

**THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE  
FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION**

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# THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

## I. INTRODUCTION

Jack Daniel’s is one of the most well-known names in whiskey.<sup>1</sup> The 150-year-old liquor emerged from prohibition and World War II as a rock and roll music staple that thrust the whiskey into the spotlight.<sup>2</sup> Aside from its appeal behind the bar, Jack Daniel’s has manifested beyond the bottle in the form of branded merchandise,<sup>3</sup> song lyrics,<sup>4</sup> and even virtual reality experiences.<sup>5</sup> So it would be no surprise to find the whiskey that graced the hands of Frank Sinatra and Axl Rose<sup>6</sup> to now be gracing the jaws of your canine... right?

Enter VIP Products LLC (“VIP”), a dog-toy company that makes and sells squeaky rubber chew toys.<sup>7</sup> In 2014, VIP released the “Bad Spaniels” dog toy, a squeaky chew toy that clearly resembles a bottle of Jack Daniel’s with a few key changes that associate the whiskey with dog excrement.<sup>8</sup>

Jack Daniel’s was not amused. The parties soon found themselves in court,<sup>9</sup> with Jack Daniel’s accusing VIP of trademark infringement<sup>10</sup> and VIP claiming Bad Spaniels was protected

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<sup>1</sup> See *Born to Make Whiskey*, JACK DANIEL’S, <https://www.jackdaniels.com/en-us/our-story> (last visited Nov. 26, 2024) (describing the fame of Jack Daniel’s whiskey); Clay Risen, *Jack Daniel’s Tweaks Its Brand, From Bland to Exclusive*, THE NEW YORK TIMES (Oct. 12, 2023), <https://www.nytimes.com/2023/10/12/dining/drinks/jack-daniels-whiskey-rebrands.html> (providing an overview of the Jack Daniel’s brand).

<sup>2</sup> See *Born to Make Whiskey*, *supra* note 1 (giving an overview of the Jack Daniel’s 150-year history).

<sup>3</sup> See *Jack Daniel’s Store*, <https://store.jackdaniels.com/> (last visited Nov. 26, 2024) (selling Jack Daniel’s merchandise).

<sup>4</sup> See *TiK ToK*, GENIUS, <https://genius.com/Kesha-tik-tok-lyrics> (last visited Nov. 26, 2024) (providing the lyrics to “TiK ToK” by Ke\$ha which includes the line “Before I leave, brush my teeth with a bottle of Jack”).

<sup>5</sup> See *Jack Daniel’s Tennessee Honey Presents Art, Beats & Lyrics.*, JACK DANIEL’S, <https://www.jackdaniels.com/en-us/vault/art-beats-lyrics> (last visited Nov. 26, 2024) (detailing the Jack Daniel’s immersive virtual reality experience, “The Verse”).

<sup>6</sup> See Clay Risen, *supra* note 1 (identifying music icons Frank Sinatra and Axl Rose as Jack Daniel’s devotees).

<sup>7</sup> See *Jack Daniel’s Props. v. VIP Prods. LLC*, 599 U.S. 140, 148 (2023) (outlining VIP’s business).

<sup>8</sup> See *id.* at 149–50 (describing the Bad Spaniels toy).

<sup>9</sup> See *id.* at 150 (noting that Jack Daniel’s sent VIP a cease and desist letter before VIP initiated court proceedings, seeking a declaratory judgment that the Bad Spaniels toy did not infringe the Jack Daniel’s marks). While this case involves claims for both trademark infringement and trademark dilution, *id.*, this Note only discusses the trademark infringement claim.

<sup>10</sup> See *id.* at 150–51 (identifying that Jack Daniel’s counterclaimed against VIP for trademark infringement).

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

by the First Amendment.<sup>11</sup> The case made its way to the Supreme Court in *Jack Daniel’s Properties v. VIP Products LLC*,<sup>12</sup> where the Court was tasked with deciding whether the Bad Spaniels toy was entitled to an application of the *Rogers* test.<sup>13</sup>

The *Rogers* test is a defendant’s dream and a plaintiff’s nightmare.<sup>14</sup> Born from the clash of an actress and the unauthorized use of her name in a movie title, the Second Circuit created the two-prong *Rogers* test to protect First Amendment interests in trademark law.<sup>15</sup> However, over the course of three decades, *Rogers* has been applied to factual scenarios that extend the doctrine well beyond its limits<sup>16</sup> and provide defendants with a quick avenue for dismissal.<sup>17</sup> Despite the doctrine’s good intentions, the *Rogers* test fails to adequately balance a brand owner’s trademark rights under the Lanham Act and an alleged infringer’s freedom of expression rights under the First Amendment.<sup>18</sup>

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<sup>11</sup> See *id.* at 151 (detailing VIP’s First Amendment argument for the trademark infringement claim). A defendant can raise a First Amendment defense in a trademark claim which allows for an application of the *Rogers* test instead of the standard likelihood of confusion test. See *id.* (describing the First Amendment defense in the context of VIP’s arguments).

<sup>12</sup> 599 U.S. 140 (2023)

<sup>13</sup> See *id.* at 152–53 (defining the issue of the case as “[s]hould [Jack Daniel’s] have had to satisfy the *Rogers* threshold test before the case could proceed to the Lanham Act’s likelihood-of-confusion inquiry?”). When an expressive work is involved, the “*Rogers* test requires dismissal of an infringement claim at the outset unless the complainant can show one of two things: that the challenged use of a mark ‘has no artistic relevance to the underlying work’ or that it ‘explicitly misleads as to the source or the content of the work.’” *Id.* at 151.

<sup>14</sup> See *id.* at 157 (stating that the *Rogers* test is “an escape from the likelihood-of-confusion inquiry and a shortcut to dismissal”); see also Amy (Salomon) McFarland, *The Last Dance? The Future of the “Rogers Test” After the Jack Daniel’s Decision*, THE NATIONAL LAW REVIEW (Mar. 28, 2024), <https://natlawreview.com/article/last-dance-future-rogers-test-after-jack-daniels-decision> (observing that an application of the *Rogers* test in trademark infringement claims usually results in favor of the defendant at the motion to dismiss or summary judgment stage).

<sup>15</sup> See *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989) (describing the First Amendment concerns that informed the creation of the *Rogers* test). The First Amendment of the United States Constitution protects the right to freedom of expression, granting individuals the right to express themselves through words or symbolic actions without government interference or regulation. See *First Amendment*, CORNELL LAW SCHOOL, [https://www.law.cornell.edu/wex/first\\_amendment](https://www.law.cornell.edu/wex/first_amendment) (last visited Nov. 27, 2024) (explaining the First Amendment).

<sup>16</sup> See *Stouffer v. Nat’l Geographic Partners, LLC*, 400 F. Supp. 3d 1161, 1178–79 (D. Colo. 2019) (giving a rationale for its refusal to adopt the *Rogers* test).

<sup>17</sup> See *Jack Daniel’s*, 599 U.S. at 157 (recognizing that the *Rogers* test offers “a shortcut to dismissal”); see also McFarland, *supra* note 14 (same).

<sup>18</sup> See, e.g., *Stouffer*, 400 F. Supp. 3d at 1177–79 (acknowledging the need to limit the Lanham Act in light of First Amendment concerns but refusing to adopt the *Rogers* test as the method to address those concerns).

