

IN THE
United States Court of Appeals

FOR THE NINTH CIRCUIT

Case No. 23-3768

LANCE HARA, P/K/A VICKY VOX,
Plaintiff-Appellant,

v.

NETFLIX, INC.; TITMOUSE, INC.; LOL SEND, INC.; GABE LIEDMAN;
FREMULON, LLC; MICHAEL SCHUR; UNIVERSAL TELEVISION, LLC;
HAZY MILLS PRODUCTIONS, INC.; SEAN HAYES; TODD MILLINER; BEN
HEINS; 3 ARTS ENTERTAINMENT, LLC; DAVID MINER; AND MAX
SILVESTRI,
Defendants-Appellees.

Appeal from the United States District Court
for the Central District of California
Case No. 2:23-cv-03456-RGK-AS
Hon. R. Gary Klausner

**BRIEF OF THE MOTION PICTURE ASSOCIATION, INC.
AS *AMICUS CURIAE* IN SUPPORT OF
DEFENDANTS-APPELLEES AND AFFIRMANCE**

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CORPORATE DISCLOSURE STATEMENT

The Motion Picture Association, Inc. (“MPA”) is a not-for-profit trade association. The MPA’s members are Netflix Studios, LLC,ⁱ Paramount Pictures Corporation, Sony Pictures Entertainment Inc., Universal City Studios LLC,ⁱⁱ Walt Disney Studios Motion Pictures, and Warner Bros. Entertainment Inc. The MPA does not have any parent companies, and no publicly held company owns 10% or more of the MPA.

Dated: May 22, 2024

Respectfully submitted,

JENNER & BLOCK LLP

/s/ Susan J. Kohlmann

Susan J. Kohlmann

ⁱ Defendant-Appellee Netflix, Inc. is the parent company of MPA member Netflix Studios, LLC.

ⁱⁱ Defendant-Appellee Universal Television LLC and MPA member Universal City Studios LLC are both indirect subsidiaries of Comcast Corporation.

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All parties consent to the filing of this amicus brief.¹

STATEMENT OF INTEREST

Amicus curiae the Motion Picture Association, Inc. (“MPA”) is a not-for-profit trade association founded in 1922. The MPA serves as the voice and advocate of the film and television industry, advancing the business and art of storytelling, protecting the creative and artistic freedoms of storytellers, and supporting the creative ecosystem that brings entertainment and inspiration to audiences worldwide. The MPA’s member companies and their affiliates produce and distribute the vast majority of filmed entertainment in the United States through the theatrical and home entertainment markets. Indeed, the MPA’s members create thousands of films and television shows that entertain, educate, and inform the public. The MPA’s members also own and enforce their rights in some of the most valuable trademarks in the world. The MPA is thus uniquely positioned to provide this Court with a well-informed perspective on the balance between protecting free expression and preventing consumer confusion.

¹ Pursuant to Federal Rule of Appellate Procedure 29(a)(4)(E), the MPA states: no party or party’s counsel authored this brief in whole or in part; no party or party’s counsel contributed money to fund the preparation or submission of this brief; and no other person except the MPA and its members (*excluding* MPA members Netflix Studios, LLC, Universal City Studios LLC, or any of their affiliates) contributed money intended to fund the preparation or submission of this brief.

The creative works produced and distributed by MPA members often depict trademarks for many reasons—such as to create a realistic or fanciful setting, to cast the mark in a creative new light, or to comment on it directly. In its seminal *Rogers v. Grimaldi* decision in 1989, the Second Circuit recognized that the First Amendment protects artistic works (such as the film and television shows created by MPA members), and that, because those works are speech in and of themselves, audience members engage with them differently than consumers interact with consumer products. Rather than applying the standard likelihood-of-confusion test for Lanham Act liability, the court in *Rogers* applied a more speech-protective test because the claims involved an artistic work. For more than twenty years, this Circuit has embraced the *Rogers* framework and has developed an established jurisprudence addressing Lanham Act and related claims involving artistic works.

MPA members often “clear” works—*i.e.*, subject the content of their films and television shows to legal vetting before release—in part on the understanding that the *Rogers* test will govern potential trademark claims involving those works. *Rogers*’ longstanding applicability to the content of films and television shows simplifies the legal analysis about whether to approve aspects of creative works, and promotes rather than chills the creation of those works. Although depictions of trademarks within creative works may also be subject to additional meritorious defenses, *Rogers* and its progeny provide important clarity for the MPA’s members

and permit them to depict trademarks and brands in their creative works without being stymied by the threat of a torrent of unfounded litigation.

