

Case No. 16-56715

Published Opinion Issued July 30, 2018

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

In the
United States Court of Appeals
for the
Ninth Circuit

CHRISTOPHER GORDON,
Plaintiff and Appellant,

v.

DRAPE CREATIVE, INC., a Missouri corporation,
and PAPYRUS-RECYCLED GREETINGS, INC., an Illinois corporation,
Defendants and Appellees.

*On Appeal from the United States District Court for the Central District of California,
Case No. 2:15-cv-04905-JFW-PLA · Honorable John F. Walter, District Judge*

**BRIEF *AMICI CURIAE* OF 37 INTELLECTUAL PROPERTY LAW
PROFESSORS IN SUPPORT OF APPELLEES' PETITION FOR
PANEL REHEARING AND REHEARING EN BANC**

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INTEREST AND IDENTITY OF THE AMICI CURIAE

Amici, identified individually in Appendix A, are law professors who teach and have written extensively on trademark law and related subjects. Amici have no stake in the outcome of this case but have an interest in seeing that trademark law develop in a clear and consistent way.¹

SUMMARY OF ARGUMENT

Mr. Gordon is a successful creator.² But it is copyright law that provides protection for creators and their creative contributions. Trademark law, by contrast, provides protection for the source-identifying functions of marks—not for the creative or expressive content of those marks or their social meanings. The *Rogers v. Grimaldi* test is a vital way to implement the distinction between source identification and expressive meaning when a trademark is allegedly infringed by an expressive, noncommercial use. The panel’s addition of a new, “non-artistic relevance” inquiry, and particularly its application of that test in this case, threatens

¹ Under Federal Rule of Appellate Procedure 29(a)(4)(E), the undersigned counsel certifies that no party’s counsel authored this brief in whole or in part, and that no person or entity other than the amici, their members, or their counsel contributed money to fund its preparation or submission.

² Gordon relied on existing National Geographic footage of the honey badger to create his video. https://en.wikipedia.org/wiki/The_Crazy_Nastyass_Honey_Badger.

Rogers's protection across a broad range of works and creates a conflict with copyright law and with prior decisions of this and other circuits.

ARGUMENT

I. Trademark Protects Source Identification, Not Creativity

A. Protection for Creativity Comes from Copyright, Not Trademark

Copyright is the constitutional mechanism by which Congress provides economic incentives for new expression. *Harper & Row Publishers, Inc. v. Nation Ents.*, 471 U.S. 539, 558 (1985). Importantly, copyright does not protect ideas or facts, *Feist Pubs., Inc. v. Rural Telephone Serv. Co.*, 499 U.S. 340, 350 (1991), nor does it protect short words and phrases of the kind at issue here. U.S. Copyright Office, Circular 33, *Works Not Protected By Copyright* (2017) (“ . . . slogans, and other short phrases or expressions cannot be copyrighted”). As the Supreme Court put it, “[i]t may seem unfair that much of the fruit of the compiler's labor may be used by others without compensation. “[H]owever, this is not some unforeseen byproduct of a statutory scheme. It is, rather, the essence of copyright, and a constitutional requirement.” *Feist*, 499 U.S. at 349 (citations omitted).

“Trademark, by contrast, is aimed not at promoting creativity and invention but rather at fostering fair competition.” *Phoenix Entertainment Partners v. Rumsey*, 829 F.3d 817, 825 (7th Cir. 2016); *Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, Inc.*, 696 F.3d 206, 216 (2d Cir. 2012) (“[T]rademark law is not

intended to ‘protect[] innovation by giving the innovator a monopoly’ over a useful product feature. Such a monopoly is the realm of patent law or copyright law, which seek to encourage innovation, and not of trademark law, which seeks to preserve a ‘vigorously competitive market’ for the benefit of consumers.”) (citations omitted). Trademark law is not a substitute for copyright when copyright is unavailable; indeed, the unavailability of copyright counsels against providing trademark protection for the creative aspects of uncopyrightable material. *Dastar v. Twentieth Century Fox Film Co.*, 539 U.S. 23, 34 (2003) (“[I]n construing the Lanham Act, we have been careful to caution against misuse or over-extension of trademark and related protections into areas traditionally occupied by patent or copyright.”) (internal quotation marks omitted).

