

No. 20-365

IN THE
Supreme Court of the United States

JACK DANIEL'S PROPERTIES, INC.,

Petitioner,

v.

VIP PRODUCTS LLC,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

1. Does the *Rogers* test apply to an artistic parody of the famous Jack Daniels whiskey bottle to determine trademark infringement?

2. Does the Trademark Dilution Revision Act's statutory exception for "noncommercial use" apply to an artistic parody of the famous Jack Daniels whiskey bottle?

CORPORATE DISCLOSURE STATEMENT

Respondent VIP Products LLC is an Arizona limited liability company, and no publicly traded company owns 10% or more of the interest in Respondent.

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INTRODUCTION

Petitioner Jack Daniels Property Inc.’s (“JDPI”) petition for a writ of certiorari should be denied because there are no cert-worthy conflicts for the Court to resolve, and the Ninth Circuit’s unanimous opinion below was decided correctly and in a manner consistent with the approach of circuit courts that have considered trademark infringement and dilution claims where the alleged offending use was part of an expressive work. Neither the Ninth Circuit nor any other circuit has perceived any conflict among them in the small number of cases that have addressed the infrequently raised issues presented. Moreover, the Ninth Circuit’s opinion did not even conclude the case, which has been remanded for a determination on the merits of the trademark infringement claim.

Petitioner’s Lanham Act trademark infringement and dilution claims target protected First Amendment expression—a parody of the famous Jack Daniels whiskey bottle, Respondent VIP Products LLC’s (“VIP”) Bad Spaniels Silly Squeaker dog toy. There is no dispute by any party or any court in this case that the Bad Spaniels parody dog toy is an expressive work.¹ The only issues decided by the Ninth Circuit were the standards that properly govern infringement and dilution claims in the expressive context.

1. Petitioner concedes that Bad Spaniels constitutes a “humorous [i.e., expressive] use of another’s trademark or trade dress,” and “imitates a Jack Daniel’s whiskey bottle, while adding ... juvenile bathroom humor.” Pet. at 4-5.

With regard to Petitioner’s infringement claim, the Ninth Circuit correctly held that the *Rogers* test—the test derived from the Second Circuit’s seminal decision in *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989)—applies to the facts here, and the court of appeals remanded the case to the district court for application of the *Rogers* test. With regard to Petitioner’s dilution claim, the Ninth Circuit correctly held that the Bad Spaniels parody was noncommercial speech under this Court’s commercial-speech doctrine and therefore was exempted from liability under the statutory “noncommercial use” exception of the Trademark Dilution Revision Act of 2006 (“TDRA”), 15 U.S.C. § 1125(c).

Petitioner asks this Court to review both of those rulings, contending that they were incorrect and in conflict with decisions of other circuits. But review is entirely unwarranted—particularly at this interlocutory stage. First, in vacating the district court’s ban on protected parody, dismissing Petitioner’s dilution claim as a matter of law under the TDRA’s noncommercial-use exception, and reversing and remanding for application of the *Rogers* test in the first instance, the unanimous Ninth Circuit scrupulously and faithfully followed settled and uniform precedent.

Second, there are no circuit conflicts, let alone cert-worthy conflicts, on either of the questions presented. Every court of appeals to consider the issue has adopted the *Rogers* test to determine likelihood of confusion in the expressive context. No circuit has rejected it. Likewise, to determine whether the alleged dilutive use falls within the TDRA’s noncommercial-use exemption, the courts, including the Ninth Circuit, uniformly apply this Court’s

commercial-speech doctrine and generally decide this issue as a matter of law. The Ninth Circuit did not believe it was creating or perpetuating a circuit conflict, and no other court has recognized a circuit conflict.

In reality, Petitioner’s (and amici curiae’s) quarrel is not with the Ninth Circuit’s manifestly correct rulings below, but with the balance Congress and the courts have struck between trademark rights and First Amendment rights, and with the long-recognized principle that the First Amendment does not permit “the trademark owner ... to control public discourse” about its trademark. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

The petition for certiorari should be denied.

STATEMENT

1. Respondent VIP designs, manufactures, markets, and sells dog toys. Pet App. 5a-6a, 26a. Among its dog toy product offerings is a parody line branded “Silly Squeakers®.” *Id.* VIP’s Silly Squeakers line of dog toys includes a variety of toys in the shapes of beer, wine, soda, and liquor bottles. Pet. App. 27a-28a. Among those Silly Squeakers® brand dog toys is the Bad Spaniels Silly Squeaker. Pet. App. 28a.

VIP designed the Bad Spaniels Silly Squeaker to be a comical parody of the Jack Daniel’s black label whiskey. Pet. App. 49a. As the Ninth Circuit stated, “VIP’s purported goal in creating Silly Squeakers was to ‘reflect’ ‘on the humanization of the dog in our lives,’ and to comment on ‘corporations [that] take themselves very

seriously.” Pet. App. 6a. The district court acknowledged that VIP owner Stephen Sacra’s “intent behind producing the Silly Squeakers line of toys was to develop a creative parody on existing products.” Pet. App. 28a.

To accomplish the parodic effect, the Bad Spaniels Silly Squeaker invokes elements of the Jack Daniel’s black label whiskey bottle and artistically transforms those elements in order to communicate the parody. “Jack Daniel’s” becomes “Bad Spaniels,” “Old No. 7” becomes “Old No. 2,” and “Tennessee whiskey” becomes “Tennessee carpet.” References to alcohol content are transformed into “43% POO BY VOL.” and “100% SMELLY.” Pet. App. 28a. Bad Spaniels approximates the shape and size of a Jack Daniel’s black label whiskey bottle but features the picture of, in the district court’s words, a “wide-eyed spaniel.” Pet. App. 28a.



