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RAISING THE THRESHOLD FOR TRADEMARK INFRINGEMENT TO PROTECT FREE EXPRESSION

CHRISTINE HAIGHT FARLEY* AND LISA P. RAMSEY**

*The First Amendment right to free speech limits the scope of rights in trademark law. Congress and the courts have devised various defenses and common law doctrines to ensure that protected speech is exempted from trademark infringement liability. These defensive trademark doctrines, however, are narrow and often vary by jurisdiction. One current example is the speech-protective test first articulated by the Second Circuit in *Rogers v. Grimaldi*, expanded by the Ninth Circuit, and recently restricted by the Supreme Court in *Jack Daniel's Properties v. VIP Products* to uses of another's mark within an expressive work that do not designate the source of the accused infringer's products. The *Rogers* test prevents a finding of infringement if this use is artistically relevant to the underlying work and does not explicitly mislead consumers as to the source or content of the work. This categorical rule has definite advantages over the multi-factor likelihood of confusion test in trademark disputes involving expressive works, but—like other speech-protective doctrines—this test has limitations and shortcomings.*

This Article therefore proposes an alternative test for protecting First

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Amendment interests in trademark law that better balances the public interest in avoiding consumer confusion against the public interest in free expression. This proposed broad trademark fair use test would apply to any informational or expressive use of words, names, or symbols claimed by another as a mark in connection with any goods or services. If this threshold requirement is satisfied, this use is not infringing unless the accused infringer's expression is (1) a false statement about its products (including false claims of sponsorship, endorsement, or approval) or (2) is likely to mislead a reasonable person about the source of the goods, services, or message. This more holistic approach to protecting speech interests in the trademark enforcement context should increase clarity and predictability in trademark law, and will enable courts to dispose of speech-harmful claims as a matter of law early in a lawsuit.

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INTRODUCTION

Trademarks have been used in expressive works for as long as we have had trademark law. Édouard Manet's 1882 painting, *A Bar at the Folies-Bergère*, depicts Bass Ale bottles with label and logo evident.¹ Other famous examples include Andy Warhol's 1962 painting *Campbell Soup Cans*, Janis Joplin's 1970 song *Mercedes Benz*, and the 1961 film *Breakfast at Tiffany's*. A recent example is the 2022 song *Victoria's Secret* by Jax where the trademark becomes a relatable vehicle for biting criticism. Consider the chorus:

I know Victoria's secret
 And, girl, you wouldn't believe
 She's an old man who lives in Ohio
 Making money off of girls like me
 Cashin' in on body issues
 Sellin' skin and bones with big boobs
 I know Victoria's secret
 She was made up by a dude²

Some uses of trademarks do not directly criticize (or laud) brands, but instead satirize them, mash them up with something else, or express a humorous message, such as T-shirts emblazoned with "Homiés" (a play on Hermès) or "Bodega Vendetta" (a play on Bottega Veneta).³

Across different styles and genres, the reason for this phenomenon is clear: art imitates life. We live in a world saturated by brands. Brands demand our attention and seep into our imagination. As a result, we effectively communicate through brands. As the Ninth Circuit recognized, "[t]rademarks often fill in gaps in our vocabulary and add a contemporary flavor to our expressions."⁴ At the same time, however, brands insist that they get the final say over any discourse that invokes them. For instance, Caterpillar Inc. sued the Walt Disney Co. because the film *George of the Jungle 2* had the villains riding Caterpillar brand

1. Kelly Grovier, *A Bar at the Folies-Bergère: A Symbol Planted in Cleavage*, BBC CULTURE (Mar. 11, 2019), <https://www.bbc.com/culture/article/20190311-a-bar-at-the-foles-bergere-a-symbol-planted-in-cleavage> [<https://perma.cc/ZRL8-4QFX>].

2. JAX, *VICTORIA'S SECRET* (Atlantic Records 2022).

3. Alexandria Symonds, *Fashion Logo Parodies, Strictly Tongue in Chic*, N.Y. TIMES (Dec. 11, 2013), <https://www.nytimes.com/2013/12/12/fashion/fashion-logo-parodies-tshirts-strictly-tongue-in-chic.html> [<https://perma.cc/XZD6-669B>].

4. *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

bulldozers.⁵ Brands cannot have it both ways. The First Amendment does not permit “the trademark owner . . . to control public discourse” about its trademark.⁶ This is so even where such discourse creates a risk of harm to the brand. A similar clash of interests occurs in defamation law, where we do not question that reputational harm must often yield to the First Amendment.⁷ In trademark law too, efforts to balance trademark protection with First Amendment freedoms must likewise ensure “breathing space” for speakers.

The tension between trademark rights and the First Amendment right of freedom of speech, though long existing, has not been fully or adequately resolved. Unlike in copyright law, where the broad, statutory defense of copyright fair use is the established test used to address this tension,⁸ the federal trademark act does not have a similar “built-in” protection for First Amendment interests. Almost anything that can convey source-distinguishing meaning can qualify as a trademark,⁹ the “likely to cause confusion” requirement in the infringement provisions is a broad and ambiguous standard,¹⁰ and the few statutory defenses to infringement (such as descriptive fair use) have a narrow focus.¹¹ Moreover, the speech-protective trademark rules created by judges only apply in limited circumstances or in some jurisdictions, and often vary in their approach to balancing trademark and free speech rights depending on the circuit where the court is located.¹² Examples include the defensive common law doctrines of nominative fair use,

5. *Caterpillar Inc. v. Walt Disney Co.*, 287 F. Supp. 2d 913, 919 (C.D. Ill. 2003) (denying a Temporary Restraining Order stating “what drives the Court’s discomfort with Caterpillar’s position is the fact that the appearance of products bearing well known trademarks in cinema and television is a common phenomenon”).

6. *Mattel, Inc.*, 296 F.3d at 900; *see* U.S. CONST. amend. I (“Congress shall make no law . . . abridging the freedom of speech . . .”).

7. *See* *Hustler Mag., Inc. v. Falwell*, 485 U.S. 46, 49-52, 56 (1988) (discussing First Amendment protection for offensive expression in disputes involving claims of defamation and intentional infliction of emotional distress).

8. 17 U.S.C. § 107. In addition to fair use, the Supreme Court has stated that the idea/expression dichotomy is the other doctrine that functions as a “built-in” First Amendment protection for free speech in copyright law. *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003) (citing *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 556 (1985)).

9. *Qualitex, Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (interpreting the broad definition of a trademark in 15 U.S.C. § 1127). We use “trademark” and “mark” interchangeably in this Article to refer to trademarks, service marks, and trade dress.

10. 15 U.S.C. §§ 1114(1), 1125(a)(1)(A).

11. *Id.* § 1115(b); *see* William McGeeveran, *Four Free Speech Goals for Trademark Law*, 18 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 1205, 1214-19 (2008).

12. McGeeveran, *supra* note 11, at 1210-11.

comparative advertising, and parody; a commercial use or trademark use requirement for infringement liability; and the *Rogers v. Grimaldi* balancing test, which requires a higher threshold for infringement liability in disputes involving the unauthorized use of another's mark in the title or content of an expressive work.¹³

The Supreme Court has not directly addressed how courts should determine whether trademark infringement law is consistent with the free speech right.¹⁴ It has, however, decided that certain trademark registration provisions conflict with the First Amendment. In *Matal v. Tam*¹⁵ and *Iancu v. Brunetti*,¹⁶ the Court held that the provisions in the federal trademark act (commonly known as the Lanham Act) banning registration of matter that is disparaging, immoral, or scandalous regulate expression based on its viewpoint, and are therefore facially-invalid regulations of speech protected by the First Amendment.¹⁷ The Court also observed that trademarks can convey messages unrelated to

13. See *infra* Parts I & II.

14. In *S.F. Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 539 & 541 n.19 (1987), the Supreme Court held the Amateur Sports Act's ban on unauthorized use of the Olympic trademarks was a reasonable way to protect the "legitimate property right" of the United States Olympic Committee (USOC) and held that Congress had discretion to "determine that unauthorized uses, even if not confusing, nevertheless may harm the USOC by lessening the distinctiveness and thus the commercial value of the marks." While *S.F. Arts & Athletics* is the primary case cited in support of the constitutionality of trademark dilution law, see Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred*, 44 *Liquormart, and Bartnicki*, 40 HOUS. L. REV. 697, 736–38 (2003) (discussing the problems with the Court's analysis and the fact it is inconsistent with *Cohen v. California*, 403 U.S. 15, 17–18 (1971)), the goals of the Amateur Sports Act are different than the purposes of the federal trademark enforcement laws which are set forth by Congress in the Lanham Act. 15 U.S.C. § 1127 (discussing the intent of the Lanham Act, which does not include the protection of property rights in trademarks or the protection of goodwill invested in a mark against nonmisleading uses).

15. 582 U.S. 218 (2017).

16. 139 S. Ct. 2294 (2019).

17. *Id.* at 2297–98 (evaluating the constitutionality of the trademark law banning registration of matter that is immoral or scandalous in section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a)); *Tam*, 582 U.S. at 247 (same for disparagement provision in section 2(a)). See generally Lisa P. Ramsey, *Free Speech Challenges to Trademark Law After Matal v. Tam*, 56 HOUS. L. REV. 401, 404–05, 410–455 (2018) (discussing how the Court's First Amendment analysis in the *Tam* decision may apply to other trademark laws); Christine Haight Farley, *Public Policy Limitations on Trademark Subject Matter: A U.S. Perspective*, in *THE CAMBRIDGE HANDBOOK OF INTERNATIONAL AND COMPARATIVE TRADEMARK LAW* (Irene Calboli & Jane C. Ginsburg, eds., 2020) (discussing the First Amendment constraint on statutory bars to registration and the implications of *Tam* and *Brunetti* on other public policy based subject matter limitations).

a product's source,¹⁸ and clarified that trademark laws that chill nonmisleading expression can implicate the free speech right. The decision in *Tam* opened the door to wide-ranging free speech challenges to trademark laws in the United States. Unfortunately, *Tam* and *Brunetti* do not provide much guidance on how to navigate the relationship between trademark and free speech rights outside the context of laws banning registration of offensive trademarks.

Nor do *Tam* and *Brunetti* clarify how the burdens that trademark enforcement laws place on nonmisleading expression can survive constitutional scrutiny.¹⁹ In this regard it is significant that the Supreme Court chose not to categorize all uses of trademarks as commercial speech in *Tam* and recognized that nonmisleading commercial uses of trademarks are protected by the First Amendment.²⁰ Writing for a plurality of four Justices, Justice Alito explained in *Tam* that the challenged disparagement provision could not even satisfy the intermediate scrutiny test for evaluating the constitutionality of regulations of commercial speech that are not misleading.²¹ Justice Kennedy (also writing for four Justices) stated that the provision at issue was "a form of speech suppression so potent that it must be subject to rigorous constitutional scrutiny" even though it regulated commercial speech, and then proceeded to find the law did not satisfy this test.²² Justice Thomas, who joined Justice Alito's opinion but also wrote separately, explained that regulations of commercial speech should be subject to strict scrutiny analysis if the "government seeks to restrict truthful speech in order to suppress the ideas it conveys."²³ In *Brunetti*, the Court did not apply intermediate or strict scrutiny analysis to the Lanham Act's ban on the registration of scandalous and immoral matter because a majority of the Justices held these laws discriminated on the

18. *Tam*, 582 U.S. at 224 ("By that time, trademark had expanded far beyond phrases that do no more than identify a good or service. Then, as now, trademarks often consisted of catchy phrases that convey a message.").

19. Justice Kennedy's concurrence in *Tam* notes that it is settled that trademark law can prohibit the use of confusing or misleading trademarks. *Id.* at 252 (Kennedy, J., concurring).

20. *See, e.g., id.* at 247 (Alito, J.) (plurality opinion); *id.* at 251 (Kennedy, J., concurring); *id.* at 254 (Thomas, J., concurring).

21. *Id.* at 245-47 (Alito, J.) (plurality opinion). The Court left open the question of whether *Central Hudson's* intermediate scrutiny test, *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 564-65 (1980), should be used when deciding free speech challenges to other provisions of the Lanham Act. *Tam*, 582 U.S. at 244 n.16, 245 n.17.

22. *Tam*, 582 U.S. at 247, 251-54 (Kennedy, J., concurring)

23. *Id.* at 254 (Thomas, J., concurring).

basis of viewpoint and the government conceded these laws could only “survive Free Speech Clause review” if they were viewpoint-neutral regulations of speech.²⁴

The Justices missed another opportunity to clarify how to resolve conflicts between trademark infringement law and the right to freedom of expression in *Jack Daniel’s Properties v. VIP Products*.²⁵ In this case involving a dog chew toy that parodied the Jack Daniel’s whisky brand, the Supreme Court chose not to adopt any particular speech-protective trademark doctrine to use in such disputes. Instead, it held only that application of the stringent threshold test for infringement set forth in *Rogers* “is not appropriate when the accused infringer has used a trademark to designate the source of its own goods—in other words, has used a trademark as a trademark.”²⁶ Per the Court, “[t]hat kind of use falls within the heartland of trademark law, and does not receive special First Amendment protection.”²⁷ Importantly, the Court also clarified that the expressive aspects of a source-designating use of another’s mark still matter when assessing whether the use is likely to cause confusion.²⁸ In addition, the Court held that the “noncommercial use of the mark” exclusion from trademark dilution liability in the Lanham Act cannot be broadly construed to include “every parody” because such an interpretation would conflict with the separate parody fair use exclusion in the Act, which “does not apply when the use is ‘as a designation of source for the person’s own goods or services.’”²⁹ Beyond these narrow holdings, the Court did not clarify how the First Amendment may limit the scope of trademark rights in the Lanham Act.

The facts of the *Jack Daniel’s* case provide an interesting example of how trademark and free speech rights can clash in the context of a trademark dispute. VIP Products LLC (“VIP”) sells a line of dog toys called “Silly Squeakers” that loosely imitate and poke fun at the marks

24. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019).

25. *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023).

26. *Id.* at *3.

27. *Id.*

28. *Id.* at *6 (The likelihood of confusion “inquiry is not blind to the expressive aspect of the Bad Spaniels toy that the Ninth Circuit highlighted. Beyond source designation, VIP uses the marks at issue in an effort to ‘parody’ or ‘make fun’ of Jack Daniel’s. Tr. Of Oral Arg. 58, 66. And that kind of message matters in assessing confusion because consumers are not likely to think that the maker of a mocked product is itself doing the mocking.”).

29. *Id.* at *10-11 (quoting 15 U.S.C. §§ 1125(c)(3)(A), 1125(c)(3)(C)).

and trade dress of various brands of beer, wine, soda, and liquor.³⁰ One such product in this line is the “Bad Spaniels” toy that parodies the Jack Daniel’s iconic black-label whiskey bottle. The toy mimics the shape, size, and design of that bottle, but also adds an image of a spaniel’s head with a guilty look in its eyes and several poop jokes. The label on the toy replaces “Jack Daniel’s” with “Bad Spaniels,” “Old No. 7” with “the Old No. 2,” “Tennessee Sour Mash Whiskey” with “on your Tennessee Carpet,” “40% ALC. BY VOL.” with “43% POO BY VOL,” and “80 PROOF” with “100% SMELLY.” The back of the packaging for the Bad Spaniels toy includes a disclaimer that says: “This product is not affiliated with Jack Daniel Distillery.”³¹ According to VIP, its “purported goal in creating Silly Squeakers was to ‘reflect’ ‘on the humanization of the dog in our lives,’ and to comment on ‘corporations [that] take themselves very seriously.’”³²

After receiving a cease and desist letter from Jack Daniel’s, VIP sought a declaratory judgement that its Bad Spaniels toy neither infringed nor diluted trademarks owned by Jack Daniel’s.³³ Jack Daniel’s counterclaimed, asserting trademark infringement and dilution.³⁴ When determining whether this use infringed or diluted the Jack Daniel’s marks, the district court did not alter its analysis in determining Jack Daniel’s claims to account for the speech interests involved in this dispute. Instead, it held that the infringement claims should be evaluated using the standard trademark likelihood of confusion analysis, because VIP was using the marks of Jack Daniel’s “to promote a somewhat non-expressive, commercial product.”³⁵ It found VIP liable for infringement and dilution of Jack Daniel’s marks and issued a permanent injunction enjoining VIP from manufacturing and selling its Bad Spaniels toy.³⁶

30. VIP Prods. LLC v. Jack Daniel’s Prods., Inc., 953 F.3d 1170, 1172 (9th Cir. 2020), *vacated & remanded*, Jack Daniel’s Prods., Inc. v. VIP Prods. LLC, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023).

31. Brief for Petitioner at 14, Jack Daniel’s Prods., Inc. v. VIP Prods. LLC, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023).

32. *VIP Prods.*, 953 F.3d at 1172 (alteration in original); *see also* Brief of Respondent at 16-19, *Jack Daniel’s*, 2023 WL 3872519 (No. 22-148).

33. VIP Prods. LLC v. Jack Daniel’s Prods., Inc., No. CV-14-2057-PHX-SMM, 2016 WL 5408313, at *1-2 (D. Ariz. Sept. 27, 2016), *aff’d in part, rev’d in part, vacated in part*, 953 F.3d 1170.

34. *Id.*

35. *Id.* at *5 (citing Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, 415-16 (S.D.N.Y. 2002)).

36. VIP Prods. LLC v. Jack Daniel’s Prods., Inc., 291 F. Supp. 3d 891, 899-911 (D. Ariz. Jan. 29, 2018), *rev’d in part, vacated in part*, 953 F.3d 1170 (9th Cir. 2022).

On appeal, a unanimous Ninth Circuit panel held that the district court erred in not classifying VIP's use as noncommercial and in not applying the higher-threshold for infringement liability set forth in the speech-protective trademark test first articulated by the Second Circuit in *Rogers v. Grimaldi*.³⁷ Under the *Rogers* test, the Lanham Act cannot apply to VIP's humorous use of the Jack Daniel's marks in this expressive work unless "defendant's use of the mark is either (1) 'not artistically relevant to the underlying work' or (2) 'explicitly misleads consumers as to the source or the content of the work.'"³⁸ The circuit court remanded the case and explained that the lower court should have focused on the content of VIP's message—here, its spoof of the Jack Daniel's marks within the Bad Spaniels design—rather than the type of products sold by the accused infringer when determining whether VIP's dog toy qualified for the noncommercial use of the mark exemption in the dilution statute and whether the *Rogers* test should be used to evaluate the infringement claims.³⁹ The district court held on remand that VIP was not liable for infringement or dilution and the Ninth Circuit affirmed.⁴⁰ The position of Jack Daniel's at the Supreme Court was that the *Rogers* test is inconsistent with the text of the Lanham Act and, at a minimum, this higher threshold for infringement liability should not be applied when the mark of another is displayed on an ordinary commercial product like VIP's dog toy.⁴¹ The Court addressed neither of these arguments in its decision.⁴²

37. *VIP Prods.*, 953 F.3d at 1175–76 ("Because Bad Spaniels is an expressive work, the district court erred in finding trademark infringement without first requiring [Jack Daniel's] to satisfy at least one of the two *Rogers* prongs.") (citing *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989)); *id.* at 1176 (holding that VIP's speech is noncommercial).

38. *Id.* at 1174 (quoting *Gordon*, 909 F.3d at 265 and discussing the test in *Rogers*, 875 F.2d at 999).

39. *Id.* at 1174–76; *see* 15 U.S.C. § 1125(c)(3)(C) (exemption from dilution liability for noncommercial use of the mark).

40. *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, No. CV-14-2057-PHX-SMM, 2021 WL 5710730 (D. Ariz. Oct. 8, 2021), *aff'd* 2022 WL 1654040 (9th Cir. Mar. 18, 2022), *vacated & remanded*, *Jack Daniel's Prods., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023).

41. Brief for Petitioner at 4, 19–39, *Jack Daniel's Prods., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023). Jack Daniel's also argued at the Supreme Court that the dilution statute should apply because this is not a noncommercial use of the mark. *Id.* at 5, 39–52.

