Jack Daniel’s and the Unfulfilled Promise of Trademark Use

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Jack Daniel's and the Unfulfilled Promise of Trademark Use

By Stacey Dogan* & Jessica Silbey##

In Jack Daniel’s v. VIP Products, the Supreme Court announced a bright-line rule: whatever speech protections govern the use of trademarks in artistic works, no such rule applies “when an alleged infringer uses a trademark in the way the Lanham Act most cares about: as a designation of source for the infringer’s own goods.”¹ Those who engage in “trademark use,” in other words, must face the usual likelihood-of-confusion standard, regardless of whether their use also has expressive dimensions. Other, non-trademark uses may require a different, more speech-protective rule; the Court takes no position on that question.² But, after Jack Daniel’s and unless Congress amends the Lanham Act, trademark law appears to offer no special protection to defendants who use marks in expressive but source-indicating ways.

Justice Kagan, writing for the Court,³ presents the use/non-use distinction as analytically straightforward and implicit in the prior case law. In particular, she views Rogers v. Grimaldi, the seminal authority on expressive uses of trademarks, as a case involving non-trademark use.⁴ As a result, her opinion can avoid the hard question that may well divide the Court: whether Rogers remains good law for non-trademark uses.⁵ But the opinion leaves no doubt about the existence of a non-trademark-use category, and it clearly intends that category to include expressive uses like the film title in Rogers, along with uses in movie scenes, songs, books, and video games.⁶ Kagan, moreover, appears open to the idea that the First Amendment requires a different analytical approach for these uses, whether under Rogers or some other alternative to the standard infringement test.⁷

Unfortunately, the opinion offers scant guidance, beyond illustrative examples, for how courts should distinguish between trademark use and non-trademark use. The Court defines trademark use “as a designation of source for the infringer’s own goods.”⁸ But the opinion misses an important nuance in Rogers: the recognition that predominantly expressive uses often have commercial dimensions.⁹ Rogers crafted a new legal standard not because expressive uses can never signal source, but because the risk of consumer confusion usually pales in comparison to the speech interests in those cases. Unlike the use of trademarks on “ordinary commercial

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¹ See id. at 1587, 1588.
² See id. at 1587, 1588.
³ Justice Sotomayor (for herself and Justice Alito) and Justice Gorsuch (for Justices Thomas, Barrett, and himself) joined the opinion in full but wrote separate concurrences.
⁴ Id. at 999-1000 (citing Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989)). The use of the title in Rogers could be read otherwise, of course — as both source-designating in a trademark way as well as merely descriptive and largely expressive. That confusion was part of why the Court developed the “Roger’s” test in the first place.
⁵ See Jack Daniel’s, 599 U.S. at 165 (Gorsuch, J., concurring).
⁶ Id. at 154-55 (Kagan, J.).
⁷ Id. (describing rationale of courts that applied Rogers to protect expressive non-trademark uses).
⁸ Id. at 153.
⁹ Rogers, 875 F.2d at 998 (“The artistic and commercial aspects of titles are inextricably intertwined.”).
products,” Rogers proposed that the use of trademarks in expressive works requires a legal standard that takes countervailing speech interests into account.\textsuperscript{10} The Rogers’ test, as it came to be known, aimed to protect expressive uses even when trademark holders might plausibly claim that they confuse as to source. Without discarding the Rogers’ test, Justice Kagan’s decision in Jack Daniel’s nonetheless grafts a “trademark use” doctrine onto it, reframing the balance Rogers struck. In doing so, the Supreme Court appears to have reshaped what the Second Circuit meant when it referred to “expressive uses” of marks.

Because the defendant in Jack Daniel’s conceded that it was engaged in trademark use, the majority had no need to tease out the trademark use/non-trademark use distinction in the case before it.\textsuperscript{11} Its failure to do so, however, has begun to wreak havoc in the lower courts. The case law since Jack Daniel’s reflects confusion over what Justice Kagan meant by trademark use.\textsuperscript{12} Rather than limiting trademark use to the narrow, brand-oriented uses described in Jack Daniel’s, some courts have extended it to other contexts involving more attenuated forms of alleged confusion. Indeed, courts have found trademark use in the very situations that Kagan treated as prototypical non-trademark uses, including use in movie titles and TV shows.\textsuperscript{13} The courts have subjected these expressive non-trademark uses to likelihood-of-confusion analysis rather than relying on the Rogers test. If this trend continues, Jack Daniel’s will effectively overrule Rogers for a wide range of expressive uses, notwithstanding Justice Kagan’s stated intent to avoid that result.

While Justice Kagan could have spoken more clearly, we believe that the full opinion leaves no doubt: “trademark use,” for purposes of deciding whether any threshold speech protection may apply, includes only uses that would support a defendant’s claim to trademark rights in the mark (assuming its use was not infringing). Uses as product names and business names qualify as trademark use and, under Jack Daniel’s, require consideration under the likelihood-of-confusion test.\textsuperscript{14} Other uses – in video games, books, movies, t-shirt designs, and other creative works – are unaffected by Jack Daniel’s and, in most jurisdictions, should be analyzed under Rogers. Of course, the Supreme Court may well take up the Rogers test for these works, as Justice Gorsuch suggests in his concurrence.\textsuperscript{15} But until it does so, Rogers remains good law for uses that do not adopt a trademark as a brand.

