

NOTE

BEYOND *ROGERS*:  
RETHINKING TRADEMARK PROTECTION IN VIDEO GAMES  
AFTER *JACK DANIEL'S*

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## I. INTRODUCTION

The incorporation of real-world trademarks into video games has become a defining feature of modern game design, reflecting a broader trend toward greater realism and immersion.<sup>1</sup> These trademarks, including logos, vehicles, branded products, and other identifiers, are used to enhance the authenticity of game environments and narratives.<sup>2</sup> For instance, a military simulation game may depict Humvee vehicles, while an augmented reality (AR) game might direct players to real-world businesses.<sup>3</sup> However, these creative choices often lead to legal conflicts between video game developers and trademark holders.<sup>4</sup> Developers argue their use of trademarks constitutes protected expression under the First Amendment, while trademark holders contend that such uses, when unauthorized, risk misleading consumers, diluting brand identity, or tarnishing a brand's reputation.<sup>5</sup>

The conflict between creative freedom and trademark protection is not new, but it has grown increasingly complex as the gaming industry expands and

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- <sup>1</sup> See Anna Piechówka, *When Video Games Meet IP Law*, WIPO MAGAZINE (June 25, 2021), [https://www.wipo.int/wipo\\_magazine/en/2021/02/article\\_0002.html](https://www.wipo.int/wipo_magazine/en/2021/02/article_0002.html) [<https://perma.cc/69LD-FTV2>] (suggesting a growing trend "towards deeper realism; a trend which, in part, has been facilitated by the technical ability to realistically render even the minutest details").
  - <sup>2</sup> See *id.* (finding the insertion of realistic objects into games often "come[s] with trademarks, which can protect their product name or logo").
  - <sup>3</sup> See *AM Gen. LLC v. Activision Blizzard, Inc.*, 450 F. Supp. 3d 467, 479 (S.D.N.Y. 2020) (discussing how modern video games incorporate real-world elements, including trademarked military vehicles, to enhance realism).
  - <sup>4</sup> See Rowan Legal, *The Use of Trademarks in Video Games in the Light of the Current Case Law*, CEE LEGAL MATTERS (Mar. 8, 2021), <https://ceelegalmatters.com/rowan-legal/16221-the-use-of-trademarks-in-video-games-in-the-light-of-the-current-case-law> [<https://perma.cc/UQS6-6VSL>] (characterizing several recent lawsuits involving gaming companies as shaking up the relationship between trademark holders and video game developers).
  - <sup>5</sup> See *id.* (highlighting that while video game developers hinge their defense on First Amendment concerns, trademark holders accuse defendants of using the mark "for the purpose of exploiting plaintiff's reputation and good name and possible confusion of products.").

technology evolves.<sup>6</sup> Today, video games represent one of the largest and fastest-growing sectors of the entertainment industry, generating over \$200 billion annually and reaching audiences worldwide.<sup>7</sup> Innovations in AR and virtual reality (VR) have pushed the boundaries of how games interact with the physical world, often embedding trademarks into gameplay in ways that challenge traditional legal frameworks.<sup>8</sup> The Supreme Court's 2023 decision in *Jack Daniel's Properties, Inc. v. VIP Products LLC* has further complicated this landscape by limiting the application of the *Rogers* test, long considered the primary framework for analyzing trademark use in expressive works.<sup>9</sup> These disputes carry significant implications for both creative expression and brand protection in digital media. While protecting trademarks remains vital to preserving brand goodwill and economic value, overly restrictive interpretations of trademark law could stifle artistic expression and innovation in an industry that thrives on creativity.<sup>10</sup> Recent

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<sup>6</sup> See *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989) (discussing the historical tension between trademark law and artistic expression); see also *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (extending this analysis to video games); *Jack Daniel's Props., Inc. v. VIP Prods., LLC*, 599 U.S. 140, 152–56 (2023) [hereinafter *Jack Daniel's II*] (acknowledging the evolving nature of this legal tension).

<sup>7</sup> See *Games-Worldwide*, STATISTA, <https://www.statista.com/outlook/dmo/digital-media/video-games/worldwide> [<https://perma.cc/DUQ9-FEKG>] (finding video games are projected to reach \$564.27bn in 2026 globally).

<sup>8</sup> See Piechówka, *supra* note 1 (discussing the legal implications of incorporating real-world brands into virtual environments); see also Mark A. Lemley & Eugene Volokh, *Law, Virtual Reality, and Augmented Reality*, 166 U. PA. L. REV. 1051, 1084–89 (2018) (analyzing the novel legal challenges posed by AR and VR technologies in relation to intellectual property).

<sup>9</sup> See *Jack Daniel's II*, 599 U.S. at 153–55 (limiting the *Rogers* test to cases where trademarks are not used "as a mark"); see also *Activision Publ'g, Inc. v. Warzone.com, LLC*, No. 22-55831, 2023 WL 7118756, at \*1 (9th Cir. July 28, 2023) [hereinafter *Activision Publ'g II*] (remanding for reconsideration in light of the Supreme Court's decision in *Jack Daniel's*); *Mar Vista Ent., LLC v. THQ Nordic AB*, No. 2:23-cv-06924-MEMF-SSC, 2024 WL 3468933, at \*2–3 (C.D. Cal. July 8, 2024) (interpreting *Jack Daniel's* as restricting *Rogers* protection when marks function as source identifiers).

<sup>10</sup> See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992) (discussing trademark law's purpose in protecting brand identity); see also *Rogers*, 875 F.2d at 998 (noting that "overextension of Lanham Act restrictions . . . might intrude on First Amendment values"); *AM Gen.*, 450 F. Supp. 3d at 484–85

high-profile cases, such as *AM General LLC v. Activision Blizzard, Inc.* and *Activision v. Warzone.com*, highlight the legal uncertainties surrounding this issue and the need for a framework that balances these competing interests.<sup>11</sup>

In an era where video games increasingly serve as both entertainment and cultural artifacts, resolving the tension between trademark law and artistic expression has become critical to the industry's future. This Note aims to provide a nuanced perspective on this legal frontier, offering insights and solutions that can guide courts, legislators, and industry stakeholders in navigating the complex interplay of law, technology, and creativity.

This Note explores the evolving legal challenges surrounding trademark use in video games through several key sections. Part II examines the foundational principles of trademark law and First Amendment protections as they intersect in the gaming industry, establishing the historical and doctrinal context for current disputes. Part III analyzes the *Rogers* test and its evolution through significant cases, focusing on how courts have adapted this framework to address the unique characteristics of interactive media. Part IV investigates the impact of *Jack Daniel's* and subsequent decisions on trademark analysis in video games, revealing how courts are reconceptualizing the balance between expressive and commercial interests. Part V proposes reforms aimed at creating a more coherent framework for evaluating trademark use in gaming contexts, emphasizing practical solutions that promote both brand protection and creative freedom. Part VI concludes by synthesizing how recent legal developments require a balanced approach that acknowledges games' dual nature as both artistic expression and commercial products, while providing practical guidance for navigating this evolving landscape.

## II. BACKGROUND

This Part provides the legal background necessary to understand the tensions at the heart of trademark disputes in video games. Part A examines the First Amendment protections that courts have extended to video games as a medium of artistic expression. Part B then outlines the traditional framework of

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(recognizing that protecting creative expression in video games extends to protecting realism when it is an artistic goal).

<sup>11</sup> See *AM Gen.*, 450 F. Supp. 3d at 484–85 (balancing trademark rights against artistic expression in military simulation games); *Activision Publ'g II*, 2023 WL 7118756 at \*1 (remanding for reconsideration in light of *Jack Daniel's*); see also *Mar Vista Ent.*, 2024 WL 3468933 at \*2–3 (analyzing how entertainment franchises create complex trademark issues across media formats).

trademark law under the Lanham Act, setting the stage for the subsequent discussion of how these two bodies of law intersect and conflict.

A. FIRST AMENDMENT PROTECTIONS IN VIDEO GAMES

The First Amendment guarantees the right to free expression, safeguarding a broad spectrum of expressive works, from literature and film to visual art.<sup>12</sup> In recent decades, courts have extended these protections to video games, recognizing them as a unique medium capable of conveying complex ideas, narratives, and social commentary.<sup>13</sup>

In 2011, this principle was firmly established in *Brown v. Entertainment Merchants Association* (2011).<sup>14</sup> In *Brown*, the Supreme Court invalidated a California law that sought to restrict the sale of violent video games to minors, ruling that video games, like other forms of media, are entitled to full First Amendment protection.<sup>15</sup> Writing for the majority, Justice Scalia emphasized that video games combine literary elements, such as plot and character development, with visual and auditory art to communicate ideas in ways that are no less deserving of protection than books, films, or music.<sup>16</sup> The Court rejected the notion that the interactive nature of video games diminished their artistic value, instead asserting that interactivity enhances a player's engagement with the ideas and themes presented.<sup>17</sup>

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<sup>12</sup> See U.S. CONST. amend. I.

<sup>13</sup> See *Brown v. Ent. Merchs. Ass'n*, 564 U.S. 786, 790 (2011) (holding that "video games qualify for First Amendment protection"); see also *Am. Amusement Mach. Ass'n v. Kendrick*, 244 F.3d 572, 577 (7th Cir. 2001) (comparing video games to other protected media like "movies, plays, novels, and other traditional media").

<sup>14</sup> *Ent. Merchs. Ass'n*, 564 U.S. at 805 ("Legislation such as this, which is neither fish nor fowl, cannot survive strict scrutiny.").

<sup>15</sup> See *id.* at 786 ("Like protected books, plays, and movies, they [video games] communicate ideas through familiar literary devices and features distinctive to the medium. And the basic principles of freedom of speech . . . do not vary with a new and different communication medium.") (citations omitted).

<sup>16</sup> See *id.* at 790 (emphasizing that alternative mediums that, nonetheless, demonstrate plot and character development, are no less worthy of Constitutional protections).

<sup>17</sup> See *id.* at 798 ("The better it is, the more interactive. Literature when it is successful draws the reader into the story, makes him identify with the

The decision marked a turning point in the legal status of video games, affirming their role as cultural and artistic artifacts.<sup>18</sup> However, *Brown* did not address how First Amendment protections for video games intersect with other legal frameworks, particularly trademark law.<sup>19</sup> When video games incorporate real-world trademarks such as logos, brands, or other identifiers, questions arise about whether these uses constitute protected artistic expression or infringe upon the rights of trademark holders.<sup>20</sup> For example, does the depiction of a branded luxury car in a racing game serve an expressive purpose, or does it amount to unauthorized commercial exploitation?<sup>21</sup> These tensions require courts to carefully balance the competing interests of developers, trademark holders, and consumers.<sup>22</sup>

## B. TRADEMARK LAW'S TRADITIONAL FRAMEWORK

The Lanham Act, which establishes federal Trademark law in the United States, provides the foundational framework for protecting brands and their

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characters, invites him to judge them and quarrel with them, to experience their joys and sufferings as the reader's own." (citations omitted).

<sup>18</sup> See *id.* at 790; see also Eli Pales, *Video Games and the First Amendment*, 20 NW. J. TECH. & INTELL. PROP. 393, 400 (2023) (describing *Brown* as adding video games to "the list of constitutionally protected mediums" alongside movies, books, and other communicative media).

