

**THE “ARTISTIC RELEVANCE TEST”
JUST BECAME RELEVANT:
THE INCREASING STRENGTH OF THE FIRST
AMENDMENT AS A DEFENSE TO
TRADEMARK INFRINGEMENT AND DILUTION**

*By Kerry L. Timbers and Julia Huston**

I. INTRODUCTION

In the last few years, there has been a virtual explosion of cases in which defendants selling artistic works are asserting the First Amendment as a defense to the infringement of famous trademarks. Many of these cases are making their way up to the federal courts of appeals, which are rejecting the well-established “alternative avenues” test of the 1970s and 1980s and instead adopting an “artistic relevance” test that tips the balance heavily in favor of the First Amendment. This development marks a sea change in trademark jurisprudence, as the artistic relevance test is much more favorable to accused infringers and, in many cases, all but mandates a finding of non-infringement. Trademark practitioners should be aware of this trend, and consider the implications of the First Amendment defense in addition to the more traditional defenses of fair use and nominative fair use. Obviously, a defendant need prevail on only one of these defenses in order to escape liability for trademark infringement.

Under the artistic relevance test, which was recently adopted in the Sixth and Ninth Circuits in cases involving the mark BARBIE and the names Tiger Woods and Rosa Parks, the issue is whether a defendant’s use of a name or mark in connection with an expressive work, such as a book, film, song or painting, is relevant to the content of that work. If so, the traditional likelihood of confusion analysis is put aside, and infringement will be found only if the use of the mark is “explicitly misleading.” This test arose in the famous “Ginger and Fred” case decided by the Second Circuit in 1989. The Second Circuit subsequently scaled back the high standard required to overcome the First Amendment defense set in that case, and now applies a variation of the artistic

* The authors are partners at Bromberg & Sunstein LLP in Boston, Massachusetts, Associate Member of the International Trademark Association, where they concentrate in trademark, patent and copyright law. The views expressed in this article reflect those of the authors, and not of Bromberg & Sunstein LLP or its clients. © 2003 Kerry L. Timbers and Julia Huston.

relevance test in which the court performs the traditional likelihood of confusion analysis in determining infringement—which the “Ginger and Fred” case did not do—and then decides whether the likelihood of confusion is “particularly compelling” such that it outweighs the First Amendment interests. Notwithstanding the Second Circuit’s retreat, the Sixth and Ninth Circuits recently adopted the stricter test articulated in the “Ginger and Fred” case.

The trend toward the artistic relevance test, and rejection of earlier, less First Amendment-friendly tests, is clear. The Second, Fifth, Sixth, Ninth, and Tenth Circuits have all expressly rejected the alternative avenues test, by which a defendant would be liable for trademark infringement if it could have expressed itself by other avenues which did not involve use of the plaintiff’s mark, in favor of some version of the artistic relevance test. This rejection is all the more interesting, given that the alternative avenues test is quite similar to the approach taken by the Supreme Court in the most closely analogous case, which involved the mark OLYMPIC. Because the opinions making this departure, and especially the recent opinions in the Barbie, Tiger Woods, and Rosa Parks cases, are so thoughtfully reasoned and highly publicized, it is likely that more courts will fall into line and adopt the artistic relevance test in place of the alternative avenues test of former decades.

II. FIRST AMENDMENT BACKGROUND

A. Road Closed:

“Alternative Avenues” Cases in the Appeals Courts

Prior to 1989, the First Amendment rarely made a serious appearance in trademark cases, and when it did, it rarely provided any defense to a charge of trademark infringement. One of the most famous, influential and typical of these cases is *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*,¹ in which the Dallas Cowboys Cheerleaders accused a movie theatre of infringing its trademarks by advertising and exhibiting the pornographic movie “Debbie Does Dallas,” which the Second Circuit described as a “gross and revolting sex film whose plot, to the extent that there is one, involves a cheerleader at a fictional high school.”² In the movie’s final scene, the lead character wears a uniform “strikingly similar” to that of the Dallas Cowboys Cheerleaders, and advertising for the movie features the character in this uniform with the captions “Starring Ex Dallas Cowgirl

1. 604 F.2d 200 (2d Cir. 1979).

2. *Id.* at 202.

Cheerleader Bambi Woods” and “You’ll do more than cheer for this X Dallas Cheerleader.” The statements regarding Bambi Woods and her connection to the plaintiff were false.³

Plaintiff sought and obtained a preliminary injunction prohibiting the promotion or exhibition of the movie, and the Second Circuit affirmed. After determining that plaintiff had trademark rights in the cheerleading uniform and that the district court correctly found a likelihood of confusion between the depicted uniform and the real uniform,⁴ the appeals court summarily addressed defendant’s fair use, parody and First Amendment defenses. As to fair use and parody, after noting (but not deciding) the question of whether fair use is even applicable to trademark cases,⁵ it flatly stated, without discussion of the evidence, that “defendant’s use of plaintiff’s uniform hardly qualifies as parody or any other form of fair use.”⁶

Turning to the First Amendment defense, the court employed a “property rights” type of analysis similar to the one set forth in *Lloyd Corp. v. Tanner*,⁷ a Supreme Court case involving time, place and manner restrictions on free speech under the First Amendment. The Second Circuit analogized trademark rights to the real property rights of the shopping center owner in *Lloyd* who was able to stop people from handing out leaflets on its property where other avenues for that speech existed. The court held that trademark rights, like other property rights, “need not ‘yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.’”⁸ The court

3. *Id.* at 203.

4. Whatever one may think of films of this sort and their possible tarnishing effects, the district court’s finding of likelihood of confusion is questionable: “The Dallas Cowboys Cheerleaders are in the commercial entertainment field. Their performances involve particular types of displays of feminine beauty. . . . [T]he public might readily accept the idea that plaintiff has gone into a new and related entertainment venture [sic] the production of motion pictures featuring members of the cheerleading group.” *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 467 F. Supp. 366, 377 (S.D.N.Y. 1979).

5. “Fair use,” as explained by the court, is terminology from copyright cases, and although the court did not decide the issue, it left no doubt about its hostility to importing a “fair use” doctrine into the law of trademarks. *Id.* at 205-206 & n.9. Fair use is now an accepted part of trademark law. See *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1286 (9th Cir. 2002).

6. 604 F.2d at 206. The district court decision discussed the reasons for coming to the same conclusion, which centered on the film’s lack of any humor, commentary, or even narrative or dialogue other than as “settings for the depiction of sex acts.” 467 F. Supp. at 376. One wonders whether First Amendment jurisprudence would have turned out differently if the movie had been funny.

