

No. 20-365

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In the Supreme Court of the United States

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JACK DANIEL'S PROPERTIES, INC.,

*Petitioner,*

v.

VIP PRODUCTS LLC,

*Respondent.*

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

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**BRIEF FOR CAMPBELL SOUP COMPANY AS  
AMICUS CURIAE IN SUPPORT OF  
PETITIONER**

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## STATEMENT OF INTEREST<sup>1</sup>

Campbell Soup Company is the leading manufacturer of high-quality soups, simple meals, snacks, and beverages. Since 1898, Campbell Soup has marketed its food products using its famous trademark and distinctive trade dresses. The company's red and white soup labels are instantly recognizable and iconic. *See, e.g., Twentieth Century Fox Television v. Empire Distribution, Inc.*, 875 F.3d 1192, 1198 (9th Cir. 2017) (“Campbell’s is an iconic soup brand”).

Today, Campbell Soup’s popular brands include CAMPBELL’S® and CHUNKY® soups, EMERALD® nuts, GOLDFISH® crackers, KETTLE® brand potato chips, MILANO® cookies, PACE® salsa, PEPPERIDGE FARM® baked goods, POP SECRET® popcorn, PREGO® pasta sauces, SNYDER’S OF HANOVER® pretzels, and V8® vegetable juices.

Campbell Soup regards its trademarks and trade dresses—and robust legal protection of them—as important ingredients of its success. To help achieve billions of dollars in annual sales, Campbell Soup spends hundreds of millions of dollars every year to maintain and cultivate consumer awareness of its brands.

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<sup>1</sup> Pursuant to Supreme Court Rule 37.6, *amicus curiae* states that no counsel for any party authored this brief in whole or in part and that no entity or person, aside from *amicus curiae*, its members, and its counsel, made any monetary contribution toward the preparation or submission of this brief. Pursuant to Supreme Court Rule 37.2(a), counsel of record for all parties have consented in writing to the filing of this brief; all parties were notified by *amicus curiae* of its intent to file this brief more than 10 days prior to its due date.

Campbell Soup has a strong interest in this case because it expects that, absent this Court's intervention, the Ninth Circuit's erroneous construction of the Lanham Act and Trademark Dilution Revision Act of 2006 ("TDRA") will deny trademark owners and consumers the important protections that Congress intended they should have. Two holdings by the Ninth Circuit—one concerning trademark infringement claims under the Lanham Act and the other concerning dilution by tarnishment claims under the TDRA—are greatly concerning.

*First*, the Ninth Circuit dealt a severe blow to the Lanham Act, which Congress enacted to protect consumers from "deceptive and misleading use of marks" and protect mark owners from "unfair competition." 15 U.S.C. § 1127. The Lanham Act "broadly prohibits uses of trademarks, trade names, and trade dress that are likely to cause confusion about the source of a product." *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003). To establish liability under the statute, the plaintiff must show a likelihood of confusion from the defendant's use of the mark. *See* 15 U.S.C. § 1114(1)(a) and § 1125(a)(1)(A).

The Ninth Circuit, however, imposes a "heightened burden" on some Lanham Act plaintiffs. In that court, if the defendant uses the plaintiff's mark to sell a commercial product and communicates a humorous message in the process, the product is considered an "expressive work" entitled to special protection under the First Amendment. In such a case, even a strong showing of confusion is not enough to prevail on a Lanham Act claim. Rather, the plaintiff claiming trademark infringement carries the heavier burden

set out in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). To prevail under the *Rogers* test, an infringement plaintiff must show, not only consumer confusion, but also that the defendant's use of the mark "is either (1) not artistically relevant to the underlying work or (2) explicitly misleads consumers as to the source or content of the work." Pet. App. 10a (quotation marks omitted).

