

No. 22-148

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**In the Supreme Court of the United States**

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JACK DANIEL'S PROPERTIES, INC.,

*Petitioner,*

*v.*

VIP PRODUCTS LLC,

*Respondent.*

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

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**BRIEF FOR CAMPBELL SOUP COMPANY  
AS *AMICUS CURIAE* IN SUPPORT  
OF PETITIONER**

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**INTRODUCTION AND INTEREST OF  
*AMICUS CURIAE*<sup>1</sup>**

Campbell Soup Company is a leading manufacturer of high-quality soups, simple meals, snacks, and beverages. Since 1898, Campbell Soup has marketed its food products using its famous trademark and distinctive trade dresses. The company’s red and white soup labels are instantly recognizable and iconic. See, e.g., *Twentieth Century Fox Television v. Empire Distribution, Inc.*, 875 F.3d 1192, 1198 n.2 (9th Cir. 2017) (“Campbell’s is an iconic soup brand”).

Today, Campbell Soup’s popular brands include CAMPBELL’S® and CHUNKY® soups, PEPPERIDGE FARM® baked goods, GOLDFISH® crackers, KETTLE BRAND® and CAPE COD® potato chips, MILANO® cookies, PACE® salsa, POP SECRET® popcorn, PREGO® pasta sauces, SNYDER’S OF HANOVER® pretzels, and V8® beverages.

Campbell Soup regards its trademarks and trade dresses—and robust legal protection of them—as essential ingredients of its success. To help achieve billions of dollars in annual sales, Campbell Soup spends hundreds of millions of dollars every year to maintain and cultivate consumer awareness of its brands.

Campbell Soup has a strong interest in this case. The Ninth Circuit’s erroneous construction of the

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<sup>1</sup> Pursuant to Supreme Court Rule 37.6, *amicus curiae* states that no counsel for any party authored this brief in whole or in part and that no entity or person, aside from *amicus curiae*, its members, and its counsel, made any monetary contribution toward the preparation or submission of this brief.

Lanham Act and Trademark Dilution Revision Act of 2006 (TDRA) have denied trademark owners and consumers the important protections that Congress intended, and that the statutory text plainly provides, they should have. Campbell agrees with Petitioner that this Court should reverse the decision below. It writes separately to explain why the two holdings of the Ninth Circuit—one concerning trademark infringement claims under the Lanham Act and the other concerning dilution by tarnishment claims under the TDRA—have no basis in the statutory text or First Amendment and are problematic for trademark owners and consumers alike.

### SUMMARY OF ARGUMENT

In the decision below, the Ninth Circuit held that, even if a Lanham Act plaintiff demonstrates a strong likelihood of consumer confusion, that is not enough to establish trademark infringement in a case involving a commercial product that expresses a humorous message. The Ninth Circuit also held that, when such a product is at issue, a claim of dilution by tarnishment under the TDRA cannot succeed. The court of appeals was wrong on both counts.

First, the heightened burden the Ninth Circuit imposed on these Lanham Act plaintiffs under *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989)—requiring them to show that the use of their mark is not artistically relevant to the infringing work or that the use explicitly misleads consumers—has no basis in the Lanham Act’s text or the Constitution. The First Amendment does not authorize the Ninth Circuit to rewrite the unambiguous language of that Act or to

decide not to apply the law as written. When a defendant's commercial use of another's mark causes significant consumer confusion, a decision to impose trademark infringement liability under the Lanham Act clearly comports with the First Amendment. Indeed, the likelihood-of-confusion test is entirely consistent with this Court's precedent holding that the First Amendment allows the government to limit deceptive and misleading speech.

Next, the Ninth Circuit was wrong to construe an exception in the TDRA that permits *noncommercial* use of a mark to permit humorous *commercial* use of a mark. Under the Ninth Circuit's equation, *commercial use + humor = noncommercial use*. But nothing in the TDRA supports the use of such twisted arithmetic to the detriment of mark owners. On the contrary, the Ninth Circuit's interpretation of the statute would allow the exception for noncommercial speech to swallow the rule prohibiting dilution, in violation of basic standards of statutory construction.

