

No. 22-148

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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 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 NEITHER PARTY**

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***AMICUS CURIAE* BRIEF OF THE  
INTERNATIONAL TRADEMARK ASSOCIATION  
IN SUPPORT OF NEITHER PARTY**

The International Trademark Association (“INTA”) submits this brief in support of neither party.<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. With more than 6,500 member organizations from 185 countries, INTA’s members share the goal of promoting the essential role that trademarks play in fostering informed decisions by consumers and fair competition.

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 participated as *amicus curiae* in numerous cases on significant Lanham Act issues, including on the First Amendment.<sup>2</sup>

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1. Counsel for *amicus curiae* INTA certifies that no party or counsel for a party authored this brief in whole or in part, 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.

2. Cases in which INTA has filed amicus briefs since 2000 include: *Abitron Austria GmbH et al. v. Hetronic Int’l, Inc.*, No.

INTA was founded in part to encourage enactment of federal trademark legislation after the invalidation 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 at issue in this appeal.

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21-1043; *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 141 S. Ct. 1054 (2020); *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); *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138 (2015); *Hana Fin., Inc. v. Hana Bank*, 574 U.S. 418 (2015); *Pom Wonderful LLC v. Coca-Cola Co.*, 573 U.S. 102 (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); *Vans, Inc., et al. v. MSCHF Product Studio, Inc.*, Case No. 22-1006-cv (2d Cir. Pending); *LTTB LLC v. Redbubble, Inc.*, 840 Fed. Appx. 148 (9th Cir. 2021); *Ohio State Univ. v. Redbubble, Inc.*, 989 F.3d 435 (6th Cir. 2021); *VIP Prods. LLC v. Jack Daniel's Props., Inc.*, 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); *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).

At its core, trademark law is about protecting consumers. Trademarks enable consumers to identify the source of products and services and are crucial indicators of quality. INTA therefore seeks to protect the interests of consumers and brand owners alike. As applied to this case, INTA's principal interest is in promoting the appropriate balance between trademark law and the First Amendment.

INTA advocates for a balance of free speech with consumer protection. For example, in its amicus briefs in *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) and *Matal v. Tam*, 137 S. Ct. 1744 (2017), INTA supported First Amendment rights to register marks that are scandalous or disparaging; while in its amicus brief in *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007), INTA argued that parodies that use another's trademark on ordinary commercial products as the defendant's own brand should be examined under traditional trademark principles to assess whether they confuse consumers or dilute the plaintiff's famous mark. INTA also supported the addition of the fair use defense in Section 43(c)(3)(A) of the Lanham Act, 15 U.S.C. § 1125(c)(3)(A).

In this case, INTA takes no position on whether the Respondent's dog toy is infringing or diluting. Those issues are better decided on the facts. Nor is INTA taking the position—argued by Petitioner Jack Daniel's Properties, Inc. (“Petitioner” or “JDPI”)—that a heightened First Amendment standard of some kind is *per se* improper in all circumstances. INTA does, however, take a position on the correct analytic framework to determine whether heightened First Amendment protection is potentially



applicable. To the extent this Court determines certain circumstances warrant a departure from long-standing and established likelihood of confusion analysis, INTA urges this Court to provide guidance on the definition of the types of works that warrant such a departure. Specifically, INTA suggests that the Court adopt a definition for “expressive work” under the test for heightened First Amendment protection set forth in *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (“*Rogers*”), or whatever test this Court may adopt. Under the definition proposed by INTA, or any other definition the Court adopts, the Respondent VIP Products LLC’s (“Respondent” or “VIP”) dog toy should not qualify for heightened First Amendment protection.

Regarding dilution, this Court should confirm that this Court’s *Bolger* test should have been applied to determine whether the dog toy is a “noncommercial use” under the TDRA, and remand for further proceedings on these claims.

