

3-19-2013

## Holding Back the (Crimson) Tide of Trademark Litigation: The Eleventh Circuit Shields Works of Art from Lanham Act Claims in *New Life Art*

Nicholas Macri  
*Boston College Law School*, [nicholas.macri@bc.edu](mailto:nicholas.macri@bc.edu)

Follow this and additional works at: <http://lawdigitalcommons.bc.edu/bclr>

 Part of the [Entertainment, Arts, and Sports Law Commons](#), [First Amendment Commons](#), and the [Intellectual Property Law Commons](#)

---

### Recommended Citation

Nicholas Macri, *Holding Back the (Crimson) Tide of Trademark Litigation: The Eleventh Circuit Shields Works of Art from Lanham Act Claims in New Life Art*, 54 B.C.L. Rev. E. Supp. 71 (2013), <http://lawdigitalcommons.bc.edu/bclr/vol54/iss6/7>

This Comments is brought to you for free and open access by the Law Journals at Digital Commons @ Boston College Law School. It has been accepted for inclusion in Boston College Law Review by an authorized editor of Digital Commons @ Boston College Law School. For more information, please contact [nick.szydowski@bc.edu](mailto:nick.szydowski@bc.edu).

# HOLDING BACK THE (CRIMSON) TIDE OF TRADEMARK LITIGATION: THE ELEVENTH CIRCUIT SHIELDS WORKS OF ART FROM LANHAM ACT CLAIMS IN *NEW LIFE ART*

**Abstract:** On June 11, 2012, in *University of Alabama Board of Trustees v. New Life Art, Inc.*, the U.S. Court of Appeals for the Eleventh Circuit held that the Lanham Act does not apply to works of art that include others' trademarks as long as the use of the trademark is artistically relevant to the underlying work and does not explicitly mislead consumers into believing that the trademark holder endorsed or sponsored its use. In so holding, the Eleventh Circuit provided clarity to artists as to what types of trademark uses are permitted in their works. This Comment argues that the Eleventh Circuit's standard is beneficial to artists and should be adopted by other courts.

## INTRODUCTION

In 2005, the University of Alabama brought suit against Daniel A. Moore, an artist whose paintings capture scenes of the university's football team.<sup>1</sup> The school alleged that Moore's works—which feature realistic portrayals of the university's uniforms, helmets, and jerseys—violated the Lanham Act.<sup>2</sup> The Lanham Act protects trademark holders from unauthorized uses of their marks that may cause confusion among consumers as to the trademark holder's involvement in the mark's use.<sup>3</sup> In 2012, in *University of Alabama Board of Trustees v. New Life Art, Inc.*, the U.S. Court of Appeals for the Eleventh Circuit held that Moore's use of the university's trademarks in his paintings, prints, and calendars was protected under the First Amendment.<sup>4</sup> As such, Moore's

---

<sup>1</sup> *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1269–70 (11th Cir. 2012).

<sup>2</sup> *Id.*; see Randall L. Newsom, Note, *Cease and Desist: Finding an Equitable Solution in Trademark Disputes Between High Schools and Colleges*, 52 B.C. L. REV. 1833, 1849 (2011) (“[T]he expansive nature of the Lanham Act and the increased revenues from collegiate merchandise have led collegiate institutions to step up their pursuit of trademark infringers . . .”).

<sup>3</sup> Lanham Act, 15 U.S.C. § 1125(a) (2006). The Lanham Act, in relevant part, prohibits the “use[ ] in commerce” of “any word, term, name, symbol, or device” which “is likely to cause confusion . . . as to the origin, sponsorship, or approval of [the trademark owner's] goods, services, or commercial activities by another person . . .” *Id.*

<sup>4</sup> *New Life Art*, 683 F.3d at 1282.

use of the university's marks was not subject to Lanham Act scrutiny.<sup>5</sup> Thus, in this battle between trademark protection under the Lanham Act and artistic expression protection under the First Amendment, artistic expression won.<sup>6</sup>

In reaching its decision, the Eleventh Circuit relied on the balancing test articulated by the U.S. Court of Appeals for the Second Circuit in 1989 in *Rogers v. Grimaldi*.<sup>7</sup> In *Rogers*, the Second Circuit held that because of First Amendment concerns, the Lanham Act should only apply to works of artistic expression when "the public interest in avoiding consumer confusion outweighs the public interest in free expression."<sup>8</sup> To balance these interests, the *Rogers* court discussed two factors, which would be used by subsequent courts as a two-prong test.<sup>9</sup> Under the two-prong test, the public interest in protecting artistic expression outweighs the public interest in avoiding confusion unless (1) the trademark use is not artistically relevant to the underlying work, or (2) the work "explicitly misleads as to the source or content of the work."<sup>10</sup>

By invoking the *Rogers* test in its *New Life Art* decision, the Eleventh Circuit became the fourth circuit to apply the *Rogers* balancing test for Lanham Act cases involving trademarks used within works of art.<sup>11</sup> But, despite their common invocation of the balancing test articulated in *Rogers*, the circuits' approaches to that test have varied.<sup>12</sup> Specifically,

---

<sup>5</sup> *Id.* at 1278.

