

Sneakers, the Shoes that Talk the Talk and Walk the
Walk: How *Jack Daniel’s Properties, Inc. v. VIP
Products* Left its Footprint on Trademark Law and the
Sneaker Industry

*Nitya Tolani**

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INTRODUCTION

Do you remember the first pair of sneakers you ever purchased? For some, their first pair may have been a colorful, light-up pair of Skechers for the first day of kindergarten. Or maybe a fresh pair of Converse Chuck Taylor All Stars for a new year of grade school. Further along the timeline, teens and adults have popularized the Nike Air Force 1s, Nike Dunks, and the Adidas Sambas.¹ Every year, trends in the sneaker industry turn based on events in popular culture, influxes of new and eager designers who seek to contribute to the market,² and demands by consumers for quality crafted footwear that balances fashion and function.³ However, as trends have come and gone, one thing about sneakers has certainly remained the same; sneakers function as a form of self-expression.⁴

As the fashion industry—including the sneaker industry housed within it—continues to go through the motions of collectively flocking

* 3L JD Candidate, Seattle University School of Law; Executive Editor of Lead Articles, Seattle University Law Review, Volume 47. A special thank you to my parents: my father, Sunil Tolani, the inspiration behind every great pair of shoes I've ever worn, and my mother, Reshma Tolani, the inspiration behind everything I write. I also thank Milan and Cody Tolani for always encouraging my creativity, the talented editors of the Seattle University Law Review for their comments and suggestions, and the Volume 47 Executive Board for their support and friendship.

1. Taylor Trudon, *What Is the Best Sneaker, According to Gen Z?*, N.Y. MAG.: STRATEGIST (Aug. 27, 2020), <https://nymag.com/strategist/article/best-sneaker-for-teens-gen-z.html> [<https://perma.cc/G44Y-FYKN>]; Alice Cary, *The It-Girls' Favorite Sneakers Have History*, VOGUE (Oct. 20, 2023), <https://www.vogue.com/article/adidas-sambas-history> [<https://perma.cc/8HUF-NXHA>].

2. See Tres Dean, *These Were the Best Sneakers of 2022*, HIGHSNOBIETY (2023), <https://www.highsnobiety.com/p/best-sneakers-2022/> [<https://perma.cc/4V87-Z3EG>].

3. See Charles Etoroma, *Here's Why New Balance Is Dominating Right Now*, HIGHSNOBIETY (2023), <https://www.highsnobiety.com/p/heres-new-balance-dominating-right-now/> [<https://perma.cc/9W4R-28UZ>].

4. See Delisia Matthews, Qiana Cryer-Coupet & Nimet Degirmencioglu, *I Wear Therefore I Am: Investigating Sneakerhead Culture, Social Identity, and Brand Preference Among Men*, 8 INT'L J. INTERDISC. RSCH., 1, 11 (2021).

towards certain styles and practices to create a trend, letting that trend fade out, and then collectively flocking again to the newest innovations in the world of wearables, the landscape of laws to protect and promote those innovations expands as well, mainly in the area of intellectual property law.⁵ Although copyright, trademark, and patent law can cover innovations in the fashion industry,⁶ this Note centers its analysis on trademark law. Trademark law has been through notable change in recent years because of the United States Supreme Court's 2023 decision in *Jack Daniel's Properties, Inc. v. VIP Products LLC*.⁷ The holding in *Jack Daniel's* marked a new chapter of intellectual property jurisprudence, as indicated by the Court's limitation of the landmark case, *Rogers v. Grimaldi*, that set forth the modern expressive use test.⁸

Although *Jack Daniel's* did not pertain to the fashion industry, the Court's decision nonetheless impacted the sneaker industry because a Second Circuit case involving sneakers, *Vans, Inc. v. MSCHF Product Studio, Inc.*,⁹ was one of the first cases to apply the *Jack Daniel's* holding. This Note takes particular interest in the sneaker industry's strong cultural roots and customs and how recent changes in trademark jurisprudence have and will continue to operate in the sneaker industry. First, this Note argues that, based on the rule in *Jack Daniel's* that limits access to the *Rogers* test for First Amendment-protected expressive use, and its application to the *Van's* sneaker case, the *Jack Daniel's* rule will limit speech that is embedded into sneakers and similar consumer goods where the good itself is an expression of speech. This Note further argues that, in sneaker cases specifically, the new *Jack Daniel's* rule has the potential to preclude inquiries in *Rogers* that serve as an important buffer for defendants to have a chance at prevailing in expressive use cases.

Part I offers a historical analysis of the sneaker industry and sneaker culture. It begins by detailing the sneaker industry's emergence, starting with the Converse company, and tracking its development through

5. See C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1148–49 (2009).

6. See Francesca M. Witzburg, *Fashion Forward: Fashion Innovation in the Era of Disruption*, 39 CARDOZO ARTS & ENT. L.J. 705, 708–16 (2021).

7. *Jack Daniel's Properties, Inc. v. VIP Products LLC*, 599 U.S. 140, 163 (2023) (concluding that the parodic use of another's trademark as one's own on a commercial product is subject to the Lanham Act's "likelihood of confusion" analysis, not the threshold *Rogers* test, and is not automatically excluded from a claim of trademark dilution) (referencing *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989)).

8. *Rogers*, 875 F.2d at 997–1001. Under the *Rogers* test, when a trademark infringement claim targets expressive work, the claim must be dismissed unless the complainant can show either (1) that the challenged use of a mark "has no artistic relevance to the underlying work" or (2) that it "explicitly misleads as to the source or the content of the work." *Id.* at 999.

9. See generally *Jack Daniel's Properties, Inc. v. VIP Products LLC*, 599 U.S. 140 (2023); *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 88 F.4th 125 (2d Cir. 2023).

increased interactions between sports and shoe brands. Part I also notes that although the industry's inception was tied to popular culture and controversy, its growth was fueled by collaboration with popular figures in the media and by customization.

Part II details the legal foundations in trademark law that apply to the sneaker industry, starting with the roots of trademark law and what has driven its growth as a body of law. It also explains how the expansion of the retail industry, including the sneaker market, has advanced trademark law's growth. This section then highlights the key provisions of the main statute that guides trademark law, the Lanham Act, including the provisions for infringement, Section 43(a) claims, and trademark dilution. Lastly, Part II illustrates how sneaker companies have utilized these rules.

Part III discusses the parameters of trademark law "fair use" situations—whereby the law permits the use of another's mark in their work—and notes how these uses have operated in the sneaker industry. Relatedly, this section analyzes the "expressive use" of another's trademarks, which can be protected as free speech by the First Amendment and highlights the relevant expressive use case law such as the quintessential *Rogers v. Grimaldi* and the recently decided *Jack Daniel's Properties, Inc. v. VIP Products LLC* cases.

Part IV explains the application of *Jack Daniel's* in *Vans Inc., v. MSCHF Product Studios, Inc.* as one of the first cases, a sneaker case at that, to do so. This section posits that *Vans, Inc.* exemplifies the pitfalls of applying *Jack Daniel's* to sneaker cases and, broadly, other consumer goods that act as vehicles for speech. It first argues that the application of *Jack Daniel's* can severely limit speech in expressive use cases when a consumer good is both a vehicle for speech and a product out for sale on the market. It also argues that in the context of the sneaker industry, the application of *Jack Daniel's* can prevent inquiries in the *Rogers* test, which can be important for defendants in expressive use cases.

Part V concludes by describing potential solutions on how to navigate the application of *Jack Daniel's* in the sneaker industry, and potentially when dealing with other consumer goods that act as vehicles for expression in expressive use cases. Part V proposes a potential new inquiry that seeks to reveal what the *intended* speech was and whether the same speech can have the same effect without the good as a vehicle. This inquiry would help to determine if the court should skip or apply the rule in *Jack Daniel's*. Another proposed solution explores the possibility of a transformative use-centered inquiry inspired by copyright law that could prove especially helpful to customizers in the sneaker industry.

I. AN INTRODUCTION TO THE SNEAKER INDUSTRY

To understand how trademark doctrines can operate in the sneaker industry, it is first helpful to understand how the industry came about and what drives its growth.

A. The Origins of the Sneaker Industry and Sneaker Culture

In 1908, the Converse Rubber Shoe Company was founded by Marquis Mills Converse, who subsequently produced the first Converse All Star sneaker in 1917.¹⁰ The Converse All Star later became the Chuck Taylor All Star following basketball player Chuck Taylor's involvement with the Converse company.¹¹ Converse All Star sneakers were the predominant sneaker, particularly in the basketball shoe market, until the later 1960s, after which a variety of brands came out with variations of basketball shoes.¹² Former professional basketball player and hip-hop journalist Bobbito García noted that the early 1970s brought a shift in sneaker culture “as a response to the increased market presence of emerging companies, such as Adidas and Keds”¹³

As sports fanaticism increased in the United States, companies such as Nike began to take on new ventures in the sneaker market, most notably working with basketball star Michael Jordan in the 1980s to create the ever-popular Air Jordan sneakers.¹⁴ Even outside the realm of sports, sneaker brand Reebok began to expand their offerings of aerobic shoes to women, a market of consumers that Nike had not tapped into, to their detriment in terms of sales numbers.¹⁵ The sports scene was the key driver behind the popularization of sneakers, but social controversy may have also played a role in making sneakers more popular. For example, rap group Run DMC, who even had an Adidas sponsorship and a song called “My Adidas,” often wore their sneakers without laces; at the time this was a trend associated with prison culture because inmates could not own shoelaces out of fear they could be used as weapons.¹⁶ In addition, as sneakers became a “status symbol” in the late 1980s and early 1990s, there were

10. Dylan A. T. Miner, *Provocations on Sneakers: The Multiple Significations of Athletic Shoes, Sports, Race and Masculinity*, 9 NEW CENTENNIAL REV. 73, 78 (2009).

11. *See id.*

12. *See id.* at 79–80.

13. *Id.* at 81.

