

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

**LEVI STRAUSS & CO. AND PATAGONIA
INC.'S *AMICUS CURIAE* BRIEF
IN SUPPORT OF PETITIONER**

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Patagonia, Inc. (“Patagonia”) and Levi Strauss & Co. (“Levi Strauss”) submit this brief in support of the petition for certiorari by Jack Daniel’s Properties, Inc. (“JDPI”).¹

**LEVI STRAUSS’S AND PATAGONIA’S INTERESTS
IN THE PETITION FOR CERTIORARI**

Patagonia and Levi Strauss use their brands to speak to consumers about public issues. In a world littered with confusing parodies, uncertainty about the source of speech associated with products like VIP Products’ dog toy inevitably will erode the effect and public confidence with which brand owners deliver their own expression to consumers. The Ninth Circuit’s *VIP Products* decision arms “parodists” with a right to take advantage of famous brands but fails to consider the adverse consequences such uses will have on the free speech rights of parties who built the brands, or the right of the public to know the source of expression.

Patagonia and Levi Strauss own purpose-driven brands supported by logos that they use to identify their commercial businesses, but also to convey their respective values that traverse a range of public interests and issues. These companies use their brands to promote expressive messages on their apparel and other products, and throughout all channels of public discourse in connection

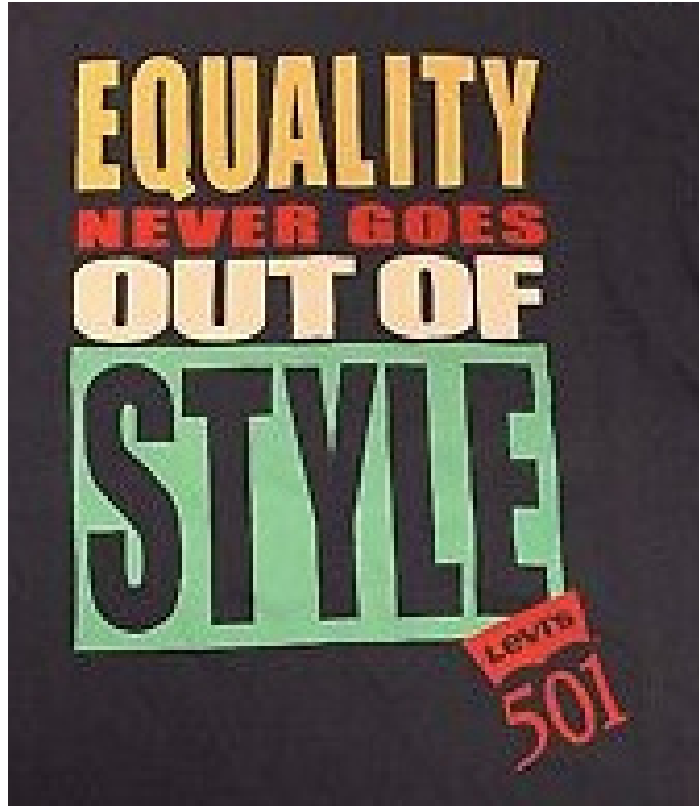
1. More than 10 days prior to the filing deadline, Patagonia and Levi Strauss gave the parties notice of their intention to file an amicus brief. Both parties consented. S. Ct. R. 37.2(a). Amici and their counsel are the sole authors of this brief. No party or counsel for a party, and no person other than amici and their counsel, made a monetary contribution intended to fund the preparation or submission of this brief. S. Ct. R. 37.6.

with charitable foundations, documentary films, public education on environmental and equality issues, books, and other public commentary. They deliberately have aligned their reputations with important causes that they and their employees support. Patagonia, whose owners just gave away their full stake in the company to fight climate change, is “in business to save our home planet.” Levi Strauss promises to “conduct its business ethically and demonstrate leadership in satisfying [its] responsibilities to our communities and to society.” Both express and reinforce these missions in countless ways when they communicate with consumers through their brands, products and trademarks.

