

“Free” Speech: Reframing the *Rogers* Test to Adequately Balance Rights in a Rapidly Evolving Digital Era

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I. INTRODUCTION

Every day, whether it's through browsing the Internet, listening to podcasts, or scrolling on social media, it's hard not to see a mention of burgeoning technology and how it may impact the future of society. Non-fungible tokens (NFTs) are one example of that kind of technology. Celebrities such as Snoop Dogg and Stephen Curry and companies including Adidas are just a fraction of the celebrities and large entities that have tried to capitalize on the profitability that exists within the NFT space.¹ Where once ownership of items and assets existed only in the physical world, now, another realm for ownership has been created. Individuals can own, buy, sell, trade, and display digital assets virtually.² The technologies involved in NFTs are rapidly evolving, meaning the market today may not be the market in the near future.³ Due to their complexity and rapid innovation, NFTs present a variety of challenges for the legal landscape.

In trademark law, NFTs create a new way for parties to potentially infringe upon the trademarks of others. The NFT space is home to a variety of works, and with that, there is an increased need for brands to protect themselves and their products.⁴ The benefit of such a space is that it can foster creativity and the further innovation of cutting-edge technology. A challenge in this space, however, has been the prevalence of alleged counterfeit and pirated items.⁵ Parties have been able to create NFT versions of trademarked items and generate sizeable profits from those NFTs.⁶ The novelty of these issues means that as courts confront them, their rulings can set precedent for both the real and virtual world.⁷

In trademark infringement litigation, several circuits have utilized the test set forth by the Second Circuit in *Rogers v. Grimaldi*, otherwise known

1. See Subin Hong, *9 celebrities who have entered the NFT world, from Leo Messi to Justin Bieber*, LIFESTYLE ASIA (Jan. 5, 2022, 4:11 PM), <https://www.lifestyleasia.com/hk/culture/the-arts/celebrity-nfts-cryptocurrency-metaverse/> [https://perma.cc/C9HD-UUH6].

2. See Ollie Leech, *What are NFTs and How Do They Work*, COINDESK (Aug. 23, 2022, 10:43 AM), <https://www.coindesk.com/learn/what-are-nfts-and-how-do-they-work/> [https://perma.cc/3JKU-AVR6]; Robyn Conti, *What is an NFT? Non-Fungible Tokens Explained*, FORBES ADVISOR (Mar. 17, 2023, 12:57 AM), <https://www.forbes.com/advisor/investing/cryptocurrency/nft-non-fungible-token/> [https://perma.cc/AY7L-ZRHJ].

3. COINDESK, <https://www.coindesk.com/indices/cmi/> [https://perma.cc/3LPS-VV4L] (last visited Mar. 4, 2023).

4. Conti, *supra* note 2.

5. Svetlana Ilnitskaya, Dir. of Customer Strategy, Corsearch, Remarks before the U.S. Patent and Trademark Office (Jan. 24, 2023), <https://www.uspto.gov/sites/default/files/documents/NFT-Roundtable-TRADEMARK-Jan24-TRANSCRIPT.pdf> [https://perma.cc/AT4L-XYAT], at 10-12.

6. Kevin Collier, *NFT Art Sales are Booming. Just Without Some Artists' Permission*, NBC NEWS (Jan. 10, 2022, 3:53 PM), <https://www.nbcnews.com/tech/security/nft-art-sales-are-booming-just-artists-permission-rcna10798> [https://perma.cc/8FEY-LUVY]; Ilnitskaya, *supra* note 5, at 11-12.

7. Andrew Steinwold, *The History of Non-Fungible Tokens (NFTs)*, MEDIUM (Oct. 7, 2019), <http://108.166.64.190/omeka222/files/original/453bc3985fdc186319dcaac0fcc9f8a.pdf> [https://perma.cc/CS6N-FMDG].

as, the *Rogers* test, to assess whether an alleged infringing use of another's trademark is permitted as an expressive work under the First Amendment.⁸ In trademark infringement litigation concerning NFTs, district courts have been confronted with the *Rogers* test's potential application to NFTs in that context.⁹ As more cases of this category continue to be confronted by courts, some argue that the *Rogers* test is not the appropriate test to analyze NFTs, as it may not account for the nuance of what is largely uncharted territory for trademarks.¹⁰ Further, the *Rogers* test may also not be the right test because of its inconsistent application across all trademark infringement suits.¹¹ NFT trademark infringement litigation is raising novel legal issues that call into question the workability of the *Rogers* test overall. Absent reform, the *Rogers* test will not strike the appropriate balance between the protection of trademark holders' intellectual property rights and the public's interest in the protection of freedom of expression under the First Amendment as applied to new technologies such as NFTs.

Through a look into the use of the *Rogers* test across trademark infringement suits and in the newer class of NFT trademark infringement suits, this Note will highlight the inconsistencies in the *Rogers* test's application, examine the application of *Rogers* in NFT trademark infringement suits, and propose a reframed version of the *Rogers* test that, if adopted by all federal circuits, would achieve a proper balance between the protection of intellectual property rights through trademark law and First Amendment protections over artistic expression. The changes to the *Rogers* test will also make the test more adaptable to technological advances in our ever-changing society, beyond NFTs. Part II will provide background into trademark law and the *Rogers* test. Part III will further discuss the application of the *Rogers* test, address the issues with applying the *Rogers* test, and propose adjustments to the *Rogers* test that would have beneficial results for trademark owners, artists, and the average consumer.

8. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989); Anthony Zangrillo, *The Split on the Rogers v. Grimaldi Gridiron: An Analysis of Unauthorized Trademark Use in Artistic Mediums*, 27 FORDHAM INTELL. PROP. MEDIA & ENT. L. J. 385, 403-14 (2017) (discussing the different applications of the *Rogers* test by the Second, Ninth, and Sixth Circuits).

9. *Hermès Int'l v. Rothschild*, 603 F. Supp. 3d 98, 102-03 (S.D.N.Y. 2022); *Yuga Labs, Inc. v. Ripps*, No. CV 22-4355-JFW(JEMx), 2022 WL 18024480, at *1 (C.D. Cal. Dec. 16, 2022).

10. See Kasey Boucher & Jonathan M. Gelchinsky, *Federal Court Rules MetaBirkin NFTs Entitled to First Amendment Protection in Hermès Trademark Case*, NAT'L L. REV. (May 20, 2022), <https://www.natlawreview.com/article/federal-court-rules-metabirkin-nfts-entitled-to-first-amendment-protection-herm-s>. [<https://perma.cc/6T7U-ZS2L>]; See also Isaiah Poritz, *MetaBirkin NFT Suit Ripe for Rogers Trademark Test, Judge Says* BLOOMBERG L. (May 19, 2022), <https://news.bloomberglaw.com/ip-law/metabirkins-nft-suit-ripe-for-rogers-trademark-test-judge-says> [<https://perma.cc/XQW9-MF7W>].

