

# An Open-Access Casebook

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## Expressive Uses of Trademarks

We use the term “expressive” to denote the great variety of unauthorized uses of marks for purposes such as parody, criticism, or social commentary, be they for profit or entirely non-commercial in nature. Unlike copyright law and its doctrine of copyright fair use, trademark law has no one-size-fits-all doctrine to address the permissibility of such expressive uses. Further complicating matters is that any particular expressive use should be analyzed both (1) for the likelihood that the use will cause consumer confusion and (2), if the targeted mark qualifies for antidilution protection, for the likelihood that the use will cause trademark dilution.

We turn first to a leading example of a court’s analysis of a for-profit parodic use both under the multifactor test for the likelihood of consumer confusion and the test under Lanham Act § 43(c), 15 U.S.C. § 1125(c), for the likelihood of trademark blurring and tarnishment. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007), is a lengthy opinion that is presented here almost in full, but it may reward a thorough reading. Not all courts follow the example of the Fourth Circuit’s analysis in *Haute Diggity Dog*, however. Indeed, the case law on expressive uses and the likelihood of consumer confusion can be quite diverse. This Part also offers a brief summary of a minor case, *MPS Entm’t, LLC v. Abercrombie & Fitch Stores, Inc.*, No. 11 Civ. 24110, 2013 WL 3288039 (S.D. Fla. June 28, 2013), in which the court engaged in a routine use of the multifactor test for the likelihood of confusion (without any special attention to the issue of parody) and simply found no likelihood of confusion.

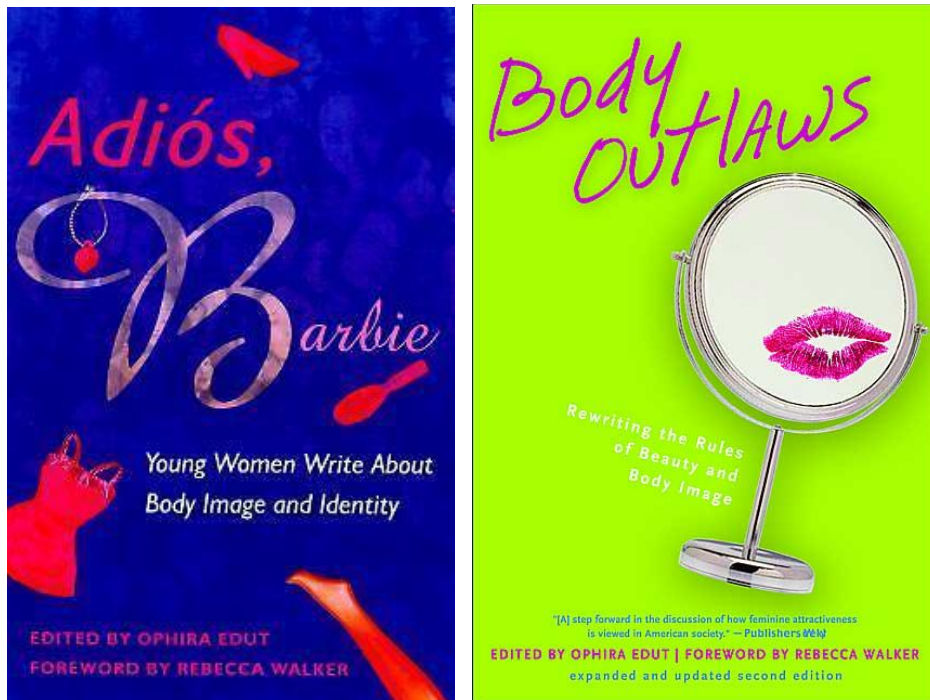
We then turn to the *Rogers v. Grimaldi* test for artistically relevant uses of trademarks. In recent years, this test has become increasingly influential as a replacement for the likelihood of confusion test in expressive use situations. However, in *Jack Daniel’s Props. v. VIP Prods. LLC*, 599 U.S. 140 (2023), the Supreme Court significantly limited the reach of the test.