Trademarks need not be new or creative, and they derive no legal protection from being either; trademarks must merely indicate to consumers that a particular product or service comes from a particular source. *The Trademark Cases*, 100 U.S. 82, 94 (1879) (“The ordinary trade-mark has no necessary relation to invention or discovery. . . . [W]hile the word *writings* may be liberally construed, as it has been, to include original designs for engravings, prints, etc., it is only such as are *original*, and are founded in the creative powers of the mind. The writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like. The trade-mark may be, and generally is, the adoption of

something already in existence as the distinctive symbol of the party using it.”); *Dastar*, 539 U.S. at 33-34.

Trademark owners’ ability to protect their marks against confusing uses comes with an important limitation: trademark rights do not entail control over the content of an expressive work itself. *Dastar*, 539 U.S. at 33-34; *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1197-98 (9th Cir. 2017); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

Trademarks often borrow from existing social meaning or acquire their own non-source identifying meanings. When they do so, others may use them to convey the non-source-identifying meanings, *Qualitex Inc. v. Jacobson Inc.*, 514 U.S. 159, 165 (1995)—and for good reason, because regulating those non-source identifying meanings would trigger First Amendment scrutiny. *Matal v. Tam*, 137 S.Ct. 1744, 1760 (2017).

Gordon did not allege copyright infringement with respect to any protectable work. Instead, he argued that defendants infringed his claimed trademark by using a phrase that became a viral phenomenon as the punchline of their jokes. The defendants didn’t use that phrase to indicate the source of some other goods or services. Rather, it was the defendant’s expressive use itself that drew Gordon’s ire. That’s not what trademark law is supposed to protect.

B. The *Rogers* Test Implements This Distinction Between Source-Identifying Meaning and Non-Source-Identifying Expression

A creative work can't be a trademark for itself. The product or service represented by the mark has to be different than the mark itself, so that the mark can identify the source of a distinct product or service. *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 62 (2d Cir. 2001); *EMI Catalogue P'ship v. Hill, Holliday, Connors Cosmopulos Inc.*, 228 F.3d 56, 64 (2d Cir. 2000) ("cases involving trademark infringement should be those alleging the appropriation of symbols or devices that identify the composition or its source, not the appropriation or copying or imitation of the composition itself"); *Rock & Roll Hall of Fame and Museum, Inc. v. Gentile Productions*, 134 F.3d 749, 754-55 (6th Cir. 1998) ("[W]hen we view the photograph in Gentile's poster, we do not readily recognize the design of the Museum's building as an indicator of source or sponsorship. What we see, rather, is a photograph of an accessible, well-known, public landmark. Stated somewhat differently, in Gentile's poster, the Museum's building strikes us not as a separate and distinct mark *on the good*, but, rather, as the good itself."). Gordon's phrase is undoubtedly well-known as a phrase and as a constituent element of a meme. But the existence of that non-trademark meaning does not entitle Gordon to control anything other than the use of the phrase to identify the source of relevant goods or services he provides.

The Second Circuit’s test in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), adopted in numerous of this Court’s opinions,³ is one tool that has proved very successful at distinguishing source-identification from non-source-related meanings. As the court in *Rogers* noted, Ginger Rogers’s undoubted fame as a dancer/actor did not mean that using her name, even in the title of a movie, created any source-identification problems, even though the defendant’s use was undoubtedly motivated by Rogers’ own fame. Indeed, very few uses of a trademark as a part of a noncommercial, expressive work could cause such problems. *Id.* at 1000. Moreover, the risks of suppressing noncommercial speech are higher and the costs to the public greater when trademark law suppresses a separate work rather than an advertisement or label.

With these considerations in mind, *Rogers* set forth an interpretive rule, based on First Amendment principles, that a use of a trademark in an expressive work (which defendant’s works clearly are)⁴ could be actionable only if (1) the use was

³ See, e.g., *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806-07 (9th Cir. 2003); *E.S.S. Ent’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013); *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1196 (9th Cir. 2017).

