

# 22-1006-cv

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**United States Court of Appeals**  
*for the*  
**Second Circuit**

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VANS, INC., VF OUTDOOR, LLC.,

*Plaintiffs-Appellees,*

– v. –

MSCHF PRODUCT STUDIO, INC.,

*Defendant-Appellant.*

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

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***AMICUS CURIAE* BRIEF ON BEHALF OF THE  
INTERNATIONAL TRADEMARK ASSOCIATION IN  
SUPPORT OF NEITHER PARTY**

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## **CORPORATE DISCLOSURE STATEMENT**

Pursuant to Federal Rule of Appellate Procedure (“FRAP”) 26.1, *amicus curiae*, the International Trademark Association (“INTA”) states that it is not a publicly held corporation or other publicly held entity. INTA does not have any parent corporation, and no publicly held corporation or other publicly held entity holds 10% or more of INTA’s stock.

**CERTIFICATIONS PURSUANT TO FED. R. APP. P. 29**

Pursuant to FRAP 29(a)(2), *amicus curiae* certifies that all parties have consented to the filing of this brief.

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## STATEMENT OF INTEREST OF *AMICUS CURIAE*<sup>1</sup>

Founded in 1878, INTA is a not-for-profit organization dedicated to the support and advancement of trademarks and related intellectual property concepts as essential elements of trade and commerce. INTA has more than 7,200 member organizations from 191 countries, including trademark owners, law firms, and other professionals who regularly assist brand owners in the creation, registration, protection, and enforcement of their trademarks. INTA's members share the goal of promoting an understanding of the essential role that trademarks play in fostering informed decisions by consumers, effective commerce, and fair competition.

INTA's members are frequent participants—as plaintiffs, defendants, and advisors—in legal actions brought under the Lanham Act and, therefore, are interested in the development of clear, consistent, and equitable principles of trademark law. INTA has substantial expertise and has participated as *amicus curiae* in numerous cases involving significant Lanham Act issues.<sup>2</sup>

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<sup>1</sup> In accordance with FRAP 29(a)(4)(E), *amicus curiae* states that this brief was authored solely by INTA and its counsel, and no part of this brief was authored by counsel to a party. No party or counsel for a party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amicus curiae* and its counsel made such a monetary contribution to its preparation or submission

<sup>2</sup> Cases in which INTA has filed *amicus* briefs include *VIP Prod. LLC v. Jack Daniel's Properties, Inc.*, No. 21-16969, 2022 WL 1654040 (9th Cir. April 25,

INTA (formerly known as the United States Trademark Association) was founded in part to encourage the enactment of federal trademark legislation after the invalidation on constitutional grounds of the United States' first trademark act. Since then, INTA has been instrumental in making recommendations and aiding legislators in connection with almost all major federal trademark legislation including the Lanham Act, which is at issue in this appeal.

In *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), this Court set forth a test for district courts to apply in determining whether the use of another's name (or trademark) in the title of an expressive work violates the Lanham Act. INTA's interest in this case is to ensure proper application of *Rogers* and to avoid the extension of the *Rogers* test to cases involving ordinary consumer products, which would lessen protection against infringements afforded to trademark owners and expose consumers to confusion. Accordingly, INTA proposes a definition for

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2022); *LTTB LLC v. Redbubble, Inc.*, 840 Fed.Appx. 148 (9th Cir. 2020); *Ezaki Glico Kabushiki Kaisha v. Lotte Int'l Am. Corp.*, 986 F.3d 250 (3d Cir.), as amended (Mar. 10, 2021); *U.S. Patent & Trademark Office v. Booking.com B.V.*, 140 S. Ct. 2298 (2020); *Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S. Ct. 1492 (2020); *Peter v. NantKwest, Inc.*, 140 S. Ct. 365 (2019); *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019); *Mission Prod. Holdings, Inc. v. Tempnology, LLC*, 139 S. Ct. 1652 (2019); *Matal v. Tam*, 137 S. Ct. 1744 (2017); *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958 (9th Cir. 2011) (on rehearing); *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 633 F.3d 1158 (9th Cir. 2011); *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007). A full list of cases in which INTA has participated as *amicus curiae* over the last twenty years is available at <https://inta.org/amicusbriefs>.

“expressive works” that courts can use in deciding whether the *Rogers* test should apply to the facts of a given case.

