



PROGRAM MATERIALS
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Is Trademark Protection Going to the Dogs?

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ASHLEY KOLEY, ESQ.

Is Trademark Protection Going to the Dogs?

A presentation for



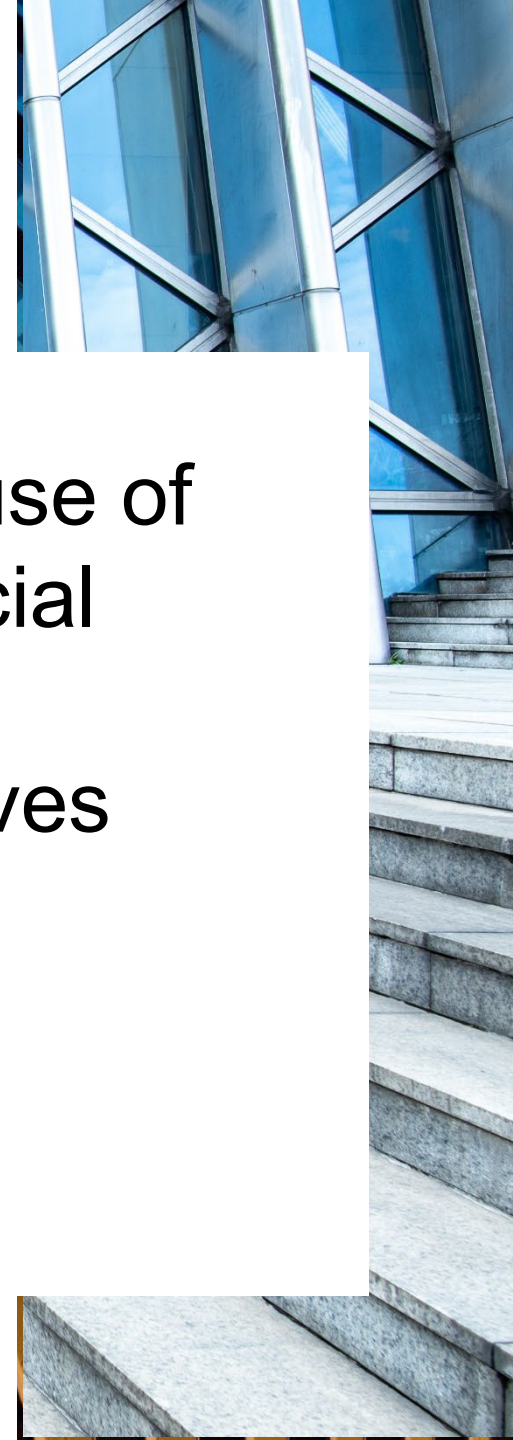
March 7, 2023

VIP Prods. LLC v. Jack Daniel's Properties, Inc., 953 F.3d 1170 (9th Cir. 2020)



Jack Daniel's Properties, Inc. v. VIP Prods. LLC, No. 22-148

- **QUESTION PRESENTED:** Whether humorous use of another's trademark as one's own on a commercial product is subject to the Lanham Act's traditional likelihood-of-confusion analysis, or instead receives heightened First Amendment protection from trademark-infringement claims.



Agenda

- Introduction
- Background – Fair Use
- *Rogers v. Grimaldi* and its Progeny
- Takeaways
- Questions: jmoskin@foley.com or akoley@foley.com



The Starting Point

- “When the mark is used in a way that does not deceive the public, we see no such sanctity in the word as to prevent its being used to tell the truth.”

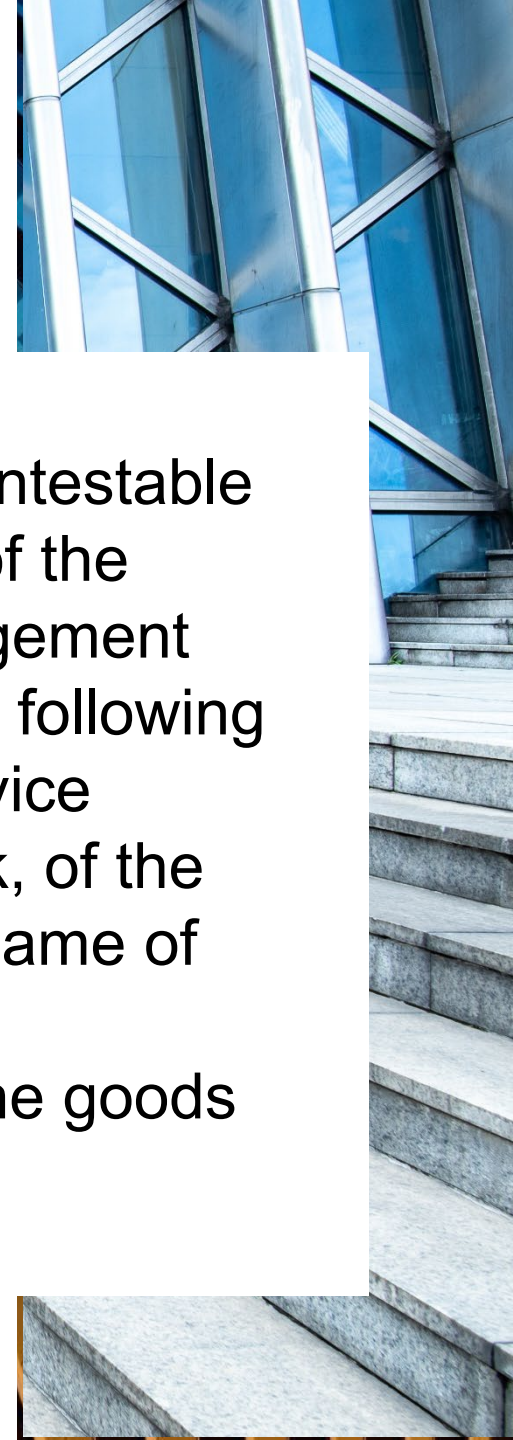
Prestonettes, Inc. v. Coty, 264 U.S. 359, 369 (1924) (Holmes, J.)



