

No. 16-56715

Published Opinion Issued July 30, 2018

Danny J. Boggs (6th Cir.), Jay S. Bybee and Paul J. Watford, Circuit Judges

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

CHRISTOPHER GORDON,

Plaintiff and Appellant,

v.

DRAPE CREATIVE, INC. AND PAPYRUS-
RECYCLED GREETINGS, INC.,

Defendants-Appellees.

On Appeal From The United States District Court
For the Central District of California (Hon. John F. Walter)
District Court Case No. 2:15-cv-04905-JFW-PLA

APPELLEES' PETITION FOR PANEL REHEARING AND REHEARING EN BANC

James J.S. Holmes (Bar No. 126779)
james.holmes@clydeco.us
Douglas J. Collodel (Bar No. 112797)
douglas.collodel@clydeco.us
CLYDE & CO US LLP
633 W. 5th Street, 26th Floor
Los Angeles, CA 90071
Telephone: (213) 358-7630
Facsimile: (213) 358-7699

Attorneys for Defendants-Appellees Drape Creative, Inc.
and Papyrus-Recycled Greetings, Inc.

Corporate Disclosure Statement

Papyrus-Recycled Greetings, Inc. is an Illinois corporation, which operates as a subsidiary of American Greetings Corporation. As of August 9, 2013, American Greetings Corporation has operated as a privately-held company.

Drape Creative, Inc. is a Missouri corporation that licenses greeting card designs for Papyrus-Recycled Greetings, Inc.

No publicly held corporation owns 10% or more of stock in either Drape Creative, Inc. or Papyrus-Recycled Greetings, Inc.

DATED: August 13, 2018

/s/*Douglas J. Collodel*

Douglas J. Collodel

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FRAP 35(b) and Circuit Rule 35-1 Statement

Panel rehearing or rehearing en banc is needed to correct a sea change at the intersection of First Amendment rights and trademark law resulting from the Panel's decision. Before the opinion in the instant action, First Amendment protections for expressive works were robust and uncomplicated – the Ninth Circuit and its District Courts have implemented the test set forth in *Rogers v. Grimaldi*, 875 F.2d 994 (2nd Cir. 1989) [the “*Rogers*” test], and adopted by this Court initially in *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002). For over fifteen years, the *Rogers* test has precluded trademark infringement claims under the Lanham Act when an expressive work reflects any amount of “artistic relevance” – more than zero. *Mattel, Inc. v. MCA Records, supra*, 296 F.3d at 902 [use of a trademark that otherwise would violate the Lanham Act is not actionable “unless the [use of the mark] has no artistic relevance to the underlying work whatsoever . . .” (quoting *Rogers, supra*, 875 F.2d at 999)]; *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) [“only the use of a trademark with ‘no artistic relevance to the underlying work whatsoever’ does not merit First

Amendment protection. In other words, the level of relevance merely must be above zero.”].

Thus, one engaged in expressive work could do so without the chill of concern that their expression would expose them to a complex and esoteric inquiry to be determined by a jury. That was the purpose of the *Rogers* standard because one claiming trademark infringement by another’s expressive work was required to demonstrate that the user’s expression had no relationship between the mark and its use in the purportedly infringing work. The Panel’s published decision radically undermines *Rogers* and this Court’s precedents, as well as seriously eroding the scope of First Amendment protections.

The Panel’s decision, which now places the issue of “any artistic relevance” in the hands of a jury after full litigation and ultimately a trial, has altered the focus of trademark disputes involving expressive works, including the addition of an obligation placed on the user to “add his own artistic expression beyond that represented by the mark.” Slip.Opin. at 21. Previously, the burden was squarely on the trademark holder to establish the complete absence of artistic relevance (i.e., the use of the mark was wholly unrelated to the content of the junior user’s expressive work) – and

such a burden is not surprising, given the salient goal of protecting First Amendment rights.

Unfortunately, the Panel's new standard places the first prong of the *Rogers* test into a state of disarray. The District Court found Defendants' use of Plaintiff's catchphrase¹ "easily meets the artistic relevance requirement under *Rogers* because its use is not wholly unrelated to the content of the work." Excerpts ("ER"), Vol. I, at p. 9. To arrive at that conclusion, the District Court appreciated the fact that Plaintiff's mark related directly to Defendants' depiction of a honey badger and was part of Defendants' conveyance of a sarcastic and apathetic message about the subject of Defendants' greeting cards. *Id.* More specifically, it recognized the "interplay between the greeting card's assumed intent (e.g., 'happy birthday!'), the artwork, and the written words offers consumers expressive content and, thus, readily demonstrates artistic relevance." *Id.*

In contrast, the Panel's decision agreed that the catchphrase is "certainly relevant to defendants' cards; the phrase is the punchline on which the cards' humor turns." [Slip.Opin. at 20], but it found a triable issue as to whether there was any artistic relevance because Defendants

¹ "Honey Badger Don't Give a S---" [HBDGAS].

“have arguably not used the [catchphrases] in any way that distinguishes their use from Gordon’s and thus have not ‘imbued’ their product with any ‘expressive value’ apart from that contained in Gordon’s trademarked phrase.” Slip.Opin. at 23. Doing so, the Panel marginalized the fact that Defendants presented their own artwork, illustrated the honey badger, chose the context in which the expressive remark would be used, and conveyed their message within the confines of a greeting card – a field not even referenced in Plaintiff’s trademark registration. Moreover, the Panel enfeebled the First Amendment focus, which had previously simply assessed whether an expressive work has any artistic connection to the trademark, and instituted a “slippery slope” evaluation as to whether the expressive work reflects “new” expression beyond that represented by the trademark. The Panel’s new and unprecedented test is an amorphous one that may have parallels in copyright jurisprudence, but copyright law specifically eschews the extension of copyrights to short phrases. In any event, the Panel’s test is inapposite when the use of the mark is expressive, not associational, and it has no place when First Amendment rights hang in the balance.

Particularly when contrasted with the Panel's examples of clear artistic relevance found as a matter of law [discussed below], the Panel's decision adopts a most difficult and unwieldy standard for invoking First Amendment protections. Furthermore, the Panel's jurisprudential transformation places the determination of free speech and expression rights in the hands of a jury, and forces defendants to endure costly litigation and ultimately a trial to vindicate their Constitutional rights.

This petition should be granted so that this case can be reevaluated under well-established precedent. Whether by the Panel or by an en banc Court should the Panel decline rehearing, this Court should restore important First Amendment rights, secure uniformity in this Court's decisions, and remove ambiguities in the *Rogers* test that the Panel's opinion has engendered. Here, Plaintiff should be held to the same burden facing other trademark holders in this country. He should be required to demonstrate that Defendants' use of his mark has absolutely no artistic relevance under a standard that poses the issue in terms of a connection between the expressive work and its implementation of a mark and not, as the Panel now requires, an expression that is unlike the one "represented by the mark." Slip.Opin. at 21.

