

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

**AMICUS CURIAE BRIEF OF THE
INTERNATIONAL TRADEMARK
ASSOCIATION IN SUPPORT OF
PETITIONER**

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TABLE OF CONTENTS

	<i>Page</i>
TABLE OF CONTENTS.....	i
TABLE OF CITED AUTHORITIES	iii
<i>AMICUS CURIAE</i> BRIEF OF THE INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF PETITIONER	1
INTEREST OF <i>AMICUS CURIAE</i>	1
SUMMARY OF ARGUMENT	4
ARGUMENT.....	8
I. THE NINTH CIRCUIT’S INFRINGEMENT ANALYSIS DIVERGES FROM OTHER FEDERAL CIRCUITS AND UPENDS THE BALANCE BETWEEN TRADEMARK LAW AND THE FIRST AMENDMENT	8
A. The <i>Rogers</i> Test Strikes The Right Balance By Granting First Amendment Protection Only To Artistic Works, Not Ordinary Commercial Products.	8

Table of Contents

	<i>Page</i>
B. No Other Circuit Has Applied <i>Rogers</i> To Ordinary Commercial Products, As Traditional Trademark Principles Provide Ample First Amendment Protections.	11
C. The Ninth Circuit’s Extension Of <i>Rogers</i> Wrongly Tilts The Balance Against The Application Of Trademark Law And Its Protection Of Consumers.....	12
D. Recent Cases Illustrate The Dangers Of The Ninth Circuit’s Departure From the <i>Rogers</i> Conception of “Expressive Work” And The Need For A Definition For What Constitutes An Expressive Work.	17
II. THE NINTH CIRCUIT’S DILUTION ANALYSIS DISREGARDS THE STATUTORY FRAMEWORK OF 15 U.S.C. § 1125(c)(3)(A).....	20
CONCLUSION	24

TABLE OF CITED AUTHORITIES

	<i>Page</i>
Cases	
<i>A.V.E.L.A., Inc. v.</i> <i>Estate of Marilyn Monroe, LLC,</i> 364 F. Supp. 3d 291 (S.D.N.Y. 2019)	10
<i>Already, LLC v. Nike, Inc.,</i> 568 U.S. 85 (2013)	2
<i>Am. Dairy Queen Corp. v. New Line Prods., Inc.,</i> 35 F. Supp. 2d 727 (D. Minn. 1998)	5
<i>B&B Hardware, Inc. v. Hargis Indus., Inc.,</i> 135 S. Ct. 1293 (2015)	2
<i>Bolger v. Youngs Drug Prods. Corp.,</i> 463 U.S. 60 (1983)	7, 21, 22
<i>Cardtoons, L.C. v. Major League Baseball</i> <i>Players Ass’n,</i> 95 F.3d 959 (10th Cir. 1996)	12
<i>Caryn Mandabach Prods. Ltd. v. Sadlers</i> <i>Brewhouse Ltd.,</i> 2021 WL 2497928 (C.D. Cal. 2021)	6
<i>Christian Louboutin S.A. v. Yves Saint Laurent</i> <i>Am. Holdings, Inc.,</i> 696 F.3d 206 (2d Cir. 2012)	2

Cited Authorities

	<i>Page</i>
<i>Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003)</i>	2
<i>E.S.S. Ent'mt 2000 Inc. v. Rock Star Videos Inc., 547 F.3d 1095 (9th Cir. 2008)</i>	12
<i>Empire Distrib., Inc. v. Twentieth Century Fox Television, 139 S.Ct. 61 (2018)</i>	13
<i>Fleischer Studios, Inc. v. A.V.E.L.A., Inc., 654 F.3d 958 (9th Cir. 2011)</i>	2
<i>Gomez v. United States, 490 U.S. 858 (1989)</i>	23
<i>Hana Fin., Inc. v. Hana Bank, 135 S. Ct. 907 (2015)</i>	2
<i>Hermès International and Hermès of Paris, Inc. v. Rothschild, __ F.Supp.3d __, 2022 WL 1564597 (S.D.N.Y. May 18, 2022)</i>	18
<i>Iancu v. Brunetti, 139 S. Ct. 2294 (2019)</i>	2, 3
<i>Jack Daniel's Properties, Inc. v. VIP Products LLC, 141 S. Ct. 1054 (2020)</i>	2

Cited Authorities

	<i>Page</i>
<i>Jordache Enters., Inc. v. Hogg Wyld, Ltd.,</i> 828 F.2d 1482 (10th Cir. 1987)	12
<i>KP Permanent Make-Up, Inc. v. Lasting</i> <i>Impression I, Inc.,</i> 543 U.S. 111 (2004)	2
<i>Louis Vuitton Malletier S.A. v.</i> <i>Haute Diggity Dog, LLC,</i> 507 F.3d 252 (4th Cir. 2007)	2, 3, 11
<i>Louis Vuitton Malletier, S.A. v.</i> <i>Hyundai Motor Am.,</i> No. 10 Civ. 1611, 2012 WL 1022247 (S.D.N.Y. Mar. 22, 2012)	23
<i>Louis Vuitton Malletier, S.A. v.</i> <i>My Other Bag, Inc.,</i> 674 Fed.Appx. 16 (2d Cir. 2016)	11
<i>Matal v. Tam,</i> 137 S. Ct. 1744 (2017)	2, 3
<i>Mattel, Inc. v. MCA Records, Inc.,</i> 296 F.3d 894 (9th Cir. 2002)	21
<i>Mattel, Inc. v. Walking Mountain, Prods.,</i> 353 F.3d 792 (9th Cir. 2003)	5

