

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 THE MOTION PICTURE ASSOCIATION, INC.
AS *AMICUS CURIAE* IN SUPPORT OF NEITHER PARTY**

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INTEREST OF *AMICUS CURIAE*¹

Amicus curiae the Motion Picture Association, Inc. (“MPA”) is a not-for-profit trade association founded in 1922. The MPA serves as the voice and advocate of the film and television industry, advancing the business and art of storytelling, protecting the creative and artistic freedoms of storytellers, and supporting the creative ecosystem that brings entertainment and inspiration to audiences worldwide.

The MPA’s member companies are Paramount Pictures Corp., Sony Pictures Entertainment Inc., Universal City Studios LLC, Walt Disney Studios Motion Pictures, Warner Bros. Entertainment Inc., and Netflix Studios, LLC. These companies and their affiliates produce and distribute the vast majority of filmed entertainment in the United States through the theatrical and home entertainment markets. Indeed, the MPA’s members create thousands of films and television shows that entertain, educate, and inform the public.

As described in more detail herein, the creative works produced and distributed by MPA members often refer to trademarks for a variety of reasons. For example, a work might do so to create a realistic or fanciful setting, to cast the mark in a creative new light,

¹ Pursuant to this Court’s Rule 37.6, counsel for *amicus curiae* certifies that this brief was not authored in whole or in part by counsel for any party and that no person or entity other than *amicus curiae*, its members, or its counsel has made a monetary contribution intended to fund the preparation or submission of this brief.

or to comment on it directly. In its seminal *Rogers v. Grimaldi* decision, the Second Circuit recognized that the First Amendment protects artistic works (such as the film and television shows created by MPA members), and that, because those works are speech in and of themselves, audience members engage with them differently than consumers interact with consumer products. Rather than applying the standard likelihood-of-confusion test for Lanham Act liability, the Second Circuit in *Rogers* applied a more speech-protective test because the claims involved an artistic work. In the thirty-plus years since *Rogers* was decided, it has been broadly adopted by courts across the nation—including every circuit court to consider it—and has generated an established jurisprudence addressing Lanham Act and related claims involving artistic works.

The MPA’s members and other creators of artistic works have come to rely on *Rogers* and its progeny to protect creative freedom and allow them to evaluate potential liability. Films and television shows are often “cleared”—*i.e.*, subjected to legal vetting by the studios producing them and allowed to proceed—in part on the understanding that the *Rogers* test will govern potential trademark claims involving those works. Any decision that unsettles *Rogers* risks chilling speech in film and television content—not only complicating the legal analysis about whether to approve aspects of creative works, but also chilling the creation of such aspects in the first place. Although references to trademarks within these creative works may also be subject to additional meritorious defenses, including that any use was non-trademark use or nominative fair use, *Rogers*

provides important clarity for creators. The MPA therefore has a critical interest in this litigation, which will be the first time this Court reviews a lower court's application of the *Rogers* standard.

At the same time, the MPA's members also own and enforce their rights in some of the most valuable trademarks in the world, both in the marketing and distribution of their films, television shows, books, games, and other artistic works and on consumer products associated with those works. The MPA is uniquely positioned to provide the Court with a well-informed perspective on the balance between protecting free expression and preventing consumer confusion.

This case does not involve an artistic work, but rather a consumer product. The MPA agrees with Petitioner that the *Rogers* test is not the proper mechanism to assess trademark claims in cases involving consumer products. Petitioner goes much too far, however, in asking the Court to reject *Rogers* wholesale—in a case that does not even implicate *Rogers*' rationale and where *Rogers* should not apply. The MPA therefore submits this brief to provide the Court with the perspective of creators that rely on the *Rogers* jurisprudence routinely, and to aid the Court in understanding how the *Rogers* jurisprudence protects creative expression in a way that balances First Amendment principles and the legitimate regulatory aims of the Lanham Act.

INTRODUCTION

Though dismissed by Petitioner, for more than thirty years, the First Amendment principles underlying *Rogers* have allowed creators to depict and reference trademarks to imbue artistic works with a sense of realism while commenting on the world in which we live.

The *Rogers* legal framework provides crucial breathing space for creators. The core principle underpinning the Lanham Act is preventing consumer confusion regarding the origin and source of goods and services. *Rogers* recognized that the First Amendment protects artistic works and that consumers do not engage with artistic works the same way they engage with consumer products. It therefore developed a test to evaluate Lanham Act claims regarding artistic works that ensures that liability attaches only when a mark is plainly unrelated to the underlying creative work or when its inclusion is explicitly misleading as to the source or content of that work. This test for liability—which has been adopted by every circuit court to consider it—effectively balances the Lanham Act’s legitimate goals and the constitutional interest in free expression.

Rogers establishes an important First Amendment defense protecting film and television creators’ creative decisions. It is as well-settled and entrenched as any line of jurisprudence. The MPA’s members rely on it every day. For artists, overruling *Rogers* would upend decades of law. For Jack Daniel’s, which produces liquor rather than art, the *Rogers* test may appear expendable. The Court should confirm that *Rogers* applies to claims

involving artistic works and reject Petitioner’s blatant attempt to enable trademark owners to censor creative expression. While other defenses may also apply, the *Rogers* jurisprudence is applied with clarity and uniformity across jurisdictions, making it a critical tool for creators to make up-front decisions about their content.

