July/August 2017
Volume 9 • Number 6

LANDSLIDE®

ABA A Publication of the ABA Section of Intellectual Property Law

CONTENTIOUS CONSTRUCTION

Does Language Fit into Copyright's Mold?

ALSO:

- Prosecuting Biotech Applications at the USPTO
- Copyright and Fair Use in Documentary Film
- IP Rights When Selling to the Government

PARODY PRODUCTS

WHEN SHOULD BRAND OWNERS "SMILE OR LAUGH" AND WHEN SHOULD THEY SUE?

By Jeffrey A. Kobulnick and Michael A. Bernet

After nearly a decade, it seems that Louis Vuitton still has not learned the meaning of the word "parody."[1] The Southern District of New York granted summary judgment in favor of My Other Bag, Inc. (MOB) earlier this year, dismissing the luxury handbag designer's trademark dilution, trademark infringement, and copyright infringement claims, finding that MOB's depiction of Louis Vuitton's marks and design on a tote bag was done in parody and thus constituted "fair use."[2] On December 22, 2016, the Second Circuit Court of Appeals affirmed the district court's ruling.[3]

Even before the appellate court's written opinion, the case came back into the spotlight when Louis Vuitton's counsel was reportedly laughed at by Second Circuit Judge Gerard E. Lynch during an extended oral argument into the meaning of the word "parody."[5] Louis Vuitton asked a three-judge panel to grant it a new trial on the theory that MOB did not intend to parody Louis Vuitton's marks, and thus the fair use defense could not apply.[6] During oral arguments, however, the panel seemed to disagree. "This is a joke. I understand you don't get the joke. But it's a joke," said Judge Lynch.[7]

The trial court's opinion in *Louis Vuitton v. My Other Bag* discusses in great length when the parody defense does *and* does not apply. This article examines that opinion, and offers insight into the parody defense in order to assist legal practitioners and business owners in evaluating potential claims. As succinctly stated by the court, "In some cases . . . it is better to 'accept the implied compliment in [a] parody' and to smile or laugh than it is to sue."[8]

The "Fair Use" Defense

Courts apply different tests to decide what constitutes fair use under copyright and trademark law. Fair use under copyright law involves the weighing of four statutorily delineated factors:

(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
(2) the nature of the copyrighted work;
(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
(4) the effect of the use upon the potential market for or value of the copyrighted work.[9]

Under trademark law, two doctrines of fair use have been recognized. The first is "classic" fair use, an affirmative defense set forth in the Lanham Act, where a trademark is not used as a mark but rather is used to describe the *defendant's* product or service.[10] The second is "nominative" fair use, a doctrine that has been adopted by several courts, where a trademark is used to reference the *plaintiff*.[11] Nominative fair use comprises three areas: (1) comparative advertisements,[12] (2) news reports and commentary,[13] and (3) noncommercial free speech[14] (otherwise known as the First Amendment defense), which further includes the parody defense, which was at issue in *My Other Bag*.

Significantly, as in *My Other Bag*, a commercial transaction involving the use of another's trademark will be considered noncommercial for fair use purposes if the use of the mark has a purpose beyond the commercial transaction, such as social commentary or criticism.[15] Additionally, to constitute nominative fair use in such quasi-commercial cases, (1) the use of the plaintiff's mark must be necessary to describe both the plaintiff's and the defendant's products, (2) the defendant may only use as much of the plaintiff's mark as is necessary to describe the plaintiff's product, and (3) the defendant's conduct must not imply that its product is sponsored by or affiliated with the plaintiff.[16]

My Other Bag's Zoey Tonal Brown Tote (Front)[4]

My Other Bag's Zoey Tonal Brown Tote (Back)

Jeffrey A. Kobulnick is a partner at Brutzkus Gubner in Los Angeles, California. He regularly litigates claims for copyright and trademark infringement and related claims under federal and state law, and extensively counsels and represents clients on the selection, clearance, and registration of trademarks and service marks worldwide. He can be reached at jkobulnick@bg.law. **Michael A. Bernet** is an associate at Brutzkus Gubner in Los Angeles, California. He practices in intellectual property and general civil litigation matters. He can be reached at mbernet@bg.law.

