

No. 22-148

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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 OF AMERICAN INTELLECTUAL  
PROPERTY LAW ASSOCIATION  
AS *AMICUS CURIAE* SUPPORTING  
PETITION FOR WRIT OF CERTIORARI**

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## I

### **QUESTION PRESENTED**

Whether humorous use of another's trademark on a commercial product is subject to the Lanham Act's traditional likelihood-of-confusion analysis, or instead receives heightened First Amendment protection from trademark-infringement claims.

II

TABLE OF CONTENTS

INTEREST OF THE *AMICUS CURIAE*..... 1

SUMMARY OF THE ARGUMENT ..... 2

ARGUMENT..... 4

I. The Ninth Circuit’s Decision Creates a  
Circuit Split on the Scope of Protection  
Afforded by the First Amendment Against  
Lanham Act Claims. .... 4

    A. Courts Have Historically Limited  
    *Rogers’* Framework to Artistic Works..... 5

    B. Misleading Trademark Parodies Used  
    as Trademarks or Trade Dress for  
    Utilitarian Products Should Not  
    Receive Heightened Protection. .... 12

II. Trademark Owners Would Rarely Prevail  
    under the Ninth Circuit’s Approach..... 18

CONCLUSION ..... 22

### III

#### TABLE OF AUTHORITIES

##### Cases

<i>Anheuser-Busch, Inc. v. L. &amp; L. Wings, Inc.</i> , 962 F.2d 316 (4th Cir. 1992) .....	12
<i>Anheuser-Busch, Inc. v. VIP Prod., LLC</i> , 666 F. Supp. 2d 974 (E.D. Mo. 2008) .....	21
<i>Bad Frog Brewery, Inc. v. N.Y. State Liquor Auth.</i> , 134 F.3d 87 (2d Cir. 1998).....	15
<i>Bolger v. Youngs Drug Prod. Corp.</i> , 463 U.S. 60 (1983) .....	3
<i>Brown v. Elec. Arts, Inc.</i> , 724 F.3d 1235 (9th Cir. 2013) .....	20
<i>Brown v. Ent. Merch.'s Ass'n</i> , 564 U.S. 786 (2011) .....	8
<i>Campbell v. Acuff-Rose Music, Inc.</i> , 510 U.S. 569 (1994) .....	12, 17, 18
<i>Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Grp., Inc.</i> , 886 F.2d 490 (2d Cir. 1989).....	10, 13
<i>Deere &amp; Co. v. MTD Prod., Inc.</i> , 41 F.3d 39 (2d Cir. 1994).....	9
<i>Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.</i> , 109 F.3d 1394 (9th Cir. 1997) .....	17
<i>Elvis Presley Enters., Inc. v. Capece</i> , 141 F.3d 188 (5th Cir. 1998) .....	16
<i>ETW Corp. v. Jireh Pub., Inc.</i> , 332 F.3d 915 (6th Cir. 2003) .....	11
<i>Gordon v. Drape Creative, Inc.</i> , 909 F.3d 257 (9th Cir. 2018) .....	19, 20
<i>Grey v. Campbell Soup Co.</i> , 650 F. Supp. 1166 (C.D. Cal. 1986).....	17
<i>Harley-Davidson, Inc. v. Grottanelli</i> , 164 F.3d 806 (2d Cir. 1999).....	passim

IV

*Jordache Enters., Inc. v. Hogg Wyld, Ltd.*,  
828 F.2d 1482 (10th Cir. 1987) ..... 12

*Knauer v. United States*,  
328 U.S. 654 (1946) ..... 20

*L.L. Bean, Inc. v. Drake Publishers, Inc.*,  
811 F.2d 26 (1st Cir. 1987).....17, 18

*Louis Vuitton Malletier S.A. v. Haute Diggity  
Dog, LLC*,  
507 F.3d 252 (4th Cir. 2007) ..... passim

*Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*,  
156 F. Supp. 3d 425 (S.D.N.Y. 2016) .....16, 18

*Lyons P’ship v. Giannoulas*,  
179 F.3d 384 (5th Cir. 1999) ..... 15

*MasterCard Int’l Inc. v. Nader 2000 Primary  
Comm., Inc.*, No. 00-CV-6068,  
2004 WL 434404 (S.D.N.Y. Mar. 8, 2004) ... 12

*Mattel, Inc. v. MCA Recs., Inc.*,  
296 F.3d 894 (9th Cir. 2002) ..... 11

*Nike, Inc. v. Just Did It Enters.*,  
6 F.3d 1225 (7th Cir. 1993) .....12, 15

*Radiance Found., Inc. v. NAACP*,  
786 F.3d 316 (4th Cir. 2015) ..... 11

*Recot, Inc. v. M. C. Becton*,  
56 USPQ2d 1859 (TTAB 2000) ..... 17

*Rogers v. Grimaldi*,  
875 F.2d 994 (2d Cir. 1989)..... passim

*Shady Grove Orthopedic Assocs., P.A. v. Allstate  
Ins. Co.*,  
559 U.S. 393 (2010) ..... 21

*Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*,  
588 F.3d 97 (2d Cir. 2009)..... 16

*Stop the Olympic Prison v. U.S. Olympic Comm.*,  
489 F. Supp. 1112 (S.D.N.Y. 1980) ..... 10

V

*TE-TA-MA Truth Foundation—Family of  
URI, Inc. v. World Church of Creator*,  
297 F.3d 662 (7th Cir. 2002) ..... 9

*Thompson v. Western States Med. Ctr.*,  
535 U.S. 357 (2002) ..... 3

*Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*,  
221 F. Supp. 2d 410 (S.D.N.Y. 2002) ..8, 15, 16

*Twentieth Century Fox Television v. Empire  
Distrib., Inc.*,  
875 F.3d 1192 (9th Cir. 2017) ..... 20

*Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*,  
996 F.2d 1366 (2d Cir. 1993)..... 11

*United We Stand Am., Inc. v. United We Stand, Am.  
New York, Inc.*,  
128 F.3d 86 (2d Cir. 1997)..... 9

*Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*,  
683 F.3d 1266 (11th Cir. 2012) ..... 11

*Wendy’s Int’l, Inc. v. Big Bite, Inc.*,  
576 F. Supp. 816 (S.D. Ohio 1983)..... 16

*Westchester Media v. PRL USA Holdings, Inc.*,  
214 F.3d 658 (5th Cir. 2000) ..... 11

*Yankee Pub. Inc. v. News Am. Pub. Inc.*,  
809 F. Supp. 267 (S.D.N.Y. 1992) ..... 13

**Other Authorities**

J. Thomas McCarthy, McCarthy on Trademarks  
& Unfair Competition (5th ed. 2018).....11, 13

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 (2019) ..... 19

**INTEREST OF THE *AMICUS CURIAE***

*Amicus curiae* American Intellectual Property Law Association (“AIPLA”) submits this brief in support of the grant of certiorari.<sup>1</sup>

AIPLA is a national bar association representing the interests of approximately 7,000 members engaged in private and corporate practice, government service, and academia. AIPLA’s members represent a diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of trademark, copyright, and patent law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. AIPLA’s mission includes providing courts with objective analyses to promote an intellectual property system that stimulates and rewards invention, creativity, and investment while accommodating the public’s interest in healthy competition, reasonable costs, and basic fairness. AIPLA has no stake in any of the parties to this litigation or in the ultimate result of the case. AIPLA’s only interest is in seeking correct and consistent interpretation of the law as it relates to intellectual property issues.

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<sup>1</sup> Under Rule 37.6, AIPLA certifies that no counsel for a party authored this brief in whole or in part and that no person or entity other than AIPLA, its members, and its counsel has made a monetary contribution to the preparation or submission of this brief. *See* Sup. Ct. R. 37.6. All parties received timely notice and provided their written consent to the filing of this amicus brief.

## SUMMARY OF THE ARGUMENT

Sections 32(1) and 43(a) of the Lanham Act regulate the use of trademarks “likely to cause confusion” among consumers. For decades, courts have uniformly understood that the use of misleading trademarks on almost all commercial products may be enjoined under this statutory standard. The Ninth Circuit’s decision below unjustifiably extends a narrow, judicially created exception for artistic works to cases involving ordinary commercial products—like the dog toys in this case—and creates a split among Courts of Appeals.

*Artistic works* like films, paintings, books, and songs are protected speech under the First Amendment. Since the Second Circuit’s landmark decision in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), courts have recognized that titles of artistic works (as well as trademarks used within such works) may be inextricably intertwined with the artistic work. Courts therefore construe the Lanham Act to apply to artistic works and their titles “only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* at 999. Under *Rogers*, the Lanham Act applies to trademarks used for artistic works only if they have “no artistic relevance” to the underlying work or if they are “explicitly misleading” as to its source or content. *Id.* at 999. This heightened standard for liability replaces the statutory “likelihood-of-confusion” standard and “insulates from restriction” trademark infringement in artistic works that is “only implicitly misleading.” *Id.* at 1000.

