



COPYCAT- WALK: PARODY IN FASHION LAW

PATRICK MCKEY, MARIA VATHIS,
JANE KWAK, AND JOY ANDERSON

Traditional legal commentaries and authorities caution against the potential dangers of parodies and the perceived negative effects they may have on trademark or copyright owners.¹ Unsuccessful parodies constitute infringement. They also may constitute dilution, blurring, tarnishment, and unfairly confuse consumers and the public that the infringing product or item is made or endorsed by the aggrieved mark holder. Most designers and labels vigorously contest parodies, issuing cease-and-desist letters and, often, eventually filing suit. While these are necessary steps to protect one's brand, goodwill, and the value of the mark, mark holders are increasingly considering whether parodies may actually benefit them in the long run. As the infamous sayings go: "All publicity is good publicity" and "Imitation is the sincerest form of flattery." Surprisingly, the fashion industry may be warming up to the idea, as parodies may even boost sales for the mark holder, while creating a whole new market for parody brands.

Taking a glance at the two raincoats on the following page, it is easy to initially mistake them for the same brand. Only a closer look (or a trained eye) reveals that jacket on the left is "VETEMENTS," the cult Parisian brand launched in 2014 by Demma Gvasalia (formerly with Balenciaga) that's making fashion headlines for its radical designs,² and the one on the right is "VETEMEMES," the Brooklyn-based parody brand started by Davil Tran. Tran, a 22-year-old fashion enthusiast, has subsequently created an entire brand using parody as its main theme.³

When the Vetememes raincoat became an internet sensation in early 2016, the fashion world held its breath, waiting for Vetements to file suit for trademark infringement. Shockingly, Gvasalia publicly

wished Vetememes the best. He told *The New York Times* that "Vetements will not be filing any lawsuits over the Vetememes raincoat and hope[s] that [Tran] has enjoyed making his project as much as we do making our clothes."⁴

This article begins with an overview of trademark and copyright law, exploring both federal statutory regimes and various courts' interpretations of the law. The second part explores the evolution of parody, as both a common law defense to trademark infringement and copyright claims. The conclusion examines whether designers should embrace parody as a potential advertising method, as well as tools to be considered when pursuing litigation against parody brands.

Brief Overview of Trademark Law

A trademark is a word, symbol, or phrase used to identify a particular manufacturer or seller's products and to distinguish them from the products of another.⁵ Brand names, logos, and slogans can all be trademarked. Trademarks serve an important function in the business of consumer products by protecting items that define a company's brand, but have an especially important presence in the business of fashion. Anyone who has set foot inside of a department store may wonder what differentiates a \$50 piece of clothing or other accessory from a similar item with a \$550 price tag. In addition to the qualitative and aesthetic differences, it is the brand and the logo sewn onto the item. For example, the retail price for a men's plain, white, 100 percent cotton, crewneck T-shirt is \$2.50.⁶ However, when a similar T-shirt is branded with small logo featuring a polo player, that shirt becomes worth \$45.⁷ This is because the trademarked polo player symbol has evolved to be a recognizable, iconic image associated with the Ralph Lauren brand and the quality and cachet that are associated with that brand.

Congress enacted the first federal trademark law in the late 1800s. Today, the prominent federal statute is the Lanham Act,⁸ enacted in 1946. To qualify as a trademark, the mark must be distinctive (i.e., it must be capable of identifying the source of a particular good). Parties who either are the first to use the mark in commerce, or are first to register the mark with the U.S. Patent and Trademark Office (USPTO), acquire rights in that trademark. Courts place trademarks into four different categories and provide for various degrees of legal protection, depending on the category. The four trademark categories are based on the relationship between the mark and the underlying product:

- 1. Generic.** A generic mark is a mark that describes the general category to which the underlying product belongs and is entitled to no protection under trademark law.⁹ For example, a designer selling "Shoe" brand shoes would have no exclusive right to use the term "shoe" with respect to that product. Generic terms are not protected by trademark law because they are simply too useful and generic for identifying a particular product. Giving a single manufacturer control over use of the term would arguably give that manufacturer too great a competitive advantage.¹⁰
- 2. Descriptive.** A descriptive mark inherently describes the particular product, but a protected, descriptive mark acquires a secondary meaning as the consuming public primarily associates that mark with the particular producer, rather than the actual underlying product.¹¹ Descriptive marks are not federally registerable unless they have acquired distinctiveness and secondary meaning.¹² When trying to determine whether a given term has acquired secondary meaning, courts will often look to the following factors: (1) the amount and manner of advertising, (2) the volume of sales, (3) the length and manner of the term's use, and (4) results of consumer surveys.¹³ Examples of descriptive marks are "American Apparel" and "Canada Goose."
- 3. Suggestive.** Suggestive marks suggest a quality or characteristic of the good or service being provided in connection with the mark.¹⁴ Suggestive marks are typically considered strong and are thus registerable. A suggestive mark evokes or suggests a characteristic of the underlying good. "Wrangler" and "Pac Sun" are examples of suggestive marks. They suggest



the underlying product while not specifically describing the underlying product. Suggestive marks are inherently distinctive and, accordingly, are afforded a high degree of protection.¹⁵

