

No. 22-148

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In The  
**Supreme Court of the United States**

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JACK DANIEL'S PROPERTIES, INC.,

*Petitioner,*

v.

VIP PRODUCTS LLC,

*Respondent.*

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**On Writ Of Certiorari To The  
United States Court Of Appeals  
For The Ninth Circuit**

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**BRIEF OF AMICUS CURIAE  
PROFESSOR ANDREW C. MICHAELS  
IN SUPPORT OF RESPONDENT**

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## INTEREST OF AMICUS CURIAE

Amicus is a member of this Court’s bar, and a law professor who teaches and writes in the areas of intellectual property law and statutory interpretation. He is interested in seeing the law develop in a manner that provides a coherent and workable framework for balancing free expression with trademark rights.<sup>1</sup>



## SUMMARY OF ARGUMENT

This case presents an important and timely opportunity to strongly reaffirm the value of the First Amendment’s protection of parodic free expression. *Cf. Elsmere Music, Inc. v. National Broadcasting Co.*, 623 F.2d 252, 253 (2d Cir. 1080) (“in today’s world of often unrelieved solemnity, copyright law should be hospitable to the humor of parody”); Russell Jacoby, *A Climate of Fear: The free speech skeptics abandon Salmon Rushdie*, HARPER’S MAGAZINE 55 (March 2023).

How to do so without unduly trampling upon the Lanham Act’s valuable protections against marketplace confusion is not an easy question. Fortunately, the venerable United States Court of Appeals for the Second Circuit has developed a carefully considered

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<sup>1</sup> Amicus has no financial interest in the outcome of this case. No counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution. No person other than amicus made a monetary contribution to the preparation and submission of this brief.

jurisprudence addressing exactly this question, stemming from the 1989 *Rogers* decision and refined over subsequent years. Basically, the Second Circuit sensibly balances these incommensurable values by requiring a more compelling case for marketplace confusion when free expression is at issue. Under this balancing approach, courts may tailor the amount of free expression protection to the type of speech at issue, without attempting to draw an arbitrary binary distinction between artistic and commercial products.

The Ninth Circuit's approach used in the courts below results from a misreading and overextension of one particular sentence from the *Rogers* decision. That sentence merely suggested how the more general balancing would "normally" come out in the very particular situation of artistic titles using celebrity names.

This Court should reject the Ninth Circuit's unduly rigid approach and adopt that of the Second Circuit. It is difficult to say whether the Ninth Circuit's approach is significantly more protective of free expression as compared with that of the Second Circuit. What is clear though is that the Ninth Circuit's approach is less coherent and does not as directly focus the inquiry on the actual values at stake.

It is sometimes argued that the Ninth Circuit's formulation is necessary to protect artists from being bullied out of permissible speech, given the high cost of proceeding to trial in trademark litigation. But this concern could be substantially mitigated by clarifying that likelihood of confusion is a question of law

potentially appropriate for early disposition, especially when free expression is at issue.

Likelihood of confusion is the central inquiry in trademark law, but troublingly, there is no consensus amongst the circuits on whether it is ultimately a question of law or fact. Although likelihood of confusion is currently treated as a question of fact in many circuits including the Ninth Circuit, this Court should (again) follow the approach of the Second Circuit and clarify that it is a mixed question, or a question of law based on underlying facts.

This would bring trademark law in line with the rest of intellectual property law, where the similarly central inquiries of obviousness in patent law and fair use in copyright are treated as questions of law based on underlying facts. Like likelihood of confusion, obviousness and fair use are often dispositive issues that are approached via judicially created multi-factor tests. With both fair use and obviousness, although some of the underlying factors are factual, some of them involve primarily legal work. Similarly, as the Second Circuit has recognized, some of the likelihood of confusion factors, such as the “strength of the mark,” involve primarily legal work, as does the ultimate balancing of the factors. Like obviousness and fair use, the inquiry of when confusion is likely *enough* to justify a claim for trademark infringement can have significant policy implications.

The inquiry is even more clearly a legal one in a case like this one, where the likelihood of confusion

must be balanced against countervailing First Amendment free expression interests. If the likelihood of confusion inquiry is ultimately a legal one, the question of whether the likelihood of confusion is sufficiently compelling to outweigh the public interest in the free expression at issue is *a fortiori* one of law.

The Ninth Circuit’s “explicitly misleading” approach was initially adopted from the Second Circuit’s *Rogers* decision, but the Second Circuit later sensibly backed away from this approach. The “explicitly misleading” formulation was a conjecture initially limited to the very specific situation of the use of a celebrity’s name in the title of an artistic work, a situation not at issue here. The explicit versus implicit distinction was appropriately criticized as unworkable in a concurrence in *Rogers*. Even the author of the “explicitly misleading” test, Judge Jon O. Newman of the Second Circuit, backed away from it in the *Twin Peaks* case just four years later, and endorsed the “sufficiently compelling likelihood of confusion” approach.

The Ninth Circuit nevertheless remains tethered to this repudiated “explicitly misleading” language. But tellingly, even the Ninth Circuit, when applying this test, often looks to factors that sound more in likelihood of confusion and seem unrelated to the distinction between explicit and implicit misleadingness. Most other circuits do not use the Ninth Circuit’s “explicitly misleading” approach.