*Ordinary commercial products*, in contrast, remain subject to the Lanham Act’s statutory standard. *Rogers* defines “ordinary commercial products” or

“utilitarian products” as products that are not inherently protected speech. *See id.* at 997-1000. The First Amendment has never protected “false, deceptive, or misleading” commercial speech, *Bolger v. Youngs Drug Prod. Corp.*, 463 U.S. 60, 69 (1983); *accord Thompson v. Western States Med. Ctr.*, 535 U.S. 357, 367 (2002) (commercial speech that “is misleading ... is not protected by the First Amendment”), and the Lanham Act’s prohibition on misleading trademarks comports with that standard. *Rogers’* limiting construction is meant to apply only in the slim margin of cases where a trademark’s commercial-speech function is “inextricably intertwined” with other protected speech. 875 F.2d at 998. Marks used with ordinary commercial products lack those inseparable “artistic and commercial elements.” *Id.*

The decision below turns *Rogers’* distinction between artistic works and ordinary commercial products on its head. The Ninth Circuit applied *Rogers* to a dog toy based on the incorrect premise that VIP’s use of Jack Daniel’s marks communicates a “humorous message” deserving of First Amendment protection as parody. 953 F.3d 1170, 1175. The court wrongly held “[t]he fact that VIP chose to convey this humorous message through a dog toy is irrelevant.” *Id.* But there is no “humor”-based First Amendment exception for misleading trademarks used on ordinary commercial products. Nor does parody automatically transform an ordinary product into an artistic work entitled to heightened protection under *Rogers*. *See e.g., Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812-13 (2d Cir. 1999). Courts overwhelmingly analyze humorous or parodic uses of marks for ordinary commercial products under the Lanham Act’s likelihood-of-confusion

standard, including parodic dog toys. *See, e.g., Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 259-60 (4th Cir. 2007).

The Ninth Circuit’s decision extends *Rogers* well beyond its original reasoning and conflicts with decisions from other Courts of Appeals. Courts asked to decide whether *Rogers* applies to “humorous” or parodic uses of trademarks on ordinary commercial products have always answered that question no; the Ninth Circuit now answers it yes. Neither the First Amendment nor the Lanham Act justifies this result. The first question presented by Jack Daniel’s petition implicates an important question of federal law on which the Courts of Appeals disagree. Given the significance of that question to trademark litigants, AIPLA urges this Court to grant certiorari.

## ARGUMENT

### **I. The Ninth Circuit’s Decision Creates a Circuit Split on the Scope of Protection Afforded by the First Amendment Against Lanham Act Claims.**

Two interrelated but separate errors led the Ninth Circuit to conclude that VIP’s use of Jack Daniel’s marks for dog toys enjoys heightened protection under the First Amendment. First, the court held that the narrow framework articulated in *Rogers* applied to VIP’s products because they communicated a “humorous message.” Second, its basis for this holding was that *Rogers* invariably applies to trademark parodies regardless of whether the dispute involves a protected artistic work or a utilitarian product. Both premises conflict with well-established precedent.

The reasoning underlying *Rogers*—and decades of subsequent lower court decisions—is that a heightened standard applies to *artistic works* because they are forms of protected speech. In contrast, *ordinary commercial products* (*i.e.*, “utilitarian products”) do not enjoy the same protection as artistic works. *Rogers*, 875 F.2d at 997-1000. Incorporating trademark parody into a utilitarian product does not transform the product into protected speech. No other court has applied *Rogers* as aggressively as the Court below to a commercial product, as is the dog toy in this case. Nor has *Rogers* been held applicable to all parodies regardless of what form they take. To the contrary, the Second Circuit has held that using an alleged parody of another’s mark to sell any commercial product does not receive heightened protection under *Rogers*. *See e.g., Harley-Davidson*, 164 F.3d at 812-13. Other circuit courts have applied the Lanham Act’s statutory likelihood-of-confusion standard to trademark parodies involving commercial products. *See, e.g., Haute Diggity Dog*, 507 F.3d at 259 (parodic dog toy).

#### **A. Courts Have Historically Limited *Rogers*’ Framework to Artistic Works.**

The Second Circuit’s decision in *Rogers* established a narrow First Amendment exception to the Lanham Act. *Rogers* requires heightened free speech protection for artistic works. *Rogers* never supplanted the Lanham Act’s traditional liability standard in cases involving other commercial products.

In *Rogers*, the court considered whether the Lanham Act can permissibly prohibit allegedly misleading film titles. Renowned filmmaker Federico Fellini cre-

ated a fictional movie based on entertainers who impersonated famous real-life dancing partners Ginger Rogers and Fred Astaire. 875 F.2d at 996-97. The movie was titled *Ginger and Fred* and featured two Italian dancers who make a career imitating Rogers and Astaire, and then reunite thirty years later for a television special. *Id.* The film was promoted as “the bittersweet story of these two fictional dancers and as a satire of contemporary television variety shows.” *Id.* at 997. Rogers filed suit under Section 43(a) of Lanham Act, alleging the *title* was likely to confuse consumers into believing she endorsed the film or was otherwise associated with it. The district court ruled against her, reasoning that Fellini’s title was not “intended primarily to serve a commercial purpose” and, thus, beyond the Lanham Act’s scope as part of an “artistic work.” See 695 F. Supp. 112, 120-21 (S.D.N.Y. 1988).

