No. 22-148

IN THE

Supreme Court of the United States

JACK DANIEL'S PROPERTIES, INC.,

Petitioner,

v.

VIP PRODUCTS LLC,

Respondent.

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

BRIEF OF INTELLECTUAL PROPERTY OWNERS ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER

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INTEREST OF THE *AMICUS CURIAE*

Amicus curiae Intellectual Property Owners Association (IPO) is an international trade association representing companies and individuals in all industries and fields of technology that own or are interested in intellectual property rights.[1] IPO's membership includes more than 200 companies and more than 12,000 individuals who are involved in the IPO either through their companies or as inventors, authors, executives, law firms, or attorney members. The corporate members of IPO own tens of thousands of trademarks and rely on the federal trademark system to protect these valuable assets. Founded in 1972, IPO represents the interests of all owners of intellectual property. IPO regularly represents the interests of its members before government entities and has filed *amicus curiae* briefs in this Court and other courts on significant issues of intellectual property law.

Uniquely, IPO represents the interests of all owners of intellectual property, and its mission is to promote high quality and enforceable intellectual property rights and predictable legal systems for all industries and technologies. IPO offers a wide array of services, including supporting member interests relating to legislative and international issues, analyzing current intellectual property issues, providing information and educational services, and disseminating information to the public on the importance of intellectual property. IPO advocates for

1. No counsel of record for any party authored this brief in whole or in part, and no person or entity other than amicus curiae made a monetary contribution to the preparation or submission of this brief.

effective, affordable, and balanced intellectual property rights before both Congress and the United States Patent and Trademark Office. The members of IPO's Board of Directors, which approved the filing of this brief, are listed in the attached Appendix.[2]

INTRODUCTION AND SUMMARY OF THE ARGUMENT

This case presents two questions of substantial practical importance to IPO's members: namely, whether humorous use of another's trademark as one's own on a commercial product is subject to the Lanham Act's traditional likelihood-of-confusion analysis, or instead receives heightened First Amendment protection from claims of trademark infringement, and whether humorous use of another's mark as one's own on a commercial product is "noncommercial" under 15 U.S.C. § 1125(c)(3)(C), thus barring as a matter of law a claim of dilution by tarnishment under the Trademark Dilution Revision Act.

IPO recognizes and affirms the importance of First Amendment considerations in connection with claims of trademark violations in certain circumstances. However, IPO also believes that protecting consumers from being misled as to the source of products and services as well as the legitimate interests of trademark owners in their registered marks and goodwill must be given due consideration. The issues presented here are of enormous concern to millions of consumers who depend on the trademark statutes to protect them from misleading

2. IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting.

designations of source under a guise of superficial claims to free speech.

The facts in this case illustrate the dangers of allowing arguments concerning the First Amendment to overshadow clear infringement of legitimate trademarks and trade dress in the case of purely commercial, nonexpressive works. The defendant here created a dog toy that is strikingly similar in appearance to the well-known Jack Daniel's bottle. The purpose of this similarity of appearance is entirely commercial and unmistakable – the defendant wants to maximize the sale of its dog toys. By appropriating the Jack Daniel's trademark and trade dress, the defendant hopes to draw attention to its product. This misappropriation will have at least two harmful results. First, some consumers will inevitably be misled that the legitimate owner of the Jack Daniel's brand has branched out into dog toys. Second, the hard-earned reputation of Jack Daniel's will be held hostage by and potentially harmed by the quality, or lack thereof, of these rip-off toys. Merely adding a humorous twist to a commercial, nonexpressive product should not shield the copier from liability for otherwise blatant trademark infringement.

Based on a balance that protects consumers from being misled and that also protects the legitimate brand rights of trademark owners, IPO believes the Ninth Circuit's application of *Rogers v. Grimaldi* in this case was incorrect. Instead, the traditional Lanham Act likelihood-of-confusion analysis is sufficiently flexible to consider the allegedly parodic or humorous nature of any subject use in a commercial context. IPO further believes that the use of another's mark as one's own source-identifying

mark in connection with a commercial product should not be considered "noncommercial" pursuant to 15 U.S.C. § 1125(c)(3)(C)).[3] IPO believes the Ninth Circuit's decision should be reversed on both questions. IPO does not, however, take a position on the ultimate outcome of this particular dispute between the parties.

