

No. 22-148

In the Supreme Court of the United States

JACK DANIEL'S PROPERTIES, INC.,
PETITIONER,

v.

VIP PRODUCTS LLC,
RESPONDENT.

*ON A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT*

BRIEF FOR PETITIONER

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QUESTIONS PRESENTED

Respondent VIP Products LLC markets and sells dog toys that trade on the brand recognition of famous companies such as petitioner Jack Daniel's Properties, Inc. The district court found that VIP's use of Jack Daniel's trademarks to sell poop-themed dog toys was likely to confuse consumers, infringed Jack Daniel's marks, and tarnished Jack Daniel's reputation. The Ninth Circuit, however, held that VIP's First Amendment interest in using Jack Daniel's trademarks as its own marks on funny dog toys conferred special protection from infringement claims and rendered VIP's commercial dog toys "noncommercial" and thus exempt from dilution-by-tarnishment claims. The questions presented are:

1. Whether humorous use of another's trademark as one's own on a commercial product is subject to the Lanham Act's traditional likelihood-of-confusion analysis, or instead receives heightened First Amendment protection from trademark-infringement claims.

2. Whether humorous use of another's mark as one's own on a commercial product is "noncommercial" under 15 U.S.C. § 1125(c)(3)(C), thus barring as a matter of law a claim of dilution by tarnishment under the Trademark Dilution Revision Act.

II

PARTIES TO THE PROCEEDING AND CORPORATE DISCLOSURE STATEMENT

Petitioner is Jack Daniel's Properties, Inc, which is a wholly owned subsidiary of Brown-Forman Corporation, a publicly traded company.

Respondent is VIP Products LLC.

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OPINIONS BELOW

The court of appeals' order summarily affirming the district court's post-remand decision is unreported and available at 2022 WL 1654040 (9th Cir. Mar. 18, 2022). Pet.App.2a. The district court's opinion granting summary judgment to respondent on remand is unreported and available at 2021 WL 5710730 (D. Ariz. Oct. 8, 2021). Pet.App.5a-19a. The court of appeals' opinion affirming in part, reversing in part, and vacating in part the district court's earlier judgment in favor of petitioner is reported at 953 F.3d 1170 (9th Cir. 2020). Pet.App.22a-34a. The district court's findings of fact and conclusions of law are reported at 291 F. Supp. 3d 891 (D. Ariz. 2018). Pet.App.45a-76a. The district court's opinion denying respondent's motion for summary judgment and granting

petitioner's motion for partial summary judgment is unreported and available at 2016 WL 5408313 (D. Ariz. Sept. 27, 2016). Pet.App.77a-124a.

JURISDICTION

The court of appeals' judgment was entered on March 18, 2022. The court of appeals denied a timely petition for rehearing en banc on May 10, 2022. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

The relevant provisions of Lanham Act sections 32-36, 43, and 45, 15 U.S.C. §§ 1114-18, 1125, 1127, are reproduced, *infra*, Stat.App.1a-25a.

STATEMENT

Petitioner Jack Daniel's Properties, Inc., its predecessors, and/or its affiliates have been selling Jack Daniel's famous Tennessee Whiskey for more than a century. Respondent VIP Products LLC sells all manner of dog toys, including ones shaped like poop. One of VIP's dog toys, "Bad Spaniels," is a near replica of a Jack Daniel's whiskey bottle that imitates Jack Daniel's trademarks and trade dress, while adding dog-poop humor:



Jack Daniel's loves dogs and appreciates a good joke as much as anyone. But Jack Daniel's likes its customers even more, and doesn't want them confused or associating its fine whiskey with dog poop. Jack Daniel's also welcomes jokes at its expense. But VIP does not just make jokes about Jack Daniel's. VIP sells products mimicking Jack Daniel's iconic marks and trade dress that mislead consumers, profit from Jack Daniel's hard-earned goodwill, and associate Jack Daniel's whiskey with excrement. In other words, poop humor has its time and place, particularly for toddlers and young children. But Jack Daniel's does not want its customers looking at their whiskey bottles and wondering why in the world *Jack Daniel's* is talking about dogs defecating on Tennessee carpets.

Jack Daniel's accordingly sought to enjoin VIP's sale of Bad Spaniels under the Lanham Act, claiming that the toy likely confused consumers and thus infringed Jack Daniel's marks and trade dress, 15 U.S.C. §§ 1114(1), 1125(a), and diluted Jack Daniel's famous marks by associating them with dog poop and with products that appeal to children, *id.* § 1125(c)(1). After a four-day bench trial, the district court agreed.

But the Ninth Circuit reversed. Applying the Second Circuit's decision in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), the Ninth Circuit held that VIP's "humorous" dog toy was an "expressive work" warranting heightened First Amendment protection from infringement liability. Pet.App.31a. The Ninth Circuit further held that VIP's use of Jack Daniel's marks to sell its dog toy was "non-commercial" and thus immune from dilution liability because the toy was "humorous." Pet.App.33a-34a.

Under those rulings, anyone could use a famous mark to sell sex toys, drinking games, or marijuana bongs, while misleading customers and destroying billions of dollars in goodwill—all in the name of just having fun. Humor does not transform the Lanham Act into a trademark free-for-all. The decision below, and the *Rogers* decision from which it flows, are egregiously wrong.

With respect to infringement, the Lanham Act prohibits using a trademark in a way "likely to cause confusion ... as to the origin, sponsorship, or approval of ... goods." 15 U.S.C. § 1125(a)(1)(A); *id.* § 1114(1). That flexible test already accounts for a defendant's use of humor: in many cases where a defendant pokes fun at a brand, consumers will get the joke and be amused, not confused. But the Act's text does not permit courts to impose heightened requirements on mark owners in cases involving "humorous" or "expressive" infringement. Nor

does the First Amendment justify the judge-made requirements imposed below; the First Amendment does not protect trademark uses that are likely to confuse.

The decision below also makes a complete mess of the dilution statute. That statute excludes from liability “non-commercial use” of a famous mark. 15 U.S.C. § 1125(c)(3)(C). Under the plain text, “noncommercial use” does not include using a mark to *sell* products. Further, the statute separately excludes from liability fair uses of famous marks including “parody[],” but only when the use is “other than as a designation of source.” *Id.* § 1125(c)(3)(A). The Ninth Circuit’s holding that any “humorous” use of a mark is “noncommercial” renders the fair-use exclusion for parodies superfluous and nullifies its limitation to uses “other than as a designation of source.” The ruling also renders the statute powerless in textbook cases of dilution where defendants humorously use marks to sell raunchy products.

If the Bad Spaniels dog toy is an “expressive work” that receives special First Amendment protection from infringement liability, and VIP’s use of Jack Daniel’s marks and trade dress to sell dog toys is “noncommercial,” the Lanham Act is virtually useless. This Court should reverse.

A. Statutory Framework

This case involves two types of trademark claims: infringement and dilution.

1. *Infringement*

The Lanham Act prohibits the use of words or symbols likely to mislead consumers about a product’s source. 15 U.S.C. § 1114(1) provides a cause of action for infringement of registered marks, while section 1125(a) provides a parallel cause of action for infringement of unregistered marks (unfair competition). 15 U.S.C. §§ 1114(1)(a),

1125(a). Both require that the defendant’s use be “likely to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1114(1)(a); *see also id.* § 1125(a) (“likely to cause confusion, or to cause mistake, or to deceive ... as to the origin, sponsorship, or approval”).

To prevent violations of either section, courts may grant injunctions “according to the principles of equity and upon such terms as the court may deem reasonable.” *Id.* § 1116(a). Prevailing parties under either section also are “entitled ... subject to the principles of equity, to recover (1) defendant’s profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action.” *Id.* § 1117(a); *see Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S. Ct. 1492, 1494-95 (2020). Attorney’s fees are available to the prevailing party “in exceptional cases.” *Id.* § 1117(a). Courts also may order that infringing products and related materials (such as advertisements) be “delivered up and destroyed.” *Id.* § 1118.

The Act provides additional remedies for cases involving “counterfeit” marks, defined as “a spurious mark which is identical with, or substantially indistinguishable from, a registered mark.” *Id.* § 1127; *see id.* § 1117(b)(1). For claims brought under section 1114(1)(a) involving counterfeit marks, courts may, “upon ex parte application, grant an order ... providing for the seizure of goods and counterfeit marks.” *Id.* § 1116(d)(1)(A). Mark owners prevailing under section 1114(1)(a) are entitled to treble damages or profits, whichever is greater, and fees for intentional violations “unless the court finds extenuating circumstances.” *Id.* § 1117(b). In cases involving counterfeits, mark owners may elect statutory rather than actual damages or disgorgement of profits. *Id.* § 1117(c).

2. *Dilution*

The Federal Trademark Dilution Act of 1995 (FTDA) amended the Lanham Act to provide trademark owners with a cause of action for dilution. Pub. L. No. 104-98, § 3(a), 109 Stat. 985 (1995). The essence of a dilution claim is to preserve the value or “selling power” of famous marks. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003). States previously had protected against dilution by prohibiting uses likely to cause “injury to business reputation” (dilution by “tarnishment”) or “dilution of the distinctive quality of a trade name or trademark” (dilution by “blurring”). *Id.* at 430, 432; see 4 McCarthy on Trademarks and Unfair Competition § 24:67 (5th ed. 2017) (McCarthy).

The FTDA established federal antidilution protection, providing owners of “famous” marks a cause of action against another’s “commercial use in commerce of a mark or trade name [that] causes dilution of the distinctive quality of the mark.” 15 U.S.C. § 1125(c) (1996) (amended 2006). The statute instructed courts to determine whether marks are famous by considering a nonexhaustive list of factors. *Id.* § 1125(c)(1) (1996) (amended 2006).

The FTDA also provided that the following were “not actionable”:

- (A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.
- (B) Noncommercial use of a mark.
- (C) All forms of news reporting and news commentary.

Id. § 1125(c)(4) (1996) (amended 2006).

In *Moseley*, this Court interpreted “causes dilution” to require proof of actual dilution. 537 U.S. at 432-34. Congress subsequently passed the Trademark Dilution Revision Act (TDRA), Pub. L. No. 109-312, 120 Stat. 1730 (2006) (codified at 15 U.S.C. § 1125(c)), which amended the dilution statute in several ways. First, the TDRA extended the statute to uses “likely to cause dilution.” 15 U.S.C. § 1125(c)(1). Second, the TDRA clarified that dilution encompasses both “blurring” and “tarnishment.” *Id.* Dilution by blurring is any association that “impairs the distinctiveness of the famous mark,” while dilution by tarnishment is any association “that harms the reputation of the famous mark.” *Id.* § 1125(c)(2)(B), (C).

Third, Congress expanded the fair-use exclusion to cover other non-exhaustive uses, like parody, as long as the defendant does not use the famous mark to designate the source of its own product:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with—

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

Id. § 1125(c)(3).

Finally, Congress defined a “famous” mark as one “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner,” and instructed courts to

consider “all relevant factors” in making that determination. *Id.* § 1125(c)(2)(A).

Successful dilution plaintiffs are entitled to an injunction “[s]ubject to the principles of equity.” *Id.* §§ 1125(c)(1), 1116(a). If the dilution was willful, successful plaintiffs also are entitled to damages, defendant’s profits, costs, and an order for the destruction of violating materials, “subject to the principles of equity.” *Id.* §§ 1117(a), 1118, 1125(c)(5).

B. Factual Background

1. Jasper (Jack) Newton Daniel, Jack Daniel’s namesake, was born in a Tennessee farmhouse around 1850. J.A.197-98; Peter Krass, *Blood & Whiskey: The Life and Times of Jack Daniel* 7 (2004) (Krass). After losing his mother, Jack set out on his own until a lay preacher and distiller, Dan Call, took him in. Krass at 36-37.

Under the tutelage of Call’s head distiller Nathan (Nearest) Green, Jack learned the process for making his now-famous “Tennessee Whiskey”: filtering the whiskey through maple charcoal before transferring it to charred-oak barrels to age. This filtration, when combined with Tennessee’s limestone-filtered spring water, produces the signature smoothness of Tennessee Whiskey. *Id.* at 51, 54-55. Jack Daniel’s still makes whiskey using the same methods and ingredients as in 1875. J.A.198, 204.

