

on several occasions to come to fruition, now may be the perfect time to reexamine its workability in light of *Warhol*.

SCOTUS Doesn't Bite On Free Speech Argument: Parody-Evoking Trademarks Be Doggoned

by *Garrett J. Hall*

Today (6/8/23), the Supreme Court released its decision in *Jack Daniel's Properties, Inc. v. VIP Products LLC*.³⁵ Though the procedural circumstances of this particular case limit the scope of this decision's precedent, it clarifies a long-recognized struggle of lower courts in handling commercialized speech³⁶ and signals a tough, uphill battle ahead for parody brands.³⁷ While parody is often covered by the First Amendment, here the Court found that constitutional free speech protections are not triggered when the speech takes the form of a commercial indication of source; under such circumstances, infringed trademarks are still afforded

³⁵ 599 U. S. ____ (2023), available at www.supremecourt.gov/opinions/22pdf/22-148_3e04.pdf, and from which page citations will be listed.

³⁶ See Stacey L. Dogan & Mark A. Lemley, *Parody as Brand*, 47 U.C. Davis L. Rev. 473, at 491 (2013) ("But the trouble with brand parodies transcends doctrine; courts seem to struggle over their own intuitions about whether a defendant's commercial objectives undermine its speech interest in the parody.").

³⁷ See *Jack Daniel's Properties*, 599 U.S. ____, at 10, 20 ("Should the company have had to satisfy the *Rogers* threshold test before the case could proceed to the Lanham Act's likelihood-of-confusion inquiry? The parties address that issue in the broadest possible way, either attacking or defending *Rogers* in all its possible applications. Today, we choose a narrower path. Without deciding whether *Rogers* has merit in other contexts, we hold that it does not 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."); ("Today's opinion is narrow. We do not decide whether the *Rogers* test is ever appropriate, or how far the "noncommercial use" exclusion goes. On infringement, we hold only that *Rogers* does not apply when the challenged use of a mark is as a mark. On dilution, we hold only that the noncommercial exclusion does not shield parody or other commentary when its use of a mark is similarly source-identifying. It is no coincidence that both our holdings turn on whether the use of a mark is serving a source-designation function. The Lanham Act makes that fact crucial, in its effort to ensure that consumers can tell where goods come from.").

full trademark protection.³⁸ Parody brands should adjust their practices accordingly in light of this result.

VIP Products' Dog Toy Barks Up Wrong Tree

VIP Products designed and sold a dog chew toy in the shape of a Jack Daniel's bottle, including the alcohol manufacturer's classic emblematic labeling. Instead of emulating the text of a Jack Daniel's bottle, however, VIP Products poked fun at the design with dog-themed attributes—replacing “Jack Daniel's” with “Bad Spaniels,” substituting “Old No. 7 Tennessee Sour Mash Whiskey” with “The Old No. 2 On Your Tennessee Carpet,” and swapping “40% alc. by vol. (80 proof)” with “43% poo by vol.” and “100% smelly.”³⁹



Comparison between Jack Daniel's bottle (left) and VIP Products' chew toy (right).

This was hardly their first ‘spoof’ dog toy; VIP Products had an entire “Silly Squeakers toy line dedicated to such parodies.⁴⁰ “Most of the toys in the line are designed to look like—and to parody—popular beverage brands. There are, to take a sampling, Dos

³⁸ *Id.* at 2 (“We hold only that [a *Rogers*-test First Amendment inquiry] is not appropriate when the accused infringer has used a trademark to designate the source of its own goods—in other words, has used a trademark as a trademark. That kind of use falls within the heartland of trademark law, and does not receive special First Amendment protection. The dilution issue is more simply addressed. The use of a mark does not count as noncommercial just because it parodies, or otherwise comments on, another’s products.”).

³⁹ *Id.* at 7.

⁴⁰ *Id.* at 6.

Perros (cf. Dos Equis), Smella Arpaw (cf. Stella Artois), and Doggie Walker (cf. Johnnie Walker).”⁴¹

Jack Daniel’s disapproved of the use of their mark and trade dress as stylized in the Bad Spaniels parody, sending VIP Products a letter demanding that VIP stop selling toys with such designs and beginning the course of events that would eventually land this case at the Supreme Court.⁴² The Supreme Court’s tasks in this case: to determine if, in a trademark infringement action such as this, a court should first conduct a First Amendment *Rogers* inquiry; and to decide whether this use could constitute a “noncommercial use” under a dilution by tarnishment analysis.⁴³

To resolve the latter, the Court walked back the Ninth Circuit’s assessment that any conveyance of a humorous message is to be necessarily regarded as a “noncommercial use,” instead determining that Bad Spaniels would not be granted protection under the noncommercial use exception on this basis.⁴⁴

To answer the former, the Court looked deeper into the interplay between trademarks, parody, and the First Amendment.

