

The *Rogers v. Grimaldi* Balancing Test in Lanham Act Claims

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I. Introduction

As electronic, virtual worlds have advanced to become more life-like, they have run up against the Lanham Act rights of trademark owners and celebrities whose images and likenesses have been imported into a game's creative elements, including titles, settings, players, vehicles, tools and outfitting. With a string of cases, many occurring over the last eight years, a body of case law grows, advancing an understanding of courts' balancing of First Amendment free speech rights with the protections afforded by Section 43(a) of the Lanham Act. This paper will examine the *Rogers v. Grimaldi* balancing test and its use in analyzing when, in defense to a cause of action brought under Section 43(a) of the Lanham Act, a video game developer's expressive work has enjoyed First Amendment rights to appropriate the trademark or celebrity belonging to another.

II. Background – Opposing Interests

Section 43(a): The Lanham Act's Section 43(a)(1)¹ makes an entity's use in commerce of

any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person,. . .

the basis for potential civil liability to a person likely to be damaged thereby.² When the trademark rights of another have been used in a video game's rendition, the rights holder generally has asserted under Section 43(a) that there has been a false designation of origin or misleading statement concerning sponsorship. While not always part of a celebrity's cause of action for use

¹ 15 U.S.C. § 1125(a).

² Id.

of a celebrity's name or likeness, a celebrity has at times pressed a Section 43(a) claim that the game developer falsely led its consumers to believe the celebrity sponsored, approved of or has an affiliation with the game.

The First Amendment and *Rogers v. Grimaldi*: Even before the 2011 Supreme Court case of *Brown v. Entm't Merchs. Ass'n.*,³ courts recognized that video games were protected speech under the First Amendment. In 2001, the Seventh Circuit case of *Am. Amusement Mach. Ass'n v. Kendrick*,⁴ recognized that video games were protected as "literary works" under the First Amendment.⁵ Then in *Brown*, the Supreme Court made clear:

Like the protected books, plays, and movies that preceded them, video games communicate ideas--and even social messages--through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player's interaction with the virtual world). That suffices to confer First Amendment protection. . . .

The most basic of those principles is this: "[A]s a general matter, . . . government has no power to restrict expression because of its message, its ideas, its subject matter, or its content."⁶

Accordingly, restrictions on video game developers imposed by the Lanham Act's Section 43(a) must be considered in light of First Amendment principles.

At least a decade before the rapid expansion of video game products, when courts' concerns with the intersection of trademark and electronic expressive works were instead focused on the medium of movies, the Second Circuit decided the case of *Rogers v. Grimaldi*.⁷ This case established what has become the analytical framework used to address developers' incorporation

³ 564 U.S. 786 (2011).

⁴ 244 F.3d 572 (7th Cir. 2001).

⁵ *Am. Amusement Mach. Ass'n v. Kendrick* 244 F.3d 572, 577 (7th Cir. 2001).

⁶ *Brown*, 564 U.S. at 790-791.

⁷ 875 F.2d 994 (1989).

of trademarks and, on occasion, celebrity rights, within video games. Although *Rogers* examined the narrow issue of whether use of a celebrity name in a movie title was protected under the First Amendment, its analytical test has been applied as well to use of trademarks and publicity rights in full works.

In *Rogers v. Grimaldi*, Ginger Rogers alleged that Italian film-maker Federico Fellini had, in titling the work “Ginger and Fred,” violated Section 43(a) of the Lanham Act⁸ by “creating the false impression that the film was about her or that she sponsored, endorsed, or was otherwise involved in the film.”⁹ In reality, the film was about two fictional Italian dancers, who, in their prime, imitated Ginger Rogers and Fred Astaire, becoming known to their Italian audience as “Ginger and Fred.”¹⁰ The film was meant to contrast the 1940s American elegance and class to “the gaudiness and banality of contemporary television,” which Fellini satirized.¹¹

The Court first recognized that a movie title combines a film-maker’s artistic expression and a commercial marketing function, to which consumers have the dual interest of “enjoying the results of the author’s freedom of expression” and not being misled.¹² Because of a title’s expressive component, the First Amendment warrants some deference in applying the Lanham Act.¹³ The Court explained specifically that the Lanham Act’s application was only supported if “the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, [if] the title explicitly misleads as to the source or the content of the work.”¹⁴

⁸ 15 U.S.C. § 1125(a)

⁹ *Rogers v. Grimaldi*, 875 F.2d 994, 996-997 (1989).

¹⁰ *Id.*

¹¹ *Id.* at 1001.

¹² *Id.* at 998

¹³ *Id.* at 998.

¹⁴ *Id.* at 999.

