Published on *The National Law Review* https://natlawreview.com

Just Humor Them in Infringement and Defamation Cases

Article By:

James (Jim) P. Flynn

In a recent article examining international trademark, copyright and related issues, we started with a focus on the place humor holds as a possible defense. To understand the roots of the penchant for humor to act as a bulwark of humanity's way of defending itself, consider this story:

> *Legend has it that shortly after Adam was created, he complained: "O, Lord! you have given the lion fierce teeth and claws, and the elephant formidable tusks; you have given the deer swiftness of legs, and the turtle a protective shell; you have given the birds of flight wings, but you have left me altogether defenseless." And the Lord said unto Adam: "I shall give you an invisible weapon that will serve you and your children better than any weapons of fight or flight, a power that will save you even from yourself. I shall give you the sense of humor."*
>
> [G. Swaminath, "Jokes a Part: In Defense of Humor," 48 *Indian J Psychiatry* 177–180 (2006)]

I thought of that story, and the unique power humor has, literally and legally, to disarm many who might otherwise complain over any number of legal issues and perceived slights.

We were reminded of this just recently in the case of *Roy Moore v. Sasha Baron Cohen*, where the United States Court of Appeals for the Second Circuit affirmed dismissal of a defamation action arising out of a mock comedic interview. Mo[ø]re on that case later (pun perhaps intended). So here we will look at the US law aspects of such issues.

Whether one looks at the pointed jabs of focused jests, the more extended, developed humor of satire and parody or the jokes in between, humor has long been legally recognized as a defense, or at least relevant factor of sorts here in the United States in both defamation and infringement cases. It has also been recognized as important for socio-political reasons as well:

> "Humor is necessary in a democracy for reasons other than serving as a device for spreading truth and attacking fools and knaves. In a free society, every few years, the populace engages in a wrenching struggle for power. Humor lets us take the issues seriously without taking ourselves too seriously. If we are able to laugh at ourselves as we lunge for the jugular, the process loses some of its malice."

[Gutterman, "New York Times Co. v. Sullivan: No Joking Matter-50 Years Of Protecting Humor, Satire And Jokers," 12 *First Amendment Law Review* 497 (2014) (quoting Gerald C. Gardner, The Mocking Of The President 12 (Wayne State University Press 1988).]

Though I have previously written at least once, twice, thrice or more about parody and satire, I had not previously focused the analysis on the importance of the jokes or jests themselves.
The *Moore* case sort of forces one to do that, just as *Hustler v. Falwell* did years ago. And recent matters, like *Jack Daniel Inc. v. VIP Products LLC* on the trademark side (of which the plaintiff is now seeking certiorari from the Supreme Court), and *Sketchworks Industrial Strength Comedy, Inc., v. James H. Jacobs* on the copyright side. These cases suggest that, if faced with defending another's claims of one's words, works or marks, understanding the meaning of saying "just humor them" may be an important lesson.

So, let's dive in to the *Moore* case. Here, simply, is what happened in *Moore*:

[Sasha] Baron Cohen created, co-produced, and co-wrote *Who Is America?*, a television program that aired on Showtime. As part of the show, Baron Cohen and his team convinced Roy Moore ("Judge Moore"), a former Chief Justice of the Supreme Court of Alabama and a former Senate candidate from Alabama, to fly to Washington, D.C. to receive a prize in honor of his support for the state of Israel and to be interviewed by an Israeli television program. It was a ruse: He was instead interviewed by Baron Cohen, who presented himself as an Israeli anti-terrorism expert and former intelligence agent. The episode of the program in which the interview aired led into the interview with news clips reporting allegations from the time of Judge Moore's Senate campaign that he had engaged in sexual misconduct as an adult, including with one woman who was fourteen at the time. During the interview itself, Baron Cohen, in character, described a fictional device that the Israeli military had purportedly developed to detect underground tunnels, which would also "identify other abnormalities," including "sex offenders and particularly pedophiles," by picking up on a certain "enzyme" that they secrete at "three times the level of non-perverts." App'x 97-98. Baron Cohen then produced a wand-like object that was supposed to be that device and waved it over Judge Moore, at which point it beeped. After a tense exchange between the two, Judge Moore exited the set, amid protestations by Baron Cohen that he was not saying that Judge Moore was a pedophile.

