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## Jack Daniel's Highlights the Second and Ninth Circuit's Divide on the Application of the Rogers Test

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# JACK DANIEL’S HIGHLIGHTS THE SECOND AND NINTH CIRCUIT’S DIVIDE ON THE APPLICATION OF THE ROGERS TEST

HANNAH KNAB\*

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## I. INTRODUCTION

On March 31, 2020, in *VIP Products LLC v. Jack Daniel's Properties, Inc.*,<sup>1</sup> the Ninth Circuit held that a dog toy was an “expressive work” and not a commercial product, thus entitling it to a heightened level of protection under the First Amendment and extending the use of the *Rogers* test. This decision diverged from the Second Circuit’s application of the Lanham Act, causing a difference in the application of the *Rogers* test.<sup>2</sup> Accordingly, Lanham Act plaintiffs in the Second Circuit are subjected to the *Rogers* test when the product is expressive but not when the product is commercial.<sup>3</sup>

The Second Circuit considers humor as one factor to determine whether a work is expressive rather than commercial.<sup>4</sup> Conversely, the Ninth Circuit, deems humor as per se expressive, and therefore applies the *Rogers* test broadly.<sup>5</sup> This bifurcated analysis of the Lanham Act will eventually require Supreme Court intervention.

In *VIP Products*, the Ninth Circuit ruled that VIP Products’ dog toy was an “expressive work” entitled to a heightened level of protection under the First Amendment and thus the Lanham Act.<sup>6</sup> The determination was rooted in VIP Products’ humorous use of the mark.<sup>7</sup> Accordingly, the court found the likelihood-of-confusion test was not the standard the district court should have relied on when interpreting the Lanham Act.<sup>8</sup>

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1. 953 F.3d 1170 (9th Cir. 2020).

2. See Quinn Emanuel Urquhart & Sullivan, LLP, *December 2019: Trademark & Copyright Litigation Update*, JD SUPRA (Jan. 3, 2020) [hereinafter *December 2019 Update*], <https://www.jdsupra.com/legalnews/december-2019-trademark-copyright-28229/> (describing how Ninth and Second Circuits deviate in their application of the *Rogers* test).

3. See, e.g., *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812–13 (2d Cir. 1999) (finding that when a product uses humor alone, it remains commercial and does not require the *Rogers* test as it is not an expressive work).

4. *Id.* at 812 (considering the “parody defense,” which allows for “considerable leeway to parodists whose expressive works aim their parodic commentary at a trademark or a trademarked product”).

5. Compare *id.* (finding that humor cannot be the only factor in determining whether a work is expressive), with *VIP Prods. LLC*, 953 F.3d at 1174–76 (finding that humor alone can constitute an expressive work).

6. *VIP Prods. LLC*, 953 F.3d at 1175–76.

7. See *id.* at 1174–75 (finding the toy an expressive work because it “communicates a ‘humorous message’ . . . using word play to alter the serious phrase that appears on a Jack Daniel’s bottle”).

8. See *id.* at 1174 (stating that the likelihood-of-confusion test fails to consider First Amendment freedom of expression in “artistic expression,” thus the *Rogers* test is required); see also David Muradyan, *Likelihood of Confusion Analysis Under the Lanham Act*, IP LAW BLOG (Aug. 15, 2012), <https://www.theiplawblog.com/2012/08/articles/trademark-law/likelihood-of-confusion-analysis-under-the-lanham-act/> (listing the likelihood-of-confusion factors: “(1) strength of the mark, (2) proximity [of]

The Ninth Circuit's decision to define a dog toy as an expressive work because of its humorous mark places the issue of whether a product should be looked at as commercial or expressive at the forefront. If humor is sufficient to define a work as expressive, plaintiffs are unduly burdened in trademark issues.<sup>9</sup> This use of "expressive work" also enables courts to over-apply the *Rogers* test, a very high threshold to pass.<sup>10</sup> The Ninth Circuit's decision to bypass any consideration of the likelihood-of-confusion test creates very stringent criteria for any plaintiff claiming unfair use or trademark infringement.<sup>11</sup>

The Second Circuit created the *Rogers* test under the Lanham Act and has been consistent in its interpretation,<sup>12</sup> being careful not to expand its use to commercial products.<sup>13</sup> The Second Circuit also maintains the purpose of the Lanham Act by utilizing the likelihood-of-confusion analysis before applying the *Rogers* test.<sup>14</sup> This limited use of the *Rogers* test allows the Second Circuit to adhere to the purpose of the Lanham Act, which is to balance First Amendment rights and trademark protection as it applies "only where the public interest in avoiding consumer confusion outweighs the public interest in free expression."<sup>15</sup>

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the goods or services, (3) similarity of the marks, (4) evidence of actual confusion, (5) the marketing channels used, (6) the type of goods or services and the degree of care likely to be exercised by the purchasers of the defendant's product, (7) defendant's intent in selecting the mark, and (8) the likelihood of expansion of the product lines").

9. See Jonathan Montcalm, *Has Fox's "Empire" Ended the Battle? Ninth Circuit Expands Scope of Permissible Promotion of Expressive Works*, DORSEY (Dec. 8, 2017), <https://thetmca.com/has-foxs-empire-ended-the-battle-ninth-circuit-expands-scope-of-permissible-promotion-of-expressive-works/> (stating the Ninth Circuit has granted significant leeway to expressive works, thus creating protections for uses that were previously unlawful).

10. See Joshua Simmons, *Trademarks and the First Amendment: Litigation Trends*, N.Y. L.J. (Nov. 6, 2020, 3:04 PM), <https://www.law.com/newyorklawjournal/2020/11/06/trademarks-and-the-first-amendment-litigation-trends/> (quoting *ESS Ent. 2000 v. Rock Star Videos*, 547 F.3d 1095, 1099 (9th Cir. 2008)) (noting that the artistic use of a trademark will not be found to infringe upon the holder's rights unless "the use of the mark has no artistic relevance to the underlying work whatsoever, or if it has some artistic relevance, unless it explicitly misleads as to the source of content of the work"). See generally *id.* (using Ninth Circuit cases as examples to show the expansion of expressive work).

11. See *December 2019 Update*, *supra* note 2 (stating Second Circuit plaintiffs do not need to meet this same high bar, but rather must only prove likelihood-of-confusion).

12. See *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (creating the *Rogers* test: (a) the title of the work has some artistic relevance to the underlying work; and (b) that the title is not explicitly misleading as to the source or content of the work).

