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## ARTICLES

### DEEPAKES AND DOG TOYS: FIRST AMENDMENT DEFENSES UNDER THE *ROGERS TEST* AFTER *JACK DANIEL'S v. VIP PRODUCTS*

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#### I. INTRODUCTION AND BACKGROUND

On June 8, 2023, the United States Supreme Court issued its unanimous opinion in *Jack Daniel's Properties, Inc. v. VIP Products LLC*,<sup>1</sup> which ruled in favor of whiskey manufacturer Jack Daniel's in its bid to end a humorous knock-off of its Jack Daniel's Old No. 7 brand of Tennessee whiskey in the form of a dog chew toy that co-opted the brand names, marks, trade dress, and logos of the iconic alcohol producer.<sup>2</sup>



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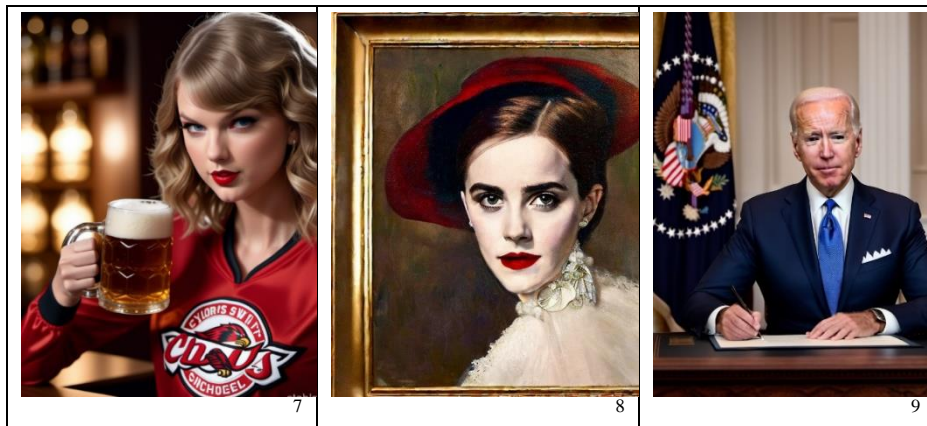
1. *Jack Daniel's Properties, Inc. v. VIP Prod. LLC*, 599 U.S. 140 (2023).

2. *Id.* at 145.

3. Jessica Gresko, *Photograph of Jack Daniel's Old No. 7 whisky bottle alongside Bad Spaniels Old No. 2 dog chew toy, in Beth Treffeisen, Supreme Court case could be the end of parody products, Northeastern expert says*, *NORTHEASTERN GLOBAL NEWS* (Apr. 11, 2023),

In the course of disposing of the case, the *Jack Daniel's* Court reinterpreted, or at least clarified, the proper scope and application of the *Rogers v. Grimaldi*<sup>4</sup> test which, since 1989, has been used as a test of First Amendment-based fair uses in federal trademark law infringement, false endorsement, false designation of origin, and trademark dilution claims, and occasionally in state law name-image-likeness exploitation claims under right of publicity or right of privacy theories. The Court's attention to the *Rogers* test potentially affects the First Amendment fair use analyses in each of these areas of law.

"Deepfake"—a combination of the words "deep learning" and "fake"<sup>5</sup>—is a twenty-first-century term for images, video, and audio recreations of the image and likeness, and sometimes the voice or performance attributes of celebrities, politicians, and other persons.<sup>6</sup> The following images all were created by the author with the assistance of Stable Diffusion, a visual generative Artificial Intelligence (AI) tool.



<https://news.northeastern.edu/2023/04/11/jack-daniels-dog-toy-dispute-supreme-court/>  
[<https://perma.cc/DCV3-XC79>].

4. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

5. New York Inst. of Tech., *Deepfakes: How do they work and what are the risks?*, THE CYBER CORNER (Oct. 26, 2023), [https://blogs.nyit.edu/the\\_cyber\\_corner/deepfakes\\_how\\_do\\_they\\_work\\_and\\_what\\_are\\_the\\_risks](https://blogs.nyit.edu/the_cyber_corner/deepfakes_how_do_they_work_and_what_are_the_risks) [<https://perma.cc/EBR4-LBRJ>].

6. Sara H. Jodka, *Manipulating reality: the intersection of deepfakes and the law*, REUTERS (Feb. 1, 2024, 12:01 PM), <https://www.reuters.com/legal/legalindustry/manipulating-reality-intersection-deepfakes-law-2024-02-01/> [<https://perma.cc/Z54Z-BFB2>].

7. Michael D. Murray, *Image of a Taylor Swift lookalike drinking beer* (Feb. 2024) (image created with the assistance of Stable Diffusion).

8. Michael D. Murray, *Image of an Emma Watson lookalike portrayed in the style of John Singer Sargent* (Feb. 2023) (image created with the assistance of Stable Diffusion).

9. Michael D. Murray, *Image of a President Joe Biden lookalike* (Apr. 2024) (image created with the assistance of Stable Diffusion).

Contemporary generative AI tools for image creation (*e.g.*, DALL-E 3,<sup>10</sup> Midjourney,<sup>11</sup> Stable Diffusion<sup>12</sup>), AI-generated video (*e.g.*, Open AI's Sora,<sup>13</sup> VideoGen,<sup>14</sup>; RunwayML<sup>15</sup>), and AI-generated audio, voice, and musical performance (*e.g.*, Suno,<sup>16</sup> RVC WebUI,<sup>17</sup> Udio,<sup>18</sup> Altered,<sup>19</sup> ElevenLabs<sup>20</sup>), have increased the speed and ease with which people can “fake” the appearances, voices, performances, and actions of real people. Whether one views these generative AI tools as a massive step toward the democratization of creation,<sup>21</sup> or a ridiculously fast and easy way to steal good will from companies, exploit celebrities, interfere with the reporting of facts, or commit a myriad of crimes,<sup>22</sup> the technology is present and only going to improve from where it is today.

Given that deepfakes are almost always associated with expression of some kind, any attempt to litigate or regulate deepfakes will require the consideration of the First Amendment. Deepfakes implicate so many areas of law and society that a discussion of the interface of First Amendment free speech rights and deepfakes writ large would require a treatise volume with several chapters. This article is more modest: It will examine the past, present, and future use of the *Rogers* test in an evaluation of the application of First Amendment protections in trademark infringement cases and in legal actions traditionally associated

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10. DALL-E 3, OPENAI, <https://openai.com/dall-e-3> (last visited Apr. 8, 2024).

11. The current model of Midjourney visual generative AI system is version 6 as of Dec. 20, 2023. See *Midjourney Model Versions*, MIDJOURNEY, <https://docs.midjourney.com/docs/model-versions> [<https://perma.cc/85JP-FXCK>] (last visited Apr. 8, 2024); Barry Collins, *Midjourney 6 Arrives at Last*, TECHFINITIVE (Dec. 22, 2023), <https://www.techfinitive.com/features/midjourney-6-pricing-features-release-date/> [<https://perma.cc/6QDZ-8NW9>].

12. The next model of Stable Diffusion, not yet openly released as of Apr. 8, 2024, is version 3, which was announced on Feb. 22, 2024. *Stable Diffusion 3*, STABILITY AI, <https://stability.ai/news/stable-diffusion-3> [<https://perma.cc/5GR3-Z8XA>] (last visited Apr. 8, 2024).

13. *Creating Video from Text*, OPENAI, <https://openai.com/sora> [<https://perma.cc/9LYL-PBND>] (last visited Apr. 9, 2024).

14. *Create Videos in seconds*, VIDEOGEN, <https://videogen.io/> [<https://perma.cc/2CLF-TLMK>] (last visited Sept. 14, 2024).

15. *Advancing creativity with artificial intelligence*, RUNWAY, <https://runwayml.com/> [<https://perma.cc/GAE5-8XYK>] (last visited Apr. 9, 2024).

16. *Make a song about anything*, SUNO, <https://suno.com/> [<https://perma.cc/VTN3-Q7WR>] (last visited Sept. 7, 2024).

17. *Retrieval-based-Voice-Conversion-WebUI*, RVC-PROJECT, <https://github.com/RVC-Project/Retrieval-based-Voice-Conversion-WebUI> [<https://perma.cc/MG5N-5SJQ>] (last visited Apr. 9, 2024).

18. UDIO, <https://udio.com> [<https://perma.cc/WFH7-NP33>] (last visited Sept. 7, 2024).

19. Altered, *Local Voice Cloning*, <https://www.altered.ai/voice-cloning/> [<https://perma.cc/FQ3Z-9NFL>] (last visited Apr. 9, 2024).

20. *AI Voice Cloning: Clone Your Voice in Minutes*, ELEVENLABS, <https://elevenlabs.io/voice-cloning> [<https://perma.cc/HBE4-8KMJ>] (last visited Apr. 9, 2024).

21. *Democratized Generative AI: Empowering Creativity*, DATACENTERS.COM (Dec. 14, 2023), <https://www.datacenters.com/news/democratized-generative-ai-empowering-creativity#> [<https://perma.cc/C4JD-G4GY>].

22. Jodka, *supra* note 6.

with the exploitation of celebrities, sports figures, other persons under federal trademark theories of false endorsement, false designation of origin, and trademark dilution, and state law theories of right of publicity and right of privacy. In each of these areas of law, the *Rogers* fair use test has been used to evaluate the use or misuse of both trademarks and publicity and privacy rights in a claimant's name, image, or likeness, distinguishing those with true expressive content from those whose exploitation or harm overwhelms the expression in the use.

Part II of this article will examine the *Rogers v. Grimaldi* case and the *Rogers* fair use test. Part III will discuss the *Jack Daniel's* case and its clarification of *Rogers*, particularly with regard to parody defenses. Part IV will explore the past and predict the future of the *Rogers* fair use test in federal trademark infringement, false endorsement, false designation of origin, and trademark dilution claims, as well as claims asserting state law theories of right of publicity and right of privacy.

## II. THE *ROGERS V. GRIMALDI* CASE AND THE *ROGERS* FAIR USE TEST

### A. *The Facts and Outcome of Rogers v. Grimaldi*

*Rogers v. Grimaldi* was a case involving a lawsuit by the actress Ginger Rogers against the director, Federico Fellini, and producer, Alberto Grimaldi, of a motion picture entitled "Ginger e Fred" in Italian ("Ginger and Fred" in English), which was about two Italian cabaret performers who reunited to stage once again their imitation of the famous American dancing duo of Ginger Rogers and Fred Astaire.<sup>23</sup> The movie title referred to the plot of the film where the Italian dancers, called Amelia Bonetti and Pippo Botticella in the movie, had received the nicknames "Ginger and Fred" based on their portrayal of the American dancing stars.<sup>24</sup>

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23. 875 F.2d 994, 996-97 (2nd Cir. 1989).

24. *Id.*



Ginger Rogers on the left and Fred Astaire on the right in a still from the motion picture, *Swing Time*<sup>25</sup>

Movie poster for *Ginger e Fred*<sup>26</sup>

Ginger Rogers claimed that the movie title “*Ginger e Fred*” violated her trademark rights under 15 U.S.C. § 1125(a)(1)(A), which prevents false endorsements and false designations of origin in association with the commercial sale of products and services, and violated her common law right of publicity under Oregon law,<sup>27</sup> because the movie title created a false impression that she endorsed or was involved in the movie, and the producers and director were commercially exploiting her famous name and star power to attract attention, advertising, and viewers for the movie. The United States District Court for the Southern District of New York dismissed her claims, and the United States Court of Appeals for the Second Circuit affirmed.<sup>28</sup>

### B. The Rogers Test

In holding that the movie title was protected by the First Amendment as an artistic expression, the court adopted a two-part test now known as the *Rogers* test to determine whether a First Amendment artistic and expressive work’s use of a trademark or celebrity name, image, or likeness is actionable under the Lanham Act. The test states that an artistic expressive work’s use of a trademark is not actionable (1) unless the use has no artistic relevance to the underlying

25. Photograph of Ginger Rogers and Fred Astaire, in *SWING TIME* (RKO Radio Pictures 1936).

26. *Ginger e Fred* (1986) Italian movie poster, CINEMATERIAL, <https://www.cinematerial.com/movies/ginger-e-fred-i91113/p/rzptdoxf> [<https://perma.cc/H7NX-RQS5>] (last visited Jul. 3, 2023).

27. *Rogers*, 875 F.2d at 1002 (citing *Anderson v. Fisher Broadcasting Cos.*, 712 P.2d 803, 812 (Ore. 1986)).