### SUMMARY OF ARGUMENT

Although never addressed by this Court, the *Rogers* test and its application of heightened First Amendment protection in circumstances involving artistically expressive works has been adopted by every Circuit Court to consider the issue. Therefore, INTA asserts the test itself need not be addressed in this case. But by expanding the reach of *Rogers* beyond the artistically expressive works (e.g., movies, art, or books) for which the Second Circuit created the test, the Ninth Circuit’s error below sets dangerous precedent that could upend nearly a century of trademark jurisprudence. The Ninth Circuit’s overexpansion of the *Rogers* test to ordinary

commercial products highlights the need for a definition for what constitute “expressive works” to determine when heightened First Amendment protection should apply.

Therefore, INTA proposes that the Court define the types of products that qualify as “expressive works” for such heightened First Amendment protection when assessing trademark infringement claims against those products. Specifically, INTA urges this Court to define “expressive works” as those products where expression is inextricably intertwined with the product itself such that the product cannot exist without expression, *i.e.*, that the expression is conceptually inseparable from the product. For example, because a novel cannot function as a novel if it is completely devoid of expressive content, it would qualify as an “expressive work.” In contrast, a coffee mug can still function as a coffee mug (or a dog toy can still function as a dog toy) even without any expressive content and, thus, would not qualify as an “expressive work” for the purposes of applying heightened First Amendment protection.

This definition seeks to balance the interests of consumers and trademark holders to avoid confusion in the marketplace with the First Amendment protections afforded creators of expressive works that incorporate the trademarks of others. Infringement claims involving ordinary commercial products that contain some expression can be, and have been, successfully addressed through traditional trademark principles, which themselves already afford protections for free expression. INTA’s proposed definition of “expressive works” further ensures that courts will be able to readily distinguish trademark infringement claims that are appropriately resolved under traditional trademark principles from those that may

merit heightened First Amendment protection.

With respect to the Ninth Circuit's determination that the dog toy at issue qualified as noncommercial speech under the TDRA, the Ninth Circuit's perfunctory, two-paragraph analysis failed to apply this Court's noncommercial speech test set out in *Bolger*. It should have. INTA urges this Court to clarify the standard for that determination and remand with instructions to carry out that analysis.

## ARGUMENT

### I. THE NINTH CIRCUIT ERRED WHEN IT APPLIED HEIGHTENED FIRST AMENDMENT PROTECTION TO A CLAIMED TRADEMARK INFRINGEMENT BY AN ORDINARY COMMERCIAL PRODUCT BECAUSE IT ALLEGEDLY CONTAINED SOME EXPRESSION.

This Court has never analyzed whether certain fact patterns warrant a departure from the long-standing likelihood of confusion tests applied by the various Circuit Courts to provide a heightened level of First Amendment protection where the defendant's product in question allegedly contains expression that incorporates another's trademark.<sup>3</sup> The Second Circuit's *Rogers* test, which was

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3. INTA further notes that this Court has also never announced a specific test for infringement of trademarks. However, this Court has acknowledged without criticism (rather, with tacit acceptance) that the various Circuit Courts apply variations of a multi-factor likelihood of confusion test. See, e.g., *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 154 (2015) (referring to Eighth Circuit's use of multi-factor test set forth in *Squirt Co v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir.

first announced in 1989, has been adopted by every Circuit Court to consider it. As such, INTA posits that the *Rogers* test and its application in narrow circumstances involving artistically expressive works need not be addressed in this case.

Given the consistent adoption of *Rogers* by the Circuit Courts, INTA takes no issue with the Ninth Circuit's general acceptance and adoption of the *Rogers* test under certain limited circumstances. INTA posits, however, that the Ninth Circuit should not have applied *Rogers* in this particular case. Specifically, the Ninth Circuit's overexpansive view of what constitutes an "expressive work" represents a grave departure from trademark law in other Circuit Courts that risks upending decades of trademark precedent.

INTA submits this brief to provide its view, and that of its thousands of trademark owner members, that if this Court concludes some circumstances warrant a departure from the established likelihood of confusion analysis, such a test should apply only to "expressive works," not ordinary commercial products. To provide guidance on what constitutes such an "expressive work" as opposed to an ordinary commercial product, INTA proposes a definition, in Section III, *infra*, to act as gatekeeper for which cases warrant a departure from nearly a century of likelihood of confusion jurisprudence.<sup>4</sup>

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1980)). INTA asserts that the Circuit Courts' multi-factor tests, which are all very similar, are established law and need not be disturbed. Moreover, analysis of the propriety of such multi-factor tests is beyond the grant of *certiorari* in this case.

