

# Roger that, Jack: Applying Jack Daniel's

By Hans Mayer, Esq., Jacob Rosenbaum, Esq., and Zach Rufa, Esq., Knobbe Martens

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## Introduction

The longstanding battle between a liquor brand and dog-toy maker may have ended not with a bang, but a squeak. On remand for a second time, an Arizona district court issued its decision in *VIP Products LLC v. Jack Daniel's Properties Inc.*, No. 14-cv-2057, 2025 WL 275909 (D. Ariz. Jan. 23, 2025). The court found that VIP Products' squeaky dog toy — meant to parody Jack Daniel's famous liquor bottle — was not likely to cause confusion but nevertheless tarnished the brand's reputation.

That decision follows the 2023 Supreme Court ruling in the case, which articulated a seemingly simple rule of trademark law: heightened First Amendment protection does not apply when the challenged use of a mark designates source. A year and a half later, though, the impact of *Jack Daniel's* has been anything but simple, and this latest district court ruling in the case is unlikely to dispel uncertainty.

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This article reviews several decisions applying the Supreme Court's *Jack Daniel's* opinion to offer insights into the one question that every trademark attorney seems to be asking: when does use of a mark cross over from protected expressive use into non-protected use? Or in the Supreme Court's words, what does it mean to use a "mark as a mark?"<sup>1</sup>

## The original case

Jack Daniel's is a well-known distiller of Tennessee whiskey. VIP Products makes dog toys that look like branded liquor bottles, including its "Bad Spaniels" toy.

Jack Daniel's demanded that VIP stop. Thereafter, VIP sued for declaratory judgment of non-infringement, and Jack Daniel's counterclaimed for trademark infringement and dilution by tarnishment. The district court rejected VIP's nominative and First Amendment fair use defenses on summary judgment. After a bench

trial, the court found that VIP's use was likely to cause confusion and tarnished Jack Daniel's marks.



On appeal, the Ninth Circuit reversed on dilution and vacated on likelihood of confusion, holding that VIP's use was an expressive work and thus entitled to heightened First Amendment protection under *Rogers v. Grimaldi*.

Under the two-prong *Rogers* test (and subsequent cases applying it), expressive works are shielded from the Lanham Act if the defendant's use of the mark (1) has some artistic relevance to the work, and (2) is not explicitly misleading as to the source or content of the work.<sup>2</sup> On remand, the court found that Jack Daniel's could not satisfy either prong of the *Rogers* test and granted summary judgment to VIP on both claims.

Jack Daniel's appealed, the Ninth Circuit summarily affirmed, and the Supreme Court granted certiorari. The Supreme Court held that *Rogers* does not apply when the challenged use of the mark designates the source of products.

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On remand again, the district court concluded that the Bad Spaniels toy tarnished Jack Daniel's marks — giving weight to the unsavory association between beverages and dog feces — but that the toy was not likely to cause confusion because it was a successful parody.

In *Jack Daniel's*, the defendant conceded that it was using its Bad Spaniels trademark and trade dress as source identifiers. In the wake of this latest decision in the case, it is worth reviewing how other courts have applied the Supreme Court's *Jack Daniel's* decision. In particular, how are courts deciding whether a challenged use is source identifying?

### Early applications of *Jack Daniel's*

One case clearly illustrating how *Jack Daniel's* affected the courts' analysis is *Punchbowl Inc. v. AJ Press, LLC*. In *Punchbowl*, an e-card company called Punchbowl sued an online news publication called Punchbowl News for trademark infringement.



The district court initially granted summary judgment to the defendant, holding that use of PUNCHBOWL was expressive and thus entitled to *Rogers* protection. The Ninth Circuit initially affirmed but withdrew its opinion following the *Jack Daniel's* decision, holding that the defendant was using PUNCHBOWL as a mark.

On remand, the district court granted summary judgment in favor of the defendant, finding no infringement due to the dissimilarity and lack of proximity between the parties' services.

