

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

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**AMICUS CURIAE BRIEF OF THE INTERNATIONAL  
TRADEMARK ASSOCIATION IN SUPPORT  
OF PETITIONER**

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***AMICUS CURIAE* BRIEF OF THE  
INTERNATIONAL TRADEMARK  
ASSOCIATION IN SUPPORT OF PETITIONER**

The International Trademark Association (“INTA”) submits this brief in support of the petition for certiorari by Jack Daniel’s Properties, Inc. (“JDPI”).<sup>1</sup>

**INTEREST OF *AMICUS CURIAE***

Founded in 1878 as the United States Trademark Association, INTA is a not-for-profit organization dedicated to the advancement of trademarks and related intellectual property concepts as essential elements of trade and commerce. INTA has more than 7,200 member organizations from 191 countries, including trademark owners, law firms, and other professionals who assist brand owners in the creation, registration, protection, and enforcement of trademarks. INTA’s members share the goal of promoting the essential role that trademarks play in fostering informed decisions by consumers and fair competition.

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<sup>1</sup> Both parties received notice of INTA’s intent to file an *amicus* brief more than 10 days prior to the filing deadline, and both parties consented. S. Ct. R. 37.2(a). This brief was authored solely by INTA and its counsel. No party or counsel for a party, and no person other than INTA and its counsel, made a monetary contribution intended to fund the preparation or submission of this brief. S. Ct. R. 37.6.

INTA's members frequently are plaintiffs, defendants, and advisors in legal actions under the Lanham Act. INTA is interested in the development of clear, consistent, and equitable principles of trademark law. INTA has substantial expertise. It has participated as *amicus curiae* in numerous cases on significant Lanham Act issues, including on the First Amendment.<sup>2</sup>

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<sup>2</sup> Cases in which INTA has filed amicus briefs include: *U.S. Patent & Trademark Office v. Booking.com B.V.*, 140 S. Ct. 2298 (2020); *Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S. Ct. 1492 (2020); *Peter v. NantKwest, Inc.*, 140 S. Ct. 365 (2019); *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019); *Mission Prod. Holdings, Inc. v. Tempnology, LLC*, 139 S. Ct. 1652 (2019); *Matal v. Tam*, 137 S. Ct. 1744 (2017); *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907 (2015); *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293 (2015); *Pom Wonderful LLC v. Coca-Cola Co.*, 134 S. Ct. 2228 (2014); *Already, LLC v. Nike, Inc.*, 568 U.S. 85 (2013); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003); *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000); *LTTB LLC v. Redbubble, Inc.*, No. 19-16464 (9th Cir. pending); *Ohio State Univ. v. Redbubble, Inc.*, Case No. 19-3388 (6th Cir. pending); *JDPI v. VIP Products*, Case No. 18-16012 (9th Cir. June 3, 2020) (denying rehearing); *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012); *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144 (4th Cir. 2012); *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958 (9th Cir. 2011) (on rehearing); *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 633 F.3d 1158 (9th Cir. 2011) (on rehearing); *Chloe v. Queen Bee of Beverly Hills, LLC*, 616 F.3d 158 (2d Cir. 2010); *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009); *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135 (2d Cir. 2007), *certified questions accepted*,

INTA was founded in part to encourage enactment of federal trademark legislation after the invalidation on constitutional grounds of the United States' first trademark act. Since then, INTA has provided recommendations and assistance to legislators in connection with almost all major federal trademark legislation, including the Lanham Act and the Trademark Dilution Revision Act ("TDRA"), both of which are at issue in this appeal.

Trademark law is about protecting consumers. Trademarks help consumers know where their products and services are coming from. Trademarks are crucial indicators of source and quality that facilitate reliable and efficient purchasing decisions.

INTA's principal interest in this case is in promoting the appropriate balance between trademark law and the First Amendment. INTA members are sometimes plaintiffs in trademark cases, and sometimes defendants. In parody cases, INTA members are sometimes the parodist and sometimes the parodied. INTA therefore does not approach this case with any bias for or against parody.