Even though the Ninth Circuit’s approach in this case was flawed, this Court should rule in favor of the

respondent here because there is no likelihood of confusion as a matter of law, and there is certainly not a sufficiently compelling case for confusion to outweigh the parodic free expression interests at stake.

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## ARGUMENT

### **I. The Ninth Circuit’s “Explicitly Misleading” Formulation Was Initially Limited To A Specific Context And Was Repudiated By The Very Judge That Created It**

#### **A. The Explicitly Misleading Test Was Initially A Tentative Proposal Limited To The Specific Context Of Artistic Titles Using Celebrity Names**

The “explicitly misleading” formulation being used by the Ninth Circuit was proposed in the *Rogers* majority opinion written by Judge Jon Newman of the Second Circuit. See *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989). This test was initially limited to a very specific context, was questioned in a concurrence in that case, and then was repudiated by the Second Circuit shortly after in various cases, including the *Twin Peaks* case also written by Judge Newman. *Twin Peaks Prods. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993).

To very briefly review the facts of *Rogers*, Ginger Rogers and Fred Astaire had established themselves as “among the most famous duos in show business history,” through their “incomparable performances in

Hollywood musicals.” *Rogers*, 875 F.2d at 996. In March 1986, the defendants produced a film entitled “Ginger and Fred,” directed by Federico Fellini, which “tells the story of two fictional Italian cabaret performers, Pippo and Amelia, who, in their heyday, imitated Rogers and Astaire and became known in Italy as ‘Ginger and Fred.’” *Id.* at 996-97.

Shortly after distribution of the film began, Ginger Rogers brought suit seeking injunctive relief and money damages, alleging that the defendants violated section 43(a) of the Lanham Act by creating the false impression that the film was about her or that she sponsored or was somehow involved in it, and also violated her common law right of publicity. *Id.* at 997. The case thus presented a “conflict between Rogers’ right to protect her celebrated name and the right of others to express themselves freely in their own artistic work.” *Id.* at 996.

Attempting to avoid intruding on First Amendment values, the court stated: “in general 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. Having first set forth this generally applicable balancing framework, the court then tentatively ventured a more specific test for the very specific situation at issue, stating that in “the *context of allegedly misleading titles using a celebrity’s name*, that balance will *normally* not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic

relevance, unless the title is *explicitly misleading* as to the source or the content of the work.” *Id.* (emphases added). The court explained that titles may be entitled to greater free expression protection in part because “consumers are well aware that they cannot judge a book solely by its title.” *Id.* at 1000.

The *Rogers* court thus provided a basic balancing framework for artistic works generally (avoiding consumer confusion v. free expression), and then attempted to sketch a more specific two-part test for how that balancing framework would “normally” apply in the context of titles of artistic works using celebrity names. This two-part initially conjectural test of no trademark liability unless (1) no artistic relevance, or (2) explicitly misleading, has taken on a life of its own, and has (as in the lower courts in this case) sometimes been rigidly applied far outside of the context that the test was originally explicitly limited to.

It is also worth noting that although it was employing the constitutional avoidance canon, the *Rogers* court made no effort to tie the “explicitly misleading” test to the language of the Lanham Act so as to show that this saving interpretation was at least fairly possible. *Cf. Nat’l Fed’n of Indep. Bus. v. Sebelius*, 567 U.S. 519, 563 (2012) (explaining that constitutional avoidance is appropriate where the saving construction is at least “fairly possible” or “reasonable”).<sup>2</sup> While the

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<sup>2</sup> On the other hand, it is perhaps also worth noting that even Justice Scalia appeared to recognize that when it comes to the Lanham Act, the text alone will only get you so far. *See Daster Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 32-33

words “explicitly misleading” do not appear in the relevant statutory text, the words “likely to cause confusion” do appear, though the Act does not specify how likely the confusion must be, or how this is to be determined. *See* 15 U.S.C. § 1114, 1125. One could conclude then that it is fairly possible to construe the Act to require a more compelling case for confusion when free expression interests are at stake, but not to rigidly limit this inquiry to consideration of whether any misleadingness is explicit.

Judge Griesa concurred with the result reached by the majority opinion (finding the likelihood of confusion outweighed by the relevant free expression interests), but had “substantial disagreement with the opinion otherwise.” *Rogers*, 875 F.2d at 1005 (Griesa,

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(2003) (Scalia, J.) (considering the “history and purpose of the Lanham Act” in interpreting Section 43(a)); *see also* Brief Amicus Curiae Motion Picture Association, Inc. In Support Of Neither Party, at \*11 (“Petitioner claims that the Lanham Act does not explicitly recite the *Rogers* test. True enough, but neither does the Lanham Act explicitly recite any multifactor likelihood-of-confusion test. Judges must interpret the Lanham Act’s text to decide what factors are salient to liability. . . .”). This Court sometimes appears to look beyond the statutory text itself in other areas of intellectual property as well. *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (explaining that the Court has long held that the Patent Act’s section 101 contains an “implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable”); *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1196-97 (2021) (explaining that 17 U.S.C. § 107, the statutory provision that embodies copyright’s “fair use” doctrine “indicates, rather than dictates, how courts should apply it,” and that the provision sets forth “general principals, the application of which requires judicial balancing, depending upon relevant circumstances”).