2. In September 2014, Petitioner JDPI “demand[ed] that VIP cease all further sales of the Bad Spaniels toy.” Pet. App. 6a, 29a. Perceiving the threat implicit in JDPI’s demand letter, VIP promptly filed the present action for a declaratory judgment that its parody of the Jack Daniel’s whiskey bottle “d[id] not infringe or dilute any claimed trademark rights” of JDPI. Pet. App. 6a; Pet. App. 29a-30a. JDPI counterclaimed and generally asserted that the Bad Spaniels Silly Squeaker infringed and diluted JDPI’s trademarks. Pet. App. 6a.

3. In September 2016, the district court denied VIP’s motion for summary judgment, rejecting VIP’s First Amendment defenses, including its parody,

noncommercial-use and fair-use defenses. Pet. App. 30a. Although the district court found that Bad Spaniels was an expressive work, the court refused to apply the *Rogers* test and the TDRA’s noncommercial-use exception, leaving for trial all of JDPI’s counterclaims. Pet. App. 30a.

In ruling on VIP’s motion for summary judgment, the district court found that VIP “adapt[ed]” JDPI’s mark for the “dual purpose” of “expressive comment[ary] [and] [to sell] a non-competing product.” Pet. App. 69a. It found Bad Spaniels to be a predominantly expressive work—the court said that it was only “somewhat non-expressive,” *id.*,—developed by a creative artist, Pet. App. 26a, whose intent “was to develop a creative parody,” *id.* Yet the court disregarded VIP’s First Amendment defenses because VIP sold the parody. Pet App. 68a.

In May 2018, following a four-day bench trial, the district court permanently banned the parody, enjoining VIP “from sourcing, manufacturing, advertising, promoting, displaying, shipping, importing, offering for sale, selling or distributing the Bad Spaniels dog toy.” Pet. App. 7a; Pet. App. 22a.

4. The Ninth Circuit, in a unanimous panel decision, reversed the district court’s judgment and remanded “because the Bad Spaniels dog toy is an expressive work entitled to First Amendment protection.” Pet. App. 5a; *VIP Prods. LLC v. Jack Daniel’s Props., Inc.*, 953 F.3d 1170, 1172 (9th Cir. 2020). The court of appeals reversed and vacated the district court’s permanent injunction; held that the parody dog toy constituted a noncommercial use such that it did not dilute Petitioner’s mark by tarnishment as a matter of law; held that the parody dog toy was an

expressive work to which the *Rogers* test applied; and remanded for application of that test in the first instance. *Id.*

In determining whether the Bad Spaniels parody was an expressive work, the Ninth Circuit analyzed “whether the work [wa]s “communicating ideas or expressing points of view.” Pet App. 10a; 953 F.3d at 1174-75 (citing *MCA Records*, 296 F.3d at 900 (quoting *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987))). The court noted that the “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.* (citations and quotations omitted).

Applying these settled standards, the Ninth Circuit held “the Bad Spaniels dog toy, although surely not the equivalent of the *Mona Lisa*, is an expressive work.” Pet App. 11a; 953 F.3d at 1175. As the court explained, Bad Spaniels is a humorous parody of the original:

The toy communicates a “humorous message,” using word play to alter the serious phrase that appears on a Jack Daniel’s bottle—“Old No. 7 Brand”—with a silly message—“The Old No. 2.” The effect is “a simple” message conveyed by “juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.” *L.L. Bean, Inc.*, 811 F.2d at 34 (affording First Amendment protection to a message “that business and product images need not always be taken too seriously”).

Id. (internal citation omitted). The court noted, “The fact that VIP chose to convey this humorous message through a dog toy is irrelevant.” Pet App. 12a; 953 F.3d at 1175 (citing *Hurley v. Irish-Am. Gay, Lesbian & Bisexual Grp. of Bos.*, 515 U.S. 557, 569 (1995)). The Ninth Circuit also observed that it was not the first court to find that dog toys can be “successful parodies” of well-known brands, pointing to the Fourth Circuit’s conclusion that a parody dog toy did not dilute or infringe as a matter of law. *Id.* (discussing *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007) (affirming grant of summary judgment for dog toy maker)).²

Petitioner sought rehearing en banc. Pet. App. 1a. The Ninth Circuit denied review, with not a single judge requesting a vote. *Id.* This petition followed.

REASONS FOR DENYING THE PETITION

I. There Is No Conflict or Split in the Lower Courts on the Application of the *Rogers* Test to Expressive Works.

With regard to Petitioner’s infringement claim, the only issue the Ninth Circuit decided was whether the Bad Spaniels parody was an expressive work to be evaluated

2. Parody products are ubiquitous in the dog product industry. For this reason, “[t]he pet owner who sees a line of products for pet dogs under names that parody [famous] brands ... such as CHEWNEL #5, DOG PERIGNON, SNIFFANY & CO. and CHEWY VUITON, is not likely to mistakenly think that those [brands] are making or authorizing the dog accessories.” 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:154 (5th ed. 2020).

under the *Rogers* test. The unanimous panel answered in the affirmative and remanded the case to the district court for application of the test. Therefore, the only issue presented by the Petition is whether there is disagreement on the standard that should govern application of the Lanham Act to expressive works. There is not.

A. The Ninth Circuit correctly held that the Bad Spaniels parody dog toy is protected expression.

The Bad Spaniels Silly Squeaker is quintessential parody, that is, “a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.” *L.L. Bean*, 811 F.2d at 34. “Parody is a form of artistic expression covered by the First Amendment.” 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:153 (5th ed. 2020).

