
The Past, Present, and Future of the *Rogers* Test: Would *Jack Daniel's* Have Impacted *Viacom*?

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I. OVERVIEW

The Flora-Bama Lounge, Package and Oyster Bar is an all-in-one restaurant, bar, and venue fittingly located on the Florida-Alabama border.¹ Established in 1964, Flora-Bama is famous for hosting regional entertainment and athletic events.² The entities that own and operate Flora-Bama (plaintiffs) also maintain “FLORA-BAMA” trademarks in connection with “entertainment, food, and drink establishments.”³ The marks have been featured in several artistic works, including song lyrics, broadcasted concerts, books, and films—all with plaintiffs’ consent.⁴

In 2009, 495 Productions Holdings LLC and ViacomCBS Inc. (defendants) created a television program for MTV that featured party-driven young adults living together in a high-energy setting.⁵ The final product, titled *Jersey Shore*, became a cultural phenomenon and one of MTV’s most-watched shows of all time.⁶ Coming off the success of *Jersey Shore*, defendants created spinoffs in various locations, including one in Panama City Beach, Florida.⁷ To capture the subculture of the area, defendants titled the Panama City spinoff *MTV Floribama Shore*.⁸ Shortly before *MTV Floribama* premiered, plaintiffs sent defendants a cease-and-desist letter alleging that the title infringed on the “FLORA-BAMA” trademark and demanding that defendants change the name.⁹

1. MGF B Props., Inc. v. Viacom Inc., 54 F.4th 670, 672 (11th Cir. 2022).
2. *Id.*
3. *Id.* at 673.
4. *Id.* at 674.
5. *Id.*
6. *Id.*
7. *Id.* at 675.
8. *Id.*
9. *Id.* at 676.

Defendants refused to comply with this demand, and plaintiffs subsequently sued for trademark infringement and unfair competition under the Lanham Act.¹⁰ The district court granted summary judgment for defendants, which plaintiffs appealed.¹¹

The United States Court of Appeals for the Eleventh Circuit *held* that defendants did not infringe on the plaintiffs' "FLORA-BAMA" trademark because *MTV Floribama Shore* had some artistic relevance to the underlying work and was not explicitly misleading regarding the source or content—finding no violation under the Lanham Act. *MGFB Properties, Inc. v. Viacom Inc.*, 54 F.4th 670 (11th Cir. 2022).

II. BACKGROUND

Trademarks are everywhere. The public cannot escape Apple's bitten fruit logo, the Yankees' New York symbol, and Target's red bull's eye. They help us recognize and differentiate between the goods and services of companies and creators.¹² Understandably, when a successful novelty is created, the creator enjoys some deserved recognition, praise, and ownership over their work. Issues that arise in trademark law often involve infringement of that ownership.

Creators incorporate omnipresent trademarks into their own expression. When trademarks are used "for the purpose of trade [or] to induce the sale of any goods or services," they are used in "commercial speech," which "receives a limited form of First Amendment protection."¹³ However, several circuits have held that trademark law applies "to *artistic* works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression."¹⁴ Between these extremes lie expressive uses of a trademark that are "promotional" but not "purely commercial."¹⁵ Recognizing First Amendment concerns, courts have adopted different doctrines to balance a trademark's commercial and consumer interests with free speech principles.¹⁶ These doctrines all point to a foundational agreement that

10. *Id.*

11. *Id.*

12. ELIZABETH TOWNSEND GARD & SIDNE K. GARD, *JUST WANNA TRADEMARK FOR MAKERS: A CREATIVE'S LEGAL GUIDE TO GETTING & USING YOUR TRADEMARK*, 12 (Roxanne Cerda & Heather Wilcox eds., 2023).

13. *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 535 (1987).

14. *See Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1277 (11th Cir. 2012).

15. *S.F. Arts*, 483 U.S. at 535-41.

16. Descriptive fair use applies when "a term is used descriptively, not as a mark, fairly, and in good faith." *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 124

trademark law must respect First Amendment rights, but conflicts can arise while determining issues that involve expressive and creative works.

