

Honey Badger Don't Care, but the Legal Community Does

Did the Ninth Circuit Miss the 'Mark' in Sending the Honey Badger Trademark Case to Trial?

by Sara Gold

Introduction

The “Honey Badger” became a pop culture sensation in 2011 when a man named Christopher Gordon, using the pseudonym Randall, added his voiceover commentary to National Geographic footage of a badger foraging for live animals in its natural habitat.¹ The roughly three-minute YouTube video now has nearly 90 million views and over 40,000 comments.² Gordon’s mock-umentary popularized the catchphrase “honey badger don’t care,” making it a “cultural icon” and “viral sensation.”³ Between 2013 and 2016, Gordon acquired five different federal trademark registrations for the phrase in connection with a variety of goods, including clothing, toys, mugs, mobile phone applications, and bumper stickers.⁴ His licensees sell over 9,000 Honey Badger-themed items, including greeting cards, at major retailers like Wal-Mart, Target, and Urban Outfitters.⁵ Even celebrities like Taylor Swift and Anderson Cooper have quoted his video narration, which he registered with the U.S. Copyright Office.⁶ He has appeared on television news

¹ Antonia Noori Farzan, *Honey Badger May Not Care, But The Creative Genius Who Took It Viral Just Won a Big Victory*, WASH. POST (Aug. 1, 2018), https://www.washingtonpost.com/news/morning-mix/wp/2018/08/01/honey-badger-may-not-care-but-the-creative-genius-who-took-him-viral-just-won-a-big-victory/?utm_term=.bc7c2be65d6a.

² For the original YouTube video, see czg123, *The Crazy Nastyass Honey Badger (original narration by Randall)*, YOUTUBE (Jan. 18, 2011), <https://www.youtube.com/watch?v=4r7wHMg5Yjg>.

³ See Farzan, *supra* note 1; Scott Alan Burroughs, *Honey Badger and Intersection Between Trademark Law and Free Speech*, ABOVE THE LAW (Aug. 1, 2018, 1:42 PM), <https://abovethelaw.com/2018/08/honey-badger-and-the-intersection-between-trademark-law-and-free-speech/>.

⁴ Currently all five registrations are active and are being used in commerce. See the Trademark Electronic Search System (TESS) results for “honey badger don’t care.”

⁵ Two of the best-selling cards say “Honey Badger Don’t Care About Your Birthday.” *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 262 (9th Cir. 2018); Farzan, *supra* note 1.

⁶ *Gordon*, 909 F.3d at 261–62.

programs, and his book, *Honey Badger Don't Care: Randall's Guide to Crazy, Nastyass Animals*, is available from Amazon and other booksellers.⁷

The trademark controversy arose in 2015 when Gordon sued on behalf of a non-licensed greeting card use.⁸ Gordon has a federally registered “honey badger don’t care” trademark associated with International Class 16, which includes stationary.⁹ Back in 2012, American Greetings, the parent company of the defendants, was in talks with Gordon to license his trademark for greeting cards, but they did not reach an agreement.¹⁰ Nonetheless, the defendants started selling one greeting card with “Honey Badger and me just don’t care,” as well as six cards with a related Honey Badger catchphrase, “honey badger don’t give a s---.”¹¹ This related catchphrase is also well-known and was featured in Gordon’s original video, but he does not have a federally registered trademark for it.¹²

Gordon filed a trademark infringement lawsuit in the U.S. District Court for the Central District of California. The defendants claimed that their use was fully protected under the First

⁷ Gordon also collaborated on a Honey Badger television project that never materialized. See Julia Borcherts, *Ew! It's So Nasty!*, REDEYE (Jan. 25, 2012, 5:05 PM), <https://www.chicagotribune.com/redeye/redeye-web-sensation-randall-talks-honey-badger-spinoffs-anonymity-and-wildlife-sex-20120125-story.html>; Farzan, *supra* note 1. For video coverage, see MSNBC, *Viral Honey Badger Video Creator: Donald Trump Is No Honey Badger – The Beat with Ari Melber – MSNBC*, YOUTUBE (Aug. 7, 2018), <https://www.youtube.com/watch?v=oNgJjulJtVM; czg123, Honey Badger's Randall: Randall's Guide to Crazy Nastyass Animals – Get It Now!!!>, YOUTUBE (Jan. 13, 2012), <https://www.youtube.com/watch?v=oL5LKYi1mKU&feature=youtu.be>.

⁸ *Gordon*, 909 F.3d at 263.

⁹ Appellees’ Petition for Panel Rehearing and Rehearing En Banc at 2, *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184 (9th Cir. 2018) (No. 16-56715) [hereinafter Petition for Rehearing]; *The Remarkable Honey Badger Does Give a Sh!t*, MAD DOG PAC (Aug. 4, 2018), <https://maddogpac.com/blogs/spicy-files/the-remarkable-honey-badger-does-give-a-sh-t?fbclid=IwAR2UIUNfIdMp61-x6b5UUWfBWU4inkDaHvwzV-IOh3HDxgeEKQsr2vD2AHk>.

¹⁰ *Gordon*, 909 F.3d at 262.

¹¹ *Id.* at 262–63.

¹² Until December 2017, Lanham Act § 2(a) prohibited federal registration for “immoral” trademarks, i.e. marks incorporating cuss words or profanity. See Dennis Crouch, *Honey Badger Don't Care: Protecting Creativity with Trademarks*, PATENTLY-O (Aug. 24, 2018), <https://patentlyo.com/patent/2018/08/protecting-creativity-trademarks.html>; see also *In re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017) (invalidating the Lanham Act’s immorality clause because it violated the First Amendment right to free speech), *cert. granted*, 2019 WL 98541 (U.S. Jan. 4, 2019) (No. 18-302).

Amendment, and the district court granted summary judgment for the defendants.¹³ The Court held that *Rogers v. Grimaldi*—the seminal case protecting expressive uses of trademarks in art—barred the infringement claim as a matter of law.¹⁴ In July 2018, the Ninth Circuit reversed summary judgment, holding there were triable issues as to whether the defendants’ greeting cards passed the *Rogers* test.¹⁵ This was the first time the Ninth Circuit had ever rejected summary judgment in a case applying *Rogers*.¹⁶ The decision evoked considerable criticism: the defendants submitted a petition for rehearing, and thirty-seven well-respected trademark professors wrote a collective amicus brief supporting rehearing and criticizing the Ninth Circuit’s rationale.¹⁷ The Court accepted rehearing and in November 2018 released an updated opinion retaining the same conclusion but with a modified rationale.¹⁸

We have yet to see how this case will turn out on remand, but regardless of the ultimate outcome, this “must-see trademark litigation” raises important concerns about how to achieve a balance between free speech and brand exploitation.¹⁹ Part I overviews the evolution of the *Rogers* test. Part II summarizes the Ninth Circuit’s ruling in the Honey Badger case, *Gordon v. Drape Creative, Inc.* Part III evaluates scholarly reactions to the ruling as well as the decision’s broader implications for trademark law and free speech. This Article concludes that while the public’s right to free expression is important, the free-speech rights of trademark owners are equally important

¹³ *Gordon*, 909 F.3d at 263.

¹⁴ *Id.* at 260.

¹⁵ *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184, 1187 (9th Cir. 2018).

¹⁶ *Id.* Law360 even named this case as one of the top 10 trademark rulings of 2018. Bill Donahue, *Top 10 Trademark Rulings of 2018*, LAW360 (Dec. 13, 2018, 2:23 PM), <https://www.law360.com/articles/1107943/top-10-trademark-rulings-of-2018>.

¹⁷ “The decision raised eyebrows for some trademark attorneys, due to what it said about the careful balance courts have struck between the speech restrictions imposed by the Lanham Act and speech rights granted by the First Amendment.” Bill Donahue, *3 Trademark Cases to Watch in 2019*, LAW360 (Jan. 1, 2019), <https://www.law360.com/articles/1108751/3-trademark-cases-to-watch-in-2019>. See also Crouch, *supra* note 12.

