

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK
MANHATTAN DIVISION

AM GENERAL LLC,

Plaintiff,

v.

ACTIVISION BLIZZARD, INC.,
ACTIVISION PUBLISHING, INC., and
MAJOR LEAGUE GAMING CORP.,

Defendants.

CASE NO. 1:17-CV-08644-GBD

**BRIEF OF INTELLECTUAL PROPERTY LAW PROFESSORS
AS *AMICI CURIAE* IN SUPPORT OF
DEFENDANTS' MOTION FOR SUMMARY JUDGMENT**

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INTEREST OF AMICI¹

*Amici*² are intellectual property professors at law schools throughout the United States who regularly teach and write about trademark law. The professors have no personal interest in the outcome of this case, but share a professional academic interest in guiding the development of trademark law in ways that protect consumers from material deception while still encouraging creativity, free expression, and the public interest.³

SUMMARY OF ARGUMENT

AM General (AMG) claims that trademark law entitles a trademark owner to dictate how its products are depicted in artistic works that seek to realistically represent military activity, and that Activision's artistic mode of realism should be treated as willful infringement because that mode was a choice.

But where the defendant's "product" is an expressive one, like a movie or (here) a video game, courts have consistently read the Lanham Act narrowly in order to avoid suppressing speech that is protected by the First Amendment. *See Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Realism in depiction, without an explicitly false statement of source or sponsorship, cannot be the basis of a valid claim here, whether sounding in trademark or relabeled under another name. Indeed, AMG's argument demonstrates exactly why the First Amendment limits on trademark law set forth in *Rogers* are so essential.

¹ *Amici*'s motion for leave accompanies this brief. No party or party's counsel authored this brief in whole or in part, or contributed money that was intended to fund preparing or submitting this brief. No person other than *amici* or their counsel contributed money that was intended to fund preparing or submitting this brief.

² A full list of *amici* can be found in the Appendix.

³ *Amici* wish to thank Stanford Law School Juelsgaard Intellectual Property and Innovation Clinic Certified Law Student Alyssa Picard for her substantial assistance in drafting this brief.

ARGUMENT

I. Activision’s Video Games Are Expressive Works, for Which There Is a Clear Test for Permissible Trademark Use That Is Easily Fulfilled in This Case.

a. The Supreme Court has held that video games such as *Call of Duty* are expressive works subject to full First Amendment protection.

The fact that this case concerns for-profit video games in no way reduces the First Amendment protections at stake. In *Brown v. Entm’t Merchants Ass’n*, the Supreme Court considered whether California could impose content-based restrictions on the sale and labelling of video games. 564 U.S. 786 (2011). In holding that any such restrictions would need to survive strict scrutiny, the Court recognized that video games were but a new form for the same kind of speech that it had long protected:

[V]ideo games qualify for First Amendment protection. . . . Like the protected books, plays, and movies that preceded them, video games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player’s interaction with the virtual world). That suffices to confer First Amendment protection. . . . And whatever the challenges of applying the Constitution to ever-advancing technology, “the basic principles of freedom of speech and the press, like the First Amendment’s command, do not vary” when a new and different medium for communication appears.

Id. at 790 (quoting *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 503 (1952)).

The *Call of Duty* games, then, are speech protected by the First Amendment. They are sold for profit, like the video games in *Brown*, but they are not “commercial speech” (promotion for some non-expressive product or service)⁴ and are therefore due the highest level of First Amendment protection. *See, e.g., City of Lakewood v. Plain Dealer Publ’g Co.*, 486 U.S. 750, 756 n.5 (1988) (“Of course, the degree of First Amendment protection is not diminished merely because the newspaper or speech is sold rather than given away.”). Because the *Call of Duty* games and their associated user guides are noncommercial speech subject to full First Amendment protection, their content may be regulated only to further a compelling government interest, and

⁴ Commercial speech is usually defined as speech that does no more than propose a commercial transaction. *U.S. v. United Foods, Inc.*, 533 U.S. 405, 409 (2001).

the regulation must be the least restrictive means of serving that compelling interest. *Brown*, 564 U.S. at 799.

b. The Second Circuit’s *Rogers* decision limits trademark protection in expressive works and has been widely and consistently followed.

