:_My_Other_Car.

[4] Designer Jessica Kagan Cushman previously did the same thing; these bags are still available in the aftermarket, as are similar bags from BagLadies.com. *See, e.g.*, http://www.polyvore.com/cabas_jessica_kagan_cushman_my/thing?id=26874543, http://www.bagladies.com.au/shop/all-bags/my-other-bags-are-pradatote/. A Jack Spade designer bag bears the joke "My Other Bag is Your Mom." Jian DeLeon, Jack Spade Tote Bag Makes Fun Of Your Mom, , http://www.complex.com/style/2012/06/jack-spade-tote-bag-makes-fun-of-your-mom.

practical, it is the ideal bag for those of us who love fashion and style, but also do not mind poking fun at ourselves from time to time."[5]

Stacey Dogan and Mark Lemley have explained the special importance of brand parodies in more general terms. Putting the parody front and center offers

> a valuable form of social commentary. Even more than non-commercial forms of parody, the subversive use of a parody as brand invites critical reflection on the role of brands in society and the extent to which we define ourselves by them. Brands that parody, in other words, offer a unique platform for expression and pose little threat to trademark law's core values….
>
> Many—perhaps most—branding parodies have a doubly subversive message. They are using a brand not only to lampoon the targeted brand, but also to call attention to the pervasiveness of branding in our society. Parodies, in general, replicate the central features of a particular work to "reference and ridicule" the work. Brand parodies do more: they not only borrow from the trademark itself, but they also appropriate the device of branding and employ it to make us think critically about the role of brands in our culture. The dog chew toy in Louis Vuitton, for example, "pokes fun at the elegance and expensiveness of a LOUIS VUITTON handbag" but also "irreverently presents haute couture as an object for casual canine destruction."…
>
> Traditional trademarks serve as the source of goods and therefore protect the customer from fake goods. By contrast, Nike swooshes, red shoe bottoms, and Chanel purse logos are not really about ensuring purchasers make the right decision, but about allowing purchasers to tell the rest of the world about that decision. … Brands, then, don't just help trademark owners speak; they help all of us speak. And that speech is so common that refusing to wear brand names is itself a recognized counter-cultural statement.
>
> … Given the prevalence of branding and its economic and social impact, commentary about both brands and branding is a matter of public concern.

[5] White My Other Bag Is Chanel, http://wheretoget.it/explore/white-my-other-bag-is-chanel (last visited July 5, 2016).

> … Just as prestige brands confer value to consumers who want to project an image of exclusivity, so brand parodies bring utility to consumers seeking to project a more rebellious or sardonic message. … [I]f brands are part of a conversation between consumers, not just with trademark owners, brand parodies allow others to participate in that conversation with a different, unapproved message. In so doing, it helps us define ourselves. As Salman Rushdie put it, "[t]hose who do not have power over the story that dominates their lives, power to retell it, rethink it, deconstruct it, joke about it, and change it as times change, truly are powerless, because they cannot think new thoughts."…
>
> Brand parodies, then, are a natural and desirable part of a social conversation that takes place through the phenomenon of branding. Trademark owners benefit from that conversation, but they are not the only ones with a right to speak.

Stacey L. Dogan & Mark A. Lemley, Parody as Brand, 47 U.C. Davis L. Rev. 473, 486, 492, 494-96 (2013) (footnotes omitted).

Likewise, with respect to LV in particular, Sonia Katyal has explained that "LVMH's logo is not just a logo; precisely because of its ubiquity, it now stands for something else—luxury, elite excess, celebrity culture, and the like." Sonia K. Katyal, Trademark Cosmopolitanism, 47 U.C. Davis L. Rev. 875, 879 (2014). It is this excess of meaning that MOB evokes, and parodies. Given the First Amendment values promoted by parodies of fashion brands, courts must be especially careful before suppressing such parodies, or forcing their creators to go through expensive trials. *See* William McGeveran, The Imaginary Trademark Parody Crisis (and the Real One), 90 Washington L. Rev. 713 (2015). The district court's careful analysis, consistent with the case law, reflected this heightened

concern for free expression. *See, e.g.*, Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc., 886 F.2d 490, 493-95 (2d Cir. 1989); Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989); Yankee Pub. Inc. v. News America Pub. Inc., 809 F. Supp. 267, 275-76 (S.D.N.Y. 1992) (Leval, J.).