\textsuperscript{10} Id.
\textsuperscript{11} Id. at 1591.
\textsuperscript{12} See infra __.
\textsuperscript{13} As a starting point, titles of expressive works are non-trademark uses. Situations may arise, however, when a title gains secondary meaning and can be protected as a trademark, “The test of secondary meaning for literary titles is essentially one of determining whether, in the minds of a significant number of people, the title in question is associated with a single source of the literary work.” 2 McCarthy § 10:10. See also Heirs of the Estate of William F. Jenkins v. Paramount Pictures Corp., 90 F. Supp. 2d 706, 710-11 (E.D. Va. 2000) (explaining that “titles, by their nature, are neither suggestive nor arbitrary; they are instead inherently descriptive or, in some instances, generic. Accordingly, the title of a single expressive work may receive trademark protection only upon a showing that the title is not generic, and that it has acquired secondary meaning” and holding that short story title “First Contact” is generic and not entitled to trademark protection as against movie producer using same title).
\textsuperscript{14} As one of us has previously argued, courts should tread carefully even in these cases, given the interests of sellers and consumers in the subversive device of using brands to critique the commercialism of famous brands. See Stacey L. Dogan & Mark A. Lemley, Parody As Brand, 47 U.C. DAVIS L. REV. 473 (2013). But we agree that parody as brand raises different questions than other expressive uses or trademarks, and thus requires different treatment by the courts.
\textsuperscript{15} Jack Daniel’s, 599 U.S. at 1594 (Gorsuch, J., concurring).
Part I describes the opinions in Rogers and Jack Daniel’s and concludes that trademark use, under Jack Daniel’s, means use as a brand or product name. Part II describes the post-Jack Daniel’s case law that has broadened “trademark use” to encompass uses that Kagan clearly meant to exclude. In Part III, we propose a definition of trademark use that aligns with Justice Kagan’s opinion and serves its stated goals. We also suggest refinements to the likelihood-of-confusion test to account for speech interests in borderline cases. Part IV concludes.

I. Rogers and Jack Daniel’s

The Rogers test comes from a 1989 decision by the Second Circuit, in a dispute over Federico Fellini’s use of “Ginger and Fred” as a film title. The film centered on a pair of French cabaret performers whose dance routine imitated the famous dancers Ginger Rogers and Fred Astaire. Ginger Rogers sued, claiming that the film title violated her right of publicity and created a likelihood of confusion as to her endorsement or involvement in the film. The case made its way to the Second Circuit, where the court crafted a new rule intended to balance the interests of trademark holders against the speech interests of those who use trademarks in expressive works.16 The court began by noting that titles can serve both expressive and commercial functions. “Titles,” Judge Newman observed, “like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. 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.”17 The court noted that enforcing trademark rights based on the commercial elements, without separate attention to the artistic ones, may conflict with the First Amendment. “[W]e must construe the [Lanham] Act narrowly to avoid such a conflict.”18 To do so, the court announced a new standard to substitute for the likelihood-of-confusion test in disputes involving titles of artistic works: “In the context of allegedly misleading titles,” the court held, a trademark claim should not succeed “unless the title [1] has no artistic relevance to the underlying work whatsoever, or, [2] if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.”19 Since the Second Circuit’s decision, courts have routinely used the Rogers test in cases involving use of trademarks in both the title and the body of expressive works like movies, books, songs, and video games.20

Jack Daniels v. VIP involves a trademark dispute between a famous bourbon maker and the manufacturer of a silly, squeaky dog toy. The plaintiff, Jack Daniel’s, needs no introduction; its name and the appearance of its bottle hold a venerable place in the annals of well-known American brands.21 The defendant, VIP, makes rubber squeak toys that imitate those brands, at least partly with the goal of poking fun at them. Its “Silly Squeakers” product line includes a

16 “This appeal presents a conflict between Rogers’ right to protect her celebrated name and the right of others to express themselves freely in their own artistic work.” Id. at 996.
17 Id. at 998 (emphasis added).
18 Id.
19 Id.
20 See cases cited in Jack Daniel’s, 599 U.S. at 1587.
21 See jackdaniels.com.
faux Coca-Cola can with the words “Enjoy Canine Cola,” a yellow bottle-shaped squeaker with the label “Jose Perro Muy Especial,” and a lime-green-colored Mountain-Dew-like bottle-toy called “Mountain Drool.” Some of these trademark holders apparently have a sense of humor, or perhaps they recognize that there’s no such thing as bad publicity. Jack Daniel’s, however, responded to VIP’s “Bad Spaniels” squeaker with a cease-and-desist letter. The letter triggered a declaratory judgment action by VIP, which in turn led to counterclaims for infringement and dilution of the Jack Daniel’s marks.

The Bad Spaniels product, shown below, emulates the color and shape of the Jack Daniel’s bottle and label while changing the name, adding an image of a dog, and substituting snarky, poop-related phrases for the text on the whiskey bottle. “Old No. 7 Brand Tennessee

\[\text{599 U.S. at 1580.}\]
Sour Mash Whiskey” becomes “The Old No. 2 on Your Tennessee Carpet”; the alcohol content is replaced with “40% poo by volume” and “100% smelly.” The toy’s hang tag shows the “Silly Squeakers” logo on one corner, and a smaller version of the “Bad Spaniels” name and dog image on the other. It also features the VIP Products logo on the bottom, alongside a disclosure (in small font) that the “product is not affiliated with Jack Daniel’s Distillery.”

