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The Split on the Rogers v. Grimaldi Gridiron: An Analysis of Unauthorized Trademark Use in Artistic Mediums

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Cover Page Footnote

Online Editor, Fordham Intellectual Property, Media & Entertainment Law Journal, Volume XXVII; J.D. Candidate, Fordham University School of Law, 2017; B.A., Politics, New York University, 2014. I would like to thank Professor Hugh Hansen for his guidance and feedback in developing this Note, and the IPLJ Editorial Board and staff for their hard work throughout the editorial process, especially Sara Gates and Jen Gordon. I would also like to thank my mom for her constant love and support.

The Split on the *Rogers v. Grimaldi* Gridiron: An Analysis of Unauthorized Trademark Use in Artistic Mediums

Anthony Zangrillo*

*Movies, television programs, and video games often exploit trademarks within their content. In particular, various media often attempt to use the logos of professional sports teams within artistic works. Courts have utilized different methods to balance the constitutional protections of the First Amendment with the property interests granted to the owner of a trademark. This Note discusses these methods, which include the alternative avenues approach, the likelihood of confusion test, and the right of publicity analysis. Ultimately, many courts utilize the framework presented in the seminal *Rogers v. Grimaldi* decision. This test analyzes the artistic relevance of the trademark's use in the allegedly infringing work, while also protecting against explicitly misleading uses. Currently, federal circuits apply the *Rogers* test inconsistently, particularly in the Second, Sixth, Seventh, and Ninth Circuits. This Note calls for a consistent method to harmonize First Amendment protections with trademark property interests through the *Rogers* test. This Note proposes that the threshold for First Amendment protections should remain relatively low for culturally relevant marks. This Note also argues that courts should analyze a First Amendment defense before engaging in a likelihood of confusion inquiry. This Note's suggested approach would implement important safeguards to avoid lengthy trademark litigation, and thus, incentivize more artistic works by lowering transaction costs.*

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INTRODUCTION

Consistently, various films, television programs, and video games utilize the trademarks owned by professional sports teams. Every artistic depiction of a sporting event consists of some generic elements: The roaring fans aggressively cheering for their favorite team; the colossal stadium housing a conflict fit for gladiators; the aggressive competitors hoping to secure a victory for their team. Yet, every artist must make a costly decision to elevate or diminish the realism in his or her expression. Should the media utilize the names and symbols of real, professional teams, or avoid a possible conflict by generating fictitious teams unique to the artistic expression?

Undoubtedly, this conflict embodies the uneasy balance currently maintained between First Amendment protections for artists

and the property interest granted to trademarks.¹ For example, the National Football League (“NFL”) openly negotiates licensing agreements with a multitude of filmmakers, but artists attempting to transcend their work in cultural critiques often find significant resistance from the NFL brass.² *Heaven Can Wait*, *Ace Ventura: Pet Detective*, and *Jerry Maguire* portrayed the NFL in a positive light and accordingly received permission to use “highly visible NFL trademarks.”³ On the other hand, *The Replacements*, *Buffalo ‘66*, and *Any Given Sunday* criticized certain aspects of the NFL, resulting in negative depictions of the league.⁴ As a result, these films did not receive permission to use NFL trademarks, forcing the films to use imaginary teams.⁵ For example, Oliver Stone’s *Any Given Sunday* tackled bigger social issues, including “nudity, graphic violence, drug use, domestic abuse, intra-team fights and players assaulting referees.”⁶ Stone remarked that the NFL “got very sensitive about [some of the movie’s] issue[s], especially domestic abuse situations.”⁷ To avoid restrictive NFL censors and a potential lawsuit, the film utilized a fictitious NFL team.⁸

However, according to legal precedent, Stone did not have to use a fictitious team. Even though the Lanham Act provides certain protections for trademark owners, this property interest cannot outweigh the constitutional protections of free expression granted by the First Amendment: Stone’s film would qualify as a valid work of artistic expression.⁹ In most circuits, the NFL’s claim would be

¹ See discussion *infra* Section I.B.

² See David Albert Pierce, *Intellectual Property in the Digital Age: Making Money & Avoiding Lawsuits*, MOVIE MAKER, no. 63, 2006, at 74, 74.

³ *Id.*

⁴ *Id.*

⁵ *Id.*

⁶ Wesley Ryan Shelley, *The Big Picture: Balancing Artists’ First Amendment Rights with the Trademark Interests of Sports Teams in the Wake of the University of Alabama v. Daniel Moore*, 2 ARIZ. ST. SPORTS & ENT. L.J. 43, 59 n.90 (2012).

⁷ Anthony Lappi, *Any Given (Super Bowl) Sunday*, SALON (Jan. 29, 2000, 12:00 PM), http://www.salon.com/2000/01/29/stone_5/ [<http://perma.cc/G8Z3-LDK4>].

⁸ See Oliver Herzfeld & Tal Benschar, *HBO’s Ballers: Touchdown or Legal Fumble?*, FORBES (June 27, 2015, 9:56 AM), <http://www.forbes.com/sites/oliverherzfeld/2015/06/17/hbos-ballers-touchdown-or-legal-fumble/#3011c3aa5d84> [<https://perma.cc/T8M5-8VN7>].

⁹ See *infra* Section I.B.

dismissed under a First Amendment defense.¹⁰ However, current inconsistencies between the circuits provide a risk of potentially costly and onerous litigation.¹¹ In effect, filmmakers and other artists cower at the bullying threats of monopolistic mark holders.¹²

This chilling effect robs the public of meaningful, critical works in exchange for extended commercials disguised as movies.¹³ For example, Sony almost “pulled the plug” on *Moneyball* because Major League Baseball (“MLB”) remained unhappy over some “factual liberties” in the initial script, which adapted the nonfiction story of Billy Beane, Oakland Athletics’ general manager.¹⁴ Eventually, Sony relented and chose to fire famed screenwriter Steven Soderbergh, picking up an MLB endorsement in the process.¹⁵ While the MLB-influenced final product was a box office success and critical darling, questions surrounding the initial vision should trouble aspiring directors.¹⁶ In effect, the sports league exercised crippling control over the studio in the shadow of the law.¹⁷ This example showcases the power of marketing juggernauts with a cache of protected trademarks.

Sony once again shrunk in the face of conflict, according to emails released in the infamous hack of Sony’s servers.¹⁸ Allegedly, Sony removed negative depictions of the NFL in the biographical

¹⁰ See *infra* notes 305–10 and accompanying text.

¹¹ See *infra* notes 306–15 and accompanying text.

¹² See *infra* notes 316–20 and accompanying text.

¹³ See Abe Sauer, *At the Movies: Adam Sandler Builds a Product Placement Joke with “Jack and Jill,”* BRANDCHANNEL (Nov. 11, 2011), <http://brandchannel.com/2011/11/11/at-the-movies-adam-sandler-builds-a-product-placement-joke-with-jack-and-jill/> [http://perma.cc/3L7M-YLY9].

¹⁴ Michael Cieply, *Money Worries Kill A-List Film at Last Minute*, N.Y. TIMES (July 1, 2009), <http://www.nytimes.com/2009/07/02/business/media/02moneyball.html> [http://perma.cc/6RJ6-XX4N].

¹⁵ *Id.*

¹⁶ See Lucas Shaw & Todd Cunningham, *Why Sports Movies Like ‘Million Dollar Arm,’ ‘Draft Day’ Have Become Their Own Underdog Stories*, WRAP (Apr. 14, 2014, 1:51 PM), <http://www.thewrap.com/draft-day-million-dollar-arm-sports-movies-underdog> [http://perma.cc/3H9F-UVU6].

¹⁷ Cieply, *supra* note 14.

¹⁸ See Ken Belson, *Sony Altered ‘Concussion’ Film to Prevent N.F.L. Protests, Emails Show*, N.Y. TIMES (Sept. 1, 2015), <http://www.nytimes.com/2015/09/02/sports/football/makers-of-sonys-concussion-film-tried-to-avoid-angering-nfl-emails-show.html> [http://perma.cc/RD6C-3SN3].

sports drama *Concussion*.¹⁹ The film follows the NFL's attempts to suppress a forensic pathologist's research on chronic traumatic encephalopathy, a degenerative brain disease that affects professional football players.²⁰ The NFL obviously had a significant interest in this film's content, which influenced Sony to collaborate with an outside consultant hired by the NFL in order to ensure the movie conveyed a "whistle-blower story, rather than a condemnation of football or the league."²¹ Sony maintained independence from the NFL's interests, merely reaching out to the league in order to accurately portray the controversial story.²² Still, the studio's true intent in making these changes remains a mystery.²³ Sony's claims of collaboration conflict with the NFL's previous actions concerning the controversial topic of head trauma.²⁴ Interestingly, the film's marketing campaign prominently touted the NFL mark, as well as the marks of the league's various teams.²⁵ It is unclear if Sony received the NFL's blessing, as neither side has commented on this question.²⁶ However, rather than enjoying *Moneyball*'s success, *Concussion* opened to a "disastrous" box office and tepid reviews.²⁷

A striking light in the fog of unauthorized trademarks is HBO's new comedy *Ballers*.²⁸ The popular show features Dwayne "The Rock" Johnson as a former player turned financial advisor.²⁹ While HBO did not utilize NFL marks in the marketing of the show, the initial episode showcased an array of protected marks—most noti-

¹⁹ *Id.*

²⁰ *Id.*

²¹ *Id.*

²² *Id.*

²³ *Id.*

²⁴ *See id.* The NFL confronted ESPN in 2004, regarding a fictional television series involving a negative depiction of NFL players, as well as in 2013, concerning a documentary analyzing the "dangers of head trauma." *Id.* Disney, ESPN's parent company, cancelled the series after one season, but the documentary later aired on PBS. *Id.*

²⁵ CONCUSSION (Columbia Pictures 2015).

²⁶ Belson, *supra* note 18.

²⁷ Daniel J. Flynn, 'Concussion' Bombs at Box Office, BREITBART (Dec. 28, 2015), <http://www.breitbart.com/big-hollywood/2015/12/28/concussion-bombs-at-box-office/> [<http://perma.cc/3ZH3-HVPG>].

²⁸ *Ballers* (HBO television broadcast 2015).

²⁹ *Id.*

ceably the Miami Dolphins logo and uniforms.³⁰ In response to cries of infringement by the NFL and media pundits, HBO maintained that “in this context[,] there is no legal requirement to obtain [the NFL’s] consent.”³¹ While the NFL has not threatened a lawsuit, HBO’s current position seems valid because the logos characterize the background of an expressive work, merely propelling the artistic work forward.³² Still, future seasons may shy away from exploring controversial issues out of a fear that a certain depiction of the NFL or its officials is misleading to the public.³³

This Note aims to reinforce HBO’s position by calling for a uniform approach to balancing the First Amendment against trademark appropriation. Part I provides a background on trademark law, focusing on the methods various circuits utilize to grant First Amendment protections to artists using trademarks in their works. Part I also discusses the alternative avenues approach, the likelihood of confusion test, and the right of publicity analysis. Part II discusses the circuit split in applying the *Rogers v. Grimaldi* framework, which most courts have adopted.³⁴ Part III calls for all courts to consistently apply this test in order to reduce uncertainty in the courtroom and argues that the threshold for First Amendment protections should remain relatively low for culturally relevant marks. Part III also argues that courts should revise how the analysis proceeds in these conflicts by analyzing a First Amendment defense before engaging in a likelihood of confusion inquiry.

³⁰ Jason Guerrasio, *Here’s Why the Rock’s New HBO Show, ‘Ballers,’ Can Legally Use NFL Logos Without the League’s Consent*, BUS. INSIDER (June 19, 2015, 11:44 AM), <http://www.businessinsider.com/why-the-rocks-ballers-can-use-nfl-logos-without-consent-2015-6> [<https://perma.cc/65WS-MGH6?type=image>]. In one scene, the Green Bay Packers logo is prominently displayed in the general manager’s office. *See id.*

³¹ *Id.*

³² *Id.*

³³ Zach Bergson, *Time Will Tell How NFL Feels About HBO’s Ballers*, FORBES (Aug. 13, 2015, 2:26 PM), <http://www.forbes.com/sites/zachbergson/2015/08/13/time-will-tell-how-nfl-feels-about-hbos-ballers/#77056bf859d9> [<http://perma.cc/D9PE-HEQE>].

³⁴ 875 F.2d 994 (2d Cir. 1989).

