

# Special Issues Concerning Service Marks in the Media and Entertainment Industries

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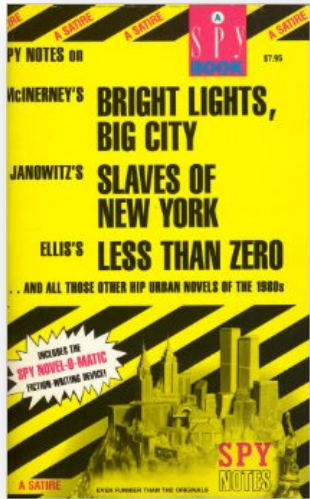
David Silverman, Davis Wright Tremaine LLP

# *Rogers v. Grimaldi* (2d Cir. 1989)

- Trademark Rights (Lanham Act) vs. First Amendment
- Title of artistic work infringes mark only if devoid of artistic significance or explicitly misleading as to source
- Court rejects “no alternative means” approach

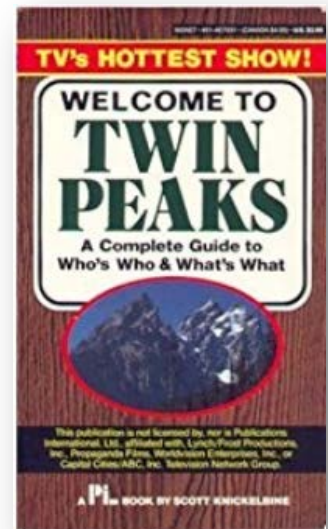


# Rogers v. Grimaldi (cont'd)



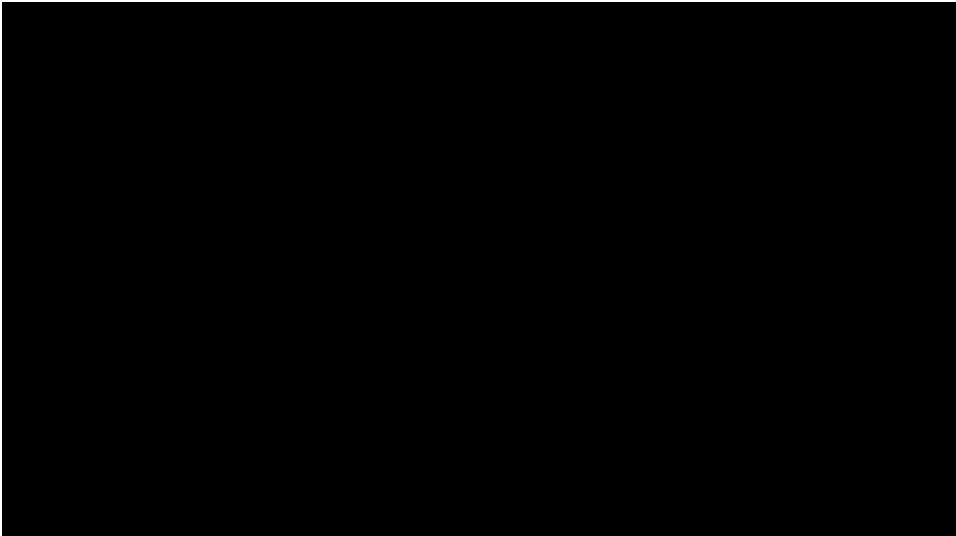
- *Cliffs Notes* (2d Cir. 1989):  
Spy Notes found to be a  
parody protected under *Grimaldi*

- *Twin Peaks* (2d Cir. 1993):  
Book about TV series found  
to infringe copyright but  
remanded on TM infringement



# Rogers v. Grimaldi (cont'd)

## *Mattel v. MCA Records* (9<sup>th</sup> Cir. 2002)



Barbie Girl in song title  
follows *Rogers v. Grimaldi*  
(9<sup>th</sup> Circuit adoption)

No dilution— Song is  
noncommercial use (?)