*Second*, the Ninth Circuit shut the door on claims of trademark dilution by tarnishment under the TDRA in cases involving commercial products that send a humorous message. Congress in the TDRA prohibited "dilution by tarnishment"—i.e., using a mark similar to a famous mark owned by another in a way that harms the reputation of the famous mark. See 15 U.S.C. § 1125(c)(2)(C). The Ninth Circuit held in this case that an exception in the TDRA allowing "noncommercial use" of a mark, *id.* § 1125(c)(3)(C), actually authorizes commercial use of another's mark if a humorous message is also conveyed. Pet. App. 13a. Under the Ninth Circuit's equation, *commercial use + humor = noncommercial use*.

The issues in this case are very important to mark owners such as Campbell Soup Company. This case involves a dog toy that looks like a Jack Daniel's bottle. The dog toy is intended to be funny, but the trademark issues it raises are no laughing matter. The dog toy is, first and foremost, a commercial product. VIP Products deliberately designed its "Bad Spaniels" toy to trade on Jack Daniel's famous whiskey trademarks and trade dress, and evidence at trial showed that 29% of those surveyed mistakenly believed that Jack Daniel's was associated with the toy.



*See* Pet. App. 47a-48a. But the Ninth Circuit gave VIP a free pass—vacating and remanding the judgment in Jack Daniel’s favor on its infringement claim and reversing outright the judgment for Jack Daniel’s on its dilution claim—because VIP’s product incorporated a little dog-related humor. In so doing, the Ninth Circuit blew gaping holes in the protections in the Lanham Act and the TDRA for mark owners and consumers.

### **SUMMARY OF ARGUMENT**

The trademark issues in this case are exceptionally important and recurring. The Ninth Circuit held that, even if a Lanham Act plaintiff demonstrates a strong likelihood of consumer confusion, that is not enough to establish trademark infringement in a case involving a commercial product that expresses a humorous message. The Ninth Circuit also held that, when such a product is at issue, a claim of dilution by tarnishment under the TDRA cannot succeed.

The heightened burden imposed by the Ninth Circuit on some Lanham Act plaintiffs—requiring them to show that the use of the mark is not artistically relevant to the work or that the use explicitly misleads consumers—has no basis in the Lanham Act’s text. The First Amendment does not authorize the Ninth Circuit to rewrite the unambiguous language of the Lanham Act or to decide not to apply the statute as written. Imposing trademark infringement liability under the Lanham Act when a defendant’s commercial use of another’s mark causes significant consumer confusion clearly comports with the First Amendment.

The Ninth Circuit also misconstrued an exception in the TDRA permitting *noncommercial* use of a mark as permitting humorous *commercial* use of a mark. The Ninth Circuit’s reading allows the exception to swallow the rule.

## ARGUMENT

### I. THE TRADEMARK ISSUES IN THIS CASE ARE EXCEPTIONALLY IMPORTANT TO MARK OWNERS AND CONSUMERS.

The questions presented in this case—(1) whether a plaintiff claiming trademark infringement under the Lanham Act must carry a heightened burden when challenging a commercial product that conveys a humorous message, and (2) whether such a product is “noncommercial” for purposes of the TDRA and hence immune to a dilution by tarnishment claim—are of exceptional importance to trademark owners such as Campbell Soup and countless other mark owners. The issues are also extremely important to the millions of consumers that the federal trademark statutes aim to protect from deceptive or misleading use of marks.

Under the Ninth Circuit’s decision, even if a plaintiff demonstrates a strong likelihood of consumer confusion, as Jack Daniel’s did here, that is not enough to establish trademark infringement in a case involving a humorous commercial product. The decision below also holds that, when such a product is at issue, there can be no claim of dilution by tarnishment. This Court should grant review to confirm that infringing commercial products do not receive heightened protection from Lanham Act claims—or immu-

ity from TDRA dilution claims—just because they are meant to be funny.

