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Based on a True Story: The Ever-Expanding Progeny of *Rogers v. Grimaldi*

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Cover Page Footnote

* LL.M. 2021, New York University School of Law; J.D. 2020, University of North Carolina School of Law; Corporate Associate, Latham & Watkins LLP, New York. The Author thanks Barton Beebe, Megan Bannigan, and David Bernstein for their guidance in researching this Article, and Alyssa Wright and Christine Xiao for their assistance during the revision process. ** “What I was, what I am, see, and seek the justice therein.” Ovid, *Metamorphoses* II.551. 1 In re Walldesign, Inc., 872 F.3d 954, 959 (9th Cir. 2017).

Based on a True Story: The Ever-Expanding Progeny of *Rogers v. Grimaldi*

Zachary Shufro*

*Quid fuerim quid simque vide meritumque require.***

Trademark law limits the extent and manner to which individuals can use a surprisingly large percentage of common words in the English language. Indeed, as one empirical study of trademark registrations revealed, “when we use our language, nearly three-quarters of the time we are using a word that someone has claimed as a trademark.” Because trademark law grants a negative right to the mark-holder—that is to say, a right to prevent others from using that trademarked word in certain manners and contexts—it inherently conflicts with the First Amendment. In assessing the resulting discord from such a conflict, courts have several measures to determine the metes and bounds of the First Amendment’s priority over trademark law. In the case of an expressive or artistic work which uses the trademark of another (or the name of an individual), one such test that has developed is the Rogers test, named for a 1989 lawsuit involving the actress and dancer Ginger Rogers. Over the past thirty years, this test has outgrown the relatively narrow confines in which it was originally envisioned by the Second Circuit Court of Appeals, and particularly in the Ninth Circuit, its progeny has taken on a life of its own. This Article examines the most recent

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** “What I was, what I am, see, and seek the justice therein.” OVID, METAMORPHOSES II.551.

development in the ever-expanding ambit of the Rogers test: the Ninth Circuit’s recent decision in VIP Products LLC v. Jack Daniel’s Properties, Inc. As one Ninth Circuit panel stated in a recent opinion, “[i]t is said that bad facts make bad law”;¹ however, VIP Products proves that the inverse can also be true, and that bad legal analysis can defeat a strong factual scenario. The implications of this decision in future cases remains unclear, but this Article considers the pernicious consequences of an even-broader application of the Rogers test in the Ninth Circuit moving forward.

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INTRODUCTION

Trademark law limits the extent and manner to which individuals can use a surprisingly large percentage of common words in the English language. Indeed, as one empirical study of trademark

¹ *In re Walldesign, Inc.*, 872 F.3d 954, 959 (9th Cir. 2017).

registrations revealed, “when we use our language, nearly three-quarters of the time we are using a word that someone has claimed as a trademark.”² Because trademark law grants a negative right to the mark-holder—that is to say, a right to prevent others from using that trademarked word in certain manners and contexts—it inherently conflicts with the First Amendment. In assessing the resulting discord from such a conflict, courts have several measures to determine the metes and bounds of the First Amendment’s priority over trademark law. In the case of an expressive or artistic work which uses the trademark of another (or the name of an individual), one such test that has developed is the *Rogers* test, named for a 1989 lawsuit involving the actress and dancer Ginger Rogers.³ Over the past thirty years, this test has outgrown the relatively narrow confines in which it was originally envisioned by the Second Circuit Court of Appeals, and particularly in the Ninth Circuit, its progeny has taken on a life of its own.

This Article examines the most recent development in the ever-expanding ambit of the *Rogers* test: the Ninth Circuit’s recent decision in *VIP Products LLC v. Jack Daniel’s Properties, Inc.*⁴ This Article proceeds in three parts. Part I summarizes the policy goals and purposes of trademark law, provides a brief overview of the Lanham Act’s false endorsement right of action and of trademark dilution, and synthesizes both *Rogers v. Grimaldi* and the development of the *Rogers* test in the Ninth Circuit. Part II then analyzes the *VIP Products LLC v. Jack Daniel’s Properties, Inc.* district court and appellate decisions, and considers the consequences of the Ninth Circuit’s decision. In its opinion, the Ninth Circuit not only stretched the purpose of the *Rogers* test to a breaking point, but also improperly relied upon the test’s basic premise as grounds to incorrectly dispose of a trademark dilution claim—despite the different standards, purposes, and policy goals of trademark infringement and trademark dilution statutes. The consequences of such precedent going forward are still unclear.

² Barton Beebe & Jeanne C. Fromer, *Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 HARV. L. REV. 945, 982 (2018).

³ See *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989).

⁴ 953 F.3d 1170 (9th Cir. 2020), *cert. denied*, 141 S. Ct. 1054 (2021).

Part III concludes by considering how to remedy the ever-increasing scope of the *Rogers* test in Ninth Circuit jurisprudence and reflects on the potential effects that *VIP Products* could have on future trademark false endorsement claims. As one Ninth Circuit panel stated in a recent opinion, “[i]t is said that bad facts make bad law”;⁵ however, *VIP Products* proves that the inverse can also be true, and that bad legal analysis can defeat a strong factual scenario. The implications of this decision in future cases remains unclear, but this Article considers the pernicious consequences of an even-broader application of the *Rogers* test in the Ninth Circuit moving forward.

I. TRADEMARK LAW OVERVIEW

A trademark is a word, name, or design used by an individual or company in commerce to identify the source from which their goods or services emanate.⁶ While important exceptions to trademark rights exist in order to balance the First Amendment interests of individuals other than the mark-holder—one such exception being that which was evaluated under the *Rogers* test⁷—as a general matter, the holder of a trademark is entitled to the sole nationwide use of that mark in commerce in connection with the goods or services identified in the trademark registration.⁸ This Part provides a short overview of the purposes and policy goals of trademark law, and then examines how the *Rogers* test first arose in 1989 and how it has evolved in Ninth Circuit jurisprudence.

⁵ *In re Walldesign, Inc.*, 872 F.3d 954, 959 (9th Cir. 2017).

⁶ *See* 15 U.S.C. § 1127 (defining a trademark as “any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown”). *See also* Zachary Shufro, *Haute Couture’s Paper Shield: The Madrid Protocol and the Absence of International Trademark Enforcement Mechanisms*, 45 N.C. J. INT’L L. 645, 649 (2020).

⁷ *See, e.g.*, *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1196 (9th Cir. 2017) (applying the *Rogers* test to determine whether the use of a trademark in the title of an expressive work constituted trademark infringement).

⁸ *See* 15 U.S.C. § 1114(1).

A. *The Purpose of Trademark Law*

Trademark law is rooted in unfair competition law, with the aim of protecting the public from commercial fraud.⁹ In its modern incarnation, it serves the important twin goals of protecting both the public and the trademark owner.¹⁰ The use of a distinctive trademark in commerce “ensures [that] the public can clearly identify a source of goods.”¹¹ In this manner—as a source identifier—trademarks protect the public in two different ways. First, trademarks protect consumers from fraud and deception by ensuring that consumers can rely upon the quality of products produced by brands they trust.¹² Second, and relatedly, trademarks reduce consumer search costs because they allow consumers to develop expectations of cost and quality for products.¹³ For example, a frantic new mother may insist on buying Pampers diapers without examining other options available, because she knows that they are high-quality, safe, and trustworthy. A trademark serves its owner in two similar fashions. First, trademarks encourage the production of quality goods and services because they allow owners to invest in their brands without fear that others will benefit from their success.¹⁴ This incentivizes businesses to maintain high quality standards for their products.¹⁵ Second, trademarks encourage fair competition (while protecting brand owners from unfair competition, misappropriation, and infringement)

⁹ See, e.g., Sidney A. Diamond, *The Historical Development of Trademarks*, 65 TRADEMARK REP. 265, 287–88 (1975) (citing *Singleton v. Bolton*, (1783) 99 Eng. Rep. 661, 3 Doug 293 (KB) (Eng.)) (“The beginning of legal protection for trademarks as such generally is traced to a 1783 dictum in an English case, stating that an action for damages would lie based upon fraud.”).

¹⁰ See William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 270 (1987).

¹¹ Ashlyn Calhoun, “*It All Started with a Mouse*”: *Resolving International Trademark Disputes Using Arbitration*, 2018 J. DISP. RESOL. 87, 88 (2018).

¹² See, e.g., Mathias Strasser, *The Rational Basis of Trademark Protection Revisited: Putting the Dilution Doctrine Into Context*, 10 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 375, 380 (2000).

¹³ See *id.* (“[T]rademarks reduce the search costs of consumers.”); see also Landes & Posner, *supra* note 10, at 270 (“The value of a trademark is the saving in search costs.”).

¹⁴ See Landes & Posner, *supra* note 10, at 270 (“[A] firm with a valuable trademark would be reluctant to lower the quality of its brand because it would suffer a capital loss on its investment in the trademark.”).

¹⁵ See *id.*

because companies are incentivized to distinguish their products from one another.¹⁶

1. False Endorsement

Beyond prohibiting simple infringement and counterfeiting, trademark law prohibits a variety of actions which threaten the very brand goodwill that businesses and consumers rely upon in commerce. One such prohibition is false endorsement. Under 15 U.S.C. Section 1125, trademark infringement liability extends to any individual who uses a trademark in commerce that is likely “to deceive as to the affiliation, connection, or association of [that] person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.”¹⁷ Generally “a person’s image or likeness cannot function as a trademark,”¹⁸ but in some circumstances, a celebrity, famous company, or other well-known individual’s name or likeness can function as an indicator of source subject to a false endorsement claim in which “the ‘mark’ at issue is the plaintiff’s identity.”¹⁹ Much like a claim for passing off—the common law antecedent of federal trademark law’s prohibition on deceptive marks²⁰—false endorsement claims prevent one producer from deceiving the public as to the relationship between its good and another individual or producer.²¹

¹⁶ *See id.* (“[Trademarks] are valuable because they denote consistent quality, and a firm has an incentive to develop a trademark only if it is able to maintain consistent quality.”).

