

No. 22-148

IN THE
Supreme Court of the United States

JACK DANIEL'S PROPERTIES, INC.,

Petitioner,

v.

VIP PRODUCTS LLC,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE NINTH CIRCUIT

**BRIEF OF *AMICI CURIAE* INTELLECTUAL
PROPERTY PROFESSORS AND
ADJUNCT PROFESSORS IN SUPPORT
OF NEITHER PARTY**

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TABLE OF CONTENTS

TABLE OF AUTHORITIES	iii
INTEREST OF <i>AMICI CURIAE</i>	1
SUMMARY OF ARGUMENT.....	1
ARGUMENT	6
I. When considering Lanham Act claims against expressive works, courts should apply heightened scrutiny, because the likelihood-of-confusion test is ill-suited to protect the public interest in free expression.....	6
A. Protecting First Amendment interests requires courts to tolerate some likelihood of consumer confusion resulting from works of noncommercial expression.....	6
B. Courts need engage in a First Amendment analysis only when an expressive work is likely to result in some likelihood of consumer confusion, as in the case of an “unsuccessful parody.”	12
II. Balancing the public interest in free expression against the public interest in avoiding confusion requires a categorical test that focuses on the nature of the expression and on the alleged infringer’s conduct.....	18
III. In determining whether the First Amendment precludes Lanham Act liability against a work, courts should focus on the context and content of the work’s expression, not its medium.	21

A. Distinguishing between a “consumer good” or “commercial product” and an expressive good is untenable and is contrary to this Court’s precedents.	21
B. The threshold question for whether a work that incorporates another party’s trademark is subject to heightened scrutiny should be whether a reasonable person would understand the work inherently to convey noncommercial expression or to convey such expression in a manner inextricable from the functional or commercial elements of the work.	26
IV. A modified version of the <i>Rogers v. Grimaldi</i> test can properly balance the interests protected by the First Amendment and trademark law.	29
A. <i>Rogers</i> has served as a useful tool for courts to balance First Amendment and Lanham Act interests.	29
B. The <i>Rogers</i> test should be modified so that it is administrable and so that it appropriately balances First Amendment and Lanham Act interests.	31
1. The new test.	31
2. Explicit misleadingness.	32
3. Clear gratuitousness.	36
4. Application of the test to Bad Spaniels.	45
CONCLUSION.	46

TABLE OF AUTHORITIES

Cases

<i>44 Liquormart, Inc. v. Rhode Island</i> , 517 U.S. 484 (1996).....	26
<i>A.V.E.L.A. v. Est. of Marilyn Monroe</i> , 364 F. Supp. 3d 291 (S.D.N.Y. 2019).....	43
<i>Am. Dairy Queen Corp. v. New Line Prods., Inc.</i> , 35 F. Supp. 2d 727 (D. Minn. 1998)	10, 42
<i>Am.'s Best Fam. Showplace Corp. v. N.Y.C., Dep't of Bldgs.</i> , 536 F. Supp. 170 (E.D.N.Y. 1982).....	22
<i>AMF, Inc. v. Sleekcraft Boats</i> , 599 F.2d 341 (9th Cir. 1979).....	7
<i>Anheuser-Busch, Inc. v. Balducci Pubs.</i> , 28 F.3d 769 (8th Cir. 1994).....	9, 41
<i>Bantam Books, Inc v. Sullivan</i> , 372 U.S. 58 (1963).....	25
<i>Bd. of Trs. of State Univ. of N.Y. v. Fox</i> , 492 U.S. 469 (1989).....	26
<i>Bleistein v. Donaldson Lithographing Co.</i> , 188 U.S. 239 (1903).....	36
<i>BMW of N. Am., Inc. v. Gore</i> , 517 U.S. 559 (1996).....	19
<i>Bond v. United States</i> , 572 U.S. 844 (2014).....	12
<i>Brown v. Elec. Arts, Inc.</i> , 724 F.3d 1235 (9th Cir. 2013).....	34

<i>Brown v. Ent. Merchants Ass’n</i> , 564 U.S. 786 (2011).....	21, 22, 25
<i>Burck v. Mars, Inc.</i> , 571 F. Supp. 2d 446 (S.D.N.Y. 2008).....	16
<i>C.B.C. Distr. and Mktg., Inc. v. Major League Baseball Advanced Media, L.P.</i> , 505 F.3d 818 (8th Cir. 2007).....	23
<i>Campbell v. Acuff-Rose Music, Inc.</i> , 510 U.S. 569 (1994).....	13, 17, 20, 27, 37
<i>Cardtoons, L.C. v. Major League Baseball Players Ass’n</i> , 95 F.3d 959 (10th Cir. 1996).....	24
<i>City of Cincinnati v. Discovery Network, Inc.</i> , 507 U.S. 410 (1993).....	25
<i>City of Lakewood v. Plain Dealer Pub’g Co.</i> , 486 U.S. 750 (1988).....	25
<i>Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Grp., Inc.</i> , 886 F.2d 490 (2d Cir. 1989).....	17, 35, 38
<i>Cohen v. California</i> , 403 U.S. 15 (1971).....	21
<i>Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.</i> , 604 F.2d 200 (2d Cir. 1979).....	10
<i>Dickinson v. Ryan Seacrest Enters., Inc.</i> , No. 18-CV-2544 (GHW), 2019 WL 3035090 (C.D. Cal. Mar. 26, 2019)	39
<i>E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.</i> , 547 F.3d 1095 (9th Cir. 2008).....	34

<i>Elec. Arts, Inc. v. Textron Inc.</i> , No. 12-CV-118 (WHA), 2012 WL 3042668 (N.D. Cal. July 25, 2012)	39
<i>Elvis Presley Enters., Inc. v. Capece</i> , 141 F.3d 188 (5th Cir. 1998).....	13
<i>ETW Corp. v. Jireh Publ'g, Inc.</i> , 332 F.3d 915 (6th Cir. 2003).....	39
<i>Gertz v. Robert Welch, Inc.</i> , 418 U.S. 323 (1974).....	12, 19
<i>Harley Davidson, Inc. v. Grottanelli</i> , 164 F.3d 806 (2d Cir. 1999)	27, 43, 45
<i>Helene Curtis Indus., Inc. v. Church & Dwight Co.</i> , 560 F.2d 1325 (7th Cir. 1977).....	7
<i>Hidden City Philadelphia v. ABC, Inc.</i> , No. 18-cv-65 (JRS), 2019 WL 1003637 (E.D. Pa. Mar. 1, 2019)	44
<i>Hilton v. Hallmark Cards</i> , 599 F.3d 894 (9th Cir. 2010).....	24
<i>Hustler Mag., Inc. v. Falwell</i> , 485 U.S. 46 (1988).....	19
<i>In re Elster</i> , 26 F.4th 1328 (Fed. Cir. 2022)	23
<i>Interpace Corp. v. Lapp, Inc.</i> , 721 F.2d 460 (3d Cir. 1983)	7
<i>Jackson v. Netflix, Inc.</i> , 506 F. Supp. 3d 1007 (C.D. Cal. 2020).....	41
<i>Joseph Burstyn, Inc. v. Wilson</i> , 343 U.S. 495 (1952).....	21, 24

<i>KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.</i> , 543 U.S. 111 (2004)	12
<i>Lemme v. Nat'l Broad. Co., Inc.</i> , 472 F. Supp. 2d 433 (E.D.N.Y. 2007)	44
<i>Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC</i> , 507 F.3d 252 (4th Cir. 2007)	14
<i>Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.</i> , 156 F. Supp. 3d 425 (S.D.N.Y. 2016).....	14, 38
<i>Lovell v. City of Griffin</i> , 303 U.S. 444 (1938).....	25
<i>Mastrovincenzo v. N.Y.C.</i> , 435 F.3d 78 (2d Cir. 2006)	22
<i>Mattel, Inc. v. MCA Recs., Inc.</i> , 296 F.3d 894 (9th Cir. 2002).....	35
<i>Mattel, Inc. v. Walking Mountain Prods.</i> , 353 F.3d 792 (9th Cir. 2003).....	38
<i>Minn. Voters Alliance v. Mansky</i> , 138 S. Ct. 1876 (2018).....	22
<i>Mut. of Omaha Ins. Co. v. Novak</i> , 836 F.2d 397 (8th Cir. 1987).....	8
<i>N.Y. Racing Ass'n, Inc. v. Perlmutter Publ'g, Inc.</i> , No. 95-CV-994 (FJS), 1996 WL 465298 (N.D.N.Y. July 19, 1996).....	30
<i>NAACP v. Claiborne Hardware</i> , 458 U.S. 886 (1982).....	18, 19
<i>New York Times Co. v. Sullivan</i> , 376 U.S. 254 (1964).....	19