Last year, the Supreme Court had the opportunity to consider *Rogers* for the first time in *Jack Daniel's Properties, Inc. v. VIP Products LLC*. That trademark dispute involved Jack Daniel's whiskey and a parody dog toy—two quintessential consumer products—and thus did not implicate the creative works at the heartland of the *Rogers* doctrine, such as films and television shows. The Court thus explicitly preserved existing case law from lower courts applying *Rogers* in favor of a narrower holding: that *Rogers* does not apply when a mark is being used “as a mark,” meaning as a designation of source for the defendant's goods or services.

This case will be the first time following the *Jack Daniel's* decision that this Court reviews a district court's application of the *Rogers* standard to the alleged depiction of a mark in the body of a creative work. The question before the Court is whether the alleged depiction of a person's likeness in an episode of an animated television show (and a trailer and still image depicting the episode) constitutes use of that likeness “as a mark” under *Jack Daniel's*, such that *Rogers* does not apply. If this Court does not apply *Rogers* here, it will cause a sea change in this Court's established jurisprudence addressing the use of trademarks in creative works.

The MPA therefore has a critical interest in this litigation. When the MPA's members and other creators of artistic works depict or refer to trademarks within

expressive works, they are not using them “as a mark.” Rather, they are using them to advance their storytelling, or to enhance the realism of a fictional world they create. *Jack Daniel’s* explicitly did not unsettle the case law from this Circuit and many others holding that depictions of trademarks in films and television shows are subject to the more speech-protective *Rogers* analysis. A contrary holding would throw this case law into doubt and would undermine the predictability and clarity that *Rogers* provides to the MPA’s members.

The MPA submits this brief to provide the Court with the perspective of creators that rely on the *Rogers* jurisprudence routinely, and to aid the Court in understanding how the *Rogers* jurisprudence carves out breathing space for creative expression in a way that balances First Amendment principles and the legitimate regulatory aims of the Lanham Act.

SUMMARY OF ARGUMENT

For decades, the MPA’s members have relied on the First Amendment jurisprudence beginning with *Rogers v. Grimaldi* to reference trademarks in creative works and realistically depict and comment on the world in which we live. The Supreme Court in *Jack Daniel’s* explicitly left lower courts’ *Rogers* jurisprudence intact, holding only that *Rogers* should not be applied when a trademark is used by the defendant “as a mark,” or as an identifier of the source of the defendant’s product.

This case is the first in which any circuit court has been asked to interpret *Jack Daniel's* as it applies to the content of a television show. Plaintiff Lance Hara performs as a drag queen in West Hollywood and Los Angeles. In 2021, Defendant Netflix released a cartoon series called *Q-Force* about a group of LGBTQ spies who fight crime and navigate life in the West Hollywood neighborhood. Plaintiff claims that an animated version of her likeness appears in one episode of *Q-Force* and materials promoting the show. In the depiction, the cartoon character who allegedly resembles Plaintiff sits in a West Hollywood gay bar with other characters and, at one point, opens a fan as a “punchline” to a joke. Plaintiff alleges that this wrongly led viewers to believe that Plaintiff had endorsed or was otherwise affiliated with *Q-Force*. Plaintiff sued under the Lanham Act, and the district court applied the *Rogers* test to dismiss Plaintiff’s claims. Plaintiff appealed, arguing that *Jack Daniel's* bars application of *Rogers* because her likeness was being used “as a mark” by Defendants.

Rogers and its progeny carefully construe the Lanham Act to avoid a conflict with the First Amendment, providing a necessary balance between the public’s interest in preventing consumer deception and the public’s interest in encouraging freedom of expression. The *Rogers* test insulates filmmakers and television producers against expensive and time-consuming litigation if they depict a trademark in their work, so long as the trademark has at least some artistic relevance

and is not explicitly misleading. *Jack Daniel's* did not meaningfully alter that precedent. *Jack Daniel's* simply clarified that if a defendant is using a plaintiff's trademark as a trademark—to indicate the source of the defendant's product—the existence of some expressive meaning does not trigger the *Rogers* test.

Treating the character depiction here as source-identifying would unravel *Rogers* and the entire body of First Amendment jurisprudence upon which MPA members routinely rely. Simply depicting a name, likeness, or trademark in a movie or television show to imbue a setting with a sense of realism cannot be using a mark “as a mark,” or else the logic of *Jack Daniel's*—distinguishing between trademark depictions that are source-identifying and depictions that are not—would collapse in on itself. In this case, the Court should hold that *Jack Daniel's* does not preclude application of this Court's well-settled *Rogers* jurisprudence to the creative use of a mark in the body of an expressive work, like a television program or movie, and trailers and still images depicting that work. Only that result would ensure the stability of the *Rogers* doctrine and allow freedom of expression to continue to flourish.

