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Bone of Fido Parody: *Louis Vuitton v. Chewy Vuiton*

By Jonathan Moskin

A biting satire it may not have been, but *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007), nonetheless concluded that canine chew toys fashioned after Louis Vuitton handbags were a permitted parody that did not infringe or dilute Louis Vuitton's admittedly well-known marks. Although the decision scratches little new ground in the trademark jurisprudence of parody and infringement, it was a first opportunity for an appellate court to assess parody under the new Trademark Dilution Revision Act. The court here squarely rejected a concerted, if not to say dogged, effort by Vuitton and its amicus, the International Trademark Association, which both urged a position that, in the words of the court, would "automatically" have made parodies unlawful. *Id.* at 264.

No Infringement

The Fourth Circuit, in affirming the district court's grant of summary judgment, fully applied the multi-factor test of likelihood of confusion, yet its application of the infringement test was shaped entirely by its initial assessment of what might be called the parody paradox; namely, that the parodist, to be effective, must make his or her rendering readily recognizable *as* the original yet just as readily distinguishable as a commentary *upon* the original. Louis Vuitton explains: "'A parody must convey two simultaneous — and contradictory — messages: that it is the original, but also that it is not the original and is instead a parody.' [Citation omitted.] This second message must not only differentiate the alleged parody from the original but must also communicate some articulable element of satire, ridicule, joking or amusement." 507 F.3d at 260. Under this standard, the court had little difficulty articulating the necessary element of satire, ridicule, joking or amusement despite (or because of) the fetching likeness of the two products: "The furry little 'Chewy Vuiton' imitation, as something to be *chewed by a dog*, pokes fun at the elegance and expensiveness of a LOUIS VUITTON handbag, which must *not* be chewed by a dog." *Id.* at 261.

To be sure, one might be hard pressed to find a claimed parody that does NOT satisfy this "some articulable element" standard — at least for products principally likely to be hounded by parodists: namely, those holding some place of esteem in culture or commerce. Nor has it ever been any great secret how daunting a task is the line-drawing required by parody cases. Indeed, one might simply compare *Louis Vuitto*n with *Grey v. Campbell Soup Co.*, 650 F. Supp. 1166, 1175 (C.D.Cal. 1986), aff'd, 830 F.2d 197 (9th Cir. 1987), where the products were DOGIVA and CATIVA pet food in purported parody of GODIVA chocolate. Although *Grey* seems plainly on all fours with Louis Vuitton, the outcome was just the opposite.

Some parody cases would appear to turn on the expressive nature (or not) of the accused work, and the gravity (or levity) of the First Amendment values in issue. For instance, the motion picture character "Spa'am" was a permitted parody in *Hormel Foods Corp. v. Jim Henson Productions, Inc.*, 73 F.3d 497, 503 (2d Cir. 1996). Yet, *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997), enjoined a book satirizing Dr. Seuss' literary style. And although defendant's "Garbage Pail Kids" children's stickers parodying Cabbage Patch Kids were enjoined in *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F.Supp. 1031 (N.D. Ga. 1988), the same company's "Wacky Packages" stickers were permitted in *Tetley, Inc. v. Topps Chewing Gum, Inc.*, 556 F. Supp. 785 (E.D.N.Y. 1983). Likewise, although an "Enjoy Cocaine" poster playfully mocking Coca Cola's logo was enjoined in *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F.Supp. 1183 (E.D.N.Y. 1972), a pregnant Girl Scout poster - under the heading "Be Prepared" — satirizing the group's chaste image was permitted in *Girl Scouts of USA v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228, 1233 (S.D.N.Y. 1969).

On the other hand, although parodic consumer products, such as the Chewy Vuitton pet toy, have at times been permitted, *see, e.g., Jordache Enter. v. Hogg Wyld, Ltd.*, 625 F. Supp. 48 (D.N.M. 1985), aff'd, 828 F.2d 1482 (10th Cir. 1987) ("Lardashe" jeans with pig insignia not an infringement of "Jordache" jeans with horse logo); *Eveready Battery Co., Inc. v. Adolph Coors Co.*, 765 F.Supp. 440 (N.D. Ill. 1991) (brewer permitted to spoof "Energizer Bunny" in purely commercial promotion of its beer); products often have been deemed unfair. Campbell Soup Co., *supra*, makes clear (as soup) the many possible shades of grey and absence of clear black and white rules.

Nor is poor taste or the prurience of the parody any sure guide to permissibility. Compare *LL Bean, Inc. v. Drake Publishers*, 811 F.2d 26, 27 (1st Cir. 1987) (allowing a "crudely humorous," "prurient parody" of plaintiff's product

catalog), with *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema Ltd.*, 604 F.2d (2d Cir. 1979). *American Express Co. v Vibra Approved, Labs Corp.*, 87 Civ. 8840, 1989 WL 39679 (S.D.N.Y. April 19, 1989), amply demonstrates how paradoxical parody — even plainly prurient parody — can be. There, a replica of an American Express card containing a condom and sold as a "sex toy" under the tag line "Never leave home without it" was *not* an infringement — but *was* deemed likely to dilute or tarnish plaintiff's marks.