<i>Pignons S.A. de Macanique de Precision v. Polaroid Corp.</i> , 657 F.2d 482 (1st Cir. 1981)	7
<i>Polaroid Corp v. Polarad Elecs. Corp.</i> , 287 F.2d 492 (2nd Cir. 1961)	7
<i>Pope v. Illinois</i> , 481 U.S. 497 (1987)	36
<i>Radiance Foundation, Inc. v. NAACP</i> , 786 F.3d 316 (4th Cir. 2015)	11
<i>Riley v. Nat’l Fed’n of the Blind of N.C., Inc.</i> , 487 U.S. 781 (1988)	25, 26
<i>RJR Foods, Inc. v. White Rock Corp.</i> , 603 F.2d 1058 (2d Cir. 1979)	8
<i>Rogers v. Grimaldi</i> , 875 F.2d 994 (2d Cir. 1989)	11, 29, 30, 32, 33, 40
<i>RXD Media, LLC v. IP Application Dev., LLC</i> , 986 F.3d 361 (4th Cir. 2021)	8
<i>Schieffelin & Co. v. Jack Co. of Boca, Inc.</i> , 850 F. Supp. 232 (S.D.N.Y. 1994)	5, 42, 45
<i>Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.</i> , 588 F.3d 97 (2d Cir. 2009)	28, 43, 45
<i>Stern Elecs., Inc. v. Kaufman</i> , 669 F.2d 852 (2d Cir. 1982)	22
<i>Stouffer v. Nat’l Geographic Partners, LLC</i> , 460 F. Supp. 3d 1133 (D. Colo. 2020)	41
<i>Streamline Prod. Systems, Inc. v. Streamline Mfg., Inc.</i> , 851 F.3d 440 (5th Cir. 2017)	7

<i>Tinker v. Des Moines Indep. Cmty. Sch. Dist.</i> , 393 U.S. 503 (1969).....	21
<i>Tommy Hilfiger Licensing v. Nature Labs, LLC</i> , 221 F. Supp. 2d 410 (S.D.N.Y. 2002).....	5, 42, 45
<i>Twentieth Century Fox Television v. Empire Distrib., Inc.</i> , 875 F.3d 1192 (9th Cir. 2017)	30, 34, 40
<i>Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.</i> , 996 F.2d 1366 (2d Cir. 1993)	34
<i>Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.</i> , 683 F.3d 1266 (11th Cir. 2012).....	30, 39
<i>VIP Prod., LLC v. Jack Daniel’s Properties, Inc.</i> , 291 F.Supp.3d 891 (D. Ariz. 2018)	15
<i>VIP Prods. LLC v. Jack Daniel’s Props., Inc.</i> , 953 F.3d 1170 (9th Cir. 2020).....	30
<i>Ward v. Rock Against Racism</i> , 491 U.S. 781 (1989).....	25
<i>World Wrestling Fed’n Ent. Inc. v. Big Dog Holdings, Inc.</i> , 280 F. Supp. 2d 413 (W.D. Pa. 2003)	24
<i>Yankee Pub’g Inc. v. News Am. Pub. Inc.</i> , 809 F. Supp. 267 (S.D.N.Y. 1992).....	15, 17, 27
Other Authorities	
4 McCarthy on Trademarks and Unfair Competition (5th ed.)	8, 9, 13
H.R. Rep. No. 116-645 (2020)	30
Pierre N. Leval, <i>Trademark: Champion of Free Speech</i> , 27 Colum. J.L. & Arts 187 (2003–04)	12

INTEREST OF *AMICI CURIAE*

This brief¹ is filed on behalf of the undersigned intellectual property law professors and adjunct professors identified in Appendix A.² *Amici* are professors whose research, teaching, and, in the case of the adjunct professors, legal practice focus on trademark law and/or the intersection of intellectual property law and constitutional law. *Amici* have no direct interest in the outcome of this litigation. They share a professional and academic interest in ensuring an appropriate balance between trademark law and First Amendment law.

SUMMARY OF ARGUMENT

The First Amendment is under attack by brand owners that lack a sense of humor, want to monopolize discussion about their brands, and exaggerate the harm expressive references cause to their trademarks. Contrary to their Chicken-Little cries, their brands will not be eviscerated by humor, commentary, criticism, or reference. For that reason, absent explicitly misleading speech or pretextual uses that are clearly gratuitous and not really about expression at all, respect for the First Amendment

¹ No counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of the brief. No person or entity, other than *amici* and their counsel, made a monetary contribution to the preparation or submission of this brief.

² *Amici's* institutional affiliations are provided only for purposes of identification.

requires that their trademark rights yield to the right to free expression.

The traditional likelihood-of-confusion analysis is generally sufficient to determine whether a defendant using a mark in a commercial manner infringes another party's trademark, but it is ill-suited to protect First Amendment interests when a claim of trademark infringement is brought against a work of artistic, political, critical, or other noncommercial expression. In such cases, and in order to appropriately balance the public interest in free expression with the public interest in avoiding consumer confusion, this Court should adopt a heightened standard of analysis to decide whether the First Amendment precludes trademark infringement claims against expressive works, regardless of whether those works are sold for a profit. Based on our decades of legal research and teaching (and, in the case of the adjunct professors, practicing), our study of how courts have addressed this balance, and our observation of how both brands and expression have fared in the wake of those cases, we believe that the *Rogers* test is a good start towards striking the right balance, but some modifications are in order.

Consistent with this Court's general approach to adjudicating civil disputes that implicate First Amendment interests, the test should be:

- a categorical test rather than a fact-intensive, multi-factor balancing test;

- focused on the content of the protected expression and the purported infringer’s conduct, rather than on the perception of a narrow segment of the consuming public, as the likelihood-of-confusion test is; and
- medium-neutral, such that it would apply to authentic expression in any medium, whether traditional media such as films, paintings, music, and books, or nontraditional mediums of expression such as clothing, sneakers, videogames, and toys.

To achieve these goals, we propose modifying *Rogers*. When a defendant makes a *prima facie* showing that the work accused of trademark infringement is a work of expression subject to First Amendment protection, courts should presume that Lanham Act liability is precluded. A plaintiff can rebut that presumption through a showing that the defendant’s use of the plaintiff’s mark is either ***explicitly misleading*** or ***clearly gratuitous*** (these two concepts are fleshed out below). If the plaintiff carries that burden, the court should apply the standard Lanham Act doctrine to determine whether the work is subject to liability, while still balancing the public’s interest in free expression with the public’s interest in avoiding consumer confusion.

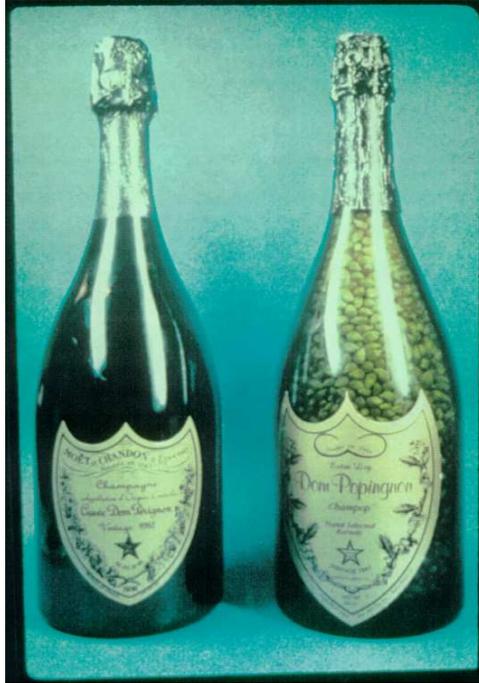
In considering whether a defendant’s use of another party’s trademark is “***explicitly misleading***,” courts should consider whether the

defendant made a false statement as to the source of the work (which is the test used in the Ninth Circuit) rather than merely considering whether the use is *implicitly* or *likely* misleading (which has been done in other circuits that require only a “particularly compelling” likelihood of confusion to satisfy the second *Rogers* prong).

