Art vs. Commerce: The Evolution of the Artistic Relevance Test

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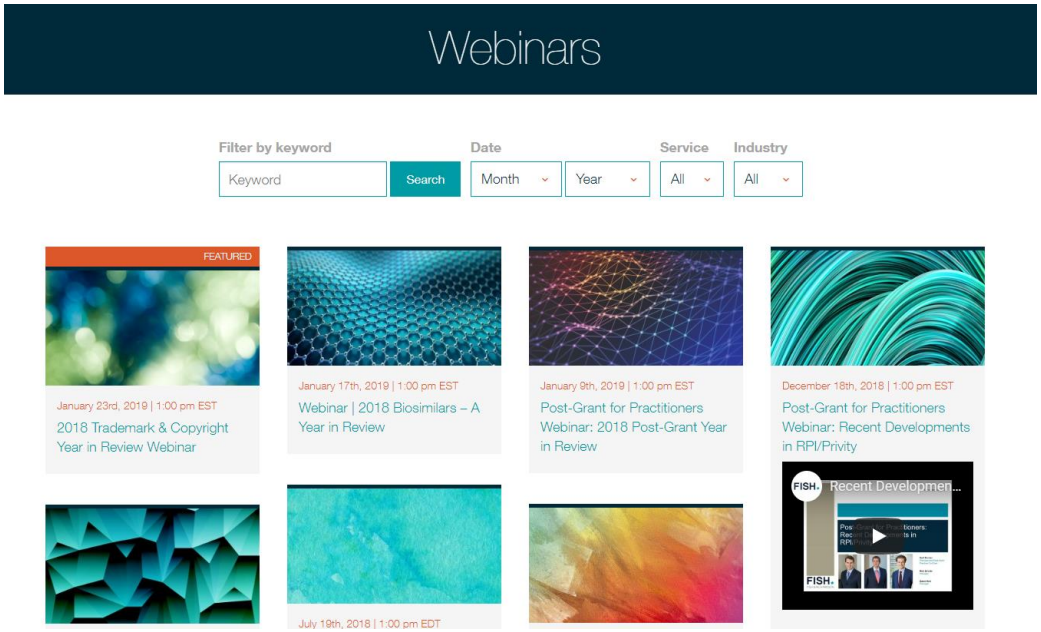
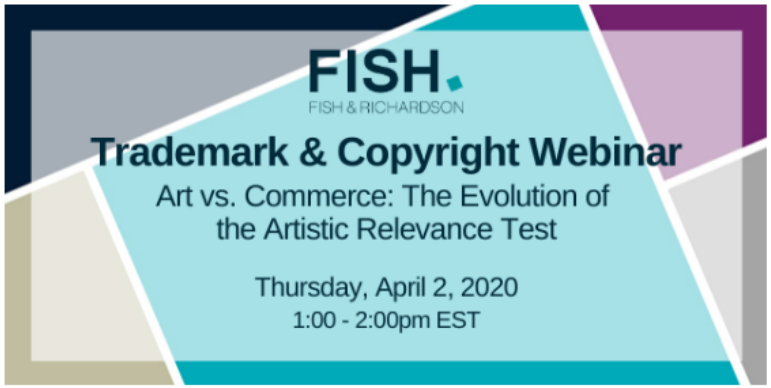
Overview





Register

The Lanham Act allows trademark holders to enforce their rights against infringers; but what happens when the allegedly infringing use is within a work of artistic expression? To resolve the inherent tension between the Lanham Act and the First Amendment, courts use the artistic relevance test to define the limits of trademark protection. Under this test, courts presume that the use of another's trademark in an artistic work is noninfringing unless it bears no relevance to the underlying work or it is intentionally misleading as to the source of the work.

In our upcoming trademark and copyright webinar, Jenifer deWolf Paine, Ryan Steinman, and Sarah Kelleher will discuss the artistic relevance test, covering topics such as:

- The foundations of the doctrine
- Its evolution over the years
- Its expansion and limitation by the courts

Jenifer and Ryan will devote particular attention to the use of the artistic relevance doctrine to video games.

We hope you will join us!

Agenda

- *Rogers v. Grimaldi* and the development of the "artistic relevance" doctrine.
- What has "artistic relevance"? What does not?
- What is "explicitly misleading"?
  - Difference between 9th and 2nd Circuits
- Application in Video Games

Rogers v. Grimaldi, 875 F.2d 944 (2d Cir. 1989)

- The Lanham Act should apply "only where the public interest in avoiding consumer confusion outweighs the public interest in free expression."
- Established the two-pronged test:
  - (i) does the title have artistic relevance to the underlying work, and
  - (ii) if it does, is it explicitly misleading

What Has “Artistic Relevance”?

