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Infringement Under The Guise Of Parody? *Louis Vuitton v My Other Bag (MOB)*

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Parody is a form of expression that injects creativity by way of humour and paradox in everyday life. In this regard, the law has recognised parody as a defence in the realms of defamation and infringement of intellectual property rights. In fact, parody had been recognised as part and parcel of one's constitutional right to freedom of expression in the South African case of *Laugh It Off Promotions CC v SAB International (Finance) BV (t/a Sabmark International)* [2005] ZACC 7.

However, as the Constitutional Court in the *Laugh It Off* case rightly puts, in the context of parodical use of one's trademark, there is a fine balance between one's constitutional right to freedom of expression on one hand and one's right to property on the other. Question is, how should these competing rights be balanced?

In the United States case of *Louis Vuitton v My Other Bag (MOB)* 156 F. Supp. 3d 425 (2016), the District Court explored the extent of the defence of parody against copyright infringement claims between a Louis Vuitton handbag and a tote bag depicting the visual characteristics of a Louis Vuitton handbag.



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Brief Facts

Louis Vuitton Malletier, S.A. (Louis Vuitton) brought claims against MOB with respect to its totes for trademark dilution and infringement under the Lanham Act, 15 U.S.C. § 1125(c); a claim of trademark dilution under New York law; and a claim of copyright infringement.

MOB sells simple canvas tote bags with the text "My Other Bag . . ." on one side of the bag, and drawings meant to evoke iconic handbags by luxury designers including Louis Vuitton, Chanel, and Fendi, on the other side of the bag. MOB filed a summary judgment on all of Louis Vuitton's claims, whilst Louis Vuitton cross moved for summary judgments on its trademark dilution and its copyright infringement claims.

Decision

The District Court allowed MOB's summary judgment application and dismissed Louis Vuitton's summary judgment application on the basis that, among others, MOB's bags are protected as fair use — in particular, that its use of Louis Vuitton's marks constitutes "parody" under Section 1125(c)(3) of the United States Code Service.

The Court made the following remarks:

- a successful parody communicates to a consumer of an entity that it is separate and distinct from the trademark owner and that it is poking fun at a trademark.
- in other words, a parody clearly indicates to the ordinary observer that the defendant is not connected in any way with the owner of the target trademark.
- the fact that Louis Vuitton at least does not find the comparison funny is immaterial; Louis Vuitton's sense of humour (or lack thereof) does not delineate the parameters of its rights (or MOB's rights) under trademark law.
- the whole point of MOB's joke: "My other bag" — that is, not this bag — is a Louis Vuitton handbag. That joke, not to mention the cartoon-like rendering of the bags,

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builds significant distance between the pattern incorporated into the bag sketches and the designated source of the totes themselves. Thus, MOB is not precluded from invoking the fair use provision.

The District Court's decision was upheld on appeal.

Commentary

Malaysian laws have recognised the defence of parody as a viable defence against copyright infringement under the Copyrights Act 1987. However, it is not clear that the Trademarks Act 2019 had accepted parody as an example of fair use. In this regard, it is believed that the test as expounded in the *Laugh It Off* case is instructive before the Malaysian Courts though this was mentioned in passing in the Court of Appeal case of *Sepakat Efektif Sdn Bhd v Menteri Dalam Negeri & Anor* [2015] 2 CLJ 328. The Court held:

"The question to be asked was whether, looking at the facts as a whole and analysing them in their specific context, an independent observer who was sensitive to both the free speech values of the Constitution and the property protection objectives of trade mark law, would say that the harm done by the parody to the property interests of the trade mark owner outweighed the free speech interests involved."

In gist, trademark and copyright owners must be aware that although the parody defence as seen in the *Louis Vuitton* case has not been tested in Malaysian courts, it provides a potential defence to copycats who wish to produce counterfeits of poor quality under the guise of "parody".

In such cases, it is crucial that brand owners take steps to protect their trademarks and copyright by employing qualified persons and experts to analyze the counterfeit and to ensure that counterfeits could not bypass the infringement test under the guise of "parody".

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