

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 *AMICUS CURIAE* ELECTRONIC
FRONTIER FOUNDATION IN SUPPORT
OF RESPONDENT**

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**STATEMENT OF IDENTITY AND INTEREST OF
*AMICUS CURIAE*¹**

Amicus curiae Electronic Frontier Foundation (“EFF”) is a nonprofit civil liberties organization that has worked for more than 30 years to protect free expression, innovation, and civil liberties in the digital world. As part of its mission, EFF regularly represents activists and cultural critics who use trademarks for parody and satire and, as a result, find themselves the target of legal threats.² EFF, its clients, and its more than 35,000 active donors have a strong interest in ensuring that trademark law adequately protects these types of uses and avoids chilling future speech by individuals and groups with limited resources to defend themselves in court.

1. No counsel for a party authored this brief in whole or in part, and no such counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amicus curiae*, or its counsel, made a monetary contribution intended to fund its preparation or submission.

2. See, e.g., Elec. Frontier Found., *EFF to Represent Yes Men in Court Battle Over Chamber of Commerce Action* (Nov. 11, 2009), <https://www.eff.org/press/archives/2009/11/11>; Letter from Cara Gagliano, Staff Attorney, Elec. Frontier Found., to Jeffrey Moreira, Rico Management (Mar. 18, 2021), <https://www.eff.org/document/eff-letter-re-virtual-coachella-video>; Elec. Frontier Found., *Religious Group Shows Little Tolerance for Parody* (July 17, 2013), <https://www.eff.org/takedowns/religious-group-shows-little-tolerance-parody>; Corynne McSherry, *Mr. Peabody’s Coal Train Tries To Run Down Free Speech*, Elec. Frontier Found. (May 13, 2011), <https://www.eff.org/deeplinks/2011/05/mr-peabodys-coal-train-tries-run-down-free-speech>.

INTRODUCTION AND SUMMARY OF ARGUMENT

This Court has long recognized the importance of protecting facetious speech in its First Amendment jurisprudence. *See Hustler v. Falwell*, 485 U.S. 46 (1988). This speech is no less worthy of protection when it incorporates trademarks to achieve its goals; the statutory rights granted by the Lanham Act do not vitiate the First Amendment's guarantees. Recognizing this, circuit courts around the nation have reached broad consensus on a sensible approach that balances trademark rights with constitutional rights: the *Rogers* test.

Discarding the *Rogers* test would be a mistake. The speech at risk goes far beyond the novelty dog toy at issue in this case. Trademarks are ubiquitous in the modern world, and the same attributes that make them useful for identifying the source of goods or services also make them a powerful expressive tool for commenting on their owners and society. Strategies that are now staples of political activism rely on trademarks in just this way.

The *Rogers* test is a key shield against the mark owner's sword. And trademark owners do not hesitate to respond with legal threats based on those uses of their brand. Its importance lies not only in the substantive standard it sets but also in its procedural application. The complexity and fact-intensive nature of traditional infringement tests translate to prolonged, expensive, and unpredictable litigation. Rather than shoulder that burden to defend their rights, many speakers will capitulate to unreasonable demands or choose not to speak in the first place. The *Rogers* test, by contrast, offers a simple test

that is easy to apply and well suited for resolution on early dispositive motions.

Eliminating the *Rogers* test would upend decades of nationwide precedent and make it significantly easier for trademark owners to chill critical and comedic expression. *Amicus* urges the Court to reject Petitioner's call to eviscerate or narrow the *Rogers* test's application. Political expression can come in many forms, and expression in a non-traditional communicative medium deserves the same First Amendment protection as a protest sign or a song.

ARGUMENT

I. *Rogers* and Its Progeny Help Ensure Trademark Law Does Not Unduly Intrude on Protected Speech

A. The Lanham Act Is Subject to First Amendment Scrutiny

Contrary to Jack Daniels's suggestion, the Lanham Act, like every other law that regulates speech, is subject to First Amendment scrutiny. *See, e.g., Matal v. Tam*, ___ U.S. ___, 137 S. Ct. 1744, 1757 (2017) (subjecting the Lanham Act's disparagement clause to First Amendment scrutiny). Congress's own efforts to accommodate free speech concerns notwithstanding, statutory rights never trump Constitutional rights.

B. The First Amendment Protects Facetious Speech, Including Parodies

Whether frivolously funny, sharply political, or something in between, facetious speech is fully protected

by the First Amendment. Parodic, satirical, joking, and other non-serious speech is not impenetrably immune from regulation—no protected speech is. But any such regulation, whether statutory or judicial, must accommodate the First Amendment and its protections.

