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Out of Bounds:
Defining the Boundaries of
Trademark and Artistic Expression in
University of Alabama v. New Life Art

*Derik T. Sanders**

I. INTRODUCTION

With an ever-increasing appreciation for intellectual property rights, individuals and entities have come to expect those valuable rights to be protected. For nearly three-quarters of a century, the Lanham Act has been the primary source for the protection of well-known symbols.¹ In contrast, the First Amendment of the United States Constitution has provided authors, artists, and others significant freedom in their own expression through artistic works.² In a head-to-head collision between the University of Alabama's trademark rights and renowned sports artist Daniel Moore's First Amendment rights, the Eleventh Circuit held that trademark law cannot restrict the freedom of expression when the marks are artistically relevant to the work.³ The court's decision was a monumental victory for artists who seek to portray realism in their art. The importance of balancing trademark rights with the value of artistic expression through the use of the marks within the art was definitively recognized in the court's opinion.⁴ The Eleventh Circuit reinforced the importance of First Amendment rights in artistic expression, indicating that sharing and enjoying of cultural symbols may be achieved without threat of trademark infringement.⁵ The court's balancing of these two rights may encourage a substantially different approach to the use of collegiate and professional sports teams' marks in the sports-themed video game and motion picture industry. The court's opinion in *New Life Art II* takes the realistic artistic expression required in sports art outside of the playing field for a traditional trademark infringement analysis.

II. FACTUAL BACKGROUND

Since its inception, the University of Alabama, located in Tuscaloosa, Alabama, has had a substantial impact on the culture of Alabama and the

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1. 15 U.S.C. § 1051 (2006).
2. U.S. CONST. amend. I; *see also* *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 502 (1952) (holding that films are protected speech).
3. *Univ. of Ala. Bd. of Trustees v. New Life Art, Inc. (New Life Art II)*, 683 F.3d 1266, 1276 (11th Cir. 2012).
4. *See id.* at 1278–79.
5. *Id.* at 1278.

Southeastern United States. The University of Alabama is widely known for its excellence in educational standards and athletics.⁶ Relevant both historically and recently, the Alabama Crimson Tide football team has won two of the last three national championships, totaling fourteen, making the University of Alabama one of the most successful, recognizable, and valuable programs in the National Collegiate Athletics Association.⁷ Unsurprisingly, the Crimson Tide's value and revenue is staggering.⁸ The University's portfolio of intellectual property assets includes trademarks, service marks, designs, logos, colors, and symbols that are managed by the University of Alabama's licensing department.⁹

Daniel Moore earned his bachelor's degree in art from the University of Alabama in 1976 and shortly thereafter began his career in sports art with "The Goal Line Stand" in 1980.¹⁰ Moore embarked on a wildly successful career of painting famous sports moments; primarily those of his alma mater, the Alabama Crimson Tide.¹¹ Art collectors and football fans alike have recognized Moore's artistic talent and quality works, thereby increasing the overall popularity and value of his paintings.¹² In 1991, after twelve years of independently producing paintings of memorable Alabama football moments, the University of Alabama and Moore entered into a licensing relationship that continued until 2000.¹³

During their licensing relationship, Moore agreed to produce and market products with the University of Alabama's marks, designs, and other sym-

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6. See Brief of Appellee/Cross-Appellant at 2–3, *New Life Art II*, (Nos. 09-16412-AA, 10-10092-A).
 7. See Chris Smith, *College Football's Most Valuable Teams*, FORBES (Dec. 22, 2011, 11:43 AM), <http://www.forbes.com/sites/chris-smith/2011/12/22/college-football-most-valuable-teams/>.
 8. See *College Football's Most Valuable Teams: 6. University of Alabama Crimson Tide*, FORBES, <http://www.forbes.com/pictures/emdm45el/6-university-of-alabama-crimson-tide/> (last visited Mar. 26, 2013) (estimating the University of Alabama Crimson Tide football team to be the sixth most valuable college football team with an approximate value of \$93 million and annual revenue of approximately \$77 million).
 9. *New Life Art II*, 683 F.3d at 1273.
 10. See *Daniel Moore: "Capturing the Classics" Artist Biography*, AMERICAN SPORT ART MUSEUM & ARCHIVES, <http://www.asama.org/awards-of-sport/memallion-series/sport-artist-of-the-year/daniel-moore/> (last visited Mar. 26, 2013); Daniel Moore, "The Shutout" . . . A Word from the Artist, NEWLIFEART.COM, <http://www.newlifeart.com/A%20Word%20from%20the%20Artist%20-%20TSO%20flat.pdf> (last visited Mar. 26, 2013).
 11. See *Daniel Moore: "Capturing the Classics" Artist Biography*, *supra* note 10.
 12. See *id.*
 13. *New Life Art II*, 683 F.3d at 1270, 1272.

