

No. 21-55881

**UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

Punchbowl, Inc.,
Plaintiff-Appellant,

v.

AJ Press,
Defendant-Appellee

On Appeal from the United States District Court
for the Central District of California
The Honorable Stephen Wilson
Case No. 2:21-cv-03010

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Table of Contents

Table of Authorities.....	ii
Interest of <i>Amici Curiae</i>	1
Summary of Argument.....	2
Argument.....	4
I. The <i>Rogers</i> rule applies to news and opinion sites	4
A. <i>Rogers</i> applies to all works of noncommercial speech	5
B. The <i>Rogers</i> rule applies to titles of ongoing publications and not just to titles of individual films or songs	8
II. The “Punchbowl News” name is not explicitly misleading	13
A. The Capitol-related meaning of Punchbowl precludes any finding of explicit misleadingness	13
B. Even if the parties used “Punchbowl” to identify the same concept, the use would not be explicitly misleading.....	15
1. Explicit misleadingness is a high bar and ambiguous uses, even ambiguous uses on similar products, are not explicitly misleading	15
2. Source-identifying use is not the “same” use	17
3. A publication’s title cannot be separated from its content for <i>Rogers</i> purposes.....	22
Conclusion	25
Certificate of Compliance.....	27

Table of Authorities

Cases

<i>Brown v. Elec. Arts, Inc.</i> , 724 F.3d 1235 (9th Cir. 2013)	18
<i>Brown v. Ent. Merch. Ass’n</i> , 564 U.S. 786 (2011)	7
<i>Cardtoons, L.C. v. Major League Baseball Players Ass’n</i> , 95 F.3d 959 (10th Cir. 1996)	12
<i>City of Lakewood v. Plain Dealer Publ’g Co.</i> , 486 U.S. 750 (1988)	7
<i>Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp.</i> , <i>Inc.</i> , 886 F.2d 490 (2d Cir. 1989)	6, 21
<i>Cohen v. Cal.</i> , 403 U.S. 15 (1971)	9
<i>Dex Media West, Inc. v. City of Seattle</i> , 696 F.3d 952 (9th Cir. 2012)	8
<i>Dickinson v. Ryan Seacrest Enters., Inc.</i> , 2019 WL 3035090 (C.D. Cal. Mar. 26, 2019)	6
<i>Dr. Seuss Enter., L.P. v. ComicMix, LLC</i> , 983 F.3d 443 (9th Cir. 2020)	15, 17
<i>E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.</i> , 547 F.3d 1095 (9th Cir. 2008)	3
<i>Facenda v. N.F.L. Films, Inc.</i> , 542 F.3d 1007 (3d Cir. 2008)	6
<i>Fortres Grand Corp. v. Warner Bros. Ent. Inc.</i> , 947 F. Supp. 2d 922 (N.D. Ind. 2013)	6
<i>Gordon v. Drape Creative</i> , 909 F.3d 257 (9th Cir. 2018)	19
<i>IOW, LLC v. Breus</i> , 425 F. Supp. 3d 1175 (D. Ariz. 2019)	8

<i>Jackson v. Netflix</i> , 506 F. Supp. 3d 1007 (C.D. Cal. 2020)	10
<i>Joseph Burstyn, Inc. v. Wilson</i> , 343 U.S. 495 (1952)	4
<i>Lacoff v. Buena Vista Publ’g, Inc.</i> , 705 N.Y.S.2d 183 (Sup. Ct. 2000)	6
<i>Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.</i> , 868 F. Supp. 2d 172 (S.D.N.Y. 2012)	6
<i>Matal v. Tam</i> , 137 S.Ct. 1744 (2017)	18
<i>Mattel, Inc. v. MCA Records, Inc.</i> , 296 F.3d 894 (9th Cir. 2002)	passim
<i>Multi Time Machine, Inc. v. Amazon.com, Inc.</i> , 804 F.3d 930 (9th Cir. 2015)	21
<i>Name.Space, Inc. v. Network Solutions, Inc.</i> , 202 F.3d 573 (2d Cir. 2000)	10
<i>New Kids on the Block v. News America Publ’g, Inc.</i> , 971 F.2d 302 (9th Cir.1992)	9
<i>Parks v. LaFace Records</i> , 329 F.3d 437 (6th Cir. 2003)	9
<i>Pomegranate Communications, Inc. v. Sourcebooks, Inc.</i> , 2019 WL 7476688, 19-cv-00119-AC (D. Or. Dec. 16, 2019)	14
<i>ProtectMarriage.com v. Courage Campaign</i> , 680 F. Supp. 2d 1225 (E.D. Cal. 2010)	7
<i>Pursuing America’s Greatness v. FEC</i> , 831 F.3d 500 (D.C. Cir. 2016)	9
<i>Radiance Found., Inc. v. NAACP</i> , 786 F.3d 316 (4th Cir. 2015)	6

