

May 2017

## Let's Stop Playing Games: A Consistent Test for Unlicensed Trademark Use and the Right of Publicity in Video Games

Arlen Papazian

Follow this and additional works at: <https://scholarship.law.wm.edu/wmblr>



Part of the [Intellectual Property Law Commons](#)

---

### Repository Citation

Arlen Papazian, *Let's Stop Playing Games: A Consistent Test for Unlicensed Trademark Use and the Right of Publicity in Video Games*, 8 Wm. & Mary Bus. L. Rev. 577 (2017), <https://scholarship.law.wm.edu/wmblr/vol8/iss3/5>

Copyright c 2017 by the authors. This article is brought to you by the William & Mary Law School Scholarship Repository.  
<https://scholarship.law.wm.edu/wmblr>

# LET'S STOP PLAYING GAMES: A CONSISTENT TEST FOR UNLICENSED TRADEMARK USE AND THE RIGHT OF PUBLICITY IN VIDEO GAMES

ARLEN PAPAZIAN\*

## ABSTRACT

*Courts cannot agree on how to handle cases centered on unlicensed use of a trademark or celebrity's likeness in video games. Two tests have arisen as the primary standards by which to judge such cases: the Rogers test and the transformative-use test. However, in an area of law muddled by multiple standards and the inconsistent application of those standards to a relatively new medium, neither test can adequately balance mark holder rights with the constitutional rights of video game developers. In this turmoil, large video game companies take advantage of marks and licenses knowing the rightful holders will have little recourse, while other mark holders bring frivolous suits against earnest game developers who simply want to create a work of immersive art. In order to tame this unrest, courts must adopt a single standard that can be applied consistently to all cases. Many scholars tout the transformative-use test as this standard, but it is not adequate.*

*This Note proposes a modification of the Rogers test that considers the factors of sufficient transformation, affirmative statements of sponsorship by the developer, the purpose of the mark use, and its frequency and importance in the context of the video game. This test will allow courts to comprehensively balance all parties' rights while still upholding precedential case law.*

---

\* Author is a J.D. Candidate at William & Mary Law School. He wishes to thank his family for always encouraging and supporting him, in particular his sister, Sabrina Papazian, for being a brilliant and driven role model, as well as the staff of *The William & Mary Business Law Review* for all their work in editing this Note.

TABLE OF CONTENTS

INTRODUCTION .....	579
I. BACKGROUND.....	582
II. THE RIGHT OF PUBLICITY AND THE TRANSFORMATIVE-USE TEST IN VIDEO GAMES .....	585
III. USE OF UNLICENSED TRADEMARKS AND THE <i>ROGERS</i> TEST IN VIDEO GAMES .....	587
IV. A CASE FOR A UNIFIED TEST: VIDEO GAMES PRIMARILY SERVE A COMMERCIAL PURPOSE.....	592
V. A REFORMED <i>ROGERS</i> TEST: TRANSFORMATIVE-USE AS A FACTOR FOR THE EXPLICITLY MISLEADING PRONG .....	596
CONCLUSION .....	602

## INTRODUCTION

Ryan Hart stands poised, ready for the snap. He dons his jersey, number thirteen with “RUTGERS” emblazoned proudly above it in large block letters. This is his home field; these are his fans that cheer enthusiastically in the crowd. The din diminishes as they wait for the game announcer to finish the sponsored advertisement. The image on the jumbotron shifts back to the field as the large Pontiac logo disappears off the screen. His team makes some last second adjustments to prepare themselves for the play. He locks his eyes on the football and takes a step back. These are the moments Ryan Hart plays football for. These are the moments Ryan Hart lives for. Except, this is not Ryan Hart. It is a virtual avatar of Ryan Hart. This is not Rutgers’s field; we are in EA Sports’s video game *NCAA Football 2005*. And, this is not what Ryan Hart signed up for.

TV shows and movies frequently use celebrity likenesses as well as real-world products and brand names in order to create a more recognizable and immersive experience to which viewers can relate.<sup>1</sup> Video games may be a more recent form of art and entertainment, but they too often use real-world likenesses to deliver a captivating experience.<sup>2</sup> However, video game developers are not always consistent in whether they gain permission from celebrities or trademark holders whose likenesses they use.<sup>3</sup>

---

<sup>1</sup> See Wesley W. Wintermyer, *Who Framed Rogers v. Grimaldi?: What Protects Trademark Holders Against First Amendment Immunity for Video Games?*, 64 ALA. L. REV. 1243, 1243 (2013).

<sup>2</sup> Even some of the earliest video games used celebrity likenesses to help sales. See Peter Mai, *Plagiarism?: Video Game Art That Looks Like the Movies*, OC WEEKLY (June 2, 2010, 10:46 AM), [http://blogs.ocweekly.com/heardmental-ity/2010/06/plagiarism\\_video\\_game\\_art\\_that\\_copied\\_movie\\_posters.php](http://blogs.ocweekly.com/heardmental-ity/2010/06/plagiarism_video_game_art_that_copied_movie_posters.php) [<https://perma.cc/VPZ6-ZHN8>] (describing resemblances between many video game characters and contemporary movie stars through the decades).

<sup>3</sup> Compare Chris Suellentrop, *Casting the Single-Player Movie Star: Kevin Spacey Stars in Call of Duty: Advanced Warfare*, N.Y. TIMES (Oct. 31, 2014), [http://www.nytimes.com/2014/11/02/arts/video-games/kevin-spacey-stars-in-call-of-duty-advanced-warfare.html?\\_r=0](http://www.nytimes.com/2014/11/02/arts/video-games/kevin-spacey-stars-in-call-of-duty-advanced-warfare.html?_r=0) [<https://perma.cc/L32V-BZZP>], with Sam Byford, *Ellen Page Accuses ‘The Last of Us’ Developers of ‘Ripping Off’ Her Likeness*, THE VERGE (June 24, 2013, 1:26 AM), <http://www.theverge.com/2013/6/24/4458368/ellen-page-says-the-last-of-us-ripped-off-her-license> [<https://perma.cc/QRW4-VR2M>].

Sometimes the developer will not bother to ask for permission at all.<sup>4</sup> Other times, developers may hire an actor to undergo motion-capture filming and rendering to deliver as lifelike a performance as possible.<sup>5</sup> The inconsistent practices of developers stem from the relative novelty of the video game industry and the varying tests that courts apply to settle cases of unlicensed image use in this field.<sup>6</sup>

The inconsistent practices of developers do not end with celebrity likenesses. In order to fully assimilate players into the universe created by the video game, different games can include all manner of consumer products and brand names based on real-world counterparts: cars, clothes, weapons, and more.<sup>7</sup> These products and brands are frequently trademarked, but developers do not bother seeking approval from the trademark holder to use their intellectual property.<sup>8</sup>

Trademark law exists to prevent consumer confusion and protect ownership rights.<sup>9</sup> A right of publicity is also widely recognized by many states,<sup>10</sup> often as an extension of the right of privacy.<sup>11</sup> The right of publicity exists to protect an individual's ability to control the image and reputation that he has built for himself.<sup>12</sup> These rights can sometimes come at odds with the First Amendment right of freedom of expression of another party who desires to use his image.<sup>13</sup> Freedom of expression protects the use of a

<sup>4</sup> Byford, *supra* note 3.

<sup>5</sup> Suellentrop, *supra* note 3.

<sup>6</sup> *Compare* E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1099 (9th Cir. 2008) (utilizing a standard called the *Rogers* test), *with* Hart v. Elec. Arts, Inc., 717 F.3d 141, 160 (3d Cir. 2013), *and In re* NCAA Student-Athlete Name & Likeness Licensing Litig., 724 F.3d 1268, 1274 (9th Cir. 2013) (applying the transformative-use test).

<sup>7</sup> Wintermyer, *supra* note 1, at 1243.

<sup>8</sup> *Id.* at 1243–44.