28. *Id.* at 997, 1005.

work whatsoever, or (2) if it has some artistic relevance, unless the use explicitly misleads as to the source or the content of the work.<sup>29</sup>

Appellant Rogers had framed her claim as pertaining to the title of the Fellini film, and so the court of appeals framed its discussion around whether the title of an expressive artistic work has no artistic relevance to the underlying work or misleads as to the source or content of the work.<sup>30</sup> The court recognized that First Amendment expressive and artistic works are meant to be sold for profit, and the titles of such works are of a “hybrid nature, combining artistic expression and commercial promotion.”<sup>31</sup> “The title of a movie may be both an integral element of the filmmaker’s expression and a significant means of marketing the film to the public.”<sup>32</sup> The court found that neither prong of its test was satisfied in this case because the movie title had some artistic relevance to the movie’s plot and theme, and it did not explicitly mislead consumers into thinking that Ms. Rogers endorsed or appeared in the movie.<sup>33</sup>

The *Rogers* court also applied its two-part test to the Oregon common law right of publicity claims brought by Ms. Rogers.<sup>34</sup> Right of publicity claims overlap federal trademark claims in the areas of false endorsement and false designation of origin because the rights protected by both areas of law and the contexts in which the claims arise are very similar.<sup>35</sup> The common law right of publicity, which multiple states have recognized,<sup>36</sup> customarily grants celebrities an exclusive right to control the commercial value of their names and to prevent others from exploiting them without permission, thus matching the “exploitation in a commercial setting” claims of trademark law, false endorsement, and false designation of origin.<sup>37</sup> One notable difference between right of publicity claims and trademark claims is that the right of publicity has no likelihood of confusion requirement, so it is potentially more expansive than the Lanham Act.<sup>38</sup>

The first prong of the *Rogers* test is very similar to the test in Section 47 of the right of publicity provisions of the Restatement of Unfair Competition.<sup>39</sup> Section 47 of the Restatement provides that the First Amendment protects the use of a person’s identity in an expressive work unless the “name or likeness is used solely to attract attention to a work that is not related to the identified

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29. *Id.* at 999.

30. *See generally id.* at 996-1000.

31. *Id.* at 998.

32. *Id.*

33. *Id.*

34. *Id.* at 1004-05.

35. *See generally* MICHAEL D. MURRAY, RIGHT OF PUBLICITY IN A NUTSHELL ch. 8 (2d ed. 2022).

36. *See id.*, app. A.

37. *Rogers*, 875 F.2d at 1003-04 (citing *Bi-Rite Enterprises v. Button Master*, 555 F. Supp. 1188, 1198-99 (S.D.N.Y. 1983)).

38. *Id.* at 1004.

39. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (AM. L. INST. 1995).

person.”<sup>40</sup> In the *Rogers* case, the court interpreted the first and second prongs of its fair use test to mean that, in right of publicity claims, the use of a celebrity’s name in the title of an expressive artistic work will not be barred unless the title was “wholly unrelated” to the content and meaning of the work or was “simply a disguised commercial advertisement for the sale of goods or services” including the expressive work itself.<sup>41</sup>

### C. *Rogers*’s Application to Deepfakes

The expressive nature of deepfakes, whether in trademark law or right of publicity or right of privacy situations implicates the protections of the First Amendment. As discussed in Section IV below, for almost thirty-five years, *Rogers* has been used to evaluate the applicability and enforcement of the Lanham Act in cases involving the use of a mark in expressive works and as a test of fair use in trademark false endorsement and false designation of origin claims and in state common law and statutory right of publicity and right of privacy claims, primarily those being litigated in a federal court either under diversity or supplemental jurisdiction.<sup>42</sup> Although *Rogers* is controlling authority only in the Second Circuit when applied in trademark claims arising under federal law, the role of the *Rogers* test in trademark litigation is more broadly endorsed in the legislative history of the Lanham Act’s latest amendment, the Trademark Modernization Act of 2020, which states that the *Rogers* test appropriately recognizes the primacy of constitutional protections for free expression.<sup>43</sup> The Judiciary Committee report went on to state, “In enacting this legislation, the Committee intends and expects that courts will continue to apply the *Rogers* standard to cabin the reach of the Lanham Act in cases involving expressive works.”<sup>44</sup>

*Rogers* has been cited—although not always followed—by all eleven circuits and the federal circuit.<sup>45</sup> In addition to the Second Circuit where the case was issued, *Rogers* has been officially adopted and applied by the Third

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40. *Id.*

41. *Rogers*, 875 F.2d at 1004-05.

42. *E.g.*, *Parks v. Laface Recs.*, 329 F.3d 437, 461 (6th Cir. 2003); *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 936 (6th Cir. 2003); *Seale v. Gramercy Pictures*, 964 F. Supp. 918, 930 (E.D. Pa. 1997).

43. H.R. REP. NO. 116-645, at 20 (2020). *See* *MGFB Properties, Inc. v. Viacom Inc.*, 54 F.4th 670, 679 (11th Cir. 2022).

44. *Id.*

45. This count is based on the Westlaw citing references for *Rogers*. Several of these citations are for a choice of law holding in *Rogers*, 875 F.2d at 1002: “In cases based on diversity of citizenship or on pendent jurisdiction, the federal district court must apply the forum state’s choice-of-law rules.” *E.g.*, *Spain v. Haseotes*, 116 F.3d 464 (1st Cir. 1997).

Circuit,<sup>46</sup> Fourth Circuit,<sup>47</sup> Fifth Circuit,<sup>48</sup> Sixth Circuit,<sup>49</sup> Ninth Circuit,<sup>50</sup> and Eleventh Circuit.<sup>51</sup> Courts have held that the *Rogers* test is not limited to the use of a trademark or a person's name in the title of a work, but applies more generally as a test of fair use for any use of marks or names, images, or likenesses in the content of the work.<sup>52</sup> Although it would be inaccurate to say that *Rogers* has become the dominant test for fair use in right of publicity or right of privacy claims in any one jurisdiction,<sup>53</sup> it has been used regularly by six federal appellate circuits in addition to the Second Circuit from which the case arose.<sup>54</sup>

### III. THE *JACK DANIEL'S* CASE AND ITS CLARIFICATION OF *ROGERS*

The events that led up to *Jack Daniel's* were that Respondent VIP Products produced, advertised, and sold a squeaky, chewable dog toy designed to look like a bottle of Jack Daniel's whiskey.<sup>55</sup> The Respondent's dog toy version of a Jack Daniel's whiskey bottle had a very similar label to the iconic brand's label, but on the dog toy, the words "Jack Daniel's" became "Bad Spaniels," and "Old No. 7 Brand Tennessee Sour Mash Whiskey" was turned into "The Old No. 2 On Your Tennessee Carpet."<sup>56</sup> It is important to note that the dog toy featured these altered Jack Daniel's marks on its own product labels and tags as trade dress and marks of its own product.<sup>57</sup> In other words, VIP had used variations

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46. *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996), *aff'd without opinion*, 156 F.3d 1225 (3d Cir. 1998). *But see* *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 158 (3d Cir. 2013) (declining to apply *Rogers* in favor of the transformative test); *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008) (declining to apply *Rogers* because expression in case was deemed to be commercial speech).

47. *Radianc Found., Inc. v. N.A.A.C.P.*, 786 F.3d 316, 322, 329 (4th Cir. 2015).

48. *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664-65 (5th Cir. 2000).

49. *Parks v. LaFace Recs.*, 329 F.3d 437, 450 (6th Cir. 2003); *Moore v. Weinstein Co., LLC*, 545 F. App'x 405, 412 (6th Cir. 2013); *see also* *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 936-37 (6th Cir. 2003) (applying both *Rogers* and the transformative test).

50. *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

51. *See* *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012); *MGFB Properties, Inc. v. Viacom Inc.*, 54 F.4th 670, 678 (11th Cir. 2022).

52. *E.g.*, *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989).

53. No single fair use test has emerged as "the" dominant fair use test for right of publicity, false endorsement, or false designation of origin claims. *See* MURRAY, RIGHT OF PUBLICITY IN A NUTSHELL, *supra* note 35, at 129, 140-42; Robert C. Post & Jennifer E. Rothman, *The First Amendment and the Right(s) of Publicity*, 130 YALE L.J. 86, 130-32 (2020).

54. MURRAY, RIGHT OF PUBLICITY IN A NUTSHELL, *supra* note 35, at 150, 167-77. *See* *Protection of Artistic Expression from Lanham Act Claims Under Rogers v. Grimaldi*, 22 A.L.R. Fed. 3d Art. 4 (2017).

55. *Jack Daniel's Properties, Inc. v. VIP Prod. LLC*, 599 U.S. 140, 144 (2023).

56. *Id.*

57. *Id.* at 149-51.



of the famous and valuable Jack Daniel's marks and trade dress *as* marks and trade dress in the display and advertising of its own product.<sup>58</sup>

VIP's verbal jokes and wordplay did not amuse petitioner Jack Daniel's Properties, who owns valuable trademarks in the distinctive shape and design trade dress of the Jack Daniel's bottle and in many of the words and the arrangement of words and graphics on its label.<sup>59</sup> Jack Daniel's sued and had success at the trial level,<sup>60</sup> but the Ninth Circuit discounted the iconic brand owner's arguments on both the application of the *Rogers* test and the merits of VIP's alleged parody of Jack Daniel's and reversed and remanded the case.<sup>61</sup> On remand, the trial court awarded judgment to VIP,<sup>62</sup> and the Ninth Circuit summarily affirmed the judgment.<sup>63</sup>

At the United States Supreme Court, the Court considered both the application of *Rogers* and the merits of VIP's alleged parody defense. Apropos to this discussion, the Court made a definitive statement early in the case that sought to put *Rogers* in its place, meaning that the Court declared that *Rogers* had absolutely no application to the facts and circumstances of VIP's use of Jack Daniel's marks:

Today, we choose a narrower path. Without deciding whether *Rogers* has merit in other contexts, we hold that it does not when an alleged infringer uses a trademark in the way the Lanham Act most cares about: as a designation of source for the infringer's own goods. *See* [15 U.S.C.] § 1127; *supra*, [143 S. Ct.] at 1582-1583. VIP used the marks derived from Jack Daniel's in that way, so the infringement claim here rises or falls on likelihood of confusion.<sup>64</sup>

The Court proceeded to analyze the case strictly as a trademark infringement "likelihood of confusion" analysis and a trademark dilution analysis.<sup>65</sup> In what may become the more important holding of the case, the Court declared that the parody defense in trademark dilution claims does not apply or does not exculpate a diluter from liability if the diluter has used the plaintiff's mark in the diluter's own mark; in other words, when the diluter used the plaintiff's mark as an identifier of the source or origin of the diluter's own goods, parody will not excuse this use.<sup>66</sup> Given the overlap in federal trademark and state and

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58. *Id.*

59. *Id.* at 145, 148.

60. VIP Prods., LLC v. Jack Daniel's Prods., Inc., No. CV-14-2057-PHX-SMM, 2016 WL 5408313, at \*1 (D. Ariz. Sept. 27, 2016).

61. VIP Prods. LLC v. Jack Daniel's Prods., Inc., 953 F.3d 1170 (9th Cir. 2020).

62. VIP Prods. LLC v. Jack Daniel's Prods. Inc., No. CV-14-02057-PHX-SMM, 2021 WL 5710730, at \*2 (D. Ariz. Oct. 8, 2021).

63. VIP Prods. LLC v. Jack Daniel's Prods. Inc., No. 21-16969, 2022 WL 1654040, at \*1 (9th Cir. Mar. 18, 2022).

64. *Jack Daniel's*, 599 U.S. at 153.

65. *Id.*

66. *Id.*

common law right of publicity and right of privacy claims,<sup>67</sup> the thrust of this holding in *Jack Daniel's* may be extended to chip away at the right of publicity's and right of privacy's own parody defense.

