

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 AUTHORS ALLIANCE
AND COMICMIX AS *AMICI CURIAE*
IN SUPPORT OF RESPONDENT**

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TABLE OF CONTENTS

	Page
TABLE OF CONTENTS	i
TABLE OF AUTHORITIES	iii
INTEREST OF <i>AMICI CURIAE</i>	1
SUMMARY OF ARGUMENT	1
ARGUMENT	4
I. Authors Engaging in Noncommercial Speech Must Receive the Highest Level of Constitutional Protection	4
A. Commentary on Brands, Even When Unwanted or Unbecoming, Should Re- ceive the Same Protections as Com- mentary on Public Figures	5
B. Procedural Protections Can Ensure that the Lanham Act Remains Within First Amendment Limits	10
II. The Use of Brand Names Is Vital to Liter- ary Expression and Could Be Chilled by Over-Enforcement of Trademark Law	14
III. <i>Rogers</i> Allows Courts to Resolve Cases Earlier and at Lower Cost, Protecting Au- thors' Ability to Exercise Noncommercial Speech in Practice	18
A. Authors Often Lack the Resources for High-Cost Trademark Litigation, Which May Have a Chilling Effect on Authors' Noncommercial Speech	19
B. The Likelihood of Confusion Inquiry Is Costly and Time-Consuming	22

TABLE OF CONTENTS—Continued

	Page
C. The <i>Rogers</i> Test Expressly Incorporates First Amendment Considerations and Reduces the Chilling Effects of Costly Trademark Litigation on Creators' Protected Speech	23
CONCLUSION.....	31

TABLE OF AUTHORITIES

	Page
CASES	
<i>AMF Inc. v. Sleekcraft Boats</i> , 599 F.2d 341 (9th Cir. 1979)	22
<i>Anheuser-Busch, Inc. v. Balducci Publ'ns</i> , 28 F.3d 769 (8th Cir. 1994).....	11
<i>Baggett v. Bullitt</i> , 377 U.S. 360 (1964)	25
<i>Campbell v. Acuff-Rose Music, Inc.</i> , 510 U.S. 569 (1994).....	8
<i>City of Austin v. Reagan Nat'l Adver. of Austin, LLC</i> , 142 S. Ct. 1464 (2022).....	10
<i>City of Lakewood v. Plain Dealer Publ'g Co.</i> , 486 U.S. 750 (1988)	12
<i>Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.</i> , 886 F.2d 490 (2d Cir. 1989)	26, 27
<i>Curtis Publ'g Co. v. Butts</i> , 388 U.S. 130 (1967)	6
<i>Dombrowski v. Pfister</i> , 380 U.S. 479 (1965).....	24, 25
<i>Frehling Enters., Inc. v. Int'l Select Grp., Inc.</i> , 192 F.3d 1330 (11th Cir. 1999).....	22
<i>Hustler Magazine v. Falwell</i> , 485 U.S. 46 (1988)....	5, 6, 7
<i>L.L. Bean, Inc. v. Drake Publs., Inc.</i> , 811 F.2d 26 (1st Cir. 1987)	14, 16, 18
<i>Lamparello v. Falwell</i> , 420 F.3d 309 (4th Cir. 2005)	6
<i>Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC</i> , 507 F.3d 252 (4th Cir. 2007)	10

TABLE OF AUTHORITIES—Continued

	Page
<i>Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.</i> , No. 1:14-cv-03419, 2018 WL 317850 (S.D.N.Y. Jan. 8, 2018), <i>aff'd</i> , 764 F. App'x 39 (2d Cir. 2019)	30
<i>Matal v. Tam</i> , 137 S. Ct. 1744 (2017)	7
<i>Mattel, Inc. v. MCA Recs., Inc.</i> , 296 F.3d 894 (9th Cir. 2002)	3, 4, 11-13, 16, 18, 24, 31
<i>Mattel, Inc. v. Walking Mountain Prods.</i> , 353 F.3d 792 (9th Cir. 2003).....	29
<i>Mattel, Inc. v. Walking Mountain Prods.</i> , No. 2:99-cv-08543 (C.D. Cal. Nov. 11, 2001).....	29, 30
<i>Mattel, Inc. v. Walking Mountain Prods.</i> , No. 2:99-cv-08543, 2004 WL 1454100 (C.D. Cal. Jun. 21, 2004)	29, 30
<i>NAACP v. Button</i> , 371 U.S. 415 (1963).....	24
<i>New York Times v. Sullivan</i> , 376 U.S. 254 (1964)	7
<i>Octane Fitness, LLC v. ICON Health & Fitness, Inc.</i> , 572 U.S. 545 (2014)	29
<i>Ohralik v. Ohio State Bar Ass'n</i> , 436 U.S. 447 (1978).....	10
<i>Parks v. LaFace Recs.</i> , 329 F.3d 437 (6th Cir. 2003)	24
<i>Polaroid Corp. v. Polarad Elecs. Corp.</i> , 287 F.2d 492 (2d Cir. 1961)	22, 27
<i>Rogers v. Grimaldi</i> , 695 F. Supp. 112 (S.D.N.Y. 1988), <i>aff'd</i> , 875 F.2d 994 (2d Cir. 1989)	25, 26

TABLE OF AUTHORITIES—Continued

	Page
<i>Rogers v. Grimaldi</i> , 875 F.2d 994 (2d Cir. 1989)	3, 4, 12, 13, 16, 18, 19, 23-29, 31
<i>Smith v. Wal-Mart Stores, Inc.</i> , 537 F. Supp. 2d 1302 (N.D. Ga. 2008)	27
<i>Smith v. Wal-Mart Stores, Inc.</i> , No. 1:06-cv- 00526, 2008 WL 11406073 (N.D. Ga. Jun. 23, 2008)	27
<i>Starbucks Corp. v. Dwyer</i> , No. 3:00-cv-01499 (N.D. Cal. June 8, 2000)	28
<i>Steaks Unlimited, Inc. v. Deaner</i> , 623 F.2d 264 (3d Cir. 1980)	7
<i>Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.</i> , 683 F.3d 1266 (11th Cir. 2012)	24
<i>Video-Cinema Films, Inc. v. Cable News Net- work, Inc.</i> , No. 1:98-cv-07128, 2003 WL 1701904 (S.D.N.Y. Mar. 31, 2003)	30
<i>VIP Prods. LLC v. Jack Daniel’s Props.</i> , 953 F.3d 1170 (9th Cir. 2020)	8
<i>Wal-Mart Stores, Inc. v. Samara Bros.</i> , 529 U.S. 205 (2000)	20
<i>Westchester Media v. PRL USA Holdings, Inc.</i> , 214 F.3d 658 (5th Cir. 2000)	24
 STATUTES	
15 U.S.C. § 1117(a)	28, 29
15 U.S.C. § 1125(c)(3)(C)	11, 13