Rogers has yielded a well-established jurisprudence that helps enable a well-functioning trademark and creative ecosystem. Legislating against this backdrop, the House Judiciary Committee report accompanying the Trademark Modernization Act of 2020 stated that “adoption by a court of a test that departs from *Rogers* ... would be contrary to the Congressional understanding of how the Lanham Act should properly operate.”

At the same time, *Rogers* functions well as a test precisely because it is confined to artistic works, not to any consumer product that could arguably be said to incorporate some expressive element. Petitioner argues that because *Rogers* was misapplied to protect Respondent’s product, *Rogers* is wrong. But *Rogers* simply does not cover this dog toy. The MPA therefore urges this Court both to affirm the validity of *Rogers* in appropriate cases and to clarify that *Rogers* does not apply when the item accused of infringement is a consumer product rather than an artistic work. This is not to suggest that all references to others’ trademarks on consumer products are necessarily infringing; all it means is that the traditional likelihood-of-confusion analysis applies, which courts have demonstrated time

and again they can easily apply to consumer products alleged to be parodies in a way that avoids First Amendment concerns.

ARGUMENT

The Court should preserve the *Rogers* test as applied to artistic works like movies and television shows. But it should ensure that *Rogers* is not used to assess alleged trademark infringement involving consumer products, such as the dog toy in this case.

I. As Applied to Artistic Works, the *Rogers* Test Is Correct.

Rogers and its progeny are well-founded and doctrinally sound. The Court should confirm that, for artistic works such as the film at issue in *Rogers*, the *Rogers* test appropriately balances consumer protection with free speech.

A. The *Rogers* Legal Standard Balances the First Amendment Right of Free Expression with Legitimate Lanham Act Interests.

Sections 32 and 43 of the Lanham Act make it illegal to use a trademark in a manner that “is likely to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. §§ 1114(1), 1125(a)(1)(A). The Lanham Act is specifically concerned with the use of trademarks to sell goods and services: for infringement claims involving registered marks, the trademark must be used “in connection with the sale, offering for sale, distribution, or advertising of

any goods or services,” 15 U.S.C. § 1114(1), and for those involving unregistered marks, the trademark must be used “in connection with any goods or services,” 15 U.S.C. § 1125(a)(1). The touchstone of infringement is consumer confusion. *See U.S. Pat. & Trademark Off. v. Booking.com B.V.*, 140 S. Ct. 2298, 2307 (2020) (use of a trademark is infringing only if it is “likely to confuse consumers”).

The Lanham Act does not define what it means for use of a mark to be “likely to cause confusion.” Courts therefore frequently engage in a multi-factor balancing analysis using factors that vary only slightly among the circuits. For example, courts in the Second Circuit balance the so-called “*Polaroid* factors,” which include “the strength of [the prior owner’s] mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant’s good faith in adopting its own mark, the quality of defendant’s product, and the sophistication of the buyers.” *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961). Other circuits have adopted similar tests. *See 4 McCarthy on Trademarks and Unfair Competition* §§ 24:30–24:43, Westlaw (5th ed. database updated Dec. 2022) (collecting cases).

This balancing analysis is highly fact-intensive and typically not amenable to resolution prior to trial. *See, e.g., JL Beverage Co., LLC v. Jim Beam Brands Co.*, 828 F.3d 1098, 1105 (9th Cir. 2016) (“Because the determination is based on a non-exhaustive, multi-factor, fact-intensive inquiry, we have cautioned against

granting summary judgment in these cases.”).

Where another’s trademark is used as a mark to designate the source or origin of goods or services, the Lanham Act does not implicate First Amendment concerns. There is no First Amendment interest, for example, in creating knock-off watches. But First Amendment interests arise when a creative work references the mark as a storytelling device in a movie, television show, or other artistic expression, rather than as a designation of source or origin.

In *Rogers*, the Second Circuit adopted a legal standard that balances the public interest in consumer protection with the First Amendment interests of both creators of artistic works and their audiences. *Rogers* involved a Lanham Act claim (among others) brought by Ginger Rogers based on the film “Ginger and Fred,” about two fictional Italian cabaret performers who became known as “Ginger and Fred” due to their performances imitating Rogers and Fred Astaire. *Rogers v. Grimaldi*, 875 F.2d 994, 996–97 (2d Cir. 1989). Rogers claimed that the film violated the Lanham Act “by creating the false impression that the film was about her or that she sponsored, endorsed, or was otherwise involved in the film.” *Id.* at 997.

The Second Circuit recognized that “[m]ovies, plays, books, and songs are all indisputably works of artistic expression and deserve protection” under the First Amendment. *Id.* Simultaneously, however, such works “are also sold in the commercial marketplace like other more utilitarian products, making the danger of

consumer deception a legitimate concern that warrants some government regulation.” *Id.*

The court identified two reasons why the traditional likelihood-of-confusion analysis should not apply to an allegedly confusing title. First, preventing creators from using their preferred titles chills *artistic* expression: “[t]itles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion”—indeed, “[t]he artistic and commercial elements of titles are inextricably intertwined.” *Id.* at 998. Second, audience members do not engage with the titles of artistic works in the same way consumers engage with the branding of consumer products: “[t]hough consumers frequently look to the title of a work to determine what it is about, they do not regard titles of artistic works in the same way as the names of ordinary commercial products.” *Id.* at 1000.

