

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 IN OPPOSITION**

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## **QUESTIONS PRESENTED**

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

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

**CORPORATE DISCLOSURE STATEMENT**

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

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## INTRODUCTION

It is ironic that America’s leading distiller of whiskey both lacks a sense of humor and does not recognize when it—and everyone else—has had enough. Petitioner Jack Daniel’s Properties Inc. (“JDPI”) has waged war against Respondent VIP Products LLC for having the temerity to produce a pun-filled parody of JDPI’s iconic bottle—the Bad Spaniels Silly Squeaker dog toy. In the playful parodic tradition that has ranged over a half century from Topps’s Wacky Packages trading cards through ‘Weird Al’ Yankovic, VIP put out a chewable dog toy. VIP has never sold whiskey or other comestibles, nor has it used “Jack Daniel’s” in any way (humorously or not). It merely mimicked enough of the iconic bottle that people would get the joke.



JDPI is now back before this Court for the second time. In 2021, this Court denied JDPI’s petition challenging the Ninth Circuit’s order to the district court to apply the *Rogers* test (named after *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989)) to JDPI’s trademark-infringement claim, and to enter judgment for VIP on JDPI’s trademark-dilution claim. To obtain the Ninth Circuit’s summary affirmance of the district court’s judgment for VIP on both claims, JDPI waived any “challenge [to] the district court’s post-remand ruling on appeal.” Doc. 14-1 at 15. So what this Court has now before it is *exactly* the same as what it had before. JDPI has deliberately forgone appellate review of the only potentially distinguishing element, i.e., the district court’s determination that the

*Rogers* test favors VIP—a result that JDPI once told this Court was a sure bet.<sup>1</sup>

Another thing that has not changed is JDPI’s failure to demonstrate an intercircuit conflict. Every circuit that has addressed the issue has adopted the *Rogers* test to reconcile trademark rights with First Amendment rights. No other circuit has held that the *Rogers* test does not apply to products like VIP’s parody dog toy. The Ninth Circuit did not perceive that it was creating or perpetuating a circuit conflict, and no other circuit has recognized a conflict or criticized the Ninth Circuit’s ruling. In fact, to find even critical *nonjudicial* commentary, JDPI had to resort to citing articles written by counsel for its amici. JDPI is left arguing that other circuits have not yet applied the *Rogers* test to similar goods, or that they have rejected claims like JDPI’s on other grounds. Neither is surprising, given the small number of cases that have addressed the infrequently raised issues presented here. But neither reflects a circuit conflict warranting this Court’s review at this time.

The unanimous Ninth Circuit panel decided this case correctly, and not one of the nearly thirty Ninth Circuit active judges even called for a vote each time JDPI sought rehearing en banc. There is no dispute by any party or any court in this case that the Bad Spaniels parody dog toy is an expressive work. The Ninth Circuit correctly held that the *Rogers* test applies to the facts here. The Ninth Circuit also correctly held that the Bad Spaniels parody

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1. JDPI assured this Court in its prior petition that the Ninth Circuit’s holding that the *Rogers* test applied was “outcome-determinative” and “dispose[s] of the case,” Pet. 30, No. 20-365, and reiterated in its reply that the issue was “case-dispositive,” Reply Br. 8, No. 20-365.

was noncommercial speech under this Court’s commercial-speech doctrine and therefore was exempted from liability under the statutory “noncommercial use” exception of the Trademark Dilution Revision Act of 2006 (“TDRA”), 15 U.S.C. § 1125(c)(3)(C).

In reality, JDPI’s (and its amici’s) quarrel is not with the Ninth Circuit’s manifestly correct rulings below, but with the balance Congress and the courts have struck between trademark rights and First Amendment rights, and with the principle that the First Amendment does not permit “the trademark owner ... to control public discourse” about its trademark. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002). If JDPI and its amici are concerned about competitors’ marketing alcoholic beverages or marijuana-laced cookies to children, *see, e.g.*, Pet. 7, 28–29, 31, they should sue those parties. VIP sells a dog toy called “Bad Spaniels Silly Squeaker” with a picture of a dog and no reference to alcohol, and the only people who would understand what was being parodied are people already familiar with whiskey. No one—not a child, not a dog—is going to be harmed by VIP’s parody. If there is some grand principle at stake, this is simply not the right case to be raising it. The petition for certiorari should be denied.

## STATEMENT

1. VIP designs, manufactures, markets, and sells dog toys. Pet App. 26a, 46a. Among its product offerings is a parody line branded “Silly Squeakers®.” *Id.* VIP’s Silly Squeakers line includes a variety of toys in the shapes of beer, wine, soda, and liquor bottles. Pet. App. 47a–48a. Among them is the Bad Spaniels Silly Squeaker. Pet. App. 48a.



VIP designed the Bad Spaniels Silly Squeaker to be a comical parody of the Jack Daniel's black-label whiskey. Pet. App. 69a. As the Ninth Circuit stated, "VIP's purported goal in creating Silly Squeakers was to 'reflect' 'on the humanization of the dog in our lives,' and to comment on 'corporations [that] take themselves very seriously.'" Pet. App. 26a. The district court acknowledged that VIP owner Stephen Sacra's "intent behind producing the Silly Squeakers line of toys was to develop a creative parody on existing products." Pet. App. 47a.

