

No. 22-148

IN THE
Supreme Court of the United States

JACK DANIEL'S PROPERTIES, INC.,

Petitioner,

v.

VIP PRODUCTS LLC,

Respondent.

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

BRIEF OF RESPONDENT

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CORPORATE DISCLOSURE STATEMENT

Respondent VIP Products LLC is an Arizona limited liability company, and no publicly traded company owns 10% or more of the interest in Respondent.

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INTRODUCTION

Freedom of speech begins with freedom to mock. Objects of mockery, satire, or parody—government officials, artists, celebrities, iconic brands—may bristle at negativity or loss of control over public discourse, but they are the price of fame. Jack Daniel’s Properties, Inc. (“JDPI”) seeks to use the Lanham Act to muzzle even VIP Products LLC’s playful dog-toy parody. But as the Ninth Circuit recognized, the legal tests for garden-variety infringement and dilution-by-tarnishment claims poorly fit parodies and other artistic expression. First Amendment interests warrant breathing room for parodies, and the Ninth Circuit correctly applied the long-standing test of *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), to the infringement claim and the noncommercial-use exclusion to the dilution claim.

The briefs of JDPI and many amici curiae miss what distinguishes VIP’s parody toy from pun-based trademarks used to sell nonparodic goods. “Bad Spaniels” is a *pretend* trademark for a *pretend* product—there is no bottle of “43% POO BY VOL.” or anything else. The dog toy is a plastic medium for expressing the parodic message. People buy the artistic expression, not the fictional product. That is why the *Rogers* test and the dilution exclusions for both noncommercial uses and parody fair uses apply.

Unable to convincingly distinguish the Bad Spaniels parody from other forms of artistic

expression, JDPI advocates the nuclear option: abolish the decades-old and universally followed *Rogers* test because it is “judge-made law.” But the multifactor test that JDPI prefers is likewise judge-made law. Neither is found in the text of the Lanham Act; both are judicial creations designed to evaluate the likelihood of confusion in different ways suitable to disparate circumstances. The multifactor test ill fits parody cases; the factors frequently are irrelevant or must actually be inverted for parodies. By contrast, the *Rogers* test appropriately balances the public’s interests in both avoiding confusion and preserving freedom of speech and humor. It also provides an early off-ramp from the expensive and time-consuming litigation of the indeterminate and unpredictable multifactor test. Our somber world needs more speech and more laughter; the *Rogers* test keeps it from growing any darker.

STATEMENT OF THE CASE

A. The birth of Bad Spaniels

Bad Spaniels was whelped in a bar. In 2013, while VIP owner Stephen Sacra and his wife sat at a bar waiting for dinner, he was inspired by what he saw in a square bottle with a black label. Sacra called his graphic designer, Elle Phillips, at home and, in a fifteen-second conversation, told her, “Bad Spaniels.” J.A.16–17, 273–74, 286. She got the joke, and worked up a sketch of a funny dog toy that parodied the iconic Jack Daniel’s brand. J.A.17–18, 273.

The following year, the new Bad Spaniels toy joined a pack of parodies. VIP designs, manufactures, and sells dog toys of various materials, shapes, and sizes. Among its products is a line of interactive-play toys made predominantly of injection-molded vinyl and branded Silly Squeakers®. J.A.271–72. VIP’s Silly Squeakers® dog toys parody famous brands in shapes of beer, wine, soda, and liquor bottles. *Id.*

As explained at greater length in part I.B., *infra* pp. 17–23, Stephen Sacra’s intent in creating Bad Spaniels was “[a]bsolutely” to create a parody product and “[u]ndoubtedly” to amuse the public. J.A.274. The parody commented on iconic brands’ bombardment of consumers with advertising, the special relationship people have with their dogs, and even the relationship between dogs and alcohol. J.A. 31–32, 36, 289. VIP did not intend to confuse the public, as it wanted everyone to know VIP was behind the Silly Squeakers® line. J.A.274.





In designing the Bad Spaniels parody, VIP borrowed only enough to make the joke work. Contrary to JDPI's insistence, it did not use "Jack Daniel's" or other elements of the trade dress as they appear on the Jack Daniel's label. JDPI Br. 4. Elle Phillips testified that she included "some decent similarities" because "we wanted it to be a parody of the Jack Daniel's bottle." J.A.23–24. Sacra confirmed that VIP had "no intent to make a copy" of Jack Daniel's label, as "our goal is to just grab enough of the elements of information that has been put into your mind ... for you ... [to] recall the brand that we're parodying, but not to copy." J.A.276.

To accomplish the parodic effect, the Bad Spaniels Silly Squeaker[®] toy artistically transforms elements of the Jack Daniel's bottle and label. "Jack Daniel's" becomes "Bad Spaniels"; "Old No. 7" becomes "Old No. 2"; and "Tennessee whiskey" becomes "Tennessee carpet." References to alcohol content are transformed into "43% POO BY VOL." and "100% SMELLY." Bad Spaniels also features a dominating cartoon of, in the district court's words, a "wide-eyed spaniel." Pet.App.48a. The differences between VIP's soft vinyl squeak toy and a Jack Daniel's glass bottle of amber liquid are greater than their similarities, and are sufficient to alert consumers that the Silly Squeaker[®] toy is a parody.

The Bad Spaniels Silly Squeaker® toy also is sold with a “hang tag” that prominently displays the Silly Squeakers® logo on the front and back, and includes a disclaimer stating, “The product and its design belong to VIP Products. This product is not affiliated with Jack Daniel Distillery.” J.A.4, 112. The disclaimer is in the same size font as the rest of the text, and was



placed at the bottom with the copyright notice because that is where consumers expect to see legal notices. Dkt. 233-1 at 75–76; Dkt. 243 at 114–15.



B. There is no evidence of consumer confusion or tarnishment in the real world.

As one would expect between a squeaky toy and a bottle of whiskey, there was no evidence of actual confusion in the real world. JDPI's witnesses were not aware of any consumer confusion between Jack Daniel's and Bad Spaniels. Dkt. 234 at 79, 85, 93, 140–41. VIP has never heard from a customer who thought the brand being parodied put out or authorized the toy. Dkt. 236 at 48–49.

Moreover, the parties operate in different product and distribution markets. VIP sells pet toys; JDPI forswears selling pet toys of any kind. J.A.215; Dkt. 234 at 136, 141–42, 139. While JDPI claims that it licenses dog leashes, collars, a treat jar, and a doghouse, JDPI Br. 12, its witnesses admit that they don't sell any of those products outside of the Lynchburg Hardware & General Store, the distillery's brick-and-mortar "gift shop." J.A.209, 214–15, 219; Dkt. 234 at 75, 134, 139–40, 142; Dkt. 235 at 55. JDPI admitted at trial that it is not aware of and does not claim any lost sales caused by Bad Spaniels. J.A.210; Dkt. 235 at 60.

There is also no evidence of real-world "disgust" associated with Bad Spaniels, much less resulting tarnishment of Jack Daniel's reputation. No consumers ever told JDPI or VIP that they thought

Bad Spaniels was disgusting or hurting the Jack Daniel's brand. J.A.255; Dkt. 243 at 87.

In fact, not everyone has a problem with parodies. Although JDPI points to the fact that Anheuser-Busch obtained a preliminary injunction against the "ButtWiper" Silly Squeaker® toy, JDPI Br. 13, 26, *see Anheuser-Busch, Inc. v. VIP Prods., LLC*, 666 F. Supp. 2d 974 (E.D. Mo. 2008), that company's specific objection was that "Buttwiper" is a recognized slang term for Budweiser. *Urban Dictionary*, "Buttwiper," <https://www.urbandictionary.com/define.php?term=buttwiper>. Anheuser-Busch agreed that if VIP gave up that toy, it would not challenge two other Silly Squeaker® toys parodying brands it controlled ("Cataroma" for Corona beer, and "O Drools" for O'Doul's nonalcoholic beer), and VIP still sells both toys. Dkt. 236 at 52–55.

SUMMARY OF ARGUMENT

This is a case about speech, and a popular brand's attempts to control that speech by weaponizing the Lanham Act. JDPI asks the Court to abolish the *Rogers* test, scrapping decades of judicial efforts to marry the public's interests in avoiding confusion and protecting free speech. The Lanham Act, which specifies no particular test for likelihood of confusion, requires no rejection of *Rogers*.

1. The Bad Spaniels Silly Squeaker® toy is indisputably a good-faith (and successful) parody. It involves a *pretend* trademark and *pretend* trade dress

on a *pretend* label on a *pretend* bottle with *pretend* contents, when the real product is a parody embodied in a solid-vinyl dog toy with a squeaker. The parody comments on both iconic alcohol brands' self-serious bombardment of consumers with advertising and dog owners' joyful humanization of their pets. The evidence and surrounding social context of "Jack" demonstrate that VIP's parody was well aimed. That VIP used a dog toy to communicate its message is irrelevant, as medium and profit motive do not matter to the First Amendment.

