

The Trademark Reporter[®]



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Another Decade of *Rogers v. Grimaldi*: Continuing to Balance the Lanham Act with the First Amendment Rights of Creators of Artistic Works
Lynn M. Jordan and David M. Kelly

Commentary: If You Remove It, You Use It: The Court of Justice of the European Union on Debranding—On the *Mitsubishi v. Duma* Judgment by the Court of Justice of the European Union
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The Trademark Reporter®

ANOTHER DECADE OF *ROGERS v. GRIMALDI*: CONTINUING TO BALANCE THE LANHAM ACT WITH THE FIRST AMENDMENT RIGHTS OF CREATORS OF ARTISTIC WORKS

By Lynn M. Jordan and David M. Kelly***

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I. INTRODUCTION

Twenty years after the U.S. Court of Appeals for the Second Circuit's watershed decision in *Rogers v. Grimaldi*¹ balancing U.S. Bill of Rights First Amendment rights in creative works with the U.S. Trademark (Lanham) Act, the authors thoroughly analyzed how courts in the Second Circuit and other federal circuits applied the two-part test created in *Rogers*.² At the time of the authors' first article, courts had applied the *Rogers* test to cases involving disputes over the titles and content³ of creative works, even the most tenuous showing of artistic relevance would be enough to satisfy the first prong of the test, and the U.S. Court of Appeals for the Ninth Circuit had fully embraced the *Rogers* test as its own.⁴ It had clearly become the standard in disputes involving trademarks and creative works.

Much has happened in the ten years since that article. Courts that had adopted the *Rogers* test have continued to refine its application, and more courts have expressly adopted the test in Lanham Act⁵ cases, bringing the current roster to the Third,⁶ Fifth,⁷ Sixth,⁸ Ninth,⁹ and Eleventh Circuits,¹⁰ and federal district courts

¹ 875 F.2d 994 (2d Cir. 1989).

² See David M. Kelly and Lynn M. Jordan, *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 99 TMR 1360 (2009).

³ The Ninth Circuit was the first to extend *Rogers* beyond titles to content, holding that "there is no principled reason why it ought not also apply to the use of a trademark in the body of the work." *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008).

⁴ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003).

⁵ Although the *Rogers* case involved right-of-publicity claims, the Ninth Circuit has held that *Rogers* is not the appropriate test in such cases. See *Elec. Arts v. Davis*, 775 F.3d 1172, 1179 (9th Cir. 2015), *cert. denied*, 136 S. Ct. 1448 (2016). The law regarding right of publicity is not so clear in other circuits, but as this article focuses on Lanham Act claims, we leave an analysis of right-of-publicity claims and the First Amendment for another day.

⁶ *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996), *aff'd without opinion*, 156 F.3d 1225 (3d Cir. 1998).

⁷ *Sugar Busters LLC v. Brennan*, 177 F.3d 258 (5th Cir. 1999); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000).

⁸ *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003); *ETW Corp. v. Jireh Publ'g*, 332 F.3d 915, 937 (6th Cir. 2003).

⁹ *Mattel, Inc.*, 296 F.3d at 902; *E.S.S. Entm't 2000, Inc.*, 547 F.3d at 1099; *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1243 (9th Cir. 2013); *Twentieth Century Fox Television v. Empire Distrib.*, 875 F.3d 1192, 1197-98 (9th Cir. 2017); *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 269-70 (9th Cir. 2018).

¹⁰ *Univ. of Ala. Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266 (11th Cir. 2012).

within the Seventh¹¹ and Tenth Circuits.¹² No courts have rejected the *Rogers* test. In the context of deciding motions for summary judgment and motions to dismiss,¹³ courts have applied the *Rogers* test to both forward and reverse confusion trademark infringement cases¹⁴ as well as false endorsement and false advertising cases.¹⁵

On the other hand, a few federal district court decisions within the Ninth Circuit misinterpreted *Rogers* as applicable only when the asserted mark had an overarching “cultural significance” in the public’s vocabulary, and the junior use referred to the senior one. In 2017, however, the Ninth Circuit stepped in and held that *Rogers* required no such threshold determination.¹⁶

Perhaps the most important substantive development of the decade, however, has been judicial refinement of the second prong of the *Rogers* test—whether the junior use is “explicitly misleading.”

Our first article discussed the *Rogers v. Grimaldi* decision at length, and then undertook a circuit-by-circuit analysis.¹⁷ Here, we analyze in detail how courts have specifically applied the two prongs of the balancing test over the past thirty years and how the test has been applied to both motions to dismiss and summary judgment.

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

¹¹ Eastland Music Grp., LLC v. Lionsgate Entm’t, No. 11 C 8224, 2012 WL 2953188 (N.D. Ill. July 19, 2012), *aff’d without reaching constitutional question*, 707 F.3d 869 (7th Cir. 2013); Fortres Grand Corp. v. Warner Bros. Entm’t, 947 F. Supp. 2d 922, 926-27 (N.D. Ind. 2013), *aff’d without reaching First Amendment constitutional question*, 763 F.3d 696 (7th Cir. 2014), *cert. denied*, 135 S. Ct. 981 (2015).

¹² Stouffer v. Nat’l Geographic Partners, LLC, No. 18-cv-3127-WJM-SKC, 2019 WL 3935180 (D. Colo. Aug. 20, 2019). It has also been adopted by a California state court. See Winchester Mystery House, LLC v. Global Asylum, Inc., 210 Cal. App. 4th 579, 590 (Cal. Ct. App. 2012).

¹³ See discussion, *infra* Part III.C.

¹⁴ Unlike traditional or “forward confusion” cases where a consumer is likely to believe that a junior user’s goods or services emanate from or are associated with the senior user, “reverse confusion” occurs when a typically larger junior user engages in such extensive promotion of goods under the senior user’s mark that the market for the junior user is swamped, resulting in a likelihood that consumers will mistakenly believe that the senior user’s goods emanate from the junior user. See *Fortres Grand Corp.*, 947 F. Supp. 2d at 926-27.

¹⁵ Use of a plaintiff’s name and likeness were at issue in *Brown*, 724 F.3d at 1243 (9th Cir. 2013); *Dickinson v. Ryan Seacrest Enters., Inc.*, No. CV 18-2544-GW, 2018 WL 6112628 at *5 (C.D. Cal. Oct. 1, 2018); and *Brown v. Showtime Networks, Inc.*, No. 18 Civ. 11078, 2019 WL 3798044 at *14-15 (S.D.N.Y. Aug. 2, 2019).

¹⁶ *Twentieth Century Fox Television*, 875 F.3d at 1197-98.

¹⁷ See Kelly & Jordan, *supra* note 2, for a detailed analysis of *Rogers v. Grimaldi* and a circuit-by-circuit analysis.

and Fred” in Italy.¹⁸ The film focused on a televised reunion of the fictional duo and was titled *Ginger and Fred*.¹⁹ Ginger Rogers sued the filmmaker, alleging, among other things, that the title violated her rights under Section 43(a) of the Lanham Act.²⁰ Realizing that applying the Lanham Act in the area of titles might intrude on First Amendment values, the district court granted summary judgment to the defendant, finding that the Lanham Act did not apply to the title of the motion picture because it was a work of artistic expression.²¹ The U.S. Court of Appeals for the Second Circuit affirmed, but held that the district court had interpreted the First Amendment’s impact on the Lanham Act too broadly, concluding that doing so would create a “nearly absolute privilege” for movie titles.²²

While cautioning that First Amendment concerns could not insulate 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 the titles of creative works.²³ Although all consumers have a right not to be misled, consumers of artistic works “also have an interest in enjoying the results of the author’s freedom of expression,” which means “the expressive elements of titles requires more protection than the labelling of ordinary commercial products.”²⁴ Ultimately, 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.”²⁵ In the context of allegedly misleading titles using a celebrity’s name, the Second Circuit explained that this “balance will normally not support application of 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.”²⁶ The court held that this construction of the Lanham Act would best accommodate both consumer and artistic interests, because “it insulates from

¹⁸ *Rogers*, 875 F.2d at 996-97.

¹⁹ *Id.*

²⁰ *Id.* at 997. Section 43(a) of the Lanham Act creates civil liability for any person who uses in connection with any goods or services “any false designation of origin, false or misleading description of fact, or false or misleading representation of fact . . . that is likely to cause confusion.” 15 U.S.C. § 1125(a) (2018).

²¹ *Rogers*, 875 F.2d at 997.

²² *Id.* at 996-97.

²³ *Id.* at 997-98.

²⁴ *Id.* at 998 (“Because overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict.”).

²⁵ *Id.* at 999.

²⁶ *Id.*

restriction titles with at least minimal artistic relevance that are ambiguous or only implicitly misleading but leaves vulnerable to claims of deception titles that are explicitly misleading as to source or content, or that have no artistic relevance at all.”²⁷

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.²⁸

III. SUBSEQUENT APPLICATION OF THE *ROGERS* BALANCING TEST

The *Rogers* test was created to balance the danger of consumer confusion, which trademark law is designed to prevent, with the benefits of free expression, which the First Amendment protects. *Rogers* effectively employs the First Amendment as a rule of construction to avoid conflict between the Constitution and the Lanham Act, and does so by setting certain threshold requirements in cases involving creative works before the Lanham Act will apply. These requirements make up the two “prongs” of the test: (1) determining whether a use has “artistic relevance”; and (2) if so, whether the use is “explicitly misleading.”

A. Artistic Relevance

“The artistic relevance prong ensures that the defendant intended an artistic—*i.e.*, noncommercial—association with the plaintiff’s mark, as opposed to one in which the defendant intends to associate with the mark to exploit its popularity and goodwill.”²⁹ It is not the role of the court to determine *how* meaningful the artistic connection is, but simply that one exists. As a result, the threshold for finding artistic relevance has always been low. Indeed, the Second Circuit established a very low bar in *Rogers*, repeatedly referring to works that had “no artistic relevance” as the only works that would be exempt from further First Amendment consideration.³⁰ The Ninth Circuit has followed suit, holding that “the level of relevance merely must be above zero.”³¹

²⁷ *Id.* at 1000.

²⁸ *Id.* at 1001.

²⁹ *Louis Vuitton Malletier S.A. v. Warner Bros. Entm’t Inc.*, 868 F. Supp. 2d 172, 178 (S.D.N.Y. 2012) (citing *Rogers*, 875 F.2d at 1001, and 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 plaintiff’s mark] but instead had genuine relevance to the film’s story”).

³⁰ *Rogers*, 875 F.2d at 999-1000.

³¹ *E.S.S. Entm’t*, 547 F.3d at 1100.

At first glance, it would appear easy for a court to determine whether use of a mark is artistically relevant to the underlying work. The artistic relevance prong has even been described as a “black-and-white rule [having] the benefit of limiting [a court’s] need to engage in artistic analysis in this context.”³² In reality, however, it isn’t always so easy to apply. Nevertheless, courts have been extremely liberal in finding artistic relevance, even though it isn’t always obvious.³³

For instance, in *Dillinger, LLC v. Electronic Arts, Inc.*, notorious gangster John Dillinger’s estate argued that the appearance of a “Dillinger Level Three Tommy Gun” as a weapon in the *Godfather* video game series infringed its trademark rights in the mark JOHN DILLINGER.³⁴ In particular, the plaintiff argued there was no artistic relevance of the “Dillinger” name to the video game because the *Godfather* novels weren’t set in the time when John Dillinger lived; the novels didn’t involve a John Dillinger character; and no one within defendant’s organization could even remember why the “Dillinger” name was chosen for the weapon.³⁵ In granting summary judgment to defendant Electronic Arts, the court held that it was “not the role of the Court to determine how meaningful the relationship between a trademark and the content of a literary work must be; consistent with *Rogers*, any connection whatsoever is enough for the Court to determine that the mark’s use meets ‘the appropriately low threshold of minimal artistic relevance.’”³⁶ Here, because John Dillinger was widely associated with Tommy Guns, even such a “superficial and attenuated” connection was “above zero.”³⁷

There are many other examples of less-than-obvious artistic relevance meeting the “above zero” standard in video game cases where the inclusion of other parties’ trademarks “increase[s] specific realism of the game.”³⁸ Game manufacturer Activision prevailed on summary judgment in two cases involving elements from its *Call of*

³² *Brown*, 724 F.3d at 1243.

³³ *Roxbury Entm’t v. Penthouse Media Grp., Inc.*, 669 F. Supp. 2d 1170, 1176 (C.D. Cal. 2009) (finding the title ROUTE 66 artistically relevant to a pornographic film because of the film’s setting in part in a roadside motel and the association of “Route 66” with cross-country travel).

³⁴ No. 1:09-cv-36-JMS-DKL, 2011 WL 2457678, at *3 (S.D. Ind. June 16, 2011).

³⁵ *Id.* at *4, *6.

³⁶ *Id.* at *6.

³⁷ *Id.* at *5.

³⁸ *E.g.*, *Novalogic Inc. v. Activision Blizzard*, 41 F. Supp. 3d 885, 900 (C.D. Cal. 2013); *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*, 74 F. Supp. 3d 1134, 1142 (N.D. Cal. 2014); *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); *see also Dillinger*, 2011 WL 2457678, at *6 (“It is not the role of the Court to determine how meaningful the relationship between a trademark and the content of a literary work must be; consistent with *Rogers*, any connection whatsoever is enough.”).

