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REPLACING THE *ROGERS* TEST: WILL AN INQUIRY INTO NON-ARTISTIC MOTIVE IN
SELECTING TITLES OF EXPRESSIVE WORKS REMEDY THE POSSIBILITY OF FLAGRANT
DECEPTION?

SABINA NEDKOVA
ORCID: 0000-0001-6727-9948

ABSTRACT

For approximately thirty years, the *Rogers* test has been used when deciding if the junior user's use of a trademark infringed upon the senior user's trademark rights or if it could be protected as artistic expression under the First Amendment. Over the years, the *Rogers* test was adopted in many jurisdictions, but often with some variations which inevitably showed that courts had not found the test to be entirely without fault. The test has often been known to tip the scales in favor of junior users. Nevertheless, the *Rogers* test had never been openly opposed until *Stouffer v. National Geographic Partners, L.L.C.*, where Judge William J. Martinez of the U.S. District Court for the District of Colorado revealed the flaws in the *Rogers* test and proposed a new test. This article examines the newly proposed test to determine if it truly infuses balance back into the equation.



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I. INTRODUCTION

For approximately thirty years, junior users have enjoyed dominance over senior users' trademarks in the realm of artistic expression,¹ a realm that is always expanding as courts cautiously redefine its boundaries while struggling to draw the line between artistic expression and commercial use.² This epic battle between senior and junior trademark users has been raging across a multitude of circuits.³ Many jurisdictions have struggled to balance senior users' trademark rights against junior user's First Amendment⁴ protections of free speech. In *Mattel, Inc. v. MCA Records*, Judge Alex Kozinski described this clash between trademark law and constitutional

* © Sabina P. Nedkova 2021, ORCID: 0000-0001-6727-9948, Candidate for Juris Doctor, University of Illinois Chicago School of Law, December 2022. I would like to dedicate this article and achievement to my father, Plamen Nedkov, who is no longer with us but who has inspired me throughout my life. I also want to express my deepest and most sincere gratitude to my brother, Stoyan Nedkov, and my mother, Toshka Nedkova, who always support and encourage me. Finally, I want to thank the editors of the UIC Review of Intellectual Property Law for their dedication, guidance, and hard work.

¹ *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2nd Cir. 1989) (ruling in favor of the junior user of a trademark in the title of a movie); *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1101 (9th Cir. 2008) (ruling in favor of a junior user of a trademark in a video game); *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 271 (9th Cir. 2018) (finding that the senior user has to show by a preponderance of the evidence that the junior user used the mark in a way that was explicitly misleading where the junior user used an almost identical mark on the same goods as sold by the senior user and remanding the case for consideration on *Rogers'* explicitly misleading prong because the Court indicated that the senior user's evidence was not bulletproof.); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1248 (9th Cir. 2013) (affording the junior user First Amendment protection when using James Brown's likeness in its *Madden NFL* video games); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (finding that the song "Barbie Girl," used by the junior user, did not infringe the Barbie doll); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490, 497 (2nd Cir. 1989) (holding that the cover used for *Spy Notes* as a parody of *Cliffs Notes* did not infringe); *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1196 (9th Cir. 2017) (ruling in favor of the junior user, a television show, about a fictional record label by the name "Empire" carrying similar name as the senior user, Empire Distribution, an actual record label).

² *Rogers*, 875 F.2d at 997 (recognizing movie titles as artistic expression); *E.S.S. Entm't 2000, Inc.*, 547 F.3d at 1100 (recognizing video games as artistic expression); *Gordon*, 909 F.3d at 271 (recognizing greeting cards as artistic expression); *Twentieth Century Fox Television*, 875 F.3d at 1196 (recognizing a television show as expressive work).

³ See William K. Ford, *Restoring Rogers: Video Games, False Association Claims, and the "Explicitly Misleading" Use of Trademarks*, 16 J. MARSHALL REV. INTELL. PROP. L. 306, 310 (2017). Courts applying the *Rogers* test have adopted variations of it, some affording more or less free speech protections to junior users. *Id.*

⁴ U.S. CONST. amend. I. ("Congress shall make no law . . . abridging the freedom of speech, or of the press.").

protections of free speech as “Speech-Zilla meets Trademark Kong.”⁵

This contentious issue of striking the right balance and preserving free speech has not yet reached the U.S. Supreme Court. Many circuits, including the Second, Fifth, Sixth, Ninth, and Eleventh, have adopted a variation of the *Rogers* test⁶ to resolve the dispute.⁷ Recently, unsatisfied with the outcome of cases applying the *Rogers* test, the U.S. District Court for the District of Colorado proposed a new test in a 2020 decision.⁸ The importance of the case was not in its outcome⁹ nor its contribution to a long line of cases dealing with trademark infringement in artistic works. The significance of the case can be read in the daring words of Judge William J. Martinez, as he took on the giant that is the *Rogers* test and boldly forged ahead to create something new, he asked the question: “[I]s the *Rogers* test the right test?” and answered it when stating that, “*Rogers* tilts too far in favor of the junior user’s First Amendment interest.”¹⁰ Judge Martinez was asking the right question but this case note will explore if he truly arrived at a novel solution that can serve as a replacement for the *Rogers* test.

This case note will examine the District of Colorado’s proposed test and discuss how it breaks from the *Rogers* thirty-year tradition, yet arrives at the same outcome. Part II of this article will examine artistic expression within current trademark law and the First Amendment protection of free speech, and provide an overview of cases applying the *Rogers* analytical framework. Part III will explore how the District Court of Colorado is planning to fill in the gap left by *Rogers* so many years ago by its new test proposed in *Stouffer v. National Geographic Partners, L.L.C.* Finally, Part IV will assess the meaning of *Stouffer* within the long-established *Rogers* tradition and discuss the future of expressive choice.

II. BACKGROUND

This section will assess First Amendment protections of free speech within the context of trademark infringement. It will examine what those protections are, how they relate to trademark law, and when the need to balance the public interest of preserving free speech against trademark protection arises.

⁵ *Mattel, Inc.*, 296 F.3d at 898.

⁶ *Rogers*, 875 F.2d at 999. The title of an expressive work does not violate the Lanham Act “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.” *Id.*

⁷ *Rogers*, 875 F.2d 994; *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000); *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003); *E.S.S. Entm’t 2000, Inc.*, 547 F.3d 1095; *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266 (11th Cir. 2012). *See supra* note 1.

⁸ *Stouffer v. Nat’l Geographic Partners, L.L.C.*, 460 F. Supp. 3d 1133, 1140 (D. Colo. 2020).

⁹ *Stouffer, et al. v. Nat’l Geographic Partners, et al.*, No. 20-1208 (10th Cir. dismissed Mar. 1, 2021). The Tenth Circuit granted a stipulation to dismiss under Federal Rule of Appellate Procedure 42, allowing for procedural termination without judicial action. *Id.*

¹⁰ *Stouffer*, 460 F. Supp. 3d at 1140.

A. First Amendment Protections of Free Speech in the Context of Artistic Expression

The First Amendment of the U.S. Constitution states that “Congress shall make no law . . . abridging the freedom of speech, or of the press.”¹¹ However, the First Amendment affords a different degree of protection to artistic expression than it does commercial speech.¹² The Supreme Court defined “commercial speech” as “expression related solely to the economic interests of the speaker and its audience.”¹³ False or misleading commercial speech, including trademarks and advertisements, is not protected under the First Amendment and can be regulated.¹⁴ However, just because “the dissemination [of speech] takes place under commercial auspices”¹⁵ does not necessarily make it commercial speech as opposed to artistic expression. Having defined commercial speech, there is still the question of what is considered artistic expression.

Some works that are considered artistic are “movies, plays, books, . . . songs,”¹⁶ video games,¹⁷ paintings,¹⁸ prints,¹⁹ greeting cards,²⁰ and design covers.²¹ Artistic works could still infringe on the rights of trademark owners because “[p]oetic license is not without limits. 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.”²² The First Amendment could be raised as an affirmative defense in cases of alleged trademark infringement when the underlying product is an expressive work.²³

¹¹ U.S. CONST. amend. I.

¹² DAVID C. HILLIARD, JOSEPH N. WELCH, II & JANET A. MARVEL, TRADEMARK AND UNFAIR COMPETITION DESKBOOK § 8.02 (2019).

¹³ *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996) (quoting *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557, 561 (1980)).

¹⁴ DAVID C. HILLIARD, JOSEPH N. WELCH, II & JANET A. MARVEL, TRADEMARK and UNFAIR COMPETITION DESKBOOK § 8.02 (2019).