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870 N.E.2d 151 (N.Y. 2007), *cert. denied*, 552 U.S. 827 (2007), *certified questions answered*, 880 N.E.2d 852 (N.Y. 2007), *later proceedings*, 518 F.3d 159 (2d Cir. 2008); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007); *Penguin Grp. (USA) Inc., v. Am. Buddha*, 946 N.E.2d 159 (N.Y. 2011).

In seeking balance between trademark law and the First Amendment, INTA prioritizes the Lanham Act's main goals: providing consumers with accurate information and avoiding deceptive or misleading conduct. In *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) and *Matal v. Tam*, 137 S. Ct. 1744 (2017), for example, INTA argued that trademark applicants have a First Amendment right to register marks that are scandalous or disparaging; the statutory restrictions on such registrations, since struck down by this Court, had nothing to do with preventing deception or confusion.

In *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007), INTA again prioritized consumer protection: It argued that some parodies, as in the context of movies and magazines, merit First Amendment protection, but parodies that use another's trademark as the defendant's own brand should be examined under trademark law to assess whether they confuse consumers or dilute the plaintiff's famous mark.

Similarly, INTA supported the addition of a parody defense for certain dilution claims in the TDRA, codified at, 15 U.S.C. § 1125(c). H.R. Rep. No. 109-23, 109th Cong., at 25 (1st Sess. 2005). That defense provides that no actionable dilution results from a "fair use" of a plaintiff's trademark "in connection with . . . parodying, criticizing, or commenting upon the famous mark owner or the

goods or services of the famous mark owner,” but **only** if defendant is using the mark “other than as a designation of source for the person’s own goods or services.” 15 U.S.C. § 1125(c)(3)(A). Other TDRA defenses proposed by INTA and adopted by Congress include comparative advertising, news reporting and commentary and noncommercial uses. 15 U.S.C. § 1125(c)(3).

In this case, INTA takes no position on whether the Respondent’s dog toy is infringing or diluting. That is properly decided on the facts (and was decided by the trial court below). INTA does take a position on the correct analytic framework: It urges this Court to grant certiorari and reverse the Ninth Circuit.

### SUMMARY OF ARGUMENT

The Ninth Circuit’s decision creates a sharp circuit split on how to balance competing claims of trademark protection and free speech in the context of claimed parodies embodied in commercial products as contrasted with artistic works.

With respect to **infringement**, the right answer is found in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) and its progeny across the circuits that have followed it. The Second Circuit held that titles of artistic works do not infringe unless (1) the title has no artistic relevance to the underlying work, or (2) the title misleads as to the source of the work.

The body of law that has developed from *Rogers* establishes that this two-part test applies to infringement claims directed at artistic works, such as movies, songs, books and photographs, because such works enjoy core First Amendment protection; that the test applies to both the titles and the content of artistic works; and that the test does not apply to mundane or utilitarian products sold in the commercial marketplace, where the risks of consumer confusion are of paramount concern.

The *Rogers* test is balanced. Plaintiffs sometimes win. *E.g.*, *Parks v. LaFace Records*, 329 F.3d 437, 451–52 (6th Cir. 2003) (reversing summary judgment for defendants; whether song entitled “Rosa Parks” had sufficient artistic connection to plaintiff was question for jury); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65, 668 (5th Cir. 2000) (magazine title POLO infringing given “particularly compelling likelihood of confusion” with Ralph Lauren’s POLO brand); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727 (D. Minn. 1998) (enjoining movie title “Dairy Queens” because movie lacked artistic connection to plaintiff’s restaurant chain).

Defendants sometimes win, too. *E.g.*, *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003) (where use of “Barbie” in titles of photographs was artistically relevant, “public interest in free and artistic expression greatly

outweighs its interest in potential consumer confusion”); *Univ. of Alabama Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1278–79 (11th Cir. 2012) (use of University of Alabama marks in paintings of football games was artistically relevant and protected under *Rogers*).

Whoever wins, the test always has been limited to artistic works. Before this case, it had never been extended to confer First Amendment protection to non-artistic commercial goods. The Ninth Circuit has put an unwarranted thumb on the scales by extending First Amendment protection to non-artistic commercial goods such as dog toys.