<sup>19</sup> *Id.* at 786–805 (focusing on content-based restrictions rather than intellectual property concerns); see also *Hart v. Electronic Arts, Inc.*, 717 F.3d 141, 148–49 (3d Cir. 2013) [hereinafter *Hart II*] (addressing the tension between First Amendment protections for video games and right of publicity claims).

<sup>20</sup> See *E.S.S. Ent. 2000*, 547 F.3d at 1099 (analyzing whether use of trademark in video game context deserves First Amendment protection).

<sup>21</sup> See *VIRAG, S.R.L. v. Sony Comput. Ent. Am. LLC*, No. 3:15-cv-01729-LB, 2015 WL 5000102, at \*1–2 (N.D. Cal. Aug. 21, 2015) (involving dispute over depiction of plaintiff's branded flooring trademark at a simulated European racetrack in the *Gran Turismo* racing game series); see also *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*, 74 F. Supp. 3d 1134, 1139–43 (N.D. Cal. 2014) (analyzing First Amendment protection for use of trademark in video game).

<sup>22</sup> See *Rogers*, 875 F.2d at 999 ("[T]he [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.").

distinctive identifiers.<sup>23</sup> At its core, a Trademark encompasses any word, phrase, or symbol that identifies the source of goods or services in the marketplace.<sup>24</sup> Through this framework, Congress created a comprehensive system for protecting both consumers and trademark owners from unauthorized use of protected marks.<sup>25</sup>

The Act's protections operate through two key provisions. First, § 1114(1)(a) safeguards registered trademarks against uses likely to cause consumer confusion, particularly in connection with the sale or advertising of goods and services.<sup>26</sup> Second, § 1125(a)(1) extends broader protections against false designations of origin and misleading representations, specifically targeting uses that might suggest unauthorized affiliations or endorsements.<sup>27</sup>

A basic purpose of the Lanham Act is to prevent consumer confusion about the source or origin of goods and protect owners' reputations, but the Act reaches further than just source confusion.<sup>28</sup> It also covers situations where the use of a mark is likely to cause confusion about the "affiliation, connection, or association" between the owner of a mark and the producer of a good.<sup>29</sup> These false association or false endorsement claims arise in various contexts, from traditional

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<sup>23</sup> See 15 U.S.C. §§ 1051–1141n; see also *Two Pesos*, 505 U.S. at 767–68 (discussing the Lanham Act's purpose and scope).

<sup>24</sup> See 15 U.S.C. § 1127 (defining "trademark" as "any word, name, symbol, or device, or any combination thereof" used to identify and distinguish goods); see also *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995) (explaining the basic principles of trademark law).

<sup>25</sup> See *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 190 (1985) (noting that the Lanham Act provides "national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers").

<sup>26</sup> 15 U.S.C. § 1114(1)(a).

<sup>27</sup> *Id.* § 1125(a)(1).

<sup>28</sup> See *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) (discussing the purpose of trademark law in preventing consumer confusion); *Two Pesos*, 505 U.S. at 774 (noting the Act's purpose in protecting producer goodwill).

<sup>29</sup> 15 U.S.C. § 1125(a)(1)(A) (prohibiting use of marks that are "likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person").

advertisements to expressive works like books, films, or video games.<sup>30</sup> The protected "mark" can even include the name, likeness, or other indicators of real persons, whether living or deceased.<sup>31</sup>

In an ordinary case of trademark infringement involving competing products, courts focus on whether the use of a mark is likely to cause confusion using the traditional multi-factor test.<sup>32</sup> However, when trademarks appear in expressive works like video games, courts must grapple with additional consideration: whether defendants are entitled to First Amendment protection.<sup>33</sup> This creates unique tensions, particularly when consumers recognize real-world trademarks in video games and may assume the existence of licensing agreements between game developers and trademark owners.<sup>34</sup>

The lower federal courts have struggled to offer a consistent means for reconciling the interests of Lanham Act plaintiffs with the First Amendment interests of defendants who produce expressive works.<sup>35</sup> Some courts omit any

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<sup>30</sup> See *Rogers*, 875 F.2d at 997–98 (addressing Lanham Act claims in the context of artistic expression); see *E.S.S. Ent. 2000*, 547 F.3d at 1099 (analyzing trademark claims in video game context).

<sup>31</sup> See *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1106–07 (9th Cir. 1992) (recognizing false endorsement claim under Lanham Act for unauthorized use of celebrity's distinctive voice); see *Fifty-Six Hope Rd. Music, Ltd. v. A.V.E.L.A., Inc.*, 778 F.3d 1059, 1067–68 (9th Cir. 2015) (applying Lanham Act protection to name and likeness of deceased musician).

<sup>32</sup> See *Polaroid*, 287 F.2d at 495 (establishing the multi-factor test for likelihood of confusion in the Second Circuit); see also *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979) (articulating the Ninth Circuit's version of the multi-factor test).

<sup>33</sup> See *Rogers*, 875 F.2d at 999 (“[The Lanham Act] should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”); see also *Ent. Merchs. Ass’n*, 564 U.S. at 790 (affirming that video games are entitled to First Amendment protection).

<sup>34</sup> See *AM Gen.*, 450 F. Supp. 3d at 482 (analyzing consumer expectations regarding licensing in the video game context); see also *Mar Vista Ent.*, 2024 WL 3468933, at \*4 (noting that “consumers expect well-known video games to be made into movies” through licensing agreements).

<sup>35</sup> See *Twentieth Century Fox TV v. Empire Distrib., Inc.*, 875 F.3d 1192, 1196 (9th Cir. 2017) (noting the tension between the First Amendment and trademark rights); see also *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664 (5th Cir. 2000) (describing the tensions courts face when balancing these competing interests).

discussion of the First Amendment and simply consider whether unlicensed use is likely to cause confusion, applying the traditional likelihood of confusion factors in a false association context.<sup>36</sup> However, the dominant approach for analyzing trademark use in expressive works emerged from the Second Circuit's decision in *Rogers v. Grimaldi*.<sup>37</sup>

These dual frameworks—traditional likelihood of confusion analysis and First Amendment considerations—serve complementary purposes in the video game industry. They protect consumers from deception while safeguarding trademark owners' investments in their brands, as articulated by the Supreme Court in *Two Pesos, Inc. v. Taco Cabana, Inc.*<sup>38</sup> Yet this balance becomes increasingly complex as video games continue to evolve, incorporating trademarks for creative or artistic purposes that extend beyond the traditional commercial uses contemplated by the Lanham Act.<sup>39</sup>

### III. EVOLUTION AND APPLICATION OF THE *ROGERS* TEST IN VIDEO GAMES

This Part traces the development and application of the Rogers test within the context of video games. Part A examines the origins of the Rogers test and its foundational principles. Part B explores how the Ninth Circuit has taken a leading role in applying the test to video game disputes, particularly through its decision in *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.* Part C then surveys how

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<sup>36</sup> See *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008) (applying likelihood of confusion test without engaging in *Rogers* analysis); see also *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403–06 (9th Cir. 1997) (applying traditional likelihood of confusion factors without *Rogers* framework).

<sup>37</sup> See *Rogers*, 875 F.2d at 999; see also *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 260–61 (9th Cir. 2018) (describing *Rogers* as the landmark case for balancing First Amendment considerations with trademark protection in expressive works).

<sup>38</sup> *Two Pesos*, 505 U.S. at 774 (explaining that trademark law serves the dual purpose of preventing others from copying a source-identifying mark and protecting the public from confusion and deception).

<sup>39</sup> See *E.S.S. Ent. 2000*, 547 F.3d at 1100 (addressing trademark use in a virtual representation of a real city); *AM Gen.*, 450 F. Supp. 3d at 485 (recognizing that realism in video games serves artistic purposes that may justify incorporating trademarked elements); see also *See Jack Daniel's II*, 599 U.S. at 152 (acknowledging the challenge of evaluating trademark use with expressive elements).

the Second Circuit and other jurisdictions have approached the same issues, including the significant *AM General LLC v. Activision Blizzard, Inc.* decision.

A. ORIGINS AND THE *ROGERS* TEST

The fundamental framework for balancing trademark rights with artistic expression emerged from a case involving not video games, but film.<sup>40</sup> In *Rogers v. Grimaldi*, the Second Circuit confronted a dispute over a film titled "Ginger and Fred" – a story about two fictional Italian performers who had gained fame imitating Ginger Rogers and Fred Astaire.<sup>41</sup> When Rogers sued under the Lanham Act, claiming the title misappropriated her name,<sup>42</sup> the court faced a crucial question: how should trademark law apply to artistic works without stifling creative expression?<sup>43</sup>

The Second Circuit's answer established what would become an important test for trademark use in expressive media, including video games.<sup>44</sup> The Court recognized that while consumers deserve protection from misleading trademark use, they also have a legitimate interest in experiencing the fruits of artistic expression.<sup>45</sup> This dual consideration led to a carefully balanced approach:

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<sup>40</sup> See generally *Rogers*, 875 F.2d. 994.

<sup>41</sup> *Id.* at 996–97. As the Second Circuit explained, "Rogers and the late Fred Astaire are among the most famous duos in show business history" who "established themselves as paragons of style, elegance, and grace." *Id.*

<sup>42</sup> *Id.* at 997. Section 43(a) of the Lanham Act imposes civil liability on any person who uses false designations of origin, descriptions, or representations in connection with goods or services in commerce that are likely to cause confusion or misrepresentation about the origin, sponsorship, or approval of their goods, services, or commercial activities. 15 U.S.C. § 1125(a).

<sup>43</sup> *Rogers*, 875 F.2d. at 997.

<sup>44</sup> *Id.*

<sup>45</sup> *Id.* at 998. The Second Circuit recognized the conflict between the Lanham Act's protection of consumers and the First Amendment's protection of artistic expressions: "Movies, plays, books, and songs are all indisputably works of artistic expression and deserve protection," but those works are "also sold in the commercial marketplace like other more utilitarian products, making the danger of consumer deception a legitimate concern that warrants some government regulation." *Id.* The court concluded that, "[b]ecause overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict." *Id.*

the Lanham Act would apply to artistic works only when the public's interest in avoiding confusion clearly outweighed the public's interest in free expression.<sup>46</sup>

From this balancing act, the Second Circuit developed its now-famous two-pronged *Rogers* test.<sup>47</sup> First, the use of a trademark must have at least minimal artistic relevance to the underlying work.<sup>48</sup> Second, even if artistically relevant, the use must not explicitly mislead consumers about the source or content of the work.<sup>49</sup> This framework proved remarkably adaptable, establishing a threshold that protected artistic expression while preserving trademark owners' rights against genuinely deceptive uses.<sup>50</sup>

The Second Circuit's application of this test to "Ginger and Fred" demonstrated its practical operation.<sup>51</sup> The court found the film's title had clear artistic relevance to its content—a story about performers known by those very names.<sup>52</sup> Moreover, nothing about the title explicitly suggested Rogers' endorsement or involvement.<sup>53</sup> This analysis provides courts with a blueprint for

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<sup>46</sup> *Id.* at 999. The court found "the [Lanham Act] should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression." *Id.*

<sup>47</sup> *Id.* at 999–1000 (establishing the two-part test requiring that trademark use must have artistic relevance to the underlying work and not explicitly mislead consumers about source or content).