42. *Jack Daniel's Prods., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023). Justice Gorsuch, however, filed a separate concurrence, joined by Justices Thomas and Barrett, that questioned whether the *Rogers* test is viable. He said that "it is not entirely clear where the *Rogers* test comes from—is it commanded by the First

The *Rogers* test is a doctrine that helps ensure First Amendment interests are protected in trademark infringement law. *Rogers* is a speech-protective interpretation of the broad “likely to cause confusion” language in the infringement statutes that furthers trademark law’s goals of preventing fraudulent, deceptive, and misleading uses of marks. However, the *Rogers* test does not adequately protect all uses of trademarks that implicate free speech interests. In addition to being restricted by the Supreme Court in *Jack Daniel’s* to non-trademark uses of marks within expressive works, *Rogers* has other limitations that we discuss below. We think Congress or courts should adopt a broader speech-protective test that applies in all trademark disputes that risk suppressing the free flow of truthful expression, and which better aligns with the First Amendment’s protection of both noncommercial speech and commercial speech that is not misleading. This Article proposes such a test.

To demonstrate why our proposed trademark fair use test is necessary, the Article first provides background information about the *Rogers* test and delineates its benefits and shortcomings. Next, it briefly reviews other ways that Congress and the courts currently resolve clashes between trademark and free speech rights. One problem is that courts often cannot use these narrow statutory and common law doctrines when First Amendment interests are implicated in a trademark dispute. Finally, the Article proposes the adoption of a new broad fair use doctrine in trademark infringement law that permits the informational or expressive use of another’s mark unless it is a false statement about the accused infringer’s products, or it is likely to mislead a reasonable person about the source of the goods, services, or message.⁴³ This approach is similar to the *Rogers* test in that it considers whether communications that include another’s mark mislead the public about the product’s source, but our proposed threshold requirement is broader to encompass all speech covered by the First

Amendment, or is it merely gloss on the Lanham Act, perhaps inspired by constitutional-avoidance doctrine?” *Id.* at *11-12 (Gorsuch, J., concurring). That concurring opinion also questioned whether “*Rogers* is correct in all its particulars” and noted that “lower courts should be attuned” to the fact that “serious questions about the decision” remain. *Id.* at *12.

43. For the sake of brevity and simplicity, this Article will often use the phrase “products” in place of the phrase “goods or services”. Also note that an “informational use” of another’s mark refers to the use of language or symbols to provide information about the qualities or purpose of a product, or to convey other information about the trademark owner (such as in news reporting or comparative advertising), and not use of the mark solely to provide information about the source of the defendant’s goods or services.

Amendment. Our two-prong test avoids consideration of the “artistic relevance” of this use of the plaintiff’s mark, contains an objective infringement standard that is more clear than the term “explicitly misleading” in the *Rogers* test, and arguably does a better job balancing the public interest in avoiding consumer confusion against the public interest in free expression.

I. UNDERSTANDING THE *ROGERS V. GRIMALDI* TEST

The speech-protective test first set forth by the Second Circuit in *Rogers v. Grimaldi*, and later developed by the Ninth Circuit, has become central in resolving many trademark-speech conflicts when someone uses another’s mark to express ideas or convey information.⁴⁴ To determine whether the *Rogers* test is the best approach for balancing trademark and free speech rights requires an understanding of its origins, which reveal the reasons for its shortcomings as a test to be applied broadly in any context where trademark laws might clash with the right to freedom of expression.

A. *The Second Circuit’s Creation of the Rogers Test*

Ginger Rogers is most remembered as Fred Astaire’s co-star in a string of musicals, whereas she deserves more credit for her Academy Award-winning acting career,⁴⁵ and, for her important contribution to trademark law. Of course, Rogers did not set out to make new law by losing her lawsuit over the title—*Ginger and Fred*—of a Fellini film, which was not about her. Perhaps she expected a standard application of the multi-factor likelihood of confusion test used to determine liability under the Lanham Act in lawsuits involving claims of false endorsement or trademark infringement.⁴⁶ However, neither the

44. See, e.g., *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091 (9th Cir. 2022); *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 902 (9th Cir. 2002); Order Granting Defendant’s Motion to Dismiss, *UFO Mag., Inc. v. Showtime Network, Inc.*, No. 22-cv-00078, 2022 WL 16644914 (D. Wyo. Nov. 3, 2022).

45. Ginger Rogers won the Academy Award for Best Actress for *Kitty Foyle* (1940). JOCELYN FARIS, *GINGER ROGERS: A BIO-BIBLIOGRAPHY* 7 (1994); Sarah Kaufman, *Ginger Rogers at 100: Even with Astaire, Always Taking the Lead*, WASH. POST (Feb. 11, 2011), https://www.washingtonpost.com/entertainment/ginger-rogers-at-100-even-with-astaire-always-taking-the-lead/2011/02/11/ABum8sQ_story.html [<https://perma.cc/TV3L-6WKS>].

46. To prevail on a claim for trademark infringement or false endorsement under the Lanham Act, a plaintiff must demonstrate that the defendant’s use of the mark or name is likely to cause confusion. 15 U.S.C. §§ 1114(1), 1125(a)(1)(A). To make this determination, courts normally use a multi-factor test which varies by circuit but usually

district court nor the court of appeals in *Rogers v. Grimaldi* thought such an approach complied with the First Amendment.⁴⁷ After considering whether to adopt the “no alternative avenues of communication” standard previously applied by courts in some trademark disputes or the district court’s proposed categorical rule “that the Lanham Act is inapplicable to all titles that can be considered artistic expression,” the Second Circuit ultimately determined that a new test was required to “sufficiently accommodate the public’s interest in free expression” and “protect the public against flagrant deception.”⁴⁸

The Second Circuit set forth its new speech-protective interpretation of the Lanham Act in two sentences, and this test is currently known as the “*Rogers* balancing test” or “*Rogers* test”:

We believe that in general the 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. In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.⁴⁹

As discussed below, courts later applied this test in trademark disputes under the Lanham Act that also implicated First Amendment interests. Some only apply the balancing test set forth in the first sentence that requires weighing of Lanham Act and free speech interests.⁵⁰ Today, most courts quote that first sentence and then also

includes similar factors that require a fact-intensive, case-by-case analysis, see, e.g., *Polaroid Corp. v. Polarad Elecs., Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), which are discussed later.

47. *Rogers v. Grimaldi*, 695 F. Supp. 112, 124 (S.D.N.Y. 1988), *aff’d*, 875 F.2d 994 (2d Cir. 1989); *Rogers v. Grimaldi*, 875 F.2d 994, 1001–02 (2d Cir. 1989).

48. *Rogers*, 875 F.2d at 999.

49. *Id.*

50. See, e.g., *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc.*, 886 F.2d 490 (2d Cir. 1989). The Second Circuit applied the *Rogers* balancing test less than four months after *Rogers* in *Cliffs Notes* when the defendant used another company’s trade dress for its books on the cover of a parody “Spy Notes” book. The court said: “We believe that the overall balancing approach of *Rogers* and its emphasis on construing the Lanham Act ‘narrowly’ when First Amendment values are involved are both relevant in this case.” *Id.* at 494. Citing *Rogers*, the court explained that “in deciding the reach of the Lanham Act in any case where an expressive work is alleged to infringe a trademark, it is appropriate to weigh the public interest in free expression against the public interest in avoiding consumer confusion.” *Id.* at 494. Although the dispute in *Cliffs Notes* involved an expressive work, and Judge Newman was in the majority in *Cliffs Notes* and *Rogers*,

apply the two prongs of the *Rogers* test set forth in the second sentence, which provide that the Lanham Act should not be applied in disputes involving artistic works unless (1) “the title has no artistic relevance to the underlying work whatsoever” or (2) “the title explicitly misleads as to the source or the content of the work.”⁵¹

Under the first prong of the *Rogers* test, a court must determine if the defendant’s use of the mark has “no artistic relevance” or surpasses the “low threshold of minimal artistic relevance.”⁵² *Bette Davis Eyes* is an example of a song title that is artistically relevant to the underlying work.⁵³ As the Lanham Act restricts “the words the speaker may use,”⁵⁴ this low requirement of expressive relevance is consistent with the Supreme Court’s opinion in *Cohen v. California*, where the Court held that a swear word displayed on a jacket was protected expression.⁵⁵ The Second Circuit even quoted *Cohen* in *Rogers*: “We cannot indulge the facile assumption that one can forbid particular words without running a substantial risk of suppressing ideas in the process.”⁵⁶ In *Cohen*, the Supreme Court recognized that particular words are chosen for their expressive impact.⁵⁷ That fact is also true with regard to artistic works. Janis Joplin could have chosen to sing about unnamed luxury cars, but the effect would be impaired. The Second Circuit’s choice to make the criteria for the first prong of the *Rogers* test “no artistic relevance” permits courts to simply point to a creative choice without going so far as to sit in judgement of the value of that choice. The bar is thus set low

the Second Circuit did *not* apply the two prongs of the *Rogers* test when it evaluated the Lanham Act claim because it said that *Rogers* dealt with the specific question of “whether a title is false advertising” and therefore “was concerned with a very different problem from the one we have here.” *Id.* at 491–92, 494. The Second Circuit’s own contemporary treatment of the *Rogers* opinion in *Cliffs Notes* suggests that the *Rogers* court may, at the time of the opinion, have only intended the *Rogers* two-prong test to be applied in Lanham Act disputes involving the use of a celebrity’s name in an allegedly misleading title of an artistic work. *Rogers*, 875 F.2d at 999.

51. See, e.g., *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

52. *Rogers*, 875 F.2d at 999.

53. *Id.* at 1000.

54. *Id.*

55. *Cohen v. California*, 403 U.S. 15, 26 (1971).

56. *Rogers*, 875 F.2d at 999 (quoting *Cohen*, 403 U.S. at 26).

57. As Judge Kozinski recognized in a case involving the Lanham Act’s special ban on unauthorized use of the Olympics marks, “Fuck the Draft” has greater expressive impact than “I Strongly Resent the Draft.” *Int’l Olympic Comm. v. S.F. Arts & Athletics*, 789 F.2d 1319, 1321 (9th Cir. 1986) (Kozinski, J., dissenting).

deliberately. Courts should not decide what art means or play editor to or critic of that artistic expression.⁵⁸

The second “explicitly misleads” prong of the *Rogers* test created a new higher threshold of confusion that must be established in Lanham Act disputes involving artistic works.⁵⁹ The Second Circuit provides examples both real and hypothetical that satisfy this more stringent test. First, it instructs that the advertisements at issue in the *Dallas Cowboys Cheerleaders v. Pussycat Cinema*⁶⁰ case were explicitly misleading because they falsely stated that the lead actress in the pornographic film had been a former Dallas Cowboys’ cheerleader.⁶¹ If the title for the *Ginger and Fred* film had actually been *The True Life Story of Ginger and Fred*, per the court this would constitute “an explicitly misleading description of content.”⁶² The Second Circuit also explains that titles such as *Nimmer on Copyright* and *Jane Fonda’s Workout Book*, or a subtitle containing the phrase “an authorized biography,” are “explicit references” to a person’s involvement in an underlying work and are “words explicitly signifying endorsement.”⁶³ If these statements are false, a Lanham Act violation should be found because these titles explicitly mislead as to the book’s source or content.

The Second Circuit contrasts these illustrations in *Rogers* with the song title *Bette Davis Eyes* and the film title *Come Back to the Five and Dime, Jimmy Dean, Jimmy Dean*, which “include a well-known name without any overt indication of authorship or endorsement.”⁶⁴ It explains: “To some people, these titles might implicitly suggest that the named celebrity had endorsed the work or had a role in producing it. Even if that suggestion is false, the title is artistically relevant to the work. In these circumstances, the slight risk that such use of a celebrity’s name might implicitly suggest endorsement or sponsorship to some people is outweighed by the danger of restricting expression, and the Lanham Act is not applicable.”⁶⁵ From these examples, we learn that a

58. See Christine Haight Farley, *Judging Art*, 79 TUL. L. REV. 805 (2005); cf. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903) (discussing the “worth of pictorial illustrations” in a copyright infringement dispute involving the issue of whether advertisements for a circus featuring designs of circus performers were sufficiently creative to be subject to copyright protection).

59. *Rogers*, 875 F.2d at 998–99.

60. 604 F.2d 200, 203, 206 (2d Cir. 1979).

61. *Id.*; *Rogers*, 875 F.2d at 998–99, 999 n.5 (citing *Dall. Cowboys Cheerleaders*, 604 F.2d at 206).

62. *Rogers*, 875 F.2d at 999.

63. *Id.*

64. *Id.*

65. *Id.* at 999–1000.

title is explicitly misleading only where the “words [are] explicitly signifying endorsement” or there is an “overt indication of authorship or endorsement.”⁶⁶ In insisting that such a claim be explicit or overt, the second prong of the test thus intentionally sets a high bar for liability under the Act.⁶⁷

As the *Ginger and Fred* title was artistically relevant and “contain[ed] no explicit indication that Rogers endorsed the film or had a role in producing it,” the Second Circuit found the public interest in artistic expression precluded application of the multi-factor likelihood of confusion test despite the fact “that some members of the public would draw the incorrect inference that Rogers had some involvement with the film.”⁶⁸ Moreover, while certain people might also think the film was about Rogers and Astaire, the Second Circuit explained that “the title is entirely truthful as to its content in referring to the film’s fictional protagonists who are known to their Italian audience as ‘Ginger and Fred.’”⁶⁹ Per the court, “[t]his mixture of meanings, with the possibly misleading meaning not the result of explicit misstatement, precludes a Lanham Act claim for false description of content in this case.”⁷⁰ Importantly, the standard showing of a likelihood of confusion—here, the “risk that the title will mislead some consumers as to what the work is about”—is not adequate in a case involving an artistic work because “that risk is outweighed by the danger that suppressing an artistically relevant though ambiguous title will unduly restrict expression.”⁷¹

Today courts in the Second Circuit hold that use of another’s mark is “explicitly misleading” under the *Rogers* test if it “induces members of the public to believe” that the trademark owner “prepared or otherwise authorized” the work of artistic expression.⁷² This determination may be made by applying the court’s multi-factor likelihood of confusion test known as the “*Polaroid*” factors, with the important qualification that these factors “must be particularly compelling to outweigh the First

66. *Id.* at 999.

67. *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 462 (9th Cir. 2020) (stating the second prong sets “a high bar that requires the use to be ‘an explicit indication’, ‘overt claim’, or ‘explicit misstatement’ about the source of the work”) (quoting *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013)).

68. *Rogers*, 875 F.2d at 1001.

69. *Id.*

70. *Id.*

71. *Id.*

72. *Twin Peaks Prods. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993).

Amendment interest recognized in *Rogers*.⁷³ In essence, the *Rogers* test now functions as a balancing test in the Second Circuit. The eight *Polaroid* factors are: (1) strength of the mark; (2) similarity of the marks; (3) proximity of the goods or services; (4) evidence that the senior user may “bridge the gap” by entering the market of the alleged infringer; (5) evidence of actual consumer confusion; (6) evidence that the mark was adopted in bad faith; (7) respective quality of the products; and (8) sophistication of consumers in the relevant market.⁷⁴ According to the trial court in the *Hermès International v. Rothschild* trademark dispute in the Southern District of New York, “the *Polaroid* factors require a fact-intensive, context-specific analysis presented on a full record” and “in most cases involving *Rogers* there would remain genuine issues of material fact with respect to many or most of its factors, even at the late stages of litigation.”⁷⁵ This approach is not followed in the Ninth Circuit, as discussed in the next Section.

There is also significant disagreement about what types of expression satisfy the threshold for application of the *Rogers* test.⁷⁶ Language in the *Rogers* opinion provides some guidance on this issue, but it does not clearly answer this question. The Second Circuit held in *Rogers* that neither a “nearly absolute privilege for movie titles” nor the regular likelihood of confusion standard should apply to Ginger Rogers’ Lanham Act claim because “[t]itles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial

73. *Id.*; see, e.g., Opinion and Order Denying Parties’ Cross Motions for Summary Judgment, *Hermès Int’l v. Rothschild*, No. 22-cv-384, 2023 WL 1458126, at *8-9 (S.D.N.Y. Feb. 2, 2023).

74. *Polaroid Corp. v. Polarad Elecs., Corp.*, 287 F.2d 492, 495 (2d Cir. 1961).

75. *Hermès Int’l*, No. 22-cv-384, 2023 WL 1458126, at *9 (holding that *Rogers* applied where defendant used a phrase similar to the trademark owner’s “Birkin” mark in connection with the sale of nonfungible tokens linked to “MetaBirkins” digital images of fur covered Birkin bags, but denying summary judgment to both parties); see also *Hermès Int’l v. Rothschild*, 590 F. Supp. 3d 647 (S.D.N.Y. 2022). While other district courts in the Second Circuit have also denied motions to dismiss trademark infringement claims as a matter of law under the *Rogers* test, see, e.g., *Chooseco LLC v. Netflix, Inc.*, 439 F. Supp. 3d 308 (D. Vt. 2020) (denying motion to dismiss due to a factual dispute about whether the use was explicitly misleading), some courts in the Second Circuit have ruled in favor of defendants as a matter of law. See, e.g., *Monbo v. Nathan*, No. 18-CV-5930, 2022 WL 4591905 (E.D.N.Y. Aug. 26, 2022) (granting motion for summary judgment on trademark claims); *Gayle v. Allee*, No. 18 CIV. 3774, 2021 WL 120063 (S.D.N.Y. Jan. 13, 2021) (granting motion to dismiss); *Brown v. Showtime Networks, Inc.*, 394 F. Supp. 3d 418 (S.D.N.Y. 2019) (same).

76. See, e.g., Briefs of the parties and amici filed in *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023), [https://www.supremecourt.gov/search.aspx?filename=/docket/docketfiles/html/pub lic/22-148.html](https://www.supremecourt.gov/search.aspx?filename=/docket/docketfiles/html/public/22-148.html) [<https://perma.cc/X5ZV-RN3D>].

promotion The artistic and commercial elements of titles are inextricably intertwined.”⁷⁷ A speech-protective reading of this language suggests that the focus of *Rogers*’ threshold requirement should be on the “hybrid nature” of the expression alleged to violate the Lanham Act (*e.g.*, the film’s title) and whether the artistic and commercial components of that expression are inextricably intertwined, rather than on the type of products for sale. If the expression combines artistic and commercial speech and these components of the message are inextricably intertwined, the First Amendment imposes limits on the scope of trademark protection. Under this approach, so long as the mark is not used as a source indicator by the accused infringer, the *Rogers* test should apply when humorous expression is displayed on dog toys, T-shirts, or similar products. The fact the expression appears on the surface of the toy or shirt rather than in a painting on a canvas is irrelevant.⁷⁸

Some argue, however, that the *Rogers* test should have a more narrow threshold requirement.⁷⁹ Under this view, *Rogers*’ heightened standard for infringement can only be applied when the accused infringer’s products are movies, plays, books, songs, or similar expressive works that have titles, and not when the accused infringer is using the mark in connection with the advertising or sale of ordinary commercial products. This view looks for support in the examples set forth by the Second Circuit in *Rogers*: “Movies, plays, books, and songs are all indisputably works of artistic expression” that “are also sold in the commercial marketplace like other more utilitarian products.”⁸⁰ In rejecting the district court’s proposed test that would deem the Lanham Act inapplicable to all titles that can be considered artistic expression, the Second Circuit explained that “[t]he purchaser of a book, like a purchaser of a can of peas, has a right not to be misled as to the source of the product.”⁸¹ Yet the court also noted that fact-intensive, case-by-case analysis of the likelihood of confusion factors was also not appropriate in this context because consumers of artistic works have

77. *Rogers v. Grimaldi*, 875 F.2d 994, 997–98, 1006 (2d Cir. 1989).

78. *See, e.g.*, Brief of Respondent at 13, 24–27, *Jack Daniel’s Prods., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023); Brief of *Amici Curiae* First Amendment Professors in Support of Respondent, *Jack Daniel’s*, 2023 WL 3872519 (No. 22-148).

79. *See, e.g.*, Brief for Petitioner at 38–39, *Jack Daniel’s*, 2023 WL 3872519 (No. 22-148); Brief of the Motion Picture Association, Inc. as *Amicus Curiae* in Support of Neither Party at 23–30, *Jack Daniel’s*, 2023 WL 3872519 (No. 22-148); Brief of *Amicus Curiae* Nike, Inc. in Support of Petitioner at 2–13, *Jack Daniel’s*, 2023 WL 3872519 (No. 22-148).

80. *Rogers*, 875 F.2d at 997.

81. *Id.* at 997–98.

both “an interest in not being misled and . . . an interest in enjoying the results of the author’s freedom of expression” and “the expressive elements of titles requires more [First Amendment] protection than the labeling of ordinary commercial products.”⁸² Under this approach, the *Rogers* test should not apply in trademark disputes like *Jack Daniel’s* because dog toys are more like cans of peas than movies or other traditional artistic and literary works.