¹⁷ 15 U.S.C. § 1125(a)(1)(A).

¹⁸ *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 922, 937 (6th Cir. 2003) (holding that the sale of works of art depicting golfer Tiger Woods did not give rise to a Lanham Act false endorsement claim).

¹⁹ *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000) (citing *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399–400 (9th Cir. 1992)).

²⁰ *See, e.g., William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526, 530 (1924) (finding a valid claim for unfair competition and fraud when one pharmaceutical company sold the less expensive product Quin-Coco to drug stores while the pharmacists could sell that product to consumers as the more expensive product Coco-Quinine).

²¹ *Cf., e.g., White*, 971 F.2d at 1399–400.

2. Trademark Dilution

Trademark dilution is a cause of action that approximates the dignitary harms of tort law in the context of unfair competition.²² As first articulated by Frank Schechter in 1927, dilution is an “interference with the uniqueness of a mark, which [is] the key to its selling power.”²³ Economic rationales for trademark dilution range from concern about increased consumer search costs,²⁴ to potential post-sale or secondary-market confusion,²⁵ to inchoate harms, to the status-signifying quality of well-known trademarks.²⁶ However, unlike other forms of trademark infringement, dilution “imposes liability without any requirement of confusion.”²⁷ Whether the diluting use of a trademark tarnishes the public perception of the well-known mark²⁸ or merely blurs the purchasing public’s association with the

²² See generally Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927).

²³ Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 517 (2008). For a discussion of the basis of Schechter’s theory in a German court’s 1924 misappropriation case, see generally Barton Beebe, *The Suppressed Misappropriation Origins of Trademark Antidilution Law: The Landgericht Elberfeld’s Odol Opinion and Frank Schechter’s “The Rational Basis of Trademark Protection,”* in INTELLECTUAL PROPERTY AT THE EDGE: THE CONTESTED CONTOURS OF IP (Rochelle Cooper Dreyfuss & Jane C. Ginsburg eds., 2014).

²⁴ See Landes & Posner, *supra* note 10, at 306–07 (“Suppose a lounge in Boston calls itself ‘Tiffany’s’ or a peanut vendor in the Bowery calls himself ‘Rolls-Royce Ltd.’ . . . hereafter when the consumer sees the name ‘Rolls-Royce,’ he will think both about the auto manufacturer and about the peanut vendor, and the connotations of the name will blur.”).

²⁵ See *id.* at 308 (“[T]he confusion does not occur in the market for the trademarked good, or in any other product market, but in a ‘resale’ market where consumers of the product compete with other consumers for advantageous personal transactions.”).

²⁶ See *id.* (“Just as people conceal their undesirable characteristics in order to create or protect such capital, so they . . . advertise themselves . . . by wearing clothes, jewelry, or accessories that tell the world that they are people of refined (or flamboyant) taste or high income. If others can buy and wear cheap copies, the ‘signal’ given out by the purchasers of the originals is blurred.”).

²⁷ Robert G. Bone, *Schechter’s Ideas in Historical Context and Dilution’s Rocky Road*, 24 SANTA CLARA COMPUT. & HIGH TECH. L.J. 469, 473 (2008).

²⁸ Dilution by tarnishment occurs when an “association arising from the similarity between a mark or trade name and a famous mark” occurs in such a manner as to “harm[] the reputation of the famous mark.” 15 U.S.C. § 1125(c)(2)(C). See also Sarah L. Burstein, *Dilution by Tarnishment: The New Cause of Action*, 98 TRADEMARK REP. 1189, 1191 (2008) (“[T]arnishment occurs when a defendant uses the same or similar marks in a way

mark,²⁹ the harm that dilution seeks to prevent “is a form of cognitive obstruction—that is, that . . . consumers must ‘think for a moment’ whenever they see one of the marks to determine to which company the mark refers.”³⁰ Confirmed in 2003 by the United States Supreme Court, dilution seeks to ensure that “the preservation of the uniqueness of a trademark . . . constitute[s] the only rational basis for its protection.”³¹ It is a distinct form of liability from trademark infringement, with its own elements to be proven in litigation and independent affirmative defenses.³²

B. *Rogers v. Grimaldi*

In 1986, famous Italian film-maker Federico Fellini³³ produced the film *Ginger and Fred*, distributed throughout the United States and Europe.³⁴ The film recounts a fictional story about two Italian cabaret performers known as Ginger and Fred, for their impersonations of Hollywood stars Ginger Rogers and Fred Astaire.³⁵ Critics described the work as a “bittersweet story of these two fictional

that creates an undesirable, unwholesome, or unsavory mental association with the plaintiff’s mark.”) (internal quotations omitted).

²⁹ Dilution by blurring consists of an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” 15 U.S.C. § 1125(c)(2)(B).

³⁰ Barton Beebe et al., *The Science of Proving Trademark Dilution*, 109 TRADEMARK REP. 955, 956 (2019) (quoting Richard A. Posner, *When Is Parody Fair Use?*, 21 J. LEGAL STUD. 67, 75 (1992)).

³¹ *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 429 (2003) (quoting Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 831 (1927)).

³² See, e.g., Kathleen B. McCabe, Note, *Dilution-by-Blurring: A Theory Caught in the Shadow of Trademark Infringement*, 68 FORDHAM L. REV. 1827, 1830 (2000) (“[T]he dilution doctrine is commonly misunderstood by courts, laboring under the impression that dilution is a consequence of infringement, and that confusion must therefore be found in order to sustain a dilution claim.”).

³³ Fellini is known for his earlier films, including the 1960 Academy Award-winner *La Dolce Vita*. See Anthony Lane, *A Hundred Years of Fellini*, New Yorker (Jan. 17, 2020), <https://www.newyorker.com/magazine/2020/01/27/a-hundred-years-of-fellini> [<https://perma.cc/XFH4-9C78>].

³⁴ *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d. Cir. 1989).

³⁵ *Id.* at 996–97. Rogers and Astaire “are among the most famous duos in show business history,” and the Second Circuit noted that they number “among that small elite of the entertainment world whose identities are readily called to mind by just their first names, particularly the pairing ‘Ginger and Fred.’” *Id.* at 996.

dancers and . . . a satire of contemporary television variety shows.”³⁶ It “received mixed reviews” before Ginger Rogers sought to permanently enjoin the movie’s distribution in the United States by filing suit against the producers, alleging a Lanham Act false endorsement claim and a right of publicity claim.³⁷

Rogers produced survey evidence³⁸ indicating that the movie title misled viewers to believe Rogers was connected to the film.³⁹ However, the Southern District of New York dismissed her claims “because the speech at issue . . . [was] not primarily intended to serve a commercial purpose, the prohibitions of the Lanham Act [did] not apply, and the Film [was] entitled to the full scope of protection under the First Amendment.”⁴⁰ Noting that while a “[p]oetic license is not without limits,” the Second Circuit affirmed the district court’s decision, as “[m]ovies, plays, books, and songs are all indisputably works of artistic expression and deserve protection.”⁴¹ The court thereby struck a balance between the free expression concerns within the First Amendment and the Lanham Act’s protection of an individual or company’s right to prevent false sponsorship, endorsement, or affiliation with the services or goods of another. This balancing act has since become known as the *Rogers* test.

1. The *Rogers* Test

In assessing Ginger Roger’s false endorsement and right of publicity claims, the Second Circuit noted that “[t]hrough First Amendment concerns do not insulate titles of artistic works from all Lanham Act claims, such concerns must nonetheless inform [a court’s] consideration of the scope of the Act.”⁴² This is because “[t]itles,

³⁶ *Id.* at 997.

³⁷ *Id.*

³⁸ Survey evidence is often an integral aspect of trademark litigation and can be a deciding factor in determining whether a mark is distinctive, generic, or is likely to confuse or mislead consumers. See Barton Beebe et al., *The Role of Consumer Uncertainty in Trademark Law: An Experimental and Theoretical Investigation* 3–6 (N.Y. Univ. L. & Econ. Rsch. Paper Series, Working Paper No. 21-13, 2021), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3854730 [<https://perma.cc/437B-TLV5>].

³⁹ *Rogers*, 875 F.2d at 997.

⁴⁰ *Rogers v. Grimaldi*, 695 F. Supp. 112, 120–21 (S.D.N.Y. 1988).

⁴¹ *Rogers*, 875 F.2d at 997.

⁴² *Id.* at 998.

like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion.”⁴³ Taking pains to narrowly construe the Lanham Act,⁴⁴ the court held the following:

In the context of allegedly misleading titles using a celebrity’s name, [the] 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.⁴⁵

While this test does not always favor creators’ First Amendment rights over mark-holders’ Lanham Act claims,⁴⁶ the Second Circuit reasoned that the test accurately balances these conflicting interests because “most consumers are well aware that they cannot judge a book solely by its title any more than by its cover.”⁴⁷ Insofar as Fellini’s film was concerned, the court held that Rogers’s claims were precluded by the First Amendment, because “[t]o the extent that there [was] a risk that the title [would] mislead some consumers as to what the work [was] about, that risk [was] outweighed by the danger that suppressing an artistically relevant though ambiguous title [would] unduly restrict expression.”⁴⁸ By producing *Ginger and Fred*, Fellini not only won the 1986 National Board of Review’s Best Foreign Film award and enjoyed some additional minor commercial success, but also secured a place in trademark law’s history.⁴⁹ In sum, through the story about two washed-up former entertainers, a legal star was born.

⁴³ *Id.*

⁴⁴ *See id.* at 999 (“[I]n 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.”).

⁴⁵ *Id.*

⁴⁶ *See id.* (“Even where a title surpassed the appropriately low threshold of minimal artistic relevance but was explicitly misleading as to source or content, a violation could be found.”); *see also id.* at 1000.