Factual Background

Plaintiff uploaded a YouTube video entitled, “The Crazy Nastyass Honey Badger (original narration by Randall)” (“YouTube video”); the YouTube video uses unlicensed content from National Geographic to which Plaintiff does not have any rights. ER, Vol.X, at pp. 2097, 2105, 2113. After publishing his YouTube video (but before filing this lawsuit), Plaintiff obtained trademark registrations for the phrase, “Honey Badger Don’t Care,” [“HBDC”], for the classes of goods including clothing, Christmas decorations, audio books and mugs, but not greeting cards. ER, Vol.VII, at pp. 1319, 1366-1369; see also, ER, Vol.X, at p. 2255. He did not obtain a registered trademark for the phrase, “Honey Badger Don’t Give a S---” [“HBDGAS”], for any class of goods. ER, Vol.VII, at pp. 1319-1320; ER, Vol.X, at pp. 2116, 2118, 2148, 2242.

Defendants created a birthday-themed card that incorporated a hand-drawn image of a honey badger. ER, Vol.X, at p. 2251. In addition to this birthday-themed card with the hand-drawn honey badger, Defendants created a Halloween-themed greeting card, additional birthday-themed cards and an election-themed greeting card, each of which used the HBDGAS phrase. *Id.* Drape Creative regularly uses animals in its greeting

card designs. ER, Vol.X, at p. 2251. Only six of Defendants' greeting cards, which were available to consumers from June 2012 to March 2016, contained the HBDGAS phrase; none used the HBDC phrase, which was the lone trademark Plaintiff registered. ER, Vol.X, at pp. 2046-2047, 2117, 2118.

Plaintiff and Zazzle, Inc. entered into a license agreement, effective between May 2012 and May 2015, under which Zazzle sold some honey badger-related greeting cards, which only used the phrases "Honey Badger Don't Care," "Honey Badger Just Takes What She Wants," and "Honey Badger Wins." ER, Vol.X, at pp. 2120-2121, 2124. Plaintiff did not design the greeting cards Zazzle sold; through his license agreement with Zazzle, Plaintiff sold only four greeting cards, the first of which sold on December 7, 2012. ER, Vol.X, at pp. 2110, 2124. Zazzle generated approximately \$12.60 in revenue for Plaintiff, with a royalty due of approximately \$2.13. ER, Vol.X, at p. 2124.

The Duck Company, Inc. offered a Christmas card on Plaintiff's behalf that uses the HBDC phrase. ER, Vol.X, at p. 2131. Duck's greeting card first sold no earlier than October 2012, which was several months after Defendant's cards were already in commerce. ER, Vol.II, at pp. 118-

119; see also, ER, Vol.X, at pp. 2133-2134. Duck, not Plaintiff, designed Duck's HBDC greeting cards. ER, Vol.X, at pp. 2110, 2133-2134. Further, Duck has no plans to create additional honey badger-related greeting cards, and its cards are only available between October and December each year. ER, Vol.X, at pp. 2132, 2134-2135. Duck could not identify the number of HBDC greeting cards sold, nor could it state whether the HBDC greeting cards had actually sold throughout the entire United States. ER, Vol.X, at p. 2134.

Procedural Statement

Plaintiff brought this trademark infringement action against Defendants, alleging causes of action based on their use of two phrases [HBDC and HBDGAS] in their greeting cards. ER, Vol.XI, at pp. 2374-2487. Defendants moved for summary judgment, asserting (among other grounds) that, under the *Rogers* test, Defendants' greeting cards were protected by the First Amendment. ER, Vol.XI, at pp. 2272-2306.

The District Court granted Defendants' summary judgment motion. ER, Vol.I, at pp. 1-11. The District Court found that Defendants' greeting cards are expressive works entitled to First Amendment protection and applied the *Rogers* test. ER, Vol.I, at pp. 5-10. Relevant here, the District

Court determined that Defendants' use of the phrase HBDGAS "easily meets the artistic relevance requirement under *Rogers* because its use is not wholly unrelated to the content of the work." ER, Vol.I, at p. 9.

The Panel reversed, finding a triable issue of fact regarding the amount of artistic relevance. Slip.Opin. at 23-24. The Panel phrased the artistic relevance evaluation as follows:

But the "artistic relevance" inquiry does not ask only whether a mark is relevant to the rest of the work; it also asks whether the mark is relevant to the defendant's own artistry. The use of a mark is artistically relevant if the defendant uses it for artistic reasons. Conversely, the use of a mark is not artistically relevant if the defendant uses it merely to appropriate the goodwill inhering in the mark or for no reason at all.

Slip.Opin. at 20.

The Panel continued, "For artistic relevance to 'be above zero,' the mark must both relate to the defendant's work and the defendant must add his own artistic expression beyond that represented by the mark." Slip.Opin. at 21. It then provided an example: "For instance, Andy Warhol reproduced Campbell's soup cans in a literal, but artistic, form; Warhol took Campbell's mark and added his own artistic expression." *Id.* The

Panel simply asserted this and provided no discussion of what Warhol added.

The Panel also endeavored to distinguish other decisions, which applied the *Rogers* test to bar trademark infringement claims as a matter of law. First, “[i]n *Rogers*, the use of Ginger Rogers’s name was integral to Fellini’s film.” Slip.Opin. at 21. Next, “[t]he junior users in our Barbie cases also viewed Barbie as a cultural icon, even if they did not treat her with the same adulation that Fellini did Rogers. *Walking Mountain*, 353 F.3d at 802 (‘To sell its product, Mattel uses associations of beauty, wealth, and glamour. Forsythe turns this image on its head . . . [to] transform Barbie’s meaning.’); *MCA Records*, 296 F.3d at 901 (‘The song pokes fun at Barbie and the values that Aqua contends she represents.’).” Slip.Opin. at 22-23. And “[i]n *Twentieth Century Fox*, the use of the word ‘Empire’ as the title for the television series conveyed a raft of meanings: ‘Empire’ was a ‘common English word’ relevant to the show’s setting (New York) and its subject matter (a music and entertainment conglomerate). 875 F.3d at 1198.” Slip.Opin. at 23. Lastly, “in our video game cases, the borrowed mark was part of a much larger context. In *Brown*, Jim Brown was one of ‘thousands of current and former NFL players’ appearing in the game, 724

F.3d at 1244, while in *E.S.S.*, the Pig Pen was just one of many fictional buildings and landmarks in a ‘cartoon-style parody’ of a neighborhood in Los Angeles, 547 F.3d at 1100.” *Id.*

To sum, the Panel “differentiated” prior authority by concluding “it was clear that the mark at issue was relevant to the junior user’s work and that the junior user employed the mark in the junior user’s own artistic expression. Here, however, there is evidence that defendants simply used Gordon’s mark in the same way that Gordon was using it—to make humorous greeting cards in which the bottom line is ‘Honey Badger don’t care.’” Slip.Opin. at 23.

