

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*
30 TRADEMARK LAW PROFESSORS
IN SUPPORT OF RESPONDENT**

Phillip R. Malone
Counsel of Record
JUELGAARD INTELLECTUAL
PROPERTY AND
INNOVATION CLINIC
MILLS LEGAL CLINIC AT
STANFORD LAW SCHOOL
559 Nathan Abbott Way
Stanford, CA 94305
(650) 725-6369
pmalone@stanford.edu

Counsel for Amici Curiae

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INTEREST OF *AMICI CURIAE*

Amici are 30 law professors who teach and write extensively about trademark law and other intellectual property law subjects.¹ *Amici* have no personal interest in this case. *Amici*'s sole interest is in the orderly development of trademark law in a way that serves the public interest, in part by ensuring the proper balance between legitimate trademark interests and strong First Amendment speech interests.

A full list of *amici* can be found in the Appendix.

SUMMARY OF ARGUMENT

Trademark law has expanded dramatically in recent decades, opening the door to claims against parties that are primarily selling speech. Those claims would have been inconceivable when the Lanham Act was passed.

Early courts facing these expanded claims in the 1970s and 1980s tried to do what the government's brief now suggests and simply apply the new, judicially created multifactor likelihood-of-confusion tests each circuit created in the middle of the twentieth century. The result was a disaster. Many courts declared obvious parodies and commentary illegal. Even the courts that properly protected speech

¹ No counsel for a party authored this brief in whole or in part, and no party or counsel for a party made a monetary contribution intended to fund its preparation or submission. No person other than the *amici* or their counsel made a monetary contribution to the preparation or submission of this brief.

about trademarks did so by mutating or ignoring their own likelihood-of-confusion test. And the fact-specific nature of the inquiry required expensive surveys and made summary judgment difficult, leading numerous defendants with meritorious cases to censor their speech rather than face the cost and uncertainty of prolonged litigation.

Something more was needed to protect speech against these new trademark claims. The Second Circuit took the first step toward solving the problem more than three decades ago in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Since 1989, every circuit to have decided the issue has adopted some version of the *Rogers* test in cases like this one. The Ninth Circuit's approach to *Rogers* appropriately balances the (attenuated) interests of trademark owners in not being made fun of against the strong speech interests of those who want to talk about famous brands.

The government's argument that this Court should overrule the consensus of the circuit courts and fall back on the failed multifactor likelihood-of-confusion test in speech cases is not just bad policy. It is based on factual claims about *Rogers* and § 43(a) of the Lanham Act that are demonstrably false. The government ignores decades of pre-*Rogers* trademark infringement litigation under § 43(a), and it mischaracterizes the claim in *Rogers* itself. This Court should disregard the government's arguments and preserve a legal standard that works to protect speech against overreaching trademark claims.

ARGUMENT**I. The Multifactor Likelihood-of-Confusion Test Is Not Required or Appropriate in Cases Involving Speech**

While the Lanham Act, 15 U.S.C. §§ 1051-1141n, creates a cause of action against uses of trademarks that are likely to cause confusion, the statute says nothing at all about *how* courts are to determine whether confusion is likely. That is not surprising—the Lanham Act as enacted and revised has always been widely understood to codify the common law. *See, e.g.*, S. Rep. No. 100-515, at 40 (1988) (noting the committee revised a section of the Act “to codify the interpretation it has been given by the courts” and “expects the courts to continue to interpret the section”). Indeed, the Lanham Act does not even define distinctiveness, the central concept of protectability; it takes for granted the common law meaning of that term.

Contrary to Petitioner’s narrative around “the Lanham Act’s traditional likelihood-of-confusion analysis,” Pet’r’s Br. I, and the government’s persistent references to “the statutory likelihood-of-confusion standard,” U.S. Br. I, 11, 13, 21, there is no such standard in the statute. The tests for likelihood of confusion have always been developed by courts, and no one test has been used in all circumstances. Nothing in the text of the Act compels the use of any particular test for confusion, especially in cases where the defendant is primarily selling speech.

A. The Judicially Created Likelihood-of-Confusion Factors Were Not Developed to Deal with Selling Speech

For most of the history of trademark law, it was inconceivable that expressive works would present trademark issues at all. Trademark law was far narrower when courts developed the likelihood-of-confusion factors.

Trademark law has always been understood as a species of the broader law of unfair competition, all of which originally focused only on parties in direct competition. *See Canal Co. v. Clark*, 80 U.S. 311, 322-23 (1871) (“[I]n all cases where rights to the exclusive use of a trade-mark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another”); *Borden Ice Cream Co. v. Borden’s Condensed Milk Co.*, 201 F. 510, 514 (7th Cir. 1912) (“The phrase ‘unfair competition’ presupposes competition of some sort. In the absence of competition the doctrine cannot be invoked.”).

In the decades preceding the enactment of the Lanham Act in 1946, courts began recognizing claims against related, but not directly competing, goods. *See Aunt Jemima Mills Co. v. Rigney & Co.*, 257 F. 407, 409-10 (2d Cir. 1917) (pancake flour and pancake syrup); *Yale Elec. Corp. v. Robertson*, 26 F.2d 972, 973 (2d Cir. 1928) (Learned Hand, J.) (flashlights and locks); *see also* Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 Notre Dame L. Rev. 1839, 1899-904 (2013).

Courts developed multifactor likelihood-of-confusion tests for the purpose of evaluating infringement in these new kinds of cases. *See*

3 Restatement (First) of Torts §§ 730-31 (Am. L. Inst. 1938); *see also* Robert G. Bone, *Taking the Confusion Out of “Likelihood of Confusion”: Toward A More Sensible Approach to Trademark Infringement*, 106 Nw. U. L. Rev. 1307, 1316-36 (2012). Every circuit has now developed some form of multifactor likelihood-of-confusion test to deal with uses of trademarks for goods that are similar but not identical. *See, e.g., Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 493-94 (2d Cir. 1961) (photography materials and television studio equipment); *Helene Curtis Indus., Inc. v. Church & Dwight Co., Inc.*, 560 F.2d 1325, 1328-29 (7th Cir. 1977) (baking soda and deodorant with baking soda); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979) (noncompeting recreational boats); *Safeway Stores, Inc. v. Safeway Disc. Drugs, Inc.*, 675 F.2d 1160 (11th Cir. 1982) (grocery chain and retail stores).