<sup>6</sup> *See id.* at 1276–77, 1278–79.

<sup>7</sup> *Id.* at 1278; *see* *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

<sup>8</sup> *Rogers*, 875 F.2d at 999.

<sup>9</sup> *See New Life Art*, 684 F.3d at 1278; *ESS Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008); *Rogers*, 875 F.2d at 999.

<sup>10</sup> *New Life Art*, 684 F.3d at 1278 (quoting *ESS Entm't*, 547 F.3d at 1099).

<sup>11</sup> *See id.* at 1278 (recognizing that other circuits have adopted this standard); *ESS Entm't*, 547 F.3d at 1099 (applying the *Rogers* test to the use of an entertainment club's likeness in a video game); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 936–37 (6th Cir. 2003) (applying the *Rogers* test to the use of a celebrity's likeness in a work of art); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989) (applying the *Rogers* test to the use of a book's trademarked cover design in creating a parody); *see also* Thomas M. Byron, *Spelling Confusion: Implications of the Ninth Circuit's View of the "Explicitly Misleading" Prong of the Rogers Test*, 19 J. INTEL. PROP. L. 1, 8 (2011) (stating, prior to the *New Life Art* decision, that the U.S. Courts of Appeals for the Second, Sixth, and Ninth Circuits have applied the *Rogers* test to trademark uses found within works of art).

<sup>12</sup> *Compare New Life Art*, 683 F.3d at 1278–79 (adopting the overall balancing standard and two-prong test as articulated in *Rogers*), *and ETW Corp.*, 332 F.3d at 936–37 (same), *with ESS Entm't*, 547 F.3d at 1099–1100 (adopting the *Rogers* overall balancing test and two-prong test but using a likelihood of confusion analysis to measure whether a trademark use is "explicitly misleading"), *and Cliffs Notes*, 886 F.2d at 495 (adopting the *Rogers* balancing

the circuits have differed in their approaches to the two prongs of the test: first, in how to balance the competing interests of avoiding consumer confusion and protecting artistic expression, and second, in how to define “explicitly misleading.”<sup>13</sup>

This Comment argues that the Eleventh Circuit’s approach to the *Rogers* test in *New Life Art* should be adopted by other courts.<sup>14</sup> Part I outlines the facts and procedural history of *New Life Art*.<sup>15</sup> Part II discusses *Rogers* and how different circuits have applied its balancing test.<sup>16</sup> Finally, Part III argues that the Eleventh Circuit’s application of the *Rogers* test in *New Life Art* encourages artistic expression by allowing artists to use others’ trademarks in their works.<sup>17</sup> It further argues that the Eleventh Circuit’s approach in *New Life Art* provides clarity to artists, trademark holders, and courts as to which types of trademark uses are protected and which are not.<sup>18</sup>

#### I. THE ELEVENTH CIRCUIT APPLICATION OF THE *ROGERS* TWO-PRONG TEST TO WORKS OF ARTISTIC EXPRESSION IN *NEW LIFE ART*

Since 1979, Daniel A. Moore has painted historical scenes of the University of Alabama football team.<sup>19</sup> The paintings—which he has produced and sold as prints, calendars, mugs, and other articles—feature realistic portrayals of the university’s uniforms, including its crimson and white helmets and jerseys.<sup>20</sup> Although Moore entered into a series of agreements with the university to produce and market specified items that featured Alabama’s trademarks, Moore also produced and sold other Alabama-related paintings that were not the subjects of any licensing agreements.<sup>21</sup>

In 2002, the university told Moore that he needed the university’s permission to use its trademarks in his works.<sup>22</sup> In particular, the university claimed that Moore needed its authorization to portray its crimson

---

standard without utilizing the two-prong *Rogers* test to evaluate if the public interest in avoiding confusion outweighed the public interest in artistic expression in this case).

<sup>13</sup> See Byron, *supra* note 11, at 9–10.

<sup>14</sup> See *infra* notes 82–93 and accompanying text.

<sup>15</sup> See *infra* notes 19–39 and accompanying text.

<sup>16</sup> See *infra* notes 40–81 and accompanying text.

<sup>17</sup> See *infra* notes 82–93 and accompanying text.

<sup>18</sup> See *infra* notes 82–93 and accompanying text.