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

In *Jack Daniel's*, the Supreme Court imposed a significant limitation on the doctrine, holding that the *Rogers* test does not apply if the alleged infringer uses the mark as a trademark.<sup>19</sup> However, the decision left unanswered what constitutes “trademark use” and when the inquiry should apply.<sup>20</sup>

## II. LEGAL BACKGROUND

A trademark is any word, phrase, symbol, design, or a combination of such elements that identify a business’s goods or services.<sup>21</sup> The primary function of a trademark is to help consumers distinguish one brand’s goods from competitors’ goods in the marketplace.<sup>22</sup> Under the Lanham Act,<sup>23</sup> a brand owner can voluntarily register its trademark with the United States Patent and Trademark Office (USPTO).<sup>24</sup> A trademark is eligible for federal registration with the USPTO if (1) the mark is used in commerce<sup>25</sup> and (2) the mark is distinctive.<sup>26</sup>

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<sup>19</sup> See *Jack Daniel's*, 599 U.S. at 153 (holding that the *Rogers* test does not apply “when an alleged infringer uses a trademark in the way the Lanham Act most cares about: as a designation of source for the infringer’s own goods.”).

<sup>20</sup> See *id.* at 165 (J. Gorsuch concurring) (“we necessarily leave much about *Rogers* unaddressed.”).

<sup>21</sup> *Id.* at 145; see also *What is a trademark?*, USPTO, <https://www.uspto.gov/trademarks/basics/what-trademark> (last visited Nov. 27, 2024) (defining a trademark). For the purposes of this Note, only goods will be discussed.

<sup>22</sup> See *Jack Daniel's*, 599 U.S. at 145–46 (identifying the primary function of trademarks); see also *What is a trademark?*, *supra* note 21 (same).

<sup>23</sup> The Lanham Act, codified as 15 U.S.C. § 1051, was enacted by Congress in 1946 and serves as the “core federal trademark statute.” *Jack Daniel's*, 599 U.S. at 145; see also *Lanham Act*, CORNELL LAW SCHOOL, [https://www.law.cornell.edu/wex/lanham\\_act](https://www.law.cornell.edu/wex/lanham_act) (last visited Nov. 27, 2024) (giving an overview of the Lanham Act).

<sup>24</sup> See *Jack Daniel's*, 599 U.S. at 146 (stating that mark owners can voluntarily register their trademarks).

<sup>25</sup> See *Lanham Act*, *supra* note 23 (providing the two basic requirements for trademark registration). A mark is used in commerce if the mark is affixed to goods that are sold or transported out of state. See *Application filing basis*, USPTO, <https://www.uspto.gov/trademarks/basics/application-filing-basis> (last visited Nov. 27, 2024) (explaining the use in commerce requirement); see also TMEP § 901.01 (May 2024) (defining use in commerce as “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”). To show that the mark is being used in commerce, applicants must submit a specimen with their trademark application that shows their mark affixed to the good’s packaging, displays, hangtags, labels, or an associated product listing for the good. See *Application filing basis*, USPTO, <https://www.uspto.gov/trademarks/basics/application-filing-basis> (last visited Nov. 27, 2024) (click on the linked text for “specimen”) (detailing the evidence required for proving a mark is used in commerce); see also TMEP § 901.01 (May 2024) (listing acceptable specimen).

<sup>26</sup> See *Lanham Act*, *supra* note 23 (providing the two basic requirements for trademark registration). A mark is distinctive if it allows consumers to easily distinguish the owner’s mark from other goods or services in the marketplace. See *Strong trademarks*, USPTO, <https://www.uspto.gov/trademarks/basics/strong-trademarks> (last visited Nov. 27, 2024) (click on the linked text for “inherently distinctive”) (defining a distinctive mark and the qualities of a strong trademark).

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

### *a. Likelihood of Confusion*

The Lanham Act allows a trademark owner to bring a federal cause of action for trademark infringement against a party using a mark in a similar way to its own.<sup>27</sup> To bring a trademark infringement claim, the plaintiff must show (1) the plaintiff has a valid trademark; (2) the plaintiff owns the mark; and (3) the defendant’s use of the mark creates a likelihood of confusion,<sup>28</sup> meaning the defendant’s use of the mark is “likely to cause confusion, or to cause mistake, or to deceive.”<sup>29</sup> A trademark registration with the USPTO is *prima facie* evidence of a valid trademark and trademark ownership, thus satisfying the first and second elements of a trademark infringement claim.<sup>30</sup>

The likelihood of confusion element is the “bête noir of trademark law—the thing that stands directly opposed to the law’s twin goals of facilitating consumers’ choice and protecting producers’ good will.”<sup>31</sup> The likelihood of confusion test is a fact-sensitive, multi-factor inquiry that aims to predict a consumer’s perception of a good in the marketplace.<sup>32</sup> Each circuit has developed its own set of factors for assessing likelihood of confusion, but there is significant overlap in the factors across jurisdictions.<sup>33</sup> The six most common likelihood of confusion

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<sup>27</sup> See *Jack Daniel’s*, 599 U.S. at 147 (relaying that, under the Lanham Act’s federal cause of action for trademark infringement, “the owner of a mark sues someone using a mark that closely resembles its own.”).

<sup>28</sup> See *Lanham Act*, *supra* note 23 (listing the three elements of a trademark infringement claim).

<sup>29</sup> See *Jack Daniel’s*, 599 U.S. at 147 (quoting §§ 1114(1)(a), 1125(a)(1)(A)) (calling the likelihood of confusion standard the statutory “keystone”).

<sup>30</sup> See *Jack Daniel’s*, 599 U.S. 140, 146–47 (2023) (citing *Iancu v. Brunetti*, 588 U.S. 388, 391 (2019)) (identifying the benefits of a federally registered trademark in a trademark infringement claim); *Why register your trademark?*, USPTO, <https://www.uspto.gov/trademarks/basics/why-register-your-trademark> (last visited Nov. 27, 2024) (noting a benefit of federal trademark registration is the “[l]egal presumption that [the brand owner] own[s] the trademark and ha[s] the right to use it”).

<sup>31</sup> *Jack Daniel’s*, 599 U.S. at 147.

<sup>32</sup> See 1 Gilson on Trademarks § 2A.05 (2024) (giving a general explanation of the likelihood of confusion test).

<sup>33</sup> See 1A Gilson on Trademarks § 5.02 (2024) (stating that the circuits’ likelihood of confusion factors “overlap[], [are] closely related and, frequently, identical.”); see also Andrew C. Michaels, *Confusion in Trademarked NFTs*, STANFORD JOURNAL OF BLOCKCHAIN LAW & POLICY (Jan. 2, 2024), <https://stanford-jblp.pubpub.org/pub/confusion-trademarked-nfts/release/1> (identifying that there are roughly six “core” likelihood of confusion factors shared across the circuits).