- 4. Arbitrary or fanciful.** Arbitrary or fanciful marks bear no logical relationship to the underlying product.¹⁶ These marks are inherently distinctive and capable of identifying the underlying product. Many fashion brands have arbitrary or fanciful marks, like "Guess," "Theory," or "Converse." Arbitrary marks are words with commonly understood meanings wholly unrelated to the products they brand. These marks are considered strong and inherently distinctive. Thus, they are also given a high degree of protection.¹⁷

Trademark Infringement

A trademark owner can sue a party who uses the protected mark without permission. The standard applied when determining whether trademark infringement exists is "likelihood of confusion."¹⁸ In other words, if a consumer is likely to be confused as to the source of the goods, or as to the sponsorship or approval of the goods, then the product has infringed upon the owners' registered mark. Infringement encompasses counterfeit goods, where imitation products are manufactured in a manner to pass as *the* product it resembles and bears an exact or confusingly similar logo or trademarked name in an effort to pass as the real thing.

Other trademark infringement actions include instances in which one company sells products with a similar product, without copying the particular brand or designer name. For example, Adidas America Inc. sued Skechers USA Inc. for selling Adidas-like shoes exhibiting white leather with perforations along the side and an accent color on the heel and tongue.¹⁹

Additionally, AE Outfitters Retail Co. (American Eagle) sued Sun-sations Inc., a Virginia-based beach store, for selling merchandise depicting a flying eagle logo, which was argued to be widely recognized by the public as an indicator of American Eagle's goods.²⁰ Though not trying to pass its goods off as American Eagle merchandise, the use of the logo was alleged to be infringement.

Dilution

In addition to bringing an action for infringement, owners of trademarks can also bring an action for trademark dilution under either federal or state law. Antidilution statutes were developed to fill a void left by the failure of trademark infringement law to curb the unauthorized use of marks where there is no likelihood of confusion between the original and infringing use. Congress amended the Lanham Act by adding the Federal Trademark Dilution Act (FTDA) in 1995.²¹ The Trademark Dilution Revision Act of 2006 (TDRA) amended the Lanham Act and the FTDA and was enacted for the primary purpose of overruling the Supreme Court's decision in *Mosley v. V Secret Catalogue Inc.* The TDRA makes it clear that under the FTDA, a showing of likelihood of dilution is enough to create liability without proof of actual economic injury.²²

The injury inflicted by dilution is the "gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use on noncompeting goods."²³ It is an injury that "stems from an unauthorized effort to market incompatible products or services by trading on another's trademark."²⁴

Under federal law, a trademark owner may obtain relief under an antidilution statute if the mark is distinctive and there is a likelihood of dilution due to: (1) injury to the value of the mark caused by actual or potential confusion, (2) diminution in the uniqueness and individuality of the mark, or (3) injury resulting from use of the mark in a manner that tarnishes or appropriates the goodwill and reputation associated with plaintiff's mark.²⁵ A dilution claim can be brought only if the mark is "famous." In deciding whether a mark is "famous," courts will look to the following factors: (1) the degree of inherent or acquired distinctiveness, (2) the duration and extent of use, (3) the amount of advertising and publicity, (4) the geographic extent of the mark, (5) the channels of trade, (6) the degree of recognition in trading areas, (7) any use of similar marks by third parties, and (8) whether the mark is registered.²⁶

Methods of dilution include tarnishment and blurring. Tarnishment refers to the negative connotations and impressions that a mark owner will suffer when infringing products dilute the mark's value. For example, the use of the mark "VeVeeda," in connection with a sexually explicit website likely tarnished the famous Velveeta mark.²⁷ Blurring refers to the general association that the public has in regard to a product or name. If the public tends to think of the derivative mark instead of, or in addition to, the original mark, blurring has occurred.²⁸