#### A. Jack Daniel's *Clarification of the Rogers Test*

The *Jack Daniel's* case did not so much reinterpret or limit the scope of the *Rogers* test as declare that the *Rogers* case never applied to uses of a plaintiff's mark as part of the alleged infringer's marks or identifiers of its own goods.<sup>68</sup> The Court said quite plainly that *Rogers* already was "cabined" off from trademark situations involving a defendant's trademark use of a plaintiff's mark, even if the defendant's use arose in the context of artistic or literary expression.<sup>69</sup> *Rogers*, the Court said, only applied—and presumably continues to apply—to "non-trademark uses" in which "the defendant has used the mark at issue in a non-source-identifying way."<sup>70</sup> And the Court reiterated that a disqualified "source-identifying" use might well arise in the midst of First Amendment expression because many of those uses will involve the expression of some idea such as humor or ironic commentary—and still, *Rogers* will not apply.<sup>71</sup>

It is important to note at this juncture that this holding of the Court is not a novel interpretation of *Rogers*. Courts have previously drawn the distinction in the coverage of the trademark laws and the protections of the First Amendment and limited the applicability of *Rogers* to expressive, non-source-identifying uses: "[W]hen unauthorized use of another's mark is part of a communicative message and not a source identifier, the First Amendment is implicated in opposition to the trademark right."<sup>72</sup> "Were we to ignore the expressive value that some marks assume, trademark rights would grow to encroach upon the zone protected by the First Amendment,"<sup>73</sup> but "[t]he First Amendment may offer little protection for a competitor who labels its commercial good with a confusingly similar mark."<sup>74</sup> "[T]rademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view."<sup>75</sup> "Simply put, the trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function."<sup>76</sup>

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67. MURRAY, RIGHT OF PUBLICITY IN A NUTSHELL, *supra* note 35, ch. 8.

68. *Jack Daniel's*, 599 U.S. at 153-57.

69. *See id.* at 155, 158.

70. *Id.* at 155-56.

71. *Id.* at 159.

72. *Yankee Publ'g, Inc. v. News Am. Publ'g, Inc.*, 809 F. Supp. 267, 276 (S.D.N.Y. 1992).

73. *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (quoting *Yankee Publ'g*, 809 F. Supp. at 276).

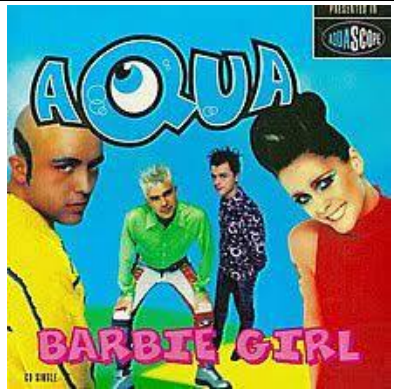
74. *Id.* (quoting *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987)).

75. *Id.*

76. *Id.* at 900-01 (quoting *Anti-Monopoly, Inc. v. Gen. Mills Fun Grp.*, 611 F.2d 296, 301 (9th Cir.1979) ("It is the source-denoting function which trademark laws protect, and nothing more.")).

The observation that *Rogers* will not be applied to source-identifying uses but will be applied to non-source identifying expressive uses is noteworthy for deepfakes because, in many instances, deepfakes are not used as marks or source indications of the deepfake creator, the deepfake image or recording itself, or any other separate product or service. At least for this analysis, deepfakes often are pure speech, revealing an expressive message or at least expressive content, and not linked in a source-identifying manner to the creator or to a separate service or product. The effect or harm caused by a deepfake might be confusion, but not necessarily *consumer* confusion caused by a misleading or deceptive source-identifying use.



The *Jack Daniel's* Court cited and discussed several federal appellate and trial court cases in support of its proclamation that *Rogers* never applied to “source-identifying” uses in expressive contexts:

| The Supreme Court’s list of cases on the applicability of <i>Rogers</i> in non-source-identifying uses and inapplicability in source-identifying uses   |   |
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|  <p>The image shows the CD cover for Aqua's song 'Barbie Girl'. The cover features the band members in colorful outfits (yellow, green, black, red) against a blue background. The word 'AQUA' is written in large, stylized blue letters at the top, and 'BARBIE GIRL' is written in pink letters at the bottom. A 'PRIORITY THE MCA SCORE' logo is in the top right corner.</p> | <p><i>Mattel, Inc. v. MCA Records, Inc.</i>, (9<sup>th</sup> Cir. 2002)<sup>78</sup>: The Supreme Court in <i>Jack Daniel's</i> explained that <i>Rogers</i> protected the band Aqua’s hit song, “Barbie Girl,” with a title and lyrics that made explicit mention of Mattel’s “Barbie”-trademarked doll franchise, because Aqua had not used the mark “Barbie” in a source-identifying manner.<sup>79</sup> This was found despite the words “Barbie Girl” being used on the actual cover of a release of the song, <i>i.e.</i>, in a manner suggesting a trade dress use (<i>see</i> image at left). The finding of a non-source-identifying use allowed <i>Rogers</i> to apply and led to the outcome that Aqua’s use of “Barbie” was artistically relevant to its musical expression, and not explicitly misleading as to the source or content of the work. <i>Mattel v. MCA</i> was a true parody case, as MCA asserted that both the title and the lyrics were intended to spoof the iconic status of Barbie that Mattel had worked so hard to construct and preserve.</p> |

77. *Barbie Girl* (photograph), in *Barbie Girl*, WIKIPEDIA, [https://en.wikipedia.org/wiki/Barbie\\_Girl](https://en.wikipedia.org/wiki/Barbie_Girl) [https://perma.cc/3UKP-V4T3] (last visited Sept. 8, 2023).

78. *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894 (9th Cir. 2002).

79. *Id.* at 902.

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|  <p style="text-align: right;">80</p>  | <p>Although not the subject of a lawsuit, the Supreme Court declared that <b>Janis Joplin’s song, “Mercedes Benz,”</b> with its repeated line, “Oh Lord, won’t you buy me a Mercedes Benz,” was a perfect situation of a non-source-identifying use wherein no one would think that the German car maker had formed a joint venture or direct sponsorship of Ms. Joplin and her music just from the title and lyrics of this song.<sup>81</sup> Neither the title nor the lyrics appeared critical of the car maker in a parody sense, but they simply were not used by Joplin in a “source-identifying” manner to promote her own music or other recordings.</p> |
|  <p style="text-align: right;">82</p> | <p><i>University of Alabama Board of Trustees v. New Life Art, Inc.</i> (11<sup>th</sup> Cir. 2012)<sup>83</sup> : Artist Daniel Moore’s paintings depicting great moments in Alabama football history were protected by <i>Rogers</i> because Moore did not use the Crimson Tide’s uniforms, logos, or marks in a source-identifying manner, and the marks were directly related to the historical message and artistic expression he was communicating in the paintings. There was no parody aspect to this case, as Moore’s homage to the team was entirely honorific.</p>   |

80. *Mercedes Benz* (photograph), in Janis Joplin’s “Mercedes Benz,” SPOTIFY, <https://open.spotify.com/track/3VI2E53C131jvkbQ3P2f3S> [<https://perma.cc/RF84-XHFT>] (last visited Sept. 8, 2023).

81. *Jack Daniel’s Properties, Inc. v. VIP Prod. LLC*, 599 U.S. 140, 143 (2023).

82. Daniel A. Moore, *The Blowout* (painting), in Eric Kelderman, *Appeals Court Stiff-Arms U. of Alabama’s Lawsuit Against Football Artist*, CHRON. HIGHER ED. (Jun. 12, 2012), <https://www.chronicle.com/article/appeals-court-stiff-arms-u-of-alabamas-lawsuit-against-football-artist/> [<https://perma.cc/N2XJ-SBBZ>].

83. *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1279 (11th Cir. 2012).

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|  <p style="text-align: right;">84</p>   | <p><b><i>Louis Vuitton Malletier S. A. v. Warner Bros. Entertainment Inc.</i></b> (S.D.N.Y. 2012)<sup>85</sup>: A character’s line in <i>The Hangover: Part II</i> movie referencing “Louis Vuitton” luggage (pronounced “Lewis”), and a character apparently carrying a Diophy knock-off Louis Vuitton bag in a scene in the movie, all were protected by <i>Rogers</i> as being non-source-identifying uses of the Louis Vuitton marks. These uses were found to be artistically relevant to the expression of the movie and not explicitly misleading as to the source or content of the work. Louis Vuitton argued that the uses were a misleading promotion of the Diophy knock-off bag that appeared in the movie because it was referred to as being a genuine Louis Vuitton bag, but the court rejected this argument. Arguably, the use of the brand’s name, mispronounced in a foolish and uninformed manner, made the brand the target of the film’s irreverent commentary on arrogant brands and the people who covet them, but the court did not characterize the use as a parody in applying the <i>Rogers</i> test to exempt the use from the manufacturer’s infringement claim.</p> |
|  <p style="text-align: right;">86</p> | <p><b><i>United We Stand Am., Inc. v. United We Stand, Am. New York, Inc.</i></b> (2d Cir. 1997)<sup>87</sup>: <i>Rogers</i> afforded no protection to the defendant, a New York based Ross Perot-supporting split-off group, because defendant used the mark “United We Stand America” in a source-identifying manner for its own services.</p>  |

84. Scene from THE HANGOVER: PART II, in Ben Child, *Louis Vuitton hits The Hangover Part II with a handbag lawsuit*, THE GUARDIAN (Dec. 23, 2011), <https://www.theguardian.com/film/2011/dec/23/louis-vuitton-hangover-part-2> [<https://perma.cc/FK2N-VPBH>].

85. *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172, 180 (S.D.N.Y. 2012).

86. Photograph of book cover, in *United We Stand America: President of the United States, Ross Perot, U.S. Presidential Election 1992, Texas, Populism*, AMAZON.FR (June 2010), <https://www.amazon.fr/United-Stand-America-President-Presidential/dp/6130484216> [<https://perma.cc/4TX9-JD5L>].

87. *United We Stand Am., Inc. v. United We Stand, Am. New York, Inc.*, 128 F.3d 86, 93 (2d Cir. 1997).

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|  <p style="text-align: right;">88</p>  | <p><i>Harley-Davidson, Inc. v. Grottanelli</i> (2d Cir. 1999)<sup>89</sup>: The Hog Farm motorcycle shop’s adaptation and use of Harley-Davidson’s bar and shield logo in its own business logo was held to be a trademark source-identifying use of the venerable motorcycle company’s mark and did not receive protection from <i>Rogers</i>. The Second Circuit stated that it “accorded considerable leeway to parodists whose expressive works aim their parodic commentary at a trademark or a trademarked product,”<sup>90</sup> but not in the context of a manufacturer’s “using an alleged parody of a competitor’s mark to sell a competing product.”<sup>91</sup></p> |
|  <p style="text-align: right;">92</p> | <p><i>Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC</i> (S.D.N.Y. 2002)<sup>93</sup>: The court did not apply <i>Rogers</i> to the situation where Nature Labs sold pet cologne under the name “Timmy Holedigger” and thereby used the Tommy Hilfiger mark and a modified split two-color trade dress in a source-identifying manner in its own mark and trade dress. But the court ultimately found that Timmy Holedigger was a parodic send-up of the famous cologne brand, and that Tommy Hilfiger had not brought forward sufficient evidence of consumer confusion and granted Nature Lab’s motion for summary judgment.</p>  |

The Supreme Court drew its conclusions from the above and other cases<sup>94</sup> and found that the expressive nature of the products at issue in these cases, and what they might have had to say *about* the brands whose marks they were adapting for their own marks, did not tip the scales in favor of the defendants—

88. Photograph of The Hog Farm motorcycle shop logo, in The Hog Farm, Custom Motorcycle Shop, Since 1969, *WELCOME to THE HOG FARM*, FACEBOOK (Nov. 10, 2014), <https://www.facebook.com/TheHogFarmCustomMotorcycleShop1969/photos/a.263884140426662/423931444421930/> [<https://perma.cc/V4ZR-W23X>].

89. *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812-13 (2d Cir. 1999).

90. *Id.* at 812 (citing *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 493-95 (2d Cir.1989)).

91. *Id.* (citing *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39 (2d Cir.1994)).

92. Photograph of Timmy Holedigger Dog Spray, in *Timmy Holedigger Dog Spray*, GOTDOG.COM, <https://gotdog.com/products/timmy-holedigger> [<https://perma.cc/LV78-AC95>] (last visited Sept. 8, 2023).

93. *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 412-14 (S.D.N.Y. 2002).

94. The Supreme Court also cited: *Matal v. Tam*, 582 U.S. 218, 245, 252 (2017); *Friedman v. Rogers*, 440 U.S. 1, 15 (1979); *Yankee Publ’g Inc. v. News Am. Publ’g Inc.*, 809 F. Supp. 267, 276 (S.D.N.Y. 1992).

at least as an initial inquiry before the evaluation of the elements of trademark or trade dress infringement or dilution. Thus, even allowing that VIP's Bad Spaniels was a send-up and spoof of Jack Daniel's very serious whiskey drinking brand, in the same manner that Timmy Holedigger was a send-up and spoof of the concept of Tommy Hilfiger's fine cologne when you turn it around and spray it on a dog, the Supreme Court said the context alone of a source-identifying use was enough to disqualify the application of the *Rogers* test as a threshold issue (*i.e.*, at the motion to dismiss or summary judgment stage) before the evaluation of the infringement factors in both *Jack Daniel's* and *Tommy Hilfiger*. As noted in the table above, Timmy Holedigger ultimately was accepted as a parody fair use absolving the user for infringement, but, as noted in the section below, Bad Spaniels missed out on that absolution.