J., concurring). Judge Griesa thought the ruling was “overly expansive” in “its unfortunate attempt to establish a rule based on the asserted difference between explicitly misleading titles and those which are ambiguous or only implicitly misleading.” *Id.* at 1006. Judge Griesa thought that this distinction between explicit and implicit misleadingness would “prove to be unsound and unworkable,” and that it “should be left to future courts, dealing with real cases, to determine if there are to be exceptions to the First Amendment protection which would seem to be generally afforded to artistically relevant titles.” *Id.* at 1007.

**B. The Judge That Authored *Rogers* Later Repudiated The Explicitly Misleading Formulation That Was Used In This Case**

Although the general *Rogers* balancing framework of free expression against likelihood of confusion has appropriately been widely applied, the Second Circuit has appropriately *not* generally applied the more specific no artistic relevance or explicitly misleading test outside of its initial context of titles using celebrity names. Instead, the court has essentially walked the explicitly misleading prong back towards a likelihood of confusion analysis, albeit one where a stronger likelihood of confusion is required to outweigh the free expression interests at stake.

This balancing approach presumably contemplates a sliding scale: the stronger the free expression interests at issue are, the stronger the likelihood of

confusion must be. Under this approach, while a parodic dog toy may not be entitled to as much free expression weight as a parodic film, it should receive at least some free expression weight. The Court need not draw an arbitrary binary line between artistic speech and ordinary commercial products. *See White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1520 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc) (“In our pop culture, where salesmanship must be entertaining and entertainment must sell, the line between the commercial and noncommercial has not merely blurred; it has disappeared.”).

The Second Circuit first extended the *Rogers* balancing framework beyond the context of titles to apply as well to the content of artistic works in *Cliffs Notes*, stating: “we hold that the *Rogers* balancing approach is generally applicable to Lanham Act claims against works of artistic expression, a category that includes parody.” *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490, 494-95 (2d Cir. 1989). But importantly, in referring to the “*Rogers* balancing approach,” the court appears to have been referring to the general approach of balancing the public interest in avoiding consumer confusion against the public interest in free expression, rather than the more specific no artistic relevance or explicitly misleading language that *Rogers* proposed specifically for allegedly infringing titles using celebrity names. This distinction is the source of some confusion as there are really two quite different things – one very general and

one much more specific – that courts sometimes refer to as the *Rogers* doctrine.

The *Cliffs Notes* court stated that the more general balancing approach takes into account likelihood of confusion but “allows greater latitude for works such as parodies, in which expression, and not commercial exploitation of another’s trademark, is the primary intent.” *Id.* at 495. In other words, “somewhat more risk of confusion is to be tolerated when a trademark holder seeks to enjoin artistic expression such as a parody.” *Id.* The court thus essentially applied the standard likelihood of confusion analysis with an additional thumb on the scale for the defendant given the artistic character of the allegedly infringing work. *See id.* at 495 (“the degree of risk of confusion between *Spy Notes* and *Cliffs Notes* does not outweigh the well-established public interest in parody”). In finding an insufficient likelihood of confusion as a matter of law, the court considered for example the degree of care which purchasers would normally exercise, a factor relevant to likelihood of confusion but irrelevant to explicit misleadingness. *See id.* at 496 (“a *Cliffs Notes* book is not likely to be bought as an impulse purchase”).

A few years later, this more flexible approach was endorsed by the very judge that wrote the *Rogers* opinion, Judge Jon Newman of the Second Circuit. *Twin Peaks Prods. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993). Interestingly, the *Twin Peaks* court very briefly stated the more specific *Rogers* test, but *dropped* the word “explicitly,” finding artistic relevance and then stating: “the question then is whether

the title is *misleading* in the sense that it induces members of the public to believe the Book was prepared or otherwise authorized by TPP.” *Id.* (emphasis added). The court explained that this determination “must be made, in the first instance, by application of the venerable *Polaroid* factors,” (the Second Circuit’s factors for likelihood of confusion initially articulated by Judge Friendly), with the modification that “the finding of likelihood of confusion must be *particularly compelling* to outweigh the First Amendment interest recognized in *Rogers*.” *Id.* at 1379 (emphasis added).

This formulation of the *Rogers* balancing framework has subsequently been generally applied in the Second Circuit, although courts sometimes use the words “sufficiently compelling” instead of “particularly compelling.” *See, e.g., Hermes Int’l v. Rothschild*, 2022 U.S. Dist. LEXIS 89799, at \*14-15 (S.D.N.Y. May 18, 2022) (Rakoff, J.) (“in considering explicit misleadingness under the *Rogers* balancing test, the Court should consider the *Polaroid* factors to determine whether the likelihood of confusion is sufficiently compelling to outweigh the public interest in free expression”) (citing *Twin Peaks*, 996 F.2d at 1379). As explained in a recent case, “the most important difference between the *Rogers* consumer confusion inquiry and the classic consumer confusion test is that consumer confusion under *Rogers* must be clear and unambiguous to override the weighty First Amendment interests at stake.” *Hermes Int’l v. Rothschild*, 22-cv-384 (JSR), D.I. 140, \*23 (S.D.N.Y. Feb. 02, 2023).

