



Trademark Lawyer Magazine Publishes Article: US Supreme Court to Rule on Jack Daniel's proposal to throw 'Bad Spaniels' to the dogs

The Trademark Lawyer Magazine features article by Amster, Rothstein & Ebenstein's [Max Vern](#) and [David Goldberg](#) on "US Supreme Court to Rule on Jack Daniel's proposal to throw 'Bad Spaniels' to the dogs". The article was published on pages 8-11, Issue 2 2023 of The Trademark Lawyer Magazine.

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JACK DANIEL'S PROPS. V. VIP PRODS.

US Supreme Court to rule on Jack Daniel's proposal to throw 'Bad Spaniels' to the dogs

Max Vern and David P. Goldberg of Amster, Rothstein & Ebenstein LLP deconstruct the arguments brought against dog toy manufacturer VIP Products LLC, whose product humorously evokes similarities with the famous No. 7 whiskey, to assess the suitability of the application of *Rogers v. Grimaldi*.

This Term, the US Supreme Court heard an appeal in a trademark case that is not just consequential, but also fun. The case involves claims of trademark infringement and dilution by famed US whiskey manufacturer Jack Daniel's Properties, Inc. ("Jack Daniel's") against VIP Products LLC ("VIP"), a manufacturer of humorous dog toys. *Jack Daniel's Props. v. VIP Prods.*, No. 22-148 (US argued Mar. 22, 2023).

Despite the whimsical nature of the claimed infringement, the case is of the foremost importance to trademark practitioners since Jack Daniel's, *inter alia*, challenges the merits and validity of the decision in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), which sets forth the standard test to balance First Amendment concerns and trademark law for expressive works.

Résumés

Max Vern is a Partner and David P. Goldberg is an Associate at Amster, Rothstein & Ebenstein LLP. Their practices focus on trademark law, and they are pleased to be able to help clients obtain, defend, and enforce their trademark rights while maintaining a sense of humor.



Max Vern



David P. Goldberg

In *Rogers v. Grimaldi*, the US Court of Appeals for the Second Circuit protected the rights of producers and distributors of Federico Fellini's motion picture "Ginger and Fred" in a lawsuit by Ginger Rogers, who enjoyed legendary fame as Fred Astaire's dance partner. The plaintiff asserted that the film violated the provisions of the Lanham Act (the US Trademark Act) by creating the false impression that it was about her or that she sponsored, endorsed, or was otherwise involved in the film. The Second Circuit supported the findings by the District Court that use of Rogers' first name in the film title and in the screenplay was an exercise of artistic expression rather than commercial speech and that "because the speech at issue here is not primarily intended to serve a commercial purpose, the prohibitions of the Lanham Act do not apply and the film is entitled to the full scope of protection under the First Amendment."

If, in the present instance, the Supreme Court holds in favor of Jack Daniel's on this point, the case could mark a far more consequential rebalancing of the boundaries of free-speech and trademark protection than the Court's recent decisions expanding the boundaries of the federal registrability of trademarks embodied in *Matal v. Tam*, 137 S. Ct. 1744 (US 2017) and *Iancu v. Brunetti*, 139 S. Ct. 2294 (US 2020), finding

the laws forbidding registration of trademarks that disparage others or are immoral or scandalous trademarks to be unconstitutional.

VIP is a manufacturer of dog toys. Among their products is a line of "Silly Squeakers" toys, which humorously mimic familiar beer, wine, liquor, and soda bottles. One of these dog toys, dubbed BAD SPANIELS, is clearly meant to call to mind the appearance of a bottle of JACK DANIEL'S whiskey, but with a scatological twist. See Figures 1 and 2.

The dogfight between the companies goes back almost 10 years. Not finding the poop-themed toy at all humorous, and notwithstanding the fact that the BAD SPANIELS hang tag includes

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a clear disclaimer that the product is not sold or authorized by Jack Daniel's (see Figure 3), the whiskey company sent VIP a Cease-and-Desist Letter. In response, VIP filed a lawsuit in the US District Court for the District of Arizona seeking, *inter alia*, declaratory judgment that its use of the BAD SPANIELS mark was neither infringing nor dilutory of Jack Daniel's rights. Jack Daniel's filed a counterclaim for both causes of action. In a bench trial, the District Court found in favor of Jack Daniel's. However, the District Court's decision was overturned by the Ninth Circuit Court of Appeals, which held that the District Court erred in finding that the BAD SPANIELS toy was not an expressive work subject to analysis under



Figure 1. JACK DANIEL'S whiskey bottle



Figure 2. BAD SPANIELS dog toy



Figure 3. Reverse side of BAD SPANIELS hang tag