Recognizing the special constitutional status of non-advertising speech, the Second Circuit has already provided a straightforward solution to avoid the unconstitutional overextension of the Lanham Act: the two-part *Rogers* test, which allows expressive works to make use of trademarks under most circumstances without the threat of liability. In *Rogers v. Grimaldi*, the Second Circuit considered the actress Ginger Rogers’s claim against the producers of the Fellini film *Ginger and Fred*. Rogers argued that the use of her name violated the Lanham Act by creating the false impression that she was involved with or endorsed the film. 875 F.2d at 997. The court recognized both that “Rogers’ name has enormous drawing power in the entertainment world,” such that controlling its use was of value to her, and that movies are “indisputably works of artistic expression and deserve protection.” *Id.* Balancing Rogers’s trademark interests and the speech interests of the film producers, the court concluded that the use of the name “Ginger” in the title and content of the movie had expressive value, the protection of which in noncommercial speech is ordinarily more important than Lanham Act interests: “We believe that in general the Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* at 999. As a result, “[t]he balance will normally not support application of the Act unless [the use of the trademark] has no artistic relevance to the underlying work whatsoever, or if it has some artistic relevance, unless [the use of the trademark] explicitly misleads as to the source of the work.” *Id.* Because use of Rogers’s name was clearly artistically relevant and did not explicitly mislead, the court rejected Rogers’s claim even in the face of survey and anecdotal evidence of consumer confusion. *Id.* at 1001.

Although *Rogers* involved the title of an expressive work, courts have routinely held that *Rogers*’s logic demands the same treatment for content found within an expressive work as well. For example, the Ninth Circuit has already applied the *Rogers* test to the content of video games.

Brown v. Elec. Arts, Inc., 724 F.3d 1235 (9th Cir. 2013); *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (explaining that the *Rogers* test is not dependent on the identifying material appearing in the title but “also appl[ies] to the use of a trademark in the body of the work”); see also *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989) (holding “that the *Rogers* balancing approach is generally applicable to Lanham Act claims against works of artistic expression”).⁵ *Rogers*'s extension to content is only logical. Consumers are even less likely to assume source or sponsorship from the expressive content of a work than they are from its title, diminishing the consumer protection interest at stake. On the other side of the balance, the First Amendment interest in choosing relevant aspects of the world to depict in the substance of a work cannot be less weighty than the interest in choosing a title.⁶

c. The *Rogers* test protects defendants' use of the Humvee trademark and trade dress in the *Call of Duty* video games.

AMG concedes that the Humvee is ubiquitous in the real world and actual military operations and engagements. Yet it seeks to control the depiction of military maneuvers by claiming that the makers of video games have no right to depict realistically any military activity in which soldiers use Humvee vehicles, unless AMG chooses to permit it. AMG is entitled to no such monopoly over reality.

⁵ Indeed, the *Rogers* test has been consistently followed by other courts assessing both titles and other content of expressive, noncommercial speech. See, e.g., *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 329 (4th Cir. 2015) (political speech); *Univ. of Alabama Bd. Of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012) (content of artwork); *Parks v. LaFace Records*, 329 F.3d 437, 451-52 (6th Cir. 2003) (song title); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (song title and content); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665 (5th Cir. 2000) (magazine title); *Dillinger, LLC v. Elec. Arts Inc.*, No. 1:09-cv-1236-JMS-DKL, 2011 WL 2457678 at *4 (S.D. Ind. June 16, 2011) (video game content); *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 339-40 (E.D. Pa. 1996) (film content).

⁶ Notably, while Ginger Rogers's claim focused on use of her name in the title of the film, in fact the film used that name repeatedly in the content of the film—a film that was about characters who imitated Ginger Rogers and Fred Astaire. Rogers apparently did not even contest that use, and the court did not address it—presumably because everyone understood that the First Amendment interests are if anything stronger, and the trademark interests weaker, with respect to content. Indeed, to the extent the court felt the need to balance trademark interests at all, it was because of the unique nature of titles. *Rogers*, 875 F.2d at 998 (“Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker's expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined.”). To suggest that *Rogers* applies only to titles and not to content would be to get *Rogers* nearly backwards.

i. The use of Humvees is clearly of artistic relevance to the games.

The first prong of the *Rogers* test sets only an “appropriately low threshold of minimal artistic relevance,” *Rogers*, 875 F.2d at 999, a standard that Activision’s use in the *Call of Duty* games easily satisfies.