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

factors are: (1) the strength of the plaintiff’s trademark; (2) the degree of similarity between the plaintiff’s and defendant’s marks; (3) the degree of relatedness between the plaintiff’s and defendant’s goods; (4) the defendant’s intent in using the mark; (5) evidence of actual consumer confusion; and (6) consumer sophistication in the marketplace.<sup>34</sup>

### *b. The Rogers Test*

In a trademark infringement suit, a defendant can argue that its use of the plaintiff’s mark in an expressive work is protected by the First Amendment.<sup>35</sup> To address First Amendment concerns in trademark law, most circuits have adopted the *Rogers* test,<sup>36</sup> a two-prong test developed in the Second Circuit’s 1989 decision, *Rogers v. Grimaldi*.<sup>37</sup>

In *Rogers*, the defendants produced and distributed “Ginger and Fred,” a film that followed two fictional Italian cabaret dancers, Pippo and Amelia, who imitated the famous dancing duo Ginger Rogers and Fred Astaire.<sup>38</sup> Once the film was released in the United States, Ginger Rogers sued the producers and distributors of the film for, *inter alia*, trademark infringement,

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<sup>34</sup> See Andrew C. Michaels, *supra* note 33 (listing the six most common likelihood of confusion factors); see also 1A Gilson on Trademarks § 5.02 (2024) (providing each circuit’s likelihood of confusion factors).

<sup>35</sup> See *Jack Daniel’s*, 599 U.S. at 151 (outlining VIP’s argument at the District Court level that the Bad Spaniels toy was part of an expressive work and was thus protected by the First Amendment); see also Taylor E. Green, *Commentary: The Rogers Test Dances Between Trademark Protection Under The Lanham Act And Freedom of Speech Under The First Amendment*, 112 THE TRADEMARK REPORTER 843, 848 (2022), <https://www.inta.org/wp-content/uploads/public-files/resources/the-trademark-reporter/TMR-Vol-112-No-05-Green.pdf> (explaining the purpose and application of the *Rogers* test).

<sup>36</sup> See Taylor E. Green, *supra* note 35, at 848 (“To prevent conflict between the First Amendment and the Lanham Act, the Second Circuit in *Rogers v. Grimaldi* adopted a two-prong test”).

<sup>37</sup> 875 F.2d 994 (2d Cir. 1989). See generally *id.* (creating the two-prong test to protect First Amendment interests in trademark infringement claims). “[T]he Third, Fifth, Sixth, Ninth, and Eleventh Circuits, and federal district courts within the Seventh and Tenth Circuits[,]” have adopted the *Rogers* test. Lynn M. Jordan and David M. Kelly, *Another Decade of Rogers v. Grimaldi: Continuing to Balance the Lanham Act with the First Amendment Rights of Creators of Artistic Work*, 109 THE TRADEMARK REPORTER 833, 834–35 (2019), [https://www.inta.org/wp-content/uploads/public-files/resources/the-trademark-reporter/vol109\\_no5\\_a1\\_jordan\\_kelly.pdf](https://www.inta.org/wp-content/uploads/public-files/resources/the-trademark-reporter/vol109_no5_a1_jordan_kelly.pdf).

<sup>38</sup> See *Rogers*, 875 F.2d at 996–97 (summarizing the facts of the case).

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

alleging that the defendants “creat[ed] the false impression that the film was about her or that she sponsored, endorsed, or was otherwise involved in the film[.]”<sup>39</sup>

The court rejected the actress’s trademark infringement claim, holding that titles of artistic works have an expressive element that implicate First Amendment values and “pose[] only a ‘slight risk’ of confusing consumers about either ‘the source or the content of the work.’”<sup>40</sup> In this, the Second Circuit developed a two-prong test to evaluate when the use of a mark in an expressive work falls within the purview of the First Amendment rather than the Lanham Act: if the alleged infringer’s use of the mark is part of an expressive work (the “threshold inquiry”), then the defendant is entitled to First Amendment protection unless (1) the use has no artistic relevance to the underlying work (the “first prong”) or (2) the use is explicitly misleading as to the source or content of the work (the “second prong”).<sup>41</sup>

Three decades later, *Rogers* has gone beyond its intended use of safeguarding First Amendment rights in trademark law to finding in favor of virtually every defendant who raises the defense.<sup>42</sup> In practice, “just about everything” satisfies the threshold inquiry of *Rogers*,<sup>43</sup> and

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<sup>39</sup> See *id.* at 996–97 (describing the cause of action for trademark infringement).

<sup>40</sup> See *Jack Daniel’s Props. v. VIP Prods. LLC*, 599 U.S. 140, 153 (2023) (quoting *Rogers*, 875 F.2d at 999–1000) (explaining the *Rogers* holding).

<sup>41</sup> See *Rogers*, 875 F.2d at 999 (stating the two-prong test “[i]n the context of allegedly misleading titles using a celebrity’s name”); *Jack Daniel’s*, 599 U.S. at 153–54 (providing the *Rogers* test threshold inquiry and two prongs); see also Amy (Salomon) McFarland, *supra* note 14 (same).

<sup>42</sup> See Lynn M. Jordan and David M. Kelly, *supra* note 37, at 871 (“Nearly every case applying *Rogers* has done so on either a motion to dismiss or on summary judgment.”); Amy (Salomon) McFarland, *supra* note 14 (noting that cases involving *Rogers* are usually dismissed at the motion to dismiss or summary judgement phase).

<sup>43</sup> See *Jack Daniel’s*, 599 U.S. at 157–59 (stating that, given that trademarks are almost always expressive, “few cases would even get to the likelihood-of-confusion inquiry if all expressive content triggered the *Rogers* filter.”); see also Massimo B. Capizzi, *Ninth Circuit Provides Further Guidance on Trademark Lawsuits Involving “Expressive Works”*, PROSKAUER: MINDING YOUR BUSINESS (Feb. 23, 2024), <https://www.mindingyourbusinesslitigation.com/2024/02/ninth-circuit-provides-further-guidance-on-trademark-lawsuits-involving-expressive-works/> (explaining how the *Rogers* test is broadly applied because “just about everything” qualifies as an expressive work).

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

anything “above zero” satisfies the level of artistic relevance required for the first prong.<sup>44</sup> As a result, much of the *Rogers* inquiry turns on the second prong which, unfortunately for plaintiffs, offers no reprieve for the defendant-friendly test.<sup>45</sup> The “explicitly misleading” standard varies across the circuits,<sup>46</sup> ranging from the Second Circuit’s “particularly compelling” showing under the likelihood of confusion factors to the Ninth Circuit’s inquiry into whether the defendant affirmatively created a false impression of affiliation with or endorsement from the plaintiff.<sup>47</sup> Regardless of what circuit the parties find themselves in, courts are quick to dismiss a trademark infringement case following an application of the *Rogers* test at the motion to dismiss or summary judgment phase.<sup>48</sup> Accordingly, as the Tenth Circuit noted in its refusal to adopt the *Rogers* test, courts that suspect abuse of *Rogers* are forced to contort the doctrine in an awkward application of precedent to achieve a just result.<sup>49</sup>

### III. *JACK DANIEL’S*: THE SUPREME COURT’S DECISION

In 2023, the Supreme Court placed a significant limitation on the application of the *Rogers* test in *Jack Daniel’s*. The case involves an unlikely pairing: Jack Daniel’s, the iconic whiskey

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<sup>44</sup> See Amber Grant, *NOTE: “Free” Speech: Reframing the Rogers Test to Adequately Balance Rights in a Rapidly Evolving Digital Era*, 76 FED. COMM. L.J. 399, 405 (2024) (providing that the standard for artistic relevance is anything “above zero”); see also Taylor E. Green, *supra* note 35, at 850 (describing how courts have been “liberal and consistent” in finding the first prong satisfied); Lynn M. Jordan and David M. Kelly, *supra* note 37, at 840 (“Very few cases have ever held that there was no artistic relevance.”).