But courts that developed what Petitioner now calls the “traditional” likelihood-of-confusion factors did so with cases like *Borden* and *Aunt Jemima* in mind—not cases involving expressive works.

Importantly, the term “expressive works” used in *Rogers* and subsequent cases is not limited to traditional forms of media such as movies, books, and plays. This Court has already recognized that speech can take many different forms, from the commercial music of rap group 2 Live Crew to video games. *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 569-71 (1994); *Brown v. Ent. Merchs. Ass’n*, 564 U.S. 786, 790 (2011). Commercial products are often the vehicles for speech, even though it is the speech that consumers are really buying. Think of a bust of Martin Luther King, Jr. for sale, for example. The fundamental

difference between expressive works and trademarks is that trademarks are designed to sell a product, while in the expressive works case, the speech is the product, at least in part.

Trademark law’s multifactor likelihood-of-confusion test properly applies to misleading commercial speech—that is, speech that does “*no more than* propose a commercial transaction.” *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976) (emphasis added); *see also Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 906 (9th Cir. 2002). But that multifactor test cannot apply to noncommercial speech that is entitled to First Amendment protection. Noncommercial speech has long included products that communicate a message even though they are sold for profit, whether those products are newspapers, video games, tennis shoes, or dog toys. *See* Mark A. Lemley & Sari Mazzurco, *The Exclusive Right to Customize?*, B.U. L. Rev. (forthcoming 2023), <https://perma.cc/5A6X-G9XG> (citing cases).

The distinction between commercial and noncommercial speech—whether the defendant is using a mark to sell another product or is selling the speech itself—has become more important in trademark law in recent decades because trademark rights were far narrower when courts created the likelihood-of-confusion factors.

B. The Reach of Trademark Law Has Steadily Expanded and Increasingly Been Applied to Expressive Works

Since the likelihood-of-confusion factors were first developed by courts, courts have steadily expanded the scope of trademark law. In recent decades, trademark

plaintiffs have asserted trademark infringement across *unrelated* product categories, and courts have recognized an increasing number of possible ways consumers might be confused, without necessarily requiring showings of actual harm to the trademark owner or to consumers. *See 1-800 Contacts, Inc. v. Lens.com, Inc.*, 722 F.3d 1229, 1238 (10th Cir. 2013) (“Confusion can be of several sorts.”).

Of particular significance, courts started recognizing claims alleging confusion as to sponsorship, affiliation, or connection between the plaintiff and defendant. That terminology, which has now been codified in Lanham Act § 43(a), 15 U.S.C. § 1125(a), has never had precise meaning, but its breadth has invited claims alleging confusion regarding almost any imaginable relationship, *see* Mark A. Lemley & Mark P. McKenna, *Irrelevant Confusion*, 59 *Stan. L. Rev.* 413, 428 (2010).

This expansion of trademark law opened the door to claims against parties that used trademarks in movies, songs, magazines, and other artistic works. *See Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205 (2d Cir. 1979) (“The public’s belief that the mark’s owner sponsored or otherwise approved the use of the trademark satisfies the confusion requirement.”); *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 774 (8th Cir. 1994) (“Many courts have applied . . . an expansive interpretation . . . extending protection against use of mark on any product or service which would reasonably be thought by the buying public to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner.”) (cleaned up).

The likelihood-of-confusion factors were not developed for the much broader universe of cases trademark law now reaches. The types of cases now dealt with under *Rogers* did not frequently arise when the likelihood-of-confusion factors were being created.² And indeed every circuit to decide the issue has instead adopted the more speech-protective *Rogers* test to deal with such cases.

II. The Multifactor Likelihood-of-Confusion Test Fails to Adequately Protect First Amendment Interests in Expressive Works

Broad application of the multifactor test beyond cases for which it was designed threatens to swallow

² Petitioner wrongly points to several title vs. title disputes as evidence that “[c]ourts long have protected trademarks from infringement in cases involving purportedly ‘expressive’ uses.” Pet’r’s Br. 31 (citing *Matsell v. Flanagan*, 2 Abb. Pr. (n.s.) 459, 460 (N.Y. Ct. Com. Pl. 1867) (enjoining “United States Police Gazette” paper fraudulently simulating “National Police Gazette” paper); *Klaw v. Gen. Film Co.*, 154 N.Y.S. 988, 988 (N.Y. Sup. Ct.), *judgment modified*, 156 N.Y.S. 1128 (1st Dep’t 1915) (enjoining photo drama using exact same title as dramatic production “A Fool There Was”). But title vs. title disputes raise different issues because the parties are in direct competition and *both* are selling speech. That is why *Rogers* explicitly carved those cases out for potentially different treatment. See *Rogers*, 875 F.2d at 999 n.5 (“This limiting construction would not apply to misleading titles that are confusingly similar to other titles.”). Title vs. title disputes would now implicate this Court’s decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003), which interpreted the Lanham Act to be limited to claims involving confusion regarding the “origin” of tangible products sold in the marketplace, *id.* at 31-32. But whatever the proper treatment of title vs. title disputes, those cases are not relevant here, where Petitioner does not contend that it is also selling speech.

all uses of another’s mark, including lawful speech protected by the First Amendment.³ The more expansively courts interpret the scope of trademark law, the more safeguards are necessary to ensure lawful speech remains protected by the First Amendment. Without any early screen or safety valve for lawful speech, the multifactor likelihood-of-confusion test “fails to account for the full weight of the public’s interest in free expression.” *See Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018).

A. Applying the Multifactor Test to Expressive Works Has Been Inconsistent and Unprincipled

The multifactor nature of the likelihood-of-confusion test leaves room for broad interpretation and is “plagued with ambiguity regarding when [the factors] apply and how much consumer confusion is tolerable.” Jeanne C. Fromer, *Trademark Ownfringement* 5 (Jan. 9, 2023), <https://perma.cc/N73N-XFDB>. Courts can diverge widely in the relative weight they give to the factors, routinely noting that the multifactor test “is only a guide, that no single factor is dispositive, and that additional factors might sometimes merit consideration.” William McGeeveran, *Rethinking Trademark Fair Use*, 94 Iowa L. Rev. 49, 67-69 (2008).

