

*Lanham Act — Trademark Infringement and Dilution —
First Amendment and Statutory Defenses —
Jack Daniel’s Properties, Inc. v. VIP Products LLC*

Brands — and the names, slogans, and logos they use to promote themselves — are “ubiquitous, embedded in every aspect of our lives and relationships.”¹ Given their omnipresence, it is no surprise that others use their trademarks for “lighthearted humor, critical cultural commentary, parody, or even simply to shock.”² Nevertheless, over the last few decades, trademark owners’ rights have expanded significantly,³ giving owners an increasing ability to suppress speech they do not like.⁴ In *Jack Daniel’s Properties, Inc. v. VIP Products LLC*,⁵ the Supreme Court added to this trend by misconstruing the proper scope of the statutory exclusion from dilution liability for noncommercial uses of a mark.

A trademark is a brand name, logo, “trade dress” (that is, a product’s packaging or general appearance), or anything else that indicates a product’s source (i.e., that a given product comes from a given producer).⁶ The Lanham Act,⁷ the federal trademark statute, creates causes of action for trademark infringement and trademark dilution. Infringement entails using in commerce “any reproduction, counterfeit, copy, or colorable imitation of a registered mark” or any “word, term, name, symbol, or device, or any combination thereof” in a manner that is “likely to cause confusion, or to cause mistake, or to deceive.”⁸ Dilution entails using a famous mark in commerce in a way that is likely to impair its distinctiveness by associating it with unrelated products (“blurring”) or to harm its reputation by associating it with low-quality or unsavory products (“tarnishment”).⁹ Each cause of action has defenses. In infringement cases, courts apply a First Amendment defense the Second Circuit developed in *Rogers v. Grimaldi*.¹⁰ Under the *Rogers* test, the

¹ SARAH BANET-WEISER, AUTHENTIC™: THE POLITICS OF AMBIVALENCE IN A BRAND CULTURE 3 (2012).

² Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 WASH. L. REV. 887, 887 (2005).

³ See Rochelle Cooper Dreyfuss, *Reconciling Trademark Rights and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity*, in TRADEMARK LAW AND THEORY 261, 263 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008); Jack M. Balkin, Commentary, *Digital Speech and Democratic Culture: A Theory of Freedom of Expression for the Information Society*, 79 N.Y.U. L. REV. 1, 17 (2004); Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867, 870 & n.14, 911 (2017).

⁴ See Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 381, 384–85 (2008).

⁵ 143 S. Ct. 1578 (2023).

⁶ See 15 U.S.C. § 1127. This comment uses “trademarks” and “marks” interchangeably to refer generally to registered and unregistered trademarks, trade dress, and any other matter protected by trademark law.

⁷ 15 U.S.C. §§ 1051–1141n.

⁸ 15 U.S.C. §§ 1114(1)(a), 1125(a)(1).

⁹ See *id.* § 1125(c)(1)–(2); see also *Ty Inc. v. Perryman*, 306 F.3d 509, 511 (7th Cir. 2002).

¹⁰ 875 F.2d 994 (2d Cir. 1989).

Lanham Act does not apply to uses of trademarks in expressive works unless a given use either has no relevance to the underlying work or is explicitly misleading.¹¹ As to dilution, the Lanham Act excludes certain uses from liability, including non-source-indicating fair uses (such as parody or criticism) as well as “[a]ny noncommercial use.”¹²

To give examples of all the above: The name “Coca-Cola,” the Coca-Cola logo and script, and the distinctive shape of a Coke bottle (part of its trade dress) could all be marks, as all indicate that the soda is made by Coca-Cola and not by, say, PepsiCo. If another company sold soda in bottles similar to Coca-Cola’s, causing purchasers to think they were buying Coke, that company could be liable for infringement. But if a movie character drank a Diet Coke onscreen, that depiction would be protected by *Rogers*. And if another company used Coca-Cola’s font to advertise even unrelated products, it could be liable for dilution by blurring (even if no consumer were confused);¹³ if that company used Coca-Cola’s font to advertise porn, it could be liable for dilution by tarnishment. But if its use were noncommercial or were a non-source-indicating parody, it would be excluded from liability.

