

No. 22-148

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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 AMICUS CURIAE NIKE, INC.  
IN SUPPORT OF PETITIONER**

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## **INTEREST OF AMICUS CURIAE**

NIKE, Inc. is the largest seller of athletic footwear and apparel in the world.<sup>1</sup> Its principal business activity is the design, development, and worldwide marketing and selling of athletic footwear, apparel, equipment, accessories, and services. Nike sells its products directly to consumers through Nike-owned retail stores and digital platforms. It also sells its products to retail accounts and a mix of independent distributors, licensees, and sales representatives in virtually all countries around the world.

The Nike brand focuses on men's, women's, and kids' products. The company also designs products specifically for the Jordan and Converse brands. Nike's footwear products are designed primarily for specific athletic use, although a large percentage of the products are worn for casual or leisure purposes. Nike places considerable emphasis on innovation and high-quality construction in the development and manufacturing of its products. In addition to footwear, Nike sells athletic apparel, featuring the same trademarks, predominantly through the same marketing and distribution channels as athletic footwear. Nike also markets apparel with licensed college and professional team and league logos, as well as performance equipment and accessories.

Nike's valuable intellectual property rights are a critical component of its brand, success, and competitive position in the marketplace. In particular, Nike's

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<sup>1</sup> Pursuant to this Court's Rule 37.6, Amicus Curiae NIKE, Inc. certifies that no party or counsel for any party authored this brief in whole or in part, and that no person other than NIKE, Inc. or its counsel made any monetary contribution intended to fund the preparation or submission of this brief.

trademarks, many of which are famous, signal to consumers that goods bearing those marks originate with Nike. They are Nike's most powerful tool in avoiding consumer deception and confusion in the marketplace. Nike uses trademarks on nearly all of its products and maintains strict quality control standards for its products bearing its trademarks. Because of the trust that Nike's consumers place in those marks, Nike strategically pursues available protections of these rights and vigorously protects them against third-party theft and infringement. Nike's significant investments in developing and protecting its trademarks assure consumers of the quality and source of authentic Nike goods.

Nike considers its NIKE word trademark and Swoosh Design trademark to be among its most valuable and recognizable assets. Nike has registered these trademarks in almost 170 jurisdictions worldwide. Nike therefore has a vital interest in strong and well-functioning legal regimes for the protection of trademark and other intellectual property rights.

Avoiding source confusion among its consumers is of the utmost importance to Nike. As a result, Nike often takes action against third parties that are duping consumers into purchasing products bearing confusingly similar trademarks. Nike is also sometimes a defendant in cases where someone else asserts that Nike has infringed its trademark. Nike therefore appreciates the importance of balancing interests in free expression—primarily through the likelihood of confusion test and defenses like classic fair use—with the protection of valid trademark rights when needed to avoid consumer confusion.

With respect to this particular case, Nike has a compelling interest in advocating against the

unwarranted extension of the *Rogers v. Grimaldi* test to ordinary consumer products. The courts of appeals traditionally have applied *Rogers v. Grimaldi* to expressive works, such as books, movies, and television shows. The Ninth Circuit, however, has extended it to ordinary consumer products, like the dog toys at issue in this case. If allowed to stand, such an extension would cause upheaval in trademark law, severely impair the paramount consumer protection function of trademarks as source-identifiers, and threaten the painstakingly-earned good will embodied in Nike's valuable trademarks.

In addition, as the owner of famous marks, Nike has a compelling interest in advocating against the improper expansion of the “noncommercial use” exception in the Trademark Dilution Revision Act to patently commercial uses. If allowed to stand, such an expansion would erode the rights of owners of famous marks in a manner contrary to what Congress enacted.

