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Rogers Test in Unsettled Paw-sition After SCOTUS's Latest Trademark Decision

Article By:

Joel Ross Feldman

On June 8, 2023, the U.S. Supreme Court unleashed its opinion in the *Jack Daniel's Properties, Inc. v. VIP Products LLC* dispute. Despite all the anticipation, the Court's decision left trademark practitioners with no new bone to chew on, as the Court declined to truly sink its teeth into the *Rogers* test. Instead, the Court held that notwithstanding some expressive content and canine-related creativity embodied within dog toys imitating whiskey bottles, these goods and their packaging had to be sniffed out for trademark infringement and trademark dilution by the district court using traditional likelihood-of-confusion and likelihood-of-dilution factors. In his concurrence, Justice Gorsuch (joined by Justices Thomas and Barrett) gave faint hope that the Court would "resolve" the *Rogers* test another day.

The Rogers Test

In 1986, famed Italian filmmaker Federico Fellini's "Federico Fellini's 'Ginger and Fred'" hit U.S. movie theaters. But the film was not actually about Ginger Rogers

or Fred Astaire. Rather, the film's plot involved a retired Ginger Rogers impersonator and a retired Fred Astaire impersonator reuniting 30 years after their last performance for an Italian television special. According to Fellini, he invoked Ms. Rogers and Mr. Astaire "only as a reference in the film based on their well-deserved reputation as paragons of style and excellence in dancing."

Almost immediately, Ginger Rogers filed an action seeking to enjoin the movie's use of her "public personality" as a misappropriation and infringement. Ms. Rogers' three claims for relief were publicity rights infringement, false light (based on the depiction of the impersonators as lovers), and false endorsement. Although Ms. Rogers would go on to lose at the district court and circuit court levels, her name would become immortalized not only in the world of dance but also in the world of trademark law.

The Southern District of New York distinguished the film, "a work of protected artistic expression," from a piece of "merchandise." Based on this distinction, the district court concluded that "Fellini was entitled to create a satire of modern television built around the bittersweet reunion of two somewhat tattered, retired hoofers who once earned the nicknames 'Ginger and Fred' by imitating America's dancing legends" and that "[e]qually protected is the title of the Film, an integral part of the work's artistic expression, which is a reference to its central characters."

The Second Circuit affirmed the district court's decision,

reiterating that “[T]he expressive element of titles requires more protection than the labeling of ordinary commercial products.” The circuit court’s reasoning became known as the “*Rogers* test”: “In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the [Lanham] Act unless the title has **no artistic relevance** to the underlying work whatsoever, or, if it has some artistic relevance, unless the title **explicitly misleads** as to the source or the content of the work.”

Although the *Rogers* test was created for titles, since its inception, it has generally been applied to the use of trademarks in the body of an artistic/expressive work. For example, the *Rogers* test allowed the Danish Europop band Aqua to sing about Barbie® dolls in its 1997 hit single “Barbie Girl.”

Litigation involving the *Rogers* test has generally centered around challenges to the artistic relevance of the reference to a trademark and whether the reference to a trademark explicitly misleads. The bar for artistic relevance has remained quite low, essentially non-zero, making this prong of the *Rogers* test nearly impossible to fail. For example, in 2020, the Southern District of New York ruled that the depiction of Humvee vehicles within the *Call of Duty* games had artistic relevance because it gave the game a “sense of realism and lifelikeness.”

The Court’s Unanimous Decision

Although the *Rogers* test was founded on the premise that

artistic and expressive works were distinct from pieces of merchandise and cans of peas, that did not stop the makers of mass-produced consumer goods from claiming their goods could be expressive works protected by the First Amendment. And so over three decades after the *Rogers* test was born, the Supreme Court found itself evaluating whether consumer goods had become modern day artistic and expressive works.

In a conversational and easy-to-read decision, Justice Kagan held a masterclass in trademark law basics, but left true trademark aficionados wanting more with respect to the nuances of the intersection of the First Amendment and trademark law. Not once, not twice, but three times the opinion points out that the Court is passing no judgment on "traditional" applications of the *Rogers* test in contexts like movies, books, and music, or contexts like comedy and news reporting, where reference to a trademark is for referential purposes rather than to indicate the source of a good or service.

There were three key facts the Court connected to reach the conclusion that the district court should move forward with its infringement analysis with respect to the dog toys at issue. First, the dog toy maker logo-ized Bad Spaniels (in a typeface similar to Jack Daniel's®) and displayed the logo on a hangtag affixed to the dog toy, demonstrating traditional trademark use:

Second, although the dog toy maker never attempted to register the name Bad Spaniels, it filed trademark applications for several of its other dog-adapted alcoholic beverage names used on other dog toys, essentially conceding that the analogous use of Bad Spaniels on its Bad Spaniels dog toys was a trademark use. And third, in its complaint initially seeking a declaratory judgment of noninfringement, the dog toy maker expressly alleged that Bad Spaniels was a trademark that it both owned and used. Accordingly, the dog toy maker could not avail itself of an argument of non-trademark use. But reading between the lines, the decision does not exclude the possibility that under a different set of facts, a dog toy imitating a well-known product, in toy form alone and with strategic avoidance of asserting any trademark rights, could circumvent the admittedly narrow scope of the Court's decision and avail itself of the *Rogers* test.

The real heavy lifting will be left to the trial court, which must now evaluate both whether the dog toy infringes Jack Daniel's trademark rights and whether the dog toy tarnishes Jack Daniel's iconic mark and trade dress. **Nevertheless, the Court left the trademark community with some helpful guidance in evaluating similar matters:**

Humor (including parodic humor) and trademark use are not mutually exclusive. The presence of humor or parody is **not** dispositive of whether the use of a word, term, name, or symbol is immune from a likelihood-of-confusion and likelihood-of-dilution claim.

Source identification (the quintessential function of a trademark) and expressive comment are not the least bit mutually exclusive. Many source identifiers *also* serve as an expression of the trademark owner.

Claiming trademark rights (for example, using a TM symbol, applying for a trademark registration, and asserting trademark rights in a complaint or cease-and-desist letter) may waive the fair use (including parody) immunity to **dilution** claims because of the "other than as a designation of source for the person's own goods or services" requirement for the exclusion to apply.

While the Court declined to provide a definitive ruling on whether the *Rogers* test was the "right" test to balance creative expression and trademark rights, the Justice Gorsuch concurrence (joined by Justices Thomas and Barrett) threw a bone to the hundreds of amicus brief pages spent discussing the *Rogers* test, noting "it is not obvious that *Rogers* is correct in all its particular—certainly, the Solicitor General raises serious questions about that decision." Justice Gorsuch went so far as to advise lower

courts to “stay attuned” to the fact that “[a]ll this remains for resolution another day.” And so, practitioners will be on the lookout for SCOTUS’s fetching of another case to truly test *Rogers*.

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