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Trademarks Weakened by the First Amendment

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Rookmin Cecilia Beepat

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“[T]he First Amendment cannot permit anyone who cries ‘artist’ to have *carte blanche* when it comes to naming and advertising his or her works, art though it may be.”

--- Judge Holschuh¹

I. INTRODUCTION

Many notorious gangsters of the twentieth century are glorified through books, parades, television, and film.² The lives of these bandits developed a gangster genre that has flourished throughout the years.³ This all makes for good business; however, it becomes problematic when a gangster’s name is federally registered as a trademark.⁴ In today’s market, we have sophisticated criminals like Martha Stewart, and allegedly heinous criminals like O.J. Simpson, who are in the public eye, and have interacted with trademark law in one facet or another.⁵ Such interesting events raise the question of whether a criminal’s name should be registered by the United States Patent and Trademark Office (“USPTO”), the amount of protection a criminal’s mark should receive; specifically, when companies use the mark in media containing product placement or inter-active purchasing options.

¹ See *Parks v. LaFace Records*, 329 F.3d 437, 447 (6th Cir. 2003) (discussing use of an artists’ name within the permissible scope of the First Amendment).

² See *Gangster Films Take Revenge on our Behalf*, MSNBC.COM (June 28, 2009, 8:31 AM), <http://today.msnbc.msn.com/id/31573508/ns/today-entertainment/t/gangster-films-take-revenge-our-behalf/#.TrHGHvQUqso> (“Images of darkly ambitious men in snazzy suits performing antisocial acts have been popular for almost as long as it has been possible to capture them on film, through good times and bad.”); Southern Arizona Transportation Museum, *Dillinger Days Commercial*, YOUTUBE (June 27, 2009), http://www.youtube.com/watch?v=2x76rqHyOd8&feature=player_embedded (local Southern Arizona “Dillinger Days” Commercial).

³ See *People & Events: The Era of Gangster Films, 1930-1935*, PBS http://www.pbs.org/wgbh/amex/dillinger/peopleevents/e_hollywood.html (last visited Nov. 11, 2012, 6:40 PM) (discussing gangster genre in film).

⁴ See *Dillinger, LLC. v. Electronic Arts, Inc.*, No. 1:09-cv-1236-JMS-DKL, 2011 U.S. Dist. LEXIS 64006, at *2 (S.D. Ind. June 16, 2011) (holding that EA was entitled to summary judgment on its First Amendment defense because Dillinger, LLC did not raise any issue of fact, regarding *Dillinger*’s relevance to the content of the *Godfather* video games); ANNE GILSON LALONDE, *Use of Dillinger for Virtual Weapons in Video Games Protected by First Amendment*, LEXISNEXIS, July 7, 2011, available at 2011 Emerging Issues 5755 (discussing the background and procedural history of *Dillinger v. EA*).

⁵ See, *The Verdict on Martha*, CNNMONEY, http://money.cnn.com/2004/03/05/news/companies/martha_verdict/ (last updated March 10, 2004: 1:51 P.M.); *Ritchie v. Simpson*, 170 F3d 1092 (D.C. Cir. 1999) (An individual filed an opposition against Orenthal James Simpson’s registration of trademarks for his name and nickname, including “O.J. Simpson,” “O.J.,” and “The Juice.”).

Generally, the use of a trademark in non-commercial media raises a First Amendment issue. A perfect example of this issue is raised in *Dillinger v. EA*.⁶ John Dillinger (“J.D.”), an infamous bank robber during the 1930’s,⁷ has descendants who frequently engage in trademark infringement litigation.⁸ Recently, Dillinger, LLC,⁹ a company formed by J.D.’s descendants, sued Electronic Arts, Inc.¹⁰ (“EA”) for trademark infringement because EA used the name *Dillinger* in its video games.¹¹ EA raised a First Amendment defense and shortly thereafter, the case was dismissed.¹²

Currently, the *Rogers v. Grimaldi*¹³ test (also known as the *artistic relevance test*) is the test predominantly used by courts to decide whether there is a valid First Amendment defense in a trademark infringement claim; however, the *alternative avenues test* and *likelihood of confusion test* are also used.¹⁴ Being the predominant test does not mean that the *artistic relevance test* provides an equitable balance between First Amendment rights and trademark rights. An analysis of existing case law indicates that courts inconsistently apply the *Rogers v.*

⁶ See *Dillinger*, 2011 U.S. Dist. LEXIS 64006, at *2.

⁷ See generally BRYAN BURROUGH, PUBLIC ENEMIES xii (The Penguin Press) (2004) (chronicling lives of famous criminals and their exploits).

⁸ See *Millions at Stake as EA Sues Bank Robber’s Relative Over Godfather Game Machine Guns*, GAMEPOLITICS.COM, <http://gamepolitics.com/2009/09/02/millions-stake-ea-sues-bank-robber039s-relative-over-godfather-game-machine-guns> (Sept. 2, 2009) (discussing EA’s filing in the Northern District Court of California seeking a declaratory judgment that would allow it to use the mark *Dillinger* in its video games).

⁹ See *Dillinger*, 2011 U.S. Dist. LEXIS 64006, at *4 (S.D. Ind. June 16, 2011) (“Plaintiff claims to own the publicity rights of the ‘late depression-era bandit’ John Dillinger, as well as the trademark rights in the words ‘John Dillinger.’”).

¹⁰ EA is a global interactive entertainment software company that was developed in 1982. The company develops, publishes, and distributes interactive software for video game systems among other devices. See EA.COM, <http://aboutus.ea.com/home.action>.

¹¹ See *Dillinger, LLC v. Electronic Arts, Inc.*, No. 1:09-cv-1236-JMS-DKL, 2011 U.S. Dist. LEXIS 64006, at *2 (S.D. Ind. June 16, 2011).

¹² See *id.*

¹³ See *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2nd Cir.1989) (holding that the Lanham Act should apply to movie titles only where the public interest in avoiding consumer confusion outweighs the public interest in free expression, unless the title has no artistic relevance, or if the title does have some artistic relevance, the title does not explicitly mislead the public.)

¹⁴ See *Elvis Presley Enterprises, Inc. v. Capece*, 141 F.3d 188, 207(5th Cir. 1998); *Mutual of Omaha, Ins. Co. v. Novak*, 836 F.2d 397, (8th Cir. 1987); LALONDE, *supra* note 4.

Grimaldi test, probably because it is unclear regarding its test; and, courts still apply other tests.¹⁵

In this note, Part II will provide biographical information on the notorious bandit J.D. and discuss *Dillinger v. EA*.¹⁶ Part III will provide a general background on trademark law topics relevant to *Dillinger v. EA*,¹⁷ including a survey of federal court decisions involving the First Amendment defense in trademark infringement claims,¹⁸ and a proposed fourth test that can clarify the confusion in existing case law.¹⁹ Lastly, Part IV of this Note concludes by declaring the need for consistency among the federal courts, which need to provide a test that combines all three tests in order to preserve First Amendment protections, trademark protections, and overall legal consistency.²⁰

II. BACKGROUND

a. John Dillinger's biographical information

In *Dillinger v. EA*, the trademark at issue was the name of the infamous J.D. The court described J.D. as a “legendary gentleman-bandit,” but, according to the FBI, J.D. was a

¹⁵ Compare, *Rogers*, 875 F.2d at 1005 (“To properly analyze this issue, the Court must therefore consider a two-part test: First, the Court must determine whether the use of the mark has any artistic relevance to the underlying work whatsoever; second, if the use of the trademark has some relevance, the Court must determine whether it explicitly misleads the public as to the source or content of the work”), with *Twin Peaks Prod. Inc. v. Publ’n Int’l, Ltd.*, 996 F.2d 1366, 1379-1380 (holding that literary titles do not violate the Lanham Act unless the title has no artistic relevance, however, if the title does have artistic relevance the title must explicitly mislead the public according to the *Polaroid* factors.), *No Fear, Inc. v. Imagine Films, Inc.*, 930 F.Supp. 1381, 1383-1384 (C.D. Cali. 1995) (analyzing *Rogers*’ first prong by determining artistic relevance and the second prong by analyzing the likelihood of confusion factors, and then weighing Plaintiff’s showing of likelihood of confusion against defendants’ First Amendment concerns), and *Cardtoons v. Major League Baseball Players Ass’n*, 95 F.3d at 959 (stating that the “no adequate alternative avenues” test does not sufficiently accommodate the public’s interest in free expression” and that “[P]roof of trademark infringement under the Lanham Act requires proof of a likelihood of confusion”), *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399-1400 (9th Cir. 1992) (“To prevail on her Lanham Act claim, White is required to show that in running the robot ad, Samsung and Deutsch created a likelihood of confusion”), and *Mutual of Omaha, Ins. Co. v. Novak*, 836 F.2d at 397 (“Mutual trademarks are a form of property, and Mutual’s rights therein need not “yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.”) (citations omitted).