To accomplish the parodic effect, the Bad Spaniels Silly Squeaker invokes elements of the Jack Daniel's black-label whiskey bottle and artistically transforms those elements in order to communicate the parody. "Jack Daniel's" becomes "Bad Spaniels," "Old No. 7" becomes "Old No. 2," and "Tennessee whiskey" becomes "Tennessee carpet." References to alcohol content are transformed into "43% POO BY VOL." and "100% SMELLY". Pet. App. 48a. Bad Spaniels approximates the shape and size of a Jack Daniel's black-label whiskey bottle but features the picture of, in the district court's words, a "wide-eyed spaniel." Pet. App. 48a.

2. In September 2014, JDPI "demand[ed] that VIP cease all further sales of the Bad Spaniels toy." Pet. App. 26a. VIP promptly filed the present action for a declaratory judgment that its parody of the Jack Daniel's whiskey bottle "does not infringe or dilute any claimed trademark rights" of JDPI. Pet. App. 26a. JDPI counterclaimed for an injunction and generally asserted that the Bad Spaniels Silly Squeaker infringed and diluted JDPI's trademarks. Pet. App. 26a-27a.

3. In September 2016, the district court denied VIP’s motion for summary judgment, rejecting VIP’s First Amendment defenses, including its noncommercial-use and fair-use defenses, e.g., the fair-use defense based on parody. Pet. App. 49a–50a. Although the district court found that Bad Spaniels was an expressive work, the court refused to apply the *Rogers* test and the TDRA’s noncommercial-use exception, leaving for a bench trial all of JDPI’s counterclaims. Pet. App. 50a.

The district court found that VIP used an “adaptation” of JDPI’s trademark and trade dress “for the dual purpose of making expressive comment as well as the commercial selling of a non-competing product.” Pet. App. 89a. It found Bad Spaniels to be a predominantly expressive work—the court said that it was only “somewhat non-expressive,” Pet. App. 90a— developed by a creative artist whose intent “was to develop a creative parody,” Pet. App. 46a–47a. Yet the court rejected VIP’s First Amendment defenses because VIP sold the parody as “a commercial product, its novelty dog toy.” Pet App. 90a.

In May 2018, following a four-day bench trial, the district court permanently banned the parody, enjoining VIP “from sourcing, manufacturing, advertising, promoting, displaying, shipping, importing, offering for sale, selling or distributing the Bad Spaniels dog toy.” Pet. App. 27a, 42a.

4. The Ninth Circuit, in a unanimous panel decision, reversed the district court’s judgment and remanded “because the Bad Spaniels dog toy is an expressive work entitled to First Amendment protection.” Pet. App. 25a; *VIP Prods. LLC v. Jack Daniel’s Props., Inc.*, 953 F.3d

1170, 1172 (9th Cir. 2020). The court of appeals reversed and vacated the district court’s permanent injunction; held that the parody dog toy constituted a noncommercial use such that it did not dilute JDPI’s mark by tarnishment as a matter of law; held that the parody dog toy was an expressive work to which the *Rogers* test applied; and remanded for application of that test in the first instance. *Id.*

In determining whether the Bad Spaniels parody was an expressive work, the Ninth Circuit analyzed “whether the work is ‘communicating ideas or expressing points of view.’” Pet App. 30a–31a (indirectly quoting *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987)). The court noted that the “work need not be the expressive equal of *Anna Karenina* or *Citizen Kane* to satisfy this requirement, and is not rendered non-expressive simply because it is sold commercially.” Pet. App. 31a (cleaned up).

Applying these settled standards, the Ninth Circuit held “the Bad Spaniels dog toy, although surely not the equivalent of the *Mona Lisa*, is an expressive work.” Pet App. 31a. As the court explained, Bad Spaniels is a humorous parody of the original:

The toy communicates a “humorous message,” using word play to alter the serious phrase that appears on a Jack Daniel’s bottle—“Old No. 7 Brand”—with a silly message—“The Old No. 2.” The effect is “a simple” message conveyed by “juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.”

*Id.* (citations omitted). The Ninth Circuit quoted the First Circuit’s decision in *L.L. Bean*, which afforded First Amendment protection to a message “that business and product images need not always be taken too seriously.” *Id.* (quoting *L.L. Bean*, 811 F.2d at 34).

The Ninth Circuit noted that “[t]he fact that VIP chose to convey this humorous message through a dog toy is irrelevant.” Pet. App. 32a (citing *Hurley v. Irish-Am. Gay, Lesbian & Bisexual Grp. of Bos.*, 515 U.S. 557, 569 (1995)). The Ninth Circuit also observed that it was not the first court to find that dog toys can be “successful parodies” of well-known brands, pointing to the Fourth Circuit’s conclusion that a parody dog toy did not infringe as a matter of law. *Id.* (discussing *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007) (affirming summary judgment for dog-toy maker)).

JDPI sought rehearing en banc. Pet. App. 21a. The Ninth Circuit denied rehearing, with not a single judge even requesting a vote. *Id.*

5. JDPI then filed a petition for certiorari raising the precise issues raised here: whether the *Rogers* test should be applied to VIP’s Bad Spaniels Silly Squeaker, and whether the dilution claim was barred under the noncommercial-use exception. As now, that petition was supported by numerous amicus briefs submitted by trademark owners and their organizations. This Court denied the petition. Pet. App. 20a.

