

No. 20-365

IN THE
Supreme Court of the United States

JACK DANIEL'S PROPERTIES, INC.,
Petitioner,

v.

VIP PRODUCTS LLC,
Respondent.

**On Petition For A Writ Of Certiorari
To The United States Court Of Appeals
For The Ninth Circuit**

**BRIEF FOR CAMPARI AMERICA LLC
AS *AMICUS CURIAE*
IN SUPPORT OF PETITIONER**

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QUESTION ADDRESSED BY *AMICUS*

Whether the Ninth Circuit erred in concluding that an infringing use of a trademark, found likely to cause consumer confusion, is not actionable under the Lanham Act because it is minimally expressive.

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INTEREST OF *AMICUS CURIAE*¹

Campari America LLC is a wholly owned subsidiary of Davide Campari-Milano N.V., which, together with its affiliates in the Campari Group, comprise an international beverage powerhouse and the sixth largest player in the premium spirits industry. Its portfolio includes more than 50 of the world's most recognizable spirits brands, including Campari, Aperol, Grand Marnier, SKYY Vodka, and Wild Turkey Bourbon.

Like petitioner, Campari invests substantial sums in developing, maintaining, and protecting trademarks and trade dress for its iconic brands. And like petitioner, Campari has been victimized by respond-



¹ Pursuant to Rule 37.6, counsel for *amicus curiae* states that no counsel for a party authored this brief in whole or in part and no one other than *amicus* and its counsel made a monetary contribution to fund the preparation or submission of this brief. Pursuant to Rule 37.2, counsel for *amicus curiae* states that counsel for petitioner and respondent received timely notice of intent to file this brief, and each consented in writing to the filing of this brief.

ent’s crude and juvenile dog toys—which confuse consumers, dilute the value of the targeted brands, and infringe intellectual property rights.

Campari, through its trade associations, participated in and agrees with a separate brief highlighting how the Ninth Circuit’s decision impedes industry-wide efforts to combat underage drinking by restricting the use of their marks in products that are marketed to minors. *See* Alcohol Beverage Indus. Ass’n Br. at 7–15. Campari submits this brief to highlight a particularly problematic aspect of the Ninth Circuit’s decision—namely, the conclusion that junior users (i.e., infringers) categorically have greater First Amendment rights than senior users (i.e., trademark holders) of a mark. If left uncorrected, this analytical error could have dramatic repercussions for trademark holders like Campari, as well as for trademark law more generally.

INTRODUCTION AND SUMMARY OF ARGUMENT

Congress enacted the Lanham Act in 1946 to “mak[e] actionable the deceptive and misleading use of marks” in interstate commerce so as to “protect persons engaged in such commerce against unfair competition” and “prevent fraud and deception” of consumers. Lanham Act, Pub. L. No. 79-489, § 45, 60 Stat. 427, 444 (1946), *codified at* 15 U.S.C. § 1127. While the statute comprehensively addresses the field of trademark law, it did not strike new ground. On the contrary, “the purpose of the Lanham Act was to codify and unify the common law of unfair competition and

trademark protection” that existed since the Founding. *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 861 n.2 (1982) (White, J., concurring in the result).

At the heart of the Lanham Act is the prohibition on “false or misleading” use of a mark in a way that “is likely to cause confusion . . . as to the origin, sponsorship, or approval of [a person’s] goods, services, or commercial activities.” 15 U.S.C. § 1125(a)(1)(A). Notwithstanding this unambiguous statutory text, the Second Circuit has held that “First Amendment values” require that courts apply a different, more exacting standard when an infringer’s use of a protected mark is “expressive.” *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989). In particular, the court in *Rogers* construed the Lanham Act not to prohibit even plainly false and misleading expressive uses of another’s mark unless the use “has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the [use] explicitly misleads as to the source or the content of the work.” *Id.* at 999. The Ninth Circuit’s application of *Rogers* was dispositive in this case.