¹⁸ Porter Wells, *‘Honey Badger’ Trademark Must Go to Trial*, BLOOMBERG (Nov. 20, 2018), <https://www.bna.com/honey-badger-trademark-n57982094071/>.

¹⁹ Donahue, *supra* note 17.

to protect. Allowing infringement cases to proceed to trial does not necessarily compromise free speech, and while dismissal via summary judgment may be appropriate in some instances, this was a borderline case complicated enough to merit a jury trial.

I. Evolution of the *Rogers* Test

Rogers v. Grimaldi (1989) sets forth the test circuit courts commonly use to assess a First Amendment defense when an alleged Lanham Act violation occurs within an artistic work—including but not limited to film/TV, books, music, and visual art.²⁰ Ginger Rogers sued the producer of *Ginger and Fred*, an Italian film about two dancers meant to resemble Rogers and her famous co-star Fred Astaire.²¹ She alleged that the film’s title falsely suggested her endorsement in violation of Lanham Act § 43(a), the same federal statute that prohibits trademark infringement.²² The district court granted summary judgment for the defendant, holding that the First Amendment prevailed because the film constituted artistic expression and was not primarily commercial in nature.²³ On appeal, the Second Circuit affirmed summary judgment but, noting the danger of an unqualified First Amendment defense, created a case-by-case test to determine whether “the public interest in avoiding consumer confusion outweighs the public interest in free expression.”²⁴ *Rogers* held that when a work’s title creates Lanham Act concerns, the First Amendment supersedes as long as the title (1) has “artistic relevance” to the work as a whole, and (2) does not “explicitly mislead” as to the content or source of the work.²⁵

²⁰ In addition to the Second Circuit, the *Rogers* test is now used by the Fifth, Sixth, and Eleventh Circuits. See Daniel Jacob Wright, *Explicitly Explicit: The Rogers Test and the Ninth Circuit*, 21 J. INTELL. PROP. L. 193, 203 (2013); Anthony Zangrillo, *The Split on the Rogers v. Grimaldi Gridiron: An Analysis of Unauthorized Trademark Use in Artistic Mediums*, 27 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 385, 385 (2017).

²¹ *Rogers v. Grimaldi*, 875 F.2d 994, 996–97 (2d Cir. 1989).

²² She also alleged state-law violations of false light and right of publicity. *Id.* at 997. See 15 U.S.C. § 1125(a)(1)(A) (prohibiting misrepresentation of “sponsorship” or “approval”).

²³ *Rogers v. Grimaldi*, 695 F. Supp. 112, 120–21 (S.D.N.Y. 1988).

²⁴ *Rogers*, 875 F.2d at 999.

²⁵ *Id.*

Prior to *Gordon v. Drape Creative*, the Ninth Circuit applied the two-pronged *Rogers* test in five cases involving trademark infringement or right of publicity claims.²⁶ The Court affirmed summary judgment in all five cases, finding that the allegedly infringing uses were First Amendment-protected as a matter of law.²⁷ These cases established that (1) very little artistic contribution is needed to meet the “artistic relevance” prong, and (2) only seriously egregious misrepresentations are considered explicitly misleading.

The Ninth Circuit first used the *Rogers* test in two trademark infringement cases, *Mattel, Inc. v. MCA Records, Inc. (2002)* and *Mattel, Inc. v. Walking Mountain Productions, Inc. (2003)*.²⁸ In *MCA Records*, Mattel sued the music companies that produced Aqua’s “Barbie Girl” song.²⁹ The song features a high-pitched female voice as “Barbie” and a deep masculine voice as “Ken,” with lyrics such as “I’m a blonde bimbo girl in a fantasy world” and “Come on Barbie, let’s go party.”³⁰ As the Court noted, the song “lampoons the Barbie image and comments humorously on the cultural values Aqua claims she represents.”³¹ Applying *Rogers*, the Court held that the “Barbie Girl” title was artistically relevant to the song itself, which pokes fun at how Barbies sexualize and degrade women.³² As to explicit misleadingness, the Court held the song title did not explicitly mislead the public as to the content’s source, for “we expect a title to describe the underlying work, not to identify the producer, and Barbie Girl does just that.”³³ Accordingly,

²⁶ *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 265–68 (9th Cir. 2018).

²⁷ *Id.* at 265.

²⁸ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.2d 894 (9th Cir. 2002); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

²⁹ *MCA Records*, 296 F.2d at 899.

³⁰ *Id.* at 899, 909. For the full Aqua music video, see AquaVEVO, *Aqua – Barbie Girl*, YOUTUBE (Aug. 20, 2010), <https://www.youtube.com/watch?v=ZyhrYis509A>.

³¹ *MCA Records*, 296 F.2d at 907.

³² *Id.* at 902.

³³ The Court also noted that if the mere inclusion of the Barbie trademark in the song title were construed as explicit misleadingness, the purpose of the *Rogers* test would be moot. *Id.* at 901–02.

the Court affirmed summary judgment for the defendants.³⁴ Similarly in *Walking Mountain Productions*, the Court affirmed summary judgment for the photographer behind “Food Chain Barbie,” a photograph collection of nude Barbie dolls being endangered by household appliances.³⁵ The title was artistically relevant because it described the subject of the photos in a way while commenting on Barbie’s cultural significance, and it did not explicitly mislead the public into believing Mattel sponsored the photos.³⁶

The Ninth Circuit has since broadened *Rogers*’ application beyond just titles of artistic works.³⁷ In *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc. (2008)*, the Play Pen strip club in Los Angeles sued the makers of a video game set in a fictionalized Los Angeles designed to mimic the city’s real-life geography.³⁸ The game included a virtual strip club called the “Pig Pen.”³⁹ The Play Pen alleged trademark infringement because the game’s “Pig Pen” recognizably resembled the real-life Play Pen, despite some visual differences between the virtual and real-life versions.⁴⁰ The Play Pen argued that the game’s cartoonish depiction of the strip club was not artistically relevant to the game as a whole for two reasons. First, the game depicted thousands of real-life locations in Los Angeles, San Francisco, and Las Vegas, making the “Pig Pen” relatively insignificant; second, the Play Pen was not a “cultural icon” like Barbie, which the Ninth Circuit had previously allowed artistic references to.⁴¹ Rejecting both arguments, the Ninth Circuit emphasized that to be artistically relevant, the relevance “merely must be above zero.”⁴² The Court

³⁴ *Id.* at 902.

³⁵ *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 796 (9th Cir. 2003).

³⁶ *Id.* at 806.

³⁷ *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 267 (9th Cir. 2018).

³⁸ *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1097 (9th Cir. 2008).

³⁹ *Id.*

⁴⁰ *Id.* at 1097–98.

⁴¹ *Id.* at 1097, 1100.

⁴² *Id.* at 1100.

held that although the “Pig Pen” may have been one of thousands of virtual locations in the game, the game’s artistry derived from its verisimilitude to the real-life regions.⁴³ Including the “Pig Pen” was artistically relevant to that goal, which relied on the (admittedly negligible) cultural significance of the Play Pen as an establishment in East Los Angeles.⁴⁴ The Court further explained that the virtual “Pig Pen” was not explicitly misleading because “a reasonable consumer would not think a company that owns one strip club in East Los Angeles, which is not well known to the public at large, also produces a technologically sophisticated video game.”⁴⁵ Ultimately, the Ninth Circuit affirmed summary judgment because the “Pig Pen” passed the *Rogers* test and thus was First Amendment-protected against an infringement claim.

In its next two rulings based on *Rogers*, the Ninth Circuit applied the “more than zero” artistic relevance standard from *E.S.S. Entertainment*. In ***Brown v. Electronic Arts, Inc. (2013)***, a right of publicity case resembling *E.S.S.*, NFL football player Jim Brown sued the maker of a sports video game featuring the likenesses of thousands of NFL players.⁴⁶ The Court affirmed summary judgment, finding that the use of Brown’s likeness passed the *Rogers* test.⁴⁷ For the same reasons as in *E.S.S.*, the use of Brown’s likeness had “at least some artistic relevance” to the goal of creating a realistic sports game.⁴⁸ As to the second *Rogers* prong, an artistic work is non-infringing as long as it is not *explicitly* misleading, for “the slight risk that the use of a celebrity’s name might implicitly suggest endorsement or sponsorship to some people is outweighed by the danger of restricting artistic expression.”⁴⁹ Thus, even if there were evidence that game players

⁴³ *Id.*

⁴⁴ *Id.*

⁴⁵ *Id.* at 1100–01.

