

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

—◆—
**BRIEF OF AMICI CURIAE
TRADEMARK LAW PROFESSORS IN OPPOSITION
TO PETITION FOR CERTIORARI**

—◆—
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STATEMENT OF INTEREST OF AMICI CURIAE

Amici are law professors who teach and have written extensively about trademark law and other intellectual property law subjects. Our sole interest in this case is in the orderly development of trademark law in a way that serves the public interest.¹

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SUMMARY OF ARGUMENT

Petitioner characterizes this as a case in which “a defendant uses a trademark to identify the origin or sponsorship of a commercial product in a humorous way.” Pet’r’s Br. 18. Using that framing, Petitioner

¹ Counsel for the parties did not author this brief in whole or in part. The parties have not contributed money intended to fund preparing or submitting the brief. No person other than Amici Curiae or their counsel contributed money to fund preparation or submission of this brief. The parties have consented to filing of amicus briefs and have been provided with ten days notice.

** All signatories speak only on behalf of themselves. Institutional affiliations are listed for identification purposes only.

contends that the Ninth Circuit created a circuit split by deviating from the standard likelihood of confusion test and applying the framework of *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). But Petitioner invents that split by mischaracterizing this case and the governing framework. There is no circuit split on “humorous products” because that is not a relevant category of cases for either trademark or First Amendment purposes. The Ninth Circuit applied *Rogers* because it (correctly) viewed VIP’s use of “Bad Spaniels” for its dog toys as noncommercial speech, and the *Rogers* framework has been applied to noncommercial speech by almost every court that has considered that framework.

Most amici, and particularly the International Trademark Association (INTA), accept that *Rogers* is the correct framework for noncommercial speech, which receives more constitutional protection than ordinary commercial speech. INTA nevertheless argues that the Ninth Circuit created a split by evaluating VIP’s Bad Spaniels dog toys under the *Rogers* framework. *See, e.g.*, INTA Br. 7. According to INTA, *Rogers* should not apply because VIP’s toys are merely “non-artistic commercial goods.” INTA Br. 7; *see also id.* at 21 (referring to “mundane” products).

But this Court’s First Amendment cases do not distinguish between commercial and noncommercial *goods*; they distinguish between commercial and noncommercial *speech*. That is an important difference, because, as this Court has long recognized, noncommercial speech is often sold for profit. *See, e.g., Brown*

v. Ent. Merchs. Ass'n, 564 U.S. 786, 790 (2011) (video games); *City of Lakewood v. Plain Dealer Publ'g Co.*, 486 U.S. 750, 756 n.5 (1988) (citing *Pittsburgh Press Co. v. Pittsburgh Comm'n on Human Rel.*, 413 U.S. 376, 385 (1973)) (“Of course, the degree of First Amendment protection is not diminished merely because the newspaper or speech is sold rather than given away.”); *Smith v. California*, 361 U.S. 147, 150 (1959) (“It is of course no matter that the dissemination [of books] takes place under commercial auspices.”). By contrast, commercial speech generally proposes a commercial transaction: it is, roughly speaking, an offer to sell something other than the speech itself.

INTA’s proposed distinction between goods and speech is fundamentally misaligned with existing First Amendment doctrine. The misalignment is evident in the examples cited by INTA of “non-artistic commercial goods” to which it claims some appellate courts other than the Ninth Circuit have declined to apply *Rogers*. These examples include goods that have played central roles in this Court’s most celebrated First Amendment cases—magazines, books, t-shirts, jackets, and even flags. INTA Br. 7; 14-21 (citing, e.g., *Univ. of Alabama Bd. of Tr. v. New Life Art, Inc.*, 683 F.3d 1266, 1278-79 (11th Cir. 2012) (flags and t-shirts); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664 (5th Cir. 2000) (magazine title); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 267-70 (5th Cir. 1999) (book title); *Nike, Inc. v. “Just Did It” Enters.*, 6 F.3d 1225, 1229 (7th Cir. 1993 (t-shirts); *A.V.E.L.A., Inc. v.*

Est. of Marilyn Monroe, LLC, 364 F. Supp. 3d 291, 322-23 (S.D.N.Y. 2019) (t-shirts and posters)).