Enter VIP Products LLC. VIP sells dog toys, including “Silly Squeakers,” which look like popular drinks but have labels with “dog-related twists.”¹⁴ In 2014, VIP introduced the “Bad Spaniels” toy, a Silly Squeaker designed to look like a bottle of Jack Daniel’s with puns about dog excrement replacing information about whiskey: “The Old No. 2 On Your Tennessee Carpet” instead of “Old No. 7 [Brand] Tennessee Sour Mash Whiskey,” and “43% poo by vol.” and “100% smelly” instead of “40% alc. by vol. (80 proof).”¹⁵

Unamused, Jack Daniel’s Properties, Inc. (JDPI),¹⁶ insisted that VIP stop selling the toy.¹⁷ VIP declined and filed suit in the U.S. District Court for the District of Arizona, seeking a declaratory judgment that the Bad Spaniels toy did not infringe or dilute any trademark rights claimed by JDPI.¹⁸ VIP also sought a declaration that the Jack Daniel’s trade dress was not entitled to trademark protection, as well as cancellation of JDPI’s Patent and Trademark Office registration for the Jack

¹¹ *E.g.*, *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264–65 (9th Cir. 2018).

¹² 15 U.S.C. § 1125(c)(3).

¹³ *Cf.* *Coca-Cola Co. v. Hoff*, Opposition No. 91244286, at 49 (T.T.A.B. May 14, 2021).

¹⁴ *VIP Prods. LLC v. Jack Daniel’s Props., Inc.*, 953 F.3d 1170, 1172 (9th Cir. 2020). Other Silly Squeakers include (among many others) “Blue Cats Trippin” for Pabst Blue Ribbon; “Pawsifico Perro” for Pacifico; “Hens R Messy” for Hennessy; and, perhaps most charming, “Pissness” for Guinness. *Silly Squeakers*, MYDOGTOY.COM, <https://mydogtoy.com/silly-squeaker> [<https://perma.cc/GP52-U3A3>]. (The Ninth Circuit apparently did not realize that VIP had branched out beyond dogs.)

¹⁵ *Jack Daniel’s*, 143 S. Ct. at 1585. One wonders in vain why the percentage went from 40 to 43.

¹⁶ In this comment, “JDPI” means the corporate entity and “Jack Daniel’s” the product.

¹⁷ *VIP Prods.*, 953 F.3d at 1172.

¹⁸ *Jack Daniel’s*, 143 S. Ct. at 1586.

Daniel's bottle design.¹⁹ JDPI brought counterclaims for trademark infringement and trademark dilution, seeking an injunction.²⁰

VIP moved for summary judgment and JDPI for partial summary judgment.²¹ The district court denied VIP's motion, holding that the Bad Spaniels toy was not protected either as nominative fair use, because VIP did not actually use Jack Daniel's marks; or by the First Amendment, because the dog toy was not an expressive work.²² The court further held that there was a disputed issue of fact as to whether VIP's use was likely to cause confusion.²³ The court also denied VIP's motion for summary judgment on JDPI's dilution counterclaim.²⁴ It held that VIP could not avail itself of the Lanham Act's parody defense because that defense does not apply when a defendant uses a mark to designate the source of its own products, as VIP had.²⁵ And there were disputed issues of fact as to whether the products were sufficiently similar for dilution and as to whether the Bad Spaniels toy tarnished JDPI's marks.²⁶ As to JDPI's motion, the court held that the Jack Daniel's trade dress was protectable (because it was distinctive and not functional) and declined to invalidate JDPI's registration for the shape of the Jack Daniel's bottle.²⁷ After a bench trial, the court found that VIP had tarnished and infringed JDPI's trademarks and trade dress, and enjoined VIP from selling or otherwise promoting the Bad Spaniels toy.²⁸

The Ninth Circuit affirmed in part, reversed in part, vacated in part, and remanded.²⁹ Writing for the panel, Judge Hurwitz³⁰ affirmed the district court's holdings that JDPI's marks were distinctive and non-functional and thus protectable; that VIP's use did not constitute nominative fair use; and that JDPI's registration was valid.³¹ The court reversed, however, on dilution, holding that, because VIP's use of JDPI's trade dress and bottle design "convey[ed] a humorous message," it did "more than propose a commercial transaction."³² It was thus

¹⁹ *VIP Prods.*, 953 F.3d at 1173.

²⁰ *Id.*; Answer and Counterclaims of Defendant and Counterclaimant JDPI at 13–20, *VIP Prods., LLC v. JDPI*, No. 14-cv-02057 (D. Ariz. Sept. 27, 2016). JDPI's infringement claims were brought under both the federal Lanham Act and Arizona state law. *Id.* at 4. JDPI's dilution claim was brought under section 43(c) of the Lanham Act. *Id.* at 15. The Lanham Act provides for injunctive relief (as well as damages, costs, and fees) for both causes of action. 15 U.S.C. §§ 1116–1117, 1125(c)(1).