These efforts range from policy and cultural issues to political messages: The following images illustrate examples of values to which Levi Strauss and Patagonia have attached their brands:





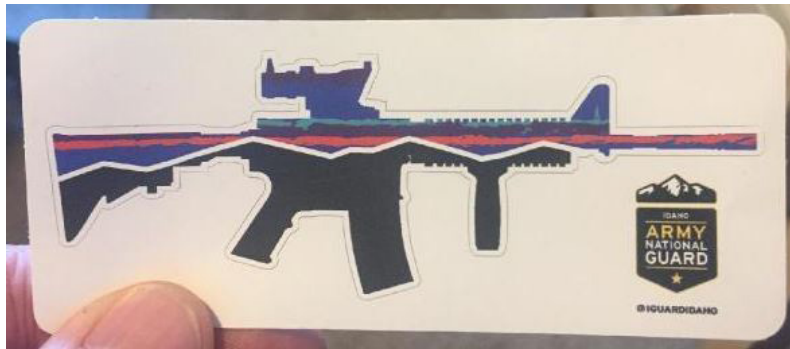


The amici's ability to have an impact depends entirely on the public's ability to perceive – with clarity – the messages and values they sponsor, and those they do not. Some messages do not so clearly originate from these trademark owners, as each from time to time adopts a counter-commercial message to help prioritize its social values to consumers and the public. For example:



The Ninth Circuit’s blanket approval of confusing expressions will create substantial conflict and uncertainty for companies like Patagonia and Levi Strauss. These companies, like many others, have robust (and costly) trademark enforcement programs, and a great deal of experience with the novel strategies and tactics that infringers use to justify and excuse confusing renditions of their brands. The ease with which so-called parodies can be produced (e.g., in print on demand shops), commercialized, and sold through online platforms has flooded the market with products that compete directly with products put out – and speech authored – by trademark owners. The Ninth Circuit’s “cover” for uses, such as those shown below and thousands like them, threatens an enormous burden for trademark owners to preserve their own ability to communicate clearly with the public through their brands and the public’s ability to know what they stand for (and just as importantly, what they may not stand for).





Levi Strauss and Patagonia support JDPI's request that the Court grant a writ of certiorari because, under the Ninth Circuit's decision, questions about their ability to stop these uses, in their home Districts, otherwise will be answered without regard to whether the uses – some undeniably exploited for commercial purposes – cause source confusion or are destructive of consumer associations with their brands.

SUMMARY OF ARGUMENT

Patagonia’s and Levi Strauss’s support for the Petition centers on the Ninth Circuit’s failure to consider a trademark owner’s or the public’s constitutional rights when it invalidated the District Court’s straightforward application of the Lanham Act. The Ninth Circuit concluded the Lanham Act fails to balance free speech interests adequately against harms caused by consumer confusion, importing an analysis from the *Rogers v. Grimaldi* case,² and relying on it to override Congress’s regulation of infringement and dilution. These amici, and other trademark owners, have constitutional rights to speak through their brands, and the public has a constitutional right to know the source of such expression. The Ninth Circuit failed to consider these rights.

The Ninth Circuit’s application of *Rogers* (a) identifies a sacrosanct speech right that protects production of commercial dog toys that, to help with sales, repurpose well-known brands as a source of humor; (b) extends this right even to uses that are confusing; and (c) ignores the countervailing constitutional rights of the trademark owner to use its marks in like expression and the public’s right to know the source of such expression. The Ninth Circuit’s favoritism for the constitutional rights of the parodist, which the court overstates without adequate analysis, cannot be reconciled with the First Amendment or this Court’s prior holdings regarding permissible source identification regulations adopted by Congress.

2. *Rogers* requires the plaintiff to show 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.”

The Lanham Act protects trademark owner's and the public's constitutional rights to free speech by regulating confusing information about the source of speech involving trademarks and brands. After the Ninth Circuit's decision, however, a parodist's use of a trademark that is likely to cause consumer confusion about the source of the product is now "irrelevant," unless the trademark owner can satisfy the *Rogers* test, proving that the mimicked logo, mark, or brand was not used for *any* expressive purpose, or the parodist *explicitly* misrepresented the source. This use of *Rogers* creates a judicially-invented filter on the Lanham Act that deliberately bypasses Congress's restriction on the likelihood use of a trademark will cause source confusion (in this case, substantial likely confusion). Neither prong of this filter on the Lanham Act is grounded in the statute and neither affords any effective guidance about what speech is immune from regulation. As to the "artistic relevance" prong, only a singularly unimaginative seller could fail to raise issues about whether there is "any" relationship between its expressions and the famous brand it is exploiting. And as to the second prong, most "parodists" are not sufficiently confessional to "explicitly" misrepresent to the public that the trademark owner authored their expression.