In addition to misconstruing federal law, the decision below, if affirmed, would have serious—and dangerous—consequences for consumers and companies. In the food and drink context, in particular—as Campbell Soup's experience confirms—consumer confusion over the products being purchased can lead to serious adverse health effects. Companies like Campbell Soup regularly contend with unauthorized and inferior imitations of their products, some of which are not even fit for human consumption. The rule adopted by the Ninth Circuit in this case will foster such mimicry and deprive both consumers and trademark owners of critical protections Congress

has provided. This Court should reverse the decision below and instruct the courts below to apply the Lanham Act and TDRA as written.

## ARGUMENT

### **I. The Ninth Circuit Has Misinterpreted Federal Statutes and the Constitution to Significantly Undermine Congress’s Protection of Trademark and Trade Dress Rights.**

As Petitioner correctly explains, Br. for Pet’r 21–38, nothing in the Lanham Act or the TDRA compels the heightened standards for trademark infringement and dilution the Ninth Circuit adopted below. That court erred in failing to apply those statutes as written.

#### **A. The Heightened Burden the Ninth Circuit Applied Under the Lanham Act Has No Basis in the Statutory Text or the Constitution.**

1. In the decision below, the Ninth Circuit decided to impose a “heightened burden” on Lanham Act plaintiffs whenever a defendant exploits the plaintiff’s mark to sell a commercial product and uses a purportedly humorous message in the process. Nothing in the text of that Act supports such a hurdle. Respondent VIP acknowledged as much the first time this case came before the Court, explaining that courts “use the *Rogers* test ‘as a rule of construction to avoid’” a purported “conflict between the Constitution and the Lanham Act.” Br. in Opp’n at 11, *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 141 S. Ct. 1054 (2021) (No. 20-365) (mem.) [hereinafter (No. 20-

365)] (quoting *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018)). See *Twentieth Century Fox Television*, 875 F.3d at 1196 n.1 (“the *Rogers* test is a limiting construction of the Lanham Act” informed by First Amendment considerations).

The Ninth Circuit has taken this purported constitutional avoidance even further, explaining that it uses *Rogers* “to determine *whether* the Lanham Act *applies*” in the first place. *Id.* at 1196 (emphases added). See Pet. App. 30a (“[W]e have held that the Lanham Act only applies to expressive works if the plaintiff establishes one of the two requirements in the test set forth in *Rogers*”). The First Amendment, however, does not authorize courts to rewrite the Lanham Act, much less to decline to apply the statute at all.

Rather, this Court has made clear that, in a Lanham Act case, a court’s “limited role is to read and apply the law those policymakers have ordained.” *Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S. Ct. 1492, 1497 (2020). The Court has further emphasized that the Act must be interpreted based on “the statute’s language, structure, and history.” *Id.* at 1497. See *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 151 (2015) (construing the Lanham Act based on its “text” and “structure”); *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985) (interpreting the Lanham Act based on “the ordinary meaning” of “the language employed by Congress”). The Act must not be interpreted, this Court has said, by “read[ing] into [it] words that aren’t there.” *Romag Fasteners*, 140 S. Ct. at 1495.

Yet that is precisely what the Ninth Circuit has done here. “One searches the language of the Lanham Act in vain to find any support,” *Park 'N Fly*, 469 U.S. at 196, for the heightened burden that court has imposed. The operative language of that statute asks if “the defendant’s use of a mark in commerce ‘is likely to cause confusion, or to cause mistake, or to deceive’ with regards to the plaintiff’s mark.” *B & B Hardware*, 575 U.S. at 144 (quoting 15 U.S.C. § 1114(1)(a) and § 1125(a)(1)(A)). It does not draw a distinction between expressive and non-expressive works; nor does it ask whether a challenged use has artistic relevance to the underlying work or explicitly misleads.