On appeal, the Second Circuit disagreed with the lower court’s bright-line rule. While films are “indisputably works of artistic expression,” 875 F.2d at 997, free speech principles “do not insulate titles of artistic works from all Lanham Act claims,” *id.* at 998. After all, films are sold “in the commercial marketplace like other more utilitarian products, making danger of consumer deception a legitimate concern that warrants some government regulation.” *Id.* at 997. Rather than dispensing with the Act entirely, the court reasoned that “First Amendment concerns” should “inform our consideration of the scope of the Act as applied to claims involving” a protected work’s title. *Id.* at 998.

The court next looked specifically to the relationship between artistic works and their titles.

Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the filmmaker's expression as well as a significant means of marketing the film to the public. *The artistic and commercial elements of titles are inextricably intertwined.*

*Id.* (emphasis added). This intertwined nature of literary titles is critical. "Film-makers and authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works." *Id.* Also, "[t]he subtleties of a title can enrich a reader's or a viewer's understanding of a work." *Id.* Given the inherent connection between artistic works and their titles, regulating a title's "commercial elements" (*i.e.*, their function as an identifier) would necessarily interfere with protected "artistic" elements that the First Amendment seeks to promote. *See id.*

To account for this concern, the *Rogers* court held that the Lanham Act does not apply to allegedly misleading film titles that are "artistically relevant" to the work and do not "explicitly mislead" as to the film's source or origin. *See id.* at 999. These dual requirements were intended to balance First Amendment interests and the Lanham Act's purpose of eliminating consumer deception in the commercial marketplace. *Rogers* permits use of "ambiguous or only implicitly misleading" film titles to allow leeway for protected speech. *Id.* at 1000. This accommodation is not absolute. "A misleading title with no artistic relevance cannot be sufficiently justified by a free expression interest." *Id.* at 999. Also, if an artistically relevant title

contains “explicit references” that are “false as applied to the underlying work,” the “interest in avoiding deception would warrant application of the Lanham Act.” *Id.* As an example, the court noted that titling Fellini’s film *The True Life Story of Ginger and Fred* may satisfy this explicitly misleading standard. *Id.* at 1000.

The *Rogers* framework is a narrow and specific limit on the Lanham Act for artistic works. As the Second Circuit made clear, *Rogers* allows use of misleading designations the Lanham Act would otherwise prohibit. The *Rogers*’ court’s reasoning rests on *two* threshold conditions that have tightly cabined its subsequent application.

**First**, the “product” identified and described by film titles (*i.e.*, the film) must be protected speech. While the First Amendment broadly protects artistic works in the realm of “entertainment,” *see Brown v. Ent. Merch.’s Ass’n*, 564 U.S. 786, 790 (2011) (“we have long recognized that it is difficult to distinguish politics from entertainment . . . . Like the protected books, plays, and movies that preceded them, video games communicate ideas . . . through many familiar literary devices.”), the vast majority of utilitarian products sold in the commercial marketplace do not qualify for this protection. *Rogers* is not meant for cases involving commercial products lacking artistic expression, and courts have overwhelmingly recognized this limitation. *See, e.g., Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 416 (S.D.N.Y. 2002) (perfume parody not subject to *Rogers*); *cf. Haute Diggity Dog*, 507 F.3d at 259-63 (statutory standard applied to parodic dog toy).

In contrast, the Ninth Circuit’s decision in the present case substantially expands the holding in *Rogers* to a utilitarian dog toy. This is the first time any court has expanded *Rogers* to a product that is not inherently protected speech. The Second Circuit itself specifically rejected expanding *Rogers* under similar circumstances. See *Harley-Davidson*, 164 F.3d at 812; cf. *Deere & Co. v. MTD Prod., Inc.*, 41 F.3d 39, 45 (2d Cir. 1994) (First Amendment did not bar state dilution law from regulating humorous parody “accomplished for the sole purpose of promoting” competing tractors). The court in *Harley-Davidson* specifically found that “somewhat humorous[]” use of Harley-Davidson’s logo for motorcycle repair services and T-shirts did not qualify for First Amendment protection and was subject to Lanham Act’s statutory enforcement standard. 164 F.3d at 813.

**Second**, film titles are uniquely “of a hybrid nature.” *Rogers*, 875 F.2d at 998. They identify the film for promotional purposes **and** communicate information about the film’s substance in a manner that is “inextricably intertwined.” *Id.* The inherent link between a title’s expressive and identifying functions is not analogous to all uses of marks that relate in some tangential way to protected speech. Courts have long imposed trademark liability on unauthorized users engaged in political speech who “furnish[] a wide variety of non-commercial public and civic benefits.” *United We Stand Am., Inc. v. United We Stand, Am. New York, Inc.*, 128 F.3d 86, 90, 93 (2d Cir. 1997). The same is true about uses of misleading marks that implicate speech relating to the exercise of religion. See, e.g., *TE-TA-MA Truth Foundation—Family of URI, Inc. v. World Church of Creator*, 297 F.3d 662, 667 (7th Cir.