Brief Overview of Copyright Law

Unlike trademarks, copyrights offer intellectual property protection for literary and artistic works. Though traditionally reserved for items like books, videos, and songs, the creative and artistic nature of the fashion industry has created a special arena for copyright law. Copyright law has its foundation in the U.S. Constitution. The Copyright Clause permits authors and inventors the exclusive right to their respective writings and discoveries for limited times to promote the progress of science and useful arts.²⁹ It has been interpreted that the framers' goal was to encourage the creation and dissemination of knowledge to increase social welfare.³⁰ The mechanism to achieve this social benefit was to create an economic incentive, and monopolistic right, to exploit their work for a limited period of time.³¹ As a result, Congress passed the first federal Copyright Act in 1790. Since then, federal copyright law has been revised several times in an effort to keep up with society's

ever-changing growth in technology.³² Among the exclusive rights afforded to a copyright owner are the rights to: (1) reproduce a work, (2) prepare derivative works, (3) distribute copies of the work to the public, and (4) perform or display the work publicly.³³ Possible penalties for copyright infringement include: (1) injunctions, (2) impounding allegedly infringing works during a legal proceeding, and (3) damages to the copyright owner. Generally, a copyright owner is entitled to actual damages and additional profits of the infringer or statutory damages between \$750 and \$30,000, with respect to any one work.³⁴ Willful infringement warrants maximum statutory damages up to \$150,000.³⁵ A court may also award the successful party reasonable attorney's fees, and any party may be awarded the recovery of full costs.³⁶

Copyright law protects original prints and patterns, unique color arrangements, and novel combinations of elements (protectable or non-protectable) used on apparel and accessories, but, in most cases, not the fashion designs themselves (which may be protected by a design patent). The one exception under the Copyright Act is that a fashion design may be protectable "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."³⁷ Courts have established that the test for separability may be met by showing either physical or conceptual separability. A design element is considered physically separable when it can be removed from an article of apparel and sold separately (e.g., a belt buckle) and conceptually separable when it comprises artistic features that do not contribute to the utilitarian aspect of the apparel and such features invoke an idea separate from the functionality of the apparel (e.g., a Halloween costume or fabric pattern).

The Fair Use Doctrine

Today, the most pervasive type of infringement is the duplication of an author's work.³⁸ Although copyright law generally prohibits duplication of a protected work, several exceptions exist where it is more beneficial to society to allow copying. Every modern-day idea necessarily derives from an idea that came before it, at least in some part, so granting creators absolute monopolies over their work may deny a subsequent author or designer the opportunity to creatively build upon it. Accordingly, unconditional adherence and overprotection impedes the free flow of ideas and runs contrary to the broad dissemination of information for the public good.³⁹

"Fair use" is defined as: "A reasonable and limited use of a copyrighted work without the author's permission, such as quoting from a book in a book review or using parts of it in a parody."⁴⁰ The doctrine was first expressed in 1841 when Supreme Court Justice Joseph Story delineated the methodology of the doctrine: "[L]ook to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work."⁴¹ The term "fair use" was first iterated in 1869.⁴² The common law application was finally codified by the Copyright Act of 1976. Fair use is a defense to an infringement claim, depending on the following statutory factors: (1) the purpose and character of the use, (2) the nature of the copyrighted work, (3) the amount of the work used, and (4) the economic impact of the use.⁴³ This section lays the groundwork the parody defense, in that:

[T]he fair use of a copyrighted work, including such use by reproduction ... in copies ... or by any other means specified by that section, for purposes such as *criticism, [or] comment* ... is not an infringement of copyright.⁴⁴

Additionally, the legislative history of the Copyright Act lists parody as one of the activities that might be accorded fair use status.⁴⁵

History of the Parody Defense Under Copyright Law

The parody defense is a subcategory of the fair use doctrine. Because a parody is either a commentary or criticism of the original work, it is a reasonable and limited use of a copyrighted work without the author's permission. "For a parody to be effective, the audience must be able to identify both the original subject of the parody, and also the parodist's mocking distortions."⁴⁶ To achieve this, a parody must necessarily copy, or mirror directly, portions of the original work. Parodies in general, by nature, are spoofs of the original work.⁴⁷ A parody is defined as "[a] transformative use of a well-known work for purposes of satirizing, ridiculing, critiquing, or commenting on the original work, as opposed to merely alluding to the original to draw attention to the later work."⁴⁸ Proper parodies are protected as free speech under the Constitution.

