

No. 17-____

IN THE

Supreme Court of the United States

EMPIRE DISTRIBUTION INC.,

Petitioner,

v.

TWENTIETH CENTURY FOX TELEVISION AND
FOX BROADCASTING COMPANY,

Respondents.

**On Petition for a Writ of Certiorari to
the United States Court of Appeals
for the Ninth Circuit**

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Section 43(a) of the Lanham Act, 15 U.S.C. 1125(a)(1)(A), recognizes a cause of action for use of another's trademark that "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." The Ninth Circuit held below, however, that the Lanham Act does not apply at all to the use of another's trademark in an "expressive work" or its "promotion," no matter how much confusion is likely to occur in the marketplace.

The question presented is:

Does an implied "expressive work" exception to the Lanham Act, 15 U.S.C. 1125(a)(1)(A), excuse the use of another's trademark, including on directly competing goods and services, without regard to the likelihood of confusion among consumers?

RULE 29.6 STATEMENT

Empire Distribution Inc. has no parent corporation, and no publicly held company owns 10% or more of its stock.

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INTRODUCTION

Section 43(a) of the Lanham Act prohibits use of another’s trademark that is “likely to cause confusion” among the public. 15 U.S.C. 1125(a)(1)(A). But the Ninth Circuit held below that petitioner Empire Distribution Inc., a producer and distributor of hip hop, R&B and rap music, could not protect its trademark EMPIRE against respondent Fox entities’ use of an identical EMPIRE mark on a television show called “Empire”—about a fictionalized hip hop, R&B and rap record label called “Empire”—or against Fox’s “promotion” of the show through musical recordings, concerts and merchandise labeled “Empire.” In the Ninth Circuit’s view, all of Fox’s uses of petitioner’s EMPIRE mark—no matter how confusing and no matter if directed at the sale of competing goods and services—are protected by a so-called “expressive work” exception to section 43(a) of the Lanham Act.

The Ninth Circuit’s categorical “expressive work” exception warrants review because it conflicts with the text and purpose of the Lanham Act as well as the law of other circuits, and because it will have intolerable practical consequences. Under the Ninth Circuit’s decision, a television show called “Gianni Versace” fictionalizing the life of the late fashion designer could be used to market a “promotional” line of high-fashion clothing using the VERSACE mark, in direct competition with the Versace fashion label. A television show called “Barbie Girl” about a fictionalized doll character could be used to market a “promotional” line of dolls using the BARBIE trademark, in direct competition with the Mattel toy brand. And a television show called “Apple” about a

high-technology company could be used to market tablets and smartphones labeled APPLE, in direct competition with the Apple brand.

Nothing in the First Amendment requires that the Lanham Act be construed to afford trademark infringers such expressive latitude. The decision below and the Ninth Circuit precedents on which it relied cite the Second Circuit’s influential decision in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). But *Rogers* was not a trademark case and did not create a categorical “expressive work” exception—especially not for directly competing products sold in the same channels of commerce. That decision held merely that legendary film star and dancer Ginger Rogers could not, on grounds of deceptive association under section 43(a), stop a filmmaker from using the title “Fred and Ginger” for a film about two dancers far more hapless than Rogers and Astaire. It deemed such use permissible where the name has some artistic relevance and does not “explicitly mislead” consumers. But the Second Circuit did not abandon the ultimate Lanham Act touchstone of likelihood of confusion for trademark infringement, as post-*Rogers* decisions of the Second Circuit make clear.

The decision below thus conflicts with the Second Circuit law it purports to follow (and the law of other circuits) as to whether likelihood-of-confusion analysis always applies in Lanham Act claims, even to uses of trademarks in or in connection with “expressive works.” The Court’s review is warranted to dispel this conflict and clarify how to properly balance First Amendment concerns with the Lanham Act’s goal to prevent consumer confusion in the use of trademarks.

The decision below created an additional conflict with the Lanham Act by holding that use of another’s trademark in the title or body of an expressive work opens the door to subsequent uses on any goods or services that can be characterized as “promoting” the expressive work—even goods and services that directly compete with and create source confusion with the trademark holder’s own business. The court called this “only a minor logical extension of the reasoning of *Rogers*,” but it is in fact a quantum leap that no other court of appeals has taken. *Rogers* itself gave the Second Circuit no occasion to consider such “promotional” activities, for it was not a trademark case and the filmmaker there was not attempting to sell, say, competing FRED AND GINGER footwear. Thus, the Ninth Circuit’s unprecedented extension of its own “expressive work” exception, far from merely “exten[ding]” *Rogers*, invites the abuse of “artistic license” to exploit the consumer goodwill and brand equity built by another.

The decision warrants review, finally, because the question presented has exceptional importance to a host of creative industries, including film, television, music and high technology. These industries are heavily concentrated within the geographical boundaries of the Ninth Circuit, and are thus subject to outsized effects from that court’s incorrect interpretation of the Lanham Act. The petition should be granted.

OPINIONS BELOW

The opinion of the U.S. Court of Appeals for the Ninth Circuit is reported at 875 F.3d 1192 and is

reproduced at App. 1a-14a. The Ninth Circuit's order denying panel and *en banc* rehearing is reproduced at App. 41a-42a. The district court's opinion is available at 161 F. Supp. 3d 902 and is reproduced at App. 15a-30a. The district court's opinion denying reconsideration is available at 2016 WL 3092156 and is reproduced at App. 31a-40a.

JURISDICTION

The court of appeals denied panel and *en banc* rehearing on January 2, 2018. App. 41a. This Court has jurisdiction under 28 U.S.C. 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

U.S. Constitution, amend. I states:

Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the government for a redress of grievances.

Section 43(a) of the Lanham Act, 15 U.S.C. 1125(a)(1), states in relevant part:

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,

* * *

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

STATEMENT OF THE CASE

1. In enacting the Lanham Act in 1946, Congress intended to make “actionable the deceptive and misleading use of marks” in commerce and “to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks.” 15 U.S.C. 1127. As one court of appeals has observed, the Act’s “provisions prohibiting trademark infringement ... exist to protect consumers from confusion in the marketplace.” *Radiance Found., Inc. v. N.A.A.C.P.*, 786 F.3d 316, 321 (4th Cir. 2015) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162-164 (1995)); see also *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) (“The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.”). These protections allow mark holders “to build and benefit from the reputation of their brands” while enabling consumers to “rely on the marks to make purchasing decisions.”

Radiance Found., 786 F.3d at 321. To that end, the Act creates a cause of action against the use of a mark that is, *inter alia*, “likely to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. 1125(a)(1)(A). Further, under the Act, the Patent and Trademark Office will not approve an application for trademark registration where the mark is likely to cause confusion with a previously registered mark. *Id.* § 1052(d).

2. “The term ‘likelihood of confusion’ has long been used to describe the standard of liability for trademark infringement in actions at common law and under federal and state trademark and unfair competition statutes.” RESTATEMENT (THIRD) OF UNFAIR COMPETITION, § 20 cmt. d (1995).

Federal courts “have developed a multi-factor test to assist in the difficult determination” of whether there is a likelihood of confusion, although the “test used is not identical throughout the various federal circuits.” 4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 23:1 (5th ed. 2018 update) (“McCarthy”). The Ninth Circuit, for example, applies factors articulated in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979), including: (1) the strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant’s intent in selecting the mark; and (8) likelihood of expansion of the product lines. See also, *e.g.*, *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (similar eight-factor test).

3. Empire Distribution Inc. (“Empire”),¹ founded in 2010, “is a well-known and respected record label” and music distribution company that produces and markets music—primarily urban, hip hop, rap and R&B music—under its trademark EMPIRE. App. 4a, 17a. As of January 2016, Empire had released over 11,000 albums and singles, 6,000 music videos, and 85,000 songs, including multiple gold and platinum singles and albums, primarily in the genres of hip hop, rap and R&B music. App. 17a. Empire, which has received 12 Grammy nominations in the last two years, has worked with many famous artists, including T.I., Snoop Dogg, Kendrick Lamar, Trinidad James, Too \$hort, The Game, Mally Mall, Rich Homie Quan, Tyga, Shaggy, Busta Rhymes, Fat Joe, Sage the Gemini, Cam’ron, Jim Jones, Rocko, Gladys Knight, and Rae Sremmurd, App. 17a, as well as, most recently, Puff Daddy and 50 Cent. Empire, which has now earned over \$200 million in revenue, has spent many millions of dollars to advertise and promote its brand, using its EMPIRE mark to promote its performances and products. See Excerpts of Record, No. 16-55577 (9th Cir.), ECF No. 13, at 501-507 (“ER”). Empire also uses the handle “@EMPIRE” and hashtag “#EMPIRE” on popular social networks such as Facebook, Twitter, Instagram, SoundCloud and more, allowing it to connect online with fans of music, pop culture and entertainment. ER 508-510, 682-683. *Forbes* has

¹ For clarity, this petition uses “Empire” to refer to petitioner and “EMPIRE” to refer to its trademark, even though petitioner in its business refers to both the company and its trademark as “EMPIRE.”

lauded Empire for its innovation in the digital music marketplace, and for leading the way for the digital distribution of music.²

In January 2015, Fox premiered a television show titled “Empire,” which portrays a fictionalized hip hop, rap and R&B music label named “Empire Enterprises,” referred to as “Empire.” App. 4a, 16a. Through an agreement with Columbia Records, Fox markets and sells music featured on the show after each episode airs, as well as albums at the end of each season, through the same online distribution channels that Empire uses to market and sell its music. App. 4a; ER 526-531. As part of this business, and like Empire, Fox scouts and signs recording artists and participates in the production and distribution of music performed by its recording artists. App. 16a-17a; ER 481-489. Fox uses the name “Empire” prominently in its marketing and product packaging for this music. App. 6a-7a; ER 523-530. In addition, Fox has sold “consumer goods such as shirts and champagne glasses bearing the show’s ‘Empire’ brand.” App. 4a, 7a. And, like Empire, Fox uses the hashtag “#EMPIRE” in

² See Ogden Payne, *Empire: The Distribution Company That Turned Music Streaming Pennies Into Profit*, FORBES (Sept. 26, 2016), <https://tinyurl.com/yd88pbx2>; *BuzzAngle Music 2017 U.S. Report: A report on 2017 U.S. Music Industry Consumption*, BUZZANGLE MUSIC 98, 102 (Jan. 3, 2018), <https://tinyurl.com/y8e2lxse> (Empire among top ten overall music distributors and top three independent distributors in 2017 based on total consumption).

marketing its “Empire” show, music and products on social media. ER 525-526.

4. In March 2015, after Empire sent Fox a claim letter, Fox sued Empire seeking a declaratory judgment that Fox’s use of “Empire” on television and in music releases does not violate Empire’s trademark rights. App. 4a. Empire counterclaimed for trademark infringement, trademark dilution, unfair competition, and false advertising under the Lanham Act and California law. App. 4a.

The record developed in discovery is replete with evidence that Fox’s use of Empire’s EMPIRE mark is likely to create significant confusion in the marketplace. By the time Fox launched its show, Empire had used its mark continuously for many years, spending millions of dollars to advertise and promote its brand in commerce through national digital and traditional advertising campaigns, such that the mark had come to be known as a symbol of innovation and quality in music, and a source identifier to buyers of music and entertainment. See, *e.g.*, ER 499-516. Fox’s use of the EMPIRE mark in the title and body of its television show and on associated musical releases, CDs, and music videos (as well as on a host of other marketing-related products including t-shirts, jackets, mugs, and other apparel and accessories) is virtually identical to Empire’s use of its EMPIRE mark on its own advertisement, promotion, packaging, and sale of musical releases (as well as on its own marketing-related merchandise such as shirts, hoodies, hats, cups, pens, lighters, towels and cell phone accessories). App. 4a, 16a-17a; see also ER 507, 523-532 (detailing Fox’s extensive use of the

EMPIRE mark, including to promote artists on digital platforms), 1047-1050 (testimony from Fox).

