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Shakin' It to the Back of the Bus: How Parks v. LaFace Uses the Artistic Relevance Test to Adjudicate Artistic Content

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Shakin' It to the Back of the Bus: How *Parks v. LaFace* Uses the Artistic Relevance Test to Adjudicate Artistic Content

Mitchell David Greggs*

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I. Introduction

In our current society most people can access a staggering volume of information with a speed and frequency unimaginable at the turn of the century.¹ With this change, the arts have become both more commercial and more influential in the life of the public as a whole.² As a result, more people have commercial access to artistic works such as music, literature, and movies.³ These informational advances and commercial distribution methods have created new popular forms of art that enjoy less prestige than more traditional forms.⁴ For example, despite one's personal preferences, opera is generally regarded as a more sophisticated form of music than rap.⁵ Beauty is truly in the eye of the beholder though, and, as a rule of thumb, these hierarchies seem to equate age and accessibility with quality.⁶ Arguably, if something is new and widely available, it cannot be as good as something that is old or exclusive.⁷

1. See JOHN A. WALKER, *ART IN THE AGE OF MASS MEDIA* 9 (1994) ("Some historians regard the invention of printing as the beginning of the age of mass media, but a situation in which billions of individuals are exposed daily to a spectrum of powerful mass media is surely a uniquely twentieth-century experience.").

2. See *id.* ("A characteristic common to the mass media is the use of machines such as cameras, projectors, printing presses, computers and satellites to record, edit, replicate and disseminate images and information. . . . The mass media make possible . . . cultural products which are cheap, plentiful, widely available and capable of rapid distribution.").

3. See *id.* (noting that "billions of people have become consumers of culture . . . produced by others").

4. See NOËL CARROLL, *A PHILOSOPHY OF MASS ART* 184-211 (1998) (presenting a definition of mass art, called popular art by some, and detailing both support and criticism of its artistic merit).

5. See Hal Crowther, *Are We Witnessing the Slow Death of Culture?*, in *IMPACT OF MASS MEDIA: CURRENT ISSUES* 418, 422 (Ray Eldon Heibert ed., 4th ed. 1999) (expressing the view that "the swine who run . . . recording companies sell murder, misogyny, anarchy, rough sex, racism and perversion to 14-year-old nihilists. . . . Not 10 percent of these rabid lyrics represent honest political or artistic expression"). But see Mary Ann Marger, *Calling it Art Doesn't Always Make it So*, *ST. PETERSBURG TIMES* (Florida), July 3, 1993, at 7B (noting that "[f]ine art abides in museums, libraries, and concert halls, . . . but it also bursts forth clamorously from urban muralists, rappers, break dancers, junk yard sculptors").

6. See CARROLL, *supra* note 4, at 89 (summarizing arguments against the new "mass art" by describing it as formulaic, not unique, and a commodity).

7. See Marger, *supra* note 5, at 7B ("Popular art . . . is instantly accessible; enjoyable for the moment, even if we have reservations; and ultimately so conventional and predictable that it is an insult to the intellect and the imagination.").

Socially this phenomenon is harmless, but when the legal community applies different levels of protection for artists based upon whether their art carries a favorable reputation among the general public, society faces an unconscionable stifling of speech.⁸ Speech, despite being presented in a vehicle sold for profit, deserves First Amendment protection.⁹ Further, the sale of expressive material does not deprive it of the full scope of First Amendment protection.¹⁰ "Music, as a form of expression and communication, is protected under the First Amendment."¹¹ The Sixth Circuit's decision in *Parks v. LaFace Records*¹² highlights the fact that the Artistic Relevance Test, as developed by the Second Circuit in *Rogers v. Grimaldi*,¹³ allows courts to stifle protected speech by focusing on the content of a protected work rather than on whether the use of the protectable interest is misleading in a commercial manner.

As noted by recent commentary, cases such as *Parks* present the unique situation in which the title of a creation is itself expressive and not merely a description of the underlying work.¹⁴ Because of their expressive nature, such titles deserve more protection than the increasingly popular Artistic Relevance Test provides. Under current law, an artist choosing to use a public figure, or a recognizable mark that has gained an expressive element, anywhere in the title of a work has no assurance of avoiding a lawsuit.¹⁵ Interestingly, if the public reacts favorably to the artistic creation, the artist runs a higher risk of facing a suit by the markholder because of the increased publicity of the work.

8. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (noting, in a Justice Holmes opinion concerning copyright, that "works are not the less connected with the fine arts because their pictorial quality attracts the crowd, and therefore gives them a real use,—if use means to increase trade and to help to make money").

9. See *Smith v. California*, 361 U.S. 147, 150 (1959) ("It is of course no matter that the dissemination [of the speech] takes place under commercial auspices.").

10. See *City of Lakewood v. Plain Dealer Publ'g Co.*, 486 U.S. 750, 756 n.5 (1988) (noting that "the degree of First Amendment protection is not diminished merely because the newspaper or speech is sold rather than given away").

11. *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989).

12. *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003). Discussed in depth *infra* at Part III.C.

13. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Discussed in depth *infra* at Part III.C.

14. See Kerry L. Timbers & Julia Huston, *The "Artistic Relevance Test" Just Became Relevant: The Increasing Strength of the First Amendment as a Defense to Trademark Infringement and Dilution*, 93 TRADEMARK REP. 1278, 1301 (2003) (presenting the question of whether the courts will "extend First Amendment protection to marks used in titles which are themselves expressive").

15. See *infra* Part IV.C (noting that artists have no assurance of avoiding a lawsuit when using a celebrity's name in the title of an artistic work).

Traditionally, public figures have guarded the use of their names and likenesses with actions invoking the rights of publicity and privacy.¹⁶ But the increasing alternative pleading of right of publicity cases as trademark cases has led the judicial system into a tight spot.¹⁷ Courts are stuck with the challenging task of trying to reconcile property rights with constitutional rights.¹⁸ The Artistic Relevance Test represents a high water mark of First Amendment protection for infringing uses of a mark in the title of an artistic work.¹⁹ However, despite this test's status as the best recent alternative for balancing speech concerns with commercial concerns, it still falls short in cases involving the titles of artistic works. Its central weakness lies in allowing a sympathetic plaintiff such as Rosa Parks to go forward with her case, and requiring the court to examine and make a determination, whether factual or legal, as to the meaning, and indirectly the merits, of the content of an artistic work.²⁰ The courts should have no right to do this.²¹

This Note will focus on how the application of trademark law principles to titles of artistic works containing the name or likeness of a celebrity, or a mark that has developed an expressive meaning, requires the court to make content determinations about those artistic works that can keep artists involved in protracted litigation, thus running the risk of stifling artistic speech. It will first provide a brief analysis of the evolution of section 43(a) of the Lanham Act in order to show its origin in consumer protection.²² This Note will then examine each test used by the circuit courts to balance the free speech interests of an

16. See 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28.01[3] (3d ed. 1992) (explaining that the right to privacy and right to publicity are two distinct rights, the former usually involving a "mental distress," and the latter usually involving a commercial damage, but both arising from an unauthorized use of a person's identity).

17. See generally Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158 (1982) (presenting an early analysis of the potential problems surrounding the increasing protections for trademarks in the judicial system).

18. See, e.g., *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664 (5th Cir. 2000) (describing the tension between the protection afforded by the Lanham Act and the protection afforded by the First Amendment).

19. See *Timbers & Huston*, *supra* note 14, at 1300 (noting that the Artistic Relevance Test typically favors the artist defendant).

20. See *infra* Part IV.C (discussing how the Artistic Relevance Test fails to adequately protect artists' right to choose an expressive title for an artistic work).

21. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) ("It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.").

22. See *infra* Part II (discussing the purpose behind the initial enactment of section 43(a) of the Lanham Act).

artist against the property interests of a markholder asserting a claim under section 43(a).²³ Also, it will assert that the Artistic Relevance Test is superior to the Alternative Avenues Test and the Likelihood of Confusion Test because it does not rely as heavily upon judicial hindsight and because it provides more direction to future artists.²⁴ Further, this Note will describe how *Parks* highlights a shortcoming of the Artistic Relevance Test when used to analyze an allegedly infringing use of a mark in the title of an artistic work by asking the legal system to make an artistic judgment concerning what a work of art means in order to determine if the title misleads as to content.²⁵ It will explain that this determination is not crucial in a society in which the consumer has more opportunity than ever before to preview the contents of an artistic work such as a book or an album, even when purchasing the work over the Internet.²⁶ Finally, this Note will conclude that the appropriate judicial analysis of Lanham Act claims for the use of a celebrity's name or likeness or an expressive mark in the title of an artistic work should revolve around an implication of endorsement or sponsorship, and not a judicial determination of artistic content.²⁷

II. Reasons for the Enactment of Section 43(a) of the Lanham Act and Its Relation to the Right of Publicity

Section 43(a) of the Lanham Act provides that:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false

23. See *infra* Part III (examining the various tests developed by the courts to deal with these claims).

24. See *infra* Part III.D (explaining how the Artistic Relevance Test has increased in popularity and application).

25. See *infra* Part IV.C (examining the shortcomings of the Artistic Relevance Test).

26. See *infra* Part IV.E (describing consumer opportunities to preview artistic works before purchasing them).

27. See *infra* Part IV.D (concluding that courts should abandon the application of the content prong of the Artistic Relevance Test when applied to expressive titles of artistic works). Surely under this test one could give a cookbook the title "The Unauthorized Biography of Rosa Parks." While this would explicitly avoid the endorsement question and might allow profiting from the name of someone else, this practice does not seem to present a real danger. Conceivably, a reader would examine the back cover, or a few pages, of the book and readily be able to determine that the content has nothing to do with the title or the use of the celebrity's name.

or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.²⁸

In application, the section provides a federal cause of action under two prongs—trademark infringement and false advertising.²⁹ According to J. Thomas McCarthy, "[s]ection 43(a) was originally envisioned as a federal anti-false advertising statute, with emphasis on the 'false description or representation' language."³⁰ Further, the drafters intended that the "false designation of origin" language would apply only to false indications of geographical origin.³¹ But, as McCarthy notes, the section expanded far beyond the envisioned application, allowing for the assertion of infringement of unregistered marks and names³² and applying to representations of the "origin of source of manufacture."³³ With respect to false advertising, section 43(a) focuses on protecting the consumer from false and misleading marks.³⁴ According to the 1989 version of the statute, this section prohibits both misleading and false advertisements.³⁵

In contrast, the right of publicity represents the "the inherent right of every human being to control the commercial use of his or her identity."³⁶ According

28. 15 U.S.C. § 1125(a)(1) (2000).

29. 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27.02[3] (3d ed. 1992).

30. *Id.* § 27.03[1][b].

31. *See id.* (noting that the phrase was thought to be limited to geographic origin).

32. *See id.* (stating that when suing for the infringement of an unregistered mark, "plaintiff must prove both validity and infringement, unaided by any presumptions").

33. *Id.*

34. *See id.* § 27.04[1][b] ("[Section] 43(a) is designed to protect the right of the consumer to be told the truth.").

35. *See id.* § 27.07[2][c] ("[T]he 1989 version codifies the case law finding that 'misleading' advertisements are prohibited in addition to literally 'false' advertisements.").

36. *Id.* § 28.01[1].

to this characterization, the right of publicity exists as a form of intellectual property.³⁷ McCarthy distinguishes the rights of a trademark holder from the right of publicity by noting a few key differences. Most importantly, "the right of publicity had its origins in the law of 'privacy,' whereas the law of trademarks had its origins in the tort of fraud."³⁸ The test for infringement used to evaluate claims constitutes a further difference.³⁹ While trademark cases are examined under a likelihood of confusion, mistake, or deception standard,⁴⁰ right of publicity cases are examined under a test of identifiability.⁴¹ Also, a trademark identifies the goods of a manufacturer or merchant, distinguishing them from those manufactured or sold by others, but the right of publicity identifies the "persona" of a single human being.⁴² Notably, this does not mean that a persona cannot serve as both a trademark and a property interest under the right of publicity.⁴³ Rather, this distinction only gives rise to "parallel legal theories protecting different aspects of the same indicia [that are] not inconsistent in any way."⁴⁴ As such, "a given plaintiff might well have a claim for infringement of *both* a trademark or service mark *and* of the right of publicity."⁴⁵

III. The Various Tests

Because of the confusingly similar rights and the complex issues involved, circuit courts historically have divided over how to balance the First Amendment and the Lanham Act. Three tests deserve note. First, the Likelihood of Confusion Test applies the traditional trademark likelihood of confusion factors with very little regard for the free speech concerns of the

37. *See id.* ("The right of publicity is property, and is properly categorized as a form of intellectual property.").