Legal Discussion

Defendants and Appellees Drape Creative, Inc. and Papyrus-Recycled Greetings, Inc. (collectively “Defendants”) respectfully request Panel rehearing or rehearing en banc of the Panel’s decision reversing a summary judgment in a trademark infringement action. The Panel found Defendants’ greeting cards were expressive works warranting implementation of the *Rogers* test to protect Defendants’ First Amendment rights. Unlike the District Court, which “easily found” Defendants’ greeting cards met the “more than zero” level for the *Rogers* test’s artistic

relevance prong, the Panel found a triable issue on this element that required a jury to determine whether Defendants added artistic expression beyond that represented by the mark, “as opposed to just copying Gordon’s artistic expression.” Slip.Opin. at 21-22.

The Panel’s decision creates a new standard for ascertaining whether a junior user’s work has any artistic relevance under the *Rogers* test. Unlike the Panel, this Circuit has never obliged the junior user to show use of the mark has some relevance “different” than that used by the trademark holder. Rather, Ninth Circuit precedent only has required the use of the mark to have some artistic relevance to the expressive work. See *Mattel, Inc. v. MCA Records, supra*, 296 F.3d at 903; *E.S.S. Entm’t 2000, supra*, 547 F.3d at 1100; see also, *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013) [finding interpretation of “artistic relevance” prong in *E.S.S.* to be correct]; *VIRAG, S.R.L. v. Sony Computer Entertainment America LLC*, No. 16-15137, 699 Fed.App’x 667, 2017 WL 4712436, at *1 (9th Cir. 2017) [“Sony’s use of the VIRAG trademark furthers its goal of realism, a legitimate artistic goal . . . and therefore satisfies the requirement that Sony’s use of the trademark have ‘above zero’ artistic relevance to the Gran Turismo games”].

More recently, *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1199 (9th Cir. 2017), held,

“[t]his is how a work fails the first prong of the *Rogers* test: by bearing a title which has no artistic relevance to the work. A title may have artistic relevance by linking the work to another mark, as with “Barbie Girl,” or it may have artistic relevance by supporting the themes and geographic setting of the work, as with *Empire*.”

Other circuits have applied the *Rogers* test so that is consistent with the above premise of *Twentieth Century Fox. Rogers, supra*, 875 F.2d at 1001 [finding “not subject to dispute “ the District Court’s conclusion that film’s title “Ginger and Fred” surpasses the minimum threshold of artistic relevance to the film’s content conclusion, as the central characters in the film are nicknamed “Ginger” and “Fred” have genuine relevance to the film’s story]; *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665, fn. 3 (5th Cir. 2000) [finding “no question” about artistic relevance, in an action brought by holder of “POLO” mark against publication entitled “New POLO Magazine,” when magazine contained articles about polo]; *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 918-19 (6th Cir.2003) [artist’s use of golfer Tiger Woods’s image on a painting had artistic

relevance to the underlying work]; *University of Alabama Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1278-1279 (11th Cir. 2012) [“readily concluding” that paintings, prints, and calendars were protected under the *Rogers* test: “The depiction of the University’s uniforms in the content of these items is artistically relevant to the expressive underlying works because the uniforms’ colors and designs are needed for a realistic portrayal of famous scenes from Alabama football history.”]. *New Life Art* has remarkably similar parallels to the instant action; but unlike the outcome here after the Panel’s redefined the test for artistic relevance, the Eleventh Circuit found as a matter of law that the paintings replicating Alabama football uniforms were artistically relevant under the *Rogers* test. 683 F.3d at 1278-1279.

So, too, this Circuit’s District Courts (like the District Court in the instant action) have analyzed the first prong of the *Rogers* test with an understanding that “artistic relevance” exists when the use of a mark is relevant to the junior user’s expressive work. *E.g., VIRAG, S.R.L. v. Sony Computer Entertainment America LLC*, 2015 WL 5000102, at *11 (N.D.Cal. 2015) [“This black-and-white rule has the benefit of limiting [a court’s] need to engage in artistic analysis in this context.”] (quoting

*Brown, supra, 724 F.3d at 1243.]; Harold Lloyd Entertainment, Inc. v. Moment Factory One, Inc., 2015 WL 12765142, at *10 (C.D.Cal. 2015) [same]; Novalogic, Inc. v. Activision Blizzard, 41 F.Supp.3d 885 (C.D.Cal. 2013); Roxbury Entertainment v. Penthouse Media Group, Inc., 669 F.Supp.2d 1170, 1175-1176 (C.D.Cal. 2009); Webceleb, Inc. v. Procter & Gamble Company, 2012 WL 12846096, at * (S.D.Cal. 2012) [“Defendants’ use of the term has to be artistically relevant to their own product, not Plaintiff’s product. Here, Defendants’ use of ‘web celeb’ has some artistic relevance to the underlying awards show category. Therefore, the first element of the artistic relevance test is met.”]; Stewart Surfboards, Inc v. Disney Book Group, LLC, 2011 WL 12877019 (C.D.Cal. 2011) [“The Ninth Circuit puts the test differently: the use of the trademark must have some ‘relevance to the underlying work,’ i.e. the defendant’s work. *E.S.S. Entm’t*, 547 F.3d at 1100; see also *MCA Records*, 296 F.3d at 902.”].*

As the District Court here indicated, “[t]he *Rogers* test is relatively straightforward to apply, and is very protective of speech.” ER, Vol. I, at p. 8. And, as it pertains to the first prong of the test, the Court stated in *Twentieth Century Fox* “[t]he bar is set low.” 875 F.3d at 1198. The Panel’s decision puts an end to the salutary simplicity of *Rogers*.

Importantly, the key value of *Rogers* is that the expressive party need demonstrate only that the content is expressive, so parties engaging in expression need not engage in an abstract justification of the nature of their content to verify it is “different enough” from whatever expressive content inheres in the trademark owner’s mark. Under the Panel’s new standard, defendants engaged in expression must try to reconcile the irreconcilable. The Panel references Andy Warhol’s Campbell Soup can as reflecting his interpretation; yet, in terms of the *Rogers* test for artistic relevance, Defendants’ original artwork is no different. Similarly, since a film title referencing a trademark can avoid an infringement claim, so, too, should a greeting card doing the same.

Defendants’ greeting cards reflected *Defendants’* rendition of the phrase HBDGAS and Defendants’ choice of colors, pictures, precise phrasing, and occasions around which the phrase should be used is “more than zero artistic relevance” as a matter of law and enough to warrant First Amendment protection. Rehearing is needed to reinstate the vigorous protection of expression assured by the *Rogers* test and clarify the current state of the law in this Circuit.

Conclusion

For the foregoing reasons, the Panel's decision creates considerable confusion over how to apply what heretofore has been a rather clear approach to assessing artistic relevance under the *Rogers* test, both in this Circuit and throughout the country. The Panel needs to revisit the issues raised in Plaintiff's appeal, albeit through a prism that evaluates whether Defendants' use of the phrase HBDGAS has any genuine relevance to Defendants' greeting cards (in contrast to the Panel's alternative lens, which infuses an "added value" component), and thereafter affirm the District Court's judgment.

