

The Trademark Reporter®



The Law Journal of the International Trademark Association

Far from Fluent: Making Sense of the Doctrine of Foreign Equivalents

Anne Gilson LaLonde

Commentary: The Rogers Test Dances Between Trademark Protection Under the Lanham Act and Freedom of Speech Under the First Amendment.

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The TMR (ISSN 0041-056X) is published electronically six times a year by INTA, 675 Third Avenue, New York, NY 10017-5704 USA. INTA, the INTA logo, INTERNATIONAL TRADEMARK ASSOCIATION, POWERFUL NETWORK POWERFUL BRANDS, THE TRADEMARK REPORTER, and inta.org are trademarks, service marks, and/or registered trademarks of the International Trademark Association in the United States and certain other jurisdictions.

COMMENTARY

THE *ROGERS* TEST DANCES BETWEEN
TRADEMARK PROTECTION UNDER THE
LANHAM ACT AND FREEDOM OF SPEECH
UNDER THE FIRST AMENDMENT

By *Taylor E. Green**

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INTRODUCTION

“Life imitates art far more than art imitates life,”¹ according to Oscar Wilde; and therefore, our perception of life is changed by art. Watching a sunset may remind you of an artist’s painting for in that moment life imitates art. The beauty of nature is appreciated because artists feature that beauty in their paintings. Artists have latitude to create a work of art according to their vision, and their right to do so is protected under the First Amendment of the United States Constitution;² yet, this right is at times at odds with other rights, including trademark rights. We must not unconditionally revel in the glories of creativity without also respecting the Trademark Act of 1946 (the “Lanham Act”).³

In *Rogers v. Grimaldi*,⁴ the U.S. Court of Appeals for the Second Circuit developed a two-prong test for trademark infringement that attempts to balance the First Amendment right of the creators of artistic works, the Lanham Act’s protection for mark owners, and the public interest against confusion in the marketplace.⁵ The *Rogers* test is used in disputes where a defendant allegedly reproduces or imitates a plaintiff’s mark in the title or the content of an artistic work.⁶ A plaintiff alleging infringement under such a scenario must show (1) the defendant’s use of the mark either has no artistic relevance to the underlying work or, (2) if it is artistically relevant, that the use is nonetheless explicitly misleading as to the source or content of the work.⁷ In some jurisdictions, the plaintiff also must make an independent showing of actual confusion by applying the test for likelihood of confusion.⁸ With few exceptions,⁹

¹ See Oscar Wilde, *The Decay of Lying* (1891) (discussing how art affects the way we look at the world around us).

² See U.S. Const. amend. I (stating “Congress shall make no law . . . abridging the freedom of speech, or of the press”).

³ See 15 U.S.C. § 1051 *et seq.*

⁴ 875 F.2d 994 (2d Cir. 1989).

⁵ See *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099-1100 (9th Cir. 2008).

⁶ See *id.* at 1099 (holding “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 was the first court to extend the *Rogers* test beyond titles to include content of an artistic work.

⁷ See *Rogers*, 875 F.2d at 999 (detailing the formulation of the *Rogers* test). The title of an expressive work does not violate the Lanham Act “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.” *Id.*

⁸ See *Cliff’s Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp.*, 886 F.2d 490, 495 (2d Cir. 1989). On appeal, the court determined it needed to prevent blatant consumer confusion; so, rather than applying the same explicitly misleading test from *Rogers*, it engaged in a limited likelihood of confusion analysis. See also *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (detailing a set of factors used to determine likelihood of confusion).

⁹ See *infra* at III, discussing *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003).

courts have liberally, yet consistently, applied the first prong of the *Rogers* test and have incongruously applied the second prong.

This commentary analyzes the *Rogers* balancing test for trademark infringement by first highlighting major circuit splits in the application of that test and then analyzing the evolution of the test from circuit to circuit, including the rejection of the *Rogers* test in *Stouffer v. National Geographic Partners, LLC*¹⁰ and that court's proposal of a new test for liability. Despite its imperfections, the new *Stouffer* test may, and this commentary argues should, set into motion a timely reexamination of the *Rogers* test. After identifying the flaws, in both the *Rogers* and *Stouffer* tests, the commentary proposes the addition of two elements to the *Rogers* test. These supplemental considerations take into account consumer protection from confusion and time as a motivating factor to use the trademark, all of which are absent from the current *Rogers* test. The current test is inadequate and too defendant-friendly; a reinvention of the *Rogers* test could bring courts closer to developing a framework capable of providing a better balance between the property interest granted to trademarks under the Lanham Act and the fundamental right to free speech under the First Amendment.¹¹

I. BACKGROUND ON APPLICABLE LAWS

The interplay between the Lanham Act and the First Amendment is a crucial factor to consider when making a trademark infringement determination. The Lanham Act and the First Amendment work in tandem as the Lanham Act protects a trademark from being unfairly used, while the First Amendment protects the freedom of artistic expression. It is important first to understand interpretations of the First Amendment and the Lanham Act individually before considering how they work together, and then how they are weighed under the *Rogers* test.

A. *The Lanham Act*

The Lanham Act is the primary federal statute governing trademark law in the United States. It established a national system of trademark registration and provided statutory causes of action for mark owners to assert against the use of similar marks likely to cause confusion. As defined in the Lanham Act, a trademark is “any word, name, symbol, or device” that a person uses in commerce to distinguish their product or service from those of

¹⁰ 460 F. Supp. 3d 1133 (D. Colo. 2020) (“*Stouffer II*”), *appeal dismissed*, No. 20-1208 (10th Cir. Feb. 24, 2021).

¹¹ See *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664 (5th Cir. 2000) (describing the tension between the protection afforded by the Lanham Act and the First Amendment).

others.¹² Examples of trademarks include the red sole heels of a pair of Christian Louboutin shoes and the golden arches in front of a McDonald's restaurant. Trademarks can appear as logos, which aid consumers in identifying the origin of a product. A mark owner may register its mark on the Principal Register of the United States Patent and Trademark Office if the mark is used in commerce, is distinctive, and is nonfunctional, in which case the registration can be either *prima facie* or conclusive evidence of the mark's validity.¹³ To avoid consumer confusion as to the source of a good or service, two sections of the Act, Section 32(1)¹⁴ and Section 43(a), recognize causes of action against, as the latter statute reads, "[a]ny person who . . . uses in commerce any word, term, name, symbol, or device . . . which is likely to cause confusion . . . as to the affiliation . . . of his or her goods."¹⁵

¹² 15 U.S.C. § 1127; *see also* *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) ("A trademark is a limited property right in a particular word, phrase or symbol.").

