

No. 20-365

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In The  
**Supreme Court of the United States**

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JACK DANIEL'S PROPERTIES, INC.,

*Petitioner,*

v.

VIP PRODUCTS LLC,

*Respondent.*

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

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**BRIEF OF CONSTELLATION BRANDS, INC. AS  
AMICUS CURIAE IN SUPPORT OF PETITIONER**

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## **QUESTIONS PRESENTED**

Respondent VIP Products LLC's business model is based on marketing and selling dog toys that intentionally use trademarks and trade dress of well-known companies in a way that courts have deemed likely to confuse consumers about the source of the toys and to tarnish the reputation of such companies, including petitioner Jack Daniel's Properties, Inc.

The questions presented are:

1. Whether a commercial product using humor is subject to the same likelihood-of-confusion analysis applicable to other products under the Lanham Act, or must receive heightened First Amendment protection from trademark-infringement claims, where the brand owner must prove that the defendant's use of the mark either is "not artistically relevant" or "explicitly misleads consumers."

2. Whether a commercial product's use of humor renders the product "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 Lanham Act.

TABLE OF CONTENTS

	Page
QUESTIONS PRESENTED .....	i
INTEREST OF <i>AMICUS CURIAE</i> .....	1
SUMMARY OF ARGUMENT .....	2
ARGUMENT .....	4
I. The Ninth Circuit’s decision undermines companies’ significant investments in their branded products, thwarting the purpose of the Lanham Act .....	4
A. Constellation carefully crafts and maintains its brands .....	5
B. The Ninth Circuit’s decision threatens Constellation’s customer goodwill and growth strategy by preventing the company from controlling the commercial products associated with its brands.....	8
II. The commercial-speech doctrine fully resolves the questions presented in this case ...	11
A. The Ninth Circuit erred by not considering this case under existing commercial-speech doctrine .....	12
B. The Lanham Act’s likelihood-of-confusion requirement limits trademark-infringement liability to commercial speech that is misleading and thus not protected by the First Amendment.....	14
CONCLUSION.....	18

## TABLE OF AUTHORITIES

	Page
CASES	
<i>American Soc’y for Testing &amp; Materials v. Public Res. Org., Inc., 896 F.3d 437 (D.C. Cir. 2018)</i> .....	16
<i>AMF Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979)</i> .....	16
<i>B&amp;B Hardware, Inc. v. Hargis Indus., Inc., 575 U.S. 138 (2015)</i> .....	4
<i>Board of Trustees of State Univ. of New York v. Fox, 422 U.S. 469 (1989)</i> .....	13, 14
<i>Bolger v. Youngs Drug Prods. Corp., 463 U.S. 60 (1983)</i> .....	12, 14
<i>Central Hudson Gas &amp; Elec. Corp. v. Pub. Ser. Comm’n of New York, 447 U.S. 557 (1980)</i> .....	12, 13
<i>ConAgra, Inc. v. George A. Hormel &amp; Co., 990 F.2d 368 (8th Cir. 1993)</i> .....	16
<i>Dreamwerks Prod. Grp., Inc. v. SKG Studio, 142 F.3d 1127 (9th Cir. 1998)</i> .....	16
<i>General Motors Corp. v. Urban Gorilla, LLC, 500 F.3d 1222 (10th Cir. 2007)</i> .....	16
<i>Georgia-Pacific Consumer Prods. LP v. Four-U-Packaging, Inc., 701 F.3d 1093 (6th Cir. 2012)</i> .....	16
<i>Herbko Int’l, Inc. v. Kappa Books, Inc., 308 F.3d 1156 (Fed. Cir. 2002)</i> .....	16