After a bench trial, the District Court ruled in favor of Jack Daniel’s on both infringement and dilution. On dilution, the court found that VIP had tarnished the Jack Daniel’s brand in two ways: by creating associations with poop, and by suggesting that Jack Daniel’s was corrupting children by selling “toys” (albeit dog toys) related to whiskey. The court’s likelihood-of-confusion analysis rested largely on a survey showing that 29% of consumers surveyed believed that Jack Daniel’s had “made, sponsored, or approved” the Bad Spaniel’s product.
On appeal, the Ninth Circuit reversed, concluding that the expressive features of VIP’s use entitled it to rely on Rogers v. Grimaldi for Jack Daniel’s’ infringement claim. The court reasoned that “the Bad Spaniel dog toy, although surely not the equivalent of the Mona Lisa, is an expressive work.” On remand, the district court reluctantly entered judgment for VIP under Rogers. After the Ninth Circuit affirmed, Jack Daniel’s filed certiorari, and the Supreme Court granted its petition and reversed. Without taking a position on Rogers, the Court found it inappropriate to apply any “threshold First Amendment filter” “when an alleged infringer uses a trademark in the way the Lanham Act most cares about: as a designation of source for the infringer’s own goods.” Because VIP Products had not only acknowledged trademark use of “Bad Spaniels” and the look and feel of the toy, but had asserted rights in both the name and trade dress, the Court’s decision meant that it had to defend itself under the usual likelihood-of-confusion test.

While the majority opinion does not address the wisdom of the Rogers test, it takes seriously the possibility that the First Amendment requires some “filter” to protect the use of trademarks in ways that do not indicate source. Justice Kagan takes pains to describe her holding as consistent with Rogers and related case law. In Kagan’s account, the Second Circuit adopted the Rogers test both out of concern for speech protection and because expressive uses rarely threaten confusion as to source:

“[The Rogers court] reasoned that the titles of ‘artistic works,’ like the works themselves, have an ‘expressive element’ implicating ‘First Amendment values.’ And at the same time, such names posed only a ‘slight risk’ of confusing consumers about either ‘the source or the content of the work.’ So, the court concluded, a threshold filter was appropriate.”

After describing the Rogers test, Kagan elaborates further on the nature of the use in Rogers and its progeny: “Over the decades, the lower courts adopting Rogers have confined it to similar cases, in which a trademark is used not to designate a work’s source, but solely to perform some other expressive function.” This conception of Rogers runs in tension with the Second Circuit’s own description of the use in that case. The Rogers court spoke of the “hybrid nature” of film titles, which it thought could include both commercial and expressive messages. While the

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31 VIP Prods., LLC v. Jack Daniel’s Properties, Inc., 953 F.3d 1170, 1175 (9th Cir. 2020). On the dilution claim, the Ninth Circuit found VIP’s use a “noncommercial” use entitled to protection under 15 USC § 1125(c)(3)(A)(ii). Id. at 1176.
32 VIP Products LLC v. Jack Daniel’s Properties, Inc., 953 F.3d 1170, 1175 (9th Cir. 2020).
33 VIP Prods LLC v. Jack Daniel’s Properties Inc., 2021 WL 5710730, at *6 (“Thus, while JDPI finds the depiction of a dog relishing a bowel movement on a carpet distasteful and an abuse of its mark, in the final analysis, JDPI has no means to protect the viability of its trademark. Yet, the Court is bound by Ninth Circuit precedent. For JDPI or similarly situated trademark holders to obtain a different outcome, they must seek relief before the United States Supreme Court or the United States Congress.”).
35 “In its complaint, VIP alleged that it both ‘own[s]’ and ‘use[s]’ the ‘Bad Spaniels’ trademark and trade dress for its durable rubber squeaky novelty dog toy. The company thus represented in this very suit that the mark and dress, although not registered, are used to ‘identify and distinguish [VIP’s] goods’ and to ‘indicate [their] source.’” Id. at 159-160.
36 Jack Daniel’s, 599 U.S. at 153-54.
37 Id. at 154 (italics and bold emphasis added).
Second Circuit did characterize the risk of confusion as “slight” in such hybrid cases involving titles, it did not treat film titles as categorically non-source-identifying.\textsuperscript{38}

The Second Circuit’s opinion in Rogers appeared motivated by the recognition that some situations exist in which no adequate line can be drawn between commercial and expressive uses of words that are also trademarks. Justice Kagan’s majority opinion, however, appears confident in the ability to distinguish trademark uses from those uses of trademarks that solely perform expressive functions, and the opinion charts a path forward in arguably hybrid cases. Indeed, Justice Kagan’s alternative framing of Rogers may offer greater clarity than Rogers itself about the types of use that deserve special treatment under trademark law.