2002) (“The World Church has every right to a distinctive name; it does not have a constitutional right to use some other denomination’s incontestable trademark.”).

This second threshold condition ensures *Rogers* does not displace the Lanham Act’s likelihood-of-confusion standard simply because a dispute involves some allegedly protected speech *unless* that expression is part-and-parcel with any commercial purpose. Few circumstances beyond titles of artistic works fulfill this condition. Compare *Stop the Olympic Prison v. U.S. Olympic Comm.*, 489 F. Supp. 1112, 1126 (S.D.N.Y. 1980) (use of Olympic marks in poster protesting planned construction of federal prison was likely protected under the First Amendment). As a result, only a small subset of trademark disputes involving protected speech is subject to *Rogers*.

Although the Second Circuit subsequently expanded the reach of *Rogers* beyond film titles, it has not altered these two threshold conditions. Nor has the Second Circuit extended the *Rogers* framework beyond artistic works, literary works, and other protected entertainment. Less than a year after *Rogers*, the Second Circuit considered an infringement action involving a parody of Cliffs Notes study guides called Spy Notes that mimicked visual elements of the familiar Cliffs Notes cover. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Grp., Inc.*, 886 F.2d 490, 491-93 (2d Cir. 1989). Recognizing that the film title in *Rogers* involved somewhat different considerations than a parodic book cover, the court nevertheless applied *Rogers* because books (*i.e.*, literary works) also qualify as protected artistic works. *Id.* at 493-94. The court held

“that the *Rogers* balancing approach is *generally applicable to Lanham Act claims against works of artistic expression.*” *Id.* at 494-95 (emphasis added). “This approach,” the court explained, “takes into account the ultimate test in trademark law, namely, the likelihood of confusion.” *Id.* at 495. Several years later in a case involving a book title, the court further clarified that a “finding of likelihood of confusion must be particularly compelling to outweigh the First Amendment interest recognized in *Rogers.*” *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993).

At least five circuits have adopted the *Rogers* framework, all of which have maintained its two threshold limitations. *See Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 328-29 (4th Cir. 2015); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1277 (11th Cir. 2012); *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 928 (6th Cir. 2003); *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894 (9th Cir. 2002); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664-665 (5th Cir. 2000). Those courts have applied *Rogers* to disputes involving artistic works like songs, paintings, books, magazines, and video games. *See* J. Thomas, 6 McCarthy on Trademarks & Unfair Competition § 31:139 (5th ed. 2022). “Circuit courts have also applied *Rogers* in cases where trademark law is being used to attack the content—as opposed to the title—of works protected by the First Amendment.” *See, e.g., Univ. of Ala.*, 683 F.3d at 1277. None of these courts have applied *Rogers* to utilitarian products having a commercial purpose. The Ninth Circuit’s application of *Rogers* to a dog toy unjustifiably extends *Rogers* and threatens the framework’s decades of stability.

**B. Misleading Trademark Parodies Used as Trademarks or Trade Dress for Utilitarian Products Should Not Receive Heightened Protection.**

The Ninth Circuit's mistaken conclusion that *Rogers* governed this case rests on its faulty determination that VIP's dog toy is protected speech merely because it is a humorous parody. Even assuming *arguendo* that VIP's dog toy is a parody, *Rogers* has never been held to insulate all parodies. The Ninth Circuit's conclusions on this point depart from well-established precedent in the Second Circuit and elsewhere.

This Court has described parody as a "literary or artistic work that imitates the characteristic style of an author or a work for comic effect or ridicule." *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580 (1994). Successful parodies mimic the original source while conveying simultaneously that they are not the original, which ensures "the customer would not be confused, but amused." *Nike, Inc. v. Just Did It Enters.*, 6 F.3d 1225, 1228 (7th Cir. 1993). Parodies can take many forms. Sometimes they are used in political advertising. See *MasterCard Int'l Inc. v. Nader 2000 Primary Comm., Inc.*, No. 00-CV-6068, 2004 WL 434404, at \*16 (S.D.N.Y. Mar. 8, 2004). Others appear as visual works printed on apparel. See *Anheuser-Busch, Inc. v. L. & L. Wings, Inc.*, 962 F.2d 316, 321 (4th Cir. 1992). Parody may also identify the name and source of utilitarian products sold for commercial purposes. See *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1486 (10th Cir. 1987) (parody as trademark for plus-sized jeans).

