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# ARTICLE

## THE EXCLUSIVE RIGHT TO CUSTOMIZE?†

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### ABSTRACT

*Artists, political commentators, and even multinational corporations are increasingly taking existing branded products and modifying them—sometimes to comment on the underlying product, sometimes to make a political or artistic statement unrelated to that product, sometimes to make them look fancier than they are, and sometimes for their own advertising purposes. As ornamenting and customizing existing products has shifted from a personal hobby to a business model, trademark owners have begun to insist that they have the exclusive right to control the appearance of products associated with them or that prominently bear their logos. We call this assertion a claim that there should be an exclusive right to customize. This is a new problem for trademark law. Trademark law doesn't lack for doctrines designed to tackle related problems. Indeed, the problem may be that it has too many doctrines that could potentially be brought to bear. Many of these doctrines point in different directions or apply poorly to common forms of customization. We lay out the approach courts should take to evaluate claims to an exclusive right to customize. We also recommend three modifications to trademark doctrine to broadly protect customization from trademark law without undermining trademark causes of actions against its pernicious forms.*

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## INTRODUCTION

In the spring of 2021, rapper and fashion icon Lil Nas X released a limited line of “Satan Shoes,” repurposed Nike sneakers to which he had added a pentagram, an upside-down cross, a biblical reference to Satan . . . and a drop of human blood.<sup>1</sup> Despite the price (\$1,018, a reference to the Luke 10:18 Bible verse) the 666 pairs of shoes sold out in under a minute.<sup>2</sup>

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<sup>1</sup> The blood apparently came from roughly six employees at Brooklyn art collective MSCHF, which produced the shoes. Bryan Pietsch, *Nike Sues over Unauthorized ‘Satan Shoes,’* N.Y. TIMES (June 18, 2021), <https://www.nytimes.com/2021/03/28/style/nike-satan-shoes-lil-Nas-x.html>.

<sup>2</sup> *Luke 10:18* (describing Satan’s fall from heaven as like lightning); see Oscar Holland & Jacqui Palumbo, *Lil Nas X’s Unofficial ‘Satan’ Nikes Containing Human Blood Sell Out in Under a Minute*, CNN: STYLE (Mar. 29, 2021), <https://www.cnn.com/style/article/lil-nas-x-mschf-satan-nike-shoes/index.html> [<https://perma.cc/482W-4RFF>] (noting other limited-edition drops by manufacturing partner like “Jesus Shoes”).

**Figure 1.** Satan Shoes by Lil Nas X.<sup>3</sup>



Nike was not amused. It sued for trademark infringement.<sup>4</sup> The parties quickly settled with an agreement by Lil Nas X's manufacturing partner, MSCHF, to "recall" the shoes—a largely meaningless gesture, since no buyer was under an obligation to return them.<sup>5</sup>

The Satan Shoes aren't alone. Artists, political commentators, and even multinational corporations are increasingly taking existing branded products and modifying them—sometimes to comment on the underlying product, sometimes to make a political or artistic statement unrelated to that product, sometimes to make them look fancier than they are, and sometimes for their own advertising

<sup>3</sup> Photograph of Satan Shoes, in Pietsch, *supra* note 1.

<sup>4</sup> Pietsch, *supra* note 1.

<sup>5</sup> Jonathan Stempel, *Nike Ends Lawsuit over Lil Nas X 'Satan Shoes,' Which Will Be Recalled*, REUTERS: U.S. LEGAL NEWS (Apr. 8, 2021, 5:08 PM), <https://www.reuters.com/article/us-nike-lil-nas-x/nike-ends-lawsuit-over-lil-nas-x-satan-shoes-which-will-be-recalled-idUSKBN2BV304> [<https://perma.cc/MZC4-LGDZ>].



purposes, such as when McDonald's decided to paint McDonald's images on Sony PlayStation controllers. Sony too was not amused.<sup>6</sup>

**Figure 2.** McDonald's-Branded PlayStation Controller.<sup>7</sup>



We call this phenomenon “aftermarket customization.”

People have been customizing their own consumer products for years. Who among us doesn't have an iPhone or a laptop they've decked out in a way Apple might not approve of? But ornamenting and customizing existing products has shifted from a personal hobby to both a business model and a form of participation in popular culture. Trademark owners have begun to insist that they have the exclusive right to control the appearance of products associated with them or that prominently bear their logos.<sup>8</sup> We call this assertion a claim that there should be an exclusive right to customize. And, in many cases, this claimed right clashes head-on with free speech interests in democratic culture.

<sup>6</sup> Luke Plunkett, *Sony Stops McDonalds from Giving Away PS5 Controllers*, KOTAKU (Aug. 2, 2021), <https://kotaku.com/sony-stops-mcdonalds-from-releasing-ps5-controllers-1847410890> [<https://perma.cc/9R4D-4V2Q>].

<sup>7</sup> Photograph of McDonald's PlayStation 5 Controller, in Adam Vjestica, *McDonald's PS5 Controller Giveaway Gets Shut Down by Sony*, TECHRADAR (Aug. 29, 2021), <https://www.techradar.com/news/mcdonalds-ps5-controller-giveaway-gets-shut-down-by-sony> [<https://perma.cc/74GZ-3SUJ>].

<sup>8</sup> See *infra* Section II.B.

This is a new problem for trademark law. While the law has regularly dealt with cases in which people made their own products or logos that allegedly looked too similar to the trademark owner's, the goods in question here are typically *actual* Nike shoes or PlayStation controllers. They carry the company's marks because they are genuine goods that were made by the trademark owner. And while the law also has no shortage of cases involving trademark owners trying (and generally failing) to stop others from reselling genuine products, those first-sale cases don't involve the sort of modifications Lil Nas X made.<sup>9</sup>

Although the claimed right of trademark owners to control customization is new, trademark law doesn't lack doctrines designed to tackle related problems. Indeed, the problem may be that it has too many doctrines that could potentially be brought to bear. As we show, trademark owners may assert trademark doctrines of consumer confusion, reverse passing off, counterfeiting, dilution by tarnishment, and sponsorship and affiliation confusion.<sup>10</sup> On the other hand, the trademark use requirement, the first sale doctrine, and expressive works defenses may all afford protection from trademark suits. Many of these doctrines point in different directions or apply poorly to common forms of customization.<sup>11</sup>

In Part I, we present the new culture of aftermarket customization. In Part II we discuss the disarray customization creates for trademark law and evaluate the various rules trademark owners and defendants might bring to bear. Finally, in Part III we lay out the approach courts should take to evaluate claims to an exclusive right to customize. That approach is complex because there are so many doctrines in play. We summarize the proper approach in a chart at the end of the paper.

We also recommend three modifications to trademark doctrine to broadly protect customization from trademark law without undermining trademark causes of actions against its pernicious forms. Specifically, we advocate for a broad interpretation of the *Rogers v. Grimaldi*<sup>12</sup> test that reaches beyond traditional categories of works regarded as expressive and recognizes that shoes, cars, and many other products can be and are being used as canvases for expression.<sup>13</sup> This recommendation is limited, but not vitiated, by the Supreme Court's recent decision in *Jack Daniel's Properties, Inc. v. VIP Products LLC*.<sup>14</sup> A broad application of *Rogers* will protect customizations that use marks for their non-source-identifying "expressive meaning" unless the customizer makes a "trademark use" of another brand's mark, the customizer's expression is commercial speech, or the customizer explicitly misleads as to the customization's source. We also support an adapted version of the nominative use defense for customizations that use a mark-bearing good as a "component part" of their finished product, where the mark truthfully indicates the

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<sup>9</sup> See *infra* Section II.C.2.

<sup>10</sup> See *infra* Section II.B.

<sup>11</sup> See *infra* Sections II.C.1, II.C.2, II.D.

<sup>12</sup> 875 F.2d 994, 999 (2d Cir. 1989).

<sup>13</sup> See *infra* Section III.B.

<sup>14</sup> *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1592-93 (2023).

component's source.<sup>15</sup> And we suggest a way to clarify trademark law's first sale doctrine so that it distinguishes between changes to the underlying product itself and changes to the appearance of that product. These modest changes to doctrine will generally protect uses like Lil Nas X's despite their commercial quality, but they are unlikely to protect McDonald's from claims that it confused consumers into assuming it was in a cobranding relationship with Sony or people who "customize" a product to imitate a different one.

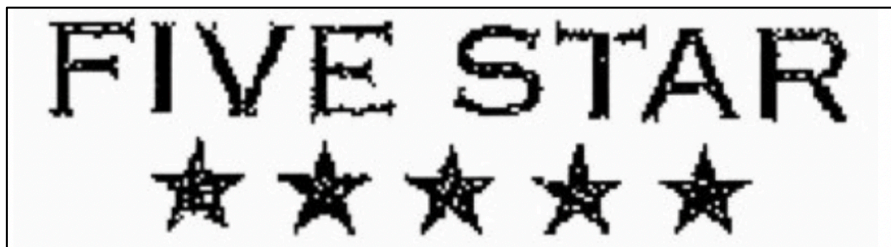
#### I. A CULTURE OF CUSTOMIZATION

We live in a society full of brand-emblazoned and trademark-protected consumer goods, from sticks of butter to all manner of apparel.<sup>16</sup> Indeed, it is difficult to think of very many products that don't bear the mark of their maker—even school notebooks contain Mead's Five Star logo.<sup>17</sup> A number of these marks have taken on cultural meaning aside from signifying their source. Think, for example, of the wildly popular single-color T-shirts, stickers, hats, and other

<sup>15</sup> See *infra* Section III.C.

<sup>16</sup> Sticks of butter have been decorated with trademarks for over one hundred years. See, e.g., *Lawrence v. P.E. Sharpless Co.*, 203 F. 762, 764 (E.D. Pa.) (noting defendant's use of cow trademark on cottage cheese going back to nineteenth century), *aff'd sub nom.* *P.E. Sharpless Co. v. William A. Lawrence & Son*, 208 F. 886 (3d Cir. 1913).

<sup>17</sup> **Figure 3.** Mead Five Star Logo.



FIVE STAR, Registration No. 4,235,401.

products embellished only with the logo of the company Supreme.<sup>18</sup> Other marks are merely a component of the product itself, no more significant than any other design detail.<sup>19</sup>

In this environment, a culture of customization has sprung up that takes these branded products and turns them into something new. A commonplace example might be the middle-school student who elaborately decorates the cover of their Mead Five Star notebook and fills its pages with essays, notes, and doodles, or a young professional who customizes their phone or laptop cover with stickers, art, or jewels. These everyday modifications aren't commercial, and trademark law generally pays them little mind, but the trademark calculus changes when people sell a transformed product that doesn't look like the original.

More complex examples include the swelling aftermarket for customized sneakers, alterations to cars and watches to make them look like other products,

<sup>18</sup> **Figure 4.** Gray Supreme Hat.



Photograph of Gray Supreme Hat, in *Supreme Military Camp Cap*, FARFETCH, <https://www.farfetech.com/shopping/women/supreme-military-camp-cap-item-16943787.aspx> [<https://perma.cc/35JR-VZZC>] (last visited Feb. 10, 2023).

<sup>19</sup> See, e.g., Tracey Panek, *The 80-Year Coverup*, LEVI STRAUSS & CO. (July 6, 2017), <https://www.levistrauss.com/2017/07/06/80-year-cover/> [<https://perma.cc/5EVB-GDXJ>] (describing evolution of hidden rivets in Levi's jeans).

and aesthetic changes to devices such as video game consoles and controllers.<sup>20</sup> But even these examples are a mere sample of a larger cultural practice—what Jack Balkin calls “glomming on,” a characteristic of democratic culture.<sup>21</sup> “Glomming on” refers to appropriating cultural artifacts—including trademarks—and “commenting on them, criticizing them, and, above all, producing and constructing things with them: using them as building blocks or raw materials for innovation and commentary.”<sup>22</sup> Forms of aftermarket customization do just that. And while aftermarket customization is a common way individuals interact privately with the brands and products they encounter, and a way for artists to communicate their message and critique our culture, it is also a burgeoning business. Limited-edition customized consumer products are in high demand, so much so that many sell out instantly as scalpers buy them up to resell at a premium.<sup>23</sup> It should come as no surprise that brands often view these creative reappropriations as a threat to their economic interests and they seek to use trademark law as a vehicle to bring these forms of cultural creation under their control.<sup>24</sup>

In this Part, we introduce the customization aftermarket through a number of examples—from sneaker sculptures to bedazzled bezels—both to demonstrate the expanse of customization as a cultural practice and to raise the trademark issues they present.

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<sup>20</sup> See Chris Scullion, *Black PS5 Faceplate Company Taunts Sony with New Designs Following Legal Threat*, VIDEO GAMES CHRON. (Oct. 19, 2021, 8:39 AM), <https://www.videogameschronicle.com/news/black-ps5-faceplate-company-taunts-sony-with-new-designs-following-legal-threat/> [<https://perma.cc/GM7B-2M2A>].

<sup>21</sup> Jack M. Balkin, Commentary, *Digital Speech and Democratic Culture: A Theory of Freedom of Expression for the Information Society*, 79 N.Y.U. L. REV. 1, 9-14 (2004).

<sup>22</sup> *Id.* at 11. For a discussion of trademarks as part of a cultural conversation, see generally Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397 (1990); and Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717 (1999). *But see* Joseph P. Fishman, *Creating Around Copyright*, 128 HARV. L. REV. 1333, 1340 (2015) (arguing society would get better expression if later users could not rely heavily on existing work).

<sup>23</sup> See Daisuke Wakabayashi, *The Fight for Sneakers*, N.Y. TIMES (Oct. 15, 2021), <https://www.nytimes.com/interactive/2021/10/15/style/sneaker-bots.html>. For example, independent customizer Shoe Surgeon released six pairs of redesigned Air Jordans for \$1,000. The shoes sold out immediately and later resold for \$2,000. Mallory Chin, *Get Your Hands on a Pair of Exotic Custom-Made “Banned” Air Jordan 1s*, HYPEBEAST (Aug. 23, 2016), <https://hypebeast.com/2016/8/the-shoe-surgeon-air-jordan-1-banned> [<https://perma.cc/4AMD7-46UH>]; *Jordan Brand × Nike × The Shoe Surgeon*, GRAILED, <https://www.grailed.com/listings/13761520-jordan-brand-x-nike-x-the-shoe-surgeon-air-jordan-1-retro-high-banned-shoe-surgeon-1-1> [<https://perma.cc/Z6T2-3EPG>] (last visited Feb. 10, 2023); *see, e.g.*, Riley Jones, *Why the Artist Who Made These Viral Sneakers Isn’t Making Any More of Them*, FOOTWEAR NEWS (Jan. 23, 2018, 3:28 PM), <https://footwearnews.com/2018/focus/athletic-outdoor/why-artist-who-made-these-viral-sneakers-isnt-making-any-more-485496/> [<https://perma.cc/6SDJ-VBL7>] (describing Joshua Vides’s customized sneakers that sell out instantly).

<sup>24</sup> *See infra* Section II.B.

A. *Sneaker Gods*

*I know that you're different in your Air Force 1s.*  
—The Chainsmokers<sup>25</sup>

As with many things brand-related in popular culture, shoes have led the way. Lil Nas X's Satan Shoes were perhaps the highest-profile aftermarket sneaker customization, but they fall into a flourishing category of creative expression that blurs the line between commercial activity (i.e., selling sneakers) and art.<sup>26</sup> Another example in this category is Jimm Lasser's "Obama Force One."

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<sup>25</sup> CHAINSMOKERS, *High, on SO FAR SO GOOD* (Disruptor Records & Columbia Records 2022).

<sup>26</sup> *See supra* notes 1-3 and accompanying text.

**Figure 5.** Obama Force One.<sup>27</sup>



Lasser created these custom Nike Air Force 1 sneakers to “mark what he considered to be the most significant moment in the history of his generation, the election of President Obama.”<sup>28</sup> Lasser “took a pair of iconic Nike Air Force 1s and transformed them into a commemorative sculpture” by adding “customized rubber soles” engraved with two portraits of President Obama and the phrase, “A Black Man Runs and a Nation is Behind Him.”<sup>29</sup> Lasser’s *Obama*

<sup>27</sup> Photograph of Jimm Lasser’s Obama Force One, in *Jimm Lasser, Obama Force One, 2008*, PHILLIPS, <https://www.phillips.com/detail/jimm-lasser/NY011118/9> [<https://perma.cc/2GZG-DKJ8>] (last visited Feb. 10, 2023).

<sup>28</sup> *Id.*

<sup>29</sup> *Id.*

*Force One* sneakers have been displayed in gallery exhibitions and featured in the Phillips Gallery auction, “Tongue + Chic Sneakers x Artists.”<sup>30</sup> The Phillips auction, and another auction held by the famed Sotheby’s, featured an array of works by artists who use branded sneakers as a medium for their own creative expression.<sup>31</sup> For example, Shantell Martin used Converse All Stars as a canvas for her drawn-line work that “question[s] boundaries and draw[s] viewers into larger conversations.”<sup>32</sup> Nicholas Avery refaced and added internal lights to a pair of Nike Air Force 1s—creating what he called “Fuck Mags”—to express

<sup>30</sup> *Tongue + Chic Sneakers x Artists*, PHILLIPS, <https://www.phillips.com/auctions/auction/NY011118> [<https://perma.cc/Q7X9-2AG4>] (last visited Feb. 10, 2023) (listing Lasser’s work alongside nineteen other customized sneakers).

<sup>31</sup> *Id.*; *Cult Canvas*, SOTHEBY’S, <https://www.sothebys.com/en/digital-catalogues/cultcanvas-2> (last visited Feb. 10, 2023).

<sup>32</sup> **Figure 6.** Shantell Martin’s Worn and Drawn Upon Converse All Stars.



Photograph of Shantell Martin’s Converse All Stars, in *Shantell Martin’s Worn and Drawn Upon Converse All Stars*, PHILLIPS, <https://www.phillips.com/detail/shantell-martin/NY011118/3> [<https://perma.cc/YPP3-ABV6>] (last visited Feb. 10, 2023).



the outrage felt by “true sneaker heads” at the exorbitant price of the Air Mags Nike released in 2012.<sup>33</sup>

While some of these customized sneakers may conceivably continue to be worn, other artistic customizations render their underlying product functionally useless. Consider Christophe “Monsieur Plant” Guinet’s plant sculptures: recycled old Nikes reskinned with moss, bark, and flowers.<sup>34</sup>

<sup>33</sup> Figure 7. Fuck Mags.



Photograph of Nicholas Avery’s *Fuck Mags*, in *Theheyman, Fuck Mags*, 2012, PHILLIPS, <https://www.phillips.com/detail/theheyman/NY011118/8> [https://perma.cc/B785-AHS7] (last visited Feb. 10, 2023).

<sup>34</sup> Mark Wilson, *This Artist Turns Old Nikes into Sculptural Marvels Made of Moss, Bark, and Rock*, FAST CO. (Oct. 22, 2021), <https://www.fastcompany.com/90688814/this-artist-turns-old-nikes-into-sculptural-marvels-made-of-moss-bark-and-rock> [https://perma.cc/L4SY-KDS9].

**Figure 8.** Tropical, Captain Wood, and Fossil.<sup>35</sup>



Not all sneaker customizations are works of footwear fine art. The vast and growing aftermarket for customized footwear encompasses a broad spectrum of alterations, additions, and redesigns. Customizers, as they're known within sneaker culture, purchase branded sneakers (sometimes counterfeits, which is problematic for its own reasons) and apply their own colorways, illustrations, and design elements.<sup>36</sup> For instance, Drip Creationz, a California-based customizer, altered Nike Air Force 1 sneakers with new fabrics and print designs, from bandanas and butterflies to Chester, the Cheetos Cheetah.<sup>37</sup> And the Shoe Bakery sold "Red Velvet Sneakers": genuine Nike Air Force 1s customized to look like a frosted cake.<sup>38</sup>

<sup>35</sup> Photograph of *Tropical*, *Captain Wood*, and *Fossil*, in *id.*

<sup>36</sup> See *In New Lawsuit, Nike Says It Cannot Allow "Customizers" to Build Businesses off of Its Famous Trademarks*, FASHION L. (July 21, 2021), <https://www.thefashionlaw.com/in-new-suit-nike-says-it-cannot-allow-customizers-to-build-businesses-off-of-its-famous-trademarks/> [https://perma.cc/JE84-M5BB].

<sup>37</sup> Complaint at 2-3, *Nike, Inc. v. Customs by Ilene, Inc.*, No. 21-cv-01201 (C.D. Cal. July 19, 2021) [hereinafter *Nike v. Customs Complaint*]. After the suit was filed, Drip Creationz stopped altering genuine Nikes and began producing their own similar shoes to customize. See *Artist Collection*, DRIP CREATIONZ, <http://web.archive.org/web/20211208145358/https://www.dripcreationz.com/collections/artist-collection> (last visited Feb. 10, 2023) (featuring sneaker designs adorned with likenesses of artists such as Billie Eilish, Ariana Grande, and Taylor Swift). It's not obvious that doing so improved their legal case, though. Indeed, it might have made it worse, but the company no longer seems to be in operation.

<sup>38</sup> Shoe Bakery™ (@shoebakery), INSTAGRAM (Oct. 19, 2021), <https://www.instagram.com/p/CVOLJTDJrK/>.

**Figure 9.** Red Velvet Cake Sneakers.<sup>39</sup>



Brands themselves also participate in custom sneaker culture.<sup>40</sup> Nike has engaged in collaborations with a number of sneaker artists to create and sell

<sup>39</sup> Photograph of Red Velvet Cake Sneakers, *in id.*

limited-release sneakers, such as Jeff Staple's 2005 *NYC Pigeon Nike Dunk Low Pro SB*, which is recalled as "one of the wildest Nike drops in history."<sup>41</sup> Staple's design was inspired by "the ubiquitous NYC pigeon," and it featured an outsole with a "pigeon-foot like color, and a pigeon embroidered on the heel."<sup>42</sup>

### B. *Bedazzled Bezels*

Jewelers have been in the customization business for a long time, adding a name or a special date to watches and jewelry. Much like sneaker customization, watch customization encompasses a broad range of alterations, from engraving, to adding diamonds, to retaining a watch's movement but changing virtually every other external feature.<sup>43</sup> Some of these customizations are made at a purchaser's request, while others are created by the jeweler and offered for sale to the general public.<sup>44</sup>

Sometimes, jewelers add diamonds to a luxury watch bezel to make it appear like an existing, higher-end luxury watch. For example, in *Cartier v. Symbolix Inc.*,<sup>45</sup> Cartier sued a jeweler in Texas for polishing and adding diamonds to authentic stainless steel Cartier *Tank Française* watches to make them appear indistinguishable from the more-expensive white gold Cartier *Tank Française* watches.<sup>46</sup>

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<sup>40</sup> Major fashion houses are also getting in on cross-brand customization as cultural "hacking." See Alice Cary, *Gucci's "Hacking" of Balenciaga Is a Fashion Power Move—And Finally Available to Shop*, VOGUE (Nov. 15, 2021), <https://www.vogue.com/article/balenciaga-gucci-collaboration> [<https://perma.cc/6HU5-U5XJ>] (describing collaboration between Gucci and Balenciaga as featuring purposeful themes of contamination and graffiti). For discussion of this phenomenon, see generally Jeanne C. Fromer, *Trademark Ownfringement*, SING. J. LEGAL STUD. (forthcoming 2023), [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=4322709](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4322709) [<https://perma.cc/57KJ-MBAJ>].

<sup>41</sup> Jeff Ng "Jeff Staple" | 'NYC Pigeon' Nike Dunk Low Pro SB Dual-Signed by Jeff Staple | Size 10, SOTHEBY'S [hereinafter *NYC Pigeon Signed by Jeff Staple*], <https://www.sothebys.com/en/buy/auction/2020/cult-canvas/jeff-ng-jeff-staple-nyc-pigeon-nike-dunk-low-pro> (last visited Feb. 10, 2023); see also Ian Servantes, *LeBron James & Nike Want You to Draw All Over Your AF1*, HIGHSNOBIETY, <https://www.highsnobiety.com/p/lebron-james-uninterrupted-nike-air-force-1/> [<https://perma.cc/P3CB-UGYT>] (last visited Feb. 10, 2023) (describing collaboration between LeBron James and Nike that encouraged wearers to draw on their Air Force 1s with sharpies).

<sup>42</sup> *NYC Pigeon Signed by Jeff Staple*, *supra* note 41.

<sup>43</sup> See, e.g., Cait Bazemore, *A One-of-a-Kind Roger W. Smith Series 1 Watch Is Heading to Auction Next Week*, ROBB REP. (Nov. 5, 2022), <https://robbreport.com/style/watch-collector/custom-roger-w-smith-series-1-watch-1234768207/> [<https://perma.cc/8ECT-SSG8>] (featuring custom dial and interior engravings).

<sup>44</sup> *Id.*

<sup>45</sup> 454 F. Supp. 2d 175 (S.D.N.Y. 2006).