ARGUMENT

I. THE TRADITIONAL LANHAM ACT LIKELIHOOD-OF-CONFUSION ANALYSIS IS APPLICABLE TO A HUMOROUS USE OF ANOTHER'S MARK IN A COMMERCIAL CONTEXT

The Lanham Act (Pub. L. No. 79-489, 60 Stat. 427 (1946)) regulates the use of trademarks in commercial activity, provides trademark users exclusive rights to their marks, and protects consumers from a likelihood of confusion between different products. There is also a public interest in protecting freedom of speech under the First Amendment of the U.S. Constitution.

In an attempt to balance these sometimes competing interests, the Second Circuit espoused a two-part test in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Under the *Rogers* test, the title of an artistic work is protected under the First Amendment (and does not violate the Lanham Act) "[(i)] unless the artistic work has no artistic relevance to the underlying work whatsoever, or, [(ii)] if it has some

3. If the Lanham Act issue is resolved as urged here, IPO believes that the comparable issue under the Trademark Dilution Revision Act would likely be resolved in a consistent manner.

artistic relevance, unless the title explicitly misleads as to the source or the content of the work. *Id.* at 999.

In *Rogers v Grimaldi*, the iconic American actress Ginger Rogers brought an action under the Lanham Act against the producers and distributors of a film titled "Ginger and Fred," alleging that the title created a false impression that she was associated with the film. In the film, directed by Federico Fellini, two Italian actors impersonated the famous acting duo of Ginger Rogers and Fred Astaire. The Second Circuit applied the *Rogers* test to affirm the District Court's decision to grant summary judgment in favor of the producers of the film. *Id.* at 1001. As to the first prong of the test, the Court determined that the film "surpasses the minimum threshold of artistic relevance to the film's content," as the central characters nicknamed "Ginger" and "Fred" have genuine relevance to the film's story. *Id.* at 1001. As to the second prong, the Court concluded that "the title is not misleading; on the contrary, it is an integral element of the film and the filmmaker's artistic expressions." *Id.*

The Second Circuit however cautioned that "in general the [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression." *Id.* at 999. The Second Circuit also made a clear distinction between "titles with a celebrity's name [that] make no explicit statement that the work is about that person in any direct sense" and "ordinary commercial products" stating that "[t]hough consumers frequently look to the title of a work to determine what it is about, they do not regard titles of artistic works in the same way as the names of ordinary commercial products." *Id.* at 1000.

A. The Ninth Circuit's use of *Rogers* as a threshold test places an improper heightened burden on the trademark owner.

The Ninth Circuit, in *VIP Products LLC v. Jack Daniel's Properties, Inc.*, 953 F.3d 1170 (9th Cir. 2020), held that the *Rogers* test, applicable to expressive works, applied to VIP Products' BAD SPANIELS dog toys. The Ninth Circuit reasoned that the dog toys were automatically entitled to heightened First Amendment protection because they conveyed a "humorous message" that commented on Jack Daniel's asserted marks. *VIP Products*, 953 F.3d at 1175. The Ninth Circuit went on to apply the *Rogers* test, thereby circumventing any likelihood-of-confusion analysis.

Such an application of the *Rogers* test places an initial heightened burden on the trademark owner and constitutes a too stringent threshold test before any consideration of the likelihood-of-confusion factors may occur. Regarding the first prong of the *Rogers* test, the district court in *VIP Products* observed, after it was reversed by the Ninth Circuit, "it appears nearly impossible for any trademark holder to prevail under the *Rogers* test. Where relevance need be merely 'above zero' – which is to say, relevance can be scant or *de minimis* – it is difficult to imagine what creative junior use would not pass the *Rogers* test." *VIP Prod. LLC v. Jack Daniel's Properties Inc.*, No. CV-14-02057-PHX-SMM, 2021 WL 5710730, at 6 (D. Ariz. Oct. 8, 2021), *aff'd,* No. 21-16969, 2022 WL 1654040 (9th Cir. Mar. 18, 2022), *cert. granted,* No. 22-148, 2022 WL 17087471 (U.S. Nov. 21, 2022). Regarding the second prong, the District Court stated that "the 'explicitly misleading' standard essentially displaces the likelihood-of-confusion

test with a standard that excuses nearly any use less than slapping another's trademark on your own work and calling it your own." *Id.* at 6.