11. See generally Zangrillo, *supra* note 8.

II. BACKGROUND

Before analyzing the *Rogers* test and its challenges as applied to a technologically advancing world, it is important to understand the foundations of trademark protection under U.S. law.

A. Trademark Law Basics

The United States Patent and Trademark Office defines a trademark as “any word, phrase, symbol, design, or a combination [of those things] that identifies [the source of one’s] goods or services.”¹² Traditionally, designations that are trademarkable include one or more letters, a word, image, shape, or color.¹³ Trademarkable designations have (less frequently) also included sounds, fragrances, and flavors.¹⁴ Trademarks do not have to be registered by the United States Patent and Trademark Office to be afforded legal protections.

Trademarks perform four tasks that courts have found are deserving of legal protection.¹⁵ The four tasks are, “(1) to identify one seller’s goods and distinguish them from goods sold by others, (2) to signify that all goods bearing the trademark come from or are controlled by a single source, (3) to signify that all goods bearing the trademark are of an equal level of quality, and (4) as a key part of advertising and selling the goods and services.”¹⁶ Additionally, trademarks are a visual symbol of the goodwill and reputation that has been established by a product or service.¹⁷

Marks must be distinctive to be protected as trademarks.¹⁸ If a designation performs the job of identifying and distinguishing the goods or services with which it appears, it is “distinctive.”¹⁹ In determining distinctiveness, courts have created four categories for trademarks based on the relationship between the mark and the product.²⁰ A mark may be: (1) arbitrary or fanciful, (2) suggestive, (3) descriptive, or (4) generic.²¹ An arbitrary mark is one that shows no logical relationship to the underlying product or service.²² “Victoria’s Secret,” which bears no logical relationship to its products—clothing and women’s intimates—is an example of an arbitrary mark.²³ A suggestive mark suggests a characteristic of the underlying product or service but requires some thought to reach a conclusion

12. U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/basics/what-trademark> [<https://perma.cc/63M6-8XXW>] (last visited Mar. 4, 2023).

13. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3.1 (5th ed. 2022).

14. *Id.*

15. *Id.* at § 3.1.

16. *Id.*

17. *See Matal v. Tam*, 582 U.S. 218, 244 (2017).

18. 15 U.S.C. § 1127.

19. MCCARTHY, *supra* note 13, at § 3.1; 15 U.S.C. § 1127.

20. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

21. MCCARTHY, *supra* note 13, at § 11.1.

22. *Id.* at §§ 11:12–13.

23. *See Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 426 (2003).

as to what the product or service is.²⁴ “COPPERTONE” for suntan lotion would be an example of a suggestive mark. A descriptive mark generally describes a characteristic or the entirety of the underlying product or service such as “American Airlines” to describe an airline in America.²⁵ Lastly, a generic mark describes the general category of the underlying product.²⁶ If a mark falls into the generic category, it is not entitled to trademark protection.²⁷ For example, a coffee brand entitled “Coffee” would be generic and not entitled to trademark protection.

B. Trademark Law Goals and an Introduction to Infringement

Trademark law has several goals. One goal is to protect the public from being deceived.²⁸ Another goal is to protect markholders from misappropriation or trademark infringement.²⁹ There is a benefit to consumers when brands are recognizable by their trademarks. Brands develop trust from their customers and establish a reputation over time. Trademarks help to maintain consumer trust and brand reputation through the confirmation of the source of a product or service.³⁰ Section 1114 of the United States Code states that a trademark is infringed when, “without the consent of the trademark registrant . . . [there is] use in commerce . . . any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . .”³¹ Commerce is crucial to trademark law; if there is no use in commerce then there is no mark to protect.³² Section 1114 is part of what is also known as the Lanham Trademark Act, the federal statute governing trademark law.³³ The Lanham Act provides federal causes of action for trademark infringement, trademark dilution, and several other offenses.³⁴

A trademark is infringed if there has been a use in commerce of a registered mark in connection with the sale, distribution, or advertising of any goods or services with which the use is likely to cause confusion, mistake, or

24. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768-69 (1992); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212 (2000).

25. MCCARTHY, *supra* note 13, at § 11:16.

26. *Id.* at § 23:49.

27. *Id.* at § 3.1.

28. See *Inwood Lab’ys, Inc. v. Ives Lab’ys, Inc.*, 456 U.S. 844, 849 n.7 (1982).

29. See 15 U.S.C. § 1125; See also *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 28 (2003).

30. MCCARTHY, *supra* note 13, at § 2:2.

31. 15 U.S.C. § 1114.

32. *Id.*; U.S. PATENT & TRADEMARK OFF., <https://www.uspto.gov/trademarks/basics/scope-protection> [https://perma.cc/J4W6-NXF8] (last visited Jan. 21, 2023).

33. Practical Law Intellectual Property & Technology, Lanham Trademark Act (Lanham Act), Practical Law Glossary Item 8-501-4903., <https://us.practicallaw.thomsonreuters.com/8-501-4903> [https://perma.cc/HLF8-T CJY]; The Lanham Trademark Act, 15 U.S.C. §§ 1051-1127 (2020).

34. Practical Law Intellectual Property & Technology, *supra* note 33; 15 U.S.C. §§ 1051-1127.

deception.³⁵ To prevail on a trademark infringement claim, a plaintiff must establish that it has a valid mark entitled to protection and that the defendant used the same or a similar mark in commerce in connection with the sale or advertising of goods without the consent of the plaintiff in such a way that is likely to cause confusion.³⁶ Satisfying the requirements of “use” and “in commerce” are straightforward elements of the claim. The standard used to evaluate the last element of whether there has been trademark infringement is referred to as the “likelihood of confusion test.”³⁷ Likelihood of confusion exists when an alleged trademark infringement causes probable confusion in reasonably prudent consumers as to the origin of products or services.³⁸ It is not sufficient for confusion to be merely “possible,” the likelihood of confusion must go beyond mere possibility and be probable.³⁹ This means that proving actual consumer confusion is not necessary to establish a successful trademark infringement claim.⁴⁰

Courts have considered a multitude of factors to assess whether a consumer is likely to be confused by an alleged infringement.⁴¹ In *AMF v. Sleekcraft Boats*, the Ninth Circuit provided eight factors relevant to finding a likelihood of confusion.⁴² The eight *Sleekcraft* factors are: (1) strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels; (6) type of goods and purchaser care; (7) intent; and (8) likelihood of expansion.⁴³ Each Circuit uses a variation of the above rules and factors to determine likelihood of confusion.⁴⁴ The modern Restatement of Unfair Competition also lists nine foundational factors that are relevant to determining whether the likelihood of confusion exists.⁴⁵ The Restatement notes, however, that “no mechanistic formula or list can set forth in advance the variety of elements that comprise the market context from which likelihood of confusion must be determined.”⁴⁶

35. 15 U.S.C. § 1114(a); 15 U.S.C. § 1125(a).