14. Kate Keller, *A Brief History of America's Obsession with Sneakers*, SMITHSONIAN MAG. (May 18, 2018), <https://www.smithsonianmag.com/innovation/brief-history-americas-obsession-sneakers-180969116/> [<https://perma.cc/267V-243J>].

15. *Id.*

16. *Id.*

fears that increases in crime rates overall could be attributed, at least in part, to crimes related to sneaker theft.¹⁷

Despite these early controversies, sneaker growth has continued—both then and now—particularly through collaboration between brands, artists, and athletes.¹⁸ The industry has grown to the extent that the term “sneakerhead” emerged to describe those who “collect, trade, and/or admire sneakers . . . and are knowledgeable about the history of sneakers, and are passionate about the nostalgic factors the sneakers possess.”¹⁹

B. How Sneaker Culture Grows

One of the fundamental ways that sneaker culture has grown is through formal or informal collaboration with figures such as athletes and musicians.²⁰ For example, musician Rihanna’s collaboration with Puma and rapper Kanye West’s work with both Nike and Adidas created an intersection between the sneaker market and music that invited new participants into sneaker culture.²¹

Another way that the sneaker industry has grown is through customization.²² Customization also has historical roots in sneaker culture; in the 1990s and 2000s, sneakerheads took existing sneakers and produced their own variations to put out into the market, one of the first being Bobbito García.²³ García began by selling painted Nike Air Force 1s.²⁴ Artist and streetwear customizer Methamphibian followed suit by selling hand-painted Nike Dunks.²⁵ Other customization pioneers include Raif Adelberg, who sold customized and “chopped up” Air Force 1s, JBF Customs, who incorporated luxury materials into sneakers, and the Shoe Surgeon.²⁶

Changes to iconic sneaker silhouettes have also been a form of artistic, social, and political expression for artists, customizers, and activists.²⁷

17. *Id.*

18. *See id.*

19. *See* Matthews, Cryer-Coupet & Degirmencioglu, *supra* note 4, at 2.

20. Adrienne Howell, *A History of Sneakers: How They Became Staples of Modern Fashion*, COLLECTOR (Jan. 25, 2021), <https://www.thecollector.com/evolution-of-sneakers-modern-fashion-collecting/> [https://perma.cc/9628-FQFH].

21. *See id.*

22. *See generally* Gunner Park, *Custom Sneakers: What Separates the Good from the Bad from the Ugly?*, HIGHSNOBIETY (2020), <https://www.highsnobiety.com/p/custom-sneakers-good-bad-ugly/> [https://perma.cc/46Y6-3SWV].

23. *Id.*

24. *Id.*

25. *Id.*

26. *Id.*

27. *See* Brandon Wallace & David L. Andrews, *Decolonizing the Sneaker: Sneaker Customization and the Racial Politics of Expressive Popular Culture*, 46 J. SPORT & SOC. ISSUES 524, 535 (2022).

Brandon Wallace and David L. Andrews noted in their article in which they interviewed fifteen racially marginalized sneaker customizers that:

Sneaker customizers aimed to establish [cultural] significance through a number diverse and creative methods. Some participants used customized sneakers to “give back” to a certain community of interest, whether that was a traditional social community left behind by racial capitalism Sometimes these decolonizing efforts were done directly through customizing shoes in efforts to empower urban youth and increase self-esteem. At other times, sneakers were customized in a way to signal and promote group identity, as well as to show solidarity with certain groups based on political, ethnic, or regional affiliations.²⁸

While some customizers are attuned to trends and are focused on profiting off of popular customizations—rather than making contributions to the growth of sneaker culture—other customizers, like Guatemalan artist Joshua Vides, have turned sneakers into an art form.²⁹ Vides, who began with Sharpie designs on sneakers, secured a collaboration with Converse.³⁰ Customizations have become an art form “that tell a story and retain a personal significance,” as shown by BespokeIND’s take on the Nike SB Dunk Low.³¹ In their twist on the Dunk, they use various textiles to create a shoe that is reminiscent of their brand and, interestingly, allows Lego pieces to be attached directly to the shoe.³² As far as customizations go, “[t]hey inspire brands and individuals alike to continue innovating. Whether it be exceptional construction, a unique design process, or an attempt to communicate a compelling narrative, there is no doubt that outstanding custom designs will continue to flood the marketplace.”³³ These examples of how customizers have utilized the iconic sneaker silhouettes and incorporated them into their own styles to create new works of art and forms of expression allude to potential disputes in the trademark law space regarding the incorporation of famous marks into new shoes.

II. SETTING THE LEGAL STAGE FOR THE APPLICATION OF TRADEMARK LAW TO THE SNEAKER INDUSTRY

In one of the earliest reported trademark cases in the federal courts, in 1844, a thread manufacturer from England, J. & W. Taylor, sought to prevent another thread manufacturer from using its name and labeling on

28. *Id.*

29. *See* Park, *supra* note 22.

30. *Id.*

31. *Id.*

32. *Id.*

33. *Id.*

their inferior product and thus benefitting from J. & W. Taylor's goodwill and reputation.³⁴ The court there established that using another's mark "with the intention of supplanting them in the good will of their trade and business" was key in liability for infringement.³⁵

From its simple roots in a case about thread, trademark law has since grown exponentially. While common law has been the foundation of the growth of trademark law, statutory protections have also been essential for trademark rights; such provisions began with the first federal trademark statute in 1870³⁶ and expanded to the adoption of the Lanham Act of 1946, which continues to govern trademark infringement cases today.³⁷

However, outside the boundaries of formal legal decisions and statutory protection, market changes have also caused significant growth in trademark law.³⁸ The growth of the retail industry increased the need for consumers to be able to distinguish between the same types of products coming from different sources, and the need for producers of goods to set their products and quality apart from others and increase their goodwill among consumers.³⁹ Included in this growth of the retail industry is the growth of the sneaker market. In 2019, an article from *Women's Wear Daily* noted that "[t]he global sneaker market stood at \$58 billion in 2018 and [was] projected to grow at a compound annual growth rate of more than 7 percent between 2019 and 2024, reaching \$88 billion"⁴⁰ It follows that in this market, the increased consumer demand for sneakers and the increased supply of sneakers have heightened the importance of trademark law as brands seek to protect their footwear innovations and set themselves apart from others.

Not only have retail market changes pushed the boundaries of trademark law, but social attitudes related to self-expression through choices of clothing, footwear, and fashion have also occurred.⁴¹ The surge in interest and use of this type of expression—often intertwined with the retail industry and branding—has created interesting issues within the trademark

34. See *Taylor v. Carpenter*, 11 Paige Ch. 292, 292–94 (N.Y. Ch. 1844); Beverly W. Pattishall, *Two Hundred Years of American Trademark Law*, 68 TRADEMARK REP. 121, 123 (1978).

35. See *Taylor*, 1844 WL 4364 at 298.

36. Pattishall, *supra* note 34, at 129.

37. See generally 15 U.S.C. §§ 1051–1129 (2004).

38. See Christine Haight Farley, *Trademarks in an Algorithmic World*, 98 WASH. L. REV. 1123, 1141–45 (2023).

39. *Id.* at 1126.

40. Tianwei Zhang, *Luxury Brands Are Running Fast with the Sneaker Trend*, WOMEN'S WEAR DAILY (Aug. 13, 2019), <https://wwd.com/fashion-news/fashion-features/luxury-sneakers-are-here-stay-1203229173/> [perma.cc/BC8N-9JF5].

41. See Rabiya Singh, *Fashion as Tool for Freedom of Expression*, FASHION & L.J. (May 13, 2021), <https://fashionlawjournal.com/fashion-as-a-tool-for-freedom-of-expression/> [https://perma.cc/Z6TK-4YG5].

space regarding how the law should treat the use of one's trademark in another's work or goods as a form of self-expression.

It can be helpful, before delving into recent cases that have touched the sneaker industry, to evaluate the current statutory foundation of trademark law in the Lanham Act and how the protections of the Lanham Act have been utilized by various trademark owners in the sneaker industry. It is equally crucial to understand the case law that provides important rules pertaining to trademark infringement and First Amendment-protected expressive use because of how these cases have come to apply to sneakers and similar goods that have a dual function as a vehicle for speech and expression and as a good available out in the retail market.

A. The Lanham Act

The Commerce Clause granted Congress the authority to create the Lanham Act,⁴² which was enacted in 1947 and effectively codified and “federalize[d]” trademark common law.⁴³ The Lanham Act contains two notable policy-based protections: protection of the consumer from confusion and protection of the trademark owner from having their trademark infringed upon.⁴⁴ More concretely, the Lanham Act protects trademarks, which generally encompass words, names, symbols, devices, or other designations used in commerce to distinguish the owner's goods or services from those of others.⁴⁵ Protection may also be extended to a product's color, colorway, texture, shape, or graphics; this is known as trade dress.⁴⁶

1. Trademark and Trade Dress Infringement

The Lanham Act provides protection against the infringement of those marks that have been registered with the U.S. Patent and Trademark Office and those that have not been registered.⁴⁷ To determine if trademark infringement has occurred, the court employs a likelihood of confusion test.⁴⁸ This test is factor-based and determines if there is a likelihood of

42. See U.S. CONST. art. I, § 8, cl. 3 (“Congress shall have the Power . . . to regulate Commerce with foreign Nations, and among the several States, and with the Indian tribes.”).

43. Kelly L. Baxter, *Trademark Parody: How to Balance the Lanham Act with the First Amendment*, 22 SANTA CLARA L. REV. 1179, 1181–82 (2004).

44. See *id.*

45. See 15 U.S.C. § 1127 (2006).

46. Andy Nikopoulos, *Trademark and Brand Protection: Don't Miss an Opportunity to “Trade Dress” for the Part*, JD SUPRA (Dec. 8, 2020), <https://www.jdsupra.com/legalnews/trademark-and-brand-protection-don-t-45580/> [<https://perma.cc/4Q88-HLN5>]; *What is a Trademark?*, HARV. OVERVIEW OF TRADEMARK L., <https://cyber.harvard.edu/metaschool/fisher/domain/tm.htm> [<https://perma.cc/PCA5-6UAQ>].