4. Petitioner's brief argues that the creation of the *Rogers* test in the first place was contrary to the statutory language for

Before doing so, however, INTA analyzes the origins of *Rogers*, the Ninth Circuit’s overly broad interpretation of what constitutes an “expressive work” in the proceedings below, and the limited circumstances in which other circuits have applied heightened First Amendment protections under *Rogers*. This discussion underscores that the *Rogers* test is a limited exception to traditional trademark infringement law. As discussed below, the *Rogers* test is properly reserved for artistically expressive works of the kind that gave rise to the *Rogers* test in the first place, not ordinary commercial products.

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claims under Lanham Act Sections 32 and 43 (15 U.S.C. §§ 1114, 1125), which impose liability for unauthorized use of a mark that “is likely to cause confusion, to cause mistake, or to deceive.” More specifically, Petitioner argues that this plain language does not contemplate different treatment for “expressive” works, and that the Second Circuit thus erred by “appl[ying] a balancing test of its own creation.” This argument proves too much. While INTA recognizes that the plain language of the Lanham Act does not expressly articulate a test for heightened First Amendment protection in certain contexts, neither does that plain language expressly articulate the multi-factor likelihood of confusion tests applied by each Circuit Court of their “own creation” for decades. Those tests, as noted in Footnote 3, *supra*, are settled law and have been at least tacitly approved by this Court. Thus, the mere absence of specific statutory language concerning heightened First Amendment protection is not dispositive of whether such a standard can exist under the Lanham Act’s plain language. The key issue in this case—and the source of the Ninth Circuit’s error below—is overestimating the limited types of products that warrant a departure from traditional likelihood of confusion analysis in favor of heightened First Amendment protection. If this Court adopts a test for heightened First Amendment protection, it should narrowly limit such protection to those products where expression is inextricable from the product itself.

**A. The *Rogers* Test Was Originated to Provide Heightened First Amendment Protection Only to Artistically Expressive Works Such as Movies, Books, and Art.**

The circumstances that led the Second Circuit to create the *Rogers* test illustrate the narrow situations to which the test should apply. The *Rogers* test was developed to resolve a specific problem: to shield the authors of artistically expressive works from being unduly limited in their artistry and expression due to an individual's rights under the Lanham Act. *Rogers* involved a Federico 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 Ginger Rogers 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 district court ruled that the film was artistic expression protected by the First Amendment and awarded the defendant 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 v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (emphasis added). The Second Circuit then 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 court then 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.

Later, in *Twin Peaks Products, Inc. v. Publications International, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993), a

trademark infringement case, the Second Circuit clarified its *Rogers* test by explaining that the second prong of the test (the “explicitly misleading” prong) involves application of the *Polaroid* likelihood of confusion factors,<sup>5</sup> but that the finding of likely confusion “must be particularly compelling” to outweigh a defendant’s First Amendment interest. Thus, the context matters for evaluating consumer 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.” *Twin Peaks Prods., Inc.*, 996 at 1380.

The decisions in *Rogers* and *Twin Peaks* establish that heightened First Amendment protection is merited only in limited circumstances, where artistically expressive works (e.g., movies and books) incorporate another’s name or trademark. Because consumers do not encounter marks in such artistically expressive works in the same way they do when purchasing an ordinary commercial product in the marketplace, the enhanced First Amendment protections of *Rogers* are more appropriate.

In the context of the commercial speech associated with the purchase of an ordinary commercial product, however, the risk of consumer confusion is greater and the heightened free speech protections of *Rogers* are likely to improperly shield infringing conduct. As discussed below, the Ninth Circuit’s inappropriately expansive interpretation of what constitutes an “expressive work”

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5. See *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961).



represents a significant, and dangerous, outlier that improperly extends *Rogers* well beyond the limited circumstances that it was created to address.

