

22-1006-cv

IN THE
United States Court of Appeals
FOR THE SECOND CIRCUIT

VANS, INC., VF OUTDOOR, LLC.,

Plaintiffs-Appellees,

v.

MSCHF PRODUCT STUDIO, INC.,

Defendant-Appellant.

*On Appeal from the United States District Court
for the Eastern District of New York*

**BRIEF FOR *AMICI CURIAE* AUTHORS ALLIANCE,
MASON ROTHSCHILD, AND ALFRED STEINER
IN SUPPORT OF NEITHER PARTY**

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CORPORATE DISCLOSURE STATEMENT

Pursuant to Fed. R. App. Proc. 26.1, amicus curiae Authors Alliance states that it does not have a parent corporation and that no publicly held corporation owns 10% or more of its stock.

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INTEREST OF AMICI

Mason Rothschild and Alfred Steiner are visual artists. Authors Alliance is a 501(c)(3) non-profit organization with over 2,300 members. Its mission is to advance the interests of authors who want to serve the public good by sharing their creations broadly. Amici have no pecuniary interest in the outcome of this case, but we have professional and humanitarian interests in seeing that the law develops in a way that protects artistic freedom and serves the public interest.¹ The parties in this case have consented to the request of amici to file this brief.

INTRODUCTION AND SUMMARY OF ARGUMENT

Brands have long been important subjects of artistic reflection and commentary. Trademark law does not give brand owners the right to control depictions of, or comments on, their brands. Nor can it. The First Amendment guarantees artists' right to depict the world as they see it and to respond in the marketplace of ideas to the inescapable corporate brand messages by which we are bombarded every day, virtually everywhere we look.

That First Amendment guarantee is practically nullified, however, if courts do not have a clear framework for disposing of unconstitutionally oppressive trademark suits early as a matter of law. Without such a speech-protective

¹ No party and no one other than the undersigned wrote any part of this brief or made any monetary contribution towards it.

framework, deep-pocketed brand owners can chill artists' exercise of their First Amendment rights simply by threatening or filing lawsuits that are unlikely to prevail on the merits but that will entail long, costly discovery battles.

This Court developed just such a clear and appropriately speech-protective framework in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Amici take no position on the applicability of the *Rogers* framework to MSCHF's *Wavy Baby* project at issue here. We write to urge the Court to clarify that First Amendment doctrine distinguishes between commercial and noncommercial *speech*, not commercial and noncommercial products. *Rogers* applies to noncommercial speech, which is speech that is the product consumers are asked to buy rather than advertising for some other product or service. Noncommercial speech can only be regulated by rules that satisfy strict scrutiny. The strong medicine of *Rogers* is necessary to deal with the extension of the Lanham Act—which usually regulates purely commercial speech—to noncommercial speech, including artistic works.

We further urge the Court to clarify that application of *Rogers* does not require consideration of the likelihood of confusion factors set out in *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961). *Rogers* insulates noncommercial speech unless it has no artistic relevance whatsoever or is explicitly misleading. Both artistic relevance and explicit misleadingness can and should regularly be evaluated on the face of the work and the immediate context

without need for extensive factual development; otherwise, the protective purpose of *Rogers* is lost.

ARGUMENT

I. Brands are Important Subjects of Artistic Reflection and Commentary

Well-known brands have long been the subject of artistic reflection and commentary. Andy Warhol famously depicted iconic brands, including Campbell's Soup and Coca-Cola, in stylized but plainly recognizable form.



In recent years, the significance of branding to popular culture has only grown, making brands even larger parts of our common cultural vocabulary. As Judge Furman recognized in evaluating a parody of Louis Vuitton's well-known handbags, the message of invoking a well known luxury brand derives from "the

² Andy Warhol, *Campbell's Soup Cans* (1962); *Coke Bottle* (1962).

features of the [product] itself, society's larger obsession with status symbols, and the meticulously promoted image of expensive taste (or showy status) that [those luxury products] have, to many, come to symbolize." *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 436 (S.D.N.Y. 2016), *aff'd*, 674 Fed. Appx. 16 (2d Cir. 2016) (emphasis in original). An artist's choice of which brands to depict is itself a reflection of that artist's view of the world, and art reproducing brands can illuminate the power brands have over people in our society. *See Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (recognizing the importance of brand references in modern social discourse); Stacey L. Dogan & Mark A. Lemley, *Parody as Brand*, 47 U.C. DAVIS L. REV. 473, 486 (2013) (speech about brands is "a valuable form of social commentary" that "invites critical reflection on the role of brands in society and the extent to which we define ourselves by them") (footnotes omitted); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 973 (1993) ("Trademarks are often selected for their effervescent qualities, and then injected into the stream of communication with the pressure of a firehose by means of mass media campaigns. Where trademarks come to carry so much communicative freight, allowing the trademark holder to restrict their use implicates our collective interest in free and open communication.").