While Kagan does not explicitly define “use as a designation of source,” a definition emerges from the examples she uses to illustrate the concept. Non-trademark uses include the title of the film in Rogers,\textsuperscript{39} the title “Barbie Girl” for a pop song,\textsuperscript{40} the use of trademarked football uniforms in an artist’s rendition of a famous game,\textsuperscript{41} and a reference to Louis Vuitton in a Hangover movie.\textsuperscript{42} While these uses certainly evoke the trademark holder and may well generate financial benefits from the association, none of them use the trademark to indicate source in the way that a product name (“Tide”) or business name (“Fidelity”) might do. In contrast, the uses described as source-identifying involve trademarks that “tell[] the public who is responsible for a product”:\textsuperscript{43} “United We Stand America” as the name of a political movement,\textsuperscript{44} a Harley Davidson look-alike as the logo of a motorcycle repair shop,\textsuperscript{45} and Timmy Holedigger as the name of a dog perfume.\textsuperscript{46} The defendant in Jack Daniel’s engaged in such trademark use, not only by naming its product Bad Spaniels’ but by asserting trademark rights in the product name and trade dress.\textsuperscript{47} These examples demonstrate that trademark use, under Jack Daniel’s, refers to a use that identifies a party’s own product or service and distinguishes it from others in the marketplace. The line between trademark use and non-use, in other words, turns on whether the defendant is using the mark in a way that would entitle it to trademark rights if the use were non-infringing.

We emphasize two final points about Jack Daniel’s. First, the fact that the likelihood-of-confusion test applies to parodic brands like Bad Spaniels does not necessarily mean that they are infringing.\textsuperscript{48} To the contrary, Justice Kagan emphasizes that an effective parody – one whose

\textsuperscript{38} 875 F.2d at 998.
\textsuperscript{39} See 599 U.S. at 154.
\textsuperscript{40} Id. (citing Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894 (9th Cir. 2002)).
\textsuperscript{41} Id. (citing Univ. of Ala. Bd. of Trustees v. New Life Art, Inc., 683 F.3d 1266 (11th Cir. 2012)).
\textsuperscript{42} Id. (citing Louis Vuitton Malletier S.A. v. Warner Bros. Entertainment Inc., 868 F. Supp. 2d 172 (S.D.N.Y. 2012)).
\textsuperscript{43} Id. at 146.
\textsuperscript{44} Id. at 155 (citing United We Stand Am., Inc. v. United We Stand, Am. New York, Inc., 128 F.3d 86 (1997)).
\textsuperscript{45} Id. (citing Harley-Davidson, Inc. v. Grottanelli, 164 F.3d 806 (2d Cir. 1999)).
\textsuperscript{46} Id. at 155-56.
\textsuperscript{47} Id. at 160 (“In its complaint, VIP alleged that it both ‘own[s]’ and ‘use[s]’ the ‘Bad Spaniels’ trademark and trade dress for its durable rubber squeaky novelty dog toy.”).
\textsuperscript{48} See generally Dogan & Lemley, supra note 14.
“message of ridicule or pointed humor comes clear” – is “not often likely to create confusion.”49 Second, while the line between trademark use and non-trademark use may often prove straightforward, some cases will present difficult line-drawing challenges, particularly in claims involving trade dress.50 The opinion leaves no doubt, however, that uses in the title or body of expressive works like books, movies, songs, or video games do not designate source. Such uses may well create confusion other than about source, but the Court leaves for another day the question of whether Rogers or some other standard should govern such claims.

II. Post-Jack Daniel’s Case Law and the Uncertainty Over Trademark Use

In the wake of Jack Daniel’s, courts appear to have struggled over what Justice Kagan meant by use “as a designation of source for the infringer’s own goods.”51 Rather than limiting “trademark use” to use that identifies a product or business name as described in Kagan’s opinion, some courts have found trademark use in cases involving expressive uses like the one in Rogers. Indeed, in the months since Jack Daniel’s, several courts have refused to apply Rogers because of questions about “trademark use” as the Court defined it, even in cases involving titles of movies, books, and TV shows – the very type of use that Kagan treated as prototypically non-source-identifying. While some courts are still applying Rogers in these contexts, significant uncertainty has arisen over trademark use, which threatens the continued relevance of Rogers in cases involving expressive uses.

In HomeVestors of America v. Warner Brothers Discovery,52 for example, the plaintiff claimed rights to a family of marks that use the word “ugly house.” When the defendant launched a television show called “Ugliest House in America,” the plaintiff sued for trademark infringement. The defendant moved to dismiss under Rogers, claiming that its use was an expressive, non-source-identifying use under Jack Daniel’s. A magistrate judge recommended against dismissal and the trial court agreed, finding the allegations in the complaint “sufficient to support a plausible inference that Defendant’s use of the mark was source-identifying.”53 The magistrate judge noted that “neither party could articulate a test or method for determining … whether an allegedly infringing mark is being used in a source-identifying way.”54

Davis v. Amazon.com likewise found Rogers inapplicable to a TV show title, though the court dismissed the trademark claims on other grounds.55 In Davis, the plaintiffs claimed trademark infringement based on the defendant’s release of a movie under the same name—GRINGO— as their successful and well-known book. Both works explored the experiences of American fugitives in Mexico, though their details differed. Pre-Jack Daniel’s, the court had

