

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 AMERICAN INTELLECTUAL
PROPERTY LAW ASSOCIATION
AS AMICUS CURIAE SUPPORTING REVERSAL**

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QUESTIONS PRESENTED

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

2. Whether humorous use of another's mark as one's own on a commercial product is "noncommercial" under 15 U.S.C. § 1125(c)(3)(C), thus barring as a matter of law a claim of dilution by tarnishment under the Trademark Dilution Revision Act.

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INTEREST OF THE *AMICUS CURIAE*

Amicus curiae American Intellectual Property Law Association (“AIPLA”) submits this brief in support of reversal of the judgment below.¹

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

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

SUMMARY OF THE ARGUMENT

The First Amendment does not prevent application of the Lanham Act to the “humorous” use of another’s trademark for the purpose of attracting consumers and promoting the sale of *dog toys* in the commercial marketplace. Jack Daniel’s trademark-infringement claims are not subject to the framework first articulated in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) (“*Rogers*”). Nor does VIP’s use of Jack Daniel’s marks qualify as “noncommercial” under the Trademark Dilution Revision Act’s (TDRA) “exclusions” for trademark-dilution claims. This Court should reverse and remand the Ninth Circuit’s judgment.²

The questions presented ultimately turn on application of the Lanham Act’s text and the Court’s commercial-speech precedents. Trademarks are intrinsically commercial symbols that convey information about a product’s source and characteristics. That communicative function is “a form of commercial speech” the Lanham Act may permissibly regulate under the First Amendment when information conveyed by a mark is “deceptive or misleading.” *See Friedman v. Rogers*, 440 U.S. 1, 11-16 (1979).

Nothing in the Act supports the Ninth Circuit’s contrary conclusion concerning VIP’s specific use of Jack Daniel’s marks. Rather, the Act already strikes

² AIPLA takes no position on the underlying merits of Jack Daniel’s claims. *See infra* Part III. AIPLA asserts only that the lower courts should have applied the Lanham Act’s statutory liability standards for trademark infringement and dilution, rather than erroneously holding that *Rogers* applied and that VIP’s use was “noncommercial” under the TDRA.

an appropriate balance with First Amendment interests by limiting liability to *commercial* uses of marks. In particular, both the infringement and dilution provisions of the Act govern the “use in commerce” of marks.³ Liability requires this basic commercial prerequisite, plus a showing that the defendant’s use is either “likely to cause confusion, or to cause mistake, or to deceive” consumers (infringement), or “likely to cause dilution” of a famous mark (dilution). *Id.* While the Act contains “exclusions” from liability for “parodying, criticizing, or commenting upon” a trademark owner or for any “noncommercial use” of a mark, those defenses are limited to claims for trademark dilution and do not apply to infringement claims. *See id.* § 1125(c)(3)(A) & (C). None of the Act’s other defenses to infringement shield parodic or “humorous” uses if they are likely to cause consumer confusion.

Lacking a textual basis for its decision, the Ninth Circuit resorted to an expansive interpretation of the *Rogers* framework. *Rogers* is a narrow, judicially created exception that displaces the Lanham Act’s statutory provisions governing infringement liability in disputes involving uses of marks within “artistic works.” 875 F.2d at 998. Artistic works like films, books, and songs enjoy heightened protection as noncommercial

³ *See, e.g.*, 15 U.S.C. § 1114(1)(a) (infringement of registered mark requires defendant’s “use in commerce...in connection with the sale, offering for sale, distribution, or advertising of any goods or services”); *id.* § 1125(a) (infringement of unregistered mark requires “use[] in commerce” “in connection with any goods or services, or any container for goods”); *id.* § 1125(c) (dilution requires “use of a mark or trade name in commerce”).

speech under the First Amendment because they express the author’s viewpoint and ideas.

Rogers recognized that use of others’ marks within artistic works—for example, in the title or storyline of a film—may serve as “both an integral element of the [artist’s] expression as well as a significant means of marketing the [work] to the public.” *See id.* Because those “artistic and commercial elements” are “inextricably intertwined,” *Rogers* held that the Lanham Act applies to marks used for artistic works only if they have “no artistic relevance” to the underlying work or if they are “explicitly misleading” as to its source or content. *Id.* at 998-99. This heightened standard replaces the statutory “likelihood-of-confusion” standard and “insulates from restriction” trademark infringement in artistic works that is “only implicitly misleading.” *Id.* at 1000.

Rogers has been widely adopted by courts across the country, and no court has rejected its framework.⁴ But as *Rogers*’ underlying reasoning makes clear, the Ninth Circuit erred by applying the *Rogers* framework

⁴ *See* Lynn M. Jordan & David M. Kelly, *Another Decade of Rogers v. Grimaldi: Continuing to Balance the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 109 TRADEMARK REP. 833, 835-36 (2019).

AIPLA takes no position on whether *Rogers* was decided correctly as an original matter. Nor does AIPLA believe this case is an appropriate vehicle to decide that question. *Rogers* dealt with a genuine artistic work—a movie by an influential artist and filmmaker—that was indisputably entitled to a significant degree of First Amendment protection. Regardless of whether *Rogers* is correct, VIP’s dog toys are not artistic works and should be subject to the Lanham Act’s plain language and statutory standards.

in this case. VIP’s products are in no way “artistic works” within the meaning of *Rogers*. Instead, the toys are what *Rogers* referred to as “ordinary commercial products”—*i.e.*, “utilitarian” items that do not independently convey content protected as noncommercial speech under the First Amendment. *Id.* at 998. *Rogers* was never meant to apply to marks used for utilitarian products, which lack the inseparable “artistic and commercial elements” animating *Rogers*’ reasoning. *See id.* The decision below turns the key distinction in *Rogers* between “artistic works” and “ordinary commercial products” on its head.

