

Summer 2019

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Dana Kramer

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Recommended Citation

Dana Kramer, *Honey Badger Does Care About First Amendment Protections in Trademark Law*, 84 Mo. L. REV. (2019)

Available at: <https://scholarship.law.missouri.edu/mlr/vol84/iss3/11>

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NOTE

Honey Badger Does Care About First Amendment Protections in Trademark Law

Gordon v. Drape Creative, Inc., 897 F.3d 1184 (9th Cir. 2018)

Dana Kramer*

I. INTRODUCTION

In his viral YouTube video, *The Crazy Nastyass Honey Badger*, comedian Christopher Gordon narrates a honey badger's actions as it hunts cobras and eats larvae from a beehive: "But look, the honey badger doesn't care. It's getting stung like a thousand times. It doesn't give a shit."¹ Shortly after Gordon's video went viral, Drape Creative, Inc. and Papyrus-Recycled Greetings, Inc. began producing greeting cards with catchphrases from Gordon's YouTube video even though the companies did not have a licensing agreement with Gordon.² Subsequently, in *Gordon v. Drape Creative, Inc.*, Gordon sued those two companies for trademark infringement.³

Trademarks assist the public in identifying the source of a good, service, or product.⁴ However, trademarks often develop their own social meaning beyond their source-identifying function, like "Google" or "Band-Aid."⁵

* B.S., Culver-Stockton College, 2017; J.D. Candidate, University of Missouri School of Law, 2020. Thank you to Professor Dennis Crouch for suggesting this topic, and thank you to the editorial staff of the Missouri Law Review for their helpful insight during the editing process.

1. Christopher Gordon, *The Crazy Nastyass Honey Badger*, YOUTUBE (Jan. 18, 2011), <https://www.youtube.com/watch?v=4r7wHMg5Yjg&t=3s> [perma.cc/HRH7-CK72]. Gordon's video received over ninety million views on YouTube and has its own Wikipedia page and mobile app. *Id.*; see also *The Crazy Nastyass Honey Badger*, WIKIPEDIA, https://en.wikipedia.org/wiki/The_Crazy_Nastyass_Honey_Badger [perma.cc/7HHZ-SASQ] (last visited Apr. 2, 2019).

2. *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 262 (9th Cir. 2018).

3. *Id.* Foul and abusive language cannot be suppressed merely because society finds it offensive. In re Brunetti, 877 F.3d 1330, 1351–52 (Fed. Cir. 2017), cert. granted *sub nom.* Iancu v. Brunetti, 139 S. Ct. 782 (2019). Moreover, the Lanham Act's prohibition on registration of immoral and scandalous trademarks is not based on sufficient justification to suppress First Amendment speech protections. *Id.* at 1355.

4. 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2.3 (5th ed.).

5. Thomas M. Byron, *Spelling Confusion: Implications of the Ninth Circuit's View of the "Explicitly Misleading" Prong of the Rogers Test*, 19 J. INTELL. PROP. L. 1, 3–4 (2011).

Trademarks are frequently used for non-source-identifying purposes in expressive works such as song titles, video games, or greeting cards.⁶ In these instances, overly broad interpretations of trademark rights may endanger First Amendment free speech values.⁷ Additionally, in trademark infringement suits, courts inconsistently apply various tests, including the *Rogers* test and the likelihood of confusion test, to determine whether use of a particular trademark is infringement, adding another barrier to the protection of free expression.⁸

In *Gordon v. Drape Creative, Inc.*, the United States Court of Appeals for the Ninth Circuit allowed Gordon to pursue his trademark claims against the greeting card companies.⁹ But the court's holding restricts First Amendment freedom of expression and adds more confusion to an already murky area of law, causing internal tension in the Ninth Circuit. The *Gordon* decision also drives a deeper wedge into a circuit split on the issue of First Amendment protections within trademark law, making this issue ripe for the United States Supreme Court to review. This Note argues trademark laws should be interpreted to avoid collision with constitutional free speech doctrine, meaning confusion may need to be tolerated sometimes for the sake of preserving free speech.¹⁰ Part II relays the facts and holding of *Gordon*. Part III provides legal background for the issues presented in *Gordon*. Part IV relates the Ninth Circuit's decision and reasoning in *Gordon*, and Part V comments on the implications of the Ninth Circuit's opinion.

6. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (stating, "Trademarks often fill in gaps in our vocabulary and add a contemporary flavor to our expressions. Once imbued with such expressive value, the trademark becomes a word in our language and assumes a role outside the bounds of trademark law.").

7. Brief *Amici Curiae* of 37 Intellectual Property Law Professors in Support of Appellees' Petition for Panel Rehearing and Rehearing En Banc at 4, *Gordon v. Drape Creative, Inc.*, 909 F.3d 257 (9th Cir. 2018) (No. 16-56715); William McGeeveran, *Four Speech Goals for Trademark Law*, 18 *FORDHAM INTELL. PROP., MEDIA & ENT. L.J.* 1205, 1206 (2008).

8. See *infra* Section III.

9. 909 F.3d 257, 260 (9th Cir. 2018).

10. *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 271–72 (9th Cir. 2018); see McGeeveran, *supra* note 7, at 1213; William McGeeveran & Mark P. McKenna, *Confusion Isn't Everything*, 89 *NOTRE DAME L. REV.* 253, 300 (2013) (stating, "In some sets of cases that raise particularly significant conflicts with other values while routinely posing little serious risk of passing off, courts should disregard confusion entirely.").

II. FACTS AND HOLDING

In 2015, Plaintiff Christopher Gordon filed a trademark infringement action under the Lanham Act¹¹ against Defendants Drape Creative, Inc. (“DCI”) and Papyrus-Recycling Greetings, Inc. (“PRG”) (“Defendants,” collectively) for using catchphrases from Gordon’s popular YouTube video.¹² PRG, a greeting card manufacturer, is a subsidiary of DCI, a Missouri greeting card design studio.¹³ Gordon is a comedian most known for his YouTube video titled *The Crazy Nastyass Honey Badger*.¹⁴ In his video, Gordon narrates National Geographic footage of a honey badger, using catchphrases such as “Honey Badger Don’t Give a Shit” (“HBDGS”) and “Honey Badger Don’t Care” (“HBDC”) to describe the honey badger’s behavior.¹⁵ In February 2011, Gordon began producing and selling items with the HBDC and HBDGS marks, including books, calendars, t-shirts, and mugs.¹⁶ Shortly thereafter, Gordon copyrighted his narration in the YouTube video and registered HBDC with the United States Patent and Trademark Office (“USPTO”) for various classes of goods, which included greeting cards.¹⁷ However, Gordon never registered HBDGS with USPTO.¹⁸

In 2012, Gordon’s licensing agent secured agreements with two companies, Zazzle, Inc. and The Duck Company, for honey badger themed products, including greeting cards.¹⁹ That same year, Gordon’s licensing agent met with PRG to discuss licensing honey badger themed greeting cards.²⁰ However, unlike Zazzle, Inc. and The Duck Company, PRG never signed a licensing agreement with Gordon.²¹ Nonetheless, PRG began producing its own line of honey badger greeting cards in June 2012.²²

PRG sold a total of seven different greeting cards with Gordon’s catchphrases.²³ Of the seven, two were election cards showing a honey badger wearing a patriotic hat and stating “The Election’s Coming.”²⁴ On the inside, one card read “Me and Honey Badger don’t give a \$#%@!” and the other said

11. 15 U.S.C. § 1051 (2012). The Lanham Act is the federal statute governing trademarks. It addresses activities such as trademark infringement, trademark dilution, and unfair competition.

