

JACK DANIEL’S VS. BAD SPANIELS— DOES A DOG TOY GET HEIGHTENED FIRST AMENDMENT PROTECTION?

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I. INTRODUCTION

A profound tension lies at the core of trademark law. Traditionally, a trademark’s primary function was to identify the source of a product, thus protecting against deceptive uses of trademarks in commerce by enabling trademark owners to create reliable identifiers for their goods or services and reduce search costs for consumers.¹ When trademark law served primarily to prevent consumer confusion regarding the commercial origin of the goods or services, the possibility of conflicts with freedom of expression was limited.² However, as mass marketing and advertising techniques became ubiquitous in the commercial marketplace, legal scholars became more receptive to the notion that the primary goal of trademark laws also includes protecting the mark’s reputation.³ Consequently, conceptions regarding the scope and

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1. *See, e.g.*, *G. & C. Merriam Co. v. Saalfield*, 198 F. 369, 373 (6th Cir. 1912) (“The entire substantive law of trade-marks . . . is a branch of the broader law of unfair competition. The ultimate offense always is that defendant has passed off his goods as and for those of the complainant.”); *see also* *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) (“Traditional trademark infringement law is part of the broader law of unfair competition . . . That law broadly prohibits uses of trademarks . . . that are likely to cause confusion about the source of a product or service.”).

2. *See* Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 797–98 (2004) (“Traditional federal trademark law doctrinally averted collision with free speech interests by authorizing judicial intervention only in contexts in which consumers were likely to be confused. Anti-dilution statutes, however, protect trademarks from the “likelihood of injury to business reputation or of dilution of the distinctive quality of a mark” absent even arguable or pretextual confusion as to the source of goods or services.”).

3. *See* David S. Welkowitz, *Reexamining Trademark Dilution*, 44 VAND. L. REV. 531, 532 (1991) (noting how the protection of a trademark has evolved over the years); *cf.* Note, *Harnessing Madison Avenue: Advertising and Products Liability Theory*, 107 HARV. L. REV. 895, 904–06 (citing cases recognizing the impact advertising has on consumer expectations). *See generally* Mark Bartholomew, *Advertising and the Transformation of Trademark Law*, 38 N.M. L. REV. 1 (2008).

purpose of trademark protection have shifted in a way that threatens freedom of expression.⁴ This focus shift is most evident in the doctrine of trademark dilution.⁵

In other words, when the concept of trademark dilution arose, trademark rights have expanded drastically from consumer-oriented protections to protect brand identities of famous marks. The Lanham Act,⁶ which establishes the foundation for United States trademark law, provides mark protection against the use of similar marks if the use would likely create consumer confusion or if the dilution of a famous trademark is likely to occur.⁷ What matters is not only whether there is consumer confusion about a product or service's origin, but also whether there is consumer distraction.⁸ Trademark dilution thus pushes in a separate normative direction, creating a policy that often conflicts with First Amendment rights. While trademark infringement focuses on consumers and aims to prevent misleading representations, trademark dilution focuses on the seller's reputation.

Moreover, famous trademarks frequently become cultural landmarks and an integral part of expressive works. Courts have recognized that some trademarks “enter public discourse and become an integral part of our vocabulary” or “transcend their identifying purpose.”⁹ Not surprisingly, many of the products people want to parody are from famous brands.

Imagine entering the store intending to pick up some liquor before your party when you come across Silly Squeakers Liquor Bottles toys adorned with brands such as Doggie Walker,¹⁰ Crispaw,¹¹ and Bad Spaniels.¹² Beyond their

4. See, e.g., Mark A. Lemley, *Romantic Authorship and the Rhetoric of Property*, 75 TEX. L. REV. 873, 900 (1997) (book review) (arguing that trademark owners “are well on their way to owning the exclusive right to pun”).

5. See Michael K. Cantwell, *Confusion, Dilution, and Speech: First Amendment Limitations on the Trademark Estate*, 87 TRADEMARK REP. 48, 52 (1997) (noting that antidilution provisions directly conflict with the free speech guarantees incorporated in the First Amendment).

6. Pub. L. No. 79-489, 60 Stat. 427 (codified as amended in scattered sections of 15 U.S.C.).

7. See 15 U.S.C. §§ 1125(a), 1125(c).

8. See, e.g., *Lever Bros. Co. v. Am. Bakeries Co.*, 693 F.2d 251, 259 (2d Cir. 1982) (explaining that “the bustling, self-service atmosphere of a typical supermarket makes careful examination of products unlikely”).

9. *Mattel v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003); *Twentieth Century Fox Television v. Empire Distr.*, 875 F.3d 1192, 1197–98 (9th Cir. 2017).

10. *Silly Squeakers Liquor Bottles: Doggie Walker*, MYDOGTOY.COM, <https://mydotoy.com/p/Silly-Squeaker-Liquor-Bottle-Doggie-Walker> (last visited Sept. 21, 2022).

11. *Silly Squeakers Wine Bottles: Crispaw*, MYDOGTOY.COM, <https://mydogtoy.com/p/Silly-Squeaker-Wine-Bottle-Crispaw> (last visited Sept. 21, 2022).

12. *Silly Squeakers Liquor Bottles: Bad Spaniels*, MYDOGTOY.COM, <https://mydogtoy.com/p/Silly-Squeaker-Liquor-Bottle-Bad-Spaniels> (last visited Sept. 21, 2022).

parodic features, it is unlikely that you ever considered the intersection of trademark law and the First Amendment. Well, trademark owners do. They often see these products as a threat to their economic interests and seek to use the trademark law as a medium to bring these forms of cultural expression under their control.

But the question is, what sorts of parodic activity fall on the side of the protected expression as opposed to trademark rights? How can courts distinguish lawful from unlawful parodies? Should speech, both commercial and non-commercial, be allowed in trademark law? What happens when the parodies sell something other than speech itself? How can trademark law be balanced with freedom of expression?

As Ninth Circuit Judge Alex Kozinski sums up, it is when “Speech-Zilla meets Trademark Kong.”¹³ In assessing these battles, courts apply the *Rogers* test, named for a 1989 case involving the actress Ginger Rogers.¹⁴ There was a need to introduce such a test because trademark law protects consumers’ interest in being free from confusion about affiliations and endorsements. Still, this protection is limited by the First Amendment, especially if the product or service involved is expressive work. Aware of the necessity to balance the public’s First Amendment interest in free expression against the public’s interest in not being confused about affiliation and endorsement of certain products, the Second Circuit created the *Rogers* test. Under the *Rogers* test, § 43(a)¹⁵ of the Lanham Act does not apply to expressive works “unless the [use of the trademark] has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the [use of trademark] explicitly misleads as to the source or the content of the work.”¹⁶

This Note analyzes the development of the *Rogers* test in the Ninth Circuit’s decision in *VIP Products LLC v. Jack Daniel’s Properties, Inc.*, in which the court held that a squeaking dog toy resembling a bottle of Jack Daniel’s whiskey is an expressive work entitled to First Amendment protection.¹⁷

13. *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 898 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003).

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

15. 15 U.S.C. § 1125(a)(1) (prohibiting, *inter alia*, “any . . . false or misleading representation of fact . . . likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.”).

16. *Rogers*, 875 F.2d at 999.

17. *VIP Prods. LLC v. Jack Daniel’s Props., Inc.*, 953 F.3d 1170, 1172 (9th Cir. 2020), *cert. denied*, 141 S.Ct. 1054 (2021).

Part II explains what a trademark is and summarizes policy arguments of trademark law. Moreover, it provides an overview of the development of dilution law and addresses the relationship between trademark infringement, dilution, and parody. Part III first summarizes *Rogers v. Grimaldi* and then sets forth the Ninth Circuit's application of the *Rogers* test. Part IV explores *Jack Daniel's v. VIP Products*, both at the district level and on appeal, and considers the consequences of the Ninth Circuit's decision. This Note argues that courts have applied the *Rogers* test in cases involving a wide range of expressive works, and that was a reasonable approach here. As the Ninth Circuit once stated, the *Rogers* test is not only dependent on the identifying material appearing in the title but "also appl[ies] to the use of a trademark in the body of the work."¹⁸ Therefore, the Ninth Circuit correctly concluded that VIP's speech is inseparable from the medium in conveying that speech. Furthermore, it lays out the Supreme Court opinions which recently sided with Jack Daniel's and strengthened trademark holders' ability to protect their trademarks against alleged parodies.¹⁹

This Note will argue that the Ninth Circuit was correct in its holding and, therefore, struck the right balance between trademark rights and freedom of expression. In doing so, it facilitates the application of the *Rogers* test to less conventional parodies. Moreover, it also argues that the Supreme Court decision that traditional trademark use does not receive special First Amendment protection, even when it has an expressive message, is inappropriate, and doesn't end ongoing debates regarding First Amendment protection in the context of parodies in trademark disputes.

II. OVERVIEW OF TRADEMARK POLICY AND DOCTRINE

As a springboard for this Note's analysis, Part II recounts fundamental aspects of trademark law, starting with an explanation of what a trademark is and how it works linguistically. Thus, this Part analyzes the internal structure of a trademark and how understanding the structure of a trademark helps distinguish it from other forms of intellectual property. Understanding the distinctive character of trademark law also raises the fundamental question of: What are the justifications for trademark law? This Part then discusses economic policy arguments undergirding trademark law doctrine to answer this question. In particular, these arguments focus on consumer protection and producer protection.

18. E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1099 (9th Cir. 2008).

19. Jack Daniel's Props., Inc., v. VIP Prods. LLC, 953 F.3d 1170, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023).

A. THE MEANING OF A TRADEMARK

Trademark law has evolved and expanded beyond its traditional scope. That evolution is central to *VIP Products LLC v. Jack Daniel's Properties, Inc.*, making it crucial to understand the development of trademarks and trademark law for our future analysis.

A trademark is any word, name, symbol, or device, or any combination thereof, used in commerce to identify and distinguish the goods of one manufacturer or seller from those of another and to indicate the source of the goods.²⁰ In simple words, a trademark is a source identifier, that is to say, a designation symbol used to denote a single seller of goods or services and distinguish it from other sellers.²¹ The essence of a trademark is to accomplish a communicative task.

Starting from the linguistic meaning of the trademark, this Part's structural analysis clarifies the nature of trademark distinctiveness amongst other forms of intellectual property. Also, it sets the groundwork necessary for the study of trademark dilution to follow in later Parts. As Professor Barton Beebe has observed, a trademark is triadic in structure, consisting of three sub-sign elements. First, the trademark must take the form of a "tangible symbol," indicating that "the 'word, name, symbol or device, or any combination thereof' constitutes the trademark's signifier."²² Second, the trademark holder must use the mark in commerce to refer to goods or services, which means that these goods or services constitute the brand's referent.²³ Third, the trademark is required to "identify and distinguish" its referent, which is generally achieved by identifying the referent with a specific source and its goodwill.²⁴ "Thus, in the case of a trademark such as NIKE, the signifier is the word 'nike,' the signified is the goodwill of Nike, Inc., and the referent is the shoes or other athletic gear to which the 'nike' signifier is attached."²⁵

20. See 15 U.S.C. § 1127.

21. See Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2104 (2004); see also J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:1 (5th ed. 2019) ("Under the modern definition of the term 'trademark,' both state common law and federal law follow the definition set forth in the federal Lanham Act: a trademark is a designation used 'to identify and distinguish' the source of goods and services of a person or company. The role that a designation must play to become a 'trademark' is to identify the source of one seller's goods and distinguish that source from other sources. If the designation performs that role, then the law deems it to be 'distinctive' and legally protectable.").

22. Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 646 (2004).

23. *Id.*

24. *Id.*

25. *Id.*

If there is no linkage between the signifier and the goodwill to which it refers, there is no trademark protection. It occurs because “trade name or mark is merely a symbol of goodwill; it has no independent significance apart from the goodwill it symbolizes.”²⁶

Since the primary purpose of the trademark is to serve as a designation of its origin, *stricto sensu*, the trademarks say almost nothing about the composition or characteristics of the product or services.²⁷ For a designation to fulfill the function of identifying and distinguishing the source of the goods or services, it must impact the minds of the consumers.²⁸ “Only where the product configuration has an established meaning as a brand in the minds of consumers is it entitled to protection.”²⁹

Accordingly, the structure of trademark law is not like other forms of intellectual property. Conceptually, a trademark is a type of intellectual property. Theoretically, though, trademark law only regulates the marketplace in a way that enhances consumer welfare. Courts have also historically held that the lack of absolute ownership in a trademark differentiates it from other intellectual property rights, such as patents and copyrights.³⁰

Modern commentators have maintained this critical conceptual insight, which is needed to assess the nature and justification of trademark law. For instance, McKenna argues that “courts did not view trademarks as separable from a producer’s underlying business.”³¹ Hence, the genuine legal interest secured by trademark law is not in the signifier itself. Because trademarks are neither creative nor intellectual creations in the way that patents and copyrights

26. *Marshak v. Green*, 746 F.2d 927, 929 (2d Cir. 1984).