The Ninth Circuit’s departure from *Rogers*’s focus on artistic works has created a sharp conflict with the Second, Fourth, Fifth, Sixth, Seventh, Eighth, Tenth and Eleventh Circuits. The expansion of *Rogers* to non-artistic commercial goods would enable evasion of infringement analysis under the Lanham Act simply by grafting some purported artistic element onto the packaging of commercial goods.

This divide already encourages forum shopping. In this very case, Respondent sought a declaratory judgment in the Ninth Circuit, having lost an infringement case within the Eight Circuit involving a different dog toy. *Anheuser-Busch, Inc. v. VIP Prods., LLC*, 666 F. Supp. 2d 974 (E.D. Mo. 2008).

Only by this Court bringing harmony to the law can such forum shopping be stopped.

With respect to **dilution**, the TDRA contains an express exclusion for some parodies, and thus already strikes the needed balance with the First Amendment. 15 U.S.C. § 1125(c)(3)(A)(ii). That exclusion applies to the “fair use” of another’s mark, but only if it does not serve to identify the defendant’s own goods. Other exclusions protect news reporting, comparative advertising, and noncommercial use. 15 U.S.C. § 1125(c)(3).

These exclusions make clear that certain parodies are protected against dilution claims, but not where defendant uses plaintiff’s mark as a designation of source of defendant’s own goods (here, use of the “Bad Spaniels” mark, together with JDPI’s trade dress, on Respondent’s dog toy). Whether a use is diluting should be decided under the substantive provisions of the TDRA (*i.e.*, whether the use blurs the distinctiveness or tarnishes the reputation of the famous mark). There is no need to consult the First Amendment when the TDRA already provides balance, especially given principles of constitutional avoidance.

Just as the *Rogers* test is flexible enough to allow for appropriate results in different cases, so too is the statutory dilution framework. In *Louis Vuitton*, for example, the Fourth Circuit resolved a claim of dilution by dog toys via parody *in the parodist’s*

*favor*. It did so solely by reference to the statute, without even mentioning the First Amendment, because the court found no risk of harm to Louis Vuitton's mark. Where harm to the distinctiveness or reputation of a famous mark has been shown, courts have enjoined parodies. *See, e.g., Louis Vuitton Malletier, S.A. v. Hyundai Motor Am.*, No. 10 Civ. 1611, 2012 WL 1022247, at \*1 (S.D.N.Y. Mar. 22, 2012) (enjoining use of Louis Vuitton trade dress in commercial for Hyundai cars on dilution grounds despite claim that commercial was intended to make "a humorous, socio-economic commentary on luxury defined by a premium price tag"); *Am. Express Co. v. Vibra Approved Lab'ys Corp.*, 1989 WL 39679, 10 U.S.P.Q.2d 2006, at \*10 (S.D.N.Y. Apr. 19, 1989) (enjoining condom sold under infringement of American Express trade dress and DON'T LEAVE HOME WITHOUT IT trademark); *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, at 1192–93 (E.D.N.Y. 1972) (enjoining poster in Coca-Cola trade dress that said ENJOY COCAINE). The Ninth Circuit's absolutist approach, which renders any product noncommercial if it includes some expressive element, lacks any such balance.

Furthermore, the Ninth Circuit's legal conclusion that this dog toy is noncommercial is at odds with this Court's decision in *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983), in which the Court articulated a multi-part test for assessing whether

speech is commercial. The Ninth Circuit made no mention of *Bolger* or its standard.

The *Rogers* test and the dilution statute each supply a flexible, largely speech-protective framework for balancing First Amendment and trademark interests in particular cases. In many cases, parodies will be protected because they are not confusing or diluting. But, nothing in the text, history, or jurisprudence of the First Amendment suggests that it provides protection for purely commercial products that are likely to confuse or dilute. No basis exists for applying the First Amendment to protect humor in the form of a dog toy that appropriates a trademark and trade dress to designate the source of the toy, and that neither comments on nor criticizes the underlying trade dress. Rather, whether the toy is infringing or diluting is appropriately analyzed under trademark law. The Court should grant certiorari and correct the Ninth Circuit's error.

