

Docket No. 18-16012

In the
United States Court of Appeals
For the
Ninth Circuit

VIP PRODUCTS LLC, an Arizona limited liability company,

Plaintiff, Counter-Defendant and Appellant,

v.

JACK DANIEL'S PROPERTIES, INC., a Delaware corporation,

Defendant, Counter-Plaintiff and Appellee.

*Appeal from a Decision of the United States District Court for the District of Arizona,
No. 2:14-cv-02057-SMM · Honorable Stephen M. McNamee*

**BRIEF OF *AMICUS CURIAE* INTERNATIONAL TRADEMARK ASSOCIATION IN
SUPPORT OF APPELLEE JACK DANIEL'S PROPERTIES, INC.'S PETITION
FOR REHEARING AND PETITION FOR REHEARING *EN BANC***

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CORPORATE DISCLOSURE STATEMENT

Pursuant to Federal Rule of Appellate Procedure (“FRAP”) 26.1, *amicus curiae*, the International Trademark Association (“INTA”) states that it is not a publicly held corporation or other publicly held entity. INTA does not have any parent corporation, and no publicly held corporation or other publicly held entity holds 10% or more of INTA’s stock.

CERTIFICATIONS PURSUANT TO FED. R. APP. P. 29

Pursuant to FRAP 29(a)(2), *amicus curiae* certifies that all parties have consented to the filing of this brief. Additionally, in accordance with FRAP 29(a)(4)(E), *amicus curiae* states that this brief was authored solely by INTA and its counsel, and no part of this brief was authored by counsel to a party. No party or counsel for a party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amicus curiae* and its counsel made such a monetary contribution to its preparation or submission.

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STATEMENT OF INTEREST OF *AMICUS CURIAE*

Founded in 1878, INTA is a not-for-profit organization dedicated to the support and 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 regularly assist brand owners in the creation, registration, protection, and enforcement of their trademarks. INTA's members share the goal of promoting an understanding of the essential role that trademarks play in fostering informed decisions by consumers, effective commerce, and fair competition.

INTA's members are frequent participants – as plaintiffs, defendants, and advisors – in legal actions brought under the Lanham Act and, therefore, are interested in the development of clear, consistent, and equitable principles of trademark law. INTA has substantial expertise and has participated as *amicus curiae* in numerous cases involving significant Lanham Act issues.¹

¹ Cases in which INTA has filed *amicus* briefs include: *U.S. Patent & Trademark Office v. Booking.com B.V.*, 140 S. Ct. 489 (2019) (granting certiorari); *Romag Fasteners, Inc. v. Fossil, Inc.*, 139 S. Ct. 2778 (2019) (granting certiorari); *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); *LTTB LLC v. Redbubble, Inc.*, No. 19-16464 (9th Cir. pending); *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);

INTA (formerly known as the United States Trademark Association) was founded in part to encourage the enactment of federal trademark legislation after the invalidation on constitutional grounds of the United States' first trademark act. Since then, INTA has been instrumental in making recommendations and providing assistance to legislators in connection with almost all major federal trademark legislation including the Lanham Act, which is at issue in this appeal.

INTA's interest in this case is to ensure the proper application of (i) *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), and (ii) the Trademark Dilution Revision Act ("TDRA")'s noncommercial use exception, 15 U.S.C. § 1125(c)(3)(C).

ARGUMENT

Rogers established a test to balance trademark rights and free speech rights in the context of the title of an expressive work – in that case, a movie. Courts have subsequently applied *Rogers* to other expressive works – including songs, video games, and greeting cards – and to the content of those works as well as their titles. Prior to the panel's decision in this case, courts have always limited *Rogers* to cases involving the use of trademarks in expressive works, which is where First Amendment protection is warranted.

Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97 (2d Cir. 2009); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007). A full list of cases in which INTA has participated as *amicus curiae* over the last twenty years is available at <https://www.inta.org/Advocacy/Pages/Amicus.aspx>.

