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Note: Artistic Relevance in Artificial Intelligence? "Roger" That!

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NOTES

ARTISTIC RELEVANCE IN ARTIFICIAL INTELLIGENCE? "*ROGER*" THAT!

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In an era of technological revolution, artificial intelligence is shocking the legal field with its increasing popularity, power, and potential.[1] The limits of property, personhood, and creativity are in question by both the public and the courts, leaving significant ambiguities in the law.[2] Legal standards regarding the regulation of advanced technologies have raised unique and critical substantive questions for intellectual property rights, particularly that of trademarks, where the traditional purpose is source identification between consumers and goods.

Since the 1989 holding in Rogers v. Grimaldi, the use of trademarks for creative purposes, as a matter of First Amendment jurisprudence, has resulted in a near-perfect track record as an infringement defense.[3] Questions have abounded as to who actually owns the property rights to an artificial intelligence generated work,

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[1] *See generally* WORLD INTELL. PROP. ORG., INTELLIGENT TRADEMARKS: IS ARTIFICIAL INTELLIGENCE COLLIDES WITH THE TRADEMARK LAW? 2, https://www.wipo.int/export/sites/www/about-ip/en/artificial_intelligence/call_for_comments/pdf/ind_revella.pdf (last visited Sep. 18, 2022) (explaining the new approach to humans being replaced by AI technology as a "tectonic shift").

[2] *See generally* INT'L BUREAU OF W.I.P.O., MEETING OF INTELLECTUAL PROPERTY OFFICES (IPOS) ON ICT STRATEGIES AND ARTIFICIAL INTELLIGENCE (AI) FOR IP, WORLD INTELL. PROP. ORG. (2018), https://www.wipo.int/edocs/mdocs/mdocs/en/wipo_ip_itai_ge_18/wipo_ip_itai_ge_18_1.pdf.

[3] *See, e.g.*, Gordon v. Drape Creative, Inc., 909 F.3d 257, 261 (9th Cir. 2018). *See also* Stouffer v. Nat'l Geographic Partners, L.L.C., 460 F. Supp. 3d 1133, 1142 (D. Colo. 2020).

and who gets to claim it as his own artful invention.[4] *This Note advances the position that, due to the ongoing circuit split regarding the infamous Rogers test, the law needs to establish clear boundaries as to ownership in artificial intelligence and once-and-for-all define what it means for a work to be "artistically relevant."*[5]

It goes without saying that artificial intelligence will continue to transform the "trademark ecosystem" and that the law will need to innovate alongside it to keep up with market trends.[6] *Consumers must be able to identify artificial intelligence as its own "being" with its proper creators and sources—the source identifying purpose of a trademark—or intellectual property protection may begin to break down and face disincentives for registration in the first place.*

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[4] Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989).
[5] *See* Stouffer v. Nat'l Geographic Partners, L.L.C., 460 F. Supp. 3d 1133, 1143 (D. Colo. 2020) (describing the *Rogers* test as "'needlessly rigid and [failing] to account for the realities of each situation").
[6] Sonia K. Katyal & Aniket Kesari, *Trademark Search, Artificial Intelligence, and the Role of the Private Sector*, 35 BERKELEY TECH. L.J. 501, 504 (2020).

ARTISTIC RELEVANCE IN ARTIFICIAL INTELLIGENCE? "*ROGER*" THAT!

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INTRODUCTION

From the *Rogers* case came the *Rogers* test ("the Test"), as did a circuit split, which is the subject of this Note.[7] The Test, described in detail below, is a defense to trademark infringement, with trademark law being regulated by the Lanham Act of 1946. If a trademark is used in a manner that is claimed to be "artistically relevant," defendants very likely will not face liability, based on the existing case law. The Test has two prongs. Using and portraying an already-registered trademark (not one's own) is protected unless (1) it has "no artistic relevance" to the underlying work, or (2) it explicitly misleads as to the source or content of the work.[8]

There appears to be two ways forward: either the property laws surrounding artificial intelligence become tighter and more transparent to the public, or the *Rogers* test will need to be, once and for all, addressed by the Supreme Court to define the limits—if any—of what it means for something to be "artistically relevant."[9]

For purposes of this Note, "artificial intelligence" is defined as "the theory and development of computer systems able to perform tasks normally requiring human intelligence, such as visual perception, speech recognition, decision-making, and translation between languages."[10] Artificial intelligence is often used as a type of automatic utility to make product selections (possessing capabilities such as maintaining artificial neural networks and hosting expert systems and robotics) rather than doing so via mere human cognition, which confuses the way a traditional trademark functions.[11]

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[7] Rogers, 875 F.2d at 999.
[8] *Id.*
[9] As stated in *Rogers v. Grimaldi*, 695 F. Supp. 112, 120 (S.D.N.Y. 1988), "[a]s the late Andy Warhol is reported to have stated, '[b]eing good in business is the most fascinating kind of art.'" By this quote, "art" is interpreted to have an incredibly broad meaning, intermingling business as an art in itself.
[10] Ida Arlene Joiner, *Artificial Intelligence*, SCI. DIRECT (2018), https://www.sciencedirect.com/topics/social-sciences/artificial-intelligence#:~:text=Artificial%20intelligence%20is%20the%20theory,making%2C%20and%20translation%20between%20languages.
[11] WORLD INTELL. PROP. ORG., *supra* note 1, at 7.

However, artificial intelligence is not limited to science fiction-style robots, and such technology has snuck into the everyday lives of consumers.[12] This makes for an inquisitive study into who (or what) intellectual property rights belong to, and if secondary use of a trademark through artful creation is considered infringement under the *Rogers* test in commonplace technologies.

A. Where It All Began

The *Rogers* test is a product of *Rogers v. Grimaldi*.[13] In that case, Ginger Rogers and Fred Astaire were considered two of the most famous entertainment industry couples, enjoying the limelight and public recognition, grouped together as "Ginger and Fred." The Appellee-defendants produced and distributed a movie, also by the name of "Ginger and Fred," but with nominal relation to the couple.[14] The question at hand was how to balance the protection of the international recognition for the couple and the right of others to express themselves.[15] Rogers filed suit, seeking permanent injunctive relief and damages for other parties profiting off of *his* name.[16] As stated in the complaint, Rogers claimed the movie title:

> (1) violated section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1982), by creating the false impression that the film was about her or that she sponsored, endorsed, or was otherwise involved in the film, (2) violated her common law right of publicity, and (3) defamed her and violated her right to privacy by depicting her in a false light.[17]

In trademark law, the main way to assess if a trademark has created a distinct commercial impression on the public is by the use of surveys, and such surveys are usually factored in quite heavily to a court's analysis as a primary source of evidence for consumer confusion.[18] Here, however, the risk of misunderstanding by the general consuming

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[12] *Id.* at 6.
[13] Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989).
[14] *Id.* at 996
[15] *Id.* at 999.
[16] Rogers v. Grimaldi, 695 F. Supp. 112, 115 (S.D.N.Y. 1988).
[17] Rogers v. Grimaldi, 875 F.2d 994, 997 (2d Cir. 1989). *See also* Keller v. Elec. Arts Inc., 724 F.3d 1268, 1279 (9th Cir. 2013) (holding that the Rogers test should not apply "wholesale for right-of-publicity claims").
[18] *See* U.S. PAT. & TRADEMARK OFF., TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1212.06(d) (July 2022).

public—in that the survey in this case found that members of the public *would* draw the incorrect inference that Rogers had some involvement with the movie at issue—was outweighed by First Amendment interests. The Second Circuit found it more dangerous to limit freedom of expression instead of following its typical jurisprudence, which would otherwise have, more likely than not, found the survey evidence to weigh in favor of the couple seeking to protect their name recognition.[19] If the point is to not mislead the consuming public, it appears that freedom of expression has surpassed that goal in terms of importance.