⁴⁷ *Id.* at 1000.

⁴⁸ *Id.* at 1001.

⁴⁹ *See 1986 Award Winners*, NAT’L BD. REV., <https://nationalboardofreview.org/award-years/1986/> [<https://perma.cc/P2Y6-5E7U>].

2. *Rogers* in the Ninth Circuit

Merely thirteen years after the Second Circuit decided *Rogers v. Grimaldi*, the Ninth Circuit adopted the *Rogers* test in its 2002 decision, *Mattel v. MCA Records, Inc.*⁵⁰ Affirming the Central District of California's ruling that the Danish music group Aqua's song "Barbie Girl" was "not likely to confuse consumers as to Mattel's affiliation with [the song] or dilute the Barbie mark,"⁵¹ the Ninth Circuit "agree[d] with the Second Circuit's analysis and adopt[ed] the *Rogers* standard" for assessing the balance of First Amendment and trademark rights in an expressive or artistic work.⁵² Given the scant evidence of consumer association between the song "Barbie Girl" and Mattel, the Ninth Circuit unsurprisingly affirmed the district court's grant of summary judgment in favor of MCA Records and Aqua.⁵³ Nevertheless, the court's equally scant *Rogers* test analysis foreshadowed the extremely permissive view of *Rogers* to come in Ninth Circuit jurisprudence.⁵⁴ Later decisions extended the applicability of the *Rogers* test from song and movie titles,⁵⁵ to the titles of artistic works such as photographs,⁵⁶ to a video game that used a company's trade dress and confusingly similar logo.⁵⁷

⁵⁰ See *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

⁵¹ *Id.* at 899.

⁵² *Id.* at 902.

⁵³ See *id.* ("The *only* indication that Mattel might be associated with the song is the use of Barbie in the title; if this were enough to satisfy this prong of the *Rogers* test, it would render *Rogers* a nullity.").

⁵⁴ See *id.* (applying the *Rogers* test to the facts of the dispute in a short, conclusory manner and in a sole paragraph).

⁵⁵ See *id.*

⁵⁶ See *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003) ("Forsythe's use of the Barbie mark is clearly relevant to his work . . . The Barbie mark in the titles of Forsythe's works and on his website accurately describe the subject of the photographs, which in turn, depict Barbie and target the doll with Forsythe's parodic message.") (citations omitted).

⁵⁷ See *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) (finding that because a video game is an artistic work and because the accurate depiction of a real-life neighborhood—including the trade dress and logo of a strip club based in that neighborhood—"is relevant" to the video game designers' "artistic goal, which is to develop a cartoon-style parody of East Los Angeles," the designer's decision "to include a strip club that is similar in look and feel to the [plaintiff's business] does indeed have at least 'some artistic relevance.'" (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989))).

Within a decade after the Ninth Circuit adopted the *Rogers* test, however, its focus shifted from only considering the *artistic* relevance of a work's title or content to considering the overall relevance of the trademark or individual's identity implicated in such an analysis.⁵⁸ For example, in *Brown v. Electronic Arts*, a celebrity football player introduced evidence that the vast majority of the consuming public believed an athlete's inclusion in a video game required permission or at least affiliation with the product.⁵⁹ This evidence implicated the second prong of the *Rogers* test: whether "the [use of the trademark or identity] explicitly misleads as to the source or the content of the work."⁶⁰ Nonetheless, the Ninth Circuit sided against the athlete whose image was used in the video game, and found that "the likeness of a great NFL player is artistically relevant to a video game that aims to recreate NFL games."⁶¹ Unlike *Rogers*, where using Ginger Rogers's name and identity was integral to the film's artistic message,⁶² the (somewhat obfuscated)⁶³ identity of one retired football player was likely not essential to the artistic goal of "extreme realism" in a video game.⁶⁴

A few years after *Brown*, the Ninth Circuit further muddied the waters of the *Rogers* test in *Twentieth Century Fox Television v. Empire Distribution, Inc.*, when it failed to distinguish between the expressive use of a trademark in a creative work (a television show) and the use of that same mark to identify the source of a commercial enterprise (the name of a record label brand).⁶⁵ In this case, Empire

⁵⁸ See, e.g., *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1242–47 (9th Cir. 2013) (holding that even though the sole "artistic relevance" of including a celebrity football player's likeness in a video game was the desire for "extreme realism," and even though "a majority of the public believes that identifying marks" such as a football player's name and likeness "cannot be included in products without permission," his inclusion in the video game did not explicitly mislead consumers as to his endorsement or sponsorship of the video game).

⁵⁹ See *id.* at 1245–46.

⁶⁰ *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

⁶¹ *Brown*, 724 F.3d at 1248.

⁶² See *supra* notes 44–48 and accompanying text.

⁶³ The video game designers "changed the jersey number" worn by Brown, for example, and otherwise "scramble[ed]" his avatar's identity in the end commercial product. *Brown*, 724 F.3d at 1246–47.

⁶⁴ *Id.* at 1243.

⁶⁵ See *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1199 (9th Cir. 2017).

Distribution—a record label founded in 2010—sued Twentieth Century Fox Television (“Fox”) after the television company began to sell music related to its 2015 show, *Empire*, under the “Empire” brand.⁶⁶ In its decision, the court elided over the distinction between Fox’s use of the Empire mark in the title of its television show—a use, under the *Rogers* test, that is equally protectable as Ginger Rogers’s name in *Fred and Ginger*.⁶⁷ The Ninth Circuit similarly ignored Fox’s use of the Empire mark as a source-identifier on the commercial products it sold—which, coincidentally, were the same type of goods as those sold under the Empire mark by Empire Distribution.⁶⁸ Despite clear, factual distinctions between *Empire* and *Rogers*, the Ninth Circuit found that Fox’s all-but-usurpation of Empire Distribution’s trademark was protected expressive use under the *Rogers* test.⁶⁹

II. *VIP PRODUCTS LLC V. JACK DANIEL’S PROPERTIES, INC.*

The Ninth Circuit’s expansive view of the *Rogers* test reached its latest apogee in a case involving Jack Daniel’s Properties, Inc. (“Jack Daniel’s”), a Delaware-based holding company that owns the intellectual property of the Jack Daniel’s Whiskey Distillery based in Lynchburg, Tennessee.⁷⁰ Founded in 1866 by Jasper Newton Daniel with the help of the company’s newly-emancipated head distiller, Nathan Green, Jack Daniel’s was the first registered distillery in the United States and has been making whiskey for over 150 years.⁷¹ With a unique mellowness and consistency resulting from

⁶⁶ See *id.* at 1195.

⁶⁷ Compare *id.* at 1197–99 (noting that Fox used the Empire mark in connection with its television show, an artistic and expressive work), with *Rogers v. Grimaldi*, 875 F.2d 994, 997 (2d Cir. 1989) (referring to “[m]ovies, plays, books, and songs” as “works of artistic expression” which “deserve protection” under the First Amendment).

⁶⁸ See *Twentieth Century Fox Television*, 875 F.3d at 1195–98.

⁶⁹ See *id.* at 1198–99.

⁷⁰ See Petition for Writ of Certiorari at 8, *Jack Daniel’s Props., Inc. v. VIP Prods., LLC*, 141 S. Ct. 1054 (2020) (No. 20-365).

⁷¹ See *Born to Make Whiskey: The Story of Jack Daniel’s*, JACK DANIEL’S, <https://www.jackdaniels.com/en-us/our-story> [<https://perma.cc/UJW6-VS75>] [hereinafter *Born to Make Whiskey*].

an exact distillation process,⁷² Jack Daniel's distinguished itself from competitors in the pre- and post-Prohibition eras.⁷³ After a 1951 *Fortune* article "chronicled its growth and appeal to such disparate figures" as William Faulkner, Winston Churchill, and John Huston, Jack Daniel's profile was truly on the rise.⁷⁴

Artificial scarcity through the 1970s and unsolicited promotion by Frank Sinatra and Paul Newman helped create a status-signifying brand with nationwide recognition.⁷⁵ After expanding its distillery and ending its exclusive allocation distribution system, the company "grew into a global brand, almost tripling sales from 1973 to 1986" and introducing its "iconic black-and-white label on the equally iconic square bottle" to the wider world.⁷⁶ The brand maintains a trademark registration "for the three-dimensional configuration of a square shape bottle container . . . for distilled spirits,"⁷⁷ with four key design elements⁷⁸ that accompany the source-identifying words, "Tennessee Sour Mash Whiskey," "Old No. 7," and "Jack

⁷² See Jim Stengel, *Jack Daniel's Secret: The History of the World's Most Famous Whiskey*, ATLANTIC (Jan. 9, 2012), <https://www.theatlantic.com/business/archive/2012/01/jack-daniels-secret-the-history-of-the-worlds-most-famous-whiskey/250966/> [<https://perma.cc/U6YC-8XW3>]. This process involved only using "iron-free cave spring water" and "the finest grains," a mellowing process achieved by filtering the whiskey "through ten feet of sugar maple charcoal," and constantly changing the charcoal used. *Id.* It is likely that this process, like Jasper Daniel's knowledge of distilling whiskey in general, is the legacy of Nathan Green, the former slave who taught him how to make whiskey, as it is "likely that the practice evolved from slave distilling traditions, in which charcoal helped remove some of the sting from illicitly made alcohol." Clay Risen, *Jack Daniel's Embraces a Hidden Ingredient: Help From a Slave*, N.Y. TIMES (June 25, 2016), <https://www.nytimes.com/2016/06/26/dining/jack-daniels-whiskey-nearis-green-slave.html> [<https://perma.cc/VQ5G-YWC3>].

⁷³ See *Born to Make Whiskey*, *supra* note 71.

⁷⁴ See Stengel, *supra* note 72.