¹⁵ *Univ. of Ala. Bd. of Trs.*, 683 F.3d at 1276 (citing *Smith v. Cal.*, 361 U.S. 147, 150 (1959) (alteration in original)).

¹⁶ *Rogers*, 875 F.2d at 997.

¹⁷ *E.S.S. Entm’t 2000, Inc.*, 547 F.3d at 1101.

¹⁸ *Univ. of Ala. Bd. of Trs.*, 683 F.3d at 1277.

¹⁹ *Id.*

²⁰ *Gordon*, 909 F.3d at 271.

²¹ *Cliffs Notes, Inc.*, 886 F.2d at 494.

²² *Rogers*, 875 F.2d at 997.

²³ *Univ. of Ala. Bd. of Trs.*, 683 F.3d at 1281. The Eleventh Circuit ruled that the defendant had waived his First Amendment defense in relation to “mundane products,” such as mugs and other articles, because he had failed to timely raise the same issue on appeal and found his brief lacking in addressing the issue or the relevant law, mainly the *Rogers* test, in connection to such articles. *Id.* However, the Court did permit defendant to assert First Amendment affirmative defense in relation to the use of images of the University’s football players he had taken and later used to create paintings, prints and other forms of artistic expression, which the Court discussed separately from “mundane articles.” *Id.*

B. Trademark Law: Infringement and Artistic Expression

Trademark law protects certain types of expression as it is used in the marketplace to identify a source of goods or services. A trademark is a word, phrase, or symbol which is a source-identifier used to distinguish the goods of one from those of another in the marketplace.²⁴ One can obtain a registered trademark if the mark is used in commerce, or the applicant has a bona fide intent to use it, and if the mark is distinctive in order to serve its source-identifying function.²⁵

The primary purpose of trademark law is to protect consumers in the marketplace by avoiding consumer confusion.²⁶ Trademark law achieves its purpose by granting trademark owners the exclusive rights to use their trademarks and exclude others from using them if such use will cause consumer confusion.²⁷ Trademark owners can bring civil action claims against alleged infringers.²⁸

The Lanham Act is a federal statute enacted by Congress in 1946, which serves to protect the rights of trademark owners against the use of similar marks that are likely to cause consumer confusion as to the source of the goods.²⁹ Sections 32³⁰ and

²⁴ 15 U.S.C. § 1127 (2020). *See also* Sugar Busters L.L.C. v. Brennan, 177 F.3d 258, 268 (5th Cir. 1999) (discussing the protectability of book titles as trademarks and providing additional information about what constitutes a trademark).

²⁵ 15 U.S.C. § 1127 (2020).

²⁶ *E.S.S. Entm't 2000, Inc.*, 547 F.3d at 1095.

²⁷ *Id.*

²⁸ 15 U.S.C. §§ 1114, 1125(a) (2020).

²⁹ *See* CORNELL LAW SCHOOL: LEGAL INFORMATION INSTITUTE, *Lanham Act*, https://www.law.cornell.edu/wex/lanham_act (last visited Sep. 27, 2020); CORNELL LAW SCHOOL: LEGAL INFORMATION INSTITUTE, *Trademark Infringement*, https://www.law.cornell.edu/wex/trademark_infringement (last visited Sep. 27, 2020).

³⁰ 15 U.S.C. § 1114(1)(a)(b) (2020). This section of the Lanham Act provides that a civil action could be filed by:

- (1) Any person who shall, without the consent of the registrant—
 - (a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or
 - (b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

43(a)³¹ of the Lanham Act³² allow a trademark owner to bring a civil action against alleged trademark infringers whose product is likely to cause consumers to be mistaken, deceived, or confused about the products' origin, association, sponsorship, or approval.³³ A prominent question to be asked is what happens when the trademark has been used to express an idea and has therefore transcended its commercial value?

C. *The Clash between "Speech-Zilla" and "Trademark Kong"*

As Mark Twain has said, "[t]he difference between the almost-right word and the right word is really a large matter."³⁴ But what happens if the right word is a trademark? Can we still use that word if someone already owns it? This is the crossing where "Speech-Zilla meets Trademark Kong."³⁵

Well-known and famous trademarks often become a point of cultural reference and an integral part of the "collective memory,"³⁶ which has led to their use in expressive works such as video games, songs, cards, and movie titles.³⁷ "The problem

³¹ 15 U.S.C. § 1125(a) (2020). This section of the Lanham Act provides that a civil action could be filed by:

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of

fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

³² See CORNELL LAW SCHOOL: LEGAL INFORMATION INSTITUTE, *Lanham Act*, https://www.law.cornell.edu/wex/lanham_act (last visited Sep. 27, 2020). The Lanham Act permits a trademark infringement claim to either be brought for a registered trademark under 15 U.S.C. § 1114 or unregistered trademarks under 15 U.S.C. § 1125(a). *Id.*

³³ *Parks*, 329 F.3d at 445.

³⁴ *Parks*, 329 F.3d at 450 (quoting J. Bartlett, *Familiar Quotations* 527 (16th ed. 1992)).

³⁵ *Mattel, Inc.*, 296 F.3d at 898.

³⁶ *Cardtoons*, 95 F.3d at 972. The Tenth Circuit referred to parody as a "vital commodity in the marketplace of ideas" because it allows the creation of new form of expression while referencing historical ones. *Id.* Parody is a powerful tool to bridge the creator's point of view on current social norms and the historical object of his ridicule, often celebrities being the subject of the same as they are reference points for our "common experience and a collective memory." *Id.* (quoting JOHN B. THOMPSON, *IDEOLOGY AND MODERN CULTURE: CRITICAL SOCIAL THEORY IN THE ERA OF MASS COMMUNICATION* 163 (1990)).

³⁷ *Mattel, Inc.*, 296 F.3d at 900. The Ninth Circuit provided examples of trademarks that have become cultural expressions such as something being "the Rolls Royce of its class" implying luxury and class, and "Band-Aid" used to reference a "quick fix." *Id.* The Court went on to say that trademarks

arises when trademarks transcend their identifying purpose . . . enter our public discourse and become an integral part of our vocabulary.”³⁸ Trademark law does not limit artistic expression or free communication because its purpose is solely limited to source identification in the marketplace for the benefit of consumers. But what happens when trademarks share the same marketplace as artistic works incorporating them?³⁹ The Lanham Act applies only when “the public interest in avoiding consumer confusion outweighs the public interest in free expression.”⁴⁰

D. *Thirty Years of the Rogers Tradition*

Rogers v. Grimaldi was a seminal case that arose in the Second Circuit in 1989.⁴¹ The plaintiff, Ginger Rogers, brought claims under the Lanham Act against an Italian film producer of a fictional movie entitled “Ginger and Fred.”⁴² The movie was about two cabaret dancers who became famous in Italy for imitating Ginger Rogers and Fred Astaire.⁴³ Given the stardom status of Ginger Rogers and Fred Astaire at the time of the suit, Rogers claimed that the title of the movie would mislead consumers to believe that she sponsored or endorsed it.⁴⁴ The district court had ruled in favor of the defendant because it found that the title was not commercial but artistic expression deserving full First Amendment protections.⁴⁵ Finding the district court’s decision to “unduly narrow[] the scope of the Act” and “create a nearly absolutely privilege,” the court engineered a new test, now known as the *Rogers* test.⁴⁶

Rogers created a two-prong framework for the application of the Lanham Act to cases of alleged trademark infringement by artistic works only if “public interest in avoiding consumer confusion outweighs the public interest in free expression.”⁴⁷ The Act will apply if: 1) the “title has no artistic relevance to the underlying work whatsoever”; or 2) “the title explicitly misleads as to the source or content of the work.”⁴⁸ The Court went on to say that a title will not receive First Amendment protection if it is explicitly misleading, even if it has minimal artistic relevance.⁴⁹

Applying the two-prong test, the Second Circuit found that the movie title “Ginger and Fred” was relevant to the underlying plot of the movie, and since there

“[o]nce imbued with such expressive value, the trademark becomes a word in our language and assumes a role outside the bounds of trademark law.” *Id.*

³⁸ *Id.*

³⁹ *Rogers*, 875 F.2d at 999.

⁴⁰ *Id.*

⁴¹ *Id.* at 997.

⁴² *Id.*

⁴³ *Id.* at 996–97.

⁴⁴ *Rogers*, 875 F.2d at 996–97.

⁴⁵ *Id.* at 997.

