

## Syllabus

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**SUPREME COURT OF THE UNITED STATES**

## Syllabus

**JACK DANIEL’S PROPERTIES, INC. v. VIP PRODUCTS  
LLC****CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR  
THE NINTH CIRCUIT**

No. 22–148. Argued March 22, 2023—Decided June 8, 2023

The Lanham Act, the core federal trademark statute, defines a trademark by its primary function: identifying a product’s source and distinguishing that source from others. In serving that function, trademarks help consumers select the products they want to purchase (or avoid) and help producers reap the financial rewards associated with a product’s good reputation. To help protect trademarks, the Lanham Act creates federal causes of action for trademark infringement and trademark dilution. In a typical infringement case, the question is whether the defendant’s use of a mark is “likely to cause confusion, or to cause mistake, or to deceive.” 15 U. S. C. §§1114(1)(A), 1125(a)(1)(A). In a typical dilution case, the question is whether the defendant “harm[ed] the reputation” of a famous trademark. §§1125(c)(2)(A), (C).

Respondent VIP Products makes a squeaky, chewable dog toy designed to look like a bottle of Jack Daniel’s whiskey. But not entirely. On the toy, for example, the words “Jack Daniel’s” become “Bad Spaniels.” And “Old No. 7 Brand Tennessee Sour Mash Whiskey” turns into “The Old No. 2 On Your Tennessee Carpet.” These jokes did not impress petitioner Jack Daniel’s Properties, which owns trademarks in the distinctive Jack Daniel’s bottle and in many of the words and graphics on its label.

Soon after the Bad Spaniels toy hit the market, Jack Daniel’s demanded that VIP stop selling it. VIP filed suit, seeking a declaratory judgment that Bad Spaniels neither infringed nor diluted Jack Daniel’s trademarks. Jack Daniel’s counterclaimed for infringement and dilution. At summary judgment, VIP argued that Jack Daniel’s infringement claim failed under the so-called *Rogers* test—a threshold

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test developed by the Second Circuit and designed to protect First Amendment interests in the trademark context. See *Rogers v. Grimaldi*, 875 F. 2d 994. When “expressive works” are involved, VIP contended, that test requires dismissal of an infringement claim at the outset unless the complainant can show either (1) that the challenged use of a mark “has no artistic relevance to the underlying work” or (2) that it “explicitly misleads as to the source or the content of the work.” *Id.*, at 999. Because Jack Daniel’s could not make that showing, VIP claimed, the Lanham Act’s statutory “likelihood of confusion” standard became irrelevant. And as for the dilution claim, VIP urged that Jack Daniel’s could not succeed because Bad Spaniels was a parody of Jack Daniel’s and therefore made “fair use” of its famous marks. §1125(c)(3)(A)(ii).

The District Court rejected both of VIP’s contentions for a common reason: because VIP had used the cribbed Jack Daniel’s features as trademarks—*i.e.*, to identify the source of its own products. As the District Court saw it, when another’s trademark is used for “source identification,” *Rogers* does not apply, and instead the infringement suit turns on likelihood of confusion. The court likewise rejected VIP’s invocation of the fair-use exclusion, holding that parodies fall within that exclusion only when they do not use a famous mark to identify the source of the alleged diluter’s product. The case proceeded to a bench trial, where the District Court found that consumers were likely to be confused about the source of the Bad Spaniels toy and that the toy’s negative associations with dog excrement (*e.g.*, “The Old No. 2”) would harm Jack Daniel’s reputation. The Ninth Circuit reversed. Finding the infringement claim subject to the threshold *Rogers* test, the Court of Appeals remanded the case to the District Court to decide whether Jack Daniel’s could satisfy either prong of that test. And the Court of Appeals awarded judgment on the dilution claim to VIP, holding that because Bad Spaniels parodies Jack Daniel’s, it falls under the “non-commercial use” exclusion. §1125(c)(3)(C). On remand, the District Court found that Jack Daniel’s could not satisfy either prong of *Rogers*, and so granted summary judgment to VIP on infringement. The Court of Appeals summarily affirmed.

*Held:*

1. When an alleged infringer uses a trademark as a designation of source for the infringer’s own goods, the *Rogers* test does not apply. Pp. 10–19.

