

**UNITED STATES:**

The Supreme Court rules for Jack Daniel's against a Dog Toy resembling their famous Whiskey Bottle

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On June 8<sup>th</sup>, 2023, the Supreme Court of the United States issued a sentence where the application of the so called "Rogers Test" (Rogers v. Grimaldi, 875 F. 2d 994, a threshold test developed by the US Second Circuit with the aim of protecting the freedom of speech rights of the US Constitution's First Amendment, in a trademark context) has been debated with regard to the application of the trademark law in the United States (Lanham Act).

The dispute has occurred between the entities VIP PRODUCTS, LLC (defendant) and JACK DANIEL'S PROPERTIES INC (plaintiff), as a result of the promotion by VIP PRODUCTS of a chewable toy for dogs, which represents the image of a JACK DANIEL'S whiskey bottle:

The case focuses on the Lanham Act, which prohibits using a trademark that may cause a risk of confusion among consumers, and the US Constitution's First Amendment, which protects forms of parody and satire as necessary elements of freedom of speech.

A lower Court had previously ruled in favour of VIP PRODUCTS, which led JACK DANIEL'S to seek further review from the Supreme Court (writ of certiorari).



On the one hand, JACK DANIEL'S considered that the product manufactured by VIP PRODUCTS represented a double act of infringement and dilution of its registered trademarks. In cases of infringement, it is discussed whether the use of a trademark by the defendant is likely to cause confusion about the origin of the products or services. In cases of dilution of "renowned trademarks", it is discussed when their reputation is damaged as a consequence of the actions carried out by the defendant. However, there are exclusions that make the concept of trademark dilution inapplicable, including "the non-commercial use of the trademark".

On the other hand, VIP PRODUCTS maintained that the application of the "Rogers test" requires the dismissal of an infringement claim unless the complainant can show (1) that the challenged use of a trademark "has no artistic relevance to the underlying work" or (2) that it "explicitly misleads as to the source or content of the work." Since JACK DANIEL'S failed to prove any of the exceptions, VIP claimed that the Lanham Act's "likelihood of confusion" legal standard was irrelevant. VIP also argued that there was no dilution of the JACK DANIEL'S trademark by assuming that its use was a "parody" and, hence, a fair use.



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Finally, it is the Supreme Court that reviews the case and, in its ruling, clearly defines what the “Roger test” is, the cases in which it has been upheld and the reasons why it is not applicable in the present case. It clearly confirms that the **“use of a trademark cannot be considered non-commercial just because it parodies or, more generally, comments on another product,”** as Justice Elena Kagan expressly advocated in her review of the case.

As a result, this decision is a precedent of how the judiciary applies the constitutional rights of freedom of speech in relation to the application of the trademark law.

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