Trademarks and trade dresses help consumers make informed choices. They make it possible for consumers to identify the products they like made by manufacturers they know and trust. *See Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (“It [a trademark] helps consumers identify goods and services that they wish to purchase, as well as those they want to avoid.”); *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) (trademarks “protect the ability of consumers to distinguish among competing producers”). Fans of Campbell’s tomato soup, for example, can be confident about what they are getting when they see the famous red and white label bearing the distinctive Campbell’s trademark. *See B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015) (“The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan’s goods from those of others.”). Of course, protection of trademarks also benefits mark owners by “secur[ing] to the owner of the mark the goodwill of his business.” *Park ’N Fly*, 469 U.S. at 198.

The Lanham Act of 1946 is “[t]he foundation of current federal trademark law.” *Tam*, 137 S. Ct. at 1752. “National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.” *Park ’N Fly*, 469 U.S. at 198. Congress’ objectives are undermined, however, by the creation of judge-made loopholes in the Lanham Act and TDRA.

Campbell Soup, like many other companies, uses trademarks and trade dresses to market its products. The company must be, and is, vigilant about protecting its trademark and trade dress rights from affront. *See, e.g.*, Complaint, *CSC Brands LP v. Chicken Soup for the Soul Publ'g, LLC*, No. 1:12-cv-06569 (D.N.J. Oct. 17, 2012) (suit to enjoin proposed launch of line of chicken soup products infringing Campbell Soup's trademarks and trade dresses); *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208 (2d Cir. 1999) (affirming grant of preliminary injunction to Campbell Soup subsidiary Pepperidge Farm, Inc., and holding that another company's goldfish-shaped cheddar cheese cracker would dilute the GOLDFISH® configuration mark).

As the owner of iconic marks, Campbell Soup has confronted trademark issues similar to those in the instant case for many years. *See, e.g.*, *Grey v. Campbell Soup Co.*, 650 F. Supp. 1166 (C.D. Cal. 1986), *aff'd*, 830 F.2d 197 (9th Cir. 1987). What has changed recently is the heightened burden that the Ninth Circuit imposes on Lanham Act plaintiffs in certain cases.

In *Grey*, the maker of “DOGIVA” dog biscuits and a “CATIVA” product for cats sued Campbell Soup in federal district court in California seeking declaratory relief.<sup>2</sup> Campbell Soup, which at that time owned the GODIVA® trademark used in marketing choco-

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<sup>2</sup> As in *Grey* and the instant case, infringers often file preemptive declaratory judgment actions against trademark owners in their forum of choice. The decision below will make the Ninth Circuit even more attractive to forum shoppers.

lates, counterclaimed against plaintiff Grey for trademark infringement and dilution. After a bench trial, the district court ruled in Campbell Soup's favor. The Ninth Circuit affirmed without opinion.

*Grey* was litigated before the Ninth Circuit adopted the *Rogers* test, and so the district court decided Campbell Soup's infringement claim by applying the Lanham Act's traditional likelihood-of-confusion standard. The fact that plaintiff Grey "decided to use DOGIVA because it was a clever play on GODIVA," 650 F. Supp. at 1175, did not call for a different analysis. If the case had been litigated today, Grey might have argued that DOGIVA was intended to be a humorous commentary on the GODIVA® brand and thus was an expressive work, and the court might have imposed a heightened burden on Campbell Soup to show that the *Rogers* test was satisfied.

The sale of humorous commercial products that infringe Campbell Soup's marks and mimic its trade dresses continues to be a concern today. In July 2020, for example, Campbell Soup halted a third party's sale of T-shirts depicting a red and white Campbell's soup label but adding the words "Bat Soup" and "Now With COVID-19." The T-shirts, despite their apparent attempt to make light of the ongoing global pandemic, clearly infringed and tarnished the reputation of Campbell Soup's marks. A commercial product of this nature should not receive heightened protection from a Lanham Act claim merely because it uses morbid humor. Nor should the commercial sale of the T-shirts have qualified for the noncommercial use exception in the TDRA based on the product's message.