As the Ninth Circuit correctly held below, the fact that the parody is in the form of a dog toy that is sold to the public does not “render[] [it] non-expressive” for First Amendment purposes. Pet. App. 10a-11a; *VIP Prods.*, 953 F.3d at 1175; see also *Brown v. Entm’t Merchs. Ass’n*, 564 U.S. 786, 790 (2011) (“[T]he basic principles of freedom of speech ... do not vary when a new and different medium for communication appears.” (quotation omitted)); *City of Lakewood v. Plain Dealer Publ’g Co.*, 486 U.S. 750, 756 (1988) (“Of course, the degree of First Amendment protection is not diminished merely because the ... speech is sold rather than given away.”).

B. Every circuit to consider the issue has adopted or endorsed the *Rogers* test.

There is no cert-worthy conflict presented here because every circuit that has addressed the issue has adopted the Second Circuit’s *Rogers* test to determine infringement claims that target expressive works. For this reason, as explained below, Petitioner is compelled to manufacture a conflict by citing either cases that pre-date *Rogers*, and therefore used other doctrinal tools to evaluate the fact-specific disputes before them, or cases where the issue of the *Rogers* test’s applicability was not addressed by the court.

To put this in context, the Lanham Act “creates a comprehensive framework for regulating the use of trademarks and protecting them against infringement, dilution, and unfair competition.” *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 263 (9th Cir. 2018) (quotation omitted). As to trademark infringement, in the typical, purely commercial context that does not involve an expressive use, courts traditionally weigh a nonexclusive list of several factors known as the likelihood-of-confusion test. *See, e.g., Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979). “Ordinarily, this test ‘strikes a comfortable balance’ between the Lanham Act and the First Amendment.” *Gordon*, 909 F.3d at 264 (quoting *MCA Records*, 296 F.3d at 900).

But “where artistic expression is at issue, [courts] have expressed concern that the traditional test fails to account for the full weight of the public’s interest in free expression.” *Id.* (internal quotation marks omitted). In that

context, when a mark is used in an expressive work, courts assess likelihood-of-confusion in a different way. That is because “First Amendment concerns” must “inform [a court’s] consideration of the scope of the [Lanham] Act as applied to claims involving” expressive works. *Rogers*, 875 F.2d at 998; *see also Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1242 (9th Cir. 2013) (“the likelihood of confusion test fails to account for the full weight of the public’s interest in free expression when expressive works are involved” (quotation omitted)).

In the seminal 1989 *Rogers* decision, the Second Circuit articulated a two-part test for assessing whether the use of a mark in an expressive work is “likely to cause confusion” within the meaning of the Lanham Act. Such a use, even if found to be likely confusing under the traditional analysis, is not actionable unless (1) the use has “no artistic relevance to the underlying work whatsoever,” or (2) the work “explicitly misleads as to the source or the content of the work.” *Rogers*, 875 F.2d at 999. Applying the *Rogers* test is straightforward: “the only threshold requirement for the *Rogers* test is an attempt to apply the Lanham Act to First Amendment expression.” *Twentieth Century Fox Television v. Empire Distrib. Inc.*, 875 F.3d 1192, 1198 (9th Cir. 2017).

Rogers is illustrative. That case involved a Federico Fellini film called *Ginger and Fred* about “two fictional Italian cabaret performers ... who, in their heyday, imitated” Ginger Rogers and Fred Astaire and so “became known in Italy as ‘Ginger and Fred.’” *Rogers*, 875 F.2d at 996-97. Ginger Rogers sued, alleging that the film’s title violated the Lanham Act “by creating the false impression that the film was about her or that

she sponsored, endorsed, or was otherwise involved in the film.” *Id.* at 997. Despite survey evidence showing likely confusion and evidence of actual confusion, *id.* at 1001, the court found no infringement because the use was artistically relevant to the work, and the work did not “explicitly mislead[] as to the source or content of the work,” *id.* at 999. The district courts in the Second Circuit continue to follow *Rogers*. See, e.g., *Louis Vuitton Malletier S.A. v. Warner Bros. Entm’t Inc.*, 868 F. Supp. 2d 172, 177 (S.D.N.Y. 2012) (applying *Rogers* and finding no infringement); *Cummings v. Soul Train Holdings LLC*, 67 F. Supp. 3d 599, 606 (S.D. N.Y. 2014) (using the *Rogers* analysis and dismissing false endorsement claim under Rule 12(b)(6)).

The *Rogers* test was a sea change in how courts treat Lanham Act infringement claims involving expressive works. Before the *Rogers* test became the governing standard in such cases, courts analyzed whether an expressive use of a trademark was infringing under the traditional likelihood-of-confusion test. See, e.g., *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403-04 (9th Cir. 1997). The circuit courts now use the *Rogers* test “as a rule of construction to avoid conflict between the Constitution and the Lanham Act.” *Gordon*, 909 F.3d at 264.

When presented with the opportunity, every circuit court has adopted or endorsed the *Rogers* test to determine infringement in cases involving expressive works. “The Second Circuit’s *Rogers* balancing test is now widely used by almost all courts.” 6 *McCarthy on Trademarks and Unfair Competition* § 31:144.50 (collecting cases). “No courts have rejected the *Rogers* test.” 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, 834-35 (2019).