2. The Ninth Circuit had no warrant to rewrite unambiguous provisions of the Lanham Act based on general First Amendment principles. To be sure, courts “may interpret ambiguous statutory language to avoid serious constitutional doubts.” *Iancu v. Brunetti*, 139 S. Ct. 2294, 2301 (2019) (quotation marks omitted). “But that canon of construction applies only when ambiguity exists.” *Id.* Therefore, even if a suggested “reading would eliminate First Amendment problems, [the Court] may adopt it only if [the Court] can see it in the statutory language.” *Id.* To the extent that First Amendment issues might arise from certain applications of the Lanham Act, they “cannot be fixed” by “rewriting the statute.” *Id.* at 2302 (Alito, J., concurring).

The avoidance canon does not come into play here, for multiple reasons. First, the Lanham Act is not ambiguous in any relevant respect. The trial court in this case had no trouble applying the statutory likeli-

hood-of-confusion test to evaluate the Lanham Act claims. See Pet. App. 62a–75a. Nor is there any basis for concluding that the *Rogers* test substituted by the Ninth Circuit may be gleaned from the text of the statute. The Ninth Circuit simply made it up.

The relevant provisions of the Lanham Act are, moreover, constitutional on their face. The Lanham Act’s express purposes include “making actionable the deceptive and misleading use of marks” and “prevent[ing] fraud and deception ... by the use of ... colorable imitations of registered marks.” 15 U.S.C. § 1127. And this Court has long recognized that Congress “constitutionally may regulate ‘deceptive or misleading’ commercial speech” through laws protecting trademark rights. *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 535 n.12 (1987). “[R]egulating confusing uses ... is within normal trademark bounds.” *Id.* See also *Matal v. Tam*, 137 S. Ct. 1744, 1768 (2017) (Kennedy, J., concurring in part and concurring in the judgment) (“It is well settled” that trademark laws may protect consumers and mark owners from “confusing or misleading” uses). Cf. *In re R.M.J.*, 455 U.S. 191, 203 (1982) (“[W]hen the particular content or method of the advertising suggests that it is inherently misleading or when experience has proved that in fact such advertising is subject to abuse, the States may impose appropriate restrictions.”).

Indeed, this Court has long affirmed that the First Amendment does not prevent the government from restricting deceptive and misleading speech. “[T]here is no constitutional value in false statements of fact.” *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 340 (1974).

Even true, but misleading, statements are subject to regulation. In *Donaldson v. Read Magazine, Inc.*, for example, this Court affirmed the Postmaster General’s authority under federal law to deem certain mail fraudulent and thus undeliverable. 333 U.S. 178, 188–192 (1948). The Court explained that “[a] contention cannot be seriously considered which assumes that freedom of the press includes a right to raise money to promote circulation by deception of the public.” *Id.* at 192. And the Court recognized that “[a]dvertisements as a whole may be completely misleading although every sentence separately considered is literally true.” *Id.* at 188.<sup>2</sup>

Under these established First Amendment principles, “for commercial speech to come within” the protections of the First Amendment, it must “concern lawful activity and not be misleading.” *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 554 (2001) (citations omitted). The Lanham Act complies with that requirement “by enforcing a trademark only when consumers are likely to be misled or confused by the alleged infringer’s use.” *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008). The likelihood-of-confusion test that the Ninth Circuit declined to apply thus presents no First Amendment concerns whatsoever.

Respondent accordingly errs in claiming that, because it intended its dog toys to be expressive, Con-

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<sup>2</sup> Cf. *Illinois ex rel. Madigan v. Telemarketing Assocs., Inc.*, 538 U.S. 600, 606 (2003) (applying similar principles in a charitable, not commercial, context and finding that “the First Amendment leaves room for a fraud claim” against charities that mislead would-be donors).

