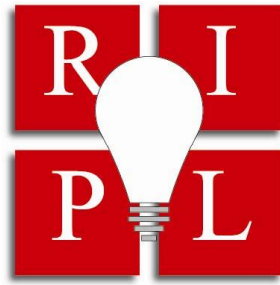


# THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



## RESTORING *ROGERS*: VIDEO GAMES, FALSE ASSOCIATION CLAIMS, AND THE “EXPLICITLY MISLEADING” USE OF TRADEMARKS

WILLIAM K. FORD

### ABSTRACT

Courts have long struggled with how to balance false association claims brought under the Lanham Act with the protections for speech under the First Amendment. The leading approach is the *Rogers* test, but this test comes in multiple forms with varying degrees of protection for speech. A substantial portion of the litigation raising this issue now involves video games, a medium that more so than others, likely needs the benefit of a clear rule that protects speech. The original version of the test is the simplest and the one most protective of speech. In 2013, the Ninth Circuit endorsed the original version of the *Rogers* test in unusually clear terms, yet in the face of conflicting decisions from the court of appeals, the district courts may still mistake the Ninth Circuit’s meaning. The Ninth Circuit may soon have the opportunity to clarify its meaning yet again. This article suggests the court does so, making clear that the original *Rogers* approach is indeed the law of at least the Ninth Circuit.

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## RESTORING *ROGERS*: VIDEO GAMES, FALSE ASSOCIATION CLAIMS, AND THE “EXPLICITLY MISLEADING” USE OF TRADEMARKS

WILLIAM K. FORD\*

### I. INTRODUCTION

Like a classic arcade game, *Rogers v. Grimaldi*<sup>1</sup> has three lives. In the leading treatise on trademark law, J. Thomas McCarthy describes the decision of the United States Court of Appeals for the Second Circuit in *Rogers* as “immensely influential” and “very popular with other courts.”<sup>2</sup> The case offers a test for balancing Lanham Act claims with the First Amendment. “The *Rogers* test,” as one district court judge explained, “is relatively straightforward to apply, and is very protective of speech.”<sup>3</sup> Yet courts that claim to follow *Rogers* often do not, at least not as the test was originally explained. In subsequent cases, the Second Circuit described the *Rogers* test in a way that is less straightforward to apply and less protective of speech,<sup>4</sup> resulting in a second version of the *Rogers* test. The Ninth Circuit has also been inconsistent. It adopted the original *Rogers* test in 2002,<sup>5</sup> but several years later in *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*,<sup>6</sup> a case that foreshadowed a flurry of video game litigation involving this issue, the Ninth Circuit arguably adopted a third version of the test, the least protective of the three. Two district court decisions in the Ninth Circuit, both involving video games and decided after *E.S.S.*, illustrate the confusion: *Electronic Arts, Inc. v. Textron, Inc.* applied this third version of *Rogers*,<sup>7</sup> whereas *Novalogic* applied the original version.<sup>8</sup> *Textron* represents a low point for creative freedom in the video game industry, but the Ninth Circuit subsequently endorsed the original *Rogers* test in no uncertain terms in 2013,<sup>9</sup> suggesting that *Textron* was wrong and *Novalogic* was right.

Currently, there is an appeal pending in the Ninth Circuit that reopens the *Textron* question. *Virag, S.R.L. v. Sony Computer Entertainment America LLC*<sup>10</sup> centers around the unauthorized use of Virag’s trademark in two racing video games.

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<sup>1</sup> 875 F.2d 994 (2d Cir. 1989).

<sup>2</sup> See J. THOMAS MCCARTHY, 6 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:144.50 (4th ed. 2017).

<sup>3</sup> *Novalogic, Inc. v. Activision Blizzard*, 41 F. Supp. 3d 885, 900 (C.D. Cal. 2013).

<sup>4</sup> See *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Group*, 886 F.2d 490, 493-95 (2d Cir. 1989); *Twin Peaks Prods. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993). See also *Louis Vuitton Mallatier S.A. v. Warner Bros. Entm’t Inc.*, 868 F. Supp. 2d 172, 179 (S.D.N.Y. 2012).

<sup>5</sup> See *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 902 (9th Cir. 2002) (“We agree with the Second Circuit’s analysis and adopt the *Rogers* standard as our own.”).

<sup>6</sup> 547 F.3d 1095 (9th Cir. 2008).

<sup>7</sup> See *Elec. Arts, Inc. v. Textron Inc.*, No. 12-0118, 2012 U.S. Dist. LEXIS 103914, at \*11-13 (N.D. Cal. July 25, 2012).

<sup>8</sup> *Novalogic*, 41 F. Supp. 3d at 898-900.

<sup>9</sup> See *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235, 1241-47 (9th Cir. 2013).

<sup>10</sup> No. 15-1729, 2015 U.S. Dist. LEXIS 111211 (N.D. Cal. Aug. 21, 2015).

The district court sided with the video game defendants on the Lanham Act claims,<sup>11</sup> but the court suggested that *Textron* might still have some viability as a persuasive application of the *Rogers* test.<sup>12</sup> The plaintiffs are now pressing *Textron* on appeal before the Ninth Circuit.<sup>13</sup> The Ninth Circuit, at some point, will have to revisit *Rogers* and end the doubt about how the test will work in the Ninth Circuit, particularly in the context of video games.<sup>14</sup> *Virag* is a suitable case both for the needed reaffirmation of *Rogers* in its original form and for dealing with *Textron*. Absent a settlement that ends the appeal, *Virag* should therefore be a particularly important case for the video game industry. Of course, *Virag* can only settle the question in the Ninth Circuit. Intervention from the U.S. Supreme Court is needed to settle the question nationally.

## II. THE FIRST AMENDMENT AND VIDEO GAMES

The Supreme Court's 2011 decision in *Brown v. Entertainment Merchants Association* held that video games, like other forms of media, are entitled to First Amendment protection.<sup>15</sup> Like newspapers, magazines, books, and films, video games are, at least in general, expressive, non-commercial speech.<sup>16</sup> Few would doubt that

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<sup>11</sup> The court also dismissed a claim that the use of the mark violated Virag the corporation's right of publicity on the ground that corporations do not have a right of publicity. *Id.* at \*13-20. The court did *not* dismiss the plaintiffs' claim that the defendants violated Virag co-owner and race car driver Mirco Virag's right of publicity. *Id.* at \*20-24. The plaintiffs voluntarily dismissed that claim, however, allowing an appeal to go forward. Br. of Appellant at 3, *Virag, S.R.L. v. Sony Comput. Entm't Am. LLC*, No. 16-15137 (9th Cir. June 2, 2016); Stipulation for Voluntary Dismissal, *Virag, S.R.L. v. Sony Comput. Entm't Am. LLC*, No. 15-1729 (N.D. Cal. Jan. 4, 2016).

<sup>12</sup> *Id.* at \*39-40.

<sup>13</sup> Br. of Appellant at 55-60, *Virag, S.R.L. v. Sony Comput. Entm't Am. LLC*, No. 16-15137 (9th Cir. June 2, 2016); Reply Br. of Appellant at 26, *Virag, S.R.L. v. Sony Comput. Entm't Am. LLC*, No. 16-15137 (9th Cir. Sept. 16, 2016).

<sup>14</sup> The confusion addressed in the present discussion is not the only confusion the Ninth Circuit has created in the application of *Rogers*. District courts in the Ninth Circuit have also disagreed over whether the *Rogers* test applies only to culturally significant marks. *Compare* *Rebelution, LLC v. Perez*, 732 F. Supp. 2d 883, 887 (N.D. Cal. 2010) ("The Ninth Circuit has adopted the *Rogers* test, however, it has placed an important threshold limitation upon its application: plaintiff's mark must be of such cultural significance that it has become an integral part of the public's vocabulary."), *with* *Stewart Surfboards, Inc. v. Disney Book Group, LLC*, No. 10-2982, 2011 U.S. Dist. LEXIS 155444, at \*10-11 (C.D. Cal. May 11, 2011) ("Expressive speech containing references to cultural icons with broad public recognition does not enjoy any greater First Amendment protection than expressive speech making only obscure references. Thus, there is no basis for applying the *Rogers* test only when the expressive or artistic speech makes reference to culturally significant marks."). The district court in *Virag* rejected the argument that the *Rogers* test applies only to culturally significant marks. *Virag*, 2015 U.S. Dist. LEXIS 111211, at \*28-30. Requiring cultural significance as a threshold requirement for the application of the *Rogers* test now appears to be the minority view among the district courts. *See* *Twentieth Century Fox TV v. Empire Distrib.*, 161 F. Supp. 3d 902, 906-07 (C.D. Cal. 2016).

<sup>15</sup> *See* *Brown v. Entm't Merchs. Ass'n*, 131 S. Ct. 2729, 2733 (2011).

<sup>16</sup> Litigants, much like law students in class, often argue that because expressive works are sold for profit, these works must constitute commercial speech, but courts, like professors, keep explaining this is not how courts define commercial speech for First Amendment purposes. *See, e.g.,* *Argello v. City of Lincoln*, 143 F.3d 1152, 1153 (8th Cir. 1998) ("The City [of Lincoln, Nebraska] contends that the ordinance [restricting fortunetelling] can be upheld as a regulation of commercial speech. It reads the ordinance as limited to fortunetelling for pay. The ordinance is not so limited on its face, nor has any court of Nebraska given it such a limiting construction. Even if it were so limited, we do not

newspapers must be free to report and comment upon people, products, and businesses by name without the need to ask for permission. A need for permission would deter critical coverage, and critical coverage provides valuable information to the public. Even the National Football League would not pressure newspaper reporters to refer to the Super Bowl as “the big game” in sports stories.<sup>17</sup> When it comes to fiction—and fiction, not hard news, dominates the video game medium—it may not be as obvious that the free use of names, likenesses, and trademarks outweighs the interests of real-world people and real-world trademark owners to control when and how they or their marks appear in the media. Nevertheless, courts do recognize that there are significant First Amendment interests in entertainment and fiction,<sup>18</sup> and they also recognize First Amendment interests in using real-world people and trademarks in expressive, non-commercial speech, whether fiction, non-fiction, or something in-between.<sup>19</sup> There are limits, however, and even when the limits are not exceeded, the unlicensed use of names or trademarks in various expressive works, including video games, can result in false association claims brought under the Lanham Act, as well as state law claims, such as infringement of the right of publicity.