Most courts applying *Rogers* distinguish between parody in literary or artistic works and parody as a source identifier for utilitarian products sold for commercial purposes. See McCarthy, *supra*, § 31:153. As one court stressed: “When another’s trademark (or a confusingly similar mark) is used without permission *for the purpose of source identification*, the trademark law generally prevails over the First Amendment.” *Yankee Pub. Inc. v. News Am. Pub. Inc.*, 809 F. Supp. 267, 276 (S.D.N.Y. 1992) (Leval, J.) (emphasis in original). In particular, two Second Circuit decisions highlight the dichotomy in how courts treat trademark parody in artistic works (*Cliffs Notes*) versus trademark parody used with ordinary commercial products (*Harley-Davidson*).

The court in *Cliffs Notes* held that the parodic use at issue in that case was protected under *Rogers* as a “work[] of artistic expression.” 886 F.2d at 495. The challenged product—a one-time parody of Cliffs Notes study guides called Spy Notes—was a *book, i.e.*, an artistic work that is inherently protected speech under the First Amendment. The book “poke[d] fun at certain novels” with known “literary shortcomings” by using a “satirize[d] Cliffs Notes” style in explaining the novels to readers. *Id.* at 493. “[T]aking into account that somewhat more risk of confusion is to be tolerated when a trademark holder seeks to enjoin artistic expression,” the court concluded that “the degree of risk of confusion between Spy Notes and Cliffs Notes does not outweigh” the First Amendment interest in allowing authors expressive freedom. *Id.*

*Harley-Davidson*, on the other hand, reached the opposite result. That decision involved a logo for a motorcycle repair shop called “The Hog Farm” that performed maintenance on Harley-Davidson motorcycles. 164 F.3d at 808-10. The shop’s logo appropriated Harley-Davidson’s seventy-year old bar-and-shield logo, except that it replaced the words “Harley-Davidson” with “American Made” and included the disclaimer “unauthorized dealer.” *Id.* at 809. The logo also included “a drawing of a pig wearing sunglasses.” *Id.* Rejecting an argument that the shop’s logo was protected parody under the First Amendment, the court held: “We have accorded considerable leeway to parodists whose expressive works aim their parodic commentary at a trademark or a trademarked product . . . but have not hesitated to prevent a manufacturer from using an alleged parody of a competitor’s mark to sell a competing product.” *Id.* at 812 (citing *Rogers*, 875 F.2d at 998). The court observed that the shop’s logo made “no comment on Harley’s mark” and “simply uses it somewhat humorously to promote [its] own products and services, which is not a permitted trademark parody use.” *Id.* at 813.

The reasoning in *Harley-Davidson* illustrates how *Rogers*’ two threshold conditions limit its application. The shop’s “product” was competing repair services and ancillary products offered in the commercial marketplace, not an artistic work that qualified as protected speech. The use of generalized humor in a logo identifying the source of motorcycle repair services is not part-and-parcel with these services or otherwise an inherent component of protected speech. Thus, the logo failed to meet either of *Rogers*’ threshold conditions. *See supra* Part I.A. *Harley-Davidson* establishes

that alleged parodies are not automatically protected by *Rogers* or the First Amendment.

The Ninth Circuit's substantial expansion of *Rogers* in this case establishes a split among the circuits. The Ninth Circuit erroneously concluded *Rogers* applied simply because the dog toys convey a "humorous message," without ever considering their inherently utilitarian and non-expressive commercial purpose. This approach cannot be squared with *Harley-Davidson* or other Second Circuit caselaw. See, e.g., *Tommy Hilfiger*, 221 F. Supp. 2d at 416; cf. *Bad Frog Brewery, Inc. v. New York State Liquor Auth.*, 134 F.3d 87, 97 (2d Cir. 1998) (no First Amendment protection for humorous beer labels that "at most link[ed] a product to a current debate").

Nor can it be squared with the broad consensus among lower courts that parody is generally subject to the Lanham Act's traditional likelihood-of-confusion standard. For example, the Seventh Circuit has recognized that the First Amendment "allows ridicule in the form of parody" while emphasizing that "[p]arodies do not enjoy a dispensation" from the traditional infringement standard. *Nike*, 6 F.3d at 1227-28. Instead, parody is "another factor to be considered in determining the likelihood of confusion" that may require recalibration of other considerations like intent. See *id.* at 1228, 1231-32. Numerous courts have endorsed this approach. See, e.g., *Lyons P'ship v. Giannoulas*, 179 F.3d 384, 389-90 (5th Cir. 1999). Likewise, courts across the

country have consistently applied the traditional liability standard to a range of parodic uses involving ordinary products.<sup>2</sup>

Parodic pet products should be treated no differently. Indeed, the Fourth Circuit in *Haute Diggity Dog* analyzed a chew toy for dogs called “Chewy Vuiton” that mimicked Louis Vuitton purses. 507 F.3d at 258. The toys were found to be a parody because they “poke[d] fun at the elegance and expensiveness of a LOUIS VUITTON handbag, which must *not* be chewed by a dog.” *Id.* at 261 (emphasis in original). That finding, however, did “not end the inquiry into whether Haute Diggity Dog’s ‘Chewy Vuiton’ products create a likelihood of confusion.” *Id.* Rather, the court assessed liability under the statutory likelihood-of-confusion standard. *Id.* at 262-63. “Recognizing that ‘Chewy Vuiton’ is an obvious parody and applying the [traditional] factors,” the court held “that LVM has failed to demonstrate any likelihood of confusion.” *Id.* at 263.