Federal trademark law is governed by the Lanham Act, which “secure[s] to the owner of [a] mark the goodwill of his business” and “protect[s] the ability of consumers to distinguish among competing producers.”¹⁷ In other words, the Lanham Act protects both trademark ownership and consumer confusion regarding the source or sponsorship of products.¹⁸ The First Amendment comes into play for the interests of the creator of the artistic work and to enable the flow of ideas and freedom of expression in the public.¹⁹

When trademark protections conflict with the First Amendment, 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.”²⁰ To achieve this, the Second Circuit developed a two-part test that has been adopted by other circuit courts.²¹ The *Rogers* test provides that the title of an artistic work does not violate the Lanham Act “[1] unless the title has no artistic relevance to the underlying work whatsoever, or, [2] if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.”²² Put simply, there is no Lanham violation if the use of the mark

(2004). Nominative fair use applies where (a) the trademark owner’s product or service is “not readily identifiable without use of the trademark;” (b) “only so much of the mark or marks” are “used as is reasonably necessary to identify” the trademark owner’s product or service; and (c) the user does “nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.” *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1151 (9th Cir. 2002). The *Rogers* test holds that an “artistic work’s use of a trademark that otherwise would” be an infringement is “not actionable unless the use of the mark has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless it explicitly misleads as to the source or the content of the work.” *ESS Ent. 2000 v. Rock Star Videos*, 547 F.3d 1095, 1099 (9th Cir. 2008). Courts have also dealt with trademark parodies but took varied approaches. Some parodies juxtapose “the irreverent representation of the trademark with the idealized image created by the mark’s owner,” *L.L. Bean, Inc. v. Drake Pubs., Inc.*, 811 F.2d 26, 34 (1st Cir. 1987), and convey “two simultaneous—and contradictory—messages: that it is the original, but also that it is not the original and is instead a parody.” *People for Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001). Some courts have held that “a successful parody only influences the way in which the” likelihood of confusion factors are applied. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007).

17. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992) (internal quotation marks omitted).

18. 15 U.S.C. § 1051 (2016).

19. *Id.*

20. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

21. *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012).

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

has some relevance to the alleged infringing work and it is not explicitly misleading.

The Eleventh Circuit adopted the *Rogers* test and applied it in a case concerning an artistic work protected by the First Amendment.²³ In *University of Alabama Board of Trustees v. New Life Art, Inc.*, the court found that an artist's use of a university's trademark in paintings featuring portrayals of the football team's helmets, jerseys, and colors did not violate the Lanham Act.²⁴ The university argued that the unlicensed paintings infringed on the university's trademarks because the depiction of the school's football uniforms "create[d] a likelihood of confusion on the part of the buyers that the University sponsored or endorsed the product."²⁵ The court disagreed, however, holding that the artist's use of the university's trademarks were "artistically relevant to the expressive underlying works," and the risk of consumer confusion was "so outweighed by the interests in artistic expression as to preclude any violation of the Lanham Act."²⁶

III. COURT'S DECISION

In the noted case, the Eleventh Circuit affirmed dismissal of a trademark infringement lawsuit against the producers of *MTV Floribama Shore*.²⁷ The court's holding portrays a balancing act between the trademark protections of the Lanham Act and the artistic freedoms guaranteed by the First Amendment.²⁸ First, the court relied on its reasoning in *University of Alabama* and applied the *Rogers* test, holding that the title defendants' series had artistic relevance to the underlying work.²⁹ Second, the court found no evidence that the television series was set out as endorsed or sponsored by the plaintiffs, nor was it explicitly stated that the series was affiliated with the plaintiffs.³⁰ Lastly, the court refused to apply the exception to the *Rogers* test found in a footnote in *Rogers*.³¹

23. *Univ. of Ala.*, 683 F.3d at 1278.

24. *Id.* The University of Alabama Board of Trustees brought a Lanham Act suit against Daniel Moore. Moore was an artist who had painted famous scenes of Alabama football games on mugs.

25. *Id.* at 1275.

26. *Id.* at 1278-79.

27. *MGFB Props., Inc. v. Viacom Inc.*, 54 F.4th 670, 672 (11th Cir. 2022).

28. *Id.* at 677-78.

29. *Id.* at 680.

30. *Id.* at 682.

31. *Id.* at 683.

The first factor of *Rogers* examines whether “the title has no artistic relevance to the underlying work whatsoever.”³² To satisfy that standard, the relationship between the challenged title and the underlying work “merely must [be zero].”³³ The court found this standard was “clearly” met because the title is artistically relevant to describe the subculture of the geographic region portrayed in *MTV Floribama Shore*; it was entirely independent of the Flora-Bama Lounge.³⁴ The court rejected plaintiffs’ argument that the defendants’ use of the trademark must be “strictly necessary” in order to be artistically relevant and clarified its 2012 decision in *University of Alabama* by emphasizing that a title does not need to be “strictly necessary to be artistically relevant.”³⁵ Otherwise, the court would have had to decide “whether the artist ‘needed’ to paint realistic uniforms or whether some lesser degree of realism would have sufficed.”³⁶

The court then analyzed the second prong of *Rogers*, and determined whether the series title “explicitly [misled] as to the source or the content.”³⁷ “Consumer confusion fuels trademark law, and [the second] prong targets that touchstone.”³⁸ Using Eleventh Circuit precedent, it is relevant to determine whether (1) the secondary user overtly “marketed” the protected work “as ‘endorsed’ or ‘sponsored’” by the primary user or (2) “otherwise explicitly stated” that the protected work was “affiliated” with the primary user.³⁹ The court saw no evidence of the defendants distributing the series as endorsed or sponsored content by plaintiffs, nor of the defendants explicitly stating that the series had an affiliation with the plaintiffs.⁴⁰ The court explained that even if some members of the public would associate the series with the Florabama Lounge, there was

32. *Id.* at 679.