# Rogers v. Grimaldi Now

Use of mark OK in title **or body** of work if any “artistic relevance” (i.e. more than zero)



*ETW v. Jireh* (6<sup>th</sup> Cir. 2003):  
Use of Tiger Woods' image  
in painting of Masters  
protected under *Rogers*  
analysis (artistic  
relevance/not misleading  
as to source)

# Rogers v. Grimaldi Now

## *ESS Entertainment 2000 v. Rock Star Videos (9<sup>th</sup> Cir. 2008)*



Use of PIG PEN for strip club in Grand Theft Auto video game did not infringe PLAY PEN

(Note: No use of mark in title...body only)

# Rogers v. Grimaldi Now

## ***Brown v. Elec. Arts* (9<sup>th</sup> Cir. 2013)**



Likeness of football player in Madden NFL video game protected under Section 43(a) (even if not Citizen Kane)

Compare *Keller v. EA* (9<sup>th</sup> Cir. 2013) re Calif. right of publicity decided same day



# Other Uses of Marks Found to be OK



*Wham-O v. Paramount* (ND Cal. 2003)



- Use of Slip 'N Slide in *Dickie Roberts*



# Other Uses of Marks Found to be OK



*Caterpillar v. Disney* (CD III. 2003)



- Use of bulldozers in George of the Jungle 2

# Other Uses of Marks Found to be OK



*Gottlieb v. Paramount* (SDNY 2008)



- Use of “Silver Slugger” pinball machine in *What Women Want*

# Other Uses of Marks Found to be OK



*Vuitton v. Warner Bros.* (SDNY 2012)



- Reference to knockoff Louis Vuitton bag as Vuitton in Hangover II had “artistic relevance”

# Other Uses of Marks Found to be OK



*Mil-Spec Monkey v. Activision* (ND Cal. 2014)

- Use of “angry monkey” morale patch in *Call of Duty: Ghosts* video game

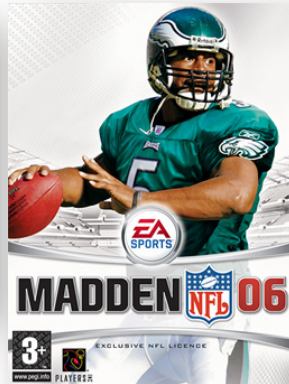


# Uses of Marks NOT OK



*American Dairy Queen v. New Line* (D. Minn. 1998):

- Distinguished Rogers since film NOT about Dairy Queen (but probably wrongly decided, since there was artistic relevance)



*Facenda v. NFL Films* (3d Cir. 2008):

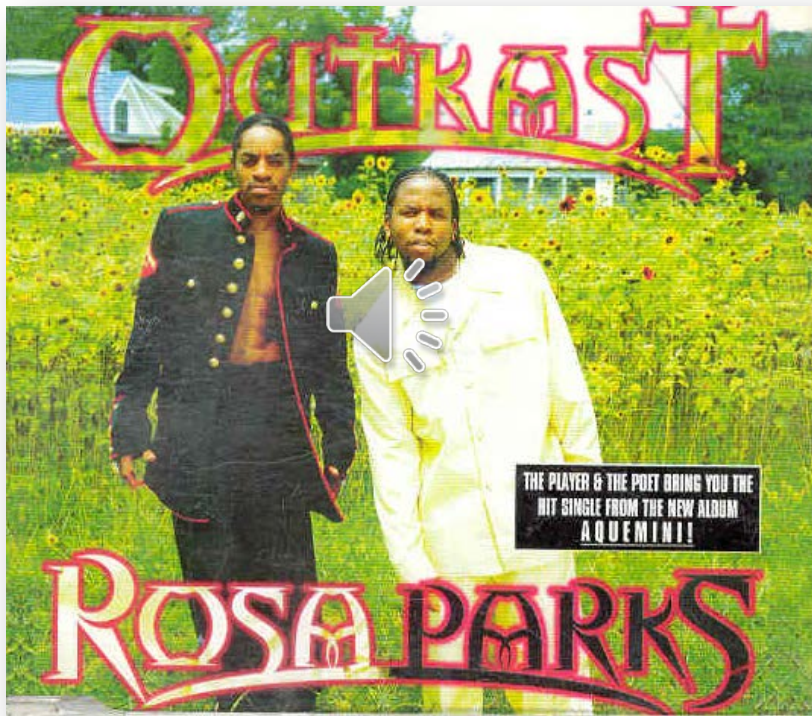
- Making of Madden NFL = Infomercial deemed commercial speech not entitled to same First Amendment protection



# Uses of Marks NOT OK



*Parks v. LaFace Records* (6<sup>th</sup> Cir. 2003)



- OutKast song “Rosa Parks” not protected under *Grimaldi*
- May also violate state right of publicity
- Song not about Rosa Parks or civil rights movement (i.e. no “artistic relevance”)
- Despite repeated use of phrase, “move to the back of the bus”



# Uses of Marks NOT OK



*Warner Bros. v. Global Asylum* (CD Cal. 2012):



- “Age of Hobbits” enjoined as explicitly misleading (planned release of “mockbuster” 3 days before “The Hobbit: An Unexpected Journey”). Title held misleading.

