FOR PUBLICATION

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

PUNCHBOWL, INC., a Delaware corporation, *Plaintiff-Appellant*, v. AJ PRESS, LLC, a Delaware limited liability company, *Defendant-Appellee*.	No.21-55881 D.C. No. 2:21-cv-03010-SVW-MAR OPINION

Appeal from the United States District Court
for the Central District of California
Stephen V. Wilson, District Judge, Presiding

Argued and Submitted October 2, 2023
Las Vegas, Nevada

Filed January 12, 2024

Before: John B. Owens and Daniel A. Bress, Circuit Judges, and Sidney A. Fitzwater,* District Judge.

Opinion by Judge Bress

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* The Honorable Sidney A. Fitzwater, United States District Judge for the Northern District of Texas, sitting by designation.

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SUMMARY[**]

Lanham Act

The panel reversed the district court's summary judgment in favor of the defendant in a trademark infringement suit involving two companies that used the word "Punchbowl" in their marks and remanded for further proceedings.

Applying *Jack Daniel's Properties, Inc. v. VIP Products LLC*, 599 U.S. 140 (2023), the panel held that the defendant's use of the Punchbowl mark was not outside the scope of the Lanham Act under the "*Rogers* test." Under this test, a trademark dispute concerning an expressive work protected by the First Amendment does not fall within the Lanham Act unless the defendant's use of the mark was not artistically relevant to the work or explicitly misled consumers as to the source or the content of the work. *Jack Daniel's* held that the *Rogers* test does not apply when the accused infringer has used a trademark to designate the source of its own goods. The panel concluded that, following *Jack Daniel's*, the Ninth Circuit's prior precedents were no longer good law insofar as they held that *Rogers* applied when an expressive mark was used as a mark, and that the only threshold for applying *Rogers* was an attempt to apply the Lanham Act to something expressive.

The panel held that *Rogers* did not apply here because the defendant was using the Punchbowl mark to identify and distinguish its news products. The panel instructed that, on

[**] This summary constitutes no part of the opinion of the court. It has been prepared by court staff for the convenience of the reader.

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remand, the district court should proceed to a likelihood-of-confusion analysis under the Lanham Act.

COUNSEL

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Cara L. Gagliano and Corynne McSherry, Electronic Frontier Foundation, San Francisco, California, Amici Curiae Electronic Frontier Foundation.

Eugene Volokh, UCLA First Amendment Clinic, UCLA School of Law, Los Angeles, California, Amici Curiae Law Professors.

OPINION

BRESS, Circuit Judge:

This case requires us to apply the Supreme Court's recent decision in *Jack Daniel's Properties, Inc. v. VIP Products LLC*, 599 U.S. 140 (2023), to a trademark infringement dispute involving two companies that use the word "Punchbowl" in their marks. Prior to *Jack Daniel's*, and bound by Ninth Circuit precedent, we held that under the

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"*Rogers* test," *see Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), the defendant's use of the term "Punchbowl" was expressive in nature and not explicitly misleading as to its source, which meant it fell outside the Lanham Act as a matter of law. *See Punchbowl, Inc. v. AJ Press, LLC* (*Punchbowl I*), 52 F.4th 1091 (9th Cir. 2022), *opinion withdrawn*, 78 F.4th 1158 (9th Cir. 2023). With the benefit of *Jack Daniel's*, we now hold that *Rogers* does not apply because the defendant is using the mark to identify its products. Although it does not follow that the plaintiff will ultimately prevail or even survive a future dispositive motion, it does mean that the defendant's use of its mark is not immune from the traditional likelihood-of-confusion inquiry.

We reverse and remand for further proceedings.

I

A

The following facts come verbatim from our initial opinion in this case. *See Punchbowl I*, 52 F.4th at 1094–96.

Punchbowl, Inc. (Punchbowl), is a self-described "technology company that develops online communications solutions for consumers," with a "focus on celebrations, holidays, events and memory-making." Punchbowl provides "online event and celebration invitations and greetings cards" and "custom sponsorships and branded invitations," as part of a subscription-based service. Punchbowl also works with companies such as The Walt Disney Company, Chuck E. Cheese, and Dave & Busters to help them promote their brands through online invitations.

Punchbowl has used the mark Punchbowl® (the Mark) since at least 2006. It registered the Mark with the United

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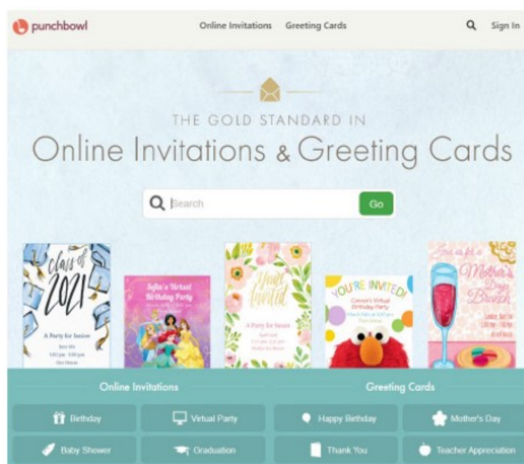
States Patent & Trademark Office in 2013. The Mark was registered primarily in connection with the "[t]ransmission of invitations, documents, electronic mail, announcements, photographs and greetings"; "[p]arty planning"; and "[p]reparation of electronic invitations, namely, providing . . . software that enables users to . . . customize electronic invitations."

Punchbowl promotes itself as "The Gold Standard in Online Invitations & Greeting Cards," as reflected in this record excerpt from Punchbowl's website:



A larger example of Punchbowl's Mark and logo (a punch ladle) is shown here:

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