<i>Riley v. Nat’l Fed’n of the Blind of N.C., Inc.</i> , 487 U.S. 781 (1988).....	9
<i>Rogers v. Grimaldi</i> , 875 F.2d 994 (2d Cir. 1989)	passim
<i>Sarver v. Chartier</i> , 813 F.3d 891 (9th Cir. 2016).....	8
<i>Smith v. Cal.</i> , 361 U.S. 147 (1959).....	7
<i>SmithKline Beecham Consumer Healthcare, L.P. v. Johnson & Johnson-Merck Consumer Pharms. Co.</i> , 2001 WL 588846, No. 1 Civ. 2775 (DAB) (S.D.N.Y. June 1, 2001).....	16
<i>Suzie’s Brewery Co. v. Anheuser-Busch Cos.</i> , 519 F. Supp. 3d 839 (D. Or. 2021).....	16
<i>Three Boys Music Corp. v. Bolton</i> , 212 F.3d 477 (9th Cir. 2000).....	21
<i>Time Warner Cable, Inc. v. DIRECTV, Inc.</i> , 497 F.3d 144 (2d Cir. 2007)	15
<i>Twentieth Century Fox Television v. Empire Dist. Inc.</i> , 875 F.3d 1192 (9th Cir. 2017).....	5, 10, 19
<i>U.S. Olympic Comm. v. American Media, Inc.</i> , 156 F. Supp. 2d 1200 (D. Colo. 2001)	6
<i>United Indus. Corp. v. Clorox Co.</i> , 140 F.3d 1175 (8th Cir. 1998).....	16
<i>VIP Prods. LLC v. Jack Daniel’s Props, Inc.</i> , 953 F.3d 1170 (9th Cir. 2020)	11
<i>Yankee Publ’g Inc. v. News America Publ’g Inc.</i> , 809 F. Supp. 267 (S.D.N.Y. 1992)	21

Other Authorities

<i>About</i> , Paste Mag., https://www.pastemagazine.com/about	11
Above the Law, http://abovethelaw.com (last visited Dec. 16, 2021).....	14
Artistic Yarn By Abi, https://www.artistic yarnbyabi.com (last visited Dec. 16, 2021).....	18
Ben Smith, <i>They Seem to Think the Next Four Years Will Be Normal</i> , N.Y. Times (Jan. 3, 2021).....	13
Pitchfork, https://pitchfork.com (last visited Nov. 6, 2021).....	11
Punchbowl News, https://punchbowl.news (last visited Nov. 6, 2021)	17
Punchbowl, https://www.punchbowl.com (last visited Nov. 6, 2021).....	17
Tim Carmody’s Amazon Chronicles, https://amazonchronicles.substack.com/	25
USA Medical and Surgical Supplies, https://www.usamedicalsurgical.com (last visited Dec. 16, 2021).....	18
<i>VICE Media Becomes One of the First News Organizations to go Pure IP</i> , Imagine Commc’ns, https://imaginecommunications.com/customer-success-stories/vice-media/	11

Interest of *Amici Curiae*¹

This brief is filed on behalf of the following law professors, whose research and teaching focus includes trademark law and who are interested in the proper development of trademark law:

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¹ No party or party's counsel has authored this brief in whole or in part, or contributed money that was intended to fund preparing or submitting the brief. No person has contributed money that was intended to fund preparing or submitting the brief, except that UCLA School of Law paid the expenses involved in filing this brief.

Their institutional affiliations are provided for identification purposes only.

Summary of Argument

Magazines, newspapers, and websites are entitled to choose names that best convey their underlying themes to readers. This right is protected by the First Amendment and by trademark law, as set forth in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), which has been adopted by this Court. AJ Press is entitled to name its news content “Punchbowl News” to communicate to its readers the topic, tone, and focus of its work (the Capitol, also known as “Punchbowl” by Washington insiders), even though there is a “Punchbowl Inc.” that deals in greeting cards and invitations. This is so for two related reasons:

First, *Rogers* applies to factual news reporting—core First Amendment-protected expression—as much as it does to fiction. Plaintiff’s argument that art should receive more First Amendment protection than news reporting is extraordinary, and extraordinarily wrong.

Second, *Rogers* protects a defendant who engages in “trademark use” but whose use is not explicitly misleading. AJ Press’s use of the mark is

not explicitly misleading, because the parties use the marks in substantively different ways, despite Plaintiff's attempt to manipulate the proper level of generality at which to assess use. Plaintiff's argument that "both parties use the mark in precisely the same way—as a brand—while providing online communication services" (App. Br. at 26), cannot suffice to avoid the *Rogers* doctrine; that doctrine was specifically developed because titles serve a branding function, unlike other elements of a work, but also are part of the work's expression. See *Rogers*, 875 F.2d at 998 (titles serve a branding function); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (same). The defendant's use of a term to serve a trademark function does not avoid *Rogers*. See *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) ("After all, a trademark infringement claim presupposes a use of the mark. If that necessary element in every trademark case vitiated a First Amendment defense, the First Amendment would provide no defense at all."). If accepted, Plaintiff's argument would render *Rogers* a nullity and would wrongly enable trademark owners who claim trademark rights for online communication services or informational services to restrict the expressive choices of future online speakers.

Argument

I. The *Rogers* rule applies to news and opinion sites

It is worth emphasizing just how extreme and unusual Plaintiff's argument is: Plaintiff contends that robust First Amendment protection shields artistic works (such as a “song, movie, book, video game, or television program”) from trademark liability—but that the First Amendment does not equally shield works of news reporting and political opinion (which Plaintiff labels “commercial news reporting products: newsletters, videos, and podcasts”). App. Br. at 9.