<sup>48</sup> *Id.* at 1000. The court held that "it insulates from restriction titles with at least minimal artistic relevance that are ambiguous or only implicitly misleading but leaves vulnerable to claims of deception titles that are explicitly misleading as to source or content, or that have no artistic relevance at all." *Id.*

<sup>49</sup> *Id.* at 1000.

<sup>50</sup> See *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241–42 (9th Cir. 2013) (applying the *Rogers* test to video games and noting its effectiveness in striking a balance between "the public's First Amendment interest in free expression [and its] interest in being free from consumer confusion about affiliation and endorsement"); see also *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012) (adopting the *Rogers* test as a "balancing test" between trademark and First Amendment interests in expressive works).

<sup>51</sup> *Rogers*, 875 F.2d at 1001–02 (applying the two-part test and concluding that the film title had artistic relevance and did not explicitly mislead as to source or sponsorship).

<sup>52</sup> *Id.* at 1001.

<sup>53</sup> *Id.*

evaluating trademark use in video games, where creative expression often relies on incorporating real-world brands and symbols.<sup>54</sup>

## B. THE NINTH CIRCUIT'S LEADERSHIP IN GAMING APPLICATIONS

Following the *Rogers* decision, courts across the country began adopting and expanding the test to analyze trademark use within expressive works themselves.<sup>55</sup> The Ninth Circuit emerged as the leading authority in applying and refining the *Rogers* test specifically for video games.<sup>56</sup> This prominent role was a natural development given California's status as a hub for the gaming industry, home to industry giants like Riot Games (Los Angeles), Activision Blizzard (Santa Monica), and Electronic Arts (Redwood City).<sup>57</sup> The concentration of major developers and publishers within the circuit's jurisdiction has provided numerous opportunities for the court to develop a sophisticated framework for evaluating trademark use in video games, making it the de facto leader in this evolving area of law.<sup>58</sup>

The Ninth Circuit significantly extended the *Rogers* test to video games in *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*<sup>59</sup> The case involved Rockstar Games, the developer of *Grand Theft Auto: San Andreas*, and its depiction of a fictional strip club, the "Pig Pen," inspired by the real-world "Play Pen Gentlemen's Club" in East Los Angeles.<sup>60</sup>

The *Grand Theft Auto* series is renowned for its dystopian, satirical depiction of urban life in fictional cities modeled after real-world American

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<sup>54</sup> See *E.S.S. Ent. 2000*, 547 F.3d at 1099–1101 (applying *Rogers* to video game's use of a strip club trademark); *AM Gen.*, 450 F. Supp. 3d at 477–79 (using *Rogers* framework to analyze military vehicle trademarks in Call of Duty games); see also *Twentieth Century Fox TV*, 875 F.3d at 1196–97 (noting *Rogers*' broad application across various expressive media).

<sup>55</sup> See Yen-Shyang Tseng, *Protecting the First Amendment Rights of Video Games from Lanham Act and Right of Publicity Claims*, 48 PEPP. L. REV. 425, 436 (2021).

<sup>56</sup> *Id.* at 436.

<sup>57</sup> *Who We Are*, RIOT GAMES, <https://www.riotgames.com/en/who-we-are> [<https://perma.cc/CY8E-MRFM>]; *Locations*, ACTIVISION BLIZZARD, <https://www.activisionblizzard.com/location> [<https://perma.cc/S667-HMLM>]; *About EA*, EA ELECTRONIC ARTS, <https://www.ea.com/about> [<https://perma.cc/Y9CG-JA5F>].

<sup>58</sup> Tseng, *supra* note 55, at 436.

<sup>59</sup> *E.S.S. Ent. 2000*, 547 F.3d.

<sup>60</sup> *Id.* at 1097.

metropolises. Each game is set in one or more exaggerated, cartoonish locations, complete with a disclaimer emphasizing their fictional nature.<sup>61</sup> Players advance through the game by completing missions that unfold in environments rife with social commentary, parody, and dark humor.<sup>62</sup> In *San Andreas*, Rockstar Games created the virtual cities of Los Santos, San Fierro, and Las Venturas, inspired by Los Angeles, San Francisco, and Las Vegas, respectively.<sup>63</sup> Los Santos, a centerpiece of the game, captures the essence of Los Angeles's iconic neighborhoods, with fictionalized counterparts like "Vinewood" (Hollywood), "Santa Maria" (Santa Monica), and "Ganton" (Compton).<sup>64</sup> Los Santos brims with elements that define West Coast "gangster" culture: liquor stores, tattoo parlors, pawn shops, and even seedy strip clubs.<sup>65</sup> These fictional locales, while grounded in reality, are imbued with a satirical tone that reflects the game's irreverent vision.<sup>66</sup>

Rockstar's approach to designing Los Santos exemplifies the game's artistic objectives. The development team drew inspiration from real Los Angeles neighborhoods, with artists taking reference photographs of streets, businesses, and landmarks that resonated with the game's theme.<sup>67</sup> However, these elements were deliberately transformed to suit the fictional world of Los Santos, emphasizing parody over realism.<sup>68</sup> One notable example is "East Los Santos," the game's version of East Los Angeles, which includes the "Pig Pen," a cartoonish strip club inspired by real-life establishments.<sup>69</sup> This depiction became the subject of litigation in this case. *E.S.S. Entertainment 2000* ("ESS") contended that Rockstar's portrayal of the Pig Pen replicated the Play Pen's unique logo and trade

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<sup>61</sup> *Id.*

<sup>62</sup> *See id.*

<sup>63</sup> *Id.*

<sup>64</sup> *Id.*

<sup>65</sup> *E.S.S. Ent. 2000*, 547 F.3d at 1097.

<sup>66</sup> *Id.*

<sup>67</sup> *Id.* at 1097.

<sup>68</sup> *Id.* (noting that Rockstar's artists "chang[ed] the images from the photographs as necessary to fit into the fictional world of Los Santos" and quoting the Lead Map Artist's testimony that the team "did not seek to re-creat[e] a realistic depiction of Los Angeles; rather, [they] were creating 'Los Santos,' a fictional city that lampooned the seedy underbelly of Los Angeles").

<sup>69</sup> *Id.* at 1097–98.

dress, potentially leading consumers to mistakenly believe that ESS had endorsed or was affiliated with the club's depiction in the game.<sup>70</sup>

The court reiterated that the *Rogers* test traditionally applied to the titles of expressive works but saw "no principled reason" why it could not extend to in-game content.<sup>71</sup> Applying the test, the court first considered artistic relevance, emphasizing that the threshold is minimal—"merely above zero."<sup>72</sup> It found that the recreation of East Los Angeles's distinctive "look and feel" was integral to Rockstar's artistic goal of parodying urban environments, making the inclusion of a strip club similar to the Play Pen artistically relevant.<sup>73</sup>

The court then turned to whether the use was explicitly misleading.<sup>74</sup> It highlighted that trademark law seeks to prevent consumer confusion, but mere inclusion of a trademark is insufficient to meet this prong.<sup>75</sup> Instead, the question was whether the game would lead players to believe the Play Pen endorsed or was associated with Rockstar.<sup>76</sup> The court concluded that no reasonable consumer would believe the Play Pen, a local strip club, was involved in the production of a sophisticated video game like *San Andreas*.<sup>77</sup> Additionally, the Pig Pen's role in the game was incidental to the broader narrative and gameplay, further reducing the likelihood of confusion.<sup>78</sup>

This decision underscores the *Rogers* test's adaptability to video games, particularly in balancing creative expression against trademark rights.<sup>79</sup> By

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<sup>70</sup> *E.S.S. Ent. 2000*, 547 F.3d at 1098.

<sup>71</sup> *See id.* at 1099 ("Although this test traditionally applies to uses of a trademark in the title of an artistic work, there is no principled reason why it ought not also apply to the use of a trademark in the body of the work.").

<sup>72</sup> *Id.* at 1100 ("In other words, the level of relevance merely must be above zero.").

<sup>73</sup> *Id.*

<sup>74</sup> *Id.*

<sup>75</sup> *Id.* ("The mere use of a trademark alone cannot suffice to make such use explicitly misleading.").

<sup>76</sup> *E.S.S. Ent. 2000*, 547 F.3d at 1100.

<sup>77</sup> *Id.* at 1100–1101 ("A reasonable consumer would not think a company that owns one strip club in East Los Angeles . . . also produces a technologically sophisticated video game like *San Andreas*.").

<sup>78</sup> *Id.* at 1100 ("Whatever one can do at the Pig Pen seems quite incidental to the overall story of the Game.").

<sup>79</sup> *Id.* at 1101.

recognizing realism and parody as legitimate artistic goals, the court reinforced developers' First Amendment protections, even when incorporating real-world trademarks.<sup>80</sup>

### C. SECOND CIRCUIT AND OTHER JURISDICTIONS' APPROACHES

Despite being the originator of the *Rogers* test in 1989, the Second Circuit has had remarkably limited opportunities to apply its own framework to video games. This jurisdictional gap is particularly noteworthy given New York's prominence in media and entertainment law.<sup>81</sup> While the Second Circuit has continued to refine the *Rogers* test in other contexts, such as literary works and films, it has yet to address the unique challenges presented by interactive media like video games.<sup>82</sup> However, the handful of video game trademark decisions that have emerged from district courts within the Second Circuit offer valuable insights into how the test might evolve to address modern gaming technology.<sup>83</sup> For example, the Southern District of New York's analysis in *AM General v. Activision Blizzard* demonstrates how courts within the circuit are adapting the *Rogers* framework to address contemporary gaming issues, even without direct guidance from the Circuit Court.<sup>84</sup>

The *AM General v. Activision Blizzard* case represents an important application of the *Rogers* test to contemporary video games, particularly illustrating how courts evaluate trademark use in service of realistic gameplay.<sup>85</sup>

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<sup>80</sup> *Id.* ("Since the First Amendment defense applies equally to ESS's state law claims as to its Lanham Act claim, the district court properly dismissed the entire case on Rockstar's motion for summary judgment.").

<sup>81</sup> *See* Tseng, *supra* note 55 (observing that "despite creating the *Rogers* test more than three decades ago, the Second Circuit so far has had no opportunity to apply it in the context of video games").

<sup>82</sup> *See* *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (applying *Rogers* to literary works); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989) (extending *Rogers* to book covers).

<sup>83</sup> *See* *AM Gen.*, 450 F. Supp. 3d at 479–80 (applying *Rogers* framework to military vehicle trademarks in *Call of Duty* games); *VIRAG, S.R.L. v. Sony Comput. Ent. Am. LLC*, No. 3:15-cv-01729-LB, 2015 WL 5000102, at \*13 (N.D. Cal. Aug. 21, 2015) (analyzing trademark use in racing video games under *Rogers*).

<sup>84</sup> *AM Gen.*, 450 F. Supp. 3d at 478–85 (providing detailed analysis of how the *Rogers* test applies to realistic depictions in video games).