B. MOB's Parody Is Unlikely To Confuse

The district court applied the standard *Polaroid* factors to LV's trademark confusion claim and properly found that confusion was unlikely. Courts routinely reach the same conclusion in cases involving trademark parodies, because a parody's mockery itself signals a lack of connection to the trademark owner. *See, e.g.*, Burnett v. Twentieth Century Fox Film Corp., 491 F. Supp. 2d 962, 972 (C.D. Cal. 2007). And that means, further, that many of the factors in the *Polaroid* analysis that ordinarily signal that confusion is likely, such as the strength of the plaintiff's mark, point in the opposite direction in a case involving a trademark parody:

> While it is true that finding a mark to be strong and famous usually favors the plaintiff in a trademark infringement case, the opposite may be true when a legitimate claim of parody is involved. As the district court observed, "In cases of parody, a strong mark's fame and popularity is precisely the mechanism by which likelihood of confusion is avoided."

Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 261 (4th Cir. 2007); *see also, e.g.*, Yankee Pub'g, 809 F. Supp. at 273-74 (strength of plaintiff's mark makes humor less likely to confuse).

Although other defenses might also apply, standard likelihood of confusion analysis indicates that no defense is needed. Parodies are at least presumptively nonconfusing. Because of the way that parody affects the likelihood of confusion factors, courts and commentators generally agree that parodies by their nature are unlikely to confuse consumers. *See, e.g.*, Hormel Foods Corp. v. Jim Henson Productions, Inc., 73 F.3d 497, 505-08 (2d Cir. 1996); Black Dog Tavern Co. v. Hall, 823 F. Supp. 48 (D. Mass. 1993) (finding "Black Hog" and "Dead Dog" marks unlikely to be confused with "Black Dog" trademark); Barton Beebe, An Empirical Study of the Multifactor Tests for Trademark Infringement, 94 Cal. L. Rev. 1581, 1596 n.65 (2006) (empirical study finding parody defenses rare but usually successful when raised); William McGeveran, Rethinking Trademark Fair Use, 94 Iowa L. Rev. 49, 68-70 (2008); Greg Skoch, Commercial Trademark Parody: A Creative Device Worth Protecting, 9 Kan. J.L. & Pub. Pol'y 357 (1999).

Contrary to LV's contention, LV Br. at 48 n.5, these cases did not turn on the strength of the defendant's own mark. To do so would conflict with the First Amendment by discriminating in favor of already-powerful speakers, and would be nonsensical besides; consumers can recognize trademark parody even when the

parodist is little-known. *See, e.g.*, Mattel v. MCA, 28 F. Supp. 2d 1120, 1144-54 (C.D. Cal. 1998) (finding parodic song that became breakout hit for then-unknown Danish music group nonconfusing),[6] *aff'd on other grounds*, 296 F. 3d 894 (9th Cir. 2002).

LV relies heavily on its claim that MOB's intent was not to parody, but merely to provide "humorous social commentary." LV asserts—baselessly—that there is an important legal distinction between the two. LV Br. at 2-3. But LV's proposed distinction is not one that makes sense in trademark law or that courts would be good at making.[7] Even if we decided not to call MOB's bags "parodies" because of some conclusion about MOB's intent, MOB's social commentary would still be readily perceptible, and that social commentary is unlikely to interfere with the source-identification function of LV's marks:

> [T]rademark law cares only about the brand-product connection in the minds of consumers and how that might affect producer incentives. There is little reason to think that either parody or satire interferes with that connection; to the contrary, both will often reinforce the connection by calling to mind the famous brand or ad campaign they mimic. And there is even less reason to

[6] *See also id.* at 1138-39 (discussing ambiguous statements made by band members about the extent to which the song was "about" Barbie).

[7] The Ninth Circuit erroneously concluded that satire was more likely to confuse than parody, but it offered no reason grounded in consumer understanding, relying instead on a mistaken, mechanical application of copyright fair use limiting its coverage to what judges deemed to be pure "parodies." Compare Dr. Seuss Enters., L.P., v. Penguin Books USA, Inc., 109 F.3d 1394 (9th Cir. 1997), *with* Tyler T. Ochoa, Dr. Seuss, the Juice and Fair Use: How the Grinch Silenced a Parody, 45 J. Copyright Soc'y U.S.A. 546, 557, 578, 623-33 (1998).

> think that satire will cause more interference with the connection than parody does.

Dogan & Lemley, *supra*, at 501-02 (footnotes omitted); *see also* Bruce P. Keller & Rebecca Tushnet, Even More Parodic Than the Real Thing: Parody Lawsuits Revisited, 94 Trademark Rep. 979, 1001 (2004) (humorous uses need not be "parodic" to be nonconfusing).

