

Wavy Baby's Shoes Not Entitled to Special First Amendment Protections

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40 years ago, I was the new kid in 6th grade – truly a terrible age in a young girl’s life to try and “fit in” at a new elementary school in a small town. But, one of my best memories from that year was procuring my first pair of blue and white checkered Vans shoes. Not many people had them where I lived, though the shoes had been around for nearly 20 years at that point. Even then I knew and appreciated the beauty of unique shoes, so imagine my delight in seeing a resurgence in the popularity of the shoes again in the marketplace the last handful of years, and the ability to add to my personal collection of awesome shoes.

Vans are undoubtedly iconic. The shoes have been available since 1966, with a broad customer base, including skateboarders, BMX bike riders, celebrities, and people that just appreciate unique and functional shoes. Of its shoes, the “Old Skool” style is arguably instantly recognizable:



The staple in the closet of any owner of Vans shoes comes with a price tag of about \$60 for a pair of shoes, and Vans has worked with multiple artists and celebrities to create

and sell special edition versions of its shoes. Special patterns, platforms, hi-tops, mid-tops . . . a marketable commitment to innovation that reaches the broadest base of consumers.

MSCHF Product Studio, Inc. is a Brooklyn-based art collective with a mission to “use artwork to start a conversation about consumer culture . . . by participating in consumer culture.” MSCHF created the “Wavy Baby” sneaker purportedly as a parody of the Old Skool shoes, to serve as social commentary about the inherent consumerism in “sneakerhead culture.” MSCHF co-Chief Creative Officer explained that “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.”

As a starting point, MSCHF took an image of a Vans Old Skool skate shoe, and then used a digital filter tool to transform the shoe “into the modern, wobbly, and unbalanced realities.” MSCHF then collaborated with musical artist Tyga as part of a marketing campaign in connection with releasing a limited run of the sneakers for purchase by consumers, with a hefty price tag of \$220 per pair. Of course, Vans quickly caught wind of the campaign and, pending release of the Wavy Baby sneakers for purchase, sent cease and desist letters to both Tyga and to MSCHF.

MSCHF nonetheless continued to promote its shoe campaign and launched a one-hour window sales promotion for consumers to purchase 4,306 pairs of Wavy Baby shoes, which sold out. (Here’s the math: \$220 multiplied by 4,306 is \$947,320)

Not surprisingly, Vans filed suit in the U.S. District Court for the Eastern District of New York, including a federal claim of trademark infringement under the Lanham Act. It also filed a Motion for a Temporary Restraining Order and Preliminary Injunction, which was granted by the district court because “Vans had shown a significant danger of consumer confusion” and also that it would suffer irreparable harm without injunctive relief. Notably, the district court rejected MSCHF’s argument that its parodic work of artistic expression was subject to special First Amendment protections rather than the traditional likelihood of confusion test. As the court put it, while courts have “considerable leeway to parodists whose expressive works aim their parodic commentary at a trademark or a trademark product . . . they also have not hesitated to prevent a manufacturer from using an alleged parody of a competitor’s mark to sell a competing product.” In other words, a successful parody should simultaneously convey that it is not the original and is a parody.

Given Vans’ significant collaborative efforts with artists and its visibility in the marketplace, as well as the manner in which MSCHF ran its advertising campaign and its sale of actual Wavy Baby shoes to consumers, the court concluded that “the Wavy Baby shoes on their face did not clearly indicate to the ordinary observer that MSCHF is not connected in any way with the owner of the target trademark.”

MSCHF then appealed the decision to the U.S. Court of Appeals for the Second Circuit, which affirmed that MSCHF is not entitled to special First Amendment protections. In doing so, the court took into account the recent Supreme Court decision in the *Jack*

Daniel's Properties, Inc. v. VIP Products LLC case and the *Rogers v. Grimaldi* case, both of which provide guidance as to whether an expressive work is entitled to heightened First Amendment scrutiny. Where an artistic expression is in play, a trademark infringement claim may be more narrowly applied. The Second Circuit held in *Rogers* that the Lanham Act should not apply to "artistic works" as long as the defendant's use of the mark is (1) artistically relevant to the work, and (2) not "explicitly misleading" as to the source or content of the work. The Supreme Court's decision in *Jack Daniel's* also clarifies when the *Rogers* test and its heightened First Amendment protections DO NOT apply – *i.e.*, when the allegedly infringing mark is used as a source identifier for its own goods.

The Second Circuit held that the Supreme Court's *Jack Daniel's* decision "forecloses MSCHF's argument that Wavy Baby's parodic message merits higher First Amendment scrutiny under *Rogers*" because the Wavy Baby shoes at issue were used "at least in part" for source identification.

MSCHF made use of the Old Skool trademarks and trade dress, it included its own branding on the Wavy Baby sneakers, and it failed to include a disclaimer disassociating it from Vans or Old Skool shoes. Ultimately, MSCHF sold nearly \$1,000,000 in shoes through the benefit of the good will that Vans owns in the Old Skool shoes and its distinctive branding. This use of Vans' trademarks as a source-identifier to sell its Wavy Baby shoes to the general public works directly against parody protection under *Rogers*. ". . . if a parodic use of protected marks and trade dress leaves confusion as to the source of the product, the parody has not "succeeded" for purposes of the Lanham Act, and the infringement is unlawful."

MSCHF's ostensible mission is to "use artwork to start a conversation about consumer culture . . . by participating in consumer culture." It certainly didn't work out very well for them here.