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The Jack Daniel's Dialogues

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The Jack Daniel's Dialogues

Cover Page Footnote

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The Jack Daniel’s Dialogues

Michael Grynberg*

Jack Daniel’s Properties, Inc. v. VIP Products LLC threatened to upend the balance between trademark rights and expressive freedom. While not going as far as it might have, the opinion limits the ability of defendants to resist trademark claims that target artistic or noncommercial speech.

As important as this result is, we should not overlook a fundamental preliminary question. How could a dog chew toy that mocks Jack Daniel’s whiskey be the basis of a viable trademark infringement claim? Answering that question requires discussing deep issues within modern trademark law.

These antecedent questions were not directly before the Court, but they nonetheless bubbled up during the Jack Daniel’s oral argument, giving the Justices the opportunity to think out loud about them. Their questions thus provide a window not only on their views about this case but about trademark law in general.

Read in conjunction with the final opinion, however, the argument highlights the challenges generalist judges face in ensuring that trademark law serves the interests of consumers and citizens rather than brands and corporations. The oral argument thus tells us a lot about problems in trademark doctrine and foreshadows why the ultimate Jack Daniel’s opinion was unable to resolve them.

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INTRODUCTION

*Jack Daniel’s Properties, Inc. v. VIP Products LLC*¹ threatened to rewrite the rules governing the interplay between trademark rights and expressive freedom. While not going as far as it might have, the final opinion limits the ability of defendants to resist trademark

¹ Jack Daniel’s Props., Inc. v. VIP Prods. LLC, 599 U.S. 140 (2023).

claims on the grounds that their activities constitute artistic or non-commercial speech.

As important as this result is, we should not overlook a fundamental preliminary question. How could a dog chew toy that mocks Jack Daniel's whiskey be the basis of a viable trademark infringement claim in the first place? Answering that question requires discussing deep issues within trademark law as it has developed since the 1946 passage of the Lanham Act.²

These antecedent questions were not directly before the Court, but they nonetheless bubbled up during the *Jack Daniel's* oral argument, giving the Justices the opportunity to think out loud about them.³ Their questions thus provide a further window to the Justices' views about this case and trademark law in general. More importantly the argument together with the final opinion highlight the challenges generalist judges face in ensuring that trademark law serves the interests of consumers and citizens rather than brands and corporations.

Part I provides a brief overview of the case and the *Rogers* test central to the litigation. Part II explores the fundamental trademark issues raised at oral argument and addressed, or not, in the ultimate opinion of the Court.

I. BACKGROUND

This part provides an overview of the *Jack Daniel's* litigation and its resolution by the Court.

A. *Dog Toys and Their Discontents*

VIP Products ("VIP") makes dog chew toys under the SILLY SQUEAKERS label.⁴ The toys evoke the brand names of some well-known drinks, including "Blue Cats Trippin," "Mountain Drool,"

² 15 U.S.C. § 1051.

³ See *infra* Part II.

⁴ *Jack Daniel's Props.*, 599 U.S. at 148.

and “Heinie Sniff’n.”⁵ These monuments to subtlety typically include a graphic of an animal that has no counterpart in the referenced trademark.⁶

The catalog includes “Bad Spaniels,” pictured below.⁷



Figure 1: A Jack Daniel’s bottle next to a Bad Spaniel’s toy.

The toy replaces “Tennessee Whiskey” with “Tennessee Carpet” and bears labels saying “40% poo by volume,” rather than reporting alcohol levels, and “100% smelly.”⁸ The accompanying hangtag disclaims any affiliation with Jack Daniel’s.⁹

Unamused, Jack Daniel’s told VIP to stop selling the toy.¹⁰ In response, the toymaker sought declaratory judgment that Bad Spaniels neither infringed nor diluted the whiskey maker’s marks.¹¹ In preliminary rulings, the district court found that the Jack Daniel’s

⁵ As of this writing, the referenced products are available on the SILLY SQUEAKERS Amazon store. See *Silly Squeakers, Beer & Soda Bottles*, AMAZON, https://www.amazon.com/stores/page/C64D287E-5F4D-41D5-BADB-8EBEB7ADADC3?ingress=0&visitId=6456e7e2-a4d2-45a4-b700-77ac446bd769&ref_=ast_bln [<https://perma.cc/EWE7-YZ5K>] (last visited Jan. 29, 2024).

⁶ See *id.*

⁷ Brief for Petitioner at 3, *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023) (No. 22-148) [hereinafter Brief for Petitioner].

⁸ *Id.*; *Jack Daniel’s Props.*, 599 U.S. at 150.

⁹ *Jack Daniel’s Props.*, 599 U.S. at 150.

¹⁰ *Id.*

¹¹ *VIP Prods., LLC v. Jack Daniel’s Props., Inc.*, 291 F. Supp. 3d 891, 899 (D. Ariz. 2018).

trade dress is both distinctive¹² and not functional.¹³ More importantly, the court ruled that the toy was not an expressive work;¹⁴ it therefore did not receive protection under the test of *Rogers v. Grimaldi*.¹⁵

B. *Rogers and the Problem of Free Speech in Trademark Law*

Rogers was the central issue in *Jack Daniel's*. The *Rogers* test was—and perhaps remains—the leading doctrinal vehicle for balancing trademark infringement claims against the First Amendment rights of purported infringers when they engage in “expressive” or “artistic” uses of a trademark.¹⁶ Ordinarily, there is no need to bring the First Amendment into trademark infringement disputes. If I am in the soda business, for example, I have no free speech interest in naming my soda COCA-COLA or something very similar to it. If I insist, most would see the inevitable Coca-Cola infringement suit against me as preventing a form of fraud, which can generally be policed without fear of a First Amendment challenge.¹⁷

Things are different, however, if I am not using COCA-COLA to brand the source of my soda, but rather using the trademark for other purposes. Maybe I want to engage in comparative advertising (“EAGLE soda has less sugar than COCA-COLA”), commentary (“COCA-COLA is rotting our children’s teeth!”), or perhaps I want

¹² VIP Prods., LLC v. Jack Daniel’s Prods., Inc., No. CV-14-2057-PHX, 2016 WL 5408313, at *8 (D. Ariz. Sept. 27, 2016).

¹³ *Id.* at *8–10. The court also ruled that the toy was not protected by the Ninth Circuit’s nominative fair use doctrine. *Id.* at *5.

¹⁴ *Id.* at *5 (“The Court finds that VIP’s dog toy is not entitled to protection under the First Amendment because it is not an expressive work.”).

¹⁵ *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

¹⁶ See 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:144.50 (5th ed. 2023).

¹⁷ See *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (“Limited to this core purpose—avoiding confusion in the marketplace—a trademark owner’s property rights play well with the First Amendment. ‘Whatever first amendment rights you may have in calling the brew you make in your bathtub “Pepsi” are easily outweighed by the buyer’s interest in not being fooled into buying it.’” (quoting Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 973 (1993))). *Jack Daniel’s* approvingly cites this passage. *Jack Daniel’s Prods., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 159 (2023). On fraud and the First Amendment, see, e.g., *United States v. Alvarez*, 567 U.S. 709, 723 (2012) (“Where false claims are made to effect a fraud . . . it is well established that the Government may restrict speech without affronting the First Amendment.”).

to use the term as a component in a larger expressive work, say by writing a song with Coca-Cola in the lyrics.¹⁸

The *Rogers* test is most closely associated with the last category. The test comes from Second Circuit litigation involving a Fellini film titled “Ginger and Fred,” whose plot referenced the famous dance pair Ginger Rogers and Fred Astaire.¹⁹ The real-life Rogers sued under the Lanham Act, claiming that the film created the misperception that she endorsed or was somehow connected to it.²⁰

The Second Circuit concluded that Lanham Act claims concerning artistic works threatened to bring First Amendment interests and trademark law into conflict.²¹ Because both artists and their audiences have free expression interests,²² the court concluded that the Lanham Act “should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”²³ With respect to “allegedly misleading” titles like *Fred and Ginger*, “that balance will normally not support application of the Act unless [1] the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless [2] the title explicitly misleads as to the source or the content of the work.”²⁴

Over time, courts applied *Rogers* outside the context of titles,²⁵ reflecting the extent to which trademark holders have attempted to

¹⁸ See, e.g., *THE KINKS, Lola, on LOLA VERSUS POWERMAN AND THE MONEYGOROUND, PART ONE* (Pye 1970) (referencing a club where the champagne “tastes just like Coca-Cola”).

¹⁹ *Rogers*, 875 F.2d at 996–97.

²⁰ *Id.* at 997. Rogers also raised a claim under her right of publicity. *Id.*

²¹ *Id.* at 998 (“Consumers of artistic works thus have a dual interest: They have an interest in not being misled and they also have an interest in enjoying the results of the author’s freedom of expression. For all these reasons, the expressive element of titles requires more protection than the labeling of ordinary commercial products.”).

²² *Id.* (“Furthermore, their interest in freedom of artistic expression is shared by their audience. The subtleties of a title can enrich a reader’s or a viewer’s understanding of a work.”).

²³ *Id.* at 999.

²⁴ *Id.* Applying its test to Rogers’s Lanham Act claim, the court granted summary judgment to the defendants. *Id.* at 1001–02.

²⁵ See, e.g., *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1277 (11th Cir. 2012).

police mere references to their marks in the *content* of expressive uses.²⁶ The *Rogers* framework has been adopted in most of the country, including the Ninth Circuit.²⁷ As Rebecca Tushnet notes, *Rogers* is part of a larger, less coherent framework that determines when noncommercial trademark speech may be regulated by Lanham Act causes of action.²⁸

C. Chew Toys at the Supreme Court

Back to the history of *Jack Daniel's*. Because the district court initially ruled *Rogers* inapplicable, the case was tried under the multifactor likelihood-of-confusion test that applies in “ordinary”

²⁶ See *infra* notes 50–56 and accompanying text.

²⁷ See *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 901–02 (9th Cir. 2002).

²⁸ See Rebecca Tushnet, *Bad Spaniels, Counterfeit Methodists, and Lying Birds: How Trademark Law Reinvented Strict Scrutiny* 9–10, 45 (Mar. 13, 2023) (unpublished manuscript) (available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4387772 [<https://perma.cc/3D4Y-QLTF>]). In discussing this regulation of noncommercial trademark speech, Tushnet writes:

[O]ne basic question—does trademark law cover noncommercial speech, defined as it is in First Amendment doctrine as speech that does more than merely propose a commercial transaction—has three different answers, all regularly used in any given jurisdiction. The answers are yes, no, and sometimes, a list both comprehensive and dismaying. And now, with *Bad Spaniels*, the Supreme Court is hearing a case that raises this question. If the Court does not address it head-on, the case law is likely to get even more incoherent and hand even more power to trademark owners to threaten speech about them.

Id. at 2 (footnote omitted). As she explains in chart form:

	Defendant engaged in noncommercial speech sold in the market—e.g., movies	“Gripe”/disparagement cases: commercial actor v. noncommercial speaker, including political speaker	Political actor v. political actor/religious actor cases; trademark registration for purely noncommercial endeavors
Does trademark cover noncommercial speech?	Yes, but with modified infringement test	No (modern view)	Yes, without explicit modification of infringement test

Id. at 3.

trademark infringement claims.²⁹ The district court concluded after a bench trial that VIP's product was infringing.³⁰ The court also ruled that the toy was likely to dilute (via tarnishment)³¹ the Jack Daniel's marks because it created negative associations between the whiskey and dog excrement.³²

VIP successfully appealed.³³ The Ninth Circuit reversed the dilution-by-tarnishment claim because the dilution statute excludes liability for "noncommercial" uses.³⁴ Because the dog toy had an inherently noncommercial component—making fun of Jack Daniel's—a dilution claim was unavailable.³⁵ The court also determined

²⁹ *VIP Prods., LLC v. Jack Daniel's Prods., Inc.*, 291 F. Supp. 3d 891, 905 (D. Ariz. 2018). The multifactor test considers factors like mark similarity, strength of the plaintiff's mark, the proximity of the parties' goods or services, evidence of actual confusion, and, more controversially, the defendant's good or bad faith. *See generally* MCCARTHY, *supra* note 16, §§ 24:28–43.

³⁰ *VIP Prods.*, 291 F. Supp. 3d at 911.

³¹ Dilution has two flavors. A dilution by blurring claim rests on the prospect that multiple uses of a famous mark will "blur" its distinctiveness. 15 U.S.C. § 1125(c)(2)(B). So, to use Judge Posner's example, suppose an upscale restaurant adopts the TIFFANY mark. Though the use would not cause confusion with the famous jeweler, when consumers next see the name 'Tiffany' they may think about both the restaurant and the jewelry store, and if so the efficacy of the name as an identifier of the store will be diminished. Consumers will have to think harder—incur as it were a higher imagination cost—to recognize the name as the name of the store.

Ty Inc. v. Perryman, 306 F.3d 509, 511 (7th Cir. 2002).

As for dilution by tarnishment, it occurs when the unauthorized use is one that "harms the reputation of the famous mark." 15 U.S.C. § 1125(c)(2)(C). For example, staying with Judge Posner, a strip club that adopts the name TIFFANY would create unsavory associations with the mark that would harm the jeweler. *Ty Inc.*, 306 F.3d at 511.

³² In this case, the unsavory associations stemmed both from VIP's evocation of poop, *VIP Prods.*, 291 F. Supp. 3d at 904–05 ("human consumption and canine excrement do not mix"), and the prospect that children would associate dog toys with whiskey. *Id.* at 905 ("Jack Daniel's is in the whiskey business and its reputation will be harmed due to the negative mental association of evoking whiskey with children, something Jack Daniel's has never done.").

³³ *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170, 1176 (9th Cir. 2020).

³⁴ *Id.*; *see also* 15 U.S.C. § 1125(c)(3)(C).

³⁵ *VIP Prods.*, 953 F.3d at 1176 ("Speech is noncommercial if it does more than propose a commercial transaction and contains some protected expression. Thus, use of a mark may be 'noncommercial' even if used to 'sell' a product. Although VIP used [Jack Daniel's] trade dress and bottle design to sell Bad Spaniels, they were also used to convey a humorous message. That message . . . is protected by the First Amendment." (citations omitted)).

that the district court erred by not applying the *Rogers* test to the infringement claims because of the chew toy's expressive aspect.³⁶

On remand, the district court dutifully conducted the *Rogers* analysis under which Jack Daniel's infringement claim became an easy win for VIP.³⁷ On the first prong, the toy "imitates, yet alters, [the Jack Daniel's] trade dress to make a joke about a dog defecating on the carpet"—accordingly, the trade dress "is relevant, if not central, to VIP's message."³⁸ As for the second prong, VIP did not explicitly mislead consumers about a connection between its goods and Jack Daniel's whiskey.³⁹ The infringement claim therefore failed.

The district judge found the outcome depressing, lamenting that a trademark holder victory under *Rogers* is "nearly impossible," contending the test "excuses nearly any use less than slapping another's trademark on your own work and calling it your own."⁴⁰ Accordingly, however distasteful the poop association, the company had no recourse save for a trip to Congress or the Supreme Court.⁴¹

That was the plan. After summary affirmance by the Ninth Circuit on the whiskey maker's motion,⁴² Jack Daniel's filed a cert petition on the following questions: "1. Whether humorous use of another's trademark as one's own on a commercial product is subject to the Lanham Act's traditional likelihood-of-confusion analysis, or instead receives heightened First Amendment protection from trademark-infringement claims" and "2. Whether humorous use of another's mark as one's own on a commercial product is

³⁶ *Id.* at 1175 ("[T]he Bad Spaniels dog toy, although surely not the equivalent of the *Mona Lisa*, is an expressive work.").

³⁷ *VIP Prods. LLC v. Jack Daniel's Props. Inc.*, No. CV-14-02057-PHX, 2021 WL 5710730, at *6 (D. Ariz. Oct. 8, 2021).

³⁸ *Id.* at *4.

³⁹ *Id.* at *6.

⁴⁰ *Id.*

⁴¹ *Id.* ("[W]hile [Jack Daniel's Properties, Inc. ("JDPI")] finds the depiction of a dog relishing a bowel movement on a carpet distasteful and an abuse of its mark, in the final analysis, JDPI has no means to protect the viability of its trademark. Yet, the Court is bound by Ninth Circuit precedent. For JDPI or similarly situated trademark holders to obtain a different outcome, they must seek relief before the United States Supreme Court or the United States Congress.>").

⁴² *VIP Prods. LLC v. Jack Daniel's Props., Inc.*, No. 21-16969, 2022 WL 1654040, at *1 (9th Cir. Mar. 18, 2022).

‘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.”⁴³

The Supreme Court granted the petition.⁴⁴ Its ultimate unanimous opinion rejected both of the Ninth Circuit’s conclusions.⁴⁵ First, the opinion reserved the general question of the viability of the *Rogers* test, but held that it cannot apply when the defendant is using the plaintiff’s trademark “as a mark.”⁴⁶ Second, whatever the general meaning of “noncommercial use” as a statutory exclusion to a dilution action, it could not encompass a defendant’s parodic use of a plaintiff’s mark as a mark.⁴⁷

II. THE ORAL ARGUMENT

The *Jack Daniel’s* litigation raises many fundamental trademark issues, but only a subset were covered by the cert grant and the Court’s ultimate opinion. The preceding oral argument is notable because the Justices found themselves addressing—sometimes explicitly, sometimes not—some of these deeper questions.⁴⁸

A. *Why This Case? Jack Daniel’s and the Problem of Trademark Merchandising*

Until *Jack Daniel’s*, the *Rogers* test was remarkably successful in the lower courts; although courts sometimes found it unnecessary

⁴³ Petition for Writ of Certiorari, *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023) (No. 22-148).