<sup>9</sup> James E. Stewart & Amy A. Lehman, *The First Amendment and the Lanham Act: What is This Thing Called Artistic Relevance?*, 28 COMM. LAW. 4, 4 (2012); *see also* Trademark (Lanham) Act of 1946, 15 U.S.C. §§ 1051–1127 (2012).

<sup>10</sup> *See generally* *Right of Publicity: An Overview*, CORNELL UNIV. L. SCH., <https://www.law.cornell.edu/wex/Publicity> [<http://perma.cc/9LF8-U6J8>].

<sup>11</sup> *See* RESTATEMENT (SECOND) OF TORTS §§ 652A–652I (recognizing intrusion, false light, appropriation of name or likeness, and unreasonable publicity as the four types of invasion of privacy).

<sup>12</sup> Joseph Gutmann, Note, *It's in the Game: Redefining the Transformative Use Test for the Video Game Arena*, 31 CARDOZO ARTS & ENT. L.J. 215, 217 (2012).

<sup>13</sup> U.S. CONST. amend. I.

name, likeness, or trademark except when used in a commercial manner.<sup>14</sup> Courts should establish a consistent test with which to best balance these competing rights.

Part of the trouble with determining consistent outcomes for cases revolving around video games arises from the gray area that they occupy as both an artistic work and a commercial product. Use of a likeness, name, or trademark without license for purely artistic expression is protected.<sup>15</sup> On the other hand, the Lanham Act prohibits unlicensed use of that same likeness, name, or trademark for a primarily commercial purpose.<sup>16</sup> Video games are undoubtedly both, so how should courts decide how to categorize decisions?

Different courts have primarily used two different tests to judge cases of this kind: the *Rogers* test and the transformative-use test.<sup>17</sup> Cases involving the right to publicity tend to invoke the transformative-use test,<sup>18</sup> while cases involving claims of trademark usually stand scrutiny against the *Rogers* test.<sup>19</sup> This Note discusses which test would be most effective in determining both categories of claims. Part I lays out the background cases from which the primary tests were derived.<sup>20</sup> Part II examines the treatment of right of publicity issues in video game cases.<sup>21</sup> Part III delves into some of the counterpart cases centered on trademark use in video games.<sup>22</sup> Part IV argues that video games are primarily a consumer product and that the Lanham Act should govern both right of publicity cases and trademark cases, and both should be subject to the same test.<sup>23</sup> Finally, Part V proposes use of a

---

<sup>14</sup> *Id.*; see also Gutmann, *supra* note 12, at 218.

<sup>15</sup> “[B]ecause of First Amendment concerns, the Lanham Act cannot apply... ‘within the realm of artistic expression[.]’” *Rogers v. Grimaldi*, 875 F.2d 994, 997 (2d Cir. 1989) (citing *Rogers v. Grimaldi*, 695 F. Supp. 112, 120 (S.D.N.Y. 1988)). See generally Steward & Lehman, *supra* note 9.

<sup>16</sup> *Right of Publicity: An Overview*, *supra* note 10; see also Trademark (Lanham) Act of 1946, 15 U.S.C. §§ 1051–1127 (2012).

<sup>17</sup> See generally *Rogers*, 875 F.2d 994 (establishing *Rogers* test); see also *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001) (establishing the transformative-use test); Wintermyer, *supra* note 1, at 1244.

<sup>18</sup> See *infra* Part II.

<sup>19</sup> See *infra* Part III.

<sup>20</sup> See *infra* Part I.

<sup>21</sup> See *infra* Part II.

<sup>22</sup> See *infra* Part III.

<sup>23</sup> See *infra* Part IV.

modified *Rogers* test that incorporates the transformative-use test as a factor.<sup>24</sup> This test considers other factors as well—namely presence of an affirmative statement of sponsorship, purpose of the mark use, and frequency and importance of the use—to ensure even-handed protection of mark holders as well as the artistic expression of video game developers.

## I. BACKGROUND

A “likelihood of confusion” analysis stands as the traditional test used in trademark infringement cases.<sup>25</sup> While courts may consider varying factors in this analysis, the core determinations are outlined in *Polaroid Corp. v. Polarad Electronics Corp.*<sup>26</sup> These variables include: the strength of the prior owner’s mark, the degree of similarity between the marks, the commercial proximity of the products, the likelihood that the prior owner will bridge the gap by entering and competing in the subsequent owner’s market, the risk of actual consumer confusion, the intent of the defendant to capitalize on the reputation of the prior owner, the quality of the defendant’s product, and the sophistication of consumers.<sup>27</sup> This long list of factors has been a source of confusion in many trademark cases,<sup>28</sup> but it is particularly ill-suited regarding cases involving video game disputes.

Video games did not find widespread mainstream popularity and commercial success until the 1970s,<sup>29</sup> about a decade after *Polaroid* was decided. *Polaroid* could not have contemplated virtual trademark use, as it was not a technological possibility at the time. Furthermore, trademarks used in video games are usually merely incidental in the context of the game.<sup>30</sup> Ideally, only in rare

---

<sup>24</sup> See *infra* Part V.

<sup>25</sup> See Wintermyer, *supra* note 1, at 1244.

<sup>26</sup> See generally Kevin Blum et al., *Consistency of Confusion? A Fifteen-Year Revisiting of Barton Beebe’s Empirical Analysis of Multifactor Tests for Trademark Infringement*, 2010 STAN. TECH. L. REV. 3, 3 (2010).

<sup>27</sup> *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961).

<sup>28</sup> Blum et al., *supra* note 26, at 3.

<sup>29</sup> Riad Chikhani, *The History of Gaming: An Evolving Community*, TECHCRUNCH (Oct. 31, 2015), <https://techcrunch.com/2015/10/31/the-history-of-gaming-an-evolving-community/> [http://perma.cc/U3NB-SU7Q].

<sup>30</sup> “[U]se of the mark is only incidental to the game itself and not integral to its sale or marketing, the likelihood is slim that the average gamer would be

cases should a consumer face actual confusion about a mark holder's role in developing a game.<sup>31</sup> On the other hand, the increase of product placement in video games, and all media generally, may lead consumers to believe that the appearance of a familiar trademark or likeness is the result of cross-promotion.<sup>32</sup>

Instead of trying to stretch the “likelihood of confusion” test developed by the *Polaroid* court for trademark disputes in pure commercial settings, courts have sought to resolve trademark disputes in video games by applying tests used in comparable cases involving similar media—namely television and movies.<sup>33</sup> In *Rogers v. Grimaldi*, Ginger Rogers—a famous actress—brought action against defendant filmmakers for invoking her name and reputation in the movie “Ginger and Fred.”<sup>34</sup> Rogers brought claims under the common law right to publicity and under the Lanham Act.<sup>35</sup> Rogers carefully selected her chosen endorsements and feared her reference by the film would cause consumers to believe she endorsed the work.<sup>36</sup> That court found in favor of the filmmakers, holding that the use of a mark or celebrity's name in the title of a work is permitted so long as the title has some artistic relevance to the underlying work and is not meant to explicitly mislead as to the source or content of the work.<sup>37</sup> This test presumes that every use of a mark is protected by the First Amendment freedom of artistic expression.<sup>38</sup> Because of the low standard for

---

confused that the markholder actually developed the game.” Wintermyer, *supra* note 1, at 1244 (citing Russell Frackman & Joel Leviton, *Trademarks, Video Games and the First Amendment: An Evolving Story*, WORLD TRADEMARK REV., Oct./Nov. 2010, at 62, 63).

<sup>31</sup> *Id.*

<sup>32</sup> *See infra* notes 113–21.

<sup>33</sup> *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492, 496 (2d Cir. 1961).

<sup>34</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. 1989).

<sup>35</sup> *Id.* The Lanham Act protects against

[a]ny person who, on or in connection with any goods or services, ... uses in commerce any ... name ... which ... 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 ....

15 U.S.C. § 1125(a)(1) (2012).

<sup>36</sup> *Rogers v. Grimaldi*, 695 F. Supp. 112, 114 (S.D.N.Y. 1988).

<sup>37</sup> *Rogers*, 875 F.2d at 999.