<sup>85</sup> *Id.*

The dispute centered on Activision's Call of Duty series, one of the world's most successful video game franchises, which allows players to experience simulated modern warfare across various historical and contemporary settings.<sup>86</sup> Central to the dispute was Activision's unauthorized inclusion of Humvee vehicles, iconic symbols of American military presence globally, in nine Call of Duty games.<sup>87</sup> These vehicles, manufactured by AM General, have been fundamental to U.S. military operations from Panama to Afghanistan, making them essential elements of any authentic military simulation.<sup>88</sup> The case presented a clear question: Does the use of real military vehicles in a war game constitute protected artistic expression or trademark infringement?<sup>89</sup>

The Southern District of New York's analysis provides a comprehensive framework for applying *Rogers* to video games.<sup>90</sup> In examining artistic relevance, the court recognized that while the requirement must be "real," the threshold should not be "unduly rigorous" to avoid suppressing First Amendment expression.<sup>91</sup> In evaluating Call of Duty's use of Humvees, the court emphasized that realism itself constitutes a legitimate artistic goal. The inclusion of actual military vehicles enhanced the game's authenticity, allowing players to experience "a sense of realism and lifelikeness" in simulated modern warfare.<sup>92</sup> Notably, the court acknowledged that even if realism were the only artistic element (which it

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<sup>86</sup> *Id.* at 475. Call of Duty is one of the "most popular and well-known video game franchises in the world" with over 130 million units sold. *Id.* Indeed, the Call of Duty franchise—which is a first-person shooter series developed, produced, and distributed by Activision—is characterized by its realism, cinematic set-pieces, and fast paced multiplayer mode. *Id.*

<sup>87</sup> *Id.*

<sup>88</sup> *Id.*

<sup>89</sup> *Id.* at 477.

<sup>90</sup> *AM Gen.*, 450 F. Supp. 3d at 477–78.

<sup>91</sup> *Id.* at 477 ("This requirement, though real, is not unduly rigorous out of the understanding that the overextension of Lanham Act restrictions . . . might intrude on First Amendment values.").

<sup>92</sup> *Id.* at 479 ("Featuring actual vehicles used by military operations around the world in video games about simulated modern warfare surely evokes a sense of realism and lifelikeness to the player who assumes control of a military soldier and fights against a computer-controlled or human-controlled opponent across a variety of computer-generated battlefields.").

was not, given the games' narrative campaigns), this alone could satisfy the artistic relevance requirement.<sup>93</sup>

For the explicit misleading analysis, the court employed the *Polaroid* factors, adapting this traditional trademark analysis to the gaming context.<sup>94</sup> The *Polaroid* factors include "the strength of the plaintiff's mark," "the degree of similarity between the two marks," "the proximity of the products" and "the likelihood that the prior owner will bridge the gap," "actual confusion," defendant's good faith in adopting its own mark and "the quality of the defendant's product," and the sophistication of consumers in the relevant market.<sup>95</sup>

Despite the strength of AM General's trademark, the court found the risk of consumer confusion was minimal, at less than 20%.<sup>96</sup> The court examined various aspects of Activision's conduct, including the presence of Humvees at promotional events and boilerplate IP statements in user guides, concluding these did not demonstrate intent to mislead consumers about source or sponsorship.<sup>97</sup>

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<sup>93</sup> *Id.* at 484–85. ("Further, assuming arguendo that realism is the only artistic interest that Call of Duty games possess—an assumption potentially belied by the presence of narrative campaign modes in all of the challenged games—it is also true that realism can have artistic merit in itself.")

<sup>94</sup> *Id.* at 480.

<sup>95</sup> *Id.* at 480–84 (citing *Polaroid*, 287 F.2d at 495) (discussing each *Polaroid* factor in detail from pages 480–84, analyzing them in the context of the video game industry and First Amendment considerations).

<sup>96</sup> *AM Gen.*, 450 F. Supp. 3d at 484 ("There is no evidence of actual confusion here."). Plaintiff cites a survey showing 16% of consumers confused about AM General's association with Call of Duty (Pl.'s Mem. at 23), but confusion below 20% reflects only minimal misunderstanding. *Id.* Under *Rogers*, trademark owners must accept "some" confusion when outweighed by free speech. *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172, n.19 (S.D.N.Y. 2012). Even favorably interpreted, the survey fails to meet the compelling standard needed to override First Amendment protections. See *Twin Peaks Prods.*, 996 F.2d at 1379. Thus, while the fifth *Polaroid* factor slightly favors Plaintiff, First Amendment interests outweigh its significance.

<sup>97</sup> *AM Gen.*, 450 F. Supp. 3d at 483 ("Plaintiff points to (1) a handful of statements by Defendants' employees in 'documents, emails, and witness testimony,' (2) the presence of Humvees decorated with Call of Duty logos at several in-person promotional events, and (3) the statements in several user guides.")

The distinct market segments (military vehicles versus video games) further reduced the likelihood of confusion.<sup>98</sup>

This decision holds particular significance for game developers seeking to create authentic experiences.<sup>99</sup> The court's recognition that realism itself carries artistic merit provides robust protection for the use of real-world trademarks when they serve to enhance gameplay authenticity.<sup>100</sup> Moreover, the analysis suggests that courts will consider the gaming industry's unique context when evaluating potential consumer confusion, acknowledging that players generally understand the difference between virtual representations and actual product endorsements.<sup>101</sup> The ruling effectively balances trademark holders' rights with developers' creative freedom to craft immersive, realistic gaming experiences.<sup>102</sup>

The *AM General* decision demonstrates how the *Rogers* test has evolved to accommodate the unique characteristics of video games as an expressive medium.<sup>103</sup> The court's emphasis on realism as an artistic value particularly resonates with modern game development, where authenticity often serves both creative and player engagement goals.<sup>104</sup> This framework provides valuable guidance for developers incorporating real-world brands into their games while respecting trademark protections.<sup>105</sup> However, recent Supreme Court jurisprudence has significantly narrowed the scope of *Rogers* protection, creating

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<sup>98</sup> *Id.* at 481 ("Put simply, Plaintiff's purpose in using its mark is to sell vehicles to militaries, while Defendants' purpose is to create realistically simulating modern warfare video games for purchase by consumers."); *see also id.* at 481 ("Plaintiff's business is solely focused on automobiles, a reasonable jury would view its forays into video game licensing as merely a 'sporadic and marginal aspect' of its business rather than its 'central purpose' and 'focus.'").

<sup>99</sup> *Id.* at 484–85.

<sup>100</sup> *Id.* at 484 ("If realism is an artistic goal, then the presence in modern warfare games of vehicles employed by actual militaries undoubtedly furthers that goal.").

<sup>101</sup> *Id.* at 481.

<sup>102</sup> *AM Gen.*, 450 F. Supp. 3d at 484.

<sup>103</sup> *Id.*

<sup>104</sup> *Id.*

<sup>105</sup> *See id.* at 484–85.

new challenges for game developers seeking to balance creative expression with trademark compliance.<sup>106</sup>

#### IV. RECENT LIMITATIONS ON THE *ROGERS* TEST AND THEIR IMPACT ON VIDEO GAMES

This Part examines how recent judicial decisions have begun to erode the broad application of the *Rogers* test, and what these developments mean for trademark disputes involving video games. Part A analyzes the Supreme Court's landmark decision in *Jack Daniel's Properties, Inc. v. VIP Products LLC*, which significantly narrowed the circumstances under which the *Rogers* test may be invoked. Part B explores the Ninth Circuit's subsequent decision in *Mar Vista Entertainment v. Tequila Brands LLC*, which further refined the boundaries of the test within the context of entertainment content. Part C then turns to the direct impact of these decisions on the video game industry, as illustrated by the Ninth Circuit's handling of *Activision Publishing, Inc. v. Warzone.com, LLC*.

##### A. THE *JACK DANIEL'S* PARADIGM SHIFT

The Supreme Court's 2023 decision in *Jack Daniel's Properties, Inc. v. VIP Products LLC* fundamentally transformed how courts evaluate trademark use in expressive works, including video games.<sup>107</sup> The case arose from a dispute over a dog toy manufacturer's parody of Jack Daniel's iconic whiskey bottle design.<sup>108</sup> VIP Products created the "Bad Spaniels Silly Squeaker" toy, which mimicked Jack Daniel's distinctive trade dress while replacing the original text with dog-themed humor - for example, changing "Old No. 7" to "The Old No. 2 On Your Tennessee Carpet."<sup>109</sup>

The case's procedural history reflected the prevailing uncertainty surrounding trademark protection in expressive works.<sup>110</sup> Initially, the District

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<sup>106</sup> See *Jack Daniel's II*, 599 U.S. at 154 (limiting *Rogers* to cases where trademarks are not used as marks); see also *Activision Publ'g II*, 2023 WL 7118756 at \*1 (remanding trademark case for reconsideration in light of *Jack Daniel's*); *Mar Vista Ent.*, 2024 WL 3468933 at \*3 (interpreting *Jack Daniel's* as restricting *Rogers* protection for marks that function as source identifiers).

<sup>107</sup> See *Jack Daniel's II*, 599 U.S. at 143.

<sup>108</sup> *Id.* at 144.

<sup>109</sup> *Id.*

<sup>110</sup> *Id.* at 151.

Court found infringement and dilution, permanently enjoining the toy's sale.<sup>111</sup> However, the Ninth Circuit reversed, holding that the *Rogers* test applied because the toy "communicates a 'humorous message' " despite being a commercial product.<sup>112</sup> The appeals court reasoned that the use of the Jack Daniel's trademarks fell within the noncommercial use exception to trademark dilution claims, as the toy conveyed a parodic message.<sup>113</sup>

Writing for a unanimous Supreme Court, Justice Kagan sharply limited the *Rogers* test's application, establishing that it does not apply when a trademark serves as a source identifier for the alleged infringer's goods.<sup>114</sup> The Court emphatically rejected the notion that merely communicating a "humorous message" or serving a parodic purpose automatically triggers *Rogers* protection.<sup>115</sup> Instead, when a mark is used "as a mark" - that is, to designate the source of goods or services—traditional likelihood-of-confusion analysis applies, even if the use also contains expressive elements.<sup>116</sup>

The Court emphasized that trademark law's primary concern remains preventing consumer confusion about source, which is most likely to arise when someone uses another's trademark as a trademark.<sup>117</sup> Justice Kagan explained that "whatever *Rogers* merit—an issue on which this Court takes no position—it has always been a cabined doctrine: It has not insulated from ordinary trademark scrutiny the use of trademarks as trademarks."<sup>118</sup> While expressive elements, including parody and commentary, remain relevant, they must be considered

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<sup>111</sup> *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 291 F. Supp. 3d 891, 911 (D. Ariz. 2018) (concluding that "Jack Daniel's merits a permanent injunction").

<sup>112</sup> *Jack Daniel's II*, 599 U.S. at 152 (citing *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170 (9th Cir. 2020)).

<sup>113</sup> *Id.* at 162–63.

<sup>114</sup> *Id.* at 154.

<sup>115</sup> *Id.* at 157–58.

<sup>116</sup> *Id.*

<sup>117</sup> *Id.* at 156 ("[T]hat kind of confusion is most likely to arise when someone uses another's trademark as a trademark—meaning, again, as a source identifier—rather than for some other expressive function.").