Such speech may be entertainment or political commentary, and often is both. The United States, in particular, has a “long and storied tradition of satiric comment” that has “enhanced political debate.” *New Times, Inc. v. Isaacks*, 146 S.W.3d 144, 151 (Tex. 2004). “Satire is particularly relevant to political debate because it tears down facades, deflates stuffed shirts, and unmasks hypocrisy. By cutting through the constraints imposed by pomp and ceremony, it is a form of irreverence as welcome as fresh air.” *Falwell v. Flynt*, 805 F.2d 484, 487 (4th Cir.1986) (Wilkinson, J., dissenting), *rev’d sub nom. Hustler Magazine v. Falwell*, 485 U.S. 46 (1988). Indeed, “[n]othing is more thoroughly democratic than to have the high-and-mighty lampooned and spoofed.” *Id.*

Accordingly, and in a wide variety of contexts, courts throughout the country have repeatedly found that various forms of facetious speech are fully protected by the First Amendment. The *New Times* case, cited above, was a defamation case. *Hustler v. Falwell* applied the same principles to intentional infliction of emotional distress. In *Matter of Callaghan*, 238 W. Va. 495, 522 (2017), the court applied the same principles in deciding whether to discipline a judge for parodic statements made in a campaign flyer.

Facetious speech need not be political to enjoy First Amendment protections. Speech intended to be “sheer

entertainment—presumably neutral as to any political or even social views” qualifies as well. *Berger v. Battaglia*, 779 F.2d 992, 998 (4th Cir. 1985). It also need not pertain to either a public figure or a matter of public concern. *Mink v. Knox*, 613 F.3d 995, 1006 (10th Cir. 2010). “The First Amendment’s shielding of figurative language reflects the reality that exaggeration and non-literal commentary have become an integral part of social discourse. . . . Hyperbole is very much the coin of the modern realm.” *Levinsky’s Inc., v. Wal-mart Stores, Inc.*, 127 F.3d 122, 126 (1st Cir. 1997).

Nor must it be inoffensive. *See Hustler*, 485 U.S. at 54. In the copyright context, the Supreme Court has made clear that whether “parody is in good taste or bad does not and should not matter to fair use.” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 582 (1994). The Ninth Circuit has similarly recognized that even “[d]estructive’ parodies play an important role in social and literary criticism.” *Fisher v. Dees*, 794 F.2d 432, 437–38 (9th Cir. 1986).

C. The First Amendment Protects Facetious Speech Involving Trademarks

Online and off, trademarks—words, symbols, images, and colors—are also essential components of everyday language, used by companies, consumers, and citizens to share information. Famous trademarks “become an important, perhaps at times indispensable, part of the public vocabulary. Rules restricting the use of well-known trademarks may therefore restrict the communication of ideas.” Robert Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 Wis. L. Rev.

158, 195–96 (1982). *See also* *W. Va. State Bd. of Educ. v. Barnette*, 319 U.S. 624, 632 (1943) (“Symbolism is a primitive but effective way of communicating ideas. The use of an emblem or flag to symbolize some system, idea, institution, or personality, is a short cut from mind to mind.”). Accordingly, First Amendment protections are no less important in the context of trademark law than they are in defamation law or any other area.

That is why in the trademark context, as in every other, courts have recognized that “because parody is a form of social and literary criticism, it has socially significant value as free speech under the First Amendment,” *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 800 (9th Cir. 2003) (internal quotation marks and citation omitted), implicating the First Amendment’s “core concerns,” *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 972 (10th Cir. 1996). *See also* *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 27, 34 (1st Cir. 1987) (First Amendment protected a pornographic magazine’s parody of the wholesome and outdoorsy L.L. Bean catalog against infringement, dilution, and unfair competition claims). “When businesses seek the national spotlight, part of the territory includes accepting a certain amount of ridicule”—including ridicule that employs their trademarks. *Nike, Inc. v. “Just Did It” Enter.*, 6 F.3d 1225, 1226 (7th Cir. 1993) (reversing summary judgment for Nike where defendant sold T-shirts with “MIKE” and Nike swoosh).

II. The *Rogers* Test Is a Vital Safeguard for Political Expression

Eliminating or narrowing the *Rogers* test risks particular harm to one form of political expression: satires that specifically incorporate trademarks as part of a critique of the mark owner.

