

NO. 21-55881

IN THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

PUNCHBOWL, INC.,

PLAINTIFF-APPELLANT,

v.

AJ PRESS, LLC,

DEFENDANT-APPELLEE.

Appeal from the United States District Court for Central California, Los Angeles
No. 2:21-cv-03010-SVW-MAR
Hon. Stephen V. Wilson

**BRIEF OF *AMICUS CURIAE* ELECTRONIC FRONTIER FOUNDATION
IN SUPPORT OF DEFENDANT-APPELLEE AND AFFIRMANCE**

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CORPORATE DISCLOSURE STATEMENT

Pursuant to Rule 26.1 of the Federal Rules of Appellate Procedure, Amicus Curiae Electronic Frontier Foundation states that it does not have a parent corporation and issues no stock.

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STATEMENT OF INTEREST¹

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 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 Pursuant to Federal Rule of Appellate Procedure 29(a)(4)(E), no one other than the Electronic Frontier Foundation or its counsel authored this brief in whole or in part, or contributed money towards its preparation. Appellee consents to the filing of this brief; Appellant does not.

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* (May 13, 2011), <https://www.eff.org/deeplinks/2011/05/mr-peabodys-coal-train-tries-run-down-free-speech>.

INTRODUCTION

Courts have long recognized the importance of ensuring that statutory trademark rights do not unduly impede constitutional free expression rights. The balancing test articulated in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), and developed in subsequent cases is central to accomplishing that goal. As a legal services organization that has defended and counseled numerous brand activists and small companies threatened by large trademark owners, EFF is acutely aware of the important role *Rogers* and its progeny play in ensuring the Lanham Act does not trump the First Amendment.

Appellant's effort to rewrite *Rogers* to make it both narrower and more complex will significantly weaken its protection for expressive uses. That effort should fail.

ARGUMENT

I. This Circuit Should Continue to Apply *Rogers* Flexibly.

Appellant urges the Court to adopt a new, narrow, and more rigid view of *Rogers*'s scope that would inevitably inhibit a range of expressive speech. The Court should decline.

First, Appellant asks the Court to distinguish news reporting from “artistic and creative works.” *See* Appellant's Opening Brief [“AOB”] 12. That distinction finds no basis in the law and indeed is inconsistent with *Rogers*'s reasoning and

purpose: to ensure that trademark rights are not used to impose monopolies on language and intrude on First Amendment values. *See Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013) (“Section 43(a) protects the public’s interest in being free from consumer confusion about affiliations and endorsements, but this protection is limited by the First Amendment, particularly if the product involved is an expressive work.”); *see generally CPC Int’l v. Skippy, Inc.*, 214 F.3d 456, 462 (4th Cir. 2000) (“It is important that trademarks not be ‘transformed from rights against unfair competition to rights to control language.’” (quoting Mark Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1710–11 (1999))). Given that news reporting falls at the very core of First Amendment protection, excluding it from the scope of a test designed to accommodate heightened expressive interests defies reason.

Moreover, even if Appellant’s framing of journalistic works such as “newsletters, podcasts, and videos” as mere “commercial products” (AOB 15) were credible, such products are not categorically denied *Rogers* protection. For example, this Court recently concluded that a dog toy incorporating a play on the plaintiff’s trademark was an expressive work, deeming the choice of medium “irrelevant” and explaining that a work “is not rendered non-expressive simply because it is sold commercially.” *See VIP Prods. LLC v. Jack Daniel’s Prods., Inc.*, 953 F.3d 1170, 1175 (9th Cir. 2020), *cert. denied*, 141 S. Ct. 1054 (2021).

