

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLORADO**

MARTY STOUFFER and )  
MARTY STOUFFER PRODUCTIONS, )  
LTD; )

Plaintiffs, )

v. )

NATIONAL GEOGRAPHICPARTNERS, LLC; )  
NGSP, INC.; )  
NGHT, LLC, d/b/a NATIONAL )  
GEOGRAPHIC )  
DIGITAL MEDIA; )  
NGC NETWORK US, LLC; and )  
NGC NETWORK INTERNATIONAL, LLC )

Defendants. )

CASE NO. 1:18-cv-03127-WJM-GPG

**MOTION BY INTELLECTUAL PROPERTY PROFESSORS FOR LEAVE TO FILE  
BRIEF AMICUS CURIAE IN SUPPORT OF DEFENDANTS**

Intellectual property professors Jack Lerner, Mark Lemley, Mark McKenna, and Rebecca Tushnet (“Amici”)<sup>1</sup> move for leave to file a brief as *amici curiae* in support of Defendants’ Motion to Dismiss. The Court should grant this motion because the proposed brief will provide additional information and analysis not found in Defendants’ motion concerning the interaction between trademark law and the First Amendment.

Though this Court has not issued a rule governing briefs *amicus curiae*, Federal Rule of Appellate Procedure 29(a)(3) instructs that amicus briefs should be permitted when the proposed

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<sup>1</sup> As a group of law professors, Amici are neither a corporation nor have parent corporation; no party’s counsel authored this brief in whole or in part, and no party or party’s counsel made a monetary contribution to fund the preparation or submission of this brief.

amici and their proposed brief *amicus curiae* have an adequate interest and a proposed brief that is both desirable and relevant to the appeal. The proposed brief *amicus curiae* would aid the court's deliberative process in these ways.

This case presents an important issue: how to treat trademark claims made against the content of expressive works, including their titles. In its August 20 Order Granting In Part And Denying Without Prejudice In Part Defendants' Motion To Dismiss, the Court created a new test to balance the directives of the First Amendment and the Lanham Act when it comes to trademark disputes. This case will help clarify what approach courts should take when it comes to addressing the balancing needed between the Lanham Act and the First Amendment. Therefore, the outcome of this case will have a significant impact on the evolution of trademark law. Amici believe that their expertise in trademark law may be of assistance to this Court in resolving these important questions.

Amici are scholars with expertise in trademark law who teach, write about, and practice trademark law. Collectively, Amici have published a substantial amount of scholarly work analyzing trademark law. *See, e.g.*, Rebecca Tushnet, *Trademark Law as Commercial Speech Regulation*, 58 S. CAROLINA L. REV. 737 (2007); Rebecca Tushnet, *Truth and Advertising: The Lanham Act and Commercial Speech Doctrine*, TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH (Graeme B. Dinwoodie and Mark D. Janis eds., 2008) (Edward Elgar Press); Mark A. Lemley & Stacey L. Dogan, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L.J. (2007); MARK MCKENNA, EDWARD LEE & DAVID L. SCHWARTZ, *THE LAW OF DESIGN: DESIGN PATENT, TRADEMARK, & COPYRIGHT* (West 2017); Mark McKenna & Shelby Niemann, *2016 Trademark Year in Review*, 92 NOTRE DAME LAW REVIEW ONLINE (2017).

Participation by Amici will not delay the briefing or argument in this case. Amici are filing this brief within seven days after the Defendant's brief was required to be filed,<sup>2</sup> and in accordance with the Court's Practice Standards, the total length of the motion and brief does not exceed fifteen pages.<sup>3</sup> Judge William J. Martinez, Practice Standards, revised 1 December 2008, p. 5-6.

Amici have consulted with counsel for the parties concerning this motion. Defendants neither consent to nor oppose the motion. Counsel for Plaintiffs has not responded to a request Amici made on September 12, 2019 via electronic mail.