49 Id. at 161. Indeed, in another case involving dog toys, the Sixth Circuit found that the parodic nature of a “Chewy Vuiton” chew toy made confusion unlikely. See Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252 (4th Cir. 2007).
50 See, e.g., Vans, Inc. v. MSCHF Product Studios, Inc., 88 F.4th 125 (2d Cir. 2023).
51 Jack Daniel’s, 599 U.S. at 153.
53 Id. at *1.
54 Report and Recommendation, HomeVestors of America, Inc. v. Warner Brothers Discovery, Inc., 2023 WL 6880341, at *4 (D. Del. Oct. 18, 2023); see also id. at *5 (“I also note that [the defendant] could not tell me exactly what the Court should take into account at this stage in determining whether a mark is used in a source-identifying way.”).
dismissed the claims under Rogers, finding the title expressively relevant to the work and not explicitly misleading as to source.\textsuperscript{56} After the Supreme Court’s opinion, however, the court found Rogers inapposite concluding that film titles can – with secondary meaning – serve as indicators of source.\textsuperscript{57} Confusingly, the court seemed to conflate the secondary meaning of the book and the film title, using secondary meaning in the book to justify a conclusion that the film title was making a source-indicating use.\textsuperscript{58} In any event, the Court ultimately dismissed the claim based on the absence of likelihood of confusion.\textsuperscript{59}

Finally, in Morlu v. Amazon.com, the court declined to apply Rogers to claims of infringement based on a book title.\textsuperscript{60} Concluding that “dicta in the Supreme Court’s opinion in [Jack Daniel’s] raises some questions about the widespread availability of the Rogers test,” the court opted to “revert to a traditional trademark analysis out of an abundance of caution.”\textsuperscript{61} Again, the court dismissed based on no likelihood of confusion. Even so, by questioning the relevance of Rogers, the opinion reinforces the trend of treating titles of creative works as trademark use under Jack Daniel’s.

In contrast to these opinions, other post-Jack Daniels courts have applied Rogers to expressive uses in the body and title of films. JHT Tax v. AMC Networks\textsuperscript{62} involved the TV show “Better Call Saul.” The plaintiff was a tax preparation service with allegedly well-known trade dress featuring red, white, and blue colors and “extensive use of Statue of Liberty’ sculptures and inflatables.”\textsuperscript{63} It sued after defendants featured its trade dress in an episode involving a fictional tax preparation service operated by a convicted felon. In evaluating plaintiff’s trademark claim, the court applied Rogers, finding the defendant had not engaged in trademark use:

The Amended Complaint does not allege that Defendants used Plaintiff’s mark to identify the source of Better Call Saul or any of Defendant’s products, and Defendants are not alleged to have “use[d]” the … “trademark and trade dress” for any product they sell. … Accordingly, … Defendants have not used Plaintiff’s marks “as [their] ‘own identifying trademark.’” Application of the Rogers test is therefore appropriate.\textsuperscript{64}

And in Down to Earth Organics v. Zac Efron,\textsuperscript{65} the court held that the film title “Down to Earth with Zac Efron” was engaged in a non-trademark use of the words “Down to Earth,”\textsuperscript{66} making the Rogers test appropriate.

\begin{footnotes}
\item 56 Id. at *5.
\item 57 Id. at *5-6.
\item 58 Id. at *6 (“Accordingly, the [complaint] alleges a secondary meaning in “GRINGO” as a source identifier of the Book.”).
\item 59 Id. at *6-10.
\item 61 Id. at *3 & n.1.
\item 63 Id. at *1.
\item 64 Id. at *7 (internal citations omitted).
\item 65 Down to Earth Organics, LLC, v. Zac Efron et al., 2024 WL 1376532 (S.D.N.Y. March 31, 2024).
\item 66 Id. at *4 (finding the use “simply to identify the subject matter and tone of the Series”).
\end{footnotes}
While these two opinions suggest that some courts are applying the Jack Daniel’s trademark use standard as intended, the variability in the courts’ treatment of expressive works is troubling and requires correction.

III. Some Reflections on the Way Forward

As discussed above, we think the proper interpretation of Jack Daniel’s would limit “trademark use” (and thus the application of the likelihood of confusion standard) to situations in which a defendant is using the mark in a way that would give it a possible claim to trademark rights of its own. This is arguably how the facts in Jack Daniel’s are best understood. The Court explained that VIP Products was asserting its own trademark rights in both the Bad Spaniel’s mark and the related trade dress that closely resembled a Jack Daniel’s bottle and label. “VIP did not apply to register the name, or any other feature of, Bad Spaniels. But according to its complaint, … VIP both ‘own[s]’ and ‘use[s]’ the “Bad Spaniels’ trademark and trade dress.” VIP’s assertion of ownership over trademarks that closely resemble Jack Daniel’s famous marks made this an easy case for Justice Kagan. All that was left to prove was that the marks were being used to designate the source of the product. Although the toy could be seen as merely expressing a joke about Jack Daniel’s in its combined shape, name, and function, and its designation of origin (“Bad Spaniel’s” and “Silly Squeakers” trademarks) on the toy’s hangtag, VIP alleged in its complaint that it is “the owner of all rights in its ‘Bad Spaniels’ trademark and trade dress for its durable rubber squeaky novelty dog toy.” In other words, VIP admitted to trademark use of the trade dress that consisted entirely of the look and feel of the toy and closely resembled Jack Daniel’s trade dress. In such a case, “trademark use” in the context of the likelihood of confusion test may be the most straightforward application of the Lanham Act.

