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Explicitly Explicit: The Rogers Test and the Ninth Circuit

Daniel Jacob Wright

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EXPLICITLY EXPLICIT: THE *ROGERS* TEST AND THE NINTH CIRCUIT

*Daniel Jacob Wright**

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* J.D. Candidate 2014, University of Georgia School of Law. The author would like to thank Professor Joseph S. Miller and the members of the *Journal of Intellectual Property Law* for their help and guidance with this Note.

I. INTRODUCTION

Trademarks surround us in everyday life. Whether choosing between Coca-Cola or Pepsi at the grocery store, watching commercials for Ford and Chevy trucks, listening to a Cee Lo Green song about X-Box and Atari, or watching James Bond drive an Aston Martin in an exciting chase scene, people view and interact with trademarks on a daily basis. It is unsurprising, then, that content creators seek to use trademarks in expressive works—whether it be movies, television shows, video games, works of visual art, or books. Perhaps equally unsurprising are efforts made by trademark holders to control and define how and when their marks may be used. Ultimately, the courts have been left with the unenviable task of balancing the public interest in free speech against the rights of markholders within the framework of the Lanham Act.

This Note provides general background information on the development of trademark law before focusing on the confusion surrounding the Ninth Circuit's adoption and application of the *Rogers* test—perhaps the most well-known test for resolving disputes between free speech and trademark protection. Ultimately, this Note argues that the decision by some Ninth Circuit district courts to import elements of the traditional test for infringement into the *Rogers* test unnecessarily confuses the law and threatens to create a chilling effect on content creators desiring to use marks in expressive works.

II. BACKGROUND

A. THE LANDSCAPE OF TRADEMARK LAW

1. *Basic Trademark Principles.* As defined by the Lanham Act, a trademark is “any word, name, symbol, or device, or any combination thereof” used by a manufacturer or seller “to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”¹ A similar concept, trade dress, applies to the distinctive packaging used for a product.² A trademark might be thought of as a commercial signature, certifying that the product bearing the mark originates with a particular manufacturer or seller. This certification of origin, when viewed in the commercial context, provides benefits to both consumers and manufacturers.

¹ 15 U.S.C. § 1127 (2006).

² *Id.* § 1125(a)(1).

For consumers, trademarks are reliable indicators of source that reduce the likelihood that unwanted products will be purchased.³ Consumers may purchase a red can bearing the name and logo of Coca-Cola without worrying that they are, in fact, purchasing a Pepsi. Less obviously, trademarks lower the search costs for consumers trying to find what they want in the marketplace.⁴ As consumers come to associate Coca-Cola with its red packaging and distinctive cursive script, they may quickly and efficiently find and purchase a case of Coca-Cola without looking at each and every case of soda at the grocery store.

For manufacturers, trademarks permit the creation of goodwill within the marketplace.⁵ By maintaining a consistent level of quality in their products or services, manufacturers can develop a reputation with consumers who come to view the manufacturers' marks as guarantees of a consistent level of quality.⁶ For example, a consumer who has a favorable experience with a Dell desktop computer may later decide to purchase a Dell laptop, trusting that it will exhibit the same general level of quality.

In short, trademarks convey a great deal of economic information accurately and quickly. With a quick glance at a trademark, a consumer can confidently determine the origin and expected quality of a product and distinguish it from different but similar products. Such confidence would be seriously undermined without at least some legal protection of trademarks.⁷ Like a person's signature, a manufacturer's trademark would be meaningless as a guarantee of quality if competitors could affix it to their own goods and pass them off as originating with the markholder.⁸ At its most basic, modern trademark law is designed to prevent the problems caused by such "passing-off" in the marketplace.⁹

Under federal law, the Lanham Act permits markholders to sue for the unauthorized use of their marks when such use is likely to create confusion as

³ WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 166–68 (2003).

⁴ *Id.*

⁵ See generally Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 787–92 (2004) (discussing the general economic framework of trademark protection).

⁶ LANDES & POSNER, *supra* note 3.

⁷ Vincent Chiappetta, *Trademarks: More Than Meets the Eye*, 2003 U. ILL. J.L. TECH. & POL'Y 35, 59–61.

⁸ *Id.*

⁹ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 28 (2003) ("The Lanham Act was intended to make 'actionable the deceptive and misleading use of marks,' and 'to protect persons engaged in . . . commerce against unfair competition.'" (quoting 15 U.S.C. § 1127 (2006))).

to the “affiliation, connection, or association” of the markholder or the “origin, sponsorship, or approval” of the offered product.¹⁰ Trademark infringement analysis focuses on whether there is a likelihood of consumer confusion.¹¹ In short, the relevant inquiry is whether the unauthorized use of the mark threatens to lead consumers to mistakenly believe that the markholder is associated with the product or service.¹² Such a determination primarily involves a fact-based application of several non-exclusive “likelihood of confusion” factors which vary from circuit to circuit.¹³ The Ninth Circuit, for example, evaluates the presence of eight factors: (1) the strength of the plaintiff’s mark; (2) the proximity or relatedness of the goods; (3) the similarity of the marks; (4) the presence of actual consumer confusion; (5) the marketing channels used; (6) the degree of care customers are likely to exercise in purchasing the goods; (7) the defendant’s intent in using the mark; and (8) the likelihood of expansion such that both parties will compete in the same market.¹⁴ Not all factors are weighed equally by the courts, and some may not apply at all depending on the given facts of a case.¹⁵

2. *Branding and the Modern Trademark.* In cases involving the origin of a product, reliance on consumer confusion as the touchstone for trademark infringement offers few problems.¹⁶ If a soda company appropriates the Coca-Cola trademark and trade dress to sell its soda, the proper inquiry is whether consumers are likely to have been confused into falsely believing that the soda was actually Coca-Cola. These passing-off claims are, as discussed earlier, at the core of what trademark law was designed to prevent.¹⁷

¹⁰ 15 U.S.C. 1125(a) (2006).

¹¹ *Leelanau Wine Cellars, Ltd. v. Black & Red, Inc.*, 502 F.3d 504, 515 (6th Cir. 2007).

¹² *Id.*

¹³ See, e.g., *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 602 (9th Cir. 2005) (“Because of the intensely factual nature of trademark disputes, summary judgment is generally disfavored in the trademark arena.” (quoting *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1140 (9th Cir. 2002))); see also Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1582–85 (2006) (discussing the significant variation in factors employed by the various circuits to determine the likelihood of confusion).

¹⁴ *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979), *abrogated in part on other grounds by* *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

¹⁵ *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1008 (9th Cir. 2001).

¹⁶ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (“Limited to this core purpose—avoiding confusion in the marketplace—a trademark owner’s property rights play well with the First Amendment.”).

¹⁷ While many scholars have argued persuasively that trademark law, at its inception, was not overly focused on protecting consumers, it was certainly focused on preventing deceitful business practices. See Lionel Bently, *From Communication to Thing: Historical Aspects of the Conceptualisation of Trade Marks as Property*, in *TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY*

However, modern trademarks serve as more than indicators of origin. Manufacturers and service providers have harnessed the communicative power of trademarks through the process of “branding,” imbuing marks with expressive and cultural significance.¹⁸ Beyond guaranteeing a certain level of quality, trademarks can convey desirable secondary reasons to own products.¹⁹ Branding can suggest to consumers that purchasing a product will make them healthier, happier, or more interesting.²⁰ For example, consumers may be persuaded by branding that Kashi food will make them healthier, or that Axe shampoo will make them more attractive to women.

Trademarks, in conjunction with branding, may also convey information wholly unrelated to the product bearing the mark.²¹ While consumers might buy Kashi cereal because they like how it tastes or because it might make them healthier, they may also decide to purchase items with the Kashi brand to support Kashi’s avowed commitment to environmental stewardship. Trademarks may even communicate that an individual is part of a special group of people, encouraging consumers to buy products to display the mark to their peers.²² A person wearing a cap with the Boston Red Sox logo displays to others that she is a fan of the team. Similarly, the Louis Vuitton and Porsche marks may be appealing to consumers for their ability to communicate to others that the owner is wealthy or successful.²³

Branding, in effect, leverages a trademark’s communicative ability to exert a distinctive or even unique impact on the minds of consumers, thus increasing selling power.²⁴ This differentiation in the minds of consumers goes beyond the mere recognition that one product originates with one manufacturer while

RESEARCH 3, 5–15 & n.13 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008) (discussing the early development of trademark law in England); Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1850 (2007).

¹⁸ See Thomas D. Drescher, *The Transformation and Evolution of Trademarks—From Signals to Symbols to Myth*, 82 TRADEMARK REP. 301, 328 (1992) (discussing the symbolic nature of trademarks resulting from “a process of mythical attachments by which . . . marks are made to refer not only to the product itself, but also to broader cultural themes”); Jerre B. Swann et al., *Trademarks and Marketing*, 91 TRADEMARK REP. 787, 800–03 (2001) (discussing the “emotional and self-expression benefits” of modern brands as well as their ability to fill social needs).

