

Blog Post

# Not Funny! Unanimous SCOTUS in Jack Daniel’s v. VIP Holds That Parody Does Not Implicate First Amendment Concerns, But Only Implicates Likelihood of Confusion

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On June 8, 2023, the Supreme Court unanimously decided the trademark parody case captioned *Jack Daniel’s Properties, Inc. v. VIP Products LLC* in favor of Jack Daniel’s, and against the dog toy manufacturer and serial parodist VIP Products. 599 U. S. \_\_\_\_ (2023) (hereinafter “Slip Op.”). The Court made plain that ***using a senior user’s trademark as a trademark*** in a parody does not implicate First Amendment concerns. Rather, parody comes into play only if the parody causes consumers not to be likely confused as to sponsorship or source of the parody product.

As we previously blogged, the issues presented in the case were:

1. Whether humorous use of another’s trademark as one’s own on a commercial product is subject to the Lanham Act’s traditional likelihood-of-confusion analysis, or instead receives heightened First Amendment protection from trademark infringement claims.
2. Whether humorous use of another’s mark as one’s own on a commercial product is

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“noncommercial” under 15 U.S.C. § 1125(c)(3)(C), thus barring as a matter of law a claim of dilution by tarnishment under the Trademark Dilution Revision Act (“TDRA”).

Likelihood of confusion analysis prevailed in Question 1; and the Court delivered a resounding “no” in response Question 2.

The opinion by Justice Kagan was summarized succinctly at the outset:

This case is about dog toys and whiskey, two items seldom appearing in the same sentence. Respondent VIP Products makes a squeaky, chewable dog toy designed to look like a bottle of Jack Daniel’s whiskey. Though not entirely. On the toy, for example, the words “Jack Daniel’s” become “Bad Spaniels.” And the descriptive phrase “Old No. 7 Brand Tennessee Sour Mash Whiskey” turns into “The Old No. 2 On Your Tennessee Carpet.” The jokes did not impress petitioner Jack Daniel’s Properties. It owns trademarks in the distinctive Jack Daniel’s bottle and in many of the words and graphics on the label. And it believed Bad Spaniels had both infringed and diluted those trademarks. Slip Op. at 1.

The Court of Appeals [for the Ninth Circuit], in the decision we review, saw things differently. Though the federal trademark statute makes infringement turn on the likelihood of consumer confusion, the Court of Appeals never got to that issue. On the court’s view, the First Amendment compels a stringent threshold test when an infringement suit challenges a so-called expressive work — here (so said the court), the Bad Spaniels toy. And that test knocked out Jack Daniel’s claim, whatever the likelihood of confusion. Likewise, Jack’s dilution claim failed—though on that issue

the problem was statutory. The trademark law provides that the “noncommercial” use of a mark cannot count as dilution. 15 U. S. C. §1125(c)(3)(C). The Bad Spaniels marks, the court held, fell within that exemption because the toy communicated a message—a kind of parody—about Jack Daniel’s. *Id.* at 1-2. Today, we reject both conclusions. The infringement issue is the more substantial. In addressing it, we do not decide whether the threshold inquiry applied in the Court of Appeals is ever warranted. We hold only that it is not appropriate when the accused infringer has used a trademark to designate the source of its own goods—in other words, has used a trademark as a trademark. That kind of use falls within the heartland of trademark law, and does not receive special First Amendment protection. The dilution issue is more simply addressed. The use of a mark does not count as noncommercial just because it parodies, or otherwise comments on, another’s products. *Id.* at 2.

The “expressive work” basis of the Ninth Circuit’s opinion in favor of VIP relied on *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). As argued by Jack Daniel’s, “[u]nder *Rogers*, an expressive work is allowed to confuse as long as the use of a mark is artistically relevant and not explicitly misleading. [Yet] parodies can be confusing ... [meaning] pervasive copying and trading off a brand’s goodwill [that] tends to confuse will get a Lanham Act pass under *Rogers*.”

Justice Kagan put the *Rogers* case in context, writing that it involved:

a film by Federico Fellini titled ‘Ginger and Fred’ about two fictional Italian cabaret dancers who imitated Ginger Rogers and Fred Astaire. When the film was released in the United States, Ginger Rogers objected

under the Lanham Act to the use of her name. The Second Circuit rejected the claim. It reasoned that the titles of ‘artistic works,’ like the works themselves, have an ‘expressive element’ implicating ‘First Amendment values.’ And at the same time, such names posed only a ‘slight risk’ of confusing consumers about either ‘the source or the content of the work.’ So, the court concluded, a threshold filter was appropriate. ... But the court made clear that it was not announcing a general rule. In the typical case, the court thought, the name of a product was more likely to indicate its source, and to be taken by consumers in just that way.

Slip Op. at 11.

In this case, by contrast, the Court found that *Rogers* was not invoked, because “an alleged infringer use[d] a trademark in the way the Lanham Act most cares about: as a designation of source for the infringer’s own goods. VIP used the marks derived from Jack Daniel’s in that way, so the infringement claim here rises or falls on likelihood of confusion.” *Id.* at 10 (emphasis added). Justice Kagan continued, noting *Rogers* only “kicks in when a suit involves solely ‘nontrademark uses of [a] mark—that is, where the trademark is not being used to indicate the source or origin’ of a product, but only to convey a different kind of message. ... If we put this case to the side, the *Rogers* test has applied only to cases involving ‘non-trademark uses’—or otherwise said, cases in which ‘the defendant has used the mark’ at issue in a ‘non-source-identifying way.’” *Id.* at 13 (internal citations omitted).