The Court pointed out that any explicit misdescription in a title would still warrant rigorous application of the Lanham Act, but that artistic titles with some ambiguity or implicitly misleading traits would be entitled to protection under the First Amendment.¹⁵ It explained that the risk of consumer confusion in the latter case was outweighed by the danger of suppressing artistically relevant, even though somewhat ambiguous, expression.¹⁶

Use of Trademarks in Video Games

E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.: The *Rogers* test began its rise in popularity in Section 43(a) video game trademark infringement claims in the 2008 decision in *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*¹⁷ That Ninth Circuit case involved, among others, claims of trademark and trade dress infringement and unfair competition under § 43(a) of the Lanham Act by the operator of a nude dancing club called the “Play Pen”¹⁸ E.S.S. alleged that Rockstar had caused consumer confusion about whether E.S.S. had endorsed or was associated with its *Grand Theft Auto* games.¹⁹ The *Grand Theft Auto* games were based in settings of “overall seediness,” and contained a cartoon-style “Pig Pen” club which mimicked the look and feel to the Play Pen, within the fictionalized seedy city of Los Santos, meant to chastise the “underbelly of Los Angeles.”²⁰ The heart of the E.S.S. complaint was that Rockstar had used Play Pen's distinctive logo and trade dress without its authorization, and had created a likelihood of confusion among consumers as to whether E.S.S. had endorsed, or was associated with, the video depiction.²¹

¹⁵ *Id.* at 1000.

¹⁶ *Id.* at 999-1001.

¹⁷ 547 F.3d 1095 (2008).

¹⁸ *E.S.S. Entm't 2000 v. Rock Star Videos*, 547 F.3d 1095, 1098 (2008).

¹⁹ *Id.*

²⁰ *Id.*, at 1097.

²¹ *Id.* at 1098.

As a threshold matter in considering Rockstar's motion for summary judgment, the Court acknowledged that the Ninth Circuit had adopted the *Rogers* test in analyzing a song title's use of another's trademark. However, this meant it had to explain the further extension of the *Rogers* test to the body of a work. It did this by referencing dicta in the Ninth Circuit case of *Mattel Inc. v. Walking Mountain Prods.*²² from which it concluded there would be "no principled reason why it ought not also apply to the use of a trademark in the body of the work."²³

In applying the first prong of the *Rogers* test to Rockstar's First Amendment defense, the Court recognized that Rockstar's artistic goal was to "develop a cartoon-style parody of East Los Angeles," including businesses and buildings that appear there.²⁴ To include a strip club similarly styled to one of the actual strip clubs meant the Play Pen had "at least 'some artistic relevance.'"²⁵ Importantly, the Court went on to say that the required level of artistic relevance is merely above zero, and that Rockstar had proven that level.²⁶

In analyzing the second prong, the Court found that no reasonable consumer would find that play involving the Pig Pen was a main selling point of the game or believe that E.S.S., a strip club operator, was connected with the game's production.²⁷ Accordingly, the Pig Pen strip club did not explicitly mislead consumers as to the source of the work.²⁸

Thus, with its thorough step-by-step analysis, *E.S.S.* firmly paved the way for numerous other video game developers to invoke the *Rogers* defense to a Section 43(a) claim. *E.S.S.* confirmed that *Rogers* was the appropriate analysis where a body of work, not just the title,

²² 353 F.3d 792 (2003).

²³ *E.S.S. Entm't 2000*, 547 F.3d at 1099 (citations omitted).

²⁴ *Id.* at 1100.

²⁵ *Id.* (citations omitted).

²⁶ *Id.* at 1100.

²⁷ *Id.* at 1100-1101.

²⁸ *Id.* at 1100.

involved the trademark of another. Additionally, it established the low artistic relevance-bar, specifically acknowledging relevance where a trademark depiction is used to portray the “look and feel” of the game’s setting.

Dillinger, LLC v. Elec. Arts Inc.: Roughly three years later, in the 2011 Seventh Circuit case of *Dillinger, LLC v. Elec. Arts Inc.*,²⁹ the District Court for the Southern District of Indiana found that Electronic Arts (“EA”) was entitled to use the names “Dillinger Tommy Gun” and “Modern Dillinger Tommy Gun” in its *Godfather* and *Godfather II* video games. This was over the objections of the Dillinger name trademark owner, despite the lack of any direct connection between John Dillinger and the *Godfather* stories.³⁰ As background, Plaintiff Dillinger LLC owned both the publicity rights and the trademark rights in the words “John Dillinger,” however its right of publicity claims had been dismissed in a prior proceeding’s motion for judgment on the pleadings.³¹ Because the prior proceeding left intact Dillinger’s Section 43(a) cause of action,³² it was addressed by the District Court here on a motion for summary judgment.