Initially, the District Court granted summary judgment to the defendants, explaining that the use of the name in the production title "failed" what is now called the *Rogers* test—as it was considered to be an "artistic expression."[20] Under the Lanham Act, the law does not bar a minimally relevant use of a celebrity's name in the title of an artistic work where the title does not explicitly denote authorship, sponsorship, or endorsement by the celebrity or explicitly mislead as to content.[21] Defendants argued, however, that the use of Rogers' first name *was* an exercise of their artistic freedom of expression under the First Amendment.[22] With such a claim, the plaintiffs had to meet the heavy burden of establishing that the speech at issue was intended, strictly, to mislead and misuse their rights and recognition, and thus, did not fit under the broad category of freedom of speech protection.[23] On appeal, the Second Circuit held that the sponsorship and endorsement of Rogers' claim raised no genuine issue of material fact since the title did not occupy *any* explicitly misleading endorsement. Therefore, it did not fit under the First Amendment category of commercial speech because the title was found to not be serving a commercial purpose, but rather, a First Amendment one since it was more than an "ordinary commercial product."[24] The speech also did not meet the requirements for the commercial speech analysis, which would otherwise fall under the categories of "trade or advertising" or an "advertisement in disguise" for a "collateral commercial product."[25] Ultimately, again, commercial speech as a potential analytical category for artistic expression and

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[19] Rogers v. Grimaldi, 875 F.2d 994, 1005 (2d Cir. 1989).
[20] Rogers v. Grimaldi, 695 F. Supp. 112, 124 (S.D.N.Y. 1988).
[21] 15 U.S.C. § 1125(a).
[22] Rogers, 875 F.2d at 998.
[23] *See* Rogers, 695 F. Supp at 112, 124.
[24] Rogers, 875 F.2d at 1006. *See, e.g.*, Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N. Y., 447 U.S. 557 (1980) (explaining the main framework under which the commercial speech analysis arose).
[25] *Id.*

creation in trademark suits proved to not fit appropriately to the existing law, and plaintiffs could not meet the heavy burden of the sweeping protection for artistic relevance under the original *Rogers* test.

B. Inconsistencies with the Foundations of Trademark Law

Traditionally, trademark law has been based in economic theory and preventing unfair competition. With its roots in Article 1, Section 8, Clause 8 of the United States Constitution, intellectual property protections have historically been an essential right as part of a flourishing marketplace.[26] At the most fundamental level, trademark law is meant to protect what Mark McKenna, a renowned trademark scholar, has described as the goal of modern marketing and branding—to rescue producers from having to compete on price or quality.[27] The use of a mark on behalf of the consumer is "an emotionally-driven choice as well as an economic one."[28] Though protecting commercial fairness, business, and innovation is a special priority for the courts, particularly to further the hallmark of this practice area, courts still struggle with whether to prioritize these principles first, or to prioritize placing such commercial activities under First Amendment jurisprudence, typically the *Central Hudson* analysis.[29]

With artificial intelligence, that struggle intensifies as the law around such technology is so new and still developing, without a clear way to avoid a likelihood of consumer confusion. One could argue artificial intelligence fits more properly, first, under market-based legal analyses since it is strongly grounded in innovating the economic sphere. However, an equally enticing argument might suggest that artificial intelligence, as creations or pieces of technological art and skill, should fall under commercial activities as regulated by the First Amendment. The courts are still considering this issue. Nevertheless, by its efficacy and obvious manufacturing of human ingenuity, thus far, artificial intelligence as an art form finds its legal implications as falling within First Amendment jurisprudence as a sort of artistic "creation," leaving trademark law behind.

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[26] U.S. Const. art. I, § 8, cl. 8.
[27] Mark P. McKenna, *Consumer Decision-Making Theory of Trademark Law*, 98 VA. L. REV. 67, 115 (2012).
[28] Katyal & Kesari, *supra* note 6, at 515.
[29] *See* 2 ANNE GILSON LALONDE & JEROME GILSON, GILSON ON TRADEMARKS § 7.02(1)(6)(C), MATTHEW BENDER & CO. LEXISNEXIS (database updated Sep. 2022); Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N. Y., 447 U.S. 557 (1980).

Because trademark law revolves around the "consumer,"[30] the first step in figuring out where artificial intelligence might legally fall is to understand how, over time, consumers associate the services offered by artificial intelligence with their sources. By looking at the *Abercrombie* case—which provides a spectrum as to how recognizable a mark is within the public mind—trademark examiners will assess the degree to which a particular trademark falls.[31] Outside of that spectrum, a mark might acquire what is known as secondary meaning (also referred to as acquired distinctiveness), meaning a mark becomes so commonplace and recognizable that regardless of where a mark falls on the spectrum, the public still recognizes the mark as indicating a certain source.[32] Thus, to receive protection, a mark must either: (1) fall into the appropriate category of the *Abercrombie* spectrum, or (2) acquire secondary meaning.[33]

In one of the most famous trademark law cases, *Qualitex Co. v. Jacobson Prods. Co.*, the Supreme Court described that:

> [T]rademark law, by preventing others from copying a source-identifying mark, 'reduces the customer's costs of shopping and making purchasing decisions,' . . . for it quickly and easily assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past.[34]

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[30] For a discussion of the "consumer" as the basis of trademark law, *see* U.S. PAT. & TRADEMARK OFF., *supra* note 18, at § 1215.02..

[31] Abercrombie & Fitch Co. v. Hunting World, 537 F.2d 4, 9–11 (2d Cir. 1976).

[32] There are four categories of trademarks: 1. Generic: defines an everyday or general term which everyone has the right to use. Generic marks are not protectable. 2. Descriptive: a mark which describes the goods or services and will be allowed protection if the owner can show secondary meaning. 3. Suggestive: a mark which suggests the quality or attributes of a good or service. Suggestive trademarks are different from descriptive marks in which they don't describe the product, but instead, suggest a feature that requires some thought or perception on the consumer's part. 4. Arbitrary or Fanciful: a fanciful trademark is one that is completely made up, such as Kodak. Fanciful marks are afforded the most protection. An arbitrary trademark is one with common meaning, but the meaning doesn't relate to the goods or services offered. An example is the name Apple for a computer. A computer has no connection to fruit so the mark is therefore arbitrary. *See generally* U.S. PAT. AND TRADEMARK OFF., PROTECTING YOUR TRADEMARK, https://www.uspto.gov/sites/default/files/documents/BasicFacts.pdf (last visited Sep. 23, 2022) (explaining trademark basics and procedures).

[33] U.S. PAT. & TRADEMARK OFF., *supra* note 18, at § 1212.

[34] Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 164–65 (1995) (internal citations omitted).

Until *Qualitex*, conventional mechanisms of source-identification were rather straightforward. Artificial intelligence, however, provides some new challenges because the source of the artificial intelligence itself has invented the concept that itself as a "smart" being is a product or a good, which automatically offers its own services. This confuses what, or who, is the source versus the service under the existing law.

Because trademark law is grounded in principles of competition, and because artificial intelligence is now another source of innovation, all of trademark jurisprudence is facing a never-before-seen challenge and must innovate to keep up with market trends. Over time, such a unique—and confusing—change in source identification will make it quicker for consumers to connect products to their sources via technology. The programming of such technology might be considered an art or software created by its inventor or its artist, or a source identifying entity itself.[35]

C. Passing the Rogers Test with Flying Colors

Under the *Rogers* test for artistic use,

> "the use of a third-party mark in 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 the title explicitly misleads as to the source or the content of the work.'"[36]

With a lack of unanimity as to the interpretation of the words of the Test, courts have taken such ambiguity to mean there is leeway for expressive use in a broad sense. As elaborated in *Gordon v. Drape Creative,* under *Rogers*, the defendant is required to show that the alleged infringing use is technically part of his freedom of expression under the protection of the First Amendment.[37] If the defendant is successful, then the plaintiff faces a heightened burden of proof. The plaintiff must satisfy both the likelihood of confusion analysis and at least one of the two *Rogers* test prongs, which the *Gordon* court restated as:

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[35] Elizabeth Rocha*, Sophia: Exploring the Ways AI May Change Intellectual Property Protections*, 28 DEPAUL J. ART TECH. & INTELL. PROP. L. 126, 145–46 (2018).
[36] Scott Hervey, *The Rogers Test Gets a Remake in Colorado*, JD SUPRA (Apr. 23, 2021), https://www.jdsupra.com/legalnews/the-rogers-test-gets-a-remake-in-7700800/; *see also* Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989).
[37] Gordon v. Drape Creative, Inc., 909 F.3d 257, 264–65 (9th Cir. 2018) (also stating that the use of the *Rogers* Test defense had never failed before).