Considerations When Determining if a Parody Exists

Historically, in the context of music parody, some factors that courts consider when determining whether an attempted parody is in fact a parody include: (1) whether it is for commercial use, (2) whether it targets the original work as the object of humor or ridicule or uses the original merely as a vehicle for boarder comment,⁴⁹ (3) the amount of the taking, and (4) market effect. In the broader context of fair use, the Supreme Court has explored whether the work demonstrates a broader social value in determining if a copy is protected by fair use.⁵⁰

Courts historically looked at commercial use as a significant factor in determining whether a taking fell under the fair use doctrine.⁵¹ However, a seminal 1994 case held that the "commercial character of song parody did not create presumption against fair use"⁵² and that the commercial purpose of a work is only one element of its purpose and character. Thus, productive use cuts in favor of finding parody.⁵³ Accordingly, it makes sense that offensive or distasteful parodies have generally been disfavored by courts.⁵⁴ The amount and substantiality of the taking are also elements that courts consider. There is a general consensus that a verbatim copying of an original work exceeds the permissible scope of fair use.⁵⁵ Consequently, courts adopted a "conjure up" test, where the parody must use only as much of the original as necessary to conjure up, or evoke, recognition of the original.⁵⁶ Market effect—or market harm—can either be presumed by commercial use or from proof that the parody has the "effect of fulfilling the demand of the original."⁵⁷ Market harm "requires courts to consider not only the extent of market harm caused by the particular actions of the alleged infringer, but also whether unrestricted and widespread conduct of the sort engaged in by the defendant ... would result in a substantially adverse impact on the potential market for the original."⁵⁸

Trademark Parody

Trademark parody is a more recent application and outgrowth of

the fair use doctrine. Unlike copyright parody, it tends to focus more on the humorous nature of the spoof. In general, a trademark parody must either be funny, clever, witty, or provide a commentary on society:

For trademark purposes, [a] parody is defined as a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark's owner.... A parody must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is not the original and is instead a parody.⁵⁹

Trademarks, designer labels, logos, and slogans have a pervasive influence on advertising and commerce, "[t]hus, trademarks have become a natural target of satirists who seek to comment on this integral part of the national culture."⁶⁰ "Trademark parodies, even when offensive, do convey a message. The message may be simply that business and product images need not always be taken too seriously; a trademark parody reminds us that we are free to laugh at the images and associations linked with the mark."⁶¹

Early cases focused on the commercial nature of parodies and often found that using trademarks for purposes of making a financial profit warranted finding infringement. For example, posters bearing the logo "Enjoy Cocaine" were found to violate the rights of Coca-Cola in the slogan "Enjoy Coca-Cola" because of its commercial nature.⁶²

Subsequent cases focused more on the comedic intent and jesting nature of parodies. For example, the use of a pig character named Spa'am in a Muppet movie was deemed to be a proper parody and found not to violate Hormel Foods Corp.'s rights in the trademark "Spam."⁶³

Parodies in the Fashion Industry

Parodies of fashion designers and labels are widespread these days. From "My Other Bag" to "Ain't Laurent Without Yves," most consumers have heard of one fashion parody or another. Even the dog toy industry has made it a business to take a comedic interpretation of the most recognizable designers. For under \$20, Fido can chew on a wide array of parody designer bags, including: the Barkin, Kate Spayed, Chewy Vuitton, Michael Klaws, Pawlenciaga, Tory Bark, or Pawda. She can even wear Jimmy Chews or Manalo Barkniks.⁶⁴

Increasingly, courts have been providing smaller labels greater protection under the defense of parody. In 2007, the Fourth Circuit held that the "Chewy Vuitton" dog toy was a successful parody, denying Louis Vuitton's motion for summary judgment in its trademark infringement, dilution, and copyright infringement action.⁶⁵

In January of this year, the Southern District of New York held for My Other Bag Inc. in its use and sale of a canvas tote bag bearing caricatures of iconic designer handbags on one side of the bag and the text "My Other Bag" on the other side.⁶⁶ The court found that the use of the trademark was a parody and, thus, a fair use for purposes of trademark dilution. Even if the use was not a parody, the court determined that the use did not affect consumers' ability to clearly and unmistakably distinguish one source as a unique identifier.

Louis Vuitton immediately filed an appeal of the district court's ruling, arguing that the district court incorrectly applied the TDRA factors by imposing a higher burden of proof of Louis Vuitton because famous marks were at issue.⁶⁷ The fashion designer argues in their opening brief that it "provided undisputed evidence that

[My Other Bag] intended to and did create an association between its products and Louis Vuitton's, whose marks [My Other Bag] used to entice consumers to buy its bags as a trendy 'homage' to fashion brands."⁶⁸ The Second Circuit's ruling is pending.

Also in January 2016, in the well-known dispute between Yves Saint Laurent (YSL) and What About Yves, the parties entered into a voluntary dismissal and settlement agreement for an unknown amount. In that case, it appears that defendant Jeanine Heller, founder of What About Yves, agreed to remove the allegedly infringing items of clothing.⁶⁹ Heller filed to register her mark with the USPTO, but was rejected because of the similarity to various existing marks belonging to YSL.

The underlying theme of the court's finding of parody in these cases is an emphasis on the creation of a parody that is a strong enough spoof that it reduces the likelihood of confusion such that a consumer would not confuse the two brands.