This is arguably a problem even in run-of-the-mill trademark cases. But the multifactor test is particularly ill-suited for cases where the defendant is primarily selling speech. History demonstrates that

³ For further discussion of First Amendment issues, see Brief of *Amici Curiae* First Amendment Professors.

abandoning the test for speech-related cases that has been adopted by every circuit to decide the question would be a catastrophe. Courts that have attempted to resolve noncommercial speech cases on confusion grounds often found infringement where it is implausible. And even when courts found no confusion, they often did so by deviating from what Petitioner calls the “traditional” likelihood-of-confusion analysis. Because these courts failed to analyze and balance the factors in a principled fashion, they produced inconsistent and ad hoc results.

i. When courts found confusion, they were being influenced by intuitions about free riding or harm to plaintiffs

Courts have sometimes found infringement in weak cases where confusion is highly implausible.⁴ Even absent finding a bad-faith intent to deceive by a defendant, courts have been influenced by intuitions that the defendant was improperly free riding on a trademark owner’s goodwill. The courts gave in to a visceral distaste for copycats and coattail riding, even though “a ‘free ride,’ without more, is in line with the theory of competition.” *Triangle Publ’ns v. Rohrlich*,

⁴ See, e.g., *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972); *Gucci Shops, Inc. v. R.H. Macy & Co.*, 446 F. Supp. 838 (S.D.N.Y. 1977); *Interbank Card Ass’n v. Simms*, 431 F. Supp. 131 (M.D.N.C. 1977); *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031 (N.D. Ga. 1986); *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769 (8th Cir. 1994); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727 (D. Minn. 1998); see also Stacey L. Dogan & Mark A. Lemley, *Parody as Brand*, 47 U.C. Davis L. Rev. 473, 476-77 (2013).

167 F.2d 969, 978 (2d Cir. 1948) (Frank, J., dissenting).

For example, without any evidence of actual confusion in the record, the Eighth Circuit declined to reverse a preliminary injunction because it believed the defendant's parodic "Mutant of Omaha" t-shirt and mug designs expressing opposition to nuclear arms "could injure plaintiffs [sic] valuable business reputation and goodwill." *Mut. of Omaha Ins. Co. v. Novak*, 775 F.2d 247, 248-49 (8th Cir. 1985).



Another court enjoined a parodic t-shirt about how often it rains "hard" in Seattle because it assumed the defendant's purpose was "to capitalize on a famous mark's popularity for the defendant's own commercial use" despite once again lacking evidence of actual confusion. *Hard Rock Cafe Licensing Corp. v. Pacific Graphics, Inc.*, 776 F. Supp. 1454, 1458, 1461-62 (W.D. Wash. 1991).

- ii. *When courts found no confusion under the multifactor likelihood-of-confusion test, it was not the factors doing the work to protect expression*

Courts applying the multifactor test did sometimes properly reject claims against expressive uses in order to accommodate speech interests. But even when they did so, it was often without any real analysis of the likelihood-of-confusion factors. In *Wham-O, Inc. v. Paramount Pictures Corp.*, 286 F. Supp. 2d 1254 (N.D. Cal. 2003), for example, the court denied a temporary restraining order against Paramount's use of a Slip 'N Slide in a movie scene, *id.* at 1254. In reaching its conclusion, the court did not analyze any of the likelihood-of-confusion factors in the body of its opinion. It simply stated, in a single footnote, that the factors "[did] not combine to support [the] plaintiff's infringement claim." *Id.* at 1262 n.7.

Some courts that rejected claims against expressive uses analyzed only a fraction of the likelihood-of-confusion factors. For example, in affirming a dismissal, the Seventh Circuit analyzed only three of its seven factors, *Fortres Grand Corp. v. Warner Bros. Ent. Inc.*, 763 F.3d 696, 702-03 (7th Cir. 2014), after the district court performed no step-by-step analysis of the factors and had applied *Rogers*, *Fortres Grand Corp. v. Warner Bros. Ent. Inc.*, 947 F. Supp. 2d 922, 928-34 (N.D. Ind. 2013).

Other courts analyzed each of the likelihood-of-confusion factors but modified those factors to account for the fact that the defendant's work was expressive or parodic. *See, e.g., Ocean Bio-Chem, Inc. v. Turner Network Television, Inc.*, 741 F. Supp. 1546, 1561 (S.D. Fla. 1990); *Nike, Inc. v. "Just Did It" Enters.*, 6

F.3d 1225, 1231-32 (7th Cir. 1993); *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 505 (2d Cir. 1996); *Louis Vuitton Malletier, S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260-61, 263 (4th Cir. 2007); *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 443 (S.D.N.Y. 2016), *aff'd*, 674 F. App'x 16, 17-18 (2d Cir. 2016); *see also* Resp't's Br. 38-39.

Still other courts ignored the factors themselves and simply declared by fiat that they did not believe there was confusion. In *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962 (C.D. Cal. 2007), for example, the court dismissed a claim against the producers of Family Guy, making the conclusory finding that “defendant’s use of the Charwoman character [for less than five seconds in a single episode] creates no likelihood of confusion,” *id.* at 966, 972; *cf. Eastland Music Grp., LLC v. Lionsgate Ent., Inc.*, 707 F.3d 869, 872 (7th Cir. 2013) (“The titles of Truman Capote’s novella Breakfast at Tiffany’s, and the movie of the same name, do not infringe . . . because no reasonable reader or moviegoer thinks that the jeweler is the source of the book or the movie.”).