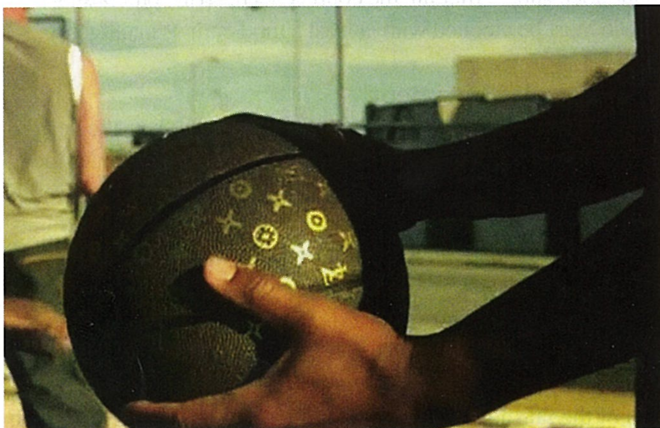
What Constitutes a Parody?

As the *My Other Bag* district court explained, with ironically heavy reliance on another highly publicized Louis Vuitton trademark loss from the Fourth Circuit,[17] a parody is "a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark's owner."[18] In order for the use of another's mark to constitute fair use, it "must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is *not* the original."[19] This generally may be accomplished by relying on some difference between the way in which the two marks are being used and communicating an "articulable element of satire, ridicule, joking, or amusement" that distinguishes them.[20] "In other words, a parody clearly indicates to the ordinary observer 'that the defendant is not connected in any way with the owner of the target trademark'" while simultaneously "poking fun at [the] trademark or the policies of its owner."[21]

A Parody Should Convey a Message about the Target Trademark or Its Owner

As demonstrated by the *My Other Bag* court, by distinguishing three well-known cases where the parody defense did not apply (including, interestingly, another Louis Vuitton case in the same court nearly three years prior), while not required, a parody should convey a message about the target trademark or its owner.[22] For instance, in *Louis Vuitton v. Hyundai*, the defendant aired a commercial after the 2010 Super Bowl that included "a four-second scene of an inner-city basketball game played on a lavish marble court with a gold hoop," and featured "a basketball bearing marks similar, but not identical, to the Louis Vuitton [Toile Monogram]."[23] Based on testimony from Hyundai representatives that indicated "the ad was only intended to make a 'broader social comment' about 'what it means for a product to be luxurious,'" and not some "critici[sm] or comment upon Louis Vuitton," the court found that the parody defense could not apply.[24]

Likewise, in *Dallas Cowboys v. Pussycat Cinema*, the parody defense was unavailable to the purveyor of the purportedly



Hyundai 2010 Super Bowl Commercial[25]

"gross and revolting" sex film *Debbie Does Dallas* because it did not have to use the Dallas Cowboys Cheerleaders' trademark in order to "comment on sexuality in athletics," but could have instead used any generic cheerleader uniform to make its professed point.[26] Additionally, in *Tommy Hilfiger v. Nature Labs*, where the defendant created a line of perfume products for pets "called [Timmy] Holedigger, which resembled a Tommy Hilfiger fragrance in name, scent, and packaging,"[27] the parody defense was unavailable because testimony of the defendant's general partner established that its product made no comment about Tommy Hilfiger but rather was intended as "a fun play on words" or "spoof . . . [t]o create enjoyment."[28]

Nature Lab's Timmy Holedigger Pet Perfume[30]

Debbie Does Dallas (1978)[29]

How Is "My Other Bag . . ." a Parody?