> When the defendant demonstrates that First Amendment interests are at stake, the plaintiff claiming infringement must show (1) that it has a valid, protectable trademark, and (2) that the mark is either not artistically relevant to the underlying work *or* explicitly misleading as to the source or content of the work.[38]

The above-described *Rogers* test has been recognized in a handful of cases as being dangerously overbroad. In *Gordon*, the court stated that the use of the *Rogers* test defense *never* failed before *Gordon* was decided.[39] Claims for artistic relevance, with such a low bar to support one's claim, pose a threat to the historically sound nature of decades of trademark jurisprudence.[40] "[B]asically, if the level of artistic relevance is more than zero, this is satisfactory."[41]

To prepare for an influx of the inevitably ensuing artificial intelligence over the coming years, trademark law becomes more important than ever, as protecting the rights of innovators is what keeps them innovating. To keep them innovating, the *Rogers* test must be narrowed, and the term "artistic relevance" properly defined in scope.

I. THE CONTROVERSY IN CONTEXT

The *Rogers* test is facially concerning because of its sweeping language for the protection of artistically relevant trademarks. Moreover, it is concerning for the field of artificial intelligence because it poses greater potential for infringement, such as secondary liability issues.[42] *Rogers* applies to more than mere titles of a work or parodies; it carries over to an expansive breadth of creations, productions, and

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[38] *See id.*; *see also* Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc., 868 F. Supp. 2d 172, 178–79, 184 (S.D.N.Y. 2012) (holding that the speech at issue was clearly artistically relevant with no matter being explicitly misleading; the court was willing to use the *Rogers* test even at the motion to dismiss phase).

[39] *See* Gordon v. Drape Creative, Inc., 909 F.3d at 261. *See also* Stouffer v. Nat'l Geographic Partners, L.L.C., 460 F. Supp. 3d 1133, 1142 (D. Colo. 2020) (explaining that *Gordon* is "analytically messy").

[40] "Artistic relevance" applies to more than just titles in trademark law. It can be expanded to cover claims of copyright infringement as well, meaning it has a dangerous scope in that can be considered overbroad. *See* Christian v. Mattel, Inc., 286 F.3d 1118, 1128–29 (9th Cir. 2002).

[41] Hervey, *supra* note 36.

[42] *Secondary Trademark Infringement Liability in the E-Commerce Setting*, USPTO (Aug. 2021), https://www.uspto.gov/sites/default/files/documents/Secondary-TM-Infringement-Liability-Response.pdf.

compositions, which, when not under the umbrella of copyright law, are under the umbrella of trademark law, thus, being subject to traditional trademark rules and practices. When artificial intelligence takes on formerly human tasks such as buyer, searcher, consumer, etc., it has the potential to be considered as using someone else's already-registered mark, otherwise known as secondary infringement. In fact, Kevin Casey helps communicate this dilemma by posing the following question: "[W]hen your Amazon Echo suggests and buys a product for you that infringes a registered trademark or is a counterfeit, does Amazon become a secondary infringer?"[43]

By claiming that artificial intelligence is one's product of artistic expression, however, plaintiffs who have been the victims of infringement may face a higher bar to seek the same remedies in infringement suits. While various intellectual property concerns about this have come before the World Intellectual Property Organization (WIPO), the Secretariat of WIPO uniquely excluded addressing trademarks.[44] What this illustrates is that we are missing sufficient research and scholarship into what the impacts of artificial intelligence are and who will address them. Though most remain optimistic for this circuit split to ultimately be resolved in favor of justice for intellectual property owners, many remain skeptical. "These changes may 'significantly improve the trademarking process' in the future. So far, however, the implementation has been 'suboptimal.'"[45]

A. The First Amendment in Trademarks: Historical Overview

Both intellectual property and First Amendment law have been "inextricably intertwined"[46] for quite some time, but routinely, the Supreme Court has favored First Amendment freedoms over intellectual property exceptions. "Artistic relevance" as a category of creative freedom of expression has a longstanding historical foundation throughout American legal history. Expressive works are subject to special treatment in the law for two primary reasons: "(1) they implicate the First Amendment right of free speech, which must be balanced against the public interest in avoiding consumer confusion; and (2) consumers are less likely to mistake the use of someone else's mark in an

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[43] Kevin R. Casey, *Artificial Intelligence in the Trademark World IP Appeal, Fall 2020*, STRADLEY RONON (Oct. 6, 2020), https://www.stradley.com/insights/publications/2020/10/ip-appeal-fall-2020.
[44] Katyal & Kesari, *supra* note 6, at 504.
[45] Casey, *supra* note 43, at 3.
[46] Rogers v. Grimaldi, 875 F.2d 994, 998 (2d Cir. 1989).

expressive work for a sign of association, authorship, or endorsement."[47] Courts have been habitually skeptical in declaring what is and is not regarded as freedom of speech in trademark cases, as it is onerous to present an argument that seeks higher preference than the very foundation of the Constitution's *First* Amendment.[48] As of now, there is little, if any, precedent on artificial intelligence being fitted within the boundaries of the First Amendment category, which this Note suggests signifies the need for further study to provide sound judgment and guidance when these types of infringement cases inevitably come up in the near future.

1. The Hallmark Cases

One need not look further for a synopsis on where the Court currently stands on these issues than landmark cases *Matal v. Tam*[49] and *Iancu v. Brunetti*.[50]

In *Matal*, decided in 2017, the USPTO denied the trademark application for an Asian band, "The Slants," arguing that it was disparaging under section 2(a) of the Lanham Act's disparagement bar, which, at the time, prohibited registration of marks that may "'disparage . . . or bring . . . into contemp[t] or disrepute' any 'persons, living or dead.'"[51] The Band successfully argued that it was using the term at issue to "reclaim" its negative connotation from popular culture and "'take ownership' of stereotypes about people of Asian ethnicity."[52]

In the tradition of protecting free speech, the Supreme Court held the disparagement bar facially unconstitutional because the clause engaged in viewpoint-based discrimination, and was "not an anti-discrimination clause, [but] a happy-talk clause."[53] Some argued that *Matal* should fall under the First Amendment's commercial speech analytical framework, but Justice Kennedy held this as irrelevant because viewpoint-based discrimination necessarily invokes heightened scrutiny, whether or not commercial speech is targeted.[54] Since the broad clause was held unconstitutional, refusing trademark registration to The Slants was not a plausible outcome. Ultimately, the law now holds that whether

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[47] Hervey, *supra* note 36.
[48] U.S. Const. amend. I.
[49] Matal v. Tam, 137 U.S. 1744 (2017).
[50] Iancu v. Brunetti, 139 U.S. 2294 (2019).
[51] *Matal*, 137 U.S. at 1751; 15 U.S.C. § 1052(a).
[52] *Matal*, 137 U.S. at 1754 (citing *In re Tam*, 808 F.3d 1321, 1331 (CA Fed. 2015)).
[53] *Id.* at 1765.
[54] *Id.* at 1750.

a trademark is disparaging to a subsection of the consuming public has no relation to the purpose of trademark law or registration, which is to facilitate source identification amongst consumers as a component of private speech.[55] Thus, the Slants trademark registered.[56]

Then, two years later in *Iancu*, the Supreme Court held that trademark law allows broad protection of *all* speech, universally covering immoral or scandalous material, a landmark holding for the intellectual property field.[57] In that case, a trademark with the letters "F U C T" was rejected by the USPTO on the grounds that it contained "immoral, deceptive, or scandalous matter" under section 2(a) of the Lanham Act, previously held two years prior to have unconstitutionally disfavored certain ideas.[58] The Court, again, in the tradition of protecting free speech, reasoned that to reject this trademark would be viewpoint-based discrimination. Rather, then, the Court suggested a narrowing of the statute, which could be "reasonably read to bar the registration of only those marks that are obscene, vulgar, or profane,"[59] or those whose "mode of expression" (independent of viewpoint) is particularly offensive. Here too, then, the trademark registered.