¹³ 15 U.S.C. §§ 1057(a), 1115(a)-(b).

¹⁴ *Id.* § 1114(1)(a), (b). This section of the Lanham Act provides:

- (1) Any person who shall, without the consent of the registrant—
 - (a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or
 - (b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

Id. § 1114(1)(a)-(b).

¹⁵ *Id.* § 1125(a)(1). This section of the Lanham Act provides:

- (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
 - (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
 - (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Id. § 1125(a)(1)(A)-(B).

The scope of the Lanham Act extends beyond disputes between producers of commercial products and their competitors and allows celebrities (and, in some circuits, non-celebrities)¹⁶ to vindicate property rights in their identities against allegedly misleading commercial uses by others. Celebrities have standing to bring a cause of action for false endorsement under Section 43(a)(1)(A) of the Act because they have an economic interest in their identities as personal brands similar to that of a traditional trademark holder. Furthermore, the Lanham Act can apply when the potential harm of consumer confusion outweighs the freedom of expression, thereby requiring courts to weigh the mark holder's rights under the Lanham Act against a defendant's right to freedom of speech under the First Amendment.

Whatever the theory of likely confusion articulated by plaintiffs, courts historically have addressed the issue by examining a series of factors: (1) "the strength of [the plaintiff's] mark"; (2) "the degree of similarity between the two marks"; (3) "the proximity of the products"; (4) "the likelihood that the . . . owner will bridge the gap"; (5) "evidence of actual confusion"; (6) "defendant's good faith in adopting [the] mark"; (7) "the quality of defendant's product"; and (8) "the sophistication of the [consumers]."¹⁷ However, as set forth below in greater detail, when a plaintiff alleges infringement of its mark in the title or content of a defendant's artistic work, a different test is applied in recognition of, and in deference to, the defendant's implicated First Amendment rights.

B. The First Amendment in the Context of Freedom of Expression

The First Amendment, comprising of a guarantee of freedom of expression, is a fundamental right granted to all persons within the United States. The First Amendment states that "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances."¹⁸ The Supreme Court interprets the extent of the protection afforded to these rights. First Amendment rights are not absolute and can yield in various circumstances to countervailing interests. A notable historic case is

¹⁶ See *Hauf v. Life Extension Found.*, 547 F. Supp. 2d 771, 777 (W.D. Mich. 2008) (recognizing false endorsement is where a celebrity's image or persona is used in association with a product to imply that celebrity endorses the product). The court found plaintiff does not need to prove that he is a "celebrity." Commercial value can be established by (1) the distinctiveness of the identity and (2) the degree of recognition of the person among those receiving the publicity.

¹⁷ See *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (defining multi-factor test established by Second Circuit for determining likelihood of confusion).

¹⁸ U.S. Const., amend. I.

Schenck v. United States,¹⁹ in which Justice Oliver Wendell Holmes set forth a “clear and present danger test” to determine whether speech is protected by the First Amendment. The “clear and present danger test” considers whether the words are used in such circumstances and are of such a nature as to create a clear and present danger that they will bring about the substantive evils that Congress has the right to prevent. *Rogers* attempts to balance the liberal, although not absolute, freedom of speech rights guaranteed by the First Amendment with unfairly using an existing trademark.

II. CIRCUIT-BY-CIRCUIT APPLICATION OF THE *ROGERS* TEST

The *Rogers* test purported to balance the challenges of applying the fact-intensive likelihood-of-confusion test for liability for infringement under the Lanham Act against the freedom of expression granted by the First Amendment. To prevent conflict between the First Amendment and the Lanham Act, the Second Circuit in *Rogers v. Grimaldi* adopted a two-prong test. That test requires the court to determine (1) whether the defendant’s use is artistically relevant to the underlying work and (2) whether the defendant’s use is explicitly misleading as to the source or content of the work. As a practical matter, the first prong has greatly overshadowed the second prong in application, to the detriment of trademark owners. Furthermore, while the *Rogers* test is useful in making a trademark infringement determination, problems exist in its application to a wide array of cases brought before different circuits. Criticism as to whether the *Rogers* test would be better suited with more factors is explored below.

A. *Rogers v. Grimaldi*

Rogers v. Grimaldi arose from a film titled *Ginger and Fred*, which starred two fictional Italian cabaret performers who imitated Ginger Rogers and Fred Astaire, one of the most famous dancing duos in the show business and internationally known as “Ginger and Fred.”²⁰ There was no dispute that the film’s producers did not receive permission to refer to Rogers or Astaire. Ginger Rogers sued the filmmaker, seeking monetary and injunctive relief, alleging the title violated her rights under Section 43(a) of the Lanham Act by creating the false impression that the film was about her or that she sponsored or endorsed the film.²¹ Recognizing that application of the

¹⁹ 249 U.S. 47 (1919). The defendants mailed leaflets to new recruits and enlisted soldiers that compared military conscription to involuntary servitude and urged them to assert their constitutional rights.

²⁰ See *Rogers v. Grimaldi*, 875 F.2d 994, 996-97 (2d Cir. 1989).

²¹ *Id.*

Lanham Act to titles of artistic works could violate the First Amendment, the district court granted summary judgment to the defendants, holding the title of the film was artistic expression and, thus, protected under the First Amendment.²²

The Second Circuit affirmed in an opinion acknowledging the tension between the Lanham Act and First Amendment protection for artistic works and their titles.²³ The court recognized that because First Amendment rights were implicated, a test other than the standard likelihood of confusion test would need to be employed, and in resolving that tension, developed the two-prong test considering whether the defendant's use of the trademark is (1) artistically relevant and/or (2) explicitly misleading. The court reasoned that a title is an integral element of a film and a producer's artistic expression and, therefore, deserves protection under the First Amendment.²⁴ Then, applying the second prong, the court determined that the title *Ginger and Fred* contained no explicit indication that Rogers sponsored or endorsed the film.²⁵ Even if some consumers would be confused as to whether Rogers was involved in the making of the film, that was sufficiently outweighed by the interest in artistic expression to preclude liability under the Lanham Act. Furthermore, should the title mislead some individuals as to the subject of the work, that risk was outweighed by the danger that suppressing an artistically relevant title would unduly restrict expression.²⁶

B. First Prong: Artistic Relevance of the Title to the Content

The first prong of the *Rogers* test turns on artistic relevance, with liability under the Lanham Act possible if the challenged use of the trademark has no artistic relevance to the underlying work.²⁷ Artistic relevance is used to determine whether the use of a trademark is relevant to a disputed work's artistic purpose. As courts have adopted and applied the *Rogers* test, it has become clear that the threshold for a finding of artistic relevance is very low. As

²² *Id.* at 997. Section 43(a) of the Lanham Act creates civil liability for any person who, "in connection with any goods or services, . . . uses in commerce . . . any false designation of origin, false or misleading description of fact, or false or misleading representation. . . ." 15 U.S.C. § 1125(a)(1).

