

No. 22-148

IN THE
Supreme Court of the United States

JACK DANIEL'S PROPERTIES, INC.,

Petitioner,

v.

VIP PRODUCTS LLC,

Respondent.

On Writ of Certiorari to the United States
Court of Appeals for the Ninth Circuit

**BRIEF OF AMICI CURIAE DAN McCALL,
SKY SHATZ, AND DON STEWART
IN SUPPORT OF RESPONDENT**

PAUL ALAN LEVY

Counsel of Record

SCOTT L. NELSON

PUBLIC CITIZEN

LITIGATION GROUP

1600 20th Street NW

Washington, DC 20009

(202) 588-1000

plevy@citizen.org

Attorneys for Amici Curiae

McCall, Shatz, and Stewart

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INTEREST OF AMICI CURIAE¹

Amici curiae are three individuals who have created and sold products featuring parodies of or artistic variations on trademarked products.

Amicus curiae Dan McCall is an artist and designer who, doing business as Liberty Maniacs, creates and sells t-shirts, coffee mugs, cell-phone cases, and other items emblazoned with words and images that address political and cultural issues relating to his libertarian views. The products are displayed and sold on his website, libertymaniacs.com. McCall often employs parody and satire of well-known trademarks to make his point, and he has had to raise First Amendment defenses when the targets of his satire claim exclusive rights to the words and imagery that he has used to express his views.

For example, in 2013, McCall created a series of t-shirt designs that criticized the National Security Agency (NSA) and Department of Homeland Security (DHS), using versions of their official seals in which he replaced the agencies' slogans with phrases such as "Peeping While You're Sleeping," "The Only Government Agency That Really Listens," and "Department of Homeland Stupidity." *E.g.*, <https://libertymaniacs.com/products/the-nsa-tri-blend-t-shirt>. DHS and NSA threatened McCall with prosecution under trademark-like statutes that forbid the use of their official seals, or altered versions of their seals, without permission. *See* 50 U.S.C. § 3613; 18 U.S.C. §§ 506, 701 &

¹ This brief was not authored in whole or part by counsel for a party. No one other than amici curiae and their counsel made a monetary contribution to preparation or submission of the brief.

1017. After McCall sought a declaratory judgment of non-infringement, both agencies retracted their threats and agreed to pay his court costs. *See McCall v. Nat'l Security Agency*, No. PWF-13-3203 (D. Md. Feb. 8, 2014).

Similarly, in 2014, McCall created a t-shirt design that mocked the slogan “Ready for Hillary” by placing the slogan “Ready for Oligarchy” in the same font that a Super PAC calling itself “Ready for Hillary” was using to promote her intended candidacy for president. *See* <https://libertymaniacs.com/products/im-ready-for-oligarchy-tshirt>. The Super PAC sent demand letters claiming infringement to the print-to-order companies through which McCall was selling t-shirts bearing the design. McCall responded by warning the Super PAC that he would seek a declaratory judgment of non-infringement unless the threat of litigation were promptly retracted. The Super PAC retracted its threat.

Amicus curiae Sky Shatz is a t-shirt designer who does business as SkyGraphx.com, selling shirts, hats, and decals printed with designs he creates. He describes his shirts as displaying “shocking imagery with a positive message.” About Us, <https://skygraphx.com/pages/about>. One of his shirts criticized Marlboro cigarettes through an image that used a parody of the well-known Marlboro cigarette package. Shatz’s version had red paint dripping down the side; he replaced the words “filter cigarettes” with “population filter” and superimposed the word “Death” across the bottom. *See* <https://skygraphx.com/products/population-filter-t-shirt>. In 2014, Philip Morris threatened to sue him for infringing its trademark, but retracted the demand after Shatz asserted his First Amendment right to parody the company through its mark.

Claiming that it had not previously understood that the use was intended as parody, the company withdrew its demand.

Amicus curiae Don Stewart is an artist who creates art works in the form of visual puns in which the overall theme is represented by component parts reflecting a different sense of the same word. For example, a drawing entitled “Baby Grand Piano” shows a “Stainway” piano composed of baby toys. See <https://dsart.com/shop/ols/products/baby-grand-piano>. In 1992, he developed a drawing in the shape of the Volkswagen Beetle but made up of insect parts. See <https://dsart.com/shop/ols/products/vw-bug>. Stewart also offered his design of the VW bug for sale on a t-shirt. In 2006, Volkswagen sent Stewart a demand letter, threatening to sue him under the Lanham Act for infringing and diluting its trademark. Stewart refused, citing his First Amendment right to use the mark in his products. Although Volkswagen disputed his contention, public criticism of its threat apparently dissuaded it from filing suit.