<sup>45</sup> See Amber Grant, *supra* note 44, at 412 (“the rights of trademark owners are solely within the ‘explicitly misleading’ prong as the First Amendment will almost always prevail on the ‘artistic relevance’ prong.”).

<sup>46</sup> See Lynn M. Jordan and David M. Kelly, *supra* note 37, at 845 (identifying that the second prong of *Rogers* is inconsistent in application across the circuits); Taylor E. Green, *supra* note 35, at 852 (same).

<sup>47</sup> See Anthony J. Dreyer, Shay Dvoretzky, Jordan Feirman, et. al., *Supreme Court Sharply Limits Applicability of Rogers v. Grimaldi Test for Trademark Infringement*, SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP (June 8, 2023), <https://www.skadden.com/insights/publications/2023/06/supreme-court-sharply-limits-applicability> (stating the standard for evaluating the second prong of *Rogers* in the Second and Ninth Circuits).

<sup>48</sup> See Lynn M. Jordan and David M. Kelly, *supra* note 37, at 871 (explaining that the *Rogers* test usually leads to quick dismissal of a trademark infringement claim); see also Amy (Salomon) McFarland, *supra* note 14 (same).

<sup>49</sup> See *Stouffer v. Nat’l Geographic Partners, LLC*, 400 F. Supp. 3d 1161, 1178–79 (D. Colo. 2019) (describing the “square-peg/round-hole problem” that have led other circuits to “analytically messy” decisions under *Rogers*).



**THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION**

brand and owner of the recognizable Jack Daniel’s trademarks,<sup>50</sup> and VIP, a company that makes and sells chewable, squeaky dog toys under the name “Silly Squeakers.”<sup>51</sup> VIP’s Silly Squeakers mostly consist of dog toys mimicking popular beverage brands such as Dos Perros (cf. Dos Equis), Smella Arpaw (cf. Stella Artois), and Doggie Walker (cf. Johnnie Walker).<sup>52</sup> VIP owns registered trademarks in each of those names as well as in the product line name, Silly Squeakers.<sup>53</sup>

In 2014, VIP added the “Bad Spaniels” toy to its product line.<sup>54</sup> The toy evoked the distinctive size, shape, and label of a Jack Daniel’s bottle with a few unsavory changes that associate the whiskey with dog excrement.<sup>55</sup> For example, the dog toy’s label replaces “Jack Daniel’s” with “Bad Spaniels” and inserts “The Old No. 2 On Your Tennessee Carpet” for “Old. No. 7 Brand Tennessee Sour Mash Whiskey” in similar graphic form.<sup>56</sup> Also, in lieu of “40% alc. by vol. (80 proof),” the small print at the bottom of the dog toy’s label claims “43% poo by vol.” and “100% smelly.”<sup>57</sup> The Bad Spaniels packaging included a cardboard hangtag featuring the Silly Squeakers and Bad Spaniels product logos along with the disclaimer, “This product is not affiliated with Jack Daniel Distillery.”<sup>58</sup>

Shortly after the Bad Spaniels toy was released, Jack Daniel’s sent VIP a letter demanding VIP to stop selling the product, claiming that consumers would believe that Jack Daniel’s created

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<sup>50</sup> Jack Daniel’s Props. v. VIP Prods. LLC, 599 U.S. 140, 144 (2023) (describing Jack Daniel’s). Jack Daniel’s owns trademarks in “Jack Daniel’s,” “Old No. 7,” the arched “Jack Daniel’s” logo, the stylized white filigree (*i.e.*, twirling white lines), and the Jack Daniel’s distinctive square bottle. *See id.* at 148 (listing the Jack Daniel’s marks).

<sup>51</sup> *See id.* at 148–49 (identifying VIP’s business).

<sup>52</sup> *Id.*

<sup>53</sup> *Id.* at 149.

<sup>54</sup> *Id.* VIP did not apply to register “Bad Spaniels” as a trademark, but its complaint alleged that it owns and uses the Bad Spaniels trademark. *Id.*

<sup>55</sup> *See id.* at 149–50 (describing how the Bad Spaniels toy mimicked a Jack Daniel’s bottle).

<sup>56</sup> *Id.*

<sup>57</sup> *Id.* at 150.

<sup>58</sup> *Id.* at 150.

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

or endorsed the dog toy.<sup>59</sup> In turn, VIP sued Jack Daniel’s in the United States District Court for the District of Arizona, seeking a declaratory judgement that Bad Spaniels did not infringe the Jack Daniel’s trademarks.<sup>60</sup> Jack Daniel’s counterclaimed for trademark infringement.<sup>61</sup> At summary judgement, VIP argued that the *Rogers* test—not the likelihood of confusion test—should apply, and that Jack Daniels’ infringement claim failed under *Rogers*.<sup>62</sup>

The District Court rejected VIP’s arguments, reasoning that *Rogers* did not apply because VIP used Jack Daniels’ trademarks “to identify the source of its own products.”<sup>63</sup> Accordingly, at a bench trial, the District Court found that Bad Spaniels would likely cause consumers to be confused about the source of the toy.<sup>64</sup>

The Ninth Circuit reversed on appeal, finding that the infringement claim should be assessed under the *Rogers* test, and remanded the case to the District Court.<sup>65</sup> On remand, the District Court granted summary judgement to VIP on the infringement claim.<sup>66</sup> The Ninth Circuit affirmed, and the Supreme Court granted certiorari to determine whether the *Rogers* test or the likelihood of confusion test applied.<sup>67</sup>

In its decision, while the Court refused to take a position on the merit of *Rogers*, the Court deemed that the doctrine is “cabined” in that its application has been limited to cases involving “non-trademark uses.”<sup>68</sup> In this, the Court held that the *Rogers* test does not apply “when an alleged infringer uses a trademark in the way the Lanham Act most cares about: as a designation

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<sup>59</sup> See *id.* at 144, 150 (laying out the contents of Jack Daniels’ cease and desist letter).

<sup>60</sup> See *VIP Prods., LLC v. Jack Daniel’s Props.*, No. 14-2057, 2016 U.S. Dist. LEXIS 133387, at \*3–4 (D. Ariz. Sept. 27, 2016) (listing VIP’s claims).

<sup>61</sup> See *Jack Daniel’s*, 599 U.S. at 150–51 (explaining the procedural history).

<sup>62</sup> See *id.* at 151 (providing VIP’s arguments).

<sup>63</sup> See *id.* (stating the District Court’s decision).

<sup>64</sup> See *id.* at 151–52 (noting the District Court’s holding under the likelihood of confusion test).

<sup>65</sup> See *id.* at 152 (explaining the Ninth Circuit’s decision).

<sup>66</sup> See *id.* (providing the District Court’s decision after the Ninth Circuit remanded).

<sup>67</sup> See *id.* (detailing the issues on appeal for the Supreme Court’s review).

<sup>68</sup> See *id.* at 155–56 (giving its view of *Rogers*).