Note also that the *Rogers v. Grimaldi* test limits itself only to the question of consumer confusion. It does not address the additional question of whether the expressive use dilutes by blurring or tarnishment the targeted mark. On that issue, a typical defendant may seek to avail itself of the “Exclusions” from antidilution protection provided by Lanham Act § 43(c)(3), 15 U.S.C. 1125(c)(3). The last Part focuses on expressive uses and trademark dilution and considers further aspects of the Lanham Act § 43(c)(3) exclusions.

One final preliminary comment going to the realities of the reading here: for all of the elaborate doctrine that is meant to limit plaintiffs’ trademark rights and allow defendants’ expressive uses, the fact is that defendants often cannot afford to benefit from these limits. They often settle rather than bankrupt themselves through litigation. Consider one example of this sad reality:

Seal Press, a small book publisher that specializes in non-fiction and fiction by women writers, published a book, “Adios, Barbie,” that examined body image from a feminist perspective {image of first edition book cover shown below on left}. Seal was sued by Mattel for dilution. Commenting on the suit, the Seal Press publisher said “[w]e thought the First Amendment provided us with every right to evoke the outrageousness of tall, thin, and white being the only widely accepted body type.” But Mattel overwhelmed the small press. In a settlement, Seal agreed to remove Barbie’s name from the book’s title and to remove images of the doll’s clothing and accoutrements from its cover. “We are a small publisher,” said the publisher. “We’re not insured for the costs associated with this type of lawsuit.”

Julie Zando-Denis, *Not Playing Around: The Chilling Power of the Federal Trademark Dilution Act of 1995*, 11 CARDOZO WOMEN’S L.J. 599, 614 (2005) (footnotes omitted).



There is simply no question that if Seal Press had had the resources to litigate the matter, it would have prevailed with respect to both confusion and dilution against Mattel — whose reputation for scorched-earth litigation tactics was matched at the time only by its reputation for almost always losing in court against those who stood up to its bullying. See, e.g., *Mattel Inc. v. Walking Mountain Productions*, 353 F.3d 792 (9th Cir. 2003); *Mattel, Inc. v. Pitt*, 229 F. Supp. 2d 315, 318 (S.D.N.Y. 2002). For more on the degree to which the mere threat of litigation can produce very strong “chilling effects” on expressive uses of

trademarks, see Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 Wisc. L. REV. 625 (2011).

## 1. Expressive Uses and the Tests for Confusion and Dilution

[The opinion in *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC* is available separately.]

[The opinion in *MPS Entm't, LLC v. Abercrombie & Fitch Stores, Inc.* is available separately.]

## 2. The *Rogers v. Grimaldi* Test for Unauthorized “Artistic” Uses

In *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), Ginger Rogers (of the dance duo with Fred Astaire) sued the producers of the Federico Fellini film *Ginger and Fred* for using her name in the film’s title. “The film tells the story of two fictional Italian cabaret performers, Pippo and Amelia, who, in their heyday, imitated Rogers and Astaire and became known in Italy as ‘Ginger and Fred.’ The film focuses on a televised reunion of Pippo and Amelia, many years after their retirement. Appellees describe the film as the bittersweet story of these two fictional dancers and as a satire of contemporary television variety shows.” *Id.* at 996-97. The district court noted that “Rogers has submitted a market research survey dated July 1986 which reports that based on approximately 200 interviews in Boston and New York (Staten Island) 43% of those exposed to the Film's title only connected the Film with Rogers and that 27% of those exposed to the Film's advertisement connected the Film with Rogers.” *Rogers v. Grimaldi*, 695 F. Supp. 112, 115 (S.D.N.Y. 1988). Nevertheless, the district court granted the defendants’ motion for summary judgment and the Second Circuit affirmed.

In finding no violation of Rogers’ Lanham Act § 43(a) rights, the Second Circuit sought to strike a balance between two competing policy objectives and in the process gave birth to the *Rogers v. Grimaldi* test:

We believe that in general the {Lanham} Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression. In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.

*Id.* at 999.