gress cannot regulate them. Br. in Opp’n at 25, 30. As this Court has recognized, congressional action that falls within “the scope of trademark law protections”—including the likelihood-of-confusion test—is “certainly within constitutional bounds.” *San Francisco Arts & Athletics*, 483 U.S. at 534–535. Thus, when faced with allegations that the Amateur Sports Act violated the First Amendment by preventing a group seeking to use the word “Olympic,” this Court had no problem rejecting those claims, explaining that the “mere fact that” an alleged infringer “claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to ‘appropriat[e] to itself the harvest of those who have sown.’” *Id.* at 541 (quoting *International News Serv. v. Associated Press*, 248 U.S. 215, 239–240 (1918)). In fact, it would be difficult to find commercial speech that does *not* have expressive content. See Br. for Pet’r 29. Yet this Court has repeatedly held that the government may regulate such speech consistent with the First Amendment. See, e.g., *Lorillard Tobacco Co.*, 533 U.S. at 554–555; see also *Donaldson*, 333 U.S. at 192 (even “freedom of the press” subject to limitations on misleading speech).

Because the dog toy at issue in this case is clearly deceptive—the trial court credited expert evidence that 29% of potential purchasers “are likely to be confused or deceived” by the toy, Pet. App. 67a—imposing liability under the Lanham Act’s likelihood-of-confusion standard raises no First Amendment problem and instead falls squarely within the regulation permitted by this Court’s precedent. The Court should, therefore, reject the Ninth Circuit’s ultra-

vires rewriting of the Lanham Act and hold that courts must apply the statute as written.

**B. The Ninth Circuit Erred in Transforming the TDRA’s “Noncommercial Use” Exception to Authorize Commercial Use of a Mark.**

After rewriting the Lanham Act, the Ninth Circuit took it upon itself to blue-pencil the TDRA and make it impossible for trademark owners to prevail in alleging that the sale of a purportedly humorous product has resulted in dilution by tarnishment. That decision is nonsensical on its face and cannot be squared with basic rules of statutory construction.

1. In adopting the TDRA in 2006, Congress acted to strengthen an earlier statute, the Federal Trademark Dilution Act of 1995 (FTDA), Pub. L. 104-98, 109 Stat. 985 (1996), in response to this Court’s decision in *Moseley v. V Secret Catalogue, Inc.*, 123 S. Ct. 1115 (2003). In that case, this Court held that the FTDA required a showing of actual dilution rather than a mere likelihood of dilution. The TDRA now provides relief if a plaintiff shows that the defendant’s use of the plaintiff’s famous mark is “likely to cause dilution,” 15 U.S.C. § 1125(c)(1), which is “conduct that lessens the association consumers have with a trademark.” *Romag Fasteners*, 140 S. Ct. at 1495. The TDRA provides for two types of dilution claims: dilution by blurring and dilution by tarnishment.

The TDRA defines dilution by tarnishment as the “association arising from the similarity between a mark or trade name and a famous mark that harms

the reputation of the famous mark.” 15 U.S.C. § 1125(c)(2)(C). The TDRA generally entitles the owner of a famous mark to injunctive relief if another person “commences uses of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark.” *Id.* § 1125(c)(1). And, unlike the Lanham Act, the TDRA does not require plaintiffs to prove confusion. See *id.* (authorizing injunctive relief as a remedy for dilution “regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury”). The TDRA thus recognizes that it may, for example, harm a purveyor of fine chocolates to have its products associated with cat and dog food. See *Grey v. Campbell Soup Co.*, 650 F. Supp. 1166, 1175 (C.D. Cal. 1986), *aff’d*, 830 F.2d 197 (9th Cir. 1987).

An exception in the TDRA provides that certain uses are not actionable as dilution, including “[a]ny noncommercial use of a mark.” 15 U.S.C. § 1125(c)(3)(C). There is also an exception for certain types of “fair use” of a trademark, although the Act explicitly provides that “parod[ies]” remain subject to suit where they use another’s trademark “as a designation of source for the person’s own goods or services.” *Id.* § 1125(c)(3)(A)(ii).

