TWENTY YEARS OF ROGERS v. GRIMALDI: BALANCING THE LANHAM ACT WITH THE FIRST AMENDMENT RIGHTS OF CREATORS OF ARTISTIC WORKS∗

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I. INTRODUCTION

Since the U.S. Trademark (Lanham) Act was enacted in 1946,1 courts have grappled with the interplay between its restrictions against use of confusingly similar trademarks2 and the constitutional guarantee of free speech under the First Amendment.3 Fundamentally, trademarks are commercial speech, intended to identify source and to promote or sell products or services. It follows that trademark laws are intended to regulate speech that proposes a commercial transaction.4 The First Amendment permits significant regulation of commercial speech, so constitutional issues are typically not implicated in trademark

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2. The Lanham Act protects trademark owners against third-party uses of the same or similar marks that are likely to cause confusion in the mind of the public as to the source, sponsorship, or affiliation of the third-party goods or services with which the marks are used.


4. Silverman v. CBS Inc., 870 F.2d 40, 48 (2d Cir. 1989) (quoting Friedman v. Rogers, 440 U.S. 1, 11 (1979) (“[T]he use of a trademark to identify a commodity or a business ‘is a form of commercial speech and nothing more.’”)).
A court simply considers whether use of a mark is likely to cause confusion with an existing mark by applying a number of factors. The junior user’s First Amendment right to express itself freely is not generally considered, because, “Requiring a commercial speaker to choose words and labels that do not confuse or deceive protects the public and does not impair expression.”

But not all trademarks are purely commercial. Movies, television shows, video games, plays, songs, and books, while all typically sold as commercial products, are also creative works of artistic expression. It is clear, however, that the commercial nature of artistic works does not diminish the First Amendment protections that are afforded them. In the context of titles of creative works, they are considered to be hybrid in nature, combining artistic expression and commercial promotion. Because the artistic and commercial elements of titles are “inextricably

5. Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc., 425 U.S. 748, 771-72 n.24 (1976) (holding that commercial speech is “more durable” than other types of speech and as a result, “there is little likelihood of its being chilled by proper regulation”). Moreover, trademark laws were not intended to override First Amendment protections. Congress was careful not to overstep this constitutional protection when it enacted the Lanham Act in 1946, and later amendments, including those in 1989, have made clear that the Lanham Act is not intended to interfere with First Amendment rights. See 135 Cong. Rec. H1216-17 (daily ed. Apr. 13, 1989) (statements of Rep. Kastenmeier) (noting that the proposed amendments to the Lanham Act “should not be read in any way to limit political speech, consumer or editorial comment, parodies, satires, or other constitutionally protected material”).

6. In the Second Circuit, these factors are known as the Polaroid factors and include: (1) strength of the plaintiff’s mark; (2) degree of similarity between the marks; (3) the proximity of the products; (4) the likelihood that the plaintiff will bridge the gap between the two markets; (5) the existence of actual confusion; (6) the defendant’s intent in adopting the mark; (7) the quality of defendant’s product; and (8) sophistication of the purchasers. Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961). These same factors are known as the Sleekcraft factors in the Ninth Circuit. AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 347 (9th Cir. 1979). Other circuits use similar tests.

7. Silverman, 870 F.2d at 48 (citing Vidal Sassoon, Inc. v. Bristol-Myers Co., 661 F.2d 272, 276 n.8 (2d Cir. 1981)) (finding that First Amendment concerns do not justify alteration of normal standard of preliminary injunctive relief based on a Lanham Act claim involving shampoo advertisements). There is some precedent for arguing that federal trademark infringement claims are confined to unauthorized uses of marks in commercial speech. For an in-depth discussion of the cases supporting this argument, see Margreth Barrett, Domain Names, Trademarks, and the First Amendment: Searching for Meaningful Boundaries, 97 TMR 865 (2007).


9. Time, Inc. v. Hill, 385 U.S. 374, 397 (1967) (“That books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment.” (quoting Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495, 501-02 (1952))).
intertwined,” these trademarks cannot be treated as ordinary commercial-product marks, but are entitled to the full scope of First Amendment protection.10

As courts have been careful to note, 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.”11 So when trademark claims extend to noncommercial speech, a balance must be struck between trademark rights and the protections afforded by the First Amendment. Some courts have held that application of the traditional likelihood-of-confusion factors alone “generally strikes a comfortable balance” between trademark rights and the First Amendment.12 Others have found that so long as “alternative avenues of communication” are available to the artist, the First Amendment is not compromised.13 Clear guidance for balancing the interests of the trademark owner and the public in avoiding confusion about the source or sponsorship of products, on the one hand, and the defendant’s and the public’s interest in freedom of expression and the free flow of ideas, on the other, finally came in the Second Circuit’s 1989 landmark decision in Rogers v. Grimaldi,14 which was a case involving a film about fictional cabaret performers and the actress Ginger Rogers’s efforts to prevent the film from being titled Ginger and Fred.

This article discusses the Rogers v. Grimaldi decision and its impact on trademark litigation in the entertainment world in the twenty years since it was decided in 1989. In particular, it looks at the application of Rogers to titles of different types of creative works of artistic expression, such as films, television shows, books, magazines, and songs; and to elements of these works, such as fictional character names and business names appearing in the works. In doing so, it analyzes the impact of Rogers on a circuit-by-circuit basis.

10. Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989); see also Bd. of Trs. v. Fox, 492 U.S. 469, 474 (1989) (explaining that when pure speech and commercial speech are “inextricably intertwined,” the entirety must be classified as noncommercial); Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1185 (9th Cir. 2001) (holding that an article was fully protected under the First Amendment because its commercial purpose was “inextricably entwined” with its expressive elements).
12. Lamparello v. Falwell, 420 F.3d 309, 314 (4th Cir. 2005)
13. See discussion infra note 23.
14. 875 F.2d 994.
II. ROGERS v. GRIMALDI

Rogers v. Grimaldi involved a fictional film about two Italian cabaret performers who imitated the famed dancing duo Ginger Rogers and Fred Astaire, and ultimately became known as “Ginger and Fred” in Italy. The film focused on a televised reunion of the fictional duo, and was titled Ginger and Fred. Ginger Rogers sued the filmmaker, alleging, among other things, that the title violated her rights under Section 43(a) of the Lanham Act. Realizing that “overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values,” the district court cautioned that the Lanham Act must therefore be construed narrowly to avoid such a conflict.

The district court granted summary judgment to the defendant, finding that the Lanham Act did not apply to the title of a motion picture because it was a work of artistic expression. The U.S. Court of Appeals for the Second Circuit affirmed, but commented that the district court had been too broad in its interpretation of the First Amendment’s impact on the Lanham Act, concluding it would create a “nearly absolute privilege” for movie titles.

While cautioning that First Amendment concerns could not insulate titles of artistic works from all Lanham Act claims, the Second Circuit recognized that those concerns were nevertheless relevant in applying the Lanham Act to claims involving titles. It also concluded that titles require more protection than ordinary commercial products.

