

A CELEBRITY BALANCING ACT: AN ANALYSIS OF TRADEMARK PROTECTION UNDER THE LANHAM ACT AND THE FIRST AMENDMENT ARTISTIC EXPRESSION DEFENSE

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I. INTRODUCTION

In September of 1998, the rap music duo OutKast released the album *Aquemini*, which contained the popular song, *Rosa Parks*.¹ On the *Aquemini* album cover, next to a label describing *Rosa Parks* as a “hit single,” is a Parental Advisory sticker warning of the song’s explicit content.² The lyrics of the song’s hook, or chorus, are as follows:

Ah ha, hush that fuss
Everybody move to the back of the bus

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¹ *Parks v. LaFace Records*, 329 F.3d 437, 442 (6th Cir. 2003), *cert. denied*, 540 U.S. 1074 (2003).

² *Id.*

Do you wanna bump and slump with us
We the type of people make the club get crunk³

The song contains no direct reference to Rosa Parks⁴ other than the title and what may be implied by the line “everybody move to the back of the bus.”⁵

The song *Rosa Parks* garnered positive reviews, with OutKast receiving a Grammy nomination for the hit single⁶ and the *Aquemini* album achieving multi-platinum status;⁷ however, not everyone was pleased with the song and its success. Rosa Parks filed suit against OutKast⁸ and LaFace

³ *Id.* at 442–43. The rest of the song continues:

Verse 1:

Many a day has passed, the night has gone by/But I still find the time to put that bump off in your eye/Total chaos, for these playas, thought we was absent/We takin another route to represent the Dungeon Family/Like Great Day, me and my nigga decide to take the back way/We stabbing every city then we headed to that bat cave/A-T-L, Georgia, what we do for ya/Bull doggin hoes like them Georgetown Hoyas/Boy you sounding silly, thank my Brougham aint sittin pretty/Doing doughnuts round you suckas like then circles around titties/Damn we the committee gone burn it down/But us gone bust you in the mouth with the chorus now/

(Hook)

Verse 2:

I met a gypsy and she hipped me to some life game/To stimulate then activate the left and right brain/Said baby boy you only funky as your last cut/You focus on the past your ass’ll be a has what/Thats one to live by or either that one to die to/I try to just throw it at you determine your own adventure/André, got to her station here’s my destination/She got off the bus, the conversation lingered in my head for hours/Took a shower kinda sour cause my favorite group ain’t comin with it/But I’m witcha you cause you probably goin through it anyway/But anyhow when in doubt went on out and bought it/Cause I thought it would be jammin but examine all the flawsky-wawsky/Awfully, it’s sad and it’s costly, but that’s all she wrote/And I hope I never have to float in that boat/Up shit creek it’s weak is the last quote/That I want to hear when I’m goin down when all’s said and done/And we got a new joe in town/When the record player get to skippin and slowin down/All yawl can say is them niggas earned that crown but until then . . .

(Hook).

Id. at 442–43.

⁴ Rosa Parks is a famous historical figure who first gained recognition when she refused to give up her seat to a white passenger and move to the back of a segregated bus in December of 1955. *Id.* at 442. As a result of her actions, the Montgomery Bus Boycott, a 381-day boycott of the city’s segregated bus system, was born. *Id.* Her single act of defiance became a “catalyst” for further organized boycotts and demonstrations all across the South. *Id.* Rosa Parks received many accolades for her actions, and she has used her celebrity status to promote civil and human rights causes. *Id.* She has also promoted television programs and books inspired by her life story, and she approved a 1995 collection of gospel recordings by various artists entitled *Verity Records Presents: A Tribute to Mrs. Rosa Parks*. *Id.*

⁵ *See id.* at 452 (discussing the appellate court’s disagreement with the district court’s determination that the line “move to the back of the bus” was a reference to Rosa Parks).

⁶ Werner, *Rosa Parks vs. OutKast*, ROLLING STONE, April 2, 1999, at <http://www.rollingstone.com/news/newsarticle.asp?nid=7480>.

⁷ Josh Grossberg, *Rosa Parks Trumps “Rosa Parks,”* E! ONLINE, May 13, 2003, at <http://www.eonline.com/News/Items/0,1,11783,00.html>.

⁸ OutKast is composed of two artists, André Benjamin (“Dré”) and Antwan Patton (“Big Boi”). *Parks*, 329 F.3d at 442. OutKast was again the subject of public debate when CBS offered a public apology for OutKast’s performance at the 2004 Grammy Awards. The performance featured “frenetic dancing, feathers and war paint—which some called . . . degrading” to Native Americans. Associated Press, *Grammy Performance by OutKast Angers American Indians* (Feb. 13, 2004), available at

records, the group's producer, and several other named affiliates, claiming that OutKast's unauthorized use of her name as the title of their song violated her common law right of publicity⁹ and was a false advertising violation under section 43(a) of the federal Lanham Act.¹⁰ Gregory Reed, Ms. Parks's lawyer, stated that to "have her name associated with lyrics that contain vulgarity and profanity" is a state of affairs that Ms. Parks "does not appreciate."¹¹ Due to her widely recognized role in the civil rights movement, Rosa Parks is known to many as a symbol of "freedom, humanity, dignity, and strength."¹² To find a name with these connotations on the cover of a music album that contains a Parental Advisory warning for explicit content is certainly enough to upset and offend not only Rosa Parks herself, but also many of those who view her as a symbol of the entire civil rights movement.¹³ Of additional concern is the possibility that the use of Rosa Parks's name as the title of the song would be viewed by the public as an approval, sponsorship, or endorsement of the views contained within the song.¹⁴

However, before Rosa Parks's case went to a jury, the district court granted the defendant's motion for summary judgment, noting that the First Amendment could operate as a defense to Rosa Parks's state right of publicity claim and that First Amendment interests were of significant concern in deciding her federal Lanham Act claims.¹⁵ The district court found that there was an obvious relationship between the *Rosa Parks* title and the content of the song.¹⁶ The court also found that, even if there were some likelihood of confusion regarding the endorsement or sponsorship of the song,¹⁷ any risk of that nature was outweighed by the defendants' First Amendment rights to freedom of expression.¹⁸ Based on this conclusion, the district

<http://www.contracostatimes.com/mld/cctimes/7949009.htm>.

⁹ While not the focus of this Comment, the right of publicity is similar in many respects to a celebrity Lanham Act claim. For a discussion of the right of publicity, see Bruce P. Keller, *The Right of Publicity: Past, Present, and Future*, in *ADVERTISING LAW IN THE NEW MEDIA AGE 2000*, 159 (PLI Corp. Law & Practice Course, Handbook Series No. 808, 2000). For more on the origins of the common law right of publicity, see William J. Prosser, *Privacy*, 48 CAL. L. REV. 383, 398 (1960).

¹⁰ *Parks*, 329 F.3d at 441.

¹¹ Werner, *supra* note 6.

¹² *Parks*, 329 F.3d at 456.

¹³ The Sixth Circuit in *Parks* stated that the song was by no "stretch of the imagination" a reference to the courage and sacrifice of the civil rights movement. *Id.* at 453.

¹⁴ *See id.* at 454.

¹⁵ *Parks v. LaFace Records*, 76 F. Supp. 2d 775, 779–80, 782 (E.D. Mich. 1999).

¹⁶ *Id.* at 782.

¹⁷ The district court, however, discounted the idea that there could be any consumer confusion at all. The court found that there was no explicit representation that Rosa Parks endorsed the song and that the prominent appearance of the name of the group, OutKast, on the album cured any likelihood of consumer confusion. *Id.* at 783–84.

¹⁸ *Id.* at 783. The court stated that in this instance "the consumer interest in avoiding deception is too slight to warrant application of the Lanham Act." *Id.* The court found that any risk of misunderstanding was not engendered by an overt claim in the title and was thus "so outweighed by the interests

court granted summary judgment for the defendants on Parks's right of publicity and Lanham Act claims.¹⁹ Rosa Parks then appealed the rulings on these issues to the Court of Appeals for the Sixth Circuit.

The Sixth Circuit faced the challenge of determining whether OutKast had a First Amendment right to use Rosa Parks's name as the title of their song given the protections of federal trademark law under the Lanham Act. The issue before the court was not a typical instance of trademark infringement; rather, it involved the tension between the protections of trademark law and the liberty interests embodied in the First Amendment. Under the Lanham Act, a celebrity,²⁰ such as Rosa Parks, has the ability to vindicate property rights in her identity against misleading commercial use by others.²¹ However, the First Amendment protections of artistic expression can serve as a limitation on the application of the Lanham Act.²²

In resolving the Lanham Act issue on appeal, the Sixth Circuit examined three different approaches that courts have adopted to balance First Amendment interests with the protections of the Lanham Act: (1) the "likelihood of confusion" test, (2) the "alternative avenues" test; and (3) the "artistic relevance" test articulated by the Second Circuit in *Rogers v. Grimaldi* (hereinafter the "Rogers test").²³ The court ultimately chose the *Rogers* test²⁴ as the most appropriate method for analyzing Rosa Parks's Lanham

in artistic expression as to preclude the application of the Lanham Act." *Id.*

¹⁹ *Id.* at 785.

²⁰ For the purposes of the *Parks* case and this Comment, the definition of a celebrity is a "celebrated or widely known person: one popularly honored for some signal achievement." *Parks*, 329 F.3d at 447 n.3 (quoting WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 359 (Phillip Babcock Gove ed., 1976)).

²¹ 15 U.S.C. § 1125 (2000); *see, e.g.*, *Waits v. Frito Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992) (involving a celebrity's lawsuit for unauthorized use of his distinctive voice in a commercial). In *Waits*, the Ninth Circuit stated that a celebrity plaintiff had standing to sue under the Lanham Act alleging false endorsement, because a claim for false endorsement based upon unauthorized use of a celebrity's identity is "a type of false association claim, for it alleges the misuse of a trademark, i.e., a symbol or device such as a visual likeness, vocal imitation, or other uniquely distinguishing characteristic, which is likely to confuse consumers as to the plaintiff's sponsorship or approval of the product." *Id.* The *Waits* court stated that it would not require "actual competition" for the celebrity to have standing to sue; rather, the court found standing to extend to "a purported endorser who has an economic interest akin to that of a trademark holder in controlling the commercial exploitation of his or her identity." *Id.*

²² *See, e.g.*, *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989) (stating that First Amendment concerns must inform the court's "consideration of the scope of the Act as applied to claims involving such titles").

²³ *Parks*, 329 F.3d at 447. The multiple tests are the result of a circuit split among the courts of appeals. Different courts have endorsed different tests, and some circuits have actually applied multiple tests.

²⁴ The *Rogers* test will be discussed in further detail *infra* Part III.C. Under the two-prong test, a title of an artistic work, such as OutKast's *Rosa Parks* title, will be protected from a celebrity's Lanham Act claim unless (1) the title has no artistic relevance to the underlying work, or (2) if there is artistic relevance, the title "explicitly misleads as to the source or the content of the work." *Rogers*, 875 F.2d at 999.

Act claims against OutKast and LaFace records.²⁵ Under the framework of the *Rogers* test, the court found that summary judgment for the defendants was inappropriate because there was a genuine issue of material fact as to whether Rosa Parks's name was artistically relevant to the content of OutKast's song, *Rosa Parks*.²⁶ Thus, the Sixth Circuit remanded the case for a finder of fact, rather than the appellate court, to determine whether the title *Rosa Parks* had any artistic relevance to the content of OutKast's song.²⁷

The *Parks* case highlights one of the most difficult challenges courts face in resolving celebrity Lanham Act claims—determining which framework or test is appropriate for analyzing such claims in light of an asserted First Amendment defense. An additional difficulty courts face is in the intricacies involved with determining, under certain tests, whether the use of a celebrity's name or identity is artistically relevant to an underlying work of art.²⁸ This has become especially problematic due to the fact that courts' determinations of artistic relevance, or lack thereof, are often relatively limited,²⁹ which deprives these decisions of some of their precedential weight and offers only minimal guidance to future courts and celebrities in comparable situations.

This Comment will examine the three different approaches courts have used to strike the balance between protections of a celebrity's name and identity under the Lanham Act and First Amendment liberties of the public and artists in works of artistic expression. The Comment will attempt to formulate a better framework for balancing the competing interests that arise in such situations. It will then further articulate factors based on federal trademark and copyright law for courts to consider when determining whether the use of a celebrity's name or identity is artistically relevant to the underlying work.

Part II of this Comment briefly introduces trademark law and the First Amendment as they apply to the use of celebrities' names and identities in the context of artistic expression. Part III explores the three current approaches that courts use to strike the balance between Lanham Act protections and First Amendment liberties: the likelihood of confusion test, the alternative avenues test, and the *Rogers* test. It then examines the arguments for and against the application of each test.

Part IV of this Comment proposes a modified test for analyzing the competing interests and provides factors that courts should consider in applying this test. Under the proposed test, a court faced with a celebrity

²⁵ *Parks*, 329 F.3d at 450.

²⁶ *Id.* at 458–59.

²⁷ *Id.* at 459.

²⁸ This difficulty arises under the first prong of the *Rogers* test and under other variations of that test. *Rogers*, 875 F.2d at 999. See *infra* Part III.C for discussion of the intrinsic difficulties associated with an artistic relevance determination.

²⁹ See, e.g., *Parks v. LaFace Records*, 76 F. Supp. 2d 775, 781 (E.D. Mich. 1999).

