Balance between brand protection and artistic expression: strengthening the First Amendment

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Several recent decisions appear to have strengthened the First Amendment's ability to insulate titles of expressive works from claims of trademark infringement. While the Supreme Court has not yet rendered a decision squarely addressing the issue, it now has the opportunity to do so.

The First Amendment defence to trademark infringement is rooted in free speech concerns. Because the title of a work may be an “integral element” of the author’s expression, as well as “a significant means of marketing” the work to the public, the Second Circuit – the first court of appeals to solidify the defence – explained that consumers of artistic works “have a dual interest: they have an interest in not being misled and they also have an interest in enjoying the results of the author's freedom of expression” (*Rogers v Grimald*, 875 F2d 994, 998 (2d Cir 1989)). In *Rogers*, the Second Circuit set forth a two-prong test for determining whether the title of a work warrants First Amendment protection. Under the *Rogers* test, the title of an expressive work does not violate the Lanham Act “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work”, as stated in *Mattel Inc v MCA Records, Inc*, 296 F3d 894, 902 (9th Cir 2002) (quoting *Rogers*, 875 F2d at 999). Several other circuits have addressed the interplay between the First Amendment and trademark infringement claims. For example, *University of Ala Bd of Trus v New Life Art*, 683 F3d 1266 (11th Cir 2012) held that a claim alleging trademark infringement based on an artist’s renderings of the University of Alabama's football uniform colours and logos in paintings, calendars and prints did not constitute trademark infringement due to First Amendment insulation. Further, *ETW Corp v Jireh Publ'g, Inc*, 332 F3d 915, 927 (6th Cir 2003) (quoting *Rogers*, 875 F2d at 999) noted that “the Lanham Act should be applied to artistic works only where the public interest in avoiding confusion outweighs the public interest in free expression”.

In November 2017, in *Twentieth Century Fox Television v Empire Distribution, Inc*, 875 F3d 1192, 1195 (9th Cir 2017), the Ninth Circuit applied the *Rogers* test to determine whether the title of the *Empire* television show featuring a music mogul based in New York was protected against Empire Distribution, Inc’s claims of trademark infringement based on its prior use of the name "Empire" for its record label and music distribution. In analysing the *Rogers* factors, the court determined that “Fox used the common English word 'Empire' for artistically relevant reasons: the show's setting is New York, the Empire State, and its subject matter is a music entertainment conglomerate, 'Empire Enterprises', which is itself a figurative empire”. The court emphasised the low bar for artistic relevance, citing *ESS Entm't 2000, Inc v Rock Star Videos, Inc*, 547 F3d 1095, 1100 (9th Cir 2008) that “the level of relevance merely must be above zero”. Under the second prong, the court determined that “Fox's *Empire* show, which contains no overt claims or explicit references to Empire Distribution, [wa]s not explicitly misleading”. As a result, the First Amendment was found to insulate Fox from the claims of trademark infringement. Empire Distribution appealed the decision to the Supreme Court.

Not surprisingly, following the Ninth Circuit's decision, on 21 May 2018 the District Court for the Southern District of California issued an order finding that a work titled *Oh, the Places You'll Boldly Go!* was insulated from Dr Seuss's claim that the title infringed the trademark rights in *Oh, the Places You'll Go!*, in *Dr Seuss Enters, LP v ComicMix, LLC*, 2018 WL 2306733, (SD Cal 21 May 2018). Noting that the artistic relevance test is a low bar, the court determined that "the title of *Boldly*, while obviously also referring to and using the title of *Go!*, describes and is relevant to its own content”. With respect to the second prong, the court noted that "*Boldly*'s copyright page states that '[t]his is a work of parody, and is not associated with or endorsed by CBS Studios or Dr Seuss Enterprises, LP”. Without addressing the effectiveness of the disclaimers, the court found that this statement cut against a likelihood of confusion by consumers as to the source or content of the work. The court remarked, however, that the second prong might have been met "if Defendants had included a leaflet or a statement within *Boldly* that stated Plaintiff endorsed or was involved in the production of *Boldly*." Because both prongs of the *Rogers* test were satisfied, the court found that the title of the work was protected by the First Amendment and granted judgment on the pleadings as to the plaintiff's trademark claims.

The *Empire* and *Dr Seuss* decisions reflect the increasing strength of free speech rights for authors of expressive works and the elevation of those rights over rights of trademark owners, so long as there is no express statement that could mislead consumers as to the source or content of the expressive work. While courts have historically imposed a low bar for establishing artistic relevance under the first prong of the *Rogers* test, these decisions seem to demonstrate a similarly low bar for the second prong, thereby strengthening the First Amendment defence. It remains to be seen whether the Supreme Court will agree with the circuit courts’

analysis of these two competing rights. If the Supreme Court agrees to hear the case and adopts the *Rogers* test or something similar, it will be interesting to see whether the court will distinguish between Fox's use of 'Empire' for the title of the television show as opposed to its use of 'Empire' in connection with the sale and distribution of music related to the television show, which Empire Distribution argues should not be insulated by the First Amendment.

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