⁴⁴ See generally *Jack Daniel’s Props.*, 599 U.S. at 140.

⁴⁵ *Id.* at 163.

⁴⁶ *Id.*; see also *id.* at 153 (“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.”). The Court noted, however, that VIP could raise other challenges to the District Court’s initial ruling on remand. *Id.* at 161 (“So although VIP’s effort to ridicule Jack Daniel’s does not justify use of the *Rogers* test, it may make a difference in the standard trademark analysis. Consistent with our ordinary practice, we remand that issue to the courts below.”).

⁴⁷ *Id.* at 163 (“[W]e hold only that the noncommercial exclusion does not shield parody or other commentary when its use of a mark is similarly source-identifying.”).

⁴⁸ See generally Transcript of Oral Argument, *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023) (No. 22-148) [hereinafter Transcript].

to decide its applicability,⁴⁹ no circuit court rejected it outright.⁵⁰ Courts applied the test to protect works like movie titles,⁵¹ paintings,⁵² songs,⁵³ video games,⁵⁴ and television shows.⁵⁵ Indeed, several of these cases were explicitly distinguished in Justice Kagan's opinion for the Court.⁵⁶

What made the chew toy different? Why did the Supreme Court decide after more than thirty years that now was the time to evaluate *Rogers* despite the absence of a circuit split? The answer lies in part in precedents that treat trademarks not as source identifiers, but as goods unto themselves.

1. Summoning the Merchandising Right

Fundamentally, *Jack Daniel's* is a merchandising case. Trademark law has long struggled to accommodate trademark merchandising—the use of a trademark not as an indicator of source (e.g., the BOSTON RED SOX mark as identifying a particular team in the American League of Major League Baseball), but rather as the

⁴⁹ See, e.g., *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008).

⁵⁰ In canvassing *Rogers's* reception in the lower courts, Professor McCarthy's examples of rejection of the test are exclusively district court cases. MCCARTHY, *supra* note 16, § 31:144.50. (“The Second Circuit’s *Rogers* balancing test has been used by almost all courts.”) It is also worth noting that, notwithstanding the fears of the *Jack Daniel's* district court, see *supra* note 40 and accompanying text, the adoption of *Rogers* does not mean automatic defendant victories. See generally *Gordon v. Drape Creative, Inc.*, 909 F.3d 257 (9th Cir. 2018); *Parks v. LaFace Recs.*, 329 F.3d 437 (6th Cir. 2003); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000).

⁵¹ In the case giving rise to the framework, see *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

⁵² See *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012) (regarding paintings of famous moments in Alabama football history).

⁵³ See *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (regarding the song “Barbie Girl”).

⁵⁴ See *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099–1100 (9th Cir. 2008) (regarding a video game depiction of a Los Angeles adult entertainment establishment).

⁵⁵ See *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1197 (9th Cir. 2017) (regarding a television show that featured a fictional record label with the same name as a real one).

⁵⁶ See *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 154 (2023) (referencing *Rogers*, 875 F.2d at 998–1000, *New Life*, 683 F.3d at 1279, and *Mattel*, 296 F.3d at 900–02).

object of purchase (e.g., a baseball cap with the trademarked BOSTON RED SOX “B”).⁵⁷

Judges have a strong intuition that popular brands should be able to control merchandising markets, and they are willing to enlist trademark law to the task.⁵⁸ Unfortunately, the effort distorts trademark doctrine.⁵⁹ In their classic application, trademarks exist to vindicate societal interests in competition and information transmission.⁶⁰ The merchandising right is not about that. It exists to police markets in which the marks have nothing to do with identifying and distinguishing goods or services or protecting consumers.⁶¹

But if trademark holders can control markets for popular logos, then they can charge monopoly rents for what should be cheap commodities. Courts don’t care. Most judges, like most people, have a strong intuition that merchandising markets belong to trademark holders and they will adjust the borders of trademark doctrine as necessary to encompass merchandising.⁶² But the contortions necessary to reach this result have second-order consequences that ripple throughout the trademark system, destabilizing doctrine in ways that often escape the notice of the judges doing the contorting.⁶³

One of these incongruities involves free expression. As noted above, the traditional story of the First Amendment and trademark

⁵⁷ *Bos. Pro. Hockey Ass’n v. Dall. Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1004–05 (5th Cir. 1975). This tendency has been the subject of heavy academic criticism. See Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 463 (2005); Michael Grynberg, *Living with the Merchandising Right (Or How I Learned to Stop Worrying and Love Free-Riding Stories)*, 25 YALE J.L. & TECH. 1, 4 n.2 (2023) [hereinafter *Living with the Merchandising Right*] (collecting examples).

⁵⁸ See *Living with the Merchandising Right*, *supra* note 57, at 16–26, 31–32 (discussing the morality of merchandising).

⁵⁹ See generally *id.* at 32–68 (discussing this point in much greater detail).

⁶⁰ See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995) (“In principle, trademark law, by preventing others from copying a source-identifying mark, ‘reduces the customer’s costs of shopping and making purchasing decisions’” (citations omitted)).

⁶¹ See *Bos. Pro. Hockey Ass’n*, 510 F.2d at 1011 (acknowledging that protection in the merchandising setting “may slightly tilt the trademark laws from the purpose of protecting the public to the protection of the business interests of plaintiffs . . .”).

⁶² See *Living with the Merchandising Right*, *supra* note 57, at 16–26.

⁶³ *Id.* at 32–68.

law is that there is no conflict between the two.⁶⁴ Insofar as trademark law is rooted in the prevention of consumer deception, it polices speech that has no First Amendment protection in the first place.⁶⁵ But First Amendment considerations began to loom larger as trademark law expanded beyond confusion at the point of sale to more nebulous conceptions of affiliation and association.⁶⁶ These concerns prompted the need for doctrines like *Rogers*, which rests on the twin notions that “expressive” or “artistic”⁶⁷ works deserve protection from overreaching trademark claims *and* that such works are inherently less likely to create meaningful confusion among consumers.⁶⁸

But how do those claims interact with merchandising rights? Most prior applications of *Rogers* concerned situations that a layperson would naturally see as outside the trademark realm. For example, the song *Barbie Girl*,⁶⁹ paintings of Alabama football,⁷⁰ a Fellini film,⁷¹ and the like, are “obviously” artistic works. The prospect that trademark law could be used to censor them raises First Amendment issues that are apparent to the courts, as they were to the Justices in the *Jack Daniel's* oral argument as discussed below.⁷²

⁶⁴ See *supra* notes 16–18 and accompanying text.

⁶⁵ See *supra* note 17 and accompanying text.

⁶⁶ See J. Thomas McCarthy, *Lanham Act § 43(a): The Sleeping Giant Is Now Wide Awake*, 59 L. & CONTEMP. PROBS. 45, 58 (1996) (discussing trademark law’s expansion); see also Kozinski, *supra* note 17, at 973 (“But once you get past the confusion rationale—as I think we should—trademark law loses this built-in first amendment compass.”).

⁶⁷ I use these terms advisedly to reflect standard ways of discussing the issue even though the usage may not withstand examination as anything other than a descriptor of case outcomes. See, e.g., Tushnet, *supra* note 28, at 17 (describing the dynamic whereby expressive works are so described “only when the court thinks the communication is worthy”). On the ultimate incoherence of the expressive/non-expressive distinction, see *id.* at 4 (describing as “patently insufficient reasoning” the claim “that there is a difference between use that is ‘expressive’ and use that is ‘source-identifying’: identifying a source *is* expressive.” (emphasis added)); *id.* at 39–40 (“Explicit deceptiveness might justify an inference of materiality, but artistic relevance is useless in sorting the value of noncommercial speech and should be discarded.”).

⁶⁸ See *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989) (“But most consumers are well aware that they cannot judge a book solely by its title any more than by its cover.”).

⁶⁹ See *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 899 (9th Cir. 2002).

⁷⁰ See *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1269 (11th Cir. 2012).

⁷¹ See *Rogers*, 875 F.2d at 996.

⁷² See *infra* Section II.A.5.

A baseball cap is something else. Rightly or wrongly, mere merchandise does not activate the same speech-protective impulses, because it is, well, mere merchandise.⁷³ Likewise, *Rogers*' secondary rationale—that expressive works are inherently unlikely to cause consumer confusion—is unimportant in merchandising cases.⁷⁴ These cases rest on the substantive judgment by the courts that merchandising markets belong to trademark holders and should be enjoyed without the interference of free-riding interlopers.⁷⁵ Considerations of likely consumer confusion are therefore largely beside the point.

Jack Daniel's is not the first case to reflect this implicit value judgment. In *Gordon v. Drape Creative, Inc.*, the Ninth Circuit balked at a robust application of *Rogers* in a merchandising setting.⁷⁶ The trademark at issue was rooted in a viral internet video about honey badgers.⁷⁷ The creator of the video, in turn, secured a trademark registration for the video's recurring phrase, "Honey Badger Don't Care," and used the phrase on merchandise.⁷⁸ The defendant made greeting cards that essentially retold the joke with accompanying graphics of a honey badger.⁷⁹ Applying *Rogers*, the Ninth Circuit found the artistic relevance prong satisfied, but concluded that there was insufficient added creativity on the defendant's part to say as a matter of law that the cards were not "explicitly

⁷³ See *Living with the Merchandising Right*, *supra* note 57, at 36–42.

⁷⁴ See *Rogers*, 875 F.2d at 1000.

⁷⁵ See *Living with the Merchandising Right*, *supra* note 57, at 16–26.

⁷⁶ *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 261 (9th Cir. 2018).

⁷⁷ *Id.* The video reedited a documentary about honey badgers with commentary about how they are fearless ass-kickers. See czg123, *The Crazy Nastyass Honey Badger (Original Narration by Randall)*, YOUTUBE (Jan. 18, 2011), https://www.youtube.com/watch?v=4r7wHMg5Yjg&ab_channel=czg123 [https://perma.cc/GE4H-86SA].

⁷⁸ See *Living with the Merchandising Right*, *supra* note 57, at 34. The creator of the video registered the mark HONEY BADGER DON'T CARE. See HONEY BADGER DON'T CARE, Registration No. 5,059,721. He also filed for but abandoned a registration application for HONEY BADGER DON'T GIVE A SHIT. See U.S. Trademark Application Serial No. 87/280,166 (filed Dec. 23, 2016).

⁷⁹ *Gordon*, 909 F.3d at 262.

misleading,” given the similarity of uses.⁸⁰ That similarity, in turn, rested on shared use in the merchandising context.⁸¹

2. Chew Toys as “Mere” Commercial Products

The *Jack Daniel's* oral argument nodded at the importance of merchandising interests without explicitly naming them. Justice Kagan, for example, disparaged VIP's chew toy as a mere “commercial product”—not the kind of thing that normally merits First Amendment protection:

The reason why every court of appeals has—that has thought about the question has adopted something like Rogers is because there are cases which look really different from this case.

There are—you know, an art photographer does photographs using a Barbie doll,^[82] which is clearly meant to have some kind of expressive meaning and is—is not *an ordinary commercial product like this one* and doesn't use the Barbie doll as a *source identifier*.⁸³

Justice Kagan makes two distinctions in the above passage. First, she identifies what ultimately becomes the key to the Court's holding—that VIP's design is a “source identifier” (which I discuss in greater detail below).⁸⁴ Second, she dismisses the chew toy as an “ordinary commercial product.”⁸⁵

Insofar as it is a commercial product, the chew toy's appeal is tied to its evocation of a Jack Daniel's whiskey bottle. Stated another

⁸⁰ *Id.* at 270–71 (“[T]he potential for explicitly misleading usage is especially strong when the senior user and the junior user both use the mark in similar artistic expressions. . . . [In such cases,] an artist who uses a trademark to identify the source of his or her product would be at a significant disadvantage in warding off infringement by another artist, merely because the product being created by the other artist is also ‘art.’”).

⁸¹ See *Living with the Merchandising Right*, *supra* note 57, at 39–42.

⁸² Transcript, *supra* note 48, at 10. Justice Kagan's example of a Barbie doll is likely referencing *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

⁸³ Transcript, *supra* note 48, at 10 (emphasis added).

⁸⁴ See *infra* notes 95–113 and accompanying text.

⁸⁵ Transcript, *supra* note 48, at 10.

way, the product is, in large part, a merchandising reference to Jack Daniel's. In her oral argument, Lisa Blatt, the attorney for Jack Daniel's, made this connection explicit by arguing that "Jack Daniel's makes dog products and sells licensed merchandise, like hats and bar stools and what have you, in the same markets that Bad Spaniels was selling its dog toys."⁸⁶ In other words, Jack Daniel's claims the merchandising market should belong to it alone, and Justice Kagan finds this unobjectionable given the merchandise's status as a simple commercial good.

That begs the question of distinguishing First Amendment-protected works and "mere" commercial goods. The Justices may have the intuition that the former deserves protection from trademark claims while the latter does not, but there is no principled way to draw a distinction between the two classes. An "obvious" expressive work may well be a commercial product and vice versa. Blatt argued that this makes line drawing a "head-scratching" affair.⁸⁷ Bennett Cooper, VIP's counsel, agreed that there is no viable standard for distinguishing between expressive works and utilitarian goods.⁸⁸ A T-shirt, in his example, is clearly functional but may also bear messages.⁸⁹

Justice Kagan nonetheless insisted that while there may be hard cases, the chew toy did not present one.⁹⁰ While a political T-shirt "says something" and "mak[es] a point," "dog toys are just utilitarian goods."⁹¹ Not so, rejoined Cooper, arguing that if the toy were sold as a collectable,

[t]hen it would not be a utilitarian good. It would be soft sculpture in copyright terms. It would be an art

⁸⁶ *Id.* at 24.

⁸⁷ *Id.* at 11; *see also id.* at 95–96 ("You could have a political message on a dog toy. You can put a parody on a T-shirt. You can put a political message on a calendar or—one man's tchotchke is another man's paperweight. They are both decorative. And—and then anytime you mention holidays, like Christmas lights, Christmas ornaments, Christmas trees, Halloween costumes, and I mentioned dreidels, menorahs, et cetera. I don't know what that is. It sounds too expressive to me, but they're all utilitarian.").

⁸⁸ *Id.* at 82.

⁸⁹ *See id.* (noting how hats may "become political symbols").

⁹⁰ *Id.*

⁹¹ *Id.*

piece. It doesn't matter whether you use it with your dog or you put it on a shelf, as I plan to do, and laugh at it from time to time. It is still an expression.⁹²

We leave the debate here. Regardless of whether there is a coherent line to draw between the expressive and utilitarian good, the author of *Jack Daniel's* nonetheless believes there must be one.⁹³ Perhaps due to the difficulties of definition, her final opinion looks elsewhere for a way to protect the interests of Jack Daniel's, but it is illuminating to see Justice Kagan taking a strong intuitive stance on the status of mere merchandise, and—by extension—the limited expressive interests of consumers in purchasing it.⁹⁴

3. The Role of Trademark Use

The final opinion focuses not on commercial or utilitarian products, but on the concept of trademark use. *Rogers* does not apply because VIP was using the challenged design *as a mark*, that is, as a source identifier.⁹⁵ As noted above, Justice Kagan foreshadowed the move in oral argument. She saw the question of use as closely intertwined with her perception of the chew toy as a mere commercial product, pressing VIP's counsel with the claim that “dog toys are just utilitarian goods *and* you're using somebody else's mark as a source identifier, and that's not a First Amendment problem.”⁹⁶

⁹² *Id.* at 83. The line between utilitarian and aesthetic goods is at play in the ongoing litigation concerning “Wavy Baby” shoes. *See Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 602 F. Supp. 3d 358, 369 (E.D.N.Y. 2022) (“Despite Defendant's assertions the Wavy Baby shoes belong in museums and galleries for exhibition, the production of 4,306 pairs of shoes places the Wavy Baby shoes on a mobile footing vastly different from one found at the Brooklyn Museum.”). Here, too, invocations of *Rogers* have been unsuccessful. *See Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 88 F.4th 125, 138–39 (2d Cir. 2023) (affirming district court's refusal to apply *Rogers* in light of *Jack Daniel's*).

⁹³ In fairness, of course, the same issue exists with respect to separating an artistic/expressive use from an ordinary trademark use for which the *Rogers* test would not apply. *See Tushnet, supra* note 28, at 39–40; *see also supra* text accompanying note 67. Justice Kagan leans on this difficulty in her discussion of why *Rogers* cannot apply to trademark uses. *See infra* notes 259–262 and accompanying text.

⁹⁴ *Cf. Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989) (“[I]nterest in freedom of artistic expression [of creators] is shared by their audience.”).

⁹⁵ *See Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 151–53 (2023).

⁹⁶ Transcript, *supra* note 48, at 82–83 (emphasis added).