Amici respectfully request that the Court grant its motion for leave to file a brief as *amici curiae* in support of Defendants' motion to dismiss and accept for filing the brief submitted with this motion.

Respectfully submitted,

*/s/ Jack I. Lerner*

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<sup>2</sup> This number has been calculated according to Federal Rule of Civil Procedure 6.

<sup>3</sup> This page count does not include the Table of Contents and Table of Authorities.

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## INTRODUCTION

The Court's is entirely correct to be concerned about chilling First Amendment-protected speech. Unfortunately, the factors it articulated in order to implement this concern will have the opposite effect and are disfavored by the vast weight of jurisprudence on this question. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), is the appropriate starting point when the challenged use is not ordinary commercial speech like the labeling of a can of peas, but instead part of an expressive work entitled to the fullest protection of the First Amendment.

## ARGUMENT

**I. The Court's overall framework properly recognized the First Amendment values at stake, but the test it devised to replace *Rogers v. Grimaldi* cannot achieve the Court's stated aims.**

The Court recognized the well-settled principle that the Lanham Act needs a limiting construction to protect First Amendment interests. Order Granting in Part and Denying without Prejudice in Part Defendant's Motion to Dismiss at 24, *Stouffer v. Nat'l Geographic Partners, LLC* (2019) (No. 18-cv-3127-WJM-SKC), 2019 U.S. Dist. LEXIS 140947 \*29 (hereinafter "*Stouffer* August 20 Order"). It incisively explained that, to avoid chilling effects, this test must be readily applicable before trial and, ideally, before a full likelihood of confusion multifactor analysis. *Stouffer* August 20 Order at 25. Similarly, the Court properly recognized that *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003), wrongly limited the idea of artistic relevance in ways that were particularly damaging to nonrepresentational art, and that *Gordon v. Drape Creative, Inc.*, 909 F.3d 257 (9th Cir. 2018), muddied the waters in the Ninth Circuit significantly. *Stouffer* August 20 Order at 26-27.



**A. One can reject *Parks* and *Gordon* without rejecting *Rogers*.**

This Court’s newly derived factors share a fundamental flaw with the *Parks* and *Gordon* tests: they burden artistic expression simply because it also has a motive to attract attention (which is to say, to find an audience). Those two things are not opposites; indeed, they regularly travel together. In *Rogers*, for example, Fellini’s basic motivation was to make a film about two dancers who were called Fred and Ginger—and one sensible way to characterize that motivation is that it at least includes “a desire to tap into Ginger Rogers’s fame” to make the story intelligible. *Stouffer* August 20 Order at 29. Artistic motivation cannot be split into true artistry on the one hand and desire to get attention on the other. Any test that tries to do so both misdescribes how creators work, and bakes incoherence into the inquiry. Worse, it necessarily requires a court to make artistic judgments of the sort a properly formulated rule would be designed to avoid.

**B. A desire to attract attention—as opposed to a desire to engage in commercial deception—is a constitutionally protected motive for speech.**

The First Amendment generally protects the right of speakers to choose their topics and the ways in which they want to speak about those topics. This includes the choice of techniques to attract attention (in nondefamatory ways). *See, e.g., Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185-86 (9th Cir. 2001) (defendant magazine’s use of an altered film photo to “attract attention” as part of use of celebrities to “rev up” its image did not diminish First Amendment protection). At the core of the idea of First Amendment-protected “newsworthiness” is that matters of legitimate public interest attract attention, and attracting attention is a perfectly legitimate goal for a for-profit publication, as for any other speaker. *See, e.g., Messenger v. Gruner + Jahr Printing & Publ’g*, 208 F.3d 122, 126 (2d Cir. 2000) (holding that a use “solely or primarily to increase the circulation” and profits of a newsworthy article is still fully protected; “most