The same analysis disposes of the Ninth Circuit’s erroneous conclusion that VIP’s use of Jack Daniel’s marks qualifies as “noncommercial” under the TDRA’s exclusions from dilution liability. The court relied almost entirely on its mistaken determination that *Rogers* applied in holding that VIP’s use is also “noncommercial.” The *Rogers* framework was derived from the same body of First Amendment precedent that governs construction of the Act’s noncommercial-use exclusion. Under those cases, VIP’s “humorous” use of Jack Daniel’s marks to attract consumers and promote the sale of its dog toys is not noncommercial speech. *See, e.g., Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of New York*, 447 U.S. 557, 563 n.5 (1980) (rejecting “broad constitutional protection [for] any advertising that links a product to a current public debate”). So too under the TDRA.

The Ninth Circuit’s decision represents a significant and unjustifiable extension of existing law—an extension that, in effect, repudiates over thirty years

of practice under *Rogers* that has so far provided trademark litigants with a relatively stable and balanced playing field. Allowed to stand, the decision would replace the balance provided by *Rogers* with an approach that overwhelmingly favors alleged infringers' expressive interests irrespective of whether the claimed infringement is in connection with a utilitarian product or, in contrast, part of a larger artistic work that is itself inherently noncommercial speech. Neither the Lanham Act nor the First Amendment supports the Ninth Circuit's approach.

ARGUMENT

I. The “Humorous” Use of Another’s Mark to Sell Utilitarian Products Is Subject to the Lanham Act’s Likelihood-of-Confusion Standard for Trademark-Infringement Claims.

The Ninth Circuit should have analyzed Jack Daniel's claims for trademark infringement under the Lanham Act's traditional likelihood-of-confusion standard instead of relying on the *Rogers* framework. Nothing in the Act supports the court's contrary conclusion. The Act's provisions governing infringement account for First Amendment interests by restricting liability to misleading commercial uses of marks in the marketplace. VIP's “humorous” use of Jack Daniel's marks to attract consumers and promote the sale of dog toys is not entitled to additional protection. The Ninth Circuit's application of *Rogers* conflicts with *Rogers*' original reasoning, decades of subsequent precedent applying *Rogers*, and this Court's commercial-speech precedents.

A. The Statutory Elements for Infringement Liability Already Strike an Appropriate Balance with First Amendment Interests.

The elements for infringement liability under the Lanham Act reflect Congress’s careful balancing of the commercial benefits secured by trademark protection with free-speech interests. The Ninth Circuit was not free to disregard the Act’s standards simply because VIP’s alleged infringement took on a “humorous” tone. On its face, the Act applies to all *commercial uses of misleading* marks—even if they also convey a “humorous message.”

The Act defines a “trademark” as “any word, name, symbol, or device” used “to identify and distinguish” the user’s goods “from those manufactured or sold by others” and “to indicate the [goods’] source.” 15 U.S.C. § 1127. This communicative function is “a form of commercial speech,” *Friedman*, 440 U.S. at 11-16 (“[T]he information associated with a trade name is largely factual, concerning the kind and price of the services offered for sale.”), that may be regulated under the Act if it misleads consumers. Imposition of infringement liability under the Act generally raises no constitutional concerns because the First Amendment does not protect “false, deceptive, or misleading” commercial speech. *See Bolger v. Youngs Drug Prod. Corp.*, 463 U.S. 60, 69 (1983). Infringement liability requires: (1) “use in commerce” of the allegedly unlawful mark “in connection with . . . goods or services”; and (2) a showing that the mark is “likely to cause confusion” among consumers. *See* 15 U.S.C. §§ 1114, 1125.

Crucially, these two statutory requirements ensure that “the Act hews faithfully to the purposes for which

it was enacted”—to prevent consumer confusion in the commercial marketplace. *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 331 (4th Cir. 2015). The Act does not apply unless the alleged infringer uses a mark in connection with the sale of goods or services (*i.e.*, commercially).⁵ Persons who use another’s mark to engage in protected speech without offering any product are not subject to liability. *See, e.g., Utah Lighthouse Ministry v. Found. for Apologetic Info. & Rsch.*, 527 F.3d 1045, 1054 (10th Cir. 2008) (“Unless there is a competing good or service labeled or associated with the plaintiff’s trademark, the concerns of the Lanham Act are not invoked.”). The Act’s commercial-use requirement thus limits infringement liability to “speech proposing a commercial transaction, which occurs in an area traditionally subject to government regulation.” *Ohralik v. Ohio State Bar Ass’n*, 436 U.S. 447, 456 (1978).

Additionally, infringement follows only from a finding of likely confusion. Thus, commercial but non-misleading uses of others’ marks do not trigger liability, as has always been the case. *Prestonettes, Inc., v. Coty*, 264 U.S. 359, 368 (1924) (“When the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth.”). Courts regularly decline to impose infringement liability where “any conceivable confusion . . . is at most exceedingly remote,” *Springboards to*

⁵ *Stop the Olympic Prison v. U.S. Olympic Comm.*, 489 F. Supp. 1112, 1124 (S.D.N.Y. 1980) (“[T]he Court seriously doubts that the Lanham Act applies to the type of deception alleged by the defendant here. . . . [T]here is no suggestion that the alleged deception was in connection with any goods or services.”).