### **ARGUMENT**

*Rogers* established a test to balance trademark rights and free speech rights in the context of the title of an expressive work – in that case, a movie. Courts have subsequently applied *Rogers* to other types of expressive works—including books, songs, video games, and greeting cards—and to the content of those works as well as their titles. Courts have consistently limited *Rogers* to cases involving the use of trademarks in such expressive works, with notable recent exceptions in the Ninth Circuit. Litigants have increasingly, however, claimed that the inclusion of any purportedly expressive content on an otherwise ordinary consumer product qualifies for the heightened First Amendment protections in *Rogers*, including in this case. In INTA’s view, an expansion of *Rogers* from traditionally expressive works to any product that contains some expression would allow would-be infringers to avoid liability merely by claiming they have incorporated some expression into their products that simultaneously misappropriate another’s mark.

This case presents an opportunity for this Court, the originator of the *Rogers* test, to confirm that the test applies only to traditionally expressive works—not ordinary consumer products—and to provide a gatekeeping definition of “expressive works” that will provide courts and litigants with more certainty when

considering whether the strong First Amendment protections of *Rogers* should apply or whether traditional trademark principles are more appropriate to better balance trademark rights with free speech. Specifically, for the reasons discussed below, INTA asserts that an “expressive work” should be defined as one where the expression cannot be removed from the product without it ceasing to be the same product, *i.e.*, that the expression is conceptually inseparable from the product.

**I. THE *ROGERS* TEST SHOULD ONLY APPLY TO TRADITIONALLY EXPRESSIVE WORKS, NOT ORDINARY CONSUMER PRODUCTS**

**A. The Origin of the *Rogers* Test and its Application to Traditionally Expressive Works.**

The circumstances that led this Court to create the *Rogers* test illustrate the narrow situations to which it applies. The *Rogers* test was developed to resolve a specific problem: to shield the authors of expressive works from being unduly limited in their expression due to trademark rights. *Rogers* involved a Federico Fellini film about two fictional cabaret performers who imitated the renowned dancing duo Ginger Rogers and Fred Astaire. Rogers sued, *inter alia*, under the Lanham Act, arguing that the film’s title, “*Ginger and Fred*,” created the false impression that the film was about her or that she endorsed, sponsored, or was otherwise involved in the film.

Analyzing the Lanham Act claim, the district court framed the central inquiry as “identify[ing] the line between commercial and artistic speech,”

concluding that, where the speech at issue is “artistic expression . . . not primarily intended to serve a commercial purpose, the prohibitions of the Lanham Act do not apply, and the [speech] is entitled to the full scope of protection under the First Amendment.” *Rogers v. Grimaldi*, 695 F. Supp. 112, 120–21 (S.D.N.Y. 1988). The court ruled that the film was artistic expression protected by the First Amendment and awarded the defendant summary judgment.

This Court affirmed, holding that the Lanham Act “should be construed to apply to artistic works *only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.*” 875 F.2d at 998 (emphasis added). This Court then articulated a two-part test to strike that balance:

In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of 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.

*Id.* at 999. This Court expressly distinguished between the title of an artistic work, which is entitled to First Amendment protection, and an “ordinary commercial product[ ],” which is not:

Though consumers frequently look to the title of a work . . . , they do not regard titles of artistic works in the same way as the names of ordinary commercial products. Since consumers expect an ordinary product to be what the name says it is, we apply the Lanham Act with some rigor to prohibit names that misdescribe such goods.

*Id.* at 1000.

Later, in *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993), this Court held that the second prong of the *Rogers* test should first apply the *Polaroid* factors<sup>3</sup> and the finding of likelihood of confusion “must be particularly compelling” to outweigh the First Amendment interest. Thus, in *Twin Peaks*, this Court faithfully applied *Rogers* to the question of whether a book title infringes trademark rights by analyzing whether the title had artistic relevance to the underlying work and, if so, whether the title explicitly misled as to the source or the content of the work. In remanding the question, this Court noted that context matters for evaluating consumer confusion: “It is a fair question whether a title that might otherwise be permissible under *Rogers* violates the Lanham Act when displayed in a manner that conjures up a visual image prominently associated with the work bearing the mark that was copied.” *Twin Peaks Prods., Inc.*, 996 at 1380.

This Court’s decisions in *Rogers* and *Twin Peaks* underscore that the *Rogers* test, which provides heightened First Amendment protection, is best applied to circumstances where traditionally artistic works (e.g., movies and books) incorporate another’s trademark. Because consumers do not encounter marks in such artistic works in the same way they do when purchasing a product in the

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<sup>3</sup> See *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1991).

marketplace, the enhanced First Amendment protections of *Rogers* are more appropriate. But in the context of the commercial speech associated with the purchase of an ordinary consumer product, the risk of consumer confusion is greater and the heightened free speech protections of *Rogers* may improperly shield infringing conduct.