¹⁹ Chiappetta, *supra* note 7, at 46.

²⁰ *Id.*

²¹ See *id.* (noting the “broader social considerations” communicated by brands).

²² *Id.*

²³ Swann et al., *supra* note 18, at 797.

²⁴ See Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 819 (1927) (opining that trademarks can actually create the goodwill that they convey and thus “actually sell[] the goods”).

another product originates with another.²⁵ Manufacturers certainly have an interest in protecting the differentiating power of their trademarks, especially since cultivating and establishing brand appeal often involves significant expenditures of time and money.²⁶ However, these examples evidence the potential for increasing sales by tapping in consumers' preference for distinctive products.

The Lanham Act is, in part, responsive to such concerns. Beyond permitting suits over consumer confusion concerning the origin of a marked product, 15 U.S.C. § 1125 prohibits the use of marks that cause confusion as to the affiliation, connection, or association with the markholder or as to the sponsorship or approval of goods or services.²⁷ The Lanham Act also provides a cause of action for "trademark dilution," where a use, though not confusing as to the origin or sponsorship of a product, nonetheless acts to chip away at a famous mark's distinctive impact on a consumer (dilution by blurring) or draw negative associations with the mark (dilution by tarnishment).²⁸ Unlike infringement, dilution actions do not require the plaintiff to show a likelihood of confusion.²⁹ However, several exceptions to dilution liability exist, including fair use, parody, news reporting, and non-commercial uses of a mark.³⁰

As the many restrictions on dilution suggest, markholders do not possess the unfettered right to determine how their marks are used. Courts have carved out numerous exceptions to trademark infringement liability. A markholder may not, for example, seek trademark protection if his mark has become the commonly accepted term for a product or good such that consumers no longer consider the mark an indicator of origin.³¹ The classic trademark "fair use doctrine" provides a defense when the mark or symbol is used by a defendant

²⁵ See Barton Beebe, *Search and Persuasion in Trademark Law*, 103 MICH. L. REV. 2020, 2029–31 (2005) (distinguishing source distinctiveness from "differential distinctiveness," which "refers . . . to the uniqueness of singularity of the mark").

²⁶ Chiappetta, *supra* note 7, at 57–60.

²⁷ 15 U.S.C. § 1125(a) (2006).

²⁸ *Id.* § 1125(c) ("[A] mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner.").

²⁹ *Id.* § 1125(c)(1).

³⁰ *Id.* § 1125(c)(3).

³¹ See *id.* § 1127 (explaining that a mark is "abandoned" if the markholder allows the mark to become a "generic" term); see also *Van Well Nursery, Inc. v. Mony Life Ins. Co.*, 421 F. Supp. 2d 1321, 1327–28 (E.D. Wash. 2006) ("Even the most distinctive symbols—coined words having no descriptive or suggestive quality—may become generic if they are adopted by the public as the name of the product rather than as the mark of the producer. Familiar examples are Aspirin, Cellophane, and Thermos, all of which were once, but are no longer, trademarks of a single manufacturer.").

to describe his own products, as opposed to those of the plaintiffs.³² The “nominative fair use doctrine,” a common law extension of the statutory classic fair use defense, protects the unauthorized use of a mark when such a use is the only practical way to identify a product or service, provided that the mark is used no more than necessary and does not imply sponsorship by the markholder.³³

3. *Trademark Protection and Free Speech.* These exceptions to trademark protection exist because trademark law, unlike patent or copyright law, “does not exist to reward manufacturers for their innovation in creating a particular devic.”³⁴ Rather, trademark law, “by preventing competitors from copying ‘a source-identifying mark,’ ‘reduce[s] the customer’s costs of shopping and making purchasing decisions,’ and ‘helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product.’”³⁵

This distinction between trademark law and patent and copyright law reflects the different origins of each form of intellectual property protection. While congressional authority to enact both patent and copyright laws stems from the constitutional grant of power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries,”³⁶ congressional authority to enact trademark law is derived from the Commerce Clause.³⁷ Trademark law is thus less concerned with conferring exclusive rights to markholders than it is with promoting efficient and competitive markets by providing consumers with more accurate information—i.e., protecting trademarks as reliable indicators of source.³⁸ If the use of a mark, though unauthorized, does not interfere with the

³² See 15 U.S.C. § 1115(b)(4) (2006); *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992) (“[T]he classic fair use case [is] where the defendant has used the plaintiff’s mark to describe the defendant’s *own* product.”).

³³ *New Kids on the Block*, 971 F.2d at 308; see also William Spieler, *Nominative Fair Use in Trademark Law: A Fair Use Like No Other*, J. PAT. & TRADEMARK OFF. SOC’Y 780, 786 (noting that “there is no statutory protection granted to nominative fair use” and otherwise distinguishing classic and nominative fair use).

³⁴ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) (quoting *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34 (2001) (internal quotation marks omitted)).

³⁵ *Id.* (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995)).

³⁶ U.S. CONST. art. I, § 8, cl. 8.

³⁷ See *Trade Mark Cases*, 100 U.S. 82, 96–97 (1879) (asserting that federal trademark laws “can only be valid as a regulation of commerce” and rejecting such a law that reached beyond the confines of the Commerce Clause); U.S. CONST. art. I, § 8, cl. 3.

³⁸ See *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 379 (2d Cir. 1997) (“[T]he Lanham Act must be construed in the light of a strong federal policy in favor of vigorously competitive markets, which is exemplified by the Sherman Act and other anti-trust

communicative function of the mark within the marketplace, or if the use implicates other important public interests such as free speech, the justification for protecting the markholder becomes more attenuated.³⁹

The tension between the public interest in protecting trademarks and in protecting free speech is particularly strong because the traits that make marks so valuable as brand icons also make them convenient and powerful cultural symbols when used outside the commercial marketplace.⁴⁰ Indeed, the powerful impact of trademarks makes them particularly suited to expressive works of entertainment, where trademarks may be included to create a sense of verisimilitude, portray certain characters or events, or serve as well-known cultural symbols.⁴¹

B. THE ROGERS TEST

1. *Origins of the Test.* While cognizant of the tension between free speech and trademark protection, circuit counts differ in how they supplement the traditional consumer confusion test when markholder interests conflict with First Amendment free speech rights.⁴² The landmark case *Rogers v. Grimaldi*⁴³ established what is perhaps the most famous and widely applied test for protecting First Amendment interests in the context of trademark law.

In *Rogers*, famous Hollywood performer Ginger Rogers brought suit against defendant producers and distributors of a film entitled *Ginger and Fred*, alleging that the film's title violated the Lanham Act under 15 U.S.C. § 1125(a) by

laws.”); Elizabeth L. Rosenblatt, *Rethinking the Parameters of Trademark Use in Entertainment*, 61 FLA. L. REV. 1011, 1022 (2009).

³⁹ See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (“[W]hen a trademark owner asserts a right to control how we express ourselves . . . applying the traditional [likelihood of confusion] test fails to account for the full weight of the public’s interest in free expression.”); *Car-Freshener Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 269 (2d Cir. 1995) (noting the “great importance” of “protect[ing] the right of society at large to use words or images in their primary descriptive sense”); *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 305 (9th Cir. 1992) (“Throughout the development of trademark law, the purpose of trademarks remained constant and limited: Identification of the manufacturer or sponsor of a good or the provider of a service.”).

⁴⁰ Rosenblatt, *supra* note 38, at 1027.

⁴¹ *Id.* at 1026–27.

⁴² While many circuits employ some variant of the *Rogers* test, some do not. See *Cartoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 972–76 (10th Cir. 1996) (balancing right of publicity interests against First Amendment interests); *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 775–77 (8th Cir. 1994) (balancing the interests after performing likelihood of confusion analysis).

⁴³ *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

“creating the false impression that the film was about her or that she sponsored, endorsed, or was otherwise involved in the film.”⁴⁴

At trial, Rogers offered survey evidence showing that forty-three percent of individuals exposed to the film’s title associated the film with Rogers and that twenty-seven percent of those exposed to a promotional advertisement for the film associated the film with Rogers.⁴⁵ Rogers also introduced evidence that the film’s distributor in the United States, MGM, had devised several promotional schemes tying the film to Fred Astaire and Ginger Rogers, though only one was ultimately implemented.⁴⁶

The defendants argued that First Amendment protections for free speech shielded the film from Rogers’s claims.⁴⁷ The film itself told the fictional story of two Italian cabaret performers who imitated Hollywood performers Ginger Rogers and Fred Astaire.⁴⁸ The film’s screenwriter, Federico Fellini, submitted an affidavit claiming that the names “Fred and Ginger” had been chosen as symbols of hope during a difficult period in Italy, and that the characters in the film were never intended to resemble or otherwise portray the real Fred Astaire and Ginger Rogers.⁴⁹ Rogers countered that the defendants could have conveyed this artistic message without infringing on her rights or deceiving the public.⁵⁰

The district court ultimately ruled in favor of the defendants, granting summary judgment and dismissing the complaint. The court concluded that the film was a work of artistic expression, not a commercial product, and thus beyond the scope of the Lanham Act.⁵¹ While affirming the judgment on appeal, the Second Circuit ruled that the Lanham Act *could* be applied to titles of expressive works.⁵² Recognizing the commercial nature of many works of artistic expression, the court acknowledged that consumers could still be harmed by artistic works with misleading titles.⁵³ Rather than affording titles of artistic works complete immunity from Lanham Act claims, the Second Circuit

⁴⁴ *Id.* at 996–97.