I. HOW TRADEMARKS AND THE FIRST AMENDMENT INTERSECT

A. *Summary of Trademark Law*

Trademarks assist consumers by helping them easily identify preferred goods or services, while companies can effectively distinguish themselves within various markets.³⁵ Companies like the NFL register trademarks that can include “any word, name, symbol, or device, or any combination thereof . . . used . . . to identify and distinguish [their] goods . . . from [competitors] and to indicate the source of the goods.”³⁶ A person or company acquires a mark through use of the mark in commerce.³⁷ Through the Lanham Act, federal law provides protection for trademark owners from uses that infringe or dilute the strength of the mark.³⁸ Infringement involves an offering for sale or sale of a product by an unauthorized user of the registered mark that is likely to cause confusion, mistake, or deception.³⁹ Dilution weakens a famous mark’s ability to identify and distinguish goods or services in the marketplace.⁴⁰ Notably, the narrow definition of infringement requires a sale or advertisement to initiate the cause of action;⁴¹ however, the Lanham Act provides broader protection through an “unfair competition” claim that protects even unregistered marks from misleading uses that cause confusion in the marketplace.⁴²

B. *Methods to Grant First Amendment Protections*

The need to artistically discuss and present famous marks has led courts to develop different schemes to balance the competing interests of the artist and mark holder.⁴³ While inconsistencies exist between the circuits, modern courts have adopted several “internal

³⁵ See *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 509 F.3d 380, 381 (7th Cir. 2007).

³⁶ 15 U.S.C. § 1127 (2012).

³⁷ See *id.*

³⁸ See generally *id.* §§ 1051–1127.

³⁹ § 1114 (1)(a).

⁴⁰ § 1125(c).

⁴¹ § 1114 (1)(a).

⁴² See *Dell Pub. Co. v. Stanley Publications, Inc.*, 172 N.E.2d 656, 660 (N.Y. 1961); *Porter v. LSB Industries, Inc.*, 192 A.D.2d 205, 211 (N.Y. 1993).

⁴³ See Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 195–96.

mechanisms to address issues of free expression [in trademark infringement and unfair competition claims].”⁴⁴ This Note recognizes the *Rogers* test as the most equitable solution, but this Section also explores other methods of granting First Amendment protections in the trademark realm. Some courts have gravitated to an alternative avenues approach, analyzing whether there is a way to comment on a trademark without infringing on the mark.⁴⁵ Other courts restrict their analysis to likelihood of confusion test alone.⁴⁶ Additionally, some courts have adopted the transformative use test from right of publicity precedent.⁴⁷

In *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinemas, Ltd.*, the plaintiff sued for trademark infringement when the Dallas Cowboys Cheerleaders service mark and uniform were used in a sexually explicit film, “Debbie Does Dallas.”⁴⁸ The defendants argued for an extension of the fair use doctrine in copyright law to the trademark context.⁴⁹ However, the *Dallas Cowboys* court found that the fair use doctrine was inapplicable to trademark claims.⁵⁰ Conversely, in *L.L. Bean, Inc. v. Drake Publishers, Inc.*, the court refused to apply the Lanham Act to noncommercial speech.⁵¹ This approach has a basis in the Lanham Act’s “use in commerce” requirement.⁵² Yet recent court interpretations of the “use in com-

⁴⁴ Mark Bartholomew & John Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*, 81 GEO. WASH. L. REV. 1, 41 (2013).

⁴⁵ See *infra* Section I.B.1.

⁴⁶ See *infra* Section I.B.2.

⁴⁷ See *infra* Section I.B.3.

⁴⁸ 604 F.2d 200, 202 (2d Cir. 1979).

⁴⁹ *Id.* at 205. “The fair use doctrine allows adjustments of conflicts between the [F]irst [A]mendment and the copyright laws, and is designed primarily to balance ‘the exclusive rights of a copyright holder with the public’s interest in dissemination of information affecting areas of universal concern, such as art, science and industry.’” *Id.* at 206 (citations omitted) (quoting *Wainwright Sec., Inc. v. Wall St. Transcript Corp.*, 558 F.2d 91, 94 (2d Cir. 1977)).

⁵⁰ *Id.* (“It is unlikely that the fair use doctrine is applicable to trademark infringements; however we need not reach that question.”).

⁵¹ 811 F.2d 26, 32–33 (1st Cir. 1987) (“It offends the Constitution, however, to invoke the anti-dilution statute as a basis for enjoining the noncommercial use of a trademark by a defendant engaged in a protected form of expression . . .”).

⁵² 15 U.S.C. § 1127 (2012); see also Margreth Barrett, *Domain Names, Trademarks and the First Amendment: Searching for Meaningful Boundaries*, 39 CONN. L. REV. 973, 983 (2007) (“The ‘use in commerce’ requirement consists of two subparts: (1) the defendant

merce” standard have rendered its application “beyond recognition.”⁵³ While commercial speech should do “no more than propose a commercial transaction,” mixed artistic and commercial speech reside in a hybrid area of First Amendment protection.⁵⁴ In effect, some courts have found a use in commerce where the plaintiff’s sales have been affected or the plaintiff can prove the defendant acted with the intent to injure the plaintiff.⁵⁵ However, a website that promotes a movie, while expanding upon the cinematically created universe, may fall in a protected area of artistic speech.⁵⁶ Disregarding the confusion among commercial and noncommercial speech, the U.S. Court of Appeals for the Second Circuit found the use in commerce approach inadequate in protecting the “public against flagrant deception.”⁵⁷ Instead, the Second Circuit found it necessary for courts to strike a balance between the “public interest in avoiding consumer confusion [and] the public interest in free expression.”⁵⁸

Parsing the difference between commercial and expressive uses becomes quite challenging in practice. Product placement is a common occurrence in popular films and television shows, but sometimes its inclusion can be vital to plot and characterization. For example, the Netflix series *Daredevil* uses a Fordham Law sweatshirt to change audience perceptions of a cynical district attorney.⁵⁹ On the other end of the commercial-expressive spectrum, the blockbuster film *Batman v Superman: Dawn of Justice* includes a

must make a ‘trademark use’ of the plaintiff’s mark, and (2) that use must be in or affect ‘commerce,’ as defined in Lanham Act section 45.”).

⁵³ Barrett, *supra* note 52, at 985–86.

⁵⁴ Bolger v. Youngs Drug Prods. Corp., 463 U.S. 60, 66 (1983); *see* Barrett, *supra* note 52, at 987.

⁵⁵ Barrett, *supra* note 52, at 986.

⁵⁶ *See, e.g.*, Fortres Grand Corp. v. Warner Bros. Entm’t Inc., 947 F. Supp. 2d 922, 933–34 (N.D. Ind. 2013) (holding that a movie website was not commercial speech, even though it suggested to buy tickets, because the website was really an “extension[] of the film”). The court’s application cuts against a “generous interpretation” of commercial use. Bartholomew, *supra* note 44, at 52 (“Trademark cases rarely involve defendants lacking any profit motive whatsoever.”).

⁵⁷ Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989).

⁵⁸ *Id.*

⁵⁹ *Daredevil: The Man in the Box* (Netflix Mar. 18, 2016). Before this scene, the series depicted the district attorney as a power-hungry politician. *Id.* After the character’s attire showcases her vulnerability, she pleads with the protagonists for forgiveness. *Id.*

blatant commercial for Turkish Airlines that does not add any relevant artistic value to the film.⁶⁰ Oliver Stone's *World Trade Center* falls somewhere in the middle of the spectrum: Stone's final cut included "the shadow of American Airlines Flight 11 pass[ing] across a *Zoolander* billboard as it plummet[ed] toward the North Tower."⁶¹ While Stone considered this a veiled attack at "launching such a silly movie in the direct wake of an American tragedy," many saw *Zoolander's* inclusion as an advertisement because Paramount released both movies.⁶² As these examples suggest, directors utilize marks for artistic relevance and social messages in unclear ways that may not always be apparent to judges. Ambiguous, creative expression creates a subjective standard that forces courts to weigh the artistic views of the creator, audience, parties to a lawsuit, and even the judges themselves.⁶³

Some courts have chosen to rely on a descriptive or nominative fair use defense in cases in which the unauthorized use has resulted in a likelihood of confusion.⁶⁴ Under descriptive fair use, an artist may use a mark in a non-trademark descriptive category.⁶⁵ To avoid a constitutional question, some courts have chosen to drudge through the nominative fair use defense.⁶⁶ Nominative fair use protects a referential use that strictly identifies a mark owner or an

⁶⁰ *BATMAN V SUPERMAN: DAWN OF JUSTICE* (Warner Bros. Pictures 2016).

⁶¹ David Ehrlich, *Derek Zoolander Writes 9/11 History*, *COLUM. SPECTATOR*, Sept. 14, 2006, at 12.

⁶² *Id.* Another questionable use of product placement appeared in the Ghostbusters reboot. While most audiences will interpret the display of a container of Pringles as blatant advertisement, the snack is utilized in a joke that arguably defines Kate McKinnon's quirky scientist character. *See GHOSTBUSTERS* (Columbia Pictures 2016).

⁶³ *See infra* Section I.B.1-3.

⁶⁴ *See Packman v. Chi. Tribune Co.*, 267 F.3d 628 (7th Cir. 2001); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 307-08 (9th Cir. 1992).

⁶⁵ *See, e.g., Packman*, 267 F.3d at 641 (7th Cir. 2001) (finding a media company's use of "The joy of six" as a headline reprinted on T-shirts did not infringe the trademark because it described the Chicago Bulls' sixth NBA championship); *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, 64 F.3d 1055, 1057-58 (7th Cir. 1995) (holding that Ocean Spray's use of "sweet-tart" did not infringe the SweeTARTS trademark because it merely described the taste of the defendant's juice rather than identify the plaintiff's brand).

⁶⁶ Bartholomew, *supra* note 44, at 45 (noting that the Third, Fifth, and Ninth Circuits, in addition to numerous district courts outside those circuits, have "recognized the viability of a nominative fair use defense").

owner's product or services.⁶⁷ In these cases, there is "no descriptive substitute . . . [as] many goods and services are effectively identifiable only by their trademarks."⁶⁸

1. Alternative Avenues Approach

The "alternative avenues" approach resolves trademark and First Amendment disputes by equating this conflict with a constitutional claim in property law.⁶⁹ The analysis examines whether there are other ways for the defendant to comment on a topic without infringing on the plaintiff's trademark.⁷⁰ For example, in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, a professional football team brought trademark infringement, unfair competition, and dilution claims against a movie studio.⁷¹ The team argued that the defendant's explicit movie harmed the team's trademark because the film featured a cheerleader performing sexual actions, while "don[ning] a uniform strikingly similar to that worn by the Dallas Cowboys Cheerleaders."⁷² The district court granted the football team a preliminary injunction against the film.⁷³ On appeal, the Second Circuit held that there was a high likelihood of confusion due to the disparagement of the brand caused by the "sexually

⁶⁷ See *New Kids on the Block*, 971 F.2d at 307–08 (9th Cir. 1992) ("Much useful social and commercial discourse would be all but impossible if speakers were under threat of an infringement lawsuit every time they referred to a person, company or product by using its trademark."). The defense requires: "First, the product or service in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and third, the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder." *Id.* at 308.

⁶⁸ *Id.* at 306; see also *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350, 352 (9th Cir. 1969) (holding that using the Volkswagen mark to merely convey information would not infringe upon Volkswagen's trademark).

⁶⁹ See *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972) ("It would be an unwarranted infringement of property rights to require them to yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist. Such an accommodation would diminish property rights without significantly enhancing the asserted right of free speech.").

⁷⁰ *Dall. Cowboys Cheerleaders, Inc., v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979).

⁷¹ *Id.* at 203.

⁷² *Id.*

⁷³ *Id.* at 205.

depraved film.”⁷⁴ When ruling on possible defenses, the court held that “[t]rademark 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 adequate alternative avenues of communication exist.’”⁷⁵ Here, the court decided that there were “numerous ways [for the] defendants [to] comment on ‘sexuality in athletics’ without infringing plaintiff’s trademark.”⁷⁶ Therefore, the injunction did not “encroach upon . . . First Amendment rights.”⁷⁷

Following this case, the Eighth Circuit adopted the alternative avenues approach in *Mutual of Omaha Insurance Co. v. Novak*.⁷⁸ In *Novak*, an insurance company brought a trademark infringement and disparagement suit against a designer.⁷⁹ The district court enjoined the designer from using the logo or a confusingly similar logo on their products.⁸⁰ On appeal, the Eighth Circuit echoed the Second Circuit’s analysis, holding that “failure to protect Mutual’s trademark rights would amount to an ‘unwarranted infringement of property rights,’ for it would “diminish [those] rights without significantly enhancing the asserted right of free speech.”⁸¹ In their analysis, the court distinguished the facts from the case of an “editorial parody,” which would receive “constitutional protection.”⁸² The court further held that a contrary ruling would weaken property rights without a corresponding enhancement in free speech.⁸³

Although the Eighth Circuit has continued to use this approach,⁸⁴ most circuits have rejected it, and commentators have discredited it.⁸⁵ In *Rogers v. Grimaldi*, the Second Circuit distin-

⁷⁴ *Id.* at 204–05.

⁷⁵ *Id.* at 206 (citations omitted) (quoting *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972)).

⁷⁶ *Id.*

⁷⁷ *Id.*

⁷⁸ 836 F.2d 397 (8th Cir. 1987).

⁷⁹ *Id.* at 398.

⁸⁰ *Id.*

⁸¹ *Id.* at 402 (quoting *Lloyd Corp.*, 407 U.S. at 567).