Statutory Fair Use

- To the extent the right to use a registered mark has become incontestable under Section 1065 of this title . . . : [s]uch conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in Section 1114 of this title, and shall be subject to the following defenses or defects:...(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin.

15 U.S.C. § 1115(b)(4)(e)



KP Permanent Make-Up, Inc. v. Lasting Impression, Inc., 543 U.S. 111 (2004)



The screenshot shows the Dawn Cragg International Make-Up Designer website. The header features the name 'Dawn Cragg' in a cursive font and 'INTERNATIONAL MAKE-UP DESIGNER' in a sans-serif font. Below the header are navigation buttons for 'TREATMENTS', 'TRAINING', 'PRODUCTS', and 'CONTACT US'. A vertical sidebar on the left contains buttons for various services: Introduction, Micro-Pigmentation, Micro Colors, **Magic Pigments**, Practise Materials, Body Art, Magic Stylo, Videos & Books, Eyebrow Design, Eyelash Perming, Scale of Charges, and Order Form. The main content area is titled 'MICRO-COLORS® Pigment' and includes a list of 80 pigment colors, a list of product benefits, and a 'BEWARE' warning about counterfeit products. A small image of a pigment bottle is shown on the right.

MICRO-COLORS® Pigment

*80 Pigment Colours to Match Over 3000 Skin Tones
For Cosmetic & Paramedical Procedures*

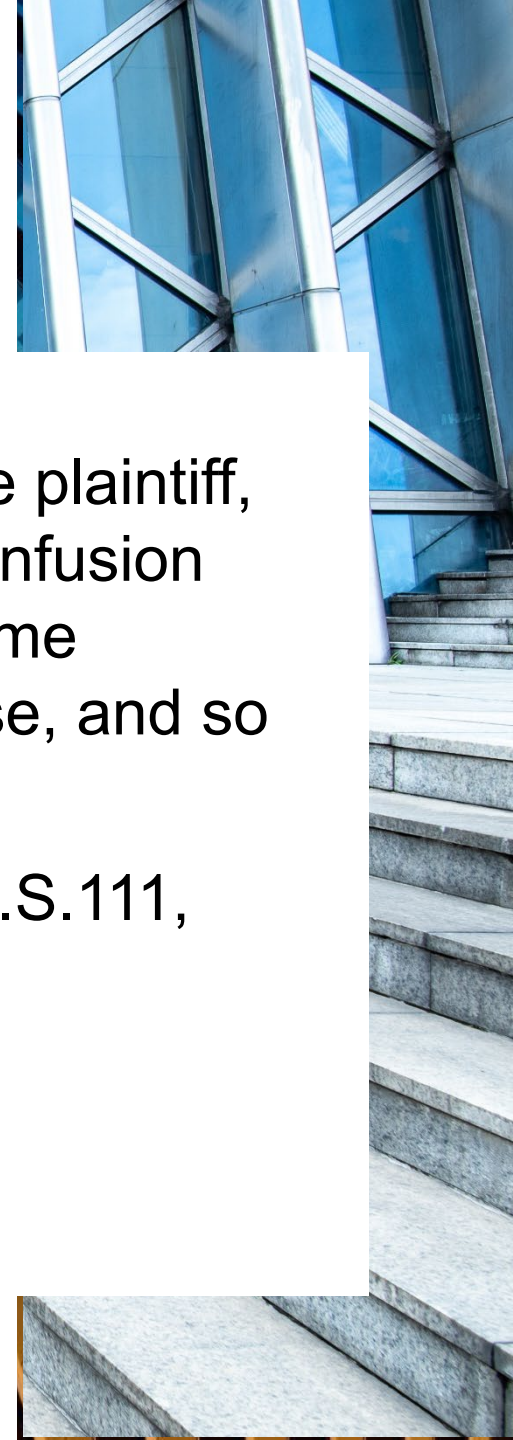
- Iron oxide base*
- No evaporation or splatter
- Same consistency and color every batch
- Contains no water
- Minimum particle size is 6 microns
- Gamma sterilized
- Lot & date coded to assure quality and freshness
- Widely used in medical and cosmetic industry
- Made in USA
- 12cc size
- Ingredient list on label
- Made with FDA approved ingredients for cosmetic use.

BEWARE: MICRO-COLORS® Pigment is the first and only MICRO-COLORS available by MCN. All brands with similar or identical names are not associated with MCN. Due to the high demand for this superior quality pigment, many impostor pigments have been developed to create confusion in the marketplace. Make an informed purchase decision; verify that MCN is the manufacturer before you buy. MICRO-COLORS is a federally registered trade name and trademark that is only available via MCN**.

The Holding

- “Since the burden of proving likelihood of confusion rests with the plaintiff, and the fair use defendant has no free-standing need to show confusion unlikely, it follows (contrary to the Court of Appeal’s view) that some possibility of consumer confusion must be compatible with fair use, and so it is.”

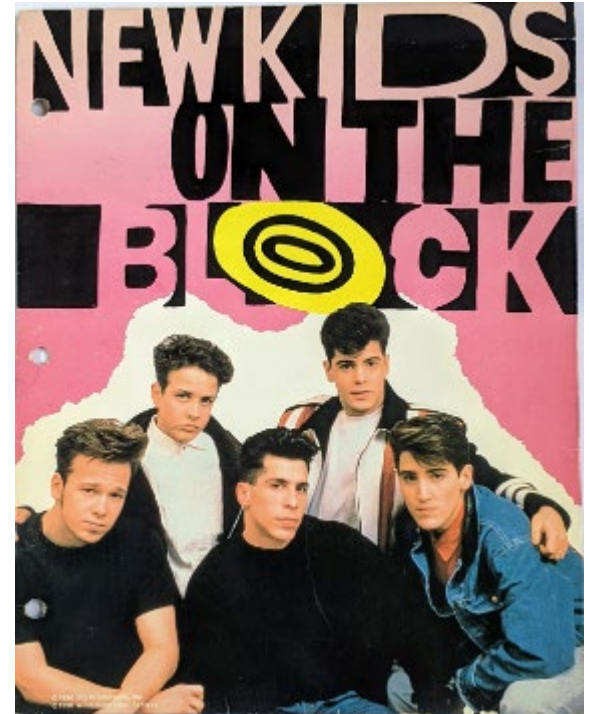
KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S.111, 125 S.Ct. 542, 550, 160 L.Ed.2d 440 (2004)



