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Ninth Circuit Provides Further Guidance on Trademark Lawsuits Involving "Expressive Works"

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We previously discussed the United States Supreme Court's June 2023 *Jack Daniel's Properties, Inc. v. VIP Products, LLC* decision, which altered the way the "*Rogers* test," a doctrine designed to protect First Amendment interests in the trademark context, should be applied. A recent decision out of the Ninth Circuit, *Punchbowl, Inc. vs. AJ Press LLC* (*"Punchbowl II")*, applies the *Rogers* test for the first time following *Jack Daniel's*.

As background, when parties bring trademark infringement claims under the Lanham Act, courts apply a likelihood-of-confusion analysis, asking whether a "reasonably prudent consumer" in the marketplace is likely to be confused as to the origin of the good or service bearing one of the marks. Following the Second Circuit's decision in *Rogers v. Grimaldi*, where background First Amendment concerns were implicated, however, courts began requiring a heightened showing for a trademark infringement claim to proceed: under the *Rogers* test, if a defendant could establish that the allegedly infringing use of a mark was an "expressive work," a Lanham Act plaintiff had to show the use (1) was not artistically relevant to the work or (2) explicitly misled consumers as to the source or the content of the work. In practice, the *Rogers* doctrine was broadly applied, because, as the *Jack Daniel's* Court recognized, "just about everything" can be considered an expressive work. *Jack Daniel's* therefore put guardrails on the use of the *Rogers* test, holding it does not apply when a trademark is used as a "source identifier"—*i.e.*, when "the accused infringer has used a trademark to designate the source of its own goods." In such instances, there is no longer a threshold inquiry into artistic relevance or whether the trademark explicitly misled consumers.

Punchbowl II applies this standard for the first time. The case involves a trademark dispute between two companies that use the name Punchbowl. Punchbowl Inc. specializes in providing online event invitations and greeting cards. AJ Press, LLC owns and operates *Punchbowl News*, a subscription-based news publication focusing on topics in American government and politics. Punchbowl Inc. sued AJ Press alleging violations of the Lanham Act for trademark infringement and unfair competition.

The *Punchbowl* dispute initially reached the Ninth Circuit in November 2022. The district court had applied the *Rogers* test and granted AJ Press's motion for summary judgment, concluding that AJ Press's use of the name "Punchbowl" constituted expressive content and was not explicitly misleading as to its source. The Ninth Circuit affirmed, 52 F.4th 1091 ("*Punchbowl I*"), reasoning that AJ Press's use of the word "Punchbowl" was expressive because it connoted a "gossipy political theme."

But just a week later, the Supreme Court granted certiorari in the *Jack Daniel's* case to consider the contours of the *Rogers* test. Recognizing that the Supreme Court's opinion could affect the body of law it relied on in deciding *Punchbowl I*, the Ninth Circuit stayed the mandate in its *Punchbowl I* decision pending the Supreme Court's ruling. Following *Jack Daniel's*, the Ninth Circuit vacated its *Punchbowl I* decision and heard re-argument.

In *Punchbowl II*, the Ninth Circuit held that the *Rogers* test does not apply to Punchbowl Inc.'s trademark claims because AJ Press used the mark to "identify and distinguish" the source of its news products. Reversing the district court, the Ninth Circuit held that: "As in *Jack Daniel's*, AJ Press must … meet the infringement claim on the usual battleground of likelihood of confusion." Echoing the Supreme Court, the Ninth Circuit reasoned that "*Rogers* does not apply when the challenged use of the mark is as a mark." It does not matter if the defendant's use of the mark is expressive, or even parodic; so long as the defendant uses the mark as a "source identifier," a plaintiff's trademark claims will proceed to the likelihood-of-confusion analysis under the Lanham Act.

The Ninth Circuit emphasized, however, that allowing trademark infringement claims to proceed under the new, limited application of *Rogers* does not bear on whether the plaintiff will actually succeed in the likelihood of confusion analysis. The *Punchbowl* court observed that parodies or particularly expressive works – while no longer immune from the Lanham Act's analysis entirely – are still unlikely to create confusion.

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