⁴⁵ *Rogers v. Grimaldi*, 695 F. Supp. 112, 115 (S.D.N.Y. 1988).

⁴⁶ *Id.*

⁴⁷ *Id.* at 116.

⁴⁸ *Id.* at 114.

⁴⁹ *Id.* at 114–15. Fellini was not a party to the suit. *Id.* at 114.

⁵⁰ *Id.* at 116.

⁵¹ *Id.* at 124.

⁵² *Rogers v. Grimaldi*, 875 F.2d 994, 997 (2d Cir. 1989) (“In effect, the District Court’s ruling would create a nearly absolute privilege for movie titles, insulating them from Lanham Act claims as long as the film itself is an artistic work, and the title is relevant to the film’s content. We think that approach unduly narrows the scope of the Act.”).

⁵³ *Id.*

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.”⁵⁴ In the context of titles of artistic works, the Second Circuit stated that balancing these conflicting interests “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 the work.”⁵⁵

Applying this standard to the facts of the case, the Second Circuit agreed with the district court that the *Ginger and Fred* title had some artistic relevance to the content of the film.⁵⁶ They held that the title not only alluded to the nicknames of the fictional protagonists, but also served as a symbol of “elegance and class” that the screenwriter contrasted in the film with the “gaudiness and banality of contemporary television.”⁵⁷ While Rogers argued that First Amendment protection should apply only if the author has no alternative way of titling his work without violating the Lanham Act, the court was unpersuaded,⁵⁸ stating that such a “no alternative” standard would provide “insufficient leeway for literary expression.”⁵⁹

Having established artistic relevance, the Second Circuit next determined that the title did not explicitly mislead as to the content or sponsorship of the film.⁶⁰ While conceding that at least some people reading the title might think that the film was about Fred Astaire and Ginger Rogers, the interest in protecting artistic expression,⁶¹ outweighed the risk of consumer confusion. The Second Circuit reasoned that, unlike commercial products, which consumers expect to be named accurately and to which courts apply the Lanham Act rigorously, titles of artistic works are not taken so literally by consumers.⁶² Only an explicitly misleading title, such as “The True Life Story of Ginger and Fred,” would pose a sufficient threat of consumer confusion to permit an action under the Lanham Act.⁶³ Accordingly, the Second Circuit

⁵⁴ *Id.* at 999.

⁵⁵ *Id.*

⁵⁶ *Id.* at 1001.

⁵⁷ *Id.*

⁵⁸ *Id.* at 998–99.

⁵⁹ *Id.* at 999.

⁶⁰ *Id.* at 1001–02.

⁶¹ *Id.* (“To the extent that there is a risk that the title will mislead some consumers as to what the work is about, that risk is outweighed by the danger that suppressing an artistically relevant though ambiguous title will unduly restrict expression.”).

⁶² *Id.* at 1000 (“[M]ost consumers are well aware that they cannot judge a book solely by its title any more than by its cover.”).

⁶³ *Id.*

found the title protected under the First Amendment, barring application of the Lanham Act.⁶⁴

Rogers v. Grimaldi effectively established a two-pronged test to determine whether a title of an artistic work is entitled to First Amendment protection in Lanham Act trademark infringement cases. Under the *Rogers* test, a defendant must show that (a) the title of the work has some artistic relevance to the underlying work; and (b) that the title is not explicitly misleading as to the source or content of the work.⁶⁵ In addition, the *Rogers* test may only be applied to noncommercial uses of a mark.⁶⁶

2. *Circuit Adoption and Development of the Rogers Test.* While originating in the Second Circuit, the *Rogers* test has since been adopted in some form or fashion by the Fifth, Sixth, Ninth, and Eleventh Circuits.⁶⁷ While the Second Circuit initially limited the *Rogers* test to titles of artistic works, it has since been applied in some circuits to uses of marks in artistic works generally.⁶⁸ However, the actual application of the *Rogers* test has varied widely across the different circuits, even within the Second Circuit itself. Less than a year after *Rogers v. Grimaldi*, the Second Circuit revisited the *Rogers* test in *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group*.⁶⁹ In *Cliffs Notes*, the defendant published a book parodying the Cliffs Notes series of study aids, which provide short synopses of

⁶⁴ *Id.* at 1001–02.

⁶⁵ *Id.* at 999.

⁶⁶ The generally accepted definition of commercial speech is speech which “does ‘no more than propose a commercial transaction.’” *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66 (1983) (quoting *Virginia Pharmacy Bd. v. Virginia Citizens Consumer Council*, 425 U.S. 748, 762 (1976)). See, e.g., *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 906 (9th Cir. 2002) (applying the *Bolger* definition of commercial speech in trademark infringement cases); *Univ. of Alabama Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1276 (11th Cir. 2012) (stating that expressive speech does “more than ‘propos[e] a commercial transaction’” (quoting *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 562 (1980))). Determining whether speech is commercial or not does not appear to cause courts too much difficulty in trademark infringement cases. *Id.*

⁶⁷ See, e.g., *Univ. of Ala. Bd. of Trs.*, 683 F.3d at 1278; *Parks v. LaFace Records*, 329 F.3d 437, 450–51 (6th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65 (5th Cir. 2000).

⁶⁸ See *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (opining that the *Rogers* test should “apply to the use of a trademark in the body of the work”); *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 928 n.11 (6th Cir. 2003) (noting that the *Rogers* test is “generally applicable to all cases involving literary or artistic works”); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp.*, 886 F.2d 490, 495 (2d Cir. 1989) (“[W]e hold that the *Rogers* balancing approach is generally applicable to Lanham Act claims against works of artistic expression . . .”).

⁶⁹ *Cliffs Notes*, 886 F.2d at 490.

literary works routinely read in university literature classes.⁷⁰ Cliffs Notes brought suit under the Lanham Act to enjoin the sale of the books, which used features of Cliffs Notes' distinctive black and yellow trade dress, arguing that the parody would confuse consumers into thinking that Cliffs Notes had published or sponsored the books.⁷¹ The district court found the *Rogers* test inapplicable and applied a traditional likelihood of confusion test, ultimately issuing a preliminary injunction on the sale of the books.⁷²

On review, the Second Circuit extended the *Rogers* test to cover artistic expression in general, not just titles.⁷³ The Second Circuit's application of the test, however, differed markedly from that in *Rogers* itself. In endorsing the *Rogers* test as the appropriate method "to weigh the public interest in free expression against the public interest in avoiding consumer confusion,"⁷⁴ the Second Circuit stated that the *Rogers* test "takes into account the ultimate test in trademark law, namely, the likelihood of confusion as to the source of the goods."⁷⁵ The Second Circuit then proceeded to determine whether the defendant's use was likely to cause confusion without specifically mentioning the likelihood of confusion factors used within the Second Circuit.⁷⁶ The Second Circuit ultimately held that the defendant's use did not create a strong likelihood of confusion and vacated the preliminary injunction.⁷⁷

The Second Circuit again employed a likelihood of confusion analysis in connection with the *Rogers* test in *Twin Peaks Productions, Inc. v. Publications International, Ltd.*⁷⁸ Determining that the defendant's use was artistically relevant enough to satisfy the first prong of the *Rogers* test, the Second Circuit remanded the case to determine whether consumer confusion was likely under the Second Circuit's factors.⁷⁹

In both cases, the Second Circuit's application of the *Rogers* test appears to have been less than complete. While the Second Circuit applied the first prong in both cases to determine whether the trademark use was artistically relevant, it then employed a likelihood of confusion test to weigh the public interest in free

⁷⁰ *Id.* at 491–92.

⁷¹ *Id.* at 492.

⁷² *Id.* at 493.

⁷³ *Id.* at 495.

⁷⁴ *Id.* at 494.

⁷⁵ *Id.* at 495 (quoting *Universal City Studios, Inc. v. Nintendo Co.*, 746 F.2d 112, 115 (2d Cir. 1984)).

⁷⁶ *Id.* at 495–97.

⁷⁷ *Id.* at 497.

⁷⁸ *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366 (2d Cir. 1993).