⁴⁶ *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239, 1243 (9th Cir. 2013).

⁴⁷ *Id.* at 1239.

⁴⁸ *Id.* at 1243.

⁴⁹ *Id.* at 1245 (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989)).

mistakenly believed Brown endorsed the game, that would not necessarily mean the game was *explicitly* misleading.⁵⁰ This prong focuses not on actual consumer confusion but on the egregiousness of the depiction itself, and the Court found that the incorporation of Brown’s likeness did not strongly suggest Brown endorsed the game.⁵¹

In *Twentieth Century Fox Television v. Empire Distribution, Inc.* (2017), the Ninth Circuit affirmed summary judgment, like in the four preceding cases.⁵² Hip hop record label Empire Distribution claimed that *Empire*, a musical drama TV show on Fox, infringed Empire Distribution’s trademark.⁵³ The Fox series revolves around the fictional hip hop record label “Empire Enterprises.”⁵⁴ Even though Fox profited from music and merchandise related to the TV series, the Court rejected Empire’s claim that the TV show was a “pretextual expressive work meant only to disguise a business profiting from another’s trademark.”⁵⁵ As long as the TV show itself passed the *Rogers* test and was thus First Amendment-protected, Fox had the right to promote the show’s name on related music and merchandise.⁵⁶ First, the Court held that Fox’s use of “Empire” in its TV show was artistically relevant because “the show’s setting is New York, the Empire State, and its subject matter is a music and entertainment conglomerate, ‘Empire

⁵⁰ *Id.* at 1245–46.

⁵¹ *Id.*

⁵² *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1195 (9th Cir. 2017).

⁵³ *Id.*

⁵⁴ In real life, Columbia Records releases the show’s music to the public after each episode airs. *Id.* Columbia Records is owned by Sony Music, whereas Empire Distribution is an independent label providing musicians an alternative to signing with a major label. See Shirley Halperin, *Columbia Records’ Joel Klaiman Leaves Label*, VARIETY (Aug. 8, 2018, 2:07 PM), <https://variety.com/2018/music/news/columbia-records-joel-klaiman-leaves-label-1202891898/>; Ogden Payne, *Empire: The Distribution Company That Turned Music Streaming Pennies Into Profit*, FORBES (Sept. 26, 2016, 3:35 PM), <https://www.forbes.com/sites/ogdenpayne/2016/09/26/empire-the-digital-distribution-company-that-turned-music-streaming-pennies-into-profit/#40ca13973ead>. Empire is no insignificant label, having distributed over 10,000 albums since its creation in 2010. See Dan Rys & Gail Mitchell, *Hip-Hop’s Other EMPIRE: How Indie Distributor is Quietly Owning the Rap Game*, BILLBOARD (Oct. 20, 2016), <https://www.billboard.com/articles/news/magazine-feature/7549759/empire-distribution-indie-success>.

⁵⁵ *Twentieth Century Fox*, 875 F.3d at 1196–97.

⁵⁶ *Id.* at 1197.

Enterprises,’ which is itself a figurative empire.”⁵⁷ Second, the Court, like in *Brown*, emphasized that consumer confusion alone is not enough to constitute explicit misleadingness, which requires an “explicit indication, overt claim, or explicit misstatement.”⁵⁸ Likelihood of confusion is necessary to have a prima facie case of trademark infringement; therefore, if consumer confusion could defeat the *Rogers* test without some greater showing of harm, the First Amendment would never succeed as a defense.⁵⁹ Because the TV show did not expressly reference Empire Distribution or suggest that the real-life Empire label endorsed the show, the Court found there was no explicit misleadingness.⁶⁰

II. The Honey Badger Case: *Gordon v. Drape Creative, Inc.*

Prior to this case, the Ninth Circuit had affirmed summary judgment in all five cases in which it applied the *Rogers* test. This case was different. Unlike in most of the previous cases, the defendants in this case created not one, but seven different works that were supposedly infringing.⁶¹ The seven greeting cards included: (1) two different *election cards*, both with a patriotic honey badger image on the front (inside, one card said “Me and Honey Badger don’t give a \$#%@! Happy Birthday,” and the other card said “Honey Badger and me just don’t care. Happy Birthday”); (2) two different *birthday cards*, both with a honey badger image on the front and “Honey Badger Don’t Give a S---” inside (one of the cards said “Honey Badger Heard It’s Your Birthday” on the front); (3) two different *Halloween cards*, both with “Halloween Is Here,” a honey badger, and a jack-o-lantern on the front (the insides said “Honey Badger Don’t Give a

⁵⁷ *Id.* at 1198.

⁵⁸ *Id.* at 1199 (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d Cir. 1989)).

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ In *Twentieth Century Fox*, there arguably were multiple works at issue, because Fox sold music and merchandise related to its *Empire* TV show. *Id.* at 1196–97.

“\$#*%!” or “Honey Badger Don’t Give a S---”); and (4) a *Twitter-style birthday card* with mock tweets by HoneyBadger@don’tgiveas--- (the front said “Just killed a cobra. Don’t give a s---,” “Just ate a scorpion. Don’t give a s---,” and “Rolling in fire ants. Don’t give a s---”; the inside said “Your Birthday’s here . . . I give a s---”).⁶²

The issue was whether the greeting cards satisfied the *Rogers* test as a matter of law, meaning the defendants had an indisputable First Amendment defense to trademark infringement.⁶³ Although the district court dismissed Gordon’s lawsuit on summary judgment, the Ninth Circuit reversed, both in its initial ruling and in its updated opinion released in response to scholarly criticism.⁶⁴ Part A summarizes the Ninth Circuit’s initial July 2018 ruling; Part B discusses the defendants’ petition for rehearing and the trademark professors’ related amicus brief; Part C reviews the changes included in the updated November 2018 opinion; and Part D explains the procedural implications for a potential trial on the merits.

A. July 2018 Ruling: Triable Issues As To Artistic Relevance

The original decision asserted there were triable issues as to whether the defendants, Drape Creative, Inc. and Papyrus-Recycled Greetings, Inc., used Gordon’s trademark in a way that was artistically relevant to the defendants’ greeting cards.⁶⁵ Once the defendant shows that the work at issue is an “expressive work” within the scope of the First Amendment, the burden shifts to the

⁶² The Twitter-style card’s reference to the cobra alludes to dialogue from Gordon’s YouTube video, apart from the trademarks. *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 262–263, 263 n.3 (9th Cir. 2018).

⁶³ *Id.* at 268.

⁶⁴ *Id.* at 261; *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184, 1187 (9th Cir. 2018).

⁶⁵ *Gordon*, 897 F.3d at 1194. Gordon’s first trademark, “honey badger don’t care,” is federally registered. *Id.* at 1187. Gordon’s second trademark, “honey badger don’t give a s---,” is not federally registered due to its inclusion of a cuss word. *See supra* note 12 and accompanying text. However, this unregistered trademark still could be valid and enforceable as a common law trademark. *See J. Thomas McCarthy, State Trademark Statutory and Common Law Is Similar to Federal Trademark Law*, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 22:1.50 (Westlaw 5th ed. 2018). The Court declined to rule on this issue, stating that the unregistered trademark’s enforceability was irrelevant to the defendants’ First Amendment defense. *Gordon*, 897 F.3d at 1194 n.7.

plaintiff to establish a triable issue relating to at least one of the *Rogers* prongs.⁶⁶ The Court had no difficulty deciding that the defendants’ greeting cards were expressive works.⁶⁷ The Court also acknowledged that the Honey Badger joke was central to the humor of the greetings cards, which aimed to “[juxtapose] an event of some significance—a birthday, Halloween, an election—with the honey badger’s aggressive assertion of apathy.”⁶⁸ Nonetheless, the Court held that the cards arguably lacked artistic relevance because the defendants may have “merely appropriated the goodwill inhering in Gordon’s mark without adding any creativity of their own.”⁶⁹

The Ninth Circuit added a new requirement for artistic relevance: not only must the use of the plaintiff’s mark be relevant to the work as a whole, but it must also be relevant to the defendant’s artistry.⁷⁰ In other words, “the defendant must add his own artistic expression beyond that represented by the mark.”⁷¹ The Court compared the greeting cards to Andy Warhol’s famous “Campbell’s Soup Cans” painting exhibit: “[Whereas] Warhol took Campbell’s mark and added his own artistic expression . . . there is evidence that defendants simply used Gordon’s mark in the same way that Gordon was using it—to make humorous greetings cards in which the bottom line is ‘Honey Badger don’t care.’”⁷² Further, the seven greeting cards utilized Gordon’s phrases in different ways, so a jury could potentially find that some, but not all, of the cards satisfied the

⁶⁶ The Court called this a “heightened burden.” *Gordon*, 897 F.3d at 1190.