We have seen similar applications in past cases such as Harley-Davidson v. Grotinelli and most recently in Punchbowl Press v. AJ Press. In both cases, the defendant used a word or image that is the same as or similar to plaintiff’s trademark in a way that designates their own products or services. In Grotinelli, defendant was allowed to use the term “Hog” to refer to Harley-Davidsons (which he serviced) and call his company “The Hog Farm,” both because “Hog” was generic for large motorcycles before Harley-Davidson began using it as a mark. But he was enjoined from using a modified version of Harley-Davidson’s bar-and-shield design mark as part of his logo, even though his hand-drawn version disclaimed a relationship to Harley-Davidson and featured humorous alterations such “a drawing of a pig wearing sunglasses.” In Punchbowl, defendants sought to register the mark “Punchbowl News” and “Punchbowl Press” for their subscription-based online news publication that covered Washington D.C. politics (“punchbowl” is the nickname the Secret Service uses to refer to the U.S. Capitol). Plaintiff owns the trademark “Punchbowl” for its online invitation and greeting card service. While plaintiff and defendants use “punchbowl” for different referents (one the capitol, the other the party drink),

67 Slip Op. at 6. VIP’s “trademark use” of its “own” mark is therefore a matter of stipulation and wasn’t adjudicated by a fact-finder.
68 Slip Op. at 8 (emphasis added)
69 164 F.3d 806 (2d Cir. 1999).
70 Punchbowl Press v. AJ Press, No. 21-55881 (9th Cir. 2023) (9th Cir. 2022).
71 164 F.3d 806, 809 (2d Cir. 1999)
the Court of Appeals for the Ninth Circuit, applying *Jack Daniel's*, held that defendant’s use was as a mark (and it was) and thus *Rogers* didn’t apply, despite Punchbowl News being a publication protected by the First Amendment and its use of “Punchbowl” as its title. In both of these cases, defendants used some version of plaintiff’s mark to establish their own independent commercial identity and therefore engaged in trademark use.

Recent scholarship has helped clarify the line between trademark use and non-trademark use when the facts of use as a mark are less clear than in *Grotinelli* and *Punchbowl*. For example, trademark examiners at the USPTO may reject applications because the applied-for word or device fails to function as a mark in the specimen submitted by the applicant. From this registration practice, we can learn about when marks that arguably lack distinctiveness of source can bolster their trademark function through indicators of “use as a trademark.” We also learn about situations that trademark examiners have come to expect are not distinctive of source, such as when words or devices are merely decoration or informational. In other trademark literature, scholars demonstrate that there are such things as “trademark spaces,” locations that consumers are likely to assume occupy trademarks rather than something else (like a decoration). Courts and the Trademark Office appear to treat those “trademark spaces” on products or packaging as an input into what counts as “trademark use.” Both approaches to determining “trademark use” can be helpful for future applications of *Jack Daniel’s* in cases where the line between source designation and expression may be blurry. And these approaches may at least limit over-extending the *Jack Daniel’s* ruling — sending all borderline cases through a likelihood of confusion analysis — by shortcutting lawsuits in which the trademark holder’s claim is not to source confusion.

A second possibility is to lean into the *Jack Daniel’s* decision and integrate the concerns of trademark-overbreadth into the likelihood of confusion test itself. Recall that in *Rogers* itself, the Court of Appeals for the Second Circuit explained it was merely putting a thumb on the scale for free expression in those cases where the public has an interest in that expression for reasons distinct from its source-identifying function. *Rogers* was not intended to automatically apply to all expressive uses, despite recent application of *Rogers* which the Supreme Court critiqued

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73 Id.
74 Id.
75 Mark Lemley and Mark McKenna, Trademark Spaces and Trademark Law’s Secret Step Zero, 75 STAN. L. R. 1 (2023).
76 Id.
77 “Because overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict. … We believe that in general the 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. In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the 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 … Where a title with at least some artistic relevance to the work is not explicitly misleading as to the content of the work, it is not false advertising under the Lanham Act. This construction of the Lanham Act accommodates consumer and artistic interests. It insulates from restriction titles with at least minimal artistic relevance that are ambiguous or only implicitly misleading but leaves vulnerable to claims of deception titles that are explicitly misleading as to source or content, or that have no artistic relevance at all.” 875 F.2d 994 (2nd Cir. 1989)
(adopting McCarthy’s treatise statement) as “potentially encompass[ing] just about everything’ because names, phrases, symbols, designs, and their varied combinations often ‘contain some expressive message’ unrelated to source.” Arguably, Jack Daniel’s returns the Rogers test and its purpose to first principles, asking district courts to narrowly construe the Lanham Act in circumstances when the public interest in avoiding consumer confusion outweighs the public interest in expression. That would mean, according to the Supreme Court, that in some instances of explicitly misleading uses of a mark, even in a title with some expressive significance, the likelihood of confusion analysis should proceed as usual and “does enough work to account for the interest in free expression.”