<sup>38</sup> *See* U.S. CONST. amend. I; Wintermyer, *supra* note 1, at 1257.

artistic relevance, the *Rogers* test is extremely lenient towards the user of a mark or name.<sup>39</sup>

The transformative-use test has emerged as another standard by which courts analyze use of a name, mark, or image in artistic media. This test, instead of determining the value of artistic relevance, focuses on whether the use varies from the protected mark in a substantial creative way.<sup>40</sup> The California Supreme Court pioneered the transformative-use test in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*<sup>41</sup> In that case, Comedy III Productions owned the rights to the former comedy act The Three Stooges.<sup>42</sup> Comedy III Productions sued Saderup, an artist selling lithographs and t-shirts bearing the likenesses of the Three Stooges, Moe, Larry, and Curly, for infringement of its right of publicity.<sup>43</sup> That court asked if the contested work added significant creative elements so as to transform it into something more than a mere imitation or celebrity likeness.<sup>44</sup> The First Amendment protects works that have been sufficiently transformed in this way, but does not protect depictions that are mere replications.<sup>45</sup> The court, in its holding, recognized the right of publicity as an intellectual property right.<sup>46</sup> Recently, in 2013, both the Third and Ninth Circuits accepted the transformative-use test as the appropriate standard in right of publicity cases regarding reproduction of celebrity likenesses.<sup>47</sup>

The transformative-use test does not provide as much leniency to unlicensed trademark users as the *Rogers* test does. While *Rogers*

---

<sup>39</sup> The *Rogers* test is designed to protect consumers from flagrant deception, not intellectual property right holders. Wintermyer, *supra* note 1, at 1252. The *Rogers* court defined the standard for artistic relevance that the mark or name must meet as the extremely low threshold of “minimal” artistic relevance. *Id.* at 1257.

<sup>40</sup> See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001).

<sup>41</sup> *Id.*

<sup>42</sup> *Id.* at 800.

<sup>43</sup> *Id.*

<sup>44</sup> *Id.* at 799, 809 (stating that the First Amendment will not protect the depiction if it is “the very sum and substance of the work in question.”).

<sup>45</sup> See Wintermyer, *supra* note 1, at 1257.

<sup>46</sup> *Comedy III Prods., Inc.*, 21 P.3d at 806.

<sup>47</sup> See generally *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013); *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013).

provides the defendant the wide berth of a low threshold for artistic relevance, the transformative-use test places the burden of proof on the content producer to prove that the trademark use presents enough creative difference to warrant protection under the First Amendment.<sup>48</sup> However, the transformative-use test has led to varying results by different courts because of the vagueness of what constitutes “significant creative elements.”<sup>49</sup>

## II. THE RIGHT OF PUBLICITY AND THE TRANSFORMATIVE-USE TEST IN VIDEO GAMES

The first case to apply the transformative-use test to a video game was another California case, *Kirby v. Sega of America*.<sup>50</sup> Kierin Kirby, lead singer for Deee-Lite, a funk-dance band in the early 1990s, brought suit against Sega of America for allegedly using her likeness as the basis for the protagonist character in the game *Space Channel 5*.<sup>51</sup> Kirby claimed the character resembled her facial features, futuristic clothing style, hairstyle, use of catch phrases, and musical and dance abilities.<sup>52</sup> Applying the transformative-use test, that court determined that Sega had transformed the virtual character into more than a mere likeness or exact depiction of Kirby.<sup>53</sup> This was primarily because the character wore different costumes and used different dance moves than Kirby; additionally, the character was a futuristic news reporter by profession, dissimilar to Kirby’s public image as a music diva.<sup>54</sup>

More recently, many cases centering on virtual representations of college athletes, primarily football players, in sports video

---

<sup>48</sup> Wintermyer, *supra* note 1, at 1258.

<sup>49</sup> District courts in California and New Jersey have applied the transformative-use test to very similar fact patterns and came to different results based on their interpretations of the definition of “sum and substance.” Gutmann, *supra* note 12, at 225.

<sup>50</sup> *Kirby v. Sega of America, Inc.*, 144 Cal. App. 4th 47 (Cal. Ct. App. 2006).

<sup>51</sup> *Id.* at 50–52.

<sup>52</sup> *Id.* at 56. For a comparison image of Ms. Kirby and *Space Channel 5* protagonist, “Ulala,” see *The Right of Publicity—Concerns About the Reach of Keller v. EA, WRITER IN L.* (Aug. 16, 2013, 6:31 PM), <https://writerinlaw.files.wordpress.com/2013/08/kirby.jpg> [<https://perma.cc/M9WB-E6H9>].

<sup>53</sup> *Kirby*, 144 Cal. App. 4th at 59.

<sup>54</sup> *Id.* “Taken together, these differences demonstrate Ulala is ‘transformative,’ and respondents added creative elements to create a new expression.” *Id.*

games have addressed the right of publicity and the transformative-use test.<sup>55</sup> These cases applied the same test to very similar facts, but—because of the vagueness of the transformative-use test—came to different conclusions at the district court level.<sup>56</sup> The District Court for the Northern District of California held in *Keller v. Electronic Arts* that a virtual representation of college football player Sam Keller in the video game series *NCAA Football* did not constitute a transformative use and was therefore barred from First Amendment protection.<sup>57</sup> That court looked at the built-in characteristics of the avatar to determine if any significant elements had been added. It did not consider the ability for players to customize and interact with the avatars.<sup>58</sup>

A District of New Jersey court looked at different factors in determining what might suffice as creative elements for transformative use, originally holding in *Hart v. Electronic Arts* that the avatar of Ryan Hart in the same *NCAA Football* video game franchise on its own would constitute an untransformed image; however, a player's ability to customize the features of the avatar made for a transformative use.<sup>59</sup> When deciding what establishes the significant creative elements for transformative-use, that court not only considered the physical depiction of the avatar and the game's environment, but also the level of changeability and interactivity available to game players.<sup>60</sup>

Despite confusion at the district court level, circuit courts have been more consistent with their rulings on transformative-use

---

<sup>55</sup> See generally *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013); *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013); *Keller v. Elec. Arts, Inc.*, 94 U.S.P.Q.2d 1130, 2010 WL 530108 (N.D. Cal. Feb. 8, 2010); *O'Bannon v. Nat'l Collegiate Athletic Ass'n*, 7 F. Supp. 3d 955 (N.D. Cal. Feb. 8, 2010).

<sup>56</sup> Gutmann, *supra* note 12, at 225.

<sup>57</sup> *Keller*, 94 U.S.P.Q.2d at \*5.

<sup>58</sup> Gutmann, *supra* note 12, at 217. The Court only looked at similarity of physical characteristics between Keller and his avatar: height, weight, jersey number, and public image as a football player. *Keller*, 94 U.S.P.Q.2d at \*5.

<sup>59</sup> The U.S. District Court for the District of New Jersey stated that since interactivity is an essential nature of video games, the ability for consumers to edit the features of the virtual players and the “potential formulations of each virtual player alone makes the game a transformative use of Hart's image.” *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 785 (D.N.J. 2011), *rev'd*, 717 F.3d 141 (3d Cir. 2013).

<sup>60</sup> Gutmann, *supra* note 12, at 224–25.

cases in video games.<sup>61</sup> In *In re NCAA Student-Athlete Name & Likeness Licensing Litigation v. Electronic Arts* (“*In re NCAA*”), the Ninth Circuit Court of Appeals upheld the district court’s decision that the use of Keller’s image in the *NCAA Football* series did not constitute a transformative use.<sup>62</sup> The Third Circuit, on the other hand, reversed the district court of New Jersey’s decision in *Hart*.<sup>63</sup> The Third Circuit still applied the transformative-use test, but it did not find that the ability to customize and modify the avatars satisfied the significant creative element requirement.<sup>64</sup> Since the original unmodified avatar was an untransformed use, the First Amendment did not protect it.<sup>65</sup> These decisions begin to harmonize the standard and interpretation of the transformative-use test. The earlier district court decisions demonstrate, however, that there still exists variation in how the test may be applied.