ARGUMENT

Rogers remains binding precedent in this Circuit in all Lanham Act cases challenging the use of a trademark in an artistic work, so long as the trademark is not being used as a source identifier. The Court should therefore affirm the district

court's application of *Rogers* in this case because the depiction is not being used to identify a source.

I. The *Rogers* Legal Standard Is a Critical Safeguard of Creative Expression.

A trademark is a mark that “identifies a product’s source (this is a Nike) and distinguishes that source from others (not any other sneaker brand).” *Jack Daniel’s Props. Inc. v. VIP Prods.*, 599 U.S. 140, 146 (2023). “In other words, a mark tells the public who is responsible for a product.” *Id.* To protect both consumers and trademark holders from fraud or mistake, the Lanham Act prohibits anyone from using a trademark to sell goods or services in a way that is “likely to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. §§ 1114(1), 1125(a)(1)(A). Infringement liability under the Lanham Act turns on likelihood of confusion because confusion about a product’s source “is the bête noire of trademark law—the thing that stands directly opposed to the law’s twin goals of facilitating consumers’ choice and protecting producers’ good will.” *Jack Daniel’s*, 599 U.S. at 147.

This Circuit applies an eight-factor balancing test to determine likelihood of confusion, considering: (1) “strength of the mark;” (2) “proximity of the goods;” (3) “similarity of the marks;” (4) “evidence of actual confusion;” (5) “marketing channels used;” (6) “type of goods and the degree of care likely to be exercised by the purchaser;” (7) “defendant’s intent in selecting the mark;” and (8) “likelihood of expansion of the product lines.” *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–

49 (9th Cir. 1979). This analysis is highly fact-dependent, and the issue often cannot be resolved on summary judgment. *See, e.g., JL Beverage Co., LLC v. Jim Beam Brands Co.*, 828 F.3d 1098, 1105 (9th Cir. 2016).²

When a party uses someone else’s trademark to dupe consumers into believing that its product is manufactured by a well-respected competitor, there is no meaningful collision between the Lanham Act and the First Amendment. In other words, “[w]hatever first amendment rights you may have in calling the brew you make in your bathtub “Pepsi” are ‘outweighed by the buyer’s interest in not being fooled into buying it.’” *Jack Daniel’s*, 599 U.S. at 159 (quoting *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002)). However, every circuit court to engage with the issue has recognized that artists *do* have an important First Amendment interest in depicting trademarks in creative works—such as movies, television shows, and songs—not to identify the source of the creative work, but to communicate something else expressive.

In *Rogers*, the Second Circuit articulated the test that still governs today in this Circuit and every other circuit that has decided the issue. *Rogers* concerned the

² This is not to say that meritless claims must proceed to discovery, even outside the *Rogers* framework. Indeed, the Supreme Court in *Jack Daniel’s* recognized that even where *Rogers* does not apply, a case may very well “not present any plausible likelihood of confusion—because of dissimilarity in the marks or various contextual considerations,” and so the complaint should be dismissed under Rule 12(b)(6). *Jack Daniel’s*, 599 U.S. at 157 n.2.

1986 film “Ginger and Fred.” *See Rogers v. Grimaldi*, 875 F.2d 994, 996–97 (2d Cir. 1989). The movie was a work of fiction about two Italian cabaret singers named Pippo and Amelia who had an act imitating Ginger Rogers and Fred Astaire. *See id.* Rogers alleged that the title “creat[ed] the false impression that the film was about her or that she sponsored, endorsed, or was otherwise involved in the film” in violation of the Lanham Act. *See id.* at 997.

The Second Circuit recognized that there can be a tension between an artist’s First Amendment rights and the government’s interest in preventing consumer deception. While “[m]ovies, plays, books, and songs are all indisputably works of artistic expression and deserve protection,” they are still “sold in the commercial marketplace like other more utilitarian products, making the danger of consumer deception a legitimate concern that warrants some government regulation.” *Id.*

However, *Rogers* also recognized two ways in which expressive works differ from other products regulated by the Lanham Act. First, expressive works “are of a hybrid nature, combining artistic expression and commercial promotion.” *Id.* at 998. The public has an interest “in enjoying the results of the author’s freedom of expression”—expression which might be chilled if subjected to expensive and time-intensive litigation. *Id.* Second, consumers interact differently with expressive works than they do other products: “[t]hough consumers frequently look to the title

of a work to determine what it is about . . . most consumers are well aware that they cannot judge a book solely by its title any more than by its cover.” *Id.* at 1000.