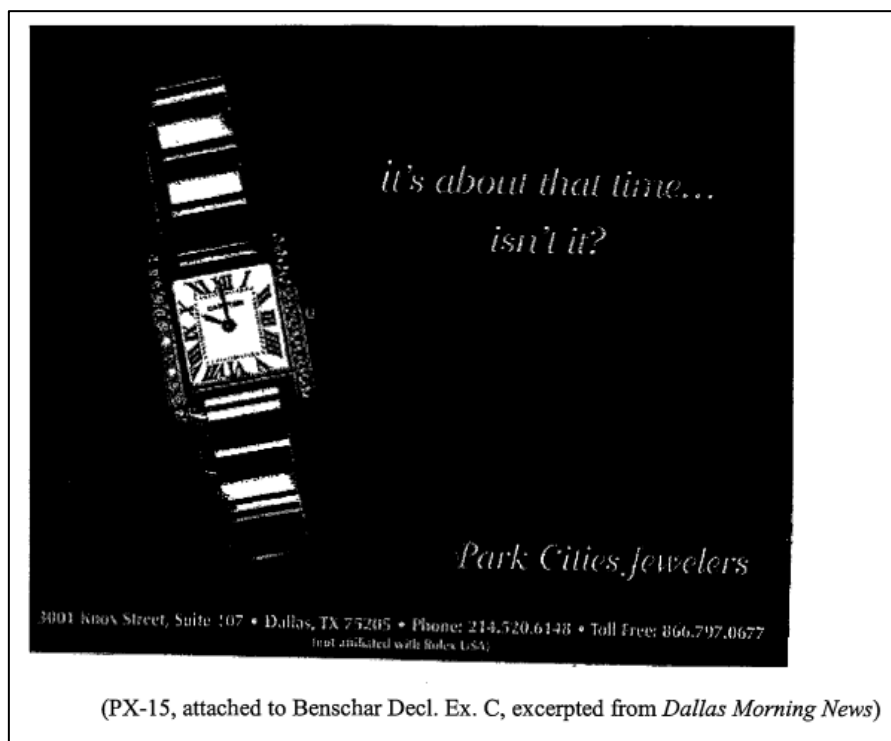
<sup>46</sup> *Id.* at 177-78; see *Cartier v. Aaron Faber Inc.*, 512 F. Supp. 2d 165, 168 (S.D.N.Y. 2007); *Cartier v. Aaron Faber Inc.*, 396 F. Supp. 2d 356, 363 (S.D.N.Y. 2005) (granting preliminary injunction against watchmaker, preventing J & P from selling, advertising, or distributing modified Cartier watches); see also *Rolex Watch USA, Inc. v. Meece*, 158 F.3d 816, 827-29 (5th Cir. 1998) (remanding action for lower court to decide whether watches were effectively counterfeits—a dubious claim—and affirming injunction against jeweler fabricating embellished watches and offering them for sale to general public). The injunction, however,

**Figure 10.** Cartier *Tank Française* Watch.<sup>47</sup>



did not limit the jeweler from making the same sorts of changes, if requested by a customer, to a watch that customer already owns. See *Symbolix*, 454 F. Supp. 2d at 186.

<sup>47</sup> Photograph of *Tank Française*, in *Cartier, Tank Française, Small Model*, TOURNEAU, <https://www.tourneau.com/watches/cartier/tank-francaise-small-model-w4ta0008-CAR0220147.html> [<https://perma.cc/DSY7-M73X>] (last visited Feb. 10, 2023).

**Figure 11.** Park Cities Jewelers *Tank Française* Advertisement.<sup>48</sup>

Sometimes, jewelers also incorporate a luxury brand’s movement and existing name engraving into an otherwise jeweler-made watch. In an older case, *Bulova Watch Co. v. Allerton Co.*,<sup>49</sup> Bulova sued a watchmaker that re-cased Bulova movements into altogether new watches and retained the “Bulova” mark on the watch’s dial, while leaving the watchmaker’s own mark too inconspicuous.<sup>50</sup> In a similar recent Second Circuit case, Hamilton sued a watchmaker for retaining the “Hamilton” mark on Hamilton pocketwatch faces and refurbished movements that the watchmaker incorporated into otherwise new wristwatches.<sup>51</sup>

<sup>48</sup> Photograph of *Tank Française* Advertisement, in Supplemental Declaration of Tal S. Benschar Exhibit C at 4, *Cartier v. Symbolix Inc.*, No. 05-cv-02777 (S.D.N.Y. Dec. 1, 2005).

<sup>49</sup> 328 F.2d 20 (7th Cir. 1964).

<sup>50</sup> *Id.* at 22-24; see also *Rolex Watch, U.S.A., Inc. v. Michel Co.*, 179 F.3d 704, 713-14 (9th Cir. 1999).

<sup>51</sup> *Hamilton Int’l Ltd. v. Vortic LLC*, 13 F.4th 264, 267-68 (2d Cir. 2021).



**Figure 12.** Vortic Watch with Hamilton Mark.<sup>52</sup>



C. *McPlayStation and Prime Kicks*

While most aftermarket customization involves creators adding their own original art or design to a branded product, another category of customization has gained the attention—and ire—of brand owners: the application of third-party brands' logos and imagery to a trademark-protected good. This includes, for example, McDonald's release of a PlayStation 5 controller decorated with French fries, a hamburger, McDonald's red, yellow, and white color scheme, and its iconic golden arches without securing a license from Sony.<sup>53</sup> And it includes Red Bull's "Wings Team": Mini Coopers decked out in Red Bull branding, toting an enormous Red Bull can.<sup>54</sup>

<sup>52</sup> Photograph of Vortic Watch with Hamilton Mark, in Christopher Wood, *Fort Collins' Vortic Watch Wins Battle with Swatch Unit Hamilton*, LOVELAND REP.-HERALD (Dec. 26, 2021, 10:33 AM), <https://www.reporterherald.com/2021/12/26/fort-collins-vortic-watch-wins-battle-with-swatch-unit-hamilton/> [<https://perma.cc/AK68-B99C>].

<sup>53</sup> See Plunkett, *supra* note 6.

<sup>54</sup> Tom Appel, *What Was the Red Bull Car?*, DAILY DRIVE (Jan. 3, 2018), <https://blog.consumerguide.com/red-bull-car/> [<https://perma.cc/4XS3-8X87>].

**Figure 13.** Red Bull “Wings Team” Mini Cooper.<sup>55</sup>



It also extends to a sizable component of the sneaker customization aftermarket. For example, a number of Drip Creationz’s customized sneakers included little more than other brands’ imagery, from Cheetos’s Chester the Cheetah to the Chick-fil-A cows and slogan “Eat Mor Chikin” to the characters of SpongeBob SquarePants.<sup>56</sup> Jeffrey Waskowiak, another sneaker customizer, released a pair of “Custom Prime Nike Air Jordan 1s”—a pair of authentic Nike shoes with “a ‘custom leather lined tongue made from Amazon Prime bubble mailer packaging,’” a recycling icon, and extensive Amazon Prime branding.<sup>57</sup>

<sup>55</sup> Photograph of Red Bull “Wings Team” Mini Cooper, *in id.*

<sup>56</sup> See Nike v. Customs Complaint, *supra* note 37, at 2-3.

<sup>57</sup> Complaint at 3, Nike, Inc. v. Waskowiak, No. 21-cv-01068 (D. Or. July 19, 2021) [hereinafter Nike v. Waskowiak Complaint].



**Figure 14.** Waskowiak’s Custom Prime Nike Air Jordan 1s.<sup>58</sup>



This form of customization is unlike the footwear fine art discussed earlier. While the moss and Obama sneaker sculptures are unlikely to be worn, these customized products change the expressive quality of the underlying product while retaining its original function.<sup>59</sup> McDonald’s uses the PS5 controller to advertise its own products and Jeffrey Waskowiak engages in commentary about Amazon’s environmental impact.<sup>60</sup> Nevertheless, one can still play Assassin’s Creed Valhalla on a McDonald’s PS5 controller and wear Prime Nike Air Jordan 1s while playing Beat Saber.

#### D. Bentley Bodies

In yet another category of cases, the customizer alters a product to make it look like a different brand’s product. Automotive body kits, for example, are modified car body parts and additional components that customizers install on a base car.<sup>61</sup> A body kit is made to fit an underlying model (say, a Mazda CX-5) and give it a totally new external appearance through the addition of new bumpers, side skirts, spoilers, hoods, and other parts.<sup>62</sup> In some cases, when those body kits are fully assembled, they imitate the external appearance of other, luxury car brands. For example, in *Bentley Motors Ltd. v. McEntegart*,<sup>63</sup>

<sup>58</sup> Photograph of Custom Prime Nike Air Jordan 1s, *in id.*

<sup>59</sup> See *supra* notes 27-30 and accompanying text.

<sup>60</sup> See Nike v. Waskowiak Complaint, *supra* note 57, at 3.

<sup>61</sup> See Press Release, Newswire, Why Aftermarket Car Body Kits Are Better than Original Equipment Manufacturer Car Parts (Dec. 28, 2012), <https://www.newswire.com/why-aftermarket-car-body-kits-are/207961> [<https://perma.cc/2K86-2QLB>].

<sup>62</sup> See *id.*

<sup>63</sup> No. 12-cv-1582-T-33TBM, 2012 WL 4458397 (M.D. Fla. Sept. 26, 2012).

Bentley sued a body-kit maker for “manufactur[ing] Bentley body kits that transform ordinary and inexpensive Chrysler and Ford vehicles into knockoff Bentley vehicles.”<sup>64</sup>

**Figure 15.** Vehicle Modified to Resemble a Bentley.<sup>65</sup>



And Ferrari sued another body-kit maker for transforming a Pontiac Fiero into a Ferrari look-alike.<sup>66</sup>

<sup>64</sup> *Id.* at \*1; *see also* *Lamborghini v. Johnson*, No. 13-cv-1136, 2014 WL 4388425, at \*3 (N.D. Ala. Aug. 29, 2014) (entering default judgment against defendants who allegedly produced Lamborghini parts for use in kit cars); *BMW of N.A., LLC v. Zahra*, No. C 15-2924, 2016 WL 215983, at \*2, \*5-6 (N.D. Cal. Jan. 19, 2016) (enjoining defendants from manufacturing and selling BMW-branded automobile parts for use in kit cars); *Gen. Motors Co. v. Urb. Gorilla, LLC*, No. 06-CV-00133, 2010 WL 5395065, at \*1 (D. Utah Dec. 27, 2010) (finding defendant’s body kits likely to be confused with General Motors’ Hummer trademarks).

<sup>65</sup> Photograph of Kit Car Bentley, *in* Complaint at 48, *McEntegart*, 2012 WL 4458397 (No. 12-cv-1582-T-33TBM).

<sup>66</sup> *See Ferrari S.P.A. Esercizio v. Roberts*, 944 F.2d 1235, 1237-38 (6th Cir. 1991).

**Figure 16.** Vehicle Modified to Resemble a Ferrari.<sup>67</sup>



E. *Branded Parts and Upcycled Beer Bottles*

Branded products often become components of other finished goods. It happens so often with complex corporate products that we take it for granted. Your car, your phone, and even your toaster contain lots of third-party components that are individually branded, though their presence and marks are generally invisible to the buyer.

Increasingly, products announce the provenance of the components they feature. A Dell laptop may have “Intel Inside” powering the computer.<sup>68</sup> Dairy Queen advertises “Reese’s Peanut Butter Cup” and “Oreo” inside their blended soft-serve Blizzards.<sup>69</sup> Restaurants may highlight the provenance of their “genuine Angus beef.”<sup>70</sup> Burger King and many other burger places point to the

<sup>67</sup> Photograph of Alleged Counterfeit Ferrari, in *Fake Ferrari Stars in Anti-Privacy Show*, MOTOR1.COM (Mar. 11, 2008, 1:13 PM), <https://www.motor1.com/news/1769/fake-ferrari-stars-in-anti-piracy-show/> [<https://perma.cc/346S-VYAB>].

<sup>68</sup> See Matt Elliott, *Dell Inspiron 16 2-in-1 Review: Spacious Laptop, Oversized Tablet*, PCWORLD (Sept. 21, 2022, 3:45 AM), <https://www.pcworld.com/article/1068741/dell-inspiron-16-2-in-1-review.html> [<https://perma.cc/7GQJ-ZMUB>].

<sup>69</sup> See *Treats Menu*, DAIRY QUEEN, <https://www.dairyqueen.com/en-us/menu/treats/> [<https://perma.cc/7T8F-U4HE>] (last visited Feb. 10, 2023).

<sup>70</sup> See, e.g., *Burger Giant McDonald’s Pulls Out of Angus Verification Program*, BEEF CENT. (Sept. 30, 2020), <https://www.beefcentral.com/news/burger-giant-mcdonalds-pulls->

plant-based “Impossible Burgers” they sell.<sup>71</sup> Bands that, in a prior era, would have thanked musicians in liner notes now prominently add “ft.” or “feat.” to show that particular tracks feature outside musicians.<sup>72</sup>

Most of these component relationships are contracted and licensed. Indeed, the contract may even specify the credit to be given or withheld, as Intel does with its Intel Inside stickers. But sometimes customizers use branded goods as components in a product without the agreement of the trademark owner, like a drug compounded in part from the plaintiff’s ingredients.<sup>73</sup>

The aftermarket customization of sneakers, watches, and video game controllers we have already described covers a wide range of alterations to these products’ expressive qualities, without adding a new *functional* purpose for the underlying product. But other aftermarket customizations, like the common practice of incorporating branded components into finished goods, involve modifying a trademarked good to change its functional purpose. This type of customization may be called “upcycling” or repurposing. It sometimes involves taking a “found object”—potentially a piece of waste that would otherwise be thrown away—and giving it a new use. “Basura” bags, for example, made by a Filipino women’s collective, take used wrappers from snacks and soft drinks and give them a second life as tote bags and lunch boxes.<sup>74</sup>

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out-of-angus-verification-program/ [https://perma.cc/X4ZQ-GHEW] (noting McDonald’s adopted independent verification process to verify that its burgers are genuine Angus beef).

<sup>71</sup> See, e.g., Sigal Samuel, *The Many Places You Can Buy Beyond Meat and Impossible Foods*, in *One Chart*, Vox (Jan. 15, 2020, 12:50 PM), <https://www.vox.com/future-perfect/2019/10/10/20870872/where-to-buy-impossible-foods-beyond-meat> [https://perma.cc/N4V4-7WJK].

<sup>72</sup> See Chris Molanphy, *Feat. Don’t Fail Me Now*, SLATE (July 31, 2015, 9:45 AM), <https://slate.com/culture/2015/07/the-history-of-featured-rappers-and-other-featured-artists-in-pop-songs.html> [https://perma.cc/6NFE-KJUN]; see also Laura R. Bradford, *Trademark Law and Agency Costs*, 55 IDEA 193, 225 (2015) (pointing to “Intel Inside” stickers as example of joint sponsorship trend whereby companies link new offerings to established names to build off consumer goodwill).

<sup>73</sup> See *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368-69 (1924) (holding cosmetics producer can refer to ingredient’s trademark so long as it does not deceive public).

<sup>74</sup> *Upcycled Basura Bags Turn Trash into Totes!*, PEOPLE POWER PRESS (Nov. 16, 2017), <https://peoplepowerpress.org/blogs/news/upcycled-bazura-bags> [https://perma.cc/FZ53-PH6U].

**Figure 17.** Basura Recycled Juice Bag.<sup>75</sup>

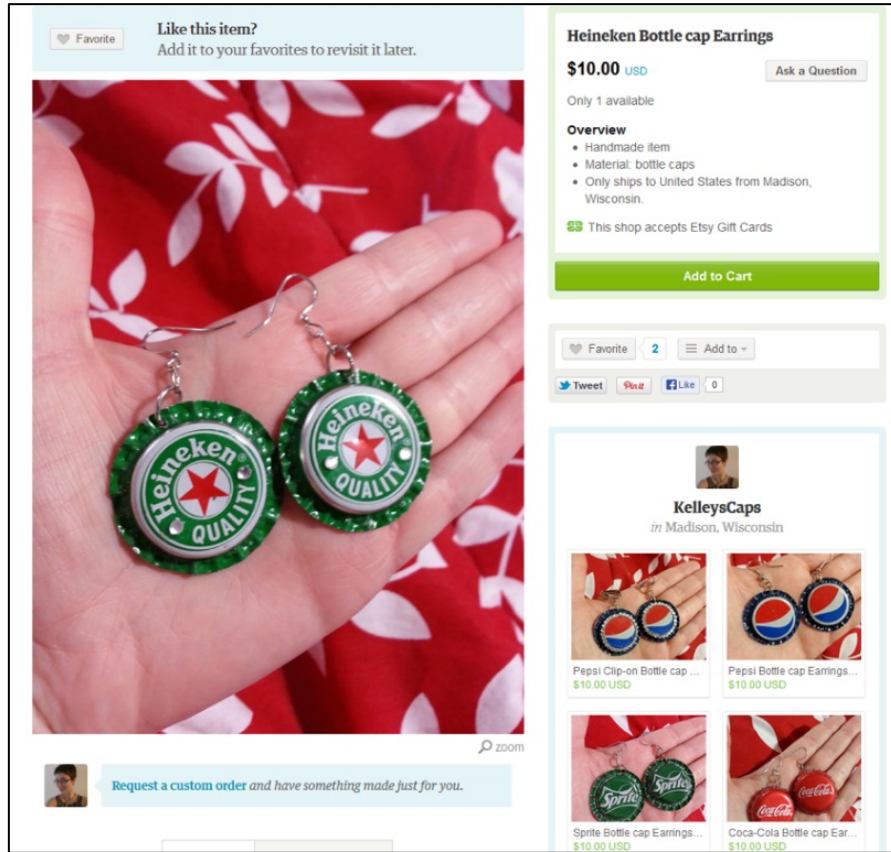


Much like Basura bags, many upcycled goods prominently feature the logos of their recycled components.

Empty containers are also frequently reused. Consider the many upcycled uses of used Heineken bottles. Home crafters might take used Heineken bottle caps and turn them into earrings.

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<sup>75</sup> Photograph of Basura Recycled Juice Bag, in *Grocery Bag—Basura Recycled Juice Bags*, PEOPLE POWER PRESS, <https://peoplepowerpress.org/collections/gift-ideas/products/grocery-bag> [<https://perma.cc/XE3G-P8BG>] (last visited Feb. 10, 2023).

**Figure 18.** Earrings Upcycled from Heineken Bottle Caps.<sup>76</sup>

A watchmaker might insert a beer label onto a watch face.

<sup>76</sup> Photograph of Recycled Heineken Bottle Cap Earrings, in *Recycled Heineken Bottle Cap Earrings*, TESORO, <https://www.tesorostcroix.com/shop/recycled-bottle-cap-jewelry/recycled-heineken-bottle-cap-earrings/> [<https://perma.cc/Z59A-LPF9>] (last visited Feb. 10, 2023).



**Figure 19.** Upcycled Heineken Bottle Cap Watch.<sup>77</sup>



Others might turn the used bottle itself into a drinking glass.

**Figure 20.** Upcycled Heineken Bottle Made into Drinking Glass.<sup>78</sup>



Other artisans have turned hard seltzer cans into “can-dles.”

<sup>77</sup> Photograph of Upcycled Heineken Bottle Cap Watch, in *Heineken Watch! Water Resistant! BNIB!!!*, WORTHPOINT, <https://www.worthpoint.com/worthopedia/heineken-watch-water-resistant-bnib-454710903> [<https://perma.cc/359W-E9X3>] (last visited Feb. 10, 2023).

<sup>78</sup> Photograph of Upcycled Heineken Bottles Made into Glasses, in *Heineken Drinking Glass*, ETSY, <https://www.etsy.com/listing/1130857309/heineken-drinking-glass?gpla=1&gao=1> [<https://perma.cc/S8SE-RSWK>] (last visited Feb. 10, 2023).



**Figure 21.** Upcycled Hard Seltzer Cans Made into Candles.<sup>79</sup>



F. *Bulova Does Battle, Nike Wages War*

The customization aftermarket covers a broad array of practices, and we don't purport to describe the full range here. Instead, we mention these examples to cast light on both the commonplace and broad nature of customization and to suggest the many questions customization raises about trademark law's proper scope and application.

Courts have interpreted trademark law's application to customization in only a limited set of cases involving a small subset of the universe of customization.

<sup>79</sup> Photograph of Upcycled Hard Seltzer Cans Made into Candles, in *TRULY Seltzer Can Scented Candle- Gift for Her or Him, Christmas, Birthday, Bridesmaids, Groomsmen, Stress Relief*, ETSY, <https://www.etsy.com/listing/1117160084/truly-seltzer-can-scented-candle-gift> [<https://perma.cc/G9FX-MPZU>] (last visited Feb. 10, 2023).

Many of those concern alterations to luxury watches and car body kits. In the first line of watch cases, luxury watchmakers sued jewelers who took authentic lower-end watches and made them appear like higher-end luxury watches for trademark infringement and counterfeiting. The issue in these cases is not that the jewelers made unauthorized alterations to the underlying genuine watch, but that the final product closely imitated an existing high-end model. Although the final product is not a counterfeit in the strict meaning of that term because it starts with a genuine product and the trademark is not reproduced or imitated,<sup>80</sup> courts have nonetheless held as much.<sup>81</sup>

The second line of watch cases involves watchmakers re-casing genuine watch parts that bear the parts maker's trademark. In *Bulova Watch Co.*, Bulova argued that a watchmaker's retention of the Bulova trademark on Bulova watch movements that were re-cased into altogether new watches would confuse consumers into thinking Bulova made the watches.<sup>82</sup> The court assessed whether retaining the Bulova trademark would cause a likelihood of confusion by looking at whether the watches and related advertising made clear that the Bulova movement was merely a component of an otherwise "new construction" by Allerton.<sup>83</sup> Ultimately, it held that Allerton's disclosures were insufficient and, worse still, the disclosures suggested the watches as a whole were Bulova creations.<sup>84</sup> On appeal, the Seventh Circuit held Allerton must *remove* the Bulova mark altogether, despite the genuine Bulova watch movement, because the watch case could not possibly accommodate a sufficiently clear and legible disclosure.<sup>85</sup> The recent Second Circuit case, *Hamilton International Ltd. v. Vortic LLC*,<sup>86</sup> came to the opposite conclusion on a similar set of facts.<sup>87</sup> The court held a watchmaker sufficiently disclosed that it incorporated vintage Hamilton pocket-watch faces and refurbished movements into otherwise new wristwatches, even though it retained the "Hamilton" mark on the face and movement.<sup>88</sup>

Car body kit cases have proceeded on a similar theory. For instance, the trademark issue in *McEntegart* is that the appearance of the final, customized

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<sup>80</sup> See 18 U.S.C. § 2320(f)(1)(A)(ii) (defining "counterfeit mark" as one "identical with, or substantially indistinguishable from," mark registered in U.S. Patent and Trademark Office).

<sup>81</sup> See *supra* notes 46-51.

<sup>82</sup> *Bulova Watch Co. v. Allerton Co.*, 328 F.2d 20, 22 (7th Cir. 1964); see also *Rolex Watch, U.S.A., Inc. v. Michel Co.*, 179 F.3d 704, 710 (9th Cir. 1999) (holding reseller could be prohibited from retaining original "Rolex" mark on altered watches).

<sup>83</sup> *Bulova Watch Co.*, 328 F.2d at 22.

<sup>84</sup> *Id.* at 23.

<sup>85</sup> See *id.*

<sup>86</sup> 13 F.4th 264 (2d Cir. 2021).

<sup>87</sup> See *id.* at 277 (affirming district court finding that refurbished wristwatch maker did not infringe trademark of original pocket watch maker).

<sup>88</sup> See *id.* at 279.

vehicle might confuse people into thinking Bentley made it.<sup>89</sup> Courts have sometimes agreed. In *Ferrari S.P.A. Esercizio v. Roberts*,<sup>90</sup> the Ninth Circuit held a defendant infringed Ferrari's rights by making a Pontiac Fiero look like a Ferrari.<sup>91</sup> By contrast, other kit replicas are less likely to be confused with the original.<sup>92</sup>

**Figure 22.** The “Rolls-Beetle” Conversion.<sup>93</sup>



Much like the first line of watch cases, the plaintiff in body kit cases is almost always the maker of the car being imitated—the Ferrari or the Rolls-Royce. Manufacturers of the base car that is being customized—the Pontiac or

<sup>89</sup> *Bentley Motors Ltd. v. McEntegart*, No. 12-cv-1582-T-33TBM, 2012 WL 4458397, \*1 (M.D. Fla. Sept. 26, 2012) (discussing plaintiff's assertion that defendants unlawfully used Bentley's likeness to increase sales).

<sup>90</sup> 944 F.2d 1235 (6th Cir. 1991).

<sup>91</sup> *See id.* at 1246.

<sup>92</sup> *See, e.g., Rolls-Royce Motors Ltd. v. A & A Fiberglass, Inc.*, 428 F. Supp. 689, 694-95 (N.D. Ga. 1976) (finding infringement where kits “substantially identical” to trademarked products).

<sup>93</sup> Photograph of the “Rolls-Beetle” Conversion, in *Current Freaks in the Oldbug.com Collection*, OLDBUG.COM, <https://www.oldbug.com/freak.htm> [<https://perma.cc/8L2V-AYJL>] (last visited Feb. 10, 2023).