⁴ The fact that defendants sell their cards for profit doesn’t change their constitutional status. *The New York Times* has a commercial purpose; so do video games, television programs, and films. See, e.g., *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501–02 (1952) (holding that “expression by means of motion pictures is included within the free speech and free press guaranty” in the Constitution, even though filmmaking

not artistically relevant, or (2) even if artistically relevant, the use was explicitly misleading. *Id.* at 999. This rule recognizes the reality that using a trademark in the content of a noncommercial work to convey meaning is not the same thing as using it to identify the source of the speaker's goods or services, even though the expressive meaning may often derive from the trademark owner's own efforts. Importantly, the centrality of the meaning conveyed by use of the mark in the defendant's noncommercial work is not determinative. In some cases, the meaning is decidedly not central. *See, e.g., Brown*, 724 F.3d at 1244 (finding defendant's use of plaintiff as one football player out of thousands depicted in the video game insulated by *Rogers*); *E.S.S.*, 547 F.3d at 1099 (finding defendant's use of the plaintiff's mark insulated by *Rogers* even though it was a minor detail in a large, open-world video game). In other cases, the meaning has been central to the defendant's work because of the way references to trademarks functioned in the expressive works. *See, e.g., Mattel, Inc. v. Walking Mountain Prod'ns*, 353 F.3d 792

“is a large-scale business conducted for private profit”); *see also Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 67 (1983) (holding that economic motivation for speech by itself does not make speech commercial); *Brown v. Entertainment Merchants Ass'n*, 564 U.S. 786 (2011) (holding that video games sold for profit were entitled to full First Amendment protection). Consistent with this First Amendment approach, almost every *Rogers* case, including every case cited by the panel, involved for-profit speech that was noncommercial under the First Amendment's definition of noncommerciality, which distinguishes between advertising and non-advertising speech.

(9th Cir. 2003) (finding photographer’s “Food Chain Barbie” series non-infringing); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002) (finding music group’s use of Barbie mark throughout “Barbie Girl” song non-infringing); *Rogers*, 875 F.2d 994.

Every formulation of the *Rogers* test makes clear that the defendant’s use need only have *some* artistic relevance under the first prong. *Rogers*, 875 F.2d at 999 (permitting a claim only when there is “*no* artistic relevance”) (emphasis added). Only when the use of a mark has no relevance at all to the defendant’s expression will a defendant’s use infringe under *Rogers*. *See id.*; *E.S.S.*, 547 F.3d at 1099 (making clear that the defendant’s use need only have “more than zero” artistic relevance); *cf. Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003) (finding a disputed issue of fact as to whether a rap song titled “Rosa Parks,” the lyrics of which did not directly refer to Rosa Parks, infringed her rights).⁵ If there is even minimal artistic relevance, *Rogers* protects artists when they talk about the world. *Brown*, 724 F.3d at 1243-44. And so it must be, or courts would in every case be in the impossible position of judging the artistic contribution of the defendant’s use—

⁵ *Parks* was the only appellate decision ever to find no artistic relevance, and it did so without making clear, as this Circuit has, that the artistic relevance need only be more than zero.

something copyright courts have long recognized as inappropriate. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

II. The Panel’s New Interpretation and Application of *Rogers* Disrupts Settled Precedent and Causes Conflict with Copyright Law

Ultimately, the panel opinion suggests that defendants just told the same joke that Gordon did. But Gordon can only assert trademark claims based on rights in a trademark, not a joke; the joke has non-trademark meaning, and preserving the freedom to engage in that kind of expression is the point of *Rogers* as it has been read up until now.

A. Artistic Relevance Is Relevance to Art (Noncommercial Speech), Nothing More.

On the panel’s own analysis, Gordon’s phrase was “relevant” to defendants’ creativity. The use of the phrase was important to the content of defendants’ cards – indeed, it was central to the joke in each of those cards. True, it was a short phrase, and claimed by Gordon as a trademark, but the Supreme Court has made clear that neither of those facts prevents the use of the phrase from being protected speech. *Tam*, 137 S. Ct. at 1760 (“[T]rademarks often have an expressive content. Companies spend huge amounts to create and publicize trademarks that convey a message. It is true that the necessary brevity of trademarks limits what they can say. But powerful messages can sometimes be conveyed in just a few words.”). *Cf. Cohen*

v. California, 403 U.S. 15 (1971) (“Fuck the Draft” on a T-shirt was protected speech).