Nominative Fair Use v. Classic Fair Use

- “We may generalize a class of cases where the use of the trademark does not attempt to capitalize on consumer confusion or to appropriate the cachet of one product for a different one. Such nominative use of a mark—where the only word reasonably available to describe a particular thing is pressed into service—lies outside the strictures of trademark law”

New Kids on the Block v. News America Publishing, Inc., 971 F.2d 302, 308 (9th Cir. 1992)



Nominative Fair Use v. Classic Fair Use

(continued)

- In classic or statutory fair use, the defendant uses the plaintiff's mark to describe the defendant's own product whereas in nominative fair use the name is used by the defendant to describe or refer to the plaintiff's product.

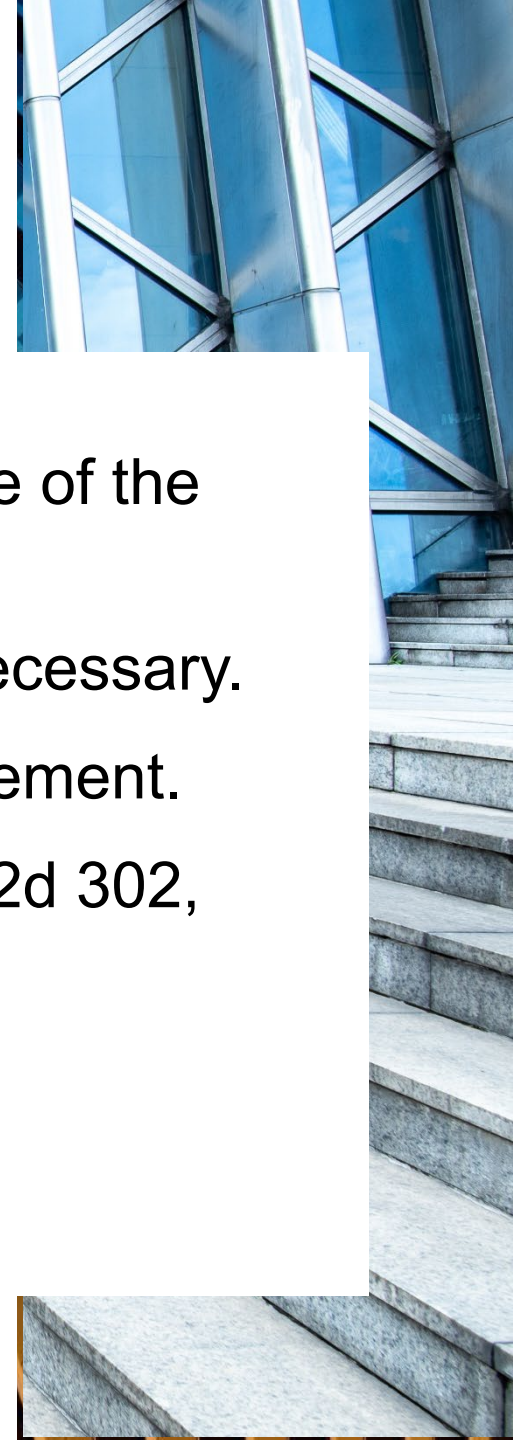
Cairns v. Franklin Mint Co., 292 F.3d 1139 (9th Cir. 2002).



Nominative Fair Use – Three Part Test

1. That the product or service not be readily identifiable without use of the mark.
2. That only so much use of the mark be made as is reasonably necessary.
3. That the user do nothing else to suggest sponsorship or endorsement.

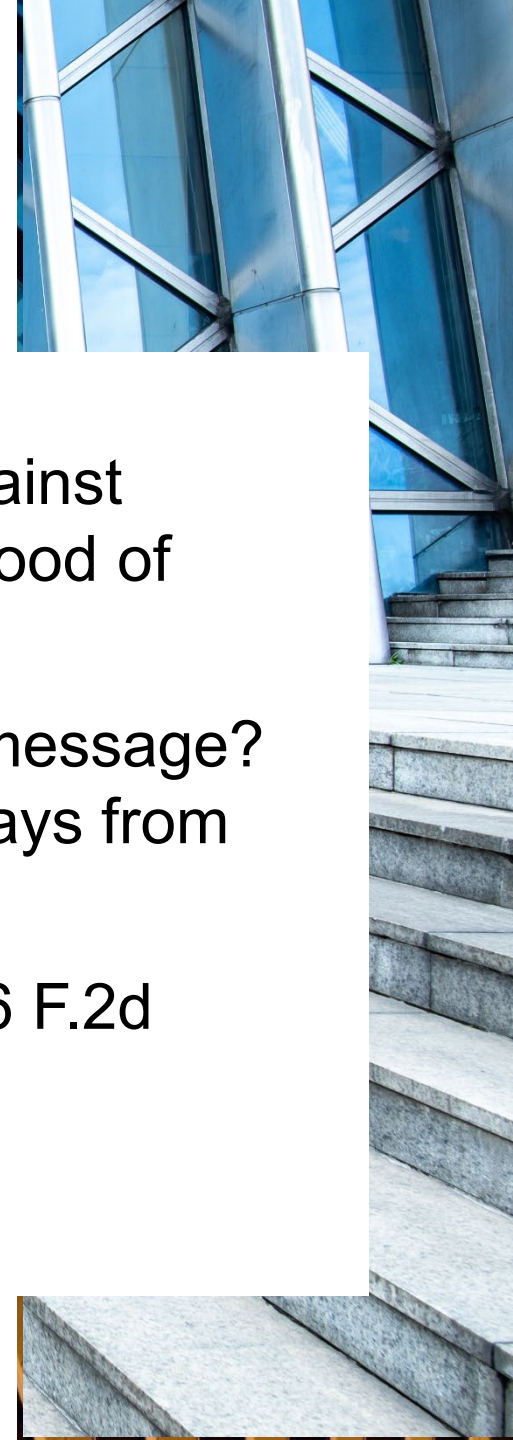
New Kids on the Block v. News America Publishing, Inc., 971 F.2d 302, 308 (9th Cir. 1992)