The standard articulated in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), providing First Amendment protection for expressive uses of words and images that might otherwise give rise to liability under the Lanham Act, is critical to the ability of amici to engage in protected speech without incurring liability. The abrogation of the *Rogers v. Grimaldi* test, as advocated by petitioner Jack Daniel’s Properties, would make it more difficult and costly for amici, and people like them who sell items that convey expressive messages using trademarks, to defend themselves against abusive trademark claims. Amici worry that under the standards advocated by Jack Daniel’s and its amici, the cost of defending parodies against claims of

trademark infringement could make even a successful defense a pyrrhic victory, as judgment for the defendant could be accompanied by insolvency.

Moreover, amici’s interests would be harmed if only the creators of books, movies, and framed art works could invoke *Rogers v. Grimaldi*—that is, if the test does not apply to the placement of trademark parodies on “ordinary commercial products,” as Jack Daniel’s contends in Part I.B of its brief. The t-shirts, coffee mugs, and other items that amici sell are “ordinary commercial products,” but they are not marketed just to keep consumers warm or hold coffee. Rather, they are sold to consumers who want to embrace the views that amici express through their parodies. Amici file this brief to urge the Court to recognize that the First Amendment constrains trademark law as applied to the fully protected speech that their designs express and to reject Jack Daniel’s attack on the *Rogers v. Grimaldi* test, which properly construes the Lanham Act to avoid needless inhibition of free speech rights.

SUMMARY OF ARGUMENT

Jack Daniel’s in its petition for a writ of certiorari focused on a claimed conflict among the circuits over whether the *Rogers v. Grimaldi* test, which had been accepted for at least some forms of expression by all the lower courts that had addressed the issue, should be limited to uses of trademarks in inherently expressive works such as books, movies, and songs, as opposed to expressive uses of trademarks on ordinary “commercial products” such as those of respondent VIP Products. Pet. i, 18–24. In its merits brief, however, Jack Daniel’s devotes the bulk of its argument to an attack on the *Rogers v. Grimaldi* standard itself—an issue on which there is no division among the lower

courts. Jack Daniel’s now contends that the test is a nontextual gloss on the Lanham Act. The application of the test to “utilitarian products,” the subject of the claimed circuit split that Jack Daniel’s invited the Court to resolve, receives less than two pages of argument at the end of part I of the brief. The United States’ amicus brief likewise exclusively addresses the broader question whether *Rogers v. Grimaldi* is correct.

In light of this change of emphasis, this amicus brief begins by addressing the reasons for the *Rogers v. Grimaldi* standard and the serious First Amendment questions that, in its absence, would arise from the application of the Lanham Act’s infringement provisions, 15 U.S.C. §§ 1114 & 1125(a), to the use of trademarks in fully protected speech—including speech incorporated in works and products sold commercially. This Court has repeatedly held that the First Amendment constrains the Lanham Act, rendering unconstitutional sections of the statute that authorize viewpoint discrimination in determinations of what trademarks may be issued. So, too, administrative agencies must construe the statute and adjudicate disputes about infringement of trademarks in conformity with the First Amendment. And a long line of authority from this Court recognizes that the First Amendment limits courts’ issuance of injunctive relief and awards of damages.

The legal standard set forth by the Lanham Act allows courts to forbid or remedy expression that is not false but only “misleading” or “likely to cause confusion.” That standard coexists uneasily with the constraints that the First Amendment imposes on restrictions of fully protected speech—which, as this Court has repeatedly held, includes expression

regarding noncommercial matters even when the speaker receives money for the sale of goods or services containing the expression.

The *Rogers v. Grimaldi* standard protects against trademark claims directed at fully protected speech when the use of a trademark is relevant to the speaker's noncommercial message and does not explicitly mislead consumers about the source or content of the expression. See Pet. App. 30a. To be sure, that standard nowhere appears in the statutory text, but neither do the factors that guide the likelihood-of-confusion analysis that Jack Daniel's and the United States as amicus curiae advocate to replace the *Rogers* standard. See U.S. Br. 15–16; see *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961) (setting forth factors). The “overlapping lists of likelihood-of-confusion factors” used by the courts of appeals and the United States Patent and Trademark Office, U.S. Br. 16, are based on years of judicial experience deciding whether a junior user has improperly used a trademark that is confusingly similar to a senior user's mark in circumstances where there is no suggestion that the junior user was trying to comment on or parody the mark. The factors are not easily applied to parody cases. In contrast, the *Rogers v. Grimaldi* standard has developed as the test applied when a mark is used for noncommercial expression. Although Jack Daniel's had strong arguments that the district court should not have granted summary judgment against it on whether it could satisfy the *Rogers* standard, it waived that argument by not pursuing it on appeal.