The *Call of Duty* series consists of first-person shooter-style games set in simulated military conflicts. Despite their fictional plots, the games make reference to real countries, real weaponry, real branches of the military, and real ranks and positions for their characters—in short, the games entertain by realistically simulating “modern warfare,” as several entries in the series declare in their titles. Since Humvees are used in modern military operations, their depiction naturally has artistic relevance to the goal of realistically depicting fictional military operations and personnel. The use of a familiar brand to quickly establish aspects of setting or character clearly meets *Rogers*’s “artistic relevance” requirement. *See Brown*, 724 F.3d at 1243 (“Given the acknowledged centrality of realism to EA’s expressive goal, and the importance of including Brown’s likeness to realistically recreate one of the teams in the game, it is obvious that Brown’s likeness has at least some artistic relevance to EA’s work.”). In *Louis Vuitton Malletier S.A. v. Warner Bros. Entm’t Inc.*, the court considered the use of a knock-off Louis Vuitton bag coupled with a character’s humorous mispronunciation of the brand in *The Hangover: Part II*. 868 F. Supp. 2d 172, 178 (S.D.N.Y. 2012). In concluding that the use met the “low threshold” of artistic relevance, the court noted that it is “because the public signifies Louis Vuitton . . . with luxury and a high society lifestyle” that the brief scene is able to effectively portray the character as “snobbish” and “socially inept and comically misinformed.” *Id.* In employing the Humvee trademark in their games and strategy guides for the games, Activision is similarly employing an effective symbol for realistic, modern warfare.

Not surprisingly, then, the Humvee is widely used in other works to evoke familiar military settings and situations.⁷ In films like *Vice* (Annapurna Pictures 2018) and *The Hurt Locker*

⁷ The following paragraph relies on a search on the Internet Movie Cars Database. See IMCDB: Internet Movie Cars Database:

(Summit Entertainment 2008), depictions of the Humvee add to historical realism. In the satirical television series *Veep* (HBO 2012-2019), the vehicle’s appearance assures us that while the foul-mouthed politicians of the show are fictional, the country they squabble over is recognizably our own. Humvees crop up regularly in superhero movies, too—however fantastic the story or characters, it seems that no save-the-world plot is complete without the U.S. military and its equipment making an appearance. *See, e.g., Deadpool 2* (Twentieth Century Fox 2018); *Justice League* (Warner Bros. Pictures 2017); *The Avengers* (Marvel Studios 2012); *The Dark Knight* (Warner Bros. Pictures 2008); *The Incredible Hulk* (Marvel Studios 2008). Animated versions of the vehicle have even appeared in *The Simpsons* (Twentieth Century Fox Television 1989-2019) and *South Park* (South Park Studios 1997-2019). Of course, this only scratches the surface. The “Internet Movie Cars Database”—a website dedicated to cataloging the makes and models of cars appearing in movies and television shows—shows that over one thousand works have depicted some model of Humvee.⁸ The Humvee is useful cultural shorthand for creators, and one that is clearly of artistic relevance to Activision’s games.

Activision suggests, in its own defense, that the Humvee does not feature greatly in the games’ narrative, and AMG may use this argument to contend that there is no compelling need to depict the Humvee. But for constitutional purposes, the prominence of the Humvee is irrelevant, and the court need not make a finding about the Humvee’s role in the game beyond the minimal finding of artistic relevance. *See VIRAG, S.R.L. v. Sony Comput. Entm’t Am. LLC*, 699 Fed. Appx. 667, 668 (9th Cir. 2017) (“Sony’s use of the VIRAG trademark furthers its goal of realism, a legitimate artistic goal, . . . and therefore satisfies the requirement that Sony’s use of the trademark have ‘above zero’ artistic relevance to the Gran Turismo games.”); *E.S.S.*, 547 F.3d at 1100 (noting that the game at issue need not be “about” the trademark owner or its product and that “the level

<https://www.imcdb.org/search.php?resultsStyle=asList&%20sortBy=0&make=&model=HMMWV&page=3>;
<https://www.imcdb.org/search.php?resultsStyle=asList&%20sortBy=0&make=&model=HMMWV&page=2>;
<https://www.imcdb.org/search.php?resultsStyle=asList&%20sortBy=0&make=&model=HMMWV&page=1> (last visited June 1, 2019).

⁸ It is possible that some of these uses may have been licensed, but that would not change that these uses illustrate the artistic relevance of depicting Humvees in a variety of settings, both realistic and imaginative.

of relevance merely must be above zero”). If this case concerned a realistic video game centered around building the Humvee and putting it through its paces, the game would remain fully constitutionally protected expression as long as it did not explicitly misrepresent the source of the work (*Rogers* prong two). The level of prominence of the Humvee in the narrative—whatever that level is—does not affect the test’s application. *Rogers*, 875 F.2d at 999-1000 (noting that while a biography explicitly and falsely labeled “authorized” could be actionable, a biography merely using the subject’s name and possibly implying authorization would not). *Cf. Bouchat v. Baltimore Ravens Ltd. P’ship*, 737 F.3d 932, 944-45 (4th Cir. 2013) (explaining that corporations should not control “depiction of history” through asserting copyright over logos).

ii. Activision’s use of the mark is not explicitly misleading.