Purely as a matter of logic, this argument fails. Although the theoretical foundations of free speech protection for art are hotly contested, one key reason that courts have historically extended First Amendment protection to art is its potential for affecting political opinions. *See, e.g., Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952) (describing “motion pictures as an organ of public opinion”). Political reporting is at least as strongly protected as art. Plaintiff has identified no situation in which art gets *more* First Amendment protection than political news reporting. Thus, it is unsurprising that Plaintiff's *Rogers*-specific arguments are unpersuasive.

A. *Rogers* applies to all works of noncommercial speech

In *Rogers v. Grimaldi*, the Second Circuit “concluded that literary titles do not violate the Lanham Act ‘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.’” *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (quoting *Rogers*, 875 F.2d at 999). In *Mattel*, this Court adopted this test, and for good reason:

Trademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view. Were we to ignore the expressive value that some marks assume, trademark rights would grow to encroach upon the zone protected by the First Amendment.

Id. at 900.

This reasoning applies as much to news publications as it does to artistic works (such as the film *Fred & Ginger* in *Rogers*, or the song *Barbie Girl* in *Mattel*). “The only threshold requirement for the *Rogers* test is an attempt to apply the Lanham Act to First Amendment expression.” *Twentieth Century Fox Television v. Empire Dist. Inc.*, 875 F.3d 1192, 1198 (9th Cir. 2017).

“First Amendment expression,” in this context, means speech that is not advertising a separate product, but is itself the product being advertised. *Rogers* was based on an opposition between “artistic expression” and “commercial speech.” 875 F.2d at 997. Many cases recognize that *Rogers* applies to noncommercial speech.² And Punchbowl News fits clearly on the *Rogers*-protected side of the line: It is selling the speech itself, not advertising a separate nonspeech product. News reports are not beer, peas, or soda, to which Plaintiff repeatedly analogizes them; they are fully protected speech even when they are sold for profit.³ “If

² See *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 322 (4th Cir. 2015) (discussing *Rogers* as providing protection for “noncommercial” speech); *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1016-17 (3d Cir. 2008) (treating *Rogers* as creating a commercial/noncommercial speech division); *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172, 177 (S.D.N.Y. 2012) (same); *U.S. Olympic Comm. v. American Media, Inc.*, 156 F. Supp. 2d 1200, 1209 (D. Colo. 2001) (same); *Fortres Grand Corp. v. Warner Bros. Ent. Inc.*, 947 F. Supp. 2d 922, 933 (N.D. Ind. 2013) (same), *aff’d on other grounds*, 763 F.3d 696 (7th Cir. 2014); *Dickinson v. Ryan Seacrest Enters., Inc.*, 2019 WL 3035090, at *8 (C.D. Cal. Mar. 26, 2019) (same); *Lacoff v. Buena Vista Publ’g, Inc.*, 705 N.Y.S.2d 183, 191 (Sup. Ct. 2000) (same).

³ As binding precedent has long recognized, noncommercial speech is often produced for profit. See, e.g., *City of Lakewood v. Plain Dealer Publ’g Co.*, 486 U.S. 750, 756 n.5 (1988) (“Of course, the degree of First Amendment protection is not diminished merely because the newspaper or speech is sold rather than given away.”) (citation omitted); *Smith v. Cal.*, 361 U.S. 147, 150 (1959) (“It is of course no matter that the dissemination

speech is not purely commercial—that is, if it does more than propose a commercial transaction—then it is entitled to full First Amendment protection.” *Mattel, Inc.*, 296 F.3d at 900.

Because news reporting is core First Amendment-protected expression, Plaintiff’s claim that courts “have never applied the *Rogers* test to the name of a news reporting website, podcast, newsletter, television network, or print newspaper,” (App. Br. at 17), is thus theoretically unsound. And it is also inaccurate: *ProtectMarriage.com v. Courage Campaign* applied *Rogers* to defendant’s use of plaintiff’s logo on a news reporting website, because “the broader website, while perhaps not artistic, is undeniably expressive of a political idea, and both political and artistic expression are protected by the First Amendment.” 680 F. Supp. 2d 1225, 1229 (E.D. Cal. 2010); *cf. IOW, LLC v. Breus*, 425 F. Supp. 3d 1175, 1192-93 (D. Ariz. 2019) (applying *Rogers* to a nonfiction book, and explicitly rejecting argument that *Rogers* only applies only to fictional “artistic” works).

[of books] takes place under commercial auspices.”); *Brown v. Ent. Merch. Ass’n*, 564 U.S. 786, 790 (2011) (taking the same view for video games).

Adhering to *Rogers* and to this Court’s precedent in *Mattel* therefore makes sense as a matter of constitutional avoidance, and of sound interpretation of trademark principles in light of free speech concerns. In the alternative, this Court would have to apply the First Amendment directly to trademark law’s regulation of political news reporting, and such regulation would have to satisfy strict scrutiny. *See, e.g., Dex Media West, Inc. v. City of Seattle*, 696 F.3d 952, 957-59 (9th Cir. 2012); *Sarver v. Chartier*, 813 F.3d 891, 903-04 (9th Cir. 2016).

B. The *Rogers* rule applies to titles of ongoing publications and not just to titles of individual films or songs

The *Rogers* rule recognizes that names and titles have meaning—they affect audiences’ interpretations of the work, and reflect the work’s message:

The title of a movie may be both an integral element of the filmmaker’s expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined. Filmmakers and authors frequently rely on wordplay, ambiguity, irony, and allusion in titling their works. Furthermore, their interest in freedom of artistic expression is shared by their audience.

