

16-0241-cv

United States Court of Appeals
for the
Second Circuit

LOUIS VUITTON MALLETIER, S.A.,

Plaintiff-Appellant,

– v. –

MY OTHER BAG, INC.,

Defendant-Appellee.

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

REPLY BRIEF FOR PLAINTIFF-APPELLANT

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PRELIMINARY STATEMENT

This case concerns the misappropriation by My Other Bag, Inc. (“**MOB**”) of the famous trademarks and copyrights of Louis Vuitton Malletier, S.A. (“**Louis Vuitton**”) to sell MOB’s own bags. It has never been about any supposed “artistic” activity by MOB, nor does it comprise the watershed First Amendment moment that the crusading law professor amici would have the Court believe. It requires only the straightforward application of the Trademark Dilution Reform Act (“**TDRA**”), the Lanham Act, and the Copyright Act in accordance with congressional intent and this Court’s decisions. Under those authorities, reversal is required of the decision below.

Following TDRA, Louis Vuitton showed in its opening brief that the *undisputed* evidence in this case was that all six of that statute’s factors overwhelmingly favored a finding of dilution. MOB, meanwhile, failed to satisfy the legal requirements of TDRA’s parody defense. The district court wrongly denied Louis Vuitton summary judgment on dilution solely because of its wholly subjective (and factually incorrect) conclusion that MOB intended its bags as a “joke.” On that basis, it wrongly inverted TDRA’s legal standards, placed improper burdens on Louis Vuitton, cast aside the strictures governing parody, and reinterpreted the dilution factors to favor MOB.

In response to MOB's summary judgment motion on trademark infringement, Louis Vuitton made a powerful factual showing of likelihood of confusion under this Court's *Polaroid* factors, particularly in the context of post-sale confusion. The district court, by contrast, committed reversible error by ignoring post-sale confusion and denied Louis Vuitton a trial, again based on its subjective view that the MOB bags were funny. Finally, ignoring the copyright statute's unique requirements for fair use and parody, the district court wrongly found for MOB on Louis Vuitton's copyright claim as well. Summary judgment should have been granted for Louis Vuitton.

Unable to contest Louis Vuitton's factual showing or provide more than a token defense of the decision below, MOB (supported by the law professor amici) launches into a wholesale attack on the governing statutes themselves. MOB and its allies contend that the First Amendment by itself necessarily preempts any possibility of relief under TDRA because MOB was supposedly engaged in "expressive" rather than "commercial" activity. The amici further argue that, even if MOB's use was commercial, the First Amendment bars any regulation of it anyway.

A moment's reflection, however, belies any notion that MOB's misuse of the LV Trademarks was "noncommercial" or absolutely protected by the First Amendment. If MOB's misappropriation of the distinctive LV Trademarks to sell

its bags and generate profits for itself is “noncommercial,” or merely “expressive,” there is almost no misuse of another’s trademarks that would ever be deemed commercial. And since most dilution cases involve a use of another’s marks that is not confusing or misleading, the radical notion that the First Amendment precludes regulation of non-misleading commercial speech is tantamount to arguing that the dilution statute is, as a whole, unconstitutional.

Unsurprisingly, neither MOB nor the amici have sound legal support for these extreme positions. Not only did Congress reject these views when it enacted TDRA, but no case has found any problem in Congress’ balancing of trademark rights and First Amendment concerns in that statute. Meanwhile, the dilution statute itself, its legislative history, and the case law foreclose MOB’s supposed “mark-to-mark” requirement. There can be no escape from dilution liability for MOB in this case.

MOB’s infringement analysis, meanwhile, does little but parrot the district court’s tendentious consideration of this Court’s *Polaroid* factors, most of which either favored Louis Vuitton or were neutral. The district court’s reliance on its subjective view of how the bags should be perceived has long since been proscribed by this Court, as well as more recently by the United States Supreme Court in its *Hana Financial* decision. Likewise, there is no basis in the law for the single-minded amici’s attempt to re-write the *Polaroid* factors to shift the burden

of proof whenever parody, however fancifully, is claimed. Louis Vuitton was entitled to a trial on its infringement claim.

As for its copyright claim, Louis Vuitton decisively demonstrated in its opening brief how the district court failed to apply proper standards. Summary judgment for Louis Vuitton should have been and should now be entered on that claim.

ARGUMENT

I. LOUIS VUITTON IS ENTITLED TO SUMMARY JUDGMENT ON ITS DILUTION CLAIM.

A. The District Court Erred In Rejecting Louis Vuitton’s Overwhelming Showing Of Dilution By Blurring.

Louis Vuitton has the right, indeed the obligation, to protect itself from commercial misappropriation of its trademarks, as provided for in TDRA and the Lanham Act.¹ As Louis Vuitton demonstrated in its opening brief, MOB is engaged in a classic case of dilution by blurring under TDRA, using Louis Vuitton’s marks to sell MOB’s products. All six TDRA factors decisively support this dilution claim, and MOB has offered nothing that shows otherwise. (Brief of Appellant Louis Vuitton (“**Br.**”) 30.)

¹ Louis Vuitton has an obligation to police its trademarks. Those like MOB who misappropriate trademarks and First Amendment advocates like the amici are always the most vocal accusers of those seeking the proper enforcement of trademark rights.