13. *Petition for Writ of Certiorari, VIP Prods. LLC v. Jack Daniel's Props.*, 953 F.3d 1170 (9th Cir. 2020) (No. 20-365).

14. See *December 2019 Update*, *supra* note 2.

15. *Rogers*, 875 F.2d at 999; Lanham Act, 15 U.S.C. § 1051.

The Ninth Circuit has adopted the *Rogers* test in a way that expands the plain language of the Lanham Act and, therefore, has broadened the test beyond its original purpose.<sup>16</sup> This is compared to the Second Circuit, which created the *Rogers* test and continues to stay within the framework of the Lanham Act.<sup>17</sup> The Second Circuit consistently separates commercial products from expressive works, and when it determines a work is commercial, it only requires the likelihood-of-confusion test for a Lanham Act plaintiff.<sup>18</sup> However, if the work is deemed expressive, the Second Circuit uses the *Rogers* test but in a way that is consistent with the plain language of the Lanham Act.

This Note distinguishes the Ninth Circuit's interpretation of expressive work and use of the *Rogers* test from the Second Circuit's. Section II will outline the Lanham Act and follow the development of the *Rogers* test in the Second and Ninth Circuits. More specifically, it will highlight the expansion of the Ninth Circuit's use of "expressive work" and the *Rogers* test. Section III will analyze the differences in the use of the Lanham Act and the *Rogers* tests applied by the Second Circuit and the Ninth Circuit.

## II. BACKGROUND

The Lanham Act serves to protect federally registered marks from similar marks that would confuse consumers.<sup>19</sup> The *Rogers* test was developed as a tool to help aid the legislature enforce trademark infringement issues.<sup>20</sup>

### A. Origins of the Lanham Act

In 1946, Congress enacted the Lanham Act at 15 U.S.C. §§ 1051-1127.<sup>21</sup> The Lanham Act provides federal guidelines and procedures to regulate the enforcement of trademark rights.<sup>22</sup> To prevail, the Lanham Act requires a

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16. See Jared Kagan, *Bad Spaniels Make Bad Law: Ninth Circuit Says Dog Toy is an Expressive Work Entitled to First Amendment Protection*, IPWATCHDOG (Apr. 3, 2020), <https://www.ipwatchdog.com/2020/04/03/bad-spaniels-make-bad-law/id=120353/>.

17. *Rogers*, 875 F.2d at 999; *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 493–94 (2d Cir. 1989); *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812–13 (2d Cir. 1999).

18. *Harley-Davidson, Inc.*, 164 F.3d at 813.

19. *Lanham Act*, LEGAL INFORMATION INSTITUTE, CORNELL LAW SCHOOL, [https://www.law.cornell.edu/wex/lanham\\_act](https://www.law.cornell.edu/wex/lanham_act) (last visited Feb. 4, 2022).

20. Ivan Blomqvist, *The Rogers Test: Free Speech v. Trademark Protection*, MOELLER IP (Feb. 12, 2021), <https://moellerip.com/the-rogers-test-free-speech-v-trade-mark-protection/>.

21. Lanham Act, 15 U.S.C. § 1051.

22. *Id.*

plaintiff to demonstrate that “(1) the plaintiff has a valid and legally protectable mark; (2) the plaintiff owns the mark; and (3) the defendant’s use of the mark to identify goods or services causes a likelihood of confusion.”<sup>23</sup> In the Second Circuit, if a work is not expressive under the Lanham Act, the likelihood-of-confusion factors are used.<sup>24</sup> However, when the work is expressive under the Lanham Act, the Second Circuit uses the *Rogers* test.<sup>25</sup>

The *Rogers* test applies to expressive works “only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”<sup>26</sup> The *Rogers* test intended to strike a balance between trademark rights and First Amendment rights.<sup>27</sup> Therefore, when an expressive work is at issue, a Lanham Act claimant must show the work is either “not artistically relevant to the underlying work” or “explicitly misleads consumers as to the source or content of the work” to prevail.<sup>28</sup>

### *B. Creation and Progression of the Rogers Test*

The *Rogers* test originated in the Second Circuit in 1989 from the landmark case *Rogers v. Grimaldi*.<sup>29</sup> There, the court analyzed a false advertising claim from a famous duo suing Grimaldi over a movie title under the Lanham Act.<sup>30</sup> The duo, Ginger Rogers and Fred Astaire, believed that the film “Ginger and Fred,” which depicted a famous cabaret duo in a satirical way, portrayed them and would lead the audience to believe Rogers and Astaire were involved with the film.<sup>31</sup>

Grimaldi claimed that the title was free speech protected under the First Amendment.<sup>32</sup> The District Court for the Southern District of New York granted summary judgment for Grimaldi as the film was an artistic expression and not a commercial product.<sup>33</sup> Rogers subsequently appealed

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23. *Id.*; *Lanham Act*, *supra* note 19.

24. *See* Muradyan, *supra* note 8 (listing the likelihood-of-confusion factors).

25. David Grossman & Mariah Volk, *Gordon v. Drape Creative, Inc.*, LOEB & LOEB LLP (Nov. 30, 2018), <https://www.loeb.com/en/insights/publications/2018/11/gordon-v-drape-creative-inc>.

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

27. *See id.*

28. *VIP Prods. LLC v. Jack Daniel’s Props.*, 953 F.3d 1170, 1174 (9th Cir. 2020); Muradyan, *supra* note 8.

29. 875 F.2d 994 (2d Cir. 1989).

30. *Id.* at 996.

31. *Id.* at 996–97.

32. *Id.* at 997.

