

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
FIRST AMENDMENT PROFESSORS
IN SUPPORT OF RESPONDENT**

—◆—
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**STATEMENT OF INTEREST
OF AMICI CURIAE**

Amici, listed in the Appendix, are law professors who teach and have written extensively about commercial speech and intellectual property law. Our sole interest in this case is in the orderly development of trademark law in a way that serves the public interest.¹



SUMMARY OF ARGUMENT

In the mid- to late twentieth century, courts began expanding the Lanham Act beyond its common-law foundations of preventing passing off and sales diversion, developing ever-more-expansive theories of actionable confusion. *See, e.g., Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 778 & n.5 (1992) (Stevens, J., concurring). Those theories began to sweep in more and more noncommercial speech. Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 197 (1982). At the same time, courts also began to impose liability if a small fraction of consumers were confused about anything, even when others benefited from the new option and even where confusion was immaterial to any

¹ Counsel for the parties did not author this brief in whole or in part. No persons other than Amici Curiae contributed money to fund preparation or submission of this brief. The parties have been provided with ten days notice.

consumer decision. See Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 414, 444–46 (2010).

Eventually, many courts recognized the resulting First Amendment problems and developed tests that cabined liability in particularly worrisome situations, including where noncommercial speech was accused of infringement. Commercial speech proposes a commercial transaction. Noncommercial speech does not, even when the speech itself is sold in the market. Noncommercial speakers do not need good reasons to be allowed to speak. The government requires a compelling interest to stop them. *Brown v. Entertainment Merchants Ass’n*, 564 U.S. 786, 799 (2011); *Reed v. Town of Gilbert*, 576 U.S. 155 (2015). In the absence of material consumer deception about the speaker or content of the speech, the government lacks an interest in protecting Petitioner JDPI against commentary and parody.

If the Lanham Act is read to apply uniformly to all speech, commercial and noncommercial, that occurs in “commerce,” then it would be unconstitutional: Congress never came close to making the necessary record to show that the interests claimed to be at stake satisfy strict scrutiny, especially for theories like affiliation/sponsorship confusion and dilution asserted by JDPI. JDPI’s arguments would turn the Lanham Act into a super-defamation law, absent the essential elements of falsity and reputational harm.

A test like that set forth in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), offers a way to manage the

commercial/noncommercial divide. When trademark owners assert that noncommercial speech causes confusion, a stringent test protects against the suppression and chilling of nonmisleading speech. This test is grounded in the recognition that, when noncommercial speech is at issue, reasonable persons do not make purchasing decisions about speech based on a belief that the trademark owner controls references, even prominent references, to its trademarks, especially when other parts of the content identify the actual speaker. Liability for explicit, material falsehoods can be constitutionally justified; liability for tarnishment or for immaterial confusion, especially immaterial confusion of a small percentage of the audience, cannot.

JDPI's position is that constitutional concerns cannot justify "rewriting" the Lanham Act. Pet. Br. at 19. Yet it has long been settled that Congress cannot pass laws that override the Constitution, *Marbury v. Madison*, 5 U.S. 137 (1803), and the Lanham Act is no exception. *Matal v. Tam*, 137 S. Ct. 1744, 1752, 1760 (2017) (noting that trademarks routinely express more than source indication, and the expressive dimensions of the marks warrant First Amendment protection); *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) (same). *Rogers* is one way of recognizing that many applications of the Lanham Act would be unconstitutional as applied to noncommercial speech, given that it is the nonadvertising aspects of speech that trademark plaintiffs often target when suing noncommercial speakers.

JDPI likewise claims that it needs the assistance of the federal government, through the dilution cause

of action, to suppress the speech of people who have a different take on the dignity or meaning of its brand. Under the First Amendment, its remedy for nondefamatory challenges to its reputation is in the marketplace of ideas, not in injunctions and damages.



ARGUMENT

I. Infringement Liability for Noncommercial Speech Must Survive Strict Scrutiny (or Be Justified by an Existing First Amendment Exception)

The line between commercial and noncommercial speech exists to allow regulation of economic transactions, including speech directly connected to those transactions. This Court has long relied on “the ‘common-sense’ distinction between speech proposing a commercial transaction . . . and other varieties of speech.” *Ohralik v. Ohio State Bar Ass’n*, 436 U.S. 447, 455–56 (1978).

Yet, when it enacted the Lanham Act, Congress engaged in no factfinding that would establish the necessary compelling interest to regulate noncommercial speech and explain why the law was narrowly tailored to further that interest. A review of the legislative history finds no discussion relevant to infringement claims against noncommercial speech. H.R. Rep. No. 219, 79th Cong. 1st Sess. 2 (1945); S. Rep. No. 1333, 79th Cong. 2d Sess. 3 (1946). *Cf.* 134 Cong. Rec. 31,851 (Oct. 19, 1988) (statement of Rep. Kastenmeier) (stating

that 1988 revisions would only cover commercial speech); Federal Trademark Dilution Act, H.R. Rep. No. 104–374, at 4 (1995) (stating that dilution would not apply to noncommercial speech). Nor have JDPI or its amici identified any longstanding historical tradition of suppressing the content of noncommercial speech at the behest of trademark owners.

Thus, many courts have reasoned that “[t]he Lanham Act is constitutional because it only regulates commercial speech, which is entitled to reduced protections under the First Amendment.” *Taubman Co. v. Webfeats*, 319 F.3d 770, 774 (6th Cir. 2003) (citing *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557, 563 (1980)); see also *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905 (9th Cir. 2002) (using the Lanham Act to prevent commercial fraud is “wholly consistent with the theory of the First Amendment,” but extensions past that may unconstitutionally suppress speech); cf. *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 579 (2011) (“[T]he government’s legitimate interest in protecting consumers from commercial harms explains why commercial speech can be subject to greater governmental regulation than noncommercial speech.”) (cleaned up); *National Institute of Family and Life Advocates v. Becerra*, 138 S. Ct. 2361, 2374 (2018) (strict scrutiny applies to content-based laws that regulate noncommercial speech).²

² The few courts that apply the Lanham Act to political speech have mainly found infringement only for what is, in essence, impersonation, not general confusion about “source,” sponsorship, etc., in effect limiting its coverage to material, explicit

A. VIP’s Speech Is Noncommercial

Commercial speech is often defined as speech that does no more than propose a commercial transaction. *U.S. v. United Foods, Inc.*, 533 U.S. 405, 409 (2001); *Mattel*, 296 F.3d at 900 (same; rejecting infringement claim against song). That is, commercial speech is an offer to sell something other than the speech itself.