⁷⁵ See *id.* ("[P]opular culture continued to associate it with maverick independence . . . Nelson Eddy says, 'When Hollywood scriptwriters want to use short-hand to show that a character is somebody to reckon with, they still put Jack Daniel's in their hands.'"). From 1964 to 1987, the company underwent a "transformation from a little known regional whiskey to an American icon as synonymous with rock and roll as the electric guitar." *Born to Make Whiskey*, *supra* note 72.

⁷⁶ Stengel, *supra* note 72.

⁷⁷ *VIP Prods., LLC v. Jack Daniel's Prods., Inc.*, No. CV-14-2057-PHX-DGC, 2015 U.S. Dist. LEXIS 64736, at *3 (D. Ariz. May 15, 2015).

⁷⁸ These elements are "(1) a square bottle with a ribbed neck; (2) a black cap; (3) a black neck wrap closure with white printing; and (4) a black front label with white printing." *Id.* at *7.

Daniel's.”⁷⁹ The company registered this trade dress in 2012⁸⁰ and has since attained incontestable status.⁸¹

Plaintiff, VIP Products, LLC (“VIP”), is an Arizona-based company that “designs, manufactures, markets, and sells chew toys for dogs,” including the “Silly Squeakers” line of durable rubber squeaky novelty toys.⁸² In July 2013, VIP released its “Bad Spaniels” novelty dog toy, which “is in the shape of a liquor bottle and features a wide-eyed spaniel over the words ‘Bad Spaniels, the Old. No. 2, on your Tennessee Carpet.’”⁸³ Beyond the phonetic similarity between the Bad Spaniels toy and the bottle design for Jack Daniel’s whiskey, the products share a variety of visual and textual characteristics, including “the shape of the product, the use of white lettering over a black background, and font styles.”⁸⁴

On the packaging for the dog toy, a disclaimer stated that VIP’s product was “not affiliated with Jack Daniel’s.”⁸⁵ Nevertheless, Jack Daniel’s “promptly demanded that VIP stop selling the new toy.”⁸⁶ VIP responded by filing a lawsuit in Arizona district court seeking a declaratory judgment for non-infringement and seeking to invalidate Jack Daniel’s trademark and trade dress registrations on the basis that the claimed marks are functional, “merely ornamental and decorative,” generic, and non-distinctive.⁸⁷ Jack Daniel’s filed a

⁷⁹ *Id.* at *9. *See* JACK DANIEL JACK DANIEL, Registration No. 4,106,178 (“The mark consists of the three-dimensional configuration of the square shaped bottle container for the goods, having an embossed ridge or scalloped design on the neck portion of the bottle, and an embossed signature design comprised of the words ‘JACK DANIEL.’”).

⁸⁰ *See* JACK DANIEL JACK DANIEL, Registration No. 4,106,178.

⁸¹ In American trademark law, a mark registered on the USPTO’s Principal Register that has been in continuous use for five years, and for which there has been no challenge by a third party, can be considered “incontestable” and is thereafter immune from legal challenge to its facial validity. 15 U.S.C. § 1065. *See also* Park’N Fly v. Dollar Park & Fly, 469 U.S. 189, 191 (1985) (where a mark had become incontestable, another party could not challenge the mark as descriptive); Casper W. Ooms & George E. Frost, *Incontestability*, 14 L. & Contemp. Probs. 220 (1949).

⁸² VIP Prods., LLC v. Jack Daniel’s Prods., Inc., No. CV-14-2057-PHX-SMM, 2016 U.S. Dist. LEXIS 133387, at *2–3 (D. Ariz. Sept. 27, 2016).

⁸³ *Id.* at *3.

⁸⁴ *Id.*

⁸⁵ *Id.*

⁸⁶ *Id.*

⁸⁷ *Id.* at *3–4. *See also* Complaint at 4, VIP Prods., LLC v. Jack Daniel’s Prods., Inc., No. CV-14-2057-PHX-DGC, 2015 U.S. Dist. LEXIS 64736 (D. Ariz. May 15, 2015) (No.

variety of counterclaims, alleging trademark and trade dress infringement, dilution by tarnishment, and state law allegations of trademark infringement and unfair competition.⁸⁸

A. District Court Decision

Both parties moved for summary judgment in district court.⁸⁹ VIP contended that Jack Daniel's "infringement and dilution claims [must] be denied because the defenses of nominative and First Amendment fair use shield it from liability."⁹⁰ Further, VIP claimed that Jack Daniel's could not prove its dilution claims under the Trademark Dilution Revision Act ("TDRA") and that Jack Daniel's trademark and trade dress registrations were not entitled to protection.⁹¹

Jack Daniel's left "for trial the issue of whether VIP's alleged parody infring[ed] or dilut[ed] the Jack Daniel's trademarks and trade dress," but asserted that its trademark and trade dress were distinctive and should not be subjected to a cancellation proceeding.⁹² The court denied VIP's motion and granted Jack Daniel's partial summary judgment, issuing a detailed Memorandum and Order on the merits of all three of VIP's claims and the related counterclaims by Jack Daniel's.⁹³

CV-14-02057-PHX-DGC), ECF No. 1 (seeking a declaratory judgment); Amended Complaint at 11, *VIP Prods.*, 2016 U.S. Dist. LEXIS 133387 (No. CV-14-2057-PHX-SMM), ECF No. 49 (seeking a declaratory judgment and cancellation of Jack Daniel's PTO registration).

⁸⁸ See *VIP Prods.*, 2016 U.S. Dist. LEXIS 133387, at *4-6; see also Answer and Counterclaims of Defendant and Counterclaimant Jack Daniel's Properties, Inc. at 4, *VIP Prods.*, 2015 U.S. Dist. LEXIS 64736 (No. CV-14-02057-PHX-DGC), ECF No. 12.

⁸⁹ See Motion and Memorandum of Points and Authorities in Support of Motion for Partial Summary Judgment at 1, *VIP Prods., LLC v. Jack Daniel's Prods., Inc.*, 291 F. Supp. 3d 891 (D. Ariz. 2018) (No. CV-14-02057-PHX-SMM), ECF No. 101 (Jack Daniel's motion for summary judgment on VIP's cancellation claim and declaratory action seeking to find the Jack Daniel's trademark and trade dress functional and/or non-distinctive); Plaintiff's Motion for Summary Judgment on its Claims for Relief and Memorandum in Support at 1, *VIP Prods., LLC v. Jack Daniel's Prods., Inc.*, 291 F. Supp. 3d 891 (D. Ariz. 2018) (No. CV-14-02057-PHX-SMM), ECF No. 110.

⁹⁰ *VIP Prods.*, 2016 U.S. Dist. LEXIS 133387, at *5-6.

⁹¹ *Id.*

⁹² *Id.* at *6.

⁹³ See *id.* at *2.

Inter alia, the court found that that VIP was unable to claim nominative fair use as a defense, as it did not use any of Jack Daniel's marks, "including the Jack Daniel's name; the number 7; the embossed Jack Daniel's signature on the bottle; the same filigree design on the label; the three-sided body label, or the identical combination of elements constituting the trade dress."⁹⁴ Turning to VIP's argument that the Bad Spaniels toy was an expressive work entitled to protection under the First Amendment, the court noted that "the *Rogers* standard applies to artistic or expressive works."⁹⁵ Thus, it found the Bad Spaniels toy was not an expressive work entitled to First Amendment protection.⁹⁶ Correctly applying the *Rogers* test to the Bad Spaniels toy, the court distinguished between "the standard trademark likelihood of confusion analysis"—where a parody defense is applicable to VIP's products—and the category of "artistic expression" to which the *Rogers* test was meant to apply.⁹⁷ Noting the parallels between VIP's Bad Spaniels toy and another parodic dog toy lawsuit,⁹⁸ the court held that "because the adaption of the Jack Daniel's trademark and trade dress [were] being used, at least in part, to promote a somewhat non-expressive, commercial product, the First Amendment [did] not extend to such use."⁹⁹

The district court then granted Jack Daniel's partial summary judgment based on the finding that Jack Daniel's "bottle dress is a source identifier for Jack Daniel's whiskey,"¹⁰⁰ and that Jack Daniel's "has established direct evidence of secondary meaning."¹⁰¹

⁹⁴ *Id.* at *12–13.

⁹⁵ *Id.* at *14–15.

⁹⁶ *Id.*

⁹⁷ *Id.* at *15.

⁹⁸ *See id.* at *16 (referencing *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 417 (S.D.N.Y. 2002) (litigation over Nature Lab, LLC's "Timmy Holedigger" alleged parody dog perfume, which copied the Tommy Hilfiger trademarks)).

⁹⁹ *VIP Prods.*, 2016 U.S. Dist. LEXIS 133387, at *16.

¹⁰⁰ *Id.* at *19.

