

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 *AMICUS CURIAE*
FOUNDATION FOR INDIVIDUAL RIGHTS
AND EXPRESSION
IN SUPPORT OF RESPONDENT**

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QUESTION(S) PRESENTED

1. Whether humorous use of another's trademark as one's own on a commercial product is subject to the Lanham Act's traditional likelihood-of-confusion analysis, or instead receives heightened First Amendment protection from trademark-infringement claims.
2. Whether humorous use of another's mark as one's own on a commercial product is "noncommercial" under 15 U.S.C. § 1125(c)(3)(C), thus barring as a matter of law a claim of dilution by tarnishment under the Trademark Dilution Revision Act.

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INTEREST OF *AMICUS CURIAE*¹

The Foundation for Individual Rights and Expression (FIRE) is a nonpartisan, nonprofit organization dedicated to defending the individual rights of all Americans to free speech and free thought—the essential qualities of liberty. Because colleges and universities play an essential role in preserving free thought, FIRE places a special emphasis on defending these rights on our nation’s campuses. Since 1999, FIRE has successfully defended the rights of individuals through public advocacy, strategic litigation, and participation as *amicus curiae* in cases that implicate expressive rights under the First Amendment. *See, e.g.*, Brief of FIRE as *Amicus Curiae* in Support of Petitioner, *Kennedy v. Bremerton Sch. Dist.*, 142 S. Ct. 2407 (2022); Brief of FIRE as *Amicus Curiae* in Support of Respondents, *Mahanoy Area Sch. Dist. v. B.L.*, 141 S. Ct. 2038 (2021).

FIRE has a direct interest in this case because this Court’s jurisprudence on the intersection of the First Amendment and trademark law impacts the individuals FIRE represents. FIRE has seen firsthand the eagerness of university administrators to wield trademark policies to suppress unpopular speakers and squelch school criticism. FIRE files this brief in support of Respondent to demonstrate the disturbing prevalence of these abuses and to urge this Court to

¹ Pursuant to Rule 37.6, *amicus* affirms that no counsel for a party authored this brief in whole or in part, and that no person other than *amicus* or its counsel contributed money intended to fund preparing or submitting this brief.

adopt a First Amendment-protective threshold test for trademark use.

SUMMARY OF ARGUMENT

When an expressive work enters the marketplace of goods or services, it does not exit the marketplace of ideas. For that reason, the Lanham Act cannot be a muzzle on the First Amendment. Yet trademark holders from liquor companies to universities often treat it like one, aiming to silence protected parody, political criticism, and social commentary that incorporates another's trademark. That misuse of the Lanham Act invites self-censorship. Thus, FIRE urges the Court not only to affirm, but also to adopt a robust First Amendment threshold test for expressive uses of another's trademark.

Expressive use of trademarks adds value to the public discourse, even when that use is commercial. Companies like VIP Products parody culturally iconic brands with expressive products, making humorous points about branding and consumerism. Activists sell posters and make websites satirizing a company or political party to drive home a message. And college students sell t-shirts toying with their school's logo to criticize the school or promote a student group.

But the usual tests for Lanham Act violations fall short when it comes to the First Amendment. Indeed, the multifactor test for trademark infringement is largely backwards for expressive works like parody and political criticism. For instance, that test dictates that the stronger the mark, the stronger the likelihood of confusion. Yet for expressive uses, stronger marks

make more effective messaging. Poking fun at Jack Daniel’s packs more expressive punch than poking fun at cheap but generic “well liquor.”

This multifactor test also invites courts to impose their own subjective views about whether an expressive use of a mark is distasteful, even when the use is non-commercial or non-competitive. That discretion defies core First Amendment principles. Just as Simon Tam had the right to register “The Slants” as his band’s trademark free of the Trademark Office’s subjective views,² a speaker has a right to avoid a court’s subjective views when speaking out about a brand.

