

Docket No. 21-55881

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

PUNCHBOWL, INC., a Delaware corporation,

Plaintiff-Appellant

vs.

AJ PRESS, LLC, a Delaware limited liability company,

Defendant-Appellee

On Appeal from the United States District Court
for the Central District of California
(Honorable Stephen V. Wilson presiding)
No. 2:21-cv-03010-SVW-MAR

**APPELLEE'S SUPPLEMENTAL BRIEF REGARDING *JACK DANIEL'S
PROPERTIES, INC. V. VIP PRODUCTS, LLC*, 143 S. CT. 1578 (2023)**

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I. INTRODUCTION

Remand is neither necessary nor appropriate. In *Jack Daniel's Properties, Inc. v. VIP Products LLC*, 143 S. Ct. 1578 (2023) (“VIP”), the Supreme Court held that the *Rogers* test should not be applied when a defendant uses a plaintiff’s trademark as a source-identifier. That is not the case here.

In *VIP*, it was undisputed that the defendant’s BAD SPANIELS mark was a deliberate variation of the plaintiff’s JACK DANIELS mark, as bolstered by the fact that the defendant had registered multiple variations of famous trademarks as brands that poked fun at the genuine liquor brand owner. *VIP*, 143 S. Ct. at 1582. Here, by contrast, it is unrefuted that AJ Press uses *Punchbowl News* and *Punchbowl Press* because “punchbowl” is the Secret Service code name for the U.S. Capitol. *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091, 1095-96 (9th Cir. 2022). There is “no indication [in the record] that AJ Press has sought to tie *Punchbowl News* to Punchbowl’s event planning products.” *Id.* at 1101 (emphasis added). Unlike in *VIP*, *Punchbowl News* has *nothing* to do with plaintiff’s unrelated mark.

Punchbowl is a “common English word.” *Twentieth Century Fox Television v. Empire Distribution, Inc.*, 875 F.3d 1192, 1198 (9th Cir. 2017) (“Fox”). While *VIP* holds that *Rogers* is inapplicable where a party uses a third party’s mark as its source-identifier, the First Amendment *Rogers* test is still applicable and controlling in this circuit where, as here, a defendant merely uses a common English language

word as a title for a legitimate, expressive publication (news reporting and commentary). Whether *Rogers* applies to AJ Press’s use of the common English language word “punchbowl” is a legal issue that should be decided by this Court, not a factual question requiring remand.

Moreover, even assuming that *VIP* applies to the use of a common English language word—not a plaintiff’s trademark—remand is inappropriate. After full summary judgment briefing, “replete with evidence as to how both companies used the name ‘Punchbowl’ in their operations,” *Punchbowl*, 52 F.4th at 1104, this Court held that “AJ Press does not use the Punchbowl Mark as a bare source-identifier.” *Id.* at 1100. Accordingly, the Supreme Court’s holding that *Rogers* does not apply “when the accused infringer has used a trademark to designate the source of its own goods” does not require disturbing this Court’s prior order affirming the entry of summary judgment in AJ Press’s favor. *VIP*, 143 S. Ct. at 1583.

II. ARGUMENT

A. *VIP* Does Not Hold That The Use Of A Common English Language Word In The Title Of A News Publication Is Outside First Amendment Protection

The Supreme Court in *VIP* made clear that it ruled, narrowly, “only” that the *Rogers* test “is not appropriate when the accused infringer has used a trademark to designate the source of its own goods” *Id.* Stated differently, the Supreme Court

held that *Rogers* “does not [apply] when an alleged infringer uses a trademark in the way the Lanham Act cares about: as a designation of source for the infringer’s own goods.” *VIP*, 143 S. Ct. at 1587. In other words, *Rogers* does not apply “when someone uses another’s trademark as a trademark” *Id.* at 1589. That is not the case here.

Despite Appellant’s allegations in its complaint, there is no evidence in the record that AJ Press uses Appellant’s mark at all. Rather, it is unrefuted that AJ Press uses *Punchbowl News* and *Punchbowl Press* because the common English language word “punchbowl” is the secret service code name for the U.S. Capitol. *Punchbowl*, 52 F.4th at 1095. As this Court held based on the “ample evidence as to how both companies used the name ‘Punchbowl’ in their operations,” *id.* at 1104, “AJ Press does not just use the word ‘Punchbowl,’ but *Punchbowl News*,” *id.* at 1101. AJ Press’s use of the ubiquitous word “punchbowl” is nothing like VIP Products’ evocation of Jack Daniel’s trademarks and trade dress to make a product that was designed to poke fun at Jack Daniel’s. *See VIP*, 143 S. Ct. at 1582, 1584-85.

The Supreme Court’s discussion in *VIP* of other cases where *Rogers* was properly applied shows that *Rogers* remains applicable here. The Supreme Court cited with approval the Ninth Circuit’s opinion in *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901 (9th Cir. 2002), where the defendant used plaintiff’s exact BARBIE trademark in a popular song, but not as a source identifier. *See VIP*, 143 S.