Speech that is itself the expressive product being sold is noncommercial, even when sold for profit. *See, e.g., Brown v. Ent. Merchs. Ass’n*, 564 U.S. 786, 790 (2011) (video games); *City of Lakewood v. Plain Dealer Publ’g Co.*, 486 U.S. 750, 756 n.5 (1988) (“Of course, the degree of First Amendment protection is not diminished merely because the newspaper or speech is sold rather than given away.”); *Smith v. California*, 361 U.S. 147, 150 (1959) (same); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996) (“Cardtoons’ trading cards . . . are not commercial speech—they do not merely advertise another unrelated product. Although the cards are sold in the marketplace, they are not transformed into commercial speech merely because they are sold for profit.”).

Here, Respondent VIP is selling the speech itself, not using the speech to sell another product. *See Gaudiya Vaishnava Soc’y v. City & Cnty. of S.F.*, 952 F.2d 1059, 1063–65 (9th Cir. 1990) (message-bearing items such as T-shirts and jewelry were noncommercial speech despite being sold); *Ayres v. City of Chicago*,

falsity. *See United We Stand America, Inc. v. United We Stand, America New York, Inc.*, 128 F.3d 86 (2d Cir. 1997).

125 F.3d 1010, 1014 (7th Cir. 1997) (“[T]here is no question that the T-shirts are a medium of expression prima facie protected by the free-speech clause of the First Amendment, and they do not lose their protection by being sold rather than given away.”); *see also, e.g., Cohen v. California*, 403 U.S. 15 (1971) (jacket bearing message was fully protected by First Amendment); *Schoenecker v. Koopman*, 349 F. Supp. 3d 745, 751 (E.D. Wis. 2018) (“[T]he shirts themselves are pure speech, in that they contain images and words that convey a message. The message may be ambiguous and open to interpretation, . . . but . . . ‘a narrow, succinctly articulable message is not a condition of constitutional protection.’”) (citing *Hurley v. Irish-American Gay, Lesbian & Bisexual Grp.*, 515 U.S. 557, 569 (1995)). To put it differently, a red T-shirt that says “America the Beautiful” on the front is a distinct product from a plain red T-shirt; the expression is part of what the product is.

A poster, like a dog toy, has physical properties and uses beyond expression—it can, for example, be used to cover up what is underneath. *See THE SHAWSHANK REDEMPTION* (1994). The First Amendment applies to both where a regulation depends on objects’ expressive content and not on their physical manifestation. The speech to which JDPI objects would be the same printed on any substrate, even if the joke wouldn’t be as good.

In short, First Amendment cases do not distinguish among expressive works on products; they distinguish between commercial and noncommercial *speech*.

JDPI's distinction between "ordinary" commercial products and for-profit speech is incoherent: books, DVDs, and video games are mass marketed, just like shirts bearing slogans and other products purchased for their communicative value.

B. The Commercial and Noncommercial Aspects of Noncommercial, For-Profit Speech Are Generally Inextricably Intertwined

The level of First Amendment protection does not change because a title or other visible feature helps promote or sell the work. Instead, where works' artistic and expressive functions are "inextricably intertwined" with commercial elements, the proper First Amendment standard is that governing noncommercial speech. *Riley v. Nat'l Fed'n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988). There is no way to suppress the commercial elements of the content of a work, including a parody, without suppressing the noncommercial elements, because the restraint would be on the communicative use itself. In advertising, by contrast, commercial pitches can be excised from otherwise noncommercial material. Compare *Board of Trustees of State Univ. of N.Y. v. Fox*, 492 U.S. 469 (1989) (finding educational presentations in "Tupperware parties" separable from accompanying sales pitches) with, e.g., *Mattel*, 296 F.3d at 903, 906–07 (commercial and expressive purposes of using "Barbie" in song title referring to Barbie doll were inextricably intertwined) (citations omitted), and *Parks v. LaFace Records*, 329

F.3d 437, 449 (6th Cir. 2003) (“[I]f a song is sold, and the title is protected by the First Amendment, the title naturally will be ‘inextricably intertwined’ with the song’s commercial promotion.”) (citations omitted); *see also Hart v. Elec. Arts*, 717 F.3d 141, 154 (3d Cir. 2013) (a test that tries to weigh expression against commerciality “is subjective at best, arbitrary at worst, and in either case calls upon judges to act as both impartial jurists and discerning art critics. These two roles cannot co-exist. . . . [It is improper] for courts to analyze select elements of a work to determine how much they contribute to the entire work’s expressiveness.”).

Creators, parodists or otherwise, routinely make nondefamatory portrayals of people, objects, beloved (or disliked) institutions, and other things they see in the world or find in its history. Thus, the First Amendment protects not just speakers’ choices of topics, but also their choices of how to speak about those topics. *See, e.g., Tam*, 137 S. Ct. at 1760 (as “trademarks often have an expressive content” and “powerful messages can sometimes be conveyed in just a few words,” regulation of trademarks implicates the First Amendment); *Cohen v. California*, 403 U.S. 15, 26 (1971) (“[W]e cannot indulge the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process.”); *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) (“[W]e need not belabor the point that some words, phrases or symbols better convey their intended meanings than others.”).