In September 2020, Campbell Soup sent a cease-and-desist letter to stop a third party from selling a product described on the packaging as “Goldfish” treats “for dogs and cats.” The product, which resembled the Goldfish-shaped snacks made by Pepperidge Farm, infringed the GOLDFISH® word, logo, and configuration marks and misappropriated the company’s trade dress. The look and labeling of the product likely would have confused consumers about whether Pepperidge Farm made the product. Such confusion would have been particularly damaging to Pepperidge Farm’s reputation since the product presented a significant food safety problem. Its improper association with and resemblance to Pepperidge Farm’s GOLDFISH® crackers easily could have caused confusion about whether the product was fit for human consumption. *See Grey*, 650 F. Supp. at 1175 (“Grey’s use of DOGIVA and CATIVA also injures Campbell’s business reputation because of the association which the public makes between DOGIVA and CATIVA treats for animals and GODIVA premium quality food products which are intended for human consumption.”). It is not clear if the offending product was intended to convey a humorous message, but, regardless, a manufacturer should not be given license to deceive and potentially harm consumers, merely by invoking its purportedly comedic intent.

Campbell Soup also had to send a cease-and-desist letter to halt a third party’s sale of Goldfish-shaped marijuana edibles. Products containing marijuana often use silly humor in their marketing, and it would be very dangerous if the Ninth Circuit’s decision allowed the purveyors of such products to claim an en-

titlement to heightened protection against Lanham Act claims.

Too, Campbell Soup has seen its share of infringing dog toys over the years. Examples include a chew toy designed to look like a bag of KETTLE® Brand Potato Chips; the toy used the words “Kennel Brand Doggie Chips” and “Spicy Bark.” Campbell Soup sent a cease-and-desist letter in response. On another occasion, Campbell Soup sent a cease-and-desist letter to those responsible for a dog toy closely resembling a red and white Campbell’s soup can but substituting the words “Canine’s ToMUTTo soup” for Campbell’s tomato soup.

The instant case involves a chew toy for dogs, but the trademark issues raised frequently arise in litigation involving a variety of humorous commercial products. The petition for certiorari cites conflicting decisions of the Second, Fourth, Fifth, Seventh, Eighth, and Tenth Circuits. *See* Pet. 18-22. The questions presented here not only have divided the circuits but are recurring issues.

The cases cited in the petition, moreover, represent just the tip of the iceberg. Numerous reported cases involve humorous commercial products that mimic the trademarks of leading food and beverage brands. *See, e.g., Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 736 F.3d 198 (2d Cir. 2013) (“Mister Charbucks” coffee); *Hormel Foods Corp. v. Jim Henson Productions, Inc.*, 73 F.3d 497 (2d Cir. 1996) (Muppet named “SPA’AM”); *Anheuser-Busch, Inc. v. Balducci Publications*, 28 F.3d 769 (8th Cir. 1994) (“Michelob Oily” ad parody); *Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.2d 316 (4th Cir. 1992)

(“King of Beaches” T-shirt resembling Budweiser label); *Anheuser-Busch, Inc. v. VIP Products, LLC*, 666 F. Supp. 2d 974 (E.D. Mo. 2008) (“ButtWiper” dog toy); *Kraft Foods Holdings, Inc. v. Helm*, 205 F. Supp. 2d 942 (N.D. Ill. 2002) (“King VelVeeda” website); *American Dairy Queen Corp. v. New Line Productions, Inc.*, 35 F. Supp. 2d 727 (D. Minn. 1998) (“Dairy Queens” movie); *Schieffelin & Co. v. Jack Co. of Boca*, 850 F. Supp. 232 (S.D.N.Y. 1994) (“Dom Popignon” popcorn); *Grey v. Campbell Soup Co.*, 650 F. Supp. 1166 (C.D. Cal. 1986) (“DOGIVA” dog biscuits), *aff’d*, 830 F.2d 197 (9th Cir. 1987). And these are just the cases involving food and beverage trademarks. Many more cases could be cited involving marks in a variety of other industries.