¹⁶ See *infra* pp. 4.

¹⁷ See *infra* pp. 10.

¹⁸ See *infra* pp. 15.

¹⁹ See *infra* pp. 21.

²⁰ See *infra* pp. 26.

“notorious and vicious thief,” and a “lurid desperado” who evoked the gangster era.²¹ J.D. was born on June 22, 1903, in Indianapolis, Indiana.²² He was born to John Dillinger, Sr. and Mary Ellen Lancaster, and was the youngest of three children.²³ Unfortunately, J.D.’s mother, Mary Lancaster, died of a stroke when he was barely four years old.²⁴ Thereafter, his father moved the family to Mooresville, Indiana so that J.D. could stay out of trouble.²⁵

At the age of sixteen, J.D. dropped out of school, rebelling against his father’s advice, and continued to work at his job eighteen miles away from their new home.²⁶ J.D. committed his first recorded crime, car theft, in Mooresville, Indiana.²⁷ During this time, his wild behavior intensified when he began routinely drinking, fighting, and visiting prostitutes.²⁸ In 1923, for instance, J.D. stole a car to impress a girl on a date, and luckily escaped a police chase.²⁹ In 1924, J.D. tried robbing a 65-year-old Mooresville, Indiana grocer;³⁰ he was caught, convicted, and spent the next nine years in prison.³¹ Prison did nothing to rehabilitate J.D. Indeed, while

²¹ See *Dillinger, LLC v Electronic Arts, Inc.*, No. 1:09-cv-1236-JMS-DKL, 2011 U.S. Dist. LEXIS 64006, at *4 (S.D. Ind. June 16, 2011).

²² See DARY MATERA, JOHN DILLINGER: THE LIFE AND DEATH OF AMERICA’S FIRST CELEBRITY CRIMINAL, CAROLL & GRAF PUBLISHERS 10-11(2004).

²³ See *id.* at 10-12. Dillinger’s subsequent marriage gave J.D. more siblings.

²⁴ See *id.*

²⁵ See *id.* at 11.

²⁶ See MATERA, *supra* note 22, at 14.

²⁷ See MATERA, *supra* note 22, at 29.

²⁸ See MATERA, *supra* note 22, at 29.

²⁹ See MATERA, *supra* note 22, at 29.

³⁰ Allan May & Marilyn Bardsley, *John Dillinger*, TRUTV.COM, http://www.trutv.com/library/crime/gangsters_outlaws/outlaws/dillinger/2.html (last visited Nov. 25, 2012). J.D. believed that the grocer would be carrying the receipts, but he was not and the grocer fought back and accidentally discharged the gun. J.D. ran away thinking that he killed the grocer and when he reached the location where the getaway car was suppose to be he found no one there.

³¹ See MATERA, *supra* note 22, at 27-32. Dillinger actually had a long prison history. First, he went to a juvenile facility, Pendleton, which was a “bleak incarceration center.” See *id.* Pendleton was a “tan-colored stone buildings with red tile roofs, thirty-foot concrete walls, and gun towers at each of its four corners.” *Id.* Soon enough, Dillinger requested to move to an adult facility after having his parole denied. His request was later granted and J.D. was transferred to the Indiana State Penitentiary. *Id.*

incarcerated, he improved his bank robbing tactics,³² which allowed him to rob banks with impunity for so long.³³

Robbing banks was the norm for gangsters from the Great Depression Era.³⁴ For instance, in 1933, J.D. robbed numerous banks throughout the Midwest and broke out of jail twice.³⁵ Like in today's economy, many citizens blamed the banks and government for the economic turmoil they were suffering.³⁶ As a result, citizens who should have decried obvious criminal behavior frequently saw J.D. and other criminals as mythical "Robin Hood" vigilantes who were actually defeating evil government forces.³⁷

One of the greatest aids to J.D.'s crime spree was his gun of choice. During J.D.'s rise to power, John T. Thompson developed the Thompson submachine gun ("Tommy Gun") for military use.³⁸ At first, the machine gun was used as a crime-fighting tool; but, like many weapons used to fight crime, the Tommy Gun ended up in the hands of criminals. The gun was "compact, easily hidden and light enough that its tremendous firepower could be unleashed swiftly from under a coat or from the back of a speeding black sedan."³⁹ J.D.'s strong association with Tommy Guns resulted from the large amounts seized from his hideouts.⁴⁰

³² See MATERA, *supra* note 22, at 32. During Dillinger's time at the Indiana State Penitentiary he had the opportunity to learn from "criminal mentors," who were thieves, burglars, bookmakers, safecrackers, and other organized crime specialists.

³³ John Dillinger, BIOGRAPHY.COM, <http://www.biography.com/people/john-dillinger-9274804> (last visited Nov. 25, 2012).

³⁴ See PBS, *supra* note 3.

³⁵ See *Star Files: John Dillinger*, INDYSTAR.COM, <http://www.indystar.com/article/99999999/NEWS06/80519042/StarFiles-John-Dillinger> (last visited Nov. 10, 2012).

³⁶ See PBS, *supra* note 3.

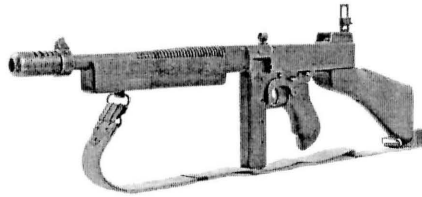
³⁷ See PBS, *supra* note 3.

³⁸ See BURROUGH, *supra* note 7.

³⁹ See BURROUGH, *supra* note 7.

⁴⁰ See *See Dillinger, LLC v Electronic Arts, Inc.*, No. 1:09-cv-1236-JMS-DKL, 2011 U.S. Dist. LEXIS 64006, at *4 (S.D. Ind. June 16, 2011); *Public Enemies Featurette*, IMDB.COM, <http://www.imdb.com/video/imdb/vi1156317721/>.

Figure 1: 1928 Tommy Gun Submachine Gun⁴¹



J.D.'s criminal career came to an end when federal agents obtained a tip that J.D. would be at a theater with his friend, Anna Sage,⁴² a brothel owner.⁴³ On July 22, 1934, J.D., who had become known as "Public Enemy No. 1" was shot in the head and chest, and killed by federal agents after leaving a theatre in Chicago.⁴⁴ Upon J.D.'s death, J. Edgar Hoover, FBI Chief expressed that he was delighted that his men succeeded in getting rid of Public Enemy No.1.⁴⁵

b. *Dillinger v. EA*

Several years after his death, J.D.'s family created Dillinger LLC.⁴⁶ The owner of Dillinger, LLC is J.D.'s half-sister's grandson; and, he claims rights to the *Dillinger* name and likeness.⁴⁷

The dispute at the heart of the *Dillinger v. EA* case resulted from EA's use of *Dillinger* in its *Godfather* and *Godfather II* video game series.⁴⁸ The *Godfather* video game used "Dillinger Tommy Gun" to name one of its fifteen weapons and *Godfather II* used "Modern Dillinger" as

⁴¹ This image displays the infamous "Tommy Gun" that Dillinger was heavily associated with. ARUNDEL MILITARIA, <http://www.deactivated-guns.co.uk/detail/1928A1-5.htm>.