Should the Panel decline to rehear this matter, Defendants respectfully invite the judges of this Circuit to vote for a rehearing en banc to restore Circuit authority to a state where First Amendment rights protect expressive works, including those that have "even the slightest artistic relevance." *Brown, supra*, 724 F.3d at 1245.

Dated: August 13, 2018

By /s/ *Douglas J. Collodel*
Douglas J. Collodel

CLYDE & CO US LLP
Attorneys for Defendants-Appellees
Drape Creative, Inc. and Papyrus-
Recycled Greetings, Inc.

Certificate of Compliance

In accordance with Ninth Circuit Rules 35-4(a) and 40-1(a), and Rule 32(c)(2) of the Federal Rules of Appellate Procedure, the undersigned certifies that the accompanying petition has been prepared using 14-point Century Schoolbook typeface and uses double line spacing (except for headings, footnotes and certain quotations).

The undersigned further certifies that the brief is proportionately spaced and contains 3,398 words, exclusive of the corporate disclosure statement, the table of contents, table of authorities, signature lines, and certificates of compliance and proof of service. The undersigned used Microsoft Word 2010 to compute the word count.

Dated: August 13, 2018

By: /s/ *Douglas J. Collodel*
Douglas J. Collodel

Appendix

Copy of Panel's Slip Opinion

FOR PUBLICATION**UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

CHRISTOPHER GORDON, an
individual,
Plaintiff-Appellant,
v.
DRAPE CREATIVE, INC., a Missouri
corporation; PAPYRUS-RECYCLED
GREETINGS, INC., an Illinois
corporation,
Defendants-Appellees.

No. 16-56715
D.C. No.
2:15-cv-04905-
JFW-PLA

OPINION

Appeal from the United States District Court
for the Central District of California
John F. Walter, District Judge, Presiding

Argued and Submitted April 9, 2018
Pasadena, California

Filed July 30, 2018

Before: Danny J. Boggs, * Jay S. Bybee,
and Paul J. Watford, Circuit Judges.

Opinion by Judge Bybee

* The Honorable Danny J. Boggs, United States Circuit Judge for the U.S. Court of Appeals for the Sixth Circuit, sitting by designation.

SUMMARY**

Trademark

The panel reversed the district court's grant of summary judgment in favor of defendants in a trademark infringement suit under the Lanham Act.

Defendants designed and produced greeting cards using "Honey Badger" catchphrases from plaintiff Christopher Gordon's YouTube video.

Under the *Rogers* test, the Lanham Act applies to expressive works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression. This balance will normally not support application of the Act unless the use of the mark has no artistic relevance to the underlying work whatsoever or explicitly misleads consumers as to the source or the content of the work.

The panel held that there was a triable issue of fact because a jury could determine that defendants did not add any value protected by the First Amendment, but merely appropriated the goodwill associated with Gordon's mark. The panel reversed the district court and remanded for further proceedings on Gordon's claims.

** This summary constitutes no part of the opinion of the court. It has been prepared by court staff for the convenience of the reader.

COUNSEL

Daniel L. Reback (argued) and Ralph C. Loeb, Krane & Smith, Encino, California, for Plaintiff-Appellant.

Douglas J. Collodel (argued), Kanika D. Corley, and James J.S. Holmes, Sedgwick LLP, Los Angeles, California, for Defendants-Appellees.

OPINION

BYBEE, Circuit Judge:

Plaintiff Christopher Gordon is the creator of a popular YouTube video known for its catchphrases “Honey Badger Don’t Care” and “Honey Badger Don’t Give a S---.” Gordon has trademarked the former phrase for various classes of goods, including greeting cards. Defendants Drape Creative, Inc. (“DCI”), and Papyrus-Recycled Greetings, Inc. (“PRG”), designed and produced greeting cards using both phrases with slight variations. Gordon brought this suit for trademark infringement, and the district court granted summary judgment for defendants, holding that Gordon’s claims were barred by the test set forth in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

We use the *Rogers* test to balance the competing interests at stake when a trademark owner claims that an expressive work infringes on its trademark rights. The test construes the Lanham Act to apply to expressive works “only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* at 999. “[T]hat balance will normally not support application of the Act,

unless the [use of the mark] has no artistic relevance to the underlying work whatsoever, or . . . explicitly misleads [consumers] as to the source or the content of the work.” *Id.*

The *Rogers* test is not an automatic safe harbor for any minimally expressive work that copies someone else’s mark. Although on every prior occasion in which we have applied the test, we have found that it barred an infringement claim as a matter of law, this case presents a triable issue of fact. Defendants have not used another’s mark in the creation of a song, photograph, video game, or television show, but have largely just pasted Gordon’s mark into their greeting cards. A jury could determine that defendants did not add any value protected by the First Amendment but merely appropriated the goodwill associated with Gordon’s mark. We therefore reverse the district court’s grant of summary judgment and remand for further proceedings on Gordon’s claims.

I

Plaintiff Christopher Gordon is a comedian, writer, and actor, who commonly uses the name “Randall” as an alias on social media.¹ Defendant DCI is a greeting-card design studio. DCI works exclusively with American Greetings Corporation and its subsidiaries, which include the other defendant in this case, PRG. PRG is a greeting-card manufacturer and distributor.

¹ Because this case comes to us on appeal from a grant of summary judgment for defendants, we recount the facts in the light most favorable to Gordon. *See VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 875 (9th Cir. 2016).

A

In January 2011, under the name Randall, Gordon posted a video on YouTube titled *The Crazy Nastyass Honey Badger*, featuring National Geographic footage of a honey badger overlaid with Gordon's narration. In the video, Gordon repeats variations of the phrases "Honey Badger Don't Care" and "Honey Badger Don't Give a S---," as a honey badger hunts and eats its prey. The parties refer to these phrases as "HBDC" and "HBDGS," and we adopt their convention.

Gordon's video quickly generated millions of views on YouTube and became the subject of numerous pop-culture references in television shows, magazines, and social media. As early as February 2011, Gordon began producing and selling goods with the HBDC or HBDGS phrases, such as books, wall calendars, t-shirts, costumes, plush toys, mouse pads, mugs, and decals. Some of the items were sold online; others were sold through national retailers such as Wal-Mart, Target, Urban Outfitters, and Hot Topic. In June 2011, Gordon copyrighted his video's narration under the title *Honey Badger Don't Care*, and in October 2011, he began filing trademark applications for the HBDC phrase for various classes of goods. The Patent and Trademark Office ("PTO") eventually registered "Honey Badger Don't Care" for International Classes 9 (audio books, etc.), 16 (greeting cards, etc.), 21 (mugs), 25 (clothing), and 28 (Christmas

decorations, dolls, etc.).² However, Gordon never registered the HBDGS phrase for any class of goods.

At the peak of his popularity, Gordon promoted his brand on television and radio shows and in interviews with national publications such as *Forbes*, *The Wall Street Journal*, and *The Huffington Post*. His brand was further boosted by celebrities like Taylor Swift and Anderson Cooper quoting his video and by LSU football players tagging their teammate, Heisman Trophy finalist Tyrann Mathieu, with the moniker “Honey Badger” for his aggressive defensive play. In November 2011, *Advertising Age* referred to Gordon’s brand as one of “America’s Hottest Brands” in an article titled “Hot Brand? Honey Badger Don’t Care.”