Lanham Act claim and an asserted First Amendment defense would apply a two-pronged balancing approach. Using this balancing test, the court would first analyze the case by applying the traditional likelihood of confusion factors, used throughout trademark law to ascertain the level of consumer confusion created by an allegedly infringing use of a trademark.³⁰ If the court found that a likelihood of confusion existed, it would then examine the artistic relevance of using the celebrity's name or identity to the underlying work,³¹ drawing upon several factors from fair use defenses in intellectual property law.³² These factors include the nature of the use of the celebrity's name or identity, the relationship between the celebrity and the product, the transformative nature of the use, and an underlying element of good faith on the part of the defendant.

II. TRADEMARK LAW AND THE FIRST AMENDMENT

A. Trademark Protection, the Lanham Act, and the Right of Publicity

Trademarks, the words and symbols used to identify and distinguish goods and services to consumers,³³ have become increasingly important in modern intellectual property law and to society in general.³⁴ Trademarks

³⁰ Part III.A, *infra*, will explain and enumerate the traditional likelihood of confusion factors, drawn from two cases in particular: *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979), and *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir. 1961).

³¹ This part of the proposed balancing test is derived from the first prong of the *Rogers* test. The purpose of this Comment in regards to this prong is to give depth to the artistic relevance determination by enumerating factors that courts can consider in determining whether the use of a celebrity's name or identity is artistically relevant to an underlying work of art.

³² These factors, both their origin and application, will be explained *infra* Part IV.B.

³³ 15 U.S.C. § 1127 (2000). Section 1127 states:

The term "trademark" includes any word, name, symbol, or device, or any combination thereof— (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Id. In order to be protected as a valid trademark, "a designation must create 'a separate and distinct commercial impression, which . . . performs the trademark function of identifying the source of the merchandise and to the customers.'" *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 753 (6th Cir. 1998) (quoting *In re Chem. Dynamics, Inc.*, 839 F.2d 1569, 1571 (Fed. Cir. 1988)).

³⁴ Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 397 (1990). Dreyfuss states that "[t]rademarks have come a long way" from their origins as a marketing tool of the merchant class in the middle ages to their current place in popular culture. *Id.* Dreyfuss notes:

[These] ideograms that once functioned solely as signals denoting the source, origin, and quality of goods, have become products in their own right, valued as indicators of the status, preferences, and aspirations of those who use them. Some trademarks have worked their way into the English language; others provide bases for vibrant, evocative metaphors. In a sense, trademarks are the emerging lingua franca: with a sufficient command of these terms, one can make oneself understood the world over, and in the process, enjoy the comforts of home.

Id. at 397–98.

are protected by federal law under the Lanham Act, which was enacted by Congress in 1947.³⁵ Section 43(a) of the Lanham Act creates a civil cause of action against any person who identifies his product in a way that is likely to cause consumer confusion regarding the product.³⁶ The language of section 43(a) is quite broad and covers many areas of consumer confusion. It states in relevant part:

(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 . . .

. . . .

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.³⁷

The intent of this portion of the Lanham Act, as stated by Congress in the Act itself, is to

regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; . . . to protect persons engaged in such commerce against unfair competition; [and] to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks³⁸

Generally, section 43(a) of the Lanham Act is invoked by plaintiffs to protect their “rights in ‘marks,’ or brand names, of ordinary merchan-

³⁵ 15 U.S.C. §§ 1051–1127. The Act protects both marks registered with the United States Patent and Trademark Office and unregistered marks in active use. See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:7, at 2-12 (4th ed. 2005).

³⁶ 15 U.S.C. § 1125.

³⁷ *Id.*

³⁸ *Id.* The United States Supreme Court has stated that in creating the Lanham Act, “Congress determined that ‘a sound public policy requires that trademarks should receive nationally the greatest protection that can be given them.’” *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 193 (1985). The legislative history of the Lanham Act further highlights the importance of protecting trademarks:

Trade-marks, indeed, are the essence of competition, because they make possible a choice between competing articles by enabling the buyer to distinguish one from the other. Trade-marks encourage the maintenance of quality by securing to the producer the benefit of the good reputation which excellence creates. To protect trade-marks, therefore, is to protect the public from deceit, to foster fair competition, and to secure to the business community the advantages of reputation and good will by preventing their diversion from those who have created them to those who have not. This is the end to which [the Lanham Act] is directed.

S. REP. NO. 79-1333, at 4 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274, 1275.

dise”³⁹ However, the scope of section 43(a) is broad enough that it extends beyond disputes between commercial competitors.⁴⁰ Relevant to this Comment, it also allows celebrities to “vindicate property rights in their identities against allegedly misleading commercial use by others.”⁴¹ Celebrities have standing to sue under section 43(a) of the Lanham Act “because they possess an economic interest in their identities” similar to that of the traditional trademark holder.⁴² The mark that is at issue when a celebrity sues under this section is the plaintiff’s identity or persona.⁴³ To prevail in a claim under section 43(a), the celebrity plaintiff must show that the allegedly infringing use of her name is likely to cause consumers confusion “as to the ‘affiliation, connection, or association’ between the celebrity and the . . . goods or services, or as to the celebrity’s participation in the ‘origin, sponsorship, or approval’ of the . . . goods or services.”⁴⁴ The celebrity plaintiff must establish the likelihood that the defendant’s designation will be confused with the plaintiff’s trademark (her name or identity), such that consumers are, or are likely to be, mistakenly led to believe that the defendant’s goods are produced by or sponsored by the plaintiff.⁴⁵

The celebrity’s ability to sue under the Lanham Act for an allegedly misleading commercial use of her identity is analogous to a celebrity’s ability to sue for alleged violation of her common law right of publicity.⁴⁶ The common law right of publicity developed in order to protect celebrities’ commercial interest in their identities.⁴⁷ The focus of the right of publicity

³⁹ *Parks v. LaFace Records*, 329 F.3d 437, 445 (6th Cir. 2003).

⁴⁰ *Id.*; see also Marcia B. Paul, *Section 43(a) of the Lanham Act*, 284 PLI/PAT 131, 257–69 (1989).

⁴¹ *Parks*, 329 F.3d at 445; see also *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407, 410 (9th Cir. 1996) (unauthorized use of celebrity’s birth name); *Waits v. Frito Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992) (unauthorized use of celebrity’s distinctive voice in a commercial); *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612, 624–25 (S.D.N.Y. 1985) (use of a celebrity look-alike in advertisements).

⁴² *Parks*, 329 F.3d at 445. See generally 4 MCCARTHY, *supra* note 35, § 28:15, at 28-19.

⁴³ *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992).

⁴⁴ 15 U.S.C. § 1125 (2000); *Parks*, 329 F.3d at 445–46.

⁴⁵ *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 753–54 (6th Cir. 1998).

⁴⁶ One of the “earliest and most enduring articulations of the common law right to publicity cause of action” comes from Prosser. *White*, 971 F.2d at 1397–98. Prosser created a “name or likeness” formulation by looking at the case law in the area and recognizing that the right of publicity cases generally involved name appropriation or picture/likeness appropriation. Prosser, *supra* note 9, at 401–02. However, Prosser also recognized that there could be a right of publicity outside of the traditional “name or likeness” formulation, stating that “[i]t is not impossible that there might be appropriation of the plaintiff’s identity, as by impersonation” that would lead to an invasion of his right to privacy. *Id.* at 401 n.155. Case law supports this proposition, and while the more typical cause of action for violation of a celebrity’s right of publicity involves the traditional “name or likeness” formulation, the cause of action is not limited to the appropriation of one’s name or likeness. *White*, 971 F.2d at 1398.

⁴⁷ *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983). The theory of the right to publicity is that “a celebrity’s identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity.” *Id.* Other justifications for the right of publicity include furthering economic goals, such as

is on protecting the celebrity's identity from economic exploitation⁴⁸ and providing an "incentive for creativity and achievement."⁴⁹ When a celebrity brings a Lanham Act section 43(a) claim for false advertising or endorsement involving the use of their name or identity, courts often consider these claims at the same time and in the same light as any state claim for a violation of the celebrity's right of publicity.⁵⁰ This has led some commentators to observe that a Lanham Act claim for false endorsement is practically the federal equivalent of the state protected right of publicity.⁵¹ However, due to the language of section 43(a) of the Lanham Act, the focus is still on the likelihood of consumer confusion created by the use of the celebrity's name or identity.⁵²

B. *The First Amendment and Its Application to the Lanham Act*

At times the strong protections of trademark law under the Lanham Act clash with an even stronger protection, the First Amendment safeguard of freedom of speech.⁵³ In the typical scenario, a trademark "is a form of commercial speech and nothing more."⁵⁴ In such situations, regulating trademarks to ensure that their use is not deceptive generally protects the public without impermissibly encroaching upon free expression or offending the First Amendment.⁵⁵ However, with trademark use that is not solely

promoting the efficient allocation of resources and protecting consumers, and protecting noneconomic interests, such as safeguarding natural rights and securing to the celebrity the fruits of his own labors. *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 973 (10th Cir. 1996).

⁴⁸ *Carson*, 698 F.2d at 835.

⁴⁹ *Cardtoons*, 95 F.3d at 973.

⁵⁰ See *Parks v. LaFace Records*, 329 F.3d 437, 459 (6th Cir. 2003) (stating that "Parks' [sic] right of publicity argument tracks that of her Lanham Act claim."). In many cases where a claim is brought under section 43(a) of the Lanham Act, the plaintiff will allege a violation of his common law right of publicity will as well. See, e.g., *id.*

⁵¹ See Keller, *supra* note 9, at 170.

⁵² See, e.g., *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992). In contrast, justifications for the right of publicity differ, and focus primarily on the argument that a right of publicity provides an incentive for creativity and achievement. *Cardtoons*, 95 F.3d at 973.

⁵³ The First Amendment provides that "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances." U.S. CONST. amend. I (emphasis added). The Supreme Court has recognized that "the freedoms of speech and of the press rank among our most cherished liberties. . . . The durability of our system of self-government hinges upon the preservation of these freedoms." *Pittsburgh Press Co. v. Pittsburgh Comm'n on Human Relations*, 413 U.S. 376, 381–82 (1973). However, artistic expression in general often conflicts with intellectual property rights. *Girl Scouts of the U.S.A. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 808 F. Supp. 1112, 1118 (S.D.N.Y. 1992).

⁵⁴ *Silverman v. CBS Inc.*, 870 F.2d 40, 48 (2d Cir. 1989) (quoting *Friedman v. Rogers*, 440 U.S. 1, 11 (1979)).

⁵⁵ *Id.* Commercial speech receives a lower, although still substantial, level of protection under First Amendment jurisprudence. *Dunn & Bradstreet, Inc., v. Greenmoss Builders*, 472 U.S. 749, 760 (1985).

commercial speech, particularly within the world of artistic expression, enforcement of trademark rights risks limiting free expression.⁵⁶

Artistic expression is a form of free speech strongly protected by the First Amendment.⁵⁷ The Constitution “looks beyond written or spoken words as mediums of expression”⁵⁸ and protects other modes of communicating ideas as well. Music, a means by which people have expressed ideas since ancient times,⁵⁹ is protected as a form of expression and communication under the First Amendment.⁶⁰ Other avenues of artistic expression, including visual arts such as photography and film, are also protected by the First Amendment.⁶¹ Further, First Amendment protection still applies to an expressive work of music, literature, and other types of art, even if it is “carried through in a form that is sold for profit.”⁶² Thus, the mere fact that artistic and expressive materials are sold does not diminish the degree of First Amendment protection they are entitled to receive.⁶³

In developing the Lanham Act, Congress was aware of the potential for conflict with the First Amendment and did not intend for the Act’s protections to exceed or limit those of the First Amendment.⁶⁴ The legislative history of the Lanham Act, especially that surrounding the 1989 amendments to section 43(a), makes it clear that Congress took the First Amendment into account in developing the Act’s protections and requirements.⁶⁵ Repre-

⁵⁶ *Silverman*, 870 F.2d at 48. However, some commentators “have noted that courts frequently overprotect trademarks at the expense of First Amendment interests.” *Girl Scouts*, 808 F. Supp. at 1118; Dreyfuss, *supra* note 34, at 398 (stating that First Amendment law has been “uncongenial” as a method of limiting trademark rights).

⁵⁷ See *Nat’l Endowment for the Arts v. Finley*, 524 U.S. 569, 602 (1998) (“It goes without saying that artistic expression lies within this First Amendment protection.”).

⁵⁸ *Hurley v. Irish-American Gay, Lesbian, and Bisexual Group of Boston, Inc.*, 515 U.S. 557, 569 (1995).

⁵⁹ *Parks v. LaFace Records*, 329 F.3d 437, 447 (6th Cir. 2003).

⁶⁰ *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989).

⁶¹ *Berry v. City of New York*, 97 F.3d 689, 695 (2d Cir. 1996) (stating that “[v]isual art is as wide ranging in its depiction of ideas, concepts and emotions as any book, treatise, pamphlet or other writing, and is similarly entitled to full First Amendment protection”).

⁶² *Time, Inc. v. Hill*, 385 U.S. 374, 397 (1967) (“That books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment.”); *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003). Courts sometimes refer to this sort of speech as “hybrid speech”—speech where commercial advertisement and promotion is “inextricably intertwined” with expressive speech. See, e.g., *O’Grady v. Twentieth Century Fox Film Corp. & Discovery Communications, Inc.*, No. 5:02CV173, 2003 U.S. Dist. LEXIS 24936, at *40–41 (E.D. Tex. Dec. 19, 2003). For example, in *Rogers v. Grimaldi*, the Second Circuit held that a movie title “may be both an integral element of the film-maker’s expression as well as a significant means of marketing the film to the public.” 875 F.2d 994, 998 (2d Cir. 1989).