38. *Id.* § 28.02[1].

39. *See id.* § 28.02[5] (presenting the different tests used to evaluate trademark infringement claims and right of publicity claims).

40. *See id.* (noting that modern trademark cases are examined for likelihood of confusion of source, sponsorship, or affiliation).

41. *See id.* (noting that the right of publicity is triggered "if a more than insignificant number of people identify the object person from the defendant's unpermitted commercial use").

42. *See id.* § 28.02[3] ("While a trademark identifies a single commercial source, the right of publicity involves identification of the 'persona' of a single human being.").

43. *See id.* (explaining that even if a person's name, likeness, or voice, among other things, is used as a trademark, it continues to be protectable under the right of publicity).

44. *Id.*

45. *Id.*

artist, and if a likelihood of confusion exists, the case will survive summary judgment and go to trial.⁴⁶ Second, the Alternative Avenues Test provides no First Amendment protection if the artist could have used alternate, non-infringing means to convey the same message.⁴⁷ Third, the Artistic Relevance Test denies First Amendment protection if the use of the mark has no artistic relevance to the underlying content of the work, or if it does have artistic relevance, if the use proves explicitly misleading as to content or endorsement.⁴⁸

Each test builds upon its predecessors, and because these cases are brought under trademark law, the likelihood of confusion factors is a staple of each.⁴⁹ Despite this similarity, each test has developed with a forgivably limited amount of foresight. The Alternative Avenues Test recognizes the need to protect speech in an increasingly commercial environment, yet it asks too much of a judge and provides too little guidance for an artist. The best balancing of these concerns occurs under the Artistic Relevance Test. However, as highlighted by *Parks*, even this test proves inadequate when applied to the title of an artistic work.⁵⁰

A. The Likelihood of Confusion Test

The Likelihood of Confusion Test applies trademark law's traditional likelihood of confusion factors and attempts to balance that likelihood of confusion against the defendant's First Amendment rights.⁵¹ Though the factors involved in analyzing the likelihood of confusion differ according to

46. See *infra* Part III.A (explaining the development and application of the Likelihood of Confusion Test).

47. See *infra* Part III.B (explaining the development and application of the Alternative Avenues Test).

48. See *infra* Part III.C (explaining the development and application of the Artistic Relevance Test).

49. See *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403–06 (9th Cir. 1997) (applying the likelihood of confusion factors in a Likelihood of Confusion Test analysis); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 774–75 (8th Cir. 1994) (applying the likelihood of confusion factors in an Alternative Avenues Test analysis); *Twin Peak Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379–80 (2d Cir. 1993) (remanding the case for analysis of the likelihood of confusion factors in an Artistic Relevance Test analysis).

50. See *infra* Part IV.C (explaining why the Alternative Avenues Test proves inadequate to protect the rights of artists using an expressive mark or a celebrity's name in the title of an artistic work).

51. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 966–67 (10th Cir. 1996) (applying the Likelihood of Confusion Test in a case involving an alleged violation of the Lanham Act and a violation of the players' right to publicity).

jurisdiction, "there is little substantive distinction in the various versions applied by the courts."⁵² Currently only the Tenth Circuit employs the Likelihood of Confusion Test.⁵³

In *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, the Tenth Circuit used that test to determine whether Cardtoons violated the trademark and publicity rights of the player-members of the Major League Baseball Players Association (MLBPA) by using their likenesses on parody trading cards.⁵⁴ After learning of Cardtoons's intention to produce trading cards presenting parodies of famous Major League Baseball players, the MLBPA wrote cease and desist letters to both Cardtoons and the company hired to print the cards.⁵⁵ Cardtoons filed suit seeking a declaratory judgment that the cards did not violate any rights of the MLBPA.⁵⁶ Ultimately, after referral to a magistrate and two opinions, the district court held that a fair use analysis of the Oklahoma right of publicity statute required the recognition of a parody exception and issued a declaratory judgment in favor of Cardtoons.⁵⁷

Cardtoons dealt more explicitly with the right of publicity than with the trademark aspects of the case⁵⁸ because Cardtoons's playing cards were an obvious parody of the players' likenesses and common media representations.⁵⁹ In fact, beginning with the first sentence of the opinion, the court refers to the cards exclusively as "parody trading cards."⁶⁰ In upholding the district court's determination that the cards did not violate the MLBPA's trademark rights under the Lanham Act, the court relied on the fact that the cards were parodies, noting that "Cardtoons' success depends upon the humorous association of its parody cards with traditional, licensed baseball cards, not upon public confusion as to the source of the cards."⁶¹

52. 2 JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 5.01[3][c][i] (2003).

53. See *Parks v. LaFace Records*, 329 F.3d 437, 447-48, 450 (6th Cir. 2003) (noting that the Tenth Circuit has endorsed this approach, the Ninth Circuit once used this approach, a pre-*Rogers v. Grimaldi* Second Circuit case used the test, and adopting the Artistic Relevance Test).

54. See *Cardtoons*, 95 F.3d at 966-67 (presenting the court's analysis of the trademark issues presented by Cardtoons's cards).

55. *Id.* at 963.

56. *Id.* at 964.

57. *Id.*

58. See *id.* at 967-76 (analyzing the balance between the MLBPA's rights to publicity with Cardtoons's First Amendment rights).

59. See *id.* at 962-63 (describing in detail the use of the players' likenesses on the parody cards).

60. *Id.* at 962.

61. *Id.* at 967. Parody presents a different issue than those found in this Note. As expressed by many cases and, notably, by the Supreme Court in *Campbell v. Acuff-Rose Music*,

Further, *Cardtoons* did not detail the application of the Likelihood of Confusion Test.⁶² For a more detailed analysis of the application of the Likelihood of Confusion Test in a similar situation, the Ninth Circuit's decision in *Dr. Seuss Enterprises, L.P. v. Penguin Books*⁶³ proves useful,⁶⁴ even though the Ninth Circuit later abandoned this approach.⁶⁵ There, the court decided to use an eight-factor test in determining whether a likelihood of confusion existed between the work in question and the existing trademark.⁶⁶ The eight factors consisted of: "(1) 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; (8) likelihood of expansion of the product lines."⁶⁷ The court noted that several other variations of this test had arisen within the Ninth Circuit, most consisting of fewer factors, but chose the eight-factor test "simply to be over-inclusive."⁶⁸ The court also

Inc., 510 U.S. 569 (1994), parody enjoys considerable First Amendment protection.

62. See *id.* at 966–67 (providing only a brief definition of the Likelihood of Confusion Test).

63. *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997). In *Dr. Seuss*, the Ninth Circuit affirmed the entry of a preliminary injunction barring the release of *The Cat NOT in the Hat! A Parody by Dr. Juice*, which allegedly infringed on copyrights and trademarks associated with *The Cat in the Hat* by Dr. Seuss. *Id.* at 1406. Initially the district court denied Dr. Seuss's request for a temporary restraining order blocking the production of the parody and set a hearing date for the preliminary injunction, which it eventually granted. *Id.* at 1397. Upon the issuance of the injunction, about 12,000 books, at a cost of approximately \$35,000, had been printed. *Id.* Upon reconsideration, the court refused to dissolve the preliminary injunction, finding that Dr. Seuss had established:

(1) a strong likelihood that [the defendants] had taken substantial protected expression from *The Cat in the Hat* . . . ; (2) a strong likelihood of success on the copyright claim raising a presumption of irreparable harm; (3) a strong likelihood of success on the parody as fair use issue; (4) serious questions for litigation and a balance of hardships favoring Seuss on the trademark violations; and (5) a minimal likelihood of success on the federal dilution claim.

Id. Penguin Books filed an interlocutory appeal to the Ninth Circuit. *Id.* The Ninth Circuit, applying a fair use analysis to the copyright claims and the Likelihood of Confusion Test to the trademark claims, determined that the application of each test left substantial questions for litigation, and affirmed the district court's preliminary injunction. *Id.* at 1406.

64. See *id.* at 1403–06 (examining the application of the Likelihood of Confusion Test in detail).

65. See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003) (adopting the Artistic Relevance Test).

66. See *Dr. Seuss*, 109 F.3d at 1404 ("The eight-factor *Sleekcraft* test is used in the Ninth Circuit to analyze the likelihood of confusion question in all trademark infringement cases . . . " (citing *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979))).

67. *Id.* at 1404.

68. *Id.* at 1404 n.13. Other variations of the test include five and six factor versions. See,

recognized three types of proof of likelihood of confusion: "(1) survey evidence; (2) evidence of actual confusion; and (3) an argument based on an inference arising from a judicial comparison of the conflicting marks themselves and the context of their use in the marketplace."⁶⁹ The court further observed that under the Likelihood of Confusion Test "doubts are resolved in favor of the senior user."⁷⁰

In applying the enumerated factors, the court agreed with the district court's conclusions that the results were indeterminate and that questions remained for litigation.⁷¹ The trademarks enjoyed wide recognition, there existed substantial proximity and similarity between the marks and the infringing items, and the infringing user could have planned the similarity of the marks to entice customers and attract consumer attention. Because of the injunction, though, no evidence of actual confusion existed, and marketing channels and likely expansion of the product lines could not be assessed, rendering the application of the Likelihood of Confusion Test indeterminate at the preliminary injunction stage of the trial.⁷² As such, the court refused to disturb the district court's injunction.⁷³

e.g., *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1179 (9th Cir. 1988) (describing a six-factor test comprised of "1) the strength or weakness of the marks; 2) similarity in appearance, sound, and meaning; 3) the class of goods in question; 4) the marketing channels; 5) evidence of actual confusion; and 6) evidence of the intention of defendant in selecting and using the alleged infringing name"); *Rodeo Collection, Ltd. v. W. Seventh*, 812 F.2d 1215, 1217 (9th Cir. 1987) (describing a five-factor test comprised of "a) The strength of the registered service mark. b) The relationship between the services identified by the competing service marks. c) The similarity of the competing service marks. d) The evidence of actual confusion. e) The junior user's intent in adopting its service mark"); *J.B. Williams Co. v. Le Conte Cosmetics, Inc.*, 523 F.2d 187, 191 (9th Cir. 1975) (describing a six-factor test comprised of "the strength or weakness of the marks, similarity in appearance, sound and meaning, the class of goods in question, the marketing channels, evidence of actual confusion, and evidence of the intention of defendant in selecting and using the alleged infringing name" (footnote omitted)).

69. *Dr. Seuss*, 109 F.3d at 1404 n.14.

70. *Id.*

71. *See id.* at 1406 (concluding that "the district court's determinations on the existence of serious questions for litigation and a balance of the hardships favoring *Seuss* are not clearly erroneous").

72. *See id.* at 1404-05 (outlining the court's analysis of the Likelihood of Confusion Test factors).

73. *Id.* at 1406.

In *Mattel, Inc. v. MCA Records, Inc.*,⁷⁴ the Ninth Circuit limited the application of this test by determining that it did not apply when a trademark owner "asserts a right to control how we express ourselves."⁷⁵ The court distinguished the case from *Dr. Seuss* by noting that the song "does not rely on the Barbie mark to poke fun at another subject but targets Barbie herself," unlike *The Cat NOT in the Hat!*, which "borrowed Dr. Seuss's trademarks and lyrics to get attention rather than to mock *The Cat in the Hat!*!"⁷⁶ According to this analysis, ignoring the expressive value that some marks assume⁷⁷ could allow trademark rights to encroach upon the zone protected by the First Amendment.⁷⁸ In response to these concerns, the Ninth Circuit adopted the Artistic Relevance Test for addressing literary titles.⁷⁹ It would appear, however, that the Likelihood of Confusion Test still applies to cases similar to *Dr. Seuss*, in which the alleged infringing use of the trademarks and copyrights has no critical bearing on the substance or style of the senior use and as such does not warrant First Amendment protection.⁸⁰ Notably, this distinction requires a determination as to whether the artistic work's content has a critical bearing on the substance or style of the senior use.

74. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003). *Mattel*, a case dubbed "Speech-Zilla meets Trademark Kong" by Judge Kozinski, found *Mattel*, the owner of trademarks associated with the popular Barbie doll, suing MCA for trademark infringement and dilution as a result of the song *Barbie Girl* by the Danish band Aqua. *Id.* at 898-99. *Mattel* brought suit against the music companies who produced, marketed, and sold the song. *Id.* at 899. The district court granted summary judgment for MCA on *Mattel*'s claims for trademark infringement and dilution and also granted summary judgment for *Mattel* on MCA's resulting defamation claim. *Id.* *Mattel* appealed the district court's determination that *Barbie Girl* was a parody and a nominative fair use. *Id.* The Ninth Circuit determined that when a trademark owner asserts a right to control how we express ourselves, the traditional Likelihood of Confusion Test fails to account for the full weight of the public's interest in free expression. *Id.* at 900. As such, the Ninth Circuit adopted the Artistic Relevance Test. *Id.* at 902. Under this test, the court determined that Aqua's use of the Barbie mark in its song was in fact protected from challenge, and thus summary judgment was appropriate. *Id.* at 902, 907.

75. *Id.* at 900.

76. *Id.* at 901.

77. *See id.* at 900 (noting that common expressions denote an object of luxury and quality "the Rolls Royce of its class" and a quick-fix a Band-Aid).

78. *See id.* ("[T]he trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function.").

79. *See id.* at 902 ("We agree with the Second Circuit's analysis and adopt the *Rogers* standard as our own.").

80. *See id.* at 901 ("*Dr. Seuss* recognized that, where an artistic work targets the original and does not merely borrow another's property to get attention, First Amendment interests weigh more heavily in the balance.").

B. The Alternative Avenues Test

According to *Mutual of Omaha Insurance Co. v. Novak*,⁸¹ the Alternative Avenues Test denies First Amendment protection to a trademark infringement "under circumstances where adequate alternative avenues of communication exist."⁸² Currently, only the Eighth Circuit uses the Alternative Avenues Test.⁸³ In *Mutual of Omaha*, Mutual of Omaha Insurance Company (Mutual) brought suit against Novak, an individual, for trademark infringement and disparagement.⁸⁴ At the heart of the suit resided a design, reminiscent of Mutual's trademarks, that used the words "Mutant of Omaha" and presented "a side view of a feather-bonneted, emaciated human head."⁸⁵ Novak initially used the logo on t-shirts, and later expanded its use to sweatshirts, caps, buttons, and coffee mugs.⁸⁶ He sold these products at retail shops, exhibitions, and fairs, as well as through advertisements on television and in newspapers and magazines.⁸⁷ The district court ruled that Novak had infringed Mutual's trademarks and permanently enjoined Novak from using the violative marks.⁸⁸ The Eighth Circuit then upheld this determination.⁸⁹ On appeal, Novak argued that "his use of the design in question [was] an exercise of his right of free speech and [was] protected by the First Amendment."⁹⁰ Noting that the injunction in no way "infringe[d] upon the constitutional protection the First Amendment would provide were Novak to present an editorial parody in a book, magazine, or film," the court concluded that the injunction "deprive[d] neither Novak nor the public of the benefits of his ideas."⁹¹

81. *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987).

82. *Id.* at 402 (quoting *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972)).

83. *See Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 776 (8th Cir. 1994) (applying the Alternative Avenues Test to deny First Amendment protection to a parodist).

84. *Mutual of Omaha Ins. Co.*, 836 F.2d at 398.

85. *Id.*

86. *See id.* (describing Novak's uses of the infringing logo).

87. *See id.* (same).

88. *Id.*

89. *Id.* at 403. Though the circuit court referred to the district court's likelihood of confusion finding, it applied an alternative avenues approach. *See id.* at 402 ("Mutual's rights . . . need not 'yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.'" (quoting *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972))).

90. *Id.*

91. *Id.*

The dissent in *Mutual* argued that Novak's First Amendment rights were implicated by the decision.⁹² Relying on scholarly discussions of the topic, the dissent argued that:

[T]he property metaphor, useful in other contexts, completely distorts the analysis, causing courts to hold . . . that the parodist's rights must yield to property rights whenever the parodist has adequate alternative avenues of communication. This notion derives from the Supreme Court's decision in *Lloyd Corp. v. Tanner*. There the Court held that the owner of real property has the right to exclude unwelcome speakers from that property. But in the *Lloyd* situation, the owner's enforcement of its property rights restricts only the *place* where the speaker's expression may occur. . . . Application of this rule is distinctly inappropriate, however, when the property involved is not real estate but a trademark—a form of intangible property that *itself* conveys or symbolizes ideas. Because a parodist expresses ideas through the use of another's trademark, the owner's attempt to enjoin the parody goes to the *content* of the speech and not merely to the time, place, or manner of its delivery.⁹³

Therefore, according to the dissent, the Alternative Avenues Test should not apply to a trademark's use as parody.⁹⁴

The Eighth Circuit nonetheless has continued to apply this test, as evidenced by *Anheuser-Busch, Inc. v. Balducci Publications*.⁹⁵ In *Anheuser-Busch*, the district court initially dismissed Anheuser-Busch's (A-B) federal and state trademark infringement claims, as well as its trademark dilution and unfair competition claims, arising from a fictitious advertisement for "Michelob Oily."⁹⁶ Balducci Publications (Balducci) published a humor magazine, *Snicker*, for two years before placing the "advertisement" in question on the back cover of the April 1989 issue.⁹⁷ The ad parody showed cans and bottles of Michelob beer pouring oil onto the eagle of the "A and Eagle Design," and bore the slogan, "At the rate it's being dumped into our oceans, lakes and rivers, you'll drink it oily sooner or later, anyway."⁹⁸ In the bottom right-hand corner

92. *Id.* at 405–06 (Heaney, J., dissenting).

93. *Id.* (Heaney, J., dissenting) (quoting Robert J. Shaughnessy, Note, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA. L. REV. 1079, 1111–12 (1986) (footnotes omitted)).

94. *See id.* at 405 (Heaney, J., dissenting) (opining that "the majority opinion cannot be squared with the first amendment").

95. *See Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 776 (8th Cir. 1994) (holding a parodist's use of Anheuser-Busch's trademarks not entitled to First Amendment protection because the trademark use was "wholly unnecessary" to the parodist's stated use).

96. *Id.* at 771.

97. *See id.* at 772 (noting that publication of *Snicker* magazine began in April 1987).

98. *See id.* (describing the ad parody).

of the ad parody, in extremely small print, Balducci placed a disclaimer characterizing the ad parody as an editorial.⁹⁹ A-B conducted a survey at St. Louis shopping malls and entered evidence at trial that six percent of those surveyed thought the ad parody was an actual A-B advertisement.¹⁰⁰

At a bench trial, the district court dismissed all of A-B's claims against Balducci, holding that Balducci's use of the marks did not create a likelihood of confusion.¹⁰¹ The district court also affirmed that the First Amendment had played a large role in this determination.¹⁰² The Eighth Circuit found this reasoning faulty and instead asserted that the district court should have viewed First Amendment protection as an entirely separate matter than likelihood of confusion.¹⁰³

As such, the court examined the case anew and found that a likelihood of confusion did exist.¹⁰⁴ The court then considered Balducci's claims to First Amendment protection.¹⁰⁵ In determining that Balducci's ad did not deserve protection, the court applied the alternative avenues portion of its analysis by finding that Balducci's First Amendment rights did not protect him because the "nearly unaltered appropriation of Anheuser-Busch's marks . . . conveys that it is the original, but the ad founders on its failure to convey that it is not the original. Thus, it is vulnerable . . . since the customer is likely to be

99. *See id.* (providing the exact text of the disclaimer).

100. *See id.* at 772-73 (listing the results of the survey). Much of the survey information had little to do with facts relevant to the case, though. The Eighth Circuit noted a few results of the survey: 58% believed that Balducci needed permission to use the Michelob name, 56% thought permission was necessary for the use of the symbols and logos, 45% found nothing to suggest that the parody was an editorial (only 3.5% noticed the disclaimer), and 75% did not perceive it as satirical. *Id.* Later, the court used these figures to support a conclusion that the survey evidence "strongly indicate[d] actual customer confusion." *Id.* at 775. In so holding, the court cited examples of other courts relying on surveys showing 8.5% to 15% confusion to support findings of confusion. *See id.* (making a comparison to the 6% finding in the A-B survey). Rightly though, the court did not put too much faith in the other statistics listed because they merely provided an impression as to what an average citizen might think is legal.

101. *Id.* at 773.

102. *See id.* ("In reaching this decision, the court expressed the need to give 'special sensitivity' to the First Amendment aspects of the case.").

103. *See id.* (describing the proper course of analysis as first considering likelihood of confusion, and then considering any First Amendment concerns). *But see* Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1405 (9th Cir. 1997) (discussing the Ninth Circuit's view that First Amendment concerns should not serve as a separate "defense," but only as a factor of the Likelihood of Confusion Test).

104. *See Anheuser-Busch, Inc.*, 28 F.3d at 774-75 (presenting the court's application of the familiar likelihood of confusion factors to Balducci's ad).

105. *Id.* at 775.

confused."¹⁰⁶ Despite this strong language, the court did note that this extensive borrowing did not amount to a per se violation,¹⁰⁷ and further explained that Balducci might have escaped liability by "taking steps to insure that viewers adequately understood this was an unauthorized editorial."¹⁰⁸ The court even suggested that the ad could have survived scrutiny if it were the only way to present the desired point.¹⁰⁹ The court then explained that Balducci should have used an obvious disclaimer, positioned the parody in a less confusing location, or altered the protected marks in a meaningful way.¹¹⁰ Beneath this analysis lies the idea that Balducci might have had a better way to convey his message that would have been less violative of A-B's trademarks. This proposition comprises the heart of the Alternative Avenues Test.¹¹¹ Judicial inquiry into the appropriateness of the speaker's mode of communication as a means of granting or denying protection to potentially protected expression only occurs after a finding of likelihood of confusion, making the Eighth Circuit's approach a separate test.

C. The Artistic Relevance Test

The Second Circuit created the third test in *Rogers v. Grimaldi*.¹¹² Under this Artistic Relevance Test, the Lanham Act will not impose liability unless the title has absolutely no artistic relevance to the underlying work, or if it does have artistic relevance, unless the title explicitly misleads as to the source or the content of the work.¹¹³ Recently, other circuits have increasingly adopted this test.¹¹⁴

106. *Id.* at 777.

107. *Id.*

108. *Id.*

109. *See id.* at 776 ("This confusion might have been tolerated if even plausibly necessary to achieve the desired commentary . . ."). The court might not have a very strong point on this issue though. *See infra* notes 225–30 and accompanying text (explaining that the Anheuser-Busch marks might have presented one of the only available means for this parody).

110. *See id.* (listing ways in which Balducci could have conveyed his message in a manner less likely to generate consumer confusion).

111. *See Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) (explaining that First Amendment protection should be denied where alternative, less infringing avenues of conveying the message were available).

112. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

113. *See id.* at 999 (expressing the Second Circuit's formulation of the test).

114. *See infra* Part III.D (explaining the recent prominence of the Artistic Relevance Test).