7. 407 U.S. 551 (1972). The case concerned whether war protesters had the First Amendment right to distribute leaflets on private property (a shopping center). The Court held that they did not.

8. 604 F.2d at 206.

thus affirmed the district court's injunction prohibiting both the promotion and exhibition of the movie.

Throughout the 1970s and the 1980s, courts presented with fair use, parody or First Amendment arguments typically used this type of analysis to come to the same conclusion, enjoining, for example, use of such marks as MUTANT OF OMAHA for nuclear-protest T-shirts and mugs,⁹ PINK PANTHER PATROL as a name and clothing logo for a gay activist group,¹⁰ GARBAGE PAIL KIDS for stickers and children's products,¹¹ GENITAL ELECTRIC for clothing,¹² and ENJOY COCAINE in a logo similar to the distinctive red and white COCA-COLA logo.¹³

***B. The Supreme Court Speaks:
The GAY OLYMPICS Case***

The alternative avenues cases have company, although not a shared heritage, in the Supreme Court's decision in *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee* ("SFAA").¹⁴ Although not officially a trademark case—it construed the federal statute granting the United States Olympic Committee ("USOC") the sole right to use the term OLYMPIC¹⁵—its analysis is in line with applications of the alternative avenues analysis in trademark cases.

Defendant San Francisco Arts & Athletics ("San Francisco Arts") promoted its "Gay Olympic Games" in advertisements, and was sued by the USOC. The district court granted a request for TRO and a preliminary injunction, entered summary judgment and a permanent injunction, and was affirmed on appeal.¹⁶ The Supreme Court first determined that the Amateur Sports Act did not require any showing of likelihood of confusion and was not susceptible to typical trademark defenses. It then addressed "whether the [Act's] incidental restrictions on First Amendment freedoms are greater than necessary to further a substantial

9. *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) (mark: MUTUAL OF OMAHA).

10. *MGM-Pathe Communications Co. v. Pink Panther Patrol*, 774 F. Supp. 869 (S.D.N.Y. 1991) (mark: PINK PANTHER).

11. *Original Appalachian Artworks, Inc. v. Topps Chewing Gum*, 642 F. Supp. 1031 (N.D. Ga. 1986) (mark: CABBAGE PATCH KIDS).

12. *General Electric Co. v. Alumpa Coal Co.*, 205 U.S.P.Q. 1036 (D. Mass. 1979) (mark: GENERAL ELECTRIC).

13. *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972).

14. 483 U.S. 522 (1987).

15. Section 110 of the Amateur Sports Act, codified at 36 U.S.C. § 380.

16. 483 U.S. at 527.

government interest.”¹⁷ The court detailed evidence that defendant San Francisco Arts “sought to exploit” the value “given [to the mark] by the USOC” and the likelihood of confusion caused by that use—even though confusion was irrelevant to the statutory inquiry. The Court then simply noted that “[t]he mere fact that the [defendant] claims an expressive, as opposed to purely commercial, purpose does not give it a First Amendment right to ‘appropriate to itself the harvest of those who have sown.’ The USOC’s right to prohibit use of the word ‘Olympic’ in the promotion of athletic events is at the core of its legitimate property right.”¹⁸ Although not explicitly using the alternative avenues test, the Court’s analysis of the USOC’s “property right” is strikingly similar to the Lloyd-based “property right” cases, like Dallas Cowboys Cheerleaders, that employ the alternative avenues test, and at least one commentator believes that this Supreme Court case “suggests that expressive aspects of trademark usage” should be analyzed under the alternative avenues framework.¹⁹

III. WIDENING THE AVENUE: REJECTION OF THE ALTERNATIVE AVENUES TEST AND RESURRECTION OF THE FIRST AMENDMENT IN TRADEMARK CASES

A. Humor Wins Out: The First Circuit Moves Away from the Alternative Avenues Test in L.L. Bean

Although the alternative avenues property rights-based cases tended to dominate during the 1970s and 1980s, there were limited departures, including the First Circuit’s opinion in *L.L. Bean, Inc. v. Drake Publishers, Inc.*,²⁰ which declined to apply Dallas Cowboys Cheerleaders and its Lloyd-based property rights analogy in a parody case involving a state dilution statute. Defendant produced the pornographic magazine “High Society,” one issue of which contained a two-page “prurient parody of Bean’s famous catalog” entitled “L.L. Bean’s Back-To-School-Sex Catalog” featuring “pictures of nude models in sexually explicit positions using ‘products’ that were described in a crudely humorous

17. *Id.* at 530, 536-37.

18. *Id.* at 540-41 (citation omitted) (citing *International News Service v. Associated Press*, 284 U.S. 215, 239-40 (1918)). *International News* was the famous case involving “news” as private property while it is still “fresh.” The Supreme Court in that case analogized to “the law of trusts—that he who has fairly paid the price should have the beneficial use of the property.” 284 U.S. at 240.

19. 3 J. Gilson, *Trademark Practice and Protection*, § 11.08 at 11-340 (2002).

20. 811 F.2d 26 (1st Cir.), cert. denied, 483 U.S. 1013 (1987).

fashion.”²¹ L.L. Bean “was neither flattered nor amused,” and sued for trademark infringement, unfair competition, dilution and the like.²² The district court granted summary judgment for L.L. Bean, relying on Dallas Cowboys Cheerleaders, but the appeals court reversed. After discussing parody at length, and focusing especially on parody’s capacity to offend, the First Circuit disapproved of the district court’s reliance on Dallas Cowboys Cheerleaders and its Lloyd-based alternative avenues approach to dismiss the First Amendment defense:

We do not believe that the first amendment concerns raised here can be resolved as easily as was done in Dallas Cowboys Cheerleaders. . . . A trademark is a form of intellectual property; the Supreme Court case *Lloyd Corp. v. Tanner* . . ., relied upon by the Dallas Cowboy Cheerleaders court involved a shopping center. The first amendment issues involved in this case cannot be disposed of by equating the rights of a trademark owner with the rights of an owner of real property. . . .

. . . Trademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view. As Justice Holmes observed while sitting on the Supreme Judicial Court of Massachusetts, “When the common law developed the doctrine of trademarks and trade-names, it was not creating a property in advertisements more absolute than it would have allowed the author of *Paradise Lost*.”²³

Thus the First Circuit determined that “[i]t offends the Constitution . . . to invoke the anti-dilution statute as a basis for enjoining the noncommercial use of a trademark by a defendant engaged in a protected form of expression,”²⁴ and reversed L.L. Bean’s victory in the lower court.