There has been interest in using the concept of use as a mark to limit overreaching trademark claims, but that is not at issue in this case.⁹⁷ By treating trademark use as a barrier to the application of *Rogers*, *Jack Daniel's* uses the concept to *expand*, not contract, trademark law's potential domain. Indeed, Blatt was careful to argue that non-source uses of trademarks may be the basis of liability.⁹⁸ And the final opinion, though paying lip service to the primacy of source-identifying uses, implicitly endorses the possibility of infringement suits based on non-trademark uses by declaring that *Rogers*, or defensive doctrines like it,⁹⁹ may only be invoked if the defendant is not engaged in a use as a mark.¹⁰⁰ That would be a null set of cases if source-identifying use were a prerequisite.

But what is a trademark use? Whatever the ultimate role of the concept after *Jack Daniel's*, the question of whether trademark-

⁹⁷ Justice Jackson seemed to be interested in the question. *See infra* Section II.C.2. The effort to utilize trademark use as a limiting doctrine comes, however, with a number of issues rooted both in statute and in the ability of trademark plaintiffs to broadly characterize conduct as source identifying. *See* Mark P. McKenna, *Trademark Use and the Problem of Source*, 2009 U. ILL. L. REV. 773, 778 (2009). There is a rich body of literature and case law on this subject that seems poised for reinvigoration, both sides of which were cited by the Court. *See Jack Daniel's Props.*, 599 U.S. at 147–48. For scholarship exploring the possibility of a trademark use requirement, *see* McKenna, *supra*; Graeme B. Dinwoodie & Mark D. Janis, *Lessons from the Trademark Use Debate*, 92 IOWA L. REV. 1703, 1704 (2007); Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 98 TRADEMARK REP. 1086, 1087 (2007) [hereinafter Dinwoodie & Janis, *Confusion Over Use*]; Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 98 TRADEMARK REP. 1345, 1345 (2007); Margreth Barrett, *Internet Trademark Suits and the Demise of "Trademark Use"*, 39 U.C. DAVIS L. REV. 371, 373 (2006); Uli Widmaier, *Use, Liability, and the Structure of Trademark Law*, 33 HOFSTRA L. REV. 603, 606 (2004).

⁹⁸ Transcript, *supra* note 48, at 14 (“But you can infringe iPhone’s marks or any mark without indicating it’s a source. You can put it on a T-shirt, you can put it in a movie, you can sell lots of products. It’s just not being used as a trademark. And the statutory definition of infringement has nothing to do with use as a source. It’s any use of a mark likely to cause confusion.”).

⁹⁹ *Jack Daniel's Props.*, 599 U.S. at 153 n.1 (“To be clear, when we refer to ‘the *Rogers* threshold test,’ we mean any threshold First Amendment filter.”).

¹⁰⁰ One of the arguments raised in the briefing and tangentially at oral argument is that courts were wrong to expand *Rogers* beyond the realm of titles. Transcript, *supra* note 48, at 40. The fact that courts felt the need to do so reflects overzealousness not on their part, but on the part of plaintiffs who brought trademark claims for uses within works of art rather than uses designed to identify or distinguish the products in the marketplace.

protected matter is being used as a source identifier is hardly clear.¹⁰¹ That said, the Court's distinction of earlier precedents in the *Rogers* line of cases suggests a common-sense view about use that might leave the *Rogers* test functionally intact when the challenged use is not as overt branding (i.e., in a location where one would normally expect to see a trademark¹⁰² or as a name of a brand or service).¹⁰³ “[Q]uintessential” trademark uses are what *Jack Daniel's* has in mind,¹⁰⁴ though existing case law may not track the Court's intuitions.¹⁰⁵

4. Merchandising Uses as Trademark Uses

It will likely take a fair amount of litigation to see how much of the pre-*Jack Daniel's* equilibrium remains intact. Merchandising uses do appear, however, to be on the wrong side of the line and will have to fight out infringement cases without the benefit of defendant-friendly shortcuts like *Rogers*.

The Court takes it as almost self-evident that VIP used its trade dress as a mark. In fairness, VIP did a lot to foster that impression, as it claimed trademark rights in the Bad Spaniels mark and, more

¹⁰¹ See McKenna, *supra* note 97, at 775.

¹⁰² See *Jack Daniel's Props.*, 599 U.S. at 154; cf. Mark P. McKenna, *Trademark Use Rides Again*, 104 IOWA L. REV. ONLINE 105, 106 (2020) (“Still, for most trademark lawyers, the idea that there’s no such thing as ‘trademark use’ always seemed wrong.”). On mark use inquiries based on the position of the trademark use, see Mark A. Lemley & Mark P. McKenna, *Trademark Spaces and Trademark Law’s Secret Step Zero*, 75 STAN. L. REV. 1, 1 (2023); Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977, 1981–82 (2019). Of course, it may well be the case that the *Rogers* opinion will ultimately be rejected based on considerations expressed in the Gorsuch concurrence. See *infra* Section II.C.2.

¹⁰³ Compare *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091, 1097 (9th Cir. 2022) (applying *Rogers* to a brand name in pre-*Jack Daniel's* litigation), *opinion withdrawn*, 78 F.4th 1158 (9th Cir. 2023), with *Punchbowl, Inc. v. AJ Press, LLC*, No. 21-55881, 2024 WL 134696, at *7 (9th Cir. Jan. 12, 2024) (ruling that *Rogers* does not apply in light of *Jack Daniel's*).

¹⁰⁴ *Jack Daniel's Props.*, 599 U.S. at 155.

¹⁰⁵ Professor McCarthy notes, for example, that the original *Rogers*, though implicitly blessed by the Court as a viable application of *Rogers*, may be on the wrong side of the trademark use line. MCCARTHY, *supra* note 16, § 31:144.20.

importantly, design.¹⁰⁶ But this likely stemmed from VIP’s desire to protect its design as merchandise, *not* as a source identifier.

Why is that? VIP was not plausibly trying to sell people on the notion that the appearance of the toy was an indicator of product quality (i.e., of its source).¹⁰⁷ Rather, the toy’s selling point was rooted in the pleasures of having a chew toy that looks like (or parodies, or evokes, or reminds one of) a bottle of Jack Daniel’s whiskey.

That is not a source-identifying use any more than the BOSTON RED SOX “B” identifies the source of a baseball cap in a classic merchandising case. The only way to call such uses “trademark uses” is if merchandising is part of trademark law. And, indeed, the USPTO uses the “secondary source” doctrine to allow marks that are used in source identifiers in certain contexts to leverage those uses into trademark registrations on merchandised goods.¹⁰⁸

This tension was latent in the *Jack Daniel’s* oral argument when VIP’s counsel tried to clarify how VIP was using the trademarks at issue. Cooper distinguished VIP’s “SILLY SQUEAKERS” mark from the term “Bad Spaniels,” the graphic of the dog, and the total design of the toy.¹⁰⁹ Only the first is a straightforward source-identifying mark.¹¹⁰ Justice Sotomayor understood the distinction and asked if “Bad Spaniels” was simply the designation of one VIP

¹⁰⁶ *Jack Daniel’s Props.*, 599 U.S. at 160 (“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.’” (citing 15 U.S.C. § 1127 (2006))).

¹⁰⁷ To be sure, a consumer of dog toys might well search “Bad Spaniels” to find VIP’s product online (as, indeed, I did), but the trademark claim was not that “Bad Spaniels,” standing alone, was an infringing term.

¹⁰⁸ *See, e.g., In re Olin Corp.*, 181 U.S.P.Q. 182 (T.T.A.B. 1973) (“[While serving as ornamentation,] the name ‘New York University’ . . . will also advise the purchaser that the university is the secondary source of that shirt Where the shirt is distributed by other than the university the university’s name on the shirt will indicate the sponsorship or authorization by the university.”); *see also* U.S. PATENT & TRADEMARK OFF., TMEP § 1202.03(c) (8th ed. 2011) (discussing “secondary source” doctrine). *But see* Pa. State Univ. v. Vintage Brand, LLC, 614 F. Supp. 3d 101, 108 (M.D. Pa. 2022) (criticizing the approach of cases like *Olin*).

¹⁰⁹ Transcript, *supra* note 48, at 73–74.

¹¹⁰ *Id.* at 74, (“We’re Silly [Squeakers]—as a designation of source on the product.”).

design among many.¹¹¹ No doubt grateful for the help, Cooper agreed. “[W]e have argued throughout the case, in the district court and in the court of appeals, that neither Bad Spaniels nor the label and the appearance on the toy are designations of source or function as a trademark.”¹¹²

The final opinion indicates that these clarifications were lost on the Court.¹¹³ Worse, it collapses VIP’s various possible permutations of “Bad Spaniels”—as a source identifying name, as a dog graphic, either or both as component parts of a toy design, and finally as a unified whole—into one bundle that it labels to be a “trademark use.”¹¹⁴ The opinion does not distinguish among the components to consider, as Cooper encouraged, *which* of those uses are trademark uses *and then* which of those uses, if any, plausibly infringed the trademark rights of Jack Daniel’s.¹¹⁵ The Court’s approach only makes sense if it sees merchandising uses as trademark uses—that is if all of VIP’s uses count as source-identifying given their merchandising context.

5. Limiting the Merchandising Right

Given the preceding, a lot of expressive conduct may find itself without the protections of *Rogers*. In oral argument, the Justices struggled to find ways to limit applications of *Rogers* to “correct” defendants. Justice Kagan, for example, pushed Blatt to accept

¹¹¹ *Id.* (“[E]very designer of products that puts their trade name on it—name any famous designer—they have a logo that symbolizes them, they give each design a different name. That’s what you do. Bad Spaniels is one among many other names.”).

¹¹² *Id.* Likewise, trademark claims as to other products in the VIP line were limited to word marks and not the parodic image. *See id.* at 74–75 (discussing the “dos perros” toy).

¹¹³ “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.” *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 160 (2023) (quoting Transcript, *supra* note 48, at 73).

¹¹⁴ *Jack Daniel’s Props.*, 599 U.S. at 159–60.

¹¹⁵ Cooper pressed this point in oral argument. *See* Transcript, *supra* note 48, at 73–74 (“And Jack Daniel’s has made clear in this case that they don’t consider Bad Spaniels to be infringing. It’s the totality of the whole look. In fact, in their confusion survey, they used Bad Spaniels and the dog head as it appears on the hangtag of the product as their control sample.”).

commercial products as defining the *Rogers* domain.¹¹⁶ Justice Sotomayor pressed for an explanation of how a win for Jack Daniel's couldn't be used to target the use of political party logos in critical T-shirts, positing a hypothetical in which someone takes the animal logo of either the Democratic or Republican party, makes a T-shirt in which a drunk version of the animal appears next to the slogan, "Time to Sober Up America," and sells the T-shirt on Amazon.¹¹⁷

Justice Sotomayor then put her finger on the fundamental problem in such cases. It well could be the case that a trademark claimant could concoct a survey demonstrating that some consumers think the permission of the parodied party was necessary.¹¹⁸ What then? If *Rogers* applies, the case is simple. But if not?

In one of the most incredible exchanges of the oral argument, Blatt took a maximalist approach, arguing that when push comes to shove, the Lanham Act simply prevails over expressive interests.

JUSTICE SOTOMAYOR: They don't need permission to make a political joke. They don't need permission to make a parody.

MS. BLATT: You can—well, you need to get permission if it's a confusing parody.¹¹⁹

The assertion that Lanham Act interests prevail over free expression claims was a good deal more plausible in a world of more restrained trademark rights.¹²⁰ As it is, however, Blatt's response raises any number of questions not only about trademark law's scope, but also about *how* plaintiffs establish likelihood of confusion

¹¹⁶ *Id.* at 8–9. Indeed, Justice Kagan was bewildered at the breadth of the scope of Blatt's claims, saying, "I'm just wondering why you are making such a broad argument when there are pretty obvious narrower arguments available to you." *Id.* at 8.

¹¹⁷ *Id.* at 19.

¹¹⁸ *Id.* at 19–20 ("[A] political party gets a consumer survey purportedly showing that 15 percent, 20, 25, 10, whatever number we make up . . . think the activist needs the party's permission to copy the logo.").

¹¹⁹ *Id.* at 23.

¹²⁰ *See supra* notes 66–68 and accompanying text.

in litigation.¹²¹ The answers explain a lot about how trademark law has evolved to require speech-protective defensive doctrines like *Rogers*. The *Jack Daniel's* oral argument drew many of these issues into the open for an illuminating discussion even though the final opinion largely leaves them aside.

B. *The Problems of Trademark Litigation*

Seeing the Bad Spaniels chew toy next to a bottle of Jack Daniel's excites varied intuitions. Some are amazed that someone can get away with ripping off the Jack Daniel's trade dress. Cases implementing the merchandising right vindicate this kind of intuition.¹²² Others are amazed that this could be a federal case in the first place. They are more likely to ask, as did Justice Alito, "[c]ould any reasonable person think that Jack Daniel's had approved this use of the mark?"¹²³ That the district court answered yes highlights several issues with trademark adjudication. Some of these reflect the accommodation of the merchandising right to trademark law, but others illustrate general issues with factfinding in the trademark context. The oral argument let us hear the Justices thinking out loud about some of them.

1. Trademark Elitism, Missing Consumers, and Materiality

Start with Lisa Blatt's reaction to Justice Alito's inquiry. After a back and forth about whether a company would ever approve an ad or product detrimental to its reputation,¹²⁴ Blatt made a nakedly elitist appeal:

Justice Alito, I don't know how old you are, but you went to law school, you're very smart, you're analytical, you have hindsight bias

[I]t's just a little rich for people who are at your level to—to say that you know what the average

¹²¹ To be sure, Blatt did claim that source confusion was likely in this case. *See* Transcript, *supra* note 48, at 41.

¹²² *See Living with the Merchandising Right*, *supra* note 57, at 23–26, 31–32 (describing the prevalence of intuitions in favor of the merchandising right).

¹²³ Transcript, *supra* note 48, at 28.

¹²⁴ *See id.* at 28–31.

purchasing public thinks about all kinds of female products¹²⁵] that you don't know anything about or dog toys that you might not know anything about.¹²⁶

Blatt's strategy was deliberate, as she had earlier defended consumer surveys by arguing:

[Consumer surveys are] capturing, for whatever reason, *because consumers are dumb or they're confused about the law* or just the way they make marketing decisions, surveys are picking up the real-world marketplace that a judge, who has hindsight bias and is *highly analytical*, is not going to represent the purchasing public.¹²⁷

The dual strategy of flattering judges and insulting your client's customers reflects several gaps in trademark doctrine. The first is a fundamental issue with trademark law's story of consumer protection. On Blatt's telling, action is required because *some* consumers are confused by VIP's conduct.¹²⁸

The underlying implicit argument is that confusion prevention is costless and that stamping out misleading conduct, no matter how minor, is an unalloyed good. Not so. In this case, it means depriving *non-confused* consumers of the benefits of the availability of the Bad Spaniels toy. In effect, Jack Daniel's seeks to leverage the purported confusion of one class of consumers against the interests of another. Unfortunately, trademark doctrine lacks a vocabulary for this issue and generally does not consider the costs of infringement suits to non-confused consumers. But if trademark law is about consumer protection, then the non-confused should be as much the object of trademark law's solicitude as the gullible.¹²⁹

¹²⁵ Earlier in the argument, Blatt defended the utility of surveys by citing their value in a case in which a male judge was trying to ascertain consumer perception when the consumers in question were teenage girls who were purchasing undergarments. *Id.* at 21–22.

¹²⁶ *Id.* at 31.

¹²⁷ *Id.* at 21 (emphases added).

¹²⁸ *See id.*

¹²⁹ *See generally* Michael Grynberg, *Trademark Litigation as Consumer Conflict*, 83 N.Y.U. L. REV. 60 (2008) (making this argument in greater detail).

This omission is unimportant with respect to everyday point-of-sale passing off cases. Given the abundance of potential marks, there is generally little cost to non-confused consumers to expect trademark defendants to select non-confusing marks.¹³⁰ If there were another dog toy maker with priority to SILLY SQUEAKERS, then of course we would expect VIP to come up with another name for its product line. The *Jack Daniel's* infringement question, however, concerns the legality of the product, not the name. VIP is either allowed to market a chew toy reminding people of Jack Daniel's or it's not—if the point of the toy is to remind people of the whiskey brand, then there is no alternative to a design that evokes it.

More importantly, this cause of action is well-removed from the ordinary passing off case at the heart of trademark law.¹³¹ If I ask for a COCA-COLA, for example, I have a straightforward autonomy interest in getting what I want and not being deceived into buying something else. Likewise, protecting trademarks improves the marketplace. Because COCA-COLA represents a single source, the mark's owner may make investments in price and quality knowing that it will benefit if those investments make the soda more attractive to purchasers. Consumers, in turn, benefit from the resulting competition among different mark holders. But if anyone could be COCA-COLA, then the term would lose meaning and the benefits of a single source would be lost.¹³²

None of these interests are at stake in *Jack Daniel's*. JACK DANIEL'S still represents a particular source of whiskey. Indeed, the joke depends on JACK DANIEL'S retaining a stable meaning. VIP therefore is effectively *reinforcing* the strength of the parodied

¹³⁰ See *id.* at 81, 89–90.

¹³¹ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt. d (AM. LAW INST. 1995).