In the *My Other Bag* district court's view, MOB's use of Louis Vuitton's marks constituted parody for three reasons. First, it found MOB's bags a "play on the well-known 'my other car . . .' joke," and thus a joke about the social expectations of those who carry luxury or nonluxury handbags.[31] Second, MOB's "stylized, almost cartoonish renderings of Louis Vuitton's bags" helped build "significant distance between MOB's inexpensive workhorse totes and the expensive handbags they are meant to evoke."[32] And finally, "the image of exclusivity and refinery that Louis Vuitton has so carefully cultivated" was, at least in part, as MOB argued, "the brunt of the joke": "Whereas a Louis Vuitton handbag is something wealthy women may handle with reverent care and display to communicate a certain status, MOB's canvas totes are utilitarian bags 'intended to be stuffed with produce at the supermarket, sweaty clothes at the gym, or towels at the beach.'"[33]

It may seem interesting, given the court's discussion of *Hyundai* and *Dallas Cowboys*, that the court would consider the "my other car . . ." joke as a basis for parody because, as Louis Vuitton argued, "MOB could use any well-known luxury handbag brand to make its points" about the social expectations of luxury handbag purchasers.[34] In this instance, however, the court felt that the "my other car . . ." joke would not make any sense without the use of a widely recognized mark, such as Louis Vuitton's Toile Monogram, because it "would confusingly communicate only that 'my other bag . . . is some other bag.'"[35] In other words, because MOB could not communicate an amusing message about the social expectations of luxury handbag purchasers without using an actual luxury handbag maker's trademark or trade dress, the parody defense could apply.

Trademark Dilution by Blurring

Despite its conclusion that MOB's use of Louis Vuitton's trademarks constituted fair use under the Lanham Act, thereby disposing of all of Louis Vuitton's trademark claims, the district court went on to discuss Louis Vuitton's trademark dilution claims. The court concluded that even in the absence of fair

Louis Vuitton's trademark dilution claims (under federal and New York law) still failed because MOB's tote bags posed "no danger of impairing the distinctiveness of Louis Vuitton's marks."[36] In the court's view, MOB's comical tote bags would instead, if anything, "reinforce and enhance the distinctiveness and notoriety of the famous [Louis Vuitton] brand."[37] While that point seems debatable, the court was clearly correct in its decision, as it noted that in order to succeed on a claim of dilution by blurring,[38] a senior user (Louis Vuitton) must show that the junior user's (MOB's) use of a mark is likely to blur the ability of consumers to "clearly and unmistakably distinguish" one user as the source of the goods.[39]

As the court stated, "it is not enough to show . . . that members of the public are likely to 'associate' the [junior user's] mark with the [senior user's] mark."[40] Rather, it must be shown that the junior user is using the senior user's mark as a "designation of source for its own goods."[41] Because MOB seemingly did not use Louis Vuitton's trademarks in order to indicate that it (MOB) was the source of its own tote bags, but rather to poke fun at Louis Vuitton, MOB could not be liable for dilution by blurring as a matter of law.[42]

Interestingly, the court reached this conclusion by relying heavily on another well-known Louis Vuitton loss from the Fourth Circuit, *Louis Vuitton v. Haute Diggity Dog*. In that case, the parody defense applied and Louis Vuitton's trademark dilution by blurring claim failed, despite the fact that the defendant—a manufacturer of plush dog chew toys resembling Louis Vuitton handbags prominently labeled "Chewy Vuiton"—used a variation of Louis Vuitton's Toile Monogram to indicate that it (Haute Diggity Dog) was the source of its own goods.[43]

It may appear, at least with respect to the trademark dilution claims, that the *My Other Bag* and *Haute Diggity Dog* opinions are inconsistent, because the defendant in *Haute Diggity Dog* used Louis Vuitton's Toile Monogram as an indicator of source for its own goods, while the defendant in *My Other Bag* did not,[45] and neither was found liable for dilution. This distinction is reconciled by the fact that MOB was statutorily exempt from liability for dilution because it did not use Louis Vuitton's marks as an indicator of source, whereas Haute Diggity Dog *could* have been liable, but ultimately was not because the court found that the application of the statutorily delineated dilution factors weighed in its favor.[46] As noted in *My Other Bag*, where a junior user parodies a senior user's mark as an indicator of source for its own goods, in cases such as *Haute Diggity Dog*, the existence of a parody typically influences the dilution analysis in favor of the defendant.[47] The more famous the mark being parodied, the higher the senior user's burden becomes to establish blurring.[48]

Haute Diggity Dog's Chewy Vuiton Purse (White)[44]

