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TRADEMARK OWNERS
WHOSE FAMOUS
BRANDS HAD BEEN
SPOOFED ON
UNRELATED PRODUCTS
HAVE TURNED TO
THE LANHAM ACT
FOR RECOURSE

Trademarks, Parody, and the First Amendment

Robert W. Sacoff



On January 23, 2025, on remand from the U.S. Supreme Court, the U.S. District Court for the District of Arizona issued a long-awaited, 49 page, opinion in *VIP Products LLC v. Jack Daniel's Properties Inc.*, No. CV-14-02057-PHX-SMM (D.

Ariz. Jan. 23, 2025) [Click Here](#), navigating the intersections between parody, trademark law, and freedom of speech under the First Amendment. The court ruled against Jack Daniel's on trademark infringement, but in Jack Daniel's favor on trademark dilution by tarnishment. VIP filed a notice of appeal to the Ninth Circuit Court of Appeals on March 27, 2025.

Parody is nothing new. It is an ancient and classical form of literature and the other arts. According to the *Encyclopedia Britannica*, "One of the earliest examples of parody comes from ancient Greece: *Batrachomyomachia* (The Battle of the Frogs and Mice), in which an anonymous poet imitated the epic style of Homer. Aristophanes parodied the dramatic styles of Aeschylus and Euripides in his play *Frogs* (produced 405 BCE)." [Click Here](#). Today, you can readily watch humorous parodies of current events and public figures every week on *Saturday Night Live*.

Over the years, parody has expanded from purely literary and artistic works into "expressive" branding for products and services sold in commerce. Trademark owners whose famous brands had been spoofed on unrelated products have turned to the Lanham Act for recourse, asserting claims of trademark infringement and dilution. But they have not had an easy time proving either likelihood of confusion or dilution.

A few notable examples:

- *Jordache Ent., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987). Jordache sought to enjoin LARDASHE designer blue jeans, but the court dismissed the federal infringement claim, finding the marks dissimilar and unlikely to cause confusion. It also dismissed the dilution claim, under the New Mexico state statute, stating that the parody actually increased public recognition of the plaintiff's JORDACHE brand without introducing unsavory connotations. [Click Here](#)

- *Tommy Hilfiger Licensing v. Nature Labs, LLC*, 221 F. Supp. 2d 410 (S.D.N.Y. 2002). Another court declined to enjoin TIMMY HOLEDIGGER pet perfume. The court (remarkably) said, “Hilfiger fails to see the humor in all of this.” It found confusion unlikely, and no dilution under the Federal Trademark Dilution Act of 1995 (“FTDA”).

[Click Here](#)

- *Louis Vuitton Malletier S.A. v. Haute Diggity Dog*, 507 F.3d 252 (4th Cir. 2007). And yet another court rejected Louis Vuitton’s request to enjoin CHEWY VUITON dog toys under the Trademark Dilution Revision Act of 2006 (“TDRA”), in which the FTDA’s stringent “actual dilution” requirement had been replaced with a “likelihood of dilution” standard. [Click Here](#)

Against this background, the long-running *Jack Daniel’s* trademark litigation arose over VIP Products’ BAD SPANIELS squeaky dog toy—a rubber, poop-themed parody of JACK DANIEL’S’ famous brand and whiskey bottle:



Jack Daniel’s alleged trademark and trade dress infringement and dilution by tarnishment. VIP countered that its dog toy is a humorous parody, unlikely to cause confusion, and denied any tarnishment.

Under the Lanham Act, trademark infringement and trademark dilution are significantly different claims. Trademark infringement claims are designed to prevent confusion of the public as to the source of products and services. Trademark dilution claims protect the uniqueness and reputation of famous trademarks, regardless of confusion or its absence. Dilution by tarnishment occurs when the famous mark’s reputation is harmed through denigrating association with a similar mark.

The Supreme Court Decision

The litigation went up to the Supreme Court in 2023. *Jack Daniel’s Properties, Inc. v. VIP Products LLC*, 599 U.S. 140 (2023), [Click Here](#). At issue there was whether VIP’s use of the BAD SPANIELS mark and trade dress constituted protectable First Amendment expression under *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), [Click Here](#). In *Rogers*, the Second Circuit Court of Appeals held that the fictional movie title “Ginger and Fred” was entitled to First Amendment protection, and dismissed the trademark claim. The court found the title did not explicitly denote authorship, sponsorship, or endorsement by Ginger Rogers, and was not “wholly unrelated” to the film’s content.