²¹ *VIP Prods.*, 953 F.3d at 1173.

²² *VIP Prods.*, 2016 WL 5408313, at *5–6.

²³ *See id.* at *11.

²⁴ *Id.* at *17.

²⁵ *Id.* at *12 (citing, *inter alia*, 15 U.S.C. § 1125(c)(3)(A)).

²⁶ *Id.* at *11–17.

²⁷ *Id.* at *6–10, *17–20.

²⁸ *VIP Prods. LLC v. JDPI*, 953 F.3d 1170, 1173 (9th Cir. 2020).

²⁹ *Id.* at 1170–71.

³⁰ Judge Hurwitz was joined by Judges Tashima and Miller.

³¹ *VIP Prods.*, 953 F.3d at 1173–74.

³² *Id.* at 1176 (quoting *Nissan Motor Co. v. Nissan Comput. Corp.*, 378 F.3d 1002, 1017 (9th Cir. 2004)).

noncommercial speech, which is nondilutive under section 43(c) of the Lanham Act.³³ The court also vacated the district court’s finding of infringement, reasoning that the Bad Spaniels product, despite being a dog toy, was an expressive work.³⁴ The court thus remanded the case for a determination as to whether Bad Spaniels passed *Rogers*.³⁵

On remand, VIP moved for summary judgment on the grounds that JDPI could not prove that Bad Spaniels failed either *Rogers* prong.³⁶ The district court granted the motion, reasoning that VIP’s use of JDPI’s marks was relevant in that the toy “play[ed] upon” those marks “to communicate a message” and did not explicitly mislead because expressive content was added and the toy’s label contained a disclaimer.³⁷ The Ninth Circuit summarily affirmed.³⁸

The Supreme Court vacated and remanded, with Justice Kagan writing for a unanimous Court.³⁹ She began by noting that a trademark’s “‘primary’ function” is to “identify the origin or ownership of the article to which it is affixed,” thereby allowing consumers to purchase goods they know they like (or avoid goods they know they do not) and incentivizing businesses to produce high-quality goods by ensuring that the positive reputations of such goods will redound to their benefit.⁴⁰

The Court stated that, when it comes to preventing confusion that could arise from source-indicating uses, “trademark rights ‘play well with the First Amendment.’”⁴¹ Thus, when an alleged infringer uses a trademark “as a mark” — that is, as an indication of source for its own products — no “threshold First Amendment filter” (like *Rogers*) applies.⁴² Where a defendant uses a mark to indicate source, the fact that the use is a parody may make confusion less likely, and so is relevant to whether the defendant infringed.⁴³ But this is the *only* First Amendment protection that source-indicating parodic uses receive.⁴⁴ Thus, because VIP used JDPI’s marks (including name and trade dress) as indicators of source for the Bad Spaniels toy, the “only question” left to resolve was whether VIP’s uses are likely to cause confusion — though the fact that it crudely mocked Jack Daniel’s can make that less likely.⁴⁵

³³ *See id.*

³⁴ *Id.* at 1174–76.

³⁵ *Id.* at 1176.

³⁶ VIP Prods., LLC v. JDPI, No. cv-14-02067, 2021 WL 5710730, at *2 (D. Ariz. Oct. 8, 2021).

³⁷ *Id.* at *5–6 (citing *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 448 (9th Cir. 2020)).

³⁸ VIP Prods., LLC v. JDPI, No. 21-16969, 2022 WL 1654040 (9th Cir. Mar. 18, 2022).

³⁹ *Jack Daniel’s*, 143 S. Ct. at 1578.

⁴⁰ *Id.* at 1583 (quoting *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916)).

⁴¹ *Id.* at 1590 (quoting *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 900 (9th Cir. 2002)).

⁴² *Id.* at 1587 & n.1.

⁴³ *Id.* at 1591–92 (citing *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 265 (4th Cir. 2007)).

⁴⁴ *See id.*

⁴⁵ *Id.* at 1591.