publications seek to increase their circulation and also their profits”) (citing *Stephano v. News Grp. Publ’ns, Inc.*, 474 N.E.2d 580, 585 (N.Y. 1984)); *Jenkins v. Dell Publ’g Co.*, 251 F.2d 447, 451 (3d Cir. 1958) (illustrated magazine article describing high profile crime was within privilege that protected normal news items from claims of tortious invasion of privacy). *See also Brown v. Entm’t Merchs. Ass’n*, 564 U.S. 786 (2011) (holding that video games sold for profit were entitled to full First Amendment protection); *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 761 (1976) (selling for profit does not negate First Amendment protections). This result is a positive good, not an accident or unfortunate consequence of other rules; the First Amendment adopts the principle that the public benefits when there is a wide variety of speech, not controlled by a single authorizer, about topics and people of public interest.

The amended complaint illustrates the problems with treating artistic motives and profit as mutually exclusive. *See* Amended Complaint ¶ 96 (“Defendants’ purpose in utilizing the Wild America Mark, and attempting to capitalize on the Wild America brand was not artistic, it was profit driven. Indeed, the National Geographic Defendants could have chosen dozens – if not hundreds – of other names, but did not.”). As the Court implicitly recognized when noting that Defendants’ titles were highly descriptive of their content, *Stouffer* August 20 Order at 31, there is an obvious artistic reason to choose a descriptive term as a title—and that descriptive term serves an equally obvious marketing function, which is to tell consumers the subject matter of the shows. In short, the artistic and profit-driven motivations are unified. And this situation demonstrates the wisdom of the First Amendment’s protection not just for speakers’ choices of topics, but also for their choices of how to speak about those topics. *See, e.g., Matal v. Tam*, 137 S. Ct. 1744, 1760 (2017) (opinion of four Justices) (“powerful messages can sometimes be conveyed in just a few

words,” meaning that trademarks implicate the First Amendment); *Cohen v. Cal.*, 403 U.S. 15, 26 (1971) (the First Amendment protects the choice of how best to communicate a message); *Pursuing America’s Greatness v. FEC*, 831 F.3d 500, 510 (D.C. Cir. 2016) (title/name is a “critical” way to identify a subject of speech).<sup>4</sup>

Trademark law has always recognized that descriptive terms in particular must be available to multiple speakers to identify the nature of their goods or services. *See, e.g., KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 119 (2004) (trademark law has long protected truthful descriptive uses even in the presence of confusion); *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 544 (1920) (explaining pro-competitive justifications for allowing descriptive use even if some consumer confusion results). Just as plaintiff should be able to communicate the subject matter of his works with a title, so should National Geographic; it should not be required to choose an unhelpful or meaningless name for its show. Stouffer might nonetheless possess narrow rights in his mark—but not because National Geographic lacks “artistic motives” for its choice.

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<sup>4</sup> The alternative would be to ask whether, in the Court’s judgment, there were acceptably similar ways to communicate the same message. But the Tenth Circuit has already recognized that an “alternative avenues” inquiry, while relevant to restrictions on the timing or sound volume of speech, is inappropriate when it starts to hypothesize rewriting the content of the challenged speech. *See Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 971 (10th Cir. 1996) (“Intellectual property ... includes the words, images, and sounds that we use to communicate, and ‘we cannot indulge in the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process.’”) (quoting *Cohen*, 403 U.S. at 26).

Consistent with these principles, trademark law can provide protection for consumers against material deception in purchasing decisions even in the marketplace for expressive works,<sup>5</sup> but it should not provide particular speakers with rights that prevent others from using nonidentical descriptive titles. And the test applied to communicative works should be laser focused on the specific risks of government intervention into the content of communicative works.

**II. Some of the specific factors identified by the Court are inappropriate and contrary to the Court's stated goal of protecting speech.**

In assessing the Amended Complaint, the Court would be better guided by the general principles it articulated to prevent the suppression of expression than by the specific factors it listed, because those factors contradict its aims.