## INTRODUCTION

In 1989, the Second Circuit adopted a two-part test for determining when the Lanham Act applies to “artistic works.” *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Since that time, most courts of appeals have adopted this test and applied it to artistic works like books, movies, and television shows. This case does not require this Court to decide whether the *Rogers v. Grimaldi* test (or some variation of it) should govern trademark infringement claims against artistic works—and Nike takes no position on that particular issue. Rather, the first question presented arises because the Ninth Circuit has vastly extended the reach of *Rogers* and applied that judicial gloss to ordinary consumer goods. This Court should hold that the traditional likelihood of confusion test, unvarnished

by any higher threshold that may or may not apply to claims against artistic works, governs claims of trademark infringement against ordinary consumer products. Applying *Rogers* to ordinary consumer products, as the Ninth Circuit has done here, would eviscerate trademark rights.

*Rogers* does not govern ordinary consumer products, but instead applies only to artistic works. And for good reason: the rationale of *Rogers* is that artistic works implicate elevated First Amendment concerns when balancing free expression with the avoidance of consumer confusion in Lanham Act cases. Artistic works are also different because, as the Second Circuit pointed out in that case, consumers typically do not expect the titles of artistic works to identify their source. The relationship between trademarks and ordinary consumer products is precisely the opposite, as the core function of a trademark is to enable consumers to identify the source of such products. The concerns that animate *Rogers* thus do not apply to ordinary consumer products.

Instead, the traditional tools of trademark law—principally the likelihood of confusion test itself, along with the established fair use defenses—are fully up to the task of balancing the First Amendment with consumer protection for ordinary consumer products. Neither *Rogers* nor any similar test should pose a threshold obstacle to those inquiries. If the accused use is likely to confuse consumers as to the source, sponsorship, or affiliation of the products, the fact that the use may simultaneously serve other expressive functions (such as humor) should not trigger an additional threshold test. Rather, courts can account for any other expressive dimensions of the use in applying the likelihood of confusion test and fair use standards. These considerations, in turn, may or may



not influence the ultimate outcome of the case. This deeply-ingrained, eminently workable approach—properly applied by the district court in its original decision in this case, Pet. App. 62a-74a—is and should remain the law.

Moreover, the distinction between ordinary consumer products and artistic works is a common sense one that is easy to apply. For example, like the dog toys at issue here, shoes and shirts are ordinary consumer products. Books and movies are artistic works. Ordinary consumer products of course may include expressive or artistic elements. The law of trademark, trade dress, design patents, and copyright recognizes as much. In fact, trademarks exist to communicate something about the product's source, sponsorship, affiliation, and/or quality. Artistic works likewise may serve utilitarian purposes, as anyone who has ever used a book as a doorstop or a paperweight can attest.

But these unremarkable facts do not change the fundamental character of these categories and the relative ease of sorting different types of goods into them. Just because expression or art is used in connection with an ordinary consumer product does not convert the product into an artistic or expressive *work* itself. And just because an artistic work can be useful does not transform it into an ordinary consumer good under *Rogers*. Even if there is some border region that may present difficult questions at the margins, most categories of goods fall well outside any potential gray area. Any effort to blur these simple distinctions should be rebuffed.

Some litigants have used the Ninth Circuit's decision to radically urge that any expressive element or purpose can bring an ordinary consumer product within the ambit of *Rogers*. But this novel approach

would steamroll consumer interests and trademark owners' rights in a way that completely undermines the Lanham Act, which is primarily intended to protect consumers against deception and confusion regarding the origin of goods and services in the marketplace. This approach also would replace a limited and manageable objective inquiry into what falls into the category of "artistic work" with arbitrary and uncertain assessments of subjective purpose and degrees of expression. Reversal here would nip this unsound approach in the bud and ensure the balance that Congress intended and the Constitution permits.