The Second Circuit developed the *Rogers* framework explicitly to deal with noncommercial speech. Given the context of *Rogers* (a claim by Ginger Rogers against use of her name in the title of a movie), it is no surprise that the Second Circuit justified its approach by highlighting the speech interests at stake and distinguishing standard trademark cases that do not raise the same concerns. But the court’s reference to “artistic works” was neither restrictive nor a comprehensive identification of situations involving noncommercial speech interests. “Artistic works” was simply the way to specify the noncommercial speech at issue in the case. Circuit courts overwhelmingly have understood this and have applied *Rogers* to a wide range of noncommercial speech. *See, e.g., Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 260 (9th Cir. 2018) (greeting cards); *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1196-97 (9th Cir. 2017) (television series and related music and merchandise such as promotional shirts and champagne glasses); *Radiance Found., Inc. v. NAACP*, 786 F.3d 316 (4th Cir. 2015) (political speech); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241-42 (9th Cir. 2013) (video games); *Mattel Inc. v. Walking Mountain Prod.*, 353 F.3d 792 (9th Cir. 2003) (photographs of Barbie Dolls); *Parks v. LaFace Recs.*, 329 F.3d 437 (6th Cir. 2003) (music); *Mattel, Inc. v. MCA Recs.*, 296 F.3d 894 (9th Cir. 2002) (songs). The putative “split” mainly comes from cases

that reject liability for parodies on alternative grounds without explicitly rejecting or even considering *Rogers*.

The *Rogers* framework may need further development to make it fully compatible with commercial speech doctrine, particularly after this Court's decisions in *Matal v. Tam*, 137 S.Ct. 1744 (2017), and *Iancu v. Brunetti*, 139 S.Ct. 2294 (2019), which raised broader questions about the application of the First Amendment to trademark law. This case is the wrong vehicle for addressing those issues, however, because VIP's speech is inseparable from the medium in which it conveys that speech. Jack Daniel's challenges the Bad Spaniels name and the design of VIP's dog toys, but the fact that the products are dog toys is part of the joke. As a result, even if it were generally possible to articulate a line between products and speech, no meaningful distinction is possible in this case.

An additional reason to deny certiorari and allow further percolation of the doctrine in the lower courts is that courts have not yet had the opportunity to work out the full consequences of *Tam* and *Brunetti* for the law of dilution. Under the logic of those cases, and in light of broader developments in First Amendment law, Jack Daniel's dilution claim must fail because dilution by tarnishment, like the prohibition on registering disparaging marks, is an unconstitutional "happy talk" provision. *Tam*, 137 S.Ct. at 1765 (opinion of Alito, J.).



ARGUMENT

Current trademark doctrine recognizes, in various ways, that parodies are unlikely to cause confusion. In fact, there are enough viable routes to that conclusion within established law that the defendant’s challenge is picking the best path, not avoiding liability. *See* William McGeeveran, *The Imaginary Trademark Parody Crisis (and the Real One)*, 90 WASH. L. REV. 713, 746-47 (2015). One such path is through the doctrine first articulated in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), which precludes trademark liability for noncommercial speech unless the accused speech is not artistically relevant or is explicitly misleading.²

As it has been applied in the lower courts, *Rogers* has generally served the role of preventing trademark law—which developed as a regulation of purely commercial speech—from impermissibly encroaching on the freedom to engage in noncommercial speech, including noncommercial speech that is sold for profit. *Brown v. Ent. Merchs. Ass’n*, 564 U.S. 786, 790 (2011) (explaining that speech that is the product being sold is noncommercial speech).

² Amici do not think the “artistic relevance” element is consistent with adequate First Amendment protection for noncommercial speech, but most courts have interpreted artistic relevance broadly enough so as not to threaten protected expression. *See, e.g., E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) (artistic relevance must merely be more than zero); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013) (“This black-and-white rule has the benefit of limiting [a court’s need] to engage in artistic analysis in this context.”). *But see Parks v. LaFace Recs.*, 329 F.3d 437 (6th Cir. 2003) (finding factual issue in context of allusive rap song).

