

Honey Badger May Not Care, but You Should: A 1930s Film Star, a 30-Year-Old Legal Test, and Trademark in the Age of Digital Content

By Donna Frosco and L. Elizabeth Dale



The year 2018 marks EASL's 30th anniversary. One year after EASL's founding in 1989, the U.S. Court of Appeals for the Second Circuit decided the landmark trademark case *Rogers v. Grimaldi*.¹ What has come to be known as the "Rogers test" would, in the ensuing years, become the standard by which courts would analyze the permitted use of trademarks in expressive works of visual art.

Ginger Rogers, Federico Fellini, and U.S. Trademarks

Ginger Rogers and Fred Astaire were an iconic dance duo who starred in classic films in the 1930s and 1940s, including *Top Hat* (1935), *Carefree* (1938), and *Swing Time* (1939). Rogers was Hollywood royalty in her time—she even earned a spot at number 14 on the American Film Institute's list of female stars of classic American films.² In 1986, renowned director Federico Fellini created and directed a film entitled *Ginger and Fred*, which followed the exploits of fictional performers who imitated Rogers and Astaire and became known in Italy as "Ginger and Fred." After Fellini released the film, Rogers sued him, claiming that the title of the work violated § 43(a) of the Lanham Act,³ by creating the false impression that the story was about her or that she "sponsored, endorsed, or was otherwise involved in the film" and that it violated her rights of publicity and privacy.⁴

In *Rogers*, the Second Circuit found that the Lanham Act "should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression."⁵ The Court then gave us the *Rogers* test. The test has been cited to require the person using a trademark in an artistic work to show that the allegedly infringing use is part of a work that is protected by the First Amendment. If he or she does so, the burden shifts to the owner of the mark to demonstrate that there is a likelihood of confusion and that either the mark is not artistically relevant to the underlying work whatsoever or, if it does have some artistic relevance, it explicitly misleads consumers as to the source or content of the work.⁶



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In tackling the threshold question of the *Rogers* test—i.e., whether the mark is protected by the First Amendment—the Second Circuit found that, because creators of artistic works can express themselves in the actual titles of creative works, the expressive elements of a title deserve more protection than those of a non-creative commercial product. Thus, the Court found that the title *Ginger and Fred* was entitled to protection under the First Amendment as an expressive work.

The Court held that the title, *Ginger and Fred*, did have artistic relevance because the names of the main characters in the film are nicknamed "Ginger" and "Fred," so Rogers' name was not arbitrarily chosen to exploit her fame.⁷ Further, the Court noted that an affidavit from Fellini revealed that he chose the title as an ironic commentary to contrast the "glamorous and carefree" Hollywood lifestyle of the 1930s and 1940s to the harsh reality of Italy during that time.⁸ Therefore, the Court found the title to be a vital part of Fellini's artistic expression.⁹

Having found artistic expression, the Court moved to the second inquiry of the *Rogers* test—determining whether the title explicitly misled consumers as to the source or content of the film. It held that the title did not clearly indicate that Rogers endorsed the film.¹⁰ It found that it would not be clear to a viewer that the film was a true depiction of Rogers' life. Thus, the Court ruled that ultimately any risk that the title would mislead consumers was "outweighed by the danger that suppressing

any artistically relevant though ambiguous title would unduly restrict expression.”¹¹ Therefore, Rogers’ claim against Fellini under the Lanham Act failed.

30 Years Later...

Fast forward 30 years to the fast-paced age of digital content and the people who capitalize on that digital content disseminated through social media. The 1989 *Rogers* test is being used as the standard by which to analyze new cases involving digital content and trademarks. Since the time of *Rogers*, the proliferation of the internet has given almost anyone with a computer and knowledge of social media the ability to create and rapidly share creative content. Elements of that content can quickly join the American lexicon. Yet, although media has changed beyond the wildest dreams of many in the 1980s, the applicable legal principles have not changed all that much.

In today’s social media arena, at the click of a mouse, individuals have the freedom to develop, express, share, and even capitalize on creative works. From videos of cats playing the piano to charitable challenges, to bad lip readings or sports trick shots, social media abounds with a collection of creative content that is ripe for visual consumption.

Enter: The Honey Badger...“Ewww”

There are many lessons to be learned from the honey badger. The honey badger is a furry animal that dwells in the dry areas of Africa, Southwest Asia, and the Indian Subcontinent, and although it may sound sweet, it is far from it. With a reputation for being ferocious and fearless, it is known to hunt animals eight to 10 times its weight.¹² UrbanDictionary.com defines the honey badger as the “Chuck Norris of the Animal Kingdom.”