⁴⁶ *Id.*

⁴⁷ *Id.* at 999.

⁴⁸ *Id.*

⁴⁹ *Rogers*, 875 F.2d at 1001. The Court summarized the achievements and shortcomings of their newly created test as one that “insulates from restriction titles with at least minimal artistic relevance that are ambiguous or only implicitly misleading but leaves vulnerable to claims of deception titles that are explicitly misleading as to source or content, or that have no artistic relevance at all.” *Id.* at 1000.

was no explicit indication of endorsement by Ginger Rogers, the Court ruled in favor of defendants.⁵⁰ However, finding the majority's opinion overly expansive, in concurrence, Judge Griesa⁵¹ identified a central flaw of the *Rogers* test.⁵² Judge Griesa foreshadowed the inherited dilemma taunting future cases to come—what works would be considered false but still artistically relevant?⁵³

Following the Second Circuit's opinion in *Rogers*, other circuits began adopting the *Rogers* test including the Fifth, Sixth, Ninth, and Eleventh Circuits.⁵⁴ Some circuits differed in their application of the *Rogers* test and modified it to some degree, but for the most part kept within the *Rogers* established framework.

In *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, the Eleventh Circuit adopted the *Rogers* test. The case involved an artist who created paintings and prints featuring realistic portrayals of the University of Alabama's football players.⁵⁵ The University brought an action under the Lanham Act.⁵⁶ In finding that the artist, the junior user in this case, had First Amendment protection over the paintings and prints,⁵⁷ the Eleventh Circuit stated, "we have no hesitation in joining our sister circuits by holding that we should construe the Lanham Act narrowly when deciding whether an artistically expressive work infringes a trademark."⁵⁸

The Fifth Circuit applied the *Rogers* test in the 1999 case *Sugar Busters L.L.C. v. Brennan*⁵⁹ and in the 2000 case *Westchester Media v. PRL USA Holdings, Inc.* The later case was between the title of POLO magazine and Ralph Lauren's registered

⁵⁰ *Id.*

⁵¹ *Id.* at 1006–07. Judge Griesa stated in relevant part that "this unique case would seem to be an inappropriate vehicle for fashioning a general rule . . . it should be left to future courts, dealing with real cases, to determine if there are to be exceptions to the First Amendment protection which would seem to be generally afforded to artistically relevant titles." *Id.*

⁵² *Id.*

⁵³ *Id.*

⁵⁴ *Stouffer*, 460 F. Supp. 3d at 1143. The Second, Fifth, Sixth, Ninth, and Eleventh Circuits have adopted the *Rogers* test for analyzing trademark infringement in works of artistic expression but the test was not applied consistency across all circuits. *See also supra* notes 3 (referencing an article which contains a list of cases) and 7 (listing cases by circuit).

⁵⁵ *Univ. of Ala. Bd. of Trs.*, 683 F.3d at 1269.

⁵⁶ *Id.*

⁵⁷ *Id.* at 1272. In its opinion, the Court separated the articles created by the artist in two categories: those for which the artist had a previous license agreement in place with the University of Alabama, mainly the paintings, prints and calendars, and those for which he did not, mainly mugs. *Id.* The Court later referenced mugs as "mundane products" and precluded them from First Amendment protection because the artist did not address how such products met the two-prong *Rogers* test. *Id.* at 1280.

⁵⁸ *Id.* at 1278.

⁵⁹ *Sugar Busters L.L.C.*, 177 F.3d at 265–69. This is an earlier case which came out of the Fifth Circuit in 1999 dealing with likelihood of confusion claims under § 43(a). *Id.* at 267. The junior and senior users both were using the mark in titles of books and the Court evaluated likelihood of confusion based on a two-prong test analyzing 1) if the title had acquired secondary meaning the marketplace and 2) if defendant's title would likely cause confusion or mislead consumers. *Id.* at 269. However, this case did not evaluate the §43 (a) claim under the *Rogers* test. *Id.* at 267–69. The Court only mentioned *Rogers* once when stating "[i]f the title of such a single work has acquired secondary meaning, 'the holder of the rights to that title may prevent the use of the same or confusingly similar titles by other authors.'" *Id.* at 269. (quoting *Rogers*, 875 F.2d at 998).

“Polo” trademarks.⁶⁰ The district court granted a permanent injunction requiring POLO magazine to provide disclaimers denying any association with Ralph Lauren’s brand.⁶¹ The Fifth Circuit gave its allegiance to *Rogers* when stating “this Circuit has adopted the Second Circuit’s approach” but then used a likelihood of confusion test to evaluate whether the magazine’s title was misleading.⁶² Furthermore, the Fifth Circuit stated that the likelihood of confusion had to be “particularly compelling” in order for the artistic work to fall outside of First Amendment protection.⁶³ The Court found that the magazine’s title infringed on Ralph Lauren’s “Polo” trademarks because the magazine fell within the senior user’s natural zone of expansion.⁶⁴ The Fifth Circuit ruling is one of few in which the senior user’s trademark rights were found to outweigh the junior user’s First Amendment protections.

In *Parks v. LaFace Records*, the Sixth Circuit applied the *Rogers* test in a case about the title of the song “Rosa Parks” produced by OutKast, a hip-hop and rap group.⁶⁵ The Court found that the song had no artistic relevance to the use of the name “Rosa Parks” in the title because the phrase “move to the back of the bus” used in the song was in no way related to Rosa Parks or civil rights.⁶⁶ The Court reversed the decision of the lower court in favor of the junior user and declared that “the First Amendment cannot permit anyone who cries ‘artist’ to have *carte blanche* when it comes to naming and advertising his or her works, art though it may be.”⁶⁷ This statement made by the Sixth Circuit may be the result of observation as to the line of cases coming out of the Ninth Circuit all favoring junior users’ rights.

The Ninth Circuit tipped the scales in favor of junior users, including the *Mattel, Inc.* case in 2002.⁶⁸ The Court ruled that the Danish band Aqua’s song “Barbie

⁶⁰ *Westchester Media*, 214 F.3d at 661.

⁶¹ *Id.* at 663.

⁶² *Id.* at 665.

⁶³ *Id.*

⁶⁴ *Id.* at 666. The Fifth Circuit took a different approach to *Rogers* than other courts by first dismissing the first prong of the test by stating that since the products were not in direct competition with each other, the only problem remaining was any confusion between the two as to origin, sponsorship or approval. *Id.* Then, the Court proceeded to evaluate the second prong of the *Rogers* test based on likelihood of confusion factors. *Id.* The focus was on actual confusion which the Court found and further stated that innocent intent on the part of the junior user would not preclude an intent to confuse consumers. *Id.* The Fifth Circuit discussed the notion of natural zone of expansion when stating “[t]he danger of affiliation or sponsorship confusion increases when the junior user’s market is one into which the senior user would naturally expand.” *Id.* See also *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 493 (2nd Cir. 1961) (“For we agree that plaintiff’s delay in proceeding against defendant bars plaintiff from relief so long as defendant’s use of Polarad remains as far removed from plaintiff’s primary fields of activity as it has been and still is.”).

⁶⁵ *Parks*, 329 F.3d at 442.

⁶⁶ *Id.* at 452.

⁶⁷ *Id.* at 447. The Court in this case gave a hypothetical example stating that if the title of the song was “Back of the Bus,” then there would be no Lanham Act violation as the junior user would not be taking advantage of a civil rights icon, Rosa Parks. *Id.* The defendants admitted that they used the Rosa Parks title to advertise their song and album. *Id.* at 446. The use would be permissible under the hypothetical but in the facts of the case, the Court found that the use of Rosa Parks’ name served commercial purpose for enhancing the marketability of the song and increasing the scope of the audience. *Id.* at 452.

⁶⁸ *Mattel, Inc.*, 296 F.3d at 898.