As then-District Judge Leval explained, parody is an example of First Amendment-protected communication about trademarks, not a label whose presence or absence is determinative:

> [T]he dispute as to whether *New York*'s cover was parody misses the point. Yankee's argument implies that the special considerations emanating from the First Amendment depend on whether the allegedly infringing work is one of parody. That is not correct. Because unauthorized uses that provoke litigation, both in the copyright and in the trademark field, often involve parody, the decisions often discuss the special latitudes that are afforded to parody. But parody is merely an *example* of the types of expressive content that are favored in fair use analysis under the copyright law and First Amendment deference under the trademark law. Indeed, of the two leading trademark cases that have explained that deference in the Second Circuit, while *Cliffs Notes* dealt with parody, *Rogers v. Grimaldi* did not. The message of these cases is not merely that parody is accorded First Amendment deference, but rather that the use of a trademark in the communication of an expressive message is accorded such deference. *New York*'s commentary on the times [rather than on the plaintiff's mark specifically] … is an expressive message that is fully entitled to First Amendment deference, as much so as in the case of typical parody.

Yankee Pub'g, 809 F. Supp. at 279.

LV contends that there was no reason to single it out for criticism and thus that MOB's speech must be deemed unprotected because LV was not "essential" to

the joke. LV Br. at 39-40, 43.[8] But this has never been the standard for judging commentary under trademark law. L.L. Bean was not the only retailer with a wholesome image that could be parodied by a pornographic magazine. L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26 (1st Cir. 1987). MasterCard was not the only pro-consumption business that Ralph Nader could have targeted in his campaign to highlight how rich people and corporations buy politicians. MasterCard International, Inc. v. Nader 2000 Primary Committee, Inc., 2004 WL 434404 (S.D.N.Y. Mar. 8, 2004). This Court has, wisely, followed the general trend of rejecting LV's "alternative avenues" argument in the trademark context. *Rogers*, 875 F.2d at 999 & n.4; *see also* Parks v. LaFace Records, 329 F.3d 437, 449-50 (6th Cir. 2003); Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 971 (10th Cir. 1996); *L.L. Bean*, 811 F.2d at 29.

As the district court properly recognized, one can criticize or comment on a subject by identifying some individual or institution that represents it, just as Alexander Hamilton criticized slaveowners by pillorying Thomas Jefferson.[9] As a matter of both constitutional law and common sense, in the absence of false advertising or defamation, a court shouldn't tell a speaker to use a different example, or insist that if a speaker is targeting a general topic, she must make up a

[8] It is worth noting that, as social commentary, MOB's speech would, if anything, deserve *more* First Amendment solicitude than LV's trademark speech about a purely commercial matter, reflecting the analytic weakness of LV's distinction.
[9] *See* Hamilton (Lin-Manuel Miranda, 2015). (Seriously, see *Hamilton*.)

hypothetical example instead of using a real one. *See* Cohen v. California, 403 U.S. 15, 26 (1971) ("[W]e cannot indulge the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process."); Ronald Dworkin, The Right to Ridicule, N.Y. Rev. Books, Mar. 23, 2006, at 44 ("Ridicule is a distinct kind of expression: its substance cannot be repackaged in a less offensive rhetorical form without expressing something very different from what was intended. That is why cartoons and other forms of ridicule have for centuries … been among the most important weapons of both noble and wicked political movements.").

Commentary about broad subjects, such as our taste for luxury goods, are often illustrated with particular examples. And there is no better justification than the one we find in this case—LV has, as a brand, deliberately sought to exemplify high quality and exclusivity, which are characteristics essential to our taste for luxury goods as well as the target of MOB's commentary. LV has promoted itself successfully as an exemplar; it reaps the benefits of that status, and in a society where speech is free it must equally accept any responsive speech that may result. *Cf.* Hustler Magazine, Inc. v. Falwell, 485 U.S. 46 (1988) (holding that First Amendment requires stringent protection for speech mocking public figures).

Relatedly, LV suggests that because the designer behind the MOB bags expresses some affection for LV and its products, the MOB bags function neither

as parody nor protected social commentary. This argument is clearly mistaken: respectful, good-natured commentary is commentary nonetheless. Many an "ode" is parodic, as the latter word's derivation suggests. Furthermore, with parody in particular, a focus on intent can be counterproductive. Dogan & Lemley, *supra*, at 504 ("[I]t is worth noting that 2 Live Crew originally defended its song as a cover of the Orbison original, not as a parody. To focus on the defendant's intent would not only be unworkable but would cause similar uses to be treated differently depending on the defendant's state of mind and how careful they were in documenting their intent.").