<sup>19</sup> *New Life Art*, 683 F.3d at 1269.

<sup>20</sup> *Id.*

<sup>21</sup> *Id.* at 1269–70.

<sup>22</sup> *Id.* at 1270.

and white uniforms and helmets.<sup>23</sup> Moore responded that he did not need the university's consent to paint scenes from Alabama football games and that his works did not constitute trademark violations because his uses of the university's marks were confined to the scenes he captured, rather than extending to the frame or packaging of the paintings.<sup>24</sup>

In 2005, unable to reach a resolution, the university filed suit against Moore in the U.S. District Court for the Northern District of Alabama.<sup>25</sup> The complaint alleged that Moore's paintings and prints, among other items, violated the Lanham Act by infringing the university's trademark rights in its football uniforms.<sup>26</sup> The university argued that Moore's use of Alabama's football uniforms in his works created a likelihood of confusion on the part of buyers as to the university's involvement with these products.<sup>27</sup> In response, Moore argued that the First Amendment protected his use of the university's uniforms in his works.<sup>28</sup>

In November 2009, in *New Life Art*, the Northern District of Alabama reviewed the facts relating to Moore's works and made two findings.<sup>29</sup> First, the court found that the university's uniform colors may be a weak trade dress mark.<sup>30</sup> Second, the court found that Moore's paintings may create a likelihood of confusion as to the school's involvement with Moore's works.<sup>31</sup> Nonetheless, the district court granted summary

---

<sup>23</sup> *Id.*

<sup>24</sup> *Id.*

<sup>25</sup> *New Life Art*, 683 F.3d at 1270.

<sup>26</sup> *Id.*; see *supra* note 3 and accompanying text (discussing the purpose and terms of the Lanham Act). Other items to which the university objected included calendars, mugs, and other mundane items. *New Life Art*, 683 F.3d at 1270–71. The university also alleged that Moore had breached several terms of his prior licensing agreements with Alabama. *Id.* at 1270.

<sup>27</sup> *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 677 F. Supp. 2d 1238, 1249 (N.D. Ala. 2009), *aff'd in part, rev'd in part*, 684 F.3d 1266 (11th Cir. 2012).

<sup>28</sup> See *id.* at 1250.

<sup>29</sup> *Id.* at 1258–59.

<sup>30</sup> *Id.* at 1247, 1258. Trade dress is a term used to describe the packaging of a product or a product's design. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209 (2000). The U.S. Supreme Court has concluded that trade dress constitutes a "symbol" or "device" under the Lanham Act. *Id.*

<sup>31</sup> *New Life Art*, 677 F. Supp. 2d at 1259. To measure the likelihood of consumer confusion, the district court looked at seven factors: (1) the type of mark used by the university; (2) the similarity of the marks; (3) the similarity of the goods or services represented by the marks; (4) the similarity of the retail outlets and the customers served; (5) the similarity of the advertising media used by the parties; (6) whether Moore had the intent to infringe; and (7) any evidence of actual confusion. *Id.* at 1249–50 (citing *Frehling Enters., Inc. v. Int'l Select Grp., Inc.*, 192 F.3d 1330, 1335 (11th Cir. 1999)); see also Lisa P. Ramsey,

judgment to Moore with respect to his paintings and prints, concluding that they were protected works of expression under the First Amendment.<sup>32</sup> The university appealed.<sup>33</sup>

On appeal, the Eleventh Circuit affirmed the district court's ruling that the Lanham Act did not apply to Moore's use of the university's trademarks in paintings and prints.<sup>34</sup> Although the Eleventh Circuit largely agreed with the district court's findings regarding the strength of the university's marks and the likelihood of consumer confusion resulting from Moore's works, the court determined that these evaluations were unnecessary.<sup>35</sup> Instead, the Eleventh Circuit adopted the balancing test set forth by the Second Circuit in 1989 in *Rogers*.<sup>36</sup> The Eleventh Circuit held that when dealing with trademark uses in works of art, courts must balance the competing public interests of protecting artistic expression and avoiding consumer confusion.<sup>37</sup> The court then held that under this balancing test, a trademark use is permitted as long as the mark's use has some artistic relevance to the underlying work and does not explicitly mislead consumers as to the source or content of the work.<sup>38</sup> Applying this standard, the court ruled that Moore's paintings, prints, and calendars were subject to First Amendment protection because: (1) the trademark uses were artistically relevant to Moore's underlying works, and (2) Moore never promoted his works as "endorsed" or "sponsored" by the university.<sup>39</sup>

---

*Brandjacking on Social Networks: Trademark Infringement by Impersonation of Markholders*, 58 *BUFF. L. REV.* 851, 894–95 (2010) (discussing eight factors, among others, that courts use when conducting a likelihood of confusion analysis, including the likelihood of expansion of product lines and the seven used by the district court in *New Life Art*).