⁴² See *People & Events: The Era of Gangster Films, 1930-1935*, PBS, http://www.pbs.org/wgbh/amex/dillinger/peopleevents/e_betrayal.html (last visited Nov. 26, 2012). The FBI promised Anna Sage that she would not be deported if she helped them catch J.D.. The FBI ultimately reneged on its promise and deported Sage to Romania.

⁴³ See *Dillinger Slain in Chicago; Shot Dead by Federal Men in Front of Movie Theatre*, NYTIMES.COM (July 22, 1934), <http://www.nytimes.com/learning/general/onthisday/big/0722.html?scp=1&sq=john%20dillinger&st=cse#article; John Dillinger, BIOGRAPHY.COM>, <http://www.biography.com/people/john-dillinger-9274804> (last visited Jan. 29, 2012, 2:30 PM).

⁴⁴ See NYTIMES.COM, *supra*, note 43.

⁴⁵ See NYTIMES.COM, *supra*, note 43.

⁴⁶ See LALONDE, *supra* note 4.

⁴⁷ See LALONDE, *supra* note 4.

⁴⁸ See LALONDE, *supra* note 4.

part of its downloadable “Level 4 Weapons Bundle.”⁴⁹ EA claimed that Dillinger LLC had previously threatened legal action if the publisher did not agree to pay millions of dollars for using *Dillinger* in its *Godfather* game.⁵⁰

Figure 2: *Godfather II* image of the Modern Dillinger⁵¹

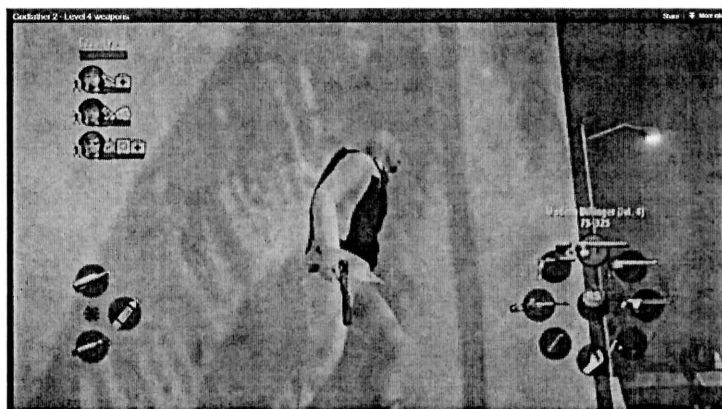
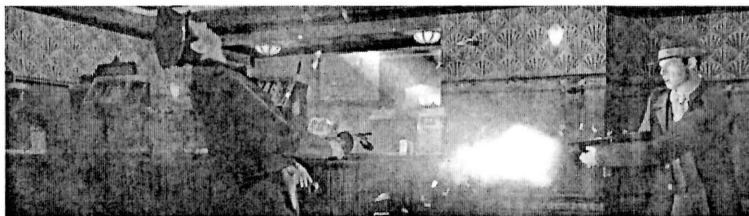


Figure 3: *Godfather* video game image of the Dillinger gun⁵²



The decision in *Dillinger v. EA*, was the court’s response to cross motions for summary judgment.⁵³ Dillinger, LLC’s Complaint initially contained six claims, but after a motion to dismiss three claims remained.⁵⁴ The remaining claims involved two trademark infringement

⁴⁹ See *Dillinger, LLC v. Electronic Arts, Inc.*, No. 1:09-cv-1236-JMS-DKL, 2011 U.S. Dist. LEXIS 64006, at *7-8 (S.D. Ind. June 16, 2011).

⁵⁰ See LALONDE, *supra* note 4.

⁵¹ TenkaQ6, *Godfather 2: Level 4 Weapons*, YOUTUBE (April 29, 2009), <http://www.youtube.com/watch?v=NDS1D2le8j0>.

⁵² *EA Victorious in Dillinger Lawsuit*, VG24/7, <http://www.vg247.com/2011/06/22/ea-victorious-in-dillinger-lawsuit/> (last updated June 22, 2011).

⁵³ See *Dillinger*, 2011 U.S. Dist. LEXIS 64006, at *2.

⁵⁴ *Dillinger, LLC v. Elec. Arts Inc.*, 795 F Supp 2d 829, 831 (S.D. Ind. 2011).

(“Count I accuses EA of violating Indiana’s right-of-publicity statute, Ind. Code §§ 32–36–1–1 *et seq.* Count II says that EA has committed unjust enrichment. Counts III and V, which the parties treat together and so will the Court,

claims, which the court and parties agreed to treat as one, and an unfair competition claim.⁵⁵ In a footnote, the court noted that the Seventh Circuit had not decided on the propriety of the *artistic relevance test*. The court applied the *artistic relevance test* because both parties agreed that it was applicable. The court stated:

“To properly analyze this issue, the Court must therefore consider a two-part test: First, the Court must determine whether the use of the mark has any artistic relevance to the underlying work whatsoever; second, if the use of the trademark has some relevance, the Court must determine whether it explicitly misleads the public as to the source or content of the work.”⁵⁶

First, the court analyzed whether artistic relevance existed and it decided that the *Godfather* video game series did have a minutia amount of relevance, which met the low threshold required by the *artistic relevance test*.⁵⁷ The court noted that according to the *artistic relevance test*, it was not the court’s job to determine the strength of the relationship between a trademark and a literary work because any connection whatsoever satisfies the test’s low artistic relevance threshold.⁵⁸

Second, the court determined whether the use in the game was *explicitly misleading*.⁵⁹ There, the court defined *explicitly misleading* as requiring defendant’s work to make some affirmative statement of plaintiff’s sponsorship or endorsement, beyond the mere use of plaintiff’s name or other characteristic.⁶⁰ Regarding this second step, the court found that Plaintiff failed to show that EA explicitly mislead consumers; thus, EA was entitled to the First Amendment’s

accuse EA of trademark infringement. Count IV alleges unfair competition. Finally, Count VI raises a claim under Indiana’s Crime Victim Act.”)

⁵⁵ *See id.*

⁵⁶ *See Dillinger*, 2011 U.S. Dist. LEXIS 64006, at *4.

⁵⁷ *See id.* at *6.

⁵⁸ *See Dillinger, LLC v Electronic Arts, Inc.*, No. 1:09-cv-1236-JMS-DKL, 2011 U.S. Dist. LEXIS 64006, at *6 (S.D. Ind. June 16, 2011).

⁵⁹ *See id.*

⁶⁰ *See id.* at *8.

protection.⁶¹ This meant that according to the court, no issue of fact existed regarding *Dillinger*'s relevance to the *Godfather* series' content and EA's use of the mark did not explicitly mislead consumers.⁶²

Unfortunately, Dillinger LLC failed in its defense because it did not argue for a test that would have resulted in a favorable outcome. Dillinger LLC conceded to using the *artistic relevance test* even though it contains an extraordinary low threshold to satisfy its artistic relevance requirement. Further, the court noted that there was commercial undertones in EA's *Godfather II* video game because "The Modern Dillinger" was a part of the "Level 4 Weapons Bundle" that required a monetary transaction. If Dillinger LLC would have used either the *likelihood of confusion test* or the *alternative avenues test* it would have had a better chance at prevailing.

III. ANALYSIS

a. Trademark law as it pertains to *Dillinger v. EA*

Trademarks generally serve the purpose of identifying a product as coming from the same source.⁶³ Federal trademark law is codified in the Lanham Act.⁶⁴ The Lanham Act was enacted in 1946 with the purpose of providing incentive to register trademarks, prevent unfair competition, fraud, and needless deception.⁶⁵

Trademarks generally provide several consumer benefits, including protecting a business' good will, assuring product quality, and strengthening consumer identification regarding a

⁶¹ See *id.*

⁶² See *id.*

⁶³ See 15 U.S.C.A. § 1127 (West 2006), SIEGRUN D. KANE, WHAT IS A TRADEMARK?, TRADEMARK L.: PRAC. GUIDE §1:1.1 (2011).

⁶⁴ 15 U.S.C.A. § 1127 ("The term 'trademark' includes any word, name, symbol, or device or any combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter[.]").