Although most courts applying *Rogers* have only required minimal artistic relevance, *see, e.g., MGF Properties, Inc. v. Viacom Inc.*, 54 F.4th 670 (11th Cir. 2022), if the question is framed as whether a noncommercial speaker had a good reason to use a given trademark, it is not a legitimate inquiry. Courts should not decide what parts of art are artistically relevant. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (judges should not measure aesthetic worth); *Rogers*, 875 F.2d at 999 n.4 (rejecting judicial scrutiny of possible alternative titles); *Parks*, 329 F.3d at 450 (same for content of expressive work); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 971 (10th Cir. 1996) (applying *Cohen* because “intellectual property” includes “the words, images, and sounds that we use to communicate”); *see also Packingham v. North Carolina*, 137 S. Ct. 1730, 1735 (2017) (invalidating law barring use of social media despite lower court’s finding that other sites could perform “same or similar” functions).

Rather than looking for artistic relevance in non-commercial speech, courts should ask only whether a work is in fact a disguised advertisement for something else (such as an influencer secretly paid to promote a separate good or service), or whether a work is being advertised in a way that misdescribes the speaker’s identity or the speech the speaker is selling, such as an ad that uses an image of Kim Kardashian to advertise a book that doesn’t have any relevance to her. *Rogers*, 875 F.2d at 999; *Woulfe v. Universal City*

Studios LLC, 2022 WL 18216089 (C.D. Cal. Dec. 20, 2022).

Artistic relevance is not a concept fit for judicial inquiry where noncommercial and commercial aspects of speech are inextricably intertwined. Prohibiting a parody prohibits both its commercial and noncommercial aspects. If the only way to “separate” them would be for the speaker to give away the speech for free, then there is no separable sales pitch, and the speech is fully protected. *See Fox*, 492 U.S. at 474; *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185 (9th Cir. 2001) (commercial aspects of for-profit magazine’s article were inextricably intertwined with editorial comment); *Federal Trade Comm’n v. Agora Financial, LLC*, 447 F. Supp. 3d 350, 363 (D. Md. 2020) (“[T]o be inextricably intertwined, the commercial aspects of a statement must match the noncommercial aspects of that statement.”).³

To put it another way, nothing about the Tupperware sold in *Fox* would change if the sales pitch were separated from home economics lessons, while removing the communicative elements from the dog toy here would create a different product. To claim separability here would instead say that the expression could not be sold in the marketplace—which directly

³ There may be cases where reasonable audiences would give so much more weight to functional aspects of a product that those aspects could be separable, such as with THC-containing foods. But products that are primarily used to convey messages, including parody toys, pose no such difficulties; JDPI’s claim would be no different if Bad Spaniels didn’t squeak.

contradicts this Court’s longstanding rule that for-profit noncommercial speech is fully protected by the First Amendment. *See Ayres*, 125 F.3d at 1017 (“To argue that the right of free speech is limited to cases in which speech is disseminated free of charge would amount to arguing that the City of Chicago could ban the sale of newspapers.”).

II. Trademark Owners Regularly Use Trademark Law to Suppress Speech

A. Noncommercial Speech Is Highly Vulnerable Without *Rogers*

Powerful entities rarely have a sense of humor about themselves, and regularly threaten speakers who don’t take them as seriously as they take themselves. *Renna v. County of Union, N.J.*, 88 F. Supp. 3d 310 (D.N.J. 2014), for example, began with the county’s cease-and-desist demands to a critic whose television show displayed the county’s logo in a spotlight:



As *Renna* noted, trademark law is far too broad to address the government's legitimate interests; a specific anti-impersonation law would be constitutional, but the Lanham Act is not that. *Id.* at 323.

Trademark owners have regularly sued noncommercial speakers,⁴ arguing that the titles or contents of their works imply some connection with the trademark

⁴ Trademark owners target both high culture and low. *See, e.g., JTH Tax LLC v. AMC Networks Inc.*, No. 1:22-cv-06526-PGG (S.D.N.Y., filed Aug. 1, 2022) (lawsuit against fictional depiction of Sweet Liberty Tax Services in TV show); *Estate of Hemingway v. Random House, Inc.*, 244 N.E.2d 250, 260 (N.Y. 1968) (lawsuit targeting biographical memoir Papa Hemingway).

owner. Without *Rogers*, they can win their claims,⁵ or at least force ruinously expensive litigation over whether small percentages of consumers were confused about the parties' relationship,⁶ even for obvious parodies and obviously immaterial confusion. A strong First Amendment rule is therefore required to protect speech from overreaching trademark claims.

Courts not applying *Rogers* have found obvious parodies likely to cause confusion (without evaluating whether consumers would care). In one case, for example, a court held a humor magazine liable for running a parody ad, relying on a survey that purported to show that consumers thought that parody required the trademark owner's permission:

⁵ See, e.g., *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727 (D. Minn. 1998) (title *Dairy Queens*, for a movie about midwestern beauty queens, enjoined without evidence of actual confusion).

⁶ See, e.g., *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266 (11th Cir. 2012) (lawsuit against artist for depicting historically important football games); *Wham-O, Inc. v. Paramount Pictures Corp.*, 286 F. Supp. 2d 1254, 1256–58 (N.D. Cal. 2003) (lawsuit about humorous Slip-n-Slide accident as part of plot of comedy film); *Caterpillar Inc. v. Walt Disney Co.*, 287 F. Supp. 2d 913, 920 (C.D. Ill. 2003) (lawsuit based on use of Caterpillar equipment by fictional villains fighting George of the Jungle; confusion immaterial).



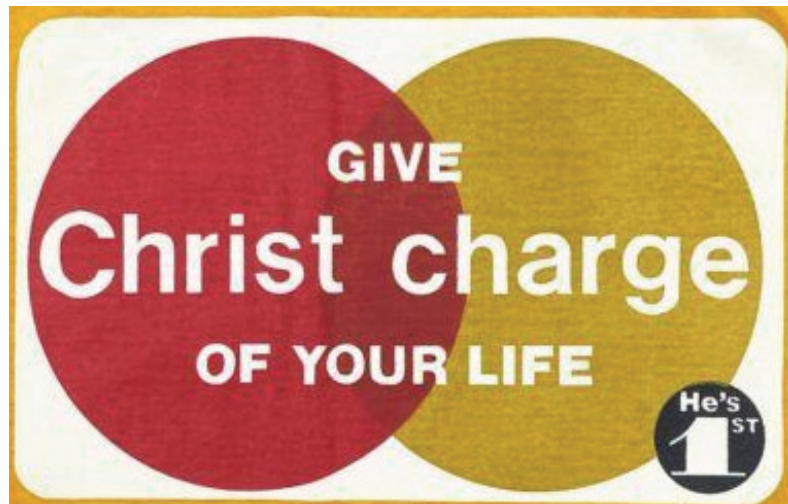
⁷ *Anheuser-Busch, Inc. v. Balducci Publications*, 28 F.3d 769 (8th Cir. 1994); *Balducci Publications*, Issue 5 1/2 (1989) (front and back).