In *Rogers*, actress Ginger Rogers, most famous for her performances in Hollywood musicals with Fred Astaire, brought suit against the producers and distributors of the movie *Ginger and Fred*, a film directed by Italian filmmaker Federico Fellini.¹¹⁵ She claimed that the use of her name in the title of the film was a violation of the Lanham Act and infringed her common law rights of publicity and privacy, but the district court disagreed and dismissed her claims on summary judgment.¹¹⁶ The Second Circuit affirmed this decision, although it articulated slightly different reasoning than the district court.¹¹⁷

The movie told the story of two fictional Italian performers who, when popular, were known across Italy as "Ginger and Fred."¹¹⁸ The film focused on a televised reunion of these two performers many years after their retirement, and the appellees described it as a satire of contemporary television variety shows.¹¹⁹ In light of the content and focus of the film, the district court held that "the speech at issue [was] not primarily intended to serve a commercial purpose, the prohibitions of the Lanham Act do not apply, and the Film is entitled to the full scope of protection under the First Amendment."¹²⁰ The Second Circuit determined that the district court had overstated the appropriate level of protection¹²¹ and that a more refined test was needed.¹²²

In articulating the Artistic Relevance Test, the court took into account many issues of policy and practicality.¹²³ First, the court noted that even though movies, plays, books, and songs are works of artistic expression, they are sold and marketed in the commercial marketplace and, as such, create a concern of consumer deception.¹²⁴ Second, the court noted that artists may vindicate their property rights against other artists.¹²⁵ The court justified this

115. *Rogers*, 875 F.2d at 996.

116. *Id.*

117. *See id.* ("Although we disagree with some of the reasoning of the District Court, we affirm.").

118. *See id.* at 996–97 (providing a description of the film).

119. *Id.* at 997.

120. *Rogers v. Grimaldi*, 695 F. Supp. 112, 120–21 (S.D.N.Y. 1998).

121. *See Rogers*, 875 F.2d at 997 ("In effect, the District Court's ruling would create a nearly absolute privilege for movie titles, insulating them from Lanham Act claims as long as the film itself is an artistic work, and the title is relevant to the film's content.").

122. *See id.* (describing the court's view that the analysis used by the district court "unduly narrows the scope of the [Lanham] Act").

123. *See id.* at 997–1002 (balancing Lanham Act protections with First Amendment considerations).

124. *See id.* at 997–98 ("Poetic license is not without limits. The purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product.").

125. *See id.* at 998 (noting that when the public associates the title of a movie or book with a particular artist's work, the holder of the rights to that title may prevent the use of that title, or

assertion by explaining an artist's entitlement to protect the right to receive compensation for artistic work, which encourages free expression.¹²⁶ Third, the court described the hybrid nature of titles as "combining artistic expression and commercial promotion."¹²⁷ Fourth, the court rejected application of the Alternative Avenues Test, asserting that it unduly restricted literary expression.¹²⁸ In light of these considerations, the court determined that an Artistic Relevance Test would most adequately balance the public interest in avoiding consumer confusion against the public interest in protecting free speech.¹²⁹

The court provided examples of how it would apply the test in various hypothetical situations.¹³⁰ For example, books with titles such as "Nimmer on Copyright," or books that contain a phrase in the title or subtitle, such as "an authorized biography," would not merit First Amendment protection if such an association did not in fact exist.¹³¹ The court, however, determined titles that some people might find confusing, but that do not imply authorship or endorsement, should merit protection.¹³² The court also asserted that if a title included specific statements about the content of a work, and those statements were false, the First Amendment should not protect these works if the factfinder made a determination of falsity.¹³³ The court retreated from this seemingly broad statement, however, by acknowledging that many titles make no explicit statement that the work is overtly about that person, but rather imply some sort

of a confusingly similar title, by other artists).

126. See *id.* (drawing this conclusion by comparing it to case law concerning copyrights).

127. See *id.* (describing further that "[t]he title of a movie may be both an integral part of the film-maker's [sic] expression as well as a significant means of marketing the film to the public").

128. See *id.* at 999 (stating that the Alternative Avenues Test does not sufficiently protect the public's interest in free expression because it amounts to a restriction on the words a speaker may use and not merely on the location of that speech).

129. See *id.* (articulating the reasons for modifying the district court's test).

130. See *id.* at 999-1000 (providing hypotheticals and analyses).

131. See *id.* at 999 (explaining that such titles "explicitly state the author of the work or at least the name of the person the publisher is entitled to associate with the preparation of the work," or signify an explicit endorsement).

132. See *id.* at 999-1000 (using the song *Bette Davis Eyes* to illustrate that even though some people might believe that the celebrity endorsed or had a role in producing the work, "the slight risk that such use of a celebrity's name might implicitly suggest endorsement or sponsorship to some people is outweighed by the danger of restricting artistic expression").

133. See *id.* at 1000 & n.6 (illustrating this point by noting that had the movie been titled *The True Life Story of Ginger and Fred* the Lanham Act might have been applicable as the title could be found explicitly misleading).

of oblique meaning only discernable upon closer inspection.¹³⁴ In these cases, the court suggested that "the consumer interest in avoiding deception is too slight to warrant application of the Lanham Act."¹³⁵ Ultimately, "[w]here a title with at least some artistic relevance to the work is not explicitly misleading as to the content of the work, it is not false advertising under the Lanham Act."¹³⁶ This provision of the test has led to the problem of judicial determinations of artistic content and merit.

The Fifth Circuit has also adopted this Artistic Relevance Test.¹³⁷ In *Westchester Media v. PRL USA Holdings, Inc.*,¹³⁸ Polo Ralph Lauren (PRL), the owner of a popular line of clothing and other lifestyle products such as cologne, brought suit against the publishers of POLO magazine, the official publication of the United States Polo Association, alleging an infringing use of its trademark in the word POLO.¹³⁹ Employing the Artistic Relevance Test, the court found that the magazine's use of the POLO name did violate PRL's trademark, but that the remedy could be adapted to better insulate and protect free speech concerns.¹⁴⁰ Interestingly, the magazine held the sole trademark for the use of the word POLO on a publication concerning the sport of polo and its surrounding lifestyle.¹⁴¹ Also, the magazine existed peacefully with PRL for many years, even carrying PRL advertisements in its lifestyle pages.¹⁴²

Problems arose upon the sale and re-launch of the magazine as two separate publications in 1997.¹⁴³ These publications reflected the same content as the old magazine, but separated the lifestyle section into a new magazine called POLO that carried the tagline "ADVENTURE • ELEGANCE • SPORT" and Polo Players Edition, which consisted exclusively of content related to the sport of polo.¹⁴⁴ The new ownership sent free copies of the first issue of the new POLO, which carried a picture of model Claudia Schiffer on the cover, to

134. See *id.* at 1000 (describing the nature of many artistic titles).

135. *Id.*

136. *Id.*

137. See *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665 (5th Cir. 2000) (noting that the Fifth Circuit has adopted the Artistic Relevance Test).

138. *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000).

139. *Id.* at 661.

140. See *id.* at 660–61 (finding trademark infringement, but declining to impose a permanent injunction against the magazine using the title POLO).

141. *Id.*

142. See *id.* at 661–62 (noting that under previous ownership, the POLO magazine carried PRL ads and even interviewed Ralph Lauren for an article).

143. *Id.* at 662.

144. *Id.*

Neiman Marcus customers.¹⁴⁵ This provoked PRL to sue for two reasons. First, Neiman Marcus represented one of PRL's largest distributors.¹⁴⁶ Second, Claudia Schiffer had served as PRL's premier model for the previous year's advertising campaign.¹⁴⁷

The trial court initially issued a preliminary injunction and required the magazine to publish a disclaimer clarifying that the magazine had nothing to do with any of PRL's enterprises.¹⁴⁸ After trial, the court issued a permanent injunction against the magazine's use of the title POLO, but not against Polo Player's Edition.¹⁴⁹ Though the circuit court upheld the trial court's determination of trademark infringement, it rejected the remedy and remanded the case for imposition of different measures.¹⁵⁰

In examining the trademark infringement claim, the Fifth Circuit presented a concise analysis of the issues involved. Initially, the court determined whether a likelihood of confusion did in fact exist.¹⁵¹ Only after finding the existence of a likelihood of confusion did the court examine the infringing user's claim of First Amendment protection.¹⁵² The court then noted that the Fifth Circuit had adopted the Artistic Relevance Test.¹⁵³ The precedent cited for this conclusion did not explicitly adopt this test, though, instead using other language identical to that found in the Second Circuit's formulation of the test.¹⁵⁴ In any event, by its treatment of the subject in this case, the court made it clear that the Fifth Circuit follows the Artistic Relevance Test.¹⁵⁵ Noting that

145. *Id.*

146. *Id.*

147. *Id.*

148. *Id.* at 663.

149. *Id.*

150. *See id.* (noting that the court stayed the permanent injunction and reinstated the disclaimer procedures pending another determination).

151. *See id.* at 664 (applying the traditional factors).

152. *See id.* (explaining that "PRL's infringement claim implicates the First Amendment right to choose an appropriate title for literary works").

153. *See id.* at 665 (adopting a standard which requires that "[a]ny finding that defendants' book title is likely to cause confusion with plaintiff's book title must be 'particularly compelling' to outweigh defendants' First Amendment interest" (citing *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 n.7 (5th Cir. 1999))).

154. *See Sugar Busters*, 177 F.3d at 269 n.7 (using the language "particularly compelling," which is also found in the *Rogers* Test); *Westchester Media Co. L.P. v. PRL USA Holdings, Inc.*, No. CIV.A.H-97-3278, 2001 WL 34109374, at *3 (S.D. Tex. Oct. 23, 2001) (referring to the Circuit Court's adoption of the Artistic Relevance Test as an implicit adoption).

155. *See Westchester Media*, 214 F.3d at 665 ("This Circuit has adopted the Second Circuit's approach . . .").

the content of the magazine explicitly related to the title,¹⁵⁶ as required by the content prong of the test, the Fifth Circuit found that the likelihood of confusion as to association of the entities amounted to an infringement of PRL's marks.¹⁵⁷

Despite the similarity of this analysis to other cases that have addressed the issue, the Fifth Circuit distinguished itself by addressing the practical implications of its decision and suggesting appropriate remedies.¹⁵⁸ In addressing remedies, the court was careful to note that a finding of likelihood of confusion does not eliminate the First Amendment concerns present in these cases.¹⁵⁹ Because of the possibility of the broad injunction issued by the lower court dictating both the title and content of the magazine,¹⁶⁰ the Fifth Circuit remanded the case and ordered that the lower court reconsider disclaimer relief.¹⁶¹

The court highlighted four factors in recommending disclaimer relief over injunctive relief. First, as discussed above, the court noted the possible intrusions into content inherent in the enforcement of the injunction.¹⁶² Second, the court addressed PRL's attempt to police the use of the word "polo" in light of the fact that the sport itself provided the original air of affluence surrounding the word.¹⁶³ Third, the court noted that PRL offered no evidence of actual confusion after publication of the magazine with disclaimers.¹⁶⁴ Fourth, the court noted that the presumably sophisticated

156. *See id.* at 665 n.3 (finding that the title carried artistic relevance to the content of the work because the new POLO magazine contained articles specifically related to polo and the magazine was the official publication of the United States Polo Association).

157. *See id.* at 668 (finding that "the evidence of actual confusion, both anecdotal and survey-based, and Westchester's intent to trade on PRL's goodwill and reputation" amounted to an infringement of PRL's marks).

158. *See id.* at 671-75 (discussing appropriate remedies).

159. *See id.* at 673 (describing Westchester's First Amendment interests as "continuing," and noting the general rule that "an equitable remedy should be no broader than the scope of the violation").

160. *See id.* ("The content-based impact of this injunction could extend beyond the title of Westchester's magazine, posing special First Amendment concerns.").

161. *See id.* at 674 (requiring the reconsideration of disclaimer relief).

162. *See id.* at 673 ("The content-based impact of this injunction could extend beyond the title of Westchester's magazine, posing special First Amendment concerns.").

163. *See id.* ("PRL is arrogating the very name of a sport from the players' publication. In a sense, PRL is biting the hand that fed it.").

