

In the Supreme Court of the United States

JACK DANIEL'S PROPERTIES, INC., PETITIONER

v.

VIP PRODUCTS LLC

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

**BRIEF FOR THE UNITED STATES
AS AMICUS CURIAE SUPPORTING PETITIONER**

THOMAS W. KRAUSE
Solicitor
CHRISTINA J. HIEBER
*Senior Counsel for Trade-
mark Policy and Litigation*
THOMAS L. CASAGRANDE
MARY BETH WALKER
BENJAMIN T. HICKMAN
*Associate Solicitors
United States Patent and
Trademark Office
Alexandria, VA 22314*

ELIZABETH B. PRELOGAR
*Solicitor General
Counsel of Record*
BRIAN M. BOYNTON
*Principal Deputy Assistant
Attorney General*
MALCOLM L. STEWART
Deputy Solicitor General
MATTHEW GUARNIERI
*Assistant to the Solicitor
General*
DANIEL TENNY
CATHERINE PADHI
Attorneys
*Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217*

QUESTIONS PRESENTED

1. Whether the court of appeals erred in requiring petitioner to satisfy a special, non-statutory test before invoking the statutory likelihood-of-confusion standard for proving trademark infringement under the Lanham Act, 15 U.S.C. 1051 *et seq.*, on the theory that the statutory standard is insufficient to address First Amendment concerns when the alleged infringement involves the expression of a humorous message through parody.

2. Whether the court of appeals erred in holding that respondent's use in commerce of parodies of petitioner's trademarks is shielded from liability for trademark dilution under the statutory exclusion for "non-commercial use of a mark," 15 U.S.C. 1125(c)(3)(C), where respondent is using the parodic marks to sell goods in commerce for a profit.

TABLE OF CONTENTS

	Page
Interest of the United States.....	1
Statutory provisions involved.....	2
Statement	2
Summary of argument	11
Argument:	
I. The court of appeals erred in declining to apply the Lanham Act’s likelihood-of-confusion standard to petitioner’s trademark-infringement claims.....	14
A. The Lanham Act’s likelihood-of-confusion standard governs the determination whether parodic use of a trademark in commerce infringes the mark.....	15
B. First Amendment concerns do not justify displacing the Lanham Act’s likelihood-of- confusion standard when the alleged infringement occurs within the context of an “expressive work”	23
II. The court of appeals erred in holding that respondent is shielded from liability for trademark dilution under the statutory exclusion for noncommercial use	29
Conclusion	34
Appendix — Statutory provisions.....	1a

TABLE OF AUTHORITIES

Cases:

<i>AMF Inc. v. Sleekcraft Boats</i> , 599 F.2d 341 (9th Cir. 1979).....	7, 8, 16
<i>B&B Hardware, Inc. v. Hargis Indus., Inc.</i> , 575 U.S. 138 (2015).....	2, 15
<i>Brookfield Commc’ns, Inc. v. West Coast Entm’t Corp.</i> , 174 F.3d 1036 (9th Cir. 1999).....	16

IV

Cases—Continued:	Page
<i>Campbell v. Acuff-Rose Music, Inc.</i> , 510 U.S. 569 (1994).....	11, 18, 19, 21, 31
<i>Cardtoons, L.C. v. Major League Baseball Players</i> Ass’n, 95 F.3d 959 (10th Cir. 1996)	26
<i>Central Hudson Gas & Elec. Corp. v. Public Serv.</i> Comm’n, 447 U.S. 557 (1986).....	25
<i>Corley v. United States</i> , 556 U.S. 303 (2009)	31
<i>Cutter v. Wilkinson</i> , 544 U.S. 709 (2005)	22
<i>Dallas Cowboys Cheerleaders, Inc. v. Pussycat</i> <i>Cinema, Ltd.</i> , 467 F. Supp. 366 (S.D.N.Y.), aff’d, 604 F.2d 200 (2d Cir. 1979)	29
<i>E. I. DuPont DeNemours & Co., In re</i> , 476 F.2d 1357 (C.C.P.A. 1973)	16
<i>Elvis Presley Enters., Inc. v. Capece</i> , 141 F.3d 188 (5th Cir. 1998).....	17
<i>Friedman v. Rogers</i> , 440 U.S. 1 (1979)	25
<i>Gordon v. Drape Creative, Inc.</i> , 909 F.3d 257 (9th Cir. 2018).....	23
<i>Hormel Foods Corp. v. Jim Henson Prods., Inc.</i> , 73 F.3d 497 (2d Cir. 1996)	19
<i>Jordache Enters., Inc. v. Hogg Wyld, Ltd.</i> , 828 F.2d 1482 (10th Cir. 1987).....	21
<i>Louis Vuitton Malletier S.A. v. Haute Diggity Dog</i> , LLC, 507 F.3d 252 (4th Cir. 2007).....	17, 20, 21
<i>Matal v. Tam</i> , 137 S. Ct. 1744 (2017).....	2, 3, 24, 26
<i>Mattel, Inc. v. MCA Records, Inc.</i> , 296 F.3d 894 (9th Cir. 2002), cert. denied, 537 U.S. 1171 (2003).....	31
<i>Moseley v. V Secret Catalogue, Inc.</i> , 537 U.S. 418 (2003).....	4, 30
<i>Nike, Inc. v. “Just Did It” Enters.</i> , 6 F.3d 1225 (7th Cir. 1993).....	17

V

Cases—Continued:	Page
<i>Polaroid Corp. v. Polarad Elecs. Corp.</i> , 287 F.2d 492 (2d Cir.), cert. denied, 368 U.S. 820 (1961).....	15
<i>Qualitex Co. v. Jacobson Prods. Co.</i> , 514 U.S. 159 (1995).....	2
<i>RadLAX Gateway Hotel, LLC v. Amalgamated Bank</i> , 566 U.S. 639 (2012)	33
<i>Rearden LLC v. Rearden Commerce, Inc.</i> , 683 F.3d 1190 (9th Cir. 2012)	16
<i>Rogers v. Grimaldi</i> , 875 F.2d 994 (2d Cir. 1989)	9, 13, 14, 26-28
<i>San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.</i> , 483 U.S. 522 (1987)	12, 24, 25
<i>Trade-Mark Cases</i> , 100 U.S. 82 (1879).....	24
<i>Two Pesos, Inc. v. Taco Cabana, Inc.</i> , 505 U.S. 763 (1992).....	3
<i>United States v. Stevens</i> , 559 U.S. 460 (2010)	24
<i>Wal-Mart Stores, Inc. v. Samara Bros.</i> , 529 U.S. 205 (2000).....	3, 15
<i>Ysleta del Sur Pueblo v. Texas</i> , 142 S. Ct. 1929 (2022)	31
Constitution and statutes:	
U.S. Const. Amend. I	12-14, 23-25, 28, 30, 31
Copyright Act of 1976, 17 U.S.C. 101 <i>et seq.</i>	18
17 U.S.C. 107	11, 18, 19
17 U.S.C. 107(1)	31
Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, § 3(a), 109 Stat. 985	30
Lanham Act, 15 U.S.C. 1051 <i>et seq.</i>	1
15 U.S.C. 1051(a)(1).....	2
15 U.S.C. 1057(b)	3