Another court reached the same result with this obvious parody:



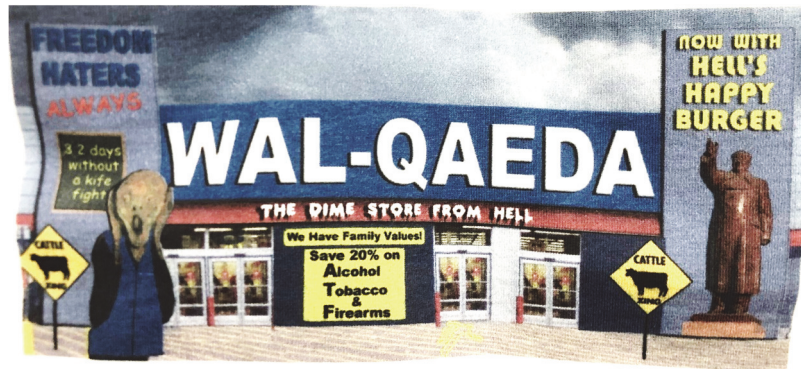
⁸ *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987).

Another enjoined this image because it was “indistinguishable” from MasterCard’s mark when used on religious tract cards and stickers:



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Still another court required substantial discovery and motion practice to determine that this image was not confusing on T-shirts:



⁹ *Interbank Card Ass'n v. Simms*, 431 F. Supp. 131, 134 (M.D.N.C. 1977).

Despite the obvious critical nature of the image, Wal-Mart submitted a survey purporting to show that over 47% of consumers were confused about whether Wal-Mart was the source of or affiliated with these shirts, demonstrating how the multifactor test and its emphasis on survey evidence can be misused to harass critics. *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1321 (N.D. Ga. 2008).

A test that finds liability—or even difficulty determining liability—with these obvious parodies is not working well. As these cases demonstrate, as applied to noncommercial speech, the multifactor test has led to bias against disfavored speakers, chilling effects, and too many opportunities for error.

B. The Multifactor Confusion Test Is Ill-Suited for Noncommercial Speech

The confusion factors used in many circumstances are likely to point in the wrong direction in specific types of cases. Among other problems, courts presume that a plaintiff with a strong mark is more likely to win, when strong marks may be more resistant to confusion—especially when parody or another, larger message is involved—than weak ones. Barton Beebe & C. Scott Hemphill, *The Scope of Strong Marks: Should Trademark Law Protect the Strong More Than the Weak?*, 92 N.Y.U. L. REV. 1339 (2017).

Surveys about noncommercial speech are particularly likely to go wrong because they are asking consumers about something they generally neither know

nor care about: whether a trademark owner has to consent to nonadvertising uses of its mark.¹⁰ Thus, it is relatively easy for surveys in such cases to produce “high” levels of confusion. *See, e.g., Rogers*, 875 F.2d at 1001 n.8 (survey purported to show that 38% of respondents mistakenly believed that Ginger Rogers was involved with the film at issue); *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013) (plaintiff submitted survey “demonstrating that a majority of the public believes that identifying marks cannot be included in products without permission”); *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915, 937 & n.19 (6th Cir. 2003) (over 60% of respondents thought that artwork’s subject was affiliated or connected with artwork or approved or sponsored it); *Smith, supra*.

Surveys alone add substantially to the expense and speech-deterrent effect of a lawsuit. Daryl Lim, *Trademark Confusion Revealed: An Empirical Analysis*, 71 AM. U. L. REV. 1285, 1313–14 (2022) (“Constructing a robust survey is dauntingly hard. . . . As a

¹⁰ Consumers often merely guess about sponsorship based on plausibility. Gita Venkataramani Johar et al., *How Event Sponsors Are Really Identified: A (Baseball) Field Analysis*, 46 J. ADVERTISING RES. 183, 188 tbl. 1 (2006) (baseball fans had false alarm rate of 40% identifying sponsors of their teams and missed 43% of actual sponsors); Michel Tuan Pham & Gita Venkataramani Johar, *Market Prominence Biases in Sponsor Identification: Processes and Consequentiality*, 18 PSYCH. & MARKETING 123, 126, 133 (2001) (evidence supports that “respondents are more likely to accurately or inaccurately identify the more prominent brand as the sponsor of an event, even if the names of other less-prominent brands are provided in the survey (thus controlling for differential brand retrievability)”).

matter of justice between the parties, the staggering costs of surveys put defendants at a disadvantage. . . . Qualitatively, cases in the dataset warn that surveys only represent circumstantial evidence of actual confusion, . . . not real consumers making mistaken purchases.”) (citations omitted); *cf. Indianapolis Colts, Inc. v. Metro. Baltimore Football Club Ltd. Partnership*, 34 F.3d 410, 416 (7th Cir. 1994) (“[N]o doubt there are other tricks of the survey researcher’s black arts that we have missed. There is the more fundamental problem, one common to almost all consumer survey research, that people are more careful when they are laying out their money than when they are answering questions.”); John P. Liefeld, *How Surveys Overestimate the Likelihood of Consumer Confusion*, 93 TRADE-MARK REP. 939 (2003).

More generally, people aren’t careful when they don’t care—that is, when the existence or nonexistence of a relationship is immaterial to them. Thus, the standard multifactor test is automatically more likely to find confusion over sponsorship or affiliation precisely because consumers are less likely to care about it. *See* Rebecca Tushnet, *Running the Gamut from A to B*, 159 U. PENN. L. REV. 1305, 1353–54 (2011).