#### A. Jack Daniel's *Limitation of the Parody Defense in Trademark Claims*

The Supreme Court took a harsh approach regarding the argument that Bad Spaniels was a parody of Jack Daniel's whiskey. Even allowing that the VIP brand quite obviously took a serious adult beverage company and put its trade dress into the mouths of dogs, the Court would not embrace the parody defense argued by VIP and practically ordered on remand that the lower court find against VIP.<sup>95</sup> Beyond *Tommy Hilfiger* discussed above, the Supreme Court cited only one additional trademark parody case, *Louis Vuitton Malletier S.A. v. Haute Diggity Dog*,<sup>96</sup> when evaluating the Ninth Circuit's opinion in *VIP v. Jack Daniel's*.<sup>97</sup> The Ninth Circuit had held that the parody and artistic expression present in VIP's use called for a threshold analysis of the First Amendment as applied through the *Rogers* test.<sup>98</sup> The Supreme Court reversed the Ninth Circuit, stating, "[P]arody (and criticism and commentary, humorous or otherwise) is exempt from liability only if *not* used to designate source."<sup>99</sup> The irony (or perhaps the criticism) here is that Haute Diggity Dog, LLC used its parody versions of the Louis Vuitton marks and trade dress—Chewy Vuiton—on its own product in much the same way that VIP used the modified Old No. 7 label and trade dress, as a label and identifier of its commercially sold products.

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95. *Jack Daniel's Properties, Inc. v. VIP Prod. LLC*, 599 U.S. 140, 163 (2023).



96. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 265 (4th Cir. 2007).

97. *VIP Prods. LLC v. Jack Daniel's Props., Inc.*, 953 F.3d 1170, 1175-76 (9th Cir. 2020).

98. *See generally id.*

99. *Jack Daniel's*, 599 U.S. at 162.



| Chewy Vuitton dog product and Louis Vuitton bag   | Jack Daniel's and Bad Spaniels' products   |
|---|--|
|  <p style="text-align: right;">100</p>  <p style="text-align: right;">101</p> |  <p style="text-align: right;">102</p> |

The *Jack Daniel's* case did not preclude the consideration of the substantive effect of an attempted parody in evaluating the *Rogers* test in a trademark or trade dress infringement or a trademark dilution case but limited the consideration to the context of the infringement analysis itself wherein the parodic nature of a work that spoofs or ridicules the plaintiff's marks or products could mitigate or eliminate any likelihood of confusion over the two uses. The application of the *Rogers* test at the infringement stage is similar to how *Rogers* and other First Amendment balancing tests are used in right of publicity and right of privacy cases when a parody defense is asserted<sup>103</sup>—the parody is weighed for its relevant and valuable comment and criticism of the person that might overcome the publicity or privacy right of the person unless the use is overly exploitative or commercialized (*i.e.*, the use becomes less about the

100. Photograph of Chewy Vuitton dog bed, in *Chewy Vuitton Dog Bed*, DOG PET BOUTIQUE, <https://dogpetboutique.com/chewy-vuitton-dog-bed/> [https://perma.cc/96Y9-97TP] (last visited Sep. 13, 2023).

101. Photograph of Louis Vuitton handbag, in *OnTheGo MM*, LOUIS VUITTON, [https://us.louisvuitton.com/images/is/image/lv/1/PP\\_VP\\_L/louis-vuitton-onthego-mm-monogram-handbags--M45321\\_PM2\\_Front%20view.png?wid=1090&hei=1090](https://us.louisvuitton.com/images/is/image/lv/1/PP_VP_L/louis-vuitton-onthego-mm-monogram-handbags--M45321_PM2_Front%20view.png?wid=1090&hei=1090) [https://perma.cc/6UCW-M8F5] (last visited Sept. 15, 2024).

102. Gresko, *supra* note 3.

103. *See, e.g., In re Tam*, 808 F.3d 1321, 1373 (Fed. Cir. 2015) (Dyk, J., concurring), *as corrected* (Feb. 11, 2016), *aff'd sub nom. Matal v. Tam*, 582 U.S. 218 (2017); *Moore v. Weinstein Co.*, 545 F. App'x 405, 409, 412 (6th Cir. 2013) (citing *Rogers* and RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1277 (11th Cir. 2012); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 810-12 (9th Cir. 2003).



commentary or criticism and much more about attracting attention for commercial purposes).<sup>104</sup>

The Second Circuit in the *Vans v. MSCHF* case (discussed below) summarized *Jack Daniel's* holding on evaluating a parody defense under the *Rogers* test only at the infringement stage as follows:

Far from disregarding the parodic nature of the Bad Spaniel's toy, however, the Supreme Court noted that “a trademark's expressive message—particularly a parodic one ... — may properly figure in assessing the likelihood of confusion.” *Id.* at 161, 143 S.Ct. 1578; *see also id.* at 159, 143 S.Ct. 1578 (noting that “the likelihood-of-confusion inquiry does enough work to account for the interest in free expression”). This is because, where a message of “ridicule or pointed humor” is clear, “a parody is not often likely to create confusion” for “consumers are not so likely to think that the maker of a mocked product is itself doing the mocking.” *Id.* at 161, 153, 143 S.Ct. 1578; *see id.* at 161, 143 S.Ct. 1578 (“[A]lthough VIP's effort to ridicule Jack Daniel's does not justify use of the *Rogers* test, it may make a difference in the standard trademark analysis.”).<sup>105</sup>

Cases prior to *Jack Daniel's*, particularly in the Ninth Circuit, had inserted the *Rogers* analysis as a threshold test of First Amendment expressive uses of marks and trade dress in which a defendant might avoid the full infringement or dilution analysis altogether and be dismissed or granted summary judgment on the plaintiff's infringement or dilution claims.<sup>106</sup> This, of course, would be favored by defendants who want to avoid the cost of litigating the fact-intensive trademark infringement factors, which, in many cases, preclude dismissal or summary judgment in the case.<sup>107</sup>

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104. *See, e.g., Moore*, 545 F. App'x at 409 (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c); *New Life Art, Inc.*, 683 F.3d at 1277; *Mattel*, 353 F.3d at 810-12; *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 937-38 (6th Cir. 2003); *Cardtoons, L.C. v. Major League Baseball Players Assoc.*, 95 F.3d 959, 969, 972-74 (10th Cir. 1996); *Hoffman v. Cap. Cities/ABC, Inc.*, 255 F.3d 1180, 1183-85 (9th Cir. 2001).

105. *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 88 F.4th 125, 137-38 (2d Cir. 2023) (inner citations presented as in original).

106. *E.g., Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 461-62 (9th Cir. 2020) (citing *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1198 (9th Cir. 2017)); *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099-1100 (9th Cir. 2008); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013)); *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1015 (3d Cir. 2008). *Cf. Parks v. LaFace Recs.*, 329 F.3d 437, 447-48 (6th Cir. 2003) (engaging in First Amendment analysis and application of *Rogers* in the context of cross-motions for summary judgment).

107. *E.g., Dorpan, S.L. v. Hotel Melia, Inc.*, 728 F.3d 55, 66 (1st Cir. 2013); *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1075 (9th Cir. 2006); *AHP Subsidiary Holding Co. v. Stuart Hale Co.*, 1 F.3d 611, 616 (7th Cir. 1993); *Country Floors, Inc. v. P'ship. Composed of Gepner & Ford*, 930 F.2d 1056, 1063 (3d Cir. 1991).

It is true that trademark parody has had a topsy-turvy reception in courts, particularly since the enactment of federal trademark dilution law, 15 U.S.C. §1125(c), in 1996. Before the enactment of the federal dilution law, courts adjudicating trademark parody cases would entertain a bona fide attempt to ridicule or criticize a brand and what it stands for as a First Amendment defense to an infringement or false designation of origin claim,<sup>108</sup> although many such defenses still failed.<sup>109</sup> After the enactment of the dilution law, the success of parody as a First Amendment defense or avoidance of a dilution claim depends on the defendant's ability to overcome the argument that every parody, no matter how clever or humorous, runs the risk of blurring or tarnishing the famous brand that is the target of the parody.<sup>110</sup>

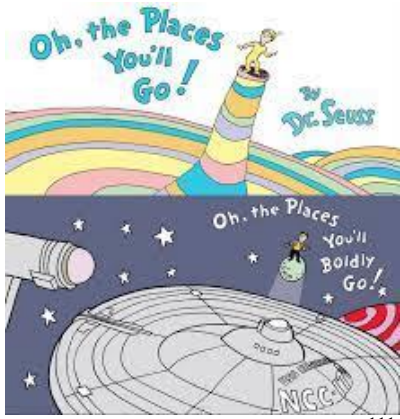

The Ninth Circuit established the track record for trademark and artistic expression cases that applied the *Rogers* test as a threshold test for applicability of the Lanham Act to the allegedly infringement trademark use: if the test applied and the two prongs were evaluated in the junior user's favor, the case ended on dismissal or summary judgment.

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108. *See, e.g.*, *Anheuser-Busch, Inc. v. L. & L. Wings, Inc.*, 962 F.2d 316, 321-22 (4th Cir. 1992); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989); *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1486-87 (10th Cir. 1987).

109. *E.g.*, *S. F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 541 (1987), *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 776 (8th Cir.1994); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir.1987); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979).

110. *E.g.*, *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 764 F. App'x 39, 41 (2d Cir. 2019); *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 112-13 (2d Cir. 2009); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 266-67 (4th Cir. 2007); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 812 (9th Cir. 2003); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 28-30 (1st Cir. 1987) (state dilution claim).

| <b>Ninth Circuit trademark cases affected by <i>Jack Daniel's</i></b>  |  |
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|  <p style="text-align: right;">111</p>  | <p><i>Dr. Seuss Enters., L.P. v. ComicMix LLC</i> (9th Cir. 2020)<sup>112</sup>: Although the copyright claims predominated in this case, the court did apply <i>Rogers</i> in a preliminary determination of whether the Lanham Act trademark claims raised by Dr. Seuss Enterprises even applied to ComicMix’s artistic work. The court found that they did not, and affirmed the dismissal of these claims. Given the fact that ComicMix used the Dr. Seuss title (“Oh, the Places You’ll Go”) and font in its own title, in what can arguably be called a “trademark use,” the case is called into question by <i>Jack Daniel's</i>, and it has been labeled as “abrogated” by the <i>Punchbowl, Inc. v. AJ Press</i><sup>113</sup> case (discussed below).</p>                                      |
|  <p style="text-align: right;">114</p> | <p><i>Twentieth Century Fox Television v. Empire Distrib., Inc.</i> (9th Cir. 2017)<sup>115</sup>: The Ninth Circuit applied <i>Rogers</i> to quash the trademark infringement and trademark dilution claims that a real-life record distributor asserted against Fox’s fictional recording industry television show, “Empire.” The use of the plaintiff’s mark “Empire” in the title and content of the show was held to be artistically relevant and not explicitly misleading. But given the fact that Fox used the Empire Distribution’s trademark in the title of the television series in what can arguably be called a “trademark use,” the case is called into question by <i>Jack Daniel's</i>, and it has been labeled as “abrogated” by <i>Punchbowl, Inc. v. AJ Press</i>.<sup>116</sup></p> |

111. Photograph comparing the Dr. Seuss work and the ComixMix work, in Ethan Schow, *Oh the Places Fair Use Can Boldly Go*, BYU COPYRIGHT LICENSING OFF. (May 11, 2020, 6:32 PM), <https://copyright.byu.edu/star-trek-ii-the-wrath-of-dr-seuss> [https://perma.cc/TM4M-JHLM].

112. *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 461-62 (9th Cir. 2020).

113. *Punchbowl, Inc. v. AJ Press, LLC (Punchbowl II)*, 90 F.4th 1022 (9th Cir. 2024).

114. Promotional image for the television show “Empire”, in *Empire season 1*, WIKIPEDIA, [https://en.wikipedia.org/wiki/Empire\\_%28season\\_1%29](https://en.wikipedia.org/wiki/Empire_%28season_1%29) [https://perma.cc/A27R-AU4P] (last visited Aug. 23, 2024).

115. *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192 (9th Cir. 2017).

116. *Punchbowl II*, 90 F.4th at 1022.