When looking at the difference between the outcomes of the *Kirby* case and the *NCAA Football* cases, it appears that the environment and persona of the virtual depictions stand as critical issues in determining whether a significant transformation occurred.<sup>66</sup>

### III. USE OF UNLICENSED TRADEMARKS AND THE *ROGERS* TEST IN VIDEO GAMES

Courts have readily applied the *Rogers* test to many cases involving unlicensed use of a trademark in video games.<sup>67</sup> Although

---

<sup>61</sup> See generally *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 141 (3d Cir. 2013); *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013).

<sup>62</sup> *NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1276. This case is a continuation of *Keller* as a larger class-action suit. See *id.*

<sup>63</sup> *Hart*, 717 F.3d at 141.

<sup>64</sup> *Id.* at 166, 174–75.

<sup>65</sup> *Id.* at 170.

<sup>66</sup> Gutmann, *supra* note 12, at 225. An important factor in deciding if there has been a transformative use should be whether or not the game takes place in an “altered reality” or is an “imitation of life.” *Id.* at 227. An environment that solely seeks to imitate life through realism is not an original creation. *Id.* at 229. However, when a developer places a celebrity’s likeness in a new environment or gives it a new persona or new characteristics, the game alters significant aspects of reality and gives rise to a new creation that should be protected by the First Amendment. *Id.* at 228–29.

<sup>67</sup> See generally *E.S.S. Entm’t 2000 v. Rock Star Videos*, 547 F.3d 1095 (9th Cir. 2008); *VIRAG, S.R.L. v. Sony Computer Entm’t America LLC*, No. 3:15-cv-01729-LB, 2015 WL 5000102 (N.D. Cal. Aug. 21, 2015); *Mil-Spec Monkey, Inc.*

the *Rogers* test traditionally applies to the title of an artistic work, it may also be extended to a trademark use in the body of the work—in these cases, trademark use within actual video games.<sup>68</sup> In *E.S.S. Entertainment 2000 v. Rock Star Videos*, the owner of a strip club, Play Pen Gentlemen’s Club, brought suit against Rockstar, the developer of the *Grand Theft Auto* video game series.<sup>69</sup> The game *Grand Theft Auto: San Andreas* takes place in a fictional recreation of California State and even contains a cartoon-style replication of Los Angeles entitled “Los Santos.”<sup>70</sup> In order to appropriately capture the feeling of the seedy underbelly of Los Angeles, Los Santos contained a virtual strip club called the “Pig Pen.”<sup>71</sup> The owner of the real-life strip club, the Play Pen, claimed that the virtual gentleman’s club constituted trademark infringement on the business from which it drew its inspiration.<sup>72</sup> The Ninth Circuit applied the *Rogers* test to determine that the “Pig Pen” served at least “some artistic relevance” in setting the tone of the game,<sup>73</sup> and Rockstar did not attempt to “explicitly mislead ... as to the source or content of the work.”<sup>74</sup> This holding shows the exceptional leniency of the “artistic relevance” prong of the test.<sup>75</sup> The video game is not about a strip club, nor is the strip club necessary to the story; it simply exists as a set piece to establish the “look and feel” of the environment.<sup>76</sup> Under this standard, it is hard to imagine an example that would not satisfy the relevance prong of the *Rogers* test.

---

v. Activision Blizzard, Inc., 74 F. Supp. 3d 1134 (N.D. Cal. 2014); Novalogic, Inc. v. Activision Blizzard, Inc., 41 F. Supp. 3d 885 (C.D. Cal. 2013); Dillinger, LLC v. Elec. Arts, No. 1:09-cv-1236-JMS-DKL, 2011 WL 2457678 (S.D. Ind. June 16, 2011).

<sup>68</sup> *E.S.S. Entm’t 2000*, 547 F.3d at 1099.

<sup>69</sup> *Id.* at 1097–98.

<sup>70</sup> GRAND THEFT AUTO: SAN ANDREAS (Rockstar Games, PlayStation 2 2004); *E.S.S. Entm’t 2000*, 547 F.3d at 1097.

<sup>71</sup> *E.S.S. Entm’t 2000*, 547 F.3d at 1097.

<sup>72</sup> *Id.* at 1097–98.

<sup>73</sup> *Id.* at 1100 (citing *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989)).

<sup>74</sup> *Id.* A reasonable buyer would not conclude that a small, largely unknown strip club helped produce a technically complicated game that painted the club in an unfavorable light; nor would a buyer reasonably believe that a game developer operated a strip club. *Id.* at 1100–01.

<sup>75</sup> *Id.* at 1099.

<sup>76</sup> *Id.* at 1100.

Since *E.S.S. Entertainment 2000*, courts in the Ninth Circuit have repeatedly and liberally applied the *Rogers* test to video game cases.<sup>77</sup> One district court in the Seventh Circuit also has applied the same standard.<sup>78</sup> That case centered on the use of the “Dillinger” trademark name—referencing famous American gangster John Dillinger—in naming weapons in Electronic Arts’s *The Godfather* games.<sup>79</sup> The plaintiff argued that the use of Dillinger’s name was not a reasonably necessary aspect of the games because John Dillinger did not appear in the video games nor the films or novel on which Electronic Arts based the games.<sup>80</sup> The court rejected the plaintiff’s argument because Dillinger’s name, even though only superficial and attenuated, had at least some artistic relevance in establishing the Mafia world of *The Godfather* games.<sup>81</sup>

Since the “artistic relevance” prong of the *Rogers* test sweepingly permits trademark use in the name of the First Amendment, it is hoped that the second prong—the “explicitly misleading” prong—might help to balance trademark holders’ interests against developers’ constitutional rights. In a suit against Textron Innovations, Electronic Arts—once again the perpetrator of unlicensed trademark use—preemptively brought action to justify use of a virtual representation of a Bell Helicopter in the video game *Battlefield 3* under the *Rogers* test.<sup>82</sup> The district court denied Electronic

---

<sup>77</sup> See generally *VIRAG, S.R.L. v. Sony Computer Entm’t America LLC*, No. 3:15-cv-01729-LB, 2015 WL 5000102 (N.D. Cal. Aug. 21, 2015) (dismissing plaintiff’s complaint of infringement for use of VIRAG’s trademark in defendant’s games *Gran Turismo 5* and *Gran Turismo 6*); *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*, 74 F. Supp. 3d 1134 (N.D. Cal. 2014) (granting summary judgment to defendants for use of registered “angry monkey” mark on military combat gear in *Call of Duty: Ghosts*); *Novalogic, Inc. v. Activision Blizzard, Inc.*, 41 F. Supp. 3d 885 (C.D. Cal. 2013) (granting summary judgment to defendants regarding use of word mark “Delta Force” in *Call of Duty: Modern Warfare 3*).

<sup>78</sup> See generally *Dillinger, LLC v. Electronic Arts*, No. 1:09-cv-1236-JMS-DKL, 2011 WL 2457678 (S.D. Ind. June 16, 2011).

<sup>79</sup> Electronic Arts chose to name two Tommy Guns after Dillinger because he was popularly depicted wielding the submachine guns as his weapon of choice. *Id.* at \*2.

<sup>80</sup> *Id.* at \*4. Plaintiff further argued that John Dillinger was not even alive during the time period in which the games take place and operated in a different location from the games’ setting. *Id.*

<sup>81</sup> *Id.* at \*5.

<sup>82</sup> See generally *Electronic Arts, Inc. v. Textron Inc.*, No. C 12-00118 WHA, 2012 WL 3042668 (N.D. Cal. July 25, 2012).

