

No. 22-347

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IN THE  
**Supreme Court of the United States**

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DIECE-LISA INDUSTRIES, INC.,

*Petitioner,*

*v.*

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

*Respondents.*

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

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**BRIEF IN OPPOSITION**

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**CORPORATE DISCLOSURE STATEMENT**

Respondents are direct and indirect wholly owned subsidiaries of The Walt Disney Company, a publicly held company. No other publicly held company owns 10% or more of Respondents' stock.

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## INTRODUCTION

*Toy Story 3* is the third installment in Pixar's celebrated *Toy Story* franchise, which follows the adventures of Buzz Lightyear, Sheriff Woody, and their ragtag group of toys. *Toy Story 3* was released in 2010 to critical acclaim, became the highest-grossing animated motion picture of all time within two months after its release, and was awarded the Oscar for Best Animated Film at the 83rd Academy Awards.

The principal antagonist in *Toy Story 3* is a cute and cuddly pink bear with a tyrannical personality named "Lots-o'-Huggin' Bear." That name, which the filmmakers selected to counterpoint the character's dark inner disposition, is spoken just once in the motion picture's entire 103-minute run time. The character is otherwise referred to only by his nickname, "Lotso."

Petitioner is a sole proprietorship owned and operated by serial inventor Randice Altschul. In the 1990s, Altschul conceived of a line of puppets in the form of stuffed animals with sleeve-like openings into which a person would place their arms and give themselves a simulated hug. After its original licensee filed for bankruptcy, Petitioner undertook to sell those wearable puppets, which it called "Lots of Hugs," at flea markets and other local gatherings in the Northeast. Over the course of 17 years, Petitioner sold fewer than 2,500 of the wearable bears, lambs, racoons, cows, monkeys, and moose.

In 2012, nearly two years after the release of *Toy Story 3*, Petitioner filed the instant action for alleged infringement of its "Lots of Hugs" mark. Petitioner



claimed that Lotso's full name, "Lots-o'-Huggin' Bear," was confusingly similar to Petitioner's word mark, and that every use of *the character*, with or without his name attached, infringed that mark.

Neither the district court nor the Ninth Circuit was required to reach Petitioner's novel theory that a character can somehow infringe a word mark. Instead, the district court entered summary judgment for Respondents, and the Ninth Circuit affirmed, based on a straightforward application of the *Rogers* test, named after *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Under that test, which has been adopted by every circuit court to consider the issue, a Lanham Act plaintiff attacking the use of an allegedly infringing mark in a motion picture or other First Amendment-protected artistic work must make a threshold showing that the mark has no artistic relevance to the work or, if it does have artistic relevance, that it explicitly misleads as to the source or content of the work. Petitioner was unable to make either showing, resulting in judgment for Respondents.

After eleven years of litigation, in an effort to forestall a final adjudication on a record that overwhelmingly favors Respondents under any legal standard, Petitioner seeks to piggy-back on this Court's granting of the certiorari petition in *VIP Products, LLC v. Jack Daniel's Properties, Inc.*, 2022 WL 1654040 (9th Cir. Mar. 18, 2022), *cert. granted* 143 S. Ct. 476 (No. 22-148), and requests that the Court either review the instant case as a "companion" to *Jack Daniel's* or, alternatively, hold the petition pending a decision in *Jack Daniel's*.

Neither request is warranted. Unlike *Jack Daniel's*, this case arises from an artistic work—the *Toy Story 3* motion picture—that falls squarely within the First Amendment guarantee. Whether or not the Ninth Circuit has gone too far in applying the *Rogers* test to ordinary consumer products, unmoored from inherently creative works of artistic expression, is of no consequence to the instant petition. Petitioner's claims fail under a traditional application of *Rogers* as it has been applied to quintessentially artistic works across circuit courts for nearly 35 years. Petitioner is seeking not to rein in an arguable overextension of *Rogers* but instead to upend well-entrenched law upon which filmmakers and other artists regularly rely. There is no circuit split on the application of *Rogers* to motion pictures and other artistic works, and no basis for throwing more than three decades of settled jurisprudence into disarray.

Neither of the questions presented in *Jack Daniel's* has any bearing on the correctness of the Ninth Circuit's ruling in this case. This case does not turn on whether humorous use of another's trademark as one's own commercial product is entitled to heightened First Amendment protection from trademark infringement claims. Nor does it implicate what constitutes a "noncommercial" use under the Trademark Dilution Revision Act. Indeed, this case does not involve a dilution claim at all. Accordingly, there is no reason to pair this petition with *Jack Daniel's* or to hold it pending a decision therein.