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|  <p>117</p>   | <p><i>Gordon v. Drape Creative, Inc.</i> (9th Cir. 2018)<sup>118</sup>: This case concerns the dispute over the “Honey Badger Don’t Give a Sh*t” greeting card between Steven Gordon, creator of the viral “Honey Badger” video series, and Drape Creative, a greeting card company that allegedly exploited Gordon’s tag line (mark?), “Honey Badger don’t give a sh*t.” The Ninth Circuit made a threshold application of the <i>Rogers</i> test and found that the card company’s use was potentially explicitly misleading, and reversed and remanded the lower court’s grant of summary judgment to the card company. Because the court followed the Ninth Circuit practice of applying <i>Rogers</i> as a threshold test of applicability of the Lanham Act, and not as a factor in evaluating the elements of infringement, the case has been called into question by <i>Jack Daniel’s</i> and it has been labeled as “abrogated” by <i>Punchbowl, Inc. v. AJ Press</i>.<sup>119</sup></p> |
|  <p>120</p> | <p><i>E.S.S. Ent. 2000, Inc. v. Rock Star Videos</i> (9th Cir. 2008)<sup>121</sup>: This case tested the claims of ESS Entertainment, the owner of the real life “Play Pen Gentlemen’s Club” in Los Angeles, against Rock Star Videos, the maker of Grand Theft Auto San Andreas. The suit challenged Rock Star’s creation of a video game strip club called “Pig Pen” in the fictional world of Los Santos which shares many similarities with real life Los Angeles. The court applied the <i>Rogers</i> test, finding that (a) Rock Star’s use was artistic expression, (b) the use of the similar name “Pig Pen” was artistically relevant to the content of the game, and (c) the use was not explicitly misleading. But, because the court followed the Ninth Circuit practice of applying <i>Rogers</i> as a threshold test of applicability of the Lanham Act and not as a factor in evaluating the elements of infringement, the</p>   |



117. Photograph of “Honey Badger” greeting card, in Dennis Crouch, *Honey Badger Don’t Care: Protecting Creativity with Trademarks*, PATENTLY-O (Aug. 24, 2018), <https://patentlyo.com/patent/2018/08/protecting-creativity-trademarks.html> [<https://perma.cc/Y6RZ-XJNC>].

118. *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 267-69 (9th Cir. 2018).

119. *Punchbowl II*, 90 F.4th at 1022.

120. Still photograph from “Grand Theft Auto San Andreas”, in Robert Grf, *The Pig Pen Totally Nude Strip club in LS GTA San Andreas*, YOUTUBE (Mar. 14, 2021), <https://www.youtube.com/watch?v=aATdAZ3-uFg> [<https://perma.cc/5ZZH-8LSN>].

121. *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099-100 (9th Cir. 2008).

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|   | <p>case has been called into question by <i>Jack Daniel's</i> and it has been labeled as “abrogated” by <i>Punchbowl, Inc. v. AJ Press</i>.<sup>122</sup></p>   |
|  <p style="text-align: right;">123</p>   | <p><b><i>Brown v. Electronic Arts, Inc.</i></b> (9th Cir. 2013)<sup>124</sup>: In a case that implicates the overlap of federal false endorsement and false designation of origin claims with state law right of publicity theories, legendary football player Jim Brown alleged that Electronic Arts (EA) violated § 43(a) of the Lanham Act by using his likeness in its NFL football simulation games. The lower court granted EA’s motion to dismiss. The Ninth Circuit applied the <i>Rogers</i> test and affirmed, emphasizing that the level of artistic relevance under <i>Rogers</i>’ first prong need only exceed zero and concluding that it was “obvious that Brown’s likeness ha[d] at least some artistic relevance to EA’s work.”<sup>125</sup> Nevertheless, because the court followed the Ninth Circuit practice of applying <i>Rogers</i> as a threshold test of applicability of the Lanham Act, and not as a factor in evaluating the elements of infringement, the case has been called into question by <i>Jack Daniel's</i> and it has been labeled as “abrogated” by <i>Punchbowl, Inc. v. AJ Press</i>.<sup>126</sup></p> |
|  <p style="text-align: right;">127</p> | <p><b><i>Mattel Inc. v. Walking Mountain Prods.</i></b> (9th Cir. 2003)<sup>128</sup>: Tom Forsythe’s photographic series of unclothed Barbie dolls imperiled by vintage kitchen appliances produced one of the classic, art law casebook-worthy cases of parody as a defense to trademark and trade dress infringement and trademark dilution claims. (The case also raised copyright infringement claims not discussed here). Mattel sought to protect Barbie, one of its most valuable properties, from this artist’s humiliating treatment and exploitation, but the court followed the approach of <i>Mattel v. MCA Records</i>, 296 F.3d at 901 (discussed above) and exonerated Forsythe and Walking Mountain on the trademark infringement and trademark</p>  |

122. *Punchbowl II*, 90 F.4th at 1022.

123. Photograph of Jim Brown, in CBS Sports HQ (@CBSSportsHQ), *Happy 85th Birthday to Jim Brown!*, X (Feb. 17, 2021, 9:38 AM), <https://twitter.com/CBSSportsHQ/status/1362048905966481413> [<https://perma.cc/M9SB-464T>].

124. *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013).

125. *Id.* at 1243.

126. *Punchbowl II*, 90 F.4th at 1022.

127. Tom Forsythe, *Food Chain Barbie* (1999), BLOGSPOT, <https://lehrmach2.blogspot.com/2017/06/mattel-v-walking-mountain-20003.html> [<https://perma.cc/5CX4-UZ8E>] (last accessed Feb. 4, 2024).

128. *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

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|  | <p>dilution claims by applying the <i>Rogers</i> test. The court found the artistic content and message of Forsythe’s photographs were clearly and essentially tied to Barbie because the works comment on and criticize, and in many ways invert, what Mattel has communicated to be the image of what the dolls stand for—fashion, good taste, and a role-model for young women. The Ninth Circuit agreed with the district court’s finding that no one “would be misled into believing that Mattel endorsed Forsythe’s photographs despite Forsythe’s use of the Barbie figure.”<sup>129</sup> But because the court followed the Ninth Circuit practice of applying <i>Rogers</i> as a threshold test of applicability of the Lanham Act and not as a factor in evaluating the elements of infringement, the case has been called into question by <i>Jack Daniel’s</i> and it has been labeled as “abrogated” by <i>Punchbowl, Inc. v. AJ Press</i>.<sup>130</sup></p> |
| <b>Other Circuits: Third Circuit and Sixth Circuit</b>   |   |
|  <p style="text-align: right; margin-right: 20px;">131</p> | <p><i>Facenda v. N.F.L. Films, Inc.</i> (3d Cir. 2008)<sup>132</sup>: The trademark issue in this dispute over the use of John Facenda’s “Voice of God” narration in a new documentary about the making of EA Sports Madden NFL ‘06 was one of false endorsement. Facenda claimed the license he gave to NFL Films did not extend to commercial product promotion, as was alleged with NFL Film’s treatment of the Madden video game development story. Because the court construed the NFL’s First Amendment defense as a “threshold issue that would affect how [the court] would apply the trademark law in th[e] case,”<sup>133</sup> the court took up the First Amendment defense before considering the likelihood of confusion factors. The court declined to apply <i>Rogers</i> to the analysis, believing that (a) <i>Rogers</i> only applied to alleged use of marks in the title of expressive works and (b) the NFL’s documentary was not pure speech but</p> |

129. *Walking Mountain Prods.*, 353 F.3d at 808-13. The court did not apply *Rogers* to the trade dress infringement claim because it deemed it more appropriate to avoid the First Amendment issue and determined that Forsythe’s use enjoyed a “classic” and nominative fair use because Forsythe had purchased and used actual Barbie dolls by Mattel to convey the target of his expression as opposed to converting or reappropriating aspects of the design of the dolls for his own products or services.


130. *Punchbowl II*, 90 F.4th at 1022.

131. Still image from film, in Dave Volsky’s *Back Door, 1968 NFL Championship Film – John Facenda – ‘Perfect Championship’ – Reconstruction*, YOUTUBE (Nov. 5, 2021), <https://www.youtube.com/watch?app=desktop&v=O31NgjTwPog> [<https://perma.cc/9Q86-E8SF>].

132. *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007 (3d Cir. 2008).

133. *Id.* at 1015.



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|   | <p>commercial speech.<sup>134</sup> It would be difficult to find that NFL Films used the thirteen seconds (in three separate voiceover clips) of Facenda’s voice in the documentary in a source-identifying manner. Because the case ultimately rejected the application of <i>Rogers</i>, it appears that <i>Jack Daniel’s</i> did not affect the precedential value of this case. Indeed, the subsequent history of <i>Facenda</i> on Westlaw does not indicate that <i>Jack Daniel’s</i> abrogated the opinion.</p>  |
|  <p style="text-align: right;">135</p> | <p><i>Parks v. LaFace Recs.</i> (6th Cir. 2003)<sup>136</sup>: In another case where right of privacy or right of publicity claims were asserted under the Lanham Act, the civil rights pioneer Rosa Parks sued the rap and hip-hop group, OutKast, who had used Parks’ name as the title of a recording. OutKast further featured the “Rosa Parks” name on the cover and trade dress for the single release of the song (see image at left here). The Sixth Circuit considered several methods of evaluating Parks’ false endorsement and false designation of origin claims in light of the First Amendment issues raised in the dispute, including the Lanham Act’s likelihood of confusion analysis itself, the “alternative avenues” test, and the <i>Rogers</i> test. The court ultimately settled on the <i>Rogers</i> test. The court followed the reasoning and application of the <i>Rogers</i> test in <i>Mattel v. MCA Records</i>,<sup>137</sup> and ultimately found that OutKast did not meet the first prong, “artistic relevance,” of the <i>Rogers</i> test “as a matter of law” (contrary to what the lower court had found). The <i>Parks</i> court reversed and remanded the case on the “artistic relevance” issue and declared that if the first prong was not met on remand, then OutKast would necessarily fail the second, “explicitly misleading,” prong. It is not as obvious whether OutKast’s use would have or should have been evaluated as “source identifying”; neither these terms nor the concepts they have come to represent were discussed in the <i>Parks</i> opinion, but the disputed name, Rosa Parks, was used in the title of the work and on trade dress marking the single release of the song on store shelves. Given that the Supreme Court in <i>Jack Daniel’s</i> also cited <i>Mattel v. MCA</i> with approval, and <i>Parks</i> found <i>Rogers</i> did not absolve</p> |

134. *Id.* at 1017-18.

135. Photograph of the cover art for the OutKast single “Rosa Parks”, in *Rosa Parks (song)*, WIKIPEDIA [https://en.wikipedia.org/wiki/Rosa\\_Parks\\_%28song%29](https://en.wikipedia.org/wiki/Rosa_Parks_%28song%29) [<https://perma.cc/GAH9-NBKV>] (last visited Aug. 22, 2024).

136. *Parks v. LaFace Recs.*, 329 F.3d 437 (6th Cir. 2003).

137. *Mattel*, 296 F.3d at 902.

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|  | OutKast's use of Rosa Park's name, it is possible that <i>Parks</i> would survive review under the Supreme Court's clarification of <i>Rogers</i> . The <i>Parks</i> case is not marked as "abrogated" by <i>Jack Daniel's</i> on Westlaw. |
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Outside the Ninth Circuit and the two cases from the Third and Sixth Circuits discussed above, other courts have dealt with parody and other First Amendment defenses or avoidances to trademark infringement and dilution claims not as a threshold test, but at other stages of the analysis, such as a part of the "likelihood of confusion" trademark infringement analysis.

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|  <p style="text-align: right;">138</p>  | <p><i>In re Elster</i> (Fed. Cir. 2022)<sup>139</sup>: The "Trump Too Small" case was an appeal from the denial of registration of a mark that incorporated a human being's last name ("Trump") without his consent. Thus, the case has right of privacy and right of publicity implications even though these issues arose in the context of an appeal from the denial of a trademark registration for the mark, "Trump Too Small." The Federal Circuit overturned the decision of the Trademark Board on First Amendment grounds and recognized that Elster's use had parodic elements in addition to political commentary. This decision was not specifically based on <i>Rogers</i> but rather is a continuation of the <i>Tam</i><sup>140</sup> and <i>Iancu</i><sup>141</sup> line of cases on First Amendment limitations on trademark registration criteria.</p> |
|  <p style="text-align: right;">142</p> | <p><i>People for Ethical Treatment of Animals v. Doughney</i> (4th Cir. 2001)<sup>143</sup>: The Fourth Circuit did not apply <i>Rogers</i> at a threshold stage or at any point in the analysis to analyze the alleged parody by Michael Doughney of the People for the Ethical Treatment of Animals (PETA) mark in the form of the organization and registered domain name, People Eating Tasty Animals (PETA.org). The court decided that using PETA.org as a domain name took the case out of the realm of parody because a parody is supposed to be seen side-by-side with its target, and no one</p>   |

138. Photograph of tee shirt featuring the phrase "Trump Too Small", in *Trump Too Small T-Shirt*, TEE SHIRT PALACE, <https://www.teeshirtpalace.com/products/tts3024623-trump-too-small-t-shirt> [https://perma.cc/42B9-FRU9] (last visited Aug. 23, 2024).