The Second Circuit first considered the “no alternative avenues of communication” standard, which had previously been applied by courts faced with conflicts between trademark rights and First Amendment concerns. This test is premised on the

15. Id. at 996-97.
16. Id. at 996.
17. Id. at 997. Section 43(a) of the Lanham Act creates civil liability for “[a]ny person who shall affix, apply, or annex, or use in connection with any goods or services . . . a false designation of origin, or any false description or representation . . . and shall cause such goods or services to enter into commerce . . . .” 15 U.S.C. § 1125(a).
18. Rogers, 875 F.2d at 998.
19. Id. at 997.
20. Id.
21. Id. at 997-98.
22. Id. at 994.
23. See Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 206 (2d Cir. 1979) (enjoining defendants from releasing pornographic film containing infringing
notion that just as a real-property owner may exclude a speaker from its property if other locations exist for the speaker to deliver the message, a mark owner may prohibit use of its mark so long as alternative ways exist for the artist to communicate the idea. In essence, under the “no alternative avenues” test, the First Amendment is implicated only where a title is so intimately related to the subject matter of a work that the author has no alternative means of expressing what the work is about.24

The Rogers v. Grimaldi court rejected the “no alternative avenues” test as not being sufficiently accommodating of the public’s interest in free expression.25 Although acknowledging that it had previously employed the test in Dallas Cowboys Cheerleaders, the Second Circuit distinguished that case as involving “a pornographic movie with blatantly false advertising,” and explained that the case should not be read “as generally precluding all consideration of First Amendment concerns whenever an allegedly infringing author has ‘alternative avenues of communication.’”26 Recognizing that the test was based on real-property cases, the Second Circuit noted that a landowner’s enforcement of its property rights restricts only the place where the speaker’s expression may occur, whereas a restriction based on intellectual property restricts the content of the speech.27 Instead, the Second Circuit held 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.”28 In the context of allegedly misleading titles using a celebrity’s name, the Second Circuit explained that this “balanc[ing] will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title marks because other avenues of expressing the message were available); Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397 (8th Cir. 1987), cert. denied, 488 U.S. 933 (1988) (finding defendant’s designs on T-shirts that parodied Mutual of Omaha’s logos likely to cause confusion, and rejecting defendant’s argument that the design was protectable free speech because defendant had adequate alternative avenues to communicate his message). The “no alternative avenues” test was derived from the Supreme Court’s decision finding no First Amendment right to distribute handbills in a private shopping mall. Lloyd Corp. v. Tanner, 407 U.S. 551 (1972).


25. Rogers, 875 F.2d at 994.

26. Id. at 999 n.4.

27. Id. at 999

28. Id. at 999.
explicitly misleads as to the source or the content of the work.”

Applying this balancing test, the Second Circuit found that the *Ginger and Fred* title surpassed the minimum threshold of artistic relevance to the film’s content and contained no explicit indication that Ginger Rogers endorsed the film or had a role in producing it.

In setting out this “no artistic relevance/explicitly misleading” balancing test, the Second Circuit noted in a footnote that “[t]his limiting construction would not apply to misleading titles that are confusingly similar to other titles” because “[t]he public interest in sparing consumers this type of confusion outweighs the slight public interest in permitting authors to use such titles.”

**III. ROGERS v. GRIMALDI IN THE SECOND CIRCUIT**

Although the *Rogers v. Grimaldi* footnote discussed above seemed to limit the scope of *Rogers* significantly, the Second Circuit had occasion to revisit the issue just a few months later, and it put to rest any idea that *Rogers* was not applicable in “title versus title” cases. In *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, the defendant, relying on the *Rogers* footnote, argued that *Rogers* was inapplicable in its parody case that involved the title *Spy Notes*, which was alleged to be confusingly similar to the plaintiff’s *Cliffs Notes* title. The Second Circuit disagreed, stating “that language says only that where a title is complained about because it is confusingly similar to another title, the *Rogers* rule that titles are subject to the Lanham Act’s false advertising prohibition only if explicitly misleading is inapplicable.”

The Second Circuit further noted that “the overall balancing approach of *Rogers* and its emphasis on construing the Lanham Act ‘narrowly’ when First Amendment values are involved” was applicable. Specifically, “in deciding the reach of the Lanham Act in any case where an expressive work is alleged to infringe a trademark, it is appropriate to weigh the public interest in free expression against the public interest in avoiding consumer confusion.”

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29. *Id.*
30. *Id.* at 1001-02.
31. *Id.* at 999 n.5.
32. 886 F.2d 490 (2d Cir. 1989).
33. *Id.* at 494.
34. *Id.*
35. *Id.* (citing *Rogers*, 875 F.2d at 998-99).
Rogers was not limited to cases involving celebrity names or inapplicable in cases involving competing titles, the Second Circuit unequivocally and broadly stated that “we hold that the Rogers balancing approach is generally applicable to Lanham Act claims against works of artistic expression.”

A few years later, in Twin Peaks Productions, Inc. v. Publications International, Ltd., the Second Circuit once again had an opportunity to hone its Rogers v. Grimaldi balancing test. In deciding whether the plaintiff’s rights in the title Twin Peaks for a fictional television series were violated by publication of an unauthorized book about the series titled Welcome to Twin Peaks: A Complete Guide to Who’s Who and What’s What, the Second Circuit found “little question” that the title had artistic relevance to the book about the television series. The issue then was whether the title was explicitly misleading in that it might induce members of the public to believe the book was prepared by or otherwise authorized by the plaintiff.

To determine whether a title was explicitly misleading, the Second Circuit believed that it must first assess the likelihood of confusion using the traditional Polaroid likelihood-of-confusion factors. If the Polaroid factors weigh in favor of likelihood of confusion, though, the likelihood of confusion must be “particularly compelling” to outweigh First Amendment interests. Because the district court had failed even to consider the Polaroid factors, the Second Circuit remanded the case to the district court. Before doing so, however, the Second Circuit noted a “special consideration” that might be relevant in balancing these particular First Amendment and Lanham Act rights. Specifically, the title of the defendant’s book and the appearance of the cover used other elements from the plaintiff’s television series, which the Second Circuit believed posed “a fair question whether a title that might otherwise be permissible under Rogers violates the Lanham Act when displayed in a manner that conjures up a visual image

36. Id. at 495.
37. 996 F.2d 1366 (2d Cir. 1993).
38. Id. at 1379.
39. Id.
40. Id. See discussion of Polaroid supra note 6.
41. Twin Peaks, 996 F.2d at 1379.
42. Id.
43. Id. at 1379-80.
prominently associated with the work bearing the mark that was copied.\textsuperscript{44}

In 2007, a U.S. district court within the Second Circuit applied Rogers in a case involving competing titles of television programs. In Lemme v. NBC, the district court considered whether NBC’s use of the title American Dreams for a fictional drama set in the 1960s infringed the plaintiff’s rights in the trademark American Dream used as the title of a cable interview show chronicling success stories of immigrants who have “made it big.”\textsuperscript{45} Finding NBC’s title artistically relevant, the district court then turned to an analysis of the Polaroid factors as the first step in determining whether the defendant’s title was explicitly misleading as to the source or content of the show it identified. The district court found that the prominent display of the NBC name with American Dreams and the fact that the plaintiff’s name (Ingrid Lemme) appeared on screen with her show title,\textsuperscript{46} combined with the national distribution of the defendant’s show and the local cable distribution of the plaintiff’s show,\textsuperscript{47} and the inherently weak nature of the marks,\textsuperscript{48} led to the conclusion that “[n]o rational trier of fact could find for [p]laintiff” on the issue of likelihood of confusion.\textsuperscript{49} Moreover, the district court noted, “This is especially so in this case where the finding of likelihood of confusion must be ‘particularly compelling’ to outweigh NBC’s significant First Amendment interest in the title of its program.”\textsuperscript{50} The district court thus granted NBC’s motion for summary judgment.