After conducting a four-day bench trial, the district court credited petitioner’s evidence showing that “approximately twenty-nine percent . . . of potential purchasers . . . are likely to be confused or deceived by the belief that Plaintiff’s Bad Spaniels dog toy is made or put out by Jack Daniel’s,” and that “such confusion is due in particular to Plaintiff’s use of Jack Daniel’s indicia or trade dress on the Bad Spaniels dog toy.” *VIP Prods., LLC v. Jack Daniel’s Prods., Inc.*, 291 F. Supp. 3d 891, 907 (D. Ariz. 2018) (omissions in original; quotation marks omitted). Because this is “nearly double the threshold to show infringement,”

the district court entered judgment for petitioner on its infringement claim. *Id.* at 908.

The Ninth Circuit did not disturb these factual findings. Rather, the court reasoned that “the Bad Spaniels dog toy, although surely not the equivalent of the *Mona Lisa*, is an expressive work” because it “communicates a ‘humorous message.’” *VIP Prods. LLC v. Jack Daniel’s Props., Inc.*, 953 F.3d 1170, 1175 (9th Cir. 2020). And “[b]ecause Bad Spaniels is an expressive work,” the Ninth Circuit concluded that “the district court erred in finding trademark infringement without first requiring [petitioner] to satisfy at least one of the two *Rogers* prongs.” *Id.* at 1175–76.

This Court should grant certiorari because *Rogers*, which the Ninth Circuit applied in this case, reflects an erroneous understanding of the First Amendment issues implicated in trademark infringement litigation. *Rogers* is premised on the assumption that a trademark holder’s use of a mark is always merely “commercial,” such that it is categorically inferior to an infringer’s use of the same mark if that use has any “expressive” component. Based on this assumption, *Rogers* employs a prophylactic rule to avoid even potential conflicts between the Lanham Act and the First Amendment.

But recent caselaw has made clear that a trademark holder’s marks often contain important expressive content of their own. *See, e.g., Matal v. Tam*, 137 S. Ct. 1744, 1763–64 (2017). And while that does not mean that an unauthorized user of a mark may *never* claim protection under the First Amendment, it shows that *Rogers*’s rule of constitutional avoidance is not properly calibrated. Instead, courts should evaluate

an alleged infringer’s First Amendment defense on a case-by-case basis. Unsurprisingly, this is something that the Lanham Act, grounded as it is in longstanding common law principles, already does through its likelihood-of-confusion test. After all, it is hornbook law that the First Amendment does not protect false or misleading speech.

Because the decision below implicates important issues at the intersection of free expression and commerce, and for all of the reasons set forth in the petition and the *amicus curiae* briefs in support thereof, the Court should grant the petition for a writ of certiorari.

ARGUMENT

I. TRADEMARKS ARE A POWERFUL FORM OF EXPRESSIVE SPEECH.

The Lanham Act defines a trademark as “any word, name, symbol, or device, or any combination thereof” that a person “use[s] in commerce . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others.” 15 U.S.C. § 1127. Although a trademark is distinguishable from other forms of speech by its commercial function, it is not limited to such a function. On the contrary, this Court recently recognized that by the time Congress enacted the Lanham Act in 1946, “trademark had expanded far beyond phrases that do no more than identify a good or service.” *Matal*, 137 S. Ct. at 1752. “Then, as now, trademarks often consisted of catchy phrases that convey a message.” *Id.*

The United States Patent and Trademark Office's trademark registration database is replete with registered trademarks that have clear political, social, or cultural content. These include:

- Make America Great Again (#5921166)
- Biden President (#6066842)
- Texans For Israel (#5877503)
- The Trayvon Martin Foundation (#5291191)
- Stand Up To Cancer (#6145543)
- Catholic Conscience (#5894048)
- Jews For Jesus (#3226873)
- Students For Liberty (#4223442)
- Social Justice Sewing Academy (#6124239)
- The She Jazz Project (#6154515)
- Latinx in AI (#5969540)

Each of these trademarks does far more than identify the source or origin of a good or service. Rather, they make an affirmative statement about the beliefs, values, and goals of the trademark holder.

Even trademarks that do not have overt expressive content may acquire such content. As one commentator has observed, Disney's "mouse ears certainly represent a vast commercial empire generally, and specifically operate as a functional trademark for Mickey Mouse cartoons and merchandise," but they also "represent something culturally—about childhood, about America, and about art—that is much more than merely a piece of commercial information."