The Ninth Circuit's extension of *Rogers v. Grimaldi* has no meaningful limits because its decision also disregards the line between commercial and noncommercial speech assumed by the Lanham Act. The Ninth Circuit overrode Congress's recognition that "parodies" may be commercial and should only receive limited immunity (and limited immunity that only applies to dilution claims). In singularly summary fashion, the court ruled there is no such thing as a "commercial" parody despite the contrary

and only plausible construction of the statutory language. The Ninth Circuit magnified this error by extending this reasoning to the constitutional issue, holding that *any* expressive content in the use of a brand is “noncommercial” and is accorded full constitutional protection. This ruling ignores this Court’s prior rulings that identify speech as “commercial” – and subject to regulation – even though it may contain noncommercial elements. Had the Ninth Circuit properly distinguished between noncommercial and commercial speech, it would have affirmed the district court’s infringement and dilution judgments.

Lower courts have floundered on the proper analysis for parody and other expressive use of trademarks since *Rogers* was decided more than 30 years ago, producing different outcomes in different circuits on these important questions. The Ninth Circuit’s extreme decision shows that the law in the circuits continues to diverge and is not moving toward any common framework in which all relevant stakeholders’ rights are considered. The Court should grant certiorari and intervene in this ever-widening gulf between the balance Congress struck in the Lanham Act and the rules that now apply in the Ninth Circuit.

ARGUMENT

I. TRADEMARK OWNERS HAVE FIRST AMENDMENT RIGHTS TO USE THEIR MARKS FOR EXPRESSIVE PURPOSES

Like the supposed parodist, a brand owner’s First Amendment rights are not limited to op-eds it might publish. In addition to the vast array of other forms of speech – whether in furtherance of a company’s business,

social, or political interests – this Court has confirmed that the *trademark itself* – and the adoption and use of that mark – is a form of expression that warrants protection. In *Matal v. Tam*, 137 S. Ct. 1744, 1760 (2017), this Court concluded that regulation of “disparaging” trademarks violates the First Amendment. The trademark itself is protected speech, and Congress therefore cannot reject federal trademark applications based on the content of proposed marks (despite the limited impact on the trademark owner’s speech caused by a refusal to register).

In treating trademarks as expressive speech, the Court recognized that a mark may serve a range of purposes for its owner, including political, social, critical, and creative ones. The Court stated: “[T]rademarks often have an expressive content. Companies spend huge amounts to create and publicize trademarks that convey a message. It is true that the necessary brevity of trademarks limits what they can say. But powerful messages can sometimes be conveyed in just a few words.” *Matal*, 137 S. Ct. at 1760. “[T]rademarks do not simply identify the source of a product or service but go on to say something more, either about the product or service or some broader issue.” *Id.* at 1764; *see also Iancu v. Brunetti*, 139 S. Ct. 2294, 2306 (2019) (First Amendment prevents regulation of “scandalous” marks).

The Court was clear-eyed, however, that constitutional rights associated with trademarks would remain subject to the Lanham Act’s mission, to safeguard their source identification function. After observing that trademarks “have an expressive component in addition to a commercial one” Justice Breyer explained in his concurring *Iancu* opinion:

[T]rademark law, is a highly regulated one with a specialized mission: to “hel[p] consumers identify goods and services that they wish to purchase, as well as those they want to avoid.” As I have noted, that mission, by its very nature, requires the Government to impose limitations on speech. Trademark law therefore forbids the registration of certain types of words—for example, those that will likely “cause confusion,” or those that are “merely descriptive.” 15 U.S.C. §§ 1052(d), (e). For that reason, an applicant who seeks to register a mark should not expect complete freedom to say what she wishes but should instead expect linguistic regulation.

139 S. Ct. at 2306 (internal citations omitted).

The Ninth Circuit’s application of the *Rogers* test to confusing expressions of a logo or brand ignores trademark owners’ right to speak freely through their brands (and to have their brands identify them as the authors of expressive speech). By holding the *Rogers* test must be met for “any” purported expression, and avoiding the likelihood of confusion analysis altogether, the Ninth Circuit’s rule prefers the parody over the trademark owner’s right to free expression. The brand owner’s First Amendment rights play second fiddle to the “parodist’s” rights or, more accurately, are not considered at all. The test abandons a fundamental mission of the Lanham Act to enable trademarks to identify the trademark owner as the source of a message and dispenses entirely with legitimate “linguistic regulation” that protects the marketplace.