For the foregoing reasons, the petition for writ of certiorari should be denied.

**STATEMENT**

1. In 1994, Altschul conceived of a puppet with sleeve-like openings into which a person could place their arms, allowing them to hug the puppet and receive a simulated hug in return. C.A. E.R. 3:403, 3:422. Altschul eventually received a patent for this so-called “hugging technology.” C.A. E.R. 2:187–191.

In 1995, Petitioner granted a license to a small toy company, Happiness Express, to manufacture and sell a “soft and squooshy stuffed creature” incorporating that hugging technology, which Petitioner called “Snugglers.” C.A. E.R. 3:450–458. Happiness Express renamed the product “Lots of Hugs,” which it registered as a word mark. C.A. E.R. 3:424, 3:460. Happiness Express began manufacturing and selling the wearable puppets under the “Lots of Hugs” word mark in the form of brown, blue, green, purple, pink, and yellow bears. C.A. E.R. 3:462–463.

Happiness Express filed for bankruptcy the very next year, and Petitioner acquired its inventory and intellectual property rights, including the “Lots of Hugs” word mark, out of bankruptcy. C.A. E.R. 3:424–425, 467–470. The USPTO cancelled the registration for “Lots of Hugs” in 2004. Petitioner filed a new application to register “Lots of Hugs” as a word mark for “puppets” in 2007, which registration issued on January 1, 2008. C.A. E.R. 3:475, 478.

After the Happiness Express bankruptcy, Petitioner sold the remaining inventory of wearable bear puppets, as well as wearable puppets it commissioned in the form of

lambs, racoons, cows, monkeys, moose, and other animals, at flea markets and other “town event[s] or community events” that Altschul saw listed in local newspapers. C.A. E.R. 3:412–413; C.A. S.E.R. 1:51, 61–68. From 1997 to 2013, Petitioner sold a total of 2,216 puppets at local events in the Northeast—an average of just 130 units per year. C.A. S.E.R. 1:192. Petitioner did not sell the puppets through any other distribution channels, not even online. C.A. E.R. 3:426; C.A. S.E.R. 1:73.

2. In 1992, the founders of Pixar, then an independent studio, began developing ideas for the company’s first feature-length motion picture. C.A. E.R. 3:434. One of their first ideas was a story about toys, one version of which included an “angry clearance aisle toy that had the exterior of a cuddly bear” and was named “Lots-o’-Lovin’ Bear.” C.A. E.R. 3:434, 443–445. The character was a “tough guy” who believed his full name conveyed weakness, so he went by “Lotso” instead. C.A. E.R. 3:440, 446–447. Lotso ultimately was not included in the original *Toy Story* motion picture, which was released in 1995. C.A. E.R. 3:435.

The Lotso character was revived when development of *Toy Story 3* began in 2006. C.A. E.R. 3:437–438. *Toy Story 3*’s creators had an affinity for bear hugs, which first produced an unwieldy name “Lots-o-Lovin’ and Bear Hugs,” that was ultimately refined to “Lots-o’-Huggin’ Bear.” C.A. E.R. 3:439. Lotso became the principal antagonist of *Toy Story 3*, with a dark, tyrannical personality lurking behind his cuddly pink exterior. C.A. Ex. 1. Just as originally conceived, the “Lots-o’-Huggin’ Bear” character went by “Lotso,” and his full name is spoken just once (around the 22-minute mark) in *Toy Story 3*’s 103-minute run time. C.A. Ex. 1; C.A. S.E.R. 1:218.

*Toy Story 3* was released theatrically in June 2010. C.A. E.R. 3: 433–434. Despite the film’s broad success, Petitioner did not learn of the Lotso character until nearly two years after the motion picture’s release, and it filed this action shortly thereafter. C.A. S.E.R. 1:123.

3. Respondents moved for summary judgment on two independent grounds. First, Respondents argued that Petitioner’s claims were barred by the First Amendment under *Rogers*. C.A. S.E.R. 1:19–23. Second, Respondents argued that Petitioner had failed to produce evidence sufficient to create a triable issue of fact with respect to the alleged likelihood of confusion. 1-SER-23–33.

