

## Honey Badger Goes to a Jury: Infringement Claim Sets Precedent in Ninth Circuit

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### I. OVERVIEW

In 2015, Christopher Gordon, creator of well-known YouTube video “The Crazy Nastyass Honey Badger,” claimed trademark infringement under the Lanham Act following the release of a line of greeting cards by American Greetings, Papyrus-Recycled Greetings, and Drape Creative, Inc. (Drape Creative). Drape Creative designed and produced greeting cards using variations of two of Gordon’s trademark protected phrases: (1) “Honey Badger Don’t Care” (HBDC) and (2) “Honey Badger Don’t Give a S---” (HBDGS).<sup>1</sup> Drape Creative included images of a honey badger with phrases like “Me and Honey Badger don’t give a \$#%@! Happy Birthday,” and “Honey Badger and me just don’t care. Happy Birthday” on several of their cards.<sup>2</sup>

The United States District Court for the Central District of California granted summary judgment for Drape Creative, holding that Gordon’s infringement claims were barred by the test set forth in *Rogers v. Grimaldi*.<sup>3</sup> The court found that the Rogers test could not apply because Drape Creative’s cards were expressive works.<sup>4</sup> Gordon appealed to the Court of Appeals for the Ninth Circuit.<sup>5</sup> The Ninth Circuit *held* that an infringement claim may be presented to a jury if there is a triable issue of fact arising from either prong of the Rogers test. *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184 (9th Cir. 2018).

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1. *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184, 1186 (9th Cir. 2018).  
2. *Id.* at 1188.  
3. *Id.* at 1189.  
4. *Id.*  
5. *Id.*

## II. BACKGROUND

The Lanham Act regulates the use of trademarks and protects them against infringement, dilution, and unfair competition.<sup>6</sup> Under the Lanham Act, a trademark owner has a cause of action against any unauthorized usage of his registered mark, including situations in which the protected mark is being used in “any reproduction, counterfeit, copy, or colorable imitation of a registered mark.”<sup>7</sup> When determining whether infringement of a mark has occurred, a court will apply the likelihood-of-confusion test.<sup>8</sup> Under this test, a plaintiff bears the burden of proving that (1) they have “a valid, protectable trademark,” and (2) “[the defendant’s] use of the mark is likely to cause confusion.”<sup>9</sup>

When artistic expression is at issue, the Ninth Circuit finds that employing the traditional likelihood of confusion test alone “fails to account for the full weight of the public’s interest in free expression.”<sup>10</sup> Thus, some courts adopt the Rogers test, which arose from the Second Circuit in the case *Rogers v. Grimaldi*.<sup>11</sup> The Rogers test “strike[s] an appropriate balance between First Amendment interests in protecting artistic expression and the Lanham Act’s purposes to secure trademarks rights.”<sup>12</sup>

Under the Rogers test, a defendant bears the initial burden of proof by demonstrating that the alleged infringement is “part of an expressive work protected by the First Amendment.”<sup>13</sup> If the defendant is successful, the plaintiff “bears a heightened burden,”<sup>14</sup> meaning he must satisfy the two elements of the likelihood-of-confusion test and at least one prong of the Rogers test.<sup>15</sup> Essentially, if a defendant asserts a First Amendment claim, the plaintiff must demonstrate (1) a valid, protectable trademark, (2) evidence that the defendant’s use of the mark is likely to cause confusion, and (3) either that the mark is not artistically relevant to the underlying work *or* the mark explicitly misleads consumers as to the source or content of the work.<sup>16</sup>

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6. See generally 15 U.S.C. § 1051 (2002).

7. *Id.*

8. *Gordon*, 897 F.3d at 1189; *Twentieth Century Fox Film Corp. v. Empire Distribution, Inc.*, 875 F.3d 1192, 1196 (9th Cir. 2017); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806-07 (9th Cir. 2003).

9. *S. California Darts Ass’n v. Zaffina*, 762 F.3d 921, 929 (9th Cir. 2014).

10. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

11. See generally *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

12. *Gordon*, 897 F.3d at 1190.

13. *Id.*

14. *Id.*

15. *Makaeff v. Trump Univ., LLC*, 715 F.3d 254, 261 (9th Cir. 2013).

16. *Gordon*, 897 F.3d at 1190.

The Rogers test was created in the case *Rogers v. Grimaldi*.<sup>17</sup> In *Grimaldi*, the actress Ginger Rogers alleged the movie title *Ginger and Fred* infringed on her name under the Lanham Act because it “gave the false impression that the film . . . was about her or sponsored by her.”<sup>18</sup> First, the Second Circuit considered whether the title of the film was artistically relevant to the underlying work.<sup>19</sup> It found that the names “Fred” and “Ginger” were not “arbitrarily chosen just to exploit the publicity value of their real life counterparts” but actually had “genuine relevance to the film’s story.”<sup>20</sup> The court considered whether the title explicitly misled consumers as to the source of the film’s content.<sup>21</sup> It found that the movie title did not explicitly mislead consumers because there was no indication that Rogers had endorsed the film or had participated in the film’s production.<sup>22</sup> After considering both elements, the court concluded that any risk the title had in misleading the audience was “outweighed by the danger that suppressing an artistically relevant though ambiguous title [would] unduly restrict expression.”<sup>23</sup> Following the Second Circuit’s decision concerning trademarks in *Grimaldi*, the Rogers test has since been applied to five Ninth Circuit trademark infringement cases.<sup>24</sup> In each Ninth Circuit opinion, the court concluded that the Rogers test barred trademark infringement claims as a matter of law.<sup>25</sup>

The Ninth Circuit first employed the Rogers test in *Mattel, Inc. v. MCA Records, Inc.*<sup>26</sup> In this case, Mattel claimed the use of the word “Barbie” in the song entitled “Barbie Girl” infringed on the company’s Barbie brand.<sup>27</sup> After applying the first prong of the Rogers test, the court found that using Barbie in the song’s title was artistically relevant to the underlying work because the song revolved around the Barbie brand and the values the band claims she represents.<sup>28</sup> Considering the second prong of the Rogers test, the court concluded that “[t]he *only* indication that Mattel might be associated with the song [was] the use of Barbie in the

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17. *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d Cir. 1989).

18. *Gordon*, 897 F.3d at 1191.

19. *Grimaldi*, 875 F.2d at 1001.

20. *Id.*

21. *Id.*

22. *Id.*

23. *Id.* at 1191.

24. *Id.*

25. *Id.*

26. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901 (9th Cir. 2002).

27. *Id.* at 899.

28. *Id.* at 902.

title,” but that kind of minor use of a mark alone is not enough to satisfy the second prong.<sup>29</sup> Thus, because the Barbie logo is artistically relevant to the song and not explicitly misleading, the court held that the band was not liable for trademark infringement.<sup>30</sup>

Recently, in *Twentieth Century Fox Film Corp. v. Empire Distribution, Inc.*, the Ninth Circuit employed the Rogers test to determine whether the title of the television show “Empire” infringed on the name of the record label Empire Distribution.<sup>31</sup> The Ninth Circuit held that Fox’s show title did not infringe under the Rogers test.<sup>32</sup> First, the court considered Fox’s purpose in using the word “Empire” for the show.<sup>33</sup> The court found that the use was artistically relevant because the show is set in New York (the Empire State) and the plot revolved around an entertainment corporation (a figurative empire).<sup>34</sup> Under the second prong, Empire Distribution did not provide sufficient evidence demonstrating that Fox tried to “explicitly mislead consumers” nor did the show contain any overt claims or explicit references to the record label.<sup>35</sup> Therefore, the court concluded that the title of the television show did not infringe on the record label’s name.<sup>36</sup>