6. On remand, the district court followed the Ninth Circuit’s mandate. It entered judgment for VIP on the dilution claim, and it entertained briefing on

the consequences of applying the *Rogers* test to the infringement claim. The district court concluded what JDPI had predicted: the *Rogers* test required judgment for VIP. Pet. App. 11a–18a. It then entered judgment for VIP. Pet. App. 3a.

7. On appeal, JDPI requested summary affirmance so that it could bring yet another petition for rehearing en banc and yet another petition for certiorari. Pet. App. 2a. To accomplish that it, JDPI waived any challenge to the district court’s application of the *Rogers* test. Doc. 14-1 at 15. Granting that wish, the Ninth Circuit panel summarily affirmed. Pet. App. 2a. Yet again, not a single Ninth Circuit judge called for a vote on JDPI’s petition for rehearing en banc. Pet. App. 1a.

This successive, repetitive petition followed.

## **REASONS FOR DENYING THE PETITION**

### **I. There Is No Circuit Conflict or Split on the Application of the *Rogers* Test to Expressive Works.**

As to JDPI’s infringement claim, the only issue the Ninth Circuit decided was whether the Bad Spaniels parody was an expressive work to be evaluated under the *Rogers* test. The unanimous panel answered in the affirmative and remanded the case to the district court for application of the test. Particularly in light of JDPI’s express waiver of any appeal of the district court’s application of the *Rogers* test, the only issue presented by the petition whether there is a current disagreement among the circuits on the standard that should govern application of the Lanham Act to expressive works. There is not.

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

The Bad Spaniels Silly Squeaker is quintessential parody, that is, “a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.” *L.L. Bean*, 811 F.2d at 34.

“Parody is a form of artistic expression covered by the First Amendment.” 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:153 (5th ed. 2022). Parody is a form of satire, which “is a long-established artistic form that uses means such as ridicule, derision, burlesque, irony, parody, or caricature to censure the vices, follies, abuses, or shortcomings of an individual or society.” *Farah v. Esquire Mag.*, 736 F.3d 528, 536 (D.C. Cir. 2013) (cleaned up). “Although satire has been employed since the time of Ancient Greece, it remains one of the most imprecise of all literary designations—a notoriously broad and complex genre whose forms are as varied as its victims.” *Id.* (cleaned up). The D.C. Circuit explained, “Sometimes satire is funny. Othertimes it may seem cruel and mocking, attacking the core beliefs of its target. And sometimes it is absurd ...” *Id.* (citations omitted). Thus, it is well established that “[t]he fact that the joke on [the plaintiff’s] luxury image is gentle, and possibly even complimentary [to the plaintiff], does not preclude it from being a parody.” *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 674 F. App’x 16, 18 (2d Cir. 2016).

Because VIP’s Bad Spaniels Silly Squeaker is a classic parody, it *had* to borrow enough from JDPI’s iconic bottle to make the parody work. The D.C. Circuit

recognized that, as with other forms of satire, in parody “the style of an individual or work is closely imitated for comic effect or in ridicule.” *Id.* As this Court held, “Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim’s (or collective victims’) imagination ....” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580–81 (1994). Whether the “parody is in good taste or bad does not and should not matter,” and even though the Court “might not assign a high rank to the parodic element here,” the standard is whether the defendant’s work “reasonably could be perceived as commenting on the original or criticizing it, to some degree.” *Id.* at 583. “[A] parody enjoys First Amendment protection notwithstanding that not everybody will get the joke.” *Gold v. Att’y Gen. of N.Y.*, 870 F.3d 89, 102 (2d Cir. 2017).

JDPI has always admitted that VIP’s Bad Spaniels Silly Squeaker is a parody: it acknowledged to this Court that Bad Spaniels constitutes a “humorous use of another’s trademark” and “imitates a Jack Daniel’s whiskey bottle, while adding poop humor.” Pet. 4–5. Indeed, because owning dogs is meant to be fun, parody products are ubiquitous in the dog-merchandise industry. “The pet owner who sees a line of products for pet dogs under names that parody elegant and high-fashion marks, such as CHEWNEL #5, DOG PERIGNON, SNIFFANY & CO. and CHEWY VUITON, is not likely to mistakenly think that those famous high-fashion houses are making or authorizing the dog accessories.” 6 *McCarthy on Trademarks, supra*, § 31:154.

As the Ninth Circuit appreciated, that the parody is in the form of a dog toy that is sold to the public does not

render “non-expressive” for First Amendment purposes. Pet. App. 31a–32a; *see also* *Brown v. Ent. Merchs. Ass’n*, 564 U.S. 786, 790 (2011) (“[T]he basic principles of freedom of speech ... do not vary when a new and different medium for communication appears.” (quotation omitted)); *City of Lakewood v. Plain Dealer Publ’g Co.*, 486 U.S. 750, 756 (1988) (“Of course, the degree of First Amendment protection is not diminished merely because the ... speech is sold rather than given away.”). Indeed, a dog toy is a fairly plastic medium for expression, including parody. A dog toy is defined by its function, and its successful performance turns on whether a dog could or would chomp on it without choking on stray pieces. The dog toy could come in any shape or color a canine might safely enjoy, from a bone to the Venus de Milo.