**B. The Ninth Circuit Overbroadly Defined an “Expressive Work” as Any Product that Contains Any Expression.**

In its first decision on the parties’ cross motions for summary judgment, the district court held that Respondent’s dog toy “is not an expressive work” and that the *Rogers test* did not apply because it only applies to artistic (*i.e.*, expressive) works such as movies, plays, books, and songs. *VIP Prods. LLC v. Jack Daniel’s Prods., Inc.*, 2016 WL 5408313, at \*5 (D. Ariz. Sept. 27, 2016). The district court explained that “the First Amendment affords no protection to VIP because it is trademark law that regulates misleading commercial speech where another’s trademark is used for source identification in a way likely to cause consumer confusion.” *Id.* Thus, the district court ruled the “standard trademark likelihood of confusion analysis, not *Rogers*, is appropriate.” *Id.* (citing *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979)<sup>6</sup>, *abrogated on other grounds by Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003)).

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6. In *Sleekcraft*, the court held that the factors relevant to a determination whether a defendant’s use constitutes trademark infringement include (1) the strength of the plaintiff’s mark, (2) the proximity of the parties’ goods in the marketplace; (3) the similarity of the parties’ marks; (4) evidence of actual confusion; (5) marketing channels used by the parties; (6) the type of goods at issue and the degree of care likely to be exercised by the purchaser; (7) the defendant’s intent in selecting the mark; and (8) the likelihood of expansion of the parties’ product lines. 599 F.2d at 348-349.

Following a four-day bench trial, the district court found in favor of JDPI and issued a permanent injunction enjoining VIP from manufacturing and selling the dog toy. *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 291 F. Supp. 3d 891 (D. Ariz. 2018).

On appeal, the Ninth Circuit held that the district court erred in finding that the dog toy was not an expressive work. The court explained that “[a] work need not be the expressive equal of *Anna Karenina* or *Citizen Kane*” to be considered expressive; nor is a work “rendered non-expressive simply because it sold commercially.” *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170, 1175 (9th Cir. 2020) (citations and quotation marks omitted). Rather, “[i]n determining whether a work is expressive, we analyze whether the work is ‘communicating ideas or expressing points of view.’” *Id.* at 1174 (quoting *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002)). The court observed that it recently had “little difficulty” concluding that greeting cards containing trademarked phrases were expressive works entitled to First Amendment protection, even though they did not show great “creative artistry.” *Id.* Although the court acknowledged that the dog toy “surely [is] not the equivalent of the Mona Lisa,” it found that the dog toy is nevertheless an expressive work because “it ‘communicates a humorous message.’” *Id.*

Accordingly, the Ninth Circuit held that the district court should have applied heightened First Amendment protection under *Rogers*, analyzing whether VIP’s use of JDPI trademarks and trade dress either (1) is “not artistically relevant to the underlying work,” or (2) “explicitly misleads consumers as to the source or content

of the work.” *Id.* at 9 (citation omitted). The Ninth Circuit vacated the district court’s finding of infringement and remanded for a determination, in the first instance, of whether JDPI could satisfy either element of the *Rogers* test. *Id.*

On remand, VIP again moved for summary judgment on JDPI’s trademark and trade dress infringement claims, which the district court granted after applying the *Rogers* test as formulated by the Ninth Circuit. *VIP Prods. LLC v. Jack Daniel’s Prods., Inc.*, No. CV-14-02057-PHX-SMM, 2021 WL 5710730, at \*6 (D. Ariz. Oct. 8, 2021), *aff’d*, No. 21-16969, 2022 WL 1654040 (9th Cir. Mar. 18, 2022), cert. granted, 143 S. Ct. 476 (2022). However, the district court expressed its strong view that the Ninth Circuit’s jurisprudence applying the *Rogers* test has led to an untenable situation where any expression is artistically relevant to the product and the “explicitly misleading” standard under *Rogers*, which supplants the likelihood of confusion test, excuses any unauthorized use but the most egregious of infringements. *Id.*