Judge Newman, and the Second Circuit generally, thus apparently came around to agree at least in part with Judge Griesa's opinion that the explicit versus implicit distinction would prove unworkable and was not a sound general basis for determining the scope of First Amendment protection in trademark law. This is not actually inconsistent with original *Rogers* opinion, which set out a more flexible balancing of the public interest in free expression against the public interest in avoiding consumer confusion as the more general test, and proposed the explicitly misleading formulation only as a suggestion as to how this balancing would "normally" work out in the very specific context of titles using celebrity names. The Court here should similarly recognize that "explicitly misleading" is not a workable general test for balancing free expression protections with potential confusion.

## **II. Even The Ninth Circuit Often Considers Likelihood Of Confusion Factors While Purportedly Applying The Explicitly Misleading Test**

Although the Second Circuit has backed away from the "explicitly misleading" formulation of *Rogers*, the Ninth Circuit still purportedly applies it. But when analyzing whether an expressive use of a mark is "explicitly misleading," courts in the Ninth Circuit often focus on factors that relate more to whether the defendant's use of the mark is likely to cause confusion. Essentially, the Ninth Circuit has interpreted "explicitly misleading" to mean "very misleading." This

provides evidence that attempting to distinguish between explicit and implicit misleadingness is not a generally workable or coherent approach to balancing trademark rights against free expression.

Indeed the district court in this very case criticized the “explicitly misleading” formulation, observing that it “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.” *VIP Prods. LLC v. Jack Daniel’s Prods.*, 2021 U.S. Dist. LEXIS 2324109, at \*19 (D. Ariz. 2021). *See also id.* (“The likelihood-of-confusion test provided a multi-factor consideration of the effects of a junior use on a senior user’s mark; the explicitly misleading test is unconcerned with the real-world effects on a senior user’s mark.”).

Another district court in the Ninth Circuit recently held that the allegedly artistic use of a mark at issue was in fact explicitly misleading. *See Yuga Labs, Inc. v. Ripps, et al.*, No. 2:22-cv-04355-JFW-JEM, D.I. 62, at \*7 (C.D. Cal. Dec. 16, 2022) (“even if the Court applied the *Rogers* test and concluded that the BAYC Marks are artistically relevant, the Court concludes that Defendants’ use of the BAYC marks is explicitly misleading”). In doing so the court explained that courts in the Ninth Circuit consider two sub-factors in determining whether the use of a mark is explicitly misleading: “(1) ‘the degree to which the junior user uses the mark in the same way as the senior user’; and (2) ‘the extent to which the junior user has added his or her own expressive content to the work beyond the

mark itself.’” *Id.* (quoting *Gordon v. Drape Creative*, 909 F.3d 261, 270-71 (9th Cir. 2018)).

The first subfactor, the degree to which the marks are used in the same way, would seem to be encompassed in the likelihood of confusion analysis, generally on the similarity of the marks and similarity of the goods factors. The second subfactor seems to look at whether the use is transformative, which sounds more like a copyright fair use analysis, but could also be considered in likelihood of confusion. *See, e.g., Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994). The notion of transformative use is also sometimes used in balancing free expression against rights of publicity. *See, e.g., Hart v. Electronic Arts*, 717 F.3d 141, 158 (3d Cir. 2013) (explaining that some courts have “imported the concept of ‘transformative’ use from copyright law into the right of publicity context”) (discussing *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387 (Cal. 2001)). In any event, neither of the two subfactors seem focused on the question of explicit misleadingness, suggesting again that this is not in fact the relevant question.

The Ninth Circuit (in *E.S.S.*) has also extended the *Rogers* doctrine from its original context of titles to cover the content of expressive works, finding “no principled reason why it ought not also apply to the use of a trademark in the body of the work.” *See E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008). Unlike the Second Circuit, which has extended the general *Rogers* balancing framework but not the specific explicit misleadingness test, the Ninth

Circuit has at least purportedly extended the explicit misleadingness test as well.

However, the *E.S.S.* case provides another example of how courts in the Ninth Circuit often consider factors sounding more in confusion when purportedly applying the explicit misleadingness prong of *Rogers*. The case involved the video game “Grand Theft Auto,” set in the fictional cities Los Santos, San Fierro, and Las Venturas, which are stylized versions of Los Angeles, San Francisco, and Las Vegas, respectively. *See id.* at 1097. The trademark suit centered around a virtual strip club in the game called “Pig Pen” in “East Los Santos,” which was loosely based on the actual strip club in East Los Angeles called “Play Pen Gentlemen’s Club.” *See id.* The Ninth Circuit affirmed the district court’s grant of summary judgment in favor of the defendants under the *Rogers* doctrine, because it found the strip club artistically relevant to the video game, and not explicitly misleading. *See id.* at 1101.

On the explicitly misleading prong, the court found it unlikely that “the Game would confuse its players into thinking that the Play Pen is somehow behind the Pig Pen or that it sponsors Rockstar’s [Grand Theft Auto] product.” *Id.* The court’s observation that consumers are highly unlikely to be confused into thinking that “a company that owns one strip club in East Los Angeles . . . also produces a technologically sophisticated video game,” *id.* at 1100-01, seems correct, but it also suggests that the truly relevant question is whether there is a sufficient likelihood of



confusion. The relevant question is not whether any misleadingness is explicit versus implicit.