Finally, LV speculates about post-sale confusion. This argument is unavailing for several reasons. First, the First Amendment considerations justifying special solicitude for communicative uses of trademarks are, if anything, stronger when the theory of confusion is more attenuated from any purchasing decision and thus the risk of harm is lower. *See, e.g.*, Jeremy N. Sheff, Veblen Brands, 96 Minn. L. Rev. 769, 804-30 (2012) (discussing intersection between post-sale confusion and First Amendment interests); Laura A. Heymann, The Public's Domain in Trademark Law: A First Amendment Theory of the Consumer, 43 Ga. L. Rev. 651 (2009) (similar). Second, the risks of post-sale confusion are lower with parody: a viewer who notices the image of the LV bag on the MOB bag is probably also going to notice that the image is a cartoon printed on an inexpensive

canvas tote, and is not the LV bag itself. The post-sale viewer is in no different position in that regard than the buyer. Given the very different appearance and message of the MOB bag versus the LV bag it is commenting on, the risk of post-sale confusion is merely theoretical and cannot, in any event, outweigh the First Amendment interests of MOB and its customers.

Separately, the post-sale confusion theory is especially unconvincing given LV's total failure to provide any evidence about it. LV bore the burden of proof on actionable confusion; LV knows how to conduct a post-sale confusion survey, and does so when it believes the results will be favorable. *See* Malletier v. Dooney & Bourke, Inc., 525 F. Supp. 2d 558 (S.D.N.Y. 2007). As one court explained in granting summary judgment,

> Plaintiff failed to provide a consumer survey showing a likelihood of confusion, which 'warrants a presumption that the results would have been unfavorable.' Playboy Enterprises, Inc. v. Netscape Communications Corp., 55 F. Supp. 2d 1070, 1084 (C.D. Cal. 1999), aff'd, 202 F.3d 278 (9th Cir. 1999) (citing Cairns v. Franklin Mint Co., 24 F. Supp. 2d 1013, 1041-42 (C.D. Cal. 1998) ("Survey evidence … is often the most persuasive evidence. Consequently, a plaintiff's failure to conduct a consumer survey, assuming it has the financial resources to do so, may lead to an inference that the results of such a survey would be unfavorable.").

James R. Glidewell Dental Ceramics, Inc. v. Keating Dental Arts, Inc., 2013 WL 655314, at *9 (C.D. Cal. Feb. 21, 2013); *see also* Kelly-Brown v. Winfrey, 95 F. Supp. 3d 350, 363 (S.D.N.Y. 2015); Essence Communications, Inc. v. Singh

Industries, Inc., 703 F. Supp. 261, 269 (S.D.N.Y. 1988); Universal City Studios, Inc. v. T-Shirt Gallery, Ltd., 634 F.Supp. 1468, 1478 (S.D.N.Y. 1987).

II. Application of Dilution to a Parody Is Unconstitutional

At the outset, it is important to recognize that the First Amendment landscape has changed substantially in recent years. This Court has ruled that content-based suppression of non-misleading speech, including non-misleading commercial speech, is presumptively unconstitutional and, to be upheld, must be shown to be narrowly tailored to serve compelling state interests. United States v. Caronia, 703 F.3d 149, 164 (2d Cir. 2012) (applying Sorrell v. IMS Health, Inc., 131 S. Ct. 2653 (2011), to non-misleading commercial speech);[10] *see also* Retail Digital Network, LLC v. Appelsmith, 810 F.3d 638 (9th Cir. 2016) (same); Sarver v. Chartier, No. 11-56986, 2016 WL 625362 (9th Cir. Feb. 17, 2016) (applying

[10] MOB's use does not constitute commercial speech. It does not propose a transaction. Rather, the MOB bag is itself the thing that a consumer would buy, and the bag's parodic message is the reason she would buy it, rather than being a separate act of speech designed to induce purchase. (Even if the Court were to conclude that MOB's use constituted "trademark use," that would not in itself make MOB's speech commercial, because under this Court's precedent even fully political speech can also constitute "trademark use." United We Stand America, Inc. v. United We Stand, America New York, Inc., 128 F.3d 86, 89-92 (2d Cir. 1997).) Given *Caronia*, however, the Court need not delve further into the commercial/noncommercial divide to resolve the question of the nature of MOB's speech. Strict scrutiny applies regardless.

strict scrutiny to right of publicity, which like dilution regulates speech in the absence of confusion); King v. Governor of the State of N.J., 767 F.3d 216, 236 (3d Cir. 2014) (same as *Caronia*).

