

No. 22-148

IN THE
SUPREME COURT OF THE UNITED STATES

JACK DANIEL'S PROPERTIES, INC.,
Petitioner,

v.

VIP PRODUCTS LLC,

Respondent.

**On a Writ of Certiorari to the
United States Court of Appeals for the
Ninth Circuit**

**BRIEF OF CONSTELLATION BRANDS, INC. AS
AMICUS CURIAE IN SUPPORT OF PETITIONER**

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INTEREST OF *AMICUS CURIAE*¹

Constellation Brands, Inc. is a market leader in consumer packaged goods. Founded in 1945 in upstate New York, Constellation has achieved its enviable position by creating powerful brands and delivering best-in-class customer experiences and consumer products. Constellation’s portfolio of beer, wine, and spirits products includes many well-known consumer brands, including Corona, Modelo, Pacifico, Kim Crawford, Robert Mondavi, Ruffino, Svedka, and High West. Each embodies Constellation’s core mission: build brands and products people love.

Constellation has a significant interest in this case because the Ninth Circuit’s decision in *VIP Prod. LLC v. Jack Daniel’s Properties, Inc.*, 953 F.3d 1170 (9th Cir. 2020), Pet.App.22a-34a, represents the latest and most radical example of the judicial branch rewriting parts of the Lanham Act. Over the years, certain courts (most notably the Ninth Circuit) have created and widened an “expression” loophole that has no support in the statutory text and which strips the Lanham Act of much of its effectiveness. The result, as demonstrated by the case below, is the sanctioning of commercial products that infringe and trade off the hard-won reputations of popular brands, such as those that make up Constellation’s consumer portfolio.

¹ No counsel for a party authored this brief in whole or in part, and no person other than Constellation, its members, or its counsel made a monetary contribution to fund its preparation or submission.

SUMMARY OF ARGUMENT

It is an old adage that “bad facts make bad law.” But so do good intentions. The Second Circuit surely believed it was only carving out a narrow exception to the Lanham Act when it devised the *Rogers* test years ago to deal with what was then a unique issue. In the decades since, however, its creation has metastasized and now threatens the corpus of the law itself.

The *Rogers* test is the foundation for the ever-growing “expression exemption” movement. This branch of legal thought is exemplified by the Ninth Circuit and holds that if a party’s use of another’s trademark is associated with an “expressive work,” that use and all related uses are exempt from Lanham Act review unless the plaintiff *also* satisfies *Rogers*’ special test, which, as the District Court below rightly observed, is “nearly impossible.” Pet.App.18a.

There is, however, no legal or logical reason to create privileged categories of commercial activity and exempt them wholesale from the Lanham Act. As will be discussed, the *Rogers* test is unsupported by statute, unworkable in practice, and unnecessary to protect parties’ First Amendment rights. It is a judge-made solution for a nonexistent problem, and its effects and consequences are severe, especially as more commerce moves to an “expressive” model.

The Lanham Act is meant to protect consumers from confusion and harm. By exempting categories of infringing use from review, however, courts are undercutting that goal and making it easy for unscrupulous actors to exploit famous brands. This

Court should reverse the decision below, reject the ill-conceived *Rogers* test, close the infringement loophole, and restore the Lanham Act to the scope intended.

ARGUMENT

I. **The *Rogers* Test, which underpins the Ninth Circuit’s decision, is judge-made law, unsupported by the Lanham Act.**

The Second Circuit developed the *Rogers* test to address what it believed was a flaw in the Lanham Act. Concerned that application of the traditional Lanham Act infringement test in “the area of titles” for artistic works might “intrude on First Amendment values,” the Second Circuit decreed that the statutory test would henceforth be “construe[d] ... narrowly” with regard to titles “to avoid such a conflict.” *Rogers v. Grimaldi*, 875 F.2d 994, 997-98 (2d Cir. 1989).

That first exception—which, tellingly, grew out of a case that had nothing to do with trademarks²—was only meant to apply to “misleading titles using a celebrity’s name.” *See id.* 999. In its decision, the Second Circuit even said that if *two titles* were confusingly similar (rather than just a title potentially being mistakenly associated with a celebrity’s name),

² The issue in *Rogers* was whether use of the movie title “Ginger and Fred” falsely suggested a connection with the famous dancer Ginger Rogers in violation of Section 43(a) of the Lanham Act [15 U.S.C. § 1125(a)]. *See Rogers*, 875 F.2d at 997. Individual movie titles, though, are not trademarks. *See, e.g., Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002).

its new “limiting construction” should not be used. *Id.*, n.5 (“The public interest in sparing consumers this type of confusion outweighs the slight public interest in permitting authors to use such titles.”).