2. The multifactor test and the *Rogers* test both are judicial glosses on the Lanham Act's barebones text that are designed to address likelihood of confusion in disparate contexts. The multifactor test performs reasonably well in commercial contexts involving competitors who should be operating at arm's length. But as to referential expressive works, the multifactor test is expensive and time-consuming to litigate, traditionally unsusceptible to resolution by dispositive motion, and (as in this case) likely to be misapplied. Its factors tend to point in the wrong direction for parodies: for example, the stronger the mark, the more recognizable a parody is. The *Rogers* test provides a valuable early off-ramp from litigation for protected speech, by asking whether the consumer is truly purchasing protected speech rather than a noncommunicative product using a gimmicky trademark, and whether the product is explicitly misleading. *Rogers* works in this case and others to

provide necessary breathing space for constitutionally protected creative expression.

3. The cause of action for dilution by tarnishment amounts to unconstitutional viewpoint discrimination. It is the same sort of “happy-talk clause” that this Court struck down in *Matal v. Tam*, but it is actually worse than the registration bar because it affirmatively restrains expressive speech. This Court can avoid the constitutional issue by applying either the noncommercial-use exclusion, as the Ninth Circuit did, or the fair-use exclusion for parodies. The Bad Spaniels toy qualifies as noncommercial speech under this Court’s commercial-speech doctrine, which Congress intended the courts to apply. Moreover, the fair-use exclusion applies because the “Bad Spaniels” image is decorative ornamentation, not a “designation of source.”

ARGUMENT

I. VIP’s Bad Spaniels parody is a work of artistic expression and noncommercial speech.

A. VIP does not use “Bad Spaniels” or other elements of its design as a trademark or designation of source.

JDPI asserts that, unless this Court reverses the Ninth Circuit’s decision, the Lanham Act will be rendered “virtually useless” by a flood of funny knock-offs. JDPI Br. 5. It won’t. This case is not a dispute

between two trademarks on commercial products. VIP uses a *pretend* trademark and *pretend* trade on a *pretend* label on a *pretend* bottle full of *pretend* contents. It is all a fiction—that *is* the parody. VIP does not sell a “knock-off” bottle of diluted canine poo; it sells a parody embodied in a solid vinyl dog toy that contains a squeaker. Everything is artistic expression directed at amusing dog owners by mocking Jack Daniel’s self-seriousness. The Bad Spaniels parody is the content that VIP is selling, and it matters not that it appears on plastic rather than canvas.

The “Bad Spaniels” artwork does not function as a trademark or, in dilution terms, a “designation of source” merely because it is the appealing ornamental decoration that distinguishes it from other Silly Squeaker® toys.¹ To use the Ninth Circuit’s analogy, the *Mona Lisa* is not a trademark or “designation of source” for a t-shirt with the *Mona Lisa* on it because the depiction distinguishes it from other t-shirts. *See, e.g., Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 674 F. App’x 16, 18–19 (2d Cir. 2016) (parody handbag did not use parodied mark as “designation of source”).

The Bad Spaniels parody is different in kind from pun-based marks used to sell the actual nonparodic products for which they are marks. JDPI trots out the

¹ VIP made this this point to both lower courts. Dkt. 163 at 6–7; Ninth Cir. Dkt. 16 at 51–52. The district court reached a contrary conclusion without offering evidence or analysis, but the Ninth Circuit found no reason to address the issue.

likes of “Double Stuf Stoneo” for pot-laced cookies, “Timmy Holedigger” for pet perfume, “Pissterine” for mouthwash, “Starbuds” for marijuana dispensaries, and “Dom Poppingnon” for popcorn. But those are *real* trademarks for *real* products. Those humorous trademarks may or may not be deemed confusing under the multifactor test, but they function as trademarks for the products they *describe*. They don’t need to be referential to sell those products.

In contrast, the only way to parody the Jack Daniel’s bottle is to parody it. “Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim’s (or collective victims’) imagination ...” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580–81 (1994). What distinguishes the Bad Spaniels toy—what consumers want in buying it—is the *speech* it embodies. The Bad Spaniels parody “is not advertising the product; it *is* the product.” *Hilton v. Hallmark Cards*, 599 F.3d 894, 905 n.7 (9th Cir. 2010).

Because the Bad Spaniels pretend label is artistic expression about a fictional product no one sells, VIP has not registered or even applied to register either “Bad Spaniels” or the other label elements as trademarks or trade dress. Nor has it used any trademark symbol—® or ™—on the label to suggest a claim of protectable trademark. Copyright law, not trademark law, is more appropriate for decorative labels on fictional products.

Brand parodies are well known in the marketplace of ideas. Since 1967, Topps *Wacky Packages* trading cards and stickers have parodied thousands of iconic brands, from “Ratz Crackers,” “Jolly Mean Giant,” and “South Beached Whale Diet” to “Blast Blew Ribbon Beer,” “Jim Mean Kentucky Sharp Broken Whiskey,” and “Old Grand-Mom Whiskey.” At the height of their popularity, *Wacky Packages* outsold Topps baseball cards.²



The one court to address an infringement claim against *Wacky Packages* rejected it on numerous grounds. *Tetley, Inc. v. Topps Chewing Gum, Inc.*, 556 F. Supp. 785, 791 (E.D.N.Y. 1983). As the court

² *Fleer Corp. v. Topps Chewing Gum, Inc.*, 501 F. Supp. 485, 495 (E.D. Pa. 1980), *rev'd*, 658 F.2d 139 (3d Cir. 1981). *See, e.g.*, *Wacky Packages*, WIKIPEDIA, https://en.wikipedia.org/wiki/Wacky_Packages; *Wacky Packages Alphabetized Crosslist*, <https://wackypacks.com/stickers/alphabetical.html>.

explained, “the worst that can be said is that defendant chooses to satirize popular products with the thought undoubtedly in mind that the more recognizable and popular the product satirized, the more successful the particular sticker will be.” *Id.* The court continued, “However, there is no evidence that defendant, in seeking to profit by the degree of recognition of plaintiff’s mark, either thought to realize that profit by means of confusion or contemplated injury to plaintiff’s mark.” *Id.* Parodies borrow, but they don’t confuse reasonable consumers. *See Farah v. Esquire Mag.*, 736 F.3d 528, 537 (D.C. Cir. 2013) (“The test, however, is not whether some actual readers [of the satire] were misled, but whether the hypothetical reasonable reader could be (after time for reflection).”).

B. The Bad Spaniels toy is a parody of both Jack Daniel’s cultivated self-image and the fun pet owners have with their dogs.

The Bad Spaniels toy would be “reasonably perceived” as a parody by an objective observer and, in light of the testimony of JDPI’s own executives, the parody was on target. *Campbell*, 510 U.S. at 583 n.17. The district court found that VIP owner Stephen Sacra’s “intent behind producing the Silly Squeakers line of toys was to develop a creative parody on existing products.” Pet.App.47a. The Ninth Circuit elaborated that “VIP’s purported goal in creating Silly Squeakers was to ‘reflect’ ‘on the humanization of the

dog in our lives,’ and to comment on ‘corporations [that] take themselves very seriously.’” Pet.App.26a.

Contrary to JDPI’s misstatements, the Ninth Circuit *never* said that a “humorous trademark” justifies applying the *Rogers* test. The court found that, “although surely not the equivalent of the *Mona Lisa*,” Bad Spaniels is “an expressive work” because it “communicates a humorous *message* ... by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.” Pet.App.31a (cleaned up; emphasis added). It cited authority “affording First Amendment protection to a message that business and product images need not always be taken too seriously,” and distinguished authority addressing a product that “made no effort to create a transformative work with new expression, meaning, or message.” Pet.App.31a–32a (cleaned up).

VIP’s parody operates at two levels: skewering JDPI’s sense of cultural self-importance, including the personification of “Jack” as a friend in the public imagination, and spoofing dog owners’ relationship with their pets. The combined parodic point is best summarized in the line of Brazilian poet, lyricist, and diplomat Vinicius de Moraes: “*O uísque é o melhor amigo do homem—é um cachorro engarrafado—* Whiskey is man’s best friend, it’s a dog in a bottle.” João Carlos Pecci, *Vinicius sem ponto final* 40 (1994).

Sacra testified that he was “making a comment about Jack Daniel’s,” “the way they market their product,” and their “having consumer influence over another person” and “taking it very seriously.” J.A.289–90. He elaborated, “The intended message for the Bad Spaniels parody toy ... is just saying, the world around you is constantly advertising to you,” and “[y]ou need to be able to sit back and laugh at yourself. Whether it is someone making fun of me, or someone else, or another brand or whatever.” J.A.274–75. Sacra added, “Not only are we parodying the actual brand, we’re also poking fun at dogs. Because if you own a dog, these are the things that you experience in your relationship with a dog.” Dkt. 243 at 98. He testified that “the Silly Squeakers line ... reflects back on the humanization of the dog in our lives,” in the spirit of “the picture of the dogs playing poker” or “people who take videos of their dogs who can actually bring them beers.” J.A.270. Consumers reviewing Bad Spaniels on Amazon.com reflect this in the dog photos they submit with their reviews. Dkt. 231-22.