<sup>118</sup> *Jack Daniel's II*, 599 U.S. at 144.

within the traditional likelihood-of-confusion framework rather than as a threshold First Amendment question.<sup>119</sup>

Significantly, the Court also addressed trademark dilution claims, holding that the noncommercial use exception does not automatically protect parodies that use marks as source identifiers.<sup>120</sup> The Court found this interpretation necessary to avoid nullifying the statute's explicit limitations on fair use protection for parodies that function as source identifiers.<sup>121</sup> This marked a significant departure from previous approaches that had expanded *Rogers* to shield various commercial uses containing expressive elements.<sup>122</sup>

B. *MAR VISTA*: REFINING THE FRAMEWORK FOR ENTERTAINMENT  
CONTENT

The Central District of California's 2024 decision in *Mar Vista Ent., LLC v. THQ Nordic AB* provides crucial guidance on how courts should apply *Jack Daniel's* in the entertainment context.<sup>123</sup> The dispute arose when Mar Vista released a horror film titled "Alone in the Dark," prompting trademark concerns from THQ Nordic, which owned rights to the storied video game franchise of the same name.<sup>124</sup> The case presented a perfect opportunity to examine how the *Jack Daniel's* framework applies to creative titles that may serve both expressive and source-identifying functions.<sup>125</sup>

*Mar Vista* significantly advanced the post-*Jack Daniel's* analysis in several key ways. First, the court rejected the argument that the title of a single creative

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<sup>119</sup> *Id.* at 161 ("[A]lthough VIP's effort to parody Jack Daniel's does not justify use of the *Rogers* test, it may make a difference in the standard trademark analysis.").

<sup>120</sup> *Id.*

<sup>121</sup> *See id.* at 162 ("The expansive view of the 'noncommercial use' exclusion effectively nullifies Congress's express limit on the fair-use exclusion for parody, etc.").

<sup>122</sup> *See id.* at 163 (holding that the noncommercial exclusion does not shield parody or other commentary when its use of a mark is source-identifying).

<sup>123</sup> *Mar Vista Ent.*, 2024 WL 3468933, at \*2.

<sup>124</sup> *Id.* at \*1-2.

<sup>125</sup> *See id.* at \*2 ("The main dispute between the parties at this stage is whether THQ's counterclaims fail as a matter of law because they are precluded by the First Amendment under the two-prong test set forth in *Rogers v. Grimaldi*.").

work cannot serve as a source identifier as a matter of law.<sup>126</sup> While acknowledging that titles of single works generally cannot be registered as trademarks, the court emphasized that this limitation does not prevent such titles from functioning as source identifiers in practice.<sup>127</sup> This distinction is particularly relevant for video games, where titles often serve dual purposes of describing content and identifying the source.<sup>128</sup>

Second, the court provided valuable guidance on how to evaluate claims that trademark use is merely expressive.<sup>129</sup> *Mar Vista* had argued that its use of “Alone in the Dark” was purely descriptive and artistic, serving only to convey the film’s horror themes.<sup>130</sup> However, the court found that under *Jack Daniel’s*, the mere presence of artistic expression does not preclude traditional trademark analysis when source identification is also present.<sup>131</sup> Particularly noteworthy is that under *Jack Daniel’s*, this principle applies even where the use carries expressive or parodic content.<sup>132</sup>

Third, *Mar Vista* clarified how courts should approach cases involving entertainment franchises.<sup>133</sup> The court recognized that in industries where adaptations and crossovers are common (as with video games and films),

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<sup>126</sup> *See id.* at \*3–4.

<sup>127</sup> *Id.* (“But a term ‘used to identify a series of creative works’ can ‘function[ ] as a trademark.’” (quoting *Brainy Baby Co.*, 101 U.S.P.Q.2d at 2)).

<sup>128</sup> *See The TL;DR on Using Trademarks to Protect Your Games*, FENWICK: INSIGHTS (Oct. 4, 2017), <https://www.fenwick.com/insights/publications/the-tl-dr-on-using-trademarks-to-protect-your-games> [<https://perma.cc/6264-VC7B>] (noting that game titles like “Duck Hunt” and “Goat Simulator” describe content while simultaneously serving as source identifiers for their respective developers).

<sup>129</sup> *Mar Vista Ent.*, 2024 WL 3468933, at \*2–3.

<sup>130</sup> *See id.*

<sup>131</sup> *Id.* at \*3 (“According to *Jack Daniel’s*, where it appears that the junior user—despite the limits of trademark law—is attempting to use a title as a source identifier, that can constitute trademark infringement.”).

<sup>132</sup> *See Jack Daniel’s II*, 599 U.S. at 157–58 (explaining that a source-identifying use does not receive special treatment “because the use of a mark has other expressive content” and recognizing that “a mark can both function as a mark and have parodic content”).

<sup>133</sup> *See id.* at \*1 (discussing the relationship between video games and film adaptations).

consumers may reasonably assume connections between similarly titled works.<sup>134</sup> This analysis is particularly relevant for video games, where franchise expansion and cross-media adaptation are increasingly common business practices.<sup>135</sup>

The court's analysis provides a framework for evaluating trademark use in entertainment that bridges the gap between *Jack Daniel's* commercial focus and the creative needs of the gaming industry.<sup>136</sup> Rather than treating artistic relevance as a threshold question, courts must examine how consumers actually perceive the relationship between marks and their sources, even in highly creative contexts.<sup>137</sup>

Most significantly for video game developers, *Mar Vista* signals that courts will conduct a fact-specific inquiry into whether a title functions as a source identifier—regardless of its expressive or artistic character—and that well-pleaded allegations of such source-identifying use are sufficient to foreclose reliance on *Rogers* at the pleadings stage.<sup>138</sup> This analysis is particularly relevant given the gaming industry's frequent practice of adapting other media properties and creating transmedia franchises.<sup>139</sup>

### C. IMPACT ON VIDEO GAMES: ACTIVISION V. WARZONE.COM

The practical implications of *Jack Daniel's* limitation on the *Rogers* test quickly emerged in the video game context through *Activision Publishing, Inc. v.*

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<sup>134</sup> *See id.* (“In the entertainment industry, it is common practice for movies to be based on popular video games, a practice that is especially prevalent in the horror genre.”).

<sup>135</sup> *See, e.g., Mar Vista Ent.*, 2024 WL 3468933 (“Due to the popularity of the *Alone in the Dark* video games, THQ licensed the rights for two *Alone in the Dark* films, released in 2005 and 2008.”).

<sup>136</sup> *Id.* at \*2 (discussing how courts must balance First Amendment concerns with trademark protection in the entertainment context).

<sup>137</sup> *See id.* at \*4 (“The reasonable inference that arises from these allegations, when coupled with the allegations that *Mar Vista* purposefully titled its movie ‘*Alone in the Dark*’ to mislead consumers into believing that THQ had some involvement with *Mar Vista's* movie, is that consumers *would* ordinarily identify the source of a movie by the title alone.”) (emphasis in the original).

<sup>138</sup> *Id.* at \*2–3.

<sup>139</sup> *Id.* at \*4 (“THQ alleges that consumers expect well-known video games to be made into movies, a practice that is particularly prevalent in the mystery/horror genre in which both parties operate.”).

*Warzone.com, LLC*.<sup>140</sup> The case presented a trademark dispute between Activision Publishing, Inc., publisher of the Call of Duty franchise, and Warzone.com, LLC, which developed a browser-based strategy game.<sup>141</sup> After Activision released its free-to-play online multiplayer game "Call of Duty: Warzone" and sought to register the WARZONE mark, the developer of an earlier browser-based game of the same name opposed the application, leading Activision to file a declaratory judgment action.<sup>142</sup>

The case's evolution through the courts illustrates the transformative impact of *Jack Daniel's* on trademark analysis in interactive media.<sup>143</sup> When initially presented to the District Court for the Central District of California, the analysis centered on the *Rogers* test's traditional framework.<sup>144</sup> The district court's pre-*Jack Daniel's* analysis focused heavily on First Amendment considerations under *Rogers*, finding that Call of Duty: Warzone constituted an expressive work entitled to First Amendment protection.<sup>145</sup> The court determined Activision's use of "Warzone" had clear artistic relevance to its game, which features "a large computer-generated battlefield, or warzone, that accommodates up to 150 players [sic], and sometimes 200 players, at one time."<sup>146</sup>

Notably, the district court rejected arguments that consumer confusion alone could satisfy *Rogers*' "explicitly misleading" prong, emphasizing that "[t]o fail the second prong of the *Rogers* test, it is key that the creator must *explicitly* mislead consumers," requiring "an explicit indication, overt claim, or explicit

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<sup>140</sup> *Activision Publ'g, Inc. v. Warzone.com, LLC*, 621 F. Supp. 3d 1090 (C.D. Cal. 2022), *vacated and remanded*, *Activision Publ'g II*, 2023 WL 7118756 [hereinafter *Activision Publ'g I*].

<sup>141</sup> *Id.* at 1093.

<sup>142</sup> *Id.*

<sup>143</sup> *See Activision Publ'g I*, 621 F. Supp. 3d at 1096–97 (applying *Rogers* test to find First Amendment protection), *vacated and remanded*, *Activision Publ'g II*, 2023 WL 7118756 at \*1 (remanding for reconsideration "consistent with *Jack Daniel's*"); *see also Mar Vista Ent.*, 2024 WL 3468933 at \*2 (interpreting *Jack Daniel's* as fundamentally altering the analytical framework for trademark disputes in expressive works).

<sup>144</sup> *See Activision Publ'g I*, 621 F. Supp. 3d at 1094–97.

<sup>145</sup> *See id.* at 1095 (explaining that a video game is "an expressive work entitled to as much First Amendment protection as . . . any other expressive work" (quoting *Novalogic, Inc. v. Activision Blizzard*, 41 F. Supp. 3d 885, 898 (C.D. Cal. 2013))).

<sup>146</sup> *See id.* at 1093, 1096.

misstatement that caused such consumer confusion.”<sup>147</sup> Finding no such explicit misleading, the court granted judgment to Activision without conducting traditional likelihood-of-confusion analysis.<sup>148</sup>

However, the Supreme Court’s subsequent decision in *Jack Daniel’s* fundamentally altered this analytical framework.<sup>149</sup> The Ninth Circuit, recognizing the significance of this shift, vacated the district court’s judgment and remanded “for further proceedings consistent with *Jack Daniel’s*.”<sup>150</sup> This reversal signaled the need for courts to prioritize analysis of source identification over artistic expression when evaluating trademark use in video games.

The Warzone litigation illustrates several critical implications of *Jack Daniel’s* for the gaming industry. First, it demonstrates that the artistic nature of video games does not automatically trigger a *Rogers* analysis, even when game titles or features serve expressive purposes.<sup>151</sup> Courts must instead determine whether the trademark serves any source-identifying function.<sup>152</sup> In the context of video game titles like “Call of Duty: Warzone,” this requires careful analysis of how consumers perceive the mark’s role in identifying the game’s origin or publisher.<sup>153</sup>

Second, the case highlights the complex interplay between artistic expression and source identification in gaming. Video game titles and features often serve dual purposes - both describing content and identifying products in

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<sup>147</sup> *Id.* at 1096 (quoting *Twentieth Century Fox TV*, 875 F.3d at 1199).