¹³² See Nicholas S. Economides, *The Economics of Trademarks*, 78 TRADEMARK REP. 523, 526–27 (1988) (“The economic role of the trademark is to help the consumer identify the unobservable features of the trademarked product. This information is not provided to the consumer in an analytic form, such as an indication of size or a listing of ingredients, but rather in summary form, through a symbol which the consumer identifies with a specific combination of features. Information in analytic form is a complement to, rather than a substitute for, trademarks.”).

mark.¹³³ Instead of source confusion, we are in the more nebulous realm of approval and permission. Assuming *arguendo* that there is a likelihood of confusion about permission, what is the harm? What consumer benefit justifies banning the dog toy for those who derive pleasure from VIP's joke?

In a wide-ranging oral argument, the counsel for Jack Daniel's was never asked the question, let alone pressed for an answer. A possible reason why not is that trademark law—unlike false advertising—lacks a materiality requirement for its infringement action.¹³⁴ Again, this gap is unimportant in traditional claims. If I ask for a COCA-COLA and receive a ROCA-COLA in return, it seems plausible that not getting what I asked for matters to me. The materiality of a mistake on my part about whether Jack Daniel's gave permission for a parodic dog toy is considerably less clear. This is not to say that arguments cannot be made for the proposition,¹³⁵ but Jack Daniel's was not even asked to make them—even by the Justices inclined to be skeptical about its trademark claims.

2. The Role of Surveys

The district court's initial ruling in favor of Jack Daniel's relied in large part on a survey conducted by the whiskey maker,¹³⁶ which gave the Supreme Court a chance to discuss surveys in oral argument. Discussing her political T-shirt hypothetical, Justice Sotomayor asked whether a political party plaintiff could avoid summary judgment and get to trial simply by commissioning a survey

¹³³ Tellingly, dilution by blurring was not an issue before the Court. *See* Jack Daniel's Props., Inc. v. VIP Prods. LLC, 599 U.S. 140, 147 (2023) (“Dilution of such a mark can occur ‘by tarnishment’ (as well as by ‘blurring,’ not relevant here).”).

¹³⁴ Courts are nonetheless capable of incorporating materiality considerations in adjudicating trademark infringement. *See* Michael Grynberg, *Things Are Worse Than We Think: Trademark Defenses in a “Formalist” Age*, 24 BERKELEY TECH. L.J. 897, 963–66 (2009) [hereinafter *Things Are Worse Than We Think*].

¹³⁵ *See* Matthew B. Kugler, *The Materiality of Sponsorship Confusion*, 50 U.C. DAVIS L. REV. 1911, 1915 (2017).

¹³⁶ *See* VIP Prods., LLC v. Jack Daniel's Props., Inc., 291 F. Supp. 3d 891, 906–08 (D. Ariz. 2018). The Supreme Court recognized that the survey was central to the infringement finding. *See* *Jack Daniel's Props.*, 599 U.S. at 151–52 (2023) (“The District Court found, based largely on survey evidence, that consumers were likely to be confused about the source of the Bad Spaniels toy.”).

showing that some percentage of test subjects think permission is required to use the trademark on the shirt.¹³⁷

The response from Jack Daniel's was equivocal,¹³⁸ but as noted above, Blatt argued that when push comes to shove, the prevention of confusion essentially trumps any First Amendment interest.¹³⁹ She also sung a paean to the value of trademark surveys to illuminate cases for judges who may not share the characteristics of the relevant purchasers at issue in the litigation.¹⁴⁰

¹³⁷ [A] political party gets a consumer survey purportedly showing that 15 percent, 20, 25, 10, whatever number we make up . . . the activist [selling T-shirts with the party's animal logo] needs the party's permission to copy the logo . . . [Does a judge] have to go through . . . a full trial under the Polaroid factors to decide this case?

Transcript, *supra* note 48, at 19–20.

¹³⁸ The initial inference from Justice Alito was that the hypothetical T-shirt would give rise to liability if there were an adequate survey. *Id.* at 26 (“I take it your short answer to Justice Sotomayor’s hypothetical where, let’s say, the—the survey shows 25 percent—let’s say it shows 30 percent, your answer is that has to go to a jury.”). When pushed, however, Blatt equivocated and seemed to wind up saying that the T-shirt would *not* be infringing, though she did not explain why, and the follow-up question seemed to suggest the opposite result.

JUSTICE ALITO: Would it go to the jury or not? Can you give me an answer?

MS. BLATT: I think it would probably—I mean, it just depends if there was something wrong about the survey, but it—I don’t know if it would go—no, no, it would not go to a jury. It could go to summary—it would—could be resolved on summary judgment.

JUSTICE ALITO: It would go on summary judgment—

MS. BLATT: Yeah.

JUSTICE ALITO: —in favor—in favor of the Republican Party or the Democratic Party?

MS. BLATT: Well, it depends. Unless it meets 12(b)(6), it survives a motion to dismiss.

Id. at 26–27.

¹³⁹ *Id.* at 23 (“You need to get permission if it’s . . . confusing”).

¹⁴⁰ *Id.* at 21–22 (“The reason we have surveys in the first place is pretty amazing. In 1948, Jerome Frank on the Second Circuit had a case involving teenage girls’ underwear and he said, you’ve got to be kidding me. I’m a man. Everyone on this court is a man. How am I supposed to know this? Couldn’t somebody do a survey?”).

Given that she was not pressed on the consumer benefits of VIP's conduct,¹⁴¹ it is unsurprising that Blatt felt free to take the extreme view that even low levels of confusion, as reflected on a survey, must be stamped out.¹⁴² But for the claim to be coherent, we must assume that the survey was conducted in an effective manner. The use and abuse of surveys in trademark litigation is a well-covered topic.¹⁴³ Even assuming the survey in this case was well constructed, it is still necessary to ensure that it measures the right thing. Otherwise, the survey may obscure key issues in the litigation.

This is what happened in the *Jack Daniel's* bench trial. The survey commissioned by Jack Daniel's purportedly showed a 29% level of confusion on the part of test subjects presented with the chew toy and the Jack Daniel's trade dress.¹⁴⁴ The court viewed the survey as dispositive of infringement,¹⁴⁵ and on first glance, the 29% figure seems impressive given results that courts have weighed favorably in the past.¹⁴⁶

¹⁴¹ See *supra* notes 124–127 and accompanying text.

¹⁴² While simultaneously pretending that all activities that might constitute trademark infringement are inherently *deceptive*. At one point Blatt equates VIP's conduct with a lawyer's attempting to mislead the Justices in briefing. Transcript, *supra* note 48, at 22 (“Now your example on the T-shirts. If it's—if there's a survey on 15 percent, and I also heard in there some sort of implicit thing that 15 percent was too low, if this Court had a rule saying advocates, please do not have briefs that are likely misleading, and if you want us to say advocates, that can go up to 50 percent because it's okay if only 20 percent of judges found it deceptive or even 40 percent, it has to be more than half.”).

¹⁴³ For a recent discussion, see Barton Beebe et al., *Consumer Uncertainty in Trademark Law: An Experimental Investigation*, 72 EMORY L.J. 489, 494 (2023) (noting that another major shortcoming in surveys is their failure to assess the degree of uncertainty of test subjects).

¹⁴⁴ *VIP Prods., LLC v. Jack Daniel's Props., Inc.*, 291 F. Supp. 3d 891, 908 (D. Ariz. 2018).

¹⁴⁵ *Id.* at 908 (“The Court credits that Dr. Ford's survey establishes likelihood of confusion in this case.”); *id.* at 907 (crediting and giving “prevailing weight” to the survey expert's conclusions).

¹⁴⁶ See MCCARTHY, *supra* note 16, § 32:188 (“Generally, figures in the range of 25% to 50% have been viewed as solid support for a finding of a likelihood of confusion.”); see also *id.* (“In the author's view, survey confusion numbers that go below 20% need to be carefully viewed against the background of other evidence weighing for and against a conclusion of likely confusion. Where other evidence is supportive, courts have found a likelihood of confusion when survey results are between 10% and 20%.”); *VIP Prods.*, 291 F. Supp. 3d at 908 (“Dr. Ford's survey results that 29% of potential purchasers were likely confused is nearly double the threshold to show infringement.”).

VIP produced an expert in response who identified potentially significant flaws with the survey.¹⁴⁷ For present purposes, what is interesting is not whether those critiques are correct, but rather the failure of the district court to engage with them.¹⁴⁸ The district court ignored the substance of the objections not because they were wrong, but because VIP's expert did not conduct a survey of his own.¹⁴⁹ None of these methodological flaws arose as a topic of discussion in the Supreme Court oral argument.¹⁵⁰

The survey's claimed confusion level of "29%" also obscures a more controversial *legal* conclusion. As the district judge noted, the 29% figure combined perceptions of source, affiliation, and the belief that the toy was "put out with the authorization or approval of Jack Daniel's."¹⁵¹ In other words, much of the potential confusion was about whether Jack Daniel's gave permission to make the toy, placing the case at the extremes of the types of confusion that could be the subject of a lawsuit.¹⁵² More importantly, the district court

¹⁴⁷ The "Expert Rebuttal Report of Stephen Nowlis" is available in the Joint Appendix of the Supreme Court proceedings. See Joint Appendix at 64, *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023) (No. 22-148) [hereinafter Joint Appendix]; see also *id.* at 68 ("In particular, Dr. Ford designed an improper Control stimulus, did not mimic marketplace conditions, and improperly analyzed his data.").

¹⁴⁸ *VIP Prods.*, 291 F. Supp. 3d at 908.

¹⁴⁹ *Id.*

Although Dr. Nowlis objected to Dr. Ford's control stimulus, Dr. Nowlis did not support this view by conducting a survey or by conducting independent research; he simply couched his opinion regarding lack of confusion through generalized objections to Dr. Ford's report.

Therefore, the Court does not credit Dr. Nowlis's generalized objections. Moreover, the Court finds that Dr. Nowlis has never written any articles on trademark surveys, or trademark survey design, or on the issue of likelihood of confusion in trademark law which undercuts his opinions.

Id. (paragraph numbers omitted).

¹⁵⁰ Though Blatt seems to hint at them at one point. See Transcript, *supra* note 48, at 25. To be sure, certiorari was not granted to resolve questions of trademark surveys, but that underscores the mismatch in trademark law between liability and defensive doctrines. Certiorari gets granted not to consider the expansion of trademark law, but rather efforts to protect free speech in its wake. This dynamic is discussed in greater detail *infra* Section III.C.2.

¹⁵¹ *VIP Prods.*, 291 F. Supp. 3d at 907.

¹⁵² See *infra* Section III.C.1.

made no effort to disaggregate permission confusion from source confusion, even though VIP's expert reviewed the survey and found that the "source" confusion figure was only 11.8%,¹⁵³ which is *lower* than the typical threshold for surveys to be treated as evidence of likely confusion.¹⁵⁴ So leaving aside questions of survey design, permission confusion was the primary issue of the case, *not source confusion*.¹⁵⁵ As VIP's expert noted, given the parodic nature of the chew toy, "it is clear that many respondents in fact recognized that the product is made or put out by VIP products, and yet were thinking that VIP would need to get authorization or approval from Jack Daniel's in order to sell such a parody product."¹⁵⁶

The district court completely ignored the question, having dismissed the objections of VIP's expert on non-substantive grounds.¹⁵⁷ When the case was argued before the Supreme Court, no Justice took up the issue of combining types of confusion,¹⁵⁸ and the final opinion seems to endorse, in passing, the fiction that the Jack Daniel's survey tells us something useful about *source* confusion.¹⁵⁹

The Court's opinion likewise ignores the methodological imbalances of trademark survey practice and precedent, saying nothing substantive about surveys. A concurring opinion by Justice Sotomayor, joined by Justice Alito, does, however, raise some of these issues, warning that in trademark cases raising First Amendment issues, "courts should treat the results of surveys with *particular* caution."¹⁶⁰ The concurrence: 1) cautions against treating surveys as dispositive (as the district court did in this case);¹⁶¹ 2) notes the potential that surveys may only be measuring a belief that trademark

¹⁵³ Joint Appendix, *supra* note 147, at 82.

¹⁵⁴ MCCARTHY, *supra* note 16, § 32:188.

¹⁵⁵ See Joint Appendix, *supra* note 147, at 82.

¹⁵⁶ *Id.* at 84.

¹⁵⁷ See *supra* notes 147–149 and accompanying text.

¹⁵⁸ Blatt implicitly engaged the critique in passing at one moment, though none of the Justices followed up. See Transcript, *supra* note 48, at 25.

¹⁵⁹ Jack Daniel's Props., Inc. v. VIP Prods. LLC, 599 U.S. 140, 151–52 (2023) ("The District Court found, based largely on survey evidence, that consumers were likely to be confused about the source of the Bad Spaniels toy.")

¹⁶⁰ *Id.* at 163 (Sotomayor, J., concurring) (emphasis added).

¹⁶¹ *Id.*

parodies require permission;¹⁶² and 3) explains that plaintiffs may manipulate surveys to take advantage of mistaken beliefs about the law among respondents.¹⁶³ Sotomayor likewise opines that courts “should also carefully assess the methodology and representativeness of surveys, as many lower courts already do.”¹⁶⁴ The failure of the full Court to take up these questions represents a missed opportunity.¹⁶⁵

Many of the survey issues described here are intertwined with the important issue of whether “permission confusion” gives rise to a viable trademark claim. The misperception of permission is fundamental to the merchandising right,¹⁶⁶ and merchandising cases feed the perception that trademark holder permission is required for mark uses.¹⁶⁷ The substantive question of whether such confusion

¹⁶² As Justice Sotomayor explained:

Survey answers may reflect a mistaken belief among some survey respondents that all parodies require permission from the owner of the parodied mark. Some of the answers to the survey in this case illustrate this potential. (“I’m sure the dog toy company that made this toy had to get [Jack Daniel’s] permission and legal rights to essentially copy the[ir] product in dog toy form.”); (“The bottle is mimicked after the Jack Daniel BBQ sauce. So they would hold the patent therefore you would have to ask permission to use the image.”)

Id. at 164 (citations omitted) (quoting Joint Appendix, *supra* note 147, at 81–82 n.25). This quote is an implicit critique of the notorious case *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769 (8th Cir. 1994), which upheld an infringement claim against a magazine that satirized the MICHELOB marks by depicting them drenched in oil is particularly noteworthy. Cooper attacked the result in *Balducci* in his argument as well. *See* Transcript, *supra* note 48, at 59 (“[A] test that convicts pure parodic speech like . . . Michelob Oily in a humor magazine is broken.”).

¹⁶³ *Jack Daniel’s Props.*, 599 U.S. at 164 (Sotomayor, J., concurring) (“Plaintiffs can point to this misunderstanding of the legal framework as evidence of consumer confusion. Cleverly designed surveys could also prompt such confusion by making consumers think about complex legal questions around permission that would not have arisen organically out in the world.”).

¹⁶⁴ *Id.* at 163.

¹⁶⁵ It also represents the second time in recent years that the Supreme Court has used surveys to expand the scope of trademark rights without offering anything to counterbalance the potential costs of doing so. *See* U.S. Patent & Trademark Off. v. Booking.com B.V., 140 S. Ct. 2298, 2307 n.6 (2020). For further discussion on *Booking.com*, see *Living with the Merchandising Right*, *supra* note 57, at 64–68.

¹⁶⁶ *See* *Living with the Merchandising Right*, *supra* note 57, at 26–29.

¹⁶⁷ Many critics of the merchandising right have noted the circularity problem. *See, e.g.*, Dogan & Lemley, *supra* note 57, at 486. Much of the “confusion” may be about what the

should be relevant in trademark cases, and how the Justices addressed the issue in oral argument, is taken up in further detail below.¹⁶⁸

3. The Myth of Factfinding and Rational Consumers

The survey issues in *Jack Daniel's* reflect a deeper issue with trademark jurisprudence. Although trademark cases require factfinding, trademark law has a fundamentally normative component. To see why, consider the “likelihood of confusion” standard.¹⁶⁹ Those words do not tell us much by themselves. How likely must the confusion be? Who must be confused? About what? How deep must uncertainty be before we can call the confusion actionable? The text of the Lanham Act does not resolve these questions, but they must be answered, either explicitly or implicitly, for a Lanham Act claim to be adjudicated.¹⁷⁰ Someone somewhere is going to be confused about any proposition you can possibly name. Unless everything is trademark infringement, choices need to be made about what kinds of confusion matter, whose confusion matters, and when it is reasonable for someone to be confused.¹⁷¹

These choices are all fundamentally normative, but that is not the story the courts generally tell themselves. For most judges, trademark infringement questions are purely questions of fact, at least as a matter of doctrine.¹⁷² Most circuit courts review infringement

law requires or doesn't require (i.e., whether people think the chew toy requires the trademark holder's permission); that perception, in turn, is shaped by opinions like the one the district court initially issued.

¹⁶⁸ See *infra* Section II.C.1.

¹⁶⁹ 15 U.S.C. §§ 1114, 1125.

¹⁷⁰ See Michael Grynberg, *The Consumer's Duty of Care in Trademark Law*, in RESEARCH HANDBOOK ON TRADEMARK LAW REFORM 326, 327 (Graeme B. Dinwoodie & Mark D. Janis eds., 2021).

¹⁷¹ See *id.* Justice Alito raised this point briefly during oral argument but did not follow up on that point after Blatt pushed back with the argument that flawed surveys could always be ignored. See Transcript, *supra* note 48, at 31–32.