⁸² *Id.*

⁸³ *Id.*

⁸⁴ *See, e.g.*, *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769 (8th Cir. 1994); *Am. Dairy Queen Corp. v. New Line Prods.*, 35 F. Supp. 2d 727 (D. Minn. 1998).

⁸⁵ *See* *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996) (rejecting the alternative avenues approach); *Rogers v. Grimaldi*, 875 F.2d 994,

guished a restriction on the “location” of speech from the “words” the speaker uses.⁸⁶ Furthermore, in a footnote, the *Rogers* court remarked that *Dallas Cowboys* should have been decided under explicitly misleading grounds alone.⁸⁷ In addition, the dissent in *Novak* provided several compelling public policy arguments for avoiding the alternative avenues test’s “significant intrusion upon the defendant’s [F]irst [A]mendment rights.”⁸⁸ The *Novak* decision’s extension of liability could stifle creativity, resulting in a chilling effect.⁸⁹ Additionally, the property metaphor “completely distorts the analysis” because a trademark is intangible property that conveys an idea.⁹⁰ Thus, the alternative avenues test grants trademark holders the ability to control the content of speech merely because the artist used the mark.⁹¹ In conclusion, the alternative avenues approach conflates the distinct real property and intellectual property areas of law.

999 (2d Cir.1989) (rejecting the “no alternative” standard); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1571 (S.D. Cal. 1996), *aff’d*, 109 F.3d 1394 (9th Cir. 1997).

⁸⁶ 875 F.2d 994, 999 (2d Cir. 1989).

⁸⁷ *Id.* at 999 n.4 (“Advertisements for the movie were explicitly misleading, stating that the principal actress in the movie was a former Dallas Cowboys’ cheerleader.”).

⁸⁸ *Novak*, 836 F.2d at 406 (Heaney, J., dissenting).

⁸⁹ See Harriet K. Dorsen, *Satiric Appropriation and the Law of Libel, Trademark, and Copyright: Remedies Without Wrongs*, 65 B.U. L. REV. 923, 964 (1985); see also *Parks v. LaFace Records*, 329 F.3d 437, 450 (6th Cir. 2003) (“To suggest that other words can be used as well to express an author’s or composer’s message is not a proper test for weighing First Amendment rights.”).

⁹⁰ Robert J. Shaughnessy, Note, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA. L. REV. 1079, 1111–12 (1986) (“Because a parodist expresses ideas through the use of another’s trademark, the owner’s attempt to enjoin the parody goes to the *content* of the speech and not merely to the time, place, or manner of its delivery.”); see also *Parks*, 329 F.3d at 450.

⁹¹ Denicola, *supra* note 43, at 206 (“The issue is not *where* the defendant may speak, but rather *what* he may say. The [F]irst [A]mendment will not permit the trademark owner the power to dictate the form, and thus the effectiveness, of another’s speech simply because his trademark has been used to express ideas that he would prefer to exclude from the public dialogue.” (emphasis added)).

2. Likelihood of Confusion Test

In other courts, likelihood of confusion concerns trump any notions of First Amendment protections for artists.⁹² Even courts that use the *Rogers* test have noted that the “likelihood-of-confusion test generally strikes a comfortable balance between trademark owner’s property rights and the public’s expressive interests.”⁹³ Upholding the likelihood of confusion approach, Professor Robert Denicola argued that the public has a greater interest in restricting deceptive or misleading commercial speech in relation to First Amendment challenges.⁹⁴ Additionally, courts were reluctant to deviate from the likelihood of confusion analysis in the face of constitutional defenses.⁹⁵ However, judicial discretion has enabled the test to find infringement whenever “the defendant’s use threatens to undermine the mark’s distinctiveness or the plaintiff’s business good will, despite the lack of any meaningful likelihood that an appreciable number of consumers will be misled.”⁹⁶ In order to protect certain expressive works, the court may engage in an ad hoc balancing approach without explicitly reaching the First Amendment defenses.⁹⁷ Scholars suggested this variation “put[s] a discrete judicial finger on the scales in favor of [the] defendant.”⁹⁸

Yet, most courts that only use a likelihood of confusion analysis will trample a defendant’s right to free expression, improperly protecting the plaintiff’s property interests.⁹⁹ For example, in *Dr.*

⁹² See Alex Konzinski, Essay, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 973 (1993). (“Whatever [F]irst [A]mendment rights you may have in calling the brew you make in your bathtub ‘Pepsi’ are easily outweighed by the buyer’s interest in not being fooled into buying it.”).

⁹³ See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

⁹⁴ See Denicola, *supra* note 43, at 165.

⁹⁵ Bartholomew, *supra* note 44, at 42–43; see also 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 TRADEMARK REP. 1360, 1362 (2009).

⁹⁶ Barrett, *supra* note 52, at 985.

⁹⁷ Bartholomew, *supra* note 44, at 43 (“Courts will acknowledge that the defendant is using the plaintiff’s mark in a socially valuable, expressive way and then apply that understanding to the likelihood of confusion test.”).

⁹⁸ 6 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 31:139 (4th ed. 2012); see also *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007) (adjusting the likelihood of confusion factors for a parody case).

⁹⁹ See, e.g., *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.* 109 F.3d 1394, 1403 (9th Cir. 1997) [hereinafter *Dr. Seuss 1997*]; *Films of Distinction, Inc. v. Allegro Film*

Seuss Enterprises, L.P. v. Penguin Books USA, Inc., Penguin published a satirical book about the O.J. Simpson trial that parodied the popular *Cat in the Hat* children's book.¹⁰⁰ While the district court recognized a different analysis for First Amendment defenses, the Ninth Circuit only applied the likelihood of confusion test on appeal.¹⁰¹ The court affirmed the district court's ruling, prohibiting the publication and distribution of the infringing work.¹⁰² Additionally, the Sixth Circuit has criticized the likelihood of confusion and alternative avenues approaches for discounting the artistic decisions resulting in a particular form of expression.¹⁰³ This reliance on the likelihood of confusion test significantly harms constitutionally protected freedoms by failing to consider a valid First Amendment defense.¹⁰⁴

3. Right of Publicity Analysis

Increasingly, commentators have gravitated toward an alternative approach that would utilize the transformative or predominant use test from right of publicity precedent. In fact, courts have sug-

Prods., Inc., 12 F. Supp. 2d 1068, 1078 (C.D. Cal. 1998) (denying a First Amendment "literary title" defense).

¹⁰⁰ *Dr. Seuss 1997*, 109 F.3d at 1396-97.

¹⁰¹ *Compare id.*, with *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1573 (S.D. Cal. 1996) ("Where alternative means of achieving the satiric or parodic ends exist that would not entail consumer confusion, the First Amendment will not protect the parodist from being held to infringe. The Court's reasoning as to the fair use defense therefore applies equally to this issue.").

¹⁰² *Dr. Seuss 1997*, 109 F.3d at 1406.

¹⁰³ *See Parks v. LaFace Records*, 329 F.3d 437, 449 (6th Cir. 2003) ("[The likelihood of confusion test] treats the name of an artistic work as if it were no different from the name of an ordinary commercial product. However, this approach ignores the fact that the artistic work is *not* simply a commercial product but is also a means of communication. . . . [The test fails] to differentiate between those artists who choose titles for the purpose of legitimate artistic relevancy and those artists who choose misleading titles for the purpose of commercial gain.").

¹⁰⁴ *See Westchester Media v. PRL USA Holdings*, 214 F.3d 658, 667-68 (5th Cir. 2000) (holding that the defendant infringed the plaintiff's mark under a particularly compelling standard of likelihood of confusion); *Cartoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 970 (10th Cir. 1996) (finding that the likelihood of confusion test "serve[s] to avoid First Amendment concerns" in trademark cases); *Gottlieb Dev. LLC v. Paramount Pictures Corp.*, 590 F. Supp. 2d 625, 636 (S.D.N.Y. 2008) (ignoring a First Amendment defense and holding for the defendant under a finding that the use was not likely to confuse audiences).

gested that false endorsement and right of publicity claims are very similar.¹⁰⁵ In *Hart v. Electronic Arts, Inc.*, the court recognized that right of publicity cases veer from traditional First Amendment interests.¹⁰⁶ In *Hart*, the court held that the transformative use test provided a more “nuanced” approach.¹⁰⁷ While the case involved the exploitation of a college football player’s image in a video game, this more complex approach could also assist courts in classic trademark cases.¹⁰⁸ The court also considered the predominant use test, exploring whether the mark’s use exploited the individual’s identity rather than commenting on their celebrity.¹⁰⁹ Ultimately, the *Hart* court rejected this approach because the test called for a court’s subjective judgment concerning the dissection of a work.¹¹⁰ Under this analysis, courts will encounter problems similar to the commercial speech analysis.¹¹¹ The vague exploitation standard could have over-inclusive results, chilling filmmakers from exercising protected forms of speech in creative works.¹¹²

The transformative use test originated in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*¹¹³ An artist sold lithographs and T-shirts exploiting the images of the Three Stooges.¹¹⁴ Even though the artist made his design on a charcoal drawing and the items were not commercial products, the California Supreme Court refused to extend First Amendment protections to the artist’s use of the likeness of these famed comedy performers.¹¹⁵ In reaching its decision,

¹⁰⁵ *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003).

¹⁰⁶ 717 F.3d 141, 149 (3d Cir. 2013).

¹⁰⁷ *Id.* at 158.

¹⁰⁸ Celebrity exploitation bears similarities to unauthorized uses of popular or “culturally relevant” marks. *Cardtoons*, 95 F.3d at 972 (“[C]elebrities are ‘common points of reference for millions of individuals who may never interact with one another, but who share, by virtue of their participation in a mediated culture, a common experience and a collective memory.’” (quoting JOHN B. THOMPSON, *IDEOLOGY AND MODERN CULTURE: CRITICAL SOCIAL THEORY IN THE ERA OF MASS COMMUNICATION* 163 (1990))).

¹⁰⁹ *Hart*, 717 F.3d at 153–54; see also *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (introducing the predominant use test).

¹¹⁰ *Hart*, 717 F.3d at 154.

¹¹¹ See *supra* notes 59–63 and accompanying text.

¹¹² See *id.*

¹¹³ 21 P.3d 797 (Cal. 2001).

¹¹⁴ *Id.* at 800–01.

¹¹⁵ *Id.* at 811.

the court reviewed prior balancing tests that considered whether the “proprietary interests at issue clearly outweigh the value of free expression in this context.”¹¹⁶ To the court, it was undisputed that not every use of a trademark is automatically protected under the First Amendment.¹¹⁷ Rather, the court remained very sensitive to the dangers of “appropriat[ing] the commercial value of the likeness of [a celebrity],” while recognizing that celebrities should not have the power to “censor . . . disagreeable portrayals.”¹¹⁸ The use cannot be “a literal depiction or imitation.”¹¹⁹ Instead, the final product must represent an original expression of the derivative author.¹²⁰ Transformative elements include “parody, . . . factual-reporting, . . . heavy-handed lampooning[, and] subtle social criticism.”¹²¹

However, in *Kirby v. Sega of America, Inc.*, the video game company prevailed in its First Amendment defense for the “Ulala” character in the *Space Channel 5* video game.¹²² The plaintiff claimed that the “Ulala” character violated American singer Kierin Kirby’s right of publicity because Sega based Ulala off of Kirby’s appearance, career as a musician, and notable catchphrases.¹²³ Yet, the court held that the use was transformative.¹²⁴ Importantly, the “setting for the game that features Ulala—as a space-age reporter in the [twenty-fifth] century—is unlike any public depiction of Kirby.”¹²⁵ As a result, Sega’s use was merely similar and not a complete reproduction.¹²⁶ In the wake of this decision, scholars questioned “whether placing an exact rendition of Kirby’s likeness

¹¹⁶ *Id.* at 806 (quoting *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 461 (Cal. 1979)).

¹¹⁷ *Id.* at 805–06 (“[T]he state’s interest in preventing the outright misappropriation of such intellectual property by others is not automatically trumped by the interest in free expression or dissemination of information.”).

¹¹⁸ *Id.* at 806–07.

¹¹⁹ *Id.* at 808.

¹²⁰ *Id.* at 809.

¹²¹ *Id.* (citations omitted).

¹²² 50 Cal. Rptr. 3d 607 (Ct. App. 2006).

¹²³ *Id.* at 609–11.

¹²⁴ *Id.* at 616.