Duty game franchise. In *Novalogic v. Activision Blizzard Inc.*, the court found as a matter of law that Activision's use of the Army's phrase "Delta Force" within the *Call of Duty* video game gave users "a sense of a particularized reality of being part of an actual elite special-forces operation and serve[d] as a means to increase specific realism of the game."³⁹ And in *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*, the court held that Activision's use of the plaintiff's ANGRY MONKEY morale patch within the video game bore "some artistic relevance to the creators' goal of offering players a feeling of personal identity and authenticity during game play."⁴⁰

Sony's use of the plaintiff's VIRAG mark on a racecourse bridge within its *Gran Turismo* racing game was also found to "provide a realistic simulation of European car racing . . . by allowing players to drive on realistic simulations of European race tracks."⁴¹ The court clarified that it need not "determine *exactly* how artistically relevant the VIRAG® mark is to the games," but instead merely had to be able to conclude that the artistic relevance is "above zero," summarizing the standard as a "black-and-white rule."⁴² Despite the defendant's claims to the contrary, the court also noted that whether Sony's use of the VIRAG mark was "for commercial gain *in addition to* . . . for artistic purposes" was "irrelevant."⁴³

The plaintiffs' objections to the defendants' uses of their marks as elements within creative works have also arisen in other contexts, including disputes regarding films, books, and art displays. For example, a defendant's depiction of a fictional cover of the plaintiff's magazine, *The Sporting Times*, featured with the lead character's picture in the film *Spaceman* was found artistically relevant as part of a montage of magazines about the film's sports-star subject;⁴⁴ a depiction of the plaintiff's surfboard, which the plaintiff admitted had "celebrity status" in the surfing community, on the back cover of a fictional book that had a surfing theme was found artistically relevant to the story;⁴⁵ and the inclusion of a drawing based on a scene from a 1923 silent film, which the plaintiff alleged was "one of the most iconic images in cinema," in a

³⁹ *Novalogic*, 41 F. Supp. 3d at 900.

⁴⁰ *Mil-Spec Monkey*, 74 F. Supp. 3d at 1142.

⁴¹ *VIRAG*, 2015 WL 5000102, at *11 (plaintiff was a frequent race sponsor).

⁴² *Id.* at *12.

⁴³ *Id.*; but see *N.Y. Racing Ass'n, Inc. v. Perlmutter Publ'g, Inc.*, No. 95-CV-994 (FJS), 1996 WL 465298, at *5 (N.D.N.Y. July 19, 1996) (court finding that although t-shirts featuring paintings of the actual Saratoga racecourse that included plaintiff's trademarks were artistically relevant, in the case of defendants' products that display paintings where plaintiff's marks were added to the scenes and the mark does not actually exist in the scene depicted, "the balance shifts").

⁴⁴ *Sporting Times, LLC v. Orion Pictures Corp.*, 291 F. Supp. 3d 817, 826 (W.D. Ky. 2017).

⁴⁵ *Stewart Surfboards, Inc. v. Disney Book Grp., LLC*, No. CV 10-2982 GAF, 2011 WL 12877019, at *5 (C.D. Cal. May 11, 2011).

multimedia work displayed in Los Angeles International Airport was found artistically relevant as a tribute to silent movies.⁴⁶ In a case with particularly unusual facts, a different court found that use of a counterfeit LOUIS VUITTON bag in the film *The Hangover II* was artistically relevant because the use was intended to create an artistic association with LOUIS VUITTON, which it did, and thus discovery was irrelevant and unnecessary as to whether Warner Bros. knew the bag was a counterfeit.⁴⁷

In a case involving the title of a work, rather than an element, the court found BITCHIN' KITCHEN artistically relevant as the title of a reality television series.⁴⁸ The Cooking Channel show starred a larger-than-life host who routinely employed sexual innuendo, provocative attire, off-color humor, and recipes such as "Save Your Sex Life Soufflé," and so the court found the title supported the show's content, tone, style, purpose, and intended appeal.⁴⁹

In all of these cases, the courts easily concluded that there was at least an "above zero" level of artistic relevance, and therefore the defendants were all entitled to summary judgment or dismissal of the claims against them under the *Rogers* balancing test. Very few cases have ever held that there was no artistic relevance.⁵⁰ *Parks v. LaFace Records* is often erroneously cited by plaintiffs for that proposition, but the court in *Parks* held only that the level of artistic relevance was insufficient for satisfying *Rogers's* first prong as a matter of law and remanded the case back to the district court for further findings.⁵¹ The musical group Outkast released the song "Rosa Parks," which was not about Rosa Parks or even the Civil Rights movement, but rather was about how Outkast is better than its competitors who must therefore take a "back seat" to them and "move to the back of the bus."⁵² Outkast argued that because the song contained the phrase "move to the back of the bus," use of Parks's name as the title was symbolic or metaphorical.⁵³ The district court agreed, and granted Outkast's motion for summary

⁴⁶ Harold Lloyd Entm't, Inc. v. Moment Factory One, Inc., No. LA CV15-01556 JAK, 2015 WL 12765142, at *10 (C.D. Cal. Oct. 29, 2015).

⁴⁷ *Louis Vuitton Malletier*, 868 F. Supp. at 178.

⁴⁸ Martha Elizabeth, Inc. v. Scripps Networks Interactive, LLC, No. 1:10-cv-1244, 2011 WL 1750711 (W.D. Mich. 2011) (comparing BITCHIN' KITCHEN v. THE BITCHEN KITCHEN).

⁴⁹ *Id.*

⁵⁰ One such example is *N.Y. Racing Ass'n*, in which the court found that incorporating plaintiff's trademarks into actual depictions of the Saratoga racecourse was artistically relevant, but adding the marks to scenes where they do not exist in real life made a finding of artistic relevance "virtually non-existent." 1996 WL 465298, at *5.

⁵¹ 329 F.3d 437 (6th Cir. 2003).

⁵² *Id.* at 452-53.

⁵³ *Id.* at 454.

judgment.⁵⁴ The Sixth Circuit reversed, finding that it could not be said *as a matter of law* that the title was artistically relevant to the song itself.⁵⁵ If the requirement of “relevance” in “artistic relevance” is to have any meaning, the court believed “it would not be unreasonable to conclude that the title *Rosa Parks* is *not* relevant to the content of the song in question.”⁵⁶ The case ultimately settled without any more factual findings or a determination whether the title was artistically relevant to the song.⁵⁷

In 2010, a series of district court cases within the Ninth Circuit began reading additional requirements into the artistic relevance part of the *Rogers* test. In *Rebellion, LLC v. Armando C. Perez*,⁵⁸ a Northern District of California court held that although the Ninth Circuit had adopted the *Rogers* test, “it has placed an important threshold limitation upon its application: plaintiff’s mark must be of such cultural significance that it has become an integral part of the public’s vocabulary.”⁵⁹ According to the court, the relevant inquiry was thus the “artistic relevance of defendant’s use of the mark related to the meaning associated with *plaintiff’s* mark.”⁶⁰

The plaintiffs in that case, whose reggae band was called “Rebellion,” sought to enjoin the defendant, Perez, known by his performance title “Pitbull,” from using the identical mark REBELUTION for an album title.⁶¹ Although Perez argued that “Rebellion” was artistically relevant to his album because the word was a made-up amalgamation of “rebel,” “revolution,” and “evolution” and symbolized his personal artistic struggles, the court found that his use was not artistically relevant as related to the meaning of the mark associated with *plaintiff’s* band.⁶² In fact, the defendant argued that he had never heard of the plaintiff’s band.⁶³ Because the plaintiffs’ mark had no independent cultural significance, and the defendant’s use did not refer to the plaintiffs’ band, the court found that there was no artistic relevance and

⁵⁴ *Id.*

⁵⁵ *Id.* at 459.

⁵⁶ *Id.* at 453.

⁵⁷ *See also Seale*, 949 F. Supp. at 340 (finding use of plaintiff’s name on film about the history of the Black Panther Party and book about the film was artistically relevant as a matter of law, but factual issues precluded summary judgment as to whether use of name was artistically relevant on the cover of a soundtrack of songs unrelated to plaintiff or the history of the Black Panther Party).

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

⁵⁹ *Id.* at 887.

⁶⁰ *Id.* at 889 (emphasis added).

⁶¹ *Id.* at 886.

⁶² *Id.* at 889.

⁶³ *Id.*

concluded that the use failed to meet the first prong of the *Rogers* test.⁶⁴

That same month, in a dispute between the maker of CAKEBOSS bakery software and Discovery Channel's CAKE BOSS television series title, a district court in the District Court for the Western District of Washington similarly held that the infringement claim against the Discovery Channel did not implicate the First Amendment interests recognized by the Ninth Circuit in *Mattel* and *Rogers* because "Discovery did not choose the name of *Cake Boss* as an allusion to *CakeBoss*" software, which the court found in any event had not attained cultural significance beyond its source-identifying function.⁶⁵

Other district courts quickly rejected the reasoning in these "outlier" cases,⁶⁶ pointing to the Ninth Circuit's own language in *E.S.S. Entertainment v. Rock Star Videos*,⁶⁷ which, in turn, drew from the *Mattel, Inc. v. MCA Records, Inc.*, the case in which the Ninth Circuit expressly adopted the *Rogers* test as its own.⁶⁸ In *E.S.S. Entertainment*, the Ninth Circuit considered whether the defendant's depiction of a fictional "Pig Pen" strip club in a video game infringed rights in a real-life "Play Pen" strip club.⁶⁹ The

⁶⁴ *Id.*

⁶⁵ *Masters Software, Inc., v. Discovery Commc'ns, Inc.*, 725 F. Supp. 2d 1294, 1306 (W.D. Wash. 2010); *see also* *Dita, Inc. v. Mendez*, No. CV 10-6277 PSG, 2010 WL 5140855, at *3 (C.D. Cal. Dec. 14, 2010); *Warner Bros. Entm't v. Global Asylum, Inc.*, No. CV 12-9547 PSG, 2012 WL 6951315, at *17 (C.D. Cal. Dec. 10, 2012). Notably, this seems to be the same type of argument that the district court in Minnesota used to find *Rogers v. Grimaldi* inapplicable many years earlier in *American Dairy Queen Corp. v. New Line Productions, Inc.*, 35 F. Supp. 2d 727, 734-35 (D. Minn. 1998).

⁶⁶ *See Mil-Spec Monkey*, 74 F. Supp. 3d at 1140-41 (calling *Rebellion* an "outlier" and pointing to the Ninth Circuit's earlier decision in *E.S.S. Entm't v. Rock Star Videos*). The *Mil-Spec* court specifically noted that the fact that *Mattel's* BARBIE mark had "made its way into the global lexicon does not mean that every mark must do so in order for its use to be protected by the First Amendment." *See also Stewart Surfboards*, 2011 U.S. Dist. LEXIS 155444, at *17 (expressly stating that it does not read the Ninth Circuit's adoption of *Rogers* as limited to cases where the mark has cultural significance, noting that "the Ninth Circuit made clear in *E.S.S. Entertainment* that a defendant's work need not be 'about' the [plaintiff's] trademark or what the trademark signifies," so long as the use has some relevance to *defendant's* work); *Webceleb, Inc. v. Procter & Gamble Co.*, No. 10cv2318 DMS (BLM), 2012 U.S. Dist. LEXIS 188117, at *15-16 (S.D. Cal. Sept. 25, 2012) (noting that the plaintiff had cited district court cases requiring that the mark have "cultural significance" and be referential to plaintiff's mark for *Rogers* to apply, which defendant's mark did not, the court pointed out that the Ninth Circuit had "specifically rejected this argument," citing *E.S.S.* Specifically, the court found that "Defendants need not refer to Plaintiff's product to meet the element of artistic relevance. Indeed, Defendants' use of the term has to be artistically relevant to their own product, not Plaintiff's product."); *Rebellion Devs. Ltd. v. Stardock Entm't, Inc.*, No. 12-12805, 2013 WL 1944888, at *3 (E.D. Mich. May 9, 2013) ("This referential requirement is simply not required by either prong of the *Rogers* test.").

⁶⁷ 547 F.3d 1095 (9th Cir. 2008).

⁶⁸ *Mattel*, 296 F.3d at 902.

⁶⁹ *E.S.S. Entm't*, 547 F.3d. at 1097.

plaintiff argued that use of “Pig Pen” had no artistic relevance and was explicitly misleading, resting its argument on the facts that “(1) the Game [was] not ‘about’ E.S.S.’s Play Pen Club the way that ‘Barbie Girl’ was ‘about’ the Barbie Doll in *MCA Records*; and (2) also unlike the [*Mattel*] case, where the trademark and trade dress at issue was a cultural icon (Barbie), the Play Pen [strip club] is not a cultural icon.”⁷⁰ The Ninth Circuit held that ESS’s objections, though factually accurate, missed the point.⁷¹ It did not matter that the game wasn’t “about” the plaintiff’s club; as long as the fictional Pig Pen club had some plausible level of artistic relevance to the defendant’s game (which it did), its name met the required “low threshold” of artistic relevance.⁷²

In *Twentieth Century Fox Television v. Empire Distribution, Inc.*, the Ninth Circuit finally addressed the question of whether the mark at issue must have obtained some “cultural significance.”⁷³ In that case, Fox sought a declaratory judgment that its use of the word “Empire” as the title of a television series about a fictional music label called “Empire Enterprises” did not infringe trademark rights held by a real-life record label called “Empire Distribution.”⁷⁴ Affirming summary judgment in favor of Fox, the Ninth Circuit first addressed the declaratory-judgment defendant’s argument that a “threshold requirement” for applying *Rogers v. Grimaldi* was whether the mark at issue—EMPIRE—had attained a meaning beyond its source-identifying function.⁷⁵ Acknowledging that trademark suits “often arise when a brand name enters common parlance and comes to signify something more than the brand itself,” the court nevertheless confirmed that this was not a requirement, noting that “we apply the *Rogers* test in other cases as well.”⁷⁶ Instead, the court held that “the only threshold requirement for the *Rogers* test is an attempt to apply the Lanham Act to First Amendment expression.”⁷⁷

⁷⁰ *Id.* at 1100.