# Uses of Marks NOT OK



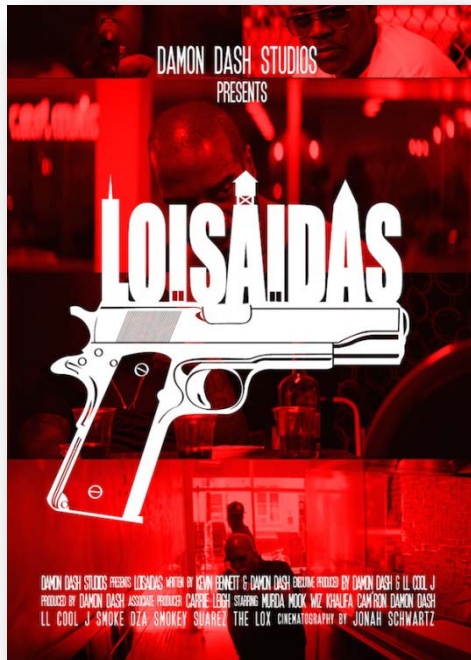
*Elec. Arts v. Textron* (ND Cal. 2012):



- Prominent use of Bell helicopter in *Battlefield 3* video game held to “explicitly mislead” as to sponsorship

# Recent Decisions

- *Fox v. Empire Distribution* (CD Cal. 2016): Follows *Grimaldi* in holding that Empire as name of TV show has artistic relevance and not misleading despite heavy use of music



- *Medina v. Dash Films* (SDNY 2016): Kanye West can use “Loisaidas” as film title about Lower East Side of NY despite plaintiff’s band of the same name

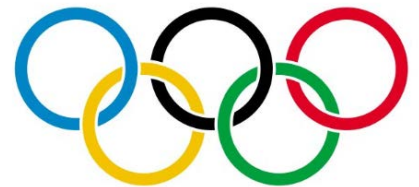
# Nominative Fair Use

- *New Kids on the Block* (9<sup>th</sup> Cir. 1992) (did not mention *Grimaldi*):
  1. Product/Service not readily identifiable without use of mark
  2. Only so much of mark may be used as reasonably necessary to identify product/service
  3. Do not suggest sponsorship or endorsement by trademark owner
- *Mattel v. Walking Mountain* (9<sup>th</sup> Cir. 2003): Use of Barbie doll in photos OK



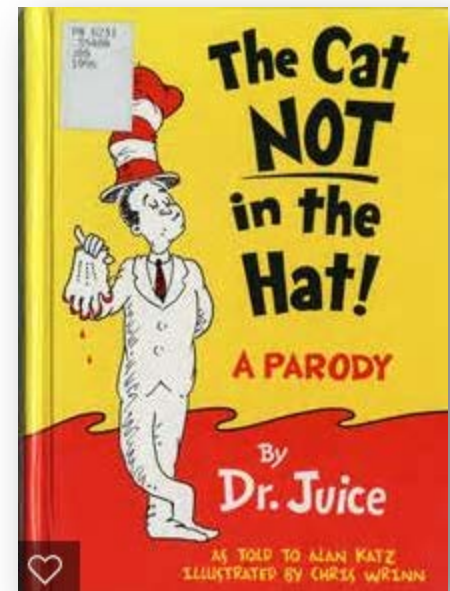
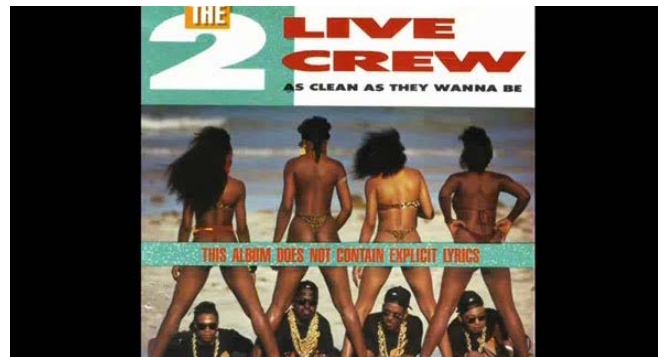
# Nominative Fair Use

