

No. 22-148

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

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INTEREST OF *AMICUS CURIAE*¹

Campbell Soup Company is a 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 n.2 (9th Cir. 2017) (“Campbell’s is an iconic soup brand”).

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

Campbell Soup regards its trademarks and trade dresses—and robust legal protection of them—as essential 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.

¹ 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. Recent developments confirm 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, and statutory text plainly provides, 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 particularly problematic.

First, contrary to every other court of appeals, the Ninth Circuit in this case held that trademark owners/plaintiffs are subject to a “heightened burden” under the Lanham Act whenever a defendant uses the plaintiff’s mark to sell a commercial product and communicates a humorous message in the process. To establish liability under the Lanham Act, a plaintiff typically must show a likelihood of confusion from the defendant’s use of the mark. See 15 U.S.C. §§ 1114(1)(a), 1125(a)(1)(A). In the context of a humorous message, however, the court of appeals held that the product should be deemed an “expressive work” entitled to special protection under the First Amendment. In those cases, the Ninth Circuit held, the owner must do more than make a strong showing of consumer confusion: the owner must carry the heavier burden set out in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), and demonstrate 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. 30a (quotation marks omitted). Because Ninth Circuit law makes it extremely difficult to make either showing, see Pet. App. 18a–19a, the decision below in effect dooms Lanham Act claims whenever a defendant purports to use humor in copying a plaintiffs’ mark.

Second, the Ninth Circuit shut the door on claims of trademark dilution by tarnishment under the TDRA in cases involving commercial products that purport to send a humorous message. Congress in the TDRA expressly 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. 33a–34a. Under the Ninth Circuit’s equation, *commercial use + humor = noncommercial use*.

The issues in this litigation are very important to mark owners, including Campbell Soup Company. This case involves a dog toy that looks like a Jack Daniel’s bottle. The dog toy may be intended to be funny, but the trademark issues it raises are no laughing matter. The dog toy is, first and foremost, a commercial product that VIP Products deliberately designed to trade on Jack Daniel’s famous whiskey trademarks and trade dress. Evidence at trial showed that 29% of those surveyed mistakenly believed that Jack Daniel’s was associated with the toy. See Pet. App. 67a–68a. But the Ninth Circuit gave

VIP a free pass to infringe 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 these Lanham Act plaintiffs—requiring them to show that the use of their mark is not artistically relevant to the infringing 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. That decision allows the exception to swallow

the rule. This Court should grant certiorari and reverse the decision below.

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 Ninth Circuit also held 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 immunity from TDRA dilution claims—just because they are meant to be funny.

A. Consumers and Companies Depend on the Trademark Protection Provided by the Lanham Act.

1. The Lanham Act serves several important purposes in protecting registered trademarks. To begin, there is no question that trademarks and trade dresses help consumers make informed choices. These marks 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”). In addition, trademarks benefit consumers because they “foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.” *Id.*

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. For this reason, Campbell Soup—like many other companies that use trademarks and trade dresses to market their products—is vigilant about protecting its trademark and trade dress rights from affront. See, e.g., *CSC Brands LP v. Chicken Soup for the Soul Publ’g, LLC*, No. 1:12-cv-06569-JEI-KMW (D.N.J.) (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).

2. As the owner of iconic marks, Campbell Soup has confronted countless 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).

In *Grey*, for example, the maker of “DOGIVA” dog biscuits and a “CATIVA” product for cats sued Campbell Soup in federal district court in California seeking declaratory relief.² Campbell Soup, which at

² 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 makes the Ninth Circuit even more attractive to potential Lanham Act defendants shopping for a favorable forum and will allow those infringers to avoid the plain text of the statute applied by the other circuits. See generally *Diece-Lisa Indus., Inc. v. Disney Store USA, L.L.C.*, No. 2:12-cv-00400-RWS-RSP, 2020 WL 1332881, at *1 (E.D. Tex. Mar. 23, 2020) (granting defendants’ motion to

that time owned the GODIVA® trademark used in marketing chocolates, 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 were litigated today, Grey would undoubtedly argue that DOGIVA was intended to be a humorous commentary on the GODIVA® brand and thus was an expressive work, and Ninth Circuit precedent would require the district court to impose 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

transfer case for trial from Texas to California); *Diece-Lisa Indus., Inc. v. Disney Store USA, LLC*, No. 21-55816, 2022 WL 2072727, at *1 (9th Cir. June 9, 2022) (citing decision below and affirming dismissal of trademark claims).