⁶³ Fully protected speech, which is bought and sold in the market place, should be distinguished from commercial speech, which, at its core, is speech which does “no more than propose a commercial transaction.” *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 422 (1993) (quoting *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66 (1983)).

⁶⁴ 135 CONG. REC. H1216 (1989) (statement of Rep. Kastenmeier).

⁶⁵ *Id.*

sentative Kastenmeier stated during a discussion regarding the 1989 revisions that the “proposed change in section 43(a) should not be read in any way to limit political speech, consumer or editorial comment, parodies, satires, or other constitutionally protected material.”⁶⁶ If courts were to act in a way that would unreasonably prevent “filmmakers, novelists, painters, and political satirists from including trademarks in their works[, such action would] cordon off an important part of modern culture from public discourse.”⁶⁷ Thus, courts have been quite careful, especially in the context of artistic expression, not to overextend the Act in ways that would intrude upon First Amendment values.⁶⁸

However, there are limits to the protections of the First Amendment in the area of artistic expression. 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.”⁶⁹ A trademark owner’s protection cannot be lost solely because an alleged infringer claims that he has used the trademark as part of a work of artistic expression.⁷⁰ As the Second Circuit, in an oft-quoted phrase, astutely pointed out, “[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.”⁷¹ A court must weigh competing interests when faced with a celebrity’s section 43(a) claim for misuse of his name or identity in a work that is arguably one of artistic expression. The court must strike a balance between First Amendment liberties of free artistic expression and Lanham Act protections against false advertising and false endorsement.⁷² American courts have yet to develop and adopt a singular approach for striking this balance, and there is continued disagreement between both appellate courts and commentators on how this should be accomplished. The next Part takes up the different approaches courts and commentators have employed.

⁶⁶ *Id.*

⁶⁷ *Girl Scouts of the U.S.A. v. Bantam Doubleday Publ’g Group, Inc.*, 808 F. Supp. 1112, 1119 (S.D.N.Y. 1992) (quoting Robert N. Kravitz, *Trademarks, Speech, and the Gay Olympics Case*, 69 B.U. L. REV. 131, 152 (1989)).

⁶⁸ *See Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989) (stating that “[b]ecause overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly so as to avoid such a conflict”).

⁶⁹ *Parks v. LaFace Records*, 329 F.3d 437, 447 (6th Cir. 2003).

⁷⁰ *Id.* (quoting *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc.*, 886 F.2d 490, 493 (2d Cir. 1989)); *see also Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184, 1187–88 (5th Cir. 1979) (“The [F]irst [A]mendment is not a license to trammel on legally recognized rights in intellectual property.”)

⁷¹ *Rogers*, 875 F.2d at 997–98. The court also noted that because works embodying First Amendment expression such as movies, books, plays and songs are sold in the commercial marketplace, there is a danger of consumer deception that legitimately deserves some level of regulation by the government. *Id.* at 997.

⁷² *See, e.g., id.* at 999.

III. CURRENT APPROACHES TO BALANCING FIRST AMENDMENT RIGHTS AND THE PROTECTIONS OF THE LANHAM ACT

As the Sixth Circuit observed in *Parks*, there are currently three established approaches that courts use to balance First Amendment interests with the protections of the Lanham Act.⁷³ These approaches are (1) the “likelihood of confusion” test, (2) the “alternative avenues” test, and (3) the *Rogers v. Grimaldi*, or “*Rogers*,” test.⁷⁴ The following sections will further explain how each test is applied, and evaluate each of the three tests in terms of its protection of trademark concerns and First Amendment liberties.

A. Likelihood of Confusion Test

In applying the “likelihood of confusion” test, courts rely solely on the traditional likelihood of confusion factors applied in other trademark cases where a First Amendment interest in freedom of expression is not at issue.⁷⁵ Courts use different variations of the likelihood of confusion factors in analyzing alleged Lanham Act infringement. Two of the most prevalent versions are the *Sleekcraft* factors⁷⁶ and the *Polaroid* factors.⁷⁷ Some courts employ the following eight *Sleekcraft* factors, derived from *AMF Inc. v. Sleekcraft Boats*:⁷⁸ (1) the strength of the plaintiff’s mark; (2) the relatedness/proximity of the goods; (3) the similarity of the marks; (4) evidence of actual confusion; (5) the marketing channels used; (6) the type of goods and the likely degree of purchaser care; (7) the defendant’s intent in selecting the mark; and (8) the likelihood of expansion in the product lines of the parties.⁷⁹ The relatively similar *Polaroid* test includes the following eight factors: (1) the strength of the plaintiff’s mark; (2) the degree of similarity between the two marks; (3) the proximity of the products; (4) the likelihood that the plaintiff will bridge the gap between the two markets; (5) the existence of actual confusion; (6) the defendant’s good faith in adopting the mark; (7) the quality of the defendant’s product; and (8) the sophistication of the purchasers.⁸⁰ Neither list of factors is considered exclusive or ex-

⁷³ *Parks*, 329 F.3d at 447.

⁷⁴ *Id.*

⁷⁵ *Id.* at 447–48. This approach has been inferred from a Ninth Circuit case. See *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997). It has also been endorsed by the Tenth Circuit. *Cardtoons, L.C. v. Major League Baseball Players Ass’n.*, 95 F.3d 959 (10th Cir. 1996). Likelihood of confusion is “synonymous with a probability of confusion, which is more than a mere possibility of confusion.” *Elvis Presley Enters. v. Capece*, 141 F.3d 188, 193 (5th Cir. 1998).

⁷⁶ These factors were developed in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979).

⁷⁷ These factors were developed in *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir. 1961).

⁷⁸ 599 F.2d at 348–49.

⁷⁹ *Id.*

⁸⁰ *Polaroid*, 287 F.2d at 495.

haustive, nor does any single factor necessarily end the inquiry.⁸¹ The analysis of the allegedly infringing trademark use is similar under both the *Sleekcraft* and the *Polaroid* factors and always involves a very fact-intensive inquiry for the judge or jury.⁸²

There are two factors in the *Sleekcraft* and *Polaroid* tests that demand special explanation in the context of a celebrity plaintiff.⁸³ In this context, the strength of the plaintiff's mark⁸⁴ refers to the "level of recognition that the celebrity enjoys among members of society."⁸⁵ The relatedness or proximity of the products,⁸⁶ in the celebrity context, concerns "the reasons for or source of the plaintiff's fame."⁸⁷

In a celebrity's Lanham Act claim against an artist, under the likelihood of confusion test, the court pays no special attention to an asserted First Amendment defense.⁸⁸ Instead, the court resolves the issue of trademark infringement based only on an analysis of evidence relating to likelihood of confusion created by the use of the celebrity's name or identity.⁸⁹ The rationale behind disregarding the First Amendment defense is based in part on the requirement that, prior to any remedies being effectively invoked, "the court must find a likelihood of confusion, mistake, or deception."⁹⁰ The argument put forth by some courts and commentators is that this requirement will generally insulate the Lanham Act trademark infringement remedy from a First Amendment challenge.⁹¹ These courts argue that because intellectual property law, including trademark law, has built-in mechanisms that operate to avoid First Amendment concerns,⁹² the likelihood of confusion factors alone should suffice to account for First Amendment protections of freedom of expression.⁹³

⁸¹ *Id.*; *Sleekcraft*, 599 F.2d at 348–49.

⁸² *McGraw-Edison Co. v. Walt Disney Prods.*, 787 F.2d 1163, 1168 (7th Cir. 1986).

⁸³ The Ninth Circuit has developed a customized version of these factors for dealing with the false endorsement situation. *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1007–08 (9th Cir. 2001). The *Abercrombie* test will be discussed in further detail *infra* Part IV.

⁸⁴ This is the first factor in both the *Sleekcraft* and *Polaroid* tests.

⁸⁵ *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992).

⁸⁶ This is factor two in the *Sleekcraft* analysis and factor three in the *Polaroid* analysis.

⁸⁷ *White*, 971 F.2d at 1400.

⁸⁸ *Parks v. LaFace Records*, 329 F.3d 437, 448 (6th Cir. 2003) (stating that under likelihood of confusion test the court does "not pay special solicitude to an asserted First Amendment defense").

⁸⁹ *Id.* at 448–49.

⁹⁰ *Morgan Creek Prods., Inc. v. Capital Cities/ABC, Inc.*, No. CV-89-5463-RSWL, 1991 U.S. Dist. LEXIS 20564, at *14 (C.D. Cal. Oct. 25, 1991) (quoting 2 J. T. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 31:37, at 663–64 (2d ed. 1984)).

⁹¹ *Id.*

⁹² *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 970 (10th Cir. 1996) (stating, for example, that "proof of trademark infringement under the Lanham Act requires proof of a likelihood of confusion").

⁹³ *See Films of Distinction, Inc. v. Allegro Film Prods., Inc.*, 12 F. Supp. 2d 1068, 1078 (C.D. Cal. 1998) (stating that in *Dr. Seuss* the Ninth Circuit "strongly suggests that this 'balancing' has already

Many courts have criticized using the likelihood of confusion approach to balance the First Amendment liberty of free expression with Lanham Act protections.⁹⁴ For example, in *Parks*, the Sixth Circuit found that the likelihood of confusion approach was not proper for dealing with such situations because it gives no explicit weight to First Amendment concerns.⁹⁵ The court stated that the likelihood of confusion test “ignores the fact that the artistic work is *not* simply a commercial product but is also a means of communication.”⁹⁶ The court noted that it is not just the content of artistic works that should receive First Amendment protection; rather, the titles of artistic works should also receive protection not afforded by this test because the “names artists bestow on their art can be part and parcel of the artistic message.”⁹⁷ In *Parks*, the court found that the likelihood of confusion test alone was not adequate to distinguish between titles chosen for a legitimate artistic purpose, which are protected by the First Amendment, and those chosen for the sole purpose of commercial gain.⁹⁸

B. *Alternative Avenues Test*

Another test used to balance First Amendment interests with Lanham Act protections is the “alternative avenues” test.⁹⁹ Under this approach, “a title of an expressive work will not be protected from a [Lanham Act] false advertising [and endorsement] claim” by the First Amendment if there are “sufficient alternative means” by which the artist can convey his idea.¹⁰⁰ This test developed from a 1972 United States Supreme Court case involving a real property dispute, *Lloyd Corp. v. Tanner*.¹⁰¹ In *Lloyd*, the Court held that the respondents had no First Amendment right to distribute handbills in the interior mall area of the petitioner’s privately owned shopping center.¹⁰² The Court noted, as important to its holding, that the respondents

been adequately accomplished by the statutory framework [of the Lanham Act]).

⁹⁴ See, e.g., *Parks*, 329 F.3d at 449.

⁹⁵ *Id.*

⁹⁶ *Id.*

⁹⁷ *Id.*

⁹⁸ *Id.*; see also *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (“[W]hen a trademark owner asserts a right to control how we express ourselves . . . applying the traditional [likelihood of confusion] test fails to account for the full weight of the public’s interest in free expression.”). The Sixth Circuit later found that the likelihood of confusion test alone was not appropriate in the case of a claim that the use of a celebrity’s identity (not just the celebrity’s name) was protected by the First Amendment. *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 926 (6th Cir. 2003).

⁹⁹ This test was endorsed by the Eighth Circuit in *Mutual of Omaha Insurance Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987), and *Anheuser-Busch, Inc. v. Balducci Publications*, 28 F.3d 769, 776 (8th Cir. 1994).

¹⁰⁰ *Parks*, 329 F.3d at 448; see also *Mut. of Omaha*, 836 F.2d at 402 (holding that a creator of t-shirts that were arguably a parody was not protected by the First Amendment because he still had other methods, such as books, magazines or films, by which he could produce editorial parodies).

¹⁰¹ 407 U.S. 551 (1972).

¹⁰² *Id.* at 566–67.

had adequate alternative means of communicating their message.¹⁰³ Under the alternative avenues test, as it has been employed in the context of celebrity Lanham Act claims under section 43(a), a celebrity challenging an artist's use of his identity will prevail if she can demonstrate that there are alternative means by which the artist can communicate his ideas.¹⁰⁴

In *American Dairy Queen Corporation v. New Line Productions*,¹⁰⁵ a case involving a traditional commercial trademark rather than a celebrity's identity, a district court found that a movie title was not protected from a Lanham Act claim by a First Amendment defense.¹⁰⁶ The court's reasoning was that there were alternative avenues available for expressing the idea of the movie.¹⁰⁷ American Dairy Queen Corporation claimed that the title of a New Line Production's movie, *Dairy Queens*, violated section 43(a) of the Lanham Act because the title was so similar to its well-established trademark, "Dairy Queen."¹⁰⁸ The movie centered not on ice cream, but on a fictitious portrayal of beauty contests in rural Minnesota.¹⁰⁹ The court observed that the author appeared to have rejected other ideas for the title of the movie such as *Dairy Princesses*, *Milk Maids*, and other similar titles.¹¹⁰ While the court stated that it was not the job of courts to name films, it nonetheless held that there were sufficient alternative means by which New Line Productions could articulate the idea of the movie.¹¹¹ Thus, by extension, the court implied that there were other available titles for the film and held that New Line Productions could not successfully assert a First Amendment defense to Dairy Queen's Lanham Act claim.¹¹²

While some courts have applied the alternative avenues test when balancing the Lanham Act and the First Amendment,¹¹³ other courts have rejected this approach as failing to "sufficiently accommodate the public's

¹⁰³ *Id.* at 567.