The Silver Lining of Parody

The notion that parodies actually benefit, rather than harm, the target brand has been often echoed by courts since the 1980s. Lardashe, marketing jeans for plus-size women, was held not to infringe Jordache jeans⁷⁰ "[b]ecause of the parody aspect of Lardashe, it is not likely that public identification of Jordache with the plaintiff will be eroded; indeed, *parody tends to increase public identification of a plaintiff's mark with the plaintiff.*"⁷¹

Similarly, Big Dog T-shirts, popular in the 1990s, depict various parodies of famous marks, brands or icons. One shirt depicted, "Bone Cold Steve Pawstin," a take on Stone Cold Steve Austin, a World Wrestling Entertainment (WWE) wrestler popular at the time. In response to WWE's dilution claims, the court held that "Big Dog's parody is more apt to increase public identification of WWE's marks with WWE."⁷²

In deciding whether "Timmy Holedigger" pet perfume infringed upon Tommy Hilfiger's trademark, the District Court for the Southern District of New York held that, "[g]iven the nature of the challenged use, then, and the utter lack of evidence that the selling power of Hilfiger's marks has been diminished, no rational trier of fact could conclude that Nature Labs' pet perfume is likely to impair the identification of Hilfiger's marks with its products" and actually tend to increase public identification of the Hilfiger mark.⁷³

If You Can't Beat Them....

Today's generation values the underdog and has pushed back more than ever on big corporations. Designers may consider the approach taken by Vetements and decide not to bring suit against the parody maker, and they may even publically endorse them. Designers risk public "shaming" and appearing to be a bully if they choose to pursue suit against the maker of the parody. As explained by professor Leah Chan Grinvald:

For any business, reputation is the key to success. Reputation, also referred to in trademark law as goodwill, ensures that former customers will make repeat purchases, and it also ensures that potential customers turn into current customers. One of the impetuses behind a business's development of a consumer community is to cultivate and maintain their reputation with their consumers. While a business's reputation traditionally rested on the quality of the good or

service it sold, in recent years, the extent to which the business is a good "corporate citizen" can also affect its reputation and its sales. [T]he norm against bullying is a widespread one and consumers (for the most part) do not condone such behavior. Therefore, when a large corporation is shamed for bullying efforts, the consumer community will likely sanction such behavior.⁷⁴

In other words, given the increased legal power of the senior mark holder, consumers may view the designer as a "trademark bully."⁷⁵ This sort of scenario has already played itself out on social media. In 2009, Hansen Beverage Company sent Rock Art Brewery (a small, family-owned microbrewery) a letter demanding that Rock Art cease and desist its use of "Vermonster" as a trademark for beer, arguing that Vermonster infringed on Hansen's Monster Energy trademarks. Rock Art took to YouTube and assembled a following of over 50,000 viewers in the first few days after posting the letter. In the end, the parties settled, and Rock Art continued its use of the brand name.⁷⁶

The Vetements' approach is not the best option for all brands, especially in circumstances in which the parody dilutes the brand, threatens the association of the brand name, presents likelihood of confusion and where actual counterfeiting is occurring. However, it is a factor that should be weighed and considered by mark holders when deciding the best approach to ensure protection of its marks. ☉



Patrick McKey is a partner at the law firm Bryan Cave. His diverse practice concentrates primarily on complex commercial litigation, international business disputes, product liability defense, mass and toxic tort defense, environmental and intellectual property litigation, as well as corporate counseling and public law. McKey is active in Bryan Cave LLP fashion law team. Maria Vathis is of



counsel at Bryan Cave. Vathis has a broad range of experience defending corporate clients in complex business litigation matters, insurance coverage, and class actions involving alleged violations of federal statutes. Vathis is active in Bryan Cave LLP's fashion law team. Jane Kwak is an associate at Bryan Cave in the firm's environmental and commercial litigation client services groups and is also a member of the fashion law team. Joy Anderson is an associate at Bryan Cave in the firm's commercial litigation client services group and a member of the fashion law team. © 2017 Patrick McKey, Maria Vathis, Jane Kwak, and Joy Anderson. All rights reserved.

Endnotes

¹*Dr. Seuss Enters. L.P. v. Penguin Books USA Inc.*, 109 F.3d 1394, 1406 (9th Cir. 1997) (affirming grant of preliminary injunction prohibiting the publication and distribution of infringing parody of Dr. Seuss' *Cat in the Hat* depicting O.J. Simpson's murder trial); *Gucci Shops Inc. v. R.H. Macy & Co.*, 446 F. Supp. 838 (S.D.N.Y. 1977) (issuing preliminary injunction against maker of diaper bag with green and red bands and the wording "Gucchi Goo," allegedly

poking fun at the well-known Gucci name and the design mark).

