GIBSON DUNN

Supreme Court Clarifies Limits Of First Amendment Defenses To Use Of Trademarks In “Parody” Products

Client Alert | June 8, 2023

Decided June 8, 2023 ***Jack Daniel’s Properties, Inc. v. VIP Products LLC*, No. 22-148**

Today, the Supreme Court unanimously reversed a decision that effectively barred trademark infringement and dilution claims against products that imitate a plaintiff’s trademark to identify the defendant’s products. Background: VIP Products makes a humorous dog toy called “Bad Spaniels,” which is designed to look like a bottle of Jack Daniel’s whiskey. The toy is shaped like a bottle of Jack Daniel’s whiskey and is labeled with “Old No. 2 on your Tennessee Carpet” instead of Jack Daniel’s “Old No. 7 Tennessee Sour Mash Whiskey” and “100% SMELLY” instead of “40% ALC. BY VOL.” Jack Daniel’s owns trademarks in its whiskey bottle and many of the words and graphics on the label. Jack Daniel’s sued VIP Products under the Lanham Act for trademark infringement, alleging the toy was likely to cause consumer confusion, and trademark dilution, alleging the toy tarnished the marks by associating famous whiskey with dog excrement. The Ninth Circuit, relying on the test from the Second Circuit’s decision in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), held the First Amendment barred the trademark infringement claim because the toy is an “expressive work” that communicates a humorous message. The Ninth Circuit also held the dilution claim failed because the toy communicated a parodic message about Jack Daniel’s, even though VIP Products used the Bad Spaniels trademark and trade dress (the features cribbed from Jack Daniel’s) to identify the source of its own products. **Issue:** Whether an expressive use of another’s trademark is entitled to heightened First Amendment protection in trademark infringement and dilution suits, where the alleged infringer uses the mark to identify the source of its own goods or services. **Court's Holding:** No. When an alleged infringer uses a trademark to identify the source of its own goods—in other words, uses the “trademark as a trademark”—the First Amendment does not preclude infringement liability. As for trademark dilution, a parodic use of another’s mark is exempt from liability only if not used to designate source.

> *Using “a trademark as a trademark … falls within the heartland of trademark law, and does not receive special First Amendment protection.”*

Justice Kagan, writing for the Court **What It Means:**

- Today’s decision underscores that, when a mark is used to identify the source of the alleged infringer’s own goods or services, the alleged infringer is not shielded from Lanham Act liability simply because the infringer is engaging in parody or commentary. The Court explained that, for both infringement and dilution claims, the crucial question is whether the use of the trademark serves a “source-designation function”—that is, whether it is being used by the infringer to identify its own products.
- The Court emphasized that its holding was “narrow.” Despite recognizing that *Rogers* has always been limited to cases involving “non-trademark uses”—in which the mark does not identify the source of the infringer’s good or service—the Court left open whether the *Rogers* test is ever appropriate. Justice Gorsuch, in a concurrence joined by Justices Thomas and Barrett, “underscore[d] that lower

Related People

Lucas C. Townsend

Bradley J. Hamburger

Brad G. Hubbard

Shaun A. Mathur

courts should handle *Rogers* . . . with care," noting that neither its genesis nor its correctness was "entirely clear."

- The Court remanded to the Ninth Circuit to consider whether the Bad Spaniels toy is likely to cause consumer confusion. The Court said the proceedings on remand should consider only this "standard trademark analysis." In that analysis, the Court noted that the alleged infringer's intent to ridicule the trademark might remain relevant in deciding likelihood of confusion.
- Justice Sotomayor, in a concurrence joined by Justice Alito, warned against excessive reliance on consumer surveys to assess consumer confusion, which is an increasingly common method of litigating confusion in trademark cases. Relying on surveys, she wrote, risks undoing the Lanham Act's "careful balancing" of the individual benefit of a trademark against the societal benefit of free expression, by granting consumers an "effective veto over mockery" and commentary they do not understand or appreciate.

The Court's opinion is available here. Gibson Dunn's lawyers are available to assist in addressing any questions you may have regarding developments at the Supreme Court. Please feel free to contact the following practice leaders:

Appellate and Constitutional Law Practice

Thomas H. Dupree Jr. +1 202.955.8547 tdupree@gibsondunn.com	**Allyson N. Ho** +1 214.698.3233 aho@gibsondunn.com	**Julian W. Poon** +1 213.229.7758 jpoon@gibsondunn.com
Lucas C. Townsend +1 202.887.3731 ltownsend@gibsondunn.com	**Bradley J. Hamburger** +1 213.229.7658 bhamburger@gibsondunn.com	**Brad G. Hubbard** +1 214.698.3326 bhubbard@gibsondunn.com

Related Practice: Fashion, Retail and Consumer Products

Howard S. Hogan +1 202.887.3640
hhogan@gibsondunn.com

Related Practice: Intellectual Property

Kate Dominguez +1 212.351.2338 kdominguez@gibsondunn.com	**Y. Ernest Hsin** +1 415.393.8224 ehsin@gibsondunn.com	**Josh Krevitt** +1 212.351.4000 jkrevitt@gibsondunn.com
Jane M. Love, Ph.D. +1 212.351.3922 jlove@gibsondunn.com		

GIBSON DUNN

Related Capabilities

Appellate and Constitutional Law

Consumer and Retail

Intellectual Property