12. *Gordon*, 909 F.3d at 263.

13. *Id.* at 261.

14. *Id.*; Christopher Gordon (@czg123), *supra* note 1.

15. *Gordon*, 909 F.3d at 261.

16. *Id.* at 261.

17. *Id.*

18. *Id.* at 261–62.

19. *Id.* at 262.

20. *Id.*

21. *Id.*

22. *Id.*

23. *Id.*

24. *Id.*

“Honey Badger and me just don’t care.”²⁵ Two birthday cards pictured a honey badger saying either “It’s Your Birthday!” or “Honey Badger Heard It’s Your Birthday.”²⁶ Inside, both cards read “Honey Badger Don’t Give a Shit.”²⁷ Two Halloween cards portrayed a honey badger standing next to a pumpkin and stated “Halloween is Here.”²⁸ Inside, the cards read either “Honey Badger don’t give a \$#*%” or “Honey Badger don’t give a s---.”²⁹ Finally, one card resembled a Twitter page and depicted a series of messages from Honey-Badger@don’tgiveas---.³⁰ The front stated “Just killed a cobra. Don’t give a s---”; “Just ate a scorpion. Don’t give a s---”; and “Rolling in fire ants. Don’t give a s---.”³¹ Inside, the card read “Your Birthday’s here... I give a s---.”³² The back of each card displayed PRG’s mark and listed websites for both DCI and PRG.³³

In June 2015, Gordon filed an action under the Lanham Act against Defendants alleging trademark infringement.³⁴ The United States District Court for the Central District of California granted summary judgment for Defendants.³⁵ The district court found Defendants’ greeting cards were expressive works,³⁶ triggering use of the *Rogers* test to bar all of Gordon’s claims.³⁷ The *Rogers* test is a two-pronged inquiry that generally provides that the Lanham Act shall not apply unless the underlying work has no artistic relevance whatsoever, or, if the work has some artistic relevance, the Lanham Act does not apply unless the work explicitly misleads consumers as to the source or content of the work.³⁸ The *Rogers* test balances two competing interests: the public interest in avoiding confusion about the source of a product and the public interest in freedom of expression.³⁹ In granting summary judgment, the district

25. *Id.*

26. *Id.*

27. *Id.*

28. *Id.*

29. *Id.* at 262–63.

30. *Id.* at 263.

31. *Id.*

32. *Id.*

33. *Id.*

34. *Id.* “The Lanham Act . . . ‘creates a comprehensive framework for regulating the use of trademarks and protecting them against infringement, dilution, and unfair competition.’” *Id.* (quoting *Fortune Dynamic, Inc. v. Victoria’s Secret Stores Brand Mgmt.*, 618 F.3d 1025, 1030 (9th Cir. 2010)); *see also* 15 U.S.C. § 1051 (2012).

35. *Gordon*, 909 F.3d at 257.

36. “‘Expressive’ uses of trademarks convey an articulable message rather than, or in addition to, the traditional function of source identification.” William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 54 (2010).

37. *Gordon*, 909 F.3d at 263; *see also* *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

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

39. *Id.*

court found that Defendants' use of Gordon's mark was not explicitly misleading because Defendants did not make "an affirmative statement of the plaintiff's sponsorship or endorsement."⁴⁰

On appeal to the United States Court of Appeals for the Ninth Circuit, Gordon argued that Defendants' greeting cards were not expressive works entitled to First Amendment protection and that Defendants' use of Gordon's catchphrases were not "artistically relevant" to the greeting cards.⁴¹ Gordon also urged that even if the *Rogers* test did apply, Defendants' use of his trademark was "explicitly misleading."⁴² In response, Defendants argued that their greeting cards were expressive works that did not identify Gordon as the source.⁴³ Therefore, Defendants urged that they were entitled to the application of the *Rogers* test and protection under the First Amendment.⁴⁴

The Ninth Circuit reversed the district court's decision and remanded the case for further fact-finding on "whether defendants' use of Gordon's mark is artistically relevant to their cards."⁴⁵ In doing so, the Ninth Circuit held that use of a mark is "artistically relevant" when the mark relates to Defendants' work and Defendants add their own artistic expression beyond that of the mark.⁴⁶

Shortly after the Ninth Circuit published its opinion, Defendants filed a petition for panel rehearing and for rehearing en banc.⁴⁷ The petition urged that the Ninth Circuit's decision "create[d] considerable confusion" in applying the *Rogers* test to evaluate artistic relevance.⁴⁸ Additionally, thirty-seven law professors filed an amicus brief, arguing that trademark law, unlike copyright law,⁴⁹ does not protect creators and their creations but rather protects the source-identifying function of trademarks.⁵⁰ The amicus curiae argued that *Gordon's* requirement of an artistry inquiry "threatens *Rogers'* protection across a broad range of works and creates a conflict with copyright law and

40. *Gordon*, 909 F.3d at 269.

41. Brief for Plaintiff-Appellant Christopher Gordon at 22–23, *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184 (9th Cir. 2018) (No. 16-56715).

42. *Id.* at 23.

43. Appellee's Brief at 25–26, *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184 (9th Cir. 2018) (No. 16-56715).

44. *Id.*

45. *Gordon*, 897 F.3d at 1196.

46. *Id.*

47. Appellees' Petition for Panel Rehearing and Rehearing En Banc, *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184 (9th Cir. 2018) (No. 05-1631).

48. *Id.* at 17.

49. Brief *Amici Curiae* of 37 Intellectual Property Law Professors in Support of Appellees' Petition for Panel Rehearing and Rehearing En Banc at 1, *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184 (9th Cir. 2018) (No. 05-1631).

50. *Id.*

with prior decisions of [the Ninth] and other circuits.”⁵¹ The amicus curiae concluded by calling for a decision consistent with *Rogers* and its progeny.⁵²

The Ninth Circuit granted rehearing and issued a superseding opinion.⁵³ The Ninth Circuit again reversed and remanded the district court’s grant of summary judgment and also created new requirements for the second prong of the *Rogers* test.⁵⁴ In its revised opinion, the Ninth Circuit resolved the first prong of the *Rogers* test against Gordon, finding that Defendants’ use of the honey badger phrases was artistically relevant.⁵⁵ When considering *Rogers*’ second prong, however, the Ninth Circuit rejected the district court’s standard of “an affirmative statement of the plaintiff’s sponsorship or endorsement” and added two subfactors to be considered when analyzing whether use of a mark is explicitly misleading.⁵⁶ The first is “the degree to which the junior user uses the mark in the same ways as the senior user.”⁵⁷ The second is “the extent to which the junior user has added his or her own expressive content to the work beyond the mark itself.”⁵⁸ The Ninth Circuit also expanded the *Rogers* test to include a “likelihood of confusion” analysis if both prongs of the *Rogers* test are met.⁵⁹ Holding that Defendants’ use was artistically relevant as a matter of law, the Ninth Circuit remanded the case for further fact-finding of whether Defendants’ use was explicitly misleading.⁶⁰

III. LEGAL BACKGROUND

Trademark law serves a dual purpose in protecting consumers against deception and confusion while protecting the producer’s infringed trademark as property.⁶¹ Generally, these two goals complement one another.⁶² These ends are achieved through the trademark holder’s right of action for trademark infringement under the Federal Trademark Act of 1946, otherwise known as the Lanham Act.⁶³

51. *Id.*

52. *Id.* at 16.