27. See Nicholas S. Economides, *The Economics of Trademarks*, 78 TRADEMARK REP. 523, 526–27 (1988) (explaining how the information of the trademarked product is not provided to the consumers in an analytic form, but rather in summary form, through a symbol).

28. See William P. Kratzke, *Normative Economic Analysis of Trademark Law*, 21 MEMPHIS ST. U. L. REV. 199, 205 (1991) (“Until a word, name, symbol or device plays some informational or identificatory role with respect to a product, it has no value.”).

29. Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 792 (2004) (citing *Wal-Mart Stores, Inc. v. Samara Bros.* 529 U.S. 205, 212–214 (2000)).

30. See, e.g., *Del. & Hudson Canal Co. v. Clark*, 80 U.S. 311, 322 (1871) (“Property in a trade-mark, or rather in the use of a trade-mark or name, has very little analogy to that which exists in copyrights, or in patents for inventions.”); *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924) (“[W]hat new rights do the trade mark confer? It does not confer a right to prohibit the use of the word or words. It is not a copyright.”); cf., *Clorox Co. v. Sterling Winthrop, Inc.*, 117 F.3d 50, 56 (2d Cir. 1997) (“A trademark, unlike other intellectual property rights, does not confer a legal monopoly on any good or idea.”).

31. Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1884 (2007).

are, most scholars reject the notion that trademark rights should serve as an incentive or reward for creating source-identifier-value.³²

If the main objective of intellectual property law is to encourage the creation of new works or improvements to existing ones, whether of a technical or expressive nature,³³ the question that naturally arises is the following: What are the justifications for the existence of trademark law?

B. TRADEMARK POLICY ARGUMENTS

As we have mentioned, prominent legal scholars argue that a trademark is primarily a regulatory entitlement that prevents unfair competition and advances consumer welfare. Consequently, it is not surprising that economic analyses are common in the contemporary trademark law doctrine.³⁴ These justifications consider intellectual property as a system of rules that promote information efficiency.³⁵

It is worth mentioning that other economic justifications for trademark law are sometimes offered. Some authors have argued that trademark law promotes the role of marks in increasing efficiency and attracting quality personnel to companies.³⁶ Others speak of the role of marks to facilitate franchising, brand differentiation, and national expansion of companies in

32. See Roger E. Meiners & Robert J. Staaf, *Patents, Copyrights and Trademarks: Property or Monopoly?* 13 HARV. J.L. & PUB. POL'Y 911, 931 (1990) ("A trademark would have zero value in a world of perfect information because consumers could determine variations in quality and performance among products at no cost."); Deven R. Desai, *From Trademarks to Brands*, 64 FLA. L. REV. 981, 1011–12 (2012) ("Trademarks do not have property rights in gross with the same strong exclusionary and temporary monopoly power that patent and copyright law enjoy."); see also *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 98 (1918) ("In truth, a trade-mark confers no monopoly whatever in a proper sense, but is merely a convenient means for facilitating the protection of one's good-will in trade by placing a distinguishing mark or symbol—a commercial signature—upon the merchandise or package in which it is sold."); accord *Beanstalk Grp. v. AM Gen. Corp.*, 283 F.3d 856, 861 (7th Cir. 2002) ("A trademark is an identifier, not a freestanding piece of intellectual property"); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 922 (6th Cir. 2003) (differentiating between trademarks and patents because the patents confer a property right in gross rather than a limited interest).

33. See, e.g., Peter S. Menell & Suzanne Scotchmer, *Intellectual Property Law*, in 2 HANDBOOK OF LAW AND ECONOMICS (A. Mitchell Polinsky & Steven Shavell eds., 2007).

34. See Beebe, *supra* note 22 at 646 ("The Chicago School of law and economics has long offered a totalizing and, for many, quite definitive theory of American trademark law.")

35. See McKenna, *supra* note 31 at 1844 ("It would be difficult to overstate the level of consensus among commentators that the goal of trademark law is and always has been to improve the quality of information in the marketplace and thereby reduce consumer search costs.")

36. See Mira Wilkins, *The Neglected Intangible Asset: The Influence of the Trademark on the Rise of the Modern Corporation*, 34 BUS. HIST. 66, 87–88 (1992).

different markets.³⁷ Non-economic justifications for trademark law exist as well.³⁸ Nonetheless, these less common alternative justifications should not distract the reader from the centrality of the concept of information efficiency in a market.

Professor Economides, in his well-known treatise on trademark law, states that the main reasons for the existence and protection of trademarks are that “(1) trademarks facilitate and improve consumer decisions, and (2) they encourage companies to produce products of preferable qualities even when they are not observable before purchase.”³⁹ From an economic perspective, trademark law plays a twofold role. It facilitates the transmission of accurate information to the market and enhances incentives for firms to invest in the quality of their activities. While it is true that the minimization of consumer search costs and the promotion of investment represents “a critical intermediate objective of the trademark system, neither of these goals is an end in itself.”⁴⁰ The legally protectable economic value of marks lies in their potential to generate more competitive markets.⁴¹

1. *Consumer Protection*

A trademark is a designation, or sign, that resolves an information asymmetry problem. Asymmetric information is a type of market failure where one of the agents has considerably better information about the unobservable features of a commodity for sale than the other one.⁴² In the trademark context, there is a problem of uncertainty about the quality of the products. This problem becomes more complex when the consumers face more alternatives of similar perceived quality. In deciding on one product without

37. See ROBERT P. MERGES, Peter S. Menell, Mark A. Lemley, *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 645–46 (3d ed. 2003) (cited in Dogan & Lemley, *supra* note 29 at 800).

38. See Bone, *supra* note 21, at 2108–13 (summarizing several non-economic justifications for trademark law and describing the limitations of each).

39. Economides, *supra* note 27, at 526.

40. Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli*, 54 EMORY L.J. 461, 467 (2005).

41. Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 370 (1999) (“[T]he only sensible conclusion, and the one eventually reached, was that trademark protection can both advance and disserve the development of an efficient and desirably competitive market.”).

42. Economides, *supra* note 27, at 526 (“In many markets, sellers have much better information as to the unobservable features of a commodity for sale than the buyers. This is known as information asymmetry.”); see also George A. Akerlof, *A Market for Lemons: Quality Uncertainty and the Market Mechanism*, 84 Q. J. ECON. 448, 490–91 (1970) (explaining how information affects economic decisions).

complete certainty, the most reliable signal for the consumers is the one that commits the seller to fulfill quality promises, which is the trademark.

Trademarks minimize information and transaction costs in the market by allowing customers to evaluate the nature and quality of products before purchasing or using,⁴³ and sometimes even after use.⁴⁴ The more difficult it is to quickly and inexpensively inspect a product to determine its quality, the more consumers rely on trademarks.⁴⁵

2. *Producer Protection*

As this Note has already discussed, the second main objective of trademark law from an economic perspective is to provide incentives to maintain and even increase the quality of the products or services. Companies have the motivation to invest resources in developing and maintaining strong trademarks. In turn, however, the value of the trademarks depends on their ability to maintain consistent quality.⁴⁶

For this system to function correctly, legal norms are necessary. Imagine for a moment a world without trademark protection. Consumers would have struggle greatly to distinguish between products that appear very similar on the surface. Moreover, trademarks would be copied freely by competitors. The

43. See William Landes & Richard Posner, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 167–68 (2003); Economides, *supra* note 27, at 525–27 (analyzing economic benefits of marks that inform consumers of unobservable product characteristics); Kratzke, *supra* note 28, at 214–17 (explaining how trademarks are highly efficient means of communicating product information); see also *Qualitex Co. v. Jacobsen Prods. Co.*, 514 U.S. 159, 163–64 (1995) (trademark law “reduce[s] the customer’s cost of shopping and making purchasing decisions,” and “helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product”); *Ty Inc. v. Perryman*, 306 F.3d 509, 510 (7th Cir. 2002) (“The fundamental purpose of a trademark is to reduce consumer search costs by providing a concise and unequivocal identifier of a particular source of goods.”). *But see* Mark P. McKenna, *A Consumer Decision-Making Theory of Trademark Law*, 98 VA. L. REV. 67, 141 (2012) (“Focusing on search costs has had serious negative effects on trademark doctrine: courts have accepted virtually any argument sounding in consumer confusion terms and the result has been nearly unbridled expansion.”).

44. See Charles J. Walsh & Marc S. Klein, *From Dog Food to Prescription Drug Advertising: Litigating False Scientific Establishment Claims under the Lanham Act*, 22 SETON HALL L. REV. 389, 399 (1992) (“Drugs are true ‘credence’ goods because they possess qualities that cannot be evaluated through normal use. The assessment of a drug’s qualities normally requires complex, time-consuming, and costly studies.”).

45. See Menell & Scotchmer, *supra* note 33, at 1536; see also Bone, *supra* note 21, at 2106 (arguing that the informational function of trademarks is particularly important for products whose features are not evident upon inspection).

46. See William Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 270 (1987) (noting that trademarks have a self-enforcing nature).

cost of copying someone else's trademark is trivial. Consequently, the incentives to engage in fraudulent actions would be enormous in the absence of legal norms. "If the law does not prevent it, free riding will eventually destroy the information capital embodied in a trademark, and the prospect of free riding may therefore eliminate the incentive to develop a valuable trademark in the first place."⁴⁷ In the past, among other things, federal trademark statutes authorized a competitor to obtain relief in limited situations, and many separate laws were confusing and difficult to enforce. For these reasons, Congress passed the Lanham Act in 1946, repealing the laws of 1881, 1905, and 1920.⁴⁸

Nowadays, every trademark infringement claim focuses on the likelihood of consumer confusion.⁴⁹ By establishing a specific legal framework for protecting trademarks against confusion, the Lanham Act ensures a trusted and mutually beneficial channel of communication between producers and consumers.⁵⁰ Trademark law encourages producers to invest in quality because they will enjoy the benefits in terms of reputation others cannot misappropriate. Consumers, on their part, can count on the reduced costs of informing themselves about the source of the product so that they can continue to buy the products of particular producers or to avoid them.⁵¹

Before turning to the next Part, it is essential to summarize that a trademark is primarily a regulatory entitlement that protects trademark holders by preventing unfair competition and protects the general public by advancing consumer welfare. Trademarks convey information and facilitate purchasing decisions. Trademark law also provides a remedy when two or more trademarks on the market are the same or similar to such an extent that they are likely to cause consumer confusion. Because the primary effect of a

47. *Id.*

48. See Ethan Horwitz & Benjamin Levi, *Fifty Years of the Lanham Act: A Retrospective of Section 43(a)*, 7 FORDHAM INTELL. PROP. MEDIA ENT. L.J. 59 (1996) (providing further discussion of this topic).

49. See MCCARTHY, *supra* note 21, § 30:2.50 ("All that must be proven to establish liability and the need for an injunction against infringement is the likelihood of confusion.")

50. See 15 U.S.C. §§ 1114, 1125(a) (providing trademark holders, whether for a registered mark under 15 U.S.C. § 1114, or an unregistered mark under 15 U.S.C. § 1125(a), with a cause of action to protect their marks from infringement).

51. Although we have highlighted two main rationales for the economic justification for trade-mark law, note that some authors offer additional explanations. See, e.g., Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1690 (1999) (discussing the signaling function theory and "the role of trademarks in allowing the growth of complex, long-term organizations spread over a wide geographic area"). See generally Paul Milgrom & John Roberts, *Price and Advertising Signals of Product Quality*, 94 J. POL. ECON. 796 (1986) (presenting an economic signaling model).

trademark is informative, the distinctive character of the sign represents the critical element. That is why trademark infringement claims often focus on the likelihood of consumer confusion test.

C. ANTIDILUTION LAW

This Note began with the assertion that trademark law is characterized by a deep internal tension. Within trademark law, we can visualize a traditional central doctrine, the likelihood of confusion, and a newer, more expansive doctrine, trademark dilution. This Section seeks to support that assertion.

Trademarks protect buyers from being confused by the concurrent uses of trademarks in products or services and the relationship between the companies that produce and sell the products or services.⁵² Therefore, any lawsuit for infringement of a trademark focuses on the infringement of source distinctiveness, that is, the likelihood of consumer confusion.⁵³

Nevertheless, over the past three decades, trademark law has expanded beyond its traditional scope of the likelihood of confusion to protect famous marks against dilution.⁵⁴ Dilution does not necessarily imply infringement, but rather a behavior that can compromise the distinguishing effect of a famous trademark in a broader sense.⁵⁵ Trademark dilution prohibits commercial trademark uses that cause no confusing interference with a famous mark.

It is commonly accepted among trademark scholars that an article by Frank Schechter introduced the concept of dilution.⁵⁶ He believed that harm occurs

52. See Beebe, *supra* note 22, at 653 (explaining that “the trademark does not identify and distinguish goods; it identifies and distinguishes the goods’ source, and the identification of the goods’ source identifies and distinguishes in turn the goods themselves.”).

53. See *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1290 (9th Cir. 1992) (“The core element of trademark infringement is the likelihood of confusion, i.e., whether the similarity of the marks is likely to confuse customers about the source of the products.”).