A. Trademarks Are a Key Element in Modern Political Activism

For many decades, activists in the U.S. and around the world have used parodies of well-known trademarks to comment on or raise awareness about the mark owners' activities and positions. This practice, also known as culture jamming, is a powerful expressive tool for political activists:

Culture jamming works because humans are creatures of habit who think in images, feel our way through life, and often rely on familiarity and comfort as the final arbiters of truth Rational arguments and earnest appeals to morality may prove less effective than a carefully planned culture jam that bypasses the audience's mental filters by mimicking familiar cultural symbols, then disrupting them.³

3. *Culture Jamming*, Beautiful Trouble, <https://beautifultrouble.org/toolbox/tool/culture-jamming> (last accessed Feb. 19, 2023).

To take one recent example, in 2022, Adbusters created the following advertisement as part of a critique of Coca Cola's contribution to global pollution:



open ecocide™

In recent years, some activists have embraced a subspecies of culture jamming called “identity correction.”⁴ In their own words,

identity correctors “take on the persona of an organization/government with power, and talk like their PR department developed a conscience. It’s a way to speak truth to power—you speak as a group in power, and say a small lie that reveals a greater truth.”⁵

By necessity, these parodies use trademarks, but the purpose is purely expressive. For example:

- In 2008, a collection of anonymous satirists created a fake New York Times website, with numerous false stories and headlines (e.g., “United Nations Passes Weapons Ban”).⁶ They created physical copies as well, which were handed out in several U.S. cities. The paper included a satirical advertisement for the diamond conglomerate De Beers, which read in part: “Your purchase of a diamond will enable us to donate a prosthetic for an

4. *Identity Correction*, Beautiful Trouble, <https://beautifultrouble.org/toolbox/tool/identity-correction/> (last accessed Feb. 19, 2023).

5. *Identity Correction*, Peace Action New York State, <https://www.panys.org/student-network/organizing-toolbox/student-toolbox-identity-correction/> (last accessed Feb. 19, 2023).

6. Jaikumar Vijayaran, *De Beers Tries to Force Spoof News Web Site Offline Over Fake Ad*, Computerworld (Dec. 4, 2008), <https://www.computerworld.com/article/2529597/de-beers-tries-to-force-spoof-news-web-site-offline-over-fake-ad.html>.

African whose hand was lost in diamond conflicts.
De Beers[:] From her fingers, to his.”

DIAMONDS

Your purchase of a diamond will enable us
to donate a prosthetic for an African
whose hand was lost in diamond conflicts.

De Beers *From her fingers, to his.*

- In 2009, activists created and carried out an elaborate parody designed to poke fun at the Chamber of Commerce and spark debate over its position on climate change. The action included a press conference during which an activist, pretending to be a Chamber spokesperson, announced that the Chamber would shift its position dramatically, recognizing climate change and supporting associated legislation.⁷ The Chamber’s logo and service marks appeared on the podium at the press conference, as well as on a press release, prepared comments, and a website designed to look like the Chamber’s website. A real Chamber representative interrupted the press conference after thirteen minutes, declaring it to be a hoax. As intended, the action received substantial media coverage that highlighted the Chamber of Commerce’s policy position.
- In 2010, an activist created a spoof of the official website for the Consortium for Clean Coal Utilization (CCCU), a group formed by several coal companies and a university, ostensibly to research “clean coal” methods—much to the consternation of students and environmental activists who view “clean coal” as an oxymoron.⁸ The spoof website

7. Lisa Lerer and Michael Calderone, *CNBC, Reuters Fall for Climate Hoax*, Politico (Oct. 19, 2009), <https://www.politico.com/story/2009/10/cnbc-reuters-fall-for-climate-hoax-028456>.

8. Corynne McSherry, *More Silly Trademark Claims: Peabody Energy Threatens “Clean Coal” Spoof Site*, Elec. Frontier Found. (Jan. 12, 2010), <https://www.eff.org/deeplinks/2010/01/and-another-one-takedown-hall-shame-peabody-energy>.

declared that CCCU's goal was to "be a public relations tool for industry for the advancement of misinformation intended to manipulate the public to believe that clean utilization of coal is possible by hijacking the credibility of universities, industries, foundations, and government organizations." The spoof site also identified consortium members by name and, reasonably enough, included the members' corporate logos.