¹²⁵ *Id.*

¹²⁶ *Id.*

in a transformed setting alone would have shielded Sega's use behind the First Amendment."¹²⁷

Recently, the transformative test has begun to encroach on cases normally applying the *Rogers* test. In *No Doubt v. Activision Publishing, Inc.*, the court applied the transformative use test to a right of publicity claim involving digital avatars of famous musicians in a video game.¹²⁸ Citing the developer's commercial motivations, the court did not find First Amendment protections for the "simply precise computer-generated reproductions."¹²⁹ When the court reached the unfair competition claim, it modified the application of the *Rogers* test by adopting elements of the transformative test.¹³⁰ In rejecting the developer's First Amendment defense, the court cited the avatar's non-transformative use, finding the work not artistically relevant.¹³¹ Accordingly, the court did not need to approach the explicitly misleading prong, holding that this non-transformative use can confuse the public.¹³² Therefore, the misuse outweighed any artistic rights to free expression.¹³³ This approach directly conflicts with most courts' application of *Rogers*. Normally, the *Rogers* test "immunize[s] trademark uses on the ground that they did not obviously mislead even though application of the standard likelihood of confusion factors could potentially demonstrate consumer confusion."¹³⁴

¹²⁷ See Wesley Wintermyer, *Who Framed Rogers v. Grimaldi?: What Protects Trademark Holders Against First Amendment Immunity for Video Games?*, 64 ALA. L. REV. 1243, 1259 (2013).

¹²⁸ 122 Cal. Rptr. 3d 397, 415 (Ct. App. 2011).

¹²⁹ *Id.* at 411, 415; see also *Beastie Boys, et al., v. Monster Energy Co.*, 66 F. Supp. 3d 424 (S.D.N.Y. 2014) (ignoring First Amendment protections for a false or misleading endorsement case involving an infringing advertisement that created a misleading endorsement).

¹³⁰ *No Doubt*, 122 Cal. Rptr. 3d at 414–15.

¹³¹ *Id.*

¹³² *Id.* Additionally, the court implied that this requirement presents an undue burden on the plaintiff, remarking that it would be "almost impossible" for the plaintiff to prove the use was explicitly misleading. *Id.*

¹³³ *Id.*

¹³⁴ Bartholomew, *supra* note 44, at 51 ("The *Rogers* test represents a significant prospeech innovation in trademark law . . .").

II. REVIEWING THE CIRCUIT SPLIT OVER THE *ROGERS* TESTA. *Second Circuit's Formulation and Modification of the Rogers Test*

The seminal test for balancing trademark property interests and rights in artistic expression originated in *Rogers v. Grimaldi*.¹³⁵ In this case, an Italian film director made a film revolving around fictional Italian cabaret singers who imitated Ginger Rogers and Fred Astaire.¹³⁶ After a short run in American cinemas with mixed reviews, Rogers claimed that the film gave a false impression of her endorsement, violated her right of publicity, and defamed her by depicting her in a negative light.¹³⁷ The district court granted summary judgment to the defendant, holding that the title was a mere “exercise of artistic expression rather than commercial speech.”¹³⁸ On appeal, the Second Circuit clarified the ambiguity present in the lower court’s narrow application of the Lanham Act.¹³⁹ The court decided 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.”¹⁴⁰ Rather than simplifying the inquiry to commercial viability,¹⁴¹ the Lanham Act applies when the use “has no artistic relevance to the underlying work whatsoever, or, if it . . . explicitly misleads as to the source or the content of the work.”¹⁴² The Second Circuit recognized the possibility that the “Ginger and Fred” title could lead to consumer confusion, but, in context, the irony of the ambiguous title is a central element of the film.¹⁴³ Therefore, the court held

¹³⁵ 875 F.2d 994 (2d Cir. 1989).

¹³⁶ *Id.* at 996–97.

¹³⁷ *Id.* at 997.

¹³⁸ *Id.*

¹³⁹ *Id.* at 998–99.

¹⁴⁰ *Id.* at 999.

¹⁴¹ Reducing the test to a commercial inquiry would be virtually impossible due to the mixed artistic and economic nature of the movie industry. *See supra* notes 59–63 and accompanying text; *see also* Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495, 501–02 (1952) (holding that a business intent of profit does not deny films and other media free speech protection).

¹⁴² *Rogers*, 875 F.2d at 999.

¹⁴³ *Id.* at 998–99.

that the filmmaker did not violate the Lanham Act, stating that a contrary decision would instead suppress artistic expression.¹⁴⁴

In the immediate aftermath of this decision, a parody case in the Second Circuit expanded the reach of the test beyond titles of works to the expressive elements within the work itself.¹⁴⁵ In the parody *Spy Notes*, the authors utilized a humorous tone to riff on the infamous study books *Cliffs Notes*.¹⁴⁶ The district court granted a preliminary injunction fearing the “unbridled freedom” the First Amendment could grant to parodists.¹⁴⁷ On appeal, the court applied the *Rogers* test, ruling that expressive parodies require more protection than ordinary commercial products.¹⁴⁸ The court determined that it did not have to judge the artistry of the joke, but rather needed to prevent blatant consumer confusion.¹⁴⁹ Furthermore, the court did not apply the same explicitly misleading test formulated in the *Rogers* decision.¹⁵⁰ Rather, the court engaged in a limited likelihood of confusion analysis, insulating the parody under the First Amendment, because it provided a great benefit to the public interest.¹⁵¹

Shortly after this case, the Second Circuit tinkered with the likelihood of confusion test, providing even more protections for artist defendants. In *Twin Peaks Productions v. Publications International, Ltd.*, the publisher of a guide to a popular television show successfully defended itself against the trademark claims of the intellectual property holder of the television series.¹⁵² The court discussed the *Rogers* test’s application to different mediums, such as literary titles.¹⁵³ Rather than utilize the explicitly misleading stan-

¹⁴⁴ *Id.* at 1001–02.

¹⁴⁵ *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp.*, 886 F.2d 490, 495 (2d Cir. 1989).

¹⁴⁶ *Id.* at 492.

¹⁴⁷ *Id.* at 493.

¹⁴⁸ *Id.* at 495.

¹⁴⁹ *See id.* at 495–96 (“But parody may be sophisticated as well as slapstick; a literary work is a parody if, taken as a whole, it pokes fun at its subject.”); *see also* Bartholomew, *supra* note 44, at 60 (“[T]rademark law should yield when no confusion exists, or other social benefits outweigh the potential for confusion.”).

¹⁵⁰ *See Cliffs Notes*, 886 F.2d at 494–95.

¹⁵¹ *See id.* at 495–97.

¹⁵² 996 F.2d 1366, 1370–71 (2d Cir. 1993).

¹⁵³ *Id.* at 1379.

dard, the plaintiff's showing of likelihood of confusion must be "particularly compelling" to overcome First Amendment concerns.¹⁵⁴ This modified test recognizes a First Amendment presumption of validity by placing a higher burden on the plaintiff to prove a violation of the Lanham Act.¹⁵⁵ Here, the *Twin Peaks* court analyzed the wording, appearance, and disclaimer of the title.¹⁵⁶ This searching inquiry could create a level of uncertainty and a rise in litigation costs.¹⁵⁷ Not every circuit has adopted this approach.¹⁵⁸

Recently, in *Louis Vuitton Malletier S.A. v. Warner Bros. Entertainment Inc.*, the Southern District of New York applied this modified *Rogers* test.¹⁵⁹ In the case, Louis Vuitton disputed the use of a knockoff bag in the *Hangover: Part II*.¹⁶⁰ The film made it appear that one of the main characters owns an over-the-shoulder Louis Vuitton "Keepall" bag without notifying the audience that the bag is a fake.¹⁶¹ This scene was even included in commercials for the film.¹⁶² In the court's analysis, the use was artistically relevant because the film intended for the bag to enhance the funny and snobbish image of the protagonist, rather than exploit the mark's popularity and good will.¹⁶³ Furthermore, the court even felt that the bag introduced a tension between the characters.¹⁶⁴ In the second stage of the analysis, the court questioned the plaintiff's claim concerning confusion as to the source or content of third-party goods.¹⁶⁵ On a side note, the court assumed that it is possible for a fictional

¹⁵⁴ *Id.*

¹⁵⁵ Barrett, *supra* note 52, at 999-1000. Rather than allowing the defendant to receive complete immunity from misleading uses, the modified *Rogers* test involves a thorough analysis weighed in favor of the defendant. *See id.*

¹⁵⁶ *Twin Peaks*, 996 F.2d at 1379-80.

¹⁵⁷ *See id.*

¹⁵⁸ Bartholomew, *supra* note 44, at 50 ("Although the Ninth Circuit has not adopted this 'particularly compelling' standard, it has set up its own inquiry that replaces the traditional multi-factor likelihood of confusion test with a judicial assessment tilted in the artist's favor."); *see also infra* Sections II.B-D.

¹⁵⁹ 868 F. Supp. 2d 172, 177 (S.D.N.Y. 2012).

¹⁶⁰ *Id.* at 174-75.

¹⁶¹ *Id.*

¹⁶² *Id.* at 175.

¹⁶³ *Id.* at 178; *see also* Robbins, *supra* note 35, at 606 ("Beyond having an effect on sales, trademarks have helped, and continue to help, carve out storylines and characters.").

¹⁶⁴ *Louis Vuitton*, 868 F. Supp. 2d at 178.

¹⁶⁵ *Id.* at 180-81.

character to make an affirmative misrepresentation.¹⁶⁶ Still, the court held that the film's use did not pass the particularly compelling likelihood of confusion standard, even if the claim was legally cognizable.¹⁶⁷ The court felt most audience members would not realize the bag was a knockoff, because it only appears on-screen for a few seconds.¹⁶⁸ Additionally, the character's misrepresentations of the bag are a joke within the film that few audiences will take seriously.¹⁶⁹ Ultimately, the claim was too indirect and implausible that the court granted the defendant's motion to dismiss.¹⁷⁰

In summary, the Second Circuit originated the artistically relevant and not explicitly misleading test for First Amendment protections in unauthorized trademark use.¹⁷¹ Over the years, the circuit has modified its interpretation of explicitly misleading, applying a modified likelihood of confusion inquiry.¹⁷² This test slightly favors the defendant, while also extending the formal process of the inquiry.¹⁷³

B. Ninth Circuit's Expansion of the Rogers Test

The Ninth Circuit has crafted a simple and coherent application of the *Rogers* test within a region that constantly must balance the First Amendment protections of creators and property interest of trademark holders. The Ninth Circuit adopted and expanded the *Rogers* test in *Mattel, Inc. v. MCA Records, Inc.*¹⁷⁴ The manufacturer

¹⁶⁶ See *id.* at 182. This conclusion presents a dangerous new area for judicial inquiry. Now, courts may have to interpret jokes and analyze the intent of fictional characters. At least in the Second Circuit, the resulting likelihood of confusion would not be sufficient to pass the particularly compelling floor. *Id.*

¹⁶⁷ *Id.* at 181-82.

¹⁶⁸ *Id.* at 182.

¹⁶⁹ *Id.* For example, the film's character even mispronounces the Louis Vuitton brand for comedic effect. *Id.* at 178.

¹⁷⁰ *Id.* at 184-85; see also *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 32-33 (2003) ("The words of the Lanham Act should not be stretched to cover matters that are typically of no consequence to purchasers.").

¹⁷¹ See *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

¹⁷² See *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp.*, 886 F.2d 490, 496-97 (2d Cir. 1989).

¹⁷³ See *Twin Peaks*, 996 F.2d at 1379.

¹⁷⁴ 296 F.3d 894, 902 (9th Cir. 2002).

of the famed Barbie doll sued a band that parodied the doll and its associated mark within a popular song.¹⁷⁵ The Ninth Circuit originally expressed its satisfaction with the likelihood of confusion test, yet the court felt it did not adequately protect the “public’s interest in free expression” for trademarks that “transcend their identifying purpose . . . and become an integral part of our vocabulary.”¹⁷⁶ In order to properly protect both interests at stake, the appellate court applied the *Rogers* test.¹⁷⁷ Here, the song was clearly relevant to the mark, because it was an obvious parody, poking fun at Barbie.¹⁷⁸ Additionally, the mere use of Barbie in the title of the song was not explicitly misleading, because that result would “render *Rogers* a nullity.”¹⁷⁹ As a result, the Ninth Circuit affirmed the summary judgment ruling.¹⁸⁰

Soon after this decision, the Ninth Circuit began to narrow the *MCA* court’s holding. In *Mattel, Inc. v. Walking Mountain Productions*, the toy manufacturer brought a trademark infringement claim against a photographer specializing in pictures of nude Barbie dolls.¹⁸¹ The artist displayed his photographs at festivals and on a website.¹⁸² The Ninth Circuit put a gloss on its earlier rulings by adding a “cultural significance” requirement on the exploited mark.¹⁸³ Under this limitation, creators will only receive First Amendment protections for works that utilize marks which have entered the public discourse.¹⁸⁴ While the *MCA* court mentioned the cultural significance of the Barbie trademark, the court did not explicitly require that the mark permeate the public discourse in order to trigger the First Amendment shield.¹⁸⁵ Applying the *Rogers*

¹⁷⁵ *Id.* at 898–99.

¹⁷⁶ *Id.* at 900. The Ninth Circuit still considered many of the likelihood of confusion factors before applying *Rogers*. See Kelly L. Baxter, Comment, *Trademark Parody: How to Balance the Lanham Act with the First Amendment*, 44 SANTA CLARA L. REV. 1179, 1200 (2004).