The Court should also reject Appellant’s proposed exclusion of source-identifying uses from *Rogers*’s ambit. *See* AOB 14–16. The appropriate question is whether the use is being made in connection with an expressive work, because even source-identifying terms attached to a work can further a speaker’s expressive goals.³ For example, in *Twentieth Century Fox Television v. Empire Distribution, Inc.*, 875 F.3d 1192 (9th Cir. 2017), the Court applied *Rogers* to the use of the word “Empire” both as a title of a television show and “as an umbrella brand to promote and sell music and other commercial products.” *Id.* at 1196. The Court did not ask whether the Empire name itself was an expressive work or if it functioned as a source identifier; rather, it focused on the television show’s expressive nature. *Id.*

That approach was wise. To exclude all source-identifying uses of language from *Rogers*’s protection would significantly undermine future expression, harming both the defendant and the public. A key distinction between infringement cases that involve expressive works and those that do not is their possible consequences. *See Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013) (*Rogers* test applies where the cost to creators and the public of

³ In cases where a mark associated with an expressive work truly is *only* a source identifier and does not further the expression, that will be dealt with by *Rogers*’s “artistic relevance” prong.

imposing trademark rights “is most significant”). In the latter category, which will cover the vast majority of cases, the biggest risk to the public is that some useful good will become unavailable or more expensive. In cases involving expressive works, on the other hand, trademark claims can result in the elimination of information and ideas from the public sphere. The Court in *Twentieth Century Fox* recognized this dynamic, explaining that “the balance of First Amendment interests struck in *Rogers* . . . could be destabilized if the titles of expressive works were protected but could not be used to promote those works.” 875 F.3d at 1197.

Appellant suggests that an infringement finding regarding a source-identifying title will not have detrimental consequences for the accompanying expression. *See* AOB 9, 14–15. In practice, however, any such finding would have far-reaching ramifications on speech. In this case, for example, an injunction would likely mean more than just editing the title of a website. Among other things, Appellee may need to purchase a new domain name and transfer all of the content currently found at www.punchbowl.news to that new location. Depending on whether the terms of the injunction permitted Appellee to retain the [punchbowl.news](http://www.punchbowl.news) domain name and redirect visitors to the new website, Appellee also may face a challenge to inform current readers of the change. Appellee may further need to rename its “Punchbowl News” YouTube channel, which has over

1,500 subscribers,⁴ and potentially rename, edit, and/or delete videos or podcasts incorporating the Punchbowl News name.

As a practical result of these requirements, Appellee would face significant burdens in reaching the audience for its existing and future expressive works, and some expression could even be removed from the public sphere entirely. These collateral consequences on noncommercial speech are reason enough for *Rogers*'s heightened protections to apply. *See Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264–65 (9th Cir. 2018) (where “First Amendment interests are at stake,” the *Rogers* test applies).

Trademark claims involving expressive works can pose these same risks even if an injunction does not result, especially where the defendant has limited resources. As discussed below, the costs of defending a trademark lawsuit can be prohibitive to small businesses or individuals. By applying the streamlined *Rogers* test liberally in cases involving expressive works, courts can reduce the cost to speakers of defending their rights and decrease the risk that availability of their works will suffer.

II. The *Sleekcraft* Factors Should Not Be Considered in the *Rogers* Test.

To allow the “explicitly misleading” prong to turn into a replication of the

⁴ *Punchbowl News* YouTube Channel, <https://www.youtube.com/channel/UCmagDxvmbBpjzKg09LmBSow> (1.57K subscribers as of Dec. 20, 2021).

standard *Sleekcraft* likelihood-of-confusion test, as Appellant suggests, would undermine the entire purpose of the *Rogers* test. To act as a meaningful First Amendment safeguard for expressive speech, the *Rogers* test should do three things: It should set a higher bar for enjoining speech, it should provide sufficiently clear guidance to prevent uncertainty-based chilling effects, and it should reduce litigation costs. While a thumb-on-the-scale balancing of First Amendment considerations against the *Sleekcraft* factors may accomplish the first goal, it will fail to achieve the latter two.

