

# UIC REVIEW OF INTELLECTUAL PROPERTY LAW



## A GOOD DAY TO BE A BAD SPANIEL: BROADENING THE APPLICATION OF THE *ROGERS* TEST

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Parodies are becoming increasingly popular to see in the world around us, from songs to dog toys. With parodies comes the importance of determining whether they are expressive works and thus protected by the First Amendment. Under the *Rogers* test from the seminal *Rogers v. Grimaldi* decision came a test to evaluate the trademark's artistic relevancy in the allegedly infringing work that also is against explicitly misleading uses of the trademark. Currently, there are three pronounced variations of the *Rogers* test used amongst the federal circuits. This note argues that the Ninth Circuit was correct in holding that the Bad Spaniels Silly Squeaker is an expressive work under the *Rogers* test, thus offering it First Amendment protection. This note places *VIP Products v. Jack Daniels* within the varying *Rogers* tests. Lastly, this note argues that the framework outlined in *VIP Products v. Jack Daniels* allows similar parodies to have the same First Amendment protection.



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A GOOD DAY TO BE A BAD SPANIEL: BROADENING THE  
APPLICATION OF THE *ROGERS* TEST

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I. INTRODUCTION

You walk into the store intending to purchase some Chardonnay when you stumble upon what appears to be an alcohol section for man’s best friend adorned with brands such as Pawtrón,<sup>1</sup> White Paw<sup>2</sup> and Wag-ernet<sup>3</sup>. Notwithstanding these parodically named products, have you ever contemplated the intersection of trademark law and the First Amendment? Jack Daniel’s certainly has.<sup>4</sup>

On March 31, 2020, Jack Daniel’s dog days ended when the Ninth Circuit ruled in favor of VIP Products LLC (“VIP”). The court held that VIP’s dog toy parody imitating Jack Daniel’s renowned Old. No. 7 bottle was an expressive work entitled to First Amendment protection and did not infringe on Jack Daniel’s trademark rights.<sup>5</sup> VIP’s toy replaced Old. No. 7 with Old No. 2 to parody Jack Daniel’s famous bottle.<sup>6</sup> The court determined that the “toy communicate[d] a ‘humorous message,’ using word play to alter the serious phrase[s] that appear[ed] on a Jack Daniel’s bottle.”<sup>7</sup>

The case of *VIP Products* represents the Ninth Circuit expanding upon what can be considered a vehicle for expression with respect to trademark rights. As the Ninth Circuit highlighted, “[A] work need not be the expressive equal of *Anna Karenina* or *Citizen Kane*” to be considered expressive;<sup>8</sup> nor is a work “rendered non-expressive simply because it is sold commercially.”<sup>9</sup> In so holding, the court ruled that Fido’s favorite toy is now an expressive work falling under the *Roger’s* test.<sup>10</sup> The

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\* © ORCID 0000-0002-7796-6394. Mikhaila Duvall, Juris Doctor Candidate, May 2023, UIC School of Law School; B.A. in Political Science, B.S. in Criminology, Loyola University of Chicago (2020). Thank you to my editor, Stephen Bartholomew, for all the help along the way and to the rest of the UIC School of Law Review of Intellectual Property Law editors and staff for their unwavering dedication to the journal. I would like to dedicate this article to my parents, friends, and mentors – thank you for providing me with the support and motivation that helped me achieve this accomplishment.

<sup>1</sup> Chewy, *Pet Shop by Fringe Studio Pawtron Tequila Plush Dog Toy*, CHEWY, <https://www.chewy.com/pet-shop-by-fringe-studio-pawtron/dp/332932> (last visited Sept. 22, 2021).

<sup>2</sup> Haute Diggity Dog, *White Paw – Bark Cherry*, HAUTE DIGGITY DOG, <https://www.hautediggitydog.com/products/white-paw-hound-seltzer> (last visited Sept. 22, 2021).

<sup>3</sup> Vanderpump Pets, *Vanderpup WAG-ERNET Sauvignon Wine Plush Toys*, VANDERPUMP PETS, <https://vanderpumppets.com/products/vanderpup-wag-ernet-sauvignon-wine-plush-toys> (last visited Sept. 22, 2021).

<sup>4</sup> *VIP Prods. LLC v. Jack Daniel's Prods.*, 953 F.3d 1170, 1172 (9th Cir. 2020). Jack Daniel’s argued that VIP’s “Bad Spaniel Silly Squeaker” violated their trademark Jack Daniel’s Old No.7 Black Label Tennessee Whiskey. *Id.* at 1172.

<sup>5</sup> *Id.* at 1175–76.

<sup>6</sup> *Id.* at 1172; see also Mydogtoy.com, *Silly Squeakers Liquor Bad Spaniels Dog Toy*, MYDOGTOY.COM, <https://mydogtoy.com/p/Silly-Squeaker-Liquor-Bottle-Bad-Spaniels> (last visited Sept. 29, 2021) (providing a picture of the Bad Spaniel’s Silly Squeaker).

<sup>7</sup> *Id.* at 1175 (quoting *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 268–69 (9th Cir. 2018)).

<sup>8</sup> *Id.*

<sup>9</sup> *VIP Prods. LLC*, 953 F.3d at 1175.

<sup>10</sup> *Id.*

*Rogers* test applies to what are traditionally thought of as expressive works, like books,<sup>11</sup> video games,<sup>12</sup> and songs.<sup>13</sup> This decision signals that the Ninth Circuit is taking a more expansive approach when considering what constitutes an expressive work, and perhaps becoming a stray dog in doing so.<sup>14</sup>

Part II of this note analyzes the protection of expressive works under the First Amendment as it applies to trademark law and the *Rogers* test's multiple applications. Part III takes an in-depth look at the case, *VIP Products LLC v. Jack Daniel's Properties, Inc.* Part IV evaluates the various *Rogers* test approaches, and places *VIP Products* within this landscape, and it will be argued that had *VIP Products* been decided under the likelihood of confusion test, the results would have been the same. And, finally, Part V concludes that the court was correct in holding the "Bad Spaniels Silly Squeaker" was an expressive work subject to the *Rogers* test as it did not infringe on Jack Daniel's trademark.<sup>15</sup> This case note argues that the Ninth Circuit struck the right balance between trademark rights and the public's freedom of expression, and in doing so opened the *Rogers* test to be applied to more avant-garde parodies.

## II. BACKGROUND

### A. General Principles of Trademark Law

A trademark is a word, name, or symbol used to identify and distinguish goods from those manufactured or sold by others.<sup>16</sup> The usage of trademarks allows

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<sup>11</sup> *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 (5th Cir. 1999) (stating that under unfair competition laws, the rights in book titles are rightfully afforded protection).

<sup>12</sup> *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*, 74 F. Supp. 3d 1134, 1140 (N.D. Cal. 2014). Video games merit First Amendment protection by communicating ideas through ever-advancing technology. *Id.*

<sup>13</sup> *Mattel, Inc. v. MCA Rec.*, 296 F.3d 894, 902 (9th Cir. 2002) (holding that MCA's song, "Barbie Girl," poking fun at Mattel's plastic dolls, was an expressive parody protected under the First Amendment).

<sup>14</sup> Mark Bartholomew & John Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*, 81 GEO. WASH. L. REV. 1, 41 (2013); see also David M. Kelly & Lynn M. Jordan, *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 99 TRADEMARK REP. 1360, 1363 (2009) (stating that courts traditionally have been reluctant to deviate from the likelihood-of-confusion analysis in the face of constitutional defenses).

<sup>15</sup> *VIP Prods. LLC*, 953 F.3d at 1172. VIP's usage of humorous messages on the Bad Spaniels Silly Squeaker resulted in it being an expressive work. *Id.*

<sup>16</sup> The Lanham Act, 15 U.S.C. § 1127(a) (2022). This section of the Lanham Act provides that a civil action could be filed by:

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

companies to effectively distinguish themselves in the marketplace and stream of commerce.<sup>17</sup> Utilizing a mark builds goodwill and brand recognition.<sup>18</sup> This, in turn, aids consumers identifying their preferred goods or services in the marketplace.<sup>19</sup>

The foundation for United States trademark law was established by the Lanham Act (“Act”), which defines federal trademark protection and outlines trademark registration rules.<sup>20</sup> The Act provides for a national system of trademark registration by protecting the owner of a federally registered mark.<sup>21</sup> The mark is protected against the use of similar marks if the use would likely create consumer confusion, or if the dilution of a famous mark is likely to occur.<sup>22</sup>

For a mark to be trademark eligible, two basic requirements must be met. First, an entity must use the mark in commerce, or register the mark with a bona fide intent to use the mark as a designation of source for its goods.<sup>23</sup> Second, the mark must be distinctive.<sup>24</sup> Distinctiveness addresses a trademark’s capacity to be identify and distinguish an entity’s goods from others.<sup>25</sup>

For trade dress to be protected, the individual asserting trade dress protection carries the burden of proof that the product is not functional.<sup>26</sup>

A feature will be considered functional and will not serve as a trademark if the feature is “essential to the use or purpose of the article or if it affects the cost or quality of the article.”<sup>27</sup> In order for a mark to be distinctive, the product with the marks must be distinguishable from the products of others.<sup>28</sup> Additionally, designation of origin allows for the mark be an identifiable source of a seller’s goods and distinguish that source from other sources.<sup>29</sup> If the designation does this, it will be considered distinctive.<sup>30</sup>

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<sup>17</sup> Top Tobacco, L.P. v. N. Atl. Operating Co., 509 F.3d 380, 381 (7th Cir. 2007).

<sup>18</sup> Premier Dental Prods. Co. v. Darby Dental Supply Co., 794 F.2d 850, 853 (3d Cir. 1986). The Third Circuit stated that “[a] trademark symbolizes the public’s confidence or ‘goodwill’ in a particular product.” *Id.*

<sup>19</sup> 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2.15 (5th ed. 2022) (“A trademark has no existence separate from the good will of the product or service it symbolizes. Good will and its tangible symbol, a trademark, are inseparable. Therefore, a trademark cannot be sold or assigned to another unless the associated goodwill is also sold.”).