## TABLE OF AUTHORITIES—Continued

	Page
<i>In re R.M.J.</i> , 455 U.S. 191 (1982) .....	15, 17
<i>Matal v. Tam</i> , 137 S. Ct. 1744 (2017) .....	4
<i>Park ‘N Fly, Inc. v. Dollar Park &amp; Fly, Inc.</i> , 469 U.S. 189 (1985) .....	5
<i>Polaroid Corp. v. Polarad Elecs. Corp.</i> , 287 F.2d 492 (2d Cir. 1961) .....	16
<i>Rogers v. Grimaldi</i> , 875 F.2d 994 (2d Cir. 1989) .....	13
<i>Sabinsa Corp. v. Creative Compounds, LLC</i> , 609 F.3d 175 (3d Cir. 2010) .....	16
<i>Smith Fiberglass Prods., Inc. v. Ameron, Inc.</i> , 7 F.3d 1327 (7th Cir. 1993).....	16
<i>Tana v. Dantanna’s</i> , 611 F.3d 767 (11th Cir. 2010).....	16
<i>The Shell Co. (P.R.) Ltd. v. Los Frailes Serv. Station, Inc.</i> , 605 F.3d 10 (1st Cir. 2010) .....	16
<i>Variety Stores, Inc. v. Wal-Mart Stores, Inc.</i> , 888 F.3d 651 (4th Cir. 2018).....	15
<i>VIP Products LLC v. Jack Daniel’s Properties, Inc.</i> , 953 F.3d 1170 (9th Cir. 2020).....	1

## TABLE OF AUTHORITIES—Continued

	Page
<i>Virginia State Bd. of Pharmacy v. Virginia Citizens Consumers Council, Inc., 425 U.S. 748 (1976)</i> .....	12, 14, 15
<i>Xtreme Lashes, LLC v. Xtended Beauty, Inc., 576 F.3d 221 (5th Cir. 2009)</i> .....	16
 FEDERAL STATUTES	
15 U.S.C. § 1125(a)(1) .....	2
15 U.S.C. § 1125(a)(1)(A) .....	15
15 U.S.C. § 1125(c) .....	2, 13
15 U.S.C. § 1127 .....	4

**INTEREST OF *AMICUS CURIAE*<sup>1</sup>**

Founded in 1945 in upstate New York, Constellation Brands, Inc. (“Constellation”) is a market leader in consumer-packaged brands. Constellation has achieved its renowned position by creating powerhouse brands and delivering best-in-class customer experiences and products. Among many other beers, wines, and spirits, Constellation’s portfolio includes Corona, Pacifico, Modelo Especial, Robert Mondavi, Kim Crawford, Meiomi, The Prisoner, Svedka Vodka, and High West Whiskey. Each of these products embodies Constellation’s mission: build brands that people love.

Constellation has a significant interest in this case because the Ninth Circuit’s decision in *VIP Products LLC v. Jack Daniel’s Properties, Inc.*, 953 F.3d 1170 (9th Cir. 2020), risks an endless stream of third-party products that infringe or dilute with impunity the brands that make up Constellation’s portfolio. Unless certiorari is granted, third-party sellers of indisputably commercial products will be able to trade on Constellation’s hard-won reputation by simply marketing their products as “humorous” derivatives of Constellation’s famous trademarks. At least in the Ninth

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<sup>1</sup> No counsel for a party authored this brief in whole or in part, and no person other than Constellation, its members, or its counsel made a monetary contribution intended to fund the preparation or submission of this brief. Counsel of record for the parties received timely notice of Constellation’s intent to file this brief under Rule 37(2)(a). All counsel consented to the filing of the brief.

Circuit, Constellation will be unable to obtain injunctive relief to stop such products under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), since self-described “humorous” products have been found to be “noncommercial” as a matter of law. Pet. App. 13a. And third-party sellers will likely escape monetary liability for trademark infringement because Constellation will be forced to jump through additional constitutional hoops in order to obtain relief under Section 43(a)(1) of the Lanham Act, 15 U.S.C. § 1125(a)(1). Pet. App. 12a. Left uncorrected, the decision below invites trademark infringers in the United States to swiftly file declaratory judgment actions in the Ninth Circuit to validate their infringement—just as Respondent did here. *Id.* at 6a.

This Court should grant certiorari to restore the proper interpretation of the Lanham Act before the meticulous investments by trademark owners like Constellation are further undermined.