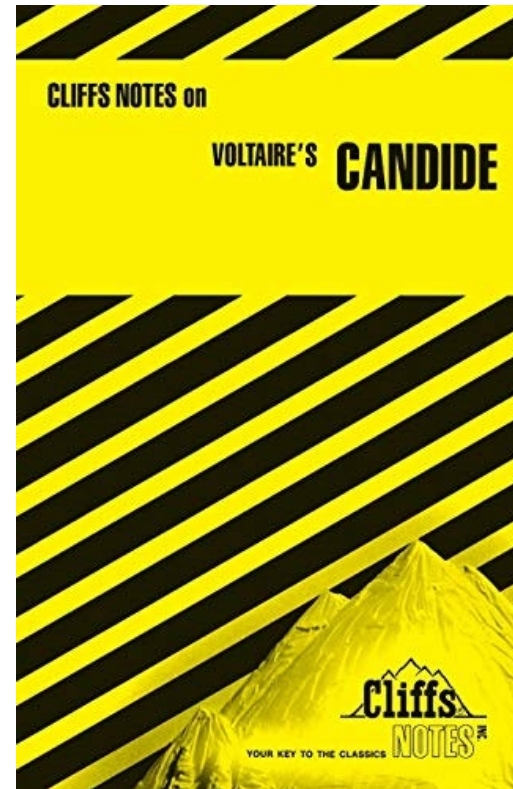
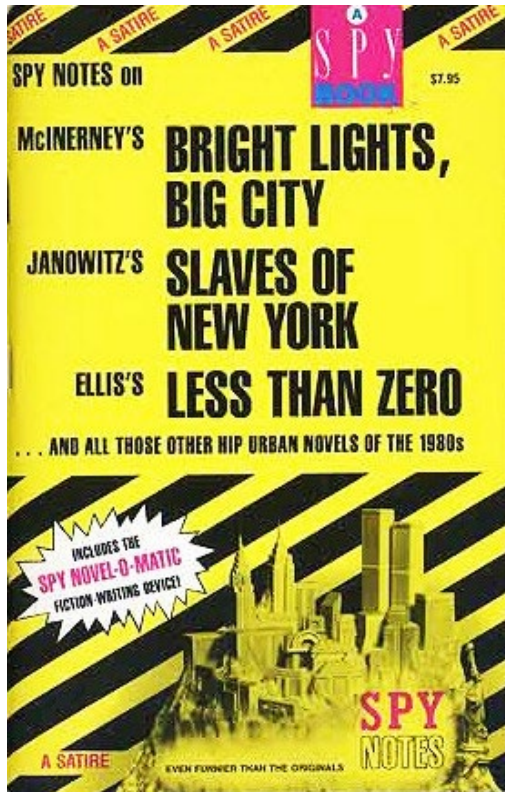
Parody

- Balancing First Amendment interest in freedom of expression against trademark owner's proprietary rights in its name or mark. Likelihood of confusion factors of secondary importance.
- Fair use if a defendant has a message and remains true to that message? Infringement if the defendant lacks a substantive message or strays from that message?

Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc., 886 F.2d 490, 495-97 (2d Cir. 1989).



Spy Notes Cover vs. Cliffs Notes Covers



Grey v. Campbell Soup, 650 F. Supp. 1166 (C.D.Cal. 1986), aff'd, 830 F.2d 197 (9th Cir. 1987)

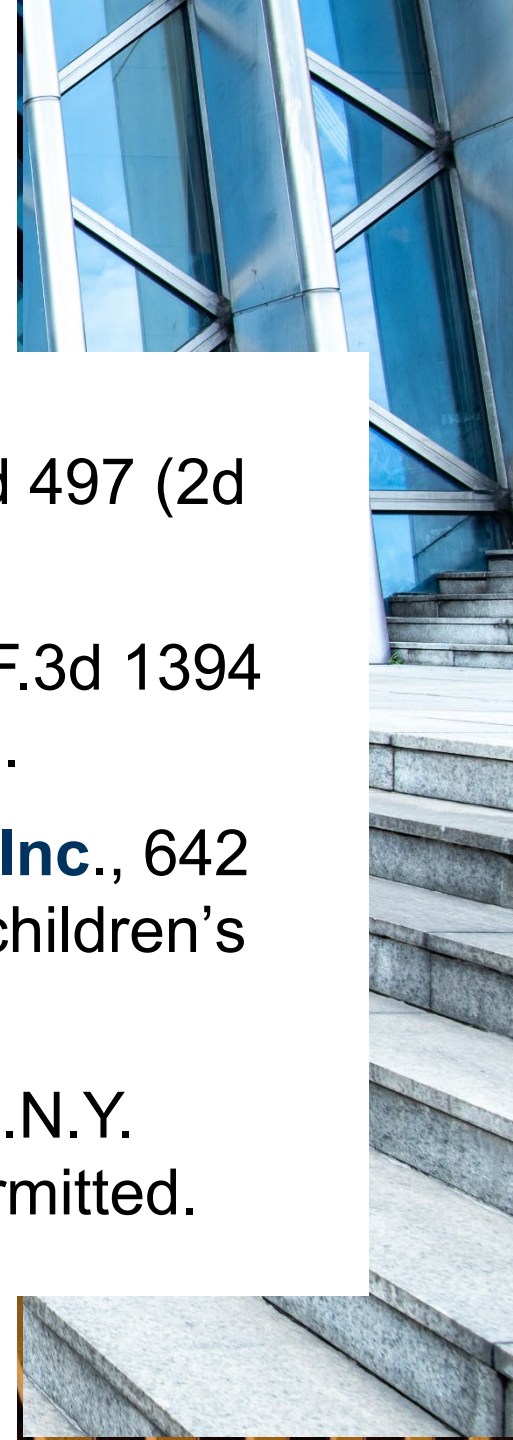


Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252 (4th Cir. 2007)



