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INTERNATIONAL TRADEMARK ASSOCIATION

675 Third Avenue, New York, NY 10017-5704

Telephone: +1 (212) 642-1700

email: wknox@inta.org

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CONSTITUTIONAL AVOIDANCE AND
STANDARDS OF PROOF IN TRADEMARK
INFRINGEMENT LITIGATION:
A COMMENT ON POST-*JACK DANIEL'S*
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FOR LIABILITY

*By Theodore H. Davis Jr.**

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* Partner, Kilpatrick Townsend & Stockton LLP, Atlanta, Georgia, Associate Member, International Trademark Association; adjunct professor, Emory University School of Law; member, Georgia, New York, and District of Columbia bars.

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I. INTRODUCTION

In *Jack Daniel's Properties, Inc. v. VIP Products LLC*,¹ the Supreme Court resolved a split among the federal circuit courts of appeal—most pronounced where the Second and Ninth Circuits were concerned—as to whether the pro-defendant test for liability for trademark infringement and unfair competition first set forth in *Rogers v. Grimaldi*² applied in cases challenging uses by defendants that are source-identifying in nature. The Court answered that question in the negative, holding that “[w]hen a mark is used as a mark (except, potentially, in rare situations), the likelihood-of-confusion inquiry does enough work to account for the interest in free expression.”³ In doing so, the Court expressly tempered its holding by observing that “[w]e do not decide whether the *Rogers* test is ever appropriate On infringement, we hold only that *Rogers* does not apply when the challenged use of a mark is as a mark.”⁴ At the same time, a concurring three-Justice bloc led by Justice Gorsuch commented both that “it is not entirely clear where the *Rogers* test comes from,”⁵ and “it is not obvious that *Rogers* is correct in all its particulars”⁶

Jack Daniel's therefore leaves open the question of *Rogers*'s viability in cases involving artistic or expressive works in which allegedly infringing uses are *not* designations of source for defendants' own goods and services, a scenario underlying many (and possibly most) applications of *Rogers*. Moreover, to the extent the *Rogers* test *does* remain viable in that context, another critical circuit split exists between the Second Circuit and the Ninth Circuit regarding the proper application of *Rogers*'s second prong, namely, the inquiry into whether a defendant's use is explicitly misleading. *Jack Daniel's* therefore cannot be read to resolve all outstanding *Rogers*-related issues.

¹ 599 U.S. 140 (2023).

² 875 F.2d 994 (2d Cir. 1989).

³ *Jack Daniel's*, 599 U.S. at 159.

The Court did not elaborate on its parenthetical qualifier, of which Professor Farley and Professor Ramsey have observed that:

The truthful use of a term for its dictionary meaning or another type of informational meaning should arguably constitute one of those rare situations where the First Amendment might demand a threshold inquiry like the *Rogers* test even though the mark was used by the accused infringer as a means of source identification.

Christine Haight Farley & Lisa P. Ramsey, *Raising the Threshold for Trademark Infringement to Protect Free Expression*, 72 Am. U. L. Rev. 1225, 1262 n.164 (2023).

⁴ *Jack Daniel's*, 599 U.S. at 163.

⁵ *Id.* at 165 (Gorsuch, J., concurring).

⁶ *Id.* (Gorsuch, J., concurring).

This article addresses the proper application of the second prong of the *Rogers* test. It argues that the constitutional-avoidance doctrine, which requires interpretations of ambiguous statutes in a manner preventing conflicts with the Constitution,⁷ allows courts to accommodate First Amendment considerations by requiring heightened showings of infringement and unfair competition as part of their consideration of that prong. The statutory causes of action for those torts found in Sections 32(1) and 43(a) of the Lanham Act⁸ identify likely confusion as the test for liability,⁹ and it is undisputed that plaintiffs asserting them bear the *burden* of proof regarding that circumstance. Neither statute, however, expressly requires application of a particular *standard* of proof. In other contexts, the Supreme Court has mandated use of the clear-and-convincing-evidence standard of proof to avoid difficult constitutional issues, and that mandate can and should apply with equal force in litigation under the Act. In addition, and as set forth below and suggested by Justice Gorsuch's concurring opinion in *Jack Daniel's*, the Act's unambiguous statutory text necessarily renders the Second Circuit's approach to constitutional avoidance in litigation under Sections 32(1) and 43(a) more appropriate than that of the Ninth Circuit.

II. DIFFERING CONCEPTIONS OF *ROGERS* BY THE SECOND AND NINTH CIRCUITS

The origin and evolution of the *Rogers* test are well known,¹⁰ and this article therefore addresses them only briefly. That test arose in

⁷ See generally *F.C.C. v. Fox Television Stations, Inc.*, 556 U.S. 502, 516 (2009) (“The so-called canon of constitutional avoidance is an interpretive tool, counseling that ambiguous statutory language be construed to avoid serious constitutional doubts.”).

⁸ 15 U.S.C. §§ 1114(1), 1125(a) (2024).

⁹ Because likely confusion is the test for liability for infringement under Section 32(1) and for unfair competition under Section 43(a), and consistent with the approach taken by the Court in *Jack Daniel's*, the remainder of this article does not distinguish between the two. Relatedly, the same torts under state law are typically coextensive with their federal law counterparts. See, e.g., *DaimlerChrysler AG v. Bloom*, 315 F.3d 932, 935 (8th Cir. 2003) (holding state and federal trademark infringement claims “coextensive” and subject to the same analysis, negating need to discuss state law claims independently). (Because it requires a showing of bad faith to support a common-law cause of action for unfair competition, and because proof of consumer injury or harm to the public interest is necessary in actions to vindicate statutory claims to similar effect, New York law is an exception. See *Focus Prods. Grp. Int'l, LLC v. Kartri Sales Co.*, 647 F. Supp. 3d 145, 228–29 (S.D.N.Y. 2022) (defining elements of common-law under common law); *Walker Wear LLC v. Off-White LLC*, 624 F. Supp. 3d 424, 432 (S.D.N.Y. 2022) (interpreting N.Y. Gen. Bus. Law §§ 349 and 350).) Although this article therefore also does not address statutory state-law likelihood-of-confusion-based causes of action separately, its arguments apply to them as well.

¹⁰ See generally Taylor E. Green, *The Rogers Test Dances Between Trademark Protection Under the Lanham Act and Freedom of Speech Under the First Amendment*, 112 TMR 843 (2022); Zachary Shufro, *Based on a True Story: The Ever-Expanding Progeny of*

litigation brought by dancer and actor Ginger Rogers of “Fred and Ginger” fame against the producers of a motion picture titled *Ginger and Fred*, which depicted two aging Italian dancers, who, earlier in their careers, had imitated Rogers and her partner, Fred Astaire. Although “[t]he film received mixed reviews and played only briefly in its first run in the United States,”¹¹ it ran long enough to attract Rogers’s attention. She filed a lawsuit asserting, among other things, that the film’s title “creat[ed] the false impression that the film was about her or that she sponsored, endorsed, or was otherwise involved in the film,” thereby violating Section 43(a) of the Lanham Act and her common-law right of publicity;¹² she also claimed the title defamed her and violated her right of privacy.¹³

The district court granted a defense motion for summary judgment, reasoning that the movie’s title was not commercial speech.¹⁴ The Second Circuit affirmed that finding of nonliability as a matter of law, but it did so for different reasons. “Though First Amendment concerns do not insulate titles of artistic works from all Lanham Act claims,” the appellate court observed, “such concerns must nonetheless inform our consideration of the scope of the Act as applied to claims involving such titles.”¹⁵ The court then articulated the now-familiar test for liability named for the case in which it originated:

[I]n general[,] 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. In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.¹⁶

With some exceptions, post-*Rogers* courts have generally accepted the Second Circuit’s framework for resolving claims of infringement arising from alleged infringements of plaintiffs’ marks

Rogers v. Grimaldi, 32 Fordham Intell. Prop. Media & Ent. L.J. 391 (2022); Kerry L. Timbers & Julia Huston, *The “Artistic Relevance Test” Just Became Relevant: The Increasing Strength of the First Amendment as a Defense to Trademark Infringement and Dilution*, 93 TMR 1278 (2003).