The panel's decision in this case improperly extends *Rogers* to the use of trademarks on any commercial good arguably having some "expressive" quality. That unprecedented expansion is inconsistent both with *Rogers* and with every other court to have applied *Rogers*.

The panel also misapplied the TDRA's noncommercial use exception when it concluded that use of Jack Daniel's Properties, Inc. ("JDPI")'s trade dress on a dog toy was noncommercial because "it does more than propose a commercial transaction." *VIP Prods. LLC v. JDPI*, 953 F.3d 1170, 1176 (9th Cir. 2020). Any such conclusion could be reached only after application of the multi-factor test set forth by the Supreme Court in *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66–67 (1983), which the panel failed to mention, let alone apply, in its two-paragraph analysis. The panel's conclusory analysis would authorize defendants to use famous marks on a wide array of commercial goods under the guise of parody, regardless of the potential dilutive effect the use may have on a brand owner's mark. Courts should decide cases involving asserted parodies on the merits of whether the defendant's use is confusing or dilutive under the Lanham Act. Resort to constitutional principles is unnecessary because, under the Lanham Act, courts and juries are likely to find many true parodies to be neither confusing nor dilutive.

The panel’s application of the law contradicts the law in other circuits. This case thus involves a question of exceptional importance, and the Court should grant JDPI’s petition for rehearing or rehearing *en banc*. FRAP 35(a)(2).

I. REHEARING SHOULD BE GRANTED BECAUSE THE PANEL’S EXPANSION OF *ROGERS* IS UNPRECEDENTED AND INCONSISTENT WITH OTHER CIRCUITS’ APPLICATION.

A. Origin of the *Rogers* Test.

Rogers involved a Fellini film about two fictional cabaret performers who imitated the renowned dancing duo Ginger Rogers and Fred Astaire. Rogers sued, *inter alia*, under the Lanham Act, arguing that the film’s title – *Ginger and Fred* – created the false impression that the film was about her or that she endorsed, sponsored, or was otherwise involved in the film.

Analyzing the Lanham Act claim, the district court framed the central inquiry as “identify[ing] the line between commercial and artistic speech,” concluding that, where the speech at issue is “artistic expression . . . not primarily intended to serve a commercial purpose, the prohibitions of the Lanham Act do not apply, and the [speech] is entitled to the full scope of protection under the First Amendment.” *Rogers v. Grimaldi*, 695 F. Supp. 112, 120–21 (S.D.N.Y. 1988). The court held that the film was artistic expression protected by the First Amendment and awarded the defendants summary judgment.

The Second Circuit affirmed, holding that the Lanham Act “should be construed to apply to artistic works *only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.*” *Rogers*, 875 F.2d at 998 (emphasis added). The court articulated a two-part test to strike that balance:

In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the [Lanham] Act unless the title has no artistic relevance to the underlying work whatsoever, or, 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 Second Circuit expressly distinguished between the title of an artistic work, which is entitled to First Amendment protection, and an “ordinary commercial product[],” which is not:

Though consumers frequently look to the title of a work . . . , they do not regard titles of artistic works in the same way as the names of 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.

B. Neither This Court, Nor Any Other Court of Appeals, Previously Has Applied *Rogers* to a Non-Expressive Commercial Good.

Courts, including this one, have heretofore limited application of *Rogers* to “artistic expression . . . not primarily intended to serve a commercial purpose,” *Rogers*, 695 F. Supp. at 120, which some courts describe in shorthand as

“expressive works.” This Court adopted *Rogers* “as its own” in *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002), which, like *Rogers*, involved the title of an artistic work: the song “Barbie Girl.” The Court reinforced the balance at the heart of *Rogers* between trademarks and free expression, noting: “Whatever first amendment rights you may have in calling the brew you make in your bathtub ‘Pepsi’ are easily outweighed by the buyer’s interest in not being fooled into buying it.” *Id.* at 900 (quoting Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. Rev. 960, 973 (1993)).