<sup>20</sup> 15 U.S.C. § 1051 (2022).

<sup>21</sup> 15 U.S.C. § 1125(a) (2022).

<sup>22</sup> 15 U.S.C. §§ 1125(a), 1125(c) (2022).

<sup>23</sup> 15 U.S.C. § 1127 (2022).

<sup>24</sup> *Id.*

<sup>25</sup> 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 4:13 (5th ed. 2022).

<sup>26</sup> *Traffix Devices v. Mktg Displays*, 532 U.S. 23, 29 (2001).

<sup>27</sup> *Id.* at 33.

<sup>28</sup> 15 U.S.C. § 1052 (2022).

<sup>29</sup> *Inwood Labs. v. Ives Labs.*, 456 U.S. 844, 863 (1982).

<sup>30</sup> *Id.*

Sections 32(1)(a)-(b)<sup>31</sup> and 43(a)<sup>32</sup> of the Lanham Act<sup>33</sup> allow a trademark owner to bring a civil claim against an alleged infringer whose product may likely confuse or deceive consumers regarding the association, origin, or sponsorship of the product.<sup>34</sup> To state a trademark infringement claim, a plaintiff must prove three basic elements: 1) distinctiveness; 2) nonfunctionality; and 3) likelihood of confusion.<sup>35</sup> However, these elements can be articulated by courts in a variety of ways.<sup>36</sup> To be protected under § 2 of the Lanham Act, the mark must distinguish the applicants goods

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<sup>31</sup> 15 U.S.C. § 1114(1)(a)(b) (2022). This section of Lanham Act provides that a civil action could be filed by:

(1) Any person who shall, without the consent of the registrant—  
 (a) use in commerce any reproduction, . . . copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or  
 (b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

<sup>32</sup> 15 U.S.C. § 1125(a) (2022). This section of the Lanham Act provides that a civil action could be filed by:

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—  
 (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person[.]

<sup>33</sup> 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27:14 (5th ed. 2022). The Lanham Act permits a trademark infringement claim to either be brought for a registered trademark under 15 U.S.C. § 1114 or unregistered trademarks under 15 U.S.C. § 1125(a). *Id.*

<sup>34</sup> *Parks v. LaFace Records*, 329 F.3d 437, 445 (6th Cir. 2003).

<sup>35</sup> *Kendall-Jackson Winery, Ltd., v. E&J Gallo Winery*, 150 F.3d 1042, 1046–47 (9th Cir. 1998).

<sup>36</sup> *See Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1144 (9th Cir. 2011) (“[A] party must prove: (1) that it has a protectible ownership interest in the mark; and (2) that the defendant’s use of the mark is likely to cause consumer confusion.”); *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 152 (4th Cir. 2012):

[A] plaintiff must prove: (1) that it owns a valid mark; (2) that the defendant used the mark ‘in commerce’ and without plaintiff’s authorization; (3) that the defendant used the mark (or an imitation of it) “in connection with the sale, offering for sale, distribution, or advertising” of goods or services; and (4) that the defendant’s use of the mark is likely to confuse consumers.

from those of another.<sup>37</sup> The last element, likelihood of confusion, is the most important element.<sup>38</sup> Evidence of likelihood of confusion amongst consumers is convincing evidence that future confusion is likely.<sup>39</sup>

### B. Protection of Expressive Works Under the First Amendment

The First Amendment of the Constitution states “Congress shall make no law . . . abridging the freedom of speech, or of the press.”<sup>40</sup> The First Amendment can be an affirmative defense when an expressive work has allegedly infringed a trademark.<sup>41</sup>

A parody is a common form of an expressive work that is a “distorted imitation of a person, group, practice or other idea, that is intended to mock the person or thing imitated.”<sup>42</sup> A parody must convey two “simultaneous—and contradictory—messages.<sup>43</sup> To not violate trademark law, the parody needs to convey that it is the original, but at the same is not the original, and rather is a parody.<sup>44</sup>

In determining whether a work is expressive, courts analyze whether the work is “communicating ideas or expressive points of view.”<sup>45</sup> A work will not be rendered non-expressive because it is commercially sold.<sup>46</sup> For example, in *Louis Vuitton SA v. Haute Diggity Dog LLC*, the Fourth Circuit ruled that Chewy Vuiton, a dog toy brand parodying Louis Vuitton’s trade dress did not infringe on Louis Vuitton’s trademark.<sup>47</sup>

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<sup>37</sup> 15 U.S.C § 1052 (2022). This section of the Lanham Act provides background on trademarks registerable on the principal register.

<sup>38</sup> In *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979), the Ninth Circuit said:

In determining whether confusion between related goods is likely, the following factors are relevant: 1. strength of the mark; 2. proximity of the goods; 3. similarity of the marks; 4. evidence of actual confusion; 5. marketing channels used; 6. type of goods and the degree of care likely to be exercised by the purchaser; 7. defendant’s intent in selecting the mark; and 8. likelihood of expansion of the product lines.

*Id.* at 348–49.

<sup>39</sup> *Fuddrucker, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 845 (9th Cir. 1987).

<sup>40</sup> U.S. CONST. amend. I.

<sup>41</sup> *Univ. of Ala. Bd. Of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1281 (11th Cir. 2012) (discussing how the Defendant was permitted to raise First Amendment affirmative defense in relation to the University football player’s images he had taken and used to create forms of artistic expression).

<sup>42</sup> *Parody*, THE WOLTERS KLUWER BOUVIER LAW DICTIONARY (Desk ed. 2012); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580 (1994) (“[At] the heart of a parodist’s claim . . . is the use of some elements of a prior author’s composition to create a new one that . . . comments on the author’s work.”).

<sup>43</sup> *World Wrestling Fed’n. Ent., Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413, 431 (W.D. Pa. 2003).

<sup>44</sup> *Nike, Inc. v. Just Did It Enters.*, 6 F.3d 1225, 1228 (7th Cir. 1993).

<sup>45</sup> *L.L. Bean, Inc. v. Drake Publs. Inc.*, 811 F.2d 26, 29 (1st Cir. 1987) (denying parodists the opportunity to poke fun at things that are woven into the fabric of daily life “constitutes a serious curtailment of a protected form of expression.”). *Id.* at 34.

<sup>46</sup> *Mattel, Inc. v. MCA Rec.*, 296 F.3d 894, 905 (9th Cir. 2002).

<sup>47</sup> *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 269–70 (4th Cir. 2007) (“Haute Diggity Dog’s ‘Chewy Vuiton’ dog toys . . . loosely resemble miniature handbags and . . . evoke LVM handbags . . . [I]n lieu of the LV mark, [the dog toy] uses ‘CV’; and the other symbols and colors employed are imitations, but not exact ones, of those used in the LVM Multicolor and Cherry designs.”). *Id.* at 258.

In doing so, the court utilized the likelihood of confusion test.<sup>48</sup> The Fourth Circuit stated that the association between Haute Diggity Dog's ("HDD") marks and Louis Vuitton's marks are not likely to impair the distinctiveness of Louis Vuitton's marks.<sup>49</sup> It was evident that HDD created an association between its marks and Louis Vuitton's marks, but HDD made it clear that there was no actual association between the marks because of the parody's operation and effect.<sup>50</sup>

### C. *The Rogers Test and its Three Variations*

*Rogers v. Grimaldi* was an influential case from the Second Circuit in 1989 that created the *Rogers* test for expressive works.<sup>51</sup> In *Rogers*, the plaintiff, Ginger Rogers brought claims under the Lanham Act against Grimaldi, an Italian producer, for creating a movie entitled "Ginger and Fred."<sup>52</sup> The movie centered around two cabaret dancers who became famous in Italy for imitating Ginger Rogers and Fred Astaire.<sup>53</sup> Given the fact that Rogers and Astaire were world-renowned at the time of the movie's creations, Rogers claimed the movie title would mislead consumers to believe she either sponsored or endorsed it.<sup>54</sup> The district court ruled in favor of Grimaldi, finding the title was an artistic expression deserving full First Amendment protection.<sup>55</sup> The Second Circuit created the *Rogers* test after finding the district court's decision "unduly narrow[ed] the scope of the act" by "creat[ing] a nearly absolute privilege."<sup>56</sup>

The *Rogers* test established a two-prong test for cases of alleged trademark infringement by an artistic work under the Lanham Act. The test looks to whether the "public interest in avoiding consumer confusion outweighs the public interest in free expression."<sup>57</sup> The *Rogers* test will apply if: 1) the "title has no artistic relevance to the underlying work whatsoever"; or 2) "the title explicitly misleads as to the source or content of the work."<sup>58</sup> The Second Circuit even mentioned when a title explicitly misleads consumers, even in a minimally artistic capacity, will not receive First Amendment protection.<sup>59</sup>

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<sup>48</sup> *Id.* at 266.

<sup>49</sup> *Id.* at 267.

<sup>50</sup> *Id.* at 268.

<sup>51</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989).

<sup>52</sup> *Id.* at 996.

<sup>53</sup> *Id.* at 996–97.

<sup>54</sup> *Id.* at 997 ("In opposition to the motion, Rogers submitted a market research survey purporting to establish that the title "Ginger and Fred" misled potential movie viewers as to Rogers' connection with the film."). *Id.*

<sup>55</sup> *Id.* (discussing that because the speech at issue was not primarily intended to serve a commercial purpose, the Lanham Act prohibitions do not apply).

<sup>56</sup> *Rogers*, 875 F.2d at 997.