Finally, the cost and complexity of litigating the multifactor test encourages brand owners like Jack Daniel’s to brandish the Lanham Act against expressive uses of marks—including those that no ordinary person would be confused by. As FIRE’s work shows, colleges and universities are just as likely to unlawfully wield trademarks against students and faculty as liquor companies are against dog toy manufacturers. School administrators regularly make trademark threats against student and faculty expression because they disagree with a message’s viewpoints, whether the message is promoting Ayn Rand, advocating for marijuana law reform, or criticizing the university.³ And unlike private companies, most students and faculty members lack

² *Matal v. Tam*, 137 S. Ct. 1744, 1763–64 (2017).

³ See Section II, *infra*.

the means to defend their expressive use of a school's mark. That disparity results in self-censorship.

There is a fix to this speech-chilling problem: a First Amendment threshold test to sort out expressive uses of marks that are not explicitly confusing. The *Rogers v. Grimaldi*⁴ test the Ninth Circuit applied is a good starting point.⁵ But because the *Rogers* test explicitly covers only artistic expression, it does not go far enough. To best uphold the public interest in free expression, *amicus* FIRE urges the Court to adopt a fortified version of the *Rogers* test that expressly covers all core protected speech, including political and social messaging.

ARGUMENT

I. First Amendment Safeguards Will Curb Misuse of the Lanham Act and Protect Free Expression.

From college students to political cartoonists, Americans regularly incorporate trademarks into criticism, commentary, and art. But the standard likelihood-of-confusion test for trademark claims fails to shield protected speech from overzealous trademark holders. Simply put, the costly and confounding multifactor likelihood-of-confusion test emboldens mark holders to treat the Lanham Act as a license to chill speech. At the same time, its cost and complexity discourages speakers from fighting back.

⁴ 875 F.2d 994 (2d Cir. 1989).

⁵ *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170, 1175 (9th Cir. 2020).

Thus, a threshold inquiry like the *Rogers* test is vital to protecting expressive works that incorporate a trademark—but it should unequivocally cover expression beyond just the artistic, including political and social messages.

A. Robust Protection for Political, Social, and Artistic Expression Requires Latitude to Draw On Trademarks, Even in the Commercial Context.

Trademarks represent prominent brands and institutions. That makes them ripe targets for satire, parody, criticism, and commentary. And just as the people possess the “prized American privilege to speak one’s mind, although not always with perfect good taste, on all public institutions,” *Bridges v. California*, 314 U.S. 252, 270 (1941), they likewise have the privilege to speak their mind on public brands.

The First Amendment thus requires breathing room for using another’s mark for political, social, and artistic expression—even if the use is intended to make money. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 761–62 (1976) (concluding that a speaker’s economic interest “hardly disqualifies him from protection under the First Amendment”) (cleaned up). Neither *Hustler* magazine nor 2 Live Crew lost constitutional protection just because they sold their infamous parodies. *Hustler Mag., Inc. v. Falwell*, 485 U.S. 46, 48, 57 (1988); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 584–85 (1994).

The freedom to use another's mark for legitimate expression must cover traditional mediums like publications, websites, and music. But it also must extend to useable products. Indeed, political, social, and artistic expression incorporating another's trademark often takes the form of a t-shirt,⁶ or here, a humorous dog toy.⁷ Those useable forms enhance a speaker's ability to reach others.

Imagine \$10 t-shirts that use a university logo to express opposition to university policy or satirize the school's losing football team. Those shirts are just like "the sandwich boards that union pickets sometimes wear," and thus "are a medium of expression prima facie protected by the free-speech clause of the First Amendment, and they do not lose their protection by being sold rather than given away." *Ayres v. City of Chicago*, 125 F.3d 1010, 1014 (7th Cir. 1997); *see also Nike, Inc. v. "Just Did It" Enters.*, 6 F.3d 1225, 1231 (7th Cir. 1993) ("[S]ome purchasers might resent paying a premium to be a walking billboard and would relish the opportunity to mock trendy folks who wear labels on their sleeves.").