53. *Gordon v. Drape Creative Inc.*, 909 F.3d 257, 271–72 (9th Cir. 2018).

54. *Id.* at 271–72.

55. *Id.* at 269.

56. *Id.* at 269–71.

57. *Id.* at 270. A junior user is a subsequent user of a mark that has already been filed with the USPTO or used by another, the senior user. The junior user’s mark is then called the “junior mark,” and the senior user’s mark is called the “senior mark.”

58. *Id.* at 270–71.

59. *Id.* at 264–65.

60. *Id.* at 271.

61. MCCARTHY, *supra* note 4, at § 2:2.

62. *Id.*

63. *Gordon*, 909 F.3d at 270–71; Byron, *supra* note 5, at 2.

Section 43(a) of the Lanham Act protects trademark holders against false advertising and infringement.⁶⁴ The USPTO defines trademark infringement as “the unauthorized use of a trademark . . . on or in connection with goods and/or services in a manner that is likely to cause confusion, deception, or mistake about the source of the goods and/or services.”⁶⁵ Traditionally, trademark infringement rulings did not violate the First Amendment because commercial speech did not receive constitutional protection.⁶⁶ Commercial speech is “a word, name, symbol, or device . . . used as a trademark to identify and distinguish the source of commercial goods or services.”⁶⁷ The Supreme Court extended First Amendment protection to commercial speech in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, where the Supreme Court recognized that consumers have an interest “in the free flow of commercial information.”⁶⁸ Although the First Amendment now protects commercial speech, more substantial free speech concerns can arise when a mark limits expressive speech.⁶⁹

When trademarks are used in expressive ways, courts have to balance the public’s interest in minimizing confusion as to the source of a good or product with the public’s interests in preserving its First Amendment freedom of expression.⁷⁰ However, the interplay between First Amendment protections and trademark law is still partially unsettled, resulting in jurisdictions employing different doctrines – such as the “likelihood of confusion” test and the *Rogers* test – to analyze whether use of a trademark infringes on the trademark holder’s rights.⁷¹

64. 15 U.S.C. § 1125 (2012).

65. *Valentine v. Chrestensen*, 316 U.S. 52, 54 (1942).

66. McGeeveran, *supra* note 7, at 1211.

67. Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 383, 396 (2008).

68. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 763–65 (1976).

69. McGeeveran, *supra* note 7, at 1211; *see also* *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 561–563 (1980) (stating, “The protection available for particular commercial expression turns on the nature both of the expression and of the governmental interests served by its regulation. The First Amendment’s concern for commercial speech is based on the informational function of advertising.”).

70. McGeeveran, *supra* note 7, at 1211; *see, e.g.*, *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002); *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 792, 807 (9th Cir. 2003); *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1196 (9th Cir. 2017).

71. 6 CALLMAN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 22.61 (4th ed. 2018).

A. “Likelihood of Confusion” Test

Generally, in determining whether infringement claims brought under the Lanham Act have merit, courts consider whether the preexisting mark used by a subsequent user might spur a “likelihood of confusion” among consumers.⁷² The likelihood of confusion test requires the plaintiff to prove it has a protectable trademark and that the defendant’s use of the mark will likely cause confusion among “ordinarily prudent buyers . . . about the source of a product.”⁷³ When applying the likelihood of confusion test to claims brought under the Lanham Act, courts weigh various factors, such as the strength of the senior mark, the degree of similarity between the marks, and the defendant’s good faith in developing its own junior mark.⁷⁴ This test, though “murky and pliable,” usually “strikes a comfortable balance” between the Lanham Act and First Amendment protections of free expression.⁷⁵

However, the likelihood of confusion test does not apply to every trademark case. Popular trademarks often become part of the consumer’s vernacular.⁷⁶ Trademarks such as “Barbie” become common terms that songs, books, and movies reference as a way to add expression to the underlying work.⁷⁷ Alternatively, a junior user may utilize the mark as a means of communication and “capitalize on knowledge common to speaker and listener.”⁷⁸ In these instances of expressive use, the applicability of the test breaks down because the public “is not very likely to be confused into believing that an expressively used trademark indicates any affiliation between the expressive user and the trademark holder.”⁷⁹ When trademarks are used in this manner, the likelihood of confusion test is ill-suited to address infringement claims because it “ignor[es] the First Amendment concerns implicated by the test.”⁸⁰ In other words, the factors considered under the likelihood of confusion test are immaterial when considering expressive works because trademark use in that context rarely confuses consumers about the source of the work.⁸¹

72. *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018).

73. *Likelihood of Confusion*, BLACK’S LAW DICTIONARY (11th ed. 2019).

74. *Byron*, *supra* note 5, at 3.

75. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d at 900; *McGeveran*, *supra* note 7, at 1214.

76. *Byron*, *supra* note 5, at 3.

77. *Id.* at 3–4.

78. *Id.* at 4–5. For example, the mark “Google” is commonly used to refer to the search engine and also to describe the act of using the search engine, i.e. when you “google” something. *Id.* at 3.

79. *Id.* at 4.

80. Daniel J. Wright, *Explicitly Explicit: The Rogers Test and the Ninth Circuit*, 21 J. INTEL. PROP. L. 194, 216 (2013).

81. *Id.*

B. The Rogers Test: Expressive Works Using Trademarks

The *Rogers* test arose out of the difficulties presented by the likelihood of confusion test.⁸² The United States Court of Appeals for the Second Circuit recognized the need for a different mode of analysis to address the problems posed by expressive works using trademarks and tackled this issue in *Rogers v. Grimaldi*.⁸³ There, Hollywood performer Ginger Rogers filed suit against the producers and distributors of the film “Ginger and Fred,” which followed the story of two fictional Italian cabaret performers who imitated Rogers and her co-star, Fred Astaire.⁸⁴ Rogers claimed the movie’s title created a false impression that the movie was about her or sponsored by her because her name was in the title of the work.⁸⁵ The United States District Court for the Southern District of New York granted summary judgment to the producers and distributors, concluding that the movie was a work of artistic expression and not a commercial product.⁸⁶ Therefore, the district court held that the Lanham Act did not apply to titles of expressive works, and accordingly the movie was entitled to full First Amendment protection.⁸⁷

The Second Circuit affirmed the district court’s ruling.⁸⁸ However, it found the district court’s holding “unduly narrow[ed] the scope of the [Lanham] Act,” reasoning that the holding would insulate movie titles almost entirely from Lanham Act claims.⁸⁹ The Second Circuit then ruled that the Lanham Act *could* be applied to titles of expressive works.⁹⁰ The court stated that “titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion.”⁹¹ The court then formulated the *Rogers* test to balance trademark rights and First Amendment rights:

[The Lanham] Act should be construed to apply only to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression [T]hat balance will normally not support application of the Act unless the title has no artis-

82. Byron, *supra* note 5, at 5.

83. 875 F.2d 994 (2d Cir. 1989).