Ultimately, the Ninth Circuit’s decision threatens mark owners with loss of control over their marks and reputations. A single offending dog toy may not have such an effect. But the Ninth Circuit’s decision will encourage a proliferation of purportedly humorous commercial products that in fact infringe trademarks and deceive consumers. A brand’s carefully cultivated image may be irreparably damaged as a result. *See, e.g., Societe Des Produits Nestle, S.A. v. Casa Helvetia, Inc.*, 982 F.2d 633, 640 (1st Cir. 1992) (“[I]rreparable harm flows from an unlawful trademark infringement as a matter of law.”); *S & R Corp. v. Jiffy Lube Int’l, Inc.*, 968 F.2d 371, 378 (3d Cir. 1992) (same). This Court should review the Ninth Circuit’s decision in this case, which rewrites the Lanham Act, to prevent such an outcome.



## **II. THE NINTH CIRCUIT HAS SIGNIFICANTLY UNDERMINED THE ACTS OF CONGRESS PROTECTING TRADEMARK AND TRADE DRESS RIGHTS.**

With the decision below, the Ninth Circuit has blown gaping holes in both the Lanham Act and the TDRA, statutes enacted by Congress to protect trademarks and trade dresses from infringement and dilution. In the Ninth Circuit, a plaintiff now carries a “heightened burden” on a trademark infringement claim—and has no chance to prevail on a dilution by tarnishment claim—when the defendant blends humor with its use of the plaintiff’s mark to sell a commercial product.

### **A. The Ninth Circuit Has Rewritten the Lanham Act to Impose a Heightened Burden With No Basis in the Statutory Text.**

The Lanham Act “creates a federal cause of action for trademark infringement. The owner of a mark, whether registered or not, can bring suit in federal court if another is using a mark that too closely resembles the plaintiff’s.” *B & B Hardware*, 575 U.S. at 144. Under the Lanham Act, the touchstone for infringement liability is likelihood of confusion. *See* 15 U.S.C. § 1114(1)(a) and § 1125(a)(1)(A).

The Ninth Circuit held in this case, however, that the Lanham Act and its likelihood-of-confusion test do not apply to “expressive works” unless the plaintiff first shows “that the defendant’s use of the mark is either (1) not artistically relevant to the underlying work or (2) explicitly misleads consumers as to the source or content of the work.” Pet. App. 10a (quotation marks omitted). In so holding, the Ninth Circuit

hit Lanham Act plaintiffs with a double whammy. The bar for a defendant to show that its use of another's mark qualifies as an "expressive work" is set very low, while the bar for plaintiffs to show that the use is "not artistically relevant" or "explicitly misleads consumers" is set very high.

The Ninth Circuit set a very low bar for status as an expressive work, saying that "we analyze whether the work is communicating ideas or expressing points of view." Pet. App. 10a (quotation marks omitted). The Ninth Circuit explained that "[a] work need not be the expressive equal of *Anna Karenina* or *Citizen Kane* to satisfy this requirement, and is not rendered non-expressive simply because it is sold commercially." *Id.* at 10a-11a (quotation marks and citations omitted). A commercial product that conveys a little lowbrow humor easily passes the Ninth Circuit's test. The court held that VIP Product's "Bad Spaniels dog toy, although surely not the equivalent of the *Mona Lisa*, is an expressive work" simply because it communicates "a silly message." *Id.* at 11a. "Great creative artistry" is not required for a product to be an expressive work under the Ninth Circuit's test. *Id.* (quotation marks omitted).

Once a humorous commercial product clears this low hurdle and is classified as an expressive work, the Ninth Circuit requires the Lanham Act plaintiff to establish "one of the two requirements in the test set forth in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989)." Pet. App. 10a. The plaintiff must show that the defendant's use of its mark "is either (1) not artistically relevant to the underlying work or (2) explicitly misleads consumers as to the source or content of

the work.” *Id.* (quotation marks omitted).<sup>3</sup> After finding that the “Bad Spaniels” dog toy was an expressive work, the Ninth Circuit remanded to the district court to determine if Jack Daniel’s can satisfy the two-prong *Rogers* test. Pet. App. 13a.