Key to the appeals court’s thinking was the nature of parody as distinct from other expression. The court did not explicitly reject Dallas Cowboys Cheerleaders in its entirety, but instead focused on the difference between the “editorial or artistic parody” in the case before it, and the “unauthorized *commercial* uses of another’s trademark” involved in Dallas Cowboys Cheerleaders and other like cases.²⁵ Specifically, the court emphasized that the parody constituted only “two pages in a one-hundred page issue,” was not

21. *Id.* at 27.

22. *Id.*

23. 811 F.2d at 29 (quoting *Chadwick v. Covell*, 151 Mass. 190, 193 (1890)).

24. *Id.* at 32.

25. *Id.* (emphasis added).

featured on the outside of the magazine, and was specifically labeled “humor” and “parody”: “Drake did not use Bean’s mark to identify or promote goods or services to consumers; it never intended to market the ‘products’ displayed in the parody.”²⁶ The court further limited its holding by noting that “a parody which engenders consumer confusion would be entitled to less protection than is granted by our decision today” because such confusion “implicates the legitimate commercial and consumer protection objectives of trademark law.”²⁷

***B. An Elegant Dance:
The Second Circuit Develops
the New “Artistic Relevance” Standard
in Rogers v. Grimaldi***

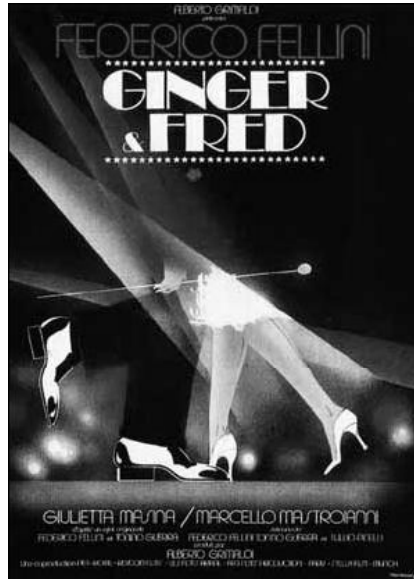
Perhaps because L.L. Bean so explicitly limited its holding to non-confusing non-commercial parodies, and made no attempt to articulate a broader rule, it did not engender a significant change in the way courts generally viewed First Amendment defenses in trademark infringement cases. Thus, throughout the 1970s and 1980s, the alternative avenues approach was the preferred one.

However, the tide began to turn in 1989 with the Second Circuit’s opinion in *Rogers v. Grimaldi*.²⁸ In this groundbreaking case, the same court responsible for the *Dallas Cowboys Cheerleaders* decision rejected the alternative avenues test and its property rights underpinning in favor of a more First Amendment-friendly analysis.

26. *Id.* at 32. These points do in fact distinguish *Dallas Cowboys Cheerleaders*, where references to the plaintiff’s trademarks were prominently used in advertisements for the film, and were in fact explicitly false, and where, at least if the court’s decision is taken at face value, there is no parody. However, if the parody analysis of L.L. Bean is applied to the facts in the *Dallas Cowboys Cheerleaders* case, it is conceivable the offending scene in the movie would be found to be a parody.

27. *Id.* at 32 n.3. Confusion was not before the L.L. Bean court, as it had been determined that the parody was not confusing.

28. 875 F.2d 994 (2d Cir. 1989).



In this case the fact pattern was far more sympathetic to First Amendment concerns than in earlier cases. Ginger Rogers sued the producers and distributors of the movie “Ginger and Fred,” directed by Federico Fellini. The movie was a fictional account of two Italian cabaret performers who imitated Ginger Rogers and Fred Astaire and became known in Italy as “Ginger and Fred.” The district court granted summary judgment for defendants on First Amendment grounds, and the appeals court affirmed.

The appeals court laid the groundwork for a new doctrine for titles of “artistic works” by noting the expressive importance of such titles and the need to give them First Amendment protection:

Movies, plays, books and songs are all indisputably works of artistic expression. . . . Poetic license, however, 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. . . .

Though First Amendment concerns do not insulate titles of artistic works from all Lanham Act claims, such concerns must nonetheless inform our consideration of the scope of the Act. . . . Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. . . . [I]nterest in freedom of artistic expression is shared by [the] audience. The subtleties of a title can enrich a reader’s or a viewer’s understanding of the work. . . . For all these reasons, the expressive element of titles requires more protection than the labeling of ordinary commercial products.

....

Because overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict.²⁹

With this critical concept established, the court next took aim at the alternative avenues test, noting its derivation from *Lloyd*, a case concerning the appropriate *location* of speech, which “is different from a restriction on the *words* the speaker may use.”³⁰ Then, in an elegant turnabout, the court cited a different Supreme Court case admittedly out of context: “We cannot indulge the facile assumption that one can forbid particular words without running a substantial risk of suppressing ideas in the process.”³¹

Determining that the alternative avenues test “does not sufficiently accommodate the public’s interest in free expression,” the court established an entirely new framework for analyzing First Amendment concerns in trademark cases involving titles of artistic works:

In the context of allegedly misleading titles using a celebrity’s name, [the] balance [between public interest in avoiding consumer confusion and public interest in free expression] will normally not support application of the [Lanham] Act unless the title has *no artistic relevance to the underlying work whatsoever*, or, if it has some artistic relevance, unless the title *explicitly misleads* as to the source or content of the work.³²

The court went on to apply the rule to exempt “Ginger and Fred” from trademark liability, finding the title artistically relevant but not explicitly misleading, and holding that although some members of the public would draw the incorrect inference that Rogers had some involvement with the film—and thus be misled—

29. *Id.* at 997-98.

30. *Id.* at 999 (emphasis in original).

31. *Id.* (quoting *Cohen v. California*, 403 U.S. 15, 26 (1971) (affirming right of war protestor to wear clothing bearing the words “Fuck the Draft” in a courthouse corridor). The court did not explicitly overrule *Dallas Cowboys Cheerleaders*, but instead distinguished it in a footnote, focusing on the fact that the *Dallas Cowboys* case involved an explicitly misleading advertisement. 875 F.2d 999 n.4. Later cases read *Rogers* as severely limiting the application of *Dallas Cowboys Cheerleaders*. See, e.g., *Parks v. LaFace Records*, 329 F.3d 437, 1743 (6th Cir. 2003) (“the Second Circuit all but retracted its decision in *Dallas Cowboys* decision in *Rogers*”). The court also all but ignored the Supreme Court’s decision in the *SFAA* case—which concerned a separate federal statute protecting the mark *OLYMPIC*—by claiming not to consider whether Congress can “bar the use of all literary titles that are to any extent misleading.” 875 F.2d at 1000 n.7.