84. *Id.* at 996–97.

85. *Id.* at 997.

86. *Id.*

87. *Id.*

88. *Id.* at 996.

89. *Id.* at 997.

90. *Id.* at 999.

91. *Id.* at 998.

tic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or content of the work.⁹²

The Second Circuit's rationale behind the *Rogers* test considered consumers' interest in not being misled and in "enjoying the results of the author's freedom of expression."⁹³

The original *Rogers* test consists of two prongs.⁹⁴ The first prong applies when use of a mark has no artistic relevance to the underlying work.⁹⁵ De minimis artistic relevance is sufficient to meet *Rogers*' first prong.⁹⁶ For example, the Ninth Circuit found a band's use of the term "Barbie" in a song titled "Barbie Girl" to be artistically relevant because the song was about Barbie and the values she represented according to the band.⁹⁷ If the use of mark has no artistic relevance, the Lanham Act will prohibit its use as trademark infringement because a "misleading [use] with no artistic relevance cannot be sufficiently justified by a free expression interest."⁹⁸ If a mark has artistic relevance, the second prong applies when use of the mark in the expressive work explicitly misleads the consumer as to the source or content of the work.⁹⁹ If either prong is met, the use of the mark will be prohibited as trademark infringement.¹⁰⁰ The Second Circuit found that the title at issue in *Rogers* had artistic relevance and did not explicitly mislead consumers as to the content or sponsorship of the defendants' film.¹⁰¹ Therefore, *Rogers*' claims under the Lanham Act were barred.¹⁰²

92. *Id.* at 999. The Second Circuit additionally rejected the "no alternative avenues" argument articulated by *Rogers*. *Id.* This standard applies when a title "is so intimately related to the subject matter of a work that the author has no alternative means of expressing what the work is about," thereby implicating First Amendment concerns. *Id.* at 998. The Second Circuit ultimately rejected the "no alternative avenues" standard because it did not sufficiently accommodate public interest in free expression. *Id.* at 999.

93. *Id.* at 998.

94. MCCARTHY, *supra* note 4, at § 31:144:50.

95. *Id.*

96. *E.S.S. Entm't 2000 Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1097 (9th Cir. 2003).

97. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

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

99. MCCARTHY, *supra* note 4, at § 31:144:50.

100. *Id.*

101. *Rogers*, 875 F.2d at 1001. "As [the producer] explains in an affidavit, *Rogers* and *Astaire* are to him 'a glamorous and care-free symbol of what American cinema represented during the harsh times which Italy experienced in the 1930s and 1940s.' In the film, he contrasts this elegance and class to the gaudiness and banality of contemporary television, which he satirizes." *Id.*

102. *Id.*

The *Rogers* test is merely a defense to trademark infringement and does not involve a constitutional analysis even though its purpose is to protect free speech.¹⁰³ The Supreme Court has previously held that a defense with an imbedded free speech protection is preferred to a constitutional analysis, as demonstrated in *Eldred v. Ashcroft*,¹⁰⁴ a parallel copyright case: “[C]opyright’s built-in free speech safeguards are generally adequate to address [First Amendment concerns].”¹⁰⁵ Just as in copyright law, trademark law inherently protects the unauthorized use of a senior mark.¹⁰⁶ Many trademark uses fall outside the realm of trademark protection because the mark is not used to identify the source of a good.¹⁰⁷ In such instances, and as exemplified in *Rogers*, free speech concerns “pervade[] the common law of trademark.”¹⁰⁸

C. Variations of the *Rogers* Test

Though the *Rogers* test originated in the Second Circuit, other courts have adopted it as well, including the United States Courts of Appeals for the Fifth, Sixth, Ninth, and Eleventh Circuits.¹⁰⁹ No court has expressly rejected the *Rogers* test, although the Fourth, Eighth, and Tenth Circuits still apply the likelihood of confusion test.¹¹⁰ Appellate courts that have adopted the *Rogers* test apply it in essentially three different categories: the strict *Rogers* test, the quasi-*Rogers* test, and the *Rogers* “rollercoaster test” of the Ninth Circuit.¹¹¹

1. The Strict *Rogers* Test

The first category – the strict *Rogers* test – applies the *Rogers* analysis as originally articulated by the Second Circuit.¹¹² Under this approach, only *explicitly* misleading uses of a trademark are regulated under the Lanham Act and

103. MCCARTHY, *supra* note 4, at § 31:144:50.

104. 537 U.S. 186 (2003).

105. *Id.* at 221.

106. Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 COLUM. J.L. & ARTS 187, 189 (2004).

107. *Id.* at 194.

108. *Id.* at 195.

109. See *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65 (5th Cir. 2000); *Parks v. LaFace Records*, 329 F.3d 437, 450 (6th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002); *Univ. of Ala. Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012).

110. See *Radiance Found., Inc. v. N.A.A.C.P.*, 786 F.3d 316, 324 (4th Cir. 2015); *Anheuser-Busch, Inc. v. Balducci Publ’n*, 28 F.3d 769, 774 (8th Cir. 1994); *PAM Media, Inc. v. Am. Research Corp.*, 889 F. Supp. 1403, 1406 (10th Cir. 1995).

111. Byron, *supra* note 5, at 9.

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

implicitly misleading trademark uses are subjected to First Amendment protections and outside the reach of the Lanham Act.¹¹³

The Eleventh Circuit falls within the strict *Rogers* category.¹¹⁴ In *University of Alabama Board of Trustees v. New Life Art*, a university brought suit against an artist for depicting the university's football jerseys in his paintings, prints, and calendars memorializing notable football moments.¹¹⁵ The United States District Court for the Northern District of Alabama initially applied the likelihood of confusion test and concluded that the artist's use of the mark produced "merely some likelihood of confusion."¹¹⁶ However, recognizing that paintings, prints, and calendars are entitled to First Amendment protection, the Eleventh Circuit, on appeal, adopted the *Rogers* test to balance the artist's interest in free speech and the university's interest in trademark rights.¹¹⁷ The court found the artist's use of the university's mark to be artistically relevant because "the uniforms' colors and designs [were] needed for a realistic portrayal of famous scenes from [the university's] football history."¹¹⁸ The court further concluded the artist's works were not explicitly misleading because the artist's use of the mark was "mere inclusion" and was substantially outweighed by the artist's interest in expression.¹¹⁹ Therefore, the artist's works did not infringe on the university's trademark.¹²⁰

The Sixth Circuit similarly adopted this approach in *Parks v. LaFace Records*.¹²¹ In *Parks*, civil rights icon Rosa Parks brought suit against a record producer and the rap duo OutKast for using her name in the title of their song *Rosa Parks*.¹²² After noting that many other jurisdictions had adopted the *Rogers* test, the court explicitly rejected the likelihood of confusion test and determined the *Rogers* test was the best approach for balancing Parks' trademark interests with OutKast's First Amendment interests.¹²³

In applying *Rogers*, the court held that the use of Parks' name was not explicitly misleading because the song "ma[de] no explicit statement that the work [was] about [Rosa Parks] in any direct sense."¹²⁴ However, the Sixth Circuit found a triable issue of fact existed as to whether the song's title was

113. Byron, *supra* note 5, at 10 (emphasis added).

114. See *New Life Art, Inc.*, 683 F.3d at 1277–78.

115. *Id.* at 1270.

