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Of Dancers, Black Panthers, Cheerleaders, and Icons: Reflections of the Idea/Expression Dichotomy in the Relevance Prong of the *Rogers* Test

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I. INTRODUCTION

When it comes to artistic or expressive works, it is quite common for the work's artist or author to rely on others' trademarks to facilitate their artistry or expression.¹ Andy Warhol painted lots of Campbell's

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1. A trademark is generally "any word, name, symbol, or device, or any combination thereof" that enables a consumer "to identify the origin or ownership of the goods to which it is affixed." 15 U.S.C. § 1127 (2006); *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916). In their most typical forms, trademarks are product names or slogans, but trademark protection may also apply, under certain circumstances, to scents, colors, and sounds. *See, e.g., Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (finding the green-gold color of certain dry cleaning pads susceptible to trademark protection). Even a celebrity or historical figure's

soup cans.² Raymond Queneau's *Zazie* needed her "Caco Calo," an intentional mistranscription of Coca-Cola.³ Lucy Pleasantchurch drew criticism from the Emersons for her reliance on a Baedeker's tour book in Forster's *A Room with a View*.⁴ Mark Knopfler's *Border Reiver* ferried about the south of Scotland in his Albion, a truck "sure as the sunrise."⁵ Kanye West suggests that a Super Bowl MVP might win a Hyundai at the conclusion of his notable on-field performance; whereas other, more hard-pressed individuals are relegated to piloting Datsuns.⁶ Even Miley Cyrus finds that a Britney Spears song improves her party-going experience.⁷

These represent but a few specific cases. In each instance, the use of the trademark is completely legal. This is because trademarks are not a form of property in gross, but protectable generally only as a means of identifying a good or service in commerce.⁸ The United States Supreme Court, the better part of a century ago, noted in this respect: "In truth, a trade-mark confers no monopoly whatever in a proper sense, but is merely a convenient means for facilitating the protection of one's goodwill in trade by placing a distinguishing mark or symbol—a commercial signature—upon the merchandise or the package in which it is sold."⁹ Consistent with this limited protection, a trademark most strongly protects its owners against the use of confusingly similar names in commerce.¹⁰ Such confusing similarity, which gives rise to a claim for

name may merit trademark protection if used in conjunction with that celebrity's goods or services. See generally *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003).

2. Thirty-two, to be exact, in one of the more famous iterations. *Andy Warhol: Campbell's Soup Cans 1962*, MOMA.ORG, http://www.moma.org/collection/object.php?object_id=79809 (last visited Apr. 12, 2010).

3. RAYMOND QUENEAU, *ZAZIE DANS LE MÉTRO* 18 (Éditions Gallimard 2003) ("J'ai déjà dit: un cacocalo.").

4. E.M. FORSTER, *A ROOM WITH A VIEW* 19 (Barnes & Noble Books 2005) (1908) ("Tut, tut! Miss Lucy! I hope we shall soon emancipate you from Baedeker.").

5. MARK KNOPFLER, *Border Reiver*, on GET LUCKY (Will D. Side Ltd. under exclusive license to Reprise Records 2009).

6. KANYE WEST, *Gold Digger*, on LATE REGISTRATION (Roc-A-Fella Records, LLC 2005).

7. MILEY CYRUS, *Party in the U.S.A.*, on THE TIME OF OUR LIVES (Hollywood Records, Inc. 2009).

8. See, e.g., *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 98 (1918).

9. *Id.*

10. Trademark law also provides certain other protections. Notable among these are protections against dilution, or a weakening in a famous mark's ability to identify the goods or services to which it is normally applied. Dilution takes on associated sub-forms of tarnishment and blurring. 15 U.S.C. § 1125(c)(1) (2006). Dilution by blurring is defined as "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." *Id.* § 1125(c)(2)(B). This might occur, according to the relevant House Report, through "the use of DUPONT shoes, BUICK aspirin, and KODAK

infringement under section 43(a) of the Lanham Act,¹¹ is detected judicially by resort to some variation on the *Polaroid* factors test, named for the case that introduced it, which considers:

[T]he strength of [the original user's] mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap [between the two marks' markets], actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers.¹²

This test works quite well in a run-of-the-mill case involving commercially available goods—where, for example, a supplier fills store shelves with a product whose name or packaging is similar to another supplier's—because it asks questions well-tailored to ferret out such confusion. If one would like to figure out whether a consumer will be confused as to the relation of two goods, it is worthwhile to determine whether there is actual confusion by conducting appropriate surveys.¹³ On a more objective level, one would equally want to review the degree of similarity between the goods and how likely they are to be placed in overlapping areas of the market.¹⁴ Greater similarity and more significant overlap would contribute to a greater likelihood of confusion on the part of consumers.¹⁵ Equally relevant are the sophistication of the consumer and the intent of the alleged infringer.¹⁶ Less sophisticated consumers are more likely to be duped, and ill-intentioned infringers are more likely to succeed in a goal of appropriating an earlier rightsholder's goodwill.¹⁷ A

pianos.” H.R. REP. NO. 104-374, at 3 (1995). Dilution by tarnishment, by contrast, is defined as “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.” 15 U.S.C. § 1125(c)(2)(C). A claim for dilution has arisen, for instance, in connection with an adult store's use of the name “Victor's Little Secret,” for which the famous Victoria's Secret brand claimed tarnishment. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003). Counterfeiting is also actionable under current trademark law. While worth noting here, these and other additional trademark protections are less relevant to this Article and will not be discussed at length.

11. 15 U.S.C. § 1125(a)(1)(A) (“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 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.”).

12. *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961).

13. *See, e.g., Malletier v. Dooney & Bourke, Inc.*, 525 F. Supp. 2d 558 (S.D.N.Y. 2007).

14. *Polaroid*, 287 F.2d at 495.

15. *See id.*

16. *Id.* at 494-95.

17. *See id.*

well-considered review of these factors in a competitive commercial setting should sufficiently detect the presence or absence of a likelihood of confusion.¹⁸

Review of these factors, however, is not as well-suited to cases concerning expression, as demonstrated by the examples noted at the outset of this Article. For example, most businesses do not branch out into the world of strictly artistic expression in a way that would confuse consumers into believing that a corporation is at the origin of a piece of music or art.¹⁹ The United States Court of Appeals for the Ninth Circuit explained in this respect:

If we see 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. . . . “[M]ost consumers are well aware that they cannot judge a book solely by its title any more than by its cover.”²⁰

In other words, it does not make much sense to ask whether consumer confusion would play a significant role when someone is looking to buy a Janis Joplin CD. They are probably not in the market for Mercedes’ latest pop offering. As such, factors like consumer sophistication, bridging the gap, intent, and actual confusion have little to no relevance to that type of consumer purchasing decision; and the factors test seems all the more ill-suited to this trademark inquiry.

But on a more fundamental level, probing for a likelihood of confusion using the factors test is inapplicable to these examples because the trademark use at issue is different than the simple placement of a label on a competing good in commerce. The trademark, instead, is doing much more than just identifying a good—it is referring to points of collective cultural experience as part of the expression of an idea. Consistent with the limits which dictate that a trademark does not confer rights akin to property in gross, this kind of use is legal regardless of the likelihood of confusion test. The public can sufficiently distinguish trademarks used by a primary source or for a goods-identifying function from such expressive uses as allusion, parody, and metaphor. As Judge Kozinski noted: “Some trademarks enter our public discourse and become an integral part of our vocabulary What else is a quick fix,

18. *See id.*

19. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

20. *Id.* (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989)).

but a Band-Aid? . . . Trademarks often fill in gaps in our vocabulary and add a contemporary flavor to our expressions.²¹

Each of the examples noted at the outset of this Article taps into a trademark's ability to function as more than a simple identifier of a good or service in a commercial setting. Warhol's work, consistent with the tenets of the Pop Art school, incorporated elements of popular culture and advertising, such as the Campbell's cans, within his art.²² But the specific choice of Campbell's cans may have more specifically enabled Warhol to juxtapose the cans' contents with a playful view on mass production. Queneau's use of Coca-Cola highlighted the fragmenting diction of a spitfire youth while perhaps weighing in on the more limited French interest in American soft drinks.²³ The mistranscription may have equally served the mathematician Queneau's interest in numbers and patterns through symmetrical two-place letter shifts that resulted in further linguistic symmetry. Forster's use of *Baedeker* indirectly framed a cabined sort of middle-class English tourism owing to both *Baedeker's* unique popularity and its apparently underinclusive scope.²⁴ Knopfler's nod to Albion Motors, a now-defunct Scottish brand, allowed him to imbue local character with his modern reworking of the long-bygone practice of border reiving in southern Scotland.²⁵ Kanye's reliance on Hyundai sarcastically placed a lesser-regarded auto nameplate on a prestigious pedestal with which it would not typically be associated.²⁶ His use of the obsolete Datsun name, which was rebranded Nissan in the 1980s, underscores the inferior quality of a car by its sheer age. Finally, Miley Cyrus relied on Britney Spears' name to depict how a shy young partygoer might rely on a personal connection with a specific song as a means to overcome the anxiety she feels in an otherwise overwhelmingly unfamiliar social setting.²⁷ Like, yeah.²⁸

Some of the more advanced judicial vetting of these expressive trademark uses has occurred in the area of literary titles that incorporate another's trademark. Perhaps the most authoritative treatment of such titles flows from the decision in *Rogers v. Grimaldi*.²⁹ There, the United States Court of Appeals for the Second Circuit confronted a suit alleging

21. *Id.* at 900.

22. *Id.*

23. *See* QUENEAU, *supra* note 3, at 18.

24. *See* FORSTER, *supra* note 4, at 19.

25. *See* KNOPFLER, *supra* note 5.

26. *See* WEST, *supra* note 6.

27. *See* CYRUS, *supra* note 7.

28. *Id.* This is a repeated lyric in Cyrus's song and a generally important sentiment.