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 significant food safety concerns. 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 a purportedly comedic intent.

Campbell Soup also had to send cease-and-desist letters to halt third party sales of Goldfish-shaped marijuana edibles and edibles that otherwise leveraged the GOLDFISH® trademarks and trade dress. Products containing marijuana often use silly humor in their marketing. That poses a real threat both to owners' marks and the safety of consumers (particularly children), who may be confused by packaging that mimics their favorite snacks. See Pet. 28. It would be very dangerous if the Ninth Circuit's decision allowed the purveyors of such products to claim an entitlement to heightened protection against Lanham Act claims.

Furthermore, Campbell Soup has seen its share of infringing dog toys over the years.³ Examples include a chew toy designed to look like a bag of KETTLE BRAND® potato chips. The dog toy used the words "Kennel Brand Doggie Chips" and "Spicy Bark." 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.

³ There is a huge market for such pet-related infringement. According to a survey conducted by the American Pet Products Association, seventy percent of American households, or about 90.5 million families, own a pet. See Ins. Info. Inst., Facts + Statistics: Pet Ownership and Insurance, <https://tinyurl.com/438znrud> (last visited Sept. 10, 2022). Sixty-nine million of those households own dogs. *Id.*

3. In short, although the instant case involves a chew toy for dogs, the trademark issues raised here frequently arise in litigation involving a variety of purportedly humorous commercial products. The petition for certiorari cites conflicting decisions of the Second, Fourth, Fifth, Seventh, Eighth, and Tenth Circuits, each of which offer trademark owners significantly more protection than the court below. See Pet. 18–24. 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 additional 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); *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 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 Prods., 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 Prods., 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 Poppingnon” 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. Although one might question how one naughty spaniel could befoul so much legal ground, 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). The Ninth Circuit’s decision here rewrote the Lanham Act to remove its bite for trademark infringers. This Court should grant review to restore the protections Congress provided for trademark owners and consumers alike.

B. The Decision Below Is Already Wreaking Havoc on Trademark and Consumer Protection Under Federal and State Law.

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” to prove 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.

That standard has no basis in the statutory text and has proven problematic even in the short time since it was issued. In *Dr. Seuss Enterprises, LP v. COMICMIX LLC*, 983 F.3d 443, 461–462 (9th Cir. 2020), *cert. denied*, 141 S. Ct. 2803 (2021), for example, another panel of the court of appeals cited this case in applying the *Rogers* framework to dismiss a Lanham Act claim against a book that essentially copied *Oh, the Places You’ll Go!*. *Id.* at 462. The court did so despite evidence of consumer confusion, and even though the book “uses the Seussian font in the cover, the Seussian style of illustrations, and even a title that adds just one word—Boldly—to the famous title.” *Id.* See also *Diece-Lisa Indus., Inc. v. Disney Store USA, LLC*, No. 21-55816, 2022 WL 2072727, at *1 (9th Cir. June 9, 2022) (citing decision below, affirming dismissal of trademark claims, and rejecting request that court hear case initially en banc so it “can reconsider its use of the *Rogers* test”).

Lower courts in the Ninth Circuit have had no choice but to apply the same analysis. See Pet. App. 19a (explaining that court was “bound by Ninth Circuit precedent”); *Punchbowl, Inc. v. AJ Press LLC*, 549 F. Supp. 3d 1061, 1064–1073 (C.D. Cal. 2021) (citing this case and applying *Rogers* test to grant summary judgment that defendant “Punchbowl News” did not infringe trademark of plaintiff “Punchbowl”); *Miller v. Easy Day Studios Pty Ltd.*, No. 20CV02187-LAB-DEB, 2021 WL 4209205, at *1–10 (S.D. Cal. Sept. 16, 2021) (citing this case and ap-

plying *Rogers* test to grant motion to dismiss Lanham Act claim raised by skateboarder whose likeness was used in defendant's video game).

