



## **15-SECOND** ADVERTISING AND TRADEMARK LAW ALERT

# FIRST AMENDMENT GAMED SUCCESSFULLY IN STRIP JOINT SUIT

**T**he First Amendment protects minimally relevant use of another's trademark in an artistic work, even where the mark is not used in a title, the Ninth Circuit recently held.\*

### **BACKGROUND**

Plaintiff owns the trademark rights to "Play Pen," the name of a strip club in east Los Angeles. Defendants are associated with producing the popular Grand Theft Auto video games.

One of the GTA games takes place in fictional east "Los Santos," the depiction of which was inspired by visiting and photographing the Play Pen and other parts of east L.A.

The game's seedy virtual location includes the "Pig Pen," a strip joint. The trademark "Play Pen" is never used in the game; Pig Pen's looks differ in several aspects from the real club. It was stipulated that the game was an artistic work.

Plaintiff, among other things, alleged under the Lanham Act that

Defendants were infringing its trademark and misleading viewers to believe Defendant endorsed or was associated with the game.

The district court threw the case out on summary judgment, holding that Defendants' depictions were completely protected by the First Amendment. Plaintiff Appealed.

### **DECISION**

The Ninth Circuit affirmed. It noted that the test for whether an artistic work's use of a trademark is actionable under the Lanham Act "traditionally applies" to uses of the mark in the title of the work.

The Court created an "extension of the doctrine," holding that there was "no principled reason why it ought not also apply to the use of the trademark in the body of the work."

It held that the First Amendment protects artistic use of a trademark that has *any* relevance "whatsoever" to the artistic work – "the level of relevance merely must be above zero." Here it was.■

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\* *ESS Entertainment 2000 v. Rock Star Videos, et al.* No. 06-56237 (9<sup>th</sup> Cir. Nov. 5, 2008).