<sup>148</sup> *See id.* at 1097 (“Activision’s use of the term ‘Warzone’ in CODWZ is entitled to First Amendment protection and does not violate the Lanham Act.”).

<sup>149</sup> *See Jack Daniel’s II*, 599 U.S. at 153 (holding that the *Rogers* test does not apply when an alleged infringer uses a trademark as a designation of source for its own goods).

<sup>150</sup> *See Activision Publ’g II*, 2023 WL 7118756 at \*1.

<sup>151</sup> *See Jack Daniel’s II*, 599 U.S. at 152–56 (limiting the *Rogers* analysis to cases where trademarks are not used “as a mark”).

<sup>152</sup> *See Mar Vista Ent.*, 2024 WL 3468933, at \*4 (reasoning that a title functions as a source identifier where “consumers would ordinarily identify the source of a movie by the title alone”); *see also Activision Publ’g III*, 2024 WL 6467326, at \*3–4 (conducting fact-specific source-identification analysis by examining trademark registration, website presentation, and promotional materials).

<sup>153</sup> *See Activision Publ’g III*, 2024 WL 6467326, at \*3–4 (conducting fact-specific source-identification analysis based on Activision’s trademark registration, website presentation, and promotional materials); *see also Mar Vista Ent.*, 2024 WL 3468933, at \*4 (reasoning that a title functions as a source identifier where consumers would ordinarily identify the source of a movie by the title alone).

the marketplace.<sup>154</sup> Under *Jack Daniel's*, courts must now conduct full likelihood-of-confusion analysis whenever source identification is present, even if the mark also carries artistic meaning.<sup>155</sup>

This new framework particularly affects how courts evaluate consumer confusion in the gaming context.<sup>156</sup> The *Warzone.com* case itself demonstrates this shift. While the district court initially dismissed *Warzone.com*'s evidence of actual confusion as insufficient under *Rogers*, the Ninth Circuit vacated that judgment after *Jack Daniel's*.<sup>157</sup> On remand, the district court reversed course, holding that *Rogers* does not apply because Activision uses "WARZONE" as a source identifier and that the case must proceed under traditional likelihood-of-confusion analysis.<sup>158</sup> This outcome confirms that evidence of consumer confusion, previously dismissed under *Rogers*, must now be weighed as part of a comprehensive likelihood of confusion inquiry.<sup>159</sup> The expressive nature of games

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<sup>154</sup> See *Mar Vista Ent.*, 2024 WL 3468933, at \*3 (recognizing that a title used for a series of works can function as a trademark even when the title of a single creative work cannot).

<sup>155</sup> See *Jack Daniel's II*, 599 U.S. at 157–59 (holding that when a mark is used as a mark, traditional likelihood-of-confusion analysis applies, even if the use also contains expressive elements).

<sup>156</sup> See *Jack Daniel's II*, 599 U.S. at 152–53, 156 (requiring consideration of traditional likelihood-of-confusion factors even when marks have expressive elements); see also *Activision Publ'g I*, 621 F. Supp. 3d at 1095–97 (demonstrating the pre-*Jack Daniel's* approach that dismissed confusion evidence as insufficient under *Rogers*); *AM Gen.*, 450 F. Supp. 3d at 480–84 (analyzing how consumer confusion should be evaluated in the gaming context).

<sup>157</sup> See *Activision Publ'g I*, 621 F. Supp. 3d at 1096–97 (applying the *Rogers* test to find no explicitly misleading use despite allegations of consumer confusion), *vacated and remanded*, 2023 WL 4856831 (9th Cir. July 28, 2023).

<sup>158</sup> See *Activision Publ'g III*, 2024 WL 6467326, at \*3–4 ("Here, the *Rogers* test does not apply because Plaintiff is using 'WARZONE' to designate itself as the source of its game 'Call of Duty: Warzone' — in other words, Plaintiff is using 'WARZONE' as a trademark.").

<sup>159</sup> See *Jack Daniel's II*, 599 U.S. at 160–61 (explaining that expressive aspects of a source-designating use still matter in the likelihood-of-confusion analysis, even though they do not trigger *Rogers*); see also *Activision Publ'g III*, 2024 WL 6467326, at \*3–4 (remanding for traditional likelihood-of-confusion analysis after finding *Rogers* inapplicable).

remains relevant, but as one factor among many rather than a threshold question.<sup>160</sup>

The combined effect of these decisions has transformed how courts approach trademark disputes in video games. While games retain their status as expressive works worthy of First Amendment protection, the mere presence of artistic expression no longer justifies bypassing traditional trademark analysis when marks serve source-identifying functions.<sup>161</sup> This more nuanced approach requires courts to carefully balance creative expression against consumer protection, particularly in cases involving virtual goods, in-game purchases, and other features where commercial and expressive elements intersect.<sup>162</sup>

## V. REFORMING THE FRAMEWORK: A REFINED *ROGERS* TEST FOR VIDEO GAMES IN THE POST-*JACK DANIEL'S* ERA

The Supreme Court's decision in *Jack Daniel's* left significant questions unanswered regarding how courts should evaluate trademark use in video games—a medium that uniquely blends artistic expression with commercial functionality. This section proposes a refined *Rogers* framework tailored to the gaming context. Part A examines the narrow scope of the *Jack Daniel's* holding and identifies the doctrinal gaps it leaves for video game disputes. Part B critiques the growing appeal of transformative use analysis as an alternative framework and explains why it is ill suited to the gaming industry. Part C articulates the need for a more nuanced approach and identifies the foundational principles that should guide the reformed framework. Part D sets forth a multi-factor analytical structure for courts to apply when evaluating trademark use in interactive media. Part E

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<sup>160</sup> See *Jack Daniel's II*, 599 U.S. at 161 (“[A]lthough VIP’s effort to ridicule Jack Daniel’s does not justify use of the *Rogers* test, it may make a difference in the standard trademark analysis.”).

<sup>161</sup> See *Ent. Merchs. Ass’n*, 564 U.S. at 790 (confirming First Amendment protection for video games); *Jack Daniel's II*, 599 U.S. at 152–53 (limiting when the *Rogers* test applies).

<sup>162</sup> See Christine Haight Farley & Lisa P. Ramsey, *Raising the Threshold for Trademark Infringement to Protect Free Expression*, 72 AM. U. L. REV. 1225, 1283–87 (2023) (proposing a fair use test that holistically considers the content, context, and products at issue when evaluating informational or expressive uses of marks, including in connection with digital goods and virtual worlds); see also *Activision Publ’g III*, 2024 WL 6467326, at \*3–4 (applying a post-*Jack Daniel's* framework by conducting a fact-specific source-identification analysis based on trademark registration, website presentation, and promotional materials).

argues that *Rogers*' core principles must be preserved regardless of how the test itself evolves, and Part F considers how the reformed framework ensures continued innovation while safeguarding trademark rights.

A. THE COURT'S LIMITED HOLDING AND ITS IMPLICATIONS IN *JACK DANIEL'S*

The Supreme Court's decision in *Jack Daniel's* has created significant uncertainty around how courts should analyze trademark use in video games.<sup>163</sup> While the Court's narrow holding focused primarily on distinguishing trademark from non-trademark use, Justice Gorsuch's concurrence, joined by Justices Thomas and Barrett, suggests a broader reconsideration of the *Rogers* test may be forthcoming.<sup>164</sup> This concurrence signals potential changes in how courts balance First Amendment protections with trademark rights in expressive works.<sup>165</sup>

The Court's decision to cabin *Rogers* to cases where trademarks are not used "as marks" leaves open critical questions about video games, which often incorporate trademarks both for artistic expression and as source identifiers.<sup>166</sup> Unlike in *Jack Daniel's*, where the defendant used a parodied mark to identify its own products, video game developers typically use third-party marks to authentically represent the trademark owners' goods within their virtual worlds, not to identify the games themselves as products.<sup>167</sup> This fundamental distinction

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<sup>163</sup> See Farley & Ramsey, *supra* note 162, at 1251–56 (explaining that *Jack Daniel's* created uncertainty and predictability problems for litigants because the Court's narrow holding provided no guidance on the threshold requirement for *Rogers* or how lower courts should evaluate its two prongs, resulting in inconsistent application across jurisdictions); see also *Jack Daniel's II*, 599 U.S. at 152–55 (limiting *Rogers* to cases where trademarks are not used "as marks"); *Activision Publ'g II*, 2023 WL 7118756, at \*1 (vacating and remanding in light of *Jack Daniel's*).

<sup>164</sup> See *Jack Daniel's II*, 599 U.S. at 165 (Gorsuch, J., concurring) ("Today, the Court rightly concludes that ... *Rogers* does not apply to cases like the one before us. But in doing so, we necessarily leave much about *Rogers* unaddressed. . . . All this remains for resolution another day, *ante*, at [154–157], and lower courts should be attuned to that fact.").

<sup>165</sup> See *id.*

<sup>166</sup> See *id.* at 153–55.

<sup>167</sup> *Id.*; see, e.g., *AM Gen.*, 450 F. Supp. 3d at 479 (noting that the use of military vehicles in *Call of Duty* was to enhance realism, not to suggest source identification); *E.S.S. Ent. 2000*, 547 F.3d at 1100 (finding that the use of a

in how marks function in gaming creates particular challenges that the Court's limited holding does not fully address.<sup>168</sup> The gaming industry requires a more coherent framework that recognizes the medium's unique status as both expressive art and commercial product.<sup>169</sup>

#### B. THE PROBLEMATIC APPEAL OF TRANSFORMATIVE USE ANALYSIS

In the wake of *Jack Daniel's*, several commentators have proposed incorporating transformative use analysis into trademark claims involving video games.<sup>170</sup> The transformative use test, primarily developed in right of publicity cases like *Comedy III Productions v. Gary Saderup, Inc.*, examines whether a work adds significant creative elements that transform it into something more than a mere imitation or literal depiction of a person or protected content.<sup>171</sup> These proposals generally take three forms: (1) replacing *Rogers* entirely with the transformative use test, (2) creating a hybrid test that combines *Rogers* with transformative use principles, or (3) applying transformative use alongside a modified likelihood of confusion analysis.<sup>172</sup> While these approaches may seem

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modified strip club name in *Grand Theft Auto* was for creative purposes, not source identification).

<sup>168</sup> See, e.g., *Mar Vista Ent.*, 2024 WL 3468933 at \*2–4 (discussing source-identifying as opposed to merely expressive trademark uses in entertainment media); see also *Gordon*, 909 F.3d at 268–70 (analyzing when use of a mark serves dual expressive and source-identifying functions).

<sup>169</sup> See *Ent. Merchs. Ass'n*, 564 U.S. at 790–91 (recognizing video games as a unique medium deserving First Amendment protection); see also *AM Gen.*, 450 F. Supp. 3d at 485 (acknowledging that “realism can have artistic merit in itself” in the video game context).

<sup>170</sup> See Arlen Papazian, *Let's Stop Playing Games: A Consistent Test for Unlicensed Trademark Use and the Right of Publicity in Video Games*, 8 WM. & MARY BUS. L. REV. 577, 595–604 (2017) (proposing a unified approach that incorporates elements of transformative use analysis and advocating for a reformed *Rogers* test, where transformative use serves as a factor in the explicitly misleading prong).