VI

Statutes—Continued:	Page
15 U.S.C. 1114.....	4
15 U.S.C. 1114(1)(a).....	3, 11, 15-17, 19, 25, 1a
15 U.S.C. 1115(a)	3
15 U.S.C. 1125(a) (1982).....	27, 13a
15 U.S.C. 1125(a)	3, 27, 2a
15 U.S.C. 1125(a)(1) (1988)	27
15 U.S.C. 1125(a)(1).....	27, 28, 2a
15 U.S.C. 1125(a)(1)(A)	3, 11, 15-17, 19, 25, 27, 2a
15 U.S.C. 1125(a)(1)(B)	3, 2a
15 U.S.C. 1125(a)(3).....	4, 3a
15 U.S.C. 1125(c)(1).....	4, 29, 3a
15 U.S.C. 1125(c)(2)(A)	8, 4a
15 U.S.C. 1125(c)(2)(B)	4, 4a
15 U.S.C. 1125(c)(2)(C)	4, 29, 5a
15 U.S.C. 1125(c)(3).....	4, 30, 5a
15 U.S.C. 1125(c)(3)(A)	5, 9, 13, 32, 33, 5a
15 U.S.C. 1125(c)(3)(A)(ii).....	17, 30, 32, 6a
15 U.S.C. 1125(c)(3)(B)	5, 13, 30, 32, 6a
15 U.S.C. 1125(c)(3)(C)	5, 10, 13, 29, 30, 6a
15 U.S.C. 1127.....	2
Trademark Act of 1946, ch. 540, 60 Stat. 427.....	2
Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, § 2, 120 Stat. 1731	30
Trademark Law Revision Act of 1988, Pub. L. No. 100-667, § 132, 102 Stat. 3946.....	27
35 U.S.C. 2(a)(1).....	1
Miscellaneous:	
H.R. Rep. No. 23, 109th Cong., 1st Sess. (2005).....	30
H.R. Rep. No. 374, 104th Cong., 1st Sess. (1995).....	4

VII

Miscellaneous—Continued:	Page
J. Thomas McCarthy, <i>McCarthy on Trademarks and Unfair Competition</i> (5th ed. 2022):	
Vol. 4	3, 15, 16
Vol. 6	20
Restatement (First) of Torts (1939)	16
S. Rep. No. 515, 100th Cong., 2d Sess. (1988).....	27
<i>The American Heritage Dictionary of the English Language:</i>	
(3d ed. 1992)	18
(4th ed. 2006).....	30
United States Patent & Trademark Office, <i>Trademark Manual of Examining Procedure</i> (July 2022)	3

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INTEREST OF THE UNITED STATES

The questions presented in this case concern the circumstances under which the commercial use of a parody of a trademark may give rise to liability for trademark infringement or dilution under the Lanham Act, 15 U.S.C. 1051 *et seq.* The United States Patent and Trademark Office (USPTO) administers the federal statutory scheme for trademark registration. 35 U.S.C. 2(a)(1). Under that scheme, the USPTO is charged with making *ex parte* decisions about the registrability of marks and with adjudicating *inter partes* disputes about registration and cancellation. The United States therefore has a substantial interest in the Court’s resolution of the questions presented here.

STATUTORY PROVISIONS INVOLVED

Pertinent statutory provisions are reproduced in an appendix to this brief. App., *infra*, 1a-14a.

STATEMENT

1. A trademark is a “word, name, symbol, or device” used by a person “to identify and distinguish his or her goods” in commerce and “to indicate the source of the goods.” 15 U.S.C. 1127. Under common-law principles, the person who first uses a trademark in commerce to identify his or her goods can acquire certain rights in the mark, including a limited right to “prevent[] others from using” it. *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015). The right to exclude allows trademarks to fulfill their essential function of “help[ing] distinguish a particular artisan’s goods from those of others.” *Ibid.* Consumers who recognize a mark can rely on it to “identify goods and services that they wish to purchase, as well as those they want to avoid.” *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017). The trademark “assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past.” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995).

Although trademarks are created by state rather than federal law, “Congress has long played a role in protecting them.” *B&B Hardware*, 575 U.S. at 142. The current federal trademark scheme dates to the Trademark Act of 1946, ch. 540, 60 Stat. 427, popularly known as the Lanham Act. The Lanham Act allows the owner of a trademark to register the mark with the USPTO if certain prerequisites are met. 15 U.S.C. 1051(a)(1). Federal registration provides *prima facie* evidence of the validity of the registered mark and of the owner’s

exclusive right to use the mark in commerce in connection with specified goods or services. 15 U.S.C. 1057(b), 1115(a).

Federal- and state-law protections against trademark infringement have “ancient origins,” rooted in the law of unfair competition. *Tam*, 137 S. Ct. at 1751. The Lanham Act provides enforcement mechanisms for the owners of both registered and unregistered marks. The owner of a mark used in interstate or foreign commerce may sue for trademark infringement when another person, without the mark owner’s consent, uses a mark in commerce in a manner that is “likely to cause confusion, or to cause mistake, or to deceive” about the source of the relevant goods. 15 U.S.C. 1114(1)(a) (registered marks); see 15 U.S.C. 1125(a)(1)(A) (unregistered marks). The “likelihood of confusion” standard is the “keystone” for determining trademark infringement. 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:1, at 23-9 (5th ed. 2022) (*McCarthy*).¹

The Lanham Act affords similar protection for a product’s distinctive “trade dress”—*i.e.*, the overall image and appearance of the product and its packaging, which may include its size, shape, color, and other design elements. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 & n.1 (1992). A product’s trade dress may be federally registered as a mark in some circumstances, see USPTO, *Trademark Manual of Examining Procedure* § 1202.02 (July 2022) (citing *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209-210

¹ Section 1125(a) extends beyond trademark infringement to encompass false advertising that “misrepresents the nature, characteristics, qualities, or geographic origin of” particular goods. 15 U.S.C. 1125(a)(1)(B). That prohibition is not at issue in this case.

(2000)), and the Lanham Act provides a cause of action for infringement of registered or unregistered trade dress. 15 U.S.C. 1114, 1125(a)(3).

Since 1995, the Lanham Act has additionally “protect[ed] famous trademarks from subsequent uses that blur the distinctiveness of the mark or tarnish or disparage it, even in the absence of a likelihood of confusion.” *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 431 (2003) (quoting H.R. Rep. No. 374, 104th Cong., 1st Sess. 2 (1995)). As amended, the Act’s antidilution provision states that “the owner of a famous mark that is distinctive,” whether registered or not, is “entitled to an injunction against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.” 15 U.S.C. 1125(c)(1). The Act defines “dilution by blurring” as an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” 15 U.S.C. 1125(c)(2)(B). The Act defines “dilution by tarnishment” as an “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.” 15 U.S.C. 1125(c)(2)(C).

The Lanham Act’s antidilution provision also contains a series of “[e]xclusions” from liability. 15 U.S.C. 1125(c)(3) (emphasis omitted). The exclusions identify three categories of activities that are not “actionable as dilution” under the Act. *Ibid.* The first exclusion protects

[a]ny fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous

mark by another person other than as a designation of source for the person's own goods or services, including use in connection with—

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

15 U.S.C. 1125(c)(3)(A). The second exclusion protects “[a]ll forms of news reporting and news commentary.”

15 U.S.C. 1125(c)(3)(B). And the third exclusion protects “[a]ny noncommercial use of a mark.” 15 U.S.C. 1125(c)(3)(C).

2. a. Petitioner is a wholly owned subsidiary of the company that produces, markets, and distributes Jack Daniel's Old No. 7 Tennessee whiskey. D. Ct. Doc. 105, at 1 (Oct. 23, 2015). Petitioner owns “the trademarks and trade dress used in connection with Jack Daniel's products,” Pet. App. 46a, which it licenses back to its corporate parent and to third parties. Petitioner owns trademarks in the words “JACK DANIEL'S” and “OLD NO. 7,” both of which are federally registered. *Id.* at 47a. Petitioner also owns a federally registered trademark “for the three-dimensional configuration of a square shape bottle container,” with the words “Jack Daniel” embossed on it. *Id.* at 47a, 79a.