In the decades since, however, that once-narrow judicial exemption has repeatedly been expanded by the Circuit Courts, eroding the Lanham Act further each time. For example, in *Mattel, Inc. v. MCA Records, Inc.*, the Ninth Circuit re-interpreted *Rogers* to have it apply to all “titles” (not just titles for literary works) and dropped the requirement for a celebrity’s name. Specifically, the court held that the song “Barbie Girl” could not violate the Lanham Act as a matter of law *even if* its name confused consumers into thinking the song was put out by the owner of the famous BARBIE® mark for dolls, which mark, the Ninth Circuit implied, deserved lesser protection in such situations because BARBIE® was a “cultural icon.” See 296 F.3d 894, 898, 902 (9th Cir. 2002). Then, the next year (in another “Barbie” matter), the Ninth Circuit widened the exception again, applying it this time to the use of a mark in both the title of a work *and* in its description. *Mattel, Inc. v. Walking Mountain Prod.*, 353 F.3d 792, 807 (9th Cir. 2003).

The Ninth Circuit, though, was far from done expanding its new exemption. Five years later, in *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, the court enlarged *Rogers* further, this time affording protection to the name of a strip club set within a video game’s virtual world, despite being fully aware that, in so doing, it was cutting *Rogers* loose from any foundational moorings. 547 F.3d 1095, 1099 (9th Cir. 2008) (“Although [*the Rogers*] test

traditionally applies to uses of a trademark in the title of an artistic work, there is no principled reason why *it ought not also apply* to the use of a trademark in the body of the work.”) (emphasis added). And once the *Rogers* test—with the court’s blessing—was no longer restricted to the use of “titles” or required the mark to be a “celebrity’s name” or invoke a “cultural icon,” it quickly spread to many more trademark matters.

In *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013), the Ninth Circuit used *Rogers* to block a claim by a football player seeking to prevent the unauthorized use of his likeness in a video game. In *Twentieth Century Fox Television v. Empire Distrib., Inc.*, the court relied on *Rogers* to exempt defendant’s commercial use of the plaintiff record company’s name, not only for the defendant’s fictional television show (about a record company), but also for the defendant’s real-life goods and services, including *the sale of music*. 875 F.3d 1192, 1196-97 (9th Cir. 2017) (“Although it is true that these promotional efforts technically fall outside the title or body of an expressive work, it requires only a minor logical extension of the reasoning of *Rogers* to hold that works protected under its test may be advertised and marketed by name, and we so hold.”). In *Diece-Lisa Indus., Inc. v. Disney Store USA, LLC*, No. 21-55816 (June 9, 2022), 2022 WL 2072727 (9th Cir. 2022), the court endorsed the use of *Rogers* for the first time in a “reverse confusion” case, turning the doctrine fully on its head.³ And just two months ago, in *Punchbowl*,

³ In a “reverse confusion” case, the senior user is usually not well known and it is the use of the infringing mark by the larger, more famous junior user that “swamps” the senior user’s reputation, (continued)

Inc. v. AJ Press, LLC, the Ninth Circuit announced yet another escalation, holding that *the brand name* of a business will now also be exempt from the traditional Lanham Act analysis provided the *content* the business sells is considered “expressive.” 52 F.4th 1091, 1099 (9th Cir. 2022) (“[Plaintiff] asserts that the *Rogers* test is entirely inapplicable because it does not extend to the brand name of a commercial enterprise. ... We disagree.”) (internal quote omitted).

All of that brings us to the point we are today—where the *Rogers* test acts to exempt any “expressive” activity from Lanham Act review unless a court finds that the defendant’s use of the mark either has no “artistic relevance” or is “explicitly misleading”—what the Ninth Circuit unabashedly calls a “gateway test.” See Pet.App.30a. However, this modern notion that courts can “exempt” entire classes of infringing uses from Lanham Act review *unless* certain additional hurdles are first cleared runs afoul of the plain text of the statute, which contains no such exemptions.

causing consumers to think that *the senior user* is the infringing party. *E.g.*, 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23:10 (5th ed. 2020). Part of the rationale for *Rogers*, however, was that because the defendant was using a famous name, the public’s interest in free expression outweighed the risk of a false celebrity endorsement. 875 F.3d at 999-1000; *see also MCA Records*, 2986 F.3d at 898, 906-7 (a “cultural icon”). In fact, the second part of the *Rogers* test—which asks whether the defendant’s use of the mark is “explicitly misleading as to source or content”; *Rogers*, 875 F.2d at 999—makes no sense in a *reverse* confusion case because a defendant would never want to “mislead” consumers into thinking it was associated with the *lesser-known* senior party. Thus, the test grants near-absolute immunity in reverse confusion matters.