32. 875 F.2d at 999 (emphasis added).

such confusion is “outweighed by the interests in artistic expression.”³³

In formulating its rule, the Rogers court in the main focused on *titles*, and not artistic works themselves, although the First Amendment concerns it raised applies to both.³⁴ However, the court also appeared to be suggesting that titles, apart from the artistic works, have special status in trademark law—without explicitly stating it, the court seemed to suggest that although titles can perform the “trademark” function of source identification, that function is performed differently in the case of titles than in other contexts: “Though consumers frequently look to the title of a work to determine what it is about, they do not regard titles of artistic works in the same way as the names of ordinary commercial products. . . . [M]ost consumers are well aware they cannot judge a book solely by its title any more than its cover.”³⁵ In other words, to put it in traditional trademark language, consumers are sophisticated about the titles of artistic works and not so easily misled.³⁶ The Rogers court may have thus felt comfortable tipping the balance in favor of First Amendment concerns, not only because of the intrinsic value of those concerns, but also because the opposing trademark interests *in titles* is less weighty than in other contexts.

On its face, Rogers appears to supplant the usual multi-factor likelihood of confusion analysis with a simpler, and much stricter, likelihood of confusion test, namely, “explicitly misleading.” To the extent this test is applied, it obviously does more than merely tip the balance in favor of the First Amendment—it rocks the balance almost inevitably in favor of alleged infringers so long as the title’s relevance to the work is apparent, and any confusion caused by it is not “explicitly” rooted in the title itself. Under this strict standard, confusion caused by a title’s subtle, ironic, multiple or mixed meanings is *per se* insufficient, regardless of how widespread it might be. “This mixture of meanings, with the possibly misleading meaning not the result of explicit misstatement, precludes a Lanham Act claim for false description of content in this case.”³⁷

33. *Id.* at 1001.

34. *Id.* at 999 (application to “artistic works”).

35. *Id.* at 1000.

36. Titles are in fact treated differently under trademark law. See *Herbko Int’l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 1164 (Fed. Cir. 2002) (book titles for single works are “inherently descriptive” at best and “inherently generic” at worst” and are thus not registrable absent secondary meaning).

37. *Id.*

***C. Rewriting the Manuscript:
Rogers is Both Extended and
Limited in the Second Circuit***

It is readily apparent that the Rogers analysis of First Amendment concerns is radically different from the alternative avenues analysis typically employed in prior cases, and that under Rogers, the ultimate outcome in many cases would be altered significantly in favor of alleged infringers. In the years following, the Second Circuit enthusiastically employed the Rogers analysis in a number of cases, and in doing so both extended and limited the Rogers analysis. In *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, the court extended it to all aspects of artistic works, not just titles, but appeared to cut back on the strict “explicitly misleading” standard,³⁸ and in *Twin Peaks Productions, Inc. v. Publications Int’l, Ltd.*, the court further clarified the standard of likelihood of confusion necessary to trump First Amendment concerns.³⁹

Cliffs Notes concerned “*Spy Notes*,” a humorous book that parodied the famous CLIFFS NOTES books both in its content and on its cover. The appeals court vacated the district court’s grant of a preliminary injunction against *Spy Notes*.⁴⁰ In addressing the First Amendment defense, the appeals court quickly acknowledged that Rogers presented a “very different problem” from the case at hand and that the Rogers rule was inapplicable. In Rogers, the claim was “that a title was false or at least misleading because it could be (mis)understood . . .,” whereas *Cliffs Notes* “is not about whether a title is false advertising but whether the appearance of the work’s cover is confusingly similar to the trademark elements of an earlier cover.”⁴¹

The court nonetheless found “relevant” Rogers’ “overall balancing approach” and emphasis on narrowly construing the Lanham Act when First Amendment issues are involved, and then extended Rogers beyond the scope of titles to all aspects of artistic works: “[T]he Rogers balancing approach is generally applicable to

38. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490, 495 (2d Cir. 1989) (First Amendment protected use of mark SPY NOTES for parody of CLIFFS NOTES; parody explicitly within category of “artistic works”; only “slight risk of consumer confusion”).

39. *Twin Peaks Productions, Inc. v. Publications Int’l, Ltd.*, 996 F.2d 1366 (2d Cir. 1993).

40. 886 F.2d at 492.

41. *Id.* at 494. The district court had doubted that Rogers was applicable to design or trade dress, as opposed to titles. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 718 F. Supp. 1159, 1163 (S.D.N.Y. 1989).

Lanham Act claims against works of artistic expression, a category that includes parody.”⁴²

However, immediately after extending the scope of Rogers beyond titles, the court in Cliffs Notes also reined in the severity of the Rogers “explicitly misleading” standard, stating that the Rogers confusion rule does not replace the traditional likelihood of confusion test: “This approach takes into account the ultimate test in trademark law, namely, the likelihood of confusion ‘as to the source of the goods in question,’” while “allow[ing] greater latitude for works such as parodies, in which expression, and not commercial exploitation of another’s trademark, is the primary intent, and in which there is a need to evoke the original work being parodied.”⁴³ The court ultimately determined that Spy Notes was entitled to First Amendment protection, in no small part due to its view that the district court erred in concluding there was a strong likelihood of confusion and that the Spy Notes cover was explicitly misleading.⁴⁴

Twin Peaks, a later Second Circuit case applying Rogers in the context of a book entitled “Twin Peaks,” repeated the requirement stated in Cliffs Notes that the standard likelihood of confusion analysis must be applied, again appeared to change the standard, noting that “the finding of likelihood of confusion must be *particularly compelling* to outweigh the First Amendment interest recognized in Rogers.”⁴⁵ It noted the applicability of Rogers, and that there was no question the title was artistically relevant to the underlying work, but criticized the district court for not applying the “venerable Polaroid factors.”⁴⁶ In doing so, it effectively restated, and some might say *misstated* the Rogers “explicitly misleading” test:

The question then is whether the title is *misleading in the sense it induces members of the public to believe the Book was prepared or otherwise authored by TPP*. This determination must be made, in the first instance, by application of the

42. Id. at 495.

43. Id.

44. Id. at 495-97 & n.6. The district court had applied the standard likelihood of confusion analysis, found a “very strong likelihood of confusion,” and further found that “[e]ven adopting the standard used by the Rogers Court,” the Spy Notes cover is “seriously or explicitly misleading.” 718 F. Supp. at 1168.