⁶⁷ “Although the cards may not share the creative artistry of Charles Schulz or Sandra Boynton, the First Amendment protects expressive works ‘[e]ven if [they are] not the expressive equal of *Anna Karenina* or *Citizen Kane*.’” *Id.* at 1194.

⁶⁸ *Id.*

⁶⁹ *Id.* at 1195. The Court cited the Sixth Circuit case *Parks v. LaFace Records*, the only appellate decision to find a triable issue regarding artistic relevance. *Id.* at 1194–95; Brief Amicus Curiae of 37 Intellectual Property Law Professors in Support of Appellees’ Petition for Panel Rehearing and Rehearing En Banc at 8 n.5, *Gordon v. Drape Creative, Inc.* 897 F.3d 1184 (9th Cir. 2018) (No. 16-56715) [hereinafter Professors’ Brief]. In *Parks*, the defendants titled their song “Rosa Parks” even though the song itself had at best a tenuous connection to the famous civil rights advocate. The song’s composers even admitted that the song was “never intended . . . to be about Rosa Parks or the civil rights movement.” *Parks v. LaFace Records*, 329 F.3d 437, 452–453 (6th Cir. 2013).

⁷⁰ *Gordon*, 897 F.3d at 1194–95.

⁷¹ *Id.* at 1195.

⁷² *Id.* at 1195–96.

artistic relevance requirement.⁷³ Because artistic relevance presented triable issues, the Court chose not to address whether the greeting cards were explicitly misleading.⁷⁴

B. Petition and Amicus Brief: The Ninth Circuit Misapplied *Rogers*

The petition for rehearing argued that the Ninth Circuit, by reversing summary judgment, “racially undermine[d] *Rogers* and this Court’s precedents, as well as seriously eroding the scope of First Amendment protections.”⁷⁵ The defendants claimed that the greeting cards incorporated the Honey Badger concept in a creative and clever way—clearly meriting First Amendment protection under the pre-existing *Rogers* test, which requires “more than zero” artistic relevance.⁷⁶ Adding a more subjective creativity inquiry resembles a copyright analysis, even though copyright law does not protect short phrases like “honey badger don’t care.”⁷⁷ The defendants also argued that sending these types of cases to a jury unnecessarily subjects defendants to the time and cost of trial in order to defend their free-speech rights.⁷⁸ Therefore, the mere threat of litigation could severely stifle artistic expression, due to the “chill of concern that their expression would expose them to a complex and esoteric inquiry to be determined by a jury.”⁷⁹

The amicus brief, written by Mark Lemley, Mark McKenna, and Rebecca Tushnet on behalf of a group of thirty-seven trademark scholars, similarly argued that the Ninth Circuit improperly interpreted *Rogers* to indicate that trademark owners own the expressive meaning of

⁷³ *Id.* at 1195.

⁷⁴ *Id.* at 1196 n.8.

⁷⁵ Petition for Rehearing, *supra* note 9, at 2.

⁷⁶ “Defendants’ greeting cards reflected *Defendants*’ rendition of the phrase [honey badger don’t give a s---] and Defendants’ choice of colors, pictures, precise phrasing, and occasions around which the phrase should be used is ‘more than zero artistic relevance’ as a matter of law and enough to warrant First Amendment protection.” *Id.* at 16.

⁷⁷ *Id.* at 4.

⁷⁸ *Id.* at 5.

⁷⁹ *Id.* at 2.

their marks, not just the source-identifying aspect.⁸⁰ Primarily, they disagreed with how the Ninth Circuit seemed to require the defendants to add their own artistic expression to the plaintiff’s mark, a concept reminiscent of the transformative use doctrine in copyright law.⁸¹ They noted that a trademark use can be artistically relevant without commenting on or changing the original mark.⁸² As stated in previous cases, any artistic relevance that is “more than zero” should be sufficient to merit First Amendment protection—“[a]nd 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—something copyright courts have long recognized as inappropriate.”⁸³ Like the defendants, the professors argued that because the Honey Badger phrases were central to the joke in each of the greeting cards, the existence of artistic relevance was unarguable under the traditional *Rogers* test.⁸⁴ They ultimately urged the Court to reconsider its ruling, for sending cases like this one to a jury would “squelch speech” and violate the fundamental principles of trademark law.⁸⁵

⁸⁰ Professors’ Brief, *supra* note 69, at 4–5; Crouch, *supra* note 12. Mark Lemley of Stanford Law School is the most-cited U.S. intellectual property scholar, with more than 16,000 book and law journal citations to his work. Mark McKenna of Notre Dame Law School is another leading intellectual property scholar whose expertise is in trademark law. Harvard Law professor Rebecca Tushnet, author of the 43(B)log about trademark law, specializes in the First Amendment implications of intellectual property. *Biography—Mark A. Lemley*, STANFORD UNIV., <https://law.stanford.edu/directory/mark-a-lemley/> (last visited Dec. 11, 2018); *Mark McKenna*, UNIV. OF NOTRE DAME, <https://law.nd.edu/directory/mark-mckenna/> (last visited Dec. 11, 2018); *Rebecca Tushnet*, HARVARD COLLEGE, <https://hls.harvard.edu/faculty/directory/11412/Tushnet> (last visited Dec. 11, 2018).

⁸¹ Professors’ Brief, *supra* note 69, at 10. In copyright law, transformative use falls within the “nature and purpose of the use,” one of four factors courts consider when determining whether the fair use defense applies to a defendant’s use of copyrighted material. See Howard B. Abrams, *Evaluating the Four Factors—The Nature and Purpose of the Use—Transformative, Productive, and Unproductive Uses*, 2 THE LAW OF COPYRIGHT § 15:51 (Westlaw 2018) (“A transformative or productive use is one where the material taken from the prior work to be incorporated into the new work is more than just the old work in disguise . . . [although] the absence of a transformative or productive use is not automatically fatal to a claim of fair use . . . [and] the fact that a use is productive does not automatically make it fair.”).

⁸² Professors’ Brief, *supra* note 69, at 11. The professors referred to *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013), holding that a video game’s inclusion of a virtual strip club mimicking the real-life establishment, with few changes, was artistically relevant to the game’s goal of realistically representing Los Angeles. See *supra* Part I for discussion of this case.

⁸³ Professors’ Brief, *supra* note 69, at 8–9.

⁸⁴ *Id.* at 9.

⁸⁵ *Id.* at 12.

C. Updated November 2018 Decision: Triable Issues As To Explicit Misleadingness

Upon rehearing, the three-judge panel behind the original decision issued an updated opinion replacing the first one.⁸⁶ Probably in response to the concerns of the professors and the defendants, the panel reversed its stance on the first *Rogers* prong, now holding that the greeting cards unarguably had artistic relevance.⁸⁷ Instead, the Court, which had before declined to address the second *Rogers* prong, held there were triable issues as to whether the defendants' greeting cards were explicitly misleading.⁸⁸ The Court rejected the district court's "rigid requirement" that a work cannot be explicitly misleading unless there is an "affirmative statement of the plaintiff's sponsorship or endorsement."⁸⁹ At the same time, mere use of a trademark is not enough to create explicit misleadingness, as established by previous cases.⁹⁰

In finding triable issues, the Court emphasized that the plaintiff and the defendants both used the trademarks in "similar artistic expressions," i.e. greeting cards.⁹¹ By contrast, because Gordon had already licensed greeting cards in which the Honey Badger trademark connoted his brand, a competing card using the same mark is more likely to be explicitly misleading.⁹² The Court added that a work can be explicitly misleading when a defendant adds little artistic

⁸⁶ *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 260 (9th Cir. 2018).