Trademark law's anti-dilution provision creates a content-based right that applies to non-misleading commercial speech. Unlike defamation, it is a right unknown to the Framers of the Constitution. It was developed in the early decades of the twentieth century, when truthful commercial speech received no constitutional protection. LV claims that dilution law allows it to prevent the creation of unauthorized new associations with its mark, which is to say, to prevent consumers from forming new opinions and beliefs even in the absence of deception. This is not just content-based suppression of speech, it is *viewpoint-based* suppression of speech – the prime evil against which the First Amendment protects. Yet Congress provided no compelling interest to sustain its new restriction on non-misleading commercial speech when it enacted the federal dilution law, nor did it attempt to use the least restrictive means to achieve any such interest.[11]

[11] The empirical basis for the claim that dilution harms famous marks, or indeed any mark, is lacking, and even if it were, the law as written could not survive strict scrutiny. *See* Christo Boshoff, The Lady Doth Protest Too Much: A Neurophysiological Perspective on Brand Tarnishment, 25 J. Prod. & Brand Mgmt. 196 (2016) (finding no empirical basis for tarnishment); Robert Brauneis & Paul J. Heald, The Myth of Buick Aspirin: An Empirical Study of Trademark Dilution by Product and Trade Names, 32 Cardozo L. Rev. 2533 (2011) (same, for

At a bare minimum, constitutional avoidance justifies affirmance of the district court's careful application of the dilution statute to avoid suppressing First Amendment-protected speech. The district court distinguished between associations that *reinforced* consumers' beliefs that LV represents a socially influential single source while possibly changing their opinions about LV (a normal effect of commentary), and associations that led consumers to think that LV's marks came from multiple *different* sources (as would be the case if a consumer saw the mark "Delta" on a product and understood that the product originated with Delta Airlines, Delta Dental, Delta Faucets, or some new Delta).

In short, speech that leads audiences to think about the social meaning of luxury goods, or forces them to choose from a variety of competing meanings for a particular luxury brand, is speech that is valued under the First Amendment, not a harm to be avoided:

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dilution overall); Mary LaFrance, No Reason to Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech, 58 S.C. L. Rev. 709 (2007) (exploring constitutional infirmity of dilution law); Mark A. Lemley, Ex Ante Versus Ex Post Justifications for Intellectual Property, 71 U. Chi. L. Rev. 129 n.63 (2004) ("Where a work is truly iconic, even repeated debasement is unlikely to affect public perceptions. …[T]he Statue of Liberty, the Mona Lisa, Mount Rushmore, and the Eiffel Tower retain their iconic status despite repeated uses and abuses in many different contexts. So too do the works of Shakespeare and the characters Frankenstein (and his monster), Dracula, Scrooge, Uncle Sam, and King Arthur.") (citation omitted); Rebecca Tushnet, Gone in Sixty Milliseconds, Trademark Law and Cognitive Science, 86 Tex. L. Rev. 507, 547-61 (2008) (analyzing dilution as unconstitutional commercial speech regulation).

> To let Vuitton monopolize the meaning of its brand, not just its source signification, leads to discrimination against certain commercial speakers because of the cultural "side" on which they deploy their ads. Vuitton, like other advertisers, gets to use imagery and emotional appeals to enhance its brand reputation, but [MOB] doesn't get to do the same to challenge that reputation. The Supreme Court said in a case about hate speech:
>
> > [A] State may choose to regulate price advertising in one industry but not in others, because the risk of fraud (one of the characteristics of commercial speech that justifies depriving it of full First Amendment protection) is in its view greater there. But a State may not prohibit only that commercial advertising that depicts men in a demeaning fashion.

Rebecca Tushnet, More Than a Feeling: Emotion and the First Amendment, 127 Harv. L. Rev. 2392, 2401 (2014) (quoting R.A.V. v. City of St. Paul, 505 U.S. 377, 388–89 (1992) (citations omitted)). But that is exactly what dilution law does if, as LV contends, it is interpreted to cover referential uses. At a minimum, applying dilution to MOB's slyly subversive use would unconstitutionally discriminate against it as compared to other nondeceptive uses of LV's mark, such as those in comparative advertising or news reporting, that are expressly permitted by trademark law. *See* Tushnet, *Gone in Sixty Milliseconds*, at 566-67 (citing City of Cincinnati v. Discovery Network, Inc., 507 U.S. 410 (1993)); Michael Handler, What Can Harm the Reputation of a Trademark? A Critical Re-Evaluation of Dilution by Tarnishment, 106 Trademark Reporter 639, 687 (2016) ("It is not immediately clear why source-identifying uses ought to be proscribed, when closely similar conduct that might be said to cause the same harm is not.").

