

False Endorsement or First Amendment?: An Analysis of Celebrity Trademark Rights and Artistic Expression*

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I. INTRODUCTION

The United States is a country dominated by celebrity, and the line between fame and everyday American life continues to blur.¹ Everyday people are becoming famous through vehicles such as reality television.²

1. David Carr, *Major Stars Not So Crucial as Concept Trumps Celebrity*, N.Y. TIMES, June 23, 2003, at A1 (discussing the transition from using “A-list” celebrities in television and film to concept-based programming, especially reality television).

2. Describing this situation, the Hartford Courant stated, “Ordinary people are the stars of reality television . . .” Editorial, *California Dreamin’*, HARTFORD COURANT, Aug. 8, 2003, at A10, available at 2003 WL 59295643. Reality shows can create new celebrities or attempt to revive old celebrity careers. Shows such as “Survivor” and “The Bachelor” (and “The Bachelorette”) make celebrities of ordinary people thrust into unusually eventful situations. See Digest, *‘Bachelor’ Couple Inks with Paradigm*, HOLLYWOOD REP., July 15, 2003, at 8, available at 2003 WL 57154323 (discussing “The Bachelor” winners signing with agency to concentrate on endorsement deals). “American Idol” promises a recording contract to an ordinary person selected by celebrity judges and an audience vote. Winners of the show, such as Kelly Clarkson, become instant celebrities complete with endorsement deals. See Carla Hay, *Fashion Houses Strike a Chord with Pop Stars*, BILLBOARD, Oct. 4, 2003, at 1 (explaining Kelly Clarkson’s endorsement deal with Candie’s shoes); Natalie Zmuda & Brian Russak, Mediabank, *Clarkson Unveiled*, FOOTWEAR NEWS, Sept. 8, 2003, at 4, available at 2003 WL 60593875 (explaining the same, and adding that Clarkson and Candie’s are discussing producing a Kelly Clarkson signature shoe).

Additionally, hosts of these shows are becoming celebrities. For example, consumers recently voted “Queer Eye for the Straight Guy” “fashion maven” Carson Kressley as the most influential celebrity endorser on their shopping decisions, more influential than Michael Jordan, Paris Hilton, or Ben Affleck. Rob Owen, TV Notes, *Simon to Help Judge ‘Idol’s’ World Contest*, PITTSBURGH POST-GAZETTE, Dec. 8, 2003, at B8, available at 2003 WL 64518690 (discussing results of a survey conducted by public relations firm Jericho Communications of 2654 shoppers in major metropolitan areas).

Moreover, reality shows will feature celebrities past their prime in an attempt to revive their careers (and the public’s recognition of them). For example, “The Surreal Life,” which aired on the WB network, followed the lives of 80’s rock icon Vince Neil, early

“A-list” celebrities, while still important, are finding themselves surrounded by ordinary people turned famous. The New York Times recently noted that celebrities have been defined “down to the guy or girl next door, riveting consumers who secretly hope to be the stars of their own movies.”³ As a result, the contours of what a celebrity is continually broadens. If “the first ‘Bachelor’ and his would-have-been bride”⁴ and ordinary people turned stars like them are afforded the same protection as traditional celebrities, litigation will certainly increase.⁵

Meanwhile, the law dealing with celebrities’ trademark protection and First Amendment defenses is splintered within and among the federal circuits.⁶ When a celebrity takes issue with use of his or her name or image in artistic works used in commerce, such as popular music or film, First Amendment concerns arise. Creation of a message, by its nature, conflicts with attempts to control that message.⁷ As a result, First

90’s rapper MC Hammer, 80’s actor Gary Coleman, and others, during their stay together in a resort house. See Eric Deggans, *The New Celebrity Standard*, ST. PETERSBURG TIMES, Dec. 2, 2003, at 1E, available at 2003 WL 56481388 (discussing the masses of “past-their-prime celebrities” trying to appear on reality shows in the hopes of jump-starting their careers, and how appearing on a reality show is a good way to launch a career).

3. Carr, *supra* note 1, at A18; cf. Pelton v. Rexall Sundown, Inc., No. 99 Civ. 4342, 2001 U.S. Dist. LEXIS 3825, at *9–10 (S.D.N.Y. Apr. 4, 2001) (denying Lanham Act suit because the plaintiff was not a recognizable celebrity even though she claimed to be an internationally known model). In *Pelton*, the plaintiff agreed to be photographed for a surfing magazine. *Id.* at *3–4. The defendant later used her photo on its vitamin supplement packaging without her permission. *Id.* at *5. The court dismissed her Lanham Act claim, finding that a reasonable consumer would not recognize the plaintiff and therefore would not falsely associate her with endorsement or sponsorship of the product. *Id.* at *10.

4. “The first ‘Bachelor’ and his would-have-been bride: Does anyone even remember their names? Doesn’t matter.” James H. Burnett III, *Celebrities Wear Out Welcome with Overexposure: Ben and J-Lo, Please Go*, MILWAUKEE J.-SENTINEL, May 9, 2003, at 10E, available at 2003 WL 3323846. While reality shows suffer this sort of backlash, their continued popularity presents a new set of celebrities created with every television season. With this ever-expanding group of celebrities comes more potential for litigation.

5. See *Privacy and Publicity: New Developments in Media Law*, METROPOLITAN CORP. COUNS., Sept. 11, 2003, at 4 (discussing Spike Lee’s suit against Spike TV for trademark infringement as “part of an expanding amount of litigation initiated by celebrities to protect the commercial use of their names and the commercial value of their personas”); Cathy J. Frankel, *In Star-Struck America, Broader Protection Sought by Celebrities*, N.Y. L.J., Aug. 7, 2000, at 9 (“[M]ore and more celebrities are becoming plaintiffs, asserting claims under a variety of legal theories.”).

6. Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 482 (2003).

7. See *id.* at 479.

Amendment free speech rights inherently conflict with attempts to exclude one's name from others' speech—that is, controlling a message and its content.⁸ Courts must determine the extent to which an artist's First Amendment right of free speech renders various legal regimes inapplicable. In the trademark context, the federal courts have used at least three different tests, and variations on those tests, to balance these interests: likelihood of confusion,⁹ alternative avenues,¹⁰ and the *Rogers v. Grimaldi* balancing test.¹¹ These tests are applied in place of the statutory likelihood of confusion test to balance the First Amendment interests involved. Only *Rogers* explicitly recognizes the First Amendment issues, while the other two tests primarily focus on the celebrity's rights.

Unclear rules breed uncertainty, and that uncertainty limits expression. Musicians, filmmakers, and artists risk expensive and prolonged litigation every time they use a celebrity's name or image in a work, no matter what relevance they contend it might have to their message.¹²

8. Joshua Waller, Comment, *The Right of Publicity: Preventing the Exploitation of a Celebrity's Identity or Promoting the Exploitation of the First Amendment?*, 9 UCLA ENT. L. REV. 59, 59 (2001).

9. The Ninth Circuit sometimes applies the standard likelihood of confusion test to cases involving literary titles. See *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1406 (9th Cir. 1997) (granting injunction against book using Dr. Seuss's trademarks to parody another subject because "serious questions" existed as to whether the claimed parody created a likelihood of confusion).

10. The Eighth Circuit applied the alternative avenues test in several instances. See *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 401–03 (8th Cir. 1987) (holding merchandise parodying Mutual of Omaha logo infringing). The Second Circuit adapted the test from *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972), in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979), but changed its approach in *Rogers*. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

11. *Rogers*, 875 F.2d at 999–1000 (holding that a movie entitled "Ginger and Fred" did not infringe actress Ginger Rogers's trademark rights in her name because the title contained minimal artistic relevance to the film's content and was not explicitly misleading as to film's source). The Second and Sixth Circuits routinely apply *Rogers*, although sometimes the Sixth Circuit applies it in different ways. Compare *Parks v. LaFace Records*, 329 F.3d 437, 454–55 (6th Cir. 2003) (finding that a rap song using civil rights icon Rosa Parks's name as its title had "highly questionable" artistic relevance, and overturning a judgment as a matter of law of noninfringement), *cert. denied*, 124 S. Ct. 925 (2003), with *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 920–21 (6th Cir. 2003) (holding that a lithograph portraying golfer Tiger Woods's victory at the Masters Tournament did not infringe on trademark rights in his name and image under *Rogers*), *reh'g denied*, 2003 U.S. App. LEXIS 19044 (6th Cir. 2003). The Ninth Circuit distinguished *Dr. Seuss* and applied *Rogers* where a potentially infringing use parodied the trademark used, instead of using the trademark to make fun of something else. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901–02 (9th Cir. 2002) (holding that song entitled "Barbie Girl" parodied Mattel's product, instead of using Mattel's trademark to parody something else, and therefore did not infringe under *Rogers*), *cert. denied*, 537 U.S. 1171 (2003).

12. See Waller, *supra* note 8, at 81–82 & nn. 184–85 (discussing several attorneys' real world assessment of the situation as requiring either celebrities' permission or use of something entirely different in order to avoid liability).

While major label musicians and their record labels, such as the rap group OutKast, LaFace Records, and, ultimately, media giant Bertelsmann, have the resources to risk expensive litigation to use a celebrity's name in a title, the vast majority of potential users do not.¹³ Imagine a local rock band that wants to use a celebrity's name in a song's title. Most musicians have neither the resources of a high profile record label, nor the notoriety to make litigation worthwhile.¹⁴ Short of risking litigation, artists will be forced to settle by using different representations in their works, even if the substitution takes away from the overall composition. The net effect of this inconsistent treatment is to chill speech by artists unwilling or unable to take this chance.¹⁵ Given the inconsistent treatment

13. OutKast entitled a song "Rosa Parks," for which Rosa Parks, the civil rights icon, filed claims of misappropriation, Lanham Act section 43(a) infringement, right of publicity violations, and other state law claims. *Parks*, 329 F.3d at 441–43. The Supreme Court denied OutKast's petition for certiorari in December, 2003. *LaFace Records v. Parks*, 124 S. Ct. 925 (2003). In September, 2004, CBS News reported that Parks has dementia and that her attorneys objected to requiring her to answer questions in the case. *Lawyer: Rosa Parks Has Dementia*, CBSNEWS.COM, (Sept. 22, 2004), at <http://www.cbsnews.com/stories/2003/12/08/national/main587389.shtml?CMP=ILC-SearchStories> (last visited Nov. 24, 2004).

At the time of the *Parks* case, OutKast's label, LaFace Records, had a distribution agreement with Bertelsmann. *Parks*, 329 F.3d at 442. Bertelsmann is one of the world's largest global media companies, "so big, [that] it needs space in the bookcase, CD rack and magazine stand." *Bertelsmann AG*, HOOVER'S COMPANY PROFILES (Sept. 15, 2004), at 2004 WL 94095915. The label is now involved in a joint venture called Sony BMG Music Entertainment between two media monsters, Bertelsmann and Sony Music. *Sony BMG Music Entertainment*, HOOVER'S COMPANY IN-DEPTH RECORDS, (Sept. 29, 2003), at 2004 WL 95248811. One can venture a guess that the celebrity in that case, Rosa Parks, was actually the smaller entity.

Conversely, the litigants in *Mattel* were giant corporations battling over trademark use in a song title. In *Mattel*, the unknown pop group Aqua faced Lanham Act infringement claims from Mattel, Inc. over a song entitled "Barbie Girl." Two defendants in *Mattel* were media giants that produced and distributed the song: MCA Records, and Universal Music Group, the one of the world's largest music publishing companies. *See Mattel*, 296 F.3d at 899; *Universal Music Group*, HOOVER'S COMPANY PROFILES, Sept. 29, 2004, at 2004 WL 95247238. Judge Kozinski noted the litigants' size in *Mattel* by stating that if the case "were a sci-fi melodrama, it might be called Speech-Zilla meets Trademark Kong." *Mattel*, 296 F.3d at 898. Not surprisingly, unknown bands without the resources of a monster record label at their disposal would not have the ability to litigate these claims, and must either settle them immediately or steer clear of possibly legal (but trademarked) titles.

14. *Cf. Parks*, 329 F.3d at 437 (involving well-known rap duo OutKast, signed to LaFace Records and affiliated with Bertelsmann); *Mattel*, 296 F.3d at 899 (involving Danish band Aqua, unknown in the United States, signed to MCA Records and affiliated with Universal Music Group).

15. Judge Kozinski stated, "Much useful social and commercial discourse would be all but impossible if speakers were under threat of an infringement lawsuit every time

and potential for increased litigation in this area, courts must apply a standard test for trademark infringement as it relates to celebrities' names and images, in order to preserve artists' First Amendment rights.

In Part I, this Comment will address both artistic and entertainment industry issues relating to using celebrity names and images in creative works. Part II will discuss the relationship between state right of publicity and privacy claims, and federal trademark law. Part III will discuss the Lanham Act's history and purpose, including its traditional applications and recent amendments. Part IV will address the First Amendment issues raised when creative works use celebrities' names and images. Part V will address the three tests courts use to balance section 43(a) Lanham Act claims and First Amendment rights. Part VI will advocate the consistent use of the *Rogers* test as a low threshold to remove artistic works from the trademark regulation regime.

II. BACKGROUND: TITLES AND IMAGES IN THE ENTERTAINMENT INDUSTRY

The title is an integral component of any expressive work. Titles have two purposes: "to catch the eye and to promote the value of the underlying work."¹⁶ Ordinary trademark infringement requires labels to refrain from misleading or confusing the public as to the good's source. Consumers are protected insofar as they can identify what they buy.

Unlike labels of ordinary commercial goods, titles of artistic works do not serve to identify the manufacturer.¹⁷ Rather, consumers would expect the title to be associated with a work's content.¹⁸ They can usually identify its creator on the work's face or by its packaging. For example, a CD package would typically identify the musician somewhere on the packaging, but consumers would not look to the song titles for that

they made reference to a person, company or product by using its trademark." *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 307 (9th Cir. 1992); *see also Parks v. LaFace Records*, 76 F. Supp. 2d 775, 781 (E.D. Mich. 1999) (quoting *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 460 (Cal. 1979), and discussing the "inevitabl[e] chill" on free speech if artists must justify their use of celebrities' identities), *aff'd in part, rev'd in part*, 329 F.3d 437 (6th Cir. 2003), *cert. denied*, 124 S. Ct. 925 (2003); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 *YALE L.J.* 1687, 1713 (1999) (blasting current expansive trademark litigation's "suppress[ion of] social, political, or artistic speech that happens to include the trademark"); Lee, *supra* note 6, at 500 (urging the rejection of the *Rogers* balancing approach because it "lacks substantive content and encourages uncertainties, which may chill speech by themselves.")

16. *Mattel*, 296 F.3d at 902.