The trade dress for Jack Daniel's Old No. 7 Tennessee whiskey has included these marks “for many decades.” Pet. App. 47a. According to company lore, in 1866 Jack Daniel took steps to establish a Tennessee distillery, and by 1875 he was using the marks “JACK DANIEL'S” and “OLD NO. 7” to identify his brand of whiskey, which he sold in square-shaped bottles. *Ibid.*;

see J.A. 196-199. Today, the product is still sold in square-shaped bottles, bearing a black label with text including the words “JACK DANIEL’S” and “OLD NO. 7” in white font—the former in arched lettering at the top of the label and the latter, underneath, in an oval with a filigreed border. Pet. App. 116a-117a.

b. Respondent “designs, manufactures, markets, and sells chew toys for dogs.” Pet. App. 46a. Respondent’s products include a line of chewable rubber toys it calls “Silly Squeakers.” *Ibid.* (citation omitted). The “Silly Squeakers line of dog toys includes a variety of toys in the shapes of beer, wine, soda, and liquor bottles,” designed to parody well-known brands. *Id.* at 47a; see *id.* at 48a (examples).

In 2014, respondent added to the Silly Squeakers line a new toy intended “to match the bottle design for Jack Daniel’s Tennessee Sour Mash Whiskey.” Pet. App. 48a. The toy is, by design, approximately the same size, shape, and color as a 750 mL bottle of Jack Daniel’s Old No. 7 Tennessee whiskey. *Id.* at 48a-49a; see D. Ct. Doc. 15-1, at 11 (Dec. 4, 2014). The faux bottle, like the original, has a black label with stylized text in white font. At the top of the label is an image of “a wide-eyed spaniel over the words ‘Bad Spaniels’” in arched lettering. Pet. App. 48a (citation omitted). Beneath the words “Bad Spaniels,” the words “the Old No. 2” appear in an oval with a filigreed border, followed by “on your Tennessee carpet.” *Ibid.* The toy also spoofs other aspects of the label for petitioner’s whiskey, *e.g.*, by replacing the words “40% ALC. BY VOL. (80 PROOF)” at the bottom of the original with the words “43% POO BY VOL.” and “100% SMELLY.” *Ibid.*; Pet. Br. 14.

Respondent’s Bad Spaniels dog toy is packaged for sale with a piece of cardboard, known as a “hangtag,”

from which it can be hung on store shelves. See J.A. 112 (picture with hangtag). On the back of the hangtag, respondent included a disclaimer stating that “[t]his product is not affiliated with Jack Daniel Distillery.” Pet. App. 48a (citation omitted).

3. After receiving a demand letter from petitioner, respondent brought this action in the District of Arizona seeking a declaratory judgment that its Bad Spaniels dog toy “did not infringe or dilute any trademark or trade dress rights owned by” petitioner. Pet. App. 49a; see J.A. 4. Respondent’s complaint alleged that it was “the owner of all rights in its ‘Bad Spaniels’ trademark and trade dress for its durable rubber squeaky novelty dog toy.” J.A. 3; see J.A. 11, 13. Petitioner counter-claimed under the Lanham Act for infringement of its registered trademarks and trade dress and for trademark dilution by tarnishment. Pet. App. 80a. The gravamen of petitioner’s dilution claim was that its marks were likely to be tarnished by association with the scatological references—the poop jokes—on respondent’s dog toy. See *id.* at 58a.

After a bench trial, the district court entered judgment for petitioner on infringement and dilution and enjoined respondent from selling the Bad Spaniels toy. Pet. App. 45a-76a. With respect to infringement, the central issue at trial was whether petitioner had demonstrated “a ‘likelihood of confusion’ about the source of [respondent’s] product.” *Id.* at 63a. The court resolved that issue by considering various criteria, known as the *Sleekcraft* factors, that it drew from circuit precedent. *Id.* at 63a-64a; see *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979).

The district court gave particular weight to a survey conducted by petitioner’s expert witness, in which sur-

vey respondents were significantly more likely to believe that petitioner had “made, sponsored, or approved” respondent’s dog toy than if the toy were merely marked “Bad Spaniels,” without the mimicry of petitioner’s other marks and trade dress. Pet. App. 67a. The court also found that other *Sleekcraft* factors favored petitioner. *Id.* at 69a-74a. Those factors included the “defendant’s intent in selecting the mark.” *Sleekcraft*, 599 F.2d at 349. Although respondent had copied the appearance of petitioner’s trademarks and trade dress when designing the Bad Spaniels product, respondent maintained that it had done so “for the purpose of parody.” Pet. App. 69a. The district court found, however, that respondent’s “intent was to capitalize on [petitioner’s] goodwill.” *Ibid.* The court stated that a “claim of parody will be disregarded” in assessing likelihood of confusion “where the purpose of the similarity is to capitalize on a famous mark’s popularity for the defendant’s own commercial use.” *Id.* at 69a-70a.

With respect to dilution, the district court determined that petitioner’s trademarks and trade dress are “famous,” as required to invoke the Lanham Act’s anti-dilution provision. Pet. App. 52a-53a; see 15 U.S.C. 1125(c)(2)(A). The court also credited petitioner’s evidence that the parodic marks on the Bad Spaniels toy were likely to tarnish the reputation of petitioner’s famous marks by causing consumers who saw the dog toy to associate petitioner’s marks, consciously or not, with “canine excrement.” Pet. App. 59a; see *id.* at 58a-59a. Earlier, at summary judgment, the court had held that respondent could not invoke the antidilution provision’s fair-use safe harbor for parody because respondent was using “its Bad Spaniels trademark and trade dress as source identifiers of its dog toy.” *Id.* at 105a.

4. The court of appeals affirmed in part and reversed, vacated, and remanded in part. Pet. App. 22a-34a. The court described the Bad Spaniels dog toy as “an expressive work entitled to First Amendment protection,” *id.* at 25a, observing that the toy “communicates a ‘humorous message’” through word play, *id.* at 31a (citation omitted). In the court’s view, the “general likelihood-of-confusion test” under the Lanham Act “‘fails to account for the full weight of the public’s interest in free expression’” when an expressive work is at issue. *Id.* at 30a (citation omitted). The court stated that the Lanham Act “[a]ccordingly * * * only applies” to expressive works “if the plaintiff establishes * * * that the defendant’s use of the mark is either (1) ‘not artistically relevant to the underlying work’ or (2) ‘explicitly misleads consumers as to the source or content of the work.’” *Ibid.* (citation omitted). The court referred to those criteria as the “*Rogers* test,” *ibid.*, after the Second Circuit’s decision in *Rogers v. Grimaldi*, 875 F.2d 994 (1989). Because the district court had not applied the *Rogers* test, the court of appeals vacated the judgment of infringement and remanded the case to allow the district court to apply that test in the first instance. Pet. App. 33a.

The court of appeals then turned to petitioner’s claim of trademark dilution by tarnishment. Pet. App. 33a-34a. The district court had focused on the statutory exclusion from liability for parody and other fair use, 15 U.S.C. 1125(c)(3)(A), and had found that safe harbor to be inapplicable because respondent was using the marks at issue to identify the source of its own goods. See p. 8, *supra*. The court of appeals did not address the parody exclusion, concluding instead that the statutory exclusion for “noncommercial use” applied. Pet.

App. 33a (quoting 15 U.S.C. 1125(c)(3)(C)). The court acknowledged that respondent was using its parody of petitioner’s marks to sell goods in commerce. *Ibid.* In the court’s view, however, “the use of a mark may be ‘noncommercial’ even if used to ‘sell’ a product,” because “[s]peech is noncommercial ‘if it does more than propose a commercial transaction’ and contains some ‘protected expression.’” *Ibid.* (citations omitted). Based on its view that the Bad Spaniels dog toy “convey[s] a humorous message” that is “protected by the First Amendment,” the court held that respondent was “entitled to judgment in its favor” on dilution. *Ibid.*

Petitioner filed a petition for a writ of certiorari, which this Court denied. 141 S. Ct. 1054 (No. 20-365).