Cited Authorities

	<i>Page</i>
<i>Metromedia, Inc. v. City of San Diego</i> , 453 U.S. 490 (1981).....	22
<i>Mission Prod. Holdings, Inc. v.</i> <i>Technology, LLC</i> , 139 S. Ct. 1652 (2019).....	22
<i>Moseley v. V Secret Catalogue, Inc.</i> , 537 U.S. 418 (2003).....	2
<i>Ohio State Univ. v. Redbubble, Inc.</i> , 989 F.3d 435 (6th Cir. 2021).....	2
<i>Parks v. LaFace Records</i> , 329 F.3d 437 (6th Cir. 2003)	2
<i>Peter v. NantKwest, Inc.</i> , 140 S. Ct. 365 (2019).....	2
<i>Pom Wonderful LLC v. Coca-Cola Co.</i> , 134 S. Ct. 2228 (2014).....	2
<i>Radiance Foundation v. NAACP</i> , 786 F.3d 316 (4th Cir. 2015).....	22
<i>Rogers v. Grimaldi</i> , 875 F.2d 994 (2d Cir. 1989)	<i>passim</i>
<i>Romag Fasteners, Inc. v. Fossil, Inc.</i> , 140 S. Ct. 1492 (2020).....	2

Cited Authorities

	<i>Page</i>
<i>Rosetta Stone Ltd. v. Google, Inc.</i> , 676 F.3d 144 (4th Cir. 2012)	2
<i>S.F. Arts & Athletics, Inc. v.</i> <i>U.S. Olympic Committee</i> , 483 U.S. 522 (1987)	14
<i>Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.</i> , 588 F.3d 97 (2d Cir. 2009)	2
<i>Tommy Hilfiger Licensing, Inc. v.</i> <i>Nature Labs, LLC</i> , 221 F. Supp. 2d 410 (S.D.N.Y. 2002)	10
<i>TrafFix Devices, Inc. v. Mktg. Displays, Inc.</i> , 532 U.S. 23 (2001)	2
<i>Twentieth Century Fox Television v.</i> <i>Empire Distrib., Inc.</i> , 875 F.3d 1192 (9th Cir. 2017)	13
<i>U.S. Patent & Trademark Office v.</i> <i>Booking.com B.V.</i> , 140 S. Ct. 2298 (2020)	2
<i>Univ. of Alabama Bd. of Trustees v.</i> <i>New Life Art, Inc.</i> , 683 F.3d 1266 (11th Cir. 2012)	5, 13

Cited Authorities

	<i>Page</i>
<i>Vans, Inc. and VF Outdoor, LLC v. MSCHF Product Studio, 22-cv-2156, __ F.Supp.3d __, 2022 WL 1446681 (E.D.N.Y. April 29, 2022) appeal filed, No. 22-1006 (2d Cir.)</i>	17
<i>Vans, Inc., et al. v. MSCHF Product Studio, Inc., Case No. 22-1006-cv (2d Cir. Pending)</i>	2
<i>VIP Prods. LLC v. Jack Daniel’s Properties, Inc., 2021 WL 5710730 (D. Ariz. Oct. 8, 2021)</i>	14
<i>VIP Prods. LLC v. Jack Daniel’s Properties, Inc., 953 F.3d 1170 (9th Cir. 2020)</i>	<i>passim</i>
<i>Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205 (2000)</i>	2
<i>Westchester Media v. PRL USA Holdings, Inc., 214 F.3d 658 (5th Cir. 2000)</i>	5

Statutes and Other Authorities

15 U.S.C. § 1125(c)(3)	7, 20
15 U.S.C. § 1125(c)(3)(A)	3, 20
15 U.S.C. § 1125(c)(3)(A)(ii)	7

Cited Authorities

	<i>Page</i>
H.R. Rep. No. 104-374	21
Mark A. Lemley & Mark P. McKenna, <i>Trademark Spaces and Trademark Law's Secret Step Zero</i> , 74 Stan. L. Rev. ____ (forthcoming 2022)	16
Pierre N. Leval, <i>Trademark: Champion of Free Speech</i> , 27:2 COLUM. J. L. & ARTS 188 (2004)	10

***AMICUS CURIAE* BRIEF OF THE
INTERNATIONAL TRADEMARK ASSOCIATION
IN SUPPORT OF PETITIONER**

The International Trademark Association (“INTA”) submits this brief in support of the petition for writ of certiorari by Jack Daniel’s Properties, Inc. (“JDPI”).¹

INTEREST OF *AMICUS CURIAE*

Founded in 1878 as the United States Trademark Association, INTA is a not-for-profit organization dedicated to the advancement of trademarks and related intellectual property concepts as essential elements of trade and commerce. With more than 7,200 member organizations from 191 countries, INTA’s members share the goal of promoting the essential role that trademarks play in fostering informed decisions by consumers and fair competition.