The Second Circuit therefore adopted a two-part test that has come to be known as the “*Rogers* test.” The court held that the Lanham Act “should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* at 999. As a result, trademark infringement liability under the *Rogers* test attaches only (1) if “the title has no artistic relevance to the underlying work whatsoever” or (2) “if [the title] has some artistic relevance, [where] the title explicitly misleads as to the source or the content of the work.” *Id.*

In *Rogers* itself, the Second Circuit held that the title “Ginger and Fred” had artistic relevance to the underlying work, since the characters’ nicknames did “have genuine relevance to the film’s story.” *Id.* at 1001. The court further found the title was not explicitly misleading, since it “contains no explicit indication that Rogers endorsed the film or had a role in producing it.” *Id.* The court thus resolved Rogers’s Lanham Act claim without resorting to a conventional likelihood-of-confusion analysis.

This Circuit has long embraced the *Rogers* doctrine, beginning with *Mattel, Inc. v. MCA Records, Inc.*, a case brought by the maker of Barbie against the music companies that produced the song “Barbie Girl.” *See Mattel, Inc. v. MCA Records,*

Inc., 296 F.3d 894, 901–02 (9th Cir. 2002). There, this Court recognized *Rogers*' underlying rationale: that when it comes to use of a trademark in association with a creative work, “[c]onsumers expect a title to communicate a message about the book or movie, but they do not expect it to identify the publisher or producer.” *Id.* at 902. As this Court put it: “If we see a painting titled ‘Campbell’s Chicken Noodle Soup,’ we’re unlikely to believe that Campbell’s has branched into the art business. Nor, upon hearing Janis Joplin croon ‘Oh Lord, won’t you buy me a Mercedes-Benz?,’ would we suspect that she and the carmaker had entered into a joint venture.” *Id.*

This Court’s subsequent jurisprudence has further developed the contours of First Amendment protection for use of marks in association with creative works. For example, this Court has recognized that “there is no principled reason why [*Rogers*] ought not also apply to the use of a trademark in the body of the work,” rather than just the title. *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008); *see also Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 796, 807 (9th Cir. 2003) (applying *Rogers* to photographs depicting a Barbie doll “in danger of being attacked by vintage household appliances”). This Court has further recognized that *Rogers* must apply to promotional activities incorporating the challenged element of an expressive work; otherwise, the creator of an expressive work would be forced to advertise with one hand tied behind their back.

See Twentieth Century Fox Television v. Empire Distrib., Inc., 875 F.3d 1192, 1196–97 (9th Cir. 2017).

In the years since it was decided, *Rogers* and its progeny in this Circuit have come to play a significant role in ensuring breathing space for artistic expression—and nowhere more so than in film and television. Motion pictures and television programs frequently depict real-life products and trademarks to tell a story, make a particular point, or convey a sense of reality of the story being told. Brands generally are used as shorthand to help the audience understand who a character is and what a scene is about. Use of known brands and marks also lends an aura of verisimilitude that is critical to effective storytelling.

To portray a car with any measure of reality, it must be recognizable as, for example, a Ferrari, Porsche, Ford, or Volkswagen. A top-of-the-line Ferrari in a heist film sets one tone. A beat-up Volkswagen camper in a homecoming story sets quite another. Such creative choices bring the writer’s and director’s vision to life. Storytellers need to be able to make artistic decisions involving trademarks to depict the world in which we live. And this necessity, of course, does not begin and end with car brands: creators must be able to have their characters drink Coca-Cola, eat Pringles, use iPhones and MacBooks, and carry Gucci handbags, all without fearing repercussions or needing to fictionalize these items in ways that an audience would

readily recognize is not reflective of the real world. For decades, *Rogers* has provided creators the predictability and breathing space to do just that.

II. *Jack Daniel's Did Not Unseat Rogers' Application to Use of Marks in Creative Works.*

The Supreme Court in *Jack Daniel's* did not fundamentally disturb the *Rogers* standard or this Circuit's case law elaborating upon that standard. There, VIP Products LLC produced a line of chewable dog toys, one of which emulated a bottle of Jack Daniel's whiskey reimagined as "Bad Spaniels." *Jack Daniel's*, 599 U.S. at 144. The "Bad Spaniels" dog toy mimicked the graphics, tagline, and overall trade dress of the Jack Daniel's bottle, swapping "Old No. 7 Tennessee Sour Mash Whiskey" for "The Old No. 2 On Your Tennessee Carpet," and "40% alc. by vol. (80 proof)" for "43% poo by vol." and "100% smelly." *See id.* at 149–50.

The question before the Supreme Court in *Jack Daniel's* was whether *Rogers* properly applies to a dog toy parodying the Jack Daniel's trademark and trade dress. At the Supreme Court, the parties staked out sweeping and extreme positions on *Rogers*. On one end of the spectrum, Jack Daniel's urged the Court to reject the *Rogers* test entirely. *See* Brief for Petitioner, *Jack Daniel's Props. Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023) (No. 22-148), 2023 WL 199388. On the other end, VIP Products argued that any use of a mark is covered by *Rogers* as long as it conveys a humorous message. *See* Brief for Respondent, *Jack Daniel's Props. Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023) (No. 22-148), 2023 WL 2189058.