Where the use of a trademark has some artistic relevance, as it does here, *Rogers* provides that the Lanham Act can be applied *only* if the use of the trademark “explicitly misleads as to the source of the work.” But where the “artistic relevance” test set a low bar, this exception sets a high bar. As the Second Circuit has noted, it is not enough that a likelihood of confusion exists—in light of the First Amendment concerns at stake, this finding must be “particularly compelling.” *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993). With this heightened bar in mind, analysis as to whether Activision explicitly misleads cannot merely collapse into the ordinary application of the *Polaroid* factors. *Rogers* did not simply reincorporate the *Polaroid* factors into the second prong of its test.⁹ Activision never explicitly misleads, as at no point does it state that AMG was affiliated with the video games in which the Humvee appears.

⁹ As the Second Circuit has noted: “The *Polaroid* test has its origin in cases of purely commercial exploitation, which do not raise First Amendment concerns. Thus, the *Polaroid* test is at best awkward in the context of [work which] constitutes original expression.” *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub’g Grp., Inc.*, 886 F.2d 490, 495 n.3 (2d Cir. 1989). *Polaroid* analysis in expressive works cases—albeit sensitized to look for a “particularly compelling” likelihood of confusion—has only been applied when the trademark for an expressive work is pitted against another expressive work, where the trademarked matter used could perform similar functions for the plaintiff and the defendant. *See, e.g., Yankee Publ’g Inc. v. News America Publ’g Inc.*, 809 F. Supp. 267, 274-75 (S.D.N.Y. 1992). Where, as here, the plaintiff’s mark is a mark for ordinary consumer goods or services and the defendant is depicting that mark in an expressive work, the First Amendment interests in preserving the creator’s freedom to make choices about what to depict and how to depict it require the strong medicine of *Rogers*.

Activision never makes an explicitly misleading statement as to the source of its games. AMG nevertheless tries to argue the following theory of how it might still mislead: by Activision visibly using the Humvee in the *Call of Duty* games, while including a paragraph in its user guide that makes a general reference to intellectual property owned by Activision “or its licensors.”¹⁰ This paragraph, AMG contends, implies that Activision licensed the use of the Humvee trademarks and trade dress from AMG. But if the bare use of a trademark in an expressive work plus general references to intellectual property rights were tantamount to an “explicit” claim about source or affiliation, then “explicit” would lack any meaning. Indeed, courts have demanded much more in the past. *See, e.g., Brown*, 724 F.3d at 1245 (“It is well established that the use of a mark alone is not enough to satisfy [the explicitly misleading] prong of the *Rogers* test.”); *Univ. of Ala. Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1279 (11th Cir. 2012) (similar); *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*, 74 F. Supp. 3d 1134, 1144 (N.D. Cal. 2014) (use of mark in promotional materials for video game was not explicitly misleading where actual source of game was clear).

Activision’s phrasing in its user guide is not explicitly misleading: it does not state that AMG was sponsoring or was affiliated with Activision’s use of the Humvee. In fact, it does not mention AMG or the Humvee at all. The closest the user guide comes is simply acknowledging that the games “contain[] certain licensed materials”—hardly an explicit statement that AMG was a licensor. At best, this is ambiguous or implicitly misleading, and requires the reader to draw a significant inference. But the Second Circuit definitively excluded statements that require an inference from being considered explicitly misleading: The *Rogers* test “insulates from restriction

¹⁰ As reproduced in AMG’s complaint, the Agreement reads:

OWNERSHIP. All title, ownership rights and intellectual property rights in and to this Program and any and all copies thereof (including but not limited to any titles, computer code, themes, objects, characters, character names, stories, dialog, catch phrases, locations, concepts, artwork, animation, sounds, musical compositions, audio-visual effects, methods of operation, moral rights, and any related documentation, incorporated into this Program) are owned by Activision or its licensors. . . . This Program contains certain licensed materials and Activision’s licensors may protect their rights in the event of any violation of this Agreement.