JDPI confirmed through its testimony and brief that it earned the parody by taking itself far too seriously. JDPI Br. 9–12. JDPI’s Global Brand Director, Phillip Epps, testified that the Jack Daniel’s package is “one of the most iconic in the world,” Dkt. 234 at 74, and its then-President, David Gooder, made VIP’s point when he claimed that “the lauding of brands in our culture and brands becoming iconic things is a good thing over all.” Dkt. 235 at 50.

Epps proclaimed that the Jack Daniel’s “brand has found its way naturally into pop culture, into movies, and has been adopted by musicians.” J.A.202. He emphasized the anthropomorphism of their whiskey that the company has long promoted in its advertising: “there’s a real familiarity about Jack, and people ask for a Jack. There’s almost a personal relationship with some of our drinkers.” Dkt. 234 at 60; *see* Dkt. 229-6 at 27.



These executives glowed with pride over people's love affair with "Jack." Epps testified that some of the brand's "very loyal consumers ... will even go to the extent of tattooing themselves with a Jack Daniel's label or logo." Dkt. 234 at 86. Gooder echoed that "there are people all over the world who feel ... like they have been injured when Jack's been injured." Dkt. 235 at 34.

As Epps suggested, the role of “Jack” in influencing “pop culture” and “musicians” shows how it positions itself as man’s *new* best friend. One essayist noted that “Jack Daniels” stands among “images of patriarchal comfort,” as “alcohol is often anthropomorphized, usually as a man.” David Lenson, *Mystery Drug One*, 36 MASS. REV. No. 1, at 43–44 (2006). Musicians’ odes to “Jack” bear this out:

- George Thorogood and the Destroyers rocked, “Yeah, the other night I laid sleeping/And I woke from a terrible dream/So I caught up my pal Jack Daniel’s/And his partner Jimmy Beam.” *I Drink Alone* (1985).
- David Allan Coe sang, “Jack Daniels, if you please/Knock me to my knees/You’re the only friend/There’s has ever been that didn’t do me wrong.” *Jack Daniel’s, If You Please* (1978).
- Country superstar Miranda Lambert crooned, “I fell in love with Jack Daniels again/He’s the best kind of lover that there is/I can have him when I please/He always satisfies my needs.” *Jack Daniels* (2001).

Lambert’s lyrics echo Gooder’s testimony that the “brand values of the Jack Daniel’s mark” include “masculinity, but in a way that is appreciated and connected with women as well.” J.A.254.

This all made “Jack” fair game and brings VIP’s Bad Spaniels toy squarely within the scope of a true

parody. “Man’s best friend” also deserves a “friend”—a joke that JDPI has invited. And the free-speech concerns the Court recognizes as to copyright law carry over to trademark law when applied to a true parody, where *speech* is what drives the consumer’s purchasing decision. Bad Spaniels is an “artistic work that imitates the characteristic style of an author or a work for comic effect or to ridicule.” *Campbell*, 510 U.S. at 580 (quotation omitted). Such commentary needs leeway and “[a]n ‘artistic painting’ might, for example, fall within the scope of fair use even though it precisely replicates a copyrighted ‘advertising logo to make a comment about consumerism.’” *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1203 (2021) (quoting 4 Melville Nimmer & David Nimmer, COPYRIGHT § 13.054[A][1][b] (2019)). The “threshold question ... is whether a parodic character may reasonably be perceived. Whether, going beyond that, parody is in good taste or bad does not and should not matter to fair use.” *Campbell*, 510 U.S. at 582. The Bad Spaniels image “has an obvious claim to transformative value,” and, “[l]ike less ostensibly humorous forms of criticism, it can provide social benefit, by shedding light on an earlier work, and, in the process, creating a new one.” *Id.* at 579.

Jack Daniel’s loves attention—but only positive attention. Epps testified that they “don’t like” a spoof of Jack Daniel’s. Dkt. 234 at 74. JDPI Licensing Manager Tobias Roush added that Bad Spaniels is “a negative toward our brand and an icon that we have all worked so hard to protect,” and every product that

makes Jack Daniel’s “the butt of the joke” is an infringement “[i]f it’s using our trade dress.” Dkt. 234 at 116–17, 138. He testified that, “in order to make a comment or poke fun at the iconic Jack Daniel’s brand, you need to be a licensee to do that”—that is, “[i]f the brand would allow you to do that.” Dkt. 234 at 139. But it is not the proper function of trademark law to stop all jokes at “Jack’s” expense.

JDPI’s goals also miss the point of parody: it attacks the strong for their strength’s sake. When baseball legend Reggie Jackson quipped, “Fans don’t boo nobodies,”³ he echoed the sentiment of a renowned chronicler of parodies in 1887: “It will be seen that the object of a Parody is very seldom to ridicule its original, more often, on the contrary, it does it honour, if only by taking it as worthy of imitation, or burlesque.”⁴ Walter Hamilton, PARODIES OF THE WORKS OF ENGLISH AND AMERICAN AUTHORS 1 (1887). Hamilton continued, “Poets are parodied in proportion to their popularity.” *Id.* (quotation omitted). “Jack” and other public figures who, “by reason of their fame, shape events in areas of concern to society at large” must accept that “one of the prerogatives of American citizenship is the right to criticize public men and measures” in terms that may be “vehement, caustic, and sometimes unpleasantly sharp.” *Hustler Mag., Inc. v. Falwell*, 485 U.S. 46, 51 (1988) (cleaned up).

³ Phil Taylor, *No Taboo to Boo*, SPORTS ILLUSTRATED, May 16, 2004, at 17.

C. It makes no difference that the message is carried by a “utilitarian product” sold for profit.

JDPI and its amici attack the Ninth Circuit for applying the *Rogers* test to the infringement claim, because VIP’s parody is borne on a dog toy, which they consider a mere “utilitarian product” that is sold. But neither the profit motive nor the medium is relevant to First Amendment interests.

First, almost everything is for sale and therefore a “commercial product”—starting with the Old Masters’ labors for wealthy patrons. It is “well settled” that First Amendment rights “are not lost merely because compensation is received,” *Riley v. Nat’l Fed’n of the Blind of N.C., Inc.*, 487 U.S. 781, 801 (1988), or the speech “takes place under commercial auspices,” *Smith v. California*, 361 U.S. 147, 150 (1969). Even “the degree of First Amendment protection is not diminished merely because the ... speech is sold rather than given away.” *City of Lakewood v. Plain Deal Publ’g Co.*, 486 U.S. 750, 756 n.5 (1988) (emphasis added). Indeed, “[s]ome of our most valued forms of fully protected speech are uttered for a profit.” *Bd. of Trs. v. Fox*, 492 U.S. 469, 482 (1989).

Second, “whatever the challenges of applying the Constitution to ever-advancing technology, ‘the basic principles of freedom of speech and the press, like the First Amendment’s command, do not vary’ when a new and different medium for communication

appears.” *Brown v. Ent. Merchs. Ass’n*, 564 U.S. 786, 790 (2011) (quoting *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 503 (1952)). Whether the medium used as a canvas for artistic expression has some independent utilitarian functionality is irrelevant. So do other tangible mediums, like apparel, coffee mugs, coasters, and greeting cards. All of those are subject to First Amendment protections when they bear speech. See, e.g., *Cohen v. California*, 403 U.S. 15 (1971) (jacket); *Minn. Voters Alliance v. Mansky*, 138 S. Ct. 1876 (2018) (political apparel); *Mastrovincenzo v. City of New York*, 435 F.3d 78, 97 (2d Cir. 2006) (shirts and hats); *Hilton*, 599 F.3d 894 (greeting cards); *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818 (8th Cir. 2007) (fantasy baseball games). Indeed, parody baseball trading cards are entitled to full First Amendment protection because, “even if the trading cards are not a traditional medium of expression, they nonetheless contain protected speech.” *Cardtoons, L.C. v. Major League Players Ass’n*, 95 F.3d 959, 969 (10th Cir. 1996). The key is not the form but the expression, i.e., whether the item is “intended to be communicative and ..., in context, would reasonably be understood by the viewer to be communicative.” *Clark v. Cmty. for Creative Non-Violence*, 468 U.S. 288, 294 (1984).

This must be so. Courts are ill suited to draw lines around what is an appropriate vehicle for social commentary. A stroll through any modern art museum confirms that, when it comes to art, one may

justifiably say, “I know it when I see it” *Jacobellis v. Ohio*, 378 U.S. 184, 197 (1964) (Stewart, J., concurring). How a speaker chooses to convey a message, or an artist an image, or an author a story is of no moment to the First Amendment. Any other conclusion would “shackle the First Amendment in its attempt to secure the widest possible dissemination of information.” *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 266 (1964) (quotation omitted).

Amicus INTA argues that “[s]tripping all the expression from a dog toy would still yield a functional dog toy.” INTA Br. 24. The same is true of many mediums. Greeting cards, coffee mugs, t-shirts, paintings, and movie DVDs stripped of all expression would still yield, respectively, “functional” stationery, china, plain white tees, canvases, and blank disks. When the law at issue will only apply dependent on the message expressed by those items, First Amendment interests are triggered. In any event, the placement of the “Bad Spaniels” image on a dog toy only doubles down on the parody.