²³ *Id.* at 999.

²⁴ *Id.* at 998.

²⁵ *Id.* at 1001.

²⁶ *Id.*

²⁷ See *Louis Vuitton Malletier S.A. v. Warner Bros. Entm't Inc.*, 868 F. Supp. 2d 172, 178 (S.D.N.Y. 2012) (finding that the defendant satisfied the artistic relevance prong where its use of the trademark was "not arbitrarily chosen just to exploit the publicity value of [the plaintiffs' mark] but instead ha[d] genuine relevance to the film's story" (alterations in original) (quoting *Rogers*, 875 F.2d at 1001)).

established by the Ninth Circuit, this requirement is nothing more than the need for the artistic relevance level to be above zero.²⁸ As reflected in the following discussion, courts historically have been liberal and consistent in finding the existence of artistic relevance, thereby foreclosing relief under the Lanham Act.

Consistent with the reasoning in *Rogers*, an example of artistic relevance crossing the above-zero finish line is in *Virag, S.R.L. v. Sony Computer Entertainment America LLC*.²⁹ Virag sued the defendant for allegedly including Virag's trademark in the content of its GRAN TURISMO racing video games. The court applied the first prong of the *Rogers* test and found Sony's use of the Virag mark had artistic relevance. The mark's artistic relevance was attributable to the role realism plays in the GRAN TURISMO games. Realism qualifies as artistic expression. The real-life logos and realistic car racing simulation in the games were examples of artistic relevance showing a connection between Virag's trademark and the logos in the video games. The court did not need to determine exactly how artistically relevant the Virag mark was to the games; rather, it only needed to find the artistic relevance level was above zero.³⁰ The "above zero" standard for determining artistic relevance likely appeals to courts because of its easy applicability as a "black-and-white rule."³¹

Another example of a court pulling the trigger at the first sight of artistic relevance and leniently applying the first prong of the *Rogers* test is the Southern District of Indiana's decision in *Dillinger, LLC v. Electronic Arts, Inc.*³² *Dillinger* involved the estate of the famous gangster, John Dillinger, which alleged that the "Dillinger Tommy Gun," which appears as a weapon in *The Godfather* video games, infringed its registered JOHN DILLINGER mark for firearms.³³ *Dillinger* argued there was no artistic relevance between its mark and the video game because *The Godfather* novel and films, upon which the video game is based, were not set in the same period as when John Dillinger was alive.³⁴ Upon consideration, the court held it was not its role to determine the degree of meaningfulness of a trademark to the content of a literary work.³⁵ Consistent with *Rogers* and its progeny, any connection

²⁸ E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1100 (9th Cir. 2008).

²⁹ 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), *aff'd*, 699 F. App'x 667 (9th Cir. 2017).

³⁰ VIRAG, 2015 WL 5000102, at *12.

³¹ *Id.* at *14-15 (*citing* Brown v. Elec. Arts, Inc., 724 F.3d 1235, 1243 (9th Cir. 2013)).

³² Dillinger, LLC v. Elec. Arts Inc., No. 1:09-cv-1236-JMS-DKL, 2011 WL 2457678 (S.D. Ind. June 16, 2011).

³³ *Id.* at *3.

³⁴ *Id.* at *4-6.

³⁵ *Id.* at *6.

whatsoever was sufficient to satisfy the low, “more than zero,” threshold of minimal artistic relevance.³⁶

In the cases discussed above, courts concluded that there was at least an “above zero” level of artistic relevance under the *Rogers* balancing test. In contrast, in *Parks v. LaFace Records*,³⁷ the Sixth Circuit found that there was a factual dispute as to whether the level of artistic relevance was sufficient to satisfy *Rogers*’s first prong, and indeed that it was “highly questionable” whether there was any relevance of the song title to the song content at all.³⁸ *Parks* involved a dispute between the civil rights icon, Rosa Parks, and the hip-hop duo OutKast over the latter’s use of Parks’ name as the title of their song “Rosa Parks.”³⁹ Parks contended the defendants violated the Lanham Act because the Rosa Parks title misled consumers into believing the song was about her or that she sponsored or endorsed the song.⁴⁰ Due to her fame, Parks acquired celebrity⁴¹ status and, as a result, had a property interest in her name similar to that of a person who owns a trademark.⁴² The district court, in ruling on cross-motions for summary judgment, found the defendant, OutKast, had added sufficient expressive content to the lyrics to warrant First Amendment protection for their use of Parks’ name as their song title.⁴³ Rosa Parks was a symbol of the civil rights movement; accordingly, the use of her name in the song title was for symbolic purposes. But the Sixth Circuit asked, “symbolic of what?” and observed that the content of the song appeared to be unrelated to the qualities for which Parks is known and, instead, was an exercise in “pure egomania” (OutKast’s assertion of superiority over other MCs).⁴⁴ If, on remand, a fact finder found (as the court suggested was likely) that there was “no artistic relevance to the lyrics of Defendants’ song,” the result

³⁶ *Id.*

³⁷ 329 F.3d 437 (6th Cir. 2003).

³⁸ *Id.* at 449, 456. The *Parks* decision is an outlier in this regard.

³⁹ *Id.* at 441.

⁴⁰ *Id.* at 446.

⁴¹ A celebrity is defined as “a celebrated or widely known person: one popularly honored for some signal achievement.” *Celebrity*, Webster’s Third New International Dictionary 359 (Phillip Babcock Grove, ed. 1976).

⁴² *Parks*, 329 F.3d at 447 (recognizing a property right in celebrity identity akin to that of a trademark holder). See, e.g., *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992), *abrogated on other grounds by* *Lexmark Int’l, Inc. v. Static Control Components*, 572 U.S. 118 (2014); *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612, 624-25 (S.D.N.Y. 1985).