As a threshold matter, the District Court acknowledged that the Seventh Circuit treated video games as literary works entitled to First Amendment protection, then moved on to analyze the matter under the *Rogers* test.³³ Weighing the first prong of the *Rogers* test, the District Court found that even though Dillinger lived prior to the time in history and in a different location of the

²⁹ 101 U.S.P.Q.2D (BNA) 1612 (2011).

³⁰ *Id.* at 1617.

³¹ *Dillinger, LLC v. Elec. Arts Inc.*, 795 F. Supp. 2d 829 (2011).

³² EA defended its trademark use only by alleging it was a fair use because it was a non-trademark use. The Court found that EA’s use was indeed a trademark use. *Dillinger, LLC*, 795 F. Supp. 2d at 838 (2011).

³³ *Dillinger, LLC v. Elec. Arts Inc.*, 101 U.S.P.Q.2D (BNA) 1612, 1615-1616 (2011) (citing *Am. Amusement Mach. Ass’n v. Kendrick*, 244 F.3d 572, 577 (7th Cir. 2001)). Interestingly, the District Court noted that the Seventh Circuit had not yet spoken about the appropriateness of using the *Rogers* test. However, since the parties agreed it was appropriate, the District Court adopted its analysis. The District Court noted that it would have used the *Rogers* test if Brown’s right of publicity claim was before it. *Id.* at 1615-1616.

country from the setting of the *Godfather* novels and movies, his “persona as a ‘flashy gangster who dressed well, womanized, drove around in fast cars, and sprayed Tommy Guns,’ has above-zero relevance to a game whose premise enables players to act like members of the mafia and spray Tommy Guns.”³⁴ Additionally, the District Court noted that the Godfather games were loosely connected with the novels and movies from which the time period and location came.³⁵ The District Court stressed its mere above-zero threshold, noting that it was “not the role of the Court to determine how meaningful the relationship between a trademark and the content of a literary work must be.”³⁶

As to the second prong, the District Court elaborated that the plaintiff had provided no evidence of consumers being misled or of defendant making any explicit misrepresentations (which alone would have satisfied the second *Rogers* prong); and that the “Dillinger name is ‘quite incidental to the overall story of the game’ and ‘not the main selling point of the [g]ame,’”³⁷ Within this holding it recognized that the listing of “Modern Dillinger” in a press release on downloadable weapons and other items was just “one of the many weapons within a visually complex video game comprised of countless artistic elements,” and thus, insufficient to create public confusion about the endorsement of Dillinger.³⁸

Overall, *Dillinger* advanced precedential approval of loosely connected themes in placing a trademark within a video game setting. It also solidified the requirement that the use not be of a main point in the play.

³⁴ Id. at 1616-1617.

³⁵ Id. at 1617.

³⁶ Id.

³⁷ Id. at 1618-1619.

³⁸ Id. at 1619.

Elec. Arts, Inc. v. Textron Inc.: In the 2012 case of *Elec. Arts, Inc. v. Textron Inc.*,³⁹ the United States District Court for the Northern District of California denied Electronic Arts motion to dismiss Textron’s infringement counterclaims against it, finding that Electronic Arts went too far in featuring and promoting the trademarked Bell helicopters to be entitled to a *Rogers* First Amendment defense. It stated that whether the *Rogers* test applied was in dispute, but that if it did apply, the defendant in the counter claim action failed the test’s second prong.⁴⁰ At issue was whether Electronic Arts’ depiction of Bell Helicopters in its *Battlefield 3* video game, which offers the player a “realistic first-person military combat simulation that depicts weapons and vehicles used by the United States military,” including specific models of Bell helicopters, violated Section 43(a) of the Lanham Act by infringing Textron’s trademarks and trade dress and confused consumers as to Textron’s affiliation with or sponsorship of the game.⁴¹

The reasons the District Court gave for Electronic Arts’ failure to meet the second prong on its motion to dismiss included Textron’s pled allegations (1) that some of the helicopters were given particular prominence in the game, (2) that the ability for a player to interact with and fly the helicopters was a reason for consumers’ purchase, (3) that Electronic Arts had specifically advertised and promoted some of the Bell helicopters, and (4) that the trade dress and trade marks were recognizable as Textron’s.⁴² Thus, “consumer confusion as to the source, affiliation, or sponsorship of the trademarked products” was likely, despite the fact that EA had a disclaimer on its packaging.⁴³ Moreover, the District Court agreed with Textron’s allegation that “[c]onsumers of these games expect that intellectual property is used with permission and approval of the mark’s

³⁹ 103 U.S.P.Q.2D (BNA) 1984 (2012).

⁴⁰ *Elec. Arts, Inc. v. Textron Inc.*, 103 U.S.P.Q.2d (BNA) 1984, 1986 (2012).