⁷⁹ *Id.* at 1379.

speech against the public interest in avoiding consumer confusion.⁸⁰ In *Rogers*, no such analysis took place.⁸¹

However, the Second Circuit is not alone in employing a likelihood of confusion analysis in conjunction with the *Rogers* test. In *Westchester Media v. PRL USA Holdings, Inc.*,⁸² the Fifth Circuit held that the second prong of the *Rogers* test required a likelihood of confusion analysis and that only a “particularly compelling” likelihood of confusion would overcome First Amendment protections.⁸³

The Sixth and Eleventh Circuits, in contrast, have applied the *Rogers* test in a manner more similar to its original incarnation. In *ETW Corp. v. Jireh Publishing, Inc.*, the Sixth Circuit employed the *Rogers* test in a trademark infringement case involving the unauthorized use of professional golfer Tiger Woods’s name and likeness in a painting depicting several champions of the famous Masters golf tournament.⁸⁴ After extending the *Rogers* test to artistic works in general,⁸⁵ the Sixth Circuit determined that the use had artistic relevance and did not explicitly mislead as to the source or sponsorship of the work.⁸⁶ The dissent contended that the *Rogers* test should not have been expanded beyond its original application to artistic titles and argued for the application of a likelihood of confusion analysis to determine whether a use was misleading, citing *Cliffs Notes, Inc.* extensively.⁸⁷ The majority specifically rejected this approach.⁸⁸

Similarly, the Eleventh Circuit recently adopted the *Rogers* test in a case involving the unauthorized depiction of the University of Alabama football team’s uniforms in paintings, prints, and calendars.⁸⁹ After determining that the defendant’s use contained some artistic relevance, the Eleventh Circuit found no evidence that the defendant artist had “ever marketed an unlicensed item as ‘endorsed’ or ‘sponsored’ by the University, or otherwise explicitly stated that such items were affiliated with the University.”⁹⁰ While acknowledging that some members of the public might incorrectly assume that the University was

⁸⁰ *Twin Peaks Prods., Inc.*, 996 F.2d at 1366, 1379; *Cliffs Notes*, 886 F.2d at 490.

⁸¹ *Rogers v. Grimaldi*, 875 F.2d 994, 1001–02 (2d Cir. 1989).

⁸² *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000).

⁸³ *Id.* at 664–65 (quoting *Twin Peaks*, 996 F.2d at 1379) (internal quotation omitted).

⁸⁴ *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003).

⁸⁵ *Id.* at 928 n.11.

⁸⁶ *Id.* at 937.

⁸⁷ *Id.* at 940–41, 943–49.

⁸⁸ *Id.* at 937 (“We disagree with the dissent’s suggestion that a jury must decide where the balance should be struck and where the boundaries should be drawn between the rights conferred by the Lanham Act and the protections of the First Amendment.”).

⁸⁹ *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278–79 (11th Cir. 2012).

⁹⁰ *Id.*

associated with the defendant's work, the Eleventh Circuit held that this risk was "outweighed by the interest in artistic expression."⁹¹

C. THE ROGERS TEST IN THE NINTH CIRCUIT

1. *The Barbie Cases.* While the circuits have applied the *Rogers* test in different and perhaps contradictory ways, the application of the test within the Ninth Circuit has proven particularly confusing. The *Rogers* test as originally adopted by the Ninth Circuit in *Mattel, Inc. v. MCA Records, Inc.*⁹² appeared to track the original application of the test in *Rogers v. Grimaldi*.⁹³ *MCA Records* involved Lanham Act claims brought by Mattel, manufacturer of the famous Barbie doll.⁹⁴ Mattel objected to the Danish band Aqua's use of the term *Barbie* in its hit song *Barbie Girl*,⁹⁵ which poked fun at the doll and the values the defendants thought she represented.⁹⁶ While the district court ruled in the defendant's favor on other grounds,⁹⁷ the Ninth Circuit instead adopted the *Rogers* test to decide the case.⁹⁸ Applying the first prong of the *Rogers* test, the Ninth Circuit determined that the use was artistically relevant.⁹⁹ The Ninth Circuit also held that the use did not explicitly mislead as to Mattel's association with the song.¹⁰⁰ No likelihood of confusion analysis was provided.¹⁰¹

The Ninth Circuit revisited the *Rogers* test (and Barbie dolls) in *Mattel, Inc. v. Walking Mountain Productions*.¹⁰² In this case, Mattel took exception to the defendant's production and sale of photographs containing the Barbie doll.¹⁰³ Most of these "photos portray[ed] a nude Barbie in danger of being attacked by

⁹¹ *Id.* at 1279 (first alteration in original) (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d Cir. 1989)) (internal quotation marks omitted).

⁹² *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002).

⁹³ *See id.* at 901–02 (discussing the facts and policies of *Rogers* and then "agree[ing] with the Second Circuit's analysis and adopt[ing] the *Rogers* standard as [their] own").

⁹⁴ *Id.* at 899.

⁹⁵ AQUA, *Barbie Girl*, on AQUARIUM (MCA Records 1997).

⁹⁶ *MCA Records*, 296 F.3d at 901.

⁹⁷ *Id.* at 899.

⁹⁸ *Id.* at 902.

⁹⁹ *Id.* ("Under the first prong of *Rogers*, the use of Barbie in the song title clearly is relevant to the underlying work, namely, the song itself. As noted, the song is about Barbie and the values [Defendant] claims she represents.").

¹⁰⁰ *Id.* ("The song title does not explicitly mislead as to the source of the work; it does not, explicitly or otherwise, suggest that it was produced by Mattel.").

¹⁰¹ *Id.* at 902 & n.2.

¹⁰² *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2008).

¹⁰³ *Id.* at 796.

vintage household appliances.”¹⁰⁴ The relevant Lanham Act claims concerned the use of *Barbie* in the titles of the photographs and the depiction of the distinctive Barbie trade dress in the photographs themselves.¹⁰⁵ The defendant, a self-professed “Artsurdist,” claimed that his photographs were “an attempt to ‘critique[] the objectification of women associated with [Barbie]. . . .’ ”¹⁰⁶

The Ninth Circuit applied the *Rogers* test to the trademark claims concerning the use of *Barbie* in the photographs’ titles, but declined to extend the test to trade dress infringement.¹⁰⁷ The court’s analysis substantially followed the approach set out in *MCA Records*, concluding that the use of the Barbie trademark was artistically relevant to the underlying work and did not explicitly mislead the consumer as to Mattel’s association with the work.¹⁰⁸

However, unlike in *MCA Records*, the Ninth Circuit suggested that the *Rogers* test only applied to the unauthorized use of marks with transcendent meaning that had entered the everyday public discourse, quoting language from Judge Kozinski’s opinion in *MCA Records*.¹⁰⁹ According to the court, *MCA Records* had determined that the Barbie mark possessed the required cultural significance to possess transcendent meaning and thus *Rogers* test protected.¹¹⁰

2. E.S.S. Entertainment. The Ninth Circuit appeared to discard the cultural significance requirement from *Walking Mountain* just five years later in *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.* (E.S.S.).¹¹¹ In E.S.S., the plaintiff operator of a strip club in Los Angeles called Play Pen Gentleman’s Club filed suit against Rockstar Games alleging trade dress infringement under the Lanham Act.¹¹² According to the plaintiff, Rockstar Games had used the distinctive logo and trade dress of Play Pen in the game *Grand Theft Auto: San Andreas* by including a similar strip club in the game called the Pig Pen.¹¹³ E.S.S. essentially argued that the similarities between the Pig Pen logo and the

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* at 797.

¹⁰⁶ *Id.* at 796–97.

¹⁰⁷ *Id.* at 807–08.

¹⁰⁸ *Id.* at 806–07.

¹⁰⁹ *See id.* (“[W]hen marks ‘transcend their identifying purpose’ and ‘enter public discourse and become an integral part of our vocabulary’ . . . First Amendment protections come into play.” (quoting *MCA Records*, 296 F.3d at 900)).

¹¹⁰ *Id.* at 807 (“As we determined in *MCA*, Mattel’s ‘Barbie’ mark has taken on such a [transcendent] role in our culture.” (citing *MCA Records*, 296 F.3d at 898–99)).

¹¹¹ *See* 547 F.3d 1095, 1100 (9th Cir. 2008) (conceding that “Play Pen has little cultural significance,” but nonetheless concluding that its inclusion has “at least ‘some artistic relevance.’ ” (citing *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989))).

¹¹² *Id.* at 1097–98.