Most recently within the Second Circuit in Syler v. Woodruff the district court denied an author’s motion for a preliminary injunction to bar another author’s use of “Perfectly Imperfect” in the book title Perfectly Imperfect: A Life in Progress.\textsuperscript{51} The plaintiff had used the title Good Enough Mother: The Perfectly Imperfect Book of Parenting and had registered the mark PERFECTLY

\textsuperscript{44} Id. at 1380. Specifically, the book title used the phrase “Welcome to” preceding “Twin Peaks,” copying the “Welcome to Twin Peaks” legend that appeared on a roadside sign in the introduction sequence of each televised episode; also, the book title was displayed on a background that appears to be a wooden slab, which evoked the wooden roadside sign depicted in the show. Id. at 1379-80.

\textsuperscript{45} 472 F. Supp. 2d 433, 438 (E.D.N.Y. 2007).

\textsuperscript{46} Id. at 448.

\textsuperscript{47} Id. at 449.

\textsuperscript{48} Id. at 447-48.

\textsuperscript{49} Id. at 452.

\textsuperscript{50} Id.

\textsuperscript{51} 2009 WL 1119370 (S.D.N.Y. Apr. 23, 2009).
IMPERFECT for various goods, including a series of books. Both books were autobiographical accounts of women who were trying to balance work and family. The district court denied injunctive relief primarily because it found that the plaintiff had failed to establish that her book title had acquired a secondary source-identifying meaning (i.e., the title was not protectable as a trademark). The district court noted that even if the plaintiff's title had acquired a secondary meaning, it did not believe that the plaintiff had established that she was likely to prevail on the merits under Rogers v. Grimaldi and its requirement that any likelihood of confusion be “particularly compelling.”

IV. ROGERS v. GRIMALDI IN THE NINTH CIRCUIT

Perhaps no circuit finds itself considering the First Amendment implications of Lanham Act claims more often than the U.S. Court of Appeals for the Ninth Circuit, which is home to Hollywood, California, and the U.S. entertainment industry. The U.S. District Court for the Central District of California has been the most common forum for such cases, and in New Kids on the Block v. News America Publishing, Inc., just one year after Rogers was decided, it had its first of many occasions to consider the Rogers v. Grimaldi test.

In New Kids on the Block, the singing group New Kids on the Block alleged that the defendant newspapers' use of its NEW KIDS ON THE BLOCK trademark in a survey that was polling readers on the “hottest pop music groups” through a 900 number violated its trademark rights and diluted its trademark. Recognizing that Rogers concerned “First Amendment values in the context of artistic expression,” the district court held that “the First Amendment plays the same central role regarding news gathering and dissemination,” and the district court granted the defendants’ motion for summary judgment. On appeal, the Ninth Circuit held that the defendants had used the trademark to identify the plaintiff’s goods or services (the musical group itself) for the ultimate purpose of identifying the defendants’ own goods and services (the telephone polls). Because the defendants’

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52. Id. at *2.
53. Id. at *7-9.
54. 745 F. Supp. 1540 (C.D. Cal. 1990), aff’d, 971 F.2d 302 (9th Cir. 1992).
55. Id. at 1542.
56. Id. at 1544.
57. New Kids, 971 F.2d at 306-09.
“nominative use” of the trademark did not function as a source indicator or constitute unfair competition, such use was a “fair” use and was “outside the strictures of trademark law.” The Ninth Circuit affirmed the district court’s ruling, but did not mention Rogers v. Grimaldi.

In Titan Sports, Inc. v. 3-G Productions, at issue were the defendant’s videotapes that were displaying the plaintiff’s marks and images of its professional wrestlers. The videos were of wrestling matches that occurred before the videotaped wrestlers had signed contracts with the plaintiff, but which contained current pictures of the wrestlers. Applying Rogers v. Grimaldi, the U.S. District Court for Central District of California found that although the titles Hulk Hogan and Randy “Macho Man” Savage had clear artistic relevance to the videos featuring those named wrestlers, the titles and the images portrayed on the video boxes were explicitly misleading as to the actual content of the videos because the videos displayed current pictures of the wrestlers, as opposed to pictures taken of them at the time when the older videotaped matches took place. Accordingly, the interest in avoiding consumer confusion outweighed the public interest in free expression.

Next, in Morgan Creek Productions, Inc. v. Capital Cities/ABC, Inc., the U.S. District Court for the Central District of California considered whether the title Young Riders for a television series infringed rights in the title Young Guns for a film with a similar subject matter. Although the Court had previously adopted the Rogers v. Grimaldi test in both New Kids on the Block and Titan Sports, it believed that Rogers did not apply where the allegation was that “one artistic title was confusingly similar to another.” Rather, according to the district court, Rogers was confined to “the context of allegedly misleading titles using a celebrity’s name,” and it denied the defendants’ motion for

58. Id. at 308. To establish a nominative fair-use defense, a commercial user must establish the following three requirements: (1) the product or service must be one not readily identifiable without use of the trademark; (2) only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and (3) the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.
60. Id. at 1868.
61. Id.
63. Id. at 1884.
summary judgment. The district court failed to mention the Second Circuit’s later clarification of the Rogers footnote in the 1989 Cliffs Notes case.

In 1995, in No Fear, Inc. v. Image Films, Inc., the U.S. District Court for the Central District of California considered whether the title No Fear for a film infringed the plaintiff’s rights in the trademark NO FEAR for clothing. Believing that Rogers v. Grimaldi was, by its own terms, limited to cases involving the use of a celebrity’s name in a movie title, the district court nevertheless recognized that later decisions had expanded the scope of Rogers to include many other areas of expressive conduct. “In so doing, the Second Circuit has effectively supplemented the Rogers test by applying the standard likelihood of confusion factors.” After a detailed consideration of the post-Rogers cases, and after recognizing that there was “substantial confusion in the case law about the precise role of the likelihood of confusion factors in the application of the rule articulated in Rogers,” the district court adopted the standard for determining whether a use is “explicitly misleading” that was set forth in Twin Peaks—first making a threshold determination of likely confusion, and second, determining whether the likelihood of confusion is particularly compelling.

Despite this seeming clarification, the waters were muddied in 1998 in Films of Distinction, Inc. v. Allegro Film Productions, Inc. The plaintiff claimed that the defendant’s use of the fictional TV channel trade name THE CRIME CHANNEL in a movie infringed the plaintiff’s trademark THE CRIME CHANNEL for an actual television network. In denying the defendant’s motion to dismiss the trademark claims on First Amendment grounds, the U.S. District Court for the Central District of California stated that “it appears the Ninth Circuit will not adopt the Second Circuit Rogers/Twin Peaks test balancing trademark protections against the artistic interest in protecting literary titles.”