The Supreme Court declined to resolve this debate in *Jack Daniel’s*. We believe the better view—which is supported by the Court’s First Amendment jurisprudence, as discussed later—is that the threshold requirement in *Rogers* should focus on whether the noncommercial and commercial elements of the artistic expression are inextricably intertwined, rather than the medium of the message. The hybrid nature of titles of artistic works is arguably the reason why the Second Circuit created the *Rogers* test, and why the Ninth Circuit applies *Rogers* when the defendant’s use of another’s mark is part of any expressive work protected by the First Amendment, as discussed next.

B. *The Ninth Circuit’s Development of the Rogers Test*

The Ninth Circuit was the first appellate court outside the Second Circuit to adopt *Rogers*. It did so in a trademark dispute involving a song—*Barbie Girl*—that poked fun at the famous Barbie toy in its title and lyrics: *Mattel, Inc. v. MCA Records, Inc.*⁸³ The Ninth Circuit set forth the two prongs of the *Rogers* test after quoting the language in *Rogers* about only applying the Lanham Act to artistic works where the public’s interest in avoiding consumer confusion outweighs its interest in free expression, and said: “We agree with the Second Circuit’s analysis and adopt the *Rogers* standard as our own.”⁸⁴ It then concluded this use of the Barbie mark was not infringing—and affirmed the grant of summary judgment to defendants—because the title was artistically relevant to the song and defendants did not suggest the song was produced by Mattel.⁸⁵

The Ninth Circuit has had many occasions to adapt and extend this speech-protective doctrine. Ninth Circuit cases have expanded application of the test to uses of another’s mark within the content or

82. *Id.* at 998.

83. 296 F.3d 894, 899–900 (9th Cir. 2002).

84. *Id.* at 902.

85. *Id.*

body of the artistic work,⁸⁶ in titles of artistic works that communicate the inherent meaning of the words⁸⁷ and which are displayed on promotional goods like shirts and champagne glasses,⁸⁸ in the descriptive title of a news publication,⁸⁹ and within a parody of a brand displayed on a dog toy.⁹⁰ In addition, the Ninth Circuit has clarified that the Second Circuit's statement about "the appropriately low threshold of *minimal* artistic relevance"⁹¹ in *Rogers'* first prong of the test means an artistic relevance of something "above zero."⁹² It has also explained that the second prong of the test is "a high bar that requires the use to be 'an explicit indication, overt claim, or explicit misstatement' about the source of the work."⁹³ Per the Ninth Circuit, "the mere use of a trademark alone" is not sufficient to establish the use is explicitly misleading;

86. See, e.g., *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 270–71 (9th Cir. 2018) (applying the *Rogers* test to use of another's mark in the content of greeting cards); *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1097 (9th Cir. 2008) (same for video game); *id.* at 1099 ("Although this test traditionally applies to uses of a trademark in the title of an artistic work, there is no principled reason why it ought not also apply to the use of a trademark in the body of the work.").

87. See, e.g., *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1198–99 (9th Cir. 2017) (finding no infringement under the *Rogers* test in a lawsuit over use of the word "Empire" as a title for a television show where "the show's setting is New York, the Empire State, and its subject matter is a music and entertainment conglomerate, 'Empire Enterprises,' which is itself a figurative empire"; *Rogers* applied even though defendant was not using the term to refer to the plaintiff).

88. *Id.* at 1196–97 ("Although it is true that these promotional efforts technically fall outside the title or body of an expressive work, it requires only a minor logical extension of the reasoning of *Rogers* to hold that works protected under its test may be advertised and marketed by name, and we so hold."). *But cf.* *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1011, 1018 (3d Cir. 2008) (declining to apply the *Rogers* test to an advertisement for a video game).

89. *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091, 1094–96, 1098 (9th Cir. 2022) (applying *Rogers* where "Punchbowl News" was selected by the accused infringer as the name of a subscription-based online news publication "because [punchbowl] is the nickname the Secret Service uses to refer to the U.S. Capitol" and this phrase elicited the subject matter and geographic location of the news reporting).

90. *VIP Prods. LLC v. Jack Daniel's Props., Inc.*, 953 F.3d 1170, 1172 (9th Cir. 2020), *vacated & remanded*, *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023).

91. *Rogers*, 875 F.2d at 999 (emphasis added).

92. *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) (discussing the first prong of the test in *Rogers*, 875 F.2d at 999).

93. *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 462 (9th Cir. 2020) (quoting *Brown*, 724 F.3d at 1245).

“[o]therwise, the First Amendment would provide no defense at all, rendering *Rogers* a nullity.”⁹⁴

In the Ninth Circuit today, the higher threshold for infringement liability in *Rogers* applies once the defendant makes the “threshold legal showing that its allegedly infringing use is part of an expressive work protected by the First Amendment,”⁹⁵ which can be determined by analyzing “whether the work is ‘communicating ideas or expressing points of view.’”⁹⁶ The fact that products are sold commercially or for profit does not render that product a non-expressive work.⁹⁷ Once this gateway requirement for application of the *Rogers* test is satisfied, “then the plaintiff claiming trademark infringement bears a heightened burden—the plaintiff must satisfy not only the [traditional multi-factor] likelihood-of-confusion test but also at least one of *Rogers*’ two prongs.”⁹⁸ Thus, the Lanham Act may not be applied in trademark infringement disputes involving expressive works unless the plaintiff establishes “that the defendant’s use of the mark is either (1) ‘not artistically relevant to the underlying work’ or (2) ‘explicitly misleads consumers as to the source or content of the work.’”⁹⁹ Courts in the Ninth Circuit routinely dismiss trademark infringement claims under the *Rogers* test on a motion to dismiss or summary judgment motion when marks are used within expressive works without authorization in an artistically relevant manner that does not explicitly mislead regarding the source or content of the work.¹⁰⁰ Unlike the Second

94. *Punchbowl*, 52 F.4th at 1100 (internal quotations omitted) (quoting *E.S.S. Ent.*, 547 F.3d at 1099; *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 902 (9th Cir. 2002)). *But see* *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 270-71 (9th Cir. 2018) (holding that use of a mark alone could be explicitly misleading where the phrase is used by the junior user without modification or additional expressive content, and used in the same way as the senior user).

95. *Gordon*, 909 F.3d at 264.

96. *VIP Prods. LLC v. Jack Daniel’s Prods., Inc.*, 953 F.3d 1170, 1174 (9th Cir. 2020) (quoting *Mattel*, 296 F.3d at 900), *vacated on other grounds & remanded*, *Jack Daniel’s Prods., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023). After the Supreme Court’s *Jack Daniel’s* decision, the accused infringer must also be using the mark otherwise than as a trademark for its own products.

97. *Id.* at 1175 (citing *Mattel*, 296 F.3d at 906-07).

98. *Gordon*, 909 F.3d at 264.

99. *VIP Prods.*, 953 F.3d at 1170 (quoting *Gordon*, 909 F.3d at 265).

100. *See, e.g.*, *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091, 1097, 1103 (9th Cir. 2022) (summary judgment motion); *K & K Promotions, Inc. v. Walt Disney Studios Motion Pictures*, No. 21-16740, 2022 WL 3585589 (9th Cir. Aug. 22, 2022) (motion to dismiss); *Diece-Lisa Indus., Inc. v. Disney Store USA, LLC*, No. 21-55816, 2022 WL 2072727, at *1-2 (9th Cir. June 9, 2022) (summary judgment motion); *Betty’s Found.*

Circuit, this appellate court has not required analysis of the multiple factors in the circuit’s likelihood of confusion test—the “*Sleekcraft*” factors¹⁰¹—once the threshold requirement for application of *Rogers* is satisfied.¹⁰²

Due to the Ninth Circuit’s significant expansion of the threshold requirement for application of the *Rogers* test and that circuit’s decision to not apply the multi-factor likelihood of confusion test to evaluate whether the use is explicitly misleading under *Rogers*, as of this writing there is no single “*Rogers* test” that applies throughout the United States in all trademark disputes involving expressive works. Regardless, some version of the test first set forth by the Second Circuit in *Rogers* is usually applied in such cases today, as discussed next.

C. *The Dominance of the Rogers Test*

Over time, the *Rogers* test has become one of the dominant speech-protective doctrines that is invoked by accused infringers and applied by courts when alleged trademark infringement is defended as expression protected by the First Amendment.¹⁰³ The *Rogers* test has

for Elimination of Alzheimers Disease v. Trinity Christian Ctr. of Santa Ana, Inc., No. 21-55553, 2022 WL 807391, at *1 (9th Cir. Mar. 16, 2022) (motion to dismiss); Dr. Seuss Enters., L.P. v. ComicMix LLC, 983 F.3d 443, 461-62 (9th Cir. 2020) (summary judgment motion); Twentieth Century Fox Television v. Empire Distrib., 875 F.3d 1192, 1197-98 (9th Cir. 2017) (summary judgment motion); Brown v. Elec. Arts, Inc., 724 F.3d 1235, 1243 (9th Cir. 2013) (motion to dismiss); VIRAG, S.R.L. v. Sony Comput. Entm’t Am. LLC, 699 F. App’x 667 (9th Cir. 2017) (motion to dismiss); E.S.S. Ent. 2000, Inc. v. Rock Star Videos, 547 F.3d 1095, 1099 (9th Cir. 2009) (summary judgment motion); Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792, 807 (9th Cir. 2003) (summary judgment motion); *Mattel*, 296 F.3d at 807, 902 (summary judgment motion); Saber Interactive Inc. v. Oovee, LTD., No. 2:21-CV-01201-JHC, 2022 WL 5247190, at *6 (W.D. Wash. Oct. 6, 2022) (motion to dismiss); Activision Publ’g, Inc. v. Warzone.com, LLC, No. 221CV03073FLAJCX, 2022 WL 4117035, at *4 (C.D. Cal. Aug. 15, 2022) (motion to dismiss counterclaims and for judgment on the pleadings); Belin v. Starz Ent., LLC, No. CV 21-09586-FWS-PLA, 2022 WL 2192999, at *10 (C.D. Cal. June 17, 2022) (motion to dismiss).

101. AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979).

102. See, e.g., *Punchbowl*, 52 F.4th at 1103 (affirming grant of summary judgment to defendants under the *Rogers* test without applying the multiple likelihood of confusion factors).

103. 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, 834 (2019) (“[The *Rogers* test] had clearly become the standard in disputes involving trademarks and creative works.”); J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:144.50 (5th ed. 2022) (“[The *Rogers* test] has become immensely influential and followed by almost all courts.”).

been adopted by almost all of the appellate courts that have considered it. In addition to the Second and Ninth Circuits, appellate courts in the Fifth,¹⁰⁴ Sixth,¹⁰⁵ and Eleventh Circuits,¹⁰⁶ and federal district courts in the Third¹⁰⁷ and Seventh Circuits,¹⁰⁸ apply this test when trademarks are used in the titles or content of expressive works. When Congress amended the Lanham Act in 2020 to clarify the standards relating to the grant of preliminary and permanent injunctions (among other things), Congressional members of the House Judiciary Committee stated in the legislative history of the Trademark Modernization Act that they approved of *Rogers'* higher threshold for infringement used in trademark disputes involving “movies, television programs, songs, books, plays, video games, and the like” and encouraged courts to continue to apply this standard “to cabin the reach of the Lanham Act in cases involving expressive works.”¹⁰⁹

One significant advantage of the Ninth Circuit’s version of the *Rogers* test is that it is an objective analysis that focuses on whether the artistically relevant expression that incorporates another’s mark is explicitly misleading, and does not require the parties to spend time and money litigating about the defendant’s subjective intent or other likelihood of confusion factors.¹¹⁰ The multi-factor test for evaluating

104. *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65 (5th Cir. 2000).

105. *ETW Corp. v. Jireh Publ’g*, 332 F.3d 915, 928 (6th Cir. 2003); *Parks v. LaFace Recs.*, 329 F.3d 437, 451–52 (6th Cir. 2003).

106. *MGFB Props., Inc. v. Viacom Inc.*, 54 F.4th 670, 679–80 (11th Cir. 2022); *Univ. of Ala. Bd. Of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012).

107. *Hidden City Phila. v. ABC, Inc.*, No. 18-65, 2019 WL 1003637, at *3-5 (E.D. Pa. Mar. 1, 2019).

108. *Fortres Grand Corp. v. Warner Bros. Ent.*, 947 F. Supp. 2d 922, 931-34 (N.D. Ind. 2013), *aff’d on other grounds*, 763 F.3d 696 (7th Cir. 2014).

109. H.R. Rep. No. 116-645, at 19–20 (2020) (With regard to the topic of “Balancing First Amendment concerns,” “the Committee acknowledges the need to take special care to ensure that the interests protected by the Lanham Act do not encroach on the rights to free speech and expression enshrined in the First Amendment. Courts have long been appropriately circumspect in applying the Lanham Act so as not to interfere with the First Amendment rights of creators and distributors of ‘artistic works’ (sometimes called ‘expressive works’), including without limitation movies, television programs, songs, books, plays, video games, and the like, which may depict or reference third-party marks within such artistic works or in such artistic works’ titles 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.”).

110. *See, e.g.*, Brief of the Motion Picture Association, Inc. as *Amicus Curiae* in Support of Neither Party at 1–7, 25–26, *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, No. 22-148,

infringement claims often requires case-by-case analysis, so courts are usually not comfortable disposing of trademark disputes as a matter of law under that test. Artists, authors, documentary filmmakers, news organizations, nonprofit groups, small businesses, and others who cannot afford to litigate through discovery and trial to a successful result or hire experts to conduct or rebut consumer surveys in a trademark dispute may settle and self-censor their nonmisleading expression.

The objective nature of the *Rogers* test increases clarity and predictability in trademark law, and reduces the chilling effect of the broad infringement standard by providing courts with a tool to dispose of weak claims early in litigation on a motion to dismiss, for judgment on the pleadings, or for summary judgment. It provides breathing space for parody and criticism about trademark owners, and for satire and other commentary about the world around us, as long as that expression does not explicitly mislead about the product's source or content. Another benefit of *Rogers* is that the test can be applied to the use of words for their inherent meaning, such as "UFO" for a documentary about unidentified flying objects.¹¹¹ The accused infringer need not be using the mark to refer to the trademark owner or its products (unlike with parody and nominative fair use) but, after the *Jack Daniel's* decision, there is now a requirement that the phrase be used otherwise than as a mark for its products (like the descriptive fair use defense).¹¹²

When *Rogers* is invoked to protect noncommercial expression from government regulation under the Lanham Act, the test also makes it less likely that trademark infringement laws will conflict with the First Amendment by limiting their application to contexts where the mark falsely identifies the speaker or the source of the expressive work.¹¹³ Yet because the test only limits the scope of trademark rights in trademark disputes involving "expressive works," and there is disagreement about what types of uses of another's mark satisfy that gateway requirement for this higher standard of infringement, *Rogers* is not applicable in all of the conflicts between trademark and free speech rights. Moreover, for

2023 WL 3872519 (U.S. June 8, 2023) (discussing the benefits of the *Rogers* test, but arguing that it should only apply in trademark disputes involving artistic works).

111. Order Granting Defendant's Motion to Dismiss, *UFO Mag., Inc. v. Showtime Network, Inc.*, No. 22-cv-00078, 2022 WL 16644914 (D. Wyo. Nov. 3, 2022).

112. See *infra* Sections II.C–E (discussing parody and nominative and descriptive fair use)

113. See Rebecca Tushnet, *Bad Spaniels, Counterfeit Methodists, and Lying Birds: How Trademark Law Reinvented Strict Scrutiny*, <https://ssrn.com/abstract=4387772> [<https://perma.cc/3S5W-ATVJ>]; see also Brief of *Amici Curiae* First Amendment Professors in Support of Respondent, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148).

reasons explained below, a few trademark owners believe the *Rogers* test should not be used in any trademark dispute.

D. Critiques of the Rogers Test

In the *Jack Daniel's* case, Jack Daniel's and some of its supporters argued that the higher standard for infringement in *Rogers*—and especially the Ninth Circuit's version of the *Rogers* test—is a “free pass” to infringe trademarks and does not prevent misleading uses of trademarks.¹¹⁴ Under their view, the multi-factor likelihood of confusion test should always be used to determine infringement under the Lanham Act because this analysis can adequately balance trademark and free speech interests in trademark disputes involving parody or other expressive uses of trademarks.¹¹⁵ Most accused infringers do prevail in trademark disputes as a matter of law once the court determines that the *Rogers* test applies.¹¹⁶ Yet the fact these cases are resolved early in the lawsuit does not mean the decisions are incorrect, as the jury or judge might have arrived at the same result—a verdict for the defendant—after costly discovery and a lengthy jury or bench trial. Moreover, some courts have found that a genuine issue of material fact exists with regard to the first or second prong of the *Rogers* test and left

114. See, e.g., Brief for Petitioner at 2–5, 19–39, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148); Brief of the Chamber of Commerce of the United States of America and the National Association of Manufacturers as Amici Curiae in Support of Petitioner at 3–4, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148); Brief of Scholars, Former Judges, and Former Government Officials as Amici Curiae Supporting Petitioner in Favor of Reversal at 15, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148); see also Brief of Amici Curiae American Apparel & Footwear Association, Footwear Distributors & Retailers of America, Council of Fashion Designers of America, Inc., and the Accessories Council in Support of Petitioner at 3, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148) (adopting the Ninth Circuit's version of the *Rogers* test will increase counterfeits and knockoffs); Brief of Amici Curiae of Levi Strauss & Co. and Patagonia, Inc. in Support of Petitioner at 11, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148) (critical of the fact that the Ninth Circuit's version of the *Rogers* test results in no discovery about defendant's intent or actual confusion).

115. Brief for Petitioner at 22–28, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148). Some amici argue that the multi-factor likelihood of confusion analysis should always be used in trademark disputes involving ordinary commercial products without taking a position on whether the *Rogers* test should apply when marks are used in movie or book titles. See, e.g., Brief of Amicus Curiae American Craft Spirits Association in Support of Petitioner at 18–19, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148); Brief of Amicus Curiae Nike, Inc. in Support of Petitioner at 3–4, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148).

116. See, e.g., *supra* note 100 (listing cases in Ninth Circuit that applied *Rogers* on a motion to dismiss or summary judgment motion).

the determination of infringement for trial.¹¹⁷ If there is an overt false claim or explicit misstatement about the source or content of the work, the decision-maker can find infringement under the *Rogers* test. By allowing the government to ban such uses of marks that are likely to cause confusion, the test in *Rogers* furthers the Lanham Act's goals of preventing fraudulent, deceptive, or misleading uses of marks.¹¹⁸

Critics of the *Rogers* test also argue that the first prong is set too low.¹¹⁹ Indeed, the requirement that the artistic relevance only be above zero is the lowest possible baseline. However, it is not clear that the solution is to require more proof of artistic relevance, as this would require judges and juries to make decisions about what qualifies as “art” or what is “artistically relevant.”¹²⁰ It may also lead to an inquiry into the subjective intent of the artist or author, and increase the cost of litigation due to the expense of obtaining document discovery and deposition testimony about this topic. When First Amendment interests are implicated in a trademark dispute, the focus should arguably be on whether the accused infringer's message is objectively false or misleading to a reasonable person, and not whether the artist or author had a true artistic intent in using the mark or was simply free riding off the trademark owner's goodwill and reputation.

Some trademark owners also complain that *Rogers'* focus on “explicitly” misleading uses of marks, and on confusion about the

117. See, e.g., *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 271 (9th Cir. 2018) (finding a triable issue of material fact on the explicitly misleads prong of the test); *Parks v. LaFace Recs.*, 329 F.3d 437, 453 (6th Cir. 2003) (“We believe that reasonable persons could conclude that there is no relationship of any kind between Rosa Parks' name and the content of the song—a song that is nothing more and nothing less than a paean announcing the triumph of superior people in the entertainment business over inferior people in that business.”); Opinion and Order Denying Parties' Cross Motions for Summary Judgment, *Hermès v. Rothschild*, No. 22-cv-384, 2023 WL 1458126, at *7-9 (S.D.N.Y. Feb. 2, 2023) (“Here, there is a genuine factual dispute as to whether Rothschild's decision to center his work around the Birkin bag stemmed from genuine artistic expression or, rather, from an unlawful intent to cash in on a highly exclusive and uniquely valuable brand name.”; stating there are also genuine issues of material fact on whether the use explicitly misleads as to the work's source or content).

