

Citing *Jack Daniel's*, the Ninth Circuit Reverses Itself and Clarifies the Test for Expressive Trademarks

January 25, 2024

In *Punchbowl, Inc. v. AJ Press, Inc.*, the Ninth Circuit revived a trademark infringement case previously dismissed on grounds that the First Amendment shields “expressive” trademarks from Lanham Act liability unless plaintiff can show the mark (1) has no artistic relevance to the underlying work, or (2) explicitly misleads as to its source.¹ This is known as the *Rogers* test, and effectively operates as a shield to trademark liability where it applies. Last year, the Supreme Court limited application of the *Rogers* test in *Jack Daniel's Properties, Inc. v. VIP Products LLC*,² holding that it does not apply where the challenged use of a trademark is to identify the source of the defendant’s goods or services. In those instances, a traditional likelihood of confusion or dilution analysis is required.

The *Punchbowl* case involved coinciding uses of the term “Punchbowl” as both a source-identifying and expressive mark by two online service providers. The Ninth Circuit initially dismissed trademark claims under the *Rogers* test because the defendant’s use of “Punchbowl” to identify its online Washington D.C.-focused news publications was protected expression and not explicitly misleading. But in the wake of *Jack Daniel's*, the Ninth Circuit withdrew and reversed that decision and declared more broadly that its prior precedents shielding expressive source-identifying marks from Lanham Act scrutiny are no longer good law. Going forward, defendants facing trademark claims directed to their use of expressive marks or trade dress to identify source should instead focus their efforts on combatting any showing of alleged likelihood of confusion and establishing other traditional defenses such as laches and estoppel.

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¹ *Punchbowl, Inc. v. AJ Press, Inc.*, No. 21-55881, 2024 WL 134696 (9th Cir. Jan. 12, 2024) (“*Punchbowl II*”).

² 599 U.S. 140 (2023).



Background

In 2021, plaintiff Punchbowl, Inc.—an online party, greeting card, and event planning service—sued defendant AJ Press, LLC for trademark infringement and unfair competition arising from its offering of Punchbowl News, a subscription-based online news service that provides articles and podcasts about American politics.³ The name “Punchbowl” derives from the Secret Service’s nickname for the U.S. Capitol. The district court granted summary judgment for AJ Press, concluding that its use constituted protected expression under *Rogers*.

On appeal, the Ninth Circuit initially affirmed. (“*Punchbowl I*”). It reiterated that where artistic expression is at issue, “the traditional [likelihood of confusion] test fails to account for the full weight of the public’s interest in free expression.”⁴ Instead, courts use *Rogers* to determine whether the Lanham Act should apply. Under the *Rogers* test, defendant must first make a threshold legal showing that its allegedly infringing use is part of an expressive work protected by the First Amendment. If so, the Lanham Act does not apply unless “defendant’s use of the mark (1) is not artistically relevant to the work or (2) explicitly misleads consumers as to the source or content of the work.”⁵

Applying this test, the Ninth Circuit upheld the lower court’s dismissal, rejecting plaintiff’s contention that the *Rogers* test does not extend to the use of brand names. Rather, the “only threshold requirement . . . is an attempt to apply the Lanham Act to First Amendment expression.”⁶ If a work communicates ideas or a point of view, it is expressive.

At the time it decided *Punchbowl I*, the Ninth Circuit’s broad reading of what works or marks are expressive extended to a wide range of activity, regardless of any source-identifying function. This included greeting cards, titles of movies and television shows, songs, and even the trade dress of rubber dog chew toys resembling a bottle of Jack Daniel’s whiskey at issue in *VIP Prods. LLC v. Jack Daniel’s Props., Inc.*

The Ninth Circuit found that “if a rubber dog toy is expressive . . . we have little doubt that AJ Press’s use of the Punchbowl Mark is as well.”⁷ The court reasoned that “Punchbowl” was used to connote a “gossipy setting” and “buzz” about political happenings, and therefore satisfied the threshold for an expressive work. It then concluded that use of “Punchbowl” was artistically relevant to defendant’s services and did not explicitly mislead consumers as to source. To the contrary, the court found that no reasonable buyer would believe that the political news organization Punchbowl News was affiliated with Punchbowl, Inc.’s online services for parties, holidays and other events.