⁶⁵ See S. Rep. No. 1399, 1974 U.S.C.C.A.N. 7113, 7114; 74 Am. Jur. 2d Trademarks and Tradenames § 6.

product's origin.⁶⁶ While a trademark can consist of various words and symbols, it does not necessarily have to be a brand name.⁶⁷ For instance, the overwhelming majority of individuals see the Coca-Cola logo and its curvy bottle shape and probably identify the Coca-Cola brand, which of course is a Coca-Cola trademark.⁶⁸

Notably, the Lanham Act provides that owners of similar and confusing marks can be held liable for trademark infringement.⁶⁹ Confusion includes uncertainty between products, and extends to confusion regarding endorsements, sponsorships, or any connection with the trademark owner.⁷⁰ Confusion is further defined to include any uncertainty before and after purchase.⁷¹

Generally, the Lanham Act is enforced by applying the *likelihood of confusion test* in trademark infringements.⁷² The federal courts all apply a different version of a multi-factor test to determine whether a likelihood of confusion exists; however, the factors are generally the same.⁷³ This Note will refer to the eight likelihood of confusion factors announced in *AMF Inc.*

⁶⁶ See *Scandia Down Corp v. Euroquilty, Inc.* 772 F.2d 1423, 1429 (7th Cir. 1985) (“[T]he lower the costs of search the more competitive the market. A trademark also may induce the supplier of goods to make higher quality products and to adhere to a consistent level of quality.”)

⁶⁷ Kane, *supra* note 63 (“While a brand name is always a trademark, a trademark is not always a brand name. Trademarks can consist of a variety of words and symbols[.]”).

⁶⁸ *Coca-Cola Co. v. Snow Crest Beverages*, 64 F. Supp. 980, 985 (D. Mass. 1946)

⁶⁹ See 15 U.S.C. § 1114 (highlighting “likelihood of confusion”); *Shakey’s Inc. v. Covalt*, 704 F.2d 426, 431 (9th Cir. 1983); SIEGRUN D. KANE, *RELATION BETWEEN TRADEMARKS AND OTHER INTELLECTUAL PROPERTY RIGHTS, TRADEMARK L.: PRAC. GUIDE* §1:1.5 (2011) (stating that unfair acts include trade name infringement where a business’ name is likely to cause confusion with an established business name).

⁷⁰ See *Shakey’s*, 704 F.2d at 431; SIEGRUN D. KANE, *CONSUMER PROTECTION: THE LIKELIHOOD OF CONFUSION STANDARD, TRADEMARK L.: PRAC. GUIDE* §1:3 (2011).

⁷¹ See KANE, *supra* note 70.

⁷² See 15 USCA § 1051 [West]; *Polaroid Corp v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (holding that plaintiff’s delay in bringing an infringement suit against defendant a similar mark in a different business barred plaintiff from bringing a claim against defendant).

⁷³ *Compare, AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979) (“In determining whether confusion between related goods is likely, the following factors are relevant: (1) the strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant’s intent in selecting the mark; and (8) likelihood of expansion of the product lines.”), with *Polaroid*, 287 F.2d at 495 (“(i) the strength of the mark, (ii) the degree of similarity between the two marks, (iii) the proximity of the products; (iv) the likelihood that the prior owner will bridge the gap, (v) actual confusion, (vi) the reciprocal of defendant’s good faith in adopting its own

v. Sleekcraft Boats.⁷⁴ Under that test, courts examine the following factors to determine whether a likelihood of confusion exists:

(1) the strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant's intent in selecting the mark; and (8) likelihood of expansion of the product lines.⁷⁵

i. Strength of a mark

Moreover, a trademark's strength can fall into one of four categories.⁷⁶ The four categories of strength are: (1) arbitrary and fanciful,⁷⁷ (2) suggestive,⁷⁸ (3) descriptive,⁷⁹ and (4) generic.⁸⁰

Courts have defined the phrase "arbitrary and fanciful" as words that have no connection with the product or service; however, courts provide the greatest protection to such marks.⁸¹ For example, KODAK is an arbitrary and fanciful mark because the word "Kodak" has nothing to do with film.⁸² Indeed, thinking of the word Kodak immediately produces the image of that particular film company, and nothing else.⁸³

Next, courts define "suggestive" marks as those that portray something about a particular

mark, (vii) the quality of defendant's product, and (viii) the sophistication of the buyers").

⁷⁴ See *Sleekcraft*, 599 F.2d at 348.

⁷⁵ See *id.*

⁷⁶ See SIEGRUN D. KANE, FACTORS TO CONSIDER IN DETERMINING LIKELY CONFUSION, Trademark L.: Prac. Guide §8:1.3 (2011).

⁷⁷ See *Kookai, S.A. v. Shabo*, 950 F.Supp 605, 607 (S.D. NY 1997) ("The Second Circuit has repeatedly held that an arbitrary or fanciful mark, such as plaintiff's mark, which does not suggest the nature of plaintiff's business, is the strongest of all marks.").

⁷⁸ See *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F.Supp. 479, 488 (S.D. NY 1968) ("A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods.").

⁷⁹ See *id.* ("A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.").

⁸⁰ See *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 445 (5th Cir. 2000) (holding "chupa" was a generic term in Spanish for lollipop so the district court's finding of a likelihood of confusion against defendant's "chupa gurts" was in error).

⁸¹ See *Eastman Kodak Co v. Photaz Imports Ltd., Inc.*, 853 F.Supp. 667, 672 (W.D.N.Y. 1993); KANE, *supra* note 76.

⁸² See *id.*

⁸³ See *id.*

product or service, like CITIBANK.⁸⁴ The word *CITI* merely suggests a “city” and *BANK* suggests the service offered; thus, the merger of the words merely suggests a local city’s bank.⁸⁵

Third, “descriptive” marks are relegated to those that immediately describe the product or service, like “frosted flakes.”⁸⁶

Fourth, “generic” is the riskiest category because it provides no protection. Generic marks are defined as the common name for the product or service.⁸⁷ For example, the trademark “Google” may someday become generic because it has grown to mean “perform an internet search;” in other words, the company name no longer serves only as the name of the company, but as a everyday term.

One of the critical issues in trademark law is trademark preservation.⁸⁸ Although one may own a registered trademark, if the holder does not take the proper precautions to protect the trademark, the strength of the mark and the protection given to it can diminish drastically.⁸⁹ The mark’s use must relate to an existing business.⁹⁰ Therefore, to protect a trademark the owner should be vigilant to carefully search and select a mark that does not have possible conflicts. The owner must use the mark publicly, properly, and continuously with the associated goods or services.⁹¹ Moreover, the mark holder should register the mark with the United States Patent and Trademark Office, and be wary of infringements by third parties.⁹²

ii. Surnames as trademarks

⁸⁴ See *Citibank, N.A. v. Citibanc Group, Inc.*, 724 F.2d 1540, 1545 (11th Cir. 1984) (“[N]o other firm, bank or otherwise, was using ‘Citibank’ as a trade name, trademark, or service mark.”).

⁸⁵ See *id.*

⁸⁶ See *id.*

⁸⁷ See *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 445 (5th Cir. 2000).

⁸⁸ See SIEGRUN D. KANE, ESTABLISHING PRIORITY, TRADEMARK L.: PRAC. GUIDE §5.1 (2011).

⁸⁹ See *id.*

⁹⁰ See *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) (noting that “the right to a particular mark grows out of its use, not its mere adoption; its function is simply to designate the goods as the product of a particular trader and not to protect his good will against the sale of another’s product as his; and it is not the subject of property except in connection with an existing business.”)

⁹¹ See *id.*

⁹² See SIEGRUN D. KANE, INSTRUCTION, TRADEMARK L.: PRAC. GUIDE §.8 (2011).