TABLE OF AUTHORITIES—Continued

	Page
OTHER AUTHORITIES	
AM. INTELL. PROP. L. ASS'N, 2021 REPORT OF THE ECONOMIC SURVEY (2021)	20, 23
<i>Authors Guild Survey Shows Drastic 42 Percent Decline in Authors Earnings in Last Decade,</i> THE AUTHORS GUILD (Jan. 5, 2019)	20, 29
<i>CBLDF Case Files – Starbucks v. Dwyer</i> , COMIC BOOK LEGAL DEF. FUND	21
CORY DOCTOROW, <i>DOWN AND OUT IN THE MAGIC KINGDOM</i> (2003)	15
DAVID FOSTER WALLACE, <i>INFINITE JEST</i> (Back Bay Books 2016) (1996)	14, 15
DEAN KOONTZ, <i>HIDEAWAY</i> (1992)	16
DONNA TARTT, <i>THE GOLDFINCH</i> (Back Bay Books 2015) (2013)	15
Gary Phillips, <i>Sporting Men</i> , in <i>FULL HOUSE</i> (Pete Hautman ed., Penguin Young Readers 2007)	17
JENNIFER EGAN, <i>A VISIT FROM THE GOON SQUAD</i> (Anchor Books 2010)	14, 15
JIMMY HAIGHT, <i>JACK AND COKE</i> (2018)	17
LAUREN WEISBERGER, <i>THE DEVIL WEARS PRADA</i> (2003)	15
<i>Rates & Fees</i> , KEEGAN & DONATO CONSULTING, LLC	22
RICK RIORDAN, <i>THE LAST KING OF TEXAS</i> (2001)	16

TABLE OF AUTHORITIES—Continued

	Page
Robert C. Denicola, <i>Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols</i> , 1982 WIS. L. REV. 158 (1982)	18
<i>Royalties</i> , KINDLE DIRECT PUBLISHING	19
Sarah Nicolas, <i>How much do authors make per book?</i> , BOOK RIOT (May 11, 2021)	19
 RULES	
Fed. R. Civ. P. 12(b)(6)	23
Fed. R. Civ. P. 56	23

INTEREST OF *AMICI CURIAE*¹

Authors Alliance is a 501(c)(3) non-profit organization with over 2,300 members. Its mission is to advance the interests of authors who want to serve the public good by sharing their creations broadly. ComicMix is a book publisher and digital news provider offering creation, coverage, and commentary on comic books and other popular culture. *Amici* have no pecuniary interest in the outcome of this case but have professional interests in seeing that the law develops in a manner that protects free expression. We urge the Court to consider the ways in which the consumer protections of trademark and related bodies of law impact the ability of creators to practice their crafts.

**SUMMARY OF ARGUMENT**

Trademarks are a cornerstone of our shared cultural vernacular. Popular brands are woven into the fabric of our national identity, recognizable by and meaningful to Americans from many different backgrounds. Authors often draw on these shared associations in their literary works, sending beloved fictional characters to real colleges, serving them familiar cereals, and outfitting them in well-known clothing labels.

¹ Pursuant to Supreme Court Rule 37, counsel for *amici curiae* represent that no counsel for a party authored this brief in whole or in part and that none of the parties or their counsel, nor any other person or entity other than *amici* and their counsel, made monetary contributions intended to fund the preparation or submission of this brief.

Whether to evoke nostalgia or to immerse their readers, authors use trademarks both to simulate reality and to critique it.

This case puts that enduring tradition at risk. While trademark law aims to protect consumers and prevent confusion as to the source of goods or services, it must be enforced in a manner consistent with the speech protections guaranteed by the First Amendment. The freedom of authors to use trademarks in their works could be stifled by the threat of litigation. Overenforcement of trademark law runs contrary to both the purpose of intellectual property and our constitutional legacy of protecting free expression.

The precedent set by the Court's decision in this case will reach far beyond whiskey bottles and dog toys, impacting the creative autonomy of artists nationwide. If heightened First Amendment protections are not incorporated into the infringement and dilution inquiries, the threat of costly legal proceedings may cause creators to avoid the use of trademarks in their artistic works. While litigation is commonplace for large corporations with significant legal resources, even a single lawsuit could be career-ending for an author without the resources to handle it. If the threat of legal sanction hangs over the heads of writers, their literary characters may no longer use iPhones, eat at McDonald's, or visit Disneyland. These uses offer meaningful expressive value to authors. Brands are often intentionally selected as cultural signifiers, chosen for the implicit associations they convey to readers. Even when trademarks are evoked in literary

circumstances that their owners find distasteful, these uses are still expressive and noncommercial, thus worthy of the highest First Amendment protection. Prioritizing the pecuniary interests of trademark owners over the First Amendment rights of creative artists could lead to a catastrophic chilling effect on authors' speech based on the perceived risk of litigation, whether or not such risk is actualized. This result is both untenable and entirely unnecessary. It is possible to ensure that trademark owners still have access to a wide variety of robust and reasonable remedies in cases of *true* infringement without creating unnecessary panic in many other circumstances.

