# 15.19A Expressive Works

The defendant’s work, [*insert name of allegedly infringing work*], is an expressive work that is protected by the First Amendment.

Therefore, you may find for the plaintiff on [his] [her] [its] trademark infringement claim only if the plaintiff proves by a preponderance of the evidence that:

1. the defendant’s use of the plaintiff’s mark is explicitly misleading as to the source or content of [*insert name of allegedly infringing work*]; and
2. the defendant’s use of the plaintiff’s mark is likely to cause confusion about the source of the plaintiff’s or the defendant’s goods.

The defendant’s use of the mark is explicitly misleading only if it explicitly misleads consumers into believing that the plaintiff sponsored or is somehow associated with [*insert name of allegedly infringing work*].

# Comment

In general, courts apply a “likelihood-of-confusion test” to claims brought under the Lanham Act. The likelihood-of-confusion test requires the plaintiff to prove two elements: (1) that “it has a valid, protectable trademark” and (2) that “the defendant’s use of the mark is likely to cause confusion.” *Gordon v. Drape Creative, Inc*. 909 F.3d 257, 264 (9th Cir. 2018).

This instruction concerns the Ninth Circuit’s adoption of the Second Circuit’s *Rogers* test, *see Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), which applies to cases involving “expressive works,” *Gordon*, 909 F.3d at 268, and “in which a trademark is used not to designate a work’s source, but solely to perform some other expressive function,” *Jack Daniels Props., Inc. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1586-87 (2023). In *Jack Daniels*, the Supreme Court took “no position on” the merits of the *Rogers* test in other instances but held that where the alleged infringing mark is used as a trademark, meaning “to identify or brand [a defendant’s] goods or services,” the *Rogers* test is not to be applied. *Id.* at 1588-89. In *Jack Daniel’s*, the alleged infringer made a squeaky, chewable dog toy designed to look like a bottle of Jack Daniel’s whiskey that included the descriptive phrase “The Old No. 2 On Your Tennessee Carpet” alongside “Bad Spaniels.” Because VIP Products used Jack Daniel’s trademarks and trade dress for its Bad Spaniels trademark and trade dress, which in turn were used as VIP Products’ source identifiers of its dog chew toy, it was using the alleged infringing mark as its trademark and thus could not avail itself of the *Rogers* test.

*Jack Daniel’s* requires the court, when faced with a *Rogers*-test challenge by a defendant, to determine if the alleged infringing trademark is used as a trademark. If it is not used as a trademark, the court applies the Lanham Act to an expressive work “only if the defendant’s use of the mark is (1) not artistically relevant to the work or (2) explicitly misleads consumers as to the source or the content of the work.” *Gordon*, 909 F.3d at 264. The court in *Gordon* explained the application of that test as follows:

The *Rogers* test requires the defendant to make a threshold legal showing that its allegedly infringing use is part of an expressive work protected by the First Amendment. If the defendant successfully makes that threshold showing, then the plaintiff claiming trademark infringement bears a heightened burden—the plaintiff must satisfy not only the likelihood-of-confusion test but also at least one of *Rogers’s* two prongs . . . . That is, when the defendant demonstrates that First Amendment interests are at stake, the plaintiff claiming infringement must show (1) that it has a valid, protectable trademark, and (2) that the mark is either not artistically relevant to the underlying work *or* explicitly misleading as to the source or content of the work. If the plaintiff satisfies both elements, it still must prove that its trademark has been infringed by showing that the defendant’s use of the mark is likely to cause confusion.

*Id*. at 264-65.

This instruction assumes that the “artistically relevant” prong of the *Rogers* test will have been decided by the trial court. *See Gordon*, 909 F.3d at 269 (noting that “the slightest artistic relevance” will suffice to prove first prong of *Rogers* test).

No case has explicitly decided whether the question of First Amendment protection is to be decided by the court in all instances or whether it is a mixed question of fact and law. This instruction assumes that the court has already determined that the allegedly infringing work is protected by the First Amendment, as was the case in *Gordon*. In a case in which the court concludes there are factual findings a jury must make before deciding the threshold question of First Amendment protection, this instruction should be modified accordingly.

“The *Rogers* test drew a balance in favor of artistic expression and tolerates ‘the slight risk that [the use of the trademark] might implicitly suggest endorsement or sponsorship to some people.” *Dr. Seuss Entprs., L.P. v. ComicMix LLC*, 983 F.3d 443, 462 (9th Cir. 2020) (holding Lanham Act did not apply despite alleged use of trademark when junior use was not explicitly misleading and distinguishing *Gordon*).

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