Girl”⁶⁹ did not infringe⁷⁰ on the trademark rights of the “glamorous, long-legged blonde” Barbie doll.⁷¹ The Court clarified that having the trademark in the title was not enough to be considered infringement because if so, “it would render *Rogers* a nullity.”⁷² Continuing on this same path, in *E.S.S. Entm’t 2000, Inc.*, the Ninth Circuit ruled in favor of the producers of the *Grand Theft Auto: San Andreas* videogame, the junior user.⁷³ In applying the *Rogers* test, the Court said that since the “level of relevance merely must be above zero,” the videogame was not infringing the rights of the Play Pen strip club by its portrayal of the Pig Pen strip club in the videogame and that no consumer would be misled to believe that the owners of the real club were involved in the videogame production.⁷⁴ Yet again in *Brown v. Electronic Arts, Inc.*, the rights of James Brown, one of the NFL’s top fifty players of all time, were outweighed by the First Amendment protection of EA’s NFL-centered videogame depicting his likeness.⁷⁵ The Ninth Circuit found that the videogame did not explicitly mislead, which was required under *Rogers*’ second-prong.⁷⁶ In *Twentieth Century Fox Television v. Empire Distribution*, the Ninth Circuit extended the application of *Rogers* to advertisements of a television show called “Empire” allegedly infringing the rights of the Empire Distribution record label.⁷⁷ Furthermore, in *Gordon v. Drape Creative, Inc.*, the Ninth Circuit showed the “full weight” of First Amendment protection when it ruled that the senior user needed to show by a preponderance of the evidence that the junior user’s use was in fact explicitly misleading, even when the junior user was producing greeting cards containing only a “slight variation” of the senior user’s protected trademark.⁷⁸

⁶⁹ *Id.* at 908. Each of the Aqua albums included a disclaimer saying that “Barbie Girl” was a “social commentary [that was] not created or approved by the makers of the doll.” *Id.* (alteration in original). Mattel, the producer of the doll, was highly unhappy with the disclaimer and equated it to a “bank robber handing a note of apology.” *Id.*

⁷⁰ *Id.* at 900. “[T]he trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function.” *Id.* The Court further stated that “[c]onsumers expect a title to communicate a message about the book or movie, but they do not expect it to identify the publisher or producer.” *Id.* at 902.

⁷¹ *Id.* at 898.

⁷² *Id.* at 902.

⁷³ *E.S.S. Entm’t 2000, Inc.*, 547 F.3d at 1097.

⁷⁴ *Id.* at 1100–01.

⁷⁵ *Brown*, 724 F.3d at 1239. “The *Rogers* test is applicable when First Amendment rights are at their height—when expressive works are involved—so it is no surprise that the test puts such emphasis on even the slightest artistic relevance.” *Id.* at 1245.

⁷⁶ *Id.* at 1245.

⁷⁷ *Twentieth Century Fox Television*, 875 F.3d at 1196–97. Empire Distribution record label brought claims against the television show “Empire” for not only use of the name but also for the promotional activities of the show. *Id.* The promotional activities included online ads, live events, sale of goods and also the promotion of the music used in the show. *Id.* In view of that, the Court stated that “it requires only a minor logical extension of the reasoning of *Rogers* to hold that works protected under its test may be advertised and marketed by name.” *Id.*

⁷⁸ *Gordon*, 909 F.3d at 271. In this case the junior user was creating greeting cards similar to the senior users’ greeting cards containing the “Honey Badger Don’t Care” trademark. *Id.* The junior user’s cards, as described in the opinion, had a “slight variation of the HBDGS phrase” and yet the Ninth Circuit did not find that the explicitly misleading *Rogers* prong was satisfied. *Id.* The Court said that this case “demonstrates *Rogers*’s outer limits” but it did not go so far as to rule in favor of

The multitude of cases forming the junior user protectionist legacy of *Rogers*, led the U.S. District Court for the District of Colorado to ask “is the *Rogers* test the right test?” in *Stouffer v. National Geographic Partners, L.L.C.*⁷⁹

III. *Stouffer v. National Geographic Partners, L.L.C.*

This section will provide a detailed layout of the facts and procedural history of the *Stouffer* case. Subsequently, it will discuss the newly proposed test by the U.S. District Court for the District of Colorado and examine how the Court applied the test to the facts of the case.

A. *Procedural History*

The plaintiff in this case, Marty Stouffer and Marty Stouffer Productions, LTD (collectively “Stouffer”), filed a claim in U.S. District Court for the District of Colorado, and the same was initially adjudicated in August of 2019.⁸⁰ The claims filed against the defendant, National Geographic Partners, L.L.C. (“National Geographic”), were for trademark and copyright infringement as well as unfair competition for use of trade dress.⁸¹ National Geographic moved to dismiss the claims based on Rule 12(b)(6)⁸² motion.⁸³ The Court granted National Geographic’s motion without prejudice on the copyright cause of action and with prejudice on the trade dress cause of action.⁸⁴ As to the trademark infringement cause of action, the Court denied National Geographic’s motion to dismiss and allowed the parties to amend their pleadings to have an opportunity to argue the case under the new test the court developed for balancing trademark rights with First Amendment protections.⁸⁵

Following the Court’s ruling in the 2019 decision, Stouffer submitted an amended complaint and National Geographic moved to dismiss once again under Rule 12(b)(6).⁸⁶ This time, the Court granted National Geographic’s motion to dismiss the case with prejudice⁸⁷ stating that “the amended complaint provides only the most

plaintiff on the explicitly misleading prong. *Id.* at 268. The Court further elaborated on the explicitly misleading prong stating that the junior user did not add any new artistic expression, he used the mark in a way in which consumers could confuse it for the senior user’s, and yet the Court stated “Gordon’s evidence is not bulletproof.” *Id.* at 271. The evidence was not bulletproof, the Court pointed out, because it was a “slight variation” of the original and junior user’s website was listed on the back. *Id.* Just when the scales seemed to shift in favor of the senior user, the Ninth Circuit’s comment on the evidence pulled us back in as it showed that even under these facts there was still a chance for the junior user to win.

⁷⁹ *Stouffer*, 460 F. Supp. 3d at 1140.

⁸⁰ *Stouffer v. Nat’l Geographic Partners, L.L.C.*, 400 F. Supp. 3d 1161 (D. Colo. 2019).

⁸¹ *Id.* at 1165.

⁸² Fed. R. Civ. P. 12(b)(6) (“a party may assert the following defenses by motion . . . (6) failure to state a claim upon which relief can be granted”).

⁸³ *Stouffer*, 400 F. Supp. 3d at 1165.

⁸⁴ *Id.*

⁸⁵ *Id.*

⁸⁶ *Stouffer*, 460 F. Supp. 3d at 1135.

⁸⁷ *Id.*

generic of accusations.”⁸⁸

B. *The Facts*

Marty and Mark Stouffer were brothers passionate about nature and filmmaking, so they founded Stouffer Productions.⁸⁹ After opening their production company, the brothers created the “Wild America” series, which aired from 1982 until 1996 and was at the top 10 regularly televised documentaries on PBS.⁹⁰ The “Wild America” series went into syndication and was popularized through streaming platforms such as Amazon, Google, and Apple as well as through DVD sales.⁹¹ The Stouffer brothers obtained a trademark registration for “Wild America” in 1982 but even more than that, they developed a unique style of filming using close-ups, time-lapses, and slow-motion to capture the beauty of nature.⁹²

Defendant, National Geographic, launched a television station in 2001 called “Nat Geo TV” and a sister channel in 2010 called “Nat Geo WILD.”⁹³ National Geographic contacted Stouffer in 2010 and 2011 to possibly purchase their “Wild America” film library, but such purchase was never realized.⁹⁴ In November of 2010, National Geographic contacted Stouffer to request permission to use “Wild Americans” and “Wildest Americans” as titles for its upcoming documentaries airing on Nat Geo TV.⁹⁵ Stouffer responded to National Geographic with their concerns that the proposed names closely resemble the Stouffer trademarks.⁹⁶ Nevertheless, National Geographic proceeded to air the following series: “Untamed Americans” (2012 series, which was named “Wild America” abroad), “America the Wild” (2013), “Surviving Wild America” (2014), and “America’s Wild Frontier” (2018).⁹⁷

C. *The Stouffer Test*

Unsatisfied with the outcome shown by the thirty-year history of applying the *Rogers* test, the district court asked, “is the *Rogers* test the right test?” and then responded with a resounding “no.”⁹⁸ The Court introduced a replacement for the two-prong *Rogers* test with the following six-prong test examining: 1) whether the junior user has added his own expressive content to the mark beyond that of the senior user; 2) whether the marks are used by both junior and senior user for similar kinds of goods and services; 3) whether the timing of the junior user’s use of the mark indicates “motive to capitalize on the popularity of senior user’s mark”; 4) whether the junior user’s use has any artistic relevance to the underlying work; 5) whether junior

⁸⁸ *Id.* at 1146.

⁸⁹ *Id.* at 1135.

⁹⁰ *Id.* (“PBS” refers to the Public Broadcasting Service).

⁹¹ *Stouffer*, 460 F. Supp. 3d at 1135–1136.