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

of source for the infringer’s own goods.”<sup>69</sup> To illustrate this point, the Court provided a hypothetical:

Suppose a filmmaker uses a Louis Vuitton suitcase to convey something about a character (he is the kind of person who wants to be seen with the product but doesn’t know how to pronounce its name). Now think about a different scenario: A luggage manufacturer uses an ever-so-slightly modified LV logo to make inroads in the suitcase market. The greater likelihood of confusion inheres in the latter use, because it is the one conveying information (or misinformation) about who is responsible for a product. That kind of use “implicate[s] the core concerns of trademark law” and creates “the paradigmatic infringement case.” So the *Rogers* test—which offers an escape from the likelihood-of-confusion inquiry and a shortcut to dismissal—has no proper application.<sup>70</sup>

Additionally, the Court reasoned that, since most trademarks have some expressive element, any expressive value proffered by an alleged infringer’s use of the mark cannot be shielded by an application of the *Rogers* test.<sup>71</sup> Rather, the Court found that free expression interests are accounted for in the likelihood of confusion inquiry.<sup>72</sup> Thus, the *Rogers* test does not apply when an alleged infringer uses a mark as an indication of source, regardless of any expressive value.<sup>73</sup>

Applying this to the case at bar, the Court found that VIP admitted to using the Bad Spaniels trademark as a source identifier.<sup>74</sup> VIP alleged in its complaint that, though unregistered, it owns and uses the Bad Spaniels trademark for its dog toy and intended to use the mark to identify VIP as the source.<sup>75</sup>

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<sup>69</sup> *Id.* at 153.

<sup>70</sup> *Id.* at 157 (citation omitted).

<sup>71</sup> *See id.* at 157–58 (stating that *Rogers* would “take over much of the world” if it applied whenever use of a trademark contained expressive content).

<sup>72</sup> *See id.* at 159 (“When a mark is used as a mark (except, potentially, in rare situations), the likelihood-of-confusion inquiry does enough work to account for the interest in free expression.”).

<sup>73</sup> *See id.* at 153 (dismissing VIP’s argument that the *Rogers* test should apply because Bad Spaniels was parodying Jack Daniel’s, reasoning that any expressive value added by the parody could “make a difference” in the application of the likelihood of confusion test).

<sup>74</sup> *See id.* at 159–60 (agreeing with the District Court’s initial decision that VIP used the Bad Spaniels trademark as a source identifier).

<sup>75</sup> *See id.* at 160 (pointing out the allegations in VIP’s complaint that showed VIP conceded the point of trademark use).

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

Outside of the complaint, the Court pointed to additional evidence of VIP’s intent to use Bad Spaniels as an indicator of source.<sup>76</sup> First, looking at the product’s marketing, the Court found that the Bad Spaniels and Silly Squeakers product logos on the toy’s hangtag served the same source-identifying function.<sup>77</sup> Second, VIP’s practice of registering some—though not all—of its beverage-themed dog toys under the Silly Squeakers line was an “admission that it is using the Bad Spaniels (née Jack Daniel’s) trademarks as trademarks, to identify product source.”<sup>78</sup> Accordingly, the Court remanded the case with instructions to apply the likelihood of confusion test.<sup>79</sup>

### IV. *JACK DANIEL’S* AFTERMATH & PROPOSED FRAMEWORK

Despite the Court’s “narrow” holding,<sup>80</sup> the impact of *Jack Daniel’s* on the future of the *Rogers* test is undeniable.<sup>81</sup> Indeed, Justice Gorsuch’s concurrence, with Justice Thomas and Justice Barrett joining, stated, “I write separately only to underscore that lower courts should handle *Rogers*... with care. ... [W]e necessarily leave much about *Rogers* unaddressed... and lower courts should be attuned to that fact.”<sup>82</sup> This concession highlights the ambiguity in how the *Jack Daniel’s* inquiry fits into the *Rogers* test and what constitutes “trademark use” under the *Jack Daniel’s* inquiry.<sup>83</sup>

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<sup>76</sup> See *id.* (“In this Court, VIP says the complaint was a mere ‘form allegation’—a matter of ‘rote.’ But even if we knew what that meant, VIP has said and done more in the same direction.”).

<sup>77</sup> See *id.* (identifying that the logos on the Bad Spaniels hangtag served a source-identifying function).

<sup>78</sup> *Id.*

<sup>79</sup> See *id.* at 163 (summarizing the Court’s decision).

<sup>80</sup> See *id.* at 153 (describing the decision as the “narrower path” in refusing to take a stance on the merit of *Rogers*).

<sup>81</sup> See, e.g., Bruce Isaacs, *Is Rogers v. Grimaldi dead? No! but...*, DAILY JOURNAL (June 14, 2023), <https://www.dailyjournal.com/articles/373282-is-i-rogers-v-grimaldi-i-dead-no-but> (explaining the impact of the *Rogers* test); Amy (Salomon) McFarland, *supra* note 14 (same).

<sup>82</sup> *Jack Daniel’s*, 599 U.S. at 165 (Justice Gorsuch concurring).

<sup>83</sup> See, e.g., Anthony J. Dreyer, Shay Dvoretzky, Jordan Feirman, et. al., *supra* note 47 (identifying the questions left unanswered from the *Jack Daniel’s* decision); Bruce Isaacs, *supra* note 83 (same); Amy (Salomon) McFarland, *supra* note 14 (same).

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

To attempt to resolve these questions, this Note proposes a revised *Rogers* framework that eliminates the threshold inquiry of the *Rogers* test, replaces the first prong of the *Rogers* test with the *Jack Daniel's* inquiry, and, only if the first prong fails, reviews the second prong of *Rogers*.<sup>84</sup> Moreover, this Note introduces a methodology for analyzing the *Jack Daniel's* inquiry by synthesizing relevant definitions under the Trademark Manual of Examining Procedure (TMEP)<sup>85</sup> and recent case law applying the *Rogers* test in light of *Jack Daniel's*.

### *a. Eliminate the Threshold Inquiry of the Rogers Test*

To begin, this Note’s proposed framework eliminates the threshold inquiry of the *Rogers* test.<sup>86</sup> As the Supreme Court made clear in *Jack Daniel's*, “trademarks are often expressive, in any number of ways[,]” and “few cases would... get to the likelihood-of-confusion inquiry if all expressive content triggered the *Rogers* filter.”<sup>87</sup> Indeed, recent lower court decisions applying *Jack Daniel's* have largely replaced the threshold inquiry with the *Jack Daniel's* inquiry.<sup>88</sup>

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<sup>84</sup> Despite some indication that *Rogers* may not survive another review by the Supreme Court, *see, e.g., Jack Daniel's*, 599 U.S. at 165 (Justice Gorsuch concurring), this Note supports the notion that First Amendment protections in trademark law should exist. That said, this Note sees the *Jack Daniel's* decision as an opportunity to update the *Rogers* test to better balance trademark law with First Amendment concerns.

<sup>85</sup> The TMEP “provide[s] trademark examining attorneys in the USPTO, trademark applicants, and attorneys and representatives for trademark applicants with a reference work on the practices and procedures relative to... register[ing] marks in the USPTO. The Manual contains guidelines... which Examining Attorneys are required or authorized to follow in the examination of trademark applications.” TMEP, *Foreword* (May 2024). “Trademark examining attorneys review trademark applications for compliance with the Lanham Act for the purpose of determining registrability in the United States.” *Become a trademark examining attorney*, USPTO, <https://www.uspto.gov/jobs/become-trademark-examining-attorney> (last visited Nov. 29, 2024). Considering that the TMEP is a primary source of guidance for determining whether a trademark should be registered with the USPTO, the source is valuable for defining the *Jack Daniel's* inquiry.