The Supreme Court declined to adopt either party’s approach to *Rogers*. See *Jack Daniel’s*, 599 U.S. at 153. Instead, the Court held more narrowly that the *Rogers* test (or any other “threshold First Amendment filter”) does not apply “when the accused infringer has used a trademark to designate the source of its own goods—in other words, has used a trademark as a trademark.” *Id.* at 145, 153 n.1. *Jack Daniel’s* recognizes that when a party is using a mark as a source identifier, such as on a commercial product, that puts it squarely in the domain typically covered by trademark law, and further afield from the expressive uses implicated by the *Rogers* doctrine. Ultimately, “[w]hen a mark is used as a mark . . . , the likelihood-of-confusion inquiry does enough work to account for the interest in free expression.” *Id.* at 159.

In *Jack Daniel’s*, the Court held as a matter of law that the dog toy at issue was making use of “Bad Spaniels” as a source identifier. But that decision hinged on several important facts far from the heartland of *Rogers*. First and foremost, VIP had explicitly conceded in its complaint that it owned and used the Bad Spaniels’ “trademark” and “trade dress.” See *id.* at 160. The Court also focused on the placement of the “Bad Spaniels” logo on the hangtag and VIP’s past practice of trademarking other parody dog toy names. See *id.* Although the Supreme Court did not set a brightline rule for when use constitutes use as a source identifier, in light of

that combination of facts, it was indisputable that VIP was using the “Bad Spaniels” mark “as a mark”—*i.e.*, to identify the source of the dog toy.

Importantly, the Supreme Court explicitly did not rule on the validity of *Rogers*, and thus did not unsettle any of the Ninth Circuit’s governing precedent. *See id.* at 145, 153, 155, 163. Indeed, “because the Supreme Court’s decision in *Jack Daniel’s* was confined to a ‘narrow’ point of law that *Rogers* does not apply when a mark is used as a mark, preexisting Ninth Circuit precedent adopting and applying *Rogers* otherwise remains intact and binding on three-judge panels.” *Punchbowl, Inc. v. AJ Press, LLC*, 90 F.4th 1022, 1031 (9th Cir. 2024) (citation omitted).

III. The District Court Properly Applied *Rogers* to Bar Plaintiff’s Lanham Act Claims.

The challenged depiction at issue here is the kind of quintessential reference in a creative work that has been subject to *Rogers* for decades and that *Jack Daniel’s* left untouched. The alleged depiction of Plaintiff’s likeness in a cartoon, and in materials promoting that cartoon, are light years away from the facts and holding of *Jack Daniel’s*. Instead, this is exactly the kind of creative expression *Rogers* protects.

A. The Challenged Use Was Not Source-Identifying.

Jack Daniel’s held solely that *Rogers* does not apply when the defendant uses a trademark to “designate the *source of its own goods*[,]” which the Court equated

to using a trademark “as a trademark.” *Jack Daniel’s*, 599 U.S. at 145 (emphasis added). Here, the alleged depictions of Plaintiff’s likeness do not constitute use “as a mark” within the meaning of *Jack Daniel’s* because none of these uses even remotely identify Plaintiff (or the stylized cartoon character Plaintiff alleges is meant to depict her) as the source of *Q-Force*.

Although *Jack Daniel’s* did not fully explicate what it means for a trademark to be used “as a mark,” none of the indicia of trademark use in *Jack Daniel’s* apply here to the quintessential use of a depiction in a creative work. Unlike in *Jack Daniel’s*, the animated character depiction that allegedly resembles Plaintiff is not itself a trademark. *See Jack Daniel’s*, 599 U.S. at 160. Nor are any of the other Q-Force cartoon characters registered trademarks, as VIP’s other dog toy products were. *See id.* And the challenged creative depiction is not used alongside other logos, trademarks, or indicia of source, the way VIP placed “Bad Spaniels” in a position of equal prominence with its own mark. *See id.* Instead, the depiction here—as is typical in other creative works—is alleged solely to have referenced Plaintiff within the body of an expressive work and in its accompanying promotional materials, where the alleged references were clearly in furtherance of the show’s artistic expression and were not source-identifying.