⁷¹ *Id.*

⁷² *Id.*

⁷³ 875 F.3d 1192 (9th Cir. 2017). Just a few weeks earlier, the Ninth Circuit had reached the same conclusion, but without discussion. *VIRAG*, 699 F. App’x at 668 (holding “[t]he test set forth in *Rogers v. Grimaldi* . . . applies regardless whether the *VIRAG* trademark has independent cultural significance . . . or Sony’s use of the trademark within the video game serves to communicate a message other than the source of the trademark”). See also *Brown*, 724 F.3d at 1235 (Although not involving the association issue, in applying *Rogers v. Grimaldi* the court emphatically stated that the “interpretation of the ‘artistic relevance’ prong of the *Rogers* test in *E.S.S.* [was] correct.”).

⁷⁴ *Twentieth Century Fox*, 875 F.3d at 1195.

⁷⁵ See *id.* at 1197-98.

⁷⁶ *Id.* at 1197.

⁷⁷ *Id.* at 1198. See also *VIRAG*, 699 F. App’x at 668; but see *IOW, LLC v. Michael Breus & Lauren Breus*, No. CV18-1649-PHX-DGC, 2019 WL 4010737, at *12 (D. Ariz. Aug. 26, 2019) for a recent case from a district court within the Ninth Circuit denying summary

This is not to say that the cultural significance of a mark may never be relevant. As the Ninth Circuit acknowledged in the *Empire* case, trademarks transcending their identifying purpose are more likely to be used in artistically relevant ways, and trademarks that have no meaning beyond their source-identifying function are more likely to be used in ways that have no artistic relevance to the underlying work whatsoever if they merely borrow another's property to get attention.⁷⁸

The Ninth Circuit found that Fox used the common English word “empire” for artistically relevant reasons, namely because the show was set in the Empire State (New York) and its subject matter was a family music “empire.”⁷⁹ Conceding that Fox’s *Empire* title was relevant to its series in that sense, the declaratory-judgment defendant nevertheless argued that the relevant inquiry was not whether Fox’s title referred to characteristics of Fox’s own series, but whether it referred to Empire Distribution’s music label.⁸⁰ But the court was also clear on this point: “This referential requirement does not appear in the text of the *Rogers* test, and such a requirement would be inconsistent with the purpose of the first prong of *Rogers*.”⁸¹ Because there was at least some level of artistic relevance, the first prong of *Rogers v. Grimaldi* was satisfied.

Closing the door to further misinterpretation, the Ninth Circuit spelled out exactly “how a work fails the first prong of the *Rogers* test: by bearing a title which has no artistic relevance to the work. A title may have artistic relevance by linking the work to another mark, as with ‘Barbie Girl,’ or it may have artistic relevance by supporting the themes and geographic setting of the work, as with *Empire*. Reference to another work may be a component of artistic relevance, but it is not a prerequisite.”⁸²

The Ninth Circuit’s resolution of the “cultural significance” question also made clear that *Rogers* applies in reverse confusion cases. In a case involving a fictional software product called CLEAN SLATE in the Batman film *The Dark Knight Rises*, the plaintiff alleged that use of that mark for the fictional software in the film

judgment to defendants’ use of non-fiction book title, erroneously citing *Rebellion* and other superseded district court cases and finding “no demonstrated independent expressive, artistic, or cultural meaning apart from its content-describing function,” therefor the use “implicates none of the First Amendment concerns that *Rogers* was adopted to safeguard.”

⁷⁸ *Twentieth Century Fox*, 875 F.3d at 1198 (citing *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997) (holding that an account of the O.J. Simpson murder trial titled “The Cat NOT in the Hat!” borrowed Dr. Seuss’s trademark and poetic style only to “get attention’ or maybe even ‘to avoid the drudgery in working up something fresh”).).

⁷⁹ 875 F.3d at 1198.

⁸⁰ *Id.*

⁸¹ *Id.*

⁸² *Id.* at 1199.

infringed its rights in its own real-life CLEAN SLATE software product.⁸³ Because the defendant Warner Bros. was the much larger user and extensively advertised and promoted its movie, the plaintiff argued that the defendant's use was likely to cause "reverse confusion," and that *Rogers* applied only to cases involving traditional forward confusion.⁸⁴ The plaintiff's argument was based on its belief that *Rogers* applied only to marks that had cultural significance, and only when a defendant used the mark to reference the senior use. "In other words, in a case of reverse confusion the defendant is not trying to use the plaintiff's mark expressively, or availing itself illegitimately of the plaintiff's reputation—the foundational rationale of *Rogers* and its progeny."⁸⁵ The court disagreed, holding definitively that "the *Rogers* test applies to reverse confusion cases."⁸⁶ The court separately held that, even in a traditional reverse likelihood-of-confusion case not implicating First Amendment concerns, the plaintiff could not prevail because no reasonable consumer would believe that Fortres Grand's software emanated from Warner Bros.⁸⁷ The plaintiff appealed only this latter ruling. In upholding the grant of Warner Bros.' motion to dismiss because the allegations of reverse confusion were "too implausible to support costly litigation," the Seventh Circuit did not weigh in on the district court's finding that *Rogers* applied to reverse confusion cases.⁸⁸ Presumably, however, with the "cultural significance" issue firmly put to rest by the Ninth Circuit, there is no reason for courts not to apply the *Rogers* test in reverse confusion cases involving creative works.⁸⁹

B. Explicitly Misleading

Although the "above zero" standard for meeting the artistic-relevance prong appears to be consistent across all circuits that have applied *Rogers*,⁹⁰ the method for determining whether a use is explicitly misleading is not, as shown below.

⁸³ *Fortres Grand Corp.*, 947 F. Supp. 2d at 924.

⁸⁴ *Id.* at 932. See discussion *supra* note 14.

⁸⁵ *Id.*

⁸⁶ *Id.* at 933 (citing other cases where *Rogers* has been applied to reverse confusion cases, namely *Webceleb*, 2012 U.S. Dist. LEXIS 188117 and *DeClemente v. Columbia Pictures Indus.*, 860 F. Supp. 30 (E.D.N.Y. 1994)). See also *Martha Elizabeth, Inc.*, 2011 WL 1750711.

⁸⁷ *Fortres Grand Corp.*, 947 F. Supp. 2d at 930-31.

⁸⁸ *Fortres Grand Corp.*, 763 F.3d at 696.

⁸⁹ *Twentieth Century Fox*, 875 F.3d at 1198. This "cultural significance" argument was the same used by the plaintiff in *Masters Software*, 725 F. Supp. 2d at 1294 to argue that *Rogers* was inapplicable in its reverse confusion case.

⁹⁰ *But see Stouffer*, 2019 WL 3935180, *3, discussed *supra* Part III.5.

1. “Explicitly Misleading” in the Second Circuit

When the Second Circuit created its balancing test in *Rogers v. Grimaldi*, it thoroughly analyzed the phrase “explicitly misleading.” Examples the court gave of what would be explicitly misleading as to *source* included NIMMER ON COPYRIGHT and JANE FONDA’S WORKOUT BOOK, for works where neither Mr. Nimmer nor Ms. Fonda were associated, or “an authorized biography” when the subject had not given authorization at all.⁹¹ The court gave use of the title THE TRUE LIFE STORY OF GINGER AND FRED as an illustration of the type of use of Ms. Rogers’s name that would have explicitly misled as to *content*, since the film, in fact, was about an Italian couple known as the “Ginger and Fred” of Italy.⁹² In giving these examples and explaining what was required, the court used the word “explicit,” which is defined as “stated clearly and in detail, leaving no room for confusion or doubt,”⁹³ more than ten times, and contrasted it with uses where the title might *implicitly* suggest an endorsement or association.⁹⁴ Where the possibility of confusion exists only because of an implicit suggestion, that risk is “outweighed by the danger of restricting artistic expression.”⁹⁵ Acknowledging that “some members of the public would draw the incorrect inference that Rogers had some involvement with the film” by reason of its title, the court nevertheless held that “that risk of misunderstanding, *not engendered by any overt claim in the title*, is so outweighed by the interests in artistic expression as to preclude application of the Lanham Act.”⁹⁶ To drive the point home, the court held emphatically that a “possibly misleading meaning *not the result of explicit misstatement*[] precludes a Lanham Act claim.”⁹⁷

Although the *Rogers* court believed that “in general 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,” the specific holding of the case was more narrow: “In the context of allegedly misleading titles using a celebrity’s name, that balance 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 explicitly misleads as to the source or the content of

⁹¹ *Rogers*, 875 F.2d at 999.

⁹² *Id.* at 1000.

⁹³ *Explicit*, Oxford Dictionaries, <https://en.oxforddictionaries.com/definition/explicit> (last visited Jan. 8, 2019).

⁹⁴ *Implicitly* is defined as “in a way that is not directly expressed; tacitly.” *Implicitly*, Oxford Dictionaries, <https://en.oxforddictionaries.com/definition/implicitly> (last visited Aug. 5, 2019).

⁹⁵ *Rogers*, 875 F.2d at 1000.

⁹⁶ *Id.* at 1001 (emphasis added).

⁹⁷ *Id.* (emphasis added).

the work.”⁹⁸ Making it arguably narrower still, the court dropped in footnote 5: “This limiting construction would not apply to misleading titles that are confusingly similar to other titles. The public interest in sparing consumers this type of confusion outweighs the slight public interest in permitting authors to use such titles.”⁹⁹

Although it appears that footnote 5 was meant only to exempt disputes between titles from the specific requirement that the defendants have engaged in an *explicitly misleading act* rather than its broader interpretation that the Lanham Act should be construed narrowly in cases involving artistic works, the footnote cast some doubt over whether the *Rogers* balancing test would apply *at all* in competing title cases.¹⁰⁰ That doubt was quickly resolved, however, by the Second Circuit’s later decisions in *Cliffs Notes* and *Twin Peaks*.

Just four months after issuing *Rogers*, the Second Circuit faced another dispute involving an expressive work, but this time instead of a false endorsement claim, the dispute hinged on whether the cover of *Spy Notes*, a parody of the popular *Cliffs Notes* study guides, constituted trademark infringement.¹⁰¹ Applying the traditional *Polaroid* likelihood-of-confusion factors,¹⁰² the district court had concluded that there was “a very strong” and “profound likelihood of confusion.”¹⁰³ Although it “seriously doubt[ed] whether the special balancing test enunciated in *Rogers*” would apply to a non-title case, the district court nonetheless believed that the plaintiff should prevail “[e]ven adopting the standard used by the *Rogers* Court.”¹⁰⁴ However, in making that finding, the district court did not undertake the two-part *Rogers* analysis, but instead merely

⁹⁸ *Id.* at 999.

⁹⁹ *Id.* at 999 n.5.

¹⁰⁰ See *Tri-Star Pictures, Inc. v. Leisure Time Prods., B.V.*, 749 F. Supp. 1243, 1252-53 (S.D.N.Y. 1990) (finding *Rogers* not applicable in a case involving two titles based on footnote 5).

¹⁰¹ *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 718 F. Supp. 1159, 1160 (S.D.N.Y. 1989).

¹⁰² The *Polaroid* factors 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. Other circuits use similar multi-factor tests.

¹⁰³ *Cliffs Notes*, 718 F. Supp. at 1168.

¹⁰⁴ *Id.* at 1163, 1168. The court elaborated that its belief that “[a] cover that sends the message, ‘This is a Cliff’s Notes product,’ explicitly sends the message that Cliff’s endorsed the product, and this message brings *Spy Notes* within the purview of the Lanham Act.”

concluded that because there was a likelihood of confusion the use was explicitly misleading, and it issued a preliminary injunction.¹⁰⁵

On appeal, the Second Circuit rejected the assumption that the *Rogers* test was limited to false endorsement cases, and definitively found that “the overall balancing approach of *Rogers* and its emphasis on construing the Lanham Act ‘narrowly’ when First Amendment values are involved” were applicable.¹⁰⁶ Moreover, the plaintiff argued that *Rogers* was inapplicable because it “does not protect ‘misleading titles that are confusingly similar to other titles,’” which were part of the overall book covers.¹⁰⁷ The Second Circuit disagreed, however, clarifying that its earlier “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.”¹⁰⁸ Emphatically, the court stated: “we hold that the *Rogers* balancing approach is generally applicable to Lanham Act claims against works of artistic expression . . . [because] this approach takes into account the ultimate test in trademark law, namely, the likelihood of confusion.”¹⁰⁹

Vacating the preliminary injunction, the Second Circuit held that “the district court erred as a matter of law in concluding on the record before it that there was a strong likelihood of confusion” because it did not give proper weight to the defendant’s First Amendment considerations.¹¹⁰ In a footnote, and with no elaboration, the court noted: “[A]s is clear from the above discussion, we also believe that the district court’s finding that the cover of *Spy Notes* is explicitly misleading is clearly erroneous.”¹¹¹

A few years later, the District Court for the Southern District of New York rendered its opinion in *Girl Scouts v. Bantam Doubleday*.¹¹² In response to the plaintiff’s urging that the court apply the *Polaroid* factors to its claim that use of the term SCOUTS in the title and content of the defendant’s books infringed plaintiff’s mark, the court believed that it was “possibly not required to do so

¹⁰⁵ *Id.* at 1168.