¹¹³ *Id.* at 1097.

configuration of the building risked leading consumers to believe E.S.S. sponsored or endorsed the game.¹¹⁴ Rockstar Games moved for summary judgment at trial, asserting nominative fair use and First Amendment free speech defenses.¹¹⁵

The district court rejected the nominative fair use defense but granted summary judgment to the defendants on First Amendment grounds, extending the *Rogers* test to trade dress and trademark use in artistic works.¹¹⁶ The district court then determined that the use had artistic relevance and did not explicitly mislead as to the source or content of the game, employing both prongs of the *Rogers* test in turn.¹¹⁷ The district court's opinion did not analyze whether the Play Pen possessed transcendent meaning or had entered into common use in public discourse.¹¹⁸

The Ninth Circuit affirmed the judgment on appeal, rejecting E.S.S.'s argument that the Play Pen had no cultural significance permitting a First Amendment defense.¹¹⁹ While conceding "that Play Pen ha[d] little cultural significance," the court noted that "the same could be said about most of the . . . establishments in East Los Angeles."¹²⁰ Of greater importance to the court was whether the use was artistically relevant.¹²¹

Moving to the second prong, the Ninth Circuit found that Rockstar's use did not explicitly mislead as to the source or content of the game.¹²² However, the Ninth Circuit's application of this prong of the *Rogers* test differed significantly from that of the trial court. When discussing whether Rockstar's use was explicitly misleading, the Ninth Circuit framed "[t]he relevant question [as] whether the Game would confuse its players into thinking that the Play Pen is somehow behind the Pig Pen or that it sponsors Rockstar's product."¹²³ The court then determined that Rockstar's use did not present any likelihood of confusion because no reasonable consumer would think (1) that E.S.S. had

¹¹⁴ *Id.* at 1098.

¹¹⁵ *Id.*

¹¹⁶ *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp. 2d 1012, 1039–40, 1048 (C.D. Cal. 2006).

¹¹⁷ *Id.* at 1040–48.

¹¹⁸ *Id.*

¹¹⁹ *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1101 (9th Cir. 2008).

¹²⁰ *Id.* at 1100.

¹²¹ *Id.* "Under *MCA Records* and the cases that followed it, only the use of a trademark with 'no artistic relevance to the underlying work *whatsoever*' does not merit First Amendment protection." (quoting *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (internal quotation marks omitted)).

¹²² *Id.* at 1100–01.

¹²³ *Id.* at 1100.

provided Rockstar with expertise or support in making the game, (2) that E.S.S. had entered the video game industry, or (3) that Rockstar operated strip clubs.¹²⁴

The approach taken by the Ninth Circuit to determine whether Rockstar Games's use was explicitly misleading appeared to invoke the traditional likelihood of confusion test, though the court never formally applied the confusion factors used by the Ninth Circuit.¹²⁵ The district court explicitly declined to take this approach.¹²⁶ While the district court did engage in some likelihood of confusion analysis,¹²⁷ it appears to have done so to compare the case to the facts in *Rogers v. Grimaldi*, where the unauthorized use posed a greater risk of consumer confusion but was nonetheless protected under the First Amendment.¹²⁸ In affirming the district court's decision, the Ninth Circuit expressed no opinion regarding the rationale employed by the district court and the likelihood of confusion analysis supplied by the Ninth Circuit was brief, even in comparison to that provided by the district court.¹²⁹

3. *Post-E.S.S. Entertainment Confusion.* The district court decisions following *E.S.S.* have exhibited confusion regarding the application of the *Rogers* test. The court in *Roxbury Entertainment v. Penthouse Media Group, Inc.*¹³⁰ applied the *Rogers* test to a case involving the use of a trademark in the title and packaging of a pornographic film.¹³¹ The court quoted the language from *E.S.S.* that the second prong of *Rogers* involves an inquiry into "whether consumers would be misled about the source or sponsorship of Defendants' movie." However, it did not engage in an involved likelihood of confusion analysis, stating only that use alone in a title could not constitute explicit misleading under *MCA Records* and that no other evidence of consumer confusion existed.¹³²

¹²⁴ *Id.* at 1100–01.

¹²⁵ See *id.* (addressing whether the use was artistically relevant and explicitly misleading without applying the factors from the Ninth Circuit).

¹²⁶ *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp. 2d 1012, 1045 (C.D. Cal. 2006) ("[W]hen First Amendment interests are implicated, the *Rogers* 'explicitly misleading' standard applies, not the traditional 'likelihood of confusion' test." (citing *MCA Records*, 296 F.3d at 900)).

¹²⁷ *Id.* at 1046–48.

¹²⁸ See *id.* at 1048 ("The likelihood of confusion in *Rogers v. Grimaldi* was far greater than here for there were no visible signs accompanying the title to show consumers that the movie was not in fact about Rogers and Astaire. Nonetheless the court found that the First Amendment interests prevailed.").

¹²⁹ *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100–01.

¹³⁰ *Roxbury Entm't v. Penthouse Media Grp., Inc.*, 669 F. Supp. 2d 1170 (C.D. Cal. 2009).

¹³¹ *Id.* at 1175–76.

¹³² *Id.* at 1176 (citing *MCA Records*, 296 F.3d at 902).

In contrast, the court in *Rebelution, LLC v. Perez*¹³³ applied both the cultural significance test from *Walking Mountain* and the likelihood of confusion test wholesale in a trademark dispute over the use of the word *rebelution*.¹³⁴ In *Rebelution*, the plaintiff, a reggae band called Rebelution, sued a hip-hop and Latin dance artist operating under the moniker *Pitbull*, for using the word *rebelution* in the title of an album.¹³⁵ The court rejected the defendant's motion for summary judgment on First Amendment grounds, stating that the word *rebelution* had no cultural significance under *Walking Mountain* or *MCA Records*, precluding application of the *Rogers* test.¹³⁶ The court distinguished *E.S.S.* by stating that, while the mark at issue in *E.S.S.* was not culturally significant, the parties in that case "did not dispute whether the *Rogers* test was applicable."¹³⁷ The court also argued that application of the *Rogers* test was inappropriate under the language of *Rogers* itself, which applied the Lanham Act in its entirety to cases of misleading artistic titles.¹³⁸ Determining whether a title is misleading, and thus beyond the scope of the *Rogers* test, the court reasoned, required analysis under the traditional likelihood of confusion test.¹³⁹

Even if the *Rogers* test applied, the court stated, the defendant would still be liable under the first prong of the test because his use was not artistically relevant.¹⁴⁰ Furthermore, the court noted that "[i]n every federal court of appeals case addressing the artistic adoption of plaintiff's non-generic mark, the artistic relevance of defendant's use of the mark related to the meaning associated with the plaintiff's mark."¹⁴¹ Since the defendant here had used the term *rebelution* without intending to reference (or even knowing that it could reference) the plaintiff reggae band, the use could not satisfy the artistic relevance prong of the *Rogers* test.¹⁴² Having dispensed with the *Rogers* test as inapplicable, the court proceeded with a lengthy analysis of the facts under the traditional likelihood of confusion test.¹⁴³ The court ultimately found sufficient

¹³³ *Rebelution, LLC v. Perez*, 732 F. Supp. 2d 883 (N.D. Cal. 2010).

¹³⁴ *Id.* at 887–99.

¹³⁵ *Id.* at 885–86.

¹³⁶ *Id.* at 887–88.

¹³⁷ *Id.* at 888 (citing *E.S.S.*, 547 F.3d at 1099–1100).

¹³⁸ *Id.*

¹³⁹ *Id.*

¹⁴⁰ *Id.* at 888–89.

¹⁴¹ *Id.* at 889.

¹⁴² *Id.* ("[Defendant] concedes that prior to releasing his album, he had never heard of plaintiff. Instead, [he] adopted the word rebelution because he saw it on a store front in Miami" (citations omitted)).

¹⁴³ *Id.* at 890–98.

likelihood of confusion to preclude the defendant's motion for summary judgment.¹⁴⁴

The *Rebelution* court's application of the *Rogers* test came under fire less than a year later in *Stewart Surfboards, Inc. v. Disney Book Group, LLC*.¹⁴⁵ In *Stewart*, the plaintiff surfboard manufacturer relied heavily on *Rebelution* in response to the defendant's motion to dismiss in a case involving the depiction of a Stewart Surfboard on the back cover of a book entitled *Hannah Montana: Rock the Waves*.¹⁴⁶ The plaintiff cited *Rebelution* to argue that the Stewart Surfboard logo did not possess the requisite cultural significance to warrant the application of the *Rogers* test.¹⁴⁷ The *Stewart* court rejected this defense and the reasoning employed in *Rebelution*, arguing that the exact same defense had been considered and rejected in *E.S.S.*¹⁴⁸ That the parties in *E.S.S.* did not dispute the applicability of the *Rogers* test was irrelevant, and distinguishing on such a basis misinterpreted the holding in *E.S.S.*¹⁴⁹ The *Stewart* court thus determined that the *Rogers* test was applicable.¹⁵⁰

The plaintiff in *Stewart* argued that even if the *Rogers* test was applicable, the defendant's use was not artistically relevant because it did not refer to the meaning associated with the Stewart trademark, again citing *Rebelution*.¹⁵¹ The *Stewart* court rejected this argument as well, citing *E.S.S.* for the principle that the artistic relevance need only "be above zero."¹⁵² The use here met this threshold because the mark evoked the surfing theme reflected in the plot of the book.¹⁵³

The court then moved to the second prong of the *Rogers* test, determining whether the use explicitly mislead as to the source or content of the work.¹⁵⁴ The court conceded that "[t]he case law [was] not entirely clear on what it means for the use of a trademark to 'explicitly mislead[]' as to the work's

¹⁴⁴ *Id.* at 899.