47. 15 U.S.C. §§ 1114, 1125 (2004).

48. Baxter, *supra* note 43.

confusion as to the source, sponsorship, or affiliation of a good.⁴⁹ Although the factors considered can depend on the court,⁵⁰ the factors articulated by the Ninth Circuit in *Sleekcraft* encompass some of the most important considerations across the board.⁵¹ The factors include:

1. strength of the mark;
2. proximity of the goods;
3. similarity of the marks;
4. evidence of actual confusion;
5. marketing channels used;
6. type of goods and the degree of care likely to be exercised by the purchaser;
7. defendant's intent in selecting the mark; and
8. likelihood of expansion of the product lines.⁵²

Once likelihood of confusion has been established through this factor analysis, there is liability for trademark infringement, even if confusion was created "unintentionally or accidentally."⁵³

In trade dress infringement actions, in addition to proving likelihood of confusion, the plaintiff has the burden of proving that their trade dress is non-functional or non-essential to the use or purpose of the good and that it is either inherently distinctive or has acquired secondary meaning.⁵⁴ Inherent distinctiveness is based on the ability of the trade dress in question to identify the source of the product.⁵⁵ Secondary meaning, on the other hand, can effectively create distinctiveness when "in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself."⁵⁶

Trademark infringement actions under the Lanham Act are no stranger to the sneaker industry, especially for sneaker giants such as Nike.⁵⁷ In fact, in a recent legal battle between Nike and streetwear brand

49. *What Constitutes Trademark Infringement?*, HARV. OVERVIEW OF TRADEMARK L., <https://cyber.harvard.edu/metaschool/fisher/domain/tm.htm> [<https://perma.cc/PCA5-6UAQ>].

50. Alfred C. Yen, *Intent and Trademark Infringement*, 57 ARIZ. L. REV. 714–15 (2015).

51. *See* AMF Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979), *abrogated by* Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792 (9th Cir. 2003).

52. *Id.* at 348–49.

53. Yen, *supra* note 50, at 714.

54. Michael Baak & Eric Torres, *How to Prove or Disprove Trade Dress Infringement*, CORNELL UNIV. L. SCH. SOC. SCI. & L., https://courses2.cit.cornell.edu/sociallaw/student_projects/Trade-dress.htm [<https://perma.cc/TQY9-ZN9L>] (last visited Apr. 1, 2024).

55. *Id.*

56. *Id.* (alteration in original) (quoting Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 209 (2000)).

57. Matthew Kish & Danni Santana, *Nike Is Doubling Down on Litigation in a Fierce Battle to Protect Its Patents and Trademarks. Here's Every Brand It Has Sued in Recent Years*, BUS. INSIDER (Mar. 1, 2023), <https://www.businessinsider.com/brands-nike-has-sued-litigation-protect-trademarks-patents-2023-3#gnarcotic-3> [<https://perma.cc/NP5V-8CZ5>].

Kool Kiy, Kool Kiy accused Nike of being a “trademark troll” that used trademark litigation to “broaden its illegitimate dominion over how others design sneakers.”⁵⁸

2. Section 43(a) Claims

Section 43(a) of the Lanham Act is a key provision used to bring various unfair competition claims.⁵⁹ In addition to unregistered trademark infringement, Section 43(a) also provides a basis for false advertisement, false designation of origin, and false endorsement.⁶⁰ Most pertinent to the sneaker industry are false designation of origin claims.

Section 43(a) prohibits the false designation of the origin of a product, with most claims coming in the form of “passing off”—passing the defendant’s goods off as those of the plaintiff.⁶¹ The defendant can do so by impliedly or expressly misrepresenting that its goods are the goods of the plaintiff, despite disparities in quality.⁶²

Sneaker companies like New Balance have included Section 43(a) claims as part of trademark infringement lawsuits against other sneaker makers.⁶³ In 2023, New Balance brought a false designation of origin claim against Golden Goose, alleging that Golden Goose used a confusingly similar design, employed similar marketing strategies, mimicked New Balance core colorways, and named their product in such a way that consumers would be confused “as to the affiliation, connection, or association of Golden Goose with New Balance and/or as to the origin, sponsorship, or approval by New Balance of Golden Goose’s goods, services, or commercial activity.”⁶⁴ Here, New Balance’s use of a false designation claim acted as another avenue, in addition to the standard trademark and trade dress claim, to demonstrate consumer confusion.

58. Matthew Kish, *Nike Slammed as ‘Dictatorial’ and Called a ‘Trademark Troll’ as Legal Battle with Streetwear Brand Heats Up*, BUS. INSIDER (Feb. 16, 2023), <https://www.businessinsider.com/nike-called-trademark-troll-as-legal-battle-with-kool-kiy-heats-up-2023-2> [<https://perma.cc/7RB5-84TY>].

59. PRAC. L. INTELL. PROP. & TECH., LANHAM ACT SECTION 43(A) CLAIMS (Thomson Reuters ed. 2024).

60. *Id.*

61. *See id.*; 15 U.S.C. § 1125(a) (2012).

62. PRACTICAL L. INTELL. PROP. & TECH., *supra* note 59.

63. Nicholas Holmes, *Who’s Your Daddy? New Balance Claims ‘Dad-Star’ Sneaker Infringes on Its ‘Dad Shoe’ Trade Dress*, JD SUPRA (Oct. 20, 2023), <https://www.jdsupra.com/legalnews/who-s-your-daddy-new-balance-claims-dad-7652244/> [<https://perma.cc/F9GA-8CVU>].

64. *See* Complaint at 26–27, *New Balance Athletics, Inc. v. Golden Goose, USA, Inc.*, No. 1:23-cv-11898 (D. Mass. Aug. 18, 2023).

3. Trademark Dilution Revision Act of 2006

The Trademark Dilution Revision Act of 2006 (FTDA), Section 43(C) of the Lanham Act, provides protections for famous marks.⁶⁵ Trademark dilution is distinct from trademark infringement; trademark dilution “refers to the unauthorized use of and/or application for a trademark that is likely to weaken the distinctive quality of or harm a famous mark.”⁶⁶ A famous mark holder, notably the holder of a mark that is “widely recognized by the general consuming public of the United States,”⁶⁷ can allege a dilution claim in the form of blurring or tarnishment.⁶⁸ Dilution by blurring happens when the unauthorized use or association of a mark similar to the famous mark causes the famous mark’s distinctiveness to be impaired or weakened.⁶⁹ On the other hand, dilution by tarnishment happens when the unauthorized use or association of a mark similar to the famous mark causes reputational harm to the famous mark.⁷⁰ Even without any signs of likelihood of confusion or actual economic injury,⁷¹ the famous mark holder may prevail in a dilution claim so long as they can prove (1) that they have a distinctive and famous mark, (2) that the defendant’s use of the allegedly diluting mark is in commerce and after the plaintiff’s mark became famous, and (3) that the defendant’s use of the allegedly diluting mark is likely to dilute the plaintiff’s famous mark.⁷²

Especially in the context of the sneaker market, where famous, household brand names are faced with products or marks that can harm their reputations and existing goodwill, dilution claims can be an arguably less burdensome way to prevent the further circulation of the claimed diluting mark or good since there is no need to prove likelihood of confusion, competition, or actual economic injury.⁷³ Nike has undoubtedly taken advantage of the availability of dilution claims in its litigation history, notably in its lawsuit against the art collective company MSCHF.⁷⁴ In 2021,

65. See 15 U.S.C. 1125(c) (2012).

66. *Fact Sheet: Protecting a Trademark, Trademark Dilution (Intended for a Non-Legal Audience)*, INT’L. TRADEMARK ASSOC. (Nov. 9, 2020), <https://www.inta.org/fact-sheets/trademark-dilution-intended-for-a-non-legal-audience/> [<https://perma.cc/5N7N-8KGS>].

67. 15 U.S.C. § 1125(c)(2)(a) (2012).

68. *Fact Sheet: Protecting a Trademark*, *supra* note 66.

69. See 15 U.S.C. § 1125(c)(2)(B) (2012).

70. See *id.* § 1125(c)(2)(C) (2012).

71. See *id.* § 1125(c)(1) (2012).

72. GREGORY P. GULIA, VANESSA C. HEW, KAREN GOLDBERGER & COZEN O’CONNOR, PRAC. L. INTELL. PROP. & TECH., TRADEMARK INFRINGEMENT AND DILUTION CLAIMS, REMEDIES, AND DEFENSES (Thomson Reuters ed. 2024).

73. Sandra L. Riererson, *The Myth and Reality of Dilution*, 11 DUKE L. & TECH. REV. 212, 212 (2012).

74. See generally Nike, Inc.’s Memorandum of Law in Support of Its Motion for a Temporary Restraining Order & Preliminary Injunction, Nike, Inc. v. MSCHF Product Studio Inc. (2021), (No.

Nike alleged that MSCHF engaged in a “textbook case of dilution, by both blurring and tarnishment,” when it created the “Satan Shoes,” a customized, Satan-themed, human blood-infused Nike Air Max 97.⁷⁵ Nike claimed that, not only was its famous Swoosh mark’s distinctiveness being impaired, but the negative associations created by MSCHF’s use would cause harm to Nike’s reputation, evidenced by customers offended by the theme of the sneaker.⁷⁶

4. Other Areas of Intellectual Property Law

While this Note is centered on the way that trademark law operates in the context of the sneaker industry, it is worth noting how other areas of intellectual property law, copyright and patent law specifically, have provided protection in this industry. Copyright law can allow a designer to obtain protection over an original, minimally creative work that is “fixed in a tangible medium of expression.”⁷⁷ Although a copyright cannot protect a useful article with a utilitarian function like a sneaker, it can cover the artistic aspects of the sneaker that can be separated from the article itself.⁷⁸

Additionally, design patents have been helpful in the sneaker industry as they “protect[] the overall visual appearance of the design” and pertain to the appearance, configuration, shape, or surface ornamentation of a good,⁷⁹ or a combination of these things.⁸⁰ For example, the iconic Nike Air Jordan 1 is protected both under its trade dress and under a design patent for the ornamental appearance of the shoe. More specifically, features such as the “design of the material panels that form the exterior body of the shoe” and “the design of a stitched line running along the midsole of the shoe” are under this protection.⁸¹

1:21-cv-01679-EK-PK) <https://www.courthousenews.com/wp-content/uploads/2021/04/Nike-motion-for-TRO.pdf> [https://perma.cc/N5EM-UEHR].