B. The Factors Are Ill-Suited to Expressive Works

It is no surprise that these decisions are arbitrary. Many of the likelihood-of-confusion factors make no sense in the expressive context. Factors such as marketing channels, likelihood of expansion, and consumer sophistication are largely irrelevant to evaluating uses of marks in expressive works. Lemley & McKenna, *supra*, at 442. And factors such as strength of the plaintiff’s mark, similarity of marks, and defendant’s intent are so uncorrelated with

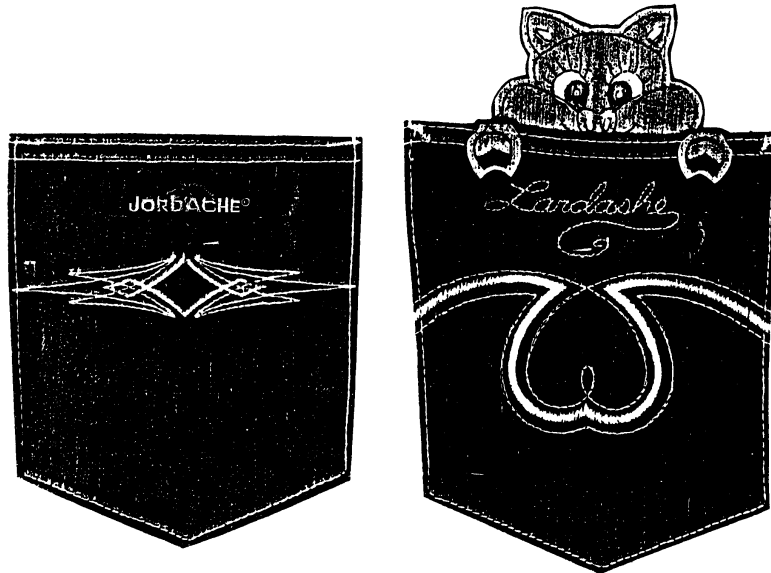
confusion that the application of what Petitioner calls the “traditional” likelihood-of-confusion analysis is a poor fit in the context of expressive works.

Ordinarily, a finding that the plaintiff’s mark is strong weighs in favor of likelihood of confusion. But in cases of expression, such as parody, satire, commentary, or jokes, the strength of the mark may “actually make it easier for the consumer to realize,” *Lyons P’ship v. Giannoulas*, 179 F.3d 384, 389 (5th Cir. 1999), or “allow consumers immediately to perceive the target” of the expressive work, *Haute Diggity Dog*, 507 F.3d at 261. The hallmark of a strong mark is that people are out in the world making fun of it. Accordingly, the strength-of-mark analysis is inverted when it comes to expressive works. People are not confused by a relatively strong mark being referenced; they realize the use is the target of expression and not serving as a source identifier.

Similarly, in run-of-the-mill trademark cases, identical or extremely similar marks weigh in favor of likelihood of confusion. However, expressive speech may require a level of similarity that enables referencing and makes room for public discourse. To an extent, the greater the similarity of the marks, the greater the likelihood that consumers will recognize the expressive nature of a work, and the lower the likelihood that consumers will be confused.

Further, courts ordinarily may infer bad-faith intent by a defendant who has copied the mark. But with expressive works, copying may simply amount to referencing a mark in the expressive work. A “lack of subtlety” may show that defendant “intended no deceit.” *Hormel Foods*, 73 F.3d at 505. Indeed, “[a]n intent to parody is not an intent to confuse the public.”

Jordache Enters., Inc. v. Hogg Wyld, Ltd., 828 F.2d 1482, 1486 (10th Cir. 1987) (concluding an image of a pig in a back pocket and the word “Lardashe” on jeans did not infringe).



As a result, “marching one-by-one through the ill-fitting factors of the likelihood-of-confusion test is a terrible methodology for resolving expressive use cases.” McGeeveran, *Rethinking Trademark Fair Use*, *supra*, at 76. The consequence of some factors being so irrelevant and other factors requiring inversion is that courts focus more and more of their attention on the defendant’s-intent and actual-confusion factors. *See* Lemley & McKenna, *supra*, at 443. Results of trademark lawsuits against expressive works are thus determined by the susceptibility of courts to free-riding instincts and by the precarity of consumer surveys.

A further problem stems from the rise of “affiliation” confusion. In speech cases, it is extremely

unlikely that anyone is confused about the actual source of the defendant's work. In *Balducci*, only 6% of consumers thought "Michelob Oily" was actually a new type of beer. 28 F.3d at 772-73. But because trademark law had expanded to include "affiliation," the Eighth Circuit ended up giving weight to survey results showing that consumers believed the defendant needed Anheuser-Busch's permission to publish the fictitious ad. *Id.* at 775. That is a fundamentally different question and one that risks letting the scope of the First Amendment itself depend on what laypeople think the law is.

C. Applying the Multifactor Test to Expressive Works Chills Speech Because It Requires Prolonged and Expensive Litigation

The likelihood-of-confusion factors' lack of clarity has caused serious collateral damage: the chilling of speech even where the speaker has meritorious defenses to a trademark claim. *See Bone, supra*, at 1336. When expressive use and speech are at stake, that uncertainty can lead potential speakers to forego or abandon otherwise lawful speech.

Requiring the multifactor likelihood-of-confusion test in expressive works cases results in burdensome litigation that is so prolonged and expensive that it chills lawful speech. *See, e.g., Mattel*, 296 F.3d at 900-02; *see also* William McGeeveran, *The Imaginary Trademark Parody Crisis (and the Real One)*, 90 Wash. L. Rev. 713, 739-45 (2015); William McGeeveran, *The Trademark Fair Use Reform Act*, 90 B.U. L. Rev. 2267, 2269, 2275-76 (2010). Properly applied, *Rogers* protects First Amendment interests by avoiding the chilling of lawful speech while still preventing genuine

confusion of the sort that trademark law is intended to address.

Cases applying the multifactor test typically cannot be resolved early in the litigation process and without the parties first investing considerable time and money. Addressing the factors usually requires considerable expert analysis. For example, after a plaintiff introduces survey evidence to assert actual confusion, “[a] defendant then has little choice but to commission a competing survey and initiate a ‘battle of the experts.’” McGeveran, *Rethinking Trademark Fair Use, supra*, at 70-71. These consumer surveys “are expensive, time-consuming and not immune to manipulation.” *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 224 (2d Cir. 1999). The most basic surveys cost in the “hundreds of thousands of dollars.” Robert H. Thornburg, *Trademark Survey Evidence: Review of Current Trends in the Ninth Circuit*, 21 Santa Clara Comput. & High Tech. L.J. 715, 717 (2005). Evaluating and rebutting the kind of questionable survey results described *supra* Section II.B only adds to a defendant’s litigation costs and burden.