The honey badger was injected into the psyche of the general populace in 2011 through the viral video titled “The Crazy Nastya** Honey Badger.”¹³ The video follows the honey badger as it goes about its day-to-day activities, scavenging for food, chasing jackals, and receiving a venomous cobra bite, passing out and regaining consciousness to eat the cobra. Yet, what earned this video the acclaim from HuffPost as being “The Best Nature Video of All Time,”¹⁴ was not necessarily the actions of the tenacious creature itself, but the video creator’s spin and voiceover.¹⁵

The video’s success is due to the original content of Christopher Gordon, the comedian who added narration and colorful commentary to what may have been a less humorous video. Gordon’s sassy voiceover made the video a viral classic, receiving over 80 million views on YouTube. Thanks to Gordon, it is no small wonder that we now know why the honey badger has been called the animal kingdom’s most fearless animal by the Guinness Book of World’s Records (according to Gordon).¹⁶

Honey Badger May “Take What It Wants” but That’s Not a License to Infringe

Gordon’s video earned him much fame in the digital world and, reportedly, copious money in the real world. Gordon was able to expand his digital dynasty into the business world and eventually registered before the United States Patent and Trademark Office the catchphrase “Honey Badger Don’t Care”¹⁷ in relation to multiple classes of goods. At the time of the lawsuit, Gordon had not filed an application for the crasser, “Honey Badger Don’t Give a Sh**”, but presently has an open application for registration.¹⁸ Gordon used the phrases on his own “Honey Badger Don’t Care” merchandise, which he sold on his website, randallshoneybadger.com, and in stores like Wal-Mart, Target, and Urban Outfitters.¹⁹ The popularity of the phrases was undeniable—celebrities quoted them,²⁰ and they were the subject of pop culture news stories in reputable publications.²¹ Understandably, along with Gordon’s success came much attention from larger entities cognizant of the viral popularity of his work.

“Thanks for the Mouse. See Ya Later”???

The 2015 *Gordon v. Drape Creative* case stems from Gordon’s claims that he marketed to the defendant greeting card companies the idea of cards featuring his “Honey Badger Don’t Care” and “Honey Badger Don’t Give a Sh**” phrases. Gordon maintains that he hired a licensing agent to manage his permitted use of the phrases, and Gordon entered into several licensing deals, including one deal for greeting cards.²² However, prior to the greeting cards licensing deal, Gordon’s agent had contacted American Greetings, the parent company of defendants Drape Creative, Inc. and Papyrus Recycled Greetings, Inc.²³ The court noted that Gordon’s agent had email exchanges with an American Greetings employee in which the employee said the video was a “really fun and irreverent property” and that she would “love to see if there (would be) an opportunity on one of (their) distribution platforms....”²⁴ However, no license was ever granted to American Greetings or the defendants, and Gordon went forward with licenses to the other card companies.²⁵

Despite the lack of a license, Gordon claimed, the defendants designed and produced seven greeting cards using his two honey badger phrases with slight variations.²⁶ These designs included an election-themed card, birthday-themed cards, and a Halloween-themed card—all of which revealed inside the card that the honey badger did not give a “sh**” about these events.²⁷

The cards gave rise to Gordon’s action against the companies alleging trademark infringement under the Lanham Act. The defendants denied infringement and claimed that the president of Drape Creative, who designed the cards, had never heard of Gordon’s video. He claimed that “he could not recall what inspired the cards’ designs.”²⁸

“Nothing Can Stop the Honey Badger When It’s Hungry”—Gordon Appealed

The lower court granted the defendants’ motion for summary judgement. Gordon appealed. On July 30, 2018, the U.S. Court of Appeals for the Ninth Circuit reversed the district court’s decision and sent the case back down to the lower court for further proceedings. The Ninth Circuit acknowledged that the *Rogers* test should be used to “balance the competing interests at stake when a trademark owner claims that an expressive work infringes on its trademark rights.”²⁹ However, the Court also noted that “the *Rogers* test is not an automatic safe harbor for any minimally expressive work that copies someone else’s mark.”³⁰

The Court distinguished *Gordon* from all prior cases in which it had applied the *Rogers* test and found that infringement claims were blocked as a matter of law.³¹ In *Gordon*, the Court found that a genuine issue of material fact existed as to whether the defendants’ use of the phrases in the greeting cards was artistically relevant, or merely a pasting of Gordon’s marks into cards to appropriate the goodwill associated with the marks.³²

In applying the *Rogers* test, the Court first found that the greeting cards were considered expressive works protected under the First Amendment because they conveyed messages to consumers through their humorous words and images.³³ Having found that the defendants met that threshold showing, the Court then turned to Gordon’s burden to demonstrate a triable issue of fact upon which a jury could find either that his marks did not add artistic relevance to the cards or that their use misled the viewer into believing that the cards were sponsored or endorsed by Gordon.