²Alexander Fury, *These Two Guys Are Changing How We Think About Fashion*, N.Y. TIMES (Apr. 11, 2016), available at <http://www.nytimes.com/2016/04/11/t-magazine/gucci-alessandro-michele-balenciaga-vetements-demna-gvasalia.html> (last visited Oct. 10, 2016).

³At the Vetements Spring/Summer 2016 fashion show, a model wore a yellow DHL T-shirt, which soon became the “it” item for 2016. Selling for £185, the shirt sold out at most retailers. The tradition of catwalk brands like Maison Margiela (where many members of the Vetements team were employed) using logos in playful form has existed since the 1990s, which is ultimately a parody of sorts. As such, the yellow Vetements “MEMES” T-shirt, a parody of the Vetements DHL T-shirt, became a parody of a parody.

⁴Vanessa Friedman, *Vetements Won't be Pouring Cold Water on Parody Raincoat*, N.Y. TIMES (Mar. 31, 2016), available at <http://www.nytimes.com/2016/04/01/fashion/vetements-wont-be-pouring-cold-water-on-parody-raincoat.html> (last visited Oct. 10, 2016).

⁵15 U.S.C. § 1127.

⁶Hanes Crewneck Undershirt 6-Pack, retail value \$15 (original price), <http://www.hanes.com/shop/hanes/sale/mens-sale/sale-mens5/hanes-mens-undershirt-117246> (last visited Oct. 10, 2016).

⁷Ralph Lauren Custom-Fit Cotton T-Shirt, retail value \$45 (original price), http://www.ralphlauren.com/product/index.jsp?productId=84540916&cp=2943767.13183412&ab=ln_nodivision_cs_t-shirts&s=D-DollarRank&parentPage=family (last visited Oct. 10, 2016).

⁸Lanham Act, 15 U.S.C. § 1051, *et seq.*

⁹Section 2(e) of the Lanham Act forbids the registration of a mark that, when applied to the goods of the applicant, is “merely descriptive.” 15 U.S.C. § 1052(e). *See also, Abercrombie & Fitch Co. v. Hunting World Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (the term “safari” has become generic in the sense that it encompasses clothing that embodies the look of exploring or an expedition for hunting in East Africa—such as khaki-colored, belted, bush jackets with patch pockets and a buttoned shoulder loop, and broad flat-brimmed hats with a single, large band—so obtaining trademark rights for the word “safari” is not warranted under the Lanham Act).

¹⁰*Abercrombie & Fitch Co.*, 537 F.2d at 9 (explaining how the Lanham Act offers protection for generic marks, even if secondary meaning has developed).

¹¹“A descriptive mark describes a characteristic or ingredient of the product to which it refers. Such a mark can obtain trademark protection but proof of secondary meaning is necessary.” *Barnes Grp. Inc. v. Connell Ltd. P'ship*, 793 F. Supp. 1277, 1295 (D. Del. 1992). “Secondary meaning exists when the trademark is interpreted by the consuming public to be not only an identification of the product, but also a representation of the product's origin [and] [o]nce a trademark which could not otherwise have exclusive appropriation achieves secondary meaning, competitors can be prevented from using a similar mark.” *Scott Paper Co. v. Scott's Liquid Gold Inc.*, 589 F.2d 1225, 1228 (3d Cir. 1978).

¹²*Abercrombie & Fitch*, 537 F.2d at 9 (the Lanham Act makes the secondary meaning exception to descriptive terms and offers protection if secondary meaning is proven).

¹³*Zatarain's Inc. v. Oak Grove Smokehouse Inc.*, 698 F.2d 786 (5th Cir. 1983).

¹⁴*Barnes*, 793 F. Supp. at 1295 (A suggestive mark suggests but does

not describe the characteristics of the goods to which it is attached.).

¹⁵*Abercrombie & Fitch*, 537 F.2d at 11 (If a term is suggestive, it is entitled to registration without proof of secondary meaning.).

¹⁶*Barnes*, 793 F. Supp. at 1295 (An arbitrary or fanciful mark does not have any logical or suggestive relation to the actual characteristics of the goods.).

¹⁷*Union Nat'l Bank of Texas, Laredo, Tex. v. Union Nat'l Bank of Texas, Austin, Tex.*, 909 F.2d 839, 844 (5th Cir. 1990) (arbitrary or fanciful terms are all protectable without proof of secondary meaning).