Even where a defendant spends large sums of money on its own survey, likelihood of confusion under the multifactor test often cannot be determined at the summary judgment stage because a substantial record is typically required to fully assess the facts and those facts are often disputed. *See, e.g., Gen. Motors Corp. v. Keystone Auto. Indus., Inc.*, 453 F.3d 351, 359 (6th Cir. 2006) (concluding “genuine disputes of material fact render summary judgment inappropriate, a common disposition in evaluating likelihood of confusion”). Although the comparative weighing of different factors in the likelihood-of-confusion analysis is

sometimes treated as a matter of law, *see, e.g., Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1043 (2d Cir. 1992), the analysis is still protracted because that weighing can only occur after factual discovery and determinations have been made.

As a result, trademark litigation is expensive. For even the smallest trademark cases with under one million dollars in controversy, average litigation costs are \$415,000 inclusive of pre-trial, trial, post-trial, and any applicable appeal costs. Am. Intell. Prop. L. Ass'n, *Report of the Economic Survey* I-193 (2021); *see also id.* at I-195-97 (costing \$892,000 for one to ten million dollars in controversy, \$1,592,000 for ten to twenty-five million dollars, and \$3,381,000 for greater than twenty-five million dollars).

The risk of prolonged and expensive litigation leaves lawful users of a mark susceptible to the *in terrorem* effect of cease-and-desist letters and other threats of litigation from trademark owners. *See Leah Chan Grinvald, Policing the Cease-and-Desist Letter*, 49 U. S.F. L. Rev. 409, 410-11 (2015). The mere threat of a lengthy and costly lawsuit involving the likelihood-of-confusion factors is frequently enough to chill speech, particularly where the speaker has fewer resources than a trademark owner.

As this Court noted with respect to the use of potentially unclear multifactor tests for inherent distinctiveness, “[c]ompetition is deterred . . . not merely by successful suit but by the plausible threat of successful suit.” *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000). This Court has recognized the harms of chilling effects on speech in other contexts, too. *See Keyishian v. Bd. of Regents of Univ. of N.Y.*, 385 U.S. 589, 604 (1967) (describing the

chilling effect of sanctions on exercising vital First Amendment rights); *Lamont v. Postmaster Gen.*, 381 U.S. 301, 305 (1965) (striking down postal regulation for chilling access to literature). The “game” of allowing a suit is often “not worth the candle.” *Wal-Mart Stores, Inc.*, 529 U.S. at 214.

Indeed, this chilling effect is particularly severe where, as is often the case with parody, satire, artistic, or political speech, and other types of expressive works, the speaker is an individual or smaller entity. “Financially, many small business and individuals have little resources to fight a legal battle against large corporations with deep financial pockets.” Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 Wis. L. Rev. 625, 647 (2011).

“[M]any small businesses would most likely choose to close shop rather than spend the energy and money required to defend themselves against the behemoths.” Yvette J. Liebesman & Benjamin Wilson, *The Mark of a Resold Good*, 20 Geo. Mason L. Rev. 157, 165 (2012). Small businesses will often be forced to abandon their parodies or other expressive uses in the face of having to pay lawyers and experts. See Grinvald, *Shaming Trademark Bullies*, *supra*, at 647; see also Lemley & McKenna, *supra*, at 418 n.13 (citing examples of cease-and-desist letters). Even well-funded defendants nonetheless frequently capitulate to trademark bullies’ scary cease-and-desist letters. See, e.g., Lemley & McKenna, *supra*, at 421 (noting the *Moneyball* movie was halted days before its original start of filming because “[a]pparently Major League Baseball believes it can control the content of any film that refers to real baseball teams”).

Defendants engaging in lawful speech who have meritorious defenses will often be chilled by threats of expensive litigation involving the likelihood-of-confusion factors. See Mark A. Lemley, *Fame, Parody, and Policing in Trademark Law*, 2019 Mich. St. L. Rev. 1, 12 (2018). Speakers avoid those risks by not making, or abandoning, legitimate, non-infringing expressive uses. They just cave.

D. A *Rogers*-like Test Is Necessary to Prevent Trademark Lawsuits from Chilling Lawful Speech

Because the ill-fitting and burdensome likelihood-of-confusion factors do not adequately protect the First Amendment speech interests in cases involving expressive works, this Court should adopt *Rogers* or a similar test to ensure that lawful speech is not unduly chilled or suppressed.

The *Rogers* test protects lawful speech in expressive works; tests that apply the full likelihood-of-confusion factors do not. Under *Rogers*, if a defendant makes a “threshold legal showing” that the accused use is an expressive work, then the plaintiff faces a “heightened burden.” 6 McCarthy on Trademarks and Unfair Competition § 31:144.50 (5th ed. 2022) (“McCarthy”). *Rogers*, unlike the multifactor test, protects lawful expressive uses by interpreting artistic relevance broadly, see *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013) (concluding the *Rogers* artistic relevance threshold is intended to protect works with even “the slightest artistic relevance”). Under *Rogers*, when the use is artistically relevant, it can only be deemed infringing when use of the mark is “explicitly misleading,”

something more than simply creating a likelihood of confusion. 875 F.2d at 999.

- i. A Rogers balancing analysis significantly reduces the risk of prolonged and expensive litigation*

Unlike the multifactor likelihood-of-confusion analysis, the *Rogers* test allows appropriate cases to be resolved before trial and often without extensive discovery and expert involvement. “A trademark infringement claim brought against the use of a mark in an expressive work can be dismissed under the *Rogers* rule by a motion for summary judgment or a Rule 12(b)(6) motion to dismiss for failure to state a claim.” 6 McCarthy § 31:144.50.

“Nearly every case applying *Rogers* has done so on either a motion to dismiss or on summary judgment,” Lynn M. Jordan & David M. Kelly, *Another Decade of Rogers v. Grimaldi: Continuing to Balance the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 109 Trademark Rep. 833, 871 (2019), because “[c]ourts are cognizant of vindicating First Amendment protections through early dispositive motions to avoid chilling speech,” *Rebellion Devs. Ltd. v. Stardock Ent., Inc.*, No. 12-12805, 2013 WL 1944888, at *4 (E.D. Mich. May 9, 2013) (“The *Rogers* test is an appropriate one to apply in the early stages of litigation.”).