The district court granted summary judgment under *Rogers*. Pet. App. 8a–10a. Because it was undisputed that *Toy Story 3* is an expressive work, the *Rogers* test required Petitioner to show that the “Lots-o’-Huggin’ Bear” name and character were either (1) not artistically relevant to *Toy Story 3* or (2) explicitly misleading as to the source or content of the motion picture. Pet. App. 8a. Petitioner did not meaningfully dispute artistic relevance, such that only the explicitly misleading prong of *Rogers* was in play. Pet. App. 8a–10a. Nor did Petitioner present any evidence that Respondents explicitly misled consumers into believing that Petitioner had endorsed or sponsored *Toy Story 3* or Lotso himself. Pet. App. 9a–10a. Because Petitioner could not satisfy either prong of the *Rogers* test, the district court entered judgment for Respondents. Pet. App. 11a.

4. The Ninth Circuit affirmed under a straightforward application of *Rogers*, finding that there was no genuine dispute that Respondents’ use of the “Lots-o’-Huggin’

Bear” name was relevant to the plot of an artistic work or that use of the name was not explicitly misleading within the meaning of *Rogers*. Pet. App. 3a. *Rogers* therefore barred Petitioner’s claims. *Id.*

## **REASONS FOR DENYING THE PETITION**

### **I. There Is No Circuit Split On Application Of The *Rogers* Test To Motion Pictures And Other Quintessentially Artistic Works**

Nearly 35 years ago, the Second Circuit in *Rogers* set forth a rubric for evaluating Lanham Act infringement claims arising from the use of a mark in connection with motion pictures and other artistic works. Specifically, liability attaches under *Rogers* only when such use is plainly unrelated to the underlying artistic work or its inclusion is explicitly misleading as to the source or content of that work. The *Rogers* test effectively balances the public interest in consumer protection with the First Amendment interests of creators of artistic works and their audiences.

In the more than three decades since *Rogers* was decided, every circuit to consider the issue has adopted the *Rogers* test to evaluate trademark infringement claims in connection with motion pictures, television shows, songs, books, videogames, and other quintessentially artistic works. *Rogers* has yielded a well-established jurisprudence that provides artists essential clarity and uniformity across jurisdictions. 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.” H.R. Rep. No. 116-645, at 20 (2020).

In the instant case, the Ninth Circuit faithfully applied *Rogers* to bar an infringement claim directed at core artistic expression—specifically, the name of a character in a motion picture. Unlike titles, which have at least some source-identifying function, character names are unmistakably expressive and are woven into the fabric of the work itself. Because the “Lots-o’-Huggin’ Bear” name has clear artistic relevance to *Toy Story 3* and is not explicitly misleading as to the source or content of the motion picture, *Rogers* barred Petitioner from proceeding with its claims.

**A. *Rogers* Strikes An Appropriate Balance Between Free Speech And Consumer Protection In The Context Of Artistic Works**

*Rogers* involved a Federico Fellini film titled “Ginger and Fred,” about two fictional cabaret performers who imitated the renowned dancing duo Ginger Rogers and Fred Astaire. Rogers sued, claiming that the title 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.” *Rogers*, 875 F.2d at 997.

The Second Circuit identified two reasons why the traditional multi-factor likelihood of confusion analysis should not apply to the allegedly confusing title. First, “the artistic and commercial elements of titles are inextricably intertwined,” such that preventing creators from using their preferred titles would chill “the author’s

freedom of expression.” *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.

Recognizing that “overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values,” the Second Circuit adopted the 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 it has some artistic relevance, [where] the title explicitly misleads as to the source or the content of the work.” *Id.*

The Second Circuit applied the *Rogers* test to affirm the district court’s grant of summary judgment in favor of the film’s producers. *Id.* at 1001. As to the first prong of the test, the court determined that the film’s title “surpasses the minimum threshold of artistic relevance to the film’s content,” as the central characters nicknamed “Ginger” and “Fred” have genuine relevance to the film’s story. *Id.* As to the second prong, the court concluded that “the title is not misleading; on the contrary, it is an integral element of the film and the filmmaker’s artistic expressions.” *Id.*



The Second Circuit did not rule out the possibility “that some members of the public would draw the incorrect inference that Rogers had some involvement with the film.” *Id.* However, “that risk of misunderstanding, not engendered by any overt claim in the title, [was] so outweighed by the interests in artistic expression” so as to require entry of judgment for the film’s producers. *Id.*

**B. *Rogers* Has Been Adopted By Every Circuit Court To Consider The Issue, And Congress Has Legislated Against Its Backdrop**