**A. The suggested test and individual factors' overall focus on "motive" as opposed to objective meaning is inherently incompatible with an inquiry that can be performed on a motion to dismiss.**

The Court correctly determined that a standard regularly allowing early dismissal is necessary to protect speakers against chilling effects. *Stouffer* August 20 Order at 24-25; *see also* David A. Han, *Middle-Value Speech*, 91 S. CAL. L. REV. 65, 83 (2017) (explaining that prophylactic rules can be justified "simply to limit the chilling effects on speech that would result from a more complex and nuanced doctrinal structure"); David A. Strauss, *The Ubiquity of*

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<sup>5</sup> One possibility, though unlikely to be relevant on these facts, is a disclaimer requirement. *Blinded Veterans Ass'n v. Blinded Am. Veterans Found.*, 872 F.2d 1035 (D.C. Cir. 1989) (requiring defendant to use reasonable means to prevent confusion but not requiring change of name). Another concurrent possibility is to use false advertising law, *see* Lanham Act §43(a)(1)(B), 15 U.S.C. §1125 (2012), which has a commercial speech requirement and a materiality requirement, to deal with materially and explicitly false titles, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 38 (2003) (explaining that advertising for expressive works could actionably "misrepresent[] the nature, characteristics [or] qualities" of those works even though trademark law should not generally interfere with the subject matter of copyright).

*Prophylactic Rules*, 55 U. CHI. L. REV. 190, 190 (1988) (arguing that courts regularly and legitimately craft prophylactic rules to protect constitutional values).] A standard in which motive is central cannot perform this function. For example, the addition of “private” statements as relevant to motive will allow every plaintiff to argue that discovery should be required, even though private statements cannot possibly deceive consumers. If the objective features of a work do not indicate likely confusion, private intent is irrelevant, as it should be with the Court’s jazz trio example. *Stouffer* August 20 Order at 28.

The Court tried to avoid authorizing too many fishing expeditions by stating that, “to adequately protect First Amendment interests, the objective facts may sometimes excuse further inquiry into the junior user’s subjective motives.” *Stouffer* August 20 Order at 29. But a balancing test with this many factors, so many of them speaking to “motive,” provides no predictability to any speaker, and provides potential plaintiffs an easy way to plausibly threaten a lawsuit and thus to suppress speech. *See, e.g., Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000) (“Competition is deterred ... not merely by successful suit but by the plausible threat of successful suit....”); William McGeeveran, *The Imaginary Trademark Parody Crisis (and the Real One)*, 90 WASH. L. REV. 713, 745-53 (2015) (emphasizing the importance of clear rules that can be applied early in litigation in order to protect speech); William McGeeveran & Mark P. McKenna, *Confusion Isn’t Everything*, 89 NOTRE DAME L. REV. 253 (2013) (same); *cf.* Glynn Lunney, *Trademark’s Judicial De-Evolution: Why Courts Get Trademark Cases Wrong Repeatedly*, 106 CAL. L. REV. 1195 (2018) (explaining that the costs of litigation mean that complex tests for liability in trademark law will inevitably suppress legitimate uses even if those uses would be protected after full-scale litigation).

**B. Any factor examining whether the parties “use the mark to identify the same kind, or a similar kind, of goods or services” is necessarily overbroad.**