Thus, even if there is pervasive actual misleading and confusion of consumers in a commercial context, if the Ninth Circuit's *Jack Daniel's* decision were permitted to stand, such considerations would be secondary to a defendant's alleged First Amendment rights. While such a heightened standard may be appropriate in the context of traditionally protected expressive works such as literary titles, songs, photographs, greeting cards, etc., *see, e.g., Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 261 (9th Cir. 2018), IPO believes the *Rogers* test is inappropriate in this entirely commercial context and should not be adopted for commercial, nonexpressive products such as dog toys.

B. This Court should reject *Rogers* as a threshold test and instead adopt the Second, Seventh, and Eighth Circuits' adherence to the plain language of the Lanham Act.

IPO believes that the likelihood-of-confusion test strikes the appropriate balance between the competing interests of the infringer, the trademark holder, and the public. That test is sufficiently flexible to allow factfinders to determine when an infringer's humorous use of another's trademark will or will not confuse consumers.

For these reasons, IPO favors an approach consistent with the Second, Seventh, and Eighth Circuits when the use at issue does not involve a traditionally protected expressive work. Specifically, IPO favors an approach wherein a defendant's arguments relating to the parodic and humorous nature of their use are weighed in

connection with the other likelihood-of-confusion factors, and the *Rogers* test is not invoked.

Accordingly, IPO respectfully urges the Court to clarify that humorous use of another's trademark as one's own on a commercial product is well within the Lanham Act's traditional likelihood-of-confusion analysis and should not be entitled to heightened First Amendment protection from trademark infringement claims.

II. UPHOLDING THE NINTH CIRCUIT'S DECISION WILL ACCENTUATE A THREAT OF INJURY TO THE PUBLIC AND NEGATIVELY IMPACT THE CONSUMER PROTECTION GOALS OF THE LANHAM ACT

The record makes it evident that the intent of the accused infringer, VIP Products, is to sell a commercial product, dog toys. The dog toys do not express a social or political message. To the contrary, in an effort to maximize its chances of selling its commercial product, VIP Products copied Jack Daniel's trademark and trade dress as closely as possible with only a slight humorous twist.



FIG. 1

As illustrated in FIG. 1, the image on the left is that of a dog toy produced and marketed by VIP Products under the label "Bad Spaniels Silly Squeaker," whereas the image on the right is that of a whiskey bottle produced and marketed by Jack Daniel's under the label "Jack Daniel's." *VIP Products LLC v. Jack Daniel's Properties, Inc.*, 953 F.3d at 1172. As the District Court found:

> VIP's intent behind designing the Bad Spaniels Toy was to match the bottle design for Jack Daniel's Tennessee Sour Mash Whiskey ("Old No. 7 Brand"). (Doc. 157.) These design elements include the size and shape of the product, the use of white lettering over a black background, and font styles. Mr. Sacra originally coined the name "Bad Spaniels," and then requested Designer Elle Phillips to work on a proposed design. (Doc. 236 at 55-56.) Ms. Phillips understood that "Bad Spaniels" was a reference to "Jack Daniel's." (Doc. 233-1 at 47, 49-50.) Ms. Phillips was familiar with that brand and had consumed Jack Daniel's Tennessee Whiskey in bars and in her home. (Id. at 52-53.) She referenced the Jack Daniel's bottle "every now and then throughout the [design] process." (Id. at 66-67.) Ms. Phillips wanted her sketch to be close to the same as the Jack Daniel's bottle. (Id. at 67.). When finished, the "Bad Spaniels" product featured all the elements of the Jack Daniel's trade dress, including the bottle shape, color scheme, and trademark stylization, as well as the word "Tennessee," and the font and other graphic elements. (Doc. 158.).

VIP Prod. LLC v. Jack Daniel's Properties Inc., No. CV-14-02057-PHX-SMM, 2021 WL 5710730, at 1. The Ninth Circuit agreed with the District Court that "Jack Daniel's trade dress and bottle design are distinctive and aesthetically nonfunctional." *VIP Products LLC v. Jack Daniel's Properties, Inc.*, 953 F.3d at 1176.