5. On remand, the district court entered judgment for respondent on all remaining claims. Pet. App. 3a-4a. The court observed that the *Rogers* test made it “nearly impossible” for petitioner to prevail. *Id.* at 18a; see *id.* at 5a-19a (order on remand). The court explained that the first prong of that test is met only when the alleged infringer uses a trademark “‘with *no* artistic relevance to the underlying work *whatsoever*,’” and that respondent’s use of the parodic marks here was “relevant, if not central, to [its] message.” *Id.* at 12a (citation omitted); see *id.* at 14a (explaining that respondent is “making a joke, and the joke turns on mimicking [petitioner’s] trade dress” and marks). The court also found, under the second prong of the *Rogers* test, that respondent was not explicitly misleading consumers about the source of its products. *Id.* at 15a-18a.

Petitioner appealed but invited the court of appeals to summarily affirm, so that petitioner could seek further review of issues controlled by the first panel decision. Pet. C.A. Mot. for Summ. Affirmance 1, 15. The

court of appeals granted petitioner’s motion, summarily affirmed, and denied a petition for rehearing en banc. Pet. App. 1a-2a.

SUMMARY OF ARGUMENT

I. The court of appeals erred in requiring petitioner to satisfy a special threshold test before invoking the statutory likelihood-of-confusion standard for proving trademark infringement under the Lanham Act.

A. Under the Lanham Act, a plaintiff asserting trademark infringement must prove that the defendant’s use of a mark in commerce “is likely to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. 1114(1)(a), 1125(a)(1)(A). The likelihood-of-confusion standard is the governing standard in all actions for trademark infringement under the Act. The Act does not prescribe a special test that a plaintiff must satisfy when the plaintiff asserts that a parodic use of its mark in commerce infringes the mark. As other courts of appeals have recognized, however, the parodic nature of the allegedly infringing use is properly taken into account under the flexible standards that the lower courts have developed for assessing likelihood of confusion.

At a high level of generality, this Court adopted a similar approach in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). In *Campbell*, the Court declined to adopt a special extra-statutory rule for evaluating whether a commercial parody of a copyrighted work constitutes fair use of the work under 17 U.S.C. 107. The Court instead directed that the parodic nature of the use be taken into account in applying the statutory fair-use criteria. Although the legal standard at issue in this case is different, the same general approach is warranted.

The parodic nature of an allegedly infringing use of a mark in commerce should be taken into account when applying the Lanham Act’s likelihood-of-confusion standard, but it does not justify adding to or displacing the statutory standard. In many cases, using a parody of a mark in commerce is unlikely to cause confusion and therefore is unlikely to infringe the mark. Parody depends on drawing an allusion to something familiar in order to make a joke, and the humorous contrast between a successful parody and the original will itself usually serve to distinguish the two.

The lower courts did not correctly apply the Lanham Act’s likelihood-of-confusion standard to petitioner’s infringement claims. The court of appeals did not apply that standard at all, and the district court wrongly disregarded respondent’s claim of parody. This Court should vacate the judgment below and remand for the court of appeals to review whether the likelihood-of-confusion standard is satisfied here.

B. The court of appeals erred in superimposing a special threshold test for trademark infringement in the context of “expressive works.” To the extent that the court understood its test to be required by the First Amendment, the court was mistaken. The First Amendment does not confer any right to use another person’s trademark, or a confusingly similar mark, as a source identifier for goods sold in commerce. In *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522 (1987), this Court held that Congress may in some circumstances confer exclusive rights to use a mark in commerce even without requiring a case-specific showing of likelihood of confusion. It follows *a fortiori* that Congress may proscribe using a mark in commerce when a plaintiff proves that the use

is, in fact, likely to cause confusion. The statutory likelihood-of-confusion standard thus functions as a built-in mechanism to avoid any First Amendment concerns.

It was particularly inappropriate for the Ninth Circuit to superimpose a non-statutory test drawn from the Second Circuit's decision in *Rogers v. Grimaldi*, 875 F.2d 994 (1989). That case did not involve trademark infringement. Importing the so-called *Rogers* test into this context would make the infringement analysis turn on factors, such as artistic relevance, that have no necessary connection to likelihood of confusion.

II. The court of appeals separately erred in determining that respondent's use in commerce of parodies of petitioner's marks qualifies for the statutory exclusion from trademark-dilution liability for "noncommercial use of a mark." 15 U.S.C. 1125(c)(3)(C). Respondent's use is plainly commercial because respondent is using the parodies to sell goods in commerce for profit. The Ninth Circuit's contrary conclusion cannot be reconciled with the statutory text and structure. The Lanham Act contains separate exclusions from trademark-dilution liability for certain fair uses, including parody, and for news reporting and commentary; those other exclusions would be largely superfluous if the exclusion for noncommercial use were as broad as the decision below indicates. See 15 U.S.C. 1125(c)(3)(A) and (B). The Ninth Circuit's interpretation also renders superfluous the limits that Congress imposed on the express statutory exclusion for parody.

ARGUMENT

I. THE COURT OF APPEALS ERRED IN DECLINING TO APPLY THE LANHAM ACT'S LIKELIHOOD-OF-CONFUSION STANDARD TO PETITIONER'S TRADEMARK-INFRINGEMENT CLAIMS

The court of appeals erred in requiring petitioner to satisfy a special threshold test, derived from the Second Circuit's decision in *Rogers v. Grimaldi*, 875 F.2d 994 (1989), before petitioner could invoke the Lanham Act's ordinary likelihood-of-confusion standard for proving infringement of the concededly valid trademarks and trade dress that it has long used to sell Jack Daniel's Old No. 7 Tennessee whiskey. The Ninth Circuit effectively held that, so long as respondent's use of petitioner's marks and trade dress is "artistically relevant" to the message the Bad Spaniels toy seeks to convey and respondent does not "explicitly mislead[]" consumers about the source of the toy, respondent cannot be held liable for infringement under the Act, regardless of the likelihood that consumers will wrongly believe that petitioner is the source of respondent's products. Pet. App. 30a (citation omitted).

Those threshold requirements for proving trademark or trade-dress infringement do not appear in the Lanham Act, and the court of appeals had no warrant to add them. Nor did the First Amendment require the court to superimpose the *Rogers* test in this context. Petitioner's infringement claims should be analyzed under the statutory likelihood-of-confusion standard, which is flexible enough to accommodate the distinct considerations that may arise in cases of trademark and trade-dress parody.

A. The Lanham Act’s Likelihood-Of-Confusion Standard Governs The Determination Whether Parodic Use Of A Trademark In Commerce Infringes The Mark

1. As explained above (at pp. 2-3), trademarks have traditionally received legal protection in order to further their core function of identifying the source of goods in the marketplace. See, *e.g.*, *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015) (“The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan’s goods from those of others.”); *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 212 (2000) (explaining that the “predominant function” of trademarks and trade dress is “source identification”). That is why “the test of likelihood of confusion is the keystone of trademark infringement.” 4 *McCarthy* § 23:1, at 23-9. Under the Lanham Act, a plaintiff asserting trademark infringement must prove that the defendant’s use of a mark in commerce “is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of [the defendant] with another person, or as to the origin, sponsorship, or approval of [the defendant’s] goods, services, or commercial activities by another person.” 15 U.S.C. 1125(a)(1)(A) (unregistered marks); see 15 U.S.C. 1114(1)(a) (registered marks).

This Court has never definitively construed the Lanham Act’s likelihood-of-confusion standard. In *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir.) (Friendly, J.), cert. denied, 368 U.S. 820 (1961), the Second Circuit identified a non-exhaustive list of “variables” or factors that may bear on a Lanham Act plaintiff’s “chance of success” in proving a likelihood of confusion, *id.* at 495, based in part on the considerations set

forth in the Restatement (First) of Torts §§ 729-731 (1938). That approach proved to be influential. All of the courts of appeals and the USPTO now employ overlapping lists of likelihood-of-confusion factors, designed to assess the similarity of the marks and other relevant circumstances. See 4 *McCarthy* §§ 24:30-24:43 (circuit tests); *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (likelihood-of-confusion factors considered in USPTO registration proceedings).