I. The *Rogers* Test Developed by the Second Circuit is Working Robustly in the Lower Courts

In *Rogers*, actress Ginger Rogers sued the producers of *Ginger and Fred*, a Fellini film about two Italian cabaret performers who made a living by imitating Ginger Rogers and Fred Astaire. Rogers claimed that use of her name in the title of the film violated the Lanham Act because it created the false impression that she was involved with the making of the film or otherwise endorsed it. *Rogers*, 875 F.2d at 997. The Second Circuit recognized both that “Rogers’ name ha[d] enormous drawing power in the entertainment world,” such that controlling its use was of value to her, and that movies were “indisputably works of artistic expression and deserve[d] protection.” *Id.* at 996, 997.

Balancing the interests at stake, the court concluded that “in general the [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* at 999. As a result, “the balance will normally not support application of the Act unless [the use of the trademark] has no artistic relevance to the underlying work whatsoever, or if it has some artistic relevance, unless [the use of the trademark] explicitly misleads as to the source or content of the work.” *Id.* Because use of

Ginger Rogers’s name was clearly artistically relevant and did not explicitly mislead, the court rejected her claim even in the face of survey and anecdotal evidence of consumer confusion. *Id.* at 1001.

Rogers has been widely adopted across the lower courts, which have uniformly extended its rule beyond titles to cover all uses in the content of noncommercial speech. *See, e.g., Gordon v. Drape Creative, Inc.*, 909 F.3d 257 (9th Cir. 2018) (greeting cards); *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 329 (4th Cir. 2015) (political speech); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241-42 (9th Cir. 2013) (video games); *Univ. of Alabama Bd. of Tr. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012) (content of artwork); *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (explaining that the *Rogers* test is not dependent on the identifying material appearing in the title but “also appl[ies] to the use of a trademark in the body of the work”); *Parks v. LaFace Recs.*, 329 F.3d 437, 451-52 (6th Cir. 2003) (song title); *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (song title and content); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664-65 (5th Cir. 2000) (magazine title); *Dillinger, LLC v. Elec. Arts Inc.*, No. 1:09-cv-1236-JMS-DKL, 2011 WL 2457678 at *4 (S.D. Ind. June 16, 2011) (video game content); *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 339-40 (E.D. Pa. 1996) (film content).

Although courts have often referred to “expressive” or “artistic” works as shorthand for the scope of *Rogers*, they have in practice applied it to speech that qualifies as noncommercial under this Court’s First

Amendment precedents—speech that does not propose a commercial transaction and is instead the product being offered to the public. This is unsurprising: *Rogers* itself was based on an opposition between “artistic expression” and “commercial speech.” 875 F.2d 997. See *Radiance*, 786 F.3d at 322 (discussing *Rogers* as protection for “noncommercial” speech); *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1016-17 (3d Cir. 2008) (treating *Rogers* as creating a commercial/noncommercial speech division); *Dickinson v. Ryan Seacrest Enters., Inc.*, 2019 WL 3035090, at *8 (C.D. Cal. Mar. 26, 2019) (same); *Fortres Grand Corp. v. Warner Bros. Ent. Inc.*, 947 F. Supp. 2d 922, 933 (N.D. Ind. 2013) (same), *aff’d on other grounds*, 763 F.3d 696 (7th Cir. 2014); *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172, 177 (S.D.N.Y. 2012) (same); *U.S. Olympic Comm. v. Am. Media, Inc.*, 156 F. Supp.2d 1200, 1209 (D. Colo. 2001) (same); *Lacoff v. Buena Vista Pub., Inc.*, 705 N.Y.S.2d 183, 191 (Sup. Ct. 2000) (same).

Petitioner and its supporters cite a grab bag of cases purporting to show a split, but no court of appeals has rejected *Rogers*. Of the cases cited by INTA that do not apply *Rogers*, several were decided before *Rogers*. See *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987); *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987) (logo on jeans; no likely confusion); *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972).