<sup>32</sup> *New Life Art*, 677 F. Supp. 2d at 1259. The district court held that Moore's works were also shielded from Lanham Act claims based on artistic expression and fair use defenses. *Id.* Conversely, the district court held in the university's favor with respect to Moore's portrayal of Alabama's uniforms on mugs, calendars, and other products. *Id.* at 1243. The court reasoned that these articles are distinct from fine art and therefore are not entitled to the same First Amendment protection. *Id.* at 1241.

<sup>33</sup> *New Life Art*, 684 F.3d at 1271. Moore appealed the court's determination that his use of Alabama's trademarks on mugs, calendars, and other products was not protected by the First Amendment. *Id.*

<sup>34</sup> *Id.* at 1276. Additionally, unlike the district court, the Eleventh Circuit determined that the calendars Moore produced also were subject to First Amendment protection. *Id.*

<sup>35</sup> *Id.*

<sup>36</sup> *Id.* at 1278; see *Rogers*, 875 F.2d at 999; see also notes 45–60 and accompanying text (discussing the *Rogers* balancing test).

<sup>37</sup> *New Life Art*, 684 F.3d at 1278; see *Rogers*, 875 F.2d at 999.

<sup>38</sup> *New Life Art*, 684 F.3d at 1278 (quoting *ESS Entm't*, 547 F.3d at 1099).

<sup>39</sup> *Id.* at 1278–79. In its ruling, the Eleventh Circuit also reversed the district court's decision regarding the licensing agreements' coverage of the "mundane products"—most notably, mugs—because disputed issues of fact remained. *Id.* at 1282. The Eleventh Circuit

## II. DIFFERING APPROACHES TO THE *ROGERS* BALANCING TEST

In its 2012 decision in *New Life Art*, the U.S. Court of Appeals for the Eleventh Circuit became the fourth circuit to invoke the balancing test first articulated in 1989 in *Rogers v. Grimaldi* by the U.S. Court of Appeals for the Second Circuit.<sup>40</sup> But the circuits that have invoked the *Rogers* balancing test have applied it differently.<sup>41</sup> Section A of this Part discusses the balancing test as it was articulated by the *Rogers* court.<sup>42</sup> Section B discusses how the various circuits have applied that test.<sup>43</sup>

### A. *The Rogers Balancing Test*

In *Rogers*, the Second Circuit addressed whether the Lanham Act applied to titles of works of art.<sup>44</sup> In that case, Ginger Rogers, an entertainer known for performing with Fred Astaire, sued the producers and distributors of a film entitled “Ginger and Fred,” claiming that their use of her celebrity name violated the Lanham Act.<sup>45</sup> The defendants countered that the First Amendment protected their use of the title.<sup>46</sup> On reviewing the case, the Second Circuit reasoned that although First Amendment concerns do not insulate titles of works from all Lanham Act claims, the Act should be construed narrowly to avoid intruding on First Amendment values.<sup>47</sup> To that end, the Second Circuit established a balancing test to determine when the Lanham Act applies.<sup>48</sup>

---

did not address Moore’s First Amendment arguments relating to his use of trademarks on mundane products because he waived the ability to argue this point at the district court level. *Id.* at 1280. The district court had concluded that calendars, mugs, and other mundane products were not subject to Lanham Act protection because they were “impulse buys” and thus different from “fine art.” *New Life Art*, 677 F. Supp. 2d at 1243. The Eleventh Circuit did not explain why it disagreed with the district court’s determination that Moore’s calendars were not subject to Lanham Act protection. *New Life Art*, 683 F.3d at 1276. The Eleventh Circuit affirmed the district court’s determination that Moore’s unlicensed paintings and prints were not prohibited by the licensing agreements, thus making the First Amendment issues regarding unauthorized use of the trademarks relevant. *Id.* at 1282.

<sup>40</sup> See *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1277–78 (11th Cir. 2012); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989); Byron, *supra* note 11, at 8.

<sup>41</sup> See *infra* notes 59–81 and accompanying text.

<sup>42</sup> See *infra* notes 44–58 and accompanying text.

<sup>43</sup> See *infra* notes 59–81 and accompanying text.

<sup>44</sup> See *Rogers*, 875 F.2d at 999.

<sup>45</sup> *Id.* at 996–97. Rogers claimed that the title would lead others to believe that the film was about her or that she had sanctioned it. *Id.* at 997.

<sup>46</sup> *Rogers v. Grimaldi*, 695 F. Supp. 112, 116 (S.D.N.Y. 1989), *aff’d*, 875 F.2d 994 (2d Cir. 1989).