This Court has a clear doctrinal path to avoiding a speech-suppressive environment. In *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), the Second Circuit struck a balance between the interests of trademark owners and First Amendment speech by crafting a clear and efficient test for infringement with appropriate protections for speech. The *Rogers* court recognized the mark owner's interest in preventing confusion while ensuring adequate protection for the vital free speech principles at play, and provided a rule to determine when expressive works infringe. The Ninth Circuit has also developed a clear mechanism for safeguarding First Amendment rights in dilution actions by interpreting the Lanham Act's "noncommercial use" dilution exception as encompassing all First Amendment noncommercial speech. See *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 903 (9th Cir. 2002). This appropriately balances trademark owners' need to preserve

the integrity of their marks against authors' interests in parody and criticism of the modern "public figure" brands. *Amici* urge the Court to adopt these heightened safeguards for expressive uses of trademarks to balance the guarantees of the First Amendment with the consumer protection objectives of trademark law.

A ruling in Petitioner's favor could strike fear into the hearts of risk-averse creators, chilling their speech by discouraging them from using certain trademarks altogether. Thus, a trademark infringement analysis that does not consider free expression interests provides insufficient legal protection to core First Amendment speech. Without First Amendment protections like those introduced in *Rogers* and *Mattel*, authors will engage in unnecessary self-censorship rather than risk costly litigation.

◆

ARGUMENT

I. Authors Engaging in Noncommercial Speech Must Receive the Highest Level of Constitutional Protection.

Trademark law must yield to the First Amendment, not vice versa. The courts have long encouraged free discourse and protected criticism of public figures, and similar principles apply to creative commentary on popular brands. Moreover, the mere fact that a work is sold for money does not detract from its expressive elements or alter the constitutional protection that it should be afforded. To remain consistent with the

Constitution's speech guarantees, the Lanham Act must be interpreted to incorporate heightened First Amendment protections into the dilution and infringement inquiries.

A. Commentary on Brands, Even When Unwanted or Unbecoming, Should Receive the Same Protections as Commentary on Public Figures.

The work of writers has always served a pivotal function in preserving and promoting the democratic principles foundational to our national identity. From Thomas Paine's *Common Sense*, which took aim at the King of England, to Curtis Sittenfeld's *Rodham*, a best-selling fictionalized imagining of Hillary Clinton's life and political career in a world where she had not married Bill Clinton, influential new ideas penned by bold, often subversive voices play a vital role in our democracy, even when they take aim at powerful figures who may wish that their names were kept out of writers' mouths.

Such speech has received First Amendment protection even when its targets would prefer that creators target others. In fact, protecting controversial and unpopular speech is *particularly* vital to the vibrant, democratic discourse that the First Amendment aims to secure. The Court has repeatedly recognized creators' ability to comment on the actions of public figures, including through satire and parody. In *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46 (1988), *Hustler* magazine

faced a lawsuit over its production of a satirical advertisement for Campari featuring Jerry Falwell, a well-known conservative evangelical preacher, explaining his “first time” involved an incestuous encounter with his mother while drinking. *Id.* at 48. In dismissing Falwell’s claim for intentional infliction of emotional distress, the Court held that the First Amendment interests at issue mandated a heightened procedural standard for such claims, because the “robust political debate encouraged by the First Amendment is bound to produce speech that is critical of those who hold public office or those public figures who are ‘intimately involved in the resolution of important public questions or, by reason of their fame, shape events in areas of concern to society at large.’” *See id.* at 51 (quoting *Curtis Publ’g Co. v. Butts*, 388 U.S. 130, 164 (1967) (Warren, C.J., concurring in the judgment)). Indeed, after Falwell’s loss in *Hustler*, the Fourth Circuit rejected Falwell’s subsequent attempt to use trademark law to police criticism using his name because of its potential infringement on critics’ First Amendment rights. *See Lamparello v. Falwell*, 420 F.3d 309, 319 (4th Cir. 2005).

These same considerations apply when the subject of criticism is a brand, not just a person. Today, corporations are often “intimately involved in the resolution of important public questions” or in “shap[ing] events in areas of concern.” *See Hustler*, 485 U.S. at 51 (quoting *Curtis Publ’g*, 388 U.S. at 164). “[B]y reason of their fame,” such an entity can be considered as much a public figure by the Court’s definition in *Curtis Publ’g Co.*

as any individual person. *See id.* It stands to reason that the same protections courts have historically afforded to commentary about public officials and public figures, justified by their role in “society at large,” extend to speech criticizing the powerful, influential entities so often identified by—and engaged in the aggressive defense of—their recognizable trademarks. *See id.*; *see also Steaks Unlimited, Inc. v. Deaner*, 623 F.2d 264, 272 (3d Cir. 1980) (holding that a corporation was a public figure with regard to the material of its advertising campaign). In *Hustler*, the satirical advertisement played on a recognizable brand to make its point about both Falwell *and* Campari. To afford a higher grade of First Amendment protection to a critique of the former, while asking authors to tread carefully around the latter, is inconsistent with our constitutional guarantees.

Although parodic speech and other expressive criticism will not always be pleasing to all readers, the ostensible value or popularity of that speech does not determine its eligibility for protection. *Hustler*, 485 U.S. at 51 (citing *New York Times Co. v. Sullivan*, 376 U.S. 254, 270 (1964)). The Court clarified the relevance of this principle to the trademark context in *Matal v. Tam*, 137 S. Ct. 1744 (2017), where it considered a claim contesting the denial of registration for a mark including a racial slur. Affirming the holding of the Federal Circuit, the Court found the Lanham Act’s antidisparagement clause facially unconstitutional under the First Amendment and allowed registration of the mark. *See id.* at 1765. In doing so, the Court

continued its long tradition of providing constitutional protection for expressive speech without regard for normative standards of quality or decency.

Asking the Court to engage in qualitative evaluation as to the value of contested speech would go against the judiciary's core principle of aesthetic non-discrimination, ultimately producing censorial effects far more harmful than the negative social impacts of any single instance of "low-value" speech. *See also Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 583 (1994) (explaining that a parody's effectiveness does not bear on its eligibility for First Amendment protection); *see also VIP Prods. LLC v. Jack Daniel's Props., Inc.*, 953 F.3d 1170, 1175 (9th Cir. 2020) (emphasizing that a work need not be "the equivalent of the *Mona Lisa*" to qualify as an expressive work). Time and time again, courts have held that speech is not any less worthy of protection just because it upsets someone. This doctrine should apply equally to all contested speech—whether vulgar social commentary, parodies in poor taste, or the creative use of a trademark that happens to irk a corporate owner. The case at bar contemplates all three. *See* Pet'r's Br. 3 (noting that "poop humor has its time and place, particularly for toddlers and young children," and implying that any excrement-related parody is categorically incompatible with its brand).