The Lanham Act provides protections based on free-speech concerns. For example, it bars registering a generic or descriptive mark, surname or geographic term.⁹³ The Lanham Act provides these protections so that it can preserve the rights of others to use needed terms and phrases.⁹⁴ A surname may only be registered on the Lanham Act's Principal Register if the owner can show a secondary meaning.⁹⁵ Additionally, if the surname belongs to a historical figure and that name is not currently used as a surname the surname will not be subject to the Lanham Act objection.⁹⁶

iii. Scandalous and immoral marks are barred

More to the point, the Lanham Act bars registration of trademarks that are immoral or scandalous.⁹⁷ The registration of a mark that is immoral or scandalous can be barred from registration but these objections must occur during the registration process.⁹⁸ The decisions on whether a mark is immoral or scandalous are very inconsistent and are based on what may seem vulgar.⁹⁹ The American population determines the standard of vulgar, therefore, old disputes do not determine current disputes.¹⁰⁰

iv. Fair use

Defendants accused of trademark infringement have several important defenses at their

⁹³ See 15 USCA § 1052 [West 2006] (“Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.”)

⁹⁴ See *id.*

⁹⁵ LOUIS ALTMAN & MALLA POLLACK, UNREGISTRABLE MARKS-SURNAMES, 4A CALLMANN ON UNFAIR COMP, § 26:37 (4th Ed. 2012).

⁹⁶ See *id.*

⁹⁷ See 15 U.S.C.A. § 1052(a) [West 2006].

⁹⁸ See TRAVIS BURCHART, Dirty, Naughty, and Four-Letter Words: Where Trademarks End and Scandalous Matter Begins, LEXISNEXIS.COM (May 24, 2011, 8:21 AM) available at <http://www.lexisnexis.com/community/copyright-trademarklaw/blogs/copyrightandtrademarklawcommunity.com>. Dillinger should have most likely been considered a slanderous or immoral mark because of Dillinger's life of crime.

⁹⁹ LOUIS ALTMAN & MALLA POLLACK, UNREGISTRABLE MARKS-IMMORAL OR SCANDALOUS MARKS, 4A CALLMANN ON UNFAIR COMP, § 26:15(4th Ed. 2012).

¹⁰⁰ See *id.*

disposal.¹⁰¹ The defense at issue in *Dillinger v. EA* is fair use, which derives from the First Amendment.¹⁰² The doctrine of fair use is supported by policies that favor the public's interest in free speech.¹⁰³ The Lanham defines fair use as:

[U]se of the name, term or device charged to be an infringement as a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin.¹⁰⁴

Fair use may be one of the more problematic defenses as it relates to intellectual property because the court must weigh First Amendment rights of free speech against the right of a trademark owner's exclusive use of a mark.¹⁰⁵ Fair use in the trademark context, requires that the mark not be used as a trademark. This distinction is not always clear.

b. Federal court decisions in First Amendment and trademark infringement cases

Generally, trademark law uses the *likelihood of confusion test* to determine whether a trademark infringement exists.¹⁰⁶ However, when there is a trademark infringement claim and a defendant raises a fair use defense, courts apply different tests.¹⁰⁷ Although, common sense

¹⁰¹ See SIEGRUN D. KANE, AFFIRMATIVE DEFENSES, TRADEMARK L.: PRAC. GUIDE §12:2 (2011). (Listing the affirmative defenses of (i) laches and acquiescence, (ii) estoppel, (iii) abandonment, (iv) fair use, (v) genericness, (vi) fraud in the procurement and maintenance of trademark registrations, (vii) unclean hands, (viii) trademark misuse, and (ix) violation of antitrust laws.)

¹⁰² See *Dillinger*, 2011 U.S. Dist. LEXIS 64006, at *2, SIEGRUN D. KANE, FAIR USE, TRADEMARK L.: PRAC. GUIDE §12:2.4(2011).

¹⁰³ See *id.*

¹⁰⁴ See 15 U.S.C.A. § 1115 (West 2006).

¹⁰⁵ See THE AMERICAN LAW INSTITUTE, DESCRIPTIVE USE (FAIR USE), RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 28 (2012).

¹⁰⁶ See 15 USCA § 1051 [West].

¹⁰⁷ Compare, *Rogers*, 875 F.2d at 1005 ("To properly analyze this issue, the Court must therefore consider a two-part test: First, the Court must determine whether the use of the mark has any artistic relevance to the underlying work whatsoever; second, if the use of the trademark has some relevance, the Court must determine whether it explicitly misleads the public as to the source or content of the work"), with *Twin Peaks Prod. Inc. v. Publ'n Int'l, Ltd.*, 996 F.2d 1366, 1379-1380 (holding that literary titles do not violate the Lanham Act unless the title has no artistic relevance, however, if the title does have artistic relevance the title must explicitly mislead the public according to the *Polaroid* factors.), *No Fear, Inc. v. Imagine Films, Inc.*, 930 F.Supp. 1381, 1383-1384 (C.D. Cal. 1995) (analyzing *Rogers*' first prong by determining artistic relevance and the second prong by analyzing the likelihood of confusion factors, and then weighing Plaintiff's showing of likelihood of confusion against defendants')

would tell us that the *likelihood of confusion test* would be the predominant test because it comes directly from the Lanham Act, it is not.¹⁰⁸ Even worse, federal courts have inconsistently analyzed whether a First Amendment defense has any validity in trademark infringement claims.¹⁰⁹ Additional discussion of this important issue follows in the next section.

i. *Artistic relevance test*

The Second Circuit decision, *Rogers v. Grimaldi*, provides the predominant test followed by several other courts, the *artistic relevance test*.¹¹⁰ In *Rogers v. Grimaldi*, the court held that the Lanham Act does not prohibit the minimal use of a celebrities' name, in the title of an artistic work, if such use does not specifically denote endorsement.¹¹¹ In *Rogers*, Ginger Rogers sued defendants for distributing a motion picture named *Ginger and Fred*.¹¹² The film concerned the story of two fictional characters that imitated Fred Astaire and plaintiff, who later became known as "Ginger and Fred."¹¹³ Among plaintiff's other claims, she alleged that the defendants violated the Lanham Act by creating a false impression that she was somehow affiliated with the film.¹¹⁴

The court believed that the Lanham Act should apply to artistic works only when avoiding consumer confusion outweighed the public's interest in free expression.¹¹⁵ The court further noted that if a title is not artistically relevant, its free expression interest was not justified

First Amendment concerns), and *Cardtoons v. Major League Baseball Players Ass'n*, 95 F.3d at 959 (stating that the "no adequate alternative avenues" test does not sufficiently accommodate the public's interest in free expression" and that "[P]roof of trademark infringement under the Lanham Act requires proof of a likelihood of confusion"), *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399-1400 (9th Cir. 1992) ("To prevail on her Lanham Act claim, White is required to show that in running the robot ad, Samsung and Deutsch created a likelihood of confusion"), and *Mutual of Omaha, Ins. Co. v. Novak*, 836 F.2d at 397 ("Mutual trademarks are a form of property, and Mutual's rights therein need not 'yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.") (citations omitted).

¹⁰⁸ See 15 USCA § 1051 [West].

¹⁰⁹ See *Parks v. LaFace Records*, 329 F.3d 437, 447 (6th Cir. 2003).

¹¹⁰ See *LALONDE*, *supra* note 3.

¹¹¹ See *Rogers v. Grimaldi*, 875 F.2d 994, 1005 (2nd Cir.1989).

¹¹² See *id.* at 996-997.

¹¹³ See *id.*

¹¹⁴ See *id.*

¹¹⁵ See *id.*

and was arguably misleading.¹¹⁶ The two prong *artistic relevance test* requires two inquiries: (1) is the use of the title minimally artistically relevant; and (2) if the title is artistically relevant does it explicitly mislead.¹¹⁷ However, the *Rogers* artistically relevant threshold is so low that almost anything qualifies as artistically relevant.¹¹⁸ Effectively, the *artistically relevant test* protects every title with the slightest artistic relevance as long as it does not explicitly mislead.¹¹⁹ For instance in this case, the court granted summary judgment in favor of Grimaldi because it found that the title *Ginger and Fred* was artistically relevant to the film because the film's title did not explicitly indicate that Ginger Rogers endorsed it in any way.¹²⁰

Following its sister circuit, the Sixth Circuit, in *Parks v. LaFace Records*, chose to use the *artistic relevance test* over using the *alternative avenues test* and the *likelihood of confusion test*.¹²¹ In *Parks v. LaFace Records*, Rosa Parks sued OutKast for using her name as the title of one of its songs.¹²² Just like the arguments raised by EA in *Dillinger v. EA*, OutKast argued that Rosa Parks' Lanham Act claim must fail because it did not use her name as a trademark, and the First Amendment protected the title of the song.¹²³ The court, in turn, stated that "the First Amendment cannot permit anyone who cries 'artist' to have *carte blanche* protection when it comes to naming and advertising his or her works"¹²⁴ There, the court adopted the *Rogers* test and remanded the case so that the jury could determine whether "Rosa Parks" had any artistic relevance to the song.¹²⁵ The case settled before there was a decision on remand, which

¹¹⁶ See *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2nd Cir.1989).