⁶ *See, e.g., Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987); *Black Dog Tavern Co. v. Hall*, 823 F. Supp. 48, 52 (D. Mass. 1993).

⁷ *VIP Prods.* 953 F.3d at 1172; *see also Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 267 (4th Cir. 2007) (holding dog toys that parodied a famous fashion mark did not sustain a trademark dilution claim).

B. The Usual Test for Trademark Infringement is More Likely to Chill Free Speech Than Protect it.

The standard multifactor likelihood-of-confusion test neglects First Amendment rights, having its “origin in cases of purely commercial exploitation, which do not raise First Amendment concerns.” *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 495 n.3 (2d Cir. 1989) (citing *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), *cert. denied*, 368 U.S. 820 (1961)); *see also AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979) (adopting an eight-factor test for likelihood-of-confusion test in a trademark dispute between boat sellers). As such, it fails to adequately consider or protect a speaker’s use of another’s mark to communicate a non-commercial message.

Consider the factors about “strength of the mark” and “similarity of the marks” under the likelihood-of-confusion test. Under the standard inquiry, “[t]he stronger the mark, the more likely it is that encroachment on it will produce confusion.” *Champions Golf Club, Inc. v. The Champions Golf Club, Inc.*, 78 F.3d 1111, 1116–17 (6th Cir. 1996) (citation omitted). Likewise, courts find a greater likelihood-of-confusion when the similarity between the mark and its unsanctioned use is high, especially when the goods or services are dissimilar. J. Thomas McCarthy, *4 McCarthy on Trademarks and Unfair Competition* § 23:20.50 (5th ed. 2022)

But “the strength of the mark and the similarity between the marks often work in reverse for cases of parody and satire as compared to a standard infringement case.” *Radiance Found., Inc. v. N.A.A.C.P.*, 786 F.3d 316, 324–25 (4th Cir. 2015).⁸ That makes sense. Stronger marks often serve as cultural symbols, making them apt for protected parody, criticism, and commentary. And effective parody must imitate: “A parody must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is *not* the original and is instead a parody.” *Cliffs Notes*, 886 F.2d at 494. In the same way, political expression about a brand or institution must replicate a mark to make a point.

There is little guidance for lower courts on how to balance these factors when protected speech is at stake. Making matters worse, courts have stressed, for instance, that the similarity factor is “entitled to considerable weight.” *Champions Golf Club*, 78 F.3d at 1119 (citation omitted). And so courts can and do wrongly emphasize the strength and similarity factors at the expense of First Amendment rights, even for non-commercial or non-competitive uses where the risk of confusion is lower. *See, e.g., Mut. of Omaha*, 836 F.2d at 399 (finding an antinuclear activist’s “Mutant of Omaha” parody of Mutual of Omaha’s marks was likely to confuse on source designation, as

⁸ *See also* Bruce P. Keller & Rebecca Tushnet, *Even More Parodic Than the Real Thing: Parody Lawsuits Revisited*, 94 Trademark Rep. 979, 1003–04 (2004) (“[T]he standard likelihood of confusion factors, like the copyright fair use factors, have to be applied differently in parody cases.”).

the strength and similarity factors favored the mark owner).

This danger to expressive freedom extends to findings of mistaken affiliation under the multifactor test. For instance, if consumers wrongly assume that satirical use of another’s mark requires the owner’s permission—or if the mark owner manipulates a survey to show that—even an obvious parody can succumb to a finding of affiliation confusion. *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 774–75 (8th Cir. 1994) (reversing district court’s refusal to find likelihood-of-confusion for a “MICHELOB OILY” parody of Michelob beer conveying a message about pollution); *Mut. of Omaha*, 836 F.2d at 400.