**B. All Other Circuits but One Have Consistently Limited *Rogers* to Traditionally Expressive Works and Have Applied Traditional Trademark Principles to Ordinary Consumer Goods.**

Since this Court decided *Rogers* in 1988, it has applied the test only three times, and each of those cases involved traditionally artistic works. *See Lombardo v. Dr. Seuss Enters., L.P.*, 729 Fed.Appx. 131, 133 (2d Cir. 2018) (content of a play); *Twin Peaks Prods, Inc. v. Publ'ns Intern., Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (book title); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc.*, 886 F.2d 490, 494-95 (2d Cir. 1989) (book cover). While these cases demonstrate that *Rogers* need not be rigidly applied to just the title of works but also to their content, this Court has never applied *Rogers* to an ordinary consumer product, regardless of the level of expression that the defendant claimed the product contained. *See, e.g., Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 674 Fed.Appx 16 (2d Cir. 2016) (applying traditional trademark principles, not *Rogers*, to claimed parody in canvas bag portraying print similar to Louis Vuitton print); *Harvey-Davidson, Inc. v. Rottefella*, 164 F.3d 806, 812-13 (2d Cir. 1999) (applying



traditional trademark principles, not *Rogers*, regarding competing motorcycle services containing alleged critique of Harley Davidson); *see also* Lynn Jordan and David Kelly, *Another Decade of Rogers v. Grimaldi: Continuing to Balance the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 109 Trademark Law Reporter 833, 850-51 (2019).

Likewise, other Circuits, except for the Ninth Circuit, have consistently applied *Rogers* only to traditionally expressive works. *Cf. Louis Vuitton Malletier S.A. v. Haute Diggity Dog LLC*, 507 F.3d 252 (4th Cir. 2007) (applying traditional trademark and parody principles to dog toys)<sup>4</sup>; *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000) (applying *Rogers* to magazines); *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003) (applying *Rogers* to a song title); *ETW Corp. v. Jireh Pub. Inc.*, 332 F.3d 915 (6th Cir. 2003) (applying *Rogers* to the contents of paintings); *Nike, Inc. v. Just Did It Enterprises*, 6 F.3d 1225 (7th Cir. 1993) (applying traditional trademark and parody principles to t-shirt); *Univ. of Alabama Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266 (11th Cir. 2012)

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<sup>4</sup> Although the Fourth Circuit has not applied *Rogers* to ordinary consumer products, in *Radiance Foundation, Inc. v. NAACP*, 786 F.3d 316 (4th Cir. 2015), it addressed and adopted *Rogers* in the context of clearly expressive speech (a billboard containing political speech). In neither *Radiance Foundation* nor *Louis Vuitton*, however, did the Fourth Circuit suggest that ordinary commercial products merit First Amendment protection for their parodic expression.

(applying *Rogers* to paintings but not commercial products such as mugs)<sup>5</sup> with *VIP Prods., Inc. v. Jack Daniel's Properties, Inc. ("JDPI")*, 953 F.3d 1170 (9th Cir. 2020) (applying *Rogers* to dog toys); *but see Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002) (adopting *Rogers* test and applying it to the title of a song).

This consistent dichotomy applying *Rogers* only to traditionally artistic works highlights the implicit understanding by courts that the *Rogers* test only applies to highly specific and narrow circumstances where a defendant has incorporated another's trademark in a traditionally artistic or expressive work like a movie, book, or painting.

**C. District Courts Consistently Apply the Likelihood of Confusion Test, Not *Rogers*, To Cases Involving Claimed Parodies of Commercial Goods.**

District courts, too, have consistently followed this Court's implicit dichotomy restricting *Rogers* to traditionally artistic works and applying traditional trademark principles to cases involving ordinary commercial products. For example, the Southern District of New York has recognized that *Rogers* "is usually

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<sup>5</sup> In *Univ. of Alabama Bd. of Trustees*, the Eleventh Circuit's ruling was limited to artistic paintings, which were protected by the First Amendment, and did not extend to the "mundane products" also at issue in the case, such as mugs, towels and T-shirts. Although the court held that appellant waived his argument regarding "mundane products" bearing copies of the painting, it noted that "the artistic work [on those products] is much less likely to have been considered significant by the purchaser." 683 F.3d at 1282, n.42.

not the appropriate mechanism for examining an ordinary commercial product.”