36. 15 U.S.C. § 1114 (further explanation of the required elements of use, in commerce, and likelihood of confusion to establish infringement).

37. See MCCARTHY, *supra* note 13, at § 23:1; See also *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 117 (2004).

38. See *KP Permanent Make-Up, Inc.*, 543 U.S. at 117.

39. MCCARTHY, *supra* note 13, at § 23:3; *Am. Steel Foundries v. Robertson*, 269 U.S. 372, 382 (1926); *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503, 1510 (2d Cir. 1997).

40. MCCARTHY, *supra* note 13, at § 23:3.

41. *Id.*

42. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979).

43. *Id.* at 348-49.

44. See *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (Second Circuit uses factored test for likelihood of confusion); See *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373 (Fed. Cir. 1998) (Federal Circuit application of “DuPont Factors” to test likelihood of confusion); See also *Application of E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (listing of the “DuPont Factors”); See *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 463 (3d Cir. 1983) (Third Circuit “Lapp Factors” for likelihood of confusion).

45. MCCARTHY, *supra* note 13, at § 23:19, .

46. *Id.*; RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 cmt. a. (AM. L. INST. 1995).

C. *Defenses to Trademark Infringement: Rogers v. Grimaldi*

In response to a trademark infringement claim, a defendant may raise a multitude of defenses to combat the assertion.⁴⁷ If proven, the defendant prevails, and his mark may continue to exist unchanged in the market. Defendants in trademark infringement claims can assert what have been referred to as “Free Speech” defenses: the First Amendment, parody, and fair use.⁴⁸ Each defense, if established, renders the defendant’s conduct a non-infringing use of another’s mark.⁴⁹ The focus of this Note will be the First Amendment defense outlined in the seminal case, *Rogers v. Grimaldi*.

The dispute in *Rogers* concerned the title of a film, however, the test used applies to all works of artistic expression such as paintings, drawings, video games, toys, and greeting cards.⁵⁰ In *Rogers*, the famous actor duo Ginger Rogers and Fred Astaire’s names were used in the title of a film called “Ginger and Fred.”⁵¹ The film tells the story of two Italian cabaret performers who imitated Ginger Rogers and Fred Astaire in their performances.⁵² Rogers filed suit on the contention that the title of the film created a false impression of her endorsement of the film and the false impression that she was the subject of the film.⁵³ The court had to determine whether Rogers could prevent the use of her name in the film title for a movie that had very little relation to her.⁵⁴ The court found that the use of Rogers’ first name in the film title was an exercise of artistic expression that did not “explicitly mislead” consumers and thus was not prohibited by the Lanham Act under 15 U.S.C § 1125(a).⁵⁵ In assessing artistic relevance, courts are not making determinations on the quality of the alleged artistic work, but are instead assessing the relevance of the mark compared to the expressive content of the work.⁵⁶ The standard is that the relevance must be above zero.⁵⁷ In recent years, the *Rogers* test has gained newfound relevance as NFTs have become a point of contention in trademark infringement suits where parties disagree over whether trademark usages are protected or prohibited under the law.

The test outlined in *Rogers* is a two-step balancing test for when a trademark is used in an expressive work aimed at balancing the rights between free speech under the First Amendment and Trademark Law policy

47. MCCARTHY, *supra* note 13, at §§ 31:43-44, 31:139, 31:156.50.

48. *Id.* at §§ 31:139; 31:153; 31:156.50.

49. *Id.*

50. *See id.* at § 31:139 (The *Rogers* test applies to all artistic works of expression and does not apply to commercial advertisements or infomercials); *Rogers*, 875 F.2d at 997.

51. *See Rogers*, 875 F.2d at 996-97.

52. *Id.*

53. *Id.*

54. *Id.* at 996.

55. *Id.* at 1005.

56. *See E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008).

57. *See id.*

preventing consumer deception and confusion.⁵⁸ The decision in *Rogers* was a landmark decision for trademark law and the test the court provided in the case has been adopted and followed by several federal circuits.⁵⁹ The two-pronged test states that a trademark used in an alleged expressive work is trademark infringement under the Lanham Act only if the mark; (1) has “no artistic relevance” to the accused work, and (2) use of the mark in the accused work “explicitly misleads” consumers as to the source or content of the work. The court in *Rogers* also stated that “the Lanham Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”⁶⁰ The *Rogers* test provides the infrastructure for courts to balance a defendant’s (and the public’s) interest in freedom of expression with the interest in the protection of intellectual property rights of trademark owners under the Lanham Act.⁶¹ The existence of a likelihood of confusion must still be demonstrated by the plaintiff alongside proving that at least one of the two factors in the *Rogers* test are met in order to prevail.⁶²

D. *The Inconsistent Application of the Rogers Test*

The purpose of the *Rogers* test was to balance the purposes of trademark law, specifically, preventing consumer confusion, with the protections over freedom of expression afforded by the First Amendment.⁶³ The *Rogers* test has been adopted and used by the Third, Fifth, Sixth, Ninth, and Eleventh Circuits as well as by several federal district courts.⁶⁴ Courts have noted, however, that the First Amendment protections cannot provide blank check permission to name and advertise his or her works to “anyone who cries ‘artist.’”⁶⁵ Thus, a balance must be struck.⁶⁶ Different courts have found that different methods do the job of striking the sought-after balance. Some courts have found that the application of the likelihood of confusion test alone strikes an appropriate balance between the rights of trademark

58. The First Amendment of the United States Constitution states, “Congress shall make no law . . . prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press . . .” US CONST. amend. I; MCCARTHY, *supra* note 13, at § 31:144.50.

59. See, e.g., *Parks v. LaFace Recs.*, 329 F.3d 437, 450 (6th Cir. 2003); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 (5th Cir. 1999); *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

60. See *Rogers*, 875 F.2d at 999.

61. *Id.* at 999-1000.