29. 875 F.2d 994 (2d Cir. 1989).

infringement arising out of Federico Fellini's movie entitled *Ginger and Fred*, a phrase typically associated with the famous dance pairing of Ginger Rogers and Fred Astaire.³⁰ The film's title offers an oblique allusion to the elegance of the original Ginger and Fred, while the film itself recounts the lives of a less glamorous fictional dance duo whose style earned them their more famous forebears' nickname.³¹

Mindful that the title's use constituted more than mere commercial expression, the Second Circuit noted a more sensitive balance of interests than that present in other such commercial trademark cases.³² More specifically, the court determined that in addition to the public interest in avoiding consumer confusion, present in both the instant case and a standard trademark case, Fellini's use of the phrase "Ginger and Fred" for his film's title also implicated a countervailing public interest in the exposition of the expressiveness of the title.³³ When the court decided that the likelihood of confusion test did not sufficiently protect the latter interest, it formulated an alternative two-prong test more specifically tailored to the competing public interests.³⁴ That test reviewed, first, whether the title bore some artistic relevance to the underlying work, and second, whether the title was explicitly misleading.³⁵ With that test in mind, the court found that the title satisfied both prongs and therefore did not infringe the rights of the original Fred and Ginger.³⁶

In the two decades since the *Rogers* case, the Second Circuit's two-prong test has witnessed widespread adoption, but courts have largely been content to limit its application to cases involving alleged trademark infringement occurring in the title of literary and artistic works.³⁷ In the recent Ninth Circuit decision in *ESS Entertainment 200, Inc. v. Rock Star Videos, Inc.*, however, the court elected to expand the applicability of the *Rogers* test to all expressive uses of a trademark within a larger literary or artistic work.³⁸

This expanded application of the *Rogers* test promises far-reaching consequences as the test may now apply to a much greater number of trademark uses. A quick perusal of the trademark uses detailed at the

30. *Id.* at 996.

31. *Id.* at 996-97.

32. *Id.* at 999.

33. *Id.*

34. *Id.* at 1000.

35. *Id.* at 999.

36. *Id.* at 1000.

37. *See, e.g.*, *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003); *Mattel, Inc. v. Walking Mountain Prods., Inc.*, 353 F.3d 792 (9th Cir. 2003); *Sugar Busters LLC v. Brennan*, 177 F.3d 258 (5th Cir. 1999).

38. 547 F.3d 1095 (9th Cir. 2008).

beginning of this Article would suggest this: in all cases but the Warhol painting, the trademark appeared in the body, but not the title, of the work. Many similar examples probably leap to mind.³⁹ One might find it more difficult, however, to compile a lengthy list of works whose use of third-party trademarks is limited to the title. In accordance with the *Rogers* test's newfound importance, some further guidance as to the test's contours might be of some use.

This Article attempts to provide just such guidance for the test's first prong, the relevance of a trademark's use to the underlying work.⁴⁰ While the concept of "relevance" might seem straightforward enough, particularly in view of its mature development in other areas of the law, judicial decisions applying that prong belie this superficial ease, and instead reveal a more complex undertaking, and on occasion, a fumbling approach.⁴¹ This Article proposes that judicial treatment of the relevance prong can best be understood from the perspective of copyright law's "idea/expression dichotomy," which states that copyright protection only extends to "expression" and not "ideas."⁴² Because the *Rogers* test requires courts to assign an "idea" to which the trademark use must be relevant, the similar "idea" assignment process undertaken by copyright to determine protectability suggests that this area of copyright law might provide useful explanation and analysis for the less developed, but currently growing, relevance prong of the *Rogers* test.⁴³ And while that may appear to be a superficial similarity, perhaps even a red herring, closer review of these distinct areas of the law reveal deeply shared analytical commonalities. Based on these shared commonalities, this Article argues that the relevance/irrelevance boundary at issue in the *Rogers* test falls coextensive to an important boundary of the idea/

39. If you are familiar with the television program *Seinfeld*, you can probably think of numerous trademarks used in that program's run alone, from the musical group The Eagles, Brentano's bookstore, the board game Risk, and Twix candy bars to Bosco chocolate syrup, Chrysler LeBaron, the New York Yankees, and the J. Peterman catalog. Trademarks in titles, on the other hand, seem about as unusual as the film *Harold and Kumar Go to White Castle*.

40. *Rogers*, 875 F.2d at 1001.

41. See FED. R. EVID. 401 ("'Relevant evidence' means evidence having any tendency to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would be without the evidence.").

42. See, e.g., *Golan v. Gonzales*, 501 F.3d 1179, 1184 (10th Cir. 2007) ("[T]he idea/expression dichotomy, denies copyright protection 'to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in [a copyrighted] work.' It reserves to authors, however, the right to exploit their 'expression,' a term that refers to 'the particular pattern of words, lines and colors, or musical notes' that comprise a work." (citing 17 U.S.C. § 102(b) (2006); ROBERT A. GORMAN, COPYRIGHT LAW 23 (2d ed. 2006)).

43. *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989).

expression spectrum: the boundary between portions of an expressive work constrained by the work's idea and portions of that work superfluous to that idea.

To tee up this analysis more completely, the Article takes a detour in Part II to review the underlying copyright law necessary to the subsequent analysis of the relevance prong of the *Rogers* test. Part III then refocuses on the development of the relevance prong by summarizing and analyzing a handful of cases applying that prong, including a more detailed review of the *Rogers* decision itself. Part III also summarizes the history of the “alternative avenues of communication” test sometimes historically applied as an alternative to the *Rogers* test. Based on these accounts, Part III begins to tease some general analysis from the cases themselves, while offering commentary foreshadowing the substance of Part IV. That Part, in turn, develops a more detailed synthesis of the idea/expression elements discussed in Section II and the *Rogers* history discussed in Section III.

II. A DETOUR THROUGH COPYRIGHT LAW

As this Article posits that certain copyright law theory might clarify judicial application of the first prong of the *Rogers* test, some background on that theory is required. More specifically, this Article contends that the “idea/expression dichotomy,” a concept explained in greater detail in this Part, provides a one-to-one mapping with the way that courts conceive of the “relevance” relationship between a trademark use and the underlying work under the *Rogers* test.

At the outset, however, it is worthwhile to consider why copyright theory might provide useful guidance in an area of trademark law. This is because these distinct legal regimes share critical common tendencies specifically highlighted in cases like *Rogers*. Notably, each is a field providing parties with limited protection in intangible property offset by public interest in free—that is, nonproprietary—expression.⁴⁴ For its part, copyright protection extends to “original works of authorship fixed in any tangible medium of expression,”⁴⁵ and exists as a means of incentivizing the creation of such works.⁴⁶ That protection generally

44. See *Franklin Mint Corp. v. Nat'l Wildlife Art Exch., Inc.*, 575 F.2d 62, 63 (3d Cir. 1978).

45. 17 U.S.C. § 102(a) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”).

46. See *Franklin Mint*, 575 F.2d at 63.

covers, at a minimum, the words or notes on the page, and prevents activities like unauthorized distribution, reproduction, performance, and broadcast of the protected work.⁴⁷ But copyright protection must have its limits as each added protection of individual authors' rights impoverishes the public's corresponding rights to expression.⁴⁸ Accordingly, copyright generally does not extend, for example, to whole genres of works,⁴⁹ stock characters,⁵⁰ or individual words.⁵¹ For example, the first romantic comedy would not prevent all subsequent, but different romantic comedies from being created. Nor would its use of two protagonists fated to fall in love, due to chemistry, coincidence, and the intercession of token friends, prevent subsequent romantic comedies from presenting their own two protagonists and array of telegenic automaton companions. The culmination of our first romantic comedy in a breathless exchange of "I'm in love with you's" would not prevent subsequent creators from using that phrase nor any of its individual words. Were the law to be otherwise in any of these cases, the public would find itself without the benefit of essential tools of communication.⁵²

While trademark differs from copyright to the extent to which it applies to different subject matter and for distinct policy reasons, trademark's protection must also yield to the interests of public expression. Unlike copyright's broad protection of expressive works, trademark's scope extends only to symbols or designations capable of identifying goods and services in commerce.⁵³ Additionally, unlike copyright's goal of promoting a body of expressive works, trademark law protects both corporate goodwill in a given designation as well as the consumers of those goods by prohibiting the sale or promotion of other goods and services branded in a confusingly similar manner.⁵⁴ But consistent with the limited goal of preventing commercial confusion and protecting commercial goodwill, a trademark's protection should leave ample room for expression that is either noncommercial, nonconfusing, or unrelated to the trademark. As such, while Joe Gibbs Racing can trademark the number eleven adorning the side of Denny Hamlin's

47. 17 U.S.C. § 106.

48. See *Franklin Mint*, 575 F.2d at 63.

49. *Id.* at 66 (noting that "variations on a theme" are not susceptible to copyright protection).

50. See, e.g., *Alexander v. Haley*, 460 F. Supp. 40 (S.D.N.Y. 1978).

51. See *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 285 (3d Cir. 2004) (noting in dicta that "short phrases" typically do not merit copyright protection).

52. Okay, maybe not strictly "essential." I am certain that many people could survive without another "rom com."

53. 15 U.S.C. § 1127.

54. *Id.* § 1125(a)(1)(A).

Toyota,⁵⁵ it cannot prevent soccer star Damien Duff from sporting the number on the back of his Ireland uniform.⁵⁶ Nor can it keep a scientist from using the number eleven in an equation or Sesame Street from teaching children the virtues of things grouped in elevens (like soccer squads or scientists, for example). These uses of the number eleven are unlikely to confuse anyone into believing that an auto racing team is behind Duff's, the scientist's, or Sesame Street's use of the number eleven. With these limits on a trademark's scope, public expression is allowed to remain all the more robust.

So if the protections of both trademark and copyright law are weighted to provide for public expression, a more detailed understanding of the idea/expression dichotomy, one of the primary ways copyright law accounts for the needs of public expression, might cast the public expression concerns of the *Rogers* test in sharper relief.⁵⁷ Simplified, the idea/expression dichotomy is summarized by the proposition that "expression" is susceptible to copyright protection, while mere "idea" is not.⁵⁸ This rather unhelpful axiom is partially illustrated by a few basic examples: the "idea" of a sculpture of a deer is not protectable, but the "expression" embodied in a specific artist's deer statue is; the "idea" of writing a play about star-crossed lovers is not protectable, but the "expression" of *Romeo and Juliet* is.⁵⁹ These examples, however, paint a woefully incomplete picture of the idea/expression dichotomy.

