9-1-2014

Ka Bow! Seventh Circuit Knocks Down Trademark Claim

Sarah B. Virani

IIT Chicago-Kent College of Law

Follow this and additional works at: http://scholarship.kentlaw.iit.edu/seventhcircuitreview

Part of the Law Commons

Recommended Citation


Available at: http://scholarship.kentlaw.iit.edu/seventhcircuitreview/vol10/iss1/7

This Intellectual Property Law is brought to you for free and open access by Scholarly Commons @ IIT Chicago-Kent College of Law. It has been accepted for inclusion in Seventh Circuit Review by an authorized editor of Scholarly Commons @ IIT Chicago-Kent College of Law. For more information, please contact dginsberg@kentlaw.iit.edu.
KA BOW! SEVENTH CIRCUIT KNOCKS DOWN TRADEMARK CLAIM

SARAH B. VIRANI

INTRODUCTION

A business’s trademark protects its intellectual property, forms its foundation, and allows it to garner goodwill in its products or services; protecting its property rights in its trademark, therefore, is integral to the success of a business. The First Amendment freedom of speech is also integral to the lifestyle of American individuals and businesses alike. To what extent can an individual or business exercise its First Amendment freedom of expression without infringing upon the trademark of another?

The Seventh Circuit addressed this question in a case where fiction and reality collide. In Fortres Grand Corporation v. Warner Bros. Entertainment, the owner of computer software that removes private data from public computers filed suit against Warner Bros. for unauthorized use of its trademark, “Clean Slate,” in the film The Dark Knight Rises and websites advertising the film. In the film, “the clean slate” describes a hacking program that enables Catwoman to rid databases of all evidence of her criminal past. Plaintiff alleged unfair competition under Indiana law and trademark infringement and unfair

* J.D. candidate, May 2016, Chicago-Kent College of Law, Illinois Institute of Technology; B.S., University of Illinois at Urbana-Champaign. Thank you, all the wonderful Viranis in my life, for your endless love and support.
competition under the Lanham Act, claiming that consumers were incorrectly led to believe that Fortres Grand’s software was related to the fictional program from the film.

This note discusses the following matters: (1) the Lanham Act and its standard for a finding of trademark infringement; (2) the doctrine of “reverse confusion”; (3) the Seventh Circuit’s analysis of the reverse confusion doctrine in its 2014 ruling in the Fortres Grand case; (4) the extent of the First Amendment’s protection of creative expression when it implicates the trademark of another; and (5) the effect of the Seventh Circuit’s ruling on future trademark lawsuits based on reverse confusion.

BACKGROUND

A. The Lanham Act

The Lanham Act, 15 U.S.C.A. §§ 1051 et seq., (the “Act”) codifies federal trademark law, providing for trademark registration and regulating the use of trademarks in commercial activity. Section 45 of the Act defines a trademark as “any word, name, symbol, or device, or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish his goods, including a unique product, from those manufactured or sold by others.” ¹ Further, a trademark must be used in commerce. ² Because the Act provides such a broad definition, trademarks “can consist of almost any conceivable subject matter, from a word, symbol, picture, design, numeral, escutcheon, monogram, abbreviation, acronym, slogan, personal name, phrase, newspaper or magazine column title, title of a book series, [or] fragrance,” ³ among other representations.

² Id.
A trademark serves “to point distinctively, either by its own meaning or by association, to the origin or ownership of the wares to which it is applied.” 4 Trademark law is based on the notion that consumers are entitled to identify the source of a product. 5 The Act provides “national protection of trademarks,” which the United States Supreme Court has noted “is desirable . . . because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.” 6 Trademarks not only identify the source of goods, but also represent and generate goodwill for the producer. 7 The consistent production of high quality products that can easily be identified as originating from a particular producer creates a good reputation and goodwill for that producer that foster brand loyalty and generate sales.

B. The Lanham Act Standard of Likelihood of Causing Confusion

Section 32 of the Act provides civil liability for “any person who shall . . . use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.” 8 In § 43, the Act further provides civil liability for “any person who . . . 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 designation of fact.”