This Court again applied *Rogers* to artistic works in *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003), this time to a series of photographs entitled “Food Chain Barbie” that showed Barbie dolls in compromising positions and used the “Barbie” name in the photographs’ titles. The Court dismissed an infringement claim against the photographer because use of “Barbie” in the titles was “clearly relevant to [the artist’s] work” and “accurately describe the subject of the photographs, which in turn, depict Barbie and target the doll with [the photographer’s] parodic message.” *Id.* at 807.

This Court also has applied *Rogers* to such works as interactive video games, *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir.

2008) (also applying *Rogers* to the content, not just the title),² television shows, *Twentieth Century Fox Television v. Empire Distribution, Inc.*, 875 F.3d 1192, 1196–97 (9th Cir. 2017) (also applying *Rogers* to ancillary products used to market such shows; “it requires only a minor logical extension of the reasoning of *Rogers* to hold that works protected under its test may be advertised and marketed by name”), and, in at least some circumstances, to greeting cards, *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 268 (9th Cir. 2018) (recognizing that greeting cards “convey a particularized message,” but remanding for trial whether the *Rogers* test was satisfied on the facts) (quoting *Hilton v. Hallmark Cards*, 599 F.3d 894, 904 (9th Cir. 2010)).

The artistic works in all of those cases stand in sharp contrast to the product at issue here – a commercial dog toy. Until this case, this Court and other circuit courts all have limited *Rogers* to “indisputabl[e] works of artistic expression,” such as “[m]ovies, plays, books, and songs.” *Rogers*, 875 F.2d at 997. *Accord Lombardo v. Dr. Seuss Enters., L.P.*, 729 Fed.Appx. 131, 133 (2nd Cir. 2018) (play); *Radiance Found., Inc. v. N.A.A.C.P.*, 786 F.3d 316, 329 (4th Cir. 2015) (articles); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1248 (9th Cir. 2013) (video game); *Univ. of Alabama Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266,

² The application of *Rogers* to video games is consistent with the Supreme Court’s subsequent recognition that video games are expressive works that warrant First Amendment protection. *Brown v. Entm’t Merchants Ass’n*, 564 U.S. 786, 790 (2011).

1278–79 (11th Cir. 2012) (paintings);³ *Parks v. LaFace Records*, 329 F.3d 437, 451–52 (6th Cir. 2003) (songs); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65 (5th Cir. 2000) (magazines); *Twin Peaks Prods, Inc. v. Publ’ns Intern., Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (book title); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc.*, 886 F.2d 490, 494–95 (2d Cir. 1989) (book cover). The panel’s expansion of *Rogers* is an unprecedented departure from established law and disrupts the careful balance that *Rogers* struck.

C. Purportedly Parodic Commercial Goods Should Be Analyzed Under the Likelihood of Confusion Test, Not *Rogers*.

Given the balance that *Rogers* seeks to achieve, courts have recognized that *Rogers* “is usually not the appropriate mechanism for examining an ordinary commercial product.” *A.V.E.L.A., Inc. v. Estate of Marilyn Monroe, LLC*, 364 F. Supp. 3d 291, 321–22 (S.D.N.Y. 2019) (“the *Rogers* test is not designed to protect commercial products [here, Marilyn Monroe T-shirts] and . . . any First Amendment concerns are already addressed by the consumer confusion test”). Rather, “[t]he *Rogers* test applies *only* to artistic or expressive works. *Hush Hush Sound, Inc. v. H&M Hennes & Mauritz LP*, 2018 WL 4962086, at *3 (C.D. Cal.

³ In *Univ. of Alabama Bd. of Trustees*, the Eleventh Circuit’s ruling was limited to artistic paintings, which were protected by the First Amendment, and did not extend to the “mundane products” also at issue in the case, such as mugs, towels and T-shirts. Although the court held that appellant waived his argument regarding “mundane products” bearing copies of the painting, it noted that “the artistic work [on those products] is much less likely to have been considered significant by the purchaser.” 683 F.3d at 1282, n.42.

Jan. 26, 2018) (emphasis added) (*Rogers* “is not applicable to commercial works such as a traditional advertisement” or, as in this case, a sweater displaying a band’s CLASSIXX trademark).

