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Constitutional Avoidance and Standards of Proof in Trademark Infringement Litigation: A Comment on Post–Jack Daniel’s Applications of the Rogers Test for Liability

The Trademark Reporter, Vol. 114, No. 3

July 2, 2024

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“In *Jack Daniel’s Properties, Inc. v. VIP Products LLC*,¹ the Supreme Court resolved a split among the federal circuit courts of appeal—most pronounced where the Second and Ninth Circuits were concerned—as to whether the pro-defendant test for liability for trademark infringement and unfair competition first set forth in *Rogers v. Grimaldi*² applied in cases challenging uses by defendants that are source-identifying in nature. The Court answered that question in the negative, holding that “[w]hen a mark is used as a mark (except, potentially, in rare situations), the likelihood-of-confusion inquiry does enough work to account for the interest in free expression.”³ In doing so, the Court expressly tempered its holding by observing that “[w]e do not decide whether the *Rogers* test is ever appropriate On infringement, we hold only that *Rogers* does not apply when the challenged use of a mark is as a mark.”⁴ At the same time, a concurring three-Justice bloc led by Justice Gorsuch commented both that “it is not entirely clear where the *Rogers* test comes from,”⁵ and “it is not obvious that *Rogers* is correct in all its particulars”⁶

Jack Daniel’s therefore leaves open the question of *Rogers’s* viability in cases involving artistic or expressive works in which allegedly infringing uses are *not* designations of source for defendants’ own goods and services, a scenario underlying many (and possibly most) applications of *Rogers*. Moreover, to the extent the *Rogers* test *does* remain viable in that context, another critical circuit split exists between the Second Circuit and the Ninth Circuit regarding the proper application of *Rogers’s* second prong, namely, the inquiry into whether a defendant’s use is explicitly misleading. *Jack Daniel’s* therefore cannot be read to resolve all outstanding *Rogers*-related issues.

This article addresses the proper application of the second prong of the *Rogers* test. It argues that the constitutional-avoidance doctrine, which requires interpretations of ambiguous statutes in a manner preventing conflicts with the Constitution,⁷ allows courts to accommodate First Amendment considerations by requiring heightened showings of infringement and unfair competition as part of their consideration of that prong. The statutory causes of action for those torts found in Sections 32(1) and 43(a) of the Lanham Act⁸ identify likely

confusion as the test for liability,⁹ and it is undisputed that plaintiffs asserting them bear the *burden* of proof regarding that circumstance. Neither statute, however, expressly requires application of a particular *standard* of proof. In other contexts, the Supreme Court has mandated use of the clear-and-convincing-evidence standard of proof to avoid difficult constitutional issues, and that mandate can and should apply with equal force in litigation under the Act. In addition, and as set forth below and suggested by Justice Gorsuch's concurring opinion in *Jack Daniel's*, the Act's unambiguous statutory text necessarily renders the Second Circuit's approach to constitutional avoidance in litigation under Sections 32(1) and 43(a) more appropriate than that of the Ninth Circuit."

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