Section 43(a) of the Lanham Act (which governs infringement of unregistered marks) plainly states that “[a]ny person” who uses “any word, term, name, symbol, or device” with “any goods or services” shall be liable for infringement if that use “is likely to cause confusion, or to cause mistake, or to deceive” 15 U.S.C. § 1125(a)(1)(A) (emphasis added); *see also id.*, § 1114(1) (protecting registered marks). Congress’ choice of language there was clear and absolute. The Lanham Act does not contain carve outs for “expressive works” with “artistic relevance,” nor are such exclusions *needed* to protect First Amendment interests—those are already safeguarded by existing, statutorily sound doctrine. *See* Section III, *supra*.

Nor should Congress’ choice not to exempt certain works be considered a legislative oversight. Congress *knows* how to create special exemptions for trademark uses if wants to do so. When it passed the original Lanham Act, for example, Congress exempted printers and periodicals from liability for innocent infringement and even addressed First Amendment concerns relating to prior restraint. *See* Pub. L. 79-489, § 32(2), 60 Stat. 427, 438 (1946) (codified as 15 U.S.C. §1114(2)); *see also id.*, § 33(b)(4), 60 Stat. at 438-39, (15 U.S.C. § 1115(b)(4)) (listing defenses to the presumptions afforded by “incontestability”). In the years since, Congress has twice updated those exemptions (adding “electronic communications” in 1988 and “domain names” in 1999), Trademark Law Revision Act, Pub. L. 100-667, § 127, 102 Stat. 3935, 3943-44 (1988); Consolidated Appropriations Act, Pub. L. 106-113, § 3004, 113 Stat. 1501, 1501A-549 (1999), but yet it still never felt the need to include an exemption similar to the one in *Rogers*.

Congress likewise demonstrated both its ability and willingness to include exemptions in the Lanham Act when it passed the Federal Trademark Dilution Act, which law included carve outs for noncommercial use, news reporting, news commentary, and other types of “fair use.” Pub. L. 104-98, § 3, 109 Stat. 985, 986 (1996) (codified as 15 U.S.C. § 1125(c)(4)). Ten years later, Congress again broadened its original exclusions, this time exempting from dilution liability the use of any famous mark for the purpose of “identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.” Trademark Dilution Revision Act, Pub. L. 109-312, § 2, 120 Stat 1730, 1731 (2006) (codified as amended as 15 U.S.C. § 1125(c)(3)).

It is dangerous for courts to invent exemptions they believe Congress “overlooked,” especially when the legislature has repeatedly had the opportunity to address those concerns. If Congress wants to consider expanding Section 32(2) and add a statutory loophole for all “expressive works,” regardless of how much damage may result to consumers or to trademark owners, it is free to do so. But until then, courts should not simply presume that Congress “forgot.”

II. The *Rogers* Test, as applied by the Ninth Circuit and other Circuits, has resulted in the creation of an unworkable standard.

The *Rogers* exemption is not only statutorily unsupported, it is intrinsically unworkable, acting in its broken state to protect art and artifice alike. It also

puts federal court judges in the awkward position of being called upon to make artistic value judgments, and it further requires them to apply a bizarre double standard and to sanction forced corporate speech.

When applying *Rogers*, a court must first decide whether the case involves an “expressive” work. *See*, Pet.App.30a. This, however, is not a mere threshold inquiry. Classifying a work as “expressive” is almost always case dispositive.⁴ What is more, that decision can exempt not only use of the subject mark for the title of the work, but also *in the body* of the work, *on* the work (e.g., its design or trade dress, as in the