Indeed, the House Judiciary Committee recently cautioned against adopting a test other than *Rogers* in expressive works cases, particularly a test “that might require a court to engage in fact-intensive inquiries.” H.R. Rep. No. 116-645, at 20 (2020). In the Committee’s view, an alternate test would be “contrary to the Congressional understanding of how

the Lanham Act should properly operate to protect important First Amendment considerations” *Id.*

Rogers further reduces the time and expense of litigation because its truncated screen typically obviates the need for costly surveys and experts that would otherwise be needed to address the likelihood-of-confusion factors. The reduced risk of burdensome litigation also means that users of a mark for expressive purposes will be less likely to be intimidated by legal threats into abandoning their lawful, non-infringing speech.

ii. A Rogers balancing analysis is most protective of lawful expression

A version of the *Rogers* test similar to that used in the Ninth Circuit is the appropriate model for a case such as this one. *See, e.g., Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1200 (9th Cir. 2017); *Mattel*, 296 F.3d at 900. The Second Circuit’s version of *Rogers* is less protective than the Ninth Circuit’s test because it contemplates “a full-fledged multi-factor likelihood-of-confusion test to the second half of the *Rogers* two-step test” to show whether a mark is explicitly misleading. 6 McCarthy § 31:139; *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993). Using a *Twin Peaks* confusion factor analysis for the explicitly misleading prong of *Rogers* is still better for speech than simply applying the entire multifactor test because it at least requires a heightened showing of confusion. *See Twin Peaks*, 996 F.2d at 1379 (“However, the finding of likelihood of confusion must be particularly compelling to outweigh the First Amendment interest recognized in *Rogers*.”). But that

approach still enmeshes defendants in the uncertainty and cost of surveys and a jury trial on confusion.

The Ninth Circuit's application of *Rogers* is the most faithful to trademark law, the First Amendment, and, indeed, to *Rogers* itself. Under that test, a use is protected as long as it has even minimal artistic relevance and the use itself is not "explicitly" misleading as to the source or content of the expressive work. *Empire Distrib.*, 875 F.3d at 1196. Importantly, it cannot be the use itself that causes confusion; doing that just collapses the test back into the problematic multifactor likelihood-of-confusion analysis. *See Elec. Arts*, 724 F.3d at 1245 ("[I]f the use of a mark alone were sufficient, it would render *Rogers* a nullity.") (cleaned up). Instead, to infringe under *Rogers*, the defendant must do something to explicitly mislead as to source, such as indicating that their works are "authorized" or "genuine" or falsely claiming that they come from the plaintiff. *See Rogers*, 875 F.2d at 999 (using as examples of "explicitly misleading" titles "Nimmer on Copyright" for a treatise not authored by Nimmer and "Jane Fonda's Workout Book" for a book Jane Fonda was not involved with).

Applying the Ninth Circuit's *Rogers*-type screen achieves the appropriate balance between trademark owners and speakers. It protects trademark owners against genuine confusion that is not outweighed by lawful speech interests by permitting a finding of infringement when an expressive use is "explicitly misleading" about source or sponsorship. Petitioner is wrong that *Rogers* "offers a free pass" to confuse customers, Pet'r's Br. 36; it is simply not the case that "[v]irtually any knock-off can be reframed as a 'humorous' or 'expressive' message," *id.*, or that

application of *Rogers* would “effectively swallow[]” the Lanham Act, *id.* at 39.

Thus, a *Rogers* or similar test is best suited to protect speech in expressive works. Without a *Rogers*-like analysis, artistic expression, parody, and political and other speech can be unduly chilled by trademark claims. Conversely, for the reasons detailed above, the multifactor likelihood-of-confusion test does not adequately protect expression and is likely to result in chilling of lawful speech.⁵

iii. A Rogers balancing analysis is an appropriate fit for expressive works like the one in this case

Petitioner attempts to rebut the usefulness of *Rogers* in this case by focusing on the *type of product* at issue rather than the *nature of the speech*. See Pet’r’s Br. 39 (arguing that *Rogers* at least should not apply to uses of a mark “to identify the source of an ordinary commercial product,” and that “VIP’s chew toy falls on the utilitarian side” of the line). The distinction is unavailing.

Courts have long applied the *Rogers* test to a wide variety of expressive works in many forms. See cases cited *infra* Section III.B. One important reason is that there is no coherent definition of “commercial products” that would distinguish them for First

⁵ The government’s assertions that the “parodic nature” of an expressive use should be taken into account simply by “applying the flexible, multi-factor” likelihood-of-confusion test, U.S. Br. 17, do not consider or even acknowledge the chilling effect on such speech imposed by the risk of lengthy and costly litigation and intimidating legal threats. Nor do they reflect any understanding of the fraught nature of past efforts to apply this test.

Amendment purposes. Speech is often sold for profit—video games, major motion pictures, commercially-produced music—and many of this Court’s most celebrated free speech cases have involved speech on products that Petitioner would presumably call “ordinary commercial products.” *See, e.g., Cohen v. California*, 403 U.S. 15, 16 (1971) (jacket); *cf. Spence v. Washington*, 418 U.S. 405, 405 (1974) (flag). The issue is whether the speech is commercial or noncommercial; not whether the vehicle of that speech is sold for profit.

This is not a case where consumers are merely buying a commercial product. Respondent’s Bad Spaniels dog toy is unambiguously a joke (though one that Jack Daniel’s does not appreciate), and that joke is at the heart of what consumers are buying when they buy a VIP toy. Consumers are buying speech, and that speech and the associated object are “inextricably intertwined.” *See Rogers*, 875 F.2d at 998; *see also Hoffman v. Cap. Cities/ABC, Inc.*, 255 F.3d 1180, 1185 (9th Cir. 2001) (“Any commercial aspects are inextricably entwined with expressive elements, and so they cannot be separated out from the fully protected whole.”) (cleaned up). Trademark law does not give Jack Daniel’s the right to prevent others from making a joke at their expense, even if the vehicle for the joke is a dog toy.