¹⁰⁴ *Parks*, 329 F.3d at 449–50; *Dallas Cowboy Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979). The notion of *Lloyd* as applied to trademark situations is that "just as a real property owner may exclude a speaker from a shopping mall so long as other locations exist for the speaker to deliver his message, a celebrity may prohibit use of his or her name so long as alternative ways exist for the artist to communicate his or her idea." *Parks*, 329 F.3d at 449–50.

¹⁰⁵ 35 F. Supp. 2d 727 (D. Minn. 1998). Though this case dealt with a traditional trademark, "Dairy Queen," as opposed to a celebrity's "trademark" in his or her name, the same analysis can be applied in both situations. Thus, this case sheds light on how an "alternative avenues" test works in the context of celebrity identities as well as with more traditional trademark issues.

¹⁰⁶ *Id.* at 734.

¹⁰⁷ *Id.*

¹⁰⁸ *Id.* at 729. The trademark "Dairy Queen" is used by "several thousand [of American Dairy Queen Corporation's] family-oriented retail outlets [that] sell[] frozen dairy treats and other food." *Id.*

¹⁰⁹ *Id.* at 728.

¹¹⁰ *Id.* at 734.

¹¹¹ *Id.* at 734–35.

¹¹² *Id.* at 735.

¹¹³ *See, e.g.*, *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402–03 (8th Cir. 1987); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979).

interest in free expression.”¹¹⁴ The concern with applying a test originally developed for real property matters, as in *Lloyd*, to trademark disputes is that a “trademark is not property in the ordinary sense.”¹¹⁵ Trademarks, unlike physical property such as the shopping center in *Lloyd*, are only words or symbols that identify and differentiate goods and services to consumers; thus, it can become quite awkward when courts attempt to analogize rights in real property, such as land, to property rights in words and ideas.¹¹⁶

The Tenth Circuit, in *Cardtoons, L.C. v. Major League Baseball Players Ass’n*,¹¹⁷ refused to apply the alternative avenues test to a case concerning a set of collectable cards that parodied several Major League Baseball players.¹¹⁸ The court found that intellectual property was far different from the real property upon which the court in *Lloyd* based its holding, and thus declined to extend the alternative avenues test to trademarks and other forms of intellectual property.¹¹⁹ As stated by the Tenth Circuit, it is overly simplistic to assume that particular words could be forbidden without also creating a substantial risk that the ideas behind them would be suppressed in the process.¹²⁰

In 1989, the Second Circuit rejected the alternative avenues test in the context of a celebrity plaintiff’s Lanham Act challenge to a film title, finding that the test did not adequately “accommodate the public’s interest in free expression.”¹²¹ The Sixth Circuit Court of Appeals has also noted that adopting this test would embroil courts in the process of titling works of art.¹²² Under the alternative avenues test, “courts would be asked to determine not just whether a title is reasonably ‘artistic’ but whether a title is ‘necessary’ to communicate the idea.”¹²³

¹¹⁴ See, e.g., *Cardtoons, L.C. v. Major League Baseball Ass’n*, 95 F.3d 959, 971 (10th Cir. 1996).

¹¹⁵ *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987) (citing *Power Test Petroleum Distrib. v. Calcu Gas*, 754 F.2d 91, 97 (2d Cir. 1985)).

¹¹⁶ *Parks v. LaFace Records*, 329 F.3d 437, 450 (6th Cir. 2003) (commenting that “[m]ore than one court has noted the awkwardness of analogizing property rights in land to property rights in words and ideas”); *L.L. Bean*, 811 F.2d at 29 (stating that “[t]he first amendment issues involved in th[e] case [could] not be disposed of by equating the rights of a trademark owner with the rights of an owner of real property”).

¹¹⁷ 95 F.3d 959 (10th Cir. 1996).

¹¹⁸ *Id.* at 971.

¹¹⁹ *Id.*

¹²⁰ *Id.* (referencing *Cohen v. California*, 403 U.S. 15, 26 (1971)).

¹²¹ *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989). One court noted that famous author Mark Twain observed that the “difference between the almost-right word and the right word is really a large matter—it’s the difference between the ‘lightening-bug’ and the ‘lightening.’” *Parks*, 329 F.3d at 450 (quoting from J. BARTLETT, *FAMILIAR QUOTATIONS* 527 (16th ed. 1992)).

¹²² *Parks*, 329 F.3d at 450. Requiring courts to determine whether a title of a work is necessary to communicate the idea of the work would likely increase the amount of litigation that enters the judicial system and the time that courts spend on such litigation.

¹²³ *Id.*

C. The Rogers Test

The third possible method for balancing the First Amendment and the Lanham Act was developed in 1989 by the Second Circuit in *Rogers v. Grimaldi*.¹²⁴ The *Rogers* case involved a Lanham Act claim brought by Ginger Rogers¹²⁵ against producers and distributors of the movie *Ginger and Fred*.¹²⁶ The issue in the case was whether Ginger Rogers could prevent the use of the title *Ginger and Fred* for a movie that told the story of two fictional, Italian cabaret performers who imitated Ginger Rogers and Fred Astaire.¹²⁷

In deciding the case, the Second Circuit considered the tension between the Lanham Act's protections against public confusion, which provide a celebrity with some amount of safeguard for her right to her name and identity, and the First Amendment freedom of expression. The court stated that while "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."¹²⁸ The court also paid attention to the dual nature of titles, noting that "[t]itles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion."¹²⁹

The dual nature of titles (and of artistic expression in general) makes balancing the Lanham Act and the First Amendment difficult in such situations. The *Rogers* court noted that both consumers and artists have an interest in artistic works.¹³⁰ Consumers have an interest both in not being misled as to the content, source, or endorsement of a work, and "in enjoying the results of [an] author's freedom of [artistic] expression."¹³¹ Thus, titles of works of art, while still commanding Lanham Act scrutiny, "require[]

¹²⁴ 875 F.2d 994 (2d Cir. 1989). As this Comment highlights, the Sixth Circuit has recently adopted the *Rogers* test in both *Parks* and *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915, 928 (6th Cir. 2003). The Ninth Circuit has also applied the *Rogers* test in the 2002 case of *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002). Of course, the Second Circuit also uses the *Rogers* test.

¹²⁵ Ginger Rogers and her dance partner Fred Astaire "are [one of] the most famous duos in" the history of show business. *Rogers*, 875 F.2d at 996. They "established themselves as paragons of style, elegance, and grace" through their many performances in Hollywood musicals. *Id.* A key fact in the case, as the court noted, was that Ginger Rogers and Fred Astaire "are among [a] small elite [group in] the entertainment world whose identities are . . . called to mind [just by] their first names," especially when paired together. *Id.*

¹²⁶ *Id.* at 996–97.

¹²⁷ *Id.*

¹²⁸ *Id.* at 998.

¹²⁹ *Id.* The court went on to say that in the context of films, "[t]he title of a movie may be both an integral element of the film-maker's expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined." *Id.*

¹³⁰ *Id.*

¹³¹ *Id.* at 998; see also *Girl Scouts of the U.S.A. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 808 F. Supp. 1112, 1120 (S.D.N.Y. 1992).

more [First Amendment] protection than the label[s] of ordinary commercial products.”¹³²

In order to balance these competing interests, the Second Circuit adopted what is now known as the *Rogers* test. Under the *Rogers* test, the title of an artistic work is protected from a celebrity’s Lanham Act claim unless (1) “the title has no artistic relevance to the underlying work,” or (2) if there is artistic relevance, the title “explicitly misleads as to the source or the content of the work.”¹³³ The court developed this two-prong test in order to bring to life, and give structure to, its belief 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.”¹³⁴ The court believed that this two-prong analysis accommodated both the interests of public consumers and First Amendment artistic interests.¹³⁵

In applying its newly developed framework, the court found that the title was artistically relevant to the film because the main characters’ nicknames of “Ginger” and “Fred” were not just arbitrarily chosen to exploit the publicity of the real-life Ginger Rogers and Fred Astaire, but rather because of a genuine relevance to the story and message of the film.¹³⁶ The court also found that the title was not explicitly misleading because “Ginger and Fred” contained no overt indication that Ginger Rogers “endorsed the film or had a role in producing it.”¹³⁷ Further, the court held, any risk of misunderstanding by the public as to Roger’s involvement with the film was “outweighed by the interests [of] artistic expression,” and thus application of the Lanham Act was precluded by the First Amendment.¹³⁸

Following the Second Circuit’s approach, the Sixth Circuit adopted the two-prong *Rogers* test to analyze Rosa Parks’s Lanham Act claim against OutKast. The court found this test to be the best available method for “balanc[ing] the public interest in avoiding consumer confusion with the public interest in free expression.”¹³⁹ Applying the *Rogers* test to the *Parks* case,

¹³² *Rogers*, 875 F.2d at 998. This is equally true for artistic works in their entirety, not just the titles of such works.

¹³³ *Id.* at 999. While the *Rogers* test was originally thought only to apply to literary and film titles, the Second Circuit later made it clear that the test “is generally applicable to Lanham Act claims against works of artistic expression.” *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc.*, 886 F.2d 490, 495 (2d Cir. 1989).

¹³⁴ *Rogers*, 875 F.2d at 999.

¹³⁵ *Id.* at 1000 (stating that the test “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 the source or content, or that have no artistic relevance at all”).

¹³⁶ *Id.* at 1001.

¹³⁷ *Id.*

¹³⁸ *Id.*

¹³⁹ *Parks v. LaFace Records*, 329 F.3d 437, 450 (6th Cir. 2003). The court noted that the *Rogers* test “has been endorsed by panels in the Second, Fifth and Ninth Circuits.” *Id.*

the Sixth Circuit found that the title of OutKast's song, *Rosa Parks*, is not explicitly misleading because it does not make a blatant statement that Rosa Parks endorsed the song or that the song directly focuses on her.¹⁴⁰

However, in regards to the first prong of the *Rogers* test, the court found that it was highly questionable whether the title, *Rosa Parks*, had any artistic relevance to the lyrics of the song.¹⁴¹ Thus, the issue could not be decided as a matter of law and was remanded to the trial court for a full evidentiary hearing.¹⁴² The Sixth Circuit was especially concerned with the fact that the phrase "move to the back of the bus," when considered in the context of the song's other lyrics, "has absolutely nothing to do with Rosa Parks."¹⁴³ The court took an admission of one of the members of the rap duo, André "Dré" Benjamin, as strong evidence of this proposition.¹⁴⁴ "Dré" stated that OutKast "never intended for the song to be about Rosa Parks or the civil rights movement. It was just symbolic, meaning that we coming back out, so all you other MCs move to the back of the bus."¹⁴⁵ Because the lyrics are not about Rosa Parks and because the defendants never intended them to be about Rosa Parks,¹⁴⁶ the court found that a rea-

¹⁴⁰ *Id.* at 459. This highlights the difficulties in determining exactly what "explicitly misleading" means. Many consumers encountering a song entitled *Rosa Parks* would likely expect the song to be about just that, Rosa Parks. They would probably expect the song to at least involve Rosa Parks in some meaningful way given the song's title.

¹⁴¹ *Id.* For commentary regarding the view that this determination goes too far, see Mitchell David Greggs, Note, *Shakin' It to the Back of the Bus: How Parks v. LaFace Uses the Artistic Relevance Test to Adjudicate Artistic Content*, 61 WASH. & LEE L. REV. 1287, 1289 (2004) (arguing that the artistic relevance test, as used in *Parks*, "allows courts to stifle protected speech by focusing on the content of a protected work rather than on whether the use of the protectable interest is misleading in a commercial manner"). See also Lucas Victor Haugh, "Insert Court Approved Title Here": *Rosa Parks v. LaFace Records*, 5 N.C. J. L. & TECH. 277, 278 (2004) (arguing that recent decisions such as *Parks* show the judicial system is "stifling artistic expression").

¹⁴² *Parks*, 329 F.3d at 459.

¹⁴³ *Id.* at 452. The court found that the chorus of the song, based on a translation from electronic dictionaries, read as follows: "Be quiet and stop the commotion. OutKast is coming back out [with new music] so all other MCs [mic checkers, rappers, Master of Ceremonies] step aside. Do you want to ride and hang out with us? OutKast is the type of group to make the clubs get hyped up/excited." *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ *Id.*

¹⁴⁶ The court found the idea that Rosa Parks's name was used in a metaphorical or symbolic sense highly questionable. *Id.* at 454. In regards to possible symbolic use, the court stated that, with "lyrics that are laced with profanity and in a 'hook' or chorus that is pure egomania, many reasonable people could find that this is a song that is clearly *antithetical* to the qualities identified with Rosa Parks." *Id.* As to the metaphorical nature of use, the court defined a metaphor as "'a figure of speech in which a word or phrase denoting one kind of object or action is used in place of another to suggest a likeness or analogy between them.'" *Id.* (quoting WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 1420 (Phillip Babcock Gove ed., 1976)). The court then stated that

the use of the phrase "go to the back of the bus" may be metaphorical to the extent that it refers to OutKast's competitors being pushed aside by OutKast's return and being forced to "take a back seat." The song, however, is not titled *Back of the Bus*. It is titled *Rosa Parks*, and it is difficult to equate OutKast's feeling of superiority, metaphorically or in any other manner, to the qualities for which Rosa Parks is known around the world.

sonable person could conclude that there is no relationship between the content of the song and Rosa Parks.¹⁴⁷ The court stated:

Where an artist proclaims that a celebrity's name is used merely as a "symbol" for the lyrics of a song, and such use is highly questionable when the lyrics are examined, a legitimate question is presented as to whether the artist's claim is sincere or merely a guise to escape liability.¹⁴⁸

The Sixth Circuit thus concluded that the case should go back to the trier of fact for a determination of whether *Rosa Parks*, the song, was artistically related to Rosa Parks, the civil rights icon.¹⁴⁹

A little over a month after deciding the *Rosa Parks* case, the Sixth Circuit was confronted with another case involving similar issues, *ETW Corp. v. Jireh Publishing, Inc.*¹⁵⁰ The suit was brought by ETW Corporation, the licensing agent of Eldrick "Tiger" Woods,¹⁵¹ against Jireh Publishing.¹⁵² Jireh had distributed paintings of Tiger Woods playing golf during his record-setting victory at the 1997 Masters Tournament in Augusta, Georgia.¹⁵³ ETW claimed that, among other things, the artwork constituted unfair competition and false advertising under section 43(a) of the Lanham Act.¹⁵⁴ Jireh counterclaimed seeking a declaratory judgment that the artwork was protected by the First Amendment and thus did not violate the Lanham Act.¹⁵⁵

The Sixth Circuit again examined the *Rogers* test and found that the test should not be limited to titles of artistic works.¹⁵⁶ The court found that the *Rogers* test should be applied to the use of a celebrity's image and identity as well as his name.¹⁵⁷ Using the *Rogers* test to strike the balance between the public interest in avoiding consumer confusion and the public

Id.