⁴ Over the past twenty years, for example, the Ninth Circuit has affirmed the grant of dismissal or judgement as a matter of law in every *Rogers* case it considered, except one. *See MCA Records*, 296 F.3d at 902; *Walking Mountain Prod.*, 353 F.3d at 816; *E.S.S. Entertain.*, 547 F.3d at 1101; *Brown*, 724 F.3d at 1239; *VIRAG, S.R.L. v. Sony Computer Entertain. Am. LLC*, 699 Fed. Appx. 667, 668 (9th Cir. 2017); *Twentieth Century Fox*, 875 F.3d at 1195; *Dr. Seuss Enter., L.P. v. ComicMix LLC*, 983 F.3d 443, 463 (9th Cir. 2020); *Diece-Lisa Indus.*, 2022 WL 2072727 at *1; *Dickinson v. Ryan Seacrest Enter. Inc.*, 839 Fed. Appx. 110, 112 (9th Cir. 2020); *Betty's Foundation for Elimination of Alzheimer's Disease v. Trinity Christian Center of Santa Ana, Inc.*, No. 21-55553 (Mar. 16, 2022), 2022 WL 807391, *2 (9th Cir.); *K and K Promotions, Inc. v. Walt Disney Studios Motion Pictures*, No. 21-16740, 2022 WL 3585589, *1 (9th Cir. 2022); *Punchbowl*, 52 F.4th at 1094. The sole exception was *Gordon v. Drape Creative, Inc.*, a one-off case the court (somewhat naively) felt at the time defined the “outer limits” of *Rogers* because the only “expressive” content was the use of the mark. 909 F.3d 257, 268 (9th Cir. 2018); *see also ComicMix*, 983 F.3d at 462. But as the District Court below observed, short of “slapping another’s trademark on your own work and calling it your own”—essentially the claim in *Gordon*—it is now “difficult to imagine what creative junior user would not pass the *Rogers* test.” Pet.Ap.18a (emphasis added).

present case), or in any way *related* to the work, including as the brand name of the business entity that simply *sells* the work. See *E.S.S. Entertain.*, 547 F.3d at 1099; *Twentieth Century Fox*, 875 F.3d at 1196-97; *Punchbowl*, 52 F.4th at 1099.

Moreover, the Ninth Circuit’s definition of an “expressive work” is very broad. The court considers a work “expressive” merely if it “communicat[es] ideas or express[es] points of view.” Pet.App.30a-31a. And notably, any “ideas” or “points” will do—they need not be profound or relate to the party whose marks are being appropriated and used.⁵ See *id.*; *Twentieth Century Fox*, 875 F.3d at 1199; see also *Gordon*, 909 F.3d at 264 (the *Rogers* test will apply so long as “the defendant ... make[s] a threshold legal showing that its allegedly infringing use is part of an expressive work protected by the First Amendment”).⁶

In practice then, that means almost any use— if argued creatively enough—can be “expressive” and, thus, all but exempt from Lanham Act review. After all, if the trade dress of a dog toy qualifies, then why not a rainbow-colored label for a bottle of vodka? Wouldn’t the vodka label communicate the idea that

⁵ This is in sharp contrast to what Congress did when it amended Section 43(c) of the Lanham Act to exempt from liability use of a famous mark that “parod[ies], criticiz[es], or comment[s] upon the famous mark owner or the goods or services of the famous mark owner.” 15 U.S.C. § 1125(c)(3)(A)(ii) (emphasis added).

⁶ This Court, albeit not endorsing or discussing *Rogers*, has itself suggested that an expressive work can broadly be considered anything subject to copyright protection. See *Golan v. Holder*, 565 U.S. 302, 327-28 (2012); *Georgia v. Public.Resource.Org, Inc.*, --- U.S. ---, 140 S. Ct. 1498, 1510 (2020).

the vodka’s manufacturer supports LGBTQ rights and express a point of view favoring such causes? And if that were the case, then wouldn’t the use of any mark *on* those goods be subject to the special *Rogers* test rather than a traditional Lanham Act analysis?

Full *Rogers* protection, of course, is not granted just because an item includes “expressive” content—there is still that further two-part test that, if met, can invalidate the *Rogers* exemption. See Pet.App.30a. Namely, if the trademark owner can show that the defendant’s use of the mark has no “artistic relevance” to the expressive work or is “explicitly misleading,” then the Lanham Act may still apply. *Id.*

Judges, though, are not meant to be art critics,⁷ which is why the first test—“artistic relevance”—is, in practice, meaningless. Seeming to acknowledge this, the Ninth Circuit requires only a *de minimis* level of relevancy—anything “above zero.” *E.S.S. Entertain.*, 547 F.3d at 1100; *Gordon*, 909 F.3d at 269 (“even the slightest artistic relevance will suffice; courts and juries should not have to engage in extensive artistic analysis”) (quote omitted). In effect, then, almost any claim of relevance will succeed. *Accord* Pet.App.18a (“Where relevance need be merely ‘above zero’—which is to say, relevance can be scant or *de minimis*—it is difficult to imagine what creative junior use would not pass the *Rogers* test.”). Indeed, it is telling that the

⁷ *Accord* *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”).