62. See *Gordon v. Drape Creative Inc.*, 909 F.3d 257, 264 (9th Cir. 2018).

63. See *Rogers*, 875 F.2d at 999.

64. See e.g., *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 339 (3d Cir. 1998); *Sugar Busters LLC*, 177 F.3d at 269; *Parks*, 329 F.3d at 452; *E.S.S. Ent. 2000, Inc.*, 547 F.3d at 1099; *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012); *Hermes Int’l*, 603 F. Supp. 3d at 277.

65. See *Parks*, 329 F.3d at 447; See also *Yuga Labs, Inc.*, 2022 WL 18024480, at *1.

66. See *Rogers*, 875 F.2d at 999.

owners and First Amendment protections.⁶⁷ Alternatively, other courts have opted for the “alternative avenues” analysis and have found that the First Amendment is not violated so long as there are “alternative avenues of communication” available to the artist.⁶⁸ Arguments have also been raised as to the applicability of a Right of Publicity Analysis which would build upon precedent set by an alternate test.⁶⁹ The *Rogers* test is the most employed because, as was stated by the Court in *Parks*, the other tests do not “accord adequate weight” to First Amendment interests when applied to specific circumstances.⁷⁰

The two prongs of the *Rogers* test—artistic relevance and whether the use of the mark is “explicitly misleading”—provide direction for how to balance the interests of trademark owners and consumers and the interest in protecting freedom of expression.⁷¹ After *Rogers* was decided, the Second Circuit, however, revisited the application of the *Rogers* test and further defined how it should apply to certain works.⁷² For example, in *Cliffs Notes*, where the defendant created a parody of the study guide, “Cliffs Notes” titled “Spy Notes,” the Second Circuit held that “the *Rogers* balancing approach is generally applicable to Lanham Act claims against works of artistic expression, a category that includes parody.”⁷³ In reaching this decision the court did not apply the “explicitly misleading” prong set forth in *Rogers* and instead applied the likelihood of confusion analysis, balancing the benefits to the public interest in avoiding consumer confusion with the public interest in protecting free expression.⁷⁴

67. See *Mattel, Inc.*, 296 F.3d at 900; See also *Lamparello v. Falwell*, 420 F.3d 309, 314 (4th Cir. 2005); See generally *Zangrillo*, *supra* note 8; See generally David M. Kelly & Lynn M. Jordan, *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 99 L. J. OF INT’L TRADEMARK ASS’N 1360, 1362 (2009).

68. See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (holding that trademark is “in the nature of a property right and as such it need not ‘yield to the exercise of First Amendment rights under circumstances where . . . alternative avenues of communication exist” and in the present case there were a number of ways for the defendants to comment on the relevant topic without infringing on the plaintiff’s trademark); See also *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972) (stating that yielding to the exercise of First Amendment rights where alternative avenues of communication exist would be an infringement of property rights without “significantly enhancing the asserted right of free speech”).

69. See *Zangrillo*, *supra* note 8, at 400 (details the *Saderup* case and origin of the transformative use test); See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001) (holding that First Amendment protections did not extend to an artist’s use of famous comedy performers’ likeness because of the accompanying dangers where there are no “transformative elements”).

70. See *Parks*, 329 F.3d at 448-49.

71. See *Kelly & Jordan*, *supra* note 67, at 1384-85.

72. See *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp.*, 886 F.2d 490, 495 (2d Cir. 1989) (holding that the public interest in free expression outweighs slight risks of consumer confusion); See also *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379-80 (2d Cir. 1993) (analyzing the “explicitly misleading” prong of the *Rogers* test through use of the *Polaroid* likelihood of confusion factors to determine whether the likelihood of confusion is sufficiently compelling to outweigh First Amendment interests).

73. See *Cliffs Notes, Inc.*, 886 F.2d at 495.

74. See *id.* at 497.

The Ninth Circuit has also confronted the *Rogers* test and expanded the test in its application.⁷⁵ On March 23, 2023 the Supreme Court heard oral argument in *Jack Daniel's Properties, Inc. v. VIP Products, LLC*, a case that centers around a chewy dog toy that resembles Jack Daniel's Old No. 7 whiskey bottle.⁷⁶ The Ninth Circuit applied the *Rogers* test and held that the dog toy was an expressive work, satisfied the prongs of the test and was therefore not an infringing work.⁷⁷ The Supreme Court's decision in *Jack Daniels* was published on June 8, 2023.⁷⁸ In a narrow ruling, the Supreme Court held that the *Rogers* test does not apply where the "challenged use of a mark is as a mark" and reversed the Ninth Circuit's judgment.⁷⁹ Here, VIP Products' use of Jack Daniel's mark on a dog toy was held by the Supreme Court not to fall within the goals of trademark law and thus did not receive heightened First Amendment protection.⁸⁰ Importantly, in concurrence with the decision, Justice Gorsuch wrote that the Court's decision left much of the *Rogers* test unaddressed and indicated that questions surrounding the test's parameters and applicability might arise again in the future.⁸¹ The Sixth Circuit has applied the test by looking further into the artistic relevance prong and considering the specific use by the defendant of the mark.⁸² Prior to a 2013 case, *Eastland Music Group, LLC v. Lionsgate Entertainment, Inc.*, the Seventh Circuit had declined to opine on the applicability of the *Rogers* test for balancing trademark and First Amendment interests.⁸³ More recently, a

75. See *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302, 304 (9th Cir. 1992) (Two nationally circulating newspapers polled their readers on pop group, New Kids on the Block through a phone number that charged between 50 and 95 cents per minute. The group alleged infringement of their New Kids on the Block trademark, and the district court held that *Rogers* focused on "First Amendment values in the context of artistic expression," which extended to the gathering and dissemination of news. The Ninth Circuit affirmed the decision.). See also *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003) (implementing a "cultural significance" requirement onto marks which provides that First Amendment protections will only be afforded to works that include marks that have entered public discourse). But see *E.S.S. Ent. 2000, Inc.*, 547 F.3d at 1099 (removing the cultural significance requirement and instead holding that a work's relevance level must simply "be above zero").

76. See generally, *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170 (9th Cir. 2020).

77. *Id.* at 1175-76.

78. *Jack Daniel's Prods., Inc., v. VIP Prods. LLC*, 599 U.S. 140 (2023).

79. *Id.* at 163.

80. *Id.* at 145.

81. *Id.* at 165.