B

In January 2012, Gordon hired Paul Leonhardt to serve as his licensing agent. Soon thereafter, Leonhardt contacted Janice Ross at American Greetings—the parent company of defendant PRG—to discuss licensing honey-badger themed greeting cards. Leonhardt and Ross had multiple email exchanges and conversations over several weeks. Ross at one point expressed some interest in a licensing agreement, stating: “I think it’s a really fun and irreverent property and would love to see if there’s an opportunity on one of our distribution platforms. But in order to do that, I need to get

² Between January 2013 and April 2014, the PTO issued registrations for HBDC in International Classes 9, 21, 25, and 28. The PTO did not issue a registration for HBDC in International Class 16—which includes greeting cards—until October 2016, well after Gordon filed this suit. The timing of Gordon’s registrations, however, is immaterial to the *Rogers* inquiry.

some key colleagues of mine on board the Crazy Honey Badger Bandwagon.” Nevertheless, neither American Greetings nor defendants ever signed a licensing agreement with Gordon.

Leonhardt did eventually secure several licensing deals for Gordon. Between May and October 2012, Gordon’s company—Randall’s Honey Badger, LLC (“RHB”—entered into licensing agreements with Zazzle, Inc., and The Duck Company for various honey-badger themed products, including greeting cards. RHB also entered into licensing agreements with other companies for honey-badger costumes, toys, t-shirts, sweatshirts, posters, and decals, among other things. HBDC and HBDGS were the two most common phrases used on these licensed products. For example, two of Zazzle’s best-selling honey-badger greeting cards stated on their front covers “Honey Badger Don’t Care About Your Birthday.”

At the same time that Gordon was negotiating licensing agreements with Zazzle and Duck, defendants began developing their own line of unlicensed honey-badger greeting cards. Beginning in June 2012, defendants sold seven different greeting cards using the HBDC or HBDGS phrases with small variations:

- The fronts of two “Election Cards” showed a picture of a honey badger wearing a patriotic hat and stated “The Election’s Coming.” The inside of one card said “Me and Honey Badger don’t give a \$#%@! Happy Birthday,” and the inside of the other said “Honey Badger and me just don’t care. Happy Birthday.”

- The fronts of two “Birthday Cards” featured different pictures of a honey badger and stated either “It’s Your Birthday!” or “Honey Badger Heard It’s Your Birthday.” The inside of both cards said “Honey Badger Don’t Give a S---.”
- The fronts of two “Halloween Cards” showed a picture of a honey badger next to a jack-o-lantern and stated “Halloween is Here.” The inside of the cards said either “Honey Badger don’t give a \$#*%!” or “Honey Badger don’t give a s---.”
- A “Critter Card” employed a Twitter-style format showing a series of messages from “Honey Badger@don’tgiveas---.” The front stated “Just killed a cobra. Don’t give a s---”; “Just ate a scorpion. Don’t give a s---”; and “Rolling in fire ants. Don’t give a s---.”³ The inside said “Your Birthday’s here. . . I give a s---.”

The back cover of each card displayed the mark for “Recycled Paper Greetings” and listed the websites www.DCISstudios.com and www.prgreetings.com. DCI’s

³ Gordon’s video refers to a honey badger getting stung by bees and eating a cobra—e.g., “Now look, here’s a house full of bees. You think the honey badger cares? It doesn’t give a s---. . . . But look the honey badger doesn’t care, it’s getting stung like a thousand times. It doesn’t give a s---. . . . Look! Here comes a fierce battle between a king cobra and a honey badger. . . . And of course, what does a honey badger have to eat for the next few weeks? Cobra.”

President testified that he drafted all of the cards in question but could not recall what inspired the cards' designs. He claimed to have never heard of a video involving a honey badger.

In June 2015, Gordon filed the instant action against DCI and PRG, alleging trademark infringement under the Lanham Act, among other claims. The district court granted summary judgment for defendants, holding that defendants' greeting cards were expressive works, and applying the *Rogers* test to bar all of Gordon's claims. Gordon timely appealed.⁴

II

The Lanham Act, 15 U.S.C. § 1051 *et seq.*, "creates a comprehensive framework for regulating the use of trademarks and protecting them against infringement, dilution, and unfair competition." *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1030 (9th Cir. 2010). The Act's two underlying purposes are to ensure that (1) "owners of trademarks can benefit from the goodwill associated with their marks" and (2) "consumers can distinguish among competing producers." *Id.*; *see also* J. THOMAS McCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 2:2 (5th ed.) (explaining the dual purposes of trademark law).

Under the Act, the owner of a trademark used in commerce may register the mark with the PTO. Registration is *prima facie* evidence of the mark's validity and of the

⁴ We have jurisdiction under 28 U.S.C. § 1291, and we review the district court's grant of summary judgment *de novo*. *See Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806 (9th Cir. 2003).

owner's exclusive right to use the mark in connection with the goods and services specified in the registration. 15 U.S.C. § 1057(b). The owner has a cause of action against any person who, without the owner's consent, "use[s] in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive." *Id.* § 1114(1)(a); *see also id.* § 1125(a) (providing a similar cause of action for "false designation of origin, false or misleading description of fact, or false or misleading representation of fact," irrespective of registration).

In general, we apply a "likelihood-of-confusion test" to claims brought under the Lanham Act. *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1196 (9th Cir. 2017); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806–07 (9th Cir. 2003). The likelihood-of-confusion test requires the plaintiff to prove two elements: (1) that "it has a valid, protectable trademark" and (2) that "the defendant's use of the mark is likely to cause confusion." *S. Cal. Darts Ass'n v. Zaffina*, 762 F.3d 921, 929 (9th Cir. 2014) (alteration omitted). Ordinarily, this test "strikes a comfortable balance" between the Lanham Act and the First Amendment. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

That said, where artistic expression is at issue, we have expressed concern that "the traditional test fails to account for the full weight of the public's interest in free expression." *Id.* The owner of a trademark "does not have the right to control public discourse" by enforcing his mark. *Id.* We have adopted the Second Circuit's *Rogers* test to strike an

appropriate balance between First Amendment interests in protecting artistic expression and the Lanham Act’s purposes to secure trademarks rights. Under *Rogers*, we read the Act “to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* at 901 (quoting *Rogers*, 875 F.2d at 999). More concretely, we apply the Act to an expressive work only if the defendant’s use of the mark is (1) not artistically relevant to the work or (2) explicitly misleads consumers as to the source or the content of the work. *See id.* at 902. Effectively, *Rogers* employs the First Amendment as a rule of construction to avoid conflict between the Constitution and the Lanham Act.