164. *See id.* ("PRL, despite strong incentive to do so, offered no evidence of actual confusion after the preliminary injunction ordered New POLO published with disclaimers.").

nature of buyers of both PRL's products and Westchester's POLO magazine presented a favorable environment for the imposition of disclaimer relief.¹⁶⁵

Upon remand, the lower court followed the order of the circuit court and reconsidered disclaimer relief.¹⁶⁶ Specifically, the district court determined that, despite a lack of direct precedent on the subject, Westchester carried the burden of proof of establishing the effectiveness of any proposed disclaimer,¹⁶⁷ and that the prior court-imposed disclaimer did not adequately do so.¹⁶⁸ The court went on to mandate an exceptionally adequate disclaimer that stated "Not affiliated with Polo Ralph Lauren" in 16-point font, in a white box with a black border placed immediately adjacent to and below the magazine's title.¹⁶⁹ One is reminded of the Surgeon General's Warning appearing on and consuming one entire side of a pack of cigarettes. The Fifth Circuit affirmed this remedy without opinion.¹⁷⁰

A district court in the Third Circuit has applied the Artistic Relevance Test as well. In *Seale v. Gramercy Pictures*,¹⁷¹ Bobby Seale, a founding member of the Black Panther Party in the late 1960s, sued Gramercy Pictures for the use of his name and image in the promotion of a film about the Black Panther Party and the accompanying soundtrack.¹⁷² Initially, Gramercy moved for summary judgment against Seale's right of publicity and trademark claims concerning both the movie and the soundtrack.¹⁷³ The district court held that Seale's claims could continue only with respect to the soundtrack and granted Gramercy's motions with respect to the movie.¹⁷⁴ In so doing, the district court applied the Artistic Relevance Test.¹⁷⁵ Applying the test to the movie, the court held that as a matter of law, because Seale's

165. *See id.* at 674 ("Such buyers are more likely to notice, read, and understand the import of any written disclaimers attached to Westchester's magazine.").

166. *See Westchester Media Co. L.P. v. PRL USA Holdings, Inc.*, No. CIV.A.H-97-3278, 2001 WL 34109374, at *8-9 (S.D. Tex. Oct. 23, 2001) (deciding and ordering the appropriate remedy in light of the circuit court's remand).

167. *See id.* at *3 (noting that under trademark law the infringing party may be required to take affirmative steps to alleviate the confusion).

168. *See id.* at *8 ("[T]his court concludes, by a preponderance of the evidence, . . . a more concise disclaimer, consistently placed in a more prominent position, may alleviate the likelihood of confusion.").

169. *See id.* at *8-9 (detailing the court's required disclaimer).

170. *Westchester Media v. PRL USA*, 48 Fed. Appx. 917 (5th Cir. 2002).

171. *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996).

172. *Id.* at 332-33.

173. *Id.* at 333.

174. *See id.* at 340-41 (summarizing the district court's holding).

175. *See id.* at 339-40 (examining Seale's claims in light of the Second Circuit's analysis).

name and likeness were related directly to the content of the movie and because the promotional materials made no explicit suggestion of sponsorship or endorsement, the movie merited First Amendment protection from a suit under the Lanham Act.¹⁷⁶ The court did allow Seale to continue with his suit over the soundtrack's use of his name and likeness, though, finding that such use did not relate to the content of the work.¹⁷⁷

At the trial on these issues, the district court held that the use of Seale's name and likeness in the marketing of the soundtrack did not constitute false advertising under the Lanham Act.¹⁷⁸ In so holding, the court noted that Seale never presented proof that the use of his likeness on the packaging of the soundtrack created consumer confusion.¹⁷⁹ As examples of what sort of proof might satisfy this requirement, the court stated that if the defendant's use of the mark is not clearly an endorsement, the plaintiff "must produce evidence, usually in the form of market research or consumer surveys, showing exactly what message customers received from [the] defendant's ad."¹⁸⁰ One can only speculate on whether the court would have held differently had Seale produced such evidence, or just how much confusion would have been required.

Most recently, in *Parks v. LaFace Records*,¹⁸¹ the Sixth Circuit affirmed its adoption of the Artistic Relevance Test.¹⁸² In *Parks*, civil rights icon Rosa Parks brought suit against the rap band OutKast and affiliated defendants for using her name as the title of a song on their album *Aquemini*.¹⁸³ Parks asserted that the band's use of her name constituted false advertising under

176. See *id.* at 340–41 (holding the movie's use of Seale's name and likeness not actionable under the Lanham Act because the First Amendment concerns outweighed any potential risk of implied endorsement or sponsorship).

177. See *id.* at 340 (noting that the songs on the soundtrack "have no direct connection to the Plaintiff or the history of the Black Panther Party" and accordingly allowing Seale to continue to trial on this claim).

178. See *Seale v. Gramercy Pictures*, 964 F. Supp. 918, 931 (E.D. Pa. 1997) (finding no implication of sponsorship or endorsement in the advertising materials and entering judgment in favor of Gramercy Pictures).

179. See *id.* ("Nor did Bobby Seale present evidence tending to show that the consumer public 'was actually deceived' into believing that he endorses, approves, or is affiliated with the musical CD.").

180. *Id.* at 930 (citing 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 5.4[B][2] (insert 3/96)).

181. *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir.), *cert. denied*, 124 S. Ct. 925 (2003).

182. See *id.* at 451–52 (examining application of the Artistic Relevance Test in other circuits and adopting it for the Sixth Circuit).

183. See *id.* at 441–42 (explaining the procedural history of the case).

the Lanham Act and intruded on her common law right of publicity.¹⁸⁴ The district court applied the Artistic Relevance Test and concluded that, as a matter of law, the First Amendment served as a defense to Parks's Lanham Act and right of publicity claims and granted summary judgment for the defendants.¹⁸⁵ With respect to the Lanham Act claim, the Sixth Circuit determined that although the song's title did not explicitly mislead as to the content of the work, the finder of fact must determine whether the title has artistic relevance to the content of the song.¹⁸⁶ Accordingly, the court reversed the grant of summary judgment for the defendants on the Lanham Act claim and remanded the case for jury consideration.¹⁸⁷ For the same reasons, the court also reached this result with respect to the right of publicity claim.¹⁸⁸

The Sixth Circuit's application of the test in *Parks* seems to be a little more watered down than the Second Circuit's in *Rogers*. This conclusion stems from dicta in *Rogers* suggesting that a title that includes a well-known name without any overt indication of authorship or endorsement should not be subject to the Lanham Act.¹⁸⁹ Perhaps the real difference arises in the test as applied and not as articulated. The basic difference between the two holdings is that the Second Circuit was willing to hold as a matter of law that the title was artistically relevant, but the Sixth Circuit determined this same question to be an issue of fact.¹⁹⁰ A further difference surfaces in the Second Circuit's willingness to hold as a matter of law that the use of a name alone does not imply endorsement.¹⁹¹ This difference has been articulated by practitioners as a difference in the balancing test employed.¹⁹² This analysis

184. *Id.* at 441.

185. *Id.* at 444.

186. *See id.* at 459 (explaining the circuit court's holding with respect to the Lanham Act claim).

187. *Id.* at 463.

188. *Id.*

189. *See Rogers v. Grimaldi*, 875 F.2d 994, 999–1000 (2d Cir. 1989) (opining that the song *Bette Davis Eyes* would not be subject to the restrictions of the Lanham Act).

190. *Compare id.* at 1000 (expressing a willingness to find that using someone's name in the title of a song, without more, cannot imply sponsorship or endorsement) *with Parks v. LaFace Records*, 329 F.3d 437, 459 (6th Cir.), *cert. denied*, 124 S. Ct. 925 (2003) (remanding the case for jury consideration).

191. *See Rogers*, 875 F.2d at 1000 (noting that when using a celebrity's name and nothing more in the title of a song, "the slight risk that such use of a celebrity's name might implicitly suggest endorsement or sponsorship to some people is outweighed by the danger of restricting artistic expression").

192. *See Timbers & Huston, supra* note 14, at 1288–90, 1300 (referring to a series of cases, beginning with *Rogers*, in which the Second Circuit first articulated the balance required to

focuses on the language employed, "explicitly misleading" as opposed to "particularly compelling," but does not speculate about what practical effect, if any, this difference will have on how cases are decided, only noting that it illustrates a general shift toward First Amendment protections in this area.¹⁹³

D. How the Artistic Relevance Test Has Moved to the Front of the Pack

Despite the presentation of these tests as three independent logical structures, some assert that they actually represent an evolution, culminating in the Artistic Relevance Test.¹⁹⁴ No matter which interpretation proves more accurate, the Artistic Relevance Test has become the dominant analysis.¹⁹⁵ Recent commentary has attributed the development and increasing popularity of the Artistic Relevance Test to a general swing of the "First Amendment pendulum" away from markholders and toward artistic expression.¹⁹⁶ In support of this view, these commentators note that the Alternative Avenues Test almost invariably favors the markholder, while the increasingly popular Artistic Relevance Test typically favors the artists.¹⁹⁷

According to Kerry Timbers and Julia Huston, who present a very concise history of the development of case law in this area, the Alternative Avenues Test at first enjoyed a position of prominence among courts considering trademark infringement cases that prompted First Amendment defenses.¹⁹⁸ They describe one of the more famous cases of this era, *Dallas*

trump First Amendment interests as "explicitly misleading," and later as "particularly compelling," and asserting that other circuits, in adopting the Artistic Relevance Test, have split over which balance is the more appropriate).

193. See *id.* at 1300 ("Regardless of which formulation of the [A]rtistic [R]elevance [T]est becomes more prominent, . . . it is clear that the days of the plaintiff-friendly Alternative Avenues Test are long gone . . .").

194. See *id.* at 1278–79 (explaining that the Artistic Relevance Test provides more First Amendment protection for artists and noting a "trend toward the [A]rtistic [R]elevance [T]est, and rejection of earlier, less First Amendment-friendly tests").

195. See *id.* at 1279 (noting the sound reasoning and high publicity of *Mattel, ETW Corp. v. Jireh Publishing, Inc.*, and *Parks*, and predicting that more courts will begin to adopt the Artistic Relevance Test).

196. See *id.* at 1300 ("In recent years, the First Amendment pendulum has clearly swung away from the rights of trademark owners and toward defendants accused of infringing famous marks in connection with expressive, creative works.").

197. See *id.* ("The 'old' [A]lternative [A]venues [T]est almost always favored the trademark owner, and the newly invigorated [A]rtistic [R]elevance [T]est typically favors the defendant.").

198. See *id.* at 1278 (describing the Alternative Avenues Test of the 1970s and 1980s as "well-established").

Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.,¹⁹⁹ as representative of this judicial approval of the Alternative Avenues Test.²⁰⁰ As evidence of the shift away from the Alternative Avenues Test, they cite *L.L. Bean, Inc. v. Drake Publishers, Inc.*,²⁰¹ a case involving a parody of L.L. Bean's mail order catalog found within the pages of the pornographic magazine *High Society*.²⁰² According to their analysis, however, the First Circuit's approach did not have much of an impact on the general case law of the area because the court "explicitly limited its holding to non-confusing non-commercial parodies, and

199. *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979). In *Dallas Cowboy Cheerleaders*, the Cheerleaders sued Pussycat Cinema and obtained a preliminary injunction preventing the distribution or exhibition of the adult film, *Debbie Does Dallas*. *Id.* at 202. On appeal, the Second Circuit made special note of the film's "gross and revolting" content, including scenes in which a woman, dressed in an outfit very similar to the uniforms of the Cheerleaders, performed various sexual acts. *Id.* The suit was brought for trademark infringement under section 43(a) of the Lanham Act. *Id.* at 203. First, the court determined that the Cheerleaders did hold a trademark in their otherwise functional uniform because of its design and the meaning that it had acquired in the eyes of the public. *Id.* at 203-04. The court further noted that "it is hard to believe that anyone who had seen defendants' sexually depraved film could ever disassociate it from plaintiff's cheerleaders." *Id.* at 205. Finally, the court held that because of the "numerous ways in which defendants may comment on 'sexuality in athletics' without infringing plaintiff's trademark, the district court did not encroach upon their first amendment rights in granting a preliminary injunction," and affirmed the district court's holding. *Id.* at 206-07.