## ARGUMENT

### **I. The *Rogers v. Grimaldi* test is ill-suited for trademark infringement cases involving the sale of ordinary consumer products and should not be applied to such cases.**

The purpose of the Lanham Act is "to prevent consumer confusion regarding a product's source . . . and to enable those that fashion a product to differentiate it from others on the market." *EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopulos Inc.*, 228 F.3d 56, 61-62 (2d Cir. 2000) (quoting *Centaur Commc'ns, Ltd. v. A/S/M Commc'ns, Inc.*, 830 F.2d 1217, 1220 (2d Cir. 1987)). The *Rogers* test does not and should not govern the use of a plaintiff's trademark in connection with an ordinary consumer product. By its very terms and in its subsequent applications (until recently in the Ninth Circuit), *Rogers v. Grimaldi* is reserved for "artistic works." 875 F.2d 994, 999 (2d Cir. 1989).

In consumer product cases, the traditional likelihood of confusion test serves to balance any interest in free expression with the need to protect consumers from

confusion and protect a trademark owner's good will. That test robustly accounts for assertions of parodic use as well. The Second Circuit—the very court from which *Rogers* emanated—has recognized this in its jurisprudence. Specifically, while that court has “accorded considerable leeway to parodists whose expressive works aim their parodic commentary at a trademark,” it has “not hesitated to prevent a manufacturer from using an alleged parody of a competitor's mark to sell a competing product.” *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812 (2d Cir. 1999). The defenses of classic fair use (describing one's own product) and nominative fair use (describing the mark owner's product) are also available when their elements are met. See 15 U.S.C. § 1115(b)(4) (classic fair use elements); *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992) (nominative fair use elements). The *Rogers* test, however, has no place in such cases as a matter of law.

It is no revelation that many consumer products have artistic elements. Indeed, an “artisan” is a worker in a skilled trade, and many of the world's most famous apparel and shoe designers are considered artisans. Sometimes these artistic elements themselves are protected by trademark, trade dress, design patent, and/or copyright law. Further, a trademark is inherently a form of expression about the source, sponsorship, or affiliation of a product. As this Court has explained, “trademarks often have an expressive content. Companies spend huge amounts to create and publicize trademarks that convey a message. It is true that the necessary brevity of trademarks limits what they can say. But powerful messages can sometimes be conveyed in just a few words.” *Matal v. Tam*, 137 S. Ct. 1744, 1760 (2017). Consumer products may also bear words or symbols other than

trademarks that constitute expression, such as an inspirational, humorous, or political message on a t-shirt or coffee mug.

But the fact that a consumer product has artistic or expressive elements, or that a defendant supposedly intends to use the product as a conduit for expression, does not transform it into an artistic or expressive *work* within the meaning of *Rogers*. Moreover, this common-sense distinction between an ordinary consumer product and an artistic work is clear and routinely applied. The language of *Rogers* itself establishes these points: “Though 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*. 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.” *Rogers*, 875 F.2d at 1000 (emphasis added). By contrast, “[m]ovies, plays, books, and songs are all indisputably works of artistic expression and deserve protection. Nonetheless, they 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 . . . . Poetic license is not without limits. The purchaser of a book, *like the purchaser of a can of peas*, has a right not to be misled as to the source of the product.” *Id.* at 997 (emphasis added).

*Rogers* therefore recognizes that ordinary consumer products like shoes, shirts, and cans of peas are the rule, and artistic works like books, movies, and songs are the exception. The traditional likelihood of confusion test suffices to balance expressive interests with consumer protection and preserving rightsholders’

good will in cases involving ordinary commercial products. But when artistic works are at stake, the Second Circuit and other courts of appeals have required trademark plaintiffs to surmount a higher hurdle to overcome the elevated protection that the First Amendment accords to the expression embodied in such works.

Because artistic works also have some of the features of “more utilitarian products,” they are not categorically exempt from the Lanham Act: they have just been given additional breathing space through the *Rogers* test. 875 F.2d at 997. But the presence of artistic or expressive elements in an ordinary commercial product does not sweep it within the ambit of *Rogers*. Were that the case, *Rogers* would swallow the traditional likelihood of confusion test whole and create a major new obstacle to trademark enforcement. Neither Congress nor *Rogers* itself intended such a paradoxical result, which would revolutionize trademark law and gut trademark rights in the process.