Ninth Circuit—in twenty years of applying *Rogers*—has never found a mark irrelevant to the defendant’s work.⁸

That means any hope of thwarting runaway application of *Rogers* must lie in the test’s second prong, which asks whether the defendant is using the other party’s mark “to explicitly mislead consumers as to the source or content” of the defendant’s work. *Brown*, 724 F.3d at 1245 (quotes omitted). On the surface, this seems to call for a traditional confusion analysis, with the Ninth Circuit even suggesting this prong “points directly at the purpose of trademark law, namely to ‘avoid confusion in the marketplace by allowing a trademark owner to prevent others from duping consumers into buying a product they mistakenly believe is sponsored by the trademark owner.’” *E.S.S. Entertain.*, 547 F.3d at 1100 (quoting *Walking Mountain*, 353 F.3d at 806). In reality, though, this test is also meaningless and can only possibly snare the most addle-minded infringers.

The Ninth Circuit emphasizes that the “key” to this test is that the defendant “must *explicitly* mislead consumers.” *Brown*, 724 F.3d at 1245 (emphasis in original). That is, *in addition* to the infringing use of

⁸ Cf. *MCA Records*, 296 F.3d at 902; *Walking Mountain Prod.*, 353 F.3d at 807; *E.S.S. Entertain.*, 547 F.3d at 1100; *Brown*, 724 F.3d at 1243; *VIRAG*, 699 Fed. Appx. at 668 (the “goal of realism” alone is artistically sufficient); *Twentieth Century Fox*, 875 F.3d at 1195; *Gordon*, 909 F.3d at 269; *Dr. Seuss Enter.*, 983 F.3d at 462; *Diece-Lisa Indus.*, 2022 WL 2072727 at *1; *Dickinson*, 839 Fed. Appx. at 111-12; *Betty’s Foundation*, 2022 WL 807391 at *1; *K and K Promo.*, 2022 WL 3585589 at *1; *Punchbowl*, 52 F.4th at 1100 (“The first part of [the *Rogers*] test sets a very low threshold... [Plaintiff] therefore understandably focuses its argument on [the] second prong.”).

the mark itself, there must be something else—an “explicit indication,” an “overt claim,” an “explicit misstatement”—directed at consumers that is likely to cause confusion. *Id.* at 1245-46; *see also E.S.S. Entertain.*, 547 at 1100 (“the mere use of a trademark alone cannot suffice to make such use explicitly misleading”); *Punchbowl*, 52 F.4th at 1100 (“it is not enough that [defendant] uses “Punchbowl” in the name of its publication”). Even direct proof that consumers *have* been misled is not enough—“[t]o be relevant, evidence must relate to the nature of the behavior of the identifying material’s user, not the impact of the use.” *Brown*, 724 F.3d at 1246 (“[e]ven if [plaintiff] could offer a survey demonstrating that consumers of [defendant’s video game] believed that [he] endorsed the game, that would not support the claim that the use was explicitly misleading”).

Consequently, short of blatantly lying directly to consumers about your goods (*i.e.*, making a public, misleading “overt claim”), *cf. Brown*, 724 F.3d at 1247, or simply “slapping another’s trademark” on the goods and “calling [them] your own,” Pet. App.18a, no half-competent infringer should ever run afoul of *Rogers*’ second prong. Under Ninth Circuit law, adding “a minimal degree of expressive content” to one’s use of another’s mark is all that is required to overcome the “explicitly misleading” test, *see Pet.App.17a*, and even failing to do that, one could always add a label saying the goods come from another source or include a small disclaimer. *See id.*, 17a-18a; *Dr. Seuss Enter.*, 983 F.3d at 462-63. Again, it does not matter if consumers *are* misled. *E.g., Brown*, 724 F.3d at 1246. The trick is for the infringer to do just enough to avoid having their use be labeled “explicitly misleading.”