139. *In re Elster*, 26 F.4th 1328, 1330 (Fed. Cir. 2022), cert. granted sub nom. Vidal v. Elster, 143 S. Ct. 2579 (2023).


140. *Matal v. Tam*, 582 U.S. 218 (2017).

141. *Iancu v. Brunetti*, 588 U.S. 388 (2019).

142. Illustration from home page, in TASTY ANIMALS, <http://www.tastyanimals.us/> [https://perma.cc/7CKA-Z9ST] (last visited Aug. 23, 2024).

143. *People for Ethical Treatment of Animals v. Doughney*, 263 F.3d 359 (4th Cir. 2001).



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|   | <p>could know of the parodic value of PETA.org until they already clicked on it and were sent to the PETA.org website. Doughney anticipated user confusion on the PETA.org site by stating: “Feeling lost? Offended? Perhaps you should, like, exit immediately” and the phrase “exit immediately” contained a hyperlink to People for the Ethical Treatment of Animal’s official website.<sup>144</sup> The case also had cybersquatting issues, which were a hot and bothersome legal issue in 2001 when the opinion was issued, and the court found Doughney’s efforts showed bad faith. It is likely that if this case came up on review in the post-<i>Jack Daniel’s</i> era, the use of the same mark, PETA, as a domain name and resource locator directing internet traffic to defendant’s site would be regarded as a commercial, source-identifying use precluding the consideration of the parody defense altogether. In any event, this outcome would match the outcome of the Fourth Circuit’s opinion.</p> |
|  <p>145</p> | <p><i>L.L. Bean, Inc. v. Drake Publishers, Inc.</i> (1st Cir. 1987)<sup>146</sup>: The L.L. Bean vs. High Society Magazine’s “L.L. Bean’s Back to School Sex Catalog” case predates <i>Rogers</i>. The First Circuit affirmed the District Court’s decision to let the federal trademark infringement claims go to trial but examined the appropriate balance of the Maine trademark dilution law and First Amendment free speech protections over parody. The court analyzed the erotic magazine’s use of Bean’s mark as being a noncommercial, non-source-identifying use<sup>147</sup> in the form of pure speech editorial or artistic parody that protected the use from Bean’s state law dilution claims.<sup>148</sup> Thus, had the <i>Rogers</i> test existed, even in light of <i>Jack Daniel’s</i>, the defendant’s use could have been protected as non-source-identifying artistic expression that did not explicitly mislead.</p>  |

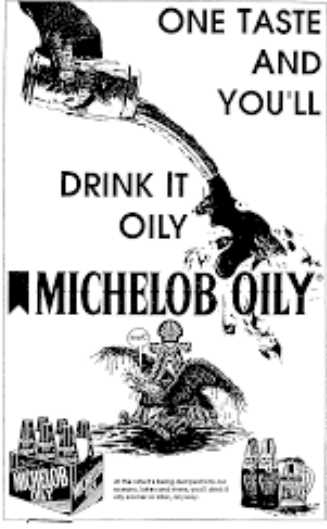
144. *Id.* at 363.

145. Image of cover art for the October 1984 edition of “High Society” magazine, *in Lot 24: October 1984 High Society Magazine-Men’s Adult Only Magazine!*, INVALUABLE (Jun. 25, 2023), <https://www.invaluable.com/auction-lot/october-1984-high-society-magazine-mens-adult-onl-24-c-92d4c94981> [<https://perma.cc/C7LP-HGPH>].

146. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987).

147. The parody sex catalog was a two-page article in the middle of the magazine, not a stand-alone booklet or cover feature. *Id.* at 27.

148. *Id.* at 32.

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|  | <p><i>Anheuser-Busch, Inc. v. Balducci Publ'ns</i><sup>150</sup>: <i>Anheuser-Busch v. Balducci</i> applied a First Amendment analysis after the court had made a determination that there was a likelihood of confusion; thus, it did not apply the First Amendment test in a threshold determination to preclude a likelihood of confusion analysis altogether (it did not apply or discuss the <i>Rogers</i> test, either). Although the words “source-identifying” were not used in the case, the court noted that Balducci’s ad parody appeared on the rear cover of the magazine in a spot frequently used for actual commercial advertisements.<sup>151</sup> Thus, the court’s resolution of the First Amendment parody defense followed the path described by <i>Jack Daniel’s</i>, and the case should not be considered to be abrogated by the decision.</p> |
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As indicated by *Anheuser Busch v. Balducci*<sup>152</sup> and other parody cases,<sup>153</sup> parody already had a difficult time in trademark, trade dress, and dilution actions. *Jack Daniel’s* increases the difficulties by drawing attention to the concept of a “source-identifying” use, which arguably was at play in *Balducci* because the parody ad for Michelob Oily was featured on the back cover of Balducci’s humor magazine where advertisements often are placed. This theory of source identification arguably was at play in *Mutual of Omaha Ins. v. Novak* because Novak’s “Mutant of Omaha” t-shirt wore its modified logo and trade dress on the face of the product where it would be seen to attract purchasers.<sup>154</sup>

Cases of the past have shown that trademark law has been stingy with the parody defense because confusion among consumers can be generated by even the most obvious parodies.<sup>155</sup> When this expression is coupled with a source-

149. Illustration of Michelob Oily advertisement, in *Anheuser-Busch, Inc. v. Balducci Publ'ns.*, 28 F.3d 769 app. A (8th Cir. 1994).

150. *Anheuser-Busch, Inc.*, 28 F.3d at 769.

151. *Id.* at 774.

152. *Id.*

153. *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979).

154. *See Novak*, 836 F.2d at 402.

155. *E.g., Balducci*, 28 F.3d at 774-76 (noting survey evidence indicating consumer confusion over whether “Michelob Oily” was in fact an actual Anheuser-Busch product); *Novak*, 836 F.2d at 402 (discussing possible confusion over whether Mutual of Omaha really was offering nuclear fallout insurance under the name “Mutant of Omaha”); *Dallas Cowboys Cheerleaders*, 604 F.2d at 206 (concluding that pornographic send-up of Dallas Cowboys cheerleaders still met infringement analysis because mocked-up cheerleader uniforms were too close to the actual Dallas Cowboy cheerleader uniform design).


identifying use and evaluated at the infringement stage,<sup>156</sup> the plaintiff's claim will have a very strong chance of success.

#### IV. THE FUTURE OF THE *ROGERS* FAIR USE TEST IN FEDERAL TRADEMARK LAW AND STATE RIGHT OF PUBLICITY AND RIGHT OF PRIVACY CLAIMS

Cases applying and adapting *Jack Daniel's* give us some clear indications of where the use of the *Rogers* test is going in trademark-related claims, and the lessons from these early rulings shed some light on the use of *Rogers* as persuasive authority in evaluating First Amendment protections in state law right of privacy and right of publicity claims.

##### A. *Post-Jack Daniel's First Amendment Analysis in Federal Trademark Claims*

In the roughly ten months after the Supreme Court issued *Jack Daniel's*, several courts had the occasion to revise or reconsider their rulings on whether, in light of *Jack Daniel's*, the *Rogers* test had been or should be applied by the court to escape the infringement analysis of an expressive use of a trademark in the context of trademark infringement or trademark dilution claims. Some found their initial analysis was consistent with *Jack Daniel's*, while others reversed course or withdrew opinions that previously had applied the *Rogers* test.

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|  | <p><b><i>Punchbowl, Inc. v. AJ Press, LLC (Punchbowl II)</i></b> (9th Cir. 2024)<sup>158</sup>: The Ninth Circuit reversed course on the evaluation of the trademark “Punchbowl” used by both plaintiff’s greeting cards company and defendant’s political news publication. In the prior opinion in the case, the Ninth Circuit applied <i>Rogers</i> in a threshold determination as to whether the Lanham Act even applied to defendant’s arguably expressive use of the term “Punchbowl” to allude to insider Washington political news. The court found that the Lanham Act did not apply and dismissed the action.<sup>159</sup> After <i>Jack Daniel's</i>, the Ninth Circuit withdrew</p> |
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156. *Jack Daniel's Props., Inc. v. VIP Prod. LLC*, 599 U.S. 140, 162 (2023).


157. Logos for Punchbowl and Punchbowl News, in Kimberly M. Maynard, *United States: Is the Party Punch Gone? Citing Jack Daniel's, Ninth Circuit Reverses Dismissal of Punchbowl Trademark Decision*, MONDAQ (Jan. 18, 2024), <https://www.mondaq.com/unitedstates/trademark/1413888/is-the-party-punch-gone-citing-jack-daniels-ninth-circuit-reverses-dismissal-of-punchbowl-trademark-decision> [https://perma.cc/E3QV-TA4N].

158. *Punchbowl, Inc. v. AJ Press, LLC (Punchbowl II)*, 90 F.4th 1022 (9th Cir. 2024).

159. *Punchbowl, Inc. v. AJ Press, LLC (Punchbowl I)*, 52 F.4th 1091, 1094 (9th Cir. 2022).

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|  | its prior opinion, <sup>160</sup> ultimately ruling (a) that <i>Rogers</i> did not apply, (b) that there would be no threshold determination on whether the Lanham Act applied, and (c) that, on remand, the court would have to adjudicate the infringement factors. <sup>161</sup> |
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As noted in the table in the prior section, *Punchbowl II* marked the abrogation of six prior Ninth Circuit cases that all had followed the formula used in the initial *Punchbowl I* case of applying *Rogers* as a threshold determination of the applicability of the Lanham Act to expressive and artistic uses of marks that, in many cases, precluded an analysis of the likelihood of confusion factors.<sup>162</sup>

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|  <p data-bbox="743 1108 776 1129">163</p> | <p><i>HomeVestors of Am., Inc. v. Warner Bros. Discovery</i> (D. Del. Dec. 21, 2023)<sup>164</sup>: The District of Delaware trial court adopted a Magistrate Judge’s report and recommendation (R&amp;R) to deny defendant Warner Bros.’ motion to dismiss the suit. The Magistrate Judge’s R&amp;R was drafted before the <i>Jack Daniel’s</i> opinion but had in effect followed the reasoning that was later applied in the <i>Jack Daniel’s</i> case. The District Court found that <i>Rogers</i> did not apply to this dispute, in which HomeVestors sued Warner Bros. over its HGTV “Ugliest House in America” television show for allegedly infringing plaintiff’s “Ugly Houses” marks (such as the mark shown at left here). Although Warner Bros. had argued that <i>Rogers</i> should preclude the suit when the allegation concerned the use of a mark in the title of an expressive work, the court disagreed, stating <i>Rogers</i> is not so broad that any use of a mark in the title of an expressive work is necessarily entitled to a threshold application of the <i>Rogers</i> analysis nor is it necessarily non-infringing. Although the</p> |
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160. *Punchbowl, Inc. v. AJ Press, LLC*, 78 F.4th 1158 (9th Cir. 2023) (withdrawing *Punchbowl I* opinion).

161. *Punchbowl II*, 90 F.4th at 1032.

162. *Dr. Seuss Enters, L.P. v. ComicMix LLC*, 983 F.3d 443, 461-62 (9th Cir. 2020); *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192 (9th Cir. 2017); *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 267-69 (9th Cir. 2018); *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099-100 (9th Cir. 2008); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013); *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806-07 (9th Cir. 2003).

163. HomeVestors caveman advertisement, in *We Buy Ugly Houses® Company Files Lawsuit Over Trademark Rights*, MADAN LAW PLLC (Dec. 19, 2022), <https://madan-law.com/4404-2/> [<https://perma.cc/863L-B2P8>].



164. *HomeVestors of Am., Inc. v. Warner Bros. Discovery*, No. CV 22-1583-RGA, 2023 WL 6880341, at \*3 (D. Del. Oct. 18, 2023), report and recommendation adopted, No. CV 22-1583-RGA, 2023 WL 8826729, at \*1 (D. Del. Dec. 21, 2023).