Given the high degree of protection given noncommercial speech, and the particular harm that false positives and the chilling effects of threatened litigation do both to speakers and to the public interest, the multifactor test is ill-suited to judge when a restriction on noncommercial speech is justified by a sufficient interest. *Cf. Lexmark Int’l, Inc. v. Static Control*

Components, Inc., 572 U.S. 118, 136 (2014) (rejecting interpretation of Lanham Act that led to vague and unpredictable results).

C. Vague and Open-Ended Inquiries Chill Noncommercial Speech

Civil claims can create First Amendment harms as surely as state enforcement, and be “markedly more inhibiting.” *New York Times Co. v. Sullivan*, 376 U.S. 254, 277 (1964). “What a State may not constitutionally bring about by means of a criminal statute is likewise beyond the reach of its civil law.” *Id.*; see also Eugene Volokh & Brett McDonnell, *Freedom of Speech and Independent Judgment Review in Copyright Cases*, 107 YALE L.J. 2431, 2446 n.84 (1998) (private enforcement can be more dangerous to speech because it can be more pervasive and effective).

Forcing defendants to litigate confusion in detail chills expression. *MGFB Properties, Inc. v. Viacom Inc.*, 54 F.4th 670, 688 (11th Cir. 2022) (Brasher, J., concurring) (*Rogers* avoids need for “extensive fact-finding”; “certainty is especially important in an area like this one where even the prospect of liability has the effect of chilling constitutionally protected speech”) (citing Glynn Lunney, *Trademark’s Judicial De-Evolution: Why Courts Get Trademark Cases Wrong Repeatedly*, 106 CALIF. L. REV. 1195, 1201 (2018)); *Mattel*, 296 F.3d at 900–02 (9th Cir. 2002); *New Kids*, 971 F.2d at 306–08; Robert G. Bone, *Rights and Remedies in Trademark Law: The Curious Distinction Between Trademark*

Infringement and Unfair Competition, 98 TEX. L. REV. 1187, 1213 (2020) (“[T]he open-ended nature of factual determinations in trademark cases generates uncertainty about outcome. One of the main sources of this uncertainty is the vague multifactor test for likelihood of confusion.”) (footnote omitted).

As this Court has recognized, rules that make it easy for trademark owners to threaten costly litigation are harmful. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000); *see also* William McGeeveran, *The Imaginary Trademark Parody Crisis (and the Real One)*, 90 WASH. L. REV. 713, 745–53 (2015) (emphasizing the importance of clear rules that can be applied early in litigation in order to protect speech); Elizabeth L. Rosenblatt, *Rethinking the Parameters of Trademark Use in Entertainment*, 61 FLA. L. REV. 1011 (2009) (same).

Without a clear test, speakers will “‘steer far wider of the unlawful zone’ . . . than if the boundaries of the forbidden areas were clearly marked.” *Grayned v. City of Rockford*, 408 U.S. 104, 110 (1972). A multifactor test that freely admits that one case will never provide much guidance for the next case seems about as bad a guide to safe conduct as one could imagine. *Baggett v. Bullitt*, 377 U.S. 360, 372 (1964); *see also Grayned*, 408 U.S. at 109 (“Where a vague statute abuts upon sensitive areas of basic First Amendment freedoms, it operates to inhibit the exercise of [those] freedoms.”) (cleaned up).

By contrast, *Rogers* offers a clear rule and a tight focus on the legitimate goal of protecting consumers against material deception. *Cf. Hustler Magazine v. Falwell*, 485 U.S. 46, 56 (1988) (holding that the First Amendment limits scope of intentional infliction of emotional distress tort “to give adequate ‘breathing space’ to the freedoms protected by the First Amendment”); David A. Han, *Middle-Value Speech*, 91 S. CAL. L. REV. 65, 83 (2017) (prophylactic rules can be justified “simply to limit the chilling effects on speech that would result from a more complex and nuanced doctrinal structure”); David A. Strauss, *The Ubiquity of Prophylactic Rules*, 55 U. CHI. L. REV. 190, 190 (1988) (courts regularly and legitimately craft prophylactic rules to protect constitutional values).

III. Strict Scrutiny Is the Proper Standard for Regulations of Noncommercial Speech Unless the Speech Falls Within a First Amendment Exception

In general, strict scrutiny applies when a regulation singles out “particular subject matter” for regulation and therefore is “based on the message a speaker conveys,” *Reed v. Town of Gilbert*, 576 U.S. 155, 163–64 (2015), unless the speech falls within a First Amendment exception such as for outright fraud.¹¹ Here, had

¹¹ *Reed* rejected the reasoning in *San Francisco Arts & Athletics v. U.S. Olympic Committee*, 483 U.S. 522 (1987), that applied minimal scrutiny to a law directed at specific trademarks because of Congress’s beneficial motive in passing it. *Compare id.* at 534–35 with *Reed*, 576 U.S. at 163–64.

VIP parodied anything else, JDPI would have no claim, and this is true in any infringement case requiring an evaluation of noncommercial speech. *See National Press Photographers Ass’n v. McCraw*, 2022 WL 939517, at *10 (W.D. Tex. Mar. 28, 2022) (finding regulation content-based when enforcement requires inquiry “into the contents of the image to determine whether it is prohibited”); Lisa P. Ramsey, *Free Speech Challenges to Trademark Law after Matal v. Tam*, 56 HOUS. L. REV. 401, 441 (2018) (content-based determinations are central to infringement cases). The government “must specifically identify an actual problem in need of solving, . . . and the curtailment of free speech must be actually necessary to the solution.” *Brown*, 564 U.S. at 799 (cleaned up). This “is a demanding standard.” *Id.*

A. There Is No Compelling Interest in Avoiding Competition in the Marketplace of Ideas

There may be a constitutional basis for restricting speech that creates material confusion over who is speaking. But many forms of “confusion” asserted under the Lanham Act extend much further. This is especially true where there is no direct competition—situations far removed from the commercial “passing off” or counterfeiting at the heart of trademark’s justifications. *See, e.g., Fortres Grand Corp. v. Warner Bros. Entertainment Inc.*, 763 F.3d 696, 700–01 (7th Cir. 2014) (“confusion ‘in the air’ is not actionable”); *Bosley Medical Institute, Inc. v. Kremer*, 403 F.3d 672, 677 (9th