- Super Bowl/March Madness/Olympics/NASCAR, etc.  
(Note: Olympics marks protected by statute)



# Parody as Fair Use

- Parody is satire that targets/criticizes the original work. If copied work is not the *object* of the parody, then parody as fair use defense is inapplicable.
- Compare *Acuff Rose* (S. Ct. 1994) (2 Live Crew parody of Roy Orbison song) with *Dr. Seuss* (9<sup>th</sup> Cir. 1997) (“The Cat NOT in the Hat” satirizing OJ Simpson trial NOT a parody)





# Parody

- Compare also *Deere v. MTD* (2d Cir. 1994) (Dilution trumps parody of Deere deer) with *Hormel v. Henson* (2d Cir. 1996) (Wild Boar High Priest Spa'am in Muppet film OK)
- “Barry Driller” for Aereo-type service held not to be parody due to purely commercial use (CD Cal. 2012)



# Parody

- USPTO: Parody cannot be a defense to dilution by virtue of statutory exclusion for use on one's own goods or services. See *Yankees v. IET* (TTAB 2015) re “House that Juice Built” and top hat/syringe logo



# Disparagement

- *In re Tam* (Fed. Cir. 2015): Section 2(a) disparagement provision of Lanham Act held unconstitutional
  - “Expressive content” subject to strict scrutiny
  - Right to use vs. right to register (latter can chill former)
  - Supreme Court to review (cert. granted Sept. 29)



# Disparagement

- Compare *Pro Football v. Blackhorse* (ED Va. 2015) Upholding cancellation of Redskins marks
  - Section 2(a) does not implicate First Amendment speech (right to use)
  - Govt. speech exempt from First Amendment scrutiny



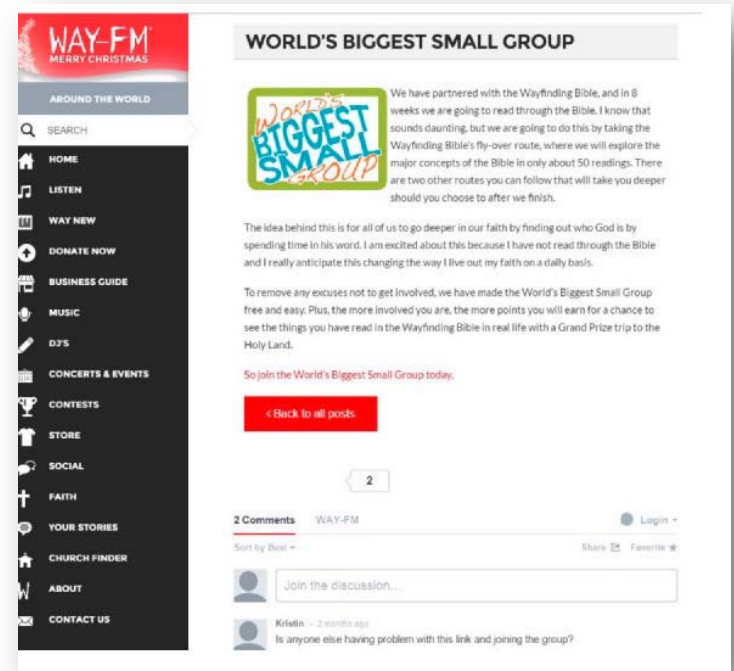
# TV/Film/Video/Radio Titles as Service Marks

- Single works not registrable at USPTO but production of one show sufficient to show production services
- MPAA Title Registration Bureau helps protect against confusing similarity
- OK to reuse titles of films that are out of circulation and lack secondary meaning
- Exception: Lee Daniels' The Butler



# USPTO

- Service Mark Specimens (must show provision of services) v. Trademark Specimens (tag or label OK)
- PTO becoming more aggressive in reviewing websites to determine whether show is a one-off or part of a series; whether services are described correctly, and for other purposes.
- “World’s Biggest Small Group” = radio program services **not** radio broadcasting services





# Thank You!



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