*A.V.E.L.A. v. Estate of Marilyn Monroe, LLC*, 364 F. Supp. 3d 291, 321–22

(S.D.N.Y. 2019) (“the *Rogers* test is not designed to protect commercial products [here, Marilyn Monroe T-shirts] and . . . any First Amendment concerns are already addressed by the consumer confusion test”). Rather, “[t]he *Rogers* test applies *only* to artistic or expressive works. *Hush Hush Sound, Inc. v. H&M Hennes & Mauritz LP*, 2018 WL 4962086, at \*3 (C.D. Cal. Jan. 26, 2018) (emphasis added) (*Rogers* “is not applicable to commercial works such as a traditional advertisement” or, as in this case, a sweater displaying a band’s CLASSIXX trademark).

Recognizing these principles, district courts within the Second Circuit have, with one exception, consistently limited *Rogers* to traditionally expressive works while applying a traditional trademark analysis to cases involving commercial products. See *A.V.E.L.A., Inc.*, 364 F. Supp. 3d at 321–22; *Knowles-Carter v. Feyonce, Inc.*, 347 F. Supp. 3d 217 (S.D.N.Y. 2018) (T-shirts); *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172, 174 (S.D.N.Y. 2012) (*Rogers* applied to content of film); *Heisman Trophy Trust v. Smack Apparel Co.*, 637 F. Supp. 2d 146 (S.D.N.Y. 2009) (T-shirts); *Tommy Hilfiger Licensing Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 415 (S.D.N.Y. 2002) (pet perfume); *Schieffelin & Co. v. Jack Co. of Boca, Inc.*, 850 F. Supp. 232 (S.D.N.Y. 1994)

(popcorn product); *but see N.Y. Racing Ass’n, Inc. v. Perlmutter Publ’g, Inc.*, No. 95-CV-994 (FJS), 1996 WL 465298, at \*5 (N.D.N.Y. July 19, 1996) (finding that although t-shirts featuring paintings of the actual Saratoga racecourse that included plaintiff’s trademarks were artistically relevant, the defendants’ products that displayed paintings where plaintiff’s marks were added to the scenes and the mark did not actually exist in the scene depicted, “the balance shift[ed]”).

Other courts have recognized, without discussing *Rogers*, that although “free speech policies are involved” in cases concerning parody products, commercial goods are not entitled to full First Amendment protection. *World Wrestling Fed’n Entm’t, Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413, 431, 446 (W.D. Pa. 2003). That is because “the claim of parody is not really a separate ‘defense’ as such, but merely a way of phrasing the traditional response that customers are not likely to be confused.” *Id.* (quoting 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:153 (4th ed. 2002)).

In sum, district courts have consistently (though not exclusively) limited the application of *Rogers* to cases involving traditionally expressive works. As discussed below, traditional trademark principles already provide significant protections for free speech and parody appearing on ordinary commercial products such that the heightened protections under *Rogers* are unnecessary and overly protective.

**D. Traditional Trademark Principles Provide Significant Protections for Parodists and Free Expression.**

As discussed above, courts confronted with potentially infringing commercial goods that claim to be parodies apply the traditional likelihood of confusion analysis. However, they also recognize that a claim of parody may “influence[ ] the way in which the [likelihood of confusion] factors are applied.” *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007). In particular, if the parody is successful (*i.e.*, if consumers “get” the joke), confusion is not likely. On the other hand, if the parody is unsuccessful, consumers may still be confused, and liability may attach. *See, e.g., Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302 (N.D. Ga. 2008) (critic’s successful parody of Wal-Mart marks on website and merchandise only “influences the way the likelihood of confusion factors are applied . . . [b]ecause even a parody may constitute trademark infringement if that parody is confusing”).

For example, in *Anheuser-Busch, Inc. v. VIP Prods., LLC*, 666 F. Supp. 2d 974 (E.D. Mo. 2008), Anheuser-Busch alleged that VIP’s “Buttwiper” dog toys infringed and diluted its trade dress for Budweiser beer. The court recognized that the toys might be parody but applied the customary likelihood of confusion analysis (not the *Rogers* test) to determine whether they were infringing. The court noted that “[p]arody is another factor to consider in determining the likelihood of confusion, and casts several of the [likelihood of confusion] factors in a different light.” *Id.* at 984–85



(quoting *Utah Lighthouse Ministry v. Found. for Apologetic Info. and Research*, 527 F.3d 1045, 1055 (10th Cir. 2008)). But, the court held, “*the cry of ‘parody!’ does not magically fend off otherwise legitimate claims of trademark infringement or dilution. There are confusing parodies and non-confusing parodies.*” *Id.* at 985 (emphasis added). After weighing the likelihood of confusion factors, the court found that Anheuser-Busch was likely to succeed on the merits and entered a preliminary injunction. *Id.* at 986.