In fact, the Court in *Jack Daniel’s* even observed that simply depicting a trademark in a movie generally will not constitute use of that trademark as a source

identifier. As an example, the Court cited with approval a district court’s application of *Rogers* to a Lanham Act claim brought by Louis Vuitton challenging the depiction of a knock-off Louis Vuitton product in the movie *The Hangover: Part II*. See *Jack Daniel’s*, 599 U.S. at 154 (citing *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172 (S.D.N.Y. 2012)). The Supreme Court went on to explain,

Suppose a filmmaker uses a Louis Vuitton suitcase to convey something about a character (he is the kind of person who wants to be seen with the product but doesn’t know how to pronounce its name). Now think about a different scenario: A luggage manufacturer uses an ever-so-slightly modified LV logo to make inroads in the suitcase market. The greater likelihood of confusion inheres in the latter use, *because it is the one conveying information (or misinformation) about who is responsible for a product.*

Id. at 157 (citation omitted) (emphasis added). In contrast, the Supreme Court implied, simply having a character carry, or discuss, a Louis Vuitton suitcase in a film does not identify Louis Vuitton as a source of the film.

Since *Jack Daniel’s* was decided, lower courts have had no trouble recognizing that the depiction of a trademark within the body of an expressive work is not use of a trademark as a source identifier. In *JTH Tax LLC v. AMC Networks Inc.*, a tax preparation service operating under the name “Liberty Tax Service” sued the producers of the show *Better Caul Saul* over an episode that depicts a fictional tax preparation service called “Sweet Liberty Tax Services.” In the episode, “Sweet Liberty Tax Services” is run by a convicted felon and his wife, who were minor

characters in an earlier season of the show. No. 22-CV-6526, 2023 WL 6215299, at *1 (S.D.N.Y. Sept. 25, 2023). The plaintiff claimed trademark and trade dress infringement. *See id.* However, the court found no allegation that the defendants used the plaintiff's marks "to identify the source of *Better Call Saul*" or "any product they sell." *Id.* at *7. Rather, the challenged uses were "used in furtherance of the Show's plot." *Id.* Accordingly, the court applied *Rogers* and ultimately dismissed the plaintiff's claim. *See id.* at *15.

The court in *JTH Tax LLC* also found that application of *Rogers* was appropriate even though the plaintiff alleged that *Better Caul Saul* used the plaintiff's marks in a trailer and social media posts for the show. *See id.* at *2, *6 & n.2. In so holding, the court recognized that *Rogers* itself held that its balancing test applies to expressive works "of a hybrid nature, combining artistic expression and commercial promotion." *Rogers*, 875 F.2d at 998. It also referred to this Court's case law addressing promotional uses before *Jack Daniel's*, which recognized that "it requires only a minor logical extension of the reasoning of *Rogers* to hold that works protected under its test may be advertised and marketed by name." *Empire Distrib.*, 875 F.3d at 1196–97.

None of the post-*Jack Daniel's* cases Plaintiff cites compel a different result here. For instance, the Second Circuit's decision in *Vans, Inc. v. MSCHF Product Studio, Inc.* is clearly inapposite. 88 F.4th 125 (2d Cir. 2023). There, the Second

Circuit found that *Rogers* did not apply to a competitor shoe branded with Vans' trademarks. *See id.* at 138–39. The allegations in *Vans* are far more akin to “[a] luggage manufacturer [who] uses an ever-so-slightly modified LV logo to make inroads in the suitcase market” than “a filmmaker [who] uses a Louis Vuitton suitcase to convey something about a character.” *Jack Daniel's*, 599 U.S. at 157. Similarly, some courts have declined to apply *Rogers* where the allegedly infringing mark was used, at least in part, to designate the source of toys and other consumer products. *See* Order at 10–12, *Diece-Lisa Industries, Inc. v. Disney Enterprises, Inc.*, No. 20-CV-9147 (C.D. Cal. May 1, 2024), ECF No. 386; *MGA Ent. Inc. v. Harris*, No. 20-CV-11548, 2023 WL 6194387, at *2–3 (C.D. Cal. Sept. 15, 2023), *motion to certify appeal denied*, 2023 WL 8896883 (C.D. Cal. Dec. 8, 2023). This Court should reject Plaintiff's efforts to extend this case law to an alleged depiction of a trademark solely in an episode of a television show and trailers promoting that episode.

Additional cases Plaintiff cites involved allegations about references to trademarks *in the titles* of expressive works. Although use of a trademark in a title is not inherently source-identifying under *Jack Daniel's*, such use can raise different issues than depictions of trademarks in the body of expressive works. *See, e.g., Down to Earth Organics, LLC v. Efron*, No. 22-CV-06218, 2024 WL 1376532, at *4–5 (S.D.N.Y. Mar. 31, 2024) (holding that alleged use of the plaintiff's “Down to

Earth” trademark in the title of a television series, “Down to Earth with Zac Efron,” was not source-identifying where the defendants were “undoubtedly using ‘Down to Earth’ simply to identify the subject matter and tone of the Series,” rather than its source). In each of the cases cited by Plaintiff, the court rejected the application of *Rogers* under the rationale that the alleged use of the mark occurred in a context where a consumer might reasonably expect to learn the source of the creative work at issue—the title of the work—raising at least a potential inference that the mark was being used in a source-identifying capacity.