Fundamentally, that the Bad Spaniels parody is carried on a dog toy cannot be relevant because the parody stands independent of the function of the toy. The toy would have no “utilitarian” function if the hang tag warned “NOT FOR USE WITH DOGS.” Elle Phillips, the graphic designer who worked on the Bad Spaniels toy, testified, “Because it’s humorous, ... it should be a collectible,” that is, “a toy or product ...

that people collect and save over time.” Dkt. 233-1 at 78. The “utilitarian product” argument does not work.

II. The Court should preserve the long-standing *Rogers* test.

JDPI and many of its amici represent the issue presented as a struggle for supremacy between the Lanham Act and the First Amendment, with the latter represented by its proxy, a judge-made *Rogers* test. That is a false construct. The Lanham Act does a lot of work with very few words, leaving the courts to flesh out the standards for trademark infringement in a variety of contexts. Both the multifactor test for ordinary commercial goods and the *Rogers* test for expressive works are judge-made tests for likelihood of confusion under the Lanham Act’s broad rubric that balance public and private interests in disparate situations. *Cf. Top Tobacco, L.P. v. N. Atl. Operating Co.*, 509 F.3d 380, 383 (7th Cir. 2007) (“A list of factors designed as *proxies* for the likelihood of confusion can’t supersede the statutory inquiry.”). They have worked well in tandem for nearly forty years, and there is no need either to abolish the *Rogers* test, as JDPI urges, or to subsume the *Rogers* test in the multifactor test, which would destroy the latter’s value in preventing litigation from chilling freedom of public discourse.

A. The Lanham Act does not specify a particular test or balance of public interests.

JDPI equates the Lanham Act with the fact-intensive multifactor test, but no mandate for that particular test is found in the statute itself. Both the multifactor test and the *Rogers* test were developed by courts to implement the statute in a context-sensitive manner. The text of the Lanham Act, both in regard to registered and unregistered marks, provides at best the outline of a legal standard for infringement: “likely to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. §§ 1114(1)(a), 1125(a)(1)(A). The Act specifies no quantum or quota of confusion required for infringement. It does not establish what makes a use “likely” to cause confusion. *See Int’l Ass’n of Machinists v. Winship Green Nursing Ctr.*, 103 F.3d 196, 200 (1st Cir. 1996). It does not specify the nature of the confusion required, e.g., factual or legal. *See 1-800 Contacts, Inc. v. Lens.com, Inc.*, 722 F.3d 1229, 1238 (10th Cir. 2013) (“Confusion can be of several sorts.”).

While JDPI and some of its amici deride the *Rogers* test as “judge-made requirements,” JDPI Br. 4–5, the law of trademark infringement has always been “largely judge-made.” *A.J. Canfield Co. v. Hickman*, 808 F.2d 291, 299 n.9 (3d Cir. 1986). Courts have developed doctrines using different confusion tests where the public has an interest in fostering fair competition or truthful commercial speech, including

comparative advertising, *Smith v. Chanel, Inc.*, 402 F.2d 562, 565 (9th Cir. 1968), and nominative (referential) fair use, *Century 21 Real Est. Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 222 (3d Cir. 2005); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992). Such tests both recognize the countervailing speech interests at stake and avoid the multifactor test's use of poorly fitting factors.

Indeed, there is no single multifactor test. Depending on the lead case in that circuit, the varying nonexhaustive lists are known as *Polaroid* factors, *Sleekcraft* factors, *Frisch* factors, *Pizzeria Uno* factors, and so forth.⁴ As explained by the Seventh Circuit, however, they all end up in roughly the same place: “The legal standard under the Act has been formulated variously, but the various formulations come down to whether it is likely that the challenged mark if permitted to be used by the defendant would cause the plaintiff to lose a substantial number of consumers.” *Indianapolis Colts, Inc. v. Metro.*

⁴ See, e.g., *Polaroid Corp v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979); *Frisch's Rests., Inc. v. Elby's Big Boy*, 670 F.2d 642, 648 (6th Cir. 1982). *Pignons S.A. de Macanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981); *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 463 (3d Cir. 1983); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984).

Baltimore Football Club Ltd. P'ship, 34 F.3d 410, 414 (7th Cir. 1994).

But the situations for which these multifactor tests were designed, and to which they are best suited, involve an ordinary use of trademarks solely as commercial speech: proposing a transaction to consumers. *See, e.g., Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (“A trademark ... helps consumers identify goods and services that they wish to purchase, as well as those they want to avoid.”). Concerns over infringement of trademarks originated in issues of counterfeiting or palming off of competitive or at least complementary goods or services. *See generally* Restatement (First) of Torts § 730 cmt. a (1938). The various factors, acting in combination, seek to determine whether the defendant’s use causes confusion among a substantial number of reasonable consumers in a way that harms the plaintiff.

As the Lanham Act broadened from “confusion of source” to “confusion of sponsorship,”⁵ there arose an increasing likelihood that a court or jury might find actionable confusion despite clarity that the junior user’s goods actually came from the junior user. *E.g., Amstar Corp. v. Domino’s Pizza, Inc.*, 615 F.2d 252, 263 (5th Cir. 1980) (holding trial court clearly erred in

⁵ *See generally* *HMH Publ’g Co. v. Brincat*, 504 F.2d 713, 716 (9th Cir. 1974) (discussing historical broadening of infringement claims to encompass “likelihood of confusion as to sponsorship”).

finding “Domino’s Pizza” was likely to cause confusion with “Domino” for sugar and condiment packets). This might not pose any problem in purely commercial contexts, where both parties sold goods under marks that functioned entirely as marks, i.e., source identifiers. But some third-party uses of established marks need to refer legitimately to those marks in order to speak to the public: indications that products may be used together or substitute for each other; sale of used goods; comparative advertising; evaluative reviews; and parodies. In all of these contexts, the core function of the third party’s use is *not* to confuse the public as to the source or sponsorship of the goods.

Expressive uses of trademarks, including parodies, are vulnerable to overextensions of trademark claims. Whether one uses the target mark in an artistically transformative way or mimics it to convey a message, the trademark owner may argue that some consumers would believe any recognizable mention of a mark requires the owner’s permission. JDPI did so below by offering a flawed confusion survey. *See infra* pp. 41–45. In this world of brand extensions and collaborations, some consumers may see affiliations that are not there. The multifactor test does not ask if these mistaken beliefs would be material to consumers’ purchasing decision, nor does it indicate what percentage of consumers must hold them. The pliability of trademark law’s multifactor test threatens free expression especially where the trademark owner wants to suppress the speech.

Addressing these challenges, the Second Circuit developed the *Rogers* test, and every other circuit to face the situation has adopted and refined it. To ensure the robust dialogue that is the core of the First Amendment, the *Rogers* court chose to “construe the Act narrowly to avoid such a conflict.” 875 F.2d at 998. The Second Circuit explained that “the 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,” and the use of a mark that is misleading or artistically irrelevant “cannot be sufficiently justified by free expression.” *Id.* at 999.

In the years since *Rogers*’s broad adoption in the context of expressive works, courts and Congress alike have worked under the assumption of the *Rogers* test’s validity and value. As the Eleventh Circuit recently noted in discussing the Trademark Modernization Act of 2020, “the legislative history of the Lanham Act’s latest amendment states that the *Rogers* test ‘appropriately recognizes the primacy of constitutional protections for free expression.’” *MGFB Props., Inc. v. Viacom Inc.*, 54 F.4th 670, 679 (11th Cir. 2022) (quoting H.R. Rep. No. 116-645, at 20 (2020)).

Although *Rogers* was initially applied to expressive uses of trademarks in titles, it has since been applied to a wide variety of expressive works in different mediums and contexts. These include calendars showing Alabama football, *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278–79

(11th Cir. 2012); paintings of Tiger Woods on envelopes bearing his name, *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 936–37 (6th Cir. 2003); a billboard's use of the mark "NAACP" in a pro-life message, *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 325 (4th Cir. 2015); greeting cards, *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 271 (9th Cir. 2018); and political speech, *Protectmarriage.com v. Courage Campaign*, 680 F. Supp. 2d 1225, 1229 (E.D. Cal. 2010). Parody is no different. *See My Other Bag*, 674 F. App'x at 18–19 (holding that a parody tote bag did more than merely identify the mark's source).

These cases repeatedly demonstrate that trademark owners are ready and willing to sue over commentary they dislike. In the face of such threats to free speech, *Rogers* offers a clear test for actionable confusion that still allows for the prospect of liability when a use is explicitly misleading about the mark's source or sponsorship. *E.g.*, *Yuga Labs, Inc. v. Ripps*, No. CV 22-4355, 2022 WL 18024480, at *3 (C.D. Cal. Jan. 16, 2022) (finding *Rogers* did not apply to defendant's non-fungible token collection that directed consumers to images of plaintiff's marks).

The *Rogers* test thus continues a tradition of adjusting existing causes of action to accommodate free-speech concerns. *See, e.g.*, *NAACP v. Claiborne Hardware*, 458 U.S. 886, 920 (1982) (conspiracy-based torts); *Hustler*, 485 U.S. 46 (intentional infliction of emotional distress); *Sullivan*, 376 U.S. at 254 (defamation claims by public figures).