2. Given VIP’s repeated assertions that its dog toy was a “parody” of Jack Daniel’s label, see, *e.g.*, Pet. App. 47a–48a, 69a; Br. in Opp’n at 1, 3, 4 (No. 20-365), there should have been no question that VIP’s toy was subject to suit for dilution under that provision of the TDRA. See Pet. App. 62(a) (original district court decision holding that the toy remained subject to suit as a parody because it used Jack Dan-

iel’s mark for source designation); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 266 (4th Cir. 2007) (quoting 15 U.S.C. § 1125(c)(3)(A)(ii)) (“Under the statute’s plain language, parodying a famous mark is protected by the fair use defense only if the parody is *not* ‘a designation of source for the person’s own goods or services.’”).

Instead, the Ninth Circuit held in this case that the statutory exception for *noncommercial* use of another’s mark actually authorizes the opposite—*commercial* use of a mark—so long as the use is combined with humor. The Ninth Circuit held that VIP Products was entitled to judgment as a matter of law on Jack Daniel’s dilution by tarnishment claim because, although VIP used Jack Daniel’s trade dress and bottle design to sell its dog toys, it “also used [them] to convey a humorous message.” Pet. App. 33a. The court thus concluded that the exception in the TDRA allowing “noncommercial use” of a mark, *id.* § 1125(c)(3)(C), actually authorizes *commercial* use of another’s mark if a humorous message is also conveyed. Pet. App. 33a–34a.

Nothing in the TDRA supports that rule. As an initial matter, the court of appeals failed to explain how the purported use of humor could somehow transform a commercial transaction into a noncommercial one. Nor could it have. “To be considered ‘commercial,’ an activity must be the type of activity by which a private party engages in trade or commerce.” *Jam v. Int’l Fin. Corp.*, 139 S. Ct. 759, 772 (2019) (cleaned up). And while selling a product for

profit is not necessary for commercial activity, it is certainly sufficient.

In addition, the court’s conclusion that any use of humor renders a product noncommercial under the TDRA would render *every* parody a noncommercial use under the statute, for a parody is by definition a humorous work. *Parody*, Oxford Reference (“[a]n imitation of the style of a particular writer, artist, or genre with deliberate exaggeration *for comic effect*” (emphasis added)), <https://tinyurl.com/2s4jbj2y> (last visited Jan. 14, 2023); *Parody*, Merriam-Webster Dictionary (“a literary or musical work in which the style of an author or work is closely imitated for comic effect or in ridicule”), <https://tinyurl.com/49vs7hex> (last visited Jan. 14, 2023); *Parody*, Dictionary.com (“a humorous or satirical imitation...”), <https://tinyurl.com/2bhn6f4n> (last visited Jan. 14, 2023). As such, parodies could never be subject to suit under the TDRA, and that would render § 1125(c)(3)(A)(ii)—the subsection of the Act that expressly authorizes suits against parodies—entirely superfluous. The Ninth Circuit’s reading of the text thus violates several basic canons of statutory construction, including the rule against interpreting a statute in a way that renders text “inoperative or superfluous, void or insignificant,” *Ysleta Del Sur Pueblo v. Texas*, 142 S. Ct. 1929, 1939 (2022) (internal citations omitted), and the rule that “the specific”—here, the text of § 1125(c)(3)(A)(ii) that explicitly allows suits against parodies—“governs the general,” here, the statutory exception for noncommercial speech. *NLRB v. SW Gen., Inc.*, 580 U.S. 288, 305 (2017) (citation omitted).

At bottom, the Ninth Circuit construed the TDRA's noncommercial use exception to permit the commercial—and diluting—use of another's mark so long as that use also strives to be funny. That ruling has no basis in the text of the statute. The Ninth Circuit's erroneous construction of the TDRA, which allows the tail to wag the dog, should be reversed.

## **II. Trademark Law Provides Critical Protection for Consumers and Companies Alike.**

In addition to misconstruing federal statutory and constitutional law, the rule adopted by the Ninth Circuit, if affirmed, will have serious adverse consequences for both consumers and trademark owners. Congress had good reason to enact laws that protect trademarks and trade dress, and those laws should be enforced as written.