45. 996 F.2d at 1379 (emphasis added). Twin Peaks is primarily a case about copyright infringement, in which the producers of the famous Twin Peaks television show sued the publisher of a book containing detailed plot summaries of Twin Peaks episodes. Plaintiff also sued for trademark infringement by the book’s title, “Welcome to Twin Peaks: a Complete Guide to Who’s Who and What’s What.” The district court granted plaintiff summary judgment on its claim of trademark infringement, and rejected defendant’s First Amendment defense; the appeals court disagreed and vacated the injunction.

46. Id.

venerable Polaroid factors. However, the finding of likelihood of confusion *must be particularly compelling* to outweigh the First Amendment interest recognized in Rogers.

Unfortunately, the District Court did not apply the Polaroid factors individually or determine whether the likelihood of confusion was so great as to overcome the presumption of Rogers.⁴⁷

As is evident from this discussion, Rogers, Cliffs Notes and Twin Peaks all arguably apply different notions of likelihood of confusion. Rogers incorporates the idea of likelihood of confusion only insofar as a title “explicitly misleads as to the source or the content of the work.”⁴⁸ This “explicitly misleading” language is repeated throughout the Rogers opinion, and never does the court in Rogers discuss or mention the traditional, multi-factor likelihood of confusion analysis. Indeed, the only likelihood of confusion factor discussed was survey evidence of confusion, which the court dismissed as “not engendered by any *overt* claim in the title,” and “outweighed by the interests in artistic expression.”⁴⁹ Cliffs Notes would appear to be a scaling back of the pro-First Amendment balance struck in Rogers, or at least implementation of a more vague and pliable standard than Rogers’ strong “explicitly misleading” standard. Finally, Twin Peaks appears to move back in the direction of Rogers with its “particularly compelling” standard, while accommodating Cliffs Notes’ insistence that the standard likelihood of confusion analysis still applies.⁵⁰

***D. Proceeding Slowly:
Limited Adoption of Rogers by
Other Circuits Until 2002***

Until quite recently, Rogers was mostly a creature of the Second Circuit, without much recognition by courts of appeals in other circuits. In 1994, the Eighth Circuit in *Anheuser-Busch, Inc. v. Balducci Publications*⁵¹ appeared to apply the Cliffs Notes version of the Rogers confusion test—amounting to engaging in the standard likelihood of confusion analysis while weighing the public

47. *Id.* (emphasis added).

48. 875 F.2d at 994.

49. *Id.* at 1001 (emphasis added).

50. The distinction between the confusion standards in Rogers and Twin Peaks was explicitly noted in *No Fear, Inc. v. Imagine Films, Inc.*, 930 F. Supp. 1381, 1383 (C.D. Cal. 1995), and again in *Films of Distinction, Inc. v. Allegro Film Productions, Inc.*, 12 F. Supp. 2d 1068, 1077 (C.D. Cal. 1998). *No Fear* explicitly rejected the Rogers “explicitly misleading” test in favor of the Twin Peaks “particularly compelling” standard.

51. 28 F.3d 769 (8th Cir. 1994), cert. denied, 513 U.S. 1112 (1995).

interest in free expression—and concluding that a magazine’s parody using plaintiff’s MICHELOB trademark was not protected by the First Amendment. The court made no mention of the Rogers artistic relevance or “explicitly misleading” tests, and indeed cited Dallas Cowboys Cheerleaders repeatedly in its discussion.

In 1996, the Tenth Circuit cited the Rogers approach with approval in *Cardtoons, L.C. v. Major League Baseball Players Ass’n*.⁵² The court generally balanced the right of publicity against First Amendment concerns, and came out in favor of the latter.⁵³

In 1999 and 2000, two Fifth Circuit cases adopted the Rogers approach as modified by *Twin Peaks: Sugar Busters LLC v. Brennan*,⁵⁴ a trademark infringement case pitting two book titles against each other (one a diet book, the other a cookbook, both using the mark SUGARBUSTERS in the title), and *Westchester Media v. PRL Holdings, Inc.*⁵⁵ In *Westchester*, PRL (Polo Ralph Lauren) complained that its mark POLO was infringed by a magazine at least partially about the sport polo, entitled “Polo.” The court ultimately ruled in favor of PRL given the district court’s not clearly erroneous finding of a strong likelihood of confusion.⁵⁶ Both cases recited the “particularly compelling” standard of *Twin Peaks* rather than the “explicitly misleading” standard of *Rogers*.⁵⁷

IV. MODERN TREND TOWARD ADOPTION OF THE “ARTISTIC RELEVANCE” AND “EXPLICITLY MISLEADING” TESTS BY OTHER CIRCUITS

In 2002 and 2003, both the Rogers artistic relevance test and the “explicitly misleading” standard—its *Twin Peaks* “particularly compelling” gloss—were enthusiastically embraced by the Ninth and Sixth Circuits in three high-profile cases. Both courts explicitly rejected the Lloyd-based property rights analogy and the alternative avenues test in favor of the Rogers approach. These cases appear to bring all the circuits to address the issue into the Rogers fold, strongly upholding First Amendment rights when they conflict with trademark rights.

52. 95 F.3d 959, 971 (10th Cir. 1996).

53. *Id.* at 976. The Rogers test, incorporating as it does the notion of likelihood of confusion, is directly applicable only to claims requiring a likelihood of confusion, and thus *not* to right of publicity causes of action—indeed, in *Rogers* itself, the court relied on other grounds to dismiss plaintiff’s right of publicity claim.

54. 177 F.3d 258, 269 (5th Cir. 1999).

55. 214 F.3d 658, 665 (5th Cir. 2000).

56. *Id.* at 667-68.

57. *Sugar Busters*, 177 F.3d at 269 n.7; *Westchester*, 214 F.3d at 665-66.

***A. BARBIE Gets Into the Act:
The Ninth Circuit’s Adoption of Rogers
in Its “Pure” Form and a
Groundbreaking Analysis of the FTDA***

The Ninth Circuit decided *Mattel, Inc. v. MCA Records, Inc.* in 2002.⁵⁸ Mattel complained about a song entitled “Barbie Girl” by the not-so-famous Danish band Aqua.⁵⁹ The song “targets Barbie” as a subject for commentary:

I’m a Barbie girl, in my Barbie world
Life in plastic, it’s fantastic
You can brush my hair, undress me everywhere
.....
I’m a blonde bimbo girl, in a fantasy world
Dress me up, make it tight, I’m your dolly
You’re my doll, rock and roll, feel the glamour in pink⁶⁰

The district court granted summary judgment for the band on plaintiff’s trademark infringement claims on grounds of parody and nominative fair use, and lack of likelihood of confusion. The appeals court affirmed.