⁴³ *Parks*, 329 F.3d at 447. See *Hurley v. Irish-Am. Gay, Lesbian Bisexual Grp. of Bos., Inc.*, 515 U.S. 557, 569 (1995) (stating that paintings, music, and poetry are “unquestionably shielded” by First Amendment); *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989) (“Music, as a form of expression and communication, is protected under the First Amendment.”).

⁴⁴ *Parks*, 329 F.3d at 454.

“would be that Defendants cannot even satisfy the first prong of *Rogers* in order to justify their appropriation of Rosa Parks’ name.”⁴⁵ As to the second prong, however, the court found that there was no material dispute as to whether the song title was explicitly misleading. “Defendants did not name the song, for example, *The True Life Story of Rosa Parks* or *Rosa Parks’ Favorite Rap*” and, therefore, if a fact finder found on remand that there was artistic relevance, judgment should be entered for the defendants.⁴⁶ The case subsequently was settled.⁴⁷ A key takeaway from the Sixth Circuit’s decision is its sagacious observation that “the First Amendment cannot permit anyone who cries ‘artist’ to have carte blanche when it comes to naming and advertising his or her works.”⁴⁸

C. Second Prong: Explicitly Misleading Title or Content

While the artistic relevance prong of the *Rogers* test appears to be somewhat uniformly applied across all circuits, with the exception of *Parks*, the method for applying the explicitly misleading prong has shown some variety. Generally, “explicitly misleading”⁴⁹ refers to an obvious and unambiguous statement of sponsorship. Below are examples of how different circuits interpret the meaning of explicitly misleading.

In *Twin Peaks Productions, Inc. v. Publications International, Ltd.*,⁵⁰ Publications International published a book titled *Welcome to Twin Peaks: A Complete Guide to the Who’s Who and What’s What*, which incorporated the title of the *Twin Peaks* television series.⁵¹ The court applied the *Rogers* test and, as to the first prong, found “little question that the title is of some artistic relevance to the Book.” The second prong, thus, was the determining factor: whether the title would mislead the public into believing the book was prepared by, or otherwise associated with, the producers of the television show.⁵² Because the title involved a literary work instead of a celebrity name, the court began by utilizing the *Polaroid*

⁴⁵ *Id.* at 456.

⁴⁶ *Id.* at 459.

⁴⁷ *Parks v. LaFace Records*, Civ. No. 2:99-cv-76405 (E.D. Mich.), ECF No. 264, Stipulated Order Dismissing Case with Prejudice filed April 14, 2005.

⁴⁸ *Parks*, 329 F.3d at 447.

⁴⁹ *Explicitly* is defined as “clearly and without any vagueness or ambiguity.” *Explicitly*, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/explicitly> (last visited Apr. 7, 2022).

⁵⁰ *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366 (2d Cir. 1993).

⁵¹ *Twin Peaks Prods., Inc. v. Publ’ns Int’l*, 778 F. Supp. 1247, 1249, 1252 (S.D.N.Y. 1991), *aff’d in part, vacated in part*, 996 F.2d 1366.

⁵² *Twin Peaks*, 996 F.2d at 1379.

likelihood-of-confusion factors. Should likelihood of confusion exist, the court held it must be “particularly compelling” to outweigh the First Amendment interest recognized in *Rogers*.⁵³ Because the record had not been adequately developed, the case was remanded to the district court for its consideration of the likelihood-of-confusion factors.⁵⁴ The most important takeaway from this case is that the second prong does not just involve an application of the likelihood-of-confusion factors, but a heightened threshold to find liability in view of First Amendment rights.

In *VIP Products LLC v. Jack Daniel’s Properties, Inc.*,⁵⁵ the Ninth Circuit took a different approach from the Second Circuit toward *Rogers*’s explicitly misleading prong. The Ninth Circuit’s application of *Rogers*’s second prong does not consider the standard likelihood-of-confusion test when determining whether a defendant’s use is explicitly misleading, but instead focuses on the defendant’s actions. Thus, even though the court requires a plaintiff to make a separate showing of likely confusion,⁵⁶ the plaintiff’s ability to do so is a different inquiry altogether. In *VIP Products*, Jack Daniel’s, a whiskey manufacturer, sued VIP Products, the maker of a dog toy, for modeling its dog toy after the JACK DANIEL’S “Old No. 7” bottle.⁵⁷ The toy design was a creative interpretation of the liquor bottle;⁵⁸ and Jack Daniel’s alleged that the toy infringed its trademark rights in its design of the bottle.⁵⁹ Considering the second prong in *Rogers*, the Ninth Circuit held the design of the dog toy was not explicitly misleading because VIP Products made comical, dog-related alterations to the JACK DANIEL’S “Old No. 7” bottle by replacing the name “Jack Daniel’s” with “Bad Spaniels,” “Old No. 7” with “Old No. 2,” and alcohol content descriptions with “43% Poo by volume” and “100% smelly.”⁶⁰

⁵³ *Id.* at 1379.

⁵⁴ *Id.*

⁵⁵ *VIP Prods. LLC v. Jack Daniel’s Props., Inc.*, 953 F.3d 1170 (9th Cir. 2020), *cert. denied*, 141 S. Ct. 1054 (2021).

⁵⁶ *See Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 265 (9th Cir. 2018) (“If the plaintiff satisfies both elements, it still must prove that its trademark has been infringed by showing that the defendant’s use of the mark is likely to cause confusion.”).

⁵⁷ *VIP Prods. LLC*, 953 F.3d at 1172.

⁵⁸ *Id.* at 1173, 1175 (stating VIP “did not use JDPI’s identical marks or trade dress in its Bad Spaniels toy” (citation omitted)).

⁵⁹ *Id.* at 1173 (“Jack Daniel’s trade dress and bottle design were distinctive, non-generic, and nonfunctional, and therefore entitled to trademark protection.”). *See also* *Anheuser-Busch, Inc. v. VIP Prods., LLC*, 666 F. Supp. 2d 974, 986 (E.D. Mo. 2008) (preliminarily enjoining VIP Product’s sale of its Buttweiler toy after finding Anheuser-Busch demonstrated a substantial likelihood of success on the merits of the trademark infringement claim).

⁶⁰ *VIP Prods. LLC*, 953 F.3d at 1172. If the plaintiff satisfied one of the *Rogers* elements, “it still must prove that its trademark has been infringed by showing that the defendant’s use of the mark is likely to cause confusion.” *Id.* at 1176 n.2 (quoting *Gordon v. Drape*

The court also held that the toy design was not explicitly misleading because VIP Productions did not intend to confuse consumers into thinking the dog toy was a whiskey bottle for human consumption but, rather, employed a marketing tactic to humanize dogs to better relate to consumers.⁶¹ There, the court's analysis focused heavily on the defendant's intent and actions.