## ARGUMENT

### I. THE NINTH CIRCUIT'S INFRINGEMENT ANALYSIS DIVERGES FROM OTHER FEDERAL CIRCUITS AND UPSETS THE BALANCE BETWEEN TRADEMARK LAW AND THE FIRST AMENDMENT

#### A. The *Rogers* Test Strikes The Right Balance By Granting First Amendment Protection Only To Artistic Works, Not Commercial Goods.

*Rogers* involved a Fellini film about two fictional cabaret performers who imitated the renowned dancing duo Ginger Rogers and Fred Astaire. Rogers sued on the theory that the film's title created the false impression that the film was about her or that she endorsed or sponsored the film. The Second Circuit recognized that the Lanham Act applies to artistic works, but "*only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.*" *Rogers*, 875 F.2d at 998 (emphasis added). The *Rogers* court articulated this two-part test:

In the context of allegedly misleading titles using a celebrity's name, that balance will normally not support application of the [Lanham] Act unless [1] the title has no artistic relevance to

the underlying work whatsoever, or, [2] if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.

*Id.* at 999.

The court expressly recognized that this test would not protect “ordinary commercial products”:

Since consumers expect an ordinary product to be what the name says it is, we apply the Lanham Act with some rigor to prohibit names that misdescribe such goods.

*Id.* at 1000. The court thus made clear that an ordinary commercial product—a category that encompasses Respondent’s dog toy—would not command the same protection as artistic works like movies, books and songs. That is because consumer confusion is a more legitimate concern when “utilitarian products” are “sold in the commercial marketplace.” *Id.* at 997.<sup>3</sup>

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<sup>3</sup> The fact that artistic works—like the film in *Rogers*—are sold in the commercial marketplace does not change the analysis. Artistic works enjoy First Amendment protection because the public has a strong interest in enjoying the “results of the author’s freedom of expression.” *Rogers*, 875 F. 2d at 998. Just because an ordinary commercial good contains some expression does not transform it into noncommercial speech worthy of First Amendment protection. Rather, with such ordinary

The Second Circuit subsequently noted that, even if a work is artistically relevant, trademark liability may be found if the case for confusion is compelling. *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366 (2d Cir. 1993).

The court applied *Rogers* to assess whether a book title—“Welcome to Twin Peaks: A Complete Guide to Who’s Who and What’s What”—infringed the trademark rights of the “Twin Peaks” television show. Although the court held that “the title [was] of some artistic relevance” to the book at issue, the key question was whether the title explicitly misled consumers as to the source or the content of the book. *Id.* at 1379. Because the district court did not give due consideration to the risk of confusion, the Second Circuit remanded, emphasizing the importance of looking at the title in context, including with the trade dress used, in order to assess the risk of confusion:

It is a fair question whether a title that might otherwise be permissible under *Rogers* violates the Lanham Act when displayed in a manner that conjures up a visual image prominently associated with the work bearing the mark that was copied.

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commercial goods, the public’s interest in not being misled takes precedence. *Id.*

*Id.* at 1380. That instruction is highly relevant here, where Respondent’s dog toy is alleged to have copied JDPI’s trade dress, “conjur[ing] up a visual image prominently associated with the work bearing the mark.” *Id.*

Consistent with *Rogers* and *Twin Peaks*, when courts in the Second Circuit consider the use of a mark on commercial products (including products that could contain artistic elements, like T-shirts), they apply neither *Rogers* nor the First Amendment—just trademark law. For example, in *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410 (S.D.N.Y. 2002) (cited by the district court below), the court rejected First Amendment protection for parody dog products because the mark was being used “at least in part to promote a somewhat non-expressive, commercial product” and “trademark law permissibly regulates misleading commercial speech.” *Id.* at 415–16.