Trademark Infringement

Similar to trademark dilution claims, the existence of a parody influences the analysis of the relevant trademark infringement factors[49] and typically leans the analysis in favor of the defendant.[50] This is especially true with more "successful" parodies that inherently communicate they are not associated with a senior user and thus reduce likelihood of consumer confusion[51]—the keystone of trademark infringement claims.[52] Such was the case with *My Other Bag*, where the court concluded, after weighing the *Polaroid* factors,[53] that there was "no credible risk that a reasonably prudent consumer would think Louis Vuitton 'sponsored or otherwise approved' of MOB's totes."[54]

Reasoning through the first two *Polaroid* factors—the strength and similarity of the marks—the court determined that although Louis Vuitton's and MOB's marks were obviously similar, the context of MOB's bags as a whole and their cartoonish renderings more than adequately separated them from Louis Vuitton in the minds of consumers.[55] Further, the next two *Polaroid* factors—the proximity of the goods and likelihood of expansion—also weighed against a likelihood of confusion due to the incredible distance in price, marketplaces, and intended uses for the bags.[56] With respect to the fifth factor—evidence of actual confusion—the court was not persuaded by the "handful of instances" of alleged consumer confusion submitted by Louis Vuitton, finding them not credible and taken out of context.[57]

The sixth *Polaroid* factor—the defendant's "bad faith" in selecting the mark—also did not weigh in Louis Vuitton's favor, because in the context of parody, the fact that a defendant intentionally selected the plaintiff's mark "does not show that defendant acted with the intent relevant in trademark cases—that is, an intent to capitalize on consumer deception or hitch a free ride on plaintiff's good will."[58] In parody, the defendant's intent is simply to amuse, and Louis Vuitton failed to demonstrate that MOB intended otherwise.[59] The court also found that the quality of Louis Vuitton's and MOB's bags were so apparently different that the seventh *Polaroid* factor weighed in neither direction.[60] And finally, the court concluded that the eighth *Polaroid* factor—consumer sophistication and degree of consumer care—weighed decidedly against Louis Vuitton as even a "minimally prudent customer would not be confused" as a result of the "gimmick" and giant price gap.[61] After all, the court echoed, "[t]he purchasing public must be credited with at least a modicum of intelligence."[62]

Copyright Infringement

Despite qualifying as "fair use" under trademark law, the designs printed on MOB's tote bags also had to be evaluated under the Copyright Act's separate fair use test using the four factors set forth above.[63] Unlike trademark law, copyright law does not presume commercial use.[64] Under copyright law, "not all parody is protected; instead, parody, 'like any other use, has to work its way through the relevant factors.'"[65] In parody cases, where a copyright infringement claim is used to pursue "what is at its core a trademark [or] trade dress infringement claim, application of the fair-use factors . . . is awkward" but feasible.[66] In such cases, similar to trademark dilution and infringement claims, the existence of the parody will typically lean the analysis in favor of the defendant, even if it is being used for commercial gain.[67]

In concluding that the first fair use factor—the purpose and character of the use—did not weigh in Louis Vuitton's favor, the court tersely stated that "although commercial use 'tends to weigh against a finding of fair use,' it is not presumptively unfair.

Parody, even when done for commercial gain, can be fair use."[68] In the court's view, the second factor—the nature of the copyrighted work—also weighed against Louis Vuitton "since parodies almost invariably [must] copy publicly known, expressive works" in order to be understood.[69] Similarly, the court concluded that the third factor—the amount and substantiality of the copyrighted work used—weighed in MOB's favor because "MOB's totes must successfully conjure Louis Vuitton's handbags in order to make sense."[70] And finally, the court concluded that the fourth and perhaps most important factor—the potential effect on the market—also weighed in favor of fair use as it correctly found that tote bags do not serve as a market replacement for luxury handbags, even though they occupy the same market "in an abstract sense."[71]

Conclusion

It can be difficult for any brand owner to see someone else using its intellectual property for his or her commercial gain. Nevertheless, as the *My Other Bag* opinions demonstrate, true parody is still a defense to trademark and copyright claims. Intellectual property rights are not without limits, particularly when conflicting with fair use principles consistent with the First Amendment. As Louis Vuitton has learned several times, only the judge needs to understand the joke, even if the intellectual property rights owner does not. The lesson here is that before brand owners initiate costly litigation against what could very well be protected as a parody, they should consider other creative means to resolve their concerns, or simply accept the implied compliment and laugh it off. This is particularly true for owners of famous marks, as they are more likely to be parodied and less likely to result in confusion. On the other hand, if the joke is truly subtle and there is a real risk of consumer confusion, legal action may be warranted. ■