For a fuller view, another superficially easy concept, "merger," offers a useful starting point. In cases where merger applies, the nonprotectable idea swallows the protectable expression because the two are said to be effectively equivalent.⁶⁰ For instance, in *Kern River Gas Transmission Co. v. Coastal Corp.*, a natural gas company sued a competitor for copyright infringement arising out of the competitor's replication of its maps, including the depiction of a proposed pipeline

55. 11, Registration No. 3240416; 11, Registration No. 3373489.

56. See, for example, his player profile. Damien Duff, Football Association of Ireland, http://www.fai.ie/index.php?option=com_content&view=article&id=36&catid=1&Itemid=8 (last visited Sept. 24, 2010).

57. *Golan v. Gonzales*, 501 F.3d 1179, 1184 (10th Cir. 2007) (listing the idea/expression dichotomy along with fair use as copyright's two main "safeguards" of public expression).

58. See *id.*; Robert Yale Libott, *Round the Prickly Pear: The Idea-Expression Fallacy in a Mass Communications World*, 14 UCLA L. REV. 735, 737 (1967).

59. In the words of the Fourth Circuit, "Several sculptors may copy a deer, even the same deer, in creating a sculpture, and each may obtain copyright protection for his or her own expression of the original." *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 492 (4th Cir. 1996).

60. *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1463 (5th Cir. 1990).

route.⁶¹ The United States Court of Appeals for the Fifth Circuit declined to find such infringement as the map was not copyrightable to the extent of the depicted pipeline route.⁶² The court based its finding on an application of the merger doctrine.⁶³ In other words, the “idea” of mapping a fixed pipeline route merged with the specific map of the pipeline route.⁶⁴ To hold otherwise, the court feared, would grant the plaintiff gas company “a monopoly of the idea for locating a proposed pipeline in the chosen corridor.”⁶⁵

Merger cases like *Kern River* offer a compacted, diametrically opposed contrast to the first examples above. Where the idea of writing a play about star-crossed lovers dictates very little about the actual content of the play, the idea of mapping a determined pipeline route inherently dictates how that route will be shaped on a map. In other words, depending on the specific work at issue, the work’s “idea” may lie at a much greater level of generality than the work’s articulation on paper, and accordingly permit significant embellishment of the idea in that specific articulation.⁶⁶ That embellishment is precisely what copyright protects. True to copyright’s concern for public expression, the extension of its protections to that embellishment does not significantly deprive the public of fundamental expressive tools. Authors following Shakespeare would be permitted to proffer their own personal protectable embellishments on the star-crossed lovers theme while only sacrificing a right to copy Shakespeare. On the other hand, as demonstrated by the mapping case, a work’s idea may sit at precisely the same level of generality as the work’s expressive articulation. In such a case, copyright protection must yield to the public’s expressive needs because the grant of a copyright would deprive the public of the ability to express an idea, such as the mapping of a fixed pipeline route.⁶⁷

But when measured against the public’s expressive needs, examples are just endpoints where the decision to grant or deny copyright protection is relatively easy. At least in the case of the play, the work at issue might be viewed from any number of levels of abstraction more specific than the broad “idea” but more general than the long procession of words on the page.⁶⁸ For instance, the idea could be supplemented

61. *Id.* at 1459.

62. *Id.* at 1464.

63. *Id.*

64. *Id.*

65. *Id.*

66. *See* *Nichols v. Universal Pictures Co.*, 45 F.2d 119, 121 (2d Cir. 1930).

67. *Kern River*, 899 F.2d at 1464.

68. Learned Hand famously articulated in this respect:

with additional details about the plot, the characters, the organization of scenes, and the work's use of literary devices such as symbolism and metaphor.⁶⁹ Ultimately, as more detail is filled into the idea, the idea would metamorphose into a detailed synopsis of the play; and at a slightly more specific distance from that point, the play would materialize. So if the specific play itself is copyrightable, but the broadest idea describing the play is not, then a division between copyrightability and uncopyrightability must fall somewhere along this spectrum of abstraction.⁷⁰

The trouble is, however, that there is no hard and fast way to mark this division because the enunciation depends entirely on a court's frame of reference.⁷¹ Courts are usually willing to find a work protectable to the extent that the public will enjoy sufficient alternative means of communicating the same idea embodied in the work.⁷² In this respect, the public's expressive need—its access to ideas—is safeguarded from appropriation by a single author. But this presence of sufficient expressive alternatives requires a baseline by which such presence is measured, and that baseline will contribute significantly to a work's copyrightability. If a court chooses a very broad baseline, for example, a far greater number of works will pass copyright muster, as that baseline will be susceptible to numerous alternatives. The converse is also true: a very specific baseline would doom many works to unprotectable or less protectable status as such works became more significantly dictated by that baseline. Consider again the *Romeo and Juliet* example. If a court were to define the "idea" of the play as a romantic, but tragic story, *Romeo and Juliet* would enjoy broad protection as one of an infinite number of alternative articulations of that idea. All other such articulations would equally merit protection. In fact, from this broad perspective, protection would likely more readily cover subelements of the play, such as the characters and the plot, since each of those

[U]pon any work . . . , a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his "ideas," to which, apart from their expression, his property is never extended.

Nichols 45 F.2d at 121.

69. *See id.*

70. *See id.*

71. *See id.*

72. *Dymow v. Bolton*, 11 F.2d 690, 691 (2d Cir. 1926) ("[I]f the same idea can be expressed in a plurality of totally different manners, a plurality of copyrights may result, and no infringement will exist.").

subelements would also represent but one of many alternatives. If, by contrast, the court chose to label the play's idea by resorting to a fifteen-page treatment of the play, many elements of the play would be dictated by the "idea," and to this extent, no expressive alternatives would remain. From this narrowed perspective, the play might merit copyright as a whole work, but the scope of that protection—as to plot elements or characters, for example—would certainly be much more limited.

Accordingly, the judicial selection of a reasonable idea baseline is of critical importance. Unduly broad ideas, such as describing *Romeo and Juliet* merely as a "play," will permit copyright protection to expand to an unduly broad scope while also failing to capture enough detail about the work at issue. Unduly narrow ideas, such as the fifteen-page treatment of *Romeo and Juliet* noted above, would stifle copyright protection by shifting legitimately creative aspects of the play from the realm of protectable expression to the realm of unprotectable idea. Some balanced, short statement as to the play's concept and contents should adequately divide these extremes without depriving the public of significant expressive content.

This balanced assignment of the idea baseline can apply equally to subparts of a larger work. Take, for example, *Murray Hill Publications, Inc. v. ABC Communications, Inc.*, where the United States Court of Appeals for the Sixth Circuit addressed a Detroit-based radio station's allegedly infringing use of the line, "This is J.P. on JR in the A.M. Have a swell day," where the line had originally been used in the background of a movie.⁷³ The court declined to find the station's use of the line infringing, partly because the ideas underpinning the line merged with the line's expression.⁷⁴ In this respect, the court assigned several reasonable parameters to the line's idea: "whose morning show, what radio station, and what time."⁷⁵ These, in turn, dictated the line's content, rendered the line uncopyrightable, and preserved public access to a basic turn of phrase.⁷⁶

Beyond the importance of an appropriately tailored baseline by which idea and expression are measured, the idea/expression dichotomy raises additional structural issues. On one hand, a given work may trace to many different, nonoverlapping broad ideas. To recall the heavily employed example of *Romeo and Juliet*, that same play could be

73. 264 F.3d 622, 627-28 (6th Cir. 2001). The radio station had used the phrase as part of a larger advertising campaign. *Id.* at 628.

74. *Id.* at 633.

75. *Id.*

76. *Id.*

described as a cautionary tale, a romance, and a tragedy. None of these ideas necessarily overlap. In that respect, a given work can be described as following numerous distinct idea/expression vectors as the specific work is abstracted to such distinct general ideas. But the reverse of this model reveals an additional point, namely, that some broad ideas will not capture all expression found within a work as the abstractions increase in specificity. The idea of a “tragedy,” for instance, would not encapsulate nontragic elements appearing in a play. Nor, to take the image a step further, would the “idea” of writing video game software encapsulate a poem written in the software’s comments section that had no nexus with the game itself. In this way, subparts of a work may only become evident at abstraction levels closer to the specific work. In some cases, certain subelements may be all but superfluous to the work, such as the poem lining the software’s comments, and may only be susceptible to accommodation by an idea that contains an addendum specifically addressing the work’s otherwise unrelated content.

This latter point is especially important because it completes the picture first painted by the merger example. Elements of a given work, viewed from the broad idea level of the idea/expression dichotomy, break into three classes based on the level of constraint imposed on the work’s expression by its idea.⁷⁷ At one end, an idea may completely dictate certain elements of a work, such as the contents of a short radio line or the mapping of a pipeline route. These elements, uncopyrightable due to the merger doctrine, are constrained by the idea to a degree that meaningful variation on the idea is not possible. One step removed from this case are the elements of the work that are constrained, but not dictated, by the idea. For instance, a work typified by the idea of a “tragedy,” would necessarily follow a plot arc leading to an unhappy ending. While that plot acts as a constraint on the development of the story, it does not dictate how the arc will reach its conclusion. As such, certain constrained aspects may still merit copyright protection. At the far end of this spectrum is the case of the poem embedded in software code, mentioned above. Such an element of a work, though still part of the integral whole, is neither dictated nor constrained by the idea of the work, in this case, video game software. That element is, instead, superfluous to the overarching idea of the work. In view of such a limited nexus with the idea of the work, such aspects are typically copyrightable as part of the overall work due to the fact that their

77. See Thomas M. Byron, *Tying Up Feist’s Loose Ends: A Probability Theory of Copyrightable Creativity*, 7 WAKE FOREST INTELL. PROP. L.J. 45 (2007).

protection rarely threatens to deprive the public of fundamental expression.⁷⁸ At a high level then, it is reasonable to view aspects of a given work as falling into one of three categories falling along a continuum of constraint: (1) dictated or inherent to a work, (2) constrained by the work's idea, or (3) superfluous to the work's idea or otherwise arbitrary. Of these three sets, only the latter two categories are generally copyrightable.

