
Case No. 21-16969

In the
United States Court of Appeals
for the
Ninth Circuit

VIP PRODUCTS LLC, an Arizona limited liability company,
Plaintiff / Counter-Defendant and Appellee,

v.

JACK DANIEL'S PROPERTIES, INC., a Delaware corporation,
Defendant / Counter-Plaintiff and Appellant.

*Appeal from the United States District Court for the District of Arizona (Phoenix),
Case No. 2:14-cv-02057-SMM · Honorable Stephen M. McNamee, Senior District Judge*

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

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DISCLOSURE STATEMENT

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

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

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

The undersigned *amicus curiae* respectfully submits this brief in support of the petition filed by Petitioner Jack Daniel’s Properties, Inc. (“JDPI”) seeking *en banc* review of a prior panel decision of this Circuit.

INTEREST OF AMICUS CURIAE

This is the second amicus brief that the International Trademark Association (“INTA”) is filing in this case. In the interest of brevity, INTA refers this Court to its prior statement on the interest of INTA as *amicus curiae*, which is the same as in the previous brief submitted by INTA in this case. See *VIP Prods, LLC v. Jack Daniels Properties, Inc.* (“JDPI I”), Ninth Circuit Case No. 18-16012, Dkt. 64.

SUMMARY OF ARGUMENT

In granting summary judgment of non-infringement to VIP Products, LLC (“VIP” or “Appellee”), the District Court observed that this Circuit’s decisions applying *Rogers* have led to a place where virtually no trademark holder can prevail on trademark infringement claims against an ordinary consumer product that has even a modicum of expression in it. This Circuit’s significant expansion of what constitutes an “expressive work” under *Rogers* also departs from the law of all other Circuits. Only in the Ninth Circuit does a commercial or consumer product with minimal “expression” receive a *Rogers* analysis, a test that was specifically designed to address—and only makes sense in the context of—truly artistic and creative works

(e.g., films). In fact, when confronted with products that defendants have claimed are expressive, this Circuit has never declined to apply *Rogers*, bolstering the District Court's conclusion that this Circuit's *Rogers* precedents preclude trademark enforcement except perhaps in the most egregious of circumstances.

INTA is concerned with the law in one Circuit departing from all others, this Circuit's undue expansion of what constitutes an "expressive work," and the resulting confusion within the district courts in this Circuit. *Rogers* was formulated in the context of a movie title—the kind of work that is inherently expressive and which cannot exist separate from that expression. When applied to such artistic expressions, *Rogers* appropriately balances the rights of trademark owners with the free speech rights of authors. But applying *Rogers* in the context of an ordinary consumer product that can exist independent of the expression placed on it, as the District Court observed, risks eviscerating important protections for brand owners.

This Circuit's panel decision unduly extends heightened First Amendment protection to non-artistic commercial goods that merely include some expression. Dog toys are far removed from the artistic works to which *Rogers* has historically and correctly been limited. This is not a matter of requiring courts to discern good from bad art—which INTA acknowledges courts are loathe to do and is not suggesting. Rather, INTA urges this Court to review its prior *Rogers* jurisprudence and realign with the intended application of *Rogers* and progeny and ensure that the

stronger First Amendment protections that *Rogers* contemplates are limited to traditionally expressive or artistic works. Consumer products that contain expression separable from the products themselves, in contrast, should be analyzed under traditional trademark likelihood of confusion principles and defenses, which already offer robust parody, nominative fair use, and First Amendment defenses.

The panel's analysis of trademark dilution also departs from the established statutory framework, which includes an express exclusion for some parodies, and conflicts with precedents of sister circuits as noted in JDPI's petition.

En banc review should be granted for this Circuit to properly balance the interests of trademark owners, artists and creatives, and manufacturers of consumer products and realign with its sister circuits in applying the Lanham Act.

ARGUMENT

I. When Applying *Rogers*, “Expressive Works” Should Be Limited To Those Products That Are Inherently Expressive.

A. The District Court's Decision On Remand Highlighted the Impossibility For Trademark Owners To Prevail Under This Circuit's Jurisprudence Applying *Rogers*.

On remand from this Court's panel decision, Appellee filed a motion for summary judgment on JDPI's trademark infringement claims. Constrained by this Circuit's precedent applying *Rogers*, the District Court granted the motion, observing that it “appears nearly impossible for any trademark holder to prevail under the *Rogers* test.” In that regard, the District Court expressed concern that a

trademark owner in this Circuit facing a *Rogers* inquiry could only hope to prevail in a case where the defendant is “slapping another’s trademark on [its] own work and calling it [its] own.” *VIP v. Jack Daniels Properties, Inc.*, 2021 WL 5710730, *6 (D. Ariz. Oct. 8, 2021).