Further, the record contains evidence of *actual* confusion among both consumers and recording artists as to whether Empire is associated with the “Empire” television series—a show about a record label named “Empire” that produces and distributes the same kind of music as Empire—and with music sold under the EMPIRE brand. ER 531-535. Compounding the problem, Fox and Empire use identical channels of trade to market the same products, including physical record stores and online music platforms such as iTunes, Google Play, Amazon, and Spotify as well as radio and online social media, placing their competing goods in close proximity. ER 523-531.

5. On summary judgment, the district court ruled in favor of Fox and dismissed all of Empire’s counterclaims. App. 29a. Specifically, applying the two *Rogers* factors, the court found that Fox uses the title “Empire” in an expressive work in a way that is “relevant to the Empire series” and does not do so “in an explicitly misleading way.” App. 29a. The court thus concluded that “Fox’s use of ‘Empire’ is protected by the First Amendment.” App. 29a. The court reached this outcome—even though “the use has caused consumer confusion”—because “[e]ven in situations where there is widespread consumer confusion, the Ninth Circuit has struck the balance in favor of protecting First Amendment expression,” and thus the court declined to “reach the issue of consumer confusion.” App. 20a, 28a-29a. The district court denied Empire’s motion for reconsideration. App. 40a.

6. The Ninth Circuit affirmed. That court held that both Fox’s “Empire” show and the songs and albums Fox sold using the “Empire” brand are expressive works subject to the *Rogers* test under prior Ninth Circuit law. App. 8a-12a. The court further reasoned that, while Fox’s uses of “Empire” to market and sell music and other products “technically fall outside the title or body of an expressive work, it requires only a minor logical extension of the reasoning of *Rogers* to hold that works protected under its test may be advertised and marketed by name.” App. 7a. The court was unconcerned that its holding allows a defendant’s marketing activities to serve as a pretext for trading on another’s goodwill, insisting that, in this case, “Fox’s promotional activities, including those that generate revenue, are auxiliary to the television show and music releases.” App. 7a.

Having found that all of Fox’s uses met the two *Rogers* factors, the Ninth Circuit declined to assess Fox’s use of EMPIRE for any likelihood of consumer confusion, holding that such a test plays no role:

If the use of a mark is artistically relevant to the underlying work, the Lanham Act does not apply “unless the title explicitly misleads as to the source or the content of the work.” [*Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002)] (quoting *Rogers*, 875 F.2d at 999) (internal quotation mark omitted). Empire Distribution argues that the “relevant inquiry ... is whether the defendant’s use of the mark would confuse consumers as to the source, sponsorship or content of the work.” But

this test conflates the second prong of the *Rogers* test with the general *Sleekcraft* likelihood-of-confusion test, which applies outside the *Rogers* context of expressive works.

App. 12a. The court concluded that Fox’s use of EMPIRE was not explicitly misleading because it did not “contain[] [any] overt claims or explicit references to Empire Distribution”—notwithstanding that the parties’ competing uses of EMPIRE, and not “Empire Distribution,” were at issue. App. 12a. The court also held that its analysis resolved Empire’s other Lanham Act claims for trademark dilution, false advertising and unfair competition. App. 4a-5a.

The court of appeals denied Empire’s petition for panel and *en banc* rehearing. App. 42a.

REASONS FOR GRANTING THE WRIT

I. REVIEW IS WARRANTED BECAUSE THE DECISION BELOW CONFLICTS WITH THE LANHAM ACT AND DEEPENS A SPLIT AMONG THE COURTS OF APPEALS

The decision below cannot be reconciled with the text of section 43(a) of the Lanham Act, which creates a cause of action for use of another’s trademark that “is likely to cause confusion.” 15 U.S.C. 1125(a)(1)(A). Moreover, it deepens an existing circuit split regarding whether the Lanham Act’s core concern with likelihood of confusion applies at all to the use of another’s mark in an “expressive work.” This Court’s intervention is needed to dispel this conflict.

**A. The Decision Below Conflicts With
The Text And Purpose Of Section
43(a) Of The Lanham Act**

Section 43(a) of the Lanham Act makes actionable any use of a mark in commerce that is “likely to cause confusion.” 15 U.S.C. 1125(a)(1)(A). Thus, pursuant to the plain text of the statute, the lower courts must undertake a likelihood-of-confusion analysis to determine whether the conduct at issue is actionably infringing and thus violates the Act.

Despite noting that “the only threshold requirement for the *Rogers* test is an attempt to apply the Lanham Act to First Amendment expression,” the Ninth Circuit did not “attempt” to apply the Lanham Act at all. App. 9a. To the contrary, the court held that the use of a mark in the title or body of an expressive work renders the Lanham Act inapplicable. See App. 5a. (“In general, claims of trademark infringement under the Lanham Act are governed by a likelihood-of-confusion test”; when the use “is in the title of an expressive work, however, we *instead* apply” *Rogers*) (emphasis added). Accordingly, the Ninth Circuit did not conduct *any* likelihood-of-confusion analysis, instead limiting its inquiry to “the *Rogers* test,” which it interpreted to hold that use of another’s mark as part of the title or body of an expressive work “does not violate the Lanham Act” unless the use lacks any artistic relevance or is “explicitly mislead[ing].” App. 6a.

This holding conflicts with the plain text of the statute. Section 43(a) contains no exception for the use of a mark in “expressive works” unless the use is artistically irrelevant or “explicitly misleading”; rather, it asks whether a use is “likely to cause

confusion.” 15 U.S.C. 1125(a)(1)(A). While *Rogers* provides guidance as to the competing values that courts should consider, it does not supersede the statute’s text by entirely removing consideration of likely confusion. As the leading treatise explains:

Application of the *Rogers* balancing test is just that: a balancing of competing interests. It does not mean that a junior user producer of an expressive work can ignore a senior user and create probable confusion just because the title has some “artistic relevance” to the accused expressive work and the junior user does not falsely assert that there is an affiliation. ... The *Rogers* test does not mean that the producer of an expressive work gets a free pass to confuse the public.

2 McCarthy § 10:17.10; cf. *Parks v. LaFace Records*, 329 F.3d 437, 447 (6th Cir. 2003) (“the First Amendment cannot permit anyone who cries ‘artist’ to have *carte blanche* when it comes to naming and advertising his or her works, art though it may be”).

The Ninth Circuit’s own reinterpretation of the *Rogers* test, in contrast, departs from the Lanham Act’s statutory language by effectively immunizing all uses of a mark in relation to an expressive work from trademark infringement at the threshold, without inquiry into likelihood of confusion. The Ninth Circuit’s test thus allows second comers to use a mark in a manner that *is* “likely to cause confusion,” as long as that use has minimal artistic relevance and is not “explicitly misleading.” The decision below, for example, holds inapplicable to an “expressive work” any consideration of the degree to

which the plaintiff's and the defendant's goods will compete (in the language of *Sleekcraft*, 599 F.2d at 348, the "proximity" of the goods), a factor that often increases the likelihood of consumer confusion as to source. Under the Ninth Circuit's approach, a junior user in the "expressive work" context is free to cause as much confusion in the marketplace as it likes, as long as the use is not "explicitly misleading" as to source. See App. 12a ("explicitly misleading" requires "overt claims" about or "explicit reference" to petitioner.). The Ninth Circuit's purported application of *Rogers*, therefore, cannot be reconciled with the text of the Lanham Act.

The Ninth Circuit compounded this problem by extending its interpretation of *Rogers* to Fox's separate commercial activities "promoting" its "Empire" television show through the creation and distribution of merchandise, including *directly competing musical performances and releases* under the brand "EMPIRE." The Ninth Circuit failed to note that these are uses of the EMPIRE mark separate from the television show that are independently likely to cause significant, widespread confusion.³ The deci-

³ Moreover, the Ninth Circuit took no account of the lesser First Amendment protection that may attach to marketing and promotional activities that, unlike the expressive work itself, are commercial in nature. See, e.g., *Facenda v. NFL Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008) (describing as "commercial speech rather than artistic expression" the NFL's use of a narrator's voice without authorization in the film "The Making of Madden NFL 06," a film made about the creation of a video game for the purpose of promoting and selling the video game).

sion below thus presents an additional conflict with the text and purpose of section 43(a) of the Lanham Act by construing it to contain not only an “expressive works” exception, but also an expressive “marketing” exception.

The expansion of such a judicially created exception for “expressive works” is particularly dubious in light of the fact that, where Congress wished to create “expressive” exceptions to the Lanham Act, it said so. For example, 15 U.S.C. 1125(c), which addresses trademark dilution in the very same section as trademark infringement, contains express “exclusions” for “[a]ny fair use” other than as a designation of source, including for “identifying and parodying, criticizing, or commenting upon” a famous mark or for comparative advertising; “[a]ll forms of news reporting and news commentary”; and “[a]ny non-commercial use of a mark.” 15 U.S.C. 1125(c)(3)(A)-(C); see also *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 114 (2004) (recognizing that 15 U.S.C. 1115(b)(4) provides a “statutory affirmative defense of fair use”). In light of such explicit exemptions, Congress’s comparative silence on an exception for “expressive works” and their supposed “promotional” penumbras may be presumed to have been intentional. See, e.g., *Bruesewitz v. Wyeth LLC*, 562 U.S. 223, 232-233 (2011) (applying canon of *expressio unius, exclusio alterius* where statute addressed certain grounds and was silent on others).

Thus, the court of appeals disregarded the statutory language of section 43(a) of the Lanham Act by declining even to consider the likelihood of consumer confusion resulting from Fox’s use of Empire’s EMPIRE mark.

B. The Decision Below Conflicts With The Decisions Of Other Circuits

The decision below also warrants review because it furthers an already-existing circuit split. In particular, while the Second and Fifth Circuits treat First Amendment considerations as an aspect of the requisite likelihood-of-confusion analysis, the Ninth Circuit treats “expressive” use as obviating *any* application of the Lanham Act’s likelihood-of-confusion analysis at all. The decision below is also in tension on this score with decisions of the Seventh and Eighth Circuits. This Court’s intervention is warranted to dispel these conflicts.

1. The Second and Fifth Circuits hold that, in evaluating whether an “expressive” work’s use of another’s trademark is infringing, a court still must consider whether the use is “likely to cause confusion,” even if the likelihood of confusion must be particularly compelling to account for potential First Amendment concerns.⁴

In *Rogers*, 875 F.2d 994, a false advertising action in which Ginger Rogers sued a filmmaker over the title of the film “Fred and Ginger,” the Second Circuit reasoned that the Lanham Act “should be

⁴ This is consistent with this Court’s prior approach to assessing likelihood of confusion. In *KP Permanent Make-Up*, for example, the Court recognized, in assessing a statutory fair use defense, that “some possibility of consumer confusion must be compatible with fair use.” 543 U.S. at 121. But such an approach requires at least some consideration of the possibility of, and extent of, consumer confusion.

construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* at 999. The court concluded that this “balance will *normally* not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.” *Id.* (emphasis added). That being said, the court noted that “[t]he purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product.” *Id.* at 997.⁵

Later Second Circuit decisions confirm that the *Rogers* factors are interpreted in that court as, at most, a rule of thumb or presumption in favor of use of trademarks in expressive works, and not the source of a rigid rule or blanket immunity for such use without regard to likelihood of confusion. In *Twin Peaks Productions, Inc. v. Publications International, Ltd.*, 996 F.2d 1366, 1370 (2d Cir. 1993), for example, the plaintiff—the owner of the trademark TWIN PEAKS in connection with the television series of the same name—alleged that the title of the defendant’s book, *Welcome to Twin Peaks: A Complete Guide to Who’s Who and What’s What*, was infringing. Using *Rogers* as a guide, the Second

⁵ *Rogers* also contains a footnote explaining that its test “would not apply to misleading titles that are confusingly similar to other titles [because the] public interest in sparing consumers this type of confusion outweighs the slight public interest in permitting authors to use such titles.” 875 F.2d at 999 n.5.