¹⁰⁶ *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 494 (2d Cir. 1989).

¹⁰⁷ *Id.*

¹⁰⁸ *Id.*

¹⁰⁹ *Id.* at 495. The court noted that “the *Polaroid* test is at best awkward in the context of parody” and thus “should be applied with proper weight given to First Amendment considerations.” *Id.* at 495 n.3.

¹¹⁰ *Id.* at 497.

¹¹¹ *Id.* at 497 n.6.

¹¹² 808 F. Supp. 1112 (S.D.N.Y. 1992).

in light of *Cliffs Notes* and *Rogers*.”¹¹³ Ultimately, however, the court did consider the *Polaroid* factors, but concluded that although the defendant’s use of its title and content “could engender some consumer confusion as to source, no overt references to Plaintiffs’ trademarks” were made.¹¹⁴ Thus, applying the *Rogers* balancing test, it granted summary judgment to defendant.¹¹⁵

The following year, the First Amendment issue was back before the Second Circuit in a case directly involving competing titles.¹¹⁶ The District Court for the Southern District of New York had found that the television show title TWIN PEAKS was infringed by a compendium book title WELCOME TO TWIN PEAKS: A COMPLETE GUIDE TO WHO’S WHO AND WHAT’S WHAT, based solely on its assessment that “a substantial number of reasonably prudent purchasers, on seeing the name Twin Peaks as part of the title of the Book would be led to believe that plaintiff was the source of the goods.”¹¹⁷ The district court had reached this conclusion without considering the defendant’s First Amendment rights.¹¹⁸ Finding this to be clearly erroneous, the Second Circuit found “little question” that the title was artistically relevant to the defendant’s book, and then considered “whether the title is misleading in the sense that it induces members of the public to believe the Book was prepared or otherwise authorized” by the plaintiff.¹¹⁹ Instead of looking at whether the defendant had made any *explicit* statements about this, as the *Rogers* court had done, presumably because the case was a dispute between titles and covered by footnote 5, the court instead held that “[t]his determination must be made, in the first instance, by application of the venerable *Polaroid* [likelihood-of-confusion] factors.”¹²⁰ If, after applying the *Polaroid* factors, a likelihood of confusion is found, it must be “particularly compelling to outweigh the First Amendment interest recognized in *Rogers*.”¹²¹

Notably, Judge Newman, author of the *Rogers* opinion, also penned the *Twin Peaks* opinion and was on the panel that decided *Cliffs Notes*, which should quell any arguments that these decisions are inconsistent or that the *Rogers* test does not apply to title-

¹¹³ *Id.* at 1122 (“In neither *Cliffs Notes* nor *Rogers* did the Second Circuit explicitly employ the *Polaroid* factors in weighing the trademark rights of the plaintiffs against the First Amendment implications of artistic expression.”).

¹¹⁴ *Id.* at 1130 (emphasis added).

¹¹⁵ *Id.* at 1119.

¹¹⁶ *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366 (2d Cir. 1993).

¹¹⁷ *Twin Peaks Prods., Inc. v. Publ’ns Int’l*, 778 F. Supp. 1247, 1252 (S.D.N.Y. 1991).

¹¹⁸ *Id.*

¹¹⁹ *Twin Peaks*, 996 F.2d at 1379.

¹²⁰ *Id.* It remanded the case back to the District Court for an assessment of the likelihood-of-confusion factors.

¹²¹ *Id.*

versus-title cases. Rather, these three cases represent an evolution of the principal that the Lanham Act must be construed narrowly when First Amendment rights are implicated and provide a roadmap for how that is to be done.¹²²

Shortly after this trilogy of Second Circuit cases, the District Court for the Southern District of New York decided a dispute between the titles THE BOOK OF VIRTUES and THE CHILDREN'S BOOK OF VIRTUES.¹²³ The defendant argued that its title was not infringing because it had not engaged in explicit misstatements.¹²⁴ The district court disagreed. Examining footnote 5 in the *Rogers* opinion and the later application of *Rogers* in *Cliffs Notes* and *Twin Peaks*, the district court concluded that "*Rogers* did not require that such a test be applied when a title is misleadingly similar to another title. Rather, *Rogers* set forth a balancing approach 'generally applicable to Lanham Act claims against works of literary expression.'"¹²⁵ The court believed that "[the defendant's] argument that its titles do not 'explicitly mislead' (i.e., [the defendant's] books are not titled 'William Bennett's Book of Virtues') misses the mark."¹²⁶ Instead, the court held in this dispute between two competing titles that the likelihood-of-confusion factors should be applied, and any likelihood of confusion would have to be particularly compelling to outweigh the First Amendment.¹²⁷ After careful consideration, the court found the likelihood of confusion sufficiently compelling to outweigh any potential First Amendment interests, and enjoined the defendant's use.¹²⁸ Although explicit misstatements were not required, the defendant's actions were nevertheless relevant, as the district court found that defendant had deliberately selected the title "in a blatant and ill-conceived effort to piggy-back on the good will associated with [plaintiff's] best-selling title."¹²⁹

In the following years, numerous federal district courts within the Second Circuit applied the *Rogers* balancing test in cases involving artistic works. The vast majority involved disputes between titles. In each of those cases, the district courts followed the mandate set forth in *Twin Peaks* that they must first apply the *Polaroid* factors in competing title cases to determine whether there

¹²² Numerous district court cases within the Second Circuit have subsequently applied the *Rogers* balancing test in title versus title cases. See, e.g., *Simon & Schuster, Inc. v. Dove Audio, Inc.*, 970 F. Supp. 279 (S.D.N.Y. 1997).

¹²³ *Id.*

¹²⁴ *Id.* at 296.

¹²⁵ *Id.*

¹²⁶ *Id.*

¹²⁷ *Id.*

¹²⁸ *Id.* at 300.

¹²⁹ *Id.* at 301.

is a likelihood of confusion. If there is no likelihood-of-confusion, the analysis is complete. If, on the other hand, there is a likelihood of confusion, the use will be found infringing only if the court finds it a “particularly compelling” likelihood of confusion that renders the title explicitly misleading.¹³⁰

Only a few of the district court cases within the Second Circuit applying *Rogers* have *not* involved two titles of competing creative works, including the four most recent cases from the District Court for the Southern District of New York.

In *Cummings v. Soul Train Holdings LLC*,¹³¹ the district court granted the defendant’s motion to dismiss a Lanham Act false-endorsement claim alleging that the inclusion of the plaintiff’s image, likeness, and voice in DVD sets containing a television program in which he had appeared violated his rights, finding that the plaintiff failed “to plead facts showing that Defendants *explicitly* misled consumers, as required by Second Circuit law.”¹³² In finding that the defendant’s use was not explicitly misleading, the court noted that the complaint contained “only conclusory allegations that Defendants’ inclusion of Plaintiff in the DVD sets and promotional materials ‘caused confusion and mistake to consumers, would-be consumers, [and] fans,’” which did not “suffice to plead that Defendants’ inclusion of Plaintiff ‘explicitly misleads as to the source or content of the work.’”¹³³ Because this was not a dispute between titles, but rather a false endorsement case, the court proceeded as the original *Rogers* court had and looked only for explicit misstatements or overt actions. The court neither mentioned *Twin Peaks* nor undertook an analysis of the *Polaroid* likelihood-of-confusion factors.

In *Medina v. Dash Films, Inc.*, the district court dismissed a claim that the title LOISIDAS for a video series infringed the rights in a band called “Loisidas.”¹³⁴ Finding that the complaint was “devoid of concrete allegations that defendants attempted to suggest that the plaintiff’s duo produced the work,” the court noted that the materials promoting the work truthfully informed the reader that defendants were the producers.¹³⁵ The court also noted that there was nothing to show that the title of the video series would be

¹³⁰ *Lemme v. NBC, Inc.*, 472 F. Supp. 2d 433, 446 (E.D.N.Y. 2007); *Syler v. Woodruff*, 610 F. Supp. 2d 256, 265 (S.D.N.Y. 2009); *Communico, Ltd. v. DecisionWise, Inc.*, No. 3:14-CV-1887 (RNC), 2018 WL 1525711, at *8 (D. Conn. Mar. 28, 2018).

¹³¹ 67 F. Supp. 3d 599 (S.D.N.Y. 2014).

¹³² *Id.* at 605.

¹³³ *Id.* at 606 (citing *Brown*, 724 F.3d at 1239, 1248 (noting that, while complaint alleged video game had “no artistic relevance” and defendant “attempted to mislead consumers about [plaintiff’s] involvement” in video game, “none of the facts asserted in support of these legal conclusions actually justify the conclusions.”)).

¹³⁴ No. 15-cv-2552 (KBF), 2016 WL 3906714, at *6 (S.D.N.Y. July 14, 2016).

¹³⁵ *Id.* at *5.

viewed as a source identifier.¹³⁶ And, as in *Rogers*, the *Medina* court did not undertake an analysis of the *Polaroid* factors.

Next, a district court in the Southern District of New York decided whether the characters and lettering style of the title of a play entitled *Who's Holiday!* meant to parody the Dr. Seuss book *The Grinch Who Stole Christmas* were protected by the First Amendment under *Rogers*.¹³⁷ In granting the motion to dismiss the trademark infringement claims, the court simply concluded that any risk of consumer confusion was outweighed by public interest in free expression.¹³⁸ It mentioned neither the *Polaroid* factors nor *Twin Peaks*. On appeal, the Second Circuit held in an unpublished opinion that the *Rogers* balancing test applied, and agreed with the district court that “the public’s interest in free speech here outweighs [plaintiff’s] interest in protecting its trademarks.”¹³⁹

Finally, in the most recent case out of the Second Circuit, a district court dismissed a false endorsement claim made by Bobby Brown against Showtime networks for using footage of him in a documentary about his late wife Whitney Houston.¹⁴⁰ After finding use of the footage artistically relevant to the film, the court dismissed the claim, finding that plaintiff had not pled any facts demonstrating that Showtime’s use of the footage was explicitly misleading as to source or content of the film. As the case was not a dispute between titles, it made no mention of the *Polaroid* factors.

In summary, a careful review of the decisions rendered by courts in the Second Circuit in the thirty years since *Rogers* leads to the conclusion that in the Second Circuit, the two-part balancing test is generally applicable to all Lanham Act claims involving artistic works. In cases where an artistic work allegedly infringes another party’s trademark rights, courts will find the use explicitly misleading only where the defendant engaged in an overt act or express misstatement. Mere use of the mark alone will not be sufficient, even if some consumers may be confused, unless the defendant did something to engender the confusion. In cases involving two competing titles, however, courts will determine whether the use is explicitly misleading by first considering the *Polaroid* factors, and, if a likelihood of confusion is found, the court will determine whether it is of a sufficiently compelling level to outweigh First Amendment concerns.

¹³⁶ *See id.*

¹³⁷ *Lombardo v. Dr. Seuss Enters., L.P.*, 279 F. Supp. 3d 497, 514 (S.D.N.Y. 2017).

¹³⁸ *Id.*

¹³⁹ *Lombardo v. Dr. Seuss Enters., L.P.*, 729 F. App’x 131 (2d Cir. 2018) (unpublished opinion).

¹⁴⁰ *Brown v. Showtime Networks, Inc.*, No. 18 Civ. 11078 (CM)(JLC), 2019 WL 3798044 at *15 (S.D.N.Y. Aug. 2, 2019).

2. “Explicitly Misleading” in the Fifth Circuit

The Fifth Circuit has stated that it “has adopted the Second Circuit’s approach,”¹⁴¹ but interestingly it determines whether a use is explicitly misleading by applying the likelihood-of-confusion factors even in cases *not* involving disputes between titles. In *Westchester Media v. PRL USA Holdings, Inc.*, the court was tasked with determining whether use of POLO for a magazine title infringed the trademark rights of the Ralph Lauren POLO brand.¹⁴² In a bench trial, the District Court for the Southern District of Texas found a likelihood of confusion and permanently enjoined use of the magazine title.¹⁴³ The Fifth Circuit affirmed the finding of likelihood of confusion and that it was particularly compelling, but remanded the case back to the district court for a determination of the appropriate remedy.¹⁴⁴ Other than as part of considering the likelihood-of-confusion analysis, the court did not look for any overt actions or misstatements as the determining factor of whether the use of the magazine title was explicitly misleading, as would have been done by the Second Circuit.

Only one subsequent district court case within the Fifth Circuit has involved *Rogers*.¹⁴⁵ In that case, Beyoncé’s song “Formation” included short clips of a comedian/performance artist reciting lines from his works. The comedian’s estate alleged that the unauthorized inclusion of the lines in his voice constituted false endorsement.¹⁴⁶ The court found that that plaintiffs’ allegations that Beyoncé had “used and exploited” his voice as “the seed from which the entire song grows” and “failed to give credit or compensation” for the use was sufficient evidence that her conduct had been explicitly misleading to survive the motion to dismiss.¹⁴⁷ This was not a decision on the merits, and the court did not mention or engage in an analysis of the likelihood-of-confusion factors.