Similarly, in *A.V.E.L.A., Inc. v. Estate of Marilyn Monroe, LLC*, 364 F. Supp. 3d 291 (S.D.N.Y. 2019), the court rejected the application of *Rogers* to T-shirts bearing marks related to Marilyn Monroe. “[T]he *Rogers* test is usually not the appropriate mechanism for examining an ordinary commercial product. . . . [T]he *Rogers* test is not designed to protect commercial products” because “any First Amendment concerns are already addressed by the consumer confusion test applicable to commercial

products.” *Id.* at 321–22; *see also* Pierre N. Leval, *Trademark: Champion of Free Speech*, 27:2 COLUM. J. L. & ARTS 188 (2004) (most trademark cases should be decided under trademark law, not the First Amendment, because trademark law itself balances free expression with property rights).

**B. No Other Circuit Has Applied *Rogers* To Commercial Products.**

Courts in the Fourth, Fifth, Sixth, Seventh, Eighth, Tenth and Eleventh Circuits likewise have either analyzed commercial products purporting to be a parody under a trademark likelihood-of-confusion analysis, rather than a First Amendment analysis, or have limited the application of *Rogers* to artistic works. None has applied *Rogers* to commercial goods.

The **Fourth Circuit** applied trademark law to hold that a “Chewy Vuiton” dog toy neither infringed nor diluted Louis Vuitton’s trademarks. *Louis Vuitton Malletier S.A.*, 507 F.3d at 263. The defense of parody did not trigger First Amendment protection; rather, the fact that the toy was a parody simply “influence[d] the way in which the [likelihood of confusion] factors are applied. . . . [A]n effective parody will actually diminish the likelihood of confusion, while an ineffective parody [will] not.” *Id.* at 261.

Curiously, the Ninth Circuit in this case relied on *Louis Vuitton* to “support[] [its] conclusion” that the First Amendment protects Respondent’s toy. *VIP Prods. LLC v. JDPI*, 953 F.3d 1170, 1175 (9th Cir. 2020). *Louis Vuitton* provides no such support because that court never mentioned the First Amendment.<sup>4</sup>

In *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000), the **Fifth Circuit** applied *Rogers* to the title of a magazine, confirming that a “particularly compelling likelihood of confusion” is required in order to find liability for trademark infringement in that context. *Id.* at 665. In holding that plaintiff demonstrated a compelling likelihood of confusion, the court acknowledged the protection for artistic works:

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<sup>4</sup> The *Louis Vuitton* decision also did not address *Rogers*. In contrast, the Fourth Circuit did apply *Rogers* in the context of a billboard containing political speech—exactly the type of speech protected by the First Amendment. *Radiance Found., Inc. v. NAACP*, 786 F.3d 316 (4th Cir. 2015). In neither *Radiance Foundation* nor *Louis Vuitton* did the Fourth Circuit suggest that commercial products such as dog toys merit First Amendment protection.

***Titles***, according to the *Rogers* court, combine both artistic expression and commercial promotion, and they consequently ***require more First Amendment protection than the labeling of ordinary commercial products.***

*Id.* at 664 (emphasis added); *see also Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 n.7 (5th Cir. 1999) (“Any finding that defendants’ book title is likely to cause confusion with plaintiff’s book title must be ‘particularly compelling’ to outweigh defendants’ First Amendment interest in choosing an appropriate book title for their work”) (quoting *Twin Peaks*).

In *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003), the **Sixth Circuit** also applied *Rogers* to an artistic work. In that case, the court held that defendants’ use of Rosa Parks’s name in a song title might infringe her rights if the title had no artistic relevance to the song’s content. The court declined to apply trademark law alone because that would “treat[] the name of an artistic work as if it were no different from the name of an ordinary commercial product.” *Id.* at 449. *See also ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003) (applying *Rogers* to artistic painting depicting Tiger Woods).

In the **Seventh Circuit**, *Nike, Inc. v. Just Did It Enterprises*, 6 F.3d 1225 (7th Cir. 1993) involved T-

shirts that said “MIKE” above a swoosh design—a parody of the NIKE word mark and “swoosh” design mark—intended for sale to persons named Mike. The First Amendment allows individuals to ridicule, the court explained, but such parodies “do not enjoy a dispensation from [the traditional likelihood of confusion] standard.” *Id.* at 1228 (remanding on likelihood of confusion).