Kristian D. Stout, *Terrifying Trademarks and a Scandalous Disregard for the First Amendment: Section 2(a)'s Unconstitutional Prohibition on Scandalous, Immoral, and Disparaging Trademarks*, 25 Alb. L.J. Sci. & Tech. 213, 243 (2015). Similarly, “[t]he mark of Levis on blue jeans meant something about American freedom and society during the Cold War that was much more than a mark guaranteeing the quality of a pair of pants.” *Id.* at 243–44. Other examples are not difficult to envision: From Coca-Cola to McDonald’s, Ford to Harley-Davidson, trademarks often—and often are intended to—evoke feelings of nostalgia, patriotism, and community, to say something about who we are and who we want to be.

This is to say nothing of the creative artistic expression often embodied in trademarks. Google’s name comes from “a play on the mathematic expression for the number 1 followed by 100 zeros and aptly reflected [founders] Larry and Sergey’s mission ‘to organize the world’s information and make it universally accessible and useful.’” Google, *From the Garage to the Googleplex*, <https://about.google/our-story/>. The company Groupon takes its name from a clever portmanteau of *group* and *coupon*, reflecting the company’s business model of offering “daily deals” for local businesses that are redeemable only if enough customers subscribe. See Annelise Schoups, *Why Is Groupon Called Groupon?*, *Rewind & Capture* (Feb. 21, 2016), <https://tinyurl.com/y56z472u>.

The same applies to trade dress. When Aperol was launched in 1919, it became an instant hit throughout Italy. Thanks to its unaltered name and recipe, Aperol is now synonymous with the Italian aperitivo cul-

ture—an association that is strengthened by the bottle’s label, color scheme, and bottle design, which employ an art nouveau style evocative of a carefree Italian summer day. See Natasha Frost, *As Aperol Spritz Fatigue Sets In, the Fight to Sell the Next Big Drink Is Already Underway*, Quartz (Oct. 30, 2019), <https://tinyurl.com/y6cwnbxk> (“Though the bottle’s label has gone through multiple iterations, it retains the same vintage feel and art nouveau sensibility of the original.”). This is important to the drink’s millions of consumers around the world, who view Aperol as “an important symbol for the Italian way of life, a signal to slow down and savor an aperitivo moment over food and drinks with family and friends.” Amanda Gabriele, *The Best Bars Around the World for an Aperol Spritz*, Travel + Leisure (July 30, 2019), <https://tinyurl.com/yyrkrqob>. Meanwhile, the label for Campari’s Espolon Tequila features artwork depicting scenes from Mexican history, specially commissioned to commemorate the country’s independence from Spain. See Steven Noble, *Espolon Tequila Packaging Illustrations*, <https://tinyurl.com/yy18ehgr>.



Campari's other brands embody very different marks and trade dress that convey very different messages. One does not need to be personally familiar with these products to know something about them—their distinctive designs convey a great deal of information to consumers before they even open a bottle:



This is the very point of branding: to use colors, shapes, and fonts—the tools of expression—to create a memorable “package” that allows consumers to quickly and reliably distinguish among products in a crowded marketplace. The ultimate goal may be commerce—but it is commerce *through* expression. And the information-signaling function of trademarks and trade dress has First Amendment as well as commercial value.

Trademarks can often serve an associational value as well. Indeed, in the case of not-for-profit organizations, this is often a primary function of trademarks. But even commercial trademarks have associ-

ational value. Using a Whole Foods reusable bag, donning a John Deere baseball cap, and wearing a pair of Toms shoes each acts as a signifier of social, cultural, or economic affiliation. This is becoming even more true as brands from Nike to Gillette invest more heavily in political and social issues. See Suzanne Kapner & Dante Chinni, *Are Your Jeans Red or Blue? Shopping America's Partisan Divide*, Wall St. J. (Nov. 19, 2019), <https://tinyurl.com/y3zwfjxh> (“Wrangler is popular in the cowboy counties of the West and Midwest while San Francisco-based Levi’s resonates more with city dwellers.”).