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believe this proscription would fall into the commercial-speech category. The speech itself, fortunetelling, is not commercial simply because someone pays for it. The speech covered by the ordinance, for the most part, does not simply propose a commercial transaction. Rather, it *is* the transaction. The speech itself is what the ‘client’ is paying for.” (emphasis in original); *Int’l Brominated Solvents Ass’n v. Am. Conf. of Governmental Industrial Hygienists, Inc.*, No. 04-0394, 2004 U.S. Dist. LEXIS 27605, at \*18 (M.D. Ga. Nov. 26, 2004) (“Plaintiffs assert that, because [defendant’s] manuals are sold for profit, the act of publishing the [manual] is commercial speech and, therefore, not entitled to the constitutional protection afforded by the prior restraint doctrine. This argument mischaracterizes the types of speech regarded as commercial for purposes of the First Amendment.”). For First Amendment purposes, commercial speech is often defined as speech that “does no more than propose a commercial transaction,” such as a traditional advertisement, but commercial speech probably includes somewhat more than the quoted phrase literally suggests. *See Harris v. Quinn*, 134 S. Ct. 2618, 2639 (2014) (discussing the difference between commercial and non-commercial speech); *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 515-17 (7th Cir. 2014) (same); *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1016-18 (3d Cir. 2008) (same).

<sup>17</sup> *See Terry Tang, Businesses Stay Clear of Using Super Bowl Name*, ASSOCIATED PRESS, Jan. 30, 2015 (“It is the game that must not be named—at least not without permission.”). The author of the article, perhaps based on her communications with an NFL spokesperson, added that news organizations can use the term because “a fair use exception allows for news organizations to use the Super Bowl moniker.” *Id.* The author did not mention whether such uses would even be likely to cause consumer confusion nor did she mention the role of the First Amendment.

<sup>18</sup> *See Winters v. New York*, 333 U.S. 507, 510 (1948) (“We do not accede to appellee’s suggestion that the constitutional protection for a free press applies only to the exposition of ideas. The line between the informing and the entertaining is too elusive for the protection of that basic right. Everyone is familiar with instances of propaganda through fiction. What is one man’s amusement, teaches another’s doctrine.”).

<sup>19</sup> *See, e.g., Rogers*, 875 F.2d at 997 (“Movies, plays, books, and songs are all indisputably works of artistic expression and deserve protection . . . Though First Amendment concerns do not insulate titles of artistic works from all Lanham Act claims, such concerns must nonetheless inform our consideration of the scope of the Act as applied to claims involving such titles.”). As a related example involving the use of a person’s identity and the right of publicity, *see* RESTATEMENT (THIRD) UNFAIR COMPETITION § 47 (1995) (“[U]se ‘for purposes of trade’ does not ordinarily include the use of a person’s identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.”).

Just as the reconciliation of the right of publicity with the First Amendment is “all over the map,”<sup>20</sup> so too is the reconciliation of the Lanham Act with the First Amendment. In Lanham Act cases, however, the disagreement among the courts is less obvious because most courts claim to follow the same test, the *Rogers* test. Plus, the outcomes of cases actually litigated to a judicial decision tend to be consistent. But *Rogers* comes in three versions, which I’ll refer to as *Rogers* I, *Rogers* II, and *Rogers* III. Each purport to offer First Amendment protection to media defendants from Lanham Act claims, but as will be discussed in more detail below, they are not equal. *Rogers* I offers the most First Amendment protection, *Rogers* II offers less, and *Rogers* III offers no special protection at all. Perhaps this inconsistency partially explains why lawsuits continue despite the often similar outcomes.

Why focus on video games in a discussion of this issue? In part, it’s because video game cases make up a significant portion of the recent cases in the *Rogers* line, particularly in the Ninth Circuit. There is also good reason to worry that video games are still treated differently by courts than other, more traditional forms of media. The cases involving the right of publicity suggest as much, even after the Supreme Court’s decision in 2011.<sup>21</sup> A comment from the bench during the oral argument in *Davis v. Electronic Arts, Inc.* (September 2014) is suggestive of the lack of familiarity with the gaming medium that video game producers can face in dealing with government decision-makers.<sup>22</sup> *Davis* involved claims by retired NFL players that Electronic Arts (“EA”) violated their rights of publicity by using their identities in the *Madden NFL* games.<sup>23</sup> The following exchange between Judge Marsha Berzon and EA’s attorney Alonzo Wickers was prompted by Wickers’ suggestion that right of publicity cases involving greetings cards and t-shirts are distinguishable from cases involving video games or other expressive works.

BERZON: In other words, the video game is more of an expressive work than a greeting card or a t-shirt?

WICKERS: A video game is *per se* an expressive work, your honor.

BERZON: What does that mean, *per se*?

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<sup>20</sup> Br. of 31 Constitutional Law Professors and Intellectual Law Professors as *Amici Curiae* in Support of Petitioner at 24, *Electronic Arts v. Davis*, No. 15-424 (9th Cir. Nov. 4, 2015), *cert. denied*, 136 S. Ct. 1448 (2016).

<sup>21</sup> See generally William K. Ford & Raizel Liebler, *Games Are Not Coffee Mugs: Games and the Right of Publicity*, 29 SANTA CLARA COMPUT. & HIGH TECH L.J. 1 (2013). See also DAVID S. WELKOWITZ & TYLER T. OCHOA, *CELEBRITY RIGHTS: RIGHTS OF PUBLICITY AND RELATED RIGHTS IN THE UNITED STATES AND ABROAD* 386 (2010) (“[A]s a practical matter, traditional media get more respect when the First Amendment implications of their works are assessed.”).

<sup>22</sup> This lack of familiarity can be found in other contexts as well, such as state legislatures trying to restrict minors’ access to violent video games. See William K. Ford, *The Law and Science of Video Game Violence: Who Lost More in Translation?*, in TRANSLATING THE SOCIAL WORLD FOR LAW, at 107, 126-129 (Elizabeth Mertz, William K. Ford, & Gregory M. Matoesian eds., 2016).

<sup>23</sup> See *Davis v. Electronic Arts*, 775 F.3d 1172, 1175-76 (9th Cir. 2015), *cert. denied*, 136 S. Ct. 1448 (2016).

WICKERS: You can have a t-shirt, for example—the one I’m wearing under my shirt today, your honor, has no content on it, no expression. It’s not an expressive work. The court, however—

BERZON: How about a greeting card?

WICKERS: A greeting card can be—you can have a plain greeting card that has no message on it.

BERZON: Well, I know, but 99% of greeting cards, it seems to me, have pictures and they have writing and they’re at least as expressive as a video game, *probably more so*.<sup>24</sup>

Regardless of whether greetings cards are properly labeled *per se* expressive works, the suggestion that video games fall somewhere *below* greeting cards on even a vague measure of expressive content is striking.

As a medium for images and text, greeting cards could be as original, memorable, profound, and timeless as any other type of expressive work. But whatever the theoretical possibilities, the greeting card medium has mostly failed to rise beyond the ephemeral. A notable image, passage of text, or character may end up on a greeting card, but such things rarely originate on one.<sup>25</sup> The lasting value of any particular card almost certainly lies with the identity of the giver, the comments he or she adds to the card, and/or the circumstances under which it is given, but not with the original work of the greeting card artist and/or writer. While Judge Berzon’s comparison between greeting cards and video games may have been a sort of softball comment not really reflective of her views,<sup>26</sup> it more likely reflects a dismissive view of the medium.<sup>27</sup>

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<sup>24</sup> Oral Argument at 00:09:33, *Davis v. Electronic Arts, Inc.*, No. 12-15737 (9th Cir. Sept. 11, 2014) (emphasis added), *available at* [https://www.youtube.com/watch?v=\\_hlz3cx6IWQ](https://www.youtube.com/watch?v=_hlz3cx6IWQ). Some minor verbal stumbles (or disfluencies) are omitted.

<sup>25</sup> Exceptions are hard to come by. One example where a creative work originated on a greeting card and then achieved some cultural impact and enduring recognition is Hallmark’s elderly curmudgeon character Maxine (and her dog Floyd). Maxine was created by John Wagner in 1986 and then appeared on greeting cards, T-shirts, coffee mugs, and ornaments, and in calendars and books from the 1980s to the present. *See* PATRICK REGAN, *HALLMARK: A CENTURY OF CARING* 232-33 (2009). Perhaps a second example is the cat and rabbit duo Hoops and Yoyo, who appear on greetings cards, television specials, and elsewhere, but they first appeared on e-cards, so maybe the example is slightly off. *See* Ben Paynter, *Creating: Mike Adair and Bob Holt, Greeting Card Artists: Two Guys, a Cat and a Funny Green Bunny*, *WALL ST. JOURNAL*, May 12, 2012, at C11. One practical limitation on individual greeting cards achieving greater notice is that, unlike books, films, poems, and paintings, they lack clear titles. Based on my discussion with the workers at a local Hallmark store, a particular Maxine card I purchased is designated, at least for their purposes, as only MXN 111-4, not by a title. On the Hallmark.com website it’s designated, “Inside This Card Funny Birthday Card.”