Circuit accepted that the title had “some artistic relevance” and proceeded to determine “whether the title is misleading in the sense that it induces members of the public to believe the Book was prepared or otherwise authored by” the plaintiff. *Id.* at 1379. To assess this, the Second Circuit ruled:

This determination must be made, in the first instance, by application of the venerable *Polaroid* factors. However, the finding of likelihood of confusion must be particularly compelling to outweigh the First Amendment interest recognized in *Rogers*.

Id. (citation omitted). That is, even where an expressive work is at issue, the likelihood-of-confusion factors and analysis remain the hallmark, although the threshold for finding liability will be more exacting. Thus, the Second Circuit specifically directed the district court on remand “to fully examine the factors relevant to the likelihood of confusion” so that it could “determine whether the likelihood of confusion was so great as to overcome the presumption of *Rogers*.” *Id.*⁶ See also *Cliffs*

⁶ The Second Circuit provided several reasons for “careful application” of the likelihood-of-confusion factors in light of *Rogers*, including: (1) the possible effect of a disclaimer on the cover; and (2) the possible effect of the imagery accompanying a word mark. See *Twin Peaks*, 996 F.2d at 1379-1380 (“It’s a fair question whether a title *that might otherwise be permissible under Rogers* violates the Lanham Act when displayed in a manner that conjures up a visual image prominently associated with the word bearing the mark that was copied.”) (emphasis added).

Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc., 886 F.2d 490, 495 & n.3 (2d Cir. 1989) (traditional likelihood-of-confusion factors apply to Lanham Act claims against titles of expressive works, although “the *Polaroid* factors should be applied with proper weight given to First Amendment concerns,” and a court should “tak[e] into account that somewhat more risk of confusion is to be tolerated”).

The Fifth Circuit—expressly adopting *Twin Peaks*—uses the same approach, instructing that, when considering an expressive work, “the court should determine whether plaintiff has demonstrated ‘particularly compelling’ evidence indicating that consumers are likely to confuse the title of defendants’ book with [plaintiff’s] mark.” *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 270 (5th Cir. 1999) (citing *Twin Peaks*, 996 F.2d at 1379). In *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 661 (5th Cir. 2000), for example, the owner of the Ralph Lauren POLO trademark brought Lanham Act claims against the publisher of POLO Magazine, which was about the sport of polo. After discussing *Rogers*, the court explained that, even though the magazine title had artistic relevance and was not explicitly misleading, the court still would “appl[y] the likelihood of confusion test,” but “the likelihood of confusion must be ‘particularly compelling’ to outweigh the First Amendment interests at stake.” *Id.* at 664-665 (quoting *Twin Peaks*, 996 F.2d at 1379). The court ultimately ruled that the magazine’s use of the POLO mark *was* infringing, even if the use was artistically relevant and not explicitly misleading. *Id.* at 668. In other words, the court found infringement notwithstanding that both *Rogers* factors were satisfied.

Other circuits, while not directly addressing *Rogers* in the context of a trademark infringement claim, are consistent with the approaches of the Second and Fifth Circuits in applying likelihood-of-confusion analysis to parodic uses of trademarks. In *Anheuser-Busch, Inc. v. Balducci Publications*, 28 F.3d 769, 773, 775-776 (8th Cir. 1994), for example, the Eighth Circuit applied likelihood-of-confusion analysis to the defendant's use of the plaintiff's trademark in a parody, concluding that, in the context of a confusing parody, "we are convinced that the First Amendment places no bar to the application of the Lanham Act." See *id.* at 777 (parody "is vulnerable under trademark law since the customer is likely to be confused"); see also *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 401-402 (8th Cir. 1987) (applying likelihood-of-confusion analysis to parody and finding infringement). Similarly, in *Nike, Inc. v. "Just Did It" Enterprises*, 6 F.3d 1225, 1227-1233 (7th Cir. 1993), the Seventh Circuit recognized that, in reviewing a parodic use of a trademark, "[t]he ultimate question ... is whether [defendant's] goods confuse customers. Parodies do not enjoy a dispensation from this standard." *Id.* at 1228; cf. *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 970 (10th Cir. 1996) (suggesting that the Lanham Act's requirement of proof of likelihood of confusion is "a built-in mechanism[] that serve[s] to avoid First Amendment concerns").

2. In contrast, the Ninth Circuit has repeatedly held that, if an expressive work satisfies both *Rogers* factors (that it possesses at least minimal artistic relevance and is not explicitly misleading), then *any* likelihood of confusion—no matter how great, no matter the circumstances—is irrelevant and the

Lanham Act has no application. The decision below, for example, held that, where the allegedly infringing use is part of an “expressive work,” the court does not assess the use for a likelihood of confusion, but “instead” applies the *Rogers* test. App. 5a. Indeed, it specifically stated that the “*Sleekcraft* likelihood-of-confusion test ... applies *outside* the *Rogers* context of expressive works.” App. 12a (emphasis added).

This decision in this respect followed earlier Ninth Circuit precedent that long jettisoned the application of likelihood-of-confusion analysis to expressive works. See, e.g., *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013) (“§ 43(a) *will not be applied* to expressive works” that satisfy both *Rogers* elements) (emphasis added); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (holding likelihood-of-confusion analysis inapplicable to use of Mattel’s BARBIE mark in the title of the musical recording “Barbie Girl” because “literary titles *do not* violate the Lanham Act” whenever they satisfy both *Rogers* elements) (emphasis added).

These differing treatments of expressive works are material: In the Second and Fifth Circuits, for example, the use of another’s mark in an expressive work, even if it has artistic relevance and is not expressively misleading, may be infringing if there is a sufficiently compelling showing of a likelihood of confusion. In the Ninth Circuit, however, that same use can never be infringing as a matter of law, no matter how compelling the proof of likelihood of confusion may be, because that court’s implied First Amendment exception to the Lanham Act presents

an absolute threshold barrier to the Lanham Act's application.⁷

In sum, the *Rogers* analysis, dating back to 1989, has evolved across the courts of appeals in conflicting fashion. This Court has never adjudicated the scope of this judicially created exception to the Lanham Act. Now that the Ninth Circuit has expanded its judicial exception to swallow the statutory rule by holding that an alleged infringer's sale of *directly competing goods* can be excused as a "minor logical extension" of *Rogers*, this Court's intervention is urgently needed.

II. THE QUESTION PRESENTED IS EXCEPTIONALLY IMPORTANT TO A HOST OF CREATIVE INDUSTRIES

For all the reasons set forth above, certiorari is warranted so that the Court may adopt a uniform standard for the federal courts to apply when faced with claims that an allegedly infringing mark has been used in an expressive work and associated marketing activities. The petition also should be

⁷ In taking such a categorical approach, the decision below also disregarded that the appropriate balance between First Amendment freedom and consumer protection may vary with the type of expressive use. For example, a parodic use of a trademark that refers to or comments on the mark might well be given more "leeway" than a use that does not comment on the mark and is used "to sell a competing product." *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812-813 (2d Cir. 1999). Fox makes no such reference to or comment on Empire's own mark here.

granted because the proper balance between trademark rights under the Lanham Act and First Amendment concerns has great practical importance, especially to the many creative industries including television, film, music and high technology that are heavily concentrated in the Ninth Circuit. This issue of whether the use of a mark in a title is exempt from Lanham Act likelihood-of-confusion analysis is all the more urgent in today's digital age, where shorthand hashtags and online identities like #EMPIRE and @EMPIRE are a principal vehicle for marketing creative works.

Under the decision below, a business in the Ninth Circuit that enters a marketplace through initial use of a mark for "First Amendment expression" is then free to seize a senior user's goodwill and brand equity by selling directly competing goods to the same customers in the same channels of trade using the senior user's own trademark. App. 28a. The Ninth Circuit's supposed "minor logical extension" of *Rogers* (App. 7a) thus in fact creates a gaping hole in the scope of traditional trademark protection.

For example, Fox's sister network, FX, recently aired a show about assassinated fashion designer Gianni Versace, founder of the eponymous clothing line trademarked VERSACE. See VERSACE, Reg. No. 2,121,984 (federal trademark registration for clothing) (Dec. 16, 1997). FX prominently uses the mark VERSACE in the show's advertising.⁸ Under the reasoning of the decision below, it would be only

⁸ See, e.g., @americancrimestoryfx, INSTAGRAM (Dec. 5, 2017), <https://tinyurl.com/yaclj3bn>.

a “minor logical extension” for FX to now sell and market high-fashion clothing under the VERSACE mark in direct competition with the Versace label, ostensibly to “promote” the television series, without any consequence under the Lanham Act. Further, under the Ninth Circuit’s decision, such a use would not be “explicitly misleading” as long as FX makes no express claim to be speaking on behalf of Gianni Versace S.p.A. See App. 12a (reasoning that Fox’s use of EMPIRE was not “explicitly misleading” because it made no express reference to petitioner itself).

The Ninth Circuit’s requirement of minimal “artistic relevance” provides no meaningful limitation on this dangerous new avenue for unfair competition. The decision below implausibly found that “Fox used the common English word ‘Empire’ for artistically relevant reasons: the show’s setting is New York, the Empire State, and its subject matter is a music and entertainment conglomerate, ‘Empire Enterprises,’ which is itself a figurative empire.” App. 10a. By that logic, a television producer could launch a television show with the title “Apple” about a computer and technology company located in New York City, include tablets and smartphones on the show (referred to as “Apple” products), and then promote the show by selling tablets and smartphones under the designation APPLE and use the social media handle @apple and hashtag #apple, and be fully protected by the First Amendment, regardless of confusion with Apple Inc., because “apple” is a “common English word” and the depicted company is located in the “Big Apple.” See APPLE, Reg. No. 3,928,818 (federal trademark registration for, *inter alia*, computers and mobile phones) (Mar. 8, 2011).

Similarly, a television producer could launch a show called “Capitol” about a storied record label, include music on the show, and then promote the show by selling musical recordings under the brand CAPITOL and using the Twitter handle @capitol and the hashtag #capitol, all without infringing the Capitol Records’ CAPITOL mark, because “capitol” is a “common English word” and the depicted record label is at the “capitol” of its profession. See CAPITOL, Reg. No. 4,264,800 (federal trademark registration for musical sound recordings and related merchandise, online sales and websites) (Dec. 25, 2012). Such consequences would be avoided if courts assessing Lanham Act claims were required to determine whether a use is “likely to cause confusion,” even while considering countervailing concerns about expressive freedom.

The practical consequences of the Ninth Circuit’s expansive exception to trademark protection are exponentially greater in a world in which consumers increasingly rely on “hashtags” and social media “handles” (*i.e.*, usernames or profile names that appear in the URL of a webpage) and other forms of digital branding to search for, identify, and connect with merchants. Social media networks such as Twitter, Facebook and Instagram are now primary avenues for individuals to communicate with one another and for merchants to communicate with their customers. Merchants—particularly those marketing popular culture—must out of necessity extend the use of their trademarks beyond traditional advertising and product packaging, and use their trademarks *as* hashtags and handles, maximizing the source-identifying function of their marks on digital platforms.

The facts of this case are illustrative. Today music is heavily marketed through digital distribution channels such as Apple Music, Spotify and Google Play, and record labels use social media platforms extensively to promote their brands.⁹ Empire, in particular, has been praised for its industry-leading focus on digital music distribution and revolutionary approach in the digital marketplace since its founding in 2010.¹⁰ The Ninth Circuit’s decision, however, allows Fox to enter the scene and compete on the same turf using the same EMPIRE mark.

And while “#EMPIRE” was once associated with Empire on social media platforms, a search for content tagged “#EMPIRE” now leads to competing content published by both Fox and Empire in connection with their directly competing goods (and, in several promotions, returns imagery associated with Fox’s show instead of Empire’s logo or artwork).¹¹ In

⁹ See, e.g., Sarah Perez, *On-demand Streaming Now Accounts for the Majority of Audio Consumption, says Nielsen*, TECH CRUNCH (Jan. 4, 2018), <https://tinyurl.com/y76fc7wk> (noting that “[o]n-demand audio streaming now accounts for 54 percent of total audio consumption”).

¹⁰ See Payne, *supra* note 2.