Again, the Second Circuit’s approach supplies an instructive blueprint. Neither that court nor district courts within that circuit have applied *Rogers* to ordinary commercial products, even where those products have expressive elements. Rather, the traditional likelihood of confusion test achieves the proper balance. *See A.V.E.L.A., Inc. v. Estate of Marilyn Monroe, LLC*, 364 F. Supp. 3d 291, 321-22 (S.D.N.Y. 2019) (rejecting argument that *Rogers* applies “because t-shirts have been recognized as an expressive medium” and agreeing with argument that “the *Rogers* test is not designed to protect commercial products and, further, that any First Amendment concerns are already addressed by the consumer

confusion test applicable to commercial products”). And, once again, defenses like classic fair use and nominative fair use are available when their elements are met. *Rogers* is inapplicable, but the First Amendment is hardly left adrift.

Further, the Second Circuit and courts within it have specifically considered the First Amendment interests implicated by parody in connection with the likelihood of confusion analysis. See, e.g., *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 114 (2d Cir. 2009); *Harley-Davidson*, 164 F.3d at 812; *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 503 (2d Cir. 1996). While a parody defense is not without its limits<sup>2</sup>, it fits comfortably within a context-specific assessment of the likelihood-of-confusion factors (which are broadly similar across circuits). See *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 440-44 (S.D.N.Y. 2016), *aff’d*, 674 F. App’x 16 (2d Cir. 2016) (“considering all eight *Polaroid* [likelihood-of-confusion] factors and looking at the products in their totality” to conclude “defendant’s use of the mark is an obvious parody or pun, readily so perceived, and unlikely to cause confusion among consumers” (citations and quotations omitted)); Pet. App. 62a-74a.

In addition to the non-exclusive nature of the factors that courts routinely use to measure likelihood of confusion, the assertedly parodic character of the use may be reflected in the analysis of factors such as: (1)

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<sup>2</sup> To qualify as such, “[a] parody must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is not the original and is instead a parody.” *Hormel Foods Corp.*, 73 F.3d at 503 (2d Cir. 1996) (quoting *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989)).

similarity of marks (where the marketplace context of the use is important), (2) similarity of goods, (3) defendant's intent, and (4) actual confusion. The extent to which an assertion of parody does or does not influence each of these factors will vary, as it should, according to the facts of the case. The far blunter and more lopsided instrument of *Rogers* is both unnecessary and unwarranted to balance the relevant interests in such cases.

**II. Using a trademark for an expressive purpose does not convert an ordinary consumer product into an expressive work.**

The Ninth Circuit mistook the expressive potential of trademarks as a reason to shrink trademark rights when third parties try to exploit the expressive potential of those trademarks to sell an ordinary consumer product. *See* Pet. App. 30a-32a. Indeed, consumers themselves will often use or display a trademark-bearing product to achieve some self-expressive purpose beyond simply identifying the source of the goods. But this unremarkable fact does not support the Ninth Circuit's expansion of *Rogers* into the vast realm of ordinary consumer products. It instead points in the opposite direction.

Trademark rights accrue when, for example, a word or a symbol takes on a secondary meaning to the consumer or when an inherently distinctive term or design is used to convey to the consumer that a product originates from a specific source. The rightsholder develops "good will" in that designation of source by using the trademark to convey something about the brand. This "brand message," in turn, may inspire consumers to choose products bearing the mark not just because it assures a certain quality, but

also because the consumer wishes to communicate something about themselves through that choice.

For example, a consumer may wear Nike shoes and apparel for a variety of reasons, including to express their loyalty to the brand, their identity as an athlete, their enthusiasm for a team or player who is also identified on the product, or their shared commitment to some of Nike's most important values of hard work and persistence in the face of obstacles. These self-expressive dimensions of the consumer's choice do not stand apart from the source-identifying nature of the Nike trademarks on the consumer's shoes or apparel. Rather, they are possible *precisely because* Nike's trademarks serve a source-identifying function. The trademarks associate the goods with Nike and the brand messages that are meaningful to the consumer. *See Matal*, 137 S. Ct. at 1760.