In both of these landmark cases, the Court protected First Amendment prerogatives, despite existing trademark regulations which were already in place for many, many years. Thus, throughout this Note, it is important to keep in mind that overcoming a freedom of expression argument is, evidently, incredibly difficult.

B. Sophisticated Consumers as a Setback

Further, the concept of "sophisticated consumers" is a relevant component, for sake of the *Rogers* test application, of the federal *DuPont* factor analysis for likelihood of confusion.[60] A typical "sophisticated consumer" would have prior knowledge in selecting a good or service, and thus have a higher degree of "sophistication" in identifying a product with its source. Machine learning through artificial intelligence can thus blend this factor with new meaning from what it entails for a "sophisticated" consumer to automatically have knowledge of marks and

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[55] *Id.* at 1768.
[56] "The Slants," Registration No. 5332283 (Nov. 2017), https://tmsearch.uspto.gov/bin/showfield?f=doc&state=4807:119h4t.2.6.
[57] Iancu v. Brunetti, 139 U.S. 2294, 2301 (2019).
[58] *Id.* at 2298.
[59] *Id.* at 2317.
[60] U.S. PAT. & TRADEMARK OFF., *supra* note 18, at § 1207..01.;*In re* E. I. du Pont deNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973).

their sources. According to the European Court of Justice, it is assumed that the average consumer is defined as "reasonably well informed and reasonably observant and circumspect."[61] However, now, we are looking at the source itself—the technology—as being sophisticated, easing the effort on behalf of the average consumer. Since the major motivations behind creating artificial intelligence included customer experience, optimizing decision-making, new revenue, efficiency, and cost reduction, moving forward, exactly how a source is identified has become the key question.

As courts grapple with the internet beginning to surpass human judgment in certain areas, consumer sophistication with new technologies may alter what it means for trademark law to actually *encourage* more registrations, if consumers themselves are not really the ones doing the source identification. The conventional doctrines may not be as readily applicable as they once were.

As long as there is an emotional connection between a source and a consumer (the purpose of a trademark), the law remains straightforward and in favor of applicants seeking admission on the Principal Register, but as this Note argues, the law cannot give clear answers here. There is "at least some potential for AI to surpass human judgment and performance when it comes to analyzing and integrating a much wider array of variables in its assessments."[62] Trademark law has always been grounded in economic, consumer-based, demand-side considerations.[63] Trademark infringement, then, has been relatively straightforward, falling primarily under the most common causes of action: likelihood of confusion and dilution.[64] Trademark law *wants* more innovation and registered marks; an initially unregistrable mark, due to its descriptiveness, may, for example, acquire secondary meaning, and be protected if enough consumers come to associate the mark with its source.[65] A "plaintiff need *only* prove . . . that there is an economic interest in her identity, and that her identity has been commercially exploited."[66] This necessitates that the federal *DuPont* factor analysis for

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[61] WORLD INTELL. PROP. ORG., *supra* note 1, at 10.
[62] Katyal & Kesari, *supra* note 6, at 586.
[63] *Id.* at 507.
[64] *Trademark Infringement*, https://law.jrank.org/pages/10850/Trademarks-Trademark-Infringement.html, (last visited Oct. 20, 2022).
[65] Abercrombie & Fitch Co. v. Hunting World, 537 F.2d 4, 9 (2d Cir. 1976).
[66] Rocha, *supra* note 35, at 132 (citing Landham v. Lewis Galoob Toys, Inc., 227 F.3d 619, 624 (6th Cir. 2000)) (emphasis added).

likelihood of confusion, particularly the "sophisticated consumers" prong, will need to be looked at from fresh eyes.[67]

C. Additional "Sophisticated" Setbacks: Personhood

As consumers adapt more and more to the use of creative technologies, the arena for infringement is about to change, especially as artificial intelligence is, literally, wired to make economic decisions in terms of purchases that otherwise belonged to consumers themselves. To emphasize the extent to which this has been taken, for example, the futuristic, stereotypical conception of robots as fully-functioning humans is no longer a distant possibility, but a reality.

Honorary legal personhood has been granted, albeit heavily scrutinized, to "Sophia," a robot created by artificial intelligence.[68] Unsurprisingly, this has raised an influx of alarming questions for the legal landscape. "'[G]enerally consumers place more trust in an independent third party to provide truthful information on quality,' suggesting a role for independent third-party private certification," or here, artificial intelligence itself.[69] Artificial intelligence, in particular forms like the "person" Sophia, might be dismissed for liability because they are now "art forms" generated by scientists. The courts are split already on the *Rogers* test, and the limits to what personhood encompasses are additionally complicated by the creation of other "beings" pushing the boundaries of "personhood." This is interesting to consider given that the name "Sophia" is described as having no doubt in being able to attain secondary meaning required by the USPTO.[70]

Given the inherently subjective nature of consumer emotion and product preference portrayed through survey evidence, trademark law must decide where it stands on this new type of technology. Such a sophisticated invention such as artificial intelligence can easily be deemed a form of expressive art as it has profound, human work going into its formation, which then seeks the attention of the viewer or user.

In effect, artificial intelligence technologies are beginning to make the decisions that previously were the responsibility of consumers themselves, and thus, this changes the entire nature of what it means for trademark owners to relate to consumers.

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[67] *In re* E. I. du Pont deNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973).
[68] Rocha, *supra* note 35, at 133. *See also* Dennis Crouch, *USPTO Rejects AI-Invention for Lack of a Human Inventor*, PATENTLYO (Apr. 27, 2020), https://patentlyo.com/patent/2020/04/rejects-invention-inventor.html.
[69] Katyal & Kesari, *supra* note 6, at 511.
[70] Rocha, *supra* note 35, at 141.

II. WHERE *ROGERS* STANDS TODAY

A. Circuit Split Implications

In application here, as the Second Circuit departed from typical trademark jurisprudence in *Rogers*, the landscape of "artistic relevance" has expanded. Courts are wary to subject trademark users to liability if an artist or creator deems his work as "artistically relevant," which usually comes out in favor of the artist or creator, not the trademark owner. This low bar is especially prevalent in the Ninth Circuit, with the court liberally protecting individuals and artists from corporate business operations.[71] Artificial intelligence's use of trademarks, celebrity names, advertisements, voice recognition, and algorithmic search engine scans, amongst other things, is entering new grounds.