⁸⁷ *Id.* at 269 ("Gordon's mark is certainly relevant to defendants' greeting cards; the phrase is the punchline on which the cards' humor turns.").

⁸⁸ *Id.* at 261.

⁸⁹ *Id.* at 269.

⁹⁰ *Id.* at 270. *See, e.g.*, *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1199 (9th Cir. 2017); *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1000 (9th Cir. 2008); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

⁹¹ *Gordon*, 909 F.3d at 270 ("In the cases in which we have applied the *Rogers* test, the junior user has employed the mark in a different context—often in an entirely different market—than the senior user. In *MCA Records* and *Walking Mountain*, for example, Mattel's Barbie mark was used in a song and a series of photos. In *E.S.S.*, the mark of a strip club was used in a video game. And in *Twentieth Century Fox*, the mark of a record label was used in a television show This disparate use of the mark was at most 'only suggestive' of the product's source and therefore did not outweigh the junior user's First Amendment interests.").

⁹² The Court analogizes a greeting card versus greeting card comparison to a title versus title comparison, noting that "'misleading titles that are confusingly similar to other titles' can be explicitly misleading, regardless of artistic relevance." *Id.* (citing *Rogers v. Grimaldi*, 875 F.2d 994, 999 n.5 (2d Cir. 1989)).

expression to the borrowed trademark.⁹³ Compared to the previous *Rogers* cases, in which the trademark “obviously served as only one ‘element of the [work] and the [junior user’s] artistic expressions,’” Gordon’s trademark could be seen as the “centerpiece” of the defendant’s greeting cards, “unadorned with any artistic contribution.”⁹⁴ Emphasizing that consumers may expect marks on the inside of cards to identify source, the Court held that explicit misleadingness could not be resolved on summary judgment.⁹⁵

D. Procedural Aftermath

Now that the Ninth Circuit has reversed summary judgment, a jury trial is possible but not guaranteed. As one commentator humorously noted, “Absent settlement or a loss on other grounds, one federal jury will be lucky enough to enjoy (or endure) an amusing take on wild honey badgers, their athletic and eating habits, and what it all means for the sale of greeting cards.”⁹⁶ The parties could decide to settle pre-trial, which was what happened in all of Gordon’s previous trademark lawsuits.⁹⁷ Or the district court on remand could find that Gordon abandoned his trademark, as the defendants claim.⁹⁸ If neither of those events happens and a trial does result, Gordon will have the burden to prove that (1) the defendants’ greeting cards create a likelihood of confusion with a valid trademark, and (2) this confusion rises to the level of explicit misleadingness, thus invalidating the defendants’ *Rogers* defense.⁹⁹

⁹³ *Id.* at 270–71.

⁹⁴ *Id.* at 271.

⁹⁵ *Id.*

⁹⁶ Ben Kappelman, *Honey Badger Don’t Care About Trademark Infringement, but the Ninth Circuit Does*, DORSEY (Dec. 20, 2018), <https://thetmca.com/honey-badger-dont-care-about-trademark-infringement-but-the-ninth-circuit-does/>.

⁹⁷ This is not the first time Gordon has sued for trademark infringement of his Honey Badger marks. *See infra* notes 124–25 and accompanying text.

⁹⁸ *Gordon*, 909 F.3d at 271 n.11. Abandonment occurs when a trademark owner stops using the mark with the intent not to resume. It can also occur if the mark becomes so widespread that it becomes genericized. *See* 15 U.S.C. § 1127.

⁹⁹ *Gordon*, 909 F.3d at 264–65.

The defendants will win if Gordon fails to prove either element. The first element, likelihood of confusion, could fail with respect to the cards featuring “honey badger don’t give a s---” if the district court does not recognize this phrase as a common-law trademark.¹⁰⁰ The outcome of the second element, regarding explicit misleadingness, is also difficult to predict. Burroughs noted that if the already available evidence were not enough to convince the Court that these cards were explicitly misleading, “[i]t is unclear what could possibly be proffered to the jury to add this ‘something else’ given the uncontroverted evidence of Gordon’s creation and popularization of his content and defendants’ clear exploitation of that content in the cards.”¹⁰¹ His prediction, based on the Court’s rationale, is that the jury would decide the cards are not explicitly misleading—meaning that the defendants passed the *Rogers* test and are not liable for infringement. But juries do not always consider evidence in the same way that judges would. Jurors unfamiliar with trademark law might not fully comprehend the distinction between what satisfies likely confusion and what satisfies the higher standard of explicit misleadingness, and might conflate the two. This is especially possible given that even judges and practitioners struggle with

¹⁰⁰ Gordon does not have a federal trademark registration for this phrase, which appears in six of the defendants’ seven greeting cards. *Id.* at 261–263. Only one of the cards spoofs “honey badger don’t care,” the phrase Gordon actually has a trademark registration for. The Ninth Circuit assumed for the purposes of its ruling that the unregistered phrase was enforceable as a common-law trademark, but it left the ultimate decision to the district court on remand. *Id.* at 263 n.5. Given the recognizability of “honey badger don’t give a s---” in connection with Gordon’s franchise, the district court will likely agree that the phrase is protected. But if not, the six cards spoofing that phrase probably would not be actionable. Then, the jury would only need to consider whether the one card spoofing “honey badger don’t care” is likely to cause confusion with the registered mark.

¹⁰¹ Burroughs, *supra* note 3.

the concept.¹⁰² Thus, a jury that finds a likelihood of confusion could also find that the cards were explicitly misleading, thus destroying the defendants' First Amendment defense.¹⁰³

III. Implications for Trademark Law and Free Speech

The Second Circuit when deciding *Rogers* in 1989 could not have foreseen the new ways in which trademarks would become genuinely relevant to discourse and artistic expression over the next thirty years.¹⁰⁴

Historically, trademarks functioned merely as a signature that decreased search costs and encouraged manufacturers to make higher quality goods. Today, however, they convey far more information than source and product quality Modern marks possess immense communicative power and transmit an array of information, much of which is derived from characteristics of the trademark owner as well as any underlying activities associated with that owner For example, the CHIK-FIL-A mark is associated with fried chicken and opposition to same-sex marriage. Likewise, the MARLBORO mark relates to cigarettes and lung cancer.¹⁰⁵

Particularly the Internet, which launched the year after *Rogers* was decided, has enabled the unprecedented dissemination of media like the Honey Badger video.¹⁰⁶ Now with 4.1 billion users worldwide, the Internet supplements TV, billboards, and other platforms in ingraining brand

¹⁰² For example, the Ninth Circuit in *E.S.S. Entm't* held that the defendant's video game depicting a real-life strip club was not explicitly misleading because it did not "confuse its players into thinking that the Play Pen is somehow behind the Pig Pen or that it sponsors Rockstar's product." This resembles a likelihood-of-confusion analysis. Courts have since indicated that explicit misleadingness is something more egregious than mere infringement. See Wright, *supra* note 20, at 208–09. For discussion of *E.S.S. Entm't*, see *supra* Part I.

¹⁰³ A Law360 writer remarked that the Ninth Circuit's ruling might in fact make explicit misleadingness easier to prove. Donahue, *supra* note 17.

¹⁰⁴ See William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 57–58 (2008); Wright, *supra* note 20, at 200 ("[T]he traits that make marks so valuable as brand icons also make them convenient and powerful cultural symbols when used outside the commercial marketplace . . . [making] them particularly suited to expressive works of entertainment.").

¹⁰⁵ Guilio Ernesto Yaquinto, *The Social Significance of Modern Trademarks: Authorizing the Appropriation of Marks as Source Identifiers for Expressive Works*, 95 TEX. L. REV. 739, 740–42 (2017).