Allowing trademark litigation to depart from the procedural protections required by the First Amendment carries significant risks. Rather than trusting American artists and commentators to exercise their commonsense judgment when dealing with expressive

trademark uses, Jack Daniel’s advocates a trademark regime with zero tolerance for even the possibility of confusion, at the expense of core First Amendment speech. While heightened application of First Amendment principles may produce a limited risk of slight consumer confusion about a given work’s origin, an overbroad trademark regime would have a less visible, yet far more devastating impact on free speech and democracy writ large. The inherent power imbalance—in terms of both financial resources and legal fluency—between the corporate behemoths most inclined to overzealously enforce their trademarks and individual creators who may find themselves on the receiving end of this enforcement deserves careful attention from the Court. The typical corporate mark-holder will almost always have much to gain from merely pursuing a given claim—win or lose. The typical author, on the other hand, has everything to lose from costly, protracted litigation, no matter how frivolous the claim.

Whether or not the Court concludes that a dog toy constitutes an expressive work in the case at hand, its ruling should not depart from our constitutional tradition of subjecting the powerful to critique and commentary. “Jack Daniel’s” (the brand) should not be insulated from the type of commentary to which “Jack Daniel” (the person) would be subject in creative works; indeed, such an outcome would be impermissible under the First Amendment.

B. Procedural Protections Can Ensure that the Lanham Act Remains Within First Amendment Limits.

While the Lanham Act was designed with commercial speech in mind, it also regulates speech that goes beyond the mere proposition of a commercial transaction, including expressive elements as well. Noncommercial speech is entitled to the highest level of First Amendment protection. *See Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 456 (1978). This requires courts to apply strict scrutiny analysis to content-based limits on noncommercial speech, assessing whether any regulation is narrowly tailored to support a compelling government interest. *City of Austin v. Reagan Nat'l Advert. of Austin, LLC*, 142 S. Ct. 1464, 1471 (2022). To ensure the Lanham Act provides the constitutionally required level of protection for expressive uses of trademarks, the Court should mandate direct consideration of First Amendment interests in determining questions of infringement and dilution.

Without procedural protections, the Lanham Act's generally applicable standards do not adequately protect noncommercial speech. First, while some argue that First Amendment interests are adequately accommodated in the infringement inquiry through the existing likelihood of confusion factors, *see, e.g., Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260–61 (4th Cir. 2007) (determining a parodic “Chewy Vuiton” dog toy did not infringe using only the Fourth Circuit's likelihood of confusion factors), experience has shown this to be a dangerously unreliable

proxy for robust, independent First Amendment analysis. *See, e.g., Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 776 (8th Cir. 1994) (finding “Michelob Oily” parodic noncommercial speech infringed because it raised likelihood of confusion to a degree not “necessary to achieve the desired commentary”).

Second, the dilution statute’s exception to actions for “noncommercial *use*” of a mark is not broad enough to protect all expressive First Amendment uses of trademarks. *See* 15 U.S.C. § 1125(c)(3)(C) (emphasis added). This provision can and should be interpreted to shield the full scope of First Amendment noncommercial speech from dilution actions, as the Ninth Circuit has done. *See Mattel*, 296 F.3d at 903 (finding that constitutional avoidance and legislative history suggest interpreting § 1125(c)(3)(C) noncommercial *use* as being coextensive with constitutionally protected noncommercial *speech*). However, even if interpreted this way, it does not apply in cases of trademark infringement rather than dilution, leaving potentially confusing uses to be evaluated without the benefit of First Amendment considerations. The exception for “noncommercial *use*” under § 1125(c)(3)(C) cannot, by itself, remedy the potential constitutional deficiencies or chilling effects of trademark law.

Given the First Amendment’s monumental import and this Court’s repeated efforts to guarantee its protections, it follows that authors engaging in noncommercial speech of the kind contemplated by the Constitution do not summarily cede their rights to do so under a statute. To ensure that the Lanham Act is

enforced in a way that is consistent with the Constitution, the Court must balance trademark protection against countervailing First Amendment considerations, accounting for the interests of the public in a free and unrestrained marketplace of ideas as well as the interests of trademark owners in preserving the integrity of their marks. *Amici* do not attempt to suggest that the Lanham Act regulates speech in a manner that is unconstitutional—rather, principles of constitutional avoidance require the Act’s standards for infringement and dilution to incorporate heightened protection for noncommercial speech contemplated by the First Amendment, as in *Rogers* and *Mattel*.

The highest degree of First Amendment protection applies not only to speech distributed for free, but also to speech that is sold but does not merely advertise a product. See *City of Lakewood v. Plain Dealer Publ’g Co.*, 486 U.S. 750, 756 n.5 (1988) (“[T]he degree of First Amendment protection is not diminished merely because the . . . speech is sold rather than given away.” (citation omitted)). *Amici* note the difference between non-advertising speech and commercial speech because many transactions that authors engage in are not advertising *per se*, but do aim to turn a profit. Under the approach advocated by Petitioner, an author who offers their book for sale or merely uses ad-supported hosting platforms to expand their audience and financially support their work, may be subject to demanding, complex, and expensive trademark review whenever they reference popular brands in their work. See Pet’r’s Br. 40–41 (“[I]t stretches the English

language to call for-profit selling a non-commercial use. . . . [T]he noncommercial-use exclusion does not extend to sales of goods or services.”). Authors engaging in any for-profit distribution of works which make expressive, non-advertising use of trademarks may have neither the protection of § 1125(c)(3)(C) against claims of tarnishment, nor the protection of heightened First Amendment scrutiny. They would be shielded only by the standard Lanham Act analysis designed primarily for non-expressive, origin-signaling uses of marks in the course of trade—a use entitled to a wholly different, and significantly lower, standard of constitutional protection.