As this author has argued elsewhere, Frankenlaw: The Supreme Court's Fair and Balanced Look At Fair Use, 95 Trademark Rptr. 848 (2005), parody appears to fall on a spectrum of fair use. Following *KP Permanent Make-Up, Inc. v. Lasting Impression, Inc.*, 543 U.S. 111 (2004), where an alleged fair use is in issue, it should, perhaps be less relevant (if not entirely beside the point) to assess the use under a traditional infringement analysis. Instead, the primary, if not sole, question should be whether the use is fair. If it is, there may be no need to assess infringement. How such an approach might be applied in trademark parody cases is hard to say, because courts rarely try. Although *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc.*, 886 F.2d 490 (2d Cir. 1989), noted, for instance, that the likelihood of confusion test is "at best awkward in the context of parody", *Id.* at 495 n.3, *Louis Vuitton* concluded that "the finding of a successful parody only influences the way in which the [likelihood of confusion] factors are applied." 507 F.3d at 261. It is not alone. *See Hard Rock Café Licensing Corp. v. Pacific Graphics, Inc.*, 776 F. Supp. 1454, 1462 (W.D. Wash. 1991) ("Parody is not a defense to trademark infringement, but rather is another factor to be considered in the likelihood of confusion equation.") Yet, the Fourth Circuit's own application of the multi-factor infringement analysis shows how thoroughly its threshold finding of permissible parody determined application of the test. Indeed, had the court doubted the use was a parody, its assessment of virtually all factors could have been flipped (strong mark; almost exact copy of that mark, selected with intent to copy; some overlap in trade channels as both products were sold at least in one store, Macys, and so forth). The tail thus wags the dog.

Although copyright fair use is itself notoriously uncertain, the Copyright Act does articulate specific factors, 17 U.S.C. §107, and often there is enough substance (or the lack thereof is itself revealing) to permit some informed judgment whether an accused work advances the purposes of the Copyright Act of encouraging creativity — most critically by being genuinely transformative. Not so in trademark law, where neither the Lanham Act nor applicable case law provides many pointers how to determine when the purposes of trademark law are or are not advanced by a parody; what it means for a parody to be "effective," or when, by contrast, a party simply out to make a quick buck has gone too far (or not far enough).

No Dilution

Regarding dilution, the Fourth Circuit acknowledged the Louis Vuitton trademarks were famous and that Chewy Vuiton pet toys created an association with the marks, albeit a parodic one. This much conceded, the focus turned squarely to the issue no dilution case has ever explained, namely how some associations cause (or are likely to cause) an impairment of the distinctiveness of a famous mark. 507 F.3d at 265. Resolving this bone of contention, Louis Vuitton concluded likelihood of dilution must in all instances be proven, based on full consideration of the six enumerated statutory factors (namely, degree of inherent or acquired distinctiveness of the famous mark, exclusivity of use of the mark; recognition level of the famous mark; similarity between the marks, intent and evidence of actual associations).

In so holding, the court rejected Louis Vuitton's proposed broad reading of the TDRA, under which "any use by a third person of an imitation of its famous marks dilutes the famous marks as a matter of law." 507 F.3d at 265. Plaintiff's argument that the chew toys were necessarily unlawful was by reverse logic from the TDRA's specification that parody can be a "fair use" only when the use is "*other than as a designation of source for the person's own goods or services*, including use in connection with … parodying…the famous mark owner or the goods or services of the famous mark owner." 15 U.S.C. §1125(c)(3)(A)(ii). By *Vuitton's* and its amicus INTA's reasoning, that the *name* of the defendant's product, CHEWY VUITON, was a designation of source was dispositive. Giving this statutory language only a short tether, however, the Fourth Circuit said it still did not trump the broader requirement of proving likelihood of dilution. Put differently, even if employing the parody as a brand name precluded a finding of fair use, the parodic nature of the use created associations *unlikely* to dilute the Vuitton trademark. "In sum," said the court, "while a defendant's use of a parody as a mark does not support a 'fair use' defense, it may be considered in determining whether the plaintiff-owner of a famous mark has proved its claim that the defendant's use of a parody mark is likely to impair the distinctiveness of the famous mark." 507 F.3d at 267. On this score, recognizing the puzzling nature of what, if anything, causes (or is likely to cause) dilution, the court explained that "by making the famous mark an object of the parody, a successful parody might actually enhance the famous mark's distinctiveness by making it an icon." *Id.*

Although not framed in terms of fair use (deliberately so), the Fourth Circuit's dilution analysis, like its infringement analysis, turned entirely

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on the effectiveness or not of the parody. In finding no likelihood of dilution, Louis Vuitton thus notes that "[w]hile a parody intentionally creates an association with the famous mark in order to be a parody, it also intentionally communicates, if it is successful, that it is ***not*** the famous mark, but rather a satire of the famous mark." 507 F.3d at 267. The court did acknowledge that "if the parody is so similar to the famous mark that it likely could be construed as actual use of the famous mark itself", *Id.* at 268, it might cause dilution. However, the analysis went no deeper in elucidating when a claimed parody indeed furthers the purposes of the Lanham Act or where or how the line between effective and failed parody is to be drawn.

CONCLUSION

Just as part of the fair use analysis asks whether the defendant has used no more than necessary to invoke the original, *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992), it may be that to the extent legal lines can be drawn, certain parodic uses coming too close to the original might simply be treated as failed parodies and hence infringements.

Louis Vuitton does not purport to go further than most trademark parody cases in demarcating these boundaries of fairness, and does not even acknowledge the line sometimes drawn between core First Amendment parodies and ordinary consumer products. However, *Louis Vuitton* does establish that the new TDRA does *not* provide any such bright line barring all plays on famous marks in naming parodic products. How long a leash parodists *should* be allowed will no doubt always be elusive, but some such legal boundary lines surely would be preferable to what is in effect an invisible fence on the current legal landscape.