¹¹⁷ See *id.*

¹¹⁸ See *id.*

¹¹⁹ See *id.* at 994.

¹²⁰ See *id.* at 1004.

¹²¹ See *Parks v. LaFace Records*, 329 F.3d 437, 450 (6th Cir. 2011).

¹²² See *id.* at 441.

¹²³ See *id.* at 446-447.

¹²⁴ See *id.* at 447.

¹²⁵ See *id.*

left the legal community wondering whether Outkast or Rosa Parks would have prevailed.¹²⁶

In *Mattel, Inc. v. MCA Records, Inc.*, the Ninth Circuit also adopted the *artistically relevant test*. Unlike, *Parks*, this case was not settled and provided important insight into a court's application of the *artistically relevant test*.¹²⁷ In this case, the Danish band Aqua produced a song named "Barbie Girl."¹²⁸ The single was a hit and made it onto the Top 40 music charts during its release.¹²⁹ Mattel, the famous toy company known for creating the cultural icon, Barbie, sued MCA Records for producing this song.¹³⁰ The court granted summary judgment to MCA Records, on Mattel's federal and state law claims for trademark infringement and trademark dilution.¹³¹ The Court found that the song's title "Barbie Girl" was artistically relevant because the song was about Barbie and Ken, who was Barbie's significant other.¹³² Moreover, the song made an actual reference to Barbie and Ken and symbolized other people like them.¹³³ According to the court, the song did not explicitly mislead consumers by suggesting Mattel endorsed it.¹³⁴ The only indication that associates Mattel with the song is the word "Barbie" in the title.¹³⁵ The court further noted that if the word "Barbie" were enough to satisfy the misleading prong of the *artistic relevance test*, the test would be useless.¹³⁶ From the reasoning in this case, one can see that the threshold for artistic relevance is minimal.

As more courts began to use the artistic relevance test many also began to modify the

¹²⁶ See *Rosa Parks Settles Suit Over OutKast CD*, CNN.COM (April 15, 2005) http://articles.cnn.com/2005-04-15/entertainment/parks.settlement_1_rosa-parks-raymond-parks-institute-381-day-boycott?_s=PM:SHOWBIZ.

¹²⁷ See *Mattel, inc. V. MCA Records, Inc.*, 296 f.3d 894, 902 (9th Cir. 2002).

¹²⁸ See *id.* at 899.

¹²⁹ See *id.*

¹³⁰ See *id.*

¹³¹ See *id.*

¹³² See *Mattel, inc. V. MCA Records, Inc.*, 296 f.3d 894, 901 (9th Cir. 2002).

¹³³ See *id.* at 898. ("Barbie was born in Germany in the 1950s as an adult collector's item. Over the years, Mattel transformed her from a doll that resembled a "German street walker," as she originally appeared, into a glamorous, long-legged blonde. Barbie has been labeled the ideal American woman and a bimbo.").

¹³⁴ See *id.* at 902.

¹³⁵ See *id.*

¹³⁶ See *id.*

test. For example, in *No Fear, Inc. v. Imagine Films, Inc.*, the court used the first prong from *Rogers v. Grimaldi's artistic relevance test* and then determined the *misleading* prong by analyzing the *likelihood of confusion test*, and then weighed Plaintiff's showing of *likelihood of confusion* against the *artistic relevance prong*.¹³⁷

In this case, the plaintiff used *No Fear* as its logo for sporting goods and jewelry and it was suing the defendant, Universal Studios, for producing a film called *No Fear*.¹³⁸ The film *No Fear* was about a disturbed young male adult who seduces a younger girl and terrorizes her family.¹³⁹ The young man in the movie engages in multiple murders, and animal mutilation.¹⁴⁰ The District Court first decided that the movie title was artistically relevant to the contents of the film; and yet, the court denied summary judgment because it did not find a showing of likelihood of confusion between the movie and the registered mark.¹⁴¹

The court in *No Fear*, explained that *Rogers v. Grimaldi's artistic relevance test* was limited to cases involving the use of a celebrity's name in a movie title¹⁴² As a result, courts have expanded the *artistic relevance test* to include numerous other areas of expressive conduct.¹⁴³ The court also states:

There is no doubt substantial confusion in the case law about the precise role of the likelihood of confusion factors in the application of the rule articulated in *Rogers*.¹⁴⁴

No Fear illustrates the apparent confusion federal courts have regarding the proper application of the *artistic relevance test*. The court in that case quite clearly conflated two separate tests to reach its desired result.

¹³⁷ See *No Fear, Inc. v. Imagine Films, Inc.*, 930 Supp. 1381, 1383-1384 (C.D. Cal. 1995).

¹³⁸ See *id.* at 1381.

¹³⁹ See *id.* at 1382.

¹⁴⁰ See *id.*

¹⁴¹ See *id.* at 1384.

¹⁴² See *No Fear, Inc. v. Imagine Films, Inc.*, 930 Supp. 1381, 1382 (C.D. Cal. 1995).

¹⁴³ See *id.*

¹⁴⁴ See *id.*

ii. *Likelihood of confusion view*

The second test used by courts is the *likelihood of confusion test*. This is the test that is traditionally used to determine whether there is a likelihood of confusion. For example, in *Elvis Presley Enterprises, Inc. v. Capece*, the court stated that the appropriate test in trademark infringement cases was the traditional *likelihood of confusion test*, which incorporates the traditional likelihood of confusion factors.¹⁴⁵ In that case, the Fifth Circuit reviewed the factors of the *likelihood of confusion test* and focused on advertising, parody, similarity of the disputed marks, similarity of products and services, actual confusion, and the defendant's intent and defenses.¹⁴⁶ Elvis Presley Enterprises, Inc. was the assignee and registrant of all trademarks belonging to the Elvis Presley estate, and it sued Barry Capece for operating a restaurant and tavern called "The Velvet Elvis."¹⁴⁷ The restaurant was a gaudy venue containing a multitude of Elvis memorabilia and a menu of Elvis's favorite dishes.¹⁴⁸ The defendant argued that the restaurant was simply a parody which did not infringe on the Elvis trademark, but the Fifth Circuit disagreed and stated that parody was only one of several factors in the likelihood of confusion test.¹⁴⁹ Ultimately, the court found that Capece infringed the Elvis mark because parody is only a factor to be the service mark was used in advertising that is likely to alter the psychological impact of the mark, and the restaurant business was a natural area of expansion.¹⁵⁰ The problem with only applying the *likelihood of confusion test* in a First Amendment context is that it gives no weight to First Amendment concerns because it treats the name of an artistic the same way it would treat a commercial product.¹⁵¹

¹⁴⁵ See *Elvis Presley Enterprises, Inc. v. Capece*, 141 F.3d 188, 207(5th Cir. 1998).

¹⁴⁶ See *id.* at 191-207.

¹⁴⁷ See *id.* at 191-192.

¹⁴⁸ See *id.* 192.

¹⁴⁹ See *id.*

¹⁵⁰ See *Elvis Presley Enterprises, Inc. v. Capece*, 141 F.3d 188, 198-203 (5th Cir. 1998).