¹⁴⁵ *Stewart Surfboards, Inc. v. Disney Book Grp., LLC*, No. CV 10-2982 GAF (SSx), 2011 U.S. Dist. LEXIS 155444, at *5–11 (C.D. Cal. May 11, 2011).

¹⁴⁶ *Id.* at *1, *5.

¹⁴⁷ *Id.* at *5.

¹⁴⁸ *Id.* at *7–9.

¹⁴⁹ *Id.* at *8 ("The *Rebelution* court ignored this aspect of *E.S.S. Entertainment* and concluded that it was inapposite because 'the parties there did not dispute whether the *Rogers* test was applicable.' In this Court's view, that misapprehends *E.S.S. Entertainment*." (quoting *Rebelution, LLC v. Perez*, 732 F. Supp. 2d 883, 888 (N.D. Cal. 2010))).

¹⁵⁰ *Id.* at *11.

¹⁵¹ *Id.* at *12–13.

¹⁵² *Id.* at *13 (quoting *E.S.S. Ent'mt 2000, Inc. v. Rock Star Video, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008)).

¹⁵³ *Id.* at *13–14.

¹⁵⁴ *Id.* at *20–28.

source or content, or whether that assessment [could] properly be made on a motion to dismiss.”¹⁵⁵ If the second prong of the *Rogers* test required the traditional likelihood of confusion test, dismissal would be inappropriate given the fact-intensive nature of the inquiry.¹⁵⁶ Given the confused state of the explicitly misleading test in the Ninth Circuit, and absent any circuit statement that the *Rogers* test could not be applied on a motion to dismiss, the *Stewart* court ultimately determined that dismissal was appropriate in this case, adopting the “original *Rogers* approach in which a work is ‘explicitly misleading’ only if it contains an ‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement.’”¹⁵⁷

In contrast, a recent denial of dismissal by a district court overseeing ongoing litigation between Electronic Arts and Textron employed language from *E.S.S.* in seemingly adopting the likelihood of confusion test to determine whether a use was explicitly misleading under the *Rogers* test.¹⁵⁸ The dispute involved Electronic Arts’s unauthorized depiction of Textron’s trademarked military helicopters in a video game.¹⁵⁹ Electronic Arts moved to dismiss on nominative fair use and First Amendment grounds.¹⁶⁰ In denying Electronic Arts’s motion to dismiss on First Amendment grounds, the district court focused on the explicitly misleading prong of the *Rogers* test.¹⁶¹ While Electronic Arts argued that the likelihood of confusion factor was inapplicable in a *Rogers* test determination the district court disagreed.¹⁶² The district court cited *E.S.S.*, noting that the Ninth Circuit had “looked at ‘whether the Game would confuse its players into thinking that the Play Pen was somehow behind the Pig Pen or that it sponsor[ed] Rockstar’s product’ when it evaluated” whether the use was explicitly misleading.¹⁶³ Unlike in *E.S.S.*, where the Ninth Circuit had determined that no reasonable consumer would think *E.S.S.* had provided Rockstar with the expertise and knowledge in depicting their strip club,¹⁶⁴ here the district court determined that, while consumers might not reasonably believe that Textron made video games, they could plausibly believe

¹⁵⁵ *Id.* at *20–21 (third alteration in original) (quoting *E.S.S.* 547 F.3d at 1099).

¹⁵⁶ *Id.* at *22–23.

¹⁵⁷ *Id.* at *24–25.

¹⁵⁸ Order Denying Plaintiff’s Motion to Dismiss Counterclaims, Granting in Part and Denying in Part Plaintiff’s Request for Judicial Notice, and Vacating Hearing, *Elec. Arts, Inc. v. Textron Inc.*, No. C 12-00118 WHA, 2012 U.S. Dist. LEXIS 103914 (N.D. Cal. July 25, 2012).

¹⁵⁹ *Id.* at *2–5.

¹⁶⁰ *Id.* at *3–5.

¹⁶¹ *Id.* at *8–9.

¹⁶² *Id.* at *11.

¹⁶³ *Id.* (quoting *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008)).

¹⁶⁴ *Id.* (quoting *E.S.S.*, 547 F.3d at 1100–01).

that Textron was somehow behind or sponsored the game.¹⁶⁵ The court cited a number of factors supporting a likelihood of confusion, including the prominence of the helicopters in the game and the ability of the consumer to control the helicopters while playing the game.¹⁶⁶ The case was later dismissed after the parties reached an undisclosed settlement.¹⁶⁷

Two recent cases show that the confusion surrounding the *Rogers* test persists in the Ninth Circuit. In *Webceleb, Inc. v. P&G*,¹⁶⁸ the court granted defendant P&G's motion for summary judgment, employing the *Rogers* test without analyzing the likelihood of confusion factors.¹⁶⁹ While the plaintiff claimed that the trademark in question (the Web Celeb name) was not culturally significant enough to warrant *Rogers* test protection, the *Webceleb* court determined that E.S.S. had explicitly rejected this requirement.¹⁷⁰

In contrast, the court in *Warner Brothers Entertainment v. Global Asylum, Inc.* applied the cultural significance requirement to the *Rogers* test in granting a temporary restraining order in a dispute over the "Hobbit" trademark.¹⁷¹ In *Warner Brothers*, defendant Global Asylum, a company known for producing so-called "mockbusters," cheaper parodies of major films, sought to release a film documenting the recently discovered prehistoric humans that had lived in Indonesia.¹⁷² The film was entitled "Age of Hobbits," referring to the nickname given to the prehistoric people by the scientists who had discovered them.¹⁷³ The movie was set to release on December 11, 2012.¹⁷⁴

As luck would have it, Warner Brothers planned to release a film entitled *The Hobbit: An Unexpected Journey* three days later on December 14, 2012.¹⁷⁵ This movie did not, however, reference the prehistoric people of Indonesia, instead depicting the well-known story written by J.R.R. Tolkien.¹⁷⁶ Concerned that the

¹⁶⁵ *Id.* at *12.

¹⁶⁶ *Id.* at *11–12 (internal quotation marks omitted).

¹⁶⁷ *Case settled: Electronic Arts v. Textron, Inc.*, PATENT ARCADE, <http://www.patentarcade.com/2013/08/case-settled-electronic-arts-v-textron.html> (last visited Oct. 10, 2013).

¹⁶⁸ *Webceleb, Inc. v. P&G*, No. 10-2318, 2012 U.S. Dist. LEXIS 188117, at *1 (S.D. Cal. Sept. 25, 2012).

¹⁶⁹ *Id.* at *6–7 ("In the Ninth Circuit, the traditional test for trademark infringement is the 'likelihood of confusion' test.... Consideration of [the likelihood of confusion factors], however, may not be appropriate or necessary in all cases of alleged trademark infringement.').

¹⁷⁰ *Id.* at *15.

¹⁷¹ *Warner Bros. Entm't Inc. v. Global Asylum, Inc.*, No. 12-9547, 2012 U.S. Dist. LEXIS 185695, at *1 (C.D. Cal. Dec. 10, 2012).

¹⁷² *Id.* at *3.

¹⁷³ *Id.*

¹⁷⁴ *Id.* at *2.

¹⁷⁵ *Id.*

¹⁷⁶ *Id.*

marketing and release date of “Age of Hobbits” would confuse potential viewers interested in their film, Warner Brothers sought a temporary restraining order preventing Global Asylum from releasing their movie with the word “hobbits” in the title.¹⁷⁷

In order to grant this request, the court had to determine whether Warner Brothers could show a likelihood of success on their trademark infringement claim.¹⁷⁸ The court immediately launched into a detailed analysis of the likelihood of confusion factors, finding that the factors weighed in favor of Warner Brothers.¹⁷⁹ The court then considered Global Asylum’s defenses, including a *Rogers* test defense.¹⁸⁰

In evaluating Global Asylum’s *Rogers* test defense, the court first characterized the test as having three prongs, citing *MCA Records and Rebellion*.¹⁸¹ This third prong requirement limits the *Rogers* test to marks that have “acquired meaning beyond [their] source-identifying function,” tracking the cultural significance requirements derived from *MCA Records* and *Walking Mountain*.¹⁸² The court determined that the “Hobbit” mark was sufficiently culturally significant to warrant *Rogers* test protection.¹⁸³

However, in considering the artistic relevance prong of the test, the court imported the requirement from *Rebellion* that the artistic relevance of the mark must be related to the original meaning associated with the mark.¹⁸⁴ Since the use of the term “hobbit” in Global Asylum’s film referenced prehistoric Indonesians instead of the small-folk in Tolkien’s novels, the court held that Global Asylum’s use of the mark was not artistically relevant to the work under the *Rogers* test.¹⁸⁵

The court went on to conclude that Asylum’s use failed the explicitly misleading prong of the test as well, since the likelihood of confusion analysis had produced a “particularly compelling” likelihood of confusion.¹⁸⁶ After dispensing with Global Asylum’s other defenses, including nominative fair use, the court granted Warner Brothers the temporary restraining order.¹⁸⁷ While

¹⁷⁷ *Id.* at *4.