The appellate cases cited by INTA that were decided after *Rogers* but do not use its framework do not

reject *Rogers*; they rule on other grounds. See *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Rsch.*, 527 F.3d 1045 (10th Cir. 2008); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog LLC*, 507 F.3d 252 (4th Cir. 2007); cf. *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000) (citing *Rogers* with approval); *Sugar Busters LLC v. Brennan*, 177 F.3d 258 (5th Cir. 1999) (citing *Rogers* with approval); *Nike, Inc. v. Just Did It Enters.*, 6 F.3d 1225 (7th Cir. 1993). *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769 (8th Cir. 1994), is an outlier that does not discuss *Rogers* and fails to recognize a parody “ad” in a humor magazine as noncommercial speech. Petitioner and its amici cannot identify any appellate case that both (1) identifies the subject matter as noncommercial speech and (2) nonetheless refuses heightened protection against trademark liability.³ See also, e.g., *Fortres Grand Corp. v. Warner Bros. Ent. Inc.*, 763 F.3d 696 (7th Cir. 2014) (affirming district court’s *Rogers*-based dismissal of claim against movie and associated websites on alternate grounds).

Their attempt to create a split out of district court cases fares no better. The Southern District of New

³ Some of the cases cited by INTA have no obvious connection to the question presented. See, e.g., *Bad Frog Brewery, Inc. v. N.Y. State Liquor Auth.*, 134 F.3d 87 (2d Cir. 1998) (beer label/commercial speech); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959 (10th Cir. 1996) (right of publicity, not trademark); *Louis Vuitton Malletier, S.A. v. Hyundai Motor Am.*, No. 10 Civ. 1611, 2012 WL 1022247 (S.D.N.Y. Mar. 22, 2012) (car ad/commercial speech); *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410 (S.D.N.Y. 2002) (pet perfume).

York is, of course, bound by *Rogers*. Cases in that district may or may not be correctly decided under governing law, but INTA's citation of Second Circuit district court cases cannot show a split. *See A.V.E.L.A., Inc. v. Est. of Marilyn Monroe, LLC*, 364 F. Supp. 3d 291 (S.D.N.Y. 2019) (declining to apply *Rogers* to t-shirts, glassware, and, clearly problematically, posters); *Am. Express Co. v. Vibra Approved Labs. Corp.*, 1989 WL 39679, 10 U.S.P.Q.2d 2006 (S.D.N.Y. Apr. 19, 1989) (condoms/commercial speech).

Indeed, the only district court cases that actually reject *Rogers* either modify its framework in an attempt to protect First Amendment interests with at least the same vigor, *Stouffer v. Nat. Geographic Partners, LLC*, 2020 WL 2306854 (D. Colo. May 8, 2020), appeal pending, No. 20-1208, or are wrong under prevailing doctrine as applied to plainly noncommercial speech. *A.V.E.L.A.*, 364 F. Supp. 3d at 321-22 (discussing only defendant's t-shirts but ruling as to posters as well); *Am. Dairy Queen v. New Line Prods.*, 35 F. Supp. 2d 727 (D. Minn. 1998) (mistakenly rejecting *Rogers* as applied to the title of a movie because there was no reference to the plaintiff; wrongly decided even under Petitioner's and INTA's purported rule).

While some courts have not ruled on whether to adopt *Rogers*, no circuit court has rejected its rule. Petitioner's fact-bound arguments as to whether *Rogers* applies to this particular expressive product do not present an issue meriting this Court's review.

II. *Rogers* Was a Reasonable Approach in this Case

VIP's Bad Spaniels dog toys are unambiguously a joke, one that Jack Daniel's doesn't appreciate. But trademark law does not—and cannot constitutionally—give Jack Daniel's the right to prevent others from making a joke at their expense, even if the vehicle for the joke is a dog toy.

One way for the courts below to have reached that conclusion would have been to find as a matter of law that VIP's parody product is not likely to cause confusion. *Cf. Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 674 Fed. App'x 16, 17-18 (2d Cir. 2016); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 263, 268 (4th Cir. 2007) (affirming grant of summary judgment to Haute Diggity Dog after “recognizing that ‘Chewy Vuiton’ [was] an obvious parody” and therefore “LVM . . . failed to demonstrate any likelihood of confusion”).