Finally, as an alternative to its request that the Court overrule *Rogers v. Grimaldi* altogether, Jack Daniel's, supported by several amici, asks that its application be limited to works that are inherently

expressive. Jack Daniel’s argues that *Rogers* should never be applied to infringement claims against “ordinary commercial products” or “utilitarian products” that use trademarks to parody the trademark owner or the mark itself. But that approach does not sufficiently avoid intrusion on fully protected speech. T-shirts and coffee mugs, and many other items on which expression may be emblazoned, are “utilitarian products” or “ordinary commercial products.” But amici, and many others like them, sell such items based on the noncommercial messages that they convey. Even when those messages use trademarks, they merit full First Amendment protection. For example, this Court and lower courts have repeatedly recognized that clothing can convey noncommercial messages that enjoy full First Amendment protection. Jack Daniel’s contention that the *Rogers v. Grimaldi* standard should apply only to artistic works, or only to songs, books and movies, and should never apply when a trademark is used on an ordinary commercial product, must be rejected.

ARGUMENT

- I. **The *Rogers v. Grimaldi* standard best reconciles the Lanham Act’s prohibition of trademark uses that are “likely to confuse” with the protection that the First Amendment provides to noncommercial speech, even speech about trademarks and trademark holders.**

The Lanham Act is at bottom a consumer protection statute: It helps consumers make informed purchases, “confident that they can identify brands they prefer, made by companies that they prefer, and can purchase those brands without being confused or

misled” about the qualities of the goods they are purchasing. *Two Pesos v. Taco Cabana*, 505 U.S. 763, 784 n.19 (1992) (Stevens, J., concurring). At the same time, because trademarks can be a shorthand way of referring to well-known people and companies, those who want to comment on companies will often use trademarks to identify the subjects of their commentary. The First Amendment protects the right to speak in this way, and the enforcement and application of the Lanham Act is not immune from First Amendment scrutiny. Moreover, unlike the Copyright Act, which contains express statutory exceptions and limitations that largely safeguard the interests in free expression that the First Amendment protects, *Harper & Row v. Nation Enter.*, 471 U.S. 539, 560 (1985), the Lanham Act’s infringement provisions lack such explicit protections, which must therefore be found by express reference to the First Amendment.

That federal trademark law implicates protected speech and is subject to First Amendment limits is well established. In *Matal v. Tam*, 137 S. Ct. 1744 (2017), and *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019), the Court struck down two subsections of 15 U.S.C. § 1052(a), which forbade the issuance of marks that “disparage” or “bring ... into contempt ... persons, living or dead” (*Matal*), and marks that are “immoral or scandalous” (*Iancu*), holding that these prohibitions discriminate based on viewpoint. Similarly, in *In re Elster*, 26 F.4th 1328 (Fed. Cir. 2022), *petition for cert. filed*, No. 22-704 (U.S. Jan. 27, 2023), the Federal Circuit overturned an adjudication by the Trademark Trial and Appeal Board that refused to register a trademark for “Trump Too Small” for use on t-shirts, on the ground that 15 U.S.C. § 1052(c), forbids registration of a mark using the name of a living person

without that person's consent. The court did not find the statutory provision facially unconstitutional because it does not discriminate based on viewpoint. *See* 26 F.4th 1331. Even so, the court held that the Board's application of the provision was unconstitutional as applied because it disfavored private speech by a private party on a controversial subject, and thus had to be subject to careful First Amendment scrutiny. could not withstand such scrutiny. *Id.* at 1333–34. The Federal Circuit held that the adjudication could not withstand such scrutiny. *Id.* at 1338–39.

Courts, like federal agencies, are government bodies whose actions are subject to First Amendment scrutiny. For example, an injunction sought by a private party and directed at speech by a private party is subject to First Amendment limits. *Madsen v. Women's Health Center*, 512 U.S. 753, 762–66 (1994); *Org. for a Better Austin v. Keefe*, 402 U.S. 415, 418–19 (1971). So, too, a suit by a private party seeking damages against another private party invokes government power to award a remedy for private speech and hence is subject to First Amendment scrutiny. *E.g.*, *Snyder v. Phelps*, 562 U.S. 443 (2011); *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988).