The Ninth Circuit thus saddles Lanham Act plaintiffs with a “heightened burden.” *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018). If the defendant makes the threshold showing that its allegedly infringing use is part of an expressive work, “then the plaintiff claiming trademark infringement bears a heightened burden—the plaintiff must satisfy not only the likelihood-of-confusion test but also at least one of *Rogers*’s two prongs.” *Id.* “If the plaintiff satisfies both elements, it still must prove that its trademark has been infringed by showing that the defendant’s use of the mark is likely to cause confusion.” *Id.* at 265.

Satisfying either prong of *Rogers* is a tough task in the Ninth Circuit. The first prong—which asks a plaintiff to show that the defendant’s use of the mark is not artistically relevant to the expressive work—is met only if “the use of the mark is arbitrary.” *Twentieth Century Fox Television*, 875 F.3d at 1198. From the defendant’s perspective, “[t]he bar is set low: the level of relevance merely must be above zero.” *Id.* (quotation marks omitted). From the vantage of the

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<sup>3</sup> Although the Second Circuit developed the *Rogers* test to judge the “use of a trademark in the title of an expressive work,” the Ninth Circuit has “extended the *Rogers* test beyond a title.” Pet. App. 10a.

plaintiff who must show that this prong is met, the bar is a high one.

The second *Rogers* prong is also difficult to establish in the Ninth Circuit. “To fail the second prong of the *Rogers* test, it is key that the [defendant] must *explicitly* mislead consumers.” *Id.* at 1199 (quotation marks, brackets, and ellipses omitted; emphasis in original). “We must ask not only about the likelihood of consumer confusion but also whether there was an ‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement’ that caused such consumer confusion.” *Id.* (quoting *Rogers*, 875 F.2d at 1001; other quotation marks omitted).

Given the Ninth Circuit’s cases, it is no surprise that plaintiffs subject to *Rogers* have not fared well in that court. In 2018, the Ninth Circuit noted that “on every prior occasion in which we have applied the [*Rogers*] test, we have found that it barred an infringement claim as a matter of law.” *Gordon*, 909 F.3d at 261. In *Gordon*, the Ninth Circuit finally broke that streak, holding that one of the *Rogers* prongs presented a triable issue of fact in that case.

Importantly, the heightened burden imposed by the Ninth Circuit on some Lanham Act plaintiffs under *Rogers*—requiring them to show that the use of the mark is not artistically relevant to the work or that the use explicitly misleads consumers—has no basis in the Lanham Act’s text. The operative language of the statute asks if “the defendant’s use of a mark in commerce ‘is likely to cause confusion, or to cause mistake, or to deceive’ with regards to the plaintiff’s mark.” *B & B Hardware*, 575 U.S. at 144 (quoting 15 U.S.C. § 1114(1)(a) and § 1125(a)(1)(A)).

The Lanham Act does not draw a distinction between expressive and non-expressive works; nor does it ask whether a challenged use has artistic relevance to the work or explicitly misleads.

This Court has emphasized that the Lanham Act must be interpreted based on “the statute’s language, structure, and history.” *Romag Fasteners, Inc v. Fossil, Inc.*, 140 S. Ct. 1492, 1497 (2020). See *B & B Hardware*, 575 U.S. at 151 (construing the Lanham Act based on its “text” and “structure”); *Park ’N Fly*, 469 U.S. at 194 (interpreting the Lanham Act based on “the ordinary meaning” of “the language employed by Congress”). And the statute must not be interpreted, this Court has said, by “read[ing] into [it] words that aren’t there.” *Romag Fasteners*, 140 S. Ct. at 1495. Here, “[o]ne searches the language of the Lanham Act in vain to find any support” for the heightened burden that the Ninth Circuit imposes on some plaintiffs. *Park ’N Fly*, 469 U.S. at 196.

The Ninth Circuit has said that “the *Rogers* test is a limiting construction of the Lanham Act” informed by First Amendment considerations. *Twentieth Century Fox Television*, 875 F.3d at 1196 n.1. It has also said that it uses *Rogers* “to determine *whether* the Lanham Act *applies*.” *Id.* at 1196 (emphases added). See Pet. App. 10a (“[W]e have held that the Lanham Act only applies to expressive works if the plaintiff establishes one of the two requirements in the test set forth in *Rogers*”).