In the first opinion that follows, *Gordon v. Drape Creative*, 909 F.3d 257 (9th Cir. Nov. 20, 2018), we consider a controversial application of the *Rogers* test involving the meme “Honey Badger Don’t Care.” The Ninth Circuit had initially issued its opinion in *Gordon* in July 2018, but largely in response to an amicus brief filed by a group of intellectual property law professors, the court withdrew that opinion four months later and issued the opinion below, which represents a slight modification (too slight, some would say) of the previous opinion. Most previous applications of the *Rogers* test that are reviewed in *Gordon* were basically easy cases in which the defendant clearly should have prevailed. *Gordon* is significant because it presented a substantially harder set of facts, one involving a defendant arguably acting in bad faith and without artistic motive to misappropriate the plaintiff’s trademark.

In the second opinion, *Jack Daniel’s Props. v. VIP Prods. LLC*, 599 U.S. 140 (2023), the Supreme Court established a significant limitation on the applicability of the *Rogers v. Grimaldi* test. Did the Court reach the right result?

[The opinion in *Gordon v. Drape Creative, Inc.* is available separately.]

### Questions and Comments

1. *Do the trademarks in Gordon deserve protection?* The protectability of Gordon’s mark was never seriously in question in the case, but as a policy matter, are you persuaded that HONEY BADGER DON’T CARE should qualify as a protectable trademark for greeting cards?

2. *Rogers’ second prong.* Much of the controversy surrounding the *Gordon* opinion is focused on its treatment of the second prong of the *Rogers* test, going to whether the defendant’s conduct “explicitly misleads as to the source . . . of the work.” Previous case law had adopted an exceedingly defendant-friendly approach to this prong. For example, in *Brown v. Electronic Arts*, 724 F.3d 1235 (9th Cir. 2013), the case involving the video game maker’s use of Jim Brown’s likeness, the Ninth Circuit explained that even persuasive survey evidence showing consumer confusion would not be enough to satisfy the prong:

The test requires that the use be *explicitly* misleading to consumers. To be relevant, evidence must relate to the nature of the behavior of the identifying material’s user, not the impact of the use. Even if Brown could offer a survey demonstrating that consumers of the Madden NFL series believed that Brown endorsed the game, that would not support the claim that the use was explicitly misleading to consumers.

*Id.* at 1245-46 (emphasis in original). *Gordon* significantly modifies *Rogers’* second prong by adding two “consideration[s]”, first, whether “the junior user uses the mark in the same way as the senior user,” and second, “the extent to which the junior user has added his or her own expressive content to the work beyond the mark itself.” If persuasive survey evidence

showing consumer confusion is not enough to satisfy the “explicitly misleading” standard, then why would the defendant’s use “in the same way” or in a non-additive manner satisfy the standard? Do these considerations address the question of whether the defendant’s conduct explicitly misleads or are they ultimately concerned with other goals? Keep in mind that the *Rogers*’ test was originally designed as a balancing test intended to determine when “the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

3. *The Rogers test and merchandising uses by the defendant.* In *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192 (9th Cir. 2017), the plaintiff Empire Distribution was a “well-known and respected record label that records and releases albums in the urban music genre.” *Id.* at 1195. Not mentioned in *Gordon*’s review of *Empire* was the fact that “Fox has also promoted the *Empire* show and its associated music through live musical performances, radio play, and consumer goods such as shirts and champagne glasses bearing the show’s ‘Empire’ brand.” *Id.* Empire Distribution asserted that this conduct should not be protected by *Rogers*. The Ninth Circuit disagreed:

Although it is true that these promotional efforts technically fall outside the title or body of an expressive work, it requires only a minor logical extension of the reasoning of *Rogers* to hold that works protected under its test may be advertised and marketed by name, and we so hold. Indeed, the *Rogers* case itself concerned both a movie with an allegedly infringing title and its advertising and promotion, although the majority opinion did not deal separately with the latter aspect. See *Rogers*, 875 F.2d at 1005 (Griesa, J., concurring in the judgment). The balance of First Amendment interests struck in *Rogers* and *Mattel* could be destabilized if the titles of expressive works were protected but could not be used to promote those works. In response, Empire Distribution raises the specter of a pretextual expressive work meant only to disguise a business profiting from another’s trademark, but the record in this case makes clear that the *Empire* show is no such thing. Fox’s promotional activities, including those that generate revenue, are auxiliary to the television show and music releases, which lie at the heart of its “Empire” brand.