For example, in an expressive use, *Rogers*-like case, *Mattel, Inc. v. MCA Record, Inc.*, the Ninth Circuit held that the use of the *Barbie Girl* song as a parody was considered expressive use.[72] In the parody, no matter the ways the defendant presented plaintiff's mark to the public, the use of the famous *Barbie* doll trademark was held not to constitute infringement of the famous toy company's trademark ownership, even after its fame for many years as a cultural icon. [73] The makers of the parody, under *Rogers* expressive use defense, were not liable for infringement, even though Barbie was recognizable worldwide and sought registration long before the party made the parody.[74] This was the first Ninth Circuit case to adopt the *Rogers* test, a significant action in that the Ninth Circuit has since routinely applied the Test's low artistic-relevance bar, despite the reputational implications for trademark owners.[75]

The tradition of protecting the freedom of expression may have been flipped on its face by the use of the *Rogers* test, creating more implications than necessary. If federal intellectual property registration,

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[71] *See* ACLU of S. Cal., *Victory Over Mattel For Artist and First Amendment*, ACLU (Dec. 29, 2003), https://www.aclusocal.org/en/news/victory-over-mattel-artist-and-first-amendment. *See also* INT'L TRADEMARK ASS'N, ARTIFICIAL INTELLIGENCE (AI) AND THE FUTURE OF BRANDS: HOW WILL AI IMPACT PRODUCT SELECTION AND THE ROLE OF TRADEMARKS FOR CONSUMERS? (2019).
[72] Mattel, Inc. v. MCA Record, Inc., 296, F.3d 894 (9th Cir. 2002).
[73] *Id.* at 908.
[74] *Id. See also* Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC., 507 F.3d 252 (4th Cir. 2007) (protecting the use of a parody of dog toys labeled "Chewy Vuitton" as opposed to the actual famous brand, Louis Vuitton).
[75] *See* Mattel, 296 F.3d at 901–03.

fame, and strong consumer-product association do not protect against infringement, then we run the risk of disincentivizing trademark registration in the first place, especially amongst indecisive circuits.

B. Reigning in Freedom of Speech

With *Matal* and *Iancu* having set the background for seminal First Amendment-trademark-mix cases, we might look to one of the *purposes* of trademark law: the prevention of unfair competition. This has come down to an economic game, one which Tabrez Ebrahim (a leading scholar in intellectual property law, entrepreneurship, and technology) argues is primarily resting on each party's ability to discover relevant information.[76] Such a low bar has opened the door for artificial intelligence technologies to cross the line into unfair business practices with limited, if any, liability for the use of trademarks of already-registered owners.

All that artificial intelligence technology inventors need to do, under *Rogers*, is to explain, under the low bar for the Test, that usage of any trademarks was a mere expression of themselves or their own works. By doing so, those creators will have free range to use trademarks which do not belong to them. This is especially true when applied to modern artificial intelligence, as trademarks are not just mere physical words; they can also be sounds, scents, and colors, all of which are creative and innovative measures used by artificial intelligence to communicate and respond to its user or users to help make purchases. While courts are universally skeptical to inhibit freedom of expression by objectively defining what *is* and *is not* a creative work of art, it would be prudent for courts moving forward to develop a new standard for artistic relevance, especially for emerging technologies.

C. The Expanding Breadth of Related Case Law

By tracing related case law, it is understandable that the crossover between First Amendment law and trademark jurisprudence is a tense intersection for the courts.

First, in *Thaler v. Hirshfield*, while artificial intelligence as a machine was found to not be considered an "inventor" under the Patent Act,[77] the danger of the *Rogers* test in trademark—as opposed to patent—

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[76] *See* Tabrez Y. Ebrahim, *Automation & Predictive Analytics in Patent Prosecution: USPTO Implications & Policy*, 35 GA. ST. U.L. REV. 1185, 1188 (2019).
[77] *See* Thaler v. Hirshfield, 558 F. Supp. 3d 2238 (E.D. Va. 2021).

law does not require such artificial intelligence to *be* the inventor. Rather, the *Rogers* test merely requires that any inventor of the artificial intelligence itself can very likely escape liability by having that inventor's "invention" be "artistically relevant." Therefore, the danger lies in the label of "art," as inventors often find their artificial intelligence technologies to be their own creations; the technology itself does not have to be viewed as an "inventor." In application, the artistic relevance bar is so shockingly low that it just needs to be above zero.[78] Essentially, any plausible, artistic connection is acceptable, and a reasonable consumer should decide so for himself.[79]

Next, the term "explicitly misleading," which is similar to the "intention to deceive" in unfair competition law, actually has a very *high* standard.[80] This can be seen in *Gordon v. Drape*.[81] In that case, the plaintiff made honey badger memes and a card company made greeting cards using those exact same memes.[82] Those cards showed the popular theme of "honey badger not giving a ****," a pop culture phrase used by thousands of users of social media, including generating millions of views on YouTube.[83] The Ninth Circuit held that such printing of the memes was an artistic use designed by the card company, even though the only content of the card was the exact meme itself. The case was remanded for further proceedings, but it is of particular importance here because it *still* applied *Rogers*, making the standard for "explicitly misleading" even higher than it was initially thought to be.[84]

This case can be distinguished from the others, however, because there usually needs to be a very explicit reference—such as the words "sponsored by"—in order to be considered within the "misleading" category. It is not enough that one is simply using the trademark within the work. While the Ninth Circuit described that "[t]he *Rogers* test is not an automatic safe harbor for any minimally expressive work that copies someone else's mark," it simultaneously admitted that "on every prior

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[78] E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1100 (9th Cir. 2008). *See also* Brown v. Elec. Arts, Inc.,724 F.3d 1235 (9th Cir. 2013) (holding that videogame producer, Electronic Arts, Inc. did not infringe on famous professional football player James "Jim" Brown's character likeness in the *Madden NFL* games when it used his avatar, as it was artistically relevant and because the video games were expressive works that were entitled to protection under the First Amendment).
[79] Rock Star Videos, 547 F.3d at 1100–01.
[80] "Explicitly misleading" is a "heightened standard," as recently reaffirmed by the Ninth Circuit in Punchbowl, Inc. v. AJ Press, L.L.C., 2022 U.S. App. LEXIS 31398 (9th Cir. 2022).
[81] Gordon v. Drape Creative, Inc., 909 F.3d 257, 261 (9th Cir. 2018).
[82] *Id.* at 260–261.
[83] *Id.* at 261.
[84] *Id.*

occasion in which we have applied the test, we have found that it barred an infringement claim as a matter of law."[85] Thus, the Ninth Circuit itself admitted that use of the *Rogers* test as a defense continues to enjoy one win after another and could potentially "turn trademark law on its head."[86]

Even though the *Rogers* case is about film titles, the court there was willing to extend the Test to insulate use inside of the body of a work, not just its title.[87] This manifested in *University of Alabama Board of Trustees v. New Life Art*.[88]In that case, the University of Alabama sued an artist who painted convincing, life-like paintings of Alabama Football games. Alabama claimed that the artist was unfairly using its trade dress. [89] If the Alabama paintings had the logo *outside* of the frame, that may have been held to fit within the explicitly misleading framework, but the court held that such paintings fell under the *Rogers* test. This was because paintings were argued to be a sort of artistic work that are centrally recognized, even though the paintings were representational of a famous user's mark. This raises a question about what kinds of artistic uses really fall within the physical boundaries of art pieces and within the metaphorical universe of *Rogers*.

III. NEGATIVE IMPACTS ON UNDERLYING TRADEMARK PHILOSOPHIES & FUNCTIONS

A. Inequitable Incentives

Regardless of the type of infringement committed by artificial intelligence or the degree to which harm results from such infringement, the *Rogers* test should not operate as a winner-takes-all approach, as many courts have already admitted it does. Such a defense that nearly always comes out in favor of the defendant is simply inequitable.