Indeed, the panel seems to have been concerned, not that there was no artistic relevance to the defendant’s use, but that there was *too much* relevance— that the defendants just took the plaintiff’s mark as the centerpiece of their expressive work. Parts of the panel opinion suggest that the panel wished to require what courts in the right of publicity context have called “transformativeness”—additional artistic content of the defendant’s own in addition to the representation of a celebrity. [slip op] (“Defendants . . . 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.”); (“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.”); (finding triable issue of fact on “whether defendants added their own artistic expression, as opposed to just copying Gordon’s artistic expression”).

But transformativeness is not the *Rogers* test, and the panel’s introduction of that concept is clear evidence that it blurred the lines between trademark and copyright law. None of the previous cases in the Ninth Circuit or any other circuit that have applied the test have assessed the amount or quality of the defendant’s own

artistic contribution, other than to confirm that the defendant’s “work” was not itself merely an advertisement or disguised advertisement for a separate product or service. *Any* quantum of artistic relevance, no matter how small, suffices. Indeed, the Ninth Circuit has expressly rejected transformativeness for trademark law even while applying it for the right of publicity. *Compare Brown*, 724 F.3d at 1243-45 with *Keller v. Electronic Arts, Inc.*, 724 F.3d 1268, 1273-82 (9th Cir. 2013) (rejecting *Rogers* in a right of publicity case and applying the transformative use test instead because the purposes of the right of publicity differ from trademark law).

The panel in this case wrote, in support of its decision to remand, that “[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.” [Slip op.] But audiences can often be familiar with the honey badger phrases as phrases without recognizing them as an indicator of source for goods and services. The defendants might have been relying on the cultural meaning of the phrase without free riding on Gordon’s “goodwill” in any trademarks. Even in cases of substantial secondary meaning, *Barbie Girl* would be “unintelligible” to listeners unfamiliar with Mattel’s Barbie, or *Fred and Ginger* to viewers unfamiliar with Astaire and Rogers. The panel’s equation of cultural meaning with trademark meaning is flatly inconsistent with *Rogers*. And a work can be artistically relevant without changing or commenting on the original. The goal of the use in both *Brown*

and *VIRAG v. Sony Ent. Corp.* was realism, not transformation. But both uses were artistically relevant. *VIRAG v. Sony Ent. Corp.*, 699 F. Appx. 667 (9th Cir. 2017) (unpub.) (“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.”).

Adding a new element to the *Rogers* test increases the risks to speakers without creating substantial protections for consumers, who generally don't rely on the presence of trademarks in the content of works to make purchasing decisions. *Dastar*, 539 U.S. at 32-33 (“The words of the Lanham Act should not be stretched to cover matters that are typically of no consequence to purchasers.”). With this new element, apparently based on a jury's opinions about artistic qualities rather than on the objective content of the work itself, defendants are more exposed to expensive discovery and a possible jury trial. This is inconsistent with the purpose of *Rogers* as well as with the Supreme Court's caution that trademark doctrine should not encourage anticompetitive (or speech-suppressive) strike suits. *Cf. Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000). Even if defendants routinely win fully litigated cases, the deterrent effect of a fact-intensive test can squelch speech, which means that the test should aim for clarity and resolution on the pleadings in most cases. William McGeeveran, *The Imaginary Trademark Parody Crisis (and the Real One)*, 90 WASH. L. REV. 713, 745-53 (2015) (emphasizing the

importance of clear rules that can be applied early in litigation in order to protect speech); William McGeveran & Mark P. McKenna, *Confusion Isn't Everything*, 89 NOTRE DAME L. REV. 253 (2013) (same).

B. If Applied to Find an Issue of Fact, the New Test Conflicts with Copyright Law

The panel offered no clear definition of the amount of “artistic” relevance it would require in holding that there was a factual issue about whether defendants’ uses were artistic or merely exploitative.⁶ But sending the case back for factfinding suggests that a reasonable factfinder could find either way. If this is so, however, then the panel has created a serious conflict with copyright law.

It is beyond question that the modest creativity added by defendants is enough to qualify their greeting cards for copyright protection. Defendants’ creativity is “artistic” in that sense, and courts should not further inquire into the cards’ artistic merit. *Bleistein*, 188 U.S. at 251.⁷ If, however, a jury has to decide whether

⁶ The panel says: “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 op.] However, the panel does not explain how to distinguish “artistic reasons” (which may well include making a popular or at least popularly intelligible work, and thus using cultural reference points such as Barbie, a gentleman’s club, or a honey badger) from uses that “appropriate the goodwill” of a mark.