Parks v. LaFace Records

- District Court: artistically relevant because there was an obvious relationship between the content of the song ("move to the back of the bus") and its title *Rosa Parks*
- On appeal: Parks argued that the relationship was not obvious but open to reasonable debate because the lyrics were about the group's competitors – not her
- Reversed: "If the requirement of 'relevance' is to have any meaning at all, it would not be unreasonable to conclude that the title *Rosa Parks* is not relevant to the content of the song"
- Thus, the level of "artistic relevance" was insufficient *as a matter of law*

Rebelution LLC v. Armando C. Perez

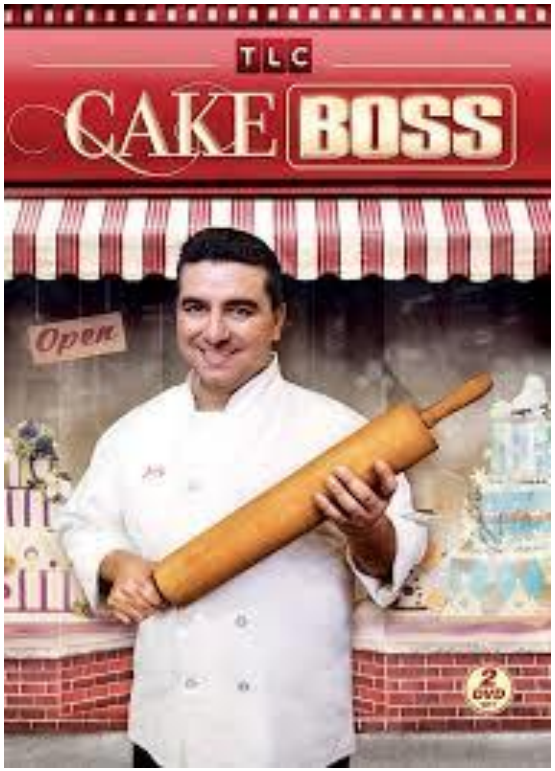
- Reggae band *Rebelution* sought to enjoin Pitbull from using its name for an album title
- Pitbull argued that "Rebelution" was artistically relevant to his album because the word was a made-up combination of "rebel," "revolution," and "evolution," which symbolized his personal struggles
- Court reads two additional requirements into the artistic relevance prong:
  - (1) plaintiff's mark must be of such cultural significance that it has become an integral part of the public's vocabulary
  - (2) defendant's use must be related to the meaning associated with *plaintiff's* mark
- Court finds no artistic relevance because the mark had no cultural significance and Pitbull's use did not refer to the plaintiff's band

"Rebelution" by Abby Gillardi, licensed under CC BY 2.0

Masters Software, Inc. v. Discovery Commc'ns, Inc.

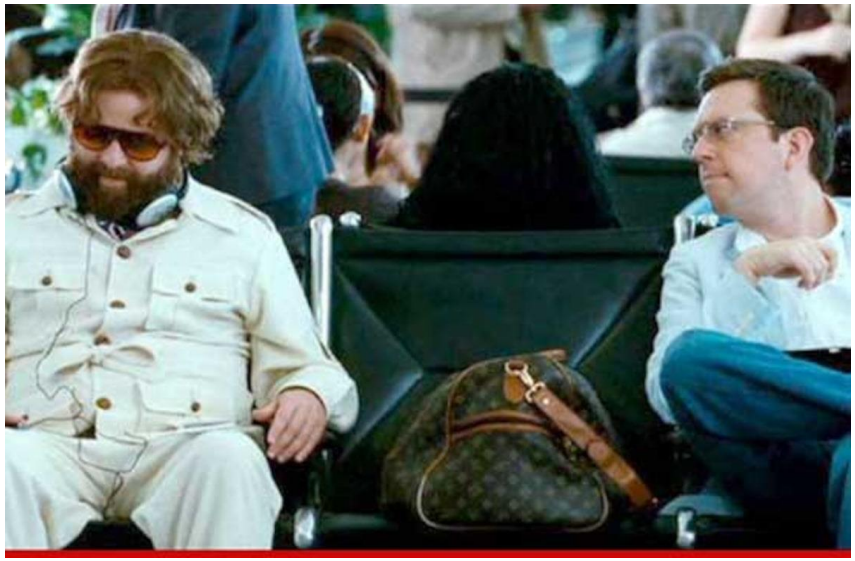
CakeBoss

software for bakers



- In 2007, Plaintiff developed software program called *CakeBoss* to assist professional bakers with business management
- In 2009, TLC introduced television show "*Cake Boss,*" which became a huge success
- TLC argued that it's choice of the title "*Cake Boss*" was artistically relevant and therefore entitled to First Amendment protection
- Like *Rebelution*, court finds no artistic relevance because the mark had no cultural significance and TLC's use did not refer to the plaintiff's software
- Court grants plaintiff's motion for preliminary injunction and the parties eventually reach a confidential settlement

Louis Vuitton Malletier SA v. Warner Bros. Entmt.