In INTA’s view, the well-settled *Rogers* test achieves a balance of important competing rights by creating a higher threshold for infringement by expressive works. *JDPI I* threatens to undo that balance by extending *Rogers* far beyond expressive works. *En banc* review by this Circuit to redirect this line of cases on a more appropriate and balanced path will better harmonize the Ninth Circuit’s approach with that of other Circuits and clarify the proper scope of First Amendment protections for ordinary commercial products to minimize consumer confusion.

B. The *Rogers* Test Was Created For Traditionally Expressive Works, Not Ordinary Consumer Products That Merely Contain Expression.

The *Rogers* test was developed to resolve a specific problem—to shield the authors of expressive works from being significantly limited in their expression due to trademark rights. Specifically, *Rogers* involved a Fellini film about two fictional cabaret performers who imitated the renowned dancing duo Ginger Rogers and Fred Astaire, prompting a suit by Ginger Rogers.

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). On appeal, the Second Circuit affirmed, echoing the distinction between the title of an artistic work and an “ordinary commercial product[],”:

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.

Rogers, 875 F.2d at 1000. The court thus made clear that an ordinary commercial product—a category that encompasses Appellee’s squeaky dog toy—would not foster the same heightened First Amendment concerns as artistic works like movies, books, and songs because consumer confusion is a more legitimate concern when “utilitarian products” are “sold in the commercial marketplace.” *Id.* at 997.

When the *Rogers* court first articulated the artistic relevance test, it did not define the term “expressive work”. Rather, through the use of conventional and traditional works of authorship (books, movies, music) as examples, the numerous cases following *Rogers* implied a mainstream understanding of the term “expressive works” to refer to traditionally artistic works such as movies. Thus, *Rogers* should only apply to works that are inherently expressive, not products that can subsist

independently of some modicum of expression affixed to them. As discussed below, all courts but this Circuit have construed *Rogers* in this manner.

C. Courts Other Than This Circuit Have Consistently Applied *Rogers* Only In The Context of Traditionally Expressive Works, Applying Standard Trademark Principles When Analyzing Ordinary Consumer Products That Contain Expressive Elements.

Apart from this Circuit's jurisprudence applying *Rogers*, other courts have consistently followed the clear distinction between traditionally artistic works (applying *Rogers*) and ordinary commercial products (applying trademark likelihood of confusion principles and defenses). The vast majority of cases involving *Rogers* have dealt with the title or content of traditionally artistic works such as movies, television, film and other audiovisual works, art, books, magazines, and music. See, e.g., *Dr. Seuss Enterprises, L.P. v. ComicMix, LLC*, 983 F.3d 4443 (9th Cir. 2020) (book title and illustration style); see also *JDPI I*, U.S. Supreme Court Case No. 20-365, cases cited in Section I(B) of INTA's amicus brief to the Supreme Court dated October 19, 2020 and discussion thereof. Further, those few departures where this and other Circuits have applied *Rogers* to other types of works all involved works that are inherently expressive and cannot exist absent the expression contained in those works. *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008) (video games); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996) (parody cartoon baseball cards); *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915 (6th Cir. 2003) (a

painting); *Radiance Foundation, Inc. v. NAACP*, 786 F.3d 316 (4th Cir. 2015) (a billboard). Thus, the touchstone of whether *Rogers* applies to a particular work should be whether the product can exist independently of the expression. If not, *Rogers* applies. On the other hand, if the product can exist independent of the expression, then traditional trademark principles and defenses should apply.

Courts have consistently followed this dichotomy. Other than this Circuit’s decision in this case and *Twentieth Century Fox Film Corp. v. Empire Distribution, Inc.*, 875 F.3d 1192 (9th Cir. 2017),¹ INTA is aware of no cases in other circuits that have applied *Rogers* in the context of ordinary consumer products. *See, e.g., Univ. of Alabama, Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012) (applying *Rogers* to protect “artistically expressive works” like paintings, prints, and calendars but not “mundane” articles like mini-prints, mugs, cups, flags, towels, and T-shirts); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog LLC.*, 507 F.3d 252 (4th Cir. 2007) (dog toys); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000) (magazines); *Nike, Inc. v. Just Did It Enterprises*, 6 F.3d 1225 (7th Cir. 1993) (t-shirts and sweatshirts); *Anheuser-Busch, Inc. v. VIP*

¹¹ Though *Empire* dealt with a traditionally expressive work—a television series—this Circuit extended *Rogers* to the ancillary goods, including t-shirts and other ordinary consumer goods, used to promote the show. This was the first time this Circuit expanded the reach of *Rogers* to an ordinary consumer product.

