Hollywood's Trademark Law

Stacey Dogan
Boston University School of Law

The Supreme Court's 2023 *Jack Daniel's* opinion ushered in a new era of confusion in trademark law. Doctrinally, the Court held that, whatever speech-protective rules might apply to the use of trademarks in expressive works, such protections do not apply to defendants who use marks "in the way the Lanham Act most cares about: as a designation of source for the infringer's own goods." The Court did not define "use as a designation of source," but its examples suggested that use in a book, movie, or song would not ordinarily qualify. Indeed, Justice Kagan offered *Rogers v. Grimaldi* – which involved a movie title – as a prototypical example of a non-source-designating use.

Since *Jack Daniel's*, however, courts have struggled over how to treat these classically expressive uses of trademarks. In cases involving TV shows, movies, and artwork, courts have accepted claims of source-designation based on the use of a mark in the title or body of the work. Commentators (including this one) have condemned these rulings for giving inadequate breathing room for creative expression. In this view, expressive works are sufficiently distinct from commercial products that they deserve a unique set of trademark rules. The danger of restricting artistic expression represents a different kind of threat than does suppression of commercial speech. Consumers, moreover, have different expectations about the meaning of words and images on expressive products, making it less likely that the unauthorized use of a mark might confuse them. This intuition – that trademarks in expressive works rarely confuse and usually have expressive value that outweighs such confusion – informed the Second Circuit's opinion in *Rogers v. Grimaldi* and has shaped the literature and case law in the intervening years.

This account of trademarks and expressive works, though compelling, is incomplete. By painting all uses of trademarks in expressive works with the same broad brush, it overlooks the range of expressive uses of trademarks, as well as the varied and evolving ways in which creative industries both claim and disclaim the use of trademarks as source-designators. The line between trademark use and expressive use was never as clear as the Supreme Court suggested in *Jack Daniel's*, particularly in the context of titles. And in recent decades, creative industries – especially brand-crazed Hollywood – have so blurred the line between culture and commodity that their claim of expressive purity often rings hollow. By treating every film as a branding opportunity, the movie industry has altered the relationship between expression and source-identification. Indeed, defendants asserting expressive use are often seeking trademark registrations for the very marks they are charged with infringing. This conflation of trademarks with titles (and sometimes characters) confuses the landscape of expressive use and makes infringement claims harder to dismiss, not just in individual cases but more broadly. Maybe it's not illogical to force Hollywood to live with the

consequences of its choices. But it's a shame for independent creators who must operate under the same legal rules.

This article considers the relationship between trademark law and expressive works in the wake of *Jack Daniel's*. It maps the range of expressive uses of marks and suggests a framework for evaluating infringement claims depending on the type of use. Perhaps most significantly, the article proposes preferential treatment for defendants who commit not to seek registration or common-law trademark protection for the mark that is claimed to be infringing.

I. Introduction

II. TM law and expressive works
   a. The current mess
   b. The history

   This section explains the post-*Jack Daniel's* cases that appear to take a cramped view of the kinds of expressive uses that qualify for protection under *Rogers*. It then takes a step back and offers the doctrinal and historical context for the current uncertainty.

III. TMs and expressive works: mapping

   This section maps expressive uses of trademarks according to four variables: the context of the use (e.g., title vs body of work), its meaning (i.e., referential, descriptive/ordinary-meaning), the extent of its commercial purpose (purely expressive element vs branding/claim of TM), and other factors, including explicitly misleading conduct or efforts to avert confusion. These four factors often interact – either explicitly or implicitly – to drive outcomes in expressive-use cases.

IV. A framework

   Drawing upon this map of expressive uses, this section proposes a framework for evaluating claims of infringement based on use of trademarks in expressive works. It distinguishes between easy cases – which courts appear to be handling quite effectively, even post-*Jack Daniel's* – and cases that are challenging at least in part because of the trend toward claiming trademarks *in* titles, characters, and other features of expressive works. To prevent this brand-fetishism from infecting expressive uses generally, the article proposes preferential treatment for defendants who commit not to seek registration or common-law trademark protection for the mark that is claimed to be infringing.

V. Conclusion