The Court then turned to dilution, which issue it “easily dispatched.”⁴⁶ That VIP’s use conveyed a nonadvertising message was insufficient for it to fit within the noncommercial use exclusion.⁴⁷ Rather, because the Lanham Act’s separate parody exclusion applies only to parodies that do not make source-indicating use of a mark, to extend the noncommercial use exception to parodies that do would “negate[] Congress’s judgment about when — and when not — parody” is protected.⁴⁸ Thus, the Court held that the “noncommercial exclusion does not shield parody or other commentary when its use of a mark is similarly source-identifying.”⁴⁹

Justice Sotomayor concurred to observe that, in the context of parodies and (potentially) other expressive works, courts must cast a gimlet eye on surveys purporting to show consumer confusion.⁵⁰ Survey responses “may reflect a mistaken belief” that “all parodies require permission from the owner of the parodied mark,” and they can be “[c]leverly designed” so as to prompt confusion.⁵¹ Therefore, if surveys are allowed to “drive the infringement analysis,” trademark owners would effectively be granted a veto over mockery.⁵²

Justice Gorsuch also concurred to emphasize his skepticism regarding *Rogers*.⁵³ He observed that “it is not entirely clear where the *Rogers* test comes from” and that “it is not obvious that *Rogers* is correct in all its particulars.”⁵⁴ Thus, he noted that lower courts should “handle [it] with care” pending its “resolution another day.”⁵⁵

In *Jack Daniel’s*, the Court unnecessarily narrowed the Lanham Act’s exclusion from dilution liability for noncommercial uses, holding that this exclusion applies only to *non*-source-indicating commentary. This holding will likely weaken First Amendment defenses necessary to protect expression from expanding trademark rights.

The *Jack Daniel’s* dilution holding rests on a misreading of section 43(c) of the Lanham Act. That portion of the opinion started by recalling that section 43(c)(3)(A)’s fair use exclusion for parody, criticism, and commentary is expressly limited to uses that do not use the

⁴⁶ *Id.* at 1592. Excluding citations, the Court’s dilution discussion comprised fewer than 400 words. *See id.*

⁴⁷ *Id.* (disagreeing with the Ninth Circuit’s holding). The Court expressed no view as to whether a given use of a mark may ever be noncommercial if it seeks to sell a product. *See id.*

⁴⁸ *Id.*

⁴⁹ *Id.* at 1593.

⁵⁰ *Jack Daniel’s*, 143 S. Ct. at 1593 (Sotomayor, J., concurring). Justice Sotomayor was joined by Justice Alito.

⁵¹ *Id.*

⁵² *Id.*

⁵³ Justice Gorsuch was joined by Justices Thomas and Barrett.

⁵⁴ *Jack Daniel’s*, 143 S. Ct. at 1594 (Gorsuch, J., concurring).

⁵⁵ *Id.*

plaintiff's trademark as a designation of source.⁵⁶ Thus, “parody (and criticism and commentary, humorous or otherwise) is exempt from liability only if *not* used to designate source.”⁵⁷

Regarding the fair use exclusion, which explicitly includes that requirement,⁵⁸ this conclusion is hard to refute. But the Court ignored that there is no such limitation on the Lanham Act's *separate* noncommercial use exclusion — even though Congress evidently knew how to include it if it wanted to. Instead, the noncommercial use exclusion applies to “[a]ny noncommercial use of a mark.”⁵⁹

As recognized by lower courts⁶⁰ — including the Ninth Circuit in *Mattel, Inc. v. MCA Records, Inc.*⁶¹ — the best reading of the noncommercial use exclusion is that it incorporates the First Amendment's concept of “commercial speech,” under which speech is commercial only if it “does no more than propose a commercial transaction.”⁶² This interpretation is supported by the Federal Trademark Dilution Act's⁶³ legislative history.⁶⁴ More importantly, it is the “only interpretation” of the exclusion that is consistent with the “overall purpose and structure of federal trademark dilution law” in providing “strong free speech protections” to counteract the strong dilution provisions.⁶⁵

On this reading, a use of a mark in speech that does not aim to sell a separate product but is *itself* the product being sold — such as a song

⁵⁶ *Id.* at 1592 (majority opinion) (citing 15 U.S.C. § 1125(c)(3)(A)). For instance, a canvas tote bag that says “My Other Bag” with a cartoon of a Louis Vuitton bag parodies Louis Vuitton, but does not use its marks as a logo or other indicator of source for itself. *See* Louis Vuitton Malletier, S.A. v. My Other Bag, Inc., 156 F. Supp. 3d 425, 435 (S.D.N.Y.), *aff'd*, 674 F. App'x 16 (2d Cir. 2016).