bols in exchange for royalty payments.¹⁴ Moore continued to create and sell football paintings and prints that were not subject to the licensing relationship despite the University's insistence that such unauthorized use of the its marks amounted to trademark infringement.¹⁵ In 2002, the University emphasized their continued request for Moore to license any and all of his University of Alabama artwork and derivative works because they featured trademarks owned by the University.¹⁶ In response, Moore asserted that his use of the University's marks, *as a part of the artistic content*, did not violate the University's trademarks.¹⁷ Despite their disagreement, Moore continued to produce artwork portraying well-known Crimson Tide jerseys, helmets, and the University's famous crimson and white colors, while the University continued to display and sell Moore's works in their campus bookstores.¹⁸

III. DESCRIPTION OF PETITIONER'S CLAIMS

The University of Alabama brought a suit in March 2005 against Daniel Moore and New Life Art, Inc., the publishers of Moore's art prints, alleging that the use of the football uniforms in Moore's paintings, prints, and other memorabilia breached a contractual obligation and infringed upon the University's trademark in violation of Section 1125(a) of the Lanham Act.¹⁹ The suit alleged that Moore was prohibited from using the University's football uniforms or "licensed indicia" in any of his work.²⁰ The University alleged that the cumulative meaning of the language in the parties' agreements prohibited Moore from using colors, designs, names, and other referencing symbols in any works he produced without its express consent.²¹

IV. PROCEDURAL AND SUBSTANTIVE HISTORY

The United States District Court for the Northern District of Alabama concluded the University of Alabama's colors had acquired some secondary meaning, but were not strong trademarks, and thus Moore's depictions of the Crimson Tide jerseys and helmets in paintings and prints received First Amendment protection and were entitled to a fair use defense.²² Accordingly, the district court granted partial summary judgment in favor of New Life Art,

14. *Id.* at 1272.

15. *Id.* at 1270.

16. *Id.*

17. *Id.*

18. *Id.*

19. *New Life Art II*, 683 F.3d at 1270.

20. *Id.* at 1271-72.

21. *Id.* at 1272-73.

22. *Univ. of Ala. Bd. of Trustees v. New Life Art, Inc. (New Life Art I)* 677 F. Supp. 2d 1238, 1258-59 (N.D. Ala. 2009).

Inc., and Daniel Moore.²³ However, the district court concluded that Moore's depictions of Crimson Tide jerseys and helmets on calendars, mugs, and "mundane products" were not entitled to a fair use defense or any First Amendment protection.²⁴ As a result, partial summary judgment was granted in favor of the University of Alabama with regard to Moore's derivative memorabilia.²⁵ The district court interpreted the collective language of the parties' prior licensing agreements to not include the use of the Crimson Tide uniforms in its definition of "licensed indicia," and subsequently found that Moore was not contractually prohibited from using the uniforms in his works.²⁶ In response to the district court's ruling, both parties appealed to the United States Court of Appeals for the Eleventh Circuit.²⁷

V. UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT'S HOLDING

The Court of Appeals interpreted the licensing agreements to lack the intention to prohibit Moore's use of the Crimson Tide uniforms in unlicensed paintings, prints, or calendars.²⁸ The court was in "basic agreement" with the district court's evaluation of the University of Alabama's mark, but determined that, because "the First Amendment interests in artistic expression so clearly outweigh whatever consumer confusion that might exist," there was no Lanham Act violation with respect to Moore's use of the uniforms in his paintings, prints, and calendars.²⁹ With respect to mugs and other "mundane products," the court found the record to be factually insufficient to determine the parties' intent within the licensing agreements.³⁰ Additionally, the court dismissed Moore's copyright claim to the derivative works and noted that Moore had "waived any challenge to the district court's conclusions that his use of the uniforms . . . was not a fair use and was not protected by the First Amendment."³¹

VI. COURT'S RATIONALE

The Eleventh Circuit methodically approached the analysis of the issues presented on appeal. After acknowledging that it had jurisdiction only over the never-licensed objects, the court categorized its analysis based on the

23. *Id.* at 1259.