Other cases in the Ninth Circuit similarly look at factors sounding in confusion when purportedly applying the “explicitly misleading” prong of *Rogers*. See, e.g., *Gordon*, 909 F.3d 261. These cases thus seem to validate Judge Griesa’s concern in his *Rogers* concurrence that the explicitly versus implicitly misleading distinction would prove unworkable, see *Rogers*, 875 F.2d at 1007 (Griesa, J., concurring), as even the Ninth Circuit does not really focus on the distinction, despite purporting to do so.

### **III. Most Other Circuits Have Declined To Adopt The Ninth Circuit’s Rigid Explicit Misleadingness Approach**

The Fifth Circuit has also adopted *Rogers*, and appears to have followed the lead of the Second Circuit in moving away from the “explicitly misleading” inquiry, in favor of requiring a particularly compelling likelihood of confusion to outweigh the public interest in free expression where use of the mark is relevant to an artistic or parodic work. See *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 667-68 (5th Cir. 2000) (“Westchester’s First Amendment interest in choosing a title for its magazine requires a particularly compelling likelihood of confusion.”). The *Westchester* case involved an allegedly infringing literary title (“POLO Magazine”), but the court nevertheless affirmed the lower court’s finding of a particularly

compelling likelihood of confusion, pointing to evidence that defendant's intent was to trade on the goodwill and reputation of the mark owner's clothing brand, as well as survey evidence of actual confusion and evidence that the products "target the same consumers and on occasion use the same retail outlets." *Id.* at 668.

The other two circuits to have adopted the *Rogers* doctrine, the Sixth and Eleventh Circuits, appear to apply the explicitly misleading requirement more rigidly, even outside the context of titles, though in both circuits the doctrine is relatively undeveloped. See *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 937 (6th Cir. 2003); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012).

The Third, Fourth, Seventh, Eighth, and Tenth Circuits have not adopted the more specific *Rogers* doctrine (requiring no artistic relevance or explicitly misleadingness) despite having had opportunities to do so, and have offered some criticism and skepticism of at least the strongest versions the doctrine, such as suggesting that it may be unnecessary because the likelihood of confusion test itself can sufficiently account for First Amendment interests.

The Fourth Circuit has suggested that a proper application of the Lanham Act should generally be enough to protect free speech. See *Radiance Found., Inc v. N.A.A.C.P.*, 786 F.3d 316, 321-22 (4th Cir. 2015) ("The Lanham Act and First Amendment may be in tension at times, but they are not in conflict so long as the Act hews faithfully to the purposes for which it was

enacted.”). The Fourth Circuit has reasoned that when marks are “used to parody, satirize, criticize, comment or compare,” that use should be considered in the application of the likelihood of confusion test, generally weighing against confusion. *Id.* at 324-25.

For example, in *Louis Vuitton*, the Fourth Circuit found that dog toys loosely resembling small Louis Vuitton handbags were not likely to confuse consumers into thinking that they were made or sponsored by Louis Vuitton, in part because the dog toys were “successful parodies of LVM handbags and the LVM marks and trade dress.” *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 258-63 (4th Cir. 2007). The court explained that a “parody relies upon a difference from the original mark, presumably a humorous difference, in order to produce its desired effect,” such that although a finding of parody is not dispositive as to likelihood of confusion, “an effective parody will actually diminish the likelihood of confusion, while an ineffective parody does not.” *Id.* at 260-61.

The Third Circuit has similarly suggested that *Rogers* may be unnecessary, stating that “the Lanham Act customarily avoids violating the First Amendment, in part by enforcing a trademark only when consumers are likely to be misled or confused by the alleged infringer’s use.” *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3rd Cir. 2008).

The Tenth Circuit has also suggested that the more specific *Rogers* test is unnecessary because trademark law already has a “built-in mechanism” to avoid

First Amendment concerns, in that “the Lanham Act requires proof of a likelihood of confusion, but, in the case of a good trademark parody, there is little likelihood of confusion, since the humor lies in the difference between the original and the parody.” *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996). A district court in that circuit has criticized the test as “needlessly rigid and failing to account for the realities of each situation.” *Stouffer v. Nat’l Geographic Partners, LLC*, 460 F. Supp. 3d 1133, 1143 (D. Colo. 2020).

The Eighth Circuit has applied the more general balancing of public interest in free expression versus public interest in avoiding confusion, but has not applied the more specific *Rogers* test of no artistic relevance or explicitly misleading, and has made clear that courts should consider the likelihood of confusion prior to considering whether the First Amendment bars trademark protection. See *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 775-76 (8th Cir. 1994). This is consonant with the approach of the Seventh Circuit, which found it “unnecessary to consider possible constitutional defenses to trademark enforcement” in a case where the complaint had failed to allege likelihood of confusion as to source, and “any such allegation would be too implausible to support costly litigation.” *Eastland Music Group, LLC v. Lionsgate Entm’t, Inc.*, 707 F.3d 869, 871 (7th Cir. 2013).

#### **IV. This Court Should Clarify That Likelihood Of Confusion Is Ultimately A Question Of Law, Especially When Balanced Against Free Expression**

The central issue in trademark law is whether the allegedly infringing items are likely to confuse a substantial number of consumers into incorrectly thinking that the items in question originated from or were endorsed by the trademark holder. This inquiry upholds the basic purposes of trademark law, which are to protect the brand and established goodwill of trademark holders against free riders, and to protect the public against confusion, primarily as to the source of goods and services. *See Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985).