Rogers, 875 F.2d at 998.⁴ Restrictions on a noncommercial speaker’s choice of title would therefore unconstitutionally interfere with the underlying speech. *See Pursuing America’s Greatness v. FEC*, 831 F.3d 500, 510 (D.C. Cir. 2016) (regulation of titles of political websites subject to strict scrutiny); *cf. Cohen v. Cal.*, 403 U.S. 15, 26 (1971) (“[W]e cannot indulge the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process.”); *New Kids on the Block v. News America Publ’g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) (“[W]e need not belabor the point that some words, phrases or symbols better convey their intended meanings than others.”).

And the same logic applies to the use of a title as an “umbrella brand to promote and sell music and other commercial products” such as “online

⁴ When such intertwining occurs, the First Amendment dictates that the trademark-using speech must be treated as noncommercial. *Riley v. Nat’l Fed’n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988) (“[W]e do not believe that the speech retains its commercial character when it is inextricably intertwined with otherwise fully protected speech”); *Mattel*, 296 F.3d at 906-07 (the commercial purpose of using “Barbie” in a song title was “inextricably intertwined” with the “expressive elements” of the song) (citations omitted); *Parks v. LaFace Records*, 329 F.3d 437, 449 (6th Cir. 2003) (“[I]f a song is sold, and the title is protected by the First Amendment, the title naturally will be ‘inextricably intertwined’ with the song’s commercial promotion.”) (citations omitted).

advertising, live events, and the sale or licensing of consumer goods,” *Twentieth Century Fox*, 875 F.3d at 1196-97 (applying *Rogers* to the mark “Empire”). Likewise, in *Mattel, Inc. v. Walking Mountain Productions*, this Court applied *Rogers* to the title of a series of 78 distinct photographs because the series title—“Food Chain Barbie”—was relevant to the photographs’ underlying parodic message. 353 F.3d 792 (9th Cir. 2003); *see also generally Jackson v. Netflix*, 506 F. Supp. 3d 1007 (C.D. Cal. 2020) (applying *Rogers* to the docuseries *Tiger King*). For the reasons given in Part I.A, this reasoning applies with at least equal force to news and opinion.

“Punchbowl News” is therefore within the scope of *Rogers* even though it contains many separate articles. Titles of online news publications create unifying themes that reflect their underlying content and are properly covered by the *Rogers* test. Likewise, when domain names are “used for . . . expressive purpose[s] such as commentary, parody, news reporting, [and] criticism,” they constitute protected speech. *Name.Space, Inc. v. Network Solutions, Inc.*, 202 F.3d 573, 586 (2d Cir. 2000). Domain names, like a film title, “communicate[] or express[] points of view,” *VIP*

Prods. LLC v. Jack Daniel's Props, Inc., 953 F.3d 1170, 1174-75 (9th Cir. 2020).

Of course, there is nothing new about these observations: It is commonplace to see publication titles serve expressive functions by communicating the publishers' viewpoints and approaches. For example,

- VICE Media is a news, music, and digital content brand that targets “next gen” readers; its title reflects that it often writes about the counterculture (including drugs) and subversive ideas. *See VICE Media Becomes One of the First News Organizations to go Pure IP*, Imagine Commc’ns, <https://imaginecommunications.com/customer-success-stories/vice-media/>.
- Paste Magazine covers music, television, the arts, and lifestyle content; its name, Paste, evokes artistic endeavors. *See About, Paste Mag.*, <https://www.pastemagazine.com/about>.
- Pitchfork is a music criticism and commentary website. Its title both refers to music (“Pitch” and tuning “fork”), and to criticism, because “Pitchfork” evokes angry villagers waving pitchforks. *Pitchfork*, <https://pitchfork.com> (last visited Nov. 6, 2021).

The existence of unrelated trademarks using the same words does nothing to change the strength of these publications' First Amendment interests in choosing names that signify their subject matter and outlook. And, as these examples highlight, a title does not have to be used again in the content of individual articles to merit this protection—it affects the tone and perception of the entire publication. Punchbowl News is as entitled to use its name, with its suggestion of a casual, insider's take on political coverage of the Capitol, as the others are to use theirs.

Instead of accepting the law of this Circuit, Plaintiff repeatedly suggests that AJ Press should be forced to choose another name to cover politics. App. Br. at 9, 33. This is the long and rightly-rejected “adequate alternatives” approach that applies to physical time, place and manner restrictions on speech, but not to content-based restrictions on what words a defendant can use; it is flatly inconsistent with *Rogers*. See *Rogers*, 875 F.2d at 999 n.4; *Parks*, 329 F.3d at 450 (“To suggest that other words can be used as well to express an author's or composer's message is not a proper test for weighing First Amendment rights.”); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 971 (10th Cir. 1996).

II. The “Punchbowl News” name is not explicitly misleading

Plaintiff does not (and cannot) seriously claim that “Punchbowl” is expressively irrelevant to a news publication about the Capitol. Instead, Plaintiff tries to convince this Court to reinterpret the *Rogers* exception for explicitly misleading titles (e.g., the unauthorized “Authorized Ginger Rogers Cookbook”) to include some *implicitly* misleading titles. The Court should not do so.