A. The *Rogers* Test Increases Predictability.

The standard likelihood-of-confusion analysis is both complex and subjective. Speakers facing a test that requires consideration of eight individual factors, to be balanced against one another with little guidance as to how strongly each factor will be weighed, will be hard-pressed to confidently evaluate their risk of infringement liability *ex ante*. Indeed, 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. In parody cases, for instance, a traditional application of the similarity of marks, similarity of goods, and intent factors would lean more heavily towards an infringement finding the more artful the parody is.

That uncertainty will inevitably chill lawful speech. As one district court in

this Circuit observed, “[b]ecause application of the multi-factor likelihood-of-confusion test could produce uncertain results, applying that test in connection with the second *Rogers* prong could chill artistically relevant expressive uses of trademarks.” *Stewart Surfboards, Inc v. Disney Book Grp., LLC*, No. CV 10-2982 GAF (SSX), 2011 WL 12877019, at *7 (C.D. Cal. May 11, 2011).

Moreover, many cases will never reach a court of law, because speakers will not have the means to fight back. Trademark owners and attorneys are well aware of the chilling effect 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, as this Circuit has construed it, helps mitigate these chilling effects. First, the test is simpler on its face. *Rogers* replaces *Sleekcraft*’s eight-factor free-form balancing with two relatively straightforward questions: Is the use

artistically relevant to the expressive work, and is it explicitly misleading? While the “explicitly misleading” prong would benefit from further clarification, it is overall far easier for a speaker to answer these two questions than to guess at how a judge or jury would balance the various *Sleekcraft* factors.

Indeed, if the *Sleekcraft* factors become embedded in the second prong of the *Rogers* analysis, the result will be a test that is actually *more* complex for expressive uses. That is, evaluating a claim under *Rogers* using this approach would require inquiries into *Rogers*’s application and the use’s artistic relevance *in addition to* the usual multifactor balancing. That new complexity will put make it significantly harder for speakers to evaluate their legal risk and defend against legal threats, contradicting the First Amendment interests *Rogers* is intended to protect.

In addition to its simplicity, the *Rogers* test 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. Adding factors outside of the user’s control into the *Rogers* analysis, like actual confusion, would erode that advantage.

B. The *Rogers* Test Decreases Litigation Costs.

The complexity of the *Sleekcraft* 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-BNE8>. The median cost of a trademark case through the end of discovery ranged from \$150,000 to \$900,000. For small businesses and individuals, those costs act as an effective bar to defending their rights.

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*); *VIRAG, S.R.L. v. Sony Computer Entm't Am. LLC*, 699 F. App'x 667, 668 (9th Cir. 2017) (same); *Jackson v. Netflix, Inc.*, 506 F. Supp. 3d 1007, 1016–17 (C.D. Cal. 2020) (dismissing infringement claim under Rule 12); *Stewart Surfboards*, 2011 WL 12877019, at *8 (same).

Rogers requires a court to answer just two questions, both of which should 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.

In *Sleekcraft* cases, 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, this Court has repeatedly 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*, e.g., *Thane Int'l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 901 (9th Cir. 2002); *JL Beverage Company, LLC v. Jim Beam Brands Co.*, 828 F.3d 1098, 1105 (9th Cir. 2016) (reversing summary dismissal), *later proceedings* 815 Fed. App'x 110 (9th Cir. 2020) (affirming judgment for defendant after trial).

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 a 2018 article, Professor Glynn Lunney, provides a striking illustration of this point. Glynn S. Lunney, Jr., *Two-Tiered Trademarks*, 56 *Hous. L. Rev.* 295, 301–03 (2018). Professor Lunney discusses two infringement cases filed by Exxon Mobil regarding a mark consisting of interlocking double Xs. In the first case, the defendant was Fox Networks, a powerful media conglomerate. Over the course of two years, the parties hired multiple experts, conducted expensive surveys, and litigated a full battery of motions, including motions to

dismiss, motions in limine, motions for summary judgment, and motions to exclude testimony. Shortly before trial was scheduled to begin, the parties reached a confidential settlement that apparently permitted Fox to continue using its FXX mark.