24. *Id.*

25. *New Life Art II*, 683 F.3d at 1271.

26. *Id.* at 1272.

27. *Id.* at 1271.

28. *Id.* at 1275.

29. *Id.* at 1276.

30. *Id.* at 1279.

31. *New Life Art II*, 683 F.3d at 1279.

objects produced by Moore: (1) paintings, prints, and calendars; and (2) mugs and other mundane products.³² The court began its analysis of the paintings, prints, and calendars by determining whether Moore's use of the Crimson Tide uniforms was contractually prohibited.³³ The parties' agreements prohibited Moore from using the "licensed indicia" for anything other than "explicitly licensed items."³⁴ The terms and conditions regarding the University's interests in its licensed indicia "survive the termination or expiration of [the] Agreement."³⁵ While the agreements defined "licensed indicia," uniforms were not mentioned in any list or appendix.³⁶ The court determined that the agreement was ambiguous as to whether the parties intended to include the Crimson Tide uniforms within the "licensed indicia," and consequently prohibited their unlicensed use.³⁷ Since the agreements were governed by Georgia law, the court then examined the course of conduct between Moore and the University to infer the parties' intent during, and after, the licensing agreement.³⁸ The Eleventh Circuit found that there was "considerable" evidence indicating that Moore's use of the uniforms in paintings, prints, and calendars was not a violation of the licensing agreements.³⁹ Since the licensing agreements had no bearing on the use of the Crimson Tide uniforms in Moore's paintings, prints, and calendars, the Court of Appeals methodically continued its analysis by addressing the University's claim of trademark infringement.⁴⁰ The Eleventh Circuit agreed with the lower court and concluded that the University's mark was weak and there was "some likelihood of confusion."⁴¹ However, the court concluded that it was unnecessary to pinpoint the strength of the mark or determine the likelihood of confusion.⁴² Moore's First Amendment interests "clearly outweigh[ed] any consumer confusion" and, therefore, could not be a violation of the Lanham Act.⁴³

The court proceeded to address the First Amendment protection of artistic expression by referencing to the methodologies that several sister circuits

32. *Id.* at 1272.

33. *Id.* at 1273.

34. *Id.*

35. *Id.*

36. *Id.*

37. *New Life Art II*, 683 F.3d at 1273.

38. *Id.* at 1274.

39. *Id.* (discussing the University's regular sale, prominent display, and museum brochure cover featuring Moore's unlicensed prints).

40. *Id.* at 1275.

41. *Id.* at 1276.

42. *Id.*

43. *New Life Art II*, 683 F.3d at 1276.

applied when confronting a conflict between the First Amendment and trademark rights.⁴⁴ First Amendment protection has been previously established in photos, films, paintings, drawings, and engravings.⁴⁵ Therefore, Moore's paintings, prints, and calendars are entitled to First Amendment protection.⁴⁶ The court applied the test used in the landmark case of *Rogers v. Grimaldi*, where the Second Circuit balanced the conflicting trademark and First Amendment rights.⁴⁷ The *Rogers* court concluded that the Lanham Act must be read narrowly to avoid encroaching on First Amendment protected speech.⁴⁸ "[I]n general, 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."⁴⁹ Here, the court likened the use of the Crimson Tide uniforms to the use of Tiger Woods' image in *ETW Corp. v. Jireh Publishing, Inc.*⁵⁰ In that case, the Sixth Circuit applied the *Rogers* balancing test to a false endorsement claim, and held that the artist's use had some artistic relevance and was not explicitly misleading.⁵¹ The court recognized no difference in the derivation of a false endorsement claim and trademark infringement, and concluded, "[a]n artistically expressive use of a trademark will not violate the Lanham Act unless the use of the mark has no artistic relevance to the underlying work whatsoever, or . . . explicitly misleads as to the source or the content of the work."⁵² Specifically, Moore's paintings, prints, and calendars garner First Amendment protection under the Eleventh Circuit's extension of the *Rogers* test because the uniforms are artistically relevant *and* necessary for a realistic portrayal of memorable University of Alabama sporting events.⁵³

In its analysis of Moore's use of the trademark on mugs and other "mundane products," the court first reemphasized the ambiguity in the parties' licensing agreements.⁵⁴ However, it concluded that the record was not adequately developed to resolve the ambiguity with respect to the mugs and

44. *Id.* at 1276-77.