Further, no scientist or inventor should be able to scapegoat infringement with such a sweeping defense. With a ready-made and seemingly "complete" defense available, this removes incentives for those owners to police their trademarks (a requirement for federal ownership), since they could likely claim this defense with no further

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[85] *Id.*
[86] *Id.* at 270.
[87] Rogers v. Grimaldi, 875 F.2d 994, 1005 (2d Cir. 1989).
[88] Univ. of Ala. Bd. of Trs. v. New Life Art, Inc., 683 F.3d 1266 (11th Cir. 2012).
[89] *Id.*; *cf.* Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992) (explaining that a secondary meaning requirement in trade case cases could have anticompetitive effects).

action.[90] It is this type of "legal thinking" that inspires and innovates the economy, but with a sort of "invincibility" defense, market checks cannot be placed on such innovators. This is similar to the process of filing a trademark as per section 15 of the Lanham Act for "incontestability." With section 15 incontestability, a trademark becomes more challenging to dispute as it essentially "earns" its way in with consumers through use and recognition.[91] With this "market incontestability" switched to the other party, however, there arises a strong disincentive for further trademark registration. Either way, the dangerous future of the *Rogers* test could create a powerful disincentive to registration on the Principal Register for all parties involved.

B. An Invasive Search Process

As of now, there are more trademarks in use in commerce than there have ever been.[92] This makes sense especially considering the steady and consistent growth in the American economy—more growth means more entrepreneurs who want intellectual property protection. As part of such innovation, artificial intelligence is used to conduct private trademark searches in order to reduce costs for searches otherwise done manually by individual consumers. This is the primary efficiency aimed at by the use of that intelligence—maximizing usage in the least amount of time and effort. Practically, artificial intelligence has become responsible for initial trademark search results and scanning the cost of searches regarding trademark selection, supply, and quality, all while focusing heavily on the demand-side of consumers.[93]

Customarily, a trademark word search in a database—namely the United States Patent and Trademark Office's ("USPTO") Trademark Electronic Search System (TESS)[94]—is a quite straightforward way to verify the existence of other registered marks. When looking for which trademarks have already been registered, trademarks in the TESS search-context have conventionally relied on character-based technology to find similar marks. This is especially interesting to note considering that trademark rights and protections have been cited as the most

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[90] *See generally* McKenna, *supra* note 27, at 117, 139 (discussing the policing of marks that deceive the preferences of consumers).
[91] U.S. PAT. & TRADEMARK OFF.,*supra* note 18, at § 1605. .
[92] Katyal & Kesari, *supra* note 6, at 506.
[93] *See id.* at 510.
[94] *Id.* at 558.

important type of intellectual property protection.[95] With the introduction of artificial intelligence, however, trademark searches have been expanded to include phonetic analogies, synonyms, and related permutations of letters.[96] "Other approaches rely on a constellation of comparisons—such as automated similarity assessments of image/pixel, text, and content."[97] These categories all have the possibility of becoming labeled as "art," whether such art be framed as a creation, production, or composition, if for nothing but for the fact that computer coding is a form of an individual's creativity. This massive increase in ability to search for and advertise different trademarks, while impressive, simultaneously raises the risk of potential infringements.

Despite its convenience, artificial intelligence, as technologically advanced as it is and will continue to be, may not be able to distinguish between marks that truly are in use in commerce and those that are merely *claiming* use but are not actually used in commerce. For trademark examiners at the USPTO, it might then potentially consider a mark "dead" or "abandoned" if it is no longer being used in a clear fashion, even if artificial intelligence finds some usage in a unique form.

There are some things that simply cannot take the place of the human brain, such as the ability to search for a mark on TESS and see its registration status as in use or not. With a high chance for confusion between marks both in and not in actual use in commerce, it poses the question: why even make the distinction at all? To not do so might even open the possibility of free-riding activity or variations on the explicitly misleading standard, altering the entire trademark system that is supposed to be based around the opposite: distinctiveness.[98]

C. Artificial Intelligence as a Creationist: A Mark of Creation Itself

The creation itself, here the artificial intelligence, is the "trademark" at issue. It is no longer the inventor and his trademarked brand name, but widespread, popular intelligence, such as Apple's Siri or

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[95] *See Trademarks, Copyright and Patents: Should Business Owners Really Care About IP?*, VARNUM (May 1, 2019), https://www.varnumlaw.com/newsroom-publications-trademarks-copyrights-and-patents-why-business-owners-should-care-about-ip ("A trademark is one of the most important business assets that a company will ever own because it identifies and distinguishes the company and its products/services in the marketplace from its competitors.").

[96] Katyal & Kesari, *supra* note 6, at 523.

[97] *Id.* at 524.

[98] *Id.* at 514. *See also* WORLD INTELL. PROP. ORG., *supra* note 1, at 5, 9.

Amazon's "Alexa," which might be able to be trademarked as an almost intermediary mark. A trademark is not limited to mere word choice, but the "packaging" of it, and the emotional bond it creates with the public.[99] Such "packaging" has the potential to be found false or misleading under Section 43(a) of the Lanham Act.[100] To hold this would mean that the aforementioned robot Sophia is seen as a mark itself, as it is considered "packaging."

If this "electronic personhood" is art itself, the creation of this quasi-"life" would be hard to challenge in court under traditional concepts of personhood.[101] "The government's recognition of Sophia (the robot) would create the front of mind connection needed for secondary meaning."[102] *Abercrombie* held that a mark categorized as generic still cannot receive protection, even if the mark proves to have secondary meaning.[103] Such recognition of artificial intelligence as beyond merely generic but also possessing the necessary secondary meaning tips the *Abercrombie* spectrum is favor of trademark protection. To have another "being" make the front of mind connection and therefore diminish the human function for source recognition between "human" and product, alters commercial impression, a discriminating factor of the *DuPont* analysis.[104] It logically follows that more and more trademarks would then enter the marketplace with the influx of more and more artificial intelligence in aspects of everyday life. The USPTO cannot, of course, register every single mark. "Because of these gaps, several private trademark search engines have emerged to supplement TESS, using machine learning to provide more thorough results."[105] Such action is circular, however, and we might be left, then, with a higher rate of registration refusals since the system would be inundated with so many more marks.

There may also begin to develop an overreliance on the conveniences of artificial intelligence, resulting in an inaccurate ability for consumers to utilize their rational judgments, particularly in distinguishing what is considered "art." Artificial intelligence-driven tools might contribute to false positives for likelihood of confusion determinations since the created technology might not be as sound, nor as fast, as human judgment calls, especially in the markets that a

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[99] LALONDE & GILSON, *supra* note 29, at § 2A.01.
[100] *Id.* at § 7.02 n. 110.156.
[101] Rocha, *supra* note 35, at 129.
[102] *Id.* at 141.
[103] Abercrombie & Fitch Co. v. Hunting World, 537 F.2d 4, 9 (2d Cir. 1976).
[104] *In re* E. I. du Pont deNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973).
[105] Katyal & Kesari, *supra* note 6, at 506.

consumer is already familiar with.[106] "Given the large number of marks that are *not* in use, but which remain registered or may be unregistered, there is also a risk that assessments may not reflect the reality of the existing marketplace."[107] Given that trademark law is based in laws aiming to prevent unfair competition in the *marketplace*, to run the risk of a misunderstood market would be detrimental to source identification—the end goal.

D. Confusing the Likelihood of Confusion

Another implication of the *Rogers* test in artificial intelligence is that the use of names, sources, or companies advertised through screens, new visual shopping experiences, and through voice recognition will undoubtedly cause confusion amongst consumers, and not just intellectual property confusion. Such multi-layered understandings of a mark and its source are a type of "signaling within advertising,"[108] which might even "surpass human judgment and performance."[109] This means that it would be difficult to know the true usage or livelihood of the presented marks in any given case. The District Court in *Rogers*, by contrast, held the relevance of "Ginger" in the movie title at issue was clear to the consumer on two levels. As explained by the court, "[f]irst, the title accurately refers to the fictionalized nicknames of the Film's two central characters. Second, the screenplay establishes the reference to Rogers and Astaire as the basis for the Film's characters' livelihood."[110] For these reasons, this was recognized as a known element of "modern culture."[111] However, it is a whole new challenge to jump from consumers' understanding of a movie title at face value versus replicated marks displayed through artificial intelligence. Surely, there are some individuals who would be able to meet that level of understanding, but it is a very lofty presumption to think all consumers would be able to have that type of knowledge already stored in their minds.