33. *Rogers v. Grimaldi*, 695 F. Supp. 112, 124 (S.D.N.Y. 1988), *aff’d*, 875 F.2d 994 (2d Cir. 1989).

the district court's decision.<sup>34</sup> The appellate court affirmed the district court's decision but found that the Lanham Act could apply to titles of artistic works.<sup>35</sup> Subsequently, the Second Circuit developed a standard for artistic works, which stated 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."<sup>36</sup>

Under this standard, artistic relevance is analyzed first.<sup>37</sup> A title is artistically relevant if it has some artistic relevance to the underlying work.<sup>38</sup> If it does have artistic relevance, then the Second Circuit analyzes whether the "title explicitly misleads as to the source or the content of the work."<sup>39</sup> Through this new standard, the Second Circuit determined that the title had artistic relevance to the underlying work and did not explicitly mislead consumers.<sup>40</sup> Therefore, it affirmed the district court's decision and, as a result, created the *Rogers* test.<sup>41</sup> After this decision, when there is an "expressive work," the *Rogers* test interprets the Lanham Act to apply when deciding if consumer confusion exceeds the right to free expression.<sup>42</sup> "[T]hat balance will normally not support applying the Act," unless the two aforementioned prongs are fulfilled<sup>43</sup> with regard to the title's creative connection and the impression that perceived connection might cause.<sup>44</sup>

#### *i. Second Circuit's Rogers Test Prongs*

As noted above, the *Rogers* test consists of two prongs: 1) "at least some artistic relevance" and 2) "not explicitly misleading as to the content of the work."<sup>45</sup> The first prong of the *Rogers* test is a factual issue that the courts

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34. *Rogers*, 875 F.2d at 996.

35. *See id.* at 998 (finding that titles counted as an expressive work and thus are entitled to protection).

36. *Id.* at 999.

37. *See id.* at 998 (analyzing artistic relevance before analyzing if a work is explicitly misleading as to its content).

38. *Id.* at 999.

39. *Id.*

40. *Id.* at 1001–02 (concluding that although the title may be misleading to some, "the title is entirely truthful as to its content" and "has an ironic meaning that is relevant to the film's content;" therefore, the Lanham Act claim must fail).

41. Lynn M. Jordan & David M. Kelly, *Another Decade of Rogers v. Grimaldi: Continuing to Balance the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 109 TRADEMARK REP. 833, 837 (2019).

42. *See Grossman & Volk, supra* note 25 (defining the main purpose of the *Rogers* test as ensuring that customers are not confused on the source of the work).

43. *See id.*

44. *Rogers*, 875 F.2d at 1000.

45. *Id.*

consider on a case-by-case basis.<sup>46</sup> The bar establishing “artistic relevance” is low; defendants simply have to prove that the work rises just above what the court considers “artistic relevance.”<sup>47</sup>

Conversely, the second prong of the *Rogers* test requires a more in-depth analysis.<sup>48</sup> Accordingly, the Second Circuit employs a variety of factors to evaluate the challenged work’s likelihood-of-confusion.<sup>49</sup> If there is confusion, then the Second Circuit analyzes whether that confusion is “particularly compelling.”<sup>50</sup> Where the confusion is “particularly compelling,” then the Second Circuit considers the work “explicitly misleading,”<sup>51</sup> meaning it fails the *Rogers* test, thus violating the Lanham Act.

### *ii. Second Circuit’s Rogers Test Development*

In 1993, the Second Circuit, in *Twin Peaks Productions, Inc. v. Publications International*,<sup>52</sup> illustrated its use of the *Rogers* test.<sup>53</sup> Publications International, Ltd. (“PIL”) published a book titled “Welcome to Twin Peaks: A Complete Guide to Who’s Who and What’s What,” based on the first season of the show “Twin Peaks.”<sup>54</sup> On the book’s cover, PIL placed a disclaimer that the show was not affiliated with the book.<sup>55</sup> Twin Peaks Production sued in the Southern District of New York alleging copyright infringement, trademark infringement, unfair competition, and trademark dilution.<sup>56</sup> PIL asserted fair use and First Amendment defenses.<sup>57</sup>

The district court found for Twin Peaks Productions on all matters besides trademark dilution and rejected PIL’s defenses.<sup>58</sup> Subsequently, PIL

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46. 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:144.50 (5th ed. 2021).

47. Jordan & Kelly, *supra* note 41, at 837 (stating that the court is simply responsible for determining that artistic relevance exists and not how much of it exists).

48. See 3 ANNE GILSON LALONDE & JEROME GILSON, GILSON ON TRADEMARKS § 13.24 (2021).

49. See Jordan & Kelly, *supra* note 41, at 850–51.

50. See *id.* at 851 (“If there is no likelihood-of-confusion, the analysis is complete.”).

51. *Id.*; see *December 2019 Update*, *supra* note 2.

52. 996 F.2d 1366 (2d Cir. 1993).

53. *Id.*

54. *Id.* at 1370.

55. *Id.* at 1370–71, 1739 (noting that PIL published the book based on the show without authorization from the network or show creators).

56. *Id.* at 1371.

57. *Id.* (asserting that their product was just using freedom of speech and not infringing on a trademark).

58. *Id.*; see also *Twin Peaks Prods., Inc., v. Publ’ns Int’l*, 778 F. Supp. 1247 (S.D.N.Y. 1991).

appealed to the Second Circuit Court of Appeals.<sup>59</sup> On appeal, the Second Circuit was “concerned that the District Court failed to recognize the special concerns implicated by the Lanham Act claims against titles of works of artistic expression.”<sup>60</sup> Therefore, the Second Circuit applied the *Rogers* test.<sup>61</sup>

The Second Circuit recognized that the first prong of *Rogers* was satisfied by the artistic relevance to the underlying work.<sup>62</sup> When analyzing whether a work is “explicitly misleading,” the Second Circuit applies the likelihood-of-confusion test.<sup>63</sup> Therefore, the Second Circuit remanded the issue of “explicitly misleading” to the district court to apply the likelihood-of-confusion test and thus, complete the full and correct analysis of the issues.<sup>64</sup> *Twin Peaks Productions* demonstrates that when the Second Circuit deems a work “expressive,” it analyzes the second prong of *Rogers* differently than the Ninth Circuit.<sup>65</sup> The Second Circuit’s analysis of the second prong contrasts with the Ninth Circuit’s because it analyzes whether an “expressive work” is misleading based on the likelihood-of-confusion factors.<sup>66</sup>

The Second Circuit does not consider a product an “expressive work” when only humor is used and, therefore, does not apply the *Rogers* test in such cases.<sup>67</sup> The Second Circuit demonstrated this with its holding in *Harley-Davidson, Inc. v. Grottanelli*<sup>68</sup> where the plaintiff filed a trademark-infringement lawsuit against a motorcycle repair business operating under the name The Hog Farm. Harley-Davidson alleged that “Hog” was a trademark for its motorcycles and this use of the term would prompt consumers to incorrectly associate the two. Though the defendant relied on a parody defense,<sup>69</sup> the court noted that for a product to be considered an “expressive work,” it must provide commentary on the original trademark.<sup>70</sup> However, humor alone is insufficient commentary on an original trademark when it fails to offer a comment with “critical bearing on the substance or

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59. *Twin Peaks Prods., Inc.*, 996 F.2d at 1371.