Other Inconsistent Results

- **Hormel Foods Corp. v. Jim Henson Productions, Inc.**, 73 F.3d 497 (2d Cir. 1996): “Spa’am” character a permitted parody.
- **Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.**, 109 F.3d 1394 (9th Cir. 1997): enjoined a book satirizing Dr. Seuss’ literary style.
- **Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.**, 642 F.Supp. 1031 (N.D. Ga. 1988), defendant’s “Garbage Pail Kids” children’s stickers parodying Cabbage Patch Kids were enjoined.
- **Tetley, Inc. v. Topps Chewing Gum, Inc.**, 556 F.Supp. 785 (E.D.N.Y. 1983), the same company’s “Wacky Packages” stickers were permitted.



Jim Beam Brands v Jack Co. of Boca, 9:91-cv-08821-JCP (S.D.Fla)



Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989)

- **Two-part test:**
- “In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the [Lanham] Act unless [1] the title has no artistic relevance to the underlying work whatsoever, or, [2] if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.” *Id.* at 999.



Application of Rogers Test for Expressive Works/Titles

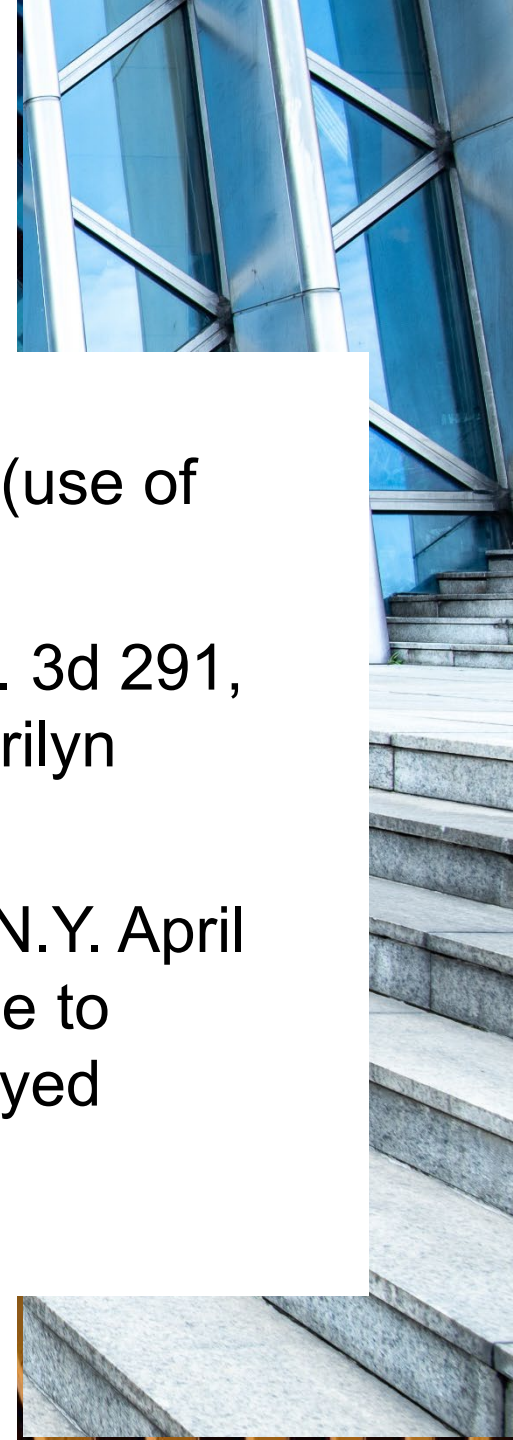
- **Mattel, Inc. v. Walking Mountain Prods.**, 353 F.3d 792 (9th Cir. 2003)(use of “Barbie” permitted in **titles** of photographs of nude Barbies in danger of being attacked by vintage household appliances).
- **E.S.S. Ent’mt 2000 Inc. v. Rock Star Videos Inc.**, 547 F.3d 1095 (9th Cir. 2008) (permitting depiction of strip club and logo in Grand Theft Auto; anything “above zero” artistic relevance standard)
- **Radiance Found., Inc. v. NAACP**, 786 F.3d 316 (4th Cir. 2015) (use of NAACP mark in anti-abortion billboard and campaign to solicit donations and sponsorship).

Tommy Hilfiger, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410 (S.D.N.Y. 2002)



Rogers Not Applied

- **Parks v. LaFace Records**, 329 F.3d 437, 451–52 (6th Cir. 2003)(use of name “Rosa Parks” in song title infringing).
- **A.V.E.L.A., Inc. v. Estate of Marilyn Monroe, LLC**, 364 F. Supp. 3d 291, 309, 322 (S.D.N.Y. 2019)(Rogers inapplicable to T-shirts with Marilyn Monroe-related marks “ordinary commercial product).
- **Vans, Inc. v. MSCHF Product Studio**, 602 F.Supp.3d 358 (E.D.N.Y. April 29, 2022), appeal filed, No. 22-1006 (2d Cir.) (Rogers inapplicable to sneakers that allegedly parodied a Vans shoe design; appeal stayed pending outcome of *Jack Daniels v. VIP*).



Univ. of Alabama v. New Life Art, Inc., 683 F.3d. 1266 (11th Cir. 2012)

- Applied Rogers to artistic works incorporating university's marks but **not** to related commercial goods incorporating the same marks.