⁹² *Id.*

⁹³ *Id.* at 1136.

⁹⁴ *Id.* National Geographic declined to purchase the Stouffer library in 2010 and 2011 but requested that it be kept apprised if it was ever sold.

⁹⁵ *Id.*

⁹⁶ *Stouffer*, 460 F. Supp. 3d at 1136.

⁹⁷ *Id.*

⁹⁸ *Id.* at 1140 (“*Rogers* tilts too far in favor of the junior user’s First Amendment interests.”).

user's statements or conducts in public are suggestive of "non-artistic motive"; and 6) whether junior user's statements or conducts in private are suggestive of "non-artistic motive."⁹⁹

Applying the facts of the case to the newly proposed six-prong *Stouffer* test, the district court found that "[t]he choice of a title for one's expressive creation is an expressive choice unto itself, including the choice of a descriptive title."¹⁰⁰ The Court considered prongs two (kinds of goods and services being used), three (timing indicative of motive to capitalize on senior user's popularity), and five (public statements or conduct indicative of non-artistic motive) in *Stouffer*'s favor.¹⁰¹ Prongs one (junior user adding expressive content beyond the original mark), four (artistic relevance to the underlying work), and six (private statement or conduct indicative of non-artistic motive) tipped the scales back in National Geographic's favor.¹⁰² Concluding its analysis under the new test, the Court determined that the lack of specificity in *Stouffer*'s allegations and proof of the current popularity of "Wild America" were detrimental to *Stouffer*'s success in this action.¹⁰³

IV. ANALYSIS

This section will explore the new *Stouffer* test in detail to determine whether the proposed test truly brings innovation to the "Speech-Zilla meets Trademark Kong"¹⁰⁴ battle or simply disguises the old questions as new. Even if there is something new in the six-prong *Stouffer* test, does it address the current gap?¹⁰⁵ The answer to that question is "no," so this section will explore where we go from here.

A. What is New?

The *Stouffer* Court attempted to marry multiple different questions courts had asked in the cases following *Rogers* in a union resulting in a single six-prong test.¹⁰⁶ The test aimed to discern whether the "junior user ha[d] a genuine artistic motive for using the senior user's mark."¹⁰⁷ As tradition dictates, the *Stouffer* Court borrowed something old in order to complete this union.

First, the *Stouffer* Court did incorporate the *Rogers* two-prong test into its newly formed six-prong test.¹⁰⁸ The Court stated that the underlying artistic relevance, which was one of the *Rogers*' prongs, should be only one of the factors examined when

⁹⁹ *Id.*

¹⁰⁰ *Id.* at 1145.

¹⁰¹ *Stouffer*, 460 F. Supp. 3d at 1143–45.

¹⁰² *Id.*

¹⁰³ *Id.*

¹⁰⁴ *Mattel, Inc.*, 296 F.3d at 898.

¹⁰⁵ *Rogers*, 875 F.2d at 1006–07. Judge Griesa identified that gap left by the *Rogers* test as those cases of "flagrant deception" in which the title for the underlying work will be false but still artistically relevant. *Id.* Similarly, in *Stouffer*, Judge Martinez identified the gap as an absence of an inquiry into artistic motive in order to determine falsehood. *Stouffer*, 460 F. Supp. 3d at 1145.

¹⁰⁶ *Stouffer*, 400 F. Supp. 3d at 1179.

¹⁰⁷ *Id.*

¹⁰⁸ *Id.* One of the prongs of the *Stouffer* test was: "In what way is the mark artistically related to the underlying work, service or product?" (quoting *Rogers*, 875 F.2d at 1001).

considering artistic motive.¹⁰⁹ Artistic relevance was a difficult question to be determined by courts because “incongruity, irrelevance, and randomness can themselves be artistic choices.”¹¹⁰ Therefore, *Stouffer* does not reject *Rogers* but rather dilutes it by adding additional elements, which resulted in lesser weight being awarded to the artistic relevance prong.

Another factor of the *Stouffer* test that resulted from artistic relevance considerations was the inquiry into junior user’s private statements as suggestive of non-artistic motive.¹¹¹ The *Stouffer* Court cited the *Parks* decision when posing this inquiry.¹¹² In *Parks*, the artists had admitted that they never intended for the song to be about Rosa Parks but rather “just symbolic, meaning that we comin’ back out.”¹¹³ Furthermore, the notion of public and private statements or actions showing non-artistic motives have close ties with the *Rogers* explicitly misleading prong.

The multiple factors *Stouffer* included in its six-prong test are echoes of the considerations given by the Court in *Gordon* in its discussion of the explicitly misleading *Rogers* prong.¹¹⁴ In *Gordon*, the Ninth Circuit said that if the mark was the “centerpiece of an expressive work itself, unadorned with any artistic contribution by the junior user” that may show an effort to cause consumer confusion.¹¹⁵ Therefore, *Stouffer*’s question into additional content added by the junior user to the original mark was born out of the *Gordon* decision.¹¹⁶

¹⁰⁹ *Id.* at 1180.

¹¹⁰ *Id.* at 1180. Changing the facts of *Parks*, the Court in *Stouffer* illustrated the difficulty in determining artistic relevance. *Id.* The Court in *Parks* had to decide if the title “Rosa Parks” was artistically relevant to the underlying work or if was used for promotional purposes only. *Id.* at 1174. The *Stouffer* Court pointed out that in *Parks*, artistic relevance was based on a factual finding rather than an objective question of law. *Id.* at 1178. The Court in *Parks* had found that the lyrics of the song, namely the phrase “move to the back of the bus,” had no connection to the title “Rosa Parks.” *Id.* The *Stouffer* Court criticized the *Parks* decision because in its view “Rogers test forced the Sixth Circuit to hang its hat on the minimal artistic relevance prong because the explicitly misleading prong could not apply.” *Id.* To emphasize the difficulty of applying the underlying artistic relatedness test, the *Stouffer* Court posed the following hypothetical question: Would the title “Rosa Parks” have artistic relevance if a jazz band created a song without the lyrics? *Id.* at 1179. *Stouffer* suggests that the new test should be expanded to include the underlying artistic relevance test as part of determining artistic motive but it should not be a leading or a single factor in the outcome of the decision. *Id.*

¹¹¹ *Id.* at 1179.

¹¹² *Id.*

¹¹³ *Parks*, 329 F.3d at 452.

¹¹⁴ *Stouffer*, 400 F. Supp. 3d at 1179.

¹¹⁵ *Gordon*, 909 F.3d at 271.

¹¹⁶ Motion by Intell. Prop. Professors for Leave to File Brief Amicus Curiae in Support of Defendants at 9, *Stouffer v. Nat’l Geographic Partners, L.L.C.*, 400 F. Supp. 3d 1161 (D. Colo. 2019). The amici in their motion argued that the prong for additional expressive content resembles closely the transformative test used in copyright law. *Id.* The amici criticized *Stouffer* for adding this prong which “inappropriately imports copyright considerations into a trademark question.” *Id.* Copyright law does not protect short words and phrases like trademark law does. *Id.* Amici also argued that this prong is misplaced because the aim of copyright law is to foster innovation and the aim of trademark law is to prevent consumer confusion. *Id.* The amici saw the *Stouffer* inquiry into creativity and the artistic relatedness test (also part of the *Rogers* two-prong test) as creating a deep conflict between copyright and trademark law, especially the fact that courts have to venture into determining what level of creativity justifies use of the chosen title by the junior user. *Id.* at 10.

Two other prongs of the *Stouffer* tests were born out of the *Gordon* opinion.¹¹⁷ First was the inquiry into public statement or actions showing non-artistic motive, which would include “explicitly misleading” statements, as defined before *Gordon*.¹¹⁸ In *Gordon*, the Court defined explicitly misleading as not only an “affirmative statement of the plaintiff’s sponsorship or endorsement,” but also as the use of the mark in a way that would mislead consumers as to the source of the product.¹¹⁹ Therefore, *Stouffer*’s inquiry into a junior user’s public statements was not a novelty but a derivative prong from the *Gordon*’s discussion of the explicitly misleading element of the *Rogers* test.