Rogers therefore is not really a “test”—it is a classification system. If a work can be classified as “expressive,” it is considered functionally exempt from Lanham Act review. *See supra*. And because the *intent* of the infringing party is irrelevant to a *Rogers* analysis (so long as that intent was not communicated to consumers); *see Brown*, 724 F.3d at 1246-47; *cf. also* Pet.App.69a (Nos. 95-97) (finding intent), companies now have a road map to use for targeting established brands and siphoning off the goodwill for profit.

For example, if an unscrupulous party wanted to trade on the goodwill of ABSOLUT vodka (one of the best-selling vodkas in the United States), why couldn't it just use the “expressive” rainbow label discussed above and call the vodka “ABSOLUTELY”? That name would certainly be artistically relevant to the label design given that it would reinforce that the manufacturer “absolutely” supports LGBTQ rights. *Cf. Gordon*, 909 F.3d at 269 (“the slightest artistic relevance will suffice”). And because the mark would have been modified (with “-ELY”), and the label would include a government-required identifier of source (37 C.F.R. § 5.63(b)(1)) and maybe even a small disclaimer on back, it could not be “explicitly misleading.” *Cf. Dr. Seuss Enter.*, 983 F.3d at 462-63; Pet. App.17a-18a.

To be sure, if such an obvious infringement were permitted, it would lead many consumers to buy the knock-off vodka believing it to be the original, causing injury both to themselves and to the maker of ABSOLUT, which would lose sales and suffer a severe

reputational hit.⁹ In the Ninth Circuit, though, preventing confusion and its associated harm is no longer of paramount concern, even though the prevention of such injuries was the *reason* Congress passed the Lanham Act. See *Walking Mountain*, 353 F.3d at 806 (describing the Lanham Act’s purpose as to “avoid confusion in the marketplace by allowing a trademark owner to prevent others from duping consumers into buying a product they mistakenly believe is sponsored by the trademark owner”).

Even more indefensible, though, is the obvious double standard the *Rogers* exemption forces courts to apply. Consider *Diece-Lisa Indus., Inc. v. Disney Store USA, LLC*, where the court held that because Disney used LOTS-O’-HUGGIN’ BEAR as the name for a toy bear in an expressive work (the movie “Toy Story 3”), retail sales of LOTS-O’-HUGGIN BEAR stuffed toys could not, as a matter of law, infringe plaintiff’s rights in the name LOTS OF HUGS for its own stuffed bear. No. 20-09147, 2021 WL 3355284 (C.D. Cal. July 7, 2021) (applying *Rogers*), *aff’d* No. 21-55816, 2022 WL 207272 (9th Cir. June 7, 2022), *petition for cert. filed*, 2022 WL 12639245 (Oct. 11, 2022) (No. 22-347). But what if their situations were reversed and Diece-Lisa began selling their stuffed bear *after* the release of “Toy Story 3”? Would Disney be barred from suing *them* for allegedly trading on the character name Disney created? Could Twentieth Century Fox stop a

⁹ Perversely, the maker of ABSOLUT could also lose *its* ability to celebrate and support LGBTQ rights in a similar way because once established, the infringer could claim trade dress rights in the *combination* of the name ABSOLUTELY and a rainbow label, thus blocking any similarly-theme ABSOLUT product.

viewer of their television show from launching an “Empire” record label? *Cf. Twentieth Century Fox*, 875 F.3d at 1196-97. Would a fan of the movie “Forest Gump” or the singer Jimmy Buffet have been immune from an infringement claim if they had been inspired to create the BUBBA GUMP SHRIMP COMPANY or MARGARITAVILLE restaurant chains?

Exempting expressive works that are likely to confuse consumers also violates the First Amendment rights of *the trademark owners*—specifically, their right not to speak. *Cf., e.g., Wooley v. Maynard*, 430 U.S. 705, 714-15 (1977). When a consumer encounters an expressive work and believes mistakenly that the trademark owner is its source, *cf.* 15 U.S.C. § 1125(a), they will *by definition* also believe that the owner is the source of any “ideas” or “points of view” expressed *by* the work. *Cf.* Pet.App.30a-31a. Forced corporate speech is thus an inevitable byproduct of *Rogers*.

By using *Rogers*, certain courts have bypassed Congress and unilaterally declared that the creators of expressive works should have more trademark rights and First Amendment protections than the rest of us. The “test” created to implement that vision, however, is an intellectual farce, and the loophole has grown so large over time that it now threatens to exempt any trade dress, product design, or mark used on, in, with, or to sell any “expressive” work.