¹¹ See, e.g., ER 525-526 (declaration of Empire’s CEO describing how Empire has “received hundreds of tweets referring to Fox’s Empire, many of which reference” both Empire’s and Fox’s respective Twitter accounts, and how whenever a user tweets the hashtag #EMPIRE, “symbols representing the Empire Series automatically appear, regardless of whether or not the user is talking about our EMPIRE label or the Empire series”).

other words, Empire has been displaced from controlling the hashtag of its own senior mark. Fox also uses the word “empire” in its social media handles (and therefore in URLs of its social media pages), weakening the utility of a handle to identify Empire’s brand. Fox, whose Twitter and Facebook handle is “@EmpireFOX,” named its profiles on those sites simply “Empire,” and applied for and received from both Twitter and Facebook identity verification for its claimed “name”—*i.e.*, a checkmark that appears next to its use of the “Empire” name to signify that it is the authentic and authoritative account:



Further, today's digitalization of yesterday's record store now puts Fox and Empire side by side in the digital marketplace. Whereas in traditional, physical record stores, the two brands might have been at least at separate ends of the hip hop music aisle, or perhaps even on different aisles altogether, digital music stores and distribution platforms including Apple, Spotify, and YouTube place the brands side by side (largely based on keywords), such as on hip hop charts, playlists, profiles and in search results, as depicted in the below search for "empire" on iTunes:



See also ER 526-528 (examples of Empire's and Fox's music offered side by side).

The issue of whether the Lanham Act categorically exempts use of a mark in an expressive work's title and associated uses is thus of essential commercial importance to the music industry, as

well as to other creative industries. As *Rogers* itself recognized, its presumption in favor of “expressive” use “would not apply to misleading titles that are confusingly similar to other titles” because “[t]he public interest in sparing consumers this type of confusion outweighs the slight public interest in permitting authors to use such titles.” 875 F.2d at 999 n.5. The decision below dismissed that important qualification in *Rogers* as merely a rarely cited “footnote” and suggested that the trademark holder’s interests are adequately protected because even a use in an expressive work may not “explicitly mislead[] as to the source or the content of the work.” App. 8a (quoting *Mattel*, 296 F.3d at 902 (quoting *Rogers*, 875 F.2d at 999)). In today’s digital environment, however, Fox may create great consumer confusion simply by using Empire’s mark EMPIRE even if Fox does not falsely say “brought to you by Empire Distribution Inc.,” as the Ninth Circuit’s “explicitly misleading” test would require.

Definitive resolution of this issue is particularly important for creative industries such as film, music, television and high technology, which are heavily concentrated within the Ninth Circuit and will be subject to outsized effects from that court’s incorrect interpretation of the Lanham Act.¹²

¹² See Kenneth A. Matuszewski, *Casting Out Confusion: How Exclusive Appellate Jurisdiction in the Federal Circuit Would Clarify Trademark Law*, 18 W. MICH. U. COOLEY J. PRAC. & CLINICAL L. 31, 58 & table 4 (2016) (observing that Ninth Circuit handled nearly twice as many appeals from trademark cases in 2014-2015 than court of appeals with next highest number).

Accordingly, this Court should decide the highly consequential question whether likelihood-of-confusion analysis applies to all Lanham Act section 43(a) claims, even where an initial use is purportedly “expressive.”

CONCLUSION

The petition should be granted.

Respectfully submitted,
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APPENDIX

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APPENDIX A

FOR PUBLICATION

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

No. 16-55577

D.C. No. 2:15-cv-02158-PA-FFM

TWENTIETH CENTURY FOX TELEVISION, a division
of Twentieth Century Fox Film Corporation;
FOX BROADCASTING COMPANY,

Plaintiffs-Appellees,

v.

EMPIRE DISTRIBUTION, INC.,

Defendant-Appellant.

Appeal from the United States District Court for the
Central District of California Percy Anderson,
District Judge, Presiding

Argued and Submitted October 3, 2017
Pasadena, California

Filed November 16, 2017

Before: DIANA GRIBBON MOTZ,* MILAN D. SMITH,
JR., and JACQUELINE H. NGUYEN, Circuit Judges.

Opinion by Judge Milan D. Smith, Jr.

OPINION

SUMMARY**

Lanham Act / First Amendment

Affirming the district court’s summary judgment in favor of Twentieth Century Fox Television and Fox Broadcasting Company, the panel held that Fox’s use of the name “Empire” was protected by the First Amendment, and was therefore outside the reach of the Lanham Act.

Fox sought a declaratory judgment that its television show titled *Empire* and associated music releases did not violate the trademark rights of record label Empire Distribution, Inc. Empire counterclaimed for trademark infringement and other causes of action.

The panel explained that when an allegedly infringing use is in the title or within the body of an expressive work, the *Rogers* test is used to determine whether the Lanham Act applies. The panel held that

* The Honorable Diana Gribbon Motz, United States Circuit Judge for the U.S. Court of Appeals for the Fourth Circuit, sitting by designation.

** This summary constitutes no part of the opinion of the court. It has been prepared by court staff for the convenience of the reader.

the *Rogers* test applied to Fox’s use of the mark “Empire.” The panel concluded that the first prong of the test was satisfied because it could not say that Fox’s use of the mark had no artistic relevance to the underlying work; rather, the title *Empire* supported the themes and geographic setting of the work. The second prong of the test also was satisfied because the use of the mark “Empire” did not explicitly mislead consumers.

COUNSEL

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OPINION

M. SMITH, Circuit Judge:

Empire Distribution, Inc. appeals the district court’s grant of summary judgment in favor of Twentieth Century Fox Television and Fox Broadcasting Company (collectively, Fox). Empire Distribution argues that the district court erred substantively and procedurally in holding that Fox’s use of the name “Empire” was protected by the First Amendment, and was therefore outside the reach of the Lanham Act, ch. 540, 60 Stat. 441 (1946) (codified as amended at 15 U.S.C. § 1125). We disagree, and affirm.

FACTUAL AND PROCEDURAL BACKGROUND

Empire Distribution, founded in 2010, is a well-known and respected record label that records and releases albums in the urban music genre, which includes hip hop, rap, and R&B. Empire Distribution has released many albums by established and lesser-known artists as well as music compilations with titles such as *EMPIRE Presents: Ratchet Music*, *EMPIRE Presents: Yike 4 Life*, and *EMPIRE Presents: Triple X-Mas*.

In 2015, Fox premiered a television show titled *Empire*, which portrays a fictional hip hop music label named “Empire Enterprises” that is based in New York. The show features songs in every episode, including some original music. Under an agreement with Fox, Columbia Records releases music from the show after each episode airs, as well as soundtrack albums at the end of each season. Fox has also promoted the *Empire* show and its associated music through live musical performances, radio play, and consumer goods such as shirts and champagne glasses bearing the show’s “Empire” brand.

In response to a claim letter from Empire Distribution, Fox filed suit on March 23, 2015, seeking a declaratory judgment that the *Empire* show and its associated music releases do not violate Empire Distribution’s trademark rights under either the Lanham Act or California law. Empire Distribution counter-claimed for trademark infringement, trademark dilution, unfair competition, and false advertising under the Lanham Act and California law, and sought both injunctive and monetary relief. Fox moved for summary judgment, and Empire Distribution’s opposition to Fox’s motion included a request for a continuance under Federal Rule of Civil Procedure 56(d) in order

to complete discovery. On February 1, 2016, the district court denied Empire Distribution's request, and granted summary judgment to Fox on all claims and counterclaims. Empire Distribution moved for reconsideration, which was denied. Empire Distribution timely appealed.

JURISDICTION AND STANDARD OF REVIEW

We have jurisdiction pursuant to 28 U.S.C. § 1291. “We review a district court’s decision to grant summary judgment de novo, considering all facts in dispute in the light most favorable to the nonmoving party.” *Glenn v. Washington Cty.*, 673 F.3d 864, 870 (9th Cir. 2011).

ANALYSIS

In general, claims of trademark infringement under the Lanham Act are governed by a likelihood-of-confusion test. *See Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002). When the allegedly infringing use is in the title of an expressive work, however, we instead apply a test developed by the Second Circuit in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), to determine whether the Lanham Act applies. *Mattel*, 296 F.3d at 902.¹ Like the Second Circuit, we have identified two rationales for treating expressive works differently from other covered works: because (1) they implicate the First Amendment right of free speech, which must be balanced against the public interest in avoiding consumer confusion; and

¹ As we noted in *Mattel*, the *Rogers* test is a limiting construction of the Lanham Act. 296 F.3d at 901 (quoting *Rogers*, 875 F.2d at 999). The parties have offered no arguments in this appeal concerning the state law claims and counterclaims in their pleadings, and we thus have no occasion to address whether the *Rogers* test applies to any state laws.

(2) consumers are less likely to mistake the use of someone else's mark in an expressive work for a sign of association, authorship, or endorsement. *See Rogers*, 875 F.2d at 997–1000; *Mattel*, 296 F.3d at 900, 902.

Under the *Rogers* test, the title of an expressive work does not violate the Lanham Act “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.” *Mattel*, 296 F.3d at 902 (internal quotation marks omitted) (quoting *Rogers*, 875 F.2d at 999). We have extended this test from titles to allegedly infringing uses within the body of an expressive work. *See E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008).

DOES THE *ROGERS* TEST APPLY TO FOX'S USE OF THE MARK “EMPIRE?”

We must first determine whether the *Rogers* test applies to Fox's use of the mark “Empire.” We decide this legal question de novo. *See Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1240–41 (9th Cir. 2013).

Empire Distribution argues that at least some of Fox's uses of the mark “Empire” fall outside the title or body of an expressive work, and therefore outside the scope of the *Rogers* test. The *Empire* television show itself is clearly an expressive work, *see Charles v. City of Los Angeles*, 697 F.3d 1146, 1151–52 (9th Cir. 2012), as are the associated songs and albums, *see Mattel*, 296 F.3d at 902, but Empire Distribution asserts that Fox's use of the mark “Empire” extends well beyond the titles and bodies of these expressive works. Specifically, Empire Distribution points to Fox's use of the “Empire” mark “as an umbrella brand

to promote and sell music and other commercial products.” These promotional activities under the “Empire” brand include appearances by cast members in other media, radio play, online advertising, live events, and the sale or licensing of consumer goods.

Although it is true that these promotional efforts technically fall outside the title or body of an expressive work, it requires only a minor logical extension of the reasoning of *Rogers* to hold that works protected under its test may be advertised and marketed by name, and we so hold. Indeed, the *Rogers* case itself concerned both a movie with an allegedly infringing title and its advertising and promotion, although the majority opinion did not deal separately with the latter aspect. *See Rogers*, 875 F.3d at 1005 (Griesa, J., concurring in the judgment). The balance of First Amendment interests struck in *Rogers* and *Mattel* could be destabilized if the titles of expressive works were protected but could not be used to promote those works. In response, Empire Distribution raises the specter of a pretextual expressive work meant only to disguise a business profiting from another’s trademark, but the record in this case makes clear that the *Empire* show is no such thing. Fox’s promotional activities, including those that generate revenue, are auxiliary to the television show and music releases, which lie at the heart of its “Empire” brand.

Empire Distribution also claims that Fox’s uses of the “Empire” mark fall within the Lanham Act due to a footnote in *Rogers*, which stated that *Rogers*’ “limiting construction would not apply to misleading titles that are confusingly similar to other titles [because the] public interest in sparing consumers this type of confusion outweighs the slight public interest in permitting authors to use such titles.” 875 F.2d

at 999 n.5. This footnote has been cited only once by an appellate court since *Rogers*, in a case in which the Second Circuit itself rejected its applicability and applied the *Rogers* test. See *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 494–95 (2d Cir. 1989). The exception the footnote suggests may be ill-advised or unnecessary: identifying “misleading titles that are confusingly similar to other titles” has the potential to duplicate either the likelihood-of-confusion test or the second prong of *Rogers*, which asks whether a title “explicitly misleads as to the source or the content of the work.” *Mattel*, 296 F.3d at 902 (quoting *Rogers*, 875 F.2d at 999). More importantly, it conflicts with our precedents, which “dictate that we apply the *Rogers* test in [Lanham Act] § 43(a) cases involving expressive works.” *Brown*, 724 F.3d at 1241–42. We therefore examine Fox’s use of the “Empire” mark under that test.