⁷ The panel’s unsupported factfinding on Andy Warhol’s soup cans highlights the unpredictability its new test generates. Although the panel asserts that “[n]o one

defendants’ artwork, while itself creative and copyrightable, is nonetheless “non-artistic” in its relevance to the punchline of their joke, then it will not be able to apply the copyrightability standard. This court will have to develop some new standard to define what qualifies as “art,” and some original works of authorship presumably won’t meet that higher definition of art.

The existence of another standard within trademark for maintaining the boundaries between the public domain and protectable expression creates a deep conflict between trademark and copyright. If the jury is allowed to find that the overlap in the parties’ ideas—using “honey badger don’t care” as a punchline for jokes about supposedly significant events—is enough to make defendants’ work “exploitative” rather than “artistic” or to determine that defendants didn’t add enough of relevance—then copyright’s preservation of freedom for ideas will be eviscerated. Courts will inevitably be dragged into the very inquiry *Bleistein* insisted they avoid—not only determining “what is art” but assessing whether the art was

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,” these claims ignore Warhol’s own history as well as that of the reception of the paintings. See Rebecca Lowery, *The Warhol Effect*, <https://www.metmuseum.org/exhibitions/listings/2012/steins-collect/~media/Files/Exhibitions/WarholTimeline.pdf> (discussing early receptions of the soup cans paintings as the work of a “fool” or a “charlatan,” and Warhol’s own persistent disavowal of meaning). We know these things now because Warhol is famous, but a standard that relies on the defendant’s own fame to impute protectable meaning to art is the opposite of what the First Amendment demands for speakers of every level.

primarily creative or instead “merely” derivative. And they will have to do so without any of the guidance copyright law offers for assessing the copying of the creative elements of the work.

The Supreme Court has repeatedly cautioned that trademark should not be expanded to interfere with the proper boundaries of copyright. *Dastar*, 539 U.S. at 33-34; *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237-38 (1964); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232-33 (1964). The panel’s interpretation is an unwarranted entanglement of copyright and trademark concepts.

Allowing a trademark owner to protect its mark because the mark is creative would result in “a species of mutant copyright law that limits the public's federal right to copy and use expired copyrights.” *Dastar*, 529 U.S. at 34; *see also Eastland Music Grp., LLC v. Lionsgate Entm’t, Inc.*, 707 F.3d 869, 872 (7th Cir. 2013) (“*Dastar* held that trademark law cannot be used to obtain rights over the content of an artistic work; that would amount to an indefinite extension of a copyright.... *Dastar* tells us not to use trademark law to achieve what copyright law forbids.”).

Overextension of trademark rights could be prevented here by recognizing that Gordon has a right to use his phrase as a trademark for a line of greeting cards, but not a trademark right in the “bottom line” [Slip op]—the punchline—of a joke. That distinction preserves the substance of the *Rogers* test and the purposes of trademark law, and it respects copyright law’s refusal to protect short phrases. Or it

could be prevented by applying the test as the panel opinion states it but recognizing that there can be no factual dispute as to whether the defendants' use of the Honey Badger Don't Care phrase has at least some artistic relevance. But demanding—as the panel opinion does here—that the jury engage in an assessment of the quality and independence of defendant's art—puts this Court at odds with its own prior precedent and the understanding of every other circuit to have adopted *Rogers*.

CONCLUSION

The panel opinion should be rejected in favor of a decision consistent with *Rogers* and its progeny.

Dated: August 23, 2018

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

I certify that pursuant to Federal Rules of Appellate Procedure 29, 32(a)(5), 32(a)(7), and Circuit Rule 29-2, the foregoing brief is proportionally spaced, has a typeface of 14-point Times New Roman, and contains 3,902 words, excluding those sections identified in Fed. R. App. P. 32(f).

Dated: August 23, 2018

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Appendix A

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Professor Christopher Jon Sprigman
New York University School of Law

Professor Rebecca Tushnet
Harvard Law School

CERTIFICATE OF SERVICE

I hereby certify that on August 23, 2018, I electronically filed the foregoing 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 participants in the case are registered CM/ECF users and that service will be accomplished by the appellate CM/ECF system.

/s/ Mark A. Lemley
Mark A. Lemley