¹¹ *Rogers*, 875 F.2d at 997.

¹² *Id.*

¹³ *Id.*

¹⁴ *Rogers v. Grimaldi*, 695 F. Supp. 112, 124 (S.D.N.Y. 1988), *aff’d*, 875 F.2d 994 (2d Cir. 1989).

¹⁵ *Rogers*, 875 F.2d at 998.

¹⁶ *Id.* at 999.

in the context of artistic or expressive works.¹⁷ Moreover, they also have taken the Ninth Circuit's lead in expanding *Rogers*'s scope beyond the titles of those works to the works' contents.¹⁸ Thus, *Rogers* is routinely invoked in challenges to appearances of plaintiffs' marks or personas (or imitations of those marks and personas) in such works as videogames,¹⁹ motion pictures,²⁰ television series,²¹ photographs,²² musical works,²³ theatrical plays,²⁴ greeting cards,²⁵ trading cards,²⁶ books,²⁷ and artistic prints featuring golfers.²⁸ Moreover, as a doctrine of federal constitutional law, *Rogers* has been applied to unfair competition claims brought under state law.²⁹

Nevertheless, there historically have been two conspicuous circuit splits concerning when and how *Rogers* should be employed.

¹⁷ See Farley & Ramsey, *supra* note 3, at 1246 ("Over time, the *Rogers* test has become one of the dominant speech-protective doctrines that is invoked by accused infringers and applied by courts when alleged trademark infringement is defended as expression protected by the First Amendment.").

One exception is the Seventh Circuit, which has declined to adopt or reject *Rogers* (albeit in opinions reaching findings of nonliability as a matter of law). See, e.g., *Eastland Music Grp. v. Lionsgate Ent., Inc.*, 707 F.3d 869, 871 (7th Cir. 2013) ("Nor need we decide whether to follow *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989), under which the title of an artistic work can infringe a trademark only if it is devoid of artistic significance or explicitly misleading about the work's source. *Rogers* treated that doctrine as an application of the first amendment rather than the Lanham Act, and courts should avoid unnecessary constitutional adjudication."). Another is the District of Colorado, which, in the absence of relevant controlling authority from the Tenth Circuit, has eschewed *Rogers* in favor of a multifactor test aimed at determining whether the defendant had a genuine artistic motive. See *Stouffer v. Nat'l Geographic Partners, LLC*, 400 F. Supp. 3d 1161, 1179 (D. Colo.), *motion to dismiss granted*, 460 F. Supp. 3d 1133 (D. Colo. 2020).

¹⁸ The Ninth Circuit undertook that expansion in *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008), in which it applied *Rogers* to protect the alleged infringement of a plaintiff's mark in a videogame. See *id.* at 1099.

¹⁹ See, e.g., *Romantics v. Activision Publ'g, Inc.*, 574 F. Supp. 2d 758, 769–70 (E.D. Mich. 2008).

²⁰ See *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172, 177 (S.D.N.Y. 2012).

²¹ See *Twentieth Century Fox Television v. Empire Distrib. Inc.*, 875 F.3d 1192, 1196–99 (9th Cir. 2017).

²² See *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806–07 (9th Cir. 2003).

²³ See *Caiz v. Roberts*, 382 F. Supp. 3d 942, 952 (C.D. Cal. 2019).

²⁴ See *Lombardo v. Dr. Seuss Enters.*, 279 F. Supp. 3d 497, 514 (S.D.N.Y. 2017), *aff'd*, 729 F. App'x 131 (2d Cir. 2018).

²⁵ See *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264–71 (9th Cir. 2018).

²⁶ See *Chrysler Corp. v. Newfield Publ'ns, Inc.*, 880 F. Supp. 504, 512 (E.D. Mich. 1995).

²⁷ See *Volkswagen AG v. Dorling Kindersley Publ'g Inc.*, 614 F. Supp. 2d 793, 810–11 (E.D. Mich. 2009).

²⁸ See *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 936–38 (6th Cir. 2003).

²⁹ See, e.g., *Belin v. Starz Ent., LLC*, 662 F. Supp. 3d 1092, 1099 n.2 (C.D. Cal. 2023) (granting motion to dismiss on ground that "the [complaint's] trademark claims under the Lanham Act, state law, and federal common law are all precluded by *Rogers*").

The first, and the only one resolved by *Jack Daniel's*, arose from disagreement over whether *Rogers* applied in cases in which defendants' alleged infringements were in the nature of trademark uses. The Second Circuit held it did not in an opinion that, as the Supreme Court pointed out in *Jack Daniel's*,³⁰ was authored by the same judge who had written *Rogers* itself.³¹ In contrast, the Ninth Circuit adopted the contrary rule that *Rogers* can protect even trademark uses by defendants;³² indeed, it doubled down on that proposition in a particularly ill-timed opinion between the Supreme Court's acceptance of *Jack Daniel's* for review and the Court's disposition of that case.³³

The second split was, and remains, more subtle. In the Second Circuit, the likelihood-of-confusion inquiry and the second prong of the *Rogers* analysis are not entirely distinct from one another. Instead, as the Second Circuit held a mere four years after *Rogers* regarding the evaluation of whether a defendant's use was explicitly misleading:

The question . . . is whether the title is misleading in the sense that it induces members of the public to believe the [defendant's work] was prepared or otherwise authorized by [the plaintiff]. This determination must be made, in the first instance, by application of the venerable *Polaroid* [likelihood-of-confusion] factors. However, the finding of likelihood of confusion must be particularly compelling to outweigh the First Amendment interest recognized in *Rogers*.³⁴

Under Second Circuit authority, uses likely to confuse, on the one hand, and explicitly misleading ones, on the other, therefore occupy different spaces on the same continuum,³⁵ with “explicitly misleads’

³⁰ See *Jack Daniel's*, 599 U.S. at 155.

³¹ See *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812–813 (2d Cir. 1999).

³² See *Twentieth Century Fox Television v. Empire Distrib. Inc.*, 875 F.3d 1192, 1196–99 (9th Cir. 2017).

³³ See *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091, 1099 (9th Cir. 2022) (“[A]ttempting to distinguish between a brand and the body and titles of individual articles fails to appreciate the expressive connection between the publication’s title and brand and the reporting that appears under that heading. . . . Just because a mark is used as a brand . . . does not mean the use of the name is beyond *Rogers*’s coverage.”), *withdrawn*, 78 F.4th 1158 (9th Cir. 2023), *later opinion*, 90 F.4th 1022, 1031 (9th Cir. 2024) (“To the point that our precedents previously held that *Rogers* applies when an expressive mark is used as a mark—and that the only threshold for applying *Rogers* was an attempt to apply the Lanham Act to something expressive—the Supreme Court has now made clear that this is incorrect. In that specific respect, our prior precedents are no longer good law.”).

³⁴ *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (footnote omitted).