<sup>26</sup> *See, e.g.*, Rachel Clark Hughey, *Effective Appellate Advocacy before the Federal Circuit: A Former Law Clerk’s Perspective*, 11 J. APP. PRAC. & PROCESS 401, 435-36 (2010) (“Sometimes one of the judges will throw a softball question—one that actually helps your case. Too many attorneys assume all questions are bad and immediately react that way.”).

<sup>27</sup> *See* Ford & Liebler, *supra* note 21, at 43-46 (2013).

As is often pointed out, the gaming medium may still lack its *Citizen Kane*,<sup>28</sup> but it has gone well beyond producing only the disposable and forgettable.<sup>29</sup>

Unfortunately, scholars have not documented, at least in any systematic way, the extent to which clearance practices in the trademark area vary across different forms of media, but it's likely that video game producers operate with less creative freedom than producers in mediums like film and television, to say nothing of books and newspapers. Consider this statement about the rights of filmmakers to show trademarks in their works in a leading book on clearance practices in the film and television industry:

A filmmaker's right to include trademarks within a film is clear. You have a right to include them in your film as long as the trademark or product bearing the trademark is used as it was intended to be used without any consequences of its use being abnormal or out of the ordinary.<sup>30</sup>

The qualification in the second sentence is due to worries about how a trademark owner or a court might react when a product is misused, which is perhaps an overstated concern with regard to a court,<sup>31</sup> but contrast this relative freedom to show a trademark with a similar book on video games:

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<sup>28</sup> See Helen Lewis, *Here Comes the Angry Birds Film, but Why Can't a Game Just Be a Game?*, THE OBSERVER (London), May 8, 2016 ("Films get taken seriously by 'serious people', and so the question 'what is the *Citizen Kane* of video games?' has long since become a cliché among games journalists."); *Citizen Kane* (RKO 1941).

<sup>29</sup> See, e.g., Ford & Liebler, *supra* note 21, at 67-72.

<sup>30</sup> MICHAEL C. DONALDSON & LISA A. CALLIF, CLEARANCE & COPYRIGHT 312 (4th ed. 2014).

<sup>31</sup> Due to a lack of actual cases involving films—but see *Films of Distinction v. Allegro Film Prods.*, 12 F. Supp. 2d 1068, 1081-82 (C.D. Cal. 1998)—the authors offer two hypothetical examples of trade libel, but neither of them is compelling. See DONALDSON & CALLIF, *supra* note 30, at 312-13. Generally speaking, trade libel requires a false statement of fact. See *Seaton v. TripAdvisor LLC*, 728 F.3d 592, 602 (6th Cir. 2013); J. THOMAS MCCARTHY, 5 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27:109 (4th ed. 2017); RESTATEMENT (SECOND) OF TORTS, §§ 623A, 626 (1977). See generally Michael A. Albert & Robert L. Bocchino Jr., *Trade Libel: Theory and Practice Under the Common Law, The Lanham Act, and the First Amendment*, 89 TRADEMARK REP. 826 (1999). Consistent with the point, Donaldson & Callif define trade libel as follows: "Trade libel occurs when a product or service is falsely accused of some bad attribute." DONALDSON & CALLIF, *supra* note 30, at 312. Their examples lack this element of falsity, however. Indeed, they seem to drop the falsity requirement by the end of the discussion. Their first example is depicting someone in a film dying from a poisoned Coca-Cola or McDonald's hamburger. They say this would be an example of trade libel. *Id.* But why would this be true if the poisoning is clearly a fictional plot device rather than a claim about these products in the real world? The other example is based on Anheuser-Busch's real-world objection to certain scenes in *Flight* (Paramount Pictures 2012), a film in which a substance-abusing pilot drinks recognizable brands of alcohol while driving and flying, including Budweiser. *Id.* at 313. They note Anheuser-Busch never sued. Why? "Surely they knew they would not win," they say. *Id.* Why is that? Donaldson and Callif don't provide a clear answer, but presumably, it's that there was no false statement of fact. Yet they still add this "stipulation" to the creative freedom of filmmakers in their conclusion: "courts side with the creative community when it comes to featuring real products in movies and television shows, as the real products were meant to be used." *Id.* (emphasis added). If this was true, then the *Flight* example would be a *winner* for Anheuser-Busch, not a loser. After all, Budweiser and other alcoholic products are not meant to be used while driving a car or piloting a plane. See, e.g., 14 CFR 91.17(a) (2017).

Donaldson and Callif seem to be blurring trade libel and dilution. Earlier versions of the book contained this warning in the section on trade libel: "You do not have the right to hold the product up



[D]evelopment teams must be careful that they do not include assets in the game that are trademarked or copyrighted—unless the legal rights are obtained to do so. For example, Coca-Cola® vending machines and Crayola® crayons cannot be used in games without contacting the companies that own these properties and finalizing a contract to use these rights.<sup>32</sup>

Another guide to video game law acknowledges that the First Amendment might protect the use of trademarks in video games, but emphasizes the practical reality that developers usually want “to avoid an unnecessary and expensive legal battle.”<sup>33</sup> In any medium, producers will sometimes (or even often) clear trademarks to avoid legal problems, but established practices and disparate judicial treatment in the past likely leave video game producers with a greater worry about provoking litigation. Minimizing these worries requires a very clear rule about when creative uses of marks will be protected. Only one version of the *Rogers* test represents a very clear rule and that’s the original version.

### III. FALSE ASSOCIATION/ENDORSEMENT

A basic purpose of the Lanham Act is to prevent consumer confusion about the source or origin of goods, but the Act reaches further than just source confusion. It also covers situations where the use of a mark is likely to cause confusion about the “affiliation, connection, or association” between the owner of a mark and the producer of a good,<sup>34</sup> what are usually labeled false association or false endorsement claims.<sup>35</sup>

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to ridicule or do anything that harms the reputation of the product.” MICHAEL C. DONALDSON, CLEARANCE AND COPYRIGHT 183 (1996). The First Amendment consequences of such a broad rule against tarnishment would be severe. They do mention possible dilution claims explicitly, DONALDSON & CALLIF, *supra* note 30, at 313-17, but the dilution provisions of the Lanham Act do not apply to non-commercial uses, which should block most of these types of claims where a mark is shown within an expressive work. See 15 U.S.C. § 1125(c)(3)(C); *Mattel*, 296 F.3d at 902-07 (discussing the meaning of “noncommercial” uses under the dilution provisions of the Lanham Act). Cf. *American Dairy Queen Corp. v. New Line Prods.*, 35 F. Supp. 2d 727, 732 (D. Minn. 1998) (applying the dilution provisions to the title of a film). However, from a practical standpoint—and they point this out—the misuse of a real-world product may increase the likelihood that a trademark owner will object, DONALDSON & CALLIF, *supra* note 30, at 313, and objections in the form of litigation are costly, regardless of the merits. Perhaps they are actually blurring the doctrinal with the practical.

<sup>32</sup> HEATHER MAXWELL CHANDLER, THE GAME PRODUCTION HANDBOOK 57 (3d ed. 2014).

<sup>33</sup> THE AMERICAN BAR ASSOCIATION’S LEGAL GUIDE TO VIDEO GAME DEVELOPMENT 108 (Ross Dannenberg ed., 2011).

<sup>34</sup> 15 U.S.C. § 1125(a)(1)(A).

<sup>35</sup> See, e.g., *Barrus v. Sylvania*, 55 F.3d 468, 469-70 (9th Cir. 1995) (referring to the “so-called ‘false association’ prong of section 43 of the Lanham Act”); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992) (“A false endorsement claim based on the unauthorized use of a celebrity’s identity is a type of false association claim[.]”). The same claim might be labeled as a false designation of origin claim, which is somewhat inaccurate when the confusion is about *association* rather than who produces the good, but the courts ultimately treat these claims in the same way, regardless of the label. See *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000) (“A false designation of origin claim brought by an entertainer under § 43(a) of the Lanham Act in a case such as this is equivalent to a false association or endorsement claim . . . .”); *Armstrong v. Eagle Rock Entm’t, Inc.*, 655 F. Supp. 2d 779, 791 (E.D. Mich. 2009) (“Even though delineated as a ‘false designation of origin’ claim, Plaintiff seems to be arguing a ‘false endorsement’ claim.”). Claims brought under the

These claims can involve the use of a mark in advertisements or on utilitarian products<sup>36</sup> and also the use of a mark in the title or body of an expressive work, such as a book, film, or video game.<sup>37</sup> The “mark” in question can even be the name, likeness, or other indication of a real person, either living or dead.<sup>38</sup> In the present context, the basic problem is this: when consumers recognize a real-world trademark or a real person in a video game, they may think there is a licensing agreement between the video game producer and the trademark owner or person depicted. And there may indeed be a licensing agreement. After all, product placement deals are common. But when there isn’t a licensing agreement, the trademark owner or the person depicted may sue for false association. In an ordinary case of trademark infringement involving competing products, a court will focus on whether the use of a mark is likely to cause confusion using the traditional multi-factor test,<sup>39</sup> but in a case involving the use of a mark in an expressive work, a critical question is whether a defendant is entitled to a First Amendment defense to avoid liability.