Whatever its conclusion as to dog toys, the Court should be sure to speak decisively on this matter as it applies to authorial works and creative works generally. For authors, the mere threat of litigation under an overbroad trademark regime has the capability to chill speech, depriving the public of invaluable new ideas, dialogue, and criticism. While courts have yet to adopt a universal approach, the *Rogers* test and the *Mattel* interpretation of the § 1125(c)(3)(C) exception offer intelligible and efficient frameworks, already used by many circuits, for incorporating the requisite First Amendment analysis into trademark infringement and dilution inquiries when noncommercial speech is at issue.

II. The Use of Brand Names Is Vital to Literary Expression and Could Be Chilled by Over-Enforcement of Trademark Law.

Whereas the harms produced by consumer confusion are largely contained and redressable, chilling effects are insidious and long-lasting. Even taken to their extreme, the consequences of confusion or dilution as to a given mark are largely identifiable, economic, and isolated. By comparison, the suppression of literary expression may go unnoticed even as it has ripple effects on the work of an entire generation. Brands are “woven into the fabric” of American life. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir. 1987). As such, they are a vital part of literature. Authors often make use of word marks in order to create settings that both reflect and critique modern society. Examples from canonical literary works demonstrate that trademarks are not only pervasive, but also indispensable in contemporary fiction. David Foster Wallace’s *INFINITE JEST* comments on American consumerism by marking time via trademarked items, such as “Year of the Whisper-Quiet Maytag Dishmaster” and “Year of the Trial-Size Dove Bar.” *DAVID FOSTER WALLACE, INFINITE JEST* 438–62 (Back Bay Books 2016) (1996).

In addition to parody and commentary, trademarks are often used for verisimilitude and imagery. Jennifer Egan’s Pulitzer Prize–winning novel *A VISIT FROM THE GOON SQUAD* contains a vignette in which a “charcoal gray Jaguar . . . peel[s] downhill along tiny streets, sending pedestrians lunging against walls and

darting into doorways to avoid being crushed.” JENNIFER EGAN, *A VISIT FROM THE GOON SQUAD* 152 (Anchor Books 2010). The specificity of the brand name changes the valence of the image, evoking a fuller mental picture than would come from a generalized description of a luxury car.

Other authors have even been known to make use of this effect in the titles of their novels, juxtaposing familiar brands with unfamiliar circumstances in order to convey the tone of the work to their reader. Cory Doctorow’s *DOWN AND OUT IN THE MAGIC KINGDOM* would have a different meaning if it were instead titled “Down and Out in an Amusement Park.” CORY DOCTOROW, *DOWN AND OUT IN THE MAGIC KINGDOM* (2003). Similarly, “The Devil Wears Luxury Clothing” is not as evocative as *THE DEVIL WEARS PRADA*. LAUREN WEISBERGER, *THE DEVIL WEARS PRADA* (2003).

Word marks are also useful for smaller instances of imagery: describing something as “Day-Glo green,” EGAN, *supra*, at 47, noting “insects of Volkswagen size,” WALLACE, *supra*, at 573, or even having a character attend a real university. In Donna Tartt’s *THE GOLDFINCH*—also a recipient of the Pulitzer Prize—the protagonist describes a history teacher who had “grown up in a tough Boston neighborhood and ended up going to Harvard.” DONNA TARTT, *THE GOLDFINCH* 126 (Back Bay Books 2015) (2013). The use of this mark allows the reader to make a series of inferences that convey meaning and give the story texture, in a way that would be difficult without drawing on cultural context from the real world. Even when these books “conjure

associations that clash with the associations generated by the owner’s lawful use of the mark,” they do so in a way that carries little risk of consumer harm, given the fact that corporations are generally not in the business of authoring books. *L.L. Bean*, 811 F.2d at 31; *see also Mattel*, 296 F.3d at 902 (holding that under the *Rogers* test, the song “Barbie Girl” does not infringe Mattel’s trademark because “[t]he song title does not explicitly mislead as to the source of the work; it does not, explicitly or otherwise, suggest that it was produced by Mattel”).

Even Jack Daniel’s itself has been subject to the literary treatment many times. For instance, take this excerpt from *HIDEAWAY* by Dean Koontz:

The half-full bottle of Jack Daniel’s whacked the side of the sleeping man’s head with such impact that it was almost as loud as a gunshot blast. . . . The man was no longer merely sleeping. He had been hammered into a deeper level of unconsciousness.

DEAN KOONTZ, *HIDEAWAY* 168 (1992). Similarly, in *THE LAST KING OF TEXAS*, author Rick Riordan describes a fictional doctor whose “breath smelled distinctly of Jack Daniel’s” while she stitched up the narrator’s wound. RICK RIORDAN, *THE LAST KING OF TEXAS* 315 (2001). In these books, mentioning a particular brand of whiskey evokes a specific image in the mind of the reader, allowing them to make further inferences about the characters and settings involved.

The brand has become so pervasive that it can even be referenced by shorthand. *See, e.g.*, Gary Phillips, *Sporting Men*, in *FULL HOUSE* 67 (Pete Hautman ed., 2007) (character asking a teenager to “[m]ix him a Jack and Coke,” referencing the popular cocktail that features Jack Daniel’s whiskey); *see also* JIMMY HAIGHT, *JACK AND COKE* (2018) (title alluding to the same cocktail). Though some of these associations may be at odds with “the brand’s history and tradition,” Pet’r’s Br. 11, they are First Amendment-protected creative expression, nonetheless.

The company’s brief itself notes that Jack Daniel’s whiskey is often featured in film and television. *Id.* at 12 (filing evidence from *Raiders of the Lost Ark*, *30 Rock*, *Criminal Minds*, and other visual media). Petitioner uses these examples to demonstrate the brand’s popularity without addressing the fact that these cameos could be in jeopardy if the Court prioritizes trademark ownership over artistic expression. Jack Daniel’s may well approve of these uses, perhaps even granting licenses for some of them; however, licensing is insufficient. In practice, seeking a license is time consuming and expensive. Authors with limited legal and financial resources should be able to rely on the First Amendment in order to use marks in creative and parodic expression without fear of liability. Authors whose depictions of the brand are unwanted or critical should not be at a heightened risk of litigation simply because their uses are less amenable to the corporate owner and, therefore, more difficult to get approved via licensing. As the Ninth Circuit once wrote, “[w]ith fame

often comes unwanted attention.” *Mattel*, 296 F.3d at 899. Corporations cannot require artists to seek licenses for every mention of a trademark.