Jack established his distillery in 1866. J.A.196, 197. According to a biographer, tax authorities assigned Jack’s distillery the number seven. Krass at 118.

Meanwhile, American consumers increasingly relied on brands to distinguish among goods. During this period, some of the country’s most iconic brands were founded: “Campbell’s Soup” (1869); “Levi Strauss’s Overalls” (1873); “Quaker Oats” (1878); and “Coca-Cola”

(1886). Krass at 115; Joe Cleveland, *Fritz Garland Lanham: Father of American Trademark Protection* 12 (2021) (Cleveland).

In 1875, Jack began selling his whiskey under the brand “Jack Daniel’s” (#1,923,981¹). It is unclear where “Old No. 7” came from, but one account is that Jack worried consumers would not recognize his product; in addition to the new name, the distillery’s registration number had changed during a controversial tax overhaul. Krass at 116-18. By naming his whiskey “Old No. 7,” Jack gave consumers a way to identify his product, while simultaneously vocalizing his opposition to government overreach. *Id.* at 118. In 1904, the company registered its “Old No. 7” trademark with the U.S. Patent and Trademark Office (PTO) (#42,663), making it one of the oldest active trademarks in the United States. *See* Cleveland at 8.

Around the turn of the century, distillers began selling whiskey in bottles rather than barrels. Jack selected a square bottle. Krass at 172-73; Dkt. 230-14.² That shape, he thought, would express that he was a “square dealer.” Krass at 173.

Jack Daniel’s trade dress still revolves around its distinctive square bottle. J.A.199-200. The label is adorned with twirling white lines called filigree. J.A.199-200. The label’s styling contrasts the blackest black against white lettering, with an arched “Jack Daniel’s” logo. J.A.199-200. Beneath the arch is the round insignia bearing “Old No. 7,” called the “cartouche.” In stylized font, the bottle

¹ Unless otherwise noted, these numbers refer to the trademark registration number assigned by the PTO. *See* <https://bit.ly/3GSSUm>; <https://bit.ly/3XOrqad>.

² Unless otherwise noted, docket numbers refer to the district court.

says, “Tennessee Sour Mash Whiskey.” J.A.199-200. Shrink wrap around the neck bears “Old No. 7.” J.A.200.

Jack Daniel’s has registered trademarks in its square bottle (#4,106,178), JACK DANIEL’S (#1,923,981), OLD NO. 7 (#42,663), the arched logo (#582,789), and the stylized label and filigree (#2,789,278). These trademarks and trade dress are integral to the brand’s integrity and value. J.A.253-254. They convey Jack Daniel’s brand values, which include authenticity and independence. J.A.202-203.

Jack Daniel’s (through its affiliates) invests heavily in its brand, spending many millions per year on advertising. J.A.203. In the last 25 years, hundreds of millions of dollars have been spent promoting the brand in the United States. *See* Pet.App.52a, 107a. Jack Daniel’s marketing communicates the brand’s history and tradition, and nearly all its advertising features the iconic label. J.A.201-202.

Jack Daniel’s is the world’s largest American whiskey brand and appeals to whiskey drinkers of all kinds, from bikers to bankers. J.A.196-197, 203. One study showed that, when asked about Jack Daniel’s, 98% of consumers expressed awareness of the brand. Pet.App.53a. Another survey ranked Jack Daniel’s 82nd on a list of the top 100 most valuable brands globally. J.A.196-197. Today, Jack Daniel’s is the most valuable spirit brand in the world.³

³ Alice Brooker, *Jack Daniel’s Named Most Valuable Spirit Brand*, *The Spirit Business* (Oct. 22, 2021), <https://bit.ly/3QxOQBr>; Interbrand, *Best Global Brands*, <https://bit.ly/3QKRCnf>.

Jack Daniel's features in countless movies,⁴ television shows,⁵ and celebrity photos.⁶ One of the brand's most notable early "friends" was Frank Sinatra, who called it "the nectar of the Gods" and was famously buried with a bottle. J.A.204.⁷

Through its affiliates and licensees, Jack Daniel's also markets specialty whiskeys and licenses Jack Daniel's-branded merchandise, such as apparel. *See, e.g.*, J.A.103; Dkt. 231-1; 231-3. Jack Daniel's has licensed various dog products, including leashes, collars, a dog-treat jar, and a doghouse. J.A.219; Dkt. 230-11.

2. VIP is the country's second-largest dog toy company. Dkt. 208 at 30. It enjoys gross revenues approaching \$15 million annually, and its catalog exceeds 500 products. J.A.150-92; Dkt. 243 at 179. Its products are sold in almost 30 countries and at every major pet supplier. Dkt. 236 at 33.

Pet products are a \$100-billion-a-year industry. Bernhard Schroeder, *Entrepreneurs, This \$104 Billion Industry Has Seen 100% Growth Over Last Decade and Shows No Sign of Slowing Down*, *Forbes* (Oct. 29, 2021, 10:34 AM), <https://bit.ly/3G6FA3y>. Many name brands collaborate with manufacturers to sell dog products, such

⁴ *E.g.*, *Raiders of the Lost Ark*, *A Few Good Men*, *The Shining*, *Animal House*, and *Goldeneye*. Dkt. 105-5 (physically filed).

⁵ *E.g.*, *True Blood*, *The Office*, *30 Rock*, and *Criminal Minds*. Dkt. 105-6 (physically filed).

⁶ Dkt. 105-7 (physically filed).

⁷ Frankly Drinking, *How Frank Sinatra Really Met Jack Daniel's*, *GlobalNewswire* (Oct. 9, 2020), <https://bit.ly/3WZwICU>.

as a “Gryffindor Quidditch Jersey” (Harry Potter) or “Scooby Snacks” dog treats (Scooby Doo).⁸

Without obtaining licenses, VIP created a “Silly Squeakers” product line mimicking trademarks of famous beverages. Most feature toilet humor. VIP’s portfolio includes “Smella R-Crotches” (Stella Artois), “Heini Sniff’n” (Heineken), “Pissness” (Guinness), and “Mountain Drool” (Mountain Dew). Pet.App.26a, 47a-48a.⁹ VIP previously offered a Budweiser-mimicking toy called “ButtWiper,” but Budweiser obtained a preliminary injunction preventing its sale. *Anheuser-Busch, Inc. v. VIP Prods., LLC*, 666 F. Supp. 2d 974, 986 (E.D. Mo. 2008).

VIP registered trademarks for Silly Squeakers (#5,447,883) and numerous toys in the line, including Dos Perros (Dos Equis, #6,176,781), Panta (Fanta, #6,466,202), and Doggie Walker (Johnnie Walker, #6,213,816). VIP regularly sues other companies for infringing *its* trademarks and trade dress, including the shape of its toys and brand markings.¹⁰

In 2014, VIP began selling its “Bad Spaniels” toy, a virtual replica of the size, shape, and design of Jack Daniel’s bottle and trade dress. Pet.App.49a; J.A.200-201. The toy is whiskey-colored and adorned with a similar black label with white lettering. J.A.200. The neck mimics Jack Daniel’s neck wrap. J.A.200. The words “Bad

⁸ *Collaborations*, BarkShop, <https://bit.ly/3Xi0F1r>.

⁹ Images appear in the petition appendix and are available on VIP’s website, <https://bit.ly/3GVHzZ3>.

¹⁰ See, e.g., *VIP Prods. LLC v. Bradley Caldwell, Inc.*, No. 17-cv-1467 (D. Ariz. May 12, 2017); *VIP Prods. LLC v. R.I. Textile Co.*, No. 15-cv-2061 (D. Ariz. Oct. 15, 2015); *VIP Prods., LLC v. Kong Co.*, No. 10-cv-998 (D. Ariz. May 7, 2010).

Spaniels” appear in arched form. J.A.200. The label includes a slightly modified cartouche, adorned with “Old No. 2” instead of “Old No. 7,” the word “Tennessee” in stylized font, and white lines mimicking filigree. J.A.200. “Jack Daniel’s” became “Bad Spaniels,” with the image of a spaniel, “Old No. 7 Tennessee Sour Mash Whiskey” became “Old No. 2 on your Tennessee Carpet,” and “40% ALC. BY VOL. (80 PROOF)” became “43% POO BY VOL.” and “100% SMELLY.” The back of the product’s hang tag states in tiny script, “This product is not affiliated with Jack Daniel Distillery.” Pet.App.6a.



J.A.112.

At the request of VIP’s owner, Stephen Sacra, the toy’s designer created Bad Spaniels by studying a Jack Daniel’s bottle from her liquor cabinet. She placed “Old

No. 2” in an oval because she “wanted it to be similar to the Jack Daniel’s bottle.” J.A.22. In deposition, Sacra testified that Bad Spaniels was “absolutely not” commenting on Jack Daniel’s whiskey, business, or marketing. J.A.39.

VIP advertised Bad Spaniels in its catalog by depicting the toy sitting on a bar, with a real bottle of Jack Daniel’s in the background. J.A.187, 192. And VIP sold Bad Spaniels to the same class of purchasers and through the same channels as Jack Daniel’s licensed products. Pet.App.73a.

C. Procedural Background

1. When Jack Daniel’s learned of Bad Spaniels, the company promptly requested that VIP stop selling the toy. Pet.App.49a. VIP responded by suing Jack Daniel’s in 2014 in VIP’s home forum, the United States District Court for the District of Arizona, seeking declaratory relief. Pet.App.49a. Jack Daniel’s counterclaimed under state and federal law for trademark infringement and dilution. Pet.App.7a. Jack Daniel’s did not request damages but rather an injunction prohibiting manufacture and distribution of Bad Spaniels; destruction or other disposition of Bad Spaniels and the production molds; and attorney’s fees and costs. Dkt. 12 at 19-21.

On cross-motions for summary judgment, the district court held that Jack Daniel’s trademarks and trade dress were distinctive and nonfunctional. Pet.App.90a-101a. Additionally, the court rejected VIP’s argument that Bad Spaniels was entitled to First Amendment protection. The court explained that “VIP makes trademark use of its adaptation of JDPI’s trademarks and the Jack Daniel’s trade dress to sell a commercial product.” Pet.App.90a. The court reasoned that “the First Amendment affords no protection to VIP because it is trademark law that regulates misleading commercial speech where another’s

trademark is used for source identification in a way likely to cause consumer confusion.” Pet.App.89a.

The court accordingly held that the traditional likelihood-of-confusion factors governed, application of which presented triable issues of fact. Pet.App.89a, 102a.

As to dilution, the district court rejected VIP’s fair-use parody defense under section 1125(c)(3)(A). As the court observed, that provision does not apply when a person uses a famous mark as “a designation of source for the person’s own goods or services.” Pet.App.104a (quoting 15 U.S.C. § 1125(c)(3)(A)). Because VIP used “its Bad Spaniels trademark and trade dress as source identifiers of its dog toy,” the exclusion did not apply. Pet.App.105a. The court then held that Jack Daniel’s raised triable issues of fact on its dilution claims. Pet.App.116a.

Following a four-day bench trial, the district court ruled in Jack Daniel’s favor on its infringement and dilution claims. As to infringement, the court weighed eight non-exclusive factors and found that Bad Spaniels was likely to confuse consumers. Among other things, the court found Jack Daniel’s marks were extremely strong, VIP’s marks were highly similar to Jack Daniel’s marks, and customers were unlikely to exercise significant care when purchasing Bad Spaniels. Pet.App.70a-74a. The court also credited Jack Daniel’s survey expert, who determined that 29% of potential customers were likely to be confused about Jack Daniel’s affiliation with Bad Spaniels—“nearly double the threshold to show infringement” under circuit law. Pet.App.65a-68a.

As to dilution, the court determined that Jack Daniel’s marks were famous, and that VIP’s marks and trade dress were similar because VIP had “appropriated the Jack Daniel’s trade dress in every aspect.” Pet.App.52a-

54a. The court found that Bad Spaniels was likely to tarnish Jack Daniel's trademarks and trade dress by associating Jack Daniel's beverages with canine excrement and products that appeal to children. Pet.App.60a-62a. The court enjoined VIP from manufacturing, advertising, or selling Bad Spaniels. Pet.App.42a.