Prods., LLC, 666 F. Supp. 2d 974 (E.D. Mo. 2008) (dog toys); *Jordache Enterprises, Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987) (jeans). These consistent decisions underscore that the *Rogers* test is more properly limited to inherently expressive works, not those ordinary consumer products that have some expression on the face of the product.²

The rationale for this distinction is not merely academic but pragmatic. Other circuits have recognized that the primacy of First Amendment principles is more attenuated in comparison to trademark rights in the context of ordinary consumer products. *See, e.g., Jordache Enterprises*, 828 F.2d at 1486 (finding no infringement of JORDACHE mark by LARDASHE parody mark). There, the court found no basis to apply the First Amendment to infringement claims over jeans:

The tension between the first amendment and trademark rights is most acute when a noncommercial parody is alleged to have caused tarnishment, a situation in which first amendment protection is greatest. This concern is not as great here because Lardashe is being used as a trademark to identify a commercial product.

Id. at 1490 n.7; *see also Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996) (parody baseball cards successfully amused, and did

² Somewhat ironically, the panel decision in *JDPI I* cited to the *Haute Diggety Dogg* case, which did not apply *Rogers* to determine whether a dog toy infringed, instead applying traditional likelihood of confusion analysis and a parody defense, leading to a defense judgment. 953 F.3d at 1175.

not confuse); *Univ. of Alabama, Bd. of Trustees* 683 F.3d. at 1278 (*Rogers* applied to paintings, prints, and calendars but not “mundane” articles like mini-prints, mugs, cups, flags, towels, and T-shirts). These decisions implicitly followed the intuitive distinction that the Second Circuit drew in *Rogers* itself between artistic works and “utilitarian products.” *Rogers*, 875 F.2d at 997.

Importantly, applying trademark principles to an ordinary consumer product that can exist independent of its expression—e.g., a coffee cup, hat, or dog toy—does not deprive a defendant of free speech defenses. As Circuit Judge Leval has written:

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

Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 Colum. J. L. & Arts 187, 210 (2004) (discussing, *inter alia*, the appropriate application of the *Rogers* test). Indeed, even in cases involving ordinary consumer products, the defendant may still avail itself of fair use, parody, and First Amendment defenses, with which defenses defendants often prevail. *See JDPI I*, U.S. Supreme Court Case No. 20-365, pages 6-7 of INTA’s amicus brief to the Supreme Court dated October 19, 2020.

Critically, INTA does not posit that this Court, or any other, should engage in an analysis of whether the expression in question in a given case is worthy of

protection. Courts are not art critics and, appropriately, this Court has expressed ample skepticism about requiring courts to determine what is meaningful art or commentary and what is not. *See, e.g., JDPI I*, 953 F.3d at 1175. Rather, the analysis INTA suggests does not vary based on the quality or nature of the commentary but rather whether it is an inextricable part of the work itself. Such a distinction is both easy to apply consistently and also comports with every other Circuit’s jurisprudence applying *Rogers*.

INTA therefore urges this Circuit to adjust its application of *Rogers* to align with the original intent of the *Rogers* test (i.e., to provide heightened First Amendment protection in cases where the work and the expression are inextricably intertwined) and other courts’ uniform application of *Rogers* only to inherently expressive works and general trademark principles to ordinary consumer products that contain elements of expression that are separable from the product itself.

D. Without Correction, This Circuit’s Extension Of *Rogers* To Works That Are Not Traditionally “Expressive Works” Inappropriately Tilts The Balance Against The Application of Trademark Law And Its Protection Of Consumers.

As discussed above, this case warrants review by this Court because the Ninth Circuit’s approach is out of step with all of the other Circuits that have analyzed *Rogers* or considered the trademark limits on commercial parodies. It is an outlier that threatens to undermine long-standing likelihood of confusion analysis for

products that include expression that is not inextricably intertwined with the product itself.