Ultimately, “[b]ecause overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values,” the Second Circuit “construe[d] the act narrowly to avoid such a conflict.” *Id.* at 998. Specifically, *Rogers* recognized that the risk of misunderstanding is outweighed by the interests in artistic expression. *Id.* at 1001.

As such, the Second Circuit adopted a two-part test now universally known as the “*Rogers* test.” The court held that the Lanham Act “should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* at 999. That condition

will be satisfied in two cases: (1) where “the title has no artistic relevance to the underlying work whatsoever” or (2) “if [the title] has some artistic relevance, [where] the title explicitly misleads as to the source or the content of the work.” *Id.*

Under this test, “Ginger and Fred” did not violate the Lanham Act. The court explained that the film’s title had artistic significance: “The central characters in the film are nicknamed ‘Ginger’ and ‘Fred,’ and these names are not arbitrarily chosen just to exploit the publicity value of their real[-]life counterparts but instead have genuine relevance to the film’s story.” *Id.* at 1001. And the title was not explicitly misleading: it “contains no explicit indication that Rogers endorsed the film or had a role in producing it.” *Id.*

Since *Rogers* was decided, every circuit to consider the issue has embraced it. *See, e.g., Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 328–29 (4th Cir. 2015); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65 (5th Cir. 2000); *Parks v. LaFace Records*, 329 F.3d 437, 450–52 (6th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901–02 (9th Cir. 2002); *MGFB Props., Inc. v. Viacom Inc.*, 54 F.4th 670, 679–80 (11th Cir. 2022). Courts have also appropriately applied *Rogers* to claims involving marks in the bodies of artistic works and not just the titles of those works. *See, e.g., E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (“Although this test traditionally applies to uses of a trademark in the title of an artistic work, there is no principled reason why it ought not also apply to the use of a trademark in the

body of the work.”); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989) (“[T]he *Rogers* balancing approach is generally applicable to Lanham Act claims against works of artistic expression.”); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1277–78 (11th Cir. 2012) (collecting cases).

B. As Applied to Artistic Works, the *Rogers* Balancing Test Provides Crucial Breathing Space for Artistic Expression.

Petitioner asks this Court to jettison the *Rogers* test, claiming that it conflicts with the Lanham Act’s text. Petitioner is wrong. *Rogers* reflects proper judicial interpretation of the Lanham Act, just as courts have fleshed out what constitutes a likelihood of confusion in contexts involving consumer products. Moreover, it is grounded in well-settled principles of statutory interpretation and constitutional avoidance.

Petitioner claims that the Lanham Act does not explicitly recite the *Rogers* test. True enough, but neither does the Lanham Act explicitly recite any multifactor likelihood-of-confusion test. Judges must interpret the Lanham Act’s text to decide what factors are salient to liability, as well as how the Act operates within the framework of the Constitution, and that is exactly what the *Rogers* jurisprudence does.

Contrary to Petitioner’s suggestion, there is nothing atextual or inconsistent about applying a different test for artistic works than for consumer products. Artistic works differ from consumer products in purpose, form,

and function, so it is common sense—as the *Rogers* court held—that actionable confusion would also arise in different circumstances. In particular, *Rogers* recognized that when a mark is referenced in connection with an artistic work, one interacts with it not as a consumer but as an audience member—and the audience understands that such reference to the mark does not signify the source, sponsorship, or affiliation of that work, but rather is part of the creator’s artistic vision.

Moreover, principles of constitutional avoidance dictate adopting the *Rogers* rule. Petitioner claims that “no serious constitutional question exists.” Pet. Br. 28. This remarkable claim—which no court has ever endorsed—is clearly wrong.

It is easy to see why applying each circuit’s traditional likelihood-of-confusion test to artistic works raises significant First Amendment concerns—and why a more rigorous test for trademark infringement is necessary to protect artistic expression. Motion pictures and television programs frequently reference products and trademarks to tell a story, make a particular point, or convey a sense of reality. See Jacques Aumont et al., *Aesthetics of Film* 121 (trans. Univ. of Texas Press 1992) (“It has often been observed that what distinguishes the cinema from other modes of representation is the impression of reality that arises from viewing films.”). Whether the work is factual, partly fictional, or entirely fictional, the ability to weave trademarks into the narrative lends an aura of verisimilitude that is critical to effective storytelling. What is more, real brands and trademarks have cultural

meaning behind them. Their inclusion allows for the story to be shown instead of told.

For example, to portray a car with any measure of reality, it must be recognizable as, for example, a Ferrari, Porsche, Ford, or Volkswagen. A top-of-the-line Ferrari in a heist film sets one tone. A beat-up Volkswagen camper in a homecoming story sets quite another. Such creative choices bring the writer's and director's vision to life. Storytellers need to be able to make artistic decisions involving trademarks to depict the world in which we live.

References to trademarks and brands permeate every aspect of filmmaking because films and television shows look to tell stories that connect with and are understood by real audiences. Brands are used as shorthand to help the audience understand who a character is and what a scene is about. Creators must be able to have their characters drink Coca-Cola, eat Pringles, use iPhones and MacBooks, and carry Gucci handbags—without fearing repercussions or needing to fictionalize these items in ways that an audience would readily recognize is not reflective of the real world. Moreover, in the MPA's experience, brand owners are particularly likely to try to suppress references to their marks in works dealing with socially critical but often emotionally charged topics such as alcohol abuse, crime, violence, or drug addiction. If brand owners could censor depiction of their goods in any artistic work dealing with difficult and unpleasant subjects, there would be no such works set in anything resembling the real world.