Like many copycats, VIP Products commissioned this close mimicking of Jack Daniel's trademark and trade dress in an effort to sell its dog toys by siphoning off the brand recognition and goodwill that Jack Daniel's enjoys among American consumers. Jack Daniel's developed this brand recognition and goodwill after extensive use of its trademarks and an investment of hundreds of millions of dollars spent promoting Jack Daniel's Tennessee Whiskey. The accused infringer's sole business strategy was to ride the coattails of Jack Daniel's costly effort to promote the Jack Daniel's brand, all for its own commercial benefit.

This type of coattail riding creates an unfair benefit to the accused infringer and an unfair detriment to the trademark owner. If the mimicking product has quality issues, these quality issues will have the potential to cast the trademark owner's brand recognition in a bad light, all of which is unfairly beyond the control of the trademark owner. And the consumer presented with the mimicking product in a store or online will not necessarily know that there is no connection between the rip-off and the real product. This is the definition of consumer confusion and should not be protected under the guise of the First Amendment. It is a commercial rip-off, not an expressive work. Regardless of the "humorous message" that may or may not be conveyed, intentional use of a famous mark by a junior user for commercial gain is unconscionable and

can have dangerous repercussions. For these reasons, such activities are prohibited by the Lanham Act.

In the present situation, VIP's dog toys may appeal to children, and therefore bear a risk of exposing children to adult brands associated with alcohol. This is a negative connection that works against the legitimate brand recognition the owners of Jack Daniel's have worked so hard to achieve. As the Ninth Circuit stated, "the name 'Jack Daniel's' is replaced with 'Bad Spaniels,' 'Old No. 7' with 'Old No. 2,' and alcohol content descriptions with '43% POO BY VOL.' and '100% SMELLY.'" *VIP Products LLC v. Jack Daniel's Properties, Inc.*, 953 F.3d at 1172. VIP sells a dog toy and the Jack Daniel's brand unfairly suffers.

The issues presented here are not just hypothetical, or merely of legal or academic interest. They have a real impact on lives and livelihoods. For example, the *Washington Post* reported that children in different states were hospitalized after consuming what looked like commercial gummy candies. Laura Reiley, *Major Food Brands Seek Crackdown on Marijuana-Infused Copycats*, Wash. Post (Apr. 29, 2022, 9:36 A.M. E.D.T.), https://www.washingtonpost.com/business/2022/04/29/thc-infused-copycat-foods/. In one instance, the packaging for the copycat product resembled that of a well-known candy manufacturer, but contained 400 milligrams of THC, a crystalline compound that is the main active ingredient of cannabis.

In another case, Ferrara Candy Company filed a claim against a company selling marijuana-infused candy products that mimic well-known Nerds candies. Compl., *Ferrera Candy Co. v. Akimov, LLC*, No. 22-cv-80768 (S.D.

Fla. May 23, 2022). Under the Ninth Circuit's decision, such copycat owners can add humorous messaging to the copycat product, thereby evading action under the Lanham Act, while having a devastating impact on innocent consumers. This would severely subvert Lanham Act's consumer protection and brand protection goals.

As noted in *Nike v. "Just Did It" Enterprises*, "[f]ederal law prohibits copies or imitations that confuse consumers. 15 U.S.C. § 1114(1)(a), 1125(a). This protects trademarks as a form of intellectual property, *L.L. Bean*, 811 F.2d at 29, and guards against confusion, deception, or mistake by the consuming public. *See James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 274 (7th Cir. 1976) ("people do not confuse trademarks — trademarks confuse people" (citations omitted))." *Nike v. "Just Did It" Enterprises*, 6 F.3d at 1227. Accordingly, IPO respectfully urges the Court to reverse the Ninth Circuit's ruling and affirm the consumer protection goals of the Lanham Act.

CONCLUSION

For the reasons stated above, IPO respectfully requests that the Supreme Court resolve the conflict among federal courts of appeals and adopt an approach consistent with the Second, Seventh, and Eighth Circuits when the use at issue is not in connection with a traditionally protected expressive work.

Respectfully submitted,

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APPENDIX

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