It is sometimes argued that easy dismissal under *Rogers* is necessary because litigating likelihood of confusion to trial would prove prohibitively costly for some artistic defendants. *See, e.g., Hermes Int'l v. Mason Rothschild*, Memorandum of Law in Support of Defendant Mason Rothschild's Motion to Dismiss the Complaint, No. 22-cv-00384-AJN-GWG, D.I. 17 at \*7 (S.D.N.Y. Feb. 9, 2022) ("If the rule required extensive factfinding before upholding artistic freedom, then a trademark owner would be able to deter speech by the threat of a lawsuit, even an unsuccessful one.") (citing William McGeeveran, *The Imaginary Trademark Parody Crisis (and the Real One)*, 90 WASH L. REV. 713 (2015), as "describing the prohibitive costs of going through litigation on likelihood of confusion, even when the defendant is likely to prevail"). But this

concern could be substantially mitigated without using the inappropriate “explicitly misleading” formulation if the Court were simply to clarify that likelihood of confusion is a question of law.

The question courts are ultimately asking is not a binary “is confusion likely or not.” The ultimate question is rather: is confusion likely *enough* to justify a claim for trademark infringement. Recognizing this as a question of law based on underlying facts would bring likelihood of confusion in line with similarly central and often dispositive inquiries in patent law and copyright, obviousness and fair use respectively, which this Court has made clear are both questions of law based on underlying facts. *See, e.g., KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007) (“The ultimate judgment of obviousness is a legal determination.”); *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1199 (2021) (“the ultimate question whether those facts showed a ‘fair use’ is a legal question”).

In clarifying that the ultimate question of fair use is one of law, this Court recently explained that the question “primarily involves legal work,” although certainly it may “involve determination of subsidiary factual questions.” *See Google*, 141 S. Ct. at 1200. Similarly, although likelihood of confusion involves some underlying factual inquiries (such as evidence of actual confusion) some factors involve primarily legal work, as does the ultimate balancing of the factors. For example, evaluating the strength or distinctiveness of the mark on the *Abercrombie* scale involves primarily legal work. *See, e.g., Two Pesos, Inc. v. Taco Cabana*,

*Inc.*, 505 U.S. 763, 768 (1992) (“following the classic formulation set out by Judge Friendly, [trademarks] may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful”) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)); *Guthrie Healthcare Sys. v. ContextMedia, Inc.*, 826 F.3d 27, 37-38 (2d Cir. 2016) (“[W]e have recognized that the assessment of some of the *Polaroid* [likelihood of confusion] factors may involve issues of law. This is particularly so for determinations as to whether the senior user’s mark is sufficiently fanciful or arbitrary in relation to the senior user’s area of commerce to be deemed a strong mark, or in contrast, merely identifies or describes the senior user’s commerce so as to be unenforceable or weak. . . .”). Like fair use, the *Abercrombie* scale for trademark distinctiveness was “originally a concept fashioned by judges,” *Google*, 141 S. Ct. at 1200, as were the multi-factor balancing tests that each circuit has developed for evaluating likelihood of confusion. Indeed, in the Second Circuit, both sets of factors (*Abercrombie* and *Polaroid*) originated from Judge Friendly.

Like fair use, the question of whether confusion is likely *enough* to find trademark infringement often can involve policy judgments, especially when adapting the test for new technologies. For example, multiple cases are currently before the courts for trademark infringement involving the new technology of NFTs, or non-fungible tokens. See Andrew Michaels, *NFT Litigation is Raising Novel Trademark Questions*, LAW360 (Aug. 17, 2022). One such case involves NFTs for digital

artwork called “MetaBirkins” depicting Birkin bags by Hermes. *See Hermes Int’l v. Rothschild*, 2022 U.S. Dist. LEXIS 89799 (S.D.N.Y. May 18, 2022). If courts start to say that companies have broad trademark rights to NFTs involving virtual depictions of their products, then consumers will begin to expect that any such NFTs were created or endorsed by such companies. In this way consumers’ expectations and likelihood of confusion can be shaped by what courts decide. At this point, given how new NFTs are, consumers may not have much of an idea what to expect. Such policy implications counsel further in favor of treating the inquiry ultimately as one of law.

Circuit courts are currently split on this important question. *See Ann Bartow, Likelihood of Confusion*, 41 SAN DIEGO LAW REVIEW 721, 748 (2004). The Second Circuit takes what seems like the correct approach, treating some individual factors as factual but others as legal and the ultimate question of balancing them as legal. *See, e.g., Car-Freshner Corp. v. Am. Covers, LLC*, 980 F.3d 314, 326 (2d Cir. 2020) (“In a trademark infringement case, we review *de novo* a ruling on whether the plaintiff has shown a likelihood of confusion because we consider the issue to be a question of law.”).

The Federal Circuit and the Sixth Circuit also follow this approach. *See, e.g., Champions Golf Club, Inc. v. The Champions Golf Club, Inc.*, 78 F.3d 1111, 1116, 38 U.S.P.Q.2d 1161 (6th Cir. 1996) (“We apply a clearly erroneous standard to the district court’s findings of fact supporting the likelihood of confusion factors, but



review de novo the legal question of whether those foundational facts constitute a ‘likelihood of confusion.’”); 2 GILSON ON TRADEMARKS § 8.05 (explaining that the Federal Circuit “reviews the Trademark Trial and Appeal Board’s ultimate conclusion on likelihood of confusion de novo, categorizing it as a question of law”).