2. The Ninth Circuit affirmed in part, reversed in part, vacated in part, and remanded. Pet.App.22a-34a. The Ninth Circuit did not disturb the district court's finding that Bad Spaniels was likely to confuse consumers. It nevertheless vacated the judgment on Jack Daniel's infringement claims because it concluded the Bad Spaniels dog toy triggered heightened First Amendment scrutiny under *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Pet.App.30a-33a.

In *Rogers*, musical star Ginger Rogers sued a movie producer over a film called "Ginger and Fred," claiming the title misled consumers into thinking she endorsed the film. The Second Circuit expressed concern that "overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values." 875 F.2d at 998. It then held 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." *Id.* at 999. In the context of "allegedly misleading titles," the court held that the Act would not apply unless the title "ha[d] no artistic relevance to the underlying work whatsoever," or "explicitly misle[d] as to the source or the content of the work." *Id.*

Invoking *Rogers*, the Ninth Circuit held that Bad Spaniels was an "expressive work" merely because it "communicate[d] a humorous message." Pet.App.31a. It then remanded for the district court to apply *Rogers*' heightened two-part test. Pet.App.33a.

The Ninth Circuit reversed as to dilution. Pet.App.33a-34a. The court held that VIP’s use of Jack Daniel’s marks to sell dog toys fell within the noncommercial-use exclusion under 15 U.S.C. § 1125(c)(3)(C). Pet.App.33a. The court reasoned that “[s]peech is non-commercial if it does more than propose a commercial transaction” and “contains some protected expression.” Pet.App.33a (cleaned up). Under that standard, the court held that Bad Spaniels qualified as “noncommercial” because, “[a]lthough VIP used [Jack Daniel’s] trade dress and bottle design to sell Bad Spaniels, they were also used to convey a humorous message.” “That message,” the court added, “is protected by the First Amendment.” Pet.App.33a.

3. On remand, the district court applied *Rogers* and granted summary judgment to VIP on infringement. Pet.App.11a-19a. As to the first question—artistic relevance—the court found VIP’s use of Jack Daniel’s marks “artistically relevant” because VIP altered the marks to “make a joke about a dog defecating on the carpet.” Pet.App.12a. As to the second question, the court found that VIP’s use was not explicitly misleading because it included a “Silly Squeakers” label and a “miniscule disclaimer” on the back. Pet.App.18a. The district court lamented, however, that “it appears nearly impossible for any trademark holder to prevail” under the Ninth Circuit’s test—a standard that “excuses nearly any use less than slapping another’s trademark on your own work and calling it your own.” Pet.App.18a.

4. On Jack Daniel’s motion, the Ninth Circuit summarily affirmed. Pet.App.2a.

SUMMARY OF ARGUMENT

I. The Lanham Act establishes only one standard for infringement: likelihood of confusion as to origin, sponsorship, or approval. The Act does not impose a heightened standard for “humorous” or “expressive” works.

Rogers (on which the Ninth Circuit relied) did not interpret the Act but invented a balancing test to assuage the Second Circuit’s fears about applying the Act to “artistic” or “expressive” works. But *Rogers*’ two-prong test does not align with the Act’s likelihood-of-confusion standard. Both artistically relevant and implicitly misleading uses of trademarks may confuse customers. Courts appropriately account for any “artistic” or “humorous” uses of trademarks using the Act’s likelihood-of-confusion standard, treating the nature of the use as a factor in determining whether customers will likely be confused. Because Jack Daniel’s proved likely confusion at trial, the matter should have ended there.

The First Amendment concerns that animated *Rogers* are misplaced. Constitutional concerns cannot justify rewriting the Lanham Act’s text. And applying the Act’s infringement provisions to “humorous” or “expressive” works does not raise serious constitutional doubts, let alone constitutional violations. The First Amendment does not protect misleading uses of trademarks or uses that infringe on mark owners’ property rights, even if those uses are deemed “expressive.”

In fact, *Rogers* creates, rather than avoids, constitutional issues. *Rogers*’ test privileges infringers’ speech over mark owners’ own expressive speech and allows courts to invent all kinds of speech-based distinctions.

Rogers also undermines the Lanham Act’s twin purposes of protecting consumers and mark owners. *Rogers*

invites consumer confusion because infringers can cast any humorous knock-off (apart from a true counterfeit) as “artistically relevant” and not “explicitly misleading.” And *Rogers* erodes mark owners’ goodwill by allowing others to exploit their marks by using them in ways that undermine mark owners’ own expression.

Even assuming *Rogers*’ legitimacy in a narrow set of cases, its heightened standard should not extend where, as here, a defendant uses a mark *as a trademark* to identify the origin, sponsorship, or approval of its goods. And *Rogers* certainly should not extend to ordinary commercial products like VIP’s dog toy. *Rogers* otherwise would completely swallow the likelihood-of-confusion standard.

II. No reason exists to depart from the plain text of the dilution statute’s noncommercial-use exclusion.

Under its ordinary meaning, the noncommercial-use exclusion does not apply where defendants use famous marks to sell goods or services. The Ninth Circuit, however, read the exclusion to apply whenever use of a mark involves humor or expression. That expansive reading improperly renders the statute’s specific exclusions for news reporting and parody—which necessarily involve expression or humor—superfluous. The Ninth Circuit’s interpretation also would nullify Congress’ decision to limit the fair-use exclusion for parody, criticism, and commentary to uses of a famous mark “other than as a designation of source for the person’s own goods or services.” 15 U.S.C. § 1125(c)(3)(A). In all events, the notion that “noncommercial use” could mean using a famous mark to sell goods *for profit* is fanciful.

Under the Ninth Circuit’s reading, the statute would exclude all parodies, criticism, and commentary, even if someone uses famous marks as a designation of source.

The Ninth Circuit’s reading also leaves the dilution statute toothless in quintessential cases of tarnishment—such as humorous uses related to sex, drugs, or, in this case, poop.

VIP claims the legislative history reveals that when Congress said “noncommercial *use*” it really meant to incorporate this Court’s commercial *speech* doctrine. But Congress did not incorporate the commercial speech doctrine without using the word “speech.”

The First Amendment does not require rewriting the noncommercial-use exclusion. Intellectual property laws are generally constitutional, even as applied to noncommercial speech. That is true in the context of copyrights and the right to publicity. And in *San Francisco Arts & Athletic, Inc. v. U.S. Olympic Committee*, 483 U.S. 522 (1987) (*SFAA*), this Court held that true in the context of a trademark statute containing fewer First Amendment guardrails than the dilution statute here. VIP has no constitutional right to misappropriate Jack Daniel’s marks for VIP’s own trademark use, particularly in ways that tarnish Jack Daniel’s goodwill. The dilution statute here unquestionably passes muster.

ARGUMENT

I. The First Amendment Does Not Require *Rogers*’ Heightened Standard for Infringement under the Lanham Act

The Second Circuit charted a flawed path in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), by rewriting the Lanham Act’s text to privilege the purported First Amendment interests of some speakers over others, contrary to the constitutional balance Congress already struck. The decision below—which extended *Rogers* to ordinary commercial products merely because they are “humorous”—exemplifies those flaws.

A. The Text Forecloses *Rogers*

1. The Lanham Act imposes liability for a person’s use of a mark in commerce that “is likely to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1114(1)(a); *id.* § 1125(a)(1)(a). That text contains no special rules for use of trademarks in “humorous” or otherwise “expressive” works. Much less does the Act hint at *Rogers*’ two-part test, which requires proof that a defendant’s use of a mark “has no artistic relevance” or “explicitly misleads” consumers about a work’s source. 875 F.2d at 999.

The broader statutory context confirms this plain-text reading. Congress exhibited “considerable care” throughout the Act and subsequent trademark statutes to protect certain trademark uses from liability or forms of relief. *See Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S. Ct. 1492, 1495 (2020). For example, Congress limited the relief available against “innocent” publishers or printers of infringing material. 15 U.S.C. § 1114(2)(A)-(C). Congress also excluded from infringement liability certain fair uses of incontestable marks. *Id.* § 1115(b)(4). Where Congress “explicitly enumerates certain exceptions to a general prohibition, additional exceptions are not to be implied, in the absence of a contrary legislative intent,” which is lacking here. *Andrus v. Glover Constr. Co.*, 446 U.S. 608, 616-17 (1980).

The TDRA’s dilution provisions also textually address certain expressive or humorous uses, showing Congress knows how to carve out expressive uses when it wants. The TDRA exempts from dilution liability “news reporting” and “fair use” including “parody[]” when marks are used “other than as a designation of source for the person’s own goods or services.” 15 U.S.C. § 1125(c)(3); *supra* pp.7-9. The absence of any such exclusion in the infringement provisions speaks volumes:

Congress intended “expressive” or “humorous” uses to be subject to the ordinary likelihood-of-confusion standard. *See Russello v. United States*, 464 U.S. 16, 23 (1983).

Congress similarly created special rules for certain kinds of explicitly misleading infringement. Intentional use of counterfeit marks or designations, unlike run-of-the-mill cases of infringement, ordinarily subjects infringers to treble damages. *See* 15 U.S.C. § 1117(b)(1); *supra* p.6. Congress’ imposition of treble damages for certain explicitly misleading forms of infringement reflects an understanding that explicit misrepresentations are not required for liability.

2. *Rogers* did not purport to ground its two-part test in the statutory text. *Rogers* fretted that “overextension of Lanham Act restrictions in the area of titles *might* intrude on First Amendment values.” 875 F.2d at 998 (emphasis added). It thus purported to “construe the Act narrowly to avoid such a conflict.” *Id.* But the Second Circuit did not discuss the Act’s text. Instead, the court applied a balancing test of its own creation, opining that the Act should “apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* at 999. Far from interpreting the Act, *Rogers* described its test as governing the decision whether to “apply” the Act at all. *Id.* at 1000.

VIP asserts that *Rogers* offers an interpretation of the “likely to cause confusion” standard in the context of “expressive” works. Br. in Opp. 23. But neither prong of the *Rogers* test derives from the likelihood-of-confusion standard. “Artistically relevant” uses can still confuse customers, such as when an infringer adorns a knock-off book with trademarks from well-known picture books. *See Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d

443, 462 (9th Cir. 2020) (finding use of Dr. Seuss Enterprises' trademarks artistically relevant, despite "evidence of consumer confusion").

Nor can the phrase "likely to cause confusion" mean only *explicitly* misleading uses. Implicitly misleading uses can confuse customers about the origin, sponsorship, or approval of goods or services. For example, in *Two Pesos, Inc. v. Taco Cabana, Inc.*, a restaurant chain misled consumers by mimicking another chain's trade dress, even though the chain never explicitly told customers the two were associated. 505 U.S. 763, 765-66 (1992). Similarly here, the district court found that VIP's dog toy so closely imitates Jack Daniel's trademarks and trade dress that the toy likely confuses consumers, even though not explicitly misleading. Pet.App.74a.

3. None of this is to say that the "artistic," "expressive," or "humorous" nature of a defendant's use of a trademark is categorically irrelevant to whether the use is likely to confuse. While the nature of the use is "not an affirmative defense" to infringement, it is a "factor" to be considered in determining whether customers are likely to be confused. *Nike, Inc. v. 'Just Did It' Enters.*, 6 F.3d 1225, 1228 (7th Cir. 1993). Thus, without resort to *Rogers*, courts routinely find that humorous uses of trademarks are not infringing because they are unlikely to confuse consumers.

For instance, Tetley, a beverage company, lost its suit against Topps Chewing Gum over the satirical depiction of its retail beverage packaging on Topps' series of "Wacky Packages" stickers. *Tetley, Inc. v. Topps Chewing Gum, Inc.*, 556 F. Supp. 785, 793 (E.D.N.Y. 1983). The court explained that several factors dispelled confusion, including the product's packaging. *Id.* at 790-93. The purchasers did not know what the stickers looked like until

after opening the packet, minimizing the chance of confusion at the point of sale. *Id.* at 790. Other cases abound.¹¹

Since likelihood of confusion is circumstance-specific and turns on *consumer* perception, no two cases will be alike. Thus, in another case involving dog toys, “Chewy Vuiton” dog toys were so different in size, design, and material from Louis Vuitton handbags (unlike in this case) that no consumer would “mistake its source or sponsorship.” *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260, 262 (4th Cir. 2007).