### **A. Trademarks Inform Consumers and Protect Their Health and Safety.**

1. There is no question that the Lanham Act and TDRA serve several important purposes in protecting registered trademarks. To begin, trademarks and trade dresses help consumers make informed choices, allowing purchasers to identify products they like made by manufacturers they know and trust. See *Tam*, 137 S. Ct. at 1751 (“It [a trademark] helps consumers identify goods and services that they wish to purchase, as well as those they want to avoid.”); *Park 'N Fly*, 469 U.S. at 198 (trademarks “protect the ability of consumers to distinguish among competing producers”).

For example, Congress’s statutory protection of trademarks ensures that fans of Campbell’s tomato soup can be confident about what they are getting when they see the famous red and white label bearing the distinctive Campbell’s trademark. See *B & B Hardware*, 575 U.S. at 142 (“The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan’s goods from those of others.”).

2. That protection is particularly important in the context of consumable products like food and beverages, where ingestion of a counterfeit good can have serious health consequences. Consumers—particularly children—may be easily misled by packaging that mimics their favorite snacks. Campbell Soup, for example, has had to send cease-and-desist letters to halt third party sales of Goldfish-shaped marijuana edibles and edibles that otherwise infringed the GOLDFISH® trademarks and trade dress. No one wants to see a child reach for a cracker and end up consuming a controlled substance instead. But products containing marijuana often use the type of silly humor in their marketing that could insulate them from liability under the rule adopted by the court of appeals below. See Br. for Pet’r 36–38. And it would be very dangerous indeed to allow the purveyors of such products to claim an entitlement to heightened protection against Lanham Act claims.

Of course, marijuana edibles are far from the only products that have been designed to capitalize on established trademarks and trade dress. As this case

demonstrates, there is a large market for pet-related infringement, as well.<sup>3</sup> In September 2020, for instance, Campbell Soup sent a cease-and-desist letter to stop a third party from selling a product described on the packaging as “Goldfish” treats “for dogs and cats.” The product, which resembled the Goldfish-shaped snacks made by Pepperidge Farm, infringed the GOLDFISH® word, logo, and configuration marks and misappropriated the company’s trade dress. The look and labeling of the product likely would have confused consumers about whether Pepperidge Farm made the product, and its improper association with and resemblance to Pepperidge Farm’s GOLDFISH® crackers easily could have caused confusion about whether the product was fit for human consumption.

In short, the use of humor does not make an imitation any less misleading—or less dangerous—to the individuals who may consume it. By allowing third parties to copy trademark and trade dress in the name of comedy, the rule adopted by the court below poses a significant threat to consumer safety.

### **B. Trademarks Allow Companies to Protect Their Brands.**

1. In addition to benefiting consumers, the federal protection of trademarks benefits mark owners by

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<sup>3</sup> According to a survey conducted by the American Pet Products Association, seventy percent of American households, or about 90.5 million families, own a pet. See Ins. Info. Inst., Facts + Statistics: Pet Ownership and Insurance, <https://tinyurl.com/438znrud> (last visited Jan. 14, 2023). Sixty-nine million of those households own dogs. *Id.*

“secur[ing] to the owner of the mark the goodwill of his business.” *Park ’N Fly*, 469 U.S. at 198. For this reason, Campbell Soup—like many other companies that use trademarks and trade dresses to market their products—is vigilant about protecting its trademark and trade dress rights from affront. See, e.g., *CSC Brands LP v. Chicken Soup for the Soul Publ’g, LLC*, No. 1:12-cv-06569-JEI-KMW (D.N.J. dismissed per stipulation Jan. 25, 2013) (suit to enjoin proposed launch of line of chicken soup products infringing Campbell Soup’s trademarks and trade dresses); *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208 (2d Cir. 1999) (affirming grant of preliminary injunction to Campbell Soup subsidiary Pepperidge Farm, Inc., and holding that another company’s goldfish-shaped cheddar cheese cracker would dilute the GOLDFISH® configuration mark). In this way, too, trademarks ultimately benefit consumers because they “foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.” *Tam*, 137 S. Ct. at 1752.