INTA’s members frequently are plaintiffs, defendants, and advisors in legal actions under the Lanham Act. INTA is interested in the development of clear, consistent, and equitable principles of trademark law. INTA has participated as *amicus curiae* in numerous cases on

1. Both parties received notice of INTA’s intent to file an *amicus* brief at least 10 days prior to the filing deadline, and both parties consented. S. Ct. R. 37.2(a). This brief was authored solely by INTA and its counsel. No party or counsel for a party, and no person other than INTA and its counsel, made a monetary contribution intended to fund the preparation or submission of this brief. S. Ct. R. 37.6.

significant Lanham Act issues, including on the First Amendment.²

INTA was founded in part to encourage enactment of federal trademark legislation after the invalidation of the United States' first trademark act. Since then, INTA has provided recommendations to legislators in connection with almost all major federal trademark legislation, including the Lanham Act and the Trademark Dilution Revision Act ("TDRA"), both at issue in this appeal.

2. Cases in which INTA has filed amicus briefs include: *Jack Daniel's Properties, Inc. v. VIP Products LLC*, 141 S.Ct. 1054 (2020); *U.S. Patent & Trademark Office v. Booking.com B.V.*, 140 S. Ct. 2298 (2020); *Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S. Ct. 1492 (2020); *Peter v. NantKwest, Inc.*, 140 S. Ct. 365 (2019); *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019); *Mission Prod. Holdings, Inc. v. Technology, LLC*, 139 S. Ct. 1652 (2019); *Matal v. Tam*, 137 S. Ct. 1744 (2017); *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907 (2015); *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293 (2015); *Pom Wonderful LLC v. Coca-Cola Co.*, 134 S. Ct. 2228 (2014); *Already, LLC v. Nike, Inc.*, 568 U.S. 85 (2013); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003); *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000); *Vans, Inc., et al. v. MSCHF Product Studio, Inc.*, Case No. 22-1006-cv (2d Cir. Pending); *Ohio State Univ. v. Redbubble, Inc.*, 989 F.3d 435 (6th Cir. 2021); *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012); *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144 (4th Cir. 2012); *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958 (9th Cir. 2011) (on rehearing); *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007).

At its core, trademark law is about protecting consumers. Trademarks help consumers learn where their products and services come from and are crucial indicators of source and quality. INTA therefore seeks to protect the interests of consumers and brand owners alike. In this case, INTA's principal interest is in promoting the appropriate balance between trademark law and the First Amendment. In parody cases, INTA members are sometimes the parodist and sometimes the parodied. INTA therefore does not approach this case with any bias for or against parody.

Rather, because its members find themselves as both plaintiffs and defendants, INTA advocates for a balance of free speech with consumer protection. *Compare Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) and *Matal v. Tam*, 137 S. Ct. 1744 (2017)(supporting First Amendment rights to register marks that are scandalous or disparaging) with *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007)(arguing that parodies that use another's trademark on consumer products as the defendant's own brand should be examined under trademark law to assess whether they confuse consumers or dilute the plaintiff's famous mark); *see also* 15 U.S.C. § 1125(c)(3)(A)(supporting addition of a fair use defense under specific circumstances).

In this case, INTA takes no position on whether the Respondent's dog toy is infringing or diluting. That is properly decided on the facts. INTA does, however, take a position on the correct analytical framework and urges this Court to grant certiorari and reverse the Ninth Circuit.

SUMMARY OF ARGUMENT

Nearly three and a half decades ago, in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), the Second Circuit fashioned a test to determine whether the title of an artistic work that incorporates another's trademark infringes that mark. Specifically, the Second Circuit held that titles of artistic works do not infringe unless (1) the title has no artistic relevance to the underlying work, or (2) even if artistically relevant, the title misleads as to the source of the work. Under *Rogers*, the author of the expressive work thus is shielded from liability unless the use of the other's mark is wholly gratuitous or, even if artistically relevant, "explicitly" misleading. Because the specific medium there, a movie, is an inherently expressive or artistic work, the *Rogers* test thus appropriately favored First Amendment interests over trademark rights.

Since the Second Circuit's decision in *Rogers*, all other circuits but the Ninth have faithfully limited *Rogers* to traditionally expressive or artistic works like movies, art, books, and the like. The Ninth Circuit's decision below continues that circuit's inappropriate (and concerning) steady expansion of *Rogers* to any product or service that merely contains discernible expression. This unwarranted expansion beyond the roots of *Rogers* creates a sharp circuit split on how to balance competing claims of trademark protection and free speech in the context of ordinary commercial products. The Ninth Circuit's decision threatens a trademark infringement framework that has been intact and applied for nearly a century.

Indeed, when properly applied to traditionally expressive works, the *Rogers* test is balanced. Plaintiffs

sometimes win. *See, e.g., Parks v. LaFace Records*, 329 F.3d 437, 451–52 (6th Cir. 2003)(use of name “Rosa Parks” in song title infringing); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65, 668 (5th Cir. 2000) (use of POLO for magazine about the sport infringed); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 730 (D. Minn. 1998)(using DAIRY QUEEN mark as title of movie infringed). Defendants sometimes win, too. *See, e.g., Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003)(use of “Barbie” in titles of photographs); *Univ. of Alabama Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1278–79 (11th Cir. 2012)(use of University of Alabama marks in paintings of football games was artistically relevant and protected under *Rogers*). Regardless of who wins, the test always has been limited to artistic works.