In an analogous setting, *U.S. Patent & Trademark Office v. Booking.com B.V.*, 140 S. Ct. 2298, 2305 (2020), this Court rejected “a nearly *per se* rule” that a term styled “generic.com” is ineligible for trademark registration. The Court reasoned that rigid rules conflict with the Act’s “bedrock principle” that “whether a term is generic depends on its meaning to consumers.” *Id.* at 2306. And the Court dismissed the PTO’s concern for competition by explaining that a mark owner’s use of descriptive language such as “booking.com” is a relevant factor in the likelihood-of-confusion analysis. *Id.* at 2307.

The same is true here. Nothing inherent in the nature of humor automatically prevents confusion. Humorous use of a mark still may confuse consumers about a product’s origin, sponsorship, or approval. *See, e.g., Schieffelin & Co. v. Jack Co. of Boca*, 850 F. Supp. 232, 251 (S.D.N.Y. 1994) (“Dom Popingnon” popcorn confusingly

¹¹ *See, e.g., N.Y. Stock Exch., Inc. v. N.Y., N.Y. Hotel, LLC*, 293 F.3d 550, 555-56 (2d Cir. 2002); *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 420 (S.D.N.Y. 2002); *Universal City Studios, Inc. v. T-Shirt Gallery, Ltd.*, 634 F. Supp. 1468, 1476-79 (S.D.N.Y. 1986); *Gen. Mills, Inc. v. Henry Regnery Co.*, 421 F. Supp. 359, 361 (N.D. Ill. 1976).

similar to “Cuvée Dom Pérignon”); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 398, 401 (8th Cir. 1987) (“Mutant of Omaha” design confusingly similar to Mutual of Omaha’s trademark); *Anheuser-Busch, Inc. v. VIP Prods., LLC*, 666 F. Supp. 2d 974, 986 (E.D. Mo. 2008) (“ButtWiper” dog toy confusingly similar to Budweiser’s bottle label, dress design, and trademark).

The PTO thus refuses registration for misleading humorous uses. *See, e.g., Houghton Mifflin Co.*, 2002 WL 519268, at *7 (T.T.A.B. Apr. 3, 2002) (“FURIOUS GEORGE” film, video, and audio); *Johnson & Johnson v. Pisterine, LLC*, 2022 WL 190986, at *11 (T.T.A.B. Jan. 18, 2022) (“PISSTERINE” mouthwash); *Warner Bros. Ent., Inc. v. Campo*, 2006 WL 2850871, at *8 (T.T.A.B. Sept. 13, 2006) (“HARRY POTHEAD” entertainment service).

Here, applying the Lanham Act’s likelihood-of-confusion standard, the district court weighed eight non-exclusive factors typically used by courts to assess likelihood of confusion:

[T]he strength of the plaintiff’s mark; the proximity or relatedness of the goods; the similarity of the parties’ marks; evidence of actual confusion; marketing channels used; the type of goods and degree of care likely to be exercised by the buyer; the defendant’s intent in adopting the junior mark; and likelihood of expansion of the parties’ product lines.

Pet.App.63a (citing *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979)).¹²

¹² The federal courts of appeals use different but substantially overlapping lists of factors to assess likelihood of confusion. *See* 4

The court found that every relevant factor favored Jack Daniel's. Jack Daniel's marks and trade dress were "extremely strong." Pet.App.71a-72a. The goods were highly similar because (1) Bad Spaniels replicated Jack Daniel's in size, shape, and style "virtually unchanged," (2) Jack Daniel's sells licensed dog products, and (3) Bad Spaniels was sold in the same marketing channels as Jack Daniel's licensed products. Pet.App.54a, 70a, 72a-73a. On this point, the court remarked, "With a single glance ... one is immediately struck by their similarity." Pet.App.54a (citation omitted).

Additionally, "VIP's intent was to capitalize on Jack Daniel's goodwill." Pet.App.69a. The degree of consumer care also favored Jack Daniel's because customers are "not likely to exercise significant care and attention when purchasing 'Bad Spaniels.'" Pet.App.74a.

As to actual consumer confusion, the court credited the opinion of Jack Daniel's survey expert, Dr. Gerald Ford, who determined that 29% of potential purchasers were likely to be confused about whether Jack Daniel's made, authorized, approved, or was affiliated with Bad Spaniels. Pet.App.65a, 67a. Survey respondents explained their confusion, stating of Bad Spaniels: "[I]t looks just like the [Jack Daniel's] bottle," and "[T]he label is based on a Jack Daniel's label." J.A.134, 143. The court emphasized that 29% confusion is "nearly double the threshold to show infringement." Pet.App.68a (citing, *e.g.*, 6 McCarthy § 32:188 n.4). VIP did not present competing survey evidence.

Finding likely confusion, the court ruled for Jack Daniel's on infringement. Pet.App.74a. That factual finding, which is entitled to significant deference on appeal,

McCarthy § 23.19. The PTO uses thirteen similar "*DuPont* factors." *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 144 (2015).

should have ended the inquiry. *See La Quinta Worldwide LLC v. Q.R.T.M., S.A. de C.V.*, 762 F.3d 867, 874 n.2 (9th Cir. 2014) (reviewing finding of likely confusion and application of likelihood-of-confusion factors for clear error).

B. The First Amendment Does Not Justify *Rogers*

Rogers did not hold that application of the likelihood-of-confusion test to “expressive” works would violate the First Amendment; the court expressly reserved that question. *See* 875 F.2d at 1000 n.7 (“We need not consider whether Congress could constitutionally bar the use of all literary titles that are to any extent misleading.”). The court nonetheless based its two-part test on concern that application of the Lanham Act to an expressive work “might intrude” on First Amendment values. *Id.* at 998. But the constitutional-avoidance canon is inapposite both because the statute is not susceptible to *Rogers*’ “interpretation” and because no constitutional issues exist to avoid.

1. The constitutional-avoidance canon applies “only when, after the application of ordinary textual analysis, the statute is found to be susceptible of more than one construction.” *Jennings v. Rodriguez*, 138 S. Ct. 830, 842 (2018) (citation omitted). “In the absence of more than one plausible construction, the canon simply has no application.” *Id.* (internal quotation marks omitted). Because *Rogers* finds no support in the Lanham Act’s text, *supra*, pp.22-28, the constitutional-avoidance canon has no work to do. Were the Lanham Act’s application to “expressive” works truly unconstitutional (it is not), the solution would be for courts to strike the Act when applied to “expressive” works, not to rewrite the statute with a two-part test.

2. The constitutional-avoidance canon also is inapplicable because no serious constitutional question exists. In

its traditional form, the avoidance canon should be used only to avoid actual constitutional *violations*, not mere *doubts*. *Clark v. Martinez*, 543 U.S. 371, 395-96 (2005) (Thomas, J., dissenting); Brett M. Kavanaugh, *Fixing Statutory Interpretation*, 129 Harv. L. Rev. 2118, 2146 (2016). Even in its broadest iteration, the canon applies only if there is “a serious likelihood that the statute will be held unconstitutional.” *Almendarez-Torres v. United States*, 523 U.S. 224, 238 (1998); see Antonin Scalia & Bryan A. Garner, *Reading Law* 250 (2012). Applying the Act’s infringement provisions to “humorous” or “expressive” works does not raise *any* constitutional doubts—much less “serious” doubts or actual violations.

All trademark uses are expressive, by owners and infringers alike. See *infra* pp.32-35. But even assuming one could distinguish between “expressive” and “non-expressive” trademark uses, the First Amendment does not protect *any* misleading trademark infringement even if “expressive.” It is “well settled” that “to the extent a trademark is confusing or misleading the law can protect consumers and trademark owners.” *Matal v. Tam*, 137 S. Ct. 1744, 1768 (2017) (Kennedy, J., concurring). The “normal trademark bounds” of the Lanham Act present no First Amendment problem because “the Government constitutionally may regulate ‘deceptive or misleading’ commercial speech.” *SFAA*, 483 U.S. at 535 n.12 (quoting *Va. State Bd. of Pharm. v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 771 (1976)).

More broadly, the First Amendment does not prevent the government from restricting “[u]ntruthful speech” to “insur[e] that the stream of commercial information flow[s] cleanly as well as freely.” *Va. State Bd. of Pharm.*, 425 U.S. at 772; see also *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 69 (1983). The First Amendment does not protect false statements associated with

“legally cognizable harm.” *United States v. Alvarez*, 567 U.S. 709, 719 (2012) (plurality op.); *id.* at 735-36 (Breyer, J., concurring) (distinguishing Lanham Act from Stolen Valor Act). Trademark infringement inflicts concrete harm—consumer confusion and deterioration of the owner’s goodwill. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995); *Park ‘n Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985).

Indeed, Congress may protect trademarks even *without* a likelihood of confusion. In *SFAA*, the Court held that Congress constitutionally granted the U.S. Olympic Committee a limited property right in the word “Olympic” in the Amateur Sports Act of 1978, which barred use of that word by others in trade, without proof of likely confusion. 483 U.S. at 534-35. A group intending to put on and promote “the Gay Olympic Games” contested the act on First Amendment grounds. *Id.* at 525-26.

The Court rejected the group’s argument that “expressive” uses receive heightened First Amendment protection. *Id.* at 541. The Court explained: “The mere fact that [a defendant] claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to appropriate to itself the harvest of those who have sown.” *Id.* (cleaned up). “Congress’ decision to grant the [Olympic Committee] a limited property right in the word ‘Olympic’ falls within the scope of trademark law protections, and thus certainly within constitutional bounds.” *Id.* at 534-35. It follows that applying the Lanham Act—which provides greater First Amendment protection by requiring likely confusion—to a purportedly “expressive” use is constitutional.

3. The historical origins of this principle are incontrovertible. Courts long have protected trademarks from infringement in cases involving purportedly “expressive” uses. Courts, for example, prevented infringing uses in a

newspaper’s name, *Matsell v. Flanagan*, 2 Abb. Pr. (n.s.) 459, 462-63 (N.Y. Ct. Com. Pl. 1867), a movie title, *Klaw v. Gen. Film Co.*, 154 N.Y.S. 988, 989 (N.Y. Sup. Ct.), *judgment modified*, 156 N.Y.S. 1128 (1st Dep’t 1915), and comic strips, *N.Y. Herald Co. v. Star Co.*, 146 F. 204, 205 (C.C.S.D.N.Y. 1906), among many others, *see, e.g.*, H. Nims, *Law of Unfair Competition and Trade-Marks* §§ 276-280 (2d ed. 1917). Despite enjoining uses in indisputably “expressive works,” none of these courts even mentioned the First Amendment.

Similarly, before *Rogers*, courts applied the Lanham Act in cases involving purportedly “expressive” works, without adopting any heightened First Amendment standard. *See, e.g., Reddy Commc’ns, Inc. v. Env’t Action Found., Inc.*, 1977 WL 23197 (D.D.C. Nov. 11, 1977) (book); *Interbank Card Ass’n v. Simms*, 431 F. Supp. 131, 132-33 (M.D.N.C. 1977) (religious tract); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202 (2d Cir. 1979) (movie). As one leading treatise explained before *Rogers*, when “defendants charged with trademark infringement have claimed the protection of the First Amendment by alleging that they [were] merely using the plaintiff’s mark to convey some important social or commercial message to the public,” this argument was “[a]lmost uniformly” rejected. 2 McCarthy, *Trademarks and Unfair Competition* § 31.37 (2d ed. 1984).¹³

Congress also has passed numerous laws without perceiving any constitutional problem in prohibiting “expressive” uses of marks in ways likely to confuse others. Federal law prohibits using “United States Mint” or “U.S. Mint” or “any colorable imitation” of those words in “any advertisement, circular, book, pamphlet, or other

¹³ The treatise identified no case accepting a First Amendment defense to infringement.