118. 15 U.S.C. § 1127 (discussing the intent of the Lanham Act).

119. See, e.g., Brief of Intellectual Property Owners Association as Amicus Curiae in Support of Petitioner at 6, *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023).

120. As noted by the Ninth Circuit, “courts and juries should not have to engage in extensive ‘artistic analysis.’” *Gordon*, 909 F.3d at 269 (quoting *Brown*, 724 F.3d at 1243, 1245; citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903) (“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”)).

product's "source or content," is inconsistent with the text of the Lanham Act's infringement provisions.¹²¹ Those provisions cover use of another's mark that is "likely to cause confusion, or to cause mistake, or to deceive" and permit a finding of liability outside the context of confusion about the product's source or origin, such as when the accused infringer's expression is likely to cause confusion about affiliation, connection, association, sponsorship, or approval.¹²² Uses of the mark that are only implicitly misleading, or which are only likely to cause confusion about sponsorship, approval, or other connections between the parties, are not infringing under *Rogers*. While it is true that the *Rogers* test contains a higher standard of proof for infringement claims that is not set forth in the statute, this is a speech-protective interpretation of the "likely to cause confusion" language in the Lanham Act which recognizes that the First Amendment imposes limitations on the scope of trademark rights.¹²³ The multi-factor likelihood of confusion test is also not set forth in the text of the Act; like the *Rogers* test, this is a judge-made doctrine that interprets the infringement statute.¹²⁴ Importantly, Congress has not disapproved of the *Rogers* test, and the House Judiciary Committee report discussed earlier shows that some members of Congress approve of the test to protect free speech in trademark law.

Free speech advocates also have concerns about the *Rogers* test.¹²⁵ The test currently provides less certainty and predictability to litigants

121. See, e.g., Brief for Petitioner at 24, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148); Brief of American Intellectual Property Law Association as *Amicus Curiae* Supporting Reversal at 11, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148); Brief of the Chamber of Commerce of the United States of America and the National Association of Manufacturers as *Amici Curiae* in Support of Petitioner at 12, 16-20, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148).

122. 15 U.S.C. §§ 1114(1), 1125(a)(1)(A).

123. See, e.g., Brief of Respondent at 28-33, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148); Brief of the Motion Picture Association, Inc. as *Amicus Curiae* in Support of Neither Party at 11-12, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148). Justices Gorsuch, Thomas, and Barrett may not agree with this argument; under their view, "it is not entirely clear where the *Rogers* test comes from—is it commanded by the First Amendment, or is it merely gloss on the Lanham Act, perhaps inspired by constitutional-avoidance doctrine?" *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519, at *11-12 (U.S. June 8, 2023) (Gorsuch, J., concurring).

124. See, e.g., *Amicus Curiae* Brief of the International Trademark Association in Support of Neither Party at 7-8, n.4, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148).

125. One problem with the *Rogers* test is that it also requires courts to consider whether this use of the mark explicitly misleads regarding the content of the work. It is not clear why the Lanham Act's trademark infringement provisions should be used to police false statements about the content of expressive works. A full discussion of this issue, however, is beyond the scope of this paper.

in trademark disputes and may chill expression protected by the First Amendment because of the lack of agreement by courts on the threshold requirement for application of the *Rogers* test and on what evidence or factors should be considered when evaluating the two prongs of the *Rogers* test. Since the Supreme Court's decision in *Jack Daniel's* only held that the *Rogers* test cannot apply when the mark is being used as a designation of source, the Court did not provide any guidance on these issues.

The *Jack Daniel's* case prompted some commentators to argue that the gateway requirement for the *Rogers* test should be whether the message that incorporates the mark is inextricably intertwined with the product itself, such as a painting on a canvas or words in a book.¹²⁶ Under this view, *Rogers'* higher threshold for infringement liability does not apply in trademark disputes when the goods retain their primary function once the expression that incorporates the mark (*e.g.*, a parody) is removed from the product (*e.g.*, a dog toy or T-shirt). Yet if the product desired by consumers is a dog toy or T-shirt that displays this specific parody message (*e.g.*, a parody of the marks "Jack Daniel's" for whisky or "Louis Vuitton" for handbags), removing the expression from the product changes it into a less desirable product. It is not the same product.¹²⁷ The Supreme Court's First Amendment jurisprudence suggests that the focus should be on whether the noncommercial and commercial elements of the regulated speech (*e.g.*, use of the mark within the parody) are inextricably intertwined like in the title *Ginger and Fred* for the Fellini film,¹²⁸ and not whether the speech (*e.g.*, the title or parody) is inextricably intertwined with the product itself (*e.g.*, the film, dog toy, or T-shirt).

After the *Jack Daniel's* decision, the Ninth Circuit's rule that the *Rogers* test applies where the mark is used in "part of an expressive work protected by the First Amendment" that communicates ideas or expresses points of view remains good law in that Circuit and other

126. See, *e.g.*, Amicus Curiae Brief of the International Trademark Association in Support of Neither Party at 7, 23–25, *Jack Daniel's Prods., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023) (proposing this test); Brief of the Motion Picture Association, Inc. as *Amicus Curiae* in Support of Neither Party at 24–25, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148) (approving of this test).

127. Brief of *Amici Curiae* First Amendment Professors in Support of Respondent at 6–8, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148).

128. *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66–67 (1983).

jurisdictions that follow this approach.¹²⁹ However, a remaining issue is whether this language will be interpreted to cover all expressive uses of another's mark where the noncommercial and commercial components of the speech are inextricably intertwined. An example would be the unauthorized use of the mark of an educational institution or political action committee within a joke, pun, parody, or political message displayed on the front of a T-shirt.¹³⁰

Another problem with the *Rogers* test is that courts currently apply this common law doctrine differently depending on the jurisdiction where they are located. As noted previously, the Ninth Circuit's approach is to delay evaluation of the *Sleekcraft* factors unless the trademark owner can establish one or both of *Rogers*'s two prongs, while in the Second Circuit the *Polaroid* factors may be employed to determine whether the use is explicitly misleading with the caveat that the factors "must be particularly compelling to outweigh the First Amendment interest recognized in *Rogers*."¹³¹ Moreover, courts are increasingly starting to revise the *Rogers* test in ways that make application of this speech-protective doctrine more complicated and less clear about whether certain expressive uses of another's mark are allowed or prohibited.

For example, in *Gordon v. Drape Creative*, the Ninth Circuit introduced two new factors to consider when evaluating whether use of another's mark is explicitly misleading under the second prong of the *Rogers* test: (1) "the degree to which the junior user uses the mark in the same way as the senior user" and (2) "the extent to which the junior user has added his or her own expressive content to the work beyond the mark itself."¹³²

129. *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018); *see also* *VIP Prods. v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170, 1174 (9th Cir. 2020), *vacated on other grounds & remanded*, *Jack Daniel's Prods., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023); *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

130. *See* Brief of *Amicus Curiae* Foundation for Individual Rights and Expression in Support of Respondent at 11-19, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148) (discussing unauthorized use of the marks of educational institutions by students and faculty); Brief of *Amici Curiae* Dan McCall, Sky Shatz, & Don Stewart in Support of Respondent, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148) (perspective of individuals who have created or sold T-shirts, coffee mugs, and similar products featuring parodies of or artistic variations of trademarks for various products).

131. *See, e.g.*, *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993); *Hermès Int'l v. Rothschild*, No. 22-cv-384, 2023 WL 1458126, at *8-9 (S.D.N.Y. Feb. 2, 2023). The multi-factor likelihood of confusion tests for these two circuits are set forth in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979) and *Polaroid Corp. v. Polarad Elecs., Corp.*, 287 F.2d 492, 495 (2d Cir. 1961).

132. *Gordon*, 909 F.3d at 270-71.

Unfortunately these factors may not help clarify whether that expression explicitly misleads as to the product's *source* when both parties are using the phrase in a non-source-identifying manner to convey a joke within the content of an expressive work.

In *Gordon*, the parties sold greeting cards that featured images of a honey badger and a punchline—phrases identical or similar to “Honey Badger Don’t Care” or “Honey Badger Don’t Give a Shit”—claimed as a trademark by Gordon for various products after he used those phrases in a video about honey badgers that went viral on the internet.¹³³ The Ninth Circuit held defendants were not entitled to summary judgment under the *Rogers* test because there was “at least a triable issue of fact as to whether defendants simply used Gordon’s mark with minimal artistic expression of their own, and used it in the same way that Gordon was using it—to identify the source of humorous greeting cards in which the bottom line is ‘Honey Badger don’t care.’”¹³⁴ Yet both parties were using the phrase on the front or inside of greeting cards in a manner that would likely not be perceived as a source-identifying use of the mark, and the back cover of defendants’ greeting cards—the normal trademark spot for such products—only “displayed the mark for ‘Recycled Paper Greetings’ and listed the websites www.DCISudios.com and www.prgreetings.com.”¹³⁵ Arguably there was no reasonable basis for a jury to determine that this expression was explicitly misleading regarding the product's *source* since the defendants were not using the language claimed as a mark in a context that provides information about the source of the greeting cards.

Another example of the variable manner in which the *Rogers* test is applied is from the *Hermès International v. Rothschild*¹³⁶ case in the Southern District of New York. In its opinion denying summary judgment, the court said the *Rogers* test applied,¹³⁷ but then it instructed the jury to focus on whether Mason Rothschild’s use of Hermès’ Birkin mark in connection with nonfungible tokens (NFTs) linked to “MetaBirkins” digital images of fur-covered Birkin bags was “actually

133. *Id.* at 260-61. An example of a similar phrase displayed on the inside of one of defendants’ greeting cards is “Honey Badger Don’t Give a S---.” *Id.* at 162.

134. *Id.* at 271.

135. *Id.* at 263. Gordon’s company entered into licensing agreements with Zazzle, Inc. and The Duck Company for various honey-badger themed products, including greeting cards, and the court’s example of Zazzle’s use of the “Honey Badger Don’t Care” mark is on the front cover of the greeting card: “Honey Badger Don’t Care About Your Birthday”. *Id.* at 262. The court’s examples of defendants’ uses of the mark are only on the front or inside of the greeting cards. *Id.* at 263.

136. No. 22-cv-384, 2023 WL 1458126 (S.D.N.Y Feb. 2, 2023).

137. *Id.* at *7-9.

intended to confuse potential customers”—a subjective analysis—in the court’s “First Amendment Protection” jury instruction.¹³⁸ A district court in the Tenth Circuit used a similar subjective approach when it decided in *Stouffer v. National Geographic Partners* that “the *Rogers* test needs adapting.”¹³⁹ In the context of a trademark dispute involving National Geographic’s use of titles that contained words similar to Stouffer’s “Wild America” mark, that court introduced a six-factor test in lieu of *Rogers*’ two-pronged test which asks, among other things, whether the junior user had a “genuine artistic motive” for using the language claimed as a mark by the senior user.¹⁴⁰

The *Gordon*, *Hermès*, and *Stouffer* cases illustrate that the standard for infringement in the *Rogers* test—and that test’s ability to protect speech interests—varies depending not only on the facts of the case, but also the jurisdiction where the court is located. Moreover, despite the *Rogers* test’s purported focus on whether the accused infringer’s use of another’s mark is causing confusion about the *source* or content of the work, some courts—including the Second Circuit in *Rogers*—interpret the “explicitly misleads as to the source” language to broadly include false or misleading statements about sponsorship, endorsement,

138. See The Court’s Instructions of Law to the Jury at 21-22, *Hermès Int’l v. Rothschild*, No. 22-cv-384 (S.D.N.Y. Feb. 7, 2023). As the *Rogers* test applied, the jury instruction stated that Hermès had to do more than prove Rothschild’s use of the mark was likely to confuse potential consumers: “It is undisputed . . . that the MetaBirkins NFTs, including the associated images, are in at least some respects works of artistic expression, such as, for example, in their addition of a total fur covering to the Birkin bag images. Given that, Mr. Rothschild is protected from liability on any of Hermès claims unless Hermès proves by a preponderance of the evidence that Mr. Rothschild’s use of the Birkin mark was not just likely to confuse potential consumers but was intentionally designed to mislead potential consumers into believing that Hermès was associated with Mr. Rothschild’s MetaBirkins project. In other words, if Hermès proves that Mr. Rothschild actually intended to confuse potential customers, he has waived any First Amendment protection . . .” *Id.* at 21. Arguably that jury instruction should have asked the jurors to determine whether Rothschild’s use of Hermès’ Birkin mark “explicitly misleads” the public regarding the source or content of the artistic expression.

139. *Stouffer v. Nat’l Geographic Partners, LLC*, 400 F. Supp. 3d 1161, 1179 (D. Colo. 2020).

140. *Id.* The factors in the test are not exclusive, and many of them focus on the motive of the junior user. Per the court, “[t]he point of these factors is to assist in answering the question, ‘Did the junior user have a genuine artistic motive for using the senior user’s mark or other Lanham Act-protected property right?’” *Stouffer v. Nat’l Geographic Partners, LLC*, 460 F. Supp. 3d 1133, 1139–46 (D. Colo. 2020) (discussing and applying the six factor test set forth by the court earlier in *Stouffer*, 400 F. Supp. 3d at 1179).

authorization, association, or affiliation.¹⁴¹ Courts applying the *Rogers* test after the *Jack Daniel's* decision should interpret the term “source” as the Court did, to refer to the entity or person that produced the product or who is responsible for it.¹⁴² But because of the Court’s narrow holding in *Jack Daniel's*, application of the test will likely not be consistent throughout the United States. To fully understand the advantages and disadvantages of adopting the *Rogers* test or a broader trademark fair use doctrine, one must consider the other defensive doctrines that may be invoked in trademark infringement disputes today.

II. NAVIGATING TRADEMARK LAW’S SPEECH-PROTECTIVE RULES

In addition to the *Rogers* test, trademark law contains other judge-made and statutory rules that limit the scope of trademark rights to protect First Amendment interests in trademark infringement

141. *Rogers*, 875 F.2d at 997–1001 (using the words “sponsorship,” “endorses,” “endorsement,” and “authorized” when talking about whether the use explicitly misleads regarding the source of the work where Rogers claimed the *Ginger and Fred* title created the false impression that the film was about her or that she sponsored, endorsed, or was otherwise involved in the film; “We consider separately the claims of confusion as to sponsorship and content.”); *see also, e.g.*, *Brown v. Elec. Arts, Inc.*, 724 F.3d, 1235, 1246 (9th Cir. 2013) (holding that “Brown needs to prove that EA explicitly misled consumers about Brown’s endorsement of the game, not that EA used Brown’s likeness in the game”); *Hermès Int’l*, 2023 WL 1458126, at *8 (“A work is ‘explicitly misleading’ if it ‘induces members of the public to believe’ that it was created or otherwise authorized by the plaintiff.”); *Id.* at *9 (noting “the parties disagree vehemently over whether consumers were confused about Hermès’ association with the MetaBirkins project”); *Champion v. Moda Operandi, Inc.*, 561 F. Supp. 3d 419, 436 (S.D.N.Y. 2021) (“Nowhere does the Vogue Runway Editorial Feature—in the body of the editorial or by positioning the words ‘Buy on Moda Operandi’ below a photo of a model—ever explicitly misrepresent that Plaintiffs endorsed Moda as the seller of the clothes they modeled or are in any way affiliated with Moda.”).

142. *See Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519, at *3 (U.S. June 8, 2023) (“[A] trademark is not a trademark unless it identifies a product’s source (this is a Nike) and distinguishes that source from others (not any other sneaker brand). . . . In other words, a mark tells the public who is responsible for a product.”); *see also* Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 422–27 (2010) (arguing that the focus in trademark infringement law should be on whether the use is likely to confuse consumers about who is responsible for the source or quality of the defendant’s goods or services). Someone who misleads the public regarding the source of the goods, services, or message is engaging in impersonation and passing off their products or messages as those of the trademark owner or person with that name. Words like sponsorship, endorsement, authorized, association, affiliation, and approved focus on the connection or business relationship between the parties or whether the trademark owner or person consented to this use of their mark or name in this context.

disputes.¹⁴³ The problem is that these speech-protective doctrines only apply in narrow circumstances or in certain jurisdictions. A piecemeal approach to protecting speech is not ideal. Some nonmisleading speech that should be protected may be enjoined because none of these defensive doctrines apply. Navigating all of these rules may be difficult for judges and litigants, especially those that lack expertise in trademark law.

As explained in more detail below, the main speech-protective rules that may be invoked today in infringement disputes include the following uses of language or designs claimed as a trademark by another: (A) noncommercial use, (B) non-trademark use, (C) descriptive fair use, (D) nominative fair use, (E) parody, and (F) aesthetically functional or ornamental use. Although these doctrines offer important checks on overreaching trademark claims, they each have constraints or other problems that prevent them from providing comprehensive protection of First Amendment values in trademark law. In Section II.G, we also explain why applying constitutional scrutiny on an as-applied basis when a First Amendment challenge is raised in trademark litigation is not an ideal solution.

A. *Noncommercial Use*

Some courts protect free speech values in trademark disputes by holding that commercial use of another's mark is required for

143. For the sake of brevity, our focus here is on the defensive doctrines that may be raised to rebut claims of trademark infringement. While the trademark dilution statute provides that certain unauthorized uses of another's famous mark are exempted from application of the dilution law, including comparative advertising, parody, criticism, commentary, news reporting, news commentary, and noncommercial use of a mark, 15 U.S.C. § 1125(c)(3), the infringement statutes do not contain such defenses.

Importantly, trademark law also protects speech interests in trademark disputes by limiting what may constitute a valid and protectable mark. Lisa P. Ramsey, *Protectable Trademark Subject Matter in Common Law Countries and the Problem with Flexibility*, in *THE CAMBRIDGE HANDBOOK OF INTERNATIONAL AND COMPARATIVE TRADEMARK LAW* 193, 195–207 (Irene Calboli & Jane Ginsburg eds., 2020). Examples include the requirements that a trademark be distinctive, not functional, and used in commerce as a trademark, 15 U.S.C. §§ 1051, 1052, 1115(b), 1127, and the ban on registration and protection of trademark rights in generic terms for goods or services, 15 U.S.C. §§ 1052, 1064(3), 1065(4), and of merely informational or ornamental matter that fails to function as a source-identifying mark. Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977, 1989–2016 (2019); see, e.g., *In re Lee Greenwood*, Serial No. 87168719, 2020 WL 7074687 (T.T.A.B. 2020) (refusing to register “God Bless the USA” as a mark for various décor products).

trademark infringement liability.¹⁴⁴ This common law rule exempts noncommercial uses of marks—noncommercial speech—from application of the Lanham Act’s infringement provisions. This rule is based on the Supreme Court’s First Amendment jurisprudence and interpretation of the use “in connection with goods or services” language in the infringement provisions of the Act.¹⁴⁵

Commercial speech is currently defined by the Supreme Court as speech that does no more than propose a commercial transaction.¹⁴⁶ Noncommercial speech is fully protected by the First Amendment from unjustified government regulations unless a categorical exception to constitutional protection of the expression applies, such as for fraudulent speech.¹⁴⁷ Laws banning or otherwise restricting noncommercial speech based on its content must satisfy strict constitutional scrutiny analysis, which is often fatal.¹⁴⁸ Commercial speech is also protected by the First Amendment if it is not misleading, but government regulations of nonmisleading commercial speech are currently only subject to intermediate scrutiny analysis under the *Central Hudson* test unless they discriminate based on viewpoint.¹⁴⁹

144. *See, e.g.*, *Farah v. Esquire Mag.*, 736 F.3d 528, 541 (D.C. Cir. 2013); *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Rsch.*, 527 F.3d 1045, 1052–54 (10th Cir. 2008); *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 676–77 (9th Cir. 2005); *Taubman Co. v. Webfeats*, 319 F.3d 770, 774 (6th Cir. 2003); *Porous Media Corp. v. Pall Corp.*, 173 F.3d 1109, 1120 (8th Cir. 1999).

145. 15 U.S.C. §§ 1114(1), 1125(a)(1)(A). While some earlier courts thought the use “in commerce” language in the infringement statutes requires commercial use of the mark for liability, this phrase is arguably in the Lanham Act for jurisdictional purposes to refer to Congress’s power to regulate commerce, and not to limit the statute to commercial speech or profit-making activity. *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 92–93 (2d Cir. 1997); Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 381, 403 (2008).