³⁵ See, e.g., *Champion v. Moda Operandi, Inc.*, 561 F. Supp. 3d 419, 436 (S.D.N.Y. 2021) (“Although this determination [of whether a defendant’s use is explicitly misleading] is

... appear[ing] to be a more demanding and exacting version of the ‘likelihood of confusion’ standard for ordinary infringement.”³⁶ Thus, although the *Rogers* court itself declined to credit the plaintiffs proffered survey evidence of confusion,³⁷ other courts applying the Second Circuit’s formulation of the test have recognized the potential relevance of confusion survey evidence to it.³⁸

Once again, however, the Ninth Circuit has taken a different approach by holding that the inquiry into whether a defendant’s use is explicitly misleading is wholly separate from that into likely confusion.³⁹ Thus, for example, that court has accused a plaintiff invoking the Second Circuit’s approach as “conflat[ing] the second prong of the *Rogers* test with the general . . . likelihood-of-confusion test, which applies outside the *Rogers* context of expressive works.”⁴⁰ So too has the court held survey evidence of actual or likely confusion irrelevant to that prong.⁴¹ Indeed, some Ninth Circuit opinions have clarified that point by holding that *Rogers*’s second prong sets “a high bar that requires the use to be ‘an “explicit

based on the same considerations as the likelihood of confusion factors for trademark infringement, only a ‘particularly compelling’ finding of likelihood of confusion can overcome the First Amendment interests.” (quoting *Twin Peaks Prods.*, 996 F.2d at 1379)).

Although neither it nor the federal district courts answering to it have applied the *Rogers* test with any frequency, the Fifth Circuit has adopted the Second Circuit’s view of explicitly misleading conduct as something to be established by particularly compelling evidence of likely confusion. See *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665 (5th Cir. 2000); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 & n.7 (5th Cir. 1999).

³⁶ J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 31:144.50 (5th ed.).

³⁷ 875 F.2d at 1001.

³⁸ See *Westchester Media*, 214 F.3d at 667–68 (affirming finding of liability in application of *Rogers* after considering survey evidence of confusion); *Hermès Int’l v. Rothschild*, 678 F. Supp. 3d 475, 486 (S.D.N.Y. 2023) (declining to disturb jury finding of liability under *Rogers* based in part on survey evidence of confusion proffered by plaintiff), *appeal docketed*, No. 23-1081 (2d Cir. July 24, 2023); *Simon & Schuster, Inc. v. Dove Audio, Inc.*, 970 F. Supp. 279, 299 (S.D.N.Y. 1997) (finding liability under *Rogers* after considering confusion survey evidence “to a very limited degree”).

³⁹ See *Gordon*, 909 F.3d at 265 (“If the plaintiff satisfies both elements [of *Rogers*], it still must prove that its trademark has been infringed by showing that the defendant’s use of the mark is likely to cause confusion.”); *accord Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 265 (9th Cir. 2018); see also *Stewart Surfboards, Inc. v. Disney Book Grp.*, No. CV 10-2982 GAF (SSX), 2011 WL 12877019, at *6–7 (C.D. Cal. May 11, 2011) (noting distinction between Second Circuit’s and Ninth Circuit’s approaches to *Rogers*).

⁴⁰ *Twentieth Century Fox Television v. Empire Distrib. Inc.*, 875 F.3d 1192, 1199 (9th Cir. 2017).

⁴¹ See *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245–46 (9th Cir. 2013) (“Adding survey evidence changes nothing. . . . Even if [the plaintiff] could offer a survey demonstrating that consumers of the [challenged videogame] series believed that [the plaintiff] endorsed the game, that would not support the claim that the use was explicitly misleading to consumers.”).

indication,” “overt claim,” or “explicit misstatement” about the source of the work.”⁴² More recently, the court has identified “two primary considerations”—neither of them likely confusion—“in evaluating whether the junior use is explicitly misleading: ‘(1) the degree to which the junior user uses the mark in the same way as the senior user and (2) the extent to which the junior user has added his or her own expressive content to the work beyond the mark itself.’”⁴³ Whatever the precise test for explicitly misleading conduct might be, the Ninth Circuit therefore treats that test as a stand-alone one instead of tying it to the statutory likelihood-of-confusion standard for infringement under the Lanham Act.⁴⁴ It is thus

⁴² *Dr. Seuss Enters. v. ComicMix LLC*, 983 F.3d 443, 462 (9th Cir. 2020) (quoting *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013)); *see also* *Novalogic, Inc. v. Activision Blizzard*, 41 F. Supp. 3d 885, 901 (C.D. Cal. 2013) (“To be ‘explicitly misleading,’ a defendant’s work must make some affirmative statement of the plaintiff’s sponsorship or endorsement, beyond the mere use of the plaintiff’s name or other characteristic.”).

⁴³ *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091, 1100 (9th Cir. 2022) (quoting *Dr. Seuss Enters.*, 983 F.3d at 462), *withdrawn on other grounds*, 78 F.4th 1158 (9th Cir. 2023), *later opinion*, 90 F.4th 1022 (9th Cir. 2024); *accord* *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 270–71 (9th Cir. 2018).

One commentator has characterized the Ninth Circuit’s additional guidance as comprising three, instead of two, considerations. *See* Yen-Shyang Tseng, *Protecting the First Amendment Rights of Video Games from Lanham Act and Right of Publicity Claims*, 48 Pepp. L. Rev. 425, 491 n.501 (2021) (“[T]he Ninth Circuit [has] identified three additional considerations in analyzing the explicitly misleading prong: whether consumers would view the mark alone as identifying the source of the expressive work, the degree to which the user and the mark owner use the marks in the same way, and the extent to which the user adds its own expressive content to the work beyond the mark itself.”).

⁴⁴ *See* *McCarthy*, *supra* note 36, § 31:144.50 (“The Ninth Circuit [has] warned that this ‘explicitly misleads’ test is definitely not the same as the ‘likelihood of confusion’ standard for ordinary infringement.”); Mark Bartholomew & John Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*, 81 Geo. Wash. L. Rev. 1, 50 (2013) (“Although the Ninth Circuit has not adopted [the Second Circuit’s] ‘particularly compelling’ standard, it has set up its own inquiry that replaces the traditional multi-factor likelihood of confusion test with a judicial assessment tilted in the artist’s favor.”); *see also* *Saber Interactive Inc. v. Oovee, Ltd.*, No. 2:21-CV-01201-JHC, 2022 WL 5247190, at *5 (W.D. Wash. Oct. 6, 2022) (“Evidence of consumer confusion does not necessarily make a use explicitly misleading.”); *CI Games S.A. v. Destination Films*, No. 2:16-CV-05719-SVW-JC, 2016 WL 9185391, at *3 n.3 (C.D. Cal. Oct. 25, 2016) (“[A]lthough the Court must evaluate whether a title is ‘explicitly misleading[,]’ the analysis must be distinct from the likelihood of confusion test in order to protect the integrity of the second *Rogers* prong.”); *VIRAG, S.R.L. v. Sony Computer Ent. Am. LLC*, No. 3:15-CV-01729-LB, 2015 WL 5000102, at *12 (N.D. Cal. Aug. 21, 2015) (“The mere use of a mark is not explicitly misleading, even if combined with consumer confusion.”), *aff’d*, 699 F. App’x 667 (9th Cir. 2017); *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp. 2d 1012, 1045 (C.D. Cal. 2006) (“[W]hen First Amendment interests are implicated, the *Rogers* ‘explicitly misleading’ standard applies, not the traditional ‘likelihood of confusion’ test.” *aff’d*, 547 F.3d 1095 (9th Cir. 2008)).

