Empire Strikes Back: First Amendment Protects TV Series Title

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Addressing the issue of trademark infringement specific to the title of an expressive work, the US Court of Appeals for the Ninth Circuit affirmed the district court’s conclusion that Twentieth Century Fox's use of the name “Empire” is protected by the First Amendment and is therefore outside the reach of the Lanham Act. Twentieth Century Fox Television v. Empire Distribution, Inc., Case No. 16-55577 (9th Cir., Nov. 16, 2017) (Smith, J).

Twentieth Century Fox launched its musical television series Empire in 2015. The show portrays a fictional New York hip-hop music label named Empire Enterprises and features songs in every episode, including original music. Fox promotes the show and its associated music through live performances, radio play and merchandise bearing the “Empire” brand. Defendant Empire Distribution is a record label and publishing company that distributes urban, hip-hop and R&B music, including the work of artists such as Snoop Dogg. Empire Distribution sent Fox a letter demanding that Fox stop using “Empire,” claiming that its use was infringing on Empire Distribution’s rights in its EMPIRE registered trademark.

Fox filed a declaratory judgment action against Empire Distribution, seeking a declaration that the Empire show and its associated music releases did not violate Empire Distribution's trademark rights under either the Lanham Act or California law. Empire Distribution counterclaimed for trademark infringement, trademark dilution, unfair competition and false advertising. After Fox moved for summary
judgment, the district court determined that Fox’s use of “Empire” is protected by the First Amendment under the two-prong test laid out by the US Court of Appeals for the Second Circuit in Rogers v. Grimaldi (1989). 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 it explicitly misleads consumers as to the source or content of the work.” After the district court granted summary judgment on all claims and counterclaims, Empire Distribution appealed.

Empire Distribution argued that the district court erred substantively and procedurally in finding that Fox’s use of the name “Empire” was protected by the First Amendment and was therefore outside the reach of the Lanham Act. The Ninth Circuit began its analysis by noting that general claims of trademark infringement under the Lanham Act are governed by the likelihood-of-confusion test laid out by the Ninth Circuit in Mattel v. MCA Records (2002). When the alleged infringing use is in the title of an expressive work, however, the proper test is the Rogers test.

Applying the Rogers test, the Ninth Circuit found that the first prong of the test was satisfied because Fox used the word “Empire” for artistically relevant reasons. The Court determined that the show is set in New York, the Empire State, and its subject matter relates to an entertainment conglomerate, which is a figurative empire. The Court further noted that 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. The court found that the title of Empire has artistic relevance by supporting the themes and geographic setting of the work sufficient to pass the first prong.

To fail the second prong of the Rogers test, the creator must explicitly mislead consumers. The Court noted that use of a mark alone is not enough to satisfy the second prong. The Court found that Fox’s Empire show made no overt claims or explicit references to Empire Distribution, and therefore concluded that it was not explicitly misleading.

The Ninth Circuit accordingly concluded that Fox’s use of “Empire” in relation to its television series and related music satisfied the Rogers test, and therefore such use was protected by the First Amendment and was outside the scope of the Lanham Act.

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