The lower federal courts have struggled to offer a consistent means for reconciling the interests of Lanham Act plaintiffs with the First Amendment interests of defendants who produce expressive works. Courts sometimes omit any discussion of the First Amendment and simply consider whether an unlicensed use is likely to cause confusion, doing the best they can to apply the traditional likelihood of confusion factors in a false association context.<sup>40</sup> The Appendix provides examples of the various approaches. However, the dominant analysis in these cases comes from the Second Circuit’s decision in *Rogers v. Grimaldi*.<sup>41</sup> The *Rogers* test applies only to expressive

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infringement provision of 15 U.S.C. § 1114 may be treated as false association claims as well and subject to the same First Amendment analysis. See *American Dairy Queen*, 35 F. Supp. 2d at 732 (describing the claim brought under 15 U.S.C. § 1114 as at least involving confusion about whether the defendant “received [an] endorsement or permission [from the plaintiff] for use of its mark”).

<sup>36</sup> See, e.g., *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983). The court in *Carson* affirmed the district court’s conclusion that the use of the phrases “Here’s Johnny” and “The World’s Foremost Comedian” in association with portable toilets was not likely to cause confusion about Johnny Carson’s association with the product; however, the defendant’s use of the mark was still within the scope of section 43(a) of the Lanham Act. *Id.* at 833-34.

<sup>37</sup> See *University of Alabama Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1277-79 (11th Cir. 2012); *E.S.S. Entm’t*, 547 F.3d at 1099; *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 928 n.11 (6th Cir. 2003).

<sup>38</sup> See *Brown*, 724 F.3d at 1239 (“Although claims under § 43(a) generally relate to the use of trademarks or trade dress to cause consumer confusion over affiliation or endorsement, we have held that claims can also be brought under § 43(a) relating to the use of a public figure’s persona, likeness, or other uniquely distinguishing characteristic to cause such confusion.”). For the deceased in particular, see *Fifty-Six Hope Rd. Music, Ltd. v. A.V.E.L.A., Inc.*, 778 F.3d 1059, 1073 (9th Cir. 2015) (“[T]he fact of the celebrity’s death does not preclude a § 1125(a) claim.”); *A.V.E.L.A., Inc. v. Estate of Marilyn Monroe*, 131 F.Supp.3d 196, 208 (S.D.N.Y. 2015) (“Preliminarily, this Court rejects the Movants’ contention that there is a blanket prohibition against false endorsement claims involving deceased celebrities.”).

<sup>39</sup> See, e.g., *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979) (listing factors); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (same). See also J. THOMAS MCCARTHY, 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:28 (4th ed. 2017) (“The Multi-factor tests of infringement”).

<sup>40</sup> See, e.g., *Caterpillar Inc. v. Walt Disney Co.*, 287 F. Supp. 2d 913, 919 (C.D. Ill. 2003) (“This is not a case where the Court can apply the traditional likelihood of confusion factors with any degree of comfort.”).

<sup>41</sup> 875 F.2d 994 (2d Cir. 1989). See MCCARTHY, *supra* note 2, at § 31:144.50.

works, not to advertisements.<sup>42</sup> The test requires consideration of two questions: (1) does the mark have “artistic relevance to the underlying work,” and if so, (2) is the use “explicitly mislead[ing] as to the source or the content of the work[?]”<sup>43</sup> The standard for artistic relevance is very low.<sup>44</sup> Only on occasion will a defendant stumble on the first part of the *Rogers* test.<sup>45</sup> It’s the second part of the test that causes more problems because courts interpret this prong of the test in different ways, even within the same circuit.

As a result of these variations, it’s plausible to speak of three *Rogers* tests, *Rogers* I, *Rogers* II, and *Rogers* III.<sup>46</sup> *Rogers* I is the original, the classic. It’s what is described in the *Rogers* decision itself. *Rogers* I provides strong First Amendment protection, as the *Rogers* defense cannot be overcome by a likelihood of confusion using the traditional likelihood of confusion factors. Instead, the plaintiff must show that a defendant *explicitly* misled consumers through some false statement of association.<sup>47</sup> The plaintiff must point to some “explicit indication,’ ‘overt claim,’ or ‘explicit misstatement’” by the defendant.<sup>48</sup>

*Rogers II*, by contrast, provides moderate—or at least unpredictable—First Amendment protection. This approach originated in two Second Circuit decisions purporting to follow *Rogers*. One is *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group*, decided in 1989 just a few months after *Rogers*.<sup>49</sup> The other is *Twin Peaks Productions, Inc. v. Publications International, Ltd.*, decided in 1993.<sup>50</sup> Under this approach, the court initially considers the traditional likelihood of confusion factors, but then balances the extent of the confusion with the First Amendment according to an ill-defined standard. *Cliffs Notes* calls for a court to give “proper weight” to the “First Amendment considerations.”<sup>51</sup> What counts as the “proper weight” is not very clear. In *Cliffs Notes*, the Second Circuit found the First Amendment protected the

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<sup>42</sup> *Rogers*, 875 F.2d at 999. See also *Brown*, 724 F.3d at 1241 (“The *Rogers* test is reserved for expressive works.”).

<sup>43</sup> *Rogers*, 875 F.2d at 999.

<sup>44</sup> *Id.* See also *E.S.S. Entm’t*, 547 F.3d at 1100 (“[T]he level of relevance merely must be above zero.”).

<sup>45</sup> See *Parks v. LaFace Records*, 329 F.3d 437, 452-58 (6th Cir. 2003) (holding that there was a genuine issue of material fact as to whether the use of Rosa Parks’ name as the title for a song was artistically relevant to the song).

<sup>46</sup> The variations in the *Rogers* line of cases have been covered by others. Particularly relevant to the present discussion, and one of the most detailed discussions of the topic, is Thomas M. Byron, *Spelling Confusion: Implications of the Ninth Circuit’s View of the “Explicitly Misleading” Prong of the Rogers Test*, 19 J. INTELL. PROP. L. REV. 1, 9-16 (2011). See also Elizabeth L. Rosenblatt, *Rethinking the Parameters of Trademark Use in Entertainment*, 61 FLA. L. REV. 1011, 1071-72 (2009). District court judges trying to follow circuit precedent sometimes discuss the problem as well. See *Stewart Surfboards, Inc. v. Disney Book Group, LLC*, No. 10-2982, 2011 U.S. Dist. LEXIS 155444, at \*19-25 (C.D. Cal. May 11, 2011).

<sup>47</sup> *Rogers*, 875 F.2d at 999 (“We believe that in general the [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression. In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.”).

<sup>48</sup> *Brown*, 724 F.3d at 1245 (quoting *Rogers*, 875 F.2d at 1001).

<sup>49</sup> 886 F.2d 490 (2d Cir. 1989).

<sup>50</sup> 996 F.2d at 1379.

<sup>51</sup> *Cliffs Notes*, 886 F.2d at 495 n.3.

defendant because there was “only a slight risk of consumer confusion.”<sup>52</sup> *Twin Peaks* says a plaintiff must make a “particularly compelling” showing of confusion.<sup>53</sup> What counts as “particularly compelling” was not resolved because the Second Circuit remanded the case to the district court to consider the question in the first instance.<sup>54</sup> Either way, *Rogers II* calls for a vague balancing of interests, though one weighted in favor of a media defendant.

Unlike *Rogers I* and *II*, *Rogers III* doesn’t even make sense. Under *Rogers III*, what counts as explicitly misleading is no more than what is likely to cause confusion. The Ninth Circuit’s 2008 decision in *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*,<sup>55</sup> is the source of the problem. In *E.S.S. Entertainment*, the court considered what was essentially a false association claim made by the owner of the Play Pen Gentlemen’s Club against Rockstar Games, Inc., the producer of *Grand Theft Auto: San Andreas*.<sup>56</sup> The game includes a strip club called the Pig Pen inspired by and sharing some similarities with the plaintiff’s real-world Play Pen club.<sup>57</sup> The district court granted Rockstar summary judgment based on its First Amendment defense and the Ninth Circuit affirmed.<sup>58</sup>

The court of appeals’ discussion of the *Rogers* test, is the issue, not the outcome. The Ninth Circuit had adopted the *Rogers* test in an earlier decision, one that seems fairly characterized as a *Rogers I* case. In that earlier case, *Mattel, Inc. v. MCA Records*,<sup>59</sup> the court held that the First Amendment protected the defendants’ use of the term “Barbie” in the song “Barbie Girl” against claims brought by Mattel, the maker of the Barbie line of dolls.<sup>60</sup> The court did not consider whether there was a likelihood of confusion, but only whether the use of the mark was explicitly misleading.<sup>61</sup>

In applying the *Rogers* test in *E.S.S. Entertainment*, the Ninth Circuit had little trouble concluding the strip club was artistically relevant to *Grand Theft Auto: San*

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<sup>52</sup> *Id.* at 497.

<sup>53</sup> *Twin Peaks*, 996 F.2d at 1379 (“The question then is whether the title is misleading in the sense that it induces members of the public to believe the Book was prepared or otherwise authorized by [the plaintiff]. This determination must be made, in the first instance, by application of the venerable *Polaroid* factors. However, the finding of likelihood of confusion must be particularly compelling to outweigh the First Amendment interest recognized in *Rogers*.”) (internal citation omitted).

<sup>54</sup> *Id.*

<sup>55</sup> 547 F.3d 1095 (9th Cir. 2008). The defendant was actually Rock Star Games, Inc., but the plaintiff made a mistake in the original complaint. See *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp. 2d 1012, 1014 n.1 (C.D. Cal. 2006) (noting the mistake), *aff’d*, *E.S.S. Entm’t*, 547 F.3d at 1101.

<sup>56</sup> The complaint labels the relevant claim “Federal Trade Dress Infringement and Unfair Competition [Lanham Act 15 U.S.C., § 1125(a)]” and includes four additional and largely duplicative state law claims. See Complaint at 1, *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, No. 05-2966 (C.D. Cal. April 28, 2005) (listing claims) (bracketed material in original); *E.S.S. Entm’t*, 444 F. Supp. 2d at 1049 (noting that “[t]he legal framework used to analyze these [state law] claims is substantially the same as the framework used to evaluate Lanham Act claims under federal law”).