54. See Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98 § 3(a), 109 Stat. 985 (codified at 15 U.S.C. §§ 1125(c), 1127 (2000)) (amended by the Trademark Dilution Revision Act in 2006); see also David S. Welkowitz, *TRADEMARK DILUTION: FEDERAL, STATE, AND INTERNATIONAL LAW* (2002) (noting that for almost fifty years, until the Federal Trademark Dilution Act arrived in 1996, state dilution laws existed. For example, Massachusetts enacted the first dilution statute, in 1947. In addition to Massachusetts, they were state laws in Illinois (1953), New York (1955), Georgia (1955), and Connecticut (1963).

55. See Christine Haight Farley, *Why We Are Confused about the Trademark Dilution Law*, 16 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 1175, 1185 (2006) (noting that “[i]nterestingly, bad faith is not even present in any dilution ‘test,’ as it is under the traditional confusion test.”).

56. See Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 *HARV. L. REV.* 813, 816–18 (1927) (discussing the judgment of September 11, 1924, *Landgericht Elberfeld*, 25 *Juristische Wochenschrift* 502, XXV *Markenschutz und Wettbewerb* (M.U.R.) 264, in which a German court prevented the name, originally registered in connection with a famous mouthwash, from being used in connection with unrelated steel products).

when a famous, distinctive mark loses its singular meaning, which is “the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competing goods.”⁵⁷ Although it may seem surprising to us today, when Schechter’s ideas appeared, there was sustained criticism of his approach.⁵⁸

Trademark dilution occurs when a person or company uses a trademark identical or substantially similar to the pre-existing trademark, stimulating a mental association by consumers concerning the two marks, thus lowering the strength of the original mark. As Schechter explained to Congress, “if you allow Rolls Royce restaurants and Rolls Royce cafeterias, and Rolls Royce pants, and Rolls Royce candy, in 10 years you will not have the Rolls Royce mark any more.”⁵⁹ In other words, dilution occurs when, because two signifiers are similar, the junior signifier (the tangible form of the mark) dilutes the distinctiveness of the senior signifier.⁶⁰ Recall that according to Beebe’s semiotic relationship, “differential distinctiveness describes the extent to which a mark’s signifier is distinctive from other signifiers in the trademark system.”⁶¹ In the typical dilution example, the plaintiff’s and the defendant’s signifiers (the tangible form of the trademark) are very similar, if not indistinguishable. Still, because their referents are the products to which the marks are affixed) are sufficiently different, consumers are not confused as to source. Consequently, this situation does not give rise to trademark infringement, which requires to show a likelihood of confusion between the two products. As Beebe points out, in this sense, trademark dilution

57. *Id.* at 825.

58. See, e.g., John Wolff, *Non-Competing Goods in Trademark Law*, 37 COLUM. L. REV. 582, 602 (1937) (arguing that Schechter’s position was very radical for the North American courts, basically because the American law of unfair competition rests on the imitation behavior, while German law admits immoral acts, which makes it much broader when it comes to be applied and further stating “[t]he very incongruousness of Schechter’s theory with the tradition and the fundamental principles of the common law forms the chief obstacle to its general acceptance in this country”); Felix S. Cohen, *Transcendental Nonsense and the Functional Approach*, 35 COLUM. L. REV. 809, 814 (1935) (noting that Schechter had focused on the damage, but not the cause (misappropriation)).

59. Hearings Before the House Comm. on Patents, 72d Cong. 15 (1932) (statement of Frank I. Schechter), quoted in Robert Burrell & Michael Handler, *Dilution and Trademark Registration*, 17 TRANSNAT’L L. & CONTEMP. PROBS. 713, 742 (2008).

60. See Beebe, *supra* note 22, at 676; see also Richard A. Posner, *When Is Parody Fair Use?*, 21 J. LEGAL STUD. 67, 75 (1992) (“A trademark seeks to economize on information costs by providing a compact, memorable, and unambiguous identifier of a product or service. The economy is less when, because the trademark has other associations, a person seeing it must think for a moment before recognizing it as the mark of the product or service.”).

61. Beebe, *supra* note 22, at 625.

constitutes a type of “nontrespassory nuisance” as to the plaintiff’s signifier.⁶² The trademark dilution action is intended to avoid such nuisances and, by doing so, preserve the differential distinction of the plaintiff’s signifier, regardless of the referent to which it is assigned.⁶³ “The prohibition against dilution is thus a prohibition against interference in *intermark* relations of value between the plaintiff’s signifier and all other signifiers in the trademark system.”⁶⁴

Curiously, the notion of dilution originally arose in Germany in 1924, in the *Odol* case, which was essentially a misappropriation case that happened to implicate a trademark.⁶⁵ There, the plaintiff used “Odol” in connection with mouth-wash product, while the respondent succeeded in registering “Odol” for products in steel industry. Nonetheless, the *Odol* court did not analyze the facts before it under trademark provisions.⁶⁶ However, as Beebe argued, when Schechter introduced the concept of dilution, he omitted that dilution was a doctrine of misappropriation and went as far as to erase the court’s fundamental conclusion from his translation of *Odol*’s opinion to support his concept of trademark dilution theoretically.⁶⁷

62. *Id.* at 676.

63. *Id.*

64. *Id.* (emphasis original).

65. See 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,”* INTELLECTUAL PROPERTY AT THE EDGE: THE CONTESTED CONTOURS OF IP 59, 64–70 (Rochelle Cooper Dreyfus & Jane C. Ginsburg, eds, 2014).

66. See *id.* at 65 (“Instead, it based its decision on two other provisions in German law, neither of which required a showing of consumer confusion. The first was § 826 of the German Civil Code of 1900 (the ‘BGB’): ‘Who, in a manner contrary to good morals [*gegen die guten Sitten*], intentionally inflicts damage on another is liable to compensate the other for the damage.’ The second was § 1 of the Law against Unfair Competition of 1909 (the ‘UWG’): ‘Who, in the course of trade, takes actions that impede against good morals [*gegen die guten Sitten*] can be sued for injunctive relief and compensation.’” (citations omitted)).

67. See *id.* at 71–72 (“Schechter omitted one sentence in particular. The penultimate page of ‘Rational Basis’ provides a lengthy block quotation from the Wertheimer translation, but from the middle of that block quotation Schechter excised and replaced with an ellipsis the following sentence, now familiar to us, from the *Odol* opinion: ‘It is opposed to good morals to appropriate thus the fruits of another’s labor in the consciousness that that other will or may thereby be damaged.’ Why would Schechter feel compelled to suppress the *Odol* court’s core finding, the very foundation of its ruling? Schechter’s expurgation of this sentence is consistent with another peculiarity of ‘Rational Basis.’ While the *Odol* court did not hesitate to explain why the respondent used the ‘Odol’ mark (‘for the obvious purpose of deriving from its selling power some advantage in marketing its own products’), Schechter scrupulously avoided speculating in ‘Rational Basis’ on what motivated defendants to adopt famous marks. Instead, he addressed only the damage such conduct inflicted on those marks. Indeed, he repeatedly sought to focus attention on the mysterious nature of this damage. Schechter’s purpose here was the same that motivated his deletion of the *Odol* court’s reference to

Nowadays, dilution actions fall into one of two categories. The first is dilution by blurring,⁶⁸ which manifests as the weakening of the power of sale and the value of a trademark through the unauthorized use of a trademark or service mark of a different nature but can weaken associations between a trademark and its product category and other distinctive aspects, which then ceases to function as a unique identifier.⁶⁹ The second is dilution by tarnishment.⁷⁰ It occurs when a famous brand is linked with harmful or poor-quality products or services, creating unwanted associations or causing a reduction in the level of preference of the famous mark.⁷¹

Dilution's importance is not for protecting consumers per se but rather the private interests of trademark owners and trademarks themselves.⁷² Then, both types of dilution⁷³ are similar in that the doctrine of dilution demands

'appropriate[ing] thus the fruits of another's labor': he sought to suppress any link between trademark dilution and misappropriation. Schechter did so, I suggest, in an attempt to cloak his concept of dilution in the emerging fashion of legal realism." (citations omitted).

68. 15 U.S.C. § 1125(c)(2)(B).

69. Menell & Scotchmer, *supra* note 33, at 1552 (explaining how dilution by blurring imposes some costs on consumers and the famous trademark owner). As "new use of the Rolls Royce term gained popularity, the association between the mark and a particular source would become blurred. Furthermore, as more companies in unrelated markets adopt this moniker—Rolls Royce tennis racquets, Rolls Royce landscaping, Rolls Royce tacos—the distinctive quality of the mark would become further eroded. Over time, consumers would lose the non-product specific identity (i.e., Rolls Royce as a brand of uncompromising quality and ornate styling) that the original Rolls Royce mark once evoked." *Id.*

70. 15 U.S.C. § 1125(c)(2) C).

71. See Menell & Scotchmer, *supra* note 33, at 1553 ("If the maker of pornographic films were to sell their movies under the brand 'Disney,' it is unlikely that consumers would believe that the Disney Corporation, famous for family orient-ed entertainment, was the manufacturer of such unwholesome products. Nonetheless, consumers' shopping lexicon would arguably be distorted because the Disney name would trigger associations with both family-oriented content and smut. Such a negative association could well injure the Disney Corporation's brand equity. As with blurring, tarnishment interferes with established associations. Perhaps even more so than blurring, it undermines brand equity.").

72. Eric A. Prager, *The Federal Trademark Dilution Act of 1995: Substantial Likelihood of Confusion*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 121, 123 (1996); see also *Mosely v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) (nothing that "[u]nlike traditional infringement law, the prohibitions against trademark dilution . . . are not motivated by an interest in protecting consumers."); cf. Transcript of Oral Argument, *Ringling Bros.-Barnum & Bailey v. Utah Div. of Travel Dev.*, 935 F. Supp. 763 (E.D. Va. 1996), quoted in Farley, *supra* note 55, at 1177 (where the federal appellate judge in litigation under the first federal dilution statute said to the attorney of the trademark owner "boy you must have some lobby to get a law like that passed.").

73. Interestingly, Schechter never conceived of blurring or tarnishment as forms of trademark dilution, nor did he ever use these denominations. Yet these conceptualizations of dilution have become dominant in the US approach to antidilution protection. For more information, see Beebe, *supra* note 65, at 79–80 ("It is a strange irony that the German-

neither proof of confusion nor competition between the parties.⁷⁴ However, in a claim for dilution by tarnishment, the focus is on the mark owner's goodwill, not on the mark's distinctiveness.⁷⁵ The underlying idea is that although consumers are unlikely to think that the trademark owner is affiliated with the junior user's distasteful or substandard goods, they "will nonetheless no longer have uniformly positive associations with the original trademark as a result of her exposure to the tarnishing use."⁷⁶ As advertising shifted from informative to persuasive strategies, trademark dilution came to safeguard the advertising power of trademarks. In this regard, dilution constitutes a significant shift in trademark jurisprudence. To put it simply, "dilution begins

American treatise writer Rudolf Callmann is largely responsible for the Americans' embrace in the late century of blurring and tarnishment, terms which Callmann initially took from an anonymous 1964 Harvard Law Review note. The irony is that Callmann made no effort in his many publications on dilution to hide the misappropriation basis and rights-in-gross nature of antidilution protection. On the contrary, he openly advocated conceiving of trademark law as a species of property law rather than unfair competition law and candidly stated his belief that when courts held in favor of antidilution plaintiffs, they did so on misappropriation grounds.⁷⁷

74. *Franklin Mint Co. v. Manatt, Phelps & Phillips, LLP*, 109 Cal. Rptr. 3d 143, 170 (Cal. App. 2010) ("In the dilution context, likelihood of confusion is irrelevant."). Some courts even recognized actionable dilution in the post-sale context. *See Ferrari S.P.A. Esercizio v. Roberts*, 944 F.2d 1235, 1245–46 (6th Cir. 1991); *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 218 (2d Cir. 1999). On the other hand, trademark law has traditionally tolerated numerous uses of same word in unconnected context, as long as these uses do not confuse the consumers. *See MCCARTHY*, *supra* note 21, § 24:11 ("If there is no likelihood of confusion (and in absence of dilution), the same marks can peacefully co-exist on different goods and services. Some well-known examples of co-existence include United Airlines and United Van Lines, Eagle Shirts, Eagle Pencils, Eagle Pretzels, Eagle Brand Condensed Milk, Champion spark plugs and Champion sportswear, Delta Airlines, Delta Dental Insurance and Delta Faucets, Ace retail hardware stores and Ace bandages, Tropicana Las Vegas Hotel and Tropicana orange juice, The Dow Stock Market Index and Dow Chemical Company, Dell Computers and Dell Magazines."). *But see* Robert Brauneis & Paul Heald, *Trademark Infringement, Trademark Dilution, and the Decline in Sharing of Famous Brands: An Introduction and Empirical Study*, 59 *BUFF. J. INT'L L.* 141 (2011) (stating that brand sharing has declined significantly over the past decades due to the anti-dilution law).