*Punchbowl* is a useful case for practitioners because it provides different reasoning before and after *Jack Daniel's*. Indeed, in light of *Jack Daniel's*, the Ninth Circuit held that AJ Press was using the "mark as a mark" despite the expressive nature of its use as the title of a publication, noting that AJ Press had filed trademark applications to register the marks "Punchbowl News" and "Punchbowl Press."

### An emerging common fact pattern

One of the most common fact patterns in which *Jack Daniel's* has been applied is in the context of terms used in titles. Courts in other

cases have found that the use of a trademark in a title served as a source designator and thus was not entitled to *Rogers* protection — including titles that were arguably even more "expressive" in nature than AJ Press', such as in titles for a television show or video game.<sup>3</sup>

In *Down to Earth Organics, LLC v. Efron*, a New York district court held that the defendants' expressive title did not use the plaintiff's mark to designate source. Down to Earth Organics sued parties involved in the production and distribution of the Netflix series "Down to Earth with Zac Efron."

The court determined that *Rogers* applied because the defendants were using "Down to Earth" simply to identify the subject matter and tone of the series rather than to indicate the source of their goods.<sup>4</sup> One possible key point of difference between *Down to Earth* and *Punchbowl* and others, is the absence of an application for registration by the defendant.

Similarly, in *McGillvary v. Netflix*, the court dismissed the plaintiff's trademark claim because Netflix's use of the alleged mark was not source identifying. The plaintiff, who had gone viral as the "hatchet-wielding hitchhiker," sued Netflix for the use of his asserted marks in its documentary, "The Hatchet Wielding Hitchhiker."

The court found that Netflix's use was entitled to *Rogers* protection because "a documentary about the criminal acts of a public figure is obviously an expressive work" and Netflix used the mark not to identify the source of the documentary but to identify its subject matter.<sup>5</sup>

*Gone are the days where any artistic expression was sufficient to evoke First Amendment protection.*

In contrast, in *Davis v. Blue Tongue Films*, the Ninth Circuit held that *Rogers* did not require dismissing the pleadings because the plaintiff plausibly alleged that the defendants' movie used GRINGO as a source identifier. The plaintiff alleged that the filmmakers chose the title mark "to suggest an association between the Book and Movie, displayed the mark in similar ways, and distributed the Movie through the same commercial platform," which supported an inference that filmmakers used the title "to identify the source."<sup>6</sup>

These decisions provide some insight into when using a mark in a title rises beyond mere expression and instead serves as source identification. Indeed, while an application for registration, which is treated as an admission of source identifying use, is perhaps the strongest evidence, the defendant's own use in a manner similar to that of the plaintiff's source identifying use can be important evidence to show that *Rogers* does not apply.

Importantly, after *Jack Daniel's*, a mere expressive aspect to a title is no longer enough to invoke *Rogers*. Instead, the title must be solely expressive, something that any amount of source identification will defeat.

### Traditional *Rogers* cases remain

So what does non-source identifying expression look like? Consider *JTH Tax LLC v. AMC Networks Inc*. There, the plaintiff operated a tax

preparation service under the name Liberty Tax Service and sued the defendants for their depiction of the fictional “Sweet Liberty Tax Service” in the AMC show “Better Call Saul,” asserting that the depiction was an obvious imitation of an actual Liberty Tax location.



The defendants argued that the challenged use of Sweet Liberty Tax Service did not designate source, entitling it to *Rogers* protection. The court agreed, concluding that “to the extent Defendants used Plaintiff’s marks — they were used in furtherance of the Show’s plot,”<sup>17</sup> and not as their own identifying trademark.

The takeaway here is that, for those cases in which the defendant’s work is what may be thought of as traditional artistic expression but *without source identification*, *Jack Daniel’s* has likely done little to change the legal analysis apart from adding the threshold consideration of whether the challenged use of the mark is as a mark.

Such a threshold analysis in these traditional *Rogers* cases is often easily dispensed with because the answer to the essential source-designation question, “who makes me,” is not met with the mark at issue: Sweet Liberty Tax is clearly not the source of the tv show.