146. *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66–67 (1983). In *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 321–24, 326–27 (4th Cir. 2015), the Fourth Circuit looked to the Supreme Court’s commercial speech doctrine for guidance on how to interpret the Lanham Act in a way that protects speech interests in trademark law and interpreted the Act’s “in connection with” goods or services element as requiring a real nexus between the accused infringer’s specific use of the mark and its goods or services, such as to denote the recipient of a political donation.

147. *United States v. Stevens*, 559 U.S. 460, 468–69 (2010).

148. *Reed v. Town of Gilbert*, 576 U.S. 155, 170–71 (2015); *see Ramsey, supra* note 17, at 414, 455; *Ramsey, supra* note 145, at 388.

149. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 564 (1980); *see Ramsey, supra* note at 17, at 453–55. Justice Thomas believes that government regulations of truthful commercial speech should be subject to strict scrutiny analysis just like noncommercial speech. *See Matal v. Tam*, 582 U.S. 218, 254 (2017) (Thomas, J., concurring). Viewpoint discriminatory regulations of commercial

When commercial and noncommercial expression is inextricably intertwined, per *Bolger* that message will usually be deemed fully protected noncommercial speech unless the message (1) is an advertisement (2) that makes “reference to a specific product” and (3) the defendant “has an economic motivation.”¹⁵⁰

A commercial use requirement for trademark infringement has several advantages. This bright-line categorical rule may reduce the chilling effect of the broad “likely to cause confusion” language in the Lanham Act. It clearly provides First Amendment protection in trademark law for the unauthorized use of another’s mark within political or religious speech. This rule also prevents trademark law from applying to speech that does not solely propose a commercial transaction. Examples include criticism of and commentary about a trademark owner or its products in consumer product reviews, cybergripe websites, or fan websites; parody and satire in virtual worlds and real-world environments like college campuses; and use of the mark in domain names or usernames linked to noncommercial communications. Noncommercial use of a mark also includes use within the title or content of artistic and literary works, and other uses of marks that may combine artistic expression and commercial promotion but which are fully protected noncommercial speech under *Bolger*. As the issue of whether expression is commercial speech can be decided as a matter of law, this threshold requirement for infringement liability makes it easier for courts to dispose of frivolous trademark claims early in a lawsuit.

Of course, one challenge with relying on a noncommercial use of the mark exception to protect free speech interests in trademark infringement disputes is that it is sometimes difficult to draw the line between commercial and noncommercial speech.¹⁵¹ Another potential disadvantage of requiring commercial use of the mark for liability is that

speech are subject to heightened scrutiny per Justice Kennedy. *Id.* at 247–51 (Kennedy, J., concurring).

150. *Bolger*, 463 U.S. at 66–67; see also MCCARTHY, *supra* note 103, § 24:128 (discussing *Bolger* in the context of trademark law).

151. *Tam*, 582 U.S. at 244–45 (Alito, J.) (plurality opinion); Ramsey, *supra* note 17, at 434–39. Yet courts currently do this when they decide whether this is a noncommercial use of the mark in the context of that 15 U.S.C. § 1125(c)(3)(C) exemption to claims for dilution.

it could permit fraudulent, deceptive, or misleading uses of another's mark as a source-identifying trademark in noncommercial speech.¹⁵²

The fact that certain noncommercial uses of another's name as a source-distinguishing mark can mislead the public in a materially harmful way is likely the reason the Second Circuit held in *United We Stand America* that the Lanham Act applies to use of a competing political organization's name that causes confusion regarding the source of fundraising activities and political services.¹⁵³ Consumers can also be harmed by unauthorized uses of marks that mislead as to the source of a book or movie, which may explain why the Second Circuit created the higher standard for liability in *Rogers* to "protect the public against flagrant deception" instead of deeming the Act inapplicable to all titles that can be considered artistic expression.¹⁵⁴ The ability to find infringement under *Rogers* when the use explicitly misleads as to the source of the expressive work furthers trademark law's goals while still providing breathing space for nonmisleading uses of marks in noncommercial speech.¹⁵⁵ Likewise, use of another's mark to impersonate a trademark owner online or in the real world in a manner that falsely identifies the trademark owner as the source of the noncommercial expression may materially harm consumers.¹⁵⁶

152. 15 U.S.C. § 1127 ("The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce" and "to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks . . .").

153. *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 89–90, 92–93 (2d Cir. 1997) (applying the infringement statute to defendant's confusing use of the mark "United We Stand America" to associate itself with the political movement that sponsored Ross Perot's presidential campaign and to solicit, collect, and otherwise raise money in support of his presidential candidacy, and holding that infringement laws are not limited to profit-seeking uses of trademarks).

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

155. *Id.*; *see, e.g., Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 905–07 (9th Cir. 2002).

156. *See, e.g., Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d 1430, 1440 (S.D.N.Y. 1997), *aff'd*, 152 F.3d 920 (2d Cir. 1998) (finding infringement where anti-abortion activist registered the domain name www.plannedparenthood.com and used the "Planned Parenthood" mark on a website located at that domain name which stated on its homepage: "Welcome to the PLANNED PARENTHOOD HOME PAGE!", but which also contained criticism of the trademark owner and information about another person's anti-abortion book for sale elsewhere). *See generally* Lisa P. Ramsey, *Brandjacking on Social Networks: Trademark Infringement by Impersonation of Markholders*, 58 *BUFF. L. REV.* 851 (2010) (discussing misleading uses of marks on social media sites such as Facebook and Twitter). Contrast the *Planned Parenthood* case with *Bosley Medical*, which involved use of another's mark in a domain name and website to criticize the trademark owner without suggesting it was the trademark owner's website.

As the public has a compelling interest in not being misled in a material way by false statements about the identity of a noncommercial speaker or the source of artistic works or political or religious services,¹⁵⁷ it may be best to only exempt noncommercial uses of another's mark from infringement liability if the mark is used otherwise than as a designation of source (*i.e.*, a non-trademark use) or if the use is not likely to mislead a reasonable person as to the source of the noncommercial products or message.

B. Non-Trademark Use

Where another's mark is not being used as a brand name or in other ways to identify the source of the accused infringer's goods or services, some courts may find there is no infringement as a matter of law. These jurisdictions require a trademark use or source-identifying use of the mark for infringement liability.¹⁵⁸ Other courts, however, have held that the Lanham Act does not explicitly or implicitly contain a threshold trademark use requirement or broad non-trademark use defense.¹⁵⁹

Examples of trademark uses of marks are the display of the word "Nike" on the inside label of athletic shoes or T-shirts, on a sign in front

Bosley Med. Inst., Inc. v. Kremer, 403 F.3d 672, 676–77 (9th Cir. 2005) (finding no infringement where customer dissatisfied with a company's hair restoration services registered the domain name www.bosleymedical.com and linked to a "highly critical" website that "to put it mildly, was uncomplimentary of the Bosley Medical Institute").

157. Application of trademark infringement law to certain false or deceptive source-identifying uses of marks in noncommercial speech could satisfy strict scrutiny analysis under the First Amendment. See Ramsey, *supra* note 17, at 408, 438-39; Ramsey, *supra* note 145, at 443-46; Tushnet, *supra* note 113. In *Jack Daniel's*, the Supreme Court suggested it approved of the Second Circuit's use of the standard likelihood of confusion test when a political group used its competitor's "United We Stand America" mark "as a source identifier." *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519, at *7 (U.S. June 8, 2023) (citing *United We Stand*, 128 F.3d at 93).

158. See, e.g., *Hensley Mfg., Inc. v. ProPride, Inc.*, 579 F.3d 603, 610 (6th Cir. 2009) (trademark use of the mark is a required threshold requirement for an infringement claim); see also *Sazerac Brands, LLC v. Peristyle, LLC*, 892 F.3d 853, 859 (6th Cir. 2018) (discussing the Sixth Circuit's "threshold 'trademark use' test" and noting that in this Circuit "plaintiffs carry a threshold burden to show that the defendant is using a mark 'in a []trademark way' that 'identifies the source of their goods,'" noting criticism of the test, and then stating that the "trademark use test resembles in nearly every particular the [descriptive] fair use defense" in the Lanham Act).

159. See 15 U.S.C. §§ 1114(1), 1125(a)(1)(A); see, e.g., *Kelley-Brown v. Winfrey*, 717 F.3d 295, 305–08 (2d Cir. 2013); *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 168–70 (4th Cir. 2012); see also McCARTHY, *supra* note 103, § 23:11.50 (stating that the Sixth Circuit's approach has no support in the Lanham Act). As the descriptive fair use defense in the Lanham Act requires use otherwise than as a mark, 15 U.S.C. § 1115(b)(4), this suggests there is no trademark use requirement in the infringement statutes.

of a retail store, in the heading of a webpage, and in other trademark spaces or spots in advertisements or on products or packaging.¹⁶⁰ Non-trademark uses of that word include informational use of the mark by a competitor in comparative advertising (“our shoes have the same quality as Nike shoes”), expressive use by a consumer in a social media post (“I love my Nike shoes”), and decorative use of the mark by an artist within a painting or photograph of a person wearing a T-shirt that displays the word Nike on the front. Other uses of Nike otherwise than as a mark include use by a news reporter or blogger within the title or content of an article or blog post about the company, use by a filmmaker within the title or content of a film that pokes fun at Nike or sneakerheads, and use in the title or content of a book about Nike the Greek goddess of victory.

Like the commercial use requirement, a trademark use requirement for infringement has some advantages.¹⁶¹ A categorical rule exempting non-trademark uses of marks from infringement liability would increase clarity and predictability in trademark disputes. It would reduce the chilling effect of the broad trademark infringement statutes and make it easier for courts to dispose of weak trademark claims early in a lawsuit without having to consider the various factors in the traditional likelihood of confusion test. By providing broad First Amendment protection for non-trademark uses of marks, this rule prevents trademark owners from enlisting courts to stop unauthorized uses of their marks that convey information or express ideas or viewpoints as long as those marks are not used within brand names or slogans, or in other trademark spaces.

Critics of this speech-protective rule note that an exemption from infringement liability for non-trademark uses of marks is both over-inclusive and under-inclusive in ways that could harm trademark and free speech interests.¹⁶² As with noncommercial uses of another’s mark, some non-trademark uses of marks may be fraudulent, deceptive, or materially misleading. More narrow categorical defenses may do a

160. Mark A. Lemley & Mark P. McKenna, *Trademark Spaces and Trademark Law's Secret Step Zero*, 75 STAN. L. REV. 1, 6-8, 27-54 (2023) (providing examples of trademark spaces on products and packaging, and noting that the side of an athletic shoe and the shoe’s tongue are also trademark spaces which display logos of companies such as Nike, Inc.); Roberts, *supra* note 143, at 2005–06 (discussing the trademark spot).

161. See, e.g., Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669, 1675–89 (2007).

162. See, e.g., Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597, 1622–67 (2007); Graeme B. Dinwoodie & Mark D. Janis, *Lessons from the Trademark Use Debate*, 92 IOWA L. REV. 1703, 1704, 1714–21 (2007).

better job balancing trademark and free speech rights, such as an affirmative defense for non-trademark use of the mark in noncommercial speech.¹⁶³

On the other hand, we may want to exempt some trademark uses of another's mark that communicate truthful product information (such as a description of the characteristics of the product),¹⁶⁴ or nonmisleading humorous expression (such as the "Chewy Vuiton" dog toy parody of the Louis Vuitton marks),¹⁶⁵ as this speech is protected by the First Amendment if it is not fraudulent or misleading commercial speech. In *Matal v. Tam*, the Supreme Court held that nonmisleading use of language as a trademark (such as "The Slants" for the entertainment services of a rock band) is protected by the First Amendment, and that expression cannot be regulated by the government without a sufficient constitutional justification.¹⁶⁶ A trademark use requirement for infringement liability would protect speech interests in trademark disputes but, like a commercial use requirement, this rule may not be the best way to balance trademark and free speech interests.

C. Descriptive Fair Use

Descriptive fair use is a statutory affirmative defense to infringement that applies when the accused infringer uses the plaintiff's trademark (1) otherwise than as a mark, (2) in good faith, (3) to describe the qualities or characteristics of its products.¹⁶⁷ Thus, if one company owns trademark rights in "Dentist's Choice" for toothbrushes, another business can state that its brand of toothpaste "is the dentists' choice for

163. See Ramsey, *supra* note 145, at 456 (providing examples of more narrow trademark rules).

164. See, e.g., *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091, 1095 (9th Cir. 2022) (explaining that punchbowl "is the nickname the Secret Service uses to refer to the U.S. Capitol" and this phrase elicited the subject matter and geographic location of the news reporting by the employees of the "Punchbowl News" online news publication). In *Jack Daniel's*, the Supreme Court said "[w]hen 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." *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519, at *9 (U.S. June 8, 2023). The truthful use of a term for its dictionary meaning or another type of informational meaning should arguably constitute one of those rare situations where the First Amendment might "demand a threshold inquiry like the *Rogers* test" even though the mark was used by the accused infringer as a means of source identification. *Id.*

165. See, e.g., *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 266-67 (4th Cir. 2007) (noting that Haute Diggity Dog was using "Chewy Vuiton" as a mark for dog toys).

166. *Matal v. Tam*, 582 U.S. 218 (2017).

167. 15 U.S.C. § 1115(b)(4).

fighting cavities” or use a similar phrase in advertisements.¹⁶⁸ This defense helps promote fair competition and protects free expression in trademark law by allowing the use of descriptive terms in commercial or noncommercial expression even when a phrase is registered as a trademark.¹⁶⁹ Descriptive fair use can be established as a matter of law if the facts necessary to satisfy the three prongs of the defense are evident on the face of the complaint.¹⁷⁰

Yet, the descriptive fair use defense has some limitations.¹⁷¹ This fair use doctrine is narrowly focused on the use of words or symbols to describe products. Thus, use of another’s mark to convey a message (such as parody or satire) on the front of a T-shirt or within a creative work is unlikely to qualify for this defense unless the phrase describes the products. Moreover, this statutory defense does not apply if the accused infringer is displaying the mark in locations on products or packaging, or in advertising, websites, or other places, which might be construed as a trademark use of the mark. Therefore, use of a phrase prominently on the outside surface of a tank top,¹⁷² within a slogan or domain name,¹⁷³ or in another trademark space, might not qualify for the descriptive fair use defense as a matter of law (or at all) on the ground that this is use of the language as a source-identifying mark.

168. *Wonder Labs, Inc. v. Procter & Gamble Co.*, 728 F. Supp. 1058 (S.D.N.Y. 1990) (holding that defendant’s use of the phrase “the dentists’ choice” in connection with advertising for Crest toothpaste was a descriptive fair use of the mark).

169. *U.S. Pat. & Trademark Off. v. Booking.com B.V.*, 140 S. Ct. 2298, 2307–08 (2020).

170. *Kelley-Brown v. Winfrey*, 717 F.3d 295, 308 (2d Cir. 2013); *Naked Cowboy v. CBS*, 844 F. Supp. 2d 510, 515 (S.D.N.Y. 2012) (use of phrase in video clip describing person; network used its own logo to identify source of its product). Since courts may consider whether the use is likely to cause some confusion as part of the descriptive fair use analysis, and the multi-factor likelihood of confusion test often requires a case-by-case analysis, it may be difficult to win this defense on a motion to dismiss.

171. Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095, 1159–69 (2003) (discussing the narrow focus of the descriptive fair use defense and its use otherwise than as a mark requirement). See also Jeanne C. Fromer, *Against Secondary Meaning*, 98 NOTRE DAME L. REV. 211 (2022) (same).

172. See, e.g., *Fortune Dynamic, Inc. v. Victoria’s Secret Store Brand Mgmt., Inc.*, 618 F.3d 1025, 1039–43 (9th Cir. 2010) (holding that a genuine issue of material fact existed with regard to whether Victoria’s Secret’s display of the plaintiff’s mark “Delicious” on the front of a tank-top described the goods and was a use otherwise than as a mark since the accused infringer displays its own marks in that spot on clothing).

173. *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 953–54 (7th Cir. 1992) (use of the plaintiff’s mark “Thirst Aid” in slogan “Gatorade is Thirst Aid” in an advertising campaign); *TCPIP Holding Co. v. Haar Commc’ns, Inc.*, 244 F.3d 88, 103–04 (2d Cir. 2001) (use of the “the name ‘thechildrensplace.com’ as the address, or name, of its website” and reference to the website “in publicity materials as ‘a children’s place’” was a use as a mark).

While this defense allows commercial and noncommercial uses of another's mark to communicate information about products, its narrow scope makes this speech-protective doctrine irrelevant in many trademark disputes that implicate important First Amendment interests.

D. Nominative Fair Use

Some courts use the nominative fair use doctrine to limit the scope of trademark rights in infringement disputes involving the use of another's mark to identify the trademark owner or its goods or services.¹⁷⁴ This judge-made doctrine permits referential use of another's mark as long as this expression does not falsely suggest the trademark owner sponsors or endorses the accused infringer's products.¹⁷⁵ The test varies slightly depending on the jurisdiction, and it can substitute for the traditional likelihood of confusion multi-factor analysis,¹⁷⁶ be added as additional factors to the usual infringement test,¹⁷⁷ or serve as an affirmative defense to infringement.¹⁷⁸ In the Ninth Circuit, once the defendant proves that it is using the mark to refer to the plaintiff or its products, the burden shifts to the plaintiff to prove this defensive doctrine does not apply to this commercial or noncommercial use of the mark.¹⁷⁹ The expression is deemed a non-infringing nominative fair use if (1) the product is not readily identifiable without use of the plaintiff's mark; (2) the defendant did not use more of the mark than necessary; and (3) it did not falsely suggest that its products are sponsored or endorsed by the trademark owner.¹⁸⁰

174. Use of another's mark not as a designation of source for the defendant's products in comparative advertising, to identify the trademark owner in parody, criticism, and commentary, and other nominative fair uses of a famous mark are statutory defenses to trademark dilution. 15 U.S.C. § 1125(c)(3)(A). So too is use of the mark in news reporting and news commentary. 15 U.S.C. § 1125(c)(3)(B).

175. *New Kids on the Block v. New Am. Publ'g*, 971 F.2d 302, 309 (9th Cir. 1992).

176. *Id.* at 309.

177. *See, e.g., Int'l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC*, 823 F.3d 153, 167-68 (2d Cir. 2016) (holding that nominative fair use is not an affirmative defense to an infringement claim and courts must "consider the Ninth Circuit and Third Circuit's nominative fair use factors, in addition to the *Polaroid* factors").

178. *See, e.g., Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 228-31 (3d Cir. 2005).

179. *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1183 (9th Cir. 2010).

180. *Id.* at 1175-77 (stating that prohibiting "truthful and nonmisleading speech does not advance the Lanham Act's purpose of protecting consumers and preventing unfair competition; in fact, it undermines that rationale by frustrating honest communications between the [defendants] and their customers").

The nominative fair use doctrine protects free expression and fair competition in trademark disputes when the mark is used to identify the plaintiff or its products in a way that is not likely to cause confusion. Examples include consumer product reviews, news reporting, critical or laudatory posts about the trademark owner on blogs or social media, advertising about goods or services related to certain brands of products (such as repair or broker services for automobiles), and other criticism or commentary about the company, organization, or person that owns the mark. Moreover, certain types of nominative fair uses are allowed by courts via more specific common law defenses. One example is comparative advertising, or the truthful use of another’s mark in advertising or promotion that permits consumers to compare the price or quality of the parties’ goods or services.¹⁸¹ If the nominative fair use is clear from the facts set forth in the complaint, one significant benefit of this doctrine is that the court may resolve the trademark claims as a matter of law.

One disadvantage of the nominative fair use doctrine is that it only applies in limited circumstances—when the defendant is referring to the trademark owner or its products. Thus, this rule cannot be invoked if the mark is being used in satire, jokes, mashups, or memes that comment only on the world around us. While the nominative fair use doctrine may apply to brand parodies and other expression about the trademark owner,¹⁸² the Ninth Circuit has held that accused infringers can only avail themselves of this fair use doctrine if their use of the mark is identical.¹⁸³ Moreover, if the defendant makes repetitive or extensive use of plaintiff’s mark, a court may find the expression does not qualify for this defense since one requirement of nominative fair use is that the defendant cannot use more of the mark than necessary.¹⁸⁴ Accordingly,

181. See, e.g., *Smith v. Chanel, Inc.* 402 F.2d 562, 565, 566 (9th Cir. 1968).

182. MCCARTHY, *supra* note 103, §§ 23:11, 31:153 (noting that parody may also be nominative fair use, such as the artistic photos of the Barbie doll in *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003)).