17. *Id.*

18. *In re Cooper*, 254 F.2d 611, 616 (C.C.P.A. 1958) (holding that a book's title cannot be trademarked because the title is not indicative of its source).

identification.¹⁹ Consumers can determine some element of the work's content from its title, although they should know better than to judge a book solely by its cover.²⁰ Creative works, or their titles including a celebrity's name, could imply endorsement or involvement. The three tests—likelihood of confusion, alternative avenues, and the *Rogers* balancing test—are used to determine whether this type of use is permitted under the false endorsement section of the Lanham Act, section 43(a), in light of First Amendment freedom of speech.²¹

III. RELATION BETWEEN RIGHT OF PUBLICITY AND TRADEMARK LAW

Celebrities use both state and federal causes of action to prevent unauthorized use and protect their economic investment in their identities. Primary federal claims are under section 43(a) of the Lanham Act for false advertising or endorsement, and for dilution under section 43(c). Right of publicity is the broadest and most frequently litigated state law claim. Right of publicity is entirely a state law claim. States have varying statutory and common law schemes.²² Unlike the right of privacy, based in the right of an individual to be left alone, the right of publicity protects an individual's name or likeness from being commercially appropriated by someone else.²³ Whereas a right of privacy claimant does not want exposure at all, a right of publicity claimant asserts that he or she "simply wants to be the one to decide when and where, and to be paid for [the exposure]." ²⁴

When the right of publicity conflicts with the First Amendment, courts resolve the tension under principles specific to each state right. Some

19. *Mattel*, 296 F.3d at 902 ("A title tells us something about the underlying work but seldom speaks to its origin.").

20. *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989).

21. See discussion *supra* text accompanying notes 157–215.

22. ALEXANDER LINDEY & MICHAEL LANDAU, 1 LINDEY ON ENTERTAINMENT, PUBLISHING AND THE ARTS, § 1:118, at 1-431 (2d ed. 2004).

23. *Lerman v. Flynt Distrib. Co.*, 745 F.2d 123, 127–30, 134 (2d Cir. 1984) (concerning limited public figure's right of privacy and publicity claims against pornographic magazine for falsely identifying her as nude woman in photograph); see also LINDEY & LANDAU, *supra* note 22, § 1.118, at 1-429 to 1-430. The right of privacy is credited to a seminal article in the Harvard Law Review. See Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890); see also Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954) (expanding on Warren and Brandeis's right of privacy to explain a new right of publicity for celebrities).

24. *Lerman*, 745 F.2d at 134; see LINDEY & LANDAU, *supra* note 22, § 1:118, at 1-429 to 1-430 (discussing differences between the torts).

states, such as California, recognize both common law and statutory rights of publicity, which may differ in application.²⁵ Trademark and right of publicity claims are similar in that each grants the celebrity the right to protect an economic interest in his or her name.²⁶ The crucial difference between the two claims is that right of publicity focuses on the individual's rights instead of consumers' rights. Right of publicity violations do not require likelihood of consumer confusion.²⁷ Additionally, celebrities can (and often do) assign their right of publicity, in gross, to studios.²⁸ Trademark rights cannot be similarly assigned because trademark rights derive from use in commerce and are not property rights in the traditional sense.²⁹

IV. HISTORY AND PURPOSES OF THE LANHAM ACT

The Lanham Act defines a trademark as “any word, name, symbol, or device or any combination thereof” used by any person “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,

25. California Civil Code section 3344 states: “Any person who knowingly uses another’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising . . . without such person’s prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.” CAL. CIV. CODE § 3344 (West 1997). See *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1514 (9th Cir. 1993) (discussing the difference between California’s statutory and common law right of publicity, and distinguishing between the protection of identity under the common law right and likeness under the statutory right).

26. *Parks v. LaFace Records*, 329 F.3d 437, 460 (6th Cir. 2003) (comparing Parks’s false advertising/trademark claim with her right of publicity claim) (citing *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983)), *cert. denied*, 124 S. Ct. 925 (2003).

27. *Id.* at 460; see also *Henley v. Dillard Dep’t Stores*, 46 F. Supp. 2d 587, 589, 591–92, 597 (N.D. Tex. 1999) (holding that musician Don Henley’s right of publicity violated by department store advertisement showing henley shirt with phrase “This is Don’s henley” because the phrase identified Henley in the minds of consumers). In California, the plaintiff does not need to be a celebrity or prove actual damages for recovery of statutory damages under section 3344. CAL. CIV. CODE § 3344. Recovery by non-celebrities is considered recovery under an invasion of privacy theory because use of an ordinary person’s name is violative of his right to be left alone. *KNB Enters. v. Matthews*, 92 Cal. Rptr. 2d 713, 717 n.6 (Ct. App. 2000). Celebrities recover under a right of publicity theory because the celebrity’s interest is harmed more by the damage to the property interest in their names than any injury from not leaving them alone. *Id.*

28. See, e.g., *Aucoin Mgmt., Inc., v. Neil’s Fads, Inc.*, No. 78-70971, 1979 WL 1076, at *1 (E.D. Mich. Sept. 28, 1979) (copyright suit by assignees of rock band KISS’s right of publicity); see also 2 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 5:12, at 417–18 (discussing nonapplicability of trademark “anti-Assignment-in-Gross Rule” to right of publicity) [hereinafter MCCARTHY, PUBLICITY AND PRIVACY].

29. 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:13 at 28-16 to 28-17 (4th ed. 2004) [hereinafter MCCARTHY, TRADEMARKS].

even if that source is unknown.”³⁰ The Lanham Act protects resource expenditures to develop identification for a product. It allows producers to exclude others from using that identification, at least to the point that consumers could be confused as to the product’s source.³¹

To win a trademark infringement action, a plaintiff must prove both validity of the mark and infringement upon it.³² Validity of the mark is established by showing that the mark specifically identifies one company’s goods from another.³³ A registered trademark is presumed valid.³⁴ Infringement is established by showing that another party used the mark in a manner that is likely to confuse consumers as to the source of the goods.³⁵

Congress passed the Lanham Act in 1946 attempting to create a federal law prohibiting unfair competition.³⁶ Specifically, the legislature intended section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), to be a “federal anti-false advertising statute”³⁷ The Act prohibits use of a trademark that could result in consumer confusion, mistake, or deceit as to the origin of the mark.³⁸ The Lanham Act’s purposes are to: (1) allow customers to identify a product’s manufacturer or sponsor, and (2) enable producers to differentiate the product from others on the market.³⁹

30. 15 U.S.C. § 1127 (2000); see *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

31. Tara J. Goldsmith, Note, *What’s Wrong with this Picture? When the Lanham Act Clashes with Artistic Expression*, 7 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 821, 829 (1997); see also 15 U.S.C. § 1114 (2000).

32. *Platinum Home Mortgage Corp. v. Platinum Fin. Group, Inc.*, 149 F.3d 722, 726 (7th Cir. 1998) (citing *Echo Travel, Inc. v. Travel Assocs.*, 870 F.2d 1264, 1266 (7th Cir. 1989)).

33. *Platinum Home Mortgage Corp.*, 149 F.3d at 726; see also 15 U.S.C. § 1125(a) (2000).

34. 15 U.S.C. § 1057(b) (2000); see also U.S. Patent and Trademark Office, *Basic Facts about Trademarks: Should I Register My Mark?*, at <http://www.uspto.gov/web/offices/tac/doc/basic/register.htm> (last modified Nov. 8, 2004).

35. 15 U.S.C. § 1125(a) (likelihood of consumer confusion establishes infringement).

36. *Conte Bros. Auto., Inc. v. Quaker State-Slick 50, Inc.*, 165 F.3d 221, 229 (3d Cir. 1998) (quoting S. REP. NO. 79-1333 (1946), reprinted in 1946 U.S.C.C.A.N. 1274, 1275 (“There is no essential difference between trade-mark infringement and what is loosely called unfair competition.”)).

37. 4 *MCCARTHY, TRADEMARKS*, supra note 29, § 27:14, at 27-25.

38. 15 U.S.C. § 1125(a).

39. *Playboy Enters., Inc. v. Welles*, 7 F. Supp. 2d 1098, 1102 (S.D. Cal. 1998), aff’d, 162 F.3d 1169 (9th Cir. 1998); *Centaur Communications, Ltd. v. A/S/M Communications, Inc.*, 830 F.2d 1217, 1220 (2d Cir. 1987) (“[The Lanham Act’s] purpose is to prevent consumer confusion regarding a product’s source”) (citing *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 871 (2d Cir. 1986)).

Section 32(1) of the Lanham Act⁴⁰ protects registered trademarks, while section 43(a) applies to unregistered marks.⁴¹

A. Survey of Lanham Act Sections, Remedies, and Amendments

I. Section 43(a)

From its inception in 1946 until 1963, section 43(a) laid virtually dormant.⁴² Early judicial interpretation of section 43(a) severely limited its application. Courts limited the meaning of origin to goods' geographic origin.⁴³ In 1963, the Sixth Circuit broadened origin to include goods' manufacturing source.⁴⁴ Narrow interpretations of standing and misrepresentation also limited the usefulness of the section.⁴⁵ Subsequent case law broadened each of these standards, resulting in decades of increased litigation under section 43(a).⁴⁶ The Trademark Law Revision Act of 1988 codified the likelihood of confusion test as

It "enable[s] those that fashion a product to differentiate it from others on the market. In that way producers create goodwill with consumers. The device used to protect both groups is a trademark." *Centaur Communications*, 830 F.2d at 1220 (citing *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 918 (9th Cir. 1980)).

40. 15 U.S.C. § 1114 (2000).

41. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

42. 4 MCCARTHY, TRADEMARKS, *supra* note 29, § 27:7, at 27-13.

43. *See Federal-Mogul-Bower Bearings, Inc. v. Azoff*, 313 F.2d 405, 408 (6th Cir. 1963) (acknowledging both interpretations of "origin," and adopting the broader view that included protection from false designation of manufacturing source); *see also* 4 MCCARTHY, TRADEMARKS, *supra* note 29, § 27:14, at 27-25.

44. *See Azoff*, 313 F.2d at 408.

45. Some early cases held that standing under section 43(a) required the plaintiff to be the sole source of the goods in question. *See Chamberlain v. Columbia Pictures Corp.*, 186 F.2d 923, 925 (9th Cir. 1951) (holding that trustees of Samuel Clemens's estate could not enjoin use of name Mark Twain in film because they did not have exclusive right to use the name). *But see Cano v. A World of Difference Inst.*, No. C 95-03291 CW, 1996 U.S. Dist. LEXIS 8161, at *51 (N.D. Cal May 31, 1996) (stating that *Chamberlain* had been limited to palming off cases, and disapproved to the extent that it suggests that false advertising is not actionable under the Lanham Act). *See also* 4 MCCARTHY, TRADEMARKS, *supra* note 29, § 27:8 n.1, at 27-16 (discussing these cases).

46. *Samson Crane Co. v. Union Nat'l Sales*, 87 F. Supp. 218, 222 (D. Mass. 1949) (finding the Lanham Act to apply only to certain misrepresentations, not false advertising generally), *aff'd*, 180 F.2d 896 (1st Cir. 1950), *superseded by statute as stated in Kasco Corp. v. Gen. Servs., Inc.*, 905 F. Supp. 29, 34 (D. Mass. 1995). *Kasco* announced that the 1988 amendments to the Lanham Act had "consigned *Samson Crane* and its progeny to the dustbin of First Circuit jurisprudence." *Kasco Corp.*, 905 F. Supp. at 34. *Kasco* cited *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1106-07 (9th Cir. 1992), *amended by* 1992 U.S. App. LEXIS 27031 (9th Cir. 1992), where singer Tom Waits recovered under California's right of publicity law when his voice was imitated in an advertisement as an example of the nationwide trend of cases moving away from *Samson Crane*'s limitations on actionable misrepresentation under the Lanham Act and allowing section 43(a) claims for false endorsement. *Kasco Corp.*, 905 F. Supp. at 33; *see also* 4 MCCARTHY, TRADEMARKS, *supra* note 29, § 27:8 & n.2, at 27-16 to 27-17.

the crucial inquiry in a trademark infringement claim.⁴⁷ By the mid 1980s, holders of unregistered trademarks could file a section 43(a) suit with virtually the same rights as registered trademark holders.⁴⁸

The Lanham Act protects marks possessing at least a threshold level of distinctiveness, so that it distinguishes the goods it identifies from others.⁴⁹ The U.S. Supreme Court adopted the Second Circuit's five categories of distinctiveness in *Two Pesos, Inc. v. Taco Cabana, Inc.*⁵⁰ In order of increasing distinctiveness, these categories are: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, and (5) fanciful.⁵¹

Generally, the level of protection corresponds to the distinctiveness of the mark. Generic marks are not protected at all. A mark is generic when it is one that is commonly used and does not identify any particular source.⁵² Generic marks "refe[r] to the genus of which the particular product is a species."⁵³

A descriptive mark "specifically describes a characteristic or an ingredient of a product."⁵⁴ A descriptive mark is not inherently distinctive because it is a "poor means of distinguishing one source of services from another,"⁵⁵ and therefore cannot be registered at its inception. It can, however, acquire secondary meaning by "becom[ing] distinctive of the

47. 15 U.S.C. § 1125(a) (2000); see Trademark Law Revision Act of 1988, Pub. L. No. 100-667, § 132, 102 Stat. 3935 (1988); see also 4 MCCARTHY, TRADEMARKS, *supra* note 29, § 27:18, at 27-33.

48. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 776 (Stevens, J., concurring in the judgment); see 4 MCCARTHY, TRADEMARKS, *supra* note 29, § 27:14, at 27-28.

49. 15 U.S.C. § 1052(e) (2000) (denying protection for merely descriptive or wholly functional terms); see also *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1047 (9th Cir. 1998) (explaining distinctiveness requirement).

50. 505 U.S. 763, 768 (1992). The distinctiveness categories originated in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

51. *Two Pesos, Inc.*, 505 U.S. at 768.

52. *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934, 936 (7th Cir. 1986) (citing *A.J. Canfield Co. v. Vess Beverages, Inc.*, 796 F.2d 903, 906 (7th Cir. 1986)); *Gimix, Inc. v. JS & A Group, Inc.*, 699 F.2d 901, 905 (7th Cir. 1983); *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 79 (7th Cir. 1977); *Abercrombie & Fitch Co.*, 537 F.2d at 9.

53. *Two Pesos, Inc.*, 505 U.S. at 768 (quoting *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985) (citing *Abercrombie & Fitch Co.*, 537 F.2d at 9)).

54. *Liquid Controls Corp.*, 802 F.2d at 936 (citing *A.J. Canfield Co.*, 796 F.2d at 906-07; *Gimix, Inc.*, 699 F.2d at 906; *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 378 (7th Cir. 1976)).