First Amendment speech doctrine defines commercial speech as that which does “no more than propose a commercial transaction.” *Va. State Bd. of Pharmacy*, 425 U.S. at 762. Expressive works, by their very nature, do much more. They can express parody, satire, humor, commentary, or political or artistic ideas. It is precisely these sorts of lawful speech that

warrant protection from being chilled by trademark litigation and legal threats. That a “commercial product” is the vehicle for that speech does not change their nature or the need for First Amendment protection.

III. The Government Mischaracterizes *Rogers* and the Lanham Act

The government’s brief fundamentally mischaracterizes trademark law, the *Rogers* decision, and the Lanham Act. The government asserts that *Rogers* did not involve a trademark infringement claim and that, in any event, its framework should be limited to cases involving uses in titles. *See* U.S. Br. 26. These arguments are flatly wrong.

A. The Government’s Position that *Rogers* Should Not Be Applied to Trademark Infringement Is Wrong

Astonishingly, the government argues that *Rogers* should not apply to trademark infringement claims because *Rogers* was decided under an earlier version of the Lanham Act that did not yet provide an explicit cause of action for trademark infringement nor an explicit reference to “likely to cause confusion,” as the 1988 version later would. U.S. Br. 13, 26-27 n.3.

That argument is not just wrong but egregiously wrong. Courts interpreted § 43(a) of the Lanham Act to provide a cause of action for infringement of unregistered trademarks for *decades* before the 1988 amendments. It is true that the drafters of the Lanham Act did not expect § 43(a) to be used that way in 1946; the “false designation of origin” language was intended to refer to designations of geographical origin. But as Justice Scalia explained in *Dastar Corp.*

v. Twentieth Century Fox Film Corp., 539 U.S. 23, 29-30 (2003), the courts of appeals, starting with the Sixth Circuit in 1963, began broadly interpreting § 43(a) to “not merely refer to geographical origin, but also to origin of source of manufacture . . . thereby creating a federal cause of action for traditional trademark infringement of unregistered marks,” *id.* at 29-30 (internal quotes omitted) (quoting *Fed.-Mogul-Bower Bearings, Inc. v. Azoff*, 313 F.2d 405, 408 (6th Cir. 1963)); *see also Scarves by Vera, Inc. v. United Merchs. & Mfrs., Inc.*, 173 F. Supp. 625, 630 (S.D.N.Y. 1959). The 1988 amendments codified those common law developments.

Dastar correctly recognized *Azoff* as a catalyst that “signaled the beginning of a whole new dimension of § 43(a) as a vehicle to assert in federal court a traditional case of infringement of an unregistered mark.” 5 McCarthy § 27:7. As a result, in the 1970s, more courts began to use § 43(a) as a basis for asserting a claim for infringement of an unregistered mark. *Id.* Thus, although § 43(a) “was originally envisioned as a federal anti-false advertising statute,” *id.*, “[g]radually, through case law interpretation, § 43(a) began to fulfill a role as the premier federal statute protecting against not only false advertising but also infringement of unregistered marks,” *id.*

The government’s inexplicable lack of awareness of decades of case law (and of this Court’s own recognition of that case law in *Dastar*) leads it to make the related claim that *Rogers* does not apply to this case (and, by extension to any infringement case) because *Rogers* “did not involve trademark infringement,” Pet’r’s Br. 13, but only involved false

advertising via false endorsement, *id.* at 26-27. That claim is misleading at best.

The specific claim in *Rogers* was false endorsement, not false advertising. False advertising is covered by a different subsection of the Lanham Act, then § 43(b), now § 43(a)(1)(B), 15 U.S.C. § 1125(a)(1)(B). And Ginger Rogers' claim that people would think she "sponsored, endorsed, or [was] otherwise involved" in the Fellini film was a claim about the likelihood of consumer confusion (tracking the language now codified in Lanham Act § 43(a)(1)(A), 15 U.S.C. § 1125(a)(1)(A)), not about false advertising. False endorsement or sponsorship, like trademark infringement, was a claim governed by the Act's pre-1988 common-law confusion standard. Before 1988, courts had long applied a likelihood-of-confusion analysis to false endorsement claims just as they had for trademark infringement claims. *Rogers* speaks in the language of those cases, and certainly does not distinguish them, as the government misleadingly implies.

No case has refused to apply *Rogers* to a trademark infringement claim on the ground that *Rogers* involved a false advertising claim. In fact, since the 1988 amendment to the Act, every case to apply the *Rogers* test has done so in the context of a consumer confusion claim. *See, e.g., Elec. Arts*, 724 F.3d at 1239; *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 926-27 (6th Cir. 2003). The Second Circuit has explicitly held that *Rogers* is generally applicable to all claims under the Lanham Act. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989). Thus, courts regularly use *Rogers* to analyze confusion in trademark

infringement cases, and the government's claim that *Rogers* did not consider confusion when analyzing a false endorsement claim is, at best, ahistorical and seriously misleading.

B. The Government's Position that *Rogers* Should Not Be Applied Beyond Titles of Artistic Works Is Wrong

The government reasons that because the *Rogers* court "narrowly" construed the Lanham Act to avoid conflict with the First Amendment in the particular "area of titles," U.S. Br. 27, courts should not similarly construe the act to avoid First Amendment conflicts for *other* expressive works. That argument gets *Rogers* exactly backwards.

The Second Circuit highlighted the "distinct concerns" raised by titles only to make clear that titles have quasi-trademark characteristics. As that court said, "[t]he artistic and commercial elements of titles are inextricably intertwined." *Rogers*, 875 F.2d at 998; *see also id.* ("Consumers of artistic works thus have a dual interest: They have an interest in not being misled and they also have an interest in enjoying the results of the author's freedom of expression."). The fact that titles also have a commercial element was the reason the court felt it had anything to balance against the First Amendment interests. That is, *Rogers* is more protective of trademark interests in titles than it would be of other speech because of the special characteristics of titles. Unlike titles, the content of works generally does not serve a quasi-trademark function; if anything, First Amendment interests deserve even stronger deference outside of titles.