But when mis-applied beyond traditionally expressive works, *Rogers* inaptly shields all but the most egregious and intentionally infringing conduct. In the decision below, and in its other recent decisions consistently (but inappropriately) expanding the reach of *Rogers*, the Ninth Circuit has put an unwarranted thumb on the scale by extending near-absolute First Amendment protection to ordinary commercial goods such as dog toys—a fact the district court below acknowledged on remand when it recognized that under the Ninth Circuit’s decision in this case it “appears nearly impossible for any trademark holder to prevail under the *Rogers* test” unless the defendant is “slapping another’s trademark on [its] own work and calling it [its] own.” Based on these conclusions, the district court below lamented that the only way to address the Ninth Circuit’s *Rogers* jurisprudence is through this Court’s review or the United States

Congress. Indeed, the Ninth Circuit’s expansion of *Rogers* to ordinary commercial products would enable defendants to evade the infringement analysis under the Lanham Act simply by grafting some purported expressive element onto those goods. This was never the intended reach of *Rogers*.

These issues created by the Ninth Circuit’s decision below are not isolated. Since that decision, more defendants using another’s mark on commercial products have talismanically cited *Rogers* as a shield from the unauthorized, and potentially confusing, use of another’s mark. See, e.g., *Caryn Mandabach Prods. Ltd. v. Sadlers Brewhouse Ltd.*, 2021 WL 2497928 (C.D. Cal. 2021) (Defendant asserted that *Rogers* applies to its use of PEAKY BLINDER for spirits, against claim by producer of PEAKY BLINDERS television show.). The modern commercial landscape has also blurred the line between commercial products and expressive works, especially in the digital realm, potentially further exacerbating the effects of the Ninth Circuit’s overexpansion of *Rogers*.

INTA therefore urges this Court to grant review and adopt a definition of the term “expressive work” that identifies those products whose core function is artistic expression and those ordinary commercial products that merely contain expression while maintaining a separate utilitarian function. Such a definition will serve the essential gatekeeping function for when *Rogers* applies. By the Ninth Circuit’s current formulation below and in its prior cases applying *Rogers*, any product that contains any arguable expression of any kind—no matter how attenuated or tangential—automatically qualifies for the near-absolute protections under *Rogers*. INTA asserts

that such an expansive view of “expressiveness” risks gutting the trademark infringement framework applied for many decades. Absent this Court’s review, the Ninth Circuit’s view threatens trademark owners’ ability to police their marks and protect consumers.

With respect to **dilution**, the TDRA contains an express exclusion for parodies, and thus already strikes the needed balance with the First Amendment. 15 U.S.C. § 1125(c)(3)(A)(ii). That exclusion applies to the “fair use” of another’s mark, but only if that use does not serve to identify the defendant’s own goods. Other exclusions protect news reporting, comparative advertising, and noncommercial use. 15 U.S.C. § 1125(c)(3).

These exclusions protect parodies where the defendant has not used the plaintiff’s mark as a designation of source of defendant’s own goods (such as here, where Respondent used a similar, albeit humorous, mark with Jack Daniel’s trade dress, on Respondent’s dog toy as a source identifier). Whether a use is diluting should be decided under the substantive provisions of the TDRA. There is no need to consult inapposite First Amendment jurisprudence when the TDRA already provides balance, especially given principles of constitutional avoidance.

Furthermore, the Ninth Circuit’s legal conclusion that the expression placed on Respondent’s dog toy is noncommercial is at odds with this Court’s decision in *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983), in which this Court articulated a multi-part test for assessing whether speech is commercial. The Ninth Circuit made no mention of *Bolger* or its standard in its decision below.

The *Rogers* test and the dilution statute each supply a flexible, speech-protective framework for balancing First Amendment and trademark interests in particular cases. Nothing in the text, history, or jurisprudence of the First Amendment suggests that it insulates from liability ordinary commercial products that are likely to confuse or dilute. No basis exists for applying the First Amendment to protect humor in the form of a dog toy that appropriates a trademark and trade dress to designate the source of the toy, and that does not clearly comment on or criticize the underlying trade dress. Rather, whether the toy is infringing or diluting is appropriately analyzed under trademark law. The Court should grant certiorari and correct the Ninth Circuit's errors.

ARGUMENT

I. THE NINTH CIRCUIT'S INFRINGEMENT ANALYSIS DIVERGES FROM OTHER FEDERAL CIRCUITS AND UPENDS THE BALANCE BETWEEN TRADEMARK LAW AND THE FIRST AMENDMENT

A. The *Rogers* Test Strikes The Right Balance By Granting First Amendment Protection Only To Artistic Works, Not Ordinary Commercial Products.

Rogers involved a Fellini film about two fictional cabaret performers who imitated renowned dancing duo Ginger Rogers and Fred Astaire. Rogers sued, claiming the film's title created the false impression that the film was about her or that she endorsed or sponsored the film. The Second Circuit recognized that the Lanham

Act applies to artistic works, but “*only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.*” *Rogers*, 875 F.2d at 998 (emphasis added). The *Rogers* court articulated this two-part test:

In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the [Lanham] Act unless [1] the title has no artistic relevance to the underlying work whatsoever, or, [2] if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.