Though the parodic dog toy created by VIP Products differs meaningfully from the use of trademarks in other media, if the toy is ruled to be noncommercial speech, then the Court’s holding on the question of infringement will likely apply to creative industries as well. If authors and publishers nationwide feel that they are putting themselves at risk every time they include a word mark in their books, they will be deprived of “an important, perhaps at times indispensable, part of the public vocabulary.” *L.L. Bean*, 811 F.2d at 30 (quoting Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 195–96 (1982)). The mere threat of litigation could be enough to change the industry’s risk calculus. A trademark-protective ruling in this case, favoring Jack Daniel’s over VIP Products, would create a significant chilling effect, thereby changing the texture of American literature.

III. *Rogers* Allows Courts to Resolve Cases Earlier and at Lower Cost, Protecting Authors’ Ability to Exercise Noncommercial Speech in Practice.

Effective protection of creators’ First Amendment interests requires a doctrine that not only defends non-commercial speech in theory, but also allows for early

dismissal of trademark claims with minimal expense. Without a test like *Rogers*, which gives direct and focused consideration to First Amendment interests, the Court risks chilling noncommercial speech through unnecessarily expensive and time-consuming litigation.

A. Authors Often Lack the Resources for High-Cost Trademark Litigation, Which May Have a Chilling Effect on Authors' Noncommercial Speech.

Authors, as a class, are not wealthy. Traditionally published authors typically receive royalties of only 5% to 20% for print books and up to 25% for ebooks, which only begin to accrue after the author has “earned out” the advance paid by the publisher upon acquiring the book—a process that often takes years, if it happens at all. See Sarah Nicolas, *How Much Do Authors Make per Book?*, BOOK RIOT (May 11, 2021).² Self-published authors fare little better—they also receive a relatively small percentage of their sales. Amazon’s Kindle Direct Publishing program pays self-published authors 70% in royalties for ebooks priced \$2.99 to \$9.99 (minus a “file delivery” charge), but only 35% in royalties for ebooks priced outside that range and 40–60% in royalties for print editions (minus printing costs). *Royalties*, KINDLE DIRECT PUBL’G.³ Self-published authors

² <https://bookriot.com/how-much-do-authors-make-per-book/> [<https://perma.cc/HN22-H43D>].

³ https://kdp.amazon.com/en_US/help/topic/G202181110 (last visited Feb. 5, 2023) [<https://perma.cc/F43M-P9PA>].

also bear the financial burden of promoting their books, which sometimes exceeds their royalty income. To put this in practical terms, a 2018 Authors Guild survey of 5,067 authors, including traditionally published and self-published authors, reported a median annual income of only \$6,080 from authorship-related activities, excluding the many authors reporting zero book-related income. *Authors Guild Survey Shows Drastic 42 Percent Decline in Authors Earnings in Last Decade*, THE AUTHORS GUILD (Jan. 5, 2019).⁴ Even full-time authors reported a median annual income of only \$20,300. *Id.* While the average author income varies significantly between categories and genres, publishing models, and full- and part-time authors, it remains in most cases relatively low.

In contrast, trademark litigation is extremely expensive. In 2020, the reported median cost of trademark litigation *before trial* ranged from \$150,000 to \$588,000, depending on the amount in controversy. AM. INTELL. PROP. L. ASS'N, 2021 REPORT OF THE ECONOMIC SURVEY 63 (2021). In previous years, the upper end of this reported range has been as high as \$1,600,000. *Id.*

High litigation costs may deter lawful use of trademarks. *See Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 214 (2000) (“Competition is deterred . . . not merely by successful suit but by the plausible threat of successful suit. . .”). Authors’ limited financial resources

⁴ <https://authorsguild.org/news/authors-guild-survey-shows-dramatic-42-percent-decline-in-authors-earnings-in-last-decade/> [https://perma.cc/WDJ5-Y7ZK].

create an especially grave risk that the costs of trademark litigation will chill First Amendment protected speech. *See, e.g., CBLDF Case Files—Starbucks v. Dwyer, COMIC BOOK LEGAL DEF. FUND*⁵ (describing a comic book artist’s decision to settle a Starbucks parody infringement lawsuit due to financial pressures). Moreover, the cost to authors of engaging in litigation is not purely monetary. Many authors are motivated by the desire to have their works read by the widest possible audience, which requires significant time and effort. Authors caught up in litigation may find themselves unable to devote energy to their craft because of the time demands and emotional strain of litigation. The financial pressures of litigation may also require them to devote more time to full-time, non-authorial employment.

If trademark litigation imposes unnecessary and overwhelming financial barriers to authors seeking to vindicate their protected speech rights, it will undermine the constitutional guarantees of the First Amendment, chilling speech and impoverishing the United States’ valuable culture of artistic commentary and criticism. Low-income authors must not be priced out of using trademarks as parody or evocative references.

⁵ <https://cblfd.org/about-us/case-files/cblfd-case-files/dwyer/> (last visited Feb. 5, 2023) [<https://perma.cc/K7CG-VVEN>].

B. The Likelihood of Confusion Inquiry Is Costly and Time-Consuming.

Effective protection of First Amendment interests in the expressive use of trademarks does not merely require a test that secures the appropriate outcomes; the process by which these outcomes are reached matters profoundly. The standard likelihood of confusion inquiry is a fact-intensive balancing test, which often demands an extensive and expensive discovery process. As one example, every circuit places weight on evidence of actual confusion in the likelihood of confusion inquiry. *See, e.g., Frehling Enters., Inc. v. Int'l Select Grp., Inc.*, 192 F.3d 1330, 1335 (11th Cir. 1999) (“[T]he type of mark and the evidence of actual confusion are the most important [factors].”); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979). Because of this, it is common for defendants to conduct countersurveys to demonstrate the absence of consumer confusion and to hire rebuttal experts in survey design to challenge plaintiffs’ confusion surveys. These surveys alone are a significant litigation expense: one New York-based firm specializing in consumer surveys for intellectual property disputes quotes prices in a range of \$30,000 to \$80,000 per survey. *See Rates & Fees*, KEEGAN & DONATO CONSULTING, LLC.⁶

⁶ <https://www.keegandonato.com/consumer-survey-studies-rates-fees.html> [<https://perma.cc/9RLV-NFCD>].