The district court did not focus on the ordinary-commercial-product-versus-“expressive work” dichotomy but rather made these comments as a general criticism of the Ninth Circuit’s jurisprudence applying *Rogers*, and suggested JDPI’s or others’ only recourse was to to seek relief from this Court or Congress. *Id.* (“[W]hile JDPI finds the depiction of a dog relishing a bowel movement on a carpet distasteful and an abuse of its mark, in the final analysis, JDPI has no means to protect the viability of its trademark. Yet, the Court is bound by Ninth Circuit precedent. For JDPI or similarly situated trademark holders to obtain a different outcome, they must seek relief

before the United States Supreme Court or the United States Congress.”).

INTA expresses no view here on the manner in which the Ninth Circuit applies the *Rogers* test but rather asserts that the court’s error below lies with *when* it applies the test in the first place. The Ninth Circuit’s overbroad interpretation of what constitutes an expressive work—to encompass essentially any product that is claimed to have some discernable expression in it—ensures that any defendant can claim expression in an otherwise infringing product to benefit from heightened First Amendment protection and shield itself from trademark liability. This overly broad interpretation of “expressive works” risks toppling decades of trademark precedent.

As discussed below, the Ninth Circuit is the only Circuit Court to expand *Rogers* to an ordinary commercial product. This Court should reverse and adopt a more appropriate definition of “expressive work” if it chooses to carve out an exception from traditional trademark law that provides heightened First Amendment protections where the defendant has used another’s trademark on its product.

**C. No Other Circuit Has Applied *Rogers* to Ordinary Commercial Products, Even if They Contain Some Expression.**

In contrast to the Ninth Circuit’s inappropriate expansion of *Rogers* well beyond its origins, other Circuit Courts have consistently reserved the heightened protections of *Rogers* to artistically expressive works. Specifically, other circuit courts 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) (plays); *Radiance Found., Inc. v. N.A.A.C.P.*, 786 F.3d 316, 329 (4th Cir. 2015) (articles); *Univ. of Alabama Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1278–79 (11th Cir. 2012) (paintings);<sup>7</sup> *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 Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (book titles); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc.*, 886 F.2d 490, 494–95 (2d Cir. 1989) (books). No other circuit, other than the Ninth Circuit, has applied *Rogers* to ordinary commercial products.

As a result, in the Ninth Circuit, but nowhere else, any seller of an ordinary commercial product who uses a humorous message with another’s mark can avoid traditional trademark infringement examination so long as the mark has some minimally artistic relevance to the product—a standard the Ninth Circuit has lowered to anything “above zero,” *E.S.S. Ent’mnt 2000 Inc. v. Rock Star Videos Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008). The Ninth Circuit’s expansion of *Rogers* is therefore

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7. In *Univ. of Alabama Bd. of Trustees*, the Eleventh Circuit’s holding 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.

an unprecedented departure from established law and disrupts the careful balance struck by traditional trademark principles. Moreover, as discussed below, traditional trademark principles provide significant First Amendment protections for the parodist or commenter without sacrificing consumers' interests in avoiding confusion in the marketplace or unnecessary resort to Constitutional principles.

**D. Traditional Trademark Law Already Provides Protections for First Amendment-Protected Expression Incorporated Into Ordinary Commercial Products.**

Rejecting the Ninth Circuit's unduly expansive view of what constitutes an "expressive work" will not deprive companies of their ability to incorporate expression in their products. Indeed, parodists and commenters who wish to incorporate expressive content that incorporates another's trademark into ordinary commercial products are not without a defense under traditional trademark principles.

For example, 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), confusion is not likely. On the other hand, if the parody is unsuccessful, consumers may still be confused, and liability may attach. *See, e.g., Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1317 (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.”).

Given the balance between commerce and free expression that traditional trademark law 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,” and “is not applicable to commercial works such as traditional advertising” or the defendant’s commercial products bearing a plaintiff’s trademark. *Hush Hush Sound, Inc. v. H&M Hennes & Mauritz LP*, 2018 WL 4962086, at \*3 (C.D. Cal. Jan. 26, 2018)(emphasis added). Other courts have recognized, without discussing *Rogers*, that although “free speech policies are involved” in cases concerning parody products, commercial products 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 and 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)).