⁴¹ *Id.* at 1895.

⁴² *Id.* at 1987.

⁴³ *Id.* at 1987-1988.

owner, particularly when a purpose of the game is to realistically simulate the use of a product associated with the mark.”⁴⁴ Finally, Electronic Arts’ conduct could be found deliberate and willful, a supporting factor to a conclusion of explicit midleading.⁴⁵ All-in-all, the District Court concluded that it was “plausible that consumers could think Textron provided expertise and knowledge to the game in order to create its realistic simulation of the actual workings of the Bell-manufactured helicopters.”⁴⁶

Because the parties settled this lawsuit, a fully litigated outcome was not available in this case.⁴⁷ However, it is a limit-setting case that puts game developers on notice that featured and advertised use of a trademarked item or a celebrity’s likeness may indeed fail to achieve a First Amendment defense under the *Rogers* test.

Rebellion Devs., Ltd. v. Stardock Entm’t, Inc.: In the application of *Rogers* to a trademark-in-title case, the Sixth Circuit’s May 2013 District Court decision in *Rebellion Devs., Ltd. v. Stardock Entm’t, Inc.*,⁴⁸ dealt with a video game known as *Sins of a Solar Empire: Rebellion*, which consumers had come to refer to simply as *Rebellion*.⁴⁹ Veteran British computer game company Rebellion Developments Limited, which owned the mark “Rebellion” “for use with, among other things, ‘entertainment and amusement machines and apparatus, namely, video games and electronic games’”⁵⁰ sued Stardock Entertainment, alleging that Stardock infringed and falsely

⁴⁴ Id.

⁴⁵ Id. at 1988.

⁴⁶ Id. at 1987. The court also addressed EA’s nominative fair use defense but concluded with little discussion that questions of law and fact existed to make a determination on the issue inappropriate in that proceeding. Id., at 1988.

⁴⁷ Sean Kane, Case Law on Trademark Use in Video Games is Evolving, Law360.com, September 9, 2013. (Law 360.com) (last visited April 28, 2016).

⁴⁸ 107 U.S.P.Q.2D (BNA) 2160 (2013)

⁴⁹ *Rebellion Devs. Ltd. V. Stardock Entm’t Inc.*, 107 U.S.P.Q.2D (BNA) 2160, 2162 (2013).

⁵⁰ Id.

designated the origin of its *Sins of a Solar Empire: Rebellion* game.⁵¹ In Stardock’s motion to dismiss, Stardock argued that its expressive use of the word “Rebellion” in the title of its video game was protected pursuant to the *Rogers* test on First Amendment grounds.⁵²

This Court was one of the first in the line of cases discussed herein to rely on the Supreme Court’s ruling in *Brown v. Entm’t Merchants Ass’n.*,⁵³ wherein the Supreme Court confirmed that video games are expressive works.⁵⁴ The District Court did not agree with Plaintiff’s argument that “Rebellion” was used as a source identifier requiring the likelihood of confusion test. The District Court confirmed that *Rogers* controlled based on the fact that video games were well recognized as expressive works and the Sixth Circuit and others had adopted the *Rogers* test, explicitly rejecting the likelihood of confusion and “alternative means” tests as failing to give sufficient weight to the public interest in freedom of expression.⁵⁵ The Court also rejected the Plaintiff’s argument that *Rogers* could not be applied because Stardock’s use of “Rebellion” was not made as a reference to Plaintiff, stating that no referential requirement was required by any part of the *Rogers* test.⁵⁶

Another important threshold matter decided as an issue of first impression in the Sixth Circuit was whether it was appropriate to apply the *Rogers* test to an early dispositive motion, especially to avoid chilling speech.⁵⁷ Plaintiff argued that it was inappropriate because to address a First Amendment defense the District Court would have to make conclusions about the work without yet having examined it.⁵⁸ In citing another Sixth Circuit case that relied on dicta to indicate

⁵¹ *Id.*

⁵² *Id.* at 2163.

⁵³ 131 S. Ct. 2729, 2733 (2011).

⁵⁴ *Rebellion Devs. Ltd.*, 107 U.S.P.Q.2D at 2163 (citations omitted).

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ *Id.* at 2164.