---

or misleading representation of fact, which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.” 9 These provisions of the Act serve a dual purpose: (1) to prevent the use of identical marks causing confusion to consumers about the actual source of goods and services; and (2) to protect the goodwill that companies have acquired in their trademarks. 10

Preventing confusion as to the source of a good is intimately connected to protecting the goodwill of the trademark owner. The company owning the registered trademark is the senior user of that mark, while the company using an identical, unregistered mark is the junior user. If two competing goods use confusingly similar marks, consumers may misidentify the source of the goods; if consumers confuse the product of junior user Company A as produced by senior user Company B, Company B then loses control over consumer perception of its reputation. 11 Company A has infringed upon the trademark of Company B if its use of the similar mark is likely to mislead consumers. 12

Because actual confusion often cannot be proven, the essential test for trademark infringement is proof of the likelihood of confusion as to the source of the product at issue. 13 This central question is based on whether consumers “are likely to believe that defendants’ products or services come from the same source as plaintiffs’ protected products or services.” 14 Courts make this determination on a case-by-

---

11 GILSON, supra note 3, § 1.03.
12 Id. at § 5.01.
13 Buckman, supra note 10, § 2[a].
14 ANNE GILSON LA LONDE & JEROME GILSON, 5-5 GILSON ON TRADEMARKS § 5.01 (2014).
case basis, using various factors in evaluating the likelihood of
confusion.\textsuperscript{15}

A likelihood of confusion may result from either forward
confusion or reverse confusion.\textsuperscript{16} Forward confusion, the more
traditional type, “occurs when a junior user of a mark uses it to sell
goods or services based on the misperception that they originate with
the mark’s senior user.”\textsuperscript{17} Conversely, reverse confusion is
characterized by a junior user’s saturation of the market with a
trademark that is identical or similar to the senior user’s trademark.\textsuperscript{18}
Generally, with respect to reverse confusion, the junior user is larger
and more powerful than the senior user,\textsuperscript{19} and “the junior user uses its
size and market penetration to overwhelm the senior, but smaller,
user.”\textsuperscript{20} The senior user’s products are mistaken as originating from
the junior user.\textsuperscript{21} Consequently, this confusion harms the senior user
by reducing the value of the trademark\textsuperscript{22} as well as “its product
identity, corporate identity, control over its goodwill and reputation,
and ability to move into new markets.”\textsuperscript{23} The doctrine of reverse
confusion “protects the senior user’s control of its mark and the
goodwill created by the mark from a junior user’s employment of the
mark, and protects the public from believing that the senior user’s
product” originates from the junior user.\textsuperscript{24}

\begin{footnotes}
\footnote{\textsuperscript{15} Id.}
\footnote{\textsuperscript{16} Buckman, supra note 10, § 2[a].}
\footnote{\textsuperscript{17} Id.}
\footnote{\textsuperscript{18} Id. § 2[a].}
\footnote{\textsuperscript{19} Id.}
\footnote{\textsuperscript{20} Custom Vehicles, Inc. v. Forest River, Inc., 476 F.3d 481, 484 (7th Cir.
2007).}
\footnote{\textsuperscript{21} Fortres Grand Corp. v. Warner Bros. Entm’t Inc., 763 F.3d 696, 701 (7th
Cir. 2014).}
\footnote{\textsuperscript{22} Id.}
\footnote{\textsuperscript{23} Buckman, supra note 10, § 2[a].}
\footnote{\textsuperscript{24} Custom Vehicles, 476 F.3d at 484.}
\end{footnotes}
C. Reverse Confusion Doctrine

While the Seventh Circuit eventually recognized reverse confusion in the 1992 case of Sands, Taylor & Wood Co. v. Quaker Oats Co.\(^\text{25}\), it had previously declined to acknowledge the doctrine in Westward Coach Mfg. Co. v. Ford Motor Co.\(^\text{26}\). Westward, the small senior user, registered and used the mark “Mustang” with the representation of a running horse to market its campers and trailers, which the large junior user Ford subsequently used to market its new sports car.\(^\text{27}\) Finding “no rational basis for support” of Westward’s claim of reverse confusion,\(^\text{28}\) the Seventh Circuit analyzed the infringement claim under the traditional likelihood of confusion theory. The court held that because Westward’s sales were small and the scope of its business narrow, its trademark was weak and did not extend from campers to automobiles and its claim was not actionable.\(^\text{29}\) If unaltered in subsequent cases, this decision “would allow powerful junior users to undermine the trademark protection accorded smaller businesses through sheer economic strength.”\(^\text{30}\) Not only would such a rule disservce smaller businesses with senior rights to a mark, but also the very consumers that trademark law seeks to protect.

