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Get up, stand up, stand up for your (trademark) rights

By Eric Boorstin

In *Fifty-Six Hope Road Music Ltd. v. A.V.E.L.A. Inc. (Hope Road)*, 778 F.3d 1059 (9th Cir. 2015), the 9th U.S. Circuit Court of Appeals was confronted with Lanham Act false endorsement claims brought by the late Bob Marley's children against a company who used Marley's images on T-shirts and other merchandise.

Bob Marley's children own a company that commercializes rights to their late father's image. Defendants produced competing Bob Marley T-shirts and other merchandise using pictures of Bob Marley acquired or licensed from other sources. The Marleys' company and its licensee claimed that defendants violated the Lanham Act by using Bob Marley's image in a manner likely to cause confusion as to plaintiffs' sponsorship or approval of defendants' merchandise. See 15 U.S.C. Section 1125(a) (2012). A jury agreed with plaintiffs, and the 9th Circuit recently affirmed the resulting judgment. The court held that the Lanham Act can protect a property right to a celebrity's persona, and that the judgment did not overextend the Lanham Act by creating a federal right of publicity.

But *Hope Road* is most notable for three potentially meritorious defenses that the 9th Circuit declined to address: (1) whether defendants' use of Bob Marley's images for their aesthetic (rather than source-identifying) function precluded plaintiffs' claims; (2) whether plaintiffs' claims impermissibly interfered with the Copyright Act under *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); and (3) whether defendants' T-shirts and other merchandise were protected expression under the First Amendment.

The 9th Circuit held these defenses were waived because defendants did not properly present them to the district court or sufficiently develop the record. *Hope Road* is unusual because the court strongly suggested that *if* these defenses had been raised, there would have been a good chance of reversal. ("It is difficult to over-state the extent to which this result is the product of the unique way this case was litigated," Judge Morgan Christen wrote concurring with the opinion.)

Indeed, each of the three waived defenses would have required the court to address important unresolved questions about the permissible scope of Lanham Act claims.

*Aesthetic functionality: If a product is bought largely for its aesthetic value, its aesthetic features may be "functional" rather than source-identifying, and therefore those features may not be protectable under the Lanham Act. See *Au-Tomotive Gold Inc. v. Volkswagen of America Inc.*, 457 F.3d 1062, 1064, 1068 (9th Cir. 2006). As the 9th Circuit noted in *Au-Tomotive*, the heart shape of a candy box might be unprotectable under the aesthetic functionality doctrine. To determine whether the aesthetic functionality doctrine precludes protection of an aesthetic feature, the 9th Circuit "inquires whether protection of the feature as a trademark would impose significant non-reputation-related competitive disadvantage." That is to say, the court will assess whether a plaintiff's exclusive use of an aesthetic feature would significantly disadvantage its competitors wholly independently of the feature's use to identify the plaintiff as the product's source.

The precise contours of the aesthetic functionality doctrine remain unresolved, particularly in the context of a false endorsement claim. See *Christian Louboutin S.A. v. Yves Saint Laurent America Holding Inc.*, 696 F.3d 206, 222 (2d Cir. 2012) (successful source indication can be difficult to distinguish from aesthetic function).

Here, defendants argued on appeal that their use of Marley's image was aesthetically functional because plaintiffs' exclusive use of Marley's image would put competitors at a significant non-reputation-related disadvantage in selling Marley merchandise. According to defendants, consumers purchase Marley merchandise because Marley's image expresses allegiance to what he represents, not because Marley's image assures consumers that plaintiffs produced or sponsored the goods.

But plaintiffs introduced evidence that some surveyed consumers viewed Marley's image on a T-shirt to mean that Marley or his agents gave their approval for the T-shirt. No prior circuit authority addresses whether putting a celebrity's image on a T-shirt or other merchandise avoids Lanham Act liability under

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the aesthetic functionality doctrine, especially where the celebrity's image performs an expressive function yet there is also evidence of consumer confusion as to a product's source.

**Dastar*: In *Dastar*, a film company copied a television series that had passed into the public domain, and marketed it as its own. The court held there could be no Lanham Act violation because the "origin" of goods in 15 U.S.C. Section 1125(a)(1)(A) should be interpreted to refer not to the author of the communication embodied in a good, but to the producer of the tangible good itself. The court reasoned that holding otherwise would provide authors of creative works with perpetual protection under the Lanham Act they could not get under the Copyright Act.

Here, defendants argued on appeal that plaintiffs' Lanham Act claims must fail under *Dastar* because they vitiate the Copyright Act by giving plaintiffs a perpetual monopoly over all images of Marley, even where plaintiffs are not the copyright holder. Interpreted broadly, *Dastar* bars Lanham Act claims based on the content of communicative products to avoid impinging on the rights traditionally recognized under copyright law. See Mark P. McKenna, *Dastar's Next Stand*, 19 J. I. P. L. 357, 363 (2012) ("*Dastar* should be understood, or at least should be extended, to rule out categorically Lanham Act claims that are based on the content of the defendant's creative work.>").

Yet it remains an open question whether to adopt this broad a reading of *Dastar*, along with whether a celebrity's image on T-shirts or similar merchandise could be protected content of communicative products under this reading.

First Amendment: The 9th Circuit has adopted the approach from *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), to address the intersection of the Lanham Act and the First Amendment. Although generally likelihood of confusion is the sine qua non of a Lanham Act action, the alternative *Rogers* test applies when an artistic work is at issue. "An artistic work's use of a trademark that otherwise would violate the Lanham Act is not actionable "unless the [use of the mark] has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless [it] explicitly misleads as to the source or the content of the work." *E.S.S. Entertainment 2000 Inc. v. Rock Star Videos Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008). The *Rogers* test has been applied to Lanham Act false endorsement claims. See *ETW Corp. v. Jireh Publ'g Inc.*, 332 F.3d 915, 926 (6th Cir. 2003).

There are no circuit authorities resolving whether T-shirts or other apparel bearing a celebrity's image can be "artistic works" subject to the *Rogers* test instead of the standard likelihood of confusion analysis. But defendants may have had a particularly strong First Amendment right to use Bob Marley's image because his image (perhaps representing reggae music, Rastafarian ideology, Jamaican culture, revolution, freedom, and smoking marijuana) transcends the symbolic value of most other celebrities.

Defendants' decision not to pursue these defenses until the appeal is especially puzzling because the 9th Circuit nearly relied on the first two defenses to hand some of the same defendants a victory when they featured the Betty Boop cartoon character on their T-shirts. See *Fleischer Studios Inc. v. A.V.E.L.A. Inc.*, 636 F.3d 1115 (9th Cir.), *withdrawn and superseded by* 654 F.3d 958 (9th Cir. 2011). The 9th Circuit initially relied on the aesthetic functionality doctrine and *Dastar* to affirm summary judgment for defendants (even though defendants did not raise those issues on appeal) before withdrawing that opinion and resolving the case on other grounds.

As in *Fleischer*, each of the waived defenses in *Hope Road* could have allowed the 9th Circuit to address important legal issues and won the case for defendants had the issues been raised earlier. *Hope Road* is one more reminder to *get up, stand up, stand up for your rights*.

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