75. Sandra L. Rierson, *The Myth and Reality of Dilution*, 11 *DUKE L. & TECH. REV.* 212, 245 (2013) ("[I]n a claim for dilution by tarnishment, the association between the two marks is actionable not because it harms the mark's distinctiveness, but because, in theory, it harms the mark owner's goodwill."); *see also TY Inc. v. Perryman*, 306 F.3d 509, 511 (7th Cir. 2002) ("[C]onsumers will not think the striptease joint [is] under common ownership with the jewelry store. But because of the inveterate tendency of the human mind to proceed by association, every time they think of the word 'Tiffany' their image of the fancy jewelry store will be tarnished by the association of the word with the strip joint.").

76. Rierson, *supra* note 75, at 246. *But see Landes & Posner*, *supra* note 43, at 306–07 (holding that there are possible economic justifications for this extension of the trademark law. These justifications are related to the potential for confusion, external benefits, and investment in reputation capital).

where infringement and its likelihood of confusion test reach their doctrinal limits.⁷⁷

Hence, dilution theories are difficult to square with traditional trademark principles because, in the long term, dilution is more about enforcing moral judgments than regulating economic behavior.⁷⁸ “[M]odern trademark law differs fundamentally from its traditional counterpart in its understanding of what a trademark does and how it adds value.”⁷⁹ There can be no doubt that most the important assignment in designing a new legal institution is the choice of a leading concept fit to be instantiated. In doing so, a new legal context as well as existing laws should be considered.

Yet Professor McCarthy has stated that “[n]o part of trademark law that I have encountered in my forty years of teaching and practicing IP law has created so much doctrinal puzzlement and judicial incomprehension as the concept of “dilution” as a form of intrusion on a trademark.”⁸⁰ Even the United States Supreme Court has had trouble understanding what dilution is.⁸¹ Not surprisingly, almost every aspect of dilution law has been the subject of sustained criticism over the last decades.⁸² Before proceeding to the next Part,

77. Paul Edward Kim, *Preventing Dilution of the Federal Trademark Dilution Act: Why the FTDA Requires Actual Economic Harm*, 150 U. PA. L. REV. 719, 723 (2001). *But see* Gerard N. Magliocca, *One and Inseparable: Dilution and Infringement in Trademark Law*, 85 MINN. L. REV. 949, 966 (2001) (“Although dilution is often described as starting where the likelihood of confusion test leaves off, it is more accurate to say that infringement follows a fortiori from dilution.”).

78. *See* Mark Bartholomew, *Trademark Morality*, 55 WM. & MARY L. REV. 85, 138 (2013); *see also* Farley, *supra* note 55, at 1183–84 (stating that “what is being sought by the trademark bar is statutorily enforced mind control” and that “the main problem with dilution law is that it provides a remedy without a supportable theorization of the harm”).

79. McKenna, *supra* note 31, at 1843.

80. J. Thomas McCarthy, *Dilution of a Trademark: European and United States Compared*, 94 TRADEMARK REP. 1163, 1163 (2005); *see also* Robert G. Bone, *Schechter’s Ideas in Historical Context and Dilution’s Rocky Road*, 24 SANTA CLARA COMPUT. & HIGH TECH. L.J. 469, 470 (2008) (“Dilution is one of the great mysteries of trademark law. Judges have trouble understanding it and scholars have difficulty justifying it.”).

81. *See* Farley, *supra* note 55, at 1177 (explaining how in *Moseley v. V Secret Catalog*, 537 U.S. 418 (2005) nearly all the questions from the Justices were seeking to simply understand what dilution is).

82. *See, e.g.*, Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029, 1037 (2006) (highlighting that the harm of dilution is elusive because it is not clear whom the law is trying to protect); Farley, *supra* note 55, at 1184 (arguing that anti-dilution law provides a remedy without a supportable theory of the harm and that, if any harm can be traced to dilutive speech, it is harm to the ability of merchants to profit from psychological manipulation of consumers); Mary LaFrance, *No Reason to Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech*, 58 S.C. L. REV. 709 (2007) (analyzing the free speech implications of anti-dilution protection); *accord* Robert G. Bone, *A Skeptical View of the Trademark Dilution Revision Act*, 11 INTELL. PROP. L. BULL. 197 (2007) (arguing that dilution lacks a coherent policy foundation); *see* Robert N. Klieger, *Trademark Dilution: The Whittling away of the Rational Basis for Trademark*

note that dilution law grants special protection to well-known marks by prohibiting all variations and evocation of the trademark, even those that do not constitute trademark infringement. Unlike a trademark infringement action, which protects both consumers and trademark owners, the dilution action works to benefit the trademark owners. It does so even when there is no appreciable risk that a consumer will confuse the origin of the product associated with the trademark.

D. DILUTION VS. PARODY

Dictionaries provide two definitions of parody: (1) a “composition in prose or verse in which the characteristic turns of thought and phrase in an author or class of authors are imitated in such a way as to make them appear

Protection, 58 U. PITT. L. REV. 789, 841 (1997); Kristen Friday, *Does Dilution Make Trademarks into Unconstitutional Patents?*, 12 J. CONTEMP. LEGAL ISSUES 180, 183 (2001) (both questioning the constitutionality of the Federal Trademark Dilution Act); Kenneth L. Port, *The Commodification of Trademarks: Some Final Thoughts on Trademark Dilution*, 46 HOFSTRA L. REV. 669, 669 (2017) (arguing that the Federal Trademark Dilution Act “has not been the panacea for famous marks it was intended to be and has created perverse unintended consequences”); cf. Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507 (2008) (questioning the imagination cost argument); Graeme W. Austin, *Tolerating Confusion about Confusion: Trademark Policies and Fair Use*, 50 ARIZ. L. REV. 137 (2008) (pouring scorn on the imagination cost argument); Sarah Lux, *Evaluating Trade Mark Dilution from the Perspective of the Consumer*, 34 U.N.S.W. L.J. 1053 (2011) (arguing that consumer-based justifications for anti-dilution protection lack internal consistency); Rierison, *supra* note 75 (arguing that the costs of anti-dilution laws to free speech and competition exceed any benefits to trademark owners); Christopher Buccafusco, Paul J. Heald & Wen Bu, *Testing Tarnishment in Trademark and Copyright Law: The Effect of Pornographic Versions of Protected Marks and Works*, 94 WASH. U. L. REV. 341 (2017) (finding no statistically significant empirical proof of trademark tarnishment, and some significant evidence of enhanced consumer preferences to the tarnished movies); see also Barton Beebe & C. Scott Hemphill, *The Scope of Strong Marks: Should Trademark Law Protect the Strong More Than the Weak?*, 92 N.Y.U. L. REV. 1339, 1339 (2017) (holding that strong trademarks are less likely to be confused with imitations); Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827, 904–05 (2004) (explaining that “trademark law’s understanding of the consumer is sometimes much less rational than consumers have been throughout history”); Chris Brown, *A Dilution Delusion: The Unjustifiable Protection of Similar Marks*, 72 U. CIN. L. REV. 1023, 1038–39 (2004) (quoting psychology evidence that the mental activity regarding related uses may reinforce rather than blur the trademark in some cases). See generally Barton Beebe, Roy Germano, Christopher Jon Sprigman & Joel Steckel, *Testing for Trademark Dilution in Court and the Lab*, 86 U. CHI. L. REV. 611 (2019) (casting doubt on evidence of dilution by blurring). But see Jerre B. Swann, *An Interdisciplinary Approach to Brand Strength*, 96 TRADEMARK REP. 943, 975–76 (2006) (defending dilution law).

ridiculous,”⁸³ and (2) a “literary or artistic work that imitates the characteristic style of an author or a work for comic effect or ridicule.”⁸⁴

As some scholars have noted, “[p]arodies make fun of a thing by copying enough of it to make it the author of a parody knows his or her subject well; however, the parodist does not need to affect a pretension of ignorance. In fact, the parodist makes his or her familiarity with the original work obvious.”⁸⁵

To understand what parody means in trademark law context, it is helpful to mention how the courts define a parody. An often-cited decision says that a parody is “a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.”⁸⁶ The Supreme Court follows this order of ideas by defining parody as “the use of some elements of a prior author’s composition to create a new one that, at least in part, comments on that author’s works.”⁸⁷

Generally, to be successful, a parody must: “communicate some articulable element of satire, ridicule, joking, or amusement,”⁸⁸ it “must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is not the original.”⁸⁹ Thus, “[a] parody relies upon a difference from the original mark, presumably a humorous difference, in order to produce its desired effect.”⁹⁰

Now that we know why the dilution doctrine represents “a fundamental shift in the nature of trademark protection,”⁹¹ it is easier to understand how

83. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580 (1994) (quoting 11 THE OXFORD ENGLISH DICTIONARY 247 (2d ed. 1989)).

84. *Id.* (quoting THE AMERICAN HERITAGE DICTIONARY 1317 (3d ed. 1992)).

85. Roger J. Kreuz & Richard M. Roberts, *On Satire and Parody: The Importance of Being Ironic*, 8 METAPHOR & SYMBOLIC ACTIVITY 97, 103 (1993).

86. *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 434 (S.D.N.Y. 2016) (quoting *Haute Diggity Dog*, 507 F.3d at 260); see also *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir.1987).

87. *Campbell*, 510 U.S. at 580. Although a copyright fair use case, *Campbell’s* application has not been limited to copyright cases; see, e.g., *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 199 (5th Cir. 1998) (“[T]he Supreme Court considered parody in the copyright context, which is relevant to the treatment of parody in the trademark con-text.”); *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 901 (9th Cir. 2002) (applying *Campbell’s* requirement that parody must target the original).

88. *Louis Vuitton*, 507 F.3d 252, 260 (4th Cir. 2007).

89. *PETA v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001) (quoting *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 494 (2d Cir. 1989)).

90. *Jordache Enters, Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1486 (10th Cir.1987) (finding the use of “Lardashe” jeans for larger women to be a successful and permissible parody of “Jordache” jeans).

91. *Lemley*, *supra* note 51, at 1698; see also *Rierson*, *supra* note 75, at 212 (2013) (“A plaintiff may state a claim for dilution even though no one is likely to be confused; plaintiff

dilution laws have far-reaching non-economic costs, as they have the potential to infringe upon protected speech, such as parody.⁹² For example, trademark owners repeatedly invoke anti-dilution provisions against junior users of their trademarks in a manner they dislike. They bring claims for singing about Barbie doll,⁹³ poking fun of a Louis Vuitton handbag,⁹⁴ making fun of L.L. Bean's mail order catalog,⁹⁵ or operating suck sites.⁹⁶

As one commentator put it, “[p]roponents of anti-dilution law often argue that dilution doctrine is properly limited if it is applied to prevent only ‘commercial’ and not ‘expressive’ junior uses of trade marks.”⁹⁷ Apropos the issue at hand, dilution law provides a general exemption from dilution liability for any non-commercial use of a trademark.⁹⁸ There are internal statutory safeguards for any *fair use* of a trademark designed to identify and parody, criticize, or comment upon “the famous mark owner or the goods or services of the famous mark owner.”⁹⁹ Nonetheless, these safeguards do not apply if the defendant has used the plaintiff's trademark as a source designation for his or her own goods or services.¹⁰⁰

and defendant do not compete; and plaintiff has incurred no actual economic injury.”); *id.* at 214 (“We do not require trademark holders to prove actual economic injury in the context of a dilution claim because, in truth, there probably is none. Instead, we have granted the holders of famous trademarks the equivalent of a moral right to these marks: an extension of the rights granted to a creator of an expressive work in the copyright context.”); Long, *supra* note 82, at 1035–36 (“Dilution is a more exclusionary version of the trademark entitlement than the classic likelihood-of-confusion variant.”); Margaret Jane Radin & R. Polk Wagner, *The Myth of Private Ordering: Rediscovering Legal Realism in Cyberspace*, 73 CHI.-KENT L. REV. 1295, 1305 (1998) (noting that modern trademark law is moving towards a property rights regime).

92. Wendy J. Gordon, *Introduction, Symposium, Ralph Sharp Brown, Intellectual Property, and the Public Interest*, 108 YALE L.J. 1611, 1614–15 (1999) (expressing concern regarding dilution's capability to frustrate comparative advertising and parody); *see also* Barton Beebe & Jeanne Fromer, *Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 HARV. L. REV. 945, 982 (2018) (“[W]hen we use our language, nearly three-quarters of the time we are using a word that someone has claimed as a trademark.”).

93. *See* *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 899 (9th Cir. 2002); *see also* Stacey L. Dogan & Mark A. Lemley, *Parody as Brand*, 47 U.C. DAVIS L. REV. 473, 474–77 (2013) (discussing trademark cases concerning parodies).

94. *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 430 (S.D.N.Y. 2016); *Louis Vuitton*, 507 F.3d 252 at 257.

95. *See* *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 27 (1st Cir. 1987).

96. *See, e.g.,* *Bosley Med. Inst. v. Kremer*, 403 F.3d 672 (9th Cir. 2005); *Lamparello v. Falwell*, 420 F.3d 309, 311 (4th Cir. 2005).

