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Wyoming Federal Court Applies Rogers Test and “Genuine Artistic Motive” Test

Dismisses with Prejudice Trademark Case Involving Title of Documentary

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In a Wyoming trademark infringement lawsuit against defendant Showtime Networks Inc. (“Showtime”) alleging that the title of a four-part documentary series about UFOs entitled “UFO” infringed two registered trademarks in the word, “UFO” owned by plaintiff UFO Magazine, Inc. (“UFO Magazine”), the District Court of Wyoming recently dismissed the claims with prejudice on the grounds that the First Amendment protected Showtime’s use of the “UFO” title under both the leading *Rogers v. Grimaldi* decision and the “Genuine Artist Motive” test created and applied in 2020 in the District of Colorado in *Stouffer v. National Geographic Partners, LLC*. See [UFO Mag., Inc. v. Showtime Network, Inc.](#), No. 22-CV-078-NDF, 2022 WL 16644914, at *1 (D. Wyo. Nov. 3, 2022).

The dismissal of the lawsuit is noteworthy for two reasons. First, the decision marks the first time that a court within the Tenth Circuit has applied the widely-adopted *Rogers* test to dismiss Lanham Act claims involving the title of an expressive work. Second, the decision is now the second case in the Tenth Circuit to apply the multi-factor test created by the District Court of Colorado in *Stouffer v. National Geographic Partners, LLC*, 460 F. Supp. 3d 1133 (D. Colo. 2020), in which that court rejected *Rogers* and applied its own standard, which asks if the junior user had “a genuine artistic motive” for using the senior user’s mark.

The case highlights the fact that a national standard as to when First Amendment interests take precedence over trademark infringement and unfair competition claims does not yet exist.

The application of both tests in *UFO Magazine, Inc.* leaves unanswered the question of which test courts in the Tenth Circuit will apply in the future when addressing Lanham Act claims asserted against expressive works. The case highlights the fact that a national standard as to when First Amendment interests take precedence over trademark infringement and unfair competition claims does not yet exist.

The Rogers Test

The seminal case, *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), involved claims by the actress Ginger Rogers that the title of the motion picture “Ginger and Fred” infringed her trademark rights. While trademark infringement is usually determined by a multi-factor likelihood of confusion test, in *Rogers*, the Second Circuit held that the First Amendment shields the titles of expressive works “unless the title [either] has no artistic relevance to the underlying work whatsoever” or “explicitly misleads as to the source or the content of the work.” *Rogers*, 875 F.2d at 998–1001.

Under the *Rogers* test, the threshold for “artistic relevance” is satisfied when the level of artistic relevance to the work in issue is “above zero.” *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235, 1243 (9th Cir. 2013). With respect to the second prong of the *Rogers* test, the relevant question is whether the defendant’s use of the mark “is misleading in the sense that it induces members of the public to believe [the work] was prepared or otherwise authorized” by the plaintiff. *Twin Peaks Prods., Inc. v. Pubs. Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993). According to the court in *Brown*, this requires an “explicit indication, overt claim or explicit misstatement” that causes consumer confusion. *Brown*, 724 F.3d at 1245.

Although the Supreme Court has not established a uniform standard to apply when balancing First Amendment rights against trademark claims, several Circuits have adopted the *Rogers* test. See, e.g., *Radiance Found., Inc. v. N.A.A.C.P.*, 786 F.3d 316, 329 (4th Cir. 2015) (“Titles, as part of expressive works, ‘require[] more protection than the labeling of ordinary’ goods”; citing *Rogers*); *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 928 (6th Cir. 2003) (“We thus apply the *Rogers* test to the facts before us”); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (applying *Rogers* to title of song); *University of Alabama Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1277 (11th Cir. 2012) (*Rogers* “is the landmark case for balancing trademark and First Amendment rights.”); see also *Twentieth Century Fox TV v. Empire Distrib., Inc.*, 875 F.3d 1192 (9th Cir. 2017) (*Rogers* test also applies to promotional materials of expressive works).

The Tenth Circuit, however, has not yet had the opportunity to do so and, until recently, the only District Court within the Tenth Circuit to address Lanham Act claims asserted against the title of an expressive work rejected *Rogers* and created its own “Genuine Artistic Motive” test.

