

Dog toy or art? What is expressive work for Rogers artistic relevance test?

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21 May 2022



Consumers read and understand the contents of the title and text of an expressive work differently than they do, for example, the contents of the label and packaging of an ordinary product. It is assumed under US trademark law, for example, that consumers encountering the book or movie *The Devil Wears Prada* are not likely to understand the use of the PRADA mark to signify the origin of the work. Indeed, well-known songs containing trademarks include *My Adidas*, *Versace* and *Lego House*.

This assumption is the rationale for an exception to the use of the usual likelihood of confusion test when infringement disputes arise relating to expressive works. Instead, the court asks whether the defendant's use of the plaintiff's mark is artistically relevant to the defendant's expressive work. If so, the defendant will prevail unless the plaintiff shows that the defendant's use was explicitly misleading.

As a practical matter, this is very difficult to prove. So expressive works are rarely held to infringe under the *Rogers* test (as this analysis is known) – but what are expressive works?

The *Rogers* test has worked well enough for over 30 years when applied to 'traditional' expressive works such as movies, books, songs and video games – works that tend to have identifiable titles and texts.

However, the recent Ninth Circuit decision in *VIP Products, Inc v Jack Daniel's Properties, Inc* (953 F.3d 1170 (9th Cir 2020)) ("BAD SPANIELS") held that a dog toy shaped to resemble a bottle of Jack Daniel's whiskey and bearing labels that parody the Jack Daniel's trade dress was an expressive work.





This decision inspired the district court judge in the case to comment that it is now impossible for a plaintiff to prevail under *Rogers*.

Simultaneously muddying the waters between artistic relevance and parody, the Southern District of New York did not even apply the test when evaluating an art collective's self-described art project consisting of a limited edition of "modified" sneakers, treating it instead as a failed parody. (Parody is a defence that has developed in parallel to the artistic relevance doctrine. As Professor McCarthy puts it, a successful parody borrows enough to remind, but too much to confuse. An unsuccessful parody fails to clearly signify its source.)

There is now a need for clarification of the *Rogers* test, beginning with the threshold question: what is an expressive work?

***Rogers v Grimaldi* first articulates artistic relevancy test**

Rogers v Grimaldi, a 1989 Second Circuit case, involved the Federico Fellini movie *Ginger and Fred*. The *Rogers* court was the first to articulate the rationale for the differing treatment of expressive works from 'ordinary' products.

In the key passage, the court noted:

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“Though consumers frequently look to the title of a work to determine what it is about, they do not regard titles of artistic works in the same way as the names of ordinary commercial products. Since consumers expect an ordinary product to be what the name says it is, we apply the Lanham Act with some rigor to prohibit names that misdescribe such goods... But most consumers are well aware that they cannot judge a book solely by its title any more than by its cover. (Rogers v Grimaldi, 875 F.2d 994, 1000 (2nd Cir 1989)) (Citations omitted.)

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The “just a dog toy” argument

Since *Rogers*, the artistic relevance test has been applied to various traditional works of expression, but without a definition of ‘expressive work’ being propounded or widely accepted.

In cases where the category of the defendant’s purported expressive work varied further from traditional artistic works and closer to ‘ordinary’ items such as greeting cards and dog toys, plaintiffs have argued that the ordinariness of the defendant’s medium diminishes the claimed level of protection of the defendant’s work. Such plaintiffs’ arguments might be paraphrased as: “It’s just a dog toy.”

However, “it’s just a dog toy” has been a losing argument for plaintiffs to date because the courts have considered only the impact of choice of medium on the quality of the expressive content, and not the impact of the medium on consumer perception – forgetting the rationale of *Rogers*.

The argument that the type of expression found on something as mundane as a greeting card or a dog toy or some other ‘ordinary’ product is of a lower quality (at least when compared to traditional works of expression) is roundly rejected (in trademark cases and elsewhere) because the courts are loathe to determine what is good art.

When courts have considered the “it’s just a dog toy” argument, they have responded not by answering the entire threshold question under *Rogers*: what is an expressive work? Rather, the courts have answered an important but preliminary question: whether the defendant’s particular expression is eligible for First Amendment protection at all.

The courts will virtually always answer this question in the affirmative, applying a non-zero level of expression. (Amusingly, rather than defining just how bad a defendant’s work can be and still be protectable, the courts indicate instead what the defendant’s expression does not have to be. The Ninth Circuit has noted in different cases that protectable expression does not have to be *Anna Karenina*, *Citizen Kane* or the *Mona Lisa*.)

Thus, the inscription on a greeting card or the funny label on a dog toy can be protectable speech – but that does not say that such speech cannot be regulated under the Lanham Act.

Bad Spaniels is art

The BAD SPANIELS decision misses the distinction between expression and expressive work.