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### SUMMARY OF ARGUMENT

Congress enacted the Lanham Act specifically to protect consumers from being misled and to protect companies like Constellation that have made significant investments building consumer goodwill around their trademarks. A major aim of trademark protection is to prevent third-party companies from ripping off a company’s trademarks for their own profit in a way that misleads consumers or that will injure the

goodwill of the trademark owner. The district court, sitting as the trier of fact, found that that is precisely what happened in this case. In vacating the district court's well-reasoned decision, the Ninth Circuit flouted this Court's precedent and Congress's purpose in adopting the Lanham Act. Unless the decision below is reversed, companies like Constellation likely will be unable to stop third-party companies from causing consumer confusion through infringing or diluting their trademarks, and from recovering for injury caused by trademark misuse so long as the third-party company can bring suit in the Ninth Circuit. This Court should end such forum shopping before it proliferates and vindicate Congress's intent in enacting the Lanham Act.

Petitioner ably explains the many flaws in the Ninth Circuit's decision. One error, however, is particularly glaring. The Ninth Circuit misunderstood the relevant First Amendment standard, believing incorrectly that this case does not involve commercial speech. That conclusion is confounding, given that respondent advertises and markets its dog toy *to make money*. Its business is lucrative, extending beyond pirating petitioner's marks. Several of respondent's dog toys infringe on Constellation's trademarks as well. And those toys have sold so well that respondent's inventory appears to be currently sold out. This is neither political speech nor commentary.

Viewing the issue here through a commercial-speech lens, the Lanham Act fully accounts for any First Amendment concerns. Whenever a court finds a

likelihood of confusion under the Lanham Act, as the district court did in this case, the commercial speech at issue is necessarily misleading and therefore not protected by the First Amendment.

The petition for writ of certiorari should be granted. Indeed, the Court may wish to summarily reverse in light of the Ninth Circuit’s clear error. *See* Pet. 36.

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## ARGUMENT

### **I. The Ninth Circuit’s decision undermines companies’ significant investments in their branded products, thwarting the purpose of the Lanham Act.**

Trademarks “ha[ve] a long history” of protection “going back at least to Roman times.” *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015). “The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan’s goods from those of others.” *Id.*; *see also* 15 U.S.C. § 1127 (similar standard for registration of a mark). Put differently, “[a] trademark ‘designate[s] the goods as the product of a particular trader’ and ‘protect[s] his good will against the sale of another’s product as his.’” *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (quoting *U.S. Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918)) (emphases added). Congress codified those longstanding legal principles in the Lanham Act,

“provid[ing] national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.” *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) (citing S. Rep. No. 1333).

The Ninth Circuit discounted that well-established history and the purpose of the Lanham Act based on its incorrect view of what constitutes an “expressive work” protected under the First Amendment. *See infra* Part II. Constellation’s experience provides a concrete example of the impact that the Ninth Circuit’s erroneous decision will have on consumer brands in the United States.

**A. Constellation carefully crafts and maintains its brands.**

With more than \$8 billion in sales, Constellation is the fastest-growing large company in consumer package goods. Constellation has achieved its success by being “consumer obsessed,” which means that (1) business decisions are made by focusing on what consumers want and why they want it; (2) consumer insights and trends are carefully tracked; and (3) everyone in the company understands the relevant trends and empathizes with the company’s consumers.

Careful and consistent focus on building consumer loyalty and goodwill plainly works. For the 2020 fiscal year, Corona was the #1 imported beer brand family in

the United States, and Modelo Especial was the fastest growing non-seltzer beer brand in the industry.<sup>2</sup>

Constellation achieved that growth in part by intentionally crafting its brand images to ensure that each brand targets identified consumer interests. For example, the mottos and themes for the company's major beer brands are tellingly distinct:

- Corona: known worldwide for its affiliation with the beach, Corona encourages consumers to relax responsibly while enjoying the product.
- Pacifico: born in Mazatlán, Mexico and discovered in Baja by a group of California surfers, Pacifico is a symbol of discovery and the perfect way to celebrate it—live on land, live on water.
- Modelo Especial: brewed with the fighting spirit since 1925 and celebrating Mexican culture, Modelo Especial is made for those who know that hard work deserves a fitting reward.

Those intentional brand differences result in particularized licensing strategies linked directly to the brand. The tailored products offered in the “official” stores for the brands confirms the point:

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<sup>2</sup> <https://companyprofile.cbrands.com/daring-vision> (last visited Oct. 15, 2020).