B. The multifactor test works well in ordinary commercial contexts, but it is ill suited to expressive works.

The multifactor test was designed for and works well in the context of commercial trademarks with solely commercial functions. But it was never intended to address expressive works that are necessarily referential.

Parodies and other expressive works confound application of the multifactor test because they are necessarily and properly referential. *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 801 (9th Cir. 2003); *Anheuser-Busch, Inc. v. L. & L. Wings, Inc.*, 962 F.2d 316, 322 (4th Cir. 1992) (“The purpose of the Lanham Act is to eliminate consumer confusion, not to banish all attempts at poking fun or eliciting amusement.”). The multifactor test “is at best awkward in the context of parody,” *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 495 n.3 (2d Cir. 1989), and it “fails to account for the full weight of the public’s interest in free expression,” *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 900 (9th Cir. 2002). In contrast, the *Rogers* test is “the most appropriate method to balance the public interest in avoiding consumer confusion with the public interest in free expression.” *Parks v. LaFace Records*, 329 F.3d 437, 450 (6th Cir. 2003). “The public has at least as much interest in the free exchange of ideas as it does in avoiding misleading advertising.” *Id.* at 449.

First Amendment jurisprudence has traditionally and consistently favored strong, categorical tests to adequately protect the interests of free expression. The appropriate standards “must entail minimal if any discovery, to allow parties to resolve disputes quickly without chilling speech through the threat of burdensome litigation,” and “must eschew ‘the open-ended rough-and-tumble of factors,’ which ‘invit[es] complex argument in a trial court and a virtually inevitable appeal.” *Fed. Election Comm’n v. Wis. Right to Life, Inc.*, 551 U.S. 449, 469 (2007) (quoting *Jerome B. Grubart, Inc. v. Great Lakes Dredge & Dock Co.*, 513 U.S. 527, 547 (1995) (cleaned up)). Endless litigation and damages “may be markedly more inhibiting than the fear of prosecution under a criminal statute.” *BMW of N. Am. Inc. v. Gore*, 517 U.S. 559, 584 n.38 (1996) (quoting *Sullivan*, 376 U.S. at 277)). As the Court noted, “In short, it must give the benefit of any doubt to protecting rather than stifling speech.” *Wis. Right to Life*, 551 U.S. at 451.

The First Amendment requires clear rules regarding boundaries on protected speech, not *ad hoc* discretionary decisions based on balancing of disparate evidentiary factors of uncertain application in any particular case. Categorical speech-based rules like *Rogers* that account for the public interest in free speech allow for early disposition of cases at the motion to dismiss and summary judgment phases—that’s what they’re designed to do. The *Rogers* test can resolve cases at the motion to dismiss stage. *E.g.*, *Louis Vuitton Malletier S.A. v. Warner Bros. Ent., Inc.*,

868 F. Supp. 2d 172, 185 (S.D.N.Y. 2012). The multifactor test, with its fact-intensive inquiries and necessary discovery, does not fit the bill here.

1. Multifactor tests are indeterminate and unpredictable.

The fundamental problems with general-purpose multifactor tests are that they are indeterminate in nature, expensive and time-consuming to litigate, and unpredictable in result. “These factors imply no mathematical precision, but are simply a guide to help determine whether confusion is likely ... and not all of these factors may be particularly helpful in any given case.” *Homeowners Grp., Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991). As this Court noted in another Lanham Act context, “experience has shown that ... open-ended balancing tests[] can yield unpredictable and at times arbitrary results.” *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 136 (2014).

As a result of this indeterminacy, parties litigating the multifactor test must develop and present evidence on all of the factors, without knowing which ones the court or jury will find more or less significant in the particular case. If the facts relevant to the applicable factors are contested, factual findings must be made with respect to each of these factors, and these findings are subject to review only for clear error. *Little Caesar Enters., Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 570 (6th Cir. 1987). Such a lack of

clarity in Lanham Act standards promotes use of litigation in and of itself as a weapon. *See Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000) (rejecting “a rule of law that facilitates plausible threats of suit against new entrants” because the lack of “clarity of the test” would deprive consumers “of the benefits of competition”); *MGFB*, 54 F.4th at 688 (Brasher, J., concurring) (criticizing trademark test for its “indeterminacy problem” and warning that “certainty is especially important in an area like this one where even the prospect of liability has the effect of chilling constitutionally protected speech”) (citing Glynn Lunney, *Trademark’s Judicial De-Evolution: Why Courts Get Trademark Cases Wrong Repeatedly*, 106 CAL. L. REV. 1195, 1201 (2018)). As discussed below, *infra* pp. 41–45, in the *Rogers* context, “[a]dding survey evidence changes nothing.” *MGFB*, 54 F.4th at 682 (quoting *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1246 (9th Cir. 2013)).

2. Multifactor tests offer little opportunity for early termination of litigation.

The multifactor test does not offer much of any early off-ramp from expensive litigation by way of either a motion to dismiss or motion for summary judgment. To litigate a motion for summary judgment “in a case [such as this one] where the likelihood of confusion is the dispositive issue, a nonmoving party must establish, through pleadings, depositions, answers to interrogatories, admissions and affidavits

in the record, that there are genuine factual disputes concerning those of the [eight] factors which may be material in the context of the specific case.” *Homeowners*, 931 F.2d at 1107. Most discovery battles concern factors, such as intent, strength of the mark, and marketing channels, that need not be addressed in applying the *Rogers* test. *See, e.g., Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091, 1104 (9th Cir. 2022) (affirming denial of Rule 56(d) continuance to allow discovery as to defendant’s knowledge of plaintiff’s mark, extent of actual confusion, and defendant’s use of mark as “source-identifier” because issues were “not relevant to the *Rogers* analysis”) .

Moreover, summary judgment under the multifactor test may be an illusory goal in many cases. “Because the determination is based on a non-exhaustive, multi-factor, fact-intensive inquiry, [courts] have cautioned against granting summary judgment.” *JL Beverage Co. v. Jim Beam Brands Co.*, 828 F.3d 1098, 1105 (9th Cir. 2004); *see also Dorpan, S.L. v. Hotel Melia, Inc.*, 728 F.3d 55, 66 (1st Cir. 2013); *Tiffany & Co. v. Costco Wholesale Corp.*, 971 F.3d 74, 85 (2d Cir. 2020); *Country Floors, Inc. v. P’ship Composed of Gepner & Ford*, 930 F.2d 1056, 1062–63 (3d Cir. 1991); *AHP Subsidiary Holding Co. v. Stuart Hale Co.*, 1 F.3d 611, 616 (7th Cir. 1993).

Although there are occasions when courts have reached the correct result for a parody by applying the multifactor test, that does not make it an appropriate tool. One may be able to clumsily turn a screw with a

claw hammer, but that does not mean one should throw everything but the hammer out of the toolbox. In *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007), the court held that the parody dog toy was not likely to cause confusion, but it did so only after applying the seven *Pizzeria Uno* factors and noting that these “factors are not always weighted equally, and not all factors are relevant in every case.” *Id.* at 259–60. After an extensive analysis of whether the toy was a true parody, the court noted that “[f]inding that Haute Diggity Dog's parody is successful, however, does not end the inquiry into whether Haute Diggity Dog's ‘Chewy Vuiton’ products create a likelihood of confusion,” but “only influences the way in which the *Pizzeria Uno* factors are applied.” *Id.* at 261. The court then slogged through discussions of the strength of the mark, the similarities between the marks, the similarities of the products themselves, the similarity of facilities and advertising channels, the defendant's intent, and whether there was evidence of actual confusion. *Id.* at 261–63.

And that appellate boondoggle followed the district court's own undertaking to “carefully consider each of these factors and determine by a totality of the circumstances if likelihood of confusion exists.” *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 464 F. Supp. 2d 495, 499 (E.D. Va. 2006), *aff'd on other grounds*, 507 F.3d 252 (4th Cir. 2007). The enormous uncertainty and cost involved in litigation using the indeterminate multifactor test undoubtedly deters

freedom of discourse and deprives creative expression of breathing space.

3. Multifactor tests are contorted in the parody context.

Another problem with the multifactor test is that, in the parody context, factors that that may favor the senior user in commercial contexts often flip in significance. For example, that the allegedly infringed mark is strong usually favors the senior user, but the opposite should be true as to parodies, because “it is precisely because of the mark’s fame and popularity that confusion is avoided, and it is this lack of confusion that a parodist depends upon to achieve the parody.” *Tommy Hilfiger Licensing v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 416 (S.D.N.Y. 2002); *see also Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 503 (2d Cir. 1996). Similarly, fictional product parodies like Bad Spaniels do not fit into the traditional categories. The Seventh Circuit noted that “[t]here is little authority on how to treat the ‘similarity of the products’ factor when one of them is fictional.” *Fortres Grand Corp. v. Warner Bros. Ent. Inc.*, 763 F.3d 696, 702 (7th Cir. 2014). *Cf. Century 21*, 425 F.3d at 222, 232 (recognizing need for “separate inquiries” for “fairness” because “our traditional likelihood of confusion test does not apply neatly to nominative fair use cases”).