Creators have integrated brands into their works to memorable effect—at times demonstrating that the same ubiquitous brand signals the same thing to the audience despite appearing in dramatically different circumstances. For example, the universality of the simple pleasure of McDonald’s has been used in movies such as *Pulp Fiction*, when two hitmen casually banter about a McDonald’s Quarter-Pounder with Cheese being called a “Royale with Cheese” in France prior to a menacing killing sequence; *The Fifth Element*, where, even in a future universe, people continue to go to a McDonald’s drive-thru in their flying cars; *The Girl with the Dragon Tattoo*, where titular protagonist Lisbeth Salander eats a McDonald’s Happy Meal, creating a striking contrast between her tough-as-nails persona and a moment of childlike vulnerability; and the popular Adult Swim cartoon show *Rick and Morty*, where an episode includes a quest to obtain the long-discontinued McDonald’s 1998 “Szechuan Sauce” product, the launch of which is described with theatrical seriousness as “[t]he day it all began—and ended.”

Other examples abound. Having a Rolex signals to the audience that a character is wealthy and successful. Thus, in *Glengarry Glen Ross*, Alec Baldwin’s character touts that his Rolex costs more than a car. The hit television series *Stranger Things* relies on brands that were ubiquitous in the 1980s to evoke a sense of nostalgia, most notably Eggo frozen waffles. And in the motion picture *Flight*, Denzel Washington’s character is a commercial airline pilot whose alcohol abuse involves consuming Absolut vodka, Budweiser beer, and Jim Beam bourbon whiskey—all of whose trademarks were

depicted on screen, without permission of the trademark owners, to demonstrate the severity and extent of the character's addiction. These are just a few of the many creative ways in which trademarks may be referenced in film and television.

Indeed, the reference to trademarks in creative works is a longstanding practice that is not limited to visual art. Other artistic forms are rife with depictions of trademarks for artistic purposes. For example, in *Mattel, Inc. v. MCA Records, Inc.*, the Ninth Circuit cited Janis Joplin's song lyrics "Oh Lord, won't you buy me a Mercedes-Benz" as an obviously permissible use of a trademark. *See* 296 F.3d at 902.²

Rogers safeguards these First Amendment interests by providing crucial protection to artists that the conventional likelihood-of-confusion test fails to provide. *First*, the *Rogers* line of cases recognizes that artists would be hamstrung if they were unable to reference or depict real marks to tell their stories. For example, the song "Barbie Girl" allows the musical artist to comment on "Barbie and the values [the artist] claims she represents." *Id.* So too does the portrayal in a photography series of Barbie "in danger of being attacked by vintage household appliances," including a malt machine, fondue pot, and oven. *Mattel, Inc. v.*

² For the very reason that specific car brands mean different things to consumers, Janis Joplin's request for the Lord to buy her a Mercedes-Benz carries a different meaning from Don McLean's refrain that he drove his Chevy to the levy in "American Pie."

Walking Mountain Prods., 353 F.3d 792, 796, 807 (9th Cir. 2003).

But creators reference marks in myriad other ways, as well. A character’s directive to be careful with his “Lewis Vuitton” bag can portray him as simultaneously “snobbish” and poorly informed, in a way that the audience can grasp instantly. *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172, 178 (S.D.N.Y. 2012). The portrayal of *Hollywood Weekly Magazine* in a documentary about the “Tiger King” documented in various *Hollywood Weekly* stories helps highlight the real-world stakes of the subject matter being covered. See *Jackson v. Netflix, Inc.*, 506 F. Supp. 3d 1007, 1016 (C.D. Cal. 2020). And the recreation of a cartoon-style business calling to mind a recognizable establishment in a particular Los Angeles neighborhood contributes to a video game’s goal of evoking the particular “look and feel” of that neighborhood. *E.S.S. Ent. 2000*, 547 F.3d at 1100.

Rogers recognizes that all of these are artistic choices that creators should be free to make so long as they are artistically relevant and not explicitly misleading. Ultimately, “[n]o author should be forced into creating mythological worlds or characters wholly divorced from reality.” *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 460 (Cal. 1979) (en banc) (Bird, C.J., concurring).

Petitioner does not seem to dispute that creators have a legitimate artistic reason to incorporate trademarks into their works. Instead, Petitioner relies

on authority holding that “deceptive” or “misleading” speech is unprotected. Pet. Br. 29–30. But the *Rogers* test does not protect explicitly misleading uses of a trademark. Rather, it protects only artistically significant references to a mark that are *not* explicitly misleading. It is obvious that the slim possibility of a likelihood of confusion does not override the creators’ First Amendment interests. “Ginger and Fred” did not cease to be protected artistic speech merely because someone might have glanced at a poster and thought it was affiliated with Ginger Rogers. Indeed, on petitioner’s theory, even *core political* speech would be unprotected if a consumer might find it confusing. “Hillary: The Movie”—the movie held to be constitutionally protected speech in *Citizens United v. FEC*, 558 U.S. 310 (2010)—could be banned because a viewer might incorrectly think that Hillary Clinton made or endorsed it. That cannot be.