⁵⁷ *Jack Daniel's*, 143 S. Ct. at 1592.

⁵⁸ 15 U.S.C. § 1125(c)(3)(A).

⁵⁹ *Id.* § 1125(c)(3)(C) (emphasis added).

⁶⁰ *See, e.g.*, *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 331 (4th Cir. 2015); *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1339 (N.D. Ga. 2008); *Sporting Times, LLC v. Orion Pictures Corp.*, 291 F. Supp. 3d 817, 827 (W.D. Ky. 2017). Some courts and commentators have also considered use as a mark to be a necessary condition for dilution liability generally. *See, e.g.*, *Nat'l Bus. Forms & Printing, Inc. v. Ford Motor Co.*, 671 F.3d 526, 536 (5th Cir. 2012); Stacey L. Dogan & Mark A. Lemley, *The Trademark Use Requirement in Dilution Cases*, 24 SANTA CLARA COMPUT. & HIGH TECH. L.J. 541, 551–54 (2008). On this reading, the Court's holding would render the noncommercial use exclusion entirely superfluous as to parody, criticism, and commentary, as it would protect only uses that were not subject to dilution liability in the first place.

⁶¹ 296 F.3d 894 (9th Cir. 2002). The Supreme Court cited *Mattel* approvingly multiple times in its infringement analysis. *See Jack Daniel's*, 143 S. Ct. at 1588, 1590.

⁶² *Mattel*, 296 F.3d at 905–06 (quoting *Hoffman v. Cap. Cities/ABC, Inc.*, 255 F.3d 1180, 1184 (9th Cir. 2001)); *see also* Patrick D. Curran, Comment, *Diluting the Commercial Speech Doctrine: “Noncommercial Use” and the Federal Trademark Dilution Act*, 71 U. CHI. L. REV. 1077, 1082 (2004) (noting that, despite some divergence in approach, “courts agree that the [Lanham Act's] ‘noncommercial use’ exemption is a catch-all for First Amendment concerns reflecting the Supreme Court's distinction between protected noncommercial speech and less-protected commercial speech”).

⁶³ 15 U.S.C. §§ 1125, 1127.

⁶⁴ *Mattel*, 296 F.3d at 905.

⁶⁵ Lee Ann W. Lockridge, *When Is a Use in Commerce a Noncommercial Use?*, 37 FLA. ST. U. L. REV. 337, 367 (2010).

called “Barbie Girl” about life as a Barbie doll⁶⁶ — is noncommercial and therefore nondilutive. And, importantly (and contrary to JDPI’s argument⁶⁷), this would not render the fair use exclusion superfluous. The fair use exception is narrower in that it covers only non-source-indicating uses, but broader in that it protects parodies that are part of purely commercial speech. Take an advertisement for a video game about tanks in which Snuggle Bear is obliterated by said tanks.⁶⁸ As an advertisement, the speech is solely intended to advance a commercial transaction, so it cannot be a noncommercial use. But Snuggle Bear is being parodied without being used as an indicator of source for the video game, so this *would* be a fair use.⁶⁹ That the two exceptions might sometimes overlap does not mean one limits the other.⁷⁰

Even if one is unconvinced that the noncommercial use exclusion is meant to extend to for-profit uses (such that the Bad Spaniels toy is commercial),⁷¹ it still does not contain the limitation that the Court has applied to it — which, again, Congress knew how to impose. Under the Court’s holding, uses of marks that are noncommercial by any understanding could still be dilutive if they are source indicating.

This narrowing of the noncommercial use exclusion threatens to make it easier for trademark owners to suppress free expression. Trademarks do more than indicate source — as the Supreme Court itself has recognized.⁷² They convey messages about what they promote, from mundane commercial products to the “momentous philosophical or political issues of the day.”⁷³ And in contemporary consumer culture, they have substantial and increasing communicative value to individuals as well.⁷⁴ They allow fans to express their support for sports teams, media franchises, celebrities, products, and lifestyles; they are used as

⁶⁶ Cf. *Mattel*, 296 F.3d at 906–07.

⁶⁷ See Brief for Petitioner at 5, *Jack Daniel’s*, 143 S. Ct. 1578 (No. 22-148).

⁶⁸ See generally *Conopco, Inc. v. 3DO Co.*, 53 U.S.P.Q.2d (BL) 1146 (S.D.N.Y. 1999). For the ad, see Game Payne, *Battle Tanx (Nintendo 64) Commercial Featuring Snuggle Bear (4K)*, YOUTUBE, (Aug. 18, 2019), <https://www.youtube.com/watch?v=3nJtoqeIwko> [<https://perma.cc/TC5L-87WW>].

