

Jack Daniel's Dog Toy Case May Clear Up Fuzzy IP Issue

By **Bruce Isaacs** (January 26, 2023, 2:50 PM EST)

Can a dog's chew toy be an expressive work? Can any product marketed to consumers for profit be anything other than a commercial work?

As numerous case decisions have held, the First Amendment may protect a party who appropriates a known trademark for an irreverent purpose — so long as the use is deemed to be expressive.

But what exactly is an expressive work, as opposed to a purely commercial product? The U.S. Supreme Court is scheduled to weigh in on these matters this term.



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In the case of *Jack Daniel's Properties Inc. v. VIP Products LLC*,^[1] the highest court may decide once and for all whether and when such a product should be considered an expressive work whose humorous — or tasteless — use is nonetheless subject to protection under the First Amendment.

When it agreed to grant certiorari on Nov. 21 — after originally denying review — the court signaled that it was ready to delve into a fraught, complex and often subjective area of law. The justices heard arguments for the case on Jan. 11.^[2]

The case at issue involves a dog chew toy called "Bad Spaniels," clearly designed to poke fun at the venerated Jack Daniel's Tennessee whiskey with an off-color, poop-themed product.

The dog toy essentially replicates the look and feel of Jack Daniel's well-known trade dress, using similar script, shape and other identifiable elements.

The two questions awaiting answer by the high court, according to Jack Daniel's brief,^[3] are:

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

Case Background

When the dispute first went to trial, Jack Daniel's prevailed on its claims for trademark infringement and dilution by tarnishment.

On appeal, however, the U.S. Court of Appeals for the Ninth Circuit was not as receptive to Jack Daniel's arguments.[4] The Ninth Circuit overturned part of the trial court's decision, ruling that the dog chew toy was actually an expressive work entitled to First Amendment protection — a controversial holding, to be sure.

Unless Jack Daniel's could meet the burden established under the Rogers test, VIP's use would be considered noninfringing because of the protections afforded by the First Amendment.

In particular, the Ninth Circuit found that VIP's use of Jack Daniel's mark was humorous, expressive and, importantly, noncommercial, because, "[a]lthough VIP used[Jack Daniel's] trade dress and bottle design to sell Bad Spaniels, they were also used to convey a humorous message" and the communication of a new message and a different meaning has been, in many cases, protected by the First Amendment.

Rogers Test

The Rogers test arose out of a U.S. Court of Appeals for the Second Circuit case decided in 1989.[5] Actress Ginger Rogers had sued the producers of a film called "Ginger and Fred," alleging trademark infringement and other violations of the Lanham Act.

The Second Circuit, concerned with balancing artistic expression against the rights of trademark owners, created a test that would become the de facto standard for adjudicating the most common defenses to Lanham Act claims in both the Second Circuit and the Ninth Circuit.

Under the Rogers test, also known as the nominative fair use doctrine, once use of a trademark has been determined to be artistically relevant to an expressive work, the burden shifts to the trademark owner to show why it is not subject to protection under the First Amendment.

The trademark owner must do this by establishing that use of the mark has no artistic relevance to the underlying expressive work or, if there is artistic relevance, that it explicitly misleads consumers as to the source or the content of the work.

Expressive Works Versus Commercial Products

In trademark, copyright and right of publicity cases, expressive works have been treated differently than purely commercial products.

Some works — movies, books, songs — are unquestionably expressive works. Others straddle the line or fall into the interstices between the two camps, such as video games, greeting cards and T-shirts that convey a message.

But in which category do dog chew toys land? Because there is no litmus test for determining what constitutes an expressive work, courts have had to decide this crucial issue on a case-by-case basis.

In the 2002 case *Mattel Inc. v. MCA Records*, the Ninth Circuit held that use of the word "Barbie" in a song title was artistic expression rather than commercial use, even though the motive behind such use was undoubtedly profit.[6]

Applying the Rogers test, the Ninth Circuit found that the song's title was artistically relevant to the underlying expressive work and that the song did not suggest that it was created by the well-known toy company Mattel. Therefore, there was no finding of trademark infringement.

In a different case, *Gordon v. Drape Creative Inc.* in 2018, the Ninth Circuit ruled against a greeting card company over its use of the Honey Badger trademark.[7] Also, see the Ninth Circuit's ruling following the petition for rehearing in the Paris Hilton greeting card case, *Hilton v. Hallmark Cards* in 2010.[8]

The Honey Badger greeting cards were "expressive works protected under the First Amendment" because they were intended to "convey a particularized message."

However, with respect to the artistic relevance question, the Ninth Circuit reasoned that the issue was not whether the use of the mark is relevant to the rest of the work, but rather "whether the mark is relevant to the Defendants' own artistry."

As the Ninth Circuit concluded in that case, the jury could easily find that defendants had used the Honey Badger catchphrase to capitalize on the goodwill established in this mark "without adding any creativity of their own."

This takes us back to the question of whether or not a dog chew toy can be an expressive work.

The Ninth Circuit found that VIP's use of the Jack Daniel's mark for its product was both humorous and a medium — although an unusual one — through which it conveyed a new and different message. It therefore found that it was an expressive work, setting the stage for the Rogers test.

In its recent brief to the high court, Jack Daniel's challenges this finding:

If the Bad Spaniels dog toy is an "expressive work" that receives special First Amendment protection from infringement liability, and VIP's use of Jack Daniel's marks and trade dress to sell dog toys is "noncommercial," the Lanham Act is virtually useless.