APPLYING THE *ROGERS* TEST

I

Under the two prongs of the *Rogers* test, “the Lanham Act should not be applied to expressive works ‘unless the [use of the trademark or other identifying material] has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the [trademark or other identifying material] explicitly misleads as to the source or the content of the work.’” *Brown*, 724 F.3d at 1242 (alterations in original) (quoting *Rogers*, 875 F.2d at 999). In addition to these two prongs, Empire Distribution argues that the *Rogers* test includes a threshold requirement that a mark have attained a meaning beyond its source-identifying function.

What Empire Distribution identifies as a threshold requirement is merely a consideration under the first prong of the *Rogers* test. Trademark suits often arise when a brand name enters common parlance and comes to signify something more than the brand itself, but we apply the *Rogers* test in other cases as well. In *Mattel*, we noted that some trademarks, such as Rolls-Royce or Band-Aid, “enter our public discourse and become an integral part of our vocabulary.” 296 F.3d at 900. The ordinary likelihood-of-confusion test provides insufficient protection against a trademark owner’s ability to control public discourse in these cases—but not *only* in these cases. *Mattel* focused on these examples, in which “the mark (like Rolls Royce) has taken on an expressive meaning apart from its source-identifying function,” as part of a larger class of cases in which “a trademark owner asserts a right to control how we express ourselves.” *Id.*² In other words, the only threshold requirement for the *Rogers* test is an attempt to apply the Lanham Act to First Amendment expression.

Of course, the cultural significance of a mark may often be relevant to the first prong of the *Rogers* test. Trademarks that “transcend their identifying purpose,” *id.*, are more likely to be used in artistically relevant ways. For example, at issue in *Mattel* was a song titled “Barbie Girl,” which poked fun at the shallow materialism identified with Mattel’s trademarked Barbie brand of dolls. *Id.* at 899, 901. Barbie’s

² Empire Distribution’s argument for a threshold requirement is also belied by the example given in *Mattel* of “a painting titled ‘Campbell’s Chicken Noodle Soup,’” which would be analyzed under the *Rogers* test if Campbell’s brought suit. *Id.* at 902. Although Campbell’s is an iconic soup brand, its brand name has not attained a meaning beyond its source-identifying function.

status as a “cultural icon” helped explain the artistic relevance of Mattel’s doll to the song. *Id.* at 898, 901–02. A mark that has no meaning beyond its source-identifying function is more likely to be used in a way that has “no artistic relevance to the underlying work whatsoever,” *id.* at 902 (quoting *Rogers*, 875 F.2d at 999), because the work may be “merely borrow[ing] another’s property to get attention,” *id.* at 901. See, e.g., *Dr. Seuss Ents., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997) (holding that an account of the O.J. Simpson murder trial titled *The Cat NOT in the Hat!* borrowed Dr. Seuss’s trademark and poetic style only “‘to get attention’ or maybe even ‘to avoid the drudgery in working up something fresh.’” (citation omitted)).

In this case, Fox used the common English word “Empire” for artistically relevant reasons: the show’s setting is New York, the Empire State, and its subject matter is a music and entertainment conglomerate, “Empire Enterprises,” which is itself a figurative empire. Because we cannot say that Fox’s use of the “Empire” mark “has no artistic relevance to the underlying work whatsoever,” the first prong of the *Rogers* test is satisfied.

Empire Distribution does not dispute that the title “Empire” is relevant to Fox’s work in this sense, but it argues that the first prong of the *Rogers* test includes a requirement that the junior work refer to the senior work. In this case, Empire Distribution argues that the *Empire* show fails the test because its use of the word “Empire” does not refer to Empire Distribution. This referential requirement does not appear in the text of the *Rogers* test, and such a requirement would be inconsistent with the purpose of the first prong of *Rogers*.

The first prong of *Rogers* distinguishes cases in which the use of the mark has some artistic relation to the work from cases in which the use of the mark is arbitrary. In these latter cases, the First Amendment interest is diminished. The bar is set low: “the level of relevance merely must be above zero.” *E.S.S. Entm’t*, 547 F.3d at 1100. Empire Distribution argues that cases like *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003), show that this prong contains a referential requirement. In *Parks*, the Sixth Circuit held that a district court erred in concluding as a matter of law that the title of the song “Rosa Parks” by the hip hop duo OutKast was artistically relevant to the work. *Id.* at 452–59. Despite the song’s use of the civil rights figure’s name, “[t]he composers did *not* intend it to be about Rosa Parks, and the lyrics are *not* about Rosa Parks.” *Id.* at 452. There was no question, however, that the title *did* refer to Parks; no one contended the name was a coincidence. The Sixth Circuit suggested that OutKast had chosen an irrelevant title that “unquestionably enhanced the song’s potential sale to the consuming public.” *Id.* at 453. A reasonable person could find that the song “Rosa Parks” failed the *Rogers* test not because of a lack of relationship between the title “Rosa Parks” and the person Rosa Parks, but because of the “highly questionable” artistic relevance of the title “Rosa Parks” to the song itself—the underlying work. *Id.* at 459.

This is how a work fails the first prong of the *Rogers* test: by bearing a title which has no artistic relevance to the work. A title may have artistic relevance by linking the work to another mark, as with “Barbie Girl,” or it may have artistic relevance by supporting the themes and geographic setting of the work, as with *Empire*. Reference to another work may be a component of artistic relevance, but it is not a prerequisite.

Accordingly, the relevance of the word “empire” to Fox’s expressive work is sufficient to satisfy the first prong of the *Rogers* test.

II

If the use of a mark is artistically relevant to the underlying work, the Lanham Act does not apply “unless the title explicitly misleads as to the source or the content of the work.” *Mattel*, 296 F.3d at 902 (quoting *Rogers*, 875 F.2d at 999) (internal quotation mark omitted). Empire Distribution argues that the “relevant inquiry . . . is whether the defendant’s use of the mark would confuse consumers as to the source, sponsorship or content of the work.” But this test conflates the second prong of the *Rogers* test with the general *Sleekcraft* likelihood-of-confusion test, which applies outside the *Rogers* context of expressive works. See *Mattel*, 296 F.3d at 900 (citing *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979)).

To fail the second prong of the *Rogers* test, “[i]t is key . . . that the creator must *explicitly* mislead consumers.” *Brown*, 724 F.3d at 1245. We must ask not only about the likelihood of consumer confusion but also “whether there was an ‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement’ that caused such consumer confusion.” *Id.* (quoting *Rogers*, 875 F.2d at 1001). As “the use of a mark alone is not enough to satisfy this prong of the *Rogers* test,” *id.*, Fox’s *Empire* show, which contains no overt claims or explicit references to Empire Distribution, is not explicitly misleading, and it satisfies the second *Rogers* prong.

CLAIMED PROCEDURAL ERRORS

Empire Distribution's claims of procedural error are also meritless.

First, Empire Distribution argues that the district court abused its discretion in denying its Rule 56(d) motion to defer consideration of Fox's summary judgment motion in order to allow more time for discovery. The district court denied the 56(d) motion as moot in its order granting summary judgment, concluding that the requested additional discovery was not "germane or relevant" to the First Amendment issues (i.e., the *Rogers* test) which it found dispositive. The subjects of further discovery that Empire Distribution claims would have been relevant are "FOX's reason for selecting the 'EMPIRE' name, FOX's prior knowledge of EMPIRE's trademarks . . . , and FOX's marketing strategy to mislead consumers." None of these facts is relevant to either prong of the *Rogers* test: they shed no light on the question of whether the word "Empire" is artistically related to the show, and they cannot make the use of that word explicitly misleading. As these facts are irrelevant to the ground on which summary judgment was granted, Empire Distribution's request for further time to discover them was correctly denied as moot.

Second, Empire Distribution argues that the district court improperly relied on disputed facts in granting summary judgment. Although it identifies several disputed facts that the district court allegedly resolved in favor of Fox, none of these facts is material to the application of the *Rogers* test. The application of the test comes out the same way whether or not Empire Distribution has validly registered trademarks to the "Empire" name and whether or not all of the songs Fox released under the "Empire" brand were later

collected in compilation albums. The fact that the *Empire* show is a “fictional” story was not a disputed fact, despite the evidence that it was based partly on individuals and events from the real world; fictional stories may take inspiration from reality. Finally, the district court’s statement that the name “Empire” “was not arbitrarily chosen to exploit Empire Distribution’s fame” was a legal conclusion relevant to the first prong of the *Rogers* test, not a statement of fact. Since Empire Distribution cannot identify any disputed fact the district court relied on that was material to its grant of summary judgment, it has not shown error.

CONCLUSION

For the foregoing reasons, the district court’s judgment is affirmed. Appellant shall bear costs on appeal. Fed. R. App. P. 39(a)(2).

AFFIRMED.

APPENDIX B

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES - GENERAL

Case No. CV 15-2158 PA (FFMx)
Date February 1, 2016
Title Twentieth Century Fox Television,
et al. v. Empire Distribution Inc.
Present: The PERCY ANDERSON,
Honorable UNITED STATES DISTRICT JUDGE
Stephen Montes Kerr
Deputy Clerk:
Not Reported
Court Reporter:
N/A
Tape No.:

Attorneys Present for Plaintiffs: None

Attorneys Present for Defendants: None

Proceedings: IN CHAMBERS

Before the Court are a Motion for Summary Judgment (Docket No. 41) and a Motion to Strike Expert Report (Docket No. 46) filed by plaintiffs and counterdefendants Twentieth Century Fox Television, a division of Twentieth Century Fox Film Corporation, and Fox Broadcasting Company (collectively “Fox” or “Plaintiffs”). Defendant and counterclaimant Empire Distribution, Inc. (“Empire Distribution” or “Defendant”) has filed oppositions to both Motions, and requests a continuance under Federal Rule of Civil Procedure 56(d). The Court vacates the hearing calendared for

February 1, 2016, finding the matter appropriate for decision without oral argument under Federal Rule of Civil Procedure 78 and Local Rule 7-15.¹

I. *Background*

On January 7, 2015, Fox debuted “Empire,” a television series which tells the fictional story of a feuding entertainment industry family (the “Empire Series”). (Declaration of Molly M. Lens in Support of Fox’s Motion (“Lens Decl.”), Ex. 2.) The Empire Series chronicles the struggle of rapper and drug-dealer turned music mogul Lucious Lyon, who is diagnosed with a fatal disease in the show’s premiere. (*Id.*, Ex. 11.) The Empire Series centers around Lucious’s ex-wife, Cookie, and their three sons, who fight for future control over Lucious’ music and entertainment company “Empire Enterprises.” (*Id.*) The Empire Series has been a breakout hit, and Fox has spent millions to advertise the show. (Declaration of Shannon Ryan in Support of Fox’s Motion, ¶¶ 2-3.)

One of the unique features of the Empire Series is that music is heavily featured on the show, including songs which were originally produced for the Empire Series. (Declaration of Geoff Bywater in Support of Fox’s Motion, ¶ 2.) Fox partners with Columbia Records to release songs following the broadcast of each episode of the Empire Series, which are then collected to create a compilation soundtrack featuring all of the songs from the season (the “Empire Soundtracks”). (Declaration of Andrew Ross in Support of Fox’s Motion, ¶¶ 2-3.) Fox offers the Empire

¹ The parties have lodged a large number of evidentiary objections to the evidence supporting their respective statements of facts. The Court has not relied on any disputed evidence in deciding this Motion.