The threat to free speech does not end at the strength and similarity factors. Courts sometimes allow distaste for a defendant’s message to distort the likelihood-of-confusion and dilution tests.⁹ Under the test Jack Daniel’s advocates for, trademark claims would turn on subjective views about references to sex, drugs, or mere dog poop—no matter if those references promote a political, social, or artistic message. Jack Daniel’s Br. at 44–47. But that makes little sense. Indeed, outlandish uses of another’s mark are less likely to confuse: “The more distasteful and

⁹ Michael K. Cantwell, *Confusion, Dilution, and Speech: First Amendment Limitations on the Trademark Estate*, 87 Trademark Rep. 48, 49, 58–60 (1997) (discussing examples); see also Stacy L. Dogan & Mark A. Lemley, *Parody as Brand*, 47 U.C. Davis L. Rev. 473, 497 (2013) (“[T]he slipperiness of trademark doctrine gives courts room to find infringement or dilution, even under dubious circumstances, if they are motivated to do so.”).

bizarre the parody, the less likely the public is to mistakenly think that the trademark owner has sponsored or approved it.”¹⁰

Jack Daniel’s view also defies a “bedrock First Amendment principle”: Giving offense is protected speech. *Tam*, 137 S. Ct. at 1751. If the First Amendment ensures that “disparaging” and immoral marks are eligible for trademark registration, then surely the First Amendment also protects crude political and artistic expression against trademark claims. *See id.* at 1763–64; *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019).

In short, the standard trademark infringement tests create immense risk to protected speech. Mark owners have incentive to stretch the Lanham Act to even obviously non-confusing works just to stifle unwanted criticism or exposure. And given the time, cost, and uncertainty required to litigate the complicated test’s many factors, many speakers will self-censor rather than use another’s mark for legitimate expression.¹¹ That outcome is even more likely for broke college students, non-profits, and

¹⁰ J. Thomas McCarthy, *6 McCarthy on Trademarks and Unfair Competition* § 31:154 (5th ed. 2022).

¹¹ William McGeeveran, *Four Free Speech Goals for Trademark Law*, 18 *Fordham Intell. Prop. Media & Ent. L.J.* 1205, 1214 (2008) (“A doctrine that is malleable and unclear, or that requires lengthy litigation for resolution, will exacerbate rather than ameliorate the chilling effect; it either discourages legitimate expression with trademarks to begin with, or it compels the defendant to withdraw speech when threatened with suit.”).

others who rely on using famous marks to speak truth to power.

No one likes being the butt of a joke or the target of criticism. But the Lanham Act should not be a club for the haves to bludgeon the have-nots into silence.

II. Colleges and Universities Regularly Use Trademark Law to Bully Students and Faculty Engaging in Disfavored Speech.

As FIRE's work shows, First Amendment safeguards regarding trademark use are particularly important in the college and university context. Student groups frequently seek to use university-trademarked images and phrases for things like club logos, t-shirts, and websites. While school administrators typically approve requests to use their trademarks for these purposes, they often deny approval—and discriminate based on viewpoint—when they disagree with the issues student groups advocate for. University denials of trademark use are particularly chilling on student speech because unlike commercial parodists, college students rarely have the money or time to litigate complicated multifactor trademark tests. Even when they do, the time-limited nature of student enrollment usually means that the affected students graduate before the case can be fully litigated.

Nor is university reliance on trademark law to suppress protected speech limited to the student context. School administrators have repeatedly sought to punish faculty using the school's name when engaging in public criticism. Absent this Court

establishing clear First Amendment protections for protected speech in the trademark context, colleges and universities will continue to abuse their power to throttle disfavored speech.

A. Public Colleges and Universities Selectively Enforce Trademark Policies Against Registered Student Organizations.

Administrators at public colleges and universities often selectively enforce their trademark policies based on viewpoint. The FIRE case *Gerlich v. Leath* is particularly instructive. 861 F.3d 697 (8th Cir. 2017). There, Iowa State University broadly granted registered student organizations permission to use its trademarks, including logos and words like “ISU,” if certain conditions were met. *Id.* at 701. The Iowa State student chapter of the National Organization for the Reform of Marijuana Laws (“NORML ISU”) complied with this policy and received school approval for a t-shirt design reading “Freedom is NORML at ISU,” with a small cannabis leaf above “NORML.” *Id.* However, after a local newspaper article covering ISU NORML led various anti-legalization state politicians to criticize the administration, Iowa State administrators revoked trademark approval and denied all new design submissions that “included the image of a cannabis leaf.” *Id.* at 702–03.