Volkswagen—generally haven't claimed such alterations infringe *their* marks in the underlying vehicle.<sup>94</sup>

Outside of this narrow set of cases, it's unclear how trademark law might apply to many other forms of aftermarket customization. Though upcycling is a commendable practice to reduce our environmental impact, when the “found objects” used to make upcycled goods contain trademarks, trademark owners might object, particularly if they don't like the use to which their product is being put. For instance, Jose Vila drew FedEx's ire for his furniture built from free FedEx boxes.

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<sup>94</sup> See *supra* notes 64-67 and accompanying text. One notable exception is a case in which Ford sued a company that modified its trucks into limousines. *Ford Motor Co. v. Ultra Coachbuilders, Inc.*, No. EDCV 00-00243-VA, 2000 WL 33256536, \* 5 (C.D. Cal. July 11, 2000), *aff'd*, 238 F.3d 428 (9th Cir. 2000). The district court held that no one would think Ford itself had made the modification. See *id.* at \*5 (“[P]laintiff has not shown that the public believes Defendant's limousines are genuine Ford cars, as opposed to limousine conversions made from Ford cars.”). The same is likely true of a putative suit by Pontiac or Volkswagen in the cases just discussed.

**Figure 23.** Couch Built from Free FedEx Boxes.<sup>95</sup>



Chanel recently sued Shiver + Duke, an accessories retailer, for making costume jewelry from “upcycled” Chanel buttons,<sup>96</sup> and Pepsi has sued over the use of its recycled cans as clever drug stash devices.<sup>97</sup>

Trademark owners might assert consumers will believe the trademark owner created the goods. In many cases, like the Basura bag, that claim won’t be credible because it is evident that the new product repurposes used goods. Similarly, a home crafter who takes used Heineken bottle caps and turns them into earrings is unlikely to confuse anyone into thinking Heineken has entered the earring market. The bottle caps are clearly used items the crafter has salvaged.<sup>98</sup>

<sup>95</sup> Jose Avila, Photograph of Couch Built from FedEx Boxes, in *Slideshow: Furniture Causes FedEx Fits*, WIRED (Sept. 11, 2005, 12:00 PM), <https://www.wired.com/2005/09/68492/>.

<sup>96</sup> See Complaint at 1-2, Chanel, Inc. v. Shiver & Duke, LLC, No. 21-cv-01277 (S.D.N.Y. Feb. 12, 2021).

<sup>97</sup> PepsiCo, Inc. v. #1 Wholesale, LLC, No. 07-CV-367, 2007 WL 2142294, at \*1 (N.D. Ga. July 20, 2007).

<sup>98</sup> Or are they? Coca-Cola makes official bottle cap earrings, so anything is possible. See *Coca-Cola Luxe Bottle Cap Earrings*, COCA-COLA, <https://us.coca-cola.com/store/coca-cola-luxe-bottle-cap-earrings> [<https://perma.cc/SK53-53XE>] (last visited Feb. 10, 2023).



By contrast, other uses may be harder to distinguish. A watchmaker who puts a Heineken beer label on the face of the watch makes a product that looks more plausibly like a promotional product made (or at least sponsored) by Heineken.<sup>99</sup> And the risk of confusion might be heightened when the upcycler creates a product that serves the same function as the trademark owner's official promotional goods, like the beer glass made from a Heineken bottle.

**Figure 24.** Official Promotional Heineken Beer Glass.<sup>100</sup>



Other times, the application of trademark law to aftermarket customization seems confused. For example, some courts have found liability for including genuine component products in an end good even when the maker truthfully told consumers it had done so. In *Suzuki Motor Corp. v. Jiujiang Hison Motor Boat Mfg. Co.*,<sup>101</sup> the defendant installed a genuine Suzuki snowmobile engine as the power plant in the defendant's inboard motorboat. Because the engine was used for a purpose for which it was not designed, the court held that damage to plaintiff's reputation could result and granted a temporary restraining order

<sup>99</sup> They also aren't really "reusing" anything about the original product except the logo itself.

<sup>100</sup> Photograph of Heineken Draught Beer Glass, in *Draught Beer*, HEINEKEN, <https://www.heineken.com/global/en/our-products/draught-beer> (last visited Feb. 10, 2023).

<sup>101</sup> No. 12-cv-20626, 2012 WL 529967 (S.D. Fla. Feb. 17, 2012).

against the defendant that prohibited them from touting the fact that its motor boat used a Suzuki engine on resale.<sup>102</sup> This decision is directly contrary to Supreme Court precedent and cannot be good law.<sup>103</sup> But the fact that the case was brought—and that a court bought it—is a sign that both litigants and courts are testing the boundaries of trademark law as applied to aftermarket customization.

Recently there has been an upsurge in cases testing trademark law's application to "unauthorized" customizations far beyond blinged bezels and Bentley bodies, most notably in the custom sneaker market.<sup>104</sup> Nike and other brand owners would like to control the appearance of their products for various reasons—from outrage at being associated with Satanism to straightforward profit motives and a desire to cash in on the customization trend. And their participation in the customization market seems to provide them a basis for extending their trademark rights into this space if it leads consumers to expect customizations are generally licensed collaborations. Others, like Sony, just seem to dislike anyone changing their products, and it has sued those who produce black faceplates that can replace the white faceplates on a PS5.<sup>105</sup>

Aftermarket customization is becoming big business,<sup>106</sup> and more trademark cases are sure to follow. In the summer and fall of 2021, Nike sued a number of customizers for counterfeiting, trademark infringement, trademark dilution, and unfair competition.<sup>107</sup> One of the defendants is Drip Creationz. Nike claims that the shoes Drip Creationz purchased to serve as canvases were counterfeits—

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<sup>102</sup> See *id.* at \*5.

<sup>103</sup> See *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368-69 (1924) (holding trademark may be used if trademark does not deceive public).

<sup>104</sup> Though the Nike suits raise a set of important questions about the proper reach of trademark law into the customization aftermarket, they have yet to generate judicial guidance. Nike's suit against Satan Shoes settled with MSCHF's agreement not to sell any more shoes and to offer to buy back the ones they did sell—a meaningless gesture as the shoes had sold out and commanded a higher price on the resale market than they did when they were launched. See Neil Vigdor, *Company Will Offer Refunds to Buyers of 'Satan Shoes' to Settle Lawsuit by Nike*, N.Y. TIMES (July 7, 2021), <https://www.nytimes.com/2021/04/08/style/satan-shoe-settlement-nike.html>.

<sup>105</sup> Emma Boyle, *Dbrand Declares Its PS5 Darkplates 'Are Dead' After Sony Threatens Legal Action*, TECHRADAR (Oct. 16, 2021), <https://www.techradar.com/news/dbrand-declares-its-ps5-darkplates-are-dead-after-sony-threatens-legal-action> [https://perma.cc/86L5-72AG].

<sup>106</sup> Indeed, customized shoes are so popular that bots are buying out entire runs to scalp them to fans. See Wakabayashi, *supra* note 23.

<sup>107</sup> See, e.g., Nike v. Customs Complaint, *supra* note 37, at 2; Complaint at 5, Nike, Inc. v. La La Land Prod. & Design, Inc., No. 21-cv-0443 (C.D. Cal. Jan. 15, 2021) (stating action arises under trademark and antidilution laws); Nike v. Waskowiak Complaint, *supra* note 57, at 5 (alleging defendants' customized sneakers with Nike logos infringe Nike's trademarks); see also Complaint at 4, Nike, Inc. v. Lotas, No. 20-cv-09431 (C.D. Cal. Oct. 14, 2020) [hereinafter Nike v. Lotas Complaint] (asserting claims for trademark infringement and dilution).

which, if true, would be a straightforward and uncontroversial violation of the law. However, Nike argued that trademark law ought to bar Drip Creationz and other customizers from selling customized *authentic* Nike shoes as well. In its own words:

Nike has no desire to limit the individual expression of creatives and artisans, many of whom are some of Nike's biggest fans. But Nike cannot allow "customizers" like Drip Creationz to build a business on the backs of its most iconic trademarks, undermining the value of those marks and the message they convey to consumers . . . Nike therefore brings this lawsuit to stop "customizers," like Drip Creationz and others, from making and selling illegal "customizations" of Nike's products . . . and to protect its brand, goodwill, and hard-earned reputation.<sup>108</sup>

Despite Nike's asserted desire for trademark law to prohibit customization of its branded products, full stop, it's not at all clear on what basis trademark law would afford that kind of protection and how far that protection would extend. We turn to those questions in the next Part.

## II. TRADEMARK LAW IN THE CUSTOMIZATION AFTERMARKET

### A. *A New Battlefield of Trademark and Free Expression*

The customization aftermarket presents a set of thorny problems for trademark law. Some aspects of these problems are familiar and have played out in other issue areas. Trademark protection and free speech interests clash often enough and as trademark doctrine has developed, it has had to make space for speech at various points. The existing doctrines of nominative and descriptive fair use, exceptions for parodies, and the line of cases following *Rogers* have dealt with different sets of issues at the intersection of trademark and free expression. Other problems are new. As the Satan Shoes example shows, aftermarket customization of consumer goods raises questions about what sorts of customizations fall on the side of protected expression as opposed to trademark infringement, why, and how courts could distinguish lawful from unlawful customizations in a principled way.

We think these new issues will become increasingly important as our consumer culture continues to bloom. Many of our cultural conversations revolve around brands, and innumerable products we passively consume or actively repurpose are emblazoned with a brand's name, logo, or other trademark-protected insignia.<sup>109</sup> Sometimes those conversations involve the

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<sup>108</sup> Nike v. Customs Complaint, *supra* note 37, at 7.

<sup>109</sup> See Dreyfuss, *supra* note 22, at 397 (describing how particularly prominent trademarks have become part of the English language); Litman, *supra* note 22, at 1718 (asserting shifts in American culture compel doctrinal changes in trademark law).



destruction or reuse of a trademarked good precisely to comment on the brand itself, such as when an artist puts a Barbie doll in a blender or an enchilada.<sup>110</sup>

**Figure 25.** Food Chain Barbie (Blender).<sup>111</sup>



**Figure 26.** Food Chain Barbie (Enchiladas).<sup>112</sup>



Other times, aftermarket customizers sell highly modified brand-bearing goods that serve their original function. People wear Air Force 1 sneakers or Satan Shoes as their everyday shoes and use stickered phones and laptops as their personal electronic devices. But from a brand’s perspective, the “intended” use of a shoe or a purse may not just be to enclose feet or carry items but to signal status, wealth, or style. Customization can change that signal, which may be a reason to oppose it or a reason to protect it.

An asserted “exclusive right to customize” that would give trademark owners the right to stop aftermarket customization altogether presents a serious threat to free speech. It would not simply protect trademark owners’ goodwill; it would shut down a form of democratic participation in consumer culture. Nike sneakers are one among many branded canvases for creative expression. Imagine Blick asserting control over what artists can paint on their brand-stamped stretched

<sup>110</sup> See *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806 (9th Cir. 2003) (holding artist’s parodic photographs did not infringe Mattel’s intellectual property rights).

<sup>111</sup> Tom Forsythe, Photograph of Barbie in a Blender, in *Mattel v. Walking Mountain | 2003 . Trademark . Copyright . Trade Dress . Tarnishment . Case Brief*, LEHRMACH (June 4, 2017), <http://lehrmach2.blogspot.com/2017/06/mattel-v-walking-mountain-20003.html> [<https://perma.cc/NTU5-F2LN>].

<sup>112</sup> Tom Forsythe, Photograph of Barbies in Enchilada, in *Barbie Doll Art by Tom Forsythe, America—2001*, SHUTTERSTOCK, <https://www.shutterstock.com/editorial/image-editorial/barbie-doll-art-by-tom-forsythe-america-2001-341412h> [<https://perma.cc/7CG2-NHFJ>] (last visited Feb. 10, 2023).

canvases, or Hanes demanding license fees for six-year-olds to sell homemade tie-dye T-shirts in their school fundraiser.

In Part III, we discuss how we think trademark law should and should not protect trademark owners from downstream customization. But before we suggest the path trademark law should take, we present the trademark doctrines customization has inherited. In the Sections that follow, we consider how trademark infringement doctrines, trademark scope doctrines, and defensive doctrines might apply to aftermarket customization.

#### B. *Customization as Confusion*

Trademark owners might bring several sorts of infringement claims against aftermarket customization, including a plain vanilla suit asserting likelihood of confusion as to source, counterfeiting, reverse passing off, dilution by blurring and by tarnishment, and confusion as to sponsorship or affiliation. However, despite the number of potentially applicable trademark doctrines, even a cursory look into *how* each doctrine would apply reveals that they fit awkwardly with aftermarket customization beyond a limited set of particularly egregious cases.

*Likelihood of source confusion.* Trademark infringement is normally based on the assumption that the defendant has affixed a mark to its products that is confusingly similar to the mark the plaintiff affixes to its products.<sup>113</sup> That's not what's happening in the customization cases. Lil Nas X doesn't copy the Nike Swoosh or anything like it. He resells a genuine Nike shoe to which Nike itself attached the Swoosh; the issue is that he has modified the genuine Nike shoe in ways Nike doesn't like. The normal likelihood of confusion doctrine, which typically applies when third parties use protected marks on altogether different goods, doesn't have a good way of dealing with that situation. Indeed, as we demonstrate below, the resale of genuine products is generally outside the scope of the likelihood of confusion test altogether.

Nike may assert that consumers will likely be confused into thinking that Nike is the source of the customized product—that it made the Satan Shoes. If buyers think Nike is producing the Satan Shoes, Nike may suffer the reputational consequences. But given the nature of Lil Nas X's shoes (and Lil Nas X himself), people are unlikely to think Nike sells them.<sup>114</sup> And the theory that Nike made

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<sup>113</sup> See 15 U.S.C. § 1114 (laying out remedies for trademark violation).

<sup>114</sup> Though evidence suggests some number of people are just perpetually confused. See, e.g., *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 772-73 (8th Cir. 1994) (noting that six percent of people believed parody ad in humor magazine was actually launching new brand of beer); *Uber Promotions, Inc. v. Uber Techs., Inc.*, 162 F. Supp. 3d 1253, 1272 (N.D. Fla. 2016) (noting consumers are "so easily confused that even trademark law cannot protect [them]"); see also Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 723 (2004) (observing trademark law treats public as "unsophisticated, easily confused rubes"); Jacqueline Pasquarella, *Trademark Law—Confusion over the Likelihood of Confusion*, 38 VILL. L. REV. 1317, 1319 n.13 (1993) (stating trademark law was intended "for the protection of . . . the public—that vast multitude which includes the ignorant, the unthinking and the credulous" (quoting *Stork Restaurant, Inc. v. Sahati*, 166 F.2d 348, 359 (9th Cir. 1948))).

the Satan Shoes presupposes that people think Lil Nas X is just a retailer of Nike shoes, which seems implausible in the case of Lil Nas X and the Satan Shoes. But other forms of aftermarket customization—say, custom iPhone cases or customized jewelry—look like products that the brand owner themselves might well have produced and might confuse consumers who think the customization was done by the brand owner.

Aftermarket customization, whether of iPhone cases or sneakers, doesn't injure the trademark owner in the traditional way. It hasn't lost a sale; it sold the unmodified shoes to the customizer in the first place. But the brand may suffer reputational consequences from wrongly being thought to have made a subpar or controversial customized product.<sup>115</sup> So while ordinary source confusion doesn't seem a particularly good fit for what is going on here, it is hard to discount it entirely.<sup>116</sup>

*Reverse passing off.* While trademark law is normally concerned with the defendant selling a product that purports to be the plaintiff's (sometimes called "passing off" one's goods as the trademark owner's), the common law also prohibits "reverse passing off."<sup>117</sup> Reverse passing off occurs when the defendant represents to buyers that goods that are actually made by the plaintiff are instead made by the defendant.<sup>118</sup> In our example, if customers thought Drip Creationz made the underlying shoe when in fact they just customized a Nike shoe, Nike might lose out on the goodwill associated with being understood to have made the underlying shoe.

Reverse passing off may seem unlikely with aftermarket customization because the brand and style of the product are clearly visible. But brand components may be less visible or may (like the living shoe sculptures) be altered in ways that make it less clear who made the components.

The potential for both source confusion ("regular" passing off) and reverse passing off in trademark law also leaves customizers in a bit of a catch-22. Keep the logo on the product you modify, and you may be sued by brands who claim you are confusing people into thinking they made the customized version. Remove or obscure the logo to avoid that problem, on the other hand, and you

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<sup>115</sup> Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 438 (2010) (describing how consumers generally do not blame partner brand for host brand's bad actions based solely on fact of association, so that any harm to producers from confusion about sponsorship or affiliation is quite attenuated); see Nicole L. Votolato & H. Rao Unnava, *Spillover of Negative Information on Brand Alliances*, 16 J. CONSUMER PSYCH. 196, 201 (2006) ("This research suggests that a host brand may generally be quite impervious to negative publicity surrounding its partner brand . . .").

<sup>116</sup> As we will see below, even if there were confusion, a number of defenses and limiting doctrines might come into play given how Satan Shoes were actually created. See *infra* Sections II.C, II.D (laying out potential defenses raised by trademark owners).

<sup>117</sup> See Mary LaFrance, *Passing Off and Unfair Competition: Conflict and Convergence in Competition Law*, 2011 MICH. ST. L. REV. 1413, 1420.

<sup>118</sup> See 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25:6 (5th ed. 2021) (explaining "reverse passing off" as misrepresentation occurring when merchant removes trademark from another merchant's good in order to deceive consumers as to its source).

may just as easily be sued by the brand owner for removing the logo and therefore making customers think the customizer made the entire product.<sup>119</sup>

*Counterfeiting.* Counterfeiting concerns a third party's production of a mark "identical with, or substantially indistinguishable from," the plaintiff's trademark that is affixed to a product that is identical or insubstantially different from a trademark-protected product.<sup>120</sup> Aftermarket customizers may be liable for counterfeiting in a fairly narrow set of cases, such as when after-market customizers know that the trademark-emblazoned consumer good they use as their canvas is a counterfeit and not a genuine Rolex, Nike, etc. Another way a customization might become a counterfeit is if the finished product is indistinguishable from an existing trademark-protected product. For instance, Nike sued sneaker artist Warren Lotas for hand-making a "reinterpreted" Staples Pigeon Dunk (that is, without using a genuine Nike Dunk as a base) that at first glance looked incredibly similar to Nike's commissioned 2005 *NYC Pigeon Nike Dunk Low Pro SB*.<sup>121</sup>

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<sup>119</sup> See, e.g., *OTR Wheel Eng'g, Inc. v. W. Worldwide Servs., Inc.*, 897 F.3d 1008, 1018 (9th Cir. 2018) (affirming judgment of reverse passing off when industrial tire distributor removed competitor's "Outrigger" trademark from its tires and passed off those tires as its own to encourage plaintiff's customer to switch suppliers).

<sup>120</sup> 15 U.S.C. §§ 1116(d)(1)(B)(ii), 1127.

<sup>121</sup> Lotas collaborated with Nike's commissioned artist, Jeff Staple. See *Nike v. Lotas Complaint*, *supra* note 107, at 3-4, 8.

**Figure 27.** Warren Lotas’s “Reinterpreted” Staple Pigeon Dunk.<sup>122</sup>



**Figure 28.** Jeff Staple’s NYC Pigeon Nike Dunk Low Pro SB.<sup>123</sup>



Customization of this sort hews close to the bejeweled bezel cases courts have decided. The issue, for the purpose of trademark law, is not that the customizer changed the appearance of the branded consumer good but that the final, customized product is a colorable imitation of *another* branded consumer

<sup>122</sup> Photograph of Warren Lotas’s Pigeon Dunks, in Sarah Osei, *Warren Lotas’ Bootleg Dunks Would Have Made Him over \$10 Million*, HIGHSNOBIETY, <https://www.highsnobiety.com/p/warren-lotas-nike-dunk-lookalikes-sold/> [https://perma.cc/LN8Z-8BRD] (last visited Feb. 10, 2023).

<sup>123</sup> Photograph of Jeff Staple’s NYC Pigeon Nike Dunk Low Pro SB, in Jeff Ng “Jeff Staple” | ‘NYC Pigeon’ Nike Dunk Low Pro SB Dual-Signed by Jeff Staple | Size 10, SOTHEBY’S, <https://www.sothebys.com/en/buy/auction/2020/cult-canvas/jeff-ng-jeff-staple-nyc-pigeon-nike-dunk-low-pro> (last visited Feb. 10, 2023).

good.<sup>124</sup> It's not that jewelers may not add diamonds to bezels, full-stop; rather, they cannot do so in a manner that makes a watch indistinguishable from an existing white gold Cartier *Tank Française*.<sup>125</sup>

Some trademark owners have sought, unsuccessfully, to broaden the definition of counterfeiting,<sup>126</sup> but, as it stands, counterfeiting only applies to a limited type of customization where the final product imitates an existing trademark-protected product. Even then, a strict reading of the statute may not apply if the defendant does not affix the mark to the product, but rather uses a genuine product with an unaltered mark.<sup>127</sup> A literal reading of that language would place most aftermarket customization outside the reach of counterfeiting claims.

*Post-sale confusion.* Similar arguments to both source confusion and reverse passing off may also be asserted not at the point of sale but under a theory of post-sale confusion. The idea of post-sale confusion is that even though the person who bought the product knew what they were getting, someone else might see it on the street and be confused as to who made it.<sup>128</sup> The doctrine has frequently been used in counterfeiting cases to give trademark owners the ability to stop the sale of fake luxury goods even when the person who purchases them knows they are buying a fake.<sup>129</sup>

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<sup>124</sup> See 15 U.S.C. § 1114(1)(a) (defining trademark infringement as use of “any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale . . . of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive”).

<sup>125</sup> See *Cartier, Inc. v. Symbolix, Inc.*, 454 F. Supp. 2d 175, 186 (S.D.N.Y. 2006) (enjoining defendants “from altering, modifying, or causing to be altered or modified any ‘Cartier watches’”); see also *Rolex Watch U.S.A., Inc. v. BeckerTime, LLC*, No. 20-cv-01060, 2022 WL 286184, at \*2, \*8 (N.D. Tex. Jan. 31, 2022) (granting injunction against defendant for adding inferior replacement parts to plaintiff’s watches without marking that defendant sourced the parts).

<sup>126</sup> See, e.g., *Williams-Sonoma, Inc. v. Amazon.com, Inc.*, No. 18-cv-07548, 2019 WL 7810815, at \*3-5 (N.D. Cal. May 2, 2019) (discussing plaintiff’s contention that Amazon’s use of plaintiff’s “[m]ark to accurately identify legitimate Williams-Sonoma products” was “unauthorized” and thus counterfeit, a theory the court derided as “not plausible”). Full disclosure: one of us (Lemley) represented Amazon in this case.

<sup>127</sup> See 15 U.S.C. § 1116(d)(1)(B)(ii) (“[B]ut [a counterfeit mark] does not include any mark or designation used on or in connection with goods or services of which the manufacture[r] or producer was . . . authorized to use the mark or designation for the type of goods or services so manufactured or produced, by the holder of the right to use such mark or designation.”).

<sup>128</sup> See Kal Raustiala & Christopher Jon Sprigman, Commentary, *Rethinking Post-Sale Confusion*, 108 TRADEMARK REP. 881, 882 (2018) (discussing “post-sale confusion”).

<sup>129</sup> See *Symbolix*, 454 F. Supp. 2d at 182 (finding disclosure to purchaser of “aftermarket” diamonds added to Cartier watch and lack of Cartier’s authorization of change had no effect on watch’s “counterfeit nature”); *BeckerTime*, 2022 WL 286184, at \*6 (stating BeckerTime’s sale of non-Rolex bracelets with Rolex clasps qualified as infringement even if sale was result of customer request).



Just confusing people on the street itself isn't a problem, however. To be illegal, post-sale confusion must affect future purchasing decisions on the theory that passers-by who saw the product (1) thought it was supplied by the trademark owner, (2) disliked the product, and (3) were, therefore, less likely to buy a product they otherwise would have purchased.<sup>130</sup> This chain of inferences is quite far-fetched, and many have criticized the post-sale confusion doctrine as targeting a problem that doesn't really exist.<sup>131</sup> But it may be asserted against products like Satan Shoes if they appear to third parties to be Nike products.

*Dilution.* Some trademark owners will assert customizers dilute their marks, either by blurring or by tarnishment. Dilution only protects marks famous to the general consuming public throughout the United States.<sup>132</sup> The standard is a strict one: even reasonably well-known marks like Coach for purses don't qualify.<sup>133</sup> But the owners of famous marks are entitled to enjoin a mark's dilution even if consumers aren't confused.<sup>134</sup> And many, though not all, of the products people want to customize are from famous brands like Nike.<sup>135</sup>

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<sup>130</sup> See Connie Davis Powell, *We All Know It's a Knock-Off! Re-Evaluating the Need for the Post-Sale Confusion Doctrine in Trademark Law*, 14 N.C. J.L. & TECH. 1, 17-18 (2012) (explaining post-sale confusion takes place when potential consumers "believe that the goods are genuine," are "unimpressed as to the quality or prestige of the original goods," and become "dissuaded from purchasing the authentic goods").