A. The Capitol-related meaning of Punchbowl precludes any finding of explicit misleadingness

The label “Punchbowl” crisply conveys three related messages about the Punchbowl News publication. First, “Punchbowl” is the Secret Service’s nickname for the Capitol. Ben Smith, *They Seem to Think the Next Four Years Will Be Normal*, N.Y. Times (Jan. 3, 2021). This informs readers that this is a site about Washington, D.C. politics.

Second, the label is an inside term, which signals to informed readers that they are getting an insider’s perspective on the D.C. political scene.

Third, precisely because it is an irreverent nickname, which suggests a boozy party, “Punchbowl News” conveys the message about the publication’s tone: edgy, self-aware, fun, and not taking its subject too seriously. (A good comparison might be the title *Above The Law* used by the

online publication about the legal profession, <http://abovethelaw.com>.)

Punchbowl News’ logo—an inverted and tilted Capitol Building filled with bright pink punch—likewise evokes this playful quality:



Because of this readily perceptible Capitol news-related meaning of “Punchbowl” in the context of a Capitol news website, it is impossible to conclude that the term explicitly and unambiguously communicates instead that Plaintiff is the source of the news. *Cf. Pomegranate Communications, Inc. v. Sourcebooks, Inc.*, 2019 WL 7476688, 19-cv-00119-AC, at *6 (D. Or. Dec. 16, 2019) (holding that, where a term had a preexisting meaning not tied to the plaintiff’s trademark, its use in a title could not be explicitly misleading, even though both parties published books on related topics).

B. Even if the parties used “Punchbowl” to identify the same concept, the use would not be explicitly misleading

1. Explicit misleadingness is a high bar and ambiguous uses, even ambiguous uses on similar products, are not explicitly misleading

To establish that the use of a mark is explicitly misleading, plaintiffs must surmount a “high bar that requires the use to be an explicit indication, overt claim or explicit misstatement about the [work’s] source.” *Dr. Seuss Enter., L.P. v. ComicMix, LLC*, 983 F.3d 443, 462 (9th Cir. 2020). *Rogers* “insulates from restriction titles with at least minimal artistic relevance that are ambiguous or only implicitly misleading.” *Rogers*, 875 F.2d at 1000. Thus, even when the parties’ referent is the same (as in *Rogers* itself), a use is ambiguous when it requires the reader to draw a significant inference: that there is a sponsorship or endorsement relationship between the parties.

Courts’ treatment of this distinction between explicit and implicit claims in Lanham Act § 43(a)(1)(B) false advertising cases is consistent with the treatment of ambiguity in *Rogers*, and can further guide the analysis here. *Cf. Time Warner Cable, Inc. v. DIRECTV, Inc.*, 497 F.3d 144, 158 (2d Cir. 2007) (“[O]nly an unambiguous message can be explicitly false. Therefore, if the language or graphic is susceptible to more than

one reasonable interpretation, the[n it] . . . cannot be literally false.”); *United Indus. Corp. v. Clorox Co.*, 140 F.3d 1175, 1181 (8th Cir. 1998) (“The greater the degree to which a message relies upon the viewer or consumer to integrate its components and draw the apparent conclusion, . . . the less likely it is that a finding of literal falsity will be supported. Commercial claims that are implicit, attenuated, or merely suggestive usually cannot be characterized as literally false.”); *Suzie’s Brewery Co. v. Anheuser-Busch Cos.*, 519 F. Supp. 3d 839, 846 (D. Or. 2021) (“[I]f the language . . . is susceptible to more than one reasonable interpretation, the advertisement cannot be literally false.”); *SmithKline Beecham Consumer Healthcare, L.P. v. Johnson & Johnson-Merck Consumer Pharms. Co.*, 2001 WL 588846, No. 1 Civ. 2775 (DAB), at *8 (S.D.N.Y. June 1, 2001) (same; ads with “several plausible meanings” are not explicitly false).

Here, AJ Press’ use of the “Punchbowl” mark is not explicitly misleading as to its source or content; AJ Press’ political content website in no way alludes to plaintiff’s greeting card business. Their lines of business are sharply different. There is no explicit reference to Plaintiff’s greeting card business on AJ Press’ website. The taglines on the parties’ landing

pages make clear that they deal in completely different products and services: “Power. People. Politics.” as opposed to “The Gold Standard in Online Invitations & Greeting Cards.”⁵ And of course the word “News” in “Punchbowl News” clearly labels it as a news site, not a greeting card and invitation company. Any mistaken inference that the parties were connected would be based only on implication, which is insufficient under *Rogers*.

2. Source-identifying use is not the “same” use

Plaintiff argues that, because AJ Press and Plaintiff offer their goods and services “to consumers of online services via the same channels of trade,” which is to say online (App. Br. at 26), and because they use the same word “Punchbowl” as a “source-identifier,” AJ Press’s use falls outside of *Rogers*, (*id.* at 28).⁶ This manipulation of the level of generality at which to assess parties’ uses is both illogical and foreclosed by precedent.

⁵ Punchbowl, <https://www.punchbowl.com> (last visited Nov. 6, 2021); Punchbowl News, <https://punchbowl.news> (last visited Nov. 6, 2021).