75. *Id.* at 18.

76. *See id.* at 18–21.

77. Christopher V. Carani & Dunstan H. Barnes, *Designs—Protecting Fashion in the United States with IP Rights*, WORLD TRADEMARK REV. (Nov. 15, 2019), <https://www.worldtrademarkreview.com/global-guide/designs/2020/article/designs-protecting-fashion-in-the-united-states-ip-rights-dagg2020> [https://perma.cc/9SBV-58WL].

78. *See id.*

79. *Definition of a Design*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/patents/basics/types-patent-applications/design-patent-application-guide#def> [https://perma.cc/2L53-HG7M].

80. *The Difference Between Design and Utility Patents*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/patents/basics/types-patent-applications/design-patent-application-guide#def> [https://perma.cc/FY8J-JC2J].

81. Ian Servantes, *Nike Has Just Now Been Awarded a Patent and Trademark for the Air Jordan 1*, INPUT (June 11, 2021), <https://www.inverse.com/input/style/nike-has-only-now-been-awarded-a-patent-and-trademark-for-the-air-jordan-1> [https://perma.cc/V4QA-CAR9].

These other areas of intellectual property law supplement trademark protection by protecting the design and other innovative aspects of sneakers.

III. THE USE OF ANOTHER'S MARK—BALANCING TRADEMARK INTERESTS AND FREE SPEECH

Although the Lanham Act's broad protective purpose is to protect from various types of unauthorized uses of another's trademark,⁸² the use of another's trademark is permissible in certain situations. The use of another's mark in one's work may at times squarely fall into an exception such as the first sale doctrine, nominative fair use, or descriptive fair use; however, the expressive use exception, in particular, poses an important First Amendment consideration.⁸³

A. A Brief Overview of Trademark Fair Use Exceptions

First, an individual may resell goods under the first sale doctrine.⁸⁴ Although not a "use" of another's mark in a literal sense, the first sale doctrine permits a buyer to resell a good containing another's trademark since it is now in the stream of commerce.⁸⁵ However, a resale will nonetheless constitute trademark infringement if the good is materially different from that which the mark owner sells using the mark, if the mark owner's quality control measures are not met, or if the reseller misrepresents to consumers that they are sponsored, approved, or authorized by the mark owner.⁸⁶ This doctrine is particularly salient in the sneaker market where reselling platforms such as StockX and GOAT provide an accessible way for nearly anyone to earn money from reselling sneakers.⁸⁷

Second, an individual may engage in nominative fair use, based in both common law and statute,⁸⁸ that "permits users to accurately refer to a trademark in order to identify those goods or services without being labeled an infringer."⁸⁹ Thinking back to reseller platforms, nominative fair

82. See generally GULIA, HEW, GOLDBERGER & O'CONNOR, *supra* note 72.

83. See Steven M. Perez, *Confronting Biased Treatment of Trademark Parody Under the Lanham Act*, 44 EMORY L.J. 1451, 1465 (1995).

84. PRAC. L. INTELL. PROP. & TECH., FIRST SALE DOCTRINE: RESALE OF TRADEMARKED GOODS, (Thomson Reuters ed. 2024) (maintained), [https://next.westlaw.com/Document/Ie5e4b881962111eb-bea4f0dc9fb69570/View/FullText.html?transitionType=Default&contextData=\(sc.Default\)](https://next.westlaw.com/Document/Ie5e4b881962111eb-bea4f0dc9fb69570/View/FullText.html?transitionType=Default&contextData=(sc.Default)).

85. *Id.*

86. *Id.*

87. Mauricio Chandler, *The Sneaker Flop*, BUS. REV. BERKELEY (Aug. 19, 2022), <https://businessreview.studentorg.berkeley.edu/the-sneaker-flop/> [<https://perma.cc/W8H8-VMMM>].

88. 15 U.S.C. § 1125(e)(3)(A) (2006).

89. Matthew D. Bunker, *Mired in Confusion: Nominative Fair Use in Trademark Law and Freedom of Expression*, 20 COMM. L. & POL'Y 192 (2015). See also *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302 (9th Cir. 1992).

use comes into play where the reseller platform may state that it sells Nike or New Balance sneakers on its platform; a use like this is nominative because it accurately refers to the Nike and New Balance trademarks to identify the goods.

Third, an individual may engage in descriptive or classic fair use, also based in statute,⁹⁰ that applies when a trademark is being used to describe the defendant non-owner's own product.⁹¹

B. First Amendment Considerations in the Expressive Use and Parody of Another's Mark

One of the more evolving forms of fair use that also functions as a defense to trademark infringement claims is expressive use. To begin with, most definitions of expressive use are seemingly "loose" and identify a number of possible acts that might constitute an expressive use.⁹² For example, Professor William McGeeveran defines expressive use as a use that:

convey[s] an articulable message rather than, or in addition to, the traditional function of source identification. The boundary is not always obvious and there will be close cases. But, some categories of expressive uses can be identified with relative ease, including: use of a mark (or parts of one) to convey a message unrelated to the markholder (e.g., using the word "apple" to talk about fruit rather than computers); use of a mark to identify a markholder or a product in order to convey a message about it . . . ; or use of a mark to draw on its meaning or associations to illustrate or enliven a message about something else entirely Thus, expressive uses can arise in such diverse situations as comparative advertising, parody, references in books or films, or news reporting.⁹³

Parodies in particular and their ability to provide commentary on other products, companies, and social phenomena have prominently emerged as a form of expressive use.⁹⁴ A parody can be defined as a "derivative and a creative form of expression; its defining characteristic is that it incorporates some recognizable features of its object while altering other features so as to ridicule the object and achieve a humorous or provocative

90. 17 U.S.C. § 1115(b)(4) (2012).

91. Bunker, *supra* note 89, at 195.

92. See, e.g., William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 54 (2008); Xiyin Tang, *Against Fair Use: The Case for a Genericness Defense in Expressive Trademark Uses*, 101 IOWA L. REV. 2021 (2016) (generally, this article names various type of expressive uses in the context of trademark law; however, its failure to define a set of uses that constitute expressive use demonstrates the lack of cohesion among expressive use rules and definitions).

93. McGeeveran, *supra* note 92, at 54 (footnote omitted).

94. See *supra* Part III.B and *infra* Part IV.

effect.”⁹⁵ Parody is an explicit statutory exception to Lanham Act Section 43(a) trademark dilution claim,⁹⁶ but in the context of trademark infringement, there has been variation among courts as to whether a parody is a defense to infringement or a piece of the puzzle in determining a likelihood of confusion among consumers.⁹⁷ Parodies can present conflict in trademark law because of the delicate balance between the First Amendment interest in allowing commentary or other expression with regards to the trademark of another and the trademark owner’s interest in maintaining a positive image associated with their mark.⁹⁸

When a defendant in a case involving a parodic use of another’s mark is asserting that their use is covered under the First Amendment’s free speech provision,⁹⁹ they are likely asserting that the use of the plaintiff’s mark is their “speech” or at least part of the speech they are trying to make.¹⁰⁰ When a trademark is used as speech, its protection falls into a grey area because past Supreme Court decisions have established that commercial speech, such as product labels and advertising,¹⁰¹ is given limited First Amendment protection. More specifically, the speech must concern a lawful activity and must not be misleading to warrant protection.¹⁰² On the other hand, noncommercial speech, including social, political, and artistic expressions, is fully protected under the First Amendment, “even if it is false or misleading.”¹⁰³ When a parody involves the defendant’s simultaneous use of the plaintiff’s trademark as commercial speech (i.e., use in the labeling of the defendant’s product) and as noncommercial speech (i.e., the defendant is attempting to make a social statement using

95. Robert J. Shaughnessy, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA. L. REV. 1079, 1079 (1986); see also 15 U.S.C. § 1125(c)(3)(A)(ii) (2022).

96. 15 U.S.C. § 1125(c)(3)(A)(ii) (2022).

97. David A. Simon, *The Confusion Trap: Rethinking Parody in Trademark Law*, 88 WASH. L. REV. 1021, 1026, 1029 (2013).

98. Shaughnessy, *supra* note 95, at 1107–09.

99. U.S. CONST. amend. I (“Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the government for a redress of grievances.”).

100. See Perez, *supra* note 83, at 1466.

101. See Christine Haight Farley & Lisa P. Ramsey, *Raising the Threshold for Trademark Infringement to Protect Free Expression*, 72 AM. U. L. REV. 1225, 1258 (2023) (“Commercial speech is currently defined by the Supreme Court as speech that does no more than propose a commercial transaction.”).

102. Perez, *supra* note 83, at 1466–67; Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc., 425 U.S. 748, 770 (1976) (“In concluding that commercial speech, like other varieties, is protected, we of course do not hold that it can never be regulated in any way. Some forms of commercial speech regulation are surely permissible. We mention a few only to make clear that they are not before us and therefore are not foreclosed by this case.”).

103. Perez, *supra* note 83, at 1468.

such labeling), there is a tension as to what degree of protection an expressive, parodic use gets under the First Amendment.¹⁰⁴

Key case law has helped to contextualize fair use and has provided a framework to evaluate the application of the First Amendment to an expressive use of another's mark. These cases have helped shape the way that the First Amendment applies to uses of another's mark in cases within the sneaker industry and similar goods that act as a vehicle for expression.