¹⁰¹ *Id.* at *22. In trademark law, secondary meaning "means proof that the consuming public understands the word or phrase to name the brand[]" in instances where such a word or phrase is not inherently distinctive. Landes & Posner, *supra* note 10, at 290. The existence of secondary meaning is often determined by survey evidence. *See* Beebe et al., *supra* note 38, at 3–6. It permits a company or individual to appropriate an otherwise undistinctive or descriptive word, phrase, color, shape, or trade dress as a trademark when such a mark is understood by the consuming public to denote a specific source of origin

Turning to Jack Daniel's trademark dilution counterclaim, the court found that the language of the TDRA¹⁰² and relevant precedent from the Fourth Circuit¹⁰³ "compel[led] the result that the fair use defense [was] not available to VIP and its alleged parody product."¹⁰⁴ This was because VIP used the "Bad Spaniels trademark and trade dress as source identifiers of its dog toy, which [took] its alleged parody product outside the fair use defense under the TDRA."¹⁰⁵ The court first determined that under Section 1125(c)(2)(A) of the TDRA, "it is undisputed that the sales, advertising, and public exposure of Jack Daniel's whiskey packaged in the Jack Daniel's trade dress provide[d] substantial indirect evidence of fame."¹⁰⁶ The court emphasized that "under the TDRA, a party only must show 'similarity,' not substantial similarity or nearly identical [use], between the famous mark and the accused mark," and ruled that "a reasonable trier of fact could find that the VIP product and Jack Daniel's trade dress [met] the requisite similarity standard for dilution."¹⁰⁷ Thus, the court denied VIP's motion for summary judgment on Jack Daniel's counterclaims, and preserved for trial "the issue of whether VIP's alleged parody infringe[d] or dilute[d] the Jack Daniel's trademarks and trade dress."¹⁰⁸

After the parties' summary judgment motions were resolved, the court held a four-day bench trial in October 2017.¹⁰⁹ At the end of the trial, Judge McNamee found in favor of Jack Daniel's on all remaining claims.¹¹⁰ Integral to this conclusion were the findings that "VIP's intent behind designing the 'Bad Spaniels' toy was to match the bottle design for Jack Daniel's Tennessee Sour Mash Whiskey ('Old No. 7 Brand')" and the "design elements include[d] the size

for the goods or services offered thereunder. *See* Landes & Posner, *supra* note 10, at 288–90.

¹⁰² Trademark Dilution Revision Act of 2006, 15 U.S.C. § 1125(c).

¹⁰³ *See* Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 266 (4th Cir. 2007).

¹⁰⁴ *VIP Prods.*, 2016 U.S. Dist. LEXIS 133387, at *36.

¹⁰⁵ *Id.*

¹⁰⁶ *Id.* at *39.

¹⁰⁷ *Id.* at *48–49.

¹⁰⁸ *Id.* at *6.

¹⁰⁹ *VIP Prods., LLC v. Jack Daniel's Prods., Inc.*, 291 F. Supp. 3d 891, 897 (D. Ariz. 2018).

¹¹⁰ *Id.*

and shape of the product, the use of white lettering over a black background, and font styles.”¹¹¹ Initial marketing materials for the Bad Spaniels toys included “the ‘Bad Spaniels’ product appear[ing] in a bar setting alongside various hanging bottles, one of which can be recognized as a Jack Daniel’s bottle.”¹¹² Given the similarity between the products and VIP’s concession “that it used Jack Daniel’s trademarks and trade dress as a model for its ‘Bad Spaniels’ dog toy,” the court found similarity between the products under the TDRA.¹¹³

At trial, Dr. Simonson—the expert for Jack Daniel’s—introduced testimony “that the ‘Bad Spaniels’ product is likely to tarnish the Jack Daniel’s trademarks and trade dress by creative negative associations, either consciously or unconsciously, and undermining the pre-existing positive associations with its whiskey.”¹¹⁴ Given the nature of Jack Daniel’s products—goods intended for human consumption—and the scatological nature of the negative association created by VIP’s dog toy,¹¹⁵ the district court found that Jack Daniel’s established all elements for a dilution by tarnishment claim.¹¹⁶

Turning to Jack Daniel’s trademark and trade dress infringement claims, the court credited the testimony of survey expert witness Dr. Gerald Ford that “over [twenty-nine percent] of those . . . who had been shown the ‘Bad Spaniels’ product . . . identified Jack Daniel’s [sic] as [the producer] who had made, sponsored, or approved the product pictured.”¹¹⁷ In the same survey, “almost none of those in the control [group]—who had been shown [a] fictitious dog toy—identified Jack Daniel’s in response to [the same] questions” of approval or sponsorship.¹¹⁸ The court weighed evidence of the survey results (which showed a likelihood of consumer confusion “nearly double the threshold to show infringement”),¹¹⁹ the “undisputed”

¹¹¹ *Id.* at 898.

¹¹² *Id.* at 899.

¹¹³ *Id.* at 901.

¹¹⁴ *Id.* at 903.

¹¹⁵ *See id.* at 904–05.

¹¹⁶ *Id.* at 905.

¹¹⁷ *Id.* at 907.

¹¹⁸ *Id.*

¹¹⁹ *Id.* at 908.

nature of VIP's intent to copy the Jack Daniel's trademarks and trade dress,¹²⁰ and the inapplicability of a parody defense since it was clear that VIP "sought to capitalize on Jack Daniel's popularity and good will for its own gain."¹²¹ It ultimately found a likelihood of consumer confusion, and thus trademark and trade dress infringement under federal and state law.¹²² The district court's opinion was, in short, a total victory for Jack Daniel's.

B. Ninth Circuit Decision

VIP appealed to the Ninth Circuit.¹²³ In its March 31, 2020 decision, the appellate panel reversed, vacated, and remanded the district court's judgment on Jack Daniel's trademark infringement and dilution claims.¹²⁴ Ignoring the survey and expert evidence on Jack Daniel's dilution claim, the court found that the "light-hearted, dog-related alterations" to the Jack Daniel's trademark and trade dress were protected under the *Rogers* test.¹²⁵ Judge Hurwitz wrote that it served VIP's goal to create a toy line that reflected on "the humanization of the dog in our lives," and commented on "corporations [that] take themselves very seriously."¹²⁶ The Ninth Circuit affirmed the district court's decision rejecting "VIP's request for cancellation of the registered mark" on the basis that it is distinctive and non-functional.¹²⁷ The court also affirmed the district court's rejection of VIP's nominative fair use defense.¹²⁸ However, in finding that the *Rogers* test applied to a parodic toy like VIP's Bad Spaniels product, the court incorrectly expanded the *Rogers* test's application well beyond the limits of the test's purpose.¹²⁹

Internal Ninth Circuit guidance documents direct judges addressing trademark disputes to *Twentieth Century Fox Television v.*

¹²⁰ *Id.*

¹²¹ *Id.*

¹²² *Id.* at 911.

¹²³ See Notice of Oral Argument on Friday, February 7, 2020, VIP Prods. LLC v. Jack Daniel's Prods., Inc., 953 F.3d 1170 (9th Cir. 2020) (No. 18-16012), ECF No. 50.

¹²⁴ See *VIP Prods.*, 953 F.3d at 1172.

¹²⁵ *Id.*

¹²⁶ *Id.* (internal quotations omitted)

¹²⁷ *Id.* at 1174.

¹²⁸ *Id.*

¹²⁹ *Id.*

*Empire Distribution, Inc.*¹³⁰ This case provides guidance as to whether the *Rogers* test is a legal question decided *de novo* when determining whether *the title of an expressive work* violates the Lanham Act.¹³¹ While the district court correctly noted that a parody defense under a normal likelihood of confusion analysis was the proper means of assessing VIP's claimed First Amendment defense to Jack Daniel's trademark infringement claim,¹³² the panel instead held the *Rogers* test applies to *any* artistic expression.¹³³ It further noted that the Lanham Act only applies to such works if the plaintiff can establish at least one of the two requirements under the *Rogers* test.¹³⁴ This framework would preclude *any* application of trademark law in allegations involving "expressive" content except in the most limited circumstances where the use of a trademark is "not artistically relevant" or "explicitly misleads consumers."¹³⁵ Under this flawed framework, the Ninth Circuit confused parody and the *Rogers* test in its analysis.¹³⁶

The panel's apparent rationale for excusing VIP's alleged infringement of Jack Daniel's was that the Bad Spaniels toys were "expressive works" that "communicate[d] a 'humorous message,' . . . using word play to alter" the Jack Daniel's trademarks.¹³⁷ Accordingly, Judge Hurwitz found the dog toys protected under the *Rogers* test.¹³⁸ However, his analysis follows the contours of *parody* rather than those of the *Rogers* test. Similar to *Gordon v. Drape*

¹³⁰ 875 F.3d 1192 (9th Cir. 2017). *See also supra* notes 65–69 and accompanying text.

¹³¹ This language is pulled from the standard of review and overview of legal issues guidelines distributed to Ninth Circuit judges and their chambers as a part of training provided by the Administrative Offices of the United States Courts, as updated in January 2019. *See* STANDARDS OF REVIEW OUTLINE § III.C.27.ee. (9th Cir. 2017). *Cf. Twentieth Century Fox Television*, 875 F.3d at 1196.

¹³² *See* VIP Prods., LLC v. Jack Daniel's Prods., Inc., 291 F. Supp. 3d 891, 908 (D. Ariz. 2018); VIP Prods., LLC v. Jack Daniel's Prods., Inc., No. CV-14-2057-PHX-SMM, 2016 U.S. Dist. LEXIS 133387, at *15 (D. Ariz. Sept. 27, 2016).

¹³³ VIP Prods. LLC v. Jack Daniel's Prods., Inc., 953 F.3d 1170, 1174 (9th Cir. 2020).

¹³⁴ *Id.*

¹³⁵ *Id.* (quoting *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 265 (9th Cir. 2018)).

¹³⁶ *Id.*

¹³⁷ *Id.* at 1175.

¹³⁸ *See id.* ("A work need not be the 'expressive equal of *Anna Karenina* or *Citizen Kane*' to satisfy this requirement." (quoting *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241 (9th Cir. 2013))).

Creative, Inc.,¹³⁹ where the Ninth Circuit found the juxtaposition of a sardonic image and slogan with a greeting card marking “an event of some significan[ce]” created a “humorous message” resulting in First Amendment protection.¹⁴⁰ Judge Hurwitz stated that though the Bad Spaniels toys were “surely not the equivalent of the *Mona Lisa*,” they were nevertheless expressive works.¹⁴¹

Rather than provide a traditional *Rogers* analysis,—examining whether, despite the expressive nature of the work, the use of a trademark was either “not artistically relevant” or “explicitly misleads consumers”¹⁴²—Judge Hurwitz explained that the Bad Spaniels toys created “‘a simple’ message conveyed by ‘juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.’”¹⁴³ This analysis perfectly mirrors the definition of a parody—articulated by the Fourth Circuit in one example as “a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.”¹⁴⁴ In short, the panel purported to apply one defense to trademark infringement—the *Rogers* test—while, in reality, applied a substantively different defense—that of parody.¹⁴⁵

Underscoring the extent to which the panel mislabeled a parody analysis as an application of the *Rogers* test, Judge Hurwitz emphasized the similarity between VIP’s Bad Spaniels toy and the dog toys at issue in the Fourth Circuit’s case, *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*.¹⁴⁶ In this case, dog toys bearing Louis Vuitton’s trademarks and named “Chewy Vuiton” were found to be

¹³⁹ 909 F.3d 257 (9th Cir. 2018).