In *Brown v. Electronic Arts, Inc.*, NFL football player Jim Brown filed a claim against Electronic Arts, Inc. (EA) under the Lanham Act section 43(a) after the company used his likeness in a football themed video game.<sup>37</sup> Using the Rogers test, the Ninth Circuit found that it was “obvious that Brown’s likeness ha[d] at least some artistic relevance to EA’s work” because Brown is a well-known football player.<sup>38</sup> Moreover, Brown failed to satisfy the second prong of the Rogers test because “EA did not produce a game called Jim Brown Presents Pinball with no relation to Jim Brown or football beyond the title.”<sup>39</sup> Instead, the company “produced a football game featuring the likeness of thousands of current and former NFL players.”<sup>40</sup> The court further explained that the use of

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29. *Id.*

30. *Id.*

31. *Twentieth Century Fox Film Corp. v. Empire Distribution, Inc.*, 875 F.3d 1192, 1196 (9th Cir. 2017).

32. *Id.*

33. *Id.* at 1197.

34. *Id.* at 1198.

35. *Id.* at 1199.

36. *Id.*

37. *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1238-39 (9th Cir. 2013).

38. *Id.* at 1243.

39. *Id.* at 1244.

40. *Id.*

Brown's likeness in the game would not lead users of the game to believe that Brown was somehow behind the [game] as a sponsor or promotor.<sup>41</sup>

These cases allowed the Ninth Circuit to evaluate the boundaries of the Rogers test. In each aforementioned case, the plaintiff's infringement claim failed and subsequently did not present a triable issue of fact.<sup>42</sup> Yet, if a plaintiff is able to prove a valid trademark and demonstrate a likelihood-of-confusion, then the issue may go to a jury to determine whether the mark is artistically relevant to the description or whether the mark explicitly misleads the public.<sup>43</sup>

### III. COURT'S DECISION

In 2011, Christopher Gordon created a protected YouTube video entitled "The Grazy Nastyass Honey Badger."<sup>44</sup> In the video, Gordon repeats the HBDC and HBDGS phrases while *National Geographic* footage reels flash clips of honey badgers hunting and eating.<sup>45</sup> Following the success of the videos, Gordon developed a line of goods using both phrases.<sup>46</sup> The products were sold online and through national retailers including Wal-Mart, Target, Urban Outfitters, and Hot Topic.<sup>47</sup> Gordon registered only the HBDC phrase with the United States Patent and Trademark Office under International Class 16 for greeting cards; however, Gordon never secured registration for the HBDGS phrase.<sup>48</sup>

In 2012, Gordon hired licensing agent, Paul Leonhardt, to execute a licensing agreement with Gordon for honey-badger themed greeting cards.<sup>49</sup> The parties met with Drape Creative to pitch the idea.<sup>50</sup> After several exchanges about possibly executing a licensing agreement with Gordon, Drape Creative declined and developed its own line of unlicensed honey-badger greetings cards.<sup>51</sup> In 2015, Gordon brought suit for trademark infringement under the Lanham Act.<sup>52</sup>

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41. *Id.* at 1245.

42. *Id.*

43. *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184, 1196 (9th Cir. 2018).

44. *Id.* at 1187.

45. *Id.*

46. *Id.*

47. *Id.*

48. *Id.* at 1187-88.

49. *Id.* at 1188.

50. *Id.*

51. *Id.*

52. *Id.* at 1186. *See generally* 15 U.S.C. § 1051 (2002).

The District Court for the Central District of California granted summary judgment for Drape Creative.<sup>53</sup> In the noted case, the Ninth Circuit reversed and remanded the district court's decision, concluding that a jury could find that Drape Creative's greeting cards did not add any artistic value but merely appropriated the goodwill already attached to Gordon's mark.<sup>54</sup> The court found that the facts in the case demonstrated the test's "outer limits."<sup>55</sup> Unlike previous trademark infringement cases in which a reasonable jury could not have found a genuine issue of material fact on either prong of the test, the noted case established a fact pattern that created a triable issue of fact as to whether the use of Gordon's trademark in the greeting cards was artistically relevant.<sup>56</sup>

