
Central District of California: First Amendment Protection Under *Rogers V. Grimaldi* Expanded to Cover Title of Television Series

Twentieth Century Fox Television, et al. v. Empire Distribution Inc., 2016 WL 685106, __ F. Supp. 3d __ (C.D. Cal. Feb. 1, 2016)

In a declaratory judgment case, the United States District Court for the Central District of California recently held that the title of Twentieth Century Fox Television's ("Fox") hit television series "Empire" (the "Empire Series") did not infringe the EMPIRE trademark of Empire Distribution Inc. [More](#)

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In a declaratory judgment case, the United States District Court for the Central District of California recently held that the title of Twentieth Century Fox Television's ("Fox") hit television series "Empire" (the "Empire Series") did not infringe the EMPIRE trademark of Empire Distribution Inc. In so holding, the Court extended the First Amendment protection for titles of expressive works provided under *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) from individual works to an entire series.

The Empire Series, which debuted in January 2015, focuses on the life of a rapper turned music mogul named Lucious Lyon and his music and entertainment company, "Empire Enterprises." Music, including original songs, is heavily featured on the Empire Series, and Fox has marketed soundtracks consisting of songs from the Series.

Empire Distribution is a record label, music distributor, and publishing company founded in 2010. Empire Distribution has released more than 11,000 albums and singles of hip hop, rap, urban, and R&B music, including those of such famous artists as Snoop Dogg, Shaggy, and Busta Rhymes. Empire Distribution uses the EMPIRE mark and EMPIRE-inclusive trademarks EMPIRE DISTRIBUTION and EMPIRE RECORDINGS.

Shortly after the Empire Series began, Empire Distribution sent Fox a letter demanding that Fox discontinue use of the EMPIRE mark in the title of the Series. Fox then brought a lawsuit against Empire Distributions seeking a declaratory judgment of non-infringement. Empire Distribution asserted counterclaims for trademark infringement and related causes of action.

In December 2015, Fox filed a motion for summary judgment on all of the claims and counterclaims in the action. Fox claimed that its use of “Empire” was governed by the rule set forth in *Rogers v. Grimaldi* and adopted by the Ninth Circuit in *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002), which provides that “[a]n artistic work’s use of a trademark that otherwise would violate the Lanham Act is not actionable unless the use of the mark has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless it explicitly misleads as to the source or the content of the work.” *Twentieth Century Fox Television, et al. v. Empire Distribution Inc.*, 2016 WL 685106, at *3, ___ F. Supp. 3d ___ (C.D. Cal. Feb. 1, 2016) (quoting *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008)). Empire Distribution, on the other hand, contended that *Rogers* should not apply in cases involving series titles used as source-identifying trademarks, and that the court should instead apply the likelihood of confusion factors set forth in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979). *See id.*; *see also* Empire Distribution, Inc.’s Memorandum of Points and Authorities in Opposition to Fox’s Motion for Summary Judgment, Case No. 2:15-cv-02158 (C.D. Cal. Jan. 6, 2016). Empire Distribution further contended that in order for the *Rogers* test to apply, the EMPIRE mark should have cultural significance apart from its source-identifying function.

In rejecting Empire Distribution’s push to apply *Sleekcraft* rather than *Rogers*, the court held that “the only relevant legal framework for balancing the public’s right to be free from consumer confusion against First Amendment rights is the *Rogers* test.” *Empire Distribution*, 2016 WL 685106, at *3 (internal quotation omitted). The court further held that no cultural significance inquiry is required under

Rogers, and that the use of a mark can be protected by the First Amendment even if that mark has not transcended its identifying purpose. See *id.* at **3-4.

Applying the first prong of the *Rogers* test, the court disregarded Empire Distribution’s argument that *Rogers* required the junior user of a mark to be referring to the senior user, instead finding that the only requirement was that the title have relevance and not be arbitrarily chosen to exploit the senior user’s mark. *Id.* at **4-5. Judge Anderson found that Fox’s use of “Empire” had artistic relevance to the Empire Series and thus satisfied this inquiry, including because the Series told the story of characters working in and around an entertainment company called “Empire Enterprises” and the Empire Series was set in New York, the Empire State. *Id.* at *4.

On the second prong of *Rogers*, which requires that the junior user’s work not explicitly mislead as to its source or content, Empire Distribution argued that the court should apply a likelihood of confusion analysis under *Sleekcraft* and find that Fox’s use of EMPIRE was likely to confuse the public. In rejecting this argument, Judge Anderson found that “[t]o be relevant, evidence must relate to the nature of the behavior of the identifying material’s user, not the impact of the use.” *Id.* at *6. Accordingly, only an “explicit indication, overt claim, or explicit misstatement” as to the source of the work, and not simple evidence of consumer confusion, is pertinent. *Id.* at **6-7. Because Fox’s title was not “explicitly misleading,” it satisfied this second component of the *Rogers* test as well and Judge Anderson found that Fox was entitled to summary judgment.

As Empire Distribution noted in this litigation, series titles such as “Empire” can assume a traditional, source-identifying role as trademarks even in the absence of secondary meaning, and thus had previously been considered outside blanket First Amendment protection. See, e.g., Empire Distribution, Inc.’s Memorandum of Points and Authorities in Opposition to Fox’s Motion for Summary Judgment, Case No. 2:15-cv-02158 (C.D. Cal. Jan. 6, 2016). The Court ignored this prior distinction, expanding the rule of *Rogers* from single-title works to series titles and potentially making trademark infringement in such titles more difficult to prove in the future.