The Fourth Circuit relied in part on an earlier case involving a “parody perfume product[] for use on pets” called “Timmy Holedigger.” *See Tommy Hilfiger*, 221 F. Supp. 2d at 413. The court in that case refused to apply *Rogers* because “the First Amendment does not

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<sup>2</sup> *See Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 115 (2d Cir. 2009) (coffee); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 200 & 200 n.5 (5th Cir. 1998) (restaurant and bar services); *Jordache*, 828 F.2d at 1486 (jeans); *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 441 (S.D.N.Y. 2016) (handbags); *Wendy’s Int’l, Inc. v. Big Bite, Inc.*, 576 F. Supp. 816, 822 (S.D. Ohio 1983) (fast food).

extend” to infringing uses for “a somewhat non-expressive, commercial product.” *Id.* at 415-16. Applying the statutory liability standard instead, the court concluded that the perfume was noninfringing under the traditional factors. *See id.* at 416-21. Another court similarly applied the statutory standard in a dispute involving parodic dog treats. *Grey v. Campbell Soup Co.*, 650 F. Supp. 1166, 1173-75 (C.D. Cal. 1986) (use of DOGIVA mark infringed GODIVA); *see also Recot, Inc. v. M. C. Becton*, 56 USPQ2d 1859, 1860-62 (TTAB 2000) (refusing registration of FIDO LAY dog treats based on likely confusion with FRITO LAY mark). The decision below fails to explain why the “humorous” aspect of VIP’s toys is any different, and more deserving of protection, than the parodic products in these cases.

Finally, the Ninth Circuit seemingly assumed, without question, that VIP’s toys qualified as parody. Although the court did not refer to the toys as protected parody, the precedents it relied on for applying *Rogers* are almost all parody cases. 953 F.3d at 1176.<sup>3</sup> As ample precedent makes clear, however, “the heart of any parodist’s claim” to use another’s work is for the purpose of providing “commentary . . . bearing on the substance of style of the original composition.” *See, e.g., Campbell*, 510 U.S. at 580. “The message ‘must not only differentiate the alleged parody from the original but must also communicate some articulable element of

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<sup>3</sup> Those cases include *Campbell*, 510 U.S. at 580 (parodic song); *Haute Diggity Dog*, 507 F.3d at 258-63 (parodic dog toy); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1397 (9th Cir. 1997) (alleged parody of *The Cat in the Hat*); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir. 1987) (parodic article).

satire, ridicule, joking or amusing.” *My Other Bag*, 156 F. Supp. 3d at 434-35 (quoting *Haute Diggity Dog*, 507 F.3d at 260). An alleged trademark parody that “makes no comment on [the original] mark” fails to establish an absence of likely confusion and remains “vulnerable” to liability. *Harley-Davidson*, 164 F.3d at 813.

The decision below considers only in passing the significance of any commentary communicated by VIP’s products. In a single sentence, the court suggested that the toys incorporated a “silly message” conveyed by “juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.” 953 F.3d at 1175 (quoting *L.L. Bean*, 811 F.2d at 34). This generic reasoning applies to virtually every claimed parody that uses a mark in a manner inconsistent with the trademark owner’s usage.

Accordingly, the Ninth Circuit’s conclusion that *Rogers* insulates all alleged parodies in connection with utilitarian products conflicts with Second Circuit precedent. *See Harley-Davidson*, 164 F.3d at 812-13. The decision below is inconsistent with *Rogers*’ threshold conditions limiting its application to trademarks used in artistic works that are inherently intertwined with protected speech. The decision also breaks with courts in multiple jurisdictions that do not apply any heightened standard to a range of allegedly parodic uses. *See, e.g., Haute Diggity Dog*, 507 F.3d at 259.

## **II. Trademark Owners Would Rarely Prevail under the Ninth Circuit’s Approach.**

The Ninth Circuit’s extension of *Rogers* to ordinary commercial products raises serious concerns for trademark owners. *Rogers* imposes a heightened “explicitly

misleading” standard in cases involving artistic works. Far more often than not, trademark owners fail to meet *Rogers*’ heightened standard. See 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, 872 (2019) (observing that courts in the Ninth Circuit often dismiss claims under *Rogers* at the motion-to-dismiss stage). While a balancing test that favors First Amendment interests may be sensible in cases involving artistic works that are inherently intertwined with protected speech, the decision below signals that infringers selling **any kind of utilitarian product** for a commercial purpose may now escape trademark liability, provided it incorporates some minimal “humorous” aspect. This approach would place an unreasonable burden on trademark owners to prove infringement and likely lead to forum shopping among trademark litigants.