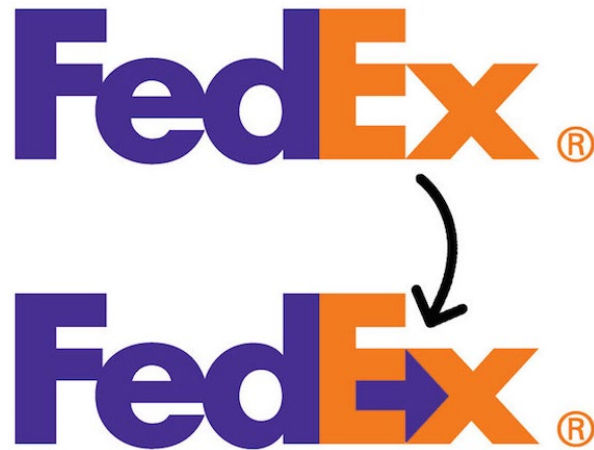
publication, play, motion picture, broadcast, telecast, or other production, in a manner reasonably calculated to convey the impression that [the work] is approved, endorsed, or authorized” by the U.S. Mint. 18 U.S.C. § 709 (emphasis added).

Similar laws prohibit confusing uses of “United States Marine Corps,” “Secret Service,” “Federal Bureau of Investigation,” “Drug Enforcement Administration,” “U.S. Marshals Service,” “Coast Guard,” and other agencies and organizations—which are all registered trademarks on the principal register. *See id.*; 10 U.S.C. § 8921; 14 U.S.C. § 934; *see also generally* 6 McCarthy at Appx. A2 A. *Rogers* would throw all these statutes into doubt.

4. *Rogers*’ test raises more constitutional questions than it answers. Trademarks are themselves expressive and protected by the First Amendment. *Tam*, 137 S. Ct. at 1752; *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299-300 (2019). Names reflect our identities; we use our names to communicate with family, friends, community, employers, and the public. Brands are similar. Trademarks often “consist[] of catchy phrases that convey a message.” *Tam*, 137 S. Ct. at 1752. They express mark owners’ beliefs, values, and ideals.

Some of the most iconic marks express their owners’ values.¹⁴ The hidden arrow between the “e” and “x” in the FedEx mark conveys speed and precision:

¹⁴ 27 *Famous Logos with Hidden Meanings*, <https://bit.ly/3IECt12>.



Amazon's mark conveys that it carries everything from "A" to "Z" with a smile:



Trademarked names likewise express beliefs of non-profit, religious, and political groups. Consider "Catholic Charities USA" (#4,181,985) and the "American Civil Liberties Union" (#1,902,649). For-profit trademark owners use their registered mottos to inspire their audiences to "Think Different" (Apple, #3,803,176) and "Just Do it" (Nike, #5,727,940), assure them "You're in Good Hands" (Allstate, #6,708,546), and warn them that "Democracy Dies in Darkness" (The Washington Post, #6,590,892). And trademarks are how companies communicate information about the quality and source of their

products: “Its Not Just Water. Its Fiji Water.” (Fiji Water Company, #6,908,301); “Quicker Picker Upper” (Bounty, #5,027,795).

Rogers unjustifiably privileges infringers’ infringing speech over mark owners’ speech. By imposing a heightened two-part test, *Rogers* puts a thumb on the scale in favor of infringers making “expressive” products. But the enterprise of asking only whether the *infringing* product is “expressive” makes no sense and assumes the absence of countervailing expressive interests. For instance, the goods and services of many mark owners, like newspapers, charities, museums, sports leagues, movie studios, and rock bands, are almost exclusively expressive. And product labels on commercial products routinely tell stories.

Take this case. Jack Daniel’s is every bit as, if not more, expressive than Bad Spaniels. But the Ninth Circuit focused solely on Bad Spaniels. It reasoned that although the toy was “not the equivalent of the *Mona Lisa*,” it still was “expressive” because of its “silly message” and thus merited heightened protection. Pet.App.31a. But by that metric, Jack Daniel’s bottle comes close to *The Last Supper* and is entitled to at least as much protection.

In contrast to VIP’s front-only label containing poop humor, Jack Daniel’s bottle has a three-sided label that conveys numerous messages. The front label reminds consumers “Every Drop Made in Lynchburg Tennessee,” and boasts “Quality & Craftsmanship Since 1866.” One side depicts Jack Daniel’s portrait (a work of art in itself) and explains that the whiskey is still filtered through maple charcoal. Dkt. 220 (Ex. 2) (physically filed). Beneath is his “charge”: “Every day we make it, we’ll make it the best we can.” The other side explains Jack Daniel’s production—“Mellowed” though sugar maple charcoal,

“Matured” in handcrafted barrels, and “Tasted” by master distillers before sale. The label mentions that the whiskey has been awarded seven gold medals since 1904.

Equally arbitrary, *Rogers* presumably would privilege humorous infringing uses over trademarks that are themselves humorous, protecting a “Shi*t the Bed Salsa” rip-off of the already humorous “Sh[*]t the Bed Hot Sauce” (#6,302,534). *Rogers* thus creates its own First Amendment problems by inviting courts to invent speaker- and content-based distinctions. The Act’s likelihood-of-confusion test, by contrast, treats all mark owners and infringers equally, while providing courts the flexibility to consider each case on its facts.

Nor is it clear how courts should determine when to apply *Rogers*, which itself limited its test to “allegedly misleading titles” but also expressed concern about applying the Act to “artistic works” in general. 875 F.2d at 997, 999. The Ninth Circuit has extended *Rogers* to the extreme: any “expressive” use of a trademark, *i.e.*, any expression of “ideas” or “points of view,” including a “humorous message,” authorizes ignoring the statutory text. Pet.App.30a-31a (citation omitted). The Ninth Circuit thus has extended *Rogers* to video games, *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241 (9th Cir. 2013), and greeting cards, *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 268 (9th Cir. 2018). And the Ninth Circuit has held *Rogers* applies when a TV show uses an allegedly infringing mark on any “consumer goods such as shirts and champagne glasses bearing [the TV show’s] brand.” *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1195-97 (9th Cir. 2017).

As Professor McCarthy noted about this case, if a dog toy counts as “expressive,” it is hard to see what would not: “why not a box of cereal containing ‘expressive’ images of a brand mascot, graphics or slogans. Applying the

Ninth Circuit’s view, the label on almost any ordinary consumer product could be argued to contain some ‘expressive’ message.” J. Thomas McCarthy, Comment on The TTABlog®, <https://bit.ly/3BR3CNC>. The decision below arguably authorizes misleading marks on mugs, water bottles, tote bags, playing cards, cellphone cases, calendars, and the like.

C. *Rogers* Undermines the Lanham Act

Rogers undermines the twin purposes of the Lanham Act: preventing customer confusion and protecting mark owners’ investments in goodwill. See *Booking.com*, 140 S. Ct. at 2302.

Start with protecting consumers. By protecting trademarks, the Act helps “consumers identify goods and services that they wish to purchase, as well as those they want to avoid.” *Tam*, 137 S. Ct. at 1751. But *Rogers* would make it virtually impossible to prevent sales of “humorous” or “expressive” products that are likely to mislead consumers, unless their marks are outright counterfeits. As the district court observed, the “‘explicitly misleading’ standard essentially displaces the likelihood-of-confusion test with a standard that excuses nearly any use less than slapping another’s trademark on your own work and calling it your own.” Pet.App.18a.

The Ninth Circuit’s extension of *Rogers* offers a free pass for anyone to confuse customers. Virtually any knock-off can be reframed as a “humorous” or “expressive” message. For instance, one might find knock-offs like “UGH” boots or “Adios” sportswear funny, even if unsuspecting customers believe they are buying genuine UGG or Adidas products. Similarly, marijuana-infused candy and foods sold under names that mimic well-known brands might strike some as funny. See *Ferrera Candy Co. v. Akimov, LLC*, No. 22-cv-80768 (S.D. Fla. May 23,

2022) (marijuana-infused Nerds candies); Laura Reiley, *Major Food Brands Seek Crackdown on Marijuana-Infused Copycats*, Wash. Post (Apr. 29, 2022, 9:36 AM), <https://wapo.st/3OREJpq> (marijuana-infused “Double Stuf Stoneos” cookies):



But when knock-offs are confusing, the joke is on consumers.

Rogers also eviscerates mark owners’ investments in goodwill. The Act encourages brand owners to invest in producing quality products by “assur[ing] a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product.” *Qualitex*, 514 U.S. at 164. Companies invest millions of dollars in production of quality goods and services, and they exercise great care in how and to whom they license their marks. Jack Daniel’s and its affiliates, for example, take their reputation seriously and encourage consumers to enjoy their whiskey responsibly.

Yet the Ninth Circuit’s decision allows infringers like VIP to exploit the goodwill of brand owners and use their marks to market products in irresponsible ways. As the district court observed, the decision below leaves mark

owners like Jack Daniel’s with “no means to protect the viability” of their trademarks. Pet.App.19a. *Rogers*, from start to finish, should be discarded.

D. *Rogers* at Least Does Not Protect Use of Marks to Identify the Source of Utilitarian Products

Even assuming *Rogers* has some valid application, it should not extend to VIP’s use of Jack Daniel’s marks as the trademarks for its own product. As noted, *Rogers* rested on concern about applying the Lanham Act to “titles” of artistic works. 875 F.2d at 998. Courts subsequently have extended *Rogers* to use of marks in the “body” of artistic works. *E.g.*, *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008). Whatever the merits of those concerns, they are not implicated where an infringer uses a mark to identify the source of its goods—that is, as a *trademark*. See 15 U.S.C. § 1127 (definition).

Outside the Ninth Circuit, courts have refused to confer First Amendment protection on trademark uses that identify the source of goods or services. See, *e.g.*, *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 93 (2d Cir. 1997) (rejecting argument that First Amendment protected group’s use of slogan because group was “using the slogan as a mark” for “source identification”); *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 414 (S.D.N.Y. 2002) (rejecting First Amendment defense where dog perfume used the plaintiff’s mark “for source identification”).

Here, VIP did not use Jack Daniel’s marks in the title or content of an artistic work. Instead, VIP imitated Jack Daniel’s marks to identify the source of its dog toy. Indeed, VIP acknowledged in its complaint that it uses “Bad

Spaniels” as a “trademark.” J.A.3, 11. Accordingly, *Rogers* should not extend here.

At a minimum, *Rogers* certainly should not apply where, as here, a defendant uses a mark to identify the source of an ordinary commercial product. As noted, *Rogers* was concerned with “artistic works,” such as “[m]ovies, plays, books, and songs.” 875 F.2d at 997-98. *Rogers* specifically distinguished such works from “more utilitarian products,” such as a “can of peas.” *Id.* at 997. And courts outside the Ninth Circuit have declined to extend *Rogers* to ordinary commercial goods or services. *See, e.g., Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999) (motorcycle repair service); *Tommy Hilfiger*, 221 F. Supp. 2d at 414 (dog perfume).

Of course, *Rogers*’ distinction between “artistic works” and “utilitarian products” is far from clear. But however one draws that line, VIP’s dog chew toy falls on the utilitarian side. To hold otherwise (as the Ninth Circuit did) would mean that virtually any product would be subject to *Rogers*, effectively swallowing the Lanham Act. At least in these circumstances, the Act’s likelihood-of-confusion test should apply. And under that test, Jack Daniel’s already prevailed. *Supra* pp.26-28.

II. Humorous Expression Does Not Trigger the Noncommercial-Use Exclusion to Dilution

The Ninth Circuit also erred in interpreting the non-commercial-use exclusion in the dilution statute to cover VIP’s use of Jack Daniel’s marks and trade dress “to sell Bad Spaniels.” Pet.App.33a. That ruling contravenes the plain text of the noncommercial-use exclusion, renders other exclusions superfluous, and leaves the dilution statute ineffective in core cases of tarnishment—namely, those involving sexual, drug-related, or (as here) poop-related humor.

A. “Noncommercial Use” Does Not Encompass Using Marks to Sell Goods or Services

The noncommercial-use exclusion does not apply where defendants use others’ marks to sell goods or services in commerce.