⁵⁸ *Id.*

that First Amendment consideration was appropriate as an affirmative defense to a Lanham Act claim, and referencing two Ninth Circuit cases, the District Court went on to conclude that as an affirmative defense, a defendant's First Amendment rights would normally be pled in an answer, properly placing it before the court.⁵⁹ In the *Rebellion* case, the District Court noted that a *Rogers* defense was not pled, but that nonetheless undisputed facts supported its finding as a matter of law. Therefore, the Court allowed the *Rogers* First Amendment defense analysis in determining whether to dismiss the action.⁶⁰

The court went on to explain that under the first prong the word "Rebellion" had some artistic relevance to Stardock's game because of the association with "rebel" factions of the civil war.⁶¹ As to the second prong, despite one YouTube user's erroneous reference to Plaintiffs as the developer of *Sins Of A Solar Empire: Rebellion*, the Sixth Circuit ruled that such confusion was not actionable without an "overt misrepresentation."⁶² Even the Defendants' intent as to confusion was irrelevant; only an overt misrepresentation to cause confusion could support failure under the second *Rogers* prong.⁶³

The advances thus made by *Rebellion* were to clarify no source identifying or referential function of the trademark use was required. Also, to avoid chilling speech, an early stage proceeding was an appropriate place at which to consider a First Amendment defense to a Lanham Act claim.

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ *Id.* at 2164, 2165.

⁶² *Id.* at 2162, 2165.

⁶³ *Id.* at 2165; *cf Elec. Arts, Inc. v. Textron Inc.*, wherein the deliberate and willful nature of Electronic Arts' conduct in specifically advertising and promoting some of the Bell helicopters was considered a relevant factor.

Novalogic, Inc. v. Activision Blizzard: The June 2013 Ninth Circuit District Court case of *Novalogic, Inc. v. Activision Blizzard*,⁶⁴ was a straight forward analysis under the *Rogers* test of whether, in its game *Call of Duty–Modern Warfare*, Activision was entitled to use the phrase “Delta Force” to describe a special force team, and to use the Modern Warfare 3 (“MW3”) Delta Force Logo as an insignia of that team⁶⁵ These items were used to evoke U.S. Army connections in Activision’s near future realistic version of “modern day soldiers involved in high risk combat operations throughout the world...”⁶⁶ Plaintiff, another game developer, and long-time producer of the *Delta Force* video game series, with trademark and design registrations for “Delta Force,” sued Activision, alleging, *inter alia*, that Activision’s use of the “Delta Force” phrase and corresponding logo within the MW3 game and its guide resulted in a false designation of origin in violation of Section 43(a) of the Lanham Act. Activision moved for summary judgment that Plaintiff’s claims were barred under the First Amendment based on the *Rogers* test.⁶⁷

One of the benefits of the decision was the District Court’s thorough discussion of the threshold issues regarding the recognition of videos as expression, and the First Amendment considerations as a result.⁶⁸ It took the opportunity to discuss *Brown v. Entm’t Merchants Ass’n.*,⁶⁹ regarding the expressive nature of videos.⁷⁰ The District Court then recognized the confused nature of legal standards on the topic, but concluded that the Ninth Circuit had clearly adopted the

⁶⁴ 41 F. Supp. 3d 885 (2013).

⁶⁵ *Novalogic, Inc. v. Activision Blizzard*, 41 F. Supp. 3d 885, 889-890 (2013).

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ *Id.* at 897-900.

⁶⁹ 131 S. Ct. 2729, 2733 (2011).

⁷⁰ *Id.* at 897-898 (Like the protected books, plays, and movies that preceded them, video games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player’s interaction with the virtual world. (*Brown v. Entm’t Merchs. Ass’n.*, 131 S. Ct. 2729, 2733 (2011)))

Rogers test to reconcile defendant’s First Amendment rights with plaintiff’s Lanham Act rights.⁷¹ It relied on *E.S.S. Entertainment 2000 v. Rock Star Videos, Inc*⁷² for the Ninth Circuit’s extension of the *Rogers* test beyond titles to trademark usage in the body of a work. Interestingly, the court cited the pre-appeal, U.S. District Court right of publicity decision in *Brown v. Electronic Arts, Inc*,⁷³ upheld on appeal as discussed below,⁷⁴ to demonstrate other Ninth Circuit use of the *Rogers* test, explaining that “‘mere use of [the plaintiff’s] likeness in the game, without more, was insufficient to make the use explicitly misleading.’”⁷⁵

On the first prong the District Court explained that Activision’s incorporation of Delta Force items helped render its video game an “authentic simulation,” adding immensely to the enjoyment users received from playing the complicated game (undoubtedly accounting for its enormous success). Thus, the District Court found artistic relevance citing that “[t]he use of the phrase ‘Delta Force’ and the MW3 Delta Force Logo give users of MW3 a sense of a particularized reality of being part of an actual elite special forces operation and serve as a means to increase specific realism of the game.”⁷⁶

On the second prong it found no explicit misleading had occurred, noting that (1) neither the phrase “Delta Force” nor the MW3 Delta Force Logo had been used in any MW3 title, or on the MW3 video game disc or packaging, and the box had clearly identified Activision as its publisher, without other references to Plaintiff or any of its other games; (2) MW3 had not made any claim that could be construed as suggesting Plaintiff’s sponsorship; and (3) Activision had

⁷¹ *Id.* at 898-899.

