Published on *The National Law Review* https://natlawreview.com

# The Last Dance? The Future of the “Rogers Test” After the Jack Daniel’s Decision

Article By:

Amy (Salomon) McFarland

After enjoying several decades of acceptance across many circuit courts, the future of the so-called “Rogers test” is uncertain. Established in the landmark Second Circuit case Rogers v. Grimaldi, Rogers is a two-step test designed to balance the public’s interest in avoiding consumer confusion with a speaker’s First Amendment rights.

The case[1] involved a film titled *Ginger and Fred*, which was about two fictional Italian cabaret dancers nicknamed “Ginger and Fred” because they imitated Fred Astaire and Ginger Rogers. Rogers did not approve the use of her name in the title of the film, and therefore sued for trademark infringement and false endorsement. The Second Circuit, in dismissing her claims, established the new test. Specifically, the Second Circuit held that when a third-party trademark (in this case, a celebrity’s name) is used in the title of an *expressive work* (such as a movie or television show title), the use constitutes trademark infringement or false endorsement only if “the title has no artistic relevance to the underlying work whatsoever;” or if there is artistic relevance, where the title “explicitly misleads as to the source or the content of the work.”

Over the years, the low bar to demonstrate artistic relevance and the high bar to demonstrate that a use is explicitly misleading resulted in countless trademark infringement lawsuits being resolved in favor of defendants at the motion to dismiss or summary judgment stage. However, the US Supreme Court’s landmark decision in *Jack Daniel’s Properties, Inc. v. VIP Products LLC* (US 2023) has invited uncertainty into this landscape. The Court, in ruling that the *Rogers* test did not apply to VIP’s sale of a dog toy that copied the trade dress of a Jack Daniel’s whiskey bottle, held: “Today’s opinion is narrow. We do not decide whether the *Rogers* test is ever appropriate…. On infringement, we hold only that *Rogers* does not apply when the challenged use of a mark is as a mark.”

The intentionally “narrow” decision declined to abolish the *Rogers* test entirely but left its future in question. Following the decision, uses that were previously held defensible under the *Rogers* test are now being remanded to the district courts to apply the *Jack Daniel’s* precedent, and several of these courts are now finding that *Rogers* does not apply.[2] Additionally, Justices Neil Gorsuch, Clarence

Thomas, and Amy Coney Barrett signed a concurring opinion in *Jack Daniel's* with ominous tidings for fans of the *Rogers* test.

"I write separately only to underscore that lower courts should handle *Rogers v. Grimaldi*…with care. Today, the Court rightly concludes that, even taken on its own terms, *Rogers* does not apply to cases like the one before us. But in doing so, we necessarily leave much about *Rogers* unaddressed. For example, it is not entirely clear where the *Rogers* test comes from — is it commanded by the First Amendment, or is it merely gloss on the Lanham Act, perhaps inspired by constitutional-avoidance doctrine?... For another thing, it is not obvious that *Rogers* is correct in all its particulars — certainly, the Solicitor General raises serious questions about the decision. …. All this remains for resolution another day…and lower courts should be attuned to that fact."

Given the *Jack Daniel's* decision and the current trend of post-*Jack Daniel's* cases, we recommend the following takeaways:

- Media and entertainment companies should include traditional likelihood of confusion and nominative fair use analysis when clearing titles that arguably contain third-party trademarks.
- For now, *Rogers* remains good law in many circuits *as long as* the third-party trademark is not used as a source identifier (*i.e*., as long as it is not used as a trademark). For example, when a third-party trademark is used within the *content* of an expressive work, rather than the title, district courts have continued to find *Rogers* applicable after *Jack Daniel's*.[3]
- It remains to be seen whether the title of a single work (like a one-off documentary) will typically be afforded protection under the *Rogers* test. While the title of a single creative work is not registrable at the US Patent and Trademark Office, courts have acknowledged that the title of a single work can be used as a source identifier, meaning such titles would not be analyzed under *Rogers*, but would instead be evaluated based on traditional likelihood of confusion standards.
- It also remains to be seen whether *Rogers* will apply in cases whether the title *as a whole* is used as a source identifier, but the trademark incorporated into the title is not. For example, following *Jack Daniel's*, the title MIXING BOWL NEWS for a recurring series would not be entitled to rely on *Rogers*, but perhaps the title LIFE IN THE MIXING BOWLwould. In the latter case, the hypothetical third-party trademark "MIXING BOWL" is not used in a source identifying manner, but the full title LIFE IN THE MIXING BOWL is. Would the source-identifying function of the title as a whole foreclose the application of the *Rogers* test, or will courts be willing to issue a more nuanced analysis? Only time will tell.
- Even if *Rogers* is ultimately overturned in its entirety, as the concurring Justices seem poised to do, many titles can still be cleared for use based on standard likelihood of confusion and nominative fair use analysis.
- Overall, media and entertainment companies should be prepared to expend more in legal fees defending title dispute cases moving forward, as such cases are less likely to be thrown out at the motion to dismiss stage.

---

[1] *Rogers v. Grimaldi*, 875 F. 2d 994 (CA2 1989)

[2] *See, e.g.*, *Diece-Lisa Indus., Inc. v. Disney Store USA, LLC*, No. 21-55816, 2023 WL 5541556 (9th Cir., Aug. 25, 2023)(remanded for further proceedings consistent with *Jack Daniel's*); *Activision Publ'g, Inc. v. Warzone.com, LLC*, No. 22-55831, 2023 WL 7118756 (9th Cir. Oct. 25, 2023)(remanded for further proceedings consistent with *Jack Daniel's*); *Vans, Inc. v. MSCHF Prod. Studio, Inc*., 88 F.4th 125, 137 (2d Cir. 2023)(applying *Jack Daniel's* and holding that *Rogers* does not apply to the defendant's use of the plaintiff's trademark); *Punchbowl, Inc. v. AJ Press, LLC*, No.

21-55881, 2024 WL 134696 (9th Cir., Jan. 12, 2024)(holding, on re-examination after *Jack Daniel's*, that *Rogers* does not apply to the defendant's use of the plaintiff's trademark).

[3] *See, e.g., JTH Tax LLC v. AMC Networks Inc*., 2023 WL 6215299 (S.D.N.Y. Sept. 25, 2023); *Hara v. Netflix, Inc.,* 2023 WL 6812769 (C.D. Cal. Aug. 23, 2023).



National Law Review, Volume XIV, Number 88