The factual record, meanwhile, failed to support any parody defense. Even apart from MOB’s misuse of the LV Trademarks as a designation of source (see *infra* p.19), MOB never thought to call its bags a parody until faced with legal liability. Rather, MOB’s founder, Tara Martin, a self-described “designer handbag junkie,” admitted repeatedly to a very different purpose: to be “able to take something I love”—*viz.* the LV Trademarks—“and put [them] on a product that other women can relate to and love as well.” (Br.10.) She marketed her totes as “the perfect complement” to, or even a substitute for, designer bags. (*Id.*) Unsurprisingly, this commercial misappropriation of the LV Trademarks failed all the requirements of parody set out in the statute and the case law.

The district court was able to avoid summary judgment for Louis Vuitton only by inverting the logic and structure of the dilution statute. It took as the most salient (indeed, almost its exclusive) consideration MOB’s after-the-fact justification of its misappropriation of the LV Trademarks as a “joke,” blaming Louis Vuitton for not doing so as well. The district court then (1) applied a higher burden to Louis Vuitton’s TDRA claim; (2) insisted irrelevantly that there was no risk of confusion; (3) ignored or reinterpreted the record evidence; and (4) all but eliminated the traditional rules of parody. Only at the conclusion of its analysis did the district court even consider TDRA’s statutory factors, rewriting those factors to

support its predetermined conclusion that the MOB bags were a “joke” that could not be diluting.

MOB has nothing but bluster to offer in support of the district court’s legal errors. Thus, MOB insists that “in typical fashion” Louis Vuitton “has not provided a single quote to support its argument” that the district court imposed a higher standard for famous marks. (Response Brief of Appellee MOB (“**Resp.**”) 44.)) Louis Vuitton’s opening brief, however, quoted the district court’s express holding that Louis Vuitton had to meet an “increased burden” because “fame and recognition only make it *less likely* that MOB’s use would impair the distinctiveness of Louis Vuitton’s marks.” (Br.31; SpA18) (emphasis in original).

Nor can MOB defend the district court’s view that the standards here should be different because competing products are at issue or there may have been no confusion. This Circuit has itself acknowledged the application of the ordinary dilution standards to cases of competing products. *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 113 (2d Cir. 2009) (“*Starbucks IV*”). And, a likelihood of dilution² can exist, indeed thrives, even in cases where confusion is not present. 15 U.S.C. § 1125(c)(3).

² MOB falsely claims Louis Vuitton admitted it is aware of no facts to indicate a likelihood of dilution. (Resp.36.) Its record citation refers to Louis Vuitton’s response when asked about facts that show *actual* dilution, which is not required under TDRA. (CA10:18-22.)

MOB and the amici labor hard to make into parody anything that someone (like the district court) might later find funny, but the term is not so flaccid or arbitrary. Contrary to MOB's illogic, Tara Martin's admissions about her original purpose to sell "stylish" bags (Br.16), which the district court ignored, are hardly irrelevant. No case has ever endorsed the nonsensical idea that unintended or accidental humor is parody. Certainly, nothing in *Cariou v. Prince*, 714 F.3d 694, 707 (2d Cir. 2013), suggests this. (Resp.37-38.)

At the same time, this Court has repeatedly rejected the notion that humor used to promote one's own product is a "permitted trademark parody use." *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999); *see also Starbucks IV*, 588 F.3d at 113; *Deere & Co. v. MTD Prods.*, 41 F.3d 39, 44-45 (2d Cir. 1994). MOB's venture into Greek philology to claim that parody "can target things we love" (Resp.37) likewise ignores this Circuit's decision in *Starbucks IV*, which rejected the idea that a mere expression of affection or admiration constitutes parody. 588 F.3d at 97 (misuse of Starbucks' marks could not be justified "as a beacon to identify Charbucks as a coffee that competes at the same level and quality as Starbucks in producing dark-roasted coffees"); *see also Salinger v. Colting*, 641 F. Supp. 2d 250, 260 n.3 (S.D.N.Y. 2009) (a tribute is not parody), *vacated on other grounds*, 607 F.3d 68 (2d Cir. 2010) (affirming dismissal of defendant's post hoc parody defense in copyright context).

Rather, TDRA adopts the common sense notion that criticism, comment, and parody need to be directed at or “upon” the trademark owner or its famous mark. Contrary to MOB’s assertion, this statutory requirement is hardly “nonsense.” (Resp.43.) This Circuit emphasized this rule in *Harley-Davidson*, 164 F.3d at 812 (leeway given to “parodists whose expressive works aim their parodic commentary at a trademark or a trademarked product”).

Even if the name My Other Bag originated from the “my other car...” trope, this idea played no role in MOB’s pre-litigation marketing. As Ms. Martin admitted, moreover, her bags, at best, made fun of MOB, not Louis Vuitton. (JA339-340.) Similarly, MOB (and the amici) cannot read out of the law the rule that parody is something different from mere social commentary. *See, e.g., Harley-Davidson*, 164 F.3d at 812-13; *Elvis Presley Enters. v. Capece*, 141 F.3d 188, 200 (5th Cir. 1998) (use that did not target Elvis Presley did not qualify as parody); *Dr. Seuss Enters. L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997) (trademark use was “pure shtick” to sell books).