60. *Id.* at 1378.

61. *Id.* at 1378–79.

62. *See id.* at 1379 (finding the work artistically relevant to the underlying work as it was a title of a book and was related to the book).

63. *See id.* The Second Circuit relies on the eight factors developed in *Polaroid Corp. v. Polaroid Electronics. Corp.* to guide its likelihood-of-confusion analysis.

64. *Id.* at 1379–80.

65. *December 2019 Update*, *supra* note 2.

66. *Id.*

67. *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999).

68. *Id.* at 806.

69. *See supra* note 4 (describing the parody defense).

70. *See Harley-Davidson, Inc.*, 164 F.3d at 813.

style of the original composition.”<sup>71</sup> The Second Circuit held that “a trademark parody that endeavors to promote primarily non-expressive products” is not entitled to First Amendment protection.<sup>72</sup> Therefore, the Second Circuit uses the likelihood-of-confusion test to determine if a trademark has infringed the plaintiff’s protected trademark.<sup>73</sup>

Thus, in the Second Circuit, Lanham Act plaintiffs are not required to pass the *Rogers* test requirements, rather, they must only satisfy the likelihood-of-confusion test when a defendant uses a trademark to humorously promote a product.<sup>74</sup> This case demonstrates that the Second Circuit only applies the likelihood-of-confusion factors and not the *Rogers* test when a work is not expressive.<sup>75</sup>

### C. Ninth Circuit’s *Rogers* Test Progression

After the landmark case of *Rogers v. Grimaldi*, the *Rogers* test has not only been used by the Second Circuit, but has also been adopted by the Ninth Circuit.<sup>76</sup> Originally, the *Rogers* test was used to analyze whether titles of expressive works were infringing on other works.<sup>77</sup> However, when the Ninth Circuit adopted the *Rogers* test, it expanded the test’s application.<sup>78</sup>

In 2017, *Twentieth Century Fox TV v. Empire Distribution, Inc.*,<sup>79</sup> the Ninth Circuit held that Fox’s use of the mark “Empire” in the show’s name and its promotional activities were protected by the First Amendment.<sup>80</sup> This holding applied to all of Fox’s uses of “Empire,” including those auxiliary to protected expressive works.<sup>81</sup> This expansion meant that Fox could use

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71. *See id.* (requiring that the humor provide additional commentary to constitute an expressive work).

72. *Id.*

73. *Id.* at 813–14.

74. *See id.*

75. *Id.*

76. *See December 2019 Update, supra* note 2 (explaining that the Ninth Circuit adopted the *Rogers* test to evaluate expressive works pursuant to the Lanham Act).

77. Meredith M. Wilkes & Jacqueline K.S. Lee, *Litigating the First Amendment Defense in the Video Game Context*, INTA BULLETIN (Sept. 15, 2013), <https://www.jonesday.com/files/Publication/46dc838c-ffa4-4cf6-b788-75a28c6642eb/Presentation/PublicationAttachment/29d1bd39-b132-4f42-a6d6-ecfd9dbfb03c/LitigatingtheFirstAmendm.pdf>.

78. Kagan, *supra* note 16.

79. 875 F.3d 1192 (9th Cir. 2017).

80. *See id.* at 1197 (finding that underlying works using marks deserve protection as they are an extension of an expressive work).

81. *See id.* (citing *Rogers v. Grimaldi*, 875 F.2d 994, 999 n.5 (2d Cir. 1989)) (using a footnote from *Rogers* to classify auxiliary products as an extension of expressive works).

the trademark “Empire” in promoting shows, “live musical performances, radio play, and consumer goods such as shirts and champagne glasses.”<sup>82</sup> Categorizing supplementary products as “expressive works” broadens the scope of permissible trademarks to include “promotional” products that create revenue and commercial goods.<sup>83</sup>

Unlike the Second Circuit, the Ninth Circuit has held that likelihood-of-confusion test is irrelevant to determine whether trademark use in an expressive work is explicitly misleading.<sup>84</sup> This is because the Ninth Circuit finds that the “likelihood-of-confusion test provides insufficient protection against a trademark owner’s ability to control public discourse.”<sup>85</sup> Instead, the Ninth Circuit requires an “explicit indication, overt claim, or explicit misstatement” to determine if a product is “explicitly misleading.”<sup>86</sup> Notably, the Ninth Circuit is the only circuit to use these factors to determine whether a trademark used in an expressive work is explicitly misleading.<sup>87</sup>

In 2018, the Ninth Circuit further expanded the reach of expressive works in *Gordon v. Drape Creative*<sup>88</sup> by using humor to classify a commercial product as an expressive work.<sup>89</sup> Christopher Gordon created a YouTube video using the catchphrase “Honey Badger Don’t Care.”<sup>90</sup> After the phrase became widely popular, Gordon trademarked the phrase and used it to sell products.<sup>91</sup> Drape Creative later used this catchphrase in greeting and birthday cards<sup>92</sup> prompting Gordon to sue the company in the United States District Court for the Central District of California. The court granted summary judgment for the defendant using the *Rogers* test<sup>93</sup> and Gordon appealed.<sup>94</sup>

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82. *Id.* at 1195.

83. *See Montcalm*, *supra* note 9.

84. *Twentieth Century Fox TV*, 875 F.3d at 1198.

85. *Id.* at 1197.

86. *See id.* at 1199 (finding that these factors were more in line with the Lanham Act).

87. Petition for Writ of Certiorari at 5–6, *VIP Prods. LLC v. Jack Daniel’s Props.*, 953 F.3d 1170 (9th Cir. 2020) (No. 20-365) (stating the Ninth Circuit is the outlier while the Second, Fourth, Fifth, Seventh, Eighth, and Tenth Circuits do not require as high of a threshold).

88. 909 F.3d 257 (9th Cir. 2018).

89. *See id.* (finding a greeting card an expressive work because it was humorous).

90. *Id.* at 260.

91. *Id.*

92. *Id.* at 260–63 (finding that Drape did not receive authorization to use the phrase, even though the two parties had communicated about the idea in the past).

93. *Id.* at 260–61.

94. *Id.* at 263.