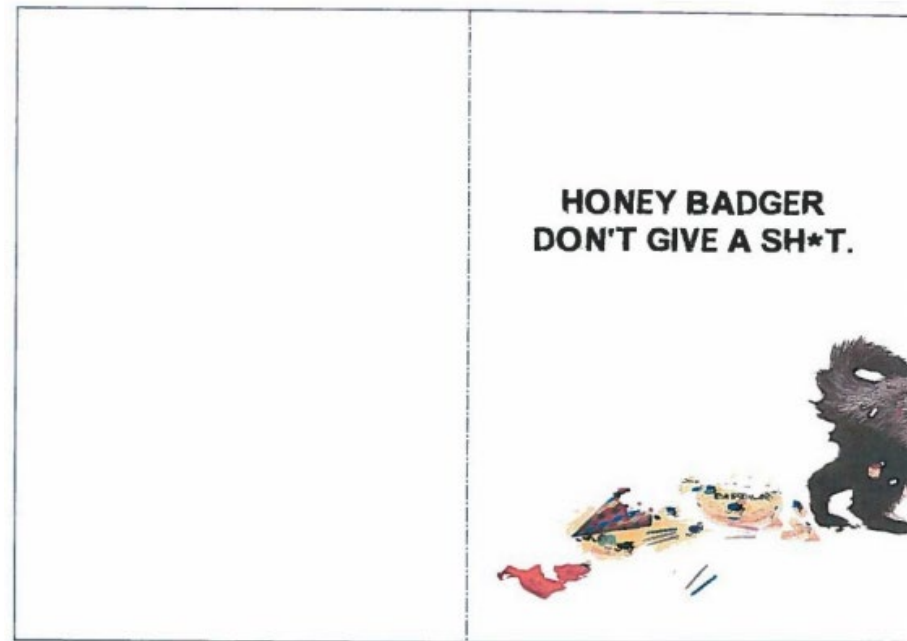
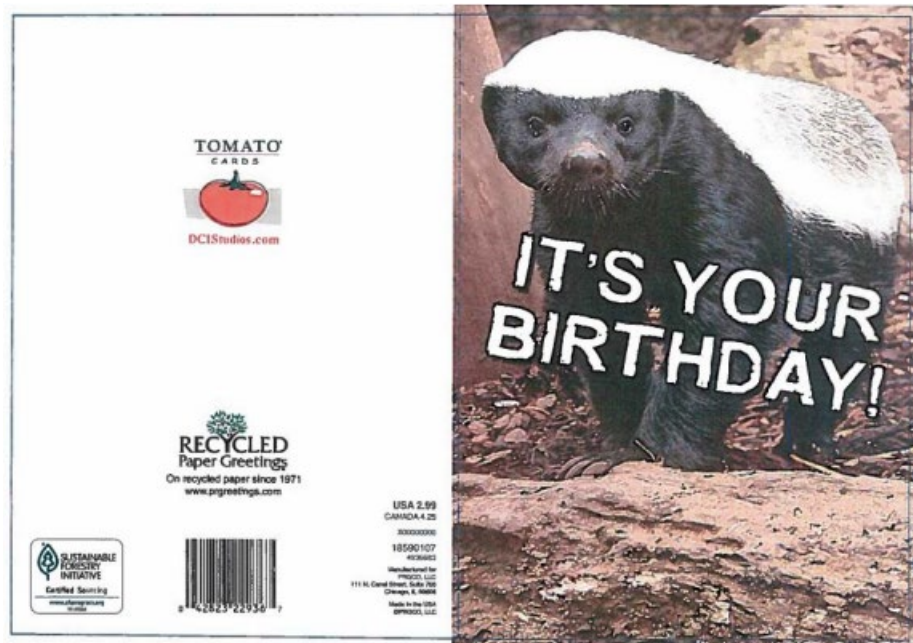


Twentieth Century Fox v. Empire Distrib., Inc., 875 F.3d 1192 (9th Cir. 2017)

- EMPIRE-branded sound recordings used to market the Fox television series “Empire” (about a fictional “Empire Entertainment” company) did not infringe the trademark rights of a real-world record label named Empire Distribution, Inc.
- Ninth Circuit’s further extended *Rogers* to shirts, glasses, and records sold under the EMPIRE trademark, despite recognizing “that these promotional efforts technically fall outside the title or body of an expressive work.” *Id.* at 1196



Gordon v. Drape Creative, Inc., 909 F.3d 257 (9th Cir. 2018)

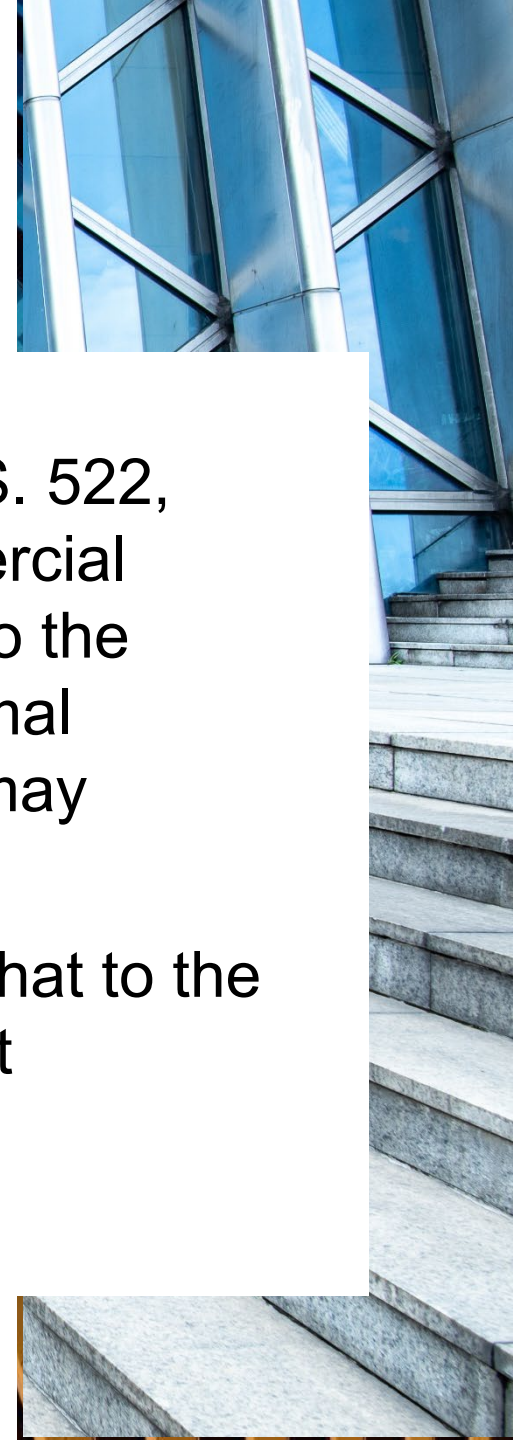


Hermès International v. Rothschild, 603 F.Supp.3d 98, 2022 WL 1564597 (S.D.N.Y. May 18, 2022)