For example, in *Punchbowl, Inc.*, the plaintiff operated an electronic invitation and greeting card business under the “Punchbowl” trademark, while the defendant operated an online news publication under the “Punchbowl News” and “Punchbowl Press” trademarks. 90 F.4th at 1025–26. This Court rejected application of *Rogers* because the defendant used “Punchbowl” to “identify and distinguish” its news products to consumers—*i.e.*, as a trademark to denote a line of online news offerings. *Id.* at 1031. Other decisions cited by Plaintiff involved similar issues. *See* Order Denying Pl.’s Mot. to Dismiss Counterclaims and/or for Judgment on the Pleadings [Dkt. 24] at 6–7, *Activision Publ’g, Inc. v. Warzone.com, LLC*, No. 21-CV-3073 (C.D. Cal. Apr. 11, 2024), ECF No. 69 (rejecting application of *Rogers* on remand from this Court because the counterclaim defendant used “WARZONE” to identify itself as the source of its computer game products and had registered “WARZONE”

as a trademark); *HomeVestors of Am., Inc. v. Warner Bros. Discovery, Inc.*, No. 22-CV-1583, 2023 WL 6880341, at *1 (D. Del. Oct. 18, 2023) (denying motion to dismiss under *Rogers* because the plaintiff adequately alleged that use of the title “Ugliest House in America” for a television show was source-identifying), *report and recommendation adopted*, 2023 WL 8826729 (D. Del. Dec. 21, 2023); *Davis v. Amazon.com, Inc.*, No. 21-CV-02090, 2023 WL 8113299, at *1–2 (C.D. Cal. Nov. 2, 2023) (rejecting application of *Rogers* to title of film identical to book title), *appeal docketed*, No. 23-3968 (9th Cir. Dec. 6, 2023).³ The rationale undergirding these decisions is inapplicable here, where the issue is instead the alleged depiction of a mark within a creative work.

B. Plaintiff’s Interpretation of *Jack Daniel’s* Would Swallow *Rogers*.

For Plaintiff to prevail here, this Court would need to hold that a trademark use is source-identifying if a consumer might be confused as to an affiliation between the trademark owner and an expressive work. *See* Appellant’s Br. 38, 44, 47. That cannot be correct. If it were the case that every instance of confusion as to affiliation between the plaintiff and defendant meant that the use was “as a mark,” then *Rogers*

³ Even if it were factually apposite, which it is not, *Davis* should also not guide this Court here. *Davis* looked to whether the plaintiff’s alleged trademark was being used as a source identifier for the *plaintiff’s* product, rather than whether the defendant’s use was being used “as a mark.” *See* 2023 WL 8113299, at *4–6 (rejecting *Rogers* because the plaintiff alleged that “GRINGO” was used as a source identifier of the plaintiff’s book).

would never apply. As this Court has long recognized, although the “likelihood-of-confusion test ... generally strikes a comfortable balance between the trademark owner’s property rights and the public’s expressive interests,” that balance shifts when a trademark owner attempts to police the content of a creative work—where “applying the traditional [likelihood-of-confusion] test fails to account for the full weight of the public’s interest in free expression.” *Mattel, Inc.*, 296 F.3d at 900 (citation omitted).

Indeed, *Rogers* itself involved a false endorsement claim brought by a celebrity. Like Plaintiff here, Ginger Rogers claimed that consumers were likely to believe that she endorsed or was otherwise affiliated with the creative work that referenced her, the movie “Ginger and Fred.” The Second Circuit explained that expressive works may reference a celebrity “without any overt indication of authorship or endorsement”—for example, the song titled “Bette Davis Eyes.” *Rogers*, 875 F.2d at 999. But in situations such as these—where the celebrity is not overtly identified as the source or sponsor of the work—the *Rogers* test weighs in favor of allowing artistic expression. *See id.* at 999–1000.