However, some circuits – indeed a majority of them, including the Ninth Circuit – consider the ultimate question of likelihood of confusion one of fact. *See, e.g., Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1355 (9th Cir. 1985) (en banc); *Equine Techs., Inc. v. Equitechnology, Inc.*, 68 F.3d 542, 546, 36 U.S.P.Q.2d 1659 (1st Cir. 1995) (“The determination as to whether a likelihood of confusion exists is a question of fact, which we review only for clear error.”); *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007 (3d Cir. 2008) (“likelihood of confusion is a question of fact”); *Shakespeare Co. v. Silstar Corp.*, 110 F.3d 234, 241, 42 U.S.P.Q.2d 1266 (4th Cir. 1997); *Sunbeam Prods. Inc. v. West Bend Co.*, 123 F.3d 246, 257, 44 U.S.P.Q.2d 1161 (5th Cir. 1997); *Board of Regents of the Univ. of Wisconsin Sys. v. Phoenix Int’l Software, Inc.*, 653 F.3d 448, 452, 99 U.S.P.Q.2d 1571 (7th Cir. 2011); *Heartsprings, Inc. v. Heartspring, Inc.*, 143 F.3d 550, 553 (10th Cir. 1998); *Frehling Enters., Inc. v. Intl’ Select Grp., Inc.*, 192 F.3d 1330, 1335 (11th Cir. 1999).

Even within circuits, courts can be inconsistent on which approach they take to this fundamental question. *See, e.g., ConAgra, Inc. v. George A. Hormel & Co.*, 990 F.2d 368, 370-71 (8th Cir. 1993).

This case provides an excellent opportunity for this Court to clarify that likelihood of confusion is ultimately a question of law, correcting the approach taken by the majority of circuits and the court below. Even if the Court does not feel comfortable making this general clarification here, it could still more narrowly clarify that in cases such as this one where the First Amendment is implicated, the question of whether the likelihood of confusion is sufficient to outweigh the relevant public interest in free expression is a question of law. This important clarification would facilitate early dismissal of unmeritorious cases against struggling artists without requiring the inappropriate “explicitly misleading” formulation of *Rogers*.

**V. The Respondent Should Prevail In This Case Because There Is Not A Sufficiently Compelling Likelihood Of Confusion As A Matter Of Law**

If, as argued above, the Court were to clarify that likelihood of confusion is an issue of law, and adopt the Second Circuit’s approach of requiring a “sufficiently compelling” case for confusion to outweigh the free expression interests at stake, it could also easily hold that as a matter of law there is no such compelling case for confusion here.

The test for likelihood of confusion unfortunately varies by circuit, but there are 5 or 6 “core” factors that can be found in most of the tests and are substantively the primary factors that courts consider:

- (1) The strength of the plaintiff's trademark;
- (2) The degree of similarity between the plaintiff's and defendant's products;
- (3) The degree of similarity in the marks used by the plaintiff and defendant;
- (4) Whether the defendant's intent is to cause confusion (bad faith);
- (5) Evidence of actual confusion;
- (6) The degree of care exercised by the relevant purchasers.

*See* Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIFORNIA LAW REVIEW 1581, 1646-47 (2006). Almost every factor has been referred to, at one time or another, as the "most important" factor. *Id.* at 1583. There is thus a fair amount of confusion surrounding likelihood of confusion, even though it lies at the very heart of trademark law. *See* Bartow, *Likelihood of Confusion*, 41 SAN DIEGO LAW REVIEW at 749 ("Predictably, the diverging viewpoints in this area have produced a muddled body of case law, characterized by such inconsistency among and within the circuits that it has become difficult to predict how a court will deal with a particular case.") (quoting Jane C. Ginsburg et al., TRADEMARK AND UNFAIR COMPETITION LAW 419 (3d ed. 2001)).

Nevertheless, it seems clear enough that there is not a particularly compelling case for confusion here. The products are very different, dog toys versus whiskey, so this factor should weigh strongly against

confusion. *See, e.g., Kellogg Co. v. Toucan Golf, Inc.*, 337 F.3d 616, 624 (6th Cir. 2003) (finding the mark “Toucan Gold” for golf equipment not confusingly similar to Kellogg’s “Toucan Sam” for cereal largely because “if the products are unrelated, confusion is highly unlikely”); Beebe, 94 CAL. L. REV. at 1632 (“in all opinions, regardless of posture, in which the proximity [of the products] factor was found to disfavor a likelihood of confusion, the plaintiffs’ [likelihood of confusion] multifactor test win rate was exceedingly low”). The district court’s finding that “Jack Daniel’s licensed its trademark and trade dress rights for use with certain dog products,” 291 F. Supp. 3d at 910, should not have been used to find that this factor weighed in favor of confusion. *See Kellogg*, 337 F.3d at 625 (“Kellogg’s presence in the golf industry was insignificant, and nothing more than a marketing tool to further boost sales of its cereal”).