⁶ Plaintiff also points to several complaints it received from people trying to unsubscribe from the AJ Press newsletter. App. Br. at 36. But survey evidence of actual confusion (much less mere anecdotal evidence) cannot render a work explicitly misleading where, as here, no other factors allow for an inference of deceptive intent. *See, e.g., Dr. Seuss Enter.*, 983 F.3d at 462 (rejecting plaintiff’s “evidence of consumer confusion in its

That the parties both use the internet does nothing to make their products and services the same. *Compare, e.g.*, USA Medical and Surgical Supplies, <https://www.usamedicalsurgical.com> (last visited Dec. 16, 2021) (medical equipment) *with* Artistic Yarn By Abi, <https://www.artistic yarnbyabi.com> (last visited Dec. 16, 2021) (hand-dyed yarn).

Nor does use as a mark for a different communicative product make the parties' uses the "same" for purposes of *Rogers*.⁷ Plaintiff has confused the doctrine of descriptive fair use, which only applies to non-trademark uses, 15 U.S.C. § 1115(b)(4). with the First Amendment-protective *Rogers* doctrine. This Court has repeatedly reaffirmed that "use of [a] mark alone is not enough" to make a use explicitly misleading.

expert survey"); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013) (holding that survey evidence showing that the majority of consumers believe that identifying marks cannot be included in games without permission "changes nothing" in the *Rogers* analysis without explicit misleadingness); *Rogers*, 875 F.2d at 1001 (holding for the defendant despite survey evidence of actual confusion; consumer misunderstanding was "not engendered by any overt claim").

⁷ The Supreme Court has made clear that trademarks regularly have significant noncommercially expressive components while they are being used as marks, *Matal v. Tam*, 137 S.Ct. 1744, 1752, 1760 (2017), further refuting Plaintiff's claim that trademark use should make a difference to the *Rogers* analysis.

Twentieth Century Fox, 875 F.3d at 1199 (quoting *Rogers*, 875 F.2d at 1001).

Overlap in product categories, likewise, does not render a use “explicitly” misleading: *Twentieth Century Fox* involved parties who both used “Empire” as a brand for entertainment services; *Mattel* involved parties who both provided entertainment services; *Dr. Seuss Enterprises* involved parties who both produced inspirational illustrated books; and *Rogers* itself involved parties who both used the term “Ginger Rogers” for movies. These cases make clear that even significant overlap in products and services do not make a use “explicitly” misleading.

Uses that serve a trademark or “branding” function have always been covered by *Rogers*. Indeed, *Gordon v. Drape Creative* explicitly stated that the uses in *Twentieth Century Fox* were not “the same” in a relevant way, even though Twentieth Century Fox concededly used “Empire” to brand a range of goods and services. *See Gordon v. Drape Creative*, 909 F.3d 257, 270 (9th Cir. 2018) (emphasizing that use as the name of a record label was a different “context” than use as the brand for a TV show and related material about a fictional record label); *Twentieth Century Fox*, 875 F.3d at 1196-97 (holding that “Fox’s use of the Empire mark as

an umbrella *brand* to promote and sell music and other commercial products” did not exclude it from *Rogers*, given that a television show and music releases “lie at the heart of its Empire *brand*”) (cleaned up) (emphasis added).

As this caselaw illustrates, Plaintiff’s “source identifier” concept is the wrong level of generality for the inquiry into whether the parties’ uses are the same. In every case of alleged trademark infringement, the plaintiff’s claim is that the defendant’s use causes confusion because consumers perceive the defendant’s use as an identifier of source or sponsorship by the plaintiff. *See, e.g., Mattel*, 296 F.3d at 900. If use as a source identifier meant that the parties were making the “same” use, *Rogers* would provide no First Amendment protection for the titles of noncommercial speech at all.

If Appellee were selling the exact same specific services as Plaintiff, the argument would at least be at the proper level of generality. It is telling that Plaintiff does not attempt to argue that the parties’ goods or services are completely interchangeable (as the Court apparently believed was the situation in *Gordon*, the “Honey Badger” case). It is implausible that, especially in 2021, online consumers would search for

greeting cards and mistakenly wind up buying subscriptions to political commentary websites. *Cf. Multi Time Machine, Inc. v. Amazon.com, Inc.*, 804 F.3d 930, 937 (9th Cir. 2015) (“[T]he default degree of [online] consumer care is becoming more heightened as the novelty of the Internet evaporates and online commerce becomes commonplace.”) (citation omitted).