82. See *Parks*, 329 F.3d at 452 (A producer and rap group used the phrase "move to the back of the bus" in a rap song that may have indicated an association with Rosa Parks, so the *Rogers* test was the most appropriate framework under which "to balance the public interest in avoiding consumer confusion with the public interest in free expression." The court stated that relationship between Rosa Parks and moving to the back of the bus is unmistakable thus the song needed not be about Parks in the strict sense but could be considered to be artistically relevant as a metaphor or symbolically.).

83. See *Eastland Music Grp., LLC v. Lionsgate Ent., Inc.*, 707 F.3d 869, 871 (7th Cir. 2013) (The court refused to adopt or reject the *Rogers* test and instead stated that it is "unnecessary to consider possible constitutional defenses to trademark enforcement . . . because the complaint . . . does not allege that the use of "50/50" as a film title has caused any confusion about the film's source.").

new class of cases has once again reignited the question of the applicability of the *Rogers* test to certain works.⁸⁴

Trademark infringement suits concerning non-fungible tokens are raising novel legal questions about artistic expression in the digital assets space and what protections may be afforded.⁸⁵ For context, a non-fungible token (NFT) is a unique, non-interchangeable digital asset that consumers can purchase, trade, and sell to show their ownership over an item on the digital ledger system known as the blockchain.⁸⁶ A variety of companies and public figures have filed trademark applications for NFTs of their name or their products including Converse, Jay-Z, and Ticketmaster.⁸⁷ The NFT space is ripe with competition, due to its high activity, and can be very lucrative.⁸⁸ In such an environment, acquiring trademark rights for an NFT has added importance to ensure that the rights in that NFT are protected by the owner.⁸⁹ Some of the rights that NFT owners can protect through trademark are exclusive use, brand credibility, and brand stability.⁹⁰ Acquiring trademark rights for an NFT also increases the NFT's value as a brand or as part of a brand.⁹¹

NFTs also have the capability of infringing upon or diluting existing trademarks.⁹² Where alleged infringing uses of another's mark through NFTs have occurred, courts have been asked to apply the *Rogers* test to afford First Amendment protection for an alleged infringing work. For example, in *Hermès v. Rothschild*, plaintiff Hermès is a well-known luxury fashion

84. See, e.g., *Hermès Int'l*, 603 F. Supp. 3d at 102-03; *Yuga Labs, Inc.*, 2022 WL 18024480, at *1.

85. See, e.g., *Hermès Int'l*, 603 F. Supp. 3d at 102-06; *Yuga Labs, Inc.*, 2022 WL 18024480, at *1.

86. See generally Mary Kate Brennan et al., *Demystifying NFTs and intellectual property: trademark and copyright concerns*, REUTERS (June 17, 2022), <https://www.reuters.com/legal/legalindustry/demystifying-nfts-intellectual-property-trademark-copyright-concerns-2022-06-17/> [<https://perma.cc/5D7N-EED4>]; See *What is blockchain technology?*, IBM (Nov. 22, 2022), <https://www.ibm.com/topics/what-is-blockchain> [<https://perma.cc/LHD8-XD49>]; See also Blockchain Research Institute, *An Intro to Blockchain and NFTs*, BLOCKCHAIN RSCH. INST., <https://www.blockchainresearchinstitute.org/an-intro-to-blockchain-and-nfts/> [<https://perma.cc/M5GL-QHSS>]; Leech, *supra* note 2.

87. U.S. PAT. & TRADEMARK OFF., *TESS SEARCH*, https://tsdr.uspto.gov/#caseNumber=97107367&caseType=SERIAL_NO&searchType=statusSearch [<https://perma.cc/6HWP-S235>]; U.S. PAT. & TRADEMARK OFFICE, *TESS SEARCH*, <https://tsdr.uspto.gov/documentviewer?caseId=sn97118641&docId=APP20211113095707#docIndex=5&page=1> [<https://perma.cc/7XHL-6XP5>]; U.S. PAT. & TRADEMARK OFF., *TESS SEARCH* <https://tsdr.uspto.gov/documentviewer?caseId=sn97089225&docId=APP20211026093031#docIndex=15&page=1> [<https://perma.cc/W3DJ-D4L3>].

88. See, generally *Spaceageagency*, SPACE AGE, <https://spaceage.agency/nft-marketing-guide/> [<https://perma.cc/KVX9-DPXY>] (last visited Feb. 26, 2024).

89. See generally Brennan, *supra* note 86.

90. U.S. Pat. & Trademark Office, *Trademark Scope of Protection*, USPTO.GOV, <https://www.uspto.gov/trademarks/basics/scope-protection> [<https://perma.cc/MF9N-VRZ5>] (last visited Jan. 28, 2023).

91. *Id.*

92. See *Hermes Int'l*, 603 F. Supp. 3d at 277-79.

business.⁹³ One of Hermès' more well-known items is its Birkin handbag, which can be sold for over a hundred thousand dollars.⁹⁴ Hermès owns the trademark rights in its name, "Hermès," as well as in "Birkin" and trade dress rights in the Birkin handbag design.⁹⁵ Defendant, Mason Rothschild is a "marketing strategist" and "entrepreneur" with ties to the fashion industry.⁹⁶ Around December of 2021, Rothschild created a collection of digital images which he titled "MetaBirkins."⁹⁷ The MetaBirkins were digital images of blurry, furry, Birkin Handbags which Rothschild used NFTs to sell for prices comparable to physical Hermès Birkin handbags.⁹⁸

Rothschild self-described the MetaBirkins collection as a sort of paying homage to Hermès' most famous handbag that is accompanied by exclusivity, mysterious waitlists, high price tags and extreme scarcity which makes them a "holy grail" item of high value.⁹⁹ Rothschild was also quoted in interviews stating that he, "wanted to see as an experiment if [he]...could create that same kind of illusion that [a Birkin] has in real life as a digital commodity."¹⁰⁰ Rothschild sold MetaBirkins on four different NFT platforms and created social media and marketing channels using MetaBirkins as the handle and URL address.¹⁰¹ Consumers and the press expressed actual confusion on whether MetaBirkins were affiliated with Hermès on the MetaBirkins Instagram page and in magazine articles.¹⁰²

Hermès filed trademark infringement claims against Rothschild for its use of the Birkin trademark.¹⁰³ The Court concluded that the *Rogers* test applied, at least in part, to the analysis of Rothschild's use of MetaBirkins as a potential infringement upon Hermès' trademarks because the complaint included sufficient allegations of explicit misleadingness.¹⁰⁴ In applying the *Rogers* test, the court began by considering the artistic relevance prong and stated that the determination would be best left to a jury as it is a mixed question of law and fact.¹⁰⁵ Second, on the "explicitly misleading" prong, the court considered survey results provided by Hermès that assessed net confusion among potential NFT consumers and anecdotal evidence of actual confusion on social media over Rothschild's connection (or lack thereof) to Hermès through the MetaBirkins.¹⁰⁶ In the case, the jury ultimately found that

93. *Id.* at 273.