The Eighth Circuit held that ISU’s decision constituted unlawful viewpoint discrimination and that the school was not entitled to qualified immunity. The court held that Iowa State created a “limited public forum” for its trademarks by making them

available on meeting certain criteria. *Id.* at 705. As such, the school engaged in viewpoint discrimination when it subjected NORML ISU to “unique scrutiny” and implemented a “prior review procedure” that no other student organization was subject to (absent evidence of prior malfeasance, which NORML did not have). *Id.* ISU’s viewpoint discrimination was particularly apparent in light of record evidence from various ISU defendants that all actions against NORML ISU were motivated by “pushback” from the governor’s office and ISU administrators’ concerns that the school could suffer if it permitted the t-shirt designs “in a state as conservative as Iowa.” *Id.* at 706.

The court additionally rejected ISU’s defense that there was no First Amendment violation because the school’s trademark licensing regime “should be considered government speech.” *Id.* at 707. ISU’s trademark policy created a limited public forum, where the “government speech doctrine does not apply.” *Id.* Even if it hadn’t, it was clear that “ISU [did] not use its trademark licensing regime to speak to the public” because ISU “allow[ed] approximately 800 student organizations to use its trademarks,” including groups with opposing views like Iowa State Democrats and ISU College Republicans. *Id.* at 708.

Gerlich is noteworthy for two reasons. *First*, the controversy began in 2012, but the case was not closed until nearly seven years later in 2018. For most college and university students, seven years is far too long to vindicate your First Amendment rights in time to actually exercise them on campus. *Second*, *Gerlich* demonstrates the brazenness with which university administrators are willing to wield their trademark

policies to suppress viewpoints they disagree with. As noted at the time by *amicus* Alliance Defending Freedom, on behalf of Students for Life of America, Young America’s Foundation, Young Americans For Liberty, Ratio Christi, and Christian Legal Society, this is not a problem limited to marijuana advocates—student groups across the ideological and issue spectrum are regularly discriminated against by university administrators.¹² And if a club logo can be banned for use of a marijuana leaf today, it will certainly be banned for use of a cross tomorrow.

In another egregious example, in 2014, the University of California – Davis demanded that the registered student organization Ayn Rand Society at UC Davis (“ARS”) change or delete its Facebook page because the URL contained the initials “UCD.” See *FIRE Letter to UC Davis Chancellor Linda P.B. Katehi*, FIRE (Dec. 10, 2014), <https://www.thefire.org/research-learn/letter-fire-uc-davis-chancellor-linda-pb-katehi> (using the URL “<https://www.facebook.com/groups/ucd.aroc/>”). When ARS refused to comply (in large part because Facebook would not allow the group to change its URL), UC Davis revoked ARS’s good standing with the school, thus blocking the club from receiving student funding, reserving club meeting space, and receiving other registered student organization benefits. *Id.* The school’s finding that ARS was in violation of its trademark policy could

¹² Br. of *Amici Curiae* Students for Life of America, Young America’s Foundation, Young Americas for Liberty, Ratio Christi, and Christian Legal Society in Support of Appellees and Affirmance, *Gerlich*, 861 F.3d 697, No. 16-1518, 2016 WL 3157519 at *15–22.

have triggered civil and criminal penalties under California law. *Id.* The school reversed course only after a letter from FIRE explained that UC Davis was violating the First Amendment, particularly given that the speech was non-commercial and there was little likelihood-of-confusion. Had it not reversed course and sued the students, a threshold test like the one *amici* FIRE and Intellectual Property Professors urge would have made short work of that lawsuit and secured the student’s First Amendment rights before the costs of complex litigation made it impossible.