<sup>57</sup> See *E.S.S. Entm’t*, 547 F.3d at 1097-98.

<sup>58</sup> *Id.* at 1098.

<sup>59</sup> See *Mattel*, 296 F.3d 894 (9th Cir. 2002).

<sup>60</sup> *Mattel*, 296 F.3d at 902.

<sup>61</sup> See *id.*

*Andreas*. The Play Pen is an East Los Angeles strip club.<sup>62</sup> The game includes a “cartoon-style parody” of East Los Angeles.<sup>63</sup> Clearly, the strip club is relevant to the game. But is the appearance of a similar club in the game explicitly misleading? In reframing this inquiry, the court said, “The relevant question, therefore, is whether the Game would confuse its players into thinking that the Play Pen is somehow behind the Pig Pen or that it sponsors Rockstar’s product.”<sup>64</sup> Under *Rogers* I, this is not at all the relevant question. The relevant question is whether the use was *explicitly* misleading, not whether consumers are likely to be confused.

Is *E.S.S. Entertainment* a *Rogers* II case, one that requires the plaintiff to make some heightened showing of confusion? The Ninth Circuit’s entire analysis consisted of a discussion of why confusion was unlikely, though it wasn’t even the right sort of confusion. The court said no one would think E.S.S. produced the game or provided any strip club expertise to Rockstar, but there is no indication E.S.S. made either argument. E.S.S. instead argued in its brief that the use of its marks communicated to consumers that E.S.S. endorsed the game, not that E.S.S. produced the game or designed the virtual strip club.<sup>65</sup> During the oral argument, E.S.S. repeatedly referred to the game implying sponsorship or association, not confusion about origin.<sup>66</sup> Regardless, is *E.S.S. Entertainment* a *Rogers* II case? Maybe, but at no point did the court say E.S.S. would need to make a heightened showing of confusion.

What about *Rogers* III then, where “explicitly misleading” simply means likely to cause confusion? A lack of any special First Amendment protection in these false association cases would not be unheard of. Various decisions have suggested that the likelihood of confusion test is itself enough to prevent First Amendment problems.<sup>67</sup> On the other hand, the Ninth Circuit implied it would not interpret the *Rogers* test to reduce the First Amendment to no defense at all.<sup>68</sup> The plaintiff always has the burden to show a likelihood of confusion in an infringement case brought under the Lanham Act.<sup>69</sup> Without a likelihood of confusion, there is no need for a defense, *Rogers* or otherwise. If the *E.S.S. Entertainment* decision does equate the term “explicitly misleading” with “a likelihood of confusion,” then the *Rogers* test would be meaningless, and the First Amendment would indeed be no defense at all. So, which

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<sup>62</sup> See *id.*

<sup>63</sup> See *E.S.S. Entm’t*, 547 F.3d at 1100.

<sup>64</sup> *Id.*

<sup>65</sup> See Opening Br. of Appellant at 24, *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, No. 06-56237 (9th Cir. March 9, 2007) (“The wholesale utilization of E.S.S.’s trademarks and trade dress and the prominence given to the club which they identify sends a clear message of endorsement by the owner of that intellectual property.”); *id.* at 37 (stating that “the claim of infringement is based not on competition between the parties but on the creation of an unauthorized implication of endorsement, sponsorship or other association.”).

<sup>66</sup> Oral Argument at 00:03:45, *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, No. 06-56237 (9th Cir. March 5, 2008).

<sup>67</sup> See *Parks*, 329 F.3d at 447-48.

<sup>68</sup> See *E.S.S. Entm’t*, 547 F.3d at 1099 (“[A] trademark infringement claim presupposes a use of the mark. If that necessary element in every trademark case vitiated a First Amendment defense, the First Amendment would provide no defense at all.”).

<sup>69</sup> See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 117-21 (2004); *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1183 (9th Cir. 2010) (“[A]s the Supreme Court has unambiguously instructed, the Lanham Act always places the ‘burden of proving likelihood of confusion . . . on the party charging infringement.’”) (quoting *KP Permanent Make-Up*, 543 U.S. at 118).

is it, *Rogers II* or *Rogers III*? As one district court judge said in reviewing these cases, “The Ninth Circuit has not made its approach clear.”<sup>70</sup> The upshot of *E.S.S. Entertainment* was that district courts in the Ninth Circuit had the flexibility to put whatever weight on the First Amendment they chose. Two district court decisions following *E.S.S. Entertainment* involving video games provide examples, one a *Rogers III* case from 2012 and the other a *Rogers I* case from 2013.

In 2012, the Northern District of California applied the *Rogers III* test in *Electronic Arts, Inc. v. Textron, Inc.*<sup>71</sup> Electronic Arts produced the *Battlefield 3* video game and used the trademarks and trade dress in the game for three military helicopters owned by Textron Innovations and produced by Bell Helicopter Textron Inc. EA did not ask for permission to use these helicopters in the game, and Textron accused EA of infringement.<sup>72</sup> The parties had a history of litigating this issue in another court involving other games.<sup>73</sup> This time, EA filed for a declaratory judgment of non-infringement.<sup>74</sup> Textron responded with multiple counterclaims, the bottom line of which was a claim of false association. EA argued the court should apply the *Rogers* test and dismiss these claims rather than consider whether confusion was likely.<sup>75</sup> The district court responded to EA’s motion to dismiss as follows:

Our court of appeals in *E.S.S.* . . . looked at “whether the Game would confuse its players into thinking that the Play Pen is somehow behind the Pig Pen or that it sponsors Rockstar’s product” when it evaluated the second prong of the *Rogers* test. Our court of appeals considered that the strip club was “incidental” to the game; consumers would not “reasonably have believed that ESS produced the video game;” it was “far-fetched that someone playing [the game] would think ESS had provided whatever expertise, support, or unique strip-club knowledge it possesses to the game;” and “the chance to attend a virtual strip club is unambiguously not the main selling point of the Game.” In contrast, here, it is plausible that consumers could think Textron provided expertise and knowledge to the game in order to create its realistic simulation of the actual workings of the Bell-manufactured helicopters. Textron alleges that its helicopters are “given particular prominence” as opposed to being

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<sup>70</sup> *Stewart Surfboards, Inc. v. Disney Book Group, LLC*, No. 10-2982, 2011 U.S. Dist. LEXIS 155444, at \*23 (C.D. Cal. May 11, 2011).

<sup>71</sup> *See Elec. Arts, Inc. v. Textron Inc.*, No. 12-0118, 2012 U.S. Dist. LEXIS 103914 (N.D. Cal. July 25, 2012).

<sup>72</sup> *Id.* at \*3.

<sup>73</sup> *Id.* at \*2-3. *See generally* Plaintiffs’ Second Amended Original Complaint, *Bell Helicopter Textron Inc. v. Elec. Arts, Inc.*, No. 06-0841 (N.D. Tex. May 1, 2007). In commenting on this earlier litigation back in 2010, I speculated that the case would have come out favorably to Electronic Arts in the courts in the Ninth Circuit, based on the ruling in *E.S.S. Entertainment*. *See* William K. Ford & Ben D. Manevitz, *Implications of Video Games and Virtual Worlds in Trademark Law* 145, 181, in *COMPUTER GAMES AND VIRTUAL WORLDS* (Ross A. Dannenberg, Steve Mortinger, Roxanne Christ, Chrissie Scelsi & Farnaz Alemi eds., 2010). Given the outcome in the later *Textron* case in the Northern District of California, the prediction looks wrong (though cases like *Novalogic* suggest it would have come down to the assigned judge). At the time, I did not read *E.S.S. Entertainment* as endorsing the *Rogers III* approach. Again, this approach makes no sense, *see supra* note 55 and accompanying text, but the 2012 *Textron* decision makes clear the confusion that can arise from *E.S.S. Entertainment*.

<sup>74</sup> *Elec. Arts*, 2012 U.S. Dist. LEXIS 103914, at \*2-3.

<sup>75</sup> *Id.* at \*11.

merely “incidental,” and the ability to control vehicles such as the helicopters in question is a major reason for the game’s success; therefore, consumers could plausibly think Textron sponsored the game. Although consumers are unlikely to think Textron has entered the video-game business, Textron has alleged sufficient facts to support the inference that the game explicitly leads consumers to believe it is “somehow behind” or “sponsors” *Battlefield 3*.<sup>76</sup>

In other words, the court thought the use of the marks might be explicitly misleading. Why? Because it’s plausible that consumers are confused about the association between the parties, particularly because of the prominent use of the marks. Prominence was not considered a problem in cases like *Mattel*, where the Barbie mark was part of the song title and song lyrics, but *Mattel* was a *Rogers* I case. *Textron* is a *Rogers* III case, and *Rogers* III requires no more than asking whether consumers are likely to be confused, and consumers probably do think licensing is the norm in the video game industry, absent a parody or some obvious modifications to the mark.<sup>77</sup>

In 2013, by contrast, the Central District of California followed *E.S.S. Entertainment* in *Novalogic, Inc. v. Activision Blizzard*,<sup>78</sup> but this time, the district court applied *Rogers* I. Novalogic owns registered trademarks in both the text DELTA FORCE and in the design of a Delta Force Logo, both for use with computer and video games.<sup>79</sup> Activision used the term “Delta Force” and a similar logo in *Call of Duty: Modern Warfare 3* video game. Penguin Group (USA) Inc. published the official strategy guide, which also used these marks.<sup>80</sup> Novalogic sued. In response to a motion for summary judgment by Activision and Penguin, the court, citing *Mattel* and *E.S.S. Entertainment*, applied the *Rogers* test and held that these uses are protected by the First Amendment.