¹⁴⁷ *Id.* at 455. The court stated:

[I]t cannot be said that the title in the present case, *Rosa Parks*, is clearly truthful as to the content of the song which, as OutKast admits, is not about Rosa Parks at all and was never intended to be about Rosa Parks, and which does not refer to Rosa Parks or to the qualities for which she is known.

Id.

¹⁴⁸ *Id.* at 454.

¹⁴⁹ *Id.* at 459.

¹⁵⁰ 332 F.3d 915 (6th Cir. 2003).

¹⁵¹ Tiger Woods is "one of the world's most famous professional golfers." *Id.* at 918.

¹⁵² *Id.* at 919.

¹⁵³ *Id.* The painting, entitled *The Masters*, commemorated Tiger Woods's victory in which he became the youngest player to ever win the Masters Tournament. *Id.* at 918. "In the foreground of [the] painting are three views of Woods in different poses," either swinging a golf club or involved in a putt.

Id.

¹⁵⁴ *Id.* at 919.

¹⁵⁵ *Id.* at 920.

¹⁵⁶ *Id.* at 928 n.11.

¹⁵⁷ *Id.*

interest in free expression, the court found that ETW's claim was precluded by the First Amendment.¹⁵⁸ Under the two-prong *Rogers* analysis, the court held that (1) Tiger Woods's image in the painting did have "artistic relevance to the underlying work," and (2) the painting did "not explicitly mislead as to the source" of the artwork.¹⁵⁹ Thus, the court found that, in this instance, the interest in artistic expression was strong enough to preclude application of the Lanham Act.¹⁶⁰

Despite acceptance of the *Rogers* test by several courts,¹⁶¹ some courts of appeals have resisted adopting it as a means of analyzing Lanham Act claims involving First Amendment defenses.¹⁶² Further, the test itself sometimes raises more questions than answers.¹⁶³ One major difficulty with the *Rogers* test is the "need for a court to make artistic judgments about whether the use of a person's name [or identity] in a title [or in the work of art itself] has some artistic relevance to content as opposed to" being used to "exploit the publicity value" of the celebrity's identity.¹⁶⁴ The foundation for this sort of criticism is starkly apparent in the *Parks* case when the court is forced to turn to "electronic 'dictionaries' of the 'rap' vernacular" for a translation of the chorus of OutKast's song, *Rosa Parks*.¹⁶⁵

Further, there is a danger that the "explicitly misleading" standard will result in courts protecting all but the most overtly misleading uses of a celebrity's identity.¹⁶⁶ More ambiguous titles or those that are only implicitly misleading will receive First Amendment protection under the first prong of the *Rogers* test.¹⁶⁷ Titles that are ambiguous or implicitly misleading can

¹⁵⁸ *Id.* at 937.

¹⁵⁹ *Id.*

¹⁶⁰ *Id.*

¹⁶¹ Obviously, the Second Circuit uses the *Rogers* test. The Sixth Circuit also adopted the *Rogers* test in *Parks*. 329 F.3d 437, 451–52 (6th Cir. 2003). A panel of the Fifth Circuit has endorsed the *Rogers* test. *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665 (5th Cir. 2000). Finally, the Ninth Circuit has recently adopted the *Rogers* test as its approach to such situations. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002). For further analysis of the *Mattel* case, see Bryan M. Gallo, *Barbie's Life in Plastic: It's Fantastic for First Amendment Protection—Or Is It?* *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002), 29 U. DAYTON L. REV. 405 (2004).

¹⁶² See *supra* note 23 (stating that there is a current circuit split on this issue). Some courts have accepted the *Rogers* test while others continue to use the "likelihood of confusion" test, see, e.g., *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997), or the "alternative avenues" approach, see, e.g., *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987).

¹⁶³ Questions that may arise include: "what does it mean for the celebrity's name or identity to be artistically relevant?"; "is a court qualified to make determinations of artistic relevance?"; "what is a sufficient link between the trademark, a celebrity's name or identity, and the underlying work?"; and "what is explicitly misleading as opposed to only somewhat or relatively misleading?"

¹⁶⁴ 2 MCCARTHY, *supra* note 35, § 10:31, at 10-68.6 (quoting *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989)).

¹⁶⁵ *Parks*, 329 F.3d at 452. See *supra* note 143 for further discussion of the translation.

¹⁶⁶ See *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989).

¹⁶⁷ *Id.* (stating that the *Rogers* test "insulates from restriction titles with at least minimal artistic relevance that are ambiguous or only implicitly misleading").

arguably cause significant consumer confusion, along the same lines as those that are more obviously misleading. It is unclear why only the most visibly deceptive uses of a celebrity's name or identity should receive Lanham Act consumer confusion protection while those of a slightly less explicit nature should not.

This discussion highlights the difficulties courts face in determining what framework or test is appropriate for analyzing celebrity Lanham Act claims presented with First Amendment defenses. There is currently no single test used by a significant majority of courts.¹⁶⁸ This state of affairs stands to create disagreement and confusion among both litigants¹⁶⁹ and the judiciary¹⁷⁰ about what standards should apply in these situations. When a court decides to use a test that involves an inquiry into the significance of the celebrity's identity to the allegedly infringing work of art, it is faced with yet another complication. The court is then presented with the intricacies involved in determining whether the use of the celebrity's identity is artistically relevant to the underlying work of art.¹⁷¹ The next Part will attempt to develop a cohesive framework for addressing these concerns and will provide additional factors for courts to consider in making a determination of artistic relevance.

IV. ANALYSIS: A NEW APPROACH FOR BALANCING THE COMPETING INTERESTS OF THE LANHAM ACT AND THE FIRST AMENDMENT

Considering the competing interests of the Lanham Act and the First Amendment, 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."¹⁷² However, if the public interest in freedom of speech and expression outweighs the risk of confusion in a given situation, then the Act should not apply in a way that would hinder these freedoms. It is in determining how to strike this balance that courts continue to face the challenge of establishing a framework for ana-

¹⁶⁸ *Parks*, 329 F.3d at 447 (stating that courts have adopted three different approaches for balancing First Amendment interests with Lanham Act protections).

¹⁶⁹ Litigants bringing this sort of a lawsuit will have to be sure to determine exactly what standards apply in the court before which they will be raising their claim. They may also find it necessary to devote considerable time arguing for the use of a particular test or arguing the merits of their client's claims under each of the three tests.

¹⁷⁰ Litigants are not the only ones who face the challenge of determining what test will apply to their case, as even the courts themselves are often unclear as to which approach they should use and, once they have chosen an approach, how to apply it. *See, e.g., No Fear, Inc. v. Imagine Films, Inc.*, 930 F. Supp. 1381, 1383 (C.D. Cal. 1995) (noting that there is "substantial confusion in the case law about the precise role of the likelihood of confusion factors in the application of the rule articulated in *Rogers*").

¹⁷¹ The first prong of the *Rogers* test requires the court to make this determination. *Rogers*, 875 F.2d at 999. Part of the problem, it has been noted, is that "there is no reliable, consistent method for determining 'artistic relevancy.'" Haugh, *supra* note 141, at 286.

¹⁷² *Rogers*, 875 F.2d at 999.

lyzing situations where the interests of trademark collide with the protections of the First Amendment.

This Comment proposes a new approach for dealing with celebrity Lanham Act claims and First Amendment defenses. The approach draws on several aspects of the existing tests as well as other areas of intellectual property law. In the context of a celebrity plaintiff, to determine if the First Amendment serves as a bar to the application of the Lanham Act in a particular case, courts should follow a balancing approach that looks to the likelihood of confusion factors on one side and a more detailed variation of the first prong of the *Rogers* test relating to artistic relevance on the other side.¹⁷³ Faced with a celebrity trademark case, a court using this proposed test should first look to the traditional likelihood of confusion factors in order to establish whether the defendant's use of the celebrity's name or identity does in fact create a likelihood of confusion for consumers.¹⁷⁴ If the court determines that the use creates a likelihood of consumer confusion, it should examine whether the defendant's use of the celebrity's name or identity is protectable artistic expression.¹⁷⁵ To determine if the use is protected by the First Amendment, the court should examine whether the celebrity's name or identity is artistically relevant to the underlying work. In deciding the artistic relevance of a particular use of a celebrity's name or identity, the court should draw upon concepts from the fair use defenses in both copyright and trademark law.¹⁷⁶

If the court determines that there is some level of artistic relevance in using the celebrity's name or identity, the court must then engage in a balancing test. It should balance the risk of consumer confusion, which is based upon the likelihood of confusion analysis, against the public interest

¹⁷³ Examining the first prong of the *Rogers* test under this proposed test, the court will examine a more concrete and factor-based analysis of the public interest in free expression as drawn from the balancing inquiry established by the *Rogers* court in the phrase "only where the public interest in avoiding consumer confusion outweighs the public interest in free expression." *Rogers*, 875 F.2d at 999. The court will look at the artistic relevance of the use of the celebrity's identity to the underlying artistic work in order to determine what interest the public has in the artist's free expression that involves the appropriation of the celebrity's identity. The factors that courts should consider in determining whether or not the use is artistically relevant will be discussed *infra* Part IV.B.

¹⁷⁴ The district court in *No Fear* followed an approach similar in structure to the one I propose when it determined that it should analyze the likelihood of confusion present in a particular situation before proceeding to address the First Amendment issues. 930 F. Supp. at 1384. The court chose to first apply the likelihood of confusion factors, rather than adopt the "explicitly misleading" approach, and then to weigh the likelihood of confusion against the First Amendment concerns. *Id.* at 1384. This Comment argues in favor of such an approach and further expands upon it by developing factors for courts to weigh against a likelihood of confusion, factors pertinent to a determination of artistic relevance.

¹⁷⁵ If a court finds that no likelihood of confusion exists, then the defendant will prevail since the court will not find a trademark infringement.

¹⁷⁶ Using enumerated factors will help to remove some of the ambiguity and subjectivity from the term "artistically relevant." It will help lawyers more easily and coherently structure their claims and arguments for trial, and help judges analyze these claims in a more straightforward, organized, and uniform manner.

in artistic expression,¹⁷⁷ which is based upon the court's previous determination of the level of artistic relevance of the celebrity's name or identity to the underlying work. The following sections will outline this proposed balancing test and discuss the rationale behind the test and its practical application in further detail.

A. Likelihood of Confusion Analysis

There has been substantial confusion among courts as to the precise role of the likelihood of confusion factors in a Lanham Act claim involving an asserted First Amendment defense, especially in regards to the application of the *Rogers* test.¹⁷⁸ Some courts, in cases involving artistic works, simply ignore the likelihood of confusion factors altogether.¹⁷⁹ These courts focus only on the First Amendment issue by applying the two-prong *Rogers* test to the use of the celebrity's name or identity.¹⁸⁰

A better approach to such situations is to evaluate them under the traditional likelihood of confusion factors first before proceeding to an analysis of the First Amendment issues.¹⁸¹ Using the likelihood of confusion factors in trademark cases involving First Amendment issues keeps these cases within the realm of trademark law and subject to some level of traditional trademark analysis. Defendants should not be able to remove themselves entirely from the purview of trademark law simply by claiming the protections of the First Amendment.¹⁸²

Beginning the examination with a likelihood of confusion analysis allows the court to first determine if the claim that the celebrity's name or identity has been misappropriated is meritorious in a traditional trademark sense before moving on to address First Amendment issues.¹⁸³ If upon examination of the likelihood of confusion factors, the court determines that

¹⁷⁷ This is consistent with the balancing test suggested by the *Rogers* court.

¹⁷⁸ See, e.g., *No Fear*, 930 F. Supp. at 1383 (referring explicitly to *DeClemente v. Columbia Pictures Indus., Inc.*, 860 F. Supp. 30, 51 (E.D.N.Y. 1994) (applying *Polaroid* factors as well as the *Rogers* "explicitly misleading" test)); *Girl Scouts of the U.S.A. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 808 F. Supp. 1112, 1122 (S.D.N.Y. 1992) ("Although possibly not required to do so in light of *Cliffs Notes* and *Rogers*, this Court chooses to examine each of the eight *Polaroid* factors in turn.").