Educ., Inc. v. Pharr-San Juan-Alamo Indep. Sch. Dist., 33 F.4th 747, 750 (5th Cir. 2022), or where likely confusion results for reasons other than the alleged infringement, *see RiseandShine Corp. v. PepsiCo, Inc.*, 41 F.4th 112, 124 (2d Cir. 2022) (“To the extent that Defendant’s use of its marks caused any likelihood of confusion, this was because Plaintiff chose a weak mark in a crowded field.”).

Taken together, the commercial-use requirement and likelihood-of-confusion standard “reconcile the commercial values protected by the Lanham Act and the democratic value of expressive freedom.” *Radiance Foundation*, 786 F.3d at 322. “Use of a mark that does not satisfy these two criteria is not trademark infringement.” *Id.* By the same token, however, infringement liability under the Act’s text may reach misleading uses of marks in commerce notwithstanding whether those uses are also broadly made in connection with speech that may receive a greater degree of protection outside the commercial context. Courts have imposed infringement liability under the Act for misleading marks used by political organizations “furnishing a wide variety of non-commercial public and civic benefits,” *see United We Stand Am., Inc. v. United We Stand, Am. New York, Inc.*, 128 F.3d 86, 90, 93 (2d Cir. 1997), as well as religious organizations, *see TETA-MA Truth Found.—Family of URI, Inc. v. World Church of Creator*, 297 F.3d 662, 667 (7th Cir. 2002).⁶

⁶ Courts have reached similar conclusions under state unfair competition law. *See, e.g., Purcell v. Summers*, 145 F.2d 979, 989 (4th Cir. 1944) (dissociated religious body could be “enjoined from using the name Methodist Episcopal Church, South” under South Carolina unfair competition law); *Missouri Fed’n of Blind v. Nat’l*

This construction is consistent with both the Act’s text and this Court’s commercial speech precedents. The Act does not include First Amendment defenses to infringement liability beyond the statutory commercial-use and likelihood-of-confusion requirements. The TDRA’s “fair use” and “noncommercial use” exclusions apply to dilution claims but not infringement claims—a “telling” omission. *See Romag Fasteners, Inc v. Fossil, Inc.*, 140 S. Ct. 1492, 1495 (2020) (use of “willfulness” requirement elsewhere in the Lanham Act but not in the relevant provision strongly suggested Congress did not intend such a requirement); *Dep’t of Homeland Sec. v. MacLean*, 574 U.S. 383, 391 (2015) (noting presumption that Congress “acts intentionally when it uses particular language in one section of a statute but omits it in another”). Further, while not all uses of marks involve purely commercial or noncommercial speech, *see Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017), it does not follow that *any* use of a mark implicating noncommercial speech, no matter how tenuous the connection, is protected under this Court’s precedents.

As this Court has held, “advertising which links a product to a current public debate is not thereby enti-

Fed’n of Blind of Missouri, Inc., 505 S.W.2d 1, 5 (Mo. App. 1973) (“[A] benevolent or other not-for-profit corporation or association has the right to adopt a name by which it shall be known and to have the benefit of the good reputation that name imports, and a court of equity will enjoin another organization from using the same or another name so similar as to be misleading.”).

tled to the constitutional protection afforded noncommercial speech.” *Bolger*, 463 U.S. at 68 (quoting *Central Hudson*, 447 U.S. at 563 n.5). The blending of commercial and noncommercial speech is treated as wholly noncommercial only when the commercial and noncommercial components are “inextricably intertwined.” See *Riley v. Nat’l Fed’n of the Blind of N. Carolina, Inc.*, 487 U.S. 781, 796 (1988). The Ninth Circuit’s interpretation of *Rogers*—on which it relied to sidestep the Act’s text in this case—does not account for that standard. The Ninth Circuit instead applies *Rogers* anytime an alleged infringement contains an “expressive” aspect, irrespective of the use’s otherwise plainly commercial nature. That overextension of *Rogers* conflicts with Congressional intent in passing the Act to “mak[e] actionable the deceptive and misleading use of marks” in the marketplace and “to prevent fraud and deception” among consumers. See 15 U.S.C. § 1127; *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 131 (2014) (relying on the “unusual, and extraordinarily helpful,” statement of the Act’s purpose in Section 1127).

Further, the Ninth Circuit has emphasized that its version of *Rogers* requires evidence that the alleged infringer’s use both “misleads consumers” and does so “explicitly.” *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018). Departing from the Lanham Act’s text, the Ninth Circuit has held that “likely” confusion is insufficient under its version of *Rogers*, as is actual confusion if caused implicitly. See *id.* at 267 (“it is not enough to show that the defendant’s use of the mark would confuse consumers as to the source”). Liability instead requires an “explicit indication,” “overt claim,” or “explicit misstatement” by the infringer.

Twentieth Century Fox Television v. Empire Distrib., Inc., 875 F.3d 1192, 1199 (9th Cir. 2017). Put differently, the Ninth Circuit’s standard “reject[s] the [statutory] ‘likelihood of confusion’ test.” *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013).

The decision below thus runs counter to the Lanham Act’s statutory text and structure. The Act’s infringement provisions already account for the free-speech concerns that motivated the Ninth Circuit to apply *Rogers*. On the present facts, the First Amendment does not require protection beyond what the Act’s plain language offers. The Ninth Circuit’s decision is unmoored from the Act’s language, as courts have understood that language under the Court’s commercial speech precedents.