183. See, e.g., *VIP Prods. LLC v. Jack Daniel’s Props., Inc.*, 953 F.3d 1170, 1174 (9th Cir. 2020), *vacated on other grounds & remanded*, *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023) (holding that the “significant differences” between the Bad Spaniels design and the Jack Daniel’s marks “preclude a finding of nominative fair use”) (citing *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 801 (9th Cir. 2002); *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008)).

184. See MCCARTHY, *supra* note 103, § 23:11 (noting that “the junior use may step over the line into a likelihood of confusion by using the senior user’s mark too prominently or too often, in terms of size, emphasis, or repetition”). Dicta in the Ninth Circuit suggests

if all three prongs of the test are not satisfied, or accused infringers fail to convince the decision-maker that their use of another's mark is comparative advertising or some other type of nominative fair use, they cannot obtain the benefit of this limitation on the scope of trademark rights even when they are engaging in an informational or expressive use of another's mark.¹⁸⁵

E. Parody

If the mark is being used in a *successful* parody to ridicule or mock the trademark owner, some courts interpret the factors of the likelihood of confusion test in a speech-protective way and conclude there is no infringement because consumers are unlikely to be confused by the parody.¹⁸⁶ This was the approach used by courts in trademark lawsuits filed by Louis Vuitton Malletier when one company used the phrase "Chewy Vuitton" and a parody of the Louis Vuitton handbag design in connection with the sale of dog toys, and another company displayed a two-dimensional image similar to that design on canvas bags that said

that use of the plaintiff's distinctive lettering or logo may be unnecessary to identify the owner of a trademark. *See, e.g., Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1181 (9th Cir. 2010) (while Toyota argued that use of the stylized Lexus mark and logo on the Tabaris' website was more use of the mark than necessary, the court explained that "the Tabaris submitted images of an entirely changed site at the time of trial: The stylized mark and 'L' logo were gone, and a disclaimer appeared in their place"). Professor McCarthy says there is no such rule and contends that most people would agree that logos can be used to refer to the trademark owner in magazine articles, parody, and expressive criticism. MCCARTHY, *supra* note 103, § 23:11.

185. Elizabeth L. Rosenblatt, *Rethinking the Parameters of Trademark Use in Entertainment*, 61 FLA. L. REV. 1011, 1065 (2009) (arguing that the nominative fair use doctrine fails to adequately protect speech interests because it is "vulnerable to the feedback loop of consumer confusion in the same way as the traditional likelihood of confusion test").

186. This is not an affirmative defense; the fact the mark is used in a parody influences how the likelihood of confusion factors are applied. *Louis Vuitton Malletier, S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 267 (4th Cir. 2007). The Supreme Court approved of this approach in *Jack Daniel's*. *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519, at *10 (U.S. June 8, 2023) ("[A] trademark's expressive message—particularly a parodic one, as VIP asserts—may properly figure in assessing the likelihood of confusion. . . . A parody must 'conjure up' 'enough of [an] original to make the object of its critical wit recognizable.' . . . Yet to succeed, the parody must also create contrasts, so that its message of ridicule or pointed humor comes clear. And once that is done (*if* that is done), a parody is not often likely to create confusion. Self-deprecation is one thing; self-mockery far less ordinary.") (alterations and emphasis in original). The Court, however, did not comment on whether the likelihood of confusion factors should or should not be adjusted in a trademark case involving a parody.

“My Other Bag.”¹⁸⁷ In the context of claims of trademark infringement, parody doctrine can apply to noncommercial or commercial uses of another’s mark, and to uses of that expression as a trademark or otherwise than as a mark. It protects freedom of expression by allowing everyone to poke fun at brands. It may also be useful if the humorous expression displayed on an ordinary commercial product (such as a beer label) is deemed to not qualify for application of the *Rogers* test.

Although defendants often win on motions for summary judgment in trademark disputes once they convince the court that their use of the mark is a successful parody, it can be expensive to litigate to that result.¹⁸⁸ It may be difficult to prevail on a motion to dismiss based on a parody argument because consideration of the fact-intensive likelihood of confusion factors is often required.¹⁸⁹ Another disadvantage of this common law doctrine is that it may require judges to decide questions of artistic merit.¹⁹⁰ Moreover, like nominative fair use, parody doctrine does not apply to commentary that is not about the owner of the mark or its products.¹⁹¹ One advantage of the *Rogers* test is that it can apply to

187. *Haute Diggity Dog*, 507 F.3d at 269–70; *Louis Vuitton Malletier, S.A. v. My Other Bag*, 156 F. Supp. 3d 425, 440, 445 (S.D.N.Y. 2016), *aff’d*, 674 F. App’x 16 (2d Cir. 2016).

188. William McGeeveran, *The Imaginary Trademark Parody Crisis (and the Real One)*, 90 WASH. L. REV. 713 (2015).

189. After the *Jack Daniel’s* decision, however, it may be easier to obtain a motion to dismiss in a trademark dispute. When discussing the likelihood-of-confusion inquiry that should be used in lieu of the *Rogers* test when a mark is used as a designation of source, the Court made the following statement in a footnote: “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). See 6 McCarthy § 32:121.75 (providing examples).” *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519, at *8 n.2 (U.S. June 8, 2023).

190. MCCARTHY, *supra* note 103, § 31:154 (discussing challenges in categorizing something as a parody or not a parody, and in deciding if the use is likely to cause confusion).

191. See, e.g., *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1400–01 (9th Cir. 1997) (use of *Cat in the Hat* marks in book about the OJ Simpson trial with the title *The Cat NOT in the Hat!*); *Louis Vuitton Malletier S.A., v. Hyundai Motor America*, No. 10 Civ. 1611, 2012 WL 1022247, at *1, *13, *21 (S.D.N.Y. Mar. 22, 2012) (use of Louis Vuitton logos on basketball for a few seconds while commenting on luxury in advertisement for automobiles); see also Bruce P. Keller & Rebecca Tushnet, *Even More Parodic Than the Real Thing: Parody Lawsuits Revisited*, 94 TRADEMARK REP. 979, 980, 1016 (2004).

parody *and* to satire, jokes, mashups, memes, and other expressive uses of marks if the threshold requirement in *Rogers* is satisfied.¹⁹²

F. *Aesthetically Functional or Ornamental Use*

If an accused infringer displays words or symbols in a decorative manner on merchandise, courts may find this use of another's mark is not infringing under aesthetic functionality doctrine or determine this is an ornamental use of the mark that fails to function as a source-identifying mark.¹⁹³ Consumers often desire T-shirts and similar goods that prominently display humorous messages, political slogans, and other expression because of the inherent meaning of the language, or the aesthetic appeal of the design, rather than the mark's ability to identify the trademark owner or the source of the products. In *Lettuce Turnip the Beet, LLC v. Redbubble, Inc.*, the Ninth Circuit held that use of the pun "Lettuce Turnip the Beet" on the outside surface of apparel, tote bags, and other products—and not on labels or hangtags—was not actionable infringement because this was an aesthetically functional use of the registered marks for this phrase.¹⁹⁴ This court's approach is akin to the creation of a common law defense for aesthetically functional or ornamental use of another's mark.¹⁹⁵ This defense protects free

192. MCCARTHY, *supra* note 103, § 31:153–154; *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 898, 902 (9th Cir. 2002) (applying *Rogers* to parody use of the "Barbie" mark in the title of the song *Barbie Girl*).

193. See *Lettuce Turnip the Beet, LLC v. Redbubble, Inc.*, No 19-16464, 2021 WL 195024, 840 F. App'x 148 (9th Cir. 2021); Lisa P. Ramsey, *Using Failure to Function Doctrine to Protect Free Speech and Competition in Trademark Law*, 104 IOWA L. REV. ONLINE 70, 94-95 (2020).

194. *Lettuce Turnip the Beet, LLC*, 2021 WL 195024, 840 F. App'x. 148, 151 (holding the marks are functional "when used on the allegedly infringing products that are the subject of LTTB's complaint"; as plaintiff presented no evidence of source confusion or evidence that consumers wanted the products because "Lettuce Turnip the Beet" identified the trademark owner, granting exclusive trademark rights in this context would put competitors at a significant non-reputation-related disadvantage since consumers most likely desired the products because of the aesthetic function of the pun). The Ninth Circuit held it was unnecessary to consider the likelihood of confusion factors after it ruled for the defendant on the ground of aesthetic functionality. *Id.* It declined to find plaintiff's incontestable registrations for its marks *per se* invalid, *id.* at 151 n.2, so this was an as-applied functionality defense to infringement. Note the district court had held this use of the mark was either an aesthetically functional use or a merely ornamental use of the mark that failed to function as a mark. *Lettuce Turnip the Beet, LLC v. Redbubble, Inc.*, 385 F. Supp. 3d 916, 920 (N.D. Cal. 2019).

195. Ramsey, *supra* note 193, at 94–95; see also *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 917–20 (9th Cir. 1980) (considering an as-applied functionality defense to a trademark infringement claim); *Pa. State Univ. v. Vintage*

expression and fair competition in the sale of T-shirts and similar merchandise that displays ideas, viewpoints, and other messages desired by consumers for non-reputation-related reasons.

However, the Ninth Circuit's aesthetic functionality defense has limited applicability because it focuses only on decorative uses of trademarks in contexts that do not identify the trademark owner or the product's source. Courts may be hesitant to apply this defense when consumers want the merchandise displaying another's brand name or logo because of the mark's source-identifying nature.¹⁹⁶

G. Applying First Amendment Jurisprudence to Trademark Infringement Law

The various speech-protective trademark rules discussed above protect First Amendment interests in trademark law, but the current defenses to trademark infringement are narrow and rigid and are not always applied consistently by courts.¹⁹⁷ Congress or courts should provide more guidance on how to limit the scope of trademark rights in situations that implicate the right to freedom of expression.

Fraudulent statements and misleading commercial speech are considered to be outside the scope of expression protected by the First Amendment,¹⁹⁸ so in most trademark disputes the "likely to cause confusion" requirement for infringement in the Lanham Act usually prevents conflicts with this fundamental right.¹⁹⁹ However, courts have

Brand, No. 4:21 CV-01091, 2022 WL 2760233, at *2–3 & n.17, *9 (M.D. Pa. July 14, 2022) (discussing whether the display of university logos on expressive merchandise identifies the source of the goods or merely serves as ornamentation). For a critique of the merchandising right in trademark law, see Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 463–65 (2005); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1696–97, 1706–09 (1999).

196. See, e.g., *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1074 (9th Cir. 2006) (noting that consumers wanted the goods because of the reputation of Volkswagen and Audi and that "the alleged aesthetic function [of the marks was] indistinguishable from and tied to the mark's source-identifying nature").

197. Michael Grynberg, *Things Are Worse than We Think: Trademark Defenses in a "Formalist" Age*, 24 BERKELEY TECH. L.J. 897, 903–24, 945–62 (2009).

198. *United States v. Stevens*, 559 U.S. 460, 468–69 (2010); *In re R.M.J.*, 455 U.S. 191, 203 (1982); *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 565–66 (1980).

199. 15 U.S.C. §§ 1114(1), 1125(a)(1)(A); *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519, at *9 (U.S. June 8, 2023) ("[T]o the extent a trademark is confusing' as to a product's source 'the law can protect consumers and trademark owners.'") (quoting *Matal v. Tam*, 582 U.S. 218, 252 (2017) (Kennedy, J., concurring in part and concurring in judgment)).

recognized that some informational, expressive, and decorative uses of another's mark should not be banned by the Lanham Act even if they pose some danger of consumer confusion.²⁰⁰ While the statutory descriptive fair use defense allows non-trademark uses of another's mark to provide product information, Congress has not categorically exempted other types of uses of trademarks from infringement liability in situations where unauthorized use of the mark is not likely to be fraudulent, deceptive, or misleading. Perhaps it should, as this would reduce the chilling effect of the Lanham Act's broadly-worded standard in the infringement provisions.²⁰¹

The Court's current intermediate and strict scrutiny tests arguably provide a framework for evaluating how trademark laws regulating enforcement of trademark rights can be made more consistent with the U.S. Constitution.²⁰² The Court's First Amendment jurisprudence

200. See *supra* Part I & Sections II.A–F. Over the years Congress has expanded the scope of trademark infringement law in several ways, such as by allowing infringement liability to be based on a likelihood of confusion about sponsorship, approval, affiliation, connection, or association, 15 U.S.C. § 1125(a)(1)(A), and not just confusion about a product's source or origin. Unfortunately, it has declined to also expand the statutory affirmative defenses that are available when the accused infringer is using another's mark to communicate information or convey ideas or viewpoints. Graeme B. Dinwoodie, *Developing Defenses in Trademark Law*, 13 LEWIS & CLARK L. REV. 99, 101, 108–12 (2009).

201. See, e.g., Robert G. Bone, *Notice Failure and Defenses in Trademark Law*, 96 BOSTON UNIV. L. REV. 1245 (2016); Dinwoodie, *supra* note 200; William McGeeveran, *The Trademark Fair Use Reform Act*, 90 B.U.L. REV. 2267 (2010); William McGeeveran, *Life in the Fast Lane: Of Presumptions, Defenses, and Burdens*, 1 IP THEORY 25 (2010); William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49 (2008); Ramsey, *supra* note 17, at 467; Ramsey, *supra* note 145, at 454–57.

202. See Ramsey, *supra* note 17, at 407, 419–22, 432–56. Under strict scrutiny analysis, a content-based regulation of noncommercial expression can only survive constitutional scrutiny if the government can “prove that the restriction furthers a compelling interest and is narrowly tailored to achieve that interest.” *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2231 (2015) (quoting *Ariz. Free Enter. Club's Freedom Club PAC v. Bennett*, 564 U.S. 721, 734 (2011)). “If a less restrictive alternative would serve the Government's purpose, the legislature must use that alternative.” *United States v. Playboy Ent. Grp., Inc.*, 529 U.S. 803, 813 (2000) (quoting *Reno v. Am. Civ. Liberties Union*, 521 U.S. 844, 874 (1997)). Assuming the speech is not misleading and concerns a lawful activity, the intermediate scrutiny test in *Central Hudson* requires the government to prove the law directly and materially advances a substantial government interest and is narrowly drawn so as to not endanger free speech more than necessary to achieve that goal. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 564–65 (1980); see also *Matal v. Tam*, 582 U.S. 218, 245–47 (2017) (Alito, J.) (plurality opinion) (applying the *Central Hudson* test); *Edenfield v. Fane*, 507 U.S. 761, 767–71 (1993) (same). The intermediate scrutiny test does not require the regulation to be the least restrictive means to achieve the government's goal. *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 476–81 (1989).

suggests that it is important to (1) identify the goals of the specific trademark law that are substantial or compelling government interests, (2) confirm this trademark provision directly and materially furthers those trademark goals, and (3) ensure that law is narrowly drawn so as to not endanger constitutionally-protected speech more than necessary to serve that government interest. Nonetheless, it is not desirable or feasible for courts to engage in an as-applied constitutional analysis of trademark infringement laws in every trademark dispute.²⁰³ Adding more speech-protective categorical affirmative defenses or other defensive doctrines to the statute or common law of trademarks—or the broad trademark fair use doctrine we propose in the next Part—is likely the best way to ensure that infringement law is narrowly tailored to further important trademark purposes and does not stifle protected expression too much in pursuit of these goals.²⁰⁴

In section 45 of the Lanham Act, Congress stated that the goals of trademark law include making actionable deceptive or misleading uses of trademarks, preventing uses of marks that cause fraud and deception, and protecting against unfair competition.²⁰⁵ Per the Supreme Court, trademark law’s purposes also include promoting competition,²⁰⁶ helping consumers identify the source of products,²⁰⁷ and protecting the

203. Ramsey, *supra* note 145, at 450–53 (discussing the advantages and disadvantages of protecting expression by considering whether trademark laws or injunctions satisfy First Amendment scrutiny).

204. Compare *id.* at 454–57 (categorical speech-protective trademark rules) with *id.* at 447–50 (contextual speech-protective interpretations of trademark law).

205. 15 U.S.C. § 1127; see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767–68 (1992) (“The Lanham Act was intended to make ‘actionable the deceptive and misleading use of marks’ and ‘to protect persons engaged in . . . commerce against unfair competition.’”) (alteration in original) (quoting 15 U.S.C. § 1127); *Matal v. Tam*, 582 U.S. 218, 252 (2017) (Kennedy, J., concurring) (noting if “a trademark is confusing or misleading the law can protect consumers and trademark owners”) (citing *FTC v. Winsted Hosiery Co.*, 258 U.S. 483, 493 (1922)).

206. See, e.g., *Tam*, 582 U.S. at 225 (majority opinion) (“[N]ational protection of trademarks is desirable,’ we have explained, ‘because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.’”) (quoting *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 531 (1987)).

207. See *id.* at 223–24 (“The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan’s goods from those of others.’ . . . A trademark ‘designate[s] the goods as the product of a particular trader’ and ‘protect[s] his good will against the sale of another’s product as his.’ . . . It helps consumers identify goods and services that they wish to purchase, as well as those they want to avoid.”) (internal citations omitted); *id.* at 253 (Kennedy, J., concurring) (“The central purpose of trademark registration is to

business goodwill and reputation symbolized by a trademark “against the sale of another’s product as [the trademark owner’s product].”²⁰⁸ Some or all of these purposes of trademark law may be invoked to justify trademark infringement laws that regulate the unauthorized use of another’s mark in a confusing manner in connection with the advertising, sale, offering for sale, or provision of goods or services.

It is understandable that trademark owners like Jack Daniel’s do not want dog toy companies, T-shirt manufacturers, and other businesses to free ride off their investment of time and money in their brand.²⁰⁹ Yet the public has a compelling government interest in free expression—and in fair and undistorted competition—which prevents trademark owners from enlisting courts to enjoin nonmisleading speech simply to protect the goodwill invested in these marks.²¹⁰

III. A PROPOSAL FOR A BROAD FAIR USE DOCTRINE IN TRADEMARK INFRINGEMENT LAW

If use of another’s trademark provides truthful information about products or expresses ideas, viewpoints, or other messages, any government regulation of that expression must be consistent with the First Amendment. Our proposal is to add a broad fair use doctrine to

facilitate source identification.”); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212–13 (2000) (“Although the words and packaging can serve subsidiary functions . . . their predominant function remains source identification.”); *see also* *Jack Daniel’s Prods., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519, at *3-4 (U.S. June 8, 2023) (noting that every trademark’s primary function is to identify the source of the product and distinguish it from others and “the single type of confusion most commonly in trademark law’s sights is confusion ‘about the source of a product or service’”).

208. *Tam*, 582 U.S. at 224 (quoting *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918)).

209. *See, e.g.*, Brief for Petitioner at 3-4, 37, *Jack Daniel’s Prods., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023); Brief of Campari America LLC as Amicus Curiae in Support of Petitioner at 1-2, 8-9, *Jack Daniel’s*, 2023 WL 3872519 (No. 22-148); *see also* Brief of Scholars, Former Judges, and Former Government Officials as Amici Curiae Supporting Petitioner in Favor of Reversal at 1-2, *Jack Daniel’s*, 2023 WL 3872519 (No. 22-148) (discussing concerns with ensuring that trademark law properly promotes and secures for owners of trademarks the valuable goodwill symbolized by their marks).

210. *Cf. Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001) (“Trade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products. In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying [C]opying is not always discouraged or disfavored by the laws which preserve our competitive economy.”); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000) (“Competition is deterred . . . not merely by successful suit but by the plausible threat of successful suit . . .”).

trademark infringement law that allows for the informational or expressive use of another's mark where the accused infringer's expression is neither a false statement about its products nor likely to mislead a reasonable person about the source of the goods, services, or message.²¹¹

This trademark fair use test would apply to commercial or noncommercial expression, and to use of the language or design as a trademark or otherwise than as a mark. There is no noncommercial use or non-trademark use requirement for application of our test since truthful commercial and trademark uses of marks are within the scope of the First Amendment's protections. Importantly, our proposed test is not an affirmative defense since the burden of proving infringement remains with the trademark owner. It is a categorical speech-protective trademark rule similar to the Ninth Circuit's version of the *Rogers* test and nominative fair use in that it protects free speech interests by requiring a higher standard for infringement than the usual multi-factor likelihood of confusion test once the threshold requirement for application of the test is satisfied. If a court or Congress wanted to limit this speech-protective test to non-trademark uses after *Jack Daniel's*, however, it could add "otherwise than as a designation of source for its own products" to the threshold requirement for the test after the "informational or expressive use of another's mark" language.