33. *Id.* at 680 (quoting *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008)); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

34. *MGFB Props., Inc. v. Viacom Inc.*, 54 F.4th at 680.

35. *Id.* at 681 (“[W]here the use of ‘Floribama’ has artistic relevance to Defendants’ show independent of referring to Plaintiffs’ establishment, artistic relevance does not turn on whether the work is about the trademark or its holder.”).

36. *Id.* (emphasis omitted).

37. *Id.* at 682.

38. *Id.*

39. *See Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1279 (11th Cir. 2012) (“[T]here is no evidence that Moore ever marketed an unlicensed item as ‘endorsed’ or ‘sponsored’ by the University, or otherwise explicitly stated that such items were affiliated with the University.”).

40. *MGFB Props., Inc. v. Viacom Inc.*, 54 F.4th at 682.

no evidence of confusion “engendered by any overt claim.”⁴¹ The court found that plaintiffs failed to meet their burden on the second prong of the *Rogers* test and concluded that defendants’ use of Floribama in its title did not violate the Lanham Act as a matter of law.⁴²

The Eleventh Circuit also addressed plaintiffs’ argument regarding a footnote in the *Rogers* opinion, which refers to an exception to the two-part test.⁴³ The court explained that the exception did not apply because the parties were not using the trademark as a title, in effect making this a title-versus-title case.⁴⁴ While the series title is the title of an artistic work, plaintiffs have never used the term Flora-Bama as a mark to identify any artistic works created or owned by plaintiffs.⁴⁵ Additionally, plaintiffs could not invoke the use of the title in third-party produced content to warrant the exception because those third parties used Flora-Bama to refer to plaintiffs’ lounge, not to identify the source of an artistic expression.⁴⁶

Judge Brasher concurred, arguing that the Eleventh Circuit should follow the Ninth Circuit in rejecting the exception for two reasons.⁴⁷ First, Judge Brasher opined that the exception is “incompatible with the First Amendment principles that justify the *Rogers* defense,” and reasoned that the exception would give the “first person who uses a mark . . . in an artistic work a monopoly over the use of that mark in . . . other artistic works.”⁴⁸ Second, the concurrence argued that “even if the exception were appropriate under the First Amendment,” the title-versus-title exception is “impractical as a matter of doctrine and hard to apply in a consistent and logical way.”⁴⁹

IV. ANALYSIS

If trademark law and the First Amendment were combative brothers, then consider the *Rogers* test as their father. With paternal instincts, the

41. *Id.* (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d Cir. 1989)) (citing *Univ. of Ala.*, 683 F.3d at 1279). Furthermore, the court acknowledged that defendants chose a title that included its own house mark and the name of one of its prominent franchise (MTV and Shore, respectively), which hinders the argument that defendants “deliberately copied” plaintiffs’ mark. *Id.*

42. *Id.* at 683.

43. *Id.* The Second Circuit noted that the test does not apply when a defendant’s title is “confusingly similar to other titles.” *Rogers*, 875 F.2d at 999 n.5.

44. *Viacom*, 54 F.4th at 683.

45. *Id.*

46. *Id.*

47. *Id.* at 685 (Brasher, J., concurring).

48. *Id.*

49. *Id.*

Rogers test quashes disputes between two siblings: trademark protections and First Amendment rights. The Eleventh Circuit affirmed the dismissal of trademark infringement claims against defendants and found that the title, *MTV Floribama Shore*, was artistically relevant to the series.⁵⁰ Additionally, the court held that defendants did not explicitly suggest the show was associated with plaintiffs' Flora-Bama Lounge.⁵¹ Therefore, there was no violation of the Lanham Act.⁵²

Trademark liability under the *Rogers* test attaches only if the use of a trademark has no artistic relevance to the underlying work or if its use explicitly misleads the consumer regarding the source or content of that work.⁵³ Until *Jack Daniel's Properties, Inc. v. VIP Products LLC*, the Supreme Court had never considered this issue. In 2014, VIP Products filed suit against Jack Daniel's for a declaratory judgment of non-infringement in response to receiving a cease-and-desist letter concerning VIP's "Bad Spaniels" dog toy.⁵⁴