In another case involving dog products, the court held that First Amendment protection did not apply to “Timmy Holedigger,” a dog perfume that allegedly parodied the Tommy Hilfiger trademark, because the mark was being used “at least in part to promote a somewhat non-expressive, commercial product” and “trademark law permissibly regulates misleading commercial speech.” *Tommy Hilfiger Licensing Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 415 (S.D.N.Y. 2002). The court therefore applied the likelihood of confusion factors, “without recourse to the First Amendment.” *Id.* at 416.

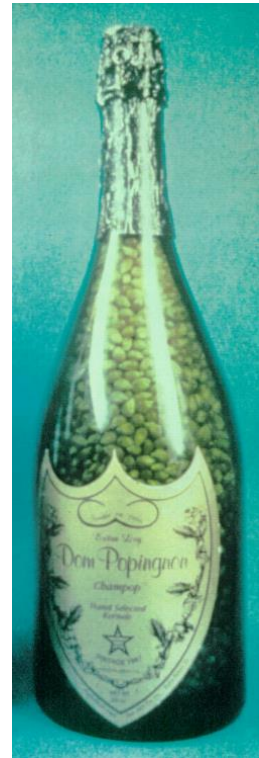


Applying the likelihood of confusion factors to commercial products purporting to parody another’s trademark is the best way to separate the “confusing parodies” from the “non-confusing parodies.” *Anheuser-Busch, Inc.*, 666 F. Supp. 2d at 985. In some cases, that will result in a win for the parodist, such as in *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 674 Fed.Appx 16 (2d Cir. 2016), where the district court and this Court found that a parody of Louis Vuitton’s handbag design (imprinted on an inexpensive canvas bag shown at right that suggested that the user’s “other bag”



is a Louis Vuitton) was not likely to cause confusion.

In other cases, consumer confusion may appropriately be found, such as in *Schieffelin & Co. v. Jack Co. of Boca, Inc.*, 850 F. Supp. 232 (S.D.N.Y. 1994), where the court found confusion was likely because the parody was not so obvious that consumers would understand that “Dom Poppingon” popcorn (shown below at right) did not come from the makers of Dom Perignon champagne. Although these courts reached different conclusions, they reached those conclusions in the same way – by applying substantive trademark law principles to the commercial goods at issue, rather than *Rogers*.<sup>6</sup>



Applying traditional trademark claims and defenses to commercial products therefore provides ample protections for parodies and free expression without the need to resort to Constitutional principles. As Judge Leval has written:

When lawsuits pit claims of exclusive trademark right against interests of free expression, courts should not run unnecessarily to the Constitution. The governing

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<sup>6</sup> *Accord Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009) (coffee); *Anheuser-Busch, Inc., v. L. & L. Wings, Inc.*, 962 F.2d 316 (4th Cir. 1992) (T-shirts); *Knowles-Carter v. Feyonce, Inc.*, 347 F. Supp. 3d 217 (S.D.N.Y. 2018) (T-shirts); *DC Comics v. Mad Engine, Inc.*, 2015 WL 9122562 (C.D. Cal. 2015) (T-shirts); *MPS Entm’t, LLC v. Abercrombie & Fitch Stores, Inc.*, 2013 WL 3288039 (S.D. Fla. 2013) (T-shirts); *Heisman Trophy Trust v. Smack Apparel Co.*, 637 F. Supp. 2d 146 (S.D.N.Y. 2009) (T-shirts).



statutes . . . are designed to balance the needs of merchants for identification as the provider of goods with the needs of society for free communication and discussion.

Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 Colum. J. L. & Arts 187, 210 (2004) (discussing, *inter alia*, the appropriate application of the *Rogers* test).

Accordingly, INTA urges this Court to clarify that *Rogers* only applies to traditionally expressive works, while providing a definition for what constitutes an “expressive work” in order to provide litigants and courts alike clarity on when to apply the *Rogers* test.