Our test modifies and expands these two common law trademark doctrines in various ways that better protect expressive values in trademark law. Importantly, it also protects trademark rights by clarifying that the defendant cannot prevail in an infringement lawsuit if it makes false claims about the product's origin or the parties' connection (such as untrue statements about the trademark owner's sponsorship or endorsement of the products). The defendant also cannot escape liability when its use of the mark is objectively likely to

211. While this Article is focused on federal trademark infringement law, the proposed trademark fair use test could also be invoked to protect First Amendment interests when a defendant is accused of infringement under state trademark law, or of counterfeiting, dilution, or cybersquatting under federal or state trademark law. It should also apply to federal or state unfair competition claims that are based on informational or expressive use of another's mark.

The term "expressive" arguably incorporates all decorative, ornamental, and aesthetically functional uses of another's mark, so the proposed speech-protective doctrine could be limited to only informational or expressive uses of a trademark or some or all of these terms could be added to the threshold requirement for the test. However, the word "expressive" does not include subject matter that is functional for utilitarian reasons, such as the dual spring design in *Traffix*, 532 U.S. at 29, that held road signs upright.

mislead about the source of the products or the speaker's identity. Courts can determine whether this trademark fair use test applies and is satisfied as a matter of law without evaluating the intent of the accused infringer or other traditional likelihood of confusion factors, which will enable judges to dispose of speech-harmful trademark claims on a motion to dismiss, motion for judgment on the pleadings, or summary judgment motion.

Courts should adopt this speech-protective doctrine to make the Lanham Act more consistent with the First Amendment right to freedom of expression, although it would be preferable for Congress to include it in the Act. Trademark infringement law needs such a broad fair use doctrine since trademark owners today can satisfy the likelihood of confusion test when consumers are merely likely to be confused about whether the trademark owner approved of the accused infringer's expression, and they can prevail where just a small percentage of surveyed consumers are confused.²¹² Consumer surveys may indicate that some people are confused from a subjective perspective, but they often do not provide objective evidence that a reasonable person is likely to be confused—and is likely to make different purchasing decisions due to this confusion—in the real world.²¹³ To protect truthful communications from constitutionally unjustified trademark regulations, our proposed fair use test would focus objectively on whether the expression of the accused infringer is fraudulent, deceptive, or misleading, and not on evidence about the impact of that use. As with the *Rogers* test, courts need not consider survey evidence about consumer misunderstandings caused by this use of the mark if the plaintiff cannot satisfy either prong of the speech-protective test.²¹⁴

212. See, e.g., *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769 (8th Cir. 1994). Justice Sotomayor wrote a concurring opinion in *Jack Daniel's* joined by Justice Alito which discusses the potential problems with consumer surveys in trademark disputes and a concern about the chilling effect on parody and free communication and discussion if courts allowed problematic survey results to drive the infringement analysis. *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519, at *11 (U.S. June 8, 2023) (Sotomayor, J., concurring).

213. Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOKLYN L. REV. 827, 832 (2004) (arguing that unlike tort law's analytical tool "the reasonable person," trademark law's "ordinarily prudent consumer" is a proxy for actual consumers but regularly minimizes consumers' rationality); Brief of *Amici Curiae* First Amendment Professors in Support of Respondent at 18–21, *Jack Daniel's*, 2023 WL 3872519 (No. 22-148).

214. Per *Rogers* and several other cases that apply this test, judges and juries do not need to consider survey evidence of confusion when the expression is not an overtly

Some judges may be inclined to protect a trademark owner against free riding on its reputation even in circumstances where the expression is truthful and not misleading, but protecting trademark rights in this context stifles expression protected by the First Amendment.²¹⁵ This is true regardless of whether the trademark owner's claim is for trademark dilution, or for infringement under the traditional likelihood of confusion standard.²¹⁶ The lack of a broad statutory fair use exception to trademark infringement chills protected expression more than necessary to fulfill the Lanham Act's objectives because it is difficult for

false or misleading claim about the product's source. *See, e.g.*, *MGFB Props., Inc. v. Viacom Inc.*, 54 F.4th 670, 682 (11th Cir. 2022) ("Plaintiffs' reliance on the survey data is unavailing. As explained above, of the 300 people surveyed, 34% had heard of the term 'Flora-bama,' with half of that 34% identifying it as the Lounge. We reject this evidence because any misunderstanding represented by the survey data was 'not engendered by any overt claim.' . . . The evidence must relate to the nature of the behavior of the defendant, not the impact of the defendant's use." (citing *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1246 (9th Cir. 2013)); *see also id.* at 1245 ("Adding survey evidence changes nothing."); *Univ. of Ala. Bd. Of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1279 (11th Cir. 2012) ("Even if some members of the public would draw the incorrect inference that the University had some involvement with Moore's paintings, prints, and calendars, that risk of misunderstanding, not engendered by any overt or in this case even implicit claim, is so outweighed by the interest in artistic expression as to preclude any violation of the Lanham Act.") (cleaned up); *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d Cir. 1989) (stating that any misunderstanding represented by the survey data was "not engendered by any overt claim"). *See generally* Graeme B. Dinwoodie, *Trademark Law as a Normative Project*, 2023 *Sing. J.L.S.* (forthcoming 2023), <https://ssrn.com/abstract=4344834> [<https://perma.cc/QR7Q-AW8B>] (arguing that trademark law should be less fixated on ascertaining, acting upon, and declaring empirical realities of consumer association and confusion and that courts should consider competing normative concerns like promoting fair competition).

215. Laura A. Heymann, *The Public's Domain in Trademark Law: A First Amendment Theory of the Consumer*, 43 *GA. L. REV.* 651, 665-66, 707-12 (2009) (arguing that trademark law should be limited to ensuring the absence of false statements of fact because broader liability interferes with the interests of consumers in First Amendment based autonomy).

216. Commentators have persuasively argued that trademark dilution laws conflict with the First Amendment, *see, e.g.*, Rebecca Tushnet, *More than a Feeling: Emotion and the First Amendment*, 127 *HARV. L. REV.* 2392, 2402-03 n.44 (2014); Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 *TEX. L. REV.* 507, 555-58 (2008); Mary LaFrance, *No Reason to Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech*, 58 *S.C. L. REV.* 709, 711 (2007); Ramsey, *supra* note 17, at 456-61; Ramsey, *supra* note 145, at 425-27 & n.269, but an evaluation of the constitutionality of these laws regulating nonmisleading commercial speech is beyond the scope of this Article, which focuses on trademark infringement law.

others to determine whether they will be liable for using another's mark for informational or expressive purposes.²¹⁷

A. The Threshold Requirement of Informational or Expressive Use

Under our test, the defendant would have the initial burden of proving the dispute involves an informational or expressive use of the plaintiff's mark.²¹⁸ If necessary, the court may consult dictionary definitions, books, and similar types of objective evidence to determine if the allegedly-infringing phrase, name, or symbol had a pre-existing informational or expressive meaning or decorative value before it was adopted or used as a mark by the plaintiff (such as the word "empire", a political message, or the fleur de lis symbol), and any other non-source-identifying meaning or value of the mark at the time of the trademark dispute. If Congress or courts choose to follow the approach in *Jack Daniel's* and require the accused infringer to prove it is using the mark otherwise than as a designation of source for its own products, then the decision-maker would also need to focus on the context of the use (this type of evidence is discussed later).

The threshold "informational use" requirement refers to uses of marks for their inherent or primary meaning to provide information about products, as well as certain nominative uses of the mark to refer to the plaintiff or to indicate the purpose of the products sold or provided by the defendant. Examples include the use of generic and descriptive terms for products (such as "Taco Tuesday" for restaurant services or "UFO" for a documentary about unidentified flying objects) or of informational symbols (such as the biohazard symbol). A defendant's use is also informational if the plaintiff's mark is used to refer to the trademark owner or its products in teaching, scholarship,

217. See, e.g., Constance Grady, *How an Author Trademarking the Word "Cocky" Turned the Romance Novel Industry Inside Out*, Vox (July 24, 2018, 1:08 PM), <https://www.vox.com/culture/2018/5/15/17339578/cockygate-explained-romance-publishing-faleena-hopkins> [<https://perma.cc/7DQG-9ELN>] (author of *The Cocky Series* romance novels that owned a trademark registration for the word "Cocky" for her book series about cocky men convinced authors to change their book titles after sending them cease and desist letters and persuaded Amazon to remove competing product listings for books with the word "Cocky" in their titles).

218. For simplicity, we will consistently refer to "marks." Our test, however, would apply to protected trademarks, service marks, collective marks, certification marks, and trade dress. We use the word "plaintiff's" here to refer to the trademark owner, but if the accused infringer files a lawsuit that asks for a declaratory judgment that it is not infringing, it would be the plaintiff and the trademark owner would be the defendant in this civil action.

news reporting, nonfiction books, documentaries, commentary in posts on blogs and social media, product reviews, comparative advertising, and advertising for compatible products, used products, repair services, broker services, and parallel imports of authentic goods. However, using another's mark to provide information *solely* about the origin or source of the defendant's products (such as "Nike" for a brand of athletic shoes or "Starbucks" for the name of a coffee shop, without any criticism or other commentary) does not qualify as an "informational use" of the mark under our proposed test.²¹⁹

The threshold "expressive use" requirement includes uses of another's mark to convey ideas, jokes, viewpoints, and similar communications. Such expression can range from storytelling, parody, satire, mashups, memes, and puns, to artistic, political, social, and religious messages that do something more than identify the trademark owner as the source of the products. Examples include use of the name "Harry Potter" within the title or content of fan fiction, and the display of "Mickey Mouse" within a comic book that portrays the character engaging in adult behaviors like drug consumption. Other examples include unauthorized uses of marks in political or social commentary displayed on T-shirts or hats, and common phrases such as "God Bless the USA" or religious messages displayed on decorative home merchandise.

While it may sometimes be difficult to draw the line between what uses are—and are not—informational or expressive, courts currently

219. If this type of source-identifying use of another's mark qualified as an informational use under the threshold requirement of our test, then most (if not all) unauthorized uses of trademarks would qualify for our higher infringement standard. In this Article, the phrases "origin" and "source" incorporate the narrow definition of origin used by the Supreme Court in *Dastar* when it interpreted this word in the Lanham Act: "We think the most natural understanding of the 'origin' of 'goods'—the source of wares—is the producer of the tangible product sold in the marketplace. . . ." *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 31 (2003); *id.* at 31-32 (noting that "[t]he dictionary definition of 'origin' is '[t]he fact or process of coming into being from a source,' and '[t]hat from which anything primarily proceeds; source'" and that the phrase origin of goods does not include "the person or entity that originated the ideas or communications that 'goods' embody or contain").

An alternative application of our proposed fair use test could require the defendant to prove as a threshold requirement that its use is an expressive or *truthful* informational use of the plaintiff's mark. This approach would exclude fraudulent or false informational statements about origin, source, sponsorship, endorsement, approval, affiliation, connection, or association at the gateway stage of the test rather than the test's first prong. We do not prefer this alternative approach because we believe the plaintiff should bear the burden of proving the statement which incorporates the mark is false.

engage in such an analysis when they determine whether the defensive doctrines of descriptive fair use, nominative fair use, parody, non-commercial use, or the *Rogers* test apply in a trademark dispute. Moreover, trademark examining attorneys at the United States Patent and Trademark Office currently consider whether certain uses of words or symbols claimed as a mark in a trademark application are merely informational or expressive matter that fails to function as a source-identifying mark for the product, including uses of language to provide “general information about the applicant’s identified goods or services,” “social, political, religious or similar informational messages in common use,” and other “widely used” messages.²²⁰

Whether a certain use of another’s mark is informational or expressive is an objective analysis that focuses on whether a reasonable person would understand the use to communicate information, ideas, or other non-source-identifying messages. The subjective intent of the accused infringer is irrelevant, so—unlike in the traditional likelihood of confusion analysis—courts need not determine whether there was an intent to confuse or an innocent reason for using this language or design. Moreover, unlike in the *Rogers* test, there is no requirement that this use of the mark be included within an expressive work, or be artistically relevant to that underlying work. Informational and expressive uses of another’s mark satisfy the threshold requirement under our test regardless of whether they are included in the title or content of traditional artistic or literary works, or are displayed on dog toys or T-shirts, labels on beer or cans of peas, or in advertisements for any of these products.²²¹ Again, if the use of another’s mark only conveys the information that the trademark owner or the accused infringer is the source of the product (such as “Nike” displayed by itself on the label or hangtag of a shoe or T-shirt), it is *not* an informational or expressive use

220. U.S. Pat. & Trademark Off., U.S. Dep’t of Com., Trademark Manual of Examining Procedure § 1202.04(a)–(b) (2022).

221. Cf. MCCARTHY, *supra* note 103, § 31:152 (explaining that mugs and T-shirts are ways to convey messages just like websites and newspapers, and that regulations of expressive uses of marks on these products can implicate the First Amendment); Brief of Amici Curiae Intellectual Property Professors and Adjunct Professors in Support of Neither Party at 2–3, 21, *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023) (arguing that the *Rogers* test should be medium-neutral, and focus on the context and content of the message rather than the medium of the message). *But cf.* Brief of the Motion Picture Association, Inc. as *Amicus Curiae* in Support of Neither Party at 11–12, 26, *Jack Daniel’s*, 2023 WL 3872519 (No. 22-148) (stating that artistic works are different than commercial products in purpose, form, and function, and they have an audience rather than a consumer).

of the mark under this fair use test and the traditional likelihood of confusion analysis should be used to determine infringement.

We believe it will be easier for courts to apply a single fair use test in trademark disputes involving informational or expressive uses of marks instead of having to choose among the various statutory and common law defenses and other speech-protective tests that may apply when First Amendment interests are implicated. Moreover, our proposed trademark fair use test is more clear and predictable than the *Rogers* test because it does not require courts to consider what constitutes an expressive *work* or whether there is an *artistic* relationship between that work and the use of the mark. Another benefit of this broader threshold requirement is that there is no need to decide whether an informational use is descriptive, or an expressive use is a parody.

B. The Trademark Fair Use Test

Once the threshold requirement of an informational or expressive use of the mark is established, the plaintiff should only prevail on its trademark infringement claim if it proves that the defendant's use is either (1) a false statement about the defendant's products, or (2) likely to mislead a reasonable person about the source of the defendant's goods, services, or message. Similar to the Ninth Circuit's nominative fair use doctrine,²²² our test is a substitute for the standard multi-factor likelihood of confusion test used to determine infringement.

Under the first "false statement" prong of our test, infringement should be found where the defendant's use of the mark is a false claim about the trademark owner's production, sponsorship, endorsement, or approval of the defendant's products, or of any affiliation, connection, or association between the parties. An example would be a false representation on labels for sports jerseys or bottles of beer, or in advertising or promotion for them, that the National Football League (NFL) "licensed" the products, or the accused infringer's use of false statements like "authorized NFL merchandise," "official beer of the NFL," "sponsored by the NFL," "endorsed by the NFL," or something similar. Such informational uses of the NFL mark are infringing false statements about the parties' business relationship. In addition, saying that a film is a parody of the heartwarming "Hallmark" movies is an expressive use of that mark, but falsely claiming that the film is approved by or affiliated with the Hallmark company would be

222. *See supra* Section II.D.

actionable infringement under our test. This first prong is similar to some courts' application of the explicitly misleads prong of the *Rogers* test to false claims about sponsorship or endorsement,²²³ except that our test clearly covers the different types of false statements about products that are listed in section 43(a)(1)(A) of the Lanham Act.²²⁴

Under the second "likely to mislead" prong of our test, a plaintiff will prevail if the defendant's use is likely to mislead a reasonable person regarding the *source* of the goods, services, or message.²²⁵ This objective standard can be established with evidence about the content and context of the use, and the products sold or provided under the mark. The focus here is on whether the use of the mark suggests that the trademark owner produced or is responsible for the product, or created the message. An example would be the prominent use of "Harry Potter" (rather than "Boy Wizard") on the packaging of a Halloween costume that closely resembles that character's clothing. Impersonation of the trademark owner may also be covered by this prong if it is difficult to determine the identity of the speaker and the content and context of the expression does not dispel the confusion caused by this unauthorized use of the mark. Examples include the false or misleading use of another's mark as a source-identifier in connection with political or religious services, websites, or social media accounts that purport to be created or maintained by the trademark owner.

The likely to mislead standard in our second prong is a speech-protective interpretation of the "likely to cause confusion" language in the Lanham Act that uses the word "mislead" to incorporate the Act's purpose of preventing fraudulent, deceptive, and misleading uses of trademarks into the test.²²⁶ Therefore, the term "mislead" signals that

223. See, e.g., *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245–46 (9th Cir. 2012); *Rogers v. Grimaldi*, 875 F.2d 994, 997–1001 (2d Cir. 1989).

224. The words origin, sponsorship, approval, affiliation, connection, and association—but not source or endorsement—are included in 15 U.S.C. § 1125(a)(1)(A). Statements *solely* about the origin or source of the defendant's products would not qualify as an informational use under the threshold requirement of our test. Regardless, such an informational statement about the product's origin or source would be found infringing under the test's first prong if it was a false claim.

225. We include messages here—not just goods and services—because consumers have an interest in not being deceived about the source of advertisements, brochures, flyers, emails, websites, social media posts, and other public communications when the accused infringer uses another's mark. See Ramsey, *supra* note 156 (discussing brandjacking on social networks like Facebook and Twitter).

226. 15 U.S.C. § 1127 ("The intent of this chapter is to regulate commerce within the control of Congress by making actionable the *deceptive and misleading* use of marks in

this is a more rigorous standard than the traditional multi-factor likelihood of confusion analysis. Significantly, this prong requires courts to focus on *source* confusion—and not other types of confusion—when First Amendment interests are at stake.²²⁷ It allows competitors and others to communicate with the public without worrying about whether some people may think the trademark owner sponsored, endorsed, or approved an informational or expressive use of its mark, or are otherwise confused about the parties' relationship. This type of breathing room is critical for expression protected by the First Amendment. Confusion solely about consent or other connections between the parties is not sufficient under this high threshold for trademark infringement liability.

Moreover, under our test, courts need not—and should not—consider the numerous likelihood of confusion factors typically used to determine infringement in regular trademark disputes because such an analysis does not adequately protect First Amendment interests when the mark is used in an informational or expressive manner by the defendant. Instead of examining the subjective intent of the defendant or consumer survey evidence, courts should determine whether this use of another's mark is likely to mislead a reasonable person about the source of the product or message by considering objective evidence about (1) the content of the defendant's use, (2) the context of its use of the mark, and (3) the products it sold or provided under the mark. Rather than use a multi-factor test which requires courts to determine whether each factor favors a certain party or is neutral or irrelevant, we propose that courts examine these three types of evidence to determine

such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent *fraud and deception* in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade name, and unfair competition entered into between the United States and foreign nations.") (emphasis added). Importantly, the standard is "likely to mislead" instead of "has misled" to emphasize that proof of actual confusion (that someone was actually misled by this informational or expressive use) (1) is not required to prove infringement under the test and (2) may not be relevant under the objective reasonable person standard.

227. Courts are able to focus solely on source confusion, just like the Ninth Circuit did in the *Lettuce Turnip the Beet* case. *Lettuce Turnip the Beet, LLC v. Redbubble, Inc.*, No. 19-16464, 2021 WL 195024, 840 F. App'x 148 (9th Cir. 2021). Moreover, the Lanham Act is more likely to survive strict scrutiny analysis if it focuses on confusion about the *source* of the products or message—the identity of the seller or speaker—when regulating unauthorized uses of marks in noncommercial speech. *See supra* note 157.

from a holistic perspective whether the use is likely to cause source confusion.

1. *The Content of the Defendant's Use*

Either party may offer evidence about the content of the defendant's expression to help the court determine whether the use of another's mark is likely to mislead a reasonable person about the source of the defendant's products or message. Evidence may include photographs, screenshots of webpages, print advertisements, or other documents which show the accused infringer is (or is not) using the words or symbols for their inherent informational or expressive meaning, to refer to the plaintiff (such as in news reporting or comparative advertising), or to set forth the purpose of the products (such as compatible goods or repair services). Such evidence can also show whether the defendant modified the plaintiff's mark in some way or added expression to it (such as a parody or mashup).