Arts's motion to dismiss Textron's counterclaims.<sup>83</sup> Textron's allegations raised sufficient support for an inference that *Battlefield 3* and its advertising were explicitly misleading as to its source and content.<sup>84</sup> Textron claimed that the ability to virtually fly Bell Helicopters in the game would factor into a consumer's decision to buy *Battlefield 3*.<sup>85</sup> The video game's website additionally advertised one of the helicopters specifically in a promotional image encouraging consumers to buy the game.<sup>86</sup> Despite Textron's strong argument to trigger the explicitly misleading prong of the *Rogers* test, Electronic Arts settled the suit out of court before a final verdict could be entered. Although details of the settlement are unknown, perhaps Electronic Arts was eager to settle in order to prevent the risk of that court holding that the use of Textron's trademark and trade dress triggered the explicitly misleading prong. A ruling against Electronic Arts would have created troublesome precedent for them that could have checked the developer's so-far-unbridled use of unlicensed trademarks and likenesses.

The *Rogers* requirement that unlicensed mark users avoid explicitly misleading consumers may provide more hope for trademark holders than the requirement for artistic relevance. Unfortunately, it is still rather lenient towards the game developers. This second prong of the test is still difficult for complainants to fulfill because, to be explicitly misleading, the unlicensed use must be more than merely a representation of the plaintiff's mark; instead, the defendant's work must make some sort of affirmative statement of the other party's endorsement accompanying that representation.<sup>87</sup>

In spite of their legal difficulties surrounding *Battlefield 3*, Electronic Arts decided not to sign licensing agreements with arms manufacturers for trademarked weapons in the sequel game in the series, *Battlefield 4*.<sup>88</sup> This could potentially cause the

---

<sup>83</sup> *Id.* at \*1.

<sup>84</sup> *Id.* at \*3. Textron argued that “[c]onsumers of these games expect that the intellectual property of a party is used with the permission and approval of the mark's owner, particularly when a purpose of the game is to realistically simulate the use of a product associated with the mark.” *Id.* at \*4.

<sup>85</sup> *Id.*

<sup>86</sup> *Id.*

<sup>87</sup> *Dillinger, LLC v. Electronic Arts*, No. 1:09-cv-1236-JMS-DKL, 2011 WL 2457678, at \*6 (S.D. Ind. June 16, 2011).

<sup>88</sup> “[T]hey're asserting their constitutional free speech right to use trademarks without permission.” Tom Sykes, *EA ditches gun licensing deals this*

developer to run into issues with the explicitly misleading prong of *Rogers*. Electronic Arts had previously paid the arms makers for the rights to virtually reproduce real-world weapons,<sup>89</sup> which consumers could view as a mutual endorsement of the products.

Furthermore, only a few months earlier, Electronic Arts was criticized for promoting gun manufacturers.<sup>90</sup> As part of marketing for the game *Medal of Honor: Warfighter*, the developer created a website detailing all of the game's featured weapons.<sup>91</sup> Not only did the website list all of the arms, but it also contained direct hyperlinks to the manufacturers' purchasing catalogs for each of the respective weapons.<sup>92</sup> The game developer publicly boasted on its official website about its partnerships with some of these manufacturers.<sup>93</sup> Even if Electronic Arts were to argue that consumers would not normally assume a brand placement in a video game indicates the mark holder's permission and approval, given Electronic Art's recent open sponsorship and licensing agreements for trademarked weapons in its previous war video games, a reasonable consumer might conclude that Electronic Arts has made the same marketing links for weaponry in *Battlefield 4*. The earlier open sponsorship between the weapons manufacturers and Electronic Arts may be enough to constitute an affirmative statement of endorsement that could be extrapolated to the subsequent game. If a challenge arises as to their now-unlicensed virtual representations of those weapons, Electronic Arts may find it difficult to

---

*year—but will continue to use branded guns*, PC GAMER (May 7, 2013), <http://www.pcgamer.com/ea-ditches-gun-licensing-deals-this-year-but-will-continue-to-use-branded-guns/> [https://perma.cc/9G34-V7V6].

<sup>89</sup> Luke Plunkett, *EA Won't Be Paying For Real Guns in Video Games Anymore*, KOTAKU (May 7, 2013, 11:08 PM), <http://kotaku.com/ea-wont-be-paying-for-real-guns-in-video-games-anymore-494940003> [https://perma.cc/96G2-2XUB].

<sup>90</sup> Paul Tassi, *Cross Promotion Gone Wrong: EA Removes Gun Manufacturer Links from Warfighter Site*, FORBES (Dec. 27, 2012, 10:01 AM), <http://www.forbes.com/sites/insertcoin/2012/12/27/cross-promotion-gone-wrong-ea-removes-gun-manufacturer-links-from-warfighter-site/> [https://perma.cc/G38C-3PWA].

<sup>91</sup> Barry Meier & Andrew Martin, *Real and Virtual Firearms Nurture a Marketing Link*, N.Y. TIMES (Dec. 24, 2012), [http://www.nytimes.com/2012/12/25/business/real-and-virtual-firearms-nurture-marketing-link.html?\\_r=2&adxnnl=1&adxnnlx=1356617383-HtbSZYGjvJzKPLLDYDh5A](http://www.nytimes.com/2012/12/25/business/real-and-virtual-firearms-nurture-marketing-link.html?_r=2&adxnnl=1&adxnnlx=1356617383-HtbSZYGjvJzKPLLDYDh5A) [https://perma.cc/82KQ-MVUY].

<sup>92</sup> *Id.*

<sup>93</sup> Tassi, *supra* note 90.

overcome the *Rogers* requirement that the work must not be explicitly misleading as to source or content.

#### IV. A CASE FOR A UNIFIED TEST: VIDEO GAMES PRIMARILY SERVE A COMMERCIAL PURPOSE

Use of both the transformative-use test and the *Rogers* test to decide cases involving the right of publicity and unlicensed trademark use in video games has led to varying and inconsistent holdings among courts.<sup>94</sup> Circuit courts employ the different tests, which creates confusion about what the applicable standard should be.<sup>95</sup> A good example of this uncertainty manifests itself in *Brown v. Electronic Arts*, a case not dissimilar to *Keller* or *Hart*.<sup>96</sup> There, a professional football player sued Electronic Arts for the use of his likeness in the *Madden NFL* series of video games.<sup>97</sup> Unlike in the NCAA video game cases, the court did not apply the transformative-use test, instead subjecting the claim to the *Rogers* test.<sup>98</sup> The Ninth Circuit claimed that the *Rogers* test was appropriate because Brown brought his claims under the Lanham Act.<sup>99</sup> Unsurprisingly, the court found in favor of the defendant under the exceptionally permissive *Rogers* test, where Brown may have prevailed under the transformative-use test applied in *Keller* and *Hart*, which involved developers' use of personal likenesses.

---

<sup>94</sup> See *supra* Parts II–III; see, e.g., *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013).

<sup>95</sup> See *supra* Parts II–III.

<sup>96</sup> See generally *Brown*, 724 F.3d 1235.

<sup>97</sup> *Id.* at 1239.

<sup>98</sup> *Id.* at 1239–41.

<sup>99</sup> *Id.* at 1239.

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 ... 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 ....

Trademark (Lanham) Act of 1946, 15 U.S.C. § 1125(a)(1) (2012).

In addition to the unreliable employment of tests among courts, even courts using the same test can fluctuate in their application of the tests to similar fact patterns.<sup>100</sup> Much of the uncertainty could be resolved if both the right of publicity cases and trademark infringement cases were treated consistently under the same test.

Although statutory law and state common law generally govern the right of publicity, the Lanham Act can provide protection of a person's identity falsely used to advertise a commercial product.<sup>101</sup> Some criticize the Ninth Circuit's use of the *Rogers* test in *Brown* in what could have been a right of publicity case subject to transformative-use,<sup>102</sup> but the *Brown* court actually made a large step toward creating a unifying test for right of publicity and trademark infringement cases in video games. Video games should be treated as a commercial product, and developers' use of a celebrity's likeness should be treated as a commercial purpose. That way, both types of cases can be afforded federal protection under the Lanham Act. This would override the diverse and differing statutory and common law doctrines that currently confuse matters for right of publicity cases in video games.<sup>103</sup> Lanham Act protection would allow for the application of a single test to right of publicity and trademark infringement cases in video games.