None of this has been lost on the courts. In considering whether the Lanham Act’s non-disparagement clause ran afoul of the First Amendment, Justice Kennedy, writing for four Justices, emphasized that “[i]n the realm of trademarks, the metaphorical marketplace of ideas becomes a tangible, powerful reality” in which “marks make up part of the expression of everyday life, as with the names of entertainment groups, broadcast networks, designer clothing, newspapers, automobiles, candy bars, toys, and so on.” *Matal*, 137 S. Ct. at 1768 (Kennedy, J., concurring in part and concurring in the judgment). Even not-for-profit organizations use trademarks “to compete in a real economic sense for funding and other resources as they seek to persuade others to join their cause.” *Id.* Justice Breyer reiterated the point a short time later, acknowledging that “[t]he Court has not decided whether the trademark statute is simply a method of regulating pure ‘commercial speech,’” but noting that there are “reasons for doubt on that score” in light of the fact that “[t]rademarks, after all, have an expressive component in addition to a commercial one, and

the statute does not bar anyone from speaking.” *Iancu v. Brunetti*, 139 S. Ct. 2294, 2305 (2019) (Breyer, J., concurring in part and dissenting in part).

Even the Ninth Circuit has recognized “the expressive value that some marks assume.” *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002). In this case, however, the same court gave no such recognition to the expressive content of petitioner’s trademarks, instead following a rule under which junior users—infringers—are automatically afforded *greater* protection under the First Amendment than senior users—the innovators and creators to whom the law affords intellectual property rights.

II. ROGERS DISREGARDS THE EXPRESSIVE CONTENT OF TRADEMARKS BY TREATING THEM AS MERELY COMMERCIAL SPEECH THAT IS CATEGORICALLY INFERIOR TO INFRINGERS’ EXPRESSIVE WORKS.

In *Rogers*, the Second Circuit construed the Lanham Act to not afford protection when the unauthorized use of a trademark appears in an expressive work, unless the mark “has no artistic relevance to the underlying work whatsoever” or the effect of the mark’s use is to “explicitly mislead[] as to the source or the content of the work.” 875 F.2d at 999. It adopted this heightened burden based on its belief that trademark law involves a direct tradeoff between the trademark holder’s commercial interest in its mark and the infringer’s expressive interest in its appropriation. So framed, the court concluded that the speech of the trademark holder must yield because it is merely commercial: “We believe that in general the 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.*; see also *Parks v. LaFace Records*, 329 F.3d 437, 450 (6th Cir. 2003) (adopting *Rogers* because it is “the most appropriate method to balance the public interest in avoiding consumer confusion with the public interest in free expression”); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1242 (9th Cir. 2013) (“The only relevant legal framework for balancing the public’s right to be free from consumer confusion . . . and EA’s First Amendment rights in the context of Brown’s § 43(a) claim is the *Rogers* test.”).

But *Rogers* rests on a false dichotomy. As detailed above, a trademark holder’s use of its mark is not strictly commercial, but often contains expressive content of its own. See *Harris v. Quinn*, 573 U.S. 616, 648 (2014) (“Our precedents define commercial speech as ‘speech that does no more than propose a commercial transaction.’”); *Bigelow v. Virginia*, 421 U.S. 809, 826 (1975) (“The relationship of speech to the marketplace of products or of services does not make it valueless in the marketplace of ideas.”). At the same time, even a purportedly “expressive” work by an infringer often is produced for commercial purposes—sometimes predominantly for commercial purposes, as in the case of respondent’s novelty dog toys. See *VIP Prods., LLC v. Jack Daniel’s Prods., Inc.*, 2016 WL 5408313, at *6 (D. Ariz. Sept. 27, 2016) (finding that respondent’s “adaptation of the Jack Daniel’s trademark and trade dress were engaged for the dual purpose of making an alleged expressive comment as well as the commercial selling of a non-competing product”).