The court started its analysis with the general observation that the *Rogers* test is “very protective of speech.”<sup>81</sup> In applying the two-part *Rogers* test, the court said the use of the marks “easily” satisfies the artistic relevance prong, largely because the marks contribute to the realism of the game due to the real-world existence of an elite Delta Force unit in the United States Army.<sup>82</sup> As for whether the uses were explicitly misleading, the court quoted a district court decision from the Southern District of Indiana calling for more than a likelihood of confusion: “To be ‘explicitly misleading,’ a defendant’s work must make some affirmative statement of the plaintiff’s

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<sup>76</sup> *Id.* at \*11-12 (internal citations omitted).

<sup>77</sup> Textron itself made this argument in the case: “Consumers of these games expect that the intellectual property of a party is used with the permission and approval of the mark’s owner, particularly when a purpose of the game is to realistically simulate the use of a product associated with the mark.” *Elec. Arts*, 2012 U.S. Dist. LEXIS 103914, at \*10.

<sup>78</sup> 41 F. Supp. 3d 885 (C.D. Cal. 2013). In the present discussion, Activision refers to both Activision Blizzard, Inc. and Activision Publishing, Inc. *See id.* at 889 n.1.

<sup>79</sup> *Id.* at 889. *See* DELTA FORCE, Registration No. 2,302,869; Registration No. 2,704,298.

<sup>80</sup> *See Novalogic*, 41 F. Supp. 3d at 892-93. *See also* MICHAEL OWEN ET AL., CALL OF DUTY: MW3 OFFICIAL STRATEGY GUIDE (2011). The description in the strategy guide of the “Black Tuesday Mission,” for example, uses both the term “Delta Force” and Activision’s version of the disputed logo. *See id.* at 8. Another issue in the case involved the use of the Delta Force logo on headphones manufactured by Turtle Beach, but this issue was not resolved in the summary judgment motion presently under discussion. *See Novalogic*, 41 F. Supp. 3d at 893.

<sup>81</sup> *Id.* at 900.

<sup>82</sup> *Id.*

sponsorship or endorsement, beyond the mere use of the plaintiff's name or other characteristic."<sup>83</sup> Novalogic was unable to provide any convincing evidence that Activision made such a statement.<sup>84</sup> The court went further and said that even if some consumers were confused, it would not matter because the confusion would not be due to an explicitly misleading statement by Activision.<sup>85</sup>

Just a few weeks after the district court decided *Novalogic*, the Ninth Circuit decided another case in the *Rogers* line, but this time, the court offered the most unmistakable endorsement yet of the *Rogers* I approach, an apparent vindication of *Novalogic* over *Textron*. In *Brown v. Electronic Arts*,<sup>86</sup> the Ninth Circuit considered a claim by retired football great Jim Brown that EA violated the Lanham Act by using his likeness in the *Madden NFL* football games without permission.<sup>87</sup>

The Ninth Circuit described the *Brown* case as similar to *E.S.S.*,<sup>88</sup> but it described the *Rogers* test in very different terms. As far as artistic relevance, there is no difference between *E.S.S. Entertainment* and *Brown*. The standard is low and as should be expected, the court viewed Brown's likeness as artistically relevant to a game that simulates professional football.<sup>89</sup> With regard to what qualifies as explicitly misleading, however, *Brown* is clearly a *Rogers* I decision.

In affirming the district court's dismissal of Brown's Lanham Act claim, the Ninth Circuit held that the First Amendment protected EA's use of Brown's likeness.<sup>90</sup> EA did not *explicitly* mislead consumers about his involvement with the game, even italicizing the word "explicitly" for emphasis more than once.<sup>91</sup> For Brown to prevail, he needed to identify some "explicit indication,' 'overt claim,' or 'explicit misstatement'" by EA.<sup>92</sup> Brown offered no (timely) examples of statements to consumers generally.<sup>93</sup> The court dismissed the relevance of any evidence of consumer confusion not tied to some explicit statement by Electronic Arts.<sup>94</sup> The fact that consumers may typically think marks are used in video games with licenses is also irrelevant.<sup>95</sup> No matter how many consumers are confused, EA's use is still protected,

<sup>83</sup> *Id.* at 901 (quoting *Dillinger, LLC v. Elec. Arts Inc.*, No. 09-1236, 2011 U.S. Dist. LEXIS 64006, at \*6 (S.D. Ind. June 16, 2011)).

<sup>84</sup> *Id.* at 903.

<sup>85</sup> *Id.* at 902-03 ("[E]ven assuming that some consumers might have mistakenly believe [sic] that some relationship exists between Activision and Plaintiff as a result of the use of the phrase 'Delta Force' and the MW3 Delta Force Logo in MW3, that mistaken belief on the part of those consumers would still not satisfy the second prong of the *Rogers* test.>").

<sup>86</sup> 724 F.3d 1235 (9th Cir. 2013).

<sup>87</sup> *Brown*, 724 F.3d at 1238-40.

<sup>88</sup> *Id.* at 1242-43.

<sup>89</sup> *Id.* at 1243 ("[I]t is obvious that Brown's likeness has at least some artistic relevance to EA's work.>").

<sup>90</sup> *Id.* at 1239, 1248.

<sup>91</sup> *Id.* at 1245, 1246.

<sup>92</sup> *Id.* at 1245 (quoting *Rogers*, 875 F.2d at 1001).

<sup>93</sup> Brown pointed to statements on the packaging of two versions of *Madden NFL* that said, 'Officially Licensed Product of NFL PLAYERS,' but the court did not consider this argument because it was not raised in Brown's opening brief. *Id.* at 1247 n.6.

<sup>94</sup> *Id.* at 1245 ("Adding survey evidence changes nothing."). See also *Twentieth Century Fox TV v. Empire Distrib.*, 161 F. Supp. 3d 902, 909 (C.D. Cal. 2016) ("[I]t is clear that no amount of evidence showing only consumer confusion can satisfy the 'explicitly misleading' prong of the *Rogers* test because such evidence goes only to the 'impact of the use' on a consumer.>").

<sup>95</sup> *Brown*, 724 F.3d at 1248.



absent an explicitly misleading statement by EA, and the court rejected any attempt to blur the line between what is explicitly misleading and what may inadvertently cause confusion.

The unusual clarity of the *Brown* decision may prevent future district courts or even appellate panels in the Ninth Circuit from backsliding into a *Rogers* II or III approach. Two subsequent video game cases provide some confirmation of *Brown*'s endurance.<sup>96</sup> The first is the 2014 decision by the Northern District of California in *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*<sup>97</sup> Mil-Spec Monkey ("MSM") sued Activision for including a digital version of MSM's "angry monkey" morale patch in *Call of Duty: Ghosts*.<sup>98</sup> A morale patch is a patch worn on non-official clothing by members of the military.<sup>99</sup> MSM's patch, as well as many other patches, can be added to highly customizable player avatars in *Call of Duty: Ghosts*.<sup>100</sup> MSM sued Activision claiming copyright infringement and several other claims all amounting to false association claims.<sup>101</sup> The district court, following *Brown*, found the patch artistically relevant to a realistic military-themed game and further found nothing explicitly misleading in Activision's use, as there was no evidence that Activision "affirmatively" misled consumers about its relationship with MSM.<sup>102</sup> The court therefore dismissed MSM's Lanham Act claims and its related state law claims.<sup>103</sup>

The second case is also a decision by the Northern District of California, the 2015 decision in *Virag, S.R.L. v. Sony Computer Entertainment America LLC*.<sup>104</sup> The plaintiffs were Virag, an Italian company that sells commercial flooring, and Marco Virag, one of the company's owners and a professional race car driver.<sup>105</sup> Virag sponsors the Rally of Monza at a racetrack in Italy, and Virag's mark appears on a bridge over the track.<sup>106</sup> This racetrack appears in two Sony video games, *Gran Turismo 5* and *Gran Turismo 6*, and Virag's mark appears on a bridge in the games.<sup>107</sup> Virag did not authorize this use of the mark.<sup>108</sup> In part, Virag sued for a violation of the Lanham Act.<sup>109</sup> In response to Sony's motion to dismiss, the district court applied the *Rogers* test, specifically, *Rogers* I.<sup>110</sup> As usual, the court found the mark was artistically relevant to the games, mainly because the mark appears at the real-world

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<sup>96</sup> An example of a non-video game case is *Twentieth Century Fox TV v. Empire Distrib.*, 161 F. Supp. 3d 902 (C.D. Cal. 2016).

<sup>97</sup> 74 F. Supp. 3d 1134 (N.D. Cal. 2014). As before, "Activision" refers to both Activision Blizzard, Inc. and Activision Publishing, Inc. See *id.* at 1136.

<sup>98</sup> *Id.* at 1136.

<sup>99</sup> *Id.* at 1136-37.

<sup>100</sup> *Id.* at 1138.

<sup>101</sup> *Id.* at 1136.

<sup>102</sup> *Id.* at 1143.

<sup>103</sup> *Mil-Spec Monkey*, 74 F. Supp. 3d at 1144.

<sup>104</sup> No. 15-1729, 2015 U.S. Dist. LEXIS 111211 (N.D. Cal. Aug. 21, 2015).

<sup>105</sup> *Id.* at \*3-4.

<sup>106</sup> *Id.* at \*2.

<sup>107</sup> *Id.* at \*5-8.