Id. at 999.³

The court expressly recognized that this test would not protect “ordinary commercial products”:

Since consumers expect an ordinary product to be what the name says it is, we apply the Lanham Act with some rigor to prohibit names that misdescribe such goods.

Id. at 1000. The court thus made clear that an ordinary commercial product—such as Respondent’s dog toy—would not command the same protection as artistic works like movies, books, and songs. That is because consumer

3. Granting review in this case would also provide the Court the opportunity to comment on the *Rogers* test, on which this Court has not opined since the test was articulated by the Second Circuit in 1989.

confusion is a more legitimate concern when “utilitarian products” are “sold in the commercial marketplace.” *Id.* at 997.⁴

Consistent with *Rogers*, courts in the Second Circuit apply traditional trademark principles, not *Rogers*, when considering the use of a mark on commercial products (including products, like T-shirts, that contain expressive elements) and whether such use is infringing. *See, e.g., A.V.E.L.A., Inc. v. Estate of Marilyn Monroe, LLC*, 364 F. Supp. 3d 291, 309, 322 (S.D.N.Y. 2019)(rejecting application of *Rogers* to T-shirts bearing marks related to Marilyn Monroe because “the *Rogers* test is usually not the appropriate mechanism for examining an ordinary commercial product.”); *see also Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 414-15 (S.D.N.Y. 2002) (no First Amendment protection for parody dog products because it was a “somewhat non-expressive, commercial product” and “trademark law permissibly regulates misleading commercial speech.”); *see also* Pierre N. Leval, *Trademark: Champion of Free Speech*, 27:2 COLUM. J. L. & ARTS 188 (2004) (most trademark cases should be decided under trademark

4. The fact that artistic works—like films—are sold in the commerce does not change the analysis. Artistic works enjoy First Amendment protection because the public has a strong interest in enjoying the “results of the author’s freedom of expression.” *Rogers*, 875 F. 2d at 998. However, just because an ordinary commercial product contains some expression does not transform it into noncommercial speech worthy of heightened First Amendment protection. With ordinary commercial products, the public’s interest in not being misled takes precedence. *Id.* at 1000 (recognizing that courts apply the Lanham Act to commercial products “with some rigor” to avoid names that misdescribe such goods).

law, not the First Amendment, because trademark law itself balances free expression with property rights). As discussed below, all other courts other than the Ninth Circuit have consistently applied this same dichotomy between artistic works and ordinary commercial products.

B. No Other Circuit Has Applied *Rogers* To Ordinary Commercial Products, As Traditional Trademark Principles Provide Ample First Amendment Protections.

In contrast to the Ninth Circuit's steady expansion of *Rogers* beyond its origins in expressive works, other circuits have consistently reserved the heightened protections of *Rogers* to expressive works and analyzed ordinary commercial products under traditional trademark likelihood of confusion principles. As Petitioner's Petition for Writ of Certiorari sets forth in more detail, unlike the Ninth Circuit's unwarranted extension of *Rogers*, all other circuits have consistently rejected the application of a more heightened First Amendment standard to cases involving expression on ordinary commercial products. (Petition at pp. 19-22). Further, as Petitioner points out, no other circuit has applied *Rogers* to ordinary commercial products. (Petition, at pp. 22-23). Rather than repeat Petitioner's thorough discussion here, INTA refers the Court to the Petition.

However, INTA does emphasize that traditional trademark principles already afford ample protection to claimed parodists and commenters, as they often win even without the heightened protections of *Rogers*. *See, e.g., Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 674 Fed.Appx. 16 (2d Cir. 2016); *Louis Vuitton Malletier S.A.*,

507 F.3d at 263 (4th Cir. 2004); *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996). With respect to ordinary commercial products, a plaintiff in a trademark infringement suit still must carry its burden to demonstrate a likelihood of confusion, which frequently is a fact-intensive analysis.

In contrast, the Ninth Circuit's alternative approach means that any seller of an ordinary commercial product who uses a humorous message with another's mark will be wholly insulated from any potential liability so long as the mark has some artistic relevance to the product—a standard the Ninth Circuit has lowered to anything “above zero,” *E.S.S. Ent'mt 2000 Inc. v. Rock Star Videos Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008)—and does not present an overwhelming likelihood of confusion. As discussed below, such a standard fails to strike the proper balance between trademark law and the First Amendment.

C. The Ninth Circuit's Extension Of *Rogers* Wrongly Tilts The Balance Against The Application Of Trademark Law And Its Protection Of Consumers.

This case warrants review by this Court because the Ninth Circuit's approach is far out of step with all other circuits that have analyzed *Rogers* or considered trademark claims involving parodies on ordinary commercial products. It is an outlier that undermines the long-standing likelihood of confusion analysis for any product that arguably includes some expression on it. The risk from the Ninth Circuit's undue departure from all other circuits applying *Rogers* is exacerbated by the prominence and size of the Ninth Circuit and will

undoubtedly lead to forum shopping. Indeed, the Ninth Circuit has repeatedly, insupportably expanded *Rogers* such that its jurisprudence on the topic sharply conflicts with other circuits' approach.