¹⁷⁸ *Id.* at *5–6.

¹⁷⁹ *Id.* at *5–41.

¹⁸⁰ *Id.* at *41.

¹⁸¹ *Id.* at *43–45.

¹⁸² *Id.* at *44–45.

¹⁸³ *Id.* at *46.

¹⁸⁴ *Id.* at *48–49.

¹⁸⁵ *Id.* at *46–49.

¹⁸⁶ *Id.* at *49–50.

¹⁸⁷ *Id.* at *70–71.

the Ninth Circuit affirmed, only the nominative fair use issue was presented on appeal.¹⁸⁸

III. ANALYSIS

A. WHY THE ROGERS TEST MATTERS

Confusion over how best to apply the *Rogers* test within the Ninth Circuit has occurred in two primary areas. The first concerns the proper role of the traditional likelihood of confusion test within the *Rogers* test.¹⁸⁹ Courts have long struggled with this question, and it is far from unique to the Ninth Circuit.¹⁹⁰ The second point of confusion involves the development of the cultural significance requirement from *MCA Records* and *Walking Mountain*, as well as the requirement derived from *Rebelution* and *Global Asylum* that a mark's use must reference the original meaning of the related mark.¹⁹¹ These two requirements are unique to the Ninth Circuit and are more recent developments in the *Rogers* test.

As the preceding district court cases have shown, how courts construe the *Rogers* test can have an important impact on the outcome of trials. Electronic Arts's motion to dismiss would likely have succeeded under the interpretation of the test employed by the court in *Stewart Surfboards*, as Electronic Arts never included an "explicit indication, overt claim, or explicit misstatement" in depicting the helicopters.¹⁹² Conversely, the heightened limitations placed on the test by the *Rebelution* and *Global Asylum* courts favor markholders and will typically require an extensive discovery period due to the fact-intensive nature of the likelihood of confusion inquiry, potentially resulting in longer litigation even if the creator of an expressive work ultimately prevails in a case.

However, the differing interpretations of the *Rogers* test within the Ninth Circuit are problematic beyond case-by-case decisions. Legal uncertainty over

¹⁸⁸ Warner Bros. Entm't, Inc. v. Global Asylum, Inc., No. 13-55352, 2013 U.S. App. LEXIS 22120, at *2 (9th Cir. Oct. 30, 2013).

¹⁸⁹ See *Webeleb*, 2012 U.S. Dist. LEXIS 188117, at *6–7 (stating that a likelihood of confusion analysis is not necessary in every instance).

¹⁹⁰ David M. Kelly & Lynn M. Jordan, *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 99 TRADEMARK REP. 1360, 1383 (1999).

¹⁹¹ See *Global Asylum*, 2012 U.S. Dist. LEXIS 185695, at *48–49 (importing the *Rebelution* court's requirement that the artistic relevance of the mark must be related to the mark's original meaning).

¹⁹² *Stewart Surfboards, Inc. v. Disney Book Grp., LLC*, No. CV 10-2982 GAF (SSx), 2011 U.S. Dist. LEXIS 155444, at *25 (C.D. Cal. May 11, 2011) (internal quotation marks omitted).

the scope of trademark protection in the context of expressive works risks creating a chilling effect by discouraging content creators from using marks that they may otherwise be entitled to use. While a definitive answer either way from the Ninth Circuit may help remove legal uncertainty, a number of factors render the use of the likelihood of confusion factors within the *Rogers* test unappealing.

B. A CONFUSING TEST FOR CONFUSION

1. *Factors and Harm.* Trademark law and the likelihood of confusion test are rooted in judicial attempts at discouraging unfair business practices and passing-off claims.¹⁹³ In this commercial context, rooting the infringement test to evidence of consumer confusion is appropriate. The factors commonly employed by courts to gauge the presence of consumer confusion function well when applied to products near each other on store shelves.¹⁹⁴ Consumer confusion in such cases goes to the heart of a passing-off claim—that a mark is being used to mislead consumers as to the origin of a good in order to compete with the rightful markholder. In passing-off claims both the markholder and the consumer are harmed. Markholders lose sales from confused customers who believe they are buying the right product. Consumers are deceived into purchasing items they do not want or are forced to incur higher transaction costs in purchasing items they do want. In either case, consumer confusion is directly tied to demonstrable harms.

For all of its utility in the commercial sales context, the likelihood of confusion test is ill-equipped to resolve claims involving infringement in expressive works, even ignoring the First Amendment concerns implicated by the test. This is because many of the factors commonly included in likelihood of confusion tests are simply irrelevant in the context of expressive works. While consumer confusion in the commercial context is chiefly concerned with confusion as to the origin of a marked good, trademark uses in expressive works rarely confuse consumers as to the origin of the work since few companies branch out into creating purely expressive works.¹⁹⁵ No reasonable

¹⁹³ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 28–29 (2003); Bently, *supra* note 17; McKenna, *supra* note 17.

¹⁹⁴ See *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979), *abrogated in part on other grounds by* *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003) (including the proximity or relationship between the goods being sold, the similarity of the trademarks, the strength of the plaintiff's mark, the existence of survey evidence of actual confusion, etc.).

¹⁹⁵ See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (describing how trademark use in titles seldom refer to origin).

consumer would believe that Textron or E.S.S. Entertainment had branched out into the video game industry, or that Mattel produced and sold surreal photographs featuring their Barbie doll. Likewise, while the similarity of the offending mark may prove important in cases of commercial passing-off, the similarity of the mark in an expressive work is almost a given. The entire point of using a mark in an expressive work is to invoke the commonly understood cultural meanings or values associated with the mark.

The scope and magnitude of the harm alleged in expressive work cases also differs significantly from those in the commercial sales context. By permitting markholders to bring passing-off claims, the Lanham Act empowers the markholder to protect not only itself, but also the consumer from demonstrable harm. However, the harms involved in expressive work cases are more difficult to discern. While a consumer may be led to wrongly believe that the markholder approved or sponsored the use of a mark in an expressive work, it is not clear in all cases that such a belief results in any real harm to the consumer. For the markholder, the most straightforward danger of unauthorized use in the context of expressive works—that the use will somehow impugn or portray the brand in a negative light—is not even addressed by the likelihood of confusion test. Indeed, many markholders will bring suit even where the use has portrayed their mark in a positive or, at worst, neutral light. In many such cases, the dispute actually stems from the markholder's lost licensing fees, a very different sort of harm from the unfair competition claims that the likelihood of confusion test was designed to address.

While a proven and effective tool for deciding traditional commercial trademark infringement cases, the traditional likelihood of confusion test is a blunt instrument to apply in the expressive works context. The fundamental assumptions made by the likelihood of confusion test—that consumer confusion works concrete harms on consumers and the manufacturers—do not necessarily apply in the context of expressive works, rendering the test less effective at gauging whether an unauthorized use of a mark is explicitly misleading in such cases.

2. *Weighing the Interests.* The *Rogers* test, as originally conceived, provided two prongs that defined when the public interest in free speech outweighed the rights granted to markholders.¹⁹⁶ If an unauthorized use of a mark failed this test, the case would then proceed as in any other infringement case, applying the likelihood of confusion factors to determine if infringement had occurred. Applying the likelihood of confusion factors within the *Rogers* test renders the

¹⁹⁶ *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

test singularly unhelpful in determining what weight should be given to the public interest in free speech.

If, for example, the likelihood of confusion test employed within the *Rogers* test is the same as that used for commercial infringement cases, then the *Rogers* test serves no purpose; an unauthorized use that fails under the traditional likelihood of confusion test will always fail the *Rogers* test. Even if the likelihood of confusion test employed within the *Rogers* test factors in the public interest in free speech by requiring plaintiffs to show evidence of greater confusion than would suffice in a traditional commercial infringement case, the degree of any increased evidentiary burden would be subject to judicial discretion, since the *Rogers* test itself provides no guidance on the matter.

While courts are certainly capable of applying balancing tests, doing so in the context of free speech is particularly worrisome. The public interest in free speech extends beyond concerns over the outcomes of individual trials. Unnecessary confusion within the law risks a chilling effect that may be just as damaging to the public interest as a straightforward law construing trademark protections strongly in favor of markholders.