In its analysis, the court first found that the greeting cards were expressive works protected under the First Amendment because they conveyed messages to consumers through their humorous words and images.<sup>95</sup> The standard of “conveying a message” expands “expressive works” to include any product if it adds any amount of humor or critique.<sup>96</sup> Then, the Court applied the *Rogers* test and remanded the issues back to the district court.<sup>97</sup>

*i. Ninth Circuit’s Rogers Test Prongs*

Despite their deviations in application, the Ninth and Second Circuits use the same prongs for the *Rogers* test. Both Circuits require: 1) “at least some artistic relevance,” and that products are 2) “not explicitly misleading as to the content of the work.”<sup>98</sup> However, the breakdown of those prongs in the Ninth Circuit is different.<sup>99</sup> Relying on Second Circuit case precedent, the Ninth Circuit interpreted the first prong of the *Rogers* test as establishing a standard<sup>100</sup> that the degree of artistic relevance “merely must be above zero.”<sup>101</sup> This standard is considered on a factual basis and does not require judges to “engage in artistic analysis.”<sup>102</sup>

When analyzing the second prong the Ninth Circuit disregards the likelihood-of-confusion analysis.<sup>103</sup> Instead, the Ninth Circuit’s analysis is rooted in a multi-part elemental test that considers: whether the work “‘explicitly misled consumers’ through an ‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement’ that caused consumer confusion.”<sup>104</sup>

*ii. The Ninth Circuit’s Analysis of VIP Prods. LLC v. Jack Daniel’s Prods.*

In 2020, the Ninth Circuit heard *VIP Products LLC*.<sup>105</sup> The court analyzed whether a dog toy was an “expressive work” and, therefore, entitled to First Amendment protection.<sup>106</sup> Jack Daniel’s argued that the dog toy was a

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95. *Id.* at 268.

96. *See* Kagan, *supra* note 16 (stating that the Ninth Circuit has strayed from traditionally expressive work by expanding its definition to include humor).

97. *Gordon*, 909 F.3d at 271.

98. *December 2019 Update*, *supra* note 2.

99. *Id.*

100. *See* Jordan & Kelly, *supra* note 41, at 837 (stating that, in the Second Circuit, “works that ha[ve] ‘no artistic relevance’ [are] the only works that would be exempt”).

101. *See id.*

102. *Id.* at 838.

103. *December 2019 Update*, *supra* note 2.

104. Jordan & Kelly, *supra* note 41, at 858.

105. 953 F.3d 1170 (9th Cir. 2020).

106. *Id.* at 1172.

commercial product that was ruining its long-established trademark.<sup>107</sup> In response, VIP Products argued that it should be afforded First Amendment protection as it was conveying a message and commenting humorously on Jack Daniel's products.<sup>108</sup> The Ninth Circuit disagreed with Jack Daniel's and held that the dog toy was an "expressive work" because it conveyed a humorous message.<sup>109</sup> Therefore, the court accepted VIP's First Amendment defense under the Lanham Act.<sup>110</sup>

The appellate court considered the likelihood-of-confusion test under the Lanham Act but determined that the test fails when "artistic expression is at issue."<sup>111</sup> The likelihood-of-confusion test fails as it does not "account for the full weight of the public's interest in free expression."<sup>112</sup> By analyzing the work as "communicating ideas or expressing points of view," the court decided the VIP dog toy was an "expressive work."<sup>113</sup> Rather than applying the likelihood-of-confusion factors, the lower court turned to the *Rogers* test which requires a plaintiff to show that the defendant's use of the mark is either "not artistically relevant to the underlying work" or "explicitly misleads consumers as to the source or content of the work."<sup>114</sup> The appellate court vacated the district court's finding of infringement and remanded to the district court to determine whether Jack Daniel's product fits one of the prongs of the *Rogers* test.<sup>115</sup>

On trademark dilution by tarnishment, the appellate court held that there can be no dilution by tarnishment when the work in question is noncommercial.<sup>116</sup> It determined that because VIP used Jack Daniel's trade dress and bottle design to "convey a humorous message," the message is subject to First Amendment protection.<sup>117</sup> Therefore, VIP was entitled to

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107. *Id.* at 1174 (highlighting that Jack Daniels has established an image of seriousness surrounding its trademark).

108. *Id.* at 1175.

109. *Id.* (finding that while the dog toy did not rise to the artistic level of the "Mona Lisa" it still was expressive).

110. *Id.* at 1175–76.

111. *Id.* at 1174 (commenting on the likelihood-of-confusion test's failure in these types of cases).

112. *Id.*

113. *Id.*

114. *Id.* (finding that when an expressive work is at issue, the likelihood-of-confusion test is not a high enough threshold).

115. *Id.* at 1176.

116. *Id.* (concluding that when a work is expressive, it is noncommercial, so dilution by tarnishment claims cannot survive).

117. *Id.* (finding that humor is an important right protected under the First Amendment, so it deserves a high bar of analysis).

judgment in its favor on the dilution claim.<sup>118</sup> Jack Daniel's filed a petition with the Supreme Court requesting that it grant a writ of certiorari and reverse the Ninth Circuit's decision.<sup>119</sup>

### III. HOW THE NINTH CIRCUIT DELINEATES IN JACK DANIELS

The Ninth Circuit continues to use the Lanham Act to analyze trademark infringement, but its expansion of “expressive work” and changes to the *Rogers* test have differed from the Second Circuit's original test.<sup>120</sup> Thus, while the Ninth Circuit's use of the test is rooted in the same purpose as the Second Circuit, to strike a balance between First Amendment protection and trademark rights under the Lanham Act, its expanded definition calls this balance into question.<sup>121</sup>

#### A. How the Ninth Circuit's Expanded its Definition of “Expressive Works”

When the Ninth Circuit determined that humor can qualify a product as an “expressive work,” it expanded the term by granting any competing product that uses humor heightened protection.<sup>122</sup> One of the Ninth Circuit's first steps in expanding the scope of the *Rogers* test was to apply the definition of expressive works to commercial products used for promotion, even when those products are considered auxiliary.<sup>123</sup> By defining primarily commercial products as expressive, defendants in the Ninth Circuit could use humor to qualify any product as expressive, a relatively low bar for junior marks to pass.<sup>124</sup>

Expanding the scope in this way allows for any commercial product using

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118. *Id.*

119. See Petition for Writ of Certiorari, *VIP Prods LLC v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170 (9th Cir. 2020) (No. 20-365).