Cir. 2005) (“The Lanham Act seeks to prevent consumer confusion that enables a seller to pass off his goods as the goods of another. . . . [T]rademark infringement protects only against mistaken purchasing decisions and not against confusion generally.”) (quoting *Lang v. Ret. Living Publ’g Co., Inc.*, 949 F.2d 576, 582–83 (2d Cir. 1991)); cf. *Radiance Found., Inc. v. N.A.A.C.P.*, 786 F.3d 316, 327–28 (4th Cir. 2015) (“Actual confusion as to a non-profit’s mission, tenets, and beliefs is commonplace, but that does not transform the Lanham Act into an instrument for chilling or silencing the speech of those who disagree with or misunderstand a mark holder’s positions or views.”) (citing *Rogers*, 875 F.2d at 1001); *Lamparello v. Falwell*, 420 F.3d 309, 317–18 (4th Cir. 2005) (applying initial interest confusion to noncommercial gripe sites “would enable the markholder to insulate himself from criticism—or at least to minimize access to it”).

JDPI maintains that it has a free speech right to be protected from others’ commentary. But, even if some audience members think that VIP needed JDPI’s permission to parody it, JDPI’s own speech has not been suppressed or coerced by the government. *MGFB Properties, Inc. v. Viacom Inc.*, 54 F.4th 670, 686 (11th Cir. 2022) (Brasher, J., concurring) (“[L]iability under the Lanham Act gives priority in the marketplace of ideas to whoever speaks first and silences the speech of the second speaker. . . . Absent a neutral time, place, or manner restriction, one person’s right to speak cannot justify silencing a second person’s speech. Another way to say it: no one has a First Amendment right to

stop someone else from speaking.”); *see also Buckley v. Valeo*, 424 U.S. 1, 48–49 (1976) (“[T]he concept that government may restrict the speech of some elements of our society in order to enhance the relative voice of others is wholly foreign to the First Amendment. . . .”); *Citizens Against Rent Control v. City of Berkeley*, 454 U.S. 290, 298–300 (1981) (asserted interest in identifying speaker insubstantial where speakers were already otherwise identifiable). Rather than exercising its own speech rights, or enforcing an anti-impersonation principle, JDPI seeks insulation from the marketplace of ideas and the ability of others to participate in the creation of meaning.

Nor does quality control merit granting trademark owners rights to control how they are spoken about. The ordinary commercial case is one in which the trademark identifies for consumers which source they want to capture otherwise-invisible characteristics: “Eveready” for a battery summarizes information about battery life and reliability for consumers. *See Taco Cabana*, 505 U.S. at 769. But, where consumers are buying speech, they can see they are getting speech—here, a parodic take on the Jack Daniel’s bottle. There is no quality-guarantee function to weigh against the speaker’s interest in communicating its message. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33 (2003) (Lanham Act “should not be stretched to cover matters that are typically of no consequence to purchasers”). Nor do reasonable consumers expect trademark owners to guarantee the quality of parodies, movies, or other expressive works

that incorporate their marks. Matthew B. Kugler, *The Materiality of Sponsorship Confusion*, 50 U.C. DAVIS L. REV. 1911, 1951, 1957 (2017).

Worse, trademark owners are poor proxies for the public interest. Trademark owners license products based on economic self-interest rather than that of the public,¹² and then often avoid responsibility for defective or falsely advertised products, even though they used branding to make the licensed product more attractive. *See, e.g., Joseph v. TGI Friday's, Inc.*, 2022 WL 17251277, at *5 (N.D. Ill. Nov. 28, 2022); Katya Assaf, *Brand Fetishism*, 43 CONN. L. REV. 83, 88, 118 (2010) (tort cases often excuse trademark licensors). There is no compelling or even substantial interest in giving trademark owners control over, but not responsibility for, speech that evokes them.

The claim that trademark owners have “property” rights in others’ expression fares no better. Trademarks are nonrivalrous—unlike a car, more than one person can use them at once, and so one person’s use does not expropriate another’s. Indeed, any interest could be reconceptualized as an intangible property interest to defeat a speech claim. Eugene Volokh & Brett McDonnell, *Freedom of Speech and Independent Judgment Review in Copyright Cases*, 107 YALE L.J. 2431, 2445–46 (1998). If the law could give claimants a property interest by fiat that outweighs the First

¹² *See, e.g., Lego Fun Snacks*, Brickipedia, https://en.brickimedia.org/wiki/LEGO_Fun_Snacks (visited Feb. 19, 2023) (“They were removed from stores as they looked similar to bricks and so were considered a choking hazard.”).

Amendment, legislatures could create liability for any form of protected speech that annoys someone or disrespects them.

Nor is animosity to “free riding” sufficient justification to suppress noncommercial speech. In the absence of impersonation, commentary that refers to a well-known entity is part of robust public discourse. *Hustler*, 485 U.S. at 51–52. In the context of compelled speech, this Court has held that the fact that one person benefits from another’s speech without paying for it—“free riding”—does not establish a compelling interest in making the first person pay. *Janus v. American Federation of State, County, & Mun. Employees*, 138 S. Ct. 2448, 2466–67 (2018).

B. Narrow Tailoring

1. Explicit Misleadingness Is a Narrowly Tailored Standard

Explicit misleadingness focuses on the most severe and hard-to-avoid risk of material confusion: confusion over who is really speaking. It protects free speech by presuming that audience members are reasonable citizens. In a case that asserted both trademark infringement and defamation claims against a satire, the D.C. Circuit noted that “the test . . . is not whether some actual readers were misled, but whether the hypothetical reasonable reader could be (after time for reflection).” *Farah v. Esquire Mag.*, 736 F.3d 528, 537 (D.C. Cir. 2013).