Finally, in *Starbucks IV*, this Court rejected MOB’s and the district court’s view that *Louis Vuitton Malletier v. Haute Diggity Dog, LLC*, 507 F.3d 252, 266-68 (4th Cir. 2007) justifies a rewrite of TDRA’s dilution factors. *Starbucks IV*, 588 F.3d at 111-13. Not only did Congress’ explanation of the factors not include parody issues (SpA58-59), it would hardly have provided separately for parody in

TDRA if it had intended the courts to have already considered it in the *prima facie* case.³

Louis Vuitton proved dilution with undisputed evidence (Br.29-35), and MOB cannot meet the standards of parody. Louis Vuitton was therefore entitled to summary judgment on its dilution claim. At a minimum, its undisputed evidence warrants a trial. The judgment below must be reversed.

B. MOB’s Misuse Of The LV Trademarks Is Not Protected By The First Amendment.

The district court wrongly reinterpreted the dilution statute based on its subjective conclusion that the bags were a “joke,” but MOB and the amici go even further, making two hyperbolic claims. First, they insist MOB’s use was “noncommercial” and “expressive” so that the First Amendment protects it no matter what. Second, the amici contend that TDRA cannot, under the First Amendment, prohibit any non-misleading commercial speech.

The Court should consider just how radical is the claim that MOB was engaged in “noncommercial,” “expressive,” or fully protected First Amendment

³ MOB argues that, because parody can be considered in evaluating the *Polaroid’s* infringement factors, “there is no reason to treat the TDRA [factors] any differently.” (Resp.32-33.) But, unlike TDRA, the Lanham Act’s infringement provisions contain no separately-stated exclusions for parody or any of the other uses that are made defenses and excluded from dilution under §1125(c)(3). *See* 15 U.S.C. §§1114, 1125(a). Moreover, infringement turns on whether there is a likelihood of confusion, which is not part of TDRA liability. *Hormel*, 73 F.3d at 503 (“A parody depends on a lack of confusion to prove its point.”)

activity. As MOB's marketing materials showed, MOB's goal in misappropriating the LV Trademarks was to sell products as part of a commercial transaction.⁴

(Br.10.)

⁴ MOB has confirmed that its real goal is to offer unlicensed Louis Vuitton consumer products, not parody, by recently releasing a cosmetic product that repeats MOB's wholesale misappropriation of Louis Vuitton's trademarks and copyrights, but with no colorable basis to claim it is engaging in protected parodic expression. Thus continues the very "death by a thousand cuts" that Congress sought to prevent via TDRA. (BR.31-32; SpA94, 136.) See, e.g., (1) https://www.amazon.com/LIMITED-CONTROL-WATER-CUSHION-NATURAL/dp/B01FB22BE4/ref=pd_sim_sbs_194_5?ie=UTF8&psc=1&refRID=KSY83KS693YMDJ5Q32 (last accessed Aug. 22, 2016); (2) http://www.thefaceshop.my/shopping/Products/Oil_Control_Water_Cushion_SPF5_0444_PA444444444_V203_MY_OTHER_BAG/ (last accessed Aug. 22, 2016); (3) <http://www.choulyin.com/2016/07/the-limited-edition-my-other-bag-x-face.html> (last accessed Aug. 22, 2016):



This Court may take judicial notice of MOB's latest offering of products bearing renderings of the LV Trademarks, which "can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned." Fed. R. Evid. 201(b)(2). See, e.g., *Rivas v. Fischer*, 780 F.3d 529, 535 n.4 (2d Cir. 2015) (courts may take judicial notice of the fact that certain materials were published, without taking the contents of the materials as true); *Staehr v. Hartford Fin. Servs. Grp.*, 547 F.3d 406, 425 (2d Cir. 2008); *Muller-Paisner v. TIAA*, 289 F. App'x 461, 466 n.5 (2d Cir. 2008) (taking judicial notice of website publication).

Any “expressive conduct” by MOB was purely incidental to its primary purpose, which, as Ms. Martin admitted, was to profit by taking the LV Trademarks and putting them on her bags, thereby convincing women to buy them. (Br.39-44.) To call such activity “noncommercial” and “expressive” is to sap these terms of any meaning whatsoever. MOB’s use is the converse of the law professors’ Magritte painting, which was intended as art first, with any sale being secondary. Nor were MOB’s bags literary works, a song, a movie or a play, the context of most of the inapplicable cases it relies on. Indeed, there is almost nothing artistic or creative here at all. MOB simply lifted the LV Trademarks and put them on its bags so that other women who “can relate” to those marks and “love [them] as well” would buy the bags and generate profits for MOB. (JA105-106.)

Citing no legal authority, MOB claims that “canvas tote bags, t-shirts and baseball hats are the standard vehicles of all kinds of expressive communications.” (Resp.17.) Even were this true, the misappropriation of another’s trademarks in that context would still give rise to liability. Otherwise, there would be nothing to prevent anyone from selling a baseball cap or a t-shirt with the famed Apple Computer symbol (let alone the federally-registered LV) on it and then later claiming that it was a mere “expressive use.”