<sup>47</sup> *Rogers*, 875 F.2d at 998. The court reasoned that “[t]itles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion.”

Under the *Rogers* balancing test, the Lanham Act applies to works of art only in circumstances in which the public interest in avoiding consumer confusion outweighs the public interest in protecting artistic expression.<sup>49</sup> The court then discussed two factors to evaluate whether this balancing tipped in favor of applying the Lanham Act in a particular case.<sup>50</sup> The court indicated that the Lanham Act should not be applied to a work unless (1) “the title has no artistic relevance to the underlying work whatsoever” or (2) “the title explicitly misleads as to the source or the content of the work.”<sup>51</sup> The court stated that the “artistic relevance” threshold was “low” and only required the title to have something to do with the work for the title to be exempt from Lanham Act scrutiny.<sup>52</sup> As for the “explicitly misleading” prong, the court indicated that titles such as *Nimmer on Copyright* and *Jane Fonda’s Workout Book* would not shield the art from Lanham Act scrutiny if Nimmer and Fonda had nothing to do with those works.<sup>53</sup> The court reasoned that if a person’s name or a trademark were used in this explicit way and the use had nothing to do with the work, then the Lanham Act would apply because confusion concerns would outweigh artistic expression concerns.<sup>54</sup>

Applying this standard, the Second Circuit concluded that the Lanham Act did not apply to the defendants’ film title.<sup>55</sup> First, the title of the film was artistically relevant because the main characters in the film were named Ginger and Fred.<sup>56</sup> Second, the title did not explicitly indicate that Rogers endorsed the film.<sup>57</sup> Despite some survey evidence suggesting consumer confusion, the court concluded that this risk of misunderstanding was so outweighed by the public interest in artistic expression that the Lanham Act did not apply, and thus the film’s use of the name “Ginger” could stand.<sup>58</sup>

---

*Id.* Because of this hybrid nature, the court concluded that consumers have a dual interest in (1) not being misled and (2) enjoying an author’s work. *Id.*

<sup>48</sup> *Id.* at 999.

<sup>49</sup> *Id.*

<sup>50</sup> *See id.*

<sup>51</sup> *See id.* at 999; Alexandra E. Olson, Note, *Dilution by Tarnishment: An Unworkable Cause of Action in Cases of Artistic Expression*, 53 B.C. L. REV. 693, 710–11 (2012) (“The Artistic Relevance Test operates under the rationale that artistic expression is a form of speech owed special protection under the First Amendment, but not absolute immunity.” (citing *Rogers*, 875 F.2d at 999)).

<sup>52</sup> *See Rogers*, 875 F.2d at 999.

<sup>53</sup> *Id.*

<sup>54</sup> *Id.*

<sup>55</sup> *Id.* at 1001.

<sup>56</sup> *Id.*

<sup>57</sup> *Id.*

<sup>58</sup> *Rogers*, 875 F.2d at 1001.

### B. *The Circuits Apply the Rogers Test Differently*

Since the Second Circuit's decision in *Rogers*, the Second, Sixth, Ninth, and Eleventh Circuits have adopted three different approaches to the *Rogers* balancing test.<sup>59</sup> The first approach, which uses the overall balancing test and the two-prong analysis found in *Rogers*, faithfully corresponds to the Second Circuit's reasoning in *Rogers*.<sup>60</sup> Under this standard, a trademark use is protected as long as it is artistically relevant to the underlying work and does not explicitly mislead regarding the source of the work.<sup>61</sup> Both the Sixth Circuit and the Eleventh Circuit (in *New Life Art*) have adopted this approach.<sup>62</sup> In 2003, in *ETW Corp. v. Jireh Publishing, Inc.*, the U.S. Court of Appeals for the Sixth Circuit became the first circuit to adopt this approach.<sup>63</sup> Golfer Tiger Woods sued an artist for using his image in a painting of Masters Tournament winners, alleging Lanham Act violations.<sup>64</sup> Utilizing the two-prong test articulated in *Rogers*, the court determined that the use of Woods's image in the painting was entitled to First Amendment protection.<sup>65</sup> The court reasoned that Woods's image was artistically relevant to the underlying work and that the artist did not explicitly mislead consumers to believe that Woods was involved in its production.<sup>66</sup> The court then applied these determinations to the overall *Rogers* balancing test.<sup>67</sup> It concluded that the artistic expression interests so outweighed the risk of consumer confusion in this case that the Lanham Act did not apply.<sup>68</sup>

The second approach uses the overall balancing test and the two-prong analysis found in *Rogers*, but when determining whether a

<sup>59</sup> See *infra* notes 60–81 and accompanying text.