In considering whether a defendant’s use of another’s mark is “**clearly gratuitous**,” courts should consider evidence regarding whether the use has or lacks an apparent good-faith nexus to the defendant’s purported protected expression. Such a nexus may be found in works of parody and satire (which may directly comment on or critique the mark owner or something symbolized by the mark), informational or representational uses of a plaintiff’s mark (as with a still-life painting that depicts branded objects or with a film that accurately depicts brands as they appear in real life), or titles of expressive works that relate directly to the subject matter of the works themselves (as with the title of Fellini’s *Ginger and Fred* film at issue in *Rogers* itself).



Where, on the other hand, the claimed expression is a gratuitous reference to a brand that merely trades on the good will or recognizability of a trademark without any apparent good-faith rationale for such use—as with the DOM POIGNON popcorn at issue in *Schieffelin & Co. v. Jack Co. of Boca, Inc.*, 850 F. Supp. 232 (S.D.N.Y. 1994) or the TIMMY HOLEDIGGER dog fragrance at issue in *Tommy Hilfiger Licensing v. Nature Labs, LLC*, 221 F. Supp. 2d 410 (S.D.N.Y. 2002)—courts should deny the defendant’s First Amendment defense and conduct a standard trademark infringement analysis.



ARGUMENT

I. When considering Lanham Act claims against expressive works, courts should apply heightened scrutiny, because the likelihood-of-confusion test is ill-suited to protect the public interest in free expression.

A. Protecting First Amendment interests requires courts to tolerate some likelihood of consumer confusion resulting from works of noncommercial expression.³

³ As explained further below in Section III.B, the threshold question for whether a work accused of trademark infringement is subject to heightened scrutiny should be

The multi-factor likelihood-of-confusion test is ill-suited to protect First Amendment interests. The test requires a fact-intensive inquiry that does not account for the nature of a purported infringer’s expression and instead focuses on factors extrinsic to the expression. Among the factors courts routinely consider are the strength of the senior user’s trademark, the quality of the alleged infringer’s goods or services, the sophistication of purchasers, any evidence of actual confusion, and the likelihood that the senior trademark user will “bridge the gap” to offer goods or services of the type offered by the junior user. *See Pignons S.A. de Macanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981); *Polaroid Corp v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2nd Cir. 1961); *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 463 (3d Cir. 1983); *Streamline Prod. Systems, Inc. v. Streamline Mfg., Inc.*, 851 F.3d 440, 453 (5th Cir. 2017); *Helene Curtis Indus., Inc. v. Church & Dwight Co.*, 560 F.2d 1325, 1330 (7th Cir. 1977); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979). Such factors do not account for the expressiveness of a use of another’s trademark, nor are they intended to.

Requiring artists and political commentators to concern themselves with whether their expression

whether a reasonable person would perceive either (a) that a work is inherently a form of noncommercial expression or (b) that the work contains noncommercial expression that is inextricably intertwined with any other functional or commercial elements of the work, even if a reasonable person could not discern the precise meaning of the expression.

would likely result in consumer confusion—as determined by a fact-intensive balancing test—would chill artistic, political, and other noncommercial expression. Chilling of expression is particularly likely because of the way courts adjudicate trademark infringement claims. For examples:

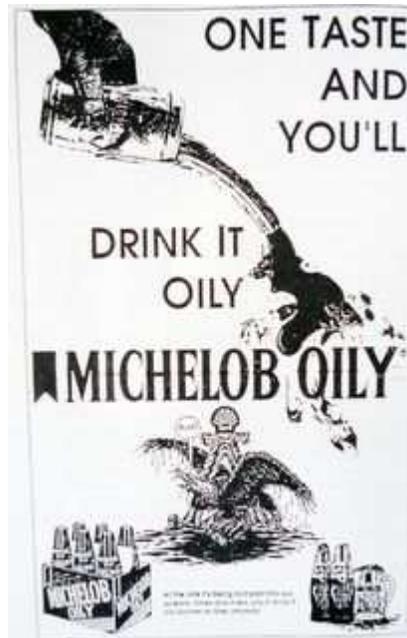
- In order to prevail on a claim for trademark infringement, a plaintiff need only show likelihood of consumer confusion, regardless of whether any consumers are actually confused. 4 McCarthy on Trademarks and Unfair Competition § 23:12 (5th ed.) (“McCarthy”) (“The test of infringement is the *likelihood* of confusion, not the proof of *actual* confusion. To prove liability, the plaintiff is not required to prove any instances of actual confusion.”).
- Courts regularly grant relief on trademark infringement claims when only a small minority of consumers (even as few as 1 in 10 people in a narrow class of consumers) are confused. *See, e.g., RXD Media, LLC v. IP Application Dev., LLC*, 986 F.3d 361, 373 (4th Cir. 2021) (10% confusion supports finding of likelihood of confusion, and 17% confusion is “clear evidence”); *RJR Foods, Inc. v. White Rock Corp.*, 603 F.2d 1058, 1061 (2d Cir. 1979) (15–20% confusion corroborates likelihood of confusion); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 400–01 (8th Cir. 1987) (10%

association can be given “significant weight” in determining likelihood of confusion).

- Unlike with a defamation claim, proving a defendant’s intent is not necessary to prevail on a trademark infringement claim, and courts regularly disregard a defendant’s showing of innocent intent. McCarthy § 23:107 (“The courts have unanimously held that to prove infringement, plaintiff does not bear the burden of pleading or proving an intent” to deceive or confuse, and “[t]he asserted subjective good faith of the defendant is no defense” to trademark infringement).

This combination of features is appropriate in the typical trademark case, because trademark law is designed to protect the public against confusion. But in the absence of limiting First Amendment principles, applying these doctrines to all claims of trademark infringement, including claims against expressive works, risks unconstitutionally suppressing works of commentary and artistic expression in the name of protecting trademarks. *See, e.g., Anheuser-Busch, Inc. v. Balducci Pubs.*, 28 F.3d 769, 776 (8th Cir. 1994) (reversing district court’s dismissal of trademark infringement claim relating to “Michelob Oily” parody advertisement in humor magazine because, although the ad implicated First Amendment interests, the defendant could have reduced the likelihood of consumer confusion by “using an obvious disclaimer, positioning the parody in a less-confusing location,

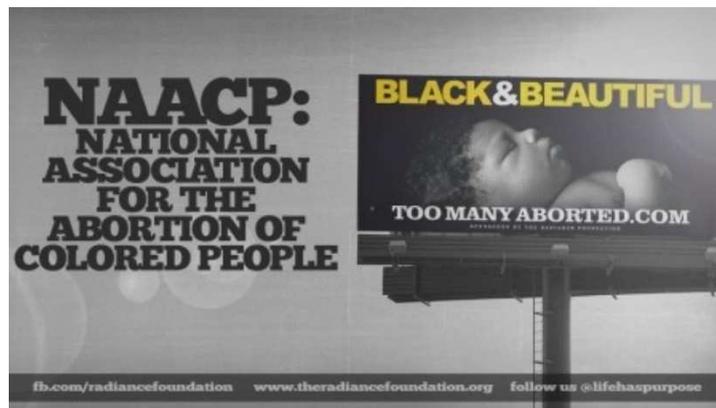
[or] altering the protected marks in a meaningful way”);



Am. Dairy Queen Corp. v. New Line Prods., Inc., 35 F. Supp. 2d 727, 734 (D. Minn. 1998) (granting preliminary injunction against “Dairy Queens” mockumentary satirizing beauty contests in “dairy country,” because “alternative avenues are available for expressing [producer’s] ideas” that do not arguably incorporate Dairy Queen’s trademark); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (affirming preliminary injunction against *Debbie Does Dallas* film depicting cheerleaders wearing uniforms resembling those of the Dallas Cowboys Cheerleaders “[b]ecause there are numerous ways in

which defendants may comment on ‘sexuality in athletics’ without” referencing plaintiff’s marks).