200. See Timbers & Huston, *supra* note 14, at 1279 (referring to *Dallas Cowboys Cheerleaders* as "[o]ne of the most famous, influential and typical of these cases").

201. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987). In *L.L. Bean*, the adult erotic entertainment magazine *High Society* published an issue containing a two-page article entitled "L.L. Bean's Back-To-School-Sex-Catalog." *Id.* at 27. Despite the article being labeled as "humor" and "parody," L.L. Bean sued alleging "trademark infringement, unfair competition, trademark dilution, deceptive trade practices, interference with prospective business advantage and trade libel," and sought a temporary restraining order that would remove the issue from circulation. *Id.* The district court denied the injunction and granted summary judgment for Drake on the claims of trade libel and interference with prospective business advantage; denied summary judgment to both parties on the claims of trademark infringement, unfair competition, and deceptive trade practices; and granted summary judgment for L.L. Bean with respect to the trademark dilution claim. *Id.* The district court further held that enjoining the publication of the parody to prevent trademark dilution did not offend the First Amendment. *Id.* On appeal, the First Circuit addressed the question of whether the injunction offended the First Amendment. *Id.* Holding that Drake's use of L.L. Bean's mark was in fact a parody, the court determined that a simple application of the Alternative Avenues Test did not adequately reflect the First Amendment concerns implicated by the injunction. *Id.* at 28-29. "Neither the strictures of the first amendment nor the history and theory of anti-dilution law permit a finding of tarnishment based solely on the presence of an unwholesome or negative context in which a trademark is used without authorization." *Id.* at 31. Further the court noted that Drake used the mark in a noncommercial context. *Id.* at 32. Accordingly, the First Circuit reversed and remanded the case. *Id.* at 34.

202. *Id.* at 27.

made no attempt to articulate a broader rule."²⁰³ They assert that true change began to occur as a result of the development of the Artistic Relevance Test by the Second Circuit in *Rogers v. Grimaldi*.²⁰⁴

Timbers and Huston describe two versions of the Artistic Relevance Test: the original, "explicitly misleading" test, developed in *Rogers*; and a newer, "particularly compelling" test, developed by the Second Circuit in two later cases, *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*,²⁰⁵ and *Twin Peaks Productions, Inc. v. Publications International, Ltd.*²⁰⁶ Under the "particularly compelling" variant articulated in *Twin Peaks*, the court should not determine if the title is "explicitly misleading as to source or content," but instead should apply the likelihood of confusion factors fundamental to trademark law and determine if they are "particularly compelling" when balanced against the First Amendment issues of the case.²⁰⁷ Under this Note's analysis, the "particularly compelling" variant is

203. See Timbers & Huston, *supra* note 14, at 1284 (describing the First Circuit's holding and stating that the decision "did not engender a significant change in the way courts generally viewed First Amendment defenses in trademark infringement cases").

204. See *id.* (noting that "the tide began to turn" with the Second Circuit's decision in *Rogers*).

205. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 886 F.2d 490 (2d Cir. 1989). In *Cliffs Notes*, respondent Cliffs Notes, the publisher of a series of study guides bearing a distinctive yellow and black cover, sued the publisher of Spy Notes, a parody of both Cliffs Notes and various contemporary novels, for trademark infringement and unfair competition. *Id.* at 491-93. Noting the tension between First Amendment concerns and trademark rights inherent in claims against parodies, the court recognized the need to weigh the public interest in free expression against the public interest in avoiding consumer confusion. *Id.* at 494. The court held that the "*Rogers* balancing approach [was] generally applicable to Lanham Act claims against works of artistic expression, a category that includes parody." *Id.* at 495. Further, the court clarified that this test took into account the "ultimate test in trademark law," the Likelihood of Confusion Test. *Id.* Examining the record, the court concluded that the district court had erred in its application of the likelihood of confusion factors, held that there was not a strong likelihood of confusion, and accordingly vacated the injunction. *Id.* at 496-97.

206. *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366 (2d Cir. 1993). In *Twin Peaks*, the producers of a popular television show sued the publisher of a book about the show. *Id.* at 1370. The producers alleged copyright infringement, trademark infringement, unfair competition, and trademark dilution. *Id.* at 1371. The district court issued an injunction against the production of the book and awarded damages to the plaintiffs. *Id.* The Second Circuit affirmed the district court's decision as to copyright liability. *Id.* at 1383. Addressing the trademark claims, the Second Circuit noted that the title of the book had artistic relevance to the underlying content, but the district court had failed to apply any of the likelihood of confusion factors, and, as such, the circuit court remanded the case for consideration of this issue. *Id.* at 1379-80. In explaining the appropriate standard to be applied, the court specified that any finding of likelihood of confusion must be particularly compelling to outweigh the First Amendment interests at stake. *Id.* at 1379.

207. See *id.* (explaining the requirements of the particularly compelling standard).

discussed as a straightforward application of the Likelihood of Confusion Test, and not as a variant of the Artistic Relevance Test.²⁰⁸

Despite naming conventions, Timbers and Huston assert that the Tenth and Fifth Circuits have adopted this "particularly compelling" variant of the Artistic Relevance Test in *Cardtoons*²⁰⁹ and *Westchester Media*,²¹⁰ respectively.²¹¹ They then assert that the Ninth and Sixth Circuits have adopted the more rigorous "explicitly misleading" variant.²¹² For the Ninth Circuit, the authors point to *Mattel*,²¹³ and for the Sixth Circuit, they point to two cases, *ETW Corp. v. Jireh Publishing, Inc.*²¹⁴ and *Parks*.²¹⁵ From this analysis, and in reliance on their assertion of the increasing popularity of the Artistic Relevance Test, they conclude that "[r]egardless of which formulation of the Artistic Relevance Test becomes more prominent, . . . it is clear that the days of the plaintiff-friendly Alternative Avenues Test are long gone."²¹⁶

208. See *supra* Part III.A (discussing the Likelihood of Confusion Test).

209. See *supra* Part III.A (discussing *Cardtoons* as a straightforward application of the Likelihood of Confusion Test).

210. See *supra* Part III.C (discussing *Westchester* as an application of the Artistic Relevance Test).

211. See Timbers & Huston, *supra* note 14, at 1290–91 (cataloging the limited adoption of the Artistic Relevance Test by other circuits).

212. See *id.* at 1291 ("In 2002 and 2003, both the Rogers [A]rtistic [R]elevance [T]est and the 'explicitly misleading' standard . . . were enthusiastically embraced by the Ninth and Sixth Circuits . . .").

213. See *supra* note 74 (explaining *Mattel*).

214. *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003). In *ETW*, the famous golfer, Tiger Woods, sued Jireh Publishing (Jireh), the publisher of artwork created by sports artist Rick Rush of Tuscaloosa, Alabama, for the unlicensed use of Tiger's image in a painting depicting his historic win at the 1997 Master's tournament in Augusta, Georgia. *Id.* at 918. ETW alleged trademark infringement, trademark dilution, unfair competition, and false advertising. *Id.* at 919. The district court granted Jireh's motion for summary judgment and ETW appealed. *Id.* The Sixth Circuit first noted that the use of Tiger's name in the materials accompanying the artwork was an appropriate use of a celebrity's name, because of its artistic relevance to the work. *Id.* at 920. The court went on to conclude that "as a general rule, a person's image or likeness cannot function as a trademark," and affirmed the district court's grant of summary judgment on this count. *Id.* at 922–23. The court further determined that Rush's prints deserved the full protection of the First Amendment, as they were not commercial speech. *Id.* at 925. Finally, applying the Artistic Relevance Test, the Sixth Circuit affirmed the district court's grant of summary judgment. *Id.* at 938.

215. See Timbers & Huston, *supra* note 14, at 1295 ("In 2003, the Sixth Circuit adopted the *Rogers* analysis in two high-profile cases . . .").

216. *Id.* at 1300.

IV. A Proposal for the Elimination of the Content Prong of the Artistic Relevance Test When a Title Is Itself Expressive

A. Parks Presents a New Scenario

Cases such as *Parks* present an entirely different situation than those previously encountered because the title in *Parks* does not "strictly 'relate' to or describe the artistic content of the work except in a very tenuous fashion."²¹⁷ Courts generally have not looked favorably upon artists' claims of First Amendment protection in these specialized situations.²¹⁸ According to Timbers and Huston, "In order to find such titles 'artistically relevant' to the content, courts would have to apply the Artistic Relevance Test even more broadly than the circuit courts have done to date."²¹⁹ But instead of broadly expanding the Artistic Relevance Test in order to protect titles that are in and of themselves expressive, courts should create a separate, narrow standard to apply to this small class of cases. Specifically, courts should not look for artistic relevance to the underlying content of the work, but only for a misrepresentation of sponsorship or endorsement. Courts should dispose of the artistic relevance prong, and only analyze such cases on whether they explicitly mislead as to sponsorship or endorsement.

B. The Danger of a Judicial Content Inquiry in Cases Like Parks

Judicial inquiry into the merit of an artistic creation, or even the means of an artistic creation, seems a very dangerous endeavor.²²⁰ As noted by Justice Holmes when writing in a famous copyright case:

At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the

217. *Id.* at 1301.

218. *See id.* (noting that the cases do not favor the artists in these situations, but also noting that "one could easily conclude that consumers would not be confused as to source or sponsorship in those circumstances").

219. *Id.*

220. *See* *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (presenting Justice Holmes's view of the inadequacy of judicial inquiry into artistic merit).

interest of any public, they have a commercial value,—it would be bold to say that they have not an aesthetic and educational value,—and the taste of any public is not to be treated with contempt.²²¹

The tests that rely on such an inquiry, the Alternative Avenues Test and the Artistic Relevance Test, call on the judicial system to inquire into matters of taste, preference, and choice. Presumably, the artist has given these matters much thought.²²² The protections afforded parody are an example of the judicial system attempting to step away from inquiring too deeply into an artist's manner of expression.²²³ But this retreat is not uniform, as evidenced by the decision in *Parks*. Whatever the grounds for an artistic choice, such as the ease of drawing or obtaining the logo in question or because a slogan or mark lends itself to alterations that most aptly convey the artist's message,²²⁴ this is not an appropriate area for judicial inquiry. Some courts seemingly desire to decide whether an artist's stylistic or content choices deserve protection based on the court's conception of what constitutes art, yet none of the courts will articulate a final standard by which an artist may be assured of protection. This invariably will have the effect of chilling speech that should be protected.

Take *Anheuser-Busch*, for example, in which the court determined that the use of the confusing trademark was "wholly unnecessary" to the artist's stated purpose.²²⁵ Nowhere in that opinion does the court recognize or make mention of the fact that Michelob Dry was most likely the only beer that could have been used to create this parody. Without knowing exactly how every contemporary beer advertised, it is most likely safe to assume that no other beer provided such a fertile ground for this sort of parody. First, Michelob Dry, a two-word beer name, easily converted into Michelob Oily.²²⁶ Second, assuming that other beers met the name requirements (a two-word name), it is

221. *Id.* at 251–52.

222. *See* *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989) ("The title of a movie may be both an integral element of the filmmaker's expression as well as a significant means of marketing the film to the public. . . . Filmmakers and authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works.").

223. *See* *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 972–73 (10th Cir. 1996) (presenting a discussion of the importance of protecting a parodist's right of expression).

224. *See* *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 776 (8th Cir. 1994) (finding no protection when, according to the court, the parodist had less intrusive means of conveying his message).

225. *See id.* (holding that a parodist's use of Anheuser-Busch's trademarks was not entitled to First Amendment protections because the trademark use was "wholly unnecessary" to the parodist's stated use).