<sup>86</sup> *See Jack Daniel's*, 599 U.S. at 161 (“There is no threshold test working to kick out all cases involving ‘expressive works.’”).

<sup>87</sup> *Id.* at 159–60.

<sup>88</sup> *See, e.g., Punchbowl, Inc. v. Aj Press, LLC*, 90 F.4th 1022, 1031 (9th Cir. 2024) (“To the point that our precedents previously held that *Rogers* applies when an expressive mark is used as a mark—and that the only threshold for applying *Rogers* was an attempt to apply the Lanham Act to something expressive—the Supreme Court has now made clear that this is incorrect.”); *Davis v. Amazon.com, Inc.*, No. 21-02090, 2023 U.S. Dist. LEXIS 197341, at \*13 (C.D. Cal. Nov. 2, 2023) (“Following *Jack Daniel's*, the threshold inquiry for this Court is whether the disputed title is a source identifier such that the holding of *Jack Daniel's* applies to bypass *Rogers*.”); *Homevestors of Am., Inc. v.*

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

Therefore, the threshold inquiry of the *Rogers* test serves no purpose in the post-*Jack Daniel's* landscape and should be discarded.<sup>89</sup>

### *b. Replace the First Prong of the Rogers Test with the Jack Daniel's Inquiry*

Next, the first prong of *Rogers* should be replaced with the *Jack Daniel's* inquiry of whether the alleged infringer used the trademark as a designation of source. Given the extremely low showing required to satisfy the first prong, courts have been “liberal and consistent” with finding that the alleged infringer’s use of the mark is artistically relevant to the underlying work.<sup>90</sup> In this, the first prong serves no real purpose in the *Rogers* test and should be replaced with the *Jack Daniel's* inquiry.

To address the *Jack Daniel's* inquiry, lower courts should ascertain the alleged infringer’s intent in using the mark: did the alleged infringer intend to use the mark as a designation of source? The thrust of this inquiry is to identify the alleged infringer’s motive for using the plaintiff’s mark.<sup>91</sup> As such, this Note’s proposed methodology for assessing the *Jack Daniel's*

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*Warner Bros. Discovery, Inc.*, No. 22-1583, 2023 U.S. Dist. LEXIS 227404, at \*4 (D. Del. Dec. 21, 2023) (finding that “[t]he Magistrate Judge correctly followed *Jack Daniel's* in conducting an initial source identification inquiry to determine whether the *Rogers* test should apply.”); *Down to Earth Organics, LLC v. Efron*, No. 22-06218, 2024 U.S. Dist. LEXIS 60825, at \*9 (S.D.N.Y. Mar. 31, 2024) (stating that the threshold inquiry to determine whether *Rogers* applies is if the defendant used the plaintiff’s marks as a designation of source); *Sajahtera, Inc. v. Kitross Apparel Los Angeles, LLC*, No. 23-8005, 2024 U.S. Dist. LEXIS 113163, at \*7–8 (C.D. Cal. June 10, 2024) (holding that the defendant’s work fell squarely within the bounds of the *Jack Daniel's* decision, rendering *Rogers* inapplicable to the case at bar).

<sup>89</sup> Under this Note’s reimagined *Rogers* test, it is worth nothing that if an alleged infringer is raising a First Amendment defense in a trademark infringement claim, it is presumed that the alleged infringer’s good or work has some expressive value. See *Jack Daniel's*, 599 U.S. at 158–59 (noting that, since trademarks are often expressive, not all expressive content should trigger the *Rogers* filter).

<sup>90</sup> See Taylor E. Green, *supra* note 35, at 849–50 (describing the first prong of the *Rogers* test).

<sup>91</sup> See, e.g., *Stouffer v. Nat’l Geographic Partners, LLC*, 400 F. Supp. 3d 1161, 1179 (D. Colo. 2019) (identifying that discerning the defendant’s motive for using the plaintiff’s mark is the appropriate question to ask in evaluating First Amendment rights in trademark law); *Hermès Int’l v. Rothschild*, 678 F. Supp. 3d 475, 484 (S.D.N.Y. 2023) (defining the “explicitly misleading” prong of *Rogers* as both “objectively misleading” and “intentionally misleading”). See also Taylor E. Green, *supra* note 35, at 861 (“The *Rogers* test fails to fairly balance the plaintiff’s use and the defendant’s use of the mark by failing to take into account the defendant’s intent and actual confusion.”); Amber Grant, *supra* note 44, at 412 (proposing to add an element assessing the defendant’s intent to the original

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

inquiry preserves the First Amendment concerns addressed in *Rogers* while preventing defendants from abusing the doctrine by crying “artist.”<sup>92</sup>

An alleged infringer’s intent can be shown through explicit or implicit evidence. Explicit evidence of intent includes a defendant’s admission of planning to use the mark as an indicator of source<sup>93</sup> or a trademark application or registration for the defendant’s mark with the USPTO.<sup>94</sup> This evidence alone would be sufficient to satisfy the *Jack Daniel’s* inquiry.

In the absence of explicit evidence, courts should weigh the following three factors to determine if there is implied intent: (1) whether the alleged infringer is using the mark in connection with a single good or work or with a product line or series of goods or works; (2) the prominent inclusion of either party’s marks on the alleged infringer’s packaging, website, or promotional materials for the good or work; and (3) whether the alleged infringer’s good or work is conceivably related to the plaintiff’s goods so as to put the parties in competition with each other.

First, it should be determined whether the alleged infringer<sup>95</sup> is using the mark in connection with a single good or work or with a product line or series of goods or works. The TMEP defines

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*Rogers* test). For the purposes of this Note’s proposed framework, whether the alleged infringer intended to invoke itself or the brand owner as the source of the good or work is irrelevant. *See Mar Vista Entm’t, LLC v. THQ Nordic AB*, No. 23-06924, 2024 U.S. Dist. LEXIS 119473, at \*9 (C.D. Cal. July 8, 2024) (“the Court does not read *Jack Daniel’s* as reaching only junior users who use a trademark as a source identifier to signal that they (the junior user) are behind the goods.”).

<sup>92</sup> *See* Taylar E. Green, *supra* note 35, at 852 (quoting *Parks v. LaFace Records*, 329 F.3d 437, 456 (6th Cir. 2003)) (emphasizing the Sixth Circuit’s “sagacious” observation that “the First Amendment cannot permit anyone who cries ‘artist’ to have carte blanche when it comes to naming and advertising his or her works.”).

<sup>93</sup> *See* *Jack Daniel’s Props. v. VIP Prods. LLC*, 599 U.S. 140, 159–60 (2023) (finding that VIP’s admission to using Bad Spaniels as a trademark was sufficient to show intent to use the mark as a source indicator).