For example, in *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192 (9th Cir. 2017), the Ninth Circuit held that EMPIRE-branded sound recordings used to market the Fox television series “Empire” (about a fictional “Empire Entertainment” company) did not infringe the trademark rights of a real-world record label named Empire Distribution, Inc. The title of the show—“Empire”—is exactly what *Rogers* was intended to protect. But INTA was troubled by the Ninth Circuit’s companion conclusion extending *Rogers* to consumer goods like shirts, glasses, and records sold under the EMPIRE trademark, even though the Ninth Circuit recognized “that these promotional efforts technically fall outside the title or body of an expressive work.” *Id.* at 1196.⁵ This decision alone splits from the Eleventh Circuit’s view that *Rogers* applies to artistic works but not related commercial products. *See Univ. of Alabama Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266 (11th Cir. 2012)(applying *Rogers* to artistic works incorporating university’s marks but not to ancillary commercial goods incorporating same marks).

But the decision below here goes substantially further. In this case, the Ninth Circuit completely untethered

5. This Court denied certiorari in the *Empire* case. *Empire Distrib., Inc. v. Twentieth Century Fox Television*, 139 S.Ct. 61 (2018). As discussed further, the Ninth Circuit’s decision below amplifies the error made in *Empire*.

Rogers from its moorings by offering First Amendment protection to a dog toy that replicates a Jack Daniel’s whiskey bottle—the precise type of “utilitarian” and “mundane” product that *Rogers* itself, and many courts since, have recognized do not merit heightened First Amendment protection. Further, the Ninth Circuit’s conclusion that any product that “communicate[s] a humorous message” is necessarily an “expressive work” with First Amendment protection, *VIP Prods. LLC v. Jack Daniel’s Properties, Inc.* (“*JDPI*”), 953 F.3d 1170, 1175 (9th Cir. 2020), clashes with decades of jurisprudence from the other circuits. As a matter of First Amendment precedent, no basis exists for this sort of near-absolute protection.

At most, humorous content on a dog toy is commercial speech subject to intermediate scrutiny, which allows trademark law to regulate such uses to advance the important interest of protecting the public from confusion. *S.F. Arts & Athletics, Inc. v. U.S. Olympic Committee*, 483 U.S. 522, 535, 541 (1987) (use of mark to induce sale of goods is “commercial speech,” which receives limited First Amendment protection”). Nothing in this Court’s free speech jurisprudence, or in the text or history of the First Amendment, supports the heightened protection afforded by the Ninth Circuit below.

To illustrate the dangers of overapplying *Rogers*, the district court in this case on remand explained its concerns with the Ninth Circuit’s jurisprudence applying *Rogers*. *VIP Prods. LLC v. Jack Daniel’s Properties, Inc.*, 2021 WL 5710730 (D. Ariz. Oct. 8, 2021). The district court concluded that based on the Ninth Circuit’s consistent expansion of *Rogers*, it “appears nearly impossible for any trademark holder to prevail under the *Rogers* test”

unless the defendant is “slapping another’s trademark on [its] own work and calling it [its] own.” *Id.* at *6. The court went so far as to say that Petitioner’s only recourse is before this Court or the U.S. Congress. *Id.*

In INTA’s view, the issue of greatest concern with *Rogers* is not necessarily the test itself but rather when it is applied. Inquiry into whether use of a trademark is “artistically relevant” makes sense in the context of a traditionally expressive work such as a movie. But the inquiry makes little sense when the expression on a defendant’s product is conceptually separable from the underlying product’s function. The expression in a book or movie—or even, potentially, a greeting card—cannot be separated from the type of work at issue. No blank novels or movies exist, and a completely blank greeting card is just notepaper. In contrast, commercial products like coffee mugs, tote bags, dog toys, or sneakers all retain their primary functionality even if all expression has been stripped from them.

The question of artistic relevance makes sense where the work and the expression are inseparable. But applying the *Rogers* test to ordinary commercial products will potentially allow parties to avoid trademark liability merely by claiming their product contains some expression, thereby enabling them to confuse consumers and trade on the goodwill of trademark owners. In INTA’s view, if a defendant asserts as a defense that its use of a plaintiff’s mark is in relation to an expressive work, the gating question under *Rogers* should be: is there protectible expression that is conceptually separable from a defendant’s underlying product—and not, as the Ninth Circuit frames the question, is there any protectible

expression at all? The rationale for this question is consistent with the underlying assumption of the *Rogers* test, that when encountering a trademark in the content or title of an expressive work, the consumer is more likely to interpret the usage as a subject of an expressive work,⁶ and less likely to interpret the usage as a source of origin, had the consumer encountered the usage of the mark in the “trademark spaces” (such as the label or packaging) of an ordinary consumer product.⁷

Allowing the Ninth Circuit’s decision below to stand unchecked will do much harm to trademark owners and consumers alike. In fact, by overapplying *Rogers* to ordinary commercial products, the Ninth Circuit’s decision below, if left intact, threatens to supplant over a century of trademark jurisprudence in favor of a test that would shield all but the most egregious infringing conduct on commercial products. Thus, this case provides a ripe opportunity to clarify the scope of *Rogers*, including the types of works that qualify as “expressive” for the application of the test.

6. For example, consumers encountering the term “The Devil Wears Prada,” presented as a movie title, are not accustomed to understanding the title to signify origin.