94. *Id.*

95. *Id.* at 100; 15 U.S.C. § 1127 (Trade dress encompasses features of a product such as packaging or shape that consumers associate with one source. Trade dress serves the same role as trademarks and can also be protected by trademark law.).

96. *Hermès Int'l*, 603 F. Supp. 3d at 101.

97. *Id.* at 100.

98. *Id.* at 101.

99. *Id.*

100. *Id.*

101. *Id.*

102. *Hermès Int'l*, 603 F. Supp. 3d at 102.

103. *Id.* at 103.

104. *Id.*

105. *Hermès Int'l v. Rothschild*, No. 22-cv-384 (JSR), 2023 U.S. Dist. LEXIS 17669, at *22 (S.D.N.Y. Feb 2, 2023).

106. *Id.* at *25.

the MetaBirkins were an infringement upon Hermès' mark and did not satisfy the requirements of the *Rogers* test.¹⁰⁷

III. PROPOSING A MODIFIED *ROGERS* TEST

Building upon the basis of the inconsistent application of the *Rogers* test by the different circuits, a preview of some of the high-level benefits and shortcomings of the *Rogers* test will illustrate the need for a reimagined version of the test that would produce fairer, more uniform results in litigation.

A. *The Benefits of the Rogers Test*

The existence of the *Rogers* test is beneficial for markholders and artists as it strives to balance the interests of all impacted by trademark protections whilst still encouraging creativity. First, the *Rogers* test has been applied to a number of different kinds of works (movie titles, books, songs, etc.) and has thus far shown adaptability.¹⁰⁸ Similarly, in an evolving digital era where social media networks such as TikTok, non-fungible tokens, generative artificial intelligence, and virtual worlds are on the rise, a malleable test that can adjust to new mediums is a necessity.

For example, with NFTs in *Hermès v. Rothschild*, the *Rogers* test proved to be applicable and accounted for the new digital medium under which NFTs are bought, sold, and traded as well as for the considerations of NFTs as artwork despite the variance from artwork as it has been known in the physical world.¹⁰⁹ There is also an inherent benefit in a test weighing considerations from multiple parties, which the *Rogers* test does through its balancing of the public's interest in protecting freedom of expression and markholders' interests in protecting the rights to their intellectual property. The consideration of the rights of trademark owners and the public can ensure a more holistic review of the use of any mark. This is a benefit to all as it prevents a one-sided view that skews to one party and neglects another. The *Rogers* test also provides clearer direction than other approaches such as the "alternative avenues" approach which simply asks the broad question of whether the defendant could have communicated the message through alternative avenues. Configuring a test with elements begins to assess an issue from more than one angle. Although the *Rogers* test has benefits, however, it is not without drawbacks.

107. *Hermès Int'l v. Rothschild*, F. Supp. 3d, 2023 WL 4145518, at *1-6 (S.D.N.Y. Jun. 23, 2023).

108. See *New Kids on the Block*, 971 F.2d at 304.

109. See generally *Hermès Int'l*, 603 F. Supp. 3d 98.

B. The Shortcomings of the Rogers Test and its Inconsistent Application

Given the variance in applications of the *Rogers* test across federal circuits and district courts, there is no clear framework upon which courts and parties can rely to produce consistent results. The first prong of the *Rogers* test, requiring that a mark have at least some “artistic relevance” presents some problems for protecting trademark rights.¹¹⁰ The threshold for “artistic relevance” is quite low, it must only be above zero.¹¹¹ With such a low threshold, creativity is encouraged; however, the requirement would almost always be satisfied, which in effect rests almost all analysis on the second prong of the test. This, ironically, creates an imbalance in the balancing-test. To be clear, this is not to encourage the elimination of the “non-zero” threshold. If the threshold in this prong were to be any higher, it would require courts to make determinations on the artistic level of a work which is not the role of the courts. Instead, adding additional elements to the test would encourage balance where the “non-zero” prong does not achieve it by solely working with the “explicitly misleading” prong.

Additionally, the current *Rogers* test could go further to protect the rights of trademark owners. Because the test in application is imbalanced, the rights of trademark owners are solely within the “explicitly misleading” prong as the First Amendment will almost always prevail on the “artistic relevance” prong. The provision of additional elements will allow for a more balanced analysis of alleged infringements upon marks and provide additional consideration for some of the protections trademark law seeks to preserve such as considerations over consumer deception. The three forthcoming proposed additional elements to the *Rogers* test specifically target the goals of trademark law through combatting bad faith intent to mislead consumers, unfair competition, and advance the public’s interest in protecting freedom of expression while ensuring that works that are permissible under *Rogers* are true expressions of art in some form.

C. A “New” Rogers Test for a New Age

The three proposed factors to be added to create a reimagined *Rogers* test are: (1) intent of defendant in his/her use of the alleged infringing mark, (2) the likelihood of defendant’s expansion into other markets, and (3) whether defendant’s use of plaintiff’s mark is transformative. By adding three additional factors to the “artistic relevance” and “explicitly misleading” prongs of the *Rogers* test, the considerations of trademark rights, First Amendment protections, and consumers are adequately balanced. Further, keeping the factors principles-based, rather than based on the technology, will accommodate the rapid advances in technology in the future.

The first proposed factor is the consideration of the intent of the defendant in the selection and use of the alleged infringing mark. As the Sixth Circuit considered in *Parks v. LaFace*, where a rap song titled “Rosa Parks”

110. See *Gordon*, 909 F.3d at 266-69.

111. See *Rogers*, 875 F.2d at 999.

by the group, OutKast used the line “move to the back of the bus” and historical civil rights figure Rosa Parks filed suit, André “Dré” Benjamin of OutKast admitted that OutKast’s intent was never for the song to be about Rosa Parks and the court considered this as evidence of the lyrics’ message.¹¹² The court concluded in that case that “reasonable persons could conclude that there is no relationship of any kind between Rosa Parks’ name and the content of the song...” notwithstanding the consumer’s right not to be misled.¹¹³ Considering intent can provide insight into whether a mark was truly an artistic endeavor or if there were other motives such as the capitalization on an already successful brand as was argued by Hermès in *Hermès v. Rothschild*.¹¹⁴

Trademark law is concerned with the deception of consumers. Assessing the intent of a defendant in the use of an allegedly infringing mark can assist courts in pinpointing any bad faith or deceptive behavior that would support a finding that the use is not one that should be given special protection even though it is causing some likelihood of confusion. A focus on the intent of a defendant is a focus on what the defendant wished to do with his use of a mark. To use the *Hermès* case as an example, imagine a scenario where Rothschild published his collection of MetaBirkins and included imagery of impoverished people in tattered clothing holding MetaBirkins. And imagine if rather than stating that he *was* in fact attempting to capitalize off of Hermès’ brand, Rothschild made clear that he intended to make a social commentary on excessive consumerism in society by juxtaposing a luxury item on someone seemingly lacking the bare necessities of life. If these were the facts of the case, Rothschild’s use of Hermès’ mark would have been assessed differently under the reimagined *Rogers* test. Society generally supports the right to express oneself and if framed this way, considering intent is important to balancing trademark protection with the First Amendment. Determining intent would have the effect of ensuring the protection of artistic creation rather than allowing for strategic infringing that harms trademark owners and confuses consumers.