58. 296 F.3d 894 (9th Cir. 2002), cert. denied, 123 S. Ct. 993 (2003).

59. *Id.* at 901 (“Aqua is a Danish band that has, as yet, only dreamed of attaining Barbie-like [fame]”).

60. *Id.* at 909.

Launching right into the First Amendment analysis, the court immediately looked to Rogers for guidance and adopted its standard, based in no small part on the view that “Consumers expect a title to communicate a message about the book or movie, but they do not expect it to identify the publisher or producer.”⁶¹ Applying the Rogers standard, the court quickly concluded that the title has artistic relevance to the song itself and does not explicitly mislead as to the source of the work, and thus does not constitute trademark infringement.⁶²

Of note is that no mention is made of Cliffs Notes’ or Twin Peaks’ arguable reworking of the Rogers standard of infringement where artistic content is involved. Instead, the Mattel court confined its discussion to the narrow one presented in Rogers: is the title *explicitly* misleading.⁶³ Indeed, the Mattel court’s discussion of confusion shows just how difficult it is for a trademark owner to meet this “pure” Rogers standard:

The song title does not explicitly mislead as to the source of the work; it does not, explicitly or otherwise, suggest that it is produced by Mattel. The *only* indication that Mattel might be associated with the song is the use of Barbie in the title; if this were enough to satisfy this prong of the Rogers test, it would render Rogers a nullity.⁶⁴

Given this analysis, one can rightly ask whether any title that meets the artistic relevance test can ever fail to meet the “explicitly misleading test”: perhaps the question is not, “is Rogers a nullity,” but instead, “is Rogers a tautology?” In other words, this comment unwittingly points out the severity of the “explicitly misleading” standard, especially the “explicitly” part. The examples given in Rogers itself are not particularly enlightening: they suggest that one could title a work “Nimmer on Copyright” or “Jane Fonda’s Workout Book” where the titles are explicitly false—and thus be “explicitly misleading” but nonetheless be artistically relevant. We would argue that these titles, which use trademarks

61. Id. at 902. See also, id. at 901 (“We expect a title to describe the underlying work, not to identify the producer, and Barbie Girl does just that”). As noted above, this sentiment about the function of titles was hinted at, but not stated explicitly, in Rogers.

62. Id.

63. The court also makes no mention of two prominent district court cases in the Ninth Circuit, *No Fear, Inc. v. Imagine Films, Inc.*, 930 F. Supp. 1381, 1383 (C.D. Cal. 1995) and again in *Films of Distinction, Inc. v. Allegro Film Productions, Inc.*, 12 F. Supp. 2d 1068, 1077 (C.D. Cal. 1998). *No Fear* rejected the Rogers confusion standard in favor of Twin Peaks. *Films of Distinction* predicted, based on language in *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1573 (9th Cir. 1997), that the “the Ninth Circuit will not adopt the Second Circuit Rogers/Twin Peaks test.” Mattel distinguishes *Dr. Seuss* as a case where the marks were used to get attention rather than to mock. 296 F.3d at 901.

64. 296 F.3d at 902 (emphasis in original).

to describe the *source* of the works, not their *content*, are not in fact artistically relevant to the underlying work, because the sources identified are false. The other example given in Rogers, that of “The True Life Story of Ginger and Fred,” where the work was not in fact the true life story of Rogers and Astaire, concerns a title misleading of its *content*, but again, if the title is explicitly false, one wonders how it is artistically relevant.⁶⁵

Although Rogers did not involve a dilution claim, Mattel did press such a claim as well. Because the Rogers test incorporates at least some modicum of “likelihood of confusion,” it is arguably not applicable in federal anti-dilution cases, where likelihood of confusion officially plays only a subsidiary role, and certainly is not a prerequisite to a finding of dilution.⁶⁶ The court took a different route, certainly inspired by Rogers’ emphasis on the importance of First Amendment protections, to dispense with Mattel’s dilution claim.

The court determined that the First Amendment insulated the title “Barbie Girl” from liability, despite the fact that the song title was “commercial use in commerce” within the meaning of the federal dilution statute and was dilutive.⁶⁷ Specifically, the court applied the “noncommercial use” exemption contained in the Federal Trademark Dilution Act (“FTDA”),⁶⁸ which the court determined, from a review of the legislative history of the FTDA, was different from the “commercial use in commerce” requirement of the statute. The noncommercial use exemption was deemed to include all speech that is not “commercial speech” under First Amendment caselaw, or in other words, all speech that “does more than propose a commercial transaction.”⁶⁹ All such noncommercial speech—speech that “is not *purely* commercial speech”—is exempted from the FTDA, and is “entitled to full First Amendment protection.”⁷⁰ This holding is itself as groundbreaking as Rogers was, and in certain contexts could vitiate the federal dilution statute for artistic works—but not perhaps for the *promotion* of

65. This very issue is implicitly raised in *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003), discussed at length below.

66. See *id.* at 905 (“Dilution, by contrast, does not require a showing of consumer confusion,” and protects “only the distinctiveness of the mark” as opposed to avoiding harm to consumers).

67. *Id.* at 903-07.

68. 15 U.S.C. § 1125(c). The “noncommercial use” exemption is found at 15 U.S.C. § 1125(c)(4)(B). It completely exempts from the anti-dilution statute all “noncommercial use of a mark.”

69. 296 F.3d at 904-06 (citing *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184 (9th Cir. 2001) (“‘core notion of commercial speech’ is that it does no more than propose a commercial transaction”).

70. *Id.* at 906 (emphasis in original), 907.

those works.⁷¹ It remains to be seen whether this solution will gain credibility in the eyes of other courts addressing dilution claims.

***B. Rosa Parks:
The Sixth Circuit Moves to the Front of the Bus***

In 2003, the Sixth Circuit adopted the Rogers analysis in two high-profile cases: *Parks v. LaFace Records*⁷² and *ETW Corp. v. Jireh Publishing, Inc.*⁷³ In *Parks*, the rap music pair OutKast recorded “Rosa Parks,” a song containing explicit content. Although the song contained the refrain “Everybody move to the back of the bus,” the song was admittedly *not* about Rosa Parks. Rosa Parks sued, but the district court granted summary judgment for defendants on Parks’ Lanham Act and right of publicity claims. The appeals court reversed.