**E. Expanding *Rogers* to Ordinary Consumer Products Inappropriately Provides Heightened First Amendment Protections that Would Make It Virtually Impossible for Trademark Holders to Enforce Their Marks.**

As noted in Section I(B) above, while some cases applying the *Rogers* test involve titles of movies, as *Rogers* did, those departures where this and other Circuits have applied *Rogers* to other types of works besides movies all involved works that are inherently expressive and would not exist absent the expression contained in those works. *See, e.g., Lombardo*, 729 Fed.Appx. at 133 (content of a play); *Twin Peaks*, 996 F.2d at 1379 (book title); *Cliffs Notes*, 886 F.2d at 494–95 (book cover); *see also, e.g., Radiance Foundation, Inc. v. NAACP*, 786 F.3d 316 (4th Cir. 2015) (a billboard); *Westchester Media v. PRL USA Holdings, Inc.*, 214

F.3d 658, 664 (5th Cir. 2000) (magazine title); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 and n.7 (5th Cir. 1999) (book title); *ETW Corp. v. Jireh Pub. Inc.*, 332 F.3d 915, 928 (6th Cir. 2003) (content of a painting); *Parks v. LaFace Records*, 329 F.3d 437, 451-52 (6th Cir. 2003) (song title); *Gordon v. Drape Creative, Inc.*, 909 F.3d 257 (9th Cir. 2018) (greeting cards); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959 (10th Cir. 1996) (parody cartoon baseball cards); *University of Alabama, Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012) (applying *Rogers* to paintings and prints but not mundane products like mugs). In each of these examples, the works in question to which courts applied *Rogers* were all traditionally expressive works, not ordinary consumer products.

Only the Ninth Circuit has expanded the *Rogers* test to consumer products, in cases that MSCHF cites in its opening brief. *VIP Products, LLC v. Jack Daniel’s Properties, Inc. (“JDPI”)*, 953 F.3d 1170 (9th Cir. 2020) (applying *Rogers* to dog toys); *Twentieth Century Fox Television v. Empire Distribution, Inc.*, 875 F.3d 1192, 1196–97 (9th Cir. 2017) (expanding *Rogers* beyond the television series at issue to include ancillary products used to market the series). The misapplication of the heightened *Rogers* test to ordinary products ignores the original premise of *Rogers*—*i.e.*, that consumers perceive trademarks used in connection with expressive works differently than those used on ordinary products. *Rogers*, 875

F.2d at 1000. Furthermore, the misapplication of *Rogers* provides a roadmap to the sham invocation of “artistic” or expressive purpose by defendants. In INTA’s view, this incorrect expansion of *Rogers* stems from the lack of an accepted definition of “expressive work” as distinguished from an “ordinary commercial product.”

To illustrate the dangers of overapplying *Rogers*, the district court in *JDPI* on remand explained its concerns with expanding *Rogers* to ordinary consumer products. *VIP v. Jack Daniel’s Properties, Inc.*, 2021 WL 5710730 (D. Ariz. Oct. 8, 2021). There, the district court concluded that based on the Ninth Circuit’s jurisprudence expanding the reach of *Rogers*, it “appears nearly impossible for any trademark holder to prevail under the *Rogers* test” unless the defendant is “slapping another’s trademark on [its] own work and calling it [its] own.” *Id.* at \*6. The district court there specifically took issue with the “artistic relevance” and “explicitly misleading” prongs of *Rogers*, concluding it was those factors that made it virtually impossible to prevail when *Rogers* applies. *Id.*

INTA takes no position on the district court’s critique of the two prongs of the *Rogers* test in *JDPI* but instead asserts that the issue of greatest concern with *Rogers* is not necessarily the test itself but rather when it is applied. For example, while the artistic relevance prong makes sense in the context of a movie, the application of that prong is inappropriate when the expression on a defendant’s

product is conceptually separable from the underlying product itself. The expression in a book or movie—or even, potentially, a greeting card—cannot be separated from the type of work at issue. No blank novels or movies exist, and a completely blank greeting card is just note paper. The same cannot be said for coffee mugs, tote bags, dog toys, or sneakers. Those products retain their functionality even if all expression has been stripped from them.

The question of artistic relevance makes sense in traditional works of authorship because the work and the expression are intertwined and inseparable. If a defendant’s work is not a work of authorship but rather a utilitarian product (*e.g.*, a coffee mug, tote bag, dog toy, or sneaker), then *Rogers*’s heightened “explicitly misleading” test too strongly shields defendants except in the most blatant of infringements. Applying the *Rogers* test to such products will potentially allow parties to avoid trademark liability merely by claiming to have added some expression to any ordinary consumer product, thereby enabling them to confuse consumers and trade on the goodwill of trademark owners. Those who wish to incorporate expression into ordinary consumer products still enjoy significant free speech protections under traditional trademark principles, as discussed in Section 1(D), above.

As discussed below, this case provides a ripe opportunity to clarify the scope of *Rogers* and the types of works that qualify as “expressive” for the application of the test.