Likewise, the **Eighth Circuit** assessed a parody under trademark law rather than the First Amendment. In a case involving commercial goods like mugs and T-shirts that displayed a parody of the MUTUAL OF OHAMA trademark (“Mutant of Omaha”), the court upheld a preliminary injunction, and rejected the defendant’s parody defense, in order to prevent confusion. The First Amendment did not shield defendant’s confusing use of plaintiff’s marks to market or identify his own products. *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987). *See also Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769 (8th Cir. 1994) (public interest in avoiding consumer confusion outweighed public interest in free expression where magazine’s use of plaintiff’s marks caused actual confusion).

A district court in the Eighth Circuit considered these same issues in a case involving Respondent. In *Anheuser-Busch, Inc. v. VIP Prods., LLC*, 666 F. Supp. 2d 974 (E.D. Mo. 2008), the court considered a squeaky dog toy called “Buttwiper” that mimicked

the Budweiser trademark and trade dress. Like all other courts until the Ninth Circuit's decision, below, the court held that trademark law, rather than the First Amendment, should govern.

“Parody,” the court held, is just “another factor to consider in determining the likelihood of confusion.” *Id.* at 984–85 (quoting *Utah Lighthouse Ministry v. Found. for Apologetic Info. and Research*, 527 F.3d 1045, 1055 (10th Cir. 2008)). It does not give rise to a First Amendment defense when used on a commercial product like a dog toy:

[T]he cry of “parody!” does not magically fend off otherwise legitimate claims of trademark infringement or dilution. There are confusing parodies and non-confusing parodies.

*Id.* at 985.

In the **Tenth Circuit**, *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987) analyzed the likelihood of confusion factors to conclude that the JORDACHE mark for blue jeans was not infringed by a LARDASHE parody mark used on plus-sized jeans. Here too, the court found no basis to apply the First Amendment:

The tension between the first amendment and trademark rights is most acute when a noncommercial

parody is alleged to have caused tarnishment, a situation in which first amendment protection is greatest. This concern is not as great here ***because Lardashe is being used as a trademark to identify a commercial product.***

*Id.* at 1490 n.7 (emphasis added); *see also Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959 (10th Cir. 1996) (parody baseball cards successfully amused, and did not confuse); *Stouffer v. Nat. Geographic Partners, LLC*, 2020 WL 2306854 (D. Colo. May 8, 2020) (applying modified version of *Rogers* to documentary title), *appeal filed*, No. 20-1208 (10th Cir. June 8, 2020).

The **Eleventh Circuit’s** decision in *Univ. of Alabama Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266 (11th Cir. 2012) is instructive. In that case, the court applied *Rogers* to protect “artistically expressive work[s]”—paintings, prints, and calendars—but not “mundane” articles like mugs, cups, flags, towels, and T-shirts. *Id.* 1278–79. Those products instead are subject to the regular likelihood of confusion analysis. That approach mimics the Second Circuit’s distinction between artistic works and “utilitarian products.” *Rogers*, 875 F.2d at 997.

As these examples show, courts outside the Ninth Circuit recognize that heightened First Amendment protection is appropriate only for artistic works. Not

one of these courts has applied *Rogers* to cover ordinary commercial products. To the contrary, when addressing mundane commercial products—like the dog toys here—courts do not extend First Amendment protection. Rather, courts analyze products alleged to be parodies under trademark law, considering whether the parody is so obvious that confusion is unlikely.

The Ninth Circuit’s alternative approach means that any seller of an ordinary commercial product who uses a humorous message with another’s mark will be entitled to First Amendment protection so long as the mark has some artistic relevance to the product (a standard the Ninth Circuit has said is any relevance “above zero,” *E.S.S. Ent’m’t 2000 Inc. v. Rock Star Videos Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008), and does not present a compelling likelihood of confusion. Such a standard fails to strike the proper balance between trademark law and the First Amendment.

**C. The Ninth Circuit’s Extension Of *Rogers* Wrongly Tilts The Balance Against The Application of Trademark Law And Its Protection Of Consumers.**

This case warrants review by this Court because the Ninth Circuit’s approach is far out of step with all of the other circuits that have analyzed *Rogers* or considered trademark claims involving parodies in commercial goods. It is an outlier that threatens to undermine long-standing likelihood of confusion analysis for any product that arguably includes some expression of any kind. That instability is exacerbated given the prominence and size of the Ninth Circuit.