Moreover, *Rogers* built in two safeguards against abuse, by requiring that a reference to a trademark be “artistically relevant” and not “explicitly misleading.” *Rogers* itself identified examples of references to notable people that would be explicitly misleading. *See id.* at 999. For example, the Second Circuit suggested

that the titles “Jane Fonda’s Workout Book,” and “Nimmer on Copyright” may be explicitly misleading, if applied to books not written or endorsed by Fonda or Nimmer, because they “explicitly state the author of the work or at least the name of the person the publisher is entitled to associate with the preparation of the work.” *Id.* So too, the subtitle “an authorized biography” may similarly “contain words explicitly signifying endorsement.” *See id.* Applying these principles, if the movie at issue were titled “The True Life Story of Ginger and Fred,” or something else that “explicit[ly] indicat[ed] that Rogers endorsed the film or had a role in producing it,” the Second Circuit recognized that the Lanham Act would likely apply. *Id.* at 1000–01. Both the “artistically relevant” and “not explicitly misleading” requirements thus train *Rogers*’ heightened protection on instances where the use is integrated into the expressive nature of the work, and so not likely to be perceived by consumers as an identifier of the source of the defendant’s goods or services.

For that reason, application of *Rogers* here would not open the floodgates to meritless claims of “some minimal artistic expression,” *contra* Appellant’s Br. 43–44. As *Jack Daniel’s* recognized, the doctrine has been applied effectively for decades to safeguard genuinely expressive uses. *See Jack Daniel’s*, 599 U.S. at 154–55 (collecting cases). Indeed, there have been numerous cases where, applying *Rogers*, courts have nonetheless declined First Amendment protection because they determined that an alleged use was either not artistically relevant or was explicitly

misleading. *See, e.g., Parks v. LaFace Records*, 329 F.3d 437, 455–56 (6th Cir. 2003) (holding gratuitous use of Rosa Parks’ name in the title of a song that “is not about Rosa Parks at all” was artistically irrelevant); *Hermès Int’l v. Rothschild*, 603 F. Supp. 3d 98, 104–07 (S.D.N.Y. 2022) (holding luxury fashion brand adequately alleged that use of its marks as non-fungible tokens was both not artistically relevant and was explicitly misleading); *Warner Bros. Ent. v. Global Asylum, Inc.*, No. 12-CV-9547, 2013 WL 12114836, at *10–11 (C.D. Cal. Jan. 29, 2013) (holding title “Age of Hobbits” was artistically irrelevant to a film about pre-historic humans when they were never referred to as hobbits within the film and the film was to be released days before a movie in the *Lord of the Rings* franchise), *aff’d*, 544 F. App’x 683 (9th Cir. 2013).

This case is unlike any of those. Here, the district court correctly recognized that the alleged depiction of Plaintiff’s likeness was artistically relevant, in line with this Court’s longstanding precedent holding that use of recognizable attributes of a particular neighborhood is artistically relevant to evoking the “look and feel” of that neighborhood. *E.S.S. Ent.*, 547 F.3d at 1100. As for the “explicitly misleading” analysis, this Court’s case law makes clear that a trademark plaintiff must allege more than a mere likelihood of confusion or use of a mark. *See, e.g., Empire Distrib.*, 875 F.3d at 1199. Ultimately, one of the ways in which *Rogers* protects expressive speech is by avoiding the chilling effect that comes with burdensome discovery on

claims that are highly likely to prove to be meritless. Plaintiff's request for discovery to better substantiate her claim of consumer confusion, *see* Appellant's Br. 43, 53–54, demonstrates the very reason why *Rogers* is needed in the first place, and the danger of treating every fleeting reference to a mark as a potential source-identifier under *Jack Daniel's*.

The practical implication of Plaintiff's position, if adopted by this Court, would be that movie and television studios would no longer be able to predict *Rogers'* application to references to or depictions of trademarks in their works, particularly if they wanted to then use a particular scene in a trailer. In turn, the lack of predictability would chill important—and constitutionally protected—creative speech. The Court should affirm the district court's application of *Rogers* and make clear that this case does not allege the kind of trademark use contemplated by *Jack Daniel's*, and therefore this Court's *Rogers* jurisprudence remains binding.

CONCLUSION

For the foregoing reasons, *amicus* respectfully urges this Court to affirm the judgment of the district court.

Dated: May 22, 2024

Respectfully submitted,

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CERTIFICATES

Susan J. Kohlmann, counsel for *amicus curiae* the Motion Picture Association, Inc. (“MPA”), hereby certifies that:

1. I am a member in good standing of the Bar of the United States Court of Appeals for the Ninth Circuit.

2. This Brief complies with the type-volume limitation in Rules 29(a)(5) and 32(a)(7)(B) of the Federal Rules of Appellate Procedure because, excluding the parts of the document exempted by Rule 32(f), this document contains 6,268 words.

3. This Brief complies with the typeface requirements of Rule 32(a)(5) and the type-style requirements of Rule 32(a)(6) of the Federal Rules of Appellate Procedure because this document has been prepared in a proportionally-spaced typeface using Microsoft Word 2013 in 14-point Times New Roman.

4. On this date, the foregoing Brief of *Amicus Curiae* MPA was filed electronically and served on the other parties via the Court’s ECF system.

Dated: May 22, 2024

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