¹⁰⁶ See Donna Frosco & L. Elizabeth Dale, *Honey Badger May Not Care, But You Should: A 1930s Film Star, A 30-Year-Old Legal Test, and Trademark in the Age of Digital Content*, 29 NYSBA ENT., ARTS & SPORTS L.J. 75, 76 (2018); Julia Murphy & Max Roser, *Internet*, OUR WORLD IN DATA (2018), <https://ourworldindata.org/internet>.

images into the public consciousness.¹⁰⁷ Nowadays, “We’re so used to viewing content for ‘free’ on services like YouTube, we forget that online creators have the same intellectual property rights as traditional publishers.”¹⁰⁸ As a result, it is now more important than ever to clarify the boundary between incorporating a trademark artistically and using it avariciously.

Some scholars praise the *Gordon* ruling as a triumph for rightful trademark owners, while others fear the ruling limits free speech and impermissibly expands the scope of trademark rights. Notably, the scholars disagree on how to apply the two *Rogers* prongs to this case. Above the Law’s Scott Burroughs believes that with respect to artistic relevance, the defendants blatantly tried to pass off their obvious trademark infringement as “art”: “Apparently, they added a hat here and a pumpkin there, but, viewing the cards objectively, it is hard to argue that any consumer purchased one of the disputed cards for another reason other than the draw of ol’ Honey Bae.”¹⁰⁹ Amicus brief co-author Rebecca Tushnet, on the other hand, strongly disagreed with the Court’s original finding that the cards lacked artistic relevance, claiming that “the word ‘relevance’ has been ignored, and ‘artistic’ has been reinterpreted as a thing that the defendant must *add* to the original, rather than having a meaning-based relationship between the original and the accused work.”¹¹⁰

¹⁰⁷ John Stevens, *Internet Stats and Facts for 2019*, HOSTING FACTS (Dec. 17, 2018), <https://hostingfacts.com/internet-facts-stats/>.

¹⁰⁸ *Ninth Circuit’s “Honey Badger” Ruling Could Impact the Internet*, LVOVICH & SZUCSKO, P.C. (2018), <https://landslawgroup.com/ninth-circuits-honey-badger-ruling-could-impact-the-internet/>. See also Frosco & Dale, *supra* note 106, at 76 (“[A]lthough media has changed beyond the wildest dreams of many in the 1980s, the applicable legal principles have not changed all that much.”).

¹⁰⁹ Burroughs, *supra* note 3 (“Greeting cards can certainly be artistic, but a greeting card company should not be able to add some degree of ancillary ‘artistic’ material to someone else’s creative content and thus avoid infringement liability.”). Accord Laura Goldbard George & Binni N. Shah, *The First Amendment: Apparent Immunity from Trademark Infringement?*, MONDAQ (Oct. 11, 2018), www.mondaq.com/unitedstates/x/744708/Trademark/The+First+Amendment+Apparent+Immunity+From+Trademark+Infringement.

¹¹⁰ See Rebecca Tushnet, *The Ninth Circuit Don’t Care: Successful Rogers Defense Reversed Because Plaintiff’s Trademark is ‘Artistic’*, REBECCA TUSHNET’S 43(B)LOG (Aug. 8, 2018), tushnet.blogspot.com/2018/08/the-ninth-circuit-dont-care-successful.html [hereinafter First Tushnet Blog Post].

What’s really going on here is a denigration of the greeting cards as works—protected by the First Amendment, yes, but not real works like songs, photos, video games, etc. This is not without irony given the ways these classes of works have been denigrated in the past, but it also speaks to the confidence courts have in making judgments about *how much* art is in a work, which they seem to think differs from judgments about merit.¹¹¹

The Court eventually changed its stance on artistic relevance but still denied summary judgment on the basis that the cards could be explicitly misleading. Whereas Burroughs thinks that consumers are apt to misidentify the defendants’ greeting cards as Gordon’s, Tushnet disagrees.¹¹² She would be “stunned” if consumers readily associated the two Honey Badger phrases with specific goods, as opposed to the general Honey Badger cultural phenomenon.¹¹³ In her view, the Court simply “transferred much (though not all) of the nonsense it previously said about artistic relevance to its explication of what counts as explicitly misleading.”¹¹⁴

Ultimately, scholars are concerned that the Ninth Circuit, by reducing the likelihood of success on summary judgment, has deterred artists from taking creative risks that might incorporate or refer to trademarks.¹¹⁵ As one analyst wrote, the *Rogers* test pre-*Gordon* was a “consistent and relatively straightforward test for courts and litigants to apply” in the midst of doctrinal confusion that tended to favor trademark rights over free speech.¹¹⁶ Before this case, confusion already existed because fair use defenses are fairly open-ended, leading to

¹¹¹ *Id.*

¹¹² Burroughs, *supra* note 3; Rebecca Tushnet, *Honey Badger Don’t Care for Different Reasons: Court Fixes Artistic Relevance but Still Doubles Down on Transformativeness*, REBECCA TUSHNET’S 43(B)LOG (Nov. 26, 2018), tushnet.blogspot.com/2018/11/honey-badger-dont-care-for-different.html [hereinafter Second Tushnet Blog Post].

¹¹³ First Tushnet Blog Post, *supra* note 110. She also argued that the phrases inside the defendants’ cards could not reasonably be misinterpreted as a source designator when most cards, including these ones, list the maker on the back. *See* Second Tushnet Blog Post, *supra* note 112.

¹¹⁴ Second Tushnet Blog Post, *supra* note 112.

¹¹⁵ *See* Donahue, *supra* note 17 (“This [case] may increase the risk for artistic works and their use of third-party marks The way the jury comes out will be an important bellwether for First Amendment defenses to trademark claims.”); Rick Kurnit, *Use of Trademarks In Expressive Works Just Got Harder*, FRANKFURT KURNIT KLEIN & SELZ PC (Nov. 27, 2018), <https://www.lexology.com/library/detail.aspx?g=5b9c320a-4c23-49c9-8491-99d38626c3e4>.

¹¹⁶ Wright, *supra* note 20, at 218, 221.

inconsistencies in how different jurisdictions interpret and apply these defenses.¹¹⁷ The difficulty of predicting the outcome at trial can pressure defendants to settle, even when their work may well have been First Amendment-protected.¹¹⁸ Even apprehension of a future lawsuit can deter artists from taking creative risks that might incorporate others' trademarks.¹¹⁹ Trademark professor William McGeveran calls this "clearance culture," where creators—ranging from individual artists to entire entertainment industries—adopt exceedingly stringent trademark avoidance or clearance procedures that are "far in excess of legal requirements . . . to eliminate even the tiniest risk of trademark disputes."¹²⁰

Gordon himself has contributed to this clearance culture over the past few years through his repeated attempts to enforce his trademark rights.¹²¹ Even before this lawsuit, Gordon routinely sent cease and desist letters to online sellers of Honey Badger-themed goods.¹²² This resulted in roughly twenty lawsuits filed from 2014-2015, all of which were ultimately resolved out of court.¹²³ Defendants ranged from small businesses to large companies such as Kohl's, Target, and Beth Bath & Beyond.¹²⁴ Honey Badger-themed T-shirts were the primary target, though a few of

¹¹⁷ See McGeveran, *supra* note 104, at 61–62.

¹¹⁸ For example, the victorious defendant in the "Food Chain Barbie" photography case would not have been able to foot the \$2 million bill for legal expenses had the ACLU not offered to defend his case pro bono. The defendant eventually defeated Mattel's infringement claim because his photography series passed the *Rogers* test. See *id.* at 62. For a discussion of *Mattel, Inc. v. Walking Mountain Productions*, see *supra* Part I.

¹¹⁹ See McGeveran, *supra* note 104, at 63–64.

¹²⁰ "For example, insurers often demand rights clearance for every single expressive use of a trademark in documentaries; reality television producers obscure unlicensed trademark logos captured incidentally in the footage they air; Google allows markholders to ban the use of their trademarks in others' advertisements; and the virtual world Second Life generally forbids graphical items created by individuals if they incorporate trademarks." *Id.* at 63. McGeveran was one of the signatories to the professors' amicus brief. See also Wright, *supra* note 20, at 218–19.