- In 2011, members of Youth for Climate Truth issued a press release, purportedly from Koch Industries, in which the company promised to stop funding organizations that deny climate change.⁹ The release was also briefly posted on a website (www.koch-inc.com) that partially imitated Koch Industries' own website.
- In 2012, as part of an effort to discourage Shell Oil from drilling in the Arctic, activists launched a campaign, ostensibly on Shell's behalf, that included billboards, a launch party in Seattle's Space Needle, and a spoof website that celebrated expanded access to Arctic resources as a result of global warming.¹⁰ The campaign was sparked by Shell's own series of promotional ads (responding

9. Noam Cohen, *A Conglomerate's Tack to Quash a Parody Site*, N.Y. Times (Feb. 13, 2011), <https://www.nytimes.com/2011/02/14/business/media/14link.html>.

10. Sydney Brownstone, *Q&A: How Anti-Shell Activists Punk'd the Internet (and Big Oil)*, Mother Jones (June 15, 2012), <https://www.motherjones.com/politics/2012/06/qa-how-activists-punkd-internet-and-big-oil/>.

to the 2010 BP oil spill) touting Shell's commitment to the environment and using the catchphrase "Let's go." The spoof ads placed text such as "Your SUV won't run on 'cute.' Let's go" and "He'll be fine. Promise. Let's go," along with Shell's logo, on top of images of polar bears and arctic foxes in the wild. Initially believed to be true, the spoof campaign was widely covered, as was the "reveal." In a 2015 follow-up action, activists posed as a Shell "street team" giving out free Shell-branded snow cones on the streets of New York City and telling people the treats were actually made from the last icebergs of the melting Arctic.¹¹



11. *Watch the Yes Men Impersonate Shell, Make 'Last Iceberg' Snow Cones*, Rolling Stone (June 12, 2015), <https://www.rollingstone.com/tv-movies/tv-movie-news/watch-the-yes-men-impersonate-shell-make-last-iceberg-snow-cones-39641/>.



- In 2014, German activists created a website touting four new Google products—Google Trust (data “insurance”), Google Bee (personal drones), Google Hug (location-based, crowdsourced hug matching) and Google Bye (an online profile for the afterlife)—to raise awareness about Google’s privacy policies.¹² The spoof was a great success, prompting a wave of commentary and coverage that recognized it for the satire that it was.
- In 2019, activists created and distributed a parody newspaper, accompanied by a website, spoofing the Washington Post and crowing about the “Unpresided” flight of Donald Trump from the Oval Office as he abandoned

12. Ellen Huet, *Google Nest Spoof by German Activists Promises Eerie, Data-Driven Future*, Forbes (May 7, 2014), <https://www.forbes.com/sites/ellenhuet/2014/05/07/google-nest-spoof-by-german-activists-promises-eerie-data-driven-future/>.

the presidency.¹³ The spoof, created by activist group the Yes Men, was also visible on the website democracyawakensinaction.org.

- In 2022, amid growing public concern over rising drug prices, a Twitter account impersonating pharmaceutical giant Eli Lilly posted, “We are excited to announce that insulin is free now.”¹⁴ The fake account used the handle @EliLillyandCo and had the company’s logo as its profile picture. Within hours, the tweet had received over 1,500 retweets and 11,000 likes. That attention forced a quick public response from Eli Lilly: “We apologize to those who have been served a misleading message from a fake Lilly account. Our official Twitter account is @LillyPad.” That response, which conspicuously failed to address the substance of the parody tweet, garnered its own obvious parody the next day, when another fake Eli Lilly account—also using the company’s trademarks—tweeted, “We apologize to those who were have been [sic] served a misleading message from a fake Lilly account about the cost of diabetic care. Humalog is now \$400. We can do this whenever we want and there’s nothing you can do about it. Suck it. Our official Twitter account is @LillyPadCo.”

13. Kit Walsh, *Washington Post Tries to Take Down Parody Site Announcing Trump’s Resignation*, Elec. Frontier Found. (Jan. 22, 2019), <https://www.eff.org/deeplinks/2019/01/washington-post-tries-take-down-parody-site-announcing-trumps-resignation-0>.

14. Matthew VanTryon, *Fake Eli Lilly Twitter Account Falsely Claimed Insulin ‘Free’*, IndyStar. (Nov. 11, 2022), <https://www.indystar.com/story/news/2022/11/10/twitter-elon-musk-insulin-eli-lilly-fake-tweet/69639067007/>.

As these examples suggest, identity correction and culture jamming have become common and effective forms of political critique. Some initial degree of confusion is often integral to that effectiveness: forcing a public denial by the target company shines a spotlight on the company's actual actions and positions. At the same time, the confusion is not meant to last: without some form of reveal, the action's goal of highlighting contradictions between marketing and reality will not be realized.