But as many courts have recognized, likelihood of confusion analysis is costly and time-consuming, and forcing defendants to litigate confusion chills expression. *See, e.g., Mattel, Inc. v. MCA Recs.*, 296 F.3d 894, 900-02 (9th Cir. 2002); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306-08 (9th Cir. 1992); *see also* McGeveran, *supra*, at 741-45 (describing the prohibitive costs of going through litigation on likelihood of confusion); *cf. Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000) (“Competition is deterred . . . not merely by successful suit but by the

plausible threat of successful suit. . . .”). As a result, lower courts have developed a number of doctrines that evaluate the defendant’s use according to principles that offer some protection against serious risks of confusion but insulate parties from liability when their uses are unlikely to cause significant harm and an injunction would impair competition or speech interests.

Several of those doctrines were plausible here. The Ninth Circuit could have treated “Bad Spaniels” as nominative fair use—a reference to Jack Daniel’s “for the ‘purposes of comparison, criticism[,] or point of reference.’” *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 809 (9th Cir. 2003) (alteration omitted) (quoting *New Kids on the Block*, 971 F.2d at 306); *see also* 15 U.S.C. § 1125(c)(3)(A) (making nominative fair use not actionable as dilution). Alternatively, the court could have treated the Bad Spaniels label as non-trademark use, since VIP is not evoking Jack Daniel’s to suggest to consumers that Jack Daniel’s is the source or sponsor of the dog toys. *Cf. Hensley Mfg., Inc. v. ProPride, Inc.*, 579 F.3d 603, 610 (6th Cir. 2009) (noting that trademark infringement laws “do[] not even apply” if the defendant uses the mark in a “non-trademark way”); *R.G. Smith v. Chanel, Inc.*, 402 F.2d 562, 563 (9th Cir. 1968) (holding that use to communicate a comparison does not fall within scope of trademark owner’s rights); *LTTB LLC v. Redbubble, Inc.*, 385 F. Supp. 3d 916, 919 (N.D. Cal. 2019) (non-source indicating use does not infringe), *appeal pending*, No. 19-16464.

Instead, recognizing the obvious parodic message of the Bad Spaniels toys, the Ninth Circuit applied

Rogers, finding VIP’s Bad Spaniels to be an expressive work. 953 F.3d at 1175-76. As detailed in Part I, *supra*, courts have applied *Rogers* in cases involving a wide range of expressive works, and that was a reasonable approach here.

III. This Case Does Not Require the Court to Revisit the Commercial/Noncommercial Speech Line

The content of noncommercial speech may be regulated only to further a compelling government interest, and the regulation must be narrowly tailored and the least restrictive means of accomplishing that compelling interest. *Brown v. Ent. Merchs. Ass’n*, 564 U.S. 786, 799 (2011); *Reed v. Town of Gilbert*, 576 U.S. 155, 155-56 (2015). *Rogers* is a helpful way to implement those principles in the context of trademark law, ensuring that most noncommercial speech is insulated from trademark liability.⁴

As noted above, Petitioner and its amici cannot identify a real circuit split on the treatment of “commercial products.” Contrary their claims, the circuits are in agreement both that parodies generally should not be deemed infringing and that noncommercial speech should be treated differently than commercial speech in Lanham Act cases. But hidden in the

⁴ The *Rogers* test might ultimately need further development for full compliance with this Court’s recent precedents, most obviously to add a materiality requirement in order to ensure that the government’s interest in preventing deception is compelling.

arguments Petitioner and its amici make about “commercial goods” is a much more difficult question of the definition of commercial *speech*, one that has not received sufficient development in the trademark context after the Court’s recent pronouncements in *Tam* and *Brunetti*.⁵

In general, commercial speech is speech that proposes a commercial transaction. *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 499 (1996); *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 562-63 (1980). Speech that is instead the product consumers are asked to buy—whether in the form of a book, movie, sculpture, or anything else—is noncommercial. Distinguishing between commercial and noncommercial speech in any particular case can be fact intensive. Yet it has been clear for decades that speech is not commercial simply because it is embodied in a physical product that people can buy. *See, e.g., Gaudiya Vaishnava Soc’y v. City & Cnty. of S.F.*, 952 F.2d 1059, 1063-65 (9th Cir. 1990) (rejecting argument that items with “intrinsic value” cannot be noncommercial speech). Here, the Ninth Circuit reasonably determined that the speech at issue, which only makes sense as a joke because of its embodiment in a dog toy, was the thing consumers were buying. VIP’s speech is therefore noncommercial. To ignore the toy’s expressive content and call it commercial would be like saying that newspaper readers are merely buying paper

⁵ *See generally* Jennifer E. Rothman, *Commercial Speech, Commercial Use, and the Intellectual Property Quagmire*, 101 VA. L. REV. 1929 (2015) (explaining the overall problem).

that just happens to have print on it. *Arkansas Writers' Project, Inc. v. Ragland*, 481 U.S. 221 (1987).