Another one of *Stouffer*’s prongs born out of the *Gordon* opinion was the inquiry into the junior user’s timing as indicative of motive.¹²⁰ When discussing this inquiry, the *Stouffer* Court cited to a page in the *Gordon* opinion where the facts surrounding the timing of the infringement were discussed.¹²¹ In *Gordon*, the plaintiff posted the “Honey Badger Don’t Care” video on YouTube in January 2011, which quickly went viral.¹²² In the next eighteen months preceding the infringement, the plaintiff filed for copyright registration, trademark protection, started selling branded merchandise, and was voted one of “America’s Hottest Brands.”¹²³ Given all of the fame surrounding the plaintiff’s marks, the defendant could not recall how he came up with almost identical phrasing to the plaintiff’s trademark.¹²⁴ Given the way the Ninth Circuit in *Gordon* presented the timing of events, it begged the question if the junior user was trying to take advantage of the senior user’s rise in popularity.¹²⁵ The Court in *Gordon* never asked the question about timing because it did not configure in the *Rogers* two-prong test evaluation, but the Court in *Stouffer* made it clear that it should be part of the inquiry.¹²⁶

Finally, the *Stouffer* inquiry regarding the similarity of the kind of goods or services offered by the senior and junior users was derived from the likelihood of confusion test.¹²⁷ Early in the *Stouffer* opinion, the Court referred to the six-prong likelihood of confusion test the Tenth Circuit had relied on to resolve infringement

¹¹⁷ *Stouffer*, 400 F. Supp. 3d at 1179.

¹¹⁸ *Id.* at 1178–79.

¹¹⁹ *Gordon*, 909 F.3d at 269–70. Use of the trademark alone cannot satisfy the explicitly misleading prong if consumers would not use the mark to identify the origin of the goods but if they do, then the test may be satisfied. *Id.* at 270. The Ninth Circuit gave an example with a Mickey Mouse painting containing the Disney mark at the bottom corner as the use of the mark in this case would be relevant to the subject but still mislead consumers as to the source. *Id.*

¹²⁰ *Stouffer*, 400 F. Supp. 3d at 1179.

¹²¹ *Id.* (citing *Gordon*, 909 F.3d at 262).

¹²² *Gordon*, 909 F.3d at 262.

¹²³ *Id.*

¹²⁴ *Id.* at 262–63. The defendant in *Gordon* used the phrases “Me and Honey Badger don’t give a \$#%@! Happy Birthday” and “Honey Badger Don’t give a S--” written on the inside of greeting cards. *Id.* The plaintiff’s original phrases were “Honey Badger Don’t Care” (trademarked in class 16 (greeting cards)) and “Honey Badger Don’t Give a S--” *Id.* at 262. Both plaintiff and defendant were printing the marks on greeting cards. *Id.*

¹²⁵ *Id.*

¹²⁶ *Stouffer*, 400 F. Supp. 3d at 1179.

¹²⁷ *Id.*

issues dealing with consumer confusion involving non-artistic works.¹²⁸ The Court stated that the factor it added in its six-prong test was the same as the following likelihood of confusion prong: “the relation in use and the manner of marketing between the goods or services marketed by the competing parties.”¹²⁹ Here again, the *Stouffer* Court continues to borrow and merge concepts already existing in our jurisprudence to create a patched-up test sewn together by the unifying inquiry of an unartistic motive.

The *Stouffer* test is not novel because it does not offer an innovative inquiry and original perspective to resolve the imbalance between trademark law and First Amendment rights. The six-prong test is a result of a marriage of a multitude of concepts and questions born out of precedent following *Rogers*. However, it may offer a different perspective as it examined motive as the centerpiece of the inquiry. The question then becomes whether an inquiry into motive is too far removed from the aims of trademark law—to avoid consumer confusion.¹³⁰ Has *Stouffer* managed to resolve the imbalance *Rogers* created leaning too heavily on the side of the junior user?

B. Same Old, Same Old

To answer the above question regarding whether *Stouffer*’s six-prong test resolved the imbalanced scales of justice, this section will provide a look at how two key decisions criticized by *Stouffer* would have been decided had the courts examined the facts under the *Stouffer* test.

1. Gordon v. Drape Creative, Inc.

Stouffer called the *Gordon* opinion “analytically messy” as a result of being “constrained by precedent” it had no power to overrule but knew would lead to unjust results.¹³¹ *Stouffer* criticized *Gordon* for favoring the junior user given that there was minimal artistic relevance, the mark was used by the junior user precisely in the same manner as the senior user, and both users were using the mark in connection with the same goods.¹³² The *Stouffer* Court stated that the “*Rogers* test, taken at face value,

¹²⁸ *Id.* at 1170. The likelihood of confusion test used in the Tenth Circuit was comprised of the following factors:

- (a) the degree of similarity between the marks; (b) the intent of the alleged infringer in adopting its mark; (c) evidence of actual confusion; (d) the relation in use and the manner of marketing between the goods or services marketed by the competing parties; (e) the degree of care likely to be exercised by purchasers; and (f) the strength or weakness of the marks.

Id. (citing *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084, 1089–90 (10th Cir. 1999)).

¹²⁹ *Id.* (citing *King of the Mountain Sports, Inc.*, 185 F.3d at 1089).

¹³⁰ Motion by Intell. Prop. Professors for Leave to File Brief Amicus Curiae in Support of Defendants at 9, *Stouffer v. Nat’l Geographic Partners, L.L.C.*, 400 F. Supp. 3d 1161 (D. Colo. 2019).

¹³¹ *Stouffer*, 460 F. Supp. 3d at 1142.

¹³² *Id.*

essentially destroyed the value of Honey Badger mark.”¹³³ The question is if the *Gordon* decision would have turned out the same if the Ninth Circuit applied the *Stouffer* test?

The issue raised in *Gordon* was that the junior user used nearly the same or a similar mark to the senior user’s “Honey Badger Don’t Care” mark, and both were using it on greeting cards.¹³⁴ The *Gordon* Court followed the *Rogers* test and quickly determined that given that the artistic relevance had to be merely above zero, the first prong of *Rogers* was satisfied.¹³⁵ Because there were no affirmative statements by the junior user that they were purposefully trying to cause confusion in the marketplace, the Ninth Circuit had difficulty ruling as a matter of law on the *Rogers* second prong.¹³⁶

However, if the *Stouffer* test had been applied to the facts in *Gordon*, the Court might have had to weigh in additional factors. There were no facts mentioned in the *Gordon* opinion about public or private statements or conduct indicative of non-artistic motive.¹³⁷ However, there were facts that spoke to three of *Stouffer*’s prongs: 1) use of the marks by both parties to identify the same or similar kinds of goods and services; 2) addition of expressive content by the junior user to the original trademark; and 3) timing of use as suggestive of motive.¹³⁸ The first and second prongs of the *Stouffer* test, if under consideration, would weigh in favor of the senior user because, as the *Gordon* Court mentions, the junior user was only using a “slight variation of the HBDGS phrase.”¹³⁹ Both the senior and junior users were using the mark in connection with the same goods, which means that the manner of marketing the products would be similar as well.¹⁴⁰ Therefore, the junior user didn’t add any expressive elements and was using the mark in an identical way and in connection to the same goods as the senior user.

Finally, the *Stouffer* prong inquiring into timing would weigh in favor of the senior user because the junior user began using the mark at a time when the senior user’s popularity had soared and even the likes of Taylor Swift and Anderson Cooper were using it.¹⁴¹ These facts would be indicative of the motive for the junior user to ride on the fame of the senior user’s mark.

Applying the *Stouffer* test to the facts in *Gordon*, it seems that three of the prongs would have been in favor of the senior user and three in favor of the junior user. The prongs in favor of the senior user would have been the timing of the junior user’s use; the absence of the additions of expressive content to the original work; the goods at issue were the same; and were used in the same manner. The prongs in favor of the junior user would have been those related to artistic relevance under the above zero minimum standard required as well as the absence of public and private statements or actions to suggest non-artistic motives. If *Gordon* had to be decided by the *Stouffer* Court, it is not entirely clear that the decision would have been different.

¹³³ *Id.*

¹³⁴ *Gordon*, 909 F.3d at 260.

¹³⁵ *Id.* at 268.

¹³⁶ *Id.* at 271.

¹³⁷ *Stouffer*, 460 F. Supp. 3d at 1142.

¹³⁸ *Id.*

¹³⁹ *Gordon*, 909 F.3d at 271.

¹⁴⁰ *Id.* at 260.

¹⁴¹ *Id.* at 262.

It seems that the decision would depend on the weight awarded to each prong in relation to the others.