¹⁷² Most circuit courts, for example, review infringement questions as questions of fact, rather than questions of law. MCCARTHY, *supra* note 16, § 23:71 (“The vast majority of the 13 federal circuits follow the rule that likelihood of confusion is an issue of fact reviewed on appeal under a deferential ‘clearly erroneous’ standard.”). The exceptions are the Second, Sixth, and Federal Circuits. *Id.* But see *Max Rack, Inc. v. Core Health &*

findings for clear error,¹⁷³ and they routinely admonish lower courts to not draw substantive conclusions about likelihood of confusion on summary judgment, lest a jury disagree.¹⁷⁴ Appellate judges nonetheless battle amongst themselves about when such conclusions are,¹⁷⁵ or are not,¹⁷⁶ appropriate at the appellate level.

In the *Jack Daniel's* oral argument, the whiskey maker tried to rely on the myth of simple factfinding in a variety of ways. First, as discussed above, Blatt made the extreme claim that expressive interests yield in the face of likely confusion, full stop.¹⁷⁷

More fundamentally, the argument showed how the factfinding ideal may be used to deny the possibility of a free expression problem. From this perspective, expressive uses worth worrying about are simply not confusing. This logic came into play when Blatt invoked the “Chewy Vuiton” case.¹⁷⁸ There, a dog chew toy labeled “Chewy Vuiton” provoked trademark claims from LOUIS VUITTON.¹⁷⁹

Though the Fourth Circuit did not use the *Rogers* test, the toymaker still prevailed under the Circuit’s ordinary likelihood-of-

Fitness, LLC, 40 F.4th 454, 464 (6th Cir. 2022) (questioning whether the clear error standard should apply to jury review).

Likewise, despite the concern expressed by Justice Sotomayor about requiring a full-blown analysis under the multifactor test for every case, circuit courts routinely admonish district judges to not dispense with the full-factor analysis. *See, e.g., Souza v. Exotic Islands Enters., Inc.*, 68 F.4th 99, 116 (2d Cir. 2023) (“We thus reiterate that as a general matter, district courts should typically address all the *Polaroid* factors and, if it deems one of the factors irrelevant, ‘explain why.’” (quoting *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384, 400 (2d Cir. 1995))).

¹⁷³ *See supra* text accompanying note 172.

¹⁷⁴ *See, e.g., Wreal, LLC v. Amazon.com, Inc.*, 38 F.4th 114, 124 n.6, 138 n.17 (11th Cir. 2022); *Ironhawk Techs., Inc. v. Dropbox, Inc.*, 2 F.4th 1150, 1165–66 (9th Cir. 2021).

¹⁷⁵ *See, e.g., Ironhawk Techs.*, 2 F.4th at 1169 (Tashima, J., dissenting).

¹⁷⁶ *See, e.g., Multi Time Mach., Inc. v. Amazon.com, Inc.*, 804 F.3d 930, 940 (9th Cir. 2015) (Bea, J., dissenting).

¹⁷⁷ Transcript, *supra* note 48, at 23 (“[Y]ou need to get permission if it’s a confusing parody.”).

¹⁷⁸ *Id.* at 23–24.

¹⁷⁹ *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 252 (2007).

confusion analysis, which was applied to take into account the parodic nature of the defendant's goods.¹⁸⁰

In the *Jack Daniel's* oral argument, Blatt argued that the Chewy Vuiton result shows the virtue of the fact-intensive approach.¹⁸¹ For its part, the Court's ultimate opinion nods to the possibility that courts may account for expressive uses via operation of ordinary infringement analysis.¹⁸² VIP's expressive interest may be vindicated on remand notwithstanding its earlier loss at trial.¹⁸³

But given that VIP *did* lose at trial, how are speech rights vindicated in a world of inconsistent factfinders? What if the true difference between Chewy Vuiton and Bad Spaniels was not any particular fact, but rather the luck of the judicial draw? Additionally, even if we have confidence in the factfinding process in the long run, adjudication is costly. The expensive and uncertain road between a cease-and-desist letter and final judgment may nudge potential defendants to stand down in the face of threats from well-heeled

¹⁸⁰ See *id.* at 256–57. So, for example, a plaintiff like Louis Vuitton normally benefits from the strength of its mark, but here it was “a matter of common sense that the strength of a famous mark allow[ed] consumers immediately to perceive the target of the parody, while simultaneously allowing them to recognize the changes to the mark that make the parody funny or biting.” *Id.* at 261. Likewise, though the defendant “concede[d] that its marks are and were designed to be somewhat similar to LVM’s marks,” that did not mean that the similarity factor weighed in favor of Louis Vuitton. *Id.* at 262. The designed similarity was “the essence of a parody—the invocation of a famous mark in the consumer’s mind, so long as the distinction between the marks is also readily recognized.” *Id.*

¹⁸¹ Transcript, *supra* note 48, at 23–24. She also maintained that similar subject matter notwithstanding, the two cases were not at all alike. *Id.* The reader can evaluate the claim for themselves with a google search for the Chewy Vuiton design.

¹⁸² *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 161 (2023) (“But a trademark’s expressive message—particularly a parodic one, as VIP asserts—may properly figure in assessing the likelihood of confusion.” (citing *Louis Vuitton*, 507 F.3d at 265)).

¹⁸³ *Id.* (“[A] parody is not often likely to create confusion. Self-deprecation is one thing; self-mockery far less ordinary. So although VIP’s effort to ridicule Jack Daniel’s does not justify use of the *Rogers* test, it may make a difference in the standard trademark analysis.”). Because the Ninth Circuit had directed that the case be disposed of under the *Rogers* test, it never reached VIP’s fact-based challenges to the district court’s ruling, so those arguments remain untested as Blatt acknowledged. See Transcript, *supra* note 48, at 37 (acknowledging that “VIP has lots of arguments that we didn’t meet the likelihood-of-confusion test, so that’ll be on remand. We’d have to win that.”).

plaintiffs. This is the value of doctrines like *Rogers*, which can be employed on summary judgment or even a motion to dismiss.¹⁸⁴

Arguing for the government, Matthew Guarnieri basically said that such considerations do not matter, arguing that some abusive cases could still be disposed of at an early stage while others would ultimately be wins for the defendant.¹⁸⁵ If so, he said, the costs along the way do not matter.

[I]ndeed, I don't take a lot of the amici who favor Rogers to be saying that the cases would really come out differently. The . . . claim is just that they don't want to have to go through the process of demonstrating that consumer confusion is not likely, and I don't think that itself is a sufficient basis for maintaining Rogers.¹⁸⁶

The final opinion downplays the issue of litigation costs, noting that particularly meritless cases can be dismissed at an early stage.¹⁸⁷ And while this indeed *can* happen,¹⁸⁸ the prospect that it *will* happen is undermined by the view, discussed above,¹⁸⁹ that trademark litigation is wholly factual, which works against motions for summary disposition.¹⁹⁰ After all, even if the Chewy Vuiton case presented facts that were an obvious win for the defendant in a way that the

¹⁸⁴ A dynamic that the Court previously appreciated in trademark cases. *See* Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 214 (2000) (“Competition is deterred, however, not merely by successful suit but by the plausible threat of successful suit . . .”).

¹⁸⁵ Transcript, *supra* note 48, at 57–58.

¹⁸⁶ *Id.* at 58.

¹⁸⁷ *Jack Daniel's Props.*, 599 U.S. at 157 n.2 (“That is not to say (far from it) that every infringement case involving a source-identifying use requires full-scale litigation. Some of those uses will not present any plausible likelihood of confusion—because of dissimilarity in the marks or various contextual considerations. And if, in a given case, a plaintiff fails to plausibly allege a likelihood of confusion, the district court should dismiss the complaint under Federal Rule of Civil Procedure 12(b)(6).”).

¹⁸⁸ The Court cited McCarthy for this proposition. *Id.*; *see* MCCARTHY, *supra* note 16, § 32:121.75 (collecting examples).

¹⁸⁹ *See supra* Section II.B.3.

¹⁹⁰ This is clear enough in the McCarthy passage cited by the Court. *Jack Daniel's Props.*, 599 U.S. at 157 n.2. McCarthy lists multiple examples of courts warning against too-early disposition of trademark cases. MCCARTHY, *supra* note 16, § 32:121.75.

facts in *Jack Daniel's* were not, it was a win that still required a trip to the Fourth Circuit to be secured.¹⁹¹

C. *The Problem of the Lanham Act*

VIP's problems were compounded by the prospect that trademark infringement claims potentially extend beyond confusion about source to confusion about mere permission.¹⁹² Permission confusion is essential to the merchandising right,¹⁹³ and the oral argument almost addressed the connection. Blatt observed:

But you can infringe iPhone's marks or any mark without indicating it's a source. You can put it on a T-shirt, you can put it in a movie, you can sell lots of products. It's just not being used as a trademark. And the statutory definition of infringement has nothing to do with use as a source. It's any use of a mark likely to cause confusion.¹⁹⁴

Justice Jackson pressed Blatt to explain how placing the Apple mark on a T-shirt would confuse consumers.¹⁹⁵ Unhelpfully, Blatt switched to a dilution argument, contending that the statement "Apple sucks" would dilute the mark (it wouldn't), and the argument unfortunately moved elsewhere.¹⁹⁶

Here, the problem is the Lanham Act, which leaves critical questions of trademark's domain to the judicial imagination.¹⁹⁷ This issue pervades the *Jack Daniel's* litigation. Recall that the *Rogers* test

¹⁹¹ These difficulties led Guarnieri to argue that even though these cases are factual, the district court still committed "legal error in failing to take account of the parodic nature" of VIP's use when applying the multifactor test. Transcript, *supra* note 48, at 50. This is true, but inconsistent with the "just-the-facts" perspective of trademark cases. If likelihood of confusion is just a fact issue, then it's entirely possible that confusion exists as when an onlooker is unaware of, or just misses, the parody. To say that parody must be considered is to say that likelihood of confusion is more than just a fact issue (which it is).

¹⁹² See *infra* Section II.C.1.

¹⁹³ See *Living with the Merchandising Right*, *supra* note 57, at 26–29.

¹⁹⁴ Transcript, *supra* note 48, at 14.

¹⁹⁵ *Id.* at 15.

¹⁹⁶ *Id.* There was no explanation of how expressing an opinion about Apple would be likely to dilute, but even if it were, the statement would squarely fit the exclusions of 15 U.S.C. § 1125(c)(3)(A).

¹⁹⁷ See *supra* Section II.B.3.

is rooted in a judicial effort to mitigate the danger that trademark infringement claims pose to freedom of speech by channeling certain claims away from ordinary infringement analysis.¹⁹⁸ Perhaps, however, the problem can be mitigated by constructing other parts of the Lanham Act restrictively—say, by limiting the scope of the infringement cause of action. Justice Jackson pushed this point by asking, “isn’t trademark consistent with the First Amendment because of trademark infringement’s limited scope?”¹⁹⁹ The next two subparts address two connected questions of Lanham Act construction: (1) what kinds of confusion does it police, and (2) if the cause of action reaches non-source-based trademark references, what can be done to stop the statute from reaching too far?

1. Confusion About What?

What kinds of confusion matter? Recall the Jack Daniel’s survey and how it combined various forms of confusion.²⁰⁰ Some of the purported confusion—confusion as to source—was clearly material. But some was not.²⁰¹ Does confusion as to who “authorized or approved” the toy matter to a reasonable purchaser? Perhaps, if the terms mean “endorse” with guarantee of quality. But not if they mean mere permission, especially if the misunderstanding is not about the trademark holder’s quality control measures, but rather about what the law requires.²⁰²

The Lanham Act does not define “approval” confusion; there is no obvious textual constraint to prevent trademark holders from trying to exercise absolute control over references to their marks.²⁰³ At oral argument, Jack Daniel’s never offered a limiting principle beyond consumer perception and the possibility that courts may make judgment calls on motions for summary judgment or Rule 12(b)(6)

¹⁹⁸ See *supra* Section I.B.

¹⁹⁹ Transcript, *supra* note 48, at 38.

²⁰⁰ See *supra* Section II.B.2.

²⁰¹ See *supra* Section II.B.1.

²⁰² See *supra* note 167.

²⁰³ See 15 U.S.C. § 1125(a). The provision also refers to potential errors of “affiliation, connection, or association” of a defendant with another person. *Id.* That said, there are textual arguments against the very broad reading of approval confusion. See *Things Are Worse Than We Think*, *supra* note 134, at 965–66.

dismissal.²⁰⁴ Blatt's bottom line was that trademark law now extends beyond mere passing off claims, so expansive confusion claims are permissible.²⁰⁵

So how far does permission confusion extend? The Justices showed some interest in the issue, notably when Blatt was pushed on her assertion that permission is required for "a confusing parody."²⁰⁶ Her claim invites the question of what exactly makes the parody confusing. Is it a failure to make the parody clear enough that purchasers do not think the products are the same? Or is the perception that permission was required, and therefore given, enough for a trademark claim?

The latter possibility was aired explicitly in questions to the Solicitor General's attorney, who would not take a definitive stance on permission confusion.²⁰⁷ Guarnieri agreed, however, that consumer confusion about what the law is may itself be the basis of a cause of action under the Lanham Act:

JUSTICE ALITO: And what about the fact that a lot of people surveyed may think that as a matter of law, it was necessary to get the approval of the mark holder?

MR. GUARNIERI: Well, that's a hard case. It's a hard question. There are, you know, certainly some amici supporting Respondent who say that that's a kind of legal mistake that should just be dismissed in the likelihood-of-confusion analysis.

I think that's hard to say because the Lanham Act itself—*one theory of trademark infringement is that consumers are confused about whether the mark*

²⁰⁴ Transcript, *supra* note 48, at 26–27.

²⁰⁵ *Id.* at 39 ("So passing off was in the 1920 Act. It started getting extending [sic] past that in 1946 and then in 1988. So it's just always been extended past passing off. And it's never been limited to designation of a source since the first trademark act of 1881.")

²⁰⁶ *Id.* at 23.

²⁰⁷ *Id.* at 52–53.

*holder has granted its permission to use its marks, that is, whether it has granted legal permission to the allegedly infringing junior mark. If the surveyed consumers think, yeah, you couldn't do this without getting Jack Daniel's permission, I think that's . . . evidence of likelihood of confusion . . .*²⁰⁸

The exchange is illuminating, for it shows how deep the uncertainty over permission confusion runs. Even the Solicitor General's office seems to agree that potential consumer mistakes about permission may give trademark holders the power to censor speech about their goods and services.²⁰⁹ And the only justification offered for this extreme claim is that the Lanham Act's inkblot provisions may be read to encompass permission confusion.²¹⁰

So, what can check extreme trademark infringement claims? Justice Kagan noted the virtue of the *Rogers* test for dispensing with meritless claims “without a lot of fuss and bother.”²¹¹ Justice Alito also pressed the Solicitor General's attorney with the observation that he seemed “not to be very concerned about the free speech implications of the position that [Guarnieri was] taking.”²¹² In response, Guarnieri fell back on the claim discussed above—that courts may bounce meritless cases on summary judgment and 12(b)(6) motions (without explaining how a court can do so in the face of a plausible survey indicating permission confusion).²¹³ Nor was Guarnieri concerned about the costs defendants must bear in

²⁰⁸ *Id.* (emphases added). Guarnieri had previously recited, without explicitly quoting, Section 43(a) of the Lanham Act's language that actionable confusion can be of sponsorship or approval as well as source. *Id.* at 43.

²⁰⁹ And, of course, the consumer perception that permission is required is fed by opinions that give credence to the theory. See Dogan & Lemley, *supra* note 57, at 486 (“The idea that once-legal conduct becomes illegal simply because the public believes it is illegal seems like bootstrapping.”).

²¹⁰ Transcript, *supra* note 48, at 43. *But see Things Are Worse Than We Think*, *supra* note 134, at 965–66 (providing textual arguments against that reading of the Lanham Act).

²¹¹ Transcript, *supra* note 48, at 54.

²¹² *Id.* at 56.

²¹³ *Id.* at 57.

fighting meritless suits all the way to final judgment.²¹⁴ After all, maybe they'll win fees!²¹⁵

Unfortunately, the ultimate *Jack Daniel's* opinion left the issue of permission confusion alone. Justice Sotomayor's concurrence addresses the danger of relying on surveys where parodies are involved.²¹⁶ She observes that surveys "may reflect a mistaken belief among some survey respondents that all parodies require permission from the owner of the parodied mark," noting that the survey relied upon by Jack Daniel's raised this issue.²¹⁷ Plaintiffs may "point to this misunderstanding of the legal framework as evidence of consumer confusion."²¹⁸ Indeed, "[c]leverly designed surveys could also prompt such confusion by making consumers think about complex legal questions around permission that would not have arisen organically out in the world."²¹⁹

But what makes this a misunderstanding? The concurrence does not explain, save for reminding the reader that the opinion of the Court emphasizes the importance of source confusion.²²⁰ Sotomayor notes the danger of allowing surveys to chill parodies, "even ones that by other metrics are unlikely to result in the confusion about *sourcing that is the core concern of the Lanham Act*."²²¹ But nothing else is said to suggest an intent to jettison the Lanham Act's openness to confusion claims that extend beyond source. The logic of the concurrence leaves the basic problem of *Jack Daniel's* alone: only the defensive doctrine (i.e., *Rogers*) is limited; the root force driving overreaching trademark claims remains intact.