3. “Explicitly Misleading” in the Ninth Circuit

In stark contrast, the likelihood-of-confusion factors are never considered in the Ninth Circuit, even in cases involving competing titles.

¹⁴¹ *Westchester Media Co. v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665 (5d Cir. 2000) (citing *Sugar Busters, LLC v. Brennan*, 177 F.3d 258, 269 n.7 (5th Cir. 1999)).

¹⁴² *Westchester*, 214 F.3d at 663 (affirming declaratory judgment that magazine title was infringing).

¹⁴³ *Westchester Media Co. v. PRL USA Holdings, Inc.*, 103 F. Supp. 2d 935, 1008-10 (S.D. Tex. 1999).

¹⁴⁴ *Westchester Media*, 214 F.3d at 675.

¹⁴⁵ *Estate of Barre v. Carter*, 272 F. Supp. 3d 906 (E.D. La. 2017).

¹⁴⁶ *Id.* at 945.

¹⁴⁷ *Id.* at 946.

When the Ninth Circuit “adopt[ed] the *Rogers* standard as [its] own” in 2002, it did so in the context of a case involving use of a non-artistic mark (BARBIE for a doll) as the title of an artistic work (BARBIE GIRL for a song title).¹⁴⁸ Because the *Mattel* case, like the *Rogers* case, did not involve a dispute between artistic titles, there was no need for the court to consider *Rogers*’s footnote 5 or to consider the likelihood-of-confusion factors.¹⁴⁹ Inevitably, however, title dispute cases were brought in federal district courts within the Ninth Circuit, and alleged infringers raised questions regarding footnote 5.

In *Kiedis v. Showtime Networks*, the band Red Hot Chili Peppers alleged that the Showtime television series title CALIFORNICATION infringed its rights in its identically titled record album.¹⁵⁰ In denying Showtime’s motion to dismiss, the District Court for the Central District of California assumed that when the Ninth Circuit “adopted the reasoning of *Rogers*, it adopted all of *Rogers*, and not just the part that was relevant to the decision in [*Mattel*].”¹⁵¹ Thus, the court believed that footnote 5 in *Rogers* precluded it from holding “as a matter of law, that Defendants are entitled to the across-the-board protection of the two-part test used in the [*Mattel*] case.”¹⁵² However, the court stated that “when the facts are fully developed, the two uses of ‘Californication’ [could] turn out not to be confusingly similar in the contexts in which they are found” but that was “a factual issue not appropriate for resolution without examining the evidence.”¹⁵³

Just a few months later, the District Court for the Northern District of California came to a different conclusion.¹⁵⁴ In *Capcom Co. v. The MKR Group*, the court easily found that the title DEAD RISING for a video game about zombies did not infringe the rights in a similarly themed film about zombies entitled *Dawn of the Dead*.¹⁵⁵ With no discussion of *Rogers*’ footnote 5, the court held that

¹⁴⁸ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

¹⁴⁹ Similar to the *Polaroid* factors, in the Ninth Circuit these are referred to as the *Sleekcraft* factors. See *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979).

¹⁵⁰ No. CV 07-8185 DSF (MAN), 2008 WL 11173143, at *1-2 (C.D. Cal. Feb. 19, 2008).

¹⁵¹ *Id.* at *4.

¹⁵² *Id.*

¹⁵³ *Id.* at *5. In response to the defendant’s argument that a dispute between a title of a song and the title of a television series should be treated differently from a dispute between two television series or two song titles, the court held that “[n]othing in *MCA* or any subsequent Ninth Circuit case . . . suggests that the two-part *MCA* test should be applied differently to a work that is in ‘direct competition’ with an allegedly infringing work than to a work that is not.” *Id.* at *4. The Ninth Circuit later addressed this issue in *Gordon v. Drape Creative*. See *infra* Part III.B.3.

¹⁵⁴ See *Capcom Co. v. MKR Grp.*, No. C 08-0904 RS, 2008 WL 4661479, at *13 (N.D. Cal. Oct. 20, 2008).

¹⁵⁵ *Id.*

there would be an infringement only if the title was found to “explicitly mislead as to the source of the work, which it simply does not do.”¹⁵⁶

The issue was soon back before the District Court for the Central District of California in *Roxbury Entertainment v. Penthouse Media Group*, a case alleging that use of the title ROUTE 66 for a pornographic film infringed the trademark rights of owners of the *Route 66* television program.¹⁵⁷ Again with no discussion of footnote 5, the court easily concluded that “the *Rogers* test provides a complete defense to all of Plaintiff’s claims,” in this case because the title was artistically relevant to the film and there was “nothing to indicate that there [was] any risk of Defendants’ use of the mark ‘duping’ consumers into thinking they [were] buying a product sponsored by, or in any way affiliated with, Plaintiff or the 1960s television series in which it owns rights.”¹⁵⁸

But the next ruling from the District Court for the Central District of California involving a dispute between two titles *did* reference footnote 5. In *Wild v. HarperCollins Publishers, LLC*, the court denied the defendant’s motion to dismiss where the plaintiff had alleged that the defendant had “deliberately chose[n] a confusingly identical title for its competing book in the same genre,” namely CARNIVAL OF SOULS for books for a young adult audience focused on supernatural beings, love story elements, and violence.¹⁵⁹ Although not specifically finding *Rogers* inapplicable based on its footnote 5, the court concluded that allegations concerning the defendant’s intent created a factual question as to whether the defendant’s book was “likely to confuse consumers as to the origin of its source.”¹⁶⁰

The *Rogers* footnote 5 was examined in much greater detail in *CI Games S.A. v. Destination Films*, which considered whether a movie entitled *Sniper: Ghost Shooter* infringed the trademark rights in a video game entitled *Sniper: Ghost Warrior* with similar themes.¹⁶¹ Rejecting the argument that the *Rogers* balancing test was wholly inapplicable because of its footnote 5, the district court concluded that “Ninth Circuit precedent weighs in favor of applying the *Rogers* test to all trademark cases in which the alleged infringement occurs in an expressive work, including when an infringing title is allegedly confusingly similar to a previous title.”¹⁶²

¹⁵⁶ *Id.*

¹⁵⁷ 669 F. Supp. 2d. 1170, 1175 (C.D. Cal. 2009).

¹⁵⁸ *Id.* at 1175-76.

¹⁵⁹ No. SACV 12-1191-JST (ANx), 2012 WL 12887690, at *5 (C.D. Cal. Nov. 29, 2012).

¹⁶⁰ *Id.*

¹⁶¹ No. 2:16-cv-05719-SVW-JC, 2016 WL 9185391 at *1 (C.D. Cal. Oct. 25, 2016).

¹⁶² *Id.* at *3; *see also* *Reflex Media, Inc. v. Pilgrim Studios, Inc.*, No. CV 18-2260-GW(FFMx), 2018 WL 6566561 (C.D. Cal. 2018) (dismissing claim that title LOVE AT FIRST FLIGHT

But the court recognized, as the *Rogers* court had believed, that the analysis of the “explicitly misleading” prong is different in the context of two confusingly similar titles because these cases present a greater likelihood of consumer confusion.¹⁶³

Unlike the Second Circuit’s determination in *Twin Peaks* that the “explicitly misleading” prong in title-versus-title cases must be satisfied by first applying the likelihood-of-confusion factors, the court in *CI Games* disagreed with that approach, stating that

the analysis of this prong cannot possibly be equivalent to the “likelihood of confusion” test employed in *Sleekcraft*. Courts apply the likelihood of confusion test when First Amendment concerns are not implicated. (citation omitted). In other words, the test applies when the *Rogers* test is found inapplicable. Therefore, incorporating the likelihood-of-confusion test into the *Rogers* test would render the second prong of the *Rogers* test a nullity, as the same test would again be applied to cases that fail the *Rogers* analysis.¹⁶⁴

Rejecting the defendant’s argument that its use of the title was not “explicitly misleading” because it had made no affirmative statements of sponsorship or endorsement, the *CI Games* court explained that the defendant had “misunderstood the purpose of the second prong [of *Rogers*] in the context of confusingly similar titles.”¹⁶⁵ As the court explained, consumers do not typically expect a title to identify the publisher or producer of a work, but rather to communicate some message about the work’s content.¹⁶⁶ But “[t]he same conclusions are not relevant when the case involves confusingly similar titles. The title of a movie, if confusingly similar to the title of a video game series, absolutely would suggest to consumers that the producer of the video game is also the producer of the movie.”¹⁶⁷ Thus, the court believed that if the evidence ultimately showed that the defendant *intended* to create confusion, even without making explicit misstatements, such evidence could be sufficient to show that the use was explicitly misleading.

The *CI Games* court concluded that the plaintiff had at least presented sufficient factual allegations to survive the motion to dismiss.¹⁶⁸ But it denied the plaintiff’s motion for a preliminary injunction because the plaintiff’s reliance only on “accusations and

for a reality dating television series infringed rights in title LOVE AT FIRST FLIGHT for a reality dating web series, noting Ninth Circuit precedent for applying *Rogers* in cases involving competing titles despite footnote 5).

¹⁶³ *Id.*

¹⁶⁴ *Id.* at *3 n.3, *9.

¹⁶⁵ *CI Games*, 2016 WL 9185391, at *8.

¹⁶⁶ *Id.*

¹⁶⁷ *Id.* at *9.

¹⁶⁸ *Id.*

speculation” and “its own insinuations and innuendo” that the plaintiff’s game was the source of the defendant’s inspiration failed to demonstrate a “clear showing” that it would ultimately overcome the First Amendment defense or succeed on the merits.¹⁶⁹

Finally, the Ninth Circuit also weighed in on the “explicitly misleading” issue in *Twentieth Century Fox v. Empire Distribution*.¹⁷⁰ Fox sought a declaratory judgment that its television show title EMPIRE did not infringe the trademark rights in a real-life record label called “Empire Distribution.” Empire Distribution, however, counterclaimed not only that Fox’s use of EMPIRE as a television series title was infringing, but also that Fox used the mark as the title of at least two soundtrack albums.¹⁷¹ Because Empire Distribution alleged it had used its EMPIRE mark on many of its own albums,¹⁷² it also positioned the case as a title-versus-title dispute, and asserted footnote 5 to argue that the *Rogers* balancing test should not apply at all.¹⁷³ The Ninth Circuit disagreed, holding that “the exception the footnote suggests may be ill-advised or unnecessary” and “conflicts with our precedents, which dictate that we apply the *Rogers* test in all . . . cases involving expressive works.”¹⁷⁴

Empire Distribution also argued that *Rogers* should not apply because Fox used the EMPIRE mark not just as an artistic title, but as an “umbrella brand” for a larger commercial enterprise including the sale of collateral merchandise, musical recordings, and other promotional activities.¹⁷⁵ The court disagreed, stating that “[a]lthough it is true that these promotional efforts technically fall outside the title or body of an expressive work, it requires only a minor logical extension of the reasoning of *Rogers* to hold that works protected under its test may be advertised and marketed by name, and we so hold.”¹⁷⁶ Furthermore, cautioning that “[t]he balance of First Amendment interests struck in *Rogers* and *Mattel* could be destabilized if the titles of expressive works were protected but could not be used to promote those works,” the court held that

¹⁶⁹ *Id.* at *12.

¹⁷⁰ 875 F.3d 1192 (9th Cir. 2017).

¹⁷¹ *Id.* at 1195.

¹⁷² Alleged titles were *EMPIRE Presents: Triple X-Mas*, *EMPIRE SAMPLER*, *EMPIRE SELECTS*, and *EMPIRE Unplugged*, among others. Appellant Empire Distribution, Inc.’s Reply Brief at 7, *Twentieth Century Fox Television*, 875 F.3d at 1192 (No. 16-55577).

¹⁷³ *Twentieth Century Fox*, 875 F.3d at 1197.

¹⁷⁴ *Id.*

¹⁷⁵ *Id.* at 1198. Empire Distribution also raised the possibility that the EMPIRE television series was “a pretextual expressive work meant only to disguise a business profiting from another’s trademark,” but the court held that “the record in this case makes clear that the *Empire* show is no such thing.” *Id.*

¹⁷⁶ *Id.* at 1196-97.