**II. THIS CASE PROVIDES AN OPPORTUNITY TO CLARIFY WHAT CONSTITUTES AN “EXPRESSIVE WORK” AND WHEN *ROGERS* APPLIES.**

**A. The Facts of this Case Raise the Question of what Qualifies as an “Expressive Work” under *Rogers*.**

MSCHF’s appeal of the decision below granting Vans’ motion for injunctive relief, *Vans v MSCHF*, 1:22-cv-02156 (E.D.N.Y. April 29, 2022), provides a vehicle for clarifying the definition of “expressive work”—because, in the face of MSCHF explicitly and repeatedly invoking *Rogers* and *JDPI* in its defense, the District Court’s decision below, while not mentioning the *Rogers* test, implicitly based its decision on its determination that MSCHF’s product was, regardless of MSCHF’s claims of it being art, an ordinary consumer product and not an “expressive work.”

This case concerns the sale by MSCHF, a self-described artists’ collective, of a limited-edition sneaker using a distorted version of Vans’ sneaker trade dress and modified versions of several of Vans’ trademarks. Implicit in the District Court’s holding is that MSCHF’s products were ordinary consumer products (*i.e.*, sneakers), and not, as MSCHF argued, works of art, relying on the high number of pairs of shoes made available (4,306), and the fact that MSCHF intended to correct

shipping errors of the wrong size. The court reasoned: “[As p]laintiff notes, if the shoes were truly meant to be artworks to be displayed rather than worn, there would be no specific need for consumers to receive a specific size.” *Id.* at 10.

Having determined that MSCHF’s products fell into the class of sneakers, *i.e.*, ordinary consumer products, not artworks, the court held that the WAVY BABY trade dress did not meet the requirements for a successful parody. Although the Wavy Baby sneakers “convey their similarity and reference to the [Vans] shoe trademarks,” they do not “sufficiently articulate ‘an element of satire, ridicule, joking or amusement’ clearly indicating to the ordinary observer that [MSCHF] is ‘not connected in any way with [Vans]’,” the court said. *Id.* at 12-13. While MSCHF’s sneakers appear to contain some artistic expression (at least under the non-zero standard of expression favored by many courts), limited edition sneakers are not the type of traditional expressive works (*e.g.*, books, movies, songs) that have been the predominant subject of *Rogers* cases.

Though the District Court did not advert to *Rogers*, INTA asserts that the analysis by the District Court below was consistent with this Court’s conception and scope, of *Rogers*. The District Court found that WAVY BABY was a competitive sneaker product and not an artwork because: (1) MSCHF had referred

to its product as a sneaker brand; (2) a high number of pairs were produced; and (3) the pairs were sized (and therefore intended to be worn).

On appeal, MSCHF specifically asks this Court to determine that the threshold for whether to apply *Rogers* need only be that the product is expressive. MSCHF argues that competitiveness between the parties and that the WAVY BABY shoe was sold for a profit are irrelevant for the application of *Rogers*, but that “[t]he relevant question remains the same regardless of the goods at issue: whether the defendant’s product is expressive.” (MSCHF’s Opening Brief, p. 31). INTA takes no position on the relevance of competitiveness or profit, which will vary in importance from case to case, but disagrees that the sole definition of an “expressive work” is merely one that contains expressive elements. This case squarely presents this key gatekeeping question of when *Rogers* should apply.

**B. Providing a Definition of an “Expressive Work” under *Rogers* Will Lead to Greater Certainty Among Litigants in Applying Trademark Law.**

This Court should take this opportunity to settle the scope of *Rogers* by clarifying when it applies. If the bar for application of *Rogers* were, as MSCHF suggests, that a product is merely “expressive,” then every case in which courts rejected application of *Rogers* to ordinary commercial products would have been wrongly decided—which is an untenable position to maintain. Applying the heightened First Amendment protections under *Rogers* to an ordinary consumer

product that also contains some expressive content would render it “nearly impossible for any trademark holder to prevail under the *Rogers* test” unless the defendant is “slapping another’s trademark on [its] own work and calling it [its] own.” *Jack Daniels*, 2021 WL 5710730 at \*6. That cannot be what this Court intended when it created the *Rogers* test.

Instead, INTA urges this Court to adopt the definition of “expressive work” suggested in Section III, *infra*. Adopting such a definition of an “expressive work” to determine when *Rogers* properly applies will provide significantly greater certainty in cases involving expression that uses another’s trademark or trade dress.

The number of art collectives that may create a product like the MSCHF shoe may be quite low; they are not a typical defendant. However, the possibility of exploitation of the standard for “expressive work” offered by MSCHF seems quite plausible. Indeed, adopting such a low threshold for applying *Rogers* would have yielded diametrically opposite holdings in the vast majority of cases that eschewed *Rogers* and instead applied traditional trademark principles—cases in which courts, applying traditional trademark principles, often found that consumers were likely to be confused.