The Sixth Circuit and Eleventh Circuit appear to have adopted the Ninth Circuit’s approach to *Rogers*’s second prong. *See* *Parks v. LaFace Recs.*, 329 F.3d 437, 459 (6th Cir. 2003) (vacating grant of defense motion for summary judgment under first prong of *Rogers* but observing with respect to second prong that “[i]n the present case, the title *Rosa Parks* ‘make[s] no explicit statement that the work is about that person in any

apparent that “there is no single ‘*Rogers* test’ that applies throughout the United States in all trademark disputes involving expressive works.”⁴⁵

III. STANDARDS OF PROOF AS MECHANISMS FOR CONSTITUTIONAL AVOIDANCE

Although sometimes conflated,⁴⁶ the burden of proof and the standard of proof applicable in particular cases are distinct concepts that serve different purposes. With respect to the former, the default common-law rule is that “[t]he burdens of pleading and proof with regard to most facts have been and should be assigned to the plaintiff who generally seeks to change the present state of affairs and who therefore naturally should be expected to bear the risk of failure of proof or persuasion.”⁴⁷ A party assigned the burden of proof must then establish the key elements of its case by satisfying an underlying standard of proof:

[T]he term “standard of proof” . . . refer[s] to the degree of certainty by which the factfinder must be persuaded of a factual conclusion to find in favor of the party bearing the burden of persuasion. In other words, the term “standard of proof” specifies how difficult it will be for the party bearing the burden of persuasion to convince the jury of the facts in its favor. Various standards of proof are familiar—beyond a reasonable doubt, by clear and convincing evidence, and by a preponderance of the evidence.⁴⁸

“The function of a standard of proof . . . is to ‘instruct the factfinder concerning the degree of confidence our society thinks he should have in the correctness of factual conclusions for a particular type of adjudication.’”⁴⁹ Consequently, “[t]he standard serves to allocate

direct sense.’ In other words, Defendants did not name the song, for example, *The True Life Story of Rosa Parks* or *Rosa Parks’ Favorite Rap*.”); *MGFB Props., Inc. v. Viacom Inc.*, 54 F.4th 670, 681–82 (11th Cir. 2022) (discounting survey evidence and holding that “[t]he relevant question is whether (1) the secondary user overtly ‘marketed’ the protected work ‘as “endorsed” or “sponsored”’ by the primary user or (2) ‘otherwise explicitly stated’ that the protected work was ‘affiliated’ with the primary user.” (quoting *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1279 (11th Cir. 2012))).

⁴⁵ Farley & Ramsey, *supra* note 3, at 1245.

⁴⁶ See, e.g., *Bockman v. Lucky Stores, Inc.*, No. CIV S 83-039 RAR, 1986 WL 10821, at *8 (E.D. Cal. Aug. 11, 1986) (“The fact that the defendant employer would still bear the clear and convincing burden of proof would become meaningless since the lowest burden of proof will control.”), *aff’d*, 826 F.2d 1069 (9th Cir. 1987).

⁴⁷ 2 Robert P. Mosteller, Kenneth S. Broun, George E. Dix, Edward J. Imwinkelried David H. Kaye & Eleanor Swift, *McCormick on Evidence* § 337 (8th ed. July 2022).

⁴⁸ *Microsoft Corp. v. i4i Ltd. P’ship*, 564 U.S. 91, 100 n.4 (2011).

⁴⁹ *Addington v. Texas*, 441 U.S. 418, 423 (1979) (quoting *In re Winship*, 397 U.S. 358, 370 (1970) (Harlan, J., concurring)).

the risk of error between the litigants and to indicate the relative importance attached to the ultimate decision.”⁵⁰

The Lanham Act does not expressly provide for a particular standard of proof. Nevertheless, consistent with the usual rules governing civil litigation,⁵¹ courts have with apparent uniformity held that plaintiffs asserting likely confusion must establish its existence by a preponderance of the evidence and testimony.⁵² Indeed, the Supreme Court apparently ratified that standard in *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*,⁵³ in which, while addressing Section 33(b)(4)’s descriptive fair use defense,⁵⁴ it held that “it is only when a plaintiff has shown likely confusion by a preponderance of the evidence that a defendant could have any need of an affirmative defense”⁵⁵ Moreover, to the extent the Ninth Circuit has addressed the standard of proof applicable to its conception of explicitly misleading conduct by a defendant as a stand-alone prerequisite for liability, it has referenced the same standard.⁵⁶

Constitutional avoidance, or the practice of interpreting statutes to prepermit conflicts with the Constitution, has an equally well-established pedigree; indeed, it has been described as the

⁵⁰ *Id.*

⁵¹ *See, e.g., Snyder v. City of Moab*, 354 F.3d 1179, 1188 (10th Cir. 2003) (“[A] preponderance of the evidence is the usual controlling standard in civil litigation.”); Kevin M. Clermont, *Procedure’s Magical Number Three: Psychological Bases for Standards of Decision*, 72 Cornell L. Rev. 1115, 1119 (1987) (“The standard of preponderance of the evidence translates into more-likely-than-not. It is the usual standard in civil litigation . . .”).

⁵² *See, e.g., Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 998 (Fed. Cir. 2020) (“In opposition proceedings, the opposer has the burden of proving a likelihood of confusion by a preponderance of the evidence.”); *Super Duper, Inc. v. Mattel, Inc.*, 382 F. App’x 308, 314 (4th Cir. 2010) (affirming district court’s instruction to jury that plaintiff had burden “of proving a likelihood of confusion by a preponderance of the evidence”); *Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc.*, 270 F.3d 298, 308 (6th Cir. 2001) (“To prove a claim of trade dress infringement under § 43(a) of the Lanham Act, [the plaintiff] must establish, by a preponderance of the evidence . . . that there is a likelihood of confusion”); *Am. Home Prods. Corp. v. Barr Lab’ys, Inc.*, 834 F.2d 368, 371 (3d Cir. 1987) (“In an action for unlawful imitation of product appearance, evidence of defendant’s intent does not relieve plaintiff of its burden of proving likelihood of confusion by a preponderance of the evidence.”); *Prime Home Care, LLC v. Pathways to Compassion, LLC*, 809 N.W.2d 751, 759 (Neb. 2012) (“In a case for trade name infringement, the plaintiff has the burden to prove by a preponderance of the evidence the existence of . . . a substantial similarity between the plaintiff’s and the defendant’s names, which would result in either actual or probable deception or confusion by ordinary persons dealing with ordinary caution.”); *see also Mark A. Lemley & Mark P. McKenna, SCOPE*, 57 Wm. & Mary L. Rev. 2197, 2222 (2016) (“Proving infringement is the IP owner’s burden, always by preponderance of the evidence . . .”).

⁵³ 543 U.S. 111 (2004).

⁵⁴ 15 U.S.C. § 1115(b)(4) (2024).

⁵⁵ *KP Permanent Make-Up*, 543 U.S. at 120.

⁵⁶ *See Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 271 (9th Cir. 2018).

“preeminent canon of federal statutory construction.”⁵⁷ Under that doctrine’s modern iteration, “when deciding which of two plausible statutory constructions to adopt, a court must consider the necessary consequences of its choice. If one of them would raise a multitude of constitutional problems, the other should prevail—whether or not those constitutional problems pertain to the particular litigant before [a] [c]ourt.”⁵⁸ Thus, courts should “construe [a] statute to avoid [serious constitutional] problems unless such construction is plainly contrary to the intent of Congress”;⁵⁹ that qualifier means that the doctrine’s invocation is most—and possibly *only*—appropriate in cases in which in the text of the statute at issue is in some way ambiguous.⁶⁰ Whatever form

⁵⁷ Adrian Vermeule, *Saving Constructions*, 85 Geo. L.J. 1945, 1948 (1997).