Analyzing First Amendment concerns, the court reviewed the alternative avenues test and the Rogers analysis, and concluded that the alternative avenues approach does not “accord[] adequate weight to the First Amendment interests in this case.”⁷⁴ The court specifically criticized the alternative avenues approach’s analogizing of “property rights in land to property rights in words or ideas,” and instead explicitly adopted the Rogers test. As in *Mattel*, the court applied the “pure” Rogers test for confusion—“explicitly misleadingly”—rather than the variations used in *Cliffs Notes* or *Twin Peaks*.⁷⁵ Application of the Rogers test to the song *Rosa Parks* led the court to determine that a fact issue regarding the title’s artistic relevance to the song barred summary judgment for defendants, although the court strongly hinted that title did *not* have artistic relevance to the song, given that it was admitted that the song was not about Rosa Parks.⁷⁶ The court also applied the

71. Although not considering the *Mattel* holding, one commentator believes the exemptions listed in § 43(c) (including the “noncommercial use” exemption of § 43(c)(4)(B)) are apparently applicable to the entirety of § 43—because the exemption makes not actionable claims “brought under this section”—and thus would be equally applicable to claims brought under § 43(a). 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 24:97 at 24-201 (4th ed. 2003). It seems unlikely *Mattel* would be applied so broadly, especially since the court based its holding on the dilution claim in part on the significant distinction between causes of action that require a showing of likelihood of confusion, such as those under § 43(a), and those that do not, such as those based on anti-dilution or right of publicity theories. See 296 F.3d at 903, 904-05.

72. 329 F.3d 437 (6th Cir. 2003).

73. 332 F.3d 915 (6th Cir. 2003).

74. 329 F.3d at 1742.

75. *Id.* at 1744.

76. *Id.* at 1742-48. Particularly noted by the court was OutKast’s admission that “We . . . never intended for the song to be about Rosa Parks or the civil rights movement. It was just symbolic, meaning that we comin’ back out, so all you other MCs move to the back of the bus.” *Id.* at 1745. Regarding whether this is a factual issue barring summary judgment,

Rogers analysis to Parks' right of publicity claim, coming to the same conclusion.⁷⁷

Parks presents an interesting problem, given Rogers' emphasis on treating titles separately from the works themselves: how tenuous can the link between the title and the work be? When is a title actually part of the work itself? In Parks, even given OutKast's admission, the defendants nonetheless arguably used the title "Rosa Parks" for primarily expressive purposes, albeit in a vague and indirect way—not to describe the lyrics of the song, but to express something *in addition* to the lyrics of the song. It seems unlikely that OutKast was using Ms. Parks' name purely for promotional purposes. Rather, one would think songs typically sell on their own merit, or by virtue of consumers' familiarity or affinity with the artist, not the name of the song.

Even if the facts of Parks do not fit this argument, certainly there will be cases where the facts do. A possible candidate is the fact pattern in *American Dairy Queen Corp. v. New Line Productions, Inc.*, decided in the federal district court in Minnesota.⁷⁸ Dairy Queen complained about the movie title "Dairy Queens" and obtained an injunction preventing release of the movie with that name (it was later released under the name "Drop Dead Gorgeous"). The film was not about the DAIRY QUEEN chain or dairy anything; it was a "mockumentary" poking fun at beauty pageants in the rural Midwest (specifically, small-town Minnesota). The court distinguished Rogers because in its view, the title "Dairy Queens" did *not* have artistic relevance, and in any event appears to have applied the principles underlying the outdated alternative avenues test in a manner that makes it clear the court missed the joke.⁷⁹ Because artistic relevance is in the eye of the beholder—the movie explicitly made fun of Minnesotans—another viewer might easily see artistic relevance in the name.⁸⁰

the Supreme Court has indicated that "[t]he inquiry into the protected status of speech is one of law, not fact." *Connick v. Myers*, 461 U.S. 138, 148 n.7 (1983). Neither of the appeals courts' decisions in Rogers nor *Mattel*, in affirming grants of summary judgment, explicitly addressed this issue, although the district court in *Mattel* cited *Connick* as authority for treating as an issue of law the question of whether "Barbie Girl" was a parody. *Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120, 1136 (C.D. Cal. 1998).

77. *Id.* at 1752.

78. 35 F. Supp. 2d 727 (D. Minn. 1998).

79. *Id.* at 734 ("It is not for this Court to name films, but it appears [defendant] has rejected ideas such as "Dairy Princesses," "Milk Maids," or any other formulation except that single title which touches ADQ's mark").

80. That the court missed the joke is evident from the alternatives it proposed. One can speculate about why the court was not amused. Perhaps the film's jokes lampooning the home state of the court were too close for comfort. Or perhaps it was the fog of nostalgia: "the Court easily recalls taking its children for 'Dairy Queens' on a warm summer's evening." *Id.* at 730.

Especially in light of Cliffs Notes' extension of Rogers beyond titles to all aspects of artistic works, it may be that the right test is not whether a title (or other aspect of the work) has "artistic relevance" directly to the underlying work, but instead whether that aspect is itself "artistic expression," as opposed to being *purely* for promotional purposes—or to use the language of Mattel in the context of "noncommercial use," whether the title is used merely to promote a commercial transaction, or does something more.

***C. Tiger Woods Joins the Play:
The Sixth Circuit Swings Again***

A month after Parks, the Sixth Circuit issued its opinion in *ETW Corp. v. Jireh Publishing, Inc.*,⁸¹ in which Tiger Woods sued over an artist's depiction of Mr. Woods' victory at the Master's Tournament in Augusta, Georgia, in a painting entitled "The Masters of Augusta." Mr. Woods' name is not on the painting, but in prints of the painting distributed by defendants, an envelope enclosing the prints had, on the back, the words "Tiger Woods," as well as a narrative description of the painting in which Mr. Woods was mentioned by name.⁸² Mr. Woods' licensing agent sued, and the district court granted defendant's motion for summary judgment and dismissed the case. The court of appeals affirmed.



81. 332 F.3d 915 (6th Cir. 2003).

82. *Id.* at 918-19.