<sup>60</sup> See *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 936–37 (6th Cir. 2003) (applying this standard to the use of a celebrity's likeness in a work of art); Byron, *supra* note 11, at 10–11 (citing *ETW Corp.* as a case that adopts this approach to the *Rogers* test).

<sup>61</sup> See *ETW Corp.*, 332 F.3d at 937; Byron, *supra* note 11, at 10–11.

<sup>62</sup> See *New Life Art*, 684 F.3d at 1278–79; *ETW Corp.*, 332 F.3d at 936–37; see also *supra* notes 36–39 and accompanying text (discussing the Eleventh Circuit's application of the *Rogers* overall balancing test and two-pronged analysis in *New Life Art*).

<sup>63</sup> See *ETW Corp.*, 332 F.3d at 936–37; Byron, *supra* note 11, at 10–11.

<sup>64</sup> *ETW Corp.*, 332 F.3d at 918–19. Woods's Lanham Act claims included trademark infringement, dilution of the mark, unfair competition, and false advertising. *Id.* at 919.

<sup>65</sup> *Id.* at 936–37.

<sup>66</sup> *Id.* at 936–37; Byron, *supra* note 11, at 11.

<sup>67</sup> *ETW Corp.*, 332 F.3d at 937.

<sup>68</sup> *Id.* But see *id.* at 945 (Clay, J., dissenting) (asserting that the majority should not have declared that the artist's inclusion of Woods's image in the painting was artistically relevant and not explicitly misleading without more meaningfully considering evidence from a survey of consumers about their beliefs of Woods's involvement in the work, as required, according to the dissent, under the *Rogers* test).

trademark use is explicitly misleading, this approach uses a likelihood of confusion analysis.<sup>69</sup> Thus, this approach differs from other applications of the “explicitly misleading” prong because instead of evaluating whether the artist conveyed that the trademark holder was involved in the work, this approach measures whether *consumers would be confused* as to the trademark holder’s involvement in the work.<sup>70</sup> In 2008, in *ESS Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, the U.S. Court of Appeals for the Ninth Circuit adopted this standard.<sup>71</sup> The defendant’s video game, “Grand Theft Auto,” featured a fictionalized version of the plaintiff’s Los Angeles strip club.<sup>72</sup> After determining that the use of the strip club’s image was artistically relevant to the game, the court turned its attention to the “explicitly misleading” prong.<sup>73</sup> The Ninth Circuit concluded that the proper inquiry regarding this prong was whether game players would be confused into thinking that the strip club was somehow affiliated with the video game.<sup>74</sup> The court then concluded that “reasonable consumer[s]” would not be confused as to the source of the trademark’s use because they would not believe that the strip club produced the video game or contributed its expertise in the defendant’s design of it.<sup>75</sup>

The third approach adopts the overall balancing test but does not use the two-prong test found in *Rogers*.<sup>76</sup> Instead of asking whether the use of the trademark is artistically relevant to the underlying work or explicitly misleads consumers as to the trademark holder’s involvement

---

<sup>69</sup> Byron, *supra* note 11, at 15 (citing *ESS Entertainment* as a case that adopts this approach to the *Rogers* test); see *ESS Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099–1100 (9th Cir. 2008) (applying this standard to the use of a strip club’s likeness in a video game).

<sup>70</sup> See *ESS Entm’t*, 547 F.3d at 1099–1100; see also *New Life Art*, 683 F.3d at 1278–79 (evaluating whether an artist marketed the work as being endorsed by or affiliated with the trademark holder); *ETW Corp.*, 332 F.3d at 937 (stating that the “risk of consumer misunderstanding not engendered by any explicit indication on [its] face” satisfies the explicitly misleading prong).

<sup>71</sup> See *ESS Entm’t*, 547 F.3d at 1099–1100; Byron, *supra* note 11, at 15.

<sup>72</sup> *ESS Entm’t*, 547 F.3d at 1097.

<sup>73</sup> *Id.* at 1100. The court determined that the use of the club’s image was “relevant” in recreating the “cartoon-style” parody of East Los Angeles that the producers sought. *Id.*

<sup>74</sup> *Id.*

<sup>75</sup> *Id.* at 1100–01. The court reached this determination based on its conclusion that the strip club and the video game have “nothing in common.” *Id.* at 1100. The court reasoned that the strip club and the game “do not go together,” consumers would not reasonably believe that Rockstar maintained a strip club or that ESS created the video game, and someone playing the video game would not think that ESS provided any expertise to Rockstar in the production of the game. *Id.*

<sup>76</sup> See *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989); Byron, *supra* note 11, at 12–13.