“Fox’s promotional activities, including those that generate revenue, are auxiliary to the television show and music releases, which lie at the heart of its ‘Empire’ brand.”¹⁷⁷

Finally, the *Fox* court cautioned against “conflat[ing] the second prong of the *Rogers* test with the general *Sleekcraft* likelihood-of-confusion test, which applies outside the *Rogers* context of expressive works.”¹⁷⁸ Instead, the court held that “[t]o fail the second prong of the *Rogers* test, ‘[i]t is key . . . that the creator must *explicitly* mislead consumers’” through an “‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement’” that caused consumer confusion.”¹⁷⁹

Because there was no evidence that Fox had made any explicit misstatements, let alone explicit misstatements that caused consumer confusion, and because Fox’s promotional activities—including release of musical recordings and the sale of collateral merchandise bearing the EMPIRE mark—were also protected as auxiliary to the *Empire* television series, the Ninth Circuit granted summary judgment to Fox on all claims.¹⁸⁰

Following this Ninth Circuit clarification confirming the applicability of the *Rogers* balancing test in competing title cases, a court in the Southern District of California considered the balancing test in a dispute involving the book titles OH THE PLACES YOU’LL GO and OH THE PLACES YOU’LL BOLDLY GO.¹⁸¹ Evaluating the plaintiff’s trademark claim “under the *Rogers* test as it has been interpreted by the Ninth Circuit” in *Twentieth Century Fox*, the court found that in the absence of explicit misstatements that the defendant’s work is associated with or endorsed by the plaintiff, it did not meet the explicitly misleading prong and therefore summary judgment was appropriate.¹⁸²

None of the other Ninth Circuit cases applying *Rogers* had involved disputes between competing titles. In another case involving the iconic BARBIE mark, a series of photographs featuring a BARBIE doll in absurd positions often involving kitchen appliances that used the title FOOD CHAIN BARBIE was found not to infringe Mattel’s BARBIE mark because the defendant made no indication that Mattel in any way created or sponsored the photographs.¹⁸³

¹⁷⁷ *Id.* at 1197.

¹⁷⁸ *Id.* at 1199

¹⁷⁹ *Id.* (alteration in original).

¹⁸⁰ *See id.* at 1200.

¹⁸¹ *Dr. Seuss Enters. v. ComicMix LLC*, No. 16-CV-2779-JLS (BGS), 2018 WL 2306733, at *4-5 (S.D. Cal. May 21, 2018).

¹⁸² *Id.*

¹⁸³ *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003).

In *E.S.S. Entertainment v. Rock Star Videos*, a case involving the use of a mark identifying a strip club within a fictional world in a video game, the court extended *Rogers* from titles of works to elements of works, and held that use of the mark within the game would not confuse players into thinking that the real-life strip club was sponsoring or endorsing the game.¹⁸⁴ The court also affirmed summary judgment in favor of Sony in a similar case, where the plaintiff had not alleged any “explicit indication, overt claim, or explicit misstatement” on the part of Sony that would cause consumers to believe the plaintiff was the source of the game.¹⁸⁵

Then in *Brown v. Electronic Arts*, another video game case, former professional football player Jim Brown alleged that use of his name and likeness in the MADDEN NFL video game franchise violated Section 43(a) of the Lanham Act.¹⁸⁶ The Ninth Circuit affirmed the district court’s granting of the motion to dismiss Brown’s claims, and used this case as an opportunity to elaborate on what type of evidence is relevant for finding a use “explicitly misleading.”¹⁸⁷

According to the Ninth Circuit, “the factual support Brown offer[ed] [wa]s simply of the wrong type.”¹⁸⁸ First, Brown argued that “written materials that accompanied versions of the game . . . explicitly represent[ed] that Brown was in EA’s game” by stating that the game contained “[f]ifty of the NFL’s greatest players.”¹⁸⁹ The court found that this true statement proved only that Brown’s likeness was in the game, not that Brown had endorsed the game.¹⁹⁰ Instead, “Brown would need to demonstrate that EA *explicitly* misled *consumers* as to his *involvement*,” not that his likeness was in the game.¹⁹¹

Second, Brown submitted survey evidence showing that a majority of the public believed that identifying marks cannot be included in products without permission.¹⁹² But the court explained that “survey evidence changes nothing” because even if a survey showed consumer confusion, “that would not support [a] claim that the use was explicitly misleading”¹⁹³ because evidence must “relate

¹⁸⁴ 547 F.3d 1095, 1100-01 (9th Cir. 2008).

¹⁸⁵ *VIRAG*, 699 F.App’x at 668.

¹⁸⁶ 724 F.3d 1235, 1239 (9th Cir. 2013).

¹⁸⁷ *Id.* at 1245-48.

¹⁸⁸ *Id.* at 1248.

¹⁸⁹ *Id.* at 1246.

¹⁹⁰ *Id.*

¹⁹¹ *Brown*, 724 F.3d at 1248 (emphasis in original).

¹⁹² *Id.* at 1245.

¹⁹³ *Id.* at 1245-46. The Sixth Circuit has also rejected the relevance of survey evidence to the “explicitly misleading” prong of *Rogers*. *ETW Corp.*, 332 F.3d at 937.

to the nature of the behavior of the identifying materials user, not the impact of the use.”¹⁹⁴

The court concluded that Brown’s evidence demonstrated only that “the public can generally be misled about sponsorship when marks are included in products” and that “EA explicitly stated that Brown’s likeness appears” in the game, which did not establish that EA engaged in any acts that explicitly misled consumers as to Brown’s endorsement of the game.¹⁹⁵

Although the *Rogers* court had also found that survey evidence would not support a finding that a use was explicitly misleading, district courts within the Second Circuit have found survey evidence relevant in disputes between titles, where the likelihood-of-confusion factors were considered.¹⁹⁶ The Fifth Circuit, the only other circuit requiring consideration of likelihood-of-confusion factors, considered survey evidence as part of the likelihood-of-confusion analysis in *Westchester Media*.¹⁹⁷

Not surprisingly, such a deliberate attempt to “dupe” consumers, as the controlling Ninth Circuit cases require, has rarely been found, despite a plethora of cases.¹⁹⁸ There are only two such decisions, one finding deliberate misstatements to mislead as to content, and the other finding deliberate misstatements to mislead as to source.

In *Titan Sports, Inc. v. 3-G Productions*, the plaintiffs objected to videotapes featuring its WWE marks and images of its professional wrestlers.¹⁹⁹ Although the videos were of matches that occurred before the wrestlers were associated with the plaintiffs, the

¹⁹⁴ *Brown*, 724 F.3d at 1246.

¹⁹⁵ *Id.* at 1248.

¹⁹⁶ *Simon & Schuster, Inc.*, 970 F. Supp. at 289.

¹⁹⁷ *Westchester Media*, 214 F.3d at 667.

¹⁹⁸ *See, e.g., Stewart Surfboards*, 2011 WL 12877019, at *7 (granting motion to dismiss and giving examples of what would have been explicitly misleading uses of the STEWART SURFBOARD mark as “BROUGHT TO YOU BY STEWART SURFBOARDS” and “PRESENTED BY STEWART SURFBOARDS”); *Webceleb*, 2012 WL 12846096, at *5 (granting summary judgment that use of WEBCELEB for a category of the People’s Choice Awards did not infringe plaintiff’s rights in the mark or an online social marketplace for music); *Novalogic*, 41 F. Supp. 3d at 901 (granting summary judgment to defendant where plaintiff did not “claim or suggest in any way that [the work] was made with the participation or endorsement of Plaintiff”); *Mil-Spec Monkey*, 74 F. Supp. 3d at 1143 (granting summary judgment to defendant where plaintiff MSM had not “put forth a single argument that Activision ha[d] affirmatively purported in any way to share a relationship with MSM”); *Harold Lloyd Entm’t*, 2015 WL 12765142, at *11 (dismissing claims that use of plaintiff’s film clip within defendant’s multimedia work was explicitly misleading where the work made no direct reference to plaintiff and the website promoting the work contained nothing that would mislead a consumer into believing that plaintiff had “sponsored or endorsed the work”); *Reflex Media*, 2018 WL 6566561, at *6 (dismissing complaint containing nothing more “than conclusory allegations” that use of an identical title for a reality dating series was explicitly misleading).

¹⁹⁹ No. CV 90-3022-RJK, 1991 WL 228716, at *1 (C.D. Cal. July 31, 1991).

videotape cases and packaging featured current pictures of the wrestlers as they were widely known to the public.²⁰⁰ The District Court for the Central District of California found that the performance titles HULK HOGAN and RANDY “MACHO MAN” SAVAGE had clear artistic relevance to the defendant’s videos featuring those named wrestlers. But the titles and images portrayed on the video boxes were explicitly misleading of the actual *content* of the videos because the videos intentionally displayed current pictures of the wrestlers, instead of pictures taken of them when the older matches depicted in the videos took place.²⁰¹ Accordingly, the interest in avoiding consumer confusion outweighed the public interest in free expression.²⁰²

Similarly, in *Warner Bros. v. Global Asylum, Inc.*, the District Court for the Central District of California found language on DVD cases a sufficient overt act to find the defendant’s actions explicitly misleading as to *source*.²⁰³ In that case, Warner Bros., on the eve of the premier of its blockbuster film *The Hobbit: An Unexpected Journey*, sought to enjoin the defendants’ release of a “mockbuster” entitled *Age of Hobbits*.²⁰⁴ Although the court’s decision improperly categorized *Rogers* as a three-prong test, with the first prong requiring that the mark have “acquired meaning beyond its source identifying function,” wrongly imparted a referential requirement, and improperly analyzed the likelihood-of-confusion factors,²⁰⁵ it is worth mentioning as the only known example of a court finding a defendant’s actions explicitly misleading as to source. The back cover of the defendant’s DVD included the language “in the tradition of Clash of the Titans and 300,” two other films from the plaintiff, which the court believed was defendant’s explicit attempt to imply a connection between its film and plaintiff.²⁰⁶

As noted in the cases discussed above, the mere use of a trademark in a creative work, without more, cannot be explicitly misleading in the Ninth Circuit. Although both the Ninth Circuit and its district courts have typically required the “more” element to be overt or explicit misstatements,²⁰⁷ a recent case has established that overt or explicit acts don’t always need to be in the form of “affirmative statement[s] of the plaintiff’s sponsorship or

²⁰⁰ *Id.*

²⁰¹ *Id.* at *4.

²⁰² *Id.*

²⁰³ 2012 WL 6951315, *5 (C.D. Cal. 2012), *aff’d*, 2013 WL 12114836, at *6 (9th Cir. 2013) (granting preliminary injunction following TRO).

²⁰⁴ *Id.* at *1-2.

²⁰⁵ *See id.* at *4-14, *15-17.

²⁰⁶ *See id.* at *12.

²⁰⁷ *See Twentieth Century Fox*, 875 F.3d at 1197.

endorsement,” but in some cases may be demonstrated through actions.²⁰⁸

In *Gordon v. Drape Creative*, Christopher Gordon posted a video on YouTube entitled “The Crazy Nastyass Honey Badger” featuring *National Geographic* footage of a honey badger.²⁰⁹ Gordon provided comedic narration over the video, repeatedly stating that “Honey badger don’t care” and “Honey badger don’t give a shit” as the honey badger hunted and ate its prey. The video went viral, and Gordon obtained federal trademark registrations for HONEY BADGER DON’T CARE (and other variations) covering various goods, including greeting cards.²¹⁰ When a licensing deal between the plaintiff and the defendants did not materialize, the defendants began selling their own line of greeting cards bearing the wording “HONEY BADGER DON’T CARE” with images of a honey badger, and little else.²¹¹

A court in the Central District of California granted summary judgment in favor of the defendants, finding that greeting cards were protectable artistic works and that the defendants had met both prongs of the *Rogers* balancing test, but the Ninth Circuit reversed on appeal.²¹² Although the court found no “triable issue of fact with respect to *Rogers*’s ‘artistic relevance’ prong,” the court held that it could not decide as a matter of law that the defendants’ use of the mark was not explicitly misleading.²¹³

Rejecting the district court’s “rigid requirement that, to be explicitly misleading, the defendant must make an ‘affirmative statement of the plaintiff’s sponsorship or endorsement,’” the Ninth Circuit held that this requirement for an affirmative statement was applicable only where “it was clear that consumers would not view the mark alone as identifying the source of the artistic work.”²¹⁴ Examples the court gave of cases where consumers would not view the mark alone as identifying source included: (1) most title cases, “because consumers ‘do not expect [titles] to identify’ the ‘origin’ of the work,” and (2) use of marks as elements within creative works like video games.²¹⁵

In cases where use of the mark *would* likely be viewed by consumers as source identifying,²¹⁶ however, the court believed that

²⁰⁸ *Gordon*, 909 F.3d at 269-70.

²⁰⁹ *Id.* at 261.

²¹⁰ *Id.*

²¹¹ *Id.* at 262-63.

²¹² *Id.* at 263, 271.

²¹³ *Id.* at 269, 271.

²¹⁴ *Id.* at 269-70.

²¹⁵ *Id.* at 270.

²¹⁶ *Gordon*, 909 F.3d at 270. The court believed that placement of a mark and the context in which it was used could result in a situation where consumers viewed an artistic use as

the “more relevant consideration is the degree to which the junior user uses the mark in the same way as the senior user,” and “the extent to which the junior user has added his or her own expressive content to the work beyond the mark itself.”²¹⁷ Under the facts before it, the court believed that consumers *would* expect that use of the HONEY BADGER DON’T CARE mark on greeting cards designated source, and that “defendants used the mark knowing that consumers rely on marks on the inside of cards to identify their source.”²¹⁸

The Ninth Circuit then analyzed “the degree to which the junior user uses the mark in the same way as the senior user,” and found that the parties both used HONEY BADGER DON’T CARE for directly competing greeting cards.²¹⁹ On the second issue, “the extent to which the junior user has added his or her own expressive content to the work beyond the mark itself,” the court explained that “the concern that consumers will not be ‘misled as to the source of [a] product’ is generally allayed when the mark is used only as one component of a junior user’s larger expressive creation, such that the use of the mark at most ‘implicitly suggest[s]’ an association with the mark’s owner.”²²⁰ But when a junior user uses a mark “as the centerpiece of an expressive work itself, unadorned with any artistic contribution by the junior user,” this “may reflect nothing more than an effort to ‘induce the sale of goods and services’ by confusion.”²²¹ In all of the previous Ninth Circuit cases, the allegedly infringing marks were used as only a small part of junior users’ overall artistic works.²²² But here, the court was troubled that the defendants had “not used Gordon’s mark in the creation of a song, photograph, video game, or television show, but ha[d] largely just pasted Gordon’s mark into their greeting cards” with no additional creative content.²²³

This reasoning is consistent with the Ninth Circuit’s focus in its prior rulings on whether a defendant’s actions had caused any risk of confusion, rather than simply whether there was a likelihood of confusion not caused by anything other than mere use of the mark.

source identifying, suggesting that use of the DISNEY mark at the bottom corner of a picture of Mickey Mouse could create such a situation because consumers expect use of a mark in that location and in that context to signify the source of the picture.