When determining the idea, and in turn, the degree of constraint imposed on a work's expression, courts generally address the inquiry from an objective review of the work and the factors contributing to its genesis.⁷⁹ By extension, the intent of the author or artist in creating a work will not necessarily determine the work's idea for the simple fact that intent or artistic concept may not always translate directly to the resultant work. For example, in *Brandir International, Inc. v. Cascade Pacific Lumber Co.*, the court found that despite an articulated intent to impart an unconstrained, sculptural concept to a sinusoidal bike rack, the manufacturing process stunted such intent in a manner that rendered the final work uncopyrightable due to its degree of constraint.⁸⁰ Although an author's or artist's intended idea may not be reflected in the final work in all cases, the author or artist certainly does have the ability to influence the idea embodied in the work. After all, it is the author who writes the story and creates the world in which the characters live; and it is the artist who puts brush to canvas and selects what an image portrays. In this respect, the author, while unable to ensure that a work will be found to convey exactly the idea intended, can still exercise some control over the identity of the idea.

III. TRADEMARK BACKGROUND

With this background in copyright in tow, we can move on to a discussion of the historical development of the *Rogers* test through a summary of key data points, articulated by decades of case law.

78. As an exception to this, truly arbitrary expression such as random sequences of numbers may not merit copyright, because such expression does not respond to an idea more specific than "the random sequencing of numbers." See, e.g., *Toro Co. v. R & R Prod. Co.*, 787 F.2d 1208, 1216 (8th Cir. 1986) (holding that purely "arbitrary" number assignments do not merit copyright protection). That said, this example may not technically constitute a set of "superfluous" elements as they are in fact a subset, albeit an unconstrained subset, of the idea. In other cases, elements will fall entirely outside a work's idea at a broad level.

79. *Brandir Int'l, Inc. v. Cascade Pac. Lumber*, 834 F.2d 1142, 1145 (2d Cir. 1987).

80. *Id.* at 1147 (dealing with the copyrightability of so-called useful articles, which is measured in a slightly different fashion than the more standard expression discussed in this Part, but its result is telling nonetheless).

Discussion of this still-developing area of case law will provide general commentary for now, and will delay until Part IV the development of the parallels between judicial wielding of the *Rogers* test and the copyright background just discussed. Before launching into this discussion, however, this Part will begin with a review of a snapshot of the *Rogers* test's primary competitor for judicial adoption, the "alternative avenues of communication" test.⁸¹ By way of foreshadowing, this Part will also begin to track the alternative avenues of communication test's notable parallels with the idea/expression dichotomy.

A. *The Alternative Avenues of Communication Test*

The *Rogers* test has achieved widespread, but not unanimous, adoption at present. Some jurisdictions utilize an older, less speech-friendly test that gauges infringement based on the presence of "alternative avenues of communication."⁸² In other words, the test asks whether the trademark user could have expressed the same message without relying on the use of another's trademark.⁸³ While the test does not directly discuss "relevance" as applied in the *Rogers* test context, the test bears discussion here because it provides further guidance into the parallels between the judicial treatment of copyrightable creativity and the expressive use of trademarks. A summary of three cases should provide a reasonably clear picture of how the test is applied.

The test draws its origin from *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*⁸⁴ There, the Dallas Cowboys Cheerleaders (DCC) sued an adult theater owner to prevent the screening of *Debbie Does Dallas*, a pornographic film in which the cheerleader protagonist dons an outfit similar to the distinctive attire associated with the DCC.⁸⁵ Needless to say, despite her cheerleading garb, the film's protagonist was not entirely concerned with displaying the type of spirit incumbent on members of a cheerocracy.⁸⁶ Following the plaintiff's initial success in achieving injunctive relief, the theater owner appealed.⁸⁷ After a preliminary finding that the DCC uniform comprised an "arbitrary design" sufficient to function as a trademark, the United States Court of

81. See *Dallas Cowboys Cheerleaders v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979).

82. *Id.*

83. *Id.*

84. *Id.* For the premise that the case marks the origin of the alternative avenues of communication test, see *Parks v. LaFace Records*, 329 F.3d 437, 449 (6th Cir. 2003).

85. *Dallas Cowboys Cheerleaders*, 604 F.2d at 202-03.

86. *Id.*; see *BRING IT ON* (Universal Pictures 2000).

87. *Dallas Cowboys Cheerleaders*, 604 F.2d at 202.

Appeals for the Second Circuit agreed with the district court's finding that the similarity between the outfits at issue was sufficient to give rise to a likelihood of confusion.⁸⁸ Among other unsuccessful arguments proffered to counter this likelihood of confusion, the defendant contended that his First Amendment rights permitted use of a cheerleading uniform similar to the DCC.⁸⁹ The court rejected this under the rationale that the DCC trademark rights "need not 'yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.'"⁹⁰ In this respect, the court explained that "[b]ecause there are 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."⁹¹

A similar reaction born of the restrictive "alternative avenues of communication" test arose in *Mutual of Omaha Insurance Co. v. Novak*.⁹² In that case, Mutual of Omaha Insurance sued for infringement and disparagement of its trademarked name and Indian head logo, arising primarily out of the defendant's marketing of t-shirts bearing an emaciated Indian head and the phrase "Mutant of Omaha."⁹³ The district court concluded that the t-shirts infringed, but did not disparage, Mutual's marks, and granted injunctive relief.⁹⁴ On appeal, the United States Court of Appeals for the Eighth Circuit viewed the issue of confusion as close, but felt, based on the "clearly erroneous" standard of review governing the case, coupled with its consideration of the likelihood of confusion factors, that the t-shirts did infringe Mutual's marks.⁹⁵ The court further rejected the defendant's First Amendment defense under the alternative avenues of communication test.⁹⁶ In this respect, the court reasoned that the injunction's limited scope, prohibiting only defendant's use of Mutual's marks to "market, advertise, or identify [his] services and products," would permit the defendant to express his apparently antinuclear ideas through, for example, "an editorial parody in a book, magazine, or film."⁹⁷ Accordingly, the injunction did not violate the First

88. *Id.* at 204.

89. *Id.* at 206.

90. *Id.* at 206 (quoting *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972)).

91. *Id.*

92. 836 F.2d 397 (8th Cir. 1987).

93. *Id.* at 398.

94. *Id.*

95. *Id.* at 399 ("It is possible that we would reach a conclusion different from that of the District Court if the likelihood of confusion issue were before us de novo.").

96. *Id.* at 402.

97. *Id.*

Amendment as it deprived “neither Novak nor the public of the benefits of his ideas.”⁹⁸

A third application of the alternative avenues of communication test, *American Dairy Queen Corp. v. New Line Productions*, saw the Dairy Queen chain of ice cream and food shacks seek a preliminary injunction against New Line Cinema’s proposed distribution of a film entitled *Dairy Queens*.⁹⁹ The film, a mockumentary, satirically portrayed the petty, backbiting, and unhealthy culture of beauty pageants in the Upper Midwest, an area traditionally known as “dairy country.”¹⁰⁰ The Dairy Queen chain asserted that the film’s title diluted and infringed its well-known marks.¹⁰¹ In view of the similarity of the marks at issue and the fame of the Dairy Queen mark, the District Court for the District of Minnesota agreed that Dairy Queen was likely to achieve success on the merits of its infringement claim.¹⁰²

As to the defendant’s claim that the First Amendment shielded its title from trademark scrutiny, the court found to the contrary per the alternative avenues test.¹⁰³ The court first supported this conclusion by noting that while it was not the court’s responsibility to rename the film, the film’s writer had steadfastly rejected all alternative titles, including *Milk Maids* and *Dairy Princesses*.¹⁰⁴ The court further believed that the film could have been differently named on the basis of New Line’s claims that the film had no relation to the Dairy Queen chain.¹⁰⁵ As such, the case was critically distinguishable from *Rogers*, where the evocation of the original Fred and Ginger was of central importance to the expressiveness of the film’s title.¹⁰⁶ In the absence of commentary on the Dairy Queen chain by the film’s title, the court felt other equally effective

98. *Id.* The dissenting opinion in the case primarily faulted the majority for its reliance on methodologically unsound survey evidence. It also noted, however, that with regard to the First Amendment question, “[t]he first amendment will not permit the trademark owner the power to dictate the form, and thus the effectiveness, of another’s speech simply because his trademark has been used to express ideas that he would prefer to exclude from the public dialogue.” *Id.* at 406 (Heaney, J., dissenting) (citing Robert Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 206).

99. 35 F. Supp. 2d 727, 728 (D. Minn. 1998).

100. *Id.* at 728-29.

101. *Id.* at 728.

102. *Id.* at 730-32. The court also found Dairy Queen likely to succeed on its dilution claim. *Id.* at 733.

103. *Id.* at 734.

104. *Id.*

105. *Id.*

106. *Id.*

titles could have been selected.¹⁰⁷ Accordingly, in view of an injunction's limited restriction on only the nonnecessary title of the film, measured against its belief that the title both diluted and infringed Dairy Queen's trademarks, the court felt that the balance of equities favored the issuance of a preliminary injunction.¹⁰⁸

Based on results alone, the alternative avenues test would clearly appear to favor trademark holders to the detriment of subsequent users and, potentially, the public. But the *Dairy Queen* holding provides an implicit explanation as to why the alternative avenues of communication test does not have to lead inevitably to a finding of nonprotected use of a trademark. Specifically, the court noted other possible titles, *Milk Maids* and *Dairy Princesses*, that New Line might have substituted for *Dairy Queens* and achieved the same effect.¹⁰⁹ Yet these titles may only serve as true "alternatives" to the original title if the title is used to define a relatively abstract concept of the film: a (poorly named) movie about beauty pageants held in dairy country.

