

Eleventh Circuit: First Amendment Means MTV Floribama Shore Does Not Infringe FLORA-BAMA Trademark

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by Ben Kappelman

In *MGFB Properties, Inc. v. Viacom Inc.*, the U.S. Court of Appeals for the Eleventh Circuit recently sided with Viacom and its subsidiary MTV in a trademark action brought by the owners of the Flora-Bama Lounge, who alleged infringement by the television series *MTV Floribama Shore*. The court held that the title of MTV's show was protected by the First Amendment, applying the familiar *Rogers v. Grimaldi* test, which assists courts in balancing Lanham Act protection against free speech.

The Flora-Bama Lounge bills itself as “the most famous beach bar in the country.” The lounge faces Orange Beach on the Florida-Alabama state line. Established in 1964, the Flora-Bama Lounge's owners operate a restaurant and liquor store that also use the Flora-Bama name and host entertainment and athletic events. In 2013, the owners obtained a federal trademark registration for FLORA-BAMA for bar and restaurant services, among other things.

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The lounge and the trademarks have made a splash in popular culture (or in the more legalistic telling of the Eleventh Circuit: “have been featured in artistic works by third parties”). Jimmy Buffett’s 1984 song Ragtop Day mentions a plan to “Get ourselves a cool one at the Florabama,” Kenny Chesney named a tune after the establishment, crooning:

Sitting here at the Flora-Bama
'Bout to open up a big old can of
Good times, unwind
Fall in and out of love in the same night
Can't say I got a whole lot of cares
I'm in the red neck Riviera
It's getting crazy, getting hammered
Sitting right here at the Flora-Bama
At the Flora-Bama

Chesney packed 25,000 attendees on condo balconies, the beach, and boats near Flora-Bama Lounge for a 2014 concert he called “Flora-Bama Jama,” which was broadcast on Country Music Television, another Viacom channel. Fellow country music performer Neil Dover similarly penned a tribute to FloraBamaTime, where “you leave the world behind.” The lounge has also been described in books, films, and major news outlets.

The conflict between the parties had its roots in *Jersey Shore*, MTV’s television series featuring 20-somethings who live in a beach house in New Jersey. Wanting to ensure that readers who have not watched *Jersey Shore* understand the show, the Eleventh Circuit explained how the *Jersey Shore* cast was perceived as belonging to a “sub-culture centered on a love of clubbing, taking care of one’s physical appearance, and a dedication to family and Italian culture.” That’s one way of putting it. Regardless of description, *Jersey Shore* was a hit that lasted six seasons and spawned several

spinoffs.

In 2016, MTV sought to revive the *Jersey Shore* franchise by developing a new series focused on Southern beach culture. That effort would become MTV Floribama Shore. The show's name began with MTV's goal of a *Shore* series that would highlight Southern beach culture. MTV also considered "Florida Shore," but didn't feel like that would capture the Gulf Coast setting and might be associated with Miami, which MTV thought had its own culture. MTV also considered "Gulf Shore," but passed on that name because it sounded too much like another MTV show, *Siesta Key*. MTV settled on "Floribama" because that name would offer a sense of the subculture and part of the country MTV desired to feature.



MTV was aware of the Flora-Bama Lounge during its development, mentioning it in an internal slide deck profiling the region. MTV also commissioned third-party marketing research, which found that 34% of 300 young people familiar with the region had heard the term "Flora-bama" and about half of them identified it as the lounge. Other research suggested that the term "Flora-bama" was either unknown or thought to refer strictly to

the lounge.

Just before *MTV Floribama Shore* was set to premiere in 2017, the lounge owners sent a cease-and-desist letter insisting that MTV change the name. MTV declined, the show premiered as scheduled, and it aired for four seasons. In 2019, after the second season aired, the lounge owners sued in Florida federal court, claiming trademark infringement and related torts. They alleged actual confusion, such as lounge patrons asking musicians if they had ever met cast members of the show or inquiring of staff as to when the cast would be in the lounge. According to the lounge owners, an elderly patron even criticized the lounge “for allowing MTV to air such a terrible depiction of the Flora-Bama.” The lounge owners also pointed to expert testimony claiming the show blurred internet search results for the lounge and the show, and that 22% of respondents to a survey were confused as to the sponsorship, approval, or affiliation between the lounge and the show. In response, MTV moved for summary judgment—and won.

The Eleventh Circuit upheld the district court’s conclusion that the title *MTV Floribama Shore* was protected by the First Amendment and thus was a permitted use of the “Flora-bama” name. The court relied on the test for balancing trademark and free speech rights established by the Second Circuit Court of Appeals in *Rogers v. Grimaldi*—a test we’ve described before. *Rogers* holds that the title of an artistic work is not trademark infringement “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.”

Applying the first part of the test, the Eleventh Circuit concluded that the name *MTV Floribama Shore* was “well above the artistic reference threshold.” “Floribama” describes the subculture profiled in the series, as well as the geographic area where that subculture exists—“Flori” for Florida and “bama” for Alabama. Also relevant was the addition of MTV’s house mark, and “Shore” to tie the series to the *Jersey Shore* franchise. The court rejected the lounge owners’ contention that a trademark must be necessary to the name of an artistic work for the work to receive First Amendment protection. The court held that “a title will be artistically relevant when it is necessary to use the title” but that does not mean that “a title must be strictly necessary to be artistically relevant.” (And in the Eleventh Circuit’s view, it would be improper for courts to decide what forms of expression are “necessary” to an artistic work.)

Next, the court analyzed the second part of the *Rogers* test—whether the *MTV Floribama Shore* title explicitly misleads as to the source of the work. In a previous decision, the Eleventh Circuit had refined this question as “whether (1) the secondary user overtly marketed the protected work as endorsed or sponsored by the primary user or (2) otherwise explicitly stated that the protected work was affiliated with the primary user.” The court concluded neither had occurred here.

The court rejected the lounge owners’ survey evidence because there was no suggestion that any misunderstanding was engendered by an overt claim of affiliation by MTV. The court observed that the “MTV” house mark and “Shore” were added to the “Floribama” name, which undercut the lounge owners’ argument that the show’s name was intended

to mislead. And although the owners charged that MTV's use of the name was intentional, the court pointed out that even intentional copying of a mark does not supplant the *Rogers* test, a case in which a title received First Amendment protection even though it intentionally copied a mark.

Finally, the court addressed a much-discussed footnote in *Rogers*, which provides that the test in *Rogers* would not apply when an artistic title is confusingly similar to other titles—the so-called “title-versus-title” exception. In the thirty-plus years since *Rogers*, no other circuit court has explicitly adopted the footnote's rule. The Eleventh Circuit decided it need not resolve that legal question because the footnote exception didn't apply. Here, the lounge owners' Flora-Bama mark is not the title of an artistic work—it is a trademark used to identify the lounge and other businesses.

The lounge owners sought to portray third-party use of the mark, such as by Kenny Chesney, as meaning that their mark was used as a title. The court rejected this theory, relying on basic trademark law. The third parties who used “Flora-Bama” in the titles of their artistic works did not do so to suggest that the works originated from the lounge. The titles identify what the artistic works are about, not who produced them. After all, Chesney might have been “sitting right here at the Flora-Bama,” but there was no evidence that the lounge was the source of his song.