7. See, generally, Mark A. Lemley & Mark P. McKenna, *Trademark Spaces and Trademark Law’s Secret Step Zero*, 74 *Stan. L. Rev.* ___ (forthcoming 2022), arguing that consumers are accustomed to encountering trademarks on specific positions on a packaging, such as the neck of a bottle, which prompts them to interpret material in those spaces as sources of origin.

D. Recent Cases Illustrate The Dangers Of The Ninth Circuit’s Departure From the *Rogers* Conception of “Expressive Work” And The Need For A Definition For What Constitutes An Expressive Work.

Since the Ninth Circuit’s decision below in 2020, several cases have arisen that demonstrate both the dangers of the Ninth Circuit’s undue expansion of *Rogers*, but also the currency of the issues presented by this case and the need for this Court’s immediate review. For example, the Southern District of New York recently decided that *Rogers* did not apply to sneakers that allegedly parodied an iconic Vans shoe and found that under traditional trademark principles the Defendant MSCHF had not successfully parodied or commented on Vans’s footwear. *Vans, Inc. and VF Outdoor, LLC v. MSCHF Product Studio*, 22-cv-2156, __ F.Supp.3d __, 2022 WL 1446681 (E.D.N.Y. April 29, 2022) *appeal filed*, No. 22-1006 (2d Cir.)

There, the defendant MSCHF, a self-described artists’ collective, sold a limited-edition sneaker using a distorted version of plaintiff Vans’s sneaker trade dress as well as modified versions of several of Vans’s trademarks. *Id.* at *1. Citing the Ninth Circuit’s *JDPI* decision below for the proposition that under *Rogers*, an expressive work is any work that contains expression, MSCHF argued that *Rogers* applied. *Id.* at *7. The district court rejected this argument and ruled that MSCHF’s products were ordinary consumer products (i.e., sneakers) to which ordinary trademark principles apply. *Id.* at *5-*7. MSCHF appealed, which appeal is currently pending. INTA has submitted an amicus brief in that appeal agreeing with

the district court's refusal to apply *Rogers* to ordinary consumer products such as sneakers. It is INTA's view that the definition of "expressive work" is not, as expressed in the Ninth Circuit's decision below, solely whether there is expression, but whether that artistic expression is so intertwined with the medium of that expression (e.g., a book or movie or painting) that it cannot be conceptually separated.

Another recent decision out of New York further illustrates the need for this Court's immediate guidance on when to apply *Rogers*. See *Hermès International and Hermès of Paris, Inc. v. Rothschild*, __ F.Supp.3d __, 2022 WL 1564597 (S.D.N.Y. May 18, 2022). The court there suggested, in *dicta*, that defendant's products initially promoted as expressive works (NFTs depicting luxury handbags sold in online galleries), may lose the benefit of the *Rogers* standard if such products acquire utilitarian qualities ("virtually wearable" NFTs of luxury handbags sold for use in "virtual worlds"). *Id.* at *7, fn. 3. Defendant created and sold a METABIRKINS collection, a set of fanciful representations of plaintiff *Hermès's* coveted BIRKIN handbag. Each image file was linked to a unique "non-fungible token." NFT authentication technology has been used to, among other purposes, authenticate digital files to facilitate sale, trading, and collectability of such files.

Hermès sought to enjoin defendant's use of the METABIRKINS trademark. Defendant moved to dismiss, asserting that his digital images were expressive works and non-infringing under the *Rogers* test. The court agreed that the digital images were expressive works, but that for purposes of a motion to dismiss, *Hermès* had

pleaded sufficient facts such that it could possibly establish that defendant would fail under either prong of the *Rogers* test, namely, plaintiff could show that defendant's use of the METABIRKINS mark was not artistically relevant to his work, or (citing evidence of actual confusion), plaintiff could show that defendant's use may be explicitly misleading. *Id.* at *5-*6. The motion to dismiss was denied. *Id.* at *7.

Notably, the court also observed in a subsequent footnote:

Rogers might not apply, [defendant] seems to concede, if the NFTs were attached to a digital file of a virtually wearable Birkin handbag, in which case the "Metabirkins" mark would refer to a non-speech commercial product (albeit not one that is, as yet, considered ordinary or quotidian).

Id. at *7, fn. 3. This observation underscores that the very same work may no longer be expressive—and may become an ordinary commercial product—as the market landscape changes. For example, with the rapid proliferation of virtual videoconferencing backgrounds, one need not be a video gamer or denizen of a virtual world to encounter utilitarian virtual products now. The issue whether utilitarian virtual products are expressive works will soon be upon us.

Further, these recent cases indicate that the line between ordinary products and art is becoming increasingly blurred, in the sense that ordinary products, such as sneakers, may be appreciated for their artistic

content while digital artistic renderings of famous trade dress may devolve into the mundane and functional such that they should be treated as ordinary commercial products and not expressive works. While INTA does not speculate here whether, or how, the *Rogers* test ought to be applied to “virtually wearable handbags,” these cases illustrate the immediate need for this Court’s guidance on how to address these increasingly tangled issues between expression and commerce. The Ninth Circuit’s definition of “expressive work” as one that merely bears a modicum of expression is too broad, as discussed above. This Court should therefore fashion a definition of “expressive work” that provides heightened First Amendment protection when the expression in a product is inextricable from its primary function while applying traditional trademark principles to products where the expression may be extracted without eviscerating their primary function.