226. *See id.* at 772 (describing the name used for Balducci's fictitious product).

likely that none of them had a slogan as easily adaptable as "One Taste and You'll Drink it Dry" (which the artist changed to "One Taste and You'll Drink it Oily").²²⁷ Third, the Anheuser-Busch A & Eagle Logo provided another way to present the intention of the parodist by providing an animal that could be shown saying "Yuck!" while covered in oil. Again, it is not likely that many other beers marketed at the time presented such a fitting set of circumstances for adaptation in order to present the artist's message.²²⁸ However, the court did have a common sense argument.²²⁹ Balducci would have incurred little expense or degradation of message had he either printed the disclaimer in a larger type or in a more prominent position, or altered the mark by reversing or transposing letters or otherwise altering the spelling and sound of Michelob, much as he did with the A & Eagle logo by placing a Shell symbol above it and redrawing the eagle, thereby explicitly distinguishing it from the real A & Eagle logo.²³⁰ But such arguments allow the court to determine the merit of the artistic content.

C. How Parks Highlights the Need for a New Standard

These are hard cases, as evidenced by the promulgation of questionable law. In attempting to protect the interests of both parties, the courts overlook the fact that they are making determinations concerning the content of primarily artistic works. The Sixth Circuit's decision in *Parks* illustrates this most effectively, calling for the jury to determine if the title is "used in some symbolic or metaphorical sense,"²³¹ and doubting that the song contains any form of "artistic expression involving Rosa Parks herself."²³² The court based this belief on statements made by the band denying that the song was meant to be about Rosa Parks.²³³ In light of these statements, the court determined that reasonable people could find that the song presents "nothing more and nothing less than a paean announcing the triumph of superior people in the

227. See *id.* (presenting the Michelob Dry slogan).

228. See *id.* (describing the Anheuser-Busch logo).

229. See *supra* notes 109–11 and accompanying text (explaining the court's Alternative Avenues Test approach).

230. See *Anheuser-Busch, Inc.*, 28 F.3d at 772 (describing how Balducci altered the Anheuser-Busch logo).

231. *Parks v. LaFace Records*, 329 F.3d 437, 459 (6th Cir. 2003).

232. *Id.* at 456.

233. *Id.* at 452 ("We (OutKast) never intended for the song to be about Rosa Parks or the civil rights movement. It was just symbolic, meaning that we comin' back out, so all you other [rappers] move to the back of the bus.").

entertainment business over inferior people in that business."²³⁴ Yet despite the "reasonable persons" language, the court gave away its true view of the issue in the preceding sentences: "The composers did *not* intend [the song] to be about Rosa Parks, and the lyrics are *not* about Rosa Parks. The lyrics' sole message is that OutKast's competitors are of lesser quality"²³⁵ In response to the assertion that the use of Rosa Parks's name is symbolic, the court even went so far as to ask "*symbolic of what?*"²³⁶ It further noted that "[i]n lyrics that are laced with profanity and in a 'hook' or chorus that is pure egomania, many reasonable people could find that this is a song that is clearly *antithetical* to the qualities identified with Rosa Parks."²³⁷ In making this statement though, the court implicitly acknowledged that if the case makes it back to trial, and the jury has as much sympathy for Rosa Parks's cause and qualities as the court does, the jury would be correct in finding that "the use of Rosa Parks' name as the title to this song was not *justified as being metaphorical or symbolic of anything for which Rosa Parks is famous*."²³⁸ By so doing, the court exposed its view that the law should be able to determine what constitutes appropriate symbolism in an artistic work. It is not comforting to speculate that, in light of this ruling, twelve people might be able to decide what this song means. Refusing to employ the content prong of the Artistic Relevance Test in cases involving the use of expressive marks in titles would avoid this sort of inquiry.

D. Modifying the Artistic Relevance Test

A modified Artistic Relevance Test is the most appropriate answer.²³⁹ Under the existing formulation, the content prong dives into the deep end of judging the artistic merit of an artist's work. A more appropriate analysis would only infringe on the rights of an artist who engaged in deceitful or deceptive practices by using a mark or a persona to imply endorsement, sponsorship, or origin of the artistic work. Under this test, the artist would know exactly what the law allows, and the court would not face the need to make a content determination. A similar approach has found favor in other

234. *Id.* at 453.

235. *Id.* at 452–53.

236. *Id.* at 454.

237. *Id.*

238. *Id.* (emphasis in original).

239. See Timbers & Huston, *supra* note 14, at 1300 (tracing the increasing popularity and application of the Artistic Relevance Test).

legal systems.²⁴⁰ Australian courts require a finding of false implication of endorsement in order to find liability for the unauthorized use of one's image, a right analogous to the use of one's name in a title.²⁴¹ Authors describing this legal standard have noted that American courts would likely reach a different result than Australian courts because, in America, "[a] mere misappropriation for commercial purposes constitutes a wrong done to the person," whereas in Australia, "a celebrity is legally wronged only where there has been some deception or misrepresentation."²⁴²

Claims based upon dilution and the right of publicity must overcome broad First Amendment protections.²⁴³ The First Amendment protections for artists sued under the Lanham Act are not as broad, though.²⁴⁴ Some have attributed this difference to the narrow pleading requirements and the specificity of the likelihood of confusion standard found in trademark law.²⁴⁵ This fails to note that the pleading of these cases under the Lanham Act is a fairly recent occurrence when compared to the history of their pleading under dilution and the right of publicity.²⁴⁶ As such, the growing trend of broad First Amendment protections for works challenged under the Lanham Act may merely illustrate that cases pleaded under trademark law are finally providing artists the protection they deserve, after an initial period of doctrinal confusion as to the scope of a "new" cause of action.

240. See MARGARET DAVIES & NGAIRE NAFFINE, ARE PERSONS PROPERTY? LEGAL DEBATES ABOUT PROPERTY AND PERSONALITY, 140-46 (2001) (examining Australian law surrounding the use of a celebrity's image).

241. *Id.* at 145 ("It is for individual celebrities to determine what they wish to endorse The limit of this recognition of self-ownership in Australian law is reached where a person's image is used for commercial purposes without any false implication of endorsement.").

242. *Id.*

243. See Timbers & Huston, *supra* note 14, at 1300 (noting that claims of dilution and right to publicity are subject to broad First Amendment defenses).

244. See *id.* at 1301 (asserting that courts addressing titles such as those found in *Parks* have not looked upon them favorably).

245. See *id.* at 1300 ("Dilution and right of publicity claims are . . . not reined in by the doctrine of likelihood of confusion," and, as such, "it seems correct that courts more quickly apply the First Amendment to protect expressive works from these potentially overbroad types of claims").

246. See *id.* at 1279 (citing *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979), as one of the early, "most famous, influential and typical" of suits brought under trademark law in which the defendant asserted First Amendment defenses); David J. Michnal, Note, *Tiger's Paper Tiger: Endangered Right of Publicity*, 58 WASH. & LEE L. REV. 1155, 1160 (2001) (attributing the term "right of publicity" to the Second Circuit in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953)).

E. How a New Standard Reflects the Realities of the Marketplace

An analysis devoid of a content inquiry recognizes the realities of the marketplace for artistic content. In today's society, consumers are able to choose books, music, and movies after obtaining a substantial preview of the material in question.²⁴⁷ Even a consumer purchasing a book over the Internet may be able to read a few pages of its content prior to completing the purchase.²⁴⁸ Similarly, many music stores, both brick and mortar and online, allow customers to listen to an album before they buy it.²⁴⁹ Movies present a harder case in this respect, but the title *Ginger and Fred* was an acceptable infringing use,²⁵⁰ even though the general public had less of an opportunity to find out what the movie was truly about.²⁵¹ Because the public has a better chance of being fully informed as to the content of a work that they are buying in the case of a novel or a song, a court should not shy away from allowing the public to be exposed to artistic works that use the name of a celebrity or an expressive mark in a title. If the public finds the title to be distasteful or misleading, it may make its dissatisfaction known at the cash register.

247. See *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 886 F.2d 490, 496 (2d Cir. 1989) (noting that in the context of the purchaser of a book, "even for those few readers who might be slightly confused by the cover, the most likely reaction would be to open the book").

248. See David D. Kirkpatrick, *Amazon Plan Would Allow Searching Texts of Many Books*, N.Y. TIMES, July 21, 2003, at C1 (describing Amazon.com's "Look Inside the Book II" program, which allows customers to search the text of selected books for terms, and noting its genesis in "a current program that lets shoppers read a table of contents, a first chapter or a few selected pages provided by the publishers of certain books").

249. See Ben Hammersley, *Duelling Music Outlets Ring to Sound of Cash*, TIMES (London), Aug. 4, 1999, (Inter//face Magazine), at 9 (asserting that a majority of customers visiting the online music store CDNow "don't buy anything, they just listen to the music" and noting that CDNow was making half a million audio clips available online); Dan Margolis, *Music to Customer's Ears; Retail: CD Buyers can Hear Them First in Stores Run by Pair who Devised the Listening Posts for a UCI Business Class*, L.A. TIMES, June 14, 1995, at D1, LEXIS, News & Business, News File (noting that "a multitude of music stores and other retailers have installed posts where customers can don headphones and listen to anything from Snoop Doggy Dogg rap to Green Day alternative-rock to classic Beethoven"); Jeff Pelling, *Music to Cyber-Marketers' Ears: CDs on the Net*, CHI. TRIB., Feb. 16, 1996, at 71 (describing that online retailer Intouch, at worldwidemusic.com, offered thirty-second music snippets of music for preview).

250. See *Rogers v. Grimaldi*, 875 F.2d 994, 1005 (2d Cir. 1989) (holding the use of the title *Ginger and Fred* not actionable under the Lanham Act).

251. Movie trailers and previews inherently provide less information than actually reading a few pages of a book or listening to a clip of a song.

F. Other Solutions and the Problems They Present

Recently, commentators have suggested a more moderate approach than the elimination of the content prong of the Artistic Relevance Test.²⁵² They suggest that in cases such as *Parks*, a more appropriate inquiry asks whether the title itself should be protected as expression, and not whether the title bears any obtuse "artistic relevance" to the underlying content of the work.²⁵³ While this inquiry certainly would afford more protection for the artist in the event of a jury trial, it ignores the fact that the judicial system still gets to make a content determination concerning an artistic work. In fact, this inquiry only emphasizes that a court can determine whether the speech is art. In making this determination, the court has the ability to influence speech by keeping an artist in the judicial process until settlement becomes the only efficient option.

As expressed by *Westchester Media*, some courts have found that the appropriate solution to this balance lies in the remedy.²⁵⁴ There, the lower court imposed an injunction that allowed Westchester to publish a sports magazine entitled POLO, but not a lifestyle magazine under that title.²⁵⁵ In determining that the injunction ordered by the lower court was inappropriate, the Fifth Circuit noted that Westchester did own a trademark for the publication of a magazine under the title of POLO²⁵⁶ and that the editorial line between the two new magazines was not clear.²⁵⁷ Both of these issues parallel those found in the *Parks* case. Just as Westchester owned the right to publish a magazine under the name POLO, OutKast has the First Amendment right to create their songs. Additionally, the editorial line between the altering of the title of a song and the altering of the content of a song is not clear. Therefore, in *Parks*, any injunctive relief would carry a danger of judicially altering the content of the song in question, a concern that has been well expressed by recent

252. See Timbers & Huston, *supra* note 14, at 1297 (positing that a proper test would be one that inquired into whether the aspect of the challenged work (such as a title) is in itself "artistic expression," and not requiring "relevance" to the underlying work as a prerequisite to affording protection).

253. See *id.* (asking instead whether the title serves any "noncommercial" use).

254. See *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 673 (5th Cir. 2000) (noting that a broad injunction allowing the publication of a sports magazine, but not a lifestyle magazine, under the title POLO "would in practice pose a continual threat of substantive editing to the magazine").