<sup>171</sup> *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 799, 808–10 (Cal. 2001) (establishing the transformative use test for right of publicity claims); see also *Hart II*, 717 F.3d at 160–65 (applying transformative use test to video game depictions in right of publicity context).

<sup>172</sup> See Michael B. Weitman, *Fair Use in Trademark in the Post-KP Permanent World: How Incorporating Principles from Copyright Law Will Lead to Less Confusion in Trademark Law*, 71 BROOK. L. REV. 1665, 1689–93 (2006) (proposing that

appealing as ways to provide more structure than *Rogers* alone, they fundamentally misunderstand both the nature of video games and the purposes of trademark protection.<sup>173</sup>

These proposals fail for several crucial reasons.<sup>174</sup> First, the transformative use test was developed for right of publicity cases and focuses primarily on visual or creative modifications to protected content.<sup>175</sup> This emphasis on transformation makes little sense in the trademark context, where the core concern is consumer confusion about source or sponsorship rather than creative appropriation of identity.<sup>176</sup> The California Court of Appeals recognized this mismatch in *de Havilland*, noting that while transformative use "makes sense when applied to products and merchandise," it becomes problematic when applied to expressive works like films, television programs, and, by extension, video games.<sup>177</sup>

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trademark fair use incorporate copyright's four-factor analysis to provide courts with more consistent guidance); *see also* Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L. J. 461, 488–92 (2005) (discussing potential doctrinal approaches to trademark fair use).

<sup>173</sup> *See AM Gen.*, 450 F. Supp. 3d at 485 (recognizing that "realism itself carries artistic merit" in video games, which would be undermined by a transformative use requirement); *see also Ent. Merchs. Ass'n*, 564 U.S. at 790 (emphasizing video games as protected speech without requiring transformation of real-world elements).

<sup>174</sup> Tseng, *supra* note 55, at 482.

<sup>175</sup> *See id.* at 484.

<sup>176</sup> *Id.* at 485.

<sup>177</sup> *Id.* at 485, *see also* *De Havilland v. FX Networks, LLC*, 230 Cal. Rptr. 3d 625, 640–41 (Cal. Ct. App. 2018) (rejecting application of the transformative use test to a docudrama depicting the plaintiff and noting that it "makes sense when applied to products and merchandise" but is "less useful" for expressive works), *review denied* (July 11, 2018), *cert. denied*, 586 U.S. 1070 (2019). The case involved actress Olivia de Havilland's right of publicity claim against FX Networks for depicting her in the television series "Feud: Bette and Joan" without her permission. *Id.* The court held that applying the transformative use test to expressive works like television programs would unduly restrict free speech. *Id.*

Second, applying transformative use analysis to video games would create a perverse incentive against realism and authenticity.<sup>178</sup> Game developers often pursue realistic depiction as a legitimate artistic goal, whether recreating historical events in *Call of Duty*, simulating professional sports in EA's games, or crafting immersive open worlds in *Grand Theft Auto*.<sup>179</sup> Under transformative use analysis, however, this artistic choice would paradoxically work against First Amendment protection - the more accurate and faithful the depiction, the less likely it would be protected.<sup>180</sup> This bias against realism cannot be reconciled with the protection given to realistic portrayals in other expressive media.<sup>181</sup>

Beyond these theoretical flaws, the transformative use test creates significant practical problems for game development.<sup>182</sup> Its uncertainty and inherent bias against realism generate a chilling effect on creative expression, particularly for games attempting to portray real-world elements.<sup>183</sup> Developers face an impossible choice between compromising their artistic vision to satisfy an arbitrary transformation requirement or risking liability for creating faithful

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<sup>178</sup> See *AM Gen.*, 450 F. Supp. 3d at 485 ("If realism is an artistic goal, then the presence in modern warfare games of vehicles employed by actual militaries undoubtedly furthers that goal.").

<sup>179</sup> See *E.S.S. Ent. 2000*, 547 F.3d at 1100 (discussing the artistic relevance of creating a "cartoon-style parody" of Los Angeles neighborhoods in *Grand Theft Auto*); see also *Hart II*, 717 F.3d at 168-69 (acknowledging EA's interest in creating realistic sports simulations).

<sup>180</sup> See *Comedy III Prods.*, 21 P.3d at 809 (suggesting that realistic portrayals receive less protection under transformative use analysis); see also Tseng, *supra* note 55, at 483-85 (critiquing the application of transformative use to video games).

<sup>181</sup> See *Ent. Merchs. Ass'n*, 564 U.S. at 790 (recognizing video games as protected speech without distinguishing between realistic and non-realistic portrayals); see also *Noriega v. Activision/Blizzard, Inc.*, No. BC 551747, 2014 WL 5930149, at \*840-41 (Cal. Super. Oct. 27, 2014) (distinguishing video games from merchandise and noting that realistic elements in games may serve expressive purposes).

<sup>182</sup> Tseng, *supra* note 55, at 484.

<sup>183</sup> See Thomas E. Kadri, *Fumbling the First Amendment: The Right of Publicity Goes 2-0 Against Freedom of Expression*, 112 MICH. L. REV. 1519, 1525 (2014) ("The transformative use test is unwieldy and verbose. It tempts courts to judge the artistic value of expressive works in a manner that censors speech and belittles our rich First Amendment tradition.").

depictions.<sup>184</sup> This chilling effect extends beyond individual games to impact entire genres - historical simulations, sports games, and contemporary military titles all depend on realistic portrayals that would be suspect under transformative use analysis.<sup>185</sup>

C. THE NEED FOR A MORE NUANCED APPROACH: REFINING *ROGERS* FOR VIDEO GAMES

Rather than attempting to retrofit transformative use analysis, courts should refine the *Rogers* test to better address video games' unique characteristics.<sup>186</sup> The *Rogers* framework, properly calibrated, can protect both First Amendment interests and legitimate trademark rights while avoiding the problems inherent in transformative use analysis.<sup>187</sup>

This refined approach must explicitly recognize several fundamental principles about video games. First, realism and authenticity constitute legitimate artistic purposes deserving First Amendment protection,<sup>188</sup> as games that faithfully recreate real-world elements serve valuable expressive functions by educating players about historical events or providing authentic simulation experiences.<sup>189</sup> Second, the mere use of real-world elements in games does not

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<sup>184</sup> See *AM Gen.*, 450 F. Supp. 3d at 485 (recognizing that protecting realistic depictions in video games serves important First Amendment interests); see also *Ent. Merchs. Ass'n*, 564 U.S. at 794, 798–99 (warning against rules that would “restrict the ideas to which children may be exposed”).

<sup>185</sup> See *Hart II*, 717 F.3d at 168–70 (acknowledging the challenge of applying transformative use to realistic sports games); see also Papazian, *supra* note 170, at 599–602 (discussing the potential impact of transformative use analysis on various game genres).

<sup>186</sup> See Tseng, *supra* note 55, at 490–92; see also *Activision Publ'g I*, 621 F. Supp. 3d at 1096–97 (demonstrating the application of *Rogers* to video games before *Jack Daniel's*), *vacated and remanded*, 2024 WL 6467326 (C.D. Cal. Apr. 11, 2024).

<sup>187</sup> See *Jack Daniel's II*, 599 U.S. at 159–61 (acknowledging that expressive elements remain relevant in trademark analysis); see also *Rogers*, 875 F.2d at 998 (establishing a framework designed to balance expressive and consumer protection interests).

<sup>188</sup> See *AM Gen.*, 450 F. Supp. 3d at 485 (“If realism is an artistic goal, then the presence in modern warfare games of vehicles employed by actual militaries undoubtedly furthers that goal.”).

<sup>189</sup> See *Ent. Merchs. Ass'n*, 564 U.S. at 790–91 (recognizing video games as a medium that communicates ideas and social messages); see also *Novalogic*, 41

automatically suggest endorsement or sponsorship.<sup>190</sup> Third, consumer expectations in gaming differ significantly from traditional commercial contexts, particularly given the prevalence of licensed content and cross-promotion in the industry.<sup>191</sup>

D. IMPLEMENTING THE REFORMED FRAMEWORK: A MULTI-FACTOR ANALYSIS

Under the reformed *Rogers* approach, courts should conduct a more structured analysis that considers multiple factors when evaluating whether trademark use in video games is explicitly misleading.<sup>192</sup> This framework provides clearer guidance while maintaining necessary flexibility to address evolving industry practices.<sup>193</sup>

The analysis should examine several key factors: (1) whether the game makes affirmative representations about authorization or sponsorship through marketing materials, packaging, or in-game presentations;<sup>194</sup> (2) the prominence and significance of the trademark use within the game, distinguishing between

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F. Supp. 3d at 898 (recognizing the expressive value of realistic military elements in video games).

<sup>190</sup> See *E.S.S. Ent.* 2000, 547 F.3d at 1100 (finding that the mere use of a trademark in a video game does not explicitly mislead consumers about endorsement); see also *Twentieth Century Fox TV*, 875 F.3d at 1199 (emphasizing that use of a mark alone is insufficient to establish explicitly misleading use).

<sup>191</sup> See *Mar Vista Ent.*, 2024 WL 3468933 at \*4 (recognizing that “consumers expect well-known video games to be made into movies” through licensing agreements); see also *AM Gen.*, 450 F. Supp. 3d at 482–83 (analyzing consumer expectations regarding licensing in the video game context).

<sup>192</sup> See *Gordon*, 909 F.3d at 268–70 (suggesting that courts should consider multiple factors when assessing whether use is explicitly misleading); see also *Twentieth Century Fox TV*, 875 F.3d at 1199 (discussing various factors that might contribute to explicitly misleading use).

<sup>193</sup> See *Jack Daniel’s II*, 599 U.S. at 159–61 (acknowledging that the expressive nature of a work remains relevant in trademark analysis even after rejecting *Rogers* as a threshold test).

<sup>194</sup> See *AM Gen.*, 450 F. Supp. 3d at 483 (examining whether statements in marketing materials or user guides suggested authorization or sponsorship).

incidental background uses and central gameplay elements;<sup>195</sup> (3) whether the use serves genuine artistic purposes versus mere exploitation;<sup>196</sup> and (4) how promotional materials and overall presentation suggest official association.<sup>197</sup>

This multi-factor framework would help courts address common scenarios in modern gaming. For sports titles like NCAA Football or Madden NFL, courts would examine the totality of circumstances suggesting official sponsorship rather than focusing narrowly on visual transformation.<sup>198</sup> Similarly, for games incorporating real-world brands to create authentic environments, courts would evaluate whether such uses reasonably suggest sponsorship, given industry practices and consumer understanding.<sup>199</sup>

#### E. PRESERVING *ROGERS*' CORE PRINCIPLES BEYOND THE TEST

Even if the Supreme Court eventually abolishes or substantially modifies the *Rogers* test, as suggested by Justice Gorsuch's concurrence in *Jack Daniel's*, the fundamental principles underlying *Rogers* should continue to inform trademark analysis in video games.<sup>200</sup> The core insight of *Rogers*, that expressive works deserve robust First Amendment protection against trademark claims unless they

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<sup>195</sup> See *E.S.S. Ent. 2000*, 547 F.3d at 1100–01 (considering that the use of the mark was “quite incidental to the overall story of the [g]ame” in finding no explicit misleadingness).