B. The *Rogers* Framework Does Not Apply to Commercial Uses of Misleading Marks on Utilitarian Products.

Two interrelated but separate errors led the Ninth Circuit to set aside the Lanham Act’s text and conclude that VIP’s use of Jack Daniel’s marks enjoys heightened First Amendment protection. First, the court held that the narrow framework articulated in *Rogers* applied to VIP’s products because they communicated a “humorous message.” Second, its basis for this holding was that *Rogers* invariably applies to “humorous” use regardless of whether that use is made within a protected artistic work or an ordinary commercial product.

Both premises are mistaken. The Second Circuit distilled the *Rogers* framework from this Court’s com-

mercial speech precedents. In effect, *Rogers* is a context-specific application of that precedent for a very slim subset of trademark disputes involving “artistic works,” 875 F.2d at 998, because those works independently convey noncommercial speech that is protected under the First Amendment regardless of whether the works also incorporate, reference, or use another’s mark. In contrast, VIP’s dog toys are “ordinary commercial products,” *see id.*, that indisputably convey no expressive content apart from their use of Jack Daniel’s marks. Courts confronted with nearly identical circumstances have applied the Act’s statutory provisions faithfully. *See, e.g., Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 259-60 (4th Cir. 2007) (likelihood-of-confusion standard applied to parodic dog toys).

1. *Rogers* Protects Noncommercial Speech Independently Conveyed by Artistic Works.

Rogers considered whether the Lanham Act can permissibly prohibit allegedly misleading film titles.

Renowned filmmaker Federico Fellini’s *Ginger and Fred* was released in 1986 and centered on fictional entertainers who impersonated famous real-life dancing partners Ginger Rogers and Fred Astaire. *See id.* at 996-97. The plot involves two Italian dancers who make a career imitating Rogers and Astaire, and then reunite thirty years later for a television special. *Id.* The film was promoted as “the bittersweet story of these two fictional dancers and as a satire of contemporary television variety shows.” *Id.* at 997. Rogers filed suit under Section 43(a) of the Lanham Act, alleging the title would confuse consumers into believing she endorsed the film or was otherwise associated with

it. The district court ruled against her, reasoning that Fellini's title was not "intended primarily to serve a commercial purpose" and, thus, beyond the Lanham Act's scope as part of an "artistic work." 695 F. Supp. 112, 120-21 (S.D.N.Y. 1988).

On appeal, the Second Circuit disagreed with the lower court's bright-line rule. While films are "indisputably works of artistic expression," 875 F.2d at 997, free speech principles "do not insulate titles of artistic works from all Lanham Act claims," *id.* at 998. Guided by this Court's precedent, the Second Circuit observed that films are sold "in the commercial marketplace like other more utilitarian products, making danger of consumer deception a legitimate concern that warrants some government regulation." *Id.* at 997 (citing *Central Hudson*, 447 U.S. at 563). Rather than dispensing with the Act entirely, the court reasoned that "First Amendment concerns" should "inform our consideration of the scope of the Act as applied to claims involving" an artistic work's title. *Id.* at 998.

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

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

Id. (emphasis added). This intertwined nature of literary titles is critical to *Rogers'* underlying reasoning.

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

To account for this concern, *Rogers* held that the Lanham Act does not apply to allegedly misleading film titles that are “artistically relevant” to the work and do not “explicitly mislead” as to the film’s source or origin. *See id.* at 999. These dual requirements were intended to balance First Amendment interests and the Lanham Act’s purpose of eliminating consumer deception in the commercial marketplace. In particular, “[t]he artistic relevance prong ensures that the defendant intended an artistic—*i.e.*, noncommercial—association with the plaintiff’s mark, as opposed to one in which the defendant intends to associate with the mark to exploit the mark’s popularity and good will.” *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172, 178 (S.D.N.Y. 2012). *Rogers* permits use of “ambiguous or only implicitly misleading” film titles to allow leeway for noncommercial speech. 875 F.3d at 1000. This accommodation is not absolute. “A misleading title with no artistic relevance cannot be sufficiently justified by a free expression interest.” *Id.* at 999. Also, if an artistically relevant title contains “explicit references” that are “false as applied to the underlying work,” the “interest in avoiding deception would warrant application of the Lanham Act.” *Id.*

Put simply, the *Rogers* framework was designed as a narrow and specific limit on the Act for artistic works. *Rogers*' reasoning rests on two threshold conditions that maintain its consistency with this Court's commercial-speech precedent and have cabined the framework's subsequent application.

First, the "product" identified by film titles (*i.e.*, the film) is undeniably noncommercial speech. *See Brown*, 564 U.S. at 790 (noting the increased scope of protection for artistic works like "books, plays, and movies"). This Court has recognized that speech "advertis[ing] an activity itself protected by the First Amendment" is subject to broader protection than other commercial speech. *Bolger*, 463 U.S. at 67 n.14 (citing *Murdock v. Pennsylvania*, 319 U.S. 105, 111-12 (1943) (ad for religious book cannot be regulated as commercial speech)). The vast majority of products sold in the commercial marketplace are utilitarian and do not independently convey noncommercial speech. *Rogers* is not meant for cases involving those products, and courts have overwhelmingly recognized this limitation. *See, e.g., Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 416 (S.D.N.Y. 2002) (perfume parody not subject to *Rogers*).

Second, film titles are uniquely "of a hybrid nature." *Rogers*, 875 F.2d at 998. They do not merely identify the film for promotional purposes, but also communicate information about the film's substance in a manner that is "inextricably intertwined." *Id.*; *accord Riley*, 487 U.S. at 796 (commercial speech does not "retain[] its commercial character when it is inextricably intertwined with otherwise fully protected

speech”). The inextricable link between a literary title’s commercial and noncommercial functions is not analogous to other uses of marks that merely relate in some tangential way to protected speech. *See Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 521 (7th Cir. 2014) (“[S]imply combining commercial and noncommercial elements in a single presentation does not transform the whole into noncommercial speech.”).

