

The Second Circuit Gets the Joke – Affirms Dismissal of Trademark Parody Lawsuit

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Last January, we [blogged](#) about a district court decision involving trademark parody in *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.* In that decision, the court held that defendant My Other Bag had convincingly argued that its products, shown below, were a parody of Louis Vuitton's iconic handbag and, as such, did not violate Louis Vuitton's trademark and copyright rights. Granting summary judgment to My Other Bag, the district judge commented that Louis Vuitton perhaps "cannot take a joke" and observed that "in some cases, it is better to 'accept the implied compliment in a parody' and to smile or laugh than it is to sue."

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The Second Circuit Court of Appeals got the joke, issuing a [Summary Order](#) on December 22, 2016 affirming the district court's decision in favor of My Other Bag. This result was not a surprise, as it was reported that at oral argument, one of the appellate judges had laughed at an argument advanced by Louis Vuitton's counsel, saying "This is a joke. I understand you don't get the joke. But it's a joke."

Turning to the merits of the legal arguments, the Second Circuit agreed that the My Other Bag tote bag qualified under the parody defense to a trademark dilution claim. The bags mimicked Louis Vuitton's designs in a way that was recognizable, but still a "conscious departure" from Louis Vuitton's luxury image. Accordingly, it was clear that My Other Bag was not a real Louis Vuitton handbag. Further "the fact that the joke on LV's luxury image is gentle, and possibly even complimentary to LV, does not preclude it from being a parody." The court distinguished other cases in which the parody defense to a dilution claim was rejected where the defendant had used the plaintiff's trademark as a designation of source to sell its goods. Here, My Other Bag was the "undisputed designation of source." The appellate court also affirmed summary judgment on Louis Vuitton's New York state law dilution claim, holding that even though the New York dilution statute "does not provide an explicit fair use defense, the manifest parodic use here precludes the requisite finding that the marks are "substantially similar" for purposes of prevailing on the state law dilution claim.

The Second Circuit also affirmed the dismissal of the trademark infringement claim, holding that under a deferential or a *de novo* standard of review, obvious differences between the marks, the lack of market proximity between the products at issue and "minimal, unconvincing evidence of consumer confusion" compel a judgment in favor of My Other Bag.

Finally, the appellate court affirmed the district court's holding that the My Other Bag tote bag did not constitute copyright infringement. The parodic use of Louis Vuitton's designs was found to constitute a "transformative" use as a new expression and message, and the remaining fair use factors under the Copyright Act either weighted in favor of My Other Bag or were deemed irrelevant.

The message of this case, in both the district court and Second Circuit opinions, is that brand owners may not like trademark parodies, but depending on how their marks are presented on the parody products, it can be very difficult to do anything about it under a trademark or copyright theory of intellectual property protection.