JDPI and its amici belittle dog toys as “utilitarian” or “ordinary commercial products,” but the line between dog toys and greeting cards, parody study guides, calendars, and video games—to which the *Rogers* test has been applied—becomes indefensible when the parodic element is entirely independent of the underlying tangible vehicle of expression in artistic and functional dimensions. *See, e.g., 6 McCarthy on Trademarks, supra*, § 31:144.50 (“The *Rogers* test is used if the mark is used in any expressive context.”) (collecting cases).

Here, VIP used its dog toys as a canvas for parodying, among others, an iconic (and, from its petition, self-obsessed) whiskey brand. It did what ‘Weird Al’ Yankovic did when he parodied Coolio’s *Gangsta’s Paradise* with *Amish Paradise*, or what Topps has done to hundreds of similarly iconic brands since 1967, through its Wacky Packages trading cards and stickers that parody similarly



iconic consumer products, from “Ratz Crackers,” “Jolly Mean Giant,” “Gulp Oil,” “Lame O Lakes,” and “Miracle Weep” to “Battletime Beer,” “Blast Blew Ribbon Beer,” “Muller Beer,” “Jim Mean Kentucky Sharp Broken Whiskey,” “Old Grand-Mom Whiskey,” and “South Beached Whale Diet.” At the height of their popularity, Wacky Packages outsold Topps baseball cards, when they were by far the most-sold trading card items in the United States.<sup>2</sup> Yet the world did not end.

JDPI complains that VIP’s Bad Spaniels Silly Squeaker bore on its hang tag a disclaimer of affiliation in too small a font, Pet. 12, but that is irrelevant. “There is no requirement that the cover of a parody carry a disclaimer that it is not produced by the subject of the parody, and we ought not to find such a requirement ....” *Cliff Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 496 (2d Cir. 1989). This is not a case where someone claimed a parody just by using the claimant’s mark on an inapt product—VIP did not put “Jack Daniel’s” on a dog toy as the sum total of the would-be parody. That Bad Spaniels Silly Squeaker is a parody is obvious from “Bad Spaniels,” the cartoon dog, and the other humorous transformations of the original.

This case is not really about confusion. It is about trademark owners who do not like being parodied—however gently—and do not enjoy that their brands’ iconic

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2. This Court may take judicial notice of such generally known background facts under Fed. R. Evid. 201. *See, e.g., Wacky Packages*, WIKIPEDIA, [https://en.wikipedia.org/wiki/Wacky\\_Packages](https://en.wikipedia.org/wiki/Wacky_Packages) (last visited Oct. 14, 2022); *Wacky Packages Alphabetized Crosslist*, <https://wackypacks.com/stickers/alphabetical.html> (last visited Oct. 14, 2022).

character makes them subject to parody that they cannot control. But “the last thing we need, the last thing the First Amendment will tolerate, is a law that lets public figures keep people from mocking them.” *Cardtoons, L.C. v. Major League Players Ass’n*, 95 F.3d 959, 972–73 (10th Cir. 1996) (quoting *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1519 (9th Cir. 1993) (Kozinski, J., dissenting)).

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

Given that Bad Spaniels Silly Squeaker is an expressive work, there is no cert-worthy conflict presented here because every circuit that has addressed the issue has adopted the Second Circuit’s *Rogers* test to resolve infringement claims that target expressive works. “[W]here artistic expression is at issue, [courts] have expressed concern that the traditional [likelihood-of-confusion] test fails to account for the full weight of the public’s interest in free expression.” *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018) (cleaned up). When a mark is used in an expressive work, courts assess likelihood of confusion in a different way because “First Amendment concerns” must “inform [a court’s] consideration of the scope of the [Lanham] Act as applied to claims involving” expressive works. *Rogers*, 875 F.2d at 998.

In the seminal 1989 *Rogers* decision, the Second Circuit articulated a two-part test for assessing whether the use of a mark in an expressive work is “likely to cause confusion” within the meaning of the Lanham Act. Such a use, even if found to be likely confusing under the traditional analysis, is not actionable unless (1) the use has

“no artistic relevance to the underlying work whatsoever,” or (2) the work “explicitly misleads as to the source or the content of the work.” *Rogers*, 875 F.2d at 999. Applying the *Rogers* test is straightforward: “the only threshold requirement for the *Rogers* test is an attempt to apply the Lanham Act to First Amendment expression.” *Twentieth Century Fox Television v. Empire Distrib. Inc.*, 875 F.3d 1192, 1198 (9th Cir. 2017). Contrary to JDPI’s repeated assertion, the *Rogers* test does not abandon all reference to likelihood of confusion, *e.g.*, Pet. 33, but rather channels that element through the standard of whether the work, even if it has artistic relevance, “explicitly misleads as to the source or content of the work.”