More recently, the Arizona Board of Regents sued a John Doe under various trademark doctrines after Doe used “ASU”—a trademark of Arizona State University—to make the Instagram account “asu_covid.parties” and criticize Arizona State’s leadership and COVID-19 policies. *Ariz. Bd. of Regents v. Doe*, 555 F. Supp. 3d 805, 810–14 (D. Ariz. 2021), *aff’d sub nom. Arizona Bd. of Regents ex rel. Arizona State Univ. v. Doe*, No. 21-16525, 2022 WL 1514649 (9th Cir. May 13, 2022). Rejecting the Board’s effort “to use our nation’s trademark laws in novel ways in an effort to combat the COVID-19 pandemic” against a “deeply unsympathetic” defendant, the district court dismissed the trademark claims because “a reasonably prudent consumer” would not be confused about whether ASU was the source of the Instagram account. *Id.* at 809, 817. The district court got it right. But one can imagine a different court imposing its subjective views to overextend the Lanham Act and subvert a “deeply unsympathetic” speaker’s First Amendment rights. See Section I.B, *supra*.

Even just this month, an administrator at the College of Lake County in Illinois insisted that the college’s Young Americans for Freedom chapter “not refer in any way to the institution on your advertising if using weapon imagery.”¹³ The chapter’s advertisement had nothing to do with guns or violence. Rather, it parodied television’s “The Sopranos”—complete with the show’s famous font featuring the lowercase “r” shaped like a pistol—to promote an event called “Union Bosses Are Ruining America” featuring former Wisconsin Governor Scott Walker. Yet after the chapter objected, the administrator responded by threatening a suspension of the chapter’s registered status if it did not cease its disfavored speech.

B. Public universities and colleges attempt to block students, alumni, and faculty from using trademarked names to criticize their schools.

The First Amendment fundamentally protects the right to criticize. However, several public colleges and universities have attempted to squelch criticism by blocking their critics from using the school name in their website titles or blog posts, citing trademark policy. For example, in 2009, an expelled student from University of California – Los Angeles launched the

¹³ Nick Baker, *College Administrator Threatens to Suspend YAF Chapter Over Sopranos-Themed Flyer Promoting Gov. Scott Walker’s Upcoming Lecture*, Young America’s Foundation (Feb. 21, 2023), <https://www.yaf.org/news/leftist-administrator-threatens-to-suspend-yaf-chapter-over-sopranos-themed-flyer-promoting-gov-scott-walkers-upcoming-lecture/>.

non-commercial website “ucla-weeding101.info” to criticize the school. See *FIRE Letter to UCLA Chancellor Gene D. Block*, FIRE (Aug. 14, 2009), <https://www.thefire.org/research-learn/fire-letter-ucla-chancellor-gene-d-block>. UCLA informed the former student that his use of “UCLA” in his URL violated the school’s trademark policy and could constitute a criminal offense under California law. *Id.* After FIRE wrote a letter to UCLA explaining that such “cybergripping” websites are usually considered constitutionally protected speech, the school formally withdrew its demand letter—only to send a renewed demand letter 9 years later. See *FIRE Letter to Laurraine Pollard*, FIRE (Aug. 31, 2018), <https://www.thefire.org/research-learn/fire-letter-university-california-los-angeles-august-2018>. Once again, it took FIRE intervening to get UCLA to drop its unconstitutional trademark claims.

University abuse of trademark is not reserved for current and former students: Faculty are often victims as well. For example, in 2013, Chicago State University retained outside counsel to pursue trademark infringement claims against two CSU professors for contributing to the *CSU Faculty Voice*, a faculty blog that was highly critical of the CSU administration’s perceived corruption and incompetence. *Beverly v. Watson*, 78 F. Supp. 3d 717, 719–20 (N.D. Ill. 2015). Though CSU eventually dropped its trademark claims after a letter from FIRE, it subsequently adopted a broad “cyberbullying policy” that it used to try and silence the *Faculty Voice*, and abandoned its efforts only after a FIRE-sponsored lawsuit led to a six-figure settlement. See *Chicago State University - Stand Up For Speech*

Lawsuit, FIRE, <https://www.thefire.org/cases/chicago-state-university-stand-speech-lawsuit>.