<sup>57</sup> *Id.* at 999. There will be no application of the *Rogers* test if the title has "no artistic relevance to the underlying work whatsoever." *Id.*

<sup>58</sup> *Id.* The court in this case explained that a misleading title with no artistic relevance cannot be sufficiently justified by a free expression of interest. *Id.*

<sup>59</sup> *Id.* at 1000. The court described its new test as one that "insulates from restriction titles with at least minimal artistic relevance that are ambiguous or only implicitly misleading but leaves vulnerable to claims of deception titles that are explicitly misleading as to source or content . . ." *Id.*



The Second Circuit applied the two-prong test and found “Ginger and Fred” to be a relevant aspect of the movie’s underlying plot, and since Rogers never explicitly endorsed the movie, the court ruled in the defendant’s favor.<sup>60</sup> The movie title as artistically relevant to the work given the juxtaposition that Grimaldi was seeking to expose.<sup>61</sup> To the extent that there was a risk of confusion as to what the work was about, that risk was outweighed by the danger that suppressing the artistically relevant yet ambiguous title would overly restrict expression.<sup>62</sup>

In the years since the creation of the *Rogers* test, it has been used to cover a wider range of trademarks than when it was first implemented.<sup>63</sup> With that, the courts have been flexible with the *Rogers* test “has yet to find its bearings” in the wider application of its use.<sup>64</sup> This expansion has resulted in three pivotal *Rogers* test variations gaining traction amongst the circuit courts.<sup>65</sup> Determining which of the variations applies turns on the amount of First Amendment protection that each circuit affords to the defendant.

Out of the *Rogers* test variations applied across the courts arose three distinct applications of the *Rogers* test, each offering varying levels of protection to speech.<sup>66</sup> *Rogers I* “more or less automatically protects expressive works” with the plaintiff needing to be able to demonstrate that the defendant made an “‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement.’”<sup>67</sup> For courts to offer protection under the First Amendment, the title of the work must explicitly mislead as to the “source or the content of the work.”<sup>68</sup> There must be evidence relating to the behavior of the identifying material’s user, not the impact of the use.<sup>69</sup>

In *Brown v. Electronic Arts, Inc.*, Electric Arts (“EA”) used Jim Brown, one of the most recognizable football players of all time, in several versions of the *Madden*

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<sup>60</sup> *Id.* at 1004. Movie titles may not utilize a celebrity’s name unless the title is “wholly unrelated” to the movie or was “. . . a disguised commercial advertisement for the sale of goods or services.” *Id.*

<sup>61</sup> *Rogers*, 875 F.2d at 1000.

<sup>62</sup> *Id.* at 1001.

<sup>63</sup> Thomas M. Byron, *Spelling Confusion: Implications of the Ninth Circuit’s View of the ‘Explicitly Misleading’ Prong of the Rogers Test*, 19 J. INTEL. PROP. L. 1, 9 (2011).

<sup>64</sup> *Id.*

<sup>65</sup> See *VIRAG, S.R.L. v. Sony Comput. Entm’t. Am. LLC*, 699 F. App’x 667, 668 (9th Cir. 2017) (The Ninth Circuit utilized *Rogers I* where it held that Sony’s usage of VRAG’s mark did not constitute a violation under the Lanham Act); see *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 778 (8th Cir. 1994) (The Eighth Circuit used *Rogers II* when ruling that Balducci’s parody of Anheuser-Busch’s Michelob beer was not protected under the First Amendment); see *Dr. Seuss Enter., L.P. v. ComicMix LLC*, 983 F.3d 443, 463 (9th Cir. 2020) (The Ninth Circuit used *Rogers III* where it held that ComicMix’s usage of Dr. Seuss’ marks in its book did not explicitly mislead as to its source).

<sup>66</sup> William K. Ford, *Restoring Rogers: Video Games, False Association Claims, and the ‘Explicitly Misleading’ Use of Trademarks*, 16 J. MARSHALL REV. INTEL. PROP. L. 306, 310 (2017). “*Rogers* comes in three versions, which [are] refer[red] to as *Rogers I*, *Rogers II*, and *Rogers III*.” *Id.*

<sup>67</sup> *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013) (stating that when First Amendment rights are of utmost importance, the *Rogers* test will apply).

<sup>68</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (stating how the Lanham Act should apply to artistic works only when the public interest in free expression is outweighed by avoiding consumer confusion as to a misleading product).

<sup>69</sup> *Elec. Arts*, 724 F.3d at 1246. The Ninth Circuit held that Brown was unable to provide evidence of EA utilizing statements from Brown to mislead consumers into thinking he sponsored or endorsed the video game.

*NFL* video games, but Brown never gave permission for his image to be used by EA.<sup>70</sup> The Ninth Circuit held that EA’s video game was an expressive work protected under the First Amendment and there were no facts demonstrating EA explicitly misled consumers by using Jim Brown’s image.<sup>71</sup> Moreover, there was no “explicit indication, overt claim, or explicit misstatement” as to the usage of Brown’s likeness that would confuse consumers.<sup>72</sup>

*Rogers II* can afford the defendant moderate protection under the First Amendment.<sup>73</sup> The Second Circuit clarified that the *Rogers* test is applicable when “expression, and not commercial exploitation of another’s trademark, is the primary intent.”<sup>74</sup> A plaintiff must make a “particularly compelling” showing of a likelihood of confusion to overcome the *Rogers* defense.<sup>75</sup> The question then becomes whether the title is misleading in a manner that induces the public to believe the product was otherwise authorized by the plaintiff.<sup>76</sup> The determination of likelihood of confusion must be compelling in a manner that outweighs First Amendment interests.<sup>77</sup>

In *Twin Peaks Productions, Inc. v. Publications International, Ltd.*, defendants created a detailed book based on the first eight episodes of television show *Twin Peaks*.<sup>78</sup> In the book, defendant noted that it was not associated with *Twin Peaks* or their affiliates.<sup>79</sup> The Second Circuit held that the book infringed on *Twin Peak*’s fictional work, thus constituting a synopsis that served no legitimate purpose and negatively impacted *Twin Peak*’s potential market for a similar product.<sup>80</sup>

*Rogers III* affords plaintiffs “no special protection” under the First Amendment.<sup>81</sup> The plaintiff merely needs to show a likelihood of confusion to overcome

<sup>70</sup> *Id.* at 1240. The *Madden NFL* series allows game users to control avatars that represent professional football players in simulated football games. *Id.*

<sup>71</sup> *Id.* at 1246. The court elaborated that under *Rogers I*, § 43(a) of the Lanham Act will not be applied to expressive works unless the use of trademark or other identifying material explicitly misleads as to the source or the content of the work. *Id.*

<sup>72</sup> *Id.* at 1245 (quoting *Rogers*, 875 F.3d at 1001).

<sup>73</sup> See *Cliff Notes, Inc. v. Bantam Doubleday Dell Pub. Group*, 886 F.2d 490, 493–95 (2d Cir. 1989). Under this approach, the court first considers the likelihood of confusion factors before balancing the extent of the confusion with the First Amendment. *Id.* at 495.

<sup>74</sup> *Id.* at 495.

<sup>75</sup> *Simon & Schuster v. Dove Audio*, 936 F. Supp. 156, 164 (S.D.N.Y. 1996) (arguing that the likelihood of confusion must be particularly compelling to outweigh the First Amendment interest established in *Rogers*).

<sup>76</sup> *Twin Peaks Prods. v. Publ’n Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (stating that the question turns on whether the title product is misleading in the sense that it induces the public to believe the product was prepared or authorized by the trademark owner).

<sup>77</sup> *Id.* at 1379.

<sup>78</sup> *Id.* at 1370.

<sup>79</sup> *Id.* at 1379 (explaining that literary titles do not violate the Lanham act unless the title has no artistic relevance to the underlying work or the artistic relevance is used in a way to explicitly mislead as to the source of the work.); see also *American Dairy Queen Corp. v. New Line Prods.*, 35 F. Supp. 2d 727, 735 (D. Minn. 1998) (holding that New Line’s documentary “Dairy Queens” documentary title would likely cause consumer confusion. Dairy Queen’s strong, distinctive, and recognizable mark meant the documentary title would likely cause consumer confusion. The balance between the public’s interest in avoiding consumer confusion and trademark dilution outweighed New Line’s First Amendment interests).

<sup>80</sup> *Id.* at 1378 (concluding that “a substantial number of . . . purchasers, on seeing the name *Twin Peaks* as part of the title of the Book, would . . . believe that plaintiff was the source of the goods.”).

<sup>81</sup> Ford, *supra* note 66, at 310.

the *Rogers* defense.<sup>82</sup> When applying the second prong of the *Rogers* test, the relevant question becomes whether the product would confuse the public into thinking that the plaintiff was involved in the creation of the defendant's product or sponsored the product.<sup>83</sup> The court's utilizing this *Rogers* test variation have rendered it nothing but another likelihood of confusion test.

In *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, Rock Star created the video game, *Grand Theft Auto* that mimicked parts of California, including ESS's club.<sup>84</sup> Rockstar utilized a logo similar to the defendant's logo and changed it from "the Play Pen" to "the Pig Pen" without obtaining authorization from the defendants.<sup>85</sup> The court held that the modification of ESS's label was not explicitly misleading, and thus protected under the First Amendment.<sup>86</sup> In its holding, the court stated that the game is not about E.S.S.'s club and that the club is not recognizable enough to constitute a Lanham Act violation.<sup>87</sup>

### III. VIP PRODUCTS LLC v. JACK DANIEL'S PROPERTIES, INC. (2020)

#### A. Facts of VIP Products

VIP designed and sold "Silly Squeaker" dog toys that resembled various bottles of familiar beverages, but with dog-related changes.<sup>88</sup> In 2013, VIP sold the "Bad Spaniels Silly Squeaker", which attempted to humorize a Jack Daniel's Old No. 7 Black Label Tennessee Whiskey bottle.<sup>89</sup> The toy has multiple humorous pooch parodies. For instance, "43% POO BY VOL. 100% SMELLY"<sup>90</sup> replaces "40% Alc. by Vol. (80 Proof)."<sup>91</sup> A tag attached to the dog toy states the "product is not affiliated with Jack Daniel Distillery."<sup>92</sup> In 2014, Jack Daniel's demanded that VIP cease selling the "Bad

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<sup>82</sup> *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008).