¹⁷⁷ *MCA Records*, 296 F.3d at 901–02.

¹⁷⁸ *Id.*

¹⁷⁹ *Id.* at 902.

¹⁸⁰ *Id.*

¹⁸¹ 353 F.3d 792, 796–97 (9th Cir. 2003).

¹⁸² *Id.*

¹⁸³ *Id.* at 807.

¹⁸⁴ *Id.*

¹⁸⁵ See *MCA Records*, 296 F.3d at 903, 906.

test, the *Walking Mountain* court reached the same conclusion as the *MCA* court, protecting the mark's use as artistically relevant and not explicitly misleading.¹⁸⁶

Despite this additional limitation, the Ninth Circuit continued to protect artists' work of expression, even in the face of tarnishment claims. In *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, the plaintiff sued the developers of the Grand Theft Auto video game for depicting the plaintiff's strip club, the Play Pen, and calling it "Pig Pen."¹⁸⁷ The game earned an infamous reputation for its "irreverent and sometimes crass brand of humor, gratuitous violence and sex, and overall seediness."¹⁸⁸ The game featured a disclaimer that the location was fictional and the creators considered it a parody that "lampooned the seedy underbelly of Los Angeles and the people, business and places [that] comprise it."¹⁸⁹ As a result, a nominative fair use defense did not apply, because the developers testified that they did not have the intent to critique the specific establishment.¹⁹⁰ Yet, the court determined that the defendant received First Amendment protections under *Rogers*.¹⁹¹ The plaintiff conceded that the developer's use was artistic.¹⁹² However, the plaintiff attempted to dispute the relevance of the use as failing to reference the Play Pen.¹⁹³ Additionally, the plaintiff argued that the defendant should not receive First Amendment protections because the Play Pen was not a cultural icon.¹⁹⁴

The Ninth Circuit rejected the plaintiff's arguments and refined the modified *Rogers* test from *Walking Mountain*.¹⁹⁵ Removing the referential and cultural icon requirements, the court held that

¹⁸⁶ *Walking Mountain*, 353 F.3d at 807.

¹⁸⁷ 547 F.3d 1095, 1097–98 (9th Cir. 2008).

¹⁸⁸ *Id.* at 1096.

¹⁸⁹ *Id.* at 1097.

¹⁹⁰ *Id.* at 1098–99.

¹⁹¹ *Id.* at 1099 ("Although this test traditionally applies to uses of a trademark in the title of an artistic work, there is no principled reason why it ought not also apply to the use of a trademark in the body of the work.").

¹⁹² *Id.* at 1099–1100.

¹⁹³ *Id.* at 1100.

¹⁹⁴ *Id.*

¹⁹⁵ *Id.*

“the level of relevance merely must be above zero.”¹⁹⁶ Here, the distinctive “look and feel” of urban neighborhoods relevant to making a cartoon-style parody satisfied the low relevance threshold.¹⁹⁷ The court held that the work was not explicitly misleading as the public would not entertain the notion that a strip club would have produced the video game.¹⁹⁸ Furthermore, the court said the location was “incidental” to the overall story and “unambiguously *not* the main selling point of the [g]ame.”¹⁹⁹ Therefore, the Ninth Circuit affirmed the summary judgment ruling in favor of the defendant.²⁰⁰

Although a tarnishment claim would have proved quite challenging for a strip club, in *Roxbury Entertainment v. Penthouse Media Group, Inc.*, the plaintiff obtained the television rights of the Route 66 mark and sued over a pornographic film titled Route 66.²⁰¹ Here, the district court considered a First Amendment defense and found the work artistically relevant and not explicitly misleading.²⁰² The “tenuous” relationship between the mental imagery of the mark and the content of the film passed the minimal relevance threshold of the test.²⁰³ Additionally, the court held that there was no concern of consumers believing that the plaintiff sponsored the film.²⁰⁴ Even though this case involved a clear commercial use, the film did not explicitly mislead consumers and received First Amendment protections.²⁰⁵ Here, the taste of the content did not affect the court’s analysis, yet other courts have granted less protection for

¹⁹⁶ *Id.* But see Lateef Mtima, *What’s Mine Is Mine but What’s Yours Is Ours: IP Imperialism, the Right of Publicity, and Intellectual Property Social Justice in the Digital Information Age*, 15 SMU SCI. & TECH. L. REV. 323, 363–64 (2012) (“[S]uch a standard essentially eliminate[s] the relevance assessment . . .”).

¹⁹⁷ *E.S.S.*, 547 F.3d at 1100. Yet this analysis differs from the *Rogers* court’s initial inquiry, as “[t]he court instead demonstrated a willingness to consider a broader concept of actionable confusion beyond that engendered by overt misrepresentations as to source.” Thomas M. Byron, *Spelling Confusion: Implications of the Ninth Circuit’s View of the “Explicitly Misleading” Prong of the Rogers Test*, 19 J. INTELL. PROP. L. 1, 16 (2011).

¹⁹⁸ *E.S.S.*, 547 F.3d at 1100.

¹⁹⁹ *Id.* at 1100–01.

²⁰⁰ *Id.* at 1101.

²⁰¹ 669 F. Supp. 2d 1170, 1172–73 (C.D. Cal. 2009).

²⁰² *Id.* at 1175–76.

²⁰³ *Id.*

²⁰⁴ *Id.* at 1176.

²⁰⁵ *Id.*

morally questionable works.²⁰⁶ As a result, trademark holders lose some dominion over their intellectual property because the court's failure to recognize the marketplace confusion over the work's use of the mark makes it increasingly difficult for mark holders to control the public depictions and associations of their brands.²⁰⁷

On the other hand, the decision in *Rebelution, LLC v. Perez* differed from precedent.²⁰⁸ In this case, international recording artist Pitbull titled one of his songs "Rebelution," even though a reggae band owned the trademark for the title.²⁰⁹ The district court applied a stringent version of the *Rogers* test, which required that the appropriated mark be of "such cultural significance that it has become [an] integral part of public's vocabulary."²¹⁰ Here, "Rebelution" had not transcended its identifying purpose and had not entered the public discourse.²¹¹ The court further complicated the *Rogers* test by formally requiring that the unauthorized use refer to the "meaning associated with plaintiff's mark" in order to pass the relevance threshold.²¹² The court found it was impossible for Pit-

²⁰⁶ See *Pillsbury Co. v. Milky Way Prods.*, No. C78-679A, 1981 WL 1402, at *16 (N.D. Ga. Dec. 24, 1981) (failing to consider First Amendment implications for the finding of infringement for the parody use of a plaintiff's mark in a pornographic magazine); Barrett, *supra* note 52, at 991 n.72 ("[S]ome of these other decisions could be characterized as finding infringement due largely to the court's distaste for the content of the defendant's noncommercial expression, which is certainly inconsistent with First Amendment principles."); Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 WASH. L. REV. 887, 910-16 (arguing that in some cases courts appear to have based infringement decisions on "visceral disapproval" of defendant's use).

²⁰⁷ See *supra* notes 93-98 and accompanying text.

²⁰⁸ 732 F. Supp. 2d 883 (N.D. Cal. 2010). Other courts within the Ninth Circuit have rejected the *Rebelution* decision. See, e.g., *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*, 74 F. Supp. 3d 1134, 1140 (N.D. Cal. 2014) (referring to the case as an "outlier decision from this district").

²⁰⁹ *Rebelution*, 732 F. Supp. 2d at 885-86.

²¹⁰ *Id.* at 887; see also *Warner Bros. Entm't v. Glob. Asylum, Inc.*, No. CV 12-9547 PSG (CWx), 2012 WL 6951315, *16 (C.D. Cal. Dec. 10, 2012) (holding that the *Rogers* test applies to the term "hobbit," even though the "term may not be integral to the public's vocabulary, but it has gained some measure of use as a term to refer to small creatures . . ."). But see *Stewart Surfboards, Inc. v. Disney Book Grp. LLC*, Case No. CV 10-2982 GAF (SSx), 2011 WL 12877019, at *3 (C.D. Cal. May 11, 2011) ("Thus, there is no basis for applying the *Rogers* test only when the expressive or artistic speech makes reference to culturally significant marks.").

²¹¹ *Rebelution*, 732 F. Supp. 2d at 888.

²¹² *Id.* at 889.

bull to meet this standard, because the artist thought the word was imaginary.²¹³ This result prevents artists from “co-opt[ing even] the most fanciful marks.”²¹⁴ The court warned that a change in the law “would allow any person to ascribe their own meaning to a mark and thereafter argue that their artistic work bears relevance to this opportunistically-defined meaning.”²¹⁵ Ultimately, the court denied Pitbull’s motion for summary judgment based on the likelihood of confusion factors.²¹⁶

In *Dita, Inc. v. Judith Mendez*, another district court in the Ninth Circuit adhered to the *Rebellion* analysis.²¹⁷ A “high fashion” eyewear designer brought an infringement and unfair competition claim against an entertainer selling jewelry, leather goods, and clothing with the designer’s trademark.²¹⁸ In analyzing a First Amendment defense, the court reiterated the importance of the *Rogers* test because the First Amendment did not “automatically insulate” artistic works from liability.²¹⁹ Here, the court explained that the entertainer’s use did not merit First Amendment protections because the defendant used the mark to promote their own product, rather than “describe or comment upon the *plaintiff’s* mark or product.”²²⁰ This application implies that the *Rogers* test would only apply to parody cases, yet other rulings in this circuit have explained that a mere reference in isolation is enough to warrant protection.²²¹ Furthermore, the court stated that even if the *Rogers* test applied, the entertainer’s use did not pass the referen-

²¹³ *Id.* (“Instead, [Pitbull] adopted the word rebellion because he saw it on a store front in Miami: ‘I was driving by, and I seen it, and I said, Wow, that is a great word, because it had everything to do with me in the music business, my family in Cuba and me just as a fighter in general.’”).

²¹⁴ *Id.* However, this referential standard has a low threshold, because the court agreed that even the loose mental connection of Route 66 and road imagery in the Roxbury decision remain consistent with this decision. *Id.*

²¹⁵ *Id.*

²¹⁶ *See id.* at 898–99. While the *Rebellion* court modified the *Rogers* test even further, the facts of this case indicated that Pitbull attempted to co-opt the mark by using the mark in the same way the owner had used it. This fact pattern may be distinguished from the other cases analyzed within this circuit.

²¹⁷ No. CV 10–6277 PSG (FMOx), 2010 WL 5140855, at *3 (C.D. Cal. Dec. 14, 2010).

²¹⁸ *Id.* at *1.

²¹⁹ *Id.* at *2.

²²⁰ *Id.*

²²¹ *See supra* notes 187–207 and accompanying text.

tial requirement and the plaintiff's mark was not culturally significant.²²² As a result, the court denied the entertainer's motion to dismiss.²²³

Recently, district courts in the Ninth Circuit have attempted to resolve these inconsistent decisions. In *VIRAG, S.R.L. v. Sony Computer Entertainment America LLC*, an Italian floor manufacturer brought an infringement claim against Sony's Gran Turismo games.²²⁴ The court applied the *Rogers* test, extending First Amendment protections to the "body of the expressive works."²²⁵ While the manufacturer argued that its mark did not meet the "cultural significance" requirement, the court rejected this additional limitation on artistic relevance.²²⁶ This reading of the *Rogers* test remained consistent with previous decision in *E.S.S.* because, in that case, the disputed mark had "little cultural significance," yet still received protection.²²⁷ Therefore, the court held that previous decisions did not preclude *Rogers* from applying to works that are "not cultural icons."²²⁸ Here, the court found the mark's use to be artistically relevant and not explicitly misleading.²²⁹ It was unnecessary for the court to determine "*exactly* how artistically relevant" the mark connects to the game, so long as the use relevance is "above zero."²³⁰ Additionally, the court held it was irrelevant "whether the defendants used the VIRAG® mark for commercial gain *in addition to* using it for artistic purposes."²³¹ Fur-

²²² *Dita*, 2010 WL 5140855, at *3.

²²³ *Id.* at *6.

²²⁴ No. 3:15-CV-01729-LB, 2015 WL 5000102, at *1 (N.D. Cal. Aug. 21, 2015), *appeal docketed*, No. 16-15137 (9th Cir. Jan. 29, 2016).

²²⁵ *Id.* at *9 (citing *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008)).

²²⁶ *Id.* ("[T]he fact that Barbie made its way into the global lexicon does not mean every mark must do so in order for its use to be protected by the First Amendment." (quoting *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*, 74 F.Supp.3d 1134, 1140-41 (N.D. Cal. 2014))).

²²⁷ *See id.* (mentioning that the disputed mark in *E.S.S.* had "little cultural significance," yet still received protection (quoting *E.S.S.*, 547 F.3d at 1100)).

²²⁸ *Id.* at *10.

²²⁹ *Id.* at *11-13.

²³⁰ *Id.* at *12 (quoting *E.S.S.*, 547 F.3d at 1100). Furthermore, the court discouraged judges from engaging in "artistic analysis." *Id.* at *11 (quoting *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1243 (9th Cir. 2013)).