Nor is it the case, as Petitioner suggests, that accounting for the First Amendment interest in referencing or depicting trademarks to tell stories about the world somehow impairs a countervailing speech interest of the trademark owner. *Cf.* Pet. Br. 34–35. A trademark owner’s First Amendment rights are not threatened because *someone else* is speaking. *Rogers* accounts for the Lanham Act’s goal in preventing consumer confusion but prevents trademark owners from inappropriately weaponizing the Lanham Act into a tool to chill speech in artistic works. Petitioner’s extreme position would embolden trademark holders to attempt to suppress Coca-Cola from Robert Rauschenberg’s *Coca-Cola Plan*, Kool-Aid from Tom

Wolfe's *The Electric Kool-Aid Acid Test*, and FedEx from *Cast Away*'s depiction of a FedEx plane crashing onto a deserted island.

Second, and relatedly, *Rogers* protects against the chilling of speech by ensuring that liability for artistic expression does not turn on the uncertainties inherent in a multifactor balancing test. This Court has cautioned that “balancing tests[] can yield unpredictable and at times arbitrary results.” *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 136 (2014). Although the traditional multifactor test may appropriately capture the nuances inherent where a plaintiff’s trademark is used on a defendant’s consumer product, it only opens the door to unpredictable and inconsistent results in the context of artistic works. Faced with the risk that other meritorious defenses may take years to resolve and the prospect of having their creative decisions turn on jury verdicts years down the road, content creators may instead cede authority to trademark owners and censor references to trademarks in their creative works. See Robert G. Bone, *Taking the Confusion Out of “Likelihood of Confusion”: Toward a More Sensible Approach to Trademark Infringement*, 106 Nw. U. L. Rev. 1307, 1336–37 (2012) (“The open-ended nature of the [likelihood-of-confusion] test creates legal uncertainty and generates high litigation costs, which invite frivolous and weak assertions of trademark rights and chill socially valuable uses.”); see also *id.* at 1376–77 & n.338 (arguing that the “best way to handle the chilling-effect problem is to carve out categorical liability exemptions for the most seriously affected uses,” as the *Rogers* test does for expressive works).

The resulting chilling effect on artistic works would be to the great detriment of creative freedom and the public.

Tellingly, Petitioner's brief does not address this chilling effect at all. Petitioner merely says that if the use of a mark is confusing, it is unprotected. Pet. Br. 29–30. But even if that were true, Petitioner overlooks that the very existence of the multifactor likelihood-of-confusion test deters speech that is *not* confusing. In interpreting the Lanham Act and applying the First Amendment, the Court must leave breathing space for artistic works, even if some incidental confusion might occasionally result.

Third, Rogers further protects First Amendment interests by not just rejecting application of an uncertain balancing test but also articulating a clear rule for liability when constitutional values are at issue. That clarity prevents every infringement lawsuit involving protected works from devolving into a drawn-out war of attrition. Unlike the conventional likelihood-of-confusion test, the *Rogers* test is more amenable to application on a motion to dismiss. *See, e.g., Warner Bros.*, 868 F. Supp. 2d at 183–84 (dismissing complaint based on alleged use of Louis Vuitton marks in film); *Stewart Surfboards, Inc. v. Disney Book Grp., LLC*, No. 10-cv-2982, 2011 WL 12877019, at *7 (C.D. Cal. May 11, 2011) (granting motion to dismiss claim based on depiction of branded surfboard on children's book cover). Such rapid resolution of meritless Lanham Act claims is necessary because creators can feel pressure to capitulate to unsubstantiated trademark claims in cease-

and-desist letters in lieu of enduring protracted litigation. *See, e.g.*, *Bone, supra*, at 1336 & n.172; *see also Wash. Post Co. v. Keogh*, 365 F.2d 965, 968 (D.C. Cir. 1966) (recognizing that “[i]n the First Amendment area, summary procedures are ... essential” because speakers “tend to become self-censors” when subjected to “the harassment of lawsuits”). Thus, in applying trademark law, courts should focus not only on whether a court or a jury will ultimately get the question of infringement “right,” but should also consider the substantial risk of chilling effects caused by a lengthy and expensive litigation process.

In the MPA’s experience, amassing the evidence required to defend against a trademark infringement claim—even where there is no evidence of actual consumer confusion in the marketplace—is invariably burdensome. It often entails expert survey research and extensive document discovery into intent and profits, among other things. Even objectively meritorious defenses can take years to resolve. Instead, *Rogers* ensures that the prospect of burdensome litigation does not chill artistic expression.

At the same time, *Rogers* recognizes that in limited cases, artistic works may still use marks in ways that run afoul of the Lanham Act. For example, courts have allowed claims to proceed against the creation of digital replicas of the plaintiff’s trademarked handbags, to be sold as non-fungible tokens;³ the gratuitous use of Rosa

³ *Hermès Int’l v. Rothschild*, No. 22-cv-384, --- F. Supp. 3d ----, 2022 WL 1564597, at *6 (S.D.N.Y. May 18, 2022).

Parks’s name in a song title that “is not about Rosa Parks at all and was never intended to be about Rosa Parks, and which does not refer to Rosa Parks or to the qualities for which she is known”;⁴ and the decision to title a movie about pre-historic humans “Age of Hobbits” when the characters were never once referred to as hobbits within the film and when the film was to be released days before a movie in the *Lord of the Rings* franchise.⁵ As these decisions demonstrate, the *Rogers* test carves out “breathing space” for “First Amendment freedoms,” *NAACP v. Button*, 371 U.S. 415, 433 (1963), while still accommodating the Lanham Act’s goal of preventing harm to consumers in the marketplace.