⁶⁹ Justin J. Gunnell, *Evaluation of the Dilution-Parody Paradox in the Wake of the Trademark Dilution Revision Act of 2006*, 26 CARDOZO ARTS & ENT. L.J. 441, 463 (2008) (noting commercial would likely be protected by since-added exclusion); see also, e.g., *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 435 (S.D.N.Y.), *aff’d*, 674 F. App’x 16 (2d Cir. 2016).

⁷⁰ See David A. Simon, *The Confusion Trap: Rethinking Parody in Trademark Law*, 88 WASH. L. REV. 1021, 1051 (2013) (making a similar argument).

⁷¹ See, e.g., Brief for Petitioner, *supra* note 67, at 20.

⁷² See *Matal v. Tam*, 137 S. Ct. 1744, 1752, 1760 (2017); *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298–302 (2019).

⁷³ Cf. Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 159. For more, see, for example, *Matal*, 137 S. Ct. at 1760; and *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 736 F.3d 198, 201 (2d Cir. 2013), which regarded a dark-roast blend named “Charbucks” in reference to Starbucks’s “unusually” dark roasts.

⁷⁴ See, e.g., Dreyfuss, *supra* note 3, at 264–66; Barton Beebe, *The Semiotic Account of Trademark Doctrine and Trademark Culture*, in TRADEMARK LAW AND THEORY, *supra* note 3, at 42, 59–60 (“Trademarks utterly dominate the lived experience of modern commercial culture.”).

“metaphors, similes, and metonyms”⁷⁵ that “fill in gaps in our vocabulary and add a contemporary flavor to our expressions.”⁷⁶ Further, using a company’s marks to criticize it ranges from a necessity (how can one criticize, for instance, Comcast without referring to it by name?) to a means of doing so more effectively.⁷⁷

But as the expressive importance of trademarks has increased,⁷⁸ so too have the rights of trademark owners and their ability to use trademark law to restrict speech.⁷⁹ Expanding notions of confusion allow infringement suits to succeed even where confusion is “dispelled before an actual sale begins”⁸⁰ or where no prospective customers (but only third parties) are likely to be confused in the first place.⁸¹ And the entrenchment of dilution in federal law — first with the 1995 passage of the Federal Trademark Dilution Act and then with the 2006 passage of the Trademark Dilution Revision Act⁸² — allows trademark owners to enjoin speech even where *nobody* is confused.⁸³

⁷⁵ Dreyfuss, *supra* note 3, at 262; *see also, e.g.*, YOUNG THUG, *Wyclef Jean*, at 1:27, *on* JEFFERY (300 Ent. 2016) (“Shop at Saks Fifth, flow on DatPiff.”); STEELY DAN, *Glamour Profession*, at 4:23, *on* GAUCHO (MCA Records 1980) (“Meet me at midnight / at Mr. Chow’s.”); SOULJA BOY, *Crank That (Soulja Boy)*, at 1:15, *on* SOULJABOYTELLEM.COM (ColliPark Music 2007) (“Haters gettin’ mad ‘cause I got me some Bathin’ Ape.”).

⁷⁶ *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

⁷⁷ *See* *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994); Richard A. Posner, *When Is Parody Fair Use?*, 21 J. LEGAL STUD. 67, 70 (1992).

⁷⁸ *See* William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 57 (2008).

⁷⁹ *See generally, e.g.*, Rebecca Tushnet, Editorial, *Trade Mark Law Dodges Free Speech Challenges in the Jack Daniel’s Case*, 18 J. INTEL. PROP. L. & PRAC. 475, 475 (2023); Denicola, *supra* note 73, at 158–60 (discussing trademark owners’ “struggle to extend the scope of trademark protection[,] . . . rais[ing] for the first time the possibility of genuine conflict between trademark law and the first amendment,” *id.* at 159–60); Dreyfuss, *supra* note 3, at 263–66; McGeeveran, *supra* note 78, at 57.

⁸⁰ *Playboy Enters., Inc. v. Netscape Comm’ns Corp.*, 354 F.3d 1020, 1025 (9th Cir. 2004). This “initial-interest” confusion exists where, for instance, a customer decides to visit a store thinking it is operated by Company A, but realizes while shopping that it is operated by Company B. *E.g., id.* *See generally* Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 CARDOZO L. REV. 105, 108–10 (2005).