B. *Rogers* Strikes the Right Balance Between Trademark Rights and Constitutional Rights

In a world where trademarks are part of common political discourse, “trademarks [must] not be transformed from rights against unfair competition to rights to control language.” *CPC Int'l, Inc. v. Skippy Inc.*, 214 F.3d 456, 462 (4th Cir. 2000) (internal quotation marks and citation omitted) (quoting Mark Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 Yale L.J. 1687, 1710–11 (1999)).

Rogers and its progeny help prevent that transformation, while simultaneously protecting consumers and the legitimate business interests of mark owners. See generally Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 Washington L. Rev. 887, 903 (2005) (“The balancing test articulated by the *Rogers* court is compelling because it is the only approach attuned to the primary purpose of trademark laws: protecting the public against confusion and fraud.”)

The *Rogers* test is a relatively non-demanding test for plaintiffs to meet as compared to other First Amendment standards for common law or statutory claims. For example, the *Rogers* test falls far short of the strict scrutiny analysis applied to practically every other content-based restriction on speech. See *Reed v. Town of Gilbert*, 576 U.S. 155, 169 (2015). Under that test, the law is presumptively unconstitutional and is upheld only if the restriction is actually necessary to advancing a compelling state interest. *Id.* at 171; *Brown v. Entm't Merchants Ass'n*, 564 U.S. 786, 799 (2011). The *Rogers* test is also less demanding than the intermediate scrutiny test courts apply to content-neutral restrictions on speech, see *Nat'l Inst. of Family & Life Advocates v. Becerra*, ___ U.S. ___, 138 S. Ct. 2361, 2375 (2018) (finding a state law failed intermediate scrutiny when it was not sufficiently drawn to achieve a substantial state interest); the time, place, and manner test applied to content-neutral restrictions on speech in public forums, *McCullen v. Coakley*, 573 U.S. 464, 477 (2014); or the “exacting scrutiny” test applied to compelled associational disclosures, *Americans for Prosperity Found. v. Bonta*, ___ U.S. ___, 141 S. Ct. 2373, 2383 (2021) (requiring “a substantial relation between the disclosure requirement and a sufficiently important governmental interest”).

Because it is largely objective, the *Rogers* test is also less demanding than the subjective actual malice standard this Court imposed upon a centuries-old body of common law defamation law, requiring public figures to prove by clear and convincing evidence that the speaker knew a statement was false or seriously doubted its truth. See *New York Times v. Sullivan*, 376 U.S. 254, 280-81 (1964). This Court later imposed a similar rigorous standard on

the tort of intentional infliction of emotional distress when the predicate conduct is the making of a false statement, requiring the public figure plaintiff to prove that the defendant subjectively intended for others to believe a false statement to be true. *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 56 (1988).

In addition to its relatively low burden, *Rogers* offers legal certainty to trademark owners, competitors, consumers, and activists alike. The test has been adopted in multiple circuits, creating almost uniform rules across the nation. *See, e.g., L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 27, 34 (1st Cir. 1987); *Nike, Inc. v. “Just Did It” Enter.*, 6 F.3d 1225, 1226 (7th Cir. 1993); *ETW v. Jireh*, 332 F.3d 915, 928 (6th Cir. 2003); *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1052 (10th Cir. 2008); *Univ. of Ala. Bd. of Trustees v. New Life Art*, 683 F.3d 1266, 1277 (11th Cir. 2012); *see generally* McCarthy at § 31:139 (describing *Rogers* rule of analysis as a “judicial consensus”); Lynn M. Jordan & David M. Kelly, *Another Decade of Rogers v. Grimaldi: Continuing to Balance the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 109 Trademark Rptr. 833, 834 (2019) (the *Rogers* test has “clearly become the standard in disputes involving trademarks”).

C. The *Rogers* Test Offers Essential Practical Protections

Thanks to its simplicity and influence, the *Rogers* test offers not just abstract but very practical protections for political speech. Activists who use trademarks as part of their critique are regularly subject to legal threats they

cannot afford to litigate. For example, nearly all of the actions described above provoked legal challenges in the form of cease and desist letters—to the activists or their webhosts—and/or lawsuits, accusing them of trademark infringement and/or dilution. *See, e.g.*, Complaint, *Chamber of Commerce v. Servin*, No. 1:09-cv-2014 (D.D.C. Oct. 26, 2009), <https://www.eff.org/document/complaint-42>; *Koch Indus., Inc. v. Does*, No. 2:10-CV-1275, 2011 WL 1775765 (D. Utah May 9, 2011).