<sup>83</sup> *Id.* (stating that the mere use of a trademark alone cannot suffice to make its use explicitly misleading).

<sup>84</sup> *Id.* at 1096. The Lead Map Artist stated he "did not seek to re-create a realistic Los Angeles; rather he created 'Los Santos,' a functional city that parodied the . . . places of Los Angeles." *Id.*

<sup>85</sup> *Id.* at 1097.

<sup>86</sup> *Id.* at 1101. There is nothing to indicate that "the buying public [*Grand Theft* players] would reasonably have believed that E.S.S. produced the video game, or for that matter Rock Star operated a strip club." *Id.* at 1100.

<sup>87</sup> *E.S.S. Ent. 2000, Inc.*, 547 F.3d at 1100-01. "A reasonable consumer would not think a company that owns one strip club in East Los Angeles, which is not well known to the public at large, also produces a technologically sophisticated video game like *San Andreas*." *Id.*

<sup>88</sup> *VIP Prods. LLC v. Jack Daniel's Props.*, 953 F.3d 1170, 1172 (9th Cir. 2020). Silly Squeaker resembles a Mountain Dew bottle but is labeled "Mountain Drool." *Id.*

<sup>89</sup> *Id.* VIP's goal in creating the Silly Squeaker was to "reflect on the humanization of the dog in our lives," and to comment on "corporations [that] take themselves very seriously." *Id.*

<sup>90</sup> *Id.* Another notable difference includes "the Old No. 2, on your Tennessee Carpet" as opposed to "Old No. 7 Brand Tennessee Sour Mash Whiskey." *Id.*

<sup>91</sup> Jack Daniel's, *Make it Count*, JACK DANIELS, <https://www.jackdaniels.com/en-us/whiskey/old-no-7> (last visited Sept. 20, 2021) (stating that Jack Daniel's Tennessee Whisky has borne the JACK DANIEL'S and OLD NO. 7 trademarks since its creation in 1875, except for during prohibition).

<sup>92</sup> *VIP Prods. LLC*, 953 F.3d at 1172.

Spaniels Silly Squeaker” and alleged that the toy infringed on their trademark rights, trade dress, and bottle design.<sup>93</sup>

### B. Procedural History

Between October 2, 2017, and October 6, 2017, the District Court of Arizona held a bench trial to decide whether VIP had violated Jack Daniel’s trademark, trade dress, and bottle design in a manner that would cause confusion amongst consumers.<sup>94</sup> After trial, the court granted Jack Daniel’s motion for summary judgement, finding VIP violated Jack Daniel’s trademark and trade dress in a manner that did not entitle them to the First Amendment defense.<sup>95</sup>

The district court rejected VIP’s fair use defense because under the *Sleekcraft* likelihood of confusion factors, there was a likelihood of confusion.<sup>96</sup> Jack Daniel’s survey established that 29% of tested consumers thought Jack Daniel’s either put out the toy or authorized the toy, thus demonstrating actual confusion.<sup>97</sup> Additionally, the court stated that VIP’s disclaimer on its packaging was not sufficient to disprove similarity.<sup>98</sup> Lastly, because Jack Daniel’s whiskey sales exceeded seventy-five million bottles between 1997 and 2015, the strength of their mark being used on noncompetitive products would cause confusion.<sup>99</sup> Because of this, the district court ordered VIP to cease production of the Bad Spaniels toy so as not to cause continued confusion amongst consumers.<sup>100</sup>

### C. The Holding of the Court

The Ninth Circuit vacated the judgment after trial on the issue of infringement and remanded for further proceedings while vacating the permanent injunction against VIP.<sup>101</sup> The permanent injunction, entered by the district court, prohibited VIP from continuing to sell the Bad Spaniels toy.<sup>102</sup>

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<sup>93</sup> *Id.* VIP responded to the demand by bringing a declaratory judgment against Jack Daniel’s. *Id.*

<sup>94</sup> *VIP Prods. LLC v. Jack Daniel’s Prods.*, 291 F. Supp. 3d 891, 897 (D. Ariz. 2018).

<sup>95</sup> *Id.* at 899 (reasoning that because were valid and famous before the Bad Spaniel’s toy was created and sold that the accused use is likely to cause negative associations that harms Jack Daniel’s reputation).

<sup>96</sup> *Id.* at 899 (holding that Jack Daniel’s trade dress and bottle design are distinctive, not generic, and are nonfunctional).

<sup>97</sup> *Id.* at 908 (stating that Jack Daniel’s survey result that 29% of potential consumers would be confused is nearly double the threshold to show infringement).

<sup>98</sup> *Id.* at 909. “Various retailers that sell Jack Daniel’s licensed merchandise also sell VIP’s “Bad Spaniels” product including Walmart, Amazon.com, and “Boozingear.com” sold both Jack Daniel’s and the Bad Spaniel’s toy.” *Id.*

<sup>99</sup> *VIP Prods. LLC*, 291 F. Supp. 3d at 909 (noting that Jack Daniel’s internal records show consumer awareness of the Jack Daniel’s brand to be around 98%).

<sup>100</sup> *Id.* at 911. The district court based its reasoning to order VIP to cease selling the Bad Spaniel’s toy on the “strong possibility” that VIP may expand into the alcohol industry. *Id.*

<sup>101</sup> *VIP Prods. LLC v. Jack Daniel’s Prods.*, 953 F.3d 1170, 1175–76 (9th Cir. 2020) (directing the district court to apply the *Rogers* test after determining that Bad Spaniels is an expressive work afforded First Amendment protection).

<sup>102</sup> *VIP Prods. LLC v. Jack Daniel’s Prods.*, No. CV-14-02057-PHX-SMM, 2021 U.S. Dist. LEXIS 232410, at \*6 (D. Ariz. Oct. 8, 2021).

Regarding the issue of aesthetic functionality and distinctiveness, the court maintained that, despite many individual elements of Jack Daniel's being used by other whiskey companies, the combination of bottle and label elements are nonfunctional and distinctive.<sup>103</sup> Because of this, VIP was able to use Jack Daniel's bottle and label elements on their toy.<sup>104</sup>

The court based its rationale for affirming the rejection of VIP's request for cancellation of Jack Daniel's registered mark on the basis that the bottle design is distinctive and nonfunctional.<sup>105</sup> The evidence VIP presented failed to demonstrate that the elements, when taken together, were functional or distinctive.<sup>106</sup>

Regarding VIP's First Amendment protections, the court stated the likelihood of confusion test was improper because artistic expression was at issue.<sup>107</sup> The likelihood of confusion test fails to consider the full weight of the public's interest in free expression.<sup>108</sup>

The Ninth Circuit determined that the toy communicated a "humorous message" through its word play that altered the serious phrasing on Jack Daniel's bottles, thus qualifying as an expressive work.<sup>109</sup> Bad Spaniels made an effort to create a transformative work with "new expression, meaning or message."<sup>110</sup> The fact that VIP chose to poke fun at the seriousness that Jack Daniel's tried to present is irrelevant.<sup>111</sup>

Concerning the infringement claim, the court strayed from using the likelihood of confusion test.<sup>112</sup> Rather, the court signaled to the district court that on remand, it should apply the *Rogers* test because VIP is able to establish at least one of the two prongs.<sup>113</sup> The Ninth Circuit laid the ground work for the district court to apply the

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<sup>103</sup> *VIP Prods. LLC*, 953 F.3d at 1173–74.

<sup>104</sup> *Id.*

<sup>105</sup> *Id.* (stating that plaintiff in an infringement case regarding a registered trademark is given the presumptive advantage on the issue of validity, thus shifting the burden to the defendant).

<sup>106</sup> *Id.* at 1174.

<sup>107</sup> *Id.* (quoting *Mattel, Inc. v. MCA Rec.*, 296 F.3d 894, 900 (9th Cir. 2002)) (explaining that *Mattel, Inc.* extended the *Rogers* test beyond a title).

<sup>108</sup> *VIP Prods. LLC*, 953 F.3d at 1174.

<sup>109</sup> *Id.* at 1175 (quoting *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 268–69 (9th Cir. 2018)). In *Gordon*, the Ninth Circuit determined that greeting cards which combined the trademarked phrases "Honey Badger Don't Care" and "Honey Badger Don't Give s - -" with event announcements such as Halloween or a birthday were expressive works entitled to First Amendment protection. The greeting cards used the juxtaposition of an event with honey badger's aggressive assertion of apathy to convey a humorous message.

<sup>110</sup> *Id.* at 1175 (quoting *Dr. Seuss Enter. L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997)) (holding that Penguin's usage of Dr. Seuss' trademarks and copyrights infringed upon the trademarks and copyrights, thus violating the Lanham Act).

<sup>111</sup> *Id.*

<sup>112</sup> *Id.* at 1174 (explaining that likelihood of confusion test seeks to strike a balance between the First Amendment and trademark rights and requires the plaintiff have a valid, protectable trademark and defendant's use of the mark is likely to cause confusion).

<sup>113</sup> *VIP Prods. LLC*, 953 F.3d at 1174 (stating that the Lanham Act will only apply to expressive works if the plaintiff is able to establish one of two prongs of the *Rogers* test).

*Rogers* test by determining Bad Spaniels was an expressive work that conveyed a humorous message by commenting on the elements Jack Daniel’s tried to enforce.<sup>114</sup>

Because VIP used Jack Daniel’s trade dress and bottle design to convey a humorous message, they were protected under the First Amendment and did not dilute Jack Daniel’s trademark.<sup>115</sup> In reversing the district court, the Ninth Circuit determined the use of the mark was “noncommercial” because it contained a “protected expression.”<sup>116</sup> Thus, the usage of various Jack Daniel’s marks was noncommercial, even though it was used to sell a dog toy.<sup>117</sup>

#### IV. ANALYSIS

The three prevalent *Rogers* tests adaptation will be expanded upon to figure out which of the variations the Ninth Circuit used. In doing so, *VIP Products* will be placed within the structure of these variations. In addition, this section will compare *Haute Diggity Dog* and the likelihood of confusion test used therein with *VIP Products* to demonstrate that the Ninth Circuit reached the same conclusion whilst using the *Rogers* test. Lastly, arguably, this case will pave the way for more unconventional parodies to be considered expressive works, like prayer candles.