Courts have uniformly understood that *Rogers* is not limited to titles, and they have applied the *Rogers*

framework well beyond the titles of expressive works. For example, in *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008), the Ninth Circuit held that although the *Rogers* test traditionally applies to uses of a trademark in the title of an artistic work, “there is no principled reason why it ought not also apply to the use of a trademark in the body of the work,” *id.* at 1099.

The Second, Sixth, and Eleventh Circuits have all reached the same conclusion as the Ninth Circuit that protection extends beyond the title of an expressive work. See *Cliffs Notes*, 886 F.2d at 495 (concluding the *Rogers* test is “generally applicable” to Lanham Act claims against works of artistic expression, “a category that includes parody”); *ETW Corp.*, 332 F.3d at 927 (concluding the *Rogers* test is “not limited to literary titles” but is instead “generally applicable” to Lanham Act claims against works of artistic expression); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1277 (11th Cir. 2012) (noting the *Rogers* test is applicable “where trademark law is being used to attack the content—as opposed to the title—of works protected by the First Amendment”).

Further, district courts within the Seventh Circuit apply the *Rogers* test in the same way as the Ninth Circuit even though the Seventh Circuit has not yet had to resolve whether to adopt *Rogers*. See, e.g., *Fortres Grand Corp.*, 947 F. Supp. 2d at 931-32, *aff’d on other grounds*, 763 F.3d 696 (“While *Rogers* was focused on the title of an artistic work, numerous courts have expanded it to apply to artistic works more broadly.”); see Anthony Zangrillo, *The Split on the Rogers v. Grimaldi Gridiron: An Analysis of Unauthorized Trademark Use in Artistic Mediums*, 27

Fordham Intell. Prop. Media & Ent. L.J. 385, 419 (2017).

Expressive works come in a variety of forms that all, at their core, involve conveying and/or selling speech. *Rogers* itself concluded that movies, plays, books, and songs are works of artistic expression that deserve protection. 875 F.2d at 997. Courts have since applied *Rogers* to a wide variety of expressive works, see Lemley & Mazzurco, *supra*, at 53-54, including video games, *Elec. Arts*, 724 F.3d at 1248; paintings, prints, and calendars, *Univ. of Ala. Bd. of Trs.*, 683 F.3d at 1276; greeting cards, *Gordon*, 909 F.3d at 257; and parody, *Cliffs Notes*, 886 F.2d at 495. They are right to do so, because “the Constitution looks beyond written or spoken words as mediums of expression,” *Hurley v. Irish-Am. Gay, Lesbian & Bisexual Grp. of Bos.*, 515 U.S. 557, 569 (1995), extending First Amendment protection to other mediums including music, pictures, films, photographs, paintings, drawings, engravings, prints, and sculptures, *ETW Corp.*, 332 F.3d at 924.

Courts have even applied the *Rogers* test beyond uses within the body of an expressive work, such as to promotional activities for the work. Although appearances by cast members in other media, online advertising, and live events “technically fall outside the title or body of an expressive work, . . . only a minor logical extension of the reasoning of *Rogers*” was required to protect the advertising and marketing by name of works protected under *Rogers*. *Empire Distrib.*, 875 F.3d 1192, 1196-97 (9th Cir. 2017).

Whether that speech is in the form of a title or the composition of a work, the *Rogers* analysis avoids conflict with the First Amendment and ensures that trademark law does not unduly burden lawful speech. The government's claim that the *Rogers* analysis is a bespoke test for titles is contradicted not only by the logic of *Rogers* itself but also by the unbroken line of subsequent decisions reasoning that the *Rogers* test is appropriate for balancing expression and confusion in expressive works generally.

CONCLUSION

The Court should adopt a speech-protective test for trademark claims against expressive works such as the one the Ninth Circuit used here and should affirm the decision below.

Respectfully submitted,
Phillip R. Malone
Counsel of Record
JUELSGAARD
INTELLECTUAL
PROPERTY AND
INNOVATION CLINIC
MILLS LEGAL CLINIC AT
STANFORD LAW SCHOOL
559 Nathan Abbott Way
Stanford, CA 94305
(650) 725-6369
pmalone@stanford.edu

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TABLE OF APPENDICES

APPENDIX — LIST OF *AMICI* A1

APPENDIX — LIST OF *AMICI*

Amici curiae are the 30 trademark law professors listed below. Affiliation is provided for identification purposes only; all signatories are participating in their individual capacity and not on behalf of their institutions.

Professor Christopher Buccafusco

Duke University School of Law

Professor Michael W. Carroll

American University Washington College of Law

Professor Zachary L. Catanzaro

St. Thomas University College of Law

Professor Stacey Dogan

Boston University School of Law

Professor Dave Fagundes

University of Houston Law Center

Professor Christine Haight Farley

American University Washington College of Law

Professor Jeanne C. Fromer

New York University School of Law

A2

Professor William T. Gallagher

Golden Gate University School of Law

Professor James Gibson

University of Richmond School of Law

Professor Andrew Gilden

Willamette University College of Law

Professor James Grimmelman

Cornell Law School

Professor Michael Grynberg

DePaul University College of Law

Professor Paul Heald

University of Illinois College of Law

Professor Laura A. Heymann

William & Mary Law School

Professor Christa J. Laser

Cleveland State University College of Law

Professor Mark A. Lemley

Stanford Law School

A3

Professor David S. Levine

Elon University School of Law

Professor Yvette Liebesman

Saint Louis University School of Law

Professor Sari Mazzurco

SMU Dedman School of Law (incoming Fall 2023)

Professor William McGeeveran

University of Minnesota Law School

Professor Mark P. McKenna

UCLA School of Law

Professor Joseph Scott Miller

University of Georgia School of Law

Professor Ira Steven Nathenson

St. Thomas University College of Law

Professor Tyler T. Ochoa

Santa Clara University School of Law

Professor David S. Olson

Boston College Law School

A4

Professor Aaron Perzanowski
University of Michigan Law School

Professor Betsy Rosenblatt
University of Tulsa College of Law

Professor Pamela Samuelson
UC Berkeley School of Law

Professor Sharon K. Sandeen
Mitchell Hamline School of Law

Professor Jessica Silbey
Boston University School of Law