Endnotes

1. *See* Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 258 (4th Cir. 2007).
2. Louis Vuitton Malletier, S.A. v. My Other Bag, Inc., 156 F. Supp. 3d 425 (S.D.N.Y. 2016).
3. Louis Vuitton Malletier, S.A. v. My Other Bag, Inc., No. 16-241-cv (2d Cir. Dec. 22, 2016).
4. *Zoey – Tonal Brown*, My Other Bag . . ., https://www.myotherbag.com/products/zoey-tonal-browns (last visited May 21, 2017).
5. Pete Brush, *2nd Circ. Judge Ready to Laugh Louis Vuitton Out of Court*, Law360 (Dec. 7, 2016), https://www.law360.com/articles/870208.
6. *See id.*
7. *Id.*
8. *My Other Bag*, 156 F. Supp. 3d at 445 (alteration in original).
9. 17 U.S.C. § 107.
10. *See In re* Dual-Deck Video Cassette Recorder Antitrust Litig., 11 F.3d 1460 (9th Cir. 1993) (holding that "VCR-2" input label on video receiver to which two videocassette recorders could be attached did not infringe the plaintiff's "VCR-2" trademark for two-deck videocassette recorders, because the defendant's use was merely descriptive of its own product). *But see* Horphag Research Ltd. v. Pellegrini, 337 F.3d 1036 (9th Cir. 2003) (finding classic fair use defense unavailable to website operator who used the plaintiff's trademark in meta-tags to advertise and sell competing pharmaceutical products).
11. *See* New Kids on the Block v. News Am. Publ'g, Inc., 971 F.2d 302, 308 (9th Cir. 1992). Examples of nominative fair use include a cleaning product that is advertised as being twice as effective as some other well-known cleaning product, and an imitation perfume that is advertised as smelling like some other more expensive perfume. *See* Smith v. Chanel, Inc., 402 F.2d 562, 565 (9th Cir. 1968); *see also* Toyota Motor Sales, U.S.A., Inc. v. Tabari, 610 F.3d 1171, 1179 (9th Cir. 2010) (considering Internet domains "buy-a-lexus.com" and "buyorleaselexus.com," operated by brokers who specialized in soliciting bids for Lexus automobiles, nominative fair use because each "site as a whole [did] not suggest sponsorship or endorsement by the trademark holder"). The Second Circuit only recently recognized the nominative fair use defense, but in contrast to the Ninth Circuit, held that it is not an affirmative defense to trademark infringement claims. *See* Int'l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC, 823 F.3d 153, 167 (2d Cir. 2016), *cert. denied*, 137 S. Ct. 624 (2017).
12. *See* 15 U.S.C. § 1125(c)(3)(A)(i); *Chanel*, 402 F.2d at 565.
13. *See* 15 U.S.C. § 1125(c)(3)(B).
14. *See id.* § 1125(c)(3)(C).
15. Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 906 (9th Cir. 2002).
16. *Int'l Info. Sys.*, 823 F.3d at 168; Swarovski Aktiengesellschaft v. Bldg. No. 19, Inc., 704 F.3d 44, 50 (1st Cir. 2013); Century 21 Real Estate Corp. v. LendingTree, Inc., 425 F.3d 211, 220 (3d Cir. 2005); *New Kids on the Block*, 971 F.2d at 308.
17. Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252 (4th Cir. 2007).
18. Louis Vuitton Malletier, S.A. v. My Other Bag, Inc., 156 F. Supp. 3d 425, 434 (S.D.N.Y. 2016) (quoting *Haute Diggity Dog*, 507 F.3d at 260).
19. *Id.* (quoting Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc., 886 F.2d 490, 494 (2d Cir. 1989)).
20. *See id.* at 434–35.
21. *Id.* at 435 (quoting 6 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 31:153 (4th ed. 2015)).
22. *Id.* at 435–38 (discussing Louis Vuitton Malletier, S.A. v. Hyundai Motor Am., No. 10-CV-1611 (PKC), 2012 WL 1022247, at *1 (S.D.N.Y. Mar. 22, 2012); Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, 415 (S.D.N.Y. 2002); and Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200 (2d Cir. 1979)); *see* 15 U.S.C. § 1125(c)(3)(A)(ii).
23. *Hyundai*, 2012 WL 1022247, at *1.
24. *Id.* at *17.
25. Alison Gendar, *Luxury Fashion House Louis Vuitton Sues Automaker Hyundai for Using Its Logo in Super Bowl Ad*, N.Y. Daily News (Mar. 1, 2010), http://www.nydailynews.com/news/money/luxury-fashion-house-louis-vuitton-sues-automaker-hyundai-logo-super-bowl-ad-article-1.171249.
26. *Dallas Cowboys*, 604 F.2d at 206. It is worth considering that if the professed comment was not about sexuality in athletics generally, but sexuality with regard to the Dallas Cowboys Cheerleaders in particular, then the parody defense may have applied.
27. *My Other Bag*, 156 F. Supp. 3d at 437.
28. Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, 415 (S.D.N.Y. 2002) (alteration in original).
29. Debbie Does Dallas, Wikipedia, https://en.wikipedia.org/wiki/Debbie_Does_Dallas (last edited May 1, 2017).