C. As Applied to Artistic Works, the *Rogers* Test Is Settled Law and Has Engendered Significant Reliance Interests.

The *Rogers* jurisprudence has become integral to the trademark landscape. Courts routinely apply it; Congress has endorsed it; and creators of all types rely on it.

In the thirty-four years since *Rogers* was decided, courts have routinely applied its logic to reject attempts to stifle a wide array of artistic works. Applying *Rogers*, courts have rejected Lanham Act challenges to

⁴ *Parks*, 329 F.3d at 455, 458.

⁵ *Warner Bros. Ent. v. Global Asylum, Inc.*, No. 12-cv-9547, 2013 WL 12114836, at *10–11 (C.D. Cal. Jan. 29, 2013), *aff’d*, 544 F. App’x 683 (9th Cir. 2013).

photographs displaying Barbie in peril from household appliances;⁶ a comedy movie depicting a character’s “snobbish” attachment to his “Lewis Vuitton” bag;⁷ a fanciful horror film set in California’s Winchester Mystery House;⁸ a video game depicting irreverently renamed businesses evoking a Los Angeles neighborhood;⁹ depictions of *Hollywood Weekly Magazine* and certain articles in a documentary;¹⁰ a television show titled “Empire” to evoke its Empire State setting and its “music and entertainment conglomerate” subject matter;¹¹ and paintings of football scenes using the trademarked red and white uniforms of the University of Alabama,¹² among many others. As discussed above, *Rogers* is an important and longstanding defense for creators, and any decision overruling *Rogers* would risk significant uncertainty.

Congress, too, has legislated against the backdrop of *Rogers* and its progeny for decades. For example, the Trademark Modernization Act of 2020 made it easier to obtain an injunction in trademark cases. *See* Pub. L. No. 116-260, § 226, 134 Stat. 1182, 2200, 2208. Without

⁶ *See Walking Mountain Prods.*, 353 F.3d 792.

⁷ *See Warner Bros.*, 868 F. Supp. 2d 172.

⁸ *See Winchester Mystery House, LLC v. Global Asylum, Inc.*, 148 Cal. Rptr. 3d 412 (Cal. Ct. App. 2012).

⁹ *E.S.S. Ent. 2000*, 547 F.3d 1095.

¹⁰ *See Jackson*, 506 F. Supp. 3d 1007.

¹¹ *See Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192 (9th Cir. 2017).

¹² *See Univ. of Ala. Bd. of Trs.*, 683 F.3d 1266.

Rogers' safeguards, this would raise the specter of films, television shows, books, and songs being enjoined due to trademark claims. The committee report accordingly recognized that the drafters "expect[] that courts will continue to apply the *Rogers* standard to cabin the reach of the Lanham Act in cases involving expressive works" and that "adoption by a court of a test that departs from *Rogers* ... would be contrary to the Congressional understanding of how the Lanham Act should properly operate." H.R. Rep. No. 116-645, at 20 (2020). Indeed, Congress's repeated amendment of the Lanham Act through the Trademark Modernization Act and other legislation has consistently made no changes that would call the well-settled body of case law applying *Rogers* into question. This is "convincing support for the conclusion that Congress accepted and ratified" the Court of Appeals consensus applying *Rogers* to artistic works—as counsel for Jack Daniel's recognized in another recent brief to this Court. *Tex. Dep't of Hous. & Cmty. Affairs v. Inclusive Cmty. Project, Inc.*, 576 U.S. 519, 536–37 (2015); Br. for Resp't at 30, *Gonzalez v. Google LLC*, No. 21-1333 (U.S. Jan. 12, 2023).

Rogers provides an important framework upon which creators have relied for decades. The Court should leave *Rogers* intact for artistic works.

II. *Rogers* Applies to Artistic Works, Not to Consumer Products.

Rogers was correctly decided, but it does not apply here. In *Rogers*, the plaintiff sought to suppress an artistic work. In this case, by contrast, Petitioner is not

trying to suppress an artistic work but rather to stop the sale of a garden-variety consumer product: a dog toy. The traditional likelihood-of-confusion analysis should thus apply, as Petitioner argues. Pet. Br. 38–39.

It is difficult to understand then why Petitioner would seek to unsettle the law so dramatically here. This case can be more easily and narrowly resolved simply by holding that the Ninth Circuit erred in applying *Rogers* to a consumer product.

A. Consistent with Its Purposes, the *Rogers* Test Is Properly Limited to Artistic Works.

The core principle underpinning *Rogers* is that quintessentially artistic works, including movies and television programs, are protected by the First Amendment. *See Schad v. Borough of Mt. Ephraim*, 452 U.S. 61, 65 (1981) (“Entertainment, as well as political and ideological speech, is protected; motion pictures, programs broadcast by radio and television, and live entertainment, such as musical and dramatic works fall within the First Amendment guarantee.”); *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952) (“[M]otion pictures are a significant medium for the communication of ideas.”). *Rogers*’ modification of the multi-factor likelihood-of-confusion balancing test is designed to protect those First Amendment interests.

Rogers is not limited to movies and television; it also applies to other artistic works such as books, music, and video games. *See, e.g., Brown v. Ent. Merchants Ass’n*, 564 U.S. 786, 790 (2011) (“Like the protected books,

plays, and movies that preceded them, video games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player’s interaction with the virtual world). That suffices to confer First Amendment protection.”).