The Ninth Circuit's mistakes have also reached beyond federal law. That court of appeals "has consistently held that state common law claims of unfair competition and actions pursuant to California Business and Professions Code § 17200 are 'substantially congruent' to claims made under the Lanham Act," and accordingly applies the same test to analyze all of those claims. *Cleary v. News Corp.*, 30 F.3d 1255, 1262–1263 (9th Cir. 1994). See *Betty's Found. for Elimination of Alzheimer's Disease v. Trinity Christian Ctr. of Santa Ana, Inc.*, No. SACV 20-02146-CJC, 2021 WL 3046889, at *2 n. 2 (C.D. Cal. Apr. 7, 2021) ("Because state common law claims of unfair competition and actions pursuant to [California's Unfair Competition Law] are substantially congruent to claims made under the Lanham Act, the Court considers Plaintiff's first five claims under the same standard." (internal quotation marks omitted)), *aff'd*, No. 21-55553, 2022 WL 807391, at *2 (9th Cir. Mar. 16, 2022) (citing decision below and holding "the district court correctly dismissed Betty's Foundation's Lanham Act and state law claims"). The Ninth Circuit's error thus infects federal and state claims alike, despite having no textual basis in any statute.

II. The Ninth Circuit Has Misinterpreted the Constitution to Significantly Undermine the Acts of Congress Protecting Trademark and Trade Dress Rights.

As petitioner correctly explains (Pet. 33–37), nothing in the Lanham Act or the TDRA compels the heightened standard for trademark infringement the Ninth Circuit adopted below. VIP agrees, acknowledging that courts “use the *Rogers* test ‘as a rule of construction to avoid’” a purported “conflict between the Constitution and the Lanham Act.” Br. in Opp’n at 11, *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 141 S. Ct. 1054 (2021) (No. 20-365) (mem.) [hereinafter (No. 20-365)] (quoting *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018)). See *Twentieth Century Fox Television*, 875 F.3d at 1196 n. 1 (“the *Rogers* test is a limiting construction of the Lanham Act” informed by First Amendment considerations). The Ninth Circuit has gone even further, explaining that it uses *Rogers* “to determine *whether* the Lanham Act *applies*” in the first place. *Id.* at 1196 (emphases added). See Pet. App. 30a (“[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, much less to decline to apply the statute at all. And if the judiciary *is* going to rewrite a law of Congress based on alleged First Amendment concerns, that is the precisely type of decision that should be reviewed by this Court. Indeed, “where a federal statute is given an unwarranted construction in order to save

its constitutionality, certiorari is usually granted because of the obvious importance of the case.” S. Shapiro, K. Geller, T. Bishop, E. Hartnett, & D. Himmelfarb, *Supreme Court Practice* § 4.12, p. 4-35 (11th ed. 2019). See generally *United States v. Edge Broad. Co.*, 509 U.S. 418, 425 (1993) (granting certiorari “[b]ecause the court below declared a federal statute unconstitutional and applied reasoning that was questionable under our cases relating to the regulation of commercial speech”).⁴

A. The Ninth Circuit Has Rewritten the Lanham Act to Impose a Heightened Burden with No Basis in the Statutory Text or the Constitution.

1. This Court has made clear that, in a Lanham Act case, a court’s “limited role is to read and apply the law those policymakers have ordained.” *Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S. Ct. 1492, 1497 (2020). The Court has further emphasized that the Act must be interpreted based on “the statute’s lan-

⁴ Even in cases that present such clearly important questions, the Court has occasionally denied certiorari where “the issue was ... not ripe enough.” Shapiro, *supra*, § 4.12, at 4-37 (quoting *Darr v. Burford*, 339 U.S. 200, 227 (1950) (Frankfurter, J., dissenting)). That seems to have been true of the first petition filed in this case, which VIP argued “should be denied for this reason [that the case was interlocutory] alone.” Br. in Opp’n at 18, No. 20-365. Certiorari is plainly warranted now that the district court—along with other panels of the Ninth Circuit—have had the chance to apply the standard adopted below and demonstrate just how flawed it is. See generally *United States v. Virginia*, 518 U.S. 515, 526 (1996) (hearing and deciding case after noting that Court had previously denied certiorari when case was in interlocutory posture).

guage, structure, and history.” *Id.* at 1497. 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”). 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.