Indeed, under MOB's and the amici's extreme theory, it is difficult to conceive of *any* misappropriation of famous trademarks that could not be deemed "expressive" and "noncommercial." Every trademark defendant would simply take its cue from MOB, claiming after-the-fact that its misuse of a senior user's trademark to sell its own products was funny, or a commentary, or "creative," and therefore "expressive" and "noncommercial" in character. This Circuit has expressly rejected claims of "noncommercial" use on such a basis. *See, e.g., Bad Frog Brewery v. New York State Liquor Auth.*, 134 F.3d 87, 97 (2d Cir. 1998) (where brewery's labels were a form of advertising, identified a specific product, and served the economic interest of the speaker, this Court was "unpersuaded by Bad Frog's attempt to separate...purported social commentary...from the hawking of beer"); *see also San Francisco Arts & Ath., Inc. v. United States Olympic Comm.*, 483 U.S. 522, 541 (1987) ("mere fact that the [junior user] claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to appropriat[e] to itself the harvest of those who have sown.") (internal quotations omitted).

Just such a radical application of the First Amendment to dilution was proposed to, *and rejected by*, Congress in enacting TDRA. (SpA80-82.) Instead, Congress adopted the far more balanced approach set forth in Section 1125(c)(3), requiring a defendant to make a showing of a genuine "fair use"—*i.e.* truly

expressive speech, not something merely incidental to a sale transaction—to avoid dilution liability in using another’s trademarks. In *Starbucks IV*, this Circuit similarly rejected MOB’s (and the law professors’) First Amendment zealotry dismissing the very sorts of “expressive use” rationalizations employed by MOB and expressly finding similar activity to be commercial and applying the strictures of the statutory parody exclusion. 588 F.3d at 112-13.

MOB’s attempt to overcome this Court’s explicit rulings relies on wholly inapposite case law. Its principal case is the district court decision in *Yankee Publ’g, Inc. v. News Am. Publ’g Inc.*, 809 F. Supp. 267, 275-76 (S.D.N.Y. 1992). Not only did Judge Leval later acknowledge that his decision contained an unnecessary and flawed First Amendment analysis, Pierre Leval, *Trademark: Champion of Free Speech*, 27 Colum. J.L. & Arts 187, 188 (Winter 2004), but that case did not even purport to address the application of the First Amendment to a federal dilution claim.⁵ It involved a trademark *infringement* claim concerning an *artistic* work, where the question was the confusion caused regarding the senior user’s mark.

⁵ *Yankee Publishing* discussed dilution not under TDRA, but only under the New York anti-dilution statute, which does not contain TDRA’s specific First Amendment-based exclusions. 809 F. Supp. 267.

Similarly inapplicable here is *Rogers v. Grimaldi*, whose balancing test was designed in the infringement context to accommodate the dual interests of artistic expression and avoiding customer confusion. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989). Unlike infringement, dilution does not depend on actual or even likely confusion. 15 U.S.C. §1125(c)(1). And, of course, since MOB's bags have nothing to do with genuine "artistic" expression, the *Rogers* test would not help MOB in any event.

Nor does the Ninth Circuit decision in *Mattel v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002) help MOB. That case involved an original song lampooning the Barbie Doll, where the artistic and non-commercial elements were inextricably intertwined. Further, *Mattel* was decided under FTDA, TDRA's predecessor, which did not have Section 1125(c)(3)(A)'s fair use exception. The Ninth Circuit therefore looked to the legislative history of FTDA's "noncommercial use" exclusion, where Congress addressed other forms of expression that "are not part of a commercial transaction." *Id.* at 905.

Nothing in *Mattel* even remotely suggests that MOB's efforts to sell handbags was "artistic" or "non-commercial." This Circuit never adopted the Ninth Circuit's expansive approach, which became irrelevant once Congress fashioned §1125(c)(3)(A) to cover such matters. To be sure, TDRA was not intended to prohibit or threaten "noncommercial expression." (SpA107.) But

Congress also made clear that “[n]othing in this bill is intended to alter existing case law on the subject of what constitutes ‘commercial’ speech.” (*Id.*)⁶

So ideologically opposed to dilution are the amici that they posit the even more radical First Amendment theory that non-misleading commercial speech may not be restricted at all, no matter how dilutive. Since TDRA was enacted to regulate non-misleading commercial speech, the gist of this argument is that TDRA as a whole is unconstitutional. But congressional legislation is presumptively constitutional and cannot be struck down in the absence of a clear showing of unconstitutionality. *Salazar v. Buono*, 559 U.S. 700, 721 (2011).

To justify their claim that TDRA is unconstitutional, the amici wrongly rely on *Sorrell v. IMS Health, Inc.*, 564 U.S. 552 (2011) and its progeny. (Amicus Br.19-20.) Unlike the statutes in those cases,⁷ TDRA is content-neutral—it does

⁶ MOB argues that its bags are hybrid products containing mixed commercial and expressive elements that receive “full First Amendment protection,” citing *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp.*, 886 F.2d 490 (2d Cir. 1989). But, *Cliffs Notes*, like *Yankee Publishing*, addressed First Amendment considerations in the context of trademark infringement, applying the *Rogers v. Grimaldi* balancing test. This Court has rejected any notion that merely using another’s mark to sell a competing product is expressive speech. *See, e.g., Starbucks IV*, 588 F.3d at 113; *Deere*, 41 F.3d at 44-45.