Absent a definitive ruling on whether a court will apply the likelihood of confusion test in an infringement case, risk-averse content creators are encouraged to assume the worst and prospectively apply the likelihood of confusion factors.¹⁹⁷ While prospectively applying the likelihood of confusion test might allow content creators to assess whether a court will find their use of a trademark overly confusing, it does not provide any insight as to the relative weight of the public interest in free expression that might protect their use even if it presents a likelihood of confusion.

The considerable difficulty in determining whether an unauthorized use of a trademark in an artistic work will be protected creates a strong incentive for risk-averse content creators to either pay licensing fees to the markholder or just avoid unauthorized trademark uses entirely, even where such uses would likely not constitute infringement. Those content creators who do go forward with the unauthorized use of a trademark risk potentially lengthy and expensive litigation due to the fact-intensive nature of the likelihood of confusion test, even if they ultimately prevail in the case.

3. *Warped Incentives.* In contrast, the application of the likelihood of confusion test in the context of creative works encourages markholders to vigorously defend their marks. Since the likelihood of confusion test links

¹⁹⁷ E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1099 (9th Cir. 2008) (quoting Mattel Inc. v. Walking Mountain Prods., 353 F.3d 792, 807 (9th Cir. 2003) (internal quotations marks omitted)).

trademark infringement to consumer confusion, determining whether infringement has occurred will depend, to some degree, on consumers' knowledge of trademark law. If consumers believe that certain uses of marks always require authorization from the markholder, consumers will infer a markholder's authorization from the presence of the mark, expanding the definition of infringement under the Lanham Act.¹⁹⁸ Indeed, plaintiffs in trademark infringement cases will frequently use consumer surveys as evidence of confusion.¹⁹⁹ This evidence can prove particularly compelling since most courts consider survey results to be evidence of actual consumer confusion, as opposed to evidence presenting the mere "likelihood of confusion" that the Lanham Act requires.²⁰⁰

By vigorously asserting their trademark rights, markholders take advantage of the unclear nature of the law, which encourages authors and publishers to either pay licensing fees to foreclose liability or avoid unauthorized uses of marks entirely.²⁰¹ As consumers become accustomed to licensing and product placement practices, they become conditioned to assume that any such uses of a trademark require the permission of the markholder, even absent any contextual evidence of markholder sponsorship or approval in the use itself.²⁰² This, in turn, places markholders in a better position for future cases that are predicated on a showing of consumer confusion. The result is a steady expansion of markholder protection into an area traditionally dominated by free speech interests without any substantive change in trademark law.²⁰³

C. REFOCUSING THE TEST

The *Rogers* test, as originally conceived and as applied in *Stewart Surfboards*, provides, at the very least, a straightforward and understandable test for determining whether the public interest in free speech will protect an

¹⁹⁸ See 3 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 24.03[4][b] (3d ed. 1992) ("If consumers think that most uses of a trademark require authorization, then in fact they will require authorization because the owner can enjoin consumer confusion caused by unpermitted uses or charge for licenses. And if owners can sue to stop unauthorized uses, then only authorized uses will be seen by consumers, creating or reinforcing their perception that authorization is necessary. This is a 'chicken and the egg' conundrum.").

¹⁹⁹ See Edward George Epstein, *Surveys: Growing Admissibility but Narrow Utilization*, 83 TRADEMARK REP. 863 (1993) (documenting history of survey evidence in trademark cases).

²⁰⁰ See *Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013, 1040 (C.D. Cal. 1998) (explaining the significance of survey results that demonstrate varying percentages of confusion).

²⁰¹ See generally James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 YALE L.J. 882, 907–27 (2007) (describing the "feedback loop" of consumer confusion in detail).

²⁰² *Id.* at 907–08.

²⁰³ *Id.* at 908.

unauthorized use of a mark. The significant modifications to the original test implemented by the Second and Fifth Circuits and the confusion currently surrounding the Ninth Circuit's implementation suggest a degree of judicial discomfort with the test.

The restrictions placed on the test by the *Rebellion* and *Global Asylum* courts are particularly telling. The *E.S.S.* decision appeared to do away with the cultural significance requirement sketched out in *Walking Mountain*.²⁰⁴ And yet the requirement persists in some district courts, with the *Global Asylum* court going so far as to include it as a third prong in the test.²⁰⁵ The only justification provided by the *Rebellion* court for this requirement was a rather strained reading of *E.S.S.* that effectively assumed that the *E.S.S.* court had ignored the cultural significance requirement because the parties had agreed that the *Rogers* test was applicable.²⁰⁶ The *Global Asylum* court did not even address *E.S.S.* on this issue, citing instead *MCA Records* and *Rebellion*.²⁰⁷

The requirement that a use demonstrate artistic relevance referencing the meaning associated with the plaintiff's mark likewise restricts application of the test. This requirement, applied by both the *Rebellion* and *Global Asylum* courts, further narrows the artistic relevance requirement of the test. Detailed justification for this heightened requirement remains scarce, however. The *Rebellion* court, which first applied this requirement, provided no rationale grounded in the purpose of the *Rogers* test or the Lanham Act, merely opining that "in every federal court of appeals case [applying the *Rogers* test], the artistic relevance of the defendant's use related to the meaning associated with the plaintiff's mark."²⁰⁸ The *Global Asylum* court repeated this assertion, but also cited *E.S.S.* in support, seemingly suggesting that the *E.S.S.* court *had not* applied the *Rogers* test in deciding that case.²⁰⁹

Some of the apparent judicial unease in applying a *Stewart Surfboards*-style *Rogers* test may stem from its broadly permissive nature, which greatly expands the ability of content creators to use marks without permission. In some cases, such as *Electronic Arts* and *Westchester Media*, application of the *Rogers* test as originally conceived seemingly permits content creators to steal a mark or

²⁰⁴ *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099–1100 (9th Cir. 2008).

²⁰⁵ *Warner Bros. Entm't Inc. v. Global Asylum, Inc.*, No. 12-9547, 2012 U.S. Dist. LEXIS 185695, at *1, *44–45 (C.D. Cal. Dec. 10, 2012).

²⁰⁶ *Rebellion, LLC v. Perez*, 732 F. Supp. 2d 883, 888 (N.D. Cal. 2010).

²⁰⁷ *Global Asylum*, 2012 U.S. Dist. LEXIS 185695, at *44–45.

²⁰⁸ *Rebellion*, 732 F. Supp. 2d at 889.

²⁰⁹ *Global Asylum*, 2012 U.S. Dist. LEXIS 185695, at *46–48.

design and profit from it without providing any compensation to the original markholder.

While this sort of free riding may appear unfair on the surface, trademark law, unlike patent and copyright law, is rooted in the Commerce Clause is thus concerned with creating a legal framework encouraging the efficient flow of commerce.²¹⁰ Patent law protects inventors from free riding because no inventor would endeavor to spend the time and money to create something only to have it copied and sold as soon as it was perfected. While creating and (especially) branding a trademark certainly involves an investment of resources, the core benefits of establishing a mark (market recognition and brand appeal) are not suddenly lost when a content creator uses the mark in an expressive work. Indeed, the use itself generally signals that the trademark has successfully made its way into the social consciousness of the public. Unlike inventions, companies will continue to register and develop trademarks in the absence of laws preventing free riding. Attempts to discourage free riding should take the form of clearer articulations of the rights held by markholders, not of further confusion regarding what is or is not an explicitly misleading use of a mark.

IV. CONCLUSION

Despite more than twenty years of applying the *Rogers* test, confusion remains over how, exactly, the test operates. As a complete defense to Lanham Act infringement claims, the *Rogers* test effectively sets the balance between the public interest in free speech and the interests of markholders. The considerable confusion within the Ninth Circuit concerning the exact contours of the test reflects the changing nature of trademarks in contemporary society, which have developed beyond their role as source-indicators to take on greater cultural significance.

Determining how best to balance the public interest in free speech against the rights of markholders presents a daunting task. While the *Rogers* test as originally conceived arguably sets the balance in favor of free speech interests, it at least presents a consistent and relatively straightforward test for courts and litigants to apply. The current confusion gripping the Ninth Circuit, and the decision of some district courts to embed the traditional likelihood of confusion test for infringement within the *Rogers* test, needlessly complicates the law by incentivizing litigation by markholders and discouraging the use of marks by content creators.

²¹⁰ See *supra* notes 36–39.

The evolution of trademarks from purely commercial designations of source to powerful brands and symbols has put greater stress on a legal framework focused on minimizing consumer confusion in the marketplace. Any decision clarifying the position of the *Rogers* test within the Ninth Circuit will have a large impact on the type of artistic expression available to the public in the future and may inform future courts in their struggle to balance free speech against trademark protection.

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