(a) The Second Circuit created the *Rogers* test for titles of “artistic works” based on its view that such titles have an “expressive element” implicating “First Amendment values” and carry only a “slight risk” of confusing consumers about the “source or content” of the underlying work. 875 F. 2d, at 998–1000. Over the decades, lower courts adopting

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*Rogers* have confined it to similar cases, in which a trademark is used not to designate a work’s source, but solely to perform some other expressive function. See, e.g., *Mattel, Inc. v. MCA Records, Inc.*, 296 F. 3d 894, 901 (use of the Barbie name in band’s song “Barbie Girl” was “not [as] a source identifier”). The same courts, though, routinely conduct likelihood-of-confusion analysis in cases where trademarks are used as trademarks—*i.e.*, to designate source. See, e.g., *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 414–415 (parodic pet perfumes did not trigger *Rogers* because defendant’s use of Tommy Hilfiger’s mark was “at least in part” for “source identification”). Thus, whatever *Rogers*’ merit—an issue on which this Court takes no position—it has always been a cabined doctrine: It has not insulated from ordinary trademark scrutiny the use of trademarks as trademarks.

That conclusion fits trademark law, and reflects its primary mission. Consumer confusion about source—trademark law’s cardinal sin—is most likely to arise when someone uses another’s trademark as a trademark. In such cases, *Rogers* has no proper application. Nor does that result change because the use of a mark has other expressive content. Under the Ninth Circuit’s approach, *Bad Spaniels* was automatically entitled to *Rogers*’ protection because it “communicate[d] a humorous message.” 953 F. 3d 1170, 1175. On that view, few trademark cases would ever get to the likelihood-of-confusion analysis. And the Ninth Circuit was mistaken to believe that the First Amendment demanded such a result. When a mark is used as a source identifier, the First Amendment does not demand a threshold inquiry. Pp. 10–17.

(b) In this case, VIP conceded that it used the *Bad Spaniels* trademark and trade dress as source identifiers. And VIP has said and done more in the same direction with respect to *Bad Spaniels* and other similar products. The only question remaining is whether the *Bad Spaniels* trademarks are likely to cause confusion. Although VIP’s effort to parody Jack Daniel’s does not justify use of the *Rogers* test, it may make a difference in the standard trademark analysis. This Court remands that issue to the courts below. Pp. 17–19.

2. The Lanham Act’s exclusion from dilution liability for “[a]ny non-commercial use of a mark,” §1125(c)(3)(C), does not shield parody, criticism, or commentary when an alleged diluter uses a mark as a designation of source for its own goods. The Ninth Circuit’s holding to the contrary puts the noncommercial exclusion in conflict with the statute’s fair-use exclusion. The latter exclusion specifically covers uses “parodying, criticizing, or commenting upon” a famous mark owner, §1125(c)(3)(A)(ii), but does not apply when the use is “as a designation of source for the person’s own goods or services,” §1125(c)(3)(A). Given

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that carve-out, parody is exempt from liability only if *not* used to designate source. The Ninth Circuit's expansive view of the noncommercial use exclusion—that parody is always exempt, regardless whether it designates source—effectively nullifies Congress's express limit on the fair-use exclusion for parody. Pp. 19–20.

953 F. 3d 1170, vacated and remanded.

KAGAN, J., delivered the opinion for a unanimous Court. SOTOMAYOR, J., filed a concurring opinion, in which ALITO, J., joined. GORSUCH, J., filed a concurring opinion, in which THOMAS and BARRETT, JJ., joined.

Opinion of the Court

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**SUPREME COURT OF THE UNITED STATES**

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No. 22–148

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JACK DANIEL’S PROPERTIES, INC., PETITIONER *v.*  
VIP PRODUCTS LLC

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF  
APPEALS FOR THE NINTH CIRCUIT

[June 8, 2023]

JUSTICE KAGAN delivered the opinion of the Court.

This case is about dog toys and whiskey, two items seldom appearing in the same sentence. Respondent VIP Products makes a squeaky, chewable dog toy designed to look like a bottle of Jack Daniel’s whiskey. Though not entirely. On the toy, for example, the words “Jack Daniel’s” become “Bad Spaniels.” And the descriptive phrase “Old No. 7 Brand Tennessee Sour Mash Whiskey” turns into “The Old No. 2 On Your Tennessee Carpet.” The jokes did not impress petitioner Jack Daniel’s Properties. It owns trademarks in the distinctive Jack Daniel’s bottle and in many of the words and graphics on the label. And it believed Bad Spaniels had both infringed and diluted those trademarks. Bad Spaniels had infringed the marks, the argument ran, by leading consumers to think that Jack Daniel’s had created, or was otherwise responsible for, the dog toy. And Bad Spaniels had diluted the marks, the argument went on, by associating the famed whiskey with, well, dog excrement.

The Court of Appeals, in the decision we review, saw things differently. Though the federal trademark statute

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