Continued on page 64

Continued from page 23

30. *Nature Labs Timmy Holedigger Cologne–4oz Spray*, Pet-Agree Grooming Supplies, http://www.petagree.net/store/p/69-Nature-Labs-Timmy-Holedigger-Cologne-4oz-Spray.aspx (last visited May 21, 2017).

31. *See My Other Bag*, 156 F. Supp. 3d at 435; *see also id.* at 430 ("MOB's totes—indeed, its very name—are a play on the classic 'my other car . . .' novelty bumper stickers, which can be seen on inexpensive, beat up cars across the country informing passersby—with tongue firmly in cheek—that the driver's 'other car' is a Mercedes (or some other luxury car brand). The 'my other car' bumper stickers are, of course, a joke—a riff, if you will, on wealth, luxury brands, and the social expectations of who would be driving luxury and non-luxury cars. MOB's totes are just as obviously a joke, and one does not necessarily need to be familiar with the 'my other car' trope to get the joke or to get the fact that the totes are meant to be taken in jest.").

32. *Id.* at 435.

33. *Id.* Interestingly, this citation to MOB's memorandum in support of a motion for summary judgment was taken from its argument in support of a parody defense under the Copyright Act. On appeal, the Second Circuit agreed that MOB's use was a parody, and that judgment should be granted in its favor on the trademark infringement claim: "Specifically, obvious differences in MOB's mimicking of LV's mark, the lack of market proximity between the products at issue, and minimal, unconvincing evidence of consumer confusion compel a judgment in favor of MOB on LV's trademark infringement claim. Accordingly, we affirm this part of the summary judgment award to MOB." Louis Vuitton Malletier, S.A. v. My Other Bag, Inc., No. 16-241-cv (2d Cir. Dec. 22, 2016).

34. *My Other Bag*, 156 F. Supp. 3d at 437.

35. *Id.*

36. *Id.* at 438.

37. *Id.* at 445.

38. There are two types of trademark dilution claims: (1) dilution by blurring, and (2) dilution by tarnishment. *See* 15 U.S.C. § 1125(c). Dilution by blurring occurs where a junior user "impairs the distinctiveness" of the senior user's mark. *Id.* § 1125(c)(2)(B). Dilution by tarnishment occurs where a junior user "harms the reputation" of the senior user. *Id.* § 1125(c)(2)(C).

39. *My Other Bag*, 156 F. Supp. 3d at 438 (quoting Hormel Foods Corp. v. Jim Henson Prods., Inc., 73 F.3d 497, 506 (2d Cir. 1996)).

40. *Id.* at 439.

41. *Id.* (citing Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 266 (4th Cir. 2007)).

42. *Id.*; 15 U.S.C. § 1125(c)(3)(A) ("Any fair use . . . of a famous mark by another person other than as a designation of source for the person's own goods" "shall not be actionable as dilution by blurring.").