Another Dog Product Case Clarifies When *Rogers* Applies

The First Amendment has clear protections for wholly non-commercial speech, but such speech was not at issue here. Instead, the Court had to examine how VIP’s use of Bad Spaniels as a trademark would limit implication of the First Amendment in a trademark infringement context.

In its discussion on this matter, the Supreme Court notes that another trademark case—involving yet another defendant who sold a dog product—bore “a

⁴¹ *Id.*

⁴² *Id.* at 8–10.

⁴³ *Id.* at 10, 19.

⁴⁴ *Id.* at 19.

striking resemblance to this one.”⁴⁵ There, in *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, the defendant marketed “a line of pet perfumes whose names parody elegant brands sold for human consumption.”⁴⁶ Tommy Hilfiger did not appreciate the defendant’s product “Timmy Holedigger,” and sought trademark redress for this use.⁴⁷

The court in *Hilfiger* did not apply *Rogers*. There, the court reasoned that “*Rogers* . . . kicks in when a suit involves solely ‘nontrademark uses of [a] mark—that is, where the trademark is not being used to indicate the source or origin’ of a product, but only to convey a different kind of message.”⁴⁸ Because the Timmy Holedigger mark also functioned “at least in part” to indicate the source of the perfume, the defendant’s use failed to implicate *Rogers*.⁴⁹

Every dog has its day, and VIP Products’ Bad Spaniels received similar treatment to its dog perfume counterpart. Just because VIP portrays a humorous message in their toy designs does not entitle it to *Rogers*’ protection.⁵⁰ Instead, VIP also used the Bad Spaniels message for other purposes, namely, as a trademark (and VIP, perplexingly, admitted as such in its court pleadings).⁵¹ Because the parody trademark still serves a

⁴⁵ *Id.* at 13; see also *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007).

⁴⁶ *Id.*

⁴⁷ *Id.*

⁴⁸ *Jack Daniel’s Properties*, 599 U.S. ____ at 13 (quoting *Hilfiger*, 221 F. Supp. 2d, at 414.)

⁴⁹ *Hilfiger*, 221 F. Supp. 2d, at 414–415.

⁵⁰ *Jack Daniel’s Properties*, 599 U.S. ____ at 15.

⁵¹ *Id.* at 17 (“Here, the District Court correctly held that ‘VIP uses its Bad Spaniels trademark and trade dress as source identifiers of its dog toy.’ In fact, VIP conceded that point below. In its complaint, VIP alleged that it both ‘own[s]’ and ‘use[s]’ the ‘Bad Spaniels’ trademark and trade dress for its durable rubber squeaky novelty dog toy.’ The company thus represented in this very suit that the mark and dress, although not registered, are used to ‘identify and distinguish [VIP’s] goods’ and to ‘indicate [their] source.’”). Indeed, the scope of this Supreme Court decision could have been a lot less narrow without this concession; hampered by a parodic trademark user that admitted to also using the parody in a trademark way, the Court was forced to rule in this narrow manner, which

trademark function “at least in part,” a traditional likelihood-of-confusion analysis is appropriate. The Court further rationalized that such a determination would not be damning to a parody trademark use since a likelihood-of-confusion analysis would have to take into account to what extent the use of parody diminishes the risk of confusion among consumers.⁵²

Unanswered Questions For Parody Brands

But to be effective in its purpose, doesn't a parody need to closely resemble the use it is parodying? Wouldn't a parodic use otherwise fail to be successfully humorous or critical? A Jack Daniel's parody that looks nothing like Jack Daniel's insignia would hardly be a parody at all. In what circumstances could a parody mark also serve a trademark purpose, be a viable parody, and not cause a likelihood of confusion among consumers? How should parody brands respond to this decision?