III. MOB's Use Was Fair as a Matter of Copyright Law

The district court's rejection of LV's copyright claims was equally sound. As an initial matter, the Supreme Court has stated that it is important to avoid using trademark law to extend the scope of copyright, *see* Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 34 (2003), and the same is true in the other direction – copyright should not be employed to circumvent limits, including First Amendment limits, to trademark claims. Fundamentally, LV did not file this case to protect its incentive to create new expressive works; LV's aim is to protect its brand from mockery. As a result, the copyright analysis should recognize the irrelevance of copyright to LV's branding choices. Specifically, the weakness of Louis Vuitton's copyright interest is evident in the district court's careful fair use analysis, both in terms of factor two (the nature of the work) and factor four (the effect on the market for the plaintiff's copyrighted works). As the district court properly recognized, there is no derivative market for parodies, and any effect on the value of Louis Vuitton's trademarks, or of its trademarked *products* as opposed to its copyrighted designs, is not the kind of harm copyright aims to avoid.

In its fair use analysis, the district court correctly found that MOB's use of LV's design was transformative. In Blanch v. Koons, 467 F.3d 244 (2d Cir. 2009),

Jeff Koons used Andrea's Blanch's photograph as "raw material" to create a new work with a different meaning and message. *Id.* at 247. Koon's use was neither parodic nor limited to Blanch's photograph, but Koons did use Blanch's work as part of a work that conveyed a new message, and the Second Circuit held that that was sufficient for the work to qualify as "transformative". A "genuine creative rationale" for Koons' copying, *id.* at 255, established transformativeness. So too here.

LV argues that MOB's use cannot be fair because some people will miss the joke. Transformativeness, however, is based on the possibility that a reasonable member of society could perceive the transformative use, not on the impossible requirement that every individual who might perceive MOB's bag will have a sense of humor. As the Supreme Court held, the fair use standard is whether a parodic character "may reasonably be perceived." Campbell v. Acuff–Rose Music, Inc., 510 U.S. 569, 582 (1994); Cariou v. Prince, 714 F. 3d 694, 707 (2d Cir. 2013). There are two core reasons for this: first, fair use is not reserved for the artistically competent who manage to communicate so clearly that everyone in the audience understands the message. Yankee Pub'g, 809 F.Supp. at 280 ("First Amendment protections do not apply only to those who speak clearly, whose jokes are funny, and whose parodies succeed") (quoted in *Campbell*, 510 U.S. at 583).

Second, and more importantly, commentary is not about singular meaning. A court is not required to do what cultural critics cannot and put the final interpretive stamp on a work. To require a fixed meaning would be to hold fair use hostage to the opinion of a majority (or even a minority), contrary to the First Amendment principles that undergird fair use. *Cf.* Mattel, Inc. v. Walking Mountain Productions, 353 F.3d 792, 801 (9th Cir. 2003) ("While individuals may disagree on the success or extent of a parody, parodic elements in a work will often justify fair use protection. … Use of surveys in assessing parody would allow majorities to determine the parodic nature of a work and possibly silence artistic creativity. Allowing majorities to determine whether a work is a parody would be greatly at odds with the purpose of the fair use exception and the Copyright Act.") (citations omitted).

Thus, if a new meaning or message is reasonably discernable in an accused work, it should be found to be transformative. History reveals the wisdom of such interpretive modesty. A number of works widely recognized as parodies were not uniformly recognized as such, especially at first. Before writing *The Clansman* (filmed as *Birth of a Nation*), for example, Thomas Dixon wrote a "sequel" to *Uncle Tom's Cabin*, keeping Simon Legree as a villain but defending the honor of the South. Dixon intended to refute Stowe's novel, but the books had numerous similarities beyond using the same characters and many (though not all) reviewers

saw his book as a superior successor to Stowe's, rather than as an assault on its message.[12]

In a large and diverse world, the meaning of a work will never be unitary.[13] It is inevitable that some people will misread articles from the satirical publication *The Onion* as standard reporting.[14] This phenomenon also occurs in the realm of caricature. For example, many people read a controversial New Yorker cartoon as

[12] Melvyn Stokes, D.W. Griffith's The Birth of a Nation 37, 41-42 (2007). Numerous other works have been interpreted both as parody and as valorization. Simon Dentith, Parody 36 (2000) ("[P]arody has the paradoxical effect of preserving the very text that it seeks to destroy . . .. This can have some odd effects, even running counter to the apparent intentions of the parodist. Thus the classic parody of *Don Quixote* . . . preserves the very chivalric romances that it attacks—with the unexpected result that for much of its history the novel has been read as a celebration of misplaced idealism rather than a satire of it."); *see also id.* at 105-06 (discussing persistent uncertainty over whether certain canonical texts are parodic or respectful).