Federal courts first recognized the doctrine of reverse confusion in the 1977 case Big O Tire Dealers, Inc. v. Goodyear Tire

\(^{25}\) 978 F.2d 947 (7th Cir.1992) (holding for the first time that the trademark holder could receive damages for reverse confusion, finding that the Lanham Act’s objectives of protecting an owner’s interest in its trademark and preventing consumer confusion are as important in a case of reverse confusion as in traditional trademark infringement).

\(^{26}\) 388 F.2d 627 (7th Cir. 1968).

\(^{27}\) Id. at 630.

\(^{28}\) Id. at 634.

\(^{29}\) Id. at 635.

In that case, junior user Goodyear saturated the market with smaller senior user Big O’s trademark “Bigfoot” to advertise its tires despite knowledge of the senior user’s ownership of the mark. The Tenth Circuit held that under state law, Big O had an actionable trademark infringement claim based on reverse confusion, reasoning that “[s]uch a rule would further Colorado’s policy of protecting trade names and preventing public confusion.” Also significant in Big O’s argument was the testimony of more than a dozen witnesses who were actually confused about the source of Big O’s tires after watching a Goodyear commercial. The Tenth Circuit’s decision marked the first instance in which federal courts explicitly upheld an infringement case based on reverse confusion.

**D. Seventh Circuit’s Recognition of Reverse Confusion**

The Seventh Circuit first recognized reverse confusion in Sands, Taylor & Wood Co. v. The Quaker Oats Co., in which the small soft drink company and owner of the registered trademark “Thirst-Aid” sued the larger junior user, Quaker, for using its mark in an advertising slogan stating “Gatorade is Thirst Aid.” For the first time, the Seventh Circuit held that the trademark holder could receive damages for reverse confusion, finding that the Lanham Act’s objectives of protecting an owner’s interest in its trademark and preventing consumer confusion are as important in a case of reverse confusion as in traditional trademark infringement.

---

31 408 F. Supp. 1219 (D. Colo. 1976), aff’d, 561 F.2d 1365 (10th Cir. 1977).
32 *Id.*
33 *Id.*
34 *Id.*
35 *Id.*
36 *Id.*
37 *Id.* at 958.
While many courts have since recognized trademark infringement based on reverse confusion, there remains little case law on the matter of a fictional good infringing upon the trademark of an actual product. 38 Some courts have held that Lanham Act analysis in reverse confusion cases should be modified “to reflect differences regarding the strength of a mark in which user’s mark should be analyzed.” 39 Courts have also held that Lanham Act analysis should be modified “to reflect differences regarding the defendant’s intent and bad faith.” 40

The Seventh Circuit has decided various reverse confusion cases, including its 2014 decision in Fortres Grand Corp. v. Warner Bros. Entm’t Inc. In the Fortres Grand case, the Seventh Circuit employed a seven-factor test in which it considered: (1) the degree of similarity between the marks in appearance and suggestion; (2) the similarity of the products for which the name is used; (3) the area and manner of concurrent use; (4) the degree of care likely to be exercised by consumers; (5) the strength of the complainant’s mark; (6) actual confusion; and (7) an intent on the part of the alleged infringer to palm off his products as those of another. 41

THE SEVENTH CIRCUIT CASE:
GOTHAM’S NEWEST VILLIAN, THE INFRINGER

Fortres Grand Corp. v. Warner Bros. Entm’t Inc.

Fortres Grand holds a federally registered trademark for its security software program, “Clean Slate,” which is “used to protect public access computers by securing the computer drive back to its

39 Buckman, supra note 10, § 3[a].
40 Id.
41 Fortres Grand Corp. v. Warner Bros. Entm’t Inc., 763 F.3d 696, 702 (7th Cir. 2014).
original configuration upon reboot.” 42. The security software is used to keep private data off of public computers. 43. As a security software, “its single most important characteristic is trustworthiness,” which had been established by Fortres Grand. 44. Fortres Grand obtained a federal trademark registration for “Clean Slate” in 2001 for a “computer software program used to protect public access computers by scouring the computer drive back to its original configuration upon reboot.” 45