That Lanham Act suits such as this one challenge the use of trademarks on items that are for sale does not exempt them from the level of scrutiny applicable to restrictions of noncommercial speech. Speech ordinarily protected by the First Amendment does not lose that protection just “because ... written materials sought to be distributed are sold rather than given away.” *Heffron v. Int'l Soc. for Krishna Consciousness*, 452 U.S. 640, 647 (1981). Indeed, in *New York Times v. Sullivan*, 376 U.S. 254 (1964), the plaintiff sought to hold a newspaper liable for content in a paid

advertisement, contained in a newspaper that was sold to its readers, in an era long before this Court recognized First Amendment protection for commercial speech. No opinion in that case suggested that the newspaper was therefore engaged in commercial speech and hence entitled to a lesser degree of First Amendment protection.

A statutory provision that forbids speech that is not false, but only misleading, rests in an uneasy relationship with the protections usually accorded to noncommercial speech. The concept of regulating speech that has the potential to be misleading, while not being, strictly speaking, false, has developed in the years since this Court first extended First Amendment protection to commercial speech. *Thompson v. Western States Med. Ctr.*, 535 U.S. 357, 367 (2001). Unlike fully protected speech, commercial speech can be regulated even if it is “not provably false, or even wholly false, but only deceptive or misleading,” *Friedman v. Rogers*, 440 U.S. 1, 9 (1979), allowing “regulation ... that might be impermissible in the realm of noncommercial expression,” *id.* at 9 n.9. Thus, although a “company has the full panoply of protections available to its direct comments on public issues, ... there is no reason for providing similar constitutional protection when such statements are made in the context of commercial transactions.” *Bolger v. Youngs Drug Prod. Corp.*, 463 U.S. 60, 68 (1983); *accord Bates v. State Bar of Ariz.*, 433 U.S. 350, 383 (1977) (“[T]he leeway for untruthful or misleading expression that has been allowed in other contexts has little force in the commercial arena.”); *Smith v. United States*, 431 U.S. 291, 318 (1977) (“Although ... misleading statements in a political oration cannot be censored, ... misleading representations in a securities prospectus

may surely be regulated.”); *Young v Am. Mini Theatres*, 427 U.S. 50, 68 & n.31 (1976) (stating that “regulatory commissions may prohibit businessmen from making statements which, though literally true, are potentially deceptive”). Indeed, several amici supporting Jack Daniel’s rest their analysis on the assumption that the Lanham Act is ordinarily free from First Amendment scrutiny because it applies only to commercial speech. See AIPLA Br. 7, 10, 12; Chamber of Commerce Br. 13–15.

To be sure, the First Amendment may not protect the use of a mark “as a source identifier for goods sold in commerce.” U.S. Br. 23. Such speech is commercial and, insofar as such a source identification is false or misleading, unprotected. But it does not follow from that premise that all uses of trademarks on items sold commercially are unprotected by the First Amendment. Indeed, the United States stops well short of arguing that use of trademarks to express views, whether critical or merely humorous, about a trademark’s owner or the mark itself, is not fully protected speech.

This Court’s analysis of Section 110 of the Amateur Sports Act of 1978, 36 U.S.C. § 380, cited by Jack Daniel’s and the United States, see Pet. Br. 30; U.S. Br. 24, illustrates the problem and shows the need for the *Rogers v. Grimaldi* standard. That statute granted broad and exclusive rights to the United States Olympic Committee (USOC) to use the term “Olympics” and the five-ring logo. When the USOC challenged a group’s use of the term “Gay Olympics” to identify its own athletic competition, for which it charged entrance fees and sold various items emblazoned with its chosen moniker, the group asserted a First Amendment defense. This Court upheld the statute on the

ground that “Section 110 primarily applies to all uses of the word ‘Olympic’ to induce the sale of goods or services,” and “the application of the Act to this commercial speech is not broader than necessary to protect the legitimate congressional interest and therefore does not violate the First Amendment.” *San Francisco Arts & Athletics v. U.S. Olympic Comm.*, 483 U.S. 522, 539–40 (1987).

In contrast, when activists used the term “Olympic” in noncommercial speech, creating a poster on the theme, “Stop the Olympic Prison” for a campaign opposing the transformation of the Olympic Village at Lake Placid into a prison, a district court avoided a potential First Amendment problem by reading the statute to apply only to commercial use of a mark to promote a rival product. *See Stop the Olympic Prison v. U.S. Olympic Comm.*, 489 F. Supp. 1112, 1120–21, 1126 (S.D.N.Y. 1980). In *San Francisco Arts & Athletics*, this Court took note of this ruling without suggesting that it was mistaken. 483 U.S. at 536 n.14.