120. See *Simmons*, *supra* note 10 (observing a “foundational agreement” that First Amendment rights must be considered in trademark infringement litigations, but “conflicts arise in trying to draw the line”).

121. See *Wilkes & Lee*, *supra* note 77 (stating that defendants are “quick” to assert First Amendment defenses and the *Rogers* test seeks to balance these defenses with Lanham Act claims).

122. Compare *VIP Prods. LLC v. Jack Daniel's Prods. Inc.*, 953 F.3d 1170, 1175 (9th Cir. 2020) (holding humor alone is enough to deem a work expressive), with *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999) (holding that when a competing product uses humor to separate itself from a senior mark, the competing product needs to convey a message).

123. See *Twentieth Century Fox TV v. Empire Distrib., Inc.*, 875 F.3d 1192, 1196–97 (9th Cir. 2017) (holding auxiliary products used to promote an expressive work was a natural extension of *Rogers*).

124. See *Kagan*, *supra* note 16.

a trademark in a humorous way to be considered an “expressive work.”<sup>125</sup> This diverges from the original purpose of the Lanham Act, to protect against customer confusion regarding trademarks.<sup>126</sup> Allowing humor alone to negate consumer confusion contravenes the original protections since the Second Circuit’s likelihood-of-confusion standard is meant to protect against humor being considered alone in place of a list of factors.<sup>127</sup> Moreover, when determining whether something is expressive, the courts are best suited to analyze if the product provides commentary on the original work.<sup>128</sup> As established by *Harley-Davidson, Inc.*, humor can be a factor, but humor alone is not enough to deem a product an “expressive work.”<sup>129</sup>

In the Second Circuit, humor alone is not enough to express an idea or offer commentary unless there is a substantial message behind it.<sup>130</sup> Thus, if a commercial product’s primary purpose is for the sale of goods and not commenting on the original work, then it cannot be expressive.<sup>131</sup> Commercial products and expressive works often conflict because they are afforded different levels of protection under the First Amendment.<sup>132</sup> The Harley Davidson court held that a product using a humorous representation of another product, especially that of a competitor, for self-promotion cannot be both expressive and commercial.<sup>133</sup> Therefore, considering humor alone gives heightened First Amendment protection to products that base their

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125. Bill Donahue, *Jack Daniel’s Takes Dog Toy TM Fight to Supreme Court*, LAW360 (Sept. 21, 2020, 4:16 PM) <https://www.law360.com/articles/1312109/jack-daniel-s-takes-dog-toy-tm-fight-to-supreme-court> (arguing that the Ninth Circuit expanded the scope by affording jokes too much First Amendment protection).

126. See *Twentieth Century Fox TV*, 875 F.3d at 1196 (explaining when the Court applies the *Rogers* test).

127. See Kagan, *supra* note 16 (explaining that the low threshold of considering humor still leaves great risk for consumer confusion); see also *December 2019 Update*, *supra* note 2 (stating that the Second Circuit uses eight factors in their likelihood-of-confusion test).

128. See *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999) (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994)) (holding commentary is necessary when humor is involved).

129. *Id.* at 812 (highlighting that the use of humor does not automatically make the product not commercial).

130. *Id.* at 812–13 (relaying that humor can be a factor but the humor needs to relate to the “original composition”).

131. See *id.* at 813 (conveying that the use of humor is not an automatic marker for expressive works and court must consider the purpose of the humor).

132. Simmons, *supra* note 10.

133. See *Harley-Davidson, Inc.*, 164 F.3d at 812 (noting examples where the court has offered “considerable leeway” to parody products so long as their expressive work is attempting to provide humorous commentary, not attempting to promote or sell the product).

designs on senior trademarks and leaves very little room for trademark owners to prevail on infringement claims.<sup>134</sup>

The Ninth Circuit built upon the *Rogers* test by expanding the definition of expressive works to include commercial products, thus, establishing a high threshold for Lanham Act claimants.<sup>135</sup> The heightened threshold burdens plaintiffs with proving that the product was “explicitly misleading” rather than just that its likelihood-of-confusion was “particularly compelling.”<sup>136</sup> The Ninth Circuit expands the *Rogers* test because it defines traditionally non-expressive works as expressive works.<sup>137</sup>

Under the Lanham Act, the *Rogers* test should only be used when the product is deemed expressive.<sup>138</sup> Through the Ninth Circuit’s expansion of the definition of “expressive work,” the *Rogers* test can be applied more broadly than it can in the Second Circuit.<sup>139</sup> The Lanham Act seeks to protect trademark owners, and by using the *Rogers* test in a way that seeks to protect junior trademarks, it strays from protecting senior trademark owners.<sup>140</sup> In the Second Circuit, when a work is non-expressive, the Lanham Act only requires a likelihood-of-confusion analysis.<sup>141</sup> The Ninth Circuit has completely disregarded this analysis.<sup>142</sup> Compared to the Ninth Circuit, the Second Circuit’s definition of “expressive work” is aligned with the *Rogers*’ test initial purpose.<sup>143</sup> The Second Circuit has not strayed from the original intentions of the Lanham Act which seeks to protect against commercial

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134. See Kagan, *supra* note 16.

135. See *December 2019 Update*, *supra* note 2 (discussing how the Ninth Circuit requires a stricter explicitly misleading inquiry instead of the likelihood-of-confusion inquiry applied by other courts in *Rogers* analyses).

136. *Id.*

137. See Kagan, *supra* note 16 (noting there was no precedent behind the Ninth Circuit choosing to define non-expressive works as expressive).

138. Michael A. Rosenhouse, Annotation, *Protection of Artistic Expression from Lanham Act Claims Under Rogers v. Grimaldi*, 857 F.2d 994 (2d Cir. 1989), 22 A.L.R. FED. 3d Art. 4 (2017).

139. See Kagan, *supra* note 16 (stating that the Ninth Circuit’s definition of expressive work is far beyond what is traditionally accepted, which poses a large risk to trademark owners).

140. Lanham Act, 15 U.S.C. § 1051(b) (“A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register . . .”).

141. *Trademarks and Expressive Works*, STITES & HARBISON PLLC (Apr. 28, 2015), <https://www.stites.com/resources/trademarkology/trademarks-and-expressive-works>.

