

Has Fox's "Empire" Ended the Battle? Ninth Circuit Expands Scope of Permissible Promotion of Expressive Works

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by Jonathan Montcalm



On the day after the airing of "Fortune Be Not Crost," the sixth episode of season four of Fox's popular show "Empire," Fox had some good fortune of its own when the Ninth Circuit Court of Appeals affirmed a declaratory judgment of non-infringement involving "Empire." In *Twentieth Century Fox TV v. Empire Distrib., Inc.*, the Court held that Fox's use of the mark "Empire" in the show's name and its marketing and promotional activities

was protected by the First Amendment, and thus neither infringed nor diluted the trademarks of Empire Distribution, Inc., a record label, music distributor and publishing company focused on hip hop, rap, and R&B. In doing so, the Court broadened the scope of permissible uses of otherwise protectable trademarks to include those uses auxiliary to protected expressive works.

As we wrote in February 2016 after the district court decision, the case involves First Amendment constraints on Lanham Act enforcement, which may be triggered when an expressive work contains an allegedly infringing use (like when a TV show uses the title “Empire” that is allegedly subject to trademark protection). There are two bases for treating expressive works differently: (1) they implicate First Amendment free speech rights that must be weighed against the public interest in avoiding consumer confusion; and (2) “consumers are less likely to mistake the use of some else’s mark in an expressive work for a sign of association, authorship, or endorsement.” When an expressive work contains an allegedly infringing use, the Ninth Circuit applies the two-part test first announced by the Second Circuit in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) to determine if there is liability under the Lanham Act. Under that test, if the allegedly infringing use has some artistic relevance to the expressive work, and does not explicitly mislead as to the source of the expressive work, then there can be no Lanham Act violation.

In this case, the Ninth Circuit agreed with the district court that Fox’s uses of the “Empire” mark passed the *Rogers* test. Of more interest, however, was the Court’s threshold determination that the test should be applied to all of Fox’s uses of the mark. That decision appears to have expanded the scope of First Amendment protection to new categories of uses not previously protected.

When the *Rogers* test was first announced (and when it was first adopted by the Ninth Circuit), it applied only to allegedly infringing uses in *titles* of expressive works. In 2008, the Ninth Circuit extended the applicability of the test to allegedly infringing uses *in the body* of expressive works. *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008). Here, the Ninth Circuit had to analyze these apparent limitations in the context of Fox’s multiple uses of the “Empire” mark, which extend beyond the title and the content of the TV show. Fox also uses the mark in connection with music released after each episode and on soundtrack albums at the end of each season. In addition, Fox promotes the show and associated music “through live musical performances, radio play, and consumer goods such as shirts and champagne glasses bearing the show’s ‘Empire’ brand.”

The Court began its analysis by concluding that the TV show, songs and albums were clearly expressive works subject to the *Rogers* test. It then characterized Fox’s other uses, including the sale of consumer goods bearing the mark, as “promotional efforts” that are “auxiliary to the television show and music releases, which lie at the heart of [Fox’s] ‘Empire’ brand.” The Court acknowledged that these promotional efforts fall outside the title and body of an expressive work, but nonetheless held that “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” The Court reasoned that the First Amendment interests underlying the *Rogers* test could be “destabilized” if the titles of protected expressive works could not also be used to promote those same works.

The idea that marks may be used to promote protected expressive works pre-dates this decision. In fact, the Court noted that *Rogers* itself involved both a movie and its promotion. But the Ninth Circuit appears to have expanded the scope of uses protected by the First Amendment by broadly characterizing all of Fox’s uses as “promotional,” even those that earn revenues like the licensing and sale of consumer goods. After this decision, one could contend that if an expressive work like a television show, movie, or song is protected under the *Rogers* test, then any arguably promotional activities for that expressive work are also protected, so long as they are “auxiliary” to that work.

Empire Distribution has since petitioned for a panel rehearing and rehearing *en banc*; the petition is pending. Relevant here, Empire Distribution distinguishes between uses that promote the title of the expressive work, such as articles and commercials, and the sale of goods and services under the “Empire” mark and the sale of musical recordings under the “Empire” brand, which Empire Distribution contends cannot be protected by the First Amendment. If the petition is denied or the Ninth Circuit affirms its earlier decision on rehearing, those promotional vehicles for protected expressive works appear to have greater leeway to use marks in connection with those activities.