[13] Empirical work studying audiences demonstrates that different audiences read mainstream works differently, meaning that there is no one message that any transformative user could identify and criticize. *See* John Fiske, Reading the Popular (1989). For example, "some viewers write letters . . . which applaud Archie [of *All in the Family*] for his racist viewpoint, while others applaud the show for effectively making fun of bigotry." Neil Vidmar & Milton Rokeach, Archie Bunker's Bigotry: A Study in Selective Perception and Exposure, 24 Journal of Communication 36 (1974). Viewers' perception of the program's intent to satirize Bunker's prejudices was greatest among nonprejudiced viewers and least among prejudiced viewers. *Id.* (This natural desire to interpret a work as supporting one's own viewpoint may also help to explain why LV sees nothing legitimate or critical about MOB's parody.)

[14] See Literally Unbelievable, http://literallyunbelievable.org/ (collecting multiple examples).

endorsing rather than commenting on depictions of President Obama as a radical Muslim; neither reading "fixed" the meaning of the cartoon itself.[15]

The D.C. Circuit has likewise emphasized the vagaries of interpretation in its holding that parody and satire must be given a wide scope to protect First Amendment values, holding that even reports of actual misunderstanding were irrelevant to the characterization of satire as a matter of law:

> In light of the special characteristics of satire, of course, "what a reasonable reader would have understood" is more informed by an assessment of her well-considered view than by her immediate yet transitory reaction…. [Plaintiffs] point to the inquiries they received following the blog post, as well as to Esquire's own "update" clarifying that the post was satire, as evidence that many actual readers were misled by Esquire's story. But it is the nature of satire that not everyone "gets it" immediately. For example, when Daniel Defoe first published The Shortest Way with the Dissenters, an anonymous satirical pamphlet against religious persecution, it was initially welcomed by the church establishment Defoe sought to ridicule. See James Sutherland, English Satire 83-84 (1958). Similarly, Benjamin Franklin's "Speech of Miss Polly Baker," a fictitious news story mocking New England's harsh treatment of unwed mothers, was widely republished in both England and the United States as actual news. See Max Hall, Benjamin Franklin & Polly Baker: The History of a Literary Deception 33-35, 87-88 (1960).

Farah v. Esquire Magazine, 736 F. 3d 528, 536-537 (D.C. Cir. 2013). When a caricature is involved, as here, one reasonable interpretation of the image is that it mocks the pretensions of high fashion and high-fashion consumers, and that suffices for transformativeness.

[15] Victor S. Navasky, The Art of Controversy: Political Cartoons and Their Enduring Power 13 (2013).

Because the use is transformative, the commercial nature of MOB's use does not weigh against fair use. Authors Guild v. Google, Inc., 804 F.3d 202, 218-19 (2d Cir. 2015) ("Many of the most universally accepted forms of fair use, such as news reporting and commentary, quotation in historical or analytic books, reviews of books, and performances, as well as parody, are all normally done commercially for profit.").[16]

The remaining fair use factors also favor MOB, as the district court properly recognized. As for the nature of LV's work, because it has already been widely published and extensively reproduced in advertising, LV's interest in control is diminished. Kelly v. Arriba Soft Corp., 336 F.3d 811, 820 (9th Cir. 2003) ("Published works are more likely to qualify as fair use because the first appearance of the artist's expression has already occurred."); Arica Inst. v. Palmer, 970 F.2d 1067, 1078 (2d Cir. 1992) (plaintiff's work was "a published work available to the general public," and the second factor thus favored the defendant).

As for the third factor, copying even an entire work (whatever that might mean with respect to LV's claimed patterns) is often consistent with fair use. From 1978-2005, defendants who took the entirety of the plaintiff's work won their fair use claims roughly as often as defendants overall. Barton Beebe, An Empirical

[16] LV misleadingly quotes older language that the Supreme Court has explicitly disavowed: commerciality is *not* presumptively dispositive. *Compare Campbell*, 510 U.S. at 584-85, *with* LV Br. at 72.