To borrow a factor from the likelihood of confusion test as another prong, the *Rogers* test should also consider the defendant’s likelihood of expansion into other markets. This consideration would aid courts in determining whether the marks would likely be in competition with each other. For example, as in *Hermès* where virtual ‘MetaBirkins’ that resembled Birkin handbags created by Hermès were being sold online, granting this activity could have prevented Hermès from expanding into the NFT space with its own NFT creations of its Birkin Bags as they would have been occupied by Rothschild. This places the two parties in direct competition with each other if the NFT consumers are the same consumers interested in purchasing physical Birkin handbags. It can be inferred that the consumers purchasing MetaBirkins may also have had an interest in purchasing authentic Hermès Birkin handbags because Rothschild’s MetaBirkins were selling for

112. See *Parks*, 329 F.3d at 453.

113. *Id.*

114. See *Hermès Int’l*, 603 F. Supp. 3d at 103.

comparable prices to Birkin handbags and resembled Hermès' Birkin handbags in design. Hermès also provided evidence of that interest through the submission of a survey.¹¹⁵ Moreover, in the present day, where technological innovation is occurring at a rapid pace, new mediums and markets are opening for marks to exist and businesses to launch. An element considering the likelihood of expansion into such potential mediums and markets is important to preserve fair competition and ward off monopolies. Generally, not every mark will have a likelihood of expanding or expanding into all markets. Thus, considering the likelihood against a potentially infringing mark leaves some consideration for new entrants in the market which, as a matter of public policy, society supports. Adding an element to consider the relation or potential relation of the marks would further steer courts down the path of achieving fairer decisions.

Lastly, the *Rogers* test should include as a final prong whether the defendant's use of the mark was transformative. The idea of the "transformation" of a work has been discussed in copyright law.¹¹⁶ In *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, the Supreme Court considered the question of whether an orange silkscreen portrait of the late musical artist, Prince, which originated as a photograph taken by photographer Lynn Goldsmith years prior, constituted a "fair use" of Goldsmith's photograph.¹¹⁷ The Supreme Court specifically only considered the question of whether the lower court correctly held that the first factor of the fair use analysis—the purpose and character of the use—weighed in Goldsmith's favor.¹¹⁸ Part of the fair use analysis in copyright law is considering the "purpose and character" of the use.¹¹⁹ This factor asks whether an allegedly infringing use simply supersedes an original creation or instead has a "further purpose or different character" than the original work by adding something new.¹²⁰ The Court stated that this is a matter of degree and the degree of difference has to be weighed against other considerations such as commercialism.¹²¹ A use that has a further purpose or different character is considered to be transformative.¹²² The determination that a use is transformative in copyright is part of a factored analysis for fair use that ultimately weighs in favor of a finding of fair use – meaning, non-infringement. If applied to trademark law through a prong of the *Rogers* test, the consideration of transformativeness should function in a similar way in determining whether a use should receive special First Amendment protections so as not to be considered trademark infringement.

To return to the example of *Hermès* with new facts where Rothschild instead portrayed impoverished individuals with MetaBirkins as a social

115. *Hermès Int'l v. Rothschild*, F. Supp. 3d, 2023 WL 4145518, at *5 (S.D.N.Y. Jun. 23, 2023).

116. *See Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508 (2023).

117. *Id.* at 525.

118. *Id.* at 525.

119. *Id.*

120. *Id.* at 528.

121. *Id.* at 525.

122. *See Warhol*, 598 U.S. 508 at 529.

commentary, with the added imagery, a use that appears this way would be potentially transformative. This inquiry into the transformativeness of a work, in effect, would go one step further than the artistic relevance prong to require something more than above zero for an alleged infringement to be permissible as free expression. The current *Rogers* test does not go far enough to consider consumer confusion as part of the “explicitly misleading” prong because of its varied application across circuits. If a work has been sufficiently transformed, consumers are much less likely to be confused or deceived as to the mark’s source, even if the mark references in some capacity the mark of another. In borrowing a concept from copyright law—transformative use—the *Rogers* test would allow courts to be better equipped to consider artistic expression without having to contort to consider the artistic nature of a work beyond the scope of what the court reasonably should. This consideration would also further protect the interests of artists, consumers, and trademark owners alike.

Much of the success of the modernization of society has hinged upon adapting to the advent of new technologies.¹²³ Technological innovation has provided society with new ways to interact with each other including expressing artwork, communicating, sharing ideas, and protecting our personhood through the invention of the Internet, televisions, cellphones, social media platforms, and more. Many U.S. laws were enacted before the technologies to which they would apply were invented—and the drafters of such laws could not have foreseen the extent to which such laws would eventually come to regulate.¹²⁴ This has been seen in many legal areas such as criminal law, privacy law, and government regulation.¹²⁵ Even in the *Rogers* test, there has been mobility in what it has applied to. In *Rogers*, the issue was a film title, but the holding has been applied to all expressive works.¹²⁶ Recent NFT infringement cases provide another opportunity for the law to be interpreted in a way that is consistent with the goals of not only trademark law, but society.

In turning the *Rogers* test into a five-factored analysis instead of a two-factored analysis, courts would have clearer guidance to follow that more holistically and precisely balances the interests of trademark owners in protecting their marks and being free from unfair competition, the public’s interest in free expression, and the interests of consumers in not being deceived or confused by the marks displaying goods and services on the market.

123. See generally, *The Ideas That Inspire Us*, HARV. BUS. REV. (2022), <https://hbr.org/2022/11/the-ideas-that-inspire-us> [<https://perma.cc/L9CE-6G3E>].