The “Genuine Artistic Motives” Test

In *Stouffer v. National Geographic Partners, LLC*, the owner of the registered trademark “Wild America,” which the owner used as the title of its nature documentaries, asserted trademark claims against National Geographic following National Geographic’s release of nature documentaries under the titles, “Wild Americas” and “Wildest Americas.” *Stouffer v. Nat’l Geographic Partners, LLC*, 400 F. Supp. 3d 1161 (D. Colo. 2019) (hereinafter, “*Stouffer I*”). The District Court rejected application of the *Rogers* test and, in its place, created a new test that focuses on the defendant’s motives for using the plaintiff’s mark.

Specifically, the court identified the following as relevant questions to discern the junior user’s motives: (1) Do the senior and junior users use the mark to identify the same kind, or a similar kind, of goods or services?; (2) To what extent has the junior user “added his or her own expressive content to the work beyond the mark itself”?; (3) Does the timing of the junior user’s use in any way suggest a motive to capitalize on popularity of the senior user’s mark?; (4) In what way is the mark artistically related to the underlying work, service, or product?; (5) Has the junior user made any statement to the public, or engaged in any conduct known to the public, that suggests a non-artistic motive?; and (6) Has the junior user made any statement in private, or engaged in any conduct in private, that suggests a non-artistic motive? See *Stouffer I*, 400 F. Supp. 3d at 1179. Following its application of the “Genuine Artist Motives” test, the District Court of Colorado dismissed plaintiff’s trademark claims under Fed. Rule Civ. P. 12(b)(6). *Stouffer v. Nat’l Geographic Partners, LLC*, 460 F. Supp. 3d 1133, 1135 (D. Colo. 2020) (hereinafter, “*Stouffer II*”).

The Trademark Modernization Act of 2020

After the ruling in *Stouffer II*, the Judiciary Committee Report issued in support of the Trademark Modernization Act of 2020 expressed a legislative intent that courts continue to apply the *Rogers* test as the sole “standard for accommodating First Amendment interests in the Lanham Act context for infringement and unfair competition claims.” See H.R. REP. No. 116-645, at 20 (2020). The Report explains that “[i]n enacting this legislation, the Committee intends and expects that courts will continue to apply the *Rogers* standard to cabin the reach of the Lanham Act in cases involving expressive works” and that “adoption by a court of a test that departs from *Rogers*, including any that might require a court to engage in fact-intensive inquiries and pass judgment on a creator’s ‘artistic motives’ in order to evaluate Lanham Act claims in the expressive-works context would be contrary to the Congressional understanding of how the Lanham Act should properly operate to protect important First Amendment considerations[.]” *Id.*