But even if the Ninth Circuit was wrong to place VIP's speech on the noncommercial side of the line, the Ninth Circuit's resolution of that factual question does not require the Court's review. Nor would the case provide an opportunity to articulate more general principles beyond those the Court has already announced for distinguishing commercial from noncommercial speech.⁶

Contradicting decades of precedent that distinguishes commercial and noncommercial speech, Petitioner's amici, including INTA, ask this Court to draw a bright line between "expressive works," to which they

⁶ The appropriate treatment of clothing may present genuinely difficult issues, as slogans or symbols displayed prominently on clothing are often fully protected speech. *See Cohen v. California*, 403 U.S. 15 (1971); *Morse v. Frederick*, 551 U.S. 393 (2007); *cf. Spence v. Washington*, 418 U.S. 405 (1974). In our view, anticounterfeiting protection is justified where trademarks serve as a quality guarantee on clothing, despite any ancillary impact on expression. But cases in which the symbol on clothing is the product consumers want to buy, without reference to the quality of the clothing on which the symbol appears, are difficult because, as this Court has said, trademarks often have important noncommercial meanings. *Tam*, 137 S.Ct. at 1752, 1760. Those issues are not squarely presented by this case, but they would have to be considered if the Court were to take this case to more generally address commercial speech doctrine in the trademark context, as Petitioner and its amici invite the Court to do.

concede *Rogers* applies, and “non-artistic commercial goods.” Amici disagree that the application of *Rogers* always depends on characterization of the product that carries the challenged message. As courts applying *Rogers* routinely recognize, there are many forms of noncommercial speech. “The protection of the First Amendment is not limited to written or spoken words, but includes other mediums of expression, including music, pictures, films, photographs, paintings, drawings, engravings, prints, and sculptures.” *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 924 (6th Cir. 2003) (citation omitted; applying *Rogers*); *Burck v. Mars, Inc.*, 571 F. Supp. 2d 446, 457 (S.D.N.Y. 2008) (“Courts have recognized, however, that a parody may have ‘hybrid’ uses, i.e., a parody can be a product and, at the same time, advertise that product.”) (discussing *Rogers*).

Rogers itself undermines the distinction amici ask this Court to embrace. *Rogers*’s claim was specifically focused on the title of a film, and it was only the special characteristics of titles that made the Second Circuit believe there was anything to balance against the film producers’ First Amendment interests. “Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker’s expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined.” *Rogers*, 875 F.2d at 998. In contrast to amici’s characterization, the Second Circuit was not describing a limited universe of “artistic

works” warranting special consideration. Instead, it created a framework for titles that gave weight to trademark interests only because titles in particular had quasi-commercial characteristics. “Consumers of artistic works thus have a dual interest: They have an interest in not being misled and they also have an interest in enjoying the results of the author’s freedom of expression. For all these reasons, the expressive element of titles requires more protection than the labeling of ordinary commercial products.” *Id.* The *Rogers* framework is therefore more speech-protective than ordinary trademark cases involving commercial speech, but arguably more trademark-protective than ordinary noncommercial speech standards.