<sup>131</sup> Many have criticized the doctrine of post-sale confusion. See, e.g., *id.* at 3-4 (noting research has shown consumers are knowledgeable of counterfeit goods, which makes post-sale confusion doctrine dispensable); Jeremy N. Sheff, *Veblen Brands*, 96 MINN. L. REV. 769, 775-76 (2012) (describing post-sale confusion doctrine as contradicting "the conventional theoretical account of trademarks," and arguing that it "be discarded entirely"); Lemley & McKenna, *supra* note 115, at 445 n.125 (criticizing post-sale confusion doctrine because it is unclear whether confusion "actually affects purchasing decisions"); Raustiala & Sprigman, *supra* note 128, at 884 (arguing that current post-sale confusion doctrine fails to map onto "the core purposes of trademark law, which are to allow consumers to economize on search costs and to facilitate producers' incentives to invest in product quality").

<sup>132</sup> 15 U.S.C. § 1125(c)(2)(A) (limiting injunctive relief from dilution by blurring or tarnishment to marks "widely recognized by the general consuming public of the United States").

<sup>133</sup> See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1376 (Fed. Cir. 2012) (holding Coach failed to provide sufficient evidence of fame for dilution purposes). Sometimes the brands that courts consider famous will surprise you. See, e.g., *Garan, Inc. v. Manimal, LLC*, No. 20-cv-00623, 2022 WL 225060, at \*8 (D. Or. Jan. 25, 2022) (holding "Garanimals" qualifies as "famous" for purpose of dilution claims).

<sup>134</sup> 15 U.S.C. § 1125(c)(1) (explaining plaintiff is entitled to injunctive relief "regardless of the presence or absence of actual or likely confusion").

<sup>135</sup> A number of district courts have held Nike's marks in its name, Swoosh, and slogans are famous for purposes of antidilution law. See, e.g., *Nike, Inc. v. Carpenter*, No. C 08-03261, 2009 WL 10696433, at \*1 (N.D. Cal. Feb. 6, 2009) ("[A]ll of the Nike trademarks qualify as famous marks . . ."); *Nike, Inc. v. Nikepal Int'l, Inc.*, No. 05-cv-01468, 2007 WL 2782030, at \*8 (E.D. Cal. Sept. 18, 2007) ("[I]f relief is not granted to Nike under its dilution claim, it will face an escalating erosion of its famous mark . . ."); *Nike, Inc. v. Lydner*, No. 07-cv-1654, 2008 WL 4426633, at \*2 (M.D. Fla. Sept. 25, 2008) ("Because of Nike's longstanding use and large advertising expenditures in support of its marks, Nike's marks have become famous marks . . ."); *Nike Inc. v. Variety Wholesalers, Inc.*, 274 F. Supp. 2d 1352, 1372 (S.D. Ga. 2003) (holding "the Nike trademarks qualify as famous marks" and "Variety has

Dilution by blurring fits most forms of customization poorly. To succeed on a claim of blurring, a trademark owner must demonstrate there is an “association arising from the similarity between [an accused] mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.”<sup>136</sup> In a blurring case, consumers understand that the defendant isn’t affiliated with the brand owner, but the defendant’s use of the mark for unrelated goods still makes the mark less unique and therefore harder to recognize.<sup>137</sup> This doesn’t describe customizations that keep the functional product intact and just change its appearance. Perhaps a bottle-cap crafter who names her brand “Heineken” or “Heineken Jewelry” would risk blurring Heineken’s mark through her use of bottle caps (and that’s a big “perhaps”),<sup>138</sup> but in the vast majority of customizations, the customizer refers truthfully to the famous brand.<sup>139</sup> The bottle caps are indeed Heineken bottle caps. In those cases, the accused mark and the famous mark aren’t similar; they are the same mark referring to the same trademark owner. Dilution by blurring simply doesn’t apply in this circumstance.

Dilution by tarnishment also proves a poor fit with customization. First, dilution law is notoriously vague about what it means to tarnish a famous mark.<sup>140</sup> But tarnishment clearly does *not* mean what trademark owners often like to think it means—a right to prevent people from criticizing or making fun of the trademark owner.<sup>141</sup> Like dilution by blurring, a famous mark owner must

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diluted the Nike trademarks”); Nike, Inc. v. E. Ports Custom Brokers, Inc., No. 11-cv-04390, 2018 WL 3472628, at \*12 (D.N.J. July 19, 2018) (concluding Nike’s “mark qualifies as famous” for purpose of its dilution claim); Nike, Inc. v. Top Brand Co., No. 00 Civ.8179, 2005 WL 1654859, at \*1, \*9 (S.D.N.Y. July 13, 2005) (granting summary judgment for Nike’s federal dilution claim after “Defendants’ use of [Nike’s] famous marks did lessen the capacity of the marks ‘to identify and distinguish goods’”).

<sup>136</sup> 15 U.S.C. § 1125(c)(2)(B).

<sup>137</sup> See Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 815-16 (1927) (proposing theory of trademark dilution). A number of commentators have cast doubt on the existence of blurring as a factual matter. See, e.g., Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 546 (2008) (“Given the available evidence, the cognitive model of dilution lacks enough empirical support to justify its adoption as a general theory underlying dilution law.”).

<sup>138</sup> And Heineken may not be even famous if brands like Coach aren’t.

<sup>139</sup> See, e.g., Rolex Watch U.S.A., Inc. v. BeckerTime, LLC, No. 20-cv-01060, 2022 WL 286184, at \*2 (N.D. Tex. Jan. 31, 2022) (finding defendant liable when it sold watches marked as “Genuine Rolex” even though its watches contained non-Rolux parts).

<sup>140</sup> See Michael Handler, *What Can Harm the Reputation of a Trademark? A Critical Re-Evaluation of Dilution by Tarnishment*, 106 TRADEMARK REP. 639, 683, 690-91 (2016) (criticizing tarnishment as vague doctrine that is wielded to protect constructed brand identity and enforce moral standards). By contrast, Stacey Dogan and Mark Lemley suggest that tarnishment, properly limited, makes sense as a trademark theory. Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1200 (2006) [hereinafter Dogan & Lemley, *What the Right of Publicity Can Learn*].

<sup>141</sup> Sarah L. Burstein, *Dilution by Tarnishment: The New Cause of Action*, 98 TRADEMARK REP. 1189, 1252 (2008) (“There is no cause of action under the Lanham Act for merely using

demonstrate an “association arising from the similarity between a mark or trade name and a famous mark,”<sup>142</sup> and in the case of tarnishment, that association must “harm[] the reputation of the famous mark.”<sup>143</sup> To tarnish a mark, the defendant must use the same or a similar mark to brand its own goods,<sup>144</sup> and those goods must be either of such low quality or so offensive in character that it will affect how consumers perceive the famous mark even though they understand the two aren’t related.<sup>145</sup> Most aftermarket customizations don’t fit the bill. But following the Supreme Court’s recent decision in *VIP Products*, expressive uses of a famous mark—like parody, critique, or criticism—aren’t excluded from dilution liability when they use that mark “as a mark.”<sup>146</sup>

Satan Shoes may be the closest example of a customization that might tarnish a famous mark.<sup>147</sup> Even then, Satan shoes are pretty clearly not using the Nike mark “as a mark.” In general, customizations that leave logos intact won’t be using the underlying brand’s mark “as a mark”; they are just part of the customizer’s canvas. And, for Satan Shoes in particular, it’s not clear that

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a famous trademark in a distasteful way.”) *But see* N.Y. *Yankees P’ship v. IET Prods. & Servs., Inc.*, 114 U.S.P.Q.2d (BL) 1497, 1512 (T.T.A.B. 2015) (concluding defendant’s parodic “THE HOUSE THAT JUICE BUILT” marks would impair distinctiveness of Yankees’ mark).

<sup>142</sup> 15 U.S.C. § 1125(c)(2)(C).

<sup>143</sup> *Id.*

<sup>144</sup> *Id.* § 1125(c)(1); *see also* Stacey L. Dogan & Mark A. Lemley, *The Trademark Use Requirement in Dilution Cases*, 24 SANTA CLARA COMPUT. & HIGH TECH. L.J. 541, 545 (2012) [hereinafter Dogan & Lemley, *Trademark Dilution*] (arguing dilution law should only be concerned with uses that interfere with *source-identifying* function of a trademark, not just any use of the mark).

<sup>145</sup> Dogan & Lemley, *What the Right of Publicity Can Learn*, *supra* note 140, at 1198. Most tarnishment cases involve associating the plaintiff’s mark with sex—even, ironically, when the plaintiff is itself engaged in sex-adjacent businesses. *See, e.g.*, *Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202 (2d Cir. 1979) (addressing trademark dispute over “distinctive” Dallas Cowboys Cheerleaders uniform after defendant featured a very similar uniform in “a gross and revolting sex film”); *V Secret Catalogue, Inc. v. Moseley*, 558 F. Supp. 2d 734, 736 (W.D. Ky. 2008) (remarking that both plaintiff and defendant sell lingerie); *see also* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25 cmt. c (AM. L. INST. 1995) (stating “illicit drugs or pornography” may tarnish). Examples of tarnishment in the real world that don’t involve sex are harder to come by. The Second Circuit held that “New York Slot Exchange” for a casino club didn’t tarnish “New York Stock Exchange.” *N.Y. Stock Exch., Inc. v. N.Y., N.Y. Hotel, LLC*, 293 F.3d 550, 552, 558 (2d Cir. 2002). Corona beer may now be tarnished by the coronavirus, though of course, they can’t sue the virus. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25 cmt. c (giving “use on insecticide of a trademark similar to one previously used by another on food products” as an example). And the Trademark Trial and Appeal Board has held that “Potify” for marijuana dilutes the famous brand “Spotify.” *Spotify AB v. U.S. Software Inc.*, Nos. 91243297, 91248487, at 21 (T.T.A.B. Jan. 10, 2022).

<sup>146</sup> *Jack Daniel’s Prods., Inc. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1584 (2023).

<sup>147</sup> *See supra* notes 1-2 and accompanying text. One court found tarnishment under the Lanham Act where the defendants advertised and sold safes for the concealment of illegal drugs manufactured using plaintiff PepsiCo’s products and bearing its famous Pepsi, Doritos, and other trademarks. *PepsiCo, Inc. v. # 1 Wholesale, LLC.*, No. 07-CV-367, 2007 WL 2142294, at \*1-2, \*4 (N.D. Ga. July 20, 2007).

associating the Nike mark with Satan is tarnishing in the sense dilution law means the word. People may well be offended by the Satan Shoes, but they're not offended by the Nike Swoosh on the shoes.<sup>148</sup> If they blame Nike it's probably because they are confused, not because they understand that there is no relationship but just can't avoid associating Nike with Satan after seeing the shoes.<sup>149</sup>

*Sponsorship and affiliation confusion.* Finally, even if it is clear that the trademark owner isn't the one making or selling the customized version of the product and even if there is no tarnishment (or no fame), consumers may think that the trademark owner has authorized or approved the customization. Trademark infringement has expanded in recent decades to prohibit not just confusion as to product or source but also confusion as to sponsorship or affiliation.<sup>150</sup> And sponsorship relationships have become more plausible over time as companies across widely different fields have entered into cobranding agreements. If K-pop supergroup BTS can sign a deal to have a McDonald's meal named for it,<sup>151</sup> video games can cross-place characters,<sup>152</sup> a baseball team can sign a deal with a convenience store chain to start all of their games at 7:11 PM,<sup>153</sup> and Ben & Jerry's will team up with Nike to release the Chunky Dunky ice cream-sneaker combo,<sup>154</sup> who's to say that Sony won't team up with McDonald's to release a French fry-themed PS5 controller?<sup>155</sup>

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<sup>148</sup> See *supra* notes 1-2 and accompanying text.

<sup>149</sup> See Lemley & McKenna, *supra* note 115, at 436.

<sup>150</sup> The use must also be "likely to come to the attention of the prior user's prospective purchasers" to undermine the positive associations they have with the mark. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25 cmt. g; see Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1902-04 (2007) (describing this expansion as "tremendously significant change" that granted protection for first time to mark owner's hypothetical future business interests). Lemley and McKenna question whether we should always treat confusion as to affiliation or relationship as problematic, but they note that the law currently does so. Lemley & McKenna, *supra* note 115, at 414-15, 435-37.

<sup>151</sup> See Amelia Lucas, *McDonald's Teams Up with BTS to Spotlight the K-Pop Band's Favorite Order*, CNBC (Apr. 19, 2021, 8:26 PM), <https://www.cnn.com/2021/04/19/mcdonalds-teams-up-with-bts-to-spotlight-the-k-pop-bands-favorite-order.html> [<https://perma.cc/7L2A-HY4F>]. We do not know, but must presume, the meal contains butter.

<sup>152</sup> See Utkarsh Saurbh, *After Fortnite, Horizon Zero Dawn's Aloy to Come to Genshin Impact*, TIMES OF INDIA (July 23, 2021, 4:54 AM), <http://timesofindia.indiatimes.com/articleshow/84674104.cms> [<https://perma.cc/U3CS-EDC6>].

<sup>153</sup> See *White Sox Slurp on Promotion, Will Start Games at 7:11*, ESPN (Oct. 11, 2006), <https://www.espn.com/mlb/news/story?id=2621231> [<https://perma.cc/ZFB9-4RBY>].

<sup>154</sup> See Brendan Dunne, *Nike SB's 'Chunky Dunky' Ben & Jerry's Collab, Explained*, COMPLEX (May 22, 2020), <https://www.complex.com/sneakers/ben-and-jerrys-nike-sb-dunk-low-chunky-dunk> [<https://perma.cc/EQ2E-VKME>].

<sup>155</sup> See *supra* note 7 and accompanying text.

**Figure 29.** Nike and Ben & Jerry's Chunky Dunky Ice Cream-Sneaker Collaboration.<sup>156</sup>



It is cobranding that provides the strongest possible theory for trademark owners to use against aftermarket customizers. If customers are conditioned to expect cobranding relationships, they may look at some aftermarket customizations and assume the trademark owner has agreed to the deal. That is particularly likely when the aftermarket customizer is a large company like McDonald's. Consumers may think it unlikely that McDonald's just decided to buy and paint PS5 controllers without Sony being in on it (but, in fact, it turned out to have done just that). Confusion as to sponsorship may also be stronger when the plaintiff participates in the customization aftermarket through official artist collaborations. If Nike allows certain customizations of its Air Force 1 sneakers<sup>157</sup> or Louis Vuitton partners with artists to generate custom versions of

<sup>156</sup> Photograph of Nike and Ben & Jerry's Sneaker-Ice Cream Collaboration, in *Nike SB Dunk Low Ben & Jerry's Chunky Dunky* (F&F Packaging), NEXT SOLE, <https://www.thenextsole.com/en/p/nike-sb-dunk-low-ben-jerrys-chunky-dunky-cu3244-100> [<https://perma.cc/3B8M-87M9>] (last visited Feb. 10, 2023).

<sup>157</sup> See Brendan Dunne, *Louis Vuitton x Nike Air Force 1s, Virgil Abloh, and the History of Luxury Bootlegs*, COMPLEX (July 1, 2021), <https://www.complex.com/sneakers/louis-vuitton-nike-air-force-1-virgil-abloh-bootleg-history> [<https://perma.cc/3PGW-TMSW>] (describing Nike-sanctioned Louis Vuitton collaboration as originating from unauthorized hybrid); *Nike By You*, NIKE, <https://www.nike.com/nike-by-you> [<https://perma.cc/38J4-LYK8>] (last visited Feb. 10, 2023) (allowing customizers to choose from range of fabrics, colors, and patterns to customize their Nike shoes through Nike's portal). In Nike's case, the

its handbags,<sup>158</sup> buyers may be more likely to assume that any customization of those products is likewise approved.

Trademark law's expansion to all forms of confusion as to sponsorship and affiliation is problematic, and one of us has criticized it elsewhere.<sup>159</sup> But the law seems firmly entrenched at this point,<sup>160</sup> and it provides the strongest basis for an exclusive right to customize.

### C. Customization and Trademark's Limiting Doctrines

But that's not the end of the story. A number of limiting doctrines and defenses may also apply to aftermarket customization and afford protection from trademark law even if courts find confusion as to sponsorship or affiliation.<sup>161</sup> These limiting doctrines fall into two buckets. One set of doctrines limits the scope of trademark law; that is, whether trademark law even applies to a third party's use of a mark.<sup>162</sup> The other set includes affirmative defenses—arguments that even though trademark law may apply, it should not prohibit the third party's use of a mark, despite any risk of confusion as to source or sponsorship.<sup>163</sup>

#### 1. The Trademark Use Requirement

Trademark law is generally concerned with the sale of goods or services featuring trademarks. One must use a trademark on or in connection with goods or services to obtain trademark rights. The law calls this “use as a mark.”<sup>164</sup>

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availability of on-site customization by buyers is likely to undermine the belief that Nike controls or is responsible for any particular sneaker's design.

<sup>158</sup> See Koyaana R., *Louis Vuitton 101: Behind Their Brand & Artist Collaborations*, REBAG: VAULT (July 29, 2020), <https://www.rebag.com/thevault/louis-vuitton-embraces-collaboration/> [<https://perma.cc/LQ9N-4XVG>].

<sup>159</sup> See Lemley & McKenna, *supra* note 115, at 438-42.

<sup>160</sup> See McKenna, *supra* note 150, at 1904-05 (noting courts since twentieth century have “accept[ed] . . . confusion as to sponsorship or affiliation” doctrine).

<sup>161</sup> We use the term “limiting doctrines” because not all of these are defenses in the strict sense. See Stacey L. Dogan & Mark A. Lemley, *A Search-Costs Theory of Limiting Doctrines in Trademark Law*, 97 TRADEMARK REP. 1223, 1224 n.3 (2007) [hereinafter Dogan & Lemley, *Limiting Doctrines*].

<sup>162</sup> See generally Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669 (2007) [hereinafter Dogan & Lemley, *Grounding Trademark Law*].

<sup>163</sup> See *id.* at 1683-84.

<sup>164</sup> 15 U.S.C. §§ 1114(1)(a), 1115(b)(5)(A) (defining trademark infringement of registered marks as “use in commerce” of a mark); see Margreth Barrett, *Internet Trademark Suits and the Demise of “Trademark Use,”* 39 U.C. DAVIS L. REV. 371, 376-87 (2006) (outlining history of trademark use requirement); Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977, 2022 (2019) (describing situations in which trademark status is denied on grounds that mark is merely decorative or fails to function as trademark).

During the 1990s and early 2000s, most circuits similarly recognized a parallel trademark use doctrine as a limit on claims of infringement.<sup>165</sup> The law has not traditionally prohibited private, noncommercial uses of a trademark, such as, for example, references to trademarks in conversation or internal group discussion.<sup>166</sup> For many years we didn't need a doctrine to protect noncommercial use; such practices simply didn't create the limited sort of confusion trademark law viewed as actionable.<sup>167</sup> But as the scope of trademark rights expanded, more and more trademark owners filed suit not against companies branding their own goods or services, but against "uses" of their trademark to locate products on store shelves, to place ads, to take advantage of preexisting confusion, or to talk about the trademark owner itself.<sup>168</sup> The trademark use doctrine arose as a way to hold onto traditional limits on the scope of the law's reach.<sup>169</sup> One of us has argued that the trademark use doctrine serves an important limiting function:

The speech-oriented objectives of the trademark use doctrine protect more than just intermediaries; they prevent trademark holders from asserting a generalized right to control language, an interest that applies equally—and sometimes especially—when the speaker competes directly with the trademark holder. The trademark use doctrine has broad application: because of it, newspapers [aren't] liable for using a trademarked term in a headline, even if the use is confusing or misleading. Writers of movies and books [aren't] liable for using trademarked goods in their stories. Makers of telephone directories aren't liable for putting all the ads for taxi services together on the same page. In-house marketing surveyors [aren't] liable for asking people what they think of a competitor's brand-name product. Magazines [aren't] liable for selling advertisements that relate to the content of their special issues, even when that content involves trademark owners. Gas stations and restaurants [aren't] liable for locating across the street from an established competitor, trading on the attraction the established company has created or benefiting from the size of the sign the established company has put up. Individuals [aren't] liable for use of a trademark in conversation, even in an inaccurate or misleading way (referring to a Puffs brand facial tissue as a "Kleenex," or a competing cola

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<sup>165</sup> See, e.g., *DaimlerChrysler AG v. Bloom*, 315 F.3d 932, 933, 938 (8th Cir. 2003) (holding that a telecommunications company did not use the term "Mercedes" in a trademark sense merely by licensing a vanity phone number that spelled "1-800-MERCEDES" to Mercedes dealers); *Interactive Prods. Corp. v. A2Z Mobile Off. Sols., Inc.*, 326 F.3d 687, 695 (6th Cir. 2003) ("If defendants are only using [plaintiff's] trademark in a 'non-trademark' way—that is, in a way that does not identify the source of a product—then trademark infringement and false designation of origin laws do not apply.").

<sup>166</sup> See Dogan & Lemley, *Grounding Trademark Law*, *supra* note 162, at 1682.

<sup>167</sup> See Dogan & Lemley, *Trademark Dilution*, *supra* note 144, at 545.

<sup>168</sup> See Dogan & Lemley, *Grounding Trademark Law*, *supra* note 162, at 1670-72.

<sup>169</sup> Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 836-37 (2004) [hereinafter Dogan & Lemley, *Trademarks and Consumer Search Costs*].



as a “Coke,” for example). Generic drug manufacturers [aren’t] liable for placing their drugs near their brand-name equivalents on drug store shelves, and the stores [aren’t] liable for accepting the placement. They may be making money from their “uses” of the trademark, and the uses may be ones the trademark owner objects to, but they [aren’t] *trademark* uses and therefore [aren’t] within the ambit of the statute.<sup>170</sup>

There are two types of aftermarket customization that ought to benefit from the trademark use doctrine: personal uses and uses of marks in art. A seventh-grader who elaborately decorates the back of her iPhone does not use the Apple logo or the iPhone trade dress as a mark for the simple reason that she is not branding anything. Those protected marks are simply parts of the canvas for her creative sticker-based expression. Neither do Jimm Lasser or Shantell Martin make trademark uses of the Nike Swoosh and the Converse All Star—even if they sell their works in art markets.<sup>171</sup> Regardless whether their works of art refer to the marks in some way, they do not use the marks affixed to the shoes as marks, but rather the shoes as canvases for their works of art. The brand is used in the work, but it is not used as a trademark.<sup>172</sup>

Unfortunately, influential decisions from the Second and Ninth Circuits rejected the trademark use doctrine, and it had fallen into disuse until 2023.<sup>173</sup> But in 2023, the Supreme Court revived the trademark use doctrine, making clear that the normal likelihood of confusion analysis applies only if the defendant uses the plaintiff’s mark to brand its own goods and services.<sup>174</sup> Noncommercial customizations to a trademarked product—from a middle

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<sup>170</sup> *Id.* at 809-10 (footnotes omitted).

<sup>171</sup> See Photograph of Jimm Lasser’s Obama Force One, *supra* note 27; see also Photograph of Shantell Martin’s Converse All Stars, *supra* note 32.

<sup>172</sup> See Dogan & Lemley, *Trademarks and Consumer Search Costs*, *supra* note 169, at 805-06.

<sup>173</sup> See *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123, 127-28 (2d Cir. 2009) (reversing dismissal of claim by district court because plaintiff adequately pled Google’s use of trademark in search engine could be “use in commerce”); *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1145 (9th Cir. 2011) (applying consumer source confusion test); see also Graeme B. Dinwoodie & Mark D. Janis, *Confusion over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597, 1602 (2007) (rejecting trademark use theory). In the wake of *Rescuecom*, the Second Circuit has held that a defendant need not use content as a mark at all to be liable for trademark infringement. See *Kelly-Brown v. Winfrey*, 717 F.3d 295, 299 (2d Cir. 2013) (holding Oprah Winfrey could be liable for putting phrase “Own Your Power” on cover of her magazine, given that plaintiff registered phrase as trademark for providing motivational services). Notably, these cases contradict prior Second and Ninth Circuit cases adopting the trademark use doctrine. See *1-800 Contacts, Inc. v. WhenU.Com, Inc.*, 414 F.3d 400, 409, 412 (2d Cir. 2005); *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 674 (9th Cir. 2005). So, their status as precedent is suspect; settled law treats earlier cases as binding unless they are overruled en banc. But the Second Circuit signaled in *Rescuecom* that the full court was okay with its reversal, and the trend in these important circuits is to deny that there is any such thing as a trademark use doctrine.

<sup>174</sup> *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1591 (2023).

school doodling to a sneaker sculpture—should easily qualify as non-trademark uses.<sup>175</sup> But how trademark law should treat these non-trademark uses remains surprisingly uncertain. How should courts evaluate a claim that someone who sees a customize-embellished MacBook will likely think that Apple had sponsored or approved it?<sup>176</sup> Most trademark owners probably wouldn't bother suing people who customize the products they own, but stranger things have happened.<sup>177</sup> And, in any event, they might be more likely to sue resale intermediary sites like eBay<sup>178</sup> or sites like Redbubble or Café Press that help produce individual customizations for a fee.<sup>179</sup>

## 2. The First Sale Doctrine and Modified Goods

A second relevant limit on the reach of trademark law is the first sale doctrine. Like other IP rights,<sup>180</sup> trademark law does not restrict what lawful purchasers of a branded good can do with the particular copy they purchased.<sup>181</sup> They are free to use or display it (privately) and to rent or resell it.<sup>182</sup> And when they do, they have the right to use the trademark to accurately communicate that they are selling a genuine product.<sup>183</sup>

The first sale doctrine does not, however, allow a reseller to mislead purchasers by misrepresenting the nature of the goods they are selling.<sup>184</sup> When the product has been changed, therefore, the first sale doctrine is less clear. Courts have held that a reseller can use the original trademark to identify the brand owner's goods even though those goods have been repaired or reconditioned, as long as the reseller clearly discloses that fact.<sup>185</sup> The rationale

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<sup>175</sup> See Dogan & Lemley, *Grounding Trademark Law*, *supra* note 162, at 1672.