Study of U.S. Copyright Fair Use Opinions, 1978–2005, 156 U. Pa. L. Rev. 549, 575-76, 616 (2008); *see also, e.g.*, Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 449–50 (1984); Bill Graham Archives, 448 F.3d 605, 609 (2d Cir. 2006) (entire reproduction is fair when the purpose differs from that of the original). Especially when images are involved, it may be impossible to convey a message about the image without reproducing the entirety or nearly the entirety, and so the amount reproduced will not weigh against an otherwise transformative purpose. *See* Rebecca Tushnet, Worth a Thousand Words: The Images of Copyright Law, 125 Harv. L. Rev. 683, 753-54 (2012). Here, the amount of copying is appropriate in that it helps viewers understand that what is being mocked is a LV bag. *See* Bill Graham Archives, 448 F.3d at 613 (finding fair use when copying was of the "size and quality" necessary to the transformative purpose).

Analysis of the fourth factor, market harm, depends on the legitimate markets a copyright owner is allowed to control, and the market for transformative works is not among them. See Authors' Guild, Inc. v. HathiTrust, 755 F.3d 87, 99 (2d Cir. 2014) ("any economic 'harm' caused by transformative uses does not count because such uses, by definition, do not serve as substitutes for the original work"); Bill Graham Archives, 448 F.3d at 614-15 ("[A] copyright holder cannot prevent others from entering fair use markets merely by developing or licensing a

market for parody, news reporting, educational or other transformative uses of its own creative work. [C]opyright owners may not preempt exploitation of transformative markets ….").

This Court has recently emphasized that, to weigh in favor of a plaintiff, the fourth factor requires a "meaningful or significant effect" on the market for the plaintiff's work via substitution. Authors Guild, 804 F.3d at 224. A parodic image printed on a canvas bag is not such a replacement for the expressive elements of LV's work, especially for the discerning audiences LV targets. LV provided no evidence sufficient to avoid summary judgment on this point.

CONCLUSION

Trademark law is designed to allow consumers to identify the source of products and services, not to control how they think; copyright is designed to encourage speech, not to suppress it. This Court should not assist LV's attempts to suppress what LV views as MOB's failure to provide LV with sufficient deference.

Respectfully submitted,

s/ Christopher Jon Sprigman
Christopher Jon Sprigman
Professor of Law
New York University School of Law
Co-Director, Engelberg Center on
Innovation Law and Policy
40 Washington Square South
New York, NY 10012
(212) 992-8162

Rebecca Tushnet
(rlt26@law.georgetown.edu)
Georgetown University Law Center
600 New Jersey Ave. NW
Washington, DC 20001
Tel. (703) 593-6759

Counsel for Amici Curiae
Law Professors

APPENDIX A

Barton Beebe (NYU)

Robert Brauneis (George Washington)

Deborah Gerhardt (UNC)

Laura Heymann (William & Mary)

Mark Lemley (Stanford)

Mark McKenna (Notre Dame)

Betsy Rosenblatt (Whittier)

Pam Samuelson (Berkeley)

Jeremy Sheff (St. John's)

Jessica Silbey (Northeastern)

Christopher Sprigman (NYU)

Rebecca Tushnet (Georgetown)

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Pursuant to Fed. R. App. P. 32(a)(7)(C), I certify as follows:

1. This Brief of Amici Curiae Law Professors in Support of Defendants-Appellees and Urging Affirmance complies with the type limitation of Fed. R. App. P. 32(a)(7)(B) because this brief contains 6903 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii); and

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s/ Rebecca Tushnet
Rebecca Tushnet
(rlt26@law.georgetown.edu)
Georgetown University Law Center
600 New Jersey Ave. NW
Washington, DC 20001
Tel. (703) 593-6759

Counsel for Amicus Curiae Law Professors

CERTIFICATE OF SERVICE

I hereby certify that on this 15th day of August, a true and correct copy of the foregoing Brief of Amici Curiae Law Professors in Support of Defendants-Appellees and Urging Affirmance was served on all counsel of record in this appeal via CM/ECF pursuant to Second Circuit Rule 25.1(h)(1)-(2).

DATED: Aug. 15, 2016

s/ Rebecca Tushnet
Rebecca Tushnet
(rlt26@law.georgetown.edu)
Georgetown University Law Center
600 New Jersey Ave. NW
Washington, DC 20001
Tel. (703) 593-6759

Counsel for Amicus Curiae Law Professors