We pause here to clarify the burden of proof under the *Rogers* test. The *Rogers* test requires the defendant to come forward and make a threshold legal showing that its allegedly infringing use is part of an expressive work protected by the First Amendment. If the defendant successfully makes that threshold showing, then the plaintiff claiming trademark infringement bears a heightened burden—the plaintiff must satisfy not only the likelihood-of-confusion test but also at least one of *Rogers*’s two prongs. *Cf. Makaeff v. Trump Univ., LLC*, 715 F.3d 254, 261 (9th Cir. 2013) (if a defendant meets its “initial burden” of showing a First Amendment interest, then a public-figure plaintiff claiming defamation must meet a “heightened standard of proof” requiring a showing of “actual malice”). That is, when the defendant demonstrates that First Amendment interests are at stake, the plaintiff claiming infringement must show not only (1) that it has a valid, protectable trademark, and (2) that the defendant’s use of the mark is likely to cause confusion, but also (3) that the mark is either not artistically relevant to the

underlying work *or* explicitly misleads consumers as to the source or content of the work.

“Summary judgment may properly be entered only against a party who has failed to make a showing sufficient to establish a genuine dispute as to the existence of an element essential to his case and upon which the party will bear the burden of proof at trial.” *Easley v. City of Riverside*, 890 F.3d 851, 859 (9th Cir. 2018). When, as here, the defendant moves for summary judgment and has demonstrated that its use of the plaintiff’s mark is part of an expressive work, the burden shifts to the plaintiff to raise a genuine dispute as to at least one of *Rogers*’s two prongs. In other words, to evade summary judgment, the plaintiff must show a triable issue of fact as to whether the mark is artistically relevant to the underlying work or explicitly misleads consumers as to the source or content of the work.

III

Before applying the *Rogers* test to the instant case, we briefly review the test’s origin in the Second Circuit and development in our court.⁵ We have applied the *Rogers* test on five separate occasions, and each time we have concluded that it barred the trademark infringement claim as a matter of law. Three of those cases, like *Rogers*, involved the use of a trademark in the title of an expressive work. Two cases involved trademarks in video games and extended the *Rogers*

⁵ The *Rogers* test has been adopted in other circuits as well. See *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012); *Parks v. LaFace Records*, 329 F.3d 437, 452 (6th Cir. 2003); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665 (5th Cir. 2000).

test to the use of a trademark in the body of an expressive work.

A

The *Rogers* case concerned the movie *Ginger and Fred*, a story of two fictional Italian cabaret performers who imitated the famed Hollywood duo of Ginger Rogers and Fred Astaire. 875 F.2d at 996–97. Rogers sued the film’s producers under the Lanham Act, alleging that the film’s title gave the false impression that the film—created and directed by well-known filmmaker Federico Fellini—was about her or sponsored by her. *Id.* at 997. The district court, however, granted summary judgment for the defendant film producers. *Id.*

On appeal, the Second Circuit recognized that, “[t]hough 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.* at 998. The court said it would construe the Lanham Act “to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* at 999. Refining its inquiry, the court further held that, “[i]n the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the 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.*

With respect to artistic relevance, the Second Circuit found that the names “Ginger” and “Fred” were “not

arbitrarily chosen just to exploit the publicity value of their real life counterparts” but had “genuine relevance to the film’s story.” *Id.* at 1001. The film’s title was “truthful as to its content” and conveyed “an ironic meaning that [was] relevant to the film’s content.” *Id.* On the second prong of its inquiry, the court held that the title was not explicitly misleading because it “contain[ed] no explicit indication that Rogers endorsed the film or had a role in producing it.” *Id.* Any risk that the title would mislead consumers was “outweighed by the danger that suppressing an artistically relevant though ambiguous title will unduly restrict expression.” *Id.* The Second Circuit therefore affirmed summary judgment for the defendant film producers. *Id.* at 1005.

B

We first employed the *Rogers* test in *MCA Records*, 296 F.3d 894, which concerned the song “Barbie Girl” by the Danish band Aqua. The song—which lampooned the values and lifestyle that the songwriter associated with Barbie dolls—involved one band-member impersonating Barbie and singing in a high-pitched, doll-like voice. *Id.* at 899. Mattel, the manufacturer of Barbie dolls, sued the producers and distributors of “Barbie Girl” for infringement under the Lanham Act, and the district court granted summary judgment for the defendants. *Id.* Applying the *Rogers* test, we affirmed. *Id.* at 902. We held that the use of the Barbie mark in the song’s title was artistically relevant to the underlying work because the song was “about Barbie and the values Aqua claims she represents.” *Id.* In addition, the song “d[id] not, explicitly or otherwise, suggest that it was produced by Mattel.” *Id.* “The *only* indication that Mattel might be associated with the song [was] the use of Barbie in

the title,” and if the use of the mark alone were enough to satisfy *Rogers*’s second prong, “it would render *Rogers* a nullity.” *Id.* Because the Barbie mark was artistically relevant to the song and not explicitly misleading, we concluded that the band could not be held liable for infringement.

We applied the *Rogers* test to another suit involving Barbie in *Walking Mountain Prods.*, 353 F.3d 792. There, photographer Thomas Forsythe developed a series of photographs titled “Food Chain Barbie” depicting Barbie dolls or parts of Barbie dolls in absurd positions, often involving kitchen appliances. *Id.* at 796. Forsythe described the photographs as critiquing “the objectification of women associated with [Barbie].” *Id.* Mattel claimed that the photos infringed its trademark and trade dress, but we affirmed summary judgment for Forsythe because “[a]pplication of the *Rogers* test here leads to the same result as it did in *MCA*.” *Id.* at 807. Forsythe’s use of the Barbie mark was artistically relevant to his work because his photographs depicted Barbie and targeted the doll with a parodic message. *Id.* Moreover, apart from Forsythe’s use of the mark, there was no indication that Mattel in any way sponsored the photographs. *Id.*

Most recently, we applied the *Rogers* test in *Twentieth Century Fox Television*, 875 F.3d 1192. Twentieth Century Fox produced the television show *Empire*, which revolved around a fictional hip-hop record label named “Empire Enterprises.” *Id.* at 1195. Empire Distribution, an actual hip-hop record label, sent Twentieth Century Fox a cease-and-desist letter, and Twentieth Century Fox sued for a declaratory judgment that its show did not violate Empire’s trademark rights. *Id.* In affirming summary judgment for

Twentieth Century Fox, we rejected Empire’s argument that “the *Rogers* test includes a threshold requirement that a mark have attained a meaning beyond its source-identifying function.”⁶ *Id.* at 1197. Whether a mark conveys a meaning beyond identifying a product’s source is not a threshold requirement but only a relevant consideration: “trademarks that transcend their identifying purpose are more likely to be used in artistically relevant ways,” but such transcendence is not necessary to trigger First Amendment protection. *Id.* at 1198 (quotation marks and citation omitted).

