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The Legal Boundaries between Freedom of Expression and Trademark Infringement: An Analysis of the U.S. Rogers Test

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Abstract. The inherent tension between trademark rights and freedom of expression presents a persistent challenge in intellectual property law. This paper examines this conflict within the U.S. legal framework, further investigating the pivotal Rogers test established to balance trademark protection under the Lanhm Act with First Amendment speech guarantees. Through a literature review and case analysis, the study analyzes the test's application and evolution, particularly in cases involving parody and social commentary, and contrasts the U.S. approach with those of EU and the UK. The findings shows that while the Rogers test provides crucial protection for expressive works, its application is not absolute and faces significant limits when a trademark is used as a source identifier, as clarified by the Supreme Court's recent decision in *Jack Daniel's v. VIP Products*. The paper concludes that achieving a precise, context-sensitive balance remains essential for the future development of trademark law in a rapidly evolving communicative landscape.

Keywords: Trademark, Rogers Test, the Lanham Act, Freedom of Expression

1. Introduction

The conflict between trademark law and freedom of speech, particularly within the context of U.S. law, has long been a significant issue in the field of intellectual property [1]. U.S. trademark law is governed by the Lanham Act, which mainly protects the validity of trademarks by preventing them from being used in commerce in ways that "may cause confusion or deceive" consumers. However, the First Amendment's guarantee of freedom of speech also complicates the use of trademarks. At first, courts viewed trademarks as commercial speech, giving less consideration to their expressive function. But as cases involving artistic works and social commentary increased, courts began to recognize that trademarks not only serve to indicate the source of goods but also carry expressive significance. Most existing research examines how the "Rogers Test" protects the use of trademarks in artistic and expressive works, especially in areas of parody and social commentary [2]. Besides, studies have pointed out that when trademark use has a commercial nature, the current judicial standards still face difficulties in balancing trademark rights with freedom of speech. By employing literature review and case analysis methods, this paper analyzes the application and evolution of the "Rogers Test," with a particular focus on its use across different legal jurisdictions. Additionally, it explores how U.S. courts apply the "Rogers Test" in actual rulings to balance trademark rights and the protection of free speech. The paper also compares the legislative and judicial approaches taken

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by regions such as the European Union and the United Kingdom in addressing similar conflicts between trademarks and freedom of speech. Hence, this paper provides predictions and suggestions for the future development of trademark law in a global context.

2. The conflict and balance between trademark law and freedom of expression

The trademark law in the United States is primarily governed by the Lanham Act, which prohibits the use of trademarks in commercial activities that could cause "confusion, mistake, or deception" [3]. However, the First Amendment grants protection for freedom of speech, especially regarding artistic and critical expression [4]. This has created a conflict between trademark law and freedom of speech, especially when trademarks are used in artistic works, where the trademark may not only serve as an identifier of source but also carry expressive and critical functions.

In the early stages, courts saw trademarks as commercial speech, viewing their main function as identifying the source of goods, which led to limited constitutional protection. Yet, as cases evolved, particularly those involving artistic works, courts acknowledged that trademarks not only identify the source of goods or services but also serve an expressive function. This shift in perspective was especially evident in cases involving artistic works. The landmark case *Virginia State Pharmacy Board v. Virginia Citizens Consumer Council* paved the way for recognizing commercial speech as a protected form of expression, so long as it does not deceive or confuse consumers. Therefore, the conflict between trademark law and free speech became particularly evident in artistic contexts. In *Rogers v. Grimaldi,* the Second Circuit established the "Rogers Test," which limits trademark infringement claims in creative works to cases where the use has no connection to the artistic content or actively misleads regarding the work's origin or subject matter [5]. And this test helps protect artistic expression by ensuring that trademark law does not overly restrict creative works. As courts reassessed the role of trademarks in artistic works, moved from prioritizing commercial interests to balancing those interests with the protection of artistic expression and free speech.

3. The application of the rogers test to trademarks and expressive works

The Rogers test stems from *Rogers v. Grimaldi,* where the Second Circuit considered whether a film title could lawfully include a celebrity's name. As a result, Ginger Rogers sued the movie's producers and distributors, claiming that the title Ginger and Fred violated the Lanham Act because it falsely suggested her involvement in the film. The district court granted summary judgment to the defendants, holding that the title was protected artistic expression. The Second Circuit affirmed, but refined the analysis: it recognized that titles of artistic works are hybrid expressions, combining artistic and commercial elements, and therefore require a balancing approach. The court ruled that the Lanham Act applies to film titles only when the use of a trademark lacks any artistic relevance to the underlying work or deliberately misleads the public about the work's source or content. Under this framework, the court determined that the title Ginger and Fred was artistically connected to the film's narrative, which centers on two fictional dancers who emulate Rogers and Astaire, and found no evidence of deliberate deception. Besides, the court noted that viewers want both accurate information and the freedom to enjoy creative works, and warned that applying the Lanham Act too broadly could violate First Amendment rights [6].