III. The *Rogers* Test is wholly unnecessary.

That the *Rogers* loophole can be exploited so easily by companies hoping to profit by confusing

consumers is, at least in the view of the Ninth Circuit, supposedly the price society must pay to protect free speech. See *Brown*, 724 F.3d at 1246 (“The risk of misunderstanding, not engendered by any explicit indication on the face of the work, is so outweighed by the interest in artistic expression as to preclude application of the Lanham Act.”) (quoting *ETW Corp. v. Jireh Publ., Inc.*, 332 F.3d 916, 937 (6th Cir. 2003)). In its quest to push an art-over-commerce narrative, however, the court has failed to appreciate that the trademark laws already give courts effective ways to protect free speech *without* the systematic risks inherent in *Rogers*’ categorical exclusion approach.

The first firewall blocking the Lanham Act from encumbering First Amendment rights is, obviously, the infringement test itself. Every Circuit Court applies some variant of a common, multi-factor test to assess whether use of a trademark is likely to confuse consumers, see, e.g., *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979), which in most cases serves effectively to separate the innocent sheep from the ill-meaning goats. This is why the majority of courts analyze a defendant’s humorous use of another party’s mark on utilitarian, commercial goods (such as the dog toys below) *within* the likelihood of confusion test, rather than just declare it an exception to it. Cf. *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813-14 (2d Cir. 1999); *Louis Vuitton Malletier, S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007); *Elvis Presley Enter., Inc. v. Capece*, 141 F.3d 188, 198-99 (5th Cir. 1998); *Nike, Inc. v. “Just Did It” Enter.*, 6 F.3d 1225, 1228 (7th Cir. 1993); *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 401-02 (8th Cir. 1987); *Jordache Enter. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1485-86 (10th

Cir. 1987); *see also, e.g., Rogers*, 875 F.2d at 997 (“Poetic license is not without limits. The purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product.”).¹⁰

Therefore, the only First Amendment activities courts may need to “protect” are those the trier of fact first finds likely to confuse consumers. But federal judges *already* have the power to do that. There is no need for the blunt instrument of *Rogers*’ categorical exemptions and their associated negative effects.

The Lanham Act is not a criminal statute—no one is going to jail if they violate another’s rights. A finding of infringement merely subjects a party to “the remedies” listed in the Act, *see* 15 U.S.C. § 1114(1); *see also id.*, § 1125(a), most notably those in Sections 34-36 (15 U.S.C. §§ 1116-18). But, importantly, none of those remedies is *mandatory* for a court to award.

One of the rarest forms of relief is an award of “actual damages,” 15 U.S.C. § 1117(a)(2), for which a

¹⁰ Before it began expanding *Rogers*, the Ninth Circuit recognized this, allowing the Lanham Act to set the outer limits for works like parody books—the very goods the court today would consider categorically exempt under *Rogers*. As the court then explained, “parody is not really a separate ‘defense’ as such, but merely a way of phrasing the traditional response that consumers are not likely to be confused[.]” *Dr. Seuss Enter., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405-06 (1997) (“[T]he cry of ‘parody!’ does not magically fend off otherwise legitimate claims of trademark infringement or dilution. There are confusing parodies and non-confusing parodies. All they have in common is an attempt at humor through the use of someone else’s trademark. A non-infringing parody is merely amusing, not confusing.”) (quoting 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 31.38 (rev. ed. 1995)).

plaintiff must prove that it either suffered a “direct injury” or “lost profits” due to the infringement. *E.g.*, *Lindy Pen Co., Inc. v. Bic Pen Corp.*, 982 F.2d 1400, 1407 (9th Cir. 1993) (“A plaintiff must prove both the fact and the amount of damage.”). But unless the defendant is using the infringing mark to sell goods *in direct competition* with plaintiff, actual damages rarely exist. *See id.* (noting that such proof is “often difficult”); *Maier Brewing Co. v. Fleischmann Distill. Corp.*, 390 F.2d 117, 120 (9th Cir. 1968) (finding “no injury,” “no diversion of sales,” and “no direct competition from which injury may be inferred”).