The Fifth Circuit has accepted the *Rogers* test for cases alleging trademark infringement and, like the Second Circuit, makes an explicitly misleading determination based on the application of the likelihood-of-confusion factors. For example, in *Westchester Media v. PRL USA Holdings, Inc.*,⁶² the court analyzed whether the use of POLO for a magazine title infringed the trademark rights of the Ralph Lauren POLO brand.⁶³ Loyal to the *Rogers* test, the Fifth Circuit conducted an artistic relevance and explicitly misleading analysis and concluded that the POLO title was likely to cause consumer confusion. The Fifth Circuit adopted the Second Circuit's two-prong test⁶⁴ and then implemented a likelihood-of-confusion test⁶⁵ to determine whether a title is misleading. Consistent with *Rogers*'s pro-defendant orientation, the Fifth Circuit held that the likelihood of confusion must be particularly compelling to fall outside of First Amendment protection.⁶⁶

Unlike the Fifth Circuit, which uses the likelihood-of-confusion test as part of the inquiry into whether a defendant's use is explicitly misleading, the Third, Sixth, and Eleventh Circuits, as well as district courts within the Seventh Circuit, have all interpreted the explicitly misleading prong in *Rogers* as requiring the defendant to

Creative, Inc., 909 F.3d 257, 265 (9th Cir. 2018)); see also *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260 (4th Cir. 2007) (stating application of likelihood-of-confusion depends "to a great extent on whether its products and marks are successful parodies"). See also *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 970 (10th Cir. 1996) ("[P]roof of trademark infringement under the Lanham Act requires proof of a likelihood of confusion, but, in the case of a good trademark parody, there is little likelihood of confusion, since the humor lies in the difference between the original and the parody." (emphasis added)).

⁶¹ *VIP Prods. LLC*, 953 F.3d at 1172.

⁶² *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000).

⁶³ *Id.* at 660.

⁶⁴ *Id.* at 665. See also *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 n.7 (5th Cir. 1999) ("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." (quoting *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993))).

⁶⁵ *Westchester Media*, 214 F.3d at 665. See *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 543 (5th Cir. 1998) ("No single factor is dispositive, and a finding of a likelihood of confusion does not require a positive finding on a majority of these 'digits of confusion.'" (citation omitted)); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 194 (5th Cir. 1998) (same); *Conan Props., Inc. v. Conans Pizza, Inc.*, 752 F.2d 145, 149-50 (5th Cir. 1985) ("The absence or presence of any one factor ordinarily is not dispositive. . .").

⁶⁶ *Westchester Media*, 214 F.3d at 665. See also *Twin Peaks Prods.*, 996 F.2d at 1379.

engage in some overt act to confuse the public. For example, in *University of Alabama Board of Trustees v. New Life Art, Inc.*,⁶⁷ the university believed the defendant artist needed permission to paint football scenes because the crimson and white colors and helmet and uniform designs were trademarks of the university.⁶⁸ The Eleventh Circuit applied the second prong of the *Rogers* test and found no evidence that the defendant had engaged in an overt act, such as labeling his items as “endorsed” or “sponsored” by the university, that might confuse consumers; the defendant’s paintings, prints, and calendars were, therefore, entitled to First Amendment protection.⁶⁹ Consistent with the Eleventh Circuit’s decision, the Third and Sixth Circuits,⁷⁰ and district courts within the Seventh Circuit,⁷¹ mirror the Eleventh Circuit’s rule that explicit misstatements or overt actions are required to find a defendant’s use explicitly misleading under *Rogers*.

As demonstrated above, the various Circuit Courts of Appeals have implemented *Rogers*’s second prong in different ways. The varying interpretations of *Rogers*’s two-prong test by courts outside of the Second Circuit suggest a degree of judicial discomfort with, or perhaps misunderstanding of, the original test. Questions have arisen in at least one court as to whether the *Rogers* test is the proper test to apply or whether an alternative test may be more suitable when balancing the rights of trademark owners and the rights of artists seeking to use or reference trademarks within their creative expressions.

III. CREATION OF A NEW TEST: *STOUFFER v. NATIONAL GEOGRAPHIC PARTNERS, L.L.C.*

The Tenth Circuit has never had the occasion to consider the propriety of applying *Rogers* in a trademark-based challenge to the title or content of a creative work. However, in *Stouffer v. National Geographic Partners, LLC*,⁷² the United States District Court for the District of Colorado, in the absence of authority from its reviewing court, rejected the *Rogers* test because previous courts have struggled to accommodate unanticipated factual patterns within

⁶⁷ Univ. of Ala. Bd. of Trs. v. New Life Art, Inc., 683 F.3d 1266 (11th Cir. 2012).

⁶⁸ *Id.* at 1269.

⁶⁹ *Id.* at 1279.

⁷⁰ See, e.g., Seale v. Gramercy Pictures, 949 F. Supp. 331 (E.D. Pa. 1996), *aff’d without opinion*, 156 F.3d 1225 (3d. Cir. 1998); ETW Corp. v. Jireh Publ’g, 332 F. 3d 915 (6th Cir. 2003).

⁷¹ See Eastland Music Grp., LLC v. Lionsgate Entm’t, No. 11 C 8224, 2012 WL 2953188 (N.D. Ill. July 19, 2012).