¹⁸15 U.S.C. § 1114; *Network Automation Inc. v. Advanced Sys. Concepts Inc.*, 638 F.3d 1137, 1144 (9th Cir. 2011) (To prevail on a claim of trademark infringement ... a party “must prove: (1) that it has a protectable ownership interest in the mark, and (2) that the defendant's use of the mark is likely to cause consumer confusion.”).

¹⁹*adidas America Inc. et al v. Skechers USA Inc.*, U.S. District Court for the District of Oregon, Case No. 3:15-cv-01741-HZ, filed on Sept. 14, 2015.

²⁰*AE Outfitters Retail Co. v. Sunsations Inc.*, U.S. District Court for the Eastern District of North Carolina, Case No. 2:16-cv-00009-D, filed on Feb. 18, 2016. A consent judgment and permanent injunction were entered enjoining Sunsations from selling, copying, using, etc. the Flying Eagle Design or any mark that is confusingly similar to the Flying Eagle Design.

²¹Corp Couns Gd to Unfair Comp § 9:13.

²²*Id.*

²³*L.L. Bean Inc. v. Drake Publishers Inc.*, 811 F.2d 26, 30 (1st Cir. 1987) (sexually explicit parody of an L.L. Bean catalog was found not to constitute trademark infringement, not only because it was protected by the First Amendment, but also because it was a proper parody).

²⁴*Id.*, 811 F.2d at 31.

²⁵*Astra Pharm. Prod. v. Beckman Instruments*, 718 F.2d 1201, 1209 (1st Cir. 1983).

²⁶15 U.S.C. § 1125(c).

²⁷*Kraft Food Holdings Inc. v. Helm*, 205 F. Supp. 2d 942, 949-950, 953 (N.D. Ill. 2002) (also concluding that “VelVeeda” was not a parody of Kraft cheese products).

²⁸*Mattel Inc. v. MCA Records Inc.*, 296 F.3d 894, 903-904 (9th Cir. 2002) (finding blurring where consumers hearing Barbie's name may now think of the song “Barbie Girl” in addition to the doll, or potentially of the song only).

²⁹U.S. Const. art. I, § 8, cl. 8.

³⁰H.R. Rep. No. 2222, 60th Cong., 2d Sess. 7 (1909) (a copyright is “[n]ot primarily for the benefit of the author, but primarily for the benefit of the public); *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in “science and useful arts.”).

³¹*See, e.g. Sony Corp. of Am. v. Universal City Studios Inc.*, 464 U.S. 417, 429 (1984) ([A copyright] is intended to motivate the creative activity of authors and inventors by the provision of a special reward.).

³²Currently codified at 17 U.S.C. § 101 *et seq.*

³³17 U.S.C. § 106.

³⁴17 U.S.C. § 504(c)(1).

³⁵17 U.S.C. § 504(c)(2).

³⁶17 U.S.C. § 505.

³⁷17 U.S.C. § 101.

³⁸Gregory D. Deutsch, *As Unoriginal As They Wanna Be: Upholding Musical Parody in Campbell v. Acuff-Rose Music Inc.*, 23 PEPP. L. REV. 205, 210 (1995).

³⁹*United States v. Paramount Pictures Inc.*, 334 U.S. 131, 158 (1948) (the author's interest is subordinate to the advancement of the public welfare).

⁴⁰BLACK'S LAW DICTIONARY (10th ed. 2014).

⁴¹*Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841) (No. 4,901).

⁴²*Lawrence v. Dana*, 15 F. Cas. 26, 60 (C.C.D. Mass. 1869) (No. 8,136).

⁴³17 U.S.C. § 107.

⁴⁴17 U.S.C. § 107 (emphasis added).

⁴⁵The examples enumerated at page 24 of the Register's 1961 Report, while by no means exhaustive, give some idea of the sort of activities the courts might regard as fair use under the circumstances: "use in a parody of some of the content of the work parodied...." H.R. Rep. No. 1476, 94th Cong., 2d Sess. 65 (1976).

⁴⁶Deutsch, at 212.

⁴⁷Robert J. Shaughnessy, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA. L. REV. 1079, 1109 (1986).

⁴⁸BLACK'S LAW DICTIONARY (10th ed. 2014).

⁴⁹*Sony*, 464 U.S. 417 (1984).

⁵⁰*Id.*; *Harper & Row Publishers Inc. v. Nation Enters.*, 471 U.S. 539, 558, (1985) (discussing to what extent the "general public good" should be considered when interpreting the fair use doctrine).

⁵¹*Sony*, 464 U.S. 417 (1984).

⁵²*Campbell v. Acuff-Rose Music Inc.*, 510 U.S. 569 (1994).

⁵³Productive use incorporates the original material in order to create a new and socially useful work for purposes such as comment, teaching, or scholarship. *See, e.g. Sony*, 464 U.S. 417 (1984); *Harper*, 471 U.S. 539 (1985).