The court found that Drape Creative met its initial burden of demonstrating that its greeting cards are expressive works protected under the First Amendment.<sup>57</sup> The Ninth Circuit refers to other cases in which it decided that "[a greeting] card certainly evinces '[a]n intent to convey a particularized message'" and that greeting cards "considered as a whole, represent tangible expression[s] of an idea."<sup>58</sup> Since Drape Creative demonstrated that its greeting cards were protected under the First Amendment, the burden then shifted to Gordon to raise a triable issue of fact to at least one prong of the test.<sup>59</sup>

The first prong of the Rogers test requires evidence that Drape Creative's use of Gordon's mark was not "artistically relevant" to its greeting cards.<sup>60</sup> Artistic relevance applies not only to the relevance of a mark to a corresponding work, but also whether the mark is relevant to the defendant's own artistry.<sup>61</sup> The use of the mark is irrelevant if the defendant uses it to "merely [] appropriate the goodwill inhering in the mark."<sup>62</sup> The "level of artistic relevance of the trademark . . . to the work

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53. *Gordon*, 897 F.3d at 1187.

54. *Id.*

55. *Id.* at 1193.

56. *Id.* at 1193-94.

57. *Id.* at 1194.

58. *Id.*; *Hilton v. Hallmark Cards*, 599 F.3d 894, 904 (9th Cir. 2010) (quoting *Spence v. Washington*, 418 U.S. 405, 410-11 (1974) (per curiam)); see also *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970) (holding that plaintiff's greeting cards as a whole, "represent[ed] a tangible expression of an idea" and hence were copyrightable).

59. *Gordon*, 897 F.3d at 1194.

60. *Id.*

61. *Id.*

62. *Id.*; see *Parks v. LaFace Records*, 329 F.3d 437, 453 (6th Cir. 2003) (finding genuine issue of material fact on artistic-relevance inquiry, where "it would not be unreasonable to conclude that the title *Rosa Parks* is not relevant to the content of the song in question").

merely must be above zero.”<sup>63</sup> In order for the artistic relevance to be above zero, the mark must “both relate to the defendant’s work and the defendant must add his own artistic expression beyond that represented by the mark.”<sup>64</sup> The court used Andy Warhol’s painting of Campbell soup cans as an example of a transformative work where an artist added personal, artistic expression to the original.<sup>65</sup> The court explained that the public would not believe that Warhol was selling soup but rather his own art.<sup>66</sup> Here, the court concluded that the honey-badger catchphrase is certainly relevant to the greeting cards because the phrase is a “punchline on which the cards’ humor turns.”<sup>67</sup>

Under the second element of the Rogers test, the court posits that Drape Creative may have merely appropriated the goodwill from Gordon’s marks without adding any of its own artistic creativity.<sup>68</sup> In fact, Drape Creative’s president, who claims to have created the cards, did not have an explanation as to what the inspiration was and claimed to have never seen Gordon’s video.<sup>69</sup>

The court notes that the use of the HBDC or HBDGS phrases is “not a non sequitur” as the phrases make sense in the context of the greeting cards.<sup>70</sup> In fact, a jury could conclude that the cards apply the catchphrases in different ways from Gordon, allowing Drape Creative to successfully meet the artistically relevant threshold on one or more of the cards.<sup>71</sup> Yet, the Ninth Circuit considered evidence suggesting Drape Creative’s use of the phrases in the same way Gordon himself had been using them—to make sarcastic, humorous greeting cards with the idea that “Honey Badger don’t care.”<sup>72</sup> The court explains that a jury could find that Drape Creative’s cards were only understandable in relation to Gordon’s YouTube video, signaling that the cards “deliberately trade on the goodwill associated with [Gordon’s] brand.”<sup>73</sup>

In remanding the case, the Ninth Circuit advised that the district court instruct the jury that Drape Creative has shown that its greeting cards are protected under the First Amendment and that Gordon must now prove an

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63. *Gordon*, 897 F.3d at 1194.

64. *Id.* at 1195.

65. *Id.*

66. *Id.*

67. *Id.* at 1194.

68. *Id.* at 1195.