An informational use of the mark is generally less likely to cause source confusion. Examples include titles that describe the content of the artistic or literary work, such as "UFO" for a documentary about unidentified flying objects, the phrase "Wild America" or similar terms for documentaries about wild animals in America, and "Super Heroes" for comic books, films, or television series about superheroes.²²⁸ Other examples include use of the phrase "Super Heroes" or "Super Hero" to convey that a toy or Halloween costume is designed to represent a superhero, the word "Lifeguard" in connection with the sale of shirts or swimsuits worn by lifeguards, and the term "Emoji" to inform consumers that the clothing for sale displays an emoji.²²⁹ On the other

228. Order Granting Defendant's Motion to Dismiss, *UFO Mag., Inc. v. Showtime Network, Inc.*, No. 22-cv-00078, 2022 WL 16644914 (D. Wyo. Nov. 3, 2022); *Stoeffler v. Nat'l Geographic Partners, LLC*, 460 F. Supp. 3d 1133, 1139–46 (D. Colo. 2020). DC Comics and Marvel Characters, Inc. jointly own trademark registrations for "Super Heroes" and "Super Hero" for various products, including expressive works and merchandise that features superheroes. SUPER HEROES, Registration No. 1,140,452 (toy figures); SUPER HEROES, Registration No. 1,179,067 (publications); SUPER HEROES, Registration No. 3,674,448 (T-shirts); SUPER HEROES, Registration No. 5,613,972 (production and distribution of a series of animated motion pictures, and entertainment services in the nature of cartoon exhibitions); SUPER HERO, Registration No. 0,825,835 (masquerade costumes).

229. "Lifeguard" and "Emoji" are registered marks for T-shirts, and the owners of these marks have engaged in aggressive enforcement of their trademark rights. LIFEGUARD, Registration Nos. 2,754,820; 3,800,325; EMOJI, Registration Nos. 7,915,9338; 7,913,6472; 5,202,078; 4,868,832. *See, e.g.*, *Emoji Co. GmbH v. Individuals Identified on Schedule A Hereto*, Nos. 20-cv-04678, 21-cv-05319 & 21-cv-05453, 2022

hand, a reasonable person may be confused about the source of the goods if a company displayed the phrase “Super Hero” on packaging for a Halloween costume along with other known references to DC Comics or Marvel.

The defendant’s expression is also less likely to mislead a reasonable person regarding the source of its products or message if this use of the mark expresses ideas, viewpoints, or a humorous message. Examples include the phrase “Chewy Vuitton” and a parody design for dog toys that is similar to the symbols displayed on Louis Vuitton handbags and “Barbie Girl” in the title of a song poking fun at the “Barbie” brand of dolls.²³⁰ If the defendant modified the mark (*e.g.*, Chewy Vuitton), or added additional expression to it (*e.g.*, adding “Girl” to the *Barbie Girl* song title, comparing the parties’ products in comparative advertising, displaying the Louis Vuitton marks within presentation slides during a lecture about trademark law, or including a Louis Vuitton product in one scene of a film),²³¹ that use is less likely to cause source confusion for a reasonable person.²³² On the other hand, an expressive use of a phrase that is identical to the plaintiff’s brand name (such as “Jack Daniel’s”, “Nike”, or “Yves Saint Laurent”) in connection with the sale of digital

WL 4465593, at *1 (N.D. Ill. Sept. 26, 2022); Declaration of Ruben Azrak at 4, *Lifeguard Licensing Corp. v. Kozak*, 371 F. Supp. 3d 114 (S.D.N.Y. 2019) (No. 1:15-cv-08459) (claiming that the trademark owner has sent approximately 100 cease-and-desist letters to alleged infringers); *see also* Leah Chan Grinvald, *Trademark Enforcement and Statutory Incentives*, 39 CARDOZO ARTS & ENT. L.J. 931, 940–41 n.70 (2021) (discussing incentives to enforce trademarks and the “Lifeguard” mark); Eric Goldman, *A SAD New Category of Abusive Intellectual Property Litigation*, COLUM. L. REV. FORUM (forthcoming 2023), <https://ssrn.com/abstract=4381824> [<https://perma.cc/PCV2-U6BG>] (explaining how Emoji Co. and other companies have engaged in abusive mass-defendant trademark litigation); Eric Goldman, *If the Word “Emoji” Is a Protectable Trademark, What Happens Next?—Emoji GmbH v. Schedule A Defendants*, TECH. & MKTG. L. BLOG (Oct. 17, 2022), <https://blog.ericgoldman.org/archives/2022/10/if-the-word-emoji-is-a-protectable-trademark-what-happens-next-emoji-gmbh-v-schedule-a-defendants.htm> [<https://perma.cc/Z5Y2-UJES>] (“Emojico has likely sued about 10,000 defendants for trademark infringement. Many defendants are small-time Amazon vendors (often from China) selling items depicting emojis, who Emojico claims are infringing by using the term ‘emoji’ in their product listings.”).

230. *Louis Vuitton Malletier, S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 267 (4th Cir. 2007); *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 899–900 (9th Cir. 2002).

231. *Louis Vuitton Malletier S.A. v. Warner Bros. Entm’t Inc.*, 868 F. Supp. 2d 172 (S.D.N.Y. 2012).

232. This fact was recognized by the Ninth Circuit in *Gordon*, but that court did not also take into account the context of the mark’s use (*i.e.*, inside the punchline of a greeting card instead of in the trademark spot on the back of the product). *See supra* Section I.D. Of course, adding words or expression, or otherwise modifying the mark, would also make the accused infringer’s expression less likely to cause confusion under the traditional likelihood of confusion test since the marks would no longer be identical.

goods or services within a virtual world may be more likely to cause source confusion depending on the context of the use and the products sold under the mark.

2. *The Context of the Defendant's Use*

Like the content of the mark, the context of the mark's use by the defendant is important evidence to consider when determining whether the expression is likely to mislead a reasonable person regarding the source of the product or message. This includes an evaluation of whether the defendant is (or is not) using the allegedly-infringing language or design as a trademark (*e.g.*, as a brand name), and other content-neutral evidence about the places where it displays the plaintiff's mark (*e.g.*, within an advertisement, website, domain name, social media post, username, or the title or content of an expressive work). Under our test, the fact the mark is used (or not used) as a trademark is relevant—but not determinative—to whether the use is infringing under the Lanham Act.²³³

Placement of the subject matter claimed as a mark in the usual trademark space on packaging or products (such as prominently at the top of a box of cookies or on the back of a greeting card), or where marks are normally displayed in advertising or promotional materials,²³⁴ is more likely to mislead consumers about the product's source than use of that subject matter otherwise than as a mark in an informational, expressive, or decorative manner (such as in the list of product ingredients or the inside of a greeting card). The trademark spot varies depending on the goods or services, but it is often located in one of a few places on products like an automobile (the outside of the trunk), a mobile phone (the back of the device), airline services (the airplane or airport signs), or restaurant services (the sign in front of the restaurant and the words or design at the top of a menu). If the phrase or symbol is not within these typical trademark spots, the use is less likely to cause source confusion.

In the merchandising industry, the context or location of the mark's use is also important when determining whether the display of a certain

233. *Cf.* Jack Daniel's Prods., Inc. v. VIP Prods. LLC, No. 22-148, 2023 WL 3872519, at *8 n.2 (U.S. June 8, 2023) ("Some [source-identifying] uses will not present any plausible likelihood of confusion—because of dissimilarity in the marks or various contextual considerations.).

234. Lemley & McKenna, *supra* note 160, at 18, 52-53, 60, 65; Roberts, *supra* note 143, at 2005-06; Thomas R. Lee, Eric D. DeRosia & Glenn L. Christensen, *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033, 1055-58, 1076-78, 1089-90, 1097-99 (2009).

term or design is not (or is) likely to mislead a reasonable person about the product's source. T-shirts and other types of expressive merchandise commonly feature non-source-identifying messages (like jokes or political slogans) on their outside surface,²³⁵ while the product's source is often found on a label, hangtag, box enclosing the products, or in particular spots on the packaging. Moreover, there are certain spaces in online marketplaces where brand information is listed and the source of the new or used products sold under that mark.²³⁶ This product-source-identifying information is distinguishable from the description of the features of the goods in the product listings. Sellers should be able to use the term "super heroes" in a product listing to describe their T-shirts that display phrases like "Firefighters are Super Heroes" regardless of the fact that "Super Heroes" is a registered mark for T-shirts.²³⁷ If the T-shirts feature emoji designs, trademark law should allow sellers to use the word "Emoji" to provide truthful information about their goods despite the fact this word is also a registered mark for clothing.²³⁸ Such non-trademark uses of these words are less likely to mislead a reasonable person about the source of the T-shirt.

3. *The Products Sold or Provided Under the Mark*

The kind of products sold or provided under the mark—political services, news reporting, artistic or literary works, T-shirts, dog toys, beer, a can of peas, or repair services²³⁹—may also make a particular use of another's mark more or less likely to mislead a reasonable person regarding the source of a product or message. However, the type of the accused infringer's goods or services should not be the determinative factor when courts consider whether its communications are protected speech under the First Amendment and therefore eligible for a speech-protective trademark rule. Truthful comparative advertising of

235. One of us has used the term "expressive merchandise" to refer to certain types of products that typically feature words or designs that communicate information, ideas, or viewpoints, including T-shirts, hats, sneakers, tote bags, mugs, keychains, license plate frames, mobile phone cases, stickers, flags, and decorative wall hangings. Ramsey, *supra* note 17, at 468; Ramsey, *supra* note 193, at 88.

236. The seller or reseller of a product may not be the same company as the manufacturer of the product whose mark is displayed on the goods.

237. SUPER HEROES, Registration No. 3,674,448.

238. EMOJI, Registration Nos. 7,915,9338; 7,913,6472; 5,202,078; 4,868,832.

239. *See, e.g.*, Scott Fetzer Co. v. House of Vacuums, Inc., 381 F.3d 477 (5th Cir. 2004) (use of Kirby logo in connection with the sale and repair of vacuum cleaners); Harley-Davidson, Inc. v. Grottanelli, 164 F.3d 806, 813 (2d Cir. 1999) (use of Harley-Davidson logo to advertise motorcycle repair shop).

commercial products and other nonmisleading informational uses of language (such as use of “Taco Tuesday” in connection with restaurant services) are protected speech and allowing such expression furthers the Lanham Act’s purpose of promoting fair competition.

A holistic analysis of the content and context of the use with the defendant’s products (or in advertising for them) is required. For example, like political messages, parodies, and puns, trademarks are displayed across the front or back of expressive merchandise like clothing. It is not uncommon to see the names and logos of universities, sports teams, athletic wear companies, and other well-known organizations or businesses prominently and centrally displayed on T-shirts, hats, keychains, and similar promotional goods. That is why it is critical to consider the content of the accused infringer’s expression (*e.g.*, Nike, Lifeguard, Super Hero, or Just Did It)²⁴⁰ and the products sold or provided by the accused infringer along with the context of its use when determining whether this use of another’s mark is likely to mislead a reasonable person as to the source of the product or message (*e.g.*, use of Nike on the inside label or hangtag of a shirt, within a news article about the company Nike, Inc., or in the title and content of a movie or book about the Greek goddess of victory). The fact that an accused infringer is selling T-shirts instead of news, movies, or books is not as important when evaluating liability under our trademark fair use test as evidence about the content of the words or designs used, and whether they are used (or not used) as a product-source-identifying trademark.

In trademark disputes that implicate First Amendment interests, our focus on the informational or expressive content and context of the accused infringer’s use of the mark, and on whether this use in connection with its products is likely to cause source confusion (or is a false claim about its products), is more speech-protective and consistent with trademark law’s purposes than using the multi-factor likelihood of confusion test. For example, the similarity of the marks factor in that test suggests that an identical use of the plaintiff’s mark means this use is more likely to cause confusion, but that is not true when a competitor displays a phrase like “Lifeguard” in an informational or decorative manner on the front of a shirt or uses the title “UFO” to describe the content of a documentary. In addition, the strength of the mark factor of the traditional test focuses on the plaintiff’s mark, and deems use of a descriptive mark less likely to cause confusion, but this factor fails to consider whether the accused infringer is using another’s fanciful,

240. Nike, Inc. v. “Just Did It” Enters., 6 F.3d 1225 (7th Cir. 1993).

arbitrary, or suggestive mark to provide information about its products or to convey ideas, viewpoints, or other messages.²⁴¹

C. *Anticipating Reactions to Our Proposal*

Importantly, this proposed trademark fair use doctrine is not a “free pass” to infringe another’s valid mark by simply claiming the expression is informational or expressive. The defense does not apply if—from an objective point of view—the threshold requirement is not satisfied, or if the accused infringer’s expression is a false statement about its products or is likely to mislead a reasonable person about the source of the goods, services, or message. Thus, under our proposal, trademark infringement law will still prevent consumer confusion and unfair competition by banning fraudulent, deceptive, or misleading use of another’s mark to convey information or express ideas, viewpoints, or other messages.

To balance trademark and free speech interests, consumer confusion just about sponsorship, endorsement, approval, affiliation, connection, or association should not be actionable if the accused infringer did not falsely contend that its use of the mark was licensed or otherwise make a false statement of fact about its relationship with the trademark owner.²⁴² There should be no finding of infringement simply because some consumers were confused about whether the defendant had the trademark owner’s consent to use the mark with these products, or whether permission was required in this context under trademark law.

Of course, some consumers may care whether Jack Daniel’s, the NFL, or a sports team, university, rock band, celebrity, or another entity or person has licensed their mark for use on a dog toy, T-shirt, or other expressive merchandise, or for use in connection with the sale of NFTs or virtual products. Members of the public may want to support their favorite companies, organizations, musical groups, athletes, actresses, and actors by purchasing products that display their brand names, logos, or personal names. Yet other people may not care about whether products that display a mark are licensed. They may just want the “Bad Spaniels” toy or parody T-shirt because it is funny. For these consumers,

241. The descriptive fair use defense does take this fact into account, but—as discussed previously—that speech-protective limitation on the scope of trademark rights is narrow since it requires use of the mark otherwise than as a mark and it is limited to uses that describe the goods or services of the defendant.

242. “Taking modern First Amendment doctrine seriously would have significant effects on the Lanham Act, affecting everything from the standard of proof to the definition of what counts as misleading.” Rebecca Tushnet, *Trademark Law as Commercial Speech Regulation*, 58 S.C. L. REV. 737, 755 (2007).

the relationship between the product's seller and the trademark owner is immaterial to their purchasing decisions. They may prefer the lower prices and increased choices that often result from fair competition in an industry. Trademark laws need to take into account the interests of all consumers and the public's interest in fair competition and free expression when the defendant has not made false statements about its products. Our fair use test balances the trademark and free speech interests of the parties and the public in disputes involving informational or expressive uses of trademarks.

As discussed in Part I, Jack Daniel's and its supporters argued in the *Jack Daniel's* case that government bans on the use of another's mark in connection with the sale of commercial products do not implicate the constitutional right to freedom of expression. The First Amendment's protections still apply in this context, however, if the expression is not fraudulent, deceptive, or misleading. While dicta in *Rogers* differentiated movies, plays, books, and songs from other more utilitarian or commercial products like a can of peas,²⁴³ an informational or expressive use of language or a design could occur on products or packaging, or in advertising or promotional materials, for any type of products. As the right to freedom of expression protects nonmisleading speech from unjustified government regulations, we cannot ignore free speech interests in trademark disputes involving informational or expressive uses of another's mark in connection with any and all goods or services.²⁴⁴

We prefer that Congress amend the Lanham Act to add our proposed trademark fair use test. Until then, we recommend that courts adopt it under the doctrine of constitutional avoidance. This doctrine allows courts to interpret the broad and ambiguous "likely to cause confusion" standard in a narrow manner when the infringement statutes apply on their face to truthful and nonmisleading uses of marks in noncommercial or commercial speech that implicate the First Amendment.²⁴⁵ While our proposed test and the *Rogers'* test are not

243. *Rogers v. Grimaldi*, 875 F.2d 994, 997–98 (2d Cir. 1989).

244. The public should be able to "avail itself of the powerful rhetorical capacity of trademarks." Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 398 (1990).

245. *Edward J. DeBartolo Corp. v. Fla. Gulf Coast Bldg. & Constr. Trades Council*, 485 U.S. 568, 575 (1988) (discussing the canon of constitutional avoidance); *see also* *Rescue Army v. Mun. Court*, 331 U.S. 549, 568–72 (1947) (explaining why courts should avoid unnecessary constitutional adjudication); *Ashwander v. Tenn. Valley Auth.*, 297 U.S. 288, 347 (1936) (Brandeis, J., concurring); *see also* Ramsey, *supra* note 145, at 448; Brief of

explicitly set forth in the text of the Lanham Act, neither is the multi-factor likelihood of confusion test for infringement developed by the circuit courts. As a result, requiring a higher threshold for a finding of trademark infringement in disputes involving informational or expressive uses of another's mark is not inconsistent with the language in the Lanham Act.

Because our test is similar in many ways to the *Rogers* test and other defensive doctrines in trademark law, adding our trademark fair use doctrine to the Lanham Act or common law would not be a disruptive change. Moreover, the gateway requirement for application of our trademark fair use test is consistent with the Supreme Court's First Amendment jurisprudence because it focuses on whether the speaker's communications are protected speech under the U.S. Constitution, and not on a categorization of the products for sale by the accused infringer. Our two-prong trademark fair use test subsumes many of the doctrines that Congress and the courts currently use to safeguard commercial and noncommercial speech in trademark law, including but not limited to nonmisleading uses of marks in expressive works, descriptive fair use, nominative fair use, parody, and aesthetically functional or ornamental uses of marks.²⁴⁶ This broad speech-protective doctrine could replace some or all of these rules with one simple test.

We agree with Professor Bill McGeveran that any new speech-protective trademark doctrine should permit trademark disputes to be resolved quickly and inexpensively, provide predictability and clarity in trademark law, balance economic and free speech rights, and internalize the First Amendment's requirements within trademark law.²⁴⁷ Litigation is expensive. Individuals, nonprofit organizations, and small businesses often cannot afford to litigate through discovery to summary judgment or trial. If the lawsuit lacks merit, courts need doctrinal tools to resolve that trademark dispute early. As our test does not require an evaluation of multiple likelihood of confusion factors or evidence of surveys about consumer perceptions, courts can use it to resolve speech-harmful infringement disputes early on a motion to dismiss, motion for judgment on the pleadings, or summary judgment motion. Our bright-line categorical fair use test may also provide cover for

the Motion Picture Association, Inc. as *Amicus Curiae* in Support of Neither Party at 11–12, *Jack Daniel's Prods., Inc. v. VIP Prods. LLC*, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023).

246. We prefer our test to the statutory descriptive fair use defense since it does not require use of the mark otherwise than as a mark and it is not limited to uses of another's mark that describe goods or services.

247. McGeveran, *supra* note 11, at 1207–23.

online marketplaces, search engine providers, social media companies, and other private entities that want to refuse to take down nonmisleading products, product listings, advertisements, or posts after a trademark owner files a frivolous trademark complaint.

We think our test provides more guidance to courts and private decision-makers that want to enforce trademark rights in a manner that safeguards expressive values and furthers trademark law's goals. It better protects First Amendment interests in trademark law because it applies in disputes involving informational or expressive uses of marks in connection with the sale or provision of any goods or services, including political services, artistic and literary works, expressive merchandise, and ordinary commercial products. Our test also protects the interests of trademark owners and consumers by not permitting this exception to infringement liability if the defendant's expression is fraudulent, deceptive, or misleading. Until Congress adds more speech-protective defensive doctrines to the Lanham Act, it is critical that courts clarify that the scope of trademark rights in a mark is narrow when the free speech right in the First Amendment is implicated in a trademark dispute and consider adopting a broader fair use doctrine in trademark law.

CONCLUSION

This Article discusses different types of thresholds in trademark infringement disputes: the threshold requirement for application of a speech-protective trademark test and, if that test applies, the higher threshold that must be satisfied by a trademark owner to prevail on an infringement claim. The *Rogers* test has definite advantages over the multi-factor likelihood of confusion test in trademark disputes involving expressive works. However, this Article proposes that Congress or the courts adopt an alternative test for protecting First Amendment interests in trademark law with a broader gateway requirement and a more clear objective standard for trademark infringement.

Our trademark fair use test would apply to any informational or expressive use of a mark in connection with any products, and not solely to use of that mark in part of an expressive work. If this threshold requirement is satisfied, this use is a fair use unless the accused infringer's expression is a false statement about its products or is likely to mislead a reasonable person about the source of the goods, services, or message. This more holistic approach to balancing trademark and free speech rights in the trademark enforcement context should increase clarity and predictability in trademark law and further trademark law's important goals.