### Handling the in-between cases

As to those cases that fall somewhere between the core artistic expression present in *JTH Tax* and the commercial, source identifying parody at work in *Jack Daniel’s*, recent decisions’ handling of the source identification issue suggest that practitioners should assume *Rogers* will not be available to them and should proceed as though a likelihood of confusion analysis will apply.

Such was the case for Brooklyn-based art collective MSCHF that released its “Wavy Baby” sneaker, intended to comment on “sneakerhead” culture by parodying Vans’ “Old Skool” skate shoe.

The Second Circuit emphasized that *Rogers* applies only when the challenged use is *solely* to perform an expressive function and will

not apply if the mark is used at least in part for source identification. To determine whether MSCHF had used the “mark as a mark,” the court compared MSCHF’s use of Vans’ marks to the defendant’s use in *Jack Daniel’s* and found that MSCHF used Vans’ marks as source identifiers.

Vans’ Trademarks/Trade Dress	WAVY BABY Design

The court determined that MSCHF used Vans’ trademarks to brand its own products, looking to MSCHF’s use of a similar red and white logo in the same location, and determined such use was “quintessential ‘trademark use.’”<sup>18</sup> MSCHF also admitted it started its design with Vans’ based on the specific message embodied in Vans’ shoe.

On these facts, the Second Circuit upheld the district court’s application of the traditional likelihood of confusion test because MSCHF chose and used its design to indicate source. This is consistent with the Supreme Court’s determination in *Jack Daniel’s*. Namely, when a design or mark is adopted to evoke an existing brand, then that use is likely source identifying and not subject to the *Rogers* test.

The difference in the outcomes for the defendants in MSCHF and the *Jack Daniel’s* district court remand illustrates that, while such referential use may bring a defendant’s use outside of the protections of *Rogers*, whether the use to reference and comment on the underlying source material creates confusion will vary, subject to the standard factual inquiry of likelihood of confusion.

In another example, the plaintiff in *Diece-Lisa Indus., Inc. v. Disney Enters., Inc.* registered “Lots of Hugs” in connection with its wearable toys. Disney thereafter featured a character in “Toy Story 3” named “Lots-o’-Huggin’ Bear.” Disney then went on to use the name in books, video games, and in connection with a toy version of the character.

Initially, the district court ruled Disney’s use was expressive and applied *Rogers* to grant summary judgment in Disney’s favor. The Ninth Circuit affirmed. Diece-Lisa sought certiorari from the Supreme Court. A month after deciding *Jack Daniel’s*, the Supreme Court vacated the district court’s summary judgment determination in *Diece-Lisa* and remanded the case for further consideration in light of its decision in *Jack Daniel’s*.

On remand, the district court held that *Rogers* did not apply because Disney used the mark as the name of its stuffed bear character, which then appeared in books, video games, and as a toy in the retail market. This use was found to be, at least in part, to sell

those books, video games, and toys, and therefore to designate the source of those goods.



However, two of the Disney defendants — Walt Disney Studios and Buena Vista Home Entertainment — moved for reconsideration on the theory that their use was solely expressive because they did not engage in any allegedly infringing acts beyond the distribution of the motion picture itself, and thus *Rogers* should still apply.

Although the court denied reconsideration, it decided that it would entertain a motion for partial summary judgment by Buena Vista Home Entertainment and Walt Disney Studios limited to whether the *Rogers* test is applicable to their use of Lots-o'-Huggin' Bear.<sup>9</sup>

As of this article, the court has yet to rule on the pending motion. How the court rules on that motion may have important ramifications for practitioners moving forward, as the decision may provide valuable guidance to determine whether some uses of the same mark by the same junior user may fall under *Rogers* while others do not, depending on which goods and services that use is connected to.

These cases emphasize the increased scrutiny given to “expressive works” post-*Jack Daniel's*. Even if to parody or evoke social

commentary, parties should be cautious when referring to others’ marks. Gone are the days where any artistic expression was sufficient to evoke First Amendment protection.