The First Amendment, however, does not authorize the Ninth Circuit to rewrite the Lanham Act or to decide not to apply the statute. It is the prerogative of Congress to determine the content and scope of the

statute. In a Lanham Act case, a court’s “limited role is to read and apply the law those policymakers have ordained.” *Romag Fasteners*, 140 S. Ct. at 1497.

In Lanham Act cases, as in others, courts “may interpret ambiguous statutory language to avoid serious constitutional doubts.” *Iancu v. Brunetti*, 139 S. Ct. 2294, 2301 (2019) (quotation marks omitted). “But that canon of construction applies only when ambiguity exists.” *Id.* Therefore, even if a suggested “reading would eliminate First Amendment problems, we may adopt it only if we can see it in the statutory language.” *Id.* To the extent that First Amendment issues might arise from certain applications of the Lanham Act, they “cannot be fixed” by “rewriting the statute.” *Id.* at 2302 (Alito, J., concurring).

The avoidance canon does not come into play here, for two reasons. First, the Ninth Circuit has not found the Lanham Act to be ambiguous in any relevant respect, and that court does not pretend that the *Rogers* test may be gleaned from the text of the statute. The trial court had no trouble applying the likelihood-of-confusion test in this case.

Second, the relevant provisions of the Lanham Act are constitutional. Imposing trademark infringement liability when a defendant’s commercial use of another’s mark causes significant consumer confusion clearly comports with the First Amendment. The Lanham Act’s express purposes include “making actionable the deceptive and misleading use of marks” and “prevent[ing] fraud and deception ... by the use of ... colorable imitations of registered marks.” 15 U.S.C. § 1127. This Court has long recognized that

Congress “constitutionally may regulate ‘deceptive or misleading’ commercial speech” through laws protecting trademark rights. *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 535 n.12 (1987). Indeed, “regulating confusing uses ... is within normal trademark bounds.” *Id.* See also *Tam*, 137 S. Ct. at 1768 (opinion of Kennedy, J.) (“It is well settled” that trademark laws may protect consumers and mark owners from “confusing or misleading” uses). Because the dog toy at issue is clearly deceptive—the trial court credited expert evidence that 29% of potential purchasers “are likely to be confused or deceived” by the toy (Pet. App. 49a)—imposing liability under the Lanham Act’s likelihood-of-confusion standard (without the added *Rogers* burden) raises no First Amendment problem.

The Ninth Circuit did not quarrel with the trial court’s application of the likelihood-of-confusion test, and it has allowed that “[o]rdinarily, this test strikes a comfortable balance between the Lanham Act and the First Amendment.” *Gordon*, 909 F.3d at 264 (quotation marks omitted). The Ninth Circuit has no warrant to rewrite unambiguous provisions of the Lanham Act based on general First Amendment principles, especially since the Lanham Act already takes First Amendment considerations into account. Unless a given application of the Lanham Act’s plain text would be unconstitutional, a court’s “limited role is to read and apply the law” that Congress passed. *Romag Fasteners*, 140 S. Ct. at 1497.

**B. The Ninth Circuit Has Transformed the TDRA’s “Noncommercial Use” Exception to Authorize Commercial Use of a Mark.**

After rewriting the Lanham Act to make it extremely difficult to secure relief from an infringing but humorous use of another’s trademark, the Ninth Circuit blue-penciled the TDRA to make it impossible to challenge a humorous commercial product as dilution by tarnishment.

In enacting the TDRA in 2006, Congress strengthened an earlier statute, the Federal Trademark Dilution Act of 1995 (“FTDA”).<sup>4</sup> In both Acts, Congress “create[d] a cause of action for trademark dilution—conduct that lessens the association consumers have with a trademark.” *Romag Fasteners*, 140 S. Ct. at 1495. The TDRA provides for two types of dilution claims: dilution by blurring and dilution by tarnishment. This case concerns the latter type.