142. See *December 2019 Update*, *supra* note 2.

143. See Kagan, *supra* note 16 (stating the Second Circuit has defined expressive products to include traditionally expressive works such as movies, titles, songs, and the like, while the Ninth Circuit has gone beyond this to include consumer goods in its definition).

activities that may cause consumers to believe a “false designation of orientation.”<sup>144</sup>

The Second Circuit has adhered to the plain language of the Lanham Act, even when humor is involved, by analyzing how consumers may confuse products before applying the *Rogers* test.<sup>145</sup> When commercial products are involved, the Second Circuit, unlike the Ninth, is cautious to consider a product an “expressive work.”<sup>146</sup> By accounting for factors other than humor when determining whether a work should be classified as expressive or commercial, the Second Circuit does not stray from the purpose of the Lanham Act, which is to avoid customer confusion.<sup>147</sup> This cautiousness strikes a proper balance between trademark rights and First Amendment rights<sup>148</sup> and has led the Second Circuit to use the likelihood-of-confusion factors before applying the *Rogers* test when non-expressive works are at issue.<sup>149</sup> The Second Circuit correctly analyzes an “expressive work” because it has not classified consumer goods as such.<sup>150</sup> When a work is not expressive, it does not require the *Rogers* test to establish a claim under the Lanham Act.<sup>151</sup> Therefore, the analysis better adheres to the plain language of the Lanham Act with its use of *Rogers* test, unlike the Ninth Circuit.

#### *B. How the Ninth Circuit’s Rogers Test Deviates from the Second Circuit’s Rogers Test*

The Second Circuit’s *Rogers* test considers the likelihood-of-confusion factors in its second prong analysis.<sup>152</sup> Ultimately, the second prong of the

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144. See *Trademarks and Expressive Works*, *supra* note 141 (showing how the Lanham Act was used in the development of the *Rogers* test).

145. See *BedRoc Ltd., LLC v. United States*, 541 U.S. 176, 177 (2004) (finding that when a statute is being analyzed “the inquiry begins with the statutory text, and ends there as the text is unambiguous”); see also *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812 (2d Cir. 1999) (exploring the court’s hesitation to give consumer products with generic names trademark protections).

146. Compare *Harley-Davidson, Inc.*, 164 F.3d at 812 (looking at competing products and addition of commentary before establishing a product as expressive), with *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 268–69 (9th Cir. 2018) (holding a product was expressive because it was a greeting card with humor).

147. *Trademarks and Expressive Works*, *supra* note 141.

148. See *id.* (noting a needed balance between First Amendment rights and Lanham Act protections).

149. *December 2019 Update*, *supra* note 2.

150. Kagan, *supra* note 16 (stating plainly expressive works as “movies, songs, photographs, television shows, video games, and greeting cards”).

151. See *December 2019 Update*, *supra* note 2 (showing that the Second Circuit does not apply the *Rogers* test if it analyzes the work and concludes that it is not-expressive).

152. *Id.*

*Rogers* test requires a claimant to show that the product “explicitly misleads consumers as to the source or content of the work.”<sup>153</sup> The likelihood of confusion factors are rooted in the *Polaroid* factors.<sup>154</sup> Using the likelihood-of-confusion factors when analyzing the second prong follows the plain language of the Lanham Act.<sup>155</sup>

The Lanham Act uses the phrase “likely to cause confusion” as a determining factor in trademark infringement cases.<sup>156</sup> The Second Circuit incorporates that language into their analysis of the *Rogers* test, showing that even though the *Rogers* test is judicially created, it adheres to the original purpose of the Lanham Act.<sup>157</sup> The Second Circuit further strikes more of a balance between trademark rights and First Amendment rights as it provides consistent, efficacious resolution of trademark infringement suits.<sup>158</sup> This allows plaintiffs to argue more for trademark infringement as the likelihood-of-confusion factors the Second Circuit employs are a less rigid standard than the Ninth Circuit’s second prong.<sup>159</sup> The likelihood-of-confusion factors also allow the courts to consider more factors for analysis, which enables courts to separate expressive works from commercial products more easily.<sup>160</sup> This is a better standard because analyzing more factors allows the court to better balance First Amendment and trademark rights, and allows both defendants and plaintiffs more opportunities to prove their arguments. This is legally significant because it creates a standard that does not give more protection to one trademark over another.

The Ninth Circuit deemed the likelihood-of-confusion factors irrelevant in its application of the second prong of the *Rogers* test.<sup>161</sup> Instead, the Ninth

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153. *Id.* (showing how the Second Circuit interprets the same language differently than the Ninth Circuit in their *Rogers* test).

154. *Id.*

155. See *Lanham Act*, *supra* note 19 (stating that the Lanham Act requires a trademark be “distinctive” so the trademark can aid in “identifying and distinguishing particular goods as emanating from one producer or source and not another”).

156. Lanham Act, 15 U.S.C. § 1125(a)(1).

157. See *December 2019 Update*, *supra* note 2 (highlighting that the Second Circuit uses the same language as the Lanham Act while the Ninth Circuit has adopted a different standard).

158. See *Kagan*, *supra* note 16 (stating trademark owners subject to Ninth Circuit jurisdiction must be “vigilant” about protecting their marks as this circuit’s high bar does not protect trademark owner’s rights).

159. See *December 2019 Update*, *supra* note 2 (stating that the Ninth Circuit only looks at “explicit indication, overt claim, or explicit misstatement”); see also Thomas M. Byron, *Spelling Confusion: Implications of the Ninth Circuit’s View of the “Explicitly Misleading” Prong of the Rogers Test*, 19 J. INTEL. PROP. L. 1 (2011).

160. See *Byron*, *supra* note 159, at 2–3, 12–14.

161. *VIP Prods. LLC v. Jack Daniel’s Props, Inc.*, 953 F.3d 1170, 1174–75 (9th Cir. 2020) (holding the likelihood-of-confusion factors are not enough); see also *December*

Circuit requires a claimant to show an “explicit indication, overt claim, or explicit misstatement” to meet the second prong.<sup>162</sup> The Ninth Circuit developed this with substantial judicial discretion<sup>163</sup> by pulling from different analyses in the Sixth and Second Circuits to broaden its consideration to include “overt misrepresentation.”<sup>164</sup>

The Ninth Circuit then expanded its interpretation in *Twentieth Century Fox*, by developing the factors of “explicit indication, overt claim, or explicit misstatement.”<sup>165</sup> It cited *Rogers* in *Twentieth Century Fox* to highlight where these factors stemmed from in the Second Circuit.<sup>166</sup> However, the Second Circuit does not use these factors, and they are not mentioned in *Rogers* nor the Lanham Act.<sup>167</sup>

Therefore, the Ninth Circuit’s analysis strays from the original language of the Lanham Act and the original use of the *Rogers* test.<sup>168</sup> Thus, not only would the *Jack Daniels* case not require the *Rogers* test if the Ninth Circuit correctly interpreted expressive works, but if the dog toy was to be considered an “expressive work,” the Ninth Circuit did not apply the *Rogers* test correctly.