The appeals court agreed with the district court that the use of Mr. Woods' name was descriptive fair use. Turning to the depiction of Mr. Woods in the painting itself, the court addressed the First Amendment defense to Mr. Woods' claims of Lanham Act unfair competition and false endorsement, and state law right of privacy. The court again reviewed the Rogers analysis and reaffirmed the Ninth Circuit's adoption of the Rogers test and rejection of the alternative avenues test.⁸³ The court also noted that the Second Circuit had "held that the Rogers test is not limited to literary titles but is generally applicable to Lanham Act claims against works of artistic expression."⁸⁴ The court also followed *Cardtoons*⁸⁵ in applying the First Amendment defense to the right of publicity claim, and its analysis of both the Lanham Act claims and the right of privacy claim predictably led to a holding in favor of the defendant artist.⁸⁶

D. Special Reproduction: The Princess Diana Case

The ETW case is fairly straightforward in its application of Rogers. It is also remarkably similar to a Ninth Circuit case that does *not* apply Rogers or *any* First Amendment analysis: *Cairns v. Franklin Mint Co.*⁸⁷ In this 2002 Ninth Circuit case, trustees of the Diana, Princess of Wales Memorial Fund and executors of her estate sued the Franklin Mint, which sold various collectibles—jewelry, plates and dolls—bearing the likeness of the Princess. As in the Tiger Woods case, plaintiffs complained that defendant used a celebrity likeness in an infringing manner. Rather than applying Rogers or its progeny, as it had in Mattel only months before, the Ninth Circuit applied the nominative fair use test of *New Kids on the Block v. News Am. Publ., Inc.*,⁸⁸ in which a defense is established upon a showing that the product at issue is not readily identifiable without use of the trademark, that only so much of the mark as necessary is used, and the user does nothing to suggest the trademark owner's sponsorship or endorsement.⁸⁹ Applying this test, the court determined the defense should prevail.

83. *Id.* at 926-27.

84. *Id.* at 927 (citing *Cliff Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc.*, 886 F.2d 490, 495 (2d Cir. 1989)).

85. *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996), discussed above.

86. 332 F.3d at 936.

87. 292 F.3d 1139 (9th Cir. 2002).

88. 971 F.2d 302 (9th Cir. 1992).

89. 292 F.3d at 1286.

It is likely that if the tests applied in *ETW* and *Cairns* were switched, the courts would have reached the same result—the fact patterns are strikingly similar. There is little doubt that the depictions of Princess Diana in *Cairns* were artistically relevant to the doll being sold, or that the depiction was not explicitly misleading. There is also little doubt that, to the extent the painting of Tiger Woods in *ETW* used a trademark or other device (Mr. Woods’ likeness), it did so in a manner completely necessary to the expression involved, and in a way that lacked any suggestion of endorsement by Mr. Woods.

The similarity of these cases does not end with the facts—*ETW* and *Cairns* also show the similarity of the artistic relevance/explicitly misleading test of *Rogers* and the nominative fair use test of *New Kids*. Both require a court to find a “need” to use the mark, although this requirement is stricter in the *New Kids* formulation than in *Rogers*. However, in neither case must the “need” be so strong as to require a showing that no other “avenue” exists for saying the same thing. As the Ninth Circuit articulated in *Cairns*, one might explain the content of the Princess Diana in narrative form—dressed in the stylish light-blue suit she wore when presented with her signature flower—but “it is far simpler (and more likely to be understood) to juxtapose . . . a picture of the doll and a photograph of Princess Diana wearing the same suit and carrying the same purse and the same bunch of flowers.”⁹⁰ This fair use formulation is just the kind of rationale used by *Rogers* to reject the alternative avenues test as too restrictive of speech.

Another similarity of approach is the “no suggestion of endorsement” requirement of *New Kids* and the “explicitly misleading” test of *Rogers*—although the *New Kids* formulation is arguably closer to the *Twin Peaks* reworking of *Rogers* than it is to the original *Rogers* test. Both approaches try to distinguish between expression that is fair and necessary—and linked to the underlying work—and use of a trademark solely to get attention and trade on the goodwill of the trademark for commercial gain. While overlap between these two tests, or the fact patterns to which they would apply, is not complete, there is no denying that courts grappling with the right to use others’ trademarks in works of artistic expression are attempting, whether consciously or not, to reconcile trademark rights and artistic rights in a way that seems both fair and consistent with the underlying function of trademarks and artistic expression in our society.

90. *Id.* at 1289.

V. CONCLUSION

In recent years, the First Amendment pendulum has clearly swung away from the rights of trademark owners and toward defendants accused of infringing famous marks in connection with expressive, creative works. The “old” alternative avenues test almost always favored the trademark owner, and the newly invigorated artistic relevance test typically favors the defendant. Whether this trend is good or bad depends of course on one’s point of view.

As a policy matter, it seems that a defendant who uses a plaintiff’s mark in connection with the criticism or identification of the mark’s owner, the mark itself, or the values that the mark represents—such as Aqua’s tongue-in-cheek commentary on the “plastic” way of life in the *BARBIE* case—should not give rise to liability provided that the defendant does not thereby create a perception of sponsorship or endorsement. First Amendment concerns are given wide deference in our jurisprudence, and with good reason. On the other hand, it is possible to protect First Amendment interests without entirely throwing out the likelihood of confusion principles which are the very bedrock of our system of trademark laws. After all, a true parodist does not intend to create a likelihood of confusion, because the very nature of the parody is to distinguish itself from the parodied subject matter and present a different, and usually opposing, point of view. Dilution and right of publicity claims are more problematic, as they are not reined in by the doctrine of likelihood of confusion, and it seems correct that courts more quickly apply the First Amendment to protect expressive works from these potentially overbroad types of claims.

It will be interesting to see how many courts will follow the Sixth and Ninth Circuits in adopting the “purer” and more radical version of the artistic relevance test, in which likelihood of confusion is apparently supplanted with an “explicitly misleading” standard, and how many will take the more moderate approach of the Second and Fifth Circuits, in which any likelihood of confusion is balanced against First Amendment interests under a “particularly compelling” standard. It seems likely that other circuits, including the Sixth and Ninth Circuits, will gravitate toward the more moderate and flexible “particularly compelling” standard developed in the Second Circuit. Regardless of which formulation of the artistic relevance test becomes more prominent, however, it is clear that the days of the plaintiff-friendly alternative avenues test are long gone—unless the Supreme Court steps up to the plate and throws a curveball. Accordingly, litigants on both sides of the question must be prepared to deal with newly strengthened First Amendment rights in the trademark context, particularly where the disputed mark is used in the title of a work or for purposes of comment, criticism, or parody.

Finally, it remains to be seen whether any court will extend First Amendment protection to marks used in titles which are themselves expressive—such as “Rosa Parks” or “Dairy Queens”—but do not strictly “relate” to or describe the artistic content of the work except in a very tenuous fashion. Although the cases addressing this issue have generally not looked favorably upon such titles, one could easily conclude that consumers would not be confused as to source or sponsorship in those circumstances. In order to find such titles “artistically relevant” to the content, courts would have to apply the artistic relevance test even more broadly than the circuit courts have done to date. This would seem to be a logical next step if the First Amendment values expressed in the recent cases are to be taken seriously—at least until the pendulum swings back again.