<sup>176</sup> *Cf. Network Automation*, 638 F.3d at 1145 (applying consumer source confusion test).

<sup>177</sup> See, e.g., *Suzuki Motor Corp. v. Jiujiang Hison Motor Boat Mfg. Co.*, No. 12-cv-20626, 2012 WL 529967, at \*6-7 (S.D. Fla. Feb. 17, 2012) (granting Suzuki injunction barring motorboat owner from accurately stating that he had put Suzuki snowmobile engine in boat).

<sup>178</sup> See *Tiffany (NJ) Inc. v. eBay Inc.*, 600 F.3d 93, 96 (2d Cir. 2010) (discussing Tiffany suing eBay for hosting auctions of allegedly counterfeit Tiffany jewelry on its site).

<sup>179</sup> See *Atari Interactive, Inc. v. Redbubble, Inc.*, 515 F. Supp. 3d 1089, 1096 (N.D. Cal. 2021) (alleging Redbubble infringed Atari's copyright and trademarks by displaying, printing, and selling products bearing protected images from third-party uploads).

<sup>180</sup> See *Impression Prods., Inc. v. Lexmark Int'l, Inc.*, 137 S. Ct. 1523, 1527 (2017) (holding authorized sales domestically or abroad exhaust all patent rights); *Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519, 525 (2013) (holding first sale doctrine in copyright also applies to copies of works made and sold abroad).

<sup>181</sup> *Champion Spark Plug Co. v. Sanders*, 331 U.S. 125, 130 (1947).

<sup>182</sup> See *Polymer Tech. Corp. v. Mimran*, 975 F.2d 58, 62 (2d Cir. 1992) (“[A] distributor who resells trademarked goods without change is not liable for trademark infringement.”).

<sup>183</sup> *Champion Spark Plug*, 331 U.S. at 130 (holding sale of reconditioned spark plugs under original name was permitted, provided there was full disclosure); see also *NEC Elecs. v. CAL Cir. Abco*, 810 F.2d 1506, 1509 (9th Cir. 1987) (“Trademark law generally does not reach the sale of genuine goods bearing a true mark even though such sale is without the mark owner's consent.”).

<sup>184</sup> See *Champion Spark Plug*, 331 U.S. at 130.

<sup>185</sup> *Id.*

is that consumers understand that used goods may have deteriorated in quality and needed repair.<sup>186</sup> Resellers can also repackage the goods into different containers and still identify the brand owner as the goods' source.<sup>187</sup> They can even reapply a logo where the original has faded or been destroyed as part of the process of fixing up the product for resale.<sup>188</sup> This would extend, for instance, to replacing the logo or hood ornament of a car that had been damaged.<sup>189</sup>

The right to recondition likely also extends to other changes customers would reasonably expect to a product—new tires or batteries in a car, for instance, and some other common forms of customization like replacing the factory-installed stereo in a car with a higher-end one.<sup>190</sup> It also extends to using the purchased product as a component in making a different product.<sup>191</sup> Those changes should be disclosed, but assuming they are, the buyer knows just what they are getting: a product made by the trademark owner and modified in specific ways.<sup>192</sup>

By contrast, if the buyer makes a significant change to the good so that it is no longer the good the customers would expect, they are no longer free to use the trademark to signal the altered product's source.<sup>193</sup> This makes sense. For instance, if a Rolex is modified to the point it appears to be a totally different watch, albeit engraved with the Rolex logo, consumers may be confused about who actually made the watch, to their detriment.<sup>194</sup>

But what is a “material difference” that would deprive buyers of the benefit of the first sale doctrine? Courts answer that question, as they often do in trademark law, by pointing to differences “that consumers consider relevant to

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<sup>186</sup> See *id.* at 129.

<sup>187</sup> *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 369 (1924) (holding branded perfume could be divided, repackaged in metal compact, and sold with description indicating trademarked product was constituent part).

<sup>188</sup> *Nitro Leisure Prods., L.L.C. v. Acushnet Co.*, 341 F.3d 1356, 1366 (Fed. Cir. 2003) (allowing company that found and reconditioned Titleist golf balls to add trademark back to recovered balls).

<sup>189</sup> See *id.*

<sup>190</sup> See *id.*

<sup>191</sup> See *Prestonettes*, 264 U.S. at 368.

<sup>192</sup> See *Bluetooth SIG Inc. v. FCA US LLC*, 30 F.4th 870, 874 (9th Cir. 2022) (holding first sale doctrine protects car manufacturer's use of Bluetooth trademarks in connection with cars that incorporated Bluetooth technology so long as relationship is disclosed accurately and truthfully).

<sup>193</sup> For examples of courts finding material differences, see *Societe des Produits Nestle, S.A. v. Casa Helvetia, Inc.*, 982 F.2d 633, 643 (1st Cir. 1992) (chocolates); *Rolex Watch, U.S.A., Inc. v. Michel Co.*, 179 F.3d 704, 713-14 (9th Cir. 1999) (watches); and *Davidoff & Cie, S.A. v. PLD Int'l Corp.*, 263 F.3d 1297, 1304 (11th Cir. 2001) (perfume bottles). For examples of a court finding no material difference, see *Iberia Foods Corp. v. Romeo*, 150 F.3d 298, 306 (3d Cir. 1998) (holding repackaged household cleaners were “genuine”).

<sup>194</sup> *Rolex*, 179 F.3d at 704.

a decision about whether to purchase a product.”<sup>195</sup> Normally consumers will care about the physical attributes of the product—what it does, how it looks, etc.<sup>196</sup> A car or boat with a different engine, a phone with a different battery, or a bottle of Pepsi made with different ingredients,<sup>197</sup> also aren’t what the consumer expects to receive. As one court put it, the question is “whether the modifications made to the product resulted in a new product.”<sup>198</sup> But some courts have (dubiously) gone further, suggesting that even changes to the packaging of a product or to the paperwork or warranty that accompanies it can be a material difference.<sup>199</sup> Those cases may well be bad law,<sup>200</sup> but they indicate that even a genuine product that works just as well as it always has may be “materially changed” when its appearance or packaging has been altered in ways customers care about.<sup>201</sup>

Much aftermarket customization will not fit within the first sale doctrine as articulated by *Davidoff & Cie, S.A. v. PLD International Corp.*<sup>202</sup> There are, of course, resellers who repair and refurbish cars, watches, and sneakers without otherwise altering the goods’ functional components or appearances. The first sale doctrine should also protect purchasers who incorporate a branded good into their new product as a component part *if* they do not prominently display the component part’s marks.<sup>203</sup> But the broader range of customizers, from those who add diamonds to watch bezels to those who intricately illustrate sneakers, likely make products that are materially different from the original trademark-protected goods.<sup>204</sup> Perhaps the greatest indication consumers consider these

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<sup>195</sup> *Davidoff*, 263 F.3d at 1302; *see also Societe des Produits Nestle*, 982 F.2d at 641 (holding difference consumers would consider relevant creates presumption of consumer confusion).

<sup>196</sup> *See Davidoff*, 263 F.3d at 1302.

<sup>197</sup> *See, e.g., PepsiCo, Inc. v. Reyes*, 70 F. Supp. 2d 1057, 1058 (C.D. Cal. 1999) (finding material differences between PEPSI products sold in U.S. market compared to those produced in Mexico, such that importation from Mexico was trademark violation).

<sup>198</sup> *In re Nitro Leisure Prods., L.L.C.*, No. 02-14008-CIV, 2002 WL 32344948, at \*4 (S.D. Fla. Aug. 8, 2002).

<sup>199</sup> *See Original Appalachian Artworks, Inc. v. Granada Elecs., Inc.*, 816 F.2d 68, 73 (2d Cir. 1987) (holding imported Cabbage Patch dolls were materially different because they had Spanish, not English, “adoption papers,” where provenance of doll was important to purchasers); *Davidoff*, 263 F.3d at 1304 (holding perfume with batch codes etched out was materially different even though actual perfume was the same).

<sup>200</sup> *Davidoff* in particular seems impossible to reconcile with *Prestonettes*: if I can take a perfume out of its original bottle altogether and resell it in smaller ones, surely I can etch out a batch code on the bottom of the original bottle. *Compare Davidoff*, 263 F.3d at 1304, with *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 369 (1924).

<sup>201</sup> *See Davidoff*, 263 F.3d at 1304; *Original Appalachian Artworks*, 816 F.2d at 73.

<sup>202</sup> *See Davidoff*, 263 F.3d at 1303-04.

<sup>203</sup> *See Prestonettes*, 264 U.S. at 268-69 (holding purchaser could use descriptions of components in their repackaging if they did not use trademark in doing so).

<sup>204</sup> *See Cartier v. Aaron Faber, Inc.*, 512 F. Supp. 2d 165, 169 (S.D.N.Y. 2007) (finding watches with modified bezels were “significantly altered,” creating “likelihood that customers would be deceived into believing that the alterations were performed by the original manufacturers”).

customizations relevant to their purchase decision is the premium they pay for these sorts of re-designed goods.<sup>205</sup> Upcycling examples involve even more dramatic changes: the literal making of a new product—such as earrings from bottle caps.<sup>206</sup> Although customizers lawfully acquire the trademark-embazoned good that goes into their own work—whether they purchase it or find it in a recycling bin—the first sale doctrine’s promise that they may use that good as they please likely won’t apply to their particular uses.

#### D. *Expression-Related Defenses*

Over the years, as trademark law has expanded in scope, courts have adopted a set of expression-related defenses in an effort to limit trademark law’s potential encroachment on free speech. Two of these defenses—the *Rogers* test for expressive works and nominative fair use—protect “the public’s interest in free expression” from liability for trademark infringement in different contexts.<sup>207</sup> In this part, we explain the existing status of these defenses and their currently limited or unsettled application to aftermarket customization.

##### 1. The *Rogers* Test

In *Rogers*, the Second Circuit considered a false endorsement claim brought by the American dancer Ginger Rogers against the Italian film director Federico Fellini. Fellini’s film, “Ginger & Fred,” told the story of two fictional retired Italian cabaret performers who impersonated Ginger Rogers and Fred Astaire as part of their cabaret act.<sup>208</sup> Rogers claimed the film’s title created the false impression that Rogers was associated with the film or that the film was about her.<sup>209</sup> Viewed strictly through the lens of consumer confusion, this was a plausible claim.<sup>210</sup> Even if it was unlikely people would think Ginger Rogers made the film, it was entirely plausible people would think it was about her or that, even if it wasn’t, she had consented to let Fellini use her name.<sup>211</sup> And while watching the film might dispel that confusion, courts have permitted trademark infringement claims based on “initial interest” confusion.<sup>212</sup>

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<sup>205</sup> See, e.g., *Wakabayashi*, *supra* note 23.

<sup>206</sup> See Photograph of Recycled Heineken Bottle Cap Earrings, *supra* note 76.

<sup>207</sup> See *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1242 (9th Cir. 2013) (quoting *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 900 (9th Cir. 2002)) (applying *Rogers* test).

<sup>208</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 996-97 (2d Cir. 1989).

<sup>209</sup> *Id.* at 997.

<sup>210</sup> See *id.* at 998.

<sup>211</sup> *Id.* at 999-1000.

<sup>212</sup> See, e.g., *Mobil Oil Corp. v. Pegasus Petrol. Corp.*, 818 F.2d 254, 260 (2d Cir. 1987) (holding “potential purchasers would be misled into initial interest in Pegasus Petroleum” due to assumed association with Mobil Oil); *Brookfield Commc’ns, Inc. v. W. Coast Ent. Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999) (holding that using competing movie database’s trademark in metatags to divert searchers to defendant’s website would cause initial interest confusion and permit defendant to improperly benefit).

Nonetheless, the court held that Rogers could not prevail as a matter of law whether or not consumers were confused.<sup>213</sup> The court reasoned that when it comes to expressive works such as films, “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.”<sup>214</sup> To achieve this balance, the Court created what’s now known as the *Rogers* test. It held that the use of a mark in the title of an expressive work will be protected by the First Amendment “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.”<sup>215</sup> Since then, the *Rogers* test has been adopted by a plurality of circuit courts<sup>216</sup> and extended to protect uses of trademarks *within* expressive works as well as in their titles.<sup>217</sup>

Although we refer to the *Rogers* test as an affirmative defense, procedurally it blurs the line between a defense and a scope limitation.<sup>218</sup> Later cases applying the *Rogers* test have explained that the test requires the defendant to show, as a threshold matter, that their work is expressive; then, the burden passes to the plaintiff to prove one of the two elements of the test—that either the plaintiff’s mark “is either not artistically relevant to the underlying work” or the defendant “explicitly mislead[s] as to the source or the content of the work.”<sup>219</sup> If the plaintiff can do neither, the defendant’s use is noninfringing. Confusion doesn’t matter.

Recently, the Supreme Court limited the application of the *Rogers* test. In *VIP Products*, the whiskey maker sued a dog toy company for its “Bad Spaniels” chew toy that parodied Jack Daniel’s bottles.<sup>220</sup> The Court held that when a third party uses a protected mark “as a mark” the *Rogers* test does not apply—even if

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<sup>213</sup> *Rogers*, 875 F.2d at 1000.

<sup>214</sup> *Id.* at 999.

<sup>215</sup> *Id.* *Rogers* was concerned with the use of a name rather than a mark, but later cases have applied *Rogers*’s precedent to trademarks as well. See *infra* notes 219-26 and accompanying text.

<sup>216</sup> See *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664-65 (5th Cir. 2000); *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 937 (6th Cir. 2003); *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 902 (9th Cir. 2002); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1277-78 (11th Cir. 2012). *But see* *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008).

<sup>217</sup> *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (“Although this test traditionally applies to uses of a trademark in the title of an artistic work, there is no principled reason why it ought not also apply to the use of a trademark in the body of the work.”). The Second, Sixth, and Eleventh Circuits have all reached the same conclusion. See *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989); *ETW Corp.*, 332 F.3d at 928 n.11, 937; *Univ. of Ala. Bd. of Trs.*, 683 F.3d at 1277.

<sup>218</sup> See *Arnold v. Treadwell*, 642 F. Supp. 2d 723, 729 (E.D. Mich. 2009). Strictly speaking the *Rogers* test replaces the test for confusion. If *Rogers* is met, confusion is irrelevant. See *Rebellion Devs. Ltd. v. Stardock Ent., Inc.*, No. 12-12805, 2013 WL 1944888, at \*4 (E.D. Mich. May 9, 2013).

<sup>219</sup> *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264-65 (9th Cir. 2018).

<sup>220</sup> *Jack Daniel’s Prods., Inc. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1579 (2023).

their use has “other expressive content.”<sup>221</sup> VIP Products LLC conceded it used “Bad Spaniels” as a mark for that particular toy, and the Court seemed fixed on the toy maker’s use of the phrase “Bad Spaniels” on the toy’s hang tag.<sup>222</sup> How *Rogers* applies to expressive works that contain others’ trademarks, or adaptations of them, was left undisturbed. For instance, the Court did not opine on whether *Rogers* would no longer protect VIP Products LLC’s use of the phrase “Bad Spaniels” on the toy itself had it not been used as a brand.

As it stands, *VIP Products* shouldn’t prevent the application of *Rogers* to aftermarket customization. In most (but not all) of the cases we discuss, the mark appears as part of the canvas on which the customizer is working; the customizer doesn’t add it as a mark for their own goods.

*Expressive work.* For customization to even qualify for the *Rogers* test, it must be considered an “expressive work.” Courts have been clear that “movies, plays, books, and songs” qualify as expressive works even though they are “sold in the commercial marketplace.”<sup>223</sup> Courts have also added video games,<sup>224</sup> paintings, prints, calendars, music,<sup>225</sup> pictures, drawings, engravings, sculptures,<sup>226</sup> greeting cards,<sup>227</sup> and even dog toys to this list.<sup>228</sup> What matters is that the works “communicate ideas—and even social messages—through many familiar [creative] devices . . . and through features distinctive to the[ir] medium” like other expressive media.<sup>229</sup> At a minimum, to qualify as an expressive work, the

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<sup>221</sup> *Id.* at 1589-90.

<sup>222</sup> *Id.* at 1591.

<sup>223</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 997 (2d Cir. 1989). A work “is not rendered non-expressive simply because it is sold commercially.” *VIP Prods. LLC v. Jack Daniel’s Props., Inc.*, 953 F.3d 1170, 1175 (9th Cir. 2020); see *MCA Recs.*, 296 F.3d at 906-07 (determining Barbie Girl song was not purely commercial speech and was intertwined with expressive elements, and thus qualified as protected speech).

<sup>224</sup> See *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241 (9th Cir. 2013) (holding video games have same constitutional protection as expressive works).

<sup>225</sup> *Univ. of Ala. Bd. of Trs.*, 683 F.3d at 1276 (“Like other expressive speech . . . paintings, prints, and calendars are entitled to full protection under the First Amendment.”).

<sup>226</sup> See *Volkswagen AG v. Dorling Kindersley Publ’g, Inc.*, 614 F. Supp. 2d 793, 809 (E.D. Mich. 2009) (citing prior precedent holding “paintings, drawings, engravings, prints, and sculptures” are protected by First Amendment).

<sup>227</sup> *VIP Prods.*, 953 F.3d at 1175 (“Even if the cards did not show great ‘creative artistry,’ they were protected under the First Amendment because the cards ‘convey[ed] a humorous message through the juxtaposition of an event of some significance—a birthday, Halloween, an election—with the honey badger’s aggressive assertion of apathy.’” (quoting *Gordon*, 909 F.3d at 268-69)).

<sup>228</sup> The Supreme Court in *VIP Products* did not reject that dog toys might be expressive works; rather, its reasoning indicated they could serve an expressive function. *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1589 (2023).

<sup>229</sup> *Brown*, 724 F.3d at 1241; see *Gordon*, 909 F.3d at 268 (“[A greeting] card certainly evinces ‘[a]n intent to convey a particularized message . . . , and in the surrounding circumstances the likelihood was great that the message would be understood by those who viewed it.’”) (alterations in original) (quoting *Hilton v. Hallmark Cards*, 599 F.3d 894, 904



work must “do more than ‘propose a commercial transaction.’”<sup>230</sup> “[I]t ‘is . . . no matter that the dissemination [of speech] takes place under commercial auspices.’”<sup>231</sup> However capacious the standard to qualify as an “expressive work,” courts have expressed some trepidation about whether it ought to cover “ordinary commercial product[s],” such as T-shirts.<sup>232</sup>

As it stands, it is unclear whether all aftermarket customization of consumer goods qualifies as expressive works. Customization encompasses a wide range of practices. Some hew more closely to established “expressive works,” such as paintings, prints, and drawings. For those, the fact that the artist uses a commercial product as a canvas arguably should not matter. Even art produced to make money still counts as art, not commercial speech.<sup>233</sup> Other forms of customization, such as upcycling, might not communicate any particularized message. Moreover, even though the *Rogers* test might apply to the use of marks *within* a custom painting, illustration, or graphic print, courts have not yet confronted whether *Rogers* should apply to expressive customizations *on* trademark-emblazoned consumer goods. We think that expression should be protected, but courts have not directly had to deal with *Rogers* in the context of aftermarket customization.

*Artistic relevance.* The *Rogers* test protects only creative uses of trademarks that are “artistically relevant” to the expressive work. Much like the threshold requirement that a work is expressive, the first prong of the *Rogers* test is capacious. Courts typically hold that an expressive use satisfies this standard if the mark’s “artistic relevance” is “above zero.”<sup>234</sup> Parties have tried to argue, unsuccessfully, that for a mark to be “artistically relevant,” the expressive work

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(9th Cir. 2010)); *see also* *Bery v. City of New York*, 97 F.3d 689, 695 (2d Cir. 1996) (“Visual art is as wide ranging in its depiction of ideas, concepts and emotions as any book, treatise, pamphlet or other writing, and is similarly entitled to full First Amendment protection.”).

<sup>230</sup> *Univ. of Ala. Bd. of Trs.*, 683 F.3d at 1276 (quoting *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 562 (1980)).

<sup>231</sup> *Id.* (third alteration in original) (quoting *Smith v. California*, 361 U.S. 147, 150 (1959)); *see* *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003) (stating exercises of speech may be protected by First Amendment despite being “carried” in profit-seeking medium); *Volkswagen*, 614 F. Supp. 2d at 809 (noting even purely commercial speech would be entitled to First Amendment protections under certain circumstances).

<sup>232</sup> *A.V.E.L.A., Inc. v. Est. of Marilyn Monroe, LLC*, 364 F. Supp. 3d 291, 322 (S.D.N.Y. 2019). What drove the court’s decision not to apply the *Rogers* test to T-shirts bearing Marilyn Monroe’s persona was the estate’s argument that the defendant tricked licensees into thinking its products were officially endorsed by the estate. *Id.*

<sup>233</sup> *See* *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 906 (9th Cir. 2002) (holding trademark law may only restrict “purely commercial” speech, meaning, speech that only proposes a commercial transaction, and may not restrict other forms of expression that may be partially, but not entirely, commercial).

<sup>234</sup> *Dillinger, LLC v. Elec. Arts Inc.*, No. 09-cv-1236, 2011 WL 2457678, at \*5 (S.D. Ind. June 16, 2011); *see* *Brown*, 724 F.3d at 1245 (highlighting emphasis *Rogers* test puts on even most minute artistic expression); *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) (“[O]nly the use of a trademark with ‘no artistic relevance to the underlying work *whatsoever*’ does not merit First Amendment protection.” (quoting *MCA Recs.*, 296 F.3d at 902)).

must be “about” the mark in some way; ostensibly, by commenting on, criticizing, or lampooning the mark or its covered goods and services.<sup>235</sup> However, courts have found marks to be “artistically relevant” to an expressive work when they serve the work’s artistic purpose, construed broadly.<sup>236</sup>

Expressive works that use trademarks for their expressive meaning satisfy this prong. Courts have acknowledged that some trademarks, for example, Rolls-Royce, Band-Aid, and Barbie, “transcend their identifying purpose” and “enter public discourse and become an integral part of our vocabulary.”<sup>237</sup> The expressive use of culturally significant marks requires First Amendment protection to prevent “trademark owner[s] [from] assert[ing] a right to control how we express ourselves.”<sup>238</sup> In the context of sneaker customization, Nike and its Swoosh likely qualify as marks that carry an expressive meaning within sneaker culture. Customizations that use these marks for the cultural meaning they carry ought to satisfy the artistic relevance requirement, so long as there is a cultural and not merely a commercial message.

More broadly, trademarks need not take on cultural significance to be “artistically relevant” to an expressive work. What’s more important is that the mark serves the expressive work’s creative purpose, whatever it may be. For instance, in *ESS Entertainment*, the owners of a Los Angeles strip club called the “Play Pen” sued the makers of Grand Theft Auto for trademark infringement because they included a cartoon-style strip club called the “Pig Pen” in the game.<sup>239</sup> The Pig Pen was a minor component of the game (and the Play Pen a minor establishment in Los Angeles); it was meant to set the stage for the game’s fictional city of “Los Santos,” which “lampooned the seedy underbelly of Los Angeles and the people, business and places [that] comprise it.”<sup>240</sup> The Ninth Circuit held that the video game’s use was artistically relevant to its purpose of

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<sup>235</sup> Parodic works routinely satisfy the artistic relevance prong. The point is that parody and other referential uses aren’t *required* for it to be satisfied. See *Dillinger*, 2011 WL 2457678, at \*5; *Rebellion Devs. Ltd. v. Stardock Ent., Inc.*, No. 12-12805, 2013 WL 1944888, at \*3 (E.D. Mich. May 9, 2013). But see *Parks v. LaFace Recs.*, 329 F.3d 437, 453-54 (6th Cir. 2003) (holding Outkast’s use of Rosa Parks’s name as title of their song with hook “move to the back of the bus” was not artistically relevant because song did not refer to Parks’s “courage, . . . sacrifice, . . . the civil rights movement or . . . any other quality with which Rosa Parks is identified”). And for songs that make no reference at all to their title, like Gorillaz’s “Clint Eastwood,” there may actually be zero artistic relevance. *GORILLAZ, Clint Eastwood*, on *GORILLAZ* (Parlophone 2001).

<sup>236</sup> See *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 462 (9th Cir. 2020) (holding even slightest relevance to achieving artistic purpose satisfies requirement of artistic relevance).

<sup>237</sup> *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003); see *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1197-98 (9th Cir. 2017) (describing transcendent quality of certain trademarks and its relevance to *Rogers* test).

<sup>238</sup> *Twentieth Century Fox Television*, 875 F.3d at 1197-98 (quoting *MCA Recs.*, 296 F.3d at 900).