Compl. 35, ECF No. 1.

titles with at least minimal artistic relevance that are ambiguous or only implicitly misleading.” *Rogers*, 875 F.2d at 1000.

In theory, some *Call of Duty* consumers might wrongly assume that everything identifiable in the game was licensed, based on a false belief that all depictions of trade dress require licensing. But when fully First Amendment-protected speech is at issue, that consumers might be misled by ambiguity or background beliefs does not suffice.¹¹ As a result, any evidence going merely to implicit misleading and likely confusion is not relevant. *See Rogers*, 875 F.2d at 1001 (rejecting the reliance on survey evidence showing that the public did tend to misunderstand *Rogers*’s involvement in the film, because that misunderstanding was “not engendered by any overt claim”); *see also Brown*, 724 F.3d at 1245 (holding that survey evidence showing that the majority of consumers believe that identifying marks cannot be included in games without permission “changes nothing” in the *Rogers* analysis without the defendant explicitly misleading). In the absence of Activision explicitly misleading as to source, the *Call of Duty* games (and ancillary materials) pass the second requirement of *Rogers*.

II. Despite the Repackaging of Trademark Claims Under Different Causes of Action, the Underlying Issue Still Concerns the Use of a Protected Mark in an Expressive Work and the First Amendment Protections Remain Unchanged.

The body of law surrounding the First Amendment’s interaction with trademark is well-established and non-controversial. Perhaps this is why AMG includes additional causes of action. But these causes of action do not allege any distinct wrongful acts. They merely “replead and

¹¹ Courts’ treatment of this distinction between explicit and implicit statements in Lanham Act § 43(a)(1)(B) false advertising cases is consistent with the treatment of ambiguity in *Rogers*, and can further guide the analysis here. As the Eight Circuit has explained:

The greater the degree to which a message relies upon the viewer or consumer to integrate its components and draw the apparent conclusion, . . . the less likely it is that a finding of literal falsity will be supported. Commercial claims that are implicit, attenuated, or merely suggestive usually cannot be characterized as literally false.

United Indus. Corp. v. Clorox Co., 140 F.3d 1175, 1181 (8th Cir. 1998). *See also SmithKline Beecham Consumer Healthcare, L.P. v. Johnson & Johnson-Merck Consumer Pharm. Co.*, No. 01 Civ. 2775(DAB), 2001 WL 588846, at *8 (S.D.N.Y. June 1, 2001) (holding that ads with “several plausible meanings” are not explicitly false); *Weight Watchers Int’l, Inc. v. Stouffer Corp.*, 744 F. Supp. 1259, 1282 (S.D.N.Y. 1990) (holding that alleged misrepresentation about Weight Watchers was not explicit because Weight Watchers was not mentioned in the challenged statement on the product package).

incorporate” the same allegations that supposedly amounted to trademark infringement. Compl. *passim*, ECF No. 1. This cannot be enough to evade the protections of the First Amendment.

AMG has made millions of dollars from selling vehicles to the military and now, like many a well-known entity, wants to control public perception about it even when no false statements are at issue. It should not be allowed such control, any more than any other well-known entity is.

a. AMG should not be able to suppress protected speech by disguising its causes of action under different names.

Rogers’s strong First Amendment protections for non-advertising speech cannot be evaded by labels. Fundamentally, creators have a First Amendment right to make nondefamatory portrayals of people, objects, beloved (or hated) institutions, and other things they see in the world or find in its history. Without strong First Amendment protections built to withstand creative pleading, creators could not depict or comment on the world—with all the inevitable inaccuracies that any individual artistic vision produces—with freedom in artistic judgment.

For that reason, in an analogous context, the Supreme Court has been careful to preclude claims against noncommercial speech that attempt to evade defamation law’s strict requirements. *See, e.g., Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 56 (1988) (finding the First Amendment would bar plaintiff’s intentional infliction of emotional distress claim, since it would have barred a defamation claim).