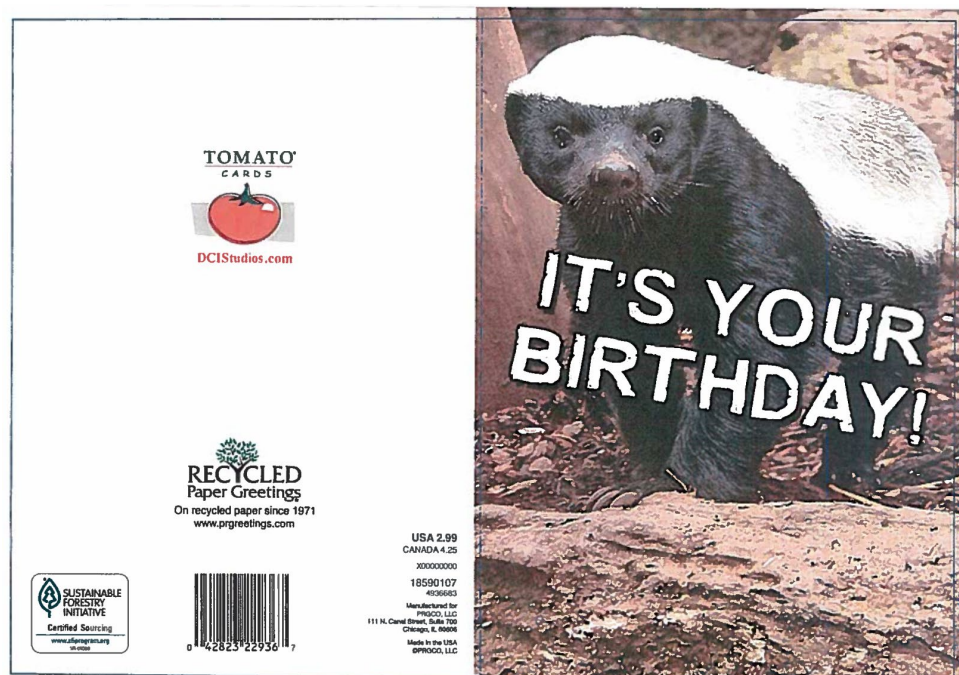
A publication that was a direct substitute that used only a famous title with no plausible alternate reference could raise an inference of fraudulent intent, but that is not the case here.⁸ Even if it were, the First Amendment would require a remedy other than suppression of speech, such as a disclaimer. The First Amendment protects similar titles against confusion claims where the speaker provides means to distinguish the works. *See Cliffs Notes, Inc.*, 886 F.2d at 496; *Yankee Publ’g Inc. v. News America Publ’g Inc.*, 809 F. Supp. 267, 279-80 (S.D.N.Y. 1992).

⁸ Overlap in titles is common and innocuous. *See Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 484 (9th Cir. 2000) (noting that 129 songs called “Love is a Wonderful Thing” were registered with the Copyright Office).

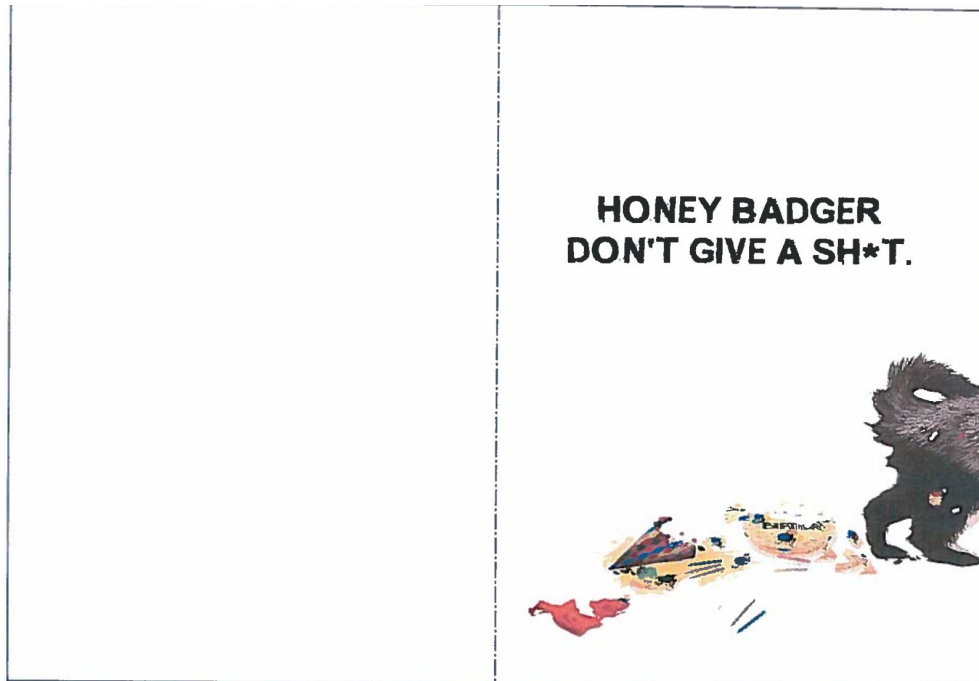
3. A publication's title cannot be separated from its content for *Rogers* purposes

Relatedly, Plaintiff tries to isolate the title of Appellee's publication from the rest of its expression in order to argue that its use is explicitly misleading because the confusion is caused by the use of the title alone. But this claim is a misreading of precedent. A plaintiff cannot divide a work into parts and then say that one part constitutes use of a putative mark "alone."