The Supreme Court’s Ruling in *Jack Daniel’s*

On November 21, 2022, the week after the Ninth Circuit decided *Punchbowl I*, the Supreme Court granted certiorari in *Jack Daniel’s*. The Court then unanimously overturned the Ninth Circuit’s ruling, holding that the parody dog chew toy resembling a Jack Daniel’s whiskey bottle fell outside the *Rogers* test because the challenged Jack Daniel’s trade dress was admittedly being

³ *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091, 1095-96 (9th Cir. 2022) (“*Punchbowl I*”).

⁴ *Id.* at 1096.

⁵ *Id.* (citations omitted).

⁶ *Id.* (citations omitted).

⁷ *Id.* at 1098.

used “as a designation of source for [VIP’s] own goods.”⁸

The Court explained that lower courts correctly apply *Rogers* only where the trademark is used “solely to perform some other expressive function,” rather than “to designate a work’s source.”⁹ As an example, the Court pointed to *Mattel, Inc. v. MCA Records, Inc.*, in which Mattel, the maker of Barbie, sued MCA Records over the song “Barbie Girl.”¹⁰ Applying *Rogers*, the Ninth Circuit found that the song did not use the term “Barbie” as a trademark (i.e., to identify the source of the song), but rather, as a means of commenting on consumerism and other social issues. As a further example, the Court highlighted *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, a case involving a pet perfume called “Timmy Holedigger.” There, the district court declined to apply *Rogers*, explaining that it applies only “where the trademark is not being used to indicate the source or origin.”¹¹

Applying these principles, the *Jack Daniel’s* Court held that because VIP alleged ownership over the use of its dog toy’s trademark and trade dress, VIP was using them to identify product source. As such, the protection provided under *Rogers* to expressive marks was not available to VIP, and the Court remanded for application of a traditional likelihood of confusion analysis. In dicta, the Court also noted that VIP may yet prevail below in showing no likelihood of confusion, particularly given that its use of the challenged trade dress was parodic.

The Ninth Circuit’s Decision in *Punchbowl II*

Following *Jack Daniel’s*, the Ninth Circuit issued an order last week withdrawing *Punchbowl I* and

remanding for further proceedings. (“*Punchbowl II*”). It held that *Rogers* does not apply following *Jack Daniel’s* because AJ press is using the Punchbowl mark “to designate the source of its own goods—in other words, has used a trademark as a trademark.”¹² That AJ Press applied for registrations of “Punchbowl News” and “Punchbowl Press” was a strong indication that the marks are source-identifying. As a result, the expressive qualities of the marks are not relevant; *Rogers* does not apply.

The Ninth Circuit rejected attempts to read the Supreme Court’s ruling in *Jack Daniel’s* narrowly or distinguish *Punchbowl* on its facts. It concluded that *Rogers* does not apply even where, as here, the marks at issue are used by two companies in different markets who both use the same common English word to identify their brand. While these factors will certainly be relevant in the likelihood-of-confusion analysis they do not permit application of the *Rogers* test.

Finally, the Ninth Circuit declared that any past precedents holding that “*Rogers* applies when an expressive mark is used as a mark—and that the only threshold for applying *Rogers* was an attempt to apply the Lanham Act to something expressive” are “incorrect” and “no longer good law.”¹³

Key Takeaways

Punchbowl II makes clear that where marks are source-identifying, *Rogers* will not apply no matter how “expressive” they may be. In these instances, courts must apply the likelihood of confusion test to determine whether or not use of the marks at issue is infringing.

⁸ 599 U.S., at 153.

⁹ *Id.* at 154.

¹⁰ 296 F.3d 894 (9th Cir. 2002).

¹¹ 221 F. Supp. 2d 410, 414 (S.D.N.Y. 2002).

¹² 2024 WL 134696, at *7.

¹³ *Id.* at *7.

Before *Jack Daniel's*, application of *Rogers* had become a useful tool for trademark defendants seeking an early exit from lawsuits. Application of the *Rogers* test can often be decided on the pleadings, whereas the likelihood-of-confusion analysis tends to be fact-intensive and less amenable to resolution as a matter of law. The Supreme Court's narrower application of the *Rogers* test will mean more cases are likely to proceed to discovery. Nevertheless, in *Punchbowl II*, the Ninth Circuit expressed skepticism that plaintiff could ultimately prevail in establishing likelihood of confusion or even survive another dispositive motion and urged the court below to consider whether this analysis can be conducted on the present record.

Finally, trademark owners should take note of this decision when registering their marks. While registrations convey *prima facie* evidence of a mark's validity, they also provide strong evidence that the mark is being used as a source-identifier and, accordingly, that the *Rogers* test does not apply.

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