In this case, “[o]ne searches the language of the Lanham Act in vain to find any support,” *Park ’N Fly*, 469 U.S. at 196, for the “heightened burden” the Ninth Circuit has imposed. *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018).⁵ The operative language of that 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, as did the court below, 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.

⁵ Given the stringent demands of Ninth Circuit precedent, 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 v. Drape Creative, Inc.*, 909 F. 3d 257, 261 (9th Cir. 2018). 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. *Id.*

2. The Ninth Circuit had 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.

To be sure, 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, [the Court] may adopt it only if [the Court] 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 multiple reasons. First, the Lanham Act is not ambiguous in any relevant respect. The trial court in this case had no trouble applying the statutory likelihood-of-confusion test to evaluate the Lanham Act claims. See Pet. App. 62a–75a. Nor is there any basis for concluding that the *Rogers* test substituted by the Ninth Circuit may be gleaned from the text of the statute.

The relevant provisions of the Lanham Act are, moreover, constitutional. Imposing trademark in-

fringement 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 (Kennedy, J., concurring in part and concurring in the judgment) (“It is well settled” that trademark laws may protect consumers and mark owners from “confusing or misleading” uses). Because the dog toy at issue in this case 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. 67a)—imposing liability under the Lanham Act’s likelihood-of-confusion standard (without the Ninth Circuit’s added *Rogers* burden) raises no First Amendment problem.

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

1. 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 for trademark owners 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”), Pub. L. 104-98, 109 Stat. 985 (1996).⁶ 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.* § 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

⁶ Congress passed the TDRA in response to this Court’s decision in *Moseley v. V Secret Catalogue, Inc.*, 123 S. Ct. 1115 (2003), which 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).

likely confusion, of competition, or of actual economic injury”). The statute thus recognizes that it may, for example, harm a purveyor of fine chocolates to have its products associated with cat and dog food. See *Grey*, 650 F. Supp. at 1175.

An exception in the TDRA provides that certain uses are not actionable as dilution, including “[a]ny noncommercial use of a mark.” 15 U.S.C. § 1125(c)(3)(C). There is also an exception for certain types of “fair use” of a trademark, although the Act explicitly provides that “parod[ies]” remain subject to suit where they use another’s trademark “as a designation of source for the person’s own goods or services.” *Id.* § 1125(c)(3)(A)(ii).

2. Given VIP’s repeated assertions that its dog toy was a “parody” of Jack Daniel’s label, see, *e.g.*, Pet. App. 47a–48a, 69a; Br. in Opp’n at 1, 3, 4 (No. 20-365), there should have been no question that VIP’s toy was subject to suit for dilution under that provision of the TDRA. See Pet. App. 62(a) (original district court decision holding that the toy remained subject to suit as a parody because it used Jack Daniel’s mark for source designation).

Instead, the Ninth Circuit held in this case that the 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. 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 con-

vey a humorous message.” Pet. App. 33a. Using another’s trademark and some dog-related humor to sell a commercial product, the Ninth Circuit declared, “is protected by the First Amendment.” *Id.*

That decision is nonsensical. As an initial matter, the court of appeals failed to explain how the purported use of humor could somehow transform a commercial transaction into a noncommercial one. In addition, the court’s conclusion that any use of humor renders a product noncommercial would render *every* parody a noncommercial use under the statute and thereby render § 1125(c)(3)(A)(ii)—the subsection that authorizes actions against parodies—entirely superfluous. Thus, in cases involving humorous commercial products, the Ninth Circuit reads the exception to swallow the rule.

In sum, the Ninth Circuit has construed 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. That ruling has no basis in the text of the statute. This Court should grant the petition and review the Ninth Circuit’s erroneous construction of the TDRA, which allows the tail to wag the dog.

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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