1. **Text.** Start with the text. The exclusion exempts from dilution liability “[a]ny noncommercial use of a mark.” 15 U.S.C. § 1125(c)(3)(C). Because the statute does not define “noncommercial use,” this Court gives that phrase its “ordinary, contemporary, common meaning.” *Perrin v. United States*, 444 U.S. 37, 42 (1979). Dictionary definitions define “noncommercial” to mean “not commercial,” *Webster’s Third New International Dictionary of the English Language* 1536 (2002), and “commercial” to mean “concerned with or engaged in” “the activity of buying and selling,” often in the context of “making or intending to make a profit,” *The New Oxford American Dictionary* 341 (2d ed. 2005).

In ordinary parlance, then, no one would call using a mark to sell a good or service “noncommercial.” And it stretches the English language to call for-profit selling a non-commercial use. VIP’s use of Jack Daniel’s marks to sell its dog toy (and to do so for profit) is a prototypical case of commercial use and clearly falls outside the exclusion.

This Court similarly has interpreted the term “commercial” in the copyright fair-use context to include for-profit sale of goods or services, even when expressive uses, like parody, are involved. Take *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994), which considered whether 2 Live Crew’s parody of Roy Orbison’s “Oh, Pretty Woman” was fair. The Court rejected the notion that a work’s “commercial character” makes it presumptively unfair. 510 U.S. at 583-84. That analytic step was

necessary because 2 Live Crew’s use of parody when selling songs was commercial. As the Court explained, if “commerciality carried presumptive force against a finding of fairness, the presumption would swallow nearly all of the illustrative uses listed in the [fair-use statute], including news reporting, comment, criticism, teaching, scholarship, and research, *since these activities are generally conducted for profit* in this country.” *Id.* at 584 (emphasis added) (internal quotation marks omitted); *see also Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1204 (2021); *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985).

2. Context. The statutory context further confirms that the noncommercial-use exclusion does not extend to sales of goods or services. Congress had good reason to exclude from dilution liability uses unrelated to sales of goods or services because such uses otherwise might fall within the statute’s broad jurisdictional provisions. The TDRA provides a cause of action when a person makes “use of a mark ... in commerce” likely to dilute a famous mark. 15 U.S.C. § 1125(c)(1). The statute, in turn, defines “use in commerce” as use of a mark “in the ordinary course of trade,” including when a mark is placed on goods “sold” or merely “transported in commerce.” *Id.* § 1127. Under that broad language, the TDRA would cover cases where marks are placed on goods that are transported in commerce but given away for free, rather than sold. The noncommercial-use exclusion thus serves an important role in the statutory scheme by exempting from dilution liability uses unrelated to sales.

The Ninth Circuit read the exclusion to apply whenever use of a mark involves “humor[]” or “expression.” Pet.App.33a. But that expansive reading renders other statutory exclusions superfluous and vitiates the textual limitations on the fair-use exclusion.

“One of the most basic interpretive canons” is “that a statute should be construed so that effect is given to all its provisions, so that no part will be inoperative or superfluous, void or insignificant.” *Corley v. United States*, 556 U.S. 303, 314 (2009) (cleaned up); see *Marx v. Gen. Revenue Corp.*, 568 U.S. 371, 386 (2013). The canon applies with particular force where general and specific provisions “exist side by side” in the same statute. *RadLAX Gateway Hotel, LLC v. Amalgamated Bank*, 566 U.S. 639, 645 (2012). A court should not interpret the more general provision so broadly that it “swallow[s]” the more specific one. *Id.*

The Ninth Circuit’s reading of the noncommercial-use exclusion renders other exclusions superfluous. Start with the specific exclusion for “news reporting and news commentary.” 15 U.S.C. § 1125(c)(3)(B). If noncommercial use covers any “expressive” use of a mark, Congress had no need to create a separate news exclusion. News reporting and commentary are undoubtedly expressive.

Next consider the fair-use exclusion, which covers, among other things, use of a famous mark “in connection with ... identifying and parodying, criticizing, or commenting upon the famous mark owner” or its goods so long as the mark is not used “as a designation of source for the person’s own goods or services.” *Id.* § 1125(c)(3)(A). If the “noncommercial use” exclusion already covers any expressive or humorous uses, then Congress had no need to separately exclude parody, criticism, and commentary.

The Ninth Circuit’s ruling relatedly nullifies Congress’ decision to limit the fair-use exclusion to uses “other than as a designation of source for the person’s own goods or services.” *Id.* In the Ninth Circuit’s view, a *humorous* parodist could circumvent the fair-use limitations

by qualifying for the separate noncommercial-use exclusion.

This case proves the point. The Ninth Circuit did not question the district court’s finding that Bad Spaniels did not qualify for the fair-use exclusion because VIP used Jack Daniel’s marks to designate the source of its dog toy. Pet.App.33a-34a. Indeed, VIP pleaded in its complaint that it used Bad Spaniels as a “trademark.” J.A.3, 11. By definition, a trademark is a source identifier. 15 U.S.C. § 1127. The Ninth Circuit nonetheless held that Bad Spaniels qualified for the separate noncommercial-use exclusion. That holding guts the “other than as a designation of source” limit on the fair-use exclusion.

3. Purpose. The Ninth Circuit’s interpretation of the noncommercial-use exclusion defeats a core purpose of the statute, which is to prevent tarnishment in cases involving lewd (but often funny) uses of marks.

Dilution statutes, like the TDRA, protect the “commercial value” or “selling power” of trademarks. Restatement (Third) of Unfair Competition § 25 cmt. a (1995) (Restatement); see *Moseley v. V Secret Catalogue*, 537 U.S. 418, 429 (2003). The mark’s selling power “can be undermined by a use of the mark with goods or services ... that ‘tarnish’ the mark’s image.” Restatement § 25 cmt. c. Classic examples include uses related to “illicit drugs” or “pornography.” *Id.*

The same is true of using a trademark in connection with poop. Undoubtedly, there are occasions when one may appropriately smile about poop. The poop emoji delights many of us. As do poop-related books for children, e.g., Professor Poopy McDooDoo, *The Kids Book of Poop: A Funny Read Aloud Picture Book for Kids of All Ages about Poop and Pooping* (2021), or adults, e.g., Katie Adams, *Sh*ts and Giggles: The Ultimate Bathroom Joke*

Book (2018). But poop humor is not for everyone, and in the wrong setting, it can kill the mood. “Many symbols have ... contaminating power in our hierarchy of taboos, but poop is the most potent.” Dave Praeger, *Poop Culture: How America is Shaped by its Grossest National Product* 128 (2007). “[E]ven in the most innocent of circumstances, [poop’s] negative image can overwhelm all else.” *Id.* at 165.

As the district court found here, VIP’s use of Jack Daniel’s trademarks and trade dress are diluting not only because Bad Spaniels associates Jack Daniel’s alcohol beverages with products appealing to children but also because the goods Jack Daniel’s offers for sale “involve[] human consumption and human consumption and canine excrement do not mix.” Pet.App.61a.

The Ninth Circuit’s holding vitiates the TDRA in textbook cases of tarnishment involving use of marks in connection with drugs, pornography, or poop. Given the potency of taboos, defendants in such cases can always argue that their use of a mark is “humorous” or “expressive” simply because the use juxtaposes the mark with images contrary to the mark owner’s brand. Under the Ninth Circuit’s ruling, such uses would qualify for the noncommercial-use exclusion. Pet.App.31a.

For example, suppose a nationwide chain of adult-entertainment stores started calling itself “The Disney Sex Store” and selling life-sized sex dolls featuring famous Disney princesses. The chain’s use of Disney’s marks could well tarnish Disney’s carefully cultivated brand by associating it with princess sex dolls. Yet under the Ninth Circuit’s ruling, Disney would have no remedy under the TDRA. The same would be true in case after case. Consider the following examples of diluting uses that courts enjoined:

- The pornographic film, “Debbie Does Dallas,” involving someone “performing sex acts” in “a uniform closely similar to that of the Dallas Cowboys Cheerleaders uniform.” *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 467 F. Supp. 366, 371, 376 (S.D.N.Y.), *aff’d*, 604 F.2d 200 (2d Cir. 1979).
- A white-powder candy that “resembles cocaine” packaged in a “plastic container resembling a Coca-Cola” bottle. *Coca-Cola Co. v. Alma-Leo U.S.A., Inc.*, 719 F. Supp. 725, 726, 728 (N.D. Ill. 1989).
- Pornographic products imitating Ben & Jerry’s marks with “Hairy Garcia,” “Banana Clit,” “Everything But The Butt,” “Late Night Snatch,” “New York Super Fat & Chunky,” “Boston Cream Thigh,” “Coconut 7 Lay-Her Bar,” “Chocolate Fudge Babes,” and “Peanut Butter D-Cups” marks. Injunction on Consent at 2, *Ben & Jerry’s Homemade, Inc. v. Rodax Distribs., Inc.*, No. 12-cv-6734 (S.D.N.Y. Sept. 11, 2012), Dkt. 11.
- A depiction of the Pillsbury Dough Boy “engaged in sexual intercourse and fellatio.” *Pillsbury Co. v. Milky Way Prods.*, 1981 WL 1402, at *1 (N.D. Ga. Dec. 24, 1981).
- A condom dispenser mimicking an American Express card bearing the phrase “never leave home without it.” *Am. Express Co. v. Vibra Approved Labs. Corp.*, 1989 WL 39679, at *1 (S.D.N.Y. Apr. 19, 1989).
- Pornographic websites using “babypotterybarn” and “potterybarnteens,” “VelVeeda,” and “barbiesplaypen.com.” *Williams-Sonoma, Inc. v. Friendfinder, Inc.*, 2007 WL 4973848, at *1-4 (N.D.

Cal. Dec. 6, 2007); *Kraft Foods Holdings, Inc. v. Helm*, 205 F. Supp. 2d 942, 944 (N.D. Ill. 2002); *Mattel, Inc. v. Internet Dimensions, Inc.*, 2000 WL 973745, at *1 (S.D.N.Y. July 13, 2000).

- A chain of cigarette stores called “Smokes R Us.” Consent Judgment and Permanent Injunction at 12, *Toys “R” Us, Inc. v. Smokes R Us*, No. 11-cv-820 (M.D. Pa. June 20, 2011), Dkt. 29.

Or consider these examples from cases that settled:

- An app that predicts penis size called “Chubby Checker.” Complaint at 6, *Evans v. Hewlett-Packard Co.*, No. 13-cv-2477 (N.D. Cal Feb. 12, 2013), Dkt. 1.
- A “[v]ibrating rubber ring[] for the penis” called “RINGO.” Notice of Opposition at 3, *Starkey v. Pac. Coast Holdings IP, LLC*, No. 91246962 (T.T.A.B. Mar. 13, 2019), Dkt. 1.

Or take the following hypothetical examples:

- Sex dolls depicting young pop stars who have trademarked their names.
- “Trader Hoes” strip club chain.
- “Sh*tbit” bowel-movement trackers.
- “Starbuds” marijuana dispensaries.

The problems with the Ninth Circuit’s ruling go beyond sex, drugs, and excrement. Under the Ninth Circuit’s view, there would be little incentive to license another’s famous trademark for non-confusing uses. Companies could appropriate others’ marks without paying the customary price, so long as they conjure up some expressive purpose. For example, Hyundai unsuccessfully argued it was free under the dilution statute to use Louis Vuitton’s mark in a car commercial because the use

involved “a humorous, socio-economic commentary on luxury.” *Louis Vuitton Malletier, S.A. v. Hyundai Motor Am.*, 2012 WL 1022247, at *1, *17-19 (S.D.N.Y. Mar. 22, 2012). But Hyundai could bypass the Act under the Ninth Circuit’s rule.