C. *Rogers v. Grimaldi*

The 1989 Second Circuit case, *Rogers v. Grimaldi*, was the “marquee moment for the emerging constitutional consideration in trademark law.”¹⁰⁵ In this case, the question was whether director Federico Fellini violated the trademark rights of famed actress Ginger Rogers by using her name in his movie title, *Ginger & Fred*.¹⁰⁶ The court stated that the Lanham Act's provisions should be construed “to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”¹⁰⁷ It also articulated that the application of the Lanham Act would be supported under this balance, at least as far as titles go, where the use of another's trademark has no artistic relevance to the underlying work or “if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.”¹⁰⁸

Therefore, if the title *Fred & Ginger* was not artistically relevant to the underlying work and could mislead a consumer as to the source or content, this could be a Lanham Act violation.¹⁰⁹ Ultimately, the “court ruled . . . that when the title of the expressive work bears artistic relevance to the underlying artistic work, ‘some’ confusion is legally acceptable and therefore insufficient to state an infringement claim.”¹¹⁰

To clarify, according to the *Rogers* test, the user of another's trademark may be shielded from a trademark infringement claim and the likelihood of confusion analysis where the use is expressive. A use is expressive if it is at least somewhat artistically relevant to the underlying work and the use is not explicitly misleading.¹¹¹ Since this test has been created, it has been broadly accepted by the courts as applicable to expressive

104. *Id.* at 1469. See also Farley & Ramsey, *supra* note 101, at 1252.

105. Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 WASH. L. REV. 887, 902 (2005).

106. See *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. 1989).

107. *Id.* at 999.

108. *Id.*

109. *Id.*

110. Gulasekaram, *supra* note 105, at 903.

111. See *Rogers*, 875 F.2d at 999.

works and not commercial products.¹¹² *Vans, Inc. v. MSCHF Product Studio, Inc.*, in 2023, called this test into the spotlight, testing whether consumer goods could be considered expressive works, particularly when they are parodies of another's trademark.¹¹³

D. Jack Daniel's Properties, Inc. v. VIP Products LLC

Jack Daniel's, a parody case, involved a dog toy by VIP Products that parodied the Jack Daniel's whiskey trademarks and trade dress.¹¹⁴ The dog toy displayed text such as "Bad Spaniels" instead of "Jack Daniel's," among other dog-themed jokes.¹¹⁵ The toy itself resembled the Jack Daniel's bottle, from the shape to the labeling, although the tag on the toy disclaimed any affiliation with Jack Daniel's.¹¹⁶ The Court's most substantial question was whether VIP Products' Bad Spaniels toy should have to satisfy the *Rogers* test for expressive use to avoid proceeding to the likelihood of confusion test, and to that question, the Court answered no.¹¹⁷ VIP Products was using the Jack Daniel's trademark as its *own* trademark in such a way that utilized the goodwill of Jack Daniel's, the trademark owner, to market VIP's own goods. The Court reasoned that because VIP Products was using the trademark of another to identify source—the "way the Lanham Act cares most about"—the *Rogers* test would not apply.¹¹⁸ Moreover, the Court noted that the *Rogers* test has only applied in other cases when there was a "non-trademark use" or when the use did not involve using the mark of another as a source identifier.¹¹⁹

Even though the Court determined that VIP's toy was not subject to *Rogers* analysis, it stated that expressive aspects of a good still have a place in the likelihood of confusion analysis.¹²⁰ Indeed, the expressive

112. Press Release, International Trademark Association, INTA Proposes Clear Definition for when Courts Should Apply the *Rogers* Analysis (June 29, 2022), <https://www.inta.org/news-and-press/press-releases/inta-proposes-clear-definition-for-when-courts-should-apply-the-rogers-analysis/> [https://perma.cc/FS6W-GZJK].

113. Robert C. Cumbow, "Wavy Baby" Case Tests Definition of an Expressive Work, MILLER NASH LLP (Oct. 14, 2022), <https://www.millernash.com/industry-news/wavy-baby-case-tests-definition-of-an-expressive-work> [https://perma.cc/RL8V-TNX8].

114. Christine Haight Farley, *Jack Daniel's Properties v. VIP Products and the Current State of Trademark Fair Use*, 23 CHI.-KENT J. INTELL. PROP. 119, 119 (2023).

115. *Jack Daniel's Properties, Inc. v. VIP Products LLC*, 599 U.S. 140, 149 (2023). Other comedic features on the VIP Products Bad Spaniels toy included replacing the "Old No. 7 Tennessee Sour Mash Whiskey" from the original Jack Daniel's bottle with "The Old No. 2 on Your Tennessee Carpet," and "40% alc. by vol. (80 proof)," from the original Jack Daniel's bottle with "43% poo by vol." and "100% smelly." *Id.* at 149–50.

116. *See id.* at 149–150.

117. *Id.* at 152–53.

118. *Id.* at 153.

119. *Id.* at 155–56.

120. *See id.* at 153.

aspect of the VIP Products toy, such as saying “Bad Spaniels” to poke fun at Jack Daniel’s, can be considered in the analysis of whether consumers would be confused “because consumers are not so likely to think that the maker of a mocked product is itself doing the mocking.”¹²¹

While the *Rogers* test remains good law, the announcement by the Court “that the defendant must not use the plaintiff’s mark as a mark themselves” does not seem to clarify what to do in infringement cases where the expressive work is embodied in a consumer good, rather than in the title of a book, movie, or song.¹²² Particularly in the sneaker industry, where the expression is embedded within the good itself, the lack of guidance on this matter created a significant need to push the boundaries of what constitutes expressiveness for trademark fair use purposes.¹²³

IV. EXPRESSION IN SNEAKERS—*JACK DANIEL’S* APPLIED TO *VANS, INC.* V. *MSCHF PRODUCT STUDIO, INC.*

After the Supreme Court rendered its decision in *Jack Daniel’s* in June 2023,¹²⁴ the Second Circuit shortly thereafter rendered a decision in *Vans, Inc. v. MSCHF Product Studio, Inc.* in December 2023.¹²⁵ Shoe giant Vans, Inc. initially sued MSCHF, an art collective, for trademark infringement in 2022, and then after MSCHF had sold over 4,000 of the sneakers in question, Vans had further sales blocked by a judge in the Eastern District of New York.¹²⁶ The case was put on pause in December 2022 by the Second Circuit, pending the decision from the Supreme Court in *Jack Daniel’s*.¹²⁷

121. *Id.*

122. Farley, *supra* note 114, at 121–22.

123. *Id.*

124. See *Jack Daniel’s Properties, Inc.*, 599 U.S. at 140.

125. See *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 88 F.4th 125, 125 (2d Cir. 2023).

126. See Isaiah Poritz, *Vans Keeps Court Order Blocking MSCHF ‘Wavy Baby’ Shoes*, BLOOMBERG L. (Dec. 5, 2023), <https://news.bloomberglaw.com/ip-law/vans-keeps-court-order-blocking-msCHF-wavy-baby-shoes> [<https://perma.cc/CV8Z-H3P4>]. See generally Complaint For (1) Trademark Infringement in Violation of 15 U.S.C. § 1114 and Common Law (2) False Designation of Origin and Unfair Competition in Violation of 15 U.S.C. § 1125(a), New York Law, and Common Law (3) Trademark Dilution in Violation of 15 U.S.C. § 1125(c) and New York Law, *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 88 F.4th 125 (2d Cir. 2023) (No. 1:22-cv-02156).

127. Poritz, *supra* note 126.

A. Facts

Vans, the famed skateboarding shoe company, popularized the “Old Skool” sneaker, over which it had a trade dress protection for the combination and placement of various stylistic features, including the side stripe, the rubber sidewall, the grooves of the side wall, the textured toe box, and the visible stitching (Figure 1).¹²⁸ The Old Skool sneaker became iconic and “easily recognizable by both ‘sneakerheads’ and the uninitiated.”¹²⁹

Figure 1¹³⁰



Vans Old Skool Shoe

MSCHF, an art collective based in Brooklyn whose work had been displayed in art museums internationally, sought to “use artwork ‘to start a conversation about consumer culture . . . by participating in consumer culture.’”¹³¹ In one such conversation, it sought to make sneakerhead culture the object of its artistic expression and “critique[] the consumerism present in sneakerhead culture, as well as sneaker companies’ practice of collaborating with ‘anyone and everyone to make money.’”¹³²

Using the Old Skool as a base, MSCHF used digital tools to warp it into a representation of “the modern, wobbly, and unbalanced realities,” with the distortion of the sole of the shoe upending the original, sought-after purpose of the Old Skool as a skateboarding shoe (Figures 2 and 3).¹³³ On this basis, MSCHF’s chief argument in the Second Circuit was that Vans’ trademark infringement claim was precluded by the First Amendment and the district court erred in deciding that Vans would be likely to

128. See *Vans, Inc.*, 88 F.4th at 129.

129. *Id.*

130. *Id.*

131. *Id.* (alteration in original).

132. *Id.* at 130.

133. *Id.* (in creating what it called the Wavy Baby sneaker, an MSCHF co-Creative Officer described that MSCHF started with the Old Skool “because no other shoe embodies the dichotomies between ‘niche and mass taste, functional and trendy, utilitarian and frivolous’ as perfectly as the Old Skool”).

succeed in such a claim.¹³⁴ Further on the issue of speech, MSCHF argued that the injunction prohibiting it from advertising or fulfilling orders for its shoe, the Wavy Baby, and forcing it to cancel current orders was an unconstitutional prior restraint on speech.¹³⁵

Figure 2¹³⁶



MSCHF "Wavy Baby"

134. *Id.* at 135.

135. *Id.* at 134–35.

136. *Id.* at 130.

Figure 3¹³⁷

137. *Id.* at 132.