55. *Platinum Home Mortgage Corp. v. Platinum Fin. Group, Inc.*, 149 F.3d 722, 727 (7th Cir. 1998) (citing *Liquid Controls Corp.*, 802 F.2d at 936 (quoting *M.B.H. Enters. v. WOKY, Inc.*, 633 F.2d 50, 54 (7th Cir. 1980))).

applicant's goods in commerce."⁵⁶ Once it has acquired this distinctive meaning, the mark may be registered or can be protected without registration.⁵⁷

Suggestive, arbitrary, and fanciful terms are automatically entitled to protection because each type of mark is inherently distinctive.⁵⁸ A suggestive term requires "imagination, thought and perception to reach a conclusion as to the nature of goods."⁵⁹ Suggestive terms are not truly descriptive of the product on the one hand, but not truly fanciful on the other.⁶⁰ Arbitrary terms are common words used in an unfamiliar way to describe a product, while fanciful terms are words invented for the sole purpose of identifying a good.⁶¹

Typically, section 43(a) Lanham Act claims arise as commercial trademark holders' actions against potentially infringing competitive uses. The key infringement question is whether the public is likely to be confused by the similarity of the marks.⁶² For example, in *Platinum Home Mortgage Corp. v. Platinum Financial Group, Inc.*,⁶³ Platinum Home Mortgage filed a section 43(a) action against Platinum Financial Group over the use of the word "platinum" in the company's name.⁶⁴ The court considered whether consumers would be confused by the defendant's use of the term "platinum" in a related business. It found

56. 15 U.S.C. § 1052(e)–(f) (2000); see *Two Pesos, Inc.*, 505 U.S. at 769.

57. Registration has both practical and legal benefits: constructive notice that the registrant owns the mark, presumption for registrant that he has the right to nationwide use of the mark on or in connection with goods or services named in the registration, ability to bring an action in federal court, the use of the U.S. registration as a basis to obtain registration in foreign countries, and the ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods. U.S. Patent and Trademark Office, *Basic Facts about Trademarks: Should I Register My Mark?*, at <http://www.uspto.gov/web/offices/tac/doc/basic/register.htm> (last modified Nov. 8, 2004).

58. *Platinum Home Mortgage Corp.*, 149 F.3d at 727 (citing *Two Pesos, Inc.*, 505 U.S. at 768).

59. *Abercrombie & Fitch Co.*, 537 F.2d at 11 (quoting *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968)), *overruled as stated in* *N.Y. Racing Ass'n v. Perlmutter Publ'g, Inc.*, 959 F. Supp. 578, 580–81 (N.D.N.Y. 1997) (finding that *Abercrombie* classifications should not act exclusively to determine whether trade dress has acquired secondary meaning, and applying the test from *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1005 (2d Cir. 1995)).

60. *Abercrombie & Fitch Co.*, 537 F.2d at 10.

61. *Id.* at 11 n.12.

62. See 15 U.S.C. § 1125(a) (2000).

63. 149 F.3d at 722.

64. *Id.* at 725; see also *A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 206 (3d Cir. 2000) (discussing section 43(a) suit by manufacturer of "Miraclesuit" swimwear against manufacturer of "Miracle Bra" swimwear); *Parks v. LaFace Records*, 329 F.3d 437, 445 (6th Cir. 2003) (citing *Platinum Home Mortgage Corp.* as a typical section 43(a) service case, and *A&H Sportswear, Inc.* as a typical section 43(a) product case), *cert. denied*, 124 S. Ct. 925 (2003).

“platinum” to be a descriptive mark, which requires secondary meaning for protection.⁶⁵ The court found that Platinum Home Mortgage could not establish secondary meaning in its name and thus dismissed the action.⁶⁶

The Lanham Act entitles holders of trademarks, registered or unregistered, to injunctive and monetary relief.⁶⁷ Circuit courts are split as to whether the plaintiff must show actual confusion to recover damages.⁶⁸ Nevertheless, damages are typically inadequate for continuing infringement because irreparable harm is often presumed to result from infringement.⁶⁹

Trademark holders initially seek preliminary injunctions to stop continued infringement. Once a preliminary injunction is obtained, defendants in entertainment cases often settle. Preliminary injunctions can be extremely costly to infringers when major entertainment projects are involved.⁷⁰

65. *Platinum Home Mortgage Corp.*, 149 F.3d at 728 (citing *Mil-Mar Shoe Co. v. Shonac Corp.*, 75 F.3d 1153, 1157 (7th Cir. 1996)).

66. *Id.* at 729.

67. 15 U.S.C. §§ 1116–1117 (2000).

68. It appears that the majority rule is that actual confusion is required. See *Res. Developers, Inc. v. The Statue of Liberty-Ellis Island Found., Inc.*, 926 F.2d 134, 139 (2d Cir. 1991); see also 5 MCCARTHY, TRADEMARKS, *supra* note 29, § 30:74, at 30-139. But see *Video Pipeline, Inc. v. Buena Vista Home Entm't, Inc.*, 275 F. Supp. 2d 543, 575 (D.N.J. 2003) (rejecting *Resource Developers* in the Third Circuit and not requiring actual confusion for damages), *aff'd*, 342 F.3d 191 (3d Cir. 2003), *cert. denied*, 124 S. Ct. 1410 (2004).

69. See *Wynn Oil Co. v. Am. Way Serv. Corp.*, 943 F.2d 595, 608 (6th Cir. 1991) (quoting *Koppers Co., Inc. v. Krupp-Koppers GmbH*, 517 F. Supp. 836, 849 (W.D. Pa. 1981) (“[A] finding of irreparable injury ordinarily follows when a likelihood of confusion or possible risk to reputation appears.”); *Jordan K. Rand, Ltd. v. Lazoff Bros., Inc.*, 537 F. Supp. 587, 597 (D.P.R. 1982); *Black Hills Jewelry Mfg. Co. v. Gold Rush, Inc.*, 633 F.2d 746, 753 (8th Cir. 1980) (“A finding of tendency to deceive satisfies the requisite of irreparable harm.”); see also 5 MCCARTHY, TRADEMARKS, *supra* note 29, § 30:2, at 30-6 to 30-8.

70. A good example of the potential cost of entertainment industry injunctions was demonstrated by a suit against the film, “Devil’s Advocate.” In this case, sculptor Frederick E. Hart claimed that the film copied his bas-relief sculpture “Ex Nihilo,” which was installed in the main entrance of the Washington National Cathedral, in the film without his permission and in a manner that “desecrated his work.” Brooke A. Masters, *Va. Judge Tells Filmmaker to Settle Suit or Halt Video*, WASHINGTON POST, Feb. 11, 1998, at B2; Lawrence Siskind, *The Devil’s Advocate*, 20 LEGAL TIMES, at 23 (Mar. 23, 1998). The court issued a deadline for settlement after which it would issue a preliminary injunction, temporarily halting distribution of over 400,000 videotapes of the film. Warner Brothers studio said the injunction would cost the studio and video stores over \$42 million. Masters, *supra*, at B2; see also K.J. Greene, *Motion Picture Copyright Infringement and the Presumption of Irreparable Harm: Toward a Reevaluation of the*

In order to receive a preliminary injunction in the Ninth Circuit, a plaintiff must show either a combination of probable success on the merits and possibility of irreparable injury, or the existence of serious questions going to the merits and that the balance of hardships tips sharply in his favor.⁷¹ Irreparable injury is presumed in trademark cases once likelihood of success is shown.⁷² Depending on the jurisdiction, likelihood of success is established by showing likelihood of confusion, alternative avenues for the message, or lack of artistic relevance under *Rogers*. These tests accommodate the First Amendment defense to some degree, either explicitly or implicitly, so no additional First Amendment inquiry is necessary.

2. Dilution

The Federal Trademark Dilution Act (FTDA) established a federal cause of action when a junior use “‘whittl[es] away the value of a trademark’ when it’s used to identify different products.”⁷³ The dilution amendment was adopted to “protect famous trademarks from subsequent uses that blur the distinctiveness of the mark or tarnish or disparage it, even in the absence of a likelihood of confusion.”⁷⁴

Dilution claims apply only to famous marks.⁷⁵ Famous marks are a subset of trademarks that are also protected by traditional infringement claims. While every trademark is, by definition, distinctive, either inherently or through acquiring secondary meaning, very few are famous.⁷⁶ Section 43(c) includes a noninclusive eight factor test to determine whether a mark is famous.⁷⁷ These factors include, for example, duration

Standard for Preliminary Injunctive Relief, 31 RUTGERS L.J. 173, 188–90 (2000) (discussing case).

71. See *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1204–05 (9th Cir. 2000).

72. *Id.* at 1205 n.4 (quoting *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1066 (9th Cir. 1999) (citing *Metro Publ’g, Ltd. v. San Jose Mercury News*, 987 F.2d 637, 640 (9th Cir.1993))); see also *Playmakers, LLC v. ESPN, Inc.*, 297 F. Supp. 2d 1277, 1280 (W.D. Wash. 2003) (citing rule), *aff’d*, 376 F.3d 894 (9th Cir. 2004); *Int’l Jensen, Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 827 (9th Cir. 1993) (citing rule).

73. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 903 (9th Cir. 2002) (quoting 4 MCCARTHY, TRADEMARKS, *supra* note 29, §§ 24:67, 24:70 (Supp. 2001)), *cert. denied*, 537 U.S. 1171 (2003).

74. H.R. REP. NO. 104-374, at 2 (1995).

75. 15 U.S.C. § 1125(c) (2000).

76. “By definition, all ‘trademarks’ are ‘distinctive’—very few are ‘famous.’” *Viacom Inc. v. Ingram Enters., Inc.*, 141 F.3d 886, 890 n.6 (8th Cir. 1998) (quoting 4 MCCARTHY, TRADEMARKS, *supra* note 29, § 24:91 (2004)).

77. Under Lanham Act section 43(c)(1), a court can consider the following factors to determine a mark’s famousness:

(A) the degree of inherent or acquired distinctiveness of the mark;

and geographical extent of use and the public's degree of recognition. By providing protection only for famous marks, courts can reasonably infer that the infringer had heard of the mark. Thus, initially, dilution protected only the most famous of celebrities, like Madonna or Michael Jordan.⁷⁸ However, as in section 43(a) cases, celebrity rights are creeping into the realm of once protected areas, and litigation under the FTDA is expanding to less famous people.⁷⁹ Federal dilution law does not preempt state dilution statutes; therefore, a local celebrity might not qualify as a famous mark under the FTDA but may still have a remedy at state law.⁸⁰

Dilution takes two forms: blurring and tarnishment. Blurring occurs when another party's unauthorized use of a trademark weakens the mark's distinctive ability to identify and distinguish its source.⁸¹ A

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- (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
 - (C) the duration and extent of advertising and publicity of the mark;
 - (D) the geographical extent of the trading area in which the mark is used;
 - (E) the channels of trade for the goods or services with which the mark is used;
 - (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;
 - (G) the nature and extent of use of the same or similar marks by third parties; and
 - (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c)(1).

78. See Steven M. Cordero, Note, *Cocaine-Cola, the Velvet Elvis, and Anti-Barbie: Defending the Trademark and Publicity Rights to Cultural Icons*, 8 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 599, 644-45 (1998) (suggesting that dilution requires "tertiary meaning," or symbolic meaning beyond descriptive attributes and secondary meaning, achievable only by cultural icons such as Barbie and Coca-Cola).

79. See Lemley, *supra* note 15, at 1698-99 (discussing "doctrinal creep" and expansion of FTDA's application). In addition to the FTDA broadening protection for less famous celebrities, some states recognize the concept of niche fame, thereby further broadening the dilution claim's scope. See, e.g., *Interstellar Starship Servs. v. Epix, Inc.*, 125 F. Supp. 2d 1269, 1281 (D. Or. 2001), *aff'd*, 304 F.3d 936 (9th Cir. 2002). Niche fame means either that the trademark qualifies as famous only in a specific geographic area, or that it is only famous within a particular industry. See *id.* (state dilution law applies to marks famous within Oregon).

80. H.R. REP. NO. 104-374, at 4 (1995) ("It is important to note that [the federal dilution statute] would not pre-empt existing state dilution statutes. State laws could continue to be applied in cases involving locally famous or distinctive marks.") (footnote omitted). However, federal trademark registration, as opposed to claimed use, acts as a complete bar to state trademark dilution claims. *Id.* at 5.

81. *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 306 n.30 (D.N.J. 1998) (citing *Panavision Int'l L.P. v. Toeppen*, 945 F. Supp. 1296, 1304 (C.D. Cal. 1996)), *aff'd without opinion*, 159 F.3d 1351 (3d Cir. 1998); see also 4 MCCARTHY, TRADEMARKS,

trademark is tarnished when a secondary use creates negative associations in consumer's minds.⁸² Examples of tarnishment include association with products of poor or cheap quality or unsavory subject matter, such as pornography.⁸³

Dilution applies whether or not the trademark users compete and regardless of the likelihood of confusion.⁸⁴ Thus, dilution shifts trademark protection's focus to the trademark holder's injury. As Judge Kozinski stated in *Mattel*, "[b]y contrast to trademark infringement, the injury from dilution usually occurs when consumers *aren't* confused about the source of a product."⁸⁵ Thus, uses that would not constitute infringement could be dilution. The three tests used to balance section 43(a) claims and First Amendment rights are therefore inadequate to address dilution claims because of the claims' opposite foci. Judge Kozinski noted that because dilution does not require a showing of consumer confusion, it "lacks the built-in First Amendment compass" of traditional trademark actions.⁸⁶

Dilution applies only to uses in commerce. In *Mattel*, the court found that the "noncommercial use exception" from the FTDA applies to any speech that is not purely commercial. The court determined that the song "Barbie Girl" was not purely commercial in nature, and thus was

supra note 29, § 24.94, at 24-192.

82. *Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497, 507 (2d Cir. 1996) (describing tarnishment under the New York dilution statute by stating, "[t]he sine qua non of tarnishment is a finding that plaintiff's mark will suffer negative associations through defendant's use").

83. *See, e.g., Kraft Foods Holdings, Inc. v. Helm*, 205 F. Supp. 2d 942, 949-50 (N.D. Ill. 2002) (finding adult website operator's use of "King VelVeeda" likely tarnished Kraft's "Velveeta" registered trademark), *modified*, 2002 U.S. Dist. LEXIS 21317 (N.D. Ill. 2002); *Eastman Kodak Co. v. Rakow*, 739 F. Supp. 116, 118 (W.D.N.Y. 1989) (comedian's use of stage name "Kodak" tarnished Eastman Kodak's trademark because it "unquestionably brings to mind" the trademark, and associated it with a comic act that made references to sex and bodily functions, and used crude, off-color language repeatedly).

84. H.R. REP. NO. 104-374, at 3 (providing "Dupont shoes, Buick aspirin, and Kodak pianos" as actionable examples of dilution).

85. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 903 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003). The Federal Trademark Dilution Act (FTDA) House of Representatives report quotes the following explanation of differences between traditional infringement and dilution:

Dilution is an injury that differs materially from that arising out of the orthodox confusion. Even in the absence of confusion, the potency of a mark may be debilitated by another's use. This is the essence of dilution. Confusion leads to immediate injury, while dilution is an infection, which if allowed to spread, will inevitably destroy the advertising value of the mark.