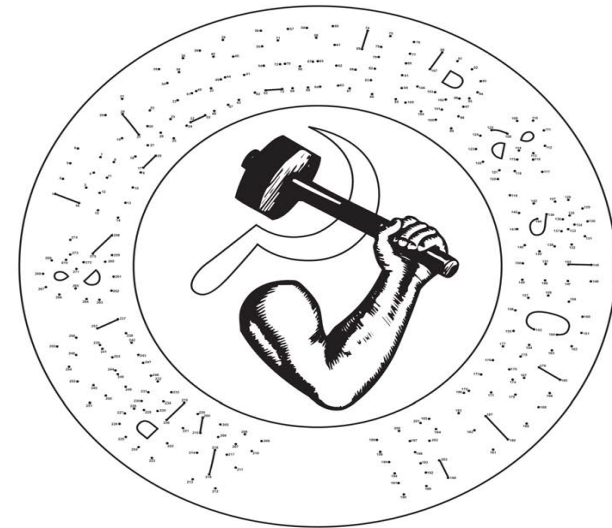
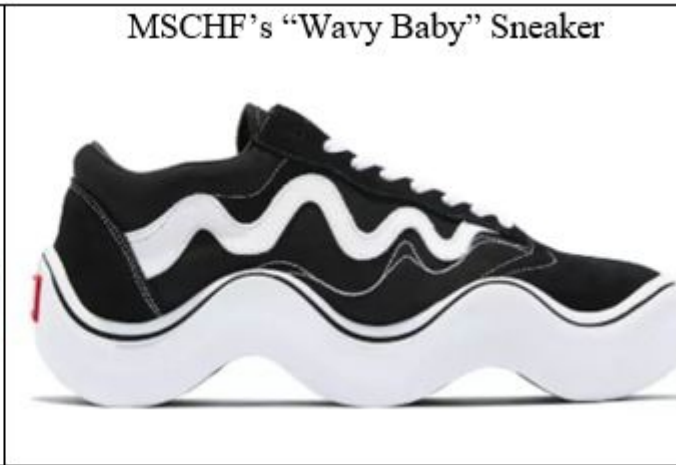


First Amendment Standard for Commercial Products

- **S.F. Arts & Athletics, Inc. v. U.S. Olympic Committee**, 483 U.S. 522, 535, 541 (1987): Use of mark to induce sale of goods is “commercial speech,” which receives “limited First Amendment protection.” “To the extent that [the statute] regulates confusing uses, it is within normal trademark bounds,” because “[t]he Government constitutionally may regulate ‘deceptive or misleading’ commercial speech.”
- **Matal v. Tam**, 137 S.Ct. 1744, 1768 (2017): “It is well settled ... that to the extent a trademark is confusing or misleading the law can protect consumers and trademark owners.”



MSCHF Manifesto



John Roberts

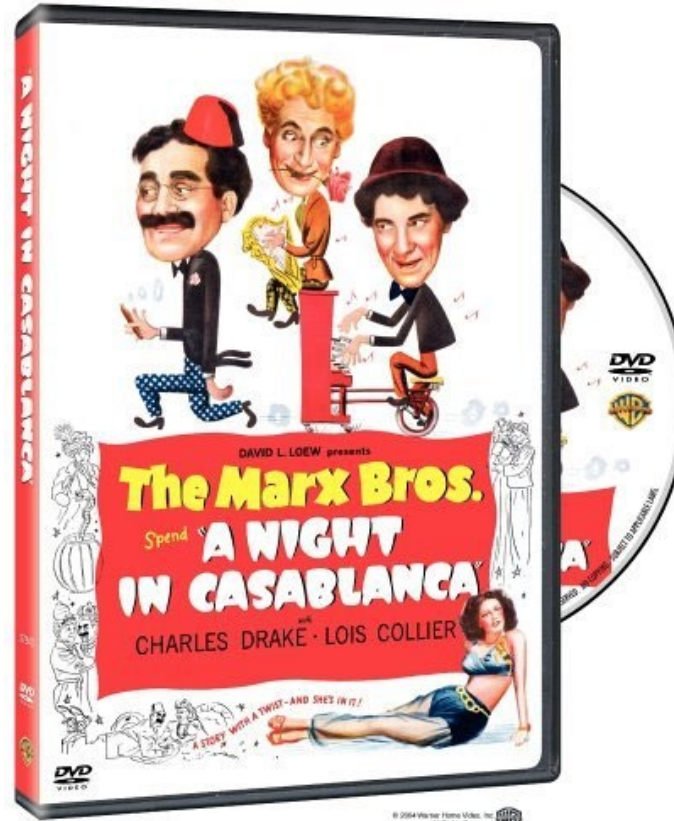
Arm & Hammer & Sickle, 2023

Pen on paper, Connect-the-Dot

Signature of the Artist, Chief Justice John Roberts

Consigned for sale. Available.

Takeaways



The End: A Letter from Groucho

Dear Warner Brothers:

Apparently there is more than one way of conquering a city and holding it as your own. For example, up to the time that we contemplated making this picture, I had no idea that the city of Casablanca belonged exclusively to Warner Brothers. However, it was only a few days after our announcement appeared that we received your long, ominous legal document warning us not to use the name Casablanca. . . .