Reinforcing the reasoning of *Rogers*, this Court further recognized in *Tam* that trademarks routinely express more than source indication, and the expressive dimensions of the marks warrant First Amendment protection. *Tam*, 137 S.Ct. 1744 at 1752, 1760. In some situations, such as the use of trademarks in the titles of expressive works, those elements are inextricably intertwined. *Rogers*, 875 F.2d at 998 (“The title of a movie may be both an integral element of the filmmaker’s expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined. Filmmakers and authors frequently rely on word-play, ambiguity, irony, and allusion in titling

their works. Furthermore, their interest in freedom of artistic expression is shared by their audience.”)⁷

When commercial and non-commercial aspects of speech are intertwined, this Court’s precedents dictate treating the trademark-using speech as noncommercial. *Riley v. Nat’l Fed’n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988) (“[W]e do not believe that the speech retains its commercial character when it is inextricably intertwined with otherwise fully protected speech”). Suppressing the commercial aspects of the parody toy in this case would necessarily suppress the noncommercial aspects, since the restraint would be on the use of the parody itself, unlike situations in which specific commercial promotions could be excised from otherwise noncommercial material. Compare *Bd. of Trs. of the State Univ. of N.Y. v. Fox*, 492 U.S. 469, 473-80 (1989) (finding educational presentations in “Tupperware parties” separable from accompanying sales pitches), with, e.g., *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 906-07 (9th Cir. 2002) (the commercial purpose of using “Barbie” in a song title was “inextricably intertwined” with the “expressive elements” of the song) (citations omitted), and *Parks v. LaFace Recs.*, 329 F.3d 437, 449 (6th Cir. 2003) (“[I]f a song is sold, and the title is protected by the First Amendment, the

⁷ While Ginger Rogers’s claim focused on use of her name, the film used that name repeatedly in its content. Rogers did not even contest that use, presumably because everyone understood that the First Amendment interests are stronger, and the trademark interests weaker, with respect to non-title aspects of work content.

title naturally will be ‘inextricably intertwined’ with the song’s commercial promotion.”) (citations omitted).

Whatever the merits of revisiting commercial speech doctrine writ large, this case is an especially bad vehicle for defining the outer boundaries of trademark law’s free speech limitations. The products Jack Daniel’s challenges are dog toys called Bad Spaniels. It is essential to the joke that the products are dog toys. Here, the medium of VIP’s speech is inseparable from its message. No clear distinction between speech and commercial product is possible. Just as in the many cases applying *Rogers* that involved “inextricably intertwined” speech, it was reasonable for the Ninth Circuit to embrace the *Rogers* approach here.

IV. The Court Below Properly Declined to Use Tarnishment Law to Suppress a Parody

Application of *Rogers* disposes of Jack Daniel’s dilution claim as well, obviating the need for this Court to consider separately the contention that VIP’s use of Bad Spaniels was not “noncommercial” under 15 U.S.C. § 1125(c)(3)(C). That conclusion is important, because if VIP’s dog toys were not protected under *Rogers*, this Court would have to confront the clash between dilution by tarnishment and its holdings in *Tam* and *Brunetti*.

Dilution by tarnishment is, according to the statute, “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark,” 15 U.S.C.

§ 1125(c)(2)(C), even in the absence of confusion. However, the First Amendment constrains Congress’s ability to restrict truthful, non-misleading speech—even speech that changes public opinion about another entity. As this Court explained:

[A] State may choose to regulate price advertising in one industry but not in others, because the risk of fraud (one of the characteristics of commercial speech that justifies depriving it of full First Amendment protection) is in its view greater there. But a State may not prohibit only that commercial advertising that depicts men in a demeaning fashion.

R.A.V. v. St. Paul, 505 U.S. 377, 388-89 (1992) (citations omitted).

Dilution claims, however, provide exactly this sort of protection for famous marks. Jack Daniel’s argues that dilution law allows it to prevent consumers from forming negative associations with or opinions about Jack Daniel’s. This is not just content-based suppression of speech, it is viewpoint-based suppression of speech—the prime evil against which the First Amendment protects.

In *Matal v. Tam*, 137 S. Ct. 1744, 1765 (2017), this Court unanimously held that the Lanham Act’s prohibition on registering disparaging trademarks, 15 U.S.C. § 1052(a), constituted unconstitutional viewpoint discrimination, regardless of the distinction between commercial and noncommercial speech. Like the

provision struck down in *Tam*, trademark law’s anti-dilution provision creates a content- and viewpoint-based rule that applies to truthful, non-misleading commercial speech. Dilution does not require any finding of falsity or deception. 15 U.S.C. § 1125(c)(1).