97. Lux, *supra* note 82, at 1062; *see also* 15 U.S.C. § 1125(c)(3)(C) (containing a general exemption from dilution liability for any non-commercial use of a trademark).

98. 15 U.S.C. § 1125(c)(3)(C).

99. 15 U.S.C. § 1125(c)(3)(A)(ii).

100. 15 U.S.C. § 1125(c)(3)(A)); *see also* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:90 (5th ed. Dec. 9) (“First Amendment

For parodists, the statute configuration produces difficulties in evaluating potential liability. Although there is an unequivocal defense for parody, it applies specifically to parody that uses the trademark other than as a designation of source. Both First Amendment and trademark jurisprudence give special status to non-commercial speech, which is reflected in court decisions.¹⁰¹ Consequently, parody in many cases does not benefit from this defense. It occurs because, most commonly, variations of famous trademarks appear on the front of T-shirts, posters, toys, or mugs intended for commercial sale. In these cases, we have a symbiosis of commercial and non-commercial speech. There is an offer to sell something apart from the parody itself.

Since the statute's fair use defense does not include all parodies that behave as trademarks, courts engage in a fact-specific analysis of factors in these kinds of cases.¹⁰² Unsurprisingly, courts have struggled with the parody analysis. While courts have protected parodies in some trademark cases, they have also held other parodies to be illegal.¹⁰³

protection is greatest in the case of an editorial, noncommercial parody which causes tarnishment. Free speech concerns are somewhat lessened, but still relevant, where the parody is a trademark used to identify a commercial product such as wearing apparel.”).

101. *See* *Brown v. Ent. Merchs. Ass'n*, 564 U.S. 786, 790 (2011) (noting that non-commercial speech is often sold for profit); *see also* *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 32 (1st Cir. 1987) (concluding there is no dilution because defendant “did not use Bean’s marks to identify or promote goods or services to consumers; it never intended to market the ‘products’ displayed in the parody”). *But see* *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 415–16 (S.D.N.Y. 2002) (noting that the parody was serving as a brand and was not entitled to First Amendment protection).

102. *See* 15 U.S.C. §§ 1125(c)(2)(B)(i)–(vi) (listing six non-exclusive factors that courts may consider in determining whether dilution by blurring is likely to occur, but not suggesting any specific factor for a court to consider when deciding whether dilution by tarnishment has occurred); *see also* *Dogan & Lemley*, *supra* note 93, at 490 (“Brand parodies, then, don’t fit well within existing trademark infringement or dilution law. Parodies generally don’t confuse consumers, and because they refer back to the plaintiff’s mark directly they will not generally blur or tarnish that mark in the way dilution law prohibits. True parodies thus cause none of the harms that trademark law seeks to avoid. But because neither law is structured with parodies in mind, rote application of infringement and dilution standards can result in a condemnation of even obvious parodies. Lacking tools specifically designed for parody, courts treat it in an ad hoc way that reflects their own subjective assessment of the value or parody and the morality of free rides.”).

103. *Lux*, *supra* note 82, at 1063 (“Courts have vacillated between the view that the slightest amount of commercial intent, content or effect should cause the entirety of the speech in question to be regarded as commercial and the notion that even the most trivial expressive content or purpose must render speech non-commercial lest freedom of expression become illusory.”); *see, e.g.,* *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 508 (2d Cir. 1996) (holding that the defendant’s use of a character named “SPA’AM” in a Muppets movie was a permissible parody of plaintiff’s “Spam” mark for potted meat. However, by focusing on finding that there was no likelihood of confusion or dilution, the court did not

In *State University of New York v. Fox*, the Supreme Court ruled that when the commercial elements of a mixed communication are not “inextricably intertwined” with its fully protected non-commercial elements, the entire communication can be regulated as commercial speech.¹⁰⁴ Curran explained that “inextricably intertwined” inquiry provides complete First Amendment protection for high-value speech, such as parody or criticism, when lower-value elements such as commercial advertising represent a fraction of the general message.¹⁰⁵ Moreover, Curran suggested using the *Fox* test to establish whether dilutive use is “inextricably intertwined” with the non-commercial elements of speech.¹⁰⁶ In this sense, if a dilutive use points to a famous mark to parody or criticize it, its high-value expressive content cannot be separated from its dilutive use of the trademark, because those uses are an essential element of parody or criticism targeting a trademark.¹⁰⁷

Courts have used similar reasoning in when deciding issues of whether commercial and non-commercial aspects of speech are intertwined.¹⁰⁸ They all indicate that commercial speech cannot, and should not, be equated with political or artistic speech and should, therefore, not receive the same degree of protection. Like in the many cases that involved “inextricably intertwined”

apply any sort of speech or some parody related test); *Black Dog Tavern Co. v. Hall*, 823 F. Supp. 48, 55 (D. Mass. 1993) (finding “Black Hog” and “Dead Dog” marks unlikely to be confused with “Black Dog” trademark); *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp.2d 1302, 1339–40 (N.D. Ga. 2008) (a critic of Wal-Mart who created “Walocaust” T-shirts was held not to have tarnished the plaintiff’s “Wal-Mart” marks because he was not engaging in commercial speech, and thus the parody was non-commercial); see also *Dogan & Lemley*, *supra* note 93, at 490 (“[B]ecause neither law is structured with parodies in mind, rote application of infringement and dilution standards can result in a condemnation of even obvious parodies. Lacking tools specifically designed for parody, courts treat it in an ad hoc way that reflects their own subjective assessment of the value or parody and the morality of free rides.”). *But see*, *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 399 (8th Cir. 1987) (holding that defendant’s antinuclear T-shirts, featuring a picture and the words “Mutant of Omaha,” were likely to confuse consumers whether the insurance company “Mutual of Omaha” was sponsoring the shirts).

104. *Bd. of Trs. v. Fox*, 492 U.S. 469, 474 (1989).

105. Patrick D. Curran, *Diluting the Commercial Speech Doctrine: Noncommercial Use and the Federal Trademark Dilution Act*, 71 U. CHI. L. REV. 1077, 1102 (2004).

106. *Id.*

107. *Id.*

108. See, e.g., *Riley v. Nat’l Fed’n of the Blind*, 487 U.S. 781, 796 (1988) (“[W]e do not believe that the speech retains its commercial character when it is inextricably intertwined with otherwise fully protected speech.”); *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 906–07 (9th Cir. 2002) (noting that the commercial purpose of using “Barbie” in a song title was “inextricably intertwined” with the “expressive elements”); *Parks v. LaFace Recs.*, 329 F.3d 437, 449 (6th Cir. 2003) (“[I]f a song is sold, and the title is protected by the First Amendment, the title naturally will be ‘inextricably intertwined’ with the song’s commercial promotion.”).

speech, it was reasonable for the Ninth Circuit to embrace this perspective in *VIP Products LLC v. Jack Daniel's Properties, Inc.* The commercial purpose of imitating Jack Daniel's in a dog toy was "inextricably intertwined" with the expressive elements. Eliminating the commercial aspects of the Bad Spaniels parody dog toy would necessarily excise non-commercial parts, as the restriction would apply to the parody itself.

From a legal perspective, it is necessary to achieve coherence to the concept of parody despite its diverse appearances. "To create a defense for brand parodies, we need either a definition of what a parody is or a general principle that encompasses brand parodies along with other forms of protected uses of a trademark."¹⁰⁹ Although there is no uniform position on whether parody deserves legal protection, jurisprudence and legal doctrine recognize that parody is a valuable form of social commentary.¹¹⁰ As such, it is recognized within the *Rogers* test, which was developed explicitly to deal with non-commercial speech. Subsequently, circuit courts have applied *Rogers* test to a wide range of non-commercial speech.¹¹¹

109. See Dogan & Lemley, *supra* note 93, at 498; see also *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429 (6th Cir. Tenn. Aug. 17, 1992) ("Unfortunately, the terminology of the fair use analysis has evolved in such a way that the popular definition of parody and the statutory definition of parody as a form of criticism have become somewhat confused.").

110. See Simon Dentith, PARODY, 159–64 (2000) (noting significant importance of parody in contemporary culture); see also Dogan & Lemley, *supra* note 93, at 486 ("Even more than non-commercial forms of parody, the subversive use of a parody as brand invites critical reflection on the role of brands in society and the extent to which we define ourselves by them. Brands that parody, in other words, offer a unique platform for expression and pose little threat to trademark law's core values."); *id.* at 494–95 ("Traditional trademarks serve as the source of goods and therefore protect the customer from fake goods. By contrast, Nike swooshes, red shoe bottoms, and Chanel purse logos are not really about ensuring purchasers make the right decision, but about allowing purchasers to tell the rest of the world about that decision. Were it otherwise, known counterfeits wouldn't be so popular. Brands, then, don't just help trademark owners speak; they help all of us speak. And that speech is so common that refusing to wear brand names is itself a recognized counter-cultural statement. Which brings us back to brand parody. As discussed above, brands that parody have a dual target: the brand itself and the phenomenon of branding. Given the prevalence of branding and its economic and social impact, commentary about both brands and branding is a matter of public concern."); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) ("Like less ostensibly humorous forms of criticism, [parody] can provide social benefit, by shedding light on an earlier work, and, in the process, creating a new one."); Hariman, Robert, *Political Parody and Public Culture*, Q.J. SPEECH 247, 260 (2008) (explaining how genres such as parody play a particularly crucial role in keeping democratic speech a multiplicity of discourses). "Other forms of speech such as formal debate will also generate awareness that public speech is both partial and disposed to exaggerate, but parody does it best." *Id.*

111. See, e.g., *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 339–40 (E.D. Pa. 1996) (applying *Rogers* test to film content); *Found., Inc. v. NAACP*, 786 F.3d 316, 329 (4th Cir. 2015) (applying *Rogers* test to social issues speech); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235,

III. ROGERS TEST

As noted above, parsing the difference between commercial and expressive trademark uses tends to be quite onerous in practice. In lacking tools designed explicitly for brand parodies contrasted with trademarks, courts decide on their subjective assessment of the value of parody and the morality of free rides.¹¹² These approaches involve ad hoc balancing, which implies that the courts recognize that the defendant uses the plaintiff's mark in a socially valuable expressive way and then apply that appreciation to the likelihood of confusion test.¹¹³ In addition to the ad hoc balancing approach, in recent years, courts have developed a specific mechanism for addressing free speech concerns in trademark law by adopting the *Rogers* test.

A. ROGERS V. GRIMALDI

In 1986, Federico Fellini, a famous Italian film director and screenwriter, made a film centered around fictional Italian cabaret singers Pippo and Amelia, who imitated Ginger Rogers and Fred Astaire, hence becoming known in Italy as “Ginger and Fred.”¹¹⁴ Following a short run in American theaters and mixed commentaries, Ginger Rogers filed suit against the producers and distributors of the film, claiming that the film gave a false impression of her endorsement, violated her right of publicity, and defamed her by depicting her in a false light.¹¹⁵ The district court granted summary judgment to the defendant, holding that the title was “exercise of artistic expression rather than commercial speech.”¹¹⁶

On appeal, the Second Circuit noted that the central question in this case was:

[A] conflict between Rogers' right to protect her celebrated name and the right of others to express themselves freely in their own artistic work. Specifically, we must decide whether Rogers can

1241–42 (9th Cir. 2013) (applying the *Rogers* test to video games); *Univ. of Ala. Bd. of Tr. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012) (applying the *Rogers* test to the content of artwork); *Parks v. LaFace Recs.*, 329 F.3d 437, 451–52 (6th Cir. 2003) (applying the *Rogers* test to song title); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65 (5th Cir. 2000) (applying the *Rogers* test to magazine title); *Gordon v. Drape Creative, Inc.*, 909 F.3d 257 (9th Cir. 2018) (applied the *Rogers* test to greeting cards).

112. *See* Dogan & Lemley, *supra* note 93, at 490.

113. *See, e.g.*, Mark Bartholomew & John Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*, 81 GEO. WASH. L. REV. 1, 43 (2013) (noting that Thomas McCarthy describes such balancing test as “putting a discrete judicial finger on the scales in favor of the defendant.”).

114. *Rogers v. Grimaldi*, 875 F.2d 994, 997 (2d Cir. 1989).

115. *Id.*

116. *Id.*

prevent the use of the title ‘Ginger and Fred’ for a fictional movie that only obliquely relates to Rogers and Astaire.¹¹⁷

In responding to whether a title of an artistic work is entitled to First Amendment protection in trademark infringement cases, the Second Circuit formulated a two-pronged test.¹¹⁸ Under this test, a defendant must show that (1) the defendant’s title is artistically relevant to the underlying work, and (2) the title is not explicitly misleading as to the source or content of the work.¹¹⁹

Although the court admitted that “Ginger and Fred” could cause consumer confusion, the court emphasized that, given the context, the irony of the ambiguous title was a central element of the film.¹²⁰ Therefore, the court held that the trademark liability should exist just if “the public interest in avoiding consumer confusion outweighs the public interest in free expression.”¹²¹

Since then, the *Rogers* test has undergone a revolution. Courts have adopted the *Rogers* test and inserted new glosses to it to “encompass all works of artistic expression,”¹²² rather than just titles of expressive works. Nevertheless, it is worth noting that the *Rogers* test is not without its critics. One critic observed that these later developments have “muddled the *Rogers* test.”¹²³ Another criticism of the *Rogers* test is that it is easily applied to trademarks and affects an equitable balance between free expression and trademark holder’s rights. As a result, some authors argue, “the *Rogers* test was intentionally designed as a low bar for those invoking the protection of the First Amendment.”¹²⁴ They contend that the *Rogers* test provides minimal protection for trademark owners while immunizing the work of content producers.