Similarly, in "ETW Corp. v. Jireh Publishing, Inc.", the Sixth Circuit faced the question of whether an artistic painting depicting golfer Tiger Woods and incorporating his registered trademark constituted infringement. The court held that the painting was a commentary on Woods' celebrity status and cultural impact, constituting expressive speech protected by the First Amendment. The

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use of the registered trademark in the painting was not to identify the source of the work but was integrated as part of the subject matter into the overall artistic expression [7]. This ruling explicitly extended the protective scope of the "Rogers" test to the visual arts and reinforced the "transformative use" doctrine, where the use of a trademark is not to identify the source of goods or services but to convey new information, aesthetics, or insights, making such use more likely to be considered protected expression [8].

Through applying and refining the "Rogers" test in a series of cases, U.S. circuit courts gradually developed a judicial consensus: purely expressive works, especially those making transformative use of trademarks for commentary, critique, or artistic purposes, should be granted a high degree of free speech protection. This consensus effectively prevents trademark rights from becoming tools to suppress social criticism and cultural discussion, thereby preserving a healthy public discourse space. However, scholars note that this consensus began to show its limits and generate divergence when confronted with more commercially tinged "merchandised expression" [9].

4. Major challenges and boundaries between commercial and expressive use

The Rogers test protects purely expressive works but is less clear for 'mixed speech,' where uses are both commercial and expressive. Hybrid uses such as satirical merchandise, humorous toys, or comparative advertising resist easy categorization and require courts to balance trademark rights with First Amendment protections.

When a trademark functions mainly as a source identifier, courts apply the Rogers test cautiously, protecting expressive elements only if they do not mislead consumers and have artistic relevance. By contrast, purely commercial uses are evaluated under the Lanham Act's likelihood-of-confusion test, with intermediate scrutiny guided by Central Hudson [10]. Mixed uses require a more nuanced approach. For example, parody products illustrate such hybrid cases. In *Jack Daniel's Properties, Inc. v. VIP Products LLC,* the Supreme Court considered whether a humorous dog toy resembling a Jack Daniel's bottle, renamed "Bad Spaniels" and featuring satirical text, qualified for Rogers test protection. Although the Ninth Circuit had applied Rogers and found no infringement, the Supreme Court reversed, holding that the Rogers test does not apply when the trademark also functions as a source identifier for the defendant's product [11]. In mixed speech cases, if the main purpose is source identification, the likelihood-of-confusion test applies.

Similarly, in comparative advertising, where a competitor's trademark is used to promote one's own products, courts usually treat it as commercial speech, applying the likelihood-of-confusion test while considering First Amendment concerns. In *August Storck K.G. v. Nabisco, Inc.,* the Seventh Circuit applied this test, noting that consumers may be more discerning in such contexts [12, 13]. Meanwhile, merchandise with expressive elements, like parody t-shirts, is often analyzed under a balancing approach similar to the Rogers test, as in *Mutual of Omaha Ins. Co. v. Novak* [14]. Nevertheless, Jack Daniel's clarified that when a trademark also identifies the source of the merchandise, the likelihood-of-confusion framework governs.

Thus, mixed-speech analysis requires a fact-intensive inquiry into whether the primary purpose of the use is source identification or expression. As the Supreme Court held in Jack Daniel's, the Rogers test is context-dependent. Accordingly, courts first assess whether the mark serves source identification or purely expressive purposes, which then guides the balance between protecting creative expression and preventing consumer confusion.

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5. Recent developments and and the reshaping of legal standards

The *Jack Daniel's Properties* case further defined the line between U.S. trademark law and freedom of speech, especially regarding the use of trademarks in parody and satirical products. This shaped the Rogers Test and balanced commercial interests with artistic expression in trademark law. It also showed how trademark law modifies its standards at the intersection of cultural expression and commercial use.

In this case, VIP Products created a parody dog toy called "Bad Spaniels," designed to resemble a Jack Daniel's whiskey bottle, with humorous and satirical text replacing the original branding. The Ninth Circuit Court, applying the Rogers Test, ruled that the product, as an artistic parody, did not constitute trademark infringement. But the U.S. Supreme Court reversed this ruling, clarifying that trademark protection as artistic or cultural symbols should be treated separately. The Court emphasized that when a trademark functions as a source identifier, particularly on products, it must be assessed using the traditional trademark infringement criteria, which considers the "likelihood of consumer confusion." Even if the product contains artistic elements, if its primary function is to identify the source of the goods, the traditional standard for infringement should apply [15].