²¹⁴ *Id.* at 58; *see also id.* at 55 ("[I]n general, the costs of litigating a trademark infringement suit are not a compelling reason to displace the statutory standard with this *Rogers* standard . . .").

²¹⁵ Guarnieri seriously made this argument. *Id.* at 56 ("In an appropriate case, a district court that, you know, found that a case was brought in bad faith to chill speech that is not confusing, you could award attorneys' fees, and that serves as a deterrent to some extent.").

²¹⁶ *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 164 (2023) (Sotomayor, J., concurring).

²¹⁷ *Id.*

²¹⁸ *Id.*

²¹⁹ *Id.*

²²⁰ *Id.*

²²¹ *Id.* (emphasis added).

2. Trademark Liability vs. Trademark Defenses

The mismatch between trademark liability and limiting doctrines is a fundamental problem in trademark law,²²² and the imbalance shapes the *Jack Daniel's* argument and opinion. The problem is that the liability provision of the Lanham Act—likelihood of confusion—is a malleable Rorschach test.²²³ In contrast, the statute's defensive doctrines are narrow.²²⁴ Judges have only a limited ability to rein in trademark's expansion, especially if they are unwilling to give a normative gloss to likelihood of confusion.²²⁵

The issue came to the fore in the *Jack Daniel's* oral argument. Justice Jackson suggested to Blatt that there was a threshold problem with the infringement claim.²²⁶ Was VIP engaging in a trademark use? If not, perhaps there is no cause of action in the first instance.

I wonder whether the cleaner, more sort of consistent with the statute way of looking at it is to ask, is the artist using this mark as a source identifier, as the threshold, and, if they aren't, *then I guess the Lanham Act doesn't apply* because, as you said, the Lanham Act worries about confusion that arises from use of a mark as a source identifier.

So, if they're not doing that, then there's no trademark problem. But, if they are, if they are doing that, if it's being used as a source identifier, then I suppose we get into all of the questions under the Lanham Act

²²² See *Things Are Worse Than We Think*, *supra* note 134, at 945–62 (exploring this issue at length).

²²³ See *supra* Section II.C.1.

²²⁴ See *Things Are Worse Than We Think*, *supra* note 134, at 945–55.

²²⁵ See *id.* at 961–62 (“Efforts to create new trademark defenses lack a stable foundation. The full consequences of this observation have yet to be internalized by the lower courts But barring a shift in the Supreme Court’s jurisprudence, the writing is on the wall. Sooner or later, the impact of the Supreme Court’s trademark formalism and the general tenor of the age will be inescapable, leaving little room for defensive innovations that cannot be tied to actual provisions of the Lanham Act.”).

²²⁶ Transcript, *supra* note 48, at 11–12.

test as to whether or not there's trademark . . . infringement.²²⁷

The question evokes the debate about the extent to which trademark claims include (or should include) a threshold requirement that the defendant engage in a trademark “use.”²²⁸ The final opinion reinvigorates the dispute not by imposing a threshold use requirement for liability, but by making non-use as a mark a condition for invoking *Rogers* or a like doctrine.²²⁹

Blatt's response to Justice Jackson was to argue that judges have no leeway to apply a trademark use requirement:

And with respect, that literally—you're taking language in the text of parody and in the text of 1115(b)(4), which you had a Supreme Court case on, KP Permanent Makeup,^[230] saying other—designation of a source are actually exceptions under two statutory provisions that don't appear in infringement. *So I'm fine with you making up stuff.*²³¹

However obnoxiously delivered, Blatt makes a plausible statutory argument that illustrates the textual problem with trademark limiting doctrines. Specifically, she refers to 15 U.S.C. § 1115(b)(4) (a.k.a. Section 33(b)(4) of the Lanham Act).²³² Section 33(b) refers to the “defenses or defects” to which marks are subject, even if they

²²⁷ *Id.* at 12 (emphases added).

²²⁸ See *supra* notes 102–103 and accompanying text.

²²⁹ *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 153 (2023) (“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.”); see also *id.* at 153 n.1 (“To be clear, when we refer to ‘the *Rogers* threshold test,’ we mean any threshold First Amendment filter.”).

²³⁰ *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 124 (2004) (“[A] plaintiff claiming infringement of an incontestable mark must show likelihood of consumer confusion as part of the prima facie case while the defendant has no independent burden to negate the likelihood of any confusion in raising the affirmative defense that a term is used descriptively, not as a mark, fairly, and in good faith.” (citations omitted)).

²³¹ Transcript, *supra* note 48, at 12–13 (emphasis added).

²³² *Id.* Blatt is also referring to the parallel dilution defense in 15 U.S.C. § 1125(c)(3)(A).

achieve incontestable status.²³³ These defenses reflect traditional common law limitations on trademark rights, and the Supreme Court has suggested that with respect to incontestable marks, the list is closed.²³⁴ For example, the list does not include an exclusion for descriptive marks that have not achieved secondary meaning.²³⁵ Secondary meaning is a requirement for trademark protection for descriptive marks,²³⁶ but what if the USPTO makes a mistake in its assessment of secondary meaning and grants a registration? And what if the mark becomes incontestable before the error can be tested in litigation? May a prospective defendant still challenge the mark as being a descriptive mark without secondary meaning?

In *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, the Supreme Court said no.²³⁷ The list is the list, and descriptiveness was left off.²³⁸ Given that, the court reasoned that allowing a defense based on the absence of secondary meaning would “effectively emasculate[]” Section 33(b).²³⁹

Blatt’s argument is in this vein. Her textual point of departure is the trademark “fair use” defense.²⁴⁰ As incorporated into the Lanham Act and interpreted by the Court,²⁴¹ the provision provides a defense to a trademark claim if the defendant’s purportedly infringing conduct “is a use, *otherwise than as a mark* . . . of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin”²⁴²

²³³ 15 U.S.C. §1115(b). A mark achieves incontestable status if it remains used in commerce for five years after registration provided certain conditions are met. 15 U.S.C. § 1065. 15 U.S.C. § 1065 also incorporates additional limitations from 15 U.S.C. § 1064.

²³⁴ *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 196 (1985).

²³⁵ See 15 U.S.C. § 1115(b).

²³⁶ See 15 U.S.C. § 1052(e)–(f).

²³⁷ 469 U.S. at 205.

²³⁸ *Id.* at 196.

²³⁹ *Id.* at 197.

²⁴⁰ The doctrine is sometimes called “classic fair use” as well as “descriptive fair use.” See MCCARTHY, *supra* note 16, § 11:45. Either way, it is an entirely different doctrine than copyright fair use, codified in 17 U.S.C. § 107.

²⁴¹ See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 114 (2004) (reading § 33(b)(4) as an affirmative defense).

²⁴² 15 U.S.C. § 1115(b)(4) (emphasis added).

One arguing against a trademark use requirement may leverage the italicized language above to claim that the statute precludes any threshold use requirement for trademark infringement claims. The logic is that if use as a mark is required for trademark infringement, then the fair use defense becomes a nullity as it, too, only applies if the defendant is not engaged in a trademark use. But if non-trademark uses are categorically non-infringing, then there is no need for the defense.²⁴³

Limiting trademark doctrines are therefore on precarious ground. Many existing doctrines are narrow,²⁴⁴ but their very existence may discourage judges from going further than what can be found in the statute, especially judges who are committed to narrow text-based interpretations that ignore the history of the Lanham Act and trademark law.²⁴⁵

3. External Limits and the First Amendment

There is still room to look elsewhere. *Rogers* is justified in part because it identifies a class of cases in which confusion is inherently unlikely—that is, it functions in part as an interpretation of the likelihood-of-confusion standard.²⁴⁶ This rationale is undermined by the

²⁴³ See Dinwoodie & Janis, *Confusion Over Use*, *supra* note 97, at 1106 (making this argument).

²⁴⁴ Recall, for example, that VIP also tried and failed to invoke the Ninth Circuit's nominative fair use doctrine. Perversely, considering that the district court found infringement in the end, this theory was rejected given the *differences* between VIP's product and the Jack Daniel's trade dress. See *VIP Prods. LLC v. Jack Daniel's Props., Inc.*, 953 F.3d 1170, 1174 (9th Cir. 2020) (affirming the district court's ruling on this point); see also *id.* (noting that the "nominative fair use defense did not apply where mark was 'not identical to the plaintiff's' mark" (quoting *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008))).

²⁴⁵ See *infra* Section II.D.

²⁴⁶ See *supra* note 68 and accompanying text. This is also how the nominative fair use doctrine functions in the Ninth Circuit. See, e.g., *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1182 (9th Cir. 2010) ("A finding of nominative fair use is a finding that the plaintiff has failed to show a likelihood of confusion as to sponsorship or endorsement."); *id.* at 1183 ("A defendant seeking to assert nominative fair use as a defense need only show that it used the mark to refer to the trademarked good The burden then reverts to the plaintiff to show a likelihood of confusion."). In the Third Circuit, it is a true defense, see *Century 21 Real Est. Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 222 (3d Cir. 2005), placing its doctrinal foundation on shakier ground. See *Things Are Worse Than We*

view that trademark disputes are purely factual.²⁴⁷ Sure, a trademark plaintiff may argue, “perhaps expressive uses tend to not be confusing, but *this* one is—after all, I have a survey!”²⁴⁸ Then there are external doctrines of general applicability²⁴⁹—like standing,²⁵⁰ the pleading requirements of *Twombly/Iqbal*,²⁵¹ the zone of interests test,²⁵² and, most importantly to the *Rogers* test, the First Amendment—that courts have used to limit trademark claims.²⁵³

Jack Daniel's throws some of that into doubt. In oral argument, Blatt's claim that *Rogers* is atextual²⁵⁴ prompted the question whether *Rogers* is rooted in the need to avoid interpreting the Lanham Act to conflict with the First Amendment.²⁵⁵ Blatt responded, “[w]ell, then you should strike the statute as either facially invalid or as applied to a dog toy.”²⁵⁶ This all-or-nothing view seemed to play off of the Justices' desire to avoid addressing First Amendment issues in the Lanham Act's treatment of noncommercial speech.

Think, supra note 134, at 960–62. The doctrine is arguably subject to the same challenges as *Rogers*. Justice Alito offered the Solicitor General's attorney a nominative use fact pattern, and he replied, as with other potential trademark abuses, with the claim that consumers would not be confused (though remaining circumspect about whether a 12(b)(6) dismissal would be possible). Transcript, *supra* note 48, at 56–57.

²⁴⁷ See *supra* Section II.B.3.

²⁴⁸ As Cooper explicitly argued by observing that “[t]he problem . . . that *Rogers* recognized is, to paraphrase my opposing counsel, but we've got a survey.” Transcript, *supra* note 48, at 86.

²⁴⁹ See Michael Grynberg, *The Judicial Role in Trademark Law*, 52 B.C. L. REV. 1283, 1309 (2011) [hereinafter *The Judicial Role in Trademark Law*].

²⁵⁰ See, e.g., *TocMail, Inc. v. Microsoft Corp.*, 67 F.4th 1255, 1267 (11th Cir. 2023).

²⁵¹ See MCCARTHY, *supra* note 16, § 32:121.75. Blatt referred to this possibility in her rebuttal argument. See Transcript, *supra* note 48, at 95.

²⁵² See, e.g., *Lexmark Int'l, Inc. v. Static Components, Inc.*, 572 U.S. 118, 129–31 (2014).

²⁵³ Compare Transcript, *supra* note 48, at 6–7 (statement of Blatt) (“There's no way to keep *Rogers* and be faithful to the text”), with *id.* at 32–33 (statement of Alito) (“[Y]ou began by saying—by stressing that *Rogers* is atextual, it was made up. You know, there is a text that says that Congress shall make no law infringing the freedom of speech. That's a text that takes precedence over the Lanham Act.”).

²⁵⁴ *Id.* at 4 (“*Rogers* doesn't plausibly construe any text . . .”).

²⁵⁵ Given that the First Amendment is part of the ultimate text, as Justice Alito noted. *Id.* at 32–33 (“You know, there is a text that says that Congress shall make no law infringing the freedom of speech. That's a text that takes precedence over the Lanham Act.”).

²⁵⁶ *Id.* at 34. She later clarified that an as-applied challenge to the Lanham Act's application was possible. *Id.* at 36.

For his part, VIP's attorney tried to raise the noncommercial speech issue, arguing that "in this case, the parody is not proposing a transaction of anything because there is no parodic product. There is no bottle of poo. It's simply making a joke and the joke is non-commercial."²⁵⁷ This led to some talking-past-each-other exchanges with Justices Sotomayor and Thomas.²⁵⁸

The final opinion left the issue alone, but it does take up the argument that the expressive/artistic use distinction cannot bear weight.²⁵⁹ Instead of limiting trademark's scope, however, Justice Kagan uses the observation to *contract* a defensive doctrine.²⁶⁰ The opinion notes the creativity that goes into a mark like the one for Frangelico liqueur as evidence that trademark law cannot exclude expressive uses from potential liability.²⁶¹ From there, the Court then fell back into the argument, discussed above, that handling the issues in ordinary trademark litigation is acceptable, at least where a use is source identifying.²⁶²

4. An Ominous Concurrence

The view that the open text of the Lanham Act's liability provisions cannot be disciplined by other bodies of law would radically upset trademark law's current equilibrium. Three Justices at least seem open to the idea. Justice Gorsuch, joined by Justices Barrett and Thomas, concurred to warn that "it is not entirely clear where the *Rogers* test comes from—is it commanded by the First

²⁵⁷ *Id.* at 89. He also argued that the Lanham Act's tarnishment provisions are viewpoint discrimination. *Id.* at 91 ("[D]ilution by tarnishment is unconstitutional viewpoint discrimination. . . . [Y]ou'll be enjoined if you tarnish but not if you burnish.").

²⁵⁸ *See generally id.* at 89–93.

²⁵⁹ *See supra* note 67.

²⁶⁰ *See* Tushnet, *supra* note 28, at 42 ("Explicitly limiting noncommercial trademark infringement claims to situations that meet the fraud pattern—direct competition between the parties plus deception that is material to a substantial number of consumers—could remind courts that trademark law now prohibits immaterial confusion among a small percentage of consumers who are not deciding between two competing products.").

²⁶¹ *See* *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 158 (2023) ("On that view, *Rogers* might take over much of the world.").

²⁶² *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.").

Amendment, or is it merely gloss on the Lanham Act, perhaps inspired by constitutional-avoidance doctrine?”²⁶³ Moreover, “it is not obvious that *Rogers* is correct in all its particulars.”²⁶⁴ Because “[a]ll this remains for resolution another day,” the concurrence invites lower courts to “be attuned to that fact.”²⁶⁵

The concurrence’s uncertainty shows the danger textualism poses to doctrines that might limit trademark’s scope. It is not simply that new defensive doctrines—like a materiality requirement—will be hard to come by. Rather, because of imbalanced statutory drafting (open liability language coupled with narrow defenses), the Lanham Act could be read to instantiate a vision of trademark law completely alien to its common law roots, which did not implement a general cause of action for permission confusion.²⁶⁶ Unfortunately, the Supreme Court only has an intermittent interest in using trademark’s history to cabin the Lanham Act’s open text.²⁶⁷ The *Jack Daniel’s* oral argument and opinion show a Court that is barely aware of the issue, let alone inclined to remedy it.

D. Extreme Textualism and Drive-by Dilution Rulings

These concerns go beyond the Gorsuch concurrence. *Jack Daniel’s* shows a Court willing to apply rigid textualism in analyzing the noncommercial use exclusion to the dilution cause of action.²⁶⁸

Both the oral argument and opinion treated dilution as something of an afterthought. This is perhaps unsurprising given the fundamental importance of the *Rogers* issue, but the issue merited more attention than it received (and, indeed, is receiving in this piece).

Recall that the district court concluded that the Bad Spaniels toy was likely to tarnish the Jack Daniel’s famous mark and trade dress because of negative associations with dog excrement.²⁶⁹ The Ninth

²⁶³ *Id.* at 165 (Gorsuch, J., concurring).

²⁶⁴ *Id.*

²⁶⁵ *Id.*

²⁶⁶ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 4 cmt. b (AM. L. INST. 1995).

²⁶⁷ See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992); see also *infra* notes 309–319 and accompanying text. *But compare* *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 31–34 (2003).

²⁶⁸ 15 U.S.C. § 1125(c).

²⁶⁹ See *VIP Prods., LLC v. Jack Daniel’s Prods., Inc.*, 291 F. Supp. 3d 891, 904–05 (D. Ariz. 2018) (“[H]uman consumption and canine excrement do not mix.”).

Circuit reversed the ruling based on the Lanham Act's dilution exclusion for noncommercial trademark uses.²⁷⁰

The court was applying existing Ninth Circuit precedent that interpreted the provision to treat mixed uses as noncommercial.²⁷¹ To illustrate the court's logic, consider the title of a song like "Barbie Girl," the subject of the earlier *Mattel* case.²⁷² In *Mattel*, the court explained that it faced a puzzle. On the one hand, the song title is commercial in that it identifies the song in the marketplace; someone seeking to buy the song may ask or search for it by name.²⁷³ On the other, it is noncommercial because writing and recording a song is a creative act that is expressive in ways that have nothing to do with commercial activity.²⁷⁴ So which is it?²⁷⁵

With respect to "Barbie Girl," *Mattel* notes the importance of providing breathing room for expressive interests in the dilution context.²⁷⁶ In ordinary trademark cases involving source confusion, enforcement of trademark rights poses little danger to expressive

²⁷⁰ See *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170, 1176 (9th Cir. 2020); see also 15 U.S.C. § 1125(c)(3)(C).