In the nearly 35 years since *Rogers* was decided, it has been broadly adopted by courts across the nation, including every circuit court to consider it. *See* J. Thomas McCarthy, 6 MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION (“McCarthy”) § 31:139 (5th ed. 2022). Courts have routinely applied *Rogers* to most every variety of artistic work and to the use of marks in the bodies of such works, and not just the titles. *See, e.g.,* *MGFB Props., Inc. v. Viacom Inc.*, 54 F.4th 670, 679–80 (11th Cir. 2022) (television series); *Lombardo v. Dr. Seuss Enters., L.P.*, 729 Fed. Appx. 131, 133 (2nd Cir. 2018) (plays); *Radiance Found., Inc. v. N.A.A.C.P.*, 786 F.3d 316, 329 (4th Cir. 2015) (articles); *Univ. of Alabama Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1278–79 (11th Cir. 2012) (paintings); *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (video games); *Parks v. LaFace Records*, 329 F.3d 437, 451–52 (6th Cir. 2003) (songs); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65 (5th Cir. 2000) (magazines); *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (book titles); *Cliff’s Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc.*, 886 F.2d 490, 494–95 (2d Cir. 1989) (books).

The *Rogers* test is applied to quintessentially artistic works with clarity and uniformity across jurisdictions, making it a critical tool for artists and elucidating an important First Amendment defense protecting their creative decisions. See Lynn M. Jordan & David M. Kelly, *Another Decade of Rogers v. Grimaldi: Continuing to Balance the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 109 Trademark Rep. 833, 873–74 (2019) (“The universal thread in thirty years of *Rogers* is the consistency with the *Rogers* court’s original concern: that consumer interests for creativity be satisfied, and only in those limited situations where a junior user acted in bad faith and intended to create confusion or trade off the goodwill of the senior user should the Lanham Act appropriately prevail.”).

*Rogers* advances critical First Amendment interests whether the plaintiff’s mark is well-known, as in many forward confusion cases, or relatively obscure, as in most reverse confusion cases. Motion pictures and television shows look to tell stories that connect with and are understood by audiences, and filmmakers would be hamstrung if they were unable to reference or depict recognized marks to tell those stories. At the same time, *Rogers* ensures that filmmakers and other artists are not constrained by the fear that a character name or other expressive element of their works may trip over lesser known, and in many cases practically undiscoverable, marks and give rise to what is often transparently opportunistic litigation. *Rogers* thus affords essential protection to artistic choices regardless of a mark’s renown.

Subjecting inherently artistic works to the vagaries inherent in the traditional multifactor test would chill core First Amendment expression. Trademark infringement actions are seldom disposed of at the pleading stage, or even on summary judgment, and are instead resolved by jury verdicts only after years of expensive litigation, with often unpredictable and inconsistent results. In a world without *Rogers*, many artists would simply cede authority to trademark owners and censor references to marks in their creative works, limiting creative freedoms and subverting the public interest in free expression. *Rogers* ensures that the prospect of burdensome and unpredictable litigation does not chill artistic expression.

Indeed, *Rogers* is so engrained in Lanham Act jurisprudence that Congress has explicitly legislated against its backdrop. For instance, 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 *Rogers*' safeguards, this would raise the specter of motion pictures, television shows, books, and songs being enjoined due to trademark claims. The committee report accordingly recognized that the committee “intends and expects 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). In other words, Congress has not only accepted *Rogers*, but it has relied on its continuing vitality as an expression of legislative intent.

**C. There Is No Circuit Split Over Whether *Rogers* Is a “Threshold” Test**

Petitioner attempts to manufacture a circuit split regarding the “explicitly misleading” prong of *Rogers*. See Pet. 25–26; Supp. Br. 2. No split exists. Both the Ninth Circuit and the Second Circuit require that use of a mark be “explicitly misleading” in order to be actionable under *Rogers*. In *Twin Peaks*, the Second Circuit observed that in applying the “explicitly misleading” prong of *Rogers*, factors supporting a finding of confusion must be “particularly compelling,” and the court remanded for further consideration of that issue. 996 F.2d at 1379. This does not reflect a departure from the Second Circuit’s own prior *Rogers* opinion, but rather describes the particular character of evidence necessary to rise to the level of being “explicitly misleading.” In line with this, the Ninth Circuit has held that without more than an ordinary showing of likelihood of confusion, the use of a mark is clearly not explicitly misleading and there is no need to wade through the likelihood-of-confusion factors to reach this conclusion. See, e.g., *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1199 (9th Cir. 2017); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245–46 (9th Cir. 2013).