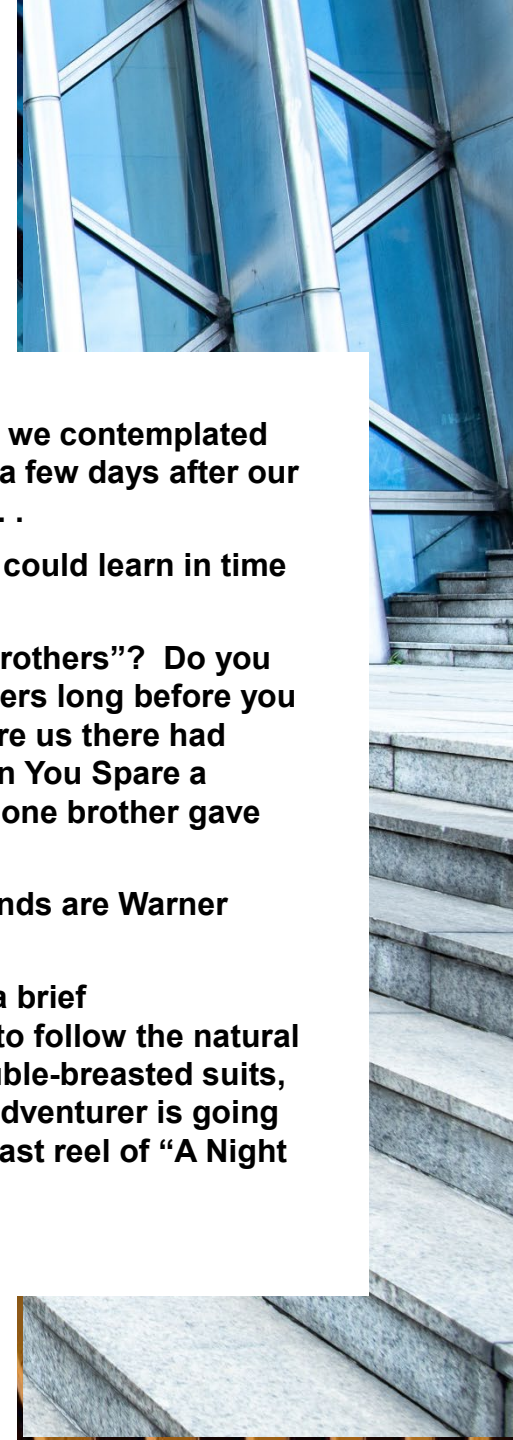
I just don't understand your attitude. Even if you plan on re-releasing your picture, I am sure that the average movie fan could learn in time to distinguish between Ingrid Bergman and Harpo. I don't know whether I could, but I certainly would like to try.

You claim you own Casablanca and that no one else can use that name without your permission. What about "Warner Brothers"? Do you own that, too? You probably have the right to use the name Warner, but what about Brothers? Professionally, we were brothers long before you were. We were touring the sticks as the Marx Brothers when Vitaphone was still a gleam in the inventor's eye, and even before us there had been other brothers - the Smith Brothers; the Brothers Karamazov; Dan Brothers, an outfielder with Detroit; and "Brother, Can You Spare a Dime?" (This was originally "Brothers, Can You Spare a Dime?" but this was spreading a dime pretty thin, so they threw out one brother gave all the money to the other one and whittled it down to, "Brother, Can You Spare a Dime?") . . .

This all seems to add up to a pretty bitter tirade, but I assure you it's not meant to. I love Warners. Some of my best friends are Warner Brothers

I have a hunch that this attempt to prevent us from using the title is the brainchild of some ferret-faced shyster, serving a brief apprenticeship in your legal department. I know the type well—hot out of law school, hungry for success and too ambitious to follow the natural law of promotion. This bar sinister probably needled your attorneys, most of whom are fine fellows with curly black hair, double-breasted suits, etc., into attempting to enjoin us. Well, he won't get away with it! We'll fight him to the highest court! No pasty-faced legal adventurer is going to cause bad blood between the Warners and the Marxes. We are all brothers under the skin and we'll remain friends till the last reel of "A Night in Casablanca" goes tumbling over the spool.

Sincerely,
Groucho Marx



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Jonathan E. Moskin is a partner with Foley & Lardner LLP. He has acted as lead trial and appellate counsel in many trademark, copyright and patent cases, as well as contract disputes, privacy matters, false advertising and right of publicity cases.

Prior to joining Foley, Mr. Moskin was a partner at White & Case LLP and Pennie & Edmonds, LLP, where he was chair of the Trademark/Copyright Group. He has also served as an *adjunct* professor at Fordham Law School.

He has regularly been ranked among the top Intellectual Property Lawyers by Legal 500 USA, New York Superlawyers; the *World Trademark Review's* "WTR 1000" directory and, *The Best Lawyers in America*®. He previously served as Editor-in-Chief of The Trademark Reporter and five years' service as the chair of the New York Intellectual Property Law Association Privacy Law Committee.

Mr. Moskin received his J.D. from Boston College Law School (cum laude, 1983), where he was also a member of the Boston College Law Review and won national honors in the Nathan Burkan Memorial Competition for an article entitled "*Make Room for the Stars: Copyright Preemption and the Right of Publicity*," (33 Copyright L. Symp., ASCAP, 159 (1983)). He received his B.A. in philosophy from Oberlin College (1979). He is a frequent author and speaker and has testified to Congress on intellectual property legislation.

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Ashley Koley is an associate with Foley & Lardner LLP, based in the firm's Los Angeles office where she is a member of the firm's Intellectual Property Litigation Practice. Ashley counsels clients regarding all aspects of intellectual property, including copyright, trademark, trade dress, patent, false advertising, and entertainment-related matters.

Ashley is an active member on several litigation teams in the high tech, design, and entertainment based spaces. She is also a founding member of Foley's Digital Assets, Web3, and NFTs team (DAWN).

Ashley earned her J.D. at Southwestern Law School (*summa cum laude*, 2020) with an entertainment and media concentration with honors. At Southwestern Law School, she was a clinician in the Southwestern Entertainment and the Arts Legal Clinic advising clients in film and television production. She was also a board member of Law Review and a research assistant in copyright law.

Prior to law school, Ashley earned her bachelor of science majoring in biochemistry at the University of Winnipeg.

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