Soundtracks for sale in both physical record stores and online stores such as iTunes. (Empire Distribution's Appendix of Exhibits, Ex. 69.) In connection with the Empire Series, Fox also enters into contracts with artists, produces and releases music. It also promotes the artists and their music at radio stations and live performances. (*Id.*)

Defendant Empire Distribution is a record label, music distributor, and publishing company which was founded in 2010. (Declaration of Ghazi Shami in Support of Empire Distribution's Opposition, ¶ 6.) Empire Distribution is a large producer and distributor of urban, hip hop, rap, and R&B music, and has released over 11,000 albums/singles, 6,000 music videos, and 85,000 songs. (*Id.*) Empire Distribution has released multiple platinum and gold records, and has worked with famous artists such as "T.I., Snoop Dogg, Kendrick Lamar, Trinidad James, Too \$hort, The Game, Mally Mall, Rich Homie Quan, Tyga, Shaggy, Busta Rhymes, Fat Joe, Sage the Gemini, Cam'ron, Jim Jones, Rocko, Gladys Knight, Rae Sremmurd, and many more." (*Id.* ¶¶ 7-15.)

Empire Distribution uses the trademarks "Empire," "Empire Distribution," "Empire Publishing," and "Empire Recordings." (*Id.* ¶ 22.) Empire has several federal trademark applications for these marks pending before the United States Patent and Trademark Office. (Declaration of Michael D. Hobbs in Support of Empire Distribution's Opposition, ¶¶ 6-11.) However, three of Empire Distribution's trademark applications have been suspended: The application for "Empire" with Serial No. 86590365 was suspended on July 17, 2015; the application for "Empire" with Serial No. 86590402 was suspended on July 17, 2015; and the application for "Empire Distribution" with Serial No.

86476822 was suspended on October 19, 2015. (Declaration of Molly M. Lens in Support of Fox's Reply, ¶ 11, Exs. 28-30.)

Defendant contends that the debut of the Empire Series caused confusion over the affiliation between Empire Distribution and Fox's Empire Series. (*See* Lens Decl., Ex. 5.) Unhappy with Fox's use of "Empire," Empire Distribution sent Fox a letter requesting that Fox cease and desist its use of the mark. After receiving the cease and desist demand, Fox initiated this lawsuit, asserting claims for declaratory relief against Empire Distribution for: (1) federal trademark infringement under 15 U.S.C. § 1125(a); (2) federal trademark dilution under 15 U.S.C. § 1125(c); and (3) state unfair competition under Cal. Bus. & Prof. Code §§ 17200 *et seq.*

In response, Empire Distribution asserted counterclaims against Fox for: (1) federal trademark infringement, 15 U.S.C. § 1125(a); (2) federal trademark dilution, 15 U.S.C. § 1125(c); (3) federal unfair competition, 15 U.S.C. § 1125(a); (4) California statutory unfair competition and false advertising, Cal. Bus. and Prof. Code §§ 17200 and 17500, *et seq.*; (5) California common law trademark infringement; and (6) California trademark dilution, Cal. Bus. & Prof. Code § 14247.

Fox now moves for summary judgment on all claims in its Complaint and against all of Empire Distribution's counterclaims. Fox also moves the Court to strike the expert report of James Pampinella.

II. *Legal Standard*

Summary judgment is proper where "the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any

material fact and that the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c). The moving party has the burden of demonstrating the absence of a genuine issue of material fact for trial. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 256, 106 S. Ct. 2505, 2514, 91 L. Ed. 2d 202 (1986). “[T]he burden on the moving party may be discharged by ‘showing’—that is, pointing out to the district court—that there is an absence of evidence to support the nonmoving party’s case.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 325, 106 S. Ct. 2548, 2554, 91 L. Ed. 2d 265 (1986); *see also Musick v. Burke*, 913 F.2d 1390, 1394 (9th Cir. 1990). The moving party must affirmatively show the absence of such evidence in the record, either by deposition testimony, the inadequacy of documentary evidence, or by any other form of admissible evidence. *See Celotex*, 477 U.S. at 322, 106 S. Ct. at 2552. The moving party has no burden to negate or disprove matters on which the opponent will have the burden of proof at trial. *See id.* at 325, 106 S. Ct. at 2554.

As required on a motion for summary judgment, the facts are construed “in the light most favorable to the party opposing the motion.” *See Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587, 106 S. Ct. 1348, 1356, 89 L. Ed. 2d 538 (1986). However, the nonmoving party’s allegation that factual disputes persist between the parties will not automatically defeat an otherwise properly supported motion for summary judgment. *See Fed. R. Civ. P. 56(e)(2)* (nonmoving party “may not rely merely on allegations or denials in its own pleading; rather, its response must—by affidavits or as otherwise provided in this rule—set out specific facts showing a genuine issue for trial”). A “mere ‘scintilla’ of evidence will be insufficient to defeat a properly supported motion for summary judgment; instead, the nonmoving party must

introduce some ‘significant probative evidence tending to support the complaint.’” *Fazio v. City & County of San Francisco*, 125 F.3d 1328, 1331 (9th Cir. 1997) (quoting *Anderson*, 477 U.S. at 249, 252, 106 S. Ct. at 2510, 2512). Otherwise, summary judgment shall be entered.

III. Discussion

Fox contends that summary judgment is appropriate because its use of “Empire” is protected by the First Amendment, and because Empire Distribution has failed to establish that there is a genuine issue of material fact as to consumer confusion. As explained below, the Court finds that Fox’s use of “Empire” is protected by the First Amendment, and therefore does not reach the issue of consumer confusion.

A. The First Amendment

The Lanham Act protects the public’s right not to be misled as to the source of a product. *Rogers v. Grimaldi*, 875 F.2d 994, 997 (2d Cir. 1989). However, trademark rights do not allow “the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view.” *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002). Courts must construe “the Lanham Act ‘to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.’” *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003) (quoting *Rogers*, 875 F.2d at 999).

In *MCA Records*, the Ninth Circuit adopted the *Rogers* test to determine when trademark protection must give way to expressive speech protected by the First Amendment. *MCA Records*, 296 F.3d at 902. Under the *Rogers* test, “[a]n 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. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (quoting *MCA Records*, 296 F.3d at 902). The *Rogers* test applies to uses of a trademarked term in both the title and the body of a work. *Id.*

Empire Distribution implores the Court to analyze this case under the *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979) likelihood of confusion test. Empire Distribution asserts that *Sleekcraft* should govern because Fox is allegedly attempting to extend its use of another’s trademark much further than in any other case applying *Rogers*. The Ninth Circuit has repeatedly made clear, without qualification based on the extent of the use, that the “*only* relevant legal framework for balancing the public’s right to be free from consumer confusion” against First Amendment rights is the *Rogers* test. *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1242 (9th Cir. 2013) (emphasis added). Accordingly, the Court will consider this case under the two-pronged *Rogers* test.

1. The *Rogers* Test Does Not Include a Threshold “Cultural Significance” Inquiry

Empire Distribution contends that before applying the two-prong *Rogers* test, the Court must find that the “Empire” mark is “of such cultural significance that it has become an integral part of the public’s vocabulary.” *Rebellion, LLC v. Perez*, 732 F. Supp. 2d 883, 887 (N.D. Cal. 2010). Under this interpretation of the *Rogers* test, no First Amendment rights are

implicated until a word or mark takes on “expressive meaning apart from [its] source-identifying function.” *Id.* at 888; *see also Dita, Inc. v. Mendez*, No. CV 10-6277 PSG (FMOx), 2010 WL 5140855, at *9 (C.D. Cal. Dec. 14, 2010); *Warner Bros. Entm’t v. Global Asylum, Inc.*, No. CV 12-9547 PSG (CWx), 2012 WL 6951315, at *45-46 (C.D. Cal. Dec. 10, 2012), *aff’d*, 544 F. App’x 683 (9th Cir. 2013).²

The cultural significance inquiry required under *Rebellion*, *Dita*, and *Global Asylum*, has been disapproved of by numerous courts. *E.g.*, *VIRAG, S.R.L. v. Sony Computer Entm’t Am. LLC*, No. 3:15-CV-01729 LB, 2015 WL 5000102, at *9-10 (N.D. Cal. Aug. 21, 2015); *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*, 74 F. Supp. 3d 1134, 1140 (N.D. Cal. 2014); *Stewart Surfboards, Inc v. Disney Book Grp., LLC*, No. CV 10-2982 GAF (SSx), 2011 WL 12877019, at *2-3 (C.D. Cal. May 11, 2011); *Winchester Mystery House, LLC v. Glob. Asylum, Inc.*, 210 Cal. App. 4th 579, 592, 148 Cal. Rptr. 3d 412, 421 (2012).

The dispositive case on this issue is *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008). In *E.S.S.*, the Ninth Circuit was presented with the argument that the mark at issue could not be protected under *Rogers* because it was not a cultural icon. *Id.* at 1100. The court dismissed this argument because it “miss[ed] the point.” *Id.* Even more significantly, the court concluded that the use at issue was protected by the First Amend-

² Although the district court’s decision in *Global Asylum* was affirmed on appeal, the appellant challenged only the district court’s analysis of a fair use defense. *Global Asylum*, 544 F. App’x at 683. The Ninth Circuit therefore did not consider whether or not the *Rogers* test included a cultural significance requirement.

ment even though the mark had “little cultural significance.” *Id.* Thus, it is clear that the *E.S.S.* court did not interpret the *Rogers* test as including a threshold cultural significance inquiry. *See id.*; *see also Mil-Spec Monkey*, 74 F. Supp. 3d at 1140-41 (explaining that courts which have imported a “cultural significance” inquiry into the *Rogers* test have done so based on a misreading of *MCA Records*.)

The only threshold for applying the *Rogers* test is whether the allegedly infringing use is contained in an expressive work. *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235, 1241 (9th Cir. 2013) (holding that the “*Rogers* test is reserved for expressive works.”) Both the Empire Series and the Empire Soundtracks are clearly expressive works, and are therefore entitled to First Amendment protection if they satisfy the *Rogers* test. *See Rogers*, 875 F.2d at 997 (“Movies, plays, books, and songs are all indisputably works of artistic expression and deserve protection.”)

2. *Rogers* Prong 1

The first prong of the *Rogers* test requires a showing that the use of a mark has artistic relevance to the underlying work. *MCA Records*, 296 F.3d at 902. The Ninth Circuit has explained that the required “level of relevance merely must be above zero.” *E.S.S.*, 547 F.3d at 1100. The word “Empire” is clearly relevant to Fox’s work because the Empire Series tells the story of characters struggling for literal control over an entertainment company called “Empire Enterprises,” and figurative control over the vast “empire” that Lucious Lyon has built. Additionally, the Empire Series is set in New York, the Empire State. Indeed, Empire Distribution concedes that the word “Empire” has artistic relevance to Fox’s work. (*See Opp’n*, 11.)

However, Empire Distribution contends that the proper inquiry under the first prong of the *Rogers* test asks whether the junior use of the mark is a reference to the senior use. Under this interpretation of the *Rogers* test, it is not enough for a junior user to show a relevant use of a word which is part of the senior user's mark. Because Fox is clear that its use of "Empire" is not a reference to Empire Distribution, Empire Distribution contends that Fox fails to meet the first prong of the *Rogers* test.

In *Rebellion, supra*, the first prong of the *Rogers* test was interpreted as including this referential requirement. 732 F. Supp. 2d at 888-89; *see also Dita, Inc. v. Mendez*, No. CV 10-6277 PSG (FMOx), 2010 WL 5140855, at *2 (C.D. Cal. Dec. 14, 2010); *Warner Bros. Entm't v. Glob. Asylum, Inc.*, No. CV 12-9547 PSG (CWx), 2012 WL 6951315, at *45-46 (C.D. Cal. Dec. 10, 2012). However, the *Rebellion* court has been criticized for misapplying the *Rogers* test. *See Stewart Surfboards, Inc. v. Disney Book Grp., LLC*, No. CV 10-2982 GAF (SSx), 2011 WL 12877019, at *4 (C.D. Cal. May 11, 2011); *Fortres Grand Corp. v. Warner Bros. Entm't Inc.*, 947 F. Supp. 2d 922, 933 n. 2 (N.D. Ind. 2013); *Rebellion Developments Ltd. v. Stardock Entm't, Inc.*, No. 12-12805, 2013 WL 1944888, at *3 (E.D. Mich. May 9, 2013). Additionally, several courts have found that the *Rogers* test protects a junior user even where the use of the mark made no reference to the senior user. *See Rebellion*, 2013 WL 1944888, at *3 (collecting cases).