Amici Mason Rothschild and Alfred Steiner, like Warhol and many other artists, have depicted and commented on the world around them by using trademarks to title certain of their artworks as well as in the content of the artworks themselves. Amicus Mason Rothschild is an American digital artist residing in Los Angeles who has created, among other works, a series of artworks that depict and comment on Hermès' "Birkin" handbags. In 2021, Mr. Rothschild created *Baby Birkin*, a digital artwork depicting a transparent Birkin handbag with a fetus gestating inside it.



Later that same year, Mr. Rothschild created his *MetaBirkins* series of digital artworks. Each of the 100 static images in Rothschild's *MetaBirkins* series is a

unique, fanciful interpretation of a Birkin bag, and each artwork is authenticated by a digital “non-fungible token,” or “NFT.” Rothschild’s art is made with pixels, but the bags are depicted as fur covered. This aspect of Rothschild’s art comments on the animal cruelty inherent in Hermès’ manufacture of its ultra-expensive leather handbags.³



Amicus Alfred Steiner is an artist in New York who often creates works for the express purpose of posing novel aesthetic and legal questions. For instance, Mr. Steiner created a parody of a Louis Vuitton boutique, complete with merchandise emblazoned with sloppily hand-drawn versions of the firm’s

³ Hermès has sued Mr. Rothschild for his fanciful depictions of Birkin bags and his identification of those images as *MetaBirkins*. That case is currently pending in the Southern District of New York. See *Hermès International et al. v. Rothschild*, No. 22-cv-00384-JSR.

Monogram pattern, to critique the brand's overreaching trademark enforcement efforts.



Mr. Steiner also creates watercolors based on well-known trademarks composed of apparently random assortments of items to explore colonialism, class, and other issues.



Messrs. Rothschild and Steiner are far from the only artists who incorporate trademarks or images or trademarked products into their work. Tom Sachs is an American contemporary artist residing in New York City. Mr. Sachs has depicted and commented on trademarks and trademarked goods in some of his paintings and sculptures. For example, in his collection of “Handmade Paintings,” Sachs focuses on some iconic trademarks. “When I look at these paintings,” Sachs said, “to me they all speak about power. There is power in logos and power in good advertising.” Tom Sachs, <https://www.tomsachs.com/exhibitions/handmade-paintings> (last visited June 24, 2022).



Mr. Sachs has also commented on trademarks and trademarked products in his sculpture exhibition “Ritual.”

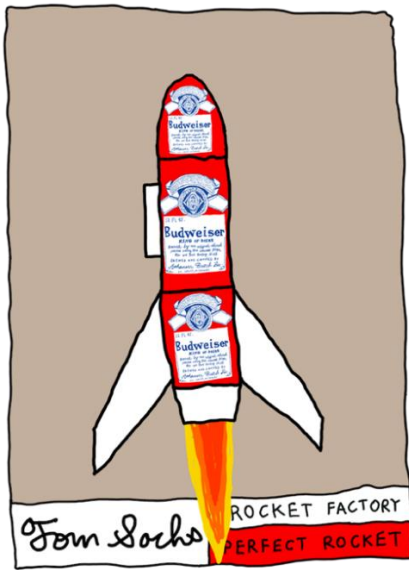


Mr. Sachs commented in connection with this exhibition that his artistic drive is powered by what he calls “guilty consumerism”; for him, the making of an object is a way of connecting with it, building intimacy. “As I create,” Sachs has stated, “I meditate on it and the lust of acquiring a product is replaced by the love of making it.” Tom Sachs, <https://www.tomsachs.com/exhibitions/ritual> (last visited June 24, 2022).

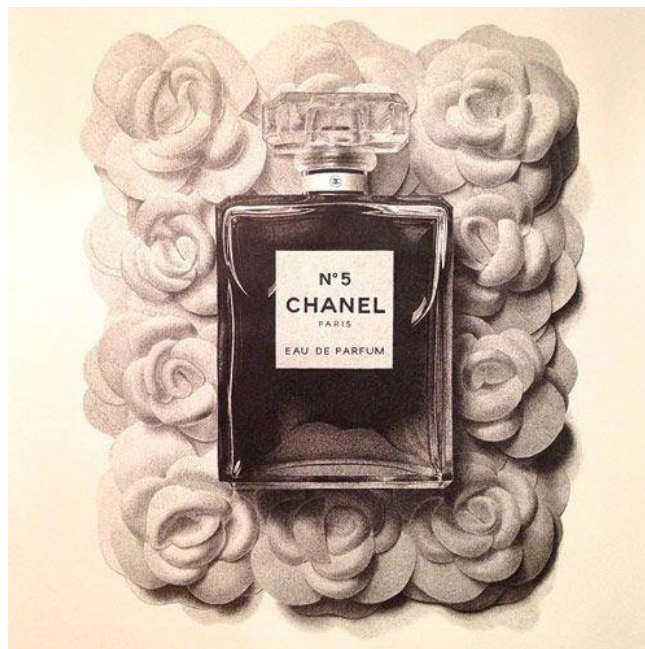
Like Mr. Rothschild, Mr. Sachs has recently produced art commenting on brands and has authenticated those artworks using NFTs. A recent example is Mr. Sachs’ “Rockets” collection, a series of artworks comprised of illustrations and