⁷ *Sorrell* addressed content-and-speaker-based legislation restricting pharmacies’ right to disclose prescriber-identifying information and disfavoring specific speakers (pharmaceutical manufacturers). 564 U.S. at 552-53. *Sarver v. Chartier*, 813 F.3d 891, 905 (9th Cir. 2016), acknowledged the constitutionality of

not restrict speech based on its message, but rather restricts only speech used in a manner likely to dilute the famous mark. And, consistent with the analysis in *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 566-70 (1980), Congress has carefully-tailored TDRA's fair use exceptions to provide for First Amendment concerns. TDRA directly advances the substantial governmental interest in protecting the distinctiveness of famous trademarks and, given its statutory exclusions, 15 U.S.C. §1125(c)(3), is no more extensive than necessary.

Unsurprisingly, in the decades since enactment, no court has ever suggested that TDRA violates the First Amendment, even when addressing dilution by an allegedly non-misleading trademark parody, as in *Starbucks IV* and *Hormel Foods Corp. v. Henson*, 73 F.3d 497, 503 (2d Cir. 1996). The *ipse dixit* of the amici is no substitute for sound analysis and genuine legal precedent.

C. TDRA Does Not Have A Mark-Versus-Mark Requirement.

In a last gasp, MOB asserts that TDRA imposes a requirement that there can be no dilution liability unless defendants' use operates as a trademark itself, designating the source of its own goods. (SpA9 n.2.) No such "mark-versus-mark" requirement exists in the dilution statute. Indeed, even the district court refused to adopt this rewriting of dilution law. Every element of TDRA's

California's right of publicity law and its application where a defendant appropriated the commercial value built into an identity or performance.

legislative history, its language, and its application by the courts is expressly to the contrary.

Certain proponents of TDRA did advocate such a mark-versus-mark restriction. But Congress *rejected* that approach (and MOB's argument). See William G. Barber, *Symposium Review: Dumping the "Designation of Source" Requirement from the TDRA: A Response to the Alleged "Trademark Use Requirement in Dilution Cases,"* 24 Santa Clara Computer & High Tech. L.J., 559 (2008).

TDRA's own language bears this out. Its fair use exclusions, for example, apply only to a usage that is "other than" a designation of source, *i.e.*, other than when used as a trademark. *Id.* If there were a mark-versus-mark requirement in the dilution statute, such that a defendant must be using the famous mark as its own trademark, then it would be unnecessary to include defenses for cases when it was not being used as a trademark. In effect, Section 1125(c)(3)(A) would be rendered superfluous, violating statutory construction rules. *United States v. DiCristina*, 726 F.3d 92, 96 (2d Cir. 2013).⁸

⁸ MOB also claims that the phrase "commences use of a mark or trade name in commerce" in the preamble to Section 1125(c) refers to defendant's use of the senior mark as its own mark. 15 U.S.C. §1125(c)(1). The quoted language nowhere suggests that this second mention of "a mark or trade name" refers to the junior user's mark rather than the junior user's use of the senior user's mark.

Unsurprisingly, MOB cites to no court that adopts the “mark-versus-mark” requirement. To the contrary, in *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144 (4th Cir. 2012)—a case MOB does not mention—the Fourth Circuit overruled this very argument.⁹ In that case, Google had argued, and the district court agreed, that TDRA did not apply because Google was not making a trademark use of Rosetta Stone’s trademarks when using them as key words for internet searches. The Fourth Circuit vacated and remanded, emphasizing that “if a federal trademark dilution claim is doomed solely by the lack of proof showing that the defendant used the famous mark as a trademark – then the term ‘fair use’ as set forth in §1125(c)(3)(A) would be superfluous.” *Id.* at 169.

Neither *Tiffany v. eBay, Inc.*, 600 F.3d 93 (2d Cir. 2010), nor *Starbucks IV*, supports MOB’s argument. In *eBay*, this Court found that, because eBay used the plaintiffs’ trademark to advertise and identify Tiffany merchandise, not to create an association with eBay’s services, its use of Tiffany’s mark was nominative fair use. It stressed there was “no second mark *or product* at issue to blur with or tarnish ‘Tiffany,’” showing that not just mark-versus-mark conflicts are actionable under TDRA. *Id.* at 112 (emphasis added).

⁹ Although the Fourth Circuit in *Rosetta Stone* refers to the federal dilution statute as the “new FTDA” or FTDA, the case arose under TDRA, not the FTDA. *See Rosetta Stone Ltd. v. Google, Inc.*, 730 F. Supp. 2d 531, 550 (E.D.Va. 2010).

Although *Starbucks IV* raised a dilution claim in a “mark-versus-mark” context, nothing in this Court’s decision suggests that dilution claims are limited to those circumstances.¹⁰ Indeed, this Court has rejected a mark-versus-mark requirement even in infringement claims. *Kelly-Brown v. Winfrey*, 717 F.3d 295, 307-08 (2d Cir. 2013). Rather, the question is whether the defendant is using the plaintiff’s trademark “as a symbol to attract public attention.” *Id.* at 306 (citation omitted).

Without mentioning *Rosetta Stone* or correctly describing other case law, MOB places its principal reliance on two commentators who advocate MOB’s position. These commentators cite nothing in support of an approach rejected by Congress in enacting TDRA and the courts in construing it.