For those reasons, courts in recent decades have correctly recognized that, in order to balance First Amendment interests against the interests protected by trademark law, they must tolerate some degree of consumer confusion in determining whether an expressive work can be subject to liability under the Lanham Act. *See, e.g., Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d Cir. 1989) (holding Lanham Act liability against *Ginger and Fred* film to be precluded by the First Amendment, despite survey evidence of consumer confusion); *Radiance Foundation, Inc. v. NAACP*, 786 F.3d 316, 325 (4th Cir. 2015) (billboard using “NAACP” mark protected by the First Amendment, despite the district court’s finding that consumers were confused as to NAACP’s sponsorship of the billboard).



This approach aligns with this Court’s precedents, which protect even false expression so that artistic and political expression can flourish. *See, e.g., Gertz*

v. Robert Welch, Inc., 418 U.S. 323, 341 (1974) (“The First Amendment requires that we protect some falsehood in order to protect speech that matters.”). The same principle—that courts must accommodate some degree of misleading speech in order to protect expressive freedoms—should apply even more strongly in the case of expression that is merely confusing, not false. *Cf. KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 121–22 (2004) (descriptive fair use doctrine tolerates some level of confusion in order to prevent brand owners from monopolizing the dictionary meaning of words).

B. Courts need engage in a First Amendment analysis only when an expressive work is likely to result in some likelihood of consumer confusion, as in the case of an “unsuccessful parody.”

Where a defendant’s use of another’s trademark is not likely to give rise to any consumer confusion, a court need not analyze the First Amendment because principles of trademark law are sufficient to adjudicate the case. *See Bond v. United States*, 572 U.S. 844, 855 (2014) (it is prudent for a court “not [to] decide a constitutional question if there is some other ground upon which to dispose of the case”); Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 *Colum. J.L. & Arts* 187, 189 (2003–04) (“Where the trademark law, by its own terms, protects the unauthorized use of another’s trademark, there is no need to turn to the Constitution to justify a judgment in the alleged

infringer's favor.”). But when such an expressive use is likely to confuse consumers, appeal to the First Amendment is necessary to consider whether the expression can give rise to liability.

Accommodating expressive interests is particularly important in the context of parody because “[p]arody needs to mimic an original to make its point,” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580–81 (1994), which leaves parodists vulnerable under trademark law. Under prevailing lower-court precedent, parodists have two distinct defenses to a claim of trademark infringement: a trademark parody defense and a First Amendment parody defense.

A “parody defense” under trademark law is simply a variation of a no-likelihood-of-confusion defense. *See* McCarthy § 31:153 (a trademark parody defense “is not an affirmative defense to a charge of trademark infringement. . . . Rather, ‘parody’ is a way of arguing that there will be no trademark infringement because there will be no likelihood of confusion. The parodist argues that the ordinary viewer will not be deceived or confused.”); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 199–200 (5th Cir. 1998) (“In the case of the standard likelihood-of-confusion analysis, a successful parody of the original mark weighs against a likelihood of confusion because, even though it portrays the original, it also sends the message that it is not the original and is a parody, thereby lessening any potential confusion.”). Accordingly, in line with

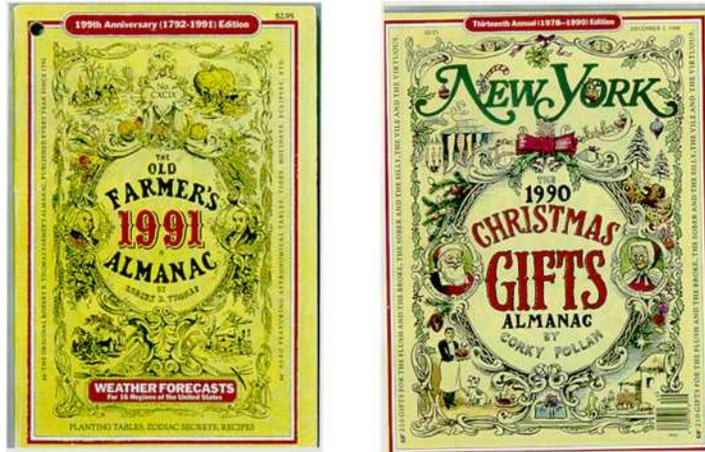
principles of constitutional avoidance, courts regularly dismiss infringement claims against trademark parodies where there is no likelihood of consumer confusion, without reaching the constitutional issue. *See, e.g., Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 443 (S.D.N.Y. 2016) (granting summary judgment for defendant on trademark infringement claim against parodic bag because “there is no triable issue of fact on the likelihood of confusion”);



Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 263 (4th Cir. 2007) (affirming grant of summary judgment for defendant on trademark infringement claim against dog toy because “[Louis Vuitton] has failed to demonstrate any likelihood of confusion”).



But where a parody is vulnerable under trademark law because some consumer confusion is likely—as the district court found in this case, see *VIP Prod., LLC v. Jack Daniel’s Properties, Inc.*, 291 F.Supp.3d 891, 911 (D. Ariz. 2018)—a parodist must resort to a First Amendment parody defense to protect its parodic expression. Such a defense requires a court to balance the defendant’s expressive interests against the public’s interest in avoiding confusion. See *Yankee Pub’g Inc. v. News Am. Pub. Inc.*, 809 F. Supp. 267, 272–82 (S.D.N.Y. 1992) (separately analyzing trademark parody defense and First Amendment defense regarding *New York* magazine cover resembling trade dress of *The Old Farmer’s Almanac*);



Burck v. Mars, Inc., 571 F. Supp. 2d 446, 455 (S.D.N.Y. 2008) (“[E]ven if a parody is not so obvious to negate any likelihood of confusion, it may still be raised as an affirmative defense. . . . The First Amendment protects parodies because they are valid forms of artistic expression and criticism. . . . Whether the parody defense is used in the likelihood of confusion analysis or as an affirmative defense, the end result is the same if the defendant successfully asserts it: the plaintiff may not recover for the defendant’s use of his trademark.”).

Analyzing parodies strictly under a likelihood-of-confusion analysis rather than a framework that accounts for the parodist’s expressive interests would protect only “successful” parodies, where reasonable consumers would not likely be confused as to the source of the parody. But such an approach would render the First Amendment powerless in this context—and it would also conflict with this Court’s precedents, which recognize that “First Amendment

protections do not apply only to those who speak clearly, whose jokes are funny, and whose parodies succeed.” *Campbell*, 510 U.S. at 583 (quoting *Yankee Publ’g*, 809 F. Supp. at 280)).

Because a court need resort to heightened scrutiny only when a work accused of trademark infringement both incorporates noncommercial expression and is likely to cause consumer confusion, application of this heightened scrutiny (such as through the *Rogers* test) is relatively rare and does not substantially disrupt parties’ trademark rights. Indeed, in the more than three decades since the Second Circuit first created the *Rogers* test, trademark law has not come crashing down but has instead made space for good-faith expressive works that incorporate trademarks into their expression.

For all of these reasons, in order to protect the public’s interest in free expression, courts should apply a heightened standard when expressive works face claims of trademark infringement. *See Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Grp., Inc.*, 886 F.2d 490, 494 (2d Cir. 1989) (where the defendant’s work is a “poor parody,” it is “vulnerable under trademark law, since the customer will be confused”; *Rogers* provides the appropriate test in such cases to balance trademark and First Amendment interests).