As the owner of iconic marks, Campbell Soup has confronted countless trademark issues similar to those in the instant case for many years. See, e.g., *Grey v. Campbell Soup Co.*, 650 F. Supp. 1166 (C.D. Cal. 1986), *aff’d*, 830 F.2d 197 (9th Cir. 1987). In *Grey*, for example, the maker of “DOGIVA” dog biscuits and a “CATIVA” product for cats sued Campbell Soup in federal district court in California seeking declaratory relief. Campbell Soup, which at that time owned the GODIVA® trademark used in marketing chocolates, counterclaimed against plaintiff Grey for trademark infringement and dilution. After

a bench trial, the district court ruled in Campbell Soup's favor. The Ninth Circuit affirmed without opinion.

*Grey* was litigated before the Ninth Circuit adopted the *Rogers* test, and so the district court decided Campbell Soup's infringement claim by applying the Lanham Act's traditional likelihood-of-confusion standard. The fact that plaintiff Grey "decided to use DOGIVA because it was a clever play on GODIVA," *Grey*, 650 F. Supp. at 1175, did not call for a different analysis. If the case were litigated today, however, Grey would undoubtedly argue that DOGIVA was intended to be a humorous commentary on the GODIVA® brand and thus was an expressive work, and Ninth Circuit precedent would wrongly require the district court to impose a heightened burden on Campbell Soup to show that the *Rogers* test was satisfied.

Furthermore, Campbell Soup—like Petitioner—has seen its share of infringing dog toys. Examples include a chew toy designed to look like a bag of KETTLE BRAND® potato chips. The dog toy used the words "Kennel Brand Doggie Chips" and "Spicy Bark." On another occasion, Campbell Soup sent a cease-and-desist letter to those responsible for a dog toy closely resembling a red and white Campbell's soup can but substituting the words "Canine's To-MUTTo soup" for Campbell's tomato soup.

In addition, in July 2020, Campbell Soup halted a third party's sale of T-shirts depicting a red and white Campbell's soup label but adding the words "Bat Soup" and "Now With COVID-19." Such a com-

mercial product should not receive heightened protection from a Lanham Act claim merely because it uses morbid humor. Nor should the commercial sale of the T-shirts have qualified for the noncommercial use exception in the TDRA based on the product's message. The T-shirts, despite their apparent attempt to make light of the ongoing global pandemic, clearly infringed and tarnished the reputation of Campbell Soup's marks.

2. Although the examples of Campbell's iconic trademarks being infringed are legion, it is only one company, and its own experiences are just the tip of the iceberg. Numerous additional reported cases involve humorous commercial products that mimic the trademarks of leading food and beverage brands. See, e.g., *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 736 F.3d 198 (2d Cir. 2013) ("Mister Charbucks" coffee); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769 (8th Cir. 1994) ("Michelob Oily" ad parody); *Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.2d 316 (4th Cir. 1992) ("King of Beaches" T-shirt resembling Budweiser label); *Anheuser-Busch, Inc. v. VIP Prods., LLC*, 666 F. Supp. 2d 974 (E.D. Mo. 2008) ("Buttwiper" dog toy); *Kraft Foods Holdings, Inc. v. Helm*, 205 F. Supp. 2d 942 (N.D. Ill. 2002) ("King VelVeeda" website); *American Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727 (D. Minn. 1998) ("Dairy Queens" movie); *Schieffelin & Co. v. Jack Co. of Boca*, 850 F. Supp. 232 (S.D.N.Y. 1994) ("Dom Popingnon" popcorn).

Ultimately, the decision below threatens all of these mark owners with loss of control over their marks and reputations. And although one might

question how one naughty spaniel could befoul so much legal ground, a decision affirming the Ninth Circuit's erroneous interpretation of the Lanham Act and TDRA will encourage the proliferation of purportedly humorous commercial products that in fact infringe trademarks and deceive consumers to the detriment of everyone involved.

### CONCLUSION

The Ninth Circuit's rule departs from the plain text of the statute and harms both consumers and trademark owners in the process. This Court should reverse the decision below.

Respectfully submitted,

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