The problem with simply classifying video games as commercial products, of course, is that they do not solely serve a commercial purpose.<sup>104</sup> Video games are also artistic expressions subject to First Amendment protection.<sup>105</sup> Video game studios color their

---

<sup>100</sup> See *supra* Part II.

<sup>101</sup> See *Right of Publicity: An Overview*, *supra* note 10; Lanham Act, 15 U.S.C. § 1125(a)(1).

<sup>102</sup> Jonathan Faber, *Two New Video Game Rulings from the Ninth Circuit*, Jim Brown v. EA and Keller v. EA, RIGHT OF PUBLICITY (Aug. 9, 2013), <http://rightofpublicity.com/tag/lanham-act> [<https://perma.cc/3C2M-XS5Z>].

<sup>103</sup> See *supra* Parts II–III; see, e.g., *Brown*, 724 F.3d at 1235.

<sup>104</sup> *Brown v. Entm't Merchants Ass'n*, 564 U.S. 786, 790–91 (2011) (“Like the protected books, plays, and movies that preceded them, video games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player's interaction with the virtual world). That suffices to confer First Amendment protection.”).

<sup>105</sup> *Id.*

games using various artistic styles to bring their virtual worlds to life; they can include immersive musical scores, tell stories, create characters, and convey ideas. A video game is a work of art just as is a book, a movie, or a play.<sup>106</sup>

On the other hand, the video game industry is incredibly profitable. Since 2010, video game sales in the United States alone have brought in an average of just under \$16 billion a year.<sup>107</sup> Including the hardware and accessories for the games, consumers in the United States spent \$22.41 billion in 2014 alone.<sup>108</sup> Video games draw a wide demographic, including a significant amount of consumers from every age group.<sup>109</sup> While traditionally people may view video games as for young males, this is simply not the case.<sup>110</sup> The average video game player is 35 years old, and 44 percent of consumers are women.<sup>111</sup> Today, four out of every five American households own a device on which to play video games.<sup>112</sup> It is clear from these statistics that video games are a very profitable commercial enterprise.

The fact that companies often contract with video game developers to include product placement only further strengthens the case to consider video games as a commercial product.<sup>113</sup> In modern times, consumers have come to expect product placement in

---

<sup>106</sup> *Id.*

<sup>107</sup> See ENTMT SOFTWARE ASSOC., 2015 SALES, DEMOGRAPHIC AND USAGE DATA: ESSENTIAL FACTS ABOUT THE COMPUTER AND VIDEO GAME INDUSTRY, at 12 (2015), <http://www.theesa.com/wp-content/uploads/2015/04/ESA-Essential-Facts-2015.pdf> [<https://perma.cc/PR73-8MHU>] (between 2010 and 2014, video game sales in the United States reached \$17.1, \$16.7, \$15.2, \$15.4, \$15.4 billion each year, respectively).

<sup>108</sup> *Id.* at 13.

<sup>109</sup> Twenty-six percent of videogame players are under 18 years of age; 30 percent are 18–35; 17 percent are 36–49; and 27 percent are 50 years or older. *Id.* at 3.

<sup>110</sup> Henry Jenkins, *Reality Bytes: Eight Myths About Video Games Debunked*, PBS, <http://www.pbs.org/kcts/videogamerevolution/impact/myths.html> [<https://perma.cc/96VZ-2P6E>].

<sup>111</sup> ENTMT SOFTWARE ASSOC., *supra* note 107, at 3.

<sup>112</sup> *Id.* at 2. This statistic is likely a conservative understatement considering the recent rapid technological advancement and boom of smart phones and mobile gaming in recent years.

<sup>113</sup> Brand placement in video games is particularly effective because it provides for active involvement with the brand as well as a platform for longer shelf life than other media. See generally Michelle R. Nelson, *Recall of Brand*

much of their visual media.<sup>114</sup> Consumers have become so bombarded with it in movies and television that when the camera zooms in and lingers on the front logo of a Mercedes G-Class SUV in *Jurassic World*, consumers know exactly what is going on.<sup>115</sup> The same is becoming true for video games.<sup>116</sup> The cost of creating games has risen substantially over the last few years, driven by increased consumer expectations and the added complexity of each new generation of video game console technology.<sup>117</sup> Despite the growing cost of production, the consumer price for games has stayed relatively constant for about a decade.<sup>118</sup> To keep up with the cost of creation, game studios are now looking to other streams of revenue to avoid raising the price for consumers, particularly looking to product placement.<sup>119</sup> As the amount of product placement in video games increases, consumers expect it more.<sup>120</sup> As gamers become accustomed to seeing product placement, they may begin

---

*Placements in Computer/Video Games*, 42 J. OF ADVER. RES., Mar.–Apr. 2002, at 80. This makes it very enticing for companies to contract for product placement in games.

<sup>114</sup> Elizabeth L. Rosenblatt, *Rethinking the Parameters of Trademark Use in Entertainment*, 61 FLA. L. REV. 1011, 1032 (2009).

<sup>115</sup> Drew Harwell, *'Jurassic World' Shows Just How Weird Product Placement has Become*, WASH. POST (June 12, 2015), [https://www.washingtonpost.com/news/wonk/wp/2015/06/12/jurassic-world-shows-just-how-weird-product-placement-has-become/?utm\\_term=.89be4dc47d9f](https://www.washingtonpost.com/news/wonk/wp/2015/06/12/jurassic-world-shows-just-how-weird-product-placement-has-become/?utm_term=.89be4dc47d9f) [<https://perma.cc/Q2UB-FUGA>]. One study showed that consumers have come to expect product placement so much that 43 percent of consumers believed that the main purpose of a scene in a television show featuring a product was to influence purchase, even if no deal had been made between the mark owner and the television producers. James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 YALE L.J. 882, 919 (2007).

<sup>116</sup> Nelson, *supra* note 113, at 81.

<sup>117</sup> LILIA GUTNIK, ET AL., NEW TRENDS IN PRODUCT PLACEMENT 12, 16 (2007), [https://www.google.com/url?sa=t&rct=j&q=&esrc=s&source=web&cd=&ved=0ahUKEwjilLKumuTRAhVDRyYKHf8FAqUQFggdMAA&url=http%3A%2F%2Fpeople.ischool.berkeley.edu%2F~hal%2FCourses%2FStratTech09%2FTech%2FPreso%2FD-placement.doc&usg=AFQjCNH37tjN\\_\\_h5mq14-X9Jjqzin-GwmA&sig2=JItk1M57x\\_QRaUdI\\_MO-uw&cad=rja](https://www.google.com/url?sa=t&rct=j&q=&esrc=s&source=web&cd=&ved=0ahUKEwjilLKumuTRAhVDRyYKHf8FAqUQFggdMAA&url=http%3A%2F%2Fpeople.ischool.berkeley.edu%2F~hal%2FCourses%2FStratTech09%2FTech%2FPreso%2FD-placement.doc&usg=AFQjCNH37tjN__h5mq14-X9Jjqzin-GwmA&sig2=JItk1M57x_QRaUdI_MO-uw&cad=rja) [<https://perma.cc/7FXJ-8EE7>]. Some blockbuster video games can cost over sixty million dollars and take years to produce. *Id.* at 16.

<sup>118</sup> Consumers typically pay fifty to sixty dollars for a video game produced for a home console. *Id.*

<sup>119</sup> Len Glickman & Anita Kim, *Product Placement and Technology*, 30 ENT. & SPORTS LAW., Spring 2012, at 32.

<sup>120</sup> Rosenblatt, *supra* note 114, at 1056–57.

to believe any use of a familiar trademark or celebrity image is the result of a marketing deal.<sup>121</sup>

The perception of video games as a commercial product and a platform for product placement should place them under the protection of the Lanham Act in right of publicity cases. Of course, courts could extend this same argument to other media, particularly television or movies, but this Note does not delve into the precise character of those media and the body of case law relating to them. Since video games exist in a twilight area between an artistic work and a commercial product, it is important that whichever test is applied balances the rights of artistic expression with the prevention of commercial exploitation: something that neither the transformative-use test nor the *Rogers* test in its current form has been able to do.