¹⁵¹ See *Parks v. LaFace Records*, 329 F.3d 437, 449 (6th Cir. 2003).

iii. *Alternative avenues view*

Of the available tests analyzing trademark infringement claims, the test least frequently employed by courts is the *alternative avenues test*, which is also the test that most favors trademark holders. Under this test, courts determine trademark infringement by deciding whether an alternative equivalent title, mark, or work could be used.¹⁵² For instance, in *American Dairy Queen, v. New Line Productions*, the court used the alternative avenues test and granted Dairy Queen a preliminary injunction.¹⁵³

In this case, the plaintiff, Dairy Queen, sued New Line Productions because of a title it had chosen for its “mockumentary,” *Dairy Queens*.¹⁵⁴ This mockumentary¹⁵⁵ poked fun at the beauty contests in the Midwest.¹⁵⁶ Plaintiff argued that defendant’s use of the title *Dairy Queens* infringed on its well-established trademark and that the public would associate its trademark with the unwholesome content of the film.¹⁵⁷ The court, however, referenced alternative titles such as *Dairy Princesses*, that New Line Productions could have used. Ultimately, the court granted Plaintiff the injunction and stated that defendant had various alternative avenues for the title of its film.¹⁵⁸ The problem with only applying the *alternative avenues test* is that it is based on the notion that a property owner may limit a person’s self expression on their property.¹⁵⁹ When this notion is extended to artists it limits every use of a mark if there are alternatives for the artist’s intended expression.¹⁶⁰ This test will always favor the trademark owner and give little

¹⁵² See *id.* at 450.

¹⁵³ See *American Dairy Queen v. New Line Productions*, 35 F.Supp.2d 727, 735 (D. Minn. 1998).

¹⁵⁴ See *id.* at 728.

¹⁵⁵ A “mockumentary” is a satirical program in the form of a documentary. See *id.*

¹⁵⁶ See *id.* at 728.

¹⁵⁷ See *id.* at 729.

¹⁵⁸ See *American Dairy Queen v. New Line Productions*, 35 F.Supp.2d 727, 735 (D. Minn. 1998).

¹⁵⁹ See *Parks v. LaFace Records*, 329 F.3d 437, 449 (6th Cir. 2003).

¹⁶⁰ See *id.*

credence to the artist and first amendment rights.¹⁶¹

c. The proposed test and its application to *Dillinger v. EA*

i. The proposed test

Considering the inconsistency among the courts and the different policies promoted by each test, both courts and litigants would be better served if one test decided trademark infringement cases containing First Amendment issues. This proposed test actually combines the three major tests, which are the (1) the *artistic relevance test*; (2) the *likelihood of confusion test*; and (3) the *alternative avenues test*.

Under the proposed test, the first prong would require courts to analyze the traditional likelihood of confusion factors.¹⁶² If such a confusion existed, then the court could proceed to the second prong. To determine a likelihood of confusion the court would weigh the following factors:

(1) the strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant's intent in selecting the mark; and (8) likelihood of expansion of the product lines.¹⁶³

After determining whether a likelihood of confusion exists, the court could then determine the degree of artistic relevance found in the disputed mark. Under the second prong of the proposed test, if a court does not find artistic relevance, it will find for the plaintiff because there is a trademark infringement, similar to the modified *artistic relevance test*.¹⁶⁴ If, however, a court found artistic relevance did exist, then the court would weigh the artistic relevance against the *alternative avenues test*.

¹⁶¹ See *id.*

¹⁶² See *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979).

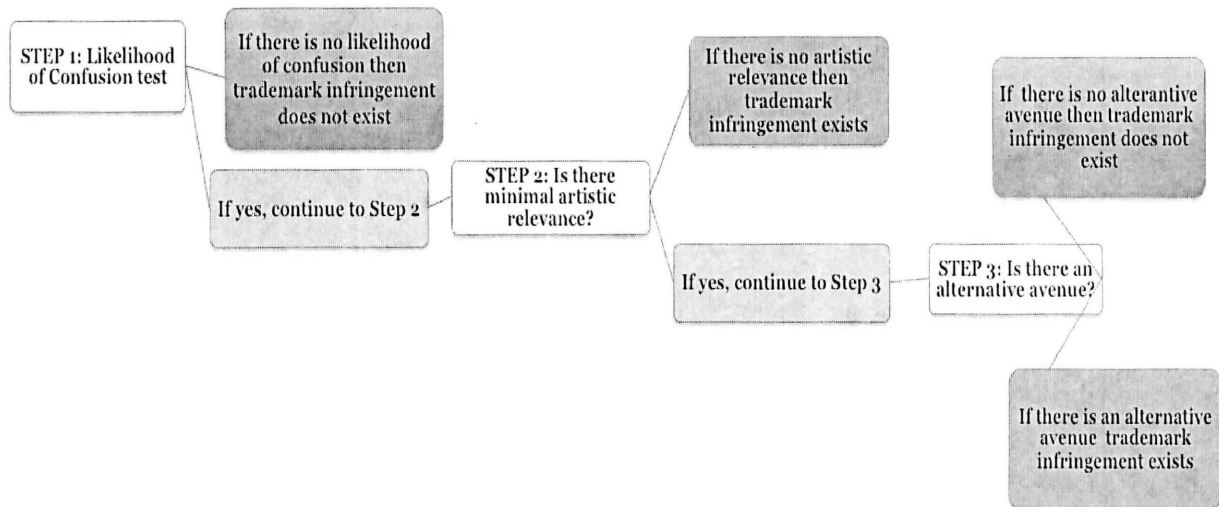
¹⁶³ See *id.*

¹⁶⁴ See *No Fear, Inc. v. Imagine Films, Inc.*, 930 Supp. 1381, 1382 (C.D. Cal. 1995).

To clarify, under the proposed test, if a court finds minor artistic relevance, and an alternative could work just as well, the court would find trademark infringement. However, if the artistic relevance is so high that the absence of the mark would greatly diminish the artistic work, then the court should decide favorably for the defendant.

For example, compare *Rogers* and *Dairy Queen*: the artistic relevance to the title of the film was intricately woven into the plot of the film in *Rogers*, yet the title in *Dairy Queens* had no relation to the mark and was merely catchy because of Dairy Queens' goodwill.¹⁶⁵ Although many courts suggest or prefer the use of one test over another, not one has looked outside the box. Courts should take a deeper look into balancing the rights involved and the policies that each test individually promotes.¹⁶⁶ By applying all the tests in an analysis it would provide a fair approach and consider each policy underlying each established test.

Figure 4: The Proposed Test



ii. The proposed test applied to *Dillinger v. EA*

If the proposed were applied in *Dillinger v. EA* it would require the court to delve into a

¹⁶⁵ See *Grimaldi*, 875 F.2d at 994; see also *Dairy Queen*, 141 F.3d, at 191-207.

deeper analysis and a more favorable outcome to Dillinger, LLC. Under the first factor of the likelihood of confusion prong, Dillinger, LLC would have the burden of showing the strength of its mark, *Dillinger*.¹⁶⁷ Arguably, the *Dillinger* trademark registration could have been barred because it was a surname, and because it belonged to a notorious criminal; but, the USPTO actually approved the mark.¹⁶⁸ The USPTO's stamp of approval and lack of objection to the registration gives credibility to the strength of the mark. Also, Dillinger, LLC's evident diligence in pursuing litigation to prevent infringement would probably favor Dillinger, LLC in determining the strength of the mark.¹⁶⁹ Further, a general search for John Dillinger's name shows that there are only forty-nine people in the United States with that name, making it a less than common mark.¹⁷⁰ Additionally, many people probably associate the name with the gangster and his crimes, which means it has most likely acquired a secondary meaning. *Dillinger* is a fairly strong mark.

Under the second factor, one must analyze the proximity of the products.¹⁷¹ Although, Dillinger LLC has not used its names on guns it does plan to do so in the future, which is evident from its current trademark.¹⁷² EA is using *Dillinger* to name its video game guns and J.D. is known for using guns, specifically Tommy Guns.¹⁷³ The relatedness would be strong. Under the third factor of the likelihood of confusion prong, one would determine whether the degree of

¹⁶⁷ See *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979).