<sup>108</sup> *Id.* at \*8; Answer to First Amended Complaint by Defendants Sony Comput. Entm't Am. LLC and Sony Comput. Entm't Inc. at ¶ 32, *Virag, S.R.L. v. Sony Comput. Entm't Am. LLC*, No. 15-1729 (N.D. Cal. Sept. 4, 2015) ("Sony admits that it did not obtain a license or authorization directly from Virag or Mirco Virag.").

<sup>109</sup> *Virag*, 2015 U.S. Dist. LEXIS 111211, at \*2.

<sup>110</sup> *Id.* at \*27.

racetrack depicted in the games, and Sony's games emphasize realism.<sup>111</sup> As for the second prong, the court followed *Brown*, looked for an explicitly misleading statement of association and found none: "The plaintiffs do not allege or even suggest that the defendants explicitly indicated, claimed, or misstated that VIRAG was a source of content for *Gran Turismo 5* or *Gran Turismo 6* or sponsored *Gran Turismo 5* or *Gran Turismo 6*."<sup>112</sup> Virag argued consumers might assume its involvement with the game because of the company's activities in European racing, but under *Brown*, that is not enough.<sup>113</sup> The court therefore granted Sony's motion to dismiss Virag's Lanham Act claims.<sup>114</sup>

*Virag* does contain a wrinkle. Unsurprisingly, Virag argued the court should follow the *Textron* decision.<sup>115</sup> The district court distinguished *Textron* partly because it was decided before the Ninth Circuit's decision in *Brown*, which should have been the end of the discussion. But the court also distinguished *Textron* because "in addition to alleging that the [EA] used [Textron's] marks and trade dress, [Textron] alleged that the helicopters were a main selling point for the game and [EA] intended consumer confusion."<sup>116</sup> In *Textron*, the prominence of the marks appeared to be the only evidence of EA's intent to deceive customers, but as already noted, the prominence of the use of a mark should not, by itself, be enough to show a use is explicitly misleading, given not only the *Mattel* "Barbie Girl" case, but also the original *Rogers* decision.

What's notable about *Virag* is that while the court thought the use of the marks in the racetrack was distinguishable from the use of the marks in *Textron*, the district court suggested that more prominent uses could change the outcome under the *Rogers* analysis. In *Virag*, this language is dicta, but it suggests some slippage from the certainty offered by *Brown*'s take on the *Rogers* test. As mentioned earlier, *Virag* is currently on appeal before the Ninth Circuit. Although Virag does not rely exclusively on its interpretation of the second prong of the *Rogers* test for its appeal, Virag does argue at length that *Textron* was sound.<sup>117</sup> On its own, this argument might not be that important, but in light of the district court's suggestion that *Textron* might still be persuasive, the need for the Ninth Circuit to respond is clear. So long as the Ninth Circuit continues to follow its prior decision in *Brown*, *Virag* should be game over for *Textron*, *Rogers II*, and *Rogers III*, but the court needs to explicitly disapprove of *Textron* to ensure its persuasive value comes to an end.

#### IV. CONCLUSION

While the results in these false association cases are often the same—victory for the media defendant—the inconsistency in the approaches works against creative

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<sup>111</sup> *Id.* at \*33-37.

<sup>112</sup> *Id.* at \*38 (italics added).

<sup>113</sup> *Id.* at \*38-39.

<sup>114</sup> *Id.* at \*40-41.

<sup>115</sup> *Virag*, 2015 U.S. Dist. LEXIS 111211, at \*39; Transcript of Official Electronic Sound Recording of Proceedings at 11-14, *Virag, S.R.L. v. Sony Comput. Entm't Am. LLC*, No. 15-1729 (N.D. Cal. July 30, 2015) (arguing for the relevance and persuasiveness of *Textron*).

<sup>116</sup> *Virag*, 2015 U.S. Dist. LEXIS 111211, at \*40.

<sup>117</sup> Br. of Appellant at 55-60, *Virag, S.R.L. v. Sony Comput. Entm't Am. LLC*, No. 16-15137 (9th Cir. June 2, 2016).

freedom. As noted in one of the attempts to persuade the Supreme Court to address the tension between the right of publicity and the First Amendment, the “lack of uniformity profoundly endangers free speech.”<sup>118</sup> The frequent statements in false association cases that a plaintiff can prevail by showing an ordinary or even a heightened likelihood of confusion invite more litigation. The regularity of these types of lawsuits suggests that even more or less consistent outcomes are not enough to deter litigation. Clear rules may help.

The original *Rogers* decision represents a clear rule, but it is undermined by the frequent departures from it. For trademarks owners, these departures are beneficial. They promote uncertainty, uncertainty increases risk, and risk leads to defensive licensing, which restricts creative freedom. Creative freedom should not harm consumers, as consumers are unlikely to make video game purchasing decisions based on whether, say, Coke or Pepsi makes an appearance in a game, any more than a product placement choice would affect whether consumers see a film. While the appearance of military equipment in a military game is quite another matter—this sort of thing is important to consumers who want a realistic game—consumers are unlikely to care whether a defense manufacturer *officially* approves of the appearance of its equipment in a game, any more than a consumer would care whether Textron or Bell Helicopter *officially* approve of the appearance of their helicopters in *Apocalypse Now*<sup>119</sup> or some other film.<sup>120</sup> Textron and Bell Helicopter have expertise in military equipment, not in video game or film evaluation.

Like *Rogers*, the Ninth Circuit’s *Brown* decision offered a clear rule, perhaps even clearer in its description than *Rogers* itself, but the district court’s decision in *Virag* hints at a setback. The Ninth Circuit can correct this setback in the *Virag* appeal, but whatever happens in the Ninth Circuit, the lack of uniformity will remain in other circuits and will likely continue as a greater deterrent to free expression in the video game industry than to other forms of media. The time is long overdue for the U.S. Supreme Court to address the issue.

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<sup>118</sup> Br. of 31 Constitutional Law Professors and Intellectual Law Professors as *Amici Curiae* in Support of Petitioner at 24, *Elec. Arts, Inc. v. Davis*, No. 15-424 (9th Cir. Nov. 4, 2015), *cert. denied*, 136 S.Ct. 1448 (2016).

<sup>119</sup> *Apocalypse Now* (United Artists 1979).

<sup>120</sup> Under *Textron*, a filmmaker couldn’t make a modern military movie without clearance from defense contractors, assuming the court treated filmmakers in the same way as video game producers. The same problem was posed by the earlier litigation between the parties involving Vietnam era games. See Ford & Manevitz, *supra* note 73, at 179-80 (“The Huey [helicopter] is among the standard imagery included in Vietnam movies, television shows, and games, meaning the plaintiffs were asserting a right to control an essential element for the creation of expressive works about the Vietnam War—an element that is not even an ordinary consumer product.”).

**Appendix**  
**Examples of False Association Cases Involving Expressive Works**<sup>121</sup>

Year	Media Defendant Prevailed on TM Claims?	Media Type	Case	Facts	Outcome	Analytical Approach
2016	Yes	films	<i>Dryer v. NFL</i> , 814 F.3d 938 (8th Cir. 2016)	plaintiff-appellants, three retired football players, sued the NFL because NFL Films reused old football game footage in which they appeared in newer historical films	affirmed grant of defendant's motion for summary judgment	misleading or false statement test  Note: The court's approach is closest to <i>Rogers I</i> , but the court did not cite <i>Rogers</i> .
2016	Yes	TV show	<i>Twentieth Century Fox TV v. Empire Distrib.</i> , 161 F. Supp. 3d 902 (C.D. Cal. 2016)	plaintiffs sought a declaratory judgment that their use of the word "empire" in the title of their TV series <i>Empire</i> did not infringe on the rights of defendant record label Empire Distribution	granted declaratory judgment plaintiffs' motion for summary judgment	<i>Rogers test (Rogers I)</i>
2015	Yes	video game	<i>Virag, S.R.L. v. Sony Comput. Entm't Am. LLC</i> , No. 15-1729, 2015 U.S. Dist. LEXIS 111211 (N.D. Cal. Aug. 21, 2015)	plaintiffs sued the defendants for the unauthorized use of the VIRAG mark on a bridge over a racetrack in two Sony racing video games, <i>Gran Turismo 5</i> and <i>Gran Turismo 6</i>	granted defendants' motion to dismiss the Lanham Act claims	<i>Rogers test (Rogers I)</i>
2014	Yes	video game	<i>Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.</i> , 74 F. Supp. 3d 1134 (N.D. Cal. 2014)	plaintiff seller of unofficial military patches sued the defendants for making its "angry monkey" patch available for players' uniforms in <i>Call of Duty: Ghosts</i>	granted defendants' motion for partial summary judgment	<i>Rogers test (Rogers I)</i>
2013	Yes	video game	<i>Brown v. Elec. Arts, Inc.</i> , 724 F.3d 1235 (9th Cir. 2013)	plaintiff football Hall of Famer Jim Brown sued the defendant over the use of his likeness in the <i>Madden NFL</i> video game series	affirmed grant of defendant's motion to dismiss	<i>Rogers test (Rogers I)</i>

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<sup>121</sup> This list is not exhaustive.