¹⁴⁰ *Id.* at 268–69.

¹⁴¹ *VIP Prods.*, 953 F.3d at 1175.

¹⁴² *See, e.g., Gordon*, 909 F.3d at 265.

¹⁴³ *VIP Prods.*, 953 F.3d at 1175 (quoting *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir. 1987)).

¹⁴⁴ *People for Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001) (quoting *L.L. Bean*, 811 F.2d at 34).

¹⁴⁵ *See VIP Prods.*, 953 F.3d at 1175 (“Bad Spaniels comments humorously on” Jack Daniel’s trademarks, and “[t]he fact that VIP chose to convey this humorous message through a dog toy is irrelevant.”) (internal citations omitted).

¹⁴⁶ *See id.* (“The Fourth Circuit’s decision in *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007), supports our conclusion.”).

a parody of the Louis Vuitton brand and its consumers.¹⁴⁷ Judge Hurwitz relied on the parodic nature of the Bad Spaniels toy to claim that VIP was entitled to protection under the *Rogers* test: “[b]ecause Bad Spaniels is an expressive work,”—apparently equating the parodic humor of the toys with an artistic message—he explained that “the district court erred in finding trademark infringement without first requiring [Jack Daniel’s] to satisfy at least one of the two *Rogers* prongs.”¹⁴⁸

Ignoring the circular logic underpinning this conclusion (a parody is expressive and therefore protected not under the test for parody, but under *Rogers*), Judge Hurwitz was also factually and legally incorrect that the district court failed to show Jack Daniel’s satisfied either prong of the *Rogers* test.¹⁴⁹ The second prong asks whether the expressive work “explicitly misleads [consumers] as to the source or the content of the work.”¹⁵⁰ At the district court level, Senior Judge McNamee explicitly made a finding of fact to that effect: he credited Dr. Ford’s survey evidence showing a twenty-nine percent likelihood of consumer confusion, and acknowledged that this clearly surpassed the threshold to show confusion.¹⁵¹ It is hard to imagine clearer evidence that VIP’s use of the Jack Daniel’s trademarks and trade dress “explicitly misle[d] [consumers] as to the source or the content of the work,”¹⁵² as required to satisfy at least one of the *Rogers* prongs.¹⁵³ Accordingly, the Ninth Circuit’s decision suffered fundamental logical flaws in its trademark infringement analysis.

The Ninth Circuit summarily reversed Jack Daniel’s trademark dilution claim due to the rationale that, under *Rogers*, the Bad Spaniels toys were protected expressions.¹⁵⁴ Judge Hurwitz noted that not all speech employed when promoting and selling a product is strictly

¹⁴⁷ *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260 (4th Cir. 2007).

¹⁴⁸ *VIP Prods.*, 953 F.3d at 1175–76.

¹⁴⁹ *See id.*

¹⁵⁰ *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

¹⁵¹ *VIP Prods., LLC v. Jack Daniel’s Prods., Inc.*, 291 F. Supp. 3d 891, 907 (D. Ariz. 2018).

¹⁵² *Rogers*, 875 F.2d at 999.

¹⁵³ *VIP Prods.*, 953 F.3d at 1177–78.

¹⁵⁴ *See id.* at 1176.

commercial, and that some uses of a mark can be “noncommercial” if they “do[] more than propose a commercial transaction,’ . . . and contain[] some ‘protected expression.’”¹⁵⁵ While Judge Hurwitz correctly noted that “use of a mark may be ‘noncommercial’ even if used to ‘sell’ a product,”¹⁵⁶ and that “noncommercial” use of a mark is normally precluded from liability for dilution by tarnishment,¹⁵⁷ the TDRA is more nuanced than depicted. Rather, the TDRA provides an affirmative defense to a dilution by tarnishment claim for “[a]ny fair use . . . other than as a designation of source for the person’s own goods or services, including use in connection with . . . parodying.”¹⁵⁸ Again, the district court’s reasoning followed the confines of the law more closely than the Ninth Circuit. Judge McNamee explicitly found that VIP used the “Bad Spaniels trademark and trade dress as source identifiers of its dog toy, which [took] its alleged parody product outside the fair use defense under the TDRA.”¹⁵⁹

Judge Hurwitz and the rest of the Ninth Circuit panel were apparently convinced by the supposedly all-encompassing First Amendment protection afforded to VIP through the “humorous message” conveyed by its Bad Spaniels toy.¹⁶⁰ Nevertheless, as the Fourth Circuit explained in *Louis Vuitton*, a parody is protected only insofar as it “undoubtedly and deliberately conjures up the [targeted trademarks] and trade dress, but at the same time, it communicates that it is not the [parodied] product.”¹⁶¹ Only an imperfect copy can “evoke a humorous, satirical association that *distinguishes* the products.”¹⁶²

¹⁵⁵ *Id.* (internal citations omitted) (quoting *Nissan Motor Co. v. Nissan Comput. Corp.*, 378 F.3d 1002, 1017 (9th Cir. 2004); *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 906 (9th Cir. 2002)).

¹⁵⁶ *Id.* (quoting *Nissan Motor*, 378 F.3d at 1017).

¹⁵⁷ *Id.* (citing 15 U.S.C. § 1125(c)(3)(C)).

¹⁵⁸ 15 U.S.C. § 1125(c)(3)(A).

¹⁵⁹ *VIP Prods., LLC v. Jack Daniel’s Props., Inc.*, No. CV-14-2057-PHX-SMM, 2016 U.S. Dist. LEXIS 133387, at *36 (D. Ariz. Sept. 27, 2016).

¹⁶⁰ *VIP Prods. LLC v. Jack Daniel’s Props., Inc.*, 953 F.3d 1170, 1175–76 (9th Cir. 2020).

¹⁶¹ *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260 (4th Cir. 2007).

¹⁶² *Id.* at 263.

Unlike *Louis Vuitton*, where there was no evidence of actual confusion,¹⁶³ VIP could not claim that consumers would immediately comprehend the “two simultaneous—and contradictory—messages” of parody: “that it is the original, but also that it is *not* the original and is instead a parody.”¹⁶⁴ Rather, as over twenty-nine percent of potential consumers experienced actual confusion as to the connection between the Bad Spaniels dog toys and Jack Daniel’s, the dog toys could, at best, be considered an unsuccessful parody, neutralizing the parodic First Amendment defense under the TDRA.¹⁶⁵ In sum, by allegedly applying the *Rogers* test in its analysis of the parodic effect of VIP’s products, the Ninth Circuit fundamentally undercut its ability to properly assess the district court’s analysis. By claiming that the humorous nature of the Bad Spaniels toy was fundamentally protected by the First Amendment, the Ninth Circuit not only incorrectly expanded the scope of the *Rogers* test, but also created a holding whose impact remains to be felt.¹⁶⁶

C. Aftermath

Shortly after the Ninth Circuit issued its opinion, Jack Daniel’s filed a petition for rehearing, stating:

Rehearing or rehearing en banc is necessary because the Panel opinion vacating and reversing [the district court’s] findings applie[d] a framework precluded by the trademark nature of VIP’s imitations and adopt[ed] a definition of expressive work unsupported by the Court’s own jurisprudence . . . thus producing an exception that swallows the traditional rules governing trademark infringement.¹⁶⁷

Noting that no other circuits apply the *Rogers* test to parodic or otherwise minimally expressive uses of a trademark “for good

¹⁶³ *Id.*

¹⁶⁴ *People for Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001).

¹⁶⁵ *See* *VIP Prods., LLC v. Jack Daniel’s Prods., Inc.*, 291 F. Supp. 3d 891, 907 (D. Ariz. 2018).

¹⁶⁶ *See* *VIP Prods. LLC v. Jack Daniel’s Prods., Inc.*, 953 F.3d 1170, 1175 (9th Cir. 2020)

¹⁶⁷ Appellee’s Petition for Rehearing and Petition for Rehearing En Banc at 1, *VIP Prods.*, 953 F.3d 1170 (No. 18-16012), ECF No. 63.

reason,” Jack Daniel’s argued that the panel’s “unnecessary constitutionalization of routine trademark disputes” was not only legally incorrect, but also “significantly restrict[ed] trademark owners’ ability to protect consumers against the likely confusion” between goods in such cases.¹⁶⁸

The International Trademark Association (“INTA”) filed an *amicus* brief in support of the rehearing petition, emphasizing the unprecedented application of the *Rogers* test to parodic uses of a mark and to noncommercial speech under the TDRA.¹⁶⁹ Seven trademark law professors led by Stanford Law School’s Mark Lemley and Harvard Law School’s Rebecca Tushnet, filed the brief in opposition to Jack Daniel’s petition for rehearing.¹⁷⁰ However, the professors noted that the most proper means by which the Ninth Circuit should have reached its eventual conclusion “would have been to find as a matter of law that VIP’s *parody* product [was] not likely to cause confusion.”¹⁷¹ Accordingly, their argument was premised on the convenience of a court applying the *Rogers* test to a parody for reasons of judicial economy and cost-saving by litigants.¹⁷² However, in this case—where both parties already committed significant resources to the suit and a four-day bench trial occurred by the time of judgment—such considerations amount to little more than a wish-list of cost-saving measures unaffected by the case itself.¹⁷³

Despite strong arguments in favor of rehearing—which would unlikely have changed the outcome, but would have provided the panel an opportunity to draft a new opinion reaching the same conclusion on Jack Daniel’s claims through application of the parody test—the panel denied rehearing and no judge on the Ninth Circuit

¹⁶⁸ *Id.* at 3–4.