2. *Twentieth Century Fox Television*

Stouffer claimed that the rule taken from *Rogers* in combination with *Twentieth Century Fox Television* ruling meant “that trademarks registered for arguably artistic products and services are not worth the paper that the trademark registration is printed on.”¹⁴² Furthermore, the *Stouffer* Court qualified the Court’s interpretation of the *Rogers* test in *Twentieth Century Fox Television* as “needlessly rigid” and unable to “account for the realities of each situation.”¹⁴³ While the *Stouffer* Court was quick at handing down judgments, examining the facts of *Twentieth Century Fox Television* under the *Stouffer* test does not seem to point at a different outcome.

Twentieth Century Fox Television addressed an issue between an existing record label company called Empire Distribution and Fox’s television show called “Empire,” which also was centered around a music label.¹⁴⁴ The music label, the senior user in this case, was founded in 2010, and the junior user’s show began airing in 2015.¹⁴⁵ Fox’s “Empire” television show released music after each episode, soundtracks after the end of each season, hosted live performances, and sold merchandise all under the “Empire” brand.¹⁴⁶ The show was also marketed through media, radio, online advertising, live events, and the sale of merchandise.¹⁴⁷ So would the *Stouffer* test yield different results than *Rogers*, under the facts presented in this case?

First, the Ninth Circuit in *Twentieth Century Fox Television* discussed the *Stouffer* prong for artistic relevance and held in favor of the junior user.¹⁴⁸ The Court found that a television show was an expressive work and, given that the show was set at the Empire State Building in New York, the title “Empire” had artistic relevance.¹⁴⁹

The next prong, examining the addition of expressive content by the junior user to the original work, would also favor the junior user.¹⁵⁰ Fox created a television series with its own original music and storyline, which constitutes expressive content.¹⁵¹

¹⁴² *Stouffer*, 460 F. Supp. 3d at 1142.

¹⁴³ *Id.* at 1143.

¹⁴⁴ *Twentieth Century Fox Television*, 875 F.3d at 1195.

¹⁴⁵ *Id.*

¹⁴⁶ *Id.*

¹⁴⁷ *Id.* at 1196.

¹⁴⁸ *Id.* at 1198.

¹⁴⁹ *Twentieth Century Fox Television*, 875 F.3d at 1198.

¹⁵⁰ *Stouffer*, 460 F. Supp. 3d at 1140.

¹⁵¹ *Id.* The plaintiff in *Stouffer* had acknowledged that the defendant’s series had added expressive content but used the plaintiff’s template for making documentaries and had a similar looking show host. *Id.* The Court did not consider this prong in favor of the senior user because the template claimed by plaintiff was not protectable and was standard for the documentary industry. *Id.* Furthermore, the Court said that even if there was some merit to plaintiff’s claims regarding non-artistic motive behind the title picked by the defendant, the allegations were too generic for the Court to find this prong in favor of plaintiff. *Id.* at 1144. Applying the *Stouffer* analysis for this prong to the facts in *Twentieth Century Fox Television*, there is little doubt that the junior user would have won on this point. *Stouffer* compared two similar types of television documentaries, but in *Twentieth*

There is no doubt that even the *Stouffer* Court would have acknowledged that the junior user had added its own original content.

The third prong, related to the similarity of the marks and the marketing channels of both users, would have most likely resulted in a win for the senior user. The mark “Empire” was the same mark used by the junior and senior users.¹⁵² Even though the junior user made a television show and the senior user had a record label company, both parties marketed through similar channels.¹⁵³ Both the television show and the record label marketed their products and services through radio, television, live concerts, and merchandise sales.¹⁵⁴ Therefore, if examined under the *Stouffer* test, this prong might have swung in the direction of the senior user.

Stouffer’s prong concerning the timing of the junior user’s use of the mark as indicative of intent may be held in favor of the junior user in this case. There was nothing in the facts, as presented by the Court in *Twentieth Century Fox Television*, that was indicative of the junior user trying to ride the wave of fame of the senior user’s mark.¹⁵⁵ Given that there was no evidence to support a showing of the junior user’s motive, this prong may be decided in their favor.

The last two of the *Stouffer* prongs had to do with the public and private statements or conduct by the junior user indicating non-artistic motives.¹⁵⁶ In the case of *Twentieth Century Fox Television*, there was no evidence of such public or private statements or actions.¹⁵⁷ In fact, Empire Distribution argued that the Ninth Circuit should overrule the summary judgment granted by the court below to allow the parties to proceed to discovery.¹⁵⁸ The senior user hoped that discovery would reveal Fox’s reasons for selecting the name “Empire” for their show.¹⁵⁹ However, the Court held that such a finding would not be relevant to the *Rogers* test.¹⁶⁰ The question is if the Court used the *Stouffer* test, would it have allowed the case to proceed to discovery?

It is entirely clear that using the *Stouffer* test and applying the facts in *Twentieth Century Fox Television* would have yielded the same result in favor of the junior user. The junior user would win on artistic relevance, public and private statement, timing as indicative of motive, and expressive content prongs. The senior user would only win on the similarity of the trademarks. Absent further evidence for public and private statements, would the Court in *Stouffer* allow the parties to reach discovery? Based on the *Stouffer* Court’s own analysis of the private and public statement prongs, it is unlikely.¹⁶¹

Century Fox Television, the comparison was of two seemingly unrelated things, a title to a show with the name of an existing company.

¹⁵² *Twentieth Century Fox Television*, 875 F.3d at 1195.

¹⁵³ *Id.* at 1195–96.

¹⁵⁴ *Id.*

¹⁵⁵ *Id.* at 1195–1200.

¹⁵⁶ *Stouffer*, 460 F. Supp. 3d at 1140.

¹⁵⁷ *Twentieth Century Fox Television*, 875 F.3d at 1195–1200.

¹⁵⁸ *Id.* at 1999.

¹⁵⁹ *Id.*

¹⁶⁰ *Id.*

¹⁶¹ *Stouffer*, 460 F. Supp. 3d at 1136. When analyzing the public statements and conduct, the Ninth Circuit considered that the junior user used an identical trademark name, “Wild America,” as the name of its documentary outside the United States. *Id.* The Court considered this fact but quickly brushed it off as non-actionable, since it is used abroad. *Id.* When analyzing the private statements

C. Going Back to the Source of the Problem

Has *Stouffer* changed the battle strategy when “Speech-Zilla meets Trademark Kong?”¹⁶² The answer to that lies in what *Stouffer* set forth to accomplish in the first place. The Court in *Stouffer* had two specific goals in mind when it formed the six-prong test.¹⁶³ First, the Court set out to create a test that would allow the parties to settle trademark infringement disputes regarding artistic expression early on before the onset of discovery.¹⁶⁴ Second, the Court wanted to replace the *Rogers* test with a test that would root out those parties hiding behind First Amendment rights but who held non-artistic motives.¹⁶⁵ Unfortunately, *Stouffer* failed to accomplish either of its goals.

1. Avoiding Discovery

“First Amendment-based limiting construction on the Lanham Act should provide a test that can be applied as early as possible in the lawsuit.”¹⁶⁶ This is what the *Stouffer* Court tried to accomplish when creating its six-prong test.¹⁶⁷ The Court reasoned that if junior users could not resolve disputes quickly, in order to determine if they can use a particular artistic expression, it would “unduly chill expression.”¹⁶⁸ On the other hand, if all cases concerning artistic expression in the trademark infringement context have to go through discovery, then the senior users could always bring a “SLAPP” suit.¹⁶⁹

The amici did not believe that *Stouffer*’s test accomplished the above goal.¹⁷⁰ They reasoned that “[a] standard in which motive is central cannot perform” the function of allowing for early dismissal.¹⁷¹ *Stouffer*’s opinion does not provide a clear standard of what kind and how much evidence is required to prove motive.¹⁷² Also, from the above analysis of *Gordon* and *Twentieth Century Fox Television* under the *Stouffer* test, it is entirely evident that the application of *Stouffer* would require more

prong, the Court considered the fact that the junior user sought to obtain permission from the senior user. *Id.* The Court stated that such actions could be indicative of desire to avoid conflict or a desire to take advantage of the trademark value. *Id.* In either case, the Court did not give much explanation or consideration to these two prongs, although some evidence was suggestive of non-artistic motive. *Id.* Given the Court’s analysis in *Stouffer*, it seems that absent any evidence of private and public interest, the Court would stop the inquiry there. Therefore, it is entirely possible that if the *Stouffer* Court had to analyze these two prongs given the facts in *Twentieth Century Fox Television*, the Court would not have come out any different on these two issues.

¹⁶² *Mattel, Inc.*, 296 F.3d at 898.

¹⁶³ *Stouffer*, 460 F. Supp. 3d at 1140.

¹⁶⁴ *Id.* at 1140–41.