It should be noted that any mark-to-mark requirement would be met here in any event. MOB conceded it used its renderings of the LV Trademarks as a designation of source. (JA350.) MOB’s strained reading of Ms. Martin’s testimony, laboring as did the district court to find some notion of “confusion” in close proximity, cannot overcome her acknowledgement that her goal in using the

¹⁰ Similarly misplaced is MOB’s reliance on *Nat’l Bus. Forms & Printing, Inc. v. Ford Motor Co.*, 671 F.3d 526 (5th Cir. 2012). There, the court found no dilution because a commercial printer who reproduces a trademark for customers as part of its printing business is not “using” the plaintiff’s trademark under §1125(c)(1). It also considered the use in the narrow context of commercial printers. *Id.* at 536.

LV Trademarks was to have customers think “Aha, there is My Other Bag” (JA350.) This is classic designation-of-source use.

II. LV IS ENTITLED TO A JURY TRIAL ON ITS TRADEMARK INFRINGEMENT CLAIMS.

Louis Vuitton’s uncontested evidence gave rise to extensive fact disputes on its infringement claim under the *Polaroid* factors. *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492, 495 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961). MOB’s response mostly parrots the district court’s *Polaroid* analysis, which ignored Louis Vuitton’s evidence on those factors and contained pervasive Rule 56 errors. (Br.46-56; Resp.47-56.) As the United States Supreme Court reiterated only last year in *Hana Financial, Inc. v. Hana Bank*, 135 S. Ct. 907, 910 (2015), the commercial impression of a trademark is customarily a matter for the jury.¹¹

The Lanham Act protects equally against point-of-sale and post-sale confusion, and it is reversible error to ignore the latter, as the district court did here. *See, e.g., Int’l Info. Sys. Sec. Certification Consortium v. Sec. Univ., LLC*, 823 F.3d 153, 162-63 (2d Cir. 2016); *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 872-73 (2d Cir. 1986). Even the ever-zealous amici admit that “the post-sale viewer is in no different position in that regard than the buyer.”

¹¹ Nothing in *Hana Financial* suggests that its general principle was limited to the tacking issue present in that case, nor is likelihood of confusion in that context any different.

(Amici Br.18.) MOB never even mentions the likelihood that, post-sale, potential consumers or passersby could come to believe that MOB “somehow is associated with [LV] or at least has consented to the use of its trademark.” *Lois Sportswear*, 799 F.2d at 873.

With respect to the *Polaroid* factors themselves, the unbroken rule in this Circuit is that, whereas the district court’s ultimate *balancing* of the *Polaroid* factors is an issue of law, there are strict limits on the district court’s fact-finding ability when evaluating each individual *Polaroid* factor. *Mana Products v. Columbia Cosmetics Mfg.*, 65 F.3d 1063, 1069 (2d Cir. 1995); *see also, Cadbury Bevs., Inc. v. Cott Corp.*, 73 F.3d 474, 478-79 (2d Cir. 1996) (vacating summary judgment for movant defendants where court failed to draw all inferences in plaintiff’s favor and impermissibly resolved disputed questions of fact in defendants’ favor).

The district court resolved disputed issues, mostly relying on its parody conclusion to dismiss Louis Vuitton’s compelling evidence on the *Polaroid* factors. This necessarily fails.

Strength and Similarity: Parody is irrelevant to the strength of Louis Vuitton’s marks, which are among the strongest in the world. Similarity is not a matter of the district court’s own analysis in its chambers, but the real life circumstances in which the products are viewed by the consuming public. *Louis*

Vuitton Malletier, S.A. v. Burlington Coat Factory Warehouse Corp., 426 F.3d 532, 537 (2d Cir. 2005). On this record, it cannot be said that consumers in the post-sale context would view the images on the side of MOB's products as parody or dissimilar to the LV Trademarks, particularly since the "My Other Bag" markings would not even be visible.

Proximity and Bridging the Gap: Tara Martin herself claimed her bags were "stylish" and an "ode" to designer bags, promoting them as a complement to or even a substitute for, Louis Vuitton bags, many of which have been similarly designed to "carry groceries, gym clothes, or beach gear."¹² (Resp.3; Br.8-9.) This overlap in targeted consumers, use, and audience appeal weighs in favor of proximity.

There is, meanwhile, no such thing as a "parody bag" market, and no reasonable interpretation of this factor would ever refer to a market reverse-engineered in this way. Consumers could easily have concluded that Louis Vuitton licensed or approved the use of its marks on less expensive products, as this factor anticipates. *Cadbury*, 73 F.3d at 482 (district court erred in concluding that this factor favored defendant as a matter of law where "it is surely plausible that a

¹² Contrary to MOB's assertion, *Nikon Inc. v. Ikon Corp.*, 987 F.2d 91, 95 (2d Cir. 1993), found there was proximity where products were sold at different price points but marketed "through similar channels of trade and to similar customers." The same is true here.

manufacturer of branded products...would enter the private-label market” or that purchasers might conclude that plaintiff had already done so).

Actual Confusion: Louis Vuitton offered more than a dozen instances of actual confusion, far surpassing the two instances of confusion found in each of *Nora Bevs., Inc. v. Perrier Grp. of Am., Inc.*, 269 F.3d 114 (2d Cir. 2001), and *Medici Classics Prods. LLC v. Medici Group*, 683 F. Supp. 2d 304, 312 (S.D.N.Y. 2010). Survey evidence, meanwhile, is not necessary for a finding of likely confusion. *See, e.g., Sports Auth., Inc. v. Prime Hospitality Corp.*, 89 F.3d 955, 967 (2d Cir. 1996).