with the work, this approach utilizes a more free-form likelihood of confusion analysis to balance the public's competing interests in protecting artistic expression and avoiding confusion.<sup>77</sup> In 1989, four months after it decided *Rogers*, the U.S. Court of Appeals for the Second Circuit adopted this approach in *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group*.<sup>78</sup> Cliffs Notes alleged that Bantam violated the Lanham Act by publishing a parody of a Cliffs Notes study guide featuring a black and yellow cover that replicated Cliffs Notes's trademarked design.<sup>79</sup> Using a likelihood of confusion analysis, the court determined that the defendant's parody cover raised only a slight risk of consumer confusion, a concern the court held did not outweigh artistic expression concerns.<sup>80</sup> In reaching its conclusion, the court cited factors such as the nature of the work (a parody), the design of the work's cover, the sophistication of Cliffs Notes readers, and the prominence of the word "satire" on the parody's cover.<sup>81</sup>

### III. *NEW LIFE ART* PROVIDES CLARITY TO ARTISTS REGARDING THE SCOPE OF ACCEPTABLE TRADEMARK USES IN THEIR WORKS

In adopting its own version of the *Rogers* balancing test, the Eleventh Circuit in *New Life Art* used clear, comprehensible terms to describe the types of trademark uses that are shielded from Lanham Act claims.<sup>82</sup> Under the court's standard, artists may use others' trademarks in their works as long as the mark's use has some artistic relevance to the underlying work and does not explicitly mislead consumers as to the source or content of the work.<sup>83</sup> This reading of the *Rogers* test should be adopted by other courts because it grants artists great latitude to express themselves artistically while also providing artists,

---

<sup>77</sup> See *Cliffs Notes*, 886 F.2d at 495; Byron, *supra* note 11, at 13.

<sup>78</sup> *Cliffs Notes*, 886 F.2d at 495; Byron, *supra* note 11, at 12.

<sup>79</sup> *Cliffs Notes*, 886 F.2d at 492.

<sup>80</sup> *Id.* at 495. The court discussed the nature of parodies and noted that most consumers would recognize that the defendant's work was a parody that aimed to poke fun at Cliffs Notes study guides. *Id.* at 495–96.

<sup>81</sup> *Id.* at 495–97; see also Byron, *supra* note 11, at 13 (citing the factors that the *Cliffs Notes* court evaluated). With regard to potential customers of Cliffs Notes's works, the court noted that Cliffs Notes books are not likely to be bought as an impulse purchase and that prospective Cliffs Notes buyers have a specific book in mind when purchasing a study guide. *Cliffs Notes*, 886 F.2d at 496. The court concluded that although some purchasers may mistakenly think the parody is a serious work produced by Cliffs Notes, this concern does not outweigh the public interest in protecting free expression. *Id.*

<sup>82</sup> *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012).

<sup>83</sup> *Id.*

trademark holders, and the courts with a clear standard of which trademark uses are permitted and which are not.<sup>84</sup>

The Eleventh Circuit's faithful application of the *Rogers* test in *New Life Art* grants artists great latitude to express themselves, thus furthering the First Amendment's goal of protecting artistic expression.<sup>85</sup> The standard applied in *New Life Art* accomplishes this by setting a low threshold for artists' works to meet to be shielded from Lanham Act liability.<sup>86</sup> As the *New Life Art* court and the Sixth and Ninth Circuits have demonstrated, the "artistically relevant" prong of the *Rogers* test is easily satisfied.<sup>87</sup> Additionally, the Eleventh Circuit's holding indicates that, under the "explicitly misleading" prong, a trademark use is protected as long as the artist does not represent that the trademark holder "sponsored" or "endorsed" the work or the use of the trademark.<sup>88</sup>

Moreover, the standard articulated in *Rogers* and applied in *New Life Art* provides artists, trademark holders, and ultimately the courts with greater clarity as to which types of trademark uses are permitted and which are not.<sup>89</sup> When other courts, including the district court in

---

<sup>84</sup> See *infra* notes 85–93 and accompanying text; see also Elizabeth L. Rosenblatt, *Rethinking the Parameters of Trademark Use in Entertainment*, 61 FLA. L. REV. 1011, 1074, 1076–78 (2009) (proposing, in an article published prior to *New Life Art*, a Lanham Act test which closely resembles the one used by the Eleventh Circuit, as it would provide greater predictability and clarity as to what types of trademark uses are protected).

<sup>85</sup> See *New Life Art*, 683 F.3d at 1282; see also Pratheepan Gulasekaram, *Policing the Border Between the Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 WASH. L. REV. 887, 893 (2005) ("In infringement claims, the parameters of trademark law and free expression are best assessed by the *Rogers* framework, which balances the public interest in protecting the use of trademarks as a source-identifier with the public interest in free speech.").