Tarnishment claims single out a subset of uses of a famous mark based on the views expressed by those uses. Use of a mark tarnishes only when it “harms the reputation of the famous mark.” 15 U.S.C. § 1125(c)(2)(C). Meanwhile, nonconfusing uses that reinforce the dignity of a trademark are not subject to suppression. *See Haute Diggity Dog, LLC*, 507 F.3d 252; *Starbucks Corp. v. Wolfe’s Borough Coffee Inc.*, 588 F.3d 97 (2d Cir. 2009). Like the disparagement bar, this is a “happy-talk” rule. *Tam*, 137 S.Ct. 1765 (opinion of Alito, J.);⁸ *see also Iancu v. Brunetti*, 139 S.Ct. 2294, 2299 (2019) (holding § 2(a)’s bar on registering “scandalous or immoral” trademarks unconstitutional because it “permits registration of marks that champion society’s sense of rectitude and morality, but not marks that denigrate those concepts”).

The fact that §2(a) targeted disparaging marks was enough to make the provision viewpoint-based even though that provision was more evenhanded in prohibiting registration of marks that disparaged any group. Dilution by tarnishment claims provide special, extra protection for “famous” marks, targeting one set of viewpoints specifically—those that “harm[]

⁸ Notably, “disparage” and “tarnish” are synonyms. *See* https://www.powerthesaurus.org/disparage/synonyms/verb_tarnish.

the reputation of the famous mark.” 15 U.S.C. § 1125(c)(2)(C). “Giving offense is a viewpoint.” *Tam*, 137 S.Ct. at 1763.

Dilution by tarnishment claims impose greater restrictions on speech than did the disparagement bar, since dilution claims enable owners of famous marks to completely suppress nonconfusing uses that disparage the dignity of their marks (rather than simply denying them the benefits of registration). *Cf. Brunetti*, 139 S.Ct. at 2303 (Roberts, C.J., concurring) (noting that denial of registration “does not affect the extent to which their owners may use them in commerce to identify goods. No speech is being restricted; no one is being punished.”).

More generally, *Tam* and *Brunetti* recognized that trademarks can be used to communicate a message other than source designation. The Supreme Court made that observation with respect to a purported mark owner’s own use, but the same is true of others who “use” a mark owned by someone else. The Ninth Circuit’s opinion in this case was therefore consistent with principles of constitutional avoidance. If VIP’s Bad Spaniel toys are not shielded from liability, courts will need to confront directly the constitutionality of dilution by tarnishment.

Although many may consider VIP’s message “low-value,” this Court has rejected the concept that outsiders’ judgments of the worth of speech should control, outside narrow traditional categories. As this Court said, “we cannot indulge the facile assumption that one

can forbid particular words without also running a substantial risk of suppressing ideas in the process.” *Cohen v. California*, 403 U.S. 15, 26 (1971). The worth of even trivial parodies may be greater than they at first appear—or, at a minimum, courts are not the entities that should be judging the worth of their truthful, nonmisleading content. This Court has also emphasized that the traditional categories of unprotected speech cannot be expanded based merely on a legislature’s determination of the speech’s unworthiness. *See United States v. Stevens*, 559 U.S. 460, 469-70 (2010).

Tam confirmed that the government lacks a substantial interest in suppressing a message—commercial or not—merely out of fear that it might convince audiences to think differently, affecting the amount of attention and goodwill a trademark can command:

The commercial market is well stocked with merchandise that disparages prominent figures and groups, and the line between commercial and non-commercial speech is not always clear, as this case illustrates. If affixing the commercial label permits the suppression of any speech that may lead to political or social “volatility,” free speech would be endangered.

Tam, 137 S.Ct. at 1765 (opinion of Alito, J.).

Given the desirability of developing the application of *Tam* and *Brunetti* to dilution law through cases in the lower courts, this case does not warrant the

Court's review to correct any purported error in the application of dilution law to VIP.



CONCLUSION

The opinion below clearly reached the right result as a matter of trademark law for any number of reasons, consistent with other circuits' rules (the *Rogers* test) and results (protection for parody). Reaching that result the way it did, the court avoided having to confront the likely unconstitutionality of dilution by tarnishment under *Brunetti* and *Tam*. Given these considerations, this case does not merit certiorari.

Respectfully submitted,

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