The Supreme Court is certainly not bound by the Ninth Circuit's decision and may not be persuaded by its reasoning, and may come to a wholly different conclusion.

Ultimately, the court may use the case as an opportunity to more clearly define what constitutes an expressive work, as opposed to a purely commercial product, and it may do so in a way that will shape future trademark, copyright and right of publicity cases.

The essential question before the Supreme Court is simple: What is, and what is not, an expressive work?

What Message is Conveyed?

In 1994, the Supreme Court ruled in *Campbell v. Acuff-Rose Music Inc.* that rap group 2 Live Crew did not violate copyright law with its song "Pretty Woman," based on Roy Orbison's "Oh, Pretty Woman." [9]

The new song, according to the court, was an expressive work that communicated urban commentary. It was also a parody of the earlier work, rather than a satire. Justice David Souter elaborated:

Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim's (or collective victims') imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing.

Parody, if done correctly, imparts a new message or commentary while making fun of an existing trademark, copyright or celebrity, in a right of publicity case. It is thus protected under the First Amendment.

It need not even be in good taste to be considered fair use, as evidenced by the numerous songs parodied in MAD Magazine over many years,[10] or it could communicate pure political commentary, as evidenced by musical compositions performed by the comedy troupe the Capitol Steps.

The key questions in such cases are as follows:

- Does the secondary work add a new message or a different meaning? See, for example, the California jury instruction addressing the First Amendment defense in a right of publicity context.[11]
- Is the secondary work really poking fun at the original work, or just trading off of the fame of the original work?

Is the Bad Spaniels chew toy merely a commercial product trading off of the trademark and fame of Jack Daniel's products? Or, to frame it somewhat differently, is the Bad Spaniels chew toy actually a parody of the Jack Daniel's whiskey bottle?

Does it use the Jack Daniel's trademark and trade dress to comment on something different? The humor — changing Jack Daniel's well-known "No. 7" to the more scatological "No. 2," for example — is decidedly lowbrow, but should that disqualify the product from protection if, in fact, the joke is on Jack Daniel's?

In a case with very similar facts, *Louis Vuitton Malletier SA v. Haute Diggy Dog LLC* in 2007, the U.S. Court of Appeals for the Fourth Circuit held that dog toys in the shape of Louis Vuitton handbags marketed as "Chewy Vuitton" were successful parodies.[12]

When a new work makes fun of an existing trademark, copyright or celebrity to comment on something else — other than the original work itself — it is deemed to be satire, not protected parody, and not subject to First Amendment protection.

Thus, a commentary in the form of a poem that retold the facts of the O.J. Simpson murder trial in the style of Dr. Seuss was found by the Ninth Circuit in *Dr. Seuss Enterprises LP v. Penguin Books USA Inc.* in 1997 not subject to protection under the First Amendment.[13]

Is Rogers Still the Test?

In its opening brief, Jack Daniel's challenges the merits and validity of the Rogers test.

According to its brief, "Rogers' test privileges infringers' speech over mark owners' own expressive speech and allows courts to invent all kinds of speech-based distinctions."

The brief goes on to argue, "Rogers invites consumer confusion because infringers can cast any humorous knock-off (apart from a true counterfeit) as 'artistically relevant' and not 'explicitly misleading.'"

VIP Products, in its prior brief opposing certiorari,[14] noted the absence of inter-circuit conflict on the Rogers test and questioned Jack Daniel's motives in challenging the test:

Every circuit that has addressed the issue has adopted the Rogers test to reconcile trademark rights with First Amendment rights. No other circuit has held that the Rogers test does not apply to products like VIP's parody dog toy. The Ninth Circuit did not perceive that it was creating or perpetuating a circuit conflict, and no other circuit has recognized a conflict or criticized the Ninth Circuit's ruling.

If there truly is no conflict between the circuits, and given that all circuits have essentially followed the Rogers test, why has the Supreme Court now agreed to hear the case, after initially denying certiorari?

Given the challenges inherent in delineating expressive works from commercial products, the court may finally be ready to provide much needed guidance for future cases. We will soon find out.

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[1] Jack Daniel's Properties Inc. v. VIP Products LLC, case number 22-148.

[2] <https://www.scotusblog.com/case-files/cases/jack-daniels-properties-inc-v-vip-products-llc-2/>.

[3] <https://assets.law360news.com/1564000/1564945/brief.pdf>.

[4] VIP Products LLC v. Jack Daniel's Properties Inc., No. 18-16012 (9th Cir. 2020).

[5] Rogers v. Grimaldi, 875 F. 2d 994 (2d Cir. 1989).

[6] Mattel, Inc. v MCA Records 296 F.3d 894 (9th Cir. 2002).

[7] Gordon v. Drape Creative, 909 F.3d 257 (9th Cir. 2018).

[8] Hilton v Hallmark Cards, 599 F.3d 894 (9th Cir. 2010).

[9] Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994).

[10] <https://www.madmagazine.com/blog/2012/12/07/totally-mad-excerpt-has-mad-ever-been-sued>.

[11] California Civil Jury Instructions (CACI) (2022) 1805. Affirmative Defense to Use or Appropriation of Name or Likeness, <https://www.justia.com/trials-litigation/docs/caci/1800/1805/>.

[12] Louis Vuitton Malletier S.A. v. Haute Diggy Dog, LLC, 507 F.3d 252 (4th Cir. 2007).

[13] Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc. 109 F.3d 1394 9th Circuit. 1997.

[14] https://www.supremecourt.gov/DocketPDF/22/22-148/243298/20221017173555298_22-148_Brief.pdf.