The same month that the Fox case ended, Exxon sued Nielsen Spirits, a two-person spirits company, over the branding of its Roxx Vodka. Nielsen moved to dismiss and/or transfer, but that was the only motion it could afford to file. Less than a year later, the suit settled with Nielsen's motion still undecided. Unlike the settlement with Fox, though, the Nielsen settlement prohibited Nielsen from continuing to use its ROXX mark. The difference between the two settlements cannot reasonably be explained by a difference in the merits of the claims—it is highly unlikely that consumers would confuse a vodka brand with a massive gas company. Instead, a far better explanation is that a small company gave in because it could not afford to do otherwise.

In addition to making litigation more affordable, 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. EFF knows this well, because it regularly offers pro bono services to activists who have faced legal threats and litigation based on their use of trademarks for parodies and satires. For 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.⁵

As the First Circuit noted in *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 28 (1st Cir. 1987), “trademarks have become a natural target of satirists who seek to comment on this integral part of the national culture.” *Id.* (citing Harriette K. Dorsen, *Satiric Appropriation and the Law of Libel, Trademark and Copyright: Remedies Without Wrongs*, 65 B.U. L. Rev. 923, 939 (1986)).

Unfortunately, as Professor Thomas McCarthy has observed:

Some of the litigation brought by trademark owners against those who make fun of their company’s policies by the use of parodies of their trademarks reveals that some mark owners are hyper-sensitive to such humorous and sometimes caustic criticism. Perhaps it is because many top executives in large companies are not used to being mocked and made fun of. Therefore, they are ready, willing and able to unleash the dogs of litigation against anyone who makes fun of the symbol of their company.

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:153 (5th ed. Dec. 2021 Update).⁶

⁵ See Corynne McSherry, *Mr. Peabody’s Coal Train Tries To Run Down Free Speech* (May 13, 2011), <https://www.eff.org/deeplinks/2011/05/mr-peabodys-coal-train-tries-run-down-free-speech>.

⁶ Consider, for example, the North Face’s trademark infringement lawsuit filed against a teen who created “The South Butt” and used the slogan “Never Stop

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 co-counsel. We, and our clients, depend on streamlined tests like *Rogers* to help avoid and/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* is an example of how the *Rogers* test should work. In *Stewart Surfboards*, 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. 2011 WL 12877019, at *1. 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.

Relaxing” (as opposed to the North Face’s “Never Stop Exploring”) to help pay for college, and included a disclaimer on his website stating: “If you are unable to discern the difference between a face and a butt, we encourage you to buy North Face products.” Debra Cassens Weiss, *The North Face Sues The South Butt for Trademark Infringement*, ABA Journal (Dec. 15, 2009), https://www.abajournal.com/news/article/the_north_face_sues_the_south_butt_for_trademark_infringement.

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 selling merchandise bearing the words “Walocaust” and “Walqaeda,” along with other anti-Wal-Mart slogans. *Id.* at 1309–13. Under Ninth Circuit precedent, 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, *Smith*, 537 F. Supp. 2d 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 McGeveran, *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.

CONCLUSION

The *Rogers* test plays an important role in safeguarding First Amendment values from erosion by trademark law in those cases where the risk to expression is highest. This Circuit has stayed true to this purpose by avoiding narrow

conceptions of the test's applicability and keeping it distinct from the standard likelihood-of-confusion analysis. It should continue to do so.

Dated: December 20, 2021

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to Fed. R. App. P. 32(g), I certify as follows:

1. This Brief of Amicus Curiae Electronic Frontier Foundation complies with the type-volume limitation because this brief contains 3,487 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(f); and

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word 2016, the word processing system used to prepare the brief, in 14-point font in Times New Roman font.

Dated: December 20, 2021

/s/ Cara Gagliano
Cara Gagliano

CERTIFICATE OF SERVICE

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

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

Dated: December 20, 2021

/s/ Cara Gagliano
Cara Gagliano