David A. Donahue Speaks to Managing IP and Law360 Regarding SCOTUS's Review of Dog Toy Dispute

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David A. Donahue spoke to both *Managing IP* and *Law360* regarding the Supreme Court's decision to review a Ninth Circuit decision in favor of a company that sells a dog toy that resembles a Jack Daniel's whiskey bottle. Jack Daniel's Properties, Inc. ("JDPI") asserted that the toy infringed and diluted its trademarks and trade dress. But the Ninth Circuit held that the toy was an "expressive work" entitled to heightened First Amendment protection and did not infringe JDPI's marks because its resemblance to JDPI's marks was "artistically relevant to the underlying work" and did not "explicitly mislead consumers as to the source or content of the work." The Supreme Court's decision in the case could have long-lasting implications on the intersection between free speech and trademark law.

David tells *Law360* that the case centers on "whether commercial products with purportedly expressive content should be granted the same First Amendment protections against trademark infringement claims as traditionally expressive works such as books, movies and works of art." He goes on to say that a win for the chew toy "would provide additional protection for purportedly parodic commercial products, even where consumers might otherwise be confused as to the source of their product." However, a SCOTUS win for Jack Daniel's would restore the "rigorous, fact-specific traditional likelihood-of-confusion test" for commercial products that are not traditionally expressive works.

David is also quoted in *Managing IP* about what SCOTUS's analysis in the Jack Daniel's case will mean for the Rogers test. This test, devised by The Court of Appeals for the Second Circuit in 1998, states that the Lanham Act should not apply to works of creative expression unless the use of marks

are explicitly misleading or have no artistic relevance. Although many other appellate courts have since applied this test, David points out that this is the first time SCOTUS has taken a case in which Rogers is implicated. He says, “Most people are assuming the court will accept that Rogers is the standard, but that’s not a given.”

Read more from *Law360* here.

Read more from *Managing IP* here. (Subscription required.)

Primary Contacts

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