II. Balancing the public interest in free expression against the public interest in avoiding confusion requires a categorical test that focuses on the nature of the expression and on the alleged infringer’s conduct.

In civil disputes implicating First Amendment interests, this Court has historically favored categorical rules rather than multi-factor balancing tests. For example, in *NAACP v. Claiborne Hardware*, this Court extended First Amendment protections to conspiracy-based torts, holding that, “[f]or [tort] liability to be imposed by reason of association alone, it is necessary to establish that the group itself possessed unlawful goals and that the individual held a specific intent to further those illegal aims.” 458 U.S. 886, 920 (1982). Such a bright-line rule is necessary because “impos[ing] liability without a finding that the [defendant]

authorized – either actually or apparently – or ratified unlawful conduct would impermissibly burden the rights of political association that are protected by the First Amendment.” *Id.* at 931.

This Court has taken a similar categorical approach to defamation and other tort claims. *See Hustler Mag., Inc. v. Falwell*, 485 U.S. 46 (1988) (holding that the First and Fourteenth Amendments bar a public figure from recovering damages on a claim of intentional infliction of emotional distress without a showing of falsity and actual malice); *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964) (holding that, if a defamation plaintiff is a public official or public figure, the plaintiff must prove that the defendant acted with actual knowledge of a statement’s falsity or with reckless disregard to the statement’s truth); *Gertz*, 418 U.S. at 347 (rejecting “strict liability” or “liability without fault” for defamation claims by a private individual against a publisher or broadcaster).

Such categorical rules permit courts to dispose of cases at early stages of litigation, as appropriate, which is necessary to prevent lawsuits that chill protected expression. As this Court has repeatedly recognized, “the fear of damage awards . . . may be markedly more inhibiting [on expression] than the fear of prosecution under a criminal statute.” *BMW of N. Am., Inc. v. Gore*, 517 U.S. 559, 583 n.38 (1996) (quoting *Sullivan*, 376 U.S. at 277). On the other hand, fact-intensive balancing tests like the likelihood-of-confusion test are generally unsuitable

for disposition at a motion to dismiss stage, and are often unsuitable for disposition at a summary judgment stage. Applying such a test to trademark infringement claims against expressive works would severely burden artists' and others' First Amendment rights by requiring them to proceed to trial in order to vindicate their rights, and thereby incur significant litigation costs. The threat of incurring such costs compounds the risk of facing a damages award, even further chilling protected expression.

Another major flaw in applying the likelihood-of-confusion test to expressive works is that the test focuses primarily on the perception of a minority of the consuming public as to the source of the work (whether or not those perceptions are reasonable), rather than on the way a reasonable person would perceive the work's expression and the conduct of the purported infringer. By focusing on a small subgroup's perception of the source of goods or services, without regard for the nature or context of the expression itself, the test fails to account for the purported infringer's First Amendment interests. *See Campbell*, 510 U.S. at 589 ("In parody, as in news reporting, context is everything." (internal citation omitted)).

III. In determining whether the First Amendment precludes Lanham Act liability against a work, courts should focus on the context and content of the work’s expression, not its medium.

A. Distinguishing between a “consumer good” or “commercial product” and an expressive good is untenable and is contrary to this Court’s precedents.

This Court has traditionally applied a medium-neutral analysis to decide whether expression is protected by the First Amendment. *See Brown v. Ent. Merchants Ass’n*, 564 U.S. 786, 790 (2011) (“[W]hatever the challenges of applying the Constitution to ever-advancing technology, ‘the basic principles of freedom of speech and the press, like the First Amendment’s command, do not vary’ when a new and different medium for communication appears.”) (quoting *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 503 (1952)). This Court’s First Amendment jurisprudence would treat a political slogan emblazoned on a t-shirt that is sold in stores across the United States as no less expressive than the same slogan printed on the front of a pamphlet handed out at a local rally, and the shirt would receive no less protection under the First Amendment. *See, e.g., Tinker v. Des Moines Indep. Cmty. Sch. Dist.*, 393 U.S. 503 (1969) (wearing black armbands fully protected by the First Amendment); *Cohen v. California*, 403 U.S. 15 (1971) (jacket fully protected by the First Amendment); *Minn. Voters*

Alliance v. Mansky, 138 S. Ct. 1876 (2018) (state ban on political apparel at polling places violated First Amendment).

As new mediums of expression have been developed, this Court has adapted First Amendment jurisprudence accordingly. For example, the Court has extended First Amendment protection to video games, despite decades of lower court precedent holding that video games were a mere entertainment good. *Compare Brown*, 564 U.S. at 790, *with Am.’s Best Fam. Showplace Corp. v. N.Y.C., Dep’t of Bldgs.*, 536 F. Supp. 170, 174 (E.D.N.Y. 1982) (video games are “pure entertainment” that “contain so little in the way of particularized form of expression that video games cannot be fairly characterized as a form of speech protected by the First Amendment”) (quoting *Stern Elecs., Inc. v. Kaufman*, 669 F.2d 852, 857 (2d Cir. 1982)).

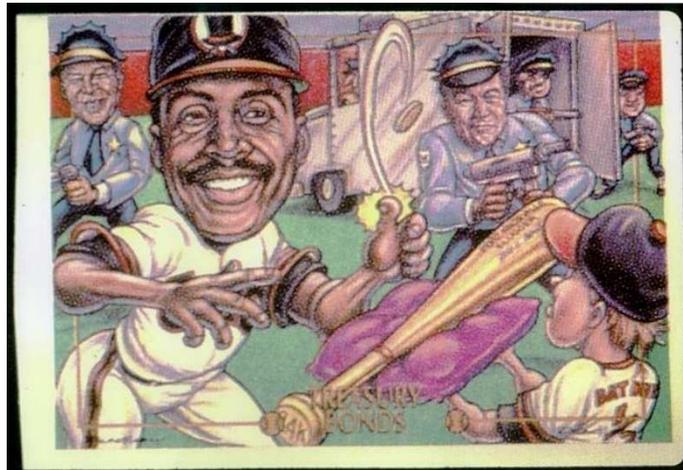
The lower courts have likewise taken a medium-neutral approach to the First Amendment, recognizing the capacity of tangible goods to embody or convey protected expression. *See, e.g., Mastrovincenzo v. N.Y.C.*, 435 F.3d 78, 97 (2d Cir. 2006) (graffiti’d shirts and hats subject to full First Amendment protection);



C.B.C. Distr. and Mktg., Inc. v. Major League Baseball Advanced Media, L.P., 505 F.3d 818 (8th Cir. 2007) (fantasy baseball games protected); *In re Elster*, 26 F.4th 1328 (Fed. Cir. 2022) (t-shirts emblazoned with the words “TRUMP TOO SMALL” protected);



Hilton v. Hallmark Cards, 599 F.3d 894 (9th Cir. 2010) (greeting card featuring the image of Paris Hilton protected); *World Wrestling Fed'n Ent. Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413 (W.D. Pa. 2003) (goods including t-shirts, mugs, sports bottles, stickers, and beanie dolls protected); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 969 (10th Cir. 1996) (parody baseball trading cards entitled to full First Amendment protection because “even if the trading cards are not a traditional medium of expression, they nonetheless contain protected speech”).



Nor does it matter for First Amendment purposes whether a good is sold for a profit. Indeed, this Court has recognized that the distribution and sale of films, music, television shows, and video games to mass audiences—often for a very large profit—does not diminish their First Amendment protection. See *Burstyn*, 343 U.S. at 501–02 (“It is urged that motion pictures do not fall within the First

Amendment's aegis because their production, distribution, and exhibition is a large-scale business conducted for private profit. We cannot agree. That books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment. We fail to see why operation for profit should have any different effect in the case of motion pictures.”). *See also Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989) (“Music, as a form of expression and communication, is protected under the First Amendment.”); *Brown*, 564 U.S. 786 (video games protected); *Bantam Books, Inc v. Sullivan*, 372 U.S. 58, 64 n.10 (1963) (“The constitutional guarantee of freedom of press embraces the circulation of books as well as their publication.”) (citing *Lovell v. City of Griffin*, 303 U.S. 444, 452 (1938)).