The marks are somewhat similar but not identical; VIP used the name “Bad Spaniels” rather than “Jack Daniel’s” and embedded various jokes on the dog toy, making it fairly clear that the dog toys were parodies. Courts have found marks more similar to be distinct enough to avoid likely confusion, even where the products are far more similar than they are here. *See, e.g., Streetwise Maps, Inc. v. Vandam, Inc.*, 159 F.3d 739, 744 (2d Cir. 1998) (finding that the two marks “Streetwise” and “StreetSmart,” both for use on street maps, were “not confusingly similar, given the context in which a purchaser sees them”).

The defendant's intent was not to cause confusion, but rather was to create a humorous parody. On this point, the district court in this case committed legal error by finding that the factor favored Jack Daniel's. *See VIP Prods., LLC v. Jack Daniel's Props.*, 291 F. Supp. 3d 891, 908 (D. Ariz. 2018) ("It is undisputed that in designing and marketing 'Bad Spaniels,' VIP's intent was to copy the Jack Daniel's trademarks and trade dress for the purpose of parody. . . . Thus, the intent factor favors Jack Daniel's."). Although VIP's intent was in fact to create a parody, the intent was not to cause confusion; indeed a successful parody will generally not cause confusion. *See Cliffs Notes, Inc.*, 886 F.2d at 494 ("A parody must convey two simultaneous – and contradictory – messages: that it is the original, but also that it is not the original and is instead a parody. To the extent that it does only the former but not the latter, it is not only a poor parody but also vulnerable under trademark law, since the customer will be confused."). Indeed various courts in various circuits have recognized that "[a]n intent to parody is not an intent to confuse the public." *Jordache Enterprises, Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1486 (10th Cir. 1987); *see also Louis Vuitton*, 507 F.3d at 263 ("Despite Haute Diggity Dog's obvious intent to profit from its use of parodies, this action does not amount to a bad faith intent to create consumer confusion. To the contrary, the intent is to do just the opposite – to evoke a humorous, satirical association that *distinguishes* the products.").

Although Jack Daniel's is a strong mark, the weight given to this factor should be diminished in the

case of a parody, for it “is a matter of common sense that the strength of a famous mark allows consumers immediately to perceive the target of the parody, while simultaneously allowing them to recognize the changes to the mark that make the parody funny or biting.” *Louis Vuitton*, 507 F.3d at 261 (citing *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 416 (S.D.N.Y. 2002)).

Courts sometimes have a tendency to place undue weight on the seemingly more empirical survey evidence of actual confusion, without adequately recognizing that this is just one factor and that the percentage number found can be manipulated, for example depending on how one asks the question to consumers. The district court below, in finding likelihood of confusion, relied heavily on survey results that found that 29% of purchasers were likely confused. See *VIP Prods.*, 291 F. Supp. 3d at 908. Although this might be enough to favor likelihood of confusion in some cases, it should not be enough to establish a sufficiently compelling case for confusion in this case, especially given that many of the other factors should weigh against confusion. Indeed in the *Rogers* case, there was survey evidence indicating a higher rate of confusion, but the court nevertheless found no trademark infringement. See *Rogers*, 875 F.2d at 1001 and n.8 (noting that “38 percent responded ‘yes’ to the question ‘Do you think that the actress, Ginger Rogers, had anything to do with this film,’” but finding “that risk of misunderstanding, not engendered by any overt claim in the title, is so outweighed by the interests in artistic

expression as to preclude application of the Lanham Act”).

Buyers of dog toys are unlikely to think they are buying whiskey, and probably would not give much thought to or be confused about whether the obviously parodic dog toy they are buying was officially endorsed by the Jack Daniel’s company or not. *Cf. Streetwise*, 159 F.3d at 746 (“due to the fact that the subject maps were rarely offered for sale at the same place and were generally impulse purchases, any lack of sophistication among buyers could not contribute to confusion between the two maps”).

In light of the major differences between the products, the differences in the marks, and the defendant’s clear parodic intent, this Court could find no likelihood of confusion here. *See Louis Vuitton*, 507 F.3d at 262 (affirming a summary judgment that the “differences are sufficiently obvious and the parody sufficiently blatant that a consumer encountering a ‘Chewy Vuiton’ dog toy would not mistake its source or sponsorship on the basis of mark similarity.”).

And as a matter of law, there is even more clearly no case for confusion sufficiently compelling to outweigh the First Amendment parodic free expression interests at stake. *See, e.g., Cliffs Notes*, 886 F.2d at 495-96 (finding that the lower court erred as a matter of law in finding a strong enough likelihood of confusion to outweigh the public interest in parodic free expression, “especially in a form of expression that must to some extent resemble the original”); *Groucho Marx*

*Prod., Inc. v. Day and Night Co.*, 689 F.2d 317, 319 n.2 (2d Cir. 1982) (recognizing “the broad scope permitted parody in First Amendment law”).

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### CONCLUSION

The Court should reject the Ninth Circuit’s rigid “explicitly misleading” approach to balancing trademark rights with the First Amendment, and instead adopt Second Circuit’s approach of requiring a sufficiently compelling case for likelihood of confusion to outweigh the relevant free expression interests. The Court should also clarify that this inquiry is ultimately a question of law, and find that as a matter of law, petitioners have not established a sufficiently compelling case for confusion here to outweigh the important public interest in parodic free expression.

Respectfully submitted,

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