

# 16-0241-CV

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United States Court of Appeals  
*for the*  
Second Circuit

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LOUIS VUITTON MALLETIER, S.A.,

*Plaintiff-Appellant,*

– v. –

MY OTHER BAG, INC.,

*Defendant-Appellee.*

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

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**BRIEF FOR DEFENDANT-APPELLEE**

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## **CORPORATE DISCLOSURE**

Pursuant to Rule 26.1 of the Federal Rules of Appellate Procedure, counsel for Defendant-Appellee My Other Bag, Inc. certifies that My Other Bag, Inc. is a privately-owned corporation solely owned by Ms. Tara Martin, and that no parent corporation or publicly held corporation that owns 10% or more of My Other Bag's stock exists.

Dated: 8 August 2016

Respectfully submitted,

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## **STATEMENT OF THE ISSUES**

1. Did the district court correctly assess and balance factors in its analysis of Plaintiff-Appellant's Lanham Act, New York state law and Copyright Act claims, finding that no factor favored Plaintiff-Appellant?
2. Did the district court correctly find any use by Defendant-Appellee of Plaintiff-Appellant's trademarks and copyrights to be fair and protected pursuant to the asserted statutes and related caselaw?
3. Even though the district court drew the First Amendment into its analysis, should the First Amendment and related caselaw provide an independent ground for affirmance?
4. Should Plaintiff-Appellant's failure to prove the mark-versus-mark requirements of antidilution law provide an alternative ground for affirmance?

## **STATEMENT OF THE FACTS**

The operative facts in the present case are few and undisputed:

Plaintiff-Appellant Louis Vuitton Malletier, S.A. (“LV”) is a world-famous purveyor of high-priced designer handbags and other luxury goods. JA24. LV handbags often sell for thousands of dollars. JA171. Certain trademarks utilized by LV are famous (JA26), and have come to represent LV itself, along with the message that LV conveys: they are recognized as a sign of high fashion and luxury. JA25. LV invests substantial sums to maintain an image of exclusivity and wealth. CA97. LV is by its own description an “active[ ] and aggressive[ ]” enforcer of its intellectual property rights. CA77; SpA28.

Defendant-Appellee My Other Bag, Inc. (“MOB”) was founded in 2011 (CA105) by its CEO and sole employee Tara Martin, a self-confessed lover of designer handbags and LV products. JA116,342. MOB produces and sells canvas tote bags for between \$35 and \$55. JA116. The bags are designed to be washable, with a tag sewn inside reading in relevant part: “Hand Wash Cold / Dry Flat.” JA121-25. On one entire side of each of these bags in large stylized print is the phrase “My Other Bag ...”. JA121-125. On the other side is a cartoonish drawing of a designer handbag – with

respect to the products at issue, a depiction evoking an LV handbag. JA121-25.

The name “My Other Bag ...” was conceived in an email chain between MOB’s sole employee, Tara Martin, and the designer of the handbag drawings, Daniel Venzke, referring to the well-known bumper sticker and joke, “My other car . . . is a Jaguar” (or other luxury car). JA153-54. MOB’s concept and website play up the idea that while high-priced designer handbags are not used to carry groceries, gym clothes, or beach gear, MOB’s totes are. JA36.<sup>1</sup>

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<sup>1</sup> MOB intends to move the Court to accept the physical samples of LV handbags and MOB totes (JA121-25,1088-91) for comparison after briefing is complete.



**My Other Bag (Zoey – Tonal Brown) (SpA31)**



**My Other Bag (Zoey – Tonal Brown) (Reverse Side) (SpA31)**



**LV (Speedy Toile Monogram) (SpA30)**

## **SUMMARY OF THE ARGUMENT**

The district court's grant of summary judgment in MOB's favor and denial of partial summary judgment to LV was correct on all counts. The record firmly supports that MOB's tote bags are obvious parodies that are accorded robust protection under the First Amendment and relevant statutes.

MOB's parody is communicated to consumers with a combination of features of the bags themselves, including, for example, the large stylized text "My Other Bag ..." on one side, the cartoonish depictions of designer handbags on the other side, the plain canvas material, and the bag-on-bag concept itself. With its luxury products and associated advertising, LV delivers a meticulously crafted message of exclusivity, wealth and refinement. MOB is entitled to respond with its own counter-message and does so effectively with its parodies. Furthermore, MOB's message is inextricably tied to the joke embodied in its very name, "My Other Bag ..." – the name that it adopted prior to ever printing a single tote, long before LV cried foul.

The district court correctly concluded that MOB is entitled to summary judgment with respect to LV's federal and state dilution claims for multiple reasons. First, MOB's product is a parody explicitly excluded under 15 U.S.C. §1125(c)(3)(C). Within this, the district court correctly

determined that MOB does not use the various cartoon depictions on the side of its totes as source identifiers. Furthermore, in considering the statutory dilution factors through the lens of parody – similarly as the factors are in a likelihood of confusion analysis pursuant to *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961) (“*Polaroid*”) – the district court found that not a single factor favored LV. Based on the record evidence and cited legal authorities, it correctly concluded that there is no likelihood MOB’s use of the cartoon depictions in any way diminishes the distinctiveness of LV’s marks; if anything, the parodies enhance the famous marks’ distinctiveness. LV has provided no evidence otherwise. There is no likelihood of dilution.

The district court also correctly granted summary judgment in MOB’s favor as to the trademark infringement claims. As with the dilution factors, not a single *Polaroid* factor favored LV. Without a survey or any other evidence to support its claims, LV relied on transparent mischaracterizations of testimony and a few anecdotes from MOB tote owners that actually serve to indicate that consumers get the joke, and understand that MOB’s totes do not come from LV. Even years after MOB’s first sale, neither party is aware of a single instance of actual confusion. There is no likelihood of confusion,

and with no dispute as to any material fact, LV is not entitled to further burden MOB or waste the district court's valuable time with a trial.

Finally, the district court correctly granted summary judgment in favor of MOB on LV's copyright claim, concluding MOB is protected under the fair use doctrine. Once again, not a single factor in the district court's analysis favored LV. Any use by MOB of LV's copyrighted prints is clearly transformative and communicative, and LV provided no evidence to indicate otherwise. Alternatively, LV failed to show requisite "substantial similarity" between MOB's totes and LV's prints.

## ARGUMENT

This is not a mark-versus-mark case, as LV wrongly urges in its appellate brief. As the district court correctly perceived, it is *message versus message*.

The district court properly concluded from the undisputed record that LV – through its pervasive, global marketing campaign; the use of the trademarks and copyrights at issue on its high-end handbags, which can cost thousands of dollars; and its admittedly “aggressive” enforcement of its purported intellectual property rights – fights to “maintain” a brand message of “exclusivity and luxury,” of “wealth and expensive taste.” SpA2,22,28.

MOB, meanwhile, produces simple canvas tote bags that can be washed in the sink (“Hand Wash Cold / Dry Flat” (JA121-25)) with the text “My Other Bag ...” printed in large distinctive script on one entire side, and cartoonish drawings evocative of iconic handbags such as LV’s on the other. SpA2,31; JA121-25. The text and drawings presented together on a plain canvas bag comprise an obvious joke – a play on the classic bumper stickers on beat-up cars that read, for example, “My other car ... is a Jaguar” (SpA1) – playfully touting that the person toting the bag is really a person of status and refinement. That joke is only enhanced when the bag is full of the items

that MOB has designed them to carry: messy groceries, sandy beach towels, or sweaty gym clothes. SpA3-4.

Yet the simple joke is not all that MOB's bags communicate, and not all that MOB wanted or wants to communicate. JA337,366. The district court also correctly found that MOB's cheeky bag-on-bag concept embodied playful parodies of LV and its high-end handbag designs. SpA10. As LV's own authority on this appeal observed nearly fifteen years ago, such parodies "convey a *message*" – one that "may be simply that business and product images need not always be taken too seriously ... that we are free to laugh at the images and associations linked with the mark." *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 415 (S.D.N.Y. 2002) (emphasis added) ("*Tommy Hilfiger*"); Brief for Plaintiff-Appellant ("Br.") 51,57.

When trademarks such as LV's "enter our public discourse"; when they are "imbued with such expressive value" as LV's certainly are; when they have "taken on an expressive meaning apart from [their] source-identifying function"; then "applying the traditional test fails to account for the full weight of the public's interest in free expression." *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) ("*Mattel*"). As Judge Kozinski in *Mattel* observed, "Were we to ignore the expressive value that

some marks assume, trademark rights would grow to encroach upon the zone protected by the First Amendment.” *Id.*

The First Amendment – not to mention the Lanham Act and the Copyright Act – must and do protect our right to respond. Accordingly, the district court correctly determined from the undisputed record – and from LV’s failure to raise *any* material facts on MOB’s motion – that MOB was entitled to summary judgment on all claims. SpA28.

LV still doesn’t get it. Or maybe it does, and just can’t take it. Both at the district court and here, LV takes a shotgun approach in its arguments, blindly firing away and hoping something will hit the target. Most of its arguments are blatantly incorrect; all fail as a matter of law. Sometimes LV cites case law without any application to the facts at hand (which are dissimilar); sometimes LV recites facts and conclusions without any legal support (there is none); sometimes LV explicitly admits no confusion and then argues confusion; sometimes LV leaves out highly relevant snippets of deposition transcripts or decisions – maybe carelessly, maybe intentionally, but always conveniently; and sometimes LV advocates a position that was overturned by the Supreme Court in the most well-known parody decision of the twentieth century.

What LV *does not* do is cite a single time in its appellate brief the one case cited *passim* in its district court moving papers, *Louis Vuitton Malletier, S.A. v. Hyundai Motor Am.*, No. 10 Civ. 1611(PKC), 2012 WL 1022247 (S.D.N.Y. 2012) (“*Hyundai*”) – a decision that has earned only criticism from commentators and that the district court concluded it should not follow.