Without *Rogers*, courts can easily miss this maladaptation of the multifactor test to parodies and

other protected expression. For example, the district court in this case misapplied several factors by failing to account for the necessary attributes of a parody. It counted the strength of JDPI's marks "strongly" in its favor, Pet.App.71a–72a; counted "VIP's intent ... to copy ... for the purpose of parody" in JDPI's favor, Pet.App.69a–70a; counted the necessary similarity "in their entirety" of the parody to the original in JDPI's favor, Pet.App.70a–71a; and counted the "consumer care factor" in JDPI's favor because the Bad Spaniels parody toy sold for only \$15, Pet.App.74a. Amicus United States agrees that the district court misapplied factors, U.S. Br. 21–22, but its suggested remedy of even more remands, along with ineluctable further appeals, shows how the multifactor test prolongs litigation and chills freedom of expression.

A multifactor test whose factors reverse in significance from time to time is not a good one for predictability, consistent application, or rule of law. *Rogers*, by contrast, can be applied consistently within its scope, and mitigates the risk of litigating a lengthy list of indeterminate factors that frequently point in the wrong direction in the context of artistic expression.

4. Confusion surveys are unreliable tools in the parody setting.

The multifactor test also encourages reliance on traditional (and expensive) tools like trademark confusion surveys, as well as the accompanying case

law evaluating whether a particular threshold percentage of detected confusion equates with actionable “actual”—really experimental—confusion. Courts sometimes use survey evidence showing a small percentage of survey respondents’ actual confusion by the allegedly confusing mark to justify their findings of a likelihood of confusion. From 1979 to 2021, courts have held that low percentages, between 10 and 20%, of respondents claiming actual confusion are typically enough to show a likelihood of confusion. *See, e.g., RJR Foods, Inc. v. White Rock Corp.*, 603 F.2d 1058, 1061 (2d Cir. 1979) (15–20% corroborates likelihood of confusion); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 400–01 (8th Cir. 1987) (10% can be significant); *RXD Media, LLC v. IP Application Dev. LLC*, 986 F.3d 361, 373 (4th Cir. 2021) (10% supports a finding of likelihood, but just 17% is “clear evidence”).

In parody cases, two problems arise. First, the surveys may detect some form of confusion, but not the kind the Lanham Act was intended to combat, that is, confusing the consumer about a product purchase decision. *See Cliffs Notes*, 886 F.2d at 495. In its first case adopting the *Rogers* test, the Ninth Circuit rejected reliance on a survey question about whether the public believed the work was a parody for fear of “possibly silenc[ing] artistic creativity.” *Walking Mountain*, 353 F.3d at 801. *Cf. Indianapolis Colts*, 34 F.3d at 416 (“[N]o doubt there are other tricks of the survey researcher’s black arts that we have missed. There is the more fundamental problem,

one common to almost all consumer survey research, that people are more careful when they are laying out their money than when they are answering questions.”).

Questions about sponsorship or approval may reveal confusion about a legal proposition, namely, “confusion about what trademark law actually requires—but it is not confusion that causes the sort of harm trademark law cares about and it should not be actionable.” Stacey L. Dogan & Mark A. Lemley, *Parody as Brand*, 47 U.C. DAVIS L. REV. 473, 482 (2013). *See, e.g., Elec. Arts*, 724 F.3d at 1245 (plaintiff relied on “a consumer survey demonstrating that a majority of the public believes that identifying marks cannot be included in products without permission”). This is a problem of circularity: a misunderstanding of whether a license or permission is legally required to make a parody creates “confusion” was to whether there was permission in the instant case. Using the multifactor test, if a survey shows that over 15% of consumers believe that a biographer needed the permission of his subject, the biographer would be at risk of infringement liability. This result is wrong, and *Rogers* is designed to avoid it by requiring explicitness in cases where false positives are extremely risky to valuable speech.

This case is a textbook example of this circularity in parody cases, and demonstrates why JDPI’s reliance on the “29% confusion” result produced by the survey of its expert, Dr. Gerald Ford, is misplaced. As

VIP's rebuttal expert, Dr. Stephen Nowlis, explained, Dr. Ford failed to analyze the results "in light of the fact that the Bad Spaniels dog toy is a parody of a Jack Daniel's liquor bottle." J.A.83–84. Dr. Nowlis's report showed that "the largest group who were counted by Dr. Ford as supposedly confused were those answering the question about authorization and approval," and they "were likely trying to figure out if a parody needs authorization or approval from the company it is spoofing." J.A.82–83. When the parodic character of Bad Spaniels was considered, "it is clear that many respondents in fact recognized that the product is made or put out by VIP Products, and yet were thinking that VIP would need to get authorization or approval from Jack Daniel's in order to sell such a parody." J.A.84.

Even if Dr. Ford's survey were otherwise unflawed, the circularity problem makes it misleading. Factors that cannot help resolve a class of cases, and that affirmatively distort the analysis, should not be used in those cases.

Second, and more fundamentally, neither JDPI nor the district court has justified why a threshold number that is meaningful in a purely commercial context should be considered equally meaningful in a parody context. Circuits have recognized that the public interest in free discourse justifies tolerating a level of confusion that might be actionable in other contexts. As the Fourth Circuit noted, "a parody necessarily must engender some initial confusion,

[but] an effective parody will diminish the risk of customer confusion.” *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001). Similarly, the Eleventh Circuit rejected survey evidence of 22% confusion “because any misunderstanding represented by the survey data was ‘not engendered by any overt claim’” by the defendant. *MGFB*, 54 F.4th at 682 (quoting *Rogers*, 875 F.2d at 1001).

So, too, the Third Circuit recognized that, in cases of nominative fair use, the proper approach “allows for the possibility that a district court could find a certain level of confusion, but still ultimately determine the use to be fair.” *Century 21*, 425 F.3d at 232. The court concluded that “consumer confusion and fair use are not mutually exclusive. The latter will in essence rebut or excuse the former so that the use is permissible.” 425 F.3d at 217–18 (citing *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004)).

In the case of parodies and other artistic expression, the same is particularly true where the confusion is based on a false legal premise—even an unreasonable false premise—that does not affect consumer behavior.

C. The *Rogers* test strikes an appropriate balance.

Rogers provides a valuable adjunct to the multifactor test by establishing a threshold that can screen qualifying expressive works from the expensive and time-consuming litigation process and uncertainty that the multifactor test engenders. As formulated by the Second Circuit, *as to an artistic expression*, the *Rogers* test asks (a) whether the allegedly infringing use has “no artistic relevance to the underlying work whatsoever,” and (b) whether it “explicitly misleads as to the source or the content of the work.” *Rogers*, 875 F.2d at 999. If the work fails either of these conditions, it is subject to the general multifactor test. *See Gordon*, 909 F.3d at 264 (“[T]he plaintiff claiming trademark infringement bears a heightened burden—the plaintiff must satisfy not only the likelihood-of-confusion test but also at least one of *Rogers*’s two prongs.”).

JDPI errs by describing the *Rogers* test as contrasting with the “likelihood of confusion” test. The *Rogers* test is very much a likelihood-of-confusion test, but it is different from the *multifactor* test. *Rogers* is a threshold way, in the context of expressive speech, of evaluating the likelihood of confusion that can be resolved more readily by summary judgment or even a motion to dismiss, without the need to build cases on each component of the multifactor test. It is a sieve to separate expressive speech from the close calls.

1. The “artistic relevance” prong

The first prong of the *Rogers* test—whether the defendant’s work has “no artistic relevance to the underlying work whatsoever”—essentially asks the question that cuts to the core of consumer decision making: What is the consumer buying? If the consumer is primarily buying the artistic expression, then what is at stake is protected speech. If the consumer is primarily buying a widget, and the humorous trademark is no more than an attempt to trigger initial interest in that widget by playing off an established brand, then the purchase transaction is more likely to be purely commercial and the dispute is relegated to the multifactor test.

In the case of *Bad Spaniels*, the purchaser is buying the parodic message embodied in the dog toy, and consumers’ use and display of it can likewise serve as their free expression. The parodic content of *Bad Spaniels* does not serve to communicate what the product *is*—*Bad Spaniels* is obviously not a real bottle of whiskey (or of anything else). No one is buying a pretend-trademarked bottle of diluted poo. If one buys a parody t-shirt or parody coffee mug, one may similarly take it for granted that the driver of the purchase is the parody, because people buy plain shirts or mugs if all they want is the function. *Rogers*, therefore, applies at the very least to mediums that can serve as vehicles for expression.

In contrast, consumers buying “Stoneo” cookies and “Dom Poppingnon” popcorn are buying pot-laced cookies and high-quality popcorn, not social commentary. The trademarks are actual trademarks for the goods people are buying, which are described by their trademarks and are not themselves parodies. In such situations, ordinary commercial-speech rules can be applied with less risk to protected speech. The *Rogers* test is “not an automatic safe harbor for any minimally expressive work that copies someone else’s mark.” *Gordon*, 909 F.3d at 261.