⁷² *Stouffer v. Nat’l Geographic Partners, LLC*, 460 F. Supp. 3d 1133 (D. Colo. 2020), *appeal dismissed*, No. 20-1208 (10th Cir. Feb. 24, 2021).

that test.⁷³ The resulting “genuine artistic motive” test, also known as the *Stouffer* test, is a six-factor test detailed below.⁷⁴ The importance of *Stouffer*, and the analysis found within it, is not in its outcome or contribution to ensuing trademark infringement cases, but, rather, the fact that the court challenged whether *Rogers* is the right test at all and offered a broader analytical approach.⁷⁵

A. *Stouffer v. National Geographic Partners, L.L.C.*

Stouffer involved a nature documentary series, *Wild America*, produced by Marty Stouffer Productions (“Stouffer”). National Geographic requested permission to use the title *Wild America* or *Wildest America* for its own production.⁷⁶ Stouffer declined on the grounds that WILD AMERICA is a protected trademark and the proposed titles by National Geographic were too similar.⁷⁷ Nevertheless, National Geographic produced several television series related to the title *Wild America*, including *America the Wild*, *Surviving Wild America*, and *America’s Wild Frontier*.⁷⁸ Consequently, Stouffer brought a trademark infringement action in the District Court of Colorado against National Geographic for using the titles.⁷⁹

Since the Tenth Circuit had neither approved nor disapproved of the *Rogers* test, the district court was not bound by any controlling authority.⁸⁰ Thus addressing *Rogers*’s applicability as a question of first impression, the court concluded the test was needlessly rigid and failed to account for the realities of each situation.⁸¹ The court expressed its concerns that, in light of the heavily pro-defense nature of the *Rogers* test, a reasonable person may believe “trademarks registered for arguably artistic products and services are not worth the paper that the trademark

⁷³ *Id.* at 1135 (concluding that *Rogers* test, without more prongs, “did not strike the appropriate balance between trademark rights and First Amendment rights”).

⁷⁴ *Id.* at 1139-40.

⁷⁵ Order, *Stouffer v. Nat’l Geographic Partners*, No. 20-1208 (10th Cir. filed Mar. 1, 2021) (granting a stipulation to dismiss under Federal Rule of Appellate Procedure 42 allowing for procedural termination without judicial action).

⁷⁶ *Stouffer II*, 460 F. Supp. 3d at 1135-36. Marty Stouffer Productions owns a federal trademark registration for WILD AMERICA. *Id.* at 1136.

⁷⁷ *Id.*

⁷⁸ *Id.* at 1136-39.

⁷⁹ *Id.* at 1139.

⁸⁰ *Id.* The court asked three questions: (1) “[D]oes the Lanham Act need a limiting construction to protect First Amendment interest? . . . [Y]es.” (2) “[M]ust the First Amendment-based limiting construction on the Lanham Act lead to a test that a court may apply before trial. . . ? . . . [Y]es.” (3) “[I]s the *Rogers* test the right test?” No, it should not be applied “as-is.” *Id.* at 1139-40.

⁸¹ *Id.* at 1143.

registration is printed upon.”⁸² To make the *Rogers* test less rigid, the court concluded that the explicitly misleading prong from the *Rogers* test should be satisfied by use of the challenged mark alone without the need for an overt act by the defendant.⁸³ After considering *Rogers*, the court held that test did not strike the appropriate balance between trademark rights and First Amendment rights because it tilted too far in favor of the defendant’s freedom of expression.⁸⁴ The court, therefore, sought a more flexible test that can be tailored to each case by considering six factors designed to answer the ultimate question of whether the defendant had a genuine artistic motive for using the plaintiff’s mark or other property right protected by the Lanham Act.⁸⁵

B. The Stouffer Test

The *Stouffer* court’s analysis added elements that courts in the Second, Fifth, Sixth, Ninth, and Eleventh Circuits had identified as missing in the *Rogers* test.⁸⁶ Displeased with the two-prong *Rogers* test, the district court introduced a six-factor alternative test examining: (1) whether the plaintiff and defendant users “use the mark to identify the same kind [or similar] goods or services,” (2) “to what extent has the [defendant] added his or her own expressive content to the work,” (3) whether “the timing of the [defendant’s] use in any way suggest[s] a motive to capitalize on popularity of the [plaintiff’s] mark,” (4) whether the defendant’s use is “artistically related to the underlying work,” (5) “whether the defendant “made any statement to the public . . . suggest[ing] a non-artistic motive,” and (6) whether the defendant “made any statement in . . . private suggest[ing] a non-artistic motive.”⁸⁷ Each factor is discussed below, including its origin and intended application to future cases.

The first factor of the *Stouffer* test, which seeks to explore the similarity of the goods or services offered by the plaintiff and defendant, echoes the significance of those considerations in the standard multifactored tests for likely confusion, including the

⁸² *Id.* at 1142.

⁸³ *Id.* at 1143.

⁸⁴ *Id.* at 1140. *See Rogers*, 875 F.2d at 1006 (stating the *Rogers* test offers a “cure . . . far worse than the ailment” (Griesa, J., concurring)).

⁸⁵ *Stouffer II*, 460 F. Supp. 3d at 1140-41.

⁸⁶ *See Hermes Int’l et al. v. Mason Rothschild*, 2022 U.S.P.Q.2d 476 (S.D.N.Y. May 18, 2022); *see also Rin Tin, Inc. v. First Look Studios, Inc.*, 671 F. Supp. 2d 893 (S.D. Tex. 2009); *see also Rebellion Devs. Ltd. v. Stardock Entm’t, Inc.*, 107 U.S.P.Q.2d 2160 (E.D. Mich. May. 9, 2013); *see also VIP Prods. LLC*, 953 F.3d at 1172; *see also Legacy Entm’t Gap, LLC v. Endemol USA Inc.*, No. 3:15-cv-252-HES-PDB, 2015 WL 12838795 (M.D. Fla. Sept. 30, 2015).

⁸⁷ *Id.* at 1140.

multifactor test extant in the Tenth Circuit.⁸⁸ The first factor directs the court to analyze, from a likelihood-of-confusion perspective, how the defendant uses its mark and whether the defendant's mark is similar to the plaintiff's mark. The likelihood of confusion is an important consideration when determining whether the defendant's use infringes the plaintiff's mark.

The second factor of the *Stouffer* test considers to what extent the defendant added expressive content to the work and is developed from *Parks v. LaFace Records*.⁸⁹

The third factor of the *Stouffer* test, derived from *Gordon v. Drape Creative*,⁹⁰ analyzes whether the timing of the defendant's use suggests a motive to benefit from the fame of the plaintiff's mark. In *Gordon*, Christopher Gordon posted on YouTube "The Crazy Nastyass Honey Badger," a video known for its catchphrase "Honey Badger Don't Care" and "Honey Badger Don't Give a S---."⁹¹ Gordon registered the former phrase as a mark for numerous classes of goods, including greeting cards.⁹² Alleging trademark infringement, Gordon sued Drape Creative Inc., a greeting card design company, and Papyrus-Recycled Greetings Inc., a greeting card manufacturer, for selling greeting cards with variations of "Honey Badger Don't Care" and "Honey Badger Don't Give a S---."⁹³ Despite the popularity of Gordon's mark, the defendant could not recall how he came up with the almost identical phrase to Gordon's mark.⁹⁴ Nevertheless, the timing of the events suggests a potential intent by the defendant to take advantage of the fame of the plaintiff's mark. Although the *Gordon* court did not consider timing as an issue, because it is not an element in the *Rogers* test, the *Stouffer* court made it clear that any temporal connection should be specifically considered part of the evaluation.⁹⁵ According to the

⁸⁸ *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Res.*, 527 F.3d 1045, 1054-55 (10th Cir. 2008) (citing Tenth Circuit's application of its traditional six-factor likelihood-of-confusion analysis). The Tenth Circuit held the plaintiff had not presented evidence from which a jury could conclude that the parody website was likely to cause confusion within the Lanham Act. *Id.* at 1056-57.