124. See, e.g., *Carpenter v. United States*, 585 U.S. 296, 309-16 (2018) (answering the question of how to assess a new phenomenon under the Fourth Amendment and holding that an individual’s cell site records can warrant Fourth Amendment protection from an unreasonable search).

125. See, e.g., *Carpenter*, 585 U.S. 296 at 309; *Y.G. v. Jewish Hosp. of St. Louis* 795 S.W.2d 488, 491 (Mo. Ct. App. 1990); *Olmstead v. U.S.* 277 U.S. 438, 477-78 (1928).

126. *Rogers*, 875 F.2d at 999.

D. *The Potential Impact of a Modified Rogers Test*

How would the modified *Rogers* test impact interested parties? To start with digital artists and NFT creators, by understanding that the *Rogers* analysis would apply to them in any trademark infringement suit, creators would be incentivized to ensure that their creation does not satisfy the elements of the test so that their mark is free to exist, be marketed, bought and sold in commerce. For example, an NFT creator could exercise due care in selecting a mark and establish a reputation through use in such a way that would provide ample evidence of its artistic nature as an expressive work. Trademark holders would be impacted by the application of the modified *Rogers* test by gaining additional criteria to consider when utilizing marks or expanding marks into new areas. Trademarks are often used in promotional material, on products themselves, or on social media channels. Each of these areas where trademarks are commonly seen can be digitized through web promotional materials, digital images of products online where they may be sold, or otherwise. With the additional elements, the *Rogers* test would be well-equipped to assess works in all spaces in a rapidly evolving digital era.

With a clear test for artists and businesses to understand, the average consumer can develop a strong sense of trust in the authenticity and source of the goods they may purchase or services they may receive. Consumers are what keep businesses moving forward as they buy, sell, and trade products and services on the market. Without consumers, businesses could not progress or persist, and thus a goal of any legislation or decision of the court in this context should, at least in part, consider consumers.

If an allegedly infringing use of another's mark fails to meet the *Rogers* test standards of having artistic relevance and being explicitly misleading, consumers will also suffer alongside the party whose marks are being potentially infringed. In a world with a well-developed *Rogers* test, consumers generally will benefit because some of them will be attracted to the artistic expression allowed in a work. If that kind of expression isn't allowed, then the artistic expression is not available to them. A key goal of trademark law is to prevent consumer deception and confusion.¹²⁷ By regulating creations that purport to be artistic under the modified *Rogers* framework, consumers will benefit greatly.

Some argue that the *Rogers* test cannot be stretched to encompass all things that show any remote sense of artistic expression.¹²⁸ On June 8, 2023, The Supreme Court published its decision and opinion in a case between the whiskey company, Jack Daniel's and VIP Products, LLC, a company that has produced a parody dog toy that reads "Bad Spaniels."¹²⁹ The American Intellectual Property Association submitted in brief, an argument against applying the *Rogers* test to the dog toy because the toy's "humorous message" does not fit the category of being an expressive work to be considered artistic.¹³⁰ This argument inadvertently highlights the shortcomings of the

127. See *Inwood Lab 'ys Inc.*, 456 U.S. at 849.

128. *Jack Daniel's Props., Inc.*, 599 U.S. at 144.

129. See generally, Brief for American Intellectual Property Law Association as Amicus Curiae supporting Petition for Writ of Certiorari at 3, *VIP Prods. LLC*, 953 F.3d 1170.

130. *Id.*

artistic relevance prong of *Rogers*. The threshold to meet the artistic relevance prong of the *Rogers* test is low and need only be above zero.¹³¹ Through the additional prong that would consider if the use of another's mark is transformative, more than "relevance" serves as a qualifying factor in allowing potentially infringing works to exist in the market. Society cherishes the ability of new entrants to come into the market and being able to sell products and offer services. Adding elements to the *Rogers* test would provide for a precise holding in each case that ensures little to no instances of the permission of what could be considered blatant infringements.

Another argument that may be advanced against the *Rogers* test is that it abandons the likelihood of confusion factors. However, this is misleading as some courts reference the likelihood of confusion test as part of the analysis under *Rogers*. Including the intent of the alleged infringer as well as the likelihood of expansion into other markets as additional prongs further remedies the concern around abandonment of the likelihood of confusion test as factors would be a part of the direct analysis on a case-by-case basis for infringement.

Lastly, courts would benefit from a modified *Rogers* test. As it stands, courts differ on whether and how they apply the *Rogers* framework to trademark infringement cases. With a clear five-factor test that considers (1) the defendant's intent in use of the mark, (2) the mark's artistic relevance, (3) whether the use of the mark is transformative, (4) whether the mark is "explicitly misleading", and (5) defendant's likelihood of expansion into other markets, courts would be able to dissect an alleged infringement more precisely in order to achieve fairer results in each case. The five-factor analysis resolves the imbalance posed by the almost always-satisfied "artistic relevance" prong and provides further considerations for the rights of trademark owners who find themselves in litigation over alleged infringements of their marks. Each factor in the modified *Rogers* test is of benefit to almost anyone. Trademark law seeks to protect citizens as does the First Amendment but, in this context, the two can be at odds. By adding additional factors to the *Rogers* test, the balance is easier to achieve between the interests the two seek to protect as the concerns behind free expression and the concerns behind protecting trademark rights are more directly addressed.

IV. CONCLUSION

In the thirty-five years since *Rogers v. Grimaldi* was decided, courts have faced conflicts with the bounds of the *Rogers* test for balancing the rights protected by trademark law with those guaranteed by the First Amendment of the U.S. Constitution. The circuit split in the approaches used on the test's two prongs further supports the call for adjustments to the test. In thirty-five years, applications of *Rogers* have been challenged and the test itself has been found to apply to many marks and artistic works which were not outlined in

131. See *Rogers*, 875 F.2d at 999.

the original case decision. This speaks to the evolution of law as society evolves. As new technologies are created and consumers continue to seek new forms of media, goods, and services in the digital space, further trademark infringement suits are bound to arise. On the horizon are considerations about generative artificial intelligence text-to-image systems, how trademark infringement can occur and how it should be analyzed in that realm. To address those claims, a universally adopted test is needed to ensure fairer, more consistent results for the next thirty-five years (and beyond) than have been seen in the last thirty-five years. As some circuits have not addressed an application of the *Rogers* test, there could be further discussion on the applicability of the test or a further split amongst the circuits. The current *Rogers* test provides a sturdy foundation upon which to build a well-structured home that would be a complete test for all federal circuits to utilize in trademark infringement litigation for years to come. As society moves in the direction of change, it is time for the *Rogers* test to do the same.