Material, explicit misleadingness could justify relief even against noncommercial speech. *United We Stand America*, 128 F.3d at 90. “[T]he First Amendment does not shield fraud,” even in the context of otherwise fully protected speech. *Illinois ex rel. Madigan v. Telemarketing Associates, Inc.*, 538 U.S. 600, 612 (2003). A noncommercial entity that uses essentially the same name as a speaker with which it is in direct ideological competition—impersonation—can produce this kind of material, explicit misleadingness. A direct competition requirement and a focus on speaker identification can target situations where a reasonable audience lacks ways to distinguish among noncommercial speakers.

But names of competing entities are usually meaningfully different than titles or other features of works of expression. Debra Baker’s article *Who Wants to Be a Millionaire?* in the ABA Journal is not explicitly misleading about its lack of connection with the well-known television show. Debra Baker, *Who Wants to Be a Millionaire?*, 86 A.B.A. J. 36 (2000). Baker has clearly identified herself as the author. By contrast, two different *Who Wants to Be a Millionaire* television shows could be a problem, *Gordon v. Drape Creative Inc.*, 909 F.3d 257 (9th Cir. 2018), and direct substitutionary competition bears both on the strength of the government interest in preventing confusion and on the ability of clear attribution to distinguish the parties’ works.

To implement that distinction, many *Rogers* and political speech cases use an intuitive view of “source

identification” as *speaker* identification.¹³ But conflation of speaker identification with the broader scope of the Lanham Act leaves room for misinterpretation when it comes to noncommercial speech. The explicit misleadingness requirement of *Rogers* thus handles ambiguous uses that might confuse some people even if they communicate a non-speaker-identifying message to other reasonable audience members. Where there are multiple reasonable responses to the use, then there can be no liability under *Rogers*.¹⁴ Requiring proof that noncommercial speech explicitly misleads about the speaker’s identity is a way of accounting for reasonable citizens, who consider who is speaking.

2. Materiality

The multifactor infringement test, as it has been applied, often focuses on whether a small percentage of consumers might be confused about the parties’ relationship, not about whether confusion would affect any purchasing decision. Tushnet, *supra*, at 1352–59. Instead, modern courts simply presume harm—and the statute now directs them to presume *irreparable* harm. 15 U.S.C. § 1116(a). But a presumption cannot substitute for an inquiry into whether the harms asserted are real. *See Animal Legal Defense Fund v. Reynolds*, 8 F.4th 781, 793 (8th Cir. 2021) (Gruender, J.,

¹³ *See, e.g., American Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 698–99 (N.D. Ohio 2002) (protecting use of variant of AFLAC duck in political ad; distinguishing cases enjoining political/nonprofit names/domain names).

¹⁴ 875 F.2d 994 (2d Cir. 1989).

concurring and dissenting in part) (“It would . . . make little sense for the Court to condition the scope of First Amendment rights on what contemporaneously supports standing under U.S. law rather than on what supported standing under U.S. law in 1791. That would imply that the scope of First Amendment protection contracts over time as Congress ‘elevate[s]’ new harms to the status of legally cognizable harms for the purposes of federal law. Worse, it would allow Congress to bootstrap laws into compliance with the First Amendment by elevating harms associated with the false speech that the laws regulate to the status of legally cognizable harms.”) (citations omitted).

The absence of a materiality requirement interacts with the expansive confusion test: audiences don’t generally pay attention to things they don’t care about in making decisions, so they’re more easily “confused” even if entirely unaffected in behavior. *See* Kugler, *supra*, at 1915 (empirical research finding that “[c]onfusion about the sponsorship of public symbols, parody products, and incidental uses of names is not commonly material”); *id.* at 1957 (consumers don’t rely on trademark owners to police quality of parodies or movies).

For First Amendment purposes, immaterial confusion cannot justify suppression of nonadvertising speech; it is too far afield from the core purpose of trademark law. Specifically, it should not matter whether trademark owners convince people that speakers require permission to comment on them or make other noncommercial uses of a trademark. Some people may

mistakenly assume that all speech about a trademark requires permission, but such an assumption has nothing to do with the core function of trademark: allowing consumers to get the products they desire and not counterfeits. *Tam*, 137 S. Ct. at 1751. In the absence of defamation, if audience members merely hold mistaken beliefs, the solution is found in the marketplace of ideas, including JDPI's own undoubted ability to advertise itself and what it wants the public to believe about the brand.

3. Remedies

Regulations of noncommercial speech must be the least restrictive means of achieving the government's compelling interest, narrowly tailored to the proscribable speech. Instead of injunctions or damages, the preferred remedy is more speech, such as a prominent disclaimer. *Washington State Grange v. Washington State Republican Party*, 552 U.S. 442, 456–57 (2008) (recognizing that prominent disclaimers prevent reasonable citizens from perceiving endorsement in political context); *Pursuing America's Greatness v. Federal Election Comm'n*, 831 F.3d 500, 510 (D.C. Cir. 2016) (disclaimer is less restrictive means than ban on titles); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 672 (5th Cir. 2000) (“Where the allegedly infringing speech is at least partly literary or artistic, however, and not solely a commercial appropriation of another's mark, the preferred course is to accommodate trademark remedies with First

Amendment interests. One obvious mode of accommodation is a disclaimer. . . .”) (citations omitted).

Clear labeling of the actual source—here, VIP—is a simple way to protect against material deception about the source of noncommercial speech. *See, e.g., Blinded Veterans Ass’n v. Blinded Am. Veterans Found.*, 872 F.2d 1035 (D.C. Cir. 1989) (requiring defendant to use reasonable means to prevent confusion but not requiring change of name); *Prolife Minnesota v. Minnesota Pro-Life Committee*, 632 N.W.2d 748, 750 (Minn. Ct. App. 2001) (same).

IV. Dilution by Tarnishment Is Unconstitutional

While the Court could avoid a final ruling on tarnishment through statutory interpretation, JDPI’s argument for tarnishment reveals the fundamental unsoundness of this viewpoint-based restriction.