- Corona: sunglasses, a beach cruiser bicycle, an “ocean bottle,” Vineyard Vines t-shirts, and an insulated cooler;<sup>3</sup>
- Pacifico: a “Grizzly Cooler,” beach towels, a “retro cruiser” bicycle, water bottle, and straw hat;<sup>4</sup> and
- Modelo Especial: t-shirts, windbreakers, varsity jacket, hat, sandals, cornhole game, papel picado for Día de Muertos, and a duffel bag.<sup>5</sup>

In short, each brand has a specific identity that Constellation cultivates by limiting brand licensing to only a handful of carefully selected product categories that are intended to build on the brand’s motto and theme.

Constellation’s strategy and focus on its consumers has paid off. Total net sales in fiscal year 2020 for the Corona brand was approximately \$2.07 billion; the Modelo Especial brand was approximately \$2.22 billion; and the Pacifico brand was approximately \$187.19 million.<sup>6</sup>

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<sup>3</sup> <https://www.coronausastore.com/Main/Default> (last visited Oct. 15, 2020).

<sup>4</sup> <https://www.pacificousastore.com/Main/Default> (last visited Oct. 15, 2020).

<sup>5</sup> <https://www.modelousastore.com/Main/Default> (last visited Oct. 15, 2020).

<sup>6</sup> Beer sales information is for the United States.

**B. The Ninth Circuit’s decision threatens Constellation’s customer goodwill and growth strategy by preventing the company from controlling the commercial products associated with its brands.**

Despite Constellation’s hard work growing its brands’ reputations with consumers, the Ninth Circuit appears to believe that third-party companies have a First Amendment right to rip off these established brands in order to sell their own commercial products. *See* Pet. App. 5a (“[B]ecause the Bad Spaniels dog toy is an expressive work entitled to First Amendment protection, we reverse the district court’s judgment. . .”). The Ninth Circuit’s holding is wrong for the reasons given in the petition, Pet. 30–37, and below, *see infra* Part II. But more importantly at this stage, the Ninth Circuit’s error threatens severe harm to companies’ trademark and branding interests by causing confusion among consumers as well as injury to their goodwill.

To begin, respondent in this case is not a small time business that accidentally stumbled into a conflict with Jack Daniel’s. Respondent’s entire business model is parasitic—appropriating other companies’ famous brands. Constellation’s products are no exception. Respondent currently offers unlicensed, commercial dog-toy products that directly mislead consumers

about Constellation's products, including Corona ("Cataroma"):<sup>7</sup>



And Pacifico ("Pawschitingo" and "Pawsifico"):<sup>8</sup>



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<sup>7</sup> Product available here: <https://mydogtoy.com/p/Silly-Squeaker-Beer-Bottle-Cataroma> (last visited Oct. 15, 2020).

<sup>8</sup> Products available: <https://mydogtoy.com/p/Silly-Squeaker-Beer-Bottle-PawsChitnGo> (last visited Oct. 15, 2020); <https://mydogtoy.com/p/Silly-Squeaker-Beer-Can-Pawsifico-Perro> (last visited Oct. 15, 2020).



Respondent's use of Constellation's Corona and Pacifico trademarks and trade dress plainly is lucrative—some of those products were entirely sold out when this brief was prepared.

And respondent is not the only opportunist seeking to pirate Constellation's trademarks. A cursory search of independent sales platforms like Etsy.com yields a fleet of unlicensed commercial products that undermine Constellation's careful branding and licensing strategy. Most troubling, some of these infringing products expressly link Corona with children:



Constellation does not license alcohol-based products that target children or otherwise encourage underage drinking. Indeed, the company forbids any use of its marks for such purposes. Constellation also avidly seeks to stop infringing activity, spending more than \$2 million on enforcement actions in the last two years. But according to the Ninth Circuit, it is the third-party sellers—as opposed to Constellation—whose rights must be protected simply because they are purporting to convey a “humorous message” in hawking their commercial products. Pet. App. 13a; *accord id.* at 12a.

The Ninth Circuit’s approach has no basis in law and is fundamentally inconsistent with the Lanham Act. *See* Pet. 17, 32–36. Unless addressed by this Court, Constellation and other companies will be at the mercy of so-called “humorous” infringing products—at least for any seller that can manufacture jurisdiction in the Ninth Circuit—no matter how severely it undermines consumer goodwill, brand value, or corporate reputation.