⁵⁸ *Clark v. Martinez*, 543 U.S. 371, 380–81 (2005); *see also Zadvydas v. Davis*, 533 U.S. 678, 689 (2001) (“[W]hen an Act of Congress raises ‘a serious doubt’ as to its constitutionality, [a] [c]ourt will first ascertain whether a construction of the statute is fairly possible by which the question may be avoided.” (quoting *Crowell v. Benson*, 285 U.S. 22, 62 (1932))); *Ryan D. Doerfler, How Clear Is “Clear”?*, 109 Va. L. Rev. 651, 686–87 (2023) (“In its ‘modern’ form, the canon of constitutional avoidance instructs courts to adopt a less natural but ‘fairly possible’ interpretation of a statute if giving that statute its ‘most natural’ interpretation would raise ‘substantial constitutional questions.’” (quoting *United States v. X-Citement Video, Inc.*, 513 U.S. 64, 68–69 (1994))).

Under an earlier, or “classical,” conception of the doctrine, constitutional avoidance meant that “as between two possible interpretations of a statute, by one of which it would be unconstitutional and by the other valid, [the Court’s] plain duty is to adopt that which will save the Act.” *Blodgett v. Holden*, 275 U.S. 142, 148 (1927) (Holmes, J., concurring). Professor Walker has explained the difference between that original conception and the one reflected in more modern decisions in the following terms:

[T]he classical version asks whether “the statute would be unconstitutional, while the [modern version] requires only a determination that one plausible reading might be unconstitutional.” Both are implicated only when the statute is ambiguous, but the classical version resolves the ambiguity by choosing a particular construction that is constitutional. The modern version, by contrast, construes the ambiguity to avoid even constitutional doubts without definitively resolving whether those doubts would make the statute unconstitutional.

Christopher J. Walker, *Avoiding Normative Canons in the Review of Administrative Interpretations of Law: A Brand X Doctrine of Constitutional Avoidance*, 64 Admin. L. Rev. 139, 148 (2012) (second alteration in original) (footnote omitted) (quoting Vermeule, *supra* note 57, at 1949).

⁵⁹ *Edward J. DeBartolo Corp. v. Fla. Gulf Coast Bldg. & Constr. Trades Council*, 485 U.S. 568, 575 (1988).

⁶⁰ *See, e.g., Dep’t of Hous. & Urb. Dev. v. Rucker*, 535 U.S. 125, 134 (2002) (stating that constitutional avoidance “has no application in the absence of statutory ambiguity” (quoting *United States v. Oakland Cannabis Buyers’ Coop.*, 532 U.S. 483, 494 (2001))); *Miller v. French*, 530 U.S. 327, 341 (2000) (declining to apply doctrine in light of perceived lack of ambiguity in statute at issue); *see also Joel S. Johnson, Vagueness Avoidance*, 110 Va. L. Rev. 71, 125 (2024) (“In ordinary constitutional avoidance cases, the [Supreme] Court relies on constitutional avoidance to resolve *ambiguity*—the choice between two or more discrete alternative understandings of semantic meaning—and it tends to do so only after first attempting to cure that ambiguity using other ordinary tools of statutory interpretation.”); Richard H. Fallon, Jr., *Facial Challenges, Saving Constructions, and Statutory Severability*, 99 Tex. L. Rev. 215, 250 (2020) (“Narrowing

it takes, *Rogers* therefore may be considered an example of constitutional avoidance, even if courts do not necessarily characterize it as one.⁶¹

Just as constitutional avoidance is a time-honored practice among courts, so too does the adoption of particular standards of proof as mechanisms for premitting constitutional issues appear in opinions from both state tribunals⁶² and their federal counterparts.⁶³ Those include Supreme Court opinions addressing judicial review of actions taken by administrative agencies, which have applied a strong presumption that Congress intends to make review possible so as to comply with the requirements of due process. For example, in *Bowen v. Michigan Academy of Family Physicians*,⁶⁴ the Court rejected an argument by the Secretary of Health and Human Services and other government defendants that, when enacting Part B of the Medicare program,⁶⁵ Congress had barred judicial review of the Secretary's implementing regulations. Quoting the legislative history of the Administrative Procedure Act⁶⁶ (but not the APA itself), the Court held that:

The statutes of Congress are not merely advisory when they relate to administrative agencies, any more than in other

constructions of federal statutes can occur only when statutes are genuinely ambiguous, with more than one plausible interpretation.”).

⁶¹ Although courts applying *Rogers* frequently reference First Amendment considerations, e.g., *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65 (5th Cir. 2000), they do not expressly identify constitutional avoidance as a basis for doing so. Thus, as Justice Gorsuch observed in *Jack Daniel's*, “it is not entirely clear where the *Rogers* test comes from—is it commanded by the First Amendment, or is it merely gloss on the Lanham Act, perhaps inspired by constitutional-avoidance doctrine?” *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 165 (2023) (Gorsuch, J., concurring).

⁶² See, e.g., *Nguyen v. State, Dep't of Health Med. Quality Assurance Comm'n*, 29 P.3d 689, 689 (Wash. 2001) (en banc) (“The issue here is whether the Due Process Clause of the United States Constitution requires proof by clear and convincing evidence in a medical disciplinary proceeding. We hold due process requires no less, reverse and remand.”); *Conservatorship of Wendland*, 28 P.3d 151, 170 (Cal. 2001) (adopting extrastatutory clear and convincing evidence standard of proof on ground that “to permit a conservator to withdraw artificial nutrition and hydration from a conscious conservatee based on a finding, by a mere preponderance of the evidence, that the conservatee would refuse treatment creates a serious risk that the law will be unconstitutionally applied in some cases, with grave injury to fundamental rights”); *Johnson v. Bd. of Governors of Registered Dentists of State of Okla.*, 913 P.2d 1339, 1345 (Okla. 1996) (“Because of the interest at stake in the loss of a license and the potential damage to a professional reputation resulting from disciplinary proceedings, this Court has recognized that the standard of proof in revocation proceedings against a person holding a professional license is a clear-and-convincing-evidence standard.”), *corrected* (May 2, 1996).

⁶³ See, e.g., *United States v. Ruiz-Gaxiola*, 623 F.3d 684, 692 (9th Cir. 2010) (requiring clear and convincing evidence in context of forcible medication of non-dangerous detainees).

⁶⁴ 476 U.S. 667 (1986).

⁶⁵ 42 U.S.C. §§ 1395j–1395w (2024).

⁶⁶ Pub. L. No. 79-404, 60 Stat. 237 (1946) (codified as amended at 5 U.S.C. §§ 551–559 (2024)).

cases. To preclude judicial review under this bill a statute, if not specific in withholding such review, must upon its face give clear and convincing evidence of an intent to withhold it. The mere failure to provide specially by statute for judicial review is certainly no evidence of intent to withhold review.⁶⁷

As another court has explained of that and other holdings to similar effect, “[t]his ‘heightened showing’ of clear and convincing evidence is required ‘in part to avoid the “serious constitutional question” that would arise if a federal statute were construed to deny any judicial forum for a colorable constitutional claim.’”⁶⁸

Judicial review of federal agency rulemaking is not the only context in which the Court has recognized an elevated standard of proof as an appropriate tool for avoiding potential constitutional complications. In *Santosky v. Kramer*,⁶⁹ New York law allowed the state to terminate, over parental objection, the rights of parents to their children upon findings by a “fair preponderance of the evidence” that the children were permanently neglected.⁷⁰ Evaluating that rule, the Court held that “while private parties may be interested intensely in a civil dispute over money damages, application of a ‘fair preponderance of the evidence’ standard indicates both society’s ‘minimal concern with the outcome,’ and a conclusion that the litigants should ‘share the risk of error in roughly equal fashion.’”⁷¹ The interest at stake in that case, however, was something else altogether because “[i]n parental rights termination proceedings, the private interest affected is commanding; the risk of error from using a preponderance standard is substantial; and the countervailing governmental interest favoring that standard is comparatively slight.”⁷² The clear-and-convincing-evidence standard of proof therefore was appropriate.⁷³

These decisions and others like them turn on the constitutional requirement of due process,⁷⁴ but, of greater significance to *Rogers*

⁶⁷ *Bowen*, 476 U.S. at 671 (quoting H.R. Rep. No. 79-1980, at 4 (1946)).