H.R. REP. NO. 104-374, at 3 (quoting *Mortellito v. Nina of Cal., Inc.*, 335 F. Supp. 1288, 1296 (S.D.N.Y. 1972)).

86. *Mattel*, 296 F.3d at 905.

fully protected from FTDA claims.⁸⁷ This is particularly important in the entertainment industry. If dilution applied to commercial music and movies, an explosion of litigation could occur, contesting uses of famous product names in song lyrics, films, or titles. Since consumer confusion isn't required, a claim would lie in any artistic work using the trademark—a dangerous situation for any artist.⁸⁸

3. Anticybersquatting Consumer Protection Act

The second Lanham Act amendment broadening celebrity protection is the Anticybersquatting Consumer Protection Act (ACPA). The ACPA prohibits the registration of an internet domain name that is identical, confusingly similar, or dilutive of a trademark with bad faith intent.⁸⁹ Congress approved this amendment in order to prevent cybersquatting—the practice of registering domain names containing trademarks, then profiting from selling these domain names to the trademark holders.⁹⁰ Celebrities such as Julia Roberts,⁹¹ Madonna,⁹² and others regained domain names containing their names in suits against alleged cybersquatters.⁹³ Like dilution claims, these rights derive from

87. *Id.* at 906–07.

88. This is not to say that celebrities are cut off from FTDA claims in many, if not most, situations where a name or image has been used. The key question for the court will be whether the use is “purely commercial.” *Cf.* Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 807–11 (Cal. 2001) (using transformative use test in copyright case to determine whether use had sufficient artistic elements to be separable from celebrity image used on t-shirt), *cert. denied*, 534 U.S. 1078 (2002).

89. 15 U.S.C. § 1125(d) (2000).

90. For a discussion of issues relating to the Federal Trademark Dilution Act and the Anticybersquatting Consumer Protection Act, see David H. Bernstein et al., *Trademark and Unfair Competition Issues*, 614 PATENTS, COPYRIGHTS, TRADEMARKS, AND LITERARY PROP. COURSE HANDBOOK 203, 247–85 (2000), available at WL 614 PLI/Pat 203; see also Jeffrey J. Look, *Law and Order on the Wild, Wild West (WWW)*, 24 U. ARK. LITTLE ROCK L. REV. 817, 825–28 (2002) (discussing varying results in celebrity litigation over domains registered by cybersquatters).

91. *Roberts v. Boyd*, No. D2000-0210 (World Intellectual Prop. Org. May 29, 2000), available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0210.html> (last visited Nov. 26, 2004).

92. *Cicccone v. Parisi*, No. D2000-0847 (World Intellectual Prop. Org. Oct. 12, 2000), available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0847.html> (last visited Nov. 26, 2004).

93. *But see* *Sumner v. Urvan*, No. D2000-0596, para. 6.1–.6 (World Intellectual Prop. Org. July 24, 2000), available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0596.html> (last visited Nov. 26, 2004) (complaint by entertainer Sting denied against registrant of sting.com, noting that Sting did not register his name as a trademark, the word sting is commonly used in the English language, and that the dispute

an individual's property interest in a name. Claims do not require a showing of consumer confusion as to the individual's involvement in the website.⁹⁴

B. Celebrity False Endorsement Lanham Act Claims

Section 43(a) protects unregistered trademarks.⁹⁵ Since the mid-1980s, courts have increasingly recognized celebrities' claims under the Lanham Act as unregistered trademarks protected by section 43(a).⁹⁶ While some commentators see this expansion as an out of control overapplication, courts continue to recognize these claims.⁹⁷

1. Unauthorized Use of Name

A name not registered as a trademark must have secondary meaning for Lanham Act protection because names are not inherently distinctive.⁹⁸ Some courts, however, seem to substitute celebrity status

resolution system was not designed to protect "personality rights" apart from trademarked words). This case shows the limits of international internet law. Query whether Sting would be protected under a state right of publicity statute, which would likely protect Sting's persona in addition to his name. *Cf., e.g., White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1398-99 (9th Cir. 1992) (protecting Vanna White's "identity" under California common law right of publicity), *amended by* 1992 U.S. App. LEXIS 19253 (9th Cir. 1992).

94. See 15 U.S.C. § 1125(c)-(d) (2000) (showing neither section adopts the section 43(a) likelihood of confusion standard for infringement).

95. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

96. *Parks v. LaFace Records*, 329 F.3d 437, 447 (6th Cir. 2003) (discussing Rosa Parks's standing to sue under section 43(a) because celebrities hold a property interest in their identities akin to commercial trademark holder), *cert. denied*, 124 S. Ct. 925 (2003); see also 2 MCCARTHY, TRADEMARKS, *supra* note 29, § 13:2 & nn.1-2, at 13-3 to 13-4 (Supp. 2002) (explaining that names are descriptive marks, protectable only upon acquiring secondary meaning through long association of a name with a business, at which point the name and business become synonymous in the public mind).

97. See 4 MCCARTHY, TRADEMARKS, *supra* note 29, § 27:14 n.5, at 27-27.

98. Relatedly, a name cannot be registered as a trademark, and thereby be protected under section 32(1), if it is "primarily merely a surname." 15 U.S.C. § 1052(e)(4) (2000).

McCarthy offers two rationales for the secondary meaning requirement under section 43(a). First, names are analogous to descriptive marks. They are not inherently distinctive because "[t]he known multiplicity of similar personal names may make consumers hesitant to assume a common source for products bearing a particular name." 2 MCCARTHY, TRADEMARKS, *supra* note 29, § 13:3 n.1, at 13-6.1 (2004). Like descriptive marks, names must acquire secondary meaning through commercial use in order to be protected. Second, sellers should not be prevented from honestly describing their products. Because names can describe a product's source, this attribution should be allowed to designate that source when used truthfully. *Id.* at § 13:3, at 13-6.1 to 13-6.2; see also *Ferguson v. Maita*, 162 F. Supp. 2d 433, 440 (W.D.N.C. 2000) (citing McCarthy and requiring secondary meaning for section 43(a) protection for law firm's name containing personal name); *Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 125 (4th

for the secondary meaning requirement.⁹⁹ Courts view the celebrity's name as a property interest bestowed upon the celebrity as a result of the individual's fame.¹⁰⁰ In these cases, courts ask whether or not the plaintiff is a celebrity, not whether consumer confusion exists. This property-based formulation of trademark rights shifts the focus of whether a name is protected from rights earned through use of the mark to an inherent right given to a famous individual.¹⁰¹ This approach is more akin to right of publicity cases, where the underlying tension between property rights in one's persona and the First Amendment is pronounced.

2. *Unauthorized Use of Image and Relation to Copyright*

Celebrities' images are typically covered by the Copyright Act and right of publicity. The basic idea of copyright is conceptually opposite to trademark. A copyright protects a tangible creation for its expression of ideas. Trademark protects something existing in the world for its user, whose use associates that thing with him.¹⁰² Although names cannot be copyrighted, tangible representations of celebrities' images are often copyrighted.¹⁰³ For example, a photograph of a celebrity could be

Cir. 1990) (requiring secondary meaning for personal name protection under federal and Maryland trademark laws).

99. See, e.g., *Parks*, 329 F.3d at 447 (recognizing Rosa Parks's property right in her name because she is a celebrity, thereby constituting a valid trademark protected by section 43(a)); *Vanderbilt v. Rolls-Royce Motor Cars, Inc.*, No. 88 CIV. 8263 (SWK), 1990 U.S. Dist. LEXIS 3342, at *1-4 (S.D.N.Y. Mar. 28, 1990) (finding representation of Alfred Vanderbilt II in Rolls-Royce commercial falsely implying his endorsement of the car actionable under Lanham Act without showing of secondary meaning based on celebrities' commercial investments in their names for product endorsements and building a career); *Condit v. Star Editorial, Inc.*, 259 F. Supp. 2d 1046, 1054 (E.D. Cal. 2003) (stating that the Lanham Act only applies to individual's identities that function akin to a trademark).

100. "[C]ourts routinely recognize a property right in celebrity identity akin to that of a trademark holder under § 43(a)." *Parks*, 329 F.3d at 447 (citing *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000)); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992) (recognizing singer Tom Waits's interest in his voice, as a "purported endorser" of Frito-Lay products as akin to a trademark holder's economic interest), *amended by* 1992 U.S. App. LEXIS 27031 (9th Cir. 1992); *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 624-25 (S.D.N.Y. 1985) (holding the same regarding Woody Allen's commercial interest in building his name's drawing power).

101. Lemley views granting celebrities such expansive property rights as destructive to free speech because it permits them to curtail speech they do not like and want to suppress, or collect money for it. Lemley, *supra* note 15, at 1713.

102. Keren Levy, Note, *Trademark Parody: A Conflict Between Constitutional and Intellectual Property Interests*, 69 GEO. WASH. L. REV. 425, 428-29 (2001).

103. *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003-04 (9th Cir. 2001)

copyrighted. A photographer would typically own the rights to his photograph regardless of what is in it. Selling the photograph to a publication would transfer those rights in the photograph. Typical copyright issues related to celebrities include suits over use of film clips,¹⁰⁴ graphic artwork,¹⁰⁵ and musical compositions.¹⁰⁶ Courts are reluctant to extend trademark protection to copyrightable materials in an effort to prevent circumvention of the limited nature of copyrights.¹⁰⁷

Right of publicity, discussed later in this Comment, protects the celebrity's ability to exclusively control his name, image, likeness and (sometimes) voice, and prevent others from imitating or copying them to endorse products. Right of publicity claims involving images often apply copyright concepts.¹⁰⁸ Conceptually, this makes sense. Right of publicity protects the physical manifestation of a copyrightable photograph.¹⁰⁹ For example, in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, the California Supreme Court considered whether a reproduction of The Three Stooges' likenesses on t-shirts constituted commercial or artistic

(citing MELVILLE B. NIMMER & DAVID NIMMER, 1 NIMMER ON COPYRIGHT § 1.01[B][1][c], at 1-23 to 1-24 (2004)) (stating that names and images are part of a persona protected by the right of publicity, whose protection is not preempted by the Copyright Act because the persona, unlike a photograph of a person, is not copyrightable); *see also* *Brown v. Ames*, 201 F.3d 654, 661 (5th Cir. 2000) (holding that Texas tort of misappropriation protecting name, image, or likeness was not preempted by Copyright Act because Congressional reports showed desire to keep state privacy and publicity laws intact).

104. *See* *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593 (9th Cir. 2000), *amended by* 2000 U.S. App. LEXIS 1421 (9th Cir. 2000). The owner of intellectual property rights in the Three Stooges filed this action against New Line Cinema for use of a Three Stooges clip in the film, *The Long Kiss Goodnight*. *Id.* at 594. Comedy III Productions argued that the clip was "particularly distinctive" of the Three Stooges' style of comedy, and thus the clip constituted a trademark. The court rejected this attempt to classify the cause of action as trademark infringement, seeing it as an attempt to circumvent copyright law by use of the Lanham Act. *Id.* at 595. The court found that a copyright claim would have failed if it had been brought since the film's copyright had expired and it had entered the public domain. *Id.*

105. *See* 17 U.S.C. § 102(a)(5) (2000).

106. *See* 17 U.S.C. § 102(a)(2). The history of musical compositions as copyright is as old as copyright law itself. For an interesting summary of copyright cases based on musical composition, see *Columbia Law Library Musical Copyright Infringement Archive*, at http://library.law.columbia.edu/music_plagiarism/index2.html (2002).

107. *See supra* note 104. *But see* *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 61–62 (2d Cir. 2001) (explaining that some works, including graphic designs and musical compositions, can identify goods as trademarks even though they are clearly protected by copyright law).

108. *See* LINDEY & LANDAU, *supra* note 22, § 1.118, at 1-432 (noting that the traditional copyright analysis covering transformative uses is "creeping" into right of publicity cases).

109. The *Comedy III* court notes that, at least theoretically, the right of publicity and copyright law share a common goal of "protecting the creative fruits of intellectual and artistic labor." *Comedy III Prods., Inc., v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001), *cert. denied*, 534 U.S. 1078 (2002).

speech in a state statutory right of publicity claim.¹¹⁰ The court used some aspects of copyright analysis to determine whether an artist's creation could be protected on its own—apart from the Three Stooges' images. While warning against the wholesale importation of the fair use doctrine of copyright law into the right of publicity, the court found the “transformative use” test typical in copyright claims to be relevant to its analysis.¹¹¹ The court applied this concept to devise a “significant transformative element” test for the right of publicity. This requires the artist to go beyond “literal depiction or imitation of a celebrity for commercial gain,” and add significant transformative elements to the work in order to claim First Amendment protection.¹¹² These elements could include parody, factual reporting, or fictionalized portrayal, and range from “heavy-handed lampooning” to “subtle social criticism.”¹¹³ This leading case demonstrates the influence of copyright principles on other related celebrity claims.¹¹⁴

As a general rule, a person's image cannot function as a trademark.¹¹⁵ However, when a specific image of an individual is consistently used to identify goods or services, it functions as a trademark and can be protected as such.¹¹⁶ In *ETW Corp. v. Jireh Publishing, Inc.*, golfer Tiger Woods's exclusive marketing firm, ETW Corporation, filed Lanham Act and right of publicity claims against an artist who sold limited edition lithographs of Woods winning the Masters golf tournament. ETW claimed that Woods's likeness is protected as a

110. *Id.* at 800–01.

111. *Id.* at 808.

112. *Id.*

113. *Id.* at 809. The court cites the *Parks* District Court decision as an example of “fictionalized portrayal”—a characterization with which the *Parks* Court of Appeals decision apparently did not agree. *Id.* A fictionalized portrayal would certainly have artistic relevance under *Rogers*, while the Court of Appeals did not find such relevance. *Parks v. LaFace Records*, 329 F.3d 437, 452–56 (6th Cir. 2003), *cert. denied*, 124 S. Ct. 925 (2003).

114. *See also* *Winter v. DC Comics*, 69 P.3d 473, 479 (Cal. 2003) (applying *Comedy III* transformative use test to find permissible use of musicians Johnny and Edgar Winter in “Jonah Hex” comic book). *But see* *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (declining to apply *Comedy III* when professional hockey player Tony Twist filed right of publicity claim against *Spawn* comic book creator when a villain in the book shared Twist's name because the test fails to protect from exploitive uses if expressive, transformative components exist in the work), *cert. denied*, *McFarlane v. Twist*, 124 S. Ct. 1058 (2004).

115. *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 922 (6th Cir. 2003), *reh'g denied*, 2003 U.S. App. LEXIS 19044 (6th Cir. 2003).