models of rockets marked with various trademarks. *See*

<https://tomsachsrocketfactory.com/rockets-and-components> (last visited June 24, 2022).



Australian-born and New York-based artist CJ Hendry made the pen-and-ink drawing of a Chanel No. 5 bottle.



And Belgian artist Cédric Peers has made several paintings featuring the Dom Perignon champagne trademarks owned by Moët Hennessy.



As these examples demonstrate, artists often refer to and depict brands in the world around them as part of their artistic work. This practice goes back at least as far as Édouard Manet's 1882 painting *A Bar at the Folies-Bergère*, which features prominently a bottle of Bass Ale—a product that bears the first trademark ever registered in the U.K.

All of these uses are at risk without clear legal rules that insulate artistic expression not only from ultimate liability, but also from being forced to litigate dubious claims by brand owners with deep pockets who seek to use the expense of trademark litigation as a weapon to chill First Amendment rights.

II. *Rogers* Keeps Trademark Law from Treading on First Amendment Interests

This Court has long recognized the importance of preventing trademark law from encroaching on First Amendment values. That is why it developed the speech-protective framework in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). *See id.* at 998 (“Though First Amendment concerns do not insulate titles of artistic works from all Lanham Act claims, such concerns must nonetheless inform our consideration of the scope of the Act as applied to claims involving such titles.”); *id.* (“Because overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict.”).

The *Rogers* framework is not based on a presumption that uses of trademarks in noncommercial speech will not be confusing. It is based on the recognition that noncommercial speech has different First Amendment status, and that ordinary application of the Lanham Act would impermissibly impinge on protected speech interests. Indeed, *Rogers* explicitly balanced concerns about consumer confusion against artists’ free speech interests and announced a categorical rule: “in the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some

artistic relevance, unless the title explicitly misleads as to the source or the content of the work.” *Id.* at 999.

This categorical balancing is required to protect artists’ First Amendment rights from being squelched by threats of suit. Categorical balancing protects individuals against chilling effects that are endemic to multifactor or highly context-sensitive tests—such as the test for the likelihood of trademark confusion set out in *Polaroid*. Application of multi-factor balancing tests enables plaintiffs to create apparent factual uncertainties and prolong costly litigation even when they are ultimately unlikely to prevail. *See* Melville B. Nimmer, *The Right to Speak from Times to Time: First Amendment Theory Applied to Libel and Misapplied to Privacy*, 56 CAL. L. REV. 935, 942-43 (1968).

III. First Amendment Doctrine Distinguishes Commercial and Non-Commercial Speech, not Commercial and Expressive Products

A. The Key Question is Whether the Speech Is Part of the Product Being Sold or is Merely Advertising for a Separate Product.

As the Supreme Court has confirmed multiple times, nonadvertising speech—including for-profit noncommercial speech—receives the highest level of constitutional protection and may be regulated only to further a compelling interest using the least restrictive means. *See, e.g., National Institute of Family and Life Advocates v. Becerra*, 138 S. Ct. 2361, 2374 (2018) (emphasizing that the Court has routinely applied strict scrutiny to regulations of noncommercial speech, and

that unobjectionable regulations of commercial speech would be unconstitutional as applied to noncommercial speech); *cf. Taubman Co. v. Webfeats*, 319 F.3d 770, 774 (6th Cir. 2003) (“The Lanham Act is constitutional because it only regulates commercial speech, which is entitled to reduced protections under the First Amendment.”) (citing *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557, 563 (1980)). *Rogers* is one way of implementing the requisite strict scrutiny when trademark owners sue noncommercial speakers.