II. THE PUBLIC HAS A RIGHT TO KNOW THE SOURCE OF SPEECH

The First Amendment also protects speech for the sake of the recipient. While the First Amendment makes no mention of a right “to listen,” “to hear,” or “to know,” this Court has determined that First Amendment protection “is to the communication, to its source and to its recipients both.” *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 756 (1976). Where one enjoys a right to speak, others hold a “reciprocal right to receive” that speech, which “may be asserted” in court. *Id.* at 757.

A long line of cases recognizes this right to hear. In *Lamont v. Postmaster General*, 381 U.S. 301 (1965), this Court confirmed the First Amendment rights of citizens to receive political publications sent from abroad. In *Kleindienst v. Mandel*, 408 U.S. 753, 762-763 (1972), this Court acknowledged that the First Amendment includes a right to “receive information and ideas,” and that freedom of speech “necessarily protects the right to receive” (internal citations omitted). And in *Procunier v. Martinez*, 416 U.S. 396 (1974), where censorship of prison inmates’ mail was under examination, this Court ruled it was unnecessary to examine the rights of the inmates themselves, because censorship of their letters infringed the rights of non-inmate recipients of the correspondence. Numerous other decisions are to the same effect. *See, e.g., Red Lion Broadcasting Co. v. FCC*, 395 U.S. 367, 390 (1969) (“It is the [First Amendment] right of the viewers and listeners, not the right of the broadcasters, which is paramount.”); *Stanley v. Georgia*, 394 U.S. 557, 564 (1969) (“It is now well established that the Constitution protects

the right to receive information and ideas. This right to receive information and ideas, regardless of their social worth, is fundamental to our free society.”); *Griswold v. Connecticut*, 381 U.S. 479, 482 (1965); *Marsh v. Alabama*, 326 U.S. 501, 505 (1946); *Thomas v. Collins*, 323 U.S. 516, 534 (1945); *Martin v. City of Struthers*, 319 U.S. 141, 143 (1943) (freedom of speech “embraces the right to distribute literature and necessarily protects the right to receive it” (citation omitted)).

Fundamental to the recipient’s right to hear is the right to know the speaker’s identity. The Ninth Circuit’s decision, however, disregards the consumer’s right to not be confused about the source of products – or the messages or expressive content they bear. Source confusion, the central focus of the Lanham Act, inherently interferes with consumers’ rights to know the source of the speech, including the trademark owner’s speech and even the parodist’s speech. The purported parodist’s joke is compromised if the audience likely believes it was the brand owner who authored it.

These are not hypothetical concerns. This Court has stated that the consumer’s right to hear – and specifically, the right to know who is producing commercial products – is fundamental to the functioning of an effective democracy. In the context of commercial advertising, the First Amendment protects the right to hear due to the need for public “information as to who is producing and selling what product, for what reason, and at what price” to allow for informed participation in and regulation of the economy. *Va. State Bd. of Pharmacy*, 425 U.S. at 765. The allocation of resources in our economy, the Court reasoned, will be made largely through private economic decisions.

Id. “It is a matter of public interest that those decisions, in the aggregate, be intelligent and well informed.” *Id.* The Ninth Circuit’s decision tramples on this “strong interest” by subordinating the Lanham Act’s safeguards against confusing expression. *See id.* at 764.

Similarly, in the context of political speech and campaign advertising, this Court has recognized the importance of ensuring that “voters are fully informed about the person or group who is speaking.” *Citizens United v. Fed. Election Comm’n*, 558 U.S. 310, 326 (2010). “Identification of the source of advertising may be required as a means of disclosure, so that the people will be able to evaluate the arguments to which they are being subjected.” *First Nat. Bank of Boston v. Bellotti*, 435 U.S. 765, 792, n. 32 (1978). Forcing the public to hear parodic (or cultural, critical or political) expression with no safeguard against confusing source information compromises its ability to meaningfully evaluate the messages it receives.