In a similar case in 2009, Emory University requested that one of its professors remove his affiliation with the school from his private blog, allegedly because it violated Emory's trademark policy, but really because the school was unhappy with the professor's parody and critique of the pharmaceutical industry. See Peter Bonilla, *Emory professor allowed to say he's an Emory professor on private blog*, FIRE (July 14, 2009), <https://www.thefire.org/news/emory-professor-allowed-say-hes-emory-professor-private-blog>. Thankfully, after significant public pressure from the media and various education organizations, including FIRE, the school relented and allowed him to identify himself online as a professor at Emory's School of Medicine.

These examples all ended in wins for the students or faculty, and ultimately in the triumph of the First Amendment over unconstitutionally applied trademark policies. But many, many cases do not end so positively. See, e.g., *University of Missouri: Censors Student Group's T-Shirts Advocating for Marijuana Legalization*, FIRE, <https://www.thefire.org/cases/university-missouri-censors-student-groups-t-shirts-advocating-marijuana-legalization> (refusing to approve marijuana leaf t-shirt designs for the NORML chapter at the University of Missouri). And even the victories demonstrate the willingness, and often eagerness, of university administrators to use trademark law to suppress speech they don't like. Adopting a threshold test for protected use of

trademarks will give students and faculty a much-needed shield against university censors.

III. A Robust Threshold Inquiry for Expressive Uses of Trademarks is Needed to Guard Against the Lanham Act Chilling Speech.

To uphold the public’s interest in free expression, this Court should adopt a threshold test for trademark infringement that expressly affords First Amendment protections not only to artistic speech, but to all core protected speech. Indeed, because the standard Lanham Act tests can chill protected speech, a threshold test that sorts out clear expressive uses of another’s mark that are not plainly misleading *before* applying the multifactor likelihood-of-confusion test—and ideally at a case’s early stages—is essential.

The *Rogers* test the Ninth Circuit applied below highlights the importance of First Amendment safeguards for trademark claims involving expressive works. *VIP Prods.*, 953 F.3d at 1174. As the Ninth Circuit explained, “[w]hen artistic expression is at issue, however, the general likelihood-of-confusion test fails to account for the full weight of the public’s interest in free expression.” *Id.* (cleaned up). Thus, the *Rogers* test requires the plaintiff to show one of two things before moving to the multifactor likelihood-of-confusion test: (1) that the defendant’s use of the mark is not artistically relevant to the underlying work or (2) that the use explicitly misleads consumers as to the source or content of the work. *Id.*

Yet *Rogers* does not go far enough to protect legitimate expressive works about political, social,

and other issues of public interest. Because the *Rogers* test on its face is limited to “artistic expression,” it risks courts excluding non-artistic uses of another’s mark that convey political or social messages. It also leaves at risk expressive utilitarian products like t-shirts or mugs that a judge might find non-artistic. In fact, Jack Daniel’s suggests—wrongly—that utilitarian products lack First Amendment protection. Jack Daniel’s Br. at 38–39; *but c.f. Minn. Voters All. v. Mansky*, 138 S. Ct. 1876, 1892 (2018) (striking down state ban on political apparel at polling places under the First Amendment).

Thus, to properly address First Amendment concerns, this threshold test should expressly embrace two speech-protective principles. *First*, if a work or good uses another’s mark to convey an artistic, political, or social message, what matters is not its utility, but if the item is “communicating ideas or expressing points of view.” *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987). *Second*, any threshold test for expressive works is not limited to “artistic expression.” Instead, lower courts should consider whether the defendant’s use of the mark is also relevant to political, social, or other protected messaging, including expression some may find distasteful.¹⁴

¹⁴ A November 2022 Ninth Circuit decision rejected a trademark holder’s argument that *Rogers* did not cover publications about politics. *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091, 1098 (9th Cir. 2022). That decision highlights the need for a uniform threshold test like the one urged.