EFF and other public interest organizations were able to assist most of those activists, and others too numerous to list here, but pro bono trademark counsel is not easy to find. And even the most committed public interest counsel will hesitate to sign up to defend a lawsuit that relies on the standard likelihood of confusion test, which usually will require lengthy discovery, including expert discovery, and potentially a trial. “Faced with hugely expensive and lengthy litigation over vague standards, the recipient of a cease and desist letter will most often capitulate.” J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:139 (5th ed. Dec. 2022 Update).

The *Rogers* test helps activists and others fight back by increasing predictability and reducing litigation costs.

1. The *Rogers* Test Increases Predictability

The standard likelihood of confusion analysis is both complex and subjective. The test varies from circuit to circuit, but each version requires consideration of between six and ten individual factors, to be balanced against one another with little guidance as to how strongly each factor will be weighed. Speakers facing such a test will be hard-

pressed to confidently evaluate their risk of infringement liability *ex ante*. That evaluation may even be more difficult in cases involving expressive works, where the traditional likelihood of confusion factors can be a poor fit and awkward to apply. For instance, in parody cases the similarity of marks and strength of mark factors would seem to lean more heavily towards an infringement finding the more effective the parody is. *Radiance Found., Inc. v. N.A.A.C.P.*, 786 F.3d 316, 324–25 (4th Cir. 2015). The resulting uncertainty from trying to apply an already unpredictable test to a context it was not developed for will inevitably chill lawful speech.

Trademark owners and attorneys are well aware of the coercive power of dubious trademark claims. In one survey of fifty attorneys who practice trademark and copyright law, many of the interviewed attorneys admitted to enforcing trademark claims they believed were weak through demand letters—because it works. *See* William T. Gallagher, *Trademark and Copyright Enforcement in the Shadow of IP Law*, 28 Santa Clara Computer & High Tech. L.J. 453, 478, 485–88 (2012). Survey participants also admitted to being more likely to take enforcement action against small-scale actors who would be unlikely to have the resources to resist even a weak claim. *Id.* at 478. *See also id.* at 496 (citing “the costs and uncertainties” of trademark litigation as the likely reason for the effectiveness of aggressive enforcement).

The *Rogers* test helps mitigate these chilling effects. First, the test is simpler on its face. *Rogers* replaces multifactor free-form balancing with two relatively straightforward questions: Is the use artistically relevant to the expressive work, and is it explicitly misleading? Second, the *Rogers* test also increases predictability by

focusing on the nature of the user’s behavior, “not the impact of the use.” *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1246 (9th Cir. 2013). Under this framework, a speaker should always have all the information they need to assess their liability risk.

Importantly, the *Rogers* test also recognizes that a modicum of confusion need not change the analysis. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989). Effective parodies often involve some confusion. In 1729, for example, Jonathan Swift published *A Modest Proposal: For Preventing the Children of Poor People in Ireland, from Being a Burden on Their Parents or Country, and for Making Them Beneficial to the Publick*.¹⁵ The “proposal” advocated for the consumption of Irish babies; Swift’s intent was to call attention to the extreme poverty of the Irish people under English rule. The point was initially lost on some shocked readers, but it stands as one of the most influential political writings in Anglo-American history. In 1996, the spring issue of a leading journal of cultural and scientific studies, *Social Text*, included an article by Alan Sokal, a physics professor at New York University, arguing that gravity, as normally construed, was a “capitalist fiction” and should be replaced by a new theory, “quantum gravity,” that would better reflect post-modern political thinking, if not actual physical reality.¹⁶ That same day, Sokal published a piece in another academic publication, *Lingua Franca*, explaining

15. Available at <https://www.gutenberg.org/cache/epub/1080/pg1080-images.html>.

16. Alan Sokal, *Transgressing the Boundaries: Towards a Transformative Hermeneutics of Quantum Gravity*, 46/47 *Social Text* 217 (1996), available at https://physics.nyu.edu/faculty/sokal/transgress_v2/transgress_v2_singlefile.html.

that the first piece was a hoax and that any competent mathematician or physicist would have known it.¹⁷ As Sokal intended, the article and its aftermath sparked a widespread debate about postmodern science studies.