##### A. *Expanding on the Three Rogers Tests Variations*

Under *Rogers* I, an artistic work may be “explicitly misleading” in either an implicit or explicit manner.<sup>118</sup> An expressive work will implicitly mislead the public when the title of the work includes “a well-known name without any overt indication of authorship or endorsement.”<sup>119</sup> An implicitly misleading use of a trademark constitutes a protectable expression outside the Lanham Act’s purview.<sup>120</sup> On the explicitly misleading side of the dichotomy, the Second Circuit in *Rogers* centered on a trademark’s use containing clear misrepresentations as to the source of the work or

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<sup>114</sup> *Id.* at 1175; *see also* Gordon v. Drape Creative, Inc., 909 F.3d 257, 268–69 (9th Cir. 2018) (holding that greeting cards combining trademarked phrase “Honey Badger Don’t Care” alongside an event such as Halloween were protected under the First Amendment because the cards conveyed a humorous message).

<sup>115</sup> *Id.* at 1176.

<sup>116</sup> *Id.* Speech is considered noncommercial “if it does more than propose a commercial transaction and contains some protected expression and contains some protected expression.” *Id.*

<sup>117</sup> *Id.*

<sup>118</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989); *see also* Byron, *supra* note 63, at 10. (“When formulating the ‘explicitly misleading’ prong of the [*Rogers*] test, the Second Circuit operated under the premise that the title of an artistic works could be misleading in either an implicit or explicit manner.”) *Id.*

<sup>119</sup> *Rogers*, 875 F.2d at 999. For example, “the hit song ‘Bette Davis Eyes,’ and the . . . film ‘Come Back to the Five and Dime, Jimmy Dean, Jimmy Dean’” may implicitly suggest the celebrity endorsed the work or helped produce. Even if that suggestion is false, the title is artistically relevant to the work. *Id.* at 999–1000.

<sup>120</sup> Dana Kramer, *Honey Badger Does Care About First Amendment Protections in Trademark Law*, 84 MO. L. REV. 873, 883–84 (2019); *see* Univ. of Ala. Bd. Of Trs. v. New Life Art, Inc., 683 F.3d 1266, 1277 (11th Cir. 2012).

the works endorsement.<sup>121</sup> Under this logic, only when a trademark's use in an expressive work falls on the explicit side of the dichotomy will the Lanham Act preclude the usage of the trademark and protect the trademark owner.<sup>122</sup>

Regarding *Rogers II*, the Second Circuit, sensitive to the limitation on the “explicitly misleading” prong, developed its own variation of the *Rogers* test.<sup>123</sup> In doing so, the Second Circuit adopted the two prong *Rogers* test in cases like *Cliff Notes, Inc. v. Bantam Doubleday Dell Publishing Group* and *Twin Peaks* for third party marks that are pivotal to an expressive work.<sup>124</sup>

In *Twin Peaks*, the court determined that a plaintiff must make a “particularly compelling” showing of confusion to overcome First Amendment concerns.<sup>125</sup> However, the Second Circuit did not expand upon what counts as “particularly compelling,” resulting in *Rogers II* calling for vague balancing of interests that tend to weigh in favor of the media defendant.<sup>126</sup> In *Cliff Notes*, the Second Circuit held that a slight risk of consumer confusion is outweighed by public interest in free expression, especially when expression must, to some extent, resemble the original.<sup>127</sup>

Under *Rogers III*, the Ninth Circuit may be the stray dog regarding its interpretation of the *Rogers* test.<sup>128</sup> There must be balance between a creators First

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<sup>121</sup> *Rogers*, 875 F.2d at 1007 (proposing a hypothetical where the characters, “Ginger and Fred” published memoirs under the title ‘The True Life Story of Ginger and Fred’ and the film-maker used the fictitious book title as the film title, the Lanham Act could apply as to the explicitly misleading content description).

<sup>122</sup> Byron, *supra* note 63, at 10 (quoting *Rogers* 875 F.2d at 1007). “[I]f the titles ‘Nimmer on Copyright’ and ‘Jane Fonda’s Workout Book’ were falsely applied to the underlying work there would be liability under the Lanham Act. . . . [I]f either of these titles was used in connection with bogus work, it would be copying a legally protected title.” *Id.*

<sup>123</sup> Byron, *supra* note 63, at 12 (explaining that *Rogers II* is less protective of expression and more effective at protecting against confusion).

<sup>124</sup> Daniel Jacob Wright, *Explicitly Explicit: The Rogers Test and the Ninth Circuit*, 21 J. INTELL. PROP. L. 193, 204 (2013) (stating that the *Rogers* test is the appropriate method “to weigh the public interest in free expression against the public interest in avoiding consumer confusion”); *see also* *Cliff Notes, Inc. v. Bantam Doubleday Dell Pub. Group*, 886 F.2d 490, 495 (2d Cir. 1989). In *Cliff Notes, Inc.*, defendant published books parodying Cliff Notes study aid series, which provided synopsis of routinely read literary works. Cliff Notes sued under the Lanham Act for Defendant’s use of Cliff Notes’ distinctive black and yellow trade dress. Cliff Notes argued the parody would confuse consumers into thinking Cliff Notes published or endorsed Defendant’s book. The Second Circuit stated the *Rogers* test “takes into account the ultimate test in trademark law, namely, the likelihood of confusion as to the source of the goods.” *Id.* The court held that the Defendant’s usage of Cliff Notes’ black and white color scheme would only create “. . . a slight risk of consumer confusion.” *Id.* at 497.

<sup>125</sup> *Twin Peaks Prods. v. Publ’n Int’l., Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993). “The question then is whether the title is misleading in that it induces . . . the public to believe the Book was prepared or authorized by [the plaintiff]. However, the finding of likelihood of confusion must be particularly compelling to outweigh the First Amendment interest recognized in *Rogers*.” *Id.*

<sup>126</sup> *Id.* at 1379; *Lombardo v. Dr. Suess Enters. L.P.*, 279 F. Supp. 3d 497, 502 (S.D.N.Y. 2017) (stating that Lombardo, author of *Who’s Holiday* [the “Play”], parodied *How the Grinch Stole Christmas!* [“Grinch”] characters, plot, and setting. The Play constituted fair use and therefore did not infringe defendant’s copyright in Grinch or related trademarks).

<sup>127</sup> *Cliff Notes, Inc.*, 886 F.2d at 497.

<sup>128</sup> Wright, *supra* note 124, at 206. “While the circuits have applied the *Rogers* test in different and perhaps contradictory ways, the application of the text [sic] within the Ninth Circuit has proven particularly confusing.” *Id.*

Amendment protection and the property interests of the trademark holders.<sup>129</sup> This balance turns on whether the product will cause consumer confusion.<sup>130</sup> However, it appears that explicitly misleading and likelihood of confusion are synonymous under this framework.<sup>131</sup> In *Mattel, Inc.*, the Ninth Circuit held that the First Amendment protected MCA's usage of the term "Barbie" in their song "Barbie Girl."<sup>132</sup> However, in doing so, the court first determined whether there was a likelihood of confusion before analyzing whether the usage of the trademark was explicitly misleading.<sup>133</sup>

In *Mattel, Inc.*, the Ninth Circuit adopted the *Rogers* test when the defendant produced the song, "Barbie Girl," which to Mattel's dismay, entered Top 40 music charts.<sup>134</sup> In its application of the *Rogers* test, the Ninth Circuit concluded that the title of the song was artistically relevant, thus satisfying the first prong of the *Rogers* test.<sup>135</sup> As to the second *Rogers* test prong, the title "Barbie Girl" does not explicitly mislead or suggest that Mattel was the creator of the song.<sup>136</sup> The Ninth Circuit went on to state that they would "adopt the *Rogers* standard as our own."<sup>137</sup>

In *E.S.S. Entertainment 2000*, the Ninth Circuit held the Play Pen being modified into the "Pig Pen" was not explicitly misleading.<sup>138</sup> The court was more concerned with the artistic relevance of the Play Pen to the underlying video game.<sup>139</sup> The court evaluated whether Rock Star's use was explicitly misleading in a manner that would invoke the traditional likelihood of confusion test, though the court never applied the traditional factors. The court determined that Rock Star's use did not present likelihood of confusion amongst consumers.<sup>140</sup> In doing so, the Ninth Circuit considered explicitly misleading and likelihood of confusion to be one in the same.<sup>141</sup>

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<sup>129</sup> Anthony Zangrillo, *The Split on the Rogers v. Grimaldi Gridiron: An Analysis of Unauthorized Trademark Use in Artistic Mediums*, 27 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 385, 406 (2017).

<sup>130</sup> Ford, *supra* note 66, at 319.

<sup>131</sup> *Id.* at 320.

<sup>132</sup> *Mattel, Inc. v. MCA Rec.*, 296 F.3d 894, 902 (9th Cir. 2002). "Under the first prong of *Rogers*, the use of Barbie in the song title clearly is relevant to the underlying work, namely, the song itself. As noted, the song is about Barbie and the values [Defendant] claims she represents." *Id.*

<sup>133</sup> *Id.* "The song title does not explicitly mislead as to the source of the work; it does not, explicitly, or otherwise, suggest that it was product by Mattel." *Id.*

<sup>134</sup> *Id.* at 899.

<sup>135</sup> *Id.* at 902 (stating that the song is about Barbie and the values Aqua believes her to hold, thus making it relevant to the underlying work).

<sup>136</sup> *Id.* "The only indication that Mattel might be associated with the song is the use of Barbie in the title; if this were enough to satisfy this prong of the *Rogers* test, it would render *Rogers* a nullity." *Id.* (emphasis in original).

<sup>137</sup> *Mattel, Inc.*, 296 F.3d at 902.

<sup>138</sup> *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008).