These threshold conditions ensure *Rogers* does not displace the Act’s likelihood-of-confusion standard simply because a mark is used in connection with allegedly noncommercial speech *unless* the noncommercial aspect is part-and-parcel with the user’s commercial purpose. Few circumstances beyond titles or content of artistic works could fulfill this condition. *Compare Stop the Olympic Prison*, 489 F. Supp. at 1126 (use of Olympic marks in poster protesting planned construction of prison was likely protected under the First Amendment). As a result, only a small subset of trademark disputes implicating noncommercial speech is subject to *Rogers*.

Although the Second Circuit later expanded *Rogers* beyond film titles, *see Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Grp., Inc.*, 886 F.2d 490, 491-93 (2d Cir. 1989) (holding that “the *Rogers* balancing approach is generally applicable to Lanham Act claims against works of artistic expression” and applying *Rogers* to the cover art and title of a parodic book), it also specifically rejected expanding *Rogers* to facts analogous to this case, *see Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812-13 (2d Cir. 1999) (“somewhat humorous[]” use of Harley-Davidson’s logo for motorcycle repair services and T-shirts was subject

to Act’s likelihood-of-confusion standard). Courts have similarly applied *Rogers* to disputes involving artistic works like songs, paintings, books, magazines, and video games. See J. Thomas McCarthy, 6 MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 31:139 (5th ed. 2022). “Circuit courts have also applied *Rogers* in cases where trademark law is being used to attack the content—as opposed to the title—of works protected by the First Amendment.” See, e.g., *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1277 (11th Cir. 2012).

Nevertheless, no court has altered *Rogers*’ threshold conditions limiting its applicability to artistic works that independently convey noncommercial speech. The decision below represents an aberration that unjustifiably extends *Rogers*.

2. Trademark Parodies Used to Identify and Promote Utilitarian Products Are Commercial Speech Beyond *Rogers*’ Scope.

The Ninth Circuit’s mistaken conclusion that *Rogers* governed this case rests on its faulty determination that VIP’s product enjoys more protection than commercial speech usually receives because it is a “humorous” parody.⁷ Regardless of whether or not VIP’s product is parody, *Rogers* does not insulate all trademark

⁷ Although the court below referred to VIP’s dog toys as “humorous” without expressly describing them as “parody,” the precedents it relied on for applying *Rogers* are almost all parody cases. Those cases include *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580 (1994) (parodic song); *Haute Diggity Dog*, 507 F.3d at 258-63 (parodic dog toy); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1397 (9th Cir. 1997)

parodies irrespective of whether the underlying product is protected as noncommercial speech. Such a rule would undermine the Lanham Act's plain language and purpose by permitting the unrestricted and misleading use of others' marks to promote the *commercial* sale of utilitarian products simply because the infringing use conveys a joke.

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

The use of a trademark parody to commercially promote a utilitarian product is not automatically non-commercial speech. Most courts applying *Rogers* distinguish between parody in literary or artistic works

(parodic book); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir. 1987) (parodic article).

and parody as a source identifier for utilitarian products sold for commercial purposes. *See* McCarthy, *supra*, § 31:153. In particular, two Second Circuit decisions highlight the dichotomy in how courts treat trademark parody in artistic works (*Cliffs Notes*) versus utilitarian products (*Harley-Davidson*).

Cliffs Notes held that the parodic use at issue was protected under *Rogers* as a “work[] of artistic expression.” 886 F.2d at 495. The challenged product—a one-time parody of *Cliffs Notes* study guides called *Spy Notes*—was a book, *i.e.*, an artistic work that independently conveys noncommercial speech. The book “poke[d] fun at certain novels” with known “literary shortcomings” by using a “satirize[d] *Cliffs Notes*” style in explaining the novels to readers. *Id.* at 493. *Rogers* applied because the parodic book (and its cover art) conveyed noncommercial speech—that is, the author’s viewpoint and ideas—in critiquing other novels.

Harley-Davidson reached the opposite result. That decision involved a motorcycle repair shop using a humorous logo mimicking Harley-Davidson’s bar-and-shield logo. 164 F.3d at 808-10. Rejecting that the shop’s logo was protected parody under the First Amendment, the court held: “We have accorded considerable leeway to parodists whose expressive works aim their parodic commentary at a trademark or a trademarked product . . . but have not hesitated to prevent a manufacturer from using an alleged parody of a competitor’s mark to sell a competing product.” *Id.* at 812 (citing *Rogers*, 875 F.2d at 998).

Harley-Davidson and *Cliffs Notes* thus demonstrate that not all trademark parodies are subject to *Rogers*’ framework, in particular those used to sell

utilitarian products—like VIP’s dog toys—rather than artistic works. The decision below cannot be squared with the broad consensus among lower courts that parody is generally subject to the Lanham Act’s traditional likelihood-of-confusion standard.