The “same kind or a similar kind” factor appears to have been modified from *Gordon*. *Gordon*’s variation of *Rogers*, suggesting that it matters whether the parties are making the same kind of use, is worse than the Second Circuit approach, which applies a First Amendment-sensitive “likely confusion” test to title-versus-title conflicts. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490 (2d Cir. 1989). To say that “same use” cases are more likely to result in liability than “different use” cases is to adopt a special, more liability-friendly rule for title-versus-title conflicts—but it also wrongly expands that approach to other components of a work. For example, Cheerios licenses some publishers to make books featuring Cheerios. *See generally* Zahr K. Said, *Mandated Disclosure in Literary Hybrid Speech*, 88 WASH. L. REV. 419, 427-32 (2013) (exploring the variety of sponsorships in film, television, literature, and other media). This licensing relationship should in no way mean that an unauthorized book about Cheerios, but not explicitly claiming endorsement or sponsorship, should get less First Amendment protection than an unauthorized book about Trader Joe’s Os. The existence of an authorized celebrity biography likewise does not make it more likely that an unauthorized biography infringes a celebrity’s trademark rights. Relatedly, and highlighting the potential for a broadly worded test to chill First Amendment rights, the Court made an error of fact in its earlier opinion when it stated that *Rogers* didn’t involve a competing product or service with which the film might conflict. *Stouffer* August 20 Order at 29. Ginger Rogers’s films were in fact competing products with Fellini’s films, and she adequately alleged that she remained persistently well-known. *See Rogers*, 875 F.2d at 1000-02. Whatever the proper rule for title-versus-title disputes,

courts should not bestow a higher status on trademark owners' strategic decisions to license expressive works.

**C. Any factor that evaluates the quality of the artistic use requires the court to be an art critic.**

The Court incisively analyzed the flaws of *Parks*, including the fact that “incongruity, irrelevance, and randomness can themselves be artistic choices.” *Stouffer* August 20 Order at 29. But to make the quality of the artistic use into a factor is to ensure that the error of *Parks* be repeated and worsened. One man’s vulgarity is another man’s lyric, even among federal judges. *Cohen*, 403 U.S. at 25. The quality of the artistic use also bears no obvious relationship to the question with which trademark law is properly concerned: will consumers be materially deceived to their detriment by the challenged use? The indirect-at-best relationship between artistic quality or technique and consumer confusion makes it even more indeterminate as a factor in a likely confusion test. Setting art criticism aside—as most lawyers should—the core problem with this and other factors is how unpredictable and unprincipled it will makes the overall balance, worsening the uncertainty of a multifactor test by adding deep subjectivity to the factors. *See e.g. Norma Kristie, Inc. v. Okla. City*, 572 F. Supp. 88, 91 (10th Cir. 1983) (“The First Amendment is not an art critic.”); *Hoepker v. Kruger*, 200 F. Supp. 2d 340, 352 (2d Cir. 2002) (“Courts should not be asked to draw arbitrary lines between what may be art and what may be prosaic as the touchstone of First Amendment protection.”); *Hart v. Elec. Arts*, 717 F.3d 141, 154 (3d Cir. 2013) (test that tries to weigh expression against commerciality “is subjective at best, arbitrary at worst, and in either case calls upon judges to act as both impartial jurists and discerning art critics. These two roles cannot co-exist.... [It is improper] for courts to analyze select elements of a work to determine how much they contribute to the entire work’s expressiveness.”).

**D. The addition of a transformativeness factor assessing what “expressive content” the junior user added inappropriately imports copyright considerations into a trademark question.**

The court’s transformativeness factor inappropriately imports copyright considerations into a trademark question. Copyright is the constitutional mechanism by which Congress provides economic incentives for new expression. *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985). Importantly, copyright does not protect short words and phrases of the kind at issue here (and in trademark law generally). U.S. Copyright Off., Circular 33, Works Not Protected By Copyright (2017) (“[S]logans, and other short phrases or expressions[,] cannot be copyrighted”). “Trademark, by contrast, is aimed not at promoting creativity and invention but rather at fostering fair competition.” *Phx. Entm’t Partners v. Rumsey*, 829 F.3d 817, 825 (7th Cir. 2016); *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 216 (2d Cir. 2012) (“[T]rademark law is not intended to ‘protect[ ] innovation by giving the innovator a monopoly’ over a useful product feature. Such a monopoly is the realm of patent law or copyright law, which seek to encourage innovation, and not of trademark law, which seeks to preserve a ‘vigorously competitive market’ for the benefit of consumers.”) (citations omitted). Trademark law is not a substitute for copyright when copyright is unavailable; indeed, the unavailability of copyright counsels against providing trademark protection for the creative aspects of uncopyrightable material. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) (“[I]n construing the Lanham Act, we have been careful to caution against misuse or over-extension of trademark and related protections into areas traditionally occupied by patent or copyright.”) (internal quotation marks omitted).