Illustrations of how the *Rogers* test can separate out legitimate artistic expressions from illegitimate ones that claim the name come from the Second Circuit’s decisions after *Rogers*. For example, in *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806 (2d Cir. 1999), which involved the motorcycle manufacturer’s suit against a shop that was repairing Harleys, the court explained that, under *Rogers*, “[w]e have accorded considerable leeway to parodists whose expressive works aim their parodic commentary at a trademark or a trademarked product.” *Id.* at 812. The court declined to apply *Rogers* in that case because there was humor but no parody: defendant’s “mark makes no comment on Harley’s mark; it simply uses [Harley’s mark] somewhat humorously to promote his own products and services, which is not a permitted trademark parody use.” *Id.* at 813.

Bad Spaniels, like the title “Ginger and Fred” in *Rogers*, is at the very least “of a hybrid nature,

combining artistic expression and commercial promotion,” and “[t]he artistic and commercial elements ... are inextricably intertwined.” 875 F.2d at 998. It employs the same kind of “word-play, ambiguity, irony, and allusion” that “require[] more protection than the labeling of ordinary commercial products.” *Id.*

Artistic relevance is, appropriately, broad and flexible once there is an underlying expressive work. In two cases concerning video games, the Ninth Circuit emphasized that the expression does not have to be “about” the plaintiff’s mark. *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008); *Elec. Arts*, 724 F.3d at 1243. Rather, “the level of relevance merely must be above zero.” *E.S.S.*, 547 F.3d at 1100. Both Rockstar’s use of an adult-entertainment club’s likeness in *Grand Theft Auto: San Andreas* and EA’s use of football great Jim Brown’s likeness in *Madden* related to the defendants’ goal of simulating realistic environments of L.A. nightlife and NFL football. *E.S.S.*, 546 F.3d at 1100; *Elec. Arts*, 724 F.3d at 1243. In parody cases, courts can also determine whether parody actually is the product. *See, e.g., Gordon*, 909 F.3d at 269 (“Gordon’s mark is certainly relevant to defendants’ greeting cards; the phrase is the punchline on which the cards’ humor turns.”).

Even if a parody or other artistic expression plays on the fame of the object of the parody or expression, the added value of the expression is what

differentiates it and adds speech-based value to the public. The test does *not* turn, however, on whether consumers necessarily get the gist of the artistic impression. “First Amendment protections do not apply only to those who speak clearly, whose jokes are funny, and whose parodies succeed.” *Walking Mountain*, 353 F.3d at 801. Whether or not successful, parodies necessarily rely on the fame of those parodied, be they government officials, actors, or other celebrities. Licenses are not needed for stand-up comedy routines. Iconic brands are not entitled to protections against parody that presidents, congressional leaders, and Supreme Court Justices do not receive.

2. The “explicitly misleading” prong

Even more clearly, the *Rogers* test’s “explicitly misleading” prong “points directly at the purpose of trademark law, namely to avoid confusion in the marketplace,” but it does so in a way that is more readily determinable from the face of the product. *See Gordon*, 909 F.3d at 269. In this case, the district court determined that the Bad Spaniels product was not explicitly misleading. Pet.App.15a–18a. In successfully moving for summary affirmance by the Ninth Circuit on whether on the *Rogers* test applied, JDPI expressly waived any “challenge [to] the district court’s post-remand ruling on appeal.” Ninth Cir. Dkt. 14-1 at 15. Bad Spaniels thus undeniably passes the test.

III. Liability for dilution by tarnishment should not be stretched to the unconstitutional extremes proposed by JDPI.

The provision of the Lanham Act that proscribes “dilution by tarnishment” runs afoul of the First Amendment, especially as applied to parodies and noncommercial speech. 15 U.S.C. § 1125(c)(1). “Dilution by tarnishment” is defined as “association ... that *harms the reputation* of the famous mark.” 15 U.S.C. § 1125(c)(2)(C) (emphasis added). That is a paradigmatic *viewpoint-based* restriction. The Court need not resolve its status in this case, however, because the statute provides (i) an exclusion for “[a]ny noncommercial use of a mark,” 15 U.S.C. § 1125(c)(3)(C), and (ii) an exclusion for “[a]ny fair use ..., including ... parodying” the famous mark or its owner, 15 U.S.C. § 1125(c)(3)(A). Those exclusions provide the “narrow specificity” of government regulation and the “breathing space” that First Amendment freedoms need to survive. *NAACP v. Button*, 371 U.S. 415, 433 (1963).

The Ninth Circuit held that dilution by tarnishment did not apply to Bad Spaniels because of the noncommercial-use exclusion. This Court may affirm based on that exclusion or, alternatively, the fair-use exclusion for parodies. In addition, the Court may affirm based on two threshold considerations for dilution claims: (1) “Bad Spaniels” does not constitute “use of a mark or trade name” within the meaning of 15 U.S.C. § 1125(c)(1) because it is not a real

trademark; and (2) “Bad Spaniels” does not use the “Jack Daniel’s” famous mark, as JDPI’s then-president testified that JDPI does not claim that words “Bad Spaniels” infringed JDPI’s “Jack Daniel’s” trademark. Dkt. 235 at 68–69.

A. Dilution by tarnishment raises serious First Amendment concerns, particularly when applied to parody.

If barring the registration of a “disparaging” trademark is unconstitutional viewpoint discrimination, *Tam*, 137 S. Ct. at 1763, then enjoining use of a disparaging mark that “harms the reputation” must be as well because it is even clearer that “speech is being restricted.” *Iancu v. Brunetti*, 139 S. Ct. 2294, 2303 (2019) (Roberts, C.J., concurring).

The Lanham Act’s tarnishment proscription amounts to “content-based restrictions on speech” that are not “confined to the few historic and traditional categories of expression long familiar to the bar,” which “have a historical foundation in the Court’s free speech tradition.” *United States v. Alvarez*, 567 U.S. 709, 717–18 (2012) (plurality) (cleaned up) (striking down Stolen Valor Act even though it “targets falsity and nothing more”). For example, the dilution provision is not about preventing confusion: the statute specifies that dilution by tarnishment may be enjoined “regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.” 15 U.S.C.

§ 1125(c)(1); *see, e.g., MCA Records*, 296 F.3d at 904. Nor does it satisfy any of the elements of trade defamation. *E.g., Laserworks v. Pitney Bowes, Inc.*, 105 F. App'x 657, 661 (6th Cir. 2004) (Ohio law).

Dilution by tarnishment is problematic because it is inherently one-sided: speech that “harms” or “tarnishes” a mark’s reputation is prohibited, but speech that burnishes a mark’s reputation is not. JDPI would have no tarnishment claim against unauthorized positive speech. A content-based restriction like this is antithetical to the “core postulate” of content neutrality in speech regulation. *Brunetti*, 139 S. Ct. at 2299. “Giving offense is a viewpoint,” *Tam*, 137 S. Ct. at 1763, and the tarnishment provision is, like the disparagement bar in *Tam*, a “happy-talk clause,” *id.* at 1765 (op. of Alito, J.).

Parody is a dangerous test case for the tarnishment provision’s constitutionality because, by its nature, parody tarnishes. As the Court has explained, “parody may quite legitimately aim at garroting the original, destroying it commercially as well as artistically.” *Campbell*, 510 U.S. at 592 (cleaned up). A parodist exposes marks to criticism that could give a consumer pause. “Since parody seeks to ridicule sacred verities and prevailing mores, it inevitably offends others, as evinced by the shock which Chaucer’s *Canterbury Tales* and Voltaire’s *Candide* provoked among their contemporaries.” *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 28

(1st Cir. 1987). “Destructive parodies” have a role to play “even though they may discourage or discredit.” *Fisher v. Dees*, 794 F.2d 432, 437–38 (9th Cir. 1986). This includes parodies that rely on scatological humor. *See, e.g., Hustler*, 485 U.S. at 51 (profane Campari ad parody targeting religious leader). Once “Jack” entered popular culture as everyone’s “friend” and “lover,” *see supra* pp. 19–23, and “the public imbue[d] his mark with a meaning beyond its source-identifying function,” JDPI lost “the right to control public discourse.” *Walking Mountain*, 353 F.3d at 807.

The paltry evidence in this case illustrates the threat that the tarnishment cause of action poses to free speech. The district court relied entirely on the subjective impression of Dr. Itamar Simonson, a marketing professor, who opined that Bad Spaniels “is an extreme example of likelihood of tarnishment,” because “if you associate any food or beverage with defecation, you are creating disgust with respect to that food or beverage that is being now associated with defecation.” J.A.236, 240. Speaking on behalf of all “normal people,” he invoked “principles of consumer psychology” to reach a “common sense conclusion” that poop “is not something that you would like to associate ... anything you eat or drink with.” J.A., 235, 229. Indeed, Dr. Simonson claimed that Bad Spaniels “will generate the disgust” even though “[c]onsumers are not stupid. No one would think there’s poo in the Jack Daniel’s product.” J.A.236. He conducted no surveys or focus groups to verify his conclusion. J.A.239–40. Moreover, his

testimony was controverted by that of VIP's expert, Bruce Silverman, a leading advertising executive and consultant, who conducted four focus groups that produced unanimous results: "they thought it was funny," and "they thought that [the idea the toy created disgust] was ludicrous." J.A.317-18. "Nobody was disgusted ... or suggested that anyone would be disgusted by the toy or disgusted by Jack Daniel's because of the toy." Dkt. 129-1 at 17 (cleaned up).