The chilling effect that LV’s litigation tactics have is no laughing matter. LV has wielded its limitless litigation budget undiscerningly, against counterfeiters and commenters alike, knowing that even if it is on the wrong side of both the facts and the law, its imposing reputation and bank account will most likely win the day. Here, however, the district court properly granted MOB summary judgment on all counts while also acknowledging both the parodic nature of MOB’s products and that *not a single one* of the Trademark Dilution Revision Act (15 U.S.C. §1125(c)) (“TDRA”), *Polaroid* or copyright fair use factors favored LV. SpA18-19,20-26,28

This Court should admonish LV’s brandishing of the Lanham Act, state antidilution law, and the Copyright Act in objectively unreasonable efforts to smother any response to its brand messages, especially MOB’s manifestly joking, parodic commentary here. LV’s appeal represents only the latest demonstration of how it has consistently failed to recognize the public’s right to comment, notwithstanding the ample education LV has

received from courts and leading commentators on the limits to a brand's trademark and copyright rights. The Court should affirm the district court's decision in its entirety – and further, it should recommend that the district court proceed with its examination of MOB's motion for attorney fees (No. 1:14-cv-03419-JMF, Dkt. No. 124).

## I. STANDARD OF REVIEW

With regard to dilution cases under the TDRA, the district court's decision is reviewed:

[A]s to each factor for clear error and its balancing of those factors *de novo*. See [*Tiffany (NJ) Inc. v. eBay Inc.*, 600 F.3d 93, 101 (2d Cir. 2010) (“*Tiffany*”)]; [*Starbucks Corp. v. Wolfe's Borough Coffee, Inc.* (“*Starbucks IV*”), 588 F.3d [97,] 105 [(2d Cir. 2009)]. Accordingly, the district court's factual findings regarding each factor bearing on the likelihood of trademark dilution by blurring will not be disturbed unless “on the entire evidence [we are] left with the definite and firm conviction that a mistake has been committed,” *United States v. Oehne*, 698 F.3d 119, 121 (2d Cir. 2012).

*Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 736 F.3d 198, 207 (2d Cir. 2013) (“*Starbucks VP*”).<sup>2</sup>

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<sup>2</sup> Cf. *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 155 (4th Cir. 2014) (noting that summary judgment under the TDRA is reviewed *de novo*, but that “the elements of the TDRA analysis are factual determinations” and thus “review[ing] the district court's factual findings for clear error and its legal conclusions *de novo*.”).

With regard to likelihood of confusion, LV's own authority holds that "[t]he fact that on summary judgment the evidence must be construed in a light favorable to the non-moving party does not modify" the "likelihood of confusion" standard, which requires a "probability of confusion, not a mere possibility." *Nora Beverages, Inc. v. Perrier Grp. of Am., Inc.*, 269 F.3d 114, 121 (2d Cir. 2001) (affirming summary judgment to defendant on trade dress infringement claim).

Additionally, "On appeal from a grant of summary judgment, the findings with respect to predicate facts underlying" individual factors of the test articulated in *Polaroid* "are reviewed with 'considerable deference' to the district court." *Playtex Prods., Inc. v. Georgia-Pacific Corp.*, 390 F.3d 158, 161 (2d Cir. 2004), citing *Patsy's Brand, Inc. v. I.O.B. Realty, Inc.*, 317 F.3d 209, 215 (2d Cir. 2003); *but see Opal Financial Group, Inc. v. Opalesque, Ltd.*, 634 Fed. Appx. 26, 27 n.1 (2d Cir. 2015) (applying "clear error" standard of review to each of the *Polaroid* factors in affirming summary judgment for defendant).<sup>3</sup>

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<sup>3</sup> LV cites the Supreme Court's decision in *Hana Financial, Inc. v. Hana Bank*, 135 S. Ct. 907 (2015), for the proposition that questions of commercial impression are "reserved for the jury." Br.3. This reliance is misplaced. First, the decision in *Hana* was limited to tacking (i.e., only a similarity analysis). Second, *Hana* explicitly notes numerous times that summary judgment in such a case is proper "[i]f the facts warrant it." *Id.* at 911-13. Third, LV moved for summary judgment itself on these very

“Although [copyright] ‘[f]air use is a mixed question of law and fact,’” this Court “has on a number of occasions resolved fair use determinations at the summary judgment stage where ... there are no genuine issues of material fact.” *Blanch v. Koons*, 467 F.3d 244, 250 (2d Cir. 2006) (affirming summary judgment to defendants on fair use defense) (citations omitted). An absence of genuine issues of material fact is especially frequent in copyright infringement actions, “because the works themselves, not descriptions or impressions of them, are the real test for claims of infringement.” *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 51 (2d Cir. 1986) (affirming summary judgment to defendants), *cert. denied*, 476 U.S. 1159 (1986).

Finally, the Court is “free to affirm a district court decision on any grounds for which there is a record sufficient to permit conclusions of law, even grounds not relied upon by the district court.” *Alfaro Motors, Inc. v. Ward*, 814 F.2d 883, 887 (2d Cir. 1987) (citations omitted).

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questions, as they pertain to dilution. Finally, LV should not presume its right to a jury trial in this case, as its principal dilution claims are equitable in nature. *See infra* n.8.

## II. THE DISTRICT COURT PROPERLY ACCORDED MOB FULL FIRST AMENDMENT PROTECTION

The district court correctly found that MOB's references to the LV marks were expressive nontrademark uses that qualified as parodies. SpA10. Affirmance of the district court's conclusions here is warranted.

As aptly summarized by Judge Leval in *Yankee Publ'g, Inc. v. New Am. Publ'g, Inc.*, 809 F. Supp. 267, 275-76 (S.D.N.Y. 1992) ("*Yankee Publ'g*"):

[T]he First Amendment confers a measure of protection for the unauthorized use of trademarks when that use is a part of the expression of a communicative message. Because the trademark law regulates the use of words, pictures, and other symbols, it can conflict with values protected by the First Amendment. The grant to one person of the exclusive right to use a set of words or symbols in trade can collide with the free speech rights of others.

In *Yankee Publ'g*, *New York Magazine* had used elements of the *Old Farmers Almanac*'s classic cover design on the cover of its own Christmas issue. Although *New York* "used" the *Farmer's Almanac* cover design (*Yankee Publ'g*, 809 F. Supp. at 269); though *New York*'s communicative expression suffered from "the obscurity of its joke" (*id.* at 280); and though its expressive message was "hybrid" and "intertwined" with "commercial

promotion” (*id.* at 276 (citation omitted)); none of this worked to deprive the defendant trademark “user” of First Amendment protections. Not only did Judge Leval find that there was neither confusion nor dilution; he ruled that even if there was some level of confusion or dilution, the First Amendment required that plaintiff’s trademark claims be dismissed nonetheless. *Id.* at 275.

The *Yankee Publ’g* decision is of substantial significance here, not simply because every aspect of its analysis is directly on point, but also because that decision followed both *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) and *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490 (2d Cir. 1989) (“*Cliffs Notes*”). Both of these decisions upheld First Amendment defenses even in mark-versus-mark settings (which is not present here). The approach of the Ninth Circuit, the other key Circuit to have actively examined and policed this issue, is entirely in line with Judge Leval. *See, e.g., Mattel*, 296 F.3d at 900.

The district court’s conclusions in favor of MOB’s speech hew closely to these First Amendment precepts, and should be affirmed. SpA12-13 (citing *Cliffs Notes*, 886 F.2d at 495-96 and *Yankee Publ’g*, 809 F. Supp. at 280).

LV admits that the Court “has ‘accorded considerable leeway to parodists whose *expressive works* aim their parodic commentary at a trademark or trademarked product’” (Br.39, *citing Harley-Davidson*, 164 F.3d at 812-13), but claims that “only successful, non-confusing parodies weigh against a finding of likelihood of confusion.” Br.57. This is plainly false. On the facts, no reasonable viewer could find that the MOB bags are not “expressive.” Canvas tote bags, t-shirts and baseball hats are now the standard vehicles of all kinds of expressive communication—political, cultural, and/or humorous. They are purchased for the messages that they bear. On the law, LV is plainly mistaken. As the district court noted, quoting *Yankee Publ’g*, “First Amendment protections do not apply only to those who speak directly, whose jokes are funny, and whose parodies succeed.” SpA13, *citing* 809 F. Supp. at 280.

LV’s claim that courts in this circuit “strictly distinguish between expressive and commercial uses where parody is claimed” (Br.57) would have a court favor trademark law over the First Amendment when messages contained both expressive and commercial elements. In fact, the opposite is true. When a “hybrid” work “combine[s] artistic expression and commercial promotion,” the Lanham Act should be construed to apply “only where the public interest in avoiding consumer confusion outweighs the publish

interest in free expression.” *Yankee Publ’g*, 809 F. Supp. at 276-77 (citing *Grimaldi*, 875 F.2d at 999). After all, only one of an expressive right and a trademark right is a constitutional right.

Where the use, as here, is not mark-versus-mark but message-versus-message—LV’s values message being addressed by MOB’s joking message about LV, which turns on the chasm between the parties’ products—there is no trademark law that will or should reach it.

### **III. SUMMARY JUDGMENT FOR MOB ON LV’S FEDERAL AND STATE DILUTION CLAIMS WAS PROPER**

This Court should affirm the district court’s federal and state dilution conclusions on four independent grounds. *First*, as noted by the district court, MOB’s totes embody “parod[ies]” of the LV marks (SpA10), which are excluded from being actionable under the TDRA (and by extension, New York’s antidilution law). *Second*, the graphic references to the LV marks are “noncommercial” uses excluded from actionability, to the extent MOB’s products “use” the marks at all. *Third*, LV has failed to show, as required under both the federal and state statutes, that MOB used the LV marks as an MOB mark. *Fourth*, the district court correctly concluded that LV had failed to raise any triable issue under a TDRA factor analysis. SpA18-19.