Good Faith: MOB clearly had an “intention of capitalizing on [LV’s] reputation and goodwill” by creating and promoting a marketing campaign that fostered an association between the brands to sell MOB bags. (Br.54-55.) Louis Vuitton’s evidence showed that MOB’s parody claim was a *post hoc* rationalization. (Br.39-44.)

Quality of the Products: MOB’s inferior quality would clearly “tarnish[] plaintiff’s reputation if consumers confuse the two.” *Morningside Grp., Ltd. v. Morningside Capital Grp., LLC*, 182 F.3d 133, 142 (2d Cir. 1999).

Sophistication of the Consumers: MOB relies on *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 561 F. Supp. 2d 368 (S.D.N.Y. 2008), to argue the sophistication of Louis Vuitton’s consumers weighs against likely confusion. This

Court has rejected this view. *See, e.g., Lois Sportswear*, 799 F.2d at 875 (“in the post-sale context, the sophisticated buyer is more likely to be affected by the sight of appellee’s stitching patterns ... [and] to transfer goodwill”); *Gotrian, Helffrich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331, 1342 (2d Cir. 1975) (harm is that sophisticated potential purchasers would believe there was some connection between plaintiff and defendant).

Characteristically, the law professor amici try to salvage the district court’s improper analysis by making again here their spurious claim that MOB’s use was expressive or artistic speech. But even they must admit that, if that speech is misleading or confusing, it may not be protected under the *Rogers v. Grimaldi* test. Their claim that the parodic purpose precludes confusion assumes its conclusion, as the *Polaroid* factors exist to determine whether consumers were confused. Nor is there a shred of authority for the amici’s unsupported view that a mere claim of parody should alter the burden of proof.

III. LOUIS VUITTON IS ENTITLED TO SUMMARY JUDGEMENT ON ITS COPYRIGHT INFRINGEMENT CLAIM.

It is undisputed that the LV Copyrights are valid and MOB copied them in creating its “London-Carry All,” “Zoey-Multi,” and “Zoey-Multi Black.” (Br.60-61.) MOB’s defense is that (1) its London and Zoey totes are not substantially similar to the LV Copyrights and (2) its “renderings” are fair use. Neither is true.

A. Substantial Similarity.

Under this Court’s test for substantial similarity, MOB’s renderings are substantially similar to the LV Copyrights. (Br.61-62.) In response, MOB tries to explain away its artist’s admission that the monogram layout has “a similar feel” to the LV copyright by claiming he used “cartoon hand-drawn” images not identical to the original. (Resp.65.) Exact duplication is not required for substantial similarity, however. *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1004 (2d Cir. 1995). It is sufficient that MOB misappropriated the original way in which Louis Vuitton “selected, coordinated, and arranged the elements of the [LV Copyrights].” *Id.* (internal quotations omitted).

MOB next argues that the Court must disregard unprotectable elements and that the LV Copyrights can protect only the 33 colors in a particular sequence. Its own renderings, it argues, used only eight colors in a “seemingly random scheme,” and are therefore not substantially similar. (Resp.65-66.) This Circuit, however, has rejected the notion that it must “dissect [the works] into their separate components, and compare only those elements which are in themselves copyrightable.” *Knitwaves*, 71 F.3d at 1003; *Boisson v. Banian, Ltd.*, 273 F.2d 262, 272 (2d Cir. 2001). Rather, it is guided by comparing the design’s total concept and overall feel, which were substantially similar here. *See Tufenkian*

Import/Export Ventures, Inc. v. Einstein Moomjy, Inc., 338 F.3d 127, 133-134 (2d Cir. 2003).

B. Fair Use.

The district court's fair use analysis in the copyright context incorrectly analyzed the factors and wrongly injected into them its views of MOB's supposed joke. (Br.63-65.) Neither MOB nor the overzealous amici provide any support for these errors.

Purpose and Character of the Use: MOB and the amici claim that the commercial nature of MOB's use does not matter under *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). Even post-*Campbell*, "the greater the private economic rewards reaped by the secondary user (to the exclusion of broader public benefits),... the less likely the use will be considered fair." *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 922 (2d Cir. 1994). Where the secondary use "can fairly be characterized as a form of 'commercial exploitation,' *i.e.*, when the copier directly and exclusively acquires conspicuous financial rewards from its use of the copyrighted material," and is also not substantially transformative, a finding of fair use becomes less likely. *Id.* at 922-23; *cf. Blanch v. Koons*, 467 F.3d 244, 254 (2d Cir. 2006) (substantially transformative secondary use diminished significance of commercialism). Nor is a use transformative "where the defendant

has done no more than find a new way to exploit the creative virtues of the original work.” *Koons*, 467 F.3d at 252 (collecting cases).

MOB and the amici again utter their parody refrain, claiming that the MOB bags are “asking that the viewer not take the person toting the bag so seriously.” (Resp.62) (emphasis omitted). Like the district court, they disregard MOB’s pre-litigation statements directly to the contrary, and they ignore that MOB’s use successfully prompted consumer comments such as “[t]he amazing design looks like you’re [sic] expensive hand bags like...Louis Vuitton” and “I have a LV Speedy and...having a canvas tote with style is the perfect in between.” (Br.16-18.) This is precisely the type of use that is *not* transformative. As this Court has stressed, “[a]n author’s right to control and profit from the dissemination of her work ought not to be evaded by conversion of the work into a different form.” *Authors Guild v. Google, Inc.*, 804 F.3d 202, 225 (2d Cir. 2015).