¹²¹ See Tim Sitzmann, *Honey Badger Don't Care, but the Owner of the Trademark Rights Do Care*, DUETS BLOG (Sept. 18, 2014), <https://www.duetsblog.com/2014/09/articles/trademarks/honey-badger-dont-care/>.

¹²² *Id.*

¹²³ Some were trademark infringement actions filed by Gordon; the rest were declaratory judgment actions filed by companies who received cease and desist notices from him. The vast majority of these lawsuits were filed in the U.S. District Court for the Central District of California, the same court in which *Gordon v. Drape Creative* originated (except this case is the only one that made it past the discovery or pleading stage).

¹²⁴ For lawsuits against large companies, see, e.g., Complaint, *Gordon v. Kohls Dep't Stores, Inc.*, No. 2:15-cv-08255 (C.D. Cal. filed Oct. 21, 2015); Complaint, *Gordon v. Target Corp.*, No. 2:15-cv-03597 (C.D. Cal. filed

the lawsuits involved other merchandise including magnets, doormats, and pillows.¹²⁵ One cannot blame Gordon for actively seeking to enforce his trademark, for a trademark can lose its validity if it becomes generic due to a proliferation of non-authorized uses.¹²⁶ Regardless, the effect has been to promote clearance culture—evidenced by how lawyers, in light of *Gordon*, are specifically advising creators to tread more carefully when it comes to IP.¹²⁷ Given this landscape that encourages trademark owners to enforce their rights and discourages artists from risking legal action, the *Gordon* ruling has understandably been criticized for disrupting the routine of dismissing infringement cases via the *Rogers* test.¹²⁸

At the same time, this one case denying summary judgment should not be overblown as an omen of legal troubles for well-meaning artists. Since the Ninth Circuit adopted the *Rogers* test in 2002, all five of its pre-*Gordon* decisions—as well as several district court decisions within the Ninth Circuit—have granted summary judgment.¹²⁹ Courts outside of the Ninth Circuit have also

May 13, 2015); Complaint, *Gordon v. Bed Bath and Beyond, Inc.*, No. 2:15-cv-08109 (C.D. Cal. filed Oct. 15, 2015). For lawsuits against small businesses, see, e.g., Complaint, *Gordon v. RK T-Shirts LLC*, No. 2:15-cv-01510 (C.D. Cal. filed Mar. 2, 2015); Complaint, *Gordon v. 80sTees.com*, No. 2:14-cv-09934 (C.D. Cal. filed Dec. 30, 2014).

¹²⁵ See *supra* note 124 for cases involving T-shirts. See also, e.g., Complaint, *Gordon v. Flash Prints LLC*, No. 2:15-cv-01059 (C.D. Cal. filed Feb. 12, 2015) (magnets); Complaint, *Damn Good Doormats LLC v. Gordon*, No. 1:15-cv-00336 (D. Md. filed Feb. 5, 2015) (doormats); Complaint, *Gordon v. Bed Bath and Beyond, Inc.*, No. 2:15-cv-08109 (C.D. Cal. filed Oct. 15, 2015) (pillows).

¹²⁶ See McGeeveran, *supra* note 104, at 64.

¹²⁷ See, e.g., Daniel M. Cislo, *Ninth Circuit Rules on “Honey Badger Don’t Care” Trademarks*, CISLO & THOMAS LLP (Aug. 14, 2018), cisloandthomas.com/ninth-circuit-rules-on-honey-badger-dont-care-trademarks/ (“If there is widespread recognition over a phrase it is advisable to avoid using that phrase for commercial gain unless you first seek permission.”); Frosco & Dale, *supra* note 106, at 77 (2018) (“[A]vid consumers of digital social media should be aware that simply because something is online or has gone viral does not necessarily mean it is up for grabs, especially for commercial gain.”); Cynthia Blake Sanders, *International Report—Honey Badger Don’t Care—Transforming Trademark Infringement into Artistic or Expressive Works*, IAM (Aug. 15, 2018), https://www.iam-media.com/honey-badger-dont-care-transforming-trademark-infringement-artistic-or-expressive-works?fbclid=IwAR2RPjVIawU37joPYkiHEYMPk_gu2jjDUUan6VaNIImDsIJQGdtDYoyXt-k (“When launching an entertainment product, it is best practice to lock down the intellectual assets before launch to reduce the number of lawsuits required to protect the marks and related content.”).

¹²⁸ See, e.g., Kurnit, *supra* note 115 (arguing that the Ninth Circuit, by “ignoring that the costs and unpredictability of jury trials chill free speech,” undermined the importance of summary judgment as a mechanism to dismiss “assaults on free expression”).

¹²⁹ See Zangrillo, *supra* note 20, at 406–14. For district court decisions upholding the First Amendment defense, see, e.g., *Virag, S.R.L. v. Sony Computer Entm’t Am. LLC*, No. 3:15-cv-01729, 2015 WL 5000102 (N.D. Cal. Aug. 21, 2015) (*Gran Turismo* video game was First Amendment-protected); *Mil-Spec Monkey, Inc. v.*

repeatedly upheld First Amendment defenses.¹³⁰ Amicus brief co-author Mark Lemley even said that the updated opinion “shows greater recognition of the risks trademark law can pose to free speech and artistic expression.”¹³¹ Therefore, this one unique case—in which the Honey Badger is distinctly famous, the trademark was closely copied, the defendants sold the same product as the plaintiff, and the defendants arguably showed bad faith in using the mark after failed licensing negotiations—does not necessarily foreshadow a general reduction of free speech rights.

At the core of the debate is whether the defendants’ Honey Badger references were a non-trademark use of Gordon’s trademark. Non-trademark use is a category encompassing trademark references that do not associate the defendant’s brand with the plaintiff.¹³² Tushnet categorizes the Honey Badger references as non-trademark uses that simply served as “punchlines” derived from Gordon’s video.¹³³ She wrote, “I do not accept that punchlines should be treated as serving as marks (and thus capable of being ‘confusingly similar’) when they are serving as punchlines; the fact that one trademark owner might use its mark as a punchline shouldn’t prevent anyone else from using it as a punchline.”¹³⁴ She implies that the Ninth Circuit, by jumping into whether the

Activision Blizzard, Inc., 74 F. Supp. 3d 1134 (N.D. Cal. 2014) (*Call of Duty* video game was First Amendment-protected); Roxbury Entm’t v. Penthouse Media Grp., Inc., 669 F. Supp. 2d 1170 (C.D. Cal. 2009) (pornographic film was First Amendment-protected).

¹³⁰ See, e.g., ETW Corp. v. Jireh Publ’g, Inc., 332 F.3d 915, 936–37 (6th Cir. 2003) (painting of Tiger Woods was First Amendment-protected); Fortres Grand Corp. v. Warner Bros. Entm’t Inc., 947 F. Supp. 2d 922, 931–32 (N.D. Ind. 2013) (Batman film referencing the plaintiff’s trademark was First Amendment-protected); Rebellion Devs. Ltd. v. Stardock Entm’t, Inc., No. 12-12805, 2013 WL 19448888, at *5–*6 (E.D. Mich. May 9, 2013) (video game title was First Amendment-protected); Eastland Music Grp., LLC v. Lionsgate Entm’t, Inc., No. 11-C-8224, 2012 WL 2953188, at *3 (N.D. Ill. July 19, 2012) (movie title was First Amendment-protected), *aff’d*, 707 F.3d 869 (7th Cir. 2013).

¹³¹ He still said he was “skeptical” of the Court’s holding, however. Barbara Grzincic, *Honey Badger Videomaker Hangs On To Second Chance in Trademark Appeal*, REUTERS LEGAL (Westlaw 2018).