B. Reliance on Legislative History Is Misplaced

Relying on the 1995 legislative history of a superseded version of the dilution statute, VIP argues that the noncommercial-use exclusion incorporates this Court’s commercial-speech cases. Br. in Opp. 27. The House Judiciary Committee’s report to the Federal Trademark Dilution Act of 1995 claims the noncommercial-use exclusion “expressly incorporates the concept of ‘commercial’ speech from the ‘commercial speech’ doctrine.” H.R. Rep. No. 104-374, at 8 (1995). VIP further contends that, under commercial-speech cases, its dog toy qualifies as noncommercial speech because the toy “communicates a humorous parody.” Br. in Opp. 28.

This Court, however, need not decide whether VIP’s application of this Court’s commercial-speech cases is correct because this snippet of legislative history has no force here. This Court does not resort to legislative history where, as here, the text is “clear.” See *Ratzlaf v. United States*, 510 U.S. 135, 147-48 (1994). The exclusion on its face applies to “noncommercial *use* of a mark,” not to noncommercial *speech*. 15 U.S.C. § 1125(c)(3)(C) (emphasis added). In ordinary usage, “use” means the “‘act of employing’ something.” *Voisine v. United States*, 579 U.S. 686, 692 (2016) (citation omitted). The text focuses on whether a person employs a mark to sell goods or services. The committee report’s line thus may be nothing more than an attempt by “unrepresentative committee members” or “unelected staffers and lobbyists” to strategically manipulate the “legislative history to secure

results they were unable to achieve through the statutory text.” *Exxon Mobil Corp. v. Allapattah Servs.*, 545 U.S. 546, 568 (2005).

Congress presumably knew the phrase “commercial speech” as used by this Court is a term of art. Had Congress intended to incorporate that concept into the exclusion, “it would have done so explicitly.” *Bd. of Educ. of Westside Cnty. Schs. v. Mergens*, 496 U.S. 226, 242 (1990) (rejecting similar argument that Congress incorporated free-speech concepts). That Congress used a different term—noncommercial *use*—“can only mean that it intended to establish a standard different from the one established” by this Court’s commercial-speech cases. *Id.* After all, the line between commercial and noncommercial speech is “not always clear.” *See Tam*, 137 S. Ct. at 1765; *accord Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 575 (2001) (Thomas, J., concurring).¹⁵

C. Purported First Amendment Concerns Do Not Justify the Ninth Circuit’s Holding

The Ninth Circuit invoked the First Amendment to justify its reading of the noncommercial-use exclusion, asserting in a single sentence that VIP’s “message” was “protected by the First Amendment.” Pet.App.33a. Although it is unclear what role the First Amendment played

¹⁵ The decision below (Pet.App.33a-34a) relied on *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894 (9th Cir. 2002). But the TDRA supersedes that case’s reasoning. Formerly, only “commercial use” of a mark came within the dilution provision’s scope. *See* 15 U.S.C. § 1125(c)(1) (1996). As a result, *Mattel* gave the noncommercial-use exclusion a different meaning to avoid rendering the exclusion superfluous and looked to the legislative history for such a meaning. 296 F.3d at 904. In the TDRA, however, Congress deleted the term “commercial” before “use.” *See* 15 U.S.C. § 1125(c)(1) (2006).

in the Ninth Circuit’s analysis, the Ninth Circuit’s concerns were misplaced. Applying the dilution statute to VIP’s use of a mark to sell commercial products does not raise constitutional concerns.

1. This Court’s cases establish that intellectual property laws generally are “constitutional even if applied to noncommercial speech,” Jennifer E. Rothman, *Commercial Speech, Commercial Use and the Intellectual Property Quagmire*, 101 Va. L. Rev. 1929, 1969 (2015), and that restrictions on speech “that embod[y] intellectual property” receive “diminished First Amendment scrutiny,” Robert C. Post & Jennifer E. Rothman, *The First Amendment and the Right(s) of Publicity*, 130 Yale L.J. 86, 134 (2020). For example, in *Harper & Row*, this Court held the First Amendment did not insulate a magazine from liability under the Copyright Act for publishing a public figure’s work. 471 U.S. at 555-60. The Court noted that copyrights restrict only the form of expression, not the ideas expressed, and that copyrights themselves serve as an “engine of free expression” by creating incentives to create. *Id.* at 556, 558.

Similarly, this Court held the First Amendment did not shield a speaker from liability for noncommercial speech under a common-law right of publicity because that right protected a “proprietary interest.” *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573, 575 (1977). This Court reasoned that the right of publicity, like “the patent and copyright laws,” “provides an economic incentive [to] make the investment required to produce a performance of interest to the public.” *Id.* at 576. “Much of [the] economic value” in a performer’s act “lies in the right of exclusive control over the publicity given to his performance.” *Id.* at 575 (cleaned up). The Constitution

“no more prevents” liability based on that right of publicity—resulting from “the theft of goodwill”—than it does based on copyright. *Id.* at 575-76 (citation omitted).

Intellectual property rights based in trademark are no different. Trademarks “have ancient origins” and “were protected at common law and in equity at the time of the founding.” *Tam*, 137 S. Ct. at 1751. Trademarks grant mark owners a limited “property right” to exclude uses that interfere with the owner’s “good-will.” *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 413 (1916); *accord Coll. Savs. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 673 (1999). Dilution statutes, which protect that right from dwindling away, are thus generally constitutional, even as applied to expressive uses.

For example, in *SFAA*, discussed *supra*, at p.30, the Court upheld the Amateur Sports Act, which was essentially an antidilution statute. As discussed above, that act prohibited certain uses of the word “Olympic” irrespective of likelihood of confusion and extended to both commercial and “expressive” uses. 483 U.S. at 528, 531, 536. And unlike the dilution statute here, it did not contain a fair-use defense. *Id.* at 531.

This Court had little difficulty finding that trademark statute constitutional. The Court explained that, by prohibiting certain uses of “Olympic,” the act did not prohibit the group from “conveying its message.” *Id.* at 536. The act restricted “only the manner” in which the group could do so. *Id.* The “appropriate inquiry” was “thus whether the [act’s] incidental restrictions on First Amendment freedoms are greater than necessary to further a substantial governmental interest.” *Id.* at 536-37. Applying that test, the Court held that the act was no broader than necessary to ensure that the Olympic Committee would “receive[] the benefit of its own efforts” and thus “have an

incentive to continue to produce a ‘quality product,’ that, in turn, benefits the public.” *Id.* at 537. Congress “could determine that unauthorized uses, even if not confusing, nevertheless may harm the [Olympic Committee] by lessening the distinctiveness and thus the commercial value of the marks”—in other words, by diluting the marks. *Id.* at 539.

2. It follows *a fortiori* that the dilution statute—which contains greater “built-in First Amendment accommodations,” see *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003) (Copyright Act)—does not present constitutional concerns. Property rights do not “yield to the exercise of First Amendment rights” where, as here, “adequate alternative avenues of communication exist.” *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972).

The dilution statute does not prohibit defendants from conveying any message. VIP, for example, can continue making dog-poop jokes. Nothing prevents it from selling poop-shaped dog toys, like the ones VIP currently sells. J.A.188. And it can even sell generic whiskey bottle toys saying “43% POO BY VOL.” or “100% SMELLY.” It just cannot profit off poop humor by appropriating Jack Daniel’s marks and trade dress for its own trademark use, tarnishing the brand in the process.

The dilution statute prohibits defendants from conveying messages only in a particular form or manner—namely, by using a mark in a way likely to dilute a famous mark. But dilution defendants lack any First Amendment right to damage mark owners’ property rights by in effect stealing their marks for use as their own property. The statute, moreover, furthers a substantial government interest. Much like the Amateur Sports Act, the dilution statute “protect[s] the commercial value or ‘selling power’” of famous marks. Restatement § 25 cmt. a. It thus ensures that mark owners will enjoy the benefits of

creating famous brands and will have incentives to continue producing quality products. *SFAA*, 483 U.S. at 538.

The dilution statute’s restrictions, moreover, are no greater than necessary to further this interest. To start, the statute requires a famous mark owner to prove that the defendant’s use of a mark “is likely to cause dilution by blurring or dilution by tarnishment of the famous mark.” 15 U.S.C. § 1125(c)(1). Like the likelihood-of-confusion test for infringement, the likelihood-of-dilution test “tends to ensure that the feared harm will in fact take place.” *Alvarez*, 567 U.S. at 735 (Breyer, J., concurring).

Further, unlike the Amateur Sports Act, the dilution statute contains exclusions protecting First Amendment values. For instance, the statute broadly excludes from dilution liability “[a]ny noncommercial use of a mark”—*i.e.*, any use not in connection with selling goods or services. 15 U.S.C. § 1125(c)(3)(C). The statute also excludes “[a]ll forms of news reporting and news commentary,” *id.* § 1125(c)(3)(B), and “[a]ny fair use” including “parodying, criticizing, or commenting” on a famous mark, as long as a person does not use the famous mark “as a designation of source of the person’s own goods and services.” *Id.* § 1125(c)(3)(A). When those exclusions are inapplicable, the dilutor is little different than an ordinary thief—just of intellectual property.

CONCLUSION

The court of appeals' judgment should be reversed.

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STATUTORY APPENDIX

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15 U.S.C. § 1114. Remedies, infringement, innocent infringement by printers and publishers

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising 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; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

As used in this paragraph, the term “any person” includes the United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, or other persons acting for the United States and with the authorization and consent of the United States, and any State, any instrumentality of a State, and any officer or employee of a State or

instrumentality of a State acting in his or her official capacity. The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(2) Notwithstanding any other provision of this chapter, the remedies given to the owner of a right infringed under this chapter or to a person bringing an action under section 1125(a) or (d) of this title shall be limited as follows:

(A) Where an infringer or violator is engaged solely in the business of printing the mark or violating matter for others and establishes that he or she was an innocent infringer or innocent violator, the owner of the right infringed or person bringing the action under section 1125(a) of this title shall be entitled as against such infringer or violator only to an injunction against future printing.

(B) Where the infringement or violation complained of is contained in or is part of paid advertising matter in a newspaper, magazine, or other similar periodical or in an electronic communication as defined in section 2510(12) of title 18, the remedies of the owner of the right infringed or person bringing the action under section 1125(a) of this title as against the publisher or distributor of such newspaper, magazine, or other similar periodical or electronic communication shall be limited to an injunction against the presentation of such advertising matter in future issues of such newspapers, magazines, or other similar periodicals or in future

transmissions of such electronic communications. The limitations of this subparagraph shall apply only to innocent infringers and innocent violators.

(C) Injunctive relief shall not be available to the owner of the right infringed or person bringing the action under section 1125(a) of this title with respect to an issue of a newspaper, magazine, or other similar periodical or an electronic communication containing infringing matter or violating matter where restraining the dissemination of such infringing matter or violating matter in any particular issue of such periodical or in an electronic communication would delay the delivery of such issue or transmission of such electronic communication after the regular time for such delivery or transmission, and such delay would be due to the method by which publication and distribution of such periodical or transmission of such electronic communication is customarily conducted in accordance with sound business practice, and not due to any method or device adopted to evade this section or to prevent or delay the issuance of an injunction or restraining order with respect to such infringing matter or violating matter.

* * *

15 U.S.C. § 1115. Registration on principal register as evidence of exclusive right to use mark; defenses

* * *

(b) Incontestability; defenses

To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 1065 of this title, or in the renewal application filed under the provisions of section 1059 of this title if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application. Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 1114 of this title, and shall be subject to the following defenses or defects:

* * *

(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin[.]

* * *

§ 1116. Injunctive relief**(a) Jurisdiction; service**

The several courts vested with jurisdiction of civil actions arising under this chapter shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office or to prevent a violation under subsection (a), (c), or (d) of section 1125 of this title. A plaintiff seeking any such injunction shall be entitled to a rebuttable presumption of irreparable harm upon a finding of a violation identified in this subsection in the case of a motion for a permanent injunction or upon a finding of likelihood of success on the merits for a violation identified in this subsection in the case of a motion for a preliminary injunction or temporary restraining order. Any such injunction may include a provision directing the defendant to file with the court and serve on the plaintiff within thirty days after the service on the defendant of such injunction, or such extended period as the court may direct, a report in writing under oath setting forth in detail the manner and form in which the defendant has complied with the injunction. Any such injunction granted upon hearing, after notice to the defendant, by any district court of the United States, may be served on the parties against whom such injunction is granted anywhere in the United States where they may be found, and shall be operative and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other United States district court in whose jurisdiction the defendant may be found.