¹⁶⁹ See Brief of *Amicus Curiae* International Trademark Association in Support of Appellee at 8–10, *VIP Prods. LLC.*, 953 F.3d 1170 (No. 18-16012).

¹⁷⁰ Brief of *Amici Curiae* Trademark Law Professors in Opposition to Motion for Rehearing En Banc, *VIP Prods.*, 953 F.3d 1170 (No. 18-16012).

¹⁷¹ See *id.* at 3 (emphasis added).

¹⁷² See *id.* at 3–4. The latter half of the *amici*’s brief focused on the (likely) unconstitutionality of dilution by tarnishment—an issue beyond this scope of this paper—on which the *amici* are quite possibly correct. See *id.* at 6–15.

¹⁷³ Cf. *supra* note 109 and accompanying text.

requested rehearing *en banc*.¹⁷⁴ Jack Daniel's filed a petition for certiorari at the United States Supreme Court in September 2020,¹⁷⁵ with the renewed support of INTA¹⁷⁶ and an additional five *amici*.¹⁷⁷

Three trademark law professors filed an *amicus* brief in opposition to the petition for certiorari—though of the original seven *amici* at the Ninth Circuit, only two remained involved in the case.¹⁷⁸ Again, despite Jack Daniel's emphasis on the inflexibility of the Ninth Circuit's ruling on appeal and the increased burden it places on trademark owners in protecting their brands,¹⁷⁹ the Supreme Court denied certiorari in January 2021.¹⁸⁰ Therefore, despite its status as an “egregiously wrong” application of the test¹⁸¹ resulting in an “outlier decision,” the Ninth Circuit's extremely broad application of the *Rogers* test remains the most recent controlling authority in the Ninth Circuit on the intersection of trademark law and the First Amendment.¹⁸²

¹⁷⁴ See Order at 1, *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, No. 18-16012 (9th Cir. June 3, 2020), ECF No. 72 (denying rehearing and rehearing *en banc*).

¹⁷⁵ Petition for Writ of Certiorari, *Jack Daniel's Prods., Inc. v. VIP Prods. LLC*, 141 S. Ct. 1054 (2021) (No. 20-365).

¹⁷⁶ See Brief for International Trademark Association as Amicus Curiae Supporting Petitioner, *VIP Prods.*, 141 S. Ct. 1054 (No. 20-365) [hereinafter Brief of the International Trademark Association].

¹⁷⁷ See Brief of Amicus Curiae Alcohol Beverage Industry Associations Supporting Petitioner, *VIP Prods.*, 141 S. Ct. 1054 (No. 20-365); Brief for the Intellectual Property Law Association of Chicago as Amicus Curiae Supporting Petitioner, *VIP Prods.*, 141 S. Ct. 1054 (No. 20-365); Brief for Campari America LLC as Amicus Curiae Supporting Petitioner, *VIP Prods.*, 141 S. Ct. 1054 (No. 20-365); Brief for Campbell Soup Co. as Amicus Curiae Supporting Petitioner, *VIP Prods.*, 141 S. Ct. 1054 (No. 20-365); Brief for Constellation Brands, Inc. as Amicus Curiae Supporting Petitioner, *VIP Prods.*, 141 S. Ct. 1054 (No. 20-365); Brief for Intellectual Property Law Association of Chicago as Amicus Curiae Supporting Petitioner, *VIP Prods.*, 141 S. Ct. 1054 (No. 20-365).

¹⁷⁸ See Brief of Amici Curiae Trademark Law Professors in Opposition to Petition for Certiorari, *VIP Prods.*, 141 S. Ct. 1054 (No. 20-365) [hereinafter Brief of Trademark Law Professors]. Compare *supra*, with Brief of the International Trademark Association, *supra* note 176.

¹⁷⁹ See Reply Brief of Petitioner at 2, *VIP Prods.*, 141 S. Ct. 1054 (No. 20-365).

¹⁸⁰ *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170 (9th Cir. 2020), *cert. denied*, 141 S. Ct. 1054 (2021).

¹⁸¹ Reply Brief of Petitioner, *supra* note 179.

¹⁸² *Id.* at 2 (alteration in original).

III. CONCLUSION: A BRIDGE TOO FAR? RE-ASSESSING THE *ROGERS* TEST

The Ninth Circuit's decision in *VIP Products* is merely the latest in a line of cases taking an exceptionally broad view of expressive or artistic works.¹⁸³ While its *ratio decidendi* follows the expanded scope of the *Rogers* test adopted in previous decisions, the panel's opinion went further than past panels dared to tread. Historically, the Ninth Circuit remained at least marginally faithful to the spirit of the initial *Rogers* decision, which was calibrated to “accommodate[] consumer and artistic interests”¹⁸⁴ by applying to “[t]itles, [and] the artistic works they identify,” which “are of a hybrid nature, combining artistic expression and commercial promotion,”¹⁸⁵ and thus implicate the First Amendment due to their artistic and expressive nature. Past decisions focused on balancing First Amendment rights and the Lanham Act with regard to the titles and content of modern art, satirical song lyrics, or the visual décor of a video game's fictionalized setting.¹⁸⁶ In contrast, in *VIP Products*, the Ninth Circuit applied the *Rogers* test to a parody whose artistic value was minimal at best.¹⁸⁷ By expanding the scope of the *Rogers* test to the point of subsuming another well-recognized trademark defense—parody—the panel potentially stretched this line of cases to the breaking point. Comparing this approach to how the Second Circuit (originator of the *Rogers* test) concurrently limited its scope, this Part considers means of restricting the *Rogers* test to cases in line with its original purpose. It then concludes by examining the problems *VIP Products* will likely create in future Ninth Circuit trademark decisions.

¹⁸³ See *supra* Part I.B.2.

¹⁸⁴ *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989).

¹⁸⁵ *Id.* at 998.

¹⁸⁶ See, e.g., *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 899–902 (9th Cir. 2002) (applying the *Rogers* test to a song's lyrics and title); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003) (applying the *Rogers* test to the name and subject of highly expressive photographic works of modern art); *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099–101 (9th Cir. 2008) (applying the *Rogers* test to the name of a store depicted in the artistic context of a video game).

¹⁸⁷ See *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170, 1174 (9th Cir. 2020).

A. *The Restrictive Rogers Test*

The Second Circuit is the font from which the *Rogers* test sprang forth *ex nihilo*, to assess a right of publicity claim framed as a Lanham Act violation.¹⁸⁸ Despite the Second Circuit's role as the progenitor of this test, whose interpretation elsewhere has ballooned to encompass greeting cards¹⁸⁹ and dog toys as "artistic" works,¹⁹⁰ the in-circuit progeny of *Rogers* pale in comparison to their West Coast brethren.

The Second Circuit began narrowing its *Rogers* holding merely 140 days after the opinion was issued in *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*¹⁹¹ (and more than a decade before the Ninth Circuit adopted the *Rogers* test in *Mattel, Inc. v. MCA Records, Inc.*).¹⁹² The case involved a parody of the Cliffs Notes study guides, and the Second Circuit distinguished the factual premise upon which *Rogers* was decided.¹⁹³ Unlike *Rogers*, which addressed a work's title as false advertising, in *Cliffs Notes*, the Second Circuit asked "whether the appearance of a work's cover is confusingly similar to the trademark elements of an earlier cover," with "the added element of parody."¹⁹⁴ While the court acknowledged that "the expressive element of parodies requires more protection than the labeling of ordinary commercial products," it ultimately applied a traditional likelihood of confusion analysis weighing First Amendment interests of parody against "the strong public interest in avoiding consumer confusion."¹⁹⁵ The Second Circuit explained that the *Rogers* test was relevant in instances where "expression, and not commercial exploitation of another's trademark, is the primary intent."¹⁹⁶ Just as a customer shopping for a book, a movie, or "a can of peas" is entitled to know the source of the product and not be misled,¹⁹⁷ the court relied on traditional parody analysis in finding

¹⁸⁸ *Cf. Rogers*, 875 F.2d at 998.

¹⁸⁹ *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 260 (9th Cir. 2018).

¹⁹⁰ *See VIP Prods.*, 953 F.3d at 1174–76.

¹⁹¹ 886 F.2d 490 (2d Cir. 1989).

¹⁹² *See Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

¹⁹³ *Cliff Notes*, 886 F.2d at 495.

¹⁹⁴ *Id.* at 494.

¹⁹⁵ *Id.* at 495.

¹⁹⁶ *Id.*

¹⁹⁷ *Id.* (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 997–98 (2d Cir. 1989)).

the works at issue in *Cliffs Notes* were unlikely to cause consumer confusion, constituting protected speech.¹⁹⁸

The applicability of the *Rogers* test was further narrowed the following year at the district court level in *Tri-Star Pictures, Inc. v. Leisure Time Products, B.V.*¹⁹⁹ This case involved a dispute over an independent film company's right to use the name "River Kwai" in the title of its film, notwithstanding a third party's trademark rights in the celebrated movie, *Bridge on the River Kwai*.²⁰⁰ While sharing a number of factual similarities with *Rogers*—the name in dispute was a film title and neither term ("River Kwai" nor "Rogers") would be registrable on its own as a trademark²⁰¹—the Southern District of New York expressly rejected the applicability of *Rogers*.²⁰² The court reasoned that *Rogers* "only applies to situations where a celebrity's name is used in a title."²⁰³

While the Southern District's view of *Rogers* as articulated in *Tri-Star Pictures* was never explicitly rejected by the Second Circuit, their application of the *Rogers* test three years later in *Twin Peaks Productions, Inc. v. Publications International, Ltd.*²⁰⁴ undercut the Southern District's hard-line approach. The dispute in *Twin Peaks Productions* centered around a book based on the television show *Twin Peaks*.²⁰⁵ In assessing whether the use of the show's name in the book title infringed the trademark, the Second Circuit noted that "[a]lthough *Rogers* arose in the context of a title using a celebrity's name, we have applied it to the literary title 'Cliffs Notes,' a literary title apparently not containing the name of a real person, and certainly not of a celebrity."²⁰⁶

¹⁹⁸ See *id.* at 496–97.