To assess likelihood of confusion, the Ninth Circuit generally considers a set of factors first identified in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979). Under that approach, a court should consider:

the strength of the plaintiff’s mark; the proximity or relatedness of the goods; the similarity of the parties’ marks; evidence of actual confusion; marketing channels used; the type of goods and degree of care likely to be exercised by the buyer; the [alleged infringer’s] intent in adopting the junior mark; and likelihood of expansion of the parties’ product lines.

Pet. App. 63a (citing *Sleekcraft*, 599 F.2d at 348). The Ninth Circuit has emphasized that this list is “not exhaustive,” *Sleekcraft*, 599 F.2d at 348 n.11; that the factors “must be applied in a flexible fashion,” *Rearden LLC v. Rearden Commerce, Inc.*, 683 F.3d 1190, 1209 (2012); and that “the relative importance of each individual factor will be case-specific,” *Brookfield Commc’ns, Inc. v. West Coast Entm’t Corp.*, 174 F.3d 1036, 1054 (1999).

2. The likelihood-of-confusion standard applies to all trademark-infringement claims brought under the Lanham Act. 15 U.S.C. 1114(1)(a) (“likely to cause confusion, or to cause mistake, or to deceive”); 15 U.S.C. 1125(a)(1)(A) (same). The Act does not suggest that a

different infringement standard applies when the defendant uses another's mark for parodic purposes or to "communicate[] a 'humorous message.'" Pet. App. 31a (citation omitted). With respect to trademark-*dilution* claims (for which likelihood of consumer confusion is not a necessary element), Congress has established special rules for uses that "parody[]" a "famous mark owner or the goods or services of the famous mark owner." 15 U.S.C. 1125(c)(3)(A)(ii); see pp. 29-30, *infra*. But the trademark-*infringement* provisions codified at 15 U.S.C. 1114(1)(a) and 1125(a)(1)(A) contain no similar language. The court of appeals erred in superimposing a non-statutory threshold test here.

Rather than adding to the Lanham Act, a court considering a trademark-infringement claim involving a parody should simply bear in mind the nature and purpose of parody when applying the statutory likelihood-of-confusion standard. A court may appropriately take into account the parodic nature of an allegedly infringing use when applying the flexible, multi-factor tests that all circuits use to assess likelihood of confusion. See, e.g., *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007) (stating that parody "influences the way in which the [likelihood-of-confusion] factors are applied"); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 199 (5th Cir. 1998) (stating that "parody is relevant to a determination of a likelihood of confusion and can even weigh heavily enough" to be dispositive); *Nike, Inc. v. "Just Did It" Enters.*, 6 F.3d 1225, 1228 (7th Cir. 1993) (stating that parody can be "an additional factor in the analysis" and that a successful parody aims to leave consumers "not * * * confused, but amused").

In analyzing potential *copyright* infringement in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994), this Court steered a middle course, declining either to adopt a special test for parody or to ignore the parodic character of an allegedly infringing use. In *Campbell*, the hip-hop group 2 Live Crew recorded and commercially released a parody of the song “Oh, Pretty Woman,” which had been co-written decades earlier by Roy Orbison. *Id.* at 572. The holder of the copyright in the Orbison song sued for infringement under the Copyright Act of 1976, 17 U.S.C. 101 *et seq.*, and this Court ultimately granted review to consider “whether 2 Live Crew’s commercial parody could be a fair use” under that Act of the original copyrighted work. *Campbell*, 510 U.S. at 574; see 17 U.S.C. 107 (fair-use provision).

The *Campbell* Court explained that a parody is a “literary or artistic work that imitates the characteristic style of an author or a work for comic effect or ridicule.” 510 U.S. at 580 (quoting *The American Heritage Dictionary of the English Language* 1317 (3d ed. 1992)). The Court further explained that, because any humor or social commentary a parody may convey “springs from recognizable allusion to” the object of the parody, a successful parodist “must be able to ‘conjure up’ at least enough of that original to make the object of its critical wit recognizable.” *Id.* at 588 (citation omitted). But while the Court recognized that the parodic character of an allegedly infringing use may be relevant to the ultimate determination whether that use is fair, it disclaimed any suggestion that fair-use analysis of parodies under the Copyright Act is governed by a special extra-statutory rule. Rather, the Court cautioned that “parody, like any other use, has to work its way through the relevant factors, and be judged case by case, in light

of the ends of the copyright law.” *Id.* at 581. The Court explained in some detail how the parodic nature of 2 Live Crew’s song was potentially relevant in applying the first (*id.* at 578-581), third (*id.* at 586-589), and fourth (*id.* at 590-594) of the fair-use factors enumerated in 17 U.S.C. 107.

The ultimate determination whether a particular parodic use is infringing is governed by different rules in the trademark context than under copyright law. Compare 15 U.S.C. 1114(1)(a), 1125(a)(1)(A), with 17 U.S.C. 107. But the text of the relevant Lanham Act provisions equally supports the same general middle-ground approach that the Court took in *Campbell*. As with 17 U.S.C. 107, nothing in the text of those Lanham Act provisions suggests that parodies are governed by a distinct infringement test. But as with 17 U.S.C. 107, the parodic character of an allegedly infringing use of a trademark may be logically relevant to the application of the governing statutory standard—here, whether that use “is likely to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. 1114(1)(a), 1125(a)(1)(A).

In the mine run of cases, a successful trademark or trade-dress parody is unlikely to cause confusion and therefore is unlikely to infringe the mark. Indeed, a successful parody “depends on a lack of confusion to make its point.” *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 503 (2d Cir. 1996). Consumers are unlikely to get the joke if they believe that the parodist’s products come from the same source as the goods bearing the mark being parodied. The comic effect of a parody often arises precisely because the idea that the entity being mocked would have created or sponsored the parody is risible, which tends to dispel any potential consumer confusion about the source of

the products at issue. See, *e.g.*, 6 *McCarthy* § 31:153, at 31-440 (“If the difference in wording or appearance of the accused use together with the context and overall setting is such as to convey to the ordinary viewer that this is a joke, not the real thing, then confusion as to source, sponsorship, affiliation, or connection is unlikely.”).

The Fourth Circuit’s decision in *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, *supra*, is illustrative. That case, like this one, concerned a dog toy designed to parody well-known trademarks and trade dress—there, a “Chewy Vuitton” toy designed to resemble a miniature Louis Vuitton handbag, complete with parodies of Louis Vuitton’s registered trademarks. 507 F.3d at 257-258. The district court granted summary judgment to the parodist on likelihood of confusion, and the court of appeals affirmed. *Id.* at 258, 270.

The Fourth Circuit correctly recognized that parody can “alter[] the likelihood-of-confusion analysis.” *Louis Vuitton*, 507 F.3d at 261. The court observed that some factors that might ordinarily “be a problem for” the dog-toy manufacturer, *id.* at 262, such as the similarity of the marks, would not carry significant weight where a parodic use is involved. Ordinarily, similarity and likelihood of confusion go hand in hand: the more similar two marks are, the greater the likelihood that consumers will infer that products bearing them come from the same source. The *Louis Vuitton* court correctly explained, however, that such an inference was unlikely where the dog-toy manufacturer was invoking “a famous mark in the consumer’s mind” in order to make a joke. *Ibid.* Likewise, the court appropriately discounted the manufacturer’s “intent to profit from its use of parodies,” observing that the manufacturer

lacked any intent “to create consumer confusion” and indeed intended just the opposite, *i.e.*, “to evoke a humorous, satirical association that *distinguishes* the products.” *Id.* at 263.