Freedom of speech should not be reduced to a battle of "experts" or turn on whether one judge buys such "common sense" hokum. "We have said time and again that 'the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers.'" *Tam*, 137 S. Ct. at 1763 (quoting *Street v. New York*, 394 U.S. 576, 592 (1969)). A claim of dilution by tarnishment is not warranted by JDPI's disdain for a playful association with an unhousebroken spaniel. Nor can it be justified, as JDPI and its liquor-industry amici claim, by a concern for the welfare of children, because, when it comes to Bad Spaniels, the only thing being consumed is the joke.

B. The Court should interpret the noncommercial-use exclusion consistent with its commercial-speech doctrine.

The statutory exclusion for "[a]ny noncommercial use of a mark" in 15 U.S.C. § 1125(c)(3)(C) does not stand alone, and it is not appropriately interpreted, as

JDPI suggests, by reference to markedly unhelpful dictionary definitions of “noncommercial” as “not commercial,” and “commercial” as “concerned with or engaged in ‘the activity of buying and selling.’” JDPI Br. 40. To the contrary, courts and commentators have interpreted “noncommercial use” by referring to this Court’s precedent on the distinction between commercial and noncommercial speech. *See, e.g., Radiance*, 786 F.3d at 331; *MCA Records*, 296 F.3d at 905–06.

JDPI’s “not buying and selling” argument does not work even on a plain-language level. The dilution statute requires at the threshold that the defendant has used a diluting mark or trade name “in commerce.” 15 U.S.C. § 1125(c)(1). If “noncommercial” means “not buying and selling,” then the noncommercial-use exclusion would only exclude uses that were outside the scope of the dilution statute in the first place. This Court avoids a construction that renders portions of a statute redundant. *See, e.g., Gustafson v. Alloyd Co.*, 513 U.S. 561, 574 (1995).

In interpreting “noncommercial use” in an expressive context, the *natural* resource for analogy and reference would be this Court’s commercial-speech doctrine, which has already given content to the term in the specific context of laws related to speech. Interpreting the noncommercial-use exclusion as referring to “speech that is not pure ‘commercial speech’ as understood in First Amendment jurisprudence” is “the only interpretation consistent

with ... the overall purpose and structure of federal trademark dilution law.” Lee Ann W. Lockridge, *When Is a Use in Commerce a Noncommercial Use?*, 37 FLA. ST. U.L. REV. 337, 338, 367 (2010). It also “is consistent with the rationale for why the First Amendment review of commercial speech restrictions differs from review of noncommercial speech restrictions,” and “will provide more predictable results in litigation and an earlier end to dilution claims in appropriate cases.” *Id.* at 364, 367.

Moreover, as the Ninth Circuit concluded after the reviewing the exclusion’s legislative history, this was precisely what Congress intended. *MCA Records, Inc.*, 296 F.3d at 905–06; *see, e.g.*, 4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:128 (5th ed. 2022) (“MCCARTHY”) (“Legislative history indicates that Congress intended the noncommercial exemption to ... incorporate the Supreme Court’s concept of ‘commercial speech.’”).

This Court has long held that “the core notion of commercial speech” is “speech which does ‘no more than propose a commercial transaction.’” *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66 (1983) (quoting *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976)). For purposes of the exclusion, “[p]arody is a form of noncommercial expression if it does more than propose a commercial transaction.” *Walking Mountain*, 353 F.3d at 812.

In *Bolger*, the Court identified three characteristics that it held do *not*, standing alone, “compel the conclusion” that the speech is “commercial,” but a “combination of *all* these characteristics” may provide “strong support” for concluding that there was commercial speech: (1) the speech is “conceded to be advertisements”; (2) the speech makes “reference to a specific product”; and (3) the defendant “has an economic motivation.” *Bolger*, 463 U.S. at 66–67. *See, e.g., Dex Media W., Inc. v. City of Seattle*, 696 F.3d 952, 958 (9th Cir. 2012) (addressing three characteristics). JDPI does not address the *Bolger* characteristics.

And for good reason: Bad Spaniels displays none of them. As to the first characteristic, the pretend trademark for a pretend product “is not advertising the product; it *is* the product.” *Hilton*, 599 F.3d at 905 n.7. As to the second, because there is no diluted-poo product, there is no transaction to be proposed and no product to be offered. As to the third, “the fact that [VIP] has an economic motivation for [creating Bad Spaniels] would clearly be insufficient by itself to turn [it] into commercial speech.” *Bolger*, 463 U.S. at 67.

JDPI also contends that the Ninth Circuit erroneously applied the noncommercial-use exclusion without requiring that VIP also satisfy the fair-use parody defense under 15 U.S.C. § 1125(c)(3)(A). JDPI Br. 42–43. These defenses are disjunctive and can be asserted in the alternative (as VIP did below), and the failure to satisfy the requirements of one defense does

not preclude application of another. *See, e.g., MCA Records*, 296 F.3d at 904–06 (addressing legislative history); *Radiance*, 786 F.3d at 330. “[T]he overlap of exemptions represents a sort of overabundance of caution to statutorily provide for free speech concerns that the federal anti-dilution law would be used to silence ‘noncommercial’ critics who use the famous marks of companies whose goods, services or policies were being criticized or mocked.” 4 MCCARTHY, *supra*, § 24:128; *see id.* § 24:90 (even source-designating parody “can still be immune under free speech principles”).

In the end, JDPI’s cabined interpretation of “noncommercial use” is both under- and overinclusive. Under its view, a t-shirt that read “Fuck Jack Daniel’s” and mocked it for failing to acknowledge its recipe came from a freed African American slave⁶ could be enjoined if it were sold, but not if it were given away for free. That would violate basic First Amendment principles. *See supra* p. 24. On the other hand, JDPI’s rule would permit a malicious competitor to label bathtub swill as “Hack Daniel’s” and hand out free samples in hopes of killing the brand’s good name. As “Jack” himself might say, that dog won’t hunt.

⁶ Clay Risen, *When Jack Daniel’s Failed to Honor a Slave, an Author Rewrote History*, N.Y. TIMES, Aug. 16, 2017, available at <https://www.nytimes.com/2017/08/15/dining/jack-daniels-whiskey-slave-nearest-green.html> (last visited Feb. 7, 2023).

C. The parody fair-use exclusion applies with full force.

The Court may affirm the judgment below on the alternative ground of the fair-use exclusion, which exempts from dilution liability “[a]ny fair use ... of a famous mark by another person other than as a designation of source ... including use in connection with identifying and *parodying*, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.” 15 U.S.C. § 1125(c)(3)(A) (emphasis added). The district court rejected the fair-use defense because it erroneously concluded that “Bad Spaniels” was a “designation of source” within the meaning of the statute. As explained above, *supra* pp. 12–16, “Bad Spaniels” and the rest of the product art are *pretend* trademarks and trade dress that constitute the parody, and the real “designation of source” is VIP’s Silly Squeaker® trademark.

The phrase “designation of source” in the fair-use exclusion is far narrower than the corresponding phrase in the infringement provision, which extends to use of “any word, term, name, symbol, or device” that “is likely to cause confusion, or to cause mistake, or to deceive as to ... the *origin, sponsorship, or approval* of his or her goods, services, or commercial activities” 15 U.S.C. § 1125(a)(1)(A) (emphasis added). “Source” corresponds with “origin,” not “sponsorship or approval.” This Court has already warned against unduly expansive interpretations of the “origin” of a

“communicative product.” *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003) (concluding that “origin of goods” “refers to the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods”).

“The general rule permits anyone, competitor, critic or comedian, to use a famous mark to make fun of or to criticize the products or policies of the mark owner” under both the First Amendment and the Trademark Dilution Revision Act. 4 MCCARTHY, *supra*, § 24:90. Where a party uses something that looks like a mark “to comment on, criticize, ridicule, parody, or disparage the other or the other’s goods, services, business, or mark,” tarnishment cannot arise as a matter of law, and the aggrieved party can recover only under the torts of “defamation, invasion of privacy, or injurious falsehood.” Restatement (Third) of Unfair Competition § 25 (1995). Thus, “[a]lthough such nontrademark uses of another’s mark may undermine the reputation and value of the mark, they should not be actionable under the law of trademarks.” *Id.* cmt. i.

As the Court warned in *Dastar*, “[t]he words of the Lanham Act should not be stretched to cover matters that are typically of no consequence to purchasers.” *Id.* at 32–33. No one would reasonably understand a pretend trademark for a pretend product as a “designation of source” of the parody, particularly given the “unlikelihood” that JDPI or similarly iconic

brands would “license ... lampoons of their own productions.” *Campbell*, 510 U.S. at 592. The only “designation of source” is Silly Squeakers®, and any contrary assertion is, well, silly.

CONCLUSION

The Court should affirm the judgment of the Ninth Circuit.

Respectfully submitted,

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