In 2012, Warner Bros. released the final installment of its Batman films, The Dark Knight Rises. 46. In the film, the character Catwoman agrees to work with a “shadowy organization” in exchange for a software program developed by “Rykin Data Corporation” called “the clean slate,” which would allow Catwoman to remove her criminal history from all databases, thus wiping “her slate clean.” 47

Upon completion of her work with the organization, Catwoman learns from the organization that she was betrayed and “the clean slate” does not exist. 48. The film later reveals that Batman’s alter ego, Bruce Wayne, had secretly obtained “the clean slate” software, which he offers to Catwoman in exchange for her help in saving Gotham City. 49

The film’s conclusion suggests that Catwoman successfully used the software to wipe her slate clean of her criminal past, as she is living a normal life with Bruce Wayne. 50. Not only was the fictional “clean slate” software depicted in the film, but it was also used in promotional websites featuring the fictional Rykin Data Corporation to market the film. 51

---

42 Id. at 699 (internal quotation marks omitted).
43 Id.
44 Id.
46 Fortres, 763 F.3d at 699.
47 Id.
48 Id.
49 Id.
50 Id.
51 Id. at 700.
for purchase or download, the website did contain a description of the software and an image of a fictional patent. 52

Fortres Grand experienced a decline in Clean Slate software sales following the film’s release, and attributes this decline to “potential customers mistakenly believing that its Clean Slate software is illicit or phony on account of Warner Bros.’ use of the name ‘the clean slate’” to describe a fictional software in the film. 53 Fortres Grand filed a three-count suit against Warner Bros.’ alleging (1) trademark infringement in violation of Lanham Act §§ 32, 43; 54 (2) unfair competition under the Lanham Act; and (3) unfair competition under Indiana trademark law. 55

B. Procedural History

Warner Bros. moved the district court to dismiss Fortres Grand’s claims, challenging the sufficiency of complaint to state a claim for trademark infringement 56 pursuant to Rule 12(b)(6). 57 The District Court for the Northern District of Indiana, South Bend Division, concluded that Fortres Grand had not sufficiently alleged trademark infringement because its claim lacked a plausible theory of consumer confusion. 58 The district court further held that Warner Bros.’ use of the phrase “the clean slate” was protected by the free speech guarantee of the First Amendment. 59

Chief Judge Simon of the district court noted that there is little case law on whether a fictional company or product can infringe on a

52 Id.
53 Id.
55 Fortres, 763 F.3d at 700.
57 F.R.C.P. 12(b)(6).
58 Fortres, 947 F. Supp. 2d at 927.
59 Id.
The court compared Fortres Grand’s Clean Slate software and the Warner Bros.’ fictional “clean slate” software. Over Fortres Grand’s objections, the court also considered the contents of the fictional websites created to promote the film that mentioned the fictional “clean slate” software and its fictional creator, Rykin Data Corporation. Although Fortres Grand argued that the contents of the websites should be disregarded because they were only referenced in the Complaint and not attached to it, the district court considered this matter. The Seventh Circuit has held that it has “taken a broader view of documents that may be considered on a motion to dismiss, nothing that a court may consider, in addition to allegations set forth in the Complaint itself, documents that are central to the complaint and are referred to in it.” (internal quotation marks omitted).

The district court evaluated Fortres Grand’s claims of trademark infringement and state and federal unfair competition using the same trademark infringement analysis because all three claims are based upon the same law and facts. The court noted that likelihood of confusion is central to a trademark infringement action, and “only a confusion about origin supports a trademark claim, and ‘origin’ for this purpose means the ‘producer of the tangible product sold in the marketplace.’” (internal quotation marks omitted). The district court further noted that trademark infringement does not protect against confusion of origin generally, but rather only mistaken purchasing decisions. The court quickly ruled out the theory of forward confusion; because senior user Fortres Grand is not as prominent as junior user Warner Bros., Warner Bros. could not have attempted to

---

60 Id. at 924 (citing McCARTHY, supra note 38, § 31:149).
61 Id.
62 Id. at 925.
63 Id. (citing Williamson v. Curran, 714 F.3d 432, 436 (7th Cir. 2013)).
64 Id. at 926.
65 Id. (quoting Eastland Music Group, LLC v. Lionsgate Entm’t, Inc., 707 F.3d 869, 872 (7th Cir. 2013)); See Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 31 (2003).
66 Id. at 927; see also Rearden LLC v. Rearden Commerce, Inc., 683 F.3d 1190, 1214 (9th Cir. 2012).
“capitalize on” Fortres Grand’s “good will and reputation by suggesting that [its] product comes from the same source as does” Fortres Grand’s “Clean Slate” software.  