VIP did place a disclaimer on its Bad Spaniels chew toy, which informed customers that the “product is not affiliated with Jack Daniel Distillery.”⁵³ The Court, understandably focused on the narrow issue of *Rogers'* applicability, did not mention how this disclaimer would affect the calculus. Could a proper disclaimer alleviate likelihood-of-confusion concerns? Does it depend on the sophistication of the purchasing audience? Could it likewise depend on the size, flair, and placement of the disclaimer? What other steps should a company that sells parodic uses of trademarks take to dispel concerns of confusion?

Perhaps we will receive some guidance regarding these unanswered questions on remand. Regardless, the commercial viability of parody marks takes a hit after this decision. If nothing else, those who parody other

has less implications to (and, subsequently, gives less answers regarding) trademark law in general.

⁵² *Id.* at 16–17.

⁵³ *Id.* at 7.

brands in their trademarks must tread lightly in response to *Jack Daniel's Properties v. VIP Products*.

The Bigger Picture

Lastly, let's take a step back to assess if *Jack Daniel's Properties* is a step in the right direction from a trademark policy standpoint. There's no doubt that parody brands have some intrinsic value: there's a reason a dog owner might buy the Bad Spaniels bottle toy over a plain bottle toy. But is the novelty of parody brands derived exclusively from appropriating the goodwill of more popular brands, or do these parody users add something of extra value through their humorous messages?⁵⁴ If the latter, is this an interest we believe is worth protecting? Should that interest, if any, be curtailed in correspondence with the parodied brand's trademark rights, or should the parodied brand not be contemplated in such analysis, given that the overarching objective of trademark law is not for monopolization of marks on the part of the mark holder but rather for consumer protection purposes?⁵⁵

To the extent that *Jack Daniel's Properties* limits the viability of brand parodies and gives trademark owners carte blanche to silence those who poke fun of its

⁵⁴ See Dogan & Lemley, *supra* n.13, at 492 (“[T]here’s a strong argument that, at least in the trademark context, incorporating a parody into a brand serves expressive goals that could not be realized through ordinary, non-branding speech. Many — perhaps most — branding parodies have a doubly subversive message. They are using a brand not only to lampoon the targeted brand, but also to call attention to the pervasiveness of branding in our society. Parodies, in general, replicate the central features of a particular work to “reference and ridicule” the work. Brand parodies do more: they not only borrow from the trademark itself, but they also appropriate the device of branding and employ it to make us think critically about the role of brands in our culture. The dog chew toy in *Louis Vuitton*, for example, ‘pokes fun at the elegance and expensiveness of a LOUIS VUITTON handbag’ but also ‘irreverently presents haute couture as an object for casual canine destruction.’”).

⁵⁵ See Dogan & Lemley, *supra* n.13, at 492 (“Trademark holders, of course, would prefer not to face this kind of ridicule of their brands or their branding practices. But trademark law does not exist to suit the needs of trademark holders; it aims to promote broader social objectives.”).

trademark in a way that trademarks are intended to function, this decision is a step back. To the extent that *Jack Daniel's Properties* instills within those who wish to parody brands the creativity necessary to continue to critique not only a brand's image but also its commercial reach – and to do so within the bounds of this decision (i.e.—avoid causing a likelihood of confusion) – this decision could compel flexible, new, and original parodic uses in the marketplace.⁵⁶

Again, as mentioned above, it is too early to know the precise practical reach of this decision given its procedural and factual limitations. But it is helpful in such circumstances to fear the worst and project the widest scope, and, in so doing, I arrive at the following assertion: While the Court was right to consider that critical speech in a trademark context need not, as a threshold matter, be as expansively protected as critical and parodic speech in other contexts, its decision in *Jack Daniel's Properties* ultimately comes down too rigidly on such parodic voices and obtrusively curtails an entire medium through which effective critique and corporate criticism could otherwise be conveyed.

⁵⁶ For example, trademarks used in a trademark way could be argued as noncommercial if under the guise of an art exhibition or in some other similar forum in which *Rogers* is more likely to take hold. What comes to mind is the 2014 use of “Dumb Starbucks” to parody commercial coffee giant Starbucks. See, e.g., Deborah J. Kemp, Lynn M. Forsythe & Ida M. Jones, *Parody In Trademark Law: Dumb Starbucks Makes Trademark Law Look Dumb*, 14 J. Marshall Rev. Intell. Prop. L. 143 (2015). Emily Greenhouse, *Dumb Starbucks and the Art of the Hoax*, *The New Yorker* (Feb. 14, 2014), www.newyorker.com/tech/annals-of-technology/dumb-starbucks-and-the-art-of-the-hoax.