²⁷¹ See *id.* ("[U]se of a mark may be 'noncommercial' even if used to 'sell' a product." (quoting *Nissan Motor Co. v. Nissan Comput. Corp.*, 378 F.3d 1002, 1017 (9th Cir. 2004))); *Mattel, Inc. v. MCA Recs.*, 296 F.3d 894, 906 (9th Cir. 2002).

²⁷² See *Mattel*, 296 F.3d at 899.

²⁷³ *Id.* at 903 ("We are also satisfied that the song amounts to a 'commercial use in commerce.' . . . [That language] refers to a use of a famous and distinctive mark to sell goods other than those produced or authorized by the mark's owner. That is precisely what MCA did with the Barbie mark: It created and sold to consumers in the marketplace commercial products (the Barbie Girl single and the *Aquarium* album) that bear the Barbie mark." (citation omitted)).

²⁷⁴ *Id.* at 902 ("[T]he 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 Aqua claims she represents.").

²⁷⁵ *Id.* at 904 ("A 'noncommercial use' exemption, on its face, presents a bit of a conundrum because it seems at odds with the earlier requirement that the junior use be a 'commercial use in commerce.' If a use has to be commercial in order to be dilutive, how then can it also be noncommercial so as to satisfy the exception of section 1125(c)(4)(B)? If the term 'commercial use' had the same meaning in both provisions, this would eliminate one of the three statutory exemptions defined by this subsection, because any use found to be dilutive would, of necessity, not be noncommercial.").

²⁷⁶ *Id.* at 905 ("[A] trademark injunction, even a very broad one, is premised on the need to prevent consumer confusion. This consumer protection rationale—averting what is essentially a fraud on the consuming public—is wholly consistent with the theory of the First Amendment, which does not protect commercial fraud.").

speech if claims are confined to stopping passing off.²⁷⁷ Potential remedies are accordingly limited.²⁷⁸ But the dilution cause of action operates *regardless* of whether the trademark use is misleading or causes a likelihood of confusion.²⁷⁹ It therefore reaches a good deal further than ordinary trademark infringement and potentially targets a broader range of First Amendment-protected activities.²⁸⁰

Given that, and the court's review of the dilution statute's legislative history and local case law defining commercial speech,²⁸¹ *Mattel* interprets noncommercial use to cover speech that was not "purely commercial."²⁸² This is the holding the Ninth Circuit would later apply to protect the Bad Spaniels chew toy.²⁸³

Jack Daniel's rejects this interpretation as a textual matter, at least as applied to a parody that uses protected matter as a mark.²⁸⁴ The Court reserves the question of whether use of a mark to sell a product may nonetheless be noncommercial.²⁸⁵ The Ninth Circuit was nonetheless wrong to treat VIP's use as noncommercial because

²⁷⁷ *Id.*

²⁷⁸ *Id.* at 904 ("A trademark injunction is usually limited to uses within one industry or several related industries.").

²⁷⁹ *Id.* at 904–05 ("Dilution law . . . seeks to protect the mark from association in the public's mind with wholly unrelated goods and services. The more remote the good or service associated with the junior use, the more likely it is to cause dilution rather than trademark infringement. A dilution injunction, by contrast to a trademark injunction, will generally sweep across broad vistas of the economy."); see 15 U.S.C. § 1125(c)(1) (Where a likelihood of dilution exists, injunctive relief is available "regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.").

²⁸⁰ See *Mattel*, 296 F.3d at 905 ("Dilution, by contrast, does not require a showing of consumer confusion, and dilution injunctions therefore lack the built-in First Amendment compass of trademark injunctions." (citation omitted)); *id.* (terming dilution prevention a "less weighty" interest than that of preventing trademark infringement).

²⁸¹ *Id.* at 905–06.

²⁸² *Id.* at 906; see also *id.* ("If speech is not 'purely commercial'—that is, if it does more than propose a commercial transaction—then it is entitled to full First Amendment protection." (citation omitted)).

²⁸³ *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170, 1176 (9th Cir. 2020) ("Although VIP used JDPI's trade dress and bottle design to sell Bad Spaniels, they were also used to convey a humorous message. That message . . . is protected by the First Amendment.").

²⁸⁴ See *Jack Daniel's Prods., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 145 (2023) ("The use of a mark does not count as noncommercial just because it parodies, or otherwise comments on, another's products.").

²⁸⁵ *Id.* at 162.

of its parodic nature: “However wide the scope of the ‘noncommercial use’ exclusion, it cannot include, as the Ninth Circuit thought, every parody or humorous commentary.”²⁸⁶

Why not? Tracking the fair use issue discussed above,²⁸⁷ the opinion explains that the Lanham Act’s dilution provision includes a fair use defense that “specifically covers uses ‘parodying, criticizing, or commenting upon’ a famous mark owner.”²⁸⁸ And, like the fair use defense for infringement,²⁸⁹ it is unavailable if the defendant’s use is as a designation of source.²⁹⁰

Reading this provision together with the noncommercial use exclusion, the Supreme Court reasoned that the fair use language *must* be a constraint on the noncommercial use exclusion as a matter of logic.²⁹¹ After all, if the noncommercial exclusion protects VIP’s parodic use *as a mark*,²⁹² then the fair use provision in the dilution statute—which only excludes uses if they *are not uses as a mark*—becomes superfluous. As Justice Kagan puts it:

Given the fair-use provision’s carve-out, parody (and criticism and commentary, humorous or otherwise) is exempt from liability only if *not* used to designate source. Whereas on the Ninth Circuit’s view, parody (and so forth) is exempt always—regardless whether it designates source. The expansive view of the “non-commercial use” exclusion effectively nullifies Congress’s express limit on the fair-use exclusion for parody, etc.²⁹³

The problem, she adds, can be seen in this case, given that the district court had ruled that VIP could not claim the fair-use parody

²⁸⁶ *Id.*

²⁸⁷ *See supra* Section II.C.2.

²⁸⁸ *Jack Daniel’s Props.*, 599 U.S. at 162 (quoting 15 U.S.C. § 1125(c)(3)(A)(ii)).

²⁸⁹ 15 U.S.C. § 1115(b)(4).

²⁹⁰ *Id.* (“In that event, no parody, criticism, or commentary will rescue the alleged dilutor. It will be subject to liability regardless.”).

²⁹¹ *Id.*

²⁹² Recall that the Court determined—in my view incorrectly, but nonetheless definitively—that VIP’s use was use as a mark. *See supra* Section II.A.3.

²⁹³ *Jack Daniel’s Props.*, 599 U.S. at 162.

exclusion because of VIP's trademark use.²⁹⁴ "The Ninth Circuit took no issue with that ruling. But it shielded VIP's parodic uses anyway. In doing so, the court negated Congress's judgment about when—and when not—parody (and criticism and commentary) is excluded from dilution liability."²⁹⁵

The reading is arguable,²⁹⁶ but it is most plausible if it is considering a statute that was drafted and enacted all at once as a unified whole. But that's not the Lanham Act, which has been subject to numerous amendments and additions since its initial passage in 1946.²⁹⁷ The statute's dilution provisions were one such addition. Congress added them—albeit without language specifying tarnishment as a cause of action—in 1996 via the Federal Trademark Dilution Act of 1995 ("FTDA").²⁹⁸ This was the language that the Ninth Circuit interpreted in *Mattel*.²⁹⁹ There was no parody exception in this version of the FTDA,³⁰⁰ but the noncommercial use exclusion was there from the start.³⁰¹

²⁹⁴ *Id.*

²⁹⁵ *Id.*

²⁹⁶ For an argument to the contrary that contends the Court's reading is "nonsense," see Mark A. Lemley & Rebecca Tushnet, First Amendment Neglect in Supreme Court Intellectual Property Cases 22–23 (Jan. 11, 2024) (unpublished manuscript) (available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4691950).

²⁹⁷ To list just the history of amendments to Section 43, which contains, among other things, the federal dilution cause of action, see ch. 540, § 43, 60 Stat. 427, 441 (1946) (codified as amended at 15 U.S.C. § 1125); Trademark Law Revision Act of 1988, Pub. L. No. 100-667, § 132, 102 Stat. 3935, 3946 (1988); Trademark Remedy Clarification Act, Pub. L. No. 102-542, § 3(c), 106 Stat. 3567, 3568 (1992); Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, § 3(a), 109 Stat. 985 (1996); Trademark Amendments Act of 1999, Pub. L. No. 106-43, §§ 3(a)(2), 5, 113 Stat. 218, 219, 220 (1999); Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, Div. B, § 1000(a)(9), 113 Stat. 1501, 1536, 1501A-545 (1999); Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, § 2, 120 Stat. 1730 (2006); Pub. L. No. 112-190, § 1(a), 126 Stat. 1436 (2012).

²⁹⁸ See Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985.

²⁹⁹ *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 903 (9th Cir. 2002).

³⁰⁰ There was, however, an exception for "[f]air use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark." Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, § 3, 109 Stat. 985, 986 (1996). This would be a commercial use, targeting commercial speech, and therefore fully consistent with the Ninth Circuit's interpretation of the noncommercial use exclusion.

³⁰¹ *Id.*

Congress later enacted the Trademark Dilution Revision Act of 2006 (“TDRA”), which added the parody exclusion but retained the preexisting language on noncommercial use without modification.³⁰² The TDRA existed to undo a Supreme Court ruling that had read the dilution cause of action too narrowly for Congress’s tastes.³⁰³ The amendment therefore established that dilution plaintiffs need only establish that a defendant’s conduct is likely to cause dilution; proof of actual dilution is unnecessary.³⁰⁴ It also defined the respective dilution causes of action of tarnishment and blurring, clarifying that tarnishment was a viable theory in the face of disagreement among the circuits on the question.³⁰⁵

This background sheds light on the purpose of the fair use parody defense. The planned expansion of the scope of antidilution rights prompted concerns about the potential burden on expressive speech, which in turn led the drafters to add the defense in response.³⁰⁶ A prepared statement by Representative Howard Berman, Ranking Member of Subcommittee on Courts, the Internet, and Intellectual Property, explained:

However, most importantly, an amendment was adopted in Subcommittee to address the First Amendment and free speech issues that were raised at the hearing. The ACLU voiced concerns about the possibility that critics could be stifled by the threat of an injunction for mere likelihood of tarnishment. Furthermore, they were concerned with the balance between the rights of trademark holders and the First Amendment. ACLU joined with INTA and AIPLA in crafting a separate exemption from a dilution cause of action for parody, comment and criticism.³⁰⁷

In other words, Congress’s apparent intent regarding the parody exclusion was to *limit* the dilution cause of action rather than *expand*

³⁰² Trademark Dilution Revision Act of 2006, 15 U.S.C. § 1125(c).

³⁰³ See *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 433 (2003).

³⁰⁴ See H.R. REP. NO. 109-23, at 2, 4 (2006).

³⁰⁵ See *id.* at 6.

³⁰⁶ *Id.* at 25.

³⁰⁷ *Id.*

it. There was no indication in any legislative history that I have been able to find that the final version was meant to undo *Mattel's* interpretation of the noncommercial use exception. That statutory language was retained without amendment together with the additional defense.³⁰⁸ Perversely, however, the *addition* of a particular dilution defense would, seventeen years later, result in the *contraction* of dilution defenses in general. The Court effectively read the new parody defense as a de facto amendment that implicitly redefined the noncommercial exclusion.

Nothing in the *Jack Daniel's* opinion or oral argument shows any awareness among the Justices of this issue. The opinion treats the Lanham Act as a statute that was enacted all at once and whose provisions should be read accordingly. To be sure, there are arguments in favor of the Court's approach. First, the all-at-once treatment of the Lanham Act's dilution provisions is arguably fair because the TDRA was a full rewrite of the dilution provisions of

³⁰⁸ There was an effort by trademark interests to remove the noncommercial use exclusion given its interpretation by *Mattel*. See Paul Alan Levy, *The Trademark Dilution Revision Act—A Consumer Perspective*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1189, 1209–10 (2006) (“[I]t was apparent that the sponsoring organizations had [*Mattel*] squarely within their sights as a reason to eliminate the ‘non-commercial use’ exception.”). For a time, it seemed that the noncommercial use exclusion might be replaced by a fair use provision. Levy recounts:

The non-commercial use defense was originally part of the bill as introduced in the House but was deleted from the bill, as part of a change that was responsive to criticism from the ACLU that the “non-commercial use” exception did not provide enough protection to commercial speech. The non-commercial use defense was replaced by an express fair use provision that protected “[f]air use of a famous mark by another person, other than as a designation of source for that person’s goods or services, including for purposes of identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.” Although this exception was plainly written with free speech considerations in mind, and standing alone was plainly a desirable addition to the bill, as a substitute for the non-commercial use exception it was actually worse from the perspective of any ordinary citizen who must face the realities of litigation

Id. at 1208 (citations omitted). Given the shortcomings of the fair use provision standing alone, “we were relieved when, on the eve of the Senate Judiciary Committee’s markup, the Senators agreed to restore the non-commercial use exception to section 43(c)(3).” *Id.* at 1211–12.

Section 43(c).³⁰⁹ Although the noncommercial use language was unchanged, it was technically enacted at the same time as the parody defense.³¹⁰ Second, given the dim views of many on the Court of the relevance of legislative history,³¹¹ perhaps Congress's purposes in enacting the parody defense is irrelevant in light of the Court's duty "to give effect, if possible, to every clause and word of a statute."³¹² Third, maybe the Court thinks that the Ninth Circuit's ruling in *Mat-tel* was just wrong.

Fine. But the fact that the Supreme Court could not be bothered to articulate any of those—or other—arguments suggests a failure to appreciate the Lanham Act for what it is. The statute is an incomplete codification of a rich body of common law originating from both state and (pre-*Erie*) federal courts that has been subject to haphazard amendment over time by a Congress that has traditionally been content to let courts fill the gaps in its handiwork.³¹³ This may

³⁰⁹ See Trademark Dilution Revision Act of 2006, 15 U.S.C. § 1125(c).

³¹⁰ But see *Minerva Surgical, Inc. v. Hologic, Inc.*, 141 S. Ct. 2298, 2317 n.4 (2021) ("Congress is presumed to be aware of [a] judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change." (citing *Lorillard v. Pons*, 434 U.S. 575, 580 (1978))); *Lamar, Archer & Cofrin, LLP v. Appling*, 138 S. Ct. 1752, 1762 (2018) (Congress is presumed to be aware of a prior judicial interpretation of a statute when it uses "the materially same language" in a subsequent statute.).

³¹¹ Unsurprisingly, the opinion made no mention of recent legislative history endorsing *Rogers* as it has been applied. H.R. REP. NO. 116-645, at 20 (2020) ("In enacting this legislation, the Committee intends and expects that courts will continue to apply the *Rogers* standard to cabin the reach of the Lanham Act in cases involving expressive works. The Committee believes that the adoption by a court of a test that departs from *Rogers* . . . would be contrary to the Congressional understanding of how the Lanham Act should properly operate to protect important First Amendment considerations, and upon which the Committee is relying in clarifying the standard for assessing irreparable harm when considering injunctive relief.").

³¹² *Students for Fair Admissions, Inc. v. President & Fellows of Harvard Coll.*, 143 S. Ct. 2141, 2220 (2023) (Gorsuch, J., concurring) (quoting *Montclair v. Ramsdell*, 107 U.S. 147, 152 (1883)).

³¹³ See, e.g., S. REP. NO. 100-515, at 21 (1988) ("Section 35 [of the Trademark Law Revision Act of 1988] revises Section 43(a) of the Act (15 U.S.C. [§] 1125(a)) to codify the interpretation it has been given by the courts. Because Section 43(a) of the Act fills an important gap in federal unfair competition law, the committee expects the courts to continue to interpret the section."); cf. Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 COLUM. J.L. & ARTS 187, 198 (2004) ("The Lanham Act . . . is the type of delegating statute that adopts common law . . . [T]he statute's central provisions relating

be unsatisfying to the Court's more textually-minded Justices, but they should not ignore that reality while engaging in statutory construction.³¹⁴

Worse, this kind of drive-by textualism with respect to Lanham Act jurisprudence seems to be a trend. In *Romag Fasteners, Inc. v. Fossil, Inc.*, the Court used a similar approach to conclude that the Lanham Act allows plaintiffs to recover profits absent a finding that the defendant acted willfully.³¹⁵ Section 35 of the Lanham Act states that profits may be awarded in an infringement action according to the "principles of equity."³¹⁶ This provision was part of the original Lanham Act as passed in 1946.³¹⁷ Do those principles include willfulness for the award of profits? The Court concluded that the background principles in place upon the Lanham Act's enactment regarding willfulness were unclear.³¹⁸ So much for the common law backdrop against which Congress legislated.³¹⁹

to the regulation of the marketplace are astonishingly brief. They consist of a few vague phrases: 'exclusive right to use,' 'use which is likely to cause confusion' and 'false designation of origin.' By those phrases, the statute adopts and stands for the complete common law development, representing a complexity of doctrine which would require dozens of pages to set forth in full." (citations omitted)).

