

Trademark tensions on the track: Court upholds First Amendment protections in *Haas v. Steiner*

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The intersection of trademark law and creative expression continues to evolve, most recently in *Haas Automation, Inc. v. Guenther Steiner and Ten Speed Press*, 2024 WL 4440914 (C.D. Cal. September 25, 2024). Haas provides fresh insight into how courts analyze trademark claims involving biographical works and sports photography. The court dismissed Haas Automation's lawsuit, which alleged that Steiner's book "Surviving to Drive," infringed on the company's trademarks associated with the Haas F1 racing team. In line with the Supreme Court's decision in *Jack Daniel's Properties, Inc. v. VIP Products LLC*, Haas underscores that trademark rights may be curtailed where expressive content is not misleading about its source.

Background

Haas Automation, Inc. is a prominent American machine tool manufacturer and sponsor of the Haas F1 racing team. Guenther Steiner, former Team Principal of Haas F1, chronicled his experiences during the 2022 Formula 1 season in his book, "Surviving to Drive: A Year Inside Formula 1." The book's covers and interior pages prominently featured images of the Haas F1 team and logos, which Haas Automation contended constituted trademark infringement. The defendants moved to dismiss, arguing that the book was an expressive work protected by the First Amendment. The key



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question for the Court was: Does the use of Haas's trademarks in a biographical work about the Haas F1 Team constitute trademark infringement, or is it protected expression under the First Amendment?

Legal framework: The Rogers test and the Supreme Court's recent clarifications

The Lanham Act provides the primary legal foundation for trademark protection in the U.S., but First Amendment rights offer a counterbalance when it comes to expressive works like books, films, and art. Traditionally, courts have applied the *Rogers v. Grimaldi* test to determine when trademark use in expressive works is permissible. 875 F.2d 994

(2d Cir. 1989). The two-part Rogers test allows use of a trademarked term unless (1) it has no artistic relevance to the work, or (2) it explicitly misleads consumers about the work's source.

The Supreme Court's recent decision in *Jack Daniel's* narrowed Rogers' applicability, holding that it doesn't apply where a trademark is used as a source identifier in the way traditional marks are. The ruling set a clear boundary, stating that First Amendment protections cannot shield use that functions as a brand marker. Under *Jack Daniels*, the threshold question is whether the defendant used the trademark "as a trademark" - that is, to designate the source of its own goods.

The court's analysis in Haas

The court distinguished this case from recent decisions like *Jack Daniels* and *Punchbowl*, where defendants used trademarks as source identifiers for their own products. In *Punchbowl*, the Ninth Circuit found that the *Rogers* test was not appropriate because the infringer used the trademarked term "Punchbowl" as a mark - i.e., as part of its source identifying name. *Punchbowl, Inc. v. AJ Press, LLC*, 90 F.4th 1022, 1032 (9th Cir. 2024). The court found that, here, Steiner and Ten Speed Press (publisher) did not use the Haas marks to identify the source of the book or suggest endorsement. Rather, the marks appeared in photographs documenting Steiner's

actual experience with the team. As a result, the Court concluded that the *Rogers* test applied to Steiner's use of Haas marks.

Finding the *Rogers* test applicable, Judge André Birotte reasoned that the book's use of Haas marks was artistically relevant to the story—a recounting of Steiner's experience with the Haas F1 team during the 2022 season. The book provided context about Steiner's tenure and the team's journey, enhancing the narrative with photos featuring the Haas F1 brand. The court found no explicit misrepresentation of the book's source, ruling that it was not likely to mislead readers into thinking that Haas Automation endorsed or was involved in creating the book. The court found this use more analogous to cases like *University of Ala. Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266 (11th Cir. 2012), where an artist's depiction of trademarked football uniforms in paintings received First Amendment protection, despite being sold commercially.

Implications for brand owners and content creators

This decision provides important guidance for authors, publishers, and trademark holders. For example,

biographical works may include trademarked content when documenting real experiences, particularly in sports and entertainment contexts. Further, photographic documentation of genuine historical events involving trademarks is likely to receive First Amendment protection, and the mere presence of trademarks in photographs, even on book covers, does not automatically constitute trademark use. Finally, commercial success does not defeat First Amendment protection for genuinely expressive works.

Looking ahead

As sports biographies and behind-the-scenes accounts become increasingly popular, *Haas* offers a framework for balancing trademark rights against creative expression. The court's application of the *Rogers* test, coupled with the First Amendment protections emphasized in *Jack Daniel's*, suggests that trademark owners may face challenges in controlling references to their brands in content that is artistically relevant and non-misleading. However, publishers should note that this protection may not extend to uses that explicitly suggest endorsement or sponsorship by the trademark holder.

The court's analysis also suggests that social media engagement by trademark holders (here, Haas F1 Team's tweets about the book) may weaken claims of unauthorized use. This highlights the importance of considering a brand's entire digital footprint when evaluating potential trademark claims. The decision reinforces that in the post-*Jack Daniels* era, courts will closely

scrutinize whether challenged uses truly function as trademarks before applying traditional likelihood-of-confusion analysis. As brands pursue global marketing strategies, they must consider how their marks may be used in a variety of public and artistic contexts. Legal counsel can be instrumental in navigating these complexities, helping to assess risk and potentially avoid costly litigation.

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