Moreover, in the thirty years since *Twin Peaks*, the Second Circuit has never returned to its discussion of the “explicitly misleading” prong. Like in the Ninth Circuit, district courts within the Second Circuit “have disposed of trademark claims where simply looking at the work itself, and the context in which it appears, demonstrates how implausible it is that a viewer will be confused into believing that the plaintiff endorsed the defendant’s work (and without relying on the likelihood of confusion factors

to do so.” *Louis Vuitton Malleteier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172, 183 (S.D.N.Y. 2012).

Petitioner also cites to the Ninth Circuit’s recent decision in *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091 (9th Cir. 2022), in a further attempt to demonstrate a circuit split. Supp. Br. 1–2. In *Punchbowl*, the Ninth Circuit determined that survey evidence of confusion was not relevant given the “entirely different market” in which the defendant used the mark and the fact that it was used as “only one component of the larger expressive work.” *Id.* at 1100–04. Such survey evidence is not “particularly compelling” evidence of confusion under *Twin Peaks* either. There is no basis for Petitioner’s speculation that the Second Circuit would have considered this evidence, much less held that it establishes a jury issue.

Even if there was some difference between the Second Circuit’s and Ninth Circuit’s standards, which there is not, that purported distinction would not have affected the result in this case. The “Lots-o’-Huggin’ Bear” name is used only fleetingly, as part of a broader artistic work, and Petitioner’s wearable puppet is in an entirely different category of goods from the *Toy Story 3* motion picture where the “Lots-o’-Huggin’ Bear” name is used. Relying on *Punchbowl*, Petitioner claims that the Second Circuit considers actual confusion evidence and the Ninth Circuit does not, but any dispute over whether to consider actual confusion evidence is irrelevant: in the ten years between the release of *Toy Story 3* and the filing of Petitioner’s summary judgment motion, Petitioner did not adduce *any* evidence of actual consumer confusion or provide any survey evidence.

## II. The Ninth Circuit Correctly Applied *Rogers* To Bar Petitioner’s Claims

The Ninth Circuit’s decision in the instant case is a textbook application of the *Rogers* test to a motion picture, the same type of quintessentially artistic work that was involved in *Rogers* itself. The court had no difficulty finding that the “Lots-o’-Huggin’ Bear” name was relevant to *Toy Story 3* and that the use of that name was not explicitly misleading within the meaning of *Rogers*. Pet. App. 3a. Consequently, *Rogers* barred Petitioner’s claims. *Id.*

As the Ninth Circuit noted in its decision, Petitioner did not meaningfully dispute that its claims were barred under existing law. Pet. App. 2a–3a.<sup>1</sup> Instead, Petitioner urged the court to modify *Rogers* in reverse confusion cases to require the defendant to explicitly *disclaim* any connection with the plaintiff and its mark. That proposal is as impractical as it is unprecedented, and it would import burdensome disclaimers into a doctrine that exists precisely to *avoid* burdens on creative expression

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1. The Petition identifies a single consumer product, a Lotso stuffed bear, that was marketed and sold using the “Lots-o’-Huggin’ Bear” name and to which Petitioner contends *Rogers* should not apply. Petitioner, however, did not argue in either the district court or the Ninth Circuit that that or any other movie-themed consumer products should be treated any differently than books, video games, or other expressive works based on *Toy Story 3*, such that Petitioner’s attempt to carve such products out of *Rogers* has been waived. See *New Life Art*, 683 F.3d at 1280 (holding that appellant had waived any challenge that mugs and other “mundane products” featuring images of respondents’ paintings were not subject to *Rogers* by failing to raise the issue in the district court).

protected by the First Amendment that the Lanham Act might otherwise impose. *See Riley v. Nat'l Fed'n of the Blind of N.C., Inc.*, 487 U.S. 781, 796–97 (1988) (First Amendment guarantees encompass “the decision of both what to say and what *not* to say”).

The Court should not broker Petitioner’s contention that *Rogers*’ “explicitly misleading” requirement simply should not apply in a reverse confusion case. Pet. 29–34. This makes no sense: the First Amendment concerns identified in *Rogers* are just as strong in a reverse confusion case as in the traditional “forward confusion” context. If anything, the concerns are heightened in a reverse confusion case because such cases typically involve a less well-known senior user of the mark, meaning that artists creating works for widespread public consumption would be forced to be on the lookout for any minor existing use of a likely little-known mark to stave off potential reverse confusion claims.