We concluded that Empire could not satisfy *Rogers*’s first prong because Twentieth Century Fox “used the common English word ‘Empire’ for artistically relevant reasons,” namely, that the show’s setting was New York (the Empire State) and its subject matter was an entertainment conglomerate (a figurative empire). *Id.* Finally, we resisted Empire’s efforts to conflate the likelihood-of-confusion test with *Rogers*’s second prong. To satisfy that prong, it is not enough to show that “the defendant’s use of the mark would confuse consumers as to the source, sponsorship or content of the work;” rather, the plaintiff must show that the defendant “*explicitly misl[ed]* consumers.” *Id.* at 1199. Because Twentieth Century Fox’s *Empire* show contained “no overt claims or explicit references to Empire Distribution,” we found that Empire could not satisfy *Rogers*’s second prong. *Id.* Empire’s inability to satisfy either of *Rogers*’s two prongs meant that it could not prevail on its infringement claim.

⁶ We explained in *MCA Records* that trademarks sometimes “transcend their identifying purpose” and “become an integral part of our vocabulary.” 296 F.3d at 900. Examples include “Rolls Royce” as proof of quality or “Band-Aid” for any quick fix.

C

We first extended the *Rogers* test beyond a title in *E.S.S. Ent'mt 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008). In that case, defendant Rockstar Games manufactured and distributed the video game *Grand Theft Auto: San Andreas*, which took place in a fictionalized version of Los Angeles. *Id.* at 1096–97. One of the game’s neighborhoods—East Los Santos—“lampooned the seedy underbelly” of East Los Angeles by mimicking its businesses and architecture. *Id.* at 1097. The fictional East Los Santos included a virtual strip club called the “Pig Pen.” *Id.* ESS Entertainment 2000, which operates the Play Pen Gentlemen’s Club in the real East Los Angeles, claimed that Rockstar’s depiction of the Pig Pen infringed its trademark and trade dress. *Id.*

We recognized that the *Rogers* test was developed in a case involving a title, and adopted by our court in a similar case, but we could find “no principled reason why it ought not also apply to the use of a trademark in the body of the work.” *Id.* at 1099. With respect to *Rogers*’s first prong, we explained that “[t]he level of relevance merely must be above zero” and the Pig Pen met this threshold by being relevant to Rockstar’s artistic goal of creating “a cartoon-style parody of East Los Angeles.” *Id.* at 1100. On the second prong, we concluded that the game did not explicitly mislead as to the source of the mark and would not “confuse its players into thinking that the Play Pen is somehow behind the Pig Pen or that it sponsors Rockstar’s product. . . . A reasonable consumer would not think a company that owns one strip club in East Los Angeles . . . also produces a technologically sophisticated video game.” *Id.* at 1100–01. Because ESS

Entertainment 2000 could not demonstrate either of *Rogers*'s two prongs, we affirmed summary judgment for Rockstar.

Another video-game case dealt with the *Madden NFL* series produced by Electronic Arts, Inc. ("EA"). *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013). Legendary football player Jim Brown alleged that EA violated § 43(a) of the Lanham Act by using his likeness in its games. *Id.* at 1238–39. The district court granted EA's motion to dismiss, and we affirmed. *Id.* at 1239. We reiterated *E.S.S.*'s holding that the level of artistic relevance under *Rogers*'s first prong need only exceed zero and found it was "obvious that Brown's likeness ha[d] at least some artistic relevance to EA's work." *Id.* at 1243. We also found that Brown had not alleged facts that would satisfy *Rogers*'s second prong: "EA did not produce a game called *Jim Brown Presents Pinball* with no relation to Jim Brown or football beyond the title; it produced a football game featuring likenesses of thousands of current and former NFL players, including Brown." *Id.* at 1244. We asked "whether the use of Brown's likeness would confuse *Madden NFL* players into thinking that Brown is somehow behind the games or that he sponsors EA's product," and held that it would not. *Id.* at 1245–47 (alterations omitted). As in *E.S.S.*, the plaintiff could not satisfy either of *Rogers*'s two prongs, and judgment for the defendant was proper.

IV

In each of the cases coming before our court, the evidence was such that no reasonable jury could have found for the plaintiff on either prong of the *Rogers* test, and we therefore concluded that the plaintiff's Lanham Act claim failed as a matter of law. This case, however, demonstrates *Rogers*'s

outer limits. Although defendants' greeting cards are expressive works to which *Rogers* applies, there remains a genuine issue of material fact as to at least *Rogers*'s first prong—i.e., whether defendants' use of Gordon's mark in their greeting cards is artistically relevant.

A

As a threshold matter, we have little difficulty determining that defendants have met their initial burden of demonstrating that their greeting cards are expressive works protected under the First Amendment. As we have previously observed, “[a greeting] card certainly evinces ‘[a]n intent to convey a particularized message . . . , and in the surrounding circumstances the likelihood was great that the message would be understood by those who viewed it.’” *Hilton v. Hallmark Cards*, 599 F.3d 894, 904 (9th Cir. 2010) (quoting *Spence v. Washington*, 418 U.S. 405, 410–11 (1974) (per curiam)); *see also Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970) (plaintiff's greeting cards, considered as a whole, “represent[ed] a tangible expression of an idea” and hence were copyrightable). Each of defendants' cards relies on graphics and text to convey a humorous message through the juxtaposition of an event of some significance—a birthday, Halloween, an election—with the honey badger's aggressive assertion of apathy. Although the cards may not share the creative artistry of Charles Schulz or Sandra Boynton, the First Amendment protects expressive works “[e]ven if [they are] not the expressive equal of *Anna Karenina* or *Citizen Kane*.” *Brown*, 724 F.3d at 1241. Because defendants have met their initial burden, the burden shifts to Gordon to raise a triable issue of fact as to at least one of *Rogers*'s two prongs.

B

Rogers's first prong requires proof that defendants' use of Gordon's mark was not "artistically relevant" to defendants' greeting cards. We have said that "the level of artistic relevance of the trademark or other identifying material to the work merely must be above zero." *Id.* at 1243 (quotation marks and alterations omitted). The honey-badger catchphrase is certainly relevant to defendants' cards; the phrase is the punchline on which the cards' humor turns. In six of the seven cards, the front cover sets up an expectation that an event will be treated as important, and the inside of the card dispels that expectation with either the HBDC or HBDGS phrase. The last card, the "Critter Card," operates in reverse: the front cover uses variations of the HBDGS phrase to establish an apathetic tone, while the inside conveys that the card's sender actually cares about the recipient's birthday.⁷

But the "artistic relevance" inquiry does not ask only whether a mark is relevant to the rest of the work; it also asks whether the mark is relevant to the defendant's own *artistry*. The use of a mark is artistically relevant if the defendant uses it for artistic reasons. Conversely, the use of a mark is not artistically relevant if the defendant uses it merely to appropriate the goodwill inhering in the mark or for no reason at all. *See Parks v. LaFace Records*, 329 F.3d 437, 453 (6th

⁷ Defendants' greeting cards generally use a variation of the HBDGS phrase—a phrase that Gordon has not registered with the PTO. Although the distinction between the HBDC and HBDGS phrases may be material to what Gordon must prove under the likelihood-of-confusion test, we do not consider it relevant for determining whether he has raised a triable issue of fact as to either of *Rogers*'s two prongs.