Several circuits have responded to the potential for conflict between the Lanham Act and the First Amendment by protecting from liability wholly non-commercial uses of marks. *See Farah v. Esquire Magazine*, 736 F.3d 528, 541 (D.C. Cir. 2013); *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1052–54 (10th Cir. 2008); *Bosley Med. Inst. v. Kremer*, 403 F.3d 672, 676–77 (9th Cir. 2005); *Taubman Co. v. Webfeats*, 319 F.3d 770, 774 (6th Cir. 2003); *Porous Media Corp. v. Pall Corp.*, 173 F.3d 1109, 1120 (8th Cir. 1999). Other courts have applied the First Amendment to support constructions of the Act that avoid needless impingements on the First Amendment right to engage in expressive speech or to limit the remedies that may be awarded in

trademark litigation. *E.g.*, *Radiance Found. v. NAACP*, 786 F.3d 316, 322–24 (4th Cir. 2015) (construing the phrase “in connection with” goods and services narrowly to avoid First Amendment concerns raised by an infringement claim against an online article criticizing the NAACP); *CPC Int’l v. Skippy*, 214 F.3d 456, 462–63 (4th Cir. 2000) (holding that the First Amendment barred extending a trademark injunction to prohibit the defendant from publicly criticizing the plaintiff’s successful trademark litigation); *Consumers Union v. General Signal Corp.*, 724 F.2d 1044, 1053 (2d Cir. 1983) (holding that “[t]he First Amendment demands use of a disclaimer,” as opposed to an injunction against challenged ads, “where there is a reasonable possibility that it will suffice to alleviate consumer confusion”); *Better Bus. Bureau of Metro. Houston v. Med. Dirs.*, 681 F.2d 397, 404–05 (5th Cir. 1982) (narrowing an injunction to allow truthful statements about the plaintiff’s rating of the defendant).

Similarly, *Rogers v. Grimaldi* and its progeny impose a narrowing construction on the Lanham Act when infringement claims are directed at the expressive, noncommercial speech elements of commercially sold works that use a trademark to make a larger point. *Rogers v. Grimaldi* does not provide a free pass to defendants: A defendant’s use of a trademark must be relevant to the point that it is expressing, and the use must not be explicitly misleading—that is, there must be no deliberate effort to use the mark to confuse consumers about the source or affiliation of the good or service to which it is attached. *See* 875 F.2d at 999–1000. The requirement that a trademark holder show deliberate deception is analogous to the First Amendment requirement that a defamation plaintiff prove that a statement about a public figure was knowingly

false, or at least published with reckless disregard of its truth or falsity. *See N.Y. Times*, 376 U.S. at 280.

Moreover, although the *Rogers v. Grimaldi* standard does not appear in the statutory language, the same is true of the likelihood-of-confusion factors that Jack Daniel's and the United States insist are the only proper means for protecting parodies against infringement claims. *Cf.* 17 U.S.C. § 107 (listing the Copyright Act fair use factors). Rather, the factors are a judicial gloss on the statute, much like the *Rogers v. Grimaldi* standard. They originated in a Second Circuit decision, authored by Judge Friendly, summarizing the considerations that structure decisions about whether rival products using similar identifying terms to designate sources for the rival products were likely to cause confusion, based on that court's experience over the years reviewing infringement actions. *See Polaroid*, 287 F.2d at 495.

In evaluating likelihood of confusion, each circuit applies its own set of factors, often in different ways depending on the type of confusion claim under consideration. Jack Daniel's and the United States note in passing that the thirteen circuits apply "overlapping" lists of factors to decide likelihood of confusion. Pet. Br. 26–27 n.12; U.S. Br. 16. But a cross-circuit empirical study of the application of the likelihood-of-confusion factors found "significant variation among the circuits in the application and outcome of their respective tests" and, indeed, concluded that judges take an early look at the case and decide based on a few factors whether there is a likelihood of confusion and then "stampede" the remaining factors to conform to the test outcome." Barton Beebe, *An Empirical Study of the Multi-Factor Tests for Trademark Infringement*, 94 Calif. L. Rev. 1581, 1581–82 (2006).