¹³² Fair use notably falls within this category. See J. Thomas McCarthy, *Infringing Use as a “Trademark”*, 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:11.50 (Westlaw 5th ed. 2018). Fair use includes descriptive fair use (use of a trademark’s language to describe one’s own goods or services) and nominative fair use (reference to a trademark for purposes of comparing goods or services). *Trademark Infringement—Defenses to Trademark Infringement: Fair Use*, CORP. COUNS. GD. TO ADVERTISING L. & AGRMTS. § 3:9 (Westlaw 2018).

¹³³ Second Tushnet Blog Post, *supra* note 112.

¹³⁴ *Id.* See also Professors’ Brief, *supra* note 69, at 13–14 (“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

greeting cards were deceptive, overlooked the initial requirement that the Honey Badger phrases must serve as a mark for the defendants' cards.¹³⁵

What the parties, and even the Court, struggle with is how to separate the trademarks' source-identifying aspect from their comedic, expressive aspect—if the two are even separable. Tushnet and other scholars argue that trademarks have a limited function, to identify source, and thus Gordon should not be able to control allusions to the Honey Badger as a character. Characters are copyright protectable, and although Gordon has a copyright registration for his Honey Badger video narration, he did not allege copyright infringement in this lawsuit.¹³⁶ Critics of the ruling believe the Court expanded Gordon's trademarks into a copyright by failing to treat the humor in his video as separate from his source-identifying trademarks.¹³⁷ But the ruling's proponents point out that the power of Gordon's trademarks is inextricable from the original video that made the Honey Badger famous; the phrases are only distinctive because people recognize them from the video.¹³⁸ Moreover, most of the defendants' greeting cards used verbatim Gordon's "honey badger don't give a s---" trademark. When a defendant borrows the exact language of a mark, especially

enough to make the 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.”).

¹³⁵ Second Tushnet Blog Post, *supra* note 112. Tushnet, by noting that a “punchline” use should not even be *capable* of being confusingly similar, suggests that the defendants' use of the Honey Badger trademark as a mark should be a prerequisite to a trademark infringement action. Based on that premise, some scholars believe it is evident from the start, without the need for a jury trial, that the defendants' Honey Badger references were non-trademark uses and thus non-actionable. But the Ninth Circuit is one of several circuits that does not require that the defendant's use be “use as a mark” in order to be potentially infringing. *See* McCarthy, *supra* note 132; *see also* Bosley Med. Inst., Inc. v. Kremer, 403 F.3d 672, 677 (9th Cir. 2005). These circuits stipulate that under the Lanham Act, use in commerce as a source identifier is required for a plaintiff to have a valid, enforceable trademark; as to infringement, however, all the Act requires is that the defendant created a “likelihood of confusion over source, sponsorship, affiliation or approval.” McCarthy, *supra* note 132; *see* 15 U.S.C. § 1125(a)(1)(A). As a result, J. Thomas McCarthy disagrees with Tushnet's theory that a defendant's “use as a mark” is required for a plaintiff to prevail on infringement. Rather than being an absolute threshold requirement, use as a mark is simply one factor in considering whether the defendant's use is likely to confuse consumers. McCarthy, *supra* note 132. By extension, it could also be a factor in considering whether the defendants in this case used the Honey Badger trademarks in an explicitly misleading manner.

¹³⁶ Gordon v. Drape Creative, Inc., 909 F.3d 257, 261 (9th Cir. 2018). *See also* *Copyrightability—Characters*, CORP. COUNS. GD. TO COPYRIGHT L. § 1:9 (Westlaw 2018).

¹³⁷ Rebecca Tushnet, for example, wrote that the defendants “[told] the same joke that Gordon did . . . a joke that has nontrademark meaning.” First Tushnet Blog Post, *supra* note 110.

¹³⁸ *See* Burroughs, *supra* note 3.

within a similar product, it is nearly impossible for the defendant to invoke only the cultural meaning without misrepresenting source, even if the misrepresentation is unintended or incidental.

After rehearing, the Court ultimately arrived at the correct assessment. The existence of artistic relevance was unarguable, because any amount should suffice and it is not the Court's role to judge the value or substantiality of art. However, explicit misleadingness was arguable. Though the defendants did not violate an intellectual property right by alluding to the Honey Badger video generally (through pictures and, in some instances, text), these references in conjunction with the borrowed trademarks could free ride off of Gordon's goodwill in the marks. As the focal point of the cards, the marks might strongly suggest source, even though they appear inside the cards and not on the back, where trademarks on greeting cards are often placed.¹³⁹ Further, Gordon's own greeting cards increase the likelihood that unauthorized cards with the same trademarks could explicitly mislead consumers.

Explicit misleadingness is prone to being unresolvable as a matter of law in borderline cases like this one, because the difference between what is regularly misleading (to satisfy likelihood of confusion) and what is *explicitly* misleading is unavoidably abstract. It is not surprising, then, that no appellate court before *Gordon* has found that a defendant's work might be explicitly misleading.¹⁴⁰ This begs the question of whether this second prong is even useful—is it too intangible to meaningfully limit *Rogers'* presumption that artists can freely borrow trademarks?¹⁴¹ *Gordon* envisions explicit misleadingness as a limit that is more than theoretical,

¹³⁹ Rebecca Tushnet argues that the back cover is “where one would expect a trademark on a greeting card.” Second Tushnet Blog Post, *supra* note 112.

¹⁴⁰ The only appellate case denying summary judgment, *Parks v. LaFace Records*, found a lack of artistic relevance, while acknowledging that the defendants' song titled “Rosa Parks” satisfied the explicit misleadingness prong. *Parks v. LaFace Records*, 329 F.3d 437, 459 (6th Cir. 2013). For more discussion of *Parks*, see *supra* note 69 and accompanying text.

¹⁴¹ Attorney Daniel Jacob Wright suggests that limitations on the First Amendment defense “should take the form of clearer articulations of the rights held by markholders, not of further confusion regarding what is or is not an explicitly misleading use of a mark.” Wright, *supra* note 20, at 221.

which is a step in the right direction towards appropriately balancing trademark rights and free expression.

Conclusion

Originally, *Rogers* arose from the genuine need to prevent trademark owners from censoring speech and monopolizing core elements of language. The resulting First Amendment protections have been important and necessary to reconciling trademark and free-speech rights in the current media age. Accordingly, legal literature over the past fifteen years has focused on the need for trademark law to accommodate free-speech principles.¹⁴² But due to this emphasis, society has largely come to regard trademarks as a threat to free speech—while forgetting that it is equally possible for free speech to threaten trademarks. As the U.S. Supreme Court recently affirmed by invalidating content-based restrictions on trademark registration, trademark owners have their own First Amendment right to promote their brands using their hard-earned intellectual property.¹⁴³ *Gordon* represents the natural backswing of the pendulum, a needed shift toward reaffirming the integrity of trademarks in a landscape that has been dominated by free-speech concerns. This case, which questions the very core of what a trademark is and what it is not, presents at least some factual issues that a jury should decide. First Amendment concerns, while valid, should not undermine the integrity of summary judgment and deprive deserving plaintiffs of their right to protect their intellectual property.

¹⁴² See, e.g., Kelly L. Baxter, *Trademark Parody: How to Balance the Lanham Act with the First Amendment*, 44 SANTA CLARA L. REV. 1179 (2004); Matthew D. Bunker, *Diluting Free Expression: Statutory First Amendment Proxies in Trademark Dilution Law*, 22 COMM. L. & POL'Y 375 (2017); Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 381 (2008).

¹⁴³ In 2017, the Supreme Court invalidated the Lanham Act's pre-existing ban on trademark registration for marks that disparage specific groups of people (e.g., ethnic and religious slurs), holding that such a ban violated trademark owners' First Amendment right to free speech. *Matal v. Tam*, 137 S. Ct. 1744, 1765 (2017). See also *In re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017) (extending *Tam*'s rationale to invalidate a related Lanham Act section barring registration for "immoral" marks), *cert. granted*, 2019 WL 98541 (U.S. Jan. 4, 2019) (No. 18-302). See generally Sara Gold, *Does Dilution "Dilute" the First Amendment?: Trademark Law and the Right to Free Speech After Tam and Brunetti*, 59 IDEA: J. FRANKLIN PIERCE FOR INTELL. PROP. (forthcoming 2019).