This profit-neutral principle follows from this Court's general First Amendment jurisprudence, which makes clear that selling speech does not deprive it of full First Amendment protection. It is “well-settled” that First Amendment rights “are not lost merely because compensation is received.” *Riley v. Nat'l Fed'n of the Blind of N.C., Inc.*, 487 U.S. 781, 801 (1988); *see also City of Lakewood v. Plain Dealer Pub'g Co.*, 486 U.S. 750, 756 n.5 (1988) (“[T]he degree of First Amendment protection is not diminished merely because the . . . speech is sold rather than given away.”); *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 418–23 (1993) (speech does not lose protection because it arises

from a speaker's economic interest); *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 482 (1989) (“Some of our most valued forms of fully protected speech are uttered for a profit.”).

B. The threshold question for whether a work that incorporates another party's trademark is subject to heightened scrutiny should be whether a reasonable person would understand the work inherently to convey noncommercial expression or to convey such expression in a manner inextricable from the functional or commercial elements of the work.

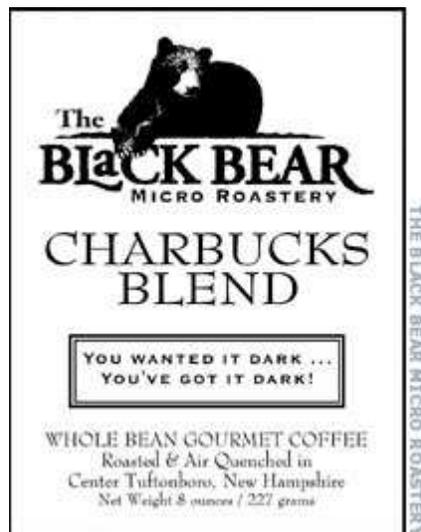
For the reasons explained above, “commercial good” is not a cognizable First Amendment category. Rather than distinguishing between commercial and noncommercial goods, this Court's cases distinguish between commercial expression (such as pure advertising) and noncommercial expression (such as political, artistic, or religious speech, regardless of whether that speech is sold). Whenever the commercial aspects of a work are intertwined with artistic content, the First Amendment dictates that the trademark-using speech must be considered “noncommercial” (*i.e.*, speech that does more than propose a commercial transaction, as pure advertising does) and thus subject to full First Amendment protection. *See Riley*, 487 U.S. at 796 (“[W]e do not believe that . . . speech retains its commercial character when it is inextricably intertwined with otherwise fully protected speech”); *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484,

499 (1996) (“[T]he State retains less regulatory authority when its commercial speech restrictions strike at the substance of the information communicated rather than the commercial aspect of it”).

Accordingly, the threshold question for whether a work accused of trademark infringement is subject to heightened scrutiny should be whether a reasonable person would perceive either (a) that a work is inherently a form of noncommercial expression (such as a novel or painting) or (b) that the work (whether a t-shirt, dog toy, or sneaker) contains noncommercial expression that is inextricably intertwined with the functional or commercial elements of the work, even if a reasonable person could not discern the precise meaning of the expression. *Cf. Campbell*, 510 U.S. at 583 (“First Amendment protections do not apply only to those who speak clearly” (quoting *Yankee Publ’g*, 809 F. Supp. at 280)).

Where a First Amendment claim is pretextual or lacking in merit—such as where a defendant uses a mark strictly to advertise or sell its own products, not to convey noncommercial expression—courts have generally proven themselves adept at recognizing that the First Amendment does not apply. *See, e.g., Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812–13 (2d Cir. 1999) (rejecting First Amendment defense because the defendant “ma[de] no comment on Harley’s mark” and instead “simply use[d] it somewhat humorously to promote his own

products and services,” in contrast to “parodists whose expressive works aim[ed] their parodic commentary at a trademark or a trademarked product”); *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 113 (2d Cir. 2009) (CHARBUCKS mark used only “as a beacon to identify Charbucks as a coffee that competes at the same level and quality as Starbucks in producing dark-roasted coffees,” not as part of defendant’s non-commercial expression).



Because such uses contain no discernible noncommercial expression, they would not pass the threshold question to receiving heightened scrutiny.

IV. A modified version of the *Rogers v. Grimaldi* test can properly balance the interests protected by the First Amendment and trademark law.

A. *Rogers* has served as a useful tool for courts to balance First Amendment and Lanham Act interests.

Over the past few decades, the lower courts have generally balanced the public interest in expression and the interest in avoiding consumer confusion in accordance with the principles explained above. The prevailing approach in the lower courts was first laid out by the Second Circuit in 1989 in *Rogers v. Grimaldi*, which set a bright-line rule that correctly focuses on the nature of a purported infringer's expression and the nature of its conduct. The *Rogers* test precludes Lanham Act liability against works of noncommercial expression, even if those works are likely to result in some consumer confusion, unless the use of the plaintiff's trademark is either (a) not artistically relevant or (b) explicitly misleading. 875 F.2d at 1000. If a work does not incorporate noncommercial expression or fails the *Rogers* test, it is subject to the traditional likelihood-of-confusion analysis to determine whether it is subject to Lanham Act liability.

The *Rogers* test thus calls for a categorical analysis rather than fact-intensive, multi-factor balancing, which aligns with this Court's precedents for civil disputes implicating First Amendment interests. The House Judiciary Committee

recognized this in the legislative history of the Lanham Act’s latest amendment, which states that the *Rogers* test “appropriately recognizes the primacy of constitutional protections for free expression.” H.R. Rep. No. 116-645, at 20 (2020).

The *Rogers* test also correctly focuses on the content and context of a work’s expression, regardless of the medium of expression. By its own terms, *Rogers* applies to “hybrid” works that “combin[e] artistic expression and commercial promotion,” where the artistic and commercial aspects are “inextricably intertwined.” 875 F.2d at 998. Courts (including the lower courts in this case) have appropriately applied *Rogers* to tangible goods that incorporate noncommercial expression, in line with this Court’s medium-neutral approach to the First Amendment. *See, e.g., VIP Prods. LLC v. Jack Daniel’s Prods., Inc.*, 953 F.3d 1170, 1174–76 (9th Cir. 2020) (dog toy); *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1195, 1196–97 (9th Cir. 2017) (shirts, champagne glasses); *N.Y. Racing Ass’n, Inc. v. Perlmutter Publ’g, Inc.*, No. 95-CV-994, 1996 WL 465298, at *1, 4 (N.D.N.Y. July 19, 1996) (shirts, note cards, greeting cards); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012) (calendars).

B. The *Rogers* test should be modified so that it is administrable and so that it appropriately balances First Amendment and Lanham Act interests.

Although the *Rogers* test generally provides an effective way to balance expressive interests with interests in avoiding consumer confusion, the test has been unevenly applied by the lower courts—for example, in their interpretation of the “explicitly misleading” standard, as discussed below—largely due to ambiguities inherent in the test. There are numerous ways *Rogers* could be revised, and numerous alternatives to *Rogers* have been proposed over the decades. This brief proposes a new test that aims to retain the valuable features of *Rogers* while enhancing its administrability for the courts, predictability for prospective litigants, and congruence with this Court’s precedents.

1. The new test

When a defendant raises a First Amendment defense and makes a *prima facie* showing that the work accused of trademark infringement is a work of expression subject to full First Amendment protection (as defined in Section III.B, above), courts should presume that Lanham Act liability is precluded. Such a presumption lends appropriate deference to constitutionally protected expression, limited only when overridden by narrow but nonetheless important countervailing interests.

Upon a defendant's showing that the accused work is sufficiently expressive, the burden would shift to the plaintiff to rebut that presumption through a showing that the defendant's use of the plaintiff's mark is either explicitly misleading or clearly gratuitous. If the use falls into either exception, the court should deny the defendant's First Amendment defense and apply standard Lanham Act doctrine to determine whether the work is subject to liability. Where neither exception applies, the Lanham Act claim should be dismissed as barred by the First Amendment.