<sup>239</sup> *E.S.S. Ent. 2000*, 547 F.3d at 1097.

<sup>240</sup> *Id.* (alteration in original).

creating the fictional city, even though the game as a whole was not *about* the Play Pen in any way.<sup>241</sup> In a similar case, the Second Circuit held that Twentieth Century Fox’s use of the trademark-protected word “Empire” as the title and a major, recurring component of a television show about a New York-based record label qualified as artistically relevant because the mark “support[ed] the themes and geographic setting of the work.”<sup>242</sup> What’s common to these expressive works is they are creative expressions and they involve substantially more artistic elements than the bare use of a third party’s trademark.

By contrast, works that are “disguised commercial advertisement[s]”<sup>243</sup> or expressive works that “consist of the mark and not much else”<sup>244</sup> would not satisfy the *Rogers* test’s first prong. The McDonald’s PS5 controller, which turns Sony’s product into a device for McDonald’s advertising, should not satisfy the artistic relevance standard but many artistic customizations of sneakers might. Even if the sneaker customizers do not use the sneaker’s mark for its cultural meaning, what’s more important is the sneaker’s mark supports the customization’s themes or artistic purpose. Thus, when Warren Lotas tweaks the Nike logo on a pair of Pigeon dunks to turn it into the Friday the 13th horror movie mask, the transformation to the logo is minimal, but it’s still artistic.

*Explicitly misleading.* The second prong of the *Rogers* test asks whether the defendant “explicitly misleads” as to the source or content of the work.<sup>245</sup> The bar for representations or implications to be explicitly misleading is much higher

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<sup>241</sup> *Id.* at 1100 (“[T]o include a strip club that is similar in look and feel to the Play Pen does indeed have at least ‘some artistic relevance.’”). The reference to “Pig Pen” was, however, clearly a commentary on the term “Play Pen” used in the context of strip clubs appealing to male chauvinist pigs. Other video game cases have reached similar conclusions. *See, e.g.,* Dillinger, LLC v. Elec. Arts Inc., No. 09-cv-1236, 2011 WL 2457678, at \*5 (S.D. Ind. June 16, 2011) (holding use of *The Godfather* video game’s “Dillinger” Tommy Guns was “artistically relevant” to game’s fictional gangster world because “mental imagery” associated with Dillinger has more than zero relevance); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1243 (9th Cir. 2013) (holding use of football player’s likeness was relevant to realism of Madden NFL game even though game includes likenesses of thousands of different current and former NFL players); *Rebellion Devs. Ltd. v. Stardock Ent., Inc.*, No. 12-12805, 2013 WL 1944888, at \*5 (E.D. Mich. May 9, 2013) (holding use of trademark-protected word “rebellion” in its title was relevant to game because, within game, players may choose to align with “loyalist” or “rebel” factions in civil war); *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*, 74 F. Supp. 3d 1134, 1142 (N.D. Cal. 2014) (holding trademark-protected “angry monkey” patches used in video game were relevant because they “represent[] part of an authentic universe of morale patches” used by military personnel).

<sup>242</sup> *Twentieth Century Fox Television*, 875 F.3d at 1199 (noting New York’s nickname, “The Empire State”); *see Punchbowl, Inc. v. AJ Press LLC*, 549 F. Supp. 3d 1061, 1066 (C.D. Cal. 2021), *aff’d*, 52 F.4th 1091 (9th Cir. 2022).

<sup>243</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989).

<sup>244</sup> *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 461 (9th Cir. 2020) (citing *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 261, 268-69 (9th Cir. 2018)). This is sometimes wrapped into the “explicitly misleading” prong. *See Punchbowl*, 549 F. Supp. 3d at 1067. We would not rely on *Gordon*’s version of the “explicitly misleading” prong, which confusingly requires use of the mark to be “transformative” for it not to explicitly mislead.

<sup>245</sup> *Rogers*, 875 F.2d at 999.

than a normal likelihood of confusion analysis.<sup>246</sup> That is to say, trademark law must tolerate expressive uses of marks that only “implicitly suggest endorsement or sponsorship.”<sup>247</sup> Courts have interpreted this standard to require the defendant to “make some affirmative statement of the plaintiff’s sponsorship or endorsement, beyond the mere use of the plaintiff’s [mark]” within the expressive work.<sup>248</sup> For aftermarket customization, this would mean customizations of branded consumer goods are allowed, as long as they do not “explicitly mislead” purchasers into thinking the sneaker’s maker is responsible for the customization as well unless the customizer makes other, explicit indications or claims to that effect.<sup>249</sup>

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Customizers are on uncertain ground as to whether the *Rogers* test will save—or even apply to—their work. As a threshold matter, *Rogers* may only apply to customizations that are “expressive”; that eliminates from its coverage some customizations that carry no “particularized message” (such as alterations to watches and upcycled beer bottles). And even for those customizations that are expressive, it’s not completely clear *Rogers* applies to expressive works *on* branded goods, rather than just expressive works that recreate trademarks.

Assuming *Rogers* applies to this new form of expression, it is likely many of the branded goods’ marks will have “above zero” artistic relevance to the customization. For instance, customizers might deliberately use Nike shoes—marks and all—for their cultural meaning within street culture or pop culture. Whether a customization explicitly misleads consumers as to source will depend on other representations the customizer made about their relationship with the underlying product’s brand. In cases where the customizer makes no other representations—aside from truthfully referring to their canvas as a “Nike Air

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<sup>246</sup> *Id.* at 1069-70. *But see* AM Gen. LLC v. Activision Blizzard, Inc., 450 F. Supp. 3d 467, 480-84 (S.D.N.Y. 2020).

<sup>247</sup> *Rogers*, 875 F.2d at 1000; *see also* ETW Corp. v. Jireh Publ’g, Inc., 332 F.3d 915, 937 (6th Cir. 2003) (holding third party’s portraits of Tiger Woods and use of Woods’s name on them contain no explicit misstatement as to source and so aren’t explicitly misleading, despite survey evidence suggesting actual confusion).

<sup>248</sup> *Dillinger*, 2011 WL 2457678, at \*6; *see Punchbowl*, 549 F. Supp. 3d at 1067 (“The second prong of the *Rogers* test is a ‘high bar that requires the use to be an explicit indication, overt claim, or explicit misstatement about the source of the work.’” (quoting *Dr. Seuss Enters.*, 983 F.3d at 462)); *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (noting challenged song does not explicitly mislead listeners to believe it was produced by Mattel); *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) (noting nothing indicates consumers would reasonably believe that challenging party produced challenged content).

<sup>249</sup> *But see Gordon*, 909 F.3d at 261, 268 (finding triable issue of fact whether selling of greeting cards that had little content beyond plaintiff’s trademarked phrase could itself be evidence of “explicit misleading”). *Gordon* casts some doubt on whether the Ninth Circuit really intends to apply the test it has set out.

Force 1”—and retains the mark on the original good, the law suggests that they do not explicitly mislead consumers.

## 2. Nominative Use

The nominative use defense<sup>250</sup> protects another type of expressive use of trademarks: when a mark is “the only word reasonably available to describe a particular thing.”<sup>251</sup> The nominative use defense protects third parties who use another’s protected mark to refer truthfully to the mark’s associated goods or services.<sup>252</sup> The Ninth Circuit created the nominative use defense in the context of a trademark infringement claim by the boyband The New Kids on the Block against newspapers running polls about the band’s popularity. Nominative use is not considered infringement because “it does not implicate the source-identification function that is the purpose of trademark.”<sup>253</sup> On the contrary, using a trademark to talk about the trademarked product itself reinforces rather than undermines the connection between the mark and the goods it represents.

The precise test for nominative use differs by circuit. In the Ninth Circuit, a nominative use is fair if:

First, the product or service in question [is] one not readily identifiable without use of the trademark; second, only so much of the mark or marks [is] used as is reasonably necessary to identify the product or service; and third, the user [] do[es] nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.<sup>254</sup>

Outside of this analysis, “the fact that [the use in question] is carried on for profit and in competition with the trademark holder’s business is beside the point.”<sup>255</sup> The Third Circuit, by contrast, adopts the first two factors, but asks a different question for the third factor: does the defendant’s conduct “reflect the true and accurate relationship” between the parties?<sup>256</sup> And the Second Circuit

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<sup>250</sup> Like the *Rogers* test, nominative use toes the line between affirmative defense and scope-limiting doctrine. See *Am. Soc’y for Testing & Materials v. Public.Resource.Org, Inc.*, 896 F.3d 437, 457 (D.C. Cir. 2018) (describing how defense is applied across circuits). Procedurally, in the Second and Ninth Circuits, the defendant must show it used the mark to refer to the trademark-protected good, then the burden shifts to plaintiffs to controvert the test’s factors (and, in so doing, show a likelihood of confusion). See *Int’l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC*, 823 F.3d 153, 166-67 (2d Cir. 2016); *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1182-83 (9th Cir. 2010). By contrast, the Third Circuit treats it as a true defense considered only after the plaintiff makes a showing of likelihood of confusion. See *Century 21 Real Est. Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 232 (3d Cir. 2005).

<sup>251</sup> *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

<sup>252</sup> See *id.*

<sup>253</sup> *Id.*

<sup>254</sup> *Id.* (footnote omitted).

<sup>255</sup> *Id.* at 309.

<sup>256</sup> *Century 21 Real Est. Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 232 (3d Cir. 2005). In addition, as previously noted, the Third Circuit considers the doctrine a defense, not a replacement for the likelihood of confusion test.

considers all the likelihood of confusion factors, *plus* the three Ninth Circuit factors, *plus* the Third Circuit’s somewhat different third factor.<sup>257</sup>

Since its creation, the nominative use doctrine has expanded to apply to trade dress too. For example, in *Mattel, Inc. v. Walking Mountain Productions*,<sup>258</sup> the court held an artist’s use of Barbie dolls in his photographs—wrapped in an enchilada, in a blender, and in other compromising positions—qualified as a nominative fair use.<sup>259</sup> The court also clarified that “a defendant’s use is *nominative* where he or she used the plaintiff’s [trade] dress to describe or identify the plaintiff’s product, even if the defendant’s ultimate goal is to describe or identify his or her own product.”<sup>260</sup> In the artist’s case, his use of the Barbie doll satisfied the three elements of nominative use—it was reasonably necessary to conjure up the Barbie product in the medium of photography, he only used as much as necessary (which, in this case, was the entire nude doll), and he did nothing that suggested Mattel’s sponsorship or endorsement.<sup>261</sup>

The nominative use doctrine has also been applied to cases involving the resale of, or services relating to, trademark-protected goods. For instance, in *Toyota Motor Sales, U.S.A., Inc. v. Tabari*,<sup>262</sup> the court held that auto brokers who specialized in brokering Lexus vehicles made nominative use of the Lexus mark in their domain names “buyorleaselexus.com” and “buy-a-lexus.com.”<sup>263</sup> The court held trademark owners must tolerate “momentary uncertainty” as to source when consumers encounter such a domain name because merchants are entitled to accurately communicate the nature of their service or product.<sup>264</sup>

Nominative use also applies to cases where a third party uses a trademark-protected good as a “component part” of a new product. For example, a car company may display the Bluetooth name and logo inside a vehicle—and associated marketing materials—that incorporates genuine Bluetooth

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<sup>257</sup> See *Int’l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC*, 823 F.3d 153, 168 (2d Cir. 2016).

<sup>258</sup> 353 F.3d 792 (9th Cir. 2003).

<sup>259</sup> *Id.* at 810 (“Forsythe’s use of the Barbie trade dress is nominative.”).

<sup>260</sup> *Id.* at 809-10.

<sup>261</sup> *Id.* at 810-11 (“Where use of the trade dress or mark is grounded in the defendant’s desire to refer to the plaintiff’s product as a point of reference for defendant’s own work, a use is nominative.”).

<sup>262</sup> 610 F.3d 1171 (9th Cir. 2010).

<sup>263</sup> *Id.* at 1175.

<sup>264</sup> *Id.* at 1179-80.

technology.<sup>265</sup> Similarly, in *Prestonettes, Inc. v. Coty*,<sup>266</sup> a case that predates the doctrine, the court held a cosmetics manufacturer that purchased loose Coty face powder, mixed it with a binder, and repackaged it in compacts as pressed powder could accurately state the compact was made with Coty's loose powder.<sup>267</sup>

By contrast, nominative use does not protect goods that copy others' trademarks to refer to their own product rather than the mark owner's product. In *Board of Supervisors for Louisiana State University Agricultural and Mechanical College v. Smack Apparel Co.*,<sup>268</sup> the Fifth Circuit held a T-shirt company did not engage in a nominative use when it made its own T-shirts to appeal to university sports fans because those shirts were sold in the team colors.<sup>269</sup> The court (dubiously) held that the merchandise would confuse consumers because of the use of the universities' colors, even though neither the name, font, nor logo appeared on the shirts.<sup>270</sup> It went on to find no nominative use because it found confusion as to sponsorship or affiliation (another dubious legal conclusion).<sup>271</sup> But in doing so, it did not require, as other circuits have, that the defendant deliberately act to suggest sponsorship by doing something other than using the referential mark.

Generally, when a third party resells, services, or incorporates a trademark-protected good into its own product, the crux of nominative use is accuracy: does the third party accurately represent its use of or connection to the branded good? On that front, courts have held that disclaimers as to affiliation are helpful, but they are by no means required.<sup>272</sup> And the Ninth Circuit has gone further, holding

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<sup>265</sup> Figure 30. Bluetooth Trademark.



Illustration of U.S. Trademark Registration No. 2,911,905, in *Bluetooth SIG, Inc. v. FCA US LLC*, 463 F. Supp. 3d 1169, 1178 (W.D. Wash. 2020), *vacated*, 30 F.4th 870 (9th Cir. 2022).

<sup>266</sup> 264 U.S. 359 (1924).

<sup>267</sup> *Id.* at 368-69. The Court did not speak in terms of nominative use, a concept that did not exist at the time, but the concept it applied fits within the nominative use framework.

<sup>268</sup> 550 F.3d 465 (5th Cir. 2008).

<sup>269</sup> *Id.* at 489.

<sup>270</sup> *Id.*

<sup>271</sup> *Id.*

<sup>272</sup> See *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 809, 811 (9th Cir. 2003); see also *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1182 (9th Cir. 2010); *Am. Soc'y for Testing & Materials v. Public.Resource.Org, Inc.*, 896 F.3d 437, 457 (D.C. Cir. 2018).



that even if the defendant took too much or misled consumers, the solution was to narrow the defendant's use, not prevent it altogether.<sup>273</sup>

Nominative use could help defend aftermarket customizers from trademark infringement claims. The trademark on a branded good signals the connection between that good and its maker—a Swoosh reveals Nike as the sneaker's manufacturer, a bitten apple suggests Apple as the phone's maker, etc. When customizers retain these marks—which, in many cases, are indelible—the marks continue to serve their nominative function, referring to the underlying product that is the customizer's canvas.

However, it's not clear that nominative use will save all customizers from claims they confuse the public as to the source of their customizations. Even if customizers use the marks nominatively, that won't stop mark owners like Nike from claiming the mark *also* misleadingly signals Nike as the customization's source.<sup>274</sup> The test for confusion in the nominative use doctrine requires more active efforts to confuse than trademark law otherwise would. Like the *Rogers* test, at least outside the Fifth Circuit, there must be an explicit suggestion of sponsorship that is more than just the nominative use of the mark itself. But the difference in the circuits, coupled with uncertainty as to how much more is required, makes it hard to rely on the doctrine to protect all customizations.

On the other hand, nominative use as it stands might afford *too much* protection to large corporate enterprises engaging in unlicensed merchandising.<sup>275</sup> McDonald's PS5 controller could arguably constitute a nominative use—the controller's trade dress continues to refer to Sony, despite its embellishment with McDonald's imagery—even though it presents a more serious likelihood of confusion as to sponsorship or affiliation. So it was with the Red Bull Mini Coopers.<sup>276</sup> In the next Part, we discuss how to separate cases that seem like efforts to confuse as to sponsorship from those that deserve protection.

### III. PROTECTING CULTURAL CANVASES

Trademark law—as it might apply to aftermarket customization—is in disarray. The problem isn't that we have no doctrines to treat the issue; it's that we have too many. The assortment of liability, scope, and defensive doctrines that might apply fail to provide a clear direction—let alone any conclusions—as

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<sup>273</sup> See *Tabari*, 610 F.3d at 1176-77, 1185 (holding that even if defendant had infringed, solution in nominative use cases was to allow use of Lexus mark in domain names by Tabari subject to disclaimer); *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 800 (9th Cir. 2002) (allowing some, but not all, uses of Playboy's trademark on defendant's website).

<sup>274</sup> See also *Int'l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC*, 823 F.3d 153, 168-69 (2d Cir. 2016).

<sup>275</sup> See Plunkett, *supra* note 6 (discussing McDonald's customization of Sony PlayStation controller).

<sup>276</sup> See Appel, *supra* note 54 (discussing Mini Coopers decked out in Red Bull branding).

to how trademark law should treat aftermarket customization of consumer goods.

Charting a clearer path doesn't necessarily mean we need a new doctrine. Rather, it means understanding that there are different types of customization and different types of customizers, and the law may respond differently to each. Trademark owners argue that customizers are engaging in trademark infringement, full stop. But the law doesn't support that conclusion. Moreover, such an extension of trademark threatens to shut down a range of activities that include free expression cherished in our democratic culture. At the same time, some customization may in fact affect how consumers perceive the source or the connections between brands in ways trademark law reasonably worries about. So we can't just say all customizations are protected from trademark suits.

The sheer range of customizations we laid out in Part I undercuts such a heavy-handed approach. Why should the sixth grader who resells her sticker-decorated iPhone be treated as a trademark infringer on par with Louis Vuitton distributing iPhones decorated with the Louis Vuitton monogram as part of a promotional campaign? What about an artist who purchases iPhones and draws meticulous illustrations on the back based on customers' requests and interests? Common sense suggests the different trademark and free expression interests at stake in each of these cases warrant a fine-tuned approach to deciding claims of trademark infringement.

In this Part, we present our suggestions for how trademark law should evaluate trademark infringement claims against customizers engaged in a diverse range of activities. To provide a sufficiently nuanced approach, we offer not a test but a schematic: a set of questions courts can ask to ascertain whether a customization is beyond the scope of trademark law, properly subject to an expression-related affirmative defense, or properly channeled to a likelihood-of-confusion analysis. We also propose a set of interpretations of the trademark use doctrine, the *Rogers* test, the nominative use doctrine, and the first sale doctrine to clarify how they should apply to aftermarket customization.

Our framework starts by dividing aftermarket customization into three basic categories: noncommercial or non-trademark uses that are outside the scope of trademark law altogether, commercial uses that serve to brand goods but are also expressive, and uses that incorporate a branded good as a component of a larger work but nonetheless display the brand of the original good. The proper analysis is different for each. We detail our approach below and we also summarize it in a chart we present at the end of the paper.

#### A. *Noncommercial Customization*

First, trademark law should only apply to commercial forms of customization—that is, customization *as a person's business* or customization *by a business* for its commercial purposes. Two forms of customization—modifications made for personal use (even if the item is later resold) and works of art that incorporate trademark-emblazoned goods—ought to fall outside the scope of trademark law altogether because they are noncommercial.

If a customization is either (1) a personal use later resold or (2) unquestionably art, it should be considered “noncommercial” and outside the

scope of trademark law. If a customization is part of the defendant's business, by contrast, it should be considered "commercial," and courts should then ask whether the customization is an expressive work.

Trademarks are protected because, in principle, they serve two functions: they lower consumers' search costs when making purchasing decisions and they protect producers' goodwill from appropriation by other producers. Noncommercial customization doesn't interfere with either purpose. An individual who covers their MacBook in stickers does not materially affect consumers' search costs even if they later resell it on eBay. Consumers will presume the reseller put the stickers on their own computer. While the law has periodically (and controversially) worried about post-sale confusion by third parties who see the customized computer, no case extends the idea of post-sale confusion to private customization of one's own used product.<sup>277</sup> And no one is likely to think that a stickered phone or laptop is necessarily endorsed or affiliated with Apple.<sup>278</sup>

That shouldn't change if the customizer resells their customized, used product on eBay. The average consumer purchasing a used product should know they are looking at a used MacBook—more to the point, they likely *intend* to look at used MacBooks for sale. Nor does the resale deprive Apple of any goodwill associated with its product; the stickered MacBook is still as long-lasting (or short-lived) as any other used MacBook. And while Apple might not like the message any given user affixes to their laptop, the law has never given trademark owners control over private rather than commercial communications made using a trademarked good.

While the connection between personal uses and trademark law's function is attenuated, in the case of works of art it is altogether absent. A live sculpture made from Nike shoes covered with moss, dirt, and plant roots will not confuse anyone in a way that affects consumer search costs or Nike's business goodwill. The Nike shoe is merely an object used to communicate the artist's vision. That vision may be one Nike doesn't like. But criticism is not one of the things the law allows trademark owners to control.

Further, even if we're wrong about what people think, the law should draw a line at private personal use for policy reasons. Trademark law has always been confined to commercial uses. And as we have seen, it has doctrines that limit the reach of the law even if consumers end up being confused. There is a good reason for that.

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<sup>277</sup> A possible exception involves the kit car cases. But even there, the worry is not that people will buy a kit car thinking it's a Ferrari. Instead, the real worry is that too many of the "wrong" sort of people will be seen to be driving Ferraris. See Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 809, 831-34 (2010) (discussing kit car case in context of persuasive imitation of distinctive goods and dilution); Sheff, *supra* note 131, at 821 ("Interfering with the mark owner's ability to maintain artificial conditions of scarcity in order to cultivate that image of exclusivity lessens the value of such marks and thereby, it is argued, injured the mark owner.").

<sup>278</sup> Cf. *supra* note 113.

In both cases, there are practical as well as policy reasons to exclude personal and artistic uses entirely from the reach of trademark law rather than running them through the normal doctrinal process. Defendants should ultimately win these cases on one ground or another, and they generally do.<sup>279</sup> But trademark litigation is expensive and uncertain. Because the likelihood of confusion test for infringement depends on consumer perception, defendants may have to hire a survey expert, and it may be difficult to get out of even a frivolous case early enough to avoid spending a lot of money. And artists and individual citizens frequently can't afford to fight a trademark suit. As a result, they often cave in to even the most ridiculous demands from trademark owners.<sup>280</sup>

Courts need a doctrine that takes such uses out of the reach of trademark law altogether and can be applied at the outset of the case. The trademark use doctrine would ideally protect these sorts of uses (or really, nonuses) of trademarks. In the circuits (still a majority) that have not eviscerated the doctrine, trademark use will protect noncommercial users from suit because they aren't using the trademark to brand anything. A sticker on an Apple laptop doesn't say anything about the maker of the computer. Even if consumers were somehow confused by the sticker, that isn't confusion about source, sponsorship, or affiliation of the sort that trademark law has historically cared about. And broadening the scope of trademark to prevent such uses would create major First Amendment problems.

When noncommercial customizations are understood in the context of trademarks' function, they present a compelling case for the application of the trademark use doctrine. And the Supreme Court's decision in *VIP Products* indicates the trademark use doctrine is back in play.<sup>281</sup> Those courts that abandoned the trademark use doctrine should recognize the Supreme Court has endorsed its use to determine whether to apply a likelihood of confusion analysis.<sup>282</sup>

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<sup>279</sup> See, e.g., *Mattel Inc. v. Walking Mountain Prods*, 353 F.3d 792, 810 (9th Cir. 2003) (holding use of Barbie dolls trademark were protected artistic expression); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1282 (11th Cir. 2012) (holding unauthorized depictions of university uniforms were artistically relevant to artist's paintings of famous football scenes).

<sup>280</sup> See Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 WIS. L. REV. 625, 628-30, 652 (explaining how costs of rebuffing "trademark bullies" can make "ceasing to use the trademark at stake without a battle" the least expensive option); Mark A. Lemley, *Fame, Parody, and Policing in Trademark Law*, 2019 MICH. ST. L. REV. 1, 5-6 (discussing how even weak infringement suits shut down valuable speech that law is not intended to target); Yvette Joy Liebesman & Benjamin Wilson, *The Mark of a Resold Good*, 20 GEO. MASON L. REV. 157, 163-64 (2012) (describing how small resellers of products may close rather than face litigation from trademark owners of related products); William McGeveran, *Four Free Speech Goals for Trademark Law*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1205, 1225-26 (2008) (arguing fair use arguments should be considered earlier in trademark litigation to avoid unnecessary costs).

<sup>281</sup> *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1591 (2023).

<sup>282</sup> Mark McKenna earlier suggested that trademark use is rearing its head again because the courts that did away with it find themselves needing a doctrine that does the same work. See Mark P. McKenna, *Trademark Use Rides Again*, 104 IOWA L. REV. ONLINE 105, 107

But even a revitalized trademark use doctrine wouldn't protect all the uses of trademark-bearing goods that should fall outside the reach of trademark law. Ideally, works of art should be excluded altogether from the scope of trademark law because they too are noncommercial.<sup>283</sup> The difficulty is that establishing a rule that categorically excludes art from trademark's reach would require courts to define what art is. That is a perilous endeavor, and one courts have shied away from in other contexts.<sup>284</sup> And when courts have decided to weigh in on what counts as proper art, they have sometimes gotten it spectacularly wrong.<sup>285</sup> We worry that that might be particularly likely to happen with nontraditional art media like shoes and earrings.