*Rogers* is illustrative. That case involved a Federico Fellini film called *Ginger and Fred* about “two fictional Italian cabaret performers ... who, in their heyday, imitated” Ginger Rogers and Fred Astaire and so “became known in Italy as ‘Ginger and Fred.’” *Rogers*, 875 F.2d at 996–97. Ginger Rogers sued, alleging that the film’s title violated the Lanham Act “by creating the false impression that the film was about her or that she sponsored, endorsed, or was otherwise involved in the film.” *Id.* at 997. Despite survey evidence showing likely confusion and evidence of actual confusion, *id.* at 1001, the court found no infringement because the use was artistically relevant to the work, and the work did not “explicitly mislead[] as to the source or content of the work,” *id.* at 999.

The *Rogers* test was a sea change in how courts treat Lanham Act infringement claims involving expressive works. When presented with the opportunity, every circuit court has adopted or endorsed the *Rogers* test to

determine infringement in cases involving expressive works. “The Second Circuit’s *Rogers* balancing test is now widely used by almost all courts.” 6 *McCarthy on Trademarks, supra*, § 31:144.50 (collecting cases). “No courts have rejected the *Rogers* test.” Lynn M. Jordan & David M. Kelly, *Another Decade of Rogers v. Grimaldi: Continuing to Balance the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 109 Trademark Rep. 833, 834–35 (2019).

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

The *Rogers* analysis was followed in *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 339 (E.D. Pa. 1996), which the Third Circuit affirmed without opinion, 156 F.3d 1225 (3d Cir. 1998) (mem.); *see also Hidden City Philadelphia v. ABC, Inc.*, 2019 WL 1003637, at \*3 (E.D. Pa. Mar. 1, 2019) (applying *Rogers* to dismiss state-law claim of trademark infringement against expressive use of title of video website).<sup>3</sup>

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3. In *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008), the Third Circuit decided not to apply the *Rogers*

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

The year after the Ninth Circuit adopted the *Rogers* test, the Sixth Circuit followed suit. *Parks v. LaFace Records*, 329 F.3d 437, 450 (6th Cir. 2003) (holding that the likelihood-of-confusion and “alternative means” tests do not give sufficient weight to the public interest in freedom of expression). Then, in *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915, 936–37 (6th Cir. 2003), the Sixth Circuit applied the *Rogers* test to the use of a Tiger Woods’s likeness in a painting of Woods at The Masters golf tournament. The court held that even though “[s]ixty-two percent” of survey respondents indicated they thought Woods was affiliated or connected with,

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test because it held the alleged infringement was not protected expression. Nevertheless, the court ruled for the defendant, overturning summary judgment for the plaintiff on the traditional factors and remanding for trial. *Id.* at 1024–25.

approved, or sponsored the painting, *id.* at 937 n.19, “[t]he risk of misunderstanding, not engendered by any explicit indication on the face of the print, is so outweighed by the interest in artistic expression as to preclude application of the [Lanham] Act,” *id.* at 937.

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

The Eleventh Circuit adopted the *Rogers* test in *University of Alabama Board of Trustees v. New Life Art, Inc.*, 683 F.3d 1266 (11th Cir. 2012), stating that “we have no hesitation in joining our sister circuits by holding that we should construe the Lanham Act narrowly when deciding whether an artistically expressive work infringes a trademark.” *Id.* at 1278. The court held that the defendant’s painted depictions of the University’s trademarked uniforms in unlicensed paintings, prints, and calendars were protected expression under the *Rogers* test. *Id.* at 1279.<sup>4</sup>

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4. Contrary to the misimpression left by one amicus, *see* INTA Br. 13, the Eleventh Circuit did not apply the *Rogers* test to mugs, towels, flags, or apparel solely because the defendant did not argue on appeal for First Amendment protections for those items and, given that waiver, “we need not address those issues with respect to” those items. *Id.* at 1279, 1282–83.

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

In short, there is no circuit disagreement on the central question at issue in this case: the standard that governs analysis of Lanham Act infringement claims involving expressive works. The Ninth Circuit did not perceive a conflict, and no subsequent circuit has criticized the Ninth Circuit’s decision below. Cases that do not even address whether to apply the *Rogers* test, which JDPI and its amici repeatedly cite, do not create a conflict based on what they did *not* consider. Moreover, to find even critical *nonjudicial* commentary on the Ninth Circuit’s decision, JDPI has cited works that fall short of compelling authority: articles written by counsel for JDPI’s own amici (without disclosure of that association),<sup>5</sup> law-student and new-graduate notes,<sup>6</sup> and an apparently subscriber-only news “report” on the “debate,” including amicus arguments.<sup>7</sup> Pet. 32.

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5. Jared I. Kagan, *Bad Spaniels Make Bad Law: Ninth Circuit Says Dog Toy is an Expressive Work Entitled to First Amendment Protection*, IPWatchdog (Apr. 3, 2020); Jared I. Kagan & Emily R. Hush, *Parody Chew Toys and the First Amendment*, *Landslide*, Jan./Feb. 2021.

6. Hannah Knab, Note, *Jack Daniel’s Highlights the Second and Ninth Circuit’s Divide on the Application of the Rogers Test*, 10 *Am. Bus. L. Rev.* 517 (2022); Zachary Shufro, *Based on a True Story: The Ever-Expanding Progeny of Rogers v. Grimaldi*, 32 *Fordham Intell. Prop. Media & Ent. L.J.* 391 (2022).