2. Explicit misleadingness

The second prong of the *Rogers* test, which considers whether a use of another party's trademark is explicitly misleading, appropriately dictates that a defendant's affirmative deception overrides the application of heightened scrutiny.

When establishing the *Rogers* test, the Second Circuit explained that "explicitly misleading" means that a use "explicitly denote[s] authorship, sponsorship, or endorsement" and is not merely "ambiguous or only implicitly misleading." 875 F.2d at 999–1000, 1005. Thus, under *Rogers*, confusion surrounding an expressive work cannot contribute to liability under the Lanham Act unless the defendant made an "explicit indication," "overt claim," or "explicit misstatement" that caused the confusion. *Id.* at 1001. The Second Circuit provided illustrative examples of the types of misleading statements that

this second prong targets for exclusion from heightened scrutiny:

[S]ome titles—such as “Nimmer on Copyright” and “Jane Fonda’s Workout Book”—explicitly state the author of the work or at least the name of the person the publisher is entitled to associate with the preparation of the work. Other titles contain words explicitly signifying endorsement, such as the phrase in a subtitle “an authorized biography.” If such explicit references were used in a title and were false as applied to the underlying work, the consumer’s interest in avoiding deception would warrant application of the Lanham Act, even if the title had some relevance to the work.

Id. at 999. Focusing on a defendant’s explicit statements in this way allows courts to consider objective indicia of a defendant’s intent to free-ride on a plaintiff’s good will, if appropriate, without burdening the defendant’s expression by considering “ambiguous” or “only implicit” statements, or by engaging in a fact-intensive analysis of the defendant’s subjective intent.

The Ninth Circuit has followed the Second Circuit’s original vision, explaining that “[w]e must ask not only about the likelihood of consumer confusion but also whether there was an ‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement’ that caused such consumer confusion,” or else courts will “conflate[] the second prong of the *Rogers* test with the general [] likelihood-of-confusion test, which

applies outside the *Rogers* context of expressive works.” *Twentieth Century Fox*, 875 F.3d at 1199. This approach correctly focuses on the conduct of the alleged infringer, requiring a showing of some affirmative conduct that deceives consumers in order to find explicit misleadingness. *See Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1246 (9th Cir. 2013) (“[T]o be relevant [to the explicitly misleading prong of *Rogers*], evidence must relate to the nature of the behavior of the [defendant], not the impact of the use” on consumers); *see also E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) (“[T]he mere use of a trademark alone cannot suffice to make such use explicitly misleading” under *Rogers*).

In contrast, courts in the Second Circuit have departed from *Rogers* and generally assessed explicit misleadingness through a modified version of the standard likelihood-of-confusion factors, requiring that a finding of likelihood of confusion must be “particularly compelling” to qualify as explicitly misleading. *See Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993).

Analyzing the likelihood-of-confusion factors as a proxy for explicit misleadingness renders the *Rogers* test insufficiently protective of First Amendment interests for the same reasons the likelihood-of-confusion test is ill-suited to balance interests under the First Amendment and trademark law, as explained in Section I. Indeed, “the [likelihood-of-confusion] test is at best awkward in the context of”

certain expressive works, *Cliffs Notes*, 886 F.2d at 495 n.3, and “fails to account for the full weight of the public’s interest in free expression.” *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 900 (9th Cir. 2002). The Second Circuit’s standard is also difficult—if not impossible—to administer, because the “particularly compelling” standard is unworkably vague and inherently subjective. How could a court—much less an artist or a political commentator—know whether application of the likelihood-of-confusion factors would render confusion “particularly compelling”? Rather than requiring courts to analyze a multi-factored standard (which would often preclude a motion to dismiss or for summary judgment), courts should instead simply consider whether there is a false statement of affiliation, endorsement, or sponsorship. Anything less would elevate the Lanham Act’s confusion analysis above the First Amendment’s protection of expression.

Furthermore, nesting a likelihood-of-confusion analysis within a First Amendment analysis overdetermines the conclusion and necessarily burdens First Amendment interests, because a test accounting for a purported infringer’s free speech interests need be applied only when there is some likelihood of consumer confusion, or else trademark law would be sufficient to resolve the case. *See* Section I.B, *supra*. Requiring that the plaintiff merely show a heightened degree of consumer confusion would render both the First Amendment and artists’ rights to comment on our commercial culture a nullity.

For all of these reasons, courts should apply *Rogers's* explicit misleadingness prong independent of the likelihood-of-confusion analysis.

3. Clear gratuitousness

Although the purpose of *Rogers's* “artistic relevance” prong is laudable—to ensure there is some nexus between the use and the expression, affording courts the ability to weed out works where the use is unrelated to the defendant’s protected expression and thus gratuitous—the prong is flawed in a number of ways. For example, it fails to provide district courts sufficient guidance on how relevant a use needs to be and the appropriate method for determining whether a use is relevant. Furthermore, by asking courts to assess whether a purported infringer’s use of a trademark is “artistically relevant,” the *Rogers* test arguably requires courts to serve as art critics, considering a work’s artistic merit or probing its hidden meaning—which is a role courts are ill-suited to perform. As Justice Holmes explained in *Bleistein v. Donaldson Lithographing Co.*, “it would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations.” 188 U.S. 239, 251 (1903); *see also Pope v. Illinois*, 481 U.S. 497, 505 (1987) (Scalia, J., concurring) (“For the law courts to decide ‘What is Beauty’ is a novelty even by today’s standards.”). Furthermore, even if courts were capable of acting as adept art critics, they would not be able to reach predictable or uniform conclusions regarding the

“artistic relevance” of any particular use of a mark. The first *Rogers* prong, as currently formulated, thus inherently results in inconsistency.

This brief proposes that instead of considering whether a defendant’s use of a trademark is artistically relevant, courts instead probe the nexus between a defendant’s use of another party’s mark and its expression by asking whether the use is “clearly gratuitous.” Where a work “can stand on its own two feet” without use of the plaintiff’s mark because the use is unnecessary to convey a certain message, the defendant “requires justification for the very act of borrowing.” *Campbell*, 510 U.S. at 581. If there is clearly no such justification for a use—such as where a defendant merely promotes a product through lighthearted association with another brand—the work would fail our proposed test, and courts would then apply standard principles of trademark law.

In considering whether a defendant’s use of another party’s mark is clearly gratuitous, courts should consider evidence regarding whether the use has or lacks an apparent good-faith nexus to the defendant’s purported protected expression, or whether the brand’s use serves merely to promote a product through association with another brand. Such a nexus could be found in many different types of works. For examples:

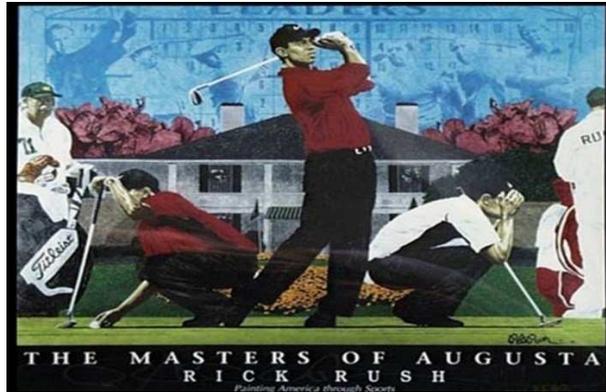
- Works of parody and satire, which directly comment on or critique the mark or mark

owner or something symbolized by the mark or mark owner, respectively. *See, e.g., Cliffs Notes*, 886 F.2d 490 (*Spy Notes* parody of *Cliffs Notes* book); *My Other Bag*, 156 F. Supp. 3d 425 (“My Other Bag” parody of Louis Vuitton bag); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003) (“Food Chain Barbie” photograph series).



- Informational or representational uses of a plaintiff's mark, as with a still-life painting that depicts a bottle of Coca Cola, or a film that depicts the Disney Store in Times Square. *See, e.g., Dickinson v. Ryan Seacrest Enters., Inc.*, No. 18-CV-2544, 2019 WL 3035090 (C.D.