The Ninth Circuit has elaborated on *Rogers*’ “explicitly misleading” standard’s meaning more than any other circuit. The court has emphasized that proof of liability under *Rogers* requires evidence that the alleged infringer’s use both “misleads consumers” and does so “explicitly.” *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018). In stark contrast to the Lanham Act, “likely” confusion is insufficient, as is actual confusion if caused implicitly. See *id.* at 267 (“it is not enough to show that the defendant’s use of the mark would confuse consumers as to the source”). Liability instead requires an “explicit indication,” “overt claim,” or “explicit misstatement” by the infringer. *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1199 (9th Cir. 2017).

Thus, the Ninth Circuit’s standard “reject[s] the ‘likelihood of confusion’ test.” *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013). It also seemingly restricts the universe of relevant evidence. Refusing to consider survey evidence that suggested significant consumer confusion, the court in *Brown* emphasized: “To be relevant, evidence must relate to the nature of the behavior of the identifying material’s user, ***not the impact of the use.***” *Id.* at 1246 (emphasis added).

Thus, liability in the Ninth Circuit is exceedingly difficult to prove when *Rogers* applies. The court has “repeatedly observed that the mere use of a trademark alone cannot suffice to make such use explicitly misleading.” *Gordon*, 909 F.3d at 270. By focusing on the “the nature of the [user’s] behavior” rather than the deceptive “impact of the use,” see *Brown*, 724 F.3d at 1239, the Ninth Circuit’s liability standard under *Rogers* turns largely on the alleged infringer’s intent. Yet, as this Court has noted: “Intent is a subjective state, illusory and difficult to establish in absence of voluntary confession.” *Knauer v. United States*, 328 U.S. 654, 659 (1946). Practically speaking, proving liability in the Ninth Circuit under *Rogers* presents a serious challenge that often becomes insurmountable.

As a result, the decision below has far reaching ramifications for trademark litigants. Expanding *Rogers* with its heightened standard to disputes involving misleading marks on utilitarian products that merely convey a “humorous message” dramatically curtails trademark owners’ ability to protect their marks. Under the Ninth Circuit’s approach, infringers could transform the use of misleading trademarks on virtually any product into protected speech and avoid liability, short of

facts showing the most egregious, willful infringement and despite substantial consumer confusion.

Rational trademark owners will undoubtedly take notice. When possible, they will likely sue alleged infringers with a colorable claim of expressive use in jurisdictions outside the Ninth Circuit. By the same token, alleged infringers facing threats of litigation now have a substantial incentive to file a declaratory judgment action in the Ninth Circuit.

The risk of forum shopping arising from the Ninth Circuit's expansion of *Rogers* to ordinary commercial products is not merely speculative, as demonstrated by this case. Indeed, VIP was previously sued in the Eighth Circuit for the sale of a highly similar dog toy, and the district court there preliminarily enjoined VIP from further sales before the case settled. *See Anheuser-Busch, Inc. v. VIP Prod., LLC*, 666 F. Supp. 2d 974, 985 (E.D. Mo. 2008). When threatened with litigation by Jack Daniel's six years later in the present case, VIP filed a declaratory judgment action in Arizona, leveraging *Rogers* to obtain a contrary result.

The decision below portends similar gamesmanship among trademark litigants in disputes raising First Amendment issues. Forum shopping will likely become routine, as parties on both sides seek to either leverage or avoid the Ninth Circuit's expansion of *Rogers*. That practical impact alone warrants review by this Court. As the Court has noted elsewhere, a rule of decision that "produce[s] forum shopping" is "unacceptable when it comes as the consequence of judge-made rules." *Cf. Shady Grove Orthopedic Assocs., P.A. v. Allstate Ins. Co.*, 559 U.S. 393, 415-16 (2010).

**CONCLUSION**

One of this Court's primary functions is to reconcile conflicts between the Courts of Appeals. The Second Circuit's *Rogers* rule is well-established law that strikes an appropriate balance between protection of trademark rights and First Amendment expression in artistic works. The Ninth Circuit in the decision below misapplied *Rogers*, expanding it substantially. This expansion disturbs the appropriate balance in favor of permitting misleading uses of trademarks that are likely to cause confusion and lack the requisite characteristics of protected speech. This expansion of *Rogers* effectively negates trademark owners' rights to challenge misleading uses of their marks on virtually any utilitarian product the infringer can colorably claim uses its marks in a humorous fashion. AIPLA urges the Court to review the Ninth Circuit's decision and restore an appropriate balance between these important competing interests.

Respectfully submitted,

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