Moreover, as a highly fact-dependent balancing test, the likelihood of confusion inquiry generally does not lend itself to disposition by motion to dismiss for failure to state a claim (under Fed. R. Civ. P. 12(b)(6)) or motion for summary judgment (under Fed. R. Civ. P. 56). Unfortunately, going to trial imposes a much greater financial burden, increasing the median cost of litigation by \$175,000 to \$412,000 depending on the amount in controversy. AM. INTELL. PROP. L. ASS'N, *supra*, at 63.

Even if the likelihood of confusion test were sufficient in theory to vindicate authors' First Amendment interests, in practice it raises a serious risk of deterring protected speech by forcing authors engaging in noncommercial speech to face a costly trial process.

C. The *Rogers* Test Expressly Incorporates First Amendment Considerations and Reduces the Chilling Effects of Costly Trademark Litigation on Creators' Protected Speech.

By providing a clear, limited-scope test for alleged infringement in cases implicating First Amendment interests, the *Rogers* test reduces the chilling effects of the threat of trademark litigation on authors' noncommercial speech. Efficient, accessible means for vindicating First Amendment interests in expressive uses of trademarks are critical, because "chilling effect[s] upon the exercise of First Amendment rights may derive from the fact of [litigation], unaffected by the

prospects of its success or failure.” *Dombrowski v. Pfister*, 380 U.S. 479, 487 (1965); *see also NAACP v. Button*, 371 U.S. 415, 433 (1963) (“[First Amendment] freedoms are delicate and vulnerable, as well as supremely precious in our society. The threat of sanctions may deter their exercise almost as potently as the actual application of sanctions.”). Just as burdensome litigation should not be permitted to stifle criticism of public figures and government action, it is imperative that popular commercial brands—influential modern-day “public figures”—are not permitted to wield the inexpediences of trademark litigation as a deterrent against commentary and parody that would be swiftly absolved, under the auspices of the First Amendment, in the absence of the use of a trademark.

Moreover, tailored legal standards designed to encourage the swift, efficient vindication of First Amendment interests are not novel. The *Rogers* test, long embraced by many of the circuit courts, *see, e.g., Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65 (5th Cir. 2000); *Parks v. LaFace Recs.*, 329 F.3d 437, 450 (6th Cir. 2003) (“[W]e find [the Second Circuit’s *Rogers* test] the most appropriate method to balance the public interest in avoiding consumer confusion with the public interest in free expression.”); *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 902 (9th Cir. 2002); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012), is a natural outgrowth of this Court’s past efforts to ensure First Amendment speech is not chilled by burdensome legal processes. In a line of civil rights cases in the 1960s,

this Court liberalized the procedure for challenging overbroad state legislation capable of interfering with First Amendment rights, to ensure it could be efficiently struck down without chilling speech. *See Dombrowski*, 380 U.S. at 487 (“[W]e have . . . avoided making vindication of freedom of expression await the outcome of protracted litigation.”); *Baggett v. Bullitt*, 377 U.S. 360, 378–79 (1964) (refusing to order abstention where it would create “undue” and “quite costly” delay, during which the challenged legislation would “inhibit the exercise of First Amendment freedoms”). In particular, this Court recognized that individuals should not be required to run the risk of criminal prosecution to exercise their First Amendment rights, *see Dombrowski*, 380 U.S. at 486; the same logic should extend to needlessly financially burdensome civil litigation. *Rogers’* targeted focus on First Amendment interests minimizes the burdens of litigation to necessary inquiries, minimizing its potential chilling effect and ensuring the Lanham Act stays within constitutional bounds.

The *Rogers* test is a relatively bounded, threshold-based inquiry that does not require intensive discovery. Under *Rogers*, courts must first determine whether use of the trademark has any “artistic relevance to the underlying work.” *Rogers*, 875 F.2d at 999. In *Rogers* itself, the district court judge determined that the film’s title, “Ginger and Fred,” was artistically relevant to the expressive work solely by examining the film at issue. *See Rogers v. Grimaldi*, 695 F. Supp. 112, 120 (S.D.N.Y. 1988), *aff’d*, 875 F.2d 994 (2d Cir. 1989). Even if broader factfinding were necessary to

apply this *Rogers* prong in some cases, it does not require expert testimony or the costly generation of survey data. Once any amount of artistic relevance “whatsoever” is found, *Rogers* then directs that the use does not violate the Lanham Act unless it “explicitly misleads as to the source or the content of the work.” *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989). This requirement can also typically be met through examination of the work and trademark at issue, due to its bright-line nature and high threshold; unlike the likelihood of confusion inquiry, there is no fact-intensive balancing to be performed. In *Rogers*, the Second Circuit ruled that even if survey evidence revealed a risk of confusion, it did not matter, because facial examination of the film revealed the risk was “not engendered by any overt claim in the title.” *Id.* at 1001. As a result, the *Rogers* test reduces the scope of discovery and increases the opportunity for resolution before trial, bringing down the costs of litigation.

Rogers’ impact on authors’ and artists’ effective exercise of protected speech becomes apparent in the contrast between cases where *Rogers* is applied and those where infringement is determined without direct consideration of the First Amendment. In *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490 (2d Cir. 1989), the creators of the satirical *Spy* magazine were sued over the publication of *SPY NOTES*, a stand-alone parodic study guide for three novels that satirized both the subject novels and the popular literary study guide, *CLIFFS NOTES*. *Id.* at 492. While the district court initially awarded a

preliminary injunction using the *Polaroid* likelihood of confusion factors, *id.* at 493, application of the *Rogers* principles enabled the Second Circuit to swiftly lift the injunction without further factfinding or remand, in time for Spy Notes to sell its obviously parodic study guide during its busiest season, *id.* at 495–97. The importance of such decisive action goes beyond safeguarding publishers’ bottom lines, as it ensures a free flow of ideas that enriches consumers’ lives and our collective culture.