116. *Id.* at 1276.

117. *Id.* at 1279.

118. *Id.* at 1278–79.

119. *Id.* at 1279.

120. *Id.*

121. 329 F.3d 437, 452 (6th Cir. 2003).

122. *Id.* at 441.

123. *Id.* at 448–52. The court adopted the *Rogers* test after looking at its application in a case from the Ninth Circuit where a band used the trademarked term "Barbie" in the title of their song. *Id.* at 451; see also *Mattel, Inc. v. MCA Records, Inc.* 296 F.3d 894 (9th Cir. 2002).

124. *Parks*, 329 F.3d at 459.

artistically relevant to the song itself.¹²⁵ Leaning toward a finding of no artistic relevance, the court questioned the relevancy of the song's title to the lyrics: "OutKast's only explanation . . . is that the name Rosa Parks is a 'symbol.' It is, indeed, a symbol, but the question is how the symbol is artistically related to the content of a song that appears to be diametrically opposed to [the qualities Rosa Parks represents]."¹²⁶ The Sixth Circuit then remanded the case to decide this question.¹²⁷

2. The Quasi-*Rogers* Category

The second category adopts the theory behind *Rogers* but not its exact articulation, resulting in a quasi-*Rogers* test.¹²⁸ The quasi-*Rogers* test, in comparison to the strict *Rogers* test, is somewhat less protective of expression and more protective of trademark holders' rights.¹²⁹

The Second Circuit itself adopted this approach in *Cliff Notes v. Bantam Doubleday Publishing* shortly after *Rogers* was decided.¹³⁰ In *Cliff Notes*, publishers of the study guide series *Cliff Notes* brought suit against the producers of a parody of the series called *Spy Notes*, alleging that the cover of *Spy Notes* gave consumers the impression that the parody was the publishers' product.¹³¹

The Southern District of New York granted a preliminary injunction against the producers of *Spy Notes*.¹³² On appeal, the Second Circuit recognized the *Rogers* test only so far as to weigh "public interest in free expression against the public interest in avoiding consumer confusion."¹³³ The court reasoned that parodies, being expressive works, required more protection than ordinary commercial speech.¹³⁴ The Second Circuit then expanded the second element of the *Rogers* test to include a likelihood of confusion analysis.¹³⁵ In applying this quasi-*Rogers* test, the court held that the parodic nature of *Spy Notes* outweighed the likelihood of consumer confusion and vacated the injunction.¹³⁶

125. *Id.* at 458.

126. *Id.* at 455–56.

127. *Id.* at 459.

128. Byron, *supra* note 5, at 12.

129. *Id.* at 14.

130. *See Cliff Notes, Inc. v. Bantam Doubleday Publ'g Group, Inc.*, 886 F.2d 490, 494 (2d Cir. 1989).

131. *Id.* at 492.

132. *Id.* at 493.

133. *Id.* at 494.

134. *Id.* at 495.

135. *Id.*

136. *Id.* at 497.

The Fifth Circuit also adopted this approach to internal trademark use in expressive works.¹³⁷ In *Westchester Media v. PRL Doubleday Publishing*, the Fifth Circuit applied the *Rogers* test when fashion designer Ralph Lauren brought an infringement suit against a magazine publisher for using Lauren's "POLO" mark as a title.¹³⁸ The court applied the likelihood of confusion test to determine whether use of the mark was explicitly misleading under the second prong of *Rogers* and found that a likelihood of confusion existed between the magazine publishers and Lauren's POLO marks.¹³⁹

3. The *Rogers* Rollercoaster Category

The third category is "more confusion-averse and expression unfriendly" in comparison to the other two categories.¹⁴⁰ This category – dubbed here as the *Rogers* rollercoaster – is the most unfriendly to First Amendment protections in infringement actions and sporadically applies a partial likelihood of confusion test to *Rogers* analyses.¹⁴¹ The Ninth Circuit adopted this approach after deciding "the Barbie cases"¹⁴² and a case involving the popular video game *Grand Theft Auto*, but its application has been "somewhat facile" and "confusing."¹⁴³

In the first Barbie case, *Mattel v. MCA Records*, the Ninth Circuit applied a strict interpretation of *Rogers*.¹⁴⁴ Mattel, the manufacturer of Barbie dolls, brought claims under the Lanham Act against the music companies that produced the song "Barbie Girl" by the Danish band Aqua for using Barbie in the title of the song.¹⁴⁵ The lyrics of the song "poke fun" at Barbie for the values she represents according to Aqua.¹⁴⁶

The Ninth Circuit applied *Rogers* in its analysis.¹⁴⁷ Considering the lyrics of the song in relation to its title, the Ninth Circuit held that the use of Barbie

137. See *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65 (5th Cir. 2000).

138. *Id.* at 664–667.

139. *Id.* at 667.

140. Byron, *supra* note 5, at 15.

141. See generally *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 894 (9th Cir. 2002); *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 792, 797 (9th Cir. 2003); *E.S.S. Entm't 2000 Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1097 (9th Cir. 2003); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013); *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192 (9th Cir. 2017).

142. See *infra* note 144–62.

143. Byron, *supra* note 5, at 8; see also *MCA Records, Inc.*, 296 F.3d at 894; *Walking Mountain Productions*, 353 F.3d at 796; *E.S.S. Entm't 2000 Inc.*, 547 F.3d at 1095.

144. *MCA Records, Inc.*, 296 F.3d at 902; Byron, *supra* note 5, at 8.

145. *MCA Records, Inc.*, 296 F.3d at 899.

146. *Id.* at 901.

147. *Id.* at 902.

in the song's title was artistically relevant to the song itself.¹⁴⁸ For the second prong of *Rogers*, the court found that the song title did not explicitly mislead consumers regarding the work's origin because use of a trademark alone was not sufficient to satisfy the second prong of *Rogers*.¹⁴⁹ If use of a mark alone was sufficient to meet *Rogers*' second prong, the court reasoned, it would nullify *Rogers* because such minimal use would automatically tip the balance in favor of protecting the rights of trademark holders without considering free speech interests.¹⁵⁰ The court noted that trademark rights do not authorize the trademark owner to stifle a third party's expressive use of the mark.¹⁵¹ Additionally, the court chose not to apply the likelihood of confusion test because it "failed to take account of the public's interest in free expression" when "trademarks transcend their identifying purpose."¹⁵² In light of these considerations, the court affirmed summary judgment for the music producers.¹⁵³

The Ninth Circuit next applied *Rogers* in the second Barbie case, *Mattel v. Walking Mountain Productions*.¹⁵⁴ There, a photographer used Barbie dolls to produce photographs with social and political connotations and used Barbie in the title of his work.¹⁵⁵ Mattel brought claims against the photographer under the Lanham Act.¹⁵⁶ The court considered the cultural significance of Barbie in its analysis: "Where a mark assumes such cultural significance, First Amendment protections come into play."¹⁵⁷ The court noted the role of the "Barbie" mark in modern culture, referencing the song at issue in *MCA Records*.¹⁵⁸ The *Walking Mountain* court then applied the *Rogers* test in essentially the same way as in *MCA Records* and held that the public's interest in free expression outweighed the risk of consumer confusion about Mattel's endorsement of the photographer's works.¹⁵⁹ However, the Ninth Circuit, in noting that the term Barbie had become part of the public vernacular "outside the bounds of trademark law,"¹⁶⁰ seemed to suggest *Rogers* only applied to the

148. *Id.*

149. *Id.*

150. *Id.* at 900.