64. Id.
67. Id. at 1382-84.
68. Id. at 1382.
69. Id. at 1383-84.
70. 12 F. Supp. 2d 1068 (C.D. Cal. 1998).
71. Id. at 1078.
Finally, in 2002, the U.S. Court of Appeals for the Ninth Circuit weighed in. In *Mattel, Inc. v. MCA Records, Inc.* 72 the Ninth Circuit considered whether the defendant’s song title “Barbie Girl” infringed the plaintiff’s BARBIE trademark.73 In finding that it did not, the Ninth Circuit expressly adopted the Second Circuit’s test in *Rogers v. Grimaldi*, stating, “We agree with the Second Circuit’s analysis and adopt the Rogers standard as our own.” 74 Finding that the song title did not explicitly mislead consumers as to the source of the work because it did not suggest that it was produced by the defendant, the Ninth Circuit noted, “The only indication that Mattel might be associated with the song is the use of Barbie in the title; if this were enough to satisfy this prong of the Rogers test, it would render Rogers a nullity.” 75

In granting summary judgment to the defendant in *Mattel*, the U.S. District Court for the Central District of California had recognized that the “Ninth Circuit has not specifically adopted the ‘particularly compelling’ language used by the Second Circuit” in *Twin Peaks*, but it noted that the test had been adopted by a California U.S. district court in *No Fear*. 76 Apparently believing that the Ninth Circuit would also adopt this approach, the district court undertook an analysis of the likelihood-of-confusion factors, ultimately finding that the song was a parody and confusion was not likely. Although the Ninth Circuit affirmed the district court’s ruling, the Ninth Circuit strictly applied the test set forth in *Rogers*, without mention of *Twin Peaks* or its expansion of the Rogers test, or any analysis of the likelihood-of-confusion factors.

In 2008, the Ninth Circuit applied *Rogers v. Grimaldi* to a case involving an element other than a title in a creative work. In *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, the plaintiff owner of the PLAY PEN trademark and associated trade dress for a strip club sued the defendant over its use of the trademark and trade dress for a fictional PIG PEN strip club in

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73. *Id.* at 898-99.
74. *Id.* at 902.
75. *Id.* The Ninth Circuit noted that consumers expect a title to describe the underlying work, not to identify the producer, so when an artistic work incorporates a trademark and titles the work accordingly, there is little risk that consumers will believe the mark owner sponsored or endorsed the work. *Id.*
the Grand Theft Auto video game. As an initial matter, the Ninth Circuit noted that “although [Rogers v. Grimaldi] 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.”

The Ninth Circuit then rejected the plaintiff’s argument that the PIG PEN mark had no artistic relevance because the game was not “about” the strip club. The court stressed that the First Amendment applies to marks except those with absolutely no artistic relevance to the underlying work whatsoever. “In other words,” the Ninth Circuit stated, “the level of relevance merely must be above zero.” Because the defendant’s artistic goal was to develop a cartoon-style parody of East Los Angeles, where the plaintiff’s club was located, it was reasonable for the defendant to re-create a critical mass of the businesses and buildings that constitute the area.

The Ninth Circuit then considered whether the defendant’s use of the mark PIG PEN explicitly misled consumers about the source or content of the work. The relevant question here, the Ninth Circuit believed, was “whether the Game would confuse its players into thinking that the Play Pen is somehow behind the Pig Pen or that it sponsors [the video game].” Noting that the real strip club and the video game had nothing in common other than that both were “a form of low-brow entertainment,” the Ninth Circuit found nothing to indicate that the public reasonably would believe that the plaintiff had produced the video game or that defendant operated a strip club. As in Mattel, the Ninth Circuit did not mention Twin Peaks, or engage in an analysis of the traditional likelihood-of-confusion factors.

77. 547 F.3d 1095 (9th Cir. 2008).
78. Id. at 1099. For a more detailed discussion of the justification for application of the Rogers balancing test to elements within an artistic work, see Pratheepan Gulasekaram, Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works, 80 Wash. L. Rev. 887, 921 (2005) (arguing that unauthorized trademark uses within the body of an expressive work—but not in the title, cover, or advertisement for the work—reduces the risk that defendant is trying to free-ride on the plaintiff’s commercial reputation or capitalize on an unbargained-for commercial advantage).
79. Id. at 1100.
80. Id.
81. Id.
82. Id.
83. Id.
Most recently, in *Roxbury Entertainment v. Penthouse Media Group Inc.*, the Central District of California granted summary judgment to the defendant, finding that the First Amendment was a complete defense to the plaintiff’s Lanham Act claims. The plaintiff was the owner of the mark ROUTE 66 for television programs and related entertainment properties, including the original 1960’s “Route 66” television program about two young men travelling across America. When the defendant began selling a pornographic DVD entitled “Route 66,” the plaintiff alleged that the title infringed and diluted its trademark rights. The defendant moved for summary judgment, arguing that its use of “Route 66” as the title of its film was fully protected under the First Amendment. The court agreed. Citing *Rogers v. Grimaldi*, and the Ninth Circuit’s application of the *Rogers* test in *E.S.S. Entertainment*, the court first found that the title was artistically relevant to the defendant’s film because of the film’s setting in part in a roadside motel and the association of “Route 66” with cross-country travel. Under the “above zero” standard for artistic relevance set forth in *E.S.S. Entertainment*, the court found the fact that the “association is tenuous does not controvert Defendant’s showing.”

The Central District of California then turned to whether the defendant’s use of “Route 66” in its film title was explicitly misleading as to source or sponsorship. Finding nothing to indicate any risk of “duping” consumers into thinking they were buying a DVD in any way affiliated with the plaintiff or the 1960’s television series, the court concluded that the First Amendment was a complete defense to the plaintiff’s claims. As in *Mattel* and *E.S.S. Entertainment*, the court did not even mention or consider the likelihood-of-confusion factors.

**V. ROGERS v. GRIMALDI IN OTHER CIRCUITS**

Although the Second and Ninth Circuits have been the most common venues for disputes involving entertainment properties, other courts have also considered the interplay between trademark rights and the First Amendment. The *Rogers v. Grimaldi* test has been explicitly adopted by the U.S. Courts of Appeal for the Third, Fifth, and Sixth Circuits, and by U.S. district courts within the

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85. *Id.* at 1763.
86. *Id.*
87. *Id.* at 1764.
U.S. Courts of Appeal for the Seventh and Eleventh Circuits. It has not been explicitly rejected by any courts. A summary of the most significant cases, by circuit, is provided below.

A. The Third Circuit

In Seale v. Gramercy Pictures, the plaintiff was a founding member of the activist Black Panthers group and he sued a film company for using his name and likeness in a docudrama film, a pictorial history book, a video release of the film, and a CD soundtrack of songs from the film. The Third Circuit, citing Rogers v. Grimaldi, noted that First Amendment concerns were implicated, and it granted the defendant's motion for a summary judgment on the plaintiff's Lanham Act-based claims related to the film and the book. The Third Circuit held that the defendant's use of the plaintiff's name and likeness in connection with the film and the book was not actionable on the ground that the First Amendment guarantee of freedom of expression outweighs any potential risk that the use might implicitly suggest that the plaintiff endorsed the film. Because the CD was merely a collection of songs performed by different artists, with no direct connection to the plaintiff or to the history of the Black Panther Party, the Third Circuit found there was a genuine issue of material fact about whether the use of the plaintiff's name and likeness on the CD cover was clearly related to the content of the film, or whether it was instead a disguised advertisement for the CD.