The Ninth Circuit, by elevating the parodist’s interests, even in confusing expression, over the trademark owner’s own expression also has compromised the public’s right to reliable source identification. It has offered no rationale for why a joke, humorous message, or other confusing expression by an interloper to a brand’s goodwill and recognition is more important than the brand owner’s use of its mark to convey its own values or produce expressive works under its brand that can be understood by consumers. Ultimately, the Ninth Circuit’s preference for the parodist’s confusing expression harms the public and undoes the very premise of an equal exchange of information and ideas that the Ninth Circuit purports to uphold.

III. THE NINTH CIRCUIT'S TEST DOES NOT CONSIDER THE TRADEMARK OWNER'S OR THE PUBLIC'S INTERESTS IN FREE SPEECH

The Ninth Circuit's test pays no attention to the trademark owner's free speech interest in using its marks for expressive purposes, or the public's First Amendment rights to know the source of speech. Both rights are vindicated primarily through the source identification protections that are implemented by the likelihood of confusion prohibitions in the Lanham Act. *Rogers'* first prong requires a finding that the expression is "not artistically relevant to the underlying work." *VIP Prods. LLC v. Jack Daniel's Properties, Inc.*, 953 F.3d 1170, 1174 (9th Cir. 2020). The requirement is nearly impossible to satisfy with any degree of certainty as the Ninth Circuit views the expression as sufficiently relevant if one can articulate "juxtaposition" of an "irreverent" (or presumably ironic, critical, or political) representation of the mark in place of the "idealistic" representation the trademark owner supposedly would make. *Id.* This requirement gives no consideration to the possibility that the trademark owner itself may make irreverent, critical or political commentary through the mark. It ignores that the "parodist" may be using the parody as its own source indicator (a factor Congress thought was relevant when it afforded limited protection of parodies from the antidilution provisions of the Lanham Act) and ignores the prospect the "expression" may be more a commercial lure than an "artistic" choice. The impact such circumstances may have on likely consumer confusion is "irrelevant" in the Ninth Circuit; confusion is discarded in favor of a standard of "artistic relevance" that has no textual support.

The second *Rogers*' prong focuses on whether expressive content is "explicitly" misleading about source. Again, this limitation does not arise from any "construction" of the statutory language. The legislative text prohibits "use in commerce" of a "registered mark" or "term, name, symbol, or device, or any combination thereof," if such use causes "likely" source confusion. 15 U.S.C. §§ 1114, 1125. Certainly, an explicit misrepresentation may cause likely confusion, but the long-established tests for confusion focus on the impact such use has on consumers, not on whether the author lied about source. An express misrepresentation is not a condition for likely confusion under any reasonable construction of the text. "Counterfeits" and "willful" infringements, to which such "explicit" misrepresentations might be relevant, receive different treatment (15 U.S.C. §§ 1117(a), (c)), but these are not requirements for infringement under the plain text of the statute.

This Court's *McConnell* and *Citizen's United* decisions upheld regulations that, beyond merely forbidding misleading statements, required the source of important political speech to be affirmatively disclosed. See *McConnell v. Fed. Election Comm'n*, 540 U.S. 93 (2003); *Citizens United*, 558 U.S. 310. These decisions are impossible to square with the Ninth Circuit's conclusion that Congress may not stop the source confusion caused by VIP Products' misleading expressions. The same public interest is at stake: preventing speakers from "hid[ing] behind dubious and misleading names...." *McConnell*, 540 U.S. at 196-97; *Citizen's United*, 558 U.S. at 367. In validating these rules against a constitutional challenge, the Court relied on "*the competing First Amendment interests* of individual citizens seeking to make informed

choices in the political marketplace.” *McConnell*, 540 U.S. at 197 (emphasis added); *see also San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*, 483 U.S. 522, 534–35 (1987) (where “the possibility for confusion as to sponsorship is obvious” and petitioner had “sought to exploit the ‘commercial magnetism’ of the term, ‘Congress’ decision to grant the USOC a limited property right in the word ‘Olympic’ falls within the scope of trademark law protections, and thus certainly within constitutional bounds.”).

