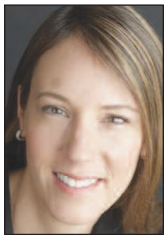


OPINION

Decades-old trademark precedent still puts owners at risk

By Kimberly B. Herman



In today's world of instant messaging, mobile technologies, virtual worlds and social media, the difficulties trademark owners face protecting their marks is well beyond what the architects of the

Constitution intended when they drafted the First Amendment.

A myriad of legal interpretations of decades-old laws are creating serious trademark enforcement problems for owners of well-known trademarks.

The law isn't always on the trademark owners' side, particularly if a trademark is used for expressive speech purposes, as a plethora of courts continue to rely on a 21-year-old test — the "Rogers Test" — first adopted by the 2nd U.S. Circuit Court of Appeals, to determine whether use of a literary title violates the Lanham Act.

The Rogers Test was based on a landmark case involving actress Ginger Rogers who filed suit against the producers of a film entitled "Ginger and Fred." Rogers alleged that the title created the false impression that she was associated with the film.

The court did not agree, holding that a title does not violate the Lanham Act unless it 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 content of the work.

In dismissing Rogers' claim, the court said: "Most consumers are well aware that they cannot judge a work solely by its title anymore than by its cover."

Hard to prove infringement

Over the last decade, many well-known

trademark owners have failed to prove that the use of their mark in artistic works constitutes infringement, consumer confusion or dilution of their brand.

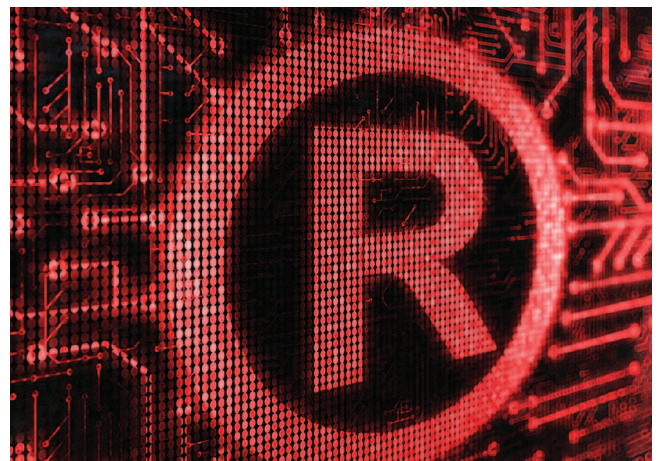
In 2006, ESS Entertainment 2000 filed suit against Rock Star Videos. ESS, a strip club operator in East Los Angeles, claimed videogame maker Rock Star was liable for trademark infringement and for violating unfair competition laws.

Rock Star created the fictional role-playing game "Grand Theft Auto: San Andreas," which takes place in fictional cities based on real California neighborhoods. To accurately depict those locales, Rock Star photographed the types of venues used in the game, including the plaintiff's club, the "Play Pen," and then created a fictional "Pig Pen" in "East Los Santos."

The court found that, under the Rogers Test, the use of the plaintiff's mark was relevant to re-creating the look and feel of the neighborhood and passed the "low threshold" necessary to meet the first prong of the Rogers Test.

Critical to the court's finding was the fact that the Pig Pen lacked "certain characteristics" of the Play Pen. The court recognized that it was necessary to include cartoon depictions and parodies of popular East Los Angeles sites in order to create a "critical mass of the businesses and buildings that constitute" the city such that the recreation is realistic.

Reaching the second prong, the court stated that the sole issue was "whether the Game would confuse its players into thinking that



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the Play Pen is somehow behind the Pig Pen or that it sponsors Rock Star's product."

The court found that no reasonable consumer would be led to believe that ESS produced the video game or that a video game maker such as Rock Star operates a strip club.

Barbie case

The Rogers Test was applied in another well-known case, this time involving Barbie — *Mattel v. MCA records*.

In 2002, Mattel sued MCA for trademark infringement and dilution of the Barbie mark over a song by the Danish group Aqua, "Barbie Girl." When applying the Rogers Test, the court found that although the song and title used Mattel's mark, both uses were intended to describe the underlying work and to provide a message to consumers about what to expect from the contents of the song.

Judge Alex Kozinski likened Barbie to a Warhol Campbell's Soup painting, stating: "If we

see a painting titled “Campbell’s Chicken Noodle Soup,” we’re unlikely to believe that Campbell’s has branched into the art business. Nor, upon hearing Janis Joplin croon, ‘Oh Lord, won’t you buy me a Mercedes-Benz?’ would we suspect that she and the carmaker had entered into a joint venture.”