#### V. A REFORMED *ROGERS* TEST: TRANSFORMATIVE-USE AS A FACTOR FOR THE EXPLICITLY MISLEADING PRONG

The right of publicity in these cases serves to protect the same interests as trademark law through the Lanham Act.<sup>122</sup> In a way, a celebrity's name and likeness is his or her own personal trademark.<sup>123</sup> Similarly, both categories must also balance those rights with the First Amendment right of others who seek to use the marks and likenesses.<sup>124</sup> Since both laws contend to protect and balance the same rights, it should follow that both laws be subject to the same test in claims of unauthorized use.

Although many criticize the Ninth Circuit's use of the *Rogers* test in *Brown*,<sup>125</sup> that decision is important in establishing that

---

<sup>121</sup> *Id.* If consumers believe that a particular kind of trademark use must always be authorized by the mark holder, then consumers will infer that any such use implies sponsorship or approval by the mark holder and an unauthorized use becomes, by definition, an infringement. *Id.* at 1020.

<sup>122</sup> Both the right of publicity and trademark law exist to protect against consumer confusion but also to protect the right holder's cultivated reputation and goodwill from others who seek to impermissibly take advantage of it or tarnished it. *See supra* notes 9–12 and accompanying text.

<sup>123</sup> "In cases involving confusion over endorsement by a celebrity plaintiff, 'mark' means the celebrity's persona." *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992) (arising in a case involving a television advertisement promoting a Samsung video-cassette recorder and the unconsented use of game show host Vanna White's likeness).

<sup>124</sup> *See supra* notes 9–14 and accompanying text.

<sup>125</sup> *Faber, supra* note 102.

the *Rogers* test can be used in cases involving celebrity likenesses in video games. It presents an example of how cases centered on rights of publicity in video games could be offered federal protection under the Lanham Act.<sup>126</sup> If courts accept that the primary purpose of video games is a commercial one, then they can conclude that any recreation of a celebrity likeness or name is therefore commercial in nature.<sup>127</sup> Consumers could perceive the appearance of the likeness as a celebrity's endorsement of the game.<sup>128</sup> This would do away with the dual treatment and ensuing confusion between unlicensed trademark use cases and right of publicity cases to create a single test under which both types of cases could be resolved.

Unfortunately, the great deference that the *Rogers* test, in its current form, gives to video game developers does not do much to protect those whose trademarks and likenesses are used without permission.<sup>129</sup> If the primary purpose of trademark law is to protect against consumer confusion,<sup>130</sup> then the *Rogers* test does not sufficiently reach that aim given popular beliefs about product placement.<sup>131</sup> An easy way to remedy this without completely overturning all prior decisions would be to continue using the *Rogers* test but to fortify its explicitly misleading prong.

---

<sup>126</sup> It is actually quite strange that the majority of the right of publicity cases discussed above do not invoke the Lanham Act and the *Rogers* test considering that *Rogers v. Grimaldi* itself centered around exactly that type of claim. See *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. 1989).

<sup>127</sup> In *Waits v. Frito-Lay, Inc.*, the Ninth Circuit explains how a celebrity's likeness used in advertisement may constitute a false endorsement of the advertised product:

A false endorsement claim based on the unauthorized use of a celebrity's identity is a type of false association claim, for it alleges the misuse of a trademark, *i.e.*, a symbol or device such as a visual likeness, vocal imitation, or other uniquely distinguishing characteristic, which is likely to confuse consumers as to the plaintiff's sponsorship or approval of the product.

978 F.2d 1093, 1110 (9th Cir. 1992) (arising from a case involving a recreated imitation of famous American singer-song writer Tom Waits's voice in an advertising campaign).

<sup>128</sup> *Id.*

<sup>129</sup> See *supra* Part III.

<sup>130</sup> Stewart & Lehman, *supra* note 9, at 4.

<sup>131</sup> See *supra* notes 109–16.

The artistic relevance prong of *Rogers* is lenient, but rightly so. “Non-zero”<sup>132</sup> relevance is extremely permissive, but the standard allows courts to make a very simple threshold determination about whether a mark adds any artistic value to the work. Any further assessment of artistic relevance is far too subjective, so increasing the standard to anything more than “non-zero” would present a significant problem in practical applications. Courts likely would have differing opinions on where to draw the line regarding what actually makes something artistically valuable and how to distinguish what meets that elevated threshold. A simple non-zero standard, in practice, allows for more consistency in applying the *Rogers* test. It keeps what would otherwise become a very gray, opinion-based decision, a binary, black-and-white determination: either a use has any amount of artistic relevance, or it has none at all.

The explicitly misleading prong, in contrast to the artistic relevance prong, provides room to guard against flagrant unlicensed mark and likeness use while still protecting the First Amendment artistic expression rights of video game developers.<sup>133</sup> To practically do this, courts must adopt several more factors in determining whether the use actually misleads as to the source of its content. Until now, courts have also applied this prong, like artistic relevance, very leniently.<sup>134</sup> Absent an affirmative statement or action from the game developer, a court will not find an unlicensed use of a mark or likeness to be explicitly misleading.<sup>135</sup> It seems this

---

<sup>132</sup> *Rogers v. Grimaldi*, 875 F.2d. 994, 999 (2d Cir. 1989) (“[U]nless [it] ... has *no artistic relevance* to the underlying work whatsoever ....”) (emphasis added).

<sup>133</sup> See *supra* notes 82–92 and accompanying text. Some of the cases against Electronic Art’s *Battlefield* series begin to show how the explicitly misleading prong may be used to protect mark holder rights. While *Textron* was settled out of court before a final verdict, that court was at least sympathetic that the use of the Bell Helicopter in that game is “sufficient to establish plausible disputes as to the existence of actual consumer confusion.” *Elec. Arts, Inc. v. Textron Inc.*, No. C 12-00118 WHA, 2012 WL 3042668, at \*5 (N.D. Cal. July 25, 2012).

<sup>134</sup> See *supra* note 85 and accompanying text.

<sup>135</sup> “To be ‘explicitly misleading,’ the defendant’s work must make some affirmative statement of the plaintiff’s sponsorship or endorsement, beyond the mere use of plaintiff’s name or other characteristic.” *Dillinger, LLC v. Electronic Arts*, No. 1:09-cv-1236-JMS-DKL, 2011 WL 2457678, at \*6 (S.D. Ind. June 16, 2011). For example, the use of “the phrase in a subtitle of ‘an authorized biography’ would be sufficiently explicit to be actionable, if false”; but, evidence that the trademark use “might implicitly suggest that the named celebrity had

standard is primarily focused on whether an unlicensed mark user *intends* to explicitly mislead consumers. Perhaps this was an adequate standard for use of a mark when *Rogers* was first decided. Today, however, given the shift in contemporary expectations for product placement and endorsement in modern media discussed in Part IV,<sup>136</sup> the presence or absence of an affirmative statement alone does not do enough to protect against video game developers explicitly misleading consumers. The standard should not be based on an unlicensed user's intent to mislead consumers, but the standard should aim to determine whether the user *actually* misled them.

Courts could use several factors in making this determination. While the factors of the original "likelihood of confusion"<sup>137</sup> test developed in *Polaroid* do not fit nicely in the context of video games, they can be looked to for inspiration. A primary consideration under the *Polaroid* test is the risk of actual consumer confusion.<sup>138</sup> As stated above, whether the use of an unlicensed mark or likeness actually misleads consumers should be the primary goal of the revised standard. The old *Polaroid* test also took into account the sophistication of consumers.<sup>139</sup> In the modern approach, this consideration can acknowledge video gamers' expectations of product placement and celebrity endorsement.

One of the new factors for the explicitly misleading prong could be transformative use.<sup>140</sup> A sufficiently transformed mark

---

endorsed the work or had a role in producing it" is "outweighed by the danger of restricting artistic expression." *Id.* (quoting *Rogers*, 875 F.2d at 999–1000).