⁸¹ This “post-sale confusion” often exists where a customer knowingly buys a knockoff product that others may think is authentic. *E.g.,* *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc.*, 221 F.2d 464, 466 (2d Cir. 1955).

⁸² Pub. L. No. 109-312, 120 Stat. 1730 (codified as amended at scattered sections of 15 U.S.C.). Though the Act raised the standard for fame and added a defense for non-source-indicating parody, it also expanded the scope of dilution liability by undoing the Supreme Court’s holding in *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003), that plaintiffs need to show actual dilution rather than just a likelihood thereof, *id.* at 433. Tyler J. Gee, *Introduction to the Trademark Dilution Act of 2006*, 11 INTEL. PROP. L. BULL. 185, 186 (2007).

⁸³ And, possibly, where nobody is harmed. *Compare* *Ty Inc. v. Perryman*, 306 F.3d 509, 511–12 (7th Cir. 2002) (Posner, J.) (explaining the economic rationales for dilution, which include internal consumer search costs), *with* Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 527–46 (2008) (evaluating empirical evidence to conclude that “the cognitive model of dilution lacks enough empirical support to justify its adoption as a general theory underlying dilution,” *id.* at 546).

Defendants may ultimately succeed in most cases.⁸⁴ But often, they do not.⁸⁵ Perhaps more importantly, because many users fold upon receipt of a cease-and-desist letter, growing trademark rights allow trademark owners to curtail even speech that would ultimately be protected by a court.⁸⁶ And even where a defendant has the resources to fully litigate a case, they are more likely to win precisely because of *Rogers* (and other defenses that have grown alongside trademark rights) and the statutory exclusions from dilution liability.⁸⁷

Jack Daniel's will likely weaken these defenses, increasing trademark owners' power to restrict speech.⁸⁸ Because dilution claims do not require plaintiffs to show that the defendant has created a likelihood of confusion — only that a use will lessen a famous mark's distinctiveness or harm its reputation⁸⁹ — they may be easier to win than infringement claims.⁹⁰ To be sure, defendants can argue that criticizing or poking fun at a mark enhances, rather than impairs, its distinctiveness.⁹¹ But this is less than reassuring (and less reassuring than the possibility of winning on likely confusion⁹²) for three interrelated reasons. First, dilution requires a low showing: “virtually any reference to a trademark influences the consumer’s mental association regarding the brand, in ways that one could characterize as” dilutive,⁹³ and a majority of courts treat

⁸⁴ See McGeeveran, *supra* note 78, at 51, 59–61.

⁸⁵ See Lisa P. Ramsey, *First Amendment Limitations on Trademark Rights*, in 3 INTELLECTUAL PROPERTY AND INFORMATION WEALTH 147, 157 (Peter K. Yu ed., 2007).

⁸⁶ See McGeeveran, *supra* note 78, at 52, 61–64. This also explains why the Supreme Court's holdings in *Matal v. Tam*, 137 S. Ct. 1744 (2017); and *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019), do not entail First Amendment triumphs over trademark rights. It is true that each struck down a section of the Lanham Act on First Amendment grounds. See *id.* at 2302; *Matal*, 137 S. Ct. at 1765. But, in striking down sections that established bars on trademark registrations (which bars had not prevented anyone from speaking or making use of any mark), each actually *expanded* trademark rights — and, by empowering trademark owners, made suppression of speech more rather than less possible. See Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 TRADEMARK REP. 797, 802 (2016).

⁸⁷ See Tushnet, *supra* note 79, at 475; Ramsey, *supra* note 86, at 840; see also Simon, *supra* note 70, at 1049 (analyzing a subset of dilution parody cases decided from 1994 and finding that fifty-four percent of such cases were analyzed under the noncommercial use exception).

⁸⁸ One may also worry about the *Jack Daniel's* infringement holding, see 143 S. Ct. at 1593–94 (Sotomayor, J., concurring), but this issue is beyond the scope of this comment.

⁸⁹ 15 U.S.C. § 1125(c).

⁹⁰ See, e.g., Curran, *supra* note 62, at 1081.

⁹¹ See *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 266–68 (4th Cir. 2007); cf. also OSCAR WILDE, *THE PICTURE OF DORIAN GRAY* 6 (Penguin Classics 1891) (“[T]here is only one thing in the world worse than being talked about, and that is not being talked about.”).