Other courts have recognized, without discussing *Rogers*, that, although “free speech policies are involved” in cases concerning parody products, commercial goods are not entitled to full First Amendment protection. *World Wrestling Fed’n Entm’t, Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413, 431, 446 (W.D. Pa. 2003). That is because “the claim of parody is not really a separate ‘defense’ as such, but merely a way of phrasing the traditional response that customers are not likely to be confused.” *Id.* (quoting 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:153 (4th ed. 2002)).

With these principles in mind, courts confronted with commercial goods that claim to be parodies apply the traditional likelihood of confusion analysis, recognizing that a claim of parody may “influence[] the way in which the [likelihood of confusion] factors are applied.” *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007). In particular, if the parody is successful (*i.e.*, if consumers “get” the joke), there is no confusion. On the other hand, if the parody is unsuccessful, consumers may still be confused and liability should attach. *Cf. Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302 (N.D. Ga. 2008) (critic’s successful parody of Wal-Mart marks on website and

merchandise only “influences the way the likelihood of confusion factors are applied . . . [b]ecause even a parody may constitute trademark infringement if that parody is confusing”).

The panel’s citation to *Haute Diggity Dog* does not support its conclusion because *Haute Diggity Dog* was decided on likelihood of confusion grounds, and did not apply *Rogers*. It is true, as the panel noted, that the Fourth Circuit had not yet adopted *Rogers* at the time *Haute Diggity Dog* was decided, but *Rogers* had already been well-established precedent for nearly two decades. Moreover, when the Fourth Circuit did adopt *Rogers* eight years later, in *Radiance Foundation*, it did not hold either that (i) commercial goods are expressive works, or (ii) *Rogers* applies to them. Rather, the Fourth Circuit applied *Rogers* to a non-profit organization’s noncommercial use of the phrase “NAACP: National Association for the Abortion of Colored People” in the headline of an article that criticized the NAACP’s stance on abortion. Indeed, the Fourth Circuit expressly stated: “Titles, as part of expressive works, ‘require[] more protection than the labeling of ordinary’ goods.” *Radiance Foundation*, 786 F.3d at 329 (quoting *Rogers*, 875 F.2d at 998). The Fourth Circuit did not suggest, either in *Radiance Foundation* or *Haute Diggity Dog*, that commercial goods such as dog toys are the type of “artistic expression . . . not primarily intended to serve a commercial purpose,” *Rogers*, 695 F. Supp. at 120, that is entitled to First Amendment protection.

Far more relevant is the case involving the dog toy shown at right, *Anheuser-Busch, Inc. v. VIP Prods., LLC*, 666 F. Supp. 2d 974 (E.D. Mo. 2008). In that case, Anheuser-Busch alleged that VIP’s “Buttwiper” dog toys infringed and diluted its trade dress for Budweiser beer. The court recognized that the toys might be parody, but applied the customary likelihood of confusion analysis (not the *Rogers* test) to determine whether they were infringing. The court noted that “[p]arody is another factor to consider in determining the likelihood of confusion, and casts several of the [likelihood of confusion] factors in a different light.” *Id.* at 984–85 (quoting *Utah Lighthouse Ministry v. Found. for Apologetic Info. and Research*, 527 F.3d 1045, 1055 (10th Cir. 2008)). But, the court held, “*the 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 (emphasis added). After weighing the likelihood of confusion factors, the court found that Anheuser-Busch was likely to succeed on the merits and entered a preliminary injunction. *Id.* at 986.