Courts have uniformly followed suit in looking to the substance rather than the label of the claims in assessing whether alleged reputational harm can be redressed in light of the First Amendment. As the Sixth Circuit put it, “Following the Supreme Court’s lead in *Falwell*, the circuit courts have likewise imposed the actual-malice standard on other tort claims predicated on defamatory speech, recognizing that ‘a plaintiff may not avoid the protection afforded by the Constitution . . . merely by the use of creative pleading.’” *Compuware Corp. v. Moody’s Investors Servs., Inc.*, 499 F.3d 520, 530 (6th Cir. 2007) (quoting *Beverly Hills Foodland, Inc. v. United Food and Commercial Workers Union, Local 655*, 39 F.3d 191, 196 (8th Cir. 1994)). *See also, e.g., Jefferson Cty. Sch. Dist. No. R-1 v. Moody’s Investor’s Servs., Inc.*, 175 F.3d 848, 856-58

(10th Cir. 1999) (tortious interference); *Unelko Corp. v. Rooney*, 912 F.2d 1049, 1057-58 (9th Cir. 1990) (product disparagement, trade libel, and tortious interference); *Smithfield Foods, Inc. v. United Food and Commercial Workers Int'l Union*, 585 F. Supp. 2d 815, 820-21 (E.D. Va. 2008) (“[I]f a plaintiff seeks damages which are ‘reputational’ in nature, constitutional libel standards (i.e., falsity and actual malice) apply to the plaintiff’s damage claims. To allow otherwise would be to countenance ‘an end-run around First Amendment strictures.’ . . . [T]he label of the claim is not dispositive” (quoting *Food Lion, Inc. v. Capital Cities/ABC, Inc.*, 194 F.3d 505, 522 (4th Cir. 1999))).

In all of these cases, the plaintiff allegedly suffered reputational harm—just as AMG has alleged here—and sought to control the way it was spoken about or depicted. But courts looked past the plaintiff’s labels and protected the defendant’s speech. In the same way, when the First Amendment protects the speech at issue from a trademark claim, the plaintiff here cannot just repackage reputational concerns and relabel its claim to get around the defendants’ right to speak freely about the world. With all of its claims, AMG really seeks the right to control the use of its trademark in an expressive work. The *Rogers* doctrine has incorporated in trademark law clear limitations on such claims to protect First Amendment rights; those limitations must survive any relabeling of the claim.

b. The false advertising claims concern the same underlying acts as the trademark ones and are subject to the same speech-protective limits.

Aside from its claims for trademark infringement, AMG also includes two claims for false advertising under federal and state law as its Seventh and Eleventh Causes of Action. But these causes of action, too, still depend on trademark theories. The way in which Activision is allegedly falsely advertising is by using the Humvee trademark and trade dress within the *Call of Duty* game and related materials, which AMG suggests will confuse consumers by making them believe Activision licensed use of the marks. If using the Humvee mark in this way is protected by the First Amendment when styled as a trademark cause of action, as it must be, then merely changing the label on the cause of action cannot be enough to circumvent the First Amendment. *Cf. Parks*

LLC v. Tyson Foods, Inc., 863 F.3d 220, 227 (3d Cir. 2017) (rejecting false advertising claim that “depend[ed] upon the purported false association between [defendant’s] brand and [plaintiff’s] mark”); *Ebony Media Operations, LLC v. Univision Commc’ns Inc.*, No. 18-cv-11434-AKH (S.D.N.Y. June 3, 2019) (rejecting false advertising claim based on allegedly misleading use of plaintiff’s trademark in news reporting).

Even if these causes of action are not considered merely repackaged trademark claims, false advertising has additional requirements not satisfied here. One requirement is that the challenged conduct be in “commercial advertising or promotion,” which *Call of Duty* is not. 15 U.S.C. § 1125(a)(1)(B) (2018); see *Fashion Boutique of Short Hills, Inc. v. Fendi USA, Inc.*, 314 F.3d 48, 56, 57-58 (2d Cir. 2002) (holding that § 1125(a)(1)(B) requires commercial speech that is disseminated sufficiently widely to the relevant purchasing public to constitute an organized campaign to penetrate the market). Furthermore, false advertising also requires that the falsity or misleadingness be material to consumers. *Nat’l Basketball Ass’n v. Motorola, Inc.*, 105 F.3d 841, 855 (2d Cir. 1997). The New York state law false advertising claim requires a similar showing of materiality. *Merck Eprova AG v. Brookstone Pharm., LLC*, 920 F. Supp. 2d 404, 426 (S.D.N.Y. 2013). No reasonable jury could determine that whether AMG licensed the Humvee’s appearance in the *Call of Duty* games or not affects reasonable consumers’ decisions about whether to buy the games. These are crucial limitations on a cause of action for false advertising—after all, these are federal and state statutes designed for consumer protection, not for assessing the truthfulness of art in all circumstances.

c. The dilution claims do not apply to the conduct at issue, and in any case cannot survive First Amendment scrutiny.