While it is certainly true that in every Ninth Circuit case interpreting *Rogers*, the allegedly infringing use was a reference to the senior user, the Ninth Circuit has never stated that the *Rogers* test includes a "referential requirement." At most, the Ninth Circuit

has suggested that this is a fact which a court may consider. *See MCA Records*, 296 F.3d at 901 (“[W]here an artistic work targets the original and does not merely borrow another’s property to get attention, First Amendment interests weigh more heavily in the balance.”)

The common thread in opinions interpreting the *Rogers* test is that a junior user “must not have arbitrarily chosen to use the trademarks just to exploit the[ir] publicity value, but rather the use of the trademarks must have genuine relevance to the work. This, however, does not require the [junior user’s] work to be ‘about’ the trademark or what the trademark signifies.” *Stewart*, 2011 WL 12877019 at *4 (internal quotations and citation omitted). This case illustrates the principle: “Empire” has genuine relevance to the Empire Series and it was not arbitrarily chosen to exploit Empire Distribution’s fame. Moreover, it would be a perverse result if Fox’s use of “Empire” would be protected if Fox had claimed that the Empire Series was in some minimal way a commentary on Empire Distribution, but the use would not be protected if, as is the case here, Fox had disclaimed any such use. Such a distinction serves neither the interests of the First Amendment nor the Lanham Act.

Fortres Grand provides another apt illustration. There, Fortres Grand owned “Clean Slate,” a program which was used to protect computer security. *Fortres Grand*, 947 F. Supp. 2d at 924. In the Batman film “The Dark Knight Rises,” one of the plot lines centered around “Clean Slate,” a fictional program capable of erasing an individual’s criminal history. *Id.* The court rejected the argument that in order for the movie’s use of “Clean Slate” to be protected, it had to be “some

well-thought-out ‘expressive’ critique of the trademark” owned by Fortres Grand. *Id.* at 932. Instead, the court held that there was no logical reason to limit *Rogers* to situations where the use essentially amounted to parody, and noted that such an interpretation could severely chill otherwise constitutionally protected speech. *Id.* at 932-33. The same result is appropriate here, where Empire Distribution contends that the common word “Empire” cannot be used in an expressive work unless it is referencing Empire Distribution.

In *E.S.S.*, the Ninth Circuit held that “only the use of a trademark with *no* artistic relevance to the underlying work *whatsoever* does not merit First Amendment protection.” *E.S.S.*, 547 F.3d at 1100 (emphasis in original, internal quotations omitted). The Ninth Circuit also made clear that the work need not be “about” the trademark, requiring only a level of “relevance merely above zero.” *Id.* Interpreting the first prong of the *Rogers* test as including a reference requirement would be inconsistent with these standards and would unnecessarily upset the carefully crafted balance between the First Amendment and the Lanham Act.

3. *Rogers* Prong 2

The second prong of the *Rogers* test requires a junior user to show that their work does not explicitly mislead as to the source or content of the work. *MCA Records*, 296 F.3d at 902. The Ninth Circuit has been clear that the use of a mark in the title of a work, divorced from other explicitly misleading actions, is not enough to bar First Amendment protection. *Id.*

Once again, the parties dispute the proper test to apply when determining whether the work is explicitly misleading. Fox contends that the Court should employ a straightforward application of the test, requiring an “explicit indication, overt claim, or explicit misstatement” as to the source of the work. *Brown*, 724 F.3d at 1246 (citing *Rogers*, 875 F.2d at 1001) (internal quotations omitted). On the other hand, Empire Distribution contends that the second prong of the *Rogers* test imports the *Sleekcraft* likelihood of confusion analysis. Like the parties, lower courts have also split on the proper standard. Compare *Kiedis v. Showtime Networks, Inc.*, No. CV 07-8185 DSF (MANx), 2008 U.S. Dist. LEXIS 124334, at *14-15 (C.D. Cal. Feb. 19, 2008) (requiring a likelihood of confusion analysis in the second prong of the *Rogers* test) with *Stewart Surfboards, Inc v. Disney Book Grp., LLC*, No. CV 10-2982 GAF (SSx), 2011 WL 12877019, at *7 (C.D. Cal. May 11, 2011) (refusing to do the same).

The Court finds that any ambiguity about the proper standard was resolved by the Ninth Circuit’s decision in *Brown*. There, the senior user put forward strong consumer survey evidence demonstrating a likelihood of confusion, which he contended established a triable issue of fact as to the second prong of the *Rogers* test. *Brown*, 724 F.3d at 1245-46 (emphasis added). The Ninth Circuit discredited the importance of the evidence, explaining that:

Adding survey evidence changes nothing. The [second prong of the *Rogers*] test requires that the use be explicitly misleading to consumers. *To be relevant, evidence must relate to the nature of the behavior of the identifying material’s user, not the impact of the use.* Even if

Brown could offer a survey demonstrating that consumers of the Madden NFL series believed that Brown endorsed the game, that would not support the claim that the use was explicitly misleading to consumers.

Brown, 724 F.3d at 1245-46 (emphasis added).

Thus, it is clear that no amount of evidence showing only consumer confusion can satisfy the “explicitly misleading” prong of the *Rogers* test because such evidence goes only to the “impact of the use” on a consumer. *See id.* Even in situations where there is widespread consumer confusion, the Ninth Circuit has struck the balance in favor of protecting First Amendment expression: “The risk of misunderstanding, not engendered by any explicit indication on the face of the [work], is so outweighed by the interest in artistic expression as to preclude application of the [Lanham] Act.” *Id.* at 1246 (quoting *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915 (6th Cir. 2003)). It follows that the *Sleekcraft* likelihood of confusion analysis is inapplicable to the second prong of the *Rogers* test.

Here, Empire Distribution’s argument under the second prong of the *Rogers* test focuses solely on consumer confusion. (*See* Opposition, 12.) Because *Brown* holds that such consumer confusion is irrelevant and there is no evidence that of an “explicit indication, overt claim, or explicit misstatement” as to the source of the work, the Court concludes that Fox has not explicitly misled consumers about its affiliation with Empire Distribution.

In sum, the First Amendment protects the use of a trademark in an expressive work if the use of the mark has artistic relevance to the underlying work and does

not explicitly mislead as to the source or content of the work. *MCA Records*, 296 F.3d at 902. Empire Distribution asserts that: (1) Fox uses “Empire” in an expressive work, although the mark has not reached the level of cultural significance; (2) Fox’s use of “Empire” is relevant to the Empire Series, although the use is not a reference to Empire Distribution; and (3) Fox has not used “Empire” in an explicitly misleading way, although the use has caused consumer confusion. Thus, Empire Distribution has conceded that Fox’s use of “Empire” satisfies all of the requirements of the *Rogers* test. Empire Distribution’s only arguments against summary judgment require the Court to rewrite the *Rogers* test. The Court declines to do so.

B. Remaining Claims

Because the Court concludes that Fox’s use of “Empire” is protected by the First Amendment and falls outside the proscriptions of the Lanham Act, Fox is entitled to summary judgment on all claims asserted in Fox’s Complaint and Empire Distribution’s Counterclaim. See *MCA Records*, 296 F.3d at 902 n. 2, 906-907; *Kerr Corp. v. Tri Dental, Inc.*, No. SACV 12-0891 DOC (CWx), 2013 WL 990532, at *4 (C.D. Cal. Mar. 11, 2013); *Mallard Creek Indus., Inc. v. Morgan*, 56 Cal. App. 4th 426, 434-35, 65 Cal. Rptr. 2d 461, 466-67 (1997).

Conclusion

For the foregoing reasons, the Court grants Fox’s Motion for Summary Judgment. The Court shall enter a Judgment consistent with this Order. Because the Court rules in favor of Fox on First Amendment grounds, the Court denies as moot Fox’s Motion to

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Strike and Empire Distribution's request for a continuance under Federal Rule of Civil Procedure 56(d).³

IT IS SO ORDERED.

³ The discovery which formed the basis of Empire Distribution's request under Rule 56(d) was not germane or relevant to the First Amendment bar raised by Fox's Motion for Summary Judgment. See *Brown*, 724 F.3d at 1239 (a *Rogers* defense to claims of trademark infringement may be adjudicated through a motion to dismiss).

APPENDIX C

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES - GENERAL

Case No. CV 15-2158 PA (FFMx)
Date March 28, 2016
Title Twentieth Century Fox Television,
et al. v. Empire Distribution Inc.
Present: The PERCY ANDERSON,
Honorable UNITED STATES DISTRICT JUDGE
Stephen Montes Kerr
Deputy Clerk:
Not Reported
Court Reporter:
N/A
Tape No.:

Attorneys Present for Plaintiffs: None

Attorneys Present for Defendants: None

Proceedings: IN CHAMBERS

Before the Court is a Motion for Reconsideration (Docket No. 83) filed by defendant and counterclaimant Empire Distribution, Inc. ("Empire Distribution" or "Defendant"). Plaintiffs and counterdefendants Twentieth Century Fox Television, a division of Twentieth Century Fox Film Corporation, and Fox Broadcasting Company (collectively "Fox" or "Plaintiffs") have filed an Opposition. The Court vacates the hearing calendared for March 28, 2016, finding the matter appropriate for decision without oral argument under

Federal Rule of Civil Procedure 78 and Local Rule 7-15.

I. *Background*

On March 23, 2015, Fox filed a Complaint for Declaratory Relief which sought a “declaration pursuant to 28 U.S.C. § 2201 that Empire, and the release of music therefrom, does not violate any of defendant’s purported trademark rights.” (Compl. ¶ 2.) On June 29, 2015, Empire Distribution filed a Counterclaim which sought to stop “Fox’s rampant, unauthorized use of the ‘Empire’ name to promote, market, distribute and sell its television program and music.” (Counterclaim ¶ 1.) The Court issued a Scheduling Order on July 23, 2015. (Docket No. 22.) The Scheduling Order established a discovery cutoff date of January 25, 2016, and a motion cutoff date of February 1, 2016.

On December 8, 2015, the parties filed a Joint Stipulation requesting that the Court alter its Scheduling Order to allow Fox’s prospective summary judgment motion to be heard on March 4, 2016, or, in the alternative, that the Court allow a modified briefing schedule which would provide Empire Distribution with additional time to file its opposition but still allow the motion to be heard before the motion cutoff date. (Docket No. 39.) The parties represented to the Court that the purpose of the Joint Stipulation was to “allow for the completion of discovery” (*Id.*) The Court granted the parties’ alternative request which modified the briefing schedule on the Motion for Summary Judgment but did not alter the Court’s Scheduling Order. (Docket No. 40.)

Fox’s Motion for Summary Judgment was briefed in accordance with the schedule proposed in the parties’

Joint Stipulation. (Docket Nos. 41, 55, 75.) Notwithstanding the modified schedule, Empire Distribution's Opposition included a request for a continuance under Federal Rule of Civil Procedure 56(d). On February 1, 2016, the Court granted Fox's Motion for Summary Judgment, denied Empire Distribution's Rule 56(d) request, and issued a Judgment. (Docket Nos. 79, 80.)

Empire Distribution has now filed the instant motion seeking reconsideration of the Court's ruling on Fox's Motion for Summary Judgment.