Of particular importance, First Amendment doctrine does not distinguish between commercial and noncommercial *products*; it distinguishes between commercial and noncommercial *speech*. As the Supreme Court has long recognized, noncommercial speech is often sold for profit. *See, e.g., Brown v. Ent. Merchs. Ass’n*, 564 U.S. 786, 790 (2011) (video games); *City of Lakewood v. Plain Dealer Publ’g Co.*, 486 U.S. 750, 756 n.5 (1988) (citing *Pittsburgh Press Co. v. Pittsburgh Comm’n on Human Rel.*, 413 U.S. 376, 385 (1973)) (“Of course, the degree of First Amendment protection is not diminished merely because the newspaper or speech is sold rather than given away.”); *Smith v. California*, 361 U.S. 147, 150 (1959) (“It is of course no matter that the dissemination [of books] takes place under commercial auspices.”).

Speech that is itself the product consumers are asked to buy—whether in the form of a book, movie, sculpture, or anything else—is noncommercial. By

contrast, commercial speech generally does nothing more than propose a commercial transaction: it is, roughly speaking, an offer to sell something *other than the speech itself*. See, e.g., *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 499 (1996); *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 562-63 (1980).

Distinguishing between commercial and noncommercial speech in any particular case can be difficult. Yet it has been clear for decades that speech is not commercial simply because it is embodied in a physical product that people can buy. See, e.g., *Gaudiya Vaishnava Soc'y v. City & Cnty. of S.F.*, 952 F.2d 1059, 1063-65 (9th Cir. 1990) (rejecting argument that items with “intrinsic value” could not be noncommercial speech); cf. *Cohen v. California*, 403 U.S. 15, 18 (1971) (message displayed on clothing was fully protected speech); *Morse v. Frederick*, 551 U.S. 393 (2007); *Ayres v. City of Chicago*, 125 F.3d 1010, 1014 (7th Cir. 1997) (“The T-shirts that the plaintiff sells carry an extensive written message of social advocacy; . . . there is no question that the T-shirts are a medium of expression prima facie protected by the free speech clause of the First Amendment.”). To ignore a product’s expressive content and call it commercial simply because it is sold for profit, or because it is sold in a substantial number of copies, is like saying that newspaper readers are merely buying paper that just

happens to have print on it. *See Arkansas Writers' Project, Inc. v. Ragland*, 481 U.S. 221 (1987).

First Amendment protection of noncommercial speech extends not only to words, but also to nonverbal methods of communication. *Kaplan v. California*, 413 U.S. 115, 119 (1973) (noting that “pictures, films, paintings, drawings, and engravings” are protected by the First Amendment). The Supreme Court has consistently held that “the Constitution looks beyond written or spoken words as mediums of expression.” *Hurley v. Irish–American Gay, Lesbian and Bisexual Group of Boston*, 515 U.S. 557, 569 (1995); *see also Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989) (protecting music without words); *Schad v. Borough of Mount Ephraim*, 452 U.S. 61, 65-66 (1981) (protecting dance); *White v. City of Sparks*, 500 F.3d 953, 956 (9th Cir. 2007) (paintings); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807-08 (9th Cir. 2003) (photographs of Barbie dolls). The Supreme Court has been clear beyond dispute: “[A] narrow, succinctly articulable message is not a condition of constitutional protection, which if confined to expressions conveying a ‘particularized message,’ would never reach the unquestionably shielded painting of Jackson Pollack, music of Arnold Schönberg, or Jabberwocky verse of Lewis Carroll.” *Hurley*, 515 U.S. at 569 (citation omitted). Thus, even without words, courts must consider an artist’s intent

and whether a reasonable audience could recognize that communication—not just conduct—was taking place. *Spence*, 418 U.S. at 409.

Here, the lower court should have considered whether some commentary was a part of the product consumers were buying when they purchased *Wavy Baby* shoes. If it was, then *Rogers* should have applied, and the court should have evaluated whether MSCHF’s reference to the Vans mark was artistically relevant and not explicitly misleading. The court’s failure to consider the application of *Rogers* was error.

B. *Rogers* Appropriately Protects the Commercial/Noncommercial Speech Divide.

Rogers applies to speech that qualifies as noncommercial under this Court’s First Amendment precedents—speech that does not merely propose a commercial transaction and is instead the product being offered to the public. *See Radiance Foundation, Inc. v. N.A.A.C.P.*, 786 F.3d 316, 322 (4th Cir. 2015) (discussing *Rogers* as protection for “noncommercial” speech); *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1016-17 (3d Cir. 2008) (treating *Rogers* as creating a commercial/noncommercial speech division); *Dickinson v. Ryan Seacrest Enters., Inc.*, Case No. CV 18-2544-GW(JPRx), 2019 WL 3035090, at *8 (C.D. Cal. Mar. 26, 2019) (same); *Fortres Grand Corp. v. Warner Bros. Ent. Inc.*, 947 F. Supp. 2d 922, 933 (N.D. Ind. 2013) (same), *aff’d on other grounds*, 763 F.3d 696 (7th Cir. 2014); *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172,

177 (S.D.N.Y. 2012) (same); *U.S. Olympic Comm. v. Am. Media, Inc.*, 156 F. Supp. 2d 1200, 1209 (D. Colo. 2001) (same); *Lacoff v. Buena Vista Pub., Inc.*, 705 N.Y.S.2d 183, 191 (Sup. Ct. 2000) (same).