**A. MOB’s Parodies Are Protected Under 15 U.S.C. §1125(c)(3)(A)(ii)**

MOB’s parody is communicated to consumers with a combination of features of the bags themselves, including, for example, the large stylized text “My Other Bag ...” on one side, the cartoonish depictions of designer handbags on the other side, the plain canvas material, and the bag-on-bag concept itself. JA121-125. With its luxury products and the associated advertising, LV delivers a meticulously crafted message of exclusivity and flashy consumerism. MOB is entitled to respond with its own counter-message and does so effectively with its parody products, and it most certainly does so by “convey[ing] two simultaneous – and contradictory – messages: that it is the original, but also that it is *not* the original and is instead a parody.” *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260 (4th Cir. 2007) (“*Haute Diggity Dog*”) (citations omitted). This expressive message is inextricably tied to the joke embodied in its very name, “My Other Bag ...”, the name that it adopted prior to ever printing a single bag. JA153-54.

The district court properly found that MOB’s products qualified as “parod[ies]” of LV and its products – and that the cartoonish renderings on the side of MOB products are *not* used “as a designation of source” for

MOB's own goods. SpA10,14-15. See p. 38, *infra*; *Tiffany*, 600 F.3d at 93; *cf. Starbucks IV, supra* (plaintiff's "Starbucks" mark v. defendant's "Charbucks" mark); *Haute Diggity Dog, supra* ("Louis Vuitton" v. "Chewy Vuiton"). Thus, MOB's totes were "fair use[s]" of the LV marks and not actionable as dilution by blurring under 15 U.S.C. §1125(c)(3)(A)(ii). Contrary to LV's assertions, the Court properly recognized the MOB totes' parodic nature and expressive "use" of the LV marks – to the extent there was actual "use" at all – by examining the bags at issue themselves, from an objective "ordinary observer" standpoint. 4 J.T. MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION (4th ed. 2015) ("MCCARTHY") §31:153, at 31-362-63; SpA.10. The district court recognized that the bags are the bags – and they say what they say.

LV refuses to acknowledge that MOB's totes convey any expressive content or comment about LV and/or its patterns, light-hearted though the "critical bearing" may be. Br.39, *citing Campbell*, 510 U.S. at 584.

However, the parodic nature of the MOB products is clear (SpA1):

MOB's totes – indeed, its very name – are a play on the classic "my other car ..." novelty bumper stickers, which can be seen on inexpensive, beat up cars across the country informing passersby – with tongue firmly in cheek – that the driver's "other car" is a Mercedes (or some other luxury car brand). The "my other car" bumper stickers are, of course, a joke – a riff, if you will, on wealth, luxury brands, and the social expectations

of who would be driving luxury and non-luxury cars. MOB's totes are just as obviously a joke.

Remarkably, LV completely withdraws on appeal the unreported case on which it most heavily relied for these mistaken arguments: *Hyundai*, 2012 WL 1022247 (S.D.N.Y. 2012). First, the district court "easily distinguished" *Hyundai* on the instant record facts:

Here, unlike in *Hyundai*, it is self-evident that MOB did mean to say something about Louis Vuitton specifically. That is, Louis Vuitton's handbags are an integral part of the joke that gives MOB its name and features prominently on every tote bag that MOB sells.

SpA11-12. *See also Cliffs Notes*, 886 F.2d at 495-96 (2d Cir. 1989) (parody need not "make an obvious joke out of" subject to warrant protection); *Yankee Publ'g*, 809 F. Supp. at 280 ("obscurity of [defendant's] joke does not deprive it of First Amendment support").<sup>4</sup>

LV nevertheless insists here that MOB totes "compet[e] at the same level and quality as" LV handbags and that therefore they cannot "qualify as

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<sup>4</sup> Nor does LV challenge here the District Court's observation that *Hyundai*'s reading of the TDRA and this Court's precedents, including *Tiffany*, have been roundly criticized by commentators including Professor McCarthy, and that the district court would not have followed *Hyundai* even on similar facts. SpA12,13,n.4. LV can only hope to shield its dubious victory in *Hyundai* from this Court's review, to preserve the case as a cudgel for future demand letters against others.

parody” under the TDRA. Br.41, *citing Starbucks IV*, 558 F.3d at 113. But LV’s claim to be the senior marketer of “workhorse” (using the district court’s term, SpA10) canvas bags in this dispute (Br.8) “does not withstand even light scrutiny,” as the district court correctly found (SpA22). The district court properly found that whereas LV handbags are primarily status symbols designed to be “handle[d] with reverent care,” MOB totes are primarily “utilitarian bags ‘intended to be stuffed with produce at the supermarket, sweaty clothes at the gym, or towels at the beach.’” SpA10; *see also* JA36; *Cliffs Notes*, 886 F.2d at 492 (parody product costing double the price of original did not infringe).

**B. MOB’s Totes Are Protected As Noncommercial Uses Under 15 U.S.C. §1125(c)(3)(C)**

Second, the district court could have found on the undisputed record that any “use” of the LV marks on MOB’s totes is “noncommercial” in nature under 15 U.S.C. §1125(c)(3)(C), and thus not actionable. The Ninth Circuit in *Mattel* interpreted the Federal Trademark Dilution Act’s (“FTDA”) substantively identical “noncommercial use” provision broadly to preserve the constitutionality of the statute. *See Mattel*, 296 F.3d at 904-06 (“If speech is not ‘purely commercial’—that is, if it does more than propose a

commercial transaction— then it is entitled to full First Amendment protection.”) (citation omitted).

**C. LV Failed To Prove the TDRA’s Mark-Versus-Mark Requirement**

The TRDA requires that the defendant use the plaintiff’s marks *in its own mark*, i.e., as a source identifier. “[T]he owner of a famous mark”<sup>5</sup> is entitled to an injunction only against another person who

commences use of a *mark or trade name* in commerce that is likely to cause dilution by blurring . . . of the famous mark.

15 U.S.C. §1125(c)(1) (emphasis added). *Accord Tiffany*, 600 F.3d at 111-12 (affirming district court’s conclusion that plaintiff’s federal and state dilution by blurring claims failed “because eBay has never used the [Tiffany] Marks to refer to eBay’s own product”). As the district court found, MOB never used the LV marks as source identifiers for its own totes; MOB’s only “mark” was “My Other Bag . . .”. SpA.15,19,n.6. LV’s failure to show otherwise provides another ground for affirming the district court’s decision on both LV’s federal and state antidilution law claims.

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<sup>5</sup> MOB argued below that several of the asserted LV trademarks are not famous, including at least the Stylized Flower Trademarks and the Damier Trademark CA123-27; accordingly, dilution claims on them should fail.

While the district court did not reach this statutory analysis because of its “fair use” finding, it did observe that the “mark-versus-mark” construction “finds support in at least one prominent authority.” SpA9,n.2, *citing* MCCARTHY §24:122. Other prominent commentators have explicated the statute in the same way. “Dilution law ... should not reach every use that affects a mark’s *meaning*, lest it turn into an über-right that would defeat the very purpose of trademark laws.” S. Dogan & M. Lemley, *The Trademark Use Requirement in Dilution Cases*, 24 SANTA CLARA HIGH TECH. L.J. 541, 545 (2008) (“Dogan & Lemley”). Accordingly, “the only actionable ‘uses’ by a defendant of the plaintiff’s famous mark are those in which a defendant uses a trademark or trade name to identify and distinguish its own goods and services.” Dogan & Lemley 552. This interpretation is supported by the statutory text itself:

- The definition of “dilution by blurring” expressly compares “the similarity between a mark or trade name and a famous mark,” i.e., the similarity between two marks. 15 U.S.C. §1125(c)(2)(B),(C).
- “[M]ark” and “trade name” are each defined in 15 U.S.C. §1127, while “famous mark” receives a distinct definition in 15 U.S.C. §1125(c)(2)(A).
- Under 15 U.S.C. §1127, “mark” includes “trademark,” which includes “any word, name, symbol, or device, or any combination thereof ... [used] *to identify and distinguish his or her goods,*

including a unique product, from those manufactured or sold by others *and to indicate the source* of the goods....” (emphasis added).

The prior version of the statute, the FTDA, had created confusion over whether the law provided the owner of a famous mark with the right to an injunction against another person’s nontrademark use of the famous mark.

As McCarthy states:

The 2006 TDRA clarified any residual confusion about whether illegal dilution requires that the accused designation must be used as a trade mark or trade name. The statute makes it clear that a nontrademark and nontrade name use of the accused designation cannot dilute.

MCCARTHY §24:122. As Dogan & Lemley also note, “This reading is also consistent with House Chairman Lamar Smith’s statement that the bill did not break new ground, and represents a clarification of what Congress meant when it passed the dilution statute almost a decade ago.” Dogan & Lemley 553, n.58, *citing Trademark Dilution Revision Act of 2005: Hearing on H.R. 683 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary, 109th Cong. 2 (2005) (statement of Hon. Lamar S. Smith, Chairman, Subcomm. On Courts, the Internet and Intellectual Property).*

The Fifth Circuit has expressly recognized the logical statutory construction that requires a mark-versus-mark conflict. In *Nat'l Bus. Forms & Printing, Inc. v. Ford Motor Co.*, 671 F.3d 526, 536 (5th Cir. 2012), the Court held:

Under the TDRA, a “trade name” is “any name used by a person to identify his or her business or vocation,” while the term “trademark” denotes “any word, name, symbol, or device ... used by a person ... to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods.” 15 U.S.C. § 1127. We agree with the district court that NBFPI did not “use” Ford’s marks (as the TDRA contemplates that term) in identifying or distinguishing its own goods or services merely by reproducing them for customers as part of its commercial printing business.

*Id.*, citing *Dogan & Lemley* 551-52. See also *Haute Diggity Dog*, 507 F.3d at 266; B. Beebe, *A Defense of the New Federal Trademark Antidilution Law*, 16 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 1143, 1165-66 (2006).

Meanwhile, the Second Circuit has construed the statutory text in the same manner. For instance, in *Starbucks VI*, 736 F.3d at 213, the Circuit noted that the case concerned the plaintiff’s “famous ‘Starbucks’ marks” and the defendant coffee roasting company’s “Charbucks” marks.

The Second Circuit has also long construed New York General Business Law §360-1 to require a likelihood of dilution of the plaintiff’s

mark by the defendant's mark. See, e.g., *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1029 (2d Cir. 1989) (stating that "the marks must be 'very' or 'substantially similar'"), and as such LV's claim should fail here as well.

