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165-year-old brand alleges trademark infringement against best-selling video game

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In under three months, *Red Dead Redemption 2* became the highest selling video game of 2018. Set in the 1800s in the Wild West, *Red Dead 2* is as much a film (with a main storyline that unfolds over more than 60 hours) as it is an interactive action-adventure game with over 100 missions for the player to navigate. It was released to universal acclaim and received several perfect scores from leading critics, due in large part to the game developers' creation of an immersive and complex environment with a relentless commitment to historical accuracy and detail. *Red Dead 2*'s developers, Take-Two Interactive Software and Rockstar Games, spent over seven years with the efforts of more than 2,000 people to create a game with more than 500,000 lines of dialogue and 300,000 animations.

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Red Dead 2 is widely celebrated for its realism and historical accuracy. For example, an article in *The Guardian* noted that the developers aim to provide players with a Wild West fantasy so authentic that "you can forget it is not real". Other historically and geographically accurate details (eg, flora and fauna, music, technology and wildlife) contribute to the game's believable and authentic experience. Even the birds are location-appropriate and sing with accurate pitch. Such commitment to realism has garnered attention from unlikely sources: the Audubon Society praised the game's inclusion of 200 distinct, interactive species of animals and 40 different plant species.

In one of the 100 or so missions throughout *Red Dead 2*'s story, fact meets fiction when the game's protagonists rob a train. The owner of the train hires Pinkerton security agents to find the culprits. In a cinematic cut-scene, two men introduce themselves to the main character as agents of the "Pinkerton Detective Agency, seconded to the United States government", and tell him he is a wanted man with a bounty on his head. The detectives are dressed in bowler hats, red vests, ties and grey coats – apparel typical of the real Pinkerton detectives.

They also wear silver shield-shaped badges on their chest and at times, the Pinkerton name can be seen. It is the same badge that the Pinkerton National Detective Agency used from 1850 to 1925. The Pinkerton detectives make appearances in 10 of the 100 or so missions.

Red Dead 2 introduces the Pinkerton detectives in the same context that the company was founded in real life: hired by railroad companies to act as private security to protect shipments in the American West. In real life, the US government hired the Pinkerton National Detective Agency to track down criminals, including famous Wild West outlaws such as Jesse James and Butch Cassidy. In the latter part of the twentieth century, when agencies like the FBI subsumed much of the detective work, Pinkerton focused more on security. Today, Pinkerton provides a variety of corporate risk management services as a subsidiary of Securitas AB, a Swedish security firm and one of the largest in the world.

Rockstar Games and Take-Two Interactive did not ask for Pinkerton's permission to use its name or badge. But did they have to?

Six weeks after the release of *Red Dead 2*, Pinkerton sent Rockstar and Take-Two Interactive a cease and desist letter alleging that the unauthorised use of the Pinkerton brand, including PINKERTON'S (US Registration Number 887,265), and the Pinkerton Detective Badge (US Registration Number 546,426), constitutes trademark infringement.

In response, Take-Two Interactive and Rockstar Games filed a declaratory judgment action in the US District Court for the Southern District of New York, seeking a declaration that it is not liable for trademark infringement based on three theories.

First, the developers relied on First Amendment grounds, arguing that "*Red Dead 2* references the Pinkerton Detective Agency and Historical Pinkerton Badge as part of the creative expression of the video game", which references are relevant to their "artistic message as [they] have sought to create a historically realistic depiction of the Wild West, and the references relate to the historical feel, setting, and plot of the video game". The developers argued that the Pinkerton name and badge are only used in the context of the video game itself and are not used in the game packaging or promotional material. In such a context, they do not suggest sponsorship or affiliation between *Red Dead 2* and Pinkerton and that the First Amendment precludes a trademark infringement claim when "the use of a mark in a creative work that is artistically relevant to the work and not overly misleading".

Second, the developers sought a declaratory judgment that their use of the Pinkerton name and badge constitute nominative fair use. Under US trademark law, a commercial user is entitled to a nominative fair use defence under the following circumstances:

- the product or service in question is not readily identifiable without the use of the trademark;
- only so much of the mark or marks is used as is reasonably necessary to identify the product or service; and
- the user does not do anything that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.

*Red Dead 2*s developers argued that they used the Pinkerton name and badge to refer to the historical Pinkerton National Detective Agency, that they only used so much of the name and badge as necessary to identify it as such, and that consumers are not likely to be confused about the source of their products as compared with those of Pinkerton.

Finally, the developers sought a declaratory judgment that their use of the Pinkerton name and badge is not likely to cause confusion as to the source or affiliation of its products or confuse consumers into believing that its products are sponsored or endorsed by the defendants, because the developers and the defendants provide completely different goods and services (video games versus corporate risk management and security).

The developers' declaratory judgment action is in its infancy and Pinkerton has not yet filed a response. Prior to the lawsuit, Pinkerton's lawyers argued in writing to the developers that there must be artistic relevance of the use of the mark for the First Amendment defence to apply:

Assessing the game's use of the Pinkerton assets, it is difficult to see how such use enhances the content, tone, style, purpose or appeal over the use of any other law enforcement brand, and thus leaves the question of whether the use was arbitrarily chosen to exploit the Pinkerton brand.

The game developers addressed Pinkerton's argument in its lawsuit in part by identifying extensive use of the Pinkerton name in media and popular culture, including dozens of classic and contemporary television shows and movies.

Pinkerton's president also issued a public statement on *Red Dead 2*, arguing that the game's claim to historical accuracy was "misleading". The statement says in part:

One cannot rewrite history to create profit in the present at the expense of real-life people who represent a brand today. In the game, Pinkertons are seen shooting horses, shooting guns and firebombs into buildings where women and children are present, and as violent villains in the community. History tells a different story.

The statement also lamented that Pinkerton employees "now have to explain to their young game players why *Red Dead Redemption 2* encourages people to murder Pinkertons," and that such an image is inaccurate and detrimental to the Pinkerton brand.

Comment

The *Red Dead 2* lawsuit raises several interesting issues. In particular, it highlights two aspects of trademark law that are often overlooked.

First, consider the duration of trademark rights, which theoretically can last forever so long as they remain in use, as compared to other IP disciplines such as copyright and patent law, which are statutorily limited. *Red Dead 2* is set in 1899 – nearly 50 years after the first Pinkerton office opened. In 1899 commercial electricity was in its infancy and the notion of a video game would not have crossed even the wildest of imaginations. Over 100 years later a

venerable security company that has been using the same name for over 165 years is accusing a video game company of trademark infringement.

Second, the *Red Dead 2* lawsuit spotlights how trademark infringement claims require trademark use. It is never sufficient to simply claim "you can't do that, it's trademarked". Whether 'use' constitutes trademark use, and whether it is permissible is a nuanced analysis. Inquiry must be made into such matters as the nature of the goods and services, or whether there is no descriptive subsite for the mark.

The *Red Dead 2* lawsuit is certainly one to watch. The developers of the game could have made up a fictitious detective agency in the style of the Pinkerton agency, but to provide the player with the most realistic experience of the 1890s Wild West, they went further – using the Pinkerton name and badge, as well as apparel and bowler hats distinctive of Pinkerton detectives. The developers defend that they used Pinkerton's marks only as much as necessary to identify Pinkerton in historical context. Arguably, historical details are even more important in a visual context than in a strictly literary one and the game relies on those details as anchor points to create an immersive and realistic experience. On the other hand, does the fictional aspect of historical fiction permit the developers to take creative licence when it suits them, if to do so is not authorised by the owner of the brand depicted in historical fiction? *Red Dead 2*'s developers put dozens of outlaws in the game, but Pinkerton is hoping it can apprehend just one more.

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