<sup>86</sup> See *New Life Art*, 683 F.3d at 1278–79; Ramsey, *supra* note 31, at 906 ("Per the Ninth Circuit, this factor is satisfied as long as the work has more than 'zero' relevance, which is a very low standard." (footnote omitted)).

<sup>87</sup> See *New Life Art*, 683 F.3d at 1278–79 (holding that the depictions of the university's uniforms were artistically relevant because they were "needed for a realistic portrayal of famous scenes from Alabama football history"); *ESS Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) (holding that an image of a strip club was artistically relevant to the creator's goal of producing a "cartoon-style" version of a city); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 937 (6th Cir. 2003) (holding that an image of Tiger Woods was artistically relevant to a painting featuring golf tournament winners).

<sup>88</sup> See *New Life Art*, 683 F.3d at 1278–79 (holding that trademark use was not subject to Lanham Act scrutiny because its use was artistically relevant and did not explicitly mislead as to its source); see also *ETW Corp.*, 332 F.3d at 936–37 (same). The approach taken in 2003 in *ETW Corp. v. Jireh Publishing, Inc.* by the Sixth Circuit is also an artist-friendly standard because "it is hard to imagine many uses of third party trademarks within a work that would run afoul of the *Rogers* test as applied by *ETW Corp.*" Byron, *supra* note 11, at 11.

<sup>89</sup> See *New Life Art*, 683 F.3d at 1278–79; see also Rosenblatt, *supra* note 84, at 1077 (proposing a test that is similar to the *New Life Art* standard that steers clear of the "morass" of a likelihood of confusion analysis).

*New Life Art*, have analyzed this type of case, they have engaged in a thorough and often time-consuming analysis of the work of art, the nature of the trademark, and consumer perceptions regarding the trademark's use in the work.<sup>90</sup> Under *New Life Art's* reading of the *Rogers* test, artists and courts need not concern themselves with weighing interests or conducting a consumer confusion analysis to determine whether a particular trademark use is protected.<sup>91</sup> As long as the two-prong *Rogers* test is satisfied, the artist's works are shielded from Lanham Act claims.<sup>92</sup> This standard should give artists the confidence to use others' trademarks in their works without fear of liability while also allowing courts to dismiss these types of Lanham Act claims early in the litigation process without having to engage in a probing analysis of the artist's use of the trademark.<sup>93</sup>

### CONCLUSION

The Eleventh Circuit's decision in *New Life Art* addressed the balance courts should strike when evaluating Lanham Act trademark claims involving works of artistic expression. Adopting the test articulated by the U.S. Court of Appeals for the Second Circuit in 1989 in *Rogers v. Grimaldi*, the Eleventh Circuit concluded that the Lanham Act should apply to works of artistic expression only in situations in which the public interest in avoiding confusion outweighed the public interest in artistic expression. The court further concluded that the public interest in avoiding confusion does not outweigh the public interest in artistic expression unless the artist's use of another's trademark is not artistically relevant to the underlying work or the artist explicitly misleads as to the trademark holder's sponsorship or endorsement of the mark's use.

The Eleventh Circuit's decision is a victory for artists seeking to use others' trademarks in their works. The standard applied by the court

---

<sup>90</sup> See *ESS Entm't*, 547 F.3d at 1100; *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 495–97 (2d Cir. 1989); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 677 F. Supp. 2d 1238, 1249–50 (N.D. Ala. 2009); see also William McGeeveran, *The Trademark Fair Use Reform Act*, 90 B.U. L. REV. 2267, 2275 (2010) (arguing that although artists usually are victorious in Lanham Act suits, the process of defending these suits is “uncertain, lengthy, and expensive”).

<sup>91</sup> See *New Life Art*, 683 F.3d at 1278.

<sup>92</sup> See *id.*

<sup>93</sup> See Rosenblatt, *supra* note 84, at 1076–78; *supra* notes 89–92 and accompanying text. Greater clarity as to the types of trademark uses that are permitted will reduce risk aversion on the part of artists. Rosenblatt, *supra* note 84, at 1076–78; see McGeeveran, *supra* note 90, at 2276.

shields most trademark uses in works of artistic expression from Lanham Act scrutiny and provides clarity to artists as to which types of trademark uses are protected and which types are not. Because it protects artists and provides artists, trademark holders, and courts with clarity, the standard articulated in *Rogers*, as applied by *New Life Art*, should be adopted by other courts.

NICHOLAS MACRI

**Preferred Citation:** Nicholas Macri, Comment, *Holding Back the (Crimson) Tide of Trademark Litigation: The Eleventh Circuit Shields Works of Art from Lanham Act Claims in New Life Art*, 54 B.C. L. REV. E. SUPP. 71 (2013), <http://lawdigitalcommons.bc.edu/bclr/vol54/iss6/7>.