<sup>94</sup> *See, e.g., Punchbowl, Inc.*, 90 F.4th at 1031 (holding that the defendant’s applications for the marks “Punchbowl News” and “Punchbowl Press” with the USPTO were indicative of trademark use); *Activision Publ’g, Inc. v. Warzone.com, LLC*, No. 21-03073, 2024 U.S. Dist. LEXIS 66820, at \*8 (C.D. Cal. Apr. 11, 2024) (finding that the counterclaim-defendant’s registration of the mark “WARZONE” with the USPTO qualified as trademark use).

<sup>95</sup> This proposed factor only examines whether the *alleged infringer*—not the brand owner—is using the mark in connection with a product line or series of goods or works. *Compare Jack Daniel’s*, 599 U.S. at 160 (finding that VIP’s use of the Jack Daniel’s marks for its Bad Spaniels toy did not warrant First Amendment protection), *with Mar*

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

a single creative work as a work “in which the content does not change, whether that work is in printed, recorded, or electronic form.”<sup>96</sup> Books, sound recordings, films, and theatrical performances are usually single works.<sup>97</sup> A single creative work is not registrable as a trademark “unless the title has been used on a *series* of creative works.”<sup>98</sup> The TMEP defines a series as “a type of work in which the content changes with each issue or performance[,]” such as magazines, “books with a second or subsequent edition in which the content changes significantly,” computer software, and coloring books.<sup>99</sup> Given the trademark registration requirements, it naturally follows that a defendant’s use of a mark in a series of creative works would be indicative of intent to use the mark as a designation of source and should thus be subject to the Lanham Act.<sup>100</sup>

The facts from *Hermès International v. Rothschild*<sup>101</sup> are helpful in illustrating this factor in practice. In *Hermès*, Mason Rothschild, a “marketing strategist,” created and released one hundred NFTs depicting a blurry, furry version of the French luxury fashion brand Hermès’ iconic Birkin handbag.<sup>102</sup> The MetaBirkins were available for purchase on Rothschild’s website, “www.metabirkins.com,” and collectively sold for over \$1.1 million.<sup>103</sup> Shortly after Hermès sent Rothschild a cease and desist letter, Hermès sued Rothschild for, *inter alia*, infringing on its

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*Vista Entm’t, LLC*, 2024 U.S. Dist. LEXIS 119473, at \*10 (holding that, since the *plaintiff’s* use of its mark was part of a registerable series, the defendant’s use of the plaintiff’s mark in the title of its single work was not protected by the First Amendment).

<sup>96</sup> TMEP § 1202.08(a) (May 2024).

<sup>97</sup> *See id.* (providing examples of single creative works).

<sup>98</sup> TMEP § 1202.08 (May 2024) (emphasis added). *See also Trademark refusal: Title of a single creative work*, USPTO, <https://www.uspto.gov/trademarks/laws/title-single-work-refusal-and-how-overcome-refusal> (last visited Nov. 30, 2024) (explaining the difference between a single work and a series of works).

<sup>99</sup> TMEP § 1202.08(b) (May 2024).

<sup>100</sup> *See Tiffany & Co. v. Costco Wholesale Corp.*, 971 F.3d 74, 92 (2d Cir. 2020) (citation omitted) (defining trademark use to include “the degree to which ‘defendants... try[] to create, through repetition... a[n] association between [themselves] and the [mark].’”).

<sup>101</sup> 678 F. Supp. 3d 475 (S.D.N.Y. June 23, 2023).

<sup>102</sup> *See Hermès Int’l v. Rothschild*, 654 F. Supp. 3d 268, 273–74 (S.D.N.Y. 2023) (providing the factual background of the case).

<sup>103</sup> *See id.* at 274 (explaining the distribution of the one hundred MetaBirkins NFTs and their collective sale total).



## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

Birkin trademarks.<sup>104</sup> Rothschild asserted a First Amendment defense.<sup>105</sup> Finding that the *Rogers* test was the appropriate standard for review,<sup>106</sup> the court instructed the jury that the first prong was satisfied as a matter of law and that “Rothschild’s works entitled him to total First Amendment protection...*unless* Hermès proved that Rothschild *intentionally* misled consumers into believing that Hermès was backing its products[.]”<sup>107</sup> The jury found Rothschild liable for trademark infringement under the *Rogers* test, determining that Rothschild intentionally used Hermès’ marks “to defraud consumers into believing, by his use of variations on Hermès’ trademarks, that Hermès was endorsing his lucrative MetaBirkins NFTs.”<sup>108</sup>

Under the first proposed factor of intent, Rothschild’s one hundred MetaBirkins NFTs would likely qualify as a series of works under the TMEP definition and would thus be evidence of implied intent. However, before Rothschild’s MetaBirkins project, Rothschild made a single NFT that depicted a fetus inside of a transparent Birkin bag called “Baby Birkin.”<sup>109</sup> In the case of the Baby Birkin, since the work would likely qualify as a single work under the TMEP, the first proposed factor of intent would not be satisfied. Accordingly, whether the alleged infringer used the mark in connection with a single good or work or with a product line or series of goods or works is indicative of intent.<sup>110</sup>

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<sup>104</sup> See *id.* at 275 (providing the procedural history of the case).

<sup>105</sup> See *id.* at 275–76 (discussing whether *Rogers* should apply).

<sup>106</sup> See *id.* at 276 (“it is the *Rogers* test that still applies here”).

<sup>107</sup> See *Hermès Int’l v. Rothschild*, 678 F. Supp. 3d 475, 481, 484 (S.D.N.Y. June 23, 2023) (providing the jury instructions).

<sup>108</sup> See *id.* at 485 (outlining the jury’s verdict).

<sup>109</sup> See *Hermès*, 654 F. Supp. 3d at 273 (detailing Rothschild’s Baby Birkin project).

<sup>110</sup> By reframing the *Rogers* court’s concerns of protecting titles of artistic works within the context of the TMEP, this proposed factor still allows First Amendment protection for titles of single artistic works that are otherwise unregistrable trademarks. See *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989) (“Though First Amendment concerns do not insulate titles of artistic works from all Lanham Act claims, such concerns must nonetheless inform our consideration of the scope of the Act as applied to claims involving such titles.”). Therefore, this factor should be allotted the most weight in the implied intent analysis.

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

Second, intent can be shown through the prominent<sup>111</sup> inclusion of either party’s marks on the alleged infringer’s packaging, website, or promotional materials for the good or work.<sup>112</sup> To register a trademark, the TMEP requires applicants to submit a specimen showing the mark affixed to the good’s packaging, displays, hangtags, labels, or an associated product listing for the good to demonstrate that the mark is being used in commerce.<sup>113</sup> The *Jack Daniel’s* decision identified that this type of evidence is indicative of trademark use, finding that VIP’s packaging of the dog toy—namely, the Bad Spaniels’ hangtag featuring the Silly Squeakers and Bad Spaniels logos—served as a designation of source.<sup>114</sup>

*Vans, Inc. v. MSCHF Product Studio, Inc.*<sup>115</sup> exemplifies this point. In *Vans*, MSCHF, an art collective, created and sold a shoe called the “Wavy Baby” that was, in essence, a “wobbly” version of the footwear and apparel company Vans’ “Old Skool” shoe.<sup>116</sup> The Wavy Baby sneakers featured “the Old Skool black and white color scheme, the side stripe, the perforated sole, the logo on the heel, the logo on the footbed, and the packaging.”<sup>117</sup> Vans sued MSCHF for, *inter alia*, trademark infringement, and MSCHF raised a First Amendment defense.<sup>118</sup> The court

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<sup>111</sup> For this proposed factor, the alleged infringer’s use of the plaintiff’s mark should rise above a “merely informational matter” which “is not registerable because consumers would perceive such matter as merely conveying general information about the goods or services or an informational message, and not as a means to identify and distinguish the applicant’s goods or services from those of others.” TMEP § 1202.04 (May 2024). The “prominence” inquiry would thus turn on “how the proposed mark would be perceived by the relevant public.” *Id.*

<sup>112</sup> See *Tiffany & Co. v. Costco Wholesale Corp.*, 971 F.3d 74, 92 (2d Cir. 2020) (citation omitted) (defining trademark use as the use of a mark “on the product ‘itself, on its packaging, or in any other advertising or promotional materials related to [the] product[.]’”).