151. *Id.*

152. *Id.*

153. *Id.* at 902.

154. *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 792, 792 (9th Cir. 2003).

155. *Id.* at 796. In his photographs, photographer Thomas Forsythe depicted Barbie in the following manners: a nude Barbie on a vintage Hamilton Beach malt machine, a Barbie head in a fondue pot, and four Barbie dolls wrapped in tortillas, covered with salsa, lying in a casserole dish inside a lit oven. *Id.*

156. *Id.* at 797.

157. *Id.* at 807.

158. *Id.*

159. *Id.*

160. *Id.* (quoting *Mattel Inc. v. MCA Records*, 296 F.3d 894, 900 (9th Cir. 2002)).

unauthorized use of marks with a “transcendent meaning” that had become part of the culture.¹⁶¹

The Ninth Circuit again employed *Rogers* in 2008 and expanded the test’s applicability beyond titles.¹⁶² In *E.S.S. Entertainment 2000 v. Rock Star Videos*, the owner of a strip club brought suit against the creators of the video game *Grand Theft Auto: San Andreas* under the Lanham Act for their portrayal of a strip club in the game that resembled the owner’s club.¹⁶³ Addressing the first prong of *Rogers*, the Ninth Circuit held that a work’s artistic relevance must only be above zero to satisfy the first prong.¹⁶⁴ However, unlike *Walking Mountain*, the court did not consider whether the owner’s club had any cultural significance.¹⁶⁵

The court then analyzed whether the use of the owner’s club explicitly misled consumers.¹⁶⁶ The court posited that the relevant inquiry was whether the video game would make players think the club owner somehow sponsored the game.¹⁶⁷ The court assessed the potential confusion with a partial likelihood of confusion analysis, considering factors such as the similarity between the marks and the lack of evidence of actual confusion among consumers.¹⁶⁸ This analysis was significantly different than the Barbie cases where the Ninth Circuit did not utilize the likelihood of confusion test.¹⁶⁹ Moreover, the *Rock Star Videos* court did not weigh the public interest in receiving the expression.¹⁷⁰ The Ninth Circuit subsequently dismissed the strip club owner’s claims.¹⁷¹

These three cases created tension within the Ninth Circuit pertaining to the application of the *Rogers* test, as exemplified in its progeny. For instance, in 2013, *Brown v. Electronic Arts* explicitly rejected the likelihood of confusion test – as in *MCA Records* – but did not consider the cultural significance of the mark at issue – as in *Walking Mountain*.¹⁷² But, in 2017 in *Twentieth Century Fox Television v. Empire Distribution*, the Ninth Circuit employed the likelihood of confusion test when considering the second prong of *Rogers* and

161. *Id.*; Wright, *supra* note 80, at 207.

162. *E.S.S. Entm’t 2000 Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2003).

163. *Id.* at 1097.

164. *Id.* at 1100.

165. *Id.*

166. *Id.*

167. *Id.*

168. *Id.* at 1100–01.

169. See Wright, *supra* note 80, at 207–08.

170. *E.S.S. Entm’t 2000 Inc.*, 547 F.3d at 1100–01; see Byron, *supra* note 5, at 15–16.

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

172. *Brown v. Elec. Arts Inc.*, 724 F.3d 1235, 1242 (9th Cir. 2013).

considered whether the trademark had “attained a meaning beyond its source-identifying function.”¹⁷³

The United States Supreme Court has yet to weigh in on the tangle of trademark tests as applicable to principles of free speech in expressive works,¹⁷⁴ leaving district and circuit courts to decide which test to apply in a given case, resulting in disparate analyses.¹⁷⁵ Instead of resolving the confusion surrounding the Ninth Circuit’s application of *Rogers* and other trademark tests, *Gordon* merely adds to the uncertainty.

IV. INSTANT DECISION

In its superseding opinion, the Ninth Circuit found that Defendants’ use of Gordon’s mark was artistically relevant and left the determination of whether Defendants’ use was explicitly misleading to the jury.¹⁷⁶ The court expanded the “explicitly misleading” prong of *Rogers* to consider additional subfactors which relate to the junior user’s artistry and use.¹⁷⁷ Further, the court stated that if a jury found Defendants’ use of the mark to be explicitly misleading, the use was not infringing unless the jury also determined a likelihood of confusion existed between Defendants’ and Gordon’s use.¹⁷⁸

The *Gordon* court began its analysis by clarifying the burden of proof in a trademark infringement action under the *Rogers* test.¹⁷⁹ The court stated that the burden of proof initially lies with the defendant to make a threshold showing that “[the mark’s] allegedly infringing use is part of an expressive work protected by the First Amendment.”¹⁸⁰ If the defendant makes this threshold

173. *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1197–99 (9th Cir. 2017).

174. The most recent Supreme Court decision addressing trademark law was *Matal v. Tam*, where a rock band’s application for a trademark was denied based on a provision in the Lanham Act that prohibits the registration of a disparaging trademark. 137 S. Ct. 1744, 1751 (2017). There, the Supreme Court held that the disparagement provision in the Lanham Act violated First Amendment protections of speech. *Id.* at 1765.

175. See *Wright*, *supra* note 80, at 209; see e.g., *Roxbury Entm’t 2000, Inc. v. Penthouse Media Group, Inc.*, 669 F. Supp. 2d 1170, 1175–76 (C.D. Cal. 2009) (considering whether consumers would be misled as to the source of the defendant’s movie and not engaging in a likelihood of confusion analysis); *Rebellion, LLC v. Perez*, 732 F. Supp. 2d 883, 887–88 (N.D. Cal. 2010) (applying the likelihood of confusion test and considering the cultural significance of the mark).

176. *Gordon v. Drape Creative, Inc.* 909 F.3d 257, 271 (9th Cir. 2018).

177. *Id.* at 270.

178. *Id.* at 264–65.

179. *Id.* at 264.