¹⁹⁹ 749 F. Supp. 1243 (S.D.N.Y. 1990).

²⁰⁰ See *id.* at 1245; see also *THE BRIDGE ON THE RIVER KWAI* (Horizon Pictures & Columbia Pictures 1957).

²⁰¹ *Rogers* would have been unable to register her surname as a trademark due to its nature as a term which "is primarily merely a surname," whereas the phrase "River Kwai" refers to a river in Thailand, and is used in the titles of both films in a manner that "is primarily geographically descriptive." See 15 U.S.C. § 1052(e)(2)–(4).

²⁰² *Tri-Star Pictures*, 749 F. Supp. at 1253.

²⁰³ *Id.*

²⁰⁴ 996 F.2d 1366 (2d Cir. 1993).

²⁰⁵ See *id.* at 1370.

²⁰⁶ *Id.* at 1379 (citing *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989)).

Nevertheless, the court maintained the limited breadth of the defense created by the *Rogers* test. It noted that in order to survive an allegation of trademark infringement under the test, an artistically relevant use of a trademark must be assessed for likelihood to mislead the public through a likelihood of confusion analysis.²⁰⁷ The Second Circuit further recognized that even in such circumstances, “[i]t is a fair question whether a title that might otherwise be permissible under *Rogers* violates the Lanham Act when displayed in a manner that conjures up a visual image prominently associated with the work bearing the mark that was copied.”²⁰⁸ Thus, the Second Circuit reduced the hitherto seemingly-powerful *Rogers* test to the status of a preliminary step in a traditional likelihood of confusion test, placing a thumb on the scale in favor of First Amendment protection without wholly overwhelming the balance in its favor.

Two recent cases in the Second Circuit demonstrate the narrowness with which the *Rogers* test applies under this line of cases. In 2019, another dispute arose in the Southern District of New York involving “multiple parties asserting multiple claims to the intellectual property rights of Marilyn Monroe.”²⁰⁹ The court rejected a *Rogers* defense to the use of Marilyn Monroe’s image on a t-shirt claimed to be “an expressive medium.”²¹⁰ The court explained that “the *Rogers* test is usually not the appropriate mechanism for examining an ordinary commercial product.”²¹¹ Even assuming *arguendo* that t-shirts are sufficiently expressive to qualify as artistic works for which a *Rogers* defense could be raised, the court found that consumer confusion about whether Marilyn Monroe’s estate endorsed or authorized these products undermined any application of *Rogers*.²¹² This is because a consumer “has a right not to be misled as to the source of the product.”²¹³ Similarly, in *Cousteau Society, Inc. v. Cousteau*,²¹⁴ the district court rejected a *Rogers* defense in a

²⁰⁷ *Id.*

²⁰⁸ *Id.* at 1380.

²⁰⁹ *A.V.E.L.A., Inc. v. Estate of Marilyn Monroe, LLC*, 364 F. Supp. 3d 291, 299 (S.D.N.Y. 2019).

²¹⁰ *Id.* at 322.

²¹¹ *Id.* at 321–22.

²¹² *See id.* at 322.

²¹³ *Id.* (internal citation omitted).

²¹⁴ 498 F. Supp. 3d 287 (D. Conn. 2020).

dispute over the plaintiff's use of the defendant's grandfather's name and likeness in a documentary, because it was not a case "where simply looking at [the] underlying work itself, and the context in which it appear[ed], demonstrate[d] how implausible it [was] that a viewer [would] be misled into believing that the plaintiff endorsed the defendant's work."²¹⁵

B. Assessing the Consequences of VIP Products

The Second Circuit's more restrictive view of the *Rogers* test is a tonic to the over-expansive progeny of *Rogers* in the Ninth Circuit; the Second Circuit views the likelihood of confusion analysis as being integrated into the second prong of the test and allows evidence of a strong likelihood of confusion (or actual confusion) to overcome strong First Amendment interests in expressive speech.²¹⁶ In *VIP Products*, the Ninth Circuit found that a "humorous message" in the parodic design of a dog toy was protected under the *Rogers* test.²¹⁷ This was interpreted as an all-but-absolute bar on claims under the Lanham Act, despite survey evidence showing that over twenty-nine percent of potential consumers experienced actual confusion as to the connection between the Bad Spaniels dog toys and Jack Daniel's.²¹⁸ However, in the Second Circuit, it is highly likely that such strong evidence of actual consumer confusion would defeat a *Rogers* defense.²¹⁹ While a strong constitutional interest in protecting expressive speech like parody still exists, the First Amendment is not an absolute bar to trademark infringement where a mark's use substantially confuses consumers as to the source of goods. Were the Ninth Circuit to temper its application of the *Rogers* test in such a manner, the worst effects of *VIP Products* could be largely mitigated.

²¹⁵ *Id.* at 298, 310.

²¹⁶ *Compare, e.g.,* *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993), *with* *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170, 1174–76 (9th Cir. 2020).

²¹⁷ *VIP Prods.*, 953 F.3d at 1176.

²¹⁸ *See* *VIP Prods., LLC v. Jack Daniel's Prods., Inc.*, 291 F. Supp. 3d 891, 907 (D. Ariz. 2018).

²¹⁹ *See, e.g.,* *A.V.E.L.A., Inc. v. Estate of Marilyn Monroe, LLC*, 364 F. Supp. 3d 291, 321–22 (S.D.N.Y. 2019).

Beyond the application of *VIP Products* to trademark infringement claims, a troubling precedent now exists in which a trademark dilution claim involving another's mark as branding for an infringing product, was disposed of under *Rogers*' artistic expression theory.²²⁰ As noted above, the plain language of the TDRA provides an affirmative defense to a claim of dilution by tarnishment for "[a]ny fair use . . . other than as a designation of source for the person's own goods or services, including use in connection with . . . parodying."²²¹ At the district court level, Judge McNamee explicitly found that VIP used the "Bad Spaniels trademark and trade dress as source identifiers of its dog toy, which [took] its alleged parody product outside the fair use defense under the TDRA."²²² Therefore, Jack Daniel's prevailed on their dilution claim.²²³ The Ninth Circuit reversed this determination,—without order for a remand and instead finding for VIP on the basis of its "humorous message"²²⁴—upsetting the already-unbalanced First Amendment considerations implicated in the TDRA.

While there is a compelling argument that the dilution by tarnishment doctrine is unconstitutional under the First Amendment,²²⁵ the analysis employed by the Ninth Circuit in *VIP Products* does nothing to correct such underlying constitutional conflict. Rather than resolving this conflict, the *VIP Products* panel substituted the traditional analysis for determining noncommercial speech, instead replacing it with the nebulous bar of humor or parody.²²⁶ As noted in INTA's *amicus* brief supporting Jack Daniel's petition for certiorari, this analysis "improperly shortcuts the analysis of whether a use is 'commercial,'" further eroding an appropriate balance between free speech and trademark interests.²²⁷ Given the district court's uncontroverted finding that VIP clearly intended "to

²²⁰ See *supra* notes 154–66 and accompanying text.

²²¹ 15 U.S.C. § 1125(c)(3)(A) (emphasis added).

²²² *VIP Prods., LLC v. Jack Daniel's Prods., Inc.*, No. CV-14-2057-PHX-SMM, 2016 U.S. Dist. LEXIS 133387, at *36 (D. Ariz. Sept. 27, 2016).

²²³ *Id.*

²²⁴ *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170, 1176 (9th Cir. 2020).

²²⁵ Cf. Brief of Trademark Law Professors, *supra* note 178, at 20–25.

²²⁶ See *VIP Prods.*, 953 F.3d at 1176.

²²⁷ Brief of the International Trademark Association, *supra* note, at 27.

capitalize on Jack Daniel's popularity and good will for its own gain"²²⁸ by using the Bad Spaniels trademark and trade dress as source identifiers of its dog toy,²²⁹ it is hard to square this analysis with the plain language of the TDRA. Short of an upcoming Ninth Circuit case explicitly disavowing this approach, the precedential value of *VIP Products* creates a scenario in which courts will cite to *VIP Products* and to *Rogers* as grounds to incorrectly dispose of a claim for trademark dilution, despite the different standards, purposes, and policy goals of trademark infringement and trademark dilution statutes.

As a whole, the Ninth Circuit's decision in *VIP Products* is distinguished by its overly expansive view of the *Rogers* test and its misunderstanding of the fragile balance between First Amendment and trademark dilution law. As the Supreme Court has denied certiorari, there is little to no chance of correcting the faulty decision itself. Were the Ninth Circuit to reform its understanding of *Rogers* to conform with the restricted application in the Second Circuit, perhaps some of the more pernicious consequences of *VIP Products* could be avoided. Nevertheless, without the panel's decision *sua sponte* to issue an amended opinion, the consequences of this case will likely be widespread in Ninth Circuit jurisprudence and will significantly curtail the trademark rights of mark holders for years to come.

²²⁸ *VIP Prods., LLC v. Jack Daniel's Prods., Inc.*, 291 F. Supp. 3d 891, 908 (D. Ariz. 2018).

²²⁹ *VIP Prods., LLC v. Jack Daniel's Prods., Inc.*, No. CV-14-2057-PHX-SMM, 2016 U.S. Dist. LEXIS 133387, at *36 (D. Ariz. Sept. 27, 2016).