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PERSPECTIVE

Is *Rogers v. Grimaldi* dead? No! but ...

By Bruce Isaacs

On June 8, the unanimous United States Supreme Court issued its opinion in the Jack Daniel's dog chew-toy parody case, *Jack Daniel's Properties, Inc. v. VIP Products LLC.* The Court did not eviscerate the artistic relevancy test of *Rogers v. Grimaldi* (the "Rogers Test"), but it did create a bright line test – a bright line test with some important nuances still remaining.

The U.S. Supreme Court was emphatically clear that where an alleged trademark infringer (or trademark diluter) makes use of the trademark of another in a primary trademark function, i.e., as a source identifying use to identify or distinguish its goods, then the Rogers Test is not the proper inquiry. In other words, the Ninth Circuit's formulation, where it reached the Rogers Test first as a threshold inquiry [(1) Does the use have no artistic relevancy? (2) Does the use explicitly mislead consumers?] is not the correct analysis. Rather, if the alleged infringer uses the trademark in a source-identifying fashion, then the Rogers Test does not apply at all and, instead, the courts are to proceed straight to the likelihood of confusion analysis which, in-and-of-itself, has the notion of parody baked into that analysis (more on that below).

So, if the infringer's use is not a primary trademark use as a commercial product to identify or distinguish source, and is instead used as a purely expressive work, does the Rogers Test still apply? The answer to that question, based on the U.S. Supreme Court's recent decision, is either "yes, for sure" or "yes, but maybe." In her opinion, Justice Kagan discussed purely expressive works, like the song parody about Barbie dolls in *Mattel, Inc. v. MCA Records, Inc.*, like the artwork of Crimson Tide football uniforms to memorialize football history in *University of Ala. Bd. of Trustees v. New Life Art, Inc.* or like in the movie "The Hangover: Part II" in its use of the Louis Vuitton luggage in *Louis Vuitton Mallatier S. A. v. Warner Bros.* Entertainment Inc., and reasoned that where the trademarks are not used to designate source, the Rogers Test would still apply. In particular, in such instances of purely expressive works, like a song, like art or like a movie, the likelihood of confusion concerns, designed to protect both consumers and the producers of goods and owners of brands, were not themselves in danger and therefore First Amendment concerns would, and should, prevail.

However, at the same time, in her opinion Justice Kagan also stated as follows:

" … There is no threshold test working to kick out all cases involving 'expressive works'." What exactly does Justice Kagan mean by this statement? Is Justice Kagan suggesting there is no longer a threshold test based on the Rogers Test to kick out purely expressive works? Her meaning is not entirely clear. Justice Kagan does clarify, however, that if an infringer's use is a source identifying use together with some expressive elements to it, such use still does not invoke the Rogers Test.

Rather, in instances where an infringer's use is a combination of source identifying use plus expressive elements, the Rogers Test does not apply. Instead, the traditional likelihood of confusion test would apply because, according to Kagan, the notion of parody is already built into the likelihood of confusion test. As Kagan reasons, a parody must conjure up the original, but, at the same time, a parody must also create contrasts in order to be effective in delivering a new, different or humorous message or to provide commentary. This contrast is then taken into consideration when applying the likelihood of confusion test and if this inherent contrast in a parody is itself enough to create meaningful distinguishing features, then those distinctions may (or may not) be sufficient to negate a finding of a likelihood of confusion. But at least, according to Justice Kagan, the expressive aspects of the trademark use are baked into the likelihood of confusion analysis.

As to dilution, there is an exception to liability for use of a famous mark where the use is "non-commercial" or where the use constitutes fair use. But the exception itself has an exception. If the use is, once again, a source identifying use, then liability for dilution will still attach. Thus, the dilution analysis mirrors the above analysis, where a parody, if used in a source identifying manner, is not a non-commercial use and is not a fair use. In such a context, the Rogers Test cannot "save the day" for the purposes of a dilution claim.

In her concurring opinion, Justice Sotomayor stated that survey evidence should be viewed with caution. Given that, now, the Rogers Test will not arise in instances of source identifying use, and that the likelihood of confusion test shall determine the outcome, Justice Sotomayor stated her concern that survey respondents would most likely assume that parodies require permission from the trademark owners (they do not) and that such an assumption might skew survey results in favor of the trademark owner, especially if clever surveys were designed to promote such a result. In his concurring opinion, Justice Gorsuch urged the district courts to apply the Rogers Test with "care" because he is not even clear as to the original origins or basis for the Rogers Test, an issue to be resolved on "another day."

In sum, in this dog chew-toy parody case, the Supreme Court has ruled, clearly, that if the use at issue is a commercial product used to identify or designate source, then the Rogers Test is dead. At the same time, if the use at issue is a commercial product used to identify or designate source + some expressive elements, the Rogers Test is still dead. If, however, the use at issue is a purely expressive use, the Rogers Test, as a threshold inquiry, is still alive – but it may be on "life support" because the line between a commercial product used to identify or designate source + some expressive elements, on the one hand, and a purely expressive use, on the other hand, is itself a less than clear line. Stay tuned.

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