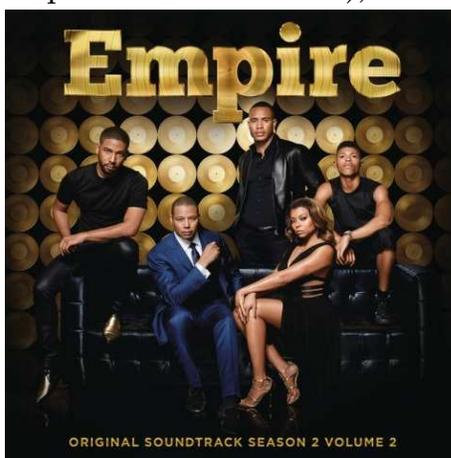
Cal. Mar. 26, 2019), *aff'd*, 839 F. App'x 110 (9th Cir. 2020), *cert. denied*, 141 S. Ct. 2861 (2021) (TV program showing video of plaintiff backstage at a fashion show); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003) (paintings of the golfer Tiger Woods contained in envelopes bearing Woods's name);



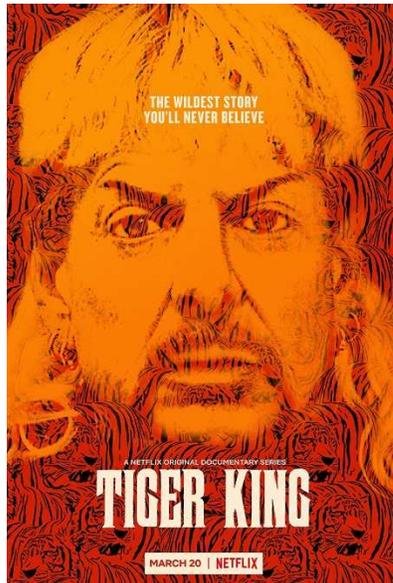
Elec. Arts, Inc. v. Textron Inc., No. 12-CV-118, 2012 WL 3042668 (N.D. Cal. July 25, 2012) (depiction of war helicopters in realistic war video game); *Univ. of Ala. Bd. of Trs.*, 683 F.3d 1266 (paintings, prints, and calendars depicting famous scenes in University of Alabama football history, with players wearing team uniforms).



- Titles of expressive works that relate directly to the subject matter of the works themselves. *Rogers*, 875 F.2d at 994 (Federico Fellini’s film titled *Ginger and Fred*, which depicted two characters impersonating the famous acting and dancing duo Ginger Rogers and Fred Astaire); *Twentieth Century Fox*, 875 F.3d 1192 (TV show called *Empire* about a music mogul running a music “empire” at a company called “Empire Entertainment”);



Stouffer v. Nat'l Geographic Partners, LLC, 460 F. Supp. 3d 1133 (D. Colo. 2020) (nature documentaries titled “Untamed Americas,” “America the Wild,” “Surviving Wild America,” and “America’s Wild Frontier”); *Jackson v. Netflix, Inc.*, 506 F. Supp. 3d 1007 (C.D. Cal. 2020) (TV show called *Tiger King* about a man operating a tiger sanctuary).



Had the Eighth Circuit applied this standard to the “Michelob Oily” parody ad at issue in *Anheuser-Busch*, 28 F.3d 769, the court would have found a clear good-faith nexus between the defendant’s use of the MICHELOB marks and the defendant’s humorous commentary on the plaintiff’s production of Michelob beer with water from a river contaminated by an oil spill. Similarly, the defendant’s use of the title “Dairy Queens” at issue

in *American Dairy Queen Corp.*, 35 F. Supp. 2d 727, was not clearly gratuitous, as the mockumentary satirized beauty queens in “dairy country.”

Where, on the other hand, a work clearly trades on the good will or recognizability of a trademark holder without any apparent good-faith rationale for such use, courts should deny the defendant’s First Amendment defense and conduct a standard trademark infringement analysis. For example, the DOM POPIGNON popcorn at issue in *Schieffelin*, 850 F. Supp. 232, made no discernible commentary or critique of Dom Pérignon, its marks for champagne, or anything represented by Dom Pérignon. Nor did the defendant’s popcorn adopt the Dom Pérignon trade dress and marks for any other apparent purpose except to promote its popcorn product. Mere wordplay does not justify use of another’s mark. The same is true for the TIMMY HOLEDIGGER pet perfume at issue in *Tommy Hilfiger*, 221 F. Supp. 2d 410 (applying the likelihood-of-confusion factors and ultimately finding no Lanham Act violation because the joke was so obvious that consumers would not reasonably be confused as to source).



A brand promoting itself through lighthearted association with another brand is not the type of expression that warrants deference under the First Amendment. *See Harley Davidson*, 164 F.3d at 812–13 (rejecting First Amendment defense because the defendant “simply use[d] [Harley Davidsons’ marks] somewhat humorously to promote his own products and services”); *A.V.E.L.A. v. Est. of Marilyn Monroe*, 364 F. Supp. 3d 291, 322 (S.D.N.Y. 2019) (finding t-shirts bearing likeness of Marilyn Monroe not subject to First Amendment protection in part because shirts incorporated Monroe’s likeness merely to “draw consumer attention,” not to comment on Monroe or otherwise express non-commercial ideas); *Starbucks*, 588 F.3d at 113 (defendant used the CHARBUCKS brand merely to associate its coffee with Starbucks’ coffee). Such

uses do not warrant heightened scrutiny and should instead be assessed under the standard likelihood-of-confusion analysis, as they lack any apparent justification for their borrowing.

Inquiring whether a use is clearly gratuitous would ensure protection for valuable commentary on or criticism of a brand or brand owner, artistic representations of the world, and titles that flow naturally from a work's subject matter, while weighing toward protection of the public from confusion where a defendant clearly uses a brand's trademark to free-ride on that brand's good will.

There will undoubtedly be difficult cases where the line between a gratuitous use and a genuine commentary is not clear—but not every case is difficult. Indeed, many cases could easily be dismissed at the early stages of litigation because the work is plainly expressive and the use is neither explicitly misleading nor clearly gratuitous. *See, e.g., Lemme v. Nat'l Broad. Co., Inc.*, 472 F. Supp. 2d 433 (E.D.N.Y. 2007) (TV show about the experiences of a fictional family in the United States titled “American Dreams”); *Hidden City Philadelphia v. ABC, Inc.*, No. 18-cv-65, 2019 WL 1003637 (E.D. Pa. Mar. 1, 2019) (“journalistic videos . . . about rare, historic locations in Philadelphia, Pennsylvania” entitled “Hidden Philadelphia”).



4. Application of the test to Bad Spaniels

The facts of this case present a closer question than the uses at issue in *Harley Davidson*, *Starbucks*, *Schieffelin*, and *Tommy Hilfiger*. The number and variety of Respondent’s jokes and puns, coupled with Respondent’s drawing of a cartoon dog, renders the Bad Spaniels toy more expressive—even if only slightly so—than the Timmy Holedigger pet perfume and the Dom Popignon popcorn. Nevertheless, as explained above, a brand’s mere wordplay and humorous association with another brand to promote its products is clearly gratuitous. Such uses do not warrant deference under the First Amendment and instead can be addressed through standard principles of trademark law. Accordingly, the Court should remand, as necessary, so that the lower courts can determine whether Respondent’s use is clearly gratuitous based on the standard outlined above.

CONCLUSION

In resolving this dispute, the Court should apply the test proposed above. In any event, the Court should apply a test that appropriately balances First Amendment and Lanham Act interests, by adopting a categorical test rather than a fact-intensive, multi-factor balancing test, focusing on the nature of the protected expression and the purported infringer's conduct, and applying it in a medium-neutral manner.

Respectfully submitted,

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APPENDIX

TABLE OF APPENDICES

APPENDIX A – SIGNATORIES.....1a

APPENDIX A – SIGNATORIES

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