Notably, many cases that follow *Rogers* recognize this. In *Rogers* itself, the Second Circuit acknowledged that “it is well established that where the title of a movie or book has acquired secondary meaning . . . the holder of the rights to that title may prevent the use of the same or confusingly similar titles by other authors,” noting that “it would be ironic if, in the name of the First Amendment, courts did not recognize the right of authors to protect titles of their creative work against infringement by other authors.” 875 F.2d at 998. And the Ninth Circuit has recognized the possibility that “the senior user and the junior user both use the mark in similar artistic expressions,” in which case “reflexively apply[ing] *Rogers*’s second prong” would put “an artist who uses a trademark to identify the source of his or her product . . . at a significant disadvantage in warding off infringement by another artist, merely because the product being created by the other artist is also ‘art.’” *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 270 (9th Cir. 2018). “That,” the Ninth Circuit realized, “would turn trademark law on its head.” *Id.*

These statements would seem to suggest that, at a minimum, *Rogers*’s categorical rule should not apply where a trademark holder’s use of its mark is also expressive. After all, *Rogers* is predicated on a presumptive “balancing” of the trademark holder’s interest in avoiding consumer confusion against the infringer’s interest in free expression, but where a trademark has expressive content, First Amendment interests must be counted on both sides of the ledger. In practice, however, *Rogers* shows no special solicitude for the free expression rights of trademark holders. Instead,

it proceeds from the mistaken belief that only infringing uses implicate First Amendment principles.

This is important because infringers almost always prevail under *Rogers*. See *Gordon*, 909 F.3d at 265 (“We have applied the *Rogers* test on five separate occasions, and each time we have concluded that it barred the trademark-infringement claim as a matter of law.”). While a trademark holder can theoretically overcome its heightened burden by showing that the use of its mark has no artistic relevance to the infringer’s work, “[t]he bar is set low: ‘the level of relevance merely must be above zero.’” *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1198 (9th Cir. 2017); see also *Parks*, 329 F.3d at 452–53 (concluding that the question whether the use of Rosa Parks’s name in a hip hop song that “[t]he composers did not intend . . . to be about Rosa Parks, and the lyrics [of which] are not about Rosa Parks” was “open to reasonable debate” and must be submitted to the jury) (emphases omitted). And while a trademark holder may also prevail by showing that the use of its mark is explicitly misleading, this requires “an explicit indication, overt claim, or explicit misstatement that cause[s] such consumer confusion.” *Twentieth Century Fox*, 875 F.3d at 1199 (quotation marks omitted). “It is well established that the use of a mark alone is not enough to satisfy this prong of the *Rogers* test.” *Brown*, 724 F.3d at 1245.

For this reason, *Rogers* has attracted considerable criticism. One leading treatise states: “In the author’s opinion, this test is incomplete and gives the false impression that the court always has its finger on the scales in favor of the junior user who produces an expressive work.” 2 J. Thomas McCarthy, *McCarthy on*

Trademarks and Unfair Competition § 10:17.10 (5th ed.). It should not be the case “that a junior user producer of an expressive work can ignore a senior user and create probable confusion just because the [work] has some ‘artistic relevance’ to the accused expressive work and the junior user does not falsely assert that there is an affiliation.” *Id.*

The Ninth Circuit clearly stacked the deck in favor of the infringer here. Without even considering the substantial expressive content of *petitioner’s* well-known and carefully curated trademarks and trade dress, the court concluded that *Rogers* applied because respondent’s jejune dog toy is an “expressive work” insofar as it “comments humorously on precisely those elements that Jack Daniels seeks to enforce here.” *VIP Prods.*, 953 F.3d at 1175. This is itself doubtful; while the Ninth Circuit has correctly observed that a work need not be “the expressive equal of *Anna Karenina* or *Citizen Kane*” to be expressive, it made that observation in discussing video games, which “[l]ike the protected books, plays, and movies that preceded them, . . . communicate ideas—and even social messages—through many familiar 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).” *Brown*, 724 F.3d at 1241 (brackets in original) (quoting *Brown v. Entm’t Merchs. Ass’n*, 564 U.S. 786, 790 (2011)). Respondent’s “Bad Spaniels” dog toy, by contrast, is nothing more than an overt rip-off of petitioner’s marks—even if the end result might be considered by some (but surely not all) to be “humorous.”