255. See *id.* at 663 (presenting the lower court's holding).

256. See *id.* at 673 ("Westchester has the right to publish some magazine under the title POLO.").

257. See *id.* (noting that "the editorial line between the publications is not clear").

commentary.²⁵⁸ This solution fails to acknowledge that if an artist has the right to create a work, that artist should have the right to market it in any appropriate manner.²⁵⁹

G. *Wrapping It Up*

Music, literature, poetry, sculpture, paintings, and all other forms of artistic expression are inherently open for interpretation. Any interpretation is subject to change and is likely to evolve with the passage of time and the institution of new social norms. Specifically in the fields of literature, poetry, and art, entire careers are spent debating the proper meanings of both popular and classic works. It therefore seems extremely superficial to allow twelve contemporaries of an artist to declare as a matter of law that the artist's creation means one thing or another, and, in so doing, possibly require the artist to alter that expression, as changing the title of a work surely alters the work itself.²⁶⁰ Often the title of a work serves as a sort of key that may be used to crack the code of the work itself and to focus one's attention on the artist's intended meaning.²⁶¹ Surely Andy Warhol was not trying to sell Campbell's soup.²⁶² Yet if a suit had arisen because of his painting, could anyone really have claimed to understand what he was trying to do, or if there would have been a "better" way to do it?

The bottom line is that each approach has flaws in dealing with expressive content. Should our society allow as few as twelve people, from one region of the country, to determine if an artist "correctly" used a name as a symbol, as

258. See Timbers & Huston, *supra* note 14, at 1297, 1301 (noting certain shortfalls of applying the Artistic Relevance Test to the titles of works; asserting that a more appropriate test might look not to the title's relevance to the underlying work, but rather to whether the title itself is artistic expression; and further opining that the Artistic Relevance Test would have to be broadened considerably to protect titles such as *Rosa Parks*).

259. See *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 336–37 (E.D. Pa. 1996) (holding that because the defendant had the right to create a movie about plaintiff, defendant had a right to use plaintiff's name and likeness in the promotion of that movie).

260. See *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989) ("The title of a movie may be . . . an integral element of the film-maker's [sic] expression Film-makers [sic] and authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works.").

261. See *id.* ("The subtleties of a title can enrich a reader's or a viewer's understanding of a work.").

262. See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) ("[Upon seeing] a painting titled 'Campbell's Chicken Noodle Soup,' we're unlikely to believe that Campbell's has branched into the art business. Nor, upon hearing Janis Joplin croon 'Oh Lord, won't you buy me a Mercedes-Benz?', would we suspect that she and the carmaker had entered into a joint venture.").

might be done in the *Parks* case? Or, in the alternative, should our society accept one judge's view that a title is artistically relevant or not as a matter of law? Settling for this result seems hollow and shameful in a culture that prides itself on freedom of speech.²⁶³ Therefore, in attempting to balance an artist's rights with those of a markholder when viewing the use of an expressive mark in the title of an artistic work, the courts should only look to whether the title misleads as to sponsorship or endorsement, and not adjudicate the appropriateness or meaning of the use in light of what it views as the artist's purpose or message.

V. What Would This Mean for Parks and Similar Cases?

Someone's name, standing alone, should not signify endorsement. The Second Circuit in *Rogers* skirted this very issue by pointing to *Estate of Hemingway v. Random House Inc.*,²⁶⁴ which held that the estate of Ernest Hemingway did not have a cause of action against the author of a biographical work entitled *Papa Hemingway*.²⁶⁵ This case and its holding seem to suggest that merely using someone's name, or a nickname, does not imply endorsement and therefore should not confuse the consumer.²⁶⁶ But that case dealt with a biography, and there existed no question concerning the title's relevance to the

263. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-52 (1903) (explaining the dangers of allowing judicial determination of artistic merit).

264. *Estate of Hemingway v. Random House Inc.*, 244 N.E.2d 250 (N.Y. 1968). In *Hemingway*, the estate of famous author Ernest Hemingway sued the author and publisher of a biography entitled *Papa Hemingway* on grounds of a violation of common law copyrights, unfair competition, violation of a confidential and fiduciary relationship, and violation of the right of privacy. *Id.* at 252-53. The author of the biography had been a close friend of both Hemingway and his wife, Mary. *Id.* at 253. After Hemingway's death, the author wrote a book, which became the subject of this suit, containing many quotes and anecdotes from the duration of the author's friendship with Hemingway, along with medical information surrounding Hemingway's suicide that the author knew because of his close relationship with the Hemingway family. *Id.* The Supreme Court of New York dismissed all counts on summary judgment. *Id.* The Appellate Division affirmed these grants of summary judgment. *Id.* at 253. The Court of Appeals also affirmed the grants of summary judgment. *Id.* at 259. Notably, the Court of Appeals, in deciding the unfair competition claim, observed that the biography presented "no competition of any kind, unfair or otherwise," with Hemingway's work, and acknowledged the lack of "palming off" or other deceitful practice. *Id.* at 256. The court did note, however, that Hemingway, prior to his death, had acquiesced to the author's writing about him. *Id.*

265. *Id.* at 259.

266. See *id.* at 256 (noting the lack of "palming off" or deceitful practices presented by the facts of the case).

content.²⁶⁷ Furthermore, the case did not explicitly address the use of Hemingway's name in the title; rather, it focused on the author's appropriation and use of Hemingway's utterances over the course of their friendship.²⁶⁸

Whether the Second Circuit's use of this authority for the proposition that someone's name in a title does not imply endorsement is the best fit or not, the message is clear. As expressed by Judge Kozinski in *Mattel*: "A title is designed to catch the eye and to promote the value of the underlying work."²⁶⁹ He further noted that "[c]onsumers expect a title to communicate a message about the book or movie, but they do not expect it to identify the publisher or producer."²⁷⁰ "A title tells us something about the underlying work, but seldom speaks to its origin."²⁷¹ Judge Kozinski's explanation of how to distinguish *Mattel* from earlier cases such as *Dr. Seuss* seemingly qualifies this point by noting that "where an artistic work targets the original and does not merely borrow another's property to get attention,"²⁷² it should merit First Amendment protection. He also cited authority for the proposition that "a parodist whose expressive work aims its parodic commentary at a trademark is given considerable leeway, but a claimed parodic use that makes no comment on the mark is not a permitted trademark parody use."²⁷³ Under an analysis devoid of the content inquiry, however, he could avoid distinguishing the cases altogether, because unlike both *Parks* and *Mattel*, *Dr. Seuss* does not involve a protectable interest in something larger than a mere product. The use of the word "Barbie" connotes the image not just of a little girl's doll, but also of a way of life.²⁷⁴ Similarly, mentioning Rosa Parks evokes the notion of an ideal even more than the image of a discrete person.²⁷⁵ *Dr. Seuss* concerned a humorist's appropriation of the title of a discrete protectable work, *The Cat in the Hat*, and not the use of a word or mark that

267. See *id.* at 253 (describing the title and contents of the book at issue).

268. See *id.* (listing the plaintiff's assertions).

269. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003).

270. *Id.* (citing *Application of Cooper*, 254 F.2d 611, 615-16 (C.C.P.A. 1958)).

271. *Id.*

272. *Id.* at 901.

273. *Id.*

274. See *id.* at 898 ("She remains a symbol of American girlhood, a public figure who graces the aisles of toy stores throughout the country and beyond. With Barbie, Mattel created not just a toy but a cultural icon.").

275. See *Parks v. LaFace Records*, 329 F.3d 437, 442 (6th Cir. 2003) (describing Rosa Parks as "a symbol of the civil rights movement in the United States during the 1950's [sic] and 1960's, [sic]" and describing how her refusal to move to the back of a segregated bus in Montgomery, Alabama, sparked "organized boycotts, sit-ins, and demonstrations all across the South").

brings to mind something more than just the work in question. Further, the way the humorist added only one word to the title of the work could have created more of a possibility of confusion as to sponsorship or endorsement.²⁷⁶ Because *Dr. Seuss* involved only the appropriation of a discrete mark, the title of a literary work, and *Mattel* involved the use of an expressive mark, the cases should require different methods of analysis.

VI. Conclusion

The Artistic Relevance Test represents an extension of First Amendment protection for artists, but it does not do enough.²⁷⁷ Initially established for the protection of the consumer, trademark law should not be allowed to restrict artistic expressions in media that inherently thrive on consumer discretion²⁷⁸ and allow ample avenues to preview the content of the work.²⁷⁹ In order to protect the public's ability to make an informed choice as to the products they prefer, the law must protect the public's ability to have such a choice. In the area of artistic content, this means protecting the artist's right to expression.

The courts could better protect the interests of the artists involved by doing away with the content prong of the Artistic Relevance Test completely and instead focusing on whether the use of the mark is misleading as to sponsorship or endorsement only.²⁸⁰ This would afford an absolute protection to artistic content that does not attempt to prey on consumers and would provide certainty for all parties.²⁸¹ In so doing, courts would further protect artistic expression by preventing corporations or celebrities from dragging artists into court for the sole purpose of inducing a settlement, a ploy that inevitably restricts speech through the threat of protracted and expensive legal proceedings.²⁸² Furthermore, this approach is more in line with the general idea behind trademark law, the

276. Without involving an alternative avenues approach, (such as, would *The O.J. is NOT in the Hat* have been less confusing?) it should be enough to say that a title such as *The Cat NOT in the Hat* has a great chance of being seen by many as a sequel, or at least another story by Dr. Seuss.

277. See *supra* Part IV.C (explaining the shortcomings of the Artistic Relevance Test when faced with expressive titles of artistic works).

278. See *supra* Part II (examining the initial purposes of trademark law).

279. See *supra* Part IV.E (explaining methods of previewing artistic content before purchase).

280. See *supra* Part IV.D (presenting a proposal for the elimination of the content prong of the Artistic Relevance Test when applied to expressive titles of artistic works).

281. See *supra* Part IV.G (concluding that the content prong of the Artistic Relevance Test should not apply to expressive titles).

282. See *supra* Part IV.B (describing the dangers of judicial content inquiries).

protection of the consumer.²⁸³ It would also avoid the requirement that a judge or jury make a determination as to the meaning of the artistic work. Under the current tests, a judge or jury enjoys too much discretion to force the modification of artistic expression in broad strokes, ignoring the possibility of less intrusive remedies.²⁸⁴

Again, trademark law is primarily employed to protect the rights of the consumer.²⁸⁵ Permitting its use in cases where the element being challenged is itself expressive allows and invites the judiciary to give the plaintiff too many rights and encourages artists to change their works in order to avoid a protracted legal battle. In light of these concerns, trademark law should not be used to vindicate the rights of an individual when doing so adversely affects the public. The song *Rosa Parks* received a Grammy nomination in 1999,²⁸⁶ and the band won Grammys for Best Rap Duo or Group and Best Rap Album in 2001.²⁸⁷ Most recently, OutKast won another Grammy for Album of the Year in 2003.²⁸⁸ If the public were truly outraged over OutKast's business practices and artistic choices, would the band have received such awards? Would OutKast have been nominated for a Grammy for *Aquemini* (the album on which *Rosa Parks* appears)²⁸⁹ if the voters had thought that the band sold records by preying on unwitting consumers who expected to hear a song about Rosa Parks? In fact, the public does not seem to have been duped into buying *Aquemini* by the clever use of Rosa Parks's name as a marketing tool. The band's current success implies that the public actually likes OutKast's music. It would be a true shame if OutKast had been forced to either slow or abandon the creative process on their newest Grammy winning album to justify their artistic choices to a judge and jury. The law should endeavor to provide a test that protects speech that is worthy of a Grammy, even if the court dislikes that speech. A test devoid of a content inquiry would accomplish this goal.

283. See *supra* Part II (examining the initial purposes of trademark law).

284. See *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 663 (5th Cir. 2000) (remanding the case to the district court for consideration of remedies other than a broad injunction).

285. See *supra* Part II (presenting an analysis of the initial purposes of trademark law).

286. See *Parks v. LaFace Records*, 76 F. Supp. 2d 775, 778 (E.D. Mich. 1999) (noting that OutKast received its first-ever Grammy nomination for the song).

287. *The Top Grammys: Alicia Keys, U2, and 'O Brother'*, N.Y. TIMES, Mar. 1, 2002, at E36.

288. *The Grammy Award Winners of 2004*, N.Y. TIMES, Feb. 9, 2004, at E5.

289. See Geoffrey Himes, *OutKast "Aquemini" LaFace; Black Eyed Peas "Behind the Front" Interscope*, WASH. POST, Dec. 4, 1998, at N20 (describing that "[t]he first single off the new OutKast album, 'Aquemini,' is 'Rosa Parks'").