The Fifth Circuit adopted the *Rogers* test in *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000). In evaluating a claim for infringement against the publisher of a lifestyle magazine, the Fifth Circuit agreed with the Second Circuit that there is a “tension between the protection afforded by the Lanham Act to trademark owners and the protection afforded by the First Amendment to expressive activity.” *Id.* at 664. The court “adopted the Second Circuit’s approach” (i.e., the *Rogers* test) for resolving that tension. *Id.* at 664-65 (quoting *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (quoting *Rogers*, 875 F.2d at 999)).

The *Rogers* analysis was followed in *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 339 (E.D. Pa. 1996), which the Third Circuit affirmed without opinion, 156 F.3d 1225 (3d Cir. 1998) (mem.); see also *Hidden City Philadelphia v. ABC, Inc.*, Civ. No. 18-65, 2019 WL 1003637, at *3 (E.D. Pa. Mar. 1, 2019) (applying *Rogers* to dismiss state-law claim of trademark infringement against expressive use of title of video website).³

3. In *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008), the Third Circuit decided not to apply the *Rogers* test because it held the alleged infringement was not protected expression. Nevertheless, the court ruled for the defendant, overturning summary judgment for the plaintiff on the traditional factors and remanding for trial. *Id.* at 1024-25.

The Ninth Circuit first adopted the *Rogers* test in 2002 in *Mattel, Inc. v. MCA Records*, which involved trademark dilution and infringement claims based on the music band Aqua's commercially successful parody song *Barbie Girl*. Applying *Rogers* to the parody song, the Ninth Circuit concluded "that MCA's use of Barbie is not an infringement of Mattel's trademark." 296 F.3d at 902. The Ninth Circuit later applied the *Rogers* test to another parodic use of Barbie in *Mattel, Inc. v. Walking Mountain Products*, 353 F.3d 792, 801 (9th Cir. 2003), which concerned postcards sold for profit that bore parodic photographs depicting the famous doll. The court affirmed summary judgment for the parodist because his use was artistically relevant to his "parodic message," and the photographs did "not explicitly mislead as to Mattel's sponsorship of the works." *Id.* at 807.

The year after the Ninth Circuit adopted the *Rogers* test, the Sixth Circuit followed suit. *Parks v. LaFace Records*, 329 F.3d 437, 450 (6th Cir. 2003) (holding that the likelihood-of-confusion and "alternative means" tests do not give sufficient weight to the public interest in freedom of expression). Then, in *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915, 936-37 (6th Cir. 2003), the Sixth Circuit applied the *Rogers* test to the use of a Tiger Woods' likeness in a painting of Woods at The Masters golf tournament. The court held that even though "[s]ixty-two percent" of survey respondents indicated they thought Woods was affiliated or connected with, approved, or sponsored the painting, *id.* at 937 n.19, "[t]he risk of misunderstanding, not engendered by any explicit indication on the face of the print, is so outweighed by the interest in artistic expression as to preclude application of the [Lanham] Act," *id.* at 937.

Although the Seventh Circuit has not expressly adopted the *Rogers* test, it affirmed a district court decision that dismissed a claim for infringement and held that even if the plaintiff could demonstrate that the use constituted “actionable trademark infringement, it is protected by the First Amendment under *Rogers*.” *Fortres Grand Corp. v. Warner Bros. Entm’t Inc.*, 947 F. Supp. 2d 922, 931-32 (N.D. Ind. 2013) (“The [*Rogers* test] is one of the beacons used to navigate the murky boundary between trademark law and the First Amendment.”), *aff’d on other grounds*, 763 F.3d 696 (7th Cir. 2014).

The Eleventh Circuit adopted the *Rogers* test in *University of Alabama Board of Trustees v. New Life Art, Inc.*, 683 F.3d 1266 (11th Cir. 2012), stating that “we have no hesitation in joining our sister circuits by holding that we should construe the Lanham Act narrowly when deciding whether an artistically expressive work infringes a trademark.” *Id.* at 1278. The court held that “[a]n artistically expressive use of a trademark will not violate the Lanham Act ‘unless the use of the mark has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless it explicitly misleads as to the source or the content of the work.’” *Id.* at 1278 (quoting *E.S.S. Ent’m’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008), and citing *Rogers*, 875 F.2d at 999).

The one-directional trend in the circuit courts in favor of *Rogers* continues. The Fourth Circuit recently endorsed *Rogers* in *Radiance Foundation, Inc. v. N.A.A.C.P.*, 786 F.3d 316 (4th Cir. 2015). As noted above, that court had previously used the traditional analysis to reject an infringement claim based on a parody dog toy. *Haute Diggity Dog*, 507 F.3d at 268-69.

In short, there is no disagreement on the central question at issue in this case: the standard that governs analysis of Lanham Act infringement claims involving expressive works.

C. Petitioner’s cases do not represent a circuit split.

Petitioner’s claim that there is a circuit split, like its incredible suggestion that the majority of circuits continue to apply the traditional likelihood-of-confusion analysis to expressive works, is simply untrue. The framework Petitioner cites as the “majority” approach to infringement claims regarding expressive uses is the outdated approach that antedates the widespread adoption of the *Rogers* test. Indeed, it is the very approach the courts have rejected in favor of *Rogers* precisely because that approach “fails to account for the full weight of the public’s interest in free expression.” *MCA Records*, 296 F.3d at 900.

As evidence of a putative intercircuit conflict, Petitioner presents a grand total of five circuit cases, but either they were decided before the widespread adoption of the *Rogers* test, or the issue of its applicability was not raised by the parties or addressed by the courts.