Next, consumers are likely to be confused—or concerned—by artificial intelligence automating partial (or even full) decisions for them and tailoring their purchasing decisions based on observed behaviors and services. In addition to likelihood of confusion and dilution, this has the potential to constitute a cause of action for blurring. "Blurring

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[106] *Id.* at 529.
[107] *Id.* at 586 (emphasis added).
[108] *Id.* at 513.
[109] *Id.* at 586.
[110] Rogers v. Grimaldi, 695 F. Supp. 112, 120 (S.D.N.Y. 1988).
[111] *Id. See also* LALONDE & GILSON, *supra* note 29, at § 7.02 n. 45.71–45.73.

happens when a famous mark's distinctiveness is harmed because it becomes or is likely to become associated with a similar mark or trade name."[112] This is because the nature of artificial intelligence and machine learning is often wired to produce similar marks and trade names as per the user's request, as the purpose is to accurately provide various, closely related options for the consumer to choose from. [113]

With any type of artificial intelligence, machine-learning suggestions to the consumer might then be considered an almost "secondary liability." The American Bar Association has even explained that, while artificial intelligence tools and software have their advantages, they can also be used in the reverse to "infringe the rights of other trademark owners—thus opening up questions of machine volition and liability."[114]

E. The "Forgotten" Consumer

Because the purpose of the *Rogers* test is to protect the artistic freedom of expression of inventors and creators, there may be a move *away* from the context and emotion-driven component to trademark law, as the consumer may simply be left out of the process because the average consumer might not be considered the "average internet consumer."[115] "The reactions of a real-world consumer, so often alluded to in trademark doctrine, may be muted even further as a result."[116] This is particularly problematic because one of the main components required to register a trademark is that the mark has demonstrated that it has a distinct commercial impression upon consumers. Now, those consumers might have become "forgotten" since there is a much lesser need for human cognition in the product suggestion and purchasing process.[117]

One of the biggest setbacks with using artificial intelligence is that it "lacks the human ability to consider context . . . which may result in a higher, expanded prediction of likelihood of confusion."[118] This is even more so a risk considering that not all consumers, especially those in more mature generations who do not have as much technological

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[112] *Trademark Dilution*, JUSTIA (Oct. 2022), https://perma.cc/76LV-HQ2P.
[113] Joiner, *supra* note 10.
[114] Katyal & Kesari, *supra* note 6, at 528; *see also Letter from American Bar Association - Intellectual Property Law Section to Secretary of Commerce for Intellectual Property & Director of the United States Patent and Trademark Office*, USPTO (July 14, 2020), https://perma.cc/TQ3C-Y7UT.
[115] *See* WORLD INTELL. PROP. ORG., *supra* note 1, at 10.
[116] Katyal & Kesari*, supra* note 6, at 586.
[117] WORLD INTELL. PROP. ORG., *supra* note 1, at 5.
[118] Katyal & Kesari*, supra* note 6, at 586.

exposure, will have the level of knowledge needed to decipher such advanced options—let alone what is "art" or not—given to them for purchase. This allows a greater possibility to deceive consumers with "strategically driven recommendations."[119]

The consumer would be left to decide what exactly he is looking at and what is actually being branded. This confusion can lead to misleading advertising, as exemplified in *Allen v. National Video, Inc.* There, the Court held that the Lanham Act was violated because of its prohibition on misleading advertising.[120] The issue of the case was a false designation of origin, which would otherwise mislead the consumer to associate a mark as stemming from the wrong party.[121] The defendant's sole purpose was to capitalize his profits based on a popularized image of a character's face.[122] The idea was to capitalize on that character's familiar name, face and 'reputation for artistic integrity' to boost sales of its movie rentals.[123] In *Rogers*, while the film at issue did not damper any reputation for sake of profit, it is plausible that when adding artificial intelligence as an additional layer to advertising, a consumer would be required to take purchasing decisions a bit more seriously with more considerations so as to avoid confusion or being misled, making sales and market innovation less efficient for consumers.

Moving forward, a balancing of the above interests should be kept in mind when assessing a case under a *Rogers* defense.

IV. MOVING FORWARD: THE "GENUINE ARTIFICIAL INTELLIGENCE MOTIVE" TEST

Courts have been applying the *Rogers* test defense for many years now, and it is still facing a circuit split, despite many suggestions for frameworks under which *Rogers* could adopt, namely commercial speech and fair use or right of publicity. As has been described, though, Rogers does not fit neatly within any of those frameworks—this is a unique legal matter in question, not answerable by mere *stare decisis*. An innovative solution is needed to fill the gap in the law

A. Failing—and Already Existing—Frameworks

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[119] *Id.* at 529; WORLD INTELL. PROP. ORG., *supra* note 1, at 10, 12.
[120] Allen v. Nat'l Video, Inc., 610 F. Supp. 612 (S.D.N.Y. 1985).
[121] *Id.* at 625–26.
[122] *Id.* at 618.
[123] *Id.* at 617.

We must narrow the *Rogers* test because artificial intelligence creators must get proper legal protection for their inventions in the competitive marketplace of science, including a *lack* of protection for property that rightfully belongs to someone else (here, trademarks owned by others). Some may argue that artistic relevance is a category under First Amendment jurisprudence, and therefore, freedom of speech or commercial speech frameworks should apply. However, as held in *Rogers*, the Second Circuit did not consider this fitting under commercial speech because it would have needed its *primary* intention to be serving a commercial purpose.[124] The Second Circuit even stated, that for some, the distinction between art and commerce has been "blurred beyond recognition."[125]

While assuming good faith in the growth of artificial intelligence, intentional misleading of the public would be incredibly hard to prove, as liability would extend to such a profoundly high number of people who use that technology. WIPO foresees this problem, asking the probing question, "[w]hat if only [a] few brands are inserted into the AI system keeping the other brands?"[126] This could actually create an increased risk of false positives for "likelihood of confusion."[127] With third-party suppliers, keyword advertising, and automated processes, [128] the source identifying purpose of a trademark continues to dwindle in clarity. With courts now on high alert of the extremely low bar for artistic relevance as a defense, some courts have proposed a stricter look at the *DuPont* likelihood of confusion factors.[129] With a reliance on the traditional factors, a court using this stricter look would merely assume that *truly* expressive works will not cause confusion. In *Rogers*, the film at issue was not an "ordinary subject of commerce," a simple "commodity," or a mere piece of "merchandise," but solely a piece of art.[130] Basically, this assumes the belief that a form of art should be so evident that it is *only* art, and that it is serves a different purpose from the trademark. In that instance, a court would pay no special attention to First Amendment concerns, but, rather, would stick exclusively to analyzing any potential

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[124] Rogers v. Grimaldi, 695 F. Supp. 112, 119–120 (S.D.N.Y. 1988).
[125] *Id.* at 120.
[126] WORLD INTELL. PROP. ORG., *supra* note 1, at 14.
[127] Katyal & Kesari, *supra* note 6, at 586.
[128] *See Trade Marks: Cosmetic Warriors Ltd. and Lush Ltd. v. Amazon.co.uk Ltd.*, FIELDFISHER (Dec. 5, 2014), https://www.fieldfisher.com/en/insights/trade-marks-cosmetic-warriors-ltd-and-lush-ltd-v-amazoncouk-ltd.; WORLD INTELL. PROP. ORG., *supra* note 1, at 16.
[129] *In re* E. I. du Pont deNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973).
[130] Rogers v. Grimaldi, 695 F. Supp. 112, 124 (S.D.N.Y. 1988).

confusion under *DuPont*.[131] This might be interpreted as being more along the lines of a right to publicity defense, but in a Third Circuit case that applied *Rogers*, the court held, the right of publicity does not implicate the potential for consumer confusion."[132] This type of analysis, then, logically leads to the opposite purpose of a mark—source identification—while also proving contrary to the purpose of landmark cases *Matal* and *Iancu*, where, as aforementioned, the Court held that First Amendment concerns were almost *superior* to trademark rights.[133]

Thus, we must look elsewhere for a new *Rogers* test framework.