<sup>136</sup> See *supra* Part IV.

<sup>137</sup> These factors include: (1) the strength of the prior owner's mark; (2) the degree of similarity between the marks; (3) the commercial proximity of the products; (4) the likelihood that the prior owner will bridge the gap by entering and competing in the subsequent owner's market; (5) the risk of actual consumer confusion; (6) the intent of the defendant to capitalize on the reputation of the prior owner; (7) the quality of the defendant's product, and the sophistication of consumers. *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961). All of these factors do not perfectly align with the concerns for video game cases, but some of them are still relevant. See *id.*

<sup>138</sup> See *id.*

<sup>139</sup> *Id.*

<sup>140</sup> Transformative use closely resembles "the degree of similarity between marks" factor from the likelihood of confusion test. *Id.* Transformative use has been used to address video game cases already and carries behind it the weight of the case law discussed in Part II.

or likeness is unlikely to trigger a consumer's expectation of product placement or endorsement.<sup>141</sup> A transformed mark actually satisfies both prongs of the *Rogers* test. In including a transformed mark, the game developer intends it to serve as a contextual tool to either establish an authentic and immersive virtual reality or as a parody of the unaltered mark.<sup>142</sup> Either way, the test's artistic relevance standard is very likely met. The transformed image should be enough to alert consumers that the true mark holder did not seek to endorse the video game or cross-promote through it, thus satisfying the *Rogers* explicitly misleading prong.<sup>143</sup> It follows that any finding of a sufficient transformation would then be dispositive in showing that the same use passes the *Rogers* test. The absence of a sufficient transformation, however, would not necessarily invalidate an unlicensed use if the game developer could show that it did not explicitly mislead consumers based on other factors.

Courts should also consider whether the developer made an affirmative statement of sponsorship as a factor in determining if a use satisfies the explicitly misleading prong.<sup>144</sup> Under the new *Rogers* test, an affirmative statement of sponsorship coupled with lack of permission from the mark holder would certainly fail this prong.<sup>145</sup> The absence of an affirmative statement, on the other hand, would not shut down the plaintiff's claim.<sup>146</sup> Furthermore, courts should interpret what constitutes an affirmative statement of sponsorship as more than a simple written or oral declaration. The determination should be made based on the totality of the

---

<sup>141</sup> See Rosenblatt, *supra* note 114, at 1057.

<sup>142</sup> See *id.*

<sup>143</sup> A transformed use ensures against risk of actual consumer confusion—a quintessential determination in the likelihood of confusion test. *Polaroid Corp.*, 287 F.2d at 493.

<sup>144</sup> Currently, courts consider this as the only way of determining whether a game developer using an unlicensed mark is explicitly misleading to consumers. See *supra* note 135 and accompanying text. Under the new test, this would be one of multiple considerations.

<sup>145</sup> There is no dispute here because this action would almost always indicate the video game developers' intent to deceive consumers or at the very least, extreme negligence in doing so.

<sup>146</sup> This is consistent with the likelihood of confusion test's analysis of the intent of the defendant to capitalize on the reputation of the prior owner. See *Polaroid Corp.*, 287 F.2d at 495.

circumstances. Courts must look at all of the game developer's actions that expose consumers to the unlicensed use.<sup>147</sup>

As a further factor, courts might also look at the game developer's purpose for using the mark or likeness in determining if that use is explicitly misleading. In a way, this speaks somewhat to artistic relevance, but courts should instead focus on how consumers will interpret the presence of the mark or likeness. Considerations for the factor should include whether the use is necessary in establishing the context of the video game,<sup>148</sup> whether it makes a symbolic or artistic point,<sup>149</sup> or whether it simply seeks to capitalize on the popularity of the trademark or celebrity.<sup>150</sup>

Finally, courts should look at the frequency with which the mark or likeness appears in the video game and its importance taken in the context of the game as a whole.<sup>151</sup> Infrequent and unimportant uses should not trigger the explicitly misleading prong of the *Rogers* test. This would still allow for incidental use of marks in video games.<sup>152</sup> Developers could continue to include well-known trademarks to create an immersive world without much risk of the average video game player believing that each small use of a mark represented that mark holder's involvement in the creation or promotion of that game.

Utilizing these new factors—transformative use, affirmative statement of sponsorship, purpose of use, and frequency and importance of use—as part of the *Rogers* test's explicitly misleading prong, courts can look back at the cases discussed above to achieve more uniformity in the application of a rule. Claims brought under right of publicity and trademark would all be subject to federal protection under the Lanham Act, allowing for the application of the reformed *Rogers* test in every case. *Brown* would have been

---

<sup>147</sup> Under this view, Electronic Arts's actions regarding *Battlefield 4* and *Medal of Honor*, as discussed in Part III, would certainly amount to an affirmative statement of sponsorship. See *supra* notes 88–92 and accompanying text.

<sup>148</sup> Rosenblatt, *supra* note 114, at 1057.

<sup>149</sup> *Id.*

<sup>150</sup> See *Polaroid Corp.*, 287 F.2d at 495.

<sup>151</sup> This speaks to the likelihood of confusion test's factor of commercial proximity of the products. See *supra* Part I. A frequently appearing or importantly placed mark or likeness in a video game runs a greater risk of consumers assuming the two are cross-promoting.

<sup>152</sup> See Wintermyer, *supra* note 1, at 1244.

correct in applying *Rogers*, but the court would have come to the opposite conclusion.<sup>153</sup> While there was no affirmative statement of sponsorship in that case, Brown's likeness was not substantially transformed; the purpose of using his image in the game was to capitalize on his fame and reputation as a football athlete to attract consumers to purchase the game. His appearance was also important as a playable character on the 1965 Cleveland Browns in-game. These factors tend to show that consumers would be misled by the appearance of Brown's likeness in the game. The other football cases involving NCAA players, *Keller* and *Hart*,<sup>154</sup> would undergo similar analyses under these new *Rogers* factors and also come out in favor of the football players, just as they did under the transformative-use test. *Rockstar* would also have come out the same as it did, allowing for the use of the "Pig Pen" virtual reconstruction of the "Play Pen" strip club.<sup>155</sup> However, it would have been subject to a slightly higher level of scrutiny but ultimately would have been a valid use because the substantial transformation of the parody gentlemen's club would protect against consumer confusion.

#### CONCLUSION

Both the right of publicity and trademark law strive to prevent consumer confusion by protecting a right holder's image and reputation against others who seek to take advantage of it. These rights often come to odds with the First Amendment right of freedom of expression for those who seek to reproduce the holder's mark in their work. Video games present a relatively new form of media in which these rights must be balanced. Their status as both an artistic medium and a commercial product has confused courts on which of the two tests—the transformative-use test or the *Rogers* test—properly applies to trademark claims under the Lanham Act and which applies to right of publicity claims. To further obscure the matter, courts have inconsistently applied the two tests, resulting in varying outcomes for similar claims. Courts could streamline the matter by devising a single test to apply to both types of cases. Because video games are significantly commercial

---

<sup>153</sup> See *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239–41 (9th Cir. 2013).

<sup>154</sup> See *supra* notes 55–65 and accompanying text.

<sup>155</sup> See *supra* notes 69–76 and accompanying text.

in nature and because consumers have come to expect product placement and celebrity endorsement in games, plaintiffs can bring right of publicity claims under the federal protection of the Lanham Act. This would allow for the application of the *Rogers* test in all suits over an unauthorized use of a mark or likeness. Unfortunately, the *Rogers* test in its current form is not well-suited to protect the interests of the mark holder; it is far too lenient to video game developers, allowing for unlicensed mark use. In order to better balance the rights of mark holders with the artistic expression right of game developers, courts should examine several factors when determining if an unauthorized use should be afforded First Amendment protection. These factors will reveal whether the video game creators are explicitly misleading consumers as to the source of a mark; the factors include: whether the mark has been substantially transformed, whether the developer has made an affirmative statement of sponsorship regarding the mark, the purpose of using the mark, and the frequency and importance of the mark in the context of the video game.