7. Muireann Bolger, *Applying the Rogers Test: A Step Too Far?*, *World Intell. Prop. Rev.*, June 7, 2022.



### C. JDPI's cases do not represent a circuit split.

JDPI argues that the Ninth Circuit, by applying the *Rogers* test to VIP's Bad Spaniels Silly Squeaker, has created a conflict with the Second, Seventh, and Eighth Circuits. Pet. 6–7, 18–22. Specifically, JDPI relies on those circuits' decisions in *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806 (2d Cir. 1999); *Nike, Inc. v. "Just Did It" Enterprises*, 6 F.3d 1225, 1228 n.3 (7th Cir. 1993); and *Mutual of Omaha Insurance Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987). None of them comes close to a conflict. Certainly the Ninth Circuit did not perceive a conflict, and for good reason: two of the courts did not even acknowledge the *Rogers* test, and the third declined to apply it because the facts were clearly distinguishable.

The Second Circuit in *Harley-Davidson* cited its prior decision in *Rogers*, explaining that “[w]e have accorded considerable leeway to parodists whose expressive works aim their parodic commentary at a trademark or a trademarked product.” 164 F.3d at 812. The court declined to apply *Rogers* because there was humor but no parody: defendant’s “mark makes no comment on Harley’s mark; it simply uses it somewhat humorously to promote his own products and services, which is not a permitted trademark parody use.” *Id.* at 813. The defendant had directly used Harley’s bar-and-shield logo in advertisements, first by a “hand-drawn copy of the bar-and-shield logo, with the name ‘Harley-Davidson’ displayed on the horizontal bar”; then, after Harley’s complaints, with “Harley-Davidson” replaced by “American-Made” and an added banner “UNAUTHORIZED DEALER”; then with eagle’s wings behind the shield, which “was apparently patterned after Harley-Davidson’s bicentennial logo design mark”; and



finally with a pig wearing sunglasses. *Id.* at 809. *Harley-Davidson* would be more relevant if someone put out a dog toy labeled “Jack Daniel’s,” without any parodic transformation. That is not this case.

Indeed, more recently, the Second Circuit distinguished its decision in *Harley-Davidson* in affirming summary judgment for the alleged infringer in *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 674 F. App’x 16 (2d Cir. 2016). “At the same time that [the defendant’s tote bags] mimic LV’s designs and handbags in a way that is recognizable, they do so as a drawing on a product that is such a conscious departure from LV’s image of luxury—in combination with the slogan ‘My other bag’—as to convey that MOB’s tote bags are *not* LV handbags.” *Id.* at 18. Citing *Harley-Davidson*, the court noted, “That distinguishes this case from ones ... where a trademark was used merely to ‘promote’ or ‘sell’ goods and services, which is impermissible.” *Id.* at 18. Again, that is not this case.

JDPI’s citations to the Seventh Circuit’s opinion in *Nike* and the Eighth Circuit’s opinion in *Mutual of Omaha* are even more perplexing, since those opinions did not address whether to apply the *Rogers* test at all. *Nike* involved a defendant who sold t-shirts and sweatshirts “with a ‘swoosh’ design identical to Nike, Inc.’s, but with the word Mike instead,” and marketed such shirts to people named “Michael.” 6 F.3d at 1226. The defendant, who was himself named “Michael,” “admitted that his ‘whole point’ was to give someone viewing from a distance the impression that the shirt actually read NIKE.” *Id.* at 1227. The opinion mentions *Rogers* only as the object of “citing” in a footnote reference, and the Seventh Circuit

did not address whether *Rogers* should be applied. The court observed only that Nike “assumes with neither citation nor argument that parody is an affirmative defense,” while the district court had cited *Cliffs Notes*, which cited *Rogers*, as employing a balancing test. *Id.* at 1228 n.3. The court reversed summary judgment for Nike, holding that whether MIKE was intended as a parody rather than mere passing off was a question for the jury. *Id.* at 1232.<sup>8</sup>

Finally, the Eighth Circuit’s opinion in *Mutual of Omaha* is even more easily disposed of. The opinion concerned an obvious parody—the defendant used “Mutant of Omaha” along with “a side view of a feather-bonneted, emaciated human head” and the words “Nuclear Holocaust Insurance.” 836 F.2d at 398. But the opinion could not create a conflict as to whether to apply the *Rogers* test because it antedated *Rogers* by two years.<sup>9</sup> Moreover, the so-called “alternative means” test employed by *Mutual of Omaha* has been discredited in favor of the *Rogers* approach, and it was rejected by *Rogers* itself. *Rogers*, 875 F.2d at 998; *see also Parks*, 329 F.3d at 448–49, 450 (6th Cir.) (“reject[ing] the alternative avenues test” because it does not “accord[] adequate weight to the First

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

9. The same is true of other pre-*Rogers* cases cited by JDPI. *See, e.g., Jordache Enters. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987).

Amendment interests”); *Westchester Media*, 214 F.3d at 672 n.18 (5th Cir.) (explicitly rejecting *Novak*’s “alternative means test”). *Mutual of Omaha* does not justify certiorari here.

Simply put, there is no circuit split to resolve. Every circuit court to consider the issue has either adopted or endorsed *Rogers* and no circuit court has rejected it. JDPI is left with cases that antedated *Rogers* or did not address the test. That does not create a *current* circuit split.