³¹⁴ Compare, for example, Judge Leval's examination of what the Lanham Act means when it uses the phrase "use in commerce," which is relevant to the (newly germane!) question of what constitutes a source-identifying use of a mark. See generally *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123 (2d Cir. 2009). Judge Leval undertook a ten-page study of the evolution of the term under the Lanham Act in an effort to interpret the effect of Congress's shifting language choices in an effort to clarify the issue for the courts (and to encourage Congress to weigh in). *Id.* at 131–41. The effort did not deny the primacy of the text, but rather recognized the complexity inherent on determining what the Lanham Act "says" given its iterative nature. *Id.* at 139.

³¹⁵ *Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S. Ct. 1492, 1495–96 (2020).

³¹⁶ 15 U.S.C. § 1117(a).

³¹⁷ Pub. L. No. 79-489, § 35, 60 Stat. 427, 439–40 (1946). The original language of § 1117 only applied to actions for infringement of registered marks, which arises under Section 32, 15 U.S.C. § 1114. The cause of action in *Romag Fasteners*, 140 S. Ct. at 1495 was based instead on Section 43(a), 15 U.S.C. § 1125(a), but Congress clarified in 1988 that all § 1117 remedies are applicable to a Section 43(a) claim. See Trademark Law Revision Act of 1988, Pub. L. No. 100-667, § 129, 102 Stat. 3935, 3945 (1988).

³¹⁸ *Romag Fasteners*, 140 S. Ct. at 1496–97.

³¹⁹ For a critique, see Mark A. Lemley, *Chief Justice Webster*, 106 IOWA L. REV. 299, 307–08 (2020) [hereinafter *Chief Justice Webster*] ("[I]n *Romag v. Fossil*, the Supreme Court turned to a dictionary to throw out centuries of equity precedent that had required conscious wrongdoing before awarding disgorgement of profits as a remedy, dismissing

As relevant here, *Romag Fasteners* reached its result in large part by focusing on later-enacted language regarding dilution remedies, which *do* include a willfulness requirement.³²⁰ To the Court, that implies that willfulness is *not* a general requirement for a profits award. But if the “principles of equity” language at issue in *Romag* would have been read in 1946 as requiring willfulness, would the 1999 addition of dilution language count as a rewrite?³²¹ Is it fair to read that text as telling us anything about Congress’s view of background principles in place fifty years before?³²² The prospect does not seem to have been on the radar of the drafters of the dilution amendment,³²³ but *Romag Fasteners* treats them as speaking to the matter.

The Court did not acknowledge the question, preferring to hallucinate a careful plan in the Lanham Act’s remedial provisions.³²⁴

the trademark statute’s express adoption of those ‘principles of equity’ with the curious argument that congressional use of the term ‘principles,’ per Black’s Law Dictionary, must mean that they were more guidelines than actual rules and thus could safely be ignored.”).

³²⁰ 15 U.S.C. § 1117(a). The Court was aware of the timeline. *See Romag Fasteners*, 140 S. Ct. at 1495 (observing that the willfulness language for dilution was “added to the Lanham Act some years after its initial adoption”).

³²¹ *See* Trademark Amendments Act of 1999, Pub. L. No. 106-43, 113 Stat. 218 (1999).

³²² *See, e.g.,* *Minerva Surgical, Inc. v. Hologic, Inc.*, 141 S. Ct. 2298, 2317 n.4 (2021) (discussing presumption against implied repeal).

³²³ The legislative history indicates that Congress’s purpose was focused on the availability of dilution remedies generally, as the initial federal dilution statute neglected to include remedies for dilution in Section 1117 despite referring to them elsewhere. *See* H.R. REP. NO. 106-250, at 6 (1999) (“Therefore, in an attempt to clarify Congress’ intent and to avoid any confusion by courts trying to interpret the statute, [the amendment] makes the appropriate changes . . . to allow for injunctive relief and damages.”). The provision seeks “to clarify that in passing the Dilution Act, Congress did intend to allow for injunctive relief and/or damages against a defendant found to have willfully intended to engage in commercial activity that would cause dilution of a famous trademark.” *Id.* The provision “clarif[ies] that recovery of profits, damages and costs, and attorneys fees *are also* available for a willful violation” of the dilution statute.” *Id.* at 10 (emphasis added).

³²⁴ “Without doubt, the Lanham Act exhibits considerable care with *mens rea* standards.” *Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S. Ct. 1492, 1495 (2020). Likewise, the Court supported its interpretation of Section 1117 by citing a number of other post-1946 additions to the Lanham Act that alluded to *mens rea*. *See id.* at 1495–96. Having done so, the Court acts as if the current version of the Lanham Act sprung fully formed from Congress’s skull. Though reliance on the “principles of equity” argument would not contradict these other provisions, “it would require us to assume that Congress intended to incorporate a willfulness requirement here obliquely while it prescribed *mens rea* conditions expressly elsewhere throughout the Lanham Act.” *Id.*

The result in *Romag*, as in *Jack Daniel's*, invites judges to apply the statutory language rigidly and without consideration of context.³²⁵ In other areas, the approach invites extreme legal claims—like the one that would treat Congress's zeroing out the tax penalty for failure to carry insurance as an effective repeal of the Affordable Care Act.³²⁶ It treats lawmaking as a game of Jenga.³²⁷ One wrong move and Congress may cause a statutory scheme to collapse.

E. *Brand Solitude*

A fascinating aspect of *Jack Daniel's* was the steady effort by Jack Daniel's to personify its brand, at least when it wasn't claiming *in rem* property rights.³²⁸ Its opening brief claimed, for example, that "Jack Daniel's loves dogs and appreciates a good joke as much as anyone. But Jack Daniel's likes its customers even more and doesn't want them confused or associating its fine whiskey with dog poop."³²⁹ The effort continued in oral argument. Blatt began her rebuttal by arguing that:

³²⁵ Cf. Chief Justice Webster, *supra* note 319, at 308 ("As the Court deemphasizes the traditional sources of statutory interpretation—legislative history, precedent, context, and the rules of statutory construction—it is casting about for something other than *ipse dixit* to take their place. The dictionary seems like a definitive source for the thing the Court is desperately looking for—a clear, plain meaning for statutory terms that has eluded lower courts and the parties."). The Court's recent approach is in some tension with the claim by textualism's defenders that the approach is more than mere literalism, however absurd. Compare John F. Manning, *Textualism and the Equity of the Statute*, 101 COLUM. L. REV. 1, 108 (2001) (defending textualism by arguing that "[m]odern textualists . . . are not literalists"), with Ryan D. Doerfler, *Late-Stage Textualism*, 2021 SUP. CT. REV. 267, 269 (2021) ("In numerous cases this Term, the Court's statutory analysis received derisive commentary from scholars and journalists, having displayed the very sort of 'wooden[ness]' that textualism had been caricatured with by its opponents for so many years." (quoting Antonin Scalia, *Common-Law Courts in a Civil-Law System: The Role of United States Federal Courts in Interpreting the Constitution and Laws*, in A MATTER OF INTERPRETATION: FEDERAL COURTS AND THE LAW 3, 23 (Amy Gutmann ed., 1997))).

³²⁶ See generally *California v. Texas*, 141 S. Ct. 2104 (2021).

³²⁷ *Jenga*, WIKIPEDIA, <https://en.wikipedia.org/wiki/Jenga> [<https://perma.cc/FS22-RCC9>] (last visited Oct. 25, 2023).

³²⁸ See, e.g., Transcript, *supra* note 48, at 4 ("Trademarks are ancient property rights that necessarily restrict speech . . ."); *id.* at 7 ("[T]he consequence of having a property right is property owners are going to protect them . . .").

³²⁹ Brief for Petitioner, *supra* note 7, at 3.

. . . all trademarks are expressive. They have speech rights. And every time you infringe them, it's going to implicate speech by definition.

And what the other side and I don't hear you guys talking about is the half of speech that no one likes, the pornography and the poison. And it is hard for me to see how you can say that the trademark owner doesn't have an interest in something that approaches compelled speech if their mark has been using in porn films and porn toys and sex toys and people are profiting off of that.³³⁰

There's a metaphorical beating heart here, but the sympathy elicited is not for a person—who under the right circumstances may be able to invoke the right of publicity—but rather for a brand. To Blatt, what should trigger our disgust vis-à-vis treatment of a person is self-evidently the same when the brand is the victim. So it is that a poop joke about a bottle of whiskey is a step along a slippery slope that ends in “the *pornographic and poisonous* things that could be done when you infringe someone's trademark.”³³¹ Won't someone please think of the ~~children~~ trademarks?

What's interesting, however, is not so much the reception to the argument, but that it was made. Lisa Blatt is a leading appellate advocate who has argued over forty cases to the Supreme Court.³³² Her sense of what is rhetorically effective with the Justices is self-

³³⁰ Transcript, *supra* note 48, at 94.

³³¹ Transcript, *supra* note 48, at 26 (emphasis added); *see id.* at 25–26 (“[T]he movie ‘Debbie Does Dallas’ was not aesthetically pleasing. It infringed a trademark. It infringed someone's property rights, and it was diluting.”). This echoes her invocation, earlier in the argument, of a pre-*Rogers* trademark case involving a pornographic movie that evoked the DALLAS COWBOYS trademarks to show the purported dangers of the *Rogers* test to brands and the need for trademark claims to reach beyond source identification. *Id.* at 14 (“The famous film pre-*Rogers* case, the Dallas Cowboy Cheerleaders involving 12 minutes of graphic sex involving a trademark, was not a source identifier. It was just a very confusing use of a trademark.”); *see generally* Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200 (2d Cir. 1979).

³³² *See Lisa S. Blatt, WILLIAMS & CONNELLY LLP*, <https://www.wc.com/Attorneys/Lisa-S-Blatt> [perma.cc/U6JQ-NUG2] (last visited Oct. 4, 2023).

evidently better than mine. Something about trademark rights activates strong moral intuitions for at least some part of the population. And not just any trademark. Not just any brand could have gotten the *Rogers* test before the Supreme Court. Jack Daniel's is a powerful brand because of its strong acquired (as opposed to inherent) distinctiveness; its broad identification is what makes courts so inclined to protect the company's merchandising interests.³³³

This leads to perverse results. Who else but a celebrity is going to be parodied or otherwise mocked? Presumably, the Justices would have no difficulty understanding the First Amendment implications of policing a poop joke about Donald Trump or Joe Biden. Cooper made this point for VIP, reminding the Justices that in "popular culture, iconic brands are another kind of celebrity. People are constitutionally entitled to talk about celebrities and, yes, even make fun of them."³³⁴

At least some of the Justices understood the problem of letting brands exercise too much power when the trademark is for a political party.³³⁵ But their interest seemed largely directed to finding a distinguishing principle that would handle *that case* while letting Jack Daniel's win here. Somehow, celebrity brands may demand more than their human counterparts.

To my mind, this was the real dog that didn't bark in the oral argument and opinion. In its brief to the court, Jack Daniel's claimed that, of course, it can take a joke.³³⁶ But, in fact, the basis of the case is that Jack Daniel's cannot, that it's somehow commercially harmful for the whiskey brand to do so, and the Supreme Court must help.³³⁷ Although some questioning pushed Jack Daniel's on whether consumers would ever believe that a company would

³³³ See *Living With the Merchandising Right*, *supra* note 57, at 74–76, 80–84.

³³⁴ Transcript, *supra* note 48, at 58.

³³⁵ See *supra* Section II.A.5.

³³⁶ See *supra* text accompanying note 329.

³³⁷ And companies often have no idea whether art hurts or helps their interests. Mattel sued over the "Barbie Girl" song, only to obtain a license to use it years later to promote Barbie. See Elva Ramirez, *Barbie's First Music Video Turns the Aqua Original on Its Head*, WALL ST. J.: L. BLOG (Aug. 28, 2009), <http://blogs.wsj.com/speakeasy/2009/08/28/barbie-model-astronaut-rock-star-marxist-theorist/> [perma.cc/UX92-P624].

intentionally create associations with disfavored subjects,³³⁸ the larger premise remained unchallenged. Jack Daniel's never had to justify the claim that a brand so powerful as to be the subject of a poop joke should naturally have the power to censor it.

It's unfortunate that such a fundamental assertion of power could be lost in a haze of accreted trademark doctrine. Jack Daniel's should not be permitted to have its proverbial cake and eat it too. After all, why was Jack Daniel's the butt of this joke? Because it's well known. VIP made jokes about it for the same reason anyone might. It's part of popular culture. It's on our mind.

And Jack Daniel's worked hard to be.³³⁹ Like Nike or Apple, Jack Daniel's is in our head because it has placed manifestations of its brand all over the place,³⁴⁰ hoping that we will see and remember it. But having shoved itself into the collective imagination, it wants to declare itself off-limits for certain kinds of jokes.

That's a power we would be very cautious about granting to a human being—imagine the reaction to Joe Biden or Donald Trump suing over a poop joke. It seems odd that an abstraction like a brand might be able to ask for more. This is hardly a new issue for trademark law.³⁴¹ *Jack Daniel's* suggests we must worry about it anew.

³³⁸ See Transcript, *supra* note 48, at 28–31.

³³⁹ Kozinski, *supra* note 17, at 975 (“Words and images do not worm their way into our discourse by accident; they’re generally thrust there by well-orchestrated campaigns intended to burn them into our collective consciousness. Having embarked on that endeavor, the originator of the symbol necessarily—and justly—must give up some measure of control. The originator must understand that the mark or symbol or image is no longer entirely its own, and that in some sense it also belongs to all those other minds who have received and integrated it.”).

³⁴⁰ See, e.g., *Jack Daniel's: Make it Count*, ADS OF THE WORLD, <https://www.adsoftheworld.com/campaigns/make-it-count> [<https://perma.cc/74PE-KJF2>] (last visited Oct. 25, 2023).

³⁴¹ See, e.g., Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 399 (1990); cf. Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1568 (1993) (“Or consider a landscape photographer. As each bit of the natural landscape is replaced by buildings, statues, and other human artifacts, the only way her interest in the common can remain ‘as good’ is if she is given the freedom to photograph her new surroundings.”).

CONCLUSION

I like to tell my students that studying trademark law offers an interesting perspective on judicial methodology. The Lanham Act creates any number of tricky interpretation questions that are made all the richer by the fact that the statute was enacted against a deep common law backdrop. Better still, the codification of the common law was incomplete, and—as *Jack Daniel's* shows—some of the gaps raise important questions of statutory interpretation and constitutional law.

That's true of any number of doctrines, of course. Trademark law also offers the additional feature (or bug) of relative judicial indifference. Judges, like most sane people, don't particularly care about trademark cases. Nobody's life or freedom is at stake, nobody runs for office on a trademark platform, and trademark disputes rarely activate political identities. They are therefore less likely to be resolved along the traditional divides that normally characterize hot-button Supreme Court cases. Instead, the biggest trademark case in years gets a unanimous opinion and a strange-bedfellows concurrence uniting Justices Sotomayor and Alito. Not only that, but despite the importance of *Jack Daniel's* to trademark doctrine, the First Amendment issues, and the fun subject matter, Justices Barrett and Kavanaugh stayed silent during argument, while Chief Justice Roberts asked just one clarifying question of the government's counsel.³⁴²

Given all that, trademark law offers a sandbox in which the Justices can freely apply their preferred methodologies of judging, free from public attention, contamination by competing ideological commitments, or pressure to maintain their “foolish consistencies.”³⁴³

From one perspective, the non-partisanship of the *Jack Daniel's* Court allowed it to model a judicial virtue. As the oral argument showed, the Justices struggled with some of the complexities of trademark law and the potential consequences of jettisoning *Rogers* altogether. The final opinion—whatever its faults—was self-consciously narrow. Rightly or wrongly, the Justices thought *Rogers*

³⁴² Transcript, *supra* note 48, at 38, 48, 58.

³⁴³ RALPH WALDO EMERSON, *Self-Reliance*, in *ESSAYS AND ENGLISH TRAITS* 63, 70 (Charles W. Eliot ed., 1909).

should not protect the Bad Spaniels chew toy, but they balked at the prospect of discarding the doctrine altogether. The self-restraint is sensible. Indeed, it stands in stark contrast to the Court's approach in other, more partisan and important cases.

But the oral argument, parts of the opinion, and the Sotomayor concurrence show that several Justices are at least aware of some of the deeper trademark questions under the surface. The expansion of trademark's domain in the almost-eighty years since the passage of the Lanham Act reflects numerous imbalances in trademark doctrine. The perverse aspect of *Jack Daniel's* is that it is the countervailing doctrine—which tries to keep trademark rights in their lane—that gets Supreme Court attention. Although that attention reveals deep problems with the scope of trademark rights, the judicial virtue of just answering the question at hand as narrowly as possible prevails. Judicial incentives independent of the task of adjudicating highly tangled and semi-autonomous doctrines keep the Court from doing anything about the underlying problem that created the need for the *Rogers* test in the first place.³⁴⁴ Another case, perhaps.

³⁴⁴ See generally *The Judicial Role in Trademark Law*, *supra* note 249.