Ct. at 1588. The Supreme Court also emphasized that *Rogers* applied in *Louis Vuitton Mallatier, S.A. v. Warner Bros. Entm't Inc.*, 868 F. Supp. 2d 172 (S.D.N.Y. 2012), because Warner Bros. “was not using the Louis Vuitton mark as its “own identifying trademark” when it used the exact Louis Vuitton mark to refer to luggage in a motion picture. *VIP*, 143 S. Ct. at 1588 (quoting *Warner Bros.*, 868 F. Supp. 2d at 180). As a consequence, confusion would be unlikely and the interest in free expression counseled “in favor of avoiding the standard Lanham Act test.” *VIP*, 143 S. Ct. at 1588 (citing *Warner Bros.*).

Here, as in *Mattel* and *Warner Bros.*, AJ Press is not using Appellant’s mark as a source identifier, because it is not using Appellant’s mark at all. AJ Press has simply chosen a title for its publication that includes a common English language word that plaintiff (and likely countless other companies) use in trademarks for various different products. AJ Press’s use of “punchbowl” is, therefore, even more squarely within the *Rogers*’s framework than Warner Bros.’s use of Louis Vuitton’s exact mark to refer to luggage in a motion picture, or MCA’s use of Mattel’s exact mark in a pop song, since AJ Press is not referring to Appellant by any stretch of understanding. Here, “[t]he name Punchbowl News itself (in addition to the underlying publications) undoubtedly communicates a perspective on the subjects it covers.” *Punchbowl*, 52 F.4th at 1100.

While *VIP* instructs when *Rogers* would *not* apply, it is factually different from the present case. Indeed, this case is different from many *Rogers* cases because it doesn't involve *any* evidence of the defendant using the plaintiff's mark—not as a trademark, or a nontrademark, or at all—this case is about AJ Press's use of a common English language word in the title for its news reporting and political commentary. Indeed, this Court has warned against the application of the ordinary likelihood-of-confusion test when a trademark owner attempts to use the Lanham Act “to control public discourse,” which can occur where marks like “Rolls-Royce or Band-Aid ‘enter our public discourse and become an integral part of our vocabulary.’” *Fox*, 875 F.3d at 1197-98.

Nothing in *VIP*'s “narrow” ruling disturbs this Court's precedent in *Fox* on the core purpose for the *Rogers* test. If *Rogers* is necessary to curb the ability for Rolls-Royce or Band-Aid to use their trademarks to control how we express ourselves, surely *Rogers* is appropriately applied when a plaintiff seeks to control how the common English language word “punchbowl” is used to promote news reporting and political commentary—primary First Amendment interests. *VIP* does not give a license to every trademark owner to monopolize unrelated uses of common English language words when there is no evidence in the record of any intent to trade on the plaintiff's mark. *See Caiz v. Roberts*, 382 F. Supp. 3d 942, 945, 949 (C.D. Cal. 2019) (*Rogers* applied to defendant's use of common English

language word “mastermind,” which was also plaintiff’s registered mark, in connection with music album and use of the word “mastermind” on tour; no evidence of an affiliation between defendant’s use of “mastermind” and plaintiff); *Hidden City Philadelphia v. ABC, Inc.*, No. CV 18-65, 2019 WL 1003637, at *1, *4-5 (E.D. Pa. Mar. 1, 2019) (*Rogers* applied to ABC’s use of the common English language word “hidden” in title of a show “Hidden City Philadelphia,” because of the journalistic nature of ABC’s videos, and where plaintiff, owner of the “Hidden City Philadelphia” mark, alleged no facts suggesting an affiliation between ABC’s journalistic video series about Philadelphia and plaintiff’s non-profit that used the same common English language word “hidden” in a trademark); *Novalogic, Inc. v. Activision Blizzard, Inc.*, 41 F. Supp. 3d 885, 890, 893, 902 n.21 (C.D. Cal. 2013) (*Rogers* applied to Activision’s use of “Delta Force”, the name of a “widely known U.S. Army Special Forces unit” as well as the name of plaintiff’s registered mark, in Activision’s video game and related strategy guide, including when used in the titles of subsections of the guide covering “Delta Force missions” in which a fictional version of the unit was featured).

The Supreme Court in *VIP* made clear it was not disturbing *Rogers* case law—merely explaining when it would not apply. 143 S. Ct. at 1587 (holding that *Rogers* did not apply where “VIP used . . . marks derived from Jack Daniel’s” “[w]ithout deciding whether *Rogers* has merit in other contexts” and rejecting both parties’

arguments “attacking or defending *Rogers* in all its possible applications” as overbroad). Because AJ Press is not using Appellant’s mark but a common English language word as part of the title of its news reporting and political commentary publication, this Court’s finding that *Rogers* applies to Appellant’s trademark infringement claims should not be disturbed.

B. Affirming The District Court’s Entry Of Summary Judgment Is Consistent With *VIP*

Even if *VIP* could be broadly construed to exclude from *Rogers*’ purview common English language words, and not merely instances where a defendant uses a plaintiff’s mark as a mark, remand is still inappropriate. This Court has already held that “AJ Press does *not* use the Punchbowl Mark as a bare source-identifier.”