²³¹ *Id.* at *12.

thermore, the manufacturers' claims of false sponsorship were insufficient to prove an explicitly misleading use because a mere use alone is not enough, even if there is also consumer confusion.²³² For an explicitly misleading claim, the Ninth Circuit often requires an "'explicit indication' . . . 'overt claim' or 'explicit misstatement.'"²³³ However, the court left open the possibility of satisfying this standard by framing the mark's use as the "main selling point for the game."²³⁴ Although VIRAG was not the main selling point and received First Amendment protection, this uncertainty could affect future decisions.²³⁵

Another recent district court decision has approached the controversial split within the circuit. In *Twentieth Century Fox Television v. Empire Distribution Inc.*, the owner of a media enterprise sent a cease and desist notice to a television network in connection with the show "Empire" and the show's soundtracks, which allegedly created confusion over the "Empire" and "Empire Distribution" marks.²³⁶ In response, Fox brought a declaratory judgment action against Empire, claiming that the defendant "attempt[ed] to extend its use of another's trademark much further than in any other case applying *Rogers*."²³⁷ As a result, the plaintiff asked the court to place a greater emphasis on the likelihood of confusion test, but the court rejected this position, upholding the *Rogers* test as the "'only relevant legal framework'" for this First Amendment question.²³⁸ Significantly, the court formally rejected the cultural significance inquiry.²³⁹ Applying the *Rogers* test, the court reiterated that the Ninth Circuit has never adopted a referential requirement.²⁴⁰ Even

²³² *Id.*

²³³ *Id.* at *13 (quoting *Brown*, 724 F.3d at 1245).

²³⁴ *Id.* (quoting *Elec. Arts, Inc. v. Textron Inc.*, No. C 12-00118 WHA, 2012 WL 3042668, at *5 (N.D. Cal. July 25, 2012)).

²³⁵ *Id.*

²³⁶ 161 F. Supp. 3d 902, 904 (C.D. Cal. 2016).

²³⁷ *Id.* at 906.

²³⁸ *Id.* (quoting *Brown*, 724 F.3d at 1242).

²³⁹ *Id.* at 906–07.

²⁴⁰ *Id.* at 907–08 ("At most, the Ninth Circuit has suggested that [the referential requirement] is a fact which a court may consider."). Rather, the court argued that the *Rogers* analysis should ensure that marks are not "arbitrarily chosen to . . . exploit the[ir] publicity value . . ." *Id.* at 908 (quoting *Stewart Surfboards, Inc. v. Disney Book Grp., LLC*, No. CV 10-2982 GAF (SSX), 2011 WL 12877019, at *4 (C.D. Cal. May 11, 2011)).

though Fox was a junior user and did not reference Empire Distribution's mark, Fox's use was "clearly relevant" to the plot and location of the defendant's television show.²⁴¹ Moreover, the court aimed to avoid the "perverse result" of not protecting uses that actually disclaim the mark's origin, rather than a veiled attempt to free ride on the mark's goodwill.²⁴² The court held that the plaintiff's use was not explicitly misleading, even if there was a danger of some consumer confusion, and granted summary judgment in favor of the plaintiffs, noting that "Empire Distribution's only arguments against summary judgment require the [c]ourt to rewrite the *Rogers* test."²⁴³

C. *Sixth Circuit's Modified Rogers Test*

An outlier among courts, the Sixth Circuit has adopted an approach that favors the mark holder in these First Amendment trademark cases. In *Parks v. LaFace Records*, a rap group referenced Rosa Parks within the title of one of their songs.²⁴⁴ However, the song is not about Parks and makes only an indirect reference to the "back of the bus."²⁴⁵ Applying *Rogers*, the district court concluded that the First Amendment provided a defense to Parks' Lanham Act claim because there was no confusion, and the title was not explicitly misleading.²⁴⁶ On appeal, the Sixth Circuit rejected the lower court's analysis, creating a significant barrier to the First Amendment shield.²⁴⁷ In analyzing the decision, the court rejected the likelihood of confusion and alternative avenues tests, and in-

²⁴¹ *See id.* at 907. ("The word 'Empire' is clearly relevant to Fox's work because the Empire Series tells the story of characters struggling for literal control over an entertainment company called 'Empire Enterprises,' and figurative control over the vast 'empire' that Lucious Lyon has built. Additionally, the Empire Series is set in New York, the Empire State. Indeed, Empire Distribution concedes that the word 'Empire' has artistic relevance to Fox's work.").

²⁴² *Id.* at 908. Additionally, the court mentioned that limiting the test to parody situations would "severely chill otherwise constitutionally protected speech." *Id.*

²⁴³ *Id.* at 909–10.

²⁴⁴ 329 F.3d 437, 441 (6th Cir. 2003).

²⁴⁵ *Id.* at 452–53.

²⁴⁶ *See id.* at 444.

²⁴⁷ *See id.* at 447. ("However, the First Amendment cannot permit anyone who cries 'artist' to have *carte blanche* when it comes to naming and advertising his or her works, art though it may be.").

stead adopted a stringent application of the *Rogers* test.²⁴⁸ The court found a genuine issue of material fact concerning the artistic relevance of the title of the song.²⁴⁹ Distinguishing the *Rogers*' title as reflecting the plot and *Mattel* as a parody case, the court viewed the Rosa Parks title as a marketing maneuver to increase the song's potential sales.²⁵⁰ The court held that the writer of the lyrics admitted that the song was a vague metaphor singling out competitors, rather than a reference to Rosa Parks.²⁵¹ However, the court left the artistic relevance issue for a jury on remand.²⁵² Furthermore, the court held that the title was not explicitly misleading.²⁵³ Thus, the Sixth Circuit probed further into the defendants' specific use of the mark by instituting a referential requirement.²⁵⁴

Shortly after the *Parks* decision, the Sixth Circuit confronted the First Amendment in the trademark context in *ETW Corp. v. Jireh Publishing, Inc.*²⁵⁵ The licensing agent of professional golfer Tiger Woods alleged trademark infringement, dilution, and unfair

²⁴⁸ *Id.* at 447–52.

²⁴⁹ *Id.* at 458.

²⁵⁰ *Id.* at 453 (“*Back of the Bus*, for example, would be a title that is obviously relevant to the content of the song, but it also would not have the marketing power of an icon of the civil rights movement. Choosing Rosa Parks’ name as the title to the song unquestionably enhanced the song’s potential sale to the consuming public.”); *see also* Seale v. Gramercy Pictures, 949 F. Supp. 331, 340 (E.D. Pa. 1996) (holding that the image of a celebrity on the cover of a soundtrack for a movie was a disguised advertisement, because the CD had various songs by various artists with no direct connection to the celebrity or his political movement). *But see* Jason Levine, *Can the Right of Publicity Afford Free Speech? A New Right of Publicity Test for First Amendment Cases*, 27 HASTINGS COMM. & ENT. L.J. 171, 226 (2004) (“[The song in *Parks*] would seem to contain at least a modicum of artistic relevance to the publicly known persona of Rosa Parks.”).

²⁵¹ *Parks*, 329 F.3d at 452–53.

²⁵² *See id.* at 453–56 (“If the requirement of ‘relevance’ is to have any meaning at all, it would not be unreasonable to conclude that the title *Rosa Parks* is *not* relevant to the content of the song in question.”). *But see* Lisa Tomiko Blackburn, *The Recording Academy (R) Entertainment Law Initiative 2003 Legal Writing Contest: Title Blanding: How the Lanham Act Strips Artistic Expression from Song Titles*, 22 CARDOZO ARTS & ENT. L.J. 837, 842 (2005) (arguing that this application “restrict[s] an artist who envisions the song title as part of the piece of art itself . . .” resulting in “title blanding”).

²⁵³ *Parks*, 329 F.3d at 456. However, the court recognized the question of relevance concerning the title and remanded the issue to the lower court.

²⁵⁴ *See id.* at 459; *see also* Mitchell David Greggs, *Shakin’ It to the Back of the Bus: How Parks v. LaFace Uses the Artistic Relevance Test to Adjudicate Artistic Content*, 61 WASH. & LEE L. REV. 1287, 1310 (2004).

²⁵⁵ 332 F.3d 915 (6th Cir. 2003).

competition claims against the publisher of a painting that commemorated Woods' victory at the Masters Tournament.²⁵⁶ The court held that use of the "Tiger Woods" mark was merely descriptive and protected under fair use, but went through a more searching inquiry for the unfair competition and false endorsement claims.²⁵⁷ Here, the alleged misuse involved a celebrity's identity, so the likelihood of confusion test was inadequate because it failed to fully consider First Amendment protections.²⁵⁸ In applying the *Rogers* test, the court believed that the artist's rendering of Woods was "much more than a mere literal likeness."²⁵⁹ Rather, the artist created a panorama of a historical event celebrating culture.²⁶⁰ As a result, the court held that the work was unquestionably relevant, even under the *Parks* interpretation.²⁶¹ Furthermore, even if there was confusion, the court found no overt misrepresentations.²⁶² Therefore, the court held that "Wood[s]' right[s] . . . must yield to the First Amendment."²⁶³ Thus, the Sixth Circuit expanded the *Rogers* test to cover third party trademarks within the work itself, beyond the mere title.²⁶⁴

Even though the *ETW* court applied the more exacting relevance test, a recent lower court case in the Sixth Circuit has rejected the *Parks* referential requirement.²⁶⁵ The plaintiff owned the mark

²⁵⁶ *Id.* at 918–19.

²⁵⁷ *Id.* at 920–21.

²⁵⁸ *Id.* at 926. Even though the court mentioned the more liberal case *Mattel v. MCA Records*, it appears that the Sixth Circuit has limited its version of the *Rogers* test to contested celebrity use. *See id.* at 926–28.

²⁵⁹ *Id.* at 936.

²⁶⁰ *Id.*

²⁶¹ *See id.* at 936 n.18.

²⁶² *See id.* at 938.

²⁶³ *Id.*

²⁶⁴ *See* Byron, *supra* note 197, at 8. However, this decision could merely reflect the court's efforts to protect a "poor" artist creating a painting of historic event from the lawsuit of a highly marketable sports figure. Thus, the successful First Amendment defense in this clearly commercial context could represent an outlier holding influenced by public policy concerns. *See* Joseph R. Dreitler, Comment, *The Tiger Woods Case—Has the Sixth Circuit Abandoned Trademark Law?* *ETW Corp. v. Jireh Publ'g, Inc.*, 38 *AKRON L. REV.* 337, 350-51 (2005).

²⁶⁵ *Rebellion Devs. Ltd. v. Stardock Entm't, Inc.*, No. 12-12805, 2013 WL 1944888, at *3 (E.D. Mich. May 9, 2013).

Rebellion for use with amusement machines.²⁶⁶ The defendants released a game that the public sometimes referred to as Rebellion.²⁶⁷ The plaintiff attempted to avoid the constitutional question by stating that the defendant did not innocently infringe because the defendant did not directly reference a trademarked term.²⁶⁸ Yet the court rejected this argument, recognizing the “inextricably intertwined” relationship between commercial and artistic attributes.²⁶⁹ The court further held that the game met the low artistic relevance threshold because it asked players to choose between the “loyalist” or “rebel” factions.²⁷⁰ This application of the test overlooks the referential requirement, merely searching for “some artistic relevance.”²⁷¹ Furthermore, even though the defendants “willfully attempted to capitalize on the reputation of [the p]laintiffs,” the use was not explicitly misleading because the defendants did not utilize “overt misrepresentation[s].”²⁷² On these grounds, the court dismissed the claim.²⁷³

D. Seventh Circuit’s Refusal to Adopt the Rogers Test

The Seventh Circuit approached First Amendment trademark protections in *Eastland Music Group, LLC v. Lionsgate Entertainment, Inc.*²⁷⁴ The district court applied the *Rogers* test to the claim that the film *50/50* infringed on the trademark “PHIFTY-50,” however, the court did not state whether the test was appropriate within the circuit.²⁷⁵ The court dismissed the claim, holding that there was “no question” that the title had artistic relevance and was not explicitly misleading.²⁷⁶ On appeal, mark owner Eastland

²⁶⁶ *Id.* at *1.

²⁶⁷ *Id.*

²⁶⁸ *Id.* at *3.

²⁶⁹ *Id.*

²⁷⁰ *Id.* at *5.

²⁷¹ *Id.*

²⁷² *Id.* at *6.

²⁷³ *Id.*

²⁷⁴ 707 F.3d 869 (7th Cir. 2013).

²⁷⁵ *Eastland Music Grp., LLC v. Lionsgate Entm’t, Inc.*, No. 11-C-8224, 2012 WL 2953188, at *3 (N.D. Ill. July 19, 2012) (“The Seventh Circuit has not spoken on the propriety of [the *Rogers*] test.”), *aff’d*, 707 F.3d 869 (7th Cir. 2013).