VIP argued to the Supreme Court that the *Rogers* rule also protected its “expressive” dog toy, and therefore precluded the courts from even reaching the trademark infringement and dilution issues. However, the Court unanimously rejected

THE COURT FOUND VIP’S PRODUCT WAS A “SUCCESSFUL PARODY”

that argument, holding that the heightened First Amendment protections under *Rogers* do not apply when a defendant uses the plaintiff’s marks as its own—here, VIP used versions of the JACK DANIEL’S trademarks and trade dress as its own branding. [Click Here](#). Importantly, the Court also acknowledged that “a trademark’s expressive message—particularly a parodic one, as VIP asserts—may properly figure in assessing the likelihood of confusion,” but it remanded the case to the trial court to consider the standard trademark infringement and trademark dilution factors.

On a separate but significant note, Justice Sotomayor issued a cautionary concurring opinion, expressing skepticism of sponsorship or endorsement terminology in confusion surveys in trademark parody cases. She stated “Survey answers may reflect a mistaken belief among some survey respondents that all parodies require permission from the owner of the parodied mark.”

The District Court Decision, on Remand

On remand, the trial court duly considered the infringement and dilution factors, along with the role of parody in that analysis. *VIP Products LLC v. Jack Daniel’s Properties Inc.*, No. CV-14-02057-PHX-SMM (D. Ariz. Jan. 23, 2025). [Click Here](#)

VIP also tried to add a new constitutional challenge to the TDRA, on the ground that it constituted viewpoint discrimination. This had recently been a successful argument in the Supreme Court. In *Matal v. Tam*, 582 U.S. 218, 137 S. Ct. 1744 (2017), [Click Here](#), the Court held that unconstitutional viewpoint discrimination was the basis for invalidating the Lanham Act prohibition against registering “disparaging” trademarks. And in *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019), [Click Here](#), the Court similarly invalidated the Lanham Act registration prohibition for “immoral or scandalous” marks because it permitted viewpoint discrimination. However, the district court did not consider that claim in this case because it had not been raised in the pleadings.

Trademark Infringement

Before analyzing the likelihood of confusion factors, the trial court in this decision addressed the Supreme Court’s statement the accused product must be a “successful parody” to avoid confusion. Citing the “Chewy Vuiton” case, [Click Here](#), the court stated that a successful parody depends on: (1) whether it evokes the original being spoofed, and (2) whether it creates a humorous contrast sufficient to dispel any confusion about the parody’s source. The court found VIP’s product was a “successful parody.” It evoked the original Jack Daniel’s bottle and branding, and also created a humorous contrast. Notably, the court held that humor alone was enough, and rejected the argument that social or other commentary is necessary to constitute a successful parody.

The court then applied the applicable “*Sleekcraft*” likelihood of confusion factors set forth in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979), [Click Here](#). Because of the “successful parody” premise, some factors that normally would have favored Jack Daniel’s “flipped” to favor VIP.

- **Similarity of the Marks** – Strong similarity, but flipped to favor VIP because the marks had to be similar to be a successful parody.
- **Strength of Jack Daniel’s Mark** – Strong mark, but also flipped to favor VIP because a parody depends on the parodied mark’s fame and recognition in order to be successful.
- **Proximity or Relatedness of the Goods Markets** – Favored Jack Daniel’s; the products were different, but Jack Daniel’s licensed dog leashes, collars, and dog houses.
- **VIP’s Intent in Selecting the Mark** – Copying would usually favor Jack Daniel’s, but here, it became “neutral,” because VIP’s intent was to parody, not to deceive.
- **Evidence of Actual Confusion** – Jack Daniel’s “Eveready” survey showed 29% confusion, almost double the widely accepted threshold for probity. Favored Jack Daniel’s, but with limited weight because the survey “may not have accounted for the fact that BAD SPANILS is a parody product,” citing Justice Sotomayor’s skepticism and reservations about surveys in trademark parody cases.
- **Marketing Channels** – Favored Jack Daniel’s, overlapping retail channels, but given limited weight in the overall analysis.
- **Degree of Consumer Care** – Favored Jack Daniel’s; low-cost items typically receive less scrutiny from consumers.