After outlining both the relevant Lanham Act provisions and the *Rogers* test, the court sought to apply the holding of recently decided *Jack Daniel's*.¹³⁸ The Second Circuit concluded that *Jack Daniel's* “fore-close[d] MSCHF’s argument that the Wavy Baby’s parodic message merits higher First Amendment scrutiny under *Rogers*,”¹³⁹ because MSCHF used the Vans trademarks and trade dress as a source identifier, as VIP did in *Jack Daniel's*.¹⁴⁰ The court noted that MSCHF used the Old Skool’s color scheme and trade dress elements, incorporating them with distortions into its product, and included its own branding and logo, which evoked the Vans and Old Skool logo. MSCHF’s actions were similar to those of VIP Products, except unlike VIP, it did not include a disclaimer that it was not affiliated with Vans.¹⁴¹ Moreover, the court pointed out MSCHF’s admission to starting with the Vans Old Skool in the creation of its shoe as a sign that MSCHF wanted to benefit from Vans’ goodwill.¹⁴² As the final point of its discussion about expressive use, before moving on to the likelihood of confusion analysis, the court said that “[n]otwithstanding the Wavy Baby’s expressive content, MSCHF used Vans’ trademarks in a source-identifying manner. Accordingly, the district court was correct when it applied the traditional likelihood-of-confusion test instead of applying the *Rogers* test.”¹⁴³ In the subsequent likelihood of confusion analysis, the court used a factor-based test to hold that Vans would prevail on the issue of whether consumers would be confused as to source.¹⁴⁴

B. Vans, Inc. Exemplifies the Pitfalls of Applying Jack Daniel’s to Sneaker Cases

Although it was by chance that one of the first cases to apply *Jack Daniel's* involved sneakers, *Vans, Inc.* creates a foundation for how courts may apply *Jack Daniel's* in similar cases involving sneakers or similar speech-conveying goods. While the Second Circuit attempted the most straightforward application of *Jack Daniel's* as it could to the sneaker-related issue in *Vans, Inc.*, there were two key pitfalls. Both relate to the restrictiveness posed by *Jack Daniel's* and should be considered in light of future trademark infringement cases involving sneakers and consumer goods that can convey speech.

138. *Id.* at 138.

139. *Id.*

140. *Id.*

141. *Id.*

142. *Id.* at 139.

143. *Id.*

144. *Id.*

1. *Jack Daniel's* Leads to the Limitation of Speech Embedded in a Good

In *Jack Daniel's*, the Court stated that even if a defendant is “making an expressive comment” by creating a parody product with another’s mark, this is still making use of the plaintiff’s mark in such a way that constitutes “source identification,” precluding the *Rogers* test.¹⁴⁵ The court in *Vans, Inc.* applies this directly when it determines that the MSCHF parody of the Vans Old Skool still uses the Vans marks as source identification to benefit from the goodwill of the Old Skool, precluding *Rogers* application.¹⁴⁶

Based on these applications, *Jack Daniel's* excludes forms of speech that are embedded in some goods available on the market—for example clothing, shoes, and toys,¹⁴⁷—because of the difficulty, or perhaps inability, to separate the aspect of a protected expressive use that serves as speech and the aspect that serves as source-identifying.¹⁴⁸ Even if the use of the Vans marks by MSCHF was effectively its entire “speech” as a direct comment on consumerism and sneaker culture,¹⁴⁹ the fact that there is some source-identifying aspect, by nature of the Wavy Baby being a sneaker using a different sneaker’s trade dress, still prevents the protection of that speech. This should raise eyebrows with regards to whether this is a fair and permissible restriction of speech because there appears to be a noncommercial and complete First Amendment-protected social commentary that is now being restricted. Underlying the inability to separate what aspect of the good is expressive and what aspect is source-identifying is the deeper-level conflict between whether the use of another’s mark in one’s own good is protected fully by the First Amendment as noncommercial expression or more limitedly protected as commercial speech if protected at all.¹⁵⁰

145. See *Jack Daniel's Properties, Inc. v. VIP Products LLC*, 599 U.S. 140, 155–56 (2023).

146. See *Vans, Inc.*, 88 F.4th at 139.

147. See Amy M. Adler, *Against Moral Rights*, 97 CALIF. L. REV. 263, 297–98 (2009).

148. See Tang, *supra* note 92, at 2039–41.

149. *Vans, Inc.*, 88 F.4th at 130 (Recall that “MSCHF’s co-Chief Creative Officer explained MSCHF’s conception of the connection between Vans’ Old Skool shoe and MSCHF’s Wavy Baby in the following manner: ‘The Wavy Baby concept started with a Vans Old Skool sneaker’ because no other shoe embodies the dichotomies between ‘niche and mass taste, functional and trendy, utilitarian and frivolous’ as perfectly as the Old Skool,” and “[o]ne evident feature of the parody is that the distortion destroys the original premise of the Old Skool’s popularity—its utility as a skateboarding shoe due to its flat sole.”).

150. Farley & Ramsey, *supra* note 101, at 1252. The authors note:

After the *Jack Daniel's* decision, the Ninth Circuit’s rule that the *Rogers* test applies where the mark is used in “part of an expressive work protected by the First Amendment” that communicates ideas or expresses points of view remains good law in that circuit and other jurisdictions that follow this approach. However, a remaining issue is whether this language will be interpreted to cover all expressive uses of another’s mark where the noncommercial and commercial components of the speech are inextricably intertwined.

The application of *Jack Daniel's* in trademark infringement cases involving goods like sneakers—those that blur the line between being an expressive work and something that can be sold—is unrealistic because, as Xiyin Tang states: “a world in which the line between ‘art’ and consumer goods no longer exists—in which artists ‘may find their medium in consumer products, making T-shirts and sneakers instead of paintings and sculptures’ is not some postmodern scholar’s post-apocalyptic vision of the future: it is here.”¹⁵¹ With the increasing popularity of using goods to make commentary about other goods and the need to reference the marks of others do so, the holding in *Vans, Inc.* shows that the *Jack Daniel's* rule may not be effective for adequately protecting speech embedded in consumer goods.

Pre-*Jack Daniel's* in *Hermès v. Rothchild*, a case pertaining to trademark infringement and non-fungible tokens (NFTs), the court stated that “a court may not strip an artistic work of First Amendment protection merely because the artist seeks to market and sell his creative output [C]ourts should not expect that the First Amendment applies only to the works of ‘starving artists’ whose sole mission is to share their artistic vision with the world.”¹⁵² This type of consideration was missing in *Jack Daniel's* and *Vans, Inc.* but is critical in the context of evolving forms of expression, like sneakers. Based on *Jack Daniel's* and how it was applied to *Vans, Inc.*, MSCHF would have two choices: either they could use the Vans marks to make their speech but not sell it because the speech is unprotected when using another’s mark as source-identifying, or it could stifle its speech by not publicly commenting on consumerism and sneaker culture via selling the Wavy Baby. MSCHF, other sneaker companies, and creatives who seek to use their art as expression should not have to choose between their speech and the financial benefit of their creation, and any expectation that they do so, as *Jack Daniel's* nearly compels, is unsustainable.

2. *Jack Daniel's* Can Preclude *Rogers* Inquiries That Are Important in the Context of the Sneaker Industry

To recap, the key rule in *Jack Daniel's* was that the *Rogers* test and First Amendment protections will not apply “when [an] allegedly infringing mark is used as a source identifier—that is, ‘as a designation of source

Id. (footnote omitted).

151. See Tang, *supra* note 92, at 2041.

152. See *Hermès Int’l v. Rothschild*, 654 F. Supp. 3d 268, 279 (S.D.N.Y. 2023) (citation omitted).

for [the alleged infringer's] own goods.”¹⁵³ When the *Rogers* test is not applied, there is neither inquiry into whether the use is expressive, or at least somewhat artistically relevant to the underlying work, nor inquiry into whether the use is misleading.¹⁵⁴ The application of *Jack Daniel's* in a case like *Vans Inc.* deprived MSCHF of the ability to show that it was entitled to First Amendment protection because (1) it did not have the opportunity to demonstrate that its use of the Vans marks was artistically relevant to the message underlying the shoe, and (2) it deprived MSCHF of the opportunity to demonstrate that, in the context of the sneaker market, misleading consumers as to source would have been unlikely.

It is important to note that at the center of *Rogers* was a movie title containing the mark of another being used to identify an underlying work.¹⁵⁵ In *Vans, Inc.* however, because the *Rogers* test was not applied or discussed in detail, it is unclear how the title and underlying work relationship would operate with a sneaker or similar good. In *Hermès*, the district court articulated that “*Rogers* itself had no occasion to elaborate on which works qualified as ‘artistic’ because the work at issue there . . . was ‘indisputably’ one of ‘artistic expression’ and therefore presumptively deserving of protection.”¹⁵⁶ *Hermès* also notes that “[l]ater cases in the Second Circuit have done little to further define ‘artistic expression.’”¹⁵⁷ Therefore, the lack of case law and clarity in how *Rogers* should be or could be applied to expressive works that are also a consumer good necessitates some creativity in imagining how it could be applied to a good like a sneaker.¹⁵⁸

To explain the importance of an inquiry into the artistic relevance of the expressive use of another's mark to the underlying work, I draw a parallel between *Rogers* and *Vans, Inc.* In *Rogers*, the court described the title of the work as an identifier that is “of a hybrid nature, combining artistic expression and commercial promotion.”¹⁵⁹ To draw a parallel to the Wavy Baby shoe in *Vans, Inc.* for the purpose of analysis, the “title” could be the appearance of the Wavy Baby shoe itself, because it combines some aspect of artistic expression as far as MSCHF's design choices and some aspect of commercial promotion through the placement of its logo on the shoe.¹⁶⁰ The underlying work in *Rogers* was the movie that the title needed to be

153. See *Vans, Inc.*, 88 F.4th at 137 (second alteration in original) (quoting *Jack Daniel's Properties, Inc. v. VIP Products LLC*, 599 U.S. 140, 153 (2023)).

154. See *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

155. See generally *id.*

156. See *Hermès Int'l.*, 654 F. Supp. 3d at 276 (second alteration in original).

157. *Id.*

158. See *id.*

159. *Rogers*, 875 F.2d at 998.