The panel's reliance on *Hurley v. Irish-Am. Gay, Lesbian and Bisexual Grp. of Bos., Inc.*, 515 U.S. 569 (1995), appears to be the basis of this Circuit's misstep in expanding *Rogers* to ordinary commercial products. Noting that "the Constitution looks beyond the written or spoken words as mediums of expression," the panel implicitly concluded that the medium is irrelevant to whether the work is eligible for *Rogers* protection. While INTA does not dispute the larger point under *Hurley* that the medium of expression does not inform *whether* the First Amendment applies, it does posit that the *level* of First Amendment protection does—and should—vary depending on the medium of the expression. As discussed in Section I(C), *supra*, all other courts other than this Circuit have only applied heightened First Amendment protection under *Rogers* to traditionally expressive works where the expression and the work cannot be decoupled, while applying traditional trademark principles—which themselves offer First Amendment defenses—to ordinary consumer products that also bear some expression.

Maintaining this Circuit's holding in this case creates a floodgates problem and is also at odds with the purpose of the *Rogers* doctrine. *JDPII*, 953 F.3d at 1175 (citing *Hurley*, 515 US 557, 569) (holding that a private group's decision to exclude another group's participation in a parade constituted an act of protectable

expression). Such a standard fails to strike the proper balance between trademark law and the First Amendment.

Indeed, defining *Rogers*-eligible expressive works as any fixed expression on any product is untenable because it opens virtually every category of product to the heightened *Rogers* standard. It is hard to envision a product that cannot in some way convey a message. Consider the tens of thousands of utilitarian products (clothing, mugs, bags, phone cases, jewelry, electronics, stickers, housewares, etc.) 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).

In contrast, consumers perceive marks differently when encountering them in traditional works of authorship. As the Second Circuit noted in *Rogers*, “...most consumers are well aware that they cannot judge a book solely by its title any more than by its cover.” *Rogers*, 875 F.2d at 1000. Accordingly, the application of the higher “explicitly misleading” standard is justified by the notion that consumers are less likely to interpret a mark appearing, for example, in the title or body of an artistic work as a trademark, and therefore a lessened likelihood of confusion exists absent

clear conduct on the defendant's part to mislead consumers.³

On the other hand, the application of the artistic relevance prong of *Rogers* is inappropriate when the expression on a defendant's product is conceptually separable from the underlying product itself. The expression in a book or movie—or even, potentially, a greeting card—cannot be separated from the medium. No blank novels or movies exist. The same cannot be said for coffee mugs or tote bags or dog toys. The question of artistic relevance is therefore comprehensible and logical in traditional works of authorship because the work and the expression are intertwined and inseparable. If a defendant's work is not a work of authorship but rather a utilitarian product (e.g. a coffee mug, tote bag, or dog toy), then the heightened explicitly misleading test too strongly shields defendants except in the most blatant of infringements.

In *JDPII*, the panel thus completely untethered *Rogers* from its moorings by applying it to a dog toy—the precise type of “utilitarian” and “mundane” product that courts, including the *Rogers* court itself, have recognized are not entitled to

³ The District Court in this case on remand concluded that the “explicitly misleading” prong of the *Rogers* test may constitute an overly high burden for trademark owners to overcome. INTA does not take a position on the appropriateness of the “explicitly misleading” factor under *Rogers* but reserves its rights to make a substantive comment on the appropriate definition or application of that prong of the test should INTA have the opportunity to submit an amicus brief during the merits briefing if this Court grants *en banc* review.

preferential First Amendment protection. Nevertheless, the Ninth Circuit panel concluded that the dog toy in this case was an “expressive work” deserving of First Amendment protection simply because it “communicated a humorous message.” *JDPI I*, 953 F.3d at 1175.

No basis in First Amendment jurisprudence exists for this sort of protection. Outside the Ninth Circuit, the limits of *Rogers* are well-settled. Until the *Empire* decision, this Court’s own precedents suggested no greater protection. *Empire Distribution*, 875 F.3d at 1196-97 (extending *Rogers* to the ancillary consumer products used to advertise and market the *Empire* television show—noting that to prohibit such advertising would effectively gut *Rogers* protection). At most, a dog toy would be considered a form of commercial speech that would be subject to intermediate scrutiny, which allows trademark law to regulate such uses to advance the important interest of protecting the public from confusion. *See San Fran Arts & Athletics, Inc. v. US Olympic Committee*, 483 U.S. 522, 535, 541 (1987) (use of mark to induce sale of goods is “commercial speech,” which “receives a limited form of First Amendment protection”); *Central Hudson Gas & Electric Corp. v. Public Service Comm.*, 447 U.S. 557, 562-63 (1980) (“The Constitution [] accords a lesser protection to commercial speech than to other constitutionally guaranteed expression.”). Nothing in the Supreme Court’s free speech jurisprudence, or in the text or history of the First Amendment, supports the constitutional protection that

this Circuit would afford to the Bad Spaniels dog toy. This overapplication of First Amendment protection will, over time, lead to innumerable commercial parodies that, to the extent they cause confusion, will erode the capacity of trademarks to effectively signal source and quality.