The other attempt AMG makes to avoid *Rogers* is through trademark dilution claims, under federal and state law, in its Eighth and Twelfth Causes of Action. As with its false advertising claims, AMG simply cannot meet the requirements for a dilution claim: dilution does not cover referential uses in video games like these. But even if a dilution claim could find any purchase

here, the First Amendment would prevent its extension to nondefamatory depictions in fully protected, non-advertising speech.

i. Referential uses do not dilute.

Definitionally, dilution does not cover Activision's use of the Humvee mark because its use is merely referential, rather than being commercial use as a separate mark for a different good or service. Dilution by blurring is "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." 15 U.S.C. § 1125(c)(2)(B) (2018). The idea is that consumers are not confused by two similar marks such as Delta Dental and Delta Airlines, but the plaintiff's mark becomes "less unique." The analysis "must ultimately focus on whether an association, arising from the similarity between the subject marks, impairs the distinctiveness of the famous mark—that is, the ability of the famous mark to serve as a unique identifier." *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 434 (S.D.N.Y. 2016) (citing *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 736 F.3d 198, 204 (2d Cir. 2013)) (internal quotation marks omitted). But if all the defendant does is remind the audience of a famous mark, this only tends to reinforce, rather than weaken, the distinctiveness of a mark, and there is no blurring. For example, where eBay used "Tiffany" without Tiffany's permission to advertise that it sold Tiffany products, there was no second mark or product (no second "Tiffany") with which Tiffany could be blurred, and thus no dilution under state or federal law. *Tiffany (NJ) Inc. v. eBay Inc.*, 600 F.3d 93, 111-12 (2d Cir. 2010). Because all Activision does here is refer to Humvees exactly as AMG makes them—as military trucks and utility vehicles famously used by the U.S. military—its use is referential and cannot dilute AMG's mark.

ii. Noncommercial uses do not dilute.

Even if the definitional issue were set aside, though, the First Amendment bars the application of dilution here, just as it limits the other causes of action.

The federal dilution statute, 15 U.S.C. § 1125(c)(3)(C) (2018), excludes "noncommercial" uses, relying on the First Amendment's definition of noncommercial speech, which extends to

non-advertising expression such as the video games at issue here. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905-06 (9th Cir. 2002) (interpreting statutory language that, while since reformulated, retains the “noncommercial” exemption unchanged).

State law dilution has the same limit, possibly as a matter of constitutional avoidance. *See Louis Vuitton*, 868 F. Supp. 2d at 184 (dismissing New York dilution and unfair competition claims against a fictional film where *Rogers* protected the film); *see also L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 32 (1st Cir. 1987) (“It offends the Constitution . . . to invoke the [Maine] anti-dilution statute as a basis for enjoining the noncommercial use of a trademark by a defendant engaged in a protected form of expression.”); *Yankee Publ’g Inc. v. News America Publ’g Inc.*, 809 F. Supp. 267, 282 (S.D.N.Y. 1992) (“[T]he same First Amendment considerations that limit a cause of action under the Lanham Act apply also to a cause of action under New York law.”).

These limitations on both the federal and state statutes are sensible, as they stop dilution claims from inhibiting fully First Amendment-protected noncommercial speech. Because video games are noncommercial speech, this is enough to render the dilution claims inapplicable to Activision’s use of the Humvee here.

iii. To allow dilution claims against the noncommercial speech of a video game would create a serious First Amendment conflict.

Finally, even if a claim for dilution was somehow available based on the facts in this case, it must fail in order to avoid directly conflicting with the First Amendment. A dilution claim would be a claim to control the content of a work, and so must be subject to strict scrutiny. *See Sarver v. Chartier*, 813 F.3d 891 (9th Cir. 2016) (in claim against a movie, applying strict scrutiny to preclude right of publicity claim, which like dilution regulates speech in the absence of confusion). Since there is no compelling interest in regulating usage like Activision’s inclusion of the Humvee in their games and related materials, nor is doing so the least restrictive means for the government to advance any such interest, the First Amendment must limit dilution’s reach.

Even as applied to commercial speech, dilution's restraints on truthful, nonmisleading speech are constitutionally suspect because dilution does not protect consumers and competitors against deception, but rather privileges a trademark owner's preferred meaning for its marks.¹² As Laura Heymann puts it:

A dilution action essentially argues . . . '[W]e have spent a lot of money and effort on telling consumers what they should think about our brand, and the defendant's activities have caused them to think something different.' . . . The brand owner, in other words, is claiming a right to the exclusive mental association with the brand in the minds of the public.