<sup>113</sup> See TMEP § 904 (May 2024) (stating that trademark applicants must submit a specimen showing their mark is used in commerce). While promotional materials are only an acceptable specimen for trademarks used in connection with services, recent case law has found an alleged infringer’s use of a mark in its promotional materials as indicative of trademark use. See, e.g., *Activision Publ’g, Inc. v. Warzone.com, LLC*, No. 21-03073, 2024 U.S. Dist. LEXIS 66820, at \*9–10 (C.D. Cal. Apr. 11, 2024) (holding that *Rogers* did not apply where the counterclaim-defendant repeatedly referred to its new video game using the counterclaim-plaintiff’s mark in a press release and made the counterclaim-plaintiff’s mark the prominent word in the title of video game on its website).

<sup>114</sup> See *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 160 (2023) (explaining how the marketing of the Bad Spaniels product qualified as trademark use).

<sup>115</sup> 88 F.4th 125 (2d Cir. 2023).

<sup>116</sup> See *id.* at 129–130 (describing the facts of the case).

<sup>117</sup> *Id.* at 130.

<sup>118</sup> See *id.* at 133–34 (giving the procedural history of the case).

## THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION

found that the *Rogers* test did not apply because MSCHF sought to benefit off Vans’ good will by creating a shoe that evoked the Vans marks.<sup>119</sup> Thus, the court found that the likelihood of confusion factors applied.<sup>120</sup>

Under the second proposed factor of intent, MSCHF’s use of its logos on the shoe and its packaging would be indicative of intent to use the mark as a designation of source. Even though the Wavy Baby shoes did not use the Vans logo *per se*, like with *Jack Daniel’s*, the fact that MSCHF’s shoes evoked the Vans marks would be sufficient to satisfy the second factor.<sup>121</sup> Therefore, whether the alleged infringer prominently included either party’s marks on its packaging, website, or promotional materials for the good or work supports a showing of intent.

Third, whether the alleged infringer’s good or work is conceivably related to the plaintiff’s goods so as to put the parties in competition with each other supports a showing of intent. As the web of related goods is ever evolving, this factor should be treated as a sliding scale: evidence of identical goods would be more persuasive than goods that are somewhat or not at all related. For example, in *Vans*, the fact that Vans and MSCHF both sold sneakers would be clear evidence of intent to use the mark as an indicator of source under this factor.

On the other hand, the TMEP offers guidance for goods that are not inherently identical. The TMEP examines relatedness of goods in terms of whether “the goods... [are] related in some manner and/or the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.”<sup>122</sup> Under the TMEP, evidence such as news articles or internet searches showing the goods are used together by purchasers or

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<sup>119</sup> See *id.* at 138–39 (finding that the Wavy Baby evoked many of the Old Skool trademarks that acted as a source identifier).

<sup>120</sup> See *id.* at 139 (determining that the likelihood of confusion test applied).

<sup>121</sup> See *id.* at 138 (comparing Wavy Baby to Bad Spaniels and finding that “MSCHF’s design evoked myriad elements of the Old Skool trademarks and trade dress.”).

<sup>122</sup> TMEP § 1207.01(a)(i) (May 2024).

**THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION**

advertisements showing that the goods are advertised together is sufficient proof that the goods are related.<sup>123</sup>

The concept of relatedness of goods is discussed in *Mar Vista Entertainment, LLC v. THQ Nordic AB*,<sup>124</sup> where THQ Nordic AB (“THQ”), a Swedish videogame publisher known for its 3D survival horror game franchise “Alone in the Dark,” counterclaimed against Mar Vista Entertainment (“Mar Vista”) for infringing on its trademark by releasing a horror film titled “Alone in the Dark.”<sup>125</sup> The opinion explained that “[i]n the entertainment industry, it is common practice for movies to be based on popular video games,” and THQ had in fact licensed the rights for two “Alone in the Dark” horror films, one of which was loosely based on the plot of the video game.<sup>126</sup> Responding to Mar Vista’s First Amendment defense, the court found that the *Rogers* test did not apply because THQ sufficiently alleged in its first amended counterclaim that Mar Vista intended to mislead consumers to believe that the film was based on the “Alone in the Dark” video games or created by the same source.<sup>127</sup>

Assessing *Mar Vista* under the third factor, the entertainment industry’s custom of creating films based on video game plots—as well as THQ’s previous licenses to create films based on its video game—would be sufficient to show that the goods are related. Therefore, whether the alleged infringer’s good or work is conceivably related to the plaintiff’s goods so as to put the parties in competition with each other serves as an indication of intent.

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<sup>123</sup> See TMEP § 1207.01(a)(vi) (May 2024) (giving examples of evidence showing relatedness of goods).

<sup>124</sup> No. 23-06924, 2024 U.S. Dist. LEXIS 119473 (C.D. Cal. July 8, 2024).

<sup>125</sup> See *id.* at \*2–3 (providing the facts of the case).

<sup>126</sup> *Id.* at \*3.

<sup>127</sup> See *id.* at \*6–8 (identifying paragraphs in the first amended counterclaim that showed Mar Vista used the mark as a source identifier).

**THE *JACK DANIEL'S* HANGOVER: DEFINING “TRADEMARK USE” & THE FUTURE OF THE *ROGERS* TEST IN LIGHT OF THE SUPREME COURT’S DECISION**

*c. Apply the Second Prong of the Rogers Test*

If the court determines that the alleged infringer intended to use the mark as an indication of source under the *Jack Daniel's* inquiry, then the First Amendment inquiry ends and the court should evaluate the claim under the likelihood of confusion standard. However, if the court finds that the alleged infringer did not intend to use the mark as a trademark, then the court should proceed to the second prong of *Rogers* to determine whether the defendant’s use of the mark was explicitly misleading as to the source of the work.

**V. CONCLUSION**

While the *Rogers* court correctly found that First Amendment rights should be insulated from trademark infringement claims, the Supreme Court appropriately limited the reach of *Rogers* in *Jack Daniel's*. That said, lawyers and lower courts alike have wrestled with how and when the *Jack Daniel's* inquiry should apply. This Note’s proposed methodology for evaluating the *Jack Daniel's* inquiry enables courts to navigate the interplay between trademarks and the First Amendment by grounding the original *Rogers* court concerns within the context of trademark law. Just as Frank Sinatra and Jack Daniel’s proved to be an iconic pair, as demonstrated by this Note’s proposed framework, the First Amendment and the Lanham Act can complement each other when balanced in a fair and viable test.