Citing Mattel, the Supreme Court said “when a challenged trademark use functions as ‘source-identifying,’ trademark rights ‘play well with the First Amendment.’” In addition to Mattel, which the Supreme Court embraced as relying on the right legal analysis and arriving at the right outcome (approving as beyond the scope of the Lanham Act Aqua’s use of “Barbie” in its song title and lyrics), the Court cites approvingly Louis Vuitton Malletier v. Haute Diggity Dog as an alternative positive example. In Haute Diggity Dog, neither the district court nor the appellate court applied the Rogers test and instead integrated into the likelihood-of-confusion test the concern for the public interest in expression. Adopting the defendant’s description of its product (a dog toy) and consumer’s perception of it (as a joke), the Court of Appeals for the Fourth Circuit said:

The marks are undeniably similar in certain respects. There are visual and phonetic similarities. [Haute Diggity Dog] admits that the product name and design mimics LVM’s and is based on the LVM marks. It is necessary for the pet products to conjure up the original designer mark for there to be parody at all. However, a parody also relies on "equally obvious dissimilarit[ies] between the marks" to produce its desired effect.

The Court of Appeals for the Fourth Circuit first determined that the defendant’s product was an effective parody. It then explained that, while the product’s parodic nature does not end the analysis, it does alter the analysis of certain likelihood-of-confusion factors. The strength-of-the-mark factor, for example, may not weigh in favor of confusion in parody cases because the

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79 Supra note 14; 875 F.2d 994 (2nd Cir. 1989)
80 Slip Op. at 17.
81 Slip Op. at 16 (citing Mattel, 296 F.3d at 900).
82 Louis Vuitton Malletier S.A. v. Haute Diggity Dog LLC, 507 F. 3d 252 (4th Cir. 2007).
83 “Finding that Haute Diggity Dog’s parody is successful, however, does not end the inquiry into whether Haute Diggity Dog’s "Chewy Vuiton" products create a likelihood of confusion. See 6 J. Thomas McCarthy, Trademarks and Unfair Competition § 31:153, at 262 (4thed. 2007) ("There are confusing parodies and non-confusing parodies. All they have in common is an attempt at humor through the use of someone else’s trademark"). The finding of a successful parody only influences the way in which the Pizzeria Uno factors are applied. See, e.g., Anheuser-Busch, Inc. v. L & L Wings, Inc., 962 F.2d 316, 321(4th Cir. 1992) (observing that parody alters the likelihood-of-confusion analysis.” Louis Vuitton Malletier S.A. v. Haute Diggity Dog LLC, 507 F. 3d 252 (4th Cir. 2007).
more recognizable the mark, the more likely consumers will perceive the parody.\textsuperscript{84} Likewise, analysis of similarity between the marks must take into account the fact that parodies require some similarity.\textsuperscript{85} Overall, the court indicated that “an effective parody will actually diminish the likelihood of confusion, while an ineffectve parody does not.”\textsuperscript{86} In \textit{Jack Daniel’s}, the Supreme Court embraces this analysis, saying “[A]though VIP’s efforts to ridicule Jack Daniel’s does not justify use of the Rogers test, it may make a difference in the standard trademark analysis.”\textsuperscript{87} It then remands on that issue for further fact finding and legal analysis.

It would be reasonable to worry that \textit{Jack Daniel’s} reasoning provides little solace for defendants who engage in expressive but source-identifying use, given how time consuming and expensive the likelihood of confusion analysis can be. One purpose of the Rogers test was to avoid the chilling effect on small businesses of litigating a trademark dispute through to summary judgment only to win on the grounds that their use of the plaintiff’s mark was not only not confusing, but largely expressive and not source-designating of defendant’s own products.\textsuperscript{88} Both the majority and concurrence in \textit{Jack Daniel’s} address this concern. First, Justice Kagan says that the likelihood of confusion “inquiry is not blind to the expressive aspect of the Bad Spaniels toy … Beyond source designation, VIP uses the marks at issue in an effort to ‘parody’ or ‘make fun’ of Jack Daniel’s. And that kind of message matters in assessing confusion because consumers are not so likely to think that the maker of a mocked product is itself doing the mocking.”\textsuperscript{89} Whether this commonsense evaluation means the likelihood of confusion analysis can be decided on a truncated factual record or at an earlier procedural posture is unclear. But six members of the Court signed on to this statement which bodes well for the defendant (and other similar defendants) on remand. Second, Justice Sotomayor in her concurrence cautions lawyers that in trademark infringement cases involving parody surveys measuring confusion “may reflect a mistaken belief among some survey respondents that all parodies require permission.”\textsuperscript{90} Justice Sotomayor even suggests some of the surveys in this very case may suffer from this problem, exacerbating the inequities in trademark cases in which “well-heeled brands with the resources to commission surveys would be handed an effective veto over mockery.”\textsuperscript{91} She cautions that courts should “ensure surveys do not completely displace other likelihood-of-confusion factors, which may accurately track the experiences of actual confusion in the marketplace.”\textsuperscript{92} And thus, like Justice Kagan’s majority, Justice Sotomayor implies that on remand the district court should oversee the likelihood-of-confusion analysis with care taken to identify and protect the expressive values amplified by the parodic nature of the defendant’s use of plaintiff’s mark. In the case of surveys, Justice Sotomayor directs lower courts to “carefully assess the methodology

\textsuperscript{84} Id. at 261-62 (“In this case, precisely because LOUIS VUITTON is so strong a mark and so well recognized as a luxury handbag brand from LVM, consumers readily recognize that when they see a “Chewy Vuiton” pet toy, they see a parody. Thus, the strength of LVM’s marks in this case does not help LVM establish a likelihood of confusion.”).

\textsuperscript{85} Id. at 262 (“a trademark parody necessarily copies enough of the original design to bring it to mind as a target”).

