

15.20 Expressive Works

The defendant [*name*]'s work, [*insert name of allegedly infringing work*], is an expressive work that is protected by the First Amendment.

Therefore, you may proceed to the likelihood-of-confusion test for trademark infringement only if the plaintiff [*name*] proves by a preponderance of the evidence that the defendant [*name*]'s use of the plaintiff's mark is explicitly misleading as to the source or content of [*insert name of allegedly infringing work*]. The defendant [*name*]'s use of the mark is explicitly misleading if it is an explicit indication, overt claim, or explicit misstatement that the [*insert name of allegedly infringing work*] is sponsored by or somehow associated with the plaintiff.

Comment

This instruction concerns the Ninth Circuit's adoption of the Second Circuit's *Rogers* test, see *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), which applies to cases involving "expressive works," *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018), and "in which a trademark is used not to designate a work's source, but solely to perform some other expressive function," *Jack Daniel's Props. v. VIP Prods. LLC*, 599 U.S. 140, 154 (2023). "[P]recedents applying *Rogers* were borne of the idea that some trademarks have expressive value and that in those situations, trademark law's traditional likelihood-of-confusion test 'fails to account for the full weight of the public's interest in free expression.'" *Punchbowl, Inc. v. AJ Press, LLC*, 90 F.4th 1022, 1027-28 (9th Cir. 2024) (quoting *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002)). If *Rogers* applies to an allegedly infringing mark, "it often precludes claims of trademark infringement." *Id.* at 1028.

When faced with a *Rogers*-test challenge by a defendant, the court must make two threshold determinations. First, the court must determine if the alleged infringing trademark is used "at least in part" as a trademark. *Jack Daniel's*, 599 U.S. at 155-56 (holding that where the alleged infringing mark is used as a trademark, meaning "to identify or brand [a defendant's] goods or services," the *Rogers* test is not to be applied, even if the use is also expressive); but see *Hara v. Netflix, Inc.*, 146 F.4th 872, 878 (9th Cir. 2025) (in observing that the *Jack Daniel's* court decision was "narrow" and did not reach the validity of the *Rogers* test, holding that the test applies because the ten-second use of the plaintiff's "image and likeness in one episode of [an animated television series] and the related teaser and still image in no way suggests or identifies [the plaintiff] as a source or origin of the show"). That determination is informed by looking at the context in which the alleged infringing mark is being used, including "the way the product is marketed." *Id.* at 160; see also *Punchbowl*, 90 F.4th at 1031 (stating that, because the alleged infringer had filed trademark applications to register its mark and used its mark to identify and distinguish its new products, it was using its mark to "designate the source of its own goods—in other words, has used a trademark as a trademark." (quoting *Jack Daniel's*, 599 U.S. at 145)). Trademark use may require factual findings made

by jury. See 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 3:4 (5th ed. 2019) (“The key question is whether, as actually used, the designation is likely to be recognized . . . as an indication of origin for this particular product or service.”).

Second, if the alleged infringing mark is not used as a trademark, the court must determine if the defendant met its burden by showing that “its allegedly infringing use is part of an expressive work protected by the First Amendment.” *Punchbowl*, 90 F.4th 1022, 1028; *Twentieth Century Fox Television v. Empire Distrib.*, 875 F.3d 1192, 1196 (9th Cir. 2017) (noting that whether a mark is an expressive work is a legal question); *Punchbowl*, 90 F.4th at 1031 (observing that, because *Jack Daniel’s* was confined to a “narrow” point of law (that is, *Rogers* does not apply when a mark is used as a mark), “preexisting Ninth Circuit precedent adopting and applying *Rogers* otherwise remains intact”). A work is expressive if it “is communicating ideas or expressing points of view.” *Mattel*, 296 F.3d at 900 (quoting *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987)). See also *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235, 1241 (9th Cir. 2013) (observing that the *Rogers* test protects an expressive work even if it is “not the expressive equal of Anna Karenina or Citizen Kane”).

If the alleged infringing mark is not used as a trademark and is an expressive work, the *Rogers* test tasks the plaintiff with proving that the defendant’s use of the plaintiff’s mark is not artistically relevant to the work or explicitly misleads consumers as to the source or the content of the work. *Punchbowl*, 90 F.4th at 1028 (citing *Gordon*, 909 F.3d at 264). Because “the level of artistic relevance of the trademark or other identifying material to the work merely must be above zero,” this instruction assumes that the artistic relevance prong will have been decided by the trial court. See *Gordon*, 909 F.3d at 269 (noting that “the slightest artistic relevance” will suffice to prove first prong of *Rogers* test).

If the plaintiff has not met its burden of proving no artistic relevance, then the jury must decide if the alleged infringing mark is explicitly misleading. The defendant’s use of the mark is explicitly misleading only if it explicitly misleads consumers into believing that the plaintiff sponsored or is somehow associated with the allegedly infringing mark. *Gordon*, 909 F.3d at 270; see also *Punchbowl*, 90 F.4th at 1028 (observing that to be explicitly misleading, “there must be an explicit indication, overt claim, or explicit misstatement about the source of the work” (citation and internal quotation marks omitted)).

If the plaintiff meets this burden, the plaintiff must proceed to prove trademark infringement under the Lanham Act. See Instruction 15.6 (Infringement—Elements and Burden of Proof—Trademark); Instruction 15.8 (Infringement—Elements—Presumed Validity and Ownership—Registered Trademark); Instruction 15.9 (Infringement—Elements—Validity—Unregistered Marks); Instruction; Instruction 15.8 (Infringement—Elements—Presumed Validity and Ownership—Registered Trademark). If the jury finds that the allegedly infringing mark was not explicitly misleading, the trademark infringement claim falls outside the Lanham Act.

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