In contrast, in *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302 (N.D. Ga. 2008), decided before the Eleventh Circuit adopted the *Rogers* test, obviously parodic “Walocaust” and “Wal-Qaeda” merchandise was subjected to a likelihood of confusion analysis, despite the district court’s recognition that the parodies were First Amendment noncommercial speech. *Id.* at 1317, 1340 (“The finding that [the defendant’s] concepts are parodies does not preclude the likelihood of confusion analysis, however; it merely influences the way the likelihood of confusion factors are applied.”). While Smith ultimately obtained summary judgment in his favor, this required hiring two experts to challenge the validity of Wal-Mart’s consumer-goods confusion survey. *See id.* at 1321–35. Smith made no profit selling his “Walocaust” and “Wal-Qaeda” products, *id.* at 1312, and vindicating Smith’s First Amendment rights required \$222,158.50 worth of legal services, *Smith v. Wal-Mart Stores, Inc.*, No. 1:06-cv-00526, 2008 WL 11406073, at *3 (N.D. Ga. June 23, 2008). In contrast, under the *Rogers* standard, VIP Products was able to

secure a judgment of non-infringement in this case without producing expensive countersurvey evidence against the Jack Daniel's consumer confusion survey. *See* Pet'r's Br. 27.

Similarly, in *Starbucks Corp. v. Dwyer*, No. 3:00-cv-01499 (N.D. Cal. Mar. 28, 2001), heard before the Ninth Circuit adopted enhanced First Amendment scrutiny for expressive trademark use, the district court issued a preliminary injunction against comic book artist Kieron Dwyer's "Consumer Whore" parody of the Starbucks logo under trademark law, despite recognizing it as a successful parody fully protected by the First Amendment. *See Starbucks Corp. v. Dwyer*, No. 3:00-cv-01499, slip op. at 4–5 (N.D. Cal. June 8, 2000). Dwyer was ultimately forced into a settlement, suppressing his protected social commentary on consumerism—and setting a precedent for future suppression of authors' brand-based speech, to the detriment of consumers and public discourse—because of the financial burdens of litigation.

Finally, where trademark owners decide to pursue litigation against obviously expressive uses of trademarks, *Rogers* offers potential grounds for awarding attorneys' fees and costs by clearly delineating permissible First Amendment uses of trademarks. This may deter meritless suits by overzealous trademark holders against lawful expressive uses, while simultaneously offering authors who are confronted with such litigation the financial capacity to defend their First Amendment interests. Under the Lanham Act, attorneys' fees can be awarded in "exceptional cases." 15

U.S.C. § 1117(a). In *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 792 (9th Cir. 2003), Mattel brought copyright and trademark infringement claims against an artist’s parodic “Food Chain Barbie” photo series, depicting Barbie dolls being attacked by vintage household appliances. *Id.* at 796–97. On remand, directed to apply *Rogers*, the district court ruled that Mattel’s trademark claim was “groundless and unreasonable” because the defendant’s use of the “Barbie” mark was “clearly relevant to his work” and “[did] not explicitly mislead.” *Mattel, Inc. v. Walking Mountain Prods.*, No. 2:99-cv-08543, 2004 WL 1454100, at *3 (C.D. Cal. June 21, 2004) (quoting *Walking Mountain Prods.*, 353 F.3d at 807). The district court awarded the parodist \$1,584,089 in attorneys’ fees and \$241,797.09 in costs. *Id.* at *4. For the majority of authors—earning a median annual income of only \$6,080 from authorship activities, see *Authors Guild Survey, supra*—such fees would make it all but impossible to vindicate their rights through litigation, even if the author had a strong expectation of winning. The artist behind “Food Chain Barbie” had earned only \$3,659 from the series prior to litigation. *Walking Mountain Prods.*, 353 F.3d at 797.

It is unlikely Mattel’s suit would have been found sufficiently baseless to qualify as “exceptional” under § 1117(a) without the clear, heightened bar of *Rogers*, even under the more generous modern *Octane Fitness* approach to attorneys’ fees, see *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545, 554 (2014). *Cf. Mattel, Inc. v. Walking Mountain Prods.*, No.

2:99-cv-08543, slip op. at 2 (C.D. Cal. Nov. 11, 2001) (denying the “Food Chain Barbie” artist’s request for attorney’s fees without explanation); *see also Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, No. 1:14-cv-03419, 2018 WL 317850, at *2 (S.D.N.Y. Jan. 8, 2018), *aff’d*, 764 F. App’x 39 (2d Cir. 2019) (denying fees, despite obvious parody, because “[e]ach of Louis Vuitton’s trademark claims—dilution by blurring and infringement—required the application of a fact-intensive, multifactor analysis, making it difficult for Louis Vuitton to predict the likelihood of success on the merits” (citations omitted)). Courts have recognized the critical role of attorneys’ fees in enabling copyright defendants “to incur the often hefty costs of litigation to defend the fair use doctrine,” *Video-Cinema Films, Inc. v. Cable News Network, Inc.*, No. 1:98-cv-07128, 2003 WL 1701904, at *5 (S.D.N.Y. Mar. 31, 2003); they are equally imperative for authors’ exercise and defense of noncommercial speech in the face of trademark litigation.

A test which brings forward and simplifies consideration of First Amendment interests in trademark infringement claims is critical to ensuring authors’ speech interests are vindicated not only in theory, but also in practice. Applying the likelihood of confusion inquiry without elevating First Amendment concerns risks unnecessarily raising the cost of vindicating First Amendment rights, chilling speech by authors who cannot afford lengthy litigation.



CONCLUSION

This case is about far more than just dog toys. Brands play a critical role in our zeitgeist, serving as meaningful cultural touchstones across diverse groups. Regardless of whether an expressive work could be successfully challenged for merely evoking a trademark, the literary canon will be severely chilled if authors begin to fear such litigation. We urge the Court to recognize the crucial First Amendment interests at stake by applying the *Rogers* test and adopting the *Mattel* interpretation to insulate creative, noncommercial speech from the heightened standard that is applied to purely commercial speech. Anything less could cause pervasive confusion and rampant self-censorship in creative communities.

Dated: February 23, 2023 Respectfully submitted,

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