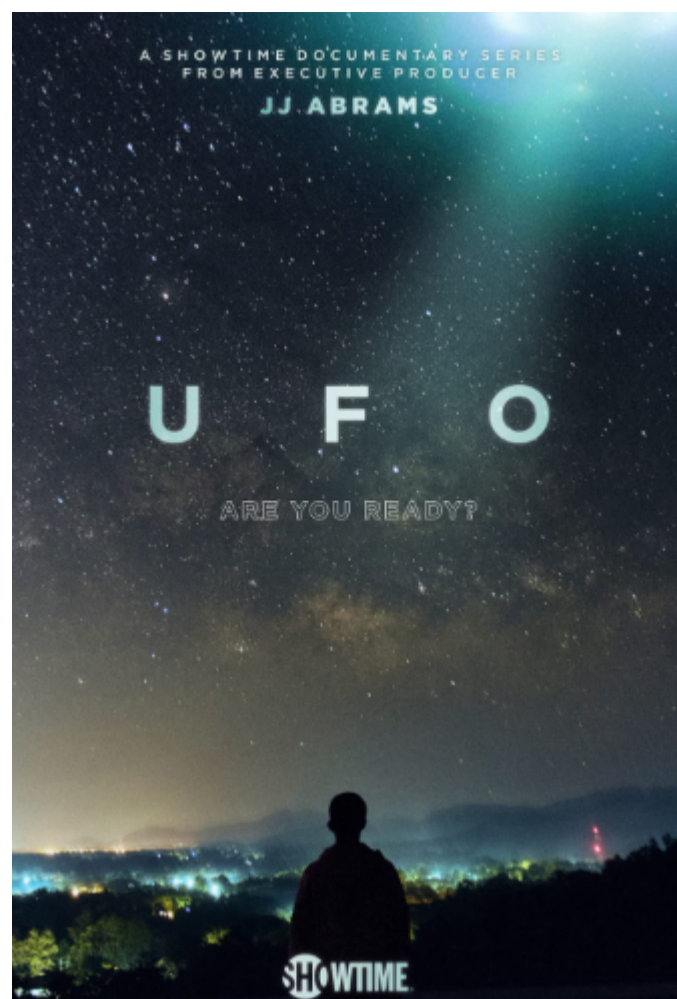
“UFO” Series – Case Background

In 2021, Showtime aired a four-part television documentary series, produced by J.J. Abrams, that explores the public’s fascination with UFOs and addresses the impact of a 2017 New York Times article that revealed that the U.S. Department of Defense had spent more than \$20 million secretly studying UFOs.

Shortly thereafter, in 2022, UFO Magazine filed its complaint asserting two claims under the Lanham Act for Trademark Infringement and Unfair Competition. UFO Magazine alleged it owned a magazine of the same name and two incontestable registered trademarks for the word “UFO,” which UFO Magazine claimed it obtained in 2007 and 2011. UFO Magazine also alleged that it has been in discussions to develop a UFO-titled motion picture “for many years” and that Showtime’s “UFO” series prevented it from using its UFO mark as it intended.

Showtime moved to dismiss UFO Magazine’s complaint under Federal Rule of Civil Procedure 12(b)(6) on the grounds that the First Amendment protected Showtime’s use of the “UFO” title. Showtime urged the court to apply the *Rogers* test to dismiss the complaint. UFO Magazine requested application of the “Genuine Artistic Motives” test. District Judge Nancy D. Freudenthal, after finding that the complaint failed under both tests, dismissed UFO Magazine’s complaint without prejudice, ruling that Showtime’s use of the “UFO” title was protected under the First Amendment.

Thereafter, UFO Magazine filed an amended complaint in which asserted the same trademark claims and substantially the same allegations included in its original complaint. Showtime again moved to dismiss on First Amendment grounds.



“UFO” Motion to Dismiss with Prejudice Ruling

In its motion to dismiss the amended complaint, Showtime again urged the District Court to adopt the *Rogers* test. Tacitly conceding that it could not overcome the *Rogers* test, UFO Magazine’s opposition asked the District Court to: (1) adopt its own test; or (2) apply the Eighth Circuit’s “no alternative avenues” test, which finds infringement if there are adequate alternatives to using the plaintiff’s trademark; or (3) to, once again, apply the “Genuine Artistic Motives” test.

In granting Showtime’s motion to dismiss with prejudice, the District Court found that Showtime’s UFO series was entitled to protection under “the leading *Rogers* test” because the title “UFO” has at least minimal artistic relevance to the underlying work and was not explicitly misleading. The District Court declined to apply the “no alternative avenues” test, noting that the Tenth Circuit had rejected that test in the context of intellectual property because it “does not sufficiently accommodate the public’s interest in free expression.” *UFO Magazine, supra*, 2022 WL 16644914, at *4 (quoting *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 971 (10th Cir. 1996) (dismissing right of publicity claims). The District Court also, once again, ruled that each factor of the “Genuine Artistic Motives” test weighed in Showtime’s favor. Finally, the District Court declined UFO Magazine’s invitation to adopt its own test, noting that UFO Magazine had not proposed a specific formulation for such a test.

While the District Court of Wyoming appears to be the first within the Tenth Circuit to apply the *Rogers* test to dismiss Lanham Act claims asserted against the title of an expressive work, the court’s simultaneous application of the “Genuine Artistic Motives” test leaves open what test courts within the Tenth Circuit will apply going forward when balancing First Amendment principles against trademark claims. The case underscores the need for a national standard to avoid chilling free speech by leaving open the opportunity for forum shopping by litigants who assert trademark claims against media defendants with multistate contacts.

Alan Friedman and Joshua Bornstein of Fox Rothschild LLP represented Showtime. Any opinions expressed in the article are the opinions of the authors alone. Plaintiff was represented by Bradley L. Boone, Jackson, WY.

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