## **II. The commercial-speech doctrine fully resolves the questions presented in this case.**

Given the split of authority and significant importance of the questions presented, *see* Pet. 17–30, certiorari is plainly warranted and the petition should be granted. The ultimate resolution of the case, however, does not require this Court to adopt any new legal rules about trademark law or the First Amendment.

Settled principles under the commercial-speech doctrine resolve this case. Indeed, because settled precedent controls the outcome here, summary resolution is entirely appropriate. *See* Pet. 36.

**A. The Ninth Circuit erred by not considering this case under existing commercial-speech doctrine.**

No one disputes that the First Amendment applies to commercial transactions. “Speech . . . is protected even though it is carried in a form that is ‘sold’ for profit.” *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumers Council, Inc.*, 425 U.S. 748, 761 (1976) (citation omitted). But so-called “commercial speech” is treated differently under the Constitution than non-commercial speech. *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 64–65 (1983) (“the Constitution accords less protection to commercial speech than to other constitutionally safeguarded forms of expression”). As this Court explained in *Central Hudson Gas & Elec. Corp. v. Pub. Ser. Comm’n of New York*, “a four-part analysis” applies when addressing commercial speech under the First Amendment:

At the outset, [the Court] must determine whether the expression is protected by the First Amendment. For commercial speech to come within that provision, it at least must concern lawful activity and *not be misleading*. Next, we ask whether the asserted governmental interest is substantial. If both inquiries yield positive answers, [the Court] must

determine whether the regulation directly advances the governmental interest asserted, and whether it is not more extensive than is necessary to serve that interest.

447 U.S. 557, 566 (1980) (emphasis added).

To the extent the Ninth Circuit (or respondent) saw First Amendment issues in this case, it should have found the governing standard in *Central Hudson*, not *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). The Ninth Circuit never even mentioned *Central Hudson*. Perhaps the court thought this case was about something other than commercial speech. In addressing the trademark-dilution claim under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), the court said that respondent's product was "noncommercial" because "it does more than propose a commercial transaction" since it is "used to convey a humorous message." Pet. App. 13a. Although not explicitly addressing the First Amendment, the court nevertheless relied on commercial-speech case law to reach that conclusion. *Id.* (quoting *Nissan Motor Co. v. Nissan Comput. Corp.*, 378 F.3d 1002, 1017 (9th Cir. 2004); *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 906 (9th Cir. 2002)).

But the Ninth Circuit's conclusion was wrong. This Court's binding precedent establishes beyond doubt that the sale of humorous dog toys intentionally designed to look like a famous product constitutes a form of commercial speech. In *Board of Trustees of State Univ. of New York v. Fox*, 422 U.S. 469 (1989), this Court concluded that "Tupperware parties" are a form

of commercial speech because the point of the parties is to “propose a commercial transaction.” *Id.* at 473 (quoting *Virginia State Bd. of Pharmacy*, 425 U.S. at 762). As the Court explained, “communications can ‘constitute commercial speech *notwithstanding the fact that they contain discussions of important public issues.*’” *Id.* (quoting *Bolger*, 463 U.S. at 67–68) (emphasis added).

The Ninth Circuit thus erred when it found, as a matter of law, that humorous products are *always* non-commercial. Pet. App. 13a. Respondent’s *raison d’être* is to sell products for profit, regardless of how many scatological chuckles it may induce along the way. Respondent designed a product it thought was humorous with the principal aim of selling it to customers to make money. That is the hallmark of commercial speech, and it required the Ninth Circuit to consider any First Amendment issues under *Central Hudson*.<sup>9</sup>

**B. The Lanham Act’s likelihood-of-confusion requirement limits trademark-infringement liability to commercial speech that is misleading and thus not protected by the First Amendment.**

Applying the proper framework, this is one of the rare cases that fails at the first step of *Central Hudson*:

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<sup>9</sup> Because the Ninth Circuit relied exclusively on commercial-speech case law to interpret the Lanham Act, a finding by this Court that the dog toy at issue constitutes commercial speech would require reversal on the second question presented.