To begin, both *Mutual of Omaha Insurance Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987), and *Jordache Enterprises, Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987), predate *Rogers*, and their use of a different analytical approach cannot reflect a circuit split. Moreover, the so-called “alternative means” test employed by *Novak* has been discredited in favor of the *Rogers* approach, and it was in fact rejected by *Rogers* itself. 875 F.2d at

998; *see also Parks*, 329 F.3d at 448-49, 450 (6th Cir.) (“reject[ing] the alternative avenues test” because it does not “accord[] adequate weight to the First Amendment interests”); *Westchester Media*, 214 F.3d at 672 n.18 (5th Cir.) (explicitly rejecting *Novak*’s “alternative means test”).

Although both were decided after *Rogers*, neither *Nike, Inc. v. “Just Did It” Enterprises*, 6 F.3d 1225 (7th Cir. 1993), nor *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806 (2d Cir. 1999), addressed whether the *Rogers* test should be applied. In fact, in *Nike*, the defense argued that “a totality of the circumstances test” applied. 6 F.3d at 1228 n.3. For this reason alone, those cases provide no support for Petitioner’s suggested precedential circuit split. *Cf. United States v. L.A. Tucker Truck Lines, Inc.*, 344 U.S. 33, 38 (1952) (issue not “raised in briefs or argument nor discussed in the opinion of the Court” cannot be taken as “a binding precedent on th[e] point”); *Webster v. Fall*, 266 U.S. 507, 511 (1925) (“Questions which merely lurk in the record, neither brought to the attention of the court nor ruled upon, are not considered as having been so decided as to constitute precedents.”).

Similarly, in *Elvis Presley Enterprises, Inc. v. Capece*, 141 F.3d 188 (5th Cir. 1998), the Fifth Circuit did not consider application of *Rogers* or the defendants’ First Amendment defense at all because it was not properly raised on appeal. *Id.* at 193 n.2. At any rate, two years later the Fifth Circuit adopted the *Rogers* test in *Westchester Media*. 214 F.3d at 664-65.

Simply put, and as demonstrated by Petitioner's cited cases, there is no circuit split to resolve. Every circuit court to consider the issue has either adopted or endorsed *Rogers* and no circuit court has rejected it.

D. The interlocutory posture of the case weighs against granting certiorari.

Even if there were a difference of opinion among the courts of appeals, this appeal does not present an appropriate circumstance in which to address it. The Ninth Circuit vacated the trial court's final judgment and remanded for further proceedings, specifically, to apply the *Rogers* test in the first instance. For this reason, no other aspect of the *Rogers* test, other than the threshold requirement for its application, is before this Court. It is well settled that this Court will not grant certiorari or otherwise consider issues that were not pressed before or considered by the court of appeals. *See Pa. Dep't of Corr. v. Yeskey*, 524 U.S. 206, 212–13 (1998) (“Where issues are neither raised before nor considered by the Court of Appeals, this Court will not ordinarily consider them.” (quotation omitted)); *Meyer v. Holley*, 537 U.S. 280, 291 (2003) (“[I]n the absence of consideration of that matter by the Court of Appeals, we shall not consider it.”)

Although this case does not present any question meriting this Court's review, even if it did, there are no extraordinary circumstances that warrant failing to wait for entry of a final judgment. *See Va. Military Inst. v. United States*, 508 U.S. 946, 113 S. Ct. 2431, 2432 (1993) (Scalia, J., concurring) (“We generally await final judgment in the lower courts before exercising our certiorari jurisdiction.”); *Mount Soledad Mem'l Ass'n v.*

Trunk, 567 U.S. 944, 132 S. Ct. 2535, 2536 (2012) (Alito, J., concurring) (“Because no final judgment has been rendered ... I agree with the Court’s decision to deny the petitions for certiorari.”). The petition should be denied for this reason alone.

E. The Ninth Circuit correctly held that *Rogers* applies.

Because there is no circuit conflict on the applicable *legal* standard, it appears that Petitioner’s real complaint is that it doesn’t appreciate the Ninth Circuit’s applying that standard to a parodic dog toy that makes light of Petitioner’s iconic brand. However, disagreeing with the application of a legal standard to particular facts does not create a conflict worthy of certiorari. And here, Petitioner does not even show a similar case in which a court of appeals refused to apply *Rogers* to a similarly parodic item. Moreover, the Ninth Circuit’s ruling below is manifestly correct.

The unanimous Ninth Circuit panel scrupulously followed settled precedent in holding that the Bad Spaniels parody dog toy constitutes First Amendment expression. *See* Section I.A., *supra*. Under uniform precedent, that holding mandates that the *Rogers* test applies. *See, e.g., Empire Distrib.*, 875 F.3d at 1198 (explaining that “the only threshold requirement for the *Rogers* test is an attempt to apply the Lanham Act to First Amendment expression”). The courts are virtually unanimous in holding that, in the expressive context, *Rogers* must be applied “as a rule of construction to avoid conflict between the Constitution and the Lanham Act.” *Gordon*, 897 F.3d at 1190.

Petitioner argues the opposite, contending that the Lanham Act’s statutory language mandates using the traditional likelihood-of-confusion test in every case of infringement, even those involving expressive uses. In Petitioner’s view, under the statute, “liability flows from a likelihood of confusion,” such language precludes the *Rogers* approach. Pet. at 31. Petitioner is incorrect.