Accordingly, any dichotomy that Respondent or its amici may try to draw between the source-identifying function of trademarks and a consumer's expressive purposes in using products with those trademarks is a false one. In fact, the extent to which a trademark is capable of being used by consumers for their own expressive purposes is likely to correlate directly with the strength of that trademark as a source-identifier in the first place. The stronger the mark, the more likely others are to perceive the message.

Moreover, whatever the *consumer's own expressive purpose* in choosing a commercial product bearing a certain trademark, the objective *character of the product* remains unchanged. It remains a shoe, a shirt, or a can of peas. It does not become a book, movie, song, or some other type of artistic work that may implicate *Rogers* concerns. The same is true when a third-party seller claims to have a transcendent



expressive purpose in deploying another’s trademark to sell its own ordinary commercial product. Whatever the result under the likelihood of confusion test and any fair use defense that may be asserted, *Rogers* does not provide a special shield to such uses.

Finally, an ordinary commercial product is also not transformed into an expressive work just because a consumer does not use the product for its intended purpose. For example, “sneakerhead culture” revolves around collecting athletic shoes that may never be worn and are often displayed and traded on online platforms. But even if the shoes are not actually worn, it does not change their identity as ordinary commercial products. Moreover, a product is more likely to become a valuable collector’s item if it bears a famous trademark that functions as a powerful source-identifier—thus underscoring collectors’ interests in the Lanham Act’s protections of that mark.

### **III. The TDRA’s “noncommercial use” exception does not automatically immunize humorous uses of a trademark.**

Turning to the second question presented, the Ninth Circuit’s ruling on the trademark dilution claims is wrong as a straightforward matter of statutory interpretation. The Ninth Circuit stated that “[a]lthough VIP used JDPI’s trade dress and bottle design to sell Bad Spaniels, they were also used to convey a humorous message.” Pet. App. 33a. The Ninth Circuit then held that the mere presence of this humorous message was enough to immunize the use from trademark dilution claims under the “noncommercial use” exception, 15 U.S.C. § 1125(c)(3)(C), as a matter of law. Pet. App. 33a-34a.

But if merely “convey[ing] a humorous message” were enough to bring a defendant’s use of a famous mark within the noncommercial use exception, then the separate parody exception in that same portion of the statute would be unnecessary. *See* 15 U.S.C. § 1125(c)(3)(A). The parody clause, moreover, is nested within a fair use exception that is unavailable when the defendant is using the plaintiff’s famous mark “as a designation of source for the [defendant]’s own goods or services.” *Id.*; *see also Starbucks Corp.*, 588 F.3d at 112. The Ninth Circuit’s interpretation of the noncommercial use exception thus accomplishes something even worse than converting the parody exception into surplusage: it obliterates important limits that Congress placed on the parody exception, and hence rewrites the statute.

This Court has consistently eschewed interpretations of statutes that render superfluous other portions of the same act. *See, e.g., Corley v. United States*, 556 U.S. 303, 314 (2009); *Hibbs v. Winn*, 542 U.S. 88, 101 (2004). The Ninth Circuit’s approach violates this rule of statutory construction. It also impermissibly deploys a more general provision of a statute to negate the boundaries of a sister provision that more specifically addresses the subject matter at hand. *See Bloate v. United States*, 559 U.S. 196, 207-09 (2010). Such a capacious approach to the noncommercial use exception of the TDRA erodes, without warrant, the rights that Congress has conferred on owners of famous trademarks. It therefore should be rejected.

This Court’s decision in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994), illustrates a better approach. By referring to 2 Live Crew’s song as a “commercial parody,” the Court confirmed that

commerciality and parody are distinct concepts. *Id.* at 571, 574. A parody can be commercial. *See id.* This common-sense recognition mirrors the separateness of the TDRA’s exceptions for parodic fair uses and noncommercial uses. Moreover, the Court recognized the equally common-sense point that a use that is undertaken “for profit” is a commercial use. *Id.* at 584 (citation and internal quotations omitted). While *Campbell* concerned a portion of the Copyright Act that codified common law, this same understanding should inform the interpretation of the TDRA’s noncommercial use exception.