Notably, parodists and commenters often win even without the heightened protections of *Rogers*. *See, e.g.*,

*Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 674 Fed. Appx. 16, 18 (2d Cir. 2016); *Louis Vuitton Malletier S.A.*, 507 F.3d at 263; *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 967 (10th Cir. 1996); *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1491 (10th Cir. 1987). With respect to ordinary commercial products, a plaintiff in a trademark infringement suit still must carry its burden to demonstrate a likelihood of confusion, which is a fact-intensive analysis suffused with principles of equity. Indeed, applying the traditional likelihood of confusion factors to ordinary 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. v. VIP Prods. LLC*, 666 F. Supp. 2d 974, 984-86 (E.D. Mo. 2008).

Moreover, avoiding the Constitutional issues presented by *Rogers*, where traditional trademark principles provide ample First Amendment protection, better balances trademark rights with free expression.<sup>8</sup> 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

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8. *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).



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). In the context of ordinary commercial products that contain expression incorporating another's mark, traditional trademark likelihood of confusion analysis strikes the correct balance between that expression and trademark rights.

## **II. THIS CASE PROVIDES AN OPPORTUNITY TO CORRECT A LEGAL ERROR AND TO CLARIFY WHEN THE *ROGERS* “EXPRESSIVE WORK” TEST APPLIES.**

### **A. Providing a Definition of an “Expressive Work” Under *Rogers* Will Lead to Greater Certainty in Applying Trademark Law.**

This Court should take this opportunity to settle the scope of *Rogers* by clarifying when it applies. If the bar for application of *Rogers* were, as the Ninth Circuit suggests, that a product merely “communicat[es] ideas or express[es] points of view,” then every case in which courts rejected application of *Rogers* to ordinary commercial products would have been wrongly decided. That is an untenable position to maintain. Applying the heightened First Amendment protections under *Rogers* to an ordinary commercial product such as a dog toy that also contains some expressive content would render it

“nearly impossible for any trademark holder to prevail under the *Rogers* test” unless the defendant is “slapping another’s trademark on [its] own work and calling it [its] own.” *VIP Products*, 2021 WL 5710730 at \*6. This would subvert the dual purposes of the Lanham Act, “to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.” *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) (citing S. Rep. No. 1333, at 3, 5).

INTA therefore urges this Court to adopt the definition of “expressive work” suggested in Section III, *infra*. Adopting such a definition of an “expressive work” to determine when *Rogers* properly applies will provide significantly greater certainty in cases involving expression on ordinary commercial products that uses another’s trademark or trade dress.

The dangers of the Ninth Circuit’s overapplication of *Rogers* have already surfaced, with manufacturers of commercial products arguing their products are “expressive works” to avoid the rigors of the traditional likelihood of confusion multi-factor tests. *See, e.g., Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 2022 WL 1446681, \*7 (E.D.N.Y. April 29, 2022) (manufacturer of shoe incorporating trademark and trade dress of iconic shoe made by well-known shoe and apparel company argued that the Ninth Circuit’s JDPI decision below should shield it from trademark liability because of its alleged expression); *see also Caryn Mandabach Prods. Ltd. v. Sadlers Brewhouse Ltd.*, 2021 WL 2497928, \*1-2 (C.D. Cal. May 19, 2021)(defendant brewery claimed its beer using plaintiff’s PEAKY BLINDERS mark from hit television

show was an “expressive work” necessitating application of *Rogers* under Ninth Circuit precedent).<sup>9</sup> In addition, adopting the Ninth Circuit’s low threshold for applying heightened First Amendment protection under *Rogers* would have yielded diametrically opposite holdings in many cases that eschewed *Rogers* and instead found likely consumer confusion under traditional trademark analysis.