But *Rogers* does not apply to consumer products, including dog toys. The Court should hold that consumer products are subject to the traditional likelihood-of-confusion analysis. This principle should apply regardless of whether, as here, the creator of the product asserts that its use of a trademark carries an “expressive message.”

In those rare cases in which a product straddles the line between a consumer product and an artistic work, MPA concurs with the brief of the International Trademark Association in support of Petitioner’s petition for writ of certiorari, which proposes that *Rogers* should not apply to any product that would retain its “primary functionality even if all expression has been stripped from [it].” *Amicus Curiae* Br. of the International Trademark Ass’n in Supp. of Pet. for Cert. at 15. But because this case is nowhere near the line, the Court need not articulate the precise legal standard applicable to that type of case.

Expanding the *Rogers* test to Respondent’s dog toys would be misguided for several reasons. *First*, an overbroad *Rogers* test would encourage the maker of every product accused of infringement to claim an

expressive element that warrants special protection. In every case, courts would have to scrutinize whether the claim of an expressive message is bona fide, or invented in an attempt to excuse trademark infringement—resulting in courts needing to individually assess whether obvious consumer products such as dog toys, sneakers,¹³ and beer¹⁴ (and more) are subject to protection under *Rogers*.

Second, expanding *Rogers* to consumer products would conflict with one of *Rogers*' core justifications: its recognition that an audience member engages with a film and its title as a viewer rather than as a consumer. *Rogers*, 875 F.2d at 1000. "Since consumers expect an ordinary product to be what the name says it is, we apply the Lanham Act with some rigor to prohibit names that misdescribe such goods." *Id.* "But most consumers are well aware that they cannot judge a book solely by its title any more than by its cover." *Id.* Or, put another way, audiences are aware a film called "Ginger and Fred" might be *about* people named "Ginger and Fred," not *by* people named "Ginger and Fred." But that reasoning does not apply to consumer products, where the branding identifies the product's source. A consumer who sees laundry detergent, diapers, or (here)

¹³ See *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, No. 22-cv-2156, --- F. Supp. 3d ---, 2022 WL 1446681, at *6 (E.D.N.Y. Apr. 29, 2022) (rejecting heightened First Amendment protection for alleged parody of Vans shoes because they "do not meet the requirements for a successful parody"), *appeal docketed*, No. 22-1006 (2d Cir. May 3, 2022).

¹⁴ See Complaint, *Sony Pictures Television Inc. v. Knee Deep Brewing Co.*, No. 18-cv-3221 (C.D. Cal. Apr. 17, 2018), ECF No. 1.

dog toys imitating Jack Daniel's distinctive marks might assume they are affiliated with Jack Daniel's. That assumption can and should be gauged by the traditional likelihood-of-confusion test taking into consideration how consumers encounter the mark in context. Compare, e.g., *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260–63 (4th Cir. 2007) (affirming grant of summary judgment to maker of “Chewy Vuitton” handbag dog toy upon likelihood-of-confusion analysis), with *Anheuser-Busch, Inc. v. VIP Prods., LLC*, 666 F. Supp. 2d 974, 985 (E.D. Mo. 2008) (granting preliminary injunction based on parody “Budweiser” dog toy where there was credible evidence of consumer confusion and Anheuser-Busch also sold Budweiser-themed dog accessories).

Third, applying *Rogers* to such uses improperly turns the test on its head. *Rogers* presupposes an “underlying work” that is distinct from the reference to the mark. 875 F.2d at 999. It then directs that courts consider whether such reference to the mark “has no artistic relevance to the underlying work whatsoever,” because (in the case of titles) “[a] misleading title with no artistic relevance cannot be sufficiently justified by a free expression interest.” *Id.* This analysis reflects the public's stronger interest in regulating confusing uses of trademarks that are not incorporated into or referencing a broader artistic work. But where there is no underlying work to be had, the inquiry collapses. Here, for example, *Rogers* would require a court to ask whether the use of the Jack Daniel's mark has “artistic relevance” to the Bad Spaniels toy. This inquiry makes no sense. This dog toy is not an artistic work, so it is

impossible for the Jack Daniel's mark to have "artistic relevance" to the dog toy.

Apparently recognizing this problem, the decisions below modified the *Rogers* test. Rather than considering whether the mark was artistically relevant to an underlying artistic work, the district court held and the Ninth Circuit affirmed that the use of a modified Jack Daniel's mark *transformed* the dog toy into art, thus requiring application of the *Rogers* test. Pet. App. 14a–15a. This faulty reasoning would allow *Rogers* to be used in *any* case where a would-be-infringer declares that reference to or depiction of a mark or a modified form of the mark has transformed a consumer product into artwork because of some alleged expressive element. The Court should reject this effort to subvert the traditional likelihood-of-confusion test.

B. The Court Should Reject Respondent's Contention that *Rogers* Applies Because Its Use of Jack Daniel's Marks Is "Expressive."

Respondent claims that the *Rogers* test should apply because its use of Jack Daniel's mark is "expressive." The Court should reject that contention. Respondent lacks any First Amendment interest in creating the consumer product at issue, regardless of whether its dog toy is purportedly "expressing" something.