⁶⁸ *Brigade Leveraged Cap. Structures Fund Ltd. v. Garcia-Padilla*, 201 F. Supp. 3d 223, 229 (D.P.R. 2016) (quoting *Webster v. Doe*, 486 U.S. 592, 603 (1988)).

⁶⁹ 455 U.S. 745 (1982).

⁷⁰ *Id.* at 747.

⁷¹ *Id.* at 755 (quoting *Addington v. Texas*, 441 U.S. 418, 423 (1979)).

⁷² *Id.* at 758.

⁷³ *Id.* at 769–70.

⁷⁴ See also *In re Winship*, 397 U.S. 358, 364 (1970) (holding, in the context of juveniles charged with violations of criminal law, that “[l]est there remain any doubt about the constitutional stature of the reasonable-doubt standard, we explicitly hold that the Due Process Clause protects the accused against conviction except upon proof beyond a reasonable doubt of every fact necessary to constitute the crime with which he is charged”); *Woodby v. Immigr. & Naturalization Serv.*, 385 U.S. 276, 277 (1966) (applying due process analysis to hold that “it is incumbent upon the Government in such

scenarios, the Court also has adopted an elevated standard of proof in the context of the First Amendment's right to free speech. It did so in *Gertz v. Robert Welch, Inc.*,⁷⁵ in which the Court clarified the test for libel it had set out ten years earlier in *New York Times Co. v. Sullivan*.⁷⁶ Although *New York Times* itself required public-figure plaintiffs to prove liability through proof of "convincing clarity,"⁷⁷ *Gertz* held that:

Those who, by reason of the notoriety of their achievements or the vigor and success with which they seek the public's attention, are properly classed as public figures and those who hold governmental office may recover for injury to reputation only on clear and convincing proof that the defamatory falsehood was made with knowledge of its falsity or with reckless disregard for the truth.⁷⁸

In requiring a "particularly compelling" showing of likely confusion if a defendant's use occurs in the content or title of an artistic or expressive work, the Second Circuit's conception of explicitly misleading conduct under *Rogers*'s second prong as a mechanism for avoiding a conflict between trademark rights and the First Amendment is consistent with *Gertz* and with opinions invoking constitutional avoidance in the due process context. But what of the Ninth Circuit's practice of treating the inquiry into the possible explicitly misleading nature of a defendant's conduct as one separate from the likelihood of confusion between the parties' respective uses? Can it not be an equally acceptable application of the constitutional avoidance doctrine?

The answer lies in the following holding from the Supreme Court:

Under the constitutional-avoidance canon, when statutory language is susceptible of multiple interpretations, a court may shun an interpretation that raises serious constitutional doubts and instead may adopt an alternative that avoids those problems. But a court relying on that canon still must *interpret* the statute, not rewrite it.⁷⁹

proceedings to establish the facts supporting deportability by clear, unequivocal, and convincing evidence").

⁷⁵ 418 U.S. 323 (1974).

⁷⁶ 376 U.S. 254 (1964).

⁷⁷ *Id.* at 285–86.

⁷⁸ *Gertz*, 418 U.S. at 342.

⁷⁹ *Jennings v. Rodriguez*, 583 U.S. 281, 286 (2018); *see also id.* at 298 ("Spotting a constitutional issue does not give a court the authority to rewrite a statute as it pleases."); *Harris v. Garner*, 216 F.3d 970, 985 (11th Cir. 2000) ("Courts should not employ the canon of construction that ambiguous statutory language is to be construed to avoid constitutional questions as a pretext for rewriting clear statutory language.").

Simply put, when addressing an unambiguous statute, courts “cannot ignore [its] text and purpose . . . in order to save it,”⁸⁰ even when the statute at issue is the Lanham Act.⁸¹ On the contrary, as one commentator has observed in the closely related context of severability, “[w]hen courts substantially rewrite statutes to save them, the resulting work is as much that of the judiciary as of the legislature. That makes it hard to hold the legislature accountable for the statute that the judiciary puts in place.”⁸²

The Supreme Court has never defined the level of ambiguity in a statute’s text necessary to render constitutional avoidance appropriate.⁸³ Nevertheless, and although the line between ambiguity and unambiguity might be a fine one in other contexts,⁸⁴ both the text and purpose of the statutory causes of action found in Section 32(1) and Section 43(a) of the Lanham Act are wholly unambiguous: They target likely confusion and nothing more.⁸⁵ Thus, even if courts have adopted varying tests for that circumstance,⁸⁶ the ultimate inquiry under each remains the one

⁸⁰ *Boumediene v. Bush*, 553 U.S. 723, 787 (2008); *see also* *Rubin v. United States*, 449 U.S. 424, 430 (1981) (“When we find the terms of a statute unambiguous, judicial inquiry is complete.”).

⁸¹ *See* *Iancu v. Brunetti*, 588 U.S. 388, 397 (2019) (“This Court, of course, may interpret ‘ambiguous statutory language’ to ‘avoid serious constitutional doubts.’ But that canon of construction applies only when ambiguity exists.” (quoting *FCC v. Fox Television Stations, Inc.*, 556 U.S. 502, 516 (2009))).

⁸² David H. Gans, *Severability as Judicial Lawmaking*, 76 *Geo. Wash. L. Rev.* 639, 644 (2008); *see also* Richard M. Re, *Narrowing Precedent in the Supreme Court*, 114 *Colum. L. Rev.* 1861, 1886–87 (2014) (“Nobody believes that courts have authority to rewrite crystal-clear legislative commands in order to salvage legislative policy from unconstitutionality.”); Eric Fish, *Judicial Amendment of Statutes*, 84 *Geo. Wash. L. Rev.* 563, 575 (2016) (“[A]s a constitutional remedy, avoidance can be used to actually change a statute’s meaning after a court has found it unconstitutional. This is no longer ‘avoidance’ in the conventional sense, as the court is in fact making a constitutional holding rather than ‘avoiding’ one. Rather, this is a mechanism for changing a statute’s meaning in order to render it constitutionally valid.”).

⁸³ *See* Brett M. Kavanaugh, *Fixing Statutory Interpretation Judging Statutes*, 129 *Harv. L. Rev.* 2118, 2147 (2016) (book review) (“A case of extraordinary magnitude [can] boil[] down to whether a key provision is clear or ambiguous, even though we have no idea how much ambiguity is enough to begin with, nor how to ascertain what level of ambiguity exists in a particular statute.”); Lisa A. Kloppenberg, *Avoiding Serious Constitutional Doubts: The Supreme Court’s Construction of Statutes Raising Free Speech Concerns*, 30 *U.C. Davis L. Rev.* 1, 12 (1996) (noting that Court “has neither determined how much ambiguity is required to apply the canon, nor has it suggested guidelines, factors or circumstances to include in an ambiguity analysis”).