<sup>139</sup> *Id.* (quoting *Mattel, Inc.*, 296 F.3d at 902) ("Under MCA Rec. and the cases that followed it, only the use of a trademark with 'no artistic relevance to the underlying work whatsoever' does not merit First Amendment protection.") *Id.*

<sup>140</sup> *Id.* at 1100-01 (explaining there would be no likelihood of confusion because no reasonable consumer would think (1) that E.S.S. had provided Rock Star with expertise or support in making the game, (2) that E.S.S. had entered the video game industry, or (3) that Rock Star operated strip clubs).

<sup>141</sup> *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp 2d 1012, 1049 (C.D. Cal 2006) (indicating that "[t]he legal framework used to analyze an [explicitly misleading claim] is substantially the same as the framework used to evaluate Lanham Act claims under federal law.") *Id.*



As a result, the court indirectly stated it would not interpret the *Rogers* test to diminish the First Amendment defense.<sup>142</sup>

### B. *Placing VIP Products Within the Rogers Test Variations*

Applying the *Rogers* test in *VIP Products*, the Ninth Circuit had no issues in concluding that the Bad Spaniels Silly Squeaker was artistically relevant to Jack Daniel's Old No. 7 Black Label Whiskey.<sup>143</sup> In doing so, the Ninth Circuit expanded what constitutes a vehicle for expression by including a nontraditional form of artistic expression.<sup>144</sup> However, because *VIP Products* has stretched the application of the *Rogers* test, it will be analyzed how this case falls within the three *Rogers* test variations.

Under *Rogers I*, the relevant question is whether the use of the trademark was explicitly or implicitly misleading.<sup>145</sup> While the parodic underpinnings from the Jack Daniel's are relevant to the toy, were the parodic interpretations by the toy's designer done in an explicitly misleading manner? There is a tag affixed to the dog toy, explicitly stating that the "product is not affiliated with Jack Daniel Distillery."<sup>146</sup> Because of this, it becomes evident that the dog toy, if misleading at all, it is misleading in only an implicit manner.<sup>147</sup> Accordingly, it constitutes a protected expressive work under the First Amendment, thus falling outside the Lanham Act's purview.<sup>148</sup>

Is *VIP Products* a *Rogers II* case that requires VIP to demonstrate it can overcome a heightened showing of confusion?<sup>149</sup> The Ninth Circuit alluded to why confusion was not likely by citing to previous Ninth Circuit cases while never explicitly stating the dog toy would not confuse consumers.<sup>150</sup> In its brief, VIP stated that there was no evidence of confusion in the marketplace, despite Jack Daniel's issuing a

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<sup>142</sup> E.S.S. Ent. 2000, *Inc.*, 547 F.3d at 1099. "[A] trademark infringement claim presupposes a use of the mark. If that necessary element in every trademark case vitiated a First Amendment defense, the First Amendment would provide no defense at all." *Id.*

<sup>143</sup> *VIP Prods. LLC v. Jack Daniel's Prods.*, 953 F.3d 1170, 1175 (9th Cir. 2020). "The effect [of the toy being an expressive work] is "a simple message" conveyed by juxtaposing the irreverent representation of the of the trademark with the idealized image created by the mark's owner." *Id.*; see also *L.L. Bean, Inc. v. Drake Publs. Inc.*, 811 F.2d 26, 34 (1st Cir. 1987) (affording First Amendment protection to a message "that business and product images need not always be taken too seriously."). *Id.*

<sup>144</sup> *VIP Prods. LLC*, 953 F.3d at 1175 "The fact that VIP chose to convey this humorous message through a dog toy is irrelevant."; see *Hurley v. Irish-American Gay, Lesbian & Bisexual Grp. of Bos.*, 515 U.S. 557, 569 (1995). "[T]he Constitution looks beyond written or spoken words as mediums of expression." *Id.*

<sup>145</sup> Byron, *supra* note 63, at 10.

<sup>146</sup> *VIP Prods. LLC*, 953 F.3d at 1172.

<sup>147</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989) (stating that a slight risk that the use of a celebrity or popular business' name might implicitly suggest endorsement is outweighed by the danger of restricting artistic expression, and the Lanham Act will not be applicable).

<sup>148</sup> Kramer, *supra* note 120, at 885. Had the Ninth Circuit taken this *Rogers* test approach, it is likely that the court would have dismissed the claim since the dog toy would have fallen outside the Lanham Act's purview since the Ninth Circuit held that the likelihood of confusion test was not appropriate in these circumstances.

<sup>149</sup> *Simon & Schuster v. Dove Audio*, 936 F. Supp. 156, 164 (S.D.N.Y. 1996) (explaining that the Lanham Act should be understood to apply to artistic works only when the public interest in avoiding consumer confusion outweighs the public interest in free expression).

<sup>150</sup> *VIP Prods. LLC*, 953 F.3d at 1175.

survey.<sup>151</sup> Moreover, Jack Daniel's failed to present evidence that the dog toy market was so saturated with Jack Daniel's dog toys that it would not be able to create its own version of a dog toy.<sup>152</sup> Whilst VIP was able to demonstrate a lack of confusion, it is not evident that, on its face, this case is a *Rogers II* case. Under the explicitly misleading prong, *Rogers II* focuses less tolerant of public expression and shields the trademark holders.<sup>153</sup>

It is evident that *VIP Products* is a *Rogers III* case for multiple reasons. First, *Rogers III* arose out of the Ninth Circuit, the circuit that decided this case. Second, this case aligns with the Ninth Circuit's broad application of the *Rogers* test.<sup>154</sup> Jack Daniel's was unable to demonstrate a likelihood of confusion or that the product was explicitly misleading.<sup>155</sup> Jack Daniel's total absence of actual confusion amongst dog toy purchasers was a strong indicator that Bad Spaniel's created no likelihood of confusion.<sup>156</sup> In its ruling, the Ninth Circuit ruled in favor of VIP by assuring that any such confusion did not outweigh VIP's First Amendment protection.<sup>157</sup> *VIP Products* appears to be a *Rogers III* case due to a new artistic medium, here a dog toy, being subject to the *Rogers* test.

### C. *There is No Likelihood of Confusion in VIP Products*

While the Ninth Circuit declined to directly apply the likelihood of confusion test,<sup>158</sup> the result would have been the same had the test been applied. Multiple likelihood of confusion factors will be analyzed to determine that there is no likelihood of confusion between the dog toy and Jack Daniels Bottle.<sup>159</sup>

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<sup>151</sup> Brief for the Appellant at 43, *VIP Prods. LLC v. Jack Daniel's Props. Inc.*, 953 F.3d 1170 (No. 18-16012) (9th Cir. Nov. 9, 2018) (quoting *Cohn v. PetSmart, Inc.*, 281 F.3d 837, 843 (9th Cir. 2002)). Jack Daniels offered no evidence of actual confusion in the marketplace, which is a "powerful indication" that such confusion unlikely. *Id.*

<sup>152</sup> See generally *Twin Peaks Prods. v. Publ'n Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (holding that the defendant's book competes in plaintiff's markets).

<sup>153</sup> *Mutual of Omaha Insurance Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987) (finding infringement arising out of a deformed t-shirt version of the Mutual of Omaha Indian logo).

<sup>154</sup> *Mattel, Inc. v. MCA Rec.*, 296 F.3d 894, 901–02 (9th Cir. 2002) (applying the *Rogers* test to a parodied song where the court held that the mere use of "Barbie" in the song title was not explicitly misleading); see also *Mattel Inc. v. Walking Mt. Prods.*, 353 F.3d 792, 796–97 (9th Cir. 2003) (narrowing *Mattel Inc.*'s holding by requiring creators to utilize marks which have a cultural significance).

<sup>155</sup> *VIP Prods. LLC v. Jack Daniel's Props. Inc.*, 953 F.3d 1170, 1175 (9th Cir. 2020).

<sup>156</sup> Brief for the Appellant at 42, *VIP Prods. LLC v. Jack Daniel's Props. Inc.*, 953 F.3d 1170 (No. 18-16012) (9th Cir. Nov. 9, 2018); see *Yankee Publ'g, Inc. v. News Am. Publ'g, Inc.*, 809 F. Supp. 267, 275 (S.D.N.Y. 1992) (explaining that an absence of evidence of confusion amongst the product's consumers strongly indicates there is no likelihood of confusion).

<sup>157</sup> *VIP Prods. LLC*, 953 F.3d at 1175.

<sup>158</sup> *Id.*; see also *Mattel Inc.*, 296 F.3d at 900 (explaining that the likelihood of confusion test fails to take into account the full extent of the public's interest in free expression.); Byron, *supra* note 63, at 16. "[T]he Ninth Circuit [has] stopped short of naming the likelihood of confusion factors test as its analytical framework for determining misleading trademark uses." *Id.*

<sup>159</sup> *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979) stating:

In determining whether confusion between related goods is likely, the following factors are relevant: 1. strength of the mark; 2. proximity of the goods; 3.

First, one must analyze the strength of VIP's mark. A trademark's strength covers two concepts: inherent distinctiveness and acquired distinctiveness.<sup>160</sup> Bad Spaniels invoked multiple elements of Jack Daniel's Old. No. 7 whiskey bottle and artistically altered the elements to convey its humorous message.<sup>161</sup> For instance, "40% Alc. by Vol." was transformed into "43% POO BY VOL."<sup>162</sup> Moreover, it does not matter that VIP chose to utilize a famous whiskey bottle to convey its humorous message because the "Constitution looks beyond written or spoken words as mediums of expression".<sup>163</sup> Thus, VIP's mark is distinctive from those of Jack Daniel's.

Next, there is no proximity between the two products.<sup>164</sup> Comparing the two products, it is evident they do not share a market. Jack Daniel's only products are spirits and mixed spirits.<sup>165</sup> VIP's only products on the market are their Silly Squeakers.<sup>166</sup> Moreover, the prices of the products are drastically different. A bottle of Jack Daniel's Old. No. 7 costs around \$23<sup>167</sup> while a Silly Squeaker costs around \$12.<sup>168</sup> Because of this, there is not enough similarity between the products for this factor to weigh in favor of the likelihood of consumer confusion.