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

The unanimous Ninth Circuit panel scrupulously followed settled precedent in holding that the Bad Spaniels parody dog toy constitutes First Amendment expression subject to the *Rogers* test. The courts are virtually unanimous in holding that, in the expressive context, *Rogers* must be applied “as a rule of construction to avoid conflict between the Constitution and the Lanham Act.” *Gordon*, 897 F.3d at 1190.

JDPI argues the opposite, contending that the Lanham Act’s statutory language mandates using the traditional likelihood-of-confusion test in every case of infringement, even those involving expressive works: “No language in the statute permits a court to require that [*Rogers*] showing in every case of humorous infringement.” Pet. 33. But JDPI’s focus on whether the defendant’s message was merely “humorous” is a red herring. The question, as the Ninth Circuit recognized, is not merely whether the defendant’s use of a mark was “humorous,” but whether the defendant produced a true parody, i.e.,

“create[d] a transformative work with new expression, meaning or message.” Pet. 32a (cleaned up). The Ninth Circuit correctly concluded that VIP did so here.

What JDPI fails to acknowledge is that the *Rogers* approach, like the traditional approach, is an interpretation of when the use of a mark in an expressive work is “likely to cause confusion.” 15 U.S.C. § 1125(a)(1)(A). The *Rogers* approach is simply a recognition that different considerations come into play when assessing likelihood of confusion in the context of an expressive work. This is also why JDPI’s characterization of the *Rogers* approach as a judicial exception that “clashes with the Lanham Act’s structure” also misses the mark. Pet. 33. Congress did not need to make an exception to trademark infringement liability under 15 U.S.C. § 1125(a) because the *Rogers* test is simply an interpretation of subsection 1125(a) in the context of expressive works.

The Lanham Act does not furnish any particular formula for evaluating whether the use of a mark is “likely to cause confusion.” 15 U.S.C. § 1125(a)(1)(A). The circuit courts have developed sets of factors to consider in determining whether confusion is likely in a typical case of related, purely commercial products. Compare *AMF Inc v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979) (listing Ninth Circuit factors), with *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (listing Second Circuit factors). Even these various “catalogue[s]” of factors do “not exhaust the possibilities—the court may have to take still other variables into account.” *Polaroid*, 287 F.2d at 495; see *Sleekcraft*, 599 F.2d at 348 n.11 (“The list is not exhaustive. Other variables may come into play depending on the particular facts presented.”).

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

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

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

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

With respect to its dilution claim, this case is in precisely the same posture as it was when this Court denied JDPI’s prior petition for certiorari. The Ninth Circuit held that VIP was entitled to judgment as a matter of law, and it remanded for entry of judgment on mandate. Despite the finality of the Ninth Circuit’s ruling, this Court denied certiorari. It should do so again.

JDPI accuses the Ninth Circuit of “adopting” a broad reading of the TDRA’s statutory noncommercial-use exception, suggesting that no other circuit would find the Bad Spaniels expressive parody a “noncommercial use.” Pet. 25–26. That is at best the prediction of a *future* circuit conflict, which militates against grant of certiorari at this time. In any event, JDPI is incorrect. The Ninth Circuit properly applied this Court’s commercial-speech doctrine to the speech at issue and correctly held an obvious parody to be fully protected, noncommercial speech such that the TDRA’s noncommercial-use exception applied.

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

The TDRA “provides three broad, overlapping categories within which any use of a famous mark, even if likely to cause harm or blurring, is not actionable: fair use; news reporting and news commentary; and noncommercial use.” *Radiance*, 786 F.3d at 330 (citing 15 U.S.C. § 1125(c) (3) and holding that the noncommercial-use exemption precluded the NAACP’s dilution-by-tarnishment claim even though it made a *prima facie* showing of dilution).<sup>10</sup>

To determine whether the alleged dilutive use falls within the noncommercial-use exemption, the courts, including the Ninth Circuit, uniformly apply this Court’s commercial-speech doctrine. *See, e.g., Radiance*, 786 F.3d at 331 (“The term ‘noncommercial’ refers to the First Amendment commercial speech doctrine.”). And contrary to JDPI’s contention, the courts decide this legal issue as a matter of law. *See, e.g., Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 65 (1983) (“[W]e must first determine the proper classification of the [speech] at issue here.”); *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 515 (7th Cir. 2014) (“classifying [speech] as commercial or noncommercial speech for constitutional purposes ... is a legal question”).

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

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

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

Contrary to JDPI’s contention, this approach is not at odds with the Fourth Circuit’s approach. See *Radiance*, 786 F.3d at 331 (“The term ‘noncommercial’ refers to the First Amendment commercial speech doctrine.”). Indeed, courts uniformly use this Court’s commercial-speech doctrine to determine whether the speech at issue falls within the TDRA’s statutory noncommercial-use exemption. See *Chooseco LLC v. Netflix, Inc.*, 439 F. Supp. 3d 308, 324 (D. Vt. 2020) (“This [noncommercial-use] ‘exemption incorporates the concept of commercial speech from the commercial speech doctrine.’”) (quoting *MCA Records*); *Liberty Counsel, Inc. v. Guidestar USA, Inc.*,



2018 WL 10323724, at \*3 (E.D. Va. Jan. 23, 2018) (“The term ‘noncommercial’ refers to the First Amendment commercial speech doctrine.”) (quoting *Radiance*, 786 F.3d at 331), *aff’d*, 737 F. App’x 171 (4th Cir. 2018).