### C. Possible Implications After Jack Daniels

The *Rogers* test has evolved from being used for titles of movies to applying to video games and gift cards and now to auxiliary products and dog toys.<sup>169</sup> The bar for artistically relevant was made low so that the First

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2019 Update, *supra* note 2.

162. *Twentieth Century Fox TV v. Empire Distrib. Inc.*, 875 F.3d 1192, 1199 (9th Cir. 2017) (using the language from the Ninth Circuit to highlight the differences in the application of the *Rogers* test between the Second and Ninth Circuits).

163. *See id.* (stating that the Ninth Circuit created this interpretation on its own; therefore, creating a divide in how the Ninth and Second Circuit use the *Rogers* test).

164. *See* Byron, *supra* note 159, at 4–5.

165. *Twentieth Century Fox TV*, 875 F.3d at 1199.

166. *Id.*; *see also* *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

167. *See* Lanham Act, 15 U.S.C. § 1125(a); *see also* *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Grp., Inc.*, 886 F.2d 490 (2d Cir. 1989); *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806 (2d Cir. 1999).

168. *See* Joshua Besser, *False Endorsement or First Amendment?: An Analysis of Celebrity Trademark Rights and Artistic Expression*, 41 SAN DIEGO L. REV. 1787, 1795 (2004) (stating that the purpose of the Lanham Act is to prevent consumer confusion as to the source of the product); *see also* Kagan, *supra* note 16 (stating the Ninth Circuit’s First Amendment protections are denying trademark owners the ability to differentiate their trademarks).

169. *See* *VIP Prods. LLC v. Jack Daniel’s Props.*, 953 F.3d 1170 (9th Cir. 2020) (finding a dog toy to be an expressive work); *see* William K. Ford, *Restoring Rogers: Video Games, False Association Claims, and the “Explicitly Misleading” Use of*

Amendment would have continued protection.<sup>170</sup> However, this shift in allowing commercial products to be considered as expressive works when they contain a humorous message creates a new balance between First Amendment rights and trademark protections.<sup>171</sup> This new balance could be concerning for trademark owners but favorable for creators.<sup>172</sup> As trademark owners are recognizing that commercial products such as dog toys pass the *Rogers* test when they involve humor, the question arises: what products will be excluded from passing the *Rogers* test?<sup>173</sup>

However, the shift in allowing humor in commercial products to be deemed as expressive is not happening in the Second Circuit.<sup>174</sup> The differences between Ninth Circuit's *Rogers* test and the Second Circuit's *Rogers* test remain intact and enable the circuits to decide similar matters differently.<sup>175</sup> This difference in how the circuits are using the test leads to a difference in protection for brand owners depending on where the case is tried.<sup>176</sup> This raises concerns for forum shopping, as trademark owners will want to try their cases in the Second Circuit as it is a more favorable forum for them.<sup>177</sup>

#### IV. CONCLUSION

The Ninth Circuit in *VIP Products*, expanded the definition of expressive work because it only considered humor when the court should have

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*Trademarks*, 16 J. MARSHALL REV. INTELL. PROP. L. 306, 308–09 (2017) (listing films, magazines, video games, and greeting cards as things currently considered as non-commercial expressive works).

170. See Ford, *supra* note 169, at 314–15.

171. Jared I. Kagan & Emily R. Hush, *Parody Chew Toys and the First Amendment*, 13 LANDSLIDE 22 (2021) (describing the Ninth Circuit's *VIP* decision as potentially “disrupting the fine balance between the Lanham Act and free speech”).

172. See *Bad Spaniels Dog Toys — Expressive Art or Noisy Trademark Infringers?*, TAFT (Apr. 21, 2021), <https://www.taftlaw.com/news-events/law-bulletins/bad-spaniels-dog-toys-expressive-art-or-noisy-trademark-infringers>.

173. See *id.* (stating trademark holders may need to use “hyper-vigilance” when protecting their marks).

174. See *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999) (stating “a trademark parody that endeavors to promote primarily non-expressive products” is not entitled to First Amendment protection).

175. See *December 2019 Update*, *supra* note 2 (discussing the continuing differences in the Second and Ninth Circuits).

176. See Jared Kagan & Jeremy Feigelson, *Will SCOTUS Tell Bad Spaniels to Roll Over?*, IP WATCHDOG (Oct. 22, 2020), <https://www.ipwatchdog.com/2020/10/22/will-scotus-tell-bad-spaniels-roll/id=126606/> (stating concerns over the Ninth Circuit's decision in ruling a dog toy as an expressive work).

177. See *id.* (pointing out that the Intellectual Property Law Association of Chicago is concerned over the forum shopping risk the Ninth Circuit is creating).

considered humor, commentary, and competing products.<sup>178</sup> Therefore, using the product in question, a dog toy, the Ninth Circuit expanded expressive works to cover commercial products.<sup>179</sup> This is a delineation from the Second Circuit, which uses commentary upon the original mark and humor as tools to determine if a work is expressive.<sup>180</sup> However, there are differences with the circuits' uses of the *Rogers* test. The Second Circuit applies the likelihood-of-confusion factors to its *Rogers* test analysis while the Ninth Circuit uses the factors: 'explicit indication,' 'overt claim,' or 'explicit misstatement.'<sup>181</sup> Overall, the Ninth Circuit and Second Circuit's differences in determining expressive works and use of the *Rogers* test are creating a lack of uniformity. *VIP Products* is one of many cases that highlights the differences in how the Ninth Circuit progressed the *Rogers* test and how the circuits' different applications will likely need to be resolved by the Supreme Court.

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178. See Kagan, *supra* note 16.

179. *Id.*

180. See, e.g., *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 813 (2d Cir. 1999).

181. *Twentieth Century Fox TV v. Empire Distrib. Inc.*, 875 F.3d 1199, 1199 (9th Cir. 2017); see Kagan, *supra* note 16.