Moreover, Jack Daniel's would not prevail on the similarity of marks element. Similarity of marks falls on three general principles. "[S]imilarity is best adjudged by appearance, sound, and meaning."<sup>169</sup> *VIP Products* presents a stark similarity between

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similarity of the marks; 4. evidence of actual confusion; 5. marketing channels used; 6. type of goods and the degree of care likely to be exercised by the purchaser; 7. defendant's intent in selecting the mark; and 8. likelihood of expansion of the product lines.

<sup>160</sup> *Virgin Enters v. Nawab*, 335 F.3d 141, 147 (2d Cir. 2003) stating, "This inquiry [into inherent distinctiveness] distinguishes between . . . inherently distinctive marks . . . and . . . that are generic, descriptive or suggestive as to those goods. The former are strong marks." Acquired distinctiveness deals with " . . . fame, or the extent to which prominent use of the mark in commerce has resulted in a high degree of consumer recognition." *Id.*

<sup>161</sup> Brief for the Appellant at 23, *VIP Prods. LLC v. Jack Daniel's Props. Inc.*, 953 F.3d 1170 (No. 18-16012) (9th Cir. Nov. 9, 2018). "The concept was to borrow enough of the Jack Daniel's mark and bottle dress . . . to invoke the original and transform those borrowed elements into a humorous comment on the original." *Id.*

<sup>162</sup> *VIP Prods. LLC.*, 953 F.3d at 1172.

<sup>163</sup> *Hurley v. Irish-American Gay, Lesbian & Bisexual Grp. of Bos.*, 515 U.S. 557, 569 (1995); see also *Schieffelin & Co. v. Jack Co. of Boca, Inc.*, 850 F. Supp. 232, 248 (S.D.N.Y. 1994). "It is unremarkable that [defendant] selected as a target of parody a readily recognizable product; indeed, one would hardly make a spoof of an obscure or unknown product!" *Id.*

<sup>164</sup> *American Steel Foundries v. Robertson*, 269 U.S. 372, 382 (1926) (stating that the less likely the public is to make such an association between the producers of related goods, the more similarity in the marks is requisite to a finding of likelihood of confusion).

<sup>165</sup> Jack Daniel's, *Our Products*, JACK DANIEL'S <https://www.jackdaniels.com/en-us/our-products> (last visited Oct. 11, 2021).

<sup>166</sup> Brief for the Appellant at 1, *VIP Prods. LLC v. Jack Daniel's Props. Inc.*, 953 F.3d 1170 (No. 18-16012) (9th Cir. Nov. 9, 2018) (explaining that each Silly Squeaker is a parody of a famous beer, wine, soda, or liquor bottle).

<sup>167</sup> Binny's, *Jack Daniel's Old No. 7 Tennessee Whiskey*, BINNY'S, <https://www.binnys.com/spirits/whiskey/jack-daniels-old-no-tennessee-whiskey-191961> (last visited Oct. 11, 2021).

<sup>168</sup> Chewy, *Silly Squeakers*, CHEWY, <https://www.chewy.com/f/silly-squeakers> (last visited Oct. 11, 2021).

<sup>169</sup> *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1032 (9th Cir. 2010) (quoting *Entrepreneur Media v. Smith*, 279 F.3d 1135, 1144 (9th Cir. 2002)).

appearances as the dog toy contains multiple parodic play on words based on the infamous Jack Daniel's bottle.<sup>170</sup> An argument could even be made that the sounds of the products are different as the dog toy makes squeaking noises<sup>171</sup> while the Jack Daniel's would make a "clinking" noise as it is made of glass.<sup>172</sup> Lastly, the two products carry two different meanings with them as the dog toy makes for a fun night with fido<sup>173</sup> and Jack Daniel's makes for a fun night with friends.<sup>174</sup>

Lastly, there is no evidence of bad faith on part of VIP.<sup>175</sup> VIP stated the intent of producing the Silly Squeakers toy line was to "develop a creative parody on existing products."<sup>176</sup> Additionally, VIP aimed at conveying a message that poked fun at famous brands that take themselves too seriously.<sup>177</sup> In doing so, VIP reminds us that "we are free to laugh at the images and associations linked with the mark."<sup>178</sup> The benefits VIP derives from the parody arise from the widely regarded whiskey and the amusing dog toy, not from customer confusion.<sup>179</sup> Because of this, there is no evidence that VIP was acting in bad faith when creating the Bad Spaniels toy.

In conclusion, it is evident the aforementioned likelihood of confusion factors weigh in VIP's favor. The strength of their mark is sufficient to set them apart from Jack Daniel's so as not to cause consumer confusion.

#### *D. Applications to Prayer Candles as Being Protected Under the Rogers Test*

In holding that a dog toy is an expressive work,<sup>180</sup> the Ninth Circuit has dramatically expanded what constitutes an expressive work for the *Rogers* test. The court's decision concerning the application of the *Rogers* test and First Amendment protections can be paralleled to other non-traditional expressive works, such as prayer-candles.<sup>181</sup> The Ninth Circuit stated that a product does not have to be "equivalent to

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<sup>170</sup> VIP Prods. LLC v. Jack Daniel's Props. Inc., 953 F.3d 1170, 1172 (9th Cir. 2020). Notable differences include "the Old No. 2, on your Tennessee Carpet" as opposed to "Old No. 7 Brand Tennessee Sour Mash Whiskey," and "43% POO BY VOL.," and "100% SMELLY" replace the infamous bottle's label of "40% Alc. by Vol. (80 Proof)." *Id.*

<sup>171</sup> Mydogtoy.com, *supra* note 6. The website describes the toys as "fun squeaky toys." *Id.*

<sup>172</sup> Binny's, *supra* note 167.

<sup>173</sup> Mydogtoy.com, *supra* note 6. The website states "your dog's favorite toys, and yours too!" *Id.*

<sup>174</sup> Jack Daniel's, *supra* note 167. "Please drink responsibly." *Id.*

<sup>175</sup> AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 354 (9th Cir. 1979); Fleischmann Distilling Corp. v. Maier Brewing Co., 314 F.2d 149, 157–58 (9th Cir. 1963) (stating that when the alleged infringer knowingly adopts a mark similar to another's, reviewing courts presume that the defendant can accomplish his purpose: that is, that the public will be deceived).

<sup>176</sup> Brief for the Appellant at 10, VIP Prods. LLC v. Jack Daniel's Props. Inc., 953 F.3d 1170 (No. 18-16012) (9th Cir. Nov. 9, 2018). The parodic nature can be confirmed when a VIP designer received a phone call from VIP's president in which he said only "Bad Spaniel's. You figure it out." *Id.*

<sup>177</sup> *Id.* at 21 (explaining that VIP aims to send the message that it is okay to make fun of well-known brands).

<sup>178</sup> *Id.*

<sup>179</sup> See generally *Louis Vuitton Malletier S.A. v. Haute Diggity Dog LLC*, 464 F. Supp. 2d, 495, 502 (E.D. Va. 2006). The benefit of making a parody arises from humorous association, not from public confusion. *Id.*

<sup>180</sup> VIP Prods. LLC v. Jack Daniel's Props. Inc., 953 F.3d 1170, 1175 (9th Cir. 2020).

<sup>181</sup> Amazon, *Saint Harry Styles: Masculinity in Femininity*, AMAZON, <https://www.amazon.com/Saint-Harry-Styles-Masculinity-in-Femininity> (last visited Oct. 11, 2021). The product description states that it is a "novelty" candle. *Id.*

the Mona Lisa” to be considered an expressive work.<sup>182</sup> Moreover, an expressive work can be communicated in different manners.<sup>183</sup> Accordingly, the standard to qualify as an expressive work is quite low. This analysis will follow that of *Rogers I* as the standard for what constitutes an expressive work is highest under this variation.

1. *The Parody Prayer Candle is Artistically Relevant to the Underlying Work*

A traditional prayer candle typically depicts an image of Jesus, Mary, or a saint.<sup>184</sup> The image on the traditional prayer candle image tends to look like it was either drawn or painted onto the candle and is framed around stained glass.<sup>185</sup> Furthermore, the name of the individual depicted is on the candle.<sup>186</sup> The medium through which the work is expressed does not matter when it pertains to a work being expressive, so long as it is artistically relevant.<sup>187</sup>

However, while the parodic interpretation of prayer candles follows the same artistic format as a prayer candle, there are key differences that make it artistically relevant. The parodic candles tend to be bright in color and look like a photograph affixed on the candle.<sup>188</sup> Similar to a traditional candle, parodic candles tend to have the celebrity’s name placed on the candle.<sup>189</sup> Despite these similarities, it would be evident that the celebrity depicted on the candle did not endorse the candle.

At a quick glance, an individual should be able to establish that one candle is religious whilst the other depicts a pop culture icon. It is these key distinctions that set parodic candles apart from the traditional prayer candles. Because the level of relevance must only be above zero, the parodic candles would qualify under this prong of the *Rogers* test.<sup>190</sup> Moreover, because the parodic candles utilize the themes of the religious candles, they are artistically relevant.<sup>191</sup>

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<sup>182</sup> *VIP Prods. LLC*, 953 F.3d at 1175.

<sup>183</sup> *Punchbowl, Inc. v. AJ Press LLC*, 2021 U.S. Dist. LEXIS 146052, at \*19 (C.D. Cal. July 16, 2021). “For example, each of the defendants in *Dr. Seuss, E.S.S., Mattel*, and *Twentieth-Century Fox* could have chosen a different title or used a different word.” *Id.*

<sup>184</sup> Target, *Jar Candle Sagrado Corazon De Jesus White Vanilla - Continental Candle*, TARGET, <https://www.target.com/p/jar-candle-sagrado-corazon-de-jesus-white-vanilla-continental-candle/> (last visited Oct. 11, 2021).