⁷² 547 F.3d 1095 (9th Cir. 2008).

⁷³ 2009 U.S. Dist. LEXIS 131387 (C.D. Cal. Sept. 23, 2009).

⁷⁴ *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235(2013).

⁷⁵ *Novalogic, Inc.*, 41 F. Supp. 3d at 899-900 (citations omitted).

⁷⁶ *Id.* at 900-901.

taken all steps possible to dispel confusion.⁷⁷ It acknowledged that under *Rogers*, any inadvertent risk of misleading consumers was outweighed by the danger of suppressing speech that might be somewhat ambiguous but artistically relevant.⁷⁸

Thus, this case built upon prior precedent's recognition that *de minimis* use connected to real-life portrayal would establish a *Rogers* defense, especially where affirmative steps were taken by the developer to clearly disconnect the trademark owner from any source function.

Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.: Finally, the November 2014 Ninth Circuit District Court trademark/video game case of *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*⁷⁹ made an important clarification that cultural icon status of the mark used is not required to invoke a First Amendment defense.⁸⁰ In an action including claims for trademark infringement, the District Court started by recognizing its similarity to Novalogic's suit against Activision in connection with *Call of Duty–Modern Warfare's* use of the Delta Force phrase and logo.⁸¹ The version at issue here, *Call of Duty: Ghosts (Ghosts)*, similarly had “compelling narrative and music, distinctive characters, how the players interact with the virtual environment as they complete a series of combat missions, how players can interact with other players, and how players control the fate of the characters and the world that they inhabit,” render[ing] it worthy of “as much First Amendment protection as any motion picture or any other expressive work.”⁸²

MSM's suit was based on its claim that Activision intentionally, in violation of Section 43(a) and for the purpose of trading on MSM's reputation, used the MSM's “angry monkey”

⁷⁷ *Id.* at 901-903.

⁷⁸ *Id.* at 903 (citing *Rogers v. Grimaldi*).

⁷⁹ 74 F. Supp. 3d 1134 (2014).

⁸⁰ *Mil-Spec Monkey, Inc. v. Activision Blizzard*, 74 F. Supp. 3d 1134, 1140-1141 (2014).

⁸¹ *Id.* at 1140.

⁸² *Id.*

trademark involved in its very popular morale patch design in creating a patch *Ghosts* players could choose to add to their avatars' uniforms in the multi-player game mode.⁸³ If selected, the patch would appear at various times later in the game.⁸⁴ Additionally, it appeared in a small way in a pre-release promotional trailer for the multi-player edition.⁸⁵ MSM's "angry monkey" morale patch was one among many that military personnel wore off duty to express personal identity; its loose replica was similarly used in *Ghosts*.⁸⁶

Citing *Brown v. Entertainment Merchants Association*,⁸⁷ the District Court easily found *Ghosts* to be an expressive work and then moved on to its *Rogers* analysis. It rejected MSM's claim that First Amendment protection only applied to renowned marks, noting that MSM had used an outlier decision⁸⁸ for this support, but, more importantly mis-read *Mattel, Inc. v. MCA Records, Inc.*⁸⁹ *Mattel* stated simply as to cultural icon status that the owner of such a mark was not entitled to control public discourse where the mark had taken on additional cultural meaning.⁹⁰ The District Court clarified, however, that the "angry monkey" patch indeed had significance beyond designating MSM, which was its personal identification characteristics, and thus expression. This ensured that *Ghosts'* multi-player was a protected use of the patch under the *Rogers* test, allowing the grant of Activision's motion for summary judgment on its Lanham Act trademark infringement claim.⁹¹

⁸³ Id. at 1138-1139.

⁸⁴ Id. at 1136.

⁸⁵ Id. at 1136, 1138.

⁸⁶ Id. at 1138, 1139.

⁸⁷ *Supra* note 70.

⁸⁸ *Mil-Spec Monkey, Inc.*, 74 F. Supp 3d at 1140. See *Rebelution, LLC v. Perez*, 732 F. Supp. Wd 883 (N.D. Cal. 2010).

⁸⁹ 296 F.3d 894, 900-02 (9th Cir. 2002).

⁹⁰ *Mil-Spec Monkey, Inc.*, 74 F. Supp. 3d., at 1140-1141.

⁹¹ Id., at 1142.