180. *Id.*

showing, the burden shifts to the plaintiff,¹⁸¹ who then must meet one of *Rogers*' two prongs and also show that the defendant's use is likely to cause confusion.¹⁸²

The court quickly assessed whether Defendants met the burden of proof.¹⁸³ Noting that greeting cards are expressive works entitled to First Amendment protections, the court found that Defendants met their initial burden.¹⁸⁴ This finding shifted the burden to Gordon "to raise a triable issue of fact as to at least one of *Rogers*' two prongs."¹⁸⁵

The court first considered whether the use of Gordon's mark was artistically relevant to Defendants' greeting cards.¹⁸⁶ The court held as a matter of law that the mark was artistically relevant to the greeting cards because "the phrase is the punchline on which the cards' humor turns."¹⁸⁷ Gordon therefore failed to meet *Rogers*' first prong.¹⁸⁸

The court next addressed the second prong of *Rogers*.¹⁸⁹ The court clarified that when considering this prong the focus should be on the "nature of the junior user's behavior rather than on the impact of the use."¹⁹⁰ The court also stated that use of a mark alone may sometimes be sufficient to meet the "explicitly misleading" prong of *Rogers* if consumers would normally identify the source by use of the mark alone.¹⁹¹ This statement departs from previous Ninth Circuit precedent, such as *MCA Records* and *Rock Star Videos*, which held that use of a trademark alone is insufficient to be explicitly misleading.¹⁹² The court distinguished those cases from *Gordon*, reasoning that in *MCA Records* and *Rock Star Videos*, no consumer would have related the use of the mark alone to the trademark holder.¹⁹³ In *Gordon*, however, consumers could relate use of Gordon's mark alone to identify him as the source of the work.¹⁹⁴

The court then articulated the first new subfactor under *Rogers*' second prong: the degree to which the junior mark is used as compared to the senior mark.¹⁹⁵ The court compared *Gordon* to *MCA Records* and *Walking Mountain*, cases where the junior mark was used in completely different ways than the

181. *Id.*

182. *Id.*

183. *Id.* at 268.

184. *Id.*

185. *Id.* at 269.

186. *Id.*

187. *Id.*

188. *Id.*

189. *Id.*

190. *Id.* (quoting *Brown v. Elec. Arts Inc.*, 724 F.3d 1235, 1246–1246 (9th Cir. 2013)) (internal marks omitted).

191. *Id.* at 270.

192. *Id.*

193. *Id.*

194. *Id.*

195. *Id.*

senior mark.¹⁹⁶ The court reasoned this subfactor would prevent a junior user from alleging First Amendment protections “merely because the product being created by [the junior user] is also ‘art.’”¹⁹⁷

The second additional subfactor under the “explicitly misleading” prong of *Rogers* is “the extent to which the junior user has added his or her own expressive content to the work beyond the mark itself.”¹⁹⁸ The Ninth Circuit articulated its rationale behind adding this subfactor to the second prong of *Rogers*: “[U]sing a mark as the centerpiece of an expressive work itself, unadorned with any artistic contribution by the junior user, may reflect nothing more than an effort to induce the sale of goods or services by confusion or lessen . . . the commercial value of a competitor’s mark.”¹⁹⁹ The court found support for this proposition in previous Ninth Circuit cases, *Rock Star Videos* and *Brown*, where a junior mark was incorporated into the body of an expressive work only as a component of the larger work.²⁰⁰ Considering these cases, this new subfactor is similar to the court’s holding in its previous opinion.²⁰¹

After incorporating these new subfactors to the *Rogers* test, the court declined to declare as a matter of law that Defendants’ use of Gordon’s mark was explicitly misleading.²⁰² The Ninth Circuit pointed out that Defendants generally pasted Gordon’s mark into their greeting cards.²⁰³ Additionally, the court noted that in some of the greeting cards, Defendants used Gordon’s mark without any other text.²⁰⁴ Therefore, the court found that a triable issue of fact existed as to whether Defendants added their own expression to its greeting cards in using Gordon’s mark or merely used Gordon’s mark in the same manner as Gordon.²⁰⁵ The Ninth Circuit accordingly remanded the case.²⁰⁶

V. COMMENT

The *Rogers* test is inconsistently applied, particularly within the Ninth Circuit, as is apparent in its case law. Some courts still utilize the likelihood of confusion test; others apply one of the three categories of *Rogers* tests.²⁰⁷ The Ninth Circuit’s superseding opinion in *Gordon* falls into the quasi-*Rogers* test

196. *Id.*

197. *Id.*

198. *Id.*

199. *Id.* (quoting *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 539 (1987)).

200. *Id.*

201. *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184, 1196 (9th Cir. 2018).

202. *Gordon*, 909 F.3d at 271.

203. *Id.* at 261.

204. *Id.* at 271.

205. *Id.*

206. *Id.*

207. *See supra* Part III.

category because it adds a likelihood of confusion analysis to the *Rogers* test.²⁰⁸ The subfactors articulated by the court, however, blur the lines between the *Rogers* test and the likelihood of confusion test. Moreover, though the Ninth Circuit seemingly departed from its previous holding that required a junior user to add his own artistry to his underlying work, the court tucked this previous holding under the second prong of *Rogers* in its new opinion.

The outcome of this case raises free speech concerns. *Gordon*'s holding may result in a chilling effect on creators' freedom of expression. Junior users may refrain from creating new works out of concern for exposure to complex litigation. Additionally, *Gordon* drives the wedge deeper into the circuit split among courts that employ the *Rogers* test.²⁰⁹

A. Implications of the *Gordon* Decision

Gordon adds to the turmoil within the Ninth Circuit and further splits the circuits regarding expressive use in trademark infringement cases. This, in turn, makes trademark litigation more difficult and uncertain. In addition, the uncertainty and the cost of litigating these claims further isolates artists. The likelihood of confusion test already requires long, fact-intensive, and expensive litigation, and those problems are amplified when courts use a quasi-*Rogers* test.²¹⁰

Professor William McGeeveran argues the possibility of costly litigation discourages people from engaging in permissible activities related to trademarks that the law would otherwise allow and should encourage.²¹¹ In supporting this stance, Professor McGeeveran cites to the defendant photographer from *Walking Mountain* who revealed that his overall costs for litigating his defense exceeded two million dollars, a cost hardly affordable for artists and small businesses.²¹²

The expense of litigation combined with the uncertainty of the applicable test chills the free expression of junior users. Individuals may be less inclined to create because of the looming threat of liability. But even if an individual is not subject to liability, the cost of reaching that outcome through the judicial system is not worth the expense.²¹³ Even those who can afford to defend expressive trademark use take excessive precautions to eliminate the possibility of a dispute. For example, Google allows trademark holders to ban the use of their marks in third party advertisements and reality television producers blur

208. *Gordon*, 909 F.3d at 257.

209. See MCCARTHY, *supra* note 4, at § 31.139; Ramsey, *supra* note 68, at 386.

210. McGeeveran, *supra* note 7, at 1221.

211. See McGeeveran, *supra* note 36, at 62.

212. *Id.* This amount includes the cost for both the trademark and copyright claims raised in the suit. *Id.* at 62–63.

213. *Id.*

out unlicensed trademark logos that appear on television.²¹⁴ These extra precautions are far beyond legal requirements, yet these junior users take these unnecessary measures to avoid costly litigation.

Moreover, the *Gordon* decision blurs the lines between the second prong of *Rogers* and the likelihood of confusion test, which will further complicate litigation. The first subfactor, concerning the similarity of use between the junior and senior marks, is similar to factors considered in the likelihood of confusion test, such as the similarity between the marks and the strength of the senior mark.²¹⁵ The Ninth Circuit noted that the “explicitly misleading” prong of *Rogers* is principally a more demanding version of the likelihood of confusion test and that “a plaintiff who satisfies the ‘explicitly misleading’ portion of *Rogers* should therefore have little difficulty showing a likelihood of confusion.”²¹⁶ A likelihood of confusion analysis serves no purpose if the same factors are applied and the outcome of the likelihood of confusion test will be the same as under the *Rogers* test. Requiring an additional likelihood of confusion is therefore superfluous and will only lengthen and complicate litigation.