Defining a *Rogers*-eligible expressive work as any product containing any expression is further untenable because it opens virtually every category of product to heightened First Amendment protection. It is hard to envision a product that cannot in some way convey a message, and therefore be an “expressive work” under the Ninth Circuit’s definition. Consider the tens of thousands of utilitarian products (e.g., clothing, mugs, bags, phone cases, jewelry, electronics, stickers, and housewares) capable of bearing some imprinted message on the products themselves, as well as standard packaging containing “trademark spaces” designed to bear messaging (e.g., labels and box panels). The Ninth Circuit’s overbroad application of *Rogers* to commercial products fails to strike the proper balance between trademark law and the First Amendment. The overapplication of heightened First Amendment protection to ordinary commercial products will, over time, lead to innumerable purported commercial parodies that will confuse consumers and erode the capacity of trademarks to effectively signal source and quality.

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9. The *Vans, Inc. v. MSCHF Product Studio, Inc.* action is currently on appeal before the Second Circuit. The Second Circuit has stayed the appeal pending the outcome of JDPI’s appeal in this case. *Vans, Inc. v. MSCHF Product Studio, Inc.*, Case No. 22-1006 (2d Cir. December 15, 2022).

This Court should therefore articulate a clear definition of “expressive work.”

**III. AN “EXPRESSIVE WORK” IS ONE IN WHICH  
EXPRESSION IS INEXTRICABLE FROM THE  
PRODUCT.**

The *Rogers* court implied that in an expressive work, the artistic expression is inextricably intertwined with the product itself. *See Rogers*, 875 F.2d at 998 (“The artistic and commercial elements of titles are inextricably intertwined.”). Put another way, if the entirety of the creator’s expression is removed from a movie or song, no underlying product remains that is recognizable as being in the same genus as the original—*i.e.*, blank movies and blank songs do not exist. If all expression is removed from a greeting card, only paper remains, which is not the original product. INTA therefore asserts that an “expressive work” is one where the expression cannot be removed from the product without it ceasing to be the same product. An “expressive work” is therefore one where expression is conceptually inseparable from the product itself.

In contrast, upon removal of the expression from a dog toy (or sneaker, coffee mug, tote bag, or water bottle), a product recognizable as the same genus as the original product remains (namely, a dog toy, sneaker, coffee mug, tote bag, or water bottle). This separability suggests that consumers perceive both the expressive content and the underlying product, and therefore may perceive the expressive content as potentially signifying origin of the product. Accordingly, traditional trademark principles are best suited to determine whether consumers perceive

the expression as designating the source of that product to such an extent that it infringes the trademark owner's rights in the mark.

INTA is careful to note that its proffered definition should not ask whether the specific expression at issue (or some subset of it) can be extracted. Instead, the question is whether the *type of product* can exist without all the expressive content within it. For example, in *Rogers*, INTA's suggested definition of an "expressive work" would not ask whether the title could be removed while still remaining a movie (it, of course, could) but rather whether all expression could be removed from the movie without nullifying the product itself. In that case, the *Ginger & Fred* movie, stripped of all expression, would yield no product at all. Thus, in the case of *Rogers*, the expression was inextricable from the type of product at issue.

By contrast, here, the product in question is a dog toy. Stripping all the expression from a dog toy would still yield a functional dog toy. Traditional trademark principles—like those applied by the numerous decisions cited in Sections I.C. and I.D., *supra*—provide the better rubric for balancing both trademark rights and First Amendment protections where the product is not an "expressive work," as INTA defines it.

INTA takes no position on how such a traditional trademark analysis should be resolved in this case but asserts that its proposed definition of "expressive work" will provide greater clarity for courts and litigants where a product containing some expression incorporates another's trademark. INTA therefore urges this Court to define "expressive works" as those in which expression and

the product itself cannot be separated without nullifying the product itself.

**IV. THE NINTH CIRCUIT’S DILUTION ANALYSIS DISREGARDS THE STATUTORY FRAMEWORK OF 15 U.S.C. § 1125(c)(3) AND THIS COURT’S JURISPRUDENCE ON NONCOMMERCIAL SPEECH.**

**A. The Ninth Circuit Did Not Apply or Consider the TDRA’s Parody Exception.**

The Court should confirm that its 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 where a defendant does not use the plaintiff’s mark as a designation of source of the defendant’s own goods. 15 U.S.C. § 1125(c)(3)(A)(ii).