The Court’s conclusion that Congress legitimately may regulate even the most important speech against efforts to disguise or hide its source speaks directly to the Ninth Circuit’s overreach in immunizing commercial, if expressive, use of marks that confuse consumers. The Ninth Circuit should have recognized the constitutional rights in trademark owners and the public, and “rigidly adhered” to the tenet “never to formulate a rule of constitutional law broader than is required by the precise facts to which it is to be applied.” *See United States v. Raines*, 362 U.S. 17, 21 (1960) (citation omitted), cited in *McConnell*, 540 U.S. at 192.

IV. COURTS MAY NOT SIMPLY SUBSTITUTE THEIR “BALANCE” OF FIRST AMENDMENT INTERESTS FOR CONGRESS’S CHOICES, AT LEAST WITHOUT A FOUNDATION IN THE TEXT OF THE STATUTE

Courts may rescue laws from constitutional defects by “choosing between competing plausible interpretations of a statutory text, resting on the reasonable presumption that Congress did not intend the alternative which raises

serious constitutional doubts.” *Clark v. Martinez*, 543 U.S. 371, 381 (2005). Courts may not, however, simply rework a law with its own “balancing” tests – particularly tests that do not include the full range of important relevant interests that Congress sought to protect. Courts “may impose a limiting construction on a statute only if it is readily susceptible to such a construction.” They may not “rewrite a law to conform it to constitutional requirements, for doing so would constitute a serious invasion of the legislative domain.” *United States v. Stevens*, 559 U.S. 460, 481 (2010) (citations omitted).

The Ninth Circuit’s unrestrained approach, however, is explicit that the two *Rogers* prongs control and that courts may not incorporate any analysis of likely confusion as the text of the law would require. *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1242 (9th Cir. 2013) (“We have previously rejected the “likelihood of confusion” test as ‘fail[ing] to account for the full weight of the public’s interest in free expression’ when expressive works are involved.”) (citations omitted). In the Ninth Circuit, the *Rogers* test is the “only relevant legal framework for balancing the public’s right to be free from consumer confusion.” *Id.*; see also *VIP Prods. LLC*, 953 F.3d at 1174 (“[T]he Lanham Act only applies to expressive works if the plaintiff establishes one of the two requirements in the test set forth in *Rogers v. Grimaldi*.”).

Numerous other Courts of Appeal have fastened their First Amendment concerns about parodies to the Lanham Act’s text by applying their likelihood of confusion tests with due regard for the possibility that parodic or other expressive uses of others’ marks may affect the analysis of source confusion. Pet. at 18-22, citing cases

from the Second, Fourth, Fifth, Seventh, Eighth, and Tenth Circuits. This makes sense: the factor tests that have developed over decades assess likely confusion in specific factual contexts that vary across many relevant dimensions. Other tests have developed regarding concepts of “fair use” that bear on free speech interests, but with a clear view to the impact on likely source confusion. Nominative fair use, for example, that does not use the marks in a manner likely to convey the trademark owner’s sponsorship of the message, is protected speech. *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302 (9th Cir. 1992). Classic fair use or use of generic terms is protected because such uses are not confusing. *See, e.g., Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150-51 (9th Cir. 2002). In none of these contexts have courts deemed it necessary to depart from the Lanham Act’s basic mission to guard against source confusion.

Insisting that “likely confusion” tests still apply to claimed expression, as other circuits have required, reflects a plausible constitutional framework for “construing” Congress’s proscription of likely source confusion. In addition to grounding the constitutional analysis in the statutory text as required, this approach also accommodates the need to consider other important stakeholders whose First Amendment rights are affected by expressive works that are misleading about their source.

V. THE NINTH CIRCUIT FAILED TO CONSIDER CONGRESS'S RECOGNITION OF COMMERCIAL PARODIES OR THIS COURT'S PRECEDENTS REGARDING COMMERCIAL SPEECH, INFECTING ITS DECISION ON ALL ISSUES

Congress unequivocally identified parodies like the “Bad Spaniels” parody of JDPI’s mark as worthy, at most, of “commercial” speech protection when it adopted the Trademark Dilution Revision Act. *See* Trademark Dilution Revision Act of 2006, Pub. L. 109-312, 120 Stat. 1730 (“TDRA”). If VIP Products’ dog toy parody was “commercial” – even if funny – the Ninth Circuit should have affirmed both the infringement and the dilution awards. Instead, in no more than a few sentences, the Ninth Circuit relied on obsolete statutory construction and disregarded this Court’s constitutional precedents discussing “commercial” and “noncommercial” speech. It rejected both the infringement and dilution awards on grounds that all parodies are inherently “noncommercial” and entitled to full-fledged First Amendment protection.