These successful satires, like the identity corrections discussed above, relied on two elements: (1) presenting a surprising or disturbing proposition that would provoke an immediate reaction from an audience; and (2) some sort of “reveal,” without which the satire would be ineffective. Swift’s “Proposal” would not accomplish its purpose if the reader did not come to understand his true point about the desperate circumstances of the Irish. Sokal’s hoax would not have accomplished its purpose if he had not published the accompanying piece in *Lingua Franca*. Both are effective precisely because they involve, in part, some initial confusion.

2. The *Rogers* Test Decreases Litigation Costs

The complexity of the standard multifactor test also translates into significant litigation costs, even for a defendant who is ultimately vindicated. A survey conducted by the American Intellectual Property Law Association found that in 2015, the median total cost of litigating a trademark claim was between \$325,000 and \$1,600,000 per party, depending on the amount in controversy. Am. I.P. Law Ass’n, *Report of the Economic Survey 2015*, at 38–39 (2015), <https://perma.cc/8UUL->

17. Alan Sokal, *A Physicist Experiments with Cultural Studies*, *Lingua Franca* 62 (1996), available at https://physics.nyu.edu/faculty/sokal/lingua_franca_v4/lingua_franca_v4.html.

BNE8. The median cost of a trademark case through the end of discovery ranged from \$150,000 to \$900,000.

The threat of high litigation costs is exacerbated by courts' reluctance to decide likelihood of confusion before discovery or even on post-discovery summary judgment motions. Indeed, courts around the country have instructed district judges that summary dismissals based on likelihood of confusion are "generally disfavored" due to the test's "intensely factual nature." *Interstellar Starship Servs., Ltd. v. Epix Inc.*, 184 F.3d 1107, 1109 (9th Cir. 1999); see also *Country Floors, Inc. v. P'ship Composed of Gepner & Ford*, 930 F.2d 1056, 1062–63 (3d Cir. 1991) (characterizing summary judgment as "the exception" in trademark cases); *AHP Subsidiary Holding Co. v. Stuart Hale Co.*, 1 F.3d 611, 616 (7th Cir. 1993) ("[A] motion for summary judgment in trademark infringement cases must be approached with great caution.").

For many activists, those costs alone act as an effective bar to defending their rights:

Many non-competitive users of trademarks in artistic, cultural, and political speech have finally prevailed in court only after incurring massive costs. Such costs, including attorney's fees, the costs of expert witnesses, lost time, and uncertainty can deter both lawful and unlawful conduct—indeed, the "specter of such expenses" is part of traditional deterrence analysis.

Hannibal Travis, *The Battle for Mindshare: The Emerging Consensus That the First Amendment Protects*

Corporate Criticism and Parody on the Internet, 10 Va. J.L. & Tech. 3, 14 (2005).

The *Rogers* test helps lower that bar by allowing courts to resolve appropriate cases early, with limited or no need for discovery. *See, e.g., Brown*, 724 F.3d at 1239 (affirming Rule 12 dismissal under *Rogers*); *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172, 183 (S.D.N.Y. 2012) (rejecting argument that *Rogers* cases cannot be decided on the pleadings and granting dismissal); *Rebellion Devs. Ltd. v. Stardock Ent., Inc.*, No. 12-12805, 2013 WL 1944888 at *4, *6 (E.D. Mich. May 9, 2013) (same). *Rogers* requires a court to answer just two questions, both of which will often be readily determinable based only on a review of the defendant's use and the plaintiff's mark. Even where a *Rogers* case cannot be resolved before discovery, the test's relative simplicity and its focus on user conduct rather than consumer perception reduce litigation costs by narrowing the issues and avoiding the need for costly survey experts.

For defendants with limited resources, the ability to dispose of a claim before discovery can make the difference in whether they can afford to vindicate their rights. In addition to making litigation less costly, the *Rogers* test's greater suitability to early resolution and lesser discovery needs increase the availability of pro bono counsel to those who need it. To give another identity correction example, when activists created a parody website, coalcares.org, to draw attention to the dangers coal plants pose to surrounding communities (the website purportedly offered free inhalers to children who had developed asthma), they promptly received a legal threat from Peabody Energy. Relying in part on the First

Amendment balancing test described by *Rogers* and its progeny, EFF was able to stave off that threat.¹⁸ EFF is proud to defend this form of criticism, but as a small nonprofit we do not have unlimited resources to fund discovery or retain survey experts, nor do the private law firms who may serve as pro bono co-counsel. We, and our clients, depend on streamlined tests like *Rogers* to help avoid or swiftly resolve litigation over expressive uses.