JACK DANIEL’S DECISIVELY WON THE BATTLE OF THE EXPERTS ON DILUTION

The court concluded: “Neither party seizes a runaway victory upon reconsideration of the *Sleekcraft* factors when accounting for the parodic intentions of ‘Bad Spaniels.’” However, the *Sleekcraft* evaluation began “with the premise that a successful parody is unlikely to be confusing.” And following from that premise, the court “flipped” or neutralized three important *Sleekcraft* factors in VIP’s favor, similarity of the marks, intent, and the strength of Jack Daniel’s marks. The court therefore found no likelihood of confusion, and dismissed Jack Daniel’s trademark and trade dress infringement claims.

Trademark Dilution by Tarnishment

The trademark and trade dress dilution claim, however, came out differently. To prove dilution by tarnishment under the TDRA, a plaintiff must show: (1) that its mark or trade dress is “famous,” (2) the defendant’s mark or trade dress is similar, and (3) the defendant’s use is likely to cause reputational harm to the plaintiff’s mark or trade dress.

- **Fame** – The trial court found the Jack Daniel’s mark and trade dress to be famous, as a result of billions of dollars of sales, hundreds of millions of dollars in advertising, and extensive public recognition over the years.

- **Similarity** – The trial court also found VIP’s dog toy intentionally mimicked Jack Daniel’s trademarks and bottle in many respects: the square bottle shape, ribbed neck, arched white lettering on a black label. The spoof wording was also similar: Jack Daniel’s “Old No 7 Tennessee Sour Mash Whiskey” becoming “The Old No. 2 on your Tennessee Carpet,” “40% alcohol by vol. (80 proof)” becoming “43% poo by vol.,” and “100% smelly.”
- **Reputational Harm** – This was hotly contested through competing expert testimony, a battle of the experts.

Jack Daniel’s expert, using a consumer psychology framework, testified that the public had strong positive mental associations with the JACK DANIEL’S brand before the introduction of the VIP product, and that the dog toy’s crude, scatological humor damaged those associations.

VIP’s expert relied on focus groups testing consumer reactions to the BAD SPANIELS product, but the court found the methodology flawed and largely disregarded the results, noting that participants were told upfront that the VIP dog toy was a spoof, undermining the objectivity of their reactions.

Jack Daniel’s decisively won the battle of the experts on dilution. The court found that the BAD SPANIELS dog toy created negative associations, and undermined positive ones, with the

famous Jack Daniel’s brand. The court held for Jack Daniel’s on its dilution by tarnishment claim, and entered an injunction on that ground. The court explained the different outcomes as flowing from the different statutory

goals and requisite elements of proof as between trademark infringement and trademark dilution, essentially confusion of the public versus reputational harm to a famous brand.

Conclusion

Proposing an ultimate conclusion would be premature, because VIP’s appeal to the Ninth Circuit Court of Appeals is yet to be heard. But with that *caveat*, and taking the district court opinion at face value, it still provides some important lessons about parody trademark cases. Before bringing such a case, brand owners should consider whether the challenged branding is a “successful parody,” because “a successful parody is unlikely to be confusing.” On the other hand, even a successful parody may be actionable as dilution if it creates negative associations – scatological or otherwise – that impair the value of the famous mark. Also, when brand owners commission surveys in such cases, they should be mindful of avoiding Justice Sotomayor’s concerns about possible respondent misconceptions. Finally, we may not have heard the last “viewpoint discrimination” challenge to the Trademark Dilution Revision Act of 2006. In sum, parody cases can be won, but they remain an uphill battle for the owners of famous trademarks. ■

PUBLICATIONS

■ Robert Sacoff

An earlier version of Bob's article *Trademarks, Parody, and the First Amendment*, was published in the March AIPPI Newsletter.

PRESENTATIONS

■ Phillip Barengolts



Phil has been selected to present the "International Case Roundup" at the Pharmaceutical Trademark Group Conference in Budapest, Hungary in October 2025.

■ Ashly Boesche



Ashly was a panelist at a Chicago Bar Association Young Lawyers Section event "Federal Court Walk-Through" on March 11, discussing the ins and outs of practice in Federal Court.

*firm*NOTEWORTHY



International Trademark Association

Jonathan Jennings was recognized as a "High-Performing Committee Member" in the International Trademark Association's February 5, 2025 e-Bulletin. [Click Here](#)