This is not the first time the Ninth Circuit has insupportably expanded *Rogers*. In *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192 (9th Cir. 2017), the Ninth Circuit held that EMPIRE-branded sound recordings used to market the Fox television series “Empire” (about a fictional “Empire Entertainment” company) did not infringe the trademark rights of a real-world record label named Empire Distribution, Inc. The title of the show—“Empire”—is exactly what *Rogers* was intended to protect. But INTA was troubled by the Ninth Circuit’s companion conclusion extending *Rogers* to consumer goods like shirts, glasses and records sold under the EMPIRE trademark, even though the Ninth Circuit recognized “that these

promotional efforts technically fall outside the title or body of an expressive work.” *Id.* at 1196.

In *Gordon v. Drape Creative, Inc.*, 909 F.3d 257 (9th Cir. 2018), the Ninth Circuit expanded *Rogers* again, this time to provide First Amendment protection to greeting cards after the defendant tried, without success, to license the plaintiff’s trademark for its greeting cards.

*JDPI* goes substantially further. In *JDPI*, the court completely untethered *Rogers* from its moorings by offering First Amendment protection to a dog toy that replicates a Jack Daniel’s whiskey bottle—the precise type of “utilitarian” and “mundane” product that courts since *Rogers* itself have recognized do not merit First Amendment protection. The Ninth Circuit’s conclusion that any product that “communicate[s] a humorous message” is an “expressive work” with First Amendment protection, *JDPI*, 953 F.3d at 1175, clashes with decades of precedent from the other circuits.

As a matter of First Amendment precedent, no basis exists for this sort of protection. At most, a dog toy would be considered a form of commercial speech that would be subject to intermediate scrutiny, which allows trademark law to regulate such uses to advance the important interest of protecting the public from confusion. *S.F. Arts & Athletics, Inc. v. U.S. Olympic Committee*, 483 U.S. 522, 535, 541 (1987) (use of mark to induce sale of goods is

“commercial speech,” which “receives a limited form of First Amendment protection”; commercial user who claims partially expressive purpose does not thereby earn “First Amendment right to ‘appropriat[e] to itself the harvest of those who have sown.’”); *Central Hudson Gas & Electric Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 562–63 (1980) (“The Constitution . . . accords a lesser protection to commercial speech than to other constitutionally guaranteed expression.”). Nothing in this Court’s free speech jurisprudence, or in the text or history of the First Amendment, supports the constitutional protection afforded by the Ninth Circuit.

## **II. THE NINTH CIRCUIT’S DILUTION ANALYSIS DEPARTS FROM THE EXISTING STATUTORY FRAMEWORK AND DISREGARDS THIS COURT’S PRECEDENT.**

The Court should grant *certiorari* to confirm that its own longstanding analysis for “commercial” speech, not the Ninth Circuit’s novel approach, applies under the TDRA.

The TDRA contains a number of defenses—including for certain parodies, news reporting, and noncommercial uses—that already strike a balance with the First Amendment. 15 U.S.C. § 1125(c)(3). With respect to parodies, the exclusion protects parodies against claims of dilution, but only where a defendant does not use the plaintiff’s mark as a designation of source of the defendant’s own goods.

The Ninth Circuit did not purport to apply that exclusion because Respondent branded its dog toy with its own mark (Bad Spaniels) and trade dress, both of which JDPI challenged as diluting.

Instead, the Ninth Circuit disregarded the limits of the parody exclusion and seized on the exclusion for noncommercial uses. It held the dog toy noncommercial because it “was used to convey a humorous message.” *JDPI*, 953 F.3d at 1176.

The TDRA’s “noncommercial use exclusion “expressly incorporates the concept of ‘commercial’ speech from the ‘commercial speech’ doctrine, and proscribes dilution actions that seek to enjoin use of famous marks in ‘non-commercial’ uses (such as consumer product reviews).” H.R. Rep. No. 104-374, 104th Cong., at 8 (1st Sess. 1995); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 906 (9th Cir. 2002) (discussing legislative history of Lanham Act’s dilution provision). Before that exclusion can be applied, a court must assess whether the use at issue qualifies as “commercial.”