Significantly, the district court also noted that the *Hyundai* decision urged by LV on this issue has been pointedly criticized by McCarthy as "ignoring the statute" and proceeding as if use of the plaintiff's mark in the defendant's mark "is not required" under the law. SpA9,n.2 (citations omitted). This Court should reiterate the statutes' operation and reject LV's effort expand the sweep of federal and state antidilution laws.

#### **D. The District Court Correctly Found No Likelihood of Dilution**

LV fundamentally misunderstands (or perhaps intentionally misstates) the concept of dilution. As the district court correctly stated at the outset of its analysis (SpA6,16), dilution by blurring is harm to a famous mark's "ability ... to clearly and unmistakably distinguish one source." *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 506 (2d Cir. 1996) (citation omitted) ("*Hormel*"). LV argues that so long as there is *any* type of "association" between MOB products and LV, a likelihood of dilution exists. Br.18. However, "[b]lurring" is not a necessary consequence of

mental association.” *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 434 (2003). “‘Association’ is a necessary condition of, but not equivalent to, dilution by blurring . . . . Even if there is proof of a likely association, that does not mean that there is also a likelihood of dilution by blurring.” MCCARTHY §24:116 (*quoted in SpA16-17*) (emphasis added). As the district court recognized, the question here is *not* whether there is an association between MOB’s totes and LV’s marks, but whether that association is “the *kind* of association [that] is likely to impair the distinctiveness of LV’s marks.” SpA17. It undoubtedly *is not*. As the record below clearly shows, the parodic association present here in no way diminishes the distinctiveness of LV’s marks.<sup>6</sup>

*1. The District Court Properly Considered the Parodic Nature of MOB’s Messages in the TDRA Analysis.*

This Court has held that while the six TDRA factors may be useful, the analysis “must ultimately focus on ‘whether an association, arising from the similarity between the subject marks, impairs the distinctiveness of the

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<sup>6</sup> See JA407, deposition testimony of MOB’s designer Daniel Venzke, stating that “[w]e are hoping that when people see the cartoon image of our bag on the bag that they understand that, yes, we are poking fun at a Louis Vuitton Speedy bag.”

famous mark.” *Starbucks VI*, 736 F.3d at 204. LV states, without citing any authority, that “parody does not change the analysis.” Br.32. LV is wrong.<sup>7</sup>

As described by the district court, in *Haute Diggity Dog*, LV brought a dilution action against the maker of dog toys utilizing the trademark “Chewy Vuitton.” 507 F.3d 252. While the district court in *Haute Diggity Dog* did not premise its decision on the parody provision of the TDRA, due to its finding that defendants used the “Chewy Vuitton” phrase as a mark (507 F.3d at 266), the circuit court concluded that the TDRA “does not preclude a court from considering parody as part of the circumstances to be considered for determining whether the plaintiff has made out a claim for dilution by blurring.” 507 F.3d at 266-67. As noted by the district court in following the *Haute Diggity Dog* TDRA analysis, the six statutory factors “are only guideposts,” and “the statute calls for consideration of ‘all relevant factors’, including the six factors supplied in §1125(c)(2)(B), with respect to several of which the use of a mark as parody is ‘specifically relevant.’”

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<sup>7</sup> Parody is expressly recognized as an “EXCLUSION[ ]” from actionable dilution, not as a “defense” to an otherwise viable cause of action as LV mistakenly claims. Br.32; 15 U.S.C. §1125(c)(3), (c)(3)(A)(ii). The exclusion encompasses parodies “other than [those used] as a designation of source”; but it does not cabin *all* potential parodic references to a plaintiff’s mark. 15 U.S.C. §1125(c)(3)(A).

SpA8,17 (citing *Haute Diggity Dog*, 507 F.3d at 267) (internal quotations omitted).

In *Starbucks IV*, this Court quoted at length from *Haute Diggity Dog*, but concluded that “Black Bear’s use of the Charbucks Marks is not a parody of the kind which would favor Black Bear in the dilution analysis even if we were to adopt the Fourth Circuit’s rule,” because “the Charbucks parody is promoted not as a satire or irreverent commentary of Starbucks but, rather, as a beacon to identify Charbucks as a coffee that competes at the same level and quality as Starbucks in producing dark-roasted coffees.” 588 F.3d at 112-13. At play here, however, are “MOB’s inexpensive workhorse totes and the expensive handbags they are meant to evoke,” which exude an “image of exclusivity and refinery that Louis Vuitton has so carefully cultivated [that] is, at least in part, the brunt of the joke.” SpA10. Concisely put, this *is* “irreverent commentary,” and “a parody of the kind which would favor [MOB] in the dilution analysis.”

LV would have this Court reduce dilution by blurring analysis to a mandatory black-letter checklist, in contravention to the statutory text. 15 U.S.C. §1125(c)(2)(B) (“the court may consider *all* relevant factors”) (emphasis added). “Like a signpost pointing in the wrong direction,” focusing exclusively on “the list of factors directs attention away from the

key issue of whether there is a likelihood of damage to the famous mark.” MCCARTHY §24-119. As conceded by LV itself, the statutory factors are *non-exclusive*, and as noted by the district court, the TDRA on its face refers to the consideration of *all* relevant factors. SpA17. LV also fails to appreciate that the TDRA expressly subjects the cause of action for injunctive relief “to the principles of equity”—i.e., it confers courts with wide latitude to evaluate the facts.<sup>8</sup>

Parody and, for that matter, humor, are most certainly relevant.<sup>9</sup> In cases of parody “the use of famous marks ... causes no loss of distinctiveness, since the success of the use depends upon the continued association of the mark with the plaintiff” (*Yankee Publ’g*, 809 F. Supp. at 282 (citation omitted))—and without a loss of distinctiveness there can be no

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<sup>8</sup> Indeed, pursuant to the statutory references to “the principles of equity,” query whether LV would be entitled to a jury trial on its dilution claims *at all*. 15 U.S.C. §1125(c)(1), (c)(5); *See Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.*, 955 F. Supp. 598, 605 (E.D.Va. 1997) (plaintiff not entitled to jury trial on FTDA dilution by blurring claim), *aff’d on other grounds*, 170 F.3d 449 (4th Cir.1999), *cert. denied*, 528 U.S. 923 (1999).

<sup>9</sup> An examination of the facts using the non-exclusive TDRA factors need not be rigid and formalistic. The court is not limited to parody when analyzing the TDRA factors. The court is free to consider humor, farce, irony, or any other contextual cue that informs its analysis in answering the ultimate question of whether the defendant’s use is likely to diminish the distinctiveness of the plaintiff’s mark.

dilution. This Court has held that “spoofs” and parodies “tend[ ] to increase public identification” with the plaintiff’s mark, and that such strengthening “undermines any superficial similarities the marks might share.” *Hormel*, 73 F.3d at 506 (quoting *Jordache Enters. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1490 (10th Cir. 1987)). The fact that the TDRA has enumerated a list of nonexclusive factors does not change this.

The Fourth Circuit is not alone in its view that the parodic nature of a defendant’s mark should be considered in the TDRA factor analysis. The preeminent trademark commentator in the United States agrees, stating that “[a]n example of where ‘association’ is not synonymous with ‘blurring’ is the use of parody marks.” MCCARTHY §24:116, citing *Haute Diggity Dog*, *supra*.

Furthermore, while there is no “parody” or similar factor enumerated amongst the eight nonexclusive *Polaroid* factors that this Court recommends to evaluate whether a likelihood of confusion exists (*see* p. 45, *infra*), the Court has acknowledged that “the *Polaroid* test is at best awkward in the context of parody,” and the “factors should be applied with proper weight given to *First Amendment* considerations.” *Cliffs Notes*, 886 F.2d at 495 n.3. *See also Tommy Hilfiger*, 221 F. Supp. 2d at 416 (“comical adaptation” can result in “no confusion”); *Hormel*, 73 F.3d at 497 (considering parody in the

*Polaroid* analysis). There is no reason to treat the TDRA any differently. The Court should affirm the district court’s recognition that “parody is relevant to the overall question of whether the defendant’s use is likely to impair the famous mark’s distinctiveness” (*Haute Diggity Dog*, 507 F.3d at 267).

2. *Each TDRA Factor Favors MOB.*

The district court properly found that, even if MOB’s totes did not qualify as fair use as a matter of law (which they did), each of the nonexclusive factors under 15 U.S.C. §1125(c)(2)(B) would favor MOB and entitle it to summary judgment. SpA16.

With regard to the similarity between plaintiff’s and defendant’s marks (factor (i)), the district court recognized that while MOB has “mimicked the famous marks[,] it did not come so close to them as to destroy the success of its parody and, more importantly to diminish the LVM marks’ capacity to identify a single source.” SpA18, *quoting Haute Diggity Dog*, 507 F.3d at 267. This is because “as they are presented to consumers,” the marks are, if anything, only *minimally* similar. *See Starbucks IV*, 588 F.3d at 106 (affirming the factual factor finding of the district court that the

marks “Starbucks” and “Charbucks” were only minimally similar; applied to the dilution context in *Starbucks VI*, 736 F.3d at 208).<sup>10</sup>

MOB does not contest the distinctiveness (factor (ii)), exclusive use (factor (iii)), or recognition (factor (iv)) of LV’s famous marks. However, the district court properly recognized that “as in *Haute Diggity Dog*, that fame and recognition only make it *less likely* that MOB’s use would impair the distinctiveness of Louis Vuitton’s marks.” SpA18. *See also Haute Diggity Dog*, 507 F.3d at 267 (“[B]ecause the famous mark is particularly strong and distinctive, it becomes more likely that a parody will not impair the distinctiveness of the famous mark.”).