Id. at 1100. As this Court held:

As will be discussed in more detail below, AJ Press uses the name “Punchbowl,” often in conjunction with its slogan and logo, to broadcast a unifying theme that reflects its focus on insider politics in Washington. And it typically uses “Punchbowl” in the title “*Punchbowl News*,” or through an otherwise obvious connection to its news reporting. The name *Punchbowl News* itself (in addition to the underlying publications) undoubtedly communicates a perspective on the subjects it covers.

Id. (citing *VIP Prods., LLC v. Jack Daniel’s Prods. Inc.*, 953 F.3d 1170, 1174 (9th Cir. 2020), *vacated on other grounds*, 143 S. Ct. 1578 (2023) (citing *Mattel*, 296

F.3d at 900)).¹ AJ Press “frequently promotes its connection to its founders,” including by stating at the top of its publications “near the name ‘Punchbowl News,’ that they are ‘by John Bresnahan, Anna Palmer, and Jake Sherman.’” *Id.* at 1096. Accordingly, the undisputed evidence in the record shows that any identification of source on *Punchbowl News* is of AJ Press’s founders—not Appellant or its “punchbowl” mark. *See also id.* at 1101-02 (further elaborating on the finding that AJ Press merely used a “common English word” as part of a “quite different” use and that any concern about consumers being misled was allayed because “Punchbowl” “is only a part of *Punchbowl News*’s overall branding, which, as noted, includes a slogan and a logo” and the public association with its founders); *Dr. Seuss*

¹ When this Court cited *VIP Prods. LLC v. Jack Daniel’s Prods., Inc.*, 953 F.3d 1170, 1174 (9th Cir. 2020) (“*VIP Prods.*”) at *Punchbowl*, 52 F.4th at 1100, this Court did not rely on *VIP Prods.* for any holdings that have been vacated by the Supreme Court. Rather, this Court cited *VIP Prods.* for the proposition that: “In determining whether a work is expressive, we analyze whether the work is ‘communicating ideas or expressing points of view.’” *VIP Prods.*, 953 F.3d at 1174 (quoting *Mattel*, 296 F.3d at 901; citing *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241 (9th Cir. 2013); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987)). This Court’s holding from *Mattel*, the genesis of this Court’s citation to *VIP Prods.* in *Punchbowl*, 52 F.4th at 1100, was upheld by the Supreme Court in *VIP*. In *VIP*, the Supreme Court discussed *Mattel* as an example of a case where *Rogers* should be applied because a “trademark is used not to designate a work’s source, but solely to perform some other expressive function.” *VIP*, 143 S. Ct. at 1588 (citing *Mattel*, 296 F.3d at 901)). Thus, nothing from *VIP* disturbs this Court’s precedent in *Mattel*, cited in *VIP Prods.* and *Punchbowl*, that *Rogers* should be applied where a mark is not used for bare source identification but to “communicat[e] ideas or express[] points of view,” as AJ Press did here. *Punchbowl*, 52 F.4th at 1100.

Enters., L.P. v. ComicMix LLC, 983 F.3d 443, 463 (9th Cir. 2020) (use of marks with the same kind of book as senior user not explicitly misleading where junior user conspicuously listed its authors on the cover of the book); *Mattel*, 296 F.3d at 902 (applying *Rogers* to use of plaintiff’s exact BARBIE mark in the title of a song where “[t]he only indication that Mattel might be associated with the song is the use of Barbie in the title”).

This case is, therefore, far removed from those that the Supreme Court has held are not subject to *Rogers*, where “the name of a product [is] more likely to indicate its source, and to be taken by consumers in just that way.” *VIP*, 143 S. Ct. at 1587 (citing *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989)). This Court held that AJ Press does not use “punchbowl” as a source-identifier following summary judgment with a full record that was “replete with evidence as to how both companies used the name ‘Punchbowl’ in their operations.” *Punchbowl*, 52 F.4th at 1104. Remand is not, therefore, appropriate to determine whether AJ Press has used Appellant’s mark as a source identifier.

Because this Court has found that AJ Press does not use “Punchbowl” as a bare source-identifier, it remains subject to *Rogers* under binding Ninth Circuit precedent.

III. CONCLUSION

Remand is not necessary or appropriate under *VIP because* whether *Rogers* applies here is a legal question to be decided by the Court following the District Court's entry of summary judgment, not a factual question requiring remand.

First, The Supreme Court's holding that *Rogers* does not apply when a defendant uses a plaintiff's trademark as a mark does not require remand because AJ Press has not used Appellant's mark, but a common English language word. Nothing in *VIP* disturbs this Court's prior holding that *Rogers* should be applied when a trademark owner attempts to use a mark to control everyday public parlance, such as the use of the ubiquitous word "punchbowl" as part of the title of a news reporting and political commentary publication. Second, this Court has already found that AJ Press does not use "punchbowl" as a bare source-identifier. This Court's holding is, therefore, outside the narrow limitation on *Rogers* adopted in *VIP*. Remand is not warranted.

Dated: June 30, 2023

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

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

FORM 8. CERTIFICATE OF COMPLIANCE FOR BRIEFS

9th Cir. Case Number: 21-55881

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Signature /s/ Ian C. Ballon

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