The other cases followed a similarly broad approach in defining the scope of the works' trademark uses. The *Dallas Cowboys Cheerleaders* case treated the pornographer's expression as a matter of only "sexuality in athletics."¹¹⁰ When defined that way, an infinite number of cheerleading outfits not like the Cowboys cheerleader uniform could have been employed in the film. Similarly, the Eighth Circuit's view that the "Mutant of Omaha" t-shirts merely disseminated antinuclear commentary, admitted to numerous alternative avenues of communication, such as editorial parody in books or magazines.¹¹¹ When the test is wielded in a manner that treats the concepts encapsulated by a title or uniform very broadly, alternatives to the chosen communication are certain to exist.

The courts, however, equally could have chosen to apply the alternative avenues test in a more narrow and artist-friendly manner. If the *Dallas Cowboys Cheerleaders* court had allowed the film's reliance on the DCC uniform to serve as an unsavory commentary on the Cheerleaders' extracurricular activities, then perhaps alternative avenues of communication may not have existed. That may not be the most plausible or convincing case for narrowed focus, but the Eighth Circuit

107. *Id.* at 734-35.

108. *Id.* at 735.

109. *Id.* at 734.

110. *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979).

111. *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987).

could have allowed the “Mutant of Omaha” t-shirt to depict more than a simple antinuclear commentary by recognizing more specific expressive elements arising out of the countercultural juxtaposition of a traditional insurance product with the image of a more disturbing dystopic future. From such a narrowed perspective, the Mutant of Omaha defendant may not have enjoyed alternative means of airing his views. In each of these hypothetical cases, the trademark use probably would have been permissible.

Therefore, a significant, perhaps dispositive, factor in the application of the alternative avenues of communication test is the breadth of concept by which a court detects alternatives. As the prior three cases demonstrate, courts tend to select broad concepts, which, in turn, lend themselves to easily detected alternatives. Accordingly, it is not the alternative avenues of communication test itself that is fatal to would-be trademark users, but the way in which courts apply the test.

This means of applying the test should serve as a high-level reminder of the idea/expression dichotomy. Just as a court applying the idea/expression dichotomy must outline an “idea” describing the underlying work, a court applying the alternative avenues of communication test must select an “idea” that a trademark-infused title conveys. From these shared perspectives, the court must then look to the number of alternatives that the idea permits. And where courts applying the idea/expression dichotomy appear willing to assign broad ideas to the overarching work, they seem equally prepared to sketch broad ideas, such as “sexuality in athletics,” when employing the alternative avenues of communication test.

But the similarities between the idea/expression dichotomy and the alternative avenues of communication test do not end there. The alternative avenues of communication test tracks precisely to the copyright concept of merger. Under both merger and the alternative avenues of communication test, a court will permit the subsequent use of another’s purported intellectual property if the subsequent user had no other alternative means of expressing an idea.¹¹² In the case of merger, no copyright protection is found where the work’s idea permits little or no other means of expression. Similarly, the alternative avenues of expression test will not find trademark protection to extend to uses where the idea encompassing the trademark use admits few alternative means of expression. In other words, a trademark use will only be permissible

112. See *Dallas Cowboys Cheerleaders*, 604 F.2d at 206-07.

in those cases where the trademark use's idea "merges" with its expression.

From this perspective, the fact that the alternative avenues of communications test is predicated on the mere existence of alternatives places a weighty thumb on the scale of nonprotected uses of trademarks. Only a very specific concept associated with the trademark use would permit a finding of a complete lack of alternatives to its use. Typically, as the *Dairy Queen* court noted in distinguishing the facts of the *Rogers* case (and as the narrower Dallas Cowboys Cheerleaders hypothetical above posits), the use will have to offer commentary specifically related to the trademark employed.¹¹³ But as noted above, courts seem unwilling to define ideas so narrowly.

Further complicating a showing of lack of alternatives is an apparent judicial alacrity to find alternatives, even poorly suited ones. For support on this point, one need look no further than the *Mutual of Omaha* court's declaration that editorial parody in a book or film might serve as an alternative to commentary delivered via the completely different medium of a t-shirt.¹¹⁴ The *Dairy Queen* court similarly expressed support for seemingly insufficient alternatives—when a movie depicts beauty queens in dairy country, "Dairy Queens" seems a very good fit for a title.¹¹⁵ "Milk Maids" or "Dairy Princesses," by contrast, represent far inferior alternative titles, as pageant contestants are not vying for the title of "maid" or "princess"; nor are their behaviors consistent with the real tasks of a "milk maid" or the imaginary tasks of the nonexistent "dairy princess."¹¹⁶ Accordingly, as with courts' apparent tendency to paint the trademark user's message in broad terms, courts' contentment with insufficiently equivalent "alternatives" to the original expressive message renders the alternative avenues test, as applied, an exceedingly high hurdle for the trademark user to overcome.

B. *Rogers Test History*

The *Rogers* test finds the use of third-party trademarks permissible when the use is "relevant" to the rest of the work, provided further that the use is not otherwise explicitly misleading.¹¹⁷ While this relevance inquiry would seem superficially less demanding than the alternative avenues of communication test, the *Rogers* test's relevance prong does

113. *American Dairy Queen*, 35 F. Supp. 2d at 734.

114. *Mutual of Omaha*, 836 F.2d at 734.

115. *American Dairy Queen*, 35 F. Supp. 2d at 734.

116. *Id.*

117. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

extend the similarities evident between alternative avenues of communication and the idea/expression dichotomy. Before further investigation into those similarities can be undertaken, however, a more extensive understanding of that prong is in order.

Perhaps the best way to establish such an understanding is to demonstrate how the test works in practice by reviewing notable decisions applying the test. While courts have put the *Rogers* test through its paces in numerous cases, most decisions spend the majority of their attention on the test's second prong, related to whether the trademark use is misleading.¹¹⁸ Relevance, by extension, is relegated to passing, occasionally conclusory acknowledgement. In most cases this makes sense, because a trademark used in the title of a work ought to have some nexus with the underlying work. A title employing a trademark ought not be completely *irrelevant* to the work it frames. Accordingly, litigants will have little incentive to spend litigation resources on low—probability arguments. Courts, in turn, will find themselves with little conflict to address. That said, a handful of cases have confronted the prong seriously, and they merit consideration here.

An obvious launching point for an overview of the *Rogers* test's relevance prong is a more careful look at the *Rogers* case itself. As noted above, the court declined to find trademark fault with Fellini's use of the phrase "Ginger and Fred" in his eponymous film.¹¹⁹ The Second Circuit initially noted a title's dual nature as serving both as a form of marketing promotion and as a means of communicating an expressive message that might include irony, allusion, or wordplay.¹²⁰ According to the Second Circuit, consumer interest in titles tracks this dual nature. To the extent that a title serves as marketing promotion, consumers have an interest in not being misled.¹²¹ However, to the extent that a title serves an expressive purpose, consumers equally have an interest in being exposed to such expression.¹²² After faulting the alternative avenues test for protecting only the consumer interest in not being misled, the court offered its two-prong test.¹²³

The court supported the structure of its test on the basis of the perceived distinction between implicitly and explicitly misleading titles.¹²⁴ Implicitly misleading titles, the court concluded, involve a title's

118. *Id.* at 1001.

119. *Id.* at 999.

120. *Id.* at 998.

121. *Id.*

122. *Id.*

123. *Id.*

124. *Id.* at 999-1000.

use of a trademark in a way that might superficially suggest an association between the trademark and the work.¹²⁵ As examples of this, the court offered the song “Bette Davis Eyes” and the film *Come Back to the Five and Dime, Jimmy Dean, Jimmy Dean*.¹²⁶ While those titles might suggest an association between the work and the trademark used, the court felt that the public’s interest in the title’s expressive message would insulate the title from Lanham Act claims provided that the title was relevant to the underlying work.¹²⁷ Meanwhile, the application of an implicitly misleading title such as *Ginger and Fred* to a film with no relevance to the dancing pair would remain susceptible to Lanham Act claims.¹²⁸

The court further fleshed out its taxonomy by defining explicitly misleading titles through cases where a work’s title conveyed misinformation as to the source of the work.¹²⁹ On this count, the court offered potential hypothetical cases such as *Nimmer on Copyright* or *Jane Fonda’s Workout Book*, or cases where a book invalidly claimed to be an “authorized biography.”¹³⁰ In each of these cases, the court felt that the negligible public interest in misleading expression was outweighed by the public interest in avoiding confusion as to the work’s source.¹³¹ Explicitly misleading titles, therefore, merit regulation under the Lanham Act, whether or not they were relevant to the underlying work.¹³²

A concurring opinion criticized the majority for espousing a “vague and fluid test” that rendered the ruling “overly expansive.”¹³³ The concurrence particularly faulted the majority’s distinction between implicitly and explicitly irrelevant titles.¹³⁴ The implicitly misleading scenarios involving the use of James Dean or Bette Davis, the concurrence argued, were not misleading at all.¹³⁵ In addition, the explicitly misleading titles involving Jane Fonda and Nimmer lacked sufficient background on the substance of the work to permit assessment of their accuracy.¹³⁶ Further, such cases lent themselves to simple

125. *Id.*

126. *Id.* at 999.

127. *Id.*

128. *Id.* at 1000.

129. *Id.* at 999.

130. *Id.*

131. *Id.*

132. *See id.* at 999-1000.

133. *Id.* at 1006 (Griesa, J., concurring).

134. *Id.*

135. *Id.* at 1007.

136. *Id.*

Lanham Act claims without further need for a new test.¹³⁷ The concurrence believed that instead of establishing a test well-suited to reach appropriate results in all cases, the majority's test was vulnerable to cases not considered by the majority and otherwise premised on an "unworkable" distinction between explicitly and implicitly misleading titles.¹³⁸

Whatever the merits of the concurring opinion, it does correctly point out that the outcome of the *Rogers* test turns on a title's relevance to the underlying work only where the work falls into the "implicitly misleading" category.¹³⁹ In other words, if we envision the *Rogers* test as a four-part box, with "relevant" and "irrelevant" on one side and "explicitly misleading" and "implicitly misleading" on the other, only the intersection of implicitly misleading and relevant will escape Lanham Act scrutiny. While this may constitute a mere 25% of the overall rubric, the majority opinion in *Rogers* suggests that these cases may make up the vast majority of trademark uses in titles.¹⁴⁰ More specifically, the majority's decision to limit "explicitly misleading" hypothetical titles to the Jane Fonda and Nimmer examples—those whose titles contain an objectively inaccurate source of the underlying work—suggests an intent by the court to limit the scope of that prong.¹⁴¹ Critical to the many remaining cases, then, is what "relevance" means, as that determination would seem commonly dispositive.