These First Amendment safeguards will not unduly burden trademark rights. Lower courts should still consider, for example, whether an expressive use of another's mark is "explicitly mislead[ing]." *VIP Prods.*, 953 F.3d at 1174. Likewise, this test would not protect purely commercial uses of another's mark masking as parody or commentary. Compare *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 113 (2d Cir. 2009) ("Thus, the Charbucks parody is promoted not as a satire or irreverent commentary of Starbucks but, rather, as a beacon to identify Charbucks as a coffee that competes at the same level and quality as Starbucks in producing dark-roasted coffees.") with *Cliffs Notes*, 886 F.2d at 497 (vacating injunction against "Spy Notes," a book parodying the trade dress of Cliffs Notes). And mark owners maintain a remedy against expressive uses where the likelihood-of-confusion is immense, like political parties or advocacy groups using their opponents' marks to create obvious confusion. See, e.g., *Tomei v. Finley*, 512 F. Supp. 695, 696–97 (N.D. Ill. 1981) (enjoining local Democratic candidates from calling themselves the "REP Party"); *Planned Parenthood Fed'n of Am., Inc. v. Problem Pregnancy of Worcester, Inc.*, 498 N.E.2d 1044, 1045 (Mass. 1986) (affirming injunction against a pro-life group down the hall from Planned Parenthood that called itself "PP" while advertising pregnancy counseling).

At the same time, a strong threshold test harmonizes with this Court's precedent. Even when protected speech is "inextricably intertwined" with financial motivation, the Court has deferred to tests for "fully protected expression." *Riley v. Nat'l Fed'n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988). And

as the Court has made clear, the Lanham Act should “not be stretched to cover matters that are typically of no consequence to purchasers.” *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 32–33 (2003).

While minimizing confusion over product origin or affiliation is important, an expressive product’s source is “typically of no consequence to purchasers.” Instead, consumers fix on the larger message the product conveys. Suppose students sell shirts protesting their college’s campus speech policy and include the college’s logo as part of the message. Purchasers will probably care more about the message than who sold it.

Not stretching the Lanham Act beyond its plain scope, as Jack Daniel’s advocates for here, also tracks the reality that legitimately expressive works rarely confuse consumers. “Trademark holders are unlikely to develop brands that lampoon themselves and consumers are unlikely to believe that they’ve done so.”¹⁵ In the same way, trademark holders are unlikely to develop brands that are self-critical or shine a negative light on the brand, in ways that expressive political or social works about the brand might.¹⁶

¹⁵ Dogan & Lemley, *supra* note 9, at 503.

¹⁶ Congress also sees the need to protect First Amendment rights against Lanham Act overreach. *E.g.*, 15 U.S.C. § 1125(c)(3) (codifying speech-protective expressions to the Trademark Dilution Act); Report 116-645, *Trademark Modernization Act of 2020*, 116th Congress 2d Session, House of Representatives

In sum, mark owners often wield infringement and dilution tests¹⁷ against disfavored speakers. First Amendment safeguards are needed to protect expressive works and products from their poorly intentioned but well-funded attacks.

CONCLUSION

For the foregoing reasons, the Court should affirm the Ninth Circuit's ruling and adopt a threshold test for trademark infringement claims that covers all protected speech, including political, social, and artistic messaging.

Committee on the Judiciary (Dec. 14, 2020) (“[T]he Committee intends and expects that courts will continue to apply the *Rogers* standard to cabin the reach of the Lanham Act in cases involving expressive works.”).

¹⁷ *Amicus* also urges the Court, as Respondent does, to refuse to stretch dilution-by-tarnishment claims to intrude on free expression. *See* Br. of Respondent, 51– 62.

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Respectfully Submitted,

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