It is clear that the content of the entire work in *Gordon* was not much more than the claimed catchphrases (and related visual) HONEY BADGER DON'T CARE/HONEY BADGER DON'T GIVE A SH*T:



Exterior of card in Gordon v. Drape Creative

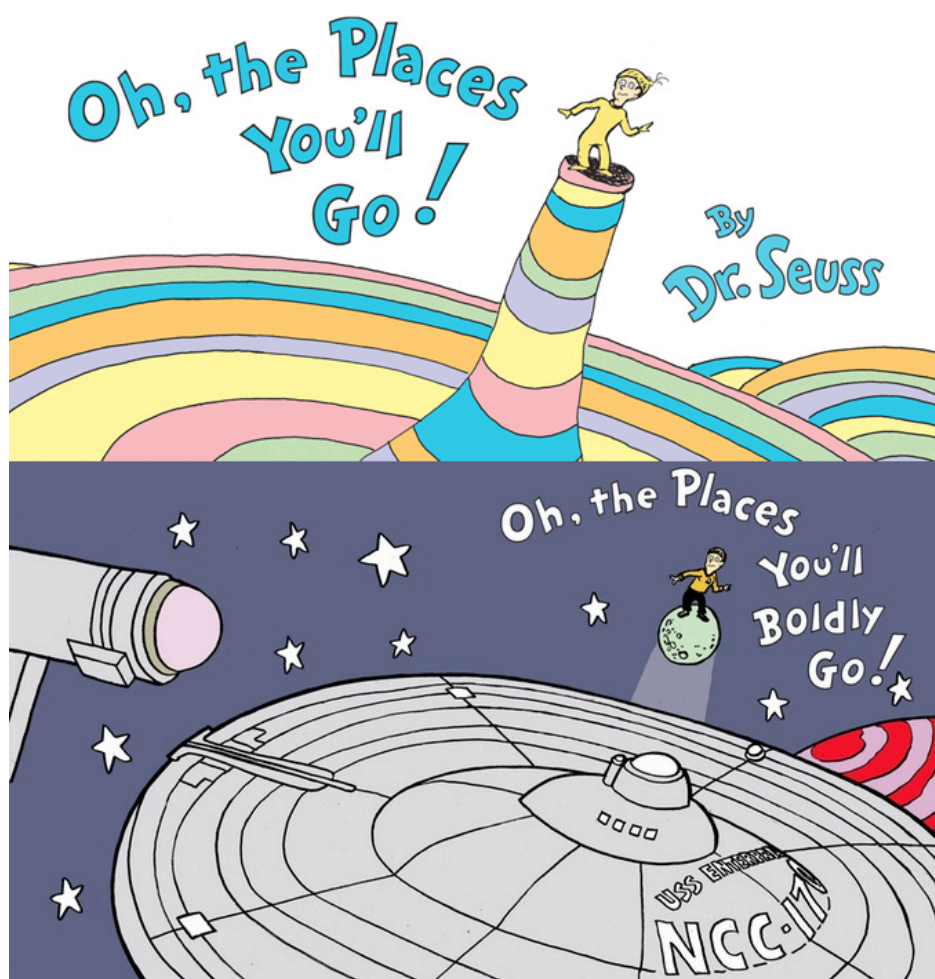


Interior of card in Gordon v. Drape Creative

But *Gordon* made clear that a title must be considered in the context of the underlying work. *Gordon* explicitly held that when a mark is used as “the title of an expressive work—such as the title of a movie, a song, a photograph, or a television show—the mark obviously serve[s] as only one element of the [work] and the [junior user’s] artistic expressions.” *Gordon*, 909 F.3d at 271 (citations omitted). Such use “at most implicitly suggest[s] that the product is associated with the mark’s owner,” which is insufficient to take a use outside of the protections of *Rogers*. *Id.*

By contrast with *Gordon*, *ComicMix* involved a work with extensive new expressive content. Even though that new content infringed the

copyright in Seuss' works, this Court applied *Rogers* to the trademark claim and found that the new content still constituted relevant additional expression under *Rogers*, meaning that the use of Dr. Seuss' trademarks was not "explicitly misleading." *Dr. Seuss Enter.*, 983 F.3d at 462-63.



Covers of Plaintiff's and Defendant's Works in ComicMix

Plaintiff is not alleging infringement based on the use of the disputed mark on shirts bearing only the word "Punchbowl," or greeting cards bearing only the punchline "Punchbowl" inside. AJ Press reports on news

under the name “Punchbowl,” adding at least as much additional expression as was present in *ComicMix*. The parties’ works are thus not relevantly “the same.”

Conclusion

Rogers has been the law for decades, and Plaintiff’s very short parade of horrors (App. Br. at 36) has not materialized, nor is it clear how consumers would suffer if it did. Instead, we enjoy publications such as Tim Carmody’s Amazon Chronicles, <https://amazonchronicles.substack.com/>; Reese’s Book Club (online book club and related businesses helmed by Reese Witherspoon, despite multiple earlier registrations of Reese’s for candy); and Politico’s Playbook (despite others’ earlier registered PLAYBOOK marks for, inter alia, sports magazines, Reg Nos. 3221914/5431692, reference manuals, Reg No. 3129571, and mobile learning platform software, Reg. No. 5464766).

Political reporting and opinion are core First-Amendment-protected expression. *Rogers*, therefore, protects titles of such works. The title “Punchbowl News” is expressively relevant, because it expresses the

site's focus and tone—an irreverent inside look at Washington, D.C. politics—and it is not explicitly misleading. This Court should thus affirm the decision below.

Respectfully Submitted,

s/ Eugene Volokh

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December 21, 2021

Certificate of Compliance

This brief contains 4,713 words, excluding the items exempted by Fed. R. App. P. 32(f). The brief's type size and typeface comply with Fed. R. App. P. 32(a)(5) and (6). The brief complies with the word limit of Fed. R. App. P. 29(a)(5).

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