- Louis Vuitton brought an action alleging that use of a “knock-off” bag in the movie *The Hangover: Part II* infringed its trademarks; argued that the question of artistic relevance was an issue of fact that required discovery
- Court finds that the use was artistically relevant because it was intended to create an artistic association with Louis Vuitton, and therefore discovery was unnecessary as to whether Warner Bros. knew the bag was a fake

Twentieth Century Fox Television v. Empire Distrib.

- Fox sought a declaratory judgment that its use of the word “Empire” did not infringe trademark rights held by record label Empire Distribution
- On appeal: Empire Distrib. argued the *Rogers* test was not applicable because Fox could not satisfy the threshold requirements that the mark had cultural significance or that its use related to Empire Distrib.
- Ninth Circuit clarifies cultural significance is “merely a consideration”; there is no referential requirement. A work fails the artistic relevance test “***by bearing a title which has no artistic relevance to the work***.”
- In sum, a title may have artistic relevance by either:

  (1) linking the work to another work, or
  (2) supporting the themes and geographic setting of the work

EMPIRE

What is “Explicitly Misleading”?

When “Explicitly” Isn’t so Explicit

“[T]he Lanham Act should only be construed to apply to artistic works where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

The Infamous Footnote 5

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.

- *Rogers v. Grimaldi*, 875 F.2d 994 at FN 5 (2d Cir. 1989).

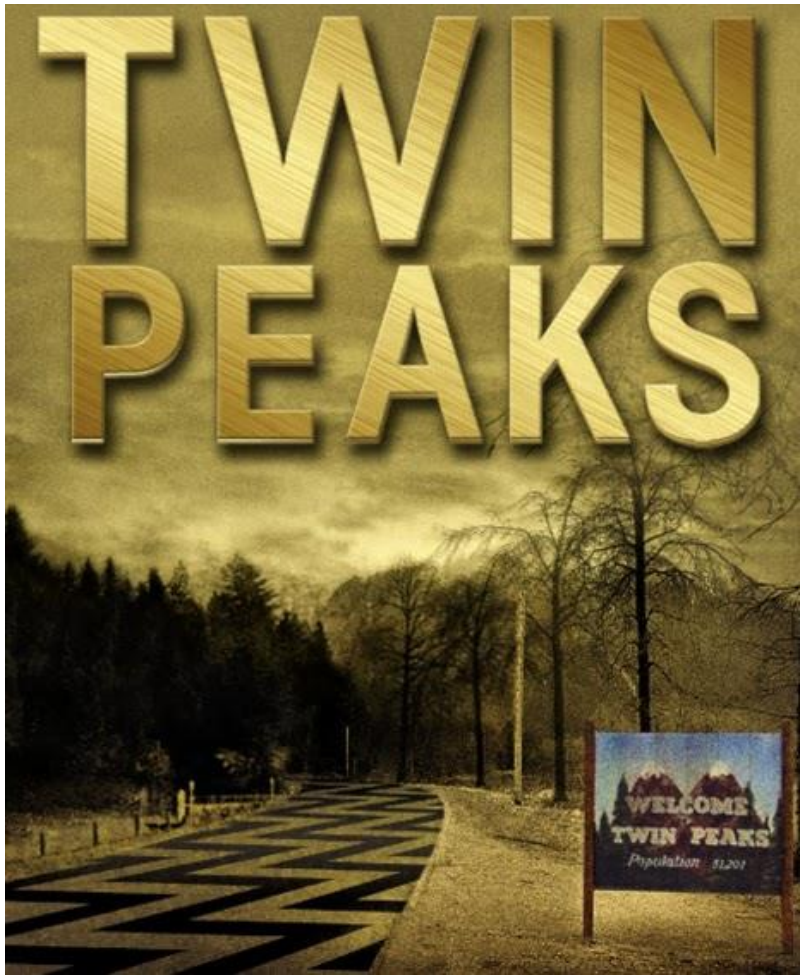
- "Where a title is complained about because it is confusingly similar to another, the *Rogers* rule that titles are subject to the Lanham Act's false advertising prohibition *only if explicitly misleading* is inapplicable." *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp.,* Inc., 886 F.2d 490 (**2d Cir.** 1989).
- "The exception the footnote suggests may be ill-advised or unnecessary." *Twentieth Century Fox Television a Division of Twentieth Century Fox Film Corp. v. Empire Distribution, Inc.*, 875 F.3d 1192 (**9th Cir**. 2017).