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|   | <p>court wrestled with whether Warner Bros.’ use was “source identifying” (<i>i.e.</i>, a trademark use of another’s trademark) in spite of the mark not only being in the title but in every aspect of the promotion of the work in question, because <i>Rogers</i> was the sole ground on which Warner Bros. moved to dismiss the federal trademark infringement claims and the federal and state trademark dilution claims, and the court accepted the recommendation that <i>Rogers</i> should not be applied to the case, the motion to dismiss was denied.</p>  |
|  <p>165</p> | <p><i>JTH Tax LLC v. AMC Networks Inc.</i> (S.D.N.Y. Sept. 25, 2023)<sup>166</sup>: JTH, purveyor of tax preparation services under “Liberty Tax Service” marks, raised trademark and trade dress infringement and state dilution claims against AMC Networks’ and Sony Television’s inclusion of an imaginary tax service company called “Sweet Liberty Tax Services” in an episode of defendants’ <i>Better Call Saul</i> television series. The court analyzed and applied <i>Jack Daniel’s</i> (and the <i>Louis Vuitton</i> case discussed above) and found that <i>Rogers</i> did apply because AMC and Sony did not use “Sweet Liberty Tax Services” as a source identifier or mark for <i>Better Call Saul</i> or any other program or product defendants produced. The imaginary “Sweet Liberty Tax Service” company run by fictional characters from the first season of <i>Better Call Saul</i> was at most used to advance the plot of one episode in Season 6 of the television series, and as such, the use was artistically relevant to the artistic expression of that fictional television episode under the first factor of <i>Rogers</i>. The court further analyzed each of the Second Circuit’s <i>Polaroid</i> factors and concluded that the use of “Sweet Liberty Tax Services” as a fictional name of a fictional tax service in a fictional television episode did not present an impermissible risk of consumer confusion under the second factor of the <i>Rogers</i> test.<sup>167</sup> Thus, the case stands for the proposition that when a senior mark is not used in a source-identifying, “trademark” use, then <i>Rogers</i> can be applied to the dispute.</p> |

165. Photograph of Betsy and Craig Kettleman, in *Sweet Liberty Tax Services*, BREAKING BAD WIKI, [https://breakingbad.fandom.com/wiki/Sweet\\_Liberty\\_Tax\\_Services?file=Betsy\\_and\\_Craig\\_Kettleman.jpeg](https://breakingbad.fandom.com/wiki/Sweet_Liberty_Tax_Services?file=Betsy_and_Craig_Kettleman.jpeg) [https://perma.cc/8ZFF-W4DY] (last visited Aug. 22, 2024).

166. *JTH Tax LLC v. AMC Networks Inc.*, 694 F. Supp. 3d 315, 328-30 (S.D.N.Y. 2023).

167. *Id.* at 335-41.

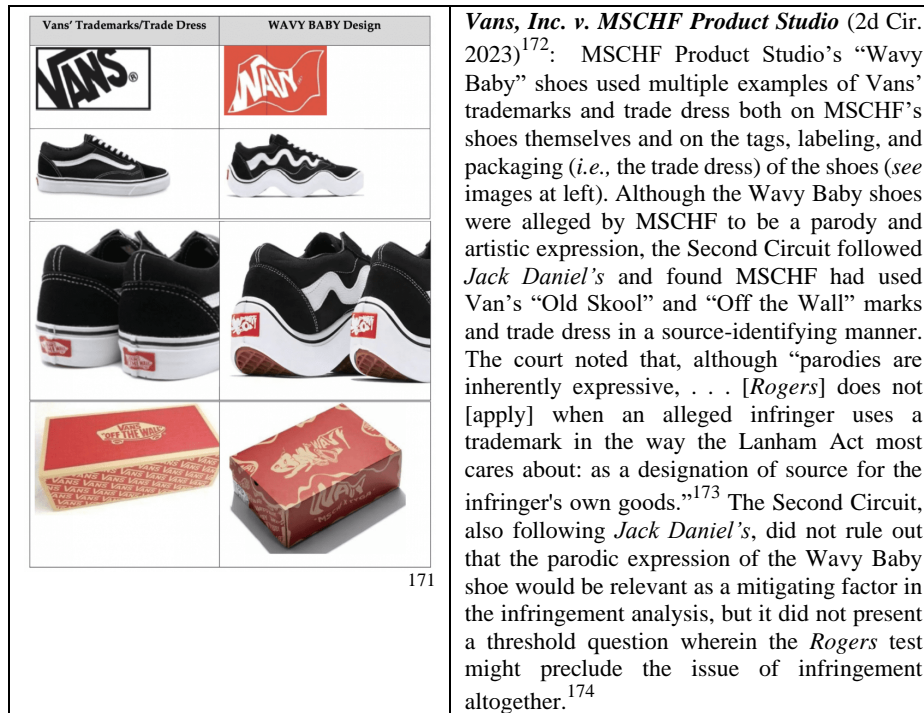
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| <p>BIRKIN Trade Dress</p>  | <p>Examples of the MetaBirkins NFTs</p>  | <p><i>Hermès Int'l v. Rothschild</i> (S.D.N.Y. June 23, 2023)<sup>169</sup>: The trademark lawsuit over Hermès’s Birkin bags and Mason Rothschild’s MetaBirkins non-fungible tokens (NFTs) culminated in a jury trial in which the jury unanimously found Rothschild (né Sonny Estival) guilty of Lanham Act trade dress infringement. In the ruling cited above, the trial court denied several post-trial motions under Fed. R. Civ. P. 50(b) and 59(a, c) and noted that the jury instructions were entirely correct in asking the jury to find first if Hermès had carried its burden to prove the elements of infringement before asking the jury to evaluate whether Hermès had proved that the First Amendment <i>did not</i> absolve Rothschild of responsibility. The court explained that the instructions were correct and consistent with <i>Jack Daniel’s</i> because a threshold inquiry based on the First Amendment and the <i>Rogers</i> analysis “is not appropriate when the accused infringer has used a trademark to designate the source of its own goods—in other words, has used a trademark as a trademark.”<sup>170</sup> The court opined, based on the unanimous jury verdict, that Rothschild had made a source-identifying use of the Birkin mark with his “MetaBirkins” NFTs and “MetaBirkins” website.</p> |
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168. Images of a Birkin Handbag and MetaBirkin NFTs, in RiKaleigh Johnson, *IP Law Watch-The MetaBirkins Battle*, LEXOLOGY (Feb. 1, 2023), <https://www.lexology.com/library/detail.aspx?g=bb83602b-69f7-4355-ac25-adfce623dc56> [<https://perma.cc/SN8E-5CLE>].

169. *Hermès Int'l v. Rothschild*, 678 F. Supp. 3d 475 (S.D.N.Y. 2023).

170. *Hermès*, 678 F. Supp. 3d at 484 (quoting *Jack Daniel's Props., Inc. v. VIP Prod. LLC*, 599 U.S. 140, 165 (2023)).



None of the above federal trademark cases involved a *deepfake* use of a mark, whether in a comment and criticism or parody context or as a source-identifying use. But the MetaBirkins suit (*Hermès Int’l v. Rothschild*) and the Wavy Baby suit (*Vans, Inc. v. MSCHF Product Studio*) are indicative scenarios to consider when predicting how such uses might come out in the deepfake generative AI context. A deepfake that is itself a product or is advertising or promoting a separate product or service of the deepfake creator, such as the NFTs Rothschild was selling and promoting in *Hermès* and the shoes MSCHF was selling and promoting in *Vans*, raises the issue that this advertising and promotional activity will in many, if not all, cases be deemed a source-identifying use. And even if the deepfake also expresses a parodic message that seeks to comment on or criticize the brand that the deepfake incorporates, and copies a portion of the trade dress or logo of the brand in order to conjure up the original as the target of the parody, as MetaBirkins and MSCHF did in their products, trade dress, and advertising, this will in many, if not all, instances bring the use squarely within the sights of *Jack Daniel’s*. These “source identifying” activities will preclude the application of *Rogers* and eliminate the

171. Photographs of Vans shoes and designs compared to Wavy Baby designs, *in Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 88 F.4th 125, 131-33 (2d Cir. 2023).

172. *Vans, Inc.*, 88 F.4th at 136-37.

173. *Id.* at 137 (quoting *Jack Daniel’s*, 599 U.S. at 153).

174. *Id.* at 137-38.



ability to raise a parody defense. At this point, it would be safer simply to identify the target's product or brand for what it is with no alteration or manipulation and make your comment or criticism about the brand directly, taking advantage of the nominative fair use.<sup>175</sup>

But *Jack Daniel's* does not preclude a deepfake that does not incorporate any part of a company's name, logos, or trade dress as a trademark or source-identifier of the deepfake creator, as in any deepfake that simply comments on or criticizes something without itself being a product or service or promoting a product or service. The author's deepfakes below attempt to illustrate this type of expressive use:



#### A. Post-Jack Daniel's First Amendment Analysis Under Rogers in State Law Publicity and Privacy Claims

The evaluation of deepfakes under state law right of publicity, name-image-likeness (NIL), or right of privacy laws requires a careful analysis of the content, message, and audience of the AI-assisted expression (*e.g.*, is it directed to consumers in a commercial context, or to voters, or consumers of news media, or the arts, or entertainment) within the elements of the substantive law and the requirements of the First Amendment.

State and federal courts have policed the intersection of right of publicity laws and the First Amendment for a considerable time because the courts recognize that right of publicity laws can potentially infringe upon the First

175. *E.g.*, *Am. Soc'y for Testing & Materials, et al. v. Public.Resource.Org, Inc.*, 896 F.3d 437, 456 (D.C. Cir. 2018); *New Kids on the Block v. News America Publ'g, Inc.*, 971 F.2d 302, 306-07 (9th Cir. 1992).

176. Michael D. Murray, *Deepfake illustration criticizing a beer company that is connected to a toxic fuel oil company* (Feb. 15, 2024) (image created with the assistance of DALL-E 3).

177. Michael D. Murray, *Deepfake illustration criticizing a fast-food company's coffee cup design* (Jan. 3, 2024) (image created with the assistance of DALL-E 3).

178. Michael D. Murray, *Deepfake illustration criticizing a tainted money source for paying off politicians* (Feb. 15, 2024) (image created with the assistance of DALL-E 3).



Amendment.<sup>179</sup> The overlap of subject matter in state and common law right of publicity, NIL, and privacy claims has led to the analysis of a parody and comment and criticism defense in each of these legal regimes.<sup>180</sup> Meeting the *Rogers* test is not essential to making a First Amendment defense on the basis of parody or comment and criticism in a right of privacy or right of publicity claim based on state statutory law or state common law. At the risk of stating the obvious, *Rogers* is controlling authority only in the Second Circuit when applied in claims arising under federal law, such as Lanham Act false endorsement and false designation or origin claims, and when the expressive use is not a trademark source-identifying use under *Jack Daniel's* (as discussed above). *Rogers* has been cited—but not always followed—by all eleven circuits and the federal circuit.<sup>181</sup> It has been officially adopted and applied by the Third

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179. See *Daniels v. FanDuel, Inc.*, 109 N.E.3d 390, 395-96 (Ind. 2018) (“The privilege of enlightening the public is by no means limited to dissemination of news in the sense of current events but extends far beyond to include all types of factual, educational and historical data, or even entertainment and amusement, concerning interesting phases of human activity in general.” (quoting *Time, Inc. v. Sand Creek Partners, L.P.*, 825 F. Supp. 210, 212 (S.D. Ind. 1993))); *Gionfriddo v. Major League Baseball*, 114 Cal. Rptr. 2d 307, 314 (Cal. Ct. App. 2001) (holding that the First Amendment will protect recitations of athletes’ accomplishments); *Haynes v. Alfred A. Knopf, Inc.*, 8 F.3d 1222, 1232 (7th Cir. 1993) (“[T]he First Amendment greatly circumscribes the right even of a private figure to obtain damages for the publication of newsworthy facts about him . . . .”); *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1001 (9th Cir. 2001) (outlining and applying a First Amendment defense to the California right of publicity statute creating a tort claim for commercial misappropriation of name and likeness); *Cardtoons, L.C. v. MLB Players Ass’n*, 95 F.3d 959, 968 (10th Cir. 1996) (describing and applying two exceptions to the Oklahoma right of publicity statute designed to accommodate the First Amendment); *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989) (citing *In re Estate of Havemeyer*, 217 N.E.2d 26 (N.Y. 1966)) (“[C]ourts delineating the right of publicity . . . have recognized the need to limit the right to accommodate First Amendment concerns.”). See also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (AM. L. INST. 1995) (“The right of publicity as recognized by statute and common law is fundamentally constrained by the public and constitutional interest in freedom of expression.”).