This Circuit should therefore revisit its *Rogers* jurisprudence and define an “expressive work” as one whose expression cannot be removed from the work without destroying the work itself. Absent such review, trademark owners will be left with no redress when sellers of ordinary consumer products co-opt others’ marks but include a modicum of expression to afford themselves heightened First Amendment protections to which they should not be entitled. This is not a question of the quality of expression involved but rather whether the expression is extricable from the ordinary consumer product itself. Without this critical distinction, this Circuit’s jurisprudence applying *Rogers* leaves trademark owners with little, if any, recourse when having to enforce against sellers of ordinary consumer products that contain some expression. Traditional trademark principles are more than adequate to fairly adjudicate such issues. This Circuit should dial back its precedents applying *Rogers* to align with other Circuits and to ensure that when sellers of ordinary consumer products adopt another’s mark, they are not afforded more First Amendment protection than they are reasonably entitled to.

II. The Ninth Circuit’s Dilution Analysis Departs From The Existing Statutory Framework And Warrants Review.

The Ninth Circuit should also grant review to apply the correct analysis for determining “commercial” speech. While INTA urges the application of the correct analytic framework, INTA takes no position on whether the use at issue constitutes dilution.

The Trademark Dilution Revision Act (“TDRA”) outlines several defenses – including for certain parodies, news reporting and noncommercial uses – that strike a balance with the First Amendment. 15 U.S.C. § 1125(c)(3). The panel conducted an oversimplified analysis of JDPI’s dilution claim by applying only the noncommercial use defense—without separate analysis. The panel disregarded the limits of the parody exclusion, focused on the exclusion for noncommercial uses, and found the dog toy noncommercial because it “was used to convey a humorous message.” *JDPI I*, 953 F.3d at 1176. But the legislative history of the dilution provisions of the Lanham Act and the jurisprudence under it make clear that the proper analysis of whether speech is commercial is the Supreme Court’s concept in *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983).

Rather than reject the dilution claim on First Amendment grounds, the panel should have analyzed the claim using the established statutory framework and merits of whether the toy was likely to tarnish or erode the distinctiveness of the brand owner’s marks. Although the dilution claim was not addressed in the district court’s

decision on remand, dilution remains a ripe issue in this case. While addressing *Rogers* and the balance of the rights of brand owners and the First Amendment, this Court should also realign the law of trademark dilution in this circuit.

CONCLUSION

This Circuit's jurisprudence applying the *Rogers* test has reached a point where trademark owners are left with no remedy when others appropriate their trademarks on products that bear some cognizable expression. *Rogers* was never meant to be so broadly applied. This Circuit should define "expressive works" to be works whose expression is inextricable from the work itself to balance which cases are subject to the heightened First Amendment protection offered by *Rogers*.

Likewise, this Circuit should require a *Bolger* analysis before determining that the non-commercial exemption to dilution liability applies under 15 U.S.C. Section 1125(c)(3)(C).

Accordingly, this Court should grant JDPI's petition for review *en banc*.

Dated: April 25, 2022

Respectfully submitted,

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- is an **amicus** brief and complies with the word limit of Fed. R. App. P. 29(a)(5), Cir. R. 29-2(c)(2), or Cir. R. 29-2(c)(3).
- is for a **death penalty** case and complies with the word limit of Cir. R. 32-4.
- complies with the longer length limit permitted by Cir. R. 32-2(b) because (*select only one*):
 - it is a joint brief submitted by separately represented parties;
 - a party or parties are filing a single brief in response to multiple briefs; or
 - a party or parties are filing a single brief in response to a longer joint brief.
- complies with the length limit designated by court order dated .
- is accompanied by a motion to file a longer brief pursuant to Cir. R. 32-2(a).

Signature

Date

(use "s/[typed name]" to sign electronically-filed documents)

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I hereby certify that on April 25, 2022, I electronically filed the foregoing with the Clerk of the Court for the United States Court of Appeals for the Ninth Circuit by using the appellate CM/ECF system.

I certify that all participants in the case are registered CM/ECF users and that service will be accomplished by the appellate CM/ECF system.

/s/ Vijay K. Toke
Vijay K. Toke