160. See *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 88 F.4th 125, 138–39 (2d Cir. 2023).

artistically relevant to in order to justify the use of Ginger Rogers' trademark;¹⁶¹ in *Vans, Inc.* a possible parallel would be the underlying comment or speech behind the Wavy Baby shoe, which was to "destroy[] the original premise of Old Skool's popularity" and utility as a skateboarding shoe as a comment on "sneakerhead culture" and "the consumerism present in sneakerhead culture."¹⁶² Although the parallels drawn here may not match exactly with those that a court may draw, they are nevertheless important because they show a relationship between the use of the Vans marks and how they were expressively used to convey an underlying message that was "embedded" into the Wavy Baby shoe as a good.

With *Jack Daniel's* precluding any inquiry into whether the use of the Vans marks by MSCHF was artistically relevant to the underlying message of consumerism, there was no weight given to how MSCHF was using the Vans marks in an expressive way to speak through the Wavy Baby sneaker.¹⁶³ This was a missed opportunity for MSCHF that, pre-*Jack Daniel's*, may have come to light, as it did in *Hermès*, where the *Rogers* test did apply.¹⁶⁴

Moreover, consideration of customs in intellectual property cases as far as what is generally done in a particular industry can be relevant in trademark infringement and false endorsement cases.¹⁶⁵ Therefore, if MSCHF had been given the opportunity to make its case for First Amendment protection, it could have incorporated sneaker industry practices to support the idea that sneakers are and have historically been vehicles for expression. In the context of the sneaker industry, sneakers can convey messages that may be social, political, or otherwise related to the wearer or creator's identity.¹⁶⁶ Sneakers have become a tool in sneaker culture to convey certain messages or stand for certain principles.¹⁶⁷ With this in mind, had the court been able to probe into whether MSCHF's use of the Vans marks was artistically relevant to its underlying message on consumerism, it may have been able to see that not only are sneakers, including MSCHF's, a vehicle for important speech, but also that the use of the Vans

161. See *Rogers*, 875 F.2d at 999.

162. *Vans, Inc.*, 88 F.4th at 130.

163. See *id.* at 139 (The court acknowledges earlier in the case that MSCHF had a parody-based purpose and acknowledges the underlying messages as a fact, but ultimately dismisses these things in its analysis by saying that "[n]otwithstanding the Wavy Baby's expressive content, MSCHF used Vans' trademarks in a source-identifying manner.").

164. See *Hermès Int'l v. Rothschild*, 654 F. Supp. 3d 268, 277 (S.D.N.Y. 2023).

165. See Jennifer E. Rothman, *The Questionable Use of Custom in Intellectual Property*, 93 VA. L. REV. 1899, 1944–45 (2007).

166. See Brandon Wallace & David L. Andrews, *Decolonizing the Sneaker: Sneaker Customization and the Racial Politics of Expressive Popular Culture*, 46 J. SPORT & SOC. ISSUES 524, 535 (2022).

167. See generally *id.*

marks was relevant to the type of social commentary being made by MSCHF.

As for the other side of the *Rogers* inquiry, which permits the expressive use of another's mark so long as it is not misleading as to the source of the good, it could have been helpful for MSCHF to obtain First Amendment protection for the Wavy Baby shoe.¹⁶⁸ If probing was done by the court on this issue, had *Jack Daniel's* not precluded it, it would have discovered that another important point relevant to the sneaker industry is the average consumer sophistication and custom. It is a common practice in the sneakerhead community to follow new shoes, which involves the "sharing of information" and "keeping up-to-date" about sneaker releases and sneakers being worn among the community, both in-person and online, through apps that inform users about what is "up and coming within the sneaker community."¹⁶⁹ Therefore, given the customs in the industry with regards to the transfer of information between participants, it would have been unlikely that consumers would be misled as to the source of the Wavy Baby sneaker.¹⁷⁰ In the explicitly misleading inquiry, there may have also been an opportunity for MSCHF to demonstrate a lack of bad faith in using the Vans mark and rather a genuine interest in the social dichotomies it possessed.¹⁷¹

V. POTENTIAL SOLUTIONS: NAVIGATING *JACK DANIEL'S* IN THE SNEAKER INDUSTRY

The newness of *Jack Daniel's* and its application in *Vans, Inc.* makes it challenging to predict exactly what solutions may work best to navigate speech restriction issues and other important, industry-relevant inquiries. However, two potential solutions include (1) developing an additional intent inquiry to be "attached" to the *Jack Daniel's* rule and (2) dipping into copyright law for fair use considerations that may become more important as forms of expression evolve.

A. Inquiry Based on Intended Speech

Looking to the intent of the speaker is an established concept in First Amendment cases—such as incitement and defamation—where

168. See *Hermès Int'l.*, 654 F. Supp. 3d at 281 (listing the *Polaroid* factors used in the Second Circuit to assess if the defendant's use of a plaintiff's mark is explicitly misleading).

169. See Matthews, Cryer-Coupet & Degirmencioglu, *supra* note 4, at 9.

170. See Rothman, *supra* note 165, at 1944–45.

171. See *Hermès Int'l.*, 654 F. Supp. 3d at 281; *supra* note 168; *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 88 F.4th 125, 139 (2d Cir. 2023).

uncovering the motivation behind specific speech is relevant.¹⁷² Even in the intellectual property space, intent can be important. In copyright law, intent is not needed to produce copyrightable works, but to be a co-author or to establish co-authorship of a work, intent is a relevant inquiry.¹⁷³ In patent law, federal courts have read an intent requirement into the statute covering acts that constitute contributory infringement of a patent.¹⁷⁴ Finally, trademark law utilizes intent as a factor in the likelihood of confusion analysis, where it can weigh in favor of finding infringement if the defendant intended to cause consumer confusion as to source by using an allegedly infringing mark.¹⁷⁵

There may be room for an additional inquiry into intent, given the issue of restriction on speech embedded into commercial goods that *Jack Daniel's* has created.¹⁷⁶ One possible solution is adding two questions to the overall expressive use analysis. The first question would ask what the intended speech was. The second question would ask if the same speech could be made with the same effect if separated from the vehicle of the speech, such as the sneaker. If the answer to the second question is no, then the defendant's conduct should be subject to the *Rogers* test. However, if the answer is yes and there was a reasonable way for the defendant to make the same speech with the same effect in a different vehicle of expression, then the court should ask the *Jack Daniel's* question: whether the plaintiff's mark was used by the defendant in a way that causes source confusion.

The benefit of the first inquiry—what the intended speech is—is that it brings out the fact that a good may contain important speech. When a court looks at a consumer good, especially something like a sneaker that may not intuitively have a speech element, and becomes aware of it at the outset—especially when the speech is social or political commentary—this inquiry may require the court to think more seriously about whether a good is actually trying to infringe or whether it is trying to serve as an expression of speech; this could tune judges into First Amendment concerns more acutely.¹⁷⁷ Calling attention to First Amendment concerns,

172. Leslie Kendrick, *Speech, Intent, and the Chilling Effect*, 54 WM. & MARY L. REV. 1633, 1635–36 (2013).

173. Eva E. Subotnik, *Intent in Fair Use*, 18 LEWIS & CLARK L. REV. 935, 942–43 (2014).

174. Lynda J. Oswald, *The Intent Element of Inducement to Infringe Under Patent Law: Reflections on Grokster*, 13 MICH. TELECOMM. & TECH. L. REV. 225, 229–30 (2006).

175. See Yen, *supra* note 50, at 723–24.

176. See *supra* Part IV.A.

177. See Nicole E. Negowetti, *Judicial Decisionmaking, Empathy, and the Limits of Perception*, 47 AKRON L. REV. 693, 707 (2014) (“[S]chemas are ‘mental blueprints’ that allow an individual to understand new people, circumstances, objects, and their relationships to each other by using an existing framework of stored knowledge based on prior experiences.”). “[S]cientists suggest that schemas allow judges in an overburdened legal system to identify important facts and distinguish relevant

despite the appearance of trademark infringement and consumer good-related concerns, can help resolve some of the uncertainty when speech is intertwined with a consumer good, as it increasingly is. Moreover, a probe into intent can help prevent a chilling of speech made through goods because it reassures speakers that they can comment or critique in confidence because their intent will be considered before a certain finding of liability.¹⁷⁸ It also helps clearly identify what the speech is for the second inquiry.

The second inquiry—whether the same speech could be made with the same effect if separated from the vehicle of the speech—is important because it can bring to light how indistinguishable a good is from the actual speech. This could perhaps give a judge pause before deciding that an expressive use serves as a source identifier. In addition, a question like this can make a person think about the policies behind both freedom of speech and trademark law. If a person cannot make the same speech to the same effect using a different vehicle, a decisionmaker will have to weigh the importance of the speech against the importance of trademark law policies, especially those that seek to protect mark holders from having their goodwill eroded.¹⁷⁹

To hypothetically apply this inquiry to *Vans, Inc.*, the court would first ask what MSCHF's intended speech was. In response, MSCHF would say that it intended to comment on sneaker culture and consumerism by distorting its idea of a shoe that embraces various social dichotomies.¹⁸⁰ Then, the court would ask if MSCHF could make this same speech or commentary about the Vans Old Skool without putting it into sneaker format and still retain the effect of the speech. If the court found that MSCHF could in fact have used some other method of commentary that would have the same effect as far as who would consume and engage with the commentary, then the court could move to determining whether the defendant's use of the plaintiff's mark was done in a way that caused source confusion. If the defendant had a different way to convey the exact same speech and retain the same effect, they should not be able to use a means of speech that erodes the trademark protections that the plaintiff has over

from irrelevant information.” *Id.* at 710. These selections suggest, in this context, that if a judge is presented with information in an unfamiliar case about sneakers that presents a First Amendment concern, a schema developed from prior experiences with First Amendment issues can help them distinguish what is important from what is irrelevant as far as facts that are important in addressing the First Amendment concern.

178. See Rebecca Tushnet, *Trademark Law as Commercial Speech Regulation*, 58 S.C. L. REV. 737, 755 (2007).

179. See Deborah J. Kemp, Lynn M. Forsythe & Ida M. Jones, *Parody in Trademark Law: Dumb Starbucks Makes Trademark Law Look Dumb*, 14 J. MARSHALL REV. INTELL. PROP. L. 145, 151 (2015).