*Empire Distrib.*, 875 F.3d at 1196-97.

Is this reasoning persuasive? Should Fox be allowed to sell music from its show under “its ‘Empire’ brand”?

4. *Virtual reality and trademark rights.* Game designers seeking to accurately simulate non-virtual reality face significant challenges as this reality consists more and more of valuable intellectual properties, whether they take the form of public advertisements incorporating trademarks, distinctive product designs, well-known human personalities, or other embodiments. A number of trademark cases have sought, not always consistently, to determine when the unauthorized simulation of a trademark—or purported trademark—

constitutes infringement. The two most significant, both referenced in *Gordon*, are *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008), and *Brown v. Electronic Arts*, 724 F.3d 1235 (9th Cir. 2013). See also *AM Gen. LLC v. Activision Blizzard, Inc.*, 450 F. Supp. 3d 467 (S.D.N.Y. 2020) (in granting summary judgment to defendant, finding that the depiction of Humvee vehicles in various *Call of Duty* games did not infringe plaintiff's trademark rights related to the vehicle); *VIRAG, S.R.L. v. Sony Computer Entm't Am. LLC*, No. 15 Civ. 01729, 2015 WL 5000102 (N.D. Cal. Aug. 21, 2015), *aff'd*, 699 F. App'x 667 (9th Cir. 2017) (dismissing plaintiff's trademark infringement claim on ground that defendant's *Gran Turismo* racing simulation games' depiction of plaintiff's racetrack advertising was permissible under *Rogers*); *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*, No. 14 Civ. 02361, 2014 WL 6655844 (N.D. Cal. Nov. 24, 2014) (finding to be non-infringing defendant's use of plaintiff's "angry monkey" trademark in defendant's combat simulation *Call of Duty: Ghosts*); *Electronic Arts, Inc. v. Textron Inc.*, 12 Civ. 00118, 2012 WL 3042668 (N.D. Cal. July 25, 2012) (denying declaratory plaintiff's motion to dismiss in dispute over plaintiff's depiction of defendant's helicopter designs in plaintiff's combat simulation *Battlefield 3*); *Dillinger, LLC v. Electronic Arts, Inc.*, 09 Civ. 1236, 2011 WL 2457678 (S.D. Ind. June 16, 2011) (finding to be non-infringing defendant's use of term "Dillinger" in reference to weapons in organized crime simulations *The Godfather* and *The Godfather II*). Cf. *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d 1268 (9th Cir. 2013).

[The opinion in *Jack Daniel's Props. v. VIP Prods. LLC* is available separately.]

### Comments and Questions

1. *The Jack Daniel's Circularity*. Is the following a fair summary of *Jack Daniel's*? *Jack Daniel's* held that the *Rogers* test may be applied only when the defendant is making a "non-trademark use" of the plaintiff's mark, i.e., only when the defendant is using the plaintiff's mark in a way that does not lead consumers to believe that the mark is identifying the source of the defendant's goods. But if the defendant's use is therefore not causing confusion as to the source of its goods, doesn't that alone resolve the likelihood of confusion issue? What does *Rogers* add in such a situation? Has the Supreme Court made a mistake akin to the Ninth Circuit's in *KP Permanent*, that the only scenario in which the *Rogers* test may be now be applied are scenarios in which the test is not even necessary?

Considered differently, the Supreme Court's reasoning in *Jack Daniel's* appears to assume that there are scenarios in which a defendant's "non-trademark use," i.e., a non-source-identifying use of a mark, may nevertheless cause confusion as to source. Otherwise there would be no need for the special *Rogers* test to address those scenarios. But what might such scenarios look like?