²¹⁷ *Id.*

²¹⁸ *Id.* at 271.

²¹⁹ *Id.* at 270-71 (noting that Gordon had introduced evidence that he also sold greeting cards; that defendants often used Gordon’s mark without any other text; and that defendants knew that “consumers rely on marks on the inside of cards to identify their source”).

²²⁰ *Id.* (quoting *Rogers*, 875 F.2d at 998-99) (alteration in original).

²²¹ *Id.* at 271.

²²² *Id.*

²²³ *Id.* at 261.

The court quoted with approval language from its decision in *Brown* that the “key” is “that the creator must *explicitly* mislead consumers, and we accordingly focus on ‘the nature of the [junior user’s] behavior’ rather than on ‘the impact of the use.’”²²⁴

Gordon is not a decision on the merits, and the court was careful to note that the plaintiff’s “evidence is not bulletproof.”²²⁵ But because the court believed that there was “at least a triable issue of fact as to whether the defendants simply used Gordon’s mark with minimal artistic expression of their own, and used it in the same way that Gordon was using it—to identify the source of humorous greeting cards in which the bottom line is ‘Honey Badger don’t care’”—the court remanded the case back to the district court for further findings on Gordon’s claims.²²⁶

As noted by the Ninth Circuit itself, *Gordon* “demonstrates *Rogers*’s outer limits.”²²⁷ In cases involving marks used in titles or as elements of creative works where consumers do not expect them to designate source, it thus appears that the Ninth Circuit will continue to require affirmative statements or actions meant to explicitly mislead consumers to overcome *Rogers*’s second prong. But in those limited situations where consumers do expect a mark in a creative work to connote source, the determination of whether the use is explicitly misleading will turn on something else—whether the mark is used for a directly competing product *and* the extent to which the junior user added his or her own expressive content or simply adopted the senior user’s mark as the centerpiece of its work.

Gordon was not the first time a court within the Ninth Circuit had recognized that the standard for determining whether a use is “explicitly misleading” may be slightly different when directly competing products are involved. In *CI Games S.A. v. Destination Films*, a case discussed above involving a dispute between the titles for a movie and a video game with similar themes, the court held that cases involving competing titles, “as contrasted with the normal case applying the *Rogers* test, which usually involves one expressive work using a non-expressive trademark,” pose an “increased risk of consumer confusion” because consumers may, by virtue of the fact that the producers of each are in the same type of business, believe the works arise from the same source.²²⁸ Therefore, the same conclusions that make sense when the plaintiff and the defendant are not in the same business are not relevant.²²⁹

²²⁴ *Id.* at 269 (quoting *Brown*, 724 F.3d at 1245-46 (alteration in original)).

²²⁵ *Id.* at 271.

²²⁶ *Id.*

²²⁷ *Id.* at 268.

²²⁸ No. 2:16-cv-05719-SVW-JC, 2016 WL 9185391, at *8-9 (C.D. Cal. Oct. 25, 2016).

²²⁹ *Id.*

In cases involving competing titles, the court held that instead of having to meet the “relatively high bar in demonstrating affirmative statements that would mislead the public as to the producer or endorser of the expressive work,” a plaintiff need only prove that a defendant selected a title with the intent to confuse consumers into thinking the products were related.²³⁰ Because the complaint contained such allegations, the court denied the motion to dismiss. But it denied the plaintiff’s motion to preliminarily enjoin release of the defendant’s movie, noting that “accusations and speculation” and “insinuations and innuendo” about the motive for the selection of the title were not sufficient to exclude the defendants from First Amendment protection.²³¹

Although *Gordon* did not involve a dispute between titles, the court suggested in *dicta* that a case involving two competing titles could be the kind where consumers expect use of a mark to identify the source of the work if the junior user’s use of the title is “identical.”²³² Giving a hypothetical example, the court theorized that a Fox television series entitled *Law & Order: Special Hip-Hop Unit* could be considered identical to NBC Universal’s use of LAW & ORDER: SPECIAL VICTIMS UNIT as its television series title.²³³ Presumably, however, a court would still have to determine whether the junior user had “added his or her own expressive content to the work beyond the mark itself.”²³⁴ Unless the subject matter and/or content of the works were very similar, the junior use of the title should be found to serve “as only one ‘element of the [work] and the [junior user’s] artistic expression,’” and not the “centerpiece” of the work itself, “unadorned with any artistic contribution by the junior user.”²³⁵ Moreover, the unique nature of the titles in this example and the fact that LAW & ORDER: SPECIAL VICTIMS UNIT is part of a series of marks for several related television shows all following the “LAW & ORDER: [DESCRIPTIVE TERM]” format are additional facts that would go to the junior user’s intent. Although consumers don’t typically view television show titles as designating source, they likely *have* become conditioned to viewing television series titles beginning with “LAW & ORDER:” as all coming from Dick Wolf and/or NBC Universal. This may also be the case in situations involving a movie title and a video game title, such as in *CI Games*, where a consumer may believe a video game and movie

²³⁰ *Id.* (“This Court now finds that intentionally creating a title that could be confused with the title of another expressive work would be ‘explicitly misleading’ for purposes of the *Rogers* test.”).

²³¹ *Id.* at *12.

²³² *Gordon*, 909 F.3d at 270.

²³³ *Id.*

²³⁴ *See id.* at 270.

²³⁵ *Id.* at 271 (alteration in original).

are from the same source. In contrast, consumers of media with less distinctive titles are unlikely to view the titles as source designating, and not assume that other artistic works with different subject matter, in different media, or in different formats would be related absent intentional acts by the junior user falsely suggesting an association.

This “title v. title” scenario was soon presented to a district court within the Ninth Circuit. In *Fierce, Inc. v. Franklin Covey Co.*, plaintiff alleged that the defendant’s book entitled *Fierce Loyalty: Cracking the Code to Customer Devotion* infringed its rights in numerous federal registrations for FIERCE and FIERCE-formative marks for corporate training materials, as well as its books titled *Fierce Conversations: Achieving Success at Work & in Life* and *Fierce Leadership, a Bold Alternative to the Worst “Best” Practices of Business Today*.²³⁶ Citing *Gordon* for the proposition that 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, the court held that the plaintiff had alleged facts giving rise to a reasonable inference that defendant’s title was explicitly misleading, and denied the defendant’s motion to dismiss.²³⁷ Specifically, the court found that the plaintiff and defendant each used the mark “in the same context and market,” namely “as the title of a book identifying strategies to help businesses ‘increase the engagement and loyalty from both employees and customers.’”²³⁸ Moreover, the defendant followed the same naming convention of “FIERCE _____” and presented its mark using a “color, typeface, and visual format” similar to that of the mark of the plaintiff.²³⁹ While this case, like *Gordon*, did not find that the defendant’s use was explicitly misleading, it allowed the case to proceed where there was evidence that the defendant’s motives and actions in adopting and using the mark may have been impure.

In contrast, just a few weeks later, another district court within the Ninth Circuit found that the defendant’s use of the mark MASTERMIND as an album title and performance title was not explicitly misleading, despite another musician’s prior use and registration of the mark for his own performance title and recordings.²⁴⁰ Recognizing that under *Gordon* use of the mark alone could be sufficient to explicitly mislead consumers where consumers would ordinarily identify the source by the mark itself, and apparently conceding that both the plaintiff and defendant were

²³⁶ No. C18-1449-MJP, 2019 WL 1453573 *1 (W.D. Wash., Apr. 2, 2019).

²³⁷ *Id.* at *7.

²³⁸ *Id.*

²³⁹ *Id.* Both books used an orange color scheme, more prominent use of the term FIERCE, and identical font.

²⁴⁰ *Caiz v. Roberts*, 382 F. Supp. 3d 942 (C.D. Cal. 2019).

using the mark in the same way, the court focused on whether the defendant had added his own expressive content to the work, or used the mark as the “centerpiece” of its own work.²⁴¹ Finding that the defendant used the mark as one album title out of six in his career, that he used the word in lyrics nine times in the album through his own artistic expression, and that when he used it as his nickname it was always accompanied by a clear indication of his primary moniker—Rick Ross, the court granted summary judgment to the defendant, holding that there was no evidence that the defendant’s use even implicitly suggested a connection, let alone any evidence of an overt association.²⁴²

4. “Explicitly Misleading” in the Third, Sixth, and Eleventh Circuits and District Courts Within the Seventh Circuit

The Third, Sixth, and Eleventh Circuits have all adopted the Ninth Circuit’s pre-*Gordon* general approach.²⁴³ To meet the “explicitly misleading” prong, the defendant must have engaged in some overt act to try to confuse the public, as opposed to the mere act of using the mark in cases where consumers do not expect a mark to have source-identifying significance, even if it resulted in consumer confusion.

The Third Circuit first adopted *Rogers* in *Seale v. Gramercy Pictures*,²⁴⁴ but a recent decision from a court within the Eastern District of Pennsylvania thoroughly analyzed the type of facts that would negate a finding of explicitly misleading. In *Hidden City Philadelphia v. ABC, Inc.* the plaintiff owned and operated a website titled “Hidden City Philadelphia” showcasing Philadelphia history and architecture. It brought a trademark infringement action against ABC for using the mark HIDDEN PHILADELPHIA for its local television news segment series highlighting little-known places in Philadelphia.²⁴⁵ The court found that the title was not explicitly misleading because it did not adopt the plaintiff’s exact name HIDDEN CITY PHILADELPHIA; there were no allegations that ABC had suggested the plaintiff was associated with its videos; and the videos appeared on ABC’s local affiliate’s website, featured the ABC logo, and indicated that they were presented by sponsor the Philadelphia Zoo, and dismissed the case.²⁴⁶

²⁴¹ *Id.* at 950-51.

²⁴² *Id.* at 951.

²⁴³ See *Seale*, 964 F. Supp. at 931, *aff’d*, 156 F.3d 1225 (3d Cir. 1998); *Parks*, 329 F.3d at 448; *Univ. of Ala. Bd. of Trs.*, 683 F.3d at 1278; *Eastland Music Grp.*, 2012 WL 2953188 at *3, *aff’d without reaching constitutional question*, 707 F.3d 869 (7th Cir. 2013).

²⁴⁴ 949 F. Supp. at 340.

²⁴⁵ No. 18-65, 2019 WL 1003637, at *1 (E.D. Pa. May 1, 2019).

²⁴⁶ *Id.* at *5.

Although remanding back to the district court for a determination of whether the song title ROSA PARKS was artistically relevant to the defendant's song, the Sixth Circuit in *Parks v. LaFace Records*, specifically instructed that if the district court ultimately found it to be artistically relevant, "application of the *Rogers* analysis . . . would appear to be complete" because the defendant made "no explicit statement that the work is about [Ms. Parks] in any direct sense."²⁴⁷ Giving specific examples of how the song title may have been explicitly misleading, the court noted that the defendants did not name the song "The True Life Story of Rosa Parks or Rosa Parks' Favorite Rap."²⁴⁸

And in a case involving use of colors and designs of sports uniforms in artistic depictions of scenes from University of Alabama football, the Eleventh Circuit found in *University of Alabama Board of Trustees v. New Life Art, Inc.* that there was no evidence that the defendant ever marketed an "item as 'endorsed' or 'sponsored by' the University, or otherwise explicitly stated that such items were affiliated with the University" and was therefore "entitled to full First Amendment protection."²⁴⁹

District courts within the Seventh Circuit have also required a defendant to have engaged in explicit misstatements or other overt actions to find a junior use explicitly misleading.²⁵⁰ In the two published cases, the district courts' denials of motions to dismiss were affirmed by the Seventh Circuit, but neither case reached the issue of whether *Rogers* applied.²⁵¹

As can be seen from the analysis above, the key distinction between how the Second Circuit determines whether a use is

²⁴⁷ *Parks*, 329 F.3d at 459. See also *ETW Corp.*, 332 F.3d at 932; *Moore v. Weinstein Co.*, 545 F. App'x 405, 409 (6th Cir. 2013); *Rebellion Devs*, 2013 WL 1944888, at *5-6 (finding allegations that defendant's use of the mark was a "willful attempt to capitalize on the substantial reputation and goodwill of Plaintiffs" insufficient to meet the second prong of *Rogers* because "even if members of the public are misled, such confusion is not actionable without an 'overt misrepresentation'"); *Martha Elizabeth*, 2011 WL 1750711, at *25 (denying preliminary injunction against show titled *Bitchin' Kitchen*, the court noting that neither the program's host nor the channel did anything to link its program to plaintiff).