With regard to factors (v) and (vi) related to the intent to create an association and actual association between the marks, the district court correctly observed any evidence of an association is not automatic evidence

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<sup>10</sup> The “minimal similarity” analysis of the *Starbucks* cases is directly on point here. In *Starbucks*, the uses in question shared the “arbucks” letters and were both used on coffee. But because the “Charbucks” mark was presented “in packaging that displays the ‘Black Bear’ name in no subtle manner” (“My Other Bag...” is sprawled in large letters on an entire side of each MOB tote), and because “the packaging also makes clear that Black Bear is a ‘Micro Roastery’ located in New Hampshire” (each MOB product includes text in large letters on an inside surface reading “Designer Handbag Junkies Gone Environmentally Conscious” and “Made in Los Angeles ♥”), this Court upheld the District Court’s factual finding of minimal similarity. *Starbucks IV*, 588 F.3d at 106; JA121-125.

of impairment of the senior mark's ability to function as a source identifier. SpA16. This observation is especially relevant here, where the association between MOB's bags and the LV marks does not cause *any* loss of distinctiveness, but actually "enhance[s] the famous mark's distinctiveness" by acknowledging its claimed status "as an icon." *Haute Diggity Dog*, 507 F.3d at 267.

And, as the district court again recognized, "if anything, MOB *distances* itself from Louis Vuitton even more than Haute Diggity Dog did, as the very point of the "my other bag" gimmick is that the MOB tote is *not* a Louis Vuitton handbag." SpA19 (emphasis added). Thus, any "increased burden" LV faced to demonstrate a likelihood of its marks' impairment, as it faced in *Haute Diggity Dog* (SpA18), was not "because it [LV] owns famous marks," as it mistakenly contends (SpA26; Br.26), but rather, because of the nature of the *association* between the LV marks *and MOB's parodies of them*. *Cf. Savin Corp. v. Savin Grp.*, 391 F.3d 439 (2d Cir. 2004) (Br.31) (parody not at issue).

3. *LV Did Not Present a Scintilla of Evidence of a Likelihood of Dilution, and has Admitted a Lack of Any Actual Dilution*

Even if an analysis of the TDRA factors favored LV, which it does not, LV's dilution claims suffer from yet another fatal flaw. While LV provides conclusory analysis of each of the six statutory TDRA factors, it does not provide a scintilla of *actual* evidence that there is any likelihood of damage to its marks. The TDRA, however, "explicitly requires proof of the likelihood that this defendant's use impairs the distinctiveness of the famous mark." SpA16 (internal quotations omitted) (*quoting* MCCARTHY § 24:116). *See, e.g., Miss Universe, L.P., LLLP v. Villegas*, 672 F. Supp. 2d 575, 594-95 (S.D.N.Y. 2009) ("Miss U.S.A." versus "Miss Asia USA": "Given the conspicuous absence of evidence on this record, the defendants are entitled to judgment on Miss Universe's federal dilution claim.").

Indeed, the most glaring record evidence is that showing there is *no* likelihood of dilution: it has admitted that it is aware of *no facts* that would indicate such a likelihood. CA-10:18-22 (deposition of John Maltbie, Louis Vuitton North America, Inc. Director of Intellectual Property).

## E. LV Attempts to Trade on a Series of Unprincipled Confusions

### Confusion #1: LV's "Designer Handbag Junkie" Red Herring

LV would have the Court believe that because MOB used phrases like “ode to handbags women love” (Br.5,9,10,25,41) and “designer handbag junkie” (Br.41) that it could not possibly be parodying LV. Just as it contorts dilution law, LV also fundamentally misunderstands parody. Parody is not limited to objects of ridicule or scorn; it can also target people and things that we love.<sup>11</sup>

There is also a much simpler, but no less correct, reason that LV's claim fails. Following *Cariou v. Prince*, 714 F.3d 694, 707 (2d Cir. 2013), *even if* Ms. Martin herself “[did not] really have a message” (*id.*) (she did), and *even if* she did not “claim[ ] that [the works] were satire or parody” (*id.*) (she did), summary judgment for MOB is proper if the parodic nature of its totes “may reasonably be perceived.” *Id.*, quoting *Campbell*, 510 U.S. at 582. Not only “may” it be reasonably perceived; the district court found it

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<sup>11</sup> LV focuses on MOB's statement regarding an “ode” as if such a compliment precludes parody. Parody “comes from the Greek *parodeia*,” which “joins the Greek words for ‘beside’ and ‘to sing’ -- the roots of our prefix ‘para’ and our word for a lyric poem, ‘ode.’” *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429, 1440 (6th Cir. 1992) (citations omitted).

“readily so perceived.” SpA25 (quoting *Tommy Hilfiger*, 221 F. Supp. 2d at 420) (emphasis added).

### Confusion #2: LV’s “Post-Litigation Tactic” Theory

LV also incorrectly contends that MOB’s claim of parody is a “post-litigation tactic.” Br.19-24. LV cannot wish away this inconvenient fact: the name of the company is and has always been My Other Bag. It adopted this name concurrently with its conception of the parody products that would bear the eponymous mark, years before LV sent its initial cease-and-desist letter. CA105; JA153-54. That is, the joke with its attendant message is as old as the company itself; it was not created out of thin air in response to this lawsuit as LV suggests. JA157.

LV’s claims fail for further reasons:

- *Salinger v. Colting*, 607 F.3d 68, 83 (2d Cir. 2010) (Br.54) is inapposite, as the record evidences MOB’s parodic intent from the company’s inception.
- And in any event, creator’s intent is of limited (if any) probative value. *See Cariou v. Prince*, 714 F.3d 694 at 707.

Confusion #3: LV's 'Designation of Source' Mischaracterizations

LV argues that MOB is not entitled to a fair use finding under 15 U.S.C. §1125(c)(3)(A) because MOB allegedly uses the cartoonish depictions on its bags as source identifiers. Br.36-39. The district court saw through LV's ruse. SpA15.

As it did in its briefs to the court below, LV seeks to refute plain evidence of nontrademark use (namely, the bags themselves) with a snippet of deposition exchange between MOB CEO Tara Martin and counsel for LV. Br.37. In its district court brief, LV produced only the first Q/A below, and was scolded by the district court for relying "on a single, mischaracterized citation to the record." SpA15.

On appeal, LV relies on the same citation, albeit with several more lines of Mr. Martin's testimony from the same exchange. Yet it continues to leave out portions (shown below in bold):

Q: Well, when you say people look at these things and they understand what they are, would you agree with me that the depictions of Louis Vuitton bags that you use on those totes that have depictions of Louis Vuitton bags are depictions, pictures you use in order for people to understand that the product comes from you, My Other Bag?

A: Yes. People know that the product comes -- people know that our tote bags with those depictions come from My Other Bag.

Q: So when they see one of these depictions, a customer or a consumer will say, "Aha, there is My Other Bag." Correct?

**A: If they see our tote bags.**

**Q: Right, with these depictions.**

A: Yes. They would recognize the tote bags as, you know, from My Other Bag.

Q: Right. And the reason they would know that is they would recognize the depictions as designating My Other Bag; right?

**A: They would recognize it in multiple ways.**

**Q: But that's one of them?**

A: That they would recognize the depictions.

Q: We were talking a little while ago about somebody seeing one of these bags as they're going down the street; right? And you're saying there's no confusion. So is it fair to say that in your estimation – in your estimation and your intent is that people who see these depictions on the side of the bag say to themselves, “Aha, My Other Bag”?

Counsel for MOB: Objection. Compound.

A: We've done everything to do our brand “My Other Bag.” It says it on the back. It says it on the front, but it is a parody of these other handbags.

JA350-51.<sup>12</sup>

“[I]t is plain that Martin's sole point was that she did not believe that consumers were confused about who produces MOB's tote bags.” SpA16.

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<sup>12</sup> Counsel for LV continued this line of questioning; even he did not consider there to be any admission.

The deposition testimony does not contradict what the bags themselves show: the text “My Other Bag...” serves as *the* source identifier.

Also as noted by the District Court, MOB bags include the text “My Other Bag...” in large stylized font sprawled over one entire side. SpA15. Here, “non-trademark use of the challenged” depictions is “evidenced by the fact that the source of the defendant[’s] product is clearly identified by the prominent display of the defendant[’s] own trademarks.” *Cosmetically Sealed Indus. v. Chesebrough-Pond’s USA Co.*, 125 F.3d 28, 30 (2d Cir. 1997). The depictions on MOB’s products “do not serve as a trademark” here because “there is also a conspicuously visible trademark that clearly serves that function.” *Dessert Beauty, Inc. v. Fox*, 568 F. Supp. 2d 416, 424 (S.D.N.Y. 2008) (Chin, J.).

Lastly, the text “My Other Bag ...” is identical from MOB product to MOB product, but there are “differing caricatures on the other side.” SpA15. “[T]he fact that the bags evoke a range of luxury brands” – Louis Vuitton, Fendi, Chanel, and others – “with different graphics” (SpA) interchangeable with one another clearly indicates nontrademark use. An image “becomes a symbolic identifier of a product or product line through repetition” (*Kelly-Brown v. Winfrey*, 717 F.3d 295, 310 (2d Cir. 2013)) – repetition that is not

present here. “[A] designation is not likely to be perceived as a mark of origin unless it is repetitively used.” MCCARTHY §3:3.

Confusion #4: LV’s Mischaracterizations of *Starbucks*

Throughout its brief, LV cites to *Starbucks IV* to support its misapplication of the designation of source exclusion. However, the facts here are readily distinguishable. For example, while the “Char” in “Charbucks” was suggestive of the darkness of defendant’s own coffee (*see* 588 F.3d at 103); MOB’s graphic depictions are in no way descriptive of its own bags (indeed, quite the opposite). Additionally, whereas “Wolfe’s Borough” and “Charbucks” were unrelated, “My Other Bag...” affirmatively disclaims the cartoon depictions. *See* SpA15.

The District Court properly recognized that LV has offered no evidence that the various cartoonish depictions on the side of MOB’s bags serve any source-identifying function whatsoever, and that record evidence and legal authority indicates otherwise.<sup>13</sup>

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<sup>13</sup> Further, “if it takes extended analysis and legalistic argument to attempt to prove that a designation has been used in a trademark sense, then it has not.” MCCARTHY §3:3, citing *In re Moody’s Investors Service Inc.*, 13 U.S.P.Q. 2d 2043, 2047 (T.T.A.B. 1989).