For example, the Seventh Circuit has recognized that the First Amendment “allows ridicule in the form of parody” while emphasizing that “[p]arodies do not enjoy a dispensation” from the traditional infringement standard. *Nike*, 6 F.3d at 1227-28. Instead, parody is “another factor to be considered in determining the likelihood of confusion” that may require recalibration of other considerations like intent. *See id.* at 1228, 1231-32. Numerous courts have endorsed this approach. *See, e.g., Lyons P’ship v. Giannoulas*, 179 F.3d 384, 389-90 (5th Cir. 1999). Likewise, courts across the country have consistently applied the traditional infringement standard to a range of parodic trademark use in connection with utilitarian products like coffee, jeans, and handbags.⁸

Humorous products like VIP’s dog toys should be treated no differently. Indeed, the Fourth Circuit in *Haute Diggity Dog* analyzed a similar dog toy called “Chewy Vuiton” mimicking Louis Vuitton purses. 507

⁸ *See Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 115 (2d Cir. 2009) (coffee); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 200 & 200 n.5 (5th Cir. 1998) (restaurant and bar services); *Jordache*, 828 F.2d at 1486 (jeans); *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 441 (S.D.N.Y. 2016) (handbags); *Wendy’s Int’l, Inc. v. Big Bite, Inc.*, 576 F. Supp. 816, 822 (S.D. Ohio 1983) (fast food).

F.3d at 258. The toys were found to be a parody because they “poke[d] fun at the elegance and expensiveness of a LOUIS VUITTON handbag, which must *not* be chewed by a dog.” *Id.* at 261 (emphasis in original). That finding, however, did “not end the inquiry into whether Haute Diggity Dog’s ‘Chewy Vuiton’ products create a likelihood of confusion.” *Id.* Rather, the court assessed liability under the statutory likelihood-of-confusion standard. *Id.* at 262-63. “Recognizing that ‘Chewy Vuiton’ is an obvious parody and applying the [traditional] factors,” the court held “that LVM has failed to demonstrate any likelihood of confusion.” *Id.* at 263.

The Fourth Circuit relied in part on an earlier case involving a “parody perfume product[] for use on pets” called “Timmy Holedigger.” *See Tommy Hilfiger*, 221 F. Supp. 2d at 413. The court in that case refused to apply *Rogers* because “the First Amendment does not extend” to infringing uses for “a somewhat non-expressive, commercial product.” *Id.* at 415-16. Applying the statutory liability standard instead, the court concluded that the perfume was noninfringing under the traditional factors. *See id.* at 416-21. Another court similarly applied the statutory standard in a dispute involving parodic dog treats. *Grey v. Campbell Soup Co.*, 650 F. Supp. 1166, 1173-75 (C.D. Cal. 1986) (use of DOGIVA mark infringed GODIVA); *see also Recot, Inc. v. M. C. Becton*, 56 USPQ2d 1859, 1860-62 (TTAB 2000) (refusing registration of FIDO LAY dog treats based on likely confusion with FRITO-LAY mark). The decision below fails to explain why the “humorous” aspect of VIP’s toys is any different, and more deserving of protection, than the parodic products in these cases.

Accordingly, the Ninth Circuit's conclusion that *Rogers* insulates all "humorous" uses of marks in connection with utilitarian products conflicts with decades of precedents from multiple jurisdictions, which have applied the Act's likelihood-of-confusion standard. The decision below is also inconsistent with *Rogers*' threshold conditions limiting its application to marks used in artistic works that are inextricably intertwined with noncommercial speech.

II. The "Humorous" Use of Another's Mark to Sell Utilitarian Products Does Not Qualify as a "Noncommercial Use" under the TDRA.

The Ninth Circuit's interpretation of the TDRA's "noncommercial use" exclusion for dilution liability suffers from similar defects. The decision below failed to consider the exclusion's broader statutory context, including the presence of a separate "fair use" exclusion that specifically covers "parodying." In addition, the Ninth Circuit's interpretation of "noncommercial use" conflicts with this Court's commercial-speech precedents. VIP's use of Jack Daniel's marks to promote the sale of its dog toys does not meet the TDRA's standard for "noncommercial use."

A. The TDRA's "Noncommercial" Use Exclusion Should Be Read Contextually with the TDRA's Separate "Fair Use" Exclusion.

The TDRA's "exclusions" were meant to account for First Amendment concerns related to the imposition of dilution liability. *See* H.R. REP. 104-374, 4, 1996 U.S.C.C.A.N. 1029, 1031. Each exclusion covers a separate category of potentially dilutive uses that are nevertheless beyond the scope of dilution liability. The

Ninth Circuit gave short shrift to this broader statutory context in holding the “noncommercial use” exclusion applied here.

“It is a fundamental canon of statutory construction that the words of a statute must be read in their context and with a view to their place in the overall statutory scheme.” *West Virginia v. Env’t Prot. Agency*, 142 S.Ct. 2587, 2607 (2022) (quoting *Davis v. Michigan Dept. of Treasury*, 489 U.S. 803, 809 (1989)). The TDRA’s exclusions cover:

- (A) “Any fair use . . . of a famous mark by another person other than as a designation of source . . . in connection with . . . identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner”;
- (B) “All forms of news reporting and news commentary”; and
- (C) “Any noncommercial use of a mark.”

15 U.S.C. § 1125(c)(3). Read together, the exclusions make clear that “any fair use” for “parodying” is addressed separately from “any noncommercial use” based on different requirements. Courts applying the TDRA’s exclusions have recognized as much.

For example, the Fourth Circuit in *Radiance Foundation* confronted both exclusions where a non-profit organization used the NAACP’s marks in connection with articles posted online that addressed the NAACP’s positions on race and abortion.^{786 F.3d at 319-20}. The court first found the “fair use” exclusion

applied to the articles' use of the NAACP's marks, noting that the exclusion "is not limited to parody" but also includes uses for criticism or commentary. *Id.* at 330-31. The court then analyzed the "noncommercial use" exclusion and held it applied as well because "[a] person navigating to the article . . . is highly unlikely to read the article as advertising [a] service or proposing a transaction of any kind." *Id.* at 331-32. In contrast, the Ninth Circuit—despite plainly analyzing VIP's dog toys through the lens of parodic uses, *see supra* at 18 n.7—did not discuss or even reference the "fair use" exclusion. The court instead skipped to the "noncommercial use" exclusion and held it applied notwithstanding VIP's use of Jack Daniel's marks "to sell Bad Spaniels." *See* 953 F.3d at 1176.