\textsuperscript{86} Id.

\textsuperscript{87} Slip Op. at 18-19.

\textsuperscript{88} See generally William McGeveran, \textit{The Imaginary Trademark Parody Crisis (And the Real One)}, 90 \textit{WASH. L. REV.} 713 (2015) (contending that the real problem with trademark parody comes from aggressive cease-and-desist practices of mark-holders, and advocating tools to deter this behavior).

\textsuperscript{89} Slip Op. at 10.

\textsuperscript{90} Slip Op. at 1 (concurrency)

\textsuperscript{91} Id. at 2.

\textsuperscript{92} Id.
and representativeness” and “be attentive to ways in which surveys may artificially prompt such confusion.” Although the Jack Daniel’s court requires the likelihood-of-confusion analysis to proceed, its embrace of Haute Diggity Dog and guidance on remand in terms of some of the more costly and error-prone uses of the likelihood-of-confusion analysis provide some benefits to defendants engaged in principally expressive (as opposed to source-designating) uses.

In addition to these two analyses that may align the Jack Daniel’s framework with the need to protect speech, we offer a third. The concurrence by Justice Gorsuch (and joined by Justice Thomas and Barrett) suggests that the Rogers test may merely be a “gloss on the Lanham Act” ostensibly “commanded by the First Amendment,” and an erroneous one at that. In so stating, it is hard not to hear the hint of a textual analysis of the Lanham Act whispering that the absence of such a test in the statute means that its derivation in 1989 and subsequent adoption by a majority of the courts of appeals was in error. Apparently lost on these concurring justices is the fact that so much of trademark law is common law derived, filling in statutory provisions to evolve with marketplace realities and business practices. The likelihood of confusion test is one such common law feature of the Lanham Act’s application; it is different in every circuit, entirely absent from the statute, and unquestioned by practitioners and courts alike. As with other common law derived trademark doctrines, the majority opinion does not jettison Rogers. Instead, it expressly sets aside the question of Rogers’ application in other contexts, holding only that it does not apply when the defendant uses the plaintiff’s mark as a designation of source for defendant’s own goods. The Court further explains that Rogers’ central domain concerns artistic works, such as films, songs, and paintings. We may be skeptical of the line between “art” and other consumer products that are also expressive, such as video games and dog toys. But whatever the ambiguity (and First Amendment tension) in that kind of line drawing, the Court drew it and future defendants seeking to assert their rights of expression while also using trademarks to do it, should take note. It is hard to fathom that First Amendment-protecting doctrine of Rogers v. Grimaldi would wither or disappear when so many other aspects of the First Amendment’s free speech protections have grown under this very same Court’s lawmaking. Instead, we see a path indicated in Jack Daniel’s that might justify and even strengthen Rogers in certain circumstances. Discarding Rogers because in this case it was held not to apply is the wrong message to take from the Jack Daniel’s decision that appears sympathetic to defendant’s position and, unlike Jack Daniel’s, demonstrates a sense of humor.

93 Id. at 1-2
94 Nominative fair use and descriptive fair use are likewise common law derived in their broadest form. Cf. 1115(b)(5); 43(a)(c)(3)(A). So is Abercrombie spectrum.
95 Slip Op. at 10.
CONCLUSION

At first read, the Supreme Court’s opinion in Jack Daniel’s appears to shrink speech protections for expressive uses of trademarks. A better reading reveals a more nuanced and even delimiting approach to overbroad trademark claims. Rogers, after all, intended to protect speech in those circumstances when the likelihood of confusion analysis would fail at that important task. At its best, likelihood of confusion is a test that assesses consumer confusion in ordinary purchasing or commercial contexts, often between related competitors; it aims to minimize that confusion to benefit consumers and trademark owners. The Rogers test applies outside of that run-of-the-mill commercial context to protect the use of artistic works that are often of a hybrid commercial-expressive nature from being enjoined or their aesthetic features changed. As originally conceived, Rogers applied in those situations in which drawing the line between commercial and artistic is difficult and in which core free speech interests, such as aesthetic and expressive choices, are at stake. Jack Daniel’s did not repudiate this goal or the Rogers test to help achieve it.

As Rogers explained in the context of determining that the title “Ginger & Fred” did not violate the Lanham Act,

“Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker's expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined… Film-makers and authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works. Furthermore, their interest in freedom of artistic expression is shared by their audience. The subtleties of a title can enrich a reader's or a viewer's understanding of a work.”

Rogers recognized – as did Jack Daniel’s – that artistic speech has commercial elements. This does not result in its loss of protection. By underscoring how constitutional values, like free expression, are protected by keeping trademark law from interfering in creative freedoms related to artistic works, Rogers identified specific cases in trademark law subject to special care. At stake is artistic freedom and promoting a full range of aesthetic creativity; also at stake is the audience’s enjoyment of that creativity and the enrichment that comes from diversity of expression and unconstrained artistic freedom. Jack Daniel’s did not repudiate these stakes or the need for special judicial attention when Lanham Act claims threaten speech. A careful reading and application of Jack Daniel’s “trademark use” limitation may yet preserve these important values, which was the goal of Rogers and the thrust of the cases applying it over the past thirty years.

98 Rogers v. Grimaldi, 875 F.2d 994, 998 (2d Cir. 1989).