The Second Circuit, however, did not provide a definition or scope of the term "relevance." In view of this lack of an articulated definition by the *Rogers* court, reliance on another court's understanding of the term may prove helpful. Due to the potential breadth of relevance, however, perhaps even more helpful are cases where the court finds a trademark use irrelevant.

Parks v. LaFace Records furnishes one notable example where the court seemed unconvinced that the use of a trademark was relevant to the underlying work.¹⁴² The case involved the song, "Rosa Parks," authored

137. *Id.*

138. *Id.*

139. *Id.* at 1000 (majority opinion).

140. *See id.*

141. *Id.* at 999.

142. *Parks v. LaFace Records*, 329 F.3d 437, 459 (6th Cir. 2003). This would not be OutKast's only run-in with an unhappy trademark owner. The band's song "Hey Ya!," which repeatedly urges its listeners to "shake it like a Polaroid picture," caused the Polaroid Corporation to issue statements that its brand of instant film was not to be shaken during development. *Don't Shake It Like a Polaroid Picture*, FOXNEWS.COM, Feb. 18, 2004, <http://www.foxnews.com/story/0,2933,111696,00.html>.

by the Atlanta-based hip-hop duo OutKast.¹⁴³ The title of the song, of course, evokes the trademark-protected name of the African-American civil rights activist Rosa Parks, most famous for her determined refusal to cede her front seat on a Montgomery, Alabama public bus to white riders.¹⁴⁴ The OutKast song, far from directly celebrating Parks' achievement, solely referenced the substance of her act through the refrain lyrics, "Ah ha, hush that fuss/ Everybody move to the back of the bus/ Do you wanna bump and slump with us/ We the type of people make the club get crunk."¹⁴⁵ Perhaps in part because of this limited connection to her work, Parks sued the group and its record company for false advertising under the Lanham Act, along with a claim of violation of her right to publicity.¹⁴⁶

On appeal of the district court's dismissal of Parks' Lanham Act claims, the Sixth Circuit expressed reservations about the relevance of the song's use of Parks' name to the underlying work.¹⁴⁷ After acknowledging a celebrity's trademark right in her name, the court confronted a choice as to what test to adopt when analyzing First Amendment defenses under the Lanham Act.¹⁴⁸ Finding that neither the alternative avenues of communication test nor a simple application of the likelihood of confusion standard afforded sufficient weight to First Amendment interests, the court settled on the *Rogers* test to guide its analysis.¹⁴⁹ Under that test, the case's primary debate revolved around the relevance of the use of the name "Rosa Parks" in the underlying song.¹⁵⁰ While defendants admitted that the song did not relate to Parks in a biographical sense, they contended that the lyrics alluded to her life symbolically through lyrics exhorting "everybody" to "move to the back of the bus"; and further, that the fact the song was not strictly "about" Parks should not matter.¹⁵¹

The Sixth Circuit disagreed, finding the relevance question a matter of disputed material fact inappropriate for a grant of summary

143. *LaFace Records*, 329 F.3d at 442. The band's members are known individually as Andre 3000 and Big Boi. *Id.*

144. *Id.*

145. *Id.* at 442-43 "Crunk," which may be a foreshortening of "crazy drunk," refers to a fusion musical genre of electronica and hip-hop typically associated with the South. It also refers to a crowd's excited reaction to music of that genre. See WILLIAM JELANI COBB, *TO THE BREAK OF DAWN: A FREESTYLE ON THE HIP-HOP AESTHETIC* 74 (2007).

146. *LaFace Records*, 329 F.3d at 441.

147. *Id.* at 452.

148. *Id.* at 447-48.

149. See generally *id.* at 448-51.

150. See *id.* at 452.

151. *Id.* at 452.

judgment.¹⁵² While the court noted that the movement to the back of a bus was an oft repeated concept in the song, when the phrase was “considered in the context of the lyrics, [it had] absolutely nothing to do with Rosa Parks.”¹⁵³ The lyrics, by OutKast member Andre 3000’s own admission, were a strongly worded suggestion to other emcees to take a back seat owing to their inferior ability to “make the club get crunk.”¹⁵⁴ The Sixth Circuit felt that this evocation of Parks’ act was not just irrelevant to Rosa Parks, but completely inconsistent with her image as it “contain[ed] absolutely nothing that could conceivably, by any stretch of the imagination, be considered, explicitly or implicitly, a reference to courage, to sacrifice, to the civil rights movement or to any other quality with which Rosa Parks is identified.”¹⁵⁵ As the lyrics of the song were accordingly “diametrically opposed” to the qualities embodied by Parks, the court found the relevance of the use of Parks’ name “highly questionable,” and thus inappropriate for summary judgment in OutKast’s favor.¹⁵⁶

The court in *Seale v. Gramercy Pictures* similarly dealt with a portion of the *Rogers* test’s relevance inquiry.¹⁵⁷ In that case, the defendant film companies produced and distributed a film entitled *Panther*, which centered around the birth of the Black Panther movement in 1960s Oakland.¹⁵⁸ Although the subject matter was historical in nature, the film surfaced that subject matter with a fictional gloss, including the insertion of a narrator-*cum*-character and the use of actors to portray prominent Panther leaders.¹⁵⁹ One such Panther leader was the plaintiff, a cofounder of the organization.¹⁶⁰ His suit alleged that the film misappropriated his likeness, portrayed him in a false light, and constituted unfair competition and false advertising in violation of his trademark rights.¹⁶¹ The latter of these claims arose out of the photographic packaging used for the film’s videotape, soundtrack, and associated pictorial history book.¹⁶² In the case of the videotape, the packaging depicted the actors who portrayed the historical Panther figures, while the soundtrack packaging also included an image

152. *Id.*

153. *Id.* (emphasis omitted).

154. *Id.* at 452-53.

155. *Id.* at 453.

156. *Id.* at 456, 459.

157. 949 F. Supp. 331 (E.D. Pa. 1996).

158. *Id.* at 332-33.

159. *Id.* at 334.

160. *Id.* at 333.

161. *Id.*

162. *Id.* at 339-40.

capturing a scene from the film in which the plaintiff's portrayal is engaging in a historically notable protest.¹⁶³ On defendants' motion for summary judgment as to the trademark claims, the court initially addressed the trademark claim by noting the applicability of the *Rogers* test to the use of the plaintiff's portrayed likeness.¹⁶⁴ As to the pictorial history book and video cassette, the court had little difficulty concluding that the images would not explicitly mislead consumers into thinking that the plaintiff endorsed, or was otherwise associated with, the film and pictorial history book.¹⁶⁵ It found with equal ease that the images adorning the video cassette and history book were related to the underlying content—the history of the Black Panther movement.¹⁶⁶ Accordingly, plaintiff's claims over the use of his likeness were found to be protected under the First Amendment.¹⁶⁷

The image used on the soundtrack, however, presented genuine issues of material fact improper to a finding of summary judgment.¹⁶⁸ In this respect, the court opined that the plaintiff's likeness on the soundtrack “d[id] not relate to the content in the CD/cassette in the same manner as the use of the Plaintiff's name and likeness on the cover of the home video and pictorial history book relate[d] to the content of the film and pictorial history book.”¹⁶⁹ The court stated:

[T]he musical CD/cassette is merely a collection of different songs performed by different musicians, which songs have no direct connection to the Plaintiff or the history of the Black Panther Party. There is a genuine issue of material fact, therefore, whether the use of the Plaintiff's name and likeness on the cover of the musical CD/cassette is clearly related to the content of the film “Panther” and serves as an advertisement for the film, [which use would be protected by the First Amendment in this case,] or whether the Defendants' use of the Plaintiff's name and likeness on the cover of the CD/cassette is a disguised advertisement for the sale of the CD/cassette.¹⁷⁰

Though neither fully declared the trademark uses at issue irrelevant, both *Laface Records* and *Seale* seem to take a parsimonious view of relevance. One could argue, for example, that the name of a historical figure is relevant to a song that references the activity for which the

163. *Id.* at 335.

164. *Id.* at 339-40.

165. *Id.*

166. *Id.* at 340.

167. *Id.*

168. *Id.*

169. *Id.* at 337.

170. *Id.* at 337-38.

historical figure is best known, even if the reference changes the tenor of the activity. One could likewise argue that images from a movie might be sufficiently relevant to a movie soundtrack, even if the songs appearing on the soundtrack are not particularly related to the movie's content.

Whether these decisions were appropriate, however, should await further clarification in light of the idea/expression dichotomy. In the meantime, the *Rock Star Videos* case offers both an expanded view of the *Rogers* test's applicability and an interpretation of the relevance prong potentially inconsistent with both *Seale* and *LaFace Records*. In *E.S.S. Entertainment 2000 v. Rock Star Videos*, the proprietor of a Los Angeles strip club called the "Play Pen" sued to enforce trademark rights in its logo, typically consisting of the phrases "Play Pen" and "Totally Nude" with a female silhouette in the stem of the first "P."¹⁷¹ The suit targeted Rockstar Games, the developers of the popular *Grand Theft Auto* series of video games.¹⁷² Generally, the games enable players to manipulate an onscreen character's pursuit of criminal or, at least, seedy activity, against the backdrop of parody urbanscapes modeled after real American cities.¹⁷³ At issue in the case was the "San Andreas" incarnation of the game, set primarily in a parody of Los Angeles.¹⁷⁴ Consistent with the game's cartoonish take on Los Angeles, *Grand Theft Auto: San Andreas* featured exaggerated representations of various Los Angeles neighborhoods, including cognates for Hollywood, Venice Beach, and Compton.¹⁷⁵ Also featured in the game was a strip club called the "Pig Pen," which, despite general architectural dissimilarity from the look of plaintiff's club, constituted sufficient similarity to plaintiff's mark to precipitate the lawsuit.¹⁷⁶

The case reached the Ninth Circuit following the district court's grant of defendant's motion for summary judgment on the basis of a First Amendment defense.¹⁷⁷ The Ninth Circuit acknowledged its prior

171. *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1097 (9th Cir. 2008).