Evaluating a dog toy that referred to the Jack Daniel's trade dress but was festooned with dog images and dog jokes, the Ninth Circuit credited the testimony of the CEO of the defendant company that the humorous label expressed the idea that brands should not take themselves so seriously. This creative "idea" met a non-zero standard of expression; the dog toy was therefore deemed to be an expressive work and thus qualified for analysis under the *Rogers* test, and not the usual likelihood of confusion test. Impliedly, any product is an expressive work for purposes of *Rogers* if it bears any expression.

A short-coming of the BAD SPANIELS analysis is that the complained-of material is intended to look like a label, appearing where authorised labels appear on authorised merchandise. It may well be the case that the BAD SPANIELS product has multiple material differences with the real JACK DANIELS label that there is no likelihood of confusion. In other words, the BAD SPANIELS label may be interpreted as a successful parody. However, the usual likelihood of confusion test, which would have taken that into account, may be better suited to make that determination.

However, as noted above, the district court judge in the BAD SPANIELS case noted that it "appears nearly impossible for any trademark holder to prevail under the *Rogers* test". The decision creates a roadmap for 'sham' parodies – products appearing that minimally alter trademarks enough to express the idea that brands should not take themselves seriously. With no limit to platform, the expression can appear on tens of thousands of products – think of all the products available for imprinting on a website such as Red Bubble or Zazzle. Reconsideration of the decision by the Ninth Circuit has been denied. Jack Daniels may file for review by the Supreme Court.

Wavy Baby is not art

The Southern District of New York, recently chose to distinguish BAD SPANIELS on the facts, rather than clarifying the *Rogers* Test. However, the decision suggests useful factors in defining what is an expressive work.

In *Vans Inc v MSCHF Product Studio Inc*, 1:22-cv-02156 (EDNY April 29, 2022), sneaker manufacturer Vans alleged that defendant MSCHF's shoe, known as the Wavy Baby, copied the trade dress of the Vans OLD SKOOL shoe in its design, and reproduced five other Vans trademarks on the shoe, on packaging and in promotion.

MSCHF, a self-described art collective, argued that its limited-edition shoe was a parody targeted at sneakerheads and skateboard culture (of which Vans was an integral part). MSCHF described its work as "an exaggerated shoe that is wobbly in shape, unique in appearance, and not practical for everyday wear (let alone balancing on a skateboard)".

MSCHF argued that under *Bad Spaniels*, its use of Vans trademarks was artistically relevant to its project. The judge studiously avoided a reference to *Rogers* or to the phrase 'artistic relevance' – and distinguished this case noting only that unlike the parties in *Bad Spaniels*, the parties here were competitors.

Implicit in that holding was the court's finding that the defendant's products were sneakers, and not works of art relying on the high number of pairs of shoes made available (4,306), and the fact that the defendant intended to correct shipping errors of the wrong size. The court reasoned: "If the shoes were truly meant to be artworks to be displayed rather than worn, there would be no specific need for consumers to receive a specific size."

Having determined that the sneakers were not to be treated as artworks, the court held that WAVY BABY did not meet the requirements for a successful parody. Although the Wavy Baby sneakers "convey their similarity and reference to the [Vans] shoe trademarks", they do not "sufficiently articulate 'an element of satire, ridicule, joking or amusement' clearly indicating to the ordinary observer that [MSCHF] is 'not connected in any way with [Vans]'", the court said. The decision is now on expedited appeal to the Second Circuit Court of Appeals.



VANS
"OFF THE WALL"



WAVY BABY



What is a useful test for what is an expressive work?

In a perfect world, artistic works and successful parodies freely exercise speech while consumers are protected from confusion. Guided by the rationale of *Rogers*, what test can determine the boundary between 'traditional expressive work' and 'ordinary product' without creating the roadmap for sham parodies under *BAD SPANIELS*?

If a defendant's work is not of a type already recognised by *Rogers* (eg, books and movies), one approach is to adopt a multi-factor test, asking the following, for example:

- Does the defendant's work bear an identifiable title of a work, as opposed to a brand name of a product?
- Does the defendant's reproduction of the mark appear within the title or text of a work, or does it appear on what are normally perceived as trademark spaces (eg, labels, tags and packaging)?
- Is the defendant's work sold in limited or unlimited quantities?
- Is the defendant's product competitive with products within the plaintiff's zone of activity?

An additional, more abstract factor would be to consider 'conceptual separability'. The *Rogers* court indicated that in an expressive work, expression is inextricably intertwined with the product. Put another way, if you remove the expression from a book or movie, there is no recognisable product left, as there is no such thing as a blank movie or blank song. In contrast, remove the expression from a dog toy (or coffee mug or water bottle) and you are left with a recognisable product. This suggests that consumers perceive both expressive content and a product. Accordingly, the usual likelihood of confusion test should be employed to determine whether consumers perceive the expression as designating the source of origin for that product.

Is refining the test for expressive works worth the fuss? The number of art collectives that can create something like the Wavy Baby shoe is probably quite low – and they are not a typical defendant. In contrast, imprinting service websites such as Zazzle and Red Bubble make the likelihood of sham parodies being created quite high. Therefore, the *BAD SPANIELS* holding should be taken seriously as an immediate problem to be solved.

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