Even more troubling, the Ninth Circuit failed to consider the implications of stretching the "noncommercial use" exclusion to cover a parodic use that otherwise fails to meet the TDRA's "fair use" requirements. Courts construe statutes to "give effect, if possible, to every word Congress used," *Reiter v. Sonotone Corp.*, 442 U.S. 330, 339 (1979), and are loath to interpret statutory provisions in a manner that renders other provisions "unnecessary" or "meaningless," *Nat'l Ass'n of Mfrs. v. Dep't of Def.*, 138 S. Ct. 617, 632 (2018). The TDRA's "fair use" exclusion applies to uses of another's mark for "parodying" only if not "as a designation of source." 15 U.S.C. § 1125(c)(3)(A). Here, VIP indisputably used Jack Daniel's marks as source designations. *See, e.g., Haute Diggity Dog*, 507 F.3d at 266 ("fair use" exclusion did not apply because "defendant uses the parody . . . as a trademark"). The Ninth Circuit's interpretation of the TDRA's exclusions conflates "parodying" under the "fair use" exclusion with

“noncommercial use” while evading the “fair use” exclusion’s express statutory limits, which in turn renders those limits meaningless.

Nothing in the TDRA’s text supports that approach. Nor do either of the cases relied on by the Ninth Circuit in reaching its erroneous conclusion. *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1017 (9th Cir. 2004), held that the defendant’s use of the domain name *nissan.com* for a website that included “negative commentary” and “disparaging remarks” about Nissan Motor Company “does more than propose a commercial transaction and is, therefore, non-commercial,” *id.* at 1016-18. Likewise, *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 906 (9th Cir. 2002), held that use of the BARBIE mark in the title of a song—which is indisputably an “artistic work” under *Rogers*—was “not purely commercial speech, and is therefore fully protected,” *id.* at 906-07. *Nissan* and *Mattel* do not address the use of another’s mark *as a source identifier* to promote the sale of *utilitarian* products. Further, both decisions were decided before the TDRA’s passage when the “fair use” exclusion’s language did not expressly cover “parodying.” See Paul Alan Levy, *The Trademark Dilution Revision Act-A Consumer Perspective*, 16 *Fordham Intell. Prop. Media & Ent. L.J.* 1189, 1203-04 (2006).

B. Trademark Parodies Used to Identify and Promote the Sale of Utilitarian Products Are Not “Noncommercial” under the TDRA.

There can be little dispute that Congress intended the “noncommercial use” exclusion to be interpreted under this Court’s commercial-speech precedents. See,

e.g., *Radiance Found*, 786 F.3d at 331 (“The term ‘non-commercial’ refers to the First Amendment commercial speech doctrine.”).⁹ The Court has recently interpreted Lanham Act provisions using those precedents. *See Tam*, 137 S. Ct. at 1763-65 (Alito, J.) (Plurality Op.). *Tam* is in line with earlier precedent that also interpreted trademark use implicating free-speech interests. *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 536 n.15 (1987) (noting that statutory scheme protecting Olympic marks applied “primarily to commercial speech” and likely could not be interpreted “to infringe significantly on noncommercial speech rights”).

As already noted, *see supra* Part I.A & B(1), VIP’s use of Jack Daniel’s marks does not qualify as noncommercial speech under those precedents. The Court has defined commercial speech as “speech proposing a commercial transaction.” *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 422 (1993). VIP undeniably used Jack Daniel’s marks as source identifiers for its own dog toys, and that source-identification function qualifies as regulable commercial speech. *See Friedman*, 440 U.S. at 11-16. The “humorous” aspect of VIP’s use, without more, does not change that. *See, e.g., Bad Frog Brewery, Inc. v. New York State Liquor*

⁹ *See also Am. Fam. Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 695 (N.D. Ohio 2002) (“[W]hen Congress passed the Federal Trademark Dilution Act . . . it used the phrase ‘noncommercial use’ as a somewhat inexact, shorthand reference to ‘speech protected by the First Amendment.’”); McCarthy, *supra* § 24:128 (“Legislative history indicates that Congress intended the noncommercial exemption to . . . incorporate the Supreme Court’s concept of ‘commercial speech.’”).

Authority, 134 F.3d 87, 97 (2d Cir. 1998) (beer label with frog character “giving the finger” was commercial speech). While the Court has held that “inextricably intertwined” commercial and noncommercial speech is protected as fully noncommercial speech, *Riley*, 487 U.S. at 796, VIP’s use does not meet that requirement.

In *Riley*, the Court addressed a state law that required professional fundraisers for charities to disclose certain information to potential donors. *See id.* As the Court later recognized in *Board of Trustees of State University of New York v. Fox*, 492 U.S. 469 (1989), *Riley*’s “inextricably intertwined” determination was based on the fact that “the state law *required* it to be included,” *id.* at 474 (emphasis in original). The Court in *Fox* addressed a different situation, where a university regulation prohibited commercial solicitations in student dormitories. *Id.* at 471-72. Rejecting an argument that a houseware company’s “Tupperware parties” included “inextricably intertwined” commercial and noncommercial speech because the company’s sales presentations touched on “home economics,” the Court explained: “No law of man or of nature makes it impossible to sell housewares without teaching home economics, or to teach home economics without selling housewares.” *Id.* at 474.