More recently, the Third Circuit considered whether Rogers v. Grimaldi should be applied beyond the titles of creative works, but ultimately did not reach the question, for it found the First Amendment inapplicable to what it deemed to be purely commercial speech. In Facenda v. NFL Films, Inc., the Third Circuit considered whether use of a famed sports commentator's voice as part of a television program entitled The Making of

88. See discussion of Dairy Queen infra note 116.
90. Id. at 336-38.
91. Id. at 337-38.
92. Id. at 340 (citing Rogers, 875 F.2d at 999-1000).
93. For another case holding that a purported artistic work was actually commercial speech, see Pam Media, Inc. v. Am. Research Corp., 889 F. Supp. 1403 (D. Colo. 1995) (finding a talk radio show featuring "spontaneity and free flow of colloquy" very different from works with established form and content).
Madden NFL 06 was the type of artistic expression protected under Rogers. Because the Third Circuit found that the program was more akin to an infomercial than a documentary—focusing only on this particular video game, praising its merits, and offering a countdown to when it would be released—the Third Circuit determined that the program was commercial speech that was less protected by the First Amendment. In the words of the court,

Unlike the film title in Rogers [or] the books in Cliffs Notes, . . . the work accused of trademark infringement in our case aims to promote another creative work, the video game. Even if Rogers should apply beyond titles . . . , we decline to apply it here in a context with that additional degree of separation.

Thus, the Third Circuit concluded, “we need not reach the issue whether our Court will adopt the Rogers test” as applied to an element within a creative work.

The Facenda case highlights the fine line often existing between commercial and noncommercial speech. The law remains that works combining artistic elements and a commercial purpose are considered noncommercial speech. Modern commercial trends in the entertainment industry, such as the production of the type of infomercial at issue in Facenda, paid product placements in films, and short “public-service announcement” clips produced by commercial entities that include a company’s products, are in fact thinly veiled advertisements and give rise to the issue of what actions may be found sufficient by the courts to transform artistic works into commercial speech, thereby stripping them of constitutional protection. As Judge Kozinski of the Ninth Circuit has aptly noted, “In our pop culture, where salesmanship must be entertaining and entertainment must sell, the line between the

94. 542 F.3d 1007 (3d Cir. 2008).
95. Id. at 1017 (citing Bolger v. Youngs Drug Prods. Corp., 463 U.S. 60, 66-67 (1983)) (quoting U.S. Healthcare, Inc. v. Blue Cross of Greater Phila., 898 F.2d 914, 933 (3d Cir. 1990)) (noting the three factors for deciding whether speech is commercial are: (1) is the speech an advertisement; (2) does the speech refer to a specific product or service; and (3) does the speaker have an economic motivation for the speech).
96. Id. at 1018. The Facenda case predates the Ninth Circuit’s recent decision in E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc. (547 F.3d 1095 (9th Cir. 2008)), holding that there is no reason why the principles of Rogers should not also apply to the use of a trademark in the body of the work.
97. Id.
98. See Bd. of Trs., 492 U.S. at 474.
commercial and noncommercial has not merely blurred; it has disappeared."

**B. The Fifth Circuit**

In a case involving competing book titles, the Fifth Circuit declined to make the factual findings necessary to determine whether the plaintiff’s SUGARBUSTERS book title had acquired a secondary source-identifying meaning. In *Sugar Busters LLC v. Brennan*, the Fifth Circuit vacated a preliminary injunction and remanded the case to the district court for such a determination. At issue was whether the defendants’ book title *Sugar Bust for Life!* infringed the plaintiff’s federally registered trademark SUGARBUSTERS for books. Although not reaching any conclusions on the merits, the Fifth Circuit, citing *Twin Peaks*, noted, “Any finding that defendants’ book title is likely to cause confusion with plaintiff’s book title must be ‘particularly compelling’ to outweigh defendants’ First Amendment interest in choosing an appropriate book title for their work.”

In *Westchester Media v. PRL USA Holdings, Inc.*, the plaintiff sought a declaratory judgment that its use of POLO for a magazine title did not infringe the defendant’s (Ralph Lauren) POLO trademark. The defendants counterclaimed for trademark infringement and dilution, and the U.S. district court found for the defendants. Citing *Rogers v. Grimaldi*, the Fifth Circuit noted that the infringement claim “implicates the First Amendment right to choose an appropriate title for literary works,” and “thus involves the tension between the protection afforded by the Lanham Act to trademark owners and the protection afforded by the First Amendment to expressive activity.” Finding no clear error in the

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99. White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1520 (9th Cir. 1993) (dissenting from denial of rehearing en banc); see also Kasky v. Nike, Inc., 45 P.3d 243, 279 (Cal. 2002) (Brown, J., dissenting) (“In today’s world, the difference between commercial and noncommercial speech is not black and white. Due to the growing politicization of commercial matters and increased sophistication of advertising campaigns, the intersection between commercial and noncommercial speech has become larger and larger. As this gray area expands, continued adherence to the dichotomous, all-or-nothing approach developed by the United States Supreme Court will eventually lead us down one of two unappealing paths; either the voices of businesses in the public debate will be effectively silenced, or businesses will be able to dupe consumers with impunity.”). See also Gulasekaram, *supra* note 77, at 931-40.

100. Sugar Busters LLC v. Brennan, 177 F.3d 258, 270 (5th Cir. 1999).

101. *Id.* at 269 n.7.

102. 214 F.3d 658 (5th Cir. 2000).

103. *Id.* at 664.
district court’s analysis of the Fifth Circuit’s likelihood-of-confusion factors, the Fifth Circuit affirmed, noting that the district court’s finding that the likelihood of confusion was particularly compelling was supported by the record, because the magazine and the defendants’ products targeted the same consumers, used the same retail outlets, and could plausibly lead consumers to believe the parties were associated.\textsuperscript{104} Moreover, there was actual confusion and evidence that the plaintiffs had intended to trade on the defendants’ goodwill and reputation.\textsuperscript{105}

\textbf{C. The Sixth Circuit}

The Sixth Circuit considered the applicability of \textit{Rogers v. Grimaldi} in a case involving the musical group Outkast and the famed civil-rights activist Rosa Parks. In \textit{Parks v. LaFace Records}, Outkast selected “Rosa Parks” as the title of one of its songs.\textsuperscript{106} The Sixth Circuit applied \textit{Rogers}, finding it “the most appropriate method to balance the public interest in avoiding consumer confusion with the public interest in free expression.”\textsuperscript{107} Specifically, the Sixth Circuit held that there was a genuine issue of fact as to whether the song title was artistically relevant to the song because the song (unlike the “Barbie Girl” song) did not directly reference Ms. Parks, but rather only contained the phrase “move to the back of the bus,” which was associated with Ms. Parks and her famous civil-rights activities.\textsuperscript{108} Accordingly, the Sixth Circuit reversed the grant of summary judgment for the defendants on the Lanham Act claim, and remanded the case to the U.S. district court.\textsuperscript{109}