¹⁷⁹ See, e.g., *Parks v. LaFace Records*, 329 F.3d 437, 451–52 (6th Cir. 2003); *Rogers*, 875 F.2d at 999.

¹⁸⁰ See, e.g., *Parks*, 329 F.3d at 451–52; *Rogers*, 875 F.2d at 999.

¹⁸¹ See, e.g., *No Fear*, 930 F. Supp. at 1384; *Girl Scouts*, 808 F. Supp. at 1121–22 (stating that the central issue in this type of case is "whether the risk of confusion as to the source of [the] Defendant's merchandise is greater than the public interest in artistic expression" and then continuing to apply the *Polaroid* factors to the case).

¹⁸² See *No Fear*, 930 F. Supp. at 1383–84 ("Defendant simply cannot distill First Amendment concerns from the traditional framework in which courts determine the likelihood of confusion under the Lanham Act.").

¹⁸³ The court may need to slightly tailor the likelihood of confusion factors for the case of a celebrity plaintiff. See *supra* Part III.A for a discussion of the application of these factors to a celebrity plaintiff.

no confusion exists, then there is no Lanham Act violation and the court does not have to reach the First Amendment issues.¹⁸⁴ Further, only by viewing the public interest in avoiding consumer confusion (one side of the scale) separately from the First Amendment concerns (the other side of the scale), can the court make an accurate determination of the weight and sufficiency of the public interest in avoiding consumer confusion.¹⁸⁵

The analysis of the likelihood of confusion factors proposed by this Comment is preferable to using the *Rogers* test's "explicitly misleading" prong.¹⁸⁶ This prong of the *Rogers* test states that the use of a celebrity's name or identity will not be protected if the use "explicitly misleads as to the source or the content of the work."¹⁸⁷ Requiring that the use of a celebrity's identity with minimal artistic relevance be "explicitly misleading" before it can receive trademark protection shields works that should not be protected by the First Amendment. This overprotection is unnecessary because there is already some level of protection for First Amendment concerns built into trademark analysis under the likelihood of confusion factors.¹⁸⁸ Overprotecting artistic works that appropriate a celebrity's identity allows works that are either ambiguously or implicitly misleading as to the celebrity's participation in, or endorsement of, the works to receive protection that they do not deserve.¹⁸⁹ In addition, overprotecting such works necessarily underprotects the interest involved on the other side of the balancing scale by needlessly increasing the consumer confusion that the Lanham Act seeks to eliminate.

Further, the term "explicitly misleading" does not provide sufficient guidance to courts attempting to determine if the use of the celebrity's name or identity is misleading in a way that will cause consumer confusion. Using the likelihood of confusion factors as the first prong of the analysis, as proposed by this Comment, would give courts solid factors to apply when determining whether the allegedly infringing use of the celebrity is misleading and confusing.¹⁹⁰ The likelihood of confusion factors would still allow courts the flexibility to tailor their examinations to the particular facts and

¹⁸⁴ If possible, courts typically prefer to address statutory issues rather than constitutional ones. See, e.g., *Wyman v. Rothstein*, 398 U.S. 275, 276 (1970).

¹⁸⁵ Keeping the two sides separate will help the court to view the public interest in avoiding confusion separately from the public interest in free expression. By viewing them as separate and distinct from one another, to the extent possible, the court will better be able to weigh each interest.

¹⁸⁶ Some district courts have used the likelihood of confusion factors to analyze whether or not an artistically relevant title misleads as to the source or content of the work under the second prong of the *Rogers* test. See *Girl Scouts*, 808 F. Supp. at 1121.

¹⁸⁷ *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

¹⁸⁸ See *supra* notes 89–93 and accompanying text for further discussion of this concept.

¹⁸⁹ See *supra* notes 163–164 and accompanying text for discussion of the possible problems with the "explicitly misleading" concept.

¹⁹⁰ This is true regardless of which set of factors the court chooses to use, be it the *Polaroid* or *Sleekcraft* factors or yet another set of factors, such as the *Abercrombie* factors described *infra* notes 193–195 and accompanying text.

circumstances of each case, as courts would not be forced to give any particular weight to any particular factor and would be free to consider additional relevant matters in determining whether a likelihood of confusion exists.¹⁹¹

Moreover, using the likelihood of confusion analysis as opposed to the somewhat amorphous “explicitly misleading” examination is a more manageable and pragmatic course for courts to take. To perform the likelihood of confusion side of the proposed balancing analysis, the court need only apply the traditional likelihood of confusion factors to the use of the celebrity’s name or identity. This is something courts should be familiar with, having used the likelihood of confusion analysis in more traditional trademark cases with greater frequency than they have likely dealt with collisions of trademark law and First Amendment jurisprudence.

To apply the likelihood of confusion analysis in the context of the celebrity’s name or identity as the trademark at issue, the court can consider the typical likelihood of confusion factors from *Sleekcraft* or *Polaroid*.¹⁹² Alternatively, the court can consider an additional variation of the eight factors, as customized for situations involving celebrities by the Ninth Circuit in *Downing v. Abercrombie & Fitch*.¹⁹³

1. the level of recognition that the plaintiff has among the segment of the society for whom the defendant’s product is intended;
2. the relatedness of the fame or success of the plaintiff to the defendant’s product;
3. the similarity of the likeness used by the defendant to the actual plaintiff;
4. evidence of actual confusion;
5. marketing channels used;
6. likely degree of purchaser care;

¹⁹¹ See, e.g., *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (stating that even the “extensive catalogue [of factors in the *Polaroid* test] does not exhaust the possibilities—the court may have to take still other variables into account”).

¹⁹² See *supra* Part III.A for a more detailed discussion of the *Sleekcraft* and *Polaroid* factors.

¹⁹³ 265 F.3d 994 (9th Cir. 2001). Under the balancing test proposed by this Comment, a court would be free to use any of the three versions of the likelihood of confusion factors discussed above. All three versions are relatively similar and point a court towards the same underlying issues of the strength of the celebrity’s mark, which is her name and identity, the possibilities for consumer confusion, and evidence of actual confusion. All three also provide the court with the necessary flexibility to tailor the factors to the particular situation before it. As it has already been tailored for the situation of a celebrity trademark, Courts may prefer to skip the additional step of adapting the *Polaroid* or *Sleekcraft* factors and simply adopt the likelihood of confusion factors as set forth by the Ninth Circuit in *Downing*.

7. defendant's intent in selecting the plaintiff; and
8. likelihood of expansion of the product lines.¹⁹⁴

Although all of the above factors are appropriate for consideration, it bears repeating that they are not all necessarily of equal weight or importance, nor will all of the factors always be applicable to determining the likelihood of confusion in a particular instance.¹⁹⁵ Further, a court could consider other factors if it found them important or necessary, based upon the totality of the facts and circumstances in the particular case.¹⁹⁶

B. Artistic Relevance Determination

Once a court determines that a likelihood of confusion is created by the use of the celebrity's name or identity, the court must consider the public interest in freedom of artistic expression. This requires the court to determine if the use of the celebrity's name or identity is artistically relevant to the underlying work.¹⁹⁷ If artistic relevance is found, the likelihood of confusion must be particularly compelling to outweigh the public's First Amendment interest in the artist's freedom of expression.¹⁹⁸ Because freedom of expression is a more fundamental protection than trademark protection,¹⁹⁹ the court need not find an exceptionally high level of artistic relevance to overcome a moderate likelihood of confusion.²⁰⁰

To determine what constitutes artistically relevant use of a celebrity's name or identity, courts should continue to use common sense, as well as examine concrete factors drawn from the fair use defenses in both copyright and trademark law. The fair use defenses in both of these areas of intellectual property law, as well as a general requirement of good faith, provide

¹⁹⁴ *Id.* at 1007–08.

¹⁹⁵ *Id.*; see also *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1186 (6th Cir. 1988) (discussing the similar *Polaroid* factors and stating that the factors “imply no mathematical precision, and a plaintiff need not show that all, or even most, of the factors listed are present in any particular case to be successful”).

¹⁹⁶ Other related factors a court could consider might include the duration of the celebrity's fame, the sophistication of the work's potential buyers, and, bearing on intent, the reaction of the artist to the celebrity's complaint for trademark infringement. See, e.g., *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 353–54 (9th Cir. 1979).

¹⁹⁷ This side of the proposed balancing test corresponds with the first prong of the *Rogers* test, in that it requires a determination of the artistic relevance of the celebrity's name or identity to the underlying work.

¹⁹⁸ *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665 (5th Cir. 2000) (adopting the Second Circuit's approach).

¹⁹⁹ See *Girl Scouts of the U.S.A. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 808 F. Supp. 1112, 1118 (S.D.N.Y. 1992) (stating that the “owner of a trademark does not possess a property right that is superior to the First Amendment right accorded to artistic expression”); see also *supra* note 53 and accompanying text.

²⁰⁰ See *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993).

useful factors that can be extrapolated for application in the context of a First Amendment defense to a celebrity's Lanham Act claim.²⁰¹

1. Trademark Fair Use Defense.—The fair use defense to trademark infringement is laid out in section 33(b)(4) of the Lanham Act.²⁰² The fair use doctrine permits others to use a protected trademark to describe certain aspects of their own goods or services.²⁰³ It is based upon the “principle that no one should be able to appropriate descriptive language through trademark registration,”²⁰⁴ and thereby restrains a trademark holder from claiming exclusive use of descriptive terminology which might prevent others from accurately describing their products.²⁰⁵ In order to claim that use of another's trademark qualifies as fair use, a defendant must demonstrate that the allegedly infringing use is a “use, otherwise than as a mark . . . which is descriptive of and used fairly and in good faith only to describe the goods or services . . . or their geographic origin.”²⁰⁶ In addition, the defendant must have made use of the mark in a way that is descriptive, different from trademark use, and in good faith.²⁰⁷ Courts have developed three basic criteria, founded on the language of the Act, to which they look in determining whether a defendant's use of a plaintiff's mark constitutes fair use:²⁰⁸

²⁰¹ McCarthy finds an analogy to copyright law to be educational in regards to the tension between the First Amendment and trademarks under the Lanham Act:

To determine the probable future place of the First Amendment in trademark litigation, the experience of copyright law is instructive. In copyright cases, no court of appeals has held that the First Amendment provides a defense distinct from the traditional “fair use” defense of copyright law. Rather, the courts have incorporated and folded First Amendment policies into the traditional rules of copyright.

5 MCCARTHY, *supra* note 35, § 31:151, at 31-252.

²⁰² 15 U.S.C. § 1115 (2000).

²⁰³ *Id.*

²⁰⁴ Sands, Taylor & Wood Co. v. Quaker Oats Co., 978 F.2d 947, 951 (7th Cir. 1992).

²⁰⁵ *See, e.g.*, New Kids on the Block v. News Am. Pub'g, Inc., 971 F.2d 302, 306. (9th Cir. 1992).

The *New Kids* court stated that “the primary cost of recognizing property rights in trademarks is the removal of words from (or perhaps non-entrance into) our language. Thus, the holder of a trademark will be denied protection if it is (or becomes) generic, i.e., if it does not relate exclusively to the trademark owner's product.” *Id.* The court noted that such a requirement should quell “fears that producers will deplete the stock of useful words by asserting exclusive rights in them.” *Id.* Thus, the court stated that “[w]hen a trademark comes to describe a class of goods rather than an individual product, the courts will hold as a matter of law that use of that mark does not imply sponsorship or endorsement of the product by the original holder.” *Id.*

²⁰⁶ 15 U.S.C. § 1115(b)(4).

²⁰⁷ *See, e.g.*, EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopolos Inc., 228 F.3d 56, 64 (2d Cir. 2000).

²⁰⁸ *See, e.g., id.* (stating that in order to qualify for the fair use defense, defendants must have made use of the mark at issue: “(1) other than as a mark, (2) in a descriptive sense, and (3) in good faith”); TCPIP Holding Co., Inc. v. Haar Communications, Inc., 244 F.3d 88, 103 (2d Cir. 2001) (stating that “one party's exclusive right to use a mark ‘will not prevent others from using the word or image [constituting the mark] in good faith in its descriptive sense, and not as a trademark’” (quoting Car-Freshner Corp. v. S.C. Johnson & Son, Inc., 70 F.3d 267, 269 (2d Cir. 1995))); *see also* RESTATEMENT (THIRD)

1. The defendant's intent—the mark must have been used in good faith without an intent to capitalize on the success and reputation of the plaintiff.²⁰⁹
2. The use of the mark—the mark must be used in a non-trademark sense, and it cannot be used as an attention-getting or source-identifying mark.²¹⁰
3. The relationship between the mark and the defendant's product or service—the mark must be used in a descriptive sense and it must accurately describe the product.²¹¹

When all three of these criteria are met, a court will find that use of the plaintiff's trademark constitutes fair use.²¹²

All three of these fair use criteria are also relevant to the determination of whether a defendant's use of a celebrity's name or identity is artistically relevant to his underlying work. In the context of artistic relevance, these factors need not be applied as strictly as they would be in establishing fair use of a traditional trademark; rather, they can provide courts with concepts to draw upon in determining whether the use of a celebrity is artistically relevant to the underlying work of art. First, the court can look to whether or not the mark was used in good faith, without intent to capitalize on the identity of the celebrity.²¹³ In this context, a court can find bad faith on the

OF UNFAIR COMPETITION § 28 (1995); 2 MCCARTHY, *supra* note 35, § 11:49, at 11-114.3 (stating that section 33(b)(4) of the Lanham Act requires a defendant “to prove three elements to establish a fair use defense: (1) Defendant's use of the term is not as a trademark or service mark; (2) Defendant uses the term ‘fairly and in good faith;’ and (3) ‘Only to describe’ its goods or services”). For a more detailed discussion of the fair use doctrine in trademark law and its modern application, see Michael G. Frey, Comment, *Is It Fair to Confuse? An Examination of Trademark Protection, the Fair Use Defense, and the First Amendment*, 65 U. CIN. L. REV. 1255 (1997). Frey's comment delves into the policies behind trademark protections and the fair use defense in light of the First Amendment, and focuses on how the two should work together in practice. See also David W. Barnes & Teresa A. Laky, *Classic Fair Use of Trademarks: Confusion About Defenses*, 20 SANTA CLARA COMPUTER & HIGH TECH. L.J. 833 (2004).