116. *Id.* at 923 (citing *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 583 (2d Cir. 1990)).

trademark. The court disagreed. Woods's status as one of the most photographed sports figures of his generation did not entitle him to a "sweeping claim to trademark rights in every photograph and image" of him.¹¹⁷ The court reasoned that no reasonable consumer would believe that every picture of Woods originated with him.¹¹⁸ He is not "a walking, talking trademark."¹¹⁹ Therefore, his image cannot be protected as a trademark unless a particular image serves the trademark function of source designation or endorsement.¹²⁰

3. *Propertization of Trademark Results in Need to Define "Celebrity"*

Under the property conception of trademark discussed above, a plaintiff claiming to be a celebrity for the purposes of trademark infringement must have been a celebrity at the time of infringement in order to have standing.¹²¹ The Lanham Act protects against economic injury, so plaintiffs must have an economic interest in their names at the time of infringement for it to be actionable. Potential for commercial interest at a later time is insufficient.¹²²

Trademark protection of a famous name may not end even with the celebrity's nonuse of this name for extended periods of time. For example, basketball Hall of Famer Kareem Abdul-Jabbar filed a Lanham Act claim against General Motors for using his long unused birth name, Lew Alcindor, as the answer to a trivia question in an Oldsmobile commercial.¹²³ Typically, a trademark can be abandoned by lack of use in interstate commerce.¹²⁴ According to the Ninth Circuit, however, names cannot be abandoned in the same manner as standard commercial trademarks.¹²⁵ The court recognized a birth name as an integral part of one's identity, neither bestowed upon him for commercial purposes, nor

117. *ETW Corp.*, 332 F.3d at 923; *see also Pirone*, 894 F.2d at 583 (trademark holder of words "Babe Ruth" not entitled to enjoin use of Babe Ruth photographs unless photographs indicate source or origin); *Estate of Presley v. Russen*, 513 F. Supp 1339, 1364 (D.N.J. 1981) (stating that estate of Elvis Presley could not enjoin all uses of photographs, image, or likeness under Lanham Act unless it designated origin).

118. *ETW Corp.*, 332 F.3d at 922.

119. *Id.*

120. *Id.*

121. *Condit v. Star Editorial, Inc.*, 259 F. Supp. 2d 1046, 1048, 1051 (E.D. Cal. 2003) (stating that Carolyn Condit lacked standing for false association claim against Star tabloid for its article "Condit's Wife's Agony," explicitly representing it as "her own story," because she was not a celebrity and did not have an economic interest in her identity).

122. *Id.* at 1051.

123. *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407, 409 (9th Cir. 1996).

124. 2 MCCARTHY, TRADEMARKS, *supra* note 29, § 17:9, at 17-11 (2004).

125. *Abdul-Jabbar*, 85 F.3d at 412. This appears to be the only section 43(a) case addressing the potential of name abandonment as a defense.

kept alive by commercial use.¹²⁶ While the court did not determine whether General Motors' use of Abdul-Jabbar's name in the commercial constituted endorsement, it held that General Motors could not assert abandonment as a defense.¹²⁷ Again, finding a special property attribute in names acknowledges the different treatment given celebrity names.

If a one-time celebrity is no longer famous, is the property right these courts find to be vested in his name also lost? Courts have not addressed whether the property interest endowed in a celebrity can be lost when the individual is no longer a celebrity. This situation is distinguishable from *Abdul-Jabbar*, where the individual remained a celebrity, but did so under a different name.

Many celebrities' most valuable asset is their name, image, or other distinctive attribute.¹²⁸ Especially after a celebrity stops performing, endorsements or other engagements become a primary income source.¹²⁹ As a result, retaining celebrity status for the purposes of trademark protection can become a crucial determination for a one-time celebrity. Marginal celebrities' ability to retain this property right is important to retaining their endorsement value in the future.

For example, consider the song "Bette Davis Eyes" (referred to as a permissible use of Bette Davis's name in *Rogers*)¹³⁰ and its singer, Kim Carnes. "Bette Davis Eyes" won Carnes a Grammy in 1981.¹³¹ Following this success, she produced several minor hits, recording her final Billboard Top 20 hit in 1985.¹³² A song entitled "Kim Carnes" at the height of her popularity would certainly implicate the Lanham Act because the public would likely associate her with the song. Assuming Carnes's property interest is vested in her and does not require use, as characterized by the *Abdul-Jabbar* court, Carnes's protection would be the same in 2004, or 2054, because her property right in her name could not be abandoned. If she endorsed products in the meantime, those endorsements would constitute a use in commerce, keeping her rights alive regardless of what conception of her right is used.

What if Carnes is no longer a celebrity? Between 1991 and 2004,

126. *Id.* at 411.

127. *Id.*

128. Frankel, *supra* note 5, at 9.

129. *Id.*

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

131. Eric Gelman et al., *Rocking Video*, NEWSWEEK, Apr. 18, 1983, at 96.

132. Steve Huey, *Kim Carnes*, ARTISTDIRECT.COM, at <http://www.artistdirect.com/nad/music/artist/bio/0,,412166,00.html#bio> (last visited Nov. 29, 2004).

Carnes did not release any new albums.¹³³ A court disagreeing with *Abdul-Jabbar* and holding to traditional trademark formulations of abandonment could find that a thirteen-year lapse in using a name commercially to identify any new product could result in abandonment of trademark rights in her name. Stated differently, the court would remove her celebrity status, thus revoking the property interest the *Abdul-Jabbar* court would have found to be endowed in her name. Carnes would then be required to establish secondary meaning in her name. Without use in trade for thirteen years except to identify her earlier albums, she would not likely be able to establish secondary meaning. As a result, and without the property right some courts attribute to celebrities' names, Carnes's name would no longer have Lanham Act protection.¹³⁴

C. First Amendment Defense

The level of First Amendment protection a use receives depends on the type of speech containing the mark. Commercial speech, such as advertising, receives some protection under the *Central Hudson* test. Artistic speech is fully protected. Commercial music and movies present more difficult analyses.

1. Attributes of Pure Commercial Speech

In cases of pure commercial speech, section 43(a) protects celebrities from use of their names in a manner that would falsely imply their endorsement of a product. "[T]he 'core notion of commercial speech' is that it 'does no more than propose a commercial transaction.'"¹³⁵

133. Steve Huey, *Kim Carnes*, ARTISTDIRECT.COM, at <http://www.artistdirect.com/nad/music/artist/card/more/0,,412166-1,00.html> (last visited Nov. 29, 2004).

134. Note that this is not really a problem after all. If Carnes is using her name for endorsements, she would retain protection by using it in commerce. If she isn't, and so much time passes that no one will know that she's famous, then she's not really losing anything of value anyway. That is, who would hire an endorser that no one will recognize? (Until she appears on *The Surreal Life*, thus magically resurrecting her celebrity status. See discussion *supra* note 2.)

135. *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184 (9th Cir. 2001) (quoting *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66 (1983)). In *Hoffman*, Los Angeles Magazine published a digitally altered photograph of actor Dustin Hoffman from the film "Tootsie," dressed in designer women's clothing for its "Fabulous Hollywood Issue!" *Id.* at 1183. The court found that the photograph was entitled to full First Amendment protection because it was not pure commercial speech. *Id.* at 1184–86. Alternatively, the court found that it would be protected under *Comedy III's* right of publicity "significant transformative element" test for artistic speech. *Id.* at 1184 n.2.

The definition of commercial speech has fluctuated. In *Central Hudson*, the Supreme Court broadened the commercial speech definition to include "expression related solely to the economic interests of the speaker and its audience." *Cent. Hudson Gas & Elec.*

Advertising is the classic example of commercial speech. However, speech does not lose its protection simply because the speaker spends money on it.¹³⁶ Commercial speech is subject to diminished First Amendment protection under *Central Hudson*. Under *Central Hudson*, commercial speech cannot be restricted unless a four-part test is met: (1) The speech must concern lawful activity that is neither false nor misleading; (2) the asserted government interest must be substantial; (3) the restriction must directly advance the substantial government interest; and (4) the restriction must not be more extensive than necessary to advance that interest.¹³⁷

2. Attributes of Pure Artistic Speech

Artistic speech receives full protection under the First Amendment. The First Amendment “looks beyond written or spoken words as mediums of expression,”¹³⁸ and protects music,¹³⁹ visual art,¹⁴⁰ pictures, films, and drawings.¹⁴¹ These expressions are protected even if they do

Corp. v. Pub. Serv. Comm’n, 447 U.S. 557, 561 (1980) (citing *Friedman v. Rogers*, 440 U.S. 1, 11 (1979); *Bates v. State Bar*, 433 U.S. 350, 363–64 (1977); *Va. State Bd. of Pharmacy v. Va. Citizen’s Consumer Council, Inc.*, 425 U.S. 748, 762 (1976)). In *Bolger*, the Court reverted to asking whether the speech proposed a commercial transaction to determine whether it was commercial. *Bolger*, 463 U.S. at 66 (citing *Va. State Bd. of Pharmacy*, 425 U.S. at 762 (quoting *Pittsburgh Press Co. v. Human Relations Comm’n on Human Relations*, 413 U.S. 376, 385 (1973))). In *Board of Trustees of the State University of New York v. Fox*, the Court announced that the proposal of a commercial transaction was “the test for identifying commercial speech.” *Bd. of Trs. of the State Univ. of N.Y. v. Fox*, 492 U.S. 469, 473–74 (1989) (emphasis added); see *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 422–24 (1993) (explaining the development of commercial speech protection).

136. *Va. State Bd. of Pharmacy*, 425 U.S. at 761 (citing *Buckley v. Valeo*, 424 U.S. 1, 35–59 (1976); *Pittsburgh Press Co.*, 413 U.S. at 384; *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 266 (1964)).

137. *Cent. Hudson Gas & Elec. Corp.*, 447 U.S. at 566. For a discussion of the interplay between the right of publicity and commercial speech, see Waller, *supra* note 8, at 59 (suggesting that the *Central Hudson* analysis is the proper current test to balance commercial speech and the right of publicity).

138. *Hurley v. Irish-Am. Gay, Lesbian, & Bisexual Group of Boston, Inc.*, 515 U.S. 557, 569 (1995) (allowing parade organizers to choose messages displayed in their parade as a protection of their First Amendment rights).

139. *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989) (stating that City’s right to regulate performers at public forum based on noise restrictions was subject to First Amendment protection for performers).

140. *Bery v. City of New York*, 97 F.3d 689, 695 (2d Cir. 1996) (finding New York City regulations strictly limiting sale of visual art violative of First Amendment), *aff’d without opinion*, 216 F.3d 1072 (2d Cir. 2000).

141. *Kaplan v. California*, 413 U.S. 115, 119–20 (1973); see also *ETW Corp. v.*

not have a “narrow, succinctly articulable” message.¹⁴² Selling expressive materials does not diminish their First Amendment protection.¹⁴³ The problem in most of these cases is that celebrities’ names or images are used in works generally considered to be artistic, such as songs or movies, and used commercially.¹⁴⁴

3. *Popular Music and Movies Combine Commercial and Artistic Elements*

Movie titles present a clear example of judicial trouble classifying types of speech for purposes of First Amendment protection. *Rogers* created a hybrid category of speech relating only to using celebrity names in creative works.¹⁴⁵ In *Rogers*, the court considered whether a filmmaker’s use of the title “Ginger and Fred” violated the Lanham Act by creating the false impression that Ginger Rogers endorsed the film.¹⁴⁶ Recognizing the difficulty in distinguishing artistic and commercial speech in celebrity cases, the *Rogers* court determined that titles and the artistic works they identify are of a “hybrid nature.”¹⁴⁷ “Movies, plays, books, and songs are all indisputably works of artistic expression and deserve protection. Nonetheless, they are also sold in the commercial marketplace like other more utilitarian products, making the danger of consumer deception a legitimate concern”¹⁴⁸ The court acknowledged *Central Hudson’s* restrictions on regulation of commercial speech. Noting the similarity between titles and ordinary commercial goods, the court stated: “The purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product.”¹⁴⁹ However, the title of an artistic work does not identify its source in the same manner as a can of peas. The commercial and artistic elements of a title and a work are “inextricably intertwined,” so a title can permissibly have artistic significance and be fashioned in such a way as

Jireh Publ’g, Inc., 332 F.3d 915, 924–25 (6th Cir. 2003) (discussing First Amendment protection for lithograph of Tiger Woods).

142. *Hurley*, 515 U.S. at 569 (noting that such a requirement would not protect the “unquestionably shielded painting of Jackson Pollock, music of Arnold Schoenberg, or Jabberwocky verse of Lewis Carroll”).

143. *ETW Corp.*, 332 F.3d at 925 (citing *City of Lakewood v. Plain Dealer Publ’g Co.*, 486 U.S. 750, 756 n.5 (1988)).

144. *See, e.g.*, *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989) (recognizing the interplay between commercial and artistic elements of speech in these cases).

145. *Id.* at 999. The Second Circuit later expanded *Rogers* to apply in any case of artistic expression clashing with the Lanham Act, including parody. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc.*, 886 F.2d 490, 495 (2d Cir. 1989).

146. *Rogers*, 875 F.2d at 997.

147. *Id.* at 998.

148. *Id.* at 997.

149. *Id.* at 997–98.

to sell more copies.¹⁵⁰

At least one court treated a movie title as commercial speech when the injunction sought related only to the film's title, not its content. In *American Dairy Queen Corp. v. New Line Productions, Inc.*,¹⁵¹ a Minnesota District Court considered whether New Line's film "Dairy Queens" infringed on American Dairy Queen's trademarked name. The court distinguished *Rogers* by finding that because the New Line film's content lacked an artistic connection with the famous name "Dairy Queen," the title itself constituted commercial speech.¹⁵²

4. Blurry Restrictions Defeat First Amendment Purposes

The two distinct, commonly acknowledged purposes of the First Amendment are: (1) "[T]o preserve an uninhibited marketplace of ideas' and to repel efforts to limit the 'uninhibited, robust and wide-open' debate on public issues"; and (2) "[T]o foster a fundamental respect for individual development and self-realization."¹⁵³ This individual realization must be free from government restraint regardless of the nature or manner of the views, "unless there is a compelling reason to the contrary."¹⁵⁴

Inconsistent tests balancing the Lanham Act and First Amendment rights, and inconsistent application of those tests, result in defeating the purposes of the First Amendment. The uninhibited marketplace of ideas and potential for individual expression are greatly restricted by the prospective effects of inconsistent litigation.¹⁵⁵ Artists are unlikely to

150. *Id.* at 998.

151. 35 F. Supp. 2d 727 (D. Minn. 1998).

152. *Am. Dairy Queen Corp.*, 35 F. Supp. 2d at 734–35.

153. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 803 (Cal. 2001) (quoting in part *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 458 (Cal. 1979)), *cert. denied*, 534 U.S. 1078 (2002). *Guglielmi* based its reasoning on *Red Lion Broadcasting Co. v. FCC*, 395 U.S. 367, 390 (1969), and *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 340 (1974). *Guglielmi*, 603 P.2d at 458 (discussing free speech rights as "essential in a democratic system of government").

154. *Comedy III Prods., Inc.*, 21 P.3d at 803 (quoting *Guglielmi*, 603 P.2d at 458).