In \textit{ETW Corp. v. Jireh Publishing, Inc.}, the Sixth Circuit extended \textit{Rogers} beyond titles.\textsuperscript{110} In that case, golfer Tiger Woods claimed that an artist’s rendering of his victory at the U.S. Masters golf tournament and the listing of his name on the back of the print constituted trademark infringement and false endorsement, and violated his right of publicity.\textsuperscript{111} Agreeing that the Lanham Act should be applied to artistic works only where the

\begin{itemize}
\item[104.] \textit{Id.} at 667.
\item[105.] \textit{Id.}
\item[106.] 329 F.3d 437 (6th Cir. 2003).
\item[107.] \textit{Id.} at 450.
\item[108.] \textit{Id.} at 452-54.
\item[109.] There is no reported subsequent history for this case.
\item[110.] 332 F.3d 915 (6th Cir. 2003).
\item[111.] \textit{Id.} at 918-19.
\end{itemize}
public interest in avoiding confusion outweighs the public interest in free expression, the Sixth Circuit noted, “The Rogers test is helpful in striking that balance in the instant case.” The Sixth Circuit concluded that the presence of Woods’s image in the painting had artistic relevance to the underlying work and did not explicitly mislead the public as to the source of the work.

**D. The Seventh Circuit**

The Seventh Circuit has not yet had occasion to consider *Rogers v. Grimaldi*, but the U.S. District Courts for the Northern District of Illinois and for the Southern District of Indiana have done so. Although ultimately finding the balance of harms sufficient to grant injunctive relief, the U.S. District Court for the Northern District of Illinois in *Ty, Inc. v. Publications International, Ltd.*, cited Rogers as “[t]he law” regarding titles, noting that in title cases, “use of the trademark does not imply sponsorship or endorsement by the trademark holder.”

In *Woodard v. Jackson*, members of a band called Ripples and Waves sued Michael Jackson for falsely representing that his band, The Jackson Five, had formerly been known as Ripples and Waves. The plaintiffs alleged that Jackson had purposefully advanced the rumor, which appeared in a 1991 biography of Jackson, in liner notes from some albums, in the biographical reference to the group in the Rock & Roll Hall of Fame, and in the title of a compilation CD released in 2000 entitled *Ripples and Waves—An Introduction to The Jackson Five*. In granting Jackson’s motion to dismiss the Lanham Act claims, the U.S. District Court for the Southern District of Indiana, citing Rogers, held that “with respect to titles of artistic works, the title must be explicitly misleading and devoid of any artistic relevance to the work for the Lanham Act to bar its use.” Noting that the Second Circuit had held as a matter of law that the film entitled *Ginger and Fred* did not violate Ginger Rogers’s rights, the district court found “that [the same] reasoning applies to the CD [title] here.”

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112. *Id.* at 936-37.
113. *Id.*
114. 81 F. Supp. 2d 899, 906 (N.D. Ill. 2000). This case involved a claim that defendants’ books about plaintiff’s BEANIE BABIES plush toys, which included the BEANIE BABIES mark and logo, were likely to cause confusion.
116. *Id.* at *24-25.
117. *Id.* at *25.
E. The Eighth Circuit

Although the interplay of trademark law and the First Amendment has been addressed several times by the Eighth Circuit, it has neither expressly accepted nor rejected the Rogers v. Grimaldi test.

In Mutual of Omaha Ins. Co. v. Novak, a pre-Rogers case involving a parody, the Eighth Circuit focused on the “alternative avenues of communication” test as a means for balancing First Amendment and trademark rights.\(^\text{118}\) In Anheuser-Busch, Inc. v. Balducci Publ’ns, a post-Rogers case that also involved parody, however, the Eighth Circuit cited the Second Circuit’s Cliffs Notes decision for the proposition that the public interest in free expression must be weighed against the public interest in avoiding consumer confusion.\(^\text{119}\) Specifically, the Eighth Circuit found that the district court had erred in finding no likelihood of confusion between a purported parody and the original, because in an effort to satisfy the First Amendment, it incorrectly weighted its analysis of the likelihood-of-confusion factors. “We believe the better course [of action] would have been to analyze the likelihood of confusion first and then proceed to an analysis of the First Amendment issues.”\(^\text{120}\)

At issue in Anheuser-Busch was a purported ad parody for MICHELOB OILY beer that appeared in a humor magazine. The ad featured Anheuser-Busch’s MICHELOB mark and its Blue Ribbon logo. Finding that the likelihood-of-confusion factors favored the plaintiff, the Eighth Circuit concluded that under the specific facts in the case, where the defendant could have altered the marks and conveyed its message with substantially less risk of

\(^{118}\) 836 F.2d at 402. Although the court relied on the “no alternative avenues” analysis in affirming a finding of infringement, it appeared to rely in part on the fact that the defendant was placing his message on commercial products such as T-shirts and mugs rather than in more traditional media. The court expressly stated that finding for the plaintiff would infringe upon the plaintiff’s First Amendment rights if the defendant had presented its editorial parody in a book, magazine, or film. \textit{Id.} at 398. Other cases that have employed the “no alternative avenues” test have similarly involved use of a third-party mark on commercial products rather than editorial parody or competing titles of creative works. See, \textit{e.g.}, MGM-Pathe Commc’ns Co. v. Pink Panther Patrol, 774 F. Supp. 869 (S.D.N.Y. 1991) (prohibiting use of PINK PANTHER PATROL for gay-activist clothing); Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc., 642 F. Supp. 1031 (N.D. Ga. 1986) (enjoining use of the mark GARBAGE PAIL KIDS for stickers and children’s books that spoofed CABBAGE PATCH KIDS); Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183 (E.D.N.Y. 1972) (enjoining use on T-shirts of ENJOY COCAINE in a logo similar to the distinctive COCA-COLA logo).

\(^{119}\) 28 F.3d 769 (8th Cir. 1994).

\(^{120}\) \textit{Id.} at 775 (emphasis added).
confusion, the public interest in avoiding consumer confusion outweighed the public interest in protecting the defendants’ freedom of expression. It did not, however, mention Rogers v. Grimaldi or its artistically relevant/explicitly misleading balancing test.

American Dairy Queen Corp. v. New Line Productions, Inc., a later decision by a district court within the Eighth Circuit that involved the title of a creative work, did little to clarify the law. The defendant produced and was preparing to release a film entitled Dairy Queens, which was described as a mock documentary satirizing beauty contests in rural Minnesota. The plaintiff was the franchisor of the DAIRY QUEEN ice-cream chain and objected on trademark infringement and dilution grounds to the use of its DAIRY QUEEN trademark as the film’s title. The district court found that the likelihood-of-confusion factors weighed in favor of the plaintiff, and it then turned to a consideration of whether the defendant’s First Amendment interests were sufficient to outweigh the plaintiff’s trademark interests in its DAIRY QUEEN trademark. Though citing the Second Circuit’s Cliffs Notes decision, the district court ultimately found that because other alternative avenues of communication were available, (i.e., Dairy Princesses or Milk Maids were apt titles), “the balance between the public’s interest in free expression and its interest in avoiding consumer confusion and trademark dilution tilts in favor of avoiding confusion and dilution.” In doing so, the district court was careful to distinguish Rogers v. Grimaldi rather than to reject it. Specifically, the Eighth Circuit characterized Rogers as involving a title that directly referred to the content of the film—performers known as Ginger and Fred—whereas the title of the defendant’s film at issue about beauty pageants in Minnesota lacked such a direct connection. Interestingly, the district court also considered “the somewhat lesser protection afforded commercial speech” in finding for the plaintiff, suggesting that the commercial nature of the film was somehow relevant to the analysis.