The District Court recognized the high protection afforded to use of a trademark in expressive speech, finding that the “angry monkey” patch, especially as set alongside the many other patches and other sophisticated features to customize player avatars, and in connection with other “real world references,” combined into a critical mass to achieve the military combat authenticity.⁹² The patch therefor had “some artistic relevance” to Activision’s goal of providing an authentic setting.⁹³ MSM’s run at irrelevance in arguing the patch was unrealistically portrayed because it was available for official uniform adornment fell short, as First Amendment protection was not based on authentic renditions of reality, merely artistic relevance.⁹⁴ The District Court found that the patch’s brief, small and non-featured appearance in pre-release promotional material for *Ghosts* did not diminish its artistic relevance to the game.⁹⁵

As to the second prong, the District Court held that MSM failed to show a material fact issue regarding whether Activision “explicitly” misled consumers.⁹⁶ Despite the actual confusion of one blogger, the District Court went on to note that the *Ghosts* packaging clearly identified its source, and that promotional display of the design was not shown to actually mislead customers.⁹⁷

Mil-Spec Monkey was thus instructive as to the absence of any requirement of either cultural icon status or a completely realistic portrayal of another’s trademark in an expressive video game.

Use of Celebrity Likeness in Video Games

Brown v. Electronic Arts, Inc.: As referenced above, the July 2013 case of *Brown v.*

⁹² *Id.*

⁹³ *Id.*

⁹⁴ *Id.* at 1142-1143; *see* *Dillinger, LLC v. Elec. Arts Inc.*, 795 F. Supp. 2d 829 (2011).

⁹⁵ *Id.* at 1138, 1143.

⁹⁶ *Id.* at 1143-1144.

⁹⁷ *Id.*

Electronic Arts, Inc.,⁹⁸ was a Ninth Circuit appellate decision that affirmed the Federal District Court's application of the *Rogers* test to a Section 43(a) claim regarding all-time great football legend Jim Brown's depiction in EA's *Madden NFL* video games.⁹⁹ Recognizing that claims under Section 43(a) generally concern consumer confusion as to affiliation or endorsement in connection with trademark or trade dress use, the Ninth Circuit cited non-video game precedent to support Section 43(a) claims in connection with a public figure's name or likeness.¹⁰⁰ Additionally, in a footnote, the Court suggested that if the state causes of action for right of publicity were involved, the analysis could be different, with a different outcome, referencing a Ninth Circuit decision of the same date in *Keller v. Elec. Arts, Inc.*¹⁰¹ The state law claims were removed from Federal court consideration when the U.S. District Court for the Central District of California declined to exercise its supplemental jurisdiction over those state law claims following dismissal of Brown's Lanham Act Claim.¹⁰² Thus, in a developing body of law primarily invoking the *Rogers* test for trademark usage in video games, Brown stands for use of the *Rogers* test in right of publicity claims under Section 43(a) alone.

Brown was one of the many historical player avatars not identified by name, but recognizable by his team affiliation, playing position, and physical and other characteristics.¹⁰³ As

⁹⁸ 724 F.3d 1235(2013).

⁹⁹ *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235(2013).

¹⁰⁰ *Id.* at 1239.

¹⁰¹ *Id.*; *see supra* note 2. *Keller v. Elec. Arts, Inc.*, 724 F.3d 1268 (2013), involved state right of publicity claims brought by college football Samuel Keller and other college football and basketball players in connection with use of their likenesses in Electronic Arts' college football and basketball video games. The state law claims of invasion of privacy and unfair and unlawful business practices brought by Brown in the same initial lawsuit were not heard by the District Court which declined to exercise supplemental jurisdiction over the stat-law claims. *Id.*, at 1240.

¹⁰² Brown did indeed filed suit in state court a right of publicity claim against Electronic Arts for knowingly and intentionally using his likeness in EA's *Madden NFL* games. *See Brown v. Electronic Arts, Inc.*, Case No. BC520019 (Sup. Ct CA, Aug. 30, 2013). That case was dismissed with prejudice when the parties settled. (EA Pays Jim Brown \$600k To Spike Publicity Rights Suit, <https://www.law360.com/articles/811983?scroll=1> (last visited May 3, 2017).

¹⁰³ *Id.* at 1240.

a historical player, Brown was not covered by any licensing agreements EA had with the NFL or the NFL Player’s Association, nor did Brown ever agree to license his likeness to EA.¹⁰⁴ Brown claimed EA was required to license his likeness, using Section 43(a) as one of the justifications.¹⁰⁵ But, applying the first prong of *Rogers*, the Court said that because the usage in EA’s video game was for the purpose of EA’s “expressive goal” in recreating realistic teams of the game, including well-known Cleveland Browns player Jim Brown, his likeness had at least some artistic relevance to EA’s work.¹⁰⁶ Specifically the court acknowledged that the artistic relevance rule was “black-and-white,” thus saving courts from engaging in an artistic analysis for the first *Rogers* prong.¹⁰⁷ In the Court’s view, this was justified given that expressive works heighten First Amendment considerations and should not be held hostage to intellectual property rights.¹⁰⁸