In *Rogers* itself, Ginger Rogers’s Lanham Act claim was specifically focused on the title of a film, and it was only the special characteristics of titles that made this Court believe there was anything to balance against the producers’ First Amendment interests. “Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker’s expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined.” *Rogers*, 875 F.2d at 998. In characterizing the case by reference to its facts, this Court was not describing a limited universe of “artistic works” that warrant special consideration. Instead, this Court created a framework for protecting noncommercial speech that gave some weight to trademark interests only because titles in particular have quasi-commercial characteristics.⁴

⁴ The *Rogers* framework is therefore more speech-protective than ordinary trademark cases involving commercial speech, but arguably more trademark-protective than general constitutional noncommercial speech standards—and thus may need strengthening to be fully consistent with the standard of strict scrutiny that the Supreme Court has made clear applies to all restrictions on noncommercial speech.

Rogers specifically recognizes that the presence of consumer confusion does not justify the suppression of noncommercial speech in the absence of explicit falsity by the speaker—especially given that courts applying the Lanham Act have not required a showing that any confusion be material to consumers’ decisions. Indeed, Ginger Rogers presented substantial evidence of confusion, including survey evidence, but the Court nonetheless rejected her claim. *Id.* at 1001; *see also id.* at 997 (discussing publicists’ initial confusion about the movie).

Reinforcing the reasoning of *Rogers*, the Supreme Court further recognized in *Matal v. Tam* that trademarks routinely express more than source indication, and the expressive dimensions of the marks warrant First Amendment protection. *See* 137 S. Ct. 1744, 1752, 1760 (2017). And in some situations, such as the use of trademarks in the titles of expressive works, those elements are inextricably intertwined. As the Court explained in *Rogers*:

The title of a movie may be both an integral element of the filmmaker’s expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined. Filmmakers and authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works. Furthermore, their interest in freedom of artistic expression is shared by their audience.⁵

⁵ Notably, while Ginger Rogers’s claim focused on use of her name in the title of the film, in fact the film used that name repeatedly in the content of the film – a film that was about characters who imitated Ginger Rogers and Fred Astaire. Rogers apparently did not even contest that use, and the court did not address it – presumably because everyone understood that the First Amendment interests are stronger, and the trademark interests weaker, with respect to non-title aspects of work content.

875 F.2d at 998.

When such intertwining occurs, the Supreme Court's precedents dictate treating the trademark-using speech as noncommercial. *See Riley v. Nat'l Fed'n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988) (“[W]e do not believe that the speech retains its commercial character when it is inextricably intertwined with otherwise fully protected speech”). Suppressing the commercial aspects of a parody artwork would of necessity suppress the noncommercial aspects, since the restraint would be on the use of the parody itself, unlike situations in which specific commercial promotions could be excised from otherwise noncommercial material. *Compare Bd. of Trs. of the State Univ. of N.Y. v. Fox*, 492 U.S. 469, 473-80 (1989) (finding educational presentations in “Tupperware parties” separable from accompanying sales pitches), *with, e.g., MCA Recs.*, 296 F.3d at 906-07 (the commercial purpose of using “Barbie” in a song title was “inextricably intertwined” with the “expressive elements” of the song) (citations omitted), *and Parks v. LaFace Recs.*, 329 F.3d 437, 449 (6th Cir. 2003) (“[I]f a song is sold, and the title is protected by the First Amendment, the title naturally will be ‘inextricably intertwined’ with the song’s commercial promotion.”) (citations omitted).

IV. Protecting Non-Commercial Speech Requires That *Rogers* be Applied in a Way That Allows Courts to Resolve Cases Early

It is critical to the effective protection of artists' First Amendment interests that *Rogers* be applied in a way that permits early dismissal of trademark claims—otherwise brand owners will be incentivized to use the expense of litigation as a weapon, even when their claims have no merit. As many courts have recognized, likelihood of confusion analysis is costly and time-consuming, and forcing defendants to litigate the likelihood of confusion chills expression.