Cir. 2003) (finding genuine issue of material fact on artistic-relevance prong, where “it would not be unreasonable to conclude that the title *Rosa Parks* is *not* relevant to the content of the song in question”). For artistic relevance to “be above zero,” the mark must both relate to the defendant’s work and the defendant must add his own artistic expression beyond that represented by the mark. For instance, Andy Warhol reproduced Campbell’s soup cans in a literal, but artistic, form; Warhol took Campbell’s mark and added his own artistic expression. No one seeing Warhol’s work would think he was merely trying to appropriate the goodwill inhering in Campbell’s mark; no one thought Warhol was selling soup, just art.

Rogers protects our First Amendment interests in artistic works, and defendants’ greeting cards are among the artistic works the Amendment protects. But it cannot be that defendants can simply copy a trademark into their greeting cards without adding their own artistic expression or elements and claim the same First Amendment protection as the original artist. *Cf. Parks*, 329 F.3d at 447 (“[T]he First Amendment cannot permit anyone who cries ‘artist’ to have *carte blanche* when it comes to naming and advertising his or her works, art though it may be.”). That would turn trademark law on its head.

Construing the facts in the light most favorable to Gordon, defendants may have merely appropriated the goodwill inhering in Gordon’s mark without adding any creativity of their own. To be sure, defendants’ use of the HBDC or HBDGS phrases is not a non sequitur; the phrases make sense in the context of defendants’ greeting cards. But there is at least a triable issue of fact as to whether defendants added their own artistic expression, as opposed to just

copying Gordon's artistic expression. Gordon has presented evidence that he sold various products bearing his mark, including greeting cards; that his agent met with a representative of defendants' parent corporation to discuss a possible licensing deal; that shortly thereafter, defendants started developing their own line of greeting cards even though their parent corporation had rejected the proposed licensing deal; and that defendants' president, who drafted the cards, could not recall what inspired them. Moreover, the cards themselves use Gordon's catchphrases in different ways, and a jury could possibly conclude that defendants used the phrases for artistic reasons on one or more cards but not on others.

These facts distinguish this case from others in which the *Rogers* test barred an infringement claim as a matter of law. In *Rogers*, the use of Ginger Rogers's name was integral to Fellini's film. His characters were trying to be like their American idols, Ginger and Fred. The film did not appropriate Ginger's mark; it came in praise of her craft, celebrating Rogers and Astaire's "elegance and class" and contrasting it with the "gaudiness and banality of contemporary television." *Rogers*, 875 F.2d at 1001. The film's title was "not a disguised advertisement for the sale of goods or services or a collateral commercial product." *Id.* at 1004–05.

The junior users in our Barbie cases also viewed Barbie as a cultural icon, even if they did not treat her with the same adulation that Fellini did Rogers. *Walking Mountain*, 353 F.3d at 802 ("To sell its product, Mattel uses associations of beauty, wealth, and glamour. Forsythe turns this image on its head . . . [to] transform Barbie's meaning."); *MCA Records*, 296 F.3d at 901 ("The song pokes fun at Barbie and

the values that Aqua contends she represents.”). In *Twentieth Century Fox*, the use of the word “Empire” as the title for the television series conveyed a raft of meanings: “Empire” was a “common English word” relevant to the show’s setting (New York) and its subject matter (a music and entertainment conglomerate). 875 F.3d at 1198. And in our video game cases, the borrowed mark was part of a much larger context. In *Brown*, Jim Brown was one of “thousands of current and former NFL players” appearing in the game, 724 F.3d at 1244, while in *E.S.S.*, the Pig Pen was just one of many fictional buildings and landmarks in a “cartoon-style parody” of a neighborhood in Los Angeles, 547 F.3d at 1100.

In short, in all of our prior cases it was clear that the mark at issue was relevant to the junior user’s work and that the junior user employed the mark in the junior user’s own artistic expression. Here, however, there is evidence that defendants simply used Gordon’s mark in the same way that Gordon was using it—to make humorous greeting cards in which the bottom line is “Honey Badger don’t care.” A jury could find that defendants’ cards are only intelligible to readers familiar with Gordon’s video and deliberately trade on the goodwill associated with his brand. Defendants have arguably not used the HBDC or HBDGS phrases in any way that distinguishes their use from Gordon’s and thus have not “imbued” their product with any “expressive value” apart from that contained in Gordon’s trademarked phrase. *MCA Records*, 296 F.3d at 900. We cannot resolve whether defendants’ use of Gordon’s mark is artistically relevant to

their cards as a matter of law. This presents a question of fact that a jury must decide.⁸

At trial, the district court should instruct the jury on the likelihood-of-confusion test, as in any infringement case. In addition, the court should instruct the jury that defendants have shown that their greeting cards are protected under the First Amendment and that Gordon must therefore prove an additional element to succeed on his claim. The jury may only find for Gordon if he proves by a preponderance of the evidence that defendants' use of his mark is (1) not artistically relevant to their greeting cards *or* (2) explicitly misleading as to the source or content of the cards. Defendants' use of the mark is artistically relevant if the mark relates to defendants' work and defendants' added their own artistic expression beyond that represented by the mark. Defendants' use of the mark is not artistically relevant if defendants merely appropriated whatever goodwill consumers associate with the mark without adding their own artistic expression or elements. Defendants' use of the mark is explicitly misleading only if it explicitly misleads consumers into believing that Gordon sponsored or is somehow associated with defendants' cards. Simply using the mark is not enough. There must be something else about

⁸ In light of our holding, we need not reach *Rogers*'s second prong—i.e., whether defendants' use of the mark is explicitly misleading. As discussed above, Gordon need only raise a triable issue of fact as to one of *Rogers*'s prongs to evade summary judgment. To succeed on his Lanham Act claim at trial, he will need to prove both a likelihood of confusion and at least one of *Rogers*'s prongs. That is, he will need to prove either a likelihood of confusion and the absence of any artistic relevance *or* a likelihood of confusion and that defendants' use of the mark is explicitly misleading.

the cards that explicitly misleads consumers into believing that Gordon sponsored or is associated with the cards.⁹

V

For the foregoing reasons, we **REVERSE** and **REMAND** to the district court for further proceedings consistent with this opinion.

⁹ We note that the district court has not yet addressed the likelihood-of-confusion test or defendants' abandonment defense. We express no opinion on those issues and leave them for the district court to address in the first instance.

Certificate of Service

I hereby certify that on August 13, 2018, I electronically filed the foregoing Petition For Panel Rehearing and Rehearing En Banc for Defendants-Appellees Drape Creative, Inc.; and Papyrus-Recycled Greetings, Inc. with the Clerk of the Court for the United States Court of Appeals for the Ninth Circuit by using the appellate CM/ECF system. I certify that all interested parties in the case are registered CM/ECF users and that service will be accomplished by the appellate CM/ECF system.

Dated: August 13, 2018

By: /s/ Barbara Fergerson
Barbara Fergerson