45. *Id.* at 1276 (citing *Kaplan v. California*, 413 U.S. 115, 119-20 (1973)).

46. *Id.*

47. *Id.* at 1276; *see also* *Rogers v. Grimaldi*, 875 F.2d 994, 999-1000 (2d Cir. 1989).

48. *New Life Art II*, 683 F.3d at 1277 (citing *Rogers*, 875 F.2d at 998-1000).

49. *Id.* (citing *Rogers*, 875 F.2d at 999).

50. *Id.* at 1278 (citing 332 F.3d 915, 918 (6th Cir. 2003)).

51. *Id.* (citing *ETW*, 332 F.3d at 936-37).

52. *Id.* (quoting *ESS Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008)).

53. *Id.*

54. *New Life Art II*, 683 F.3d at 1279; *see supra* notes 34-38 and accompanying text.

mundane products.⁵⁵ Moore contended that his copyright ownership of the original paintings entitled him to a right to produce derivative products featuring his copyrighted works; the court disagreed.⁵⁶ “[A] copyright is not a ‘right’ to use: it is a right to exclude *others* from using the copyrighted work.”⁵⁷ The court declined to address the First Amendment and fair use issues *sua sponte*.⁵⁸ Due to Moore’s failure to raise these issues on appeal, the court noted the only trademark argument that remained was acquiescence.⁵⁹ Accordingly, the court dismissed Moore’s copyright “defense,” and after narrowing his remaining arguments, the court reversed summary judgment and remanded the case for an appropriate resolution as to the remaining disputed issues of material fact.⁶⁰

VII. CRITIQUE OF COURT’S APPROACH

The notion that universities are merely institutions providing higher education is outdated, now replaced by a new reality: collegiate athletics, led by college football and basketball, have morphed into a dominating enterprise. The availability of sporting events on television has driven the popularity of collegiate athletics through the roof. It is no longer safe to assume that someone who supports a university’s team with a bumper sticker or t-shirt is a student, graduate, or even a resident of the same state as that university. Major college athletics are en vogue. Dozens of college teams have estimated values nearing \$100 million.⁶¹ Several conferences and universities have their own television networks.⁶² Like any other multi-million dollar entity with valuable intellectual property rights, universities strategically monitor the use of their trademarks in an apparent effort to protect their brand and

55. *New Life Art II*, 683 F.3d at 1279.

56. *Id.* at 1280.

57. *Id.* (quoting McCarthy on Trademarks and Unfair Competition § 6:14 (4th ed. 2011)).

58. *Id.*

59. *Id.* at 1280-81. Acquiescence is a statutory defense requiring “three elements: (1) the plaintiff actively represented it would not assert a right or claim; (2) the delay between the active representation and assertion of the right or claim was not excusable, and (3) the delay caused the defendant undue prejudice.” *Id.* at 1281 (quoting *Angel Flight of Ga., Inc. v. Angel Flight Am., Inc.*, 522 F.3d 1200, 1207 (11th Cir. 2008)); see also 15 U.S.C. § 1115(b)(9) (2012); In order to demonstrate acquiescence, “the relevant evidence . . . would be active behavior by the University during the time that Moore has been portraying the University’s uniforms.” *New Life Art II*, 683 F.3d at 1282.

60. *Id.* at 1280-82.

61. See Smith, *supra* note 7.

62. See, e.g., Dennis Dodd, *Pac-12 Network Debuts*, CBS SPORTS, (Aug. 15, 2012, 4:32 PM), <http://www.cbssports.com/collegefootball/blog/dennis-dodd/19802949/pac-12-network-debuts-now-everyone-please-calm-down>.

sustain the success of their budding golden goose. Trademark rights should not impede the freedom of expression embodied in the First Amendment.⁶³ Filmmakers, artists, and authors must have the untethered freedom to use marks in artistic works. A prohibition on using marks in artistic works would deprive the public of unnecessarily suppressed ideas. Yet, the Lanham Act grants an exclusive right to prevent others from the use of particular symbols.⁶⁴ Balancing the ideals underlying First Amendment rights with the goals of trademark jurisprudence can, therefore, be challenging.