²⁷⁶ *Id.* (mentioning that the film reveals that the title is a reference to the protagonist’s 50/50 odds of surviving a rare form of cancer). This application certainly ignores the Sixth Circuit’s referential requirement. *See supra* Section II.C.

Music Group (“EMG”) argued that the district court’s decision granted the defendants “*carte blanche* to use and infringe upon EMG’s trademark(s) no matter how much time, money and effort EMG has put into building its brand.”²⁷⁷ EMG disagreed with the court’s outcome, citing the fact that “the vast majority of the movie is not about the character’s ‘50/50’ diagnosis . . . [but, rather,] the lead character’s personal relationships.”²⁷⁸ While this argument has merit, an opposite ruling would call for judges to engage in unqualified artistic determinations that could create a dangerous chilling effect.²⁷⁹ On appeal, the Seventh Circuit punted on adopting or rejecting the Rogers test to “avoid unnecessary constitutional adjudication.”²⁸⁰

Prior to the *Eastland Music* decision, the Seventh Circuit had elected to avoid answering First Amendment questions in these unauthorized trademark use cases. In *Dillinger, LLC v. Electronic Arts Inc.*, a district court in the Seventh Circuit heard a case involving the use of a trademarked name on weapons in a video game.²⁸¹ The Seventh Circuit had not yet opined on the *Rogers* approach to balancing First Amendment and intellectual property interests.²⁸² In the end, the court accepted the parties’ request to apply the *Rogers* test.²⁸³ For this court, the test would bar trademark claims “unless the use of the plaintiff’s likeness is ‘wholly unrelated to the [work] or [is] simply a disguised commercial advertisement for the sale of goods or services.’”²⁸⁴ Even though the mark holder argued that the use was an “isolated element[] in the work” with no relation to the story, the court found this use was artistically relevant

²⁷⁷ Brief of Appellant at 16, *Eastland Music Grp., LLC v. Lionsgate Entm’t, Inc.*, 707 F.3d 869 (7th Cir. July 19, 2012) (No. 12-2928).

²⁷⁸ *Id.* at 17.

²⁷⁹ *See infra* Part III.

²⁸⁰ *Eastland Music Grp.*, 707 F.3d at 871. Rather, the Seventh Circuit held that the “complaint fails at the threshold . . . [to] allege that the use of ‘50/50’ as a title has caused any confusion about the film’s source.” *Id.*

²⁸¹ No. 1:09-CV-1236-JMS-DKL, 2011 WL 2457678, at *1 (S.D. Ind. June 16, 2011).

²⁸² *Id.* at *4 n.1 (“Although the parties agree that the [c]ourt should adopt the test set forth by the Second Circuit in *Rogers*, the Seventh Circuit has not yet spoken on the propriety of this test.”).

²⁸³ *Id.*

²⁸⁴ *Id.* at *4 (citing *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989)).

within this “fictional world.”²⁸⁵ The court reiterated that “any connection” could satisfy the artistic relevance standard, noting that it is not the court’s role to parse the “meaningful[ness of] the relationship between a trademark and the content of a literary work.”²⁸⁶ Additionally, the court held that the use was not explicitly misleading or confusing.²⁸⁷ The plaintiff argued that the trademarked weapon was touted as “arguably the most powerful gun available” in the game, yet the court found this claim unpersuasive.²⁸⁸ The court indicated that the mark was not the “selling point of the game,” thereby adopting a high bar for the explicitly misleading prong.²⁸⁹

In *Fortres Grand Corporation v. Warner Bros. Entertainment Inc.*, the owner of the “Clean Slate” mark brought a trademark infringement claim against Warner Bros. for a reference to a fictional “clean slate” software program in the film *The Dark Knight Rises*.²⁹⁰ Similar to the *Louis Vuitton* case, the district court struggled with the lack of precedent on fictional product infringements.²⁹¹ The court reasoned that in comparing the final products, the film’s display of a fictional product did not harm the software company.²⁹² Additionally, Warner Bros. remained insulated from misleading sponsorship claims because the advertised product was fiction-

²⁸⁵ *Id.* at *4–5 (“[E]ven if the [c]ourt accepts the characterization as attenuated, such connection is enough to satisfy the *Rogers* test: The gentleman-bandit, commonly known for his public persona as a ‘flashy gangster who dressed well, womanized, drove around in fast cars, and sprayed Tommy Guns,’ has above-zero relevance to a game whose premise enables players to act like members of the mafia and spray Tommy Guns.” (citations omitted)).

²⁸⁶ *Id.* at *6.

²⁸⁷ *Id.*

²⁸⁸ *Id.* at *6–8 (“To be ‘explicitly misleading,’ the defendant’s work must make some affirmative statement of the plaintiff’s sponsorship or endorsement, beyond the mere use of plaintiff’s name or other characteristic.”).

²⁸⁹ *Id.* at *7–8.

²⁹⁰ 947 F. Supp. 2d 922, 924 (N.D. Ind. 2013), *aff’d*, 763 F.3d 696 (7th Cir. 2014).

²⁹¹ *See id.* (“Is it trademark infringement if a fictional company or product in a movie or television drama bears the same name or brand as a real company or product?” (quoting 6 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:149 (4th ed.))).

²⁹² *See id.* at 929; *see also* *Caterpillar Inc. v. Walt Disney Co.*, 287 F. Supp. 2d 913, 920 (C.D. Ill. 2003) (“[I]t appears unlikely . . . that any consumer would be more likely to buy or watch *George [of the Jungle] 2* because of any mistaken belief that Caterpillar sponsored this movie.”).

al, and, therefore, the use did not identify a source.²⁹³ The district court also entertained a First Amendment defense, applying the *Rogers* test and finding that the work was artistically relevant and not explicitly misleading.²⁹⁴ The court applied a low relevance standard, concluding that the use of a mark as part of the plot satisfies the *Rogers* test.²⁹⁵ Importantly, the court rejected the plaintiff's adoption of a referential requirement that would prevent the test from applying to reverse confusion claims.²⁹⁶ The court agreed with the stance that this additional restriction would limit protection to parodies, while creating a monopoly on certain words, chilling filmmakers.²⁹⁷ The district court granted the motion to dismiss.²⁹⁸ Perplexingly, on appeal, the Seventh Circuit affirmed this decision, but refused to even consider a First Amendment defense because it was unnecessary to the court's holding.²⁹⁹

Overall, the district courts within the Seventh Circuit appear to apply the *Rogers* test with the same consistency as the Ninth Circuit.³⁰⁰ The lower courts analyze the artistic relevance and explicitly misleading aspects of the unauthorized use of the trademark.³⁰¹ While these courts use the First Amendment to shield content creators from any infringement liability, on appeal, the Seventh Circuit has repeatedly avoided the constitutional issue by deciding the factual matter purely under the likelihood of confusion standard.³⁰² As a result, the precedent of the *Rogers* test remains merely persuasive within the Seventh Circuit.³⁰³ Furthermore, the applica-

²⁹³ *Fortres Grand Corp.*, 947 F. Supp. 2d at 930.

²⁹⁴ *Id.* at 931–32.

²⁹⁵ *Id.* at 932.

²⁹⁶ *Id.* at 932–33.

²⁹⁷ *Id.* at 933.

²⁹⁸ *Id.* at 934.

²⁹⁹ *Fortres Grand Corp. v. Warner Bros. Entm't Inc.*, 763 F.3d 696, 705–06 (7th Cir. 2014) (citing *Eastland Music Grp., LLC v. Lionsgate Entm't, Inc.*, 707 F.3d 869 (7th Cir. 2013)). The Seventh Circuit held that the only relevant factor in the analysis was the similarity of the marks, yet the factor was not dispositive, when analyzed in the context of the other weaker factors. *Id.* at 705.

³⁰⁰ See *supra* Sections II.B, notes 274–99 and accompanying text.

³⁰¹ See *supra* notes 274–99 and accompanying text.

³⁰² See *supra* notes 274–80, 290–99 and accompanying text.

³⁰³ See *id.*

tion of the test appears to hinge on the mutual adoption of conflicted parties.³⁰⁴

III. PROPOSING A CLEAR AND CONSISTENT TEST TO BENEFIT ARTISTS AND PROTECTIVE MARK HOLDERS

The circuits vary on a multitude of issues concerning the application of the *Rogers* test. The Second Circuit formulated the test in relation to artistic uses within titles, but the circuit opted to extend their application to the content within a work.³⁰⁵ However, this original approach morphed from a quick application with a limited inquiry into the likelihood of confusion factors to a fact-intensive analysis favoring the defendant's free expression.³⁰⁶ The Seventh Circuit remains totally unpredictable due to the circuit's refusal to clarify the correct approach to balancing First Amendment and trademark rights.³⁰⁷ Additionally, the Sixth Circuit's inconsistent application of a referential requirement further complicates an artist's creative process and decision to litigate.³⁰⁸ Finally, the most contentious decisions reside in the Ninth Circuit, where narrow interpretations of the *Rogers* decision demand the artist's use to reference a culturally significant mark to receive First Amendment protection.³⁰⁹ Yet, recent Ninth Circuit decisions have rejected these requirements for a very liberal defense of artistic works that provide little to no control for mark holders.³¹⁰

Across the circuits, most decisions favor the artist, but "uncertain, lengthy, and expensive" litigation could have disastrous chilling effects.³¹¹ The current conflict between circuits will result in trademark users seeking an unnecessary license.³¹² This risk-averse strategy will often result in forsaking original artistic decisions in

³⁰⁴ See note 283 and accompanying text.

³⁰⁵ See *supra* Section II.A.

³⁰⁶ See *id.*

³⁰⁷ See *supra* Section II.D.

³⁰⁸ See *supra* Section II.C.

³⁰⁹ See *supra* Section II.B.

³¹⁰ See notes 224–43 and accompanying text.

³¹¹ William McGeeveran, *The Trademark Fair Use Reform Act*, 90 B.U. L. REV. 2267, 2268–69, 2275 (2010).

³¹² Rebecca Tushnet, *Why the Customer Isn't Always Right: Producer-Based Limits on Rights Accretion in Trademark*, 116 YALE L.J. POCKET PART 352, 352–53 (2007).

order to avoid possible legal conflicts.³¹³ In effect, the proliferation of licensed markets informs consumers, treating “licensing as the norm” within society.³¹⁴ This feedback loop results in an expansion of trademark entitlements fortified by the public’s misguided perception.³¹⁵ Even though trademark users may be able to surmount a reasonable defense against infringement, risk-averse film studios and insurance companies prefer to seek a license.³¹⁶ These profit-seeking gatekeepers often determine that the “potential cost of defending a lawsuit is too high, even when discounted for the low likelihood of getting sued and the very low likelihood of paying damages.”³¹⁷ As a result, this “excessive caution” forces parties to pay unnecessary licensing fees, while potentially affecting the creative process, harming the quality of entertainment for the market consumer.³¹⁸ For example, the rights holders of Sherlock Holmes effectively threatened “the entertainment powerhouse” Warner Bros. to remove any hints of a “gay subtext regarding Holmes,” changing the final version of the film.³¹⁹ The current market deters “sinking costs into a product that may later be enjoined,” because clearing rights can be a long and arduous process that ultimately stifles creativity.³²⁰

On the other hand, promotional arrangements have further complicated the relationship between artistic endeavors and disguised commercials. Instead of paying a fee for a trademark license,

³¹³ McGeveran, *supra* note 311, at 2276.

³¹⁴ James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 *YALE L.J.* 882, 907–08 (2007).

³¹⁵ *Id.* at 908.

³¹⁶ *Id.* at 913.

³¹⁷ McGeveran, *supra* note 311, at 2276; *see also* Elizabeth Rosenblatt, *The Adventure of the Shrinking Public Domain*, 86 *U. COLO. L. REV.* 561, 613 (2015).

³¹⁸ McGeveran, *supra* note 311, at 2276; *see also* *THE INCREDIBLES* (Walt Disney Home Entertainment 2005) (director’s commentary) (noting that the writer and director of the film wanted to call a bomb-throwing French villain “Bomb Perignon,” but fear of a lawsuit from champagne maker Dom Perignon caused the creative team to change the name to “Bomb Voyage”). *But see* McGeveran, *supra* note 311, at 2277 (“On the other hand, few defendants would consider their ability to refer to particular trademarks to be central to their life’s work. Sometimes the mark, even if helpful, is not essential to the message they want to convey.”).

³¹⁹ *See* Rosenblatt, *supra* note 317, at 565, 613–14.