⁸⁴ *See generally* Marco Bastile, *Ordinary Meaning and Plain Meaning*, 110 *Va. L. Rev.* 135 (2024); Jonathan H. Choi, *Measuring Clarity in Legal Text*, 91 *U. Chi. L. Rev.* 1 (2024); Doerfler, *supra* note 58; Lawrence M. Solan, *Pernicious Ambiguity in Contracts and Statutes*, 79 *Chi.-Kent L. Rev.* 859 (2004).

⁸⁵ 15 U.S.C. §§ 1114(1), 1125(a) (2024).

⁸⁶ In addition to the *Rogers* test, those include the standard multifactor test in conventional cases, e.g., *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), the inquiry into whether there are material differences between diverted or altered goods resold by defendants and their authorized counterparts that have not been

expressly codified by those statutes.⁸⁷ In contrast, neither statute requires (or even implicitly contemplates) explicitly misleading conduct by a defendant as a stand-alone extrastatutory prerequisite for a finding of liability. The Ninth Circuit's adoption of just such a prerequisite therefore is in a wholly different category than the time-honored practice of requiring an elevated standard of proof if doing so will avoid a conflict between the cause of action at issue and the Constitution. Specifically, the employment of a particular standard of proof when interpreting statutes that are silent on the issue is one thing; the adoption of an additional test (or requirement) for liability under an unambiguous statute is another thing altogether.⁸⁸ As between the Second Circuit's conception of the test for explicitly misleading conduct by a defendant and that of the Ninth Circuit, the former therefore rests on sounder statutory and doctrinal moorings.⁸⁹

adequately disclosed, e.g., *Societe des Produits Nestle, S.A. v. Casa Helvetia, Inc.*, 982 F.2d 633, 638 (1st Cir. 1992), whether once-genuine goods have been so materially altered that no disclosure can cure the resulting likely confusion, e.g., *Cartier v. Aaron Faber, Inc.*, 396 F. Supp. 2d 356, 360 (S.D.N.Y. 2005), and the Second Circuit's and Ninth Circuit's competing tests in cases in which the nominative fair use doctrine is in play, e.g., *International Information Systems Security Certification Consortium, Inc. v. Security University, LLC*, 823 F.3d 153, 156 (2d Cir. 2016), and *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302, 307–08 (9th Cir. 1992).

⁸⁷ Cf. *B & B Hardware, Inc. v. Hargis Indus.*, 575 U.S. 138, 154–55 (2015) (holding that differing tests for likely confusion applied in infringement and registrability contexts address the same issue for issue-preclusion purposes).

⁸⁸ See *Jennings v. Rodriguez*, 583 U.S. 281, 296 (2018) (“The canon of constitutional avoidance ‘comes into play only when, after the application of ordinary textual analysis, the statute is found to be susceptible of more than one construction.’ In the absence of more than one plausible construction, the canon simply ‘has no application.’” (first quoting *Clark v. Martinez*, 543 U.S. 371, 385 (2005); and then quoting *Warger v. Shauers*, 574 U.S. 40, 50 (2014))); *Ileto v. Glock, Inc.*, 565 F.3d 1126, 1143 (9th Cir. 2009) (“[Constitutional avoidance] does not apply where, as here, congressional intent is clear from the text and purpose of the statute.”); *State v. Holle*, 379 P.3d 197, 207 (Ariz. 2016) (“It is one thing to interpret an ambiguous statute in a way that avoids a potential constitutional issue, but it is quite another to rewrite an unambiguous statute to avoid an alleged constitutional issue.”).

⁸⁹ It is no answer that the Court in *New York Times* invoked the First Amendment when requiring public figures to demonstrate actual malice as a condition for the recovery of actual damages in defamation actions. 376 U.S. at 279–80. To begin with, the Court noted in that case that the plaintiffs’ cause of action was grounded in “[the] common law only, though supplemented by statute.” *Id.* at 265. Likewise, in *Gertz*, the Court understood its earlier holding as establishing “a constitutional privilege intended to free criticism of public officials from the restraints imposed by the common law of defamation.” 418 U.S. at 334; see also *id.* at 342 (characterizing *New York Times* as “administer[ing] an extremely powerful antidote to the inducement to media self-censorship of the common-law rule of strict liability for libel and slander”). Finally, the Court did not identify any Alabama statutes providing for a presumption of malice upon a finding of falsity, and, indeed, then-extant Alabama common law provided that:

Where words are libelous per se . . . , the right to damages results as a consequence, because there is a tendency of such libel to injure the person libeled in his reputation, profession, trade or business, and proof of such pecuniary injury is not required, such injury being implied.

Of course, applications of the Second Circuit's approach to *Rogers*'s second prong are made no easier by that court's distinctly unhelpful failure to explain the precise nature of its elevated "particularly compelling" standard of proof.⁹⁰ Specifically, it has never defined the relationship of that standard to the preponderance-of-the-evidence, clear-and-convincing evidence, and beyond-a-reasonable-doubt triumvirate of alternatives.⁹¹ Moreover, although the Supreme Court has articulated a three-factor test for evaluating whether particular standards of proof comply with due process,⁹² it has not offered similar guidance for weighing those standards' compliance with the First Amendment in either *Gertz* or that decision's progeny.⁹³

Nevertheless, particularly compelling evidence obviously is distinguishable from a preponderance of the evidence; otherwise, there would be little point to the *Rogers* exercise.⁹⁴ Likewise, unless

Johnson Publ'g Co. v. Davis, 124 So. 2d 441, 450 (Ala. 1960). There thus is no apparent basis for the theory that the Court rewrote a statute (as opposed to adding a constitutional gloss to a common-law cause of action) to incorporate an extrastatutory prerequisite for monetary relief in pursuit of constitutional avoidance.

⁹⁰ To the extent courts applying that standard have sought to explain it, they have held that "the most important difference between the *Rogers* consumer confusion inquiry and the classic consumer confusion test is that consumer confusion under *Rogers* must be clear and unambiguous to override the weighty First Amendment interests at stake." *Hermès Int'l v. Rothschild*, 654 F. Supp. 3d 268, 281 (S.D.N.Y. 2023); *accord JTH Tax LLC v. AMC Networks Inc.*, No. 22 CIV. 6526 (PGG), 2023 WL 6215299, at *5 (S.D.N.Y. Sept. 25, 2023).

⁹¹ For a discussion of three additional standards of proof—substantial, credible evidence, strong basis in evidence, and clear, unequivocal, and convincing evidence—see Hillary Gaston Walsh, *Unequivocally Different: The Third Civil Standard of Proof*, 66 U. Kan. L. Rev. 565, 572–73 (2018). Although arguing for their broader application, however, that discussion characterizes those standards as "outliers." *Id.* at 572; *see also* Clermont, *supra* note 51, at 1120 ("[T]oday there seem to be only three feasible choices in the range stretching from preponderance of the evidence through proof beyond a reasonable doubt. The law did not always recognize this, but with time the law acknowledged that the conceivable spectrum of standards had coalesced irresistibly into three." (footnote omitted)).

⁹² Those factors are the private interests affected by the proceeding, the risk of error created by government action at issue, and the countervailing governmental interest supporting use of the challenged procedure. *Mathews v. Eldridge*, 424 U.S. 319, 335 (1976).

⁹³ To the extent the Court in *Gertz* articulated a rationale for requiring clear and convincing evidence in cases arising from the alleged libel of public figures, it held only that its new gloss on the *New York Times* standard was not "justified solely by reference to the interest of the press and broadcast media in immunity from liability. Rather, we believe that the *New York Times* rule states an accommodation between this concern and the limited state interest present in the context of libel actions brought by public persons." 418 U.S. at 343.