²⁴⁸ *Parks*, 329 F.3d at 458-59. District court decisions within the Sixth Circuit include *Sporting Times*, 291 F. Supp. 3d at 817 (finding use of fictional magazine title and cover within film was not explicitly misleading when there was "no suggestion of sponsorship or partnership" with a real-life magazine with the same title, let alone an "overt misrepresentation") and *Rebellion Developments*, 2013 WL 1944888 (finding video game title did not infringe name of video game development company absent overt misrepresentations as to affiliation).

²⁴⁹ 683 F.3d 1266, 1279 (11th Cir. 2012).

²⁵⁰ *Eastland Music Grp.*, 2012 WL 2953188, at *3, *aff'd without reaching constitutional question*, 707 F.3d 869 (7th Cir. 2013). In *Fortres Grand Corporation*, the court noted that a requirement of explicitly misleading is "a high bar" requiring an "affirmative statement." 947 F. Supp. 2d at 932, *aff'd without reaching First Amendment constitutional question*, 763 F.3d 696 (7th Cir. 2014).

²⁵¹ *Id.*

explicitly misleading in competing title cases under *Twin Peaks* and how the Ninth Circuit determines whether a use is explicitly misleading under *Rogers* is the focus on the junior user's actions rather than the impact on consumers.²⁵² In the Ninth Circuit, it does not matter if there is some level of consumer confusion, provided the defendant did not do anything (aside from using the mark) to cause it, which is why the likelihood-of-confusion factors (including survey evidence) are never considered.²⁵³ In the Second Circuit, a defendant's clean hands are irrelevant in disputes between titles, provided there is a compelling level of confusion, which is determined after considering the likelihood-of-confusion factors, which could include survey evidence.

5. "Explicitly Misleading" in a District Court Within the Tenth Circuit

The Tenth Circuit has never had the occasion to consider *Rogers*, but a district court within the circuit recently held that it would apply *Rogers* to a dispute between titles of different animal nature series, but that "the *Rogers* test needs adapting to the legitimate considerations brought out in subsequent cases" and "should not be adopted as is."²⁵⁴

The case was brought by Marty Stouffer, producer of the *Wild America* nature series that aired on PBS for fourteen years. After negotiations to air the series between the plaintiff and NatGeo Channel broke down, NatGeo launched its own nature series with allegedly similar features under the title AMERICA THE WILD.²⁵⁵ In ruling on defendant's motion to dismiss under *Rogers*, the court acknowledged it had "the luxury of thirty years of court decisions applying *Rogers*, demonstrating its strength and weaknesses."²⁵⁶ Focusing heavily on *Parks*²⁵⁷ and *Gordon*,²⁵⁸ the court was troubled by treating "artistic relevance" as a threshold inquiry, believing that this could create an unwarranted distinction if a work is abstract, such as an instrumental piece without lyrics, or if the irrelevance of a title to a work could in itself be an artistic choice.²⁵⁹

²⁵² *Gordon*, 909 F.3d at 269 ("The 'key here [is] that the creator must explicitly mislead consumers,' and we accordingly focus on 'the nature of the [junior user's] behavior' rather than on 'the impact of the use.'" (quoting *Brown*, 724 F.3d at 1245-46)).

²⁵³ Even under *Gordon*, the focus is not on whether consumers are confused but rather whether defendant: (1) used the mark for a directly competing product; and (2) added his own expressive content.

²⁵⁴ *Stouffer*, 2019 WL 3935180, at *12.

²⁵⁵ *Id.* at *2.

²⁵⁶ *Id.* at *12.

²⁵⁷ 329 F.3d 437 (6th Cir. 2003).

²⁵⁸ 909 F.3d 257 (9th Cir. 2018).

²⁵⁹ *Id.* at *13.

Instead, the court held that “genuine artistic motive” of the junior user was the more relevant consideration, and that it encompassed both prongs of the *Rogers* test.²⁶⁰ To determine whether a junior user had a genuine artistic motive in selecting a mark, several questions should be considered, including whether the junior user used the mark to identify the same or similar kinds of goods or services; to what extent the junior user added his or her own expressive content; whether the timing of the junior use suggested a motive to capitalize on the popularity of the senior user’s mark; the way in which the mark is artistically related to the underlying word; whether the junior user made any statements to the public or engaged in conduct known to the public that suggests a non-artistic motive (including but not limited to “explicitly misleading” statements); and whether the junior user made any statements in private, or engaged in any conduct in private, that suggests a non-artistic motive.”²⁶¹

Recognizing that the “genuine artistic motive” test is framed in terms of the junior user’s state of mind, the court also held that to adequately protect First Amendment interests, “the objective facts may sometimes excuse further inquiry into the junior user’s subjective motives.”²⁶² It should be a rare case, the court held, “in which a junior user with a ‘pure heart’ receives First Amendment protection but a junior user with a ‘black heart’ does not.”²⁶³ This is because the “First Amendment places a thumb on the scale of expressive use, even if at the expense of sometimes allowing junior users with subjectively ‘unartistic’ motives to avoid Lanham Act liability.”²⁶⁴

If the “genuine artistic motive” test favors the junior user, the court held that the inquiry would end there with no Lanham Act liability.²⁶⁵

Because the parties could not have anticipated that the court would formulate its own application of the *Rogers* test, it denied the motion to dismiss without prejudice to allow plaintiff the opportunity to amend its complaint and the defendant to refile for dismissal.²⁶⁶

At first glance, this “reformulation” of the *Rogers* test appears to be significant. But a closer examination reveals that it simply combines the artistic relevance/explicitly misleading prongs into one, and takes into account the “motive” issues courts seemed

²⁶⁰ *Id.* at *12.

²⁶¹ *Id.* at *12-13.

²⁶² *Id.* at *13.

²⁶³ *Id.*

²⁶⁴ *Id.*

²⁶⁵ *Id.* at *14.

²⁶⁶ *Id.*

troubled by in *Warner Bros. v. Global Asylum*,²⁶⁷ *CI Games*,²⁶⁸ *Fierce*,²⁶⁹ and *Gordon*.²⁷⁰ Artists who use a mark for genuine artistic purposes and without any intent or actions meant to capitalize on the senior user's goodwill or confuse consumers into believing the work is related to the other work should still find their interests fully protected by the First Amendment in this district or the Tenth Circuit if it upholds this decision or otherwise adopts this application of *Rogers*.

C. Rogers May Be Applied on Summary Judgment or Motions to Dismiss

Nearly every case applying *Rogers* has done so on either a motion to dismiss or on summary judgment. This is because “[c]ourts are cognizant of vindicating First Amendment protections through early dispositive motions to avoid chilling speech.”²⁷¹

Determining whether a defendant has satisfied the first prong of the *Rogers* test—artistic relevance—can usually be done simply by looking at the work itself. In *Louis Vuitton Malletier SA v. Warner Bros. Entertainment*, where the plaintiff alleged that Warner Bros. impermissibly used a counterfeit LOUIS VUITTON bag in the film *Hangover 2*, the plaintiff argued that whether the use was artistically relevant was an issue of fact that required discovery, and thus was inappropriate for a motion to dismiss.²⁷² The court disagreed, however, finding it obvious that the purpose of the use was to create an artistic association with LOUIS VUITTON by a snobbish character regardless of whether the bag was genuine or counterfeit, so discovery was unnecessary and summary judgment was appropriate.²⁷³

Determining whether a mark is explicitly misleading can also typically be done early in a proceeding. The Second Circuit “has never stated that a court cannot properly apply *Rogers* (or the likelihood of confusion factors) on a motion to dismiss. In fact, the Second Circuit has suggested that granting a motion to dismiss would be appropriate ‘where the court is satisfied that the products or marks are so dissimilar that no question of fact is presented,’”²⁷⁴ and that “no amount of discovery will tilt the scales in favor of the

²⁶⁷ 2012 WL 6951315, *5 (C.D. Cal. 2012), *aff'd*, 2013 WL 12114836, at *6.

²⁶⁸ 2016 WL 9185391, at *8.

²⁶⁹ No. C18-1449-MJP, 2019 WL 1453573 *1.

²⁷⁰ 909 F.3d at 269-71.

²⁷¹ *Rebellion Devs.* 2013 WL 1944888, at *4.

²⁷² 868 F. Supp. 2d 172, 178 (S.D.N.Y. 2012).

²⁷³ *Id.*

²⁷⁴ *Medina v. Dash Films, Inc.*, No. 15-cv-2551 (KBF), 2016 WL 3906714 (S.D.N.Y. July 14, 2016) (quoting *Louis Vuitton*, 868 F. Supp. 2d at 183).

mark holder at the expense of the public's right to free expression."²⁷⁵

In the Ninth Circuit and those following its interpretation of *Rogers*, courts can typically look to the allegations in the complaint and/or the work itself to determine whether a defendant has made any overt actions or explicit misstatements.²⁷⁶ A motion to dismiss may be inappropriate only in extremely limited situations where the nature of the use is such that consumers could believe that: the use indicated source; the junior and senior users were directly competing; the junior user had used the mark with minimal additional creativity; and there are factual issues regarding a defendant's possible intent. But presumably those factual determinations would not preclude summary judgment after discovery is complete given courts' proclivity to decide such issues without a trial.

IV. CONCLUSION

In the thirty years since the landmark holding in *Rogers v. Grimaldi* created a balancing test for trademark infringement cases implicating First Amendment rights, the law has continued to evolve. A series of cases from the Second and Ninth Circuits—the most influential jurisdictions on the subject—provide a road map for how freedom of artistic expression should be weighed against trademark rights.

Although the *Rogers* case concerned a false-endorsement claim involving a celebrity's name used as a film title and the court suggested that the test may not apply in cases involving confusingly similar titles, the Second Circuit quickly held that the *Rogers* balancing approach generally applies to Lanham Act claims against all works of artistic expression, and the limiting language from *Rogers's* footnote 5 says only that in competing title cases the specific requirement for an overt act or affirmative misstatement is not required to determine whether a use is explicitly misleading.²⁷⁷ Instead, in competing title cases, the determination of "explicitly misleading" must begin with an analysis of the likelihood-of-confusion factors, and if a likelihood of confusion is found, it must be sufficiently compelling to outweigh a junior user's First Amendment rights to artistic expression.²⁷⁸

²⁷⁵ *Louis Vuitton*, 868 F. Supp. 2d at 184.

²⁷⁶ See *Stewart Surfboards*, 2011 WL 12877019, at *5; *Rebellion*, 2013 WL 1944888, at *4 (In rejecting plaintiff's argument that the *Rogers* test is not well-suited to an early dispositive motion because a court may not have had the opportunity to examine the underlying work, the court held that "The *Rogers* test is an appropriate one to apply in the early stages of litigation.")

²⁷⁷ *Cliffs Notes, Inc.*, 886 F.2d at 494.

²⁷⁸ *Twin Peaks Prods.*, 996 F.2d at 1379.

The Ninth Circuit fully adopted the *Rogers* balancing test in 2002,²⁷⁹ and has since refined its application in deciding more cases than any other jurisdiction. First, it extended *Rogers* from titles to elements within creative works, and set the standard for artistic relevance as anything “above zero.”²⁸⁰ It then directed district courts to determine the explicitly misleading prong based on the junior user’s actions and not on the impact of its use of the mark, and it also made both survey evidence and a likelihood-of-confusion analysis irrelevant.²⁸¹ Significantly, the Ninth Circuit refuted any suggestion that *Rogers* applied only to marks that had achieved cultural significance and then only when the junior use was referencing the senior use, and it extended *Rogers*’s protection to include not just the artistic work itself, but also the promotion of the work.²⁸² Finally, it had occasion to examine the “outer limits” of *Rogers* and found that in the limited cases where consumers would believe that use of a mark in an artistic context was source-identifying, courts could find an explicitly misleading use even in the absence of explicit misstatements provided that the use was directly competing and the junior user had used the mark as the centerpiece of its work without adding much, if any, original content.²⁸³

The Fifth Circuit has largely adopted the methodology of the Second Circuit, while the Third, Sixth, and Eleventh Circuits as well as district courts within the Seventh Circuit have adopted the Ninth Circuit’s approach, and do not consider likelihood-of-confusion factors at all.²⁸⁴ A district court within the Tenth Circuit recently restructured *Rogers* into a single-prong “genuine artistic motive” test, which largely resembles the test as most recently refined by the Ninth Circuit.

The past decade also has established that *Rogers* applies in both forward and reverse confusion cases because there is no requirement for the junior use to refer to the senior use. Courts have made it clear that *Rogers* issues can be decided on motions to dismiss and for summary judgment.²⁸⁵ In fact, nearly all of the cases applying *Rogers* have done so through early dispositive motions.

The universal thread in thirty years of *Rogers* is the consistency with the *Rogers* court’s original concern: that consumer interests for creativity be satisfied, and only in those limited situations where a junior user acted in bad faith and intended to create confusion or

²⁷⁹ See *Mattel*, 296 F.3d at 902.

²⁸⁰ *E.S.S. Entm’t 2000*, 547 F.3d at 1100.

²⁸¹ *Brown*, 724 F.3d at 1245-46.

²⁸² *Twentieth Century Fox*, 875 F.3d at 1196-98.

²⁸³ *Gordon*, 909 F.3d at 269-71.

²⁸⁴ See *supra* Part III.B.

²⁸⁵ See *supra* Part III.C.

trade off the goodwill of the senior user should the Lanham Act appropriately prevail.