³²⁰ *Id.* at 619.

the mark owner pays a fee to the content creator.³²¹ These arrangements have been very successful within the entertainment industry, effectively lowering production costs and providing an additional source of film revenue.³²² As product placement is commonplace in the industry, the notion of unauthorized trademark use fails to pierce the minds of consumers. Compounding this idea, popular films often satirize product placement, utilizing “jokes that assume audience familiarity with the practice.”³²³ In addition to product placement’s penetration of popular culture, certain filmmakers even choose to blur out the trademarks of items they use in their films.³²⁴ This pixilation results in the public thought that filmmakers cannot use marks, even if the use is artistically relevant and not explicitly misleading.³²⁵ Thus, the combination of obvious product placements and glaring avoidance tactics further propels the perception that licensing is the norm.³²⁶

Furthermore, it would benefit the public to impose punitive measures against trademark bullies attempting to use courts as a weapon to silence content creators. For example, the plaintiff in the *VIRAG* decision, an Italian manufacturer, has already filed an appeal even though the district court dismissed the plaintiff’s

³²¹ Gibson, *supra* note 314, at 914.

³²² In fact, in the late 1990s, product placement generated around fifteen percent of Hollywood’s feature film revenue, and in the early 2000s, product placement helped reduce the industry’s production costs by twenty-five percent. Kim Bartel Sheehan & Aibing Guo, “Leaving on a (Branded) Jet Plane”: *An Exploration of Audience Attitudes Towards Product Assimilation in Television Content*, J. CURRENT ISSUES & RES. ADVERT. Spring 2005, at 79, 80.

³²³ Gibson, *supra* note 314, at 919.

³²⁴ See MARJORIE HEINS & TRICIA BECKLES, BRENNAN CTR. FOR JUSTICE, WILL FAIR USE SURVIVE? FREE EXPRESSION IN THE AGE OF COPYRIGHT CONTROL 21 (2005) (quoting a filmmaker for the proposition that “you see everything being blurred now, because for the first time, [we are] able to do that technically without it being a big deal”).

³²⁵ See Gibson, *supra* note 314, at 918. This result is unfortunate. While the blurring tactic could guarantee insulation from infringement lawsuits, this technique undermines the current case precedent. See *supra* Part II. Furthermore, certain filmmakers do not even consider the legal implications of blurring logos, favoring the tactic to “minimize the ‘damage’ (or distractions) to the film.” Abe Sauer, *Hollywood Marketers Face the Impossible: Blurring Product Placements in Sandler Films*, BRANDCHANNEL (Jan. 18, 2011), <http://brandchannel.com/2011/01/18/hollywood-marketers-face-the-impossible-blurring-product-placements-in-sandler-films/> [<http://perma.cc/ZP7G-FL3P>].

³²⁶ Gibson, *supra* note 314, at 919.

claims with prejudice.³²⁷ Rising legal costs could pressure Sony into settling with VIRAG rather than continuing a lengthy appeals process,³²⁸ even though the appellate court will likely rule in Sony's favor. One possible way to prevent this perverse result is to impose judicial sanctions against this borderline frivolous appeal or even force the aggressive mark holders to pay for the defendant's legal fees when the plaintiffs eventually lose.³²⁹

In order to reduce the proliferation of unnecessary licenses, courts and legislators should strive to "increase . . . the predictability and clarity of trademark fair use . . . making adjudication faster and less expensive" for content creators.³³⁰ To achieve this result, serious consideration must be given to a shift from general standards to a regime of *ex ante* rules.³³¹ Whereas standards apply "after the fact" rules could provide more guidance and further assurances to artists that fall within the defined categories.³³² The following list of categories would correctly balance public benefits in artistic expression against the economic function of trademarks.³³³

The first category would involve the unauthorized use of a well-known or culturally relevant trademark. Artists utilizing these marks should adhere to the Ninth Circuit's most recent application of the *Rogers* test.³³⁴ The defendant must merely prove that the use of the mark is artistically relevant and not explicitly misleading.³³⁵ The relevance threshold should remain substantially low, so judges

³²⁷ *VIRAG, S.R.L. v. Sony Comput. Entm't Am. LLC*, No. 3:15-CV-01729-LB, 2015 WL 5000102 (N.D. Cal. Aug. 21, 2015), *appeal docketed*, No. 16-15137 (9th Cir. Jan. 29, 2016).

³²⁸ See William T. Gallagher, *Trademark and Copyright Enforcement in the Shadow of IP Law*, 28 *SANTA CLARA COMPUTER & HIGH TECH. L.J.* 453, 496 (2012) ("[T]rademark . . . lawyers and their clients sometimes enforce admittedly weak IP claims precisely because it can be an effective strategy with few downsides . . . as enforcement targets frequently choose to capitulate or settle rather than resist claims on the legal merits . . .").

³²⁹ See Rosenblatt, *supra* note 317, at 623-24; see also Irina D. Manta, *Bearing Down on Trademark Bullies*, 22 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 853, 858-62 (2012); William McGeeveran, *Rethinking Trademark Fair Use*, 94 *IOWA L. REV.* 49, 123 (2008).

³³⁰ McGeeveran, *supra* note 311, at 2271.

³³¹ *Id.* at 2288-89. Rules would specify infringing conduct in advance, leaving factual determinations after the disputed case of infringement.

³³² *Id.* at 2286-87.

³³³ *Id.* at 2304.

³³⁴ See *supra* notes 224-43 and accompanying text.

³³⁵ See *id.*

do not have to make a determination concerning a work's artistic value.³³⁶ Additionally, only an obvious and unambiguous statement of sponsorship would render the work explicitly misleading. Finally, the courts should ignore any semblance of a referential requirement, so that defendants are not constrained in creative decisions surrounding the mark in question. An important characteristic of this suggested approach is the complete removal of a searching inquiry for the likelihood of confusion. Rather than wasting precious time and money litigating an inconsequential matter, courts should first decide any First Amendment defenses at the motion to dismiss stage of a trial.³³⁷

This suggestion would clarify the inconsistent decisions within the Ninth Circuit. The Seventh and Second Circuits would remove the likelihood of confusion analysis from their initial inquiries, leading to a more equitable position between competing parties that have unequal resources.³³⁸ Furthermore, removing the referential requirement would significantly widen creative freedom by overruling the artificial restrictions adopted by the Sixth Circuit in *Parks*.³³⁹ However, courts should only analyze the popularity of the mark itself, not the popularity of the artist utilizing the mark.³⁴⁰ While there is an obvious risk of obscure artists exploiting a

³³⁶ See Jason K. Levine, *Can the Right of Publicity Afford Free Speech? A New Right of Publicity Test for First Amendment Cases*, 27 HASTINGS COMM. & ENT. L.J. 171, 188 (2004) ("It is hard to imagine a better way to chill free speech and engender a complete lack of reliability in judicial holdings than to let judges determine on motions of law what is or is not expressive or creative.").

³³⁷ This would remedy one of the central weaknesses of the current *Rogers* test, which "allow[s] a sympathetic plaintiff . . . to go forward with her case . . . requiring the court to examine and make a determination, whether factual or legal, as to the meaning, and indirectly the merits, of the content of an artistic work." Greggs, *supra* note 254, at 1290.

³³⁸ See Joshua Beser, Comment, *False Endorsement or First Amendment? An Analysis of Celebrity and Trademark Rights and Artistic Expression*, 41 SAN DIEGO L. REV. 1787, 1791 (2004) ("While major label musicians and their record labels, such as the rap group OutKast, LaFace Records, and, ultimately, media giant Bertelsmann, have the resources to risk expensive litigation to use a celebrity's name in a title, the vast majority of potential users do not.").

³³⁹ See *supra* Section II.C.

³⁴⁰ *But see* Beser, *supra* note 338, at 1825 ("If an artist is popular, he will have less reason to use a celebrity's name or likeness for his own gain, and thus the use is more likely artistic in nature. Likewise, an unknown artist using a celebrity's name will do so to gain notoriety for his work, free-riding on the celebrity's fame.").

brand's fame, the dangers of unequal treatment among artists far outweigh these concerns.³⁴¹

The second category of uses would involve unfamiliar marks that are relatively new to the market. For these marks, it is important for the law to grant a limited window of protection to mark holders against artists that may attempt to co-opt marks through intentional or unintentional means. Many of the cases within this category would involve reverse confusion claims, similar to the *Rebellion* decision.³⁴² In order to maintain consistency without actually implementing the stringent referential requirement, unauthorized uses of unfamiliar marks must be artistically relevant, not explicitly misleading, and transformative. The relevance and misleading standards would follow the same application as the previous category. However, the court should treat these uses under the more nuanced transformative approach adopted in right of publicity cases.³⁴³ Even though the marks in these situations would be less established, unfamiliar marks, the marks remain extremely vulnerable to confusing uses that undermine the marketplace. The content creator will have free reign to use another's mark in any way that satisfies his creative urges, so long as the creator validates his use as an original expression.³⁴⁴ While this inquiry would require judges to engage in a minimal level of artistic judgment,³⁴⁵ this high barrier grants extra protection to senior mark holders that

³⁴¹ *Id.* (“Whether an artist has already gained notoriety should have no bearing on the First Amendment protection he receives.”).

³⁴² 732 F. Supp. 2d 883 (N.D. Cal. 2010).

³⁴³ *See supra* Section I.B.3.

³⁴⁴ *See e.g.*, *Medina v. Dash Films, Inc.*, No. 15-CV-2551 (KBF), 2016 WL 3906714, *4–6 (S.D.N.Y. July 14, 2016), *appeal docketed*, No. 16-2848 (2d Cir. Aug. 17, 2016). In *Medina*, a relatively unknown Latin band “Loisaidas” brought a trademark infringement lawsuit against an episodic work created by Kanye West that utilized the “Loisaidas” mark. *Id.* at *1–2. The district court dismissed the claim under the First Amendment. *Id.* at *6. In analyzing artistic relevance, the court inferred that the term was slang for Manhattan’s Lower East Side, and the use did not attempt to free ride on the band. *Id.* at *5. Thus, Kanye validated his use of the unknown mark and was free to use it in his artistic work. *Id.* at *5–6.

³⁴⁵ However, relying on judges to make these determinations can be problematic. *See Stewart Surfboards, Inc. v. Disney Book Grp., LLC*, No. CV 10–2982 GAF (SSX), 2011 WL 12877019, at *5 (C.D. Cal. May 11, 2011) (“[C]ourts are ill-equipped to make the artistic judgments as to precisely how important the use of a mark is to the message conveyed.”).

may not have attained the same notoriety of possible celebrity artists, such as Pitbull in *Rebellion*.³⁴⁶ Still, if the artist proves that the use is sufficiently transformative, the court should dismiss the claim without engaging in a prolonged analysis of likelihood of confusion.

Finally, an analysis of the current case law suggests that the *Rogers* test makes significant concessions of trademark ownership in the tarnishment realm. In the wake of controversial decisions, like *Roxbury* and *Walking Mountain*,³⁴⁷ courts should consider a new approach to allow mark holders to control the associations of their brand with morally questionable material. This Note proposes that any use of a registered mark in direct and close accompaniment to sex or drugs should receive very limited First Amendment protections.³⁴⁸ This framework would preserve the mark's integrity against associations that significantly harm the public perception of the mark, but some transformative uses would permit artists to utilize a mark for artistic expression. For example, *Any Given Sunday* could have freely utilized real NFL marks even though it tackled very adult material, because it reflected the current lifestyle within the league.³⁴⁹ Still, even a valid transformative use should bear a disclaimer explicitly denouncing any public notion of sponsorship by the mark holder. For a transformative film like *Any Given Sunday*, this requirement could demand a title credit that clearly disavows any sense of sponsorship. On the other hand, a "gross and revolting sex film" with a purely exploitative intent would not re-

³⁴⁶ See *supra* notes 208–16 and accompanying text.

³⁴⁷ See *supra* notes 195–207 and accompanying text.

³⁴⁸ See *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 388 (6th Cir. 2010) ("There have been at least eight federal cases in six jurisdictions that conclude that a famous mark is tarnished when its mark is semantically associated with a new mark that is used to sell sex-related products."); *Kraft Foods Holdings, Inc. v. Helm*, 205 F. Supp. 2d 942, 950 (N.D. Ill. 2002) ("[G]iven the graphic, sexually explicit nature of the website and the illustrations of illegal drug use, the 'VelVeeda' mark likely tarnishes Velveeta®."); Jennifer E. Rothman, Symposium, *Adult Entertainment: Sex Exceptionalism in Intellectual Property*, 23 STAN. L. & POL'Y REV. 119, 161 (2012) ("[T]rademark . . . law ha[s] disfavored works, marks and uses that depict sex or simply nudity.").

³⁴⁹ See *supra* notes 4–12 and accompanying text.

ceive any semblance of protections, adopting the remnants of the alternative avenues test.³⁵⁰

CONCLUSION

This Note's suggested approach would implement important safeguards to avoid lengthy trademark litigation. When a defendant in a trademark action pleads valid First Amendment defenses, courts must strive to completely avoid any semblance of a likelihood of confusion inquiry. The threshold analysis of artistic relevance and explicit misleadingness will function as a gatekeeper to prevent an unnecessary and lengthy factual inquiry. In essence, the earlier that judges settle these borderline frivolous claims, the more likely that transaction costs and risk of future litigation will decrease. Thus, artists will face fewer hurdles in creating content.

³⁵⁰ *Dall. Cowboys Cheerleaders, Inc., v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202-03 (2d Cir. 1979).