⁹² But see Barton Beebe, *The Continuing Debacle of U.S. Antidilution Law: Evidence from the First Year of Trademark Dilution Revision Act Case Law*, 24 SANTA CLARA COMPUT. & HIGH TECH. L.J. 449, 450 (2008) (noting “the remarkable extent to which courts continue to treat the dilution cause of action as redundant of — and, thus, made superfluous by — the infringement cause of action”). However, now that the Court has limited *Rogers* and indicated that parodies may benefit from a friendlier likelihood-of-confusion analysis, plaintiffs may be encouraged to bring *only* dilution claims, which they can win without needing to make any heightened confusion showing.

⁹³ Dogan & Lemley, *supra* note 60, at 544.

an association between a defendant's use and a plaintiff's mark as sufficient for dilution.⁹⁴ Second, there may be some instances — like using a mark for criticism — where confusion is simply not plausible, but dilution is.⁹⁵ Third, this counter would likely not apply to tarnishment: even a use that enhances a mark's distinctiveness by drawing attention to it can do so in a way that harms its reputation — especially in cases of criticism or commentary. Moreover, the dilution analysis may involve surveys and other costly discovery,⁹⁶ making it prohibitively expensive for defendants to fully litigate these cases, whereas the statutory exclusion could be raised on a motion to dismiss.⁹⁷

The *Jack Daniel's* dilution holding threatens speech in a variety of contexts in which a use of a mark is both (at least arguably) source designating and valuably expressive. Such uses can take the form, for example, of criticism of the trademark owner (on so-called “gripe sites”⁹⁸ or by social media accounts dedicated to criticism of a given company⁹⁹); of a means of quickly signaling what a political candidate stands for;¹⁰⁰ of commentary that uses a well-known mark as simile or metonym;¹⁰¹ or as a prism for reflection on the ubiquity of brands in contemporary society.¹⁰² After *Jack Daniel's*, all such uses are potentially at risk.

⁹⁴ Barton Beebe et al., *Testing for Trademark Dilution in Court and the Lab*, 86 U. CHI. L. REV. 611, 612 (2019).

⁹⁵ E.g., FUCK YOU COMCAST, <https://fuckyoucomcast.com> [<https://perma.cc/V326-CVK7>].

⁹⁶ See McGeeveran, *supra* note 78, at 70.

⁹⁷ E.g., United Fed'n of Churches, LLC v. Johnson, 598 F. Supp. 3d 1084, 1102 (W.D. Wash. 2022).

⁹⁸ See, e.g., ROYALDUTCHSHELLPLC.COM, <https://royaldutchshellplc.com> [<https://perma.cc/65M8-ULPD>]; BLOGSPOT: WALMARTSUCKS.ORG, <http://walmartsucksorg.blogspot.com> [<https://perma.cc/95R5-JJC5>]. To be sure, some if not all of these site names would likely not be eligible for trademark protection because they are descriptive and probably do not have secondary meaning. See generally, e.g., Converse, Inc. v. Int'l Trade Comm'n, 909 F.3d 1110, 1116 (Fed. Cir. 2018). But that does not mean that they are not being used as source identifiers.

⁹⁹ See, e.g., I hate United Airlines, FACEBOOK, <https://www.facebook.com/profile.php?id=100064588363628> [<https://perma.cc/K3NH-5M6P>] (social media page dedicated to hating United Airlines); fuck.united, INSTAGRAM, <https://www.instagram.com/fuck.united> [<https://perma.cc/5L84-JHPN>] (social media page dedicated to hating Manchester United).

¹⁰⁰ See, e.g., D. Hunter Schwarz, *This Candidate Had a Fox News-Inspired Logo . . . Until He Didn't*, SUBSTACK: YELLO (May 17, 2022), <https://yello.substack.com/p/this-candidate-had-a-fox-news-inspired> [<https://perma.cc/GV7F-96ZR>].

¹⁰¹ See, e.g., MasterCard Int'l Inc. v. Nader 2000 Primary Comm., Inc., No. 00 Civ.6068, 2004 WL 434404, at *1 (S.D.N.Y. Mar. 8, 2004).

¹⁰² See, e.g., *Submission Guidelines*, TACO BELL Q., <https://tacobellquarterly.org/submission-guidelines> [<https://perma.cc/T89E-EW9C>] (“Taco Bell Quarterly seeks [submissions such as stories and poems] . . . that explore any and all elements of Taco Bell.”).