⁹⁴ In a non-*Rogers* trademark case, the Second Circuit itself has distinguished between mere compelling evidence (but not *particularly* compelling evidence), on the one hand, and a preponderance of the evidence, on the other. *See Fed. Exp. Corp. v. Fed. Espresso, Inc.*, 201 F.3d 168, 177 (2d Cir. 2000) ("While the [district] court itself was unpersuaded that the marks were similar or that there was bad faith or predatory or freeloading intent—as was the court's prerogative as the preliminary factfinder in connection with

the rule is mandated by statute,⁹⁵ courts generally have not required proof beyond a reasonable doubt in civil litigation; instead, “[that] unique standard of proof, not prescribed or defined in the Constitution, is regarded as a critical part of the ‘moral force of the criminal law,’ and [courts] should hesitate to apply it too broadly or casually in noncriminal cases.”⁹⁶ That leaves clear and convincing evidence as the most appropriate point of comparison among the traditional three ones, and, indeed, interpretations of that standard are so divergent that they can easily encompass the one applied by the Second Circuit.⁹⁷

the preliminary injunction motion—these facts need be proven only by a preponderance of the evidence, not by compelling evidence . . .”).

⁹⁵ See, e.g., Cal. Welf. & Inst. Code § 6604 (West) (providing that, in civil commitment proceedings, “[t]he court or jury shall determine whether, beyond a reasonable doubt, the person is a sexually violent predator”).

⁹⁶ *Addington v. Texas*, 441 U.S. 418, 428 (1979) (quoting *In re Winship*, 397 U.S. 358, 364 (1970)); accord *California ex rel. Cooper v. Mitchell Bros.’ Santa Ana Theater*, 454 U.S. 90, 93 (1981); see also Stephen J. Moss, *Clear and Convincing Civility: Applying the Civil Commitment Standard of Proof to Civil Asset Forfeiture*, 68 Am. U. L. Rev. 2257, 2280 (2019) (“The reasonable doubt standard exists only in criminal cases because the specter of a conviction places immense risk on the defendant.”).

⁹⁷ “Although the clear and convincing evidence standard has never been a model of clarity, it is nonetheless reasonably familiar to courts by virtue of its long use in defamation cases applying the actual malice standard.” Arlen W. Langvardt, *Section 43(a), Commercial Falsehood, and the First Amendment: A Proposed Framework*, 78 Minn. L. Rev. 309, 394 (1993). One court has observed that “[q]uantified, the probabilities might be in the order of above 70% [u]nder a clear and convincing evidence burden.” *United States v. Fatico*, 458 F. Supp. 388, 405 (E.D.N.Y. 1978), *aff’d*, 603 F.2d 1053 (2d Cir. 1979). In less empirical fashion, the Supreme Court suggested in 1984 that clear and convincing evidence should “place in the ultimate factfinder an abiding conviction that the truth of [the proffering party’s] factual contentions are ‘highly probable.’” *Colorado v. New Mexico*, 467 U.S. 310, 316 (1984) (quoting Charles T. McCormick, *Law of Evidence* § 320, at 679 (1954)). Six years later, it held that clear and convincing evidence is proof that “produces in the mind of the trier of fact a firm belief or conviction as to the truth of the allegations sought to be established, evidence so clear, direct and weighty and convincing as to enable [the factfinder] to come to a clear conviction, without hesitancy, of the truth of the precise facts at issue.” *Cruzan v. Dir., Missouri Dep’t of Health*, 497 U.S. 261, 285 n.11 (1990) (alteration in original) (quoting *In re Jobes*, 529 A.2d 434, 441 (N.J. 1987)). The flexibility of the standard is likewise reflected in the competing (but not necessarily inconsistent) definitions found in Fifth Circuit case law. *Compare* *Am. Cyanamid Co. v. Elec. Indus.*, 630 F.2d 1123, 1127 (5th Cir. 1980) (holding that clear and convincing evidence “requires that the existence of disputed facts be highly probable”) with *Shafer v. Army & Air Force Exch. Serv.*, 376 F.3d 386, 396 (5th Cir. 2004) (“Clear and convincing evidence is ‘that weight of proof which “produces in the mind of the trier of fact a firm belief or conviction as to the truth of the allegations sought to be established, evidence so clear, direct and weighty and convincing as to enable the fact finder to come to a clear conviction, without hesitancy, of the truth of the precise facts” of the case.” (quoting *In re Medrano*, 956 F.2d 101, 102 (5th Cir. 1992))), *opinion clarified*, No. 03-10074, 2004 WL 2107672 (5th Cir. Sept. 17, 2004).

IV. CONCLUSION

The issue of whether the *Rogers* test remains viable in contexts other than that presented in *Jack Daniel's* is beyond the scope of this article, and the article therefore does not dispute that the First Amendment may well protect the incorporation of some nontrademark imitations of plaintiffs' marks into artistic or expressive works. Likewise, this article does not take a position on three related issues, namely, whether such an incorporation constitutes an actionable use in commerce for purposes of the Lanham Act's statutory causes of action,⁹⁸ whether the expressive nature of a good or service provided under a challenged mark is in and of itself a consideration weighing against a finding of liability,⁹⁹ and whether the Second Circuit's or the Ninth Circuit's approach to the second prong of *Rogers* is more difficult to satisfy.¹⁰⁰

Nevertheless, if *Rogers*'s continued viability rests on the doctrine of constitutional avoidance, the Ninth Circuit's treatment of *Rogers*'s second prong as a stand-alone requirement independent of the likelihood-of-confusion analysis is fundamentally inconsistent with the unambiguous texts of the statutory causes of action it purports to apply. In contrast, the Second Circuit's adoption of a higher standard of proof for likely confusion in *Rogers* scenarios is compatible with the silence of the Lanham Act's causes of action on that issue, as well as the long-standing practice of the Supreme Court and other tribunals in analogous circumstances. It therefore is the better option.

⁹⁸ 15 U.S.C. §§ 1114(1), 1125(a), 1125(c) (2024).

For an example of an opinion questioning whether the seven-second appearance of a cartoon character in a motion picture constituted an actionable use in commerce, see *Felix the Cat Productions Inc. v. New Line Cinema Corp.*, 54 U.S.P.Q.2d 1856, 1857–58 (C.D. Cal. 2000) (granting motion to dismiss).

⁹⁹ The Ninth Circuit has so suggested in a post-*Jack Daniel's* opinion. See *Punchbowl, Inc. v. AJ Press, LLC*, 90 F.4th 1022, 1032 (9th Cir. 2024) (“[T]he expressive nature of [the defendant’s] use of [its mark] . . . will certainly be relevant in the likelihood-of-confusion analysis.”).

¹⁰⁰ Plaintiffs clearly face challenges under both approaches even after *Jack Daniel's*. Compare *Hara v. Netflix, Inc.*, No. 2:23-CV-03456-RGK-AS, 2023 WL 6812769, at *4 (C.D. Cal. Aug. 23, 2023) (granting post-*Jack Daniel's* *Rogers*-based motion to dismiss challenge to appearance of alleged imitation of plaintiffs’ image in teaser for animated series on ground that “allegations regarding ‘the impact of the use’ are insufficient to show that a content creator explicitly misled consumers”) with *Down To Earth Organics, LLC v. Efron*, No. 22-CV-06218 (NSR), 2024 WL 1376532, at *9 (S.D.N.Y. Mar. 31, 2024) (granting post-*Jack Daniel's* *Rogers*-based motion to dismiss challenge to television series title with explanation that “Plaintiff’s conclusory allegations are insufficient to state a plausible claim of likelihood of confusion, much less a ‘particularly compelling one’”).