172. *Id.* at 1096.

173. *See generally id.* at 1096-97. Players may pursue missions to advance in the game. At the risk of alerting the game's police force, they may also perpetrate crimes, including, as the title suggests, the theft of automobiles.

174. *Id.* at 1097. It also included parodies of San Francisco and Las Vegas.

175. *Id.*

176. *Id.* at 1097-98.

177. *Id.* at 1098. The case also involved an appeal of the district court's denial of defendant's nominative fair use defense, but the Ninth Circuit upheld this finding as proper in view of the fact that nominative fair use extends only to uses of a trademark itself, and not a caricature of a trademark. *Id.* at 1099.

adoption of the *Rogers* test to analyze such defenses in the context of titles, and found “no principled reason why [the test] ought not also apply to the use of a trademark in the body of the work.”¹⁷⁸ As to the merits of the test, the plaintiff argued that Rockstar Games failed to satisfy the relevance prong because the videogame was not “about” the Play Pen and because the Play Pen was not a cultural icon like “Barbie,” whose use was found acceptable in a song title in a previous Ninth Circuit case.¹⁷⁹ The court rejected the first argument as setting a bar inconsistently high with the minimal requirement that a trademark use have some relevance to the underlying work.¹⁸⁰ In the court’s estimation, the relevance prong of the *Rogers* test required that “the level of relevance merely must be above zero.”¹⁸¹ The court further appeared to opine that the point of the relevance prong was not only to protect the use of iconic trademarks, but to ensure that any trademark use fit within the “artistic goal” of the overall work.¹⁸² In view of the low relevance bar, the defendant’s goal “to recreate a critical mass of the businesses and buildings” in East Los Angeles accommodated the creation of a strip club similar in designation to the Play Pen.¹⁸³ Finding further that the Pig Pen strip club was not explicitly misleading as to the source or affiliation of the defendant’s videogame,¹⁸⁴ the court concluded that the district court had properly granted summary judgment on defendant’s First Amendment defense.¹⁸⁵

The *Rogers* test’s expanded application guided the Eastern District of California’s denial of a temporary restraining order in *ProtectMarriage.com v. Courage Campaign*.¹⁸⁶ In that case, an aftershock of the Proposition 8 controversy, an organization opposed to homosexual marriage sued to enforce rights in its trademarked logo, comprised of the stylized silhouettes of a heterosexual couple flanking smaller silhouettes of two children and holding a banner depicting the phrase, “Yes on 8 Protect

178. *Id.*

179. *Id.* at 1100.

180. *Id.*

181. *Id.*

182. *Id.*

183. *Id.*

184. While slightly off-topic for the point of this article, the court’s dismissal of Play Pen’s claims in this respect are notable. After opining that no consumer would likely believe that a relatively unknown strip club was behind a “sophisticated” video game like *Grand Theft Auto*, the court addressed plaintiff’s contention that players could direct their onscreen characters to spend all of their time in the virtual confines of the Pig Pen as follows: “[F]ans can spend all nine innings of a baseball game at the hot dog stand; that hardly makes Dodger Stadium a butcher’s shop. In other words, the chance to attend a virtual strip club is unambiguously *not* the main selling point of the [g]ame.” *Id.* at 1101.

185. *Id.*

186. *ProtectMarriage.com v. Courage Campaign*, 680 F. Supp. 2d 1225 (E.D. Cal. 2010).

Marriage.”¹⁸⁷ The defendant, a nonprofit organization in favor of homosexual marriage, created a parody of the plaintiff’s logo in which a female silhouette replaced the male parental silhouette and the banner was altered to read “Prop 8 trial tracker.”¹⁸⁸ In other words, consistent with its political views, the defendant modified the plaintiff’s logo to depict a homosexual couple.¹⁸⁹ As the plaintiff sought a temporary restraining order prohibiting use of the altered mark, the court was required to assess the likelihood of plaintiff’s success on the merits.¹⁹⁰ That success was predicated on the likelihood of confusion as to the source, sponsorship, or approval of the parody mark.¹⁹¹ Because the mark constituted an artistic parody of the original, the court noted that such confusion would not lie if the work satisfied the *Rogers* test.¹⁹² In this respect, the district court commented that “the Ninth Circuit has taken ‘no relevance’ literally” when assessing the first prong, to the point that a work need not be “about” the trademark used.¹⁹³ As such, the district court had little difficulty in finding the parody logo relevant to the “support for homosexual marriages, and . . . opposition to recent California efforts to limit the right to such marriages.” Because the logo was not otherwise explicitly misleading, it was protected under the *Rogers* test.¹⁹⁴

IV. HOW THE *ROGERS* TEST TRACKS IDEA/EXPRESSION DICHOTOMY

The *ProtectMarriage.com* decision highlights the newly developed breadth of applicability of the *Rogers* test. If the test currently captures the use of a parody logo on a web page, it should equally apply to all of the examples cited at the outset of this Article. With this impact in mind, this Part will review, in greater detail, how the cases applying the *Rogers* test can be understood by resorting to the principles underlying the idea/expression dichotomy.

One case, *Volkswagen AG v. Dorling Kindersley Publishing, Inc.*, serves as the initial bridge between these seemingly disparate legal domains.¹⁹⁵ In that case, while the court did not hint at the possibility of a finding of irrelevance, it did wield the relevance prong in a notable

187. *Id.* at 1227.

188. *Id.*

189. *Id.*

190. *Id.*

191. *Id.* at 1228.

192. *Id.* at 1229.

193. *Id.*

194. *Id.*

195. 614 F. Supp. 2d 793 (E.D. Mich. 2009).

manner.¹⁹⁶ The case primarily involved claims for trademark infringement by Volkswagen against the defendant, a children's book publisher, for the use of its VW emblem, its Beetle trademark, and the trade dress incorporated in the updated Beetle.¹⁹⁷ The infringement, VW asserted, arose out of the defendant's creation and distribution of *Fun Cars*, a book that doubled as a sort of toy car, complete with wheels, pages cut in the profile of a Beetle, and miniature VW marks.¹⁹⁸ While the court could not address the parties' cross motions for summary judgment on the defendant's First Amendment defense due to lack of evidentiary record on the explicitly misleading prong of the *Rogers* test, the court noted, with respect to the relevance prong, "One can reasonably conclude upon inspection of *Fun Cars* that [defendant]'s use of the N[ew] B[eetle] design in *Fun Cars* is relevant to the book's underlying 'fun' theme."¹⁹⁹

On its face, the court's comment is noncontroversial. Indeed, a book in the shape of a car is relevant to a "fun" theme, because it certainly increases the likelihood of "fun" that the book's audience might experience while reading the book or while drift-racing on a fierce Capri Sun bender and subsequently crashing the book. But to the degree that a "fun" theme is all that is needed to make it relevant to the underlying work, a nearly infinite number of other trademarks might also have been applied to *Fun Cars*, including marks related to shopping, spelunking, or competitive arm wrestling. Clearly, however, the use of such trademarks would not have been relevant to *Fun Cars*. In other words, the court's assessment of the relevance factor by resorting to a "fun theme" as a measuring stick has the practical effect of rendering the relevance factor irrelevant. While the court might not be at fault for this, because the parties appear not to have argued the relevance point with any vigor, the court should have been more precise in framing the relevance question. The book did more than just present a general "fun theme;" it was at least a fun-themed children's book about automobiles. Taken from this more specific point of reference, the use of Volkswagen's (or Audi's or GM's) trademarks is still relevant, and the court's outcome is still correct; but the use of the name of a favorite boutique, lighted cave helmet, or competitive arm wrestling wrist strap would have properly failed the *Rogers* test. Accordingly, although determinations of relevance may be

196. *Id.*

197. *Id.* at 798.

198. *Id.* at 798-99.

199. *Id.* at 810. The defendant publisher also raised defenses of nominative fair use and nontrademark use of the trademarks.

informed in part by an understanding of the word “relevance” itself, they are perhaps more substantially informed by what the trademark use is relevant to—the baseline by which relevance is measured.

Here appears the nub of similarity between the idea/expression dichotomy and the *Rogers* test—a similarity grounded in the baseline idea that courts must select for both doctrines. In other words, where courts pursuing copyright inquiries must determine an idea by which expression may be measured, courts pursuing the first prong of the *Rogers* test must determine an idea by which relevance may be measured. But the *Volkswagen* case offers more than this general parallel—it also stands as a cautionary tale that reflects equally on the idea/expression dichotomy. Because of its choice of an unduly broad idea, the “fun” theme of the children’s book, the court reduced the relevance test to a nullity that would find relevant many items and topics completely irrelevant to the book. As noted above, precisely the same outcome occurs when courts wield unduly broad ideas in copyright cases—the measurement of the alternatives necessary to find copyrightable expression becomes a near given, and the bar for copyrightability may be unduly lowered.²⁰⁰ Accordingly, in each of these areas, a court’s ability to construct an appropriately measured “idea” is of critical importance to the proper operation of the test.

The group of cases described in Part III shed further light on the similarities between the idea/expression dichotomy and the relevance prong of the *Rogers* test, but such similarities may only flow from a better understanding of the set of cases as a whole. As an initial matter, it is worthwhile to ask whether *Rogers*, *LaFace Records*, *Seale*, and *Rock Star Videos* offer a consistent perspective on the *Rogers* test’s relevance prong. On the face of these cases, one could make this argument. *Rogers*, for one, noted the expressive value that the use of the names “Fred” and “Ginger” in the title added to the film because the trademark use drew a parallel between the authentic reputation of the Hollywood icons and the protagonists in the story.²⁰¹ Compare this with the result in *LaFace Records*, where OutKast described a hip-hop world in which their self-described superiority over other music purveyors was completely inconsistent with Rosa Parks’ traditional image of quiet courage in the face of hardship.²⁰² This inconsistency with Parks’ image could

200. See, e.g., *Whelan Assocs. Inc. v. Jaslow Dental Lab. Inc.*, 797 F.2d 1222 (3d Cir. 1986).

201. *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989).