The United States Court of Appeals for the Eleventh Circuit effectively articulated the implication of the issues presented in *New Life Art II*, extending the Second Circuit's speech-protection test developed in *Rogers*.⁶⁵ *Rogers* provided First Amendment protection to artistically relevant titles, later extended to include the content of artistic works,⁶⁶ but it is the Eleventh Circuit's extension to the expressive content "needed for a realistic portrayal" that may prove revolutionary.⁶⁷ The court appropriately used the *Rogers* test for direction in order to balance the public's interests in expression and confusion. It is vital for trademark and First Amendment jurisprudence to develop in concert with developments in technology and market preference. However, it is equally important that trademark law remain rooted in its fundamental purpose: to protect consumers. By favoring expressive works of art that use trademarks for artistically relevant purposes, the Eleventh Circuit has made it permissible and has, perhaps, provided an avenue for artists to create art that enables the public to experience new levels of realistic experience. Artists should be censored from portraying the most realistic versions of art only if a substantial likelihood of genuine consumer confusion is presented. The court's decision signaled the importance of artistic freedom when memorializing notable events through realistic expressions of art.

VIII. CONCLUSION

New Life Art II addressed the conflict between the First Amendment right of expression in artistic works and the trademark protection provided by the Lanham Act. Current First Amendment jurisprudence provides that expressive speech, such as art and film, is noncommercial and entitled to full First Amendment protection. By extending the *Rogers* test to protect the use of marks when artistically relevant and necessary for realism, the Eleventh Circuit has reinforced the strength of First Amendment rights and embodied

63. See U.S. CONST. amend. I; see also *Kaplan*, 413 U.S. at 119–20 (holding that the First Amendment protection extends beyond words and include pictures, films, paintings, drawings).

64. See 15 U.S.C. § 1051.

65. *New Life Art II*, 683 F.3d at 1278–79; see also *Rogers*, 875 F.2d at 1001.

66. See *Cliff's Notes, Inc. v. Bantam Doubleday Dell Publ'g Group*, 886 F.2d 490, 495 (2d Cir. 1989).

67. *New Life Art II*, 683 F.3d at 1278.

the significance of sharing and enjoying important cultural symbols. The court's decision could impact other modes of art; particularly, video game producers' and filmmakers' hesitance to use trademarks in games and films in efforts to provide a more realistic and accurate illustration of the world.⁶⁸ Like motion pictures, video games have been classified as expressive works entitled to First Amendment protection.⁶⁹ Modern video games have become increasingly realistic and interactive, thereby significantly altering the determination of the proper rights for protection in the revolutionary gaming industry.⁷⁰

The decision could have a significant impact on the relevance of the Collegiate Licensing Company and may alter how universities and their mascots, nicknames, and colors are used in video games and motion pictures. Further, with the extensive use of paid-for product placement in motion pictures, this decision may accelerate a reexamination of the Supreme Court's commercial and noncommercial speech dichotomy.⁷¹ Considering the increased commercialization of artistic works featuring marks and the booming market for collegiate memorabilia, *New Life Art II* aptly defined the proper bounds in the struggle between trademark and First Amendment jurisprudence.

68. See generally Lateef Mtima, *What's Mine is Mine but What's Yours is Ours: IP Imperialism, the Right of Publicity, and Intellectual Property Social Justice in the Digital Information Age*, 15 SMU SCI. & TECH. L. REV. 323, 360-70 (2012); *Louis Vuitton Mallatier S.A. v. Warner Bros. Entm't*, 868 F. Supp. 2d 172 (S.D.N.Y. 2012) (upholding the use of trademark where there is some artistic relevance).

69. *Brown v. Entm't Merchs. Ass'n.*, 131 S. Ct. 2729, 2733 (2011) ("Like protected books, plays, and movies that preceded them, video games communicate ideas—even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium. . . . That suffices to confer First Amendment protection.").

70. See, e.g., *Brown v. Elec. Arts, Inc.*, 722 F. Supp. 2d 1148, 1150–51 (C.D. Cal. 2010), *on appeal*, No. 09-56675 (9th Cir. Oct. 23, 2009) (argued before the Ninth Circuit on July 13, 2012, no subsequent ruling has been issued).

71. See Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 WASH. L. REV. 887, 936 (2005).