Dilution developed in the early decades of the twentieth century, when truthful commercial speech received no constitutional protection. Yet this Court has repeatedly emphasized that the traditional categories of unprotected speech cannot be expanded based merely on a legislature’s determination of the speech’s low value. *See United States v. Stevens*, 559 U.S. 460, 468 (2010).

The dilution harm alleged by JDPI is that its reputation could be affected by people thinking about it in an unwanted context. But that kind of harm must

be judged by the rigorous requirements of defamation, which requires falsity, not merely negativity. This Court has been careful to preclude claims against non-commercial speech that attempt to evade defamation law's strict requirements. *See, e.g., Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 56 (1988). Lower courts have recognized that attempts to protect "reputation" must follow the same constitutional rules. *New York Stock Exchange, Inc. v. Gahary*, 196 F. Supp. 2d 401, 412–13 & n.17 (S.D.N.Y. 2002) (applying *Hustler* to parody; trademark liability would be "at odds with the principles articulated in that case"); *Smithfield Foods, Inc. v. United Food and Commercial Workers Int'l Union*, 585 F. Supp. 2d 815, 820–21 (E.D. Va. 2008) ("[I]f a plaintiff seeks damages which are 'reputational' in nature, constitutional libel standards (i.e., falsity and actual malice) apply to the plaintiff's damage claims. To allow otherwise would be to countenance 'an end-run around First Amendment strictures.' . . . [T]he label of the claim is not dispositive. . . .") (quoting *Food Lion, Inc. v. Capital Cities/ABC, Inc.*, 194 F.3d 505, 522 (4th Cir. 1999)); *see also Compuware Corp. v. Moody's Investors Servs., Inc.*, 499 F.3d 520, 530 (6th Cir. 2007) (same); *Beverly Hills Foodland, Inc. v. United Food & Commercial Workers Union, Local 655*, 39 F.3d 191, 196 (8th Cir. 1994) (same).

Even as applied to commercial speech, dilution's restraints on truthful, nonmisleading speech are illegitimate because dilution does not protect consumers and competitors against deception, but rather privileges a

trademark owner’s preferred meaning for its marks. As Justice Kennedy wrote:

A subject that is first defined by content and then regulated or censored by mandating only one sort of comment is not viewpoint neutral. . . . By mandating positivity, the law here might silence dissent and distort the marketplace of ideas.

. . . The danger of viewpoint discrimination is that the government is attempting to remove certain ideas or perspectives from a broader debate. That danger is all the greater if the ideas or perspectives are ones a particular audience might think offensive, at least at first hearing.

Tam, 137 S. Ct. at 1766–67 (Kennedy, J., concurring); see also *R.A.V. v. City of St. Paul*, 505 U.S. 377, 388 (1992) (“A State might choose to prohibit only that obscenity which is the most patently offensive in its prurience. . . . But it may not prohibit, for example, only that obscenity which includes offensive political messages.”); Mark P. McKenna, *Dilution and Free Speech in the U.S.*, *Reprise*, https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3352090 (2019); Rebecca Tushnet, *Gone in 60 Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 554–58 (2008).

JDPI is concerned that Bad Spaniels will pollute the meaning of its mark. But there’s nothing false in VIP’s parody. At a minimum, citizens, not courts, should judge the worth of truthful, nonmisleading content.

As noted above, absent an interest in preventing commercial deception, strict scrutiny applies to regulations of the content of speech. There is no compelling or substantial interest in suppressing a message out of fear that it might lead audiences to think differently. Mary LaFrance, *No Reason to Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech*, 58 S.C. L. REV. 709, 719 (2007) (“[A]ny harm to the value of the trademarks affected by dilutive speech interferes only with the ability of the trademark owners to psychologically manipulate consumers. Preserving the ability of trademark owners to influence consumers in this way does not amount to a substantial governmental interest.”); Ramsey, *supra*, at 443–61 (dilution laws are viewpoint-based and unconstitutional).

Dilution law reflects a paternalism that this Court has condemned: the fear is that people may make the “wrong” decisions because their opinion of or level of attention to a famous mark has been changed. But, in the absence of falsity or deception, it is for people themselves to make such decisions. As Justice Thomas wrote, “when the government seeks to restrict truthful speech in order to suppress the ideas it conveys, strict scrutiny is appropriate, whether or not the speech in question may be characterized as “commercial.” *Tam*, 137 S. Ct. at 1769 (Thomas, J., concurring) (cleaned up); *see also* 44 *Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 503 (1996) (Stevens, J.) (“Precisely because bans against truthful, nonmisleading commercial speech rarely seek to protect consumers from

either deception or overreaching, they usually rest solely on the offensive assumption that the public will respond ‘irrationally’ to the truth. The First Amendment directs us to be especially skeptical of regulations that seek to keep people in the dark for what the government perceives to be their own good.”) (cleaned up).

Freedom for nonmisleading speech frees speakers and audiences to develop their own value systems and judgments. When we allow trademark law to avoid that fact-based constraint, we are returning to the protection of the powerful against *lèse-majesté*, a concept rejected throughout the rest of First Amendment law. See *Red Lion Broad. Co. v. FCC*, 395 U.S. 367, 390 (1969) (“It is the purpose of the First Amendment to preserve an uninhibited marketplace of ideas in which truth will ultimately prevail, rather than to countenance monopolization of that market. . . .”).

It is indeed possible that the free flux of meaning can change the relative economic positions of particular actors in the system. But, as the *Tam* Court made clear, that result is a benefit, not a cost, of a system that protects freedom of speech. Dilution represents a disagreement with this core constitutional commitment to communication-driven change. Allowing audiences to choose from a variety of competing meanings, experiences, and opinions is generally a First Amendment value, not a harm to be avoided.



CONCLUSION

Trademarks can be, and often are, used for far more than source identification. As Ronald Reagan's famous repurposing of the Wendy's "Where's the Beef?" slogan showed, they can take on significance beyond what a trademark owner wants. But trademarks are not monopolies, and the law should not encourage trademark owners to try to convince consumers that references to them, even prominent ones, require permission. The judgment of the Court of Appeals should be affirmed.

Respectfully submitted,

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