Nevertheless, the amici urge for “interpretive modesty” so that “if a new meaning or message would be reasonably discernable,” the work is transformative. (Amicus Br.24-25.) This Circuit has repeatedly rejected this approach where the record reveals that the defendant intended to profit from or merely pay homage to

plaintiff's popularity. *Castle Rock Entm't, Inc. v. Carol Publ'g Grp., Inc.*, 150 F.3d 132, 142-43 (2d Cir. 1998); *Salinger*, 641 F. Supp. 2d at 260.¹³

MOB and the amici also disregard the unambiguous requirement that, to constitute parody under the Copyright Act's fair use doctrine, MOB's products must critique or comment on the LV Copyrights themselves. (Br.64-65.) MOB's use of the LV Copyrights, like its use of renderings of other handbags, was to create a "perfect complement to [the designer] bags we love" as a "cute fashion reusable tote." (Br.10.) MOB cannot demonstrate any "genuine creative rationale for borrowing" the LV copyrights. *Koons*, 467 F.3d at 255.

The amici's claim that everything humorous is creative only underscores how their approach would eviscerate copyright law. Not surprisingly, the Supreme Court has rejected any such argument. *Campbell*, 510 U.S. at 584 ("[P]arody may or may not be fair use, and [the] suggestion that any parodic use is presumptively fair has no...justification in law or fact...").

Nature of the Copyrighted Work: MOB never disputes that "creative...works are generally more deserving of protection than factual works,"

¹³ MOB and the amici ignore *Castle Rock*, where this Court rejected a parody defense given defendant's purpose, as here, to capitalize on the fan's enjoyment of the plaintiff's product. 150 F.3d at 142-43. MOB distinguishes *Salinger* on the false premise that MOB's intent to parody was "evident" from its inception, disregarding the unchallenged evidence to the contrary.

Warner Bros. Entm't Inc. v. RDR Books, 575 F. Supp. 2d 513, 549 (S.D.N.Y. 2008), or that the LV Copyrights are creative works. The amici, however, claim that the LV Copyrights are “published works” widely available to the public and extensively advertised. But the creative designs of renowned contemporary artist Takashi Murakami are not akin to thumbnails of photographs in a search engine database, *Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003), or terms and figures from a human development training program, *Arica Inst. v. Palmer*, 970 F.2d 1067 (2d Cir. 1992).

MOB and the amici also urge this Court to adopt the district court’s misapprehension that Louis Vuitton’s copyright claim is nothing more than an effort to pursue a trademark and trade dress claim. Unlike trademark law, “copyright is a commercial right, intended to protect the ability of authors to profit from the exclusive right to merchandise their own work.” *Authors Guild*, 804 F.3d at 214. MOB admittedly copied LV’s Copyrights, making changes to try to avoid being sued while maintaining enough of a likeness so that consumers would associate MOB’s products with Louis Vuitton. (Br. 15-16; *see also* JA994-1006.) Its goal was to attract consumers whom it encouraged to purchase its products instead of those of Louis Vuitton. (JA336-347, JA405-410, JA1010-1013.)

Amount and Substantiality of Use: According to MOB, it used no protectable elements of the Louis Vuitton copyrights since it used only 8 of the 33

colors and the individual designs were not identical. This is the wrong inquiry. “[T]he question of fairness asks what else the parodist did besides go to the heart of the original.” *Campbell*, 510 U.S. at 589. MOB admitted that capturing the gist of the original was its objective. *Cf. Koons*, 467 F.3d at 257-58 (artist extracted only a woman’s legs and feet from the original photograph); *Authors Guild*, 804 F.3d at 222 (full-text search function aggregating thousands of books allowed public to see only “snippets” of books).

Effect Upon the Potential Market for or Value of the Copyrighted

Work: It is undisputed that Louis Vuitton sells casual canvas tote bags and has even sold bags with an artist’s rendering of its marks and bag. (Br.8-9.) MOB marketed its totes to Louis Vuitton’s own consumer base as an alternative to these bags. (Br.10-11.) As such, MOB impermissibly sought to serve as a market substitute for Louis Vuitton’s products.

Even if MOB’s products are less expensive, Louis Vuitton retains the exclusive right to create derivative works or, conversely, refrain from derivative uses. *Castle Rock*, 150 F.3d at 145-46. Unlike cases where plaintiff’s “work appeals to an *entirely different* sort of collector,” *cf. Cariou*, 714 F.3d at 709 (emphasis added), MOB’s target demographic here directly overlapped with Louis Vuitton’s market. (JA99; JA105-106; JA358-359; JA886-889; JA910; JA912; JA951; CA279-283; CA292-294.) Thus, MOB’s totes “substitute for a derivative

market” that Louis Vuitton could personally develop or license, and has in fact entered already.

CONCLUSION

For the foregoing reasons, this Court should reverse the decision below, enter judgment for Louis Vuitton on its dilution and copyright claims (or order a trial thereon), and grant Louis Vuitton a trial on its infringement and false designation of origin claims.

DATED: August 22, 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 6,996 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: August 22, 2016

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