

famous trademark on noncompetitive goods or services in a manner that is likely to weaken the famous mark's distinctiveness. In the U.S., the "Rogers test" determines if certain unauthorized uses of trademarks that possess artistic or expressive qualities are shielded against claims of infringement and dilution under the freedom of speech provisions of the First Amendment. These protected uses include commentary, criticism, news reporting, education, and research, even if they would typically be considered trademark infringement or dilution. This is commonly referred to as the "fair use" of the trademark. Additionally, current U.S. law provides a defense against trademark dilution claims if the unauthorized use of the trademark is "noncommercial" in nature.

In the case at hand, the BAD SPANIEL'S dog toys humorously imitated the JACK DANIEL'S trademark and trade dress, including the renowned JACK DANIEL'S name (trademark) and the square-shaped whiskey bottle and font (trade dress). VIP Products argued that its BAD SPANIEL toy utilized a "pretend" trademark for a "pretend" product, asserting that such use was noncommercial and qualified for protection as a parody under fair use. Based on these arguments, VIP further contended that the BAD SPANIEL toy did not constitute trademark infringement or dilution.

However, the Court disagreed and concluded that VIP was not solely parodying Jack Daniel's marks but was also employing those parodies as its own "brand" for an actual product. The Court determined that VIP utilized an altered version of the Jack Daniel's name, label, and bottle not only for humor, but also to identify the origin of the dog toy. This finding was supported by the fact that while VIP had not registered BAD SPANIEL'S as a federal trademark, the company possessed registrations for other alcohol-inspired dog toys based on well-known brands, such as SMELLA ARPAW beer can-inspired squeaker toys that resemble the widely recognized STELLA ARTOIS beer. The Court considered this evidence as an indication that VIP was utilizing the parody marks as their own trademarks, leading to the determination that neither the Rogers test nor the fair use or noncommercial defenses applied to such use. From here, unless the parties reach a settlement, the lower court will determine whether the BAD SPANIEL'S toy constitutes infringement or dilution of the JACK DANIEL'S marks.



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As previously mentioned, this case does not significantly alter the landscape of U.S. trademark law or trademark defenses. Rather, it serves as a reminder for companies contemplating the parody of another company's trademark that they must proceed with caution and ensure that such parodies are executed in a non-trademark manner.

If you have questions about this case or how it could impact your business, please contact a member of our [intellectual property](#) team to ensure proper protection of your brand's assets.