<sup>185</sup> Amazon, *Prayer Glass Candle Yellow - Jesus*, AMAZON, <https://www.amazon.com/Glass-Candle-Yellow-Jesus/> (last visited Oct. 11, 2021).

<sup>186</sup> Target, *Jar Candle San Miguel Red - Continental Candle*, TARGET, <https://www.target.com/p/jar-candle-san-miguel-red-continental-candle/> (last visited Oct. 11, 2021).

<sup>187</sup> Kramer, *supra* note 120, at 877 (“[H]olding that use of a mark is ‘artistically relevant’ when the mark relates to defendants’ work and defendants add their own artistic expression beyond that of the mark.”).

<sup>188</sup> Etsy, *Cardi B Prayer Candle*, ITSLITBYE, <https://www.etsy.com/listing/585831947/cardi-b-prayer-candle> (last visited Oct. 11, 2021). The candle depicts Cardi B, a well-known singer, who is holding a bottle of Bacardi Rum and states “Saint Bardi”. *Id.*

<sup>189</sup> Amazon, *Timothee Chalamet Celebrity Prayer Candle - Funny Saint Candle*, AMAZON, <https://www.amazon.com/Timothee-Chalamet-Celebrity-Prayer-Candle/> (last visited Oct. 11, 2021). The candle depicts Timothee Chalamet, a well-known French actor, additionally the title of the candle says, “Funny Celeb Novelty Actor TV Show Movie Gift.” *Id.*

<sup>190</sup> *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008).

<sup>191</sup> *Twentieth Century Fox TV v. Empire Distrib., Inc.*, 875 F.3d 1192, 1199 (9th Cir. 2017) (explaining that a product may have artistic relevance by supporting the themes of another work. However, while reference to another work may be a component of artistic relevance, it is not a prerequisite).

2. *The Parody Prayer Candle Does Not Explicitly Mislead Consumers as to the Source or Content of the Work*

To fail the second prong of the *Rogers* test in the Ninth Circuit, “the creator must explicitly mislead consumers.”<sup>192</sup> On its face, it is not evident that consumer confusion as to celebrity endorsement of the candle is likely for multiple reasons.

Where the candles can be purchased should allude to a lack of confusion. The traditional prayer candles are typically purchased at grocery stores and online vendors.<sup>193</sup> On the other hand, the parodic candles are normally found exclusively through online vendors.<sup>194</sup> Had the parodic candles been endorsed by celebrities, they would likely be found online on their own websites, not an online vendor selling a multitude of celebrity candles.<sup>195</sup>

Lastly, and most notable, the names of the candles should be a strong indicator that consumer confusion is not likely. The traditional prayer candles have the name of the religious figure in them or explicitly say prayer candle.<sup>196</sup> For example, a candle depicting the image of Archangel San Miguel contains “San Miguel” in the candle’s title, clearly indicating the candle’s religious connotations.

Had celebrities endorsed these candles, the name of the celebrity, or their brand, would likely appear in the title or description of the product. This is a practice commonly seen in a variety of industries.<sup>197</sup> For example, Beyonce’s collaboration with Adidas is entitled “Adidas x Ivy Park.”<sup>198</sup> However, the parodic candles clearly depict a pop culture icon or contain words in the title alluding to it being a parody. To illustrate, the words “celebrity,” “novelty,” and “funny” appear in the title of a candle portraying Timothee Chalamet.<sup>199</sup>

These key distinctions between the candles indicate that the parodic candle creators do not explicitly mislead consumers to make them believe the candles to be celebrity endorsed.<sup>200</sup> Moreover, the usage of a mark is not enough to satisfy the second prong of the *Rogers* test.<sup>201</sup> However, perhaps these parodic candles are merely “living on a prayer” until a lawsuit by a celebrity is brought forth against them.<sup>202</sup>

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<sup>192</sup> *Id.*

<sup>193</sup> Target, *supra* note 184; Amazon, *supra* note 185.

<sup>194</sup> Etsy, *supra* note 188; Amazon, *supra* note 185.

<sup>195</sup> Billie Eilish, *Apparel*, BILLIE EILISH, [www.store.billieeilish.com](http://www.store.billieeilish.com) (last visited Mar. 14, 2022).

<sup>196</sup> Target, *supra* note 184. The name of the candle, “San Miguel,” matches the San Miguel Archangel depicted on the candle. *Id.*; Amazon, *supra* note 185. The candle name states it is a prayer candle with “Jesus,” matching the image of Jesus on the candle. *Id.*

<sup>197</sup> See Morphe, *Morphe x Maddie Ziegler*, MORPHE, <https://eu.morphe.com/collections/morphe-x-maddie-ziegler> (last visited Mar. 16, 2022) (showing a makeup collaboration between makeup brand, Morphe, and famous dancer, Maddie Ziegler); CB2, *Kravitz Design by Lenny Kravitz*, CB2, <https://www.cb2.com/design-collabs/kravitz/1> (last visited Mar. 16, 2022) (showing a look book and shop for a furniture collaboration between home goods store, CB2, and famous musician, Lenny Kravitz).

<sup>198</sup> Adidas, *Adidas x Ivy Park*, ADIDAS, [www.adidad.com/us/ivypark](http://www.adidad.com/us/ivypark) (last visited Mar 15, 2022) (showing Ivy Park as Beyonce’s fashion line).

<sup>199</sup> Amazon, *supra* note 189. Additional words alluding to the candle being a parody include “pop culture” and “funny celeb novelty.” *Id.*

<sup>200</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d Cir. 1989).

<sup>201</sup> *Id.*

<sup>202</sup> BON JOVI, *LIVIN’ ON A PRAYER* (Mercury Records 1986).

## V. CONCLUSION

Following the formation of the *Rogers* test in 1989, circuit courts have struggled to find a balance between First Amendment rights regarding artistic expression with the rights of the trademark owner to avoid consumer confusion. Out of this struggle came three prevalent *Rogers* tests variations, each with their own varying degree of First Amendment protection.<sup>203</sup> These three drastically different variations of the *Rogers* test needlessly complicate the law which is reflected in the inconsistent holdings across the circuits.<sup>204</sup>

The Ninth Circuit's inconsistent application of the *Rogers* test reflects the capricious nature of trademarks in modern society. Trademarks have developed beyond their role as "source indicators to take on greater cultural significance."<sup>205</sup>

*Rogers*, *MCA Records*, *Walking Mountain*, and most recently *VIP Products*, demonstrate how the First Amendment can broadly protect cultural references, criticisms, and parody.<sup>206</sup> While a dog toy may not be a traditional form of artistic expression, *VIP Products* serves to broaden what constitutes an expressive work, and more importantly, what expressive works can be protected under the First Amendment.<sup>207</sup>

A decision out of the Ninth Circuit clarifying its position and application of the *Rogers* test will have an immense impact on the nature of artistic expression available to the public.<sup>208</sup> However, *VIP Products* falls short of being the Ninth Circuit case providing such clarity. *VIP Products* will likely form another "fault line in the circuit split" regarding the application of the *Rogers* test to expressive works.<sup>209</sup>

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<sup>203</sup> Ford, *supra* note 66, at 310 (stating that *Rogers* I offers the most First Amendment protection to media defendants from Lanham Act claims); *Cliff Notes, Inc. v. Bantam Doubleday Dell Pub. Group*, 886 F.2d 490, 493 (2d Cir. 1989) (considering initially that the traditional likelihood of confusion factors before balancing consumer confusion with the First Amendment); *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) (stating what counts as misleading as synonymous to what is likely to cause confusion).

<sup>204</sup> Ford, *supra* note 66, at 307.

<sup>205</sup> Wright, *supra* note 124, at 221.

<sup>206</sup> Brief for the Appellant at 29, *VIP Prods. LLC v. Jack Daniel's Props. Inc.*, 953 F.3d 1170 (No. 18-16012) (9th Cir. Nov. 9, 2018) (treating VIP's parody of the Jack Daniel's bottle as artistically relevant and not explicitly misleading as to its source, offers the toy First Amendment protection).

<sup>207</sup> *VIP Prods. LLC v. Jack Daniel's Props. Inc.*, 953 F.3d 1170, 1175 (9th Cir. 2020) (explaining that the Bad Spaniel's toy conveys a simple message through the juxtaposition of the "irreverent representation" of Jack Daniel's marks with the idealized image created by VIP); *see also* *L.L. Bean, Inc. v. Drake Publs. Inc.*, 811 F.2d 26, 34 (1st Cir. 1987) (holding that Drake Publisher's adult erotic periodical parodying an L.L. Bean catalog featuring models using L.L. Bean products crudely and humorously was used in an unauthorized negative context, but it was protected because it was used for non-commercial purposes).

<sup>208</sup> Wright, *supra* note 124, at 222. If the Ninth Circuit were to issue a clarifying decision, it may help guide future courts in their struggle to balance free speech against trademark protection. *Id.*

<sup>209</sup> Thomas Key, *The Bad Spaniel's Gets a Treat: VIP Products LLC v. Jack Daniels Properties Inc.*, THE IP KAT (May 7, 2020), <https://ipkitten.blogspot.com/2020/05/the-bad-spaniel-gets-treat-vip-products>.

Some may say that the court's holding was unprecedented and may place brand owners at substantial risk of infringement masquerading as expressive works.<sup>210</sup> It is evident that what makes a title or creative aspect "artistically relevant" and "explicitly misleading" is undoubtedly evolving as time progresses.<sup>211</sup> With this, comes a game of tug of war for the *Rogers* test between encouraging and stifling economic activity to protect major brands and encouraging artistic expression in the form of expression.

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<sup>210</sup> Jared Kagan, *Bad Spaniels Make Bad Law: Ninth Circuit Says Dog Toy is an Expressive Work Entitled to First Amendment Protection*, IP WATCH DOG (Apr. 3, 2020), <https://www.ipwatchdog.com/2020/04/03/bad-spaniels-make-bad-law>.

<sup>211</sup> Kelly, *supra* note 14, at 1365.