<sup>196</sup> See *AM Gen.*, 450 F. Supp. 3d at 485 (evaluating whether the use of military vehicles served legitimate artistic purposes of creating realistic gameplay).

<sup>197</sup> Cf. *Activision Publ'g I*, 621 F. Supp. 3d at 1096–97 (analyzing how the game's marketing made clear its association with the broader Call of Duty franchise); see also *AM Gen.*, 450 F. Supp. 3d at 482–83 (examining whether marketing materials suggested authorization or sponsorship).

<sup>198</sup> See *Hart II*, 717 F.3d at 168–69 (discussing the complex interplay of realism and expressive elements in sports video games); see also *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 783–84 (D.N.J. 2011) (analyzing EA's NCAA Football games under various First Amendment tests), *rev'd on other grounds*, 717 F.3d 141 (3d Cir. 2013).

<sup>199</sup> See *E.S.S. Ent. 2000*, 547 F.3d at 1100–01 (evaluating whether consumers would reasonably believe a strip club had sponsored a video game); see also *Mar Vista Ent.*, 2024 WL 3468933 at \*2–3 (analyzing consumer expectations regarding licensing in the entertainment industry).

<sup>200</sup> See *Jack Daniel's II*, 599 U.S. at 165 (Gorsuch, J., concurring).

explicitly mislead consumers, remains vital regardless of the specific doctrinal framework employed.<sup>201</sup>

These foundational principles could be incorporated into whatever new framework emerges. Courts could still examine whether trademark uses serve genuine artistic purposes and create explicitly misleading impressions of authorization, even without formally applying *Rogers*.<sup>202</sup> The key factors identified above, including the prominence of trademark use, the presence of affirmative representations about sponsorship, and the role of industry practices in shaping consumer expectations, would remain relevant to analyzing potential consumer confusion about authorization or sponsorship.<sup>203</sup>

This approach would maintain the essential balance between creative freedom and trademark protection that *Rogers* sought to achieve.<sup>204</sup> Rather than focusing on technical applications of specific tests, courts could examine how trademark uses actually function in the gaming context and whether they create genuine confusion about authorization.<sup>205</sup> This would preserve meaningful protection for both artistic expression and consumer understanding, regardless of doctrinal evolution.<sup>206</sup>

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<sup>201</sup> See *Rogers*, 875 F.2d at 999 (“[The Lanham Act] should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”).

<sup>202</sup> See *Jack Daniel’s II*, 599 U.S. at 156–57 (acknowledging that expressive elements remain relevant within traditional trademark analysis); see also *AM Gen.*, 450 F. Supp. 3d at 482–85 (analyzing artistic purpose and consumer understanding within the Polaroid framework).

<sup>203</sup> See *Gordon*, 909 F.3d at 268–70 (identifying factors that contribute to explicitly misleading use); see also *Mar Vista Ent.*, 2024 WL 3468933, at \*2–3 (analyzing consumer expectations regarding licensing in the entertainment industry post-*Jack Daniel’s*).

<sup>204</sup> See *Rogers*, 875 F.2d at 998 (seeking to balance First Amendment concerns with trademark protections); see also *Ent. Merchs. Ass’n*, 564 U.S. at 790–91 (affirming the importance of protecting video games as expressive works).

<sup>205</sup> See *Twentieth Century Fox TV*, 875 F.3d at 1199; see also *Activision Publ’g I*, 621 F. Supp. 3d at 1096–97 (analyzing whether use created genuine confusion about authorization).

<sup>206</sup> See *Jack Daniel’s II*, 599 U.S. at 159 (emphasizing that First Amendment considerations remain relevant within traditional trademark analysis); see also *AM Gen.*, 450 F. Supp. 3d at 484–85 (recognizing the importance of protecting creative expression in video games).

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F. ENSURING CONTINUED INNOVATION WHILE PROTECTING RIGHTS

This refined *Rogers* framework offers several advantages over alternative approaches.<sup>207</sup> Unlike transformative use analysis, it does not inherently discriminate against realistic portrayal or authentic simulation.<sup>208</sup> It provides clearer guidance to developers while maintaining flexibility to address new technologies and business models.<sup>209</sup> Most importantly, it better serves both creative and commercial interests by focusing on genuine consumer confusion rather than arbitrary visual transformation requirements.<sup>210</sup>

Critics might argue that this approach insufficiently protects trademark holders. However, the framework still guards against misleading practices while recognizing that video game consumers understand the difference between artistic depiction and official sponsorship.<sup>211</sup> By examining multiple factors that contribute to consumer understanding of authorization, courts can identify genuinely misleading uses while preserving space for legitimate artistic expression.<sup>212</sup>

The video game industry continues to evolve rapidly, with new technologies and business models constantly emerging.<sup>213</sup> This refined *Rogers* framework provides an adaptable approach that can grow with the medium while

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<sup>207</sup> See *AM Gen.*, 450 F. Supp. 3d at 484–85 (recognizing realism as a legitimate artistic goal that should be protected); see also *Hart II*, 717 F.3d at 168–69 (acknowledging the challenges posed by transformative use analysis for realistic sports games).

<sup>208</sup> *Id.*

<sup>209</sup> See Kadri, *supra* note 183, at 1525 (“The transformative use test is unwieldy and verbose. It tempts courts to judge the artistic value of expressive works in a manner that censors speech and belittles our rich First Amendment tradition.”).

<sup>210</sup> See *Jack Daniel’s II*, 599 U.S. at 159.

<sup>211</sup> See *E.S.S. Ent. 2000*, 547 F.3d at 1100–01 (“[A] reasonable consumer would not think a company that owns one strip club in East Los Angeles . . . also produces a technologically sophisticated video game.”); see also *AM Gen.*, 450 F. Supp. 3d at 482 (analyzing consumer expectations regarding licensing in the video game context).

<sup>212</sup> See *Twentieth Century Fox TV*, 875 F.3d at 1199 (focusing on whether uses create a genuine risk of consumer confusion); see also *Gordon*, 909 F.3d at 268–70 (identifying factors that contribute to explicitly misleading use).

<sup>213</sup> See Lemley & Volokh, *supra* note 8, at 1084–89 (discussing emerging technologies in gaming and their legal implications).

maintaining consistent principles.<sup>214</sup> Rather than forcing games into rigid categories or requiring artificial transformation of real-world elements, it allows courts to examine how trademark uses actually function in the gaming context and whether they create genuine confusion about authorization or sponsorship.<sup>215</sup>

This approach ultimately supports both artistic freedom and consumer protection by providing clearer standards while maintaining flexibility.<sup>216</sup> It recognizes video games as a unique form of expression that often requires incorporating real-world elements for artistic purposes, while still protecting against practices that genuinely mislead consumers about authorization or sponsorship.<sup>217</sup> As the gaming industry continues to mature, this balanced framework will help courts navigate the complex intersection of trademark rights and creative expression in this important medium.<sup>218</sup>

## VI. CONCLUSION

The intersection of trademark law and video games represents a critical frontier in intellectual property jurisprudence, one that continues to evolve as courts grapple with the medium's unique characteristics. The Supreme Court's decision in *Jack Daniel's* marks a watershed moment in this evolution, fundamentally restructuring how courts evaluate trademark use in expressive works. While the Court's narrow holding, which limits the *Rogers* test to non-trademark uses, provides some clarity, it also creates significant challenges for an

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<sup>214</sup> See *Jack Daniel's II*, 599 U.S. at 143 (acknowledging that expressive elements remain relevant within traditional trademark analysis); see also *Ent. Merchs. Ass'n*, 564 U.S. at 790 (establishing flexible principles for First Amendment protection of video games).

<sup>215</sup> Compare *Activision Publ'g I*, 621 F. Supp. 3d at 1096–97 (applying *Rogers* to video game title), with *Activision Publ'g III*, 2024 WL 6467326, at \*3–4 (holding that traditional likelihood-of-confusion analysis applies when mark is used as source identifier); see also *Mar Vista Ent.*, 2024 WL 3468933, at \*2–3.

<sup>216</sup> See *Rogers*, 875 F.2d at 999 (establishing principles to balance free expression with consumer protection); see also *Ent. Merchs. Ass'n*, 564 U.S. at 790–91 (affirming the importance of protecting video games as expressive works).

<sup>217</sup> See *AM Gen.*, 450 F. Supp. 3d at 484–85; see also *E.S.S. Ent. 2000*, 547 F.3d at 1100–1101.

<sup>218</sup> See Tseng, *supra* note 55, at 490–92 (arguing for refined approaches to trademark law in video games); see also Papazian, *supra* note 170, at 599–602 (proposing balanced frameworks for trademark analysis in gaming).

industry where trademarks frequently serve both expressive and source-identifying functions.

The post-*Jack Daniel's* landscape, as illustrated by cases like *Mar Vista* and *Warzone.com*, reveals the complexity of applying traditional trademark principles to interactive media. These decisions demonstrate that courts must now navigate a more nuanced terrain, particularly when evaluating claims of "merely expressive" use in an industry where licensing and collaboration are increasingly common. This heightened scrutiny creates both challenges and opportunities: while it may complicate developers' efforts to create authentic experiences, it also provides an opportunity to establish clearer standards for legitimate trademark use in gaming contexts.

The gaming industry's continued evolution, characterized by technological innovation, new business models, and changing consumer expectations, demands a more sophisticated legal framework than either pure *Rogers* analysis or traditional likelihood-of-confusion tests can provide. The reformed approach proposed in this Note, which emphasizes contextual analysis and industry-specific factors, offers a path forward. This framework recognizes video games' dual nature as both expressive works and commercial products, while providing courts with practical tools to evaluate potential consumer confusion about authorization or sponsorship. Several key principles should guide courts and policymakers in developing this more nuanced approach. First, realism and authenticity in video games constitute legitimate artistic purposes deserving First Amendment protection. Second, the sophisticated nature of modern gaming audiences requires courts to recalibrate their understanding of consumer confusion in interactive contexts. Third, trademark analysis must account for the industry's established practices regarding licensed content and cross-promotion, which shape consumer expectations about authorization and sponsorship.

Looking ahead, the challenge lies in developing standards that protect both brand identity and creative expression while remaining flexible enough to accommodate technological innovation. Success will require collaboration between developers, trademark holders, courts, and regulators to create guidelines that serve all stakeholders' interests. Particularly crucial is the development of clear standards for evaluating trademark use in emerging contexts like augmented reality, virtual reality, and user-generated content. Rather than viewing *Jack Daniel's* as a limitation on creative expression, the gaming industry should see it as an opportunity to establish more predictable and practical standards for trademark use. By focusing on genuine consumer confusion rather than artificial distinctions between trademark and non-trademark use, courts can protect both brand identity and artistic freedom. This balanced approach will

better serve the industry's needs while preserving video games' status as a protected form of expression under the First Amendment.

The future of trademark protection in video games will likely require continued refinement as technology and consumer expectations evolve. However, by emphasizing clear guidelines, practical solutions, and balanced protection of stakeholder interests, the legal system can foster both innovation and fair competition in this dynamic medium. The goal should be to preserve video games' expressive potential while ensuring that trademark law continues to serve its essential function of preventing consumer confusion and protecting brand identity in an increasingly complex digital landscape.