VIP’s use here is no different. Lower courts applying *Riley* and *Fox* in the Lanham Act context have consistently held that “the inextricably intertwined doctrine applies only when it is legally or practically impossible for the speaker to separate out the commercial and noncommercial elements of his speech.” *Jordan*, 743 F.3d at 521; *accord Ariix, LLC v. NutriSearch Corp.*, 985 F.3d 1107, 1119 (9th Cir. 2021). No legal or

practical constraints “make it impossible,” *Fox*, 492 U.S. at 474, for VIP to sell its dog toys without using Jack Daniel’s marks. Rather, notwithstanding any attenuated “humorous message,” VIP’s use of the marks to attract consumers and promote the sale of its products is commercial speech that is not exempt under the TDRA’s “noncommercial use” exclusion.

III. The Lanham Act’s Liability Standards Establish a Balanced Playing Field for Disputes Involving “Humorous” or Parodic uses of Others’ Marks to Sell Utilitarian Products.

Reversal of the Ninth Circuit’s erroneous decision in no way dictates or suggests which party should ultimately prevail on the merits of Jack Daniel’s infringement and dilution claims. Plaintiffs do not always win these types of cases; nor do defendants. The Lanham Act’s statutory liability standards are multifaceted and highly context-specific. The outcome often turns on the nature and clarity of the “humor” or parody, and how consumers would perceive it. The Act’s standards thus establish a balanced approach that turns on the particular circumstances rather than bright-line rules that unduly favor trademark owners over purported parodists, or vice versa.

Haute Diggity Dog well illustrates the point. *See* 507 F.3d at 259-269. The Fourth Circuit did not apply any heightened standard for infringement based on the First Amendment or the TDRA’s exclusions despite the humorous nature of the defendant’s dog toys. Instead, it relied on the Act’s statutory standards while accounting for the parodic element of the defendant’s products in its analysis. The court found no likelihood of confusion, in part because “the parody [was]

sufficiently blatant that a consumer encountering a ‘Chewy Vuiton’ dog toy would not mistake its source or sponsorship.” *Id.* at 261-63. The court also found no likelihood of dilution, reasoning: “Haute Diggity Dog mimicked the famous marks; it did not come so close to them as to destroy the success of its parody and, more importantly, to diminish the LVM marks’ capacity to identify a single source.” *See id.* at 265-69.

Other courts applying the Act’s standards to successful parodies have reached similar conclusions. The Tenth Circuit found no likelihood of confusion or dilution where a defendant parodied JORDACHE jeans by creating “LARDASHE” plus-sized jeans. *Jordache*, 828 F.2d at 1490 (“the public will not associate Lardashe jeans with the appellant or, if they do, they will only make the association because of the parody”). District courts have likewise found no likelihood of confusion or dilution from the use of WAL-QAEDA to parody Wal-Mart and TIMMY HOLEDIGGER to parody Tommy Hilfiger. *See Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1339 (N.D. Ga. 2008); *Tommy Hilfiger*, 221 F. Supp. 2d at 420-421.

On the other hand, not all claimed parodists escape liability. Lawful parody is “a takeoff, not a ripoff.” *Nike*, 6 F.3d at 1228 (disputed fact issue on consumer perception of alleged parody required trial). Courts “have not hesitated to prevent a manufacturer from using an alleged parody” that is merely “somewhat humorous[]” or that “makes no comment” on the original mark.” *Harley Davidson*, 164 F.3d at 812-13. Thus, while some decisions like *Haute Diggity Dog* absolve professed parodists, others do not. *See, e.g., Anheuser-Busch, Inc. v. VIP Prods., LLC*, 666 F. Supp. 2d 974,

986 (E.D. Mo. 2008) (“BUTTWIPER” dog toy that claimed to parody BUDWEISER mark and trade dress enjoined).

The Seventh Circuit’s decision in *Eli Lilly & Co. v. Nat. Answers, Inc.*, 233 F.3d 456. (7th Cir. 2000), highlights the limits of parody. The court affirmed a preliminary injunction against an herbal-supplement manufacturer that used the mark HERBROZAC to sell “mood elevators” as an alleged parody of PROZAC anti-depressants, *id.* at 459-60. Noting that HERBROZAC lacked “any humor or satire in its imitation of PROZAC,” the court agreed that the trademark owner was likely to succeed on the merits of its infringement and dilution claims. *See id.* at 463, 468-69.

These decisions reflect not only faithful application of the Act’s text but also a balanced give-and-take between trademark owners and aspiring parodists. Trademark rights are not absolute. *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) (trademark protection is not “a right in gross or at large”). The Act’s text restricts its application to commercial uses that cause “likely” confusion or dilution, both of which require credible evidence and not speculation. *See, e.g., Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 226 (5th Cir. 2009) (likelihood of confusion “means more than a mere possibility”); *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 495 (1st Cir. 1981) (“attenuated and speculative” injury is not “cognizable” as trademark dilution). The Ninth Circuit should have applied those statutory standards here, rather than resort to *Rogers* and the “noncommercial use” exclusion. The Act’s statutory approach establishes a level playing field for

trademark litigants and is consistent with the Act's purpose, decades of precedent applying *Rogers*, and this Court's commercial-speech precedents.

CONCLUSION

For these reasons, the Ninth Circuit's decision should be reversed and remanded for proper consideration of Jack Daniel's claims under the Lanham Act's standards.

Respectfully submitted,

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