Congress provided immunity for dilution caused by “noncommercial uses of a mark.” 15 U.S.C. § 1125(c) (3)(C). In the TDRA, Congress also adopted a partial immunity for fair use of parodies. *Id.* (immunizing fair use “identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner”). Congress recognized, however, that some parodic or critical expressions remain dangerous to famous marks. It limited the parody immunity from antidilution provisions, accordingly, to uses “other than as a designation of source for the person’s own goods or services.” *Id.* at § 1125(c)(3)(A).

The separate immunities for “noncommercial” use and “parodies” means that, at most, a parody used to designate the parodist as a source of commercial goods is “commercial” speech. The limitation on this immunity is meaningless if all parodies are “noncommercial” because parodies would then be swept up in the immunity for “noncommercial” uses even if a parody were used as a source indicator. “A statute should be construed so that effect is given to all its provisions, so that no part will be inoperative or superfluous, void or insignificant....” *Hibbs v. Winn*, 542 U.S. 88, 101 (2004) (quoted in *Corley v. United States*, 556 U.S. 303, 314 (2009)); see also *Bailey v. United States*, 516 U.S. 137, 146 (1995) (“We assume that Congress used two terms because it intended each term to have a particular, nonsuperfluous meaning.”).

Congress was well within its rights to regulate confusing parodies as constituting, at most, commercial speech under both the infringement and dilution sections of the statute.³ This Court has held that the presence of noncommercial content does not mean that speech automatically is afforded full First Amendment protection. *Bolger v. Youngs Drug Prod. Corp.*, 463 U.S. 60, 67–68 (1983). In *Bolger*, mailers promoted the sale of contraceptives and discussed public health and policy issues. The Court concluded – despite the presence of noncommercial speech elements – that the mailers only would receive the limited protection accorded commercial speech. *Id.* (“The mailings constitute commercial speech notwithstanding the fact that they contain discussions of important public issues such as venereal disease and family

3. Congress afforded no immunity for parodies likely to cause source confusion.

planning.”) (footnotes and citations omitted); *see also* *Central Hudson Gas & Electric Corp. v. Public Service Comm’n*, 447 U.S. 557, 563, n. 5 (noting that advertising which “links a product to a current public debate” is not thereby entitled to the constitutional protection afforded noncommercial speech); *San Francisco Arts & Athletics*, 483 U.S. at 541 (“The SFAA’s expressive use of the word [“Olympics”] cannot be divorced from the value the USOC’s efforts have given to it. The mere fact that the SFAA claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to ‘appropriate[e] to itself the harvest of those who have sown.’” (citation omitted)); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 592–93 (1994) (approving Congress’s requirement that a fair use defense for parody of a copyrighted work include consideration of the commercial impact caused by the alleged infringement).

In *VIP Products*, the Ninth Circuit relied on its prior *MCA* decision for its expansive interpretation of the “noncommercial” speech immunity from antidilution protections. *VIP Products*, 953 F. 3d at 1176, citing *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 906 (9th Cir. 2002). *MCA*, however, was decided under the Federal Trademark Dilution Act (“FTDA”) (the predecessor to the TRDA), holding then that the “noncommercial” exemption to dilution extended to any uses that are not “wholly” commercial. 296 F.3d at 906–07 (“Barbie Girl is *not purely* commercial speech and is therefore *fully* protected.”) (emphasis added). This logic, if extended from song titles and lyrics to parodies as *VIP Products* held, would mean that all parodies are “noncommercial,” as parodies inherently contain at least some expression.

Nothing was proper about the Ninth Circuit’s cursory importation of *MCA*’s reasoning into its *VIP Products* holding that the dog toy parody was “noncommercial” and entitled to effective immunity from the source confusion and antidilution provisions of the Lanham Act. Whatever merit *MCA* may have had under the FTDA, the statute did not then expressly address immunity for parodies. The limited parody immunity – and the unambiguous inference that Congress considered parodies used to indicate source, at most, to be “commercial” speech – first appeared in 2006 when Congress passed the TDRA. When the Ninth Circuit expanded this immunity to funny dog toys, it failed to consider the obsolescence of the *MCA* holding on this point, or Congress’s inescapable intention to regulate parodies that are used by parodists as a source identifier.⁴