When “Explicitly” isn’t so Explicit

- **Explicitly misleading as to source** – “Nimmer on Copyright” or “Jane Fonda’s Workout Book”
- **Explicitly misleading as to content** – Same film but titled “The True Life Story of Ginger and Fred”
- **Not explicitly misleading** – “Bette Davis Eyes” or “Come Back to the Five and Dime, Jimmy Dean, Jimmy Dean”

Likelihood of Confusion is Compelling in the 2nd Circuit

- **“**But 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.” *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d Cir. 1989) (emphasis added).
- “This determination must be made, in the first instance, by application of the venerable Polaroid factors [h]owever, the finding of likelihood of confusion must be particularly compelling to outweigh the First Amendment interest recognized in Rogers.” *Twin Peaks Productions, Inc. v. Publications Intern.*, Ltd., 996 F.2d 1379 (2d Cir. 1993) (internal citation omitted).



The 9th Circuit Requires More

- "The *only* indication that Mattel might be associated with the song is the use of Barbie in the title; if this were enough to satisfy this prong of the *Rogers* test, it would render *Rogers* a nullity." *Mattel, Inc. v. MCA Records, Inc.,* 296 F.3d 894, 902 (9th Cir. 2002).

- Analyzing likelihood of confusion "conflates the second prong of the *Rogers* test with the general [ ] likelihood-of-confusion test, which applies outside the *Rogers* context of expressive works" and "use of a mark alone is not enough to satisfy this prong". *Twentieth Century Fox Television a division of Twentieth Century Fox Film Corporation v. Empire Distribution, Inc.,* 875 F.3d 1192, 1199, (9th Cir. 2017).

Honey Badger Don't Give a SH*%!

- "We therefore reject 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." *Gordon v. Drape Creative, Inc.,* 909 F.3d 257, 270–71 (9th Cir. 2018).
- "In some instances, the use of a mark alone may explicitly mislead consumers about a product's *source if consumers would ordinarily identify the source by the mark itself." Id.* at 270.

Application in Video Games

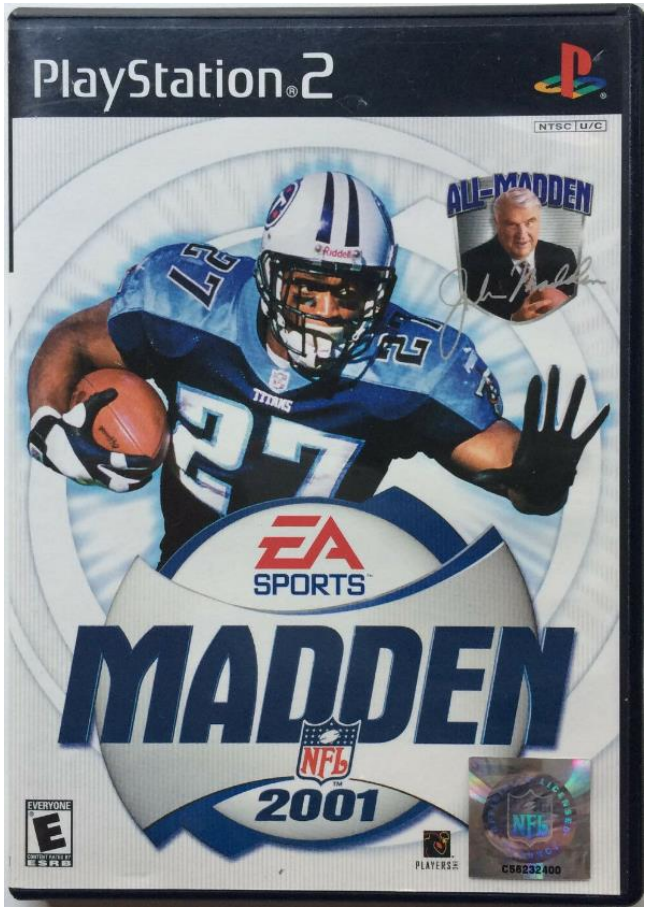
Entertainment 2000 Inc. v. Rock Star Videos Inc., 2008 WL 4791705 (9th Cir. Nov. 5 2008)

- Affirmed summary judgment in favor of defendants. Although the artistic relevance test "traditionally applies to uses of a trademark in the title of an artistic work, there is no principled reason why it ought not also apply to the use of a trademark in the body of the work."
- Artistic relevance: The use was "relevant to RockStar's artistic goal, which is to develop a cartoon-style parody of East Los Angeles."
- Explicitly misleading: "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."