²⁰⁹ *Inst. for Scientific Info., Inc. v. Gordon & Breach, Sci. Publishers, Inc.*, 931 F.2d 1002, 1008–10 (3d Cir. 1991).

²¹⁰ *Id.* at 1008; *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 954 (7th Cir. 1992) (stating that because the mark was used in a trademark sense, the defendant was unable to claim fair use).

²¹¹ *Inst. for Scientific Info.*, 931 F.2d at 1008.

²¹² See, e.g., *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, 64 F.3d 1055, 1058 (7th Cir. 1995). In *Sunmark*, the court held that Ocean Spray's use of the phrase “sweet-tart” was not an infringement of Sunmark's “SWEETART” mark and that if words are employed “simply as descriptions, and ‘otherwise than as a mark,’ . . . there can be no violation of the Lanham Act under what is known as the fair use defense.” *Id.* (citation omitted). In addition, the court noted that “[s]ection 1115(b)(4) [of the Lanham Act] also requires that the use be in good faith.” *Id.*; see also *Wonder Labs, Inc. v. Proctor & Gamble Co.*, 728 F. Supp. 1058, 1062–64 (S.D.N.Y. 1990) (finding fair use because the court found no evidence of bad faith, and because the phrase at issue was not used as a trademark, but rather in a descriptive manner).

²¹³ A more detailed discussion of the requirement of good faith on the part of the defendant follows

part of the artist if he employed the celebrity's name or identity simply in order to attract or increase his profits on the sale of the work, without a real, solid connection between the celebrity and the work. The court might look for evidence that the celebrity's name or identity was simply chosen as an afterthought, as a way to attract attention to the work, or to exploit the market value of the celebrity. A defendant's capitalization on the name of a celebrity without an accompanying strong connection between the celebrity and the underlying work should counsel the court against a determination of artistic relevance.²¹⁴

Second, the court can consider the way in which the celebrity's mark—her name or identity—was used. Was the celebrity used simply as a means of creating public awareness of the product?²¹⁵ Was the celebrity employed as an instrument to draw consumer attention to the work of art, instead of actually serving as an integral element of the artwork? If so, the use would tilt against artistic relevance because the mark was used in a normal trademark sense, functioning more as a way to draw consumer attention to the work of art, rather than operating as a vital part of the work of art itself.²¹⁶ Certainly, a finding that the celebrity's name or identity was employed to draw consumer attention to the product would not always mandate that the court find that no artistic relevance exists; rather, it is only one factor that the court can consider in making that determination.

Third, and perhaps most importantly in the context of a celebrity plaintiff, the court should look to the relationship between the celebrity plaintiff's name and identity and the defendant's work of art. To be descriptive, the use of the mark must describe the qualities, ingredients, effects, or characteristics of the good or service.²¹⁷ In order to support a finding of artistic relevance, the use of the celebrity's mark should accurately describe the defendant's product. In this context, an accurate description means that the use of the celebrity's name or identity must truthfully reflect some underlying connection between the celebrity's persona and the work of art. An accurate description would not require that the way in which the artwork

infra Part IV.B.

²¹⁴ See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1401 n.3 (9th Cir. 1992) (discussing the possible exploitation of a celebrity's value to sell products).

²¹⁵ See *Sands*, 978 F.2d at 953.

²¹⁶ In the case of a title, a court might want to compare the degree the celebrity persona is involved with the underlying work with the extent to which the celebrity's name or identity serves to draw attention to the work that it might not have otherwise received. Again, this would be only one factor for a court to consider in reaching a determination of artistic relevance, and not necessarily the deciding one.

²¹⁷ *Thompson Med. Co., Inc. v. Pfizer, Inc.*, 753 F.2d 208, 212 (2d Cir. 1985) (stating that descriptive marks are marks that "describ[e] the qualities, ingredients, effects, or other features of the product naturally and in ordinary language"); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976) (stating that a descriptive mark "conveys an immediate idea of the ingredients, qualities or characteristics of the goods"). A trademark can traditionally be descriptive in one of two ways: (1) "[i]t can literally describe the product, or [(2)] it can describe the purpose or utility of the product." *DeClemente v. Columbia Pictures Indus., Inc.*, 860 F. Supp. 30, 43 (E.D.N.Y. 1994).

employs the celebrity necessarily be a realistic portrayal of the celebrity or her personality and characteristics. Thus, a hyperbole or even total mischaracterization of the celebrity, such as in the form of a parody or political satire, could be artistically relevant, so long as the celebrity was a recognizable part of the work of art.

Thus, for the use of the celebrity's name or identity to be artistically relevant to the work, it must have a descriptive relationship to the work of art itself. This is especially true for titles. If, for example, the use of the celebrity's name occurs in the title of a work and the underlying work is not about or related to the image of the celebrity, this factor would weigh against the finding of artistic relevance. This was precisely the situation in *Parks* that led the Sixth Circuit to skeptically remand the issue of the artistic relevance of Rosa Parks to OutKast's song to the lower court for a factual determination.²¹⁸ On the other hand, if the artistic work in question was a song entitled "Kobe Bryant" and the contents of the song proceeded to focus on Kobe Bryant and criticize (or praise) him for his actions on and off the basketball court, or even if the song exaggerated or mischaracterized his actions as a means of commenting on them, this level of descriptiveness in the title would certainly point toward a finding of artistic relevance.²¹⁹

As previously mentioned, in *Parks*, one of the court's primary concerns was that the title, *Rosa Parks*, was not clearly descriptive of the song's content.²²⁰ The court was especially troubled by OutKast's statement that the song was not actually about Rosa Parks, "was never intended to be about" her, and did not refer to Rosa Parks or the qualities that have made her famous.²²¹ The court thought that the fact that the content of the song was "diametrically opposed" to the qualities such as dignity and strength that Rosa Parks stands for highlighted the lack of descriptiveness, especially when combined with OutKast's admission that the song is not in any way about Rosa Parks.²²²

In reviewing works to determine if their use of a celebrity is artistically relevant to the underlying work, courts can thus draw upon several factors from the trademark fair use defense. Whether the artist intended to capitalize on the use of the celebrity, the nature in which the celebrity trademark is used, and the existence of a descriptive relationship between the celebrity

²¹⁸ *Parks v. LaFace Records*, 329 F.3d 437, 460–63 (6th Cir. 2003).

²¹⁹ A finding of artistic relevance does not preclude other issues from being litigated such as defamation or a similar claim. The example should be viewed only in the context of artistic relevance, as an illustration of a use of a celebrity's name that would lean toward a finding of artistic relevance.

²²⁰ *Parks*, 329 F.3d at 455.

²²¹ *Id.*

²²² *Id.* at 455–56. Simply juxtaposing Rosa Parks with qualities that she is not typically thought to embody is not wrong, but when combined with the fact that the song is admittedly not about her at all, this points strongly against a finding of artistic relevance. A work that paints a celebrity in a very unflattering light, even in an untraditional way, can certainly have artistic relevance. To hold otherwise would stifle the edifying commentary that the First Amendment seeks to protect.

and the underlying work are three concrete factors that courts can utilize to examine the artistic relevance of the celebrity to the artwork. By invoking these factors, as well as those that can be drawn from the copyright fair use defense,²²³ courts can create a framework consistent with the underlying principles of intellectual property law for deciding such cases.²²⁴

2. *Copyright Fair Use Defense.*—The fair use defense in copyright law is also helpful in determining the artistic relevance of a celebrity’s name or identity to an underlying work. Although the source and protections of copyright law differ from trademark law, the two are similar in many respects. Therefore, some of the concepts and standards from copyright law can serve as a starting point for an examination of artistic relevance as part of a First Amendment defense to a celebrity’s section 43(a) Lanham Act claim.²²⁵ This is especially true because the “essence of copyrightability is originality of artistic, creative expression,”²²⁶ which goes straight to the heart of a determination of artistic relevance.

To determine whether one work makes fair use of another copyrighted work, courts consider the following four factors:

1. the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
2. the nature of the copyrighted work;
3. the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
4. the effect of the use upon the potential market for or value of the copyrighted work.²²⁷

The fair use doctrine in copyright law “permits [and requires] courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity that the law is designed to foster.”²²⁸ This focus on creativity makes the copyright fair use factors especially relevant and ap-

²²³ These factors will be explained *infra* Part IV.B.2.

²²⁴ By using concrete factors such as those enumerated here, courts will also provide greater guidance to potential litigants and improve the precedential value of their cases.

²²⁵ A similar proposal has been suggested in a parallel context, the right of publicity, by one author in particular. Patrick Whitman, *Everyone’s a Critic: Tiger Woods, the Right of Publicity and the Artist*, 1 HOUS. BUS. & TAX. L.J. 41 (2001). The article examines the common law right of publicity and proposes that courts use the copyright law fair use defense to examine a celebrity’s right of publicity claim.

²²⁶ *Ets-Hokin v. Sky Spirits, Inc.*, 225 F.3d 1068, 1073 (9th Cir. 2000).

²²⁷ 17 U.S.C. § 107 (2000). Some courts have stated that the second factor, regarding the nature of the copyrighted work has typically “not been terribly significant in the overall fair use balancing.” *See, e.g., Mattel v. Walking Mountain Prods.*, 353 F.3d 792, 803–04 (9th Cir. 2003).

²²⁸ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994) (quoting *Stewart v. Abend*, 495 U.S. 207, 236 (1990)).

propriate when considering artistic relevance relating to the use of a celebrity trademark.

While all four of the fair use factors can be considered in the context of the artistic use of a celebrity's identity,²²⁹ the first factor is the most germane to the specific determination of artistic relevance. In the context of a celebrity plaintiff claiming a right of publicity violation, Patrick Whitman has suggested that this factor, regarding the purpose or character of the use, should ask, "[W]hat does the use of a celebrity's name or likeness add to societal discourse?"²³⁰ Such an argument is relevant to a Lanham Act claim as well as a right of publicity claim because section 43(a) of the Lanham Act, as previously discussed, operates to some extent as the federal equivalent of the state right of publicity.²³¹ In the context of the Lanham Act and a determination of artistic relevance, a finding that the use of the celebrity adds to societal discourse will help the court to ensure that the work makes significant artistic use of the celebrity's name or identity, rather than simply misappropriating it merely to attract consumer attention to the product and for potential commercial gain.

In examining what an artist's use of a celebrity's name or identity could possibly add to societal discourse, one aspect the court can consider is whether the artist's use constitutes criticism, commentary, or parody.²³² Criticism, commentary, and parody are entitled to First Amendment protection because such representations "foster another opinion or idea that the public can weigh, discuss, agree or disagree with."²³³ It should not matter

²²⁹ In *Everyone's a Critic: Tiger Woods, the Right of Publicity and the Artist*, *supra* note 225, Patrick Whitman suggests that all four of the factors are relevant to an artist's use of a celebrity's identity. His analysis of the first factor is explained in the above text. As for the other three factors, Whitman finds them to be equally relevant to a right of publicity balancing test. *Id.* at 65. Whitman uses the second factor, the nature of the use, as a starting point to focus on whether the artist appropriates the celebrity's image for reasons that are predominately financial or for artistic reasons. *Id.* at 69. He uses the third factor, the frequency of the use, to examine the frequency of the appropriation of the celebrity's identity, focusing primarily on the number of art pieces the artist offers for sale. *Id.* at 71. Finally, Whitman examines the fourth factor, the effect of the use upon the potential market value for the copyrighted work, to focus on what effect the artist's use will have on the celebrity's economic value. *Id.*

²³⁰ *Id.* at 65–66.

²³¹ See *supra* notes 46–52 and accompanying text for a discussion of the relationship between the right of publicity and a claim under section 43(a) of the Lanham Act.

²³² Whitman, *supra* note 225, at 66. Again, it should be noted that this factor is not intended to be the deciding factor in every situation, as it is one of several factors that this Comment proposes for courts to consider in determining whether the use of a celebrity is artistically relevant to the work of art. In addition, this Comment does not mean to imply that criticism, comment, and parody are the only means by which an artist might add to societal discourse through his use of a celebrity. However, they are common means of communication that are protected by the First Amendment, even if trademarks are made use of in the communication. See *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir. 1987) ("Denying parodists the opportunity to poke fun at symbols and names which have become woven into the fabric of our daily life, would constitute a serious curtailment of a protected form of expression.").

²³³ Whitman, *supra* note 225, at 67. By fostering another opinion or idea the artist is making trans-

that the artist can profit from his use of the celebrity's name or identity in such an instance because the use adds different views and ideas to societal discourse that would never be expressed if celebrity endorsement or approval were required.²³⁴

Another way of framing the consideration of the purpose or character of the artist's use of the celebrity is to look at the transformative nature of the use.²³⁵ A work is transformative when it "adds something new, with a further purpose or different character, altering the [protected work] with new expression, meaning, or message."²³⁶ To be transformative, a work should meter something, not just repeat it or simply "supplant" the original work.²³⁷ For example, in copyright, if an author simply duplicates the words of another book without the author's writings actually being about those words on a higher level or adding to them in some way, the duplicative author is in violation of the rights of the original author. But if the second author uses a selection of words from the first author's book in order to comment on them or criticize their validity, then his use is fair use because it is a transformative work.