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

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

JDPI’s suggestion that Bad Spaniels would be deemed commercial speech under the Fourth Circuit’s three-part *Bolger* analysis (or that the Ninth Circuit does not use that analysis to aid in determining the issue) is simply incorrect. First, the Ninth Circuit does use the *Bolger* analysis in cases that present “close questions,” *Dex Media W., Inc. v. City of Seattle*, 696 F.3d 952, 958 (9th Cir. 2012) (quoting *Hunt v. City of Los Angeles*, 638 F.3d 703, 715 (9th Cir. 2011)), which this case decidedly does not.

Second, the Bad Spaniels parody dog toy does not qualify as commercial speech under the factors identified

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

The Bad Spaniels Silly Squeaker “is not advertising the product; it *is* the product.” *Hilton v. Hallmark Cards*, 599 F.3d 894, 905 n.7 (9th Cir. 2010); *see also Am. Acad. of Pain Mgmt. v. Joseph*, 353 F.3d 1099, 1106 (9th Cir. 2004) (first *Bolger* factor met only if “the speech is admittedly advertising”). In short, “[e]ven the most cursory examination of [Bad Spaniels] reveals that it is not ‘concededly an advertisement’ and ... it does not refer to a specific product.” *Dex Media*, 696 F.3d at 959. VIP is not offering or selling bottles of anything, much less bottles of “Old No. 2” that contain “43% POO BY VOL.”

That leaves the final factor, economic motivation. VIP did want to sell Bad Spaniels Silly Squeaker (as do most, if not all, artists and parodists<sup>11</sup>), but “the fact that [VIP] has

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

an economic motivation for [creating Bad Spaniels] would clearly be insufficient by itself to turn [it] into commercial speech.” *Bolger*, 463 U.S. at 67 (citing *Bigelow v. Virginia*, 421 U.S. 809, 818 (1975)).

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

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

*Id.*

JDPI attempts to distinguish *Radiance* on the basis that the speech there involved social criticism, but it fails

to acknowledge that “[p]arody is regarded as a form of social and literary criticism, having a socially significant value as free speech under the First Amendment.” *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1400 (9th Cir. 1997); *see also Cliffs Notes*, 886 F.2d at 493 (“parody and satire are deserving of substantial freedom—both as entertainment and as a form of social and literary criticism”). “Parody is a humorous form of social commentary and literary criticism that dates back as far as Greek antiquity.” *L.L. Bean*, 811 F.2d at 28. And at least since the advent of *Wacky Packages* trading cards in the 1960s, parodying famous brands has been part of American culture.

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

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

JDPI also contends that the Ninth Circuit erred and created a circuit conflict by applying the TDRA’s statutory noncommercial-use exception under 15 U.S.C. § 1125(c)(3)(C) without also requiring satisfaction of the statutory fair-use parody defense under 15 U.S.C. § 1125(c)(3)(A). Pet. 25–26, 37. That argument misstates the law. The Ninth Circuit explained in its detailed examination in *MCA Records* of the TDRA’s legislative history that the statute contains “three statutory exemptions [for] uses that, though potentially dilutive, are nevertheless permitted: comparative advertising; news reporting and commentary; and noncommercial use.” 296 F.3d

at 904. As the statute’s plain language and the cases construing it make clear, these defenses can be asserted in the alternative (as VIP did below), and the failure to satisfy the requirements of one defense does not preclude application of another. *See, e.g., MCA Records*, 296 F.3d at 904 (holding “[t]he first two exemptions clearly do not apply” but the noncommercial-use exemption did).

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

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

4 *McCarthy on Trademarks, supra*, § 24:128; *see also Radiance*, 786 F.3d at 330 (explaining that “[t]he law provides three broad, overlapping categories within which any use of a famous mark, even if likely to cause harm or blurring, is not actionable,” and holding that the exemption precluded the dilution claim despite evidence of dilution). For example, McCarthy notes that though an allegedly dilutive use does not fall within the statutory fair-use

exception, “[e]ven if the accused use is a trademark use, a parody can still be immune under free speech principles from liability for dilution by tarnishment.” 4 *McCarthy on Trademarks*, *supra*, § 24:90 (collecting cases).

**D. JDPI’s cases do not represent a circuit split.**

JDPI struggles to identify a circuit split under the TDRA, and it ultimately cites a grand total of two circuit cases that it argues reflect a conflict. Pet. 26–26. But neither of those cases stand for the proposition that failure to satisfy the fair-use parody defense under 15 U.S.C. § 1125(c)(3)(A) precludes the court from applying the noncommercial-use exception in 15 U.S.C. § 1125(c)(3)(C). In *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 113 (2d Cir. 2009), the court considered only the fair-use defense under subsection (A), and never addressed whether the noncommercial-use exception in subsection (C) applied in that case. The same thing happened in *Haute Diggity Dog*—the Fourth Circuit never addressed whether the noncommercial-use exception applied in that case. 507 F.3d at 266.

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

**CONCLUSION**

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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