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

arguably lead to a finding of irrelevance where consistency with Fred and Ginger's image led to a finding of relevance in *Rogers*.

Similar reasoning would justify the different outcomes as between *Rock Star Videos* and *LaFace Records*. In *Rock Star Videos*, the court explicitly commented on the “artistic goal” of the video game developers—to create a semi-realistic, but exaggerated rendering of Los Angeles.²⁰³ The original Play Pen gentlemen's club, depicted as the Pig Pen in the game, fit an image perfectly consistent with this overarching artistic goal. Conversely, the “artistic goal” of OutKast did not justify a portrayal of Rosa Parks in a light so opposed to her actual historical achievements.²⁰⁴

Seale fits in nicely with these rationalizations inasmuch as it represents a more tempered form of the *LaFace Records* case. More specifically, where *LaFace Records* dealt with the presentation of a historical figure in a manner inconsistent with that figure's image, *Seale* merely dealt with the presentation of a historical figure in a manner arguably unrelated to that figure—through a CD of songs with no direct nexus with the figure's life. *Rogers* and *Rock Star Videos* each feature that direct nexus—the former through the evocation of a famous dance pair through a parallel with a lesser known dance pair, and the latter through the muddied portrayal of the real club whose trademark it mocked. Accordingly, the opposite outcomes reached as between *Rock Star Videos* and *Rogers*, on one hand, and *Seale* on the other, might flow from the presence in *Rock Star Videos* and *Rogers* of a closer relation between the context of the trademark use and the use itself.

All of these arguments, however, are a mere sleight of hand capitalizing on fortuitously distinguishable factual scenarios. At heart, the methodology informing the *Seale* and *LaFace Records* decisions is inconsistent with the one informing *Rogers* and *Rock Star Videos*. Here is where further comparison with the idea/expression dichotomy provides shape to such inconsistencies. Let us start by noting that *Rock Star Videos* expressly disclaimed any requirement that a work be “about” the third-party trademark used—in that case, that the video game be “about” the Pig Pen.²⁰⁵ This disclaimer is effectively tantamount to a statement that a trademark use need not map closely to the high level abstraction of a work. For what does it mean for a work to be “about” something, if not that the high level idea of the work relates to that something? Consistent

203. E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1100 (9th Cir. 2008).

204. *LaFace Records*, 329 F.3d at 452-53.

205. *Rock Star Videos*, 547 F.3d at 1100.

with this, the depiction of the Pig Pen is constrained, if only scarcely, by the high-level abstraction of a video game set in sensational version of Los Angeles. But a more specific idea, one encompassing various neighborhoods and a more detailed understanding of the parodic intentions of the video game developers, would apply greater constraint on the appearance of the Pig Pen as that idea became more specific. The *Rock Star Videos* court accordingly demonstrated an implicit willingness to telescope the idea, or artistic goal, of the *Grand Theft Auto* games into different levels as a means of understanding how the Pig Pen was a constrained, but possible, manifestation of those idea levels.

It would appear, then, that the Ninth Circuit's decision in *Rock Star Videos* stands for the possible proposition that relevance merely means "constrained by the idea" of the work on some level. Or put differently, only a trademark use that is wholly superfluous to the idea of the use will be deemed irrelevant. In this way, *Rock Star Videos* binds permissible use of a third party's trademark at the point where constraint by the idea shifts to nonconstraint by the idea.

Rogers would seem potentially consistent with this view. The court's holding of relevance with respect to Fellini's use of the title *Ginger and Fred* was based on the applicability of that pair to the world captured in the film.²⁰⁶ While *Ginger and Fred* was not directly about Ginger Rogers and Fred Astaire, the use of that trademark marked a constrained result of the idea of a film recounting the story of Ginger and Fred dance-alikes. Fellini, in this way, was able to shape a world sufficiently reflective of the real Fred and Ginger to enable the title to serve as a legitimate constraint on that world.

Neither *Seale* nor *LaFace Records*, however, stands for a finding of relevance coextensive with the superfluous/constrained idea/expression boundary. *Seale*'s use of a historical figure's image on the packaging of a movie soundtrack might seem superfluous to the idea of a "movie soundtrack," but that use is far from superfluous when the movie soundtrack relates to a movie involving that historical figure. In this respect, the use of the historical figure's image is merely a constrained outcropping of a slightly more specific idea. Granted, a certain degree of additional misdirection is involved, as the movie must serve as an organizational bridge between its soundtrack and its constituent characters, but the constraint is still present at a reasonable idea level descriptive of the trademark use. As for *LaFace Records*, the idea of writing a song about musical superiority would not seem to permit use of

206. *Rogers*, 875 F.2d at 1001.

Rosa Parks' name, but when the number of references to the act of "moving to the back of the bus" is additionally considered, it is hard to argue that the name of Rosa Parks in the title is not constrained on some idea level by this reference. Put differently, where Fellini's use of the names "Fred" and "Ginger" was found relevant following his creation of a world obliquely reflecting the famous dance pairing, OutKast's use of Rosa Parks, through a song obliquely evoking that famous historical figure, was deemed irrelevant. This is because the *LaFace Records* court gave insufficient weight to an artist's ability to create a work answering to a certain overarching idea. Perhaps OutKast's reflection of the famous image was not as clearly articulated, but the outcomes of the two cases seem inconsistent nonetheless. Finally, as to both *Seale* and *LaFace Records*, the fact that a trademark use might either be inconsistent with the image of the trademark or only related at a step of removal would implicitly belie even the possibility that such use could be found "irrelevant" to the overall work. In the case of *LaFace Records* particularly, that inconsistency itself amounts to the existence of a relation, and accordingly, relevance, even if somewhat counterintuitive.

This review of the methodologies of these four cases seems to reveal two differing tendencies. On one hand, *Seale* and *Laface Records* represent somewhat *ad hoc* decisions in which the use of a third party's trademark is apparently not acceptable even if it constitutes a constrained result of the work's overarching idea. Viewed from this idea/expression angle, it is difficult to extrapolate the holdings to a more broadly applicable rule outside of these specific factual scenarios.²⁰⁷ On the other hand, *Rogers* and *Rock Star Videos* offer a more permissive perspective on use of third-party trademarks, prohibiting only those uses that fall outside the scope of one of any number of reasonable idea levels informing a work.

Now let us reexamine the alternative avenues communication test in light of this background. Earlier, this Article proposed that that test tracked the merger doctrine precisely. Where a use of a third party's trademark could be found to merge with the idea of that use, the use would not be protectable by the trademark's owner. Accordingly, the alternative avenues of communication test sets the boundary between permissible and impermissible uses of third-party trademarks at the point where a trademark use is dictated by the idea of the trademark use. The cases above merely fall as other points along the idea/expression

207. *LaFace Records* is open to criticism, from a judicial realism standpoint, in that the court simply respected Rosa Parks' accomplishments more than OutKast's music. Accordingly, if OutKast would not do justice to Parks' historical achievements, then the Sixth Circuit would.

spectrum as measured by the degree of constraint imposed by the idea. *Seale* and *LaFace Records*, for all the unpredictability built into their limited and possibly arbitrary rationales, seem to place relevance at a point where an idea underpinning a trademark use may still constrain the use, but not significantly enough. At a further distance, *Rock Star Videos* places relevance at the dividing line between trademark uses constrained by the idea of the overall work and trademark uses superfluous to the idea of the overall work.

While a full spectrum of results may be represented, the relevance prong seems most faithfully and clearly applied by the *Rock Star Videos* court. There, the court, unburdened by arbitrary boundaries not carefully tailored to the concept of relevance, began to construct a workable methodology based on a familiar copyright interface, one that wields a work's idea flexibly before determining if the trademark use is superfluous to that idea.²⁰⁸ Based on this relatively clear, easily extrapolated boundary, courts in the Ninth Circuit should have a much easier time applying the *Rogers* test—as evidenced in part by the *ProtectMarriage.com* case—than courts in the Sixth Circuit who must guess at what level of constraint by the work's "idea" is enough to render a trademark use relevant.

V. CONCLUSION

Because of the Ninth Circuit's recent expansion of the *Rogers* test to a set of trademark uses potentially greater than the set of titles previously reached by the test, this Article has invested some effort exposing the history and development of both the relevance prong of the *Rogers* test and the parallel alternative avenues of communication test. This background, coupled with a review of the copyright concept known as the idea/expression dichotomy, reveals striking analytical similarities present in both the trademark tests and the copyright theory; each considers public expression by reviewing the alternative means of expressing an idea. Based on these similarities, this Article contends that both the alternative avenues of communication test and the relevance prong of the *Rogers* test map to critical points on the idea/expression spectrum. More specifically, the alternative avenues of communication test sits on a boundary coextensive with the merger doctrine, at the interface between works dictated by their idea and works merely constrained by their idea. The relevance prong of the *Rogers* test, by contrast, is more permissive in its scope, and draws the distinction

208. *Rock Star Videos*, 547 F.3d at 1100.

between protectable and unprotectable trademark uses at the interface between uses constrained by their idea and uses superfluous to their idea. This Article contends that “relevant,” in the meaning of the *Rogers* test, may be understood by resorting to a reasonable application of the idea/expression dichotomy and a further application of the distinction between constrained and superfluous elements. Cast in this light, the arbitrary methodology informing ill-conceived case law like *LaFace Records* sloughs off, and the Ninth Circuit’s expanding body of law seems all the more credible. Per this clearer rule, each of the expressive trademark uses offered at the outset of this Article, from Queneau’s Caco-Calo to Kanye’s cars, would easily pass muster, and public expression would remain appropriately robust.