The Ninth Circuit provided guidance, finding that the question of whether the use of a mark is artistically relevant to an underlying expressive work not only asks “whether the mark is relevant to the rest of the work; it also asks whether the mark is relevant to the defendant’s own *artistry*.”³⁴ The Court explained that the crux of whether the mark adds to the defendant’s artistry is whether the defendant used the mark for artistic reasons rather than to simply appropriate the trademark owner’s goodwill.

The Ninth Circuit noted that in *Rogers* and in the cases in which it applied the *Rogers* test, the mark at issue was clearly relevant to the secondary user’s work and it was used to add to the user’s artistic expression.³⁵ In this case, the Court found that “[a] jury could find that defendants’ cards are only intelligible to readers familiar with Gordon’s video and deliberately trade on the goodwill associated with his brand.”³⁶

Why Should You Care About the Honey Badger?

The Ninth Circuit has deemed there to be real factual issues that have yet to be determined, but the *Honey Bad-*

ger case teaches us that the *Rogers* test is still as important as ever. Other circuits are also ruling that creative digital content deserves trademark protection in the real world. In May 2018, the Fifth Circuit in *Viacom Int’l v. IJR Capital Investments* held that a restaurant with the same name as a fictional restaurant in Nickelodeon’s “SpongeBob SquarePants” (owned by Viacom) would infringe on Viacom’s trademark rights.³⁷

We arguably are experiencing a new technological revolution where access to copious amounts of information and the creative works of others are literally at our fingertips. Not everything is Fellini-esque—but it need not be to have real financial value.

The ability to produce, publish, and disseminate content to hundreds of thousands or millions of viewers is a few clicks away. With technology advancing at such a rapid pace, trademark owners should be aware of the value of their intellectual property and the steps that are available to protect it. Conversely, avid consumers of digital social media should be aware that simply because something is online or has gone viral does not necessarily mean it is up for grabs, especially for commercial gain.

Endnotes

1. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).
2. <http://www.afi.com/100Years/stars.aspx>.
3. *Rogers* was decided before the Trademark Law Revision Act of 1988. At that time, Section 43(a) of the Lanham Act imposed civil liability on “[a]ny person who shall . . . use in connection with any goods or services . . . a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent same, and shall cause such goods to enter into commerce . . .” 15 U.S.C. § 1125(a) (1982).
4. *Rogers*, 875 F.2d at 997.
5. *Id.* at 999.
6. *Id.*; *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184, 1190 (9th Cir. 2018).
7. *Rogers*, 875 F.2d at 1001.
8. *Id.*
9. *Id.*
10. *Id.*
11. *Id.*
12. <https://blog.nationalgeographic.org/2011/11/04/honey-badger-dont-care-but-we-do/>.
13. <https://youtu.be/4r7wHMg5Yjg>.
14. https://www.huffingtonpost.com/2011/03/04/honey-badger-dont-care_n_831278.html.
15. *Gordon*, 897 F.3d at 1187.
16. <https://youtu.be/4r7wHMg5Yjg> at 00:21.
17. Registered for Christmas tree ornaments and decorations; talking dolls and plush toys (Reg. No. 4419081); mugs (Reg. No. 4281472); audio books in the field of comedy, parody and satire; computer application software for mobile phones, portable media players, handheld computers, namely, software for playing games (Reg. No. 4419079); clothing, namely, t-shirts, tank tops, one piece garment for infants and toddlers; Long-sleeve shirts, caps (Reg. No. 4505781); and Bumper Stickers; decals (Reg. No. 5059721).

18. Applied for clothing, namely, t-shirts (Serial No. 87280166).
19. *Gordon*, 897 F.3d at 1187.
20. *Id.* at 1188 (citing use by Taylor Swift and Anderson Cooper).
21. *Id.* (noting coverage of the video in FORBES, THE WALL STREET JOURNAL, and THE HUFFINGTON POST).
22. *Id.* at 1188.
23. *Id.*
24. *Id.*
25. *Id.*
26. *Id.* at 1186.
27. *Id.* at 1188-89.
28. *Id.* at 1189.
29. *Id.* at 1186-87.
30. *Id.* at 1187.
31. *Id.* at 1191.
32. *Id.* at 1194.
33. *Id.*
34. *Id.* at 1189 (emphasis in original).
35. *Id.*
36. *Id.* at 1196.
37. *Viacom Int'l v. IJR Capital Investments, L.L.C.*, 891 F.3d 178, 183 (5th Cir. 2018).

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