### Looking ahead

While it remains unclear when a use will be found to be use “as a mark,” the decisions outlined herein provide some guidance. Filing a trademark application appears likely to be viewed as an admission that the use is as a source indicator, thus precluding *Rogers*.

However, in the absence of an application, the manner in which the mark is used, by both the plaintiff and the defendant, how it is marketed, whether the use was intended to draw a connection or evoke the original source, and even the types of goods on which the mark appears, can all be used as evidence to determine whether the mark is being used as a source indicator, or is merely expressive.

### Notes:

<sup>1</sup> *Jack Daniel's Properties, Inc. v. VIP Prods. LLC*, 599 U.S. 140, 148 (2023).

<sup>2</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

<sup>3</sup> See *Homevestors of Am., Inc. v. Warner Bros. Discovery*, No. CV 22-1583-RGA, 2023 WL 8826729, at \*1 (D. Del. Dec. 21, 2023) (plaintiff's allegations that defendant's television show “Ugliest House in America” used the mark as a source-identifier found sufficient to defeat motion to dismiss); *Activision Publ'g, Inc. v. Warzone.com, LLC*, No. 2:21-cv-03073-FLA (JCx), 2024 U.S. Dist. LEXIS 66820, at \*12 (C.D. Cal. Apr. 11, 2024) (finding that *Rogers* did not apply to party's use of WARZONE as a source identifier for its video game “Call of Duty: Warzone”); *Belin v. Starz Ent., LLC*, No. 2:21-cv-09586-FWS-PLA, 2024 WL 4720795, at \*16 (C.D. Cal. Sep. 20, 2024) (plaintiff plausibly alleged for purposes of motion to dismiss that defendants used plaintiff's BMF Mark in their television show “BMF” as a trademark).

<sup>4</sup> *Down to Earth Organics, LLC v. Efron*, No. 22-CV-06218 (NSR), 2024 WL 1376532, at \*4 (S.D.N.Y. Mar. 31, 2024).

<sup>5</sup> *McGillvary v. Netflix, Inc.*, No. 2:23-CV-01195-JLS-SK, 2024 WL 3588043, at \*13 (C.D. Cal. July 30, 2024).

<sup>6</sup> *Davis v. Blue Tongue Films*, No. 23-3968, 2024 WL 5182630, at \*2 (9th Cir. Dec. 20, 2024).

<sup>7</sup> *JTH Tax LLC v. AMC Networks Inc.*, 694 F. Supp. 3d 315, 332–33 (S.D.N.Y. 2023).

<sup>8</sup> *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 88 F.4th 125, 139 (2d Cir. 2023).

<sup>9</sup> *Diece-Lisa Indus. v. Disney Enters.*, No. CV 20-09147 TJH (JCx), 2024 WL 5257020 (C.D. Cal. Aug. 1, 2024).

### About the authors



**Hans Mayer (L)** is a litigation partner in **Knobbe Martens’** Los Angeles office and co-chair of the firm’s advertising, media and entertainment practice. He represents clients in district courts throughout the country, as well as before the Trademark Trial and Appeal Board and Patent Trial and Appeal Board. He can be reached at [hans.mayer@knobbe.com](mailto:hans.mayer@knobbe.com). **Jacob Rosenbaum (C)** is a partner in the firm’s Irvine, California, office who assists clients in all aspects of trademark, patent, unfair-competition, copyright and right-of-publicity litigation and enforcement. He can

be reached at [jacob.rosenbaum@knobbe.com](mailto:jacob.rosenbaum@knobbe.com). **Zach Rufa (R)** is an associate in the firm’s Los Angeles office. His practice focuses on disputes relating to trademark, trade secret, domain name, false advertising and unfair-competition matters, as well as all aspects of right-of-publicity and copyright law. He can be reached at [zachery.rufa@knobbe.com](mailto:zachery.rufa@knobbe.com).

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