Indeed, defining *Rogers*-eligible expressive works as any product containing expression is further untenable because it opens virtually every category of product to the heightened *Rogers* standard. It is hard to envision a product that cannot in



some way convey a message, and therefore be expressive. Consider the tens of thousands of utilitarian products (clothing, mugs, bags, phone cases, jewelry, electronics, stickers, housewares, etc.) capable of bearing some imprinted message on the products themselves, as well as standard packaging containing “trademark spaces” designed to bear messaging (e.g., labels and box panels). Such a standard fails to strike the proper balance between trademark law and the First Amendment. The over-application of increased First Amendment protection to ordinary consumer products will, over time, lead to innumerable purported commercial parodies that will erode the capacity of trademarks to effectively signal source and quality and result in confusion among consumers.

This Court should therefore articulate a clear definition of “expressive work” consistent with the original intent of *Rogers*.

### **III. AN “EXPRESSIVE WORK” IS ONE WHERE EXPRESSION IS INEXTRICABLE FROM THE PRODUCT.**

The *Rogers* court implied that in an expressive work, expression is inextricably intertwined with the product itself. Put another way, if the entirety of the creator’s expression is removed from a book or movie, no product remains that is recognizable as being in the same genus as the original product—blank movies and blank songs do not exist. If all expression is removed from a greeting card, only paper remains, which is not the original product. INTA therefore asserts that

an “expressive work” is one where the expression cannot be removed from the product without it ceasing to be the same product, *i.e.*, that the expression is conceptually inseparable from the product.

In contrast, upon removal of the expression from a sneaker (or coffee mug, tote bag, dog toy, or water bottle), a product recognizable as the same genus as the original product remains (namely, a sneaker, coffee mug, tote bag, dog toy, or water bottle). This separability suggests that consumers perceive both the expressive content and the underlying product, and therefore may perceive the expressive content as potentially signifying origin of the product.<sup>7</sup> Accordingly, traditional trademark principles should be employed to determine whether consumers perceive the expression as designating the source of that product.

This Court should thus define an “expressive work” as one whose expression cannot be removed from the work without destroying the functionality of the work itself. INTA is careful to note that this definition should not ask whether the specific expression at issue (or some subset of it) can be extracted but rather whether the *type of product* can exist without the expressive content. For example,

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<sup>7</sup> “Conceptual separability” may very well be applicable to instances involving the use of trade dress as well. Trade dress properly covers only non-functional elements of a product, and thus are potentially “separable” from the underlying product. The *JDPI* case and this case are good examples of this.

in *Rogers* itself, INTA’s suggested definition of an “expressive work” would not ask whether the title could be removed while still remaining a movie (it, of course, could) but rather whether all expression could be removed from a movie without nullifying the product itself. In that case, *Ginger & Fred*, stripped of all expression, would yield no product at all. Thus, in the case of *Rogers*, the expression was inextricable from the type of product at issue.

By contrast, here, the product in question is a shoe, albeit one claimed to be art. Its expression is an alleged caricature of the VANS mark and trade dress on its footwear. Yet stripping all the expression from a shoe would still yield a functional shoe. The District Court’s findings below regarding the sizing of the shoes and replacement of sizes for consumers suggest that however uncomfortable or impractical the shoes were, consumers purchased them as shoes, not art. Thus, traditional trademark principles—like those applied by the numerous decisions cited in Sections I.(C)-(D) above—provide an appropriate rubric for adjudicating this case to balance both trademark rights and free expression. INTA takes no position on how that question should be resolved—and therefore supports neither party here—but asserts that its proposed definition of “expressive work” will provide greater clarity for courts and litigants on the level of First Amendment protections to which a particular product is entitled.

## CONCLUSION

The *Rogers* test originated in a very specific and narrow context to apply greater First Amendment protection to the use of another’s mark in the title of a film. Since 1988, *Rogers* has been applied to an expanding array of traditionally expressive works, not to ordinary consumer products, with the exception of two recent decisions in the Ninth Circuit. This Court should take this opportunity to confirm the narrow circumstances in which the *Rogers* test applies and define an “expressive work” as one where the defendant’s expression is inextricable from the product.

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## CERTIFICATION OF SERVICE

The undersigned hereby certifies that on June 24, 2022, an electronic copy of the Brief of amicus curiae International Trademark Association was filed with the Clerk of the Court for the United States Court of Appeals for the Second Circuit by using the CM/ECF system. The undersigned also certifies that all participants are registered CM/ECF users and will be served via the CM/ECF system.

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