In moving to the second prong, the Court pointed out that this element directly addresses the purpose of trademark, which is avoiding marketplace confusion as to mistaken sponsorship.¹⁰⁹ But the inquiry was not only whether use of Brown’s likeness by EA would cause players to believe he was behind or sponsored the games, but also whether there was an “‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement’ that caused such consumer confusion.”¹¹⁰

As with other video game trademark usage cases, the Court found Brown’s survey evidence irrelevant, explaining that the law would allow some misunderstanding absent an explicitly misleading statement to preclude the Lanham Act from overriding the free speech interest.¹¹¹ Brown had attempted to introduce a survey that demonstrated that the majority of consumers

¹⁰⁴ Id.

¹⁰⁵ Id.

¹⁰⁶ Id. at 1243.

¹⁰⁷ Id. (note 4).

¹⁰⁸ Id. at 1245.

¹⁰⁹ Id. at 1245.

¹¹⁰ Id.

¹¹¹ Id. at 1245-1246.

believe trademarks can only be used in a video game with the permission of the mark owner.¹¹² The Court pointed out that the only relevant survey would be one that related “to the nature of the behavior of the identifying material’s user, not the impact of the use.”¹¹³ In a similar vein, Brown’s evidence that EA’s promotional materials referenced the game’s inclusion of fifty of NFL’s historical greats was not an explicit statement that any of those players endorsed the game.¹¹⁴ The court found that EA’s changes to certain Brown attributes lacked support for meeting the second prong of *Rogers* because those changes would actually be less likely to cause consumers to associate Brown with the game.¹¹⁵ Finally, the comments of EA about player likenesses used in the game which were made at a conference rather than to consumers could not, the Court said, “realistically be expected to confuse consumers as to Brown’s involvement.”¹¹⁶ To clarify, the Court added that if statements about inclusion of Brown’s likeness were placed on the packaging of any *Madden NFL* game, “that might satisfy the “explicitly misleading” prong, or at least raise a triable issue of fact.”¹¹⁷ If this were done, the matter would be closer to the case of *Elec. Arts, Inc. v. Textron Inc.* where the appropriated right was central to the game.

Also of importance was the Court’s explanation of the properness of the District Court’s decision to decide the First Amendment issue on EA’s motion to dismiss. Brown argued doing this required the Court to engage in improper fact finding contrary to the pleadings.¹¹⁸ But only the reasonable inferences in Brown’s favor based on the pled facts were required, allowing appropriate conclusions to be drawn thereon.¹¹⁹ In this manner, the case is similar to *Rebellion*

¹¹² Id. at 1245.

¹¹³ Id. at 1246.

¹¹⁴ Id. at 1246.

¹¹⁵ Id. at 1246-1247.

¹¹⁶ Id. at 1247.

¹¹⁷ Id.

¹¹⁸ Id. at 1247-1248.

¹¹⁹ Id. at 1248.

Devs., Ltd. v. Stardock Entm't, Inc., which permitted a Court to make reasonable inferences from the pleadings in concluding the matter on an early stage motion.

Conclusion

The message in these *Rogers*-test-based video game cases is that developers have quite a bit of leeway under Section 43(a) in using trademarks and name and likeness of celebrities to create their expressive video game offerings. Clearly video games are recognized as expressive works and the *Rogers* test has become well accepted in analyzing uses in bodies of work, and as well as titles. The *Rogers* test is appropriate to use in early dispositive motions, even where to do so requires a court to go beyond the specifics of the pleadings, including invoking judicial notice and the making of logical inferences. Additionally, it is applicable whether the use is referential or independent of the markholder's mark, including where renditions of the mark or celebrity are not exact portrayals of their real-life existence or function.

As to the first prong, the "above-zero" amount of artistic relevance gives designers a lot of leeway so that as long as a mark is not gratuitous, but has a place in the setting or story-line, this prong will be satisfied. Appropriately, this keeps courts from having to carefully analyze the artistic nature and how meaningful is the connection of an element's use, thus, keeping courts from having to act as art critics.

As to the second prong, the decisions make clear that some consumer confusion, in the absence of an overt marketing ploy to interest consumers based on the mark or celebrity's use, will not cause the use to fail First Amendment protection under *Rogers*. In keeping with this, survey evidence is generally disregarded unless it relates to overt misrepresentations. Only where a game's intent is to provide an overall realistic simulation of use of the product whose trademark

is at issue, might it be possible for the rights holder to demonstrate widespread consumer belief that use of that intellectual property equates to approval or sponsorship.