The TDRA defines dilution by tarnishment as the “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.” 15 U.S.C. § 1125(c)(2)(C). The TDRA generally entitles the owner of a famous mark to injunctive relief if another person “commences uses of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark.” *Id.*

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<sup>4</sup> Congress passed the TDRA in response to *Moseley*, in which this Court held that the FTDA required a showing of actual dilution rather than a likelihood of dilution. The TDRA now provides relief if the plaintiff shows that the defendant’s use of its famous mark is “likely to cause dilution.” 15 U.S.C. § 1125(c)(1).



§ 1125(c)(1). And, unlike the Lanham Act, the TDRA does not require plaintiffs to prove confusion. *See id.* (authorizing injunctive relief as a remedy for dilution “regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury”).

An exception in the TDRA provides that certain uses are not actionable as dilution, including “[a]ny noncommercial use of a mark.” *Id.* § 1125(c)(3)(C). The Ninth Circuit held in this case that this exception for *noncommercial* use of another’s mark actually authorizes the opposite—*commercial* use of a mark—so long as the use is combined with humor. Thus, in cases involving humorous commercial products, the Ninth Circuit reads the exception to swallow the rule.<sup>5</sup>

The Ninth Circuit held that VIP Products was entitled to judgment as a matter of law on Jack Daniel’s dilution by tarnishment claim because, although VIP used Jack Daniel’s trade dress and bottle design to sell its dog toys, it “also used [them] to convey a humorous message.” Pet. App. 13a. Using another’s trademark and some dog-related humor to sell a

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<sup>5</sup> The TDRA contains a separate exception for parody. That exception permits “fair use” of a famous mark, including “parodying, criticizing, or commenting upon” a mark, so long as the use is “other than as a designation of source for the person’s own goods or services.” 15 U.S.C. § 1125(c)(3)(A)(ii). The district court held in this case that the parody exception did not apply because VIP Products used Jack Daniel’s mark for source designation. *See* Pet. App. 84a-85a. The Ninth Circuit did not disturb that holding on appeal.

commercial product, the Ninth Circuit declared, “is protected by the First Amendment.” *Id.*

The decision below extended a prior Ninth Circuit decision holding that the noncommercial use exception permitted the commercial use of a mark. *See Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002). The *Mattel* case involved the pop song “Barbie Girl” recorded by the band Aqua. Mattel, the owner of the Barbie mark, claimed that Aqua’s record label, MCA, had diluted the mark in violation of the FTDA. But the Ninth Circuit held that, even though “MCA used Barbie’s name to sell copies of the song,” the noncommercial use exception applied because “the song also lampoons the Barbie image and comments humorously on the cultural values Aqua claims she represents.” *Id.* at 907. The decision below is even more egregious than *Mattel* because it applied *Mattel*’s holding to a commercial product, a “silly” dog toy. Pet. App. 11a.

The Ninth Circuit construes the TDRA’s noncommercial use exception to permit the commercial—and diluting—use of another’s mark so long as the use also strives to be funny. This Court should review the Ninth Circuit’s construction of the TDRA, which allows the tail to wag the dog.<sup>6</sup>

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<sup>6</sup> The sponsors of the identical bills that became the FTDA explained that “[t]he bill will not prohibit or threaten noncommercial expression, such as parody, satire, editorial and other forms of expression *that are not part of a commercial transaction.*” 141 Cong. Rec. S19306, S19310 (daily ed. Dec. 29, 1995) (statement of Sen. Hatch) (emphasis added); 141 Cong. Rec. H14317, H14318 (daily ed. Dec. 12, 1995) (statement of Rep. Moorhead) (emphasis added). In the instant case, however, the humorous expression comes from a commercial product.

**CONCLUSION**

For the foregoing reasons, as well as those stated by petitioner, the petition for certiorari should be granted.

Respectfully submitted,

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October 19, 2020