Furthermore, this petition is not the proper vehicle to address any questions regarding the relationship between *Rogers* and reverse confusion. Petitioner does not contend that the Ninth Circuit has created a circuit split, nor can it. The challenged analysis arises from an unpublished Ninth Circuit decision on an issue that has not been addressed by other circuits, let alone in published decisions. Because this issue has arisen in so few cases, Petitioner can only speculate as to situations in which a reverse-confusion plaintiff may or may not be able to show an explicitly misleading use under *Rogers*, and ignores that *Rogers* provides a mechanism in all cases to address uses of trademarks that are most likely to deceive because they involve an explicitly misleading indication of source, sponsorship, or affiliation.

The Ninth Circuit’s decision was a straightforward application of *Rogers* to a quintessentially artistic work, and its reversal would require nothing short of overruling *Rogers* and upending decades of jurisprudence that is uniform across jurisdictions, has been endorsed by Congress, and provides critical guidance for authors, filmmakers, songwriters, painters, and artists in every medium.

### **III. The Questions Presented In *Jack Daniel’s* Have No Bearing On The Instant Petition**

In the absence of any circuit split or other legitimate basis for review of the Ninth Circuit’s decision in this case, Petitioner seeks to tether its petition to the certiorari petition that this Court recently granted in *Jack Daniel’s*. Petitioner devotes much of its petition to exploring the Ninth Circuit’s purported “transmogrification” of the *Rogers* test over time from cases involving artistic works such as motion pictures and television shows to utilitarian items such as the dog toy at issue in *Jack Daniel’s*. Pet. at pp. 16–25. Petitioner argues based thereon that the instant petition should be treated as a “companion” to *Jack Daniel’s* or, alternatively, held pending the decision in that case.

Neither of the questions presented in *Jack Daniel’s* has any bearing on the correctness of the Ninth Circuit’s ruling in this case, and the instant petition should not be treated as a “companion” case. The first question presented in *Jack Daniel’s* is “[w]hether humorous use of another’s trademark as one’s own on a commercial product is subject to the Lanham Act’s traditional likelihood-of-confusion analysis, or instead receives heightened First Amendment



protection from trademark-infringement claims.” In marked contrast to the poop-themed dog toy at issue in *Jack Daniel’s*, this case involves alleged infringement in the context of a motion picture—a quintessentially artistic work that falls squarely within the First Amendment guarantee. Whether or not the Ninth Circuit’s embrace of First Amendment protection for the humorous use of another’s trademark on an ordinary consumer product is affirmed is of no consequence to the instant petition; the Ninth Circuit’s citation to *Jack Daniel’s* in its unpublished disposition in this case did not depend on *Jack Daniel’s* particular application of *Rogers* to consumer products, but rather incorporated its existing precedents generally applying *Rogers*. Pet. App. 2a. Petitioner’s claims here fail not under an arguable overextension of *Rogers* but instead under the *Rogers* test as it has consistently and uniformly been applied to artistic works by circuit courts for more than three decades.

The second question presented in *Jack Daniel’s* is wholly unrelated to any issue in this case. That question asks “[w]hether humorous use of another’s mark as one’s own on a commercial product is ‘noncommercial’ under 15 U.S.C. § 1125(c)(3)(C), thus barring as a matter of law a claim of dilution by tarnishment under the Trademark Dilution Revision Act.” The Ninth Circuit’s decision in the instant case did not turn on application of the Lanham Act’s protections against dilution. Indeed, the instant case does not involve a dilution claim at all.

Moreover, this case need not be held for *Rogers* because, as Respondents have argued throughout this case, Respondents would prevail under any legal standard. Even under the traditional likelihood-of-confusion factors,

the record overwhelmingly favors Respondents. There was zero evidence of actual confusion: in addition to putting forth no survey evidence, Petitioner put forth no evidence that any actual consumer had been confused, ever. After eleven years, this Court should end this litigation and deny certiorari.

Accordingly, the granting of the certiorari petition in *Jack Daniel's* neither supports review of the Ninth Circuit's ruling in this case nor provides any reason to hold the instant petition pending a decision in *Jack Daniel's*.

#### CONCLUSION

The petition for writ of certiorari should be denied.

Respectfully submitted,

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