### Confusion #5: LV's Misstatements on Parody Targets

LV asserts that it is not “essential to the joke,” and that “there is no ‘joke’ specific to Louis Vuitton or requiring the use of the Louis Vuitton trademarks,” and as such it is shielded from MOB’s comment. Br.40-41. However, it is clear that MOB *does* say something about LV. SpA11-12; *see also Cliffs Notes*, 886 F.2d at 492 (Spy Notes parodied both the summarized works and Cliffs Notes).

LV also asserts that “Ms. Martin admitted that the ‘my other bag’ trope [did not comment] on Louis Vuitton” (Br.40), but it cites to none of Ms. Martin’s actual words. In any event, Ms. Martin made clear numerous times her intent to parody LV: “Louis Vuitton is luxury and finely crafted ... [a]nd they are thousands of dollars and they’re a status. And this is, you know, a funny play and social commentary on that materialism and status.” JA364; *see also* JA365-368.

With regard to LV’s continued assertion commentary on its marks was not “necessary” because “[a]ny famous luxury handbag would, and did, suffice” (Br.40), this is simply nonsense, as the District Court recognized. SpA14 (MOB’s “parody must evoke at least one of a finite set of marks in order to make its point”).

Confusion #6: LV's False "Heightened Standard for Famous Marks"

LV attempts to cast the District Court's decision as imposing a higher burden upon "ultra-famous" marks (Br.31), yet in typical fashion has not provided a single quote supporting its argument. LV would have the Court believe that the District Court would have applied the same analysis in a case against Louis Vuitton Chewing Gum or Louis Vuitton Dry Cleaners. The District Court would not have done so: MOB's evocation is "quite different from the hypothetical seller of 'Buick aspirin tablets.'" SpA19. Instead, the District Court properly held that 1) the TDRA requires a likelihood of a loss of distinctiveness, and 2) the parodic nature of a product can cut against such a likelihood. This is because "the use of famous marks in parodies causes no loss of distinctiveness, since the success of the use depends upon the continued association of the mark with the plaintiff" and "because the brunt of the joke becomes yet more famous." *Yankee Publ'g*, 809 F. Supp. at 282 (citation omitted); SpA18 (citing *Haute Diggity Dog*, 507 F.3d at 267).

**IV. SUMMARY JUDGMENT TO MOB ON LV'S TRADEMARK INFRINGEMENT CLAIMS WAS PROPER**

Likelihood of confusion is "is a matter of law" (*Starbucks IV*, 588 F.3d at 109), and as such is ripe for summary adjudication where, as here,

“the admissible evidence and the pleadings demonstrate ‘no genuine dispute as to any material fact.’” SpA4. “In moving for summary judgment against a party who will bear the ultimate burden of proof at trial, the movant’s burden will be satisfied if he can point to an absence of evidence to support an essential element of the nonmoving party’s claim.” *Goenaga v. March of Dimes Birth Defects Found.*, 51 F.3d 14, 18 (2d Cir. 1995) (citations omitted) (*quoted in SpA4*).

**A. LV Failed to Meet the Lanham Act’s Threshold Requirements**

The District Court properly held that, viewing all facts in the light most beneficial to defendant, MOB was entitled to summary judgment based upon an analysis of the traditional *Polaroid* factors. SpA19-26. The District Court’s holding was proper; that said, it did not even have to perform a *Polaroid* analysis to grant MOB’s motion. LV has cited *Mana Products v. Columbia Cosmetics Mfg.*, 65 F.3d 1063, 1069 (2d Cir. 1995) for the proposition that likelihood of confusion is a question of fact for the jury. First, *Starbucks IV*, decided after *Mana*, makes clear that this is not the case – likelihood of confusion is a matter of law. Second, *Mana* upheld summary judgment for defendant *without a Polaroid analysis or reaching likelihood of confusion*. The lesson of *Mana* is clear: because LV has failed to meet the

threshold issues of MOB's "use" of its trademarks, or any "false designation of origin," it is not entitled to a likelihood of confusion inquiry. Summary judgment is proper for this reason alone.

**B. The Court Properly Found No Likelihood of Confusion**

In describing the present case, LV states:

The consumer often *knows* that the junior use is from a different source, but wants the fame the trademark conveys while buying the junior user's products. This is exactly what happened here.

Br.35 (underline added).

MOB has been selling its parody bags for years; if any confusion was even possible, it would have happened before now. And, yet, LV has produced not a shred of evidence of confusion. Indeed, LV has admitted repeatedly, it knows that consumers are not confused. CA167-68. Even without these admissions, summary judgment to MOB was warranted based on this Court's *Polaroid* framework.

To succeed on a Lanham Act claim for trademark infringement, a plaintiff must prove that "*numerous* ordinary prudent purchasers are likely to be misled or confused as to the source of the product in question," or as to the "sponsorship, affiliation, connection, or identification" of the relevant marks. *Time Inc. v. Petersen Publ'g Co.*, 173 F.3d 113, 117 (2d Cir. 1999)

(emphasis added); *Star Indus. v. Bacardi & Co.*, 412 F.3d 373, 383 (2d Cir. 2005). The burden of proving likelihood of confusion lies with the party charging infringement. “A probability of confusion, not a mere possibility, must be found to exist.” *Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072, 1077 (2d Cir. 1993).

The Second Circuit uses the well-established multi-factor test described in *Polaroid*, 287 F.2d 492 at 495. When a defendant’s use is parodic, as is the case here, the factors must be analyzed through the lens of the First Amendment. “[T]he *Polaroid* factors should be applied with proper weight given to First Amendment considerations,” since a parody “convey[s] two simultaneous – and contradictory – messages: that it is the original, but also that it is not the original and is instead a parody.” *Cliffs Notes*, 886 F.2d at 490 (2d Cir. 1989); *Haute Diggity Dog*, 507 F.3d at 260; *see also Hormel, supra*. The *Tommy Hilfiger* Court has integrated parody into its factor analysis under a common-sense approach:

[E]ven without recourse to the First Amendment, a comical adaptation (can still be) relevant to the extent that the joke is clear enough to result in no confusion under the statutory likelihood of confusion analysis. In such cases, 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 as to source, sponsorship or approval.

221 F. Supp. 2d at 410 (citation omitted).

After finding that not a single one of the eight *Polaroid* factors favored LV, the District Court concluded that “there is no triable issue of fact on the likelihood confusion. Rather, a defendant’s use of the mark is an obvious parody or pun, readily so perceived, and unlikely to cause confusion among consumers.” SpA25 (quoting *Tommy Hilfiger*, 221 F. Supp. 2d at 420). LV offers *no* evidence to refute the Court’s findings or conclusion.

**Strength of the Marks:** In this case, the District Court understood that the strength of LV’s marks makes confusion unlikely. “The strength and recognizability of the mark may make it easier for the audience to realize that the use is a parody and a joke on the qualities embodied in trademarked word or image.” *Id.* at 20 (quoting *Tommy Hilfiger*, 221 F. Supp. 2d at 420). Here, the fame of LV’s marks aids consumers in quickly recognizing that MOB is making a joke, a counter-message, about the physical differences between the MOB tote bags and the LV designer handbags in response to LV’s message of exclusivity and prestige. Because the strength of LV’s marks make it more likely that a consumer will recognize MOB’s products as parody, this factor favors MOB.

**Similarity of the Marks:** MOB intends similarities between the cartoon depictions on the side of its totes and the actual designer handbags depicted. These similarities are necessary for the parody, which must

simultaneously convey that it refers to the original but that it is not the original. *Cliffs Notes*, 886 F.2d at 494. MOB uses these recognizable cartoonish renderings of various designer handbags as part of its joke in which viewers are invited to consider the *differences* between MOB's casual totes and the designer handbags rather than any similarities. The District Court recognized some of these obvious differences. SpA21. The similarities and the differences in the context of parody favor MOB. LV offers *nothing* to convince otherwise.

**Proximity of the Products:** Here, there is an absence of proximity of the products or competitiveness with one another. While both LV and MOB products serve the practical function of holding items, both primarily perform a social display function which is value-expressive. The values expressed by the respective products are in stark contrast, as are the prices for which they are sold: the My Other Bag Products at Issue retail for \$35 to \$55, while the average price of the LV Products is over \$1,000. JA116,171. While LV argues that there is a close proximity of the products since many of its bags are “casual” and made of canvas, “that claim does not withstand even light scrutiny.” SpA22. “In short, MOB’s bags are in no meaningful sense ‘competitive’ with Louis Vuitton’s designer handbags.”

In struggling to make its case that the products are proximate, LV mischaracterizes *Nikon, Inc. v. Ikon Corp.*, 987 F.2d 91 (2d Cir. 1993). Under the *Nikon* Court’s analysis of the *bridging the gap* factor, the court states that “*if* there is already an overlap in the market, the likelihood of confusion is greater.” *Id.* at 95 (emphasis added). This says nothing about “targeted consumers” as LV states. Br.52. And, as the District Court recognized, the evidence establishes that the products are clearly not competitive with one another. *See* SpA22. As such, the court correctly found that this factor favors MOB.

**Bridging the Gap:** The evidence shows that LV is highly unlikely to “bridge the gap” and develop a product for sale in MOB’s market. Indeed, they seem be moving in the opposite direction. With the recent “launch of a new line of handbags (with an individual price tag of USD \$40,000) ... [LV] has repositioned to protect and elevate its legendary status. This strategy signifies a move to resolve the tensions between.” JA131. LV is cutting back on less expensive merchandise (*see id.*), indicating that it has no intentions of entering into MOB’s market “by selling casual parody totes at low price points.” SpA22.

Nevertheless, LV again mischaracterizes the record by referring this Court to its “Monogram Sponge” bag which allegedly “has an artist’s

rendering of a Louis Vuitton handbag on one side.” Br.9. Yet a simple inspection of a photograph of this bag next to other bags from LV’s line very clearly shows that the Monogram Eponge does not depict “a Louis Vuitton handbag on one side,” but actually depicts a pocket present on the side of many other LV products:



This is not “bag-on-bag” (where are the handles?); it is “pocket-on-bag.”

With no credible evidence in LV’s favor, the District Court correctly found that this factor favors MOB.

**Actual Confusion:** LV has not shown, nor can it show, any actual consumer confusion as to the source or sponsorship of My Other Bag’s products. CA167-68. This factor carries significant weight here.