⁸⁹ *Stouffer II*, 460 F. Supp. 3d at 1140 (citing court's inspiration from *Parks v. LaFace Recs.*, 329 F.3d 437 (6th Cir. 2003) (exploring *Rogers*'s first prong of artistic relevance)).

⁹⁰ *Id.*, citing *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184, 1186 (9th Cir.), *withdrawn and superseded on reh'g by* 909 F.3d 257 (9th Cir. 2018).

⁹¹ *Id.* at 1186-87.

⁹² *Id.* at 1187.

⁹³ *Id.* at 1186.

⁹⁴ *Id.* at 1189 (claiming to have never heard of a video involving a honey badger).

⁹⁵ *Stouffer II*, 460 F. Supp. 3d at 1140 (discussing Court's proposal of a six non-exclusive factor test to weigh First Amendment interests). One of the factors the Court states is "[t]o what extent has the junior user 'added his or her own expressive content to the work beyond the mark itself[']'?" *Id.* (second and third alterations in original) (quoting *Stouffer v. Nat'l Geographic Partners, LLC*, 400 F. Supp. 3d 1161, 1179 (D. Colo. 2019) ("*Stouffer I*").

court, even though motive is a subjective element, inferences of motive can prove helpful to the court in determining the propriety of a defendant's use of a plaintiff's mark vis-a-vis First Amendment and Lanham Act concerns.⁹⁶

The fourth factor of the *Stouffer* test is the first prong of the *Rogers* test, which questions the artistically related nature of the plaintiff's mark as compared with the defendant's use of the mark.⁹⁷ Notably, the *Stouffer* court did not outright reject the *Rogers* test, but broadened it so that the "more than zero" threshold would not be so dispositive.⁹⁸ Nevertheless, the *Stouffer* court recognized that artistic relevance is a key component to a creative work and deserves to remain a part of the test. The artistic relevance prong seeks to ensure there is an intended artistic association with the mark. It is not the court's role to determine how meaningful the artistic connection is but rather that one exists. In *Stouffer*, the defendants' *Wild America* title was artistically relevant to the underlying television series, because the series was a nature documentary taking place in America's wilderness.⁹⁹ This finding was consistent with case precedent, as courts have liberally found artistic relevance.

Additionally, the *Stouffer* court created factors five and six, which further consider motive, as in the third element, except these factors consider whether the defendant made any statement either in public or in private that suggests a non-artistic motive.¹⁰⁰ In *Gordon*, the court defined a public statement as an explicitly misleading statement, which it derived from *Rogers*'s second prong.¹⁰¹ The *Stouffer* court held that a defendant's explicitly misleading statements should be an additional factor considered when weighing First Amendment concerns with the public's interest in avoiding confusion.¹⁰²

As this analysis demonstrates, the *Stouffer* test seeks to resolve the imbalance in the *Rogers* test of allowing too much freedom of expression and, consequently, leaning too far in favor of the

⁹⁶ *Id.* at 1146.

⁹⁷ *Id.* at 1140 (citing to fourth prong of *Stouffer* test). The fourth prong asks, "In what way is the mark artistically related to the underlying work, service, or product?" *Id.*

⁹⁸ *Id.* at 1139 (stating Tenth Circuit has neither approved nor disapproved of *Rogers* test).

⁹⁹ *Id.* at 1146.

¹⁰⁰ *Id.* at 1140.

¹⁰¹ *Gordon*, 909 F.3d at 269-70. The use of a mark alone may explicitly mislead consumers about a product's source if consumers would ordinarily identify the source by the mark itself. *Id.* at 270. The Ninth Circuit provided an example with a Mickey Mouse painting containing the Disney mark at the bottom corner as the use of the mark would be relevant to the subject but mislead consumers as to the source. *Id.*

¹⁰² *Stouffer II*, 460 F. Supp. 3d at 1142. A major premise of the common-law tradition is that judges will adapt the tests and rules as unexpected situations arise.

defendant.¹⁰³ The additional *Stouffer* factors are not new but, rather, seek to resolve unanswered questions that arose in cases succeeding *Rogers*. The key distinction between the *Rogers* test and the *Stouffer* test is the additional element of motive. Recognizing there could be a more inclusive test and acknowledging the idea of reformation, the *Stouffer* test appears to be a significant achievement. However, upon closer examination, factors one, five, and six of the *Stouffer* test are effectively coextensive with the two prongs of the *Rogers* test. The *Stouffer* test accounts for artistic relevance and the additional facet of motive in reference to explicitly misleading statements. Nevertheless, three additional factors in the *Stouffer* test tilt in favor of possible liability for trademark infringement. Artists using the plaintiffs' marks for genuine artistic purposes, with no intention of confusing consumers, can find solace in knowing their freedom of expression is protected, yet within the bounds of trademark law, should courts decide to adopt this test. The development of the *Stouffer* test demonstrates a possible alternative to the *Rogers* test.

IV. A PROPOSED UPDATED TRADEMARK INFRINGEMENT TEST IN CHALLENGES TO THE TITLES OR CONTENT OF CREATIVE WORKS

Although the *Rogers* test is widely used to evaluate allegations of infringement in challenges to the titles or contents of creative works, the circuit splits in approaching its two prongs demonstrates that the test is ripe for improvement. The Second Circuit believes the two-prong *Rogers* test is sufficient for determining infringement while the Fifth, Sixth, Ninth, Eleventh, and most likely Tenth Circuits have facially adopted the test but also look to considerations such as the defendant's intent or the standard likelihood of confusion factors. The inconsistent applications of the test across circuit courts reflects at least some degree of judicial discomfort with *Rogers*.¹⁰⁴

The *Rogers* test provides a basic structure to govern the evaluation of claims of infringement originating in the titles or content of artist works, but it is not a finished product. Given the fact that courts have largely adopted this framework over the past thirty-three years, the two prongs need not be discarded completely, but as the *Stouffer* court demonstrated, the test can be expanded in order to more fairly weigh trademark protection interests. While the first prong of artistic relevance has been consistently applied, nearly

¹⁰³ *Id.* at 1140.