First Amendment protection turns on the *type* of work at stake, not whether, in some abstract sense, a particular product might be said to "send a message." This Court has typically afforded First Amendment

coverage to “recognized and protected mediums of expression” by “identifying a given medium of expression as protected and then applying coverage to all works within that medium, whether representational or not.” Brian Soucek, *The Constitutional Irrelevance of Art*, 99 N.C. L. Rev. 685, 733 (2021) (footnote omitted). As such, *all* books and paintings are protected, without regard to whether, in any particular case, the book or painting expresses a particular idea. *Hurley v. Irish-Am. Gay, Lesbian & Bisexual Grp. of Bos.*, 515 U.S. 557, 569 (1995) (holding that “a narrow, succinctly articulable message is not a condition of constitutional protection” and that the “painting of Jackson Pollock, music of Arnold Schönberg, or Jabberwocky verse of Lewis Carroll” are “unquestionably shielded”). Likewise, in *Brown*, the Court held that “video games,” *as a whole*, “qualify for First Amendment protection,” rather than considering whether particular messages within video games qualify for such protection. 564 U.S. at 790; *accord Joseph Burstyn*, 343 U.S. at 500–01 (same, for movies).

Conversely, consumer products that retain their primary functionality even when all expression is stripped from them are not categorically protected in the same way. This principle is in line with this Court’s recognition, going back decades, that even if the use of a trademark has an expressive component in part, *use of a trademark to designate the origin of goods or services* also has a plainly commercial component. In *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*, the Court held that where the creators of the “Gay Olympic Games” “sought to exploit the

‘commercial magnetism’” of “Olympic,” “[t]he mere fact that [they claimed] an expressive, as opposed to a purely commercial, purpose does not give [them] a First Amendment right to ‘appropriat[e] to [themselves] the harvest of those who have sown.’” 483 U.S. 522, 539–41 (1987). By contrast, depictions of or references to marks in artistic works do not seek “to exploit the ‘commercial magnetism’” of the preexisting marks. *Id.* at 539.

C. The Likelihood-of-Confusion Test Leaves Room for Genuine Parody Products.

The MPA recognizes that there should be space for businesses to market *genuine* parody products—those mocking a product rather than imitating it. But even if such products provide genuine social commentary, such protection does not require applying *Rogers*. The traditional likelihood-of-confusion test and other trademark defenses, such as non-trademark use or nominative fair use, are well equipped to address alleged confusion involving two consumer products.

Lower court decisions applying the likelihood-of-confusion factors account for whether a product is a parody. For example, courts have routinely rejected trademark claims involving parodies in consumer products (including with respect to humorous dog toys), without stretching the *Rogers* analysis outside its purview. *See, e.g., Haute Diggity Dog*, 507 F.3d at 260–63; *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 674 F. App’x 16, 17–18 (2d Cir. 2016) (affirming grant of summary judgment to manufacturer of humorous tote

bags parodying luxury handbag brand, upon applying likelihood-of-confusion factors); *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1484–88 (10th Cir. 1987) (affirming bench trial verdict of non-infringement based on humorous pig-themed “Lardashe” jeans parodying “Jordache,” upon considering likelihood-of-confusion factors); *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 414–21 (S.D.N.Y. 2002) (declining to apply the *Rogers* analysis to a humorous “Tommy Holedigger” perfume for dogs, but nonetheless granting the manufacturer summary judgment).

In so doing, these decisions have recognized that the likelihood-of-confusion factors are well suited to assess whether a parody consumer product is likely to generate confusion with another product on the market, and that certain factors may affect the analysis differently. This means, for example, that the strength of the plaintiff’s mark no longer tilts in its favor—where a mark is particularly recognizable, that is part of what allows for a successful parody product. *See, e.g., Tommy Hilfiger Licensing*, 221 F. Supp. 2d at 416 (“[I]t is precisely because of the mark’s fame and popularity that confusion is avoided, and it is this lack of confusion that a parodist depends upon to achieve the parody.”). At the same time, the defendant’s use on its own product must borrow “enough of the original design to bring it to mind as a target,” meaning both that some similarity between the marks is necessary and does not inherently favor the plaintiff. *Haute Diggity Dog*, 507 F.3d at 262. And the intent factor will generally favor the defendant, as “[a]n intent to parody is not an intent to confuse the public.” *Id.* at 263 (quoting *Jordache Enters.*, 828 F.2d at 1486).

Courts are thus very capable of assessing whether uses of trademarks on consumer products are in service of parodic expression—and then, accounting for such parodic use, assessing whether the traditional likelihood-of-confusion test prohibits the use. Thus, despite Respondent’s claim, the *Rogers* test is not the only mechanism by which consumer products with an arguably expressive element can be protected.

* * *

The MPA therefore urges that the Court affirm the *Rogers* framework. In so doing, it should limit that framework to the contexts for which *Rogers* was designed and for which it makes most sense: use of marks relating to quintessentially artistic mediums.¹⁵

CONCLUSION

The MPA respectfully requests that the Court affirm *Rogers*’ application to artistic works or limit its consideration to whether *Rogers* applies to consumer products such as the dog toy at issue in this case.

¹⁵ As for Petitioner’s dilution claim, the MPA agrees that the Bad Spaniels dog toy in this case does not constitute “noncommercial” use of a mark—not because the meaning of “noncommercial” is entirely divorced from this Court’s commercial speech precedent, as Petitioner suggests, but because Respondent’s product is plainly commercial under that precedent. So are the other examples Petitioner posits. *See* Pet. Br. 44–46. In contrast, when creators reference a mark in their artistic expression—as opposed to merely proposing a commercial transaction—the Court should construe the “noncommercial use” exception in light of the First Amendment concerns, and the exception should apply.

Respectfully submitted,

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