* * *

(d) Civil actions arising out of use of counterfeit marks

(1)(A) In the case of a civil action arising under section 1114(1)(a) of this title or section 220506 of title 36 with respect to a violation that consists of using a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services, the court may, upon ex parte application, grant an order under subsection (a) of this section pursuant to this subsection providing for the seizure of goods and counterfeit marks involved in such violation and the means of making such marks, and records documenting the manufacture, sale, or receipt of things involved in such violation.

(B) As used in this subsection the term “counterfeit mark” means—

(i) a counterfeit of a mark that is registered on the principal register in the United States Patent and Trademark Office for such goods or services sold, offered for sale, or distributed and that is in use, whether or not the person against whom relief is sought knew such mark was so registered; or

(ii) a spurious designation that is identical with, or substantially indistinguishable from, a designation as to which the remedies of this chapter are made available by reason of section 220506 of title 36;

but such term does not include any mark or designation used on or in connection with goods or services of which the manufacture¹ or producer was, at the time of the manufacture or production in question 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

¹ So in original. Probably should be “manufacturer”.

use such mark or designation.

(2) The court shall not receive an application under this subsection unless the applicant has given such notice of the application as is reasonable under the circumstances to the United States attorney for the judicial district in which such order is sought. Such attorney may participate in the proceedings arising under such application if such proceedings may affect evidence of an offense against the United States. The court may deny such application if the court determines that the public interest in a potential prosecution so requires.

(3) The application for an order under this subsection shall—

(A) be based on an affidavit or the verified complaint establishing facts sufficient to support the findings of fact and conclusions of law required for such order; and

(B) contain the additional information required by paragraph (5) of this subsection to be set forth in such order.

(4) The court shall not grant such an application unless—

(A) the person obtaining an order under this subsection provides the security determined adequate by the court for the payment of such damages as any person may be entitled to recover as a result of a wrongful seizure or wrongful attempted seizure under this subsection; and

(B) the court finds that it clearly appears from specific facts that—

(i) an order other than an ex parte seizure order is not adequate to achieve the purposes of section

1114 of this title;

(ii) the applicant has not publicized the requested seizure;

(iii) the applicant is likely to succeed in showing that the person against whom seizure would be ordered used a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services;

(iv) an immediate and irreparable injury will occur if such seizure is not ordered;

(v) the matter to be seized will be located at the place identified in the application;

(vi) the harm to the applicant of denying the application outweighs the harm to the legitimate interests of the person against whom seizure would be ordered of granting the application; and

(vii) the person against whom seizure would be ordered, or persons acting in concert with such person, would destroy, move, hide, or otherwise make such matter inaccessible to the court, if the applicant were to proceed on notice to such person.

(5) An order under this subsection shall set forth—

(A) the findings of fact and conclusions of law required for the order;

(B) a particular description of the matter to be seized, and a description of each place at which such matter is to be seized;

(C) the time period, which shall end not later than seven days after the date on which such order is issued, during which the seizure is to be made;

(D) the amount of security required to be provided under this subsection; and

(E) a date for the hearing required under paragraph (10) of this subsection.

(6) The court shall take appropriate action to protect the person against whom an order under this subsection is directed from publicity, by or at the behest of the plaintiff, about such order and any seizure under such order.

(7) Any materials seized under this subsection shall be taken into the custody of the court. For seizures made under this section, the court shall enter an appropriate protective order with respect to discovery and use of any records or information that has been seized. The protective order shall provide for appropriate procedures to ensure that confidential, private, proprietary, or privileged information contained in such records is not improperly disclosed or used.

(8) An order under this subsection, together with the supporting documents, shall be sealed until the person against whom the order is directed has an opportunity to contest such order, except that any person against whom such order is issued shall have access to such order and supporting documents after the seizure has been carried out.

(9) The court shall order that service of a copy of the order under this subsection shall be made by a Federal law enforcement officer (such as a United States marshal or an officer or agent of the United States Customs Service, Secret Service, Federal Bureau of Investigation, or Post Office) or may be made by a State or local law enforcement officer, who, upon making service, shall carry out the seizure under the order. The court shall issue

orders, when appropriate, to protect the defendant from undue damage from the disclosure of trade secrets or other confidential information during the course of the seizure, including, when appropriate, orders restricting the access of the applicant (or any agent or employee of the applicant) to such secrets or information.

(10)(A) The court shall hold a hearing, unless waived by all the parties, on the date set by the court in the order of seizure. That date shall be not sooner than ten days after the order is issued and not later than fifteen days after the order is issued, unless the applicant for the order shows good cause for another date or unless the party against whom such order is directed consents to another date for such hearing. At such hearing the party obtaining the order shall have the burden to prove that the facts supporting findings of fact and conclusions of law necessary to support such order are still in effect. If that party fails to meet that burden, the seizure order shall be dissolved or modified appropriately.

(B) In connection with a hearing under this paragraph, the court may make such orders modifying the time limits for discovery under the Rules of Civil Procedure as may be necessary to prevent the frustration of the purposes of such hearing.

(11) A person who suffers damage by reason of a wrongful seizure under this subsection has a cause of action against the applicant for the order under which such seizure was made, and shall be entitled to recover such relief as may be appropriate, including damages for lost profits, cost of materials, loss of good will, and punitive damages in instances where the seizure was sought in bad faith, and, unless the court finds extenuating circumstances, to recover a reasonable attorney's fee. The

court in its discretion may award prejudgment interest on relief recovered under this paragraph, at an annual interest rate established under section 6621(a)(2) of title 26, commencing on the date of service of the claimant's pleading setting forth the claim under this paragraph and ending on the date such recovery is granted, or for such shorter time as the court deems appropriate.

* * *

15 U.S.C. § 1117. Recovery for violation of rights

(a) Profits; damages and costs; attorney fees

When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125(a) or (d) of this title, or a willful violation under section 1125(c) of this title, shall have been established in any civil action arising under this chapter, the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 of this title, and subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action. The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be

just, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty. The court in exceptional cases may award reasonable attorney fees to the prevailing party.

(b) Treble damages for use of counterfeit mark

In assessing damages under subsection (a) for any violation of section 1114(1)(a) of this title or section 220506 of title 36, in a case involving use of a counterfeit mark or designation (as defined in section 1116(d) of this title), the court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever amount is greater, together with a reasonable attorney's fee, if the violation consists of—

(1) intentionally using a mark or designation, knowing such mark or designation is a counterfeit mark (as defined in section 1116(d) of this title), in connection with the sale, offering for sale, or distribution of goods or services; or

(2) providing goods or services necessary to the commission of a violation specified in paragraph (1), with the intent that the recipient of the goods or services would put the goods or services to use in committing the violation.

In such a case, the court may award prejudgment interest on such amount at an annual interest rate established under section 6621(a)(2) of title 26, beginning on the date of the service of the claimant's pleadings setting forth the claim for such entry of judgment and ending on the date such entry is made, or for such shorter time as the court considers appropriate.

(c) Statutory damages for use of counterfeit marks

In a case involving the use of a counterfeit mark (as defined in section 1116(d) of this title) in connection with the sale, offering for sale, or distribution of goods or services, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits under subsection (a), an award of statutory damages for any such use in connection with the sale, offering for sale, or distribution of goods or services in the amount of—

(1) not less than \$1,000 or more than \$200,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just; or

(2) if the court finds that the use of the counterfeit mark was willful, not more than \$2,000,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just.

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15 U.S.C. § 1118. Destruction of infringing articles

In any action arising under this chapter, in which a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125(a) of this title, or a willful violation under section 1125(c) of this title, shall have been established, the court may order that all labels, signs, prints, packages, wrappers, receptacles, and advertisements in the possession of the defendant, bearing the registered mark or, in the case of a violation of section 1125(a) of this title

or a willful violation under section 1125(c) of this title, the word, term, name, symbol, device, combination thereof, designation, description, or representation that is the subject of the violation, or any reproduction, counterfeit, copy, or colorable imitation thereof, and all plates, molds, matrices, and other means of making the same, shall be delivered up and destroyed. The party seeking an order under this section for destruction of articles seized under section 1116(d) of this title shall give ten days' notice to the United States attorney for the judicial district in which such order is sought (unless good cause is shown for lesser notice) and such United States attorney may, if such destruction may affect evidence of an offense against the United States, seek a hearing on such destruction or participate in any hearing otherwise to be held with respect to such destruction.

15 U.S.C. § 1125. False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

* * *

(c) Dilution by blurring; dilution by tarnishment

(1) Injunctive relief

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

(2) Definitions

(A) For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

(i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

(ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.

(iii) The extent of actual recognition of the mark.

(iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(B) For purposes of paragraph (1), "dilution by blurring" is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

(i) The degree of similarity between the mark or trade name and the famous mark.

(ii) The degree of inherent or acquired distinctiveness of the famous mark.

(iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the

mark.

(iv) The degree of recognition of the famous mark.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.

(C) For purposes of paragraph (1), “dilution by tarnishment” is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) Exclusions

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with—

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

(4) Burden of proof

In a civil action for trade dress dilution under this

chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that—

(A) the claimed trade dress, taken as a whole, is not functional and is famous; and

(B) if the claimed trade dress includes any mark or marks registered on the principal register, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such registered marks.

(5) Additional remedies

In an action brought under this subsection, the owner of the famous mark shall be entitled to injunctive relief as set forth in section 1116 of this title. The owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity if—

(A) the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment was first used in commerce by the person against whom the injunction is sought after October 6, 2006; and

(B) in a claim arising under this subsection—

(i) by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to trade on the recognition of the famous mark; or

(ii) by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark.

(6) Ownership of valid registration a complete bar to action

The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register under this chapter shall be a complete bar to an action against that person, with respect to that mark, that—

(A) is brought by another person under the common law or a statute of a State; and

(B)(i) seeks to prevent dilution by blurring or dilution by tarnishment; or

(ii) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.

(7) Savings clause

Nothing in this subsection shall be construed to impair, modify, or supersede the applicability of the patent laws of the United States.

* * *

15 U.S.C. § 1127. Construction and definitions; intent of chapter

In the construction of this chapter, unless the contrary is plainly apparent from the context—

The United States includes and embraces all territory which is under its jurisdiction and control.

The word “commerce” means all commerce which may lawfully be regulated by Congress.

The term “principal register” refers to the register provided for by sections 1051 to 1072 of this title, and the term “supplemental register” refers to the register provided for by sections 1091 to 1096 of this title.

The term “person” and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this chapter includes a juristic person as well as a natural person. The term “juristic person” includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.

The term “person” also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

The term “person” also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

The terms “applicant” and “registrant” embrace the legal representatives, predecessors, successors and assigns of such applicant or registrant.

The term “Director” means the Under Secretary of

Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

The term “related company” means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.

The terms “trade name” and “commercial name” mean any name used by a person to identify his or her business or vocation.

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

The term “service mark” means any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered

as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

The term “certification mark” means any word, name, symbol, or device, or any combination thereof—

(1) used by a person other than its owner, or

(2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

The term “collective mark” means a trademark or service mark—

(1) used by the members of a cooperative, an association, or other collective group or organization, or

(2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

and includes marks indicating membership in a union, an association, or other organization.

The term “mark” includes any trademark, service mark, collective mark, or certification mark.

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in

commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

A mark shall be deemed to be “abandoned” if either of the following occurs:

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining

abandonment under this paragraph.

The term “colorable imitation” includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive.

The term “registered mark” means a mark registered in the United States Patent and Trademark Office under this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase “marks registered in the Patent and Trademark Office” means registered marks.

The term “Act of March 3, 1881”, “Act of February 20, 1905”, or “Act of March 19, 1920”, means the respective Act as amended.

A “counterfeit” is a spurious mark which is identical with, or substantially indistinguishable from, a registered mark.

The term “domain name” means any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet.

The term “Internet” has the meaning given that term in section 230(f)(1) of title 47.

Words used in the singular include the plural and vice versa.

The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair

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competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.