Depending on the amount in controversy, the 2015 American Intellectual Property Law Association survey reported average trademark litigation costs through the end of discovery of \$150,000 to \$900,000. AIPLA, REPORT OF THE ECONOMIC SURVEY 2015, at 38-39 (2015). Very few artists have the resources to litigate a case that requires extensive discovery. *See, e.g., Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000) (“Competition is deterred ... not merely by successful suit but by the plausible threat of successful suit....”); *MCA Recs.*, 296 F.3d at 900-02; *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 306-08 (9th Cir. 1992); *see also* William McGeeveran, *The Imaginary Trademark Parody Crisis (and the Real One)*, 90 WASH. L. REV. 713, 741-45 (2015) (describing the prohibitive costs of going through litigation on likelihood of confusion, even when the defendant is likely to prevail); Sonia K. Katyal, *Stealth Marketing and Antibranding: The Love That Dare Not Speak Its Name*, 58

BUFFALO L. REV. 795, 821-23 (2010) (discussing Starbucks parodist’s inability to bear costs of litigating obvious parody); *id.* at 838-39 (discussing *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d. 1302 (N.D. Ga. 2008), in which seller of obviously parodic “Walocaust” and “Wal-qaeda” T-shirts was forced to litigate through summary judgment including rebutting plaintiff’s confusion survey); William McGeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 52 (2008) (discussing chilling effects of threatened trademark enforcement).

This is no abstract problem. Amicus Mason Rothschild moved to dismiss Hermès’ claims regarding Rothschild’s *MetaBirkins*—which Hermès concedes in its own pleadings are static images depicting fanciful Birkin bags—on the ground that those claims are barred by *Rogers*. The district court denied the motion, ruling that the case needed factual development and that resolution of Hermès’ claims would require consideration of the *Polaroid* factors. *See Hermès International*, No. 22-cv-00384-JSR, Dkt. No. 50. Mr. Rothschild’s motion to certify an interlocutory appeal is pending. *See id.* Dkt. No. 52. Meanwhile, burdensome and costly discovery in that case is underway.

A. The Boundaries of the *Rogers* Doctrine are Established Explicitly in *Rogers*: Artistic Relevance and Lack of Explicit Misleadingness.

i. Artistic Relevance Generally Is Apparent on the Face of a Work and the Immediate Context.

Under the first prong of the *Rogers* test, “courts must determine whether the use of the trademark has any artistic relevance whatsoever.” *Rogers*, 875 F.2d at 999. As courts in this Circuit have repeatedly noted, the requirement of minimal artistic relevance “is not unduly rigorous out of the understanding that the ‘overextension of Lanham Act restrictions ... might intrude on First Amendment values.’” *AM General LLC v. Activision Blizzard, Inc.*, 450 F. Supp. 3d 467, 477 (S.D.N.Y. 2020) (quoting *Rogers*, 875 F.2d at 998); *see also Rogers*, 875 F.2d at 999 (describing the “appropriately low threshold of minimal artistic relevance”); *Louis Vuitton*, 868 F. Supp. 2d at 178 (describing the artistic relevance threshold as “purposely low”). According to the Ninth Circuit, which adopted *Rogers* and has applied it to a wide range of noncommercial speech, artistic relevance must simply be “more than zero.” *E.S.S.*, 547 F.3d 1095. *See also Brown*, 724 F.3d at 1245 (“This black-and-white rule has the benefit of limiting [a court’s need] to engage in artistic analysis in this context.”).

As this Court has made clear, the artist’s choice of subject matter determines artistic relevance. In *Rogers*, this Court held the title “Ginger and Fred” artistically relevant because the central characters in the film were nicknamed “Ginger” and

“Fred.” 875 F.2d at 1001. Importantly, the film was not about Ginger Rogers and Fred Astaire—the characters were fictional and the filmmaker could have chosen different names, but the names were “not arbitrarily chosen just to exploit the publicity value of their real-life counterparts but instead ha[d] genuine relevance to the film’s story.” *Id.*; *see also id.* at 998 (“Filmmakers and authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works. Furthermore, their interest in freedom of artistic expression is shared by their audience. The subtleties of a title can enrich a reader’s or viewer’s understanding of a work.”). Indeed, because use of Ginger Rogers’ name was clearly artistically relevant and did not explicitly mislead, the court rejected her claim despite survey and anecdotal evidence of consumer confusion. *Id.* at 1001; *see also id.* at 997 (discussing publicists’ initial confusion about the movie).

Similarly, in *Louis Vuitton*, the court considered the use of a knock-off Louis Vuitton bag coupled with a character’s humorous mispronunciation of the brand in the movie *The Hangover: Part II*. 868 F. Supp. 2d at 178. In concluding that the use met the “low threshold” of artistic relevance, the court noted that the brief scene was able to effectively portray the character as “snobbish” and “socially inept and comically misinformed” precisely “because the public signifies Louis Vuitton . . . with luxury and a high society lifestyle.” *Id.* *See also Walking Mountain*, 353 F.3d at 807 (finding “Food Chain Barbie” series title and titles of

specific works referencing Barbie artistically relevant because they referred to artist's photographs, which depicted Barbie dolls).