Although a finding that the use of the copyrighted material is transformative is "not absolutely necessary for a finding of fair use," it is a very significant factor because the goal of copyright is furthered more by the

formative use of the celebrity's identity. Further discussion of transformative use follows later in this analysis.

²³⁴ *Id.* at 68. Whitman would not protect glorifying use of the celebrity's identity from a right of publicity claim because the artist would be adding nothing new to societal discourse. *Id.* Whitman believes this is justified because the celebrity already disseminates positive characterizations about herself. *Id.* This reasoning can work under the transformative use analysis discussed subsequently in this section as well. The use of the celebrity in a glorifying manner, as she is traditionally viewed by society, is arguably not transformative. An interesting twist on this view would be presented if the celebrity whose identity was at issue were a celebrity due to notoriety. If the celebrity were famous for her bad reputation as opposed to a good reputation, an artist's glorifying presentation of the celebrity could in fact be quite transformative. For example, if an artist were to write a song characterizing Jesse James as an upstanding and model citizen, the work would likely add something new to the traditional societal discourse surrounding Jesse James and could be viewed as transformative.

²³⁵ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994). For an alternative view, see F. Jay Dougherty, *All the World's Not a Stooge: The "Transformativeness" Test for Analyzing a First Amendment Defense to a Right of Publicity Claim Against Distribution of a Work of Art*, 27 COLUM. J.L. & ARTS 1 (2003), which refutes the use of the "transformativeness" test in the realm of the right of publicity as "inadequate to satisfy the constitutional requirements under current First Amendment jurisprudence." *Id.* at 28. Professor Eugene Volokh has also criticized the "transformative use" test in right of publicity cases as being too vague. Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 Hous. L. Rev. 903, 918-23 (2003). This Comment does not argue that the transformative nature of a work should be the sole or even the primary consideration in either a Lanham Act or a right of publicity inquiry, but rather that it is one element or factor for a court to consider in determining the artistic relevance of a celebrity to an underlying work.

²³⁶ *Campbell*, 510 U.S. at 579 (stating that the central purpose of the investigation is whether the new work merely supercedes the object of the original creation or if it instead adds something new).

²³⁷ *See id.*; *Folsom v. Marsh*, 9 F. Cas. 342, 345 (C.C.D. Mass. 1841) (No. 4901).

creation of transformative works than nontransformative works.²³⁸ Transformative works “lie at the heart of the fair use doctrine’s guarantee of breathing space within the confines of copyright.”²³⁹ Thus, “the more transformative the new work,” the less significant the other factors, like commercialism, are to a finding of fair use of a copyrighted work.²⁴⁰

The concept of transformative works is also applicable when an artist asserts a First Amendment defense to a celebrity’s Lanham Act claim for infringing use of his name or identity. If a work simply repeats a celebrity’s name or copies her identity, without the artist adding anything of his own expression to the work, then what does it add to public discourse that should be protected by the First Amendment?²⁴¹ Society does not gain much if an artist is free to profit from the repeated use of a celebrity’s identity without adding any new expression or ideas. For instance, if an artist were to simply put a celebrity’s picture on a t-shirt²⁴² without any alteration or commentary, the public would gain very little in the form of artistic expression, but would be forced to accept a great deal of risk of confusion as to the celebrity’s endorsement of the t-shirt.

In order for art that involves the use of a celebrity to be transformative it must convey a different message than that which the celebrity’s name or identity typically implies. The use must add a new dimension to the public dialogue surrounding the celebrity and that which the celebrity puts forth herself. A work that criticizes or comments on a celebrity in some way will meter the celebrity and add a view of the celebrity that he will not generally put forth himself.²⁴³ California Supreme Court Justice Mosk described a transformative use of a celebrity as follows:

[The question is] whether the celebrity likeness is one of the “raw materials” from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression

²³⁸ *Campbell*, 510 U.S. at 579.

²³⁹ *Id.*

²⁴⁰ *Id.*

²⁴¹ Though the test proposed by this Comment does not intend to explicitly limit ways in which an artist might add to public discourse through use of a celebrity’s name or identity, it does propose that courts strongly consider whether the work itself adds anything to such discourse in reaching a determination on the issue of artistic relevance. Mere repetition of a celebrity’s likeness, be it through name or image, in a work of art that presents no message or commentary beyond the celebrity should compellingly point the court away from a finding of artistic relevance.

²⁴² It may be of note to the reader that McCarthy makes an interesting point that it often appears to be the medium, not the message, which makes a difference as to the result of a case pitting the protections of the First Amendment against those of trademark law. 5 MCCARTHY, *supra* note 35, § 31:152, at 31-253. McCarthy argues that if the medium is a “commercial” product, then the use is infringing. If the medium is “communicative,” then the First Amendment should trump trademark law. *Id.*

²⁴³ See Whitman, *supra* note 225, at 67 (right of publicity context).

rather than the celebrity's likeness. And when we use the word "expression," we mean expression of something other than the likeness of the celebrity.²⁴⁴

The court should compare the intensity of infringement on the celebrity's identity to the level of transformation of that identity in the new artistic work. A work that offers little edifying commentary as compared to its intense use of a celebrity's identity should not generally satisfy the requirement of a transformative work.²⁴⁵ For example, an article that offers only one small comment on a celebrity in an otherwise large piece should not be considered transformative in such a way as to allow the title of the article to include the celebrity's name.²⁴⁶ Where an artist makes no substantial effort to create a transformative work with new expression, meaning, or message apart from a celebrity's identity, the infringing work's commercial use will cut against the application of both copyright and trademark fair use defenses²⁴⁷ and should stand in opposition to a finding of artistic relevance. One court considering transformativeness as an affirmative defense to the use of a celebrity in a right of publicity claim has stated that courts should consider, as a subsidiary inquiry, the following:

[D]oes the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted? If this question is answered in the negative, then there would generally be no actionable right of publicity. When the value of the work comes principally from some source other than the fame of the celebrity—from the creativity, skill, and reputation of the artist—it may be presumed that sufficient transformative elements are present to warrant First Amendment protection. If the question is answered in the affirmative, however, it does not necessarily follow that the work is without First Amendment protection—it may still be a transformative work.²⁴⁸

If attaching a celebrity's name or identity to a work of art only serves to increase consumer appeal because of the prestige and reputation associated with the celebrity, and the work is not transformative of the celebrity's

²⁴⁴ *Comedy III Prods., Inc. v. Saderup*, 21 P.3d 797, 809 (Cal. 2001). The California Supreme Court was considering the transformativeness notion in a right of publicity claim in *Saderup*.

²⁴⁵ See, e.g., *Ty, Inc. v. Publ'ns Int'l, Ltd.*, No. 99-C-5565, 2000 WL 1499449, at *6 (N.D. Ill. Oct. 6, 2000) (stating that the fatal flaw in the defendant's argument that its use of the plaintiff's trademark was protected "criticism" and "commentary" was the defendant's failure to address the ratio of its infringing use to edifying commentary), *rev'd*, 292 F.3d 512 (7th Cir. 2002); *Paramount Pictures Corp. v. Carol Pub'g Group*, 11 F. Supp. 2d 329, 335 (S.D.N.Y. 1998) (finding a book, *The Joy of Trek*, was not transformative due to the fact that it failed to add "anything substantial that is new to the Star Trek story" as much of the book "merely encapsulate[d]" the story with only limited "asides").

²⁴⁶ At least the celebrity's name should not be used as the title of the work without the celebrity's express consent.

²⁴⁷ It will fall against a finding of fair use under copyright law because the infringing use of the celebrity's identity will not be transformative. Under trademark law, it may also fall against a finding of fair use because the appropriation of the celebrity's trademark, her name or identity, will likely not be descriptive of the underlying work.

²⁴⁸ *Saderup*, 21 P.3d at 810.

identity, then there is little artistic relevance and societal gain in the use of the celebrity. Thus, the alleged artistic relevance should carry little weight to counterbalance the likelihood of confusion found to exist.

In such a circumstance of competing rights (the celebrity's versus the artist's)²⁴⁹ and interests (the public interest in not being confused versus the public interest in free artistic expression), the weaker right and interest should give way to the stronger ones.²⁵⁰ When an artist merely repeats a celebrity's name or identity without transforming it in some way, the artist's right to free expression and the public's interest in it are the far weaker of the two rights and interests. The right of the celebrity to protect his identity and the public interest in avoiding consumer confusion are the much stronger rights and interests in a situation involving so little transformation of the trademark at issue.

The basic lesson that courts can draw from the copyright fair use defense is that an important aspect of an artistic relevance determination should be the way in which the artist makes use of the celebrity's name or identity. If the purpose or character of the use adds something to societal discourse in the form of commentary, parody, or criticism, for example, then courts should weigh this finding in favor of artistic relevance. Further, the more transformative the work, the greater the support the court will have for a finding of artistic relevance.

3. *Good Faith Requirement.*—Underlying any analysis of the artistic relevance of a defendant's use of a celebrity's name or identity should be a required element of good faith. While the good faith factor in the trademark fair use defense has not been frequently discussed or litigated,²⁵¹ courts should continue to pay attention to the defendant's intent in using the celebrity's mark. Courts and commentators that have considered good faith in the context of a fair use defense “equate a lack of good faith with the [defendant's] intent to trade on the good will of the trademark holder by creating confusion as to source or sponsorship” of the goods or services.²⁵² In analyzing the proper scope of good faith, precedents that apply the concept of good faith under the good faith factor of the likelihood of confusion test

²⁴⁹ While this steps a bit into the realm of the right of publicity, it is relevant for this discussion because of the similarities between a Lanham Act section 43(a) claim and a right of publicity claim.

²⁵⁰ In the light of a state law right of publicity claim, the California Supreme Court in *Saderup* addressed such a weighing of interests, saying that whenever

artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond the trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.

21 P.3d. at 808.

²⁵¹ *EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopolos, Inc.*, 228 F.3d 56, 66 (2d Cir. 2000) (citing 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:49, at 11-97 (4th ed. 2000)).

²⁵² *EMI*, 228 F.3d at 66.

are also relevant. Primarily, courts should focus on whether the defendant adopted a celebrity's mark with the principal intent to capitalize on the plaintiff's good will.²⁵³

No defendant should be allowed to prevail on a First Amendment defense where his use of a celebrity's name or identity, artistic or not, is intended to capitalize on the celebrity's fame and popularity for the defendant's own commercial use.²⁵⁴ For example, if an explicit reference to a celebrity's endorsement was used in a title and was false as applied to the underlying work, then the Lanham Act should apply even if there is some arguably artistic relevance between the title and the underlying work.²⁵⁵ This holds true because the public's interest in avoiding deception is certainly stronger than the public interest in the minor amount of free expression entailed in the misleading title in that case.²⁵⁶ No artist should be allowed to take a free ride on a celebrity's star value at the expense of both the celebrity and the public.²⁵⁷

V. CONCLUSION

Courts have long struggled to find an appropriate method for determining who should prevail between a celebrity and an artist when it comes to the use of a celebrity's identity in an artistic work. Over time, courts have developed and adjusted multiple approaches. However, none of these alternatives has succeeded in garnering majority acceptance, likely because of the inherent weaknesses that each test brings with it in protecting either trademark interests or the First Amendment right of artistic expression.

The balancing test proposed in this Comment satisfies the demand for a test that will sufficiently balance Lanham Act interests against First Amendment protections in the case where the trademark at issue is a celebrity's name or identity. By examining first the possible confusion caused by the use of the celebrity under the likelihood of confusion factors, courts begin with an analysis that provides proper protection for trademark interests. Upon finding a likelihood of confusion, courts should then take into

²⁵³ *Id.*

²⁵⁴ *See, e.g.,* Dr. Seuss Enters., L.P., v. Penguin Books USA, Inc., 109 F.3d 1394, 1405–06 (9th Cir. 1997).

²⁵⁵ For example, if the title of a book about basketball was *An Endorsed Biography of Michael Jordan*, but the book was not actually endorsed by the sports icon, then the Lanham Act should apply, even if the book is primarily about Michael Jordan. Thus, as is fairly clear, an artist's misrepresentation of the source or endorsement of a work should warrant a finding of bad faith. Bad faith should also be found by a court in the context of an artistic relevance determination whenever an artist attempts to trade on the value of a celebrity's name or identity without actually intending to create a work of art that is about that celebrity. A difficulty for courts facing this situation may arise in determining the actual intent of an artist as opposed to his actions as evidenced in the final work of art that comes before the court.

²⁵⁶ *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989).

²⁵⁷ *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1401 n.3 (9th Cir. 1992).

account the free expression element of the artistic relevance of the use by examining both common sense considerations and the additional factors drawn from fair use defenses in intellectual property law that have been enumerated in this Comment. These factors, which include the nature of the use of the celebrity's name or identity, the relationship between the celebrity and the product, the transformative nature of the use, and an underlying element of good faith on the part of the defendant, allow a court to ensure that an artist's use of a celebrity is in fact artistically relevant to the underlying work rather than operating as a mere gratuitous reference with no inherent value to the work itself or public discourse in general. By analyzing celebrity Lanham Act claims and First Amendment defenses in this manner, courts can identify the weight on each side of the scale and then strike the appropriate balance between the two competing interests and sides.