Year	Media Defendant Prevailed on TM Claims?	Media Type	Case	Facts	Outcome	Analytical Approach
2013	Yes	video game	<i>Novalogic, Inc. v. Activision Blizzard</i> , 41 F. Supp. 3d 885 (C.D. Cal. 2013)	plaintiff publisher of video games sued the defendants over the use of plaintiff's Delta Force marks within the game <i>Call of Duty 3: Modern Warfare</i> , the related strategy guide, and a set of headphones, with only the first two uses at issue in the present decision	granted defendants' motion for partial summary judgment	<i>Rogers</i> test ( <i>Rogers</i> I)
2012	No	video game	<i>Elec. Arts, Inc. v. Textron Inc.</i> , No. 12-0118, 2012 U.S. Dist. LEXIS 103914 (N.D. Cal. July 25, 2012)	plaintiff Electronic Arts sought a declaratory judgment that it did not infringe the defendants' trademarks by including the defendants' helicopters in the video game <i>Battlefield 3</i> ; the defendants filed trademark infringement counterclaims	denied plaintiff's motion to dismiss the defendants' counterclaims	<i>Rogers</i> test ( <i>Rogers</i> III)
2011	Yes	video game	<i>Dillinger, LLC v. Elec. Arts, Inc.</i> , No. 09-1236, 2011 U.S. Dist. LEXIS 64006 (S.D. Ind. June 16, 2011)	plaintiff owner of the rights to John Dillinger's name sued Electronic Arts for naming a weapon after Dillinger in <i>The Godfather</i> (2006) and <i>The Godfather II</i> (2009) video games	granted defendant's motion for summary judgment	<i>Rogers</i> test ( <i>Rogers</i> I)
2011	Yes	book	<i>Stewart Surfboards, Inc. v. Disney Book Group, LLC</i> , No. 10-2982, 2011 U.S. Dist. LEXIS 155444 (C.D. Cal. May 11, 2011)	plaintiffs sued Disney for the appearance of the plaintiffs' Stewart Surfboards trademark on a surfboard shown on the back cover of a book called <i>Hannah Montana: Rock the Waves</i>	granted defendant's motion to dismiss	<i>Rogers</i> test ( <i>Rogers</i> I)
2009	Yes	pornographic film	<i>Roxbury Entm't v. Penthouse Media Group, Inc.</i> , 669 F. Supp. 2d 1170 (C.D. Cal. 2009)	plaintiff owner of the "Route 66" television program sued the defendants over the title of a pornographic film called <i>Route 66</i> (according to plaintiff) or <i>Penthouse: Route 66</i> (according to defendants)	granted defendants' motion for summary judgment	<i>Rogers</i> test ( <i>Rogers</i> III)
2008	Yes	video game	<i>E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.</i> , 547 F.3d 1095 (9th Cir. 2008)	plaintiff owner of the "Play Pen" strip club sued defendants over the use of the "Pig Pen" strip club in <i>Grand Theft Auto: San Andreas</i>	affirmed the grant of defendant's motion for summary judgment	<i>Rogers</i> test ( <i>Rogers</i> II, III?)

Year	Media Defendant Prevailed on TM Claims?	Media Type	Case	Facts	Outcome	Analytical Approach
2008	No	video game	<i>Ultimate Creations, Inc. v. THQ Inc.</i> , No. 06-1134, 2008 U.S. Dist. LEXIS 8224 (D. Ariz. Jan. 24, 2008)	plaintiff, the licensing agent of the professional wrestler originally named the Ultimate Warrior and later just Warrior, sued the defendant over the ability to create wrestlers similar to the Warrior in its assorted wrestling video games	denied the defendant's motion for summary judgment	likelihood of confusion test
2007	No	video game	<i>Bell Helicopter Textron Inc. v. Elec. Arts, Inc.</i> , No. 06-0841 (N.D. Tex. Dec. 6, 2007) (order)	plaintiffs Bell Helicopter Textron and Textron Innovations sued the defendant over the use of their helicopters in the defendant's <i>Battlefield Vietnam</i> , <i>Battlefield Vietnam: Redux</i> , and <i>Battlefield 2</i> video games	denied defendant's motion to dismiss	no rationale given
2007	Yes	TV show	<i>Burnett v. Twentieth Century Fox Film Corp.</i> , 491 F. Supp. 2d 962 (C.D. Cal. 2007)	plaintiff Carol Burnett sued the defendant over verbal references to her and the depiction of her "Charwoman" character from the <i>Carol Burnett Show</i> in an episode of <i>Family Guy</i>	granted defendant's motion to dismiss	likelihood of confusion test  + vague references to the <i>Rogers</i> First Amendment test
2005	Yes	film	<i>Davis v. Walt Disney Co.</i> , 430 F.3d 901 (8th Cir. 2005)	plaintiffs Earth Protector Licensing Corporation and Earth Protector, Inc. sued the defendants over the use of a fictional company called Earth Protectors in a film called <i>Up, Up and Away</i>	affirmed grant of defendants' motion for summary judgment	likelihood of confusion test
2003	Yes	photographs	<i>Mattel Inc. v. Walking Mountain Prods.</i> , 353 F.3d 792 (9th Cir. 2003)	plaintiff Mattel sued the defendants over the defendant's photographs, most of which depicted "a nude Barbie in danger of being attacked by vintage household appliances"	affirmed grant of defendant's motion for summary judgment	<i>Rogers</i> test ( <i>Rogers I</i> ?)
2003	Yes	film	<i>Caterpillar Inc. v. Walt Disney Co.</i> , 287 F. Supp. 2d 913 (C.D. Ill. 2003)	plaintiff Caterpillar sued the defendant for the use of Caterpillar bulldozers (with visible Caterpillar marks) in the film <i>George of the Jungle 2</i>	denied plaintiff's motion for a TRO	likelihood of confusion test

Year	Media Defendant Prevailed on TM Claims?	Media Type	Case	Facts	Outcome	Analytical Approach
2003	Yes	film	<i>Wham-O, Inc. v. Paramount Pictures Corp.</i> , 286 F. Supp. 2d 1254 (N.D. Ill. 2003)	plaintiff toymaker sued the defendants over the use of the Slip 'N Slide in the film <i>Dickie Roberts: Former Child Star</i>	denied plaintiff's motion for a TRO	likelihood of confusion test
2003	Yes	painting	<i>ETW Corp. v. Jireh Publ'g, Inc.</i> , 332 F.3d 915 (6th Cir. 2003)	plaintiff, the licensing agent for Tiger Woods, sued the defendant over his painting "The Masters of Augusta," a depiction of Wood's 1997 victory at the Masters Tournament in Augusta, Georgia	affirmed grant of defendant's motion for summary judgment	<i>Rogers</i> test ( <i>Rogers</i> I)
2002	Yes	song	<i>Mattel, Inc. v. MCA Records</i> , 296 F.3d 894 (9th Cir. 2002)	plaintiff Mattel sued the defendants over the reference to Barbie in defendants' song "Barbie Girl"	affirmed grant of defendants' motion for summary judgment	<i>Rogers</i> test ( <i>Rogers</i> I)
1998	No	film	<i>American Dairy Queen Corp. v. New Line Prods.</i> , 35 F. Supp. 2d 727 (D. Minn. 1998)	plaintiff restaurateur Dairy Queen sued the producer of a mockumentary about beauty contests in rural Minnesota entitled "Dairy Queens"	granted a preliminary injunction prohibiting defendant from using the title "Dairy Queens"	likelihood of confusion test where adequate alternative avenues of communication exist, plus a dash of <i>Rogers</i> ( <i>Rogers</i> II?)  Note: The court also held that the title of the film was a commercial use of a mark and that the plaintiff's dilution claim was likely to succeed.
1998	No	film	<i>Films of Distinction v. Allegro Film Prods., Inc.</i> , 12 F. Supp. 2d 1068 (C.D. Cal. 1998)	plaintiff owner of "The Crime Channel" television network sued the defendants over the use of a "Crime Channel" television station in the plot for the film <i>Relative Fear</i>	denied defendants' motion to dismiss plaintiff's Lanham Act claims	likelihood of confusion test  Note: The district court predicted the Ninth Circuit would not adopt the Second Circuit's <i>Rogers</i> test (which the court described as <i>Rogers</i> II).
1994	No	magazine	<i>Anheuser-Busch, Inc. v. Balducci Publ'ns</i> , 28 F.3d 769 (8th Cir. 1994)	plaintiff brewer of Michelob beers sued the defendants over a parody advertisement for "Michelob Oily" on the back page of <i>Snickers</i> magazine	reversed the district court's dismissal and directed judgment for the plaintiff	<i>Rogers</i> test ( <i>Rogers</i> II?)

Year	Media Defendant Prevailed on TM Claims?	Media Type	Case	Facts	Outcome	Analytical Approach
1993	Mixed	book	<i>Twin Peaks Prods. v. Publ'ns Int'l, Ltd.</i> , 996 F.2d 1366 (2d Cir. 1993)	plaintiff producer of the television program “Twin Peaks” sued the publisher of a book about “Twin Peaks” called <i>Welcome to Twin Peaks: A Complete Guide to Who's Who and What's What</i>	vacated the district court's grant of plaintiff's motion for summary judgment on trademark liability	<i>Rogers test (Rogers II)</i>
1989	Yes	film	<i>Rogers v. Grimaldi</i> , 875 F.2d 994 (2d Cir. 1989)	plaintiff Ginger Rogers sued the defendants over the reference to her in the title of the film <i>Ginger and Fred</i>	affirmed grant of defendants' motion for summary judgment	<i>Rogers test (Rogers I)</i>  Note: The Second Circuit distinguished <i>Dallas Cowboys Cheerleaders</i> by claiming it “involved a pornographic movie with blatantly false advertising.”
1979	No	pornographic film	<i>Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.</i> , 604 F.2d 200 (2d Cir. 1979)	plaintiff Dallas Cowboys Cheerleaders sued the defendants over the use of a uniform “strikingly similar” to the Dallas Cowboys Cheerleaders uniform in the advertisements for the film <i>Debbie Does Dallas</i> and in the film itself, including references to the star as an “Ex Dallas Cowgirl Cheerleader”	affirmed granted plaintiff a preliminary injunction	likelihood of confusion test where adequate alternative avenues of communication exist  Note: This case is plausibly seen as primarily about dilution by tarnishment in the special context of pornography.