[More Affirmance Order at page 3 (line 1) through page 4 (line 11)]

Based on those facts, Judge Moore sued. The legal question presented by the defamation claims included whether a reasonable viewer would understand the program as making factual claims:

The determinative issue is thus whether the segment could "reasonably have been interpreted as stating actual facts about" Judge Moore. *Hustler Mag., Inc. v. Falwell*, 485 U.S. 46, 50 (1988); *see also Milkovich v. Lorain J. Co.,* 497 U.S. 1, 17 (1990). We agree with the District Court that the segment at issue was clearly comedy and that no reasonable viewer would conclude otherwise. *See Moore v. Baron Cohen*, 548 F.Supp. 3d 330, 348 (S.D.N.Y.

> 2021). The segment opened by referencing news clips of the allegations that Judge Moore had engaged in sexual misconduct, including with minors, and what followed was an attempt to comment on those allegations through humor. Baron Cohen may have implied (despite his in-character disclaimers of any belief that Judge Moore was a pedophile) that he believed Judge Moore's accusers, but he did not imply the existence of any independent factual basis for that belief besides the obviously farcical pedophile-detecting "device," which no reasonable person could believe to be an actual, functioning piece of technology. "Humor is an important medium of legitimate expression and central to the well-being of individuals, society, and their government. Despite its typical literal 'falsity,' any effort to control it runs severe risks to free expression as dangerous as those addressed to more 'serious' forms of communication." Robert D. Sack, *Sack on Defamation: Libel, Slander, and Related Problems* § 5:5.2, at 5-130 (5th ed. 2017).
>
> [Moore Affirmance Order at 9 (line 17) through 11 (line 2)].

This fairly straight-forward result seems wholly consistent with US First Amendment principles, and perhaps such a defense is simply a constitutional requirement.

But perhaps not—and I say that because humor as a defensive or responsive consideration is not limited to the context of defamation of public figures. Humor is also central to trademark infringement claims through notions of parody, and as part of copyright claims through satire. And, of equal interest, humor impacts in these contexts outside the U.S. constitutional system. Perhaps something more than the United States' Constitution's First Amendment and American notions of jocularity are present here.

It has been accepted that defamation law "isn't supposed to change based on the method of communication" and that "only statements of fact can be libel[, slander or defamation]," according to the authors of *It's Hard To Prove Libel When Everything's A Joke*. But "[j]okes, opinions, and even statements that the author mistakenly believed to be true are protected. So, if your statement is made in a setting that judges and juries think of as a freewheeling circus for insults, gags, and ephemera, it gets tough to prove" defamation claims. *Id*. That is true even though an Irish judge in *Donoghue v. Hayes*, [1831] Hayes, Irish Exchequer, 265, 266, wrote that "if a man in jest conveys a serious imputation, he jests at his peril," quoted in *Dall v. Time, Inc*. (1937).

Humor has also come up as relevant factor outside the defamation context, and specifically within the trademark and copyright context. As one law review put it (at 509), "several jokers have even found themselves in intellectual property battles." Remember here that technically, "[p]arody is not a defense to trademark infringement, but a factor to be considered when analyzing a likelihood of confusion," as a US court noted just a few months ago. Still, it is worth reviewing.

On the trademark side, one US court decision upheld the parodist's right to remain free of infringement and dilution liability, noting that "gentle, and possibly even complimentary" jokes directed at another's mark remain protectible parody. Another US court opinion has also noted that a "trademark parody reminds us that we are free to laugh at the images and associations linked with the mark . . . [or provides] entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark's owner." In fact, the stronger the mark, the bigger the joke and the better defense, as noted in by another court. On the other hand, the joke,

parody or satire needs to be detectable and understood, as one court noted in saying that "[t]he Court is unprepared to conclude that Feyoncé rises to the level of parody, as there is no evidence in the record to suggest that Defendants intended their products to convey a message about or critique of Beyoncé." That same court also held that even a mere pun may create a protected fair use if "the joke is clear enough to result in no confusion under the statutory likelihood of confusion analysis."

Many of these issues on the trademark side could be addressed in the *Jack Daniels* matter, if the US Supreme Court grants cert. According to the cert. petition (at 5), "Respondent VIP Products LLC copied Jack Daniel's marks and trade dress to make a dog toy, 'Bad Spaniels,' that imitates a Jack Daniel's whiskey bottle, while adding poop humor." The district court originally found that VIP's use was likely to confuse as to source or origin, but was overruled by the Ninth Circuit on 1st Amendment grounds. After remand, the district court "begrudingly" ruled in favor of VIP, while "lamenting that the Ninth Circuit's test 'excuses nearly any use less than slapping another's trademark on your own work and calling it your own.'" Cert. Petition at page 5 (quoting Memorandum Opinion, copy at Appendix, page 18a). After the Ninth Circuit summarily affirmed (Appendix at 2a), plaintiff sought Supreme Court review because, in its view:

> The Ninth Circuit's infringement holding unjustifiably transforms humor into a get-out-of-the-Lanham-Act-free card. To be sure, everyone likes a good joke. But VIP's profit-motivated "joke" confuses consumers by taking advantage of Jack Daniel's hard-earned goodwill. The likelihood-of-confusion test already reconciles the competing First Amendment interests of mark holders and infringers; the Ninth Circuit's test unjustifiably protects even intentionally misleading trademark use and elevates the infringer's supposed free-speech interest above the mark holder's.
>
> [Jack Daniels' Cert. Petition, at 5]

For those interested in the well-supported arguments that Jack Daniels makes, read the entre cert. petition, as it provides both descriptive and visual support for is position that the Ninth Circuit's humor exemption for trademark infringement liability may go too far. But, then again, comedy is always about pushing boundaries, so stay tuned because "Response due September 16, 2022," which one imagines will hammer home the notion that, by creating a bottle-shaped doggie chew toy that is not even in the beverage category, VIP is not copying a liquid product's bottle trade dress at all.

There are, likewise, US copyright analogs focused on jokes and humor as central to avoiding infringement liability. For instance, in the *Sketchworks* case decided May 12, 2022, a federal district court in New York granted plaintiff judgment on the pleadings, holding that the new play *Vape* was non-infringing parody of *Grease* and that "parody has an obvious claim to transformative value" because, "'[l]ike less ostensibly humorous forms of criticism, it can provide social benefit, by shedding light on an earlier work, and, in the process, creating a new one.'" (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)). Still, one wonders whether the record Jack Daniels made as to trademarks will be similarly made by those seeking greater protection for pre-existing works in the copyright context as well.

At times, the strength of a joke as defense under US law has come down to whether the work at issue was a parody "of" the preceding work or whether a previous work became a way to parody

some other work, in others words to do a parody “with” that work. The “of”/”with” distinction is one that has complicated US law, as I have noted previously more than once. And it has also been detailed nicely by Lisa Hein as she has looked at *Dr. Seuss Enterprises v. Penguin Books USA, Inc*. (where the court considered whether the producers of *The Cat NOT in the Hat! A Parody by Dr. Juice*) and *Suntrust v. Houghton Mifflin Co.* (concerning the novel *The Wind Done Gone*, which “’reimagines the story of *Gone with the Wind* by telling it from the perspective of Scarlett O’Hara’s black halfsister”). As Hein noted (at 8-9), her takeways from the divergent decisions (*Seuss* finding infringement rather than parody and *Suntrust* finding protectible parody), are that the “different results of the *Dr. Seuss* and *Suntrust* cases …show how subjective a decision regarding parody and fair use privilege can be.” Some, like Hein, attribute those distinctions to differences in judicial taste or judges’ drawing lines too finely between parody and satire.

This notion of subjectivity in legal analysis of what is fair use remains with us, as seen in the Second Circuit’s decision in *Andy Warhol Foundation v. Goldsmith*, 11 F. 4th 26, 41-42 (2d Cir. 2021)(“the district judge should not assume the role of art critic and seek to ascertain the intent behind or meaning of the works at issue. That is so both because judges are typically unsuited to make aesthetic judgments and because such perceptions are inherently subjective”). That decision is being taken up by the Supreme Court this fall now that cert. has been granted (matter 21-869). Though *Warhol* is not about humor or parody *per se*, its analysis could well impact how these related issues are addressed in the future here in the United States and elsewhere.

Clearly the above discussion suggests that the humor of a statement, mark or work of authorship deserves consideration as part of a good defense to defamation or infringement. Yet, as true as that may be, that “real judges and lawyers are not comedians,” and “legal players in the courtroom are rarely funny,” I have devoted many a post here to the proposition that “the lawsuits that make their way into the formal legal process can be [funny],” and fun, as noted in The New Yorker. While many contexts and countries have been noted above, this little survey falls short of proving that “humor is a universal language,” or that, as we started this post, it is a god-given attribute common to humanity. (But I did learn that the phrase “laughter is the best medicine” itself has biblical roots, and have now passed that along).

Thus, as much as I’d like to claim that this article has given you a fool-proof system for understanding how to mount a humor (if not humorous) defense, I cannot make that claim. As Patry noted (in his section on parody under US law at 328-33) “[t]he fact that parody can claim legitimacy for some appropriation does not, of course, tell either parodist or judge much about where to draw the line.” Hopefully this post gets them a little closer to putting it in the right place….and, if it doesn’t, just keep practicing on your own as best you can and humor me.

National Law Review, Volume XII, Number 266