Physical likeness

A third case in which current laws failed to protect the brand owner was *James “Jim” Brown v. Electronic Arts, Inc. (EA Sports)*.

Brown claimed the electronic videogame designer violated the Lanham Act because it allegedly used his celebrity persona and likeness without his consent in the videogame “Madden NFL.”

Brown, a well-known player, argued that EA Sports changed his jersey number and name but included him on a team using his physical likeness and similar athletic statistics.

In dismissing Brown’s federal claim with prejudice, the court assumed that EA Sports used Brown’s likeness. While emphasizing that commercial speech is given less protection than non-commercial speech, the court held that, despite the commercial nature of the speech, it was protected under the First Amendment because the game contained “numerous creative elements” that rendered the game an expressive work “akin to an expressive painting that depicts celebrity athletes of past and present in a realistic sporting environment.”

Applying the Rogers Test, the court found that Brown failed to show that EA Sports’ usage of his likeness was irrelevant to the underlying work because Madden NFL is about NFL football and that Brown is a “legendary player.”

Furthermore, the court found that the game was not explicitly misleading because no promotional materials for the game featured his name or likeness.

More importantly, the court found that Brown’s “anonymous [and] mis-numbered ... presence in the games” would require a “leap of logic” for a consumer to equate the aforementioned usage as an endorsement of the product.

Absent any explicit representations of endorsement, the court found that consumer confusion was highly unlikely, and, therefore,

the use of Brown’s likeness failed to outweigh the public’s interest in the expressive nature and creative aspects of the game.

Confusion lingers

The clash over Ginger Rogers’ and Jim Brown’s marks provides a critical lesson in that it is legally permissible to use someone else’s trademarks for expressive speech purposes. For any creator of artistic works, the practical ramification is clear: If an artist wants to use someone’s trademark for an artistic work, make sure it is used for a protected purpose, such as parody, not just to draw attention to the artist.

But the Barbie decision leaves a few things unclear. Although the 9th Circuit adopted the Rogers Test, that test was meant to evaluate whether the title of a literary work infringes a trademark. It is uncertain whether the court intended the test to be used for all trademarks that have become part of the public vocabulary. Nor does the decision draw a clean line between commercial and noncommercial speech.

A case decided in a Los Angeles court recently crossed that invariably fuzzy line and perhaps offers a glimmer of hope for those attempting to protect the use of their likeness in artistic works.

In a case strikingly similar to Jim Brown’s, Samuel Keller, a former starting quarterback for Arizona State University and the University of Nebraska football teams, alleged that EA used his likeness without his consent in a series of videogames called “NCAA Football.”

The games include virtual football players that resemble real-life college football athletes. Keller alleged that EA used his likeness by including a virtual player in the series of games with his identical jersey number and position, similar physical characteristics (height and weight), and that the player hailed from his true home state.

Keller also sued the NCAA for civil conspiracy and breach of contract, and the Collegiate Licensing Company for civil conspiracy and unjust enrichment.

The court held that, under California’s right of publicity statute, Keller’s action could be maintained despite EA’s invocation of First Amendment defenses including transformative use and the public interest doctrine.


The sin non qua of the holding was that “EA’s depiction of [the] Plaintiff in ‘NCAA Football’ is not sufficiently transformative ... [I]n the game, the quarterback for Arizona State University shares many of the Plaintiff’s characteristics ... The virtual player wears the same jersey number, is the same height and weight and hails from the same state. EA does not depict Plaintiff in different form; he is represented as what he was: the starting quarterback for Arizona State University [and] the game’s setting is identical to where the public found Plaintiff during his collegiate career: on the football field.”

One of the more recent consumer market examples of possible infringement involves the leader of the free world. President Obama recently appeared on a billboard in New York’s Times Square wearing a Weatherproof jacket. The unsuspecting presidential pitchman’s tagline read: “A Leader in Style.” The White House got wind of the stunt and the billboard came down, but not before Weatherproof communicated its message.

There’s no telling how much additional revenue Weatherproof collected from President Obama’s perceived one-day “endorsement” of its product, or whether EA Sports benefited financially from using the likeness of James Brown in its Madden NFL game.

But the underlying message from these decisions is that trademark owners do not have unfettered rights to prevent others from using their trademarks in an artistic manner when the use is not misleading.

Consider the fact that so many trademarks provide us with the strongest metaphors — who could forget ET eating Reese’s Pieces in the blockbuster film? No one really thought that the candy manufacturer was somehow affiliated with the movie.

Yet while the Rogers Test is still the yardstick to measure these types of infringement cases, the 21-year-old litmus test creates significant loopholes that must be addressed in today’s frenetic social media environment. 

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