



## When Does the First Amendment Trump Trademark Law? 11<sup>th</sup> Circuit Adopts *Rogers v. Grimaldi* Test

September 10, 2012

By [Janet Marvel, Partner](#)

In 1989, the Second Circuit adopted a balancing test to weigh the value of an artist's First Amendment rights against the value of trademarks depicted in the artist's work. *Rogers v. Grimaldi*, 875 F.2d 994 (9<sup>th</sup> Cir. 1989). In June of this year, the 11<sup>th</sup> Circuit adopted essentially the same test in *University of Alabama Board of Trustees v. New Life Art, Inc.*, 683 F.3d 1266 (11<sup>th</sup> Cir. June 11, 2012).

### Some Background

In *Rogers v. Grimaldi*, 875 F.2d 994 (9<sup>th</sup> Cir. 1989), Ginger Rogers sued over an Italian film titled "Ginger and Fred," which was about two cabaret performers who imitated Ginger Rogers and Fred Astaire. Ms. Rogers alleged violations of her rights under the federal trademark statute (the Lanham Act) and of her right of publicity under state law. The district court dismissed the claim and the Second Circuit affirmed. The court stated that enjoining the distribution of artistic works does not violate the First Amendment where the public interest in avoiding consumer confusion outweighs the public interest in free expression. For movie titles, the court stated that unless the title had no artistic relevance to the underlying work or was expressly misleading, no injunction should issue. Other courts have adopted similar tests, including the Sixth Circuit, in *ETW v. Jireh Publishing, Inc.*, 332 F.3d 915 (6<sup>th</sup> Cir. 2003), where the court permitted defendant's use of Tiger Woods' name on the inside flap of an envelope containing an art print featuring his image, and in the narrative description for the print. See also *ESS Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9<sup>th</sup> Cir. 2008) (scene in a video game featuring trademark of plaintiff's entertainment club did not infringe plaintiff's trademark rights).

### The Crimson and White

In *University of Alabama Board of Trustees v. New Life Art, Inc.*, 683 F.3d 1266 (11<sup>th</sup> Cir. June 11, 2012), the University sued an artist who, for over thirty years, had painted and sold images of plays



PATTISHALL  
McAULIFFE  
NEWBURY  
HILLIARD &  
GERALDSON LLP • 311 South Wacker Drive, Suite 5000 • Chicago IL 60606 • T (312) 554-8000 • F (312) 554-8015 • [www.pattishall.com](http://www.pattishall.com)

These materials have been prepared by Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP for general informational purposes only. They are not legal advice. They are not intended to create, and their receipt by you does not create, an attorney-client relationship.

in University of Alabama football games. The parties had entered into various licensing agreements, apparently licensing some University of Alabama logos, among other things. In 2002, the University demanded that the artist take a license for all of his works because they depicted University uniforms in the colors crimson and white, which the University stated were its trademarks. The artist declined, arguing that he did not need a license to depict University trademarks within his images.

The court separately considered the parties' respective rights in calendars, and large-size paintings and prints, and "mundane products," comprising such things as "mini-prints," mugs, cups, flags, and towels.

In its discussion with respect to paintings, prints and calendars, the court adopted the following *Rogers v. Grimaldi*-like test:

[W]e have no hesitation in joining our sister circuits by holding that we should construe the Lanham Act narrowly when deciding whether an artistically expressive work infringes a trademark. This requires that we carefully weigh the public interest in free expression against the public interest in avoiding consumer confusion. An artistically expressive use of a trademark will not violate the Lanham Act unless the use of the mark has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless it explicitly misleads as to the source or the content of the work.

*Id.* at 1278, internal quotations and citations omitted.

The court then concluded that the artist's depiction of University uniforms was "artistically relevant to the expressive underlying works because the uniforms' colors and designs are needed for a realistic portrayal of famous scenes from Alabama football history." Therefore, the First Amendment rights of the artist outweighed any possible confusion regarding the University's association with the works, and there could be no trademark infringement.

Interestingly, the court remanded the issue of whether the artist was required to license uniform images for use on "mundane products" because the parties' licensing agreement was ambiguous on whether it applied to such products. While at first glance, this leaves the door open to an interesting argument that First Amendment concerns merit different weight when the same image is used on different products, this is unlikely. The artist waived on appeal his First Amendment arguments with respect to mundane items.

### **Take-Aways**

In the *University of Alabama* case, the parties failed to carefully delineate, and amend as necessary, the specific marks and items to which their license agreement applied. This is a common problem, and ambiguous language in licensing agreements is the cause of fairly frequent litigation. Specific marks and goods should be listed in exhibits to licenses. A broad license simply stating that one party licenses "his trademarks" is very likely to be considered ambiguous, and cause trouble later.

In addition, companies, particularly non-profit entities, and actors, athletes and other would-be celebrities need to consider and protect their rights early. Often, such entities and persons only assert trademark rights after they have become popular, or a problem has arisen. They then have to play catch-up to prove that the popularized slogans and images belong to them, not to another trademark applicant or to the public generally. One should audit, evaluate and protect rights early, and reevaluate a trademark portfolio regularly to ensure that rights are protected. A trademark lawyer can help evaluate how, and in which cases, to protect and assert trademark rights in images.

\* \* \*

*Janet Marvel is a partner with [Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP](#), a [leading intellectual property law firm](#) based in Chicago, Illinois. Pattishall McAuliffe represents both plaintiffs and defendants in [trademark](#), [copyright](#), and [unfair competition trials and appeals](#), and advises its clients on a broad range of domestic and international intellectual property matters, including [brand protection](#), [Internet](#), and [e-commerce](#) issues. Ms. Marvel's practice focuses on litigation, transactions, and counseling in domestic and international [trademark](#), [trade dress](#), [Internet](#), and [copyright law](#). She co-authored the Fifth Edition of the [Trademarks and Unfair Competition Deskbook](#), recently published by LexisNexis.*