121. Id.
123. Id. at 729.
124. Id. at 732.
125. Id. at 735.
126. Id. at 734-35.
127. Id. at 735.
The district court’s Dairy Queen decision has been widely criticized. The flaws in the Eighth Circuit’s reasoning have been thoroughly discussed by many commentators, including the use of a test that analogizes trademark rights to real-property rights, the idea that an artist’s First Amendment rights are not compromised so long as any alternative artistic expression is available, the failure to recognize the cultural implications and metaphorical meaning of some trademarks, and the ultimate weighing of corporate interests against public interests. No subsequent case has cited the Dairy Queen decision with approval.

Although the holding in Dairy Queen ostensibly was made under the “no alternative avenues” theory, the Eighth Circuit appears also to have based its decision on its subjective finding that the film title was not artistically relevant to the film because the film was not about the ice-cream chain. This finding misses the fact that the title was selected because of the reference to the restaurant, and disregards the creator’s First Amendment right to use another’s trademark as a means of creative cultural commentary. As the Second Circuit noted in Rogers v. Grimaldi, it is precisely because “[t]he subtleties of a title can enrich a reader’s or a viewer’s understanding of a work . . . [and because] the expressive element of titles requires more protection than the labeling of ordinary commercial products.” This distinction—between use of a trademark simply to identify and sell a product and use of a trademark as an understandable metaphor for social


130. Dairy Queen, 35 F. Supp. 2d at 734.

131. Timbers & Huston, supra note 122, at 1296; Gulasekaram, supra note 77, at 911 n.137 (“[A]s with most cultural commentary, there will often be ‘alternative avenues’ that could have been used for expression, rendering such a restrictive test wholly antithetical to First Amendment concerns.”); Denicola, supra note 123, at 195-96 (“[F]amous trademarks offer a particularly powerful means of conjuring up the image of their owners, and thus become an important, perhaps at times indispensable part of the public vocabulary. Rules restricting the use of well-known trademarks may therefore restrict the communication of ideas.”).

132. 875 F.2d at 997-98.
commentary—appears to have been lost on the Eighth Circuit in *Dairy Queen*.

**F. The Tenth Circuit**

Although the Tenth Circuit has not decided a case balancing trademark rights and the First Amendment, it has approved principles of *Rogers v. Grimaldi* in an arguably similar context.\(^{133}\) In a right-of-publicity case involving use of the names of Major League Baseball players on parody-style trading cards, the Tenth Circuit, citing *Rogers*, noted that “in the context of intellectual property, [the] ‘no adequate alternative avenues’ test does not sufficiently accommodate the public’s interest in free expression.”\(^{134}\) The Tenth Circuit then concluded that the plaintiff’s First Amendment right to free expression outweighed the defendant’s proprietary right of publicity, and the Tenth Circuit affirmed the district court’s ruling in favor of the plaintiff.\(^{135}\)

**G. The Eleventh Circuit**

While the Eleventh Circuit also has not yet had occasion to consider the tension between trademark law and the First Amendment, the U.S. District Court for the Southern District of Florida confronted the issue in *Club Méditerranée v. Fox Searchlight Pictures*.\(^{136}\) The district court rebuffed the efforts of the owners of the trademark CLUB MED for resort services to preliminarily enjoin use of CLUB DREAD for the title of a comedy/horror film about a serial killer at a swanky hedonistic island paradise for swingers.\(^{137}\) Expressly adopting *Rogers v. Grimaldi*, the district court noted that the issues before it were whether the title had artistic relevance to the film and whether the title explicitly misled as to the source of the work, after a consideration of the *Polaroid* factors.\(^{138}\) Specifically, the district court found that in comparing the parties’ services, all-inclusive vacations were very dissimilar to motion pictures.\(^{139}\) After

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134. *Id.* at 971.
135. *Id.* at 976.
137. *Id.* at *1-3.
138. *Id.* at *7.
139. *Id.* at *9.
analyzing all of the Polaroid factors, the district court found that the likelihood of confusion was very low, that the title had clear artistic relevance to the movie, and that there was nothing explicitly misleading about it.\textsuperscript{140}

\textbf{VI. THE FUTURE OF ROGERS \textit{v.} GRIMALDI}

Rightly rejecting an absolute First Amendment privilege for titles or elements of creative works, in Rogers \textit{v.} Grimaldi the Second Circuit noted, “Poetic license is not without limits” and “[t]he purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product.”\textsuperscript{141} Nevertheless, the Second Circuit recognized that the First Amendment must be part of any analysis of infringement claims involving creative works, because the artistic and the commercial elements are “inextricably intertwined.”\textsuperscript{142} Because consumers of creative works have a dual interest in enjoying the results of an artist’s freedom of expression while not being misled, the expressive elements of titles and other elements of creative works require more protection than ordinary commercial products. So the Rogers balancing test was born.

In the twenty years since Rogers \textit{v.} Grimaldi was decided, U.S. courts have struggled with defining—and refining—the test for balancing trademark rights with First Amendment rights in cases involving creative works. It appears that the Rogers test has become the standard for these types of disputes, by supplanting the “no alternative avenues” test previously used by some courts. It is also clear that Rogers, which was limited to rights in a celebrity’s name and was made expressly inapplicable to cases involving disputes between titles, has been significantly broadened in subsequent cases, and is now being applied by U.S. courts to claims involving any element of artistic expression.

Under the modern-day Rogers test, a U.S. court will first determine whether the title or mark has artistic relevance to the underlying work. Recent case law suggests that the threshold for such a finding is very low, as it can be met by anything “above zero.”\textsuperscript{143} If some artistic relevance can be shown, the court must

\begin{itemize}
  \item \textsuperscript{140} Id. at *11-12.
  \item \textsuperscript{141} Rogers, 875 F.2d at 997-98.
  \item \textsuperscript{142} Id. at 998.
  \item \textsuperscript{143} E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1100 (9th Cir. 2008); Roxbury Entm’t v. Penthouse Media Group Inc., 92 U.S.P.Q.2d 1760, 1763 (C.D. Cal. 2009).
\end{itemize}
then consider whether use of the mark is explicitly misleading. In the Second Circuit, this is determined by first analyzing the traditional likelihood-of-confusion factors. If these factors weigh in favor of finding confusion likely, the court will then determine whether the likelihood of confusion is “particularly compelling.” If it is not, then the First Amendment rights of the creators of the artistic work will prevail over the complainant’s trademark rights. In the Ninth Circuit, however, a determination of whether a mark is explicitly misleading is made without consideration of the traditional likelihood-of-confusion factors, instead, the Ninth Circuit focuses directly on whether consumers would believe that the trademark owner sponsored or was associated with the creative work. The Ninth Circuit has not expressly rejected the Second Circuit’s Twin Peaks modification of Rogers, leaving open the possibility that it could some day become the standard in the Ninth Circuit. Other courts have taken mixed approaches on how to determine whether artistic use of a trademark is explicitly misleading.