The district court then evaluated a theory of trademark infringement by reverse confusion, in which the “large senior user saturates the market with a trademark similar or identical to that of a smaller, senior user, “leading consumers to believe the two products share the same origin” (internal quotes omitted). The court, in evaluating the similarity of the two products, found a major flaw in Fortres Grand’s argument that it has been “damaged by the reverse confusion resulting from Warner Bros.’ saturation of the market with its big-budget film and its promotional websites” (internal quotes omitted). The district court noted that because “the clean slate” software from the film is a fictional software, the court must compare the parties’ ultimate products, which in this instance are Fortres Grand’s “Clean Slate” software to Warner Bros.’ film.  

A theory of reverse confusion, the court noted, would certainly have succeeded had Warner Bros. saturated the market with a campaign for an actual software called the “Clean Slate.” However, in the present matter, the court compared Fortres Grand’s software to Warner Bros.’ film and held that Fortres Grand failed to plausibly allege: (1) consumer were deceived into believing the fictional software from the film originates from or is connected to Fortres Grand; or (2) consumers were deceived into believing that the film originates from or is connected to Fortres Grand.  

Holding that no reasonable consumer would plausibly believe either of the aforementioned notions, the court concluded that Fortres Grand failed

---

67 Fortres, 947 F. Supp. 2d at 926-27.
68 Id. at 927.
69 Id. at 928.
71 Fortres, 947 F. Supp. 2d at 928.
72 Id. at 929.
73 Id. at 930.
to state a claim for trademark infringement under both the traditional “forward confusion” theory and the “reverse confusion” theory. In dictum, the court postulated that even if Fortres Grand had alleged a plausible claim for likelihood of confusion, Warner Bros.’ use of “clean slate” is protected by the First Amendment.

C. Reasoning

The Seventh Circuit reasoned that “all three of Fortress Grand’s claims depended on plausibly alleging that Warner Bros.’ use of the words ‘clean slate’ is ‘likely to cause confusion’” under the Lanham Act. The court stated that only confusion about “origin, sponsorship, or approval of . . . goods supports a trademark claim” (internal quotes omitted). To survive a motion to dismiss for failure to state a claim for infringement based on reverse confusion, Fortres Grand must have alleged that “Warner Bros.’ use of the words ‘clean slate’ in its movie to describe an elusive hacking program that can eliminate information from any and every database on earth has caused a likelihood that consumers will be confused into thinking that Fortres Grand’s Clean Slate software ‘emanates from, is connected to, or is sponsored by [Warner Bros.]’”

The Seventh Circuit employed a seven-factor test in evaluating the plausibility of Fortres Grand’s allegation of confusion. The court considered: (1) the degree of similarity between the marks in appearance and suggestion; (2) the similarity of the products for which the name is used; (3) the area and manner of concurrent use; (4) the

---

74 Id.
75 Id. at 931.
76 Fortres Grand Corp. v. Warner Bros. Entm’t Inc., 763 F.3d 696, 700 (7th Cir. 2014).
78 Fortres, 763 F.3d at 701.
79 Id. (quoting Custom Vehicles, Inc. v. Forest River, Inc., 476 F.3d 481, 484 (7th Cir. 2007)).
80 See generally Fortres, 763 F.3d 696 (7th Cir. 2014).
degree of care likely to be exercised by consumers; (5) the strength of the complainant’s mark; (6) actual confusion; and (7) an intent on the part of the alleged infringer to palm off his products as those of another.  

Fortres Grand argued that in finding that Fortres Grand failed to state a claim, the lower court improperly relied heavily on the “similarity of the products” factor when it concluded that Fortres Grand’s software and the Warner Bros.’ movie were not sufficiently similar as to plausibly cause confusion. Fortres Grand argued that instead of comparing its software to the movie, the court should have compared its software to the fictional software in the movie. The issue, therefore, was whether the products are sufficiently similar as to cause consumers to attribute them to a single source.