If consumers have been exposed to two allegedly similar trademarks in the marketplace for an adequate period of time and no actual confusion is detected either by survey or in actual reported instances of confusion, that can be powerful indication that the junior trademark does not cause a meaningful likelihood of confusion.

*Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 228 (2d Cir. 1999) (citation omitted). As of early 2015, MOB had sold about 10,000 units of the Products at Issue, with some of these products having been on the market for about two years. JA116. “As the duration of non-confusing coexistence stretches into years, the force of the inference [of no confusion] strengthens.” MCCARTHY §23:18. LV has acknowledged that it is unaware of *any* actual confusion by a consumer or potential consumer. CA167-68. It has not received a *single* consumer communication with regard to confusion, endorsement, or association with respect to the present case. *Id.* Not a single customer has complained to MOB that it expected to receive a Louis Vuitton product after ordering a tote from MOB. JA117.

Most startling, even the litigation-savvy Louis Vuitton has failed to provide any survey evidence of confusion. This is not because LV could not afford to conduct such a survey; it has and does conduct such surveys when it believes the results will support its position. *See LV v. Dooney & Bourke, Inc.*, 525 F. Supp. 2d 558 (S.D.N.Y. 2007). The failure here constitutes not merely an inference, but evidence: a “failure to offer a survey showing the

existence of confusion is evidence that the likelihood of confusion cannot be shown.” *Essence Communications, Inc. v. Singh Industries, Inc.*, 703 F. Supp. 261, 269 (S.D.N.Y. 1988), citing *Mattel, Inc. v. Azrak-Hamway Int’l, Inc.*, 724 F.2d 357, 361 (2d Cir. 1983). “The absence of surveys is evidence that actual confusion cannot be shown.” *Sports Auth., Inc. v. Prime Hospitality Corp.*, 89 F.3d 955, 964 (2d Cir. 1996).

With no survey or other evidence to offer, LV instead attempts to rely on a few anecdotal internet posts referring to certain MOB totes as “LV” bags. This argument is fundamentally flawed for multiple reasons. First, “[e]ven if those descriptions were taken literally, a handful of instances is hardly strong evidence of actual consumer confusion.” SpA23. *See also Nora Beverages, Inc. v. Perrier Grp. Of Am., Inc.*, 269 F.3d 114, 124 (2d Cir. 2001) (Br.6,28) (“[W]e do not believe that the district court erred in finding that two anecdotes of confusion over the entire course of competition constituted *de minimis* evidence insufficient to raise triable issues.”).

“Anecdotal evidence can sometimes still be used to show confusion, however it must be more than *de minimis*.” *Medici Classics Prods. LLC v. Medici Group LLC*, 683 F. Supp. 2d 304, 312 (S.D.N.Y. 2015) (citation omitted). Here, even if LV’s assertions regarding the meaning of the few

internet posts it cites were taken for fact, such evidence is *de minimis* and cannot avoid summary judgment.

Second, LV misconstrues each of the internet posts upon which it relies. Any reasonable juror would find that, as noted by the District Court, “the anecdotes . . . do not suggest that any consumers actually believed MOB’s totes were produced or sponsored by Louis Vuitton.” SpA23. As such, the actual confusion factor significantly favors MOB.

**Good Faith:** There is no evidence whatsoever that MOB produced its totes in bad faith; quite the opposite. “An intent to parody is not an attempt to confuse the public.” *Jordache*, 828 F.2d at 1486. Here, an email from MOB designer Dan Venzke to CEO Tara Martin clearly shows their good faith and comedic intent before MOB ever produced a single bag:

Idea is like those bumper stickers... that say “My other car is a \_\_\_\_\_” Except its “My other bag is a \_\_\_\_\_”, what do you think? We can print that somewhere on the bag... and then just have the pictures of different bags...

JA153-54. The District Court found that “MOB’s intent ‘to imitate and suggest, but not *use*, the marks of a high-fashion LOUIS VUITTON handbag’ is not the sort of ‘bad faith’ that cuts in favor of a finding of infringement under the *Polaroid* test.” SpA24 (quoting *Haute Diggity Dog*, 507 F.3d at 268). LV presents no evidence to controvert this finding.

**Dissimilarity of the Goods:** With a sprawling price gap and obvious differences in quality between the products, “the *dissimilarity between the goods* . . . substantially lessens the likelihood of consumers’ misapprehending the source of either type of products.” *Plus Prods. v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1007 (2d Cir. 1983) (citations omitted); *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503 (2d Cir. 1997). As explained by the District Court, “it is uncontroverted that MOB’s totes are not of the same quality as Louis Vuitton’s handbags in a way that might cause confusion as to source.” SpA24. And yet, it does not appear that the quality of the MOB products is so inferior that it would threaten to tarnish LV’s trademark if, *arguendo*, there were any confusion in the marketplace. At least, LV’s Director of Intellectual Property in North America did not think so. *See* CA14. The District Court found that this factor is “either neutral or cut[s] against Louis Vuitton.” SpA24. MOB submits the latter.

**Sophistication of Consumers:** LV simply rehashes its unsuccessful argument in *Dooney & Bourke*, 561 F. Supp. 2d at 389. Finding that the factor went against LV in that case, the *Dooney & Bourke* court stated that “consumers of quality, expensive handbags made by Louis Vuitton, Dooney & Bourke, and other high-end brands tend to be sophisticated, hyper fashion-conscious, and are not likely to be easily confused . . . .” *Id.* In that

case, similarly as they have done here, LV alleged post-sale confusion to which the *Dooney* court correctly responded that “most cases finding actionable post-sale confusion involve a defendant's counterfeit or ‘knock-off’ copies of the plaintiff's product.” *Id.* at n.141 (citing *Cartier v. Symbolix, Inc.*, 386 F. Supp. 2d 354 (S.D.N.Y.2005)). Here, the District Court recognized that “MOB’s gimmick would be obvious to even its most unsophisticated customers, as one whole side of the tote bag is blank except for the words ‘My Other Bag ....’” SpA25. LV responds by accusing the court of ignoring “record evidence that consumers did not find MOB’s products to be a joke” (Br.56), but then, oddly, *cites to none*.

Tellingly, the District Court found that not a single *Polaroid* factor favors LV. In reaching these conclusions, the court carefully considered the “overall impression” created by the entire MOB products in the “context in which [they are] found” (*Star Indus.*, 412 F.3d at 386), and arrived at the well-reasoned conclusion that “... there is no credible risk that a reasonably prudent consumer would think [LV] “sponsored or otherwise approved” of MOB’s totes.” (SpA 26). LV has not presented, and cannot present, any evidence or legal authority to warrant disturbing the District Court’s factor findings and its ultimate legal conclusion here.

### C. LV Continues Its Misstatements of the Law

#### Confusion #7: LV's Misstatement of Parody's Role in the *Polaroid*

##### Analysis

It is well-established in this Circuit that “the *Polaroid* test is at best awkward in the context of parody, which must evoke the original and constitutes artistic expression. In such a situation, the *Polaroid* factors should be applied with proper weight given to *First Amendment* considerations.” *Cliffs Notes*, 886 F.2d at 495, n.3. The District Court properly applied this weight, since “a comical adaptation (can still be) relevant to the extent that the joke is clear enough to result in no confusion under the statutory likelihood of confusion analysis.” *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 416 (S.D.N.Y. 2002) (citation omitted).

LV argues that the District Court's reliance upon *Cliffs Notes* is misplaced, since “[t]here, the Second Circuit analyzed an *expressive* work under the balancing test articulated in *Rogers v. Grimaldi*,” as opposed to “considering a competing commercial product such as MOB's tote bags.” Br.57. However, as discussed above, MOB's products *are* expressive, and LV's competition claim “does not withstand even light scrutiny.” SpA22. Further, LV ignores the facts that in *Cliffs Notes*, the parodic product sold

for double the price of the parodied product, and both products were books summarizing prior works (one in a parodic manner) – yet this Court still included the parodic nature of the accused product in the analysis. *Cliffs Notes*, 886 F.2d at 492.

LV cites *Harley-Davidson, Inc. v. Grotanelli*, 164 F.3d 806 (2d Cir. 1999), and *Tommy Hilfiger*. Both of these cases are easily distinguishable in that they involved use as a designation of source, which is not the case here. And, in *Tommy Hilfiger, supra*, despite the use as a designation of source, the court granted summary judgment to defendant.

## **V. SUMMARY JUDGMENT TO MOB ON LV’S COPYRIGHT CLAIM WAS PROPER**

Contrary to LV’s assertion (Br.4), the District Court, in its review of the MOB bags that evoked LV’s alleged copyrighted prints, performed no “new parody analysis” to conclude that “any use by MOB of copyrightable elements of Louis Vuitton’s prints qualifies as a matter of law as fair use.” SpA26.<sup>14</sup> It plainly applied the longstanding, four-factor test from *Campbell*

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<sup>14</sup> Alternatively, the Court could affirm summary judgment to MOB here on the ground that MOB did not infringe LV’s prints. *See Alfaro Motors, Inc. v. Ward*, 814 F.2d at 887; see *infra* p.64.

*v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) – which LV admits “represents the prototypical case of parody” and fails to distinguish (Br.63).

LV mischaracterizes the record in arguing that the District Court should have found infringement of its two “Multicolore” prints – all elements of which more than a century old except for a “distinctive, bright color scheme.” Br.62. But more glaringly, LV fails to acknowledge a core fair use holding of *Campbell* and this Court. It presents as a “rule,” which the District Court purportedly “ignored,” the Supreme Court’s observation in *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985) – derived from a dictum assertion in *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984) – that “[E]very commercial use of copyrighted material is presumptively . . . unfair” (Br.64). In fact, *Campbell* overturned that so-called “presumption” 22 years ago:

If, indeed, commerciality carried presumptive force against a finding of fairness, the presumption would swallow nearly all of the illustrative uses listed in the preamble paragraph of § 107, including news reporting, comment, criticism, teaching, scholarship, and research, since these activities “are generally conducted for profit in this country.” *Harper & Row, supra*, at 592 . . . (Brennan, J., dissenting). Congress could not have intended such a rule.