3. In this case, neither of the courts below correctly applied the Lanham Act’s likelihood-of-confusion standard. The court of appeals did not apply that standard at all, concluding that likelihood of confusion was irrelevant unless petitioner first satisfied the *Rogers* test. Pet. App. 32a-33a & n.2; see pp. 23-28, *infra*. The district court applied the likelihood-of-confusion factors identified in circuit precedent, but it concluded that respondent’s “claim of parody” must be “disregarded” under the intent factor because respondent intended “to capitalize on Jack Daniel’s popularity and good will.” Pet. App. 69a-70a. And under the similarity-of-the-marks factor, the court recognized that a parody must “conjure up the original” in order to achieve its intended effect, *id.* at 70a (citation omitted), but it gave no apparent weight to that point in finding that the similarity factor favored petitioner, see *id.* at 70a-71a.

The district court erred in both respects. When assessing likelihood of confusion in a case like this one, a court should bear in mind that a degree of resemblance to the original mark or trade dress is essential for a parody to be recognizable as such. Cf. *Campbell*, 510 U.S. at 588. But the parodist usually intends to draw a humorous allusion that itself serves to distinguish the parody from the original. Thus, the fact that the parodist intended its mark to be similar to the original ordinarily should bear little weight in the analysis. “An intent to parody” the original for comic effect should not be confused with “an intent to confuse the public.” *Jordache*

Enters., Inc. v. Hogg Wyld, Ltd., 828 F.2d 1482, 1486 (10th Cir. 1987).

A claim of parody also should not be “disregarded” (Pet. App. 69a) merely because the parodist is trying to profit from making fun of a well-known mark. The district court appeared to believe (see *id.* at 69a-70a) that respondent is engaged in improper freeriding on petitioner’s accumulated goodwill in its Jack Daniel’s marks and trade dress. But because parody depends for its desired effect on recognizable similarity to a familiar original, parodists naturally tend to choose, as the objects of their mockery, original works or products that are well known. In that sense most commercial parodists seek to profit from the goodwill (or at least the fame or notoriety) that others have accumulated. There is nothing illicit about that endeavor.

Under the Lanham Act, likelihood of confusion is an essential element of a trademark-infringement claim. (The Act’s antidilution provision, by contrast, provides significant protections to owners of famous marks even when consumer confusion is unlikely.) Using a mark or trade dress that is likely to confuse consumers is a forbidden *way* of profiting from another’s goodwill, but the Lanham Act’s prohibitions against trademark infringement do not ban freeriding per se. The district court therefore should have assessed whether the parodic character of respondent’s dog toy reduced the likelihood of consumer confusion as to its source.

Consistent with its ordinary practice, this Court should vacate the judgment of non-infringement and remand this case to the court of appeals for that court to review, in the first instance, the district court’s finding of a likelihood of confusion under the correct legal standard. Cf. *Cutter v. Wilkinson*, 544 U.S. 709, 718 n.7

(2005) (observing that this Court is generally “a court of review, not of first view”).

B. First Amendment Concerns Do Not Justify Displacing The Lanham Act’s Likelihood-of-Confusion Standard When The Alleged Infringement Occurs Within The Context Of An “Expressive Work”

The court of appeals held that, in order to establish trademark infringement under the Lanham Act, petitioner was required to satisfy a special threshold test in addition to proving likelihood of confusion. The court did not purport to derive that test from the Act itself, instead describing it as necessary to protect “the public’s interest in free expression.” Pet. App. 30a (citation omitted); see *id.* at 29a (referring to a “First Amendment [d]efense”) (emphasis omitted); cf. *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 261 (9th Cir. 2018) (stating that the Lanham Act’s infringement provisions “apply to expressive works” only if the *Rogers* test is satisfied). To the extent that the court of appeals understood its threshold test to be required by the First Amendment, the court was mistaken. The Lanham Act’s likelihood-of-confusion standard already accounts for First Amendment interests, and superimposing the *Rogers* test—plucked from a materially different context—is particularly unwarranted.

1. The First Amendment does not confer any right to use another person’s trademark, or a confusingly similar mark, as a source identifier for goods sold in commerce. Indeed, the absence of any such right is a basic animating premise of trademark-infringement law. If such a right existed, States and the federal government might lack authority to prohibit trademark infringement. Yet such prohibitions have “ancient origins,” predating the adoption of the First Amendment

and coexisting with it for many years. *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017); see *Trade-Mark Cases*, 100 U.S. 82, 92 (1879) (observing that “[t]he right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has long been recognized by the common law and the chancery courts of England”). To the extent that using a confusingly similar mark as a source identifier in commerce constitutes “speech,” U.S. Const. Amend. I, history and tradition demonstrate that Congress may regulate that speech without offending the First Amendment. Cf. *United States v. Stevens*, 559 U.S. 460, 468 (2010) (explaining that certain “historic and traditional categories” of speech enjoy no First Amendment protection) (citation omitted).

This Court confirmed as much in *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522 (1987) (*SFAA*). That case involved a federal statute that gave the U.S. Olympic Committee—a private corporation established by federal law—certain exclusive rights to use the word “Olympic” for the purpose of trade or to promote athletic performances. *Id.* at 528. The Committee sought an injunction against use of the word “Olympic” by a nonprofit group (the SFAA), to promote what the group called the “Gay Olympic Games.” *Id.* at 525 (citations omitted); see *id.* at 527. The SFAA contended that the statute should be construed to apply only to uses of the word “Olympic” that were likely to cause confusion and that, absent such a limiting construction, the statute would violate the First Amendment. See *id.* at 528-529, 532.

This Court rejected both contentions. The Court explained that, insofar as the statute regulated use of the

word “Olympic” as a mark in commerce, “its application is to commercial speech” that receives only “‘limited * * * First Amendment protection.’” *SFAA*, 483 U.S. at 535 (citation omitted); see *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557, 562-563 (1980); *Friedman v. Rogers*, 440 U.S. 1, 11-16 (1979). The Court also observed that, “[t]o the extent that [the statute] regulates confusing uses, it is within normal trademark bounds,” because “[t]he Government constitutionally may regulate ‘deceptive or misleading’ commercial speech.” *SFAA*, 483 U.S. at 535 n.12 (citations omitted). But the Court also made clear that the statute was constitutional even as applied to uses that were “not confusing,” *id.* at 539, and even as applied to “[t]he SFAA’s expressive use of the word,” *id.* at 541, to convey a message about “the status of homosexuals in society,” *id.* at 535. The Court explained that “[t]he mere fact that the SFAA claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to ‘appropriate to itself the harvest of those who have sown.’” *Id.* at 541 (brackets and citation omitted).

It follows *a fortiori* that Congress may proscribe unauthorized uses in commerce of trademarks or trade dress where the plaintiff *does* make a case-specific showing of likely consumer confusion about the source of the defendant’s goods or the plaintiff’s association with them, 15 U.S.C. 1114(1)(a), 1125(a)(1)(A), even when the defendant’s infringing conduct has an expressive component. Put differently, the Lanham Act accommodates any potential First Amendment concerns by limiting the scope of actionable infringement to unauthorized uses of a mark that satisfy the likelihood-of-confusion standard. And “[i]t is well settled * * * that

to the extent a trademark is confusing or misleading the law can protect consumers and trademark owners.” *Tam*, 137 S. Ct. at 1768 (opinion of Kennedy, J.); see, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996) (describing the likelihood-of-confusion standard as one of the Lanham Act’s “built-in mechanisms * * * to avoid First Amendment concerns”).