The case limited the scope of the Rogers test, especially when trademarks are commercialized, with the court emphasizing their role as source identifiers and analyzing trademark infringement. The Supreme Court, through this ruling, clearly defined the legal boundaries between trademarks as cultural symbols and as source identifiers for goods. Thus, the case clarified the future application of trademark law in parody and satirical products. Meanwhile, the court will rigorously examine if the commercial use of a trademark leads to consumer confusion. Moreover, when trademarks are used for artistic expression, the court will place greater importance on protecting freedom of speech, preventing trademark law from restricting creative freedom. This ruling adjusted the standards of trademark law, making it more precise in balancing freedom of speech with commercial interests. Future rulings may further clarify the distinction between "expressive use" of trademarks and their "source-identifying function" and adjust legal standards based on the purpose of use [11].

6. Conclusion

This paper analyzed the interplay between U.S. trademark law and freedom of speech, focusing on the development and application of the Rogers test. Through case studies like *Rogers v. Grimaldi, ETW Corp. v. Jireh Publishing, Mutual of Omaha v. Novak, and Jack Daniel's Properties v. VIP Products,* it found that while purely expressive uses are strongly protected, mixed speech incorporating commercial elements requires context-sensitive balancing, with source-identifying uses governed by the likelihood-of-confusion standard. The research highlights how courts navigate the boundary between artistic expression and trademark protection, ensuring both free speech and consumer clarity. Limitations include a primary focus on U.S. law and the challenge of applying current standards to emerging digital and social media contexts. Future research could explore these new forms of mixed speech, refine criteria for distinguishing expressive versus commercial use, and examine comparative approaches in international jurisdictions to support a more consistent global framework.

References

[1] Lemley, M. A., & Volokh, E. (1998). Freedom of speech and injunctions in intellectual property cases. Duke Law Journal, 48, 147.

[2] Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989). https: //www.oyez.org/cases/1988/88-1806

DOI: 10.54254/2753-7048/2026.LD33888

[3] Lanham Act § 43(a), 15 U.S.C. § 1125(a) (2006). https: //www.law.cornell.edu/uscode/text/15/1125
[4] Nimmer, M. B. (1969). Does copyright abridge the first amendment guarantees of free speech and press. UCLA Law Review, 17, 1180.
[5] Jordan, L. M. (2021). Recent shifts in Rogers v. Grimaldi: Looking for a genuine artistic motive. Entertainment & Sports Law Journal, 37, 39.
[6] Zangrillo, A. (2016). The split on the Rogers v. Grimaldi gridiron: An analysis of unauthorized trademark use in artistic mediums. Fordham Intellectual Property, Media & Entertainment Law Journal, 27, 385.
[7] ETW Corp. v. Jireh Publishing, Inc., 332 F.3d 915, 936 (6th Cir. 2003). https: //uk.practicallaw.thomsonreuters.com
[8] Tushnet, R. (2000). Copyright as a model for free speech law: What copyright has in common with anti-pornography laws, campaign finance reform, and telecommunications regulation. Berkeley Communications Law Journal, 42, 1.
[9] Dogan, S. L., & Lemley, M. A. (2019). Parody as brand. University of Pennsylvania Law Review, 107, 1021-1023.
[10] Central Hudson Gas & Electric Corp. v. Public Service Commission of New York, 447 U.S. 557 (1980). https: //supreme.justia.com/cases/federal/us/447/557/
[11] Rai, D. (2024). Jack Daniel's v. VIP Products: Preserving the Rogers test for bad spaniels. Berkeley Technology Law Journal, 39, 1375.
[12] Beebe, B. (2004). Search and persuasion in trademark law. Michigan Law Review, 103, 2020.
[13] McGeveran, W. (2010). The Trademark Fair Use Reform Act. Boston University Law Review, 90, 2267–2275. https: //scholarship.law.umn.edu/faculty_articles/1012/
[14] Mutual of Omaha Insurance Co. v. Novak, 836 F.2d 397 (8th Cir. 1987). https: //law.resource.org/pub/us/case/reporter/F2/836/836.F2d.397.87-1043.87-1042.html
[15] Tushnet, R. (2023). The Supreme Court's trademark parody case is about more than just Jack Daniel's. SCOTUSblog. https: //www.scotusblog.com/2023/03/the-supreme-courts-trademark-parody-case-is-about-more-than-just-jack-daniels/