Laura A. Heymann, *Metabranding and Intermediation: A Response to Professor Fleischer*, 12 Harv. Negot. L. Rev. 201, 218-19 (2007).

The Court's analysis in *Matal v. Tam*, 137 S. Ct. 1744 (2017) bolsters the conclusion that a broad interpretation of dilution is constitutionally suspect. The Court held in that case that the prohibition on registering disparaging trademarks constituted unconstitutional viewpoint discrimination. Dilution by tarnishment is the exact same type of "happy talk" provision as the Court struck down, and dilution by blurring is highly similar. Rebecca Tushnet, *Gone in 60 Milliseconds: Trademark Law and Cognitive Science*, 86 Tex. L. Rev. 507, 554-58 (2008); Mark P. McKenna, *Dilution and Free Speech in the U.S.*, Reprise (May 1, 2019) (unpublished manuscript) (available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3352090).

Perhaps AMG is concerned that players of *Call of Duty* will have a view of Humvees after playing the game that is different from the one AMG would prefer. But dilution law cannot be used to prevent consumers from having opinions. The risks to free speech and artistic depictions from such a rule are substantial, and dilution lacks even the counterweight of possible consumer confusion. As the Supreme Court said half a century ago, "we cannot indulge the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in

¹² Dilution was developed in the early decades of the twentieth century, when truthful commercial speech received no constitutional protection. Yet the modern Court has repeatedly emphasized that the traditional categories of unprotected speech cannot be expanded based merely on a legislature's determination of the speech's worth. See *United States v. Stevens*, 559 U. S. 460, 468 (2010).

the process.” *Cohen v. California*, 403 U.S. 15, 26 (1971). At a minimum, courts are not the entities that should be judging the worth of truthful, nonmisleading content.

Dilution law lacks a compelling or substantial interest in suppressing a message merely out of fear that it might lead audiences to think differently, affecting the amount of attention and goodwill a trademark can command. Decades of First Amendment jurisprudence have made clear that in general, there is *no* cognizable interest in fixing meaning or protecting reputations from non-factual, non-falsifiable claims. When the potential harm is a change in third parties’ opinions, defamation law has provided a detailed map of what the law may suppress: false statements of facts alone. Even though nonfactual speech can be effective in changing a reputation, as in *Hustler*, it is not actionable. As with dilution, the interest in protecting reputations is simply not compelling enough to suppress free speech.

Dilution law reflects a paternalism that the Supreme Court has condemned: the fear is that consumers may make the “wrong” decisions because their opinion of or level of attention to a famous mark has changed. But, in the absence of falsity or deception, it is for consumers themselves to make such decisions. Freedom for nonmisleading speech frees speakers and audiences to develop their own value systems and judgments. When we allow trademark law to avoid that fact-based constraint, we are returning to the protection of the powerful against *lèse-majesté*, a concept rejected throughout the rest of First Amendment law. See *Red Lion Broad. Co. v. FCC*, 395 U.S. 367, 390 (1969) (“It is the purpose of the First Amendment to preserve an uninhibited marketplace of ideas in which truth will ultimately prevail, rather than to countenance monopolization of that market . . .”).

It is indeed possible that the free flux of meaning can change the relative economic positions of particular actors in the system. But, as the *Tam* Court made clear, that result is a feature, not a bug, in a system that protects freedom of speech. Dilution represents a disagreement with this core constitutional commitment to communication-driven change. Allowing audiences to choose from a variety of competing meanings, experiences, and opinions is generally a First Amendment value, not a harm to be avoided.

CONCLUSION

The *Rogers* rule recognizes the reality that creators can use a trademark in a work to convey meaning, and that this is not the same as using it to identify the speaker’s own source or sponsorship. AMG is likely correct when it says that the Humvee is “widely recognized” as a successful tactical wheeled vehicle, and that the United States military has relied on them for decades. Compl. 6-7, ECF No. 1. For that reason, the use of the Humvee conveys meaning and adds realism to a simulated military environment—which is part of the entertainment value and expression of Activision’s games. *Rogers* protects artists when they talk about the world in this way.

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CERTIFICATE OF SERVICE

I hereby certify that on June 7, 2019, I caused the foregoing **BRIEF OF *AMICI CURIAE* INTELLECTUAL PROPERTY LAW PROFESSORS IN SUPPORT OF DEFENDANTS' MOTION FOR SUMMARY JUDGMENT** to be served by electronic means via the Court's CM/ECF system on all counsel registered to receive electronic notices.

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