

No. 22-347

IN THE
Supreme Court of the United States

DIECE-LISA INDUSTRIES, INC.,

Petitioner,

v.

DISNEY STORE USA, LLC, *et al.*,

Respondents.

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

SUPPLEMENTAL BRIEF

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CORPORATE DISCLOSURE STATEMENT

Petitioner Diece-Lisa Industries, Inc.'s Rule 29.6 Statement remains accurate. Petitioner certifies it has no parent corporation, and there is no publicly held corporation that owns 10% or more of its stock.

SUPPLEMENTAL BRIEF

Pursuant to Rule 15.8, Petitioner respectfully submits this supplemental brief to address two new authorities that further reinforce the need for review.

First, on November 21, 2022, this Court granted certiorari in *Jack Daniel's Properties, Inc. v. VIP Products LLC*, No. 22-148. *Jack Daniel's* raises a similar question to this case regarding the intersection of the First Amendment and the Lanham Act, particularly the Ninth Circuit's expansive and problematic application of *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

This case is a fitting companion to *Jack Daniel's*. While *Jack Daniel's* involves a case of forward confusion, this case involves *reverse* confusion, where the shortcomings of *Rogers* and the Ninth Circuit's application of *Rogers* are even more stark. Accordingly, this Court should grant the petition alongside *Jack Daniel's* to clarify the balance between free expression and trademark protection in cases implicating both common types of confusion (forward and reverse). Alternatively, this Court should hold the petition pending its decision in *Jack Daniel's*, and then grant, vacate, and remand for the lower courts to apply this Court's holding and reasoning.

Second, on November 14, 2022, the Ninth Circuit issued its opinion in *Punchbowl, Inc. v. AJ Press, LLC*, No. 21-55881, ___ F.4th ____, 2022 WL 16911996. *Punchbowl* affirmed the district court's grant of summary judgment of non-infringement based on *Rogers*. In doing so, it demonstrated how the Ninth Circuit has drifted further apart from the Second Circuit.

Punchbowl involved, on the one side, an event-planning company that owned the registered mark “Punchbowl,” and, on the other side, a news publication called *Punchbowl News*. The event planner alleged that Punchbowl News infringed on its mark. Applying *Rogers*, the Ninth Circuit found the news publication’s use of “Punchbowl” fell outside of the Lanham Act as a matter of law because the term was expressive in nature and not explicitly misleading as to its source. The Ninth Circuit expressly held that survey evidence of actual confusion, one of several traditional likelihood-of-confusion factors, is “not relevant” under *Rogers*. *Punchbowl*, 2022 WL 16911996, at *9.

The Ninth Circuit’s abandonment of traditional likelihood-of-confusion factors further ossifies an intractable split between itself and the Second Circuit. The Second Circuit—which created the *Rogers* test—analyzes trademark infringement cases involving expressive works by first applying traditional likelihood-of-confusion factors, such that a “particularly compelling” finding of likelihood of confusion can outweigh the First Amendment concerns recognized in *Rogers*. See *Twin Peaks Prods., Inc. v. Pubs. Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993). The Ninth Circuit, meanwhile, flips the analysis. It requires a plaintiff to first survive a *Rogers* challenge before proceeding to a likelihood-of-confusion analysis. See *Punchbowl*, 2022 WL 16911996, at *9; *VIP Prods. LLC v. Jack Daniel’s Props., Inc.*, 953 F.3d 11953 F.3d 1170, 1176 (9th Cir. 2020).

This case below, like *Punchbowl*, involved strong indicia of consumer confusion. C.A. E.R. 614-22. The Ninth Circuit now undoubtedly precludes district courts

from considering such facts. The different approaches by the Second and Ninth Circuits will often be outcome determinative in trademark infringement cases.

The petition for a writ of certiorari should be granted. Alternatively, this Court should hold the petition pending its decision in *Jack Daniel's Properties, Inc. v. VIP Products LLC*, and then grant, vacate, and remand for the lower courts to apply this Court's holding and reasoning.

Respectfully submitted,

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