

DOES YOUR TRADEMARK HAVE RELEVANT ARTISTIC EXPRESSION? IF SO, YOUR MARK MAY HAVE GREATER FIRST AMENDMENT RIGHTS THAN YOU THINK.

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Traditionally speaking, we think of a ‘trademark’ protected under the Lanham Act as a mark used to identify and distinguish a good or service from other goods and services on the market. But what if the purported ‘trademark’ is being used to express a certain idea, statement, artistic expression, or cultural significance? The same protections do not apply. Instead, when a mark is being used for artistically relevant reasons, a higher degree of protection under the First Amendment is afforded, which means that the threshold for proving trademark infringement is somewhat higher than the ‘likelihood of confusion’ test.

RELEVANT CASE LAW

The Ninth Circuit recently decided *Twentieth Century Fox Television v. Empire Distribution, Inc.* Empire Distribution, a well-known hip-hop and rap record company, claimed that Fox’s *Empire* show and its related content, such as its music and commercial products, infringed upon the Empire Distribution trademark. Fox’s *Empire* show depicts a New York City fictional hip-hop record label named ‘Empire Enterprises.’ The music aired on the show is also sold as promotional albums.

The Court determined that Fox’s usage of the name “Empire” was protected by the First Amendment and outside of the reach of the Lanham Act. In so doing, the Court reasoned that when an allegedly infringing use is in the title or within the body of an expressive work, the *Rogers* test is first used to determine if the Lanham Act applies. Since it was determined that the Empire show was an expressive work, the *Rogers* test must first be applied before the traditional ‘likelihood of confusion’ test becomes appropriate. Under the two prong *Rogers* test, in order for a trademark infringement allegation to avoid consideration under the Lanham Act, the following must be shown: (1) the trademark or other identifying material has artistic relevance to the underlying work; and (2) the trademark does not explicitly mislead as to the source of the content of the work. If the *Rogers* test is satisfied, first amendment protections apply and the Lanham Act is not implicated.

KNOWING THE PARAMETERS OF YOUR EXPRESSIVE WORK

According to *Twentieth Century Fox*, works that are expressive in nature are recognized in the law differently from other covered work because they implicate the First Amendment right of free speech and because consumers are less likely to mistake the use of someone else’s mark in an expressive work for a sign of association, authorship or endorsement. However, the Courts have shown dedication in distinguishing between the expressive use of a mark just to spark attention and the use of a mark to express artistic relevance that goes beyond the mark itself.



Here are two fundamental questions to ask when choosing to use another's trademark for your goods or services in an artistically relevant way:

1. Does your trademark have any artistic relevance to the underlying work?

You will fail the first prong of the Rogers test if your trademark has no artistic relevance to the work. In *Twentieth Century Fox*, the Court held that the word "Empire" had meaning beyond Empire Distribution's trademark identifying it as a record company. "Empire" symbolized the geographic setting of the show taking place in New York City as well as the idea that the fictional hip-hop record company itself was an "empire".

2. Does the trademark mislead as to the source of the content of the work?

Similarly to the likelihood of confusion test, no trademark will be protected that explicitly misleads as to the source of the content of the work, no matter how artistically expressive the mark is. However, with artistically expressive works, the threshold is higher, i.e. to fail the second part of the *Rogers* test, the creator must explicitly mislead consumers. As such, these marks are afforded high protections.

Accordingly, when you are strategic – or artistic – in choosing the ways in which you use a trademark, you can afford yourself greater benefits and protection in the long run.

To read the *Rogers v. Grimaldi* case, [click here](#).

To read *Twentieth Century Fox Television v. Empire Distribution, Inc.*, [click here](#).

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