2. Even apart from the impropriety of superimposing *any* extra-statutory prerequisites to infringement liability, the Ninth Circuit’s adoption of the *Rogers* test was a particularly inappropriate choice. *Rogers* was decided under a predecessor version of the Lanham Act; that case did not involve a trademark-infringement claim; and the *Rogers* court emphasized the distinct concerns associated with the imposition of liability for *titles* of expressive works. By treating that test as applicable to all Lanham Act cases involving allegedly infringing “expressive works,” Pet. App. 30a, the Ninth Circuit has made it “nearly impossible for any trademark holder to prevail” in a broad category of infringement suits, *id.* at 18a (district court’s opinion on remand).

In *Rogers*, the defendants had produced and distributed a film by Federico Fellini, entitled “‘Ginger and Fred,’” about “two fictional Italian cabaret performers, Pippo and Amelia, who, in their heyday, imitated” the famed American duo Ginger Rogers and Fred Astaire. 875 F.2d at 996-997. When the film was released in the United States, Ginger Rogers sued. *Id.* at 997. Rogers invoked the Lanham Act (and state law), but she did not allege that the defendants had infringed any trademark. *Ibid.* She contended instead that the title of the film constituted false advertising by creating a false im-

pression either that she had endorsed the film or that it was about her. See *id.* at 1000-1001. The Lanham Act provision that Rogers invoked, as in effect when she sued, prohibited using “any false description or representation” in connection with goods or services in commerce. 15 U.S.C. 1125(a) (1982) (quoted in *Rogers*, 875 F.2d at 997).² That version of Section 1125(a) did not explicitly refer to likelihood of confusion.³ The Second Circuit thus had no occasion in *Rogers* to apply the likelihood-of-confusion standard that appears in the current Lanham Act provisions addressing trademark infringement.

The *Rogers* court explained that the title of a film “may be both an integral element of the film-maker’s expression as well as a significant means of marketing the film to the public.” 875 F.2d at 998. The court perceived a need to construe the Lanham Act’s false-advertising provision “narrowly” in the “area of titles” of artistic works so as not to “intrude on First Amendment values.” *Ibid.* The court emphasized that “[f]ilm-makers and authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works.” *Ibid.*

² Cf. 15 U.S.C. 1125(a)(1) (current prohibition on using in commerce a “false or misleading description of fact, or false or misleading representation of fact”).

³ The Lanham Act was not amended to provide an express cause of action for infringement of an unregistered mark until after *Rogers* sued, see Trademark Law Revision Act of 1988 (1988 Act), Pub. L. No. 100-667, § 132, 102 Stat. 3946, although the Act had been construed before then to authorize such actions under theories of false designation of origin or false representation, see S. Rep. No. 515, 100th Cong., 2d Sess. 40 (1988). The 1988 Act also added to Section 1125(a) the likelihood-of-confusion language that has been carried forward to the current version. See 1988 Act § 132, 102 Stat. 3946; 15 U.S.C. 1125(a)(1) (1988); 15 U.S.C. 1125(a)(1)(A).

(Imagine a claim that the title *Chariots of Fire* is a “false or misleading representation of fact,” 15 U.S.C. 1125(a)(1), because the film does not actually depict chariots.) The court therefore construed the Act not to reach an “allegedly misleading title[] using a celebrity’s name * * * 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.” 875 F.2d at 999.

Whatever the merits of that approach as applied in *Rogers* itself, the Ninth Circuit erred in adopting it as a threshold requirement for proving trademark and trade dress infringement in all cases involving purportedly “expressive work[s].” Pet. App. 25a.⁴ That approach wrongly makes infringement liability turn on factors, such as artistic relevance, that have no necessary connection to likelihood of confusion—the standard prescribed by the statute. To the extent that using the marks to identify goods in commerce is viewed as a form of speech, the First Amendment permits the regulation of such speech when the Act’s likelihood-of-confusion standard is satisfied. See pp. 23-26, *supra*.

⁴ Indeed, the *Rogers* court appeared to discountenance any suggestion that its test applied beyond titles of artistic works. The court noted that consumers “do not regard titles of artistic works in the same way as the names of ordinary commercial products,” 875 F.2d at 1000, which consumers expect to contain literally accurate descriptions of the merchandise, see *ibid.* (“[C]onsumers expect an ordinary product to be what the name says it is.”).

**II. THE COURT OF APPEALS ERRED IN HOLDING THAT
RESPONDENT IS SHIELDED FROM LIABILITY FOR
TRADEMARK DILUTION UNDER THE STATUTORY
EXCLUSION FOR NONCOMMERCIAL USE**

The court of appeals separately erred in holding (see Pet. App. 33a-34a) that respondent's parodies of petitioner's marks are excluded from trademark-dilution liability as "noncommercial use of a mark." 15 U.S.C. 1125(c)(3)(C). Respondent's use of the parodied marks to sell goods for profit is plainly commercial.

The Lanham Act's antidilution provision permits the owner of a "famous mark that is distinctive" to obtain an injunction against another person whose use of a mark in commerce is likely to cause "dilution by tarnishment of the famous mark." 15 U.S.C. 1125(c)(1). Dilution by tarnishment occurs when the defendant's use of a mark creates an "association arising from the similarity between [the] mark * * * and a famous mark that harms the reputation of the famous mark." 15 U.S.C. 1125(c)(2)(C). For example, the owner of a famous mark could bring a dilution-by-tarnishment claim against a person who uses a similar mark in an obscene commercial film—*e.g.*, to create a sense of verisimilitude—on the theory that using the similar mark is likely to harm the famous mark's reputation by producing an association in viewers' minds between the famous mark and the objectionable content of the film. See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 467 F. Supp. 366, 372 (S.D.N.Y.) (state-law dilution claim), *aff'd*, 604 F.2d 200 (2d Cir. 1979).

Under the Lanham Act, proof of likely confusion about source or association is not an element of a trademark-dilution claim. See 15 U.S.C. 1125(c)(1) (authorizing relief "regardless of the presence or absence

of actual or likely confusion”). The Act’s antidilution provision thus lacks one of the safeguards that ensure that trademark-infringement liability comports with the First Amendment. In 1996, when Congress added the antidilution provision to the Act, it included a set of exclusions from liability that were intended to provide an alternate way of avoiding First Amendment concerns. See Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, § 3(a), 109 Stat. 985; *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 431 (2003) (recounting history). Congress expanded those exclusions in 2006, including by adopting language that expressly addresses parodies. See Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, § 2, 120 Stat. 1731; H.R. Rep. No. 23, 109th Cong., 1st Sess. 25 (2005).

As amended, the Lanham Act excludes from dilution liability three categories of uses. 15 U.S.C. 1125(c)(3). The first exclusion encompasses “[a]ny fair use” of a mark, “other than as a designation of source for the [defendant’s] own goods or services,” including any fair use in connection with “identifying and *parodying*, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.” 15 U.S.C. 1125(c)(3)(A)(ii) (emphasis added). The second exclusion encompasses “[a]ll forms of news reporting and news commentary.” 15 U.S.C. 1125(c)(3)(B). And the third exclusion encompasses “any noncommercial use of a mark.” 15 U.S.C. 1125(c)(3)(C).

Respondent’s use does not fall within that third exclusion. Respondent is using the marks that are accused of causing dilution by tarnishment—for example, the words “the Old No. 2”—to sell dog toys in commerce for profit. That is a commercial use. See, e.g., *The American Heritage Dictionary of the English Lan-*

guage 371 (4th ed. 2006) (defining “commercial” to mean “[o]f or relating to commerce,” or “[h]aving profit as a chief aim”) (emphasis omitted); cf. *Campbell*, 510 U.S. at 573, 584 (treating “the commercial nature of [2 Live Crew’s] parody” as established when the hip-hop group sold recordings of the parody).⁵

The court of appeals did not consider the ordinary meaning of the statutory language. The court instead found the “noncommercial use” exclusion applicable on the theory that “[s]peech is noncommercial ‘if it does more than propose a commercial transaction’ and contains ‘some protected expression.’” Pet. App. 33a (citations omitted). On that view—which the court had adopted in a prior case based largely on its reading of the legislative history, see *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905-906 (9th Cir. 2002), cert. denied, 537 U.S. 1171 (2003)—any use of a mark that conveys an expressive message would be “noncommercial,” even when the mark is being used to sell goods for profit.