Moreover, the likelihood-of-confusion factors have not proved to be a good fit for cases where speakers use a trademark for expression about the mark or the trademark holder. Courts trying to apply the multifactor tests in parody cases turn on their head the most important factors—the ones that typically drive the outcome in a rival-product case. Thus, in a rival-product case not involving parody, the strength of the senior user’s mark and the similarity of the junior user’s mark to the senior user’s mark tend to show likelihood of confusion. *E.g.*, *E.&J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1291–92 (9th Cir. 1992). But in the cases that Jack Daniel’s cites for the proposition that the factors can easily be deployed to defend a genuine parody, the courts say that the strength and close-similarity factors militate *against* confusion. *See Louis Vuitton v. Haute Diggity Dog*, 507 F.3d 252, 261–62 (4th Cir. 2007); *Tommy Hilfiger Licensing v. Nature Labs*, 221 F. Supp. 2d 410, 416–17 (S.D.N.Y. 2002). Similarly, in a rival-products case not involving parody, the junior user’s deliberate use of a term for its product closely resembling the senior user’s mark is treated as supporting a likelihood of confusion. *See, e.g.*, *E.&J. Gallo Winery*, 967 F.2d at 1293. But when a trademark is used expressively to comment on the senior user (including by poking fun), deliberate use of a similar mark reflects an intent to parody and not to confuse, and supports a finding of no confusion. *E.g.*, *Haute Diggity Dog*, 507 F.3d at 263; *Tommy Hilfiger*, 221 F. Supp. at 419–20. Nonetheless, consumer surveys through which trademark owners litigating parody cases under multi-factor tests seek to demonstrate “actual confusion,” like the survey in this case, may neglect to test what fraction of the respondents understand the joke.

Displacing the *Rogers v. Grimaldi* standard with the likelihood-of-confusion factors as the sole protection for expressive uses of trademarks also overlooks that trademark litigation can be extraordinarily expensive when it proceeds to discovery, cross-motions for summary judgment, and trial on the likelihood-of-confusion factors. Trademark infringement claimants commonly hire experts to conduct consumer surveys, and survey costs alone can run into six figures. An alleged infringer may have little choice but to bear the expense of responding in kind, because if a defendant's expert does not do his own survey, many district judges will discount his objections to the plaintiff's survey, as happened here. See Pet App. 68a–69a. According to a biennial survey of the costs of intellectual property litigation published by amicus AIPLA, the average cost of litigating an infringement case in 2015 was \$325,000 even for the category of cases with the least amount of money at risk; with higher monetary stakes, the average cost can run into the millions. Glynn Lunney, *Two-Tiered Trademarks*, 25 Hous. L. Rev. 295, 321–22 (2018). A large company can afford to defend the merits of an infringement case, but defendants like amici McCall, Shatz, and Stewart are priced out of court unless they can obtain pro bono representation and, indeed, a pro bono expert. That economic reality puts a high toll on noncommercial speech that offends a well-heeled trademark holder.

For example, in *Louis Vuitton v. My Other Bag*, 156 F. Supp. 3d 425 (S.D.N.Y.), *aff'd*, 674 F. App'x 16 (2d Cir. 2016), a case cited by AIPLA to show the adequacy of the multi-factor test to protect parodists, it took defense counsel more than 1,500 hours to get summary judgment for the maker of parody canvas tote bags and defend that judgment on appeal. Much of that

representation was pro bono because the cost of the litigation outstripped defendant's ability to pay early in the litigation. See Mem. Supporting Renewed Mot. for Award of Att'y Fees at 28–30, *Louis Vuitton v. My Other Bag*, No. 14-cv-03419 (S.D.N.Y. Apr. 7, 2017), ECF No. 154. Similarly, in *Haute Diggity Dog*, cited by Jack Daniel's and several of its amici to show how the multi-factor test protects parody, a tiny company incurred \$300,000 in legal fees to get summary judgment and prevail on appeal. See NBC News, *Louis Vuitton loses 'Chewy Vuiton' Appeal* (Nov. 14, 2007), www.nbcnews.com/id/wbna21793188. And in *Smith v. Wal-Mart Stores*, 537 F. Supp. 2d 1302 (N.D. Ga. 2008), a parodist whose t-shirts attacked Wal-Mart was able to get to summary judgment only because he found pro bono lawyers who worked 500 hours and was able to retain pro bono experts to counter a likelihood-of-confusion survey that purportedly found that nearly half of consumers surveyed thought Wal-Mart was the source of t-shirts using such slogans as “Boycott Wal-Qaeda.” See Mem. Supporting Mot. for Award of Att'y Fees at 15, 18, *Wal-Mart v. Smith*, No. 06-cv-526 (N.D. Ga., May 5, 2008), ECF No. 110-1.

The complexity of modern trademark litigation is a boon for trademark lawyers, but not potential defendants like amici. This Court has previously noted the importance of clear rules in trademark litigation that make it less likely that plaintiffs will bully alleged infringers into submission by bringing strike suits that threaten to impose ruinous litigation costs. See *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 214–15 (2000). *Rogers v. Grimaldi* provides a clear rule that, when applied at an early stage in the litigation, allows defendants who use trademarks for genuinely noncommercial expression to obtain dismissal or

summary judgment without incurring the severe costs that trademark litigation will otherwise impose on their exercise of First Amendment rights.