One final pair of cases highlights the difference that the *Rogers* test can make in the burden of litigating expressive uses. *Stewart Surfboards v. Disney* is an example of how the *Rogers* test should work. In that case, a well-known surfboard maker sued Disney for the inclusion of its trademark on a depiction of a surfboard on the back cover of a fictional surfing-themed book. *Stewart Surfboards, Inc. v. Disney Book Grp., LLC*, No. CV 10–2982, 2011 WL 12877019, at *1 (C.D. Cal. May 11, 2011). The court applied *Rogers* and decided in Disney’s favor on the pleadings under Rule 12(b)(6)—no discovery or experts required. *Id.* at *4, *8. In its decision, the court observed that “if the court must consider the likelihood-of-confusion factors in assessing *Rogers*’ second prong, ruling on a motion to dismiss would usually not be appropriate.” *Id.* at *6.

On the other end of the spectrum is *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302 (N.D. Ga. 2008). In *Smith*, Wal-Mart claimed that a critic of the company had infringed and diluted its trademarks by

18. See Corynne McSherry, *Mr. Peabody’s Coal Train Tries To Run Down Free Speech*, Elec. Frontier Found. (May 13, 2011), <https://www.eff.org/deeplinks/2011/05/mr-peabodys-coal-train-tries-run-down-free-speech>.

selling merchandise bearing the words “Walocaust” and “Walqaeda,” along with other anti-Wal-Mart slogans. *Id.* at 1309–13. Under *Rogers*, Wal-Mart’s claims could easily be resolved on early motions. That did not happen in *Smith*. While the court ultimately found in Smith’s favor by applying the Eleventh Circuit’s standard likelihood of confusion factors, *id.* at 1338–39, it did so in a 41-page summary judgment opinion after more than two years of litigation, including a full course of discovery and dueling survey experts, *see id.* at 1311 (action filed Mar. 6, 2006); *id.* at 1317, 1329. Smith was fortunate to have pro bono legal counsel from the nonprofit organization Public Citizen, which allowed him to persevere through the litigation process and vindicate his rights. *See* William McGeeveran, *Rethinking Trademark Fair Use*, 94 Iowa L. Rev. 49, 70–71 (2008). Otherwise, the likely result would have been the silencing of lawful speech by one of the world’s largest companies.

D. The *Rogers* Test Should Not Have a Non-Commerciality Requirement or Hinge on the Expressive Medium

To adequately protect critical political expression, the *Rogers* test should apply not only to traditional expressive mediums—films, books, visual art, etc.—but also to expressive uses in contexts that seem more akin to everyday consumer goods. In other words, the applicability of the *Rogers* test should hinge on the message, not the medium.

Political expression can come in many forms. *See, e.g., Tinker v. Des Moines Indep. Community Sch. Dist.*, 393 U.S. 503, 505–06 (1969) (black armbands); *Cohen v. California*, 403 U.S. 15, 18 (1971) (jacket reading “Fuck

the Draft”); *Texas v. Johnson*, 491 U.S. 397 (1989) (flag burning); *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 576 U.S. 200, 219 (2015) (specialty license plates). Modes of political expression that rely on trademarks, such as culture jamming, are by their nature particularly likely to use nontraditional mediums to communicate a message. In 2009, for example, the Yes Men collaborated with the Bhopal Medical Appeal (BMA) to make limited-edition bottles of water “bottled at the source of the world’s largest industrial accident”—a 1984 toxic-gas leak in Bhopal, India.¹⁹ The water was bottled under the name “B’eau Pal” and featured a label design based on the Dow Chemical logo:



19. Bruce Sterling, *More Mayhem from the Yes-Men*, *Wired* (Jul. 18, 2009), <https://www.wired.com/2009/07/more-mayhem-from-the-yes-men/>.

The activists sold the water to increase awareness of the disaster and its continuing effects, and to raise money for the BMA, which advocates for the victims of the Bhopal Catastrophe whose drinking water is still contaminated.

With too narrow a construction of the *Rogers* test, a court might well find that the B'eau Pal water bottles fall outside of the test's reach: the medium seems to be a regular consumer good, the Dow logo is used in a way that appears to be a source identifier, and the bottles were sold for money. Yet this is exactly the kind of core political speech the *Rogers* test should help protect—a biting critique of a powerful corporation, not an attempt to profit off of Dow's goodwill or mislead consumers.

CONCLUSION

Amicus EFF respectfully requests that the Court endorse the *Rogers* test as the standard for evaluating Lanham Act claims based on expressive uses of trademarks.

February 23, 2023

Respectfully submitted,

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