2. *Jack Daniel's on remand*. On remand to the District of Arizona, the district court found no likelihood of consumer confusion. *VIP Prods. LLC v. Jack Daniel's Props. Inc.*, No. 14 Civ. 02057, 2025 WL 275909, at \*25 (D. Ariz. Jan. 23, 2025). In reaching this conclusion, the district court first followed the example of the Fourth Circuit in *Louis Vuitton Malletier S.A.*



*v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260 (4th Cir. 2007), and found that VIP’s dog toy “succeeds as a parody.” *VIP Prods. LLC v. Jack Daniel’s Props. Inc.*, 2025 WL 275909, at \*22. The district court then applied the Ninth Circuit’s *Sleekcraft* multifactor test for the likelihood of consumer confusion, from *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979). The court’s analysis of the *Sleekcraft* factors was heavily influenced by its finding that VIP’s parody was a “successful parody.” *VIP Prods. LLC v. Jack Daniel’s Props. Inc.*, 2025 WL 275909, at \*20.

However, the district court found a likelihood of tarnishment. *VIP Prods. LLC v. Jack Daniel’s Props. Inc.*, 2025 WL 275909, at \*19. The district court declined to consider whether the Lanham Act’s anti-tarnishment provision violated the Free Speech Clause of the First Amendment because VIP did not raise the issue in its pleadings. *Id.* at \*15.

3. A finding that *Rogers v. Grimaldi* does not apply is not fatal to the defendant. As in *VIP Prods. LLC v. Jack Daniel’s Props. Inc.*, even when a court determines that the defendant has made a “trademark use” of the accused expression and cannot therefore benefit from the *Rogers v. Grimaldi* test, a court may still find no likelihood of confusion. See, e.g., *Punchbowl, Inc. v. AJ Press LLC*, No. 21 Civ. 03010, 2024 WL 4005220 (C.D. Cal. Aug. 22, 2024), appeal dismissed, 2025 WL 899951 (9th Cir. Feb. 14, 2025). In *Punchbowl*, the plaintiff used the term “punchbowl” in its trademark for online greeting card services. The defendant used the term in its trademark for an online political news website. The district court had initially applied *Rogers* and found no infringement, and the Ninth Circuit affirmed. *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091 (9th Cir. 2022). The Supreme Court then issued its *Jack Daniel’s* opinion, with the result that the Ninth Circuit withdrew its opinion affirming and instead remanded to the district court to “proceed to a likelihood-of-confusion analysis.” *Punchbowl, Inc. v. AJ Press, LLC*, 90 F.4th 1022, 1032 (9th Cir. 2024). The district court then found no likelihood of confusion.

### 3. Further Aspects of Expressive Uses and Trademark Dilution

#### **Lanham Act § 43(c)(3), 15 U.S.C. § 1125(c)(3)**

(3) Exclusions. The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with—

- (i) advertising or promotion that permits consumers to compare goods or services; or
- (ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.



(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

We focus here on two of the exclusions listed in § 43(c)(3): the exclusion for “[a]ny noncommercial use of a mark” and the exclusion for uses “in connection with . . . identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.”

*a. Noncommercial Expressive Uses*

The noncommercial use exception has proven, where it applies, to be an extraordinarily powerful limitation on trademark dilution liability. The following brief overview of *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002), shows why. If the so-called “Aqua Case” were litigated today, now after *Jack Daniel’s*, would the Ninth Circuit be able to reach the same result?

[The opinion in *Mattel, Inc. v. MCA Records, Inc.* is available separately.]

**Questions and Comments**

1. *An alternative approach to the question of noncommercial uses.* For a significantly more subtle (but less defendant-friendly) approach to the question of whether a use qualifies as non-commercial, see *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509 (7th Cir. 2014).

*b. What Qualifies as Parody under § 43(c)(3)(A)(ii)?*

The following two opinions count as relatively minor opinions in the case law on trademark dilution and parody. But together they provide a good means of exploring the question of what constitutes parody under Lanham Act § 43(c)(3)(A)(ii). Do the opinions adopt differing approaches to the definition of parody under that subsection or were the facts (or quality of the lawyering) in the two cases sufficiently different to explain the differing outcomes?

[The opinion in *Louis Vuitton Malletier, S.A. v. Hyundai Motor Am.* is available separately.]

[The opinion in *Louis Vuitton Malletier v. My Other Bag, Inc.* is available separately.]