Not all alleged infringers will benefit from this rule. The view expressed by the district court on remand from the Ninth Circuit—that the *Rogers v. Grimaldi* rule never allows a trademark owner to prevail against an alleged infringer even when there are powerful indications of likely confusion or, indeed, intent to confuse, Pet. App. 19a—is flatly wrong. Both the requirement that the defendant identify noncommercial expression to which the use of the mark is relevant, and the unavailability of the defense where the use of the mark is explicitly misleading about the source of the product or the content of its expression, prevent the overbroad application of the *Rogers v. Grimaldi* test to protect misuse of trademarks in ways that fall outside the protections of the First Amendment. For example, in *Hermès International v. Rothschild*, 2023 WL 1458126 (S.D.N.Y. Feb. 2, 2003), the district court denied summary judgment to the defendant on both prongs of the test, citing, for example, a survey showing an 18 percent net confusion rate. *Id.* at *9. That case resulted in a jury verdict finding infringement. Thus, where the trademark owner’s showing of likely confusion is “sufficiently compelling,” the showing can “outweigh the First Amendment interest recognized in *Rogers*.” *Simon & Schuster v. Dove Audio*, 970 F. Supp. 279, 296, 300 (S.D.N.Y. 1997).

In its brief in the district court after the Ninth Circuit’s initial ruling, Jack Daniel’s itself explained that the *Rogers v. Grimaldi* test is not a get-out-of-jail-free card for deliberate infringers, and it cited several cases in which trademark holders whose claims were held subject to the test nevertheless prevailed at trial

or at some other stage of the case. See Jack Daniel's Br. on Remand at 3, *VIP Prods. v. Jack Daniel's Prods.*, No. CV-14-02057 (D. Ariz. July 16, 2021), ECF No. 302 ("Indeed, plaintiffs can and do prevail on the merits at trial even when defendants invoke *Rogers*."). Jack Daniel's made a strong argument to the district court that it should be able to survive VIP's motion for summary judgment and get to trial on both prongs of the *Rogers v. Grimaldi* test: expressive relevance and explicitly misleading content. *Id.* at 4–18. Jack Daniel's pointed to evidence that many consumers believed that the use of the mark indicated that Jack Daniel's was the source of the product.

Those arguments were properly made to the district court and could have been made on appeal, because, even after a court has decided that *Rogers v. Grimaldi* applies, evidence of likelihood of confusion can come into play in consideration of the "explicitly misleading" element of the test. See *Simon & Schuster*, 970 F. Supp. at 296. Certainly, the 29 percent confusion rate found in this case (assuming the validity of that finding) may have been compelling if Jack Daniel's had argued on appeal that the district court was, at the very least, wrong to grant summary judgment because there were sufficient factual disputes to allow application of the *Rogers v. Grimaldi* standard to go to a jury. But instead of arguing on appeal that it could have prevailed under that standard, Jack Daniel's asked the Ninth Circuit to grant summary affirmance against it because it sought only to create a test case for attacking the standard as a matter of law.

Having chosen that route, Jack Daniel's has waived any right to seek a remand to apply *Rogers v. Grimaldi*. This Court should not, however, assume that plaintiffs who can make a strong showing of

likelihood of confusion are doomed under the *Rogers* standard just because Jack Daniel's chose, for tactical reasons, to abandon the argument. Nothing in *Rogers v. Grimaldi* denies a trademark holder a fair opportunity to protect its rights and, in doing so, to protect consumers from genuine likelihood of confusion.²

II. The *Rogers v. Grimaldi* standard properly applies to utilitarian products such as t-shirts that contain noncommercial expression about trademarks.

Jack Daniel's argues that, if the Court does not abrogate *Rogers v. Grimaldi* altogether, it should confine its scope to the use of trademarks in works that inherently enjoy full First Amendment protection, such as books, movies, newspapers and magazines, and songs. Jack Daniel's argues that *Rogers v. Grimaldi* should never be applied to "ordinary commercial products" or,

² The United States faults application of *Rogers v. Grimaldi* to trademark infringement litigation on the ground that Ginger Rogers was not making a claim of likelihood of confusion with a trademark in her name, because, when that case arose, section 1125(a) did not contain the "likely confusion" language that it has today. U.S. Br. 27. That argument is not a fair account of *Rogers*. Although section 1125(a) was not amended to address claims of likely confusion (now the subject of 15 U.S.C. § 1125(a)(1)(A)) until 1988, the Second Circuit even before that amendment construed section 1125(a)'s cause of action for false advertising (now 15 U.S.C. § 1125(a)(1)(B)), as requiring the same likelihood-of-confusion showing as trademark infringement under section 1114. See *Lois Sportswear, U.S.A. v. Levi Strauss & Co.*, 799 F.2d 867, 871 (2d Cir. 1986). Moreover, the Second Circuit applies *Rogers* to trademark claims other than the false advertising prohibition at issue in *Rogers*, see *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Group*, 886 F.2d 490 (2d Cir. 1089), as do the many other circuits that apply the *Rogers* standard, e.g., *Parks v. LaFace Records*, 329 F.3d 437, 451–52 (6th Cir. 2003).

as it sometimes describes them, “utilitarian products.” Pet. Br. 38–39. Several amici argue for retaining *Rogers v. Grimaldi* but adopting this same limitation. See, e.g., INTA Br. 8–12, 23–24.