More to the point, however, the Ninth Circuit then concluded that the district court must ignore all evidence of consumer confusion until it determines whether petitioner has satisfied *Rogers* by showing that the use of its marks is not “artistically relevant” to respondent’s dog toy or that this use “explicitly misleads” consumers. See *VIP Prods.*, 953 F.3d at 1175–76 (“Because *Bad Spaniels* is an expressive work, the district court erred in finding trademark infringement without *first* requiring [petitioner] to satisfy at least one of the two *Rogers* prongs.”) (emphasis added); *id.* at 1176 n.2 (“If the plaintiff satisfies one of the *Rogers* elements, ‘it *still* must prove that its trademark has been infringed by showing that the defendant’s use of the mark is likely to cause confusion.’”) (emphases added). As discussed above, trademark holders will almost always fail to satisfy this onerous burden, no matter how plainly the infringement runs afoul of the Lanham Act’s likelihood-of-confusion test.

III. ROGERS UNDERMINES IMPORTANT FIRST AMENDMENT PRINCIPLES.

Of course, trademark infringers have First Amendment rights, and their free expression should not automatically yield to the interests of a trademark holder any more than the trademark holder’s free expression should automatically yield to the interests of the infringer. Indeed, it would be a marked departure from First Amendment jurisprudence if one party’s expressive speech could serve as a basis for silencing another party’s expressive speech. See *Red Lion Broad. Co. v. FCC*, 395 U.S. 367, 390 (1969) (“It is the purpose of the First Amendment to preserve an uninhibited marketplace of ideas in which truth will ulti-

mately prevail, rather than to countenance monopolization of that market, whether it be by the Government itself or a private licensee.”).

But crucially, *Rogers* is not limited to protecting an alleged infringer’s First Amendment rights. On the contrary, “*Rogers* employs the First Amendment as a rule of construction to avoid conflict between the Constitution and the Lanham Act.” *Gordon*, 909 F.3d at 264 (emphasis added); see also *Rogers*, 875 F.2d at 998 (“Because overextension of Lanham Act restrictions in the area of [expressive works] might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict.”). In other words, *Rogers* negates the protections afforded by the Lanham Act to avoid even potential conflicts with the First Amendment, with the result that at least some infringing uses of a protected mark will be permitted despite the fact that they are not in fact protected by the First Amendment. This prophylactic rule, which categorically privileges infringers over trademark holders, has no principled basis in the statute enacted by Congress.

As an initial matter, it is far from clear whether *Rogers*’s use of the canon of constitutional avoidance is proper. The canon “is a tool for choosing between competing plausible interpretations of a statutory text, resting on the reasonable presumption that Congress did not intend the alternative which raises serious constitutional doubts.” *Clark v. Martinez*, 543 U.S. 371, 381 (2005). But it may not be employed to give a statute an interpretation that is not supported by the text itself. See *United States v. Stevens*, 559 U.S. 460, 481 (2010) (“This Court may impose a limiting construction on a statute only if it is readily susceptible

to such a construction. We will not rewrite a law to conform it to constitutional requirements, for doing so would constitute a serious invasion of the legislative domain.”) (alterations, quotation marks, and citations omitted); *see also Iancu*, 139 S. Ct. at 2301 (declining to adopt a limiting construction of the Lanham Act where the statutory text “stretches far beyond the Government’s proposed construction”).

Nothing in the text of the Lanham Act supports *Rogers*’s two-tiered framework for evaluating unauthorized use of a mark based on how the mark is used by the alleged infringer. On the contrary, the statute clearly establishes a single standard that is applicable to all unauthorized uses: “Any person who . . . uses in commerce . . . any false designation of origin . . . which is likely to cause confusion . . . shall be liable in a civil action.” 15 U.S.C. § 1125(a)(1)(A) (emphases added). Nor does the Lanham Act say anything about the “artistic relevance” of an infringing use or whether that use is “explicitly misleading.” These aspects of *Rogers* are wholly atextual.

The prophylactic rule embodied in *Rogers* is particularly concerning because the Lanham Act *already* ensures that an unauthorized use of a mark will not support liability when the use is protected by the First Amendment. As noted, the Lanham Act prohibits only “false” designations that are “likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association . . . as to the origin, sponsorship, or approval of [an infringer’s] goods, services, or commercial activities.” 15 U.S.C. § 1125(a)(1)(A). And it is well established that “the knowingly false state-

ment and the false statement made with reckless disregard of the truth, do not enjoy constitutional protection.” *Garrison v. Louisiana*, 379 U.S. 64, 75 (1964).