What Petitioner fails to recognize is that the *Rogers* approach, like the traditional approach, is an interpretation of when the use of a mark in an expressive work is “likely to cause confusion.” 15 U.S.C. § 1125(a)(1)(A). The *Rogers* approach is simply a recognition that different considerations come into play when assessing likelihood of confusion in the context of an expressive work. This is also why Petitioner’s characterization of the *Rogers* approach as a judicial exception that “clashes with the Lanham Act’s structure” also misses the mark. Pet. at 31. Congress did not need to make an exception to trademark infringement liability under 15 U.S.C. § 1125(a) because the *Rogers* test is simply an interpretation of subsection 1125(a) in the context of expressive works.

The Lanham Act does not furnish any particular formula for evaluating whether the use of a mark is “likely to cause confusion.” 15 U.S.C. § 1125(a)(1)(A). The circuit courts have evolved various sets of factors to consider in determining whether confusion is likely in a typical case of related, purely commercial products. *Compare Sleekcraft*, 599 at 348-49 (listing Ninth Circuit factors), *with Polaroid*, 287 F.2d at 495 (listing Second Circuit factors). Even these various “catalogue[s]” of factors do “not exhaust the possibilities—the court may have to take still other variables into account.” *Polaroid*, 287 F.2d at

495; see *Sleekcraft*, 599 F.2d at 348 n.11 (“The list is not exhaustive. Other variables may come into play depending on the particular facts presented.”).

These “traditional” factors have their “origin in cases of purely commercial exploitation.” *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 495 n.3 (2d Cir. 1989). In the purely commercial context, there are no countervailing First Amendment interests to consider. But “when a trademark owner claims that an expressive work infringes on its trademark rights,” those countervailing First Amendment interests must be taken into account. *Gordon*, 909 F.3d at 260-61. Courts “use the *Rogers* test to balance th[ose] competing interests.” *Id.* And they do so because, as the courts have repeatedly explained, the traditional factors are “at best awkward in the context of parody” and “artistic expression.” *Cliff Notes*, 886 F.2d at 495 n.3.

The use of the *Rogers* test “as a rule of construction to avoid conflict between the Constitution and the Lanham Act,” *Gordon*, 909 F.3d at 264, is warranted by the bedrock principle that statutes should be construed, when fairly possible, to avoid constitutional difficulties. *Nw. Austin Mun. Util. Dist. No. 1 v. Holder*, 557 U.S. 193, 205 (2009); cf. *Matal v. Tam*, 137 S. Ct. 1744 (2017) (invalidating separate provision of Lanham Act for impinging on free expression); *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) (same).

Petitioner and amici curiae disagree with the *Rogers* approach (but do not cite a single case that agrees with them) because it does not permit them to stifle criticism either outright or through expensive, speech-chilling

litigation. *See e.g., Novalogic, Inc. v. Activision Blizzard*, 41 F. Supp. 3d 885, 900 (C.D. Cal. 2013) (“The *Rogers* test is relatively straightforward to apply and is very protective of speech.”). But that is precisely what the First Amendment requires in the context of protected expression: clear rules regarding any boundaries on protected speech, not the ad hoc, discretionary weighing of factors fostered by the traditional approach. As this Court explained in a different First Amendment context, to avoid “chilling speech through the threat of burdensome litigation,” First Amendment standards “must eschew the open-ended rough-and-tumble of factors, which invites complex argument in a trial court and a virtually inevitable appeal. In short, it must give the benefit of any doubt to protecting rather than stifling speech.” *Fed. Election Comm’n v. Wis. Right to Life, Inc.*, 551 U.S. 449, 469 (2007) (citations and quotations omitted).

Congress and the courts have struck the proper balance between trademark rights and First Amendment rights. Petitioner is simply unhappy with that balance because it does not permit it “to control public discourse” about its trademark. *MCA Records*, 296 F.3d at 900.

II. The Ninth Circuit Correctly Interpreted and Applied the TDRA as Required by the First Amendment, and Consistently with Existing Law.

Petitioner accuses the Ninth Circuit of “adopting” a “broad reading of” the TDRA’s statutory “noncommercial use” exception, suggesting that no other circuit would find the Bad Spaniels expressive parody a “noncommercial use.” Pet. at 24. That is at best the prediction of a *future* circuit conflict, which militates against grant of certiorari

at this time. In any event, Petitioner is simply incorrect. The Ninth Circuit did not “adopt” a definition of commercial use; it properly applied this Court’s commercial-speech doctrine to the speech at issue and correctly held an obvious parody to be fully protected, noncommercial speech such that the TDRA’s noncommercial-use exception applied.

A. The TDRA may not regulate a work of creative expression, which is fully protected, noncommercial speech.

The TDRA “provides three broad, overlapping categories within which any use of a famous mark, even if likely to cause harm or blurring, is not actionable: fair use; news reporting and news commentary; and noncommercial use.” *Radiance Found.*, 786 F.3d at 330 (citing 15 U.S.C. § 1125(c)(3) and holding that the noncommercial-use exemption precluded the NAACP’s dilution-by-tarnishment claim even though it made a *prima facie* showing of dilution).⁴

To determine whether the alleged dilutive use falls within the noncommercial-use exemption, the courts, including the Ninth Circuit, uniformly apply this Court’s commercial-speech doctrine. *See, e.g., Radiance Found.*, 786 F.3d at 331 (“The term ‘noncommercial’ refers to the First Amendment commercial speech doctrine.”). And contrary to Petitioner’s contention, the courts decide this

4. The 2006 version of the TDRA defines in Lanham Act § 43(c)(3)(C) a defense exempting from liability “[a]ny noncommercial use of a mark.” This exemption is identical to an exception in the 1996 Federal Trademark Dilution Act, but for the inclusion in the 2006 version of the determiner “any.”

legal issue as a matter of law. *See, e.g., Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 65 (1983) (“[W]e must first determine the proper classification of the [speech] at issue here.”); *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 515 (7th Cir. 2014) (“classifying [speech] as commercial or noncommercial speech for constitutional purposes ... is a legal question”).