B. The New Approach

The circuit split on the *Rogers* test demands answers. While many have been proposed, the most promising appears to be what is deemed the "Genuine Artistic Motive" test, a product of a Colorado district court, the first district court to explicitly reject a *Rogers* defense.[134]

That court, which belongs to the Tenth Circuit, created its own test for artistic relevance in 2020 when it rejected a *Rogers* application in *Stouffer v. National Geographic Partners*.[135] The case had a similar fact pattern to *Rogers*—a producer of a nature documentary series claimed that a National Geographic nature documentary, which was made after the producer's documentary, infringed his trademark rights by use of the National Geographic documentary's title, claiming a likelihood of confusion, unfair competition, and deceptive trade practices. The court, while having agreed with the underlying theory of the *Rogers* test, ultimately created its own test.[136]

The new six-prong test, aptly named the "Genuine Artistic Motive" test, included the following factors:

- Whether the senior and junior users use the mark to identify the same or similar kind of goods or services;
- The extent to which the junior user has added expressive content to the work beyond the mark itself;

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[131] *In re* E. I. du Pont, 476 F.2d at 1361.
[132] Hart v. Elec. Arts, Inc., 717 F.3d 141, 158 (3d Cir. 2012).
[133] *Matal v. Tam*, 137 U.S. 1744 (2017); *Iancu v. Brunetti*, 139 U.S. 2294 (2019).
[134] Practical Law Intellectual Property & Technology, *"Genuine Artistic Motive" Test, Not Rogers Test, Applicable For Balancing Trademark And First Amendment Rights: D. Colo.*, THOMAS REUTERS PRACTICAL LAW (May 15, 2020), https://us.practicallaw.thomsonreuters.com/w-025-5350.
[135] Hervey, *supra* note 36; Stouffer v. Nat'l Geographic Partners, L.L.C., 460 F. Supp. 3d 1133 (D. Colo. 2020).
[136] *Stouffer*, 460 F. Supp. 3d at 1140.

- Whether the timing of the junior user's use suggests a motive to capitalize on popularity of the senior user's mark;
- ***How*** the mark is artistically related to the underlying work, service, or product;
- Whether the junior user has made any public statement or engaged in any public conduct that suggests a non-artistic motive; and
- Whether the junior user has made any statement in private or engaged in any conduct in private that suggests a non-artistic motive.[137]

Despite this new test, the outcome was the same as if *Rogers* had applied—National Geographic's title was considered its First Amendment expressive use, meaning it was not liable for infringement. The *Stouffer* court's reasoning provides a glimpse into the danger of the *Rogers* test moving forward. Citing the outcome in *Gordon*, the court reasoned that, the "*Rogers* test, taken at face value, essentially destroyed the value of the Honey Badger mark—and perhaps many other marks, if parties are willing to be sued and defend themselves under the *Rogers* test."[138] This does not even take into account the added potential for infringement on behalf of emerging technologies that can more readily display marks at an increased rate to consumers. Because of this, the "Genuine Artistic Motive" test must incorporate technological considerations for artificial intelligence under a "Genuine Artificial Intelligence Motive" test.

1. Alternative Avenues

With the "Genuine Artificial Intelligence Motive" test, there might be potential for an "alternative avenues" prong to take foot. This would pose a question to the creator, inventor, or artist seeking to use a trademark, asking him if he could make that exact same artistic and communicative point that his mark proposes to portray without actually using that mark. Basically, this would require an alternative use to express the idea of an artistic work but without incorporating an already-registered trademark to make that same expression.

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[137] *Id.*
[138] *Id.* at 1142 (citing Gordon v. Drape Creative, Inc., 909 F.3d 257, 268–71 (9th Cir. 2018)).

To get this off the ground, courts might visit *Stouffer*'s "Genuine Artistic Motive" test to assess the intentions behind such use.[139] When analyzing the factor's above, courts would weigh the appropriateness of the junior user's subjective motives behind each prong.[140] This would mean that expressive works could not be protected from infringement claims if there are sufficient alternative means for an artist to convey his or her idea to the general consuming public. This type of test would fail, however, to give latitude for creativity and free expression.

C. A Final Suggestion for Artificial Intelligence

Though in *Stouffer*, the court rejected the notion that *Rogers* could strike an appropriate balance between freedom of speech and trademark rights, moving forward, courts might resort to a balancing of *harms* analysis instead, in which the potential harm to one party and harm to the public interest is considered in equity.[141] There might be a temptation, then, for courts to look to the framework for commercial speech, but with a caveat for the sophistication of consumers under *DuPont*.[142] The idea is that more sophisticated consumers will be able to distinguish between particular goods and services as marketed by the artificial intelligence and their respective sources, while other, less-technologically savvy consumers in that market might not be able to do so. This would be the equitable purpose of the "Genuine Artificial Intelligence Motive" test.

In addressing this factor, courts might consider the generational age differences between consumers, as younger consumers might be more in touch with the latest technologies. Thus, they would be able to more readily identify which marks the artificial intelligence is advertising, and ideally, more attune to what might be infringement or dilution of those marks.[143] Courts might then suggest that the USPTO invest in training some of these youthful consumers to "monitor" new artificial intelligence technologies to discern the genuine nature of "artistically relevant" functions and secondary liability of marks used for commercial exploitation. Without this, there is a high potential for the

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[139] *Id.* at 1140, 1145.
[140] *Id.*
[141] Stouffer v. Nat'l Geographic Partners, L.L.C., 400 F. Supp. 3d 1161, 1177–80 (D. Colo. 2019).
[142] *In re* E. I. du Pont deNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973).
[143] *See generally* Katyal & Kesari, *supra* note 6, at 515; *see* WORLD INTELL. PROP. ORG., *supra* note 1.

enabling of free-riding activity.[144] The *Stouffer* court agreed with this notion as it stated, "it seems that anyone can use a trademark, *even to sell the same good or service for which the trademark was granted*, if the good or service can be deemed 'art.'"[145]

Weighing the freedom of expression and intellectual property protection is not an uncommon balancing test for the courts, especially after *Matal* and *Iancu*.[146] In fact, both the Eighth and the Tenth Circuits have applied balancing tests to cases concerning *Rogers*, in favor of a "flexible, case-by-case approach."[147] While this might be sustainable in the short-term, the "Genuine Artificial Intelligence Motive" test is the best answer in the long term because there does not seem to be any movement so far, but only more confusion, from both a legal *and* a consumer standpoint.

CONCLUSION

Overall, artificial intelligence as artistically relevant under the *Rogers* test will likely become increasingly difficult to govern, monitor, and regulate. Since *Rogers* has been adopted more and more over the last two decades, courts must address its future application in terms of how broad the law is willing to go to protect both artistic expression in technologies and intellectual property at the expense of one another, ideally through the "Genuine Artificial Intelligence Motive" test. Otherwise, the United States Patent and Trademark Office simply will not have enough bodies to keep up with the necessary trademark prosecution and protection of already-registered trademarks. As courts grapple with these new and emerging technologies, we are left with urgency to find scholars, judges, and scientists who can navigate where artificial intelligence meets artistic relevance. "*Roger*" that!

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[144] Katyal & Kesari, *supra* note 6, at 586.
[145] *Stouffer*, 460 F. Supp 3d at 1142.
[146] *Matal v. Tam*, 137 U.S. 1744 (2017); *Iancu v. Brunetti*, 139 U.S. 2294 (2019).
[147] Keller v. Elec. Arts Inc., 724 F.3d 1268, 1282 (9th Cir. 2013).