⁵⁴*Dallas Cowboys Cheerleaders Inc. v. Pussycat Cinema Ltd. & Michael Zaffarano*, 604 F.2d 200 (2d Cir. 1979) (Second Circuit found likelihood of confusion in the use of the Dallas Cowboys cheerleading uniforms in the sexually explicit film "Debbie Does Dallas."); *Hasbro Inc. v. Internet Entm't Group Ltd.*, U.S. District Court for the Western District of Washington, Case No. 2:96-cv-00130-WLD, filed on Jan. 25, 1996 (stipulated judgment and permanent injunction ordered against use of website "candyland.com," a sexually explicit internet site, because the domain name tarnished and diluted Hasbro's Candy Land trademark).

⁵⁵*See, e.g. MCA Inc. v. Wilson*, 677 F.2d 180, 189 (2d Cir. 1981); *Warner Bros. Inc. v. American Broad. Co.*, 654 F.2d 204, 207-209 (2d Cir. 1981).

⁵⁶*Campbell*, 510 U.S. at 588.

⁵⁷*Sony*, 464 U.S. at 485-486 (manufacturers of home videotape recorders creation of a market for the recording of copyrighted programs deprived copyright holders from exploiting that market, which was held not to be a fair use).

⁵⁸*Campbell*, 510 U.S. at 590.

⁵⁹*People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001) (internal quotations and citations omitted).

⁶⁰*L.L. Bean Inc.*, 811 F.2d 26, 28 (1st Cir. 1987).

⁶¹*L.L. Bean*, 811 F.2d at 34.

⁶²*Coca-Cola Co. v. Gemini Rising Inc.*, 346 F. Supp. 1183 (E.D.N.Y.

1972) (granting preliminary injunction against infringer).

⁶³*Hormel Foods Corp. v. Jim Henson Prods. Inc.*, 73 F.3d 497, 503 (2d Cir. 1996) (affirming denial of preliminary injunction because there was no evidence that Jim Henson's use of the name Spa'am would cause negative associations, and since the parody was so inherent in the use, the court found no likelihood of dilution under a tarnishment theory).

⁶⁴HAUTE DIGGITY DOG, <http://hautediggitydog.com> (last visited Oct. 10, 2016).

⁶⁵*Louis Vuitton Malletier S.A. v. Haute Diggity Dog LLC*, 507 F.3d 252 (4th Cir. 2007).

⁶⁶*Louis Vuitton Malletier S.A. v. My Other Bag Inc.*, 156 F. Supp. 3d 425 (S.D.N.Y. 2016) (granting My Other Bag Inc.'s motion for summary judgment on Louis Vuitton's trademark and copyright claims because use was a successful parody and constituted fair use).

⁶⁷*Louis Vuitton Malletier S.A. v. My Other Bag Inc.*, Case No. 16-0241-cv; Brief for Plaintiff-Appellant.

⁶⁸*Id.*

⁶⁹*Luxury Goods Int'l S.A. v. Jeanine Heller, d/b/a What About Yves*, U.S. District Court for the Southern District of New York, Case No. 1:15-cv-02967-NRB.

⁷⁰*Jordache Enters. Inc. v. Hogg Wyld Ltd.*, 828 F.2d 1482, 1491 (10th Cir. 1987) (affirming district court's finding of no trademark interference or dilution).

⁷¹*Jordache Enters. Inc. v. Hogg Wyld Ltd.*, 625 F. Supp. 48, 57 (D.N.M. 1985), *aff'd*, 828 F.2d 1482 (10th Cir. 1987) (emphasis added).

⁷²*World Wrestling Fed'n Entm't Inc. v. Big Dog Holdings Inc.*, 280 F. Supp. 2d 413, 441-442 (W.D. Pa. 2003) (finding no dilution or tarnishment since the Big Dog graphics were humorous and generally family-friendly, unlikely to create a negative association with WWE's marks).

⁷³*Tommy Hilfiger Licensing Inc. v. Nature Labs LLC*, 221 F. Supp. 2d 410, 422 (S.D.N.Y. 2002) (granting defendant's motion for summary judgment because of the light-hearted parody and failure to show impairment of Hilfiger's marks).

⁷⁴Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 Wis. L. REV. 625, 672-673 (2011) (internal citations omitted).

⁷⁵Deborah J. Kemp, Lynn M. Forsythe, & Ida M. Jones, *Parody in Trademark Law: Dumb Starbucks Makes Trademark Law Look Dumb*, 14 J. MARSHALL REV. INTELL. PROP. L. 143, 177 (2015).

⁷⁶Grinvald, *supra* n.74 at 627.