More specifically, Justice Kagan validated the District Court’s holding that “VIP uses its Bad Spaniels trademark and trade dress as source identifiers of its dog toy,” by reasoning that “[w]hen ... the use is ‘at least in part’ for ‘source identification’—when the defendant may be ‘trading on the good will

of the trademark owner to market its own goods’ — *Rogers* has no proper role. And that is so ... even if the defendant is also ‘making an expressive comment,’ including a parody of a different product. The defendant is still ‘mak[ing] trademark use of another’s mark,’ and must meet an infringement claim on the usual battleground of ‘likelihood of confusion.’ Slip Op. at 14.

The Court was careful to note that it was not taking a position on *Rogers*, but rather restoring its proper place as a “cabined doctrine.” *Id.* at 13. “Over the decades, the lower courts adopting *Rogers* have confined it to similar cases, in which a trademark is used not to designate a work’s source, but solely to perform some other expressive function.” *Id.* at 11.

With the only question remaining being “whether the Bad Spaniels marks are likely to cause confusion,” the Court remanded the case on VIP’s asserted defense to infringement, namely, that its product’s “expressive message—particularly a parodic one,” refuted a likelihood of confusion. “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. So although VIP’s effort to ridicule Jack Daniel’s does not justify use of the *Rogers* test, it may make a difference in the standard trademark analysis. Consistent with our ordinary practice, we remand that issue to the courts below.” Slip Op. at 18-19.

On the dilution by tarnishment issue, the Court rejected the Ninth Circuit’s view that parodies are “non-commercial uses” even when used to sell a product. *Id.* at 19. The Supreme Court noted that “[h]owever wide the scope of the ‘noncommercial use’ exclusion, it cannot include, as the Ninth Circuit thought, every parody or humorous commentary.” *Id.* Rather, like the fair-use defense, the parody defense only applies when the mark is

“not used to designate source. ... The [Ninth Circuit’s] expansive view of the ‘noncommercial use’ exclusion effectively nullifies Congress’s express limit on the fair-use exclusion for parody, etc.” for dilution liability. *Id.* at 20.

In closing, the Court concluded:

Today’s opinion is narrow. We do not decide whether the *Rogers* test is ever appropriate, or how far the “noncommercial use” exclusion goes. On infringement, we hold only that *Rogers* does not apply when the challenged use of a mark is as a mark. On dilution, we hold only that the noncommercial exclusion does not shield parody or other commentary when its use of a mark is similarly source-identifying. It is no coincidence that both our holdings turn on whether the use of a mark is serving a source-designation function. The Lanham Act makes that fact crucial, in its effort to ensure that consumers can tell where goods come from.

Slip Op. at 20.

Justice Sotomayor’s short concurring opinion, which was joined by Justice Alito, addressed the use of surveys “in the context of parodies and potentially other uses implicating First Amendment concerns.” Sotomayor Concurrence at 1. She cautioned that “[a]llowing such survey results to drive the infringement analysis would risk silencing a great many parodies, even ones that by other metrics are unlikely to result in the confusion about sourcing that is the core concern of the Lanham Act.” *Id.* at 2. “As petitioner did here, plaintiffs in trademark infringement cases often commission surveys that purport to show that consumers are likely to be confused by an allegedly infringing product. Like any other evidence, surveys should be understood as

merely one piece of the multifaceted likelihood of confusion analysis....” *Id.*

Justice Gorsuch’s even shorter concurrence, which was joined by Justices Thomas and Barrett, focused on the *Rogers* test:

Today, the Court rightly concludes that, even taken on its own terms, *Rogers* does not apply to cases like the one before us. But in doing so, we necessarily leave much about *Rogers* unaddressed. For example, 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? For another thing, it is not obvious that *Rogers* is correct in all its particulars—certainly, the Solicitor General raises serious questions about the decision. All this remains for resolution another day, and lower courts should be attuned to that fact.

Gorsuch Concurrence at 1.

As we previously blogged, the U.S. Solicitor General’s office appearing as *Amicus Curiae* in support of Petitioner, argued that “*Rogers* is substantively inconsistent with the Lanham Act. *Rogers* requires a showing either of a complete lack of artistic relevance or that the use of the trademark is explicitly misleading. ... *Rogers* currently is operating to protect a lot of behavior that could cause confusion to consumers.... [I]n our view, the way that parody enters into the picture in most of these cases is that ... the more similar two marks are, the more likely consumers are to be confused. And a fact-finder could conclude that that’s not the case in a parody case because the parody, by its nature, is going to be drawing some humorous contrast with the original, and that contrast will itself serve to distinguish the two in the minds of consumers.”

At bottom, another parody may have been squelched in favor of a powerful trademark owner based on purported likelihood of confusion. That remains to be seen on remand. Justice Sotomayor addressed the high cost of, and the often undue weight given to, consumer surveys in infringement cases, but nonetheless “little guy” (or at least smaller guy) commercial parodists are going to have to be very careful trying to make fun of brands going forward, because First Amendment protection is not on their side after this decision. They must rely entirely on lack of likelihood of confusion.

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