*Campbell*, 510 U.S. at 584. Moreover, this Court recently emphasized that “the *Sony* dictum was enormously overstated.” *Author’s Guild v. Google, Inc.*, 804 F.3d 202, 218 (2d Cir. 2015), *cert. denied*, 136 S.Ct. 1658 (Apr.

18, 2016). Even LV’s own authority noted that Courts in this Circuit “do not give much weight to the fact that the secondary use was for commercial gain.” *Castle Rock Entm’t, Inc. v. Carol Pub. Grp., Inc.*, 150 F.3d 132 (2d Cir. 1998). Instead, “The more critical inquiry . . . in fair use analysis generally is whether the allegedly infringing work ‘merely supersedes’ the original work ‘or instead adds something new, with a further purpose or different character, altering the first with new . . . meaning [ ] or message,’ in other words ‘whether and to what extent the new work is “transformative.””” *Id.* at 141-42, *citing Campbell*, 510 U.S. at 579, *quoting* Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L.Rev. 1105, 1111 (1990). The District Court here correctly premised its fair use opinion on the grounds that commercial use “is not presumptively unfair,” and that “[p]arody, even when done for commercial gain, can be fair use.” SpA27 (*citing Campbell*, 510 U.S. at 584-85). LV’s misstatement of settled law on this point is objectively unreasonable.<sup>15</sup>

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<sup>15</sup> The District Court’s quote of the Fourth Circuit’s observation in *Haute Diggity Dog* merely cast doubt on LV’s expansive, aggressive view of its intellectual property rights. It did not signal the District Court’s subjecting LV to any more strict of a standard, as LV mistakenly suggests. SpA27.

## **A. The District Court’s Fair Use Determination Was Proper**

The District Court properly concluded that none of the nonexclusive fair use factors favor LV. SpA27; 17 U.S.C. §107(1)-(4).

As to the first factor, “The central purpose of [the] investigation” . . . is to determine “whether the new work merely ‘supersede[s] the objects’ of the original creation . . . or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is ‘transformative.’” *Campbell*, 510 U.S. at 579 (internal quotation marks and citations omitted). “Suffice it to say . . . that parody has an obvious claim to transformative value.” *Id.*

The standard for determining parody and “transformative use” is objective. “The threshold question when fair use is raised in defense of parody is whether a parodic character may *reasonably* be perceived.” *Campbell*, 510 U.S. at 582 (1994) (emphasis added). *Accord Cariou v. Prince*, 714 F.3d at 694 (when transformative use is at issue, “[w]hat is critical is how the work in question appears to the reasonable observer”).<sup>16</sup>

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<sup>16</sup> In this Court’s review of copyright infringement claims, “the works themselves supersede and control contrary descriptions of them.” *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 52 (2d Cir. 1986) (affirming summary

The District Court recognized, as part of its trademark fair use analysis, that the designs on MOB’s totes literally conveyed a joke *about Louis Vuitton* and the handbags that feature its alleged copyrighted prints.

Colorful as LV’s Multicolore prints may be, their message is serious: they demand the viewer recognize the luxe handbag owner as a person of status. In contrast, MOB’s “almost cartoonish renderings” (SpA10) – which as the District Court found use “simplified colors, graphic lines, and patterns” that merely reference and “evoke” the Multicolore prints (SpA3) – ask that the viewer *not* take the person toting the bag so seriously. *See* SpA13-14, *quoting Tommy Hilfiger*, 221 F. Supp. 2d at 415. The District Court correctly concluded that MOB’s lighthearted renderings of LV’s alleged copyrighted prints were parodies with “an obvious claim to transformative value” that far outweighed any “commercial” dimension. SpA26, *citing Campbell*, 510 U.S. at 579; SpA27.

As to the second fair use factor, the District Court quoted *Campbell*’s observation that it “does not provide ‘much help . . . in a parody case, since parodies almost invariably copy publicly known, expressive works.’”

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judgment of defendants’ noninfringement), *cert. denied*, 476 U.S. 1159 (1986).

SpA27, *citing Campbell*, 510 U.S. at 586.<sup>17</sup> However, the District Court also prefaced its fair use analysis by noting that LV “attempts to use a copyright claim to pursue what is at its core a trademark and trade dress infringement claim.” SpA27, *citing Haute Diggity Dog*, 507 F.3d at 269. Beyond suggesting that the “creative nature” of rendering its trademarks in a series of 33 colors is “significant” – it is not – LV offers no reason to disturb the District Court’s finding.

As to the third factor, the District Court correctly found that any “use” by MOB of the Multicolore prints was “reasonable” in amount and substantiality “in relation to the purpose of the use.” SpA27, *citing Campbell*, 510 U.S. at 587. Indeed, as MOB undisputedly established, its bags used *eight or fewer colors*, in no sequence at all, and altogether different letters and symbols, to evoke LV’s Multicolore prints. JA121-125. LV even concedes that in *Campbell*, “the prototypical case of parody,” the defendant’s song used the “refrain” of the plaintiff’s work – a refrain that appeared in nearly every line of that work’s lyrics. Br.63; *Campbell*, 510

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<sup>17</sup> The District Court *did not* examine the second factor under *Harper & Row*, as LV claims in its attempt to discredit the District Court’s analysis. Compare Br.66, with SpA27.

U.S. at 594-96. MOB's bags simply use *no protectible element* of the Multicolore prints, and as such this factor favors MOB.

As to the fair use fourth factor, courts look “not [to] whether the secondary use suppresses or even destroys the market for the original work or its potential derivatives, but whether the secondary use *usurps* the market of the original work.” *Prince*, 714 F.3d at 708, *quoting Blanch v. Koons*, 467 F.3d 244, 258 (2d Cir. 2006) (emphasis added). The District Court correctly found that MOB's totes “do not ‘serve[ ] as a market replacement for’ Louis Vuitton’s bags in a way that it would make ‘it likely that cognizable market harm to [Louis Vuitton] will occur.’” SpA27, *citing Campbell*, 510 U.S. at 591. To the District Court’s point, the undisputed record showed that market usurpation was in fact nil, and LV’s contention of “competition” between the products does “not withstand even light scrutiny.” CA167-68; SpA22.

**B. An Absence of Substantial Similarity Also Favors Affirmance**

LV:

MOB’s designer admitted that its monogram layout “has a similar feel to the Louis Vuitton bag.”

Br.62 (*quoting* JA408, deposition transcript of Daniel Venzke).

The Record:

Q: You're the artist who created the pattern based on the Louis Vuitton toile monogram; correct?

A: I produced -- yeah, a cartoon image of a bag that used a monogram pattern. **None of the symbols used were the symbols in the toile monogram pattern** that Louis Vuitton uses and has trademarked, but the general feeling of the monogram layout has a similar feel to a Louis Vuitton bag **with the exception that it is a cartoon hand-drawn image clearly versus, you know, what Louis Vuitton does for their products.**

JA408 (emphasis added).

In the unlikely event that this Court disagrees with the District Court's fair use conclusions, the absence of substantial similarity between the Multicolore prints and MOB's designs provides an alternative ground for affirmance. *See Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57 (2d Cir. 2010) ("*Gaito*").

"[O]nly a visual comparison of the works" in question is necessary to determine whether the works are substantially similar. *Gaito*, 602 F.3d at 64, citing *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 766 (2d Cir. 1991). The Court "must attempt to extract the unprotectible elements from . . . consideration and ask whether the protectible elements, standing alone, are substantially similar," while "compar[ing] the contested design's total concept and overall feel." *Gaito*, 602 F.3d at 63, 66 (internal quotation marks omitted).

This Court “has explicitly cautioned” that the “total concept and overall feel” standard

may ‘invite an abdication of analysis,’ because ‘feel’ can seem a ‘wholly amorphous referent. . . .’” *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 134 (2d Cir. 2003) (quoting 4 Nimmer on Copyright § 13.03[A][1][c] (2003)). In order to avoid the possibility that “a copyright doctrine whose aspiration is to protect a work’s ‘concept’ could end up erroneously protecting ‘ideas,’” or something else unprotectible, the Court of Appeals “has taken care to identify precisely the particular aesthetic decisions—original to the plaintiff and copied by the defendant—that might be thought to make the designs similar *in the aggregate*.” *Id.* (emphasis added).

*Canal+ Image UK Ltd. v. Lutvak*, 773 F. Supp. 2d 419, 439 (S.D.N.Y. 2011). LV has identified *no* “particular aesthetic decisions” original to its designs; it merely asserts they are “creative.” Br.65.

Yet whereas LV’s Multicolore prints feature 33 colors, in a particular sequence, MOB’s designs use eight or fewer colors, in a seemingly random scheme. SpA3; JA29,121-125. And MOB’s design patterns incorporate *none* of the constituent trademarked elements that appear in LV’s Prints. JA121-125.

Further, the District Court correctly found as part of its trademark discussion that MOB’s designs embody a markedly different concept and

feel than the LV works at issue, including the Multicolore prints. SpA25; JA408. And the “concept” of MOB’s designs is a two-sided joke.

The playful, humorous, utilitarian “concept and feel” of MOB’s design and message is completely distinct from the luxurious, exclusive, refined, and ultimately serious “feel” of the Multicolore prints and the message they convey. See SpA26-28; JA121-125,1089-91.

## **CONCLUSION**

For the foregoing reasons, this Court should affirm the District Court's decision in its entirety.

Dated: 8 August 2016

Respectfully submitted,

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**CERTIFICATE OF COMPLIANCE WITH FED. R. APP. 32(a)**

1. This brief complies with the type-volume limitations of Fed. R. App. P. 32(a)(7)(B) because this brief contains 13,973 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii).

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word 2010 Times New Roman font in size 14.

Dated: 8 August 2016

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## CERTIFICATE OF SERVICE

I hereby certify that on this 8th day of August, 2016, a true and correct copy of the foregoing Brief for Defendant-Appellee was served on all counsel of record in this appeal via CM/ECF pursuant to Second Circuit Rule 25.1(h)(1)-(2).

Dated: 8 August 2016

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