The more common financial remedy is an award based on the defendant’s “profits,” 15 U.S.C. § 1117(a)(1), typically under the theory of unjust enrichment. *Lindy Pen*, 982 F.3d at 1407. Here again, though, there is first a high hurdle to clear: unless the defendant is knowingly violating plaintiff’s rights for its own gain, courts are highly unlikely to grant an equitable award of the defendant’s profits. *See Romag Fasteners, Inc v. Fossil, Inc.*, --- U.S. ---, 140 S. Ct. 1492, 1497 (2020) (explaining that although a finding of “willfulness” is a not precondition to an award of profits, the “defendant’s mental state” is still “a highly important consideration”); *see also id.* at 1498 (“a district court’s award of profits for innocent or good-faith trademark infringement would not be consonant with the ‘principles of equity’ referenced in [15 U.S.C.] § 1117(a)”) (Sotomayor, J., concurring).¹¹

¹¹ And if the defendant *is intending* to confuse consumers for its own gain, then perhaps compensating the trademark owner for some of the injury it will suffer or denying the defendant some of the profit it will unjustly earn should at least be *an option* for a (continued)

The primary form of relief granted in cases, of course, is the issuance of a permanent injunction against further infringement, *see* 15 U.S.C. § 1116(a), and on the surface, this would seem to be of most concern should a defendant’s First Amendment rights be implicated. Existing law, though, already fully protects against restrictions on free speech. There is thus no need to rely on the overly broad categorical exemptions in *Rogers* to achieve equitable results.

This Court has explained that “[a]n injunction is a drastic and extraordinary remedy, which should not be granted as a matter of course.” *Monsanto Co. v. Geertson Seed Farms*, 561 U.S. 139, 165 (2010). What is more, any trademark plaintiff that applies for an injunction as a remedy for infringement must also satisfy the traditional, four-factor equitable test:

A plaintiff must demonstrate: (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.

eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388, 391 (2006); *see also Reno Air Racing Ass’n, Inc. v. McCord*,

court to consider when fashioning equitable relief, especially if it were inclined to let the defendant continue its activities. *See* 15 U.S.C. § 1117(a) (award is “subject to the principles of equity”).

452 F.3d 1126, 1137-38 (9th Cir. 2006) (applying *eBay*). Whether to grant an injunction is an equitable decision entrusted to the sound discretion of the district court, *eBay*, 547 U.S. at 391, and even if a court is convinced to grant such relief, the injunction still must be “narrowed tailored to remedy the specific harm” presented. *East Bay Sanctuary Covenant v. Barr*, 934 F.3d 1026, 1029 (9th Cir. 2019).

These multiple safeguards thus make it highly unlikely a federal court would haphazardly enjoin an infringing activity that actually implicates legitimate First Amendment concerns. After all, it is understood that “[t]he loss of First Amendment freedoms, for even minimal periods of time, unquestionably constitutes irreparable injury,” *Elrod v. Burns*, 427 U.S. 347, 373 (1976), and courts “have consistently recognized the significant public interest in upholding First Amendment principles.” *Sammartano v. First Jud. Dist. Ct.*, 303 F.3d 959, 974 (9th Cir. 2002), *abrogated on other grounds by Winter v. Nat. Res. Def. Council, Inc.*, 555 U.S. 7 (2008). Therefore, a defendant whose use of the plaintiff’s mark raises First Amendment issues should easily be able to defeat an injunction request based on the third and fourth *eBay* factors even if (as would be necessary) they are first found to have infringed the plaintiff’s trademark rights.¹²

¹² Although Congress recently amended the Lanham Act to include a presumption that a plaintiff would suffer irreparable harm from infringement, 15 U.S.C. § 1116(a), that presumption (which is rebuttable; *see* Fed. R. Evid. 301) only applies to *one* of the four injunction factors. A trademark plaintiff must still show that the hardship it will suffer without an injunction outweighs the harm to the defendant’s First Amendment rights *and* that (continued)

Given that the proper application of the Lanham Act as written is not a threat to First Amendment rights, courts do not need the made-up *Rogers* test to shield “expressive works” from potential Constitutional harm. Although the courts have likely meant well, the more they have expanded *Rogers* to address changing forms of speech (e.g., video games, virtual worlds), the more loopholes they have created for new, ever more creative infringers to exploit.

The district courts should be re-empowered to consider whether humorous dog toys, realistic video games, and any other “expressive” goods infringe a plaintiff’s trademark rights, and if—and only if—they so find, to fashion an appropriate, narrowly-tailored equitable remedy that takes into consideration First Amendment concerns. The unsupported, unworkable, and unnecessary categorical exemption approach of *Rogers* and its progeny should thus be rejected.

the public interest would be served by an injunction, *eBay*, 547 U.S. at 391, a daunting task in cases touching on free speech.

CONCLUSION

The decision below should be reversed.

Respectfully submitted,

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