43. *My Other Bag*, 156 F. Supp. 3d at 439.

44. *Chewy Vuiton Purse (White)*, Haute Diggity Dog, http://www.hautediggitydog.com/products/white-chewy-vuiton-purse (last visited May 21, 2017).

45. *Haute Diggity Dog*, 507 F.3d at 266 (used as indicator of source); *My Other Bag*, 156 F. Supp. 3d at 440 (not used as indicator of source).

46. *See Haute Diggity Dog*, 507 F.3d at 266–68.

47. *My Other Bag*, 156 F. Supp. 3d at 439–40; *see Haute Diggity Dog*, 507 F.3d at 266–68.

48. *Haute Diggity Dog*, 507 F.3d at 267.

49. In contrast to a trademark dilution analysis, which is guided by statutorily delineated factors, *see* 15 U.S.C. § 1125(c), a trademark infringement analysis is guided by judicially created factors. Circuit courts employ different, albeit very similar, multifactor tests to determine whether trademark infringement has occurred. *See, e.g.*, Pizzeria Uno Corp. v. Temple, 747 F.2d 1522 (4th Cir. 1984); AMF Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979); Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492 (2d Cir. 1961).

50. *See Haute Diggity Dog*, 507 F.3d at 261–63; *My Other Bag*, 156 F. Supp. 3d 425 at 440–41; Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, 415–21 (S.D.N.Y. 2002). *But see* N.Y. Yankees P'ship v. IET Prods. & Servs., Inc., No. 91189692 (T.T.A.B. May 6, 2016) (rejecting parody defense as basis for obtaining trademark registration).

51. *See My Other Bag*, 156 F. Supp. 3d at 441 (citing *Tommy Hilfiger*, 221 F. Supp. 2d at 420).

52. *See* 15 U.S.C. § 1114(1); KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 117 (2004).

53. *See Polaroid*, 287 F.2d 492; *see also* Star Indus., Inc. v. Bacardi & Co., 412 F.3d 373, 384 (2d Cir. 2005) ("The eight factors are: (1) strength of the trademark; (2) similarity of the marks; (3) proximity of the products and their competitiveness with one another; (4) evidence that the senior user may 'bridge the gap' by developing a product for sale in the market of the alleged infringer's product; (5) evidence of actual consumer confusion; (6) evidence that the imitative mark was adopted in bad faith; (7) respective quality of the products; and (8) sophistication of consumers in the relevant market.").

54. *My Other Bag*, 156 F. Supp. 3d at 425.

55. *See id.* at 441.

56. *See id.* at 442 ("[Louis Vuitton's] handbags cost hundreds, if not thousands of dollars, and are 'sold exclusively in Louis-Vuitton owned stores and on the e-commerce website, www.louisvuitton.com.' By contrast, MOB's totes are sold on its website, www.myotherbag.com, and retail for only between thirty and fifty-five dollars." (citation omitted)).

57. *Id.*

58. *Id.* at 443 (quoting Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, 419 (S.D.N.Y. 2002)).

59. *See id.* (citing Jordache Enters., Inc. v. Hogg Wyld, Ltd., 828 F.2d 1482, 1486 (10th Cir. 1987)).

60. *Id.*

61. *See id.*

62. *Id.* (quoting *Tommy Hilfiger*, 221 F. Supp. 2d at 420).

63. *See id.* at 444–45.

64. *Compare* 17 U.S.C. § 102 (matters subject to copyright), *with* 15 U.S.C. § 1127 (definition of trademark).

65. *My Other Bag*, 156 F. Supp. 3d at 444.

66. *See id.*

67. *See id.* at 444–45.

68. *Id.* (citation omitted) (quoting Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 562 (1985)).

69. *Id.* at 445 (quoting Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 586 (1994)).

70. *Id.*

71. *Id.* ("Indeed . . . any reasonable observer would grasp that the whole point of MOB's invocation of the 'my other car . . .' trope is to communicate that MOB's totes are *not* replacements for Louis Vuitton's designer handbags." (citing Cariou v. Prince, 714 F.3d 694, 707 (2d Cir. 2013))).