The proposed limitation fails to take account of the way in which some “ordinary commercial products” or “utilitarian products,” such as the t-shirts and coffee mugs that amici McCall, Shatz, and Stewart design and sell, are bought and sold because of the expression that they contain, and because consumers want to wear or display those items to engage in their own noncommercial speech about trademarks and trademark holders. The *Rogers v. Grimaldi* standard should protect the noncommercial, expressive aspects of such items as well.

Both this Court and lower courts have repeatedly recognized that the content of clothing items can express views and opinion and that such expression is core speech protected by the First Amendment. Thus, in *Cohen v. California*, 403 U.S. 15, 18 (1971), the Court recognized that words emblazoned on a denim jacket that Paul Cohen wore when in a California courthouse expressed his views on a public issue. The Court held that the First Amendment protected him against being convicted of disturbing the peace by offensive conduct. In *Tinker v. Des Moines Independent School District*, 393 U.S. 503, 508 (1968), the color black and its use on an armband expressed the view of three students about the war in Vietnam. The Court held that First Amendment protected their right to express their views through the armband, which, the Court said, was “akin to ‘pure speech’” through “a silent, passive expression of opinion.” *Id.* at 508. In *Minnesota Voters Alliance v. Mansky*, 138 S. Ct. 1876 (2018), the Court struck down a Minnesota rule

extending a ban on political buttons in the polling place to “expressive apparel” bearing words and symbols showing agreement with the “Tea Party” because the rule regulated fully protected political expression in a manner not capable of reasoned application. *Id.* at 1891.³

Similarly, many lower court decisions have held that the content on t-shirts and similar items is expression fully protected by the First Amendment. *Frudden v. Pilling*, 742 F.3d 1199, 1205, 1207 (9th Cir. 2014) (requirement of wearing school uniform emblazoned with the slogan “tomorrow’s leaders” was compelled speech endorsing a specific viewpoint in violation of the First Amendment); *Ayres v. City of Chicago*, 125 F.3d. 1010, 1014 (7th Cir. 1997) (stating that “T-shirts that the plaintiff sells carry an extensive written message of social advocacy ... there is no question that the T-shirts are a medium of expression prima facie protected by the ... First Amendment”); *Comedy III Prods. v. Gary Saderup, Inc.*, 21 P.3d 797, 804 (Cal. 2001) (“Nor does the fact that Saderup’s art appears in large part on a less conventional avenue of communications, T-shirts, result in reduced First Amendment protection.”).

As discussed in Part I, above, the function of the *Rogers v. Grimaldi* standard is to safeguard expressive users of trademarks in noncommercial speech against being dragged into trademark litigation that

³ In *Iancu*, the Court recognized that the use of an offensive term on articles of clothing was speech protected by the First Amendment against viewpoint discrimination, although the use in the case was as a trademark to identify source, and the Court did not consider the level of protection attached to that speech. *See* 139 S. Ct. at 2299.

will normally be resolved in favor of the expression, absent an especially strong showing of likely confusion. And because noncommercial expression can easily be printed on a message t-shirt, like the designs that amici create and sell, the rule for which Jack Daniel's contends, under which the standard does not apply to use on "ordinary commercial" or "utilitarian" products, cannot be the right one. After all, t-shirts are utilitarian products, even when the content printed on them expresses a point of view that is core speech protected by the First Amendment. Consequently, the argument of Jack Daniel's and its amici that the *Rogers v. Grimaldi* standard should never apply to the use of trademarks on "ordinary commercial products" or "utilitarian products" must be rejected.

CONCLUSION

For the foregoing reasons, the decision below rejecting Jack Daniel's Properties' infringement claim should be affirmed.

Respectfully submitted,

PAUL ALAN LEVY

Counsel of Record

SCOTT L. NELSON

PUBLIC CITIZEN LITIGATION GROUP

1600 20th Street NW

Washington, DC 20009

(202) 588-1000

plevy@citizen.org

Attorneys for Amici Curiae

McCall, Shatz, and Stewart

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