When courts use the trademark use doctrine, they will have to decide whether a work of art incorporates a trademark in the service of the artist's creative expression—which would be a non-trademark use—or is in fact branding itself using the plaintiff's trademark as the artist's own mark—an act that might well be legal, but which is a trademark use.<sup>286</sup> That may be an even harder question.

Nonetheless, we think there are some categories of customization that can straightforwardly be excluded from trademark risk at the outset.

Some artistic aftermarket customizations do not make a trademark use and should be outside the scope of trademark law altogether. Modifying (“modding”) a video game to include brands inside the game or using a game construction platform like Minecraft or Roblox to construct a virtual Ikea, simply don't involve using trademarks to brand goods; they involve private aftermarket modifications akin to putting stickers on a laptop. That same concept

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(2020) (explaining that “use as a mark is undervalued” in part because we lack “sufficiently clear rules for determining use as a mark”).

<sup>283</sup> Works of art are noncommercial even though some works may fetch high prices in art markets, just as newspapers are noncommercial even though they are sold for profit. Noncommercial in this context means that it is not speech that proposes a commercial transaction rather than something that doesn't make money. “If speech is not ‘purely commercial’—that is, if it does more than propose a commercial transaction—then it is entitled to full First Amendment protection.” *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 906 (9th Cir. 2002).

<sup>284</sup> For the oft-quoted refrain, see *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”). *But see* Brian Soucek, *Aesthetic Judgment in Law*, 69 ALA. L. REV. 381, 426-31 (2017) (noting moves intended to “sidestep retail-level aesthetic evaluation” themselves involved “higher order aesthetic judgments”); Alfred C. Yen, *Copyright Opinions and Aesthetic Theory*, 71 S. CAL. L. REV. 247, 250 (1998) (arguing judges cannot avoid aesthetic judgments and inevitably show preference for certain aesthetic perspectives because copyright law requires aesthetic choices).

<sup>285</sup> See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258 (2023) (affirming Second Circuit holding as matter of law that Andy Warhol's portraits were not transformative and merely superseded photographs on which they were based).

<sup>286</sup> See Stacey L. Dogan & Mark A. Lemley, *Parody as Brand*, 47 U.C. DAVIS L. REV. 473, 478 (2013) [hereinafter Dogan & Lemley, *Parody*] (explaining trademark use “is a logical filter to weed out cases that are about parodies”).

should extend to customized physical consumer goods. Regardless whether the customizer creates one-of-a-kind works or produces a certain volume (like 666 Satan Shoes), keeping the underlying product's existing marks should be considered a non-trademark use if the customizer doesn't use those existing marks as the customizer's own mark. Following *VIP Products*, that would mean a sneaker customizer should be careful not to state too prominently in marketing materials that their work is on Nike Air Force 1s, or add any tags that do the same. There is a degree of absurdity in this marketing limitation—trademark law would not apply to a customized sneaker that retains a Nike Swoosh, but truthful marketing that features the underlying product's source would invite its application.

If we can be sure that a work is art and not a commercial product, there is a strong argument for treating it as outside the scope of trademark law altogether. But art will often blur the line between using a trademark to brand the defendant's goods and using a mark "in" those goods. The living shoe sculptures we identified in Part I don't use the Nike sneakers as a brand per se, but the trademark is front and center as a part of the artwork. So too with Walking Mountain's Barbie in a blender. Courts may differ on whether they view art that features a brand as a centerpiece as effectively using the brand to identify the work of art. But, following *VIP Products*, courts are more likely to be in a position to make these sorts of judgments, and they should be principled. As the Supreme Court would have it, an artist conceding they use the brand as a mark or using it to market their own work would cross the line into "trademark use." There are some straightforward applications of this rule—"Satan Shoes" doesn't use Nike as a mark, but "Nike Satan Shoes" would. But other applications are more fraught, like Jim Lasser's use of the title "Obama Force Ones" for the portrait of President Obama he engraved into a single-edition customized pair of Nike Air Force 1s. Courts should nevertheless recognize that marks appearing within works of art are unlikely to be "used as a mark."

Brand owners will no doubt push back against a rule that resold personal customizations and works of art are beyond trademark's reach; they will likely claim such a rule will be abused by those in the business of customization. They may claim, for instance, that a home crafter who sells branded bottle-cap earrings on Etsy will assert she made the earrings for her personal use, but then decided to sell them. Or perhaps Nike or Adidas will argue that shoes someone decorated with Fortnite characters will confuse consumers given that there is an existing relationship between Epic Games and those brands.<sup>287</sup>

While there are line-drawing problems here, as in all areas of law, we aren't as worried about these kinds of cases. It should be fairly obvious to a factfinder whether someone makes a business of customization—a name like "Kelly's Caps" seems to give that away. And if the customizer is a large business enterprise that plasters its marks and related imagery on a trademark-protected good, courts can fairly presume the business is doing so for its own commercial

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<sup>287</sup> *Fortnite Partners Nike and Adidas*, MAGIC FABRIC BLOG (Sept. 4, 2019), <https://magicfabricblog.com/fortnite-partners-nike-and-adidas/> [<https://perma.cc/D4NQ-NK2B>].

purposes despite the business's contrary assertions. Truly personal customizations and the use of trademarks in works of art do not implicate trademarks' purposes. But for works that are closer to the line, it may be harder for the law to say that trademark law simply doesn't apply at all.

Even if courts apply the trademark use doctrine, many expressive customizations won't fit within that doctrine because they *do* make use of a mark similar to the plaintiff's to try to sell their own product. Noncustomization cases provide good examples. Consider Bad Spaniels or Chewy Vuiton dog toys, for instance.<sup>288</sup> They are parodies, and the lawsuits against them were ridiculous, but the parodic names were being used as trademarks to brand the goods that bore those names. Similarly, musical artists make a trademark use of the brand names that appear in their song titles even though their songs are works of art.<sup>289</sup> Those uses should be legal, but they are trademark uses, so we can't just exclude them from the trademark framework altogether.<sup>290</sup> And now, *VIP Products* requires courts to direct those cases to a likelihood of confusion analysis.<sup>291</sup>

As a result, while private, noncommercial customization should be outside trademark's reach, even when the individual product is resold, not all art that deserves protection from suit will similarly be exempted by the trademark use doctrine or a noncommercial use equivalent. Thus, we need a doctrine to deal with those works. We turn to that case in the next Section.

#### B. Customization as Expressive Work

Even if a customization is commercial, trademark law should often permit it. Art doesn't stop being art because it is commercial. Selling 666 pairs of sneakers doesn't change the nature of the artistic statement, any more than selling limited-

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<sup>288</sup> See *VIP Prods. LLC v. Jack Daniel's Props., Inc.*, 953 F.3d 1170, 1172 (9th Cir. 2020) (holding "Bad Spaniels" dog toy was expressive work protected by First Amendment); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 256-57 (4th Cir. 2007) (holding "Chewy Vuiton" dog toy was successful parody and not likely to cause confusion).

<sup>289</sup> See *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 899 (9th Cir. 2002) (discussing reference to "Barbie" in Aqua's song title); see also *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. 1989) (discussing use of Ginger Rogers's name in movie title "Ginger and Fred"). The Supreme Court distinguished song and film titles from titles of expressive dog toys, such that *Rogers* would continue to apply to song and film titles that include third party marks but not to titles of expressive dog toys, but we see no principled basis to draw that line. *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1587-88 (2023).

<sup>290</sup> See *Dogan & Lemley, Parody*, *supra* note 286, at 480 ("Nor should the fact that a mark appears in the title of an expressive work change the outcome."). By contrast, the trademark use should arguably protect references to a brand in the body (as opposed to the title) of an expressive work. As we have seen, *Rogers* has been extended to provide substantial protection to the use of a brand inside an expressive work. But it shouldn't be necessary. Mentioning a brand in a book or movie just isn't a trademark use at all.

<sup>291</sup> *VIP Prods.*, 143 S. Ct. at 1589.

edition prints makes a painter's work not art, or the fact that millions of people watch a movie means it isn't protected expression.<sup>292</sup>

If a customization is commercial and uses the trademark to identify the goods being sold, the next question to ask is whether the customization is part of an expressive work that is not purely commercial speech.<sup>293</sup> If it is, while it is not categorically immune from suit, the customized good is properly reviewed under the deferential standard *Rogers* sets for expressive works. The fact that it started life as a consumer product does not prevent it from being turned into an expressive work.

The Supreme Court recently limited the application of the *Rogers* test—it no longer protects those who use another's mark (or some adaptation of it) to identify their own products, regardless whether their adaptation is parodic, critical, or otherwise expressive.<sup>294</sup> But the Court did not overrule *Rogers* or provide any clarity as to whether *Rogers* should apply to works of creative expression on a branded medium.

We think there are still strong and legally viable reasons for *Rogers* to protect expressive customizations applied on branded goods. Brands are part of our ongoing cultural conversation. Not only do we talk about brands, but we use them, change their meaning, catapult some to high status, and reduce others to embarrassment. Expression that refers to brands' trademarks does not become "commercial" solely because it appears on a medium sold for profit. Art—such as the Fellini film at issue in the *Rogers* case—often generates profit. *Humorous* uses of marks in expressive works, regardless of whether those works are applied on so-called "commercial products" or other media, especially merit protection from trademark suits. Otherwise, we risk ossifying what we regard as "speech" and worthy of protection in a manner that fails to keep up with contemporary forms of cultural expression—and, instead, silences them. Lower courts have the opportunity to interpret the *Rogers* test in the manner we recommend: to find the *Rogers* test should apply to expressive works *even if* the expressive work appears on or in a consumer good.

Moreover, trademark owners often overtly seek to insinuate their brands with broad cultural meaning, from Nike's "Just Do It" campaign to just about any time someone says, "Google it."<sup>295</sup> And brands naturally feature prominently in expressive works of all sorts, from books to movies to video games. Want to

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<sup>292</sup> Annie Seminara has suggested that the test should turn on whether the market treats the customized shoe as art rather than as a shoe. Annie Seminara, Note, *Satan Shoes or Satan Speech? Balancing Trademark and First Amendment Rights in the Altered Authentic Goods Context*, 46 COLUM. J.L. & ARTS 221, 237-41 (2022). While that test would protect many of the customizations we have discussed here, we worry that it would miss works of art that, unlike Wavy Baby, actually also function as shoes.

<sup>293</sup> For the challenging line between products and speech, see Robert C. Post & Jennifer E. Rothman, *The First Amendment and the Right(s) of Publicity*, 130 YALE L.J. 86, 113 (2020). But we emphasize that this is not an either-or distinction; products can and do include protected speech.

<sup>294</sup> *VIP Prods.*, 143 S. Ct. at 1589.

<sup>295</sup> See *Air Force 1: Just Do It*, NIKE, <https://www.nike.com/id/launch/t/air-force-1-premium-just-do-it> [<https://perma.cc/29B3-QN28>] (last visited Feb. 10, 2023).



make a video game that realistically depicts the Iraq war? It's hard to do so without including Humvees.<sup>296</sup> Want to set a scene in your movie in Times Square? It's not going to look realistic unless it includes the buildings and advertisements that dominate that square.<sup>297</sup> And if a singer wants to ask "oh Lord, won't you buy me a Mercedes-Benz?",<sup>298</sup> she might not be satisfied asking for an "unspecified German luxury car." While some works of fiction change the names of brands, doing so breaks the illusion of reality, as anyone who has seen a television show in which people search the internet on some made-up search engine like "Finder Spyder" can attest.<sup>299</sup> *Rogers* is designed to make sure that expressive works can use brands in the work, and even in the title, without fear of liability in most circumstances.

Visual art, for instance, is a recognized form of expression protected under *Rogers* even though it might use a trademark on its face—and heavily, at that. Take Andy Warhol's soup can paintings, for instance.

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<sup>296</sup> See *AM Gen. LLC v. Activision Blizzard, Inc.*, 450 F. Supp. 3d 467, 484 (S.D.N.Y. 2020) (holding that use of "vehicles employed by actual militaries" has artistic value by furthering game's realism).

<sup>297</sup> See *Sherwood 48 Assocs. v. Sony Corp. of Am.*, 76 F. App'x 389, 392 (2d Cir. 2003) (rejecting Times Square property owner's claim of trade dress infringement over ad alterations to buildings in Spider-Man movie).

<sup>298</sup> JANIS JOPLIN, *Mercedes Benz, on PEARL* (Columbia Records 1971).

<sup>299</sup> Ian G. McFarland & John T. Winemiller, *Fictional Brands, Famous Marks: Recurring Characters, Places, and Elements Can Serve as Source Identifiers for Creative Works*, AM. BAR ASS'N, [https://www.americanbar.org/groups/intellectual\\_property\\_law/publications/landslide/2018-19/march-april/fictional-brands-famous-marks/](https://www.americanbar.org/groups/intellectual_property_law/publications/landslide/2018-19/march-april/fictional-brands-famous-marks/) [https://perma.cc/35CC-ATAU] (last visited Feb. 10, 2023).

Figure 31. Andy Warhol's *Campbell's Soup Cans*.<sup>300</sup>



That is true even though Andy Warhol made his own images of Campbell's marks.

*Rogers* fits less well, though, when creators seek to engage in cultural conversation not through traditional expressive media, but by using branded goods as canvases for creators' expression. The trademark isn't being used to title an expressive work or recreated in a new visual medium; it is a physical component of the customized good itself.

But the medium on which the expressive work appears should be beside the point; forms of creative expression will fluctuate as society discovers and creates new ways to communicate ideas. Jeff Koons's appropriation art and Marcel Duchamp's *Fountain* were innovations of their time. The current generation has chosen to take up consumer goods as their expressive medium, which should not be that surprising considering how saturated popular culture is with brand imagery and messaging.<sup>301</sup> Creative alterations to consumer goods contribute to cultural conversation in the same way creative expression does generally; the fact that this new form of expression appears on a mark-bearing product does not diminish that. Indeed, it seems even more defensible than Warhol making new images of soup cans. And it's especially critical for trademark law to protect this new form of expression from infringement suits; otherwise, trademark enforcement might lead consumers to expect every instance of customization to be licensed, chilling valuable creative expression. *Rogers* must protect expressive works even if that expression occurs in nontraditional contexts.

<sup>300</sup> Andy Warhol, *Campbell's Soup Cans* (photograph), in MUSEUM OF MOD. ART LEARNING, [https://www.moma.org/learn/moma\\_learning/andy-warhol-campbells-soup-cans-1962/](https://www.moma.org/learn/moma_learning/andy-warhol-campbells-soup-cans-1962/) [https://perma.cc/4X98-JRED] (last visited Feb. 10, 2023).

<sup>301</sup> See Dreyfuss, *supra* note 22, at 398; Litman, *supra* note 22, at 1732.

That doesn't mean every customization is an expressive work. We propose an interpretation of the *Rogers* test, in line with *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*<sup>302</sup> and *Mattel, Inc. v. MCA Records, Inc.*,<sup>303</sup> that should protect most customizers who use consumer goods as a canvas to communicate their artistic expression.<sup>304</sup> The threshold question under *Rogers* is whether the work is "expressive" such that the *Rogers* test even applies. To distinguish those works that raise genuine cosponsorship or cobranding issues from those that participate in cultural dialogue, we propose those works whose "expression" is no more than commercial branding should be excluded. We draw our definition of commercial expression from the First Amendment commercial speech doctrine. Commercial speech—that which "does no more than propose a commercial transaction"<sup>305</sup>—should not qualify for a *Rogers* defense. Customizing a product in a way that does no more than use it as an advertisement for a different product, as with the McDonald's-themed PS5 controller, doesn't belong in this category. These products might or might not be confusing to consumers, but they don't deserve special treatment.<sup>306</sup>

The next consideration is whether the use of the mark is "artistically relevant." We propose courts should follow the Ninth Circuit in *E.S.S. Entertainment 2000* and find that customization satisfies this prong when using the trademark serves the customization's creative purpose in some way.

This condition will be met when the customization uses a mark for its "expressive meaning apart from its source-identifying function."<sup>307</sup> Sometimes the artistic relevance will be obvious. Consider a customizer who adds the word "SWEATSHOP" to a pair of Nike sneakers.<sup>308</sup> His use of a Nike-branded shoe

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<sup>302</sup> 547 F.3d 1095 (9th Cir. 2008).

<sup>303</sup> 296 F.3d 894 (9th Cir. 2002).

<sup>304</sup> *E.S.S. Ent. 2000*, 547 F.3d at 1099; *MCA Recs.*, 296 F.3d at 901-02.

<sup>305</sup> *MCA Recs.*, 296 F.3d at 906.

<sup>306</sup> The fact that the underlying product is a genuine product from the trademark owner still matters in the analysis. The first sale doctrine precludes a counterfeiting theory (that is, that the finished, customized product is a counterfeit) or a claim that the underlying product itself infringes the trademark it bears if that product is genuine. But it won't prevent a possible theory that the customization confuses consumers about sponsorship or affiliation between the two brands. That sort of confusion seems entirely possible in a case like the McDonald's PS5 controller, because cobranding between large companies is relatively common, and people are likely to assume two sophisticated trademark owners likely came to terms before what seems like cross-promotion. See, e.g., Camilla Rydzek, *Gucci and Balenciaga's The Hacker Project Launched in Three London Locations*, INDUS. FASHION (Nov. 17, 2021), <https://www.theindustry.fashion/gucci-and-balenciagas-the-hacker-project-launched-in-three-london-locations/> [<https://perma.cc/3RQ4-43YE>] (describing fashion collaboration in which Balenciaga and Gucci agreed to modify each other's products in what seemed like guerilla graffiti campaign).

<sup>307</sup> *MCA Recs.*, 296 F.3d at 900.

<sup>308</sup> See Kathleen Elkins, *A Fight with Nike Led Jonah Peretti to Create a Billion-Dollar Media Empire*, YAHOO!NEWS (Aug. 3, 2017), <https://www.yahoo.com/news/fight-nike-led->

is relevant to his desire to call attention to Nike's inhumane working conditions—that is his creative purpose—and it is certainly not Nike's preferred message. Shoes modified to light up the words "Fuck Mags" are even more obviously critical of Nike. Other messages are clearly social or political even though they aren't critiques. Obama Force One sneakers are a homage to the former president, but they are no less expressive because they support rather than attack a cultural icon.

But the defense is meant to be even more expansive than that. The artistic relevance of the use must merely be "above zero."<sup>309</sup> For instance, sneaker customizers that alter brand-bearing sneakers with new colorways, illustrations, and designs are often participating in the same street culture in which Nike Air Force 1s have meaning beyond Nike as the shoe's source. They use Air Force 1s as a canvas because their art is about Air Force 1s in some sense. These creative uses of a brand-bearing product should be a protected form of cultural expression. Notably, that is true whether or not the customization parodies or critiques the shoes. What matters is the customization uses the underlying product's mark to convey the *customization's* artistic expression, whatever that may be.<sup>310</sup>

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jonah-peretti-121500551.html [https://perma.cc/N9LC-XYC2] (describing Jonah Peretti's infamous attempt to order custom Nike shoes emblazoned with word "sweatshop").

<sup>309</sup> See *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (concluding that titles do not violate Lanham Act "unless the title has no artistic relevance to the underlying work whatsoever"). Indeed, we are aware of only one case that ultimately found no artistic relevance. See *Parks v. LaFace Recs.*, 329 F.3d 437, 459 (6th Cir. 2003) ("[T]he issue of artistic relevance of the title Rosa Parks to the lyrics of the song is highly questionable and cannot be resolved as a matter of law."). Other cases find liability by refusing to apply *Rogers* to advertisements even if they could also be viewed as expressive works. See, e.g., *MGFB Props., Inc. v. Viacom Inc.*, No. 21-13458, 2022 U.S. App. LEXIS 32879, at \*8-11, \*31 (11th Cir. Nov. 29, 2022) (holding that television show could be called "Flori-Bama" despite existence of Flora-Bama bar); *Louis Vuitton Malletier, S.A. v. Hyundai Motor Am.*, No. 10 Civ. 1611, 2012 WL 1022247, at \*19 (S.D.N.Y. Mar. 22, 2012) ("[N]o reasonable trier of fact could conclude that the Louis Vuitton-style marks shown in the 'Luxury' ad could constitute 'use in connection with . . . identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.'" (quoting 15 U.S.C. § 1125(c)(3)(A)(ii))).

<sup>310</sup> The same is true of shoes created to both mimic and comment on brands, not just those that customize actual branded shoes. Cf. *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 602 F. Supp. 3d 358, 364 (E.D.N.Y. 2022) (granting temporary restraining order and preliminary injunction to bar MSCHF, maker of Satan's Shoes, from selling "Wavy Baby," a play on the Vans sneaker).

Most noncommercial aftermarket customizations should easily qualify as artistically relevant under *Rogers*. As long as the customization says something that relates to or bears on the product or brand, the use of the underlying product should satisfy step one of *Rogers*. Those uses may be subtle. But if it is art with a message that relates in some way to the brand, even a subtle one, it satisfies the first prong of *Rogers*.<sup>311</sup>

The second prong of the *Rogers* test does more work to weed out customizations that unfairly appropriate brand owners' goodwill. Those customizers who "explicitly mislead" the public into thinking the underlying trademark is the source of their custom shoes cross the line into trademark infringement. Purely commercial customizations (such as the McDonald's PS5) may meet that test, though as we noted above, they should not be covered by *Rogers* in the first instance. But a customizer who engages in noncommercial artistic expression may nonetheless fail the *Rogers* test if they mislead the public into thinking that the trademark owner made or authorized their changes. Notably, however, the mere possibility that the public thinks that Nike must have sponsored or approved any customization of its sneakers does *not* suffice to defeat the second *Rogers* prong. The defendant must do something that "explicitly misleads" as to the source. The use of the mark alone cannot do so, particularly where, as in the cases we consider here, the mark is used to accurately identify a genuine underlying product.

**Figure 32.** Wavy Baby Sneaker.



Photograph of Wavy Baby Sneaker, *in* Complaint at 3, *Vans, Inc.*, 602 F. Supp. 3d 358 (No. 22-CV-2156).

<sup>311</sup> For example, while the *NYC Pigeon* shoes have a message, it is less obvious that the message has anything to do with Nike.

The clearest application of *VIP Products* to customizations would also exclude from *Rogers*' protections customizers who use the underlying product's marks prominently in the course of marketing their customizations.<sup>312</sup> That would mean, for instance, if Lil Nas X sold the Satan Shoes as "Nike Air Max 'Satan Shoes'" or added a hang tag that identified the shoes as "Nike Air Max" (which, indeed, the underlying shoes were), those uses of the Nike mark would be subject to a likelihood of confusion analysis.

Other cases that would fail step two of the *Rogers* test would include some sort of express claim of sponsorship or relationship—calling the customized product "official" or "sponsored." But what qualifies as an express statement of affiliation will depend on how conversational language evolves over time. We might presume, for instance, "Nike x Patta" serves as a shorthand for an official collaboration between Nike and the customizer Patta.<sup>313</sup> On the other hand, "Butterflies #byAlli" on Nike Air Force 1s does not suggest any relationship between Alli and Nike.<sup>314</sup> But other claims may be more ambiguous. Does "'The Skyler' Nike AF1" suggest that Nike came up with or approved of the "Skyler" floral design?<sup>315</sup> How should we interpret Lil Nas X's claim that he is selling "genuine" Nike shoes? If we take the claim of "genuineness" to refer to the underlying product, that is a true statement—he bought and customized actual Nikes. But it is possible that consumers could understand it to indicate that his redesigns were also Nike products. Is the claim of genuineness "explicitly misleading"? Courts might view it as raising a factual question about the explicitly misleading prong, but the "explicitly misleading" prong of *Rogers* sets a high bar.<sup>316</sup> And for good reason: the whole point of the *Rogers* test is to avoid enmeshing every defendant in expensive and uncertain litigation over consumer confusion. Courts applying *Rogers* typically protect artistically relevant uses of trademarks even where there is evidence some consumers would be confused unless that confusion is engendered by explicit indications of a relationship with the mark owner.<sup>317</sup> That should extend to accurate statements by customizers like Drip Creationz or Lil Nas X even if some people are confused as a result.

Customizations that juxtapose two different brands complicate the *Rogers* analysis even further. We have already suggested that if a brand owner does that by doing nothing more than decorating Adidas shoes with their own trademarks, *Rogers* should not even apply because the brand owner's speech is most likely

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<sup>312</sup> Jack Daniel's Props., Inc. v. VIP Prods. LLC, 143 S. Ct. 1578, 1590-91 (2023).

<sup>313</sup> Riley Jones, *Patta's 'Pure Platinum' Nike Air Max 1 Collab Releases This Week*, SOLE COLLECTOR (Aug. 23, 2022), <https://solecollector.com/news/patta-nike-air-max-1-metallic-silver-monarch-pure-platinum-noise-aqua-2021-release-date> [<https://perma.cc/4XFG-DGCB>].