**IV. Not every joke that uses another’s trademark is a parody.**

Finally, any application of trademark doctrines to assertions of “parody” should be tethered carefully to the true nature of parody itself. It should not be enough for a defendant to say: “You take your trademark seriously. I am using it to make a joke. Therefore, I am parodying your trademark.” That alone is not parody. But that is essentially what the Ninth Circuit allowed to qualify as “parody” here.

As this Court explained in *Campbell*, a parody must at least partly comment on or criticize the object of its mimicry. 510 U.S. at 580, 582. The Court further confirmed that such commentary or criticism is essential to parody when it contrasted parody with satire: “parody often shades into satire when society is lampooned through its creative artifacts.” *Id.* at 581.

Circuit Judge Leval, on whose academic writings this Court relied extensively in *Campbell*, further explicated these distinctions when he described “a common form of copying that is neither parodic nor satirical, where one simply piggy-backs on a famous

song or poem, passage, or logo, playing on public recognition of the original to give punch or humor to a new, unrelated message.” Pierre Leval, *Fair Use: A Ramble Through the Bramble*, NYU Proving IP Symposium, May 16, 2019, video available at [https://www.youtube.com/watch?v=OGky\\_yG8dV8](https://www.youtube.com/watch?v=OGky_yG8dV8) (last accessed January 16, 2023) (starting at 11:49). Such “copying is essentially either to harness the expressive brilliance of the original for the delivery of the copier’s message, or to gain audience impact for the new message by free-riding on the fame of the original expression.” *Id.* While the governing rules will differ according to whether the legal regime is copyright or trademark, the relevant premise is the same: this “common form” of “piggy-back[ing]” that Judge Leval described is not “parody.”

The decision below reflects a lax conception of parody that is inconsistent with *Campbell’s* explication of parody’s essence. The Ninth Circuit categorized the accused use of the trademark on a dog toy as a parody because “[t]he effect is ‘a simple’ message conveyed by ‘juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.’” *L.L. Bean, Inc.*, 811 F.2d at 34 (affording First Amendment protection to a message ‘that business and product images need not always be taken too seriously’).” Pet. App. 31a (quoting *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir. 1987)). But the Ninth Circuit failed to identify any meaningful way in which the accused use was commenting on or criticizing the trademark at issue. The belief that things “need not always be taken too seriously” is the foundation of humor more generally. If this element alone is enough to make humor a “parody,” then all humor is a parody of everything involved in the joke. This is neither the

law nor the meaning of those words, and the Ninth Circuit's overly expansive view should be rejected.

Though defendants will often have an incentive to label it as such, not every humorous use of another's trademark is a parody. Courts therefore should take a disciplined approach to this important classification in cases where "parody" is claimed.

### CONCLUSION

When balancing trademark owners' rights with First Amendment interests, courts should tread lightly. Rigid rules are highly unsuited to this inquiry. Here, the footfalls of the Ninth Circuit's approach are far too heavy. Whatever the fate of the *Rogers* test in the realm of artistic works, it should not extend beyond that sphere to ordinary consumer products. Such an expansion would disable the legitimate enforcement of trademark rights by superimposing a difficult and unsuitable threshold inquiry on garden-variety trademark cases. This upheaval would destroy the balance between expressive interests and consumer protection that Congress already has built into the Lanham Act.

The decision below therefore should be reversed. With respect to the first question presented, this Court should hold that the traditional likelihood of confusion test applies to an accused infringer's assertedly parodic or other humorous use of a trademark in connection with an ordinary commercial product—without any supervening gloss that may or may not apply to artistic works. With respect to the second question presented, this Court should hold that the humorous use of a famous mark does not automatically qualify for the "noncommercial use" exception of the TDRA.

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