This Court in *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983), considered three characteristics, the combination of which provides “strong support” for finding speech to be “commercial”:

- (1) Whether the material is an advertisement;

- (2) Whether the materials refer to a specific product;
- (3) Whether the speaker has an economic motive;

*Id.* at 66–67. The Court was mindful that “[a]dvertisers should not be permitted to immunize false or misleading product information from government regulation simply by including references to public issues.” *Id.* at 68 (noting approvingly Justice Brennan’s concurrence in *Metromedia, Inc. v. City of San Diego*, 453 U.S. 490, 540 (1981), that “those who seek to convey commercial messages will engage in the most imaginative of exercises to place themselves within the safe haven of noncommercial speech, while at the same time conveying their commercial message”).

Although this Court has not addressed the TDRA’s noncommercial use exception, other courts have applied *Bolger* to analyze whether a trademark use is “noncommercial” under the TDRA. In *Radiance Foundation*, the Fourth Circuit applied the *Bolger* factors and added one more: “the viewpoint of the listener’, *i.e.*, whether the listener would perceive the speech as proposing a transaction.” 786 F.3d at 331.

The Ninth Circuit did not consider *Bolger* at all. Instead, in two paragraphs, it held as a matter of law that Respondent’s dog toy was noncommercial,

and therefore statutorily exempt from a claim for dilution, because the toy conveyed a “humorous message” and did “more than propose a commercial transaction.” *JDPI*, 953 F.3d at 1176. That analysis ignores the other *Bolger* factors and improperly shortcuts the analysis of whether a use is “commercial.”

An example of *Bolger*’s proper application involved a denial by the New York State Liquor Authority of an application for a beer label with a “picture of a frog with the second of its four unwebbed ‘fingers’ extended in a manner evocative of a well known human gesture of insult.” *Bad Frog Brewery, Inc. v. N.Y. State Liquor Auth.*, 134 F.3d 87, 90 (2d Cir. 1998). The Second Circuit applied *Bolger* and held that the label, although it contained expressive elements, nevertheless was commercial speech:

We are unpersuaded by Bad Frog’s attempt to separate the purported social commentary in the labels from the hawking of beer. Bad Frog’s labels meet the three criteria identified in *Bolger*: the labels are a form of advertising, identify a specific product, and serve the economic interest of the speaker. Moreover, the purported noncommercial message is not so “inextricably intertwined” with the

commercial speech as to require a finding that the entire label must be treated as “pure” speech. Even viewed generously, Bad Frog’s labels at most link[] a product to a current debate, which is not enough to convert a proposal for a commercial transaction into “pure” noncommercial speech.

*Id.* at 97 (citations and quotation marks omitted).

As the Second Circuit did with beer in *Bad Frog Brewery*, the Ninth Circuit should have done with the dog toy here; it should have applied the *Bolger* factors with reference to the district court’s factual findings, rather than summarily conclude that the toy made noncommercial use of Petitioner’s trade dress.

The Ninth Circuit not only failed to apply this Court’s established test for analyzing commercial speech, but also unnecessarily resorted to the First Amendment. The TDRA already includes provisions balancing trademark interests with free speech. The Ninth Circuit should have applied those provisions, especially given this Court’s “settled policy” to avoid unnecessary constitutional questions. *Gomez v. United States*, 490 U.S. 858, 864 (1989) (invoking doctrine of constitutional avoidance in dispute raising potential First Amendment issues). Adherence to this “settled policy” calls for instructing the lower courts to follow the statutory

framework and avoid injecting unneeded new First Amendment rules. *See also* Leval, *supra*, at 210 (“Where the terms of the trademark law adequately protect an accused infringer’s use as falling outside the scope of the trademark owner’s exclusive right, the court has no need to seek answers in the First Amendment.”).

### CONCLUSION

For the foregoing reasons, the Court should grant JDPI’s petition for certiorari.

Dated: October 19, 2020

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