69. *Id.*

70. *Id.*

71. *Id.*

72. *Id.* at 1196.

73. *Id.*

additional element to succeed on his claim.<sup>74</sup> In essence, “the jury may only find for Gordon if he proves by a preponderance of the evidence that [Drape Creative’s] use of his mark is (1) not artistically relevant to their greeting cards or (2) explicitly misleading as to the source or content of the cards.”<sup>75</sup> Ultimately, Gordon will need to prove both a likelihood of confusion and at least one of the test’s elements.<sup>76</sup> The Ninth Circuit also noted that the second element was not discussed because it was able to find a triable issue of fact as to the first element of the test.<sup>77</sup>

#### IV. ANALYSIS

The holding in *Gordon* is significant because it is the first time the Ninth Circuit has not barred a trademark infringement claim under the Rogers test.<sup>78</sup> In fact, the court states that, “on every prior occasion in which we have applied the test, we have found that it barred an infringement claim as a matter of law” but that the noted case presents a triable issue of fact.<sup>79</sup> Accordingly, by reversing and remanding the issue to a jury, the court effectively expands the boundaries of the test.<sup>80</sup>

Utilizing juries, specifically for trademark infringement claims, is likely the optimal method of striking a balance between the protective nature of the Lanham Act and free expression granted by the First Amendment.<sup>81</sup> As de facto consumers themselves, jury members can accurately deliberate on whether a trademark is artistically relevant to an underlying work and/or if a mark is likely to confuse a consumer as to the source of a work’s content.<sup>82</sup> As aforementioned by the court, “[s]imply using the mark is not enough.”<sup>83</sup> “There must be something else about the cards that explicitly misleads consumers into believing that Gordon sponsored or is associated with the cards,” and a jury of consumers presumably is in the best position to decide.<sup>84</sup>

Moreover, current and future plaintiffs with trademark infringement claims will likely benefit from this decision. There is now precedent from

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74. *Id.*

75. *Id.*

76. *Id.*

77. *Id.* at 1190.

78. *Id.* at 1187.

79. *Id.*

80. *Id.* at 1193.

81. *Id.* at 1190.

82. *Id.* at 1196.

83. *Id.*

84. *Id.*

an appellate court explaining the threshold needed for a plaintiff to overcome summary judgment and create a triable issue of fact.<sup>85</sup> Prior to *Gordon*, there has not been a clear standard explaining to plaintiffs how to overcome summary judgment under the test, since a case with a genuine issue of material fact had never arisen.<sup>86</sup>

Nevertheless, this decision could result in inconsistent outcomes. As with any case involving a jury, bias or outside influences may affect jury verdicts. This could leave a defendant at the mercy of capricious and fickle jury members, which would inevitably lead to varying results. Moreover, although the Ninth Circuit provided the district court with jury instructions to administer, the effectiveness of those instructions on a jury remains unclear.<sup>87</sup> Juries may become confused by the instructions or may encounter problems in applying the court's instructions. For example, a jury may struggle with applying the meaning of legal concepts like "artistically relevant" or understanding the threshold for a mark that "explicitly mislead[s] consumers."<sup>88</sup> Because of these potential issues, the results from juries may not produce consistent results. Although consistency is important in all cases, it is critical in infringement cases because First Amendment rights are being subjected to restriction.

Even so, the Ninth Circuit's opinion in *Gordon* will allow a court to better balance the goals of the Lanham Act and the First Amendment.<sup>89</sup> As unreliable as juries may be, at the crux of the test are the opinions and perspectives of consumers.<sup>90</sup> A jury made up of actual, day-to-day consumers is decidedly the best group of individuals to determine whether a mark at issue constitutes trademark infringement. Ultimately, the noted case serves as a guidepost for courts throughout the United States regarding the utilization of juries in trademark infringement claims.

Jacqueline Suh\*

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85. *Id.* at 1190.

86. *See generally id.*

87. *Id.* at 1196.

88. *Id.*

89. *Id.* at 1190.

90. *Id.*

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