

US: TRADE MARKS

Trade mark infringement test for TV show titles

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In *Twentieth Century Fox Television v Empire Distribution* the US Court of Appeals for the Ninth Circuit recently addressed the issue of the appropriate test to apply when an allegedly infringing use is in the title or within the body of an expressive work.

Empire Distribution, a record label that releases albums in the urban music genre, had sent a demand letter to Twentieth Century Fox Television (Fox) regarding a television show titled “Empire”, which portrays a fictional music label named “Empire Enterprises”. In response to such demand letter, Fox commenced a law suit seeking a declaratory judgment that the “Empire” television show did not violate Empire Distribution’s trade mark rights. Empire Distribution, in turn, counter-claimed for trade mark infringement under the Lanham Act, among other causes of action.

The district court granted summary judgment in favour of Fox, holding that Fox’s use of the name “Empire” was protected by the First Amendment and, as such, outside the reach of the Lanham Act. Empire Distribution appealed such decision to the Ninth Circuit.

In reviewing the district court’s decision, the Ninth Circuit noted that, generally, Lanham Act claims of trade mark infringement are governed by a likelihood of confusion test. However, when the allegedly infringing use is in the title of an expressive work (such as, in the case at hand, a television program), the court first applies the “*Rodgers*” two-prong test to determine whether the Lanham Act is applicable. The court explained that expressive works are treated differently because: “(1) they implicate the First Amendment right of free speech, which must be balanced against the public interest of avoiding consumer confusion; and (2) consumers are less likely to mis-

take the use of someone else’s mark in an expressive work for a sign of association, authorship or endorsement.”

Under the *Rodgers* test, a television show title does not violate the Lanham Act “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.” In applying the *Rodgers* test, the Court found that Fox’s use of the name “Empire” satisfied both prongs. First, the Court determined that Fox used the word “Empire” for artistically relevant reasons – noting that the level of relevance does not need to be high – since the television show is set in New York (known as “The Empire State”) and its subject matter is a music and entertainment conglomerate (a figurative empire). Second, the Court found that Fox’s use of the title did not explicitly mislead consumers, indicating that it contains no overt claims or explicit references to Empire Distribution and no explicit misstatement that caused consumer confusion. In analysing the second prong, the Court held that “use of a mark alone is not enough” and that they must ask not only about the likelihood of consumer confusion but whether the creator explicitly misleads consumers.

The Court also dismissed Empire Distribution’s arguments that Fox’s use of the “Empire” mark “as an umbrella brand to promote and sell music and other commercial properties” falls outside the title of an expressive work and therefore outside the *Rogers* test. The Court noted that “it requires only a minor logical extension of the reasoning of *Rogers* to hold that works protected under its test may be advertised and marketed by name.”

This decision is instructive for media companies when developing content.