The Ninth Circuit instead settled for reasoning that speech short of the Mona Lisa might be entitled to full noncommercial speech protection under the First Amendment. *VIP Prods. LLC*, 953 F.3d at 1175. The ‘Mona Lisa’ straw man, however, reflects nothing more than a truism. It does not answer whether Congress constitutionally might regulate “commercial” parodies or, as Congress required here, commercial parodies found to

4. This cavalier treatment of the TDRA and the Ninth Circuit’s expansion of the *Rogers v. Grimaldi* doctrine did not start with *VIP Products*. *E.g. E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008); *Twentieth Century Fox Television a division of Twentieth Century Fox Film Corp. v. Empire Distribution, Inc.*, 875 F.3d 1192, 1196–97 (9th Cir. 2017). None of these decisions, including *VIP Products*, contemplate the possibility of “commercial” and “noncommercial” parodies, even though the only plausible construction of the Lanham Act since 2006 is that both types of parodies must be recognized.

be used by the parodist as a source identifier. The statute and this Court's First Amendment decisions differentiating between "commercial" and "noncommercial" speech compel the conclusion that Congress was within its power to regulate source identifying parodies, and to subject parodies that consist of commercial speech (such as those used to sell dog toys) to the Lanham Act's prohibition of infringement. The District Court was right when it found both infringement and dilution.

VI. THE COURT SHOULD GRANT THE PETITION FOR CERTIORARI AND DIRECT LOWER COURTS TO RECONCILE THE LANHAM ACT'S PROTECTIONS WITH A PROPER BALANCE OF FIRST AMENDMENT AND STATUTORY INTERESTS

Rogers v. Grimaldi is more than three decades old. *VIP Products* is only the most recent of the Ninth Circuit's persistent expansion of *Rogers*. Even the Second Circuit appears to have forsaken any argument that likely confusion is "irrelevant," holding long ago that a parody raising a "strong" likelihood of source confusion remains subject to the Lanham Act. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Grp., Inc.*, 886 F.2d 490, 494 (2d Cir. 1989). "A parody must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is *not* the original and is instead a parody. To the extent that it does only the former but not the latter, it is not only a poor parody but also vulnerable under trademark law, since the customer will be confused." *Id.*

The Ninth Circuit did not follow even this lead. Its test for "expressiveness" has expanded to the point where it now ignores the distinction between commercial and

noncommercial speech, while becoming increasingly unequivocal that the Lanham Act will not apply in any context involving “expression” unless the *Rogers* test is “first” met. Meanwhile other Circuits have concluded that Congress achieved a constitutional balance when it regulated parodies and other expression likely to cause confusion. Pet. at 24-26.

Some amici have suggested the case law should “percolate” in the lower courts before the tension in these approaches is resolved. *See, e.g.*, Brief amicus curiae of Trademark Law Professors at 5 (Dec. 16, 2020). At this point, the competing doctrines have percolated enough. In free speech cases there is a value to having federal courts operate within the same framework as it will increase the uniformity in outcomes and avoid forum shopping. The Court should step in when “the Old No. 2” represents the free exercise of a cherished right while “Buttwiper” is punished as trademark infringement. *VIP Prods. LLC*, 953 F.3d 1170; *Anheuser-Busch, Inc. v. VIP Prods. LLC*, 666 F. Supp. 2d 974 (E.D. Mo. 2008).

This Court’s ruling in this case, if a writ of certiorari is granted, will not end the development of these principles. There will be ample opportunity for constructive “percolation” of factors that protect non-confusing parodies if the Ninth Circuit’s error is remedied. Fundamental issues must be accounted for, however, about the import of the trademark owner’s and the public’s First Amendment rights, as well as appropriate limitations on the courts’ review of “commercial” parodies. It is vital for the courts, including two of the most important trademark circuits that are wayward on these issues, to operate within the same, proper analytical framework as these factors develop in the case law.

CONCLUSION

The cost to develop meaningful trademarks is enormous and requires decades of investment and effort to establish a public audience worthy of a parody. Trademark owners, of course, should be able to take a joke but not at the cost of their own source identifiers or the public's understanding of their speech. The Court should grant the petition and remedy the Ninth Circuit's errors.

Respectfully submitted,

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