In its decision, the Seventh Circuit relied on cases of forward confusion that “have considered the likelihood of confusion between the senior user’s product and the junior user’s creative work – not any fictional product therein.” In both Davis v. Walt Disney and Ocean Bio-Chem, Inc. v. Turner Network Television, those respective courts compared the senior user’s product to the movie, not the fictional product in the movie. The Seventh Circuit held that this approach aligns with the Supreme Court’s emphasis on “the tangible product sold in the marketplace.”

Applying the product similarity rule to reverse confusion, the Seventh Circuit concluded that the proper tangible products to be compared, the software and the film, were “quite dissimilar.”

---

81 McGraw-Edison Co. v. Walt Disney Prods., 787 F.2d 1163, 1167-68 (7th Cir. 1986) (quoting Helene Curtis Indus., Inc. v. Church & Dwight Co., Inc., 560 F.2d 1325, 1330 (7th Cir. 1977)).
82 See generally Fortres, 763 F.3d 696 (7th Cir. 2014).
83 Id.
85 Fortres, 763 F.3d at 701 (quoting Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 31 (2003) (internal quotation marks omitted).
86 Id. at 704.
court further noted, “Fortres Grand has alleged no facts that would make it plausible that a super-hero movie and desktop management software are ‘goods related in the minds of consumers in the sense that a single producer is likely to put out both goods.’” The similarity of the marks, the strongest factor in support of Fortres Grand’s argument, is not enough considering the weakness of the other factors. The court noted, “[t]rademark law protects the source-denoting function of words used in conjunction with goods and services in the marketplace, not the words themselves.” The Seventh Circuit affirmed the district court’s verdict in favor of Warner Bros., properly concluding that Fortres Grand did not plausibly allege trademark infringement based on reverse confusion. The Seventh Circuit did not, however, address the matter of First Amendment protections as related to trademarks because the insufficiency of the claim had already been determined.

ANALYSIS

A. Trademarks and First Amendment

The First Amendment of the Constitution provides in relevant part that “Congress shall make no law [. . .] abridging the freedom of speech, or of the press.” Because the Seventh Circuit found that Fortres Grand’s Complaint did not sufficiently state a claim for reverse confusion, the court did not address the matter of First Amendment protections. The lower court, however, held that Warner Bros.’ use of the term “clean slate” was also protected by the First Amendment.

87 Id.
88 Id. at 705
89 Id.
90 Id.
91 U.S. CONST. amend. I.
92 Fortres,763 F.3d at 698.
In its holding, the lower court relied on the Second Circuit’s balancing test for application of the Lanham Act, as established in Rogers v. Grimaldi. The plaintiff in Rogers alleged that the defendant’s film violated the Lanham Act’s rights of publicity and privacy by creating the false impression that Ginger Rogers was associated with the film “Ginger and Fred.” In Rogers, the Second Circuit held that the Lanham Act must be narrowly construed, as application of the Lanham Act to the titles of artistic works may infringe First Amendment rights. The Second Circuit reasoned that the Lanham Act applied “to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” Because the film’s title had an ironic meaning and did not directly state that it depicted Ginger Rogers, the interest in free speech outweighed the potential misconception “that Rogers had some involvement with the film.” Applying the Second Circuit’s test, the lower court in Fortres Grand reasoned that “the Lanham Act is inapplicable to ‘artistic works’ as long as the defendant’s use of the mark is (1) ‘artistically relevant’ to the work and (2) not ‘explicitly misleading’ as to the source or content of the work.” Finding that the Warner Bros.’ film constituted an artistic work, the lower court correctly reasoned that Warner Bros. satisfied both prongs of the Rogers test and was thus protected by the First Amendment.

While the Second Circuit discussed only the title of an artistic work, the Ninth, Sixth, and Eleventh Circuits have all expanded the

---

94 875 F.2d 994 (2d Cir.1989); see also Facenda v. NFL Films, Inc., 542 F.3d 1007, 1016 (3d Cir. 2008).
95 875 F.2d 997.
96 Id. at 998.
97 Id.
98 Id. at 1001.
100 Id. at 932; see also Facenda v. NFL Films, Inc., 542 F.3d 1007, 1016 (3d Cir. 2008).
Rogers test to apply to artistic works generally. Applying the Rogers test, the Second Circuit concluded that Warner Bros. use of the term “clean slate” was artistically relevant and did not explicitly mislead consumers as to the source of the work, satisfying both prongs of the Rogers test.