In its seminal 2002 decision in *Mattel, Inc. v. MCA Records*, 296 F.3d at 903, the Ninth Circuit took a deep dive into the legislative history behind the noncommercial-use exception and found that “the exemption for noncommercial speech is used as a somewhat inexact, shorthand reference to ‘speech protected by the First Amendment.’” *Sporting Times, LLC v. Orion Pictures Corp.*, 291 F. Supp. 3d 817, 826-27 (W.D. Ky. 2017) (quoting and finding “the noncommercial use exemption reasoning of *Mattel* persuasive,” and dismissing the “dilution claim [as] meritless” under that rubric).

Stated somewhat differently, the “[l]egislative history indicates that Congress intended the noncommercial exemption to ... incorporate the Supreme Court’s concept of ‘commercial speech.’” 4 *McCarthy on Trademarks and Unfair Competition* § 24:128. Accordingly, in *MCA Records*, the Ninth Circuit held that “[t]o determine whether [the speech at issue] falls within this exemption, we look to our definition of commercial speech under our First Amendment caselaw.” 296 F.3d at 906.

Contrary to Petitioner’s contention, this approach is not at odds with the Fourth Circuit’s approach. *See Radiance Found.*, 786 F.3d at 331 (“The term ‘noncommercial’ refers to the First Amendment commercial speech doctrine.”).

Indeed, courts uniformly use this Court’s commercial-speech doctrine to determine whether the speech at issue falls within the TDRA’s statutory noncommercial-use exemption. *See also Chooseco LLC v. Netflix, Inc.*, 439 F. Supp. 3d 308, 324 (D. Vt. 2020) (“This [i.e., the noncommercial-use] ‘exemption incorporates the concept of commercial speech from the commercial speech doctrine.’”) (quoting *MCA Records; Liberty Counsel, Inc. v. Guidestar USA, Inc.*, No. 4:17CV71, 2018 WL 10323724, at *3 (E.D. Va. Jan. 23, 2018) (“The term ‘noncommercial’ refers to the First Amendment commercial speech doctrine.”) (quoting *Radiance Found.*, 786 F.3d at 331), *aff’d*, 737 F. App’x 171 (4th Cir. 2018).

B. The Bad Spaniels parody dog toy is fully protected, noncommercial speech.

There is no question that the Bad Spaniels parody dog toy constitutes noncommercial speech under this Court’s commercial-speech doctrine. As this Court has held, “[p]arody is a form of noncommercial expression if it does more than propose a commercial transaction.” *Bolger*, 463 U.S. at 66-67 (1983) (finding that speech does not become “commercial” simply because the author had economic motivation). Entirely consistent with this Court’s definition, the Ninth Circuit held that the Bad Spaniels Silly Squeaker does more than propose a commercial transaction—it communicates a humorous parody—and therefore is not commercial speech. 953 F.3d at 1176. That holding is unassailable.

Petitioner’s suggestion that Bad Spaniels would be deemed commercial speech under the Fourth Circuit’s three-part *Bolger* analysis (or that the Ninth Circuit does

not use that analysis to aid in determining the issue) is simply incorrect. First, the Ninth Circuit does use the *Bolger* analysis in cases that present “close questions,” *Dex Media W., Inc. v. City of Seattle*, 696 F.3d 952, 958 (9th Cir. 2012) (quoting *Hunt v. City of Los Angeles*, 638 F.3d 703, 715 (9th Cir. 2011)), which this case decidedly is not.

Second, the Bad Spaniels parody dog toy does not qualify as commercial speech under the factors identified in *Bolger*. As the Ninth Circuit has applied this Court’s decision, “[t]he factors identified in *Bolger* include ‘three characteristics which, in combination, support[]’ a conclusion that the document ‘at issue constitute[s] commercial speech, including (i) their advertising format, (ii) their reference to a specific product, and (iii) the underlying economic motive of the speaker.’” *Dex Media*, 696 F.3d at 958 (quotation omitted).

The Bad Spaniels parody dog toy is not an advertisement; it does “not advertis[e] [another] product; it is the product.” *Hilton v. Hallmark Cards*, 599 F.3d 894, 905 n.7 (9th Cir. 2010); see also *Am. Acad. of Pain Mgmt. v. Joseph*, 353 F.3d 1099, 1106 (9th Cir. 2004) (first *Bolger* factor met only if “the speech is admittedly advertising”). Nor does Bad Spaniels reference a product; again, it *is* the product. See *Hilton*, 599 F.3d at 905 n.7. In short, “[e]ven the most cursory examination of [Bad Spaniels] reveals that it is not ‘concededly an advertisement’ and ... it does not refer to a specific product.” *Dex Media*, 696 F.3d at 959. VIP is not offering or selling bottles of anything, much less bottles of “Old No. 2” that contain “43% POO BY VOL.”

That leaves the final factor, economic motivation. Respondent did want to sell Bad Spaniels (as do most, if not all, artists and parodists⁵), but “the fact that [VIP] has an economic motivation for [creating Bad Spaniels] would clearly be insufficient by itself to turn [it] into commercial speech.” *Bolger*, 463 U.S. at 67 (citing *Bigelow v. Virginia*, 421 U.S. 809, 818 (1975)).