¹⁶⁸ See *Trademark Electronic Search System*, USPTO.COM, http://tess2.uspto.gov/bin/showfield?f=toc&state=4001%3Aa5age7.1.1&p_search=searchss&p_L=50&BackReference=&p_plural=yes&p_s_PARA1=&p_tagrepl~%3A=PARA1%24LD&expr=PARA1+AND+PARA2&p_s_PARA2=dillinger&p_tagrepl~%3A=PARA2%24COMB&p_op_ALL=AND&a_default=search&a_search=Submit+Query&a_search=Submit+Query (last visited Jan. 29, 2012) (search for registrations of *Dillinger*).

¹⁶⁹ See *id.*

¹⁷⁰ See WHITEPAGES.COM, <http://names.whitepages.com/john/dillinger> (last visited Jan. 29, 2012) (search engine).

¹⁷¹ See *Dillinger*, 2011 U.S. Dist. LEXIS 64006, at *7-8.

¹⁷² See LALONDE, *supra* note 4.

¹⁷³ See LALONDE, *supra* note 4.

similarity between the two marks is high.¹⁷⁴ EA is using *Dillinger* on its video game guns, the surname of the mark.

Under the fourth factor of the first prong, one must analyze whether there was actual confusion; however, Dillinger, LLC failed to show this.¹⁷⁵ Dillinger, LLC made efforts to show that there was confusion when media uses a mark, but the court did not find it sufficient to show actual confusion. Under the fifth factor of the first prong, one must look at the marketing channels for both. Unfortunately, this can be shown through surveys, which can be fairly expensive, however, current marketing strategies used in the gaming arena could strongly imply a gamer would believe that a mark in a video game is endorsed by the owner.¹⁷⁶ Video games have become an important medium for product placement.¹⁷⁷ Under the sixth factor, one must look at the purchaser's degree of care. The mark *Dillinger* may suggest to a gamer who likes gangster mob-related material that the mark is endorsed by affiliates of J.D., especially because of current marketing practices in the gaming industry.¹⁷⁸ Seventh, EA stated that it could not remember its reason for choosing *Dillinger*, but the Defendant's continued to use the mark after being warned by Dillinger, LLC.¹⁷⁹ This could have assisted in showing defendant's possible bad faith in the use of the mark, specifically its use in *Godfather II*.

The last factor under the likelihood of confusion prong requires that plaintiff show expansion of its market and Dillinger, LLC could have shown its expansion to gun products

¹⁷⁴ See *supra*, p. 20.

¹⁷⁵ See *Dillinger, LLC v Electronic Arts, Inc.*, No. 1:09-cv-1236-JMS-DKL, 2011 U.S. Dist. LEXIS 64006, at *19 (S.D. Ind. June 16, 2011).

¹⁷⁶ See *Product Placement on the Rise in Video Games: Marketers desperate to engage well-to-do market of 132 million gamers*, MSNB.COM, (July 21, 2006) http://www.msnbc.msn.com/id/13960083/ns/technology_and_science-tech_and_gadgets/t/product-placement-rise-video-games/#.TyiG4sUeN2A.

¹⁷⁷ See *id.*

¹⁷⁸ See *id.*

¹⁷⁹ See *Dillinger*, 2011 U.S. Dist. LEXIS 64006, at *7-8.

because it had a trademark registration with the USPTO.¹⁸⁰ The court in, *Dillinger, LLC v. EA*, stated that use of a well-known gun manufacturer such as Smith & Wesson would be an infringement.¹⁸¹ Ultimately, the factors of the likelihood of confusion test were strongly in Plaintiff's favor.

Under the *artistic relevance* prong, the court found *Dillinger* was slightly relevant to the game because he was a criminal affiliated with that particular gun and the video game related to mobsters. But, as discussed in the case, *J.D.* and the *Godfather* are based in two different time eras and are different types of criminals. There is some artistic relevance but it is not nearly as strong as the artistic relevance presented in *Rogers*.

Lastly, under the *alternative avenues* prong the court would have found that there were equivalent substitutes to name the guns in the *Godfather* video game series. Although, the court would have found that *Dillinger* was slightly relevant to the *Godfather* video game series it would not be sufficient to establish a necessary need by EA. The use of another name, for example, "Tommy Gun" would not diminish the value of the artistry of the game. The name would be the name of the actual gun, instead of the name of the gangster who was famous for using the gun. The end result would have established a better analysis to determine the rights of *Dillinger, LLC* and EA. Under this proposed test *Dillinger, LLC* most likely would have prevailed.

IV. CONCLUSION

The First Amendment was designed to enable criticism of the government and other

¹⁸⁰ See LALONDE, *supra* note 3.

¹⁸¹ See *Dillinger*, 2011 U.S. Dist. LEXIS 64006, at *7-8.

entities without retaliation, which is why the fair use defense exists.¹⁸² On the other hand, the inadequate safeguarding of trademarks can lead to grave economic damages for trademark holders.¹⁸³ Federal courts should be consistent in their decisions of protecting the right to fair use and the protections granted by trademarks. Greater consistency among the Federal Courts in applying a test that serves both the First Amendment's purpose, and enhances trademark protections, is far past due. For this reason, courts should apply the proposed test, which incorporates the most useful aspects of the three tests in this legal area.¹⁸⁴ By removing problematic areas that are frequently misinterpreted and misapplied, the proposed test actually furthers the important interests of artists and trademark users.

Dillinger v. EA, is a great example of how the proposed test could have allowed the litigants and the court to better understand that there was more at risk in that case than simply allowing a gaming company to make a profit from an item using a registered trademark.¹⁸⁵ Indeed, crucial First Amendment protections were at stake.

Unfortunately, one of the problems facing surrounding the utilization of a proper test to analyze trademark infringement cases is that this problem may remain unaddressed until circuit courts wrestle with the tremendous confusion found in the District Courts.¹⁸⁶ A perfect example is *Parks v. LaFace Records*,¹⁸⁷ or any other case where parties fail to advocate for a different test during litigation.

While the Lanham Act and established case law should resolve trademark infringement litigation a majority of the courts have decided that when a trademark issue faces a First

¹⁸² See Mike McCurry and Marck McKinnon, *Free Speech Shouldn't be a Shield for Online Thieves*, FIERCETELECOM.COM (Sept. 19, 2011, 6:09 AM), <http://www.fiercetelecom.com/story/free-speech-shouldnt-be-shield-online-thieves/2011-09-19#ixzz1Z3Kn2IBR>

¹⁸³ See *id.*

¹⁸⁴ See *supra*, pp. 20.

¹⁸⁵ See *supra*, pp. 17.

¹⁸⁶ See *supra*, note 15.

¹⁸⁷ See *supra*, note 126.

Amendment issue, the First Amendment issue always governs.¹⁸⁸ This unfortunate pattern followed by courts permits companies like EA to diminish trademark rights because courts fail to recognize that EA is a business making a profit¹⁸⁹ off of video games, and using the First Amendment as a mere excuse to blatantly infringe a registered trademark.¹⁹⁰ Any supposed artist work that uses a trademark should be treated like any other media that uses products, sponsorships, or endorsements; it should be treated like a commercial use excluding instances of nominative use and parody.¹⁹¹ The deterrence that the Lanham Act is supposed to promote against infringement is lost in cases like *Dillinger*; indeed, because of the current confusion, businesses like EA, who are constantly in litigation over these matters, generally win.

If courts continue to blindly apply the *Rogers* test the leeway for abuse by companies like EA is limitless. The proposed test, by contrast, would ultimately balance the equities for each party. Unless courts find a better way to balance these rights trademark rights will greatly diminish because of the minimal artistic requirement required by *Rogers v. Grimaldi*. The proposed test would provide better protection because it incorporates the Lanham Act's overall purpose, by applying the likelihood of confusion test, it protects property rights by applying the alternative avenues test, and it strengthens First Amendment rights by applying the artistically relevant test.

¹⁸⁸ See *supra*, note 11.

¹⁸⁹ See *supra*, note 176. ("Spending on in-game advertising and product placement, \$56 million last year, will reach \$730 million by 2010, predicts Yankee Group, a Boston research firm.").

¹⁹⁰ See *supra*, note 4. After acknowledging the issues raised in the *Godfather* EA still continued to use the mark in *Godfather II*.

¹⁹¹ See *supra* note 176.