
Kluwer Copyright Blog

Jack Daniels v. VIP Products and the Freedom to Parody and Comment in the United States

Dave Hansen (Authors Alliance) · Thursday, March 2nd, 2023

This post is based in part on an amicus brief filed by the Harvard Cyberlaw Clinic on behalf of Authors Alliance and ComicMix before the United States Supreme Court in Jack Daniels v. VIP Products.

Ordinarily, authors who write parodies look to copyright limitations and exceptions to protect their rights. In the United States, the doctrine of fair use has been held to permit parody in uses ranging from rap music to children's books. These fair use rights, the courts have said, have their roots in the U.S. Constitution's First Amendment protections for freedom of speech.

In a recent case before the U.S. Supreme Court, *Jack Daniels v. VIP Products*, those parody rights are at risk. In a twist, however, it is not copyright law, but rather an expansive view of trademark law, that poses this threat.

The facts of this case are straightforward: Jack Daniels, creator of the famous Tennessee Whiskey, brought the trademark suit to stop VIP Products for production of a dog toy, which it titled "Bad Spaniels," in the shape of Jack Daniels' iconic whiskey bottle and label. Jack Daniels asserts that the Bad Spaniels toy infringes on its trademark and dilutes its brand. VIP Products counters that the toy is meant to parody Jack Daniels' bottle and is protected speech under the U.S. Constitution's First Amendment.



Jack Daniel's Whiskey Bottle (left) and VIP Products' "Bad Spaniels" dog toy (right). From *Jack Daniels Properties, Inc. s v. VIP Products, LLC*, Case No. 22-148, U.S. Supreme Court, Brief for Petitioner (11 January 2023), page 3, available [here](#).

Although dog toys and whiskey bottles seem relatively inconsequential to literature, parody, and creative work, this case could have a dramatic impact on how authors write about, and parody, famous brands.

Trademarks are a cornerstone of our shared cultural vernacular. Popular brands are woven into the fabric of our national identity, recognizable by and meaningful to those from many different backgrounds. Authors often draw on these shared associations in their literary works, sending beloved fictional characters to real colleges, serving them familiar cereals, and outfitting them in well-known clothing labels. Whether to evoke nostalgia or to immerse their readers, authors use trademarks both to simulate reality and to critique it.

While trademark law aims to protect consumers and prevent confusion as to the source of goods or services, it must be enforced in a manner consistent with the speech protections guaranteed by the First Amendment of the U.S. Constitution. The freedom of authors to use trademarks in their works could be stifled by the threat of litigation. Overenforcement of trademark law runs contrary to both the purpose of intellectual property law and the U.S. constitutional legacy of protecting free expression. Protections for parody in other areas of the law, such as copyright's fair use doctrine,

will be undermined by a trademark ruling that allows for expansive enforcement.

If heightened First Amendment protections are not put in place, the threat of costly legal proceedings may cause creators to avoid the use of trademarks in their artistic works. While trademark law does have other mechanisms to protect authors of parody and commentary, such as a showing that an author's use does not pose a likelihood of confusion, the process for successfully defending a trademark infringement case is remarkably expensive. In 2020, the American Intellectual Property Law Association reported that the median cost of trademark litigation in the U.S. *before even going to trial* ranged from \$150,000 to \$588,000. In the American system, litigants ordinarily bear their own costs, and so even an author who successfully defends such a suit would be on the hook for a large amount in legal fees. While litigation is commonplace for large corporations with significant legal resources, even a single lawsuit could be career-ending for an author without the resources to handle it.

If the threat of legal sanction hangs over the heads of writers, their literary characters may no longer use iPhones, eat at McDonald's, or visit Disneyland. These uses offer meaningful expressive value to authors. Brands are often intentionally selected as cultural signifiers, chosen for the implicit associations they convey to readers. Cory Doctorow's *Down and Out in the Magic Kingdom* (a Disney theme park) would have a different meaning if it were instead titled *Down and Out in an Amusement Park*. Nor is *The Devil Wears Luxury Clothing* as evocative as *The Devil Wears Prada*.

Even when trademarks are evoked in literary circumstances that their owners find distasteful, these uses are still expressive and noncommercial, thus worthy of the highest First Amendment protection. Prioritizing the pecuniary interests of trademark owners over the First Amendment rights of creative artists could lead to a catastrophic chilling effect on authors' speech based on the perceived risk of litigation, whether or not such risk is actualized. This result is both untenable and entirely unnecessary. It is possible to ensure that trademark owners still have access to a wide variety of robust and reasonable remedies in cases of *true* infringement without creating unnecessary panic in many other circumstances.

The Supreme Court has a clear doctrinal path to avoiding a speech-suppressive environment. In *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), the Second Circuit Court of Appeals struck a balance between the interests of trademark owners and First Amendment speech by crafting a clear and efficient test for infringement with appropriate protections for speech. The *Rogers* court recognized the mark owner's interest in preventing confusion while ensuring adequate protection for the vital free speech principles at play, and provided a rule to determine at the outset of litigation—before incurring substantial costs—when expressive works infringe trademark rights. *Rogers*, in short, provided that in cases of artistic or creative works, trademark infringement should only be considered “where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” Ordinarily, the court explained, this rule “will normally not support [the] application of [trademark law] unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.”

A ruling that substantially adopts a test like that in *Rogers* would continue to protect the rights of trademark owners, while also ensuring that authors who reference popular brands are protected by providing a clear, consistent and efficient rule to protect authors. A ruling in favor of Jack Daniels, however, could strike fear into the hearts of risk-averse creators, chilling their speech by

discouraging them from using certain trademarks in their works altogether. It would undermine the otherwise strong protections that U.S. courts have identified for parodists and other authors in U.S. copyright law, under the doctrine of fair use.

To make sure you do not miss out on regular updates from the Kluwer Copyright Blog, please subscribe [here](#).

Kluwer IP Law

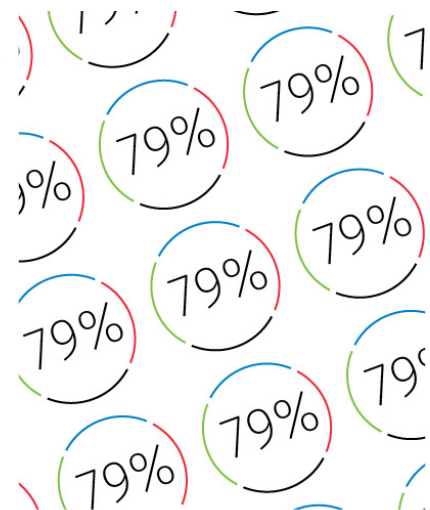
The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

79% of the lawyers think that the importance of legal technology will increase for next year.

Drive change with Kluwer IP Law.

The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT
The Wolters Kluwer Future Ready Lawyer
Leading change

This entry was posted on Thursday, March 2nd, 2023 at 7:58 am and is filed under [Case Law](#), [Exceptions](#), [Fair Use](#), [Infringement](#), [Limitations](#), [USA](#)

You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. You can leave a response, or [trackback](#) from your own site.