Issues arise with the second subfactor articulated by the *Gordon* opinion as well. This subfactor – whether the junior user added expressive content to the underlying work – reflects the Ninth Circuit’s original holding, which looked to whether the junior user added his own artistry to the underlying work.²¹⁷ The court merely used “expressive content” as a stand-in for “artistry.”²¹⁸ The difference between the two opinions is that the court slotted this inquiry into *Rogers*’ second prong instead of the first prong.²¹⁹ However, the effect remains the same because the junior user still must show that he added his own expression, which creates an added barrier to permissible free speech in expressive works.²²⁰

In his amicus curiae brief, Stanford University Professor Mark Lemley urged that Defendants’ use of HBDC and HBDGS were not source-identifying uses of Gordon’s mark and therefore, trademark law should not protect Gordon’s property right in the mark.²²¹ The original *Rogers* test distinguished between using a mark in an expressive way and using a mark to identify the source of a company’s goods or services.²²² The *Rogers* test required only

214. *Id.* at 63.

215. *S. Cal. Darts Ass’n v. Zaffina*, 762 F.3d 921, 930 (9th Cir. 2014).

216. *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 272 n.7 (9th Cir. 2018).

217. *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184, 1196 (9th Cir. 2018).

218. *Id.* at 1194–95.

219. *Id.*

220. *Gordon*, 909 F.3d at 271.

221. Brief *Amici Curiae* of 37 Intellectual Property Law Professors in Support of Appellees’ Petition for Panel Rehearing and Rehearing En Banc at 4, *Gordon v. Drape Creative, Inc.*, 909 F.3d 257 (9th Cir. 2018) (No. 16-56715).

222. *Id.* at 7.

minimal relevance to trigger First Amendment protection.²²³ This low bar allowed artists to express themselves and not feel inhibited by the possibility of a trademark infringement action. But *Gordon*'s holding raises the bar. A defendant now must add expressive content to his underlying work, a requirement that parallels the previous *Gordon* opinion.²²⁴ This requirement, Lemley urged, invades the realm of copyright law.²²⁵ Lemley argued that the overextension of trademark rights in *Gordon* could be prevented by "recognizing that Gordon has a right to use his phrase as a trademark for a line of greeting cards but not a trademark right in the [punchline] of a joke."²²⁶

Although trademark law should give reasonable notice of the standard a court will apply, courts should generally avoid a constitutional analysis of trademark law if the action can be resolved on other grounds.²²⁷ The *Rogers* test as originally articulated by the Second Circuit is not a constitutional analysis, but the test inherently incorporates First Amendment concerns by protecting trademarks used in an expressive manner.²²⁸ Constitutional decisions are known to freeze the development of law, which could negatively impact the development of the Lanham Act because the Act relies on common law standards.²²⁹ To achieve this aim, courts should interpret trademark claims narrowly and trademark defenses broadly to protect expression, meaning that some confusion may be necessary for the sake of preserving rights of expression under the First Amendment.²³⁰

The Supreme Court has noted that a little confusion may be tolerated in order to protect freedom of speech:

The common law's tolerance of a certain degree of confusion on the part of consumers followed from the very fact that . . . an originally descriptive term was selected to be used as a mark, not to mention the

223. *Rogers v. Grimaldi*, 875 F.3d 994, 999 (2d. Cir. 1989); *E.S.S. Entm't 2000 Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2003).

224. *Gordon*, 909 F.3d at 270.

225. Brief *Amici Curiae* of 37 Intellectual Property Law Professors in Support of Appellees' Petition for Panel Rehearing and Rehearing En Banc at 14, *Gordon v. Drape Creative, Inc.*, 909 F.3d 257 (9th Cir. 2018) (No. 16-56715).

226. *Id.* at 15.

227. See e.g., Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 COLUM. J.L. & ARTS 187, 188–89, 209 (2004); McGeeveran, *supra* note 7, at 1211–14; see also *Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 906 n.16 (9th Cir. 2007) (declining to rule on the First Amendment challenge after finding for defendant on other grounds).

228. *Rogers v. Grimaldi*, 875 F.3d 994, 998 (2d. Cir. 1989).

229. McGeeveran, *supra* note 7, at 12.

230. Ramsey, *supra* note 67, at 448.

undesirability of allowing anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first.²³¹

Moreover, applying trademark law to prevent otherwise permissible speech should require strong justification.²³² Strong justification is absent, however, when a mark is used within an expressive work as it has little, if any, effect on the senior mark.²³³ A minute chance of confusion should not outweigh First Amendment speech protections. The Ninth Circuit recognized this in *Rock Star Videos* – few people would have believed the strip club owner was connected with the makers of *Grand Theft Auto*.²³⁴

B. Suggestions and Recommendations

The Ninth Circuit should increase consistency in its application of the *Rogers* test. The quasi-*Rogers* test articulated in *Gordon* only adds to the confusion of the test's application in the Ninth Circuit. Adopting a strict *Rogers* test would remedy the inconsistency within the Ninth Circuit and simplify litigation for defendants who wish to defend their expressive use of trademarks.

The original *Rogers* test, as articulated by the Second Circuit, recognized that confusion was not the only concern in third party trademark use – First Amendment protections need to be addressed as well.²³⁵ Restricting use of a mark because of slight confusion infringes on the public's right to free speech and expression. If a trademark is not used to source-identify, then consumer interest in free expression should outweigh application of the Lanham Act.²³⁶ A strict *Rogers* test would allow permissible expressive speech to trump a minute risk of confusion.

Weighing the likelihood of confusion in the junior mark merely lengthens and adds expense to litigation. A strict application of *Rogers* would eliminate the likelihood of confusion analysis entirely, along with other unnecessary considerations, such as whether a defendant added his own expressive content to his work, thereby shortening litigation and removing the chilling effect on free speech. Moreover, this would provide much needed consistency in the Ninth Circuit for future infringement actions.

The application of the *Rogers* test is an issue ripe for the Supreme Court's review. If the Supreme Court were to hear a case involving this issue, it could resolve the inconsistencies across the United States. This would provide guidance to both trademark holders and junior users as to what test a court will

231. See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004) [KP Permanent I].

232. McGeeveran & McKenna *supra* note 10, at 305.

233. *Id.*

234. *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1097 (9th Cir. 2008).

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

236. McGeeveran & McKenna, *supra* note 10, at 289.

apply in trademark infringement actions. Until that time, the Ninth Circuit needs to create consistency within its own courts to protect and properly balance First Amendment and trademark rights.

VI. CONCLUSION

Gordon adds to the tangled web that is the Ninth Circuit's approach to trademark infringement and contributes to the *Rogers* test circuit split. The Ninth Circuit, though it issued a superseding opinion, stood by its controversial application of *Rogers*. The court's holding further splits circuits on the issue, which makes defending expressive trademark use a complex and expensive process for litigants. Lengthy and costly litigation will deter artists and creators from using trademarks in an otherwise permissible manner and chill this type of work. The effect of *Gordon*'s overly broad application of the *Rogers* test may endanger First Amendment free speech principles.