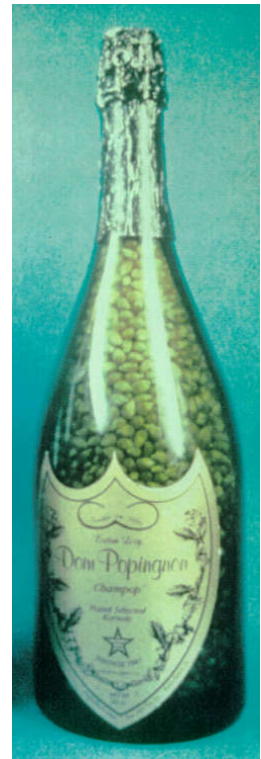
In another case involving dog products, Judge Mukasey held that First Amendment protection did not apply to “Timmy Holedigger,” a dog perfume that allegedly parodied the Tommy Hilfiger trademark, because the mark was being used “at least in part to promote a somewhat non-expressive, commercial product” and “trademark law permissibly regulates misleading commercial speech.” *Tommy Hilfiger Licensing Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 415 (S.D.N.Y. 2002). The court therefore applied the likelihood of confusion factors, “without recourse to the First Amendment.” *Id.* at 416.



Applying the likelihood of confusion factors to commercial products purporting to parody another’s trademark is the best way to separate the “confusing parodies” from the “non-confusing parodies.” *Anheuser-Busch, Inc.*, 666 F. Supp. 2d at 985. In some cases, that will result in a win for the parodist, such as in *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 674 Fed.Appx 16 (2d Cir. 2016), where the court found that a parody of Louis Vuitton’s handbag design (imprinted on an inexpensive canvas bag shown at right that suggested that the user’s “other bag” is a Louis Vuitton)



was not likely to cause confusion. In other cases, consumer confusion may appropriately be found, such as in *Schieffelin & Co. v. Jack Co. of Boca, Inc.*, 850 F. Supp. 232 (S.D.N.Y. 1994), where the court found confusion was likely because the parody was not so obvious that consumers would understand that “Dom Poppingnon” popcorn (shown at right) did not come from the makers of Dom Perignon champagne. Although these courts reached different conclusions, they reached those conclusions in the same way – by applying substantive trademark law principles to the commercial goods at issue, rather than *Rogers*.⁴



The panel’s application of *Rogers* to mundane dog toys – commercial products that are not fairly characterized as “artistic expression . . . not primarily intended to serve a commercial purpose” *Rogers*, 695 F. Supp. at 120, or goods that are “indisputabl[e] works of artistic expression,” such as “[m]ovies, plays, books, and songs,” *Rogers*, 875 F.2d at 997 – is thus wholly inconsistent with the way in which the test has been applied for the last three decades. It also

⁴ *Accord Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009) (coffee); *Anheuser-Busch, Inc., v. L. & L. Wings, Inc.*, 962 F.2d 316 (4th Cir. 1992) (T-shirts); *Knowles-Carter v. Feyonce, Inc.*, 347 F. Supp. 3d 217 (S.D.N.Y. 2018) (T-shirts); *DC Comics v. Mad Engine, Inc.*, 2015 WL 9122562 (C.D. Cal. 2015) (T-shirts); *MPS Entm’t, LLC v. Abercrombie & Fitch Stores, Inc.*, 2013 WL 3288039 (S.D. Fla. 2013) (T-shirts); *Heisman Trophy Trust v. Smack Apparel Co.*, 637 F. Supp. 2d 146 (S.D.N.Y. 2009) (T-shirts).

unnecessarily resorts to constitutional law principles. As Circuit Judge Leval has written:

When lawsuits pit claims of exclusive trademark right against interests of free expression, courts should not run unnecessarily to the Constitution. The governing statutes. . . are designed to balance the needs of merchants for identification as the provider of goods with the needs of society for free communication and discussion.

Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 Colum. J. L. & Arts 187, 210 (2004) (discussing, *inter alia*, the appropriate application of the *Rogers* test).

II. REHEARING IS WARRANTED BECAUSE THE PANEL’S RULING DEVIATES FROM THE SUPREME COURT’S TEST FOR NONCOMMERCIAL SPEECH

A. The TDRA’s “Noncommercial Use” Exception Is Analyzed the Same Way as Noncommercial Speech.

The TDRA excludes from liability “noncommercial use of a trademark.” 15 U.S.C. § 1125(c)(3)(C). The 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, at 8 (1995); *Mattel, Inc.*, 296 F.3d at 906 (discussing legislative history of Lanham Act’s anti-dilution provision).⁵

⁵ The TDRA includes a separate exception for “parodying . . . the famous mark owner or the goods or services of the famous mark owner.” 15 U.S.C.