II. *Legal Standard*

Reconsideration is an "extraordinary remedy, to be used sparingly in the interests of finality and conservation of judicial resources." *Kona Enters., Inc. v. Estate of Bishop*, 229 F.3d 877, 890 (9th Cir. 2000) (citation omitted). A "motion for reconsideration should not be granted, absent highly unusual circumstances, unless the district court is presented with newly discovered evidence, committed clear error, or if there is an intervening change in the controlling law." *389 Orange St. Partners v. Arnold*, 179 F.3d 656, 665 (9th Cir. 1999) (citation omitted); *see also McDowell v. Calderon*, 197 F.3d 1253, 1255 (9th Cir. 1999). A motion to reconsider "may not be used to raise arguments or present evidence for the first time when they reasonably could have been raised earlier in the litigation." *Carroll v. Nakatani*, 342 F.3d 934, 945 (9th Cir. 2003). Under Local Rule 7-18, a motion to reconsider may only be brought if the moving party demonstrates:

- (a) a material difference in fact or law from that presented to the Court before such decision that in the exercise of reasonable diligence could not have been known to the party

moving for reconsideration at the time of such decision, or (b) the emergence of new material facts or a change of law occurring after the time of such decision, or (c) a manifest showing of a failure to consider material facts presented to the Court before such decision.

Local Rule 7-18 also advises that “[n]o motion for reconsideration shall in any manner repeat any oral or written argument made in support of or in opposition to the original motion.”

III. *Discussion*

Empire Distribution contends that the Court erred in denying its request for a continuance under Rule 56(d). Empire Distribution also contends that the Court erred by relying on disputed evidence when applying the First Amendment defense articulated in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) and adopted by the Ninth Circuit in *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002). As explained below, neither contention is correct.

A. 56(d) Request

Under Rule 56(d), the Court has discretion to extend a response deadline where the “nonmovant shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition.” Accordingly, to meet its burden under Rule 56(d), the non-moving party must show: “(1) it has set forth in affidavit form the specific facts it hopes to elicit from further discovery; (2) that the facts sought exist; and (3) that the sought-after facts are essential to oppose summary judgment.” *Family Home & Fin. Ctr., Inc. v. Fed. Home Loan Mortg. Corp.*, 525 F.3d 822, 827 (9th Cir. 2008). An extension is not justified merely because discovery is incomplete or desired facts are

unavailable. *Jensen v. Redev. Agency of Sandy City*, 998 F.2d 1550, 1554 (10th Cir. 1993). Rather, “the party filing the affidavit must show how additional time will enable him to rebut the movant’s allegations of no genuine issue of fact.” *Id.* “[T]he party seeking a continuance bears the burden to show what specific facts it hopes to discover that will raise an issue of material fact.” *Continental Maritime v. Pacific Coast Metal Trades*, 817 F.2d 1391, 1395 (9th Cir. 1987). “The burden is on the party seeking additional discovery to proffer sufficient facts to show that the evidence sought exists, and that it would prevent summary judgment.” *Chance v. Pac-Tel. Teletrac, Inc.*, 242 F.3d 1151, 1161 n.6 (9th Cir. 2001).

In support of Empire Distribution’s Rule 56(d) request, its counsel submitted a declaration detailing perceived shortcomings in Fox’s conduct during discovery. (*See* Declaration of Peter N. Villar in Support of Empire Distribution’s Opposition to Fox’s Motion for Summary Judgment, ¶¶ 2-34.) The declaration stated that:

The depositions, documents and other discovery that EMPIRE has requested is directed at issues raised by Fox in its Motion including, but not limited to, the origin of, and Fox’s selection of, the “Empire” name; Fox’s knowledge of the EMPIRE marks (including Fox’s trademark searches relating to the EMPIRE marks); Fox’s marketing expenses and promotional efforts relating to the Empire series and Empire series music; sales data for the Empire series music; the strength of the marks at issue; the proximity of the goods; the similarity of the marks; the evidence of actual and likely confusion; the marketing channels

used; the type of goods and the degree of care likely to be exercised by the purchaser; Fox's intent in selecting the Empire mark; and the likelihood of expansion of the product lines.

(*Id.* ¶ 34.)

Counsel's declaration was insufficient to satisfy the requirements for a Rule 56(d) continuance. Specifically, Empire Distribution's counsel's laundry list of additional discovery did not identify with specificity the facts he hoped to obtain. Nor did Empire Distribution's counsel make any showing that such facts exist. Instead, Empire Distribution's counsel appeared to be engaged in a fishing expedition in the hopes of obtaining evidence to support his theories, as confirmed by the Magistrate Judge's denial of Empire Distribution's Motion to Compel. (Docket No. 59.)

Moreover, the general categories of evidence Empire Distribution's counsel hoped to obtain would not defeat Fox's Motion for Summary Judgment. As the Court's Order previously noted, "[t]he discovery which formed the basis of Empire Distribution's request under Rule 56(d) was not germane or relevant to the First Amendment bar raised by Fox's Motion for Summary Judgment." (February 1, 2016 Minute Order, 8 n.3 (citing *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013) (holding that a *Rogers* defense to claims of trademark infringement may be adjudicated through a motion to dismiss).)

Finally, Empire Distribution's Reply contends that "[t]here is nothing improper about gathering evidence through the final days of discovery." (Reply, 10.) While that statement may be correct in the abstract, its applicability to the present case is belied by the very facts underlying Empire Distribution's Rule 56(d)

request. Despite the fact that Fox noticed its Motion for Summary Judgment for the final day allowed by the Court's Scheduling Order, and even though Empire Distribution had the benefit of a modified briefing schedule which afforded it more time to file an opposition, Empire Distribution still requested a continuance under Rule 56(d). That request was made in a deficient manner, and sought discovery which was irrelevant to the Motion's dispositive issue. As such, the Court did not err in denying Empire Distribution's Rule 56(d) request. *See Family Home & Fin. Ctr., Inc. v. Fed. Home Loan Mortgage Corp.*, 461 F. Supp. 2d 1188, 1192 (C.D. Cal. 2006) *aff'd sub nom. Family Home & Fin. Ctr., Inc. v. Fed. Home Loan Mortgage Corp.*, 525 F.3d 822 (9th Cir. 2008).

B. Applicability of Rogers

Empire Distribution also contends that the Court erred in applying the *Rogers* test, and relied on disputed evidence in doing so. Many of Empire Distribution's arguments, in blatant disregard for the Court's Local Rules, are entirely duplicative of those already advanced in its Opposition to Fox's Motion for Summary Judgment. *See* L.R. 7-18. Primarily, Empire Distribution reiterates its flawed argument that the use of a trademark which is otherwise protected under *Rogers*, loses that protection if it also serves a source-identifying function for the junior user.

In its Opposition to the Motion for Summary Judgment, Empire Distribution contended that Fox sells "ancillary goods (including, but not limited to, shirts, jackets, hats, handbags, mugs, and other apparel and accessories) under the 'Empire' banner" and that "Fox will sell, sells, or has sold at least branded music, apparel, nail polish, mugs, and bags. SOF ¶¶ 74-77,

82, 123.” (Opposition to Motion for Summary Judgment, 3, 7 n.4.) However, the Court’s review of the cited evidence did not reveal any support for the associated propositions. The rest of the Opposition, just as the pleadings in the Complaint and Counterclaim, focused on the Empire television show and Fox’s sale of music featured on the show. The Court thus agreed with Fox’s contention that these alleged ancillary uses were not properly before the Court in the Motion for Summary Judgment or, to the extent that they were, they were only used to support Empire Distribution’s “source-identifying function” argument. Accordingly, the Court also does not consider Fox’s new evidence showing that Fox uses “Empire” for “branded nail polish, champagne glasses, key chains, backpacks, hats, purses, calendars, slot machines, and more” because that argument could have been, but was not, raised in Empire Distribution’s Opposition. (Motion for Reconsideration, 15 n.10.) However, the Court agrees that the use of a mark on a commercial good is not the type of expressive activity which is protectable under *Rogers*. Despite this, even if Empire Distribution had adequately put these commercial uses before the Court, it is clear that it did not put forward any evidence demonstrating a likelihood of confusion which would have justified denying the Motion for Summary Judgment.

Nor did the Court rely on any disputed facts in adjudicating the Motion for Summary Judgment. Empire Distribution contends that the Court ignored evidence that Fox releases songs featured on the Empire show both individually and in compilation albums. However, The Court’s Order made clear that “Fox partners with Columbia Records to release songs following the broadcast of each episode of the Empire

Series.” (February 1, 2016 Minute Order, 1.)¹ Thus, the Court clearly considered that Fox regularly sold individual songs featured on the show.

C. Other Arguments

None of Empire Distribution’s remaining arguments regarding newly discovered evidence² or likelihood of confusion merit reconsideration. (Motion, 9-22.) As shown by the Court’s ruling on the Motion for Summary Judgment, evidence of the validity of Empire Distribution’s trademarks was not material to the Court’s First Amendment analysis. Indeed, the Court assumed the validity of Empire Distribution’s rights to

¹ The sentence with which Empire Distribution takes issue, reads: “Fox partners with Columbia Records to release songs following the broadcast of each episode of the Empire Series, which are then collected to create a compilation soundtrack featuring all of the songs from the season.” (February 1, 2016 Minute Order, 1.) Although the Court inadvertently stated that “all” of the individually released songs from a season are also released in a compilation album, both the evidence the Court cited in support of that statement and common sense make clear that only selected songs are featured on compilation albums. (Declaration of Andrew Ross in Support of Fox’s Motion for Summary Judgment, ¶ 4.) The Court clearly considered that Fox’s use of the Empire mark included selling individual songs featured on the Empire show, and Empire Distribution’s reading of the Court’s resuscitation of the facts is demonstrably incorrect. Moreover, this is not the type of a “manifest showing of a failure to consider material facts” that would warrant reconsideration. L.R. 7-18.

² Additionally, as Fox points out, much of the evidence which Empire Distribution purports to rely on as newly discovered evidence supporting its Motion for Reconsideration was produced by Fox prior to the date that Empire Distribution’s Opposition to the Motion for Summary Judgment was due. (*See* Declaration of Molly M. Lens in Support of Fox’s Opposition to Empire Distribution’s Motion for Reconsideration, ¶¶ 2-7.)

the Empire mark when conducting its First Amendment analysis. Next, Fox's assertion of a trademark right in "Empire" against multiple third parties may be proper or improper, but it is clearly outside of the scope of the Court's well-defined inquiry under *Rogers*. Additionally, this argument was previously advanced in Empire Distribution's Opposition to the Motion for Summary Judgment. Likewise, the Court has already considered, and rejected as immaterial to the *Rogers* analysis, Empire Distribution's arguments based on Fox's plans to market the record label portrayed in the show as a real record label, and the fact that music featured on the show is sold in the marketplace alongside music sold by Empire Distribution. These facts do not "explicitly mislead as to the source or content of the work" and at most create some likelihood of confusion which is irrelevant under *Rogers*. *MCA Records*, 296 F.3d at 902; *Brown*, 724 F.3d at 1245-46. Not surprisingly, Empire Distribution's discovery of additional evidentiary support for these facts does not change that conclusion. Finally, because the Court did not conduct a likelihood of confusion analysis in its initial ruling on the Motion for Summary Judgment, none of Empire Distribution's arguments on that point provide a basis for reconsideration.

Conclusion

For the foregoing reasons, the Court denies Empire Distribution's Motion for Reconsideration.

IT IS SO ORDERED.

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APPENDIX D

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

[Filed Jan. 2, 2018]

No. 16-55577

D.C. No. 2:15-cv-02158-PA-FFM
Central District of California, Los Angeles

TWENTIETH CENTURY FOX TELEVISION, a division
of Twentieth Century Fox Film Corporation,
and FOX BROADCASTING COMPANY,

Plaintiffs-Appellees,

v.

EMPIRE DISTRIBUTION, INC.,

Defendant-Appellant.

ORDER

Before: MOTZ,* M. SMITH and NGUYEN, Circuit
Judges.

The panel has unanimously voted to deny the
petition for panel rehearing; Judges M. Smith and
Nguyen have voted to deny the petition for rehearing
en banc, and Judge Motz so recommends. The full
court has been advised of the petition for rehearing

* The Honorable Diana Gribbon Motz, United States Circuit
Judge for the U.S. Court of Appeals for the Fourth Circuit, sitting
by designation.

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en banc and no judge of the court has requested a vote on it. Fed. R. App. P. 35.

The petition for panel rehearing and the petition for rehearing en banc are DENIED.