There is simply no merit in Petitioner’s contention that there is a conflict in how courts determine whether the TDRA’s noncommercial-use exemption applies, or that the issue would have been decided differently under the Fourth Circuit’s *Bolger* analysis. In fact, in the principal case championed by Petitioner on this issue, the Fourth Circuit not only affirmed dismissal of the dilution claim there, but recognized more broadly that “[t]rademark law in general and dilution in particular are not proper vehicles for combatting speech with which one does not agree. Trademarks do not give their holders under the rubric of dilution the rights to stymie criticism.” *Radiance Found.*, 786 F.3d at 332. The court continued:

Criticism of large and powerful entities in particular is vital to the democratic function....

5. Cases applying *Rogers* to parody products routinely (if not always) involve commercial products sold for a profit. *See, e.g., MCA Records*, 296 F.3d at 903 (finding “[t]hat is precisely what MCA did with the Barbie mark: It created and sold to consumers in the marketplace commercial products (the Barbie Girl single and the Aquarium album) that bear the Barbie mark.”); *Walking Mountain*, 353 F.3d at 797, 803 (finding that the “‘Food Chain Barbie’ series earned [the parodist] income” and that the parodist “had a commercial expectation and presumably hoped to find a market for his art”).

The article in this case was harsh. But that did not forfeit its author's First Amendment liberties. The most scathing speech and the most disputable commentary are also the ones most likely to draw their intended targets' ire and thereby attract Lanham Act litigation. It is for this reason that law does not leave such speech without protection.

Id.

Petitioner attempts to distinguish *Radiance Foundation* on the basis that the speech there involved social criticism, but it fails to acknowledge that “[p]arody is regarded as a form of social and literary criticism, having a socially significant value as free speech under the First Amendment.” *Dr. Seuss*, 109 F.3d at 1400 (9th Cir.); *see also Cliffs Notes*, 886 F.2d at 493 (2d Cir.) (“parody and satire are deserving of substantial freedom—both as entertainment and as a form of social and literary criticism”). “Parody is a humorous form of social commentary and literary criticism that dates back as far as Greek antiquity.” *L.L. Bean*, 811 F.2d at 28 (1st Cir.). And at least since the advent of “Wacky Packages” stickers in the 1960s, parodying famous brands has been part of American culture.

Simply put, there is no reason to anticipate that any other circuit would disagree with the Ninth Circuit's conclusion here.

C. The TDRA’s noncommercial-use exception is an independent statutory basis for protecting expression.

Petitioner also contends that the Ninth Circuit’s application of the TDRA’s statutory noncommercial-use exception under 15 U.S.C. § 1125(c)(3)(C) without also requiring satisfaction of the statutory fair-use defense under 15 U.S.C. § 1125(c)(3)(A) is error and conflicts with other circuit’s authority. Pet. at 25-26. That argument misstates the law. As the Ninth Circuit explained in its detailed explanation of the TDRA’s legislative history in *MCA Records*, the statute contains “three statutory exemptions [for] uses that, though potentially dilutive, are nevertheless permitted: comparative advertising; news reporting and commentary; and noncommercial use.” 296 F.3d at 904. As the statute’s plain language and the cases construing it make clear, these defenses can be asserted in the alternative (as Respondent did below), and the failure to satisfy the requirements of one defense does not preclude application of another. *See, e.g., MCA Records*, 296 F.3d at 904 (holding “[t]he first two exemptions clearly do not apply” but the noncommercial-use exemption did).

The Ninth Circuit explained in *MCA Records* that the statutory noncommercial-use exception contained in 15 U.S.C. § 1125(c)(3)(C) allays First Amendment concerns not addressed by the statutory defenses contained in 15 U.S.C. § 1125(c)(3)(A) and (B). 296 F.3d at 906 (“the bill’s sponsors relied on the ‘noncommercial use’ exemption to allay First Amendment concerns”). The three statutory defenses overlap to ensure robust First Amendment protection:

[T]he overlap of exemptions represents a sort of overabundance of caution to statutorily provide for free speech concerns that the federal anti-dilution law would be used to silence “noncommercial” critics who use the famous marks of companies whose goods, services or policies were being criticized or mocked.

4 *McCarthy on Trademarks and Unfair Competition* § 24:128; see also *Radiance Found.*, 786 F.3d at 330 (explaining that “[t]he law provides three broad, overlapping categories within which any use of a famous mark, even if likely to cause harm or blurring, is not actionable,” and holding that the exemption precluded the dilution claim despite evidence of dilution). For example, McCarthy notes that though an allegedly dilutive use does not fall within the statutory fair-use exception, “[e]ven if the accused use is a trademark use, a parody can still be immune under free speech principles from liability for dilution by tarnishment.” 4 *McCarthy on Trademarks and Unfair Competition* § 24:90 (collecting cases).

D. Petitioner’s cases do not represent a circuit split.

Petitioner struggles to identify a circuit split under the TDRA, and it ultimately cites a grand total of two circuit cases that it argues reflect a conflict. But neither of those cases stand for the proposition that failure to satisfy the statutory fair-use defense under 15 U.S.C. § 1125(c)(3)(A) precludes the court from applying the noncommercial-use exception in 15 U.S.C. § 1125(c)(3)(C). In *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 113 (2d Cir. 2009), the court considered only the fair-use defense under

15 U.S.C. § 1125(c)(3)(A) and never addressed whether the noncommercial-use exception in 15 U.S.C. § 1125(c)(3)(C) applied in that case. The same thing happened in *Haute Diggity Dog*—the Fourth Circuit never addressed whether the noncommercial-use exception applied in that case. 507 F.3d at 266.

There is no intercircuit conflict for this Court to resolve on this or any of the issues presented for review.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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