The Supreme Court in *Bolger*, in the context of advertising, 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?

Bolger, 463 U.S. 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 with approval Justice Brennan’s concurrence in *Metromedia, Inc. v. City of San Diego*, 453 U.S. 490, 540 (1981), stating 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”).

The *Bolger* factors have been expanded to analyze whether a particular trademark use is “noncommercial” under the TDRA, such as in *Radiance Foundation*, where the Fourth Circuit applied the *Bolger* factors in analyzing the article at issue, and added an additional one: “‘the viewpoint of the listener’, i.e. whether the listener would perceive the speech as proposing a transaction.”

§ 1125(c)(3)(A)(ii). That exception does not apply here because VIP conceded it was not attempting to parody JDPI. *See* ER 2380.

Radiance Found., 786 F.3d at 331. The Fourth Circuit emphasized that no single factor is dispositive of whether the speech (or trademark use) is commercial. *Id.* at 332 (“The factors are cumulative, but, again, the absence of any particular element does not necessarily render the speech noncommercial.”).

B. The Panel Short-Circuited the Proper Analysis.

The panel found, as a matter of law, that the dog toy was noncommercial because it conveyed a “humorous message,” and therefore did “more than propose a commercial transaction.” *JDPI*, 953 F.3d at 1176. That analysis, ignores the other *Bolger* factors and is not an appropriate holding for the panel to make without more; rather, at best, that might be a conclusion that follows from a proper application of the *Bolger* test, modified as appropriate for the context of a dog toy.

An example of a case that properly applied the *Bolger* analysis involved a denial by the New York State Liquor Authority of an application for a beer label that contained 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). In that case, the Second Circuit applied the *Bolger* factors (albeit in a context other than a dilution claim) and held that the label, although it contained some expressive elements, was commercial speech and was not fully protected by the First Amendment:

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 *Bad Frog Brewery* court did in relation to beer, the Court in this case should apply the *Bolger* factors with reference to the district court’s factual findings related to the dog toy, rather than conclude on its own that the toy made noncommercial use of JDPI’s trade dress that, therefore, immunized it against a dilution claim.

III. THE PANEL’S DECISION PUTS BRAND OWNERS’ MARKS AT RISK.

The panel’s holding that commercial goods may be expressive works that warrant the full protection of the First Amendment has the potential to exempt from trademark infringement liability any product that employs a modicum of creative expression on packaging or on the products themselves. That risk is exacerbated by this Court’s recognition that “the level of [artistic] relevance [to the

underlying work] merely must be above zero” to entitle a work to protection under the first prong of the *Rogers* test. *E.S.S. Ent'mt* 547 F.3d at 1100.

Moreover, under the panel’s analysis, simply incorporating some humorous element or applying the label of “parody” to a commercial good that uses another’s trademark will immunize that product from infringement and dilution liability even if the use causes confusion with, or harm to, another’s trademark. Such a result would undercut the very purpose of the Lanham Act. That not only would create risk to brand owners that have worked hard to build goodwill in their brands, but also could cause rampant consumer confusion in the marketplace. The panel’s expansive application of *Rogers* threatens to make this new iteration of the *Rogers* test the exception that swallows the likelihood of confusion standard that has been applied in trademark infringement cases for nearly a century.

CONCLUSION

For the foregoing reasons, the Court should grant JDPI's petition for rehearing or rehearing *en banc*.

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The undersigned hereby certifies that on April 22, 2020, an electronic copy of the Brief of amicus curiae International Trademark Association was filed with the Clerk of the Court for the United States Court of Appeals for the Ninth Circuit by using the CM/ECF system. The undersigned also certifies that all participants are registered CM/ECF users and will be served via the CM/ECF system.

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