In its briefing and at oral argument, Jack Daniel's argued that the *Rogers* test stands without merit in both constitutional and statutory law.⁵⁵ The Court, however, explicitly declined to rule on the general merits of the *Rogers* test.⁵⁶ Rather, the Court held that the *Rogers* test or "any threshold First Amendment filter" does not apply when the trademark is used "as a designation of source for the infringer's own goods."⁵⁷ The Court explained that the "primary mission" of the Lanham Act is to prevent confusion about source, which is "most likely to arise when someone uses another's trademark—meaning, again, as a source identifier—rather than for some other expressive function."⁵⁸ Furthermore, the Court acknowledged that even when a party is using another's trademark as a source identifier, "full-scale litigation" may not

50. *Id.* at 672.

51. *Id.*

52. *Id.* at 683.

53. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

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

55. Oral Argument at 1:04, *Jack Daniel's*, 599 U.S. 140 (2023) (No. 22-148), <https://www.oyez.org/cases/2022/22-148>; Brief for Petitioner at 28-36, *Jack Daniel's*, 599 U.S. 140 (2023) (No. 22-148).

56. *Jack Daniel's*, 599 U.S. at 161.

57. *Id.* at 153 n.1.

58. *See id.* at 157.

be justified.⁵⁹ With that, the district court possibly could have dismissed the plaintiffs' claim in *Viacom*.⁶⁰

Had *Jack Daniel's* been decided before *Viacom*, would the Eleventh Circuit's decision remain the same? The majority opinion in *Jack Daniel's* confirmed that a mark is used as a trademark when it identifies a product's source. The Court provided some guidance for litigants attempting to prove that a mark has been used as a source identifier. First, parties should focus on the way a product is marketed. Second, a party's treatment of similar products may also inform the inquiry.⁶¹ Focusing on a mark's source-identifying function could raise questions about the use of a mark to identify the source of a creative work, such as its title. The Court recognized that *Rogers* involved a dispute over a film's title.⁶² However, there may be cases where all or part of a title is used to identify a series of related works and thus may be claimed to identify the "source" of the works.

Courts will need to determine whether *Jack Daniel's* excludes application of the *Rogers* test in such cases. Litigants seeking to apply the *Rogers* test could also rely on the opinion's suggestion that there may be "rare situations" where a mark is used as a mark, but heightened First Amendment protection could be necessary.⁶³ The Eleventh Circuit decision should fall within this scope despite its rarity. As the Second Circuit mentioned, the First Amendment interest is stronger when "expression, and not commercial exploitation of another's trademark, is the primary intent."⁶⁴ Here, the defendants' primary intent of expression was conveying to the audience the subject of the television series, not exploiting the plaintiffs' mark.

In the noted case's concurring opinion, Judge Brasher reasoned that exercising First Amendment interests by using a title is equally as heavy as enforcing trademark protections in the balancing between the two.⁶⁵ A

59. *Id.* at 157 n.2 ("[I]f, in a given case, a plaintiff fails to plausibly allege a likelihood of confusion, the district court should dismiss the complaint under Federal Rule of Civil Procedure 12(b)(6).").

60. *MGFB Props., Inc. v. Viacom Inc.*, No. 5:19-cv-00257, 2021 WL 4843905, at *1 (N.D. Fla. Sept. 22, 2021) ("[P]laintiff's showing on the seven likelihood-of-confusion factors is weak.").

61. *Jack Daniel's*, 599 U.S. at 160.

62. *Id.* at 153.

63. *Id.* at 159.

64. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989).

65. *MGFB Props., Inc. v. Viacom Inc.*, 54 F.4th 670, 685 (11th Cir. 2022) (Brasher, J., concurring).

curious topic to explore could be what may activate the *Rogers* exception. Titles deserve the same degree of First Amendment protection as the other parts of an artistic work because they convey an idea or express a particular subject matter.⁶⁶ A strong justification for the exception is the public interest against confusion between the sources of two artistic works, which is consistent with the idea of trademark law. Moviegoers should be able to identify the movie they want to see. However, the exclusion for explicit misleadingness in *Rogers* “is already consistent with the historical and traditional goals of trademark law. There is no need for a separate exception that applies to ‘confusingly similar’ titles alone.”⁶⁷ One could argue that confusion can occur even without explicit misleadingness, but that “strays from the core historical justification of trademark law, which is identifying the source of a good.”⁶⁸

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66. See *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091, 1098 (9th Cir. 2022).

67. *Viacom*, 54 F.4th at 687 (Brasher, J., concurring).

68. *Id.*

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