Dillinger, LLC v. Electronic Arts Inc., 2011 WL 2457678 (S.D. IN June 16, 2011)

- Summary judgment in favor of defendants.
- Artistic relevance: "[I]t 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 for the Court to determine that the mark's use meets 'the appropriately low threshold of minimal artistic relevance.'"
- Explicitly misleading: There was no "affirmative statement of the plaintiff's sponsorship or endorsement beyond the mere use of plaintiff's name" and thus the use was not explicitly misleading.

Brown v. Electronic Arts, Inc. 724 F.3d 1235 (9th Cir. 2012)



Affirmed granting of defendant's motion to dismiss. The 9th Circuit made clear that the proper standard is "explicitly misleading", and that this means that there was an "explicit indication", "overt claim", or "explicit misstatement."

Electronic Arts, Inc. v. Textron Inc. et al., 3:12-cv-00118 WHA (N.D. Cal. July 25, 2012)

Summary judgment denied. Distinguished PlayPen because the helicopters were "given particular prominence", and the ability to control vehicles such as the helicopters was a major reason for the game's success.

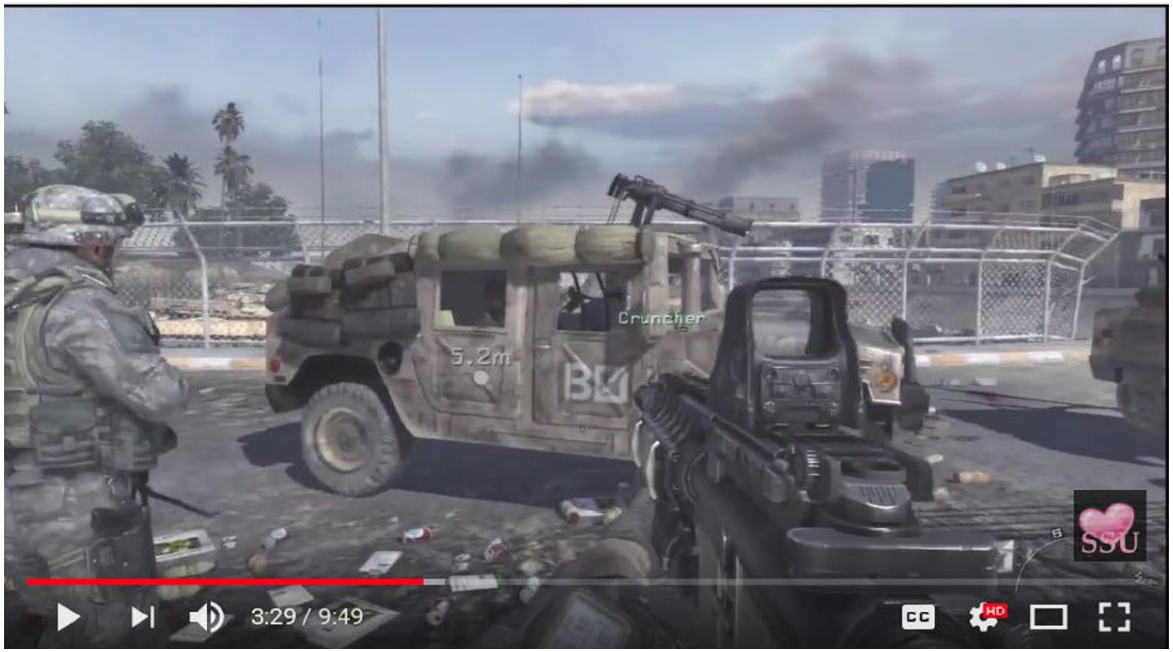
Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc. 74 F.Supp.3d 1134 (N.D. CA 2014)

- Granted defendant's motion for summary judgment
- Inclusion of the patch bore "some artistic relevance to the creators' goal of offering players a feeling of personal identity and authenticity during game play."
- There is no obligation to completely mimic reality in order to be entitled to First Amendment protection

Virag, S.R.L. v. Sony Computer Entertainment America LLC, 2015 WL 5000102 (N.D. Cal. Aug. 21, 2015)

Granted defendant's motion to dismiss. "Given the central role of realism" to the games, use of the banner was artistically relevant. Whether defendants also used for "commercial gain" was irrelevant.

AM General v. Activision Blizzard et al., SDNY 1:17-cv-08644 (Pending)



Thank You!

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