To encourage the application of *Rogers* by lower courts in a way that vindicates artists' First Amendment interests as a practical matter, rather than only in theory, this Court should make clear that no factual inquiry is necessary to determine whether an artwork's title is artistically relevant to the content or message of the artwork itself. That is especially true when the title of the artwork describes, either directly or by implication, what the artwork portrays. Use of a trademark in a title is perhaps the most straightforward form of artistic relevance; indeed, it is precisely the sort of artistic relevance found in *Rogers* itself, where the title "Ginger and Fred" was deemed artistically relevant because "[t]he central characters in the film are nicknamed 'Ginger' and 'Fred,' and these names are not arbitrarily chosen just to exploit the publicity value of their real life counterparts but instead have genuine relevance to the film's story." *Rogers*, 875 F.2d at 1001.

Critically, *Rogers* did not require factfinding to determine that the title of the film was artistically relevant to its content. Nor did *Rogers* require the defendants to justify their choice to base a story on characters nicknamed Ginger and Fred—

this Court accepted the artists’ decision about the content of their work, and it evaluated artistic relevance in relation to the work the artists chose to make.⁶

ii. The Determination of Explicit Misleadingness Does Not Require Factfinding.

Where the use of a trademark has some artistic relevance, *Rogers* provides that the Lanham Act can be applied only if the use of the trademark “explicitly misleads as to the source of the work.” 875 F.2d at 999. But where the “artistic relevance” test set a low bar, this exception sets a high bar. Specifically, for the Lanham Act to apply to an artistically relevant use, the use must be explicitly misleading; implicit suggestions are not enough.

In *Rogers*, which rejected both survey evidence and anecdotal evidence of confusion among ordinary consumers and sophisticated market participants, this Court gave examples that illustrate the narrowness of the circumstances in which a court could find a use of a trademark in a title to be “explicitly misleading.”

Explicitly misleading titles, this Court held, would be “Nimmer on Copyright” for

⁶ The court in *Louis Vuitton* correctly applied *Rogers* on this point. The *Louis Vuitton* court expressly rejected the plaintiff’s argument in that case that discovery was needed “to determine whether Warner Bros. intended to use an authentic Louis Vuitton bag or Diophy’s knock-off bag” in the film at issue, ruling that the use was artistically relevant because “the significance of the airport scene relies on Alan’s bag— authentic or not—looking like a Louis Vuitton bag.” 868 F. Supp. 2d at 178. As in *Rogers*, the *Louis Vuitton* court did not require the producers of the film to justify their choice to write the scene in a way that focused on the authenticity of a Louis Vuitton bag; that court accepted the artists’ choice and evaluated artistic relevance in light of that choice.

a treatise that was not authored by Nimmer, or “Jane Fonda’s Workout Book” for a book Jane Fonda had nothing to do with. *Id.* Likewise, titles containing references that falsely and explicitly claimed endorsement—*e.g.*, “an authorized biography”—might be actionable. *Id.*

The *Rogers* court contrasted those explicitly misleading uses with the “many titles” that “include a well-known name without any overt indication of authorship or endorsement—for example, the hit song ‘Bette Davis Eyes,’ and the film ‘Come back to the Five and Dime, Jimmy Dean, Jimmy Dean.’” *Id.* “To some people, th[o]se titles might implicitly suggest that the named celebrity had endorsed the work or had a role in producing it.” *Id.* at 999-1000. But “the slight risk that such use of a celebrity’s name might implicitly suggest endorsement or sponsorship to some people is outweighed by the danger of restricting artistic expression, and the Lanham Act is not applicable.” *Id.* at 1000.

These examples make clear that explicit misleadingness cannot be established by use of the mark alone. Indeed, “if the use of a mark alone were sufficient ‘it would render *Rogers* a nullity.’” *Brown*, 724 F.3d at 1245 (quoting *MCA*, 296 F.3d at 902); *see also E.S.S.*, 547 F.3d at 1100 (“[T]he mere use of a trademark alone cannot suffice to make such use explicitly misleading.”); *Dr. Seuss Enters., L.P. v. Comicmix LLC*, 983 F.3d 443, 462-63 (9th Cir. 2020)

(concluding that the copying of distinctive elements of Dr. Seuss books was not explicitly misleading where the actual creator was disclosed).