117. *Id.* at 996.

118. *Id.* at 999.

119. *Id.*

120. *See id.* at 998–99.

121. *Id.* at 996.

122. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 10:22 (4th ed. 2006) (cited in *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1038 (9th Cir. 2008)).

123. William McGeeveran, *The Trademark Fair Use Reform Act*, 90 B.U. L. REV. 2267, 2313 (2010); *see also* David Jacob Wright, *Explicitly Explicit: The Rogers Test and the Ninth Circuit*, 21 J. INTEL. PROP. L. 193, 203–06 (2013) (stating that the circuits have applied the *Rogers* test in different and perhaps contradictory ways, and that its application within the Ninth Circuit has proven particularly confusing).

124. Wesley W. Wintermeyer, *Who Framed Rogers v. Grimaldi? What Protects Trademark Holders Against First Amendment Immunity for Video Games?*, 64 ALA. L. REV. 1243, 1252 (2013). *But see* Matthew D. Bunker, *Mired in Confusion: Nominative Fair Use in Trademark Law and Freedom of Expression*, 20 COMM. L. & POL’Y 191, 209–212 (2015) (suggesting a more expansive application of the *Rogers* test to include other uses beyond simply titles and artistic works).

Despite these criticisms, the *Rogers* test remains the most commonly applied framework in which to analyze cases involving the Lanham Act's application to expressive works.

B. ROGERS TEST APPLIED IN THE NINTH CIRCUIT

The Ninth Circuit adopted the *Rogers* test in *Mattel, Inc. v. MCA Records, Inc.*,¹²⁵ thirteen years after the Second Circuit decided *Rogers v. Grimaldi*. In this case, the manufacturer of a famous Barbie doll sued a music band that parodied the doll and its associated trademark within its song “Barbie girl.”¹²⁶ Noting that some “trademarks transcend their identifying purpose . . . enter our public discourse and become an integral part of our vocabulary,”¹²⁷ the Ninth Circuit applied the *Rogers* test to decide the case.¹²⁸

Applying the test's first prong, the Ninth Circuit determined that the use of the mark was artistically relevant because it was an obvious parody, making fun of Barbie.¹²⁹ Additionally, the Ninth Circuit held that the use of the term “Barbie” in the song's title did not explicitly mislead as to Mattel's association with the song.¹³⁰ As a result, no likelihood of confusion was provided.¹³¹

Subsequently, the Ninth Circuit readdressed the *Rogers* test in *Mattel, Inc. v. Walking Mountain Productions*.¹³² In this case, the Barbie manufacturer brought a trademark infringement claim against a photographer specializing in pictures of nude Barbie dolls portrayed “in danger of being attacked by vintage household appliances.”¹³³ The defendant claimed that his photographs were “an attempt to “critique [] the objectification of women associated with [Barbie], and [] [to] lambast [] the conventional beauty myth and the societal acceptance of women as objects because this is what Barbie embodies.”¹³⁴ In applying the *Rogers* test, the court's analysis followed the perspective outlined in *Mattel, Inc. v. MCA Records*, concluding that the mark's use was artistically

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

126. *Id.* at 899.

127. *Id.* at 900.

128. *Id.* at 901–02.

129. *Id.* at 902. (“Under the first prong of *Rogers*, the use of Barbie in the song title clearly is relevant to the underlying work, namely, the song itself. As noted, the song is about Barbie and the values [Defendant] claims she represents.”).

130. *Id.* (“The song title does not explicitly mislead as to the source of the work; it does not, explicitly or otherwise, suggest that it was produced by Mattel. 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.”).

131. *Id.* at 900.

132. *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

133. *Id.* at 796.

134. *Id.* at 796–97.

relevant to the underlying work and did not mislead consumers as to Mattel's association with the work.¹³⁵ However, while the *MCA Records* court mentioned the cultural significance of the Barbie doll in its earlier ruling, the court did not explicitly envision that creator receives First Amendment protections for works that only utilize trademarks that have entered the public discourse.¹³⁶ This decision is significant because many of our cultural discussions revolve around the various products we consume. Sometimes those conversations involve destroying or reusing a trademarked asset to comment on the brand itself, even when such reuse does not please the trademark owner, as when an artist puts a Barbie doll in a blender, an oven, or an enchilada.

In *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*,¹³⁷ the operator of a strip club in Los Angeles called Play Pen Gentleman's Club, filed suit against the developers of the "Grand Theft Auto" video games for portraying the plaintiff's strip club in the game "Grand Theft Auto: San Andreas" and calling it "Pig Pen." E.S.S. argued that the similarities between the Pig Pen logo and the design of the building would cause consumer confusion as to whether the strip club in the video game was associated with E.S.S. or whether E.S.S. endorsed it.¹³⁸ The Ninth Circuit permitted a First Amendment defense, observing that it is "true that Play Pen has little cultural significance, but the same could be said about most of the individual establishments in East Los Angeles."¹³⁹

Adjusting the cultural significance requirement, the court held that "the level of relevance merely must be above zero."¹⁴⁰ Because "[a] reasonable consumer would not think a company that owns one strip club in East Los Angeles, which is not well known to the public at large, also produces a technologically sophisticated video game,"¹⁴¹ the court held that Rockstar's work was not explicitly misleading. Similarly, the court observed that the location was "incidental to the overall story of the Game" and "the chance to attend a virtual strip club is unambiguously not the main selling point of the Game."¹⁴²

135. *Id.* at 806–07.

136. *Id.*

137. *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1096–97 (9th Cir. 2008).

138. *Id.* at 1097.

139. *Id.* at 1100.

140. *Id.* at 1100.

141. *Id.* at 1100–01.

142. *Id.*

The Ninth Circuit held that even though the game principally was not about the Play Pen, the video game's use was artistically relevant to its purpose of creating the fictional city.¹⁴³ What counts is that the expressive work represents creative expression and involves substantially more artistic elements than the simple use of a third party's trademark.

More recently, in *Twentieth Century Fox Film Corp. v. Empire Distribution, Inc.*, the Ninth Circuit employed the *Rogers* test to determine whether the title of the television show "Empire" infringed on the name of the record label "Empire Distribution."¹⁴⁴ In this case, "Empire Distribution," a record label that records and releases music albums, including compilations featuring "EMPIRE Presents" in their titles, sued Twentieth Century Fox after the television company began to sell music bearing the show's "Empire" brand. Following the District Court's grant of summary judgment for Fox, the Ninth Circuit reviewed the case *de novo*.¹⁴⁵ The Ninth Circuit held that Fox's show title did not infringe under the *Rogers* test.¹⁴⁶ First, the court found that Fox's purpose in using the word "Empire" for the show was artistically relevant because "the show's setting is New York, the Empire State, and its subject matter is a music and entertainment conglomerate, "Empire Enterprises," which is itself a figurative empire."¹⁴⁷ Regarding the second prong of the *Rogers* test, the court emphasized that the Empire Distribution did not provide sufficient evidence demonstrating that Fox's use was explicitly misleading, nor did the show contain any "overt claims or explicit references to the record label."¹⁴⁸

The hermeneutical relevance of this decision is evident when one comprehends its repercussions. First, the Fox uses of the "Empire" term have acted "as an umbrella brand to promote and sell music and other commercial products," including "appearances by cast members in other media, radio play, online advertising, live events, and the sale or licensing of consumer goods."¹⁴⁹ Concerning this issue, the Ninth Circuit has characterized Fox's uses primarily

143. Other video game cases have reached similar conclusions. *See, e.g.*, *MilSpec Monkey Inc v. Activision Blizzard*, 74 F. Supp. 3d 1134, 1142 (N.D. Cal. 2014) (the court found that trademark-protected "angry monkey" patches used in a video game were relevant because they represent "part of an authentic universe of morale patches" used by military staff).

144. *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1196 (9th Cir. 2017); *see also* *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1244–45 (9th Cir. 2013) (holding that the use of former player Jim Brown was relevant for creating realistic representations in the virtual world).

145. *Twentieth Century Fox Television*, 875 F.3d at 1196 (9th Cir. 2017).

146. *Id.* at 1196.

147. *Id.* at 1198.

148. *Id.* at 1199.

149. *Id.* at 1196.

as an expressive work, requiring “only a minor logical extension of the reasoning of Rogers” to shield that use behind the First Amendment.¹⁵⁰

This last case indicates that the *Rogers* test applies not only to the expressive work itself but also to promotional attributes of that expressive work. Where the use of a third party’s trademark has artistic relevance to the underlying work and it is not explicitly misleading, the *Rogers* defense can extend to the promotional activities of that artistic work. These promotional activities include appearances by cast members in other media, radio play, online advertising, live events, and the sale or licensing of consumer goods.¹⁵¹ For parodists, this development in the law raises new benefits and considerations.

Most recently, in *Gordon v. Drape Creative, Inc.*, the Ninth Circuit analyzed the “outer limits” of the *Rogers* test.¹⁵² In this case, the plaintiff, Christopher Gordon, created the popular YouTube video “The Crazy Nastyass Honey Badger.”¹⁵³ This video became known for its catchphrases, including “Honey Badger Don’t Give a S---” and “Honey Badger Don’t Care.”¹⁵⁴ Gordon trademarked the latter catchphrase for various classes of products, including greeting cards, mugs, clothing, but he never registered the phrase “Honey Badger Don’t Give a S---.”¹⁵⁵ Gordon brought trademark infringement claims against Drape Creative, Inc., a greeting-card design studio, and Papyrus-Recycled Greetings Inc., a greeting card manufacturer and distributor, for designing and producing a variety of greeting cards using variations of both catchphrases mentioned above without Gordon’s permission.¹⁵⁶ The district court granted summary judgment for defendants, holding that the greeting cards were expressive works, and that the *Rogers* test holds impassable plaintiff’s claims.¹⁵⁷

In applying the *Rogers* test, the Ninth Circuit noted that “Gordon’s mark is certainly relevant to defendants’ greeting cards; the phrase is the punchline on which the cards’ humor turns.”¹⁵⁸ Holding that the defendant’s work was expressive and hence justified applying the *Rogers* test, the court focused on whether the defendant’s use of the mark was explicitly misleading.¹⁵⁹ The Ninth Circuit rejected the district court’s requisite the defendant must make

150. *Id.*

151. *Id.*

152. *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 268 (9th Cir. 2018).

153. *Id.* at 260.

154. *Id.*

155. *Id.*

156. *Id.*

157. *Id.*

158. *Id.* at 269.

159. *Id.* at 268.

an “affirmative statement of the plaintiff’s sponsorship or endorsement.”¹⁶⁰ Equally interestingly, the Ninth Circuit came to theorize about the instances in which the use of the mark, while relevant to expressive content, would establish misleading use.¹⁶¹

Regarding the second prong of the *Rogers* test, the Ninth Circuit reasoned that a more relevant deliberation would be the point to which the defendants use the trademark in the same manner as the plaintiff. “Indeed, the potential for explicitly misleading usage is especially strong when the senior user and the junior user both use the mark in similar artistic expressions.”¹⁶² The court decided in favor of the plaintiff, stating that the “[d]efendants have not used Gordon’s mark in the creation of a song, photograph, video game, or television show, but have largely just pasted Gordon’s mark into their greeting cards.”¹⁶³

In sum, this Note has explained how the Second Circuit developed the *Rogers* framework, which precludes trademark liability for non-commercial speech unless the implicated speech is not artistically relevant or is explicitly misleading. As it has been explained, the *Rogers* test has served the role of preventing trademark law, which developed as a concept of information efficiency in a market, from improperly invading the freedom to engage in non-commercial speech, including non-commercial speech sold for profit.

Regarding the *Rogers* test, the Ninth Circuit has crafted a simple and consistent application to a wide range of references to trademarks within a very liberal defense of parody speech. All these cases from the Ninth Circuit have in common that they protect expressive works, meaning creative expressions that involve more artistic elements than the mere use of a third party’s trademark.

Likewise, the Ninth Circuit has explained how the test requires the defendant to show, as a threshold matter, that the work in question is expressive. Then, the burden passes to the plaintiff to prove one of the two elements of the *Rogers* test, that either the plaintiff’s mark “has no artistic relevance to the underlying work whatsoever” or the defendant “explicitly

160. *Id.* at 269.