Even those courts that follow *Rogers* recognize that its dual requirements that an infringing use must be “false” and “likely to confuse” ensures that protected expression will not be penalized. *See, e.g., Mattel*, 296 F.3d at 900 (“Our likelihood-of-confusion test generally strikes a comfortable balance between the trademark owner’s property rights and the public’s expressive interests.”) (citation omitted); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996) (noting that “[t]rademark . . . ha[s] built-in mechanisms that serve to avoid First Amendment concerns”). Nevertheless, they deem a heightened standard necessary where the unauthorized use is expressive. *See Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 672 (5th Cir. 2000) (acknowledging that, “[l]ike fraudulent speech, speech that misleads or creates confusion is not protected under the First Amendment,” but concluding that “[w]here the allegedly infringing speech is at least partly literary or artistic, . . . and not solely a commercial appropriation of another’s mark, the preferred course is to accommodate trademark remedies with First Amendment interests”).

But the expressive nature of a false and misleading work makes no difference to the First Amendment analysis. On the contrary, “[u]ntruthful speech, commercial or otherwise, has never been protected for its own sake.” *Va. State Bd. of Pharm. v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 771 (1976); *see also Brown v. Hartlage*, 456 U.S. 45, 60 (1982) (“[D]emonstrable falsehoods are not protected by the First

Amendment in the same manner as truthful statements.”); *Herbert v. Lando*, 441 U.S. 153, 171 (1979) (“Spreading false information in and of itself carries no First Amendment credentials.”); *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 340 (1974) (“[T]here is no constitutional value in false statements of fact.”).

To be sure, this Court recently qualified the above statements, observing that they “all derive from cases discussing defamation, fraud, or some other legally cognizable harm associated with a false statement, such as an invasion of privacy or the costs of vexatious litigation,” and thus do not “endorse[] a categorical rule . . . that false statements receive no First Amendment protection.” *United States v. Alvarez*, 567 U.S. 709, 719 (2012). But like defamation and fraud, trademark infringement also causes “some other legally cognizable harm” both to trademark holders and consumers. And like those causes of action, the common law has recognized trademark infringement as a basis for civil liability since before the enactment of the First Amendment. “Trademarks and their precursors have ancient origins, and trademarks were protected at common law and in equity at the time of the founding of our country.” *Matal*, 137 S. Ct. at 1751; *see also* 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 5:2 (5th ed.) (“By 1783, Lord Mansfield could state that ‘if the defendant had sold a medicine of his own under the plaintiff’s name or mark, that would be a fraud for which an action would lie.”) (citing *Singleton v. Bolton*, 99 Eng. Rep. 661 (K.B. 1783)).

The effect of *Rogers*, then, is to invoke the First Amendment to protect infringers’ appropriation of a

protected mark, long understood to fall outside its ambit, at the expense of trademark holders, whose marks and trade dress often have important political, social, cultural, or associational value to the trademark holders themselves as well as the public more generally. This not only “turn[s] trademark law on its head,” *Gordon*, 909 F.3d at 270; it turns the First Amendment on its head, as well.

Respondent is not creating museum pieces. Its “Silly Squeakers” line of dog toys transparently trades on the value of brands that petitioner, *amicus*, and others have spent a great deal of time and money creating. *See My Dog Toy, Silly Squeakers*, <https://mydogtoy.com/silly-squeaker>. To suggest that these trinkets are more expressive—or more entitled to First Amendment protection—than the iconic marks they emulate has no foundation in the facts of this case or common sense.

In these circumstances, there can be no doubt that the traditional likelihood-of-confusion balancing test under the Lanham Act is more than adequate to address and protect the rights of both the senior user and the junior user. The district court conducted that weighing and found that petitioner prevailed. The Ninth Circuit second-guessed that decision only by applying *Rogers* to insist that the First Amendment tips the balance—apparently always—in favor of the infringer. That approach should be reviewed, and rejected, by this Court.

CONCLUSION

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

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