The statutory canon of constitutional avoidance mandates that courts construe statutes to avoid serious constitutional problems unless such a construction is contrary to congressional intent. Where exactly, then, does the boundary between First Amendment rights and trademark rights lie?

The Supreme Court first discussed the application of First Amendment rights to commercial speech in *Valentine v. Chrestenson*, in which the Court held that “the Constitution imposes no restraint on government as respects purely commercial advertising.” More than 30 years later in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, the Court first held that the First Amendment protects commercial speech.

Commercial speech is usually defined as “speech that does no more than propose a commercial transaction.” The sale of an artistic work for profit does not make it per se commercial.

“Trademark rights promote the aims of the First Amendment by enabling producers of the spoken and written word to differentiate

---

101 Fortres, 947 F. Supp. 2d at 931; see E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1099 (9th Cir. 2008); Univ. of Alabama Bd. of Trustees v. New Life Art, Inc., 683 F.3d 1266, 1278 (11th Cir. 2012); ETW Corp. v. Jireh Pub., Inc., 332 F.3d 915, 928 n.11 (6th Cir.2003); Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, 886 F.2d 490, 495 (2d Cir.1989).
102 Fortres, 947 F.Supp.2d at 932.
105 Id.
106 Id. (internal quotation marks omitted).
107 Id. at 398.
themselves.” Although there is no conflict between free speech principles and trademark law, commercial speech enjoys less First Amendment protection than non-commercial speech. The Supreme Court held in *Joseph Burstyn, Inc. v. Wilson* “that expression by means of motion pictures is included within the free speech and free press guaranty” even though film-making “is a large-scale business conducted for private profit.” The Court “implicitly characterized motion pictures as noncommercial speech when it held this expression is protected by the First Amendment.” Therefore, “use of another’s mark within the context of artistic or literary expression should generally be classified as noncommercial speech that is fully protected by the First Amendment.” If the use of a trademark is misleading, it is excluded from First Amendment protections. As in the Fortres Grand case, when an artistic expression is deemed noncommercial, it receives the full protection of the First Amendment. The courts must protect the fundamental right of free expression, especially when that expression is noncommercial and thus does not conflict with the commercial objectives that trademark law seeks to protect.

**B. Impact on Future Reverse Confusion Cases**

The Seventh Circuit has decided only a handful of cases in which plaintiffs’ claims were based on a theory of reverse confusion, holding in most that there was no likelihood of confusion as to violate the Lanham Act. Although there are few cases discussing whether a fictional good may plausibly infringe upon the trademark of an actual product, it is likely that such cases will be heard by courts more

---

108 *McCarthy*, *supra* note 38, § 31:139.
109 *Id.*
110 *Ramsey*, *supra* note 104, at 396.
111 *Id.*
112 *Id.*
113 *Id.*
114 *Id.* at 412.
extensively as the worlds of actual goods, entertainment, and social media intermingle.

While businesses hold an important interest in protecting their trademarks and the goodwill that may accompany it, the First Amendment guarantee of freedom of expression remains a central tenet of American culture for both individuals and businesses. The District Court of Northern Indiana properly decided in the Fortres Grand case that even if Warner Bros.’ use of the term “clean slate” in *The Dark Knight Rises* resulted in a likelihood of confusion among consumers as to the source of either parties’ products, Warner Bros. is protected by the First Amendment. When it comes to artistic expression, artists, like filmmakers, should be able to express an idea without fear of infringing upon the trademark of another. In the United States, there are two million registered trademarks and countless unregistered trademarks. It would be unduly burdensome for a filmmaker, for instance, to research every term or phrase it uses to ensure it has not violated the trademark of another. This burden is fair when a business is creating a product for use in commerce, because the research is limited, but excessively onerous for a filmmaker or other artist creating a more extensive work.

Although the First Amendment protects artistic works from trademark infringement lawsuits, businesses must still protect their trademarks, along with their goodwill and reputation among consumers, with claims based on the Lanham Act. The reverse confusion doctrine is very much applicable when two goods or services in commerce using identical marks create a likelihood of confusion. The Seventh Circuit’s decision in the Fortres Grand provides an additional decision in the area of potential trademark infringement in entertainment, upholding and applying the doctrine of reverse confusion that has established its rank as a plausible theory for trademark infringement.