<sup>314</sup> The Custom Movement (@thecustommovement), INSTAGRAM (Apr. 29, 2020), [https://www.instagram.com/p/B\\_krZhoJdws/](https://www.instagram.com/p/B_krZhoJdws/).

<sup>315</sup> *The Skyler' Nike AF1 (Women's)*, DJ ZO DESIGNS, <https://djzodesigns.com/products/the-skyler-nike-af1-womens> [<https://perma.cc/ZAQ9-UPFC>] (last visited Feb. 10, 2023).

<sup>316</sup> See *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 265 n.7 (9th Cir. 2018).

<sup>317</sup> See, e.g., *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 937 (6th Cir. 2003) ("The risk of misunderstanding, not engendered by any explicit indication on the face of the print, is so outweighed by the interest in artistic expression as to preclude application of the Act.")

commercial. But individual customizers who aren't associated with any brand frequently include brand imagery in their customizations. Recall Jeffrey Waskowiak's use of the Amazon Prime logo on a customized Nike sneaker and Drip Creationz's designs that feature Chester the Cheetos Cheetah and Chick-fil-A logos. Consumers may well think the resulting shoe is a cobranding effort, just as they likely would with the McDonald's PS5 controller. But in fact, the brand owners didn't create the customizations. Individual customizers used these brands' imagery for their own creative expression and perhaps to make a political or social statement.

In these cases, context matters. The identity of the customizer doesn't determine whether their expression is commercial or creative. We cannot say in absolute terms McDonald's can never make or sponsor noncommercial expressive uses, or that Drip Creationz can never use a Nike shoe as a canvas for commercial speech, merely because the former is a major corporation and the latter is a small group of designers.<sup>318</sup> But it might be fair to presume a business's application of its own brand imagery to a trademark-emblazoned product serves a promotional function given contextual factors, particularly if it doesn't add anything else. And trademark law may very well have to tolerate the risk that customizers' juxtaposition of brands may create confusion as to a cosponsorship relationship to protect the public's ability to use brands as symbols of ideas and values in the public vocabulary.<sup>319</sup> The Supreme Court limits this protection in *VIP Products*, with a potentially absurd effect. Jeffrey Waskowiak's use of the Amazon Prime logo in his customization of a Nike sneaker could (and should) still be protected from trademark liability under *Rogers*, but calling the sneaker "Custom Prime Nike Air Jordan 1" raises the spectre of liability to both Amazon and Nike. But if trademark law doesn't protect the customized product itself from liability, we place creative appropriations of trademarks like Andy Warhol's depiction of the Campbell's soup can in a perilous position.

Though they aren't required, relationship disclaimers might do much to dispel the risk that a customizer's reference to the underlying product's brand might explicitly mislead. The Third Circuit's formulation of the nominative use test—that the defendant must accurately state the relationship between the parties—may be a helpful middle ground in cases where the nature of the customization is inherently likely to suggest a relationship.<sup>320</sup> Even in that circumstance, a

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<sup>318</sup> As an example, one commentator suggested to us a story in which the McDonald's PlayStation controller was coupled with a claim that "everything you think is bad for you isn't, whether it's French fries or video games." Telling such a story presumably communicates an expressive message.

<sup>319</sup> See *ETW Corp.*, 332 F.3d at 932.

<sup>320</sup> See *Century 21 Real Est. Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 230-32 (3d Cir. 2005). Nominative use also employs a similar test that requires that the defendant do more than just use the mark to suggest sponsorship or affiliation.

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disclaimer or accurate statement about who did what should suffice to immunize the customizer.<sup>321</sup>

This application of *Rogers* is likely to protect most noncommercial customizations. That is a good thing. *Rogers* is, by design, very protective of expressive works, including art but also new forms of creative expression as they emerge. So long as the customizer's use of a good's trademark is relevant to the customizer's original expression and they do not explicitly mislead people about the relationship, *Rogers* will protect their customizations from trademark infringement suits. Notably, and importantly, this is true even if consumers are confused. One useful feature of *Rogers* is that it, therefore, avoids problematic uses of doctrines like post-sale confusion to shut down valuable expression.

Where does this leave us? We think the law should parse commercial customization as follows:

- If a customizer uses the underlying product's mark to market their customization, that *new* use of the mark is subject to a likelihood of confusion analysis. By contrast, if the customizer does not use the mark to brand the customizer's goods, their retention of the underlying product's mark is not a trademark use and may be considered an expressive work subject to the *Rogers* test.
- If a commercial customization intends to communicate a particularized message that is not commercial speech, it should be considered an expressive work subject to the *Rogers* test.
- If an expressive commercial customization satisfies *Rogers*, it is protected as free expression.
- If an expressive commercial customization's use of the mark is "artistically relevant" to the customization, but the defendant explicitly misleads as to the customization's source, the customization should be subject to a trademark infringement analysis.
- If an expressive commercial customization's use of the mark is not "artistically relevant," courts should ask whether the customization uses the branded good as a "component part" of a "new configuration."
- If a commercial customization does not intend to communicate a particularized message, it should not be considered an expressive work and courts should ask whether the customization uses the branded good as a "component part" of a "new configuration."

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<sup>321</sup> See *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1182 (9th Cir. 2010); see also *Ferrari S.P.A. Esercizio v. Roberts*, 944 F.2d 1235, 1250 (6th Cir. 1991) (Kennedy, J., dissenting) ("[T]hese cases conclude that the proper remedy is to require identification of the source of the replica, not prohibit copying of the product. Accordingly, even if I were to conclude that plaintiff's copies created confusion in the presale context, I would tailor the remedy to protect only against such confusion; this would best be accomplished through adequate labelling." (citations omitted)).



- If a commercial customization's message is purely commercial, it should not be considered an expressive work and it should be subject to a trademark infringement and nominative use analysis.

C. *Branded Goods as Component Parts*

For some customizations, the trademark's appearance on the consumer good is irrelevant to the customizer's message, or the customizer may have no message at all. Consider the trademark implications of Marcel Duchamp's *Fountain*, a sculpture composed of a purchased urinal, reoriented and signed "R. Mutt 1917," if that urinal retained the brand name of its maker, J. L. Mott Iron Works.<sup>322</sup> Should trademark law protect Duchamp's sculpture from liability only if he used "J. L. Mott Iron Works" to communicate his creative expression? We think the answer is no. The branded urinal is merely a physical component of Duchamp's work. It is one of the "raw materials" that comprises his artistic creation, and the trademark is not signaling source in this context.

The doctrine of nominative use has a role to play here, but it requires a degree of clarification. When someone engages in customization, whether the final product is a work of art or an embellished consumer good, they are creating something new, separate, and apart from the components that go into their custom product.

Some customized goods will retain the trademarks affixed to their components simply because they would be difficult, costly, or unsightly to remove. Others are less prominent. Adidas's iconic three stripes take up a substantial portion of the body of most Adidas shoes; Hanes' word mark is generally confined to the inner label of their T-shirts. Other customized goods separate marks from the original product and affix them to new things altogether, such as a custom watch that uses a Heineken label as a face plate. Each of these uses has different implications for the sort of consumer confusion trademark law seeks to avoid, and not all should be protected from infringement analysis.

We propose courts should ask three questions when a customization uses a branded good as a "component part" of a "new configuration." First, does the custom work use only the branded good's label or mark and not the good itself? If so, the court should proceed to an infringement analysis without any special defense for the customization. Second, does the custom work add physical or aesthetic elements to the branded good itself? If it does, courts should then ask whether the finished, customized work prominently displays the component part's trademark. If the component part's trademark is a minor or less visible feature of the finished work (such as Hanes's logo on an internal clothing label of a customized T-shirt), the use should be outside trademark's scope. If the trademark features as a prominent aesthetic element of the custom work (like Adidas's three stripes) but the finished product includes other elements, the court should proceed to a nominative use analysis.

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<sup>322</sup> *Marcel Duchamp: Fountain*, TATE, <https://www.tate.org.uk/art/artworks/duchamp-fountain-t07573> [<https://perma.cc/TTE5-X9F2>] (last visited Feb. 10, 2023).

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*Labels alone.* The threshold question we ask seeks to eliminate those downstream appropriations of marks that don't use branded products as component parts at all, but merely take a product's label and use it as part of the customizer's new product. A particularly egregious example would be a clothing manufacturer who bulk-buys Lacoste's iconic alligator logo patch and affixes it to the manufacturer's own apparel. This would present a compelling case of counterfeiting because it overtly seeks to profit off Lacoste's brand goodwill. So, it should not be a protected form of aftermarket customization. But we think it also includes products that copy only the trademark from one product onto an unrelated product, like the people who put a Heineken beer label inside a watch face. The label is genuine, but there is no part of the beer or the beer bottle itself that is being used in the new product. And because the label is the logo, it seems likely to mislead consumers into thinking the product is an official one.

*Combining products.* Trademark law provides less direction as to how it would deal with customizations that add physical or aesthetic elements to a branded good. As we demonstrate in Part I, the practice, as a commercial matter, is both historied and widespread. Indeed, in the *Prestonettes* case that established the first sale doctrine, the Supreme Court had to decide how trademark law would apply to a manufacturer of pressed powder compacts that used "Coty loose powder" as its main ingredient and said as much on its label.<sup>323</sup> Trademark law could not prohibit the compact manufacturer's use of Coty loose powder in its product; trademark law is concerned with protecting the source-signifying function of marks, not policing the uses goods may be put to when they enter commerce. But the line between use of a product and use of the product's trademark is much less clear when the product used as a component indelibly displays its maker's mark.

A useful first step is to distinguish between customizations that prominently display the component part's mark and those that don't, for the same reasoning that animates the trademark use doctrine. When a six-year-old tie-dyes Hanes T-shirts to sell at her school fair, she doesn't use the Hanes mark to signal the source of her custom work or to refer to Hanes. The Hanes mark is not the thing motivating her young consumers to purchase the tie-dyed T-shirts. The same can be said of caricaturists who draw on paper bearing Blick's watermark, or a watchmaker who uses a Bulova movement engraved with "Bulova" only inside the watch's case. The fact that the mark is such a minor or difficult-to-detect feature of the customizer's finished work is indication enough that the customizer does not intend to use the mark to sell the product.

Often, however, customized works will retain and prominently display their component part's mark. Recall the Heineken bottle cap earrings and beer bottle turned into a drinking glass. A viewer would have no difficulty identifying the Heineken mark on those upcycled products. A wide swath of sneaker customizations are also likely to share this characteristic. As we saw in the last Section, many of these are expressive works to which the *Rogers* test applies. But not all. Other modifications, like the one in *Prestonettes*, aren't expressive,

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<sup>323</sup> See generally *Prestonettes, Inc. v. Coty*, 264 U.S. 359 (1924).

but simply include the trademarked product as a component of a new product.<sup>324</sup> But even these uses should be protected from a full-scale infringement analysis. These customizations use the underlying product's mark as a mark, but they do so truthfully, to refer to the underlying product's source.<sup>325</sup>

Nominative use should generally protect the use of a brand in these component works. As we explained above, courts have relied on different versions of a nominative use analysis.<sup>326</sup> While some tests are better than others,<sup>327</sup> we believe all will protect a wide array of customizations from infringement claims.

The nominative use analysis should ask, first, whether the component part is “not readily identifiable without the use of the trademark.”<sup>328</sup> An unmarked watch face or band, a Swoosh-less or three-stripe-less sneaker, and a blank bottle cap would easily meet this standard. Second, it asks whether only so much of the mark is used as is reasonably necessary to identify the component part. We venture courts should be able to presume those marks the part's manufacturer elected to emblazon on their goods are “reasonably necessary” to identify the part's source. The brand owner figured as much, and they added them to signal their goods' source; they would be at cross-purposes to argue later that the marks were excessive when a downstream customizer faithfully retained them. Only where the defendant adds additional logos or cuts away much of the product to highlight the logo would there be a problem.<sup>329</sup>

The Ninth Circuit would then complete the analysis by asking whether the customizer suggested they have the trademark holder's sponsorship or endorsement. The Third Circuit would instead focus on whether the customizer accurately states the relationship between themselves and the trademark holder. As with *Rogers's* “explicitly misleading” prong, this question should be able to separate customizations that wrongfully seek to appropriate trademark holders' brand goodwill from those that do not. So, for example, if Kelly's Caps stated,

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<sup>324</sup> It is conceivable that some sneaker customizations involve no creative expression at all—brand owners might argue as much when the customization involves rather sparse changes to the shoe's colorway, for instance.

<sup>325</sup> See *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 810-11 (9th Cir. 2003) (“Where use of the trade dress or mark is grounded in the defendant's desire to refer to the plaintiff's product as a point of reference for defendant's own work, a use is nominative.”).

<sup>326</sup> See *Century 21 Real Est. Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 230-31 (3d Cir. 2005); *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1182 (9th Cir. 2010); see also *Ferrari S.P.A. Esercizio*, 944 F.2d at 1250.

<sup>327</sup> The Third Circuit has it right: nominative use should be a defense even if consumers are confused. The Ninth Circuit's formulation is close to the Third Circuit's but replaces the confusion inquiry and uses somewhat vague language in the third factor. The Second Circuit's “throw together redundant and inconsistent approaches into a single pot” approach seems excessive.

<sup>328</sup> *Walking Mountain Prods.*, 353 F.3d at 810.

<sup>329</sup> See *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 803-04 (9th Cir. 2002) (holding Welles' use of Playboy's trademark to be mostly nominative use but concluding that repeated use of Playboy logo as wallpaper on her website was excessive).

“Bottle cap earrings created in partnership with Heineken,” the customizer should not benefit from the nominative use doctrine’s protection. Before *VIP Products*, if she labeled her product “Heineken bottle caps” followed by the disclaimer, “Earrings created by Kelly’s Caps using bottle caps from discarded Heineken beer bottles,” her use would likely be protected. Following *VIP Products*, a customizer’s references to the underlying product’s mark to identify her customized work would be subject to a likelihood of confusion analysis, though the nominative use defense might still apply. Context may also matter. FedEx doesn’t make furniture out of its (free) mailing boxes. Consumers are unlikely to think the reuse of those boxes in a strikingly different context is endorsed by FedEx; any claim of confusion as to sponsorship or endorsement should accordingly have to be based on a clearer and more explicit statement than would be true in what might seem more like a cobranding relationship.

The nominative use doctrine has an important role to play in protecting aftermarket customizations from the threat of trademark suits. It broadens the coverage afforded by *Rogers* because customizers need not engage in creative expression for their use of consumer goods’ marks to be protected. It is fair for them to retain these marks to truthfully refer to the goods’ original manufacturers. Indeed, that use goes directly to the purpose of trademark law—to allow consumers to associate goods with their sources—and, in that sense, customizers might actually serve trademark holders’ interests. Moreover, it helps secure people’s right to do what they want with the things they purchase. Buy a crate of Spalding basketballs and burn them, paint them, cover them in rhinestones, slash them, and resell them, but be truthful about your relationship with Spalding.

*Customization in the service of confusion.* We close with a note on a class of customizations that presents a different problem we believe is outside the scope of the protective doctrines we put forward. Recall from Part I the line of cases involving luxury watches, where a jeweler alters a lower-end but authentic Cartier watch to closely resemble an existing higher-end model. Car body kits present an analogous fact pattern—as when a customizer alters a Mazda to look like a Ferrari. In these cases, there are two potential theories of liability: first, from the underlying product’s manufacturer, contesting the customizer’s alteration to the good *in itself*; second, from the manufacturer of the *copied* good, asserting the customizer created an imitation of their product, from whatever source materials. A nominative use analysis could apply to the first theory of liability, for example, if the customizer retains the Mazda medallion or nameplate to refer to the Mazda that’s been altered. But the second theory of liability is beyond the scope of both the *Rogers* and nominative use protective doctrines. Whether the finished product is an imitation of an existing trademark-protected good is properly subject to a standard trademark infringement analysis. The problem isn’t the use of the original logo per se, but the fact that the product has been modified in conjunction with the logo to suggest that it is something it isn’t.

That doesn’t mean there will necessarily be liability. A watch modified to mislead consumers is doubtless confusing, but a Ferrari kit car may not be.

Certainly, the buyers themselves won't be confused.<sup>330</sup> But those issues turn on application of the normal rules of consumer confusion; the aftermarket customization doesn't warrant any special defense.

Where does that leave us? We propose the following approach:

- If the customization adds physical or aesthetic elements to the branded good, the branded good should be considered a “component part” of the customization’s “new configuration,” and courts should then ask whether the finished, customized work prominently displays the component part’s trademark.
- If the customization’s “new configuration” does not prominently display the component part’s trademark, its use of the mark should be outside the scope of trademark law.
- If the customization’s “new configuration” prominently displays the component part’s trademark, courts should then apply a nominative use analysis. If the use satisfies the nominative use analysis, it should be protected as free expression. If the use fails to satisfy the nominative use analysis, it should be considered trademark infringement.
- If the customization uses only a branded good’s label or mark and not the good itself, the branded good should not be considered a “component part” of the customization’s “new configuration,” and the customization should be subject to a trademark infringement analysis.

#### D. *First Sale and Modified Products*

Finally, we note one piece of the puzzle that has played surprisingly little role in our analysis: the first sale doctrine. It might seem that the central fact about aftermarket customization is that it is indeed aftermarket—that the products in question are all genuine branded goods that have been changed one at a time. The strong policy across all IP regimes in favor of the free movement of goods<sup>331</sup> would seem to counsel against allowing trademark owners to control the use or resale of their products after they have made the initial sale.

In fact, however, the first sale doctrine as currently constituted does little to protect aftermarket customization. The reason is that trademark law does not apply the doctrine if the product is “materially different.”<sup>332</sup> Courts like *Davidoff* have interpreted that material differences test to extend not only to differences

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<sup>330</sup> Most kit car cases have turned on post-sale confusion. *See supra* notes 130-31 and accompanying text.

<sup>331</sup> *See* *Impression Prods., Inc. v. Lexmark Int’l, Inc.*, 137 S. Ct. 1523, 1528 (2017) (noting, in patent context, notion “that overseas buyers expect to be able to use and resell items freely”); *Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519, 539 (2013) (noting, in copyright dispute, that “American law . . . has generally thought that competition, including freedom to resell, can work to the advantage of the consumer”).

<sup>332</sup> *Davidoff & Cie, S.A. v. PLD Int’l Corp.*, 263 F.3d 1297, 1302 (11th Cir. 2001).

in what is being sold but also to even seemingly minor changes in the external appearance of the packaging. In *Davidoff*, that was scratching product codes off the bottom of a perfume bottle, presumably to make it harder for the plaintiff to track who was reselling the perfume.<sup>333</sup> If even a minor change like that is a material alteration, painted sneakers or kit cars will not be able to take advantage of the first sale doctrine.

We think that is not the right rule, however. The “material difference” limitation to the first sale doctrine is designed to serve the purpose of trademark law by ensuring that consumers get what they think they are getting. If American Coke has different ingredients than Mexican Coke,<sup>334</sup> it will taste different, and people who buy one thinking that it is the other will be confused. But the same is not necessarily true of changes to the external appearance of the product. No one thinks that the Davidoff perfume is any different because it doesn’t have a batch code on the bottom—and indeed it isn’t. Nor are Nike shoes any different as shoes because they have a pigeon on the outside. True, people surely value the appearance of products, but the changes to the appearance are evident on the face of the product. Customers can see what they are getting. We believe the “material difference” limitation on first sale should apply to substantial changes to the physical attributes of the product itself, but not to changes to the expressive characteristics of that product. Doing so would allow the first sale doctrine to protect expressive customizations that do not mislead consumers as to what the product is. But it wouldn’t extend to changes that misrepresent the product, such as altering a Cartier watch to look like a more expensive one or putting a Bulova watch movement into a non-Bulova watch.

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There are many issues with customization. We offer a chart to summarize how the law should treat different aftermarket issues.

**Table 1.** Trademark Claims Against and Defenses of Third-Party Customizations.

Evaluative Criteria for Trademark Claims Against Third-Party Customizations of Branded Goods		
1. Is the customization commercial?		
<i>Not commercial if:</i>	It is a personal use later resold	Outside trademark’s scope
	It is unquestionably art	Outside trademark’s scope

<sup>333</sup> *Id.* at 1304.

<sup>334</sup> It does. Chloë Nannestad, *Here’s Why Mexican Coke Tastes Better Than American Coke*, READER’S DIG. (May 16, 2022), <https://www.rd.com/article/mexican-coke/> [<https://perma.cc/65DQ-BQHU>] (“American Coke is made with high-fructose corn syrup, while Mexican Coke is made with cane sugar.”).

<b>Evaluative Criteria for Trademark Claims Against Third-Party Customizations of Branded Goods</b>		
<i>Commercial if:</i>	Customization is part of the defendant's business	Go to question (2)
<b>2(a). Is the customization an expressive work?</b>		
<i>Expressive if:</i>	It intends to communicate a particularized message that is not commercial speech	<i>Rogers test</i>
		If the customization satisfies <i>Rogers</i> , protected as free expression*
		If the mark is "artistically relevant" to the customization, but defendant explicitly misleads as to customization's source, infringement analysis
		Go to question (2b)
<i>Not expressive if:</i>	It does not intend to communicate a particularized message	Go to question (3a)
	Its message is purely commercial speech	Infringement analysis
<b>2(b). Does the customizer use the mark to identify the source of the customization?</b>		
<i>Trademark use if:</i>	Customizer makes additional uses of branded good's mark(s) as their own mark (i.e., in the customization's title or on added hang tag)	Additional uses of mark are subject to infringement analysis
<i>Non-trademark use if:</i>	Customizer does not make additional uses of branded good's mark(s) as their own mark	If the mark is not "artistically relevant" to the customization, go to question (3a)
<b>3(a). Does the customization use the branded good as a "component part" of a "new configuration"?</b>		
<i>Component part if:</i>	Customization adds physical or aesthetic elements to the branded good	Go to question (3b)
<i>Not component part if:</i>	Customization uses only good's label/mark and not the good itself	Infringement analysis

Evaluative Criteria for Trademark Claims Against Third-Party Customizations of Branded Goods		
<b>3(b). Does the finished, customized work prominently display the component part's trademark?</b>		
No	Component part's mark is small, obscured, interior, or otherwise not prominent on the customization	Outside trademark's scope
Yes	Component part's mark is external and large or otherwise a focal point of the customization	Nominative use analysis
		If use of the mark satisfies nominative use analysis, protected as free expression*
		If use of the mark fails to satisfy nominative use analysis, trademark infringement, subject to the first sale doctrine
*If the final, customized good is indistinguishable from a different, existing trademark-protected good, whoever owns the mark associated with that existing good may separately have a claim for infringement		

#### E. *Broader Lessons*

While aftermarket customization is interesting in its own right, it also offers us some broader lessons for trademark law. The reach of trademark law has expanded tremendously in the last fifty years, and so has the cultural power and significance of brands.<sup>335</sup> With that growth, it becomes harder and harder to tell whether any product or communication that includes a brand is made by the trademark owner, with its permission, or by an unrelated third party. Indeed, brands themselves blur this line, encouraging some forms of aftermarket customization and even launching what appear to be guerilla hacks of their products that are, in fact, authorized.

In this environment, trademark law's customary focus on confusion begins to break down. There may be no way for a consumer to tell that the Chunky Dunky shoe is an authorized cobranding collaboration between two companies while the McPlayStation 5 controller is an unauthorized effort by one company to promote its brand using another and the Air Force Prime shoes are an art project sponsored by neither Nike nor Amazon. Similarly, there is no way to know whether a character in a television show drinking a can of Coke or using Google is doing so as part of a paid product placement or not.

<sup>335</sup> See, e.g., Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1687-88 (1999) (describing expansion of trademark law in last fifty years); Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 371 (1999) (noting "substantial and ongoing expansion of trademark protection" since mid-1950s).



An exclusive focus on consumer confusion in this environment risks giving trademark owners plenary control over comment, criticism, art, and even personal uses of marks. Trademark law can and should resist giving in to this impulse. As one of us has argued elsewhere, trademark courts must not act solely as norm followers, doing what consumer surveys tell them.<sup>336</sup> Sometimes they have to act as norm entrepreneurs, setting limits on the expansion of trademark law. Doing so will protect other values, such as promoting art, criticism, and dialog on matters of social concern. But it will also help consumers think for themselves, preventing them from falling automatically into the easy assumption that everything they see with a brand must come from the brand owner. And it will hew to the true goals of trademark law, which are rooted in ensuring that we have a robust and well-functioning marketplace.<sup>337</sup> Preventing fraud and consumer confusion can serve that goal, and that has been trademark law's primary purpose. But ensuring that customizers, resellers, artists, and consumers can participate in that marketplace also serves that goal. The limits we place on trademark law are just as important as the rights it grants in building a social and economic ecosystem around brands.<sup>338</sup>

#### CONCLUSION

Nike, understandably, doesn't want Lil Nas X to sell Satan Shoes with Nike logos on them. But when those shoes are genuine Nike shoes modified to make an expressive or artistic point, trademark law should properly say "too bad." Brands today are an essential part of art, politics, and cultural conversation. The ability to customize branded products is an important part of that conversation, and it is one the law should protect.

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<sup>336</sup> See generally Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461 (2005).

<sup>337</sup> See Dogan & Lemley, *Limiting Doctrines*, *supra* note 161, at 1226.

<sup>338</sup> See *id.* at 1250-51.