It is beyond question that the creativity added by Defendants is enough to qualify their television shows for copyright protection. Courts should not further inquire into their artistic merit. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903). According to the Court’s proposed balancing test, however, a factfinder could apparently find that Defendants’ shows, while creative and copyrightable, nonetheless added insufficient creativity to justify the use of the title. Such a new standard for maintaining the boundaries between the public domain and protectable expression would create a deep conflict between trademark and copyright. If the factfinder were allowed to determine that the overlap in the parties’ ideas—a show about American wilderness—is enough to conclude that defendants didn’t add enough of relevance to justify their use of a descriptive phrase, then the distinction copyright makes between ideas and expression would be eviscerated. Courts will inevitably be dragged into the very inquiry *Bleistein* insisted they avoid—not only determining “what is art” but assessing whether the art was creative *enough*. This is contrary to repeated warnings from the Supreme Court that trademark should not be expanded to interfere with the proper boundaries of copyright. *Dastar Corp.*, 539 U.S. at 33-34; *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237-38 (1964); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232-33 (1964).

### **III. Conclusion**

This Court aims to distinguish “a genuine artistic motive” from “a desire to profit from the senior user’s goodwill.” But those are not opposites. As a result, its proposed factors will not do the job of making that distinction. In fact, Amici respectfully suggest that that is not the right distinction to make. The appropriate distinction is between the need to protect a substantial number

of consumers against material deception on the one hand, and the First Amendment right to engage in expression, including expression for profit, on the other.

Speech-protective tests, like the qualified immunity test to which the Court analogized, *Stouffer* August 20 Order at 25, deliberately decline to try to identify every possible bad actor, because of the speech-suppressive costs a plausible threat of suit would impose on legitimate speakers. Prophylactic rules such as the qualified immunity test are required to protect First Amendment interests in free speech. While the Court’s analysis of precedent recognizes this truth, the multifactor balancing test it developed does not. In all cases involving challenges to titles of expressive works, *Rogers* dictates construing the Lanham Act “narrowly” and granting titles “more [First Amendment] protection than the labeling of ordinary commercial products.” *Cliffs Notes*, 886 F.2d at 494-95. Amici respectfully suggest that *Rogers v. Grimaldi* as interpreted by *Twentieth Century Fox TV v. Empire Distribution, Inc.*, 875 F.3d 1192, 1195 (9th Cir. 2017), states the proper rule for analysis of trademark claims against artistic works. *Stouffer* has not justified the suppression of a nonidentical, artistically relevant title.

**IN THE UNITED STATES DISTRICT COURT  
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CASE NO. 1:18-cv-03127-WJM-GPG

v. )  
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NATIONAL GEOGRAPHICPARTNERS, LLC; )  
NGSP, INC.; )  
NGHT, LLC, d/b/a NATIONAL )  
GEOGRAPHIC )  
DIGITAL MEDIA; )  
NGC NETWORK US, LLC; and )  
NGC NETWORK INTERNATIONAL, LLC )  
 )  
Defendants. )

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**CERTIFICATE OF SERVICE**

I hereby certify that I have filed the foregoing MOTION BY INTELLECTUAL PROPERTY PROFESSORS FOR LEAVE TO FILE BRIEF AMICUS CURIAE IN SUPPORT OF DEFENDANTS and proposed BRIEF *AMICUS CURIAE* with the Court’s CM/ECF system, which will automatically serve a copy upon all counsel of record.

This 15<sup>th</sup> day of October, 2019.

*s/ Jack I. Lerner*  
Jack I. Lerner  
California Bar No. 220661  
*Member of the U.S. District Court for the District of Colorado Bar*