That interpretation is unsound. It renders the anti-dilution provision’s first two exclusions largely superfluous and thus violates the principle that courts should “normally seek to construe Congress’s work ‘so that effect is given to all provisions, so that no part will be inoperative or superfluous.’” *Ysleta del Sur Pueblo v. Texas*, 142 S. Ct. 1929, 1939 (2022) (quoting *Corley v. United States*, 556 U.S. 303, 314 (2009)). Most if not all “news reporting and news commentary” contains some expressive content protected by the First Amendment.

⁵ The Copyright Act identifies “the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes,” as a factor relevant to the determination whether a particular use of copyrighted expression is fair. 17 U.S.C. 107(1).

15 U.S.C. 1125(c)(3)(B). If that were enough to trigger the noncommercial-use exclusion, a separate exclusion for news reporting and commentary would be unnecessary. See *ibid.* The express protections for “parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner,” 15 U.S.C. 1125(c)(3)(A)(ii), likewise would be superfluous if those activities are categorically noncommercial, as the decision below suggests.

In the specific context of parody, moreover, the court of appeals’ expansive view of noncommercial use effectively negates the *limits* Congress placed on the fair-use exclusion. That exclusion provides a safe harbor from dilution liability if the defendant is “parodying * * * the famous mark.” 15 U.S.C. 1125(c)(3)(A)(ii). But the fair-use exclusion does not apply when the accused dilutor is using the mark at issue “as a designation of source for the person’s own goods or services.” 15 U.S.C. 1125(c)(3)(A). Thus, a person’s sale of goods in commerce using a parody of a famous mark will not subject her to dilution liability, *so long as* the parody is not itself being used to designate the source of the products (*i.e.*, as a trademark).

The court of appeals’ interpretation renders that limitation nugatory, as this case illustrates. The district court found that respondent could not invoke the fair-use exclusion for parody because respondent was using the accused marks to identify the source of its own products. Pet. App. 105a. The court of appeals did not dispute that finding, which was premised on express allegations in respondent’s own complaint. See J.A. 3, 11, 13. The court instead construed the noncommercial-use exclusion to cover respondent’s use of parodies of petitioner’s marks, without regard to whether respondent

was using the parodies as source identifiers. Pet. App. 33a-34a. Although the three exclusions might overlap, the usual rule in statutory construction is that “the specific governs the general.” *RadLAX Gateway Hotel, LLC v. Amalgamated Bank*, 566 U.S. 639, 645 (2012) (citation omitted). More general neighboring language should not be construed to negate the limit that Congress placed on a specific exclusion for parody.

This Court should vacate the judgment entered below on dilution liability and remand for further proceedings. Respondent argued in the court of appeals that its parodies of petitioner’s marks and trade dress are not actually being used as “a designation of [the] source” of the Bad Spaniels toy, 15 U.S.C. 1125(c)(3)(A), and that the district court therefore erred in finding the parody exclusion inapplicable. See 18-16012 Resp. C.A. Br. 51-52. On remand, the court of appeals may address whether respondent has adequately preserved that argument and, if so, whether it has merit.

CONCLUSION

The judgment of the court of appeals should be vacated, and the case should be remanded for further proceedings.

Respectfully submitted.

THOMAS W. KRAUSE
Solicitor
 CHRISTINA J. HIEBER
*Senior Counsel for Trade-
 mark Policy and Litigation*
 THOMAS L. CASAGRANDE
 MARY BETH WALKER
 BENJAMIN T. HICKMAN
Associate Solicitors
*United States Patent and
 Trademark Office*

ELIZABETH B. PRELOGAR
Solicitor General
 BRIAN M. BOYNTON
*Principal Deputy Assistant
 Attorney General*
 MALCOLM L. STEWART
Deputy Solicitor General
 MATTHEW GUARNIERI
*Assistant to the Solicitor
 General*
 DANIEL TENNY
 CATHERINE PADHI
Attorneys

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APPENDIX

TABLE OF CONTENTS

	Page
Statutory provisions:	
15 U.S.C. 1114(1)	1a
15 U.S.C. 1125	2a
15 U.S.C. 1125 (1982)	13a

1. 15 U.S.C. 1114(1) provides:

Remedies; infringement; innocent infringement by printers and publishers

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive;

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

As used in this paragraph, the term “any person” includes the United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, or other persons acting for the United States and with the authorization and consent of the United States, and any

(1a)

State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

2. 15 U.S.C. 1125 provides:

False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term “any person” includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

(b) Importation

Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this chapter in cases involving goods refused entry or seized.

(c) Dilution by blurring; dilution by tarnishment

(1) Injunctive relief

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner’s mark has become famous, commences

use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

(2) Definitions

(A) For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

(i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

(ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.

(iii) The extent of actual recognition of the mark.

(iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(B) For purposes of paragraph (1), "dilution by blurring" is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is

likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

(C) For purposes of paragraph (1), “dilution by tarnishment” is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) Exclusions

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

- (A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with—

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

(4) Burden of proof

In a civil action for trade dress dilution under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that—

(A) the claimed trade dress, taken as a whole, is not functional and is famous; and

(B) if the claimed trade dress includes any mark or marks registered on the principal register, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such registered marks.

(5) Additional remedies

In an action brought under this subsection, the owner of the famous mark shall be entitled to injunctive relief as set forth in section 1116 of this title. The owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity if—

(A) the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment was first used in commerce by the person against whom the injunction is sought after October 6, 2006; and

(B) in a claim arising under this subsection—

(i) by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to trade on the recognition of the famous mark; or

(ii) by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark.

(6) Ownership of valid registration a complete bar to action

The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register under this chapter shall be a complete bar to an action against that person, with respect to that mark, that—

(A) is brought by another person under the common law or a statute of a State; and

(B)(i) seeks to prevent dilution by blurring or dilution by tarnishment; or

(ii) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.

(7) Savings clause

Nothing in this subsection shall be construed to impair, modify, or supersede the applicability of the patent laws of the United States.

(d) Cyberpiracy prevention

(1)(A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person—

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

(ii) registers, traffics in, or uses a domain name that—

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of title 18 or section 220506 of title 36.

(B)(i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to—

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are

identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c).

(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

(C) In any civil action involving the registration, trafficking, or use of a domain name under this paragraph, a court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

(D) A person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant's authorized licensee.

(E) As used in this paragraph, the term "traffics in" refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

(2)(A) The owner of a mark may file an in rem civil action against a domain name in the judicial district in

which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located if—

(i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office, or protected under subsection (a) or (c); and

(ii) the court finds that the owner—

(I) is not able to obtain in personam jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or

(II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by—

(aa) sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and

(bb) publishing notice of the action as the court may direct promptly after filing the action.

(B) The actions under subparagraph (A)(ii) shall constitute service of process.

(C) In an in rem action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which—

(i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or

(ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.

(D)(i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark. Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in a United States district court under this paragraph, the domain name registrar, domain name registry, or other domain name authority shall—

(I) expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court; and

(II) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.

(ii) The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.

(3) The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.

(4) The in rem jurisdiction established under paragraph (2) shall be in addition to any other jurisdiction that otherwise exists, whether in rem or in personam.

3. 15 U.S.C. 1125 (1982) provided:

False designations of origin and false descriptions forbidden

(a) Civil action

Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.

(b) Importation

Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal

14a

that is given under the customs revenue laws or may have the remedy given by this chapter in cases involving goods refused entry or seized.