respondent's product is misleading and therefore not protected by the First Amendment. Put simply, "there can be no constitutional objection to the suppression of commercial messages that do not accurately inform the public about lawful activity." *Central Hudson*, 447 U.S. at 563; *accord Virginia State Bd. of Pharmacy*, 425 U.S. at 771. "The government may ban forms of communication more likely to deceive the public than to inform it." *Central Hudson*, 447 U.S. at 563; *see also In re R.M.J.*, 455 U.S. 191, 203 (1982) ("Misleading advertising may be prohibited entirely."). Because the Lanham Act already requires a product to be misleading before trademark-infringement liability may be imposed, the Ninth Circuit erred by grafting a separate First Amendment inquiry onto the analysis.

Under 15 U.S.C. § 1125(a)(1)(A), liability for trademark infringement attaches only when a person

uses in commerce any word, term, name, symbol, or device, or combination thereof . . . which is *likely to cause confusion*, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.

(emphasis added). To determine whether a particular use "is likely to cause confusion" under the Lanham Act, every circuit court uses essentially the same multi-factor balancing test. *E.g.*, *Variety Stores, Inc. v. Wal-Mart Stores, Inc.*, 888 F.3d 651, 660 (4th Cir. 2018);

*Georgia-Pacific Consumer Prods. LP v. Four-U-Packaging, Inc.*, 701 F.3d 1093, 1100–01 (6th Cir. 2012); *The Shell Co. (P.R.) Ltd. v. Los Frailes Serv. Station, Inc.*, 605 F.3d 10, 21 n.9 (1st Cir. 2010); *Sabinsa Corp. v. Creative Compounds, LLC*, 609 F.3d 175, 182 (3d Cir. 2010); *Tana v. Dantanna’s*, 611 F.3d 767, 774–75 (11th Cir. 2010); *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 227 (5th Cir. 2009); *General Motors Corp. v. Urban Gorilla, LLC*, 500 F.3d 1222, 1227 (10th Cir. 2007); *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164 (Fed. Cir. 2002); *Smith Fiberglass Prods., Inc. v. Ameron, Inc.*, 7 F.3d 1327, 1329 (7th Cir. 1993); *ConAgra, Inc. v. George A. Hormel & Co.*, 990 F.2d 368, 369–70 (8th Cir. 1993); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961) (Friendly, J.); *see also American Soc’y for Testing & Materials v. Public Res. Org., Inc.*, 896 F.3d 437, 456 (D.C. Cir. 2018) (“Although our court has yet to opine on the precise factors courts should consider when assessing likelihood of confusion, our sister circuits have adopted similar multi-factor tests, all of which ‘owe their origin to the 1938 Restatement of Torts.’”) (citation omitted).

The Lanham Act’s likelihood-of-confusion requirement ensures that a party’s First Amendment rights are protected in every case that involves a commercial product. Before liability may be imposed, courts must determine “whether a ‘reasonably prudent consumer’ in the marketplace is likely to be confused as to the origin of the good or service bearing one of the marks.” *Dreamwerks Prod. Grp., Inc. v. SKG Studio*, 142 F.3d

1127, 1129 (9th Cir. 1998). A product that likely confuses “reasonably prudent consumers” plainly is “more likely to deceive the public than inform it” and thus is not protected speech under the First Amendment. *Central Hudson*, 447 U.S. at 563.

The district court’s thorough analysis in this case demonstrates how this test works in practice and shows how careful courts have been before concluding that speech is likely to cause confusion. Pet. App. 42a–55a. This type of detailed, fact-specific approach is exactly what this Court has said is required when dealing with restrictions on commercial speech. “[A]bsolute prohibition[s] on certain types of potentially misleading information” are not permissible “if the information also may be presented in a way that is not deceptive.” *See In re R.M.J.*, 455 U.S. at 203. Congress complied with that rule by including the likelihood-of-confusion requirement in the Lanham Act. Applying that rule and following settled law fully addresses any First Amendment concerns.

In short, respondent is free to make humorous dog toys—respondent just cannot claim protection under the First Amendment when it misleads consumers into thinking that its products are affiliated with or authorized by the trademarks’ owners.



**CONCLUSION**

The petition for writ of certiorari should be granted.

Respectfully submitted,

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