¹⁶⁵ *Id.*

¹⁶⁶ *Stouffer*, 400 F. Supp. 3d at 1178.

¹⁶⁷ *Id.*

¹⁶⁸ *Id.*

¹⁶⁹ *Id.* (“SLAPP” stands for “strategic lawsuit against public participation.”).

¹⁷⁰ Motion by Intell. Prop. Professors for Leave to File Brief Amicus Curiae in Support of Defendants at 6, *Stouffer v. Nat’l Geographic Partners, L.L.C.*, 400 F. Supp. 3d 1161 (D. Colo. 2019).

¹⁷¹ *Id.* at 5.

¹⁷² *Stouffer*, 460 F. Supp. 3d at 1143–45.

evidence, especially the inquiries into the timing and private statements or conduct in order to reveal if there is an ulterior motive to the junior user's use of the mark.¹⁷³ The *Stouffer* test does not seem to accomplish the goal of avoiding discovery and allowing for early dismissal of cases as it sought to do.¹⁷⁴

2. Replacing *Rogers*

The second goal *Stouffer* set out to accomplish was to replace the *Rogers* test because it “tilts too far in favor of the junior user’s First Amendment interests.”¹⁷⁵

The amici expressed its dissatisfaction with the *Stouffer* test because it was “worsening the uncertainty of a multifactor test by adding deep subjectivity to the factors.”¹⁷⁶ Furthermore, they stated that “[a]rtistic motivation cannot be split into true artistry on the one hand and desire to get attention on the other. Any test that tries to do so both misdescribes how creators work and bakes incoherence into the inquiry.”¹⁷⁷

The *Stouffer* Court set out to prevent the fate that senior users had suffered under *Rogers* and create something new that will again infuse balance in the scales of justice.¹⁷⁸ However, the application of the test to real cases may not be what Judge Martinez originally envisioned. The *Stouffer* Court incorporated *Rogers* factors of artistic expression and explicitly misleading overt statements.¹⁷⁹ The inquiries into private and public statements seem to echo the explicitly misleading prong of *Rogers*. The test then dives into copyright law and likelihood of confusion with its similarity of goods and services prong.¹⁸⁰ With its patched-up test sewn together by the unifying inquiry of an unartistic motive, *Stouffer* did not solve the problem left by the *Rogers* tradition. This becomes evident as the *Stouffer* Court ruled in favor of the junior user even after the Court stated that “there is evidence . . . that points toward a subjectively un-artistic motive.”¹⁸¹ What *Stouffer* did accomplish was point out a gap¹⁸² in our jurisprudence, which has been taken advantage of by junior users. The question remains, what do we do now?

V. CONCLUSION

Following the *Rogers* opinion in 1989, circuit after circuit has struggled to balance First Amendment rights to free speech in artistic expression with the rights of

¹⁷³ Motion by Intell. Prop. Professors for Leave to File Brief Amicus Curiae in Support of Defendants at 6, *Stouffer v. Nat’l Geographic Partners, L.L.C.*, 400 F. Supp. 3d 1161 (D. Colo. 2019). The amici reasoned that private statements cannot possibly deceive consumers and, after all, the aims of trademark law are to prevent consumer confusion. *Id.*

¹⁷⁴ *Stouffer*, 460 F. Supp. 3d at 1140–41.

¹⁷⁵ *Id.* at 1140.

¹⁷⁶ Motion by Intell. Prop. Professors for Leave to File Brief Amicus Curiae in Support of Defendants at 8, *Stouffer v. Nat’l Geographic Partners, L.L.C.*, 400 F. Supp. 3d 1161 (D. Colo. 2019).

¹⁷⁷ *Id.* at 2.

¹⁷⁸ *Stouffer*, 460 F. Supp. 3d at 1140–41.

¹⁷⁹ *Id.*

¹⁸⁰ *Id.*

¹⁸¹ *Id.* at 1145.

¹⁸² *See supra* note 105.

trademark owners to avoid confusion in the marketplace. The *Rogers* test provided a safe harbor for junior users to escape liability in infringement cases brought against them if they claimed that the use had an underlying artistic relevance.¹⁸³ For the last thirty years, such junior users were given “*carte blanche*”¹⁸⁴ because the threshold for relevance promulgated by the *Rogers* test was merely above zero.¹⁸⁵ The *Stouffer* Court set out to curtail the imbalance created in favor of junior users by introducing motive into the equation.¹⁸⁶

Thus far, the *Rogers* test has been criticized by Judge Griesa, writing in concurrence in *Rogers*, for offering a “cure . . . far worse than the ailment”¹⁸⁷ and by Judge Martinez, in *Stouffer*, for “tilt[ing] too far in favor of the junior user’s First Amendment interests.”¹⁸⁸ However, the six-prong test proposed by the Court in *Stouffer* was said to focus too much on the wrong issue.¹⁸⁹ The *Stouffer* test was criticized for focusing on the junior user’s artistic motive versus their desire to profit off of the senior user’s goodwill and not enough on protecting consumers, which is the aim of trademark law.¹⁹⁰ The *Stouffer* test borrowed elements from *Rogers*, from copyright law, and from the likelihood of confusion test used in trademark law in order to create its six-prong test laced with subjective questions into motive, artistic relevance, and expressive content.¹⁹¹ The result of infusing the test with subjective standards is that it prevents the speedy resolution of disputes at the pre-trial stage and therefore, may lead to the “unwarranted chilling of free expression.”¹⁹²

The importance of the *Stouffer* opinion may not be in its substantive contributions to our trademark jurisprudence in the form of its six-prong test, but it asked the right question. The *Stouffer* Court was the first one to outright oppose the adoption of the *Rogers* test and avoid creating yet another variation of it like most other courts have previously done. *Stouffer* shed light on the imbalance *Rogers* created and although the Court was not successful in formulating the right test to solve this issue, it opened the conversation to what are the right questions we should

¹⁸³ *Rogers*, 875 F.2d at 999.

¹⁸⁴ *Parks*, 329 F.3d at 447.

¹⁸⁵ *E.S.S. Entm’t 2000, Inc.*, 547 F.3d at 1100 (“the level of relevance merely must be above zero.”).

¹⁸⁶ *Stouffer*, 460 F. Supp. 3d at 1140. The Court’s last two prongs of the six-prong test dealt with private and public statements or actions made by the junior user showing non-artistic motive. *Id.*

¹⁸⁷ *Rogers*, 875 F.2d at 1006. In concurrence, Judge Griesa said that the circumstances of the case should not be used by the majority to put forward such a general proposition as they have with the *Rogers* test. *Id.*

¹⁸⁸ *Stouffer*, 460 F. Supp. 3d at 1140.

¹⁸⁹ Motion by Intell. Prop. Professors for Leave to File Brief Amicus Curiae in Support of Defendants at 10, *Stouffer v. Nat’l Geographic Partners, L.L.C.*, 400 F. Supp. 3d 1161 (D. Colo. 2019).

¹⁹⁰ *Id.*

¹⁹¹ *Stouffer*, 460 F. Supp. 3d at 1140–41.

¹⁹² *Id.* National Geographic and the amici both agreed that examination into motive and intent when examining First Amendment protections would chill free expression by making it more difficult to dismiss the case. *Id.* The *Stouffer* Court did not provide a response to this question except by stating that it will not adopt the *Rogers* test. *Id.* Given that the Court in *Stouffer* asked the question if “First Amendment-based limiting construction on the Lanham Act lead to a test that a court may apply before trial . . . ?,” it is curious that the Court chose not to answer that question. *Id.* The Court only discussed the inability of the *Rogers* test to dismiss cases in the pre-trial stage and offered no further comment on why the new six-prong test would. *Id.*

be asking in order to prevent flagrant deception by junior users.

The *Rogers* test has been easy enough to apply but it doesn't seem to strike the right balance between allowing freedom of speech and artistic expression while preserving trademark rights for senior users. When does artistic choice turn into trademark infringement? Under *Rogers*, the answer to that question seems to be closer to "never," and it gets further away from the protections of trademark law as courts continue to increase the number of works under the umbrella of artistic expression. However, as *Stouffer* indicates there are those cases cloaked as an artistic expression but with unartistic motive hiding underneath that exterior. There is a need for a clear standard that allows for early dismissal as prolonged litigation can only stifle creativity and expression. There is a need for a more balanced approach to the conflict between Speech-Zilla and Trademark Kong, and it is long overdue that the U.S. Supreme Court weighs in on this increasingly important issue.