II. THE NINTH CIRCUIT’S DILUTION ANALYSIS DISREGARDS THE STATUTORY FRAMEWORK OF 15 U.S.C. § 1125(c)(3)(A).

The Court should grant *certiorari* to confirm that its own longstanding analysis for “commercial” speech, not the Ninth Circuit’s novel approach, applies under the TDRA. The TDRA contains a number of defenses—including for certain parodies, news reporting, and noncommercial uses—that already strike a balance with the First Amendment. 15 U.S.C. § 1125(c)(3). With respect to parodies, the exclusion protects parodies against claims of dilution where a defendant does not use the plaintiff’s mark as a designation of source of the defendant’s own goods.

The Ninth Circuit did not apply the parody exclusion. Instead, the Ninth Circuit applied the exclusion for noncommercial uses. It held, without substantive analysis, that the dog toy is noncommercial because Respondent’s humorous message “is protected by the First Amendment.” *JDPI*, 953 F.3d at 1176.

However, the TDRA’s noncommercial use exclusion “expressly incorporates the concept of ‘commercial’ speech from the ‘commercial speech’ doctrine, and proscribes dilution actions that seek to enjoin use of famous marks in ‘non-commercial’ uses (such as consumer product reviews).” H.R. Rep. No. 104-374, 104th Cong., at 8 (1st Sess. 1995); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 906 (9th Cir. 2002) (discussing legislative history of Lanham Act’s dilution provision). Therefore, before that exclusion can be applied, a court must first assess whether the use at issue qualifies as “commercial.”

This Court in *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983), considered three characteristics, the combination of which provides “strong support” for finding speech to be “commercial”:

- (1) Whether the material is an advertisement;
- (2) Whether the materials refer to a specific product;
- (3) Whether the speaker has an economic motive;

Id. at 66–67. This Court was mindful that “[a]dvertisers should not be permitted to immunize false or misleading product information from government regulation simply

by including references to public issues.” *Id.* at 68 (noting approvingly Justice Brennan’s concurrence in *Metromedia, Inc. v. City of San Diego*, 453 U.S. 490,540 (1981), that “those who seek to convey commercial messages will engage in the most imaginative of exercises to place themselves within the safe haven of noncommercial speech, while at the same time conveying their commercial message”).

Although this Court has not addressed the TDRA’s noncommercial use exception, other courts have applied *Bolger* to analyze whether a trademark use is “noncommercial” under the TDRA. For example, the Fourth Circuit, applied the *Bolger* factors under similar circumstances and added one more factor: “the viewpoint of the listener’, *i.e.*, whether the listener would perceive the speech as proposing a transaction.” *Radiance Foundation v. NAACP*, 786 F.3d 316, 331 (4th Cir. 2015).

Here, the Ninth Circuit did not consider *Bolger* at all. Instead, in two paragraphs, it held as a matter of law that Respondent’s dog toy was noncommercial, and therefore statutorily exempt from a claim for dilution, because the toy conveyed a “humorous message” and did “more than propose a commercial transaction.” *JDPI*, 953 F.3d at 1176. That analysis ignores the other *Bolger* factors and improperly shortcuts the analysis of whether a use is “commercial.”

Applying *Bolger* would not deprive Respondent of protections afforded by the TDRA. Just as the *Rogers* test is flexible enough to allow for appropriate results in different cases, so too is the statutory dilution framework. In *Louis Vuitton*, for example, the Fourth Circuit resolved

a claim of dilution by dog toys via parody *in the parodist's favor*. It did so solely by reference to the statute, without even mentioning the First Amendment, because the court found no risk of harm to Louis Vuitton's mark. Where harm to the distinctiveness or reputation of a famous mark has been shown, courts have enjoined parodies. See, e.g., *Louis Vuitton Malletier, S.A. v. Hyundai Motor Am.*, No. 10 Civ. 1611, 2012 WL 1022247, at *1 (S.D.N.Y. Mar. 22, 2012) (enjoining use of Louis Vuitton trade dress in commercial for Hyundai cars on dilution grounds despite claim that commercial was intended to make "a humorous, socio-economic commentary on luxury defined by a premium price tag"). The Ninth Circuit's absolutist approach, which renders any product noncommercial if it includes some expressive element, lacks any such balance.

Moreover, the Ninth Circuit not only failed to apply *Bolger*, but also unnecessarily resorted to the First Amendment. The TDRA already includes provisions balancing trademark interests with free speech. The Ninth Circuit should have applied those provisions, especially given this Court's "settled policy" to avoid unnecessary constitutional questions. *Gomez v. United States*, 490 U.S. 858, 864 (1989) (invoking doctrine of constitutional avoidance in dispute raising potential First Amendment issues).

Accordingly, this Court should grant the petition and ultimately reverse the Ninth Circuit's decision below and require that it apply *Bolger* to determine if the dog toy at issue truly contains non-commercial speech.

CONCLUSION

For the foregoing reasons, the Court should grant JDPI's petition for writ of certiorari to both clarify the definition of an "expressive work" for the application of *Rogers* and to require that the Ninth Circuit apply *Bolger* to determine if the dog toy at issue truly contains non-commercial speech.

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Respectfully submitted,

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