These examples also demonstrate that explicit misleadingness can typically be determined on the face of a use and the immediate context; it does not require factfinding because the rule does not require the court to resolve any ambiguity. Under *Rogers*, the First Amendment “insulates from restriction titles [and works] with at least minimal artistic relevance that are ambiguous or only implicitly misleading.” *Id.* at 1000. Even when the artist is referring to the trademark claimant (as in *Rogers* itself), a use is not explicitly misleading when it requires the reader to draw an inference that there is a sponsorship or endorsement relationship between the parties, rather than making that assertion explicitly and directly. Put simply: factual development would only be necessary to help resolve ambiguity, but if the use is ambiguous, it cannot be explicitly misleading and therefore cannot support a claim under *Rogers*.

B. This Court Should Clarify that the *Rogers* Approach Does Not Require Consideration of the *Polaroid* Factors.

Critically, because the question of whether an artist’s use of a mark is explicitly misleading is not a function of the amount of possible confusion, courts applying *Rogers* need not, and should not, conduct a *Polaroid* analysis—as *Rogers* itself did not. Some lower courts in this Circuit have cited *Twin Peaks Productions, Inc. v. Publ’ns Intern., Ltd.*, 996 F.2d 1366 (2d Cir. 1993), for the proposition that

explicit misleadingness must be assessed, in the first instance, by way of the *Polaroid* factors. See, e.g., *Louis Vuitton*, 868 F. Supp. 2d at 179. But *Twin Peaks* involved a situation that *Rogers* itself clearly exempted from the *Rogers* framework: title-versus-title conflicts. This Court in *Twin Peaks*, characterizing the trademark issue as involving “the scope of trademark protection for literary titles,” see 875 F.2d at 1370, adhered to its earlier statement in *Rogers* that the *Rogers* test did not govern title-versus-title conflicts, *Rogers*, 875 F.2d at 999 fn. 5, though it emphasized that the First Amendment was still highly relevant. *Twin Peaks*, 996 F.2d at 1379.

The *Twin Peaks* “quick look” *Polaroid* approach applies, by its own terms, only when the plaintiff claims rights in the title of an artistic work, and the defendant uses that title for its own work.⁷ *Rogers* itself did not perform even a “quick look” *Polaroid* analysis. Instead, this Court rejected Ginger Rogers’ claim as a matter of law despite survey evidence showing that a not insubstantial percentage of the public misunderstood Rogers’ involvement in the film. It did so because that misunderstanding was “not engendered by any overt claim.” 875 F.2d

⁷ Title-versus-title cases would now frequently implicate the Supreme Court’s ruling in *Dastar v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (holding that “origin of goods” for purposes of the Lanham Act refers to the origin of tangible goods and not the origin of any intangible creative content). But however the *Twin Peaks* approach needs to be modified in light of *Dastar*, that approach is not relevant outside of title-versus-title cases.

at 1001; *cf. Brown*, 724 F.3d at 1245 (holding that survey evidence showing that the majority of consumers believe that identifying marks cannot be included in games without permission “changes nothing” in the *Rogers* analysis in the absence of an explicitly misleading affirmative claim).⁸

As the Ninth Circuit held, “[t]he [*Rogers*] test requires that the use be explicitly misleading to consumers. To be relevant, evidence must relate to the nature of the behavior of the identifying material’s user, not the impact of the use.” *Brown*, 724 F.3d at 1245-46; *Twentieth Century Fox*, 875 F.3d at 1199 (“We must ask not only about the likelihood of consumer confusion but also whether there was an explicit indication, overt claim, or explicit misstatement that caused such consumer confusion.”) (cleaned up); *Univ. of Ala. Bd. of Trustees*, 683 F.3d at 1279 (similar).

The First Amendment foundations of *Rogers* explains why the rule must be strong: noncommercial speech is vulnerable to chilling effects. If the rule required extensive factfinding before upholding artistic freedom, as it always would if courts were required to evaluate the *Polaroid* factors to apply *Rogers*, then a

⁸ Even when courts have performed a “quick look” *Polaroid* analysis, they have been clear that the likelihood of confusion must be “particularly compelling” to outweigh the First Amendment interests in artistic expression. *See Twin Peaks*, 996 F.2d at 1379.

trademark owner would be able to deter speech by the threat of a lawsuit, even an unsuccessful one. *See* McGeveran, *supra*.

CONCLUSION

Whether or not the Court holds that *Rogers* applies in this case, the Court should clarify (i) that First Amendment doctrine distinguishes between commercial and noncommercial *speech*, not commercial and noncommercial products; (ii) that application of *Rogers* does not require consideration of the *Polaroid* likelihood of confusion factors; and (iii) that artistic relevance and explicit misleadingness under the *Rogers* framework can and should be evaluated on the face of the speech at issue.

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