¹⁰⁴ *Stouffer I*, 400 F. Supp. 3d at 1171-77 (citing Second, Fifth, Sixth, Ninth, and Eleventh Circuits' different applications of *Rogers* test). Judge Friendly recognized, the "problem of determining how far a valid trademark shall be protected . . . has long been vexing and does not become easier of solution with the years." *Id.*

to the point of irrelevance, with the “non-zero” threshold for artistic relevance virtually always satisfied, courts have not applied the explicitly misleading prong with equal consistency. The *Rogers* test fails to fairly balance the plaintiff’s use and the defendant’s use of the mark by failing to take into account the defendant’s intent and actual confusion.

Building upon *Rogers*’s first prong of artistic relevance and second prong of explicitly misleading, the test needs additional elements to provide a sufficient framework for courts to follow. By adding motive and consumer confusion as additional factors, this reimagined *Rogers* test could adopt and apply uniformly across all circuits. Specifically, the *Rogers* test should include a third factor that considers whether the timing of the defendant’s use in any way suggests a motive to capitalize on the popularity of the plaintiff’s mark.¹⁰⁵ This added factor will steer courts down the path of analyzing whether a celebrity’s status contributes to the defendant’s desire to use the plaintiff’s mark. Looking to the future, software, blockchain technology, cryptocurrencies, and non-fungible tokens (“NFTs”) are all transformative concepts in our new metaverse that are beginning to present various old, but unsettled, intellectual property issues in a new light.¹⁰⁶ While some may wonder if motive is too far removed from trademark law as to be relevant, motive will help courts detect fraud or bad faith and arrive at a fairer decision. Lastly, a fourth factor should be added to the *Rogers* test requiring courts to consider whether consumers are protected from copies and confusion of similar goods, services, products, or assets. Consumer confusion can occur in both the marketplace and the metaverse. In this era of digitalization, the proposed updated *Rogers* test will allow for additional focus on consumer confusion necessary to avoid the duplication and consequent confusion of items in real life and in virtual reality. The shortfall in the current *Rogers* test is the heavy weight accorded to the freedom of expression and the lack of consideration given to enforcement of trademark law. A reinvented *Rogers* test, comprising four factors, may appeal to courts open to establishing an updated trademark infringement test where the titles and content of artistic works are concerned.

V. CONCLUSION

In the thirty years since the legendary *Rogers v. Grimaldi* case, the law continues to evolve as courts carry on in pursuit of a balancing test for trademark infringement cases implicating First Amendment rights. The *Rogers* test provides a basic framework for courts to follow when evaluating trademark infringement in

¹⁰⁵ *Id.* at 1179 (citing *Gordon*, 909 F.3d at 262).

¹⁰⁶ *See Hermes v. Int’l v. Rothschild*, 2022 U.S.P.Q.2d 476 (S.D.N.Y. May. 18, 2022).

relation to First Amendment and Lanham Act principles. Comprising only two prongs, the *Rogers* test is straightforward to apply, but over time, the need to refine the *Rogers* test has become evident.¹⁰⁷ Courts, therefore, should consider a broader test striking a fairer balance between the First Amendment protections and the Lanham Act principles.

The problem with the *Rogers* test, which considers the artistic relevance and explicitly misleading nature of a creative work, is that it provides a safe harbor to which defendants can escape to avoid trademark infringement.¹⁰⁸ Defendants effectively receive carte blanche¹⁰⁹ because the threshold for artistic relevance in *Rogers* is anything above zero, and there is a virtual absence from at least recent case law of findings that defendants' uses are explicitly misleading.¹¹⁰ Under *Rogers*, artistic creations rarely are actionable as infringement. Therefore, there needs to be a more balanced framework to apply when weighing the First Amendment freedoms against the Lanham Act's interest in preventing confusion. Recognizing this disparity, the *Stouffer* court set out to curtail the defendant's liberty by introducing motive as an additional component in a new six-prong test.¹¹¹ Borrowing elements from the *Rogers* test and the likelihood-of-confusion test, the *Stouffer* test sought to infuse key factors from each to debut a new and improved standard. Nevertheless, the court still failed to perfect the test, as decisions seem to depend on the weight awarded to each prong in relation to the others, among other issues.¹¹² The *Stouffer* opinion is historic in opening the door to conversations about refining the *Rogers* test. The inclusion of the additional factors proposed in this commentary is needed to develop a universal framework to be used by all circuits across the country in scenarios such as *Rogers*. Through carefully selected additional elements of motive and consumer protection, the *Rogers* test will now equip courts to be able

¹⁰⁷ *Rogers*, 875 F.2d at 1006-07. Judge Griesa identified the gap left by the *Rogers* test as those cases of "flagrant deception" in which the title for the underlying work will be false but artistically relevant. *Id.*; see also *Warner Bros. Pictures Corp. v. Majestic Pictures Corp.*, 70 F.2d 310 (2d Cir. 1934); see also *Orion Pictures Co. v. Dell Publ'g Co.*, 471 F. Supp. 392 (S.D.N.Y. 1979).

¹⁰⁸ *Rogers*, 875 F.2d at 999.

¹⁰⁹ *Parks v. LaFace Recs.*, 329 F.3d 437, 447 (6th Cir. 2003).

¹¹⁰ *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008); see also Nedkova, *Replacing the Rogers Test :Will an Inquiry into Non-Artistic Motive in Selecting Titles of Expressive Works Remedy the Possibility of Flagrant Deception?*, 20 *UIC Rev. Intell. Prop. L.* 429 (2021).

¹¹¹ *Stouffer II*, 460 F. Supp. 3d at 1140. Prongs five and six deal with private and public statements or actions made by the plaintiff showing non-artistic motive.

¹¹² Motion by Intell. Prop. Professors for Leave to File Brief Amicus Curiae in Support of Defendants at 10, *Stouffer v. Nat'l Geographic Partners, LLC*, ECF No. 75; motion granted, ECF No. 75 (D. Colo. Oct. 16, 2019). The six-prong *Stouffer* test focuses too much on the wrong issue; see also *Gordon*, 909 F.3d at 260.

to arrive at a better balance between First Amendment and Lanham Act rights.