The Rogers court’s artistically relevant/explicitly misleading test is the correct approach to the conflict between trademark rights and free expression, because it is the only test attuned to the primary purpose of trademark law, namely, protecting the public against confusion and fraud. The innovation of the Rogers court was not its employment of flexible balancing, per se, but rather its choice of the two interests considered in the balance. Both interests—the interest in avoiding confusion and the interest in free speech—are public, and the underlying message is unmistakable, “[I]n the context of expressive works, private property interests in trademarks are protected only to the extent they coincide with the public’s interest in avoiding confusion and fraud.” By focusing on consideration of the public interests and de-emphasizing concerns about the private interests of trademark holders in its balancing test, “the Rogers court recognized a famous trademark’s tremendous cultural and communicative value, which in expressive use transcends a trademark’s value solely as a source identifier.” Numerous trademarks in our popular culture have clearly taken on second artistic meanings for our shared values, ideas, and experiences that the trademark holder never intended, and allowing a trademark holder to control these expressive uses could impair First Amendment interests. In the words of Judge

144. Gulasekaram, supra note 77, at 903.
145. Id.
146. Id. The “no alternative avenues” test instead focuses on the mark holder’s rights.
Kozinski, “[T]he trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function.”

A recent title dispute between a well-known band and a popular television series creates an opportunity for consideration. In 1999, the Red Hot Chili Peppers band released a single and album entitled Californication, which sold more than 14 million copies and received numerous awards. When Showtime Networks began airing a television series also entitled Californication, about a sex addict who recently relocated to California, and distributed a music compilation album featuring songs used in the television series entitled Temptation—Music from the Showtime Series Californication, the band brought suit in Kiedis v. Showtime Networks, Inc., alleging various violations of the Lanham Act. The case ultimately settled, and Showtime’s series Californication recently began its third season.

In ruling on defendant Showtime’s motion to dismiss for failure to state a claim, the U.S. District Court for the Central District of California took the opportunity to discuss the application of Rogers v. Grimaldi in the Ninth Circuit to cases involving disputes between titles. Showtime had argued that under Rogers there could be no claim for trademark infringement. The title Californication, it argued, was artistically relevant because the show is set in California and features a great deal of fornication; and because the title did not refer to the band, it was not explicitly misleading. The district court denied the motion. Although acknowledging the Ninth Circuit’s adoption of Rogers in Mattel, Inc. v. MCA Records, Inc., the district court believed that Showtime had ignored “the fact that Rogers exempted works with confusingly similar titles” from its test. The district court theorized that under Showtime’s interpretation of the law, there would be nothing to restrict an author from using the exact title of someone else’s earlier work as the title of a new work, so long as the words in that title had some relevance to the content of the new work, “[t]hus, HBO or Cinemax could decide to produce

147. Mattel, 296 F.3d at 900-01 (noting that the “Barbie Girl” song is about Barbie and Ken, a reference that “can only be to Mattel’s famous couple”).


149. The term “Californication” first appeared in a Time magazine article in 1972, and was used to describe the haphazard development of California and the influx of outsiders responsible for the state’s rapid growth. Sandra Burton, The Great Wild Californicated West, Time, Aug. 21, 1972, available at http://www.time.com/time/magazine/article/0,9171,877985,00.html.

150. Kiedis, supra note 142, at 6.
another show also entitled *Californication*; and, so long as it took place in California and somehow involved fornication, defendants would not be able to prevent it.”151 Although the district court did refer to the Second Circuit’s *Twin Peaks* decision, it believed that the likelihood-of-confusion factors must be applied before application of the *Rogers* balancing test, whereas the *Twin Peaks* decision held that determination of whether a title is explicitly misleading is made, in part, by applying the likelihood-of-confusion factors.152

Had the *Kiedis v. Showtime Networks, Inc.* case gone forward, a crucial issue would likely have been whether the title *Californication* was artistically relevant to the show. Obviously, this differs from the clear-cut situation where the title directly identifies the subject matter, such as *Ginger and Fred* or “Barbie Girl,” but does artistic relevance have to be so direct and obvious? Although the answer was “yes” in the Sixth Circuit’s *Parks* decision, more recent case law in the Ninth Circuit suggests that it simply must be “above zero.”153 This highlights an inherent problem with the artistic relevance portion of the test. Isn’t artistic relevance really in the eye of the beholder?154

Assuming for the sake of argument that the district court found the title *Californication* artistically relevant, under the Ninth Circuit’s current version of the *Rogers* test, the district court would have then considered whether the title was explicitly misleading. Although the title clearly does not contain any of the most obvious indicators for being explicitly misleading (i.e., it was not *Red Hot Chili Peppers Californication*), the series itself contains some elements that the district court may have found tipped the balance. Showtime’s series includes a character named Dani California, a character that also happens to appear in three

151. *Id.*

152. The *Kiedis v. Showtime Networks* case predates the 2009 decision in *Roxbury Entm’t v. Penthouse Media Group Inc.*, where the Central District of California granted summary judgment to the defendant, finding that the First Amendment was a complete defense to Lanham Act claims between competing titles without any consideration of the traditional likelihood-of-confusion factors.


154. *See Timbers & Huston*, *supra* note 122, at 1296, arguing that because artistic relevance is in the eye of the beholder, one viewer might easily see artistic relevance where another does not. Artistic relevance may be as hard to objectively determine as pornography. *See* *Jacobellis v. Ohio*, 378 U.S. 184, 197 (1964) (noting Justice Stewart’s test for determining what constitutes pornographic or obscene materials as simply, “I know it when I see it”).
different Red Hot Chili Peppers songs, and the character’s name is, in fact, the title of one of the band’s songs, “Dani California.” As the Second Circuit noted in Twin Peaks, it is possible that “a title that might otherwise be permissible under Rogers violates the Lanham Act when displayed in a manner that conjures up a visual image prominently associated with the work bearing the mark that was copied.” While the facts differ here, the band might have argued that inclusion of that character in the defendants’ underlying work transformed a title that may otherwise have been permissible to an explicitly misleading title that outweighed Showtime’s First Amendment interests.

VII. CONCLUSION

The past twenty years have seen a marked change in the scope of protection afforded trademarks involved in creative works. The next twenty years will most certainly bring more. As new technologies and an ever-growing appetite for entertainment in all forms of media expand, the competition for consumers’ attention—and dollars—will intensify. New technologies will undoubtedly create potential conflicts for similar titles where none may have existed before. Moreover, just what makes a title or creative element “artistically relevant” and “explicitly misleading” will likely evolve. Finally, because a number of U.S. circuit courts of appeal have not yet addressed the application of Rogers v. Grimaldi, there is potential for further modifications of Rogers, or even an outright rejection of Rogers that could result in a split among the circuits of the kind that prompts a U.S. Supreme Court review. Stay tuned.

155. Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd., 996 F.2d 1366, 1380 (2d Cir. 1993).