The Ninth Circuit did not apply the parody exclusion, even though Respondent claimed to be engaging in a parody of JDPI’s trademark and trade dress. *VIP Products*, 953 F.3d at 1176. Presumably this was because Respondent was clearly using JDPI’s trademark and trade dress as a source identifier of Respondent’s own goods, so that exception to trademark dilution liability was unavailable under the plain language of the statute. Instead, the Ninth Circuit applied the exclusion for noncommercial uses. It held, without substantive analysis, that the dog toy is

noncommercial because Respondent’s humorous message “is protected by the First Amendment.” *Id.*

**B. The Ninth Circuit Failed to Apply the *Bolger* Test for Determining Noncommercial Speech.**

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 first assess whether the use at issue qualifies as noncommercial.

This Court in *Bolger v. Youngs Drug Prods. Corp.*, 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.

463 U.S. 60. 66-67 (1983). This 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 under similar circumstances and added one more factor: “the viewpoint of the listener’, *i.e.*, whether the listener would perceive the speech as proposing a transaction.” *Radiance Foundation v. NAACP*, 786 F.3d 316, 331 (4th Cir. 2015).

Here, 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.” *VIP Products*, 953 F.3d at 1176. The Ninth Circuit’s opinion ignores the *Bolger* factors and improperly shortcuts the analysis of whether Respondent’s use of Petitioner’s trademarks and trade dress is “commercial.”

An example of the *Bolger* case’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 a beer label in *Bad Frog Brewery*, the Ninth Circuit should have done with the dog toy here: apply the *Bolger* factors with reference to the district court’s factual findings, rather than summarily concluding that the toy made noncommercial use of Petitioner’s trademarks and trade dress.

Applying *Bolger* would not deprive Respondent of protections afforded by the TDRA. Just as the likelihood of confusion test is flexible enough to allow for appropriate results in different cases, so too is the statutory dilution

framework. In *Louis Vuitton Malletier, S.A. v. Haute Diggity Dog, LLC*, for example, the Fourth Circuit resolved a claim of dilution by dog toys via parody *in the parodist's favor*. 507 F.3d at 267-68. It did so solely by reference to the TDRA, without relying on 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, however, courts have enjoined purported 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”); *cf. Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1192–93 (E.D.N.Y. 1972) (enjoining poster in Coca-Cola trade dress that said ENJOY COCAINE under New York State's anti-dilution statute). The Ninth Circuit's absolutist approach, which renders any product noncommercial if it includes some arguably expressive element, lacks any such balance.

**C. Resort to Constitutional Principles, Rather than Traditional Trademark Principles, Was Unnecessary to Resolve this Dispute.**

The Ninth Circuit not only failed to apply *Bolger*, but also unnecessarily resorted to the First Amendment, just as it did in inappropriately applying *Rogers* to JDPI's infringement claims. 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.”).

Accordingly, this Court should reverse the Ninth Circuit’s decision below with instructions to apply *Bolger* to determine if the dog toy qualifies as non-commercial speech under the TDRA.

## CONCLUSION

For the foregoing reasons, INTA asks this Court to reverse the Ninth Circuit’s decision below applying the *Rogers* test to an ordinary commercial product. Though Respondent claims the product contains some expression, it is not the type of product to which the heightened First Amendment protection was meant to apply. Accordingly, INTA urges this Court to clarify that when a seller uses another’s mark on a product, only “expressive works”—*i.e.*, products where expression is conceptually inseparable from the products themselves—warrant heightened First Amendment protection. The dog toy at issue here is not such an “expressive work.”

With respect to the Ninth Circuit's decision on JDPI's dilution claim, INTA urges this Court to remand with instructions to engage in the full *Bolger* noncommercial speech analysis in order to determine if the dog toy in fact constitutes noncommercial speech.

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Respectfully submitted,

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