180. See, e.g., *In re Tam*, 808 F.3d 1321, 1373 (Fed. Cir. 2015) (Dyk, J., concurring), *as corrected* (Feb. 11, 2016), *aff’d sub nom. Matal v. Tam*, 582 U.S. 218 (2017); *Moore v. Weinstein Co., LLC*, 545 F. App’x 405, 409, 412 (6th Cir. 2013) (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (AM. L. INST. 1995) and *Rogers*, 875 F.2d at 999); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1277 (11th Cir. 2012); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 810-12 (9th Cir. 2003); *Lohan v. Perez*, 924 F. Supp. 2d 447, 454 (E.D.N.Y. 2013); *Geary v. Goldstein*, No. 91 CIV. 6222 (KMW), 1996 WL 447776, at \*3-4 (S.D.N.Y. Aug. 8, 1996).

181. This count is based on the Westlaw citing references for *Rogers*. Several of these citations are for a choice of law holding in *Rogers*, 875 F.2d at 1002: “A federal court sitting in diversity or adjudicating state law claims that are pendent to a federal claim must apply the choice of law rules of the forum state.” *E.g., Spain v. Haseotes*, 116 F.3d 464 (1st Cir. 1997) (unpublished table decision).

Circuit,<sup>182</sup> Fourth Circuit,<sup>183</sup> Fifth Circuit,<sup>184</sup> Sixth Circuit,<sup>185</sup> Ninth Circuit,<sup>186</sup> and Eleventh Circuit.<sup>187</sup> But it has only been cited by five states—California,<sup>188</sup> Kentucky,<sup>189</sup> Missouri,<sup>190</sup> New York,<sup>191</sup> and North Carolina<sup>192</sup>—and not officially adopted as the sole test of free expression rights in any of these states.

In state law right of privacy and right of publicity contexts, the *Rogers* test falls within a family of related fair use tests—the *Rogers* “Relatedness” test,<sup>193</sup> the *Cardtoons* “Balancing” test,<sup>194</sup> the *CBC* and *Doe* “Predominant Purpose” test,<sup>195</sup> and the *Simeonov* “Artistic Expression” test<sup>196</sup>—that balance the value or strength of the expression using a person’s name, image, likeness, or aspects of their persona against the injury or nature or level of exploitation of the name, image, likeness, or persona. These tests are summarized in RIGHT OF PUBLICITY IN A NUTSHELL as evaluating:

the purpose behind the use of the celebrity name/image/likeness and its context and connection to the activity (*i.e.*, high value expression or high commercial activity) to see if the use looks expressive and communicative or exploitative. Works that have high expressive value and are not commercial speech and not overtly commercialized will be

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182. *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 339-41 (E.D. Pa. 1996), *aff’d without opinion*, 156 F.3d 1225 (3d Cir. 1998) (unpublished table decision). *But see Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 158 (3d Cir. 2013) (declining to apply *Rogers* in favor of the transformative test); *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008) (declining to apply *Rogers* because expression in case was deemed to be commercial speech).

183. *Radiance Found., Inc. v. NAACP.*, 786 F.3d 316, 322, 329 (4th Cir. 2015).

184. *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664-65 (5th Cir. 2000).

185. *Parks v. LaFace Recs.*, 329 F.3d 437, 450 (6th Cir. 2003); *Moore v. Weinstein Co., LLC*, 545 F. App’x 405, 412 (6th Cir. 2013). *See also ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 936-37 (6th Cir. 2003) (applying both *Rogers* and the transformative test).

186. *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

187. *See Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012); *MGFB Props., Inc. v. Viacom Inc.*, 54 F.4th 670, 678 (11th Cir. 2022).

188. *E.g., Serova v. Sony Music Ent.*, 515 P.3d 1, 13 (Cal. 2022).

189. *Montgomery v. Montgomery*, 60 S.W.3d 524, 533 n.8 (Ky. 2001) (Keller, J., dissenting).

190. *Doe v. TCI Cablevision*, 110 S.W.3d 363, 373 (Mo. 2003) (en banc).

191. *E.g., Laccoff v. Buena Vista Pub., Inc.*, 705 N.Y.S.2d 183, 190 (N.Y. Sup. Ct. 2000).

192. *Wachovia Bank, Nat. Ass’n v. Harbinger Cap. Partners Master Fund I, Ltd.*, No. CIV.A. 07 CVS 5097, 2008 WL 684926, at \*12 (N.C. Super. Mar. 13, 2008) (citing *Rogers* for the proposition that a federal court adjudicating a supplemental state law claim must apply the choice of law rules of the forum state), *aff’d*, 687 S.E.2d 487 (N.C. Ct. App. 2009).

193. *Rogers v. Grimaldi*, 875 F.2d 994, 998-99 (2d Cir. 1989).

194. *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 968 (10th Cir. 1996). The Supreme Court’s opinion in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 574-75 (1977), is considered to be in line with the balancing approach that was later refined and applied in *Cardtoons*. *See, e.g., Doe v. TCI Cablevision*, 110 S.W.3d 363, 373 (Mo. 2003) (en banc).

195. *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 820 (8th Cir. 2007); *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003).

196. *Simeonov v. Tiegs*, 602 N.Y.S.2d 1014, 1018 (Civ. Ct. N.Y. Cty. 1993).

considered fair even when they feature the name, image, or likeness of a celebrity. Works that are highly commercialized in nature or in context and seek to exploit the celebrity's persona for gain in a fairly obvious manner will be considered unfair.<sup>197</sup>

The competing First Amendment fair use test that falls outside the family of balancing tests is the “transformative” test borrowed from copyright fair use law<sup>198</sup> by the California Supreme Court in *Comedy III Productions v. Gary Saderup, Inc.*<sup>199</sup> The transformative test does not specifically weigh the value of the expression using the name, image, likeness, or persona of a person against the level of commercial exploitation of these attributes. Rather, it attempts to determine if the creator of the new work adds First Amendment expressive value to the depiction beyond the value of the name, image, or likeness used in the work either through artistic, expressive additions or because the status of the creator of the work (*e.g.*, a famous artist such as Andy Warhol) supplies value.<sup>200</sup> In cases involving visual depictions of valuable images or likenesses (*e.g.*, of celebrities and sports figures), the court is to ask “whether the [plaintiff's] likeness is one of the ‘raw materials’ from which the [defendant's] work is synthesized, or whether the depiction or imitation of the [plaintiff] is the very sum and substance of the work in question.”<sup>201</sup> A rough shorthand of the inquiry that is offered by the California Supreme Court asks if consumers of the work will value the work (*e.g.*, buy it) because of the person who created it or because of the image or likeness depicted in the work.<sup>202</sup>

The transformative test is qualitatively and substantively different from *Rogers* and the other balancing tests cited above because it weighs the value of the defendant's *additions* of content or context (*e.g.*, how valuable is the celebrity defendant's participation in the expression) against the value of the depiction of the celebrity or non-celebrity plaintiff's image itself.<sup>203</sup> *Rogers* first evaluates if the speech presents a reason for using the plaintiff's name or identifying attributes (the relatedness question) and then weighs the level and nature of the exploitation or commercialization of the plaintiff's image (the exploitation question).<sup>204</sup> *Rogers* and the other balancing tests do not try to directly measure how clever and valuable the content of the expression of the

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197. MURRAY, *supra* note 35, at 166-67.

198. Within copyright law, the transformative fair use test has recently been clarified in *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508, 530-32 (2023). See Michael D. Murray, *Copyright Transformative Fair Use after Andy Warhol Foundation v. Goldsmith*, 24 WAKE FOREST J. BUS. & INTELL. PROP. L. 21 (2023).

199. 21 P.3d 797, 811 (Cal. 2001).

200. *Id.* at 804-08.

201. *Id.* at 809.

202. *See id.* at 810.

203. *E.g., id.* at 810 (holding that Gary Saderup, the defendant artist, did not contribute enough star power or valuable artistic skill to outweigh the publicity value of the images of the Three Stooges' images depicted in Saderup's work).

204. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

use is, or how famous the defendant making that expression is, so that this value can be compared to the value of the fame or celebrity of the person whose name or identifying information is used.<sup>205</sup>

The diminished importance of *Rogers* in state law actions means that the Supreme Court's clarifications of when *Rogers* applies and to what extent the context of a trademark source-identifying use defeats the application of *Rogers* and limits the application of parody and other free expression defenses<sup>206</sup> will have less impact in state law actions for right of publicity and right of privacy claims. A "trademark" type source-identifying use of a person's name, image, likeness, or other identifying information is, by definition, highly commercialized and directly targets the person's privacy rights or publicity rights for exploitation. The balancing tests, of which the *Rogers* relatedness test is one, would be likely to balance this level of exploitation against a finding of fair use even if the use was embedded in a related expressive activity.<sup>207</sup> By the same token, when the Supreme Court stated that *Rogers* continues to apply to "non-trademark uses" of a rival's trademark in an expressive context, this may be held to be persuasive authority in a state lawsuit where a defendant has used the name, image, likeness, or other identifying material of a person in a "non-source-identifying way."<sup>208</sup> The *Rogers* relatedness test or another balancing test can be applied to evaluate the expression against the commercial exploitation present in the use.<sup>209</sup>

## V. CONCLUSIONS

The post-*Jack Daniel's* cases discussed above show us that in federal litigation asserting trademark law theories, if the defendant made use of the plaintiff's marks and trade dress in the defendant's own marks, trade dress, or promotional materials in a "source-identifying" manner, there will be no threshold application of *Rogers* at the motion to dismiss stage to determine if

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205. Compare *Winter v. DC Comics*, 69 P.3d 473, 477 (Cal. 2003) ("When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist." Thus, depictions of celebrities amounting to little more than the appropriation of the celebrity's economic value are not protected expression under the First Amendment.") (quoting *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001)), with *Parks v. LaFace Recs.*, 329 F.3d 437, 450-51 (6th Cir. 2003), and *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 336 (E.D. Pa. 1996), *aff'd without opinion*, 156 F.3d 1225 (3d Cir. 1998) (unpublished table decision).

206. *Jack Daniel's Prods., Inc. v. VIP Prods., LLC*, 599 U.S. 140, 162 (2023).

207. See, e.g., *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (plaintiff Doe's—Tony Twist's—name arguably was used in a source-identifying manner when used in materials promoting the *Spawn* comic and its creator, Todd McFarlane, and the use was held not to be protected by the First Amendment).

208. *Jack Daniel's*, 599 U.S. at 155-56.

209. E.g., *Parks*, 329 F.3d at 450; *Seale*, 949 F. Supp. at 336.

the use is even actionable under the trademark laws so as to save the defendants the cost of developing the infringement case. And then, at the infringement stage of these cases presenting “source-identifying” uses of plaintiff’s marks and trade dress, the role of parody and other comment and criticism First Amendment defenses is diminished. In this way, the *Hermès Int’l v. Rothschild (MetaBirkins)* case and *Van’s v. MSCHF (Wavy Baby)* cases may be the most indicative predictors of how cases with this type of expressive but potentially confusing or exploitative use will fare under trademark law and the First Amendment. Cases of the past have shown that trademark law has been stingy with the parody defense because confusion among consumers can be generated by even the most obvious parodies.<sup>210</sup> When this expression is coupled with a source-identifying use and evaluated at the infringement stage,<sup>211</sup> the plaintiff’s claim will have a very strong chance of success.

The Supreme Court’s clarifications of when *Rogers* applies and to what extent the context of a trademark source-identifying use defeats the application of *Rogers* and limits the application of parody and other free expression defenses<sup>212</sup> are not controlling and have less importance in state law actions asserting right of publicity and right of privacy claims. But the parallel nature of trademark false endorsement and false designation of origin claims and state law publicity and privacy actions should mean that a “trademark” type source-identifying use of a person’s name, image, likeness, or other identifying information that is by definition highly commercialized and directly targets the person’s privacy rights or publicity rights for exploitation should fail the balancing tests used in state law claims, of which the *Rogers* relatedness test is one. These tests would be likely to balance this level of exploitation against a finding of fair use, even if the use was embedded in a related expressive activity.<sup>213</sup>

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210. *E.g.*, *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 774-76 (survey evidence indicated consumer confusion over whether “Michelob Oily” was in fact an actual Anheuser-Busch product); *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 400-02 (8th Cir. 1987) (discussing possible confusion over whether Mutual of Omaha really was offering nuclear fallout insurance under the name “Mutant of Omaha”); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204-05 (2d Cir. 1979) (pornographic send-up of Dallas Cowboys cheerleaders still met infringement analysis because mocked up cheerleader uniforms were too close to the actual Dallas Cowboy cheerleader uniform design).

211. *Jack Daniel’s*, 599 U.S. at 162.

212. *Id.*

213. *See, e.g.*, *Doe v. TCI Cablevision*, 110 S.W.3d 363, 373 (Mo. 2003).