180. *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 88 F.4th 125, 130, 139 (2d Cir. 2023).

its marks, therefore harming its goodwill. However, if the court determines that the defendant's speech would not have the same effect in a different vehicle of expression, for example, if the court said that a social media post about the Old Skool by MSCHF would hardly reach the same consumers, then the court should use *Rogers* to determine if the expressive use will be protected by the First Amendment under that test.

With the introduction of an inquiry based on unearthing the intended speech of an infringing party, there is a valid counterargument based in the key policy consideration in trademark law: preventing consumer confusion. When a consumer is looking at two goods of the same type in the market that have rivaling marks, they may not intuitively not know what the defendant's intended speech was, and because they may not know this underlying speech, they will be confused as to the source given the marks that they see in front of them.¹⁸¹ Therefore, even though a court can unearth what the intended speech is through fact-finding in the judicial process, this may be insignificant when it comes to upholding the ultimate policy of avoiding confusion in the eyes of consumers.

Another possible issue with placing a responsibility on the courts to make a judgement about whether the same speech can be made with the same effect in a different vehicle is that this would likely be based on speculation that judges may not be equipped to make in a consistent way. The only true way to know whether the same speech in a new vehicle would be as impactful and effective as the speech was in the allegedly infringing vehicle is to test it out in the market or in society itself, a test which is not likely helpful in the efficient resolution of an infringement dispute.

Although this solution does not pose any radical changes to *Jack Daniel's*, it seeks to address the fundamental issue *Jack Daniel's* creates in the case of a sneaker or similar good where the good itself is both in the market as a product and in the world as a statement. By focusing on the speech aspect and its inseparability from the good that is conveying it, it attempts to emphasize that perhaps the speech aspect needs to be highlighted more than the source-identifying issue.

B. Borrowing from Copyright Law: A Fair Use Standard to Accommodate Market Changes

Another possible solution looks not to modify *Jack Daniel's* but to explore an entirely different framework for determining if a good that was created using the trademarks or trade dress of another is infringing, or alternatively, is sufficiently different from the original to justify the use. A framework like this can be especially beneficial in the sneaker market or

181. See Yen, *supra* note 50, at 739.

other industries where growth is furthered by building on the ideas of one another. Copyright law, although a distinct area of intellectual property, has a fair use exception that may be interesting to probe to find a solution for the issue that *Jack Daniel's*, and perhaps trademark law more broadly, is falling short of solving when it comes to goods that have both commercial and expressive value.

Copyright law gives copyright owners exclusive rights in their works; however, this right is limited by the fact that a non-owner can engage in fair use of the copyrighted work without it constituting infringement.¹⁸² The factors considered for fair use include:

(1) the purpose and character of the use . . . ; (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.¹⁸³

When looking at the first factor, the Supreme Court has interestingly considered whether a work is “transformative” or whether it “adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.”¹⁸⁴ Transformativeness is highly valued in copyright law because of a policy emphasis on promoting innovation in science and the arts, which can be driven by allowing transformative works.¹⁸⁵

The adoption of a similar consideration about how much a work has been transformed may be helpful if applied in the trademark law space, especially in situations where a defendant may be using the plaintiff's marks in a way that is completely unlike the original, either as a form of innovation or as commentary. In the sneaker industry in particular, customizations—which involve in some way adding onto or adding a unique touch to existing sneakers from brands like Nike which, of course, contain Nike's trademarks and trade dress—have helped the industry continue to grow and innovate.¹⁸⁶ Not only could the implementation of some type of fair use transformativeness analysis support innovation in industries where

182. R. Anthony Reese, *Transformativeness and the Derivative Work Right*, 31 COLUM. J.L. & ARTS 467, 467 (2008).

183. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994).

184. *Id.* at 579.

185. See Reese, *supra* note 182, at 467–68. “Transformativeness” in copyright law refers to the degree to which a defendant's use has transformed the underlying work into something new by giving it a new purpose or character or changing or adding a meaning or expression. When considering transformativeness, courts have also considered how a defendant used the underlying work for a “completely different purpose than the purpose for which the copyright owner produced or used the original work.” See *id.* at 467–69, 485.

186. Park, *supra* note 22.

growth is based on building upon one another's ideas, but it may also allow a little more room for smaller artists and creators to contribute to the market without being crushed by giants in the industry.

For example, in 2020, Nike filed a complaint against designer Warren Lotas alleging trademark infringement, among other claims, because Lotas created a series of sneakers that it said infringed upon the trade dress for the Nike Dunk and because Lotas used a mark that appeared to be the iconic Nike Swoosh mark, altered to look like the mask from the movie *Friday the 13th*, on the shoes.¹⁸⁷ Although Lotas ended up settling with Nike,¹⁸⁸ the existence of some sort of transformativeness inquiry at the time of this dispute may have provided Lotas with some ground to stand on as far as the changes he made to the Nike Dunk trade dress and the Nike Swoosh mark.

Shortly before the decision in *Jack Daniel's*, the Supreme Court looked at the issue of transformativeness in the copyright context in *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*.¹⁸⁹ There, the Court established that when determining whether a work is transformative for the purpose of copyright fair use, the degree of transformativeness of the allegedly infringing use “must be weighed against other considerations, like commercialism.”¹⁹⁰ In other words, the Court said that when an original work and the transformative use have highly similar purposes, “and the secondary use is commercial in nature,” this weighs against the fair use of the original work.¹⁹¹ Although *Andy Warhol Foundation* is a case within copyright territory, its implications should also be considered within this proposed solution of adding a transformativeness consideration into trademark law. Similar to *Jack Daniel's*, *Andy Warhol Foundation's* recency limits what can be said about how it will practically apply; however, if transformativeness made its way into trademark law, the reasoning behind *Andy Warhol Foundation* would logically follow into trademark territory. Although the proposed solution seeks to give creatives breathing room as far as using the marks of others in their expressive goods, it is subject to the barrier of the transformative use being “commercial in nature” and similar in purpose to the original mark. To trace this back to the

187. See generally Complaint for: (1) Trademark Infringement; (2) False Designation of Origin / Unfair Competition (3) Trademark Dilution; (4) Unfair Competition; (5) Common Law Trademark Infringement and Unfair Competition, Nike, Inc. v. Warren Lotas, No. 2:20-cv-09431 (C.D. Cal. Oct. 14, 2020). See also Ian Servantes, *Warren Lotas and Nike Have Reached a Settlement Over His 'Illegal Fake' Dunks*, INVERSE: INPUT (Dec. 14, 2020), <https://www.inverse.com/input/style/warren-lotas-nike-have-reached-a-settlement-over-his-illegal-fake-dunks> [<https://perma.cc/3VBE-KGJS>].

188. Servantes, *supra* note 187.

189. See generally *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508 (2023).

190. See *id.* at 509.

191. *Id.* at 532–33.

example of Warren Lotas, even if Lotas's use was of a unique and distinct kind from Nike's marks, it may still hit a wall because both Lotas's and Nike's uses of the underlying mark are on sneakers and Lotas's use of Nike's mark is commercial in nature. Thus, even though *Andy Warhol Foundation* currently speaks to transformative fair use in copyright law, the incorporation of transformativeness in trademark law should expect a similar analysis that may undermine the purpose for bringing such an inquiry into trademark law in the first place, unless of course, the law develops in the future in favor of these unique types of creative fair uses.

Another challenging aspect of introducing a new inquiry like transformativeness is potential inconsistencies in application, which is a struggle that many established tests and inquiries in the legal system face.¹⁹² Inconsistency in application, especially in the trademark space, can have broader business implications because "the judicial system and its interpretations of trademarks have a significant impact on the economic value of a trademark" and "[i]f the courts are inconsistent in their application of the law and unexpectedly reduce or increase protection for a particular mark, the court's decisions have a far-reaching impact on businesses and valuation of their trademarks."¹⁹³

Therefore, although not a perfect solution to the lack of clarity that riddles expressive uses and speech in consumer goods—and the way that trademark law will be operating with *Jack Daniel's* in mind—this solution offers an additional or alternative way to look at the use of another's mark in a sneaker or other artistic work.

CONCLUSION

As the courts continue to develop trademark case law through the application of *Jack Daniel's*, clarity around the topic of how courts should treat consumer goods that act as vehicles for expression in expressive use cases will likely increase. Looking to the sneaker industry and taking particular note of how the rule in *Jack Daniel's* applied to *Vans, Inc.* highlights two key pitfalls in the *Jack Daniel's* approach. First, the application of *Jack Daniel's* leads to limitations on speech when the speech is embedded in a consumer good like a sneaker. When such goods expressively use another's trademark, protected speech cannot be easily separated from use of that trademark as a source identifier—under *Jack Daniel's*, this precludes any protection from the *Rogers* test. Second, in the context of the sneaker industry, the application of *Jack Daniel's* can prevent a defendant in an expressive use case from reaching important *Rogers* inquiries that

192. See JBrandon Duck-Mayr, *Explaining Legal Inconsistency*, 34 J. THEORETICAL POL. 107, 109–10 (2022) (explaining some of the causes of inconsistencies in judicial decision-making).

193. See Kemp, Forsythe & Jones, *supra* note 179, at 150.

may give them a better chance of prevailing in a trademark infringement or dilution case.

While *Jack Daniel's* may look like bad news for sneaker designers or artists generally who seek to make commentary on larger brands and their marks by utilizing consumer goods to convey their messages, there is reason to believe that as the market for consumer goods continues to expand, innovate, and use these goods to make statements about the world, the law will create new solutions to address these developments.¹⁹⁴ As an industry that values innovation and creativity, the sneaker industry will be one to watch from a legal perspective in the coming years as designers and artisans, large and small, learn how to navigate the trademark law space with care, while continuing to use sneakers as a way to make fashion and social statements.

194. See Farley, *supra* note 38, at 1126.