161. *See id.* at 270 (“If an artist pastes Disney’s trademark at the bottom corner of a painting that depicts Mickey Mouse, the use of Disney’s mark, while arguably relevant to the subject of the painting, could explicitly mislead consumers that Disney created or authorized the painting, even if those words do not appear alongside the mark itself.”); *see also id.* at 271 (“In the cases extending *Rogers* to instances in which a mark was incorporated into the body of an expressive work, we made clear that the mark served as only one component of the larger expressive work.”).

162. *Id.* at 270.

163. *Id.* at 261; *see also id.* at 270 (“The court making determinations whether the defendants added their “own expressive content to the work beyond the mark itself.”).

misleads as to the source or the content of the work.”¹⁶⁴ Such an approach balances the First Amendment and trademark rights with a judicial evaluation tilted in favor of the parodist.

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

The Ninth Circuit *Rogers* policy balance favoring First Amendment concerns reached its zenith in a decision involving a product arguably different than the songs,¹⁶⁵ photographs,¹⁶⁶ video games,¹⁶⁷ television programs,¹⁶⁸ or greeting cards.¹⁶⁹ Indeed, this case is about a dog chew toy.¹⁷⁰

Figure 1: The Jack Daniel's bottle next to the VIP Products “Bad Spaniels” dog toy



164. *Id.* at 264.

165. *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 899 (9th Cir. 2002).

166. *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

167. *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1096 (9th Cir. 2008).

168. *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192 (9th Cir. 2017); *see also Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013).

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

170. *VIP Prods. LLC v. Jack Daniel's Properties, Inc.*, 953 F.3d 1170, 1172 (9th Cir. 2020).

VIP Products, an Arizona-based company, sells “Silly Squeaker” dog toys.¹⁷¹ In July of 2013, VIP Products released a toy in the shape of a Jack Daniel’s whiskey bottle, containing an image of a spaniel over the words “Bad Spaniels.”¹⁷² Jack Daniel’s label says, “Old No. 7 Brand Tennessee Sour Mash Whiskey,” while the label on the Bad Spaniels toy instead has the phrase “the Old No. 2, on your Tennessee Carpet.”¹⁷³ Additionally, the name “Jack Daniel’s” is replaced with “Bad Spaniels,” “Old No. 7” with “Old No. 2,” and alcohol content descriptions with “43% POO BY VOL.” and “100% SMELLY.”¹⁷⁴ In addition to these similarities between the “Bad Spaniels” and the bottle of Jack Daniel’s whiskey, the products share various visual features, such as the product’s shape, the use of white lettering over a black background, and font style.¹⁷⁵ However, a disclaimer on its packaging states that the Bad Spaniels “product is not affiliated with Jack Daniel Distillery.”¹⁷⁶

A. DISTRICT COURT DECISION

Unsurprisingly, Jack Daniel’s Properties was not amused and sent the parodist a demand letter asking him to cease and refrain from selling the chewy dog toy parodying its whiskey. VIP Products filed suit seeking a declaratory judgment of non-infringement.¹⁷⁷ Jack Daniel’s Properties counterclaimed for trademark infringement and dilution.¹⁷⁸

In its holding, the district court noted that VIP was not entitled to the nominative fair use defense because the dog toy is not an expressive work.¹⁷⁹ Moreover, by distinguishing between “the standard trademark likelihood of confusion analysis,” within which a parody defense potentially applies to VIP Products, and the notion of the “artistic expression” from the *Rogers* test, the district court held that the *Rogers* test was inapplicable.¹⁸⁰ The court pointed out that this test applies to artistic expressions such as songs, movies, and books and “requires courts to construe trademark law only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”¹⁸¹

171. *Id.*

172. *Id.*

173. *Id.* at 1172.

174. *Id.*

175. *Id.*

176. *Id.*

177. *See* VIP Prods. LLC v. Jack Daniel’s Props., Inc., 2016 WL 5408313, at *1 (D. Ariz. Sept. 27, 2016).

178. *Id.* at *2.

179. *Id.* at *5.

180. *Id.* at *6.

181. *Id.*

Regarding Jack Daniel's trademark dilution counterclaim, the court first held that "it is undisputed that the sales, advertising, and public exposure of Jack Daniel's whiskey packaged in the Jack Daniel's trade dress provide substantial indirect evidence of fame."¹⁸² Second, the court held that "a reasonable trier of fact could find that the VIP product and Jack Daniel's trade dress meet the requisite similarity standard for dilution, an "association arising from the similarity between a mark or trade name and a famous mark."¹⁸³

After a four-day bench trial, the district court decided in favor of Jack Daniel's, finding that it was clear that VIP's intent "sought to capitalize on Jack Daniel's popularity and good will for its own gain."¹⁸⁴ The court issued a permanent injunction prohibiting VIP from manufacturing and selling the "Bad Spaniels Silly Squeaker" dog toy.¹⁸⁵

B. NINTH CIRCUIT DECISION

VIP Products appealed to the Ninth Circuit, which found that the dog toy is an expressive work entitled to First Amendment protection.¹⁸⁶ In deciding so, the Ninth Circuit reversed and vacated the lower court's permanent injunction and held that the "Bad Spaniels" constituted a non-commercial use.¹⁸⁷ Hence, it did not dilute Jack Daniel's mark by tarnishment as a matter of law.¹⁸⁸

182. *Id.* at *13.

183. *See id.* at *1.

184. *VIP Prods., LLC v. Jack Daniel's Prods., Inc.*, 291 F.Supp.3d 891, 908 (D. Ariz. 2018). The court relied upon the testimony from an expert in consumer behavior, based on conventional consumer psychology research to observe that "when you associate any food or beverage with defecation, you are creating disgust in the mind of the consumer with respect to that food or beverage." *Id.* at 903. Based on this testimony, the court support a finding of dilution by tarnishment because the parody product's references to defecation would result in "creating negative associations, either consciously or unconsciously, and undermining the pre-existing positive associations with its whiskey" that would be "particularly harmful for a company such as Jack Daniel's because the goods it offers for sale involves human consumption and human consumption and canine excrement do not mix." *Id.* Moreover, the court also found tarnishment of Jack Daniel's trademarks by associating the whiskey with toys that might appeal to children. "[W]hile an association with toys may not ordinarily cause reputational harm, Jack Daniel's is in the whiskey business, and does not market to children, does not license goods for children, and does not license goods that might appeal to children. *Id.* at 904. Lastly, the district court relied upon the trademark owner's internet survey showing that over 29% of potential consumers likely experienced confusion as to the connection between the Bad Spaniels dog toy and Jack Daniel's. *See id.* at 907.

185. *Id.* at 911.

186. *See VIP Prods. LLC v. Jack Daniel's Prods., Inc.* 953 F.3d 1170, 1172 (9th Cir. 2020).

187. *Id.* at 1176.

188. *Id.*

Although the “Bad Spaniels Silly Squeaker” dog toy resembles a bottle of Jack Daniel’s Old No. 7 Black Label Tennessee Whiskey, it has “light-hearted, dog-related alterations.”¹⁸⁹ As this Note will analyze, the court found that those alterations were protectable under the *Rogers* test. In determining whether the “Bad Spaniels” was expressive, the Ninth Circuit analyzed “whether the work [wa]s ‘communicating ideas or expressing points of view.’”¹⁹⁰ The court noted that “VIP’s purported goal in creating Silly Squeakers was to ‘reflect’ ‘on the humanization of the dog in our lives,’ and to comment on ‘corporations [that] take themselves very seriously.’”¹⁹¹

In granting a dog toy expressive work status, the Ninth Circuit explained that “although surely not the equivalent of the *Mona Lisa*,” “Bad Spaniels” is “an expressive work.”¹⁹² It “communicates a humorous message using wordplay to alter the serious phrase that appears on a Jack Daniel’s bottle” and “is not rendered non-expressive simply because it is sold commercially.”¹⁹³ The result is “‘a simple’ message conveyed by ‘juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.’”¹⁹⁴ The court noted that the fact that VIP chose to convey this humorous message through a new artistic medium is irrelevant message because “the Constitution looks beyond written or spoken words as mediums of expression.”¹⁹⁵ Likewise, the Ninth Circuit paid attention to the fact that it was not the first time the court found that dog toys can be successful parodies of the well-known trademark.¹⁹⁶

Citing *Twentieth Century Fox Television v. Empire Distribution, Inc.*,¹⁹⁷ the Ninth Circuit stated that trademark infringement claims are generally governed by a likelihood-of-confusion test to “strike the appropriate balance between the

189. *Id.* at 1172.

190. *Id.* at 1174 (citing *Mattel, Inc. v. MCA Recs.*, 296 F.3d 894, 900 (9th Cir. 2002) (quoting *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987))).

191. *Id.* at 1172.

192. *Id.* at 1175 (analogizing to the greeting cards in *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018) (finding that although the cards did not show a great level of creativity, they were protected under the First Amendment because they “convey[ed] a humorous message through the juxtaposition of an event of some significance”); *see also id.* (quoting *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241) (“A work need not be the ‘expressive equal of *Anna Karenina* or *Citizen Kane*’ to satisfy this requirement.”).

193. *Id.*

194. *Id.* (quoting *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir. 1987)).

195. *Id.* (quoting *Hurley v. Irish-Am. Gay, Lesbian & Bisexual Grp.*, 515 U.S. 557, 569 (1995)).

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

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

First Amendment and trademark rights.”¹⁹⁸ However, the court noted that “when artistic expression is at issue, however, the general likelihood-of-confusion test fails to account for the total weight of the public’s interest in free expression.”¹⁹⁹ According to the Ninth Circuit, the district court mistakenly found that VIP’s product was not a creative and expressive good and thus not eligible for the protection under the *Rogers* test.²⁰⁰

As a threshold matter, the Ninth Circuit concluded that it was necessary to apply the *Rogers* test.²⁰¹ Because the district court concluded the possible confusion under the multifactor test without first deciding whether the plaintiff could meet either prong of *Rogers* test, the Ninth Circuit remanded the matter for a finding of that issue.²⁰²

Moreover, the Ninth Circuit instructed the district court judges to tilt their interpretation to a critical perspective “if the plaintiff satisfies one of the *Rogers* elements, ‘it still must prove that its trademark has been infringed by showing that the defendant’s use of the mark is likely to cause confusion.’”²⁰³

C. AFTEREFFECTS

Fourteen days after the court made its decision, Jack Daniel’s filed a petition for rehearing or rehearing *en banc*,²⁰⁴ after which the International Trademark Association (INTA) filed an *amicus* brief because the “panel’s expansive application of *Rogers* threaten[ed] to make this new iteration of the *Rogers* test the exception that swallows the likelihood of confusion standard that has been applied in trademark infringement cases for nearly a century.”²⁰⁵ Stating that the Ninth Circuit panel’s application of the law contradicts the law in other circuits, Jack Daniel’s argued that the “unnecessary

198. *VIP Prods.*, 953 F.3d at 1174.

199. *Id.* (internal citations omitted) (quoting *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018)); see *Arnold v. Treadwell*, 642 F.Supp.2d 723, 729 (E.D. Mich. 2009); *Rebellion Devs. Ltd v. Stardock Ent. Inc.*, No. 12-12805, 2013 WL 1944888, at *4 (E.D. Mich. May 9, 2013) (both showing that if the *Rogers* test is met, confusion is irrelevant); see also *Mikhaila Duvall, A Good Day to Be a Bad Spaniel: Broadening the Application of the Rogers Test*, 21 UIC REV. INTELL. PROP. L. 193, 208–210 (2022) (explaining that even though the Ninth Circuit declined to directly apply the likelihood of confusion test, the result would have been the same had the test been applied).

200. *VIP Prods.*, 953 F.3d at 1176.

201. *Id.*

202. *Id.*

203. *Id.* at 1176 n. 2 (quoting *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 265 (9th Cir. 2018)).

204. Appellee’s Petition for Rehearing and Petition for Rehearing En Banc, *VIP Prods.*, 953 F.3d 1170 (No. 18-16012), ECF No. 63 [hereinafter Appellee’s Petition].

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

constitutionalization of routine trademark disputes” via the *Rogers* test “restricts trademark owners’ ability to protect consumers against the likely confusion.”²⁰⁶

On the other hand, a group of prominent law professors filed an amicus curiae brief in opposition to Jack Daniel’s petition for rehearing advancing one important argument.²⁰⁷ They argued that the Ninth Circuit correctly applied the *Rogers* test and that the “Bad Spaniels” dog toy was correctly considered non-commercial, and thus exempt from trademark infringement liability. However, the petition for panel rehearing and rehearing en banc was denied.²⁰⁸

In consequence, Jack Daniel’s filed a petition for certiorari at the United States Supreme Court on September 15, 2020,²⁰⁹ and was supported by several amici, including INTA, the Intellectual Property Law Association of Chicago, various alcohol beverage industry associations Campari America LLC, Constellation Brands Inc., and Campbell Soup Company.²¹⁰ Again, trademark law professors filed an amicus brief in opposition to the petition for certiorari.²¹¹ In January 2021, the Supreme Court denied certiorari.²¹²

Reactions to this decision immediately followed. Some authors argued that the Ninth Circuit decision is distinguished by its “potential to render any commercial product that contains humorous elements a ‘work of artistic expression.’”²¹³ Moreover, the Ninth Circuit has been said to have improperly extended First Amendment protection “for allegedly infringing uses of

206. Appellee’s Petition, *supra* note 204, at 3–4.

207. Brief of Amici Curiae Trademark Law Professors in Opposition to Motion for Rehearing En Banc, VIP Prods., 953 F.3d 1170 (No. 18-16012) (filed by Rebecca Tushnet, Mark A. Lemley, Mark P. McKenna, Lisa P. Ramsey, Jennifer Rothman, Pamela Samuelson & Eugene Volokh).

208. *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*).

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

210. *See* Brief for International Trademark Association as Amicus Curiae 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 Constellation Brands, Inc. 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).

211. *See* Brief of Amici Curiae Trademark Law Professors in Opposition to Petition for Certiorari, VIP Prods., 141 S. Ct. 1054 (No. 20-365) (filed by Rebecca Tushnet, Mark P. McKenna & Jessica Silbey).

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

213. Jared I. Kagan & Emily R. Hush, *Parody Chew Toys and the First Amendment*, 13 LANDSLIDE 22, 24 (2021).

protected trademarks and unsettling the balance between trademark protection and freedom of expression.”²¹⁴ Other authors argue that this decision “is distinguished by its overly expansive view of the *Rogers* test and its misunderstanding of the fragile balance between First Amendment and trademark dilution laws.”²¹⁵

Arguably, these criticisms represent no more than a analytical extension of the existing conceptual differences in approach that still exist between supporters and critics of trademark dilution. There are two irreconcilable poles in the debates on the convenience of protecting trademarks against dilution. At one extreme are those whose notion is that a dilution is a necessary form of trademark protection. At another extreme are those who hold that anti-dilution statutes are the too broad mechanism for protecting trademark rights. In their opinion, this form of protection has the possibility of granting an almost exclusive property right over a trademark to its owner, something that traditional trademark law has avoided. While it is true that the *Rogers* test has been extended beyond the titles of an expressive work, which at first sight could be approximated as a stretching of its purpose, this decision also reflects trademark acromegaly. Never before, and on so many occasions, could one imagine that consumers could be confused about sponsorship or permission when viewing a product in a video game, music video, or movie or hearing it as part of a podcast or a rap song. What is true is that these both types of concerns will become increasingly important as our consumer culture continues to bloom.

D. SUPREME COURT DECISION

After the Supreme Court, without comment or reasoning, denied Jack Daniel’s petition for certiorari in January 2021,²¹⁶ the famous whisky manufacturer took a second shot when it filed a second petition for certiorari, which has proven to be worthwhile.²¹⁷ In the latest petition, Jack Daniel’s asked the Court to consider “[w]hether humorous use of another’s trademark as one’s own on a commercial product is subject to the Lanham Act’s traditional

214. *Id.*

215. Zachary Shufro, *Based on a True Story: The Ever-Expanding Progeny of Rogers v. Grimaldi*, 32 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 391, 424 (2022). *See generally* Hannah Knab, *Jack Daniel’s Highlights the Second and Ninth Circuit’s Divide on the Application of the Rogers Test*, 10 AM. U. BUS. L. REV. 517 (2022) (claiming that the Ninth Circuit has adopted the *Rogers* test in a way that expands the plain language of the Lanham Act and, therefore, has broadened the test beyond its original purpose).

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

217. *See* VIP Prods. LLC v. Jack Daniel’s Prods., Inc., 953 F.3d 1170 (9th Cir. 2020), *cert. granted*, 143 S. Ct. 476 (2022).

likelihood-of-confusion analysis, or instead receives heightened First Amendment protection from trademark-infringement claims,”²¹⁸ and “[w]hether humorous use of another’s mark as one’s own on a commercial product is ‘noncommercial’ under 15 U.S.C. § 1125(c)(3)(C), thus barring as a matter of law a claim of dilution by tarnishment under the Trademark Dilution Revision Act.”²¹⁹ On the Supreme Court, disagreement about how to answer the threshold question of when a particular use of another’s mark qualifies to apply the standard for infringement outlined in *Rogers* continued. Jack Daniel’s and some of its supporters argued that the higher standard for infringement in the Ninth Circuit’s version of the *Rogers* test is a *via* to infringe trademarks and does not prevent misleading uses of trademarks.²²⁰ In other words, Jack Daniel’s and its supporters argued that the *Rogers* test has a narrower threshold requirement. They insisted that the *Rogers* test should not apply in Jack Daniel’s trademark dispute because dog toys are more like “cans of peas” and not like traditional artistic and literary creations.²²¹ Under this view, *Rogers*’ standard for infringement would apply only when the infringer’s products are movies, books, songs, and similar expressive works with titles and not ordinary commercial products.²²² Thus, Jack Daniel’s argued that the dilution statute should apply because VIP’s dog toy is not a non-commercial use of the trademark.²²³

On the other hand, VIP Products and its supporters argued that the *Rogers* test should apply to the humorous message of Bad Spaniels because the fact that the expression appears in connection with a dog toy rather than in a painting is irrelevant.²²⁴ When the expression combines artistic and commercial speech, and these message components are inextricably intertwined, the

218. See Petition for a Writ of Certiorari in *I, Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 2022 WL 3561781 (S. Ct. Aug. 5, 2022) (No. 22-148).

219. *Id.*

220. See Brief for Petitioner at 2–5, 19–39, *Jack Daniel’s*, 143 S. Ct. 476 (No. 22-148); see also Brief of Amici Curiae American Apparel & Footwear Association, Footwear Distributors & Retailers of America, Council of Fashion Designers of America, Inc., and the Accessories Council in Support of Petitioner at 3, *Jack Daniel’s*, 143 S. Ct. 476 (No. 22-148) (arguing that the Ninth Circuit’s version of the *Rogers* test will increase counterfeits); Brief of Amici Curiae of Levi Strauss & Co. and Patagonia, Inc. in Support of Petitioner at 11, *Jack Daniel’s*, 143 S. Ct. 476 (No. 22-148) (arguing that the Ninth Circuit’s application of the *Rogers* test doesn’t include discovery about defendant’s intent or actual confusion).

221. See Brief for Petitioner at 4, 19–39, *Jack Daniel’s*, 143 S. Ct. 476 (No. 22-148) (citing *Rogers*, 875 F.2d at 997).

222. *Id.*

223. *Id.* at 5, 39–52.

224. See Brief of Respondent at 13, 24–27, *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 143 S. Ct. 476 (2022) (No. 22-148); see also Brief of Amici Curiae First Amendment Professors in Support of Respondent, *Jack Daniel’s*, 143 S. Ct. 476 (No. 22-148).

Rogers test and the First Amendment limit the scope of trademark protection if the artistically relevant use of another's mark is not explicitly misleading.²²⁵

In a unanimous opinion with two concurrences delivered by Justice Kagan, the Supreme Court held that the Rogers test for trademark infringement claims challenging expressive works does not apply “when the alleged infringer uses the trademark as a designation of source for the infringer’s own goods.”²²⁶ Moreover, non-commercial exclusion from dilution liability under Lanham Act “does not shield parody or other commentaries when their use of a mark is source-identifying.”²²⁷ The Court distinguished the case at bar from cases employing a First Amendment defense “in which a trademark is used not to designate a work’s source, but solely to perform some other expressive function.”²²⁸ According to the Court, for example, when the manufacturer of a famous Barbie doll sued a music band over the song “Barbie Girl,” the Ninth Circuit applied the Rogers test because the band’s use of the Barbie name was not performing a source identifier task.²²⁹ In other words, the Court held that the First Amendment filter only applies where a trademark is not used to designate the source of the goods. However, the Court explained that lower courts can consider the core of VIP’s argument because “[an] expressive message of the trademark—particularly a parodic one, as VIP asserts—may properly figure in assessing the likelihood of confusion.”²³⁰ Thus, the most important takeaway from the decision is that trademark use does not necessarily result in non-commercial use when it parodies, criticizes, or comments on someone else’s product. Consequently, the traditional likelihood of confusion analysis applies to those marks, and they are not exempt from dilution claims when used to designate the source of goods or services. Therefore, the Supreme Court remanded the judgment for further proceedings consistent with their opinion.²³¹

Although the Supreme Court decision represents a victory for Jack Daniel’s, which argued that the Ninth Circuit erred when it said the dog toy was non-commercial and therefore enjoyed constitutional protection, the Justices did not decide the fate of the Rogers test. Interestingly, despite an extensive briefing on the topic, the Supreme Court made clear it “choose[d] a

225. *Id.*

226. Jack Daniel’s Properties, Inc. v. VIP Prod. LLC, No. 22-148, 2023 WL 3872519, at *2 (U.S. June 8, 2023).

227. *Id.*

228. *Id.* at *7.

229. *Id.*

230. *Id.* at *10.

231. *Id.* at *11.

narrower path”²³² without deciding “whether Rogers has merit in other contexts”²³³ or “how far the “noncommercial use” exclusion goes.”²³⁴

The question arises of which cases would be considered to have met the standards of not confusing under a First Amendment filter. If the books, movies, songs, and T-shirts fit the bill, but dog toys are a bridge too far, we need the principles to let us know which objects will enter the protection category and which will not. Unfortunately, the Supreme Court does not provide a guide in this regard.²³⁵ Jack Daniel’s strategy of going after Rogers test in its entirety and convincing the Court to compromise turns into a win at Jack Daniels’ corner. However, by saying the test has its place but is inappropriate for a dog’s toy, the Supreme Court necessarily leaves much about Rogers test unaddressed. In addition, the decision makes it harder for everyone to determine what happens next. For example, Justice Gorsuch’s concurrence, joined by Justices Thomas and Barrett, expressed general uncertainty about “where Rogers’ evidence comes from.”²³⁶ Moreover, the concurrence opinion stated that “it’s not obvious that Rogers is right on all of his details” and cautioned lower courts that they “must be attuned to that fact.”²³⁷ While the Supreme Court decision leaves unsolved questions of free speech concerns in the context of parodies in trademark disputes, it appears to be a victory for trademark owners seeking to assert their rights against those who sell uncompetitive goods intended to mock those marks.

V. CONCLUSION

Traditional trademark law restricts only commercial speech when it is false or misleading. On the other hand, dilution laws enable the owner of a famous trademark to prevent the use of its mark, even if the user is neither misleading nor confusing. Moreover, relying on commerciality as a responsibility requirement supposes difficulties when creating a defense for brand parodies.

Following the *Rogers v. Grimaldi* decision, the *Rogers* test provided a safe harbor for junior users to escape liability if their use had an underlying artistic relevance. In the Ninth Circuit, the *Rogers* test has generally served to prevent

232. *Id.* at *6.

233. *Id.* (noting that Rogers test has merit when an alleged infringer uses a trademark as a designation of source for the infringer’s own goods).

234. *Id.* at *11.

235. *Id.* at *8 (“The point is that whatever you make of Rogers—and again, we take no position on that issue—it has always been a cabined doctrine.”).

236. *Id.* at *12 (Gorsuch, J., concurring).

237. *Id.*

trademark law from intruding on the freedom to participate in non-commercial speech, including non-commercial speech sold for profit.

In recognizing the unmistakable parodic message of the dog toy, the Ninth Circuit applied the *Rogers* test, finding VIP's "Bad Spaniels" to be an expressive work. While a dog toy may not be the most typical form of artistic expression, as detailed in Part IV, courts have applied the *Rogers* test in cases involving a wide range of expressive works. Moreover, what is considered artistically relevant evolves through time.²³⁸ The same is true for our cultural habits and values. For instance, the pet industry has tripled in the past 15 years, reaching \$123.6 billion in sales in 2021, the highest level in history.²³⁹ According to the American Pet Products Association (APPA), 69% of U.S. households own a dog.²⁴⁰

This decision is one more in line to reflect the current Ninth Circuit *Rogers* policy balance favoring First Amendment concerns. Nonetheless, if the Ninth Circuit issued a more clarifying decision, it could help instruct future courts in their struggle to balance free speech with trademark protection. The *Rogers* test tries to establish the balance between the public interest in free speech and the interests of trademark owners. However, despite several decades of use, more clarity is needed about the exact contours of the test. The unknowns of how exactly such a test should work rest on the changing nature of trademarks in contemporary society, which have developed beyond their role as source indicators to acquire significant cultural value. However, the Ninth Circuit failed to provide such clarity in this case.

238. David M. Kelly & Lynn M. Jordan, *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 99 TRADEMARK REP. 1360, 1365 (2009).

239. See *Total U.S. Pet Industry Expenditures, 2012–2021*, INS. INFO. INST., <https://www.iii.org/table-archive/22253> (last visited Sept. 22, 2022).

240. See *2021–2022 APPA National Pet Owners Survey Statistics*, AM. PET PRODS. INST., https://www.americanpetproducts.org/press_industrytrends.asp (last visited Sept. 22, 2022).