155. *See Comedy III Prods., Inc.*, 21 P.3d at 803 (discussing the potential for the right of publicity to limit important elements of speech); *see also* Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125 (1993). Madow discusses the importance of speech about celebrities:

[I]ndividuals and groups also use star signs in their everyday lives to communicate *meanings of their own making*. They make active and creative use of celebrity images to construct themselves and their social relations, to identify themselves as individuals and as members of subcultural groups, and to express and communicate their sense of themselves and their particular

use celebrity names in their work for fear of litigation. Celebrities are an integral part of American culture, whether they are heroes, rock stars, or just the next big thing.¹⁵⁶ Courts recognize First Amendment protection for popular culture commentary irrespective of the content of the ideas expressed. A free marketplace of ideas requires clear restrictions on celebrity name usage. The Lanham Act's limitations on expression are valid so long as the uncertainty surrounding its application does not push that protection beyond its legal limits.

V. BALANCING PROBLEMS

A. Tests Balancing Section 43(a) and the First Amendment

1. Likelihood of Confusion

In typical trademark cases, courts apply the likelihood of confusion test to determine infringement.¹⁵⁷ The primary question under this test is

experience of the world. Indeed, celebrity images are among the basic semiotic and symbolic raw materials out of which individuals and groups “establish their presence, identity and meaning.”

Id. at 143 (citing PAUL WILLIS ET AL., COMMON CULTURE: SYMBOLIC WORK AT PLAY IN THE EVERYDAY CULTURES OF THE YOUNG 1 (1990)).

156. “Celebrities . . . are an important element of the shared communicative resources of our cultural domain.” *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 972 (10th Cir. 1996), *aff’d*, 335 F.3d 1161 (10th Cir. 2003); *see* *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 933 (6th Cir. 2003) (applying *Cardtoons* to recognize the First Amendment importance of artist’s ability to create and sell prints of a Tiger Woods painting); *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1513 n.6 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc) (“Trademarks are often reflected in the mirror of our popular culture.”); *see also* *Petition for a Writ of Certiorari at 9, LaFace Records v. Parks*, 124 S. Ct. 925 (2003) (No. 03-504), *available at* 2003 WL 23145528.

157. *See* *Frisch’s Rests., Inc. v. Elby’s Big Boy of Steubenville, Inc.*, 670 F.2d 642, 648 (6th Cir. 1982) (adopting likelihood of confusion test from *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979)), *aff’d*, 849 F.2d 1012 (6th Cir. 1988); *see also* *Parks v. LaFace Records*, 329 F.3d 437, 447–48 (6th Cir. 2003) (explaining application of the test), *cert. denied*, 124 S. Ct. 925 (2003).

The Ninth Circuit restated the likelihood of confusion factors as they apply to celebrity cases. As restated by the court, these factors are:

1. [T]he level of recognition that the plaintiff has among the segment of the society for whom the defendant’s product is intended;
2. the relatedness of the fame or success of the plaintiff to the defendant’s product;
3. the similarity of the likeness used by the defendant to the actual plaintiff;
4. evidence of actual confusion;
5. marketing channels used;
6. likely degree of purchaser care;
7. defendant’s intent on selecting the plaintiff; and
8. likelihood of expansion of the product lines.

Downing v. Abercrombie & Fitch, 265 F.3d 994, 1002, 1007–09 (9th Cir. 2001) (finding genuine issue of material fact as to surfers’ endorsement of clothing catalog when catalog used surfers’ names and images without their consent “essentially as window-

whether consumers would likely be confused as to the product's source.¹⁵⁸ The likelihood of confusion factors vary by jurisdiction, but usually include: strength of the plaintiff's mark,¹⁵⁹ relatedness of the goods,¹⁶⁰ similarity of the marks,¹⁶¹ evidence of actual confusion,¹⁶²

dressing to advance the catalog's surf-theme"). The overtly commercial nature of the defendant's speech distinguishes it from cases of hybrid artistic and commercial expression discussed in this Comment. *See* Carafano v. Metrosplash.com, Inc., 207 F. Supp. 2d 1055, 1075 (C.D. Cal. 2002), *aff'd*, 339 F.3d 1119 (9th Cir. 2003).

158. *See* 15 U.S.C. § 1125(a)(1)(A) (2000) (premising liability on use in commerce "likely to cause confusion").

159. Strength of plaintiff's mark is a two-part analysis, weighing the mark's inherent distinctiveness and the degree of distinctiveness in the marketplace. *Nabisco v. Warner-Lambert Co.*, 32 F. Supp. 2d 690, 697 (S.D.N.Y. 1999) (citing *W.W.W. Pharm. Co. v. Gillette Co.*, 984 F.2d 567, 572 (2d Cir. 1993) (quoting *Lang v. Ret. Living Publ'g Co.*, 949 F.2d 576, 581 (2d Cir. 1991)), *aff'd*, 220 F.3d 43 (2d Cir. 2000)). Inherent distinctiveness is determined through classifying the mark as generic, descriptive, suggestive, arbitrary, or fanciful. Distinctiveness in the marketplace is determined by many factors, including "evidence of money spent on product (*i.e.*, advertising and marketing expenditures), success in the marketplace (*i.e.*, sales and consumer studies), recognition by others in the market (*i.e.*, awards or prizes), and length and exclusivity of use (*i.e.*, attempts to plagiarize)." *Nabisco*, 32 F. Supp. 2d at 697-98.

160. The more closely related the goods are, the more likely consumers are to be confused as to their source. *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1147 (9th Cir. 2002).

161. Similarity of the marks is particularly important in cases between direct competitors. *See* *Brookfield Communications, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1054 (9th Cir. 1999); *see also* *Thane Int'l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 903 (9th Cir. 2002) (citing rule). Courts analyze similarities in spelling, appearance, and pronunciation. *Id.*

162. *See* Edwin S. Clark, Comment, *Finding Likelihood of Confusion with Actual Confusion: A Critical Analysis of the Federal Courts' Approach*, 22 GOLDEN GATE U. L. REV. 393 (1992) (arguing that federal courts give more weight to actual confusion than other factors, that objections to this application are baseless, and that this shift should be explicitly recognized). Actual confusion is "undoubtedly the best evidence" of likelihood of confusion. *Wynn Oil Co. v. Am. Way Serv. Corp.*, 943 F.2d 595, 601 (6th Cir. 1991). However, because evidence of actual confusion is "difficult to produce and frequently discounted as unclear or insubstantial," it should be "weighted heavily only when there is evidence of past confusion, or perhaps, when the particular circumstances indicate such evidence should have been available." *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1188 (6th Cir. 1988) (quoting in part *Bandag, Inc. v. Al Bolser's Tire Stores, Inc.*, 750 F.2d 903, 914 (Fed. Cir. 1984) (quoting *Sleekcraft*, 599 F.2d at 352-53)); *see also* *Champions Golf Club, Inc. v. The Champions Golf Club, Inc.*, 78 F.3d 1111, 1119 (6th Cir. 1996) (stating rule); *Times Newspapers, Ltd. v. Times Publ'g Co.*, No. 92-1435-CIV-T-15(A), 1993 WL 120614, at *5 (M.D. Fla. 1993) (stating rule).

Clark traces this rule's basis to Judge Frank's dissent in *Triangle Publications, Inc. v. Rohrlich*, where Judge Frank noted that finding no likelihood of confusion must yield to a finding of actual confusion. *Triangle Publ'ns, Inc. v. Rohrlich*, 167 F.2d 969, 976 (2d Cir. 1948) (Frank, J., dissenting). Thus, finding actual confusion would automatically result in a finding of likelihood of confusion. Clark, *supra*, at 399-400.

marketing channels used, likely degree of purchaser care, the defendant's intent in selecting the mark, and likelihood of expansion of the product lines of the parties.¹⁶³ These factors are used only as a guide. They are not intended to be used as a “scorecard—whether a party ‘wins’ a majority of the factors is not the point.”¹⁶⁴ At the summary judgment stage, the court then decides whether a genuine issue of material fact as to the likelihood of confusion exists.¹⁶⁵

Some courts apply the traditional likelihood of confusion test to celebrity infringement cases without any special First Amendment considerations. Courts consider the “mark” to be the celebrity's persona.¹⁶⁶ The strength of the mark refers to the level of recognition the celebrity receives in society.¹⁶⁷ The “goods” are the reasons for, or sources of, the plaintiff's fame.¹⁶⁸

This test is consistent with traditional product infringement trademark cases. It does not attempt to apply a special judge-made standard to the special case of celebrities; rather, it simply treats the celebrity's right as the same as any other trademarked good.¹⁶⁹ Some courts criticize this effect¹⁷⁰ even though the test “generally strikes a comfortable balance between the trademark owner's property rights and the public's expressive interests.”¹⁷¹ The test is also “intuitive, straightforward, and easy to apply.”¹⁷² Professor Lee states that courts applying this test simply find confusing speech to be misleading. Since the First Amendment does not protect misleading speech, speech causing consumer confusion is not protected.¹⁷³

163. If either party might expand to compete with the other, the potential for likelihood of confusion is greater. *Interstellar Starship Servs., Ltd. v. Epix, Inc.*, 184 F.3d 1107, 1111 (9th Cir. 1999) (citing *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 354 (9th Cir. 1979)), *aff'd*, 304 F.3d 936 (9th Cir. 2002).

164. *Thane Int'l*, 305 F.3d at 901.

165. *Parks v. LaFace Records*, 329 F.3d 437, 448 (6th Cir. 2003) (explaining the test, but ultimately declining to apply it), *cert. denied*, 124 S. Ct. 925 (2003).

166. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992) (citing *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 627 (S.D.N.Y. 1985)).

167. *White*, 971 F.2d at 1400 (citing *Acad. of Motion Picture Arts & Sciences v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1455 (9th Cir. 1991)).

168. *White*, 971 F.2d at 1400.

169. *Parks*, 329 F.3d at 449; *cf. Downing*, 265 F.3d at 1002, 1007–08 (adapting traditional test to use of pictures of “surfing legends” in catalog).

170. *See Parks*, 329 F.3d at 449 (noting that simply applying the traditional likelihood of confusion test is inadequate because it ignores the communicative value of artistic work, and that titles can be “part and parcel” of the artistic work).

171. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003). The court goes on to say that when the trademark owner in a products context attempts to limit how people can express themselves, the likelihood of confusion test does not adequately weigh First Amendment interests. *Id.*

172. *Lee*, *supra* note 6, at 486–87.

173. *Id.*

The most significant problem in applying the likelihood of confusion test to celebrity cases is that it does not specifically address the First Amendment defense.¹⁷⁴ Arguably, Congress weighed the First Amendment claim when it enacted the Act.¹⁷⁵ When the Act was passed, it applied solely to commercial advertising contexts.¹⁷⁶ Congress probably did not anticipate the current expansion covering celebrities' rights concerning speech that is not purely commercial.¹⁷⁷ Even in a commercial advertising context, celebrities historically lost cases factually similar to those that they have recently won.¹⁷⁸ Adequate recognition of artists' First Amendment freedom of speech is necessary to protect artists' ability to freely create while ensuring that clear boundaries exist.

2. Alternative Avenues

The second test used by some courts to balance section 43(a) and the First Amendment is the alternative avenues test. Under this test, an expressive work's use of a trademark has First Amendment protection only if no sufficient alternative means exist to express the idea conveyed

174. *Parks*, 329 F.3d at 448–49.

175. *Films of Distinction, Inc. v. Allegro Film Prods., Inc.*, 12 F. Supp. 2d 1068, 1078 (C.D. Cal. 1998) (discussing *Dr. Seuss* and the likelihood that the Ninth Circuit would not adopt *Rogers* because First Amendment concerns had already been weighed by the legislature).

176. Discussing the Lanham Act's purpose, the Second Circuit stated:

Congress' purpose in enacting § 43(a) was to create a special and limited unfair competition remedy, virtually without regard for the interests of consumers generally and almost certainly without any consideration of consumer rights of action in particular. The Act's purpose . . . is exclusively to protect the interests of a purely commercial class against unscrupulous commercial conduct.

Colligan v. Activities Club of N.Y., Ltd., 442 F.2d 686, 692 (2d Cir. 1971) (footnotes omitted).

177. Lemley, *supra* note 15, at 1713 (“[N]o one in 1948 could seriously have thought the law would contemplate granting [this type of protection.]”). Lemley advocates taking “the likelihood of confusion requirement, the fair use doctrine, and the doctrine of non-trademark use seriously,” in order to eradicate “the property rationale for trademarks.” *Id.* at 1714. Courts should be concerned with expanding trademark rights beyond the scope envisioned by the Lanham Act's drafters when such expansion has serious First Amendment implications.

178. *Compare Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343, 348–49 (S.D.N.Y. 1973) (finding no cause of action for celebrity against advertiser for using imitation of her voice in a commercial because her voice cannot be trademarked), *with Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1108–11 (9th Cir. 1992) (finding for singer under similar facts), *amended by* 1992 U.S. App. LEXIS 27031 (9th Cir. 1992).

by using the trademark.¹⁷⁹ This test classifies trademarks as a property interest. Its owner need not “yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.”¹⁸⁰ The Eighth Circuit has used the alternative avenues test in the contexts of a product logo parody and a film title containing another company’s registered trademark.¹⁸¹

This test originated in the Second Circuit’s 1979 decision in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*¹⁸² In *Dallas Cowboys Cheerleaders*, the defendant’s “gross and revolting sex film” entitled “Debbie Does Dallas” used the distinctive Dallas Cowboys cheerleader costume without permission.¹⁸³ The court examined whether the filmmaker could express his message of “sexuality in athletics” without using the uniform’s distinctive design.¹⁸⁴ The court found that the filmmaker’s message could be expressed in “numerous ways . . . without infringing plaintiff’s trademark,” and upheld the plaintiff’s claim.¹⁸⁵

The Eighth Circuit adopted the alternative avenues test in *Mutual of Omaha Insurance Co. v. Novak*.¹⁸⁶ In *Novak*, the defendant created t-shirts, coffee mugs, and other merchandise containing a picture depicting an emaciated, bonneted human head resembling the Mutual of Omaha’s logo.¹⁸⁷ The shirts contained the words “Mutant of Omaha” and “Nuclear Holocaust Insurance.”¹⁸⁸ The defendant claimed his merchandise parodied the logo.¹⁸⁹ The court determined that alternative methods of expressing the same idea existed, and therefore the artist’s use of Mutual of Omaha’s logo infringed its trademark.¹⁹⁰

In *American Dairy Queen Corp. v. New Line Productions*, the Eighth

179. *Parks*, 329 F.3d at 448 (citing *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987)).

180. *Novak*, 836 F.2d at 402 (quoting *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972)).

181. *Id.* at 398, 402.

182. 604 F.2d 200 (2d Cir. 1979).

183. *Id.* at 202–03.

184. *Id.* at 206. The court clearly did not take the defendant’s message very seriously. As described by the court, the film’s plot:

[T]o the extent that there is one, involves a cheerleader at a fictional high school, Debbie, who has been selected to become a “Texas Cowgirl.” In order to raise enough money to send Debbie, and eventually the entire squad, to Dallas, the cheerleaders perform sexual services for a fee. The movie consists largely of a series of scenes graphically depicting the sexual escapades of the “actors.”

Id. at 202–03.

185. *Id.* at 206.

186. 836 F.2d at 402.

187. *Id.* at 398.

188. *Id.*

189. *Id.* at 401.

190. *Id.* at 402.

Circuit considered whether a movie studio's use of a trademarked corporate name in a movie title infringed the trademarked name.¹⁹¹ The court acknowledged *Rogers* but reverted to the alternative avenues test because it found the title to be commercial speech.¹⁹² Because the film title "Dairy Queens" had nothing to do with American Dairy Queen's trademark or products, the court found that other titles would be adequate for the film.¹⁹³ *American Dairy Queen* seems to be a significant departure from applying *Rogers*. If the court applied *Rogers* and no artistic relevance whatsoever was found, then the Lanham Act would apply notwithstanding First Amendment concerns. Instead, *American Dairy Queen* classified the title as commercial speech. It found that alternative avenues existed to express New Line's idea, such as "Dairy Princesses" or "Milk Maids."¹⁹⁴

The Eighth Circuit has not yet applied this test to a celebrity name infringement case. The Second Circuit refused to extend this application to a celebrity name confusion case in *Rogers*, and instead established a third test.¹⁹⁵

The alternative avenues test provides celebrities with the greatest protection of the various tests used by the Courts of Appeals.¹⁹⁶ Proof of infringement still requires showing likelihood of confusion. The First Amendment defense is disposed of when the plaintiff can show that the

191. *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 734–35 (D. Minn. 1998).

192. *Id.* at 734.

193. *Id.*

194. *Id.* The court did not apply *Central Hudson* because the alternative avenues test is designed to take into account First Amendment issues. *Id.* at 735. The court simply noted that *Central Hudson* stands for lesser protection for commercial speech. *Id.* New Line did not appeal this decision. This case stands as the Eighth Circuit's only application of the alternative avenues test to a mass entertainment product.

195. *Rogers v. Grimaldi*, 875 F.2d 994, 999–1000 (2d Cir. 1989). *Rogers* states that *Dallas Cowboys* involved "blatantly false advertising" and holds the case out as a special situation. *Id.* at 999 n.4. Because the Second Circuit now applies *Rogers* to cover all works of artistic expression, and given the *Rogers* opinion's harsh characterization of the alternative avenues test, it is unlikely that the Second Circuit would now employ the alternative avenues test. See *Parks v. LaFace Records*, 329 F.3d 437, 450 (6th Cir. 2003), *cert. denied*, 124 S. Ct. 925 (2003); 5 MCCARTHY, TRADEMARKS, *supra* note 29, § 31:144, at 31-235 to 31-237 (discussing *Rogers*'s concern with alternative avenues test's inability to properly balance First Amendment and Lanham Act concerns, and *Rogers*'s adoption in different contexts in other circuits).

196. See *Rogers*, 875 F.2d at 999 (stating that the alternative avenues test insufficiently accommodates the public's interest in free expression).

defendant had alternative ways to express his idea.¹⁹⁷ Finding sufficient alternative means to express an idea goes directly to the court's perception of the use's artistic integrity.¹⁹⁸ If the court feels that the artist's use of a celebrity's name or image makes a unique artistic statement, it is unlikely that it will find a sufficient alternative method to express that idea.

This interpretation broadens the Lanham Act's applicability. By protecting the individuals' rights so long as alternate means of communicating the idea exist, the artist must exclude every existing celebrity name and image unless he can *prove* that the idea's expression with the celebrity name is the best expression—that is, that no sufficient alternative means of expression exist. Thus, the alternative avenues test recognizes and rewards the effort of celebrities in creating and maintaining their name, public image, and the associations that the public draws from them. In doing so, it severely limits artists' abilities to freely create work involving those celebrities.¹⁹⁹

The alternative avenues test is exceptionally subjective. The court must judge both whether the use is artistically relevant and whether that relevance can be approximated by another similar alternative.²⁰⁰ Judges

197. *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979).

198. *Parks*, 329 F.3d at 450 (discussing the difficulties in substituting words for those of the author in attempting to convey the same message, and suggesting that the alternative avenues test would “needlessly entangle courts in the process of titling works of art”).

199. *Novak* involved a parody of a famous trademark. See *supra* notes 186–90 and accompanying text. Describing musical parody in a copyright infringement case, Justice Kennedy stated: “The parody must target the original, and not just its general style, the genre of art to which it belongs, or society as a whole (although if it targets the original, it may target those features as well).” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 597 (1994) (Kennedy, J., concurring) (citing *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992); *Fisher v. Dees*, 794 F.2d 432, 436 (9th Cir. 1986)). In typical trademark cases, parody is not really a separate defense to infringement, but merely another way of saying that consumers are not likely to be confused as to the product's source. *Mattel, Inc. v. MCA Records, Inc.*, No. CV 97-6791-WMB, 1998 U.S. Dist. LEXIS 7310, at *29 (C.D. Cal. Feb. 19, 1998) (citing *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997)), *aff'd*, 296 F.3d 894 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003). Recognizing that the “Mutant of Omaha” design parodied the insurance company's logo, the court nonetheless denied First Amendment protection because the plaintiffs showed significant evidence of actual confusion, thus presenting a strong infringement case. *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 400–01 (8th Cir. 1997).

200. The Sixth Circuit in *Parks* aptly criticized this test as follows: “[A]dopting the ‘alternative avenues’ test would needlessly entangle courts in the process of titling works of art; courts would be asked to determine not just whether a title is reasonably ‘artistic’ but whether a title is ‘necessary’ to communicate the idea.” *Parks*, 329 F.3d at 450. Notably, however, taking such pains as lyrical translation and comparing a “message” to a celebrity's artistic qualities seem to move toward a similar “needless[] entangle[ment]” that the court was so conscious to avoid. *Id.*

often warn their colleagues against interpreting artistic work at all; thus, it makes sense that if courts need to make some interpretation, it should be at the simplest, most-baseline level possible. The alternative avenues test goes far beyond this surface look, “needlessly entang[ling] courts in the process of titling works of art.”²⁰¹ In moving away from using this test, *Rogers* quoted *Cohen v. California*: “[W]e cannot indulge the facile assumption that one can forbid particular words without running a substantial risk of suppressing ideas in the process.”²⁰² Courts should not be put in the position of evaluating artistic work and then suggesting and evaluating alternatives based on their subjective evaluation.

3. *Rogers Balancing Test*

a. *Application to Using Celebrity Names*

The *Rogers* balancing test attempts to accommodate the dual public interests: free expression and avoiding consumer confusion.²⁰³ Under *Rogers*, the Lanham Act does not apply to the use of a celebrity’s name in a title “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.”²⁰⁴ The court made clear that minimal artistic relevance is an “appropriately low threshold.”²⁰⁵ To exemplify this threshold, the court discussed both a song and a movie that contained celebrity names in their titles.²⁰⁶ While neither title made any overt indication of the celebrity’s involvement or endorsement of the work, each had the requisite minimal artistic relevance because the content of each had something to do with their titles.²⁰⁷ The court found that “the slight risk that such use of a celebrity’s name might implicitly suggest endorsement or sponsorship to some people is outweighed by

201. *Id.*

202. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (quoting *Cohen v. California*, 403 U.S. 15, 26 (1971)).

203. *Id.* at 998.

204. *Id.* at 999.

205. *Id.* The court made clear that its test would construe the Lanham Act narrowly. *Id.* at 998.

206. “Bette Davis Eyes” and “Come Back to the Five and Dime, Jimmy Dean, Jimmy Dean”, respectively. *Id.* at 999–1000.

207. The court notes that each of these titles *might* contain requisite artistic relevance, but that the final decision is for the factfinder. Its conclusion was only that, in such an instance, the factfinder should have the opportunity to determine if such minimal relevance exists. *Id.* at 1000 n.6.

the danger of restricting artistic expression, and the Lanham Act is not applicable.”²⁰⁸

Once any artistic relevance whatsoever is found, the title is not subject to the Lanham Act unless it is explicitly misleading as to the source or content of the work.²⁰⁹ The court demonstrated that specific titles can indicate the source from which the work originated, “such as ‘Nimmer on Copyright’ [or] ‘Jane Fonda’s Workout Book.’”²¹⁰ If the work did not originate with the individual named in the title, it would be explicitly misleading and the Lanham Act would apply. This prong of the *Rogers* test protects the consumer from potentially misleading explicit information as to the work’s source notwithstanding artistic relevance.

b. Application to Using Celebrity Images

Properly applied, the *Rogers* test can similarly protect celebrity images. For example, in *Seale v. Gramercy Pictures*, civil rights activist and former Black Panther Bobby Seale made a Lanham Act claim against the producers of the film, “Panther.”²¹¹ His suit challenged the use of his name and likeness (in the form of an actor portraying him) in the film, on the cover of a book memorializing the film, the soundtrack CD, and the home video.²¹² The film recounted the history of the Black Panther party in a “docudrama” format presenting a dramatic recreation or adaptation of actual events and thus was not a true historical account per se.²¹³ The court considered the use of Seale’s image and name in the film and on the covers of both the book and CD as artistically relevant to the content of each expression.

Seale is best known for his participation in the Black Panther movement. Because each of these media recounted that involvement, use of his name was artistically relevant in that it related to the content of each media.²¹⁴ Relevance existed because of the nexus between the actions for which Seale is known and reference to those actions (even if in a fictional light) in the film and book.

The *Rogers* test is closer to traditional trademark law because likelihood of confusion is a key interest. Unlike traditional tests, it considers First Amendment rights explicitly. Adoption of *Rogers* by the

208. *Id.* at 1000.

209. *Id.* at 999.

210. *Id.*

211. *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 332–33 (E.D. Pa. 1996), *aff’d without opinion*, 156 F.3d 1225 (3d Cir. 1998).

212. *Id.* at 334–35.

213. *Id.* at 335 (citing 2 MCCARTHY, PUBLICITY AND PRIVACY, *supra* note 28, § 8.9[A] n.2 (1999)).

214. *Id.* at 340.

Ninth Circuit in 2002 and the Sixth Circuit in 2003 demonstrates this test's growing acceptance.²¹⁵

B. Problems Applying Rogers

1. Relevant as to What?

The District Court and Court of Appeals opinions in *Parks* demonstrate problems interpreting *Rogers* without a clear federal standard. In the District Court case, the court considered the question of minimal artistic relevance in a different light than did the Court of Appeals.²¹⁶ The District Court analyzed the song on its face by considering its lyrics. The song's chorus is: "ah hah, hush that fuss, everybody move to the back of the bus."²¹⁷ The court found that the song made "unmistakable reference" to the act for which Rosa Parks is universally known.²¹⁸ Ms. Parks protested segregation laws in Montgomery, Alabama in 1955 by refusing to move to the back of a bus.²¹⁹ Based solely on this link between the chorus of OutKast's song and Ms. Parks's historic actions, the court found the relation between using her name in the title of the song and its content to be "so obvious that the matter is not open to reasonable debate."²²⁰ How, then, did the Court of Appeals overturn this obvious connection?

The Court of Appeals framed the question differently. Instead of attempting to find a connection between the use of the name "Rosa Parks" and content of OutKast's song, the Court of Appeals looked to link the content of the song with Parks's personal qualities.²²¹ This

215. The Ninth Circuit expressly adopted *Rogers* in *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003). The Sixth Circuit *Parks* decision likewise expressly adopted *Rogers*, although as discussed *infra* notes 216–24 and the accompanying text, the court went too far in analyzing the content of the song at issue. *Parks v. LaFace Records*, 329 F.3d 437, 451–52 (6th Cir. 2003) (explaining, after analyzing each of the tests, the court's determination that the "application of *Rogers* in *Mattel*, as well as in cases decided in other circuits, persuades us that *Rogers* is the best test for balancing Defendants' and the public's interest in free expression under the First Amendment . . . and the public's interest in enforcement of the Lanham Act"), *cert. denied*, 124 S. Ct. 925 (2003).

216. *Parks v. LaFace Records*, 76 F. Supp. 2d 775, 780–84 (E.D. Mich. 1999), *aff'd in part, rev'd in part*, 329 F.3d 437 (6th Cir. 2003), *cert. denied*, 124 S. Ct. 925 (2003).

217. The chorus is repeated a total of ten times. *Id.* at 780.

218. *Id.*

219. *Parks*, 329 F.3d at 442.

220. *Parks*, 76 F. Supp. 2d at 782.

221. Petition for a Writ of Certiorari at 9–11, *Parks v. LaFace Records*, 124 S. Ct.

important distinction strayed from the *Rogers* analysis. Under the Court of Appeals' interpretation of *Rogers*, the song would have to have been about Parks *herself* and not simply demonstrate some minimal artistic relevance of the title to the content of the song. The court said as much when it went to great lengths to "translate" the lyrics of the song to determine whether the song was about Parks.²²² After this translation it was easy to find a question of fact as to whether artistic relevance existed. As the basis of the Court of Appeals' analysis, the translation removed the obvious link to Parks by rephrasing the reference to her universally known act of moving to the back of the bus. Instead of recognizing this link to Parks, the court translated it out of the analysis and found that the title of "Rosa Parks" had no artistic relevance whatsoever to the content of the song. After admonishing the song's profanity, the court stated that the lyrics "contain absolutely nothing that could conceivably, by any stretch of the imagination, be considered, explicitly or implicitly, a reference to courage, to sacrifice, to the civil rights movement or to any other quality with which Rosa Parks is identified."²²³ True. By rephrasing the key *Rogers* question from "Does the title have any minimal artistic relevance whatsoever to the content of the work?" to "Does the content of the work have any minimal connection to the personality traits or qualities of the celebrity named in the title?", the Court of Appeals drastically changed the *Rogers* inquiry.²²⁴ Instead of attempting to link something from the expression to anything recognizable about the celebrity, the Court of Appeals attempted to link something from the expression to some quality or attribute of the celebrity. Thus, a link to an event in the celebrity's life would not suffice under this version of the *Rogers* analysis.

A similar type of analysis may have yielded a different result in *Rogers*. In *Rogers*, the court was satisfied to find that the presence of characters nicknamed Ginger and Fred in the film passed the minimal artistic relevance threshold. Suppose that, instead, the court wanted to determine whether the characters Ginger and Fred had similar qualities

925 (2003) (No. 03-504), available at 2003 WL 23145528.

222. The Court of Appeals resorted to a "translation" of the song, derived by Parks from "'dictionaries' of the 'rap' vernacular." The chorus of, "Ah hah, hush that fuss/ Everybody move to the back of the bus/ Do you wanna bump and slump with us/ We the type of people make the club get crunk" was translated to, "Be quiet and stop the commotion. OutKast is coming back out [with new music] so all other MCs [mic checkers, rappers, Master of Ceremonies] step aside. Do you want to ride and hang out with us? OutKast is the type of group to make the clubs get hyped-up/excited." *Parks*, 329 F.3d at 442-43, 452.

223. *Id.* at 453 (emphasis added).

224. See Petition for a Writ of Certiorari at 10-12, *Parks*, (No. 03-504) (discussing Sixth Circuit's transformation of the *Rogers* inquiry).

to Ginger Rogers and Fred Astaire. The court could have solicited testimony of dance experts to determine whether the characters provided an accurate portrayal of Rogers's and Astaire's dance moves. It could have questioned the pair's friends to determine whether the characters' personality traits accurately reflected individuals' qualities. Of course, *Rogers* rejected this type of analysis out of hand.²²⁵ Rather, the court explicitly required only minimal relevance to the content of the film, not an accurate portrayal of the celebrity involved. The Court of Appeals decision in *Parks* suggests the second, faulty analysis.

2. *Considering Artists' Notoriety*

The second problem courts face when applying *Rogers* is discerning whether the artist used the celebrity to gain notoriety for himself. To do this, courts are tempted to consider an artist's commercial popularity when applying *Rogers*. If an artist is popular, he will have less reason to use a celebrity's name or likeness for his own gain, and thus the use is more likely artistic in nature. Likewise, an unknown artist using a celebrity's name will do so to gain notoriety for his work, free-riding on the celebrity's fame.

This is the type of unfair competition that the Lanham Act intended to avoid, but considering an artist's current popularity as indicia of unfair competition is improper. The analysis must be limited to the work's content in order to treat all artists equally. *Rogers* does not question anything outside the use of the name inside the work itself. If the use does not lack any artistic relevance whatsoever, it is irrelevant whether the artist was nominated for a Grammy for the song (as OutKast was for Rosa Parks) or the song never received a minute of radio airplay.²²⁶ Whether an artist has already gained notoriety should have no bearing on the First Amendment protection he receives.

OutKast had achieved critical success before the "Rosa Parks" release. The Sixth Circuit scrutinized OutKast's use of Parks's name in light of whether it increased album sales as a part of its artistic relevance inquiry. The court found that it "unquestionably" increased sales, and

225. The *Rogers* court rejected Ginger Rogers's claim that the title was misleading because the film was not about her. Instead, it found the title to be entirely truthful as to the content of the film in referring to the film's characters and story. *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d Cir. 1989).

226. Petition for a Writ of Certiorari at 5, *Parks* (No. 03-504).

viewed this benefit as the true reason for OutKast's use.²²⁷ The court's logic fails on two grounds. First, the court failed to acknowledge that OutKast may have sold just as many records because the group had "received widespread critical acclaim within the music industry and from the general public."²²⁸ Second, and more importantly, the court should not look beyond the name's relevance to the song to determine infringement. Doing so would suggest a rule that provides greater First Amendment protection for well known artists. Such a rule would stifle creativity: a presumption that an unknown artist's use is improper because its true purpose is to gain notoriety systematically discriminates against new or unknown artists. At best, it permits only the speech of commercially successful bands such as OutKast (or commercially viable bands such as Aqua, at issue in *Mattel*), because these groups have the resources to litigate their claims. At the same time, it counts as a strike against any unsigned band in a similar situation, but lacking the funds to litigate. However, as OutKast's defeat in *Parks* demonstrates, simply having resources to litigate will not help an artist if courts continue to apply inconsistent tests to their speech.

Admittedly, it is difficult to assess artistic relevance without considering whether a use is an advertising ploy. Artists' intentions in using a trademark are difficult to ascertain. Artists cannot simply "cry symbol" to avoid liability.²²⁹ At the same time, courts' unbiased ability to find a link between a work and its title, according to *Rogers*'s "appropriately low threshold," is not so daunting a task to be unmanageable.²³⁰ Isolating the analysis to the work at hand, without considering the artists' success (or lack thereof), is the only way to fairly analyze artists on a level scale and provide the same protection for each artist's speech.

Properly, *Mattel* left Aqua's lack of notoriety out of the equation. Aqua did not have any commercial success in the United States prior to "Barbie Girl."²³¹ Indeed, "Barbie Girl" may have been a major record label's ploy to gain international commercial success for a group that could sell records, but was short on talent. Even so, Judge Kozinski did not analyze Aqua's lack of prior record sales when applying *Rogers*, nor did he venture a guess as to how many more records Aqua sold because

227. *Parks*, 329 F.3d at 453–54.

228. Petition for a Writ of Certiorari at 5, *Parks* (No. 03-504) (citing numerous newspaper articles praising OutKast's social consciousness and musical talent).

229. *Parks*, 329 F.3d at 454.

230. *Rogers*, 875 F.2d at 999.

231. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 899 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003). The band had some success in their native Denmark with one platinum record and a single reaching gold record status faster than any other in Danish history. Jeremy Ulrey, *Aqua: Biography*, at <http://ubl.artistdirect.com/music/artist/bio/0,,593419,00.html?artist=Aqua> (last visited Nov. 26, 2004).

the song was not entitled “Little Plastic Blond Doll” (or any other non-trademarked alternative). Unlike *Parks*, where the judge suggested another song title for “Rosa Parks” (although he disclaimed applying the alternative avenues test), *Mattel* properly focused solely on the song’s content to find relevance.

V. SOLUTION

A. Proper Formulation/Application of *Rogers*

Properly applied, the *Rogers* test is an appropriate balance of whether the use of a name is protected by the First Amendment. Standing alone, the likelihood of confusion test is inadequate to balance trademark and First Amendment interests.²³² If the Lanham Act applies under *Rogers*, the traditional likelihood of confusion test should be applied to determine whether the use infringes the plaintiff’s mark notwithstanding First Amendment concerns.²³³ Once the court specifically addresses and accommodates First Amendment concerns, likelihood of consumer confusion is the appropriate test. At this point, the case becomes a standard trademark infringement claim and the statutory test for infringement must be applied.²³⁴

Inconsistent application of *Rogers* has created numerous, confused standards under the guise of a *Rogers* analysis. Courts should be concerned with maintaining trademark law’s traditional purpose of avoiding consumer confusion and avoiding further muddling of a legal regime intended to protect consumers. Likewise, courts should protect artists from celebrities intending to use trademark as a sword to capitalize on

232. *Mattel*, 296 F.3d at 900 (noting that the likelihood of confusion test is inadequate when a trademark owner tries to control expression).

233. *See id.* at 17.

234. *See* Petition for a Writ of Certiorari at 16, *Parks* (No. 03-504) (criticizing Sixth Circuit’s statement that if a jury found no artistic relevance in OutKast’s use of Parks’s name in “Rosa Parks,” it would violate the Lanham Act without consideration of likelihood of confusion or other ordinary trademark infringement claim prerequisites). A celebrity Lanham Act claim does not create a new, different cause of action under the current Act. The *Parks* court misinterpreted *Rogers* to mean that finding “no artistic relevance whatsoever” replaces traditional trademark concerns. *See id.* *Rogers* did not intend this result; it merely used artistic relevance test to determine whether the Act applied at all. If it did, then the court gave no indication that it would not still consider the likelihood of consumer confusion or other traditional trademark concerns. The *Parks* court’s interpretation essentially changes the requirements for proving a claim. In doing so, the court creates a kind of “mutant defamation law, wholly unmoored by the Trademark Act’s commercial focus.” *Id.*

their power and fame. Applying the *Rogers* balancing test and holding to the “minimal threshold” of artistic relevance that it requires permits courts to accommodate both interests. When courts have to look beyond the surface of the work to ask whether a use is artistically relevant, it should already have decided that this minimal standard has been met.

Rogers is the best test to accommodate First Amendment and Lanham Act interests. It specifically addresses the First Amendment issues. It provides a minimal threshold of artistic relevance for artists to use celebrity names, celebrity images and culturally significant symbols necessary to express their ideas without fear of litigation.²³⁵ Under *Rogers*, courts do not have to make the bold artistic judgments required of the alternative avenues test—much less than being required to actually suggest alternatives for artists to use in their work. Critics of *Rogers* note that courts are ill equipped to make judgments to determine whether using a celebrity’s name in a title has some artistic relevance to the content or if the name is used simply to exploit its commercial value.²³⁶ Properly applied, *Rogers* does not require dissections of artistic work. A court must make artistic value judgments, but only sufficient to find a minimal standard of relevancy to the content of the work. In fact, and much to the chagrin of many celebrities, a minimally artistic use *can* be a “good marketing tool,” designed just to sell more copies.²³⁷

235. Some commentators have argued that a federal right of publicity will solve the problem. See generally Eric J. Goodman, *A National Identity Crisis: The Need for a Federal Right of Publicity Statute*, 9 DEPAUL-LCA J. ART & ENT. L. & POL’Y 227 (1999); J. Eugene Salomon, Jr., Note, *The Right of Publicity Run Riot: The Case for a Federal Statute*, 60 S. CAL. L. REV. 1179 (1987); Jennifer Y. Choi, Comment, *No Room for Cheers: Schizophrenic Application in the Realm of Right of Publicity Protection*, 9 VILL. SPORTS. & ENT. L.J. 121, 150 (2002); Felix H. Kent, *Advertising Law—Reviewing 1997: Tobacco Settlement*, N.Y. L.J., Dec. 19, 1997, at 3. This may be the case. My point is that, whatever new federal legal regime is created to deal with these types of claims, trademark is not the appropriate regime to use. See also K.J. Greene, *Abusive Trademark Litigation and the Incredible Shrinking Confusion Doctrine—Trademark Abuse in the Context of Entertainment Media and Cyberspace*, 27 HARV. J.L. & PUB. POL’Y 609, 612–14 (2004) (discussing the use of trademark law by celebrities and corporations to limit speech with which they do not agree, and the resultant circumvention of the policies underlying trademark). By applying *Rogers* as the minimum threshold that it was intended to be, the Lanham Act will not apply in most of these cases.

236. 4 MCCARTHY, TRADEMARKS, *supra* note 29, § 27:86, at 27-171 to 27-172.

237. *Parks v. LaFace Records*, 329 F.3d 437, 453 (6th Cir. 2003), *cert. denied*, 124 S. Ct. 925 (2003); see *Parks v. LaFace Records*, 76 F. Supp. 2d 775, 781 (E.D. Mich. 1999) (rejecting plaintiff’s argument that defendants only used her name to sell records, and stating that “grave harm” would result if courts were required to compel the author to justify use of the celebrity’s identity), *rev’d*, 329 F.3d at 437, *cert. denied*, 124 S. Ct. at 925.

*B. Application to Other Entertainment Industry Issues**1. Soundtracks*

Soundtracks present a difficult situation. In *Seale*, the court distinguished between use of Bobby Seale's name in the film "Panther", on packaging for the film and on a book about the film from use of his name on packaging for the film's soundtrack compact disc. The songs on the CD were "merely a collection of different songs performed by different musicians . . ." ²³⁸ Each song on the CD played during the film. ²³⁹ The court differentiated the songs' connection to the film from their lack of connection to Seale or the history of the Black Panther Party. ²⁴⁰ Here, the question of minimal artistic relevance required an intermediate step from the celebrity, through the film, to the music in the film.

The court seems to draw this artificial distinction as a way to limit *Rogers*'s application. Seale's name had artistic relevance to the film. The music had artistic relevance to the film. The soundtrack was not a random assortment of songs from unrelated artists; rather, it was a carefully planned and produced collection relating directly to the artistic presentation of "Panther." The songs certainly were not about Seale. However, when presented with the story of the film, they were artistically related to his character (if not Seale in the historical sense). When packaged as the soundtrack to that film, the connection is clear to the consumer that the name "Bobby Seale" on its cover is in connection to Seale in the film, not as an endorsement by Seale through an actor portraying him on a CD cover. Whether consumers might mistakenly believe that Seale endorsed the film is a risk that the First Amendment allows. ²⁴¹ When a soundtrack consists of songs played during a film, its packaging should be able to name characters from that film because of the connection between the two.

238. *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 337 (E.D. Pa. 1996).

239. *Id.* at 335.

240. *Id.* at 337:

Clearly, the use of the Plaintiff's name and likeness on the cover of the musical CD/cassette does not relate to the content in the CD/cassette in the same manner as the use of the Plaintiff's name and likeness on the cover of the home video and pictorial history book relates to the content of the film and pictorial history book—the subject matter of which concerns the Black Panther Party and the Plaintiff's role as co-founder of the Party.

241. *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989) ("[T]he slight risk that such use of a celebrity's name might implicitly suggest endorsement or sponsorship to some people is outweighed by the danger of restricting artistic expression, and the Lanham Act is not applicable.").

2. Cover Art/Track Listing

Compact discs and movies invariably include some sort of packaging. In the case of a compact disc, the packaging usually includes cover artwork and a track listing. In the case of a DVD or VHS tape, the packaging generally includes a picture related to the film as well as a summary of the plot. If a celebrity's name is included on the packaging, how does the Lanham Act apply?

Under *Rogers*, the use would be protected if it had any artistic relevance whatsoever to the content of the packaging. That is, a song title with a celebrity's name in it may only be used on the packaging for a CD containing that song.²⁴² In the case of a film, a name could only be used if it was artistically relevant to the film itself. Either situation contains some gray areas. For example, what if a trumpet player touted himself as the next Miles Davis?²⁴³ A court could find minimal artistic relevance under *Rogers* if the reference to Davis actually had something to do with the trumpet player. An unknown artist might have difficulty establishing that he did not simply use Davis's name as a marketing tool.²⁴⁴ However, if a music review made an identical statement, the artist probably would include it on his CD because the statement would be protected speech.

VI. CONCLUSION

The Lanham Act's conflict with the First Amendment produced several conflicting tests to weigh these interests. Courts treat celebrity claims differently than typical trademark claims. The Lanham Act's expanded applicability has led to cases in which consumer confusion is supplanted by celebrities' property interests in their names and images. Courts balance these interests inconsistently, resulting in artists' inability to use these trademarks in their works for fear of litigation. Several tests used by federal courts include the standard likelihood of confusion test, the alternative avenues test, and several formulations of the *Rogers* balancing test. Consistent treatment of these claims is necessary in order

242. Otherwise, the speech would be false and misleading, and the First Amendment would not protect it anyway. *See supra* notes 172–73 and accompanying text.

243. *See Greene, supra* note 235, at 622 (discussing false advertising implications of a hypothetical pizza parlor displaying a sign stating, “Robert DeNiro eats here” when he in fact does not as a fraud on the public violative of the Lanham Act).

244. *See* discussion of potential bias against unknown artists *supra* notes 226–31 and accompanying text.

to permit artists to create work with clearly defined boundaries, thus vindicating their First